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

Proceeding	91185310
Party	Plaintiff BIG O TIRES, LLC
Correspondence Address	Marsha G. Gentner Jacobson Holman PLLC 400 - 7th Street, N.W. Washington, DC 20004 UNITED STATES lweiss@jhip.com, mgentner@jhip.com
Submission	Motion for Sanctions
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Signature	/Leesa N. Weiss/
Date	03/01/2010
Attachments	Motion for Sanctions - Opp. No. 91185310.pdf ( 8 pages )(413139 bytes )

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

BIG O TIRES, LLC )  
 )  
 Opposer, )  
 )  
 v. ) Opposition No. 91185310  
 )  
 WEEMS INDUSTRIES,, INC. )  
 )  
 Applicant. )

**OPPOSER’S MOTION FOR SANCTIONS**

Opposer, Big O Tires, LLC, hereby moves the Board for an Order imposing sanctions against Applicant pursuant to F.R.Civ.P. 37(b)(2), and 37 C.F.R. § 2.120(g)(2). As set forth and described, below, Applicant’s attorney of record has advised that Applicant’s initial disclosures in this proceeding would not be provided. Accordingly, Opposer requests the Board to render a default judgment against Applicant, pursuant to F.R.Civ.P. 37(b)(2)(A)(vi).

**Background**

On July 16, 2008, Opposer timely filed a Notice of Opposition<sup>1</sup> to application Serial No. 77109547. In its Order dated July 21, 2008, the Board formally instituted this proceeding. Until recently, the parties were engaged in settlement discussions, during which time, by mutual consent, all proceedings in this opposition were suspended. Although Opposer believed the parties had reached an agreement, in principle, on January 19, 2010, Applicant conclusively advised that settlement would not proceed on these terms.

On December 18, 2009, the parties held their Initial Discovery Conference. By previous consented motions and the Board’s January 26, 2010 Order, the parties were to serve

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<sup>1</sup>Big O opposed registration of Applicant’s mark in Classes 7, 9 and 21.

their Initial Disclosures by February 23, 2010. However, on February 22, 2010, Applicant's counsel expressly stated in writing that Applicant would not be serving the required Initial Disclosures. *See* attached copy of the February 22, 2010 e-mail from Applicant's counsel ("we do not intend to file an initial disclosure in the proceeding").

On February 23, 2010, Opposer's counsel served Opposer's Initial Disclosures. No initial disclosure has been received from Applicant's counsel.

### Argument

Rule 26(a)(1) of the Federal Rules of Civil Procedure outline the initial disclosures required in a civil proceeding governed by the Rules. *See also* 37 C.F.R.

§ 2.120(a)(1). Rule 2.120(g)(2) of the Trademark Rules of Practice, provides in terms that are patently clear:

If a party fails to make required initial disclosures or expert testimony disclosure, and such party or the party's attorney or other authorized representative informs the party or parties entitled to receive disclosures that required disclosures will not be made, the Board may make an appropriate order, as specified in paragraph (g)(1) of this section.

The sanctions provided for in Rule 2.120(g)(1) include those "provided in Rule 37(b)(2) of the Federal Rules of Civil Procedure". Rule 37(b)(2)(A)(vi) of the Federal Rules of Civil Procedure provides for the sanction of "rendering a default judgment against the disobedient party."

This proceeding is not one where Applicant's initial disclosures were served late, or were incomplete. *See Influence, Inc. v. Elaina Zuker*, 88 U.S.P.Q.2d 1859 (T.T.A.B. 2008) (Respondent served her initial disclosures late, and such disclosures were found to be inadequate). Rather, Applicant's counsel *affirmatively* has stated to Opposer's counsel that "we

*do not intent to file* an initial disclosure in the proceeding.” [Emphasis added] *Kairos Institute of Sound Healing, LLC v. Doolittle Gardens, LLC*, 88 U.S.P.Q.2d 1541 (2008):

the sanctions provided for under Trademark Rule 2.120(g)(2) may be ordered even in the absence of a prior Board order affirming or reiterating the party’s obligation to make disclosures, but require that the party bearing the obligation affirmatively state that disclosures will not be forthcoming.

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. . . It is clear that the obligation of parties to make initial disclosures is integral to the efficient conduct of Board proceedings and not an obligation to be taken lightly by the parties.

As evidenced in the attached February 22, 2010 e-mail from Applicant’s counsel, this is precisely the case in the present proceeding.

Under these circumstances, the Board, unquestionably, has the authority to enter sanctions now sought by Opposer under Trademark Rule 2.120(g)(2). *HighBeam Marketing, LLC v. Highbeam Research, LLC*, 85 U.S.P.Q.2d 1902(T.T.A.B. 2008). If there was any doubt as to Applicant’s intentions *vis-a-vis* this proceeding, its Motion – filed just days prior to the deadline for serving its Initial Disclosures – effectively seeking to abandon, without Opposer’s consent, certain of the goods which were the subject of two of the three classes in the opposed application, clearly demonstrates Applicant’s intention to withdraw from its participation in this proceeding. However, the Trademark Rules do not permit a party to so refrain without suffering the consequences, and the Board should not permit Applicant herein to do otherwise.

