

UNITED STATES PATENT AND TRADEMARK OFFICE
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KGC/wbc

September 1, 2021

Cancellation No. 92068091

Usina Sao Francisco S.A.

v.

Tile World Corporation dba TWCorp

Wendy Boldt Cohen, Interlocutory Attorney:

This case comes before the Board on Petitioner's motion to extend the close of its discovery period and remaining dates. *See* 52 TTABVUE. The motion is fully briefed.¹

Motion to Extend

Because Petitioner acted prior to the expiration of its discovery period,² it need only show "good cause" for the extension sought, and the parties do not appear to disagree on this point. *See* Fed. R. Civ. P. 6(b)(1)(A); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 509.01(a) (2021). A motion to extend should include a recitation of specific facts constituting good cause for the extension

¹ The Board has considered the parties' submissions and presumes the parties' familiarity with the arguments made therein. The parties' arguments will not be summarized herein except as necessary to explain the Board's decision. *See Guess? IP Holder L.P. v. Knowlux LLC*, 116 USPQ2d 2018, 2019-20 (TTAB 2015).

² Discovery for Petitioner, as last reset, was set to expire June 18, 2021. *See* 50 TTABVUE 15. Petitioner's motion to extend was filed June 17, 2021. *See* 52 TTABVUE.

sought. See *Fairline Boats plc v. New Howmar Boats Corp.*, 59 USPQ2d 1479, 1479-80 (TTAB 2000); *Instruments SA Inc. v. ASI Instruments Inc.*, 53 USPQ2d 1925, 1927 (TTAB 1999); *Luemme Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758, 1760 (TTAB 1999). The Board is generally liberal in granting extensions before the period to act has lapsed, so long as the moving party has not been guilty of negligence or bad faith and the privilege of extensions is not abused. See, e.g., *Am. Vitamin Prods. Inc. v. DowBrands Inc.*, 22 USPQ2d 1313, 1315 (TTAB 1992).

Further, “[w]hile the Board encourages early service of discovery instead of reliance upon motions to extend the discovery period, a party wishing to serve discovery requests at a point in the discovery period when the last day for responding to the requests would fall after the close of discovery may seek an extension of the discovery period when appropriate and if it can establish good cause for the extension” (emphasis in original). *Trans-High Corp. v. JFC Tobacco Corp.*, 127 USPQ2d 1175, 1176-77 (TTAB 2018) (citing *Estudi Moline Dissey, S.L. v. BioUrn Inc.*, 123 USPQ2d 1268, 1271 n.6 (TTAB 2017)).

In its March 2, 2020 order denying Petitioner’s motion to compel, the Board informed the parties of its expectation that they “cooperate with one another in the future to avoid unnecessary motions that tax the Board’s limited resources and to move this case forward efficiently.” 24 TTABVUE 4. Following this, Respondent supplemented its initial discovery responses in the summer of 2020 (52 TTABVUE 14, ¶ 3; 53 TTABVUE 11, ¶ 3), which contained, according to Petitioner’s counsel, “nearly 2,500 pages of documents, mostly in Spanish, without translation” that

Petitioner has “diligently worked to analyze and translate,” (52 TTABVUE 14, ¶¶ 3-4). Thereafter, on three occasions (January 8, 20, and 21, 2021), Petitioner e-mailed Respondent about its deficient supplemental responses, and conducted two telephone conferences with Respondent on January 15 and 22, 2021 on this subject as well. *Id.* at 14-15, ¶¶ 5-6. Between these dates, on January 20, 2021, Respondent also submitted its final supplemental responses. 53 TTABVUE 11, ¶ 3.

In its motion, Petitioner requests a sixty-day extension to conduct discovery “to resolve the parties’ remaining discovery disputes and take depositions that were previously noticed on three occasions.” 52 TTABVUE 2. Specifically, as for the remaining discovery disputes, Petitioner argues that Respondent

insist[s] that [Petitioner] can only access responsive documents by physically searching through its Miami warehouse in the middle of a pandemic, engaging in lengthy delays in producing documents, producing a significant portion of its documents in Spanish following such delays, and inappropriately referring to documents—some of which are in Spanish—in response to interrogatories without an explanation demonstrating significant burden under Fed. R. Civ. P. 33(d).

Id. Petitioner also complains that Respondent “fail[ed] to timely notify [Petitioner] that a previously-noticed [] witness identified in [Respondent’s] Initial Disclosures does not exist,” *id.*, and that Respondent “has not supplemented its initial disclosures to correct this misidentification and designate an alternative witness,” *id.* at 9-10.

Respondent opposes the motion, arguing that Petitioner wishes to “conduct some vague ‘follow-up discovery’ and depose witnesses it has known about since 2018.” 53 TTABVUE 3. For example, with respect to the warehouse inspection issue, Respondent maintains that it never “insisted” Petitioner inspect the warehouse;

rather, Petitioner was first invited to inspect it in Respondent's July 2018 discovery responses. *Id.* at 7. Respondent claims that it was only "during a global pandemic [that] Petitioner first expressed an interest in inspecting the warehouse," and that, notwithstanding the outstanding invitation to inspect, Respondent has already produced nearly 2,500 pages of documents, including photographs of packaging, but "Petitioner apparently doesn't believe [such packaging] exists, [and] simply refuses to inspect the warehouse." *Id.*

Regarding the depositions, Respondent notes that Petitioner has noticed depositions on three occasions, and that, most recently, Petitioner served five notices of depositions to be taken remotely, but, according to Respondent, "Petitioner did not actually intend to take any depositions" because it "did not provide [Respondent] with the required access information to attend the remote depositions." *Id.* at 12, ¶¶ 7-8.

