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Filing date: **08/17/2010**

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

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|------------------------|---|
| Proceeding | 91188903 |
| Party | Plaintiff Apple Inc. |
| Correspondence Address | JOSEPH PETERSEN KILPATRICK STOCKTON LLP 31 WEST 52ND STREET - 14TH FLOOR NEW YORK, NY 10019 UNITED STATES AlJones@kilpatrickstockton.com, JPetersen@kilstock.com, JVogel@kilstock.com, ipefiling@kilpatrickstockton.com, agarcia@kilstock.com |
| Submission | Motion for Sanctions |
| Filer's Name | Alicia Grahn Jones |
| Filer's e-mail | AlJones@kilpatrickstockton.com, JPetersen@kilstock.com, JVogel@kilstock.com, ipefiling@kilpatrickstockton.com, agarcia@kilstock.com |
| Signature | /Alicia Grahn Jones/ |
| Date | 08/17/2010 |
| Attachments | Apple v Fabasoft (APPLSTRUDL) - Motion Memorandum in Support for Sanctions in the Form of Default.pdf (6 pages)(20477 bytes) Apple v Fabasoft- Decl. of A. Jones ISO of Motion for Sanctions.pdf (5 pages)(108054 bytes) |

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

In the matter of Application Serial No. 77/460,315
For the mark: APPLSTRU DL
Filed: April 29, 2008
Published: December 16, 2008

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| APPLE INC., | : | |
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| Opposer, | : | |
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| | : | Opposition No. 91188903 |
| v. | : | |
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| FABASOFT AG, | : | |
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| Applicant. | : | |
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**OPPOSER’S MOTION AND MEMORANDUM IN SUPPORT FOR
SANCTIONS IN THE FORM OF DEFAULT JUDGMENT**

Opposer Apple Inc. (“Opposer” or “Apple”), pursuant to Federal Rule of Civil Procedure 37 and 37 C.F.R. § 2.120(g), respectfully moves for sanctions in the form of default judgment against Applicant Fabasoft AG (“Applicant”) in light of Applicant’s longstanding and willful disregard for its discovery obligations and the Board’s June 28, 2010 Order requiring it to produce Initial Disclosures and responses to discovery requests served more than one year ago.

I. RELEVANT FACTS AND PROCEDURAL HISTORY

Opposer commenced this proceeding by filing a notice of opposition against Applicant’s intent to use application to register the mark APPLSTRU DL (Serial No. 77/460,315) on February 13, 2009. *See* Dkt. No. 1. Applicant failed to serve Initial Disclosures before the May 29, 2009 deadline. *See* Dkt. No. 2; March 10, 2010 Declaration of Alicia Grahn Jones (“Jones Decl.”) ¶ 2. On June 25, 2009, Opposer served written discovery, including document requests,

requests for admission, and interrogatories, on Applicant. *See id.* ¶ 3. Applicant failed to serve its discovery responses in advance of the July 31, 2009 deadline. *See* Dkt. No. 19, p. 3.

On March 10, 2010, Opposer filed a motion to compel Applicant's Initial Disclosures, Applicant's responses to Opposer's First Set of Interrogatories, and Applicant's production of documents responsive to Opposer's First Request for Production of Documents. *See* Dkt. No. 11. Applicant failed to respond to Opposer's Motion to Compel and instead filed a Motion to Suspend. *See* Dkt. No. 13; *see also* Dkt. No. 15.

On June 25, 2010, the Board held a telephone conference with counsel for both parties. *See* Dkt. No. 19. During the conference, the Board granted Opposer's motion to compel and ordered Applicant to serve its Initial Disclosures and to respond to Opposer's outstanding interrogatories and request for production of documents (without objection) by no later than July 25, 2010. *See id.*, pp. 3-4. The Board also deemed Opposer's First Requests for Admission admitted by Applicant. *See* Dkt. No. 11, p. 4. The Board issued an order on June 28, 2010 memorializing its decision issued in the June 25, 2010 conference (the "Board's Order"). *See* Dkt. No. 19. Despite the Board's Order, Applicant failed to serve its disclosures, discovery responses, or responsive documents. *See* August 17, 2010 Declaration of Alicia Grahn Jones ("Second Jones Decl.") ¶ 3. On July 27, 2010, counsel for Opposer sent an email to counsel for Applicant following up on Applicant's overdue responses. *See id.* ¶ 4, Ex. A. Counsel for Applicant responded that