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

Proceeding	91187460
Party	Plaintiff Tyler Perry
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Tyler Perry Opposer, v. Edith M Jebbinson and Novella S. Brown Applicants	Opposition No. 91187460 Application Serial No. 77/286,291 Mark: MADEA'S SECRETS Published for Opposition: July 15, 2008

OPPOSER'S MOTION FOR SANCTIONS UNDER TBMP RULE 527.03 AND 37 C.F.R. §2.120(g)(1)

Commissioner for Trademarks
PO Box 1451
Alexandria, VA 22313-1451

Opposer Tyler Perry ("Perry") hereby brings this Motion for Sanctions against Applicants, Edith M. Jebbinson and Novella S. Brown (collectively, "Applicants") for Applicants' failure to meet their obligation to timely schedule and conduct the discovery conference pursuant to Rule 26(f).

Pursuant to 37 C.F.R. §2.120(g)(1), the parties are required to participate in a discovery conference at the outset of discovery (pursuant to Fed. R. Civ. P. 26(f). Opposer sent email messages to Applicant at the email address Applicant provided as part of its correspondence information in the instant Opposition, on March 11, March 18, March 24 and

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March 31, 2009, soliciting Applicant's participation in the discovery conference with the following words:

> There is an upcoming deadline of April 8, 2009 before which we are to have a Discovery Conference and discuss this matter and whether there is any potential for amicable settlement. Please let me know your availability in the upcoming weeks leading up to the 8th, and a number at which you may be reached so that we may set up a date and time for the teleconference.

On May 11, 2009, Opposer filed a motion to extend the deadline for holding the Discovery Conference, and concurrently served a copy on Applicants via First Class Mail (a copy of the Certificate of Mailing was inadvertently not included with the filing at the TTAB). The Motion was denied on May 27, 2009, at which time the Board invited Opposer to move for sanctions as sought herein.

Although Applicants have ostensibly received all of the foregoing correspondence in this Opposition, none having been returned as undeliverable by electronic means or the United States Postal Service, Applicants have not responded to Opposer's repeated entreaties to schedule and hold the Discovery Conference as required, raising thereby the prospect that Applicants are not in good faith.

The rules provide for the imposition of sanctions. 37 C.F.R. §2.120(g). Specifically, 37 C.F.R. §2.120(g)(1) calls for the imposition of sanctions pursuant to those available under Fed. R. Civ. P. 37(b)(2), including "dismissing the action or proceeding or any part thereof, or rendering a judgment by default against a disobedient party." Fed. R. Civ. P. 37(b)(2)(C).

Generally, the determination and imposition of an appropriate sanction is a fact-specific inquiry. Ehrenhaus v. Reynolds, 965 F.2d 916, 920 (10th Cir. 1992). Dismissal of a party's case is appropriate in instances of willful misconduct. Id.; Meade v. Grubbs, 841 F.2d 1512, 1520-21 (10th Cir. 1988). This is the case in the instant Opposition.

Alternatively, the Board may, on its own inherent authority, enter judgment adverse to a party that has lost interest in its case. TBMP §527.03. If the Applicants' failure to respond to Opposer's repeated requests does not rise to the level of willful misconduct, it surely

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demonstrates a loss of interest by Applicants in their application which is the subject of the instant Opposition.

In Ehrenhaus, the Court directed trial courts to consider a number of factors prior to choosing dismissal as an appropriate sanction, including (1) the degree of actual prejudice to the opposing party; (2) the amount of interference with the judicial process; (3) the culpability of the litigant; and (4) the efficacy of lesser sanctions. 965 F.2d at 921. Opposer discusses each of these factors in turn:

1. Actual Prejudice to Opposer.

Applicants have not agreed to schedule, much less participate in, the required Rule 26(f) Discovery Conference. According to Fed.R.Civ.P. 26(d)(1):

> A party may not seek discovery from any source before the parties have conferred as required by Rule 26(f), except in a proceeding exempted from initial disclosure under Rule 26(a)(1)(B), or when authorized by these rules, by stipulation, or by court order.

As a result, Opposer is unable to proceed with discovery in its case. Moreover, Applicants have sent no initial disclosures. This failure causes prejudice to Opposer.