**Conclusion**

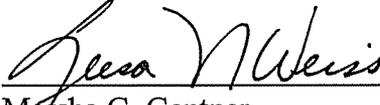
In view of the foregoing, it is respectfully submitted that the only appropriate remedy for Applicant's explicit rejection of its obligation under the Trademark Rules to serve its Initial Disclosures is to sustain this opposition by issuing a default judgment against Applicant.

Accordingly, and inasmuch as this Motion is potentially dispositive of the Opposition, Opposer assumes that proceedings herein will be suspended pending the Board's decision. However, to the extent the proceedings herein are not automatically suspended, Opposer respectfully requests the Board to suspend these proceedings pending its decision on Opposer's Motion for Sanctions. *See* 37 C.F.R. § 2.117.

Respectfully submitted,

BIG O TIRES, LLC

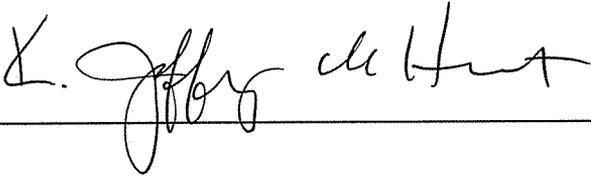
Dated: March 1, 2010

By:   
\_\_\_\_\_  
Marsha G. Gentner  
Leesa N. Weiss  
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[Lweiss@jhip.com](mailto:Lweiss@jhip.com)

**Certificate of Service**

I hereby certify that on this 1<sup>st</sup> day of March, 2010, the foregoing Motion for Sanctions was served on Applicant, by mailing same first class and postage prepaid, on the following attorney of record and correspondent:

Brian J. Laurenzo  
Dorsey & Whitney LLP  
801 Grand Avenue  
Suite 3900  
Des Moines, Iowa 50309

  
\_\_\_\_\_

**Leesa Weiss**

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**From:** [Laurenzo.Brian@dorsey.com](mailto:Laurenzo.Brian@dorsey.com)  
**Sent:** Monday, February 22, 2010 12:43 PM  
**To:** Leesa Weiss  
**Cc:** [McFadden.Carole@dorsey.com](mailto:McFadden.Carole@dorsey.com)  
**Subject:** RE: Big O Tire, LLC v Weems Industries, Inc. dba Legacy Manufacturing Company (475451-81)  
[Leesa,](#)

We do not need any further extensions as we do not intend to file an initial disclosure in the proceeding. That being said, we are not expressly abandoning our application in lieu of the motions we filed last week. If you need to extend the deadlines up to 30 days for your own purposes, we will not object but you will need to file them yourself.

Very truly yours,

Brian

This e-mail message was sent by:

Brian J. Laurenzo  
Patent Attorney  
Dorsey & Whitney LLP  
801 Grand Avenue, Suite 3900  
Des Moines, Iowa 50309  
Telephone: (515) 699-3286  
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**From:** Leesa Weiss [<mailto:lweiss@jhip.com>]  
**Sent:** Friday, February 19, 2010 1:13 PM  
**To:** Laurenzo, Brian  
**Cc:** McFadden, Carole  
**Subject:** RE: Big O Tire, LLC v Weems Industries, Inc. dba Legacy Manufacturing Company (475451-81)  
**Importance:** High

Brian,

We are in receipt of your secretary's e-mail, forwarding the two Motions which you filed today.

2/22/2010

In the meantime, we continue to have a **February 23, 2010** deadline for initial disclosures by the parties, as well as the other extended dates set forth in our Consented Motion to Extend, filed last month. These dates will, again, all need to be extended.

Please confirm: (1) that you will agree to such an extension of time for all of the dates and, if so, the amount of time for such extension; and (2) that you will prepare and file the stipulated/consented request for such an extension.

Very truly yours,

Leesa N. Weiss  
Senior Attorney  
Jacobson Holman PLLC  
400 Seventh Street, N.W.  
Sixth Floor  
Washington, D.C. 20004  
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202.393.5350 (fax)

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**From:** McFadden.Carole@dorsey.com [mailto:McFadden.Carole@dorsey.com]  
**Sent:** Friday, February 19, 2010 11:54 AM  
**To:** Marsha Gentner; Leesa Weiss  
**Cc:** Lorenzo.Brian@dorsey.com  
**Subject:** Big O Tire, LLC v Weems Industries, Inc. dba Legacy Manufacturing Company (475451-81)

Sent on behalf of Brian Lorenzo.

The attached Defendant's Motion to Divide Application and Defendant's Motion to Amend Application Without Consent were filed with the Trademark Trial and Appeal Board on February 19, 2010.

Very truly yours,

Brian J. Lorenzo

<<Motion to Divide Application .PDF>> <<Motion to Amend Application wo Consent.PDF>>

**Carole D. McFadden**  
Legal Secretary to Brian Lorenzo, Jason Hunt  
and Eli Swanson

.....  
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*Thank you.*