

THIS DISPOSITION
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OF THE TTAB

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

WINTER

Mailed: October 6, 2009

Opposition No. 91185103

Cherokee Nation, a Federally
Recognized Indian Tribe

v.

Tiffany Adams

Before Seeherman, Grendel, and Rogers,
Administrative Trademark Judges.

By the Board:

This case now comes up for consideration of opposer's motion (filed March 16, 2009) for summary judgment on its claims of likelihood of confusion, false suggestion of a connection and disparagement¹; applicant's combined motion (filed May 11, 2009) to strike the summary judgment motion and for sanctions; and opposer's motion (filed June 15, 2009) to strike a supplemental declaration submitted by applicant. The motions are fully briefed.

Preliminary Matter

Before discussing the subject motions, we are compelled to address the parties' conduct, specifically, both parties' failure to abide by several Trademark Rules applicable to

¹ In the notice of opposition, opposer also asserts claims of dilution by tarnishment and by blurring.

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this proceeding. Both parties are admonished for their mutual failure to conduct a discovery conference. Further, each party is admonished for failing to timely serve on the other party initial or expert disclosures. Adherence to the rules governing conferencing and disclosures is not discretionary. "The discovery conference *shall occur no later than the opening of the discovery period ...*" Trademark Rule 2.120(a)(2), 37 C.F.R. § 2.120(a)(2) (emphasis in italics). See also, in regard to the shared obligation of the parties to arrange and conduct their discovery conference, *Influence Inc. v. Zuker*, 88 USPQ2d 1859, 1860 n.2 (TTAB 2008) and *Guthy-Renker Corp. v. Boyd*, 88 USPQ2d 1701 (TTAB 2008). Further, the parties may modify disclosure deadlines and obligations only upon "written stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board." *Id.* See *Boston Red Sox Baseball Club Limited Partnership v. Harry F. Chaveriat III*, 87 USPQ2d 1767 (TTAB 2008) (Board approved parties' "Notice of Waiver of Initial Disclosures"). The Board will not presume, merely because both parties failed to make required disclosures when due, that the parties implicitly have agreed to waive the obligation to make such disclosures.

Here, the parties have never submitted a written stipulation or a motion requesting that the initial and expert disclosure deadlines, both of which fall during

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discovery and passed unheeded by the parties, be changed, or that the Board allow them to waive their disclosure obligations. Further, opposer has, in our view, flouted the Trademark Rules by serving its initial disclosures on applicant both five months late and on the same date that it served the subject motion for summary judgment and that it served its discovery requests.² Opposer errs in its treatment of initial disclosures solely as a technical prerequisite for the filing of its motion for summary judgment and discovery requests. Such treatment of its disclosure obligation fails to comply with both the plain wording of Trademark Rule 2.127(e)(1) and with the purposes of the revised Trademark Rules. *See generally* "Miscellaneous Changes to Trademark Trial and Appeal Board Rules," 72 Fed. Reg. 42242, 42246 (Aug. 1, 2007) (hereinafter "Amended Rules Notice").

Trademark Rule 2.127(e)(1) requires that, except for specified circumstances not applicable here, a party may not file a motion for summary judgment until the party has made its initial disclosures. The purpose of these disclosures are, *inter alia*, to facilitate communication between the

²Opposer's service of discovery requests on applicant on the last day of the discovery period seems inconsistent with the filing of its motion for summary judgment, which presumably indicates that opposer believed it had the evidence it required to show an absence of a genuine issue of material fact, or at least that there was no need to develop evidence to prove facts in this case.

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parties and to "prompt routine disclosure of names of potential witnesses and basic information about documents and things that a party may use to support a claim or defense," so that the parties may plan and effectuate more efficient discovery. See "Amended Rules Notice," 72 Fed. Reg. at 42246. Thus, the Board, in issuing the trial schedule in any proceeding, presumes that a period of time exists between the service of initial disclosures and the filing of any motion for summary judgment so that each adverse party may consider the other party's disclosures. Opposer's actions circumvented the rules and its argument that it timely served its initial disclosures involves a perverse interpretation of applicable rules.

