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**UNITED STATES PATENT AND TRADEMARK OFFICE**
**Trademark Trial and Appeal Board**
**P.O. Box 1451**
**Alexandria, VA 22313-1451**

Skoro

Mailed: May 22, 2008

Opposition No. **91175854**

E. & J. Gallo Winery

v.

Fine Spirits Distribution, LLC

Before Hohein, Zervas and Bergsman,
Administrative Trademark Judges.

This case now comes up on several motions.

Applicant's Motion to Suspend

In response to opposer's motion for summary judgment filed September 19, 2007, applicant filed a motion to suspend the proceedings for two months pending settlement negotiations. Opposer has objected to the suspension, contending that there are no on-going settlement discussions and, even if there were, a settlement offer[1] does not constitute good cause for suspension.

In the alternative, applicant requested a reopening of its time to respond to opposer's motion for summary judgment.[2] Opposer has objected to a reopening, contending applicant has not established excusable neglect to justify a reopening.

[1] Applicant submitted a "limited use agreement" to opposer on November 19, 2007, the day before filing its motion to suspend.

[2] Applicant's response to opposer's motion for summary judgment was due October 15, 2007.

While it is the Board's preference to allow the parties unfettered opportunity to work out a settlement rather than having to monitor and approve subsequent extensions of time, in this case opposer has indicated that the parties are not engaged in settlement negotiations. Further, because any suspension is subject to a request to resume at any time prior to the end of the suspension period, it appears likely that opposer would be filing such a request. Accordingly, applicant's motion to suspend is hereby denied.

Applicant's Request to Reopen

As noted, as an alternative to suspending proceedings, applicant has requested a reopening of its time to respond to opposer's motion for summary judgment and opposer has objected.

As grounds for its request, applicant states that the reason counsel was unable to timely respond to the motion for summary judgment was due to an impending death in his family, email transmission problems with opposer's counsel, and that applicant did not receive opposer's discovery requests.[3] Opposer contends that applicant has not met any of the established grounds considered sufficient to establish excusable neglect.

Pursuant to Fed. R. Civ. P. 6(b)(2), the requisite showing for reopening an expired period is that of excusable neglect. In *Pioneer Investment Services Company v. Brunswick*

[3] Opposer's discovery requests were served on June 22, 2007, and discovery closed on September 14, 2007.

*Associates Limited Partnership,* 507 U.S. 380, 395 (1993), and as discussed by the Board in *Pumpkin, Ltd. v. The Seed Corps,* 43 USPQ2d 1582 (TTAB 1997), the U.S. Supreme Court set forth factors to be considered in determining excusable neglect. Those factors include: (1) the danger of prejudice to the nonmovant; (2) the length of the delay and its potential impact on judicial proceedings; (3) the reason for the delay, including whether it was within the reasonable control of the movant, and (4) whether the movant acted in good faith. In subsequent applications of this test, several courts have stated that the third *Pioneer* factor, namely the reason for the delay and whether it was within the reasonable control of the movant, might be considered the most important factor in a particular case. *See Pumpkin, supra* at n.7.

Accordingly, we turn to the third factor and find that applicant's failure to respond to the motion for summary judgment was caused by its complete failure to act and to monitor the time periods in this proceeding. Such action was wholly within the reasonable control of applicant. While the Board is sympathetic to counsel's personal circumstances, as opposer points out, perhaps there were other members of counsel's firm who could have either stepped in or requested an extension of time. Docketing errors and breakdowns do not constitute excusable neglect. *See Pumpkin, supra,* and cases cited therein.

The statements offered by applicant in support of its request to reopen -- that counsel had communication problems

with opposing counsel[4] -- do not constitute circumstances which meet the excusable neglect standard when, in fact, there is no evidence that counsel actually placed a telephone call to opposer's counsel to try to work matters out. As for applicant's contention that counsel had a personal family crisis, there is no evidence that applicant's counsel took any action to monitor his docket during the illness of his family member. As opposer pointed out, applicant's counsel failed to explain why another member of counsel's firm, who would presumably be aware of counsel's family crisis, did not step in to monitor the time periods.

As to the first factor, applicant contends that there is no prejudice to opposer, but does not indicate why. The Board does not see any evidence of prejudice.

With regard to the second *Pioneer* factor, we find that the delay caused by applicant's failure to respond to the motion for summary judgment or to respond to discovery is significant. While the delay in responding to the motion for summary judgment was only a month after its response was due, applicant did not at that point file a response, but rather seeks further time to suspend or answer the motion, adding to the delay in this matter. The Board's growing docket of active cases, and the resulting, inevitable increase in motion practice before the Board, increasingly strains the Board's

[4] Applicant's counsel first reported communication problem was in October, well after discovery closed and prior to the due date of its response to the motion for summary judgment.

limited resources. Both the Board and parties before it have an interest in minimizing the amount of the Board's time and resources that must be expended on matters, such as the matters decided herein, which come before the Board solely as a result of one party's total failure to monitor its own litigation. The Board's interest in deterring such failure weighs against a finding of excusable neglect under the second *Pioneer* factor.

As for the fourth factor, whether applicant acted in good faith, we find that there is no evidence of bad faith on the part of applicant.

