

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

MBA

Mailed: October 21, 2010

Opposition No. 91183905

Google, Inc.

v.

Eric Watson

**Before Walters, Grendel and Bergsman, Administrative  
Trademark Judges**

**By the Board:**

This case now comes up for consideration of opposer's motion, filed February 26, 2010, for judgment as a sanction for applicant's alleged failure to comply with the Board's order of December 30, 2009 (the "Prior Order"). The motion is fully briefed.

Background and Undisputed Facts

Applicant seeks registration of GOOTUBE.COM, in standard characters, for "Hosting of digital content on the internet, namely, hosting of digital media content for infants, children, and the parents of small children."<sup>1</sup> In its amended notice of opposition, opposer alleges prior use and ownership of a pending application for registration of

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<sup>1</sup> Application Serial No. 77020099, filed October 12, 2006, based on an intent to use the mark in commerce.

YOUTUBE and a variation thereof for an online video service and related products and services,<sup>2</sup> and prior use and registration of GOOGLE for an Internet search engine and other Internet-related services,<sup>3</sup> and that use of applicant's mark is likely to cause confusion with opposer's marks. Opposer specifically alleges that three days before applicant filed the involved application, "Opposer Google Inc. announced it would acquire YouTube," and "it was common in the press and other media to refer to Opposer as GooTube, a combination of the GOOGLE and YOUTUBE marks." In its answer, applicant admits that opposer has priority with respect to its GOOGLE and YOUTUBE marks, but otherwise denies the salient allegations in the amended notice of opposition.

On September 23, 2009, opposer served interrogatories, requests for production and requests for admission, but applicant failed to respond thereto, leading to opposer's motion to compel, which the Board granted in the Prior Order. Pursuant to the Prior Order, applicant was allowed thirty days to serve responses to opposer's interrogatories and document requests, without objection on the merits. Applicant did not respond to opposer's discovery requests in

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<sup>2</sup> Application Serial Nos. 78802261 and 78802278, both filed January 30, 2006.

<sup>3</sup> Registration Nos. 2806075, 2884502 and 3140793, issued January 20, 2004, September 14, 2004 and September 12, 2006, respectively.

any manner, however, within the time provided in the Prior Order or thereafter.

After opposer filed its motion for sanctions, applicant's former attorney filed a motion to withdraw as applicant's counsel, which the Board granted. Applicant then filed a letter with the Board on April 23, 2010, indicating that applicant would represent himself going forward ("Applicant's Letter"). In addition, Applicant's Letter includes explanations for applicant's failure to respond to opposer's discovery requests or comply with the Prior Order. Among other things, Applicant's Letter indicates that personal and family issues prevented him from responding to the discovery requests, but "[g]iven some time, I can certainly provide answers to the interrogatories ... As well, I should be allowed the opportunity to ask questions and get discovery regarding the motives and business dealings of the Opposer in this case."

Opposer's Motion and Applicant's Response

Opposer requests sanctions because applicant "failed to serve upon Opposer any responses to Opposer's Discovery Requests by the Board-imposed deadline, and has yet to serve upon Opposer any responses." Moreover, "Applicant has not had any communications of any kind with Opposer or the Board for almost 3 months." Opposer argues that the ultimate sanction of judgment is appropriate because "[t]o the extent

Applicant has even engaged in this matter, it has been for the purpose of delaying progress."

In his response, applicant focuses primarily on refuting opposer's allegations about applicant's alleged improper intent. He also incorporates by reference and repeats some the claims made in Applicant's Letter and alleges that opposer is "maliciously trying to misrepresent Applicant's character and intentions to the Board." With respect to his failure to comply with the Prior Order, the only issue before us, applicant states:

There has been no willful noncompliance and there should certainly not be a judgment for the Opposer in "furtherance of efficiencies." Sanctions are not warranted because there is no evidence of bad faith whatsoever by Applicant, and Applicant's failure to comply is due to both extenuating circumstances and the Opposer's unwillingness to negotiate in good faith. On the other hand, the Opposer's obvious procedural advantage and attempts to grossly mislead the Board as to the nature of Applicant's trademark intentions should warrant that the Applicant receive some degree of leniency, or that the Opposition be terminated.

However, applicant does not explain why he did not seek an extension of time to comply with the Prior Order.

In its reply brief, opposer points out that applicant "fails to explicitly agree to furnish the requested discovery responses ... and fails to explain why Applicant

ignored a Board order compelling discovery, despite being represented by counsel."

Decision

"If a party fails to comply with an order of the [Board] relating to discovery ... the Board may make any appropriate order, including any of the orders provided in Rule 37(b)(2) of the Federal Rules of Civil Procedure ..."  
Trademark Rule 2.120(g)(1); see also, M.C.I. Foods Inc. v. Bunte, 86 USPQ2d 1044, 1047 (TTAB 2008); HighBeam Marketing, LLC v. Highbeam Research, LLC, 85 USPQ2d 1902, 1904 (TTAB 2008). Potential sanctions include entering judgment against the disobedient party. HighBeam Marketing, 85 USPQ2d at 1904.

In this case, it is clear that applicant violated the Prior Order by failing to respond in any manner to opposer's interrogatories or document requests, even after being required to do so by the Prior Order. Furthermore, applicant, who was represented by counsel at the time, did not even request an extension of time in which to comply with the Prior Order.<sup>4</sup> Therefore, applicant's excuse that he is currently unrepresented rings hollow.

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<sup>4</sup> "[I]t is well settled that the client and the attorney share a duty to remain diligent in prosecuting or defending the client's case; that communication between the client and attorney is a two-way affair; and that action, inaction or even neglect by the client's chosen attorney will not excuse the inattention of the client so as to yield the client another day in court." CTRL

While there is no evidence that applicant's failure to comply with the Prior Order was in bad faith, or that he filed the involved application with an improper intent, that is not particularly relevant. The point is that applicant failed to comply with the Prior Order, request an extension of time in which to do so, or at least contact opposer to explain why he could not provide timely responses. In addition, applicant's initial failure to respond to opposer's discovery requests or opposer's motion to compel, even when represented by counsel, and its current failure to agree to finally comply with the Prior Order by a date certain, leave use with no expectation that anything is likely to change. Therefore, judgment is warranted.

Accordingly, opposer's motion for the sanction of judgment is hereby **GRANTED**. See e.g., Fed. R. Civ. P. 37(b)(2); Trademark Rule 2.120(g)(1); MHW Ltd. v. Simex, Aussenhandelsgesellschaft Savelsberg KG, 59 USPQ21d 1477 (TTAB 2000). Judgment is hereby entered against applicant, the opposition is sustained and registration to applicant is refused.

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Systems Inc. v. Ultraphonics of North America, 52 USPQ2d 1300, 1302 (TTAB 1999).