

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

Dunn

Mailed: January 13, 2010

Opposition No. 91187460

Tyler Perry

v.

Edith M. Jebbinson and
Novella S. Brown

Before Quinn, Zervas, and Cataldo, Administrative Trademark
Judges:

By the Board:

This case comes up on opposer's motion, filed June 16, 2009, for sanctions based on the failure of joint applicants Edith M. Jebbinson and Novella S. Brown to conduct the required discovery conference by April 8, 2009?, and applicants' motion, filed July 16, 2009, to reopen the time for conducting the conference.

Although this opposition is barely past the pleading stage, this is not the first order addressing applicants' failure to follow Board procedures and deadlines. Applicants filed no answer to the notice of opposition, and then filed an incomplete answer, before filing one that could be accepted. While applicants contend that their

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initial answer was acceptable and timely, applicants made no effort to review their filing or ascertain that it was complete, and it was only after the Board issued two orders addressing such failure that the complete answer was filed and accepted. In addition, the Board's January 28, 2009 order notified applicants of the technical nature of Board proceedings, strongly recommended legal representation, and advised applicants that all parties, whether or not represented by counsel, must comply with the Board's rules.

Applicants then failed to respond to opposer's several requests for applicants' participation in the required discovery conference. On May 27, 2009, the Board denied opposer's motion to extend the time for the discovery conference in an order which informed the parties that the obligation to participate in the discovery conference was mutual, and that failure to participate in the required discovery conference could result in entry of sanctions.

Following issuance of the Board's order, applicants made no effort to communicate with opposer. Opposer filed the instant motion seeking sanctions against applicants, noting that its email communications of March 11, March 18, March 24, and March 31 seeking to schedule the discovery conference were unanswered by applicants. Opposer contends

sanctions are warranted based on the delay to litigation and the expense to opposer caused by applicant's actions.

On July 16, 2009, more than three months after the April 8, 2009 deadline for the discovery conference, applicants filed a motion to extend the time for conducting the conference, maintaining that they did not receive opposer's email communications dated March 24 and 31, 2009, that they called opposer on June 17, 2009, and that they spoke to opposer by phone on June 22, 2009.

Applicants' filing of their motion to reopen the time for conducting the conference is denied and thus does not moot the issue of sanctions.¹ Applicants' motion falls far short of demonstrating that excusable neglect was the basis for their failure to conduct the conference by the due date.² Applicants' bare assertion that they failed to receive two of several communications from opposer focuses on the wrong party's conduct. That is, the Board's rules,

¹ Although titled a motion to extend, applicants' motion was not filed within the period for conducting the discovery conference, and thus extension is no longer available. Fed. R. Civ. P. 6(b).

² The excusable neglect determination must take into account all relevant circumstances surrounding the party's omission or delay, including (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. *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997).

case law, its institution order issued November 12, 2008 in this proceeding, and its May 27, 2009 order denying opposer's motion to extend, all make very plain that participation in the discovery conference is an obligation of both parties. See Trademark Rule 2.120(a) and (g); *Promgirl, Inc. v. JPC Co., Ltd.*, ___ USPQ2D ___ (TTAB 2009); *Guthy-Renker Corporation v. Michael Boyd*, 88 USPQ2d 1701 (TTAB 2008); *Kairos Institute of Sound Healing, LLC v. Doolittle Gardens, LLC*, 88 USPQ2d 1541 fn3 (TTAB 2008). Applicants' motion does nothing to convince us that applicants are not wholly responsible for their failure to participate in the discovery conference by the due date.

We grant opposer's motion, and turn then to the issue of the appropriate sanction under Trademark Rule 2.120(g)(1) ("If a party fails to participate in the required discovery conference ... the Board may make any appropriate order, including those provided in Rule 37(b)(2) of the Federal Rules of Civil Procedure").³

³ Trademark Rule 2.120(g)(1) also provides that "A motion for sanctions against a party for its failure to participate in the required discovery conference must be filed prior to the deadline for any party to make initial disclosures", which in this case was May 8, 2009. We note opposer's attempt to extend the deadline for the discovery conference, which would have resulted in extending the date for initial disclosures, and we consider the motion for sanctions to be timely.

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Notwithstanding opposer's understandable impatience with applicants, we disagree that applicants' conduct warrants entry of judgment for opposer at this time. In fashioning a sanction, the Board must "make the sanction appropriate for the nature of the violation. Also, our chosen sanction should serve to ensure smoother prosecution of the remainder of this case." *Electronic Industries Association v. Patrick H. Potega DBA Lifestyle Technologies*, 50 USPQ2d 1775, 1778 (TTAB 1999).

Because applicants have delayed this proceeding and caused unnecessary expense to opposer, our sanction is intended to save opposer time and expense in seeking and obtaining discovery, and to reinforce to applicants the Board's interest in avoiding further delay. Specifically, applicants have forfeited their right to serve only the initial disclosures required under Fed. R. Civ. P. 26(a). Instead, applicants are ordered to produce to opposer as part of their initial disclosures documents related to applicants' first use of the mark which is the subject of the opposed application, the name of and identifying information about their first customer, and, from first use to the present, the geographic extent of their use, representative samples of any advertising, and a listing of annual expenditures on advertising and annual sales. To

the extent no such documents exist, applicants must so state.

The expanded initial disclosures should be served upon opposer only. Neither written disclosures nor discovery are filed with the Board. Trademark Rule 2.122(j)(8). To the extent that the expanded initial disclosures include confidential information, the parties are advised that the Board's standard protective order for the exchange of confidential information is in effect for all Board proceedings unless modified by party agreement or Board order. The Board's standard protective order is available from the Office website. If applicants do not comply with the Board's order regarding expanded initial disclosures, opposer may seek additional sanctions, including judgment as a sanction for violation of this order.⁴

The Board also seeks to preclude any further delay based on an assertion that applicants were unaware of a communication from opposer or the Board. Throughout the pendency of this proceeding applicants are ordered to (1)

⁴ Moreover, if at trial applicants attempt to introduce information or documents which should have been produced as expanded initial disclosures but were not, opposer may seek to bar consideration of that evidence. *ConAgra Inc. v. Saavedra*, 4 USPQ2d 1245, 1247 n.6 (TTAB 1987) (exhibits demonstrating pronouncement not produced during discovery, though encompassed by discovery requests, excluded from consideration).

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list a phone number which is checked for messages daily on any paper filed with the Board or served on opposer; (2) if the listed phone or answering machine/messaging service is out of order or unavailable for any length of time, call opposer to ensure no paper was served during that period, and (3) check the Board's electronic docket at <http://ttabvueint.uspto.gov/ttabvue/> each week to ensure that applicants know of any Board orders which issued in this proceeding.

Disclosure, discovery and trial dates are reset below:

Initial Disclosures Due	02/19/10
Expert Disclosures Due	7/19/10
Discovery Closes	8/18/10
Plaintiff's Pretrial Disclosures	10/2/10
Plaintiff's 30-day Trial Period Ends	11/16/10
Defendant's Pretrial Disclosures	12/1/10
Defendant's 30-day Trial Period Ends	1/15/11
Plaintiff's Rebuttal Disclosures	1/30/11
Plaintiff's 15-day Rebuttal Period Ends	3/1/11

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing after briefing is not required but will be scheduled upon request of any party, as provided by Trademark Rule 2.129.