On balance, we find that applicant's failure to timely act in response to the motion for summary judgment was not caused by factors constituting excusable neglect. Accordingly, applicant's request to reopen its time to respond to the motion for summary judgment is hereby denied.

Opposer's Motion for Summary Judgment

We turn now to opposer's motion for summary judgment, filed September 19, 2007. As grounds for the summary judgment motion, opposer states that because applicant has not answered its requests for admission, such requests are deemed admitted, thereby removing any genuine issue of material fact that there is likely to be any confusion between the parties' respective marks and their goods and services. In support of its motion, opposer submitted, *inter alia,* copies of the requests for admission served on applicant stating that they had not been responded to.

If a party on which requests for admission have been served fails to file a timely response thereto, the requests will stand admitted unless the party is able to show that its failure to timely respond was the result of excusable neglect; or unless a motion to withdraw or amend the admissions is filed pursuant to Fed. R. Civ. P. 36(b) and is granted by the Board. Responses to requests for admission must be served within 35 days after the date of service, if served by mail. Fed. R. Civ. P. 36(a) and 37 CFR § 2.120(a).

It is clear that applicant has not answered the requests for admission and has not requested withdrawal or amendment of the admissions. Fed. R. Civ. P. 36(a) provides that a matter is admitted unless a response is timely served or "the [Board] on motion permits withdrawal or amendment of the admission".[5] In that applicant has not responded to opposer's requests for admission, nor filed a motion to withdraw or amend those admissions, those matters are thus "conclusively established". Fed. R. Civ. P. 36(b).

A motion for summary judgment is a pretrial device to dispose of cases in which "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to

[5] The Board may not *sua sponte* withdraw or ignore admissions without a motion to withdraw or amend. *See American Automobile Ass'n (Inc.) v. AAA Legal Clinic of Jefferson Crooke, P.C.*, 930 F.2d 117, 19 USPQ2d 1142, 1144 (5th Cir. 1991). Further, a party may not be relieved of the untimeliness of its response when the reasons for failing to timely respond do not constitute excusable neglect. *See Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064, 2064 n.1 (TTAB 1990).

any material fact and that the moving party is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c). The burden on the moving party is to demonstrate the absence of any genuine issue of material fact by showing "that there is an absence of evidence to support the nonmoving party's case.' *Celotex Corporation v. Catrett,* 477 U.S. 317, 325 (1986). If the moving party meets the initial burden of showing the Board that the basis for the motion is satisfied, the nonmoving party is required to go beyond the pleadings and designate specific facts showing that there is a genuine issue for trial. *Celotex supra* at 324.

In this case, through the declaration of its counsel, Mr. Paul W. Reidl, opposer submitted in support of its motion, *inter alia*, a copy of the requests for admission sent to applicant, photocopies of opposer's registrations and a printout from the USPTO TESS database of applicant's marks.

Applicant is advised that for purposes of summary judgment, an admission of a request for admission will be considered by the Board if a copy of the request for admission and the admission, or a statement that the party from which an admission was requested failed to respond thereto, is submitted. 37 CFR § 2.127(e)(2). Thus, viewing the evidence of record, namely the admissions, and any inferences which may be drawn from the underlying undisputed facts in the light most favorable to applicant, opposer has

established: (1) that the marks[6] as used by the parties, in connection with the identified goods, are similar (R/A 27-29); (2) that the goods sold or to be sold under the marks are related and competitive (alcoholic beverages, namely wine vs. distilled spirits) (R/A 22-24, 26); (3) that the respective goods are both impulse items, sold to consumers at retail and such that consumers will assume they are related (R/A 7, 8, 11, 13, 17, 31-33, 35); and (4) that opposer has priority of use.

On the other hand, applicant has failed to demonstrate that there are genuine issues of material fact and that opposer is not entitled to judgment. *See Olde Tyme Foods Inc. v. Roundy's Inc.,* 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

The Board agrees with opposer that there are no genuine issues of material fact to be determined. As stated by the Supreme Court in *Celotex:*

> The plain language of Rule 56(c) mandates the entry of summary judgment, after adequate time for discovery and upon motion, against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial. In such a situation, there can be 'no genuine issue as to any material fact', since a complete failure of proof concerning an essential element of the nonmoving party's case necessarily renders all other facts immaterial.

[6] Opposer claims ownership of Reg. No. 2942335 for the mark FALCON RIDGE for "alcoholic beverages, namely, wines"; issued April 19, 2005, claiming dates of use of November 1, 2004. Applicant's is seeking to register the mark FALCON for "distilled spirits", filed March 27, 2006 claiming a bona fide intention to use the mark in commerce (Serial No. 78846757).

*Celotex Corp. v. Catrett*, 477 U.S. 317, 322-23 (1986).

In this case opposer has established its standing and priority through the submission of a status and title copy of its pleaded registration. (See Ex. 1 to Reidl Dec.). Further, the admissions establish that the goods are related, the products move in the same channels of trade and that they are bought by the same class of purchasers.

Accordingly, opposer's motion for summary judgment is hereby granted. See Trademark Rule 2.127(a) and Fed. R. Civ. P. 56.

Judgment is hereby entered against applicant, the opposition is sustained, and registration to applicant is refused.