ESTTA Tracking number: **ESTTA1091457**

Filing date: **10/27/2020**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92072649
Party	Defendant Columbia Insurance Company
Correspondence Address	DAVID CHEN IP ATTORNEYS GROUP LLC 16 OXFORD ROAD 2ND FLOOR MILFORD, CT 06460 UNITED STATES Primary Email: dchen@ipattorneysgroup.com Secondary Email(s): trademark@ipattorneysgroup.com, tgulick@ipattornrysgroup.com 2032984830
Submission	Opposition/Response to Motion
Filer's Name	David Chen
Filer's email	dchen@ipattorneysgroup.com, trademark@ipattorneysgroup.com, tgulick@ipattorneysgroup.com
Signature	/David Chen/
Date	10/27/2020
Attachments	opp to motion to reopen 201019.pdf(654284 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

AIR SKATE & AIR JUMP CORP.	:	**Cancellation No.: 92072649**
	:	**Registration No.: 3579672**
Petitioner,	:	
v.	:	**Mark:** solo
	:	
COLUMBIA INSURANCE COMPANY	:	
Registrant.	:	

REGISTRANT'S OPPOSITION TO MOTION TO REOPEN DISCOVERY

Registrant, Columbia Insurance Company, by and through its counsel hereby opposes Petitioner's Motion to Reopen Discovery.

In order to reopen a time for taking a required action, the moving party must show that its failure to act is the result of excusable neglect for failing to take the necessary action or timely request an extension of time to do so. See generally, *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997). The four factors in determining excusable neglect are: (1) the danger of prejudice to the non-moving party; (2) the length of the delay and potential impact on judicial proceedings; (3) the reason for the delay and whether the delay was in the reasonable control of the moving party; and (4) whether the movant acted in good faith. *Pioneer Inv. Services Co. v. Brunswick Associates Ltd. Partnership*, 507 U.S. 380, 395 113 S. Ct. 1489, 123 L.Ed.2d 74 (1993).

Factor #1: Prejudice to Columbia Insurance Company

Registrant notes that cases evaluating excusable neglect focus on the second and third factor as the most significant. *Luster Products Inc. v. Van Zandt*, 104 USPQ2d 1877 (TTAB 2012) (citing *Pumpkin Ltd.,* 43 USPQ2d at 1586 n. 7).

Factor # 2: Length of the Delay and its Potential Impact on Judicial Proceedings

The length of the delay and its potential impact on the proceedings is often considered more important than the first (prejudice to the non-moving party) and fourth (whether the movant acted in good faith) factors. *See Pumpkin Ltd.*, 43 USPQ2d 1582.

When evaluating the length of the delay and its potential impact on the judicial proceedings, the Board must also include the time for the Board to consider the pending motion. *The Coffee Studio LLC v. Reign LLC dba Coffee Studio*, 129 USPQ2d 1480, 1483, (TTAB 2019). Petitioner is not seeking to reopen or extend its testimony period but is seeking to reopen its discovery period, which ended on July 9, 2020. Petitioner could have sought to reopen discovery or even extend discovery (prior to July 9, 2020). However, Petitioner waited until the last day of its testimony period to seek relief. Such an extended period has been deemed "not insignificant." *See e.g. JB Livsey Holdings, LLC d/b/a Ranger Technology Solutions v. Wagner*, 2019 WL 1220884 (TTAB Mar. 13, 2019) (finding a motion to reopen the day after pretrial disclosures deadline was not insignificant) and *Old Nutfield Brewing Co. v. Hudson Valley Brewing Co.*, 65 USPQ2d 1701 (TTAB 2002) (seeking to reopen four months after the relevant period closed was significant).

In addition, Petitioner has already admitted that no discovery was taken in this case. This was not a question of a follow up on discovery already propounded but instead (along with its request to open the discovery period for sixty (60) days) is nothing more than an opportunity to simply litigate this matter for the first time filed on the last day of Petitioner's testimony period.

Factor #3: Reason for the Delay and Whether the Delay was in Petitioner's Reasonable Control

Registrant does not contest that the COVID-19 pandemic was not within Petitioner's control. However, the generalizations of its reasons for delay along with its failure to act to reserve its rights are insufficient to meet the excusable neglect standard.

Part of Petitioner's claim for the reason for the delay was that it could not gain access to its place of business and its ability to communicate with counsel was impaired due to the pandemic. 5 TTABVUE 4-5. Petitioner has not explained why communication would have been impaired for nearly seven months during the COVID-19 pandemic. This proceeding commenced well before the start of the COVID-19 pandemic. Further, it would appear that on some level there was communication between Petitioner and its counsel as Petitioner filed a Notice of Opposition in the Trademark Trial and Appeal Board against another U.S. trademark application back on September 1, 2020. See TTABVUE for U.S. Trademark Opposition No. 91264522 at 1 TTABVUE 1.

Part of Petitioner's argument for good cause for its delay was that during the COVID-19 pandemic it was not sure it would survive the economic strain and was

hesitant to incur costs. See 5 TTABVUE 5. Petitioner has cited to no case where such a reason was sufficient to meet the excusable neglect standard. Such an excuse is unlikely to meet the standard for policy reasons. If excusable neglect were to be found every time there was an economic strain and fear of economic costs, there would be many "reopened" periods during the course of an opposition proceeding. Cost saving has not been found to be excusable neglect to warrant the reopening of a trial period. See generally, *Old Nutfield Brewing Co.*, 65 USPQ2d 701.

Factor #4: Whether the Movant Acted in Good Faith

Registrant does not dispute that Petitioner acted in good faith. However, its reasoning of a potential settlement and waiting on informal evidence (to be provided after the close of discovery) is related to the reason for the delay and whether the delay was within Petitioner's control. Delays due to efforts to settle or judicial economy are not excuses for a party not to prosecute the matter or file for extension or suspensions of time. See generally, *id.*

Conclusion

Based on the foregoing, Petitioner has failed to meet its burden to show excusable neglect and its request to reopen the discovery period should be denied. Because Petitioner has failed to provide any testimony during its testimony period, the Petitioner has failed to carry its burden of proof in the cancellation and therefore, the cancellation should be dismissed with prejudice. 37 C.F.R. § 2.132.

Respectfully submitted,

IP ATTORNEYS GROUP, LLC

Dated: October 27, 2020

By: _____

David Chen
16 Oxford Road, 2nd Floor
Milford, CT 06460
Tel: (203) 298-4830
Fax: (203) 298-4832
Attorneys for Registrant
Columbia Insurance Company

CERTIFICATE OF SERVICE

This hereby certifies that the foregoing **REGISTRANT'S OPPOSITION TO MOTION TO REOPEN DISCOVERY** was served via email, this 27th day of October, 2020, addressed to Petitioner's correspondent at the address identified in the USPTO records below:

GREGG A PARADISE

LERNER DAVID LITTENBERG KRUMHOLZ & MENTLIK LLP

20 COMMERCE DRIVE

CRANFORD NJ UNITED STATES , 07016

litigation@lernerdavid.com , gparadise@lernerdavid.com

Thomas P. Gulick
IP ATTORNEYS GROUP, LLC
16 Oxford Road
Milford, CT 06460
Tel: (203) 298-4830
Fax: (203) 298-4832
tgulick@ipattorneysgroup.com
trademark@ipattorneysgroup.com