Opposer is left to guess as to what evidence, if any, Applicants have to support their contentions. Opposer is unable to formulate an adequate discovery plan because it has no way of determining the nature and scope of Applicants' evidence, including written materials, which, if any, individuals Applicants intend to use to support their claims, and what witnesses they intend to call. Opposer is left to speculate about Applicants' contentions. In addition to the prejudice caused by this failure, Opposer suffers prejudice caused by expense and delay.

Because Applicants have not cooperated in scheduling and conducting the Discovery Conference, Opposer has been and will continue to be forced to spend more time and money in pursuit of discovery (including the preparation of the instant Motion), which runs counter to the intention of the Board's new rules. Moreover, should Opposer proceed with service of discovery requests on Applicants in the absence of a Discovery Conference, Opposer would be subject to the substantial risk that the Applicants could later cite the non-occurrence of the Discovery Conference as a basis to dismiss the Opposition on procedural grounds. Applicants' non-compliance is prolonging this litigation and increasing its cost without

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justification. Additional steps are now required to ascertain the state of discovery – and the Opposition itself – while a cloud of uncertainty hangs over Opposer's head.

The Board should determine that Opposer has been prejudiced by Applicants' failures and enter judgment in favor of Opposer in this action.

2. Interference with the Judicial Process.

The failure to schedule and participate in the Rule 26(f) Discovery Conference halts and stymies the rest of the Opposition proceeding and interferes with the judicial process.

Nothing further can be accomplished in this case. It cannot be moved forward into discovery, much less toward a meaningful disposition other than the relief prayed for in the instant Motion, without first there being a Discovery Conference. Applicants have willfully thwarted the Board's attempt to clearly delineate an orderly process through its scheduling order, and have repeatedly, willfully ignored Opposer's attempts to abide by the schedule calendared by the Board so that the opposition proceeding could move forward. The Board should thus determine that Applicants' acts (or failure to act) significantly interfere with the judicial process. Accordingly, the Board should enter judgment in favor of Opposer in this proceeding.

3. Culpability of Applicants.

Applicants are fully culpable in their failure to follow the rules for the Discovery Conference and making initial disclosures. The form and substance of Applicants' Answer and Affirmative Defenses indicate operational familiarity with the Trademark Office and Board rules, rendering a plea of ignorance thereof by Applicants inoperative. Moreover, even if the Applicants claim not to have received any electronic correspondence from the Opposer, the calendar was laid out by the Board on several occasions via mail, including as late as the May 27, 2009 Board decision on Opposer's Motion to Extend, which in addition to Opposer's several reminders, constitutes yet another reminder to Applicants of their obligation under the rules. Not only have Applicants shirked their responsibility, they have also sought to circumvent the rules by holding up Opposer's discovery, effectively preventing Opposer from collecting evidence necessary to prepare and present its case, knowing that Opposer bears the burden in the instant proceeding. It is clear that Applicants are gaming the system, for which the appropriate sanction is an entry of judgment against them. The culpability is plain and the Board should thus enter judgment in favor of Opposer.

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4. Efficacy of Lesser Sanctions.

Applicants have not responded to repeated entreaties to engage in discussion concerning discovery in the instant proceeding, nor have they responded to invitations to discuss the potential for amicable settlement thereof, including efforts by Opposer to amicably resolve the dispute before initiating the instant Opposition proceeding. Further, Applicants have not served (timely or otherwise) initial disclosures, even after having been served Opposer's initial disclosures. Applicants' clear disregard of their responsibilities under the rules, and their silence in response to the numerous requests to schedule and initiate the Discovery Conference and discuss the case indicate a loss of interest in their case, and by extension in their application that is the subject of the instant proceeding. Given the foregoing, the appropriate sanction is entry of judgment against Applicants.

WHEREFORE, Opposer prays that the Board, pursuant to 37 C.F.R. §2.120(g)(1) and Fed. R. Civ. P. 37(b)(2), and TBMP §527.03, enters judgment in favor of Opposer for willful and continuing failure to comply with the rules governing discovery. Such action is respectfully requested.

Respectfully submitted,

Dated: June 15/2009

By: _____

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CERTIFICATE OF SERVICE

I certify that a copy of the OPPOSER'S MOTION FOR SANCTIONS UNDER TBMP RULE 527.03 AND 37 C.F.R. §2.120(g)(1) was sent via First Class Mail this 16th day of June, 2009 to:

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