We similarly find applicant's objections to opposer's untimely disclosures, and her motion for sanctions based on the timing of such disclosures, both of which essentially assert that opposer has failed to follow the rules, as entirely disingenuous, given that applicant also failed to follow the rules. Each party is obligated to comply with the disclosure requirements, notwithstanding the fact that the adverse party may have failed to discharge its own obligations. See Fed. R. Civ. P. 26(a)(1)(A); and Trademark Rule 2.116, 37 C.F.R. § 2.116(a). Cf. *Miss America Pageant v. Petite Productions Inc.*, 17 USPQ2d 1067, 1070 (TTAB 1990) ("a party is not relieved of its discovery obligations in

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spite of the fact that its adverse party has wrongfully failed to fulfill its own obligations"); and *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626, 633 (TTAB 1986). Further, applicant did not file a motion to compel opposer's initial disclosures pursuant to Trademark Rule 2.120(e). An order compelling service of initial disclosures is a prerequisite to the imposition of sanctions, thus, applicant's motion for sanctions is improper. See Trademark Rule 2.120(g)(1), 37 C.F.R. § 2.120(g)(1).

We find also that, to the extent that applicant's discussion of Federal Rule 56(f) discovery at the end of her motion to strike could be construed as a motion for additional discovery under Rule 56(f), said motion is similarly not well taken, as well as untimely.³ By failing to serve her initial disclosures, applicant could not (and correctly did not) serve any discovery requests during the discovery period; thus, there is little merit in her arguments that "Opposer's improper actions effectively deprived Applicant of the ability to take discovery

³ Applicant's motion, including the statements regarding Federal Rule 56(f), was filed on May 11, 2009, more than thirty days after the filing of the subject motion for summary judgment. A motion under Rule 56(f) must be filed within thirty days from the date of service of the summary judgment motion. "The time for filing a motion under Rule 56(f) will not be extended." Trademark Rule 2.127(e)(1), 37 C.F.R. § 2.127(e)(1). The parties' stipulation to extend the time for applicant to respond to opposer's motion for summary judgment did not effect an extension of time to seek discovery under Federal Rule 56(f); moreover, parties cannot by their own agreement modify the rule prohibiting any extension of time to seek Rule 56(f) discovery.

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depositions" and "Applicant's lack of prior access to [facts essential to justify its opposition to the summary judgment motion] is the specific and direct result of Opposer's manifest bad faith" (motion to strike, p. 5). Applicant's own inaction resulted in her inability to take discovery.⁴

In view of the foregoing and our disposition of opposer's motion for summary judgment (see *infra*), both parties are warned that they must adhere to the Trademark Rules and that their lax approaches to their respective obligations under the rules may be considered as an aggravating factor in reviewing any possible motion for sanctions that may later arise in this proceeding. Further, inasmuch as we have determined that there exist genuine issues of material fact in regard to opposer's claims, the parties' respective motions filed in connection with the briefing of the motion for summary judgment are moot and will not be given any further consideration. We briefly consider only the motion for summary judgment and the ultimate response thereto on the merits, to explain why genuine issues of fact exist dictating that the motion be denied and that the parties proceed to trial.

⁴ Moreover, opposer's motion for summary judgment was filed on the last day of the discovery period, and was not received by applicant until after discovery had closed. Thus, applicant's time for taking discovery had passed before she was aware of opposer's motion for summary judgment; as a result, the filing of the motion for summary judgment did not deprive applicant of the opportunity to take discovery, applicant's failure to timely take discovery did.

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Motion for Summary Judgment

Opposer seeks summary judgment on its claims of likelihood of confusion, false suggestion of a connection and disparagement. Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). Additionally, the evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1993). Further, the Board may only ascertain whether issues of material fact are present, and may not resolve factual issues on a motion for summary judgment, or even on cross-motions for summary judgment. *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); and *Opryland USA, supra*.