Despite the fact that this proceeding has been pending for over three years, and though it has been suspended a substantial number of times, the delays for the most part are attributed either to the parties' consented motions to suspend pending settlement negotiations or to Board-ordered suspensions arising from the filing of other motions, such as motions for summary judgment, to compel, and to dismiss. In fact, the Board has only once granted an unconsented motion for an extension from Petitioner (31 TTABVUE), which was for a relatively brief period of fifteen days (27 TTABVUE). Given this, the Board does not find that Petitioner has abused the privilege of extensions.³

³ Petitioner also moved for an extension as part of its motions to amend its petition to cancel and for summary judgment (42 TTABVUE), which the Board denied because the motion

The Board also does not find, nor does Respondent allege, that Petitioner engaged in bad faith. Rather, the core of the parties' disagreement is whether Petitioner was negligent, thus requiring an extension to complete its discovery. For example, with respect to the depositions that Petitioner noticed, Petitioner indicates that they "were rescheduled three times on account of settlement discussions, the parties' ongoing meet and confer efforts, and witness unavailability." 52 TTABVUE 9. Even if, as Respondent argues, Petitioner "served [its] notices of deposition all set to occur on the last day of its discovery period as then-set ... and the day prior" "during the last suspension," and regardless if, as Respondent maintains, Petitioner "did not provide [Respondent] with the required access information ... to attend the remote deposition," 53 TTABVUE 7-8, this does not necessarily evince an intent on Petitioner's part to avoid the taking of depositions, especially given that, on multiple occasions, Petitioner appears to have timely noticed the depositions it wished to take.

Additionally, with regards to the dispute surrounding responsive discovery allegedly contained in Respondent's Miami warehouse, Respondent permitted Petitioner to inspect this location back in 2018. 52 TTABVUE 42, ¶ 2. Notwithstanding this and the difficulties the COVID-19 pandemic has posed since then (and continues to pose), Petitioner informed Respondent months ago on January 21, 2021 that Respondent's discovery responses made it "unclear whether [it] has

"contain[ed] very little information upon which the Board could find good cause" (43 TTABVUE 5). Petitioner's second more recent motion for an extension was filed in conjunction with its brief in opposition to Respondent's motion to dismiss (47 TTABVUE), which the Board denied as being "improperly filed while proceedings were suspended pending disposition of Respondent's motion to dismiss" (50 TTABVUE 2).

produced all documents responsive to these requests ..., or whether there are documents remaining in the Miami warehouse and [Respondent] expects [Petitioner] to travel to Miami at the height of the pandemic and sort through boxes.” *Id.* at 28. Thus, at the very least, it is far from clear, and the parties appear to disagree, whether Respondent’s discovery responses are sufficient such that Petitioner’s inspection of Respondent’s Miami warehouse otherwise would be necessary.

Accordingly, after careful consideration of the parties’ submissions, noting the parties’ apparent dispute regarding discovery responses and issues related to depositions, the Board is persuaded that Petitioner has demonstrated the necessary good cause for the extension sought, although barely.⁴ At the very least, Petitioner has attempted, albeit unsuccessfully, to conduct the depositions that it has previously noticed on multiple occasions.

Decision

Accordingly, Petitioner’s motion to extend its discovery deadline and all remaining dates thereafter is **granted** as modified below.

⁴ In light of Petitioner’s warning that, given the pandemic, Petitioner “may require additional extensions of time to inspect [Respondent’s] warehouse” (52 TTABVUE 8, n.4), the Board expects the parties to comply with its revised schedule. The parties are reminded that failure to act diligently during discovery may result in the Board denying any further motions to extend. *See, e.g., Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1851 (TTAB 2000) (applicant’s motion to extend discovery denied when counsel knew of unavailability of witness a month before, yet delayed until last day to seek an agreement on an extension of time); *Luemme Inc.*, 53 USPQ2d at 1760-61 (diligence not shown; discovery requests not served until last day of the discovery period).

Schedule

Proceedings are resumed and dates are reset as follows:⁵

Discovery Closes	October 31, 2021
Plaintiff's Pretrial Disclosures Due	December 15, 2021
Plaintiff's 30-day Trial Period Ends	January 29, 2022
Defendant's Pretrial Disclosures Due	February 13, 2022
Defendant's 30-day Trial Period Ends	March 30, 2022
Plaintiff's Rebuttal Disclosures Due	April 14, 2022
Plaintiff's 15-day Rebuttal Period Ends	May 14, 2022
BRIEFS SHALL BE DUE AS FOLLOWS:	
Plaintiff's Main Brief Due	July 13, 2022
Defendant's Main Brief Due	August 12, 2022
Plaintiff's Reply Brief Due	August 27, 2022

General Information

The Federal Rules of Evidence generally apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at

⁵ When a motion for an extension of the discovery closing date is granted, or the Board orders such an extension, the Board ordinarily will reset the deadline for expert disclosure. However, if the time for serving expert disclosures has passed and it is clear from the record that such expert disclosures have been served or the parties have made it clear that they do not intend to use experts, the Board may not reset the time for expert disclosures. *See* TBMP § 403.04. Inasmuch as the deadline for expert disclosures has passed and neither party has indicated an intent to use experts, the Board does not reset the expert disclosure deadline.

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final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).