

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

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Mailed: September 24, 2010

Opposition No. **91187847**

The Susan G. Komen Breast
Cancer Foundation, Inc.

v.

Christine Machleit and
Matilda Beeler

**Before Seeherman, Hairston and Ritchie, Administrative
Trademark Judges.**

By the Board:

This matter comes up on opposer's motion (filed December 1, 2009) for sanctions in the form of judgment for applicants' failure to comply with the Board's order of October 22, 2009. The motion is fully briefed.

To summarize, opposer filed a motion to compel discovery and initial disclosures on September 22, 2009. With no response of record, the Board granted the motion on October 22, 2009, and ordered applicants to serve, within thirty days of the order, their initial disclosures¹ and responses, without objection unless privileged, to opposer's interrogatories and

¹ Unbeknownst to the Board at the time of the order, initial disclosures were served by applicants on September 24, 2009.

requests for documents.² Having received no response to the Board's order, opposer filed a motion for sanctions in the form of judgment on December 1, 2009.³ On December 17, 2009, applicants filed a response to the motion along with responses to opposer's discovery requests.

Decision

Where a party fails to comply with an order of the Board relating to discovery, the Board may order appropriate sanctions, including entry of default judgment. Trademark Rule 2.120(g)(1) and Fed. R. Civ. P. 37(b)(2). However, default judgment is a harsh remedy that is granted where no less drastic remedy would be effective and where there is a strong showing of willful evasion. *See Unicut Corp. v. Unicut, Inc.*, 222 USPQ 341, 344 (TTAB 1984).

Here, applicants assert that they were unable to timely comply with the Board's order as they did not receive opposer's discovery requests until December 7, 2009. Although opposer argues that its discovery requests (or copies thereof) were served on applicants at the address on record with the Board on three separate occasions, it is undisputed that the original discovery requests that were served on August 10, 2009, were returned to opposer by the postal service despite the forwarding service applicants had in place at the time. This certainly undermines the reliability of the forwarding service

² Opposer did not include its request for admissions as part of the motion to compel on the ground that the admission requests are deemed admitted pursuant to Fed. R. Civ. P. 36(a).

offered by the postal service and, at the very least, raises doubts as to whether applicants actually received the subsequent mailings from opposer and willfully failed to respond to opposer's discovery requests. Indeed, applicants' making their initial disclosures on September 24, 2009, and their responses to opposer's discovery requests shortly after receiving them, indicate that they are not seeking to evade their discovery obligations.

Although the better practice would have been for applicants to file their change of correspondence address with the Board concurrently with the change filed at their local post office, the parties' confusion as to applicants' most current correspondence address cannot be solely attributed to applicants' failure to update the Board's records. Opposer does not dispute that its counsel was apprised of applicants' change of correspondence address as early as February 2009. Yet opposer gives no reasonable explanation as to why it failed to update its records or why it chose to serve applicants at an older correspondence address despite being informed of a new one.⁴

³ Pursuant to a change of correspondence filed by applicants on October 29, 2009, opposer's motion was served on the new address of record.

⁴ Although opposer relies on TBMP § 117.07 for the proposition that applicants had an obligation to update their correspondence address with the Board and opposer's only obligation was to send correspondence to the address of record, the primary purpose of that section is to keep the Board's records up to date and to ensure that the Board's correspondence is sent to the most current address. There is nothing in the section to suggest that a party is required to send correspondence only to the address of record and to ignore any change of correspondence communicated between the parties, particularly in situations involving discovery during which communications are normally conducted between the parties and any related documents and correspondence are not filed with the Board.

In view thereof, opposer's motion for sanctions is **DENIED**. Furthermore, and contrary to opposer's unilateral declaration, opposer's admission requests are not deemed admitted because of applicants' failure to timely serve responses; as noted, applicants state that they did not receive opposer's discovery requests until December 7, 2009. Instead, applicants' responses to opposer's discovery requests that were served on opposer on December 17, 2009, are accepted subject to any objections opposer may put forward in terms of the sufficiency of applicants' responses. Further, **discovery is reopened for opposer only, for two months**, to conduct follow up discovery as needed. Applicants are reminded of their duty to cooperate and to deal in good faith. Opposer is free to renew its motion to compel if necessary, if the parties are not able to resolve their discovery disputes.

Dates are reset as follows:

Plaintiff's Discovery Closes	11/22/2010
Plaintiff's Pretrial Disclosures Due	1/6/2011
Plaintiff's 30-day Trial Period Ends	2/20/2011
Defendant's Pretrial Disclosures Due	3/7/2011
Defendant's 30-day Trial Period Ends	4/21/2011
Plaintiff's Rebuttal Disclosures Due	5/6/2011
Plaintiff's 15-day Rebuttal Period Ends	6/5/2011

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 taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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