Based on our review of the parties' arguments and supporting papers,⁵ we find that opposer, as the party moving

⁵ The parties should note that evidence submitted in support of or in opposition to a motion for summary judgment is of record only for consideration of that motion. Any such evidence to be

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for summary judgment, has not met its burden of establishing that no genuine issues of material fact exist and that it is entitled to judgment as a matter of law on its claims of likelihood of confusion, false suggestion of a connection and disparagement. At a minimum, with regard to the likelihood of confusion claim, there exists a genuine issue of material fact as to opposer's priority of use of the terms CHEROKEE and CHEROKEE NATION as trade names or trademarks, rather than merely as the given name for opposer. Specifically, the exhibits attached to opposer's motion, including the declarations⁶ provided in support of its exhibits, do not provide a date indicating that opposer's common law use of its asserted marks for any goods or services precedes applicant's asserted date of first use.⁷ See Trademark Act Sections 2(d) and 45, 15 U.S.C. §§ 1052 and 1127; *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996), *vacating*, *Pactel Teletrac v. T.A.B.*

considered at final hearing must be properly introduced in evidence during the appropriate trial period. See, e.g., *Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993). See TBMP § 528.05(a) (2d ed. rev. 2004).

⁶ It should be noted that while the declarations of opposer's counsel submitted in support of opposer's exhibits sufficiently attest to the authenticity of those exhibits, e.g., web pages from opposer's website, the declarations are insufficient to demonstrate the truth of the statements made in those exhibits. See Fed. R. Evid. 801(c). See also, *Boyd's Collection Ltd v. Herrington & Company*, 65 USPQ2d 2017, 2020 n.10 (TTAB 2003).

⁷ Applicant asserts that she has used the mark identified in the application since at least as early as August 2002. See declaration of Tiffany Adams (opposition to motion for summary judgment).

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Systems, 32 USPQ2d 1668 (TTAB 1994). In view thereof, summary judgment on the claim of likelihood of confusion is inappropriate at this juncture.

Likewise, in connection with opposer's false suggestion of a connection claim, in view of applicant's submissions showing third-party use of the mark CHEROKEE, there exists a genuine issue of material fact as to whether the word CHEROKEE points uniquely and unmistakably to opposer such that when applicant uses the CHEROKEE mark in connection with her services, a connection with opposer would be presumed. *See The University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985).

Nor has opposer shown an absence of a genuine issue of a material fact regarding its claim of disparagement. We note, in particular, that the declarations of the three Cherokee Nation members do not state that the declarants discussed with other members applicant's use of CHEROKEE in connection with the adult entertainment services identified in applicant's application; thus, we find that the declarants speak for themselves individually, and do not represent a substantial composite of the Cherokee population. *See Harjo v. Pro-Football Inc.*, 50 USPQ2d 1705 (TTAB 1999), *rev'd on*

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other grounds, 284 F.Supp.2d 96, 68 USPQ2d 1225 (D.D.C. 2003), *remanded*, 415 F.3d 44, 75 USPQ2d 1525 (D.C. Cir. 2005) ("*Harjo I*").

Accordingly, opposer's motion for summary judgment is denied.⁸

Proceeding Resumed; Trial Dates Reset

This proceeding is resumed. The discovery period is closed. Trial dates are reset as follows:

Plaintiff's Pretrial Disclosures	11/20/2009
Plaintiff's 30-day Trial Period	
Ends	1/4/2010
Defendant's Pretrial Disclosures	1/19/2010
Defendant's 30-day Trial Period	
Ends	3/5/2010
Plaintiff's Rebuttal Disclosures	3/20/2010
Plaintiff's 15-day Rebuttal Period	
Ends	4/19/2010

IN EACH INSTANCE, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party **WITHIN THIRTY DAYS** after completion of the taking of testimony. See Trademark Rule 2.125, 37 C.F.R. § 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b), 37 C.F.R. §§ 2.128(a) and (b). An

⁸ Although we have mentioned only three genuine issues of material fact, we do not state that these are the only issues of material fact in dispute and, therefore, the only issues of fact to be focused on at trial. Rather, each party has the burden of proving, at trial, all facts alleged to support its position.

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oral hearing will be set only upon request filed as provided
by Trademark Rule 2.129, 37 C.F.R. § 2.129.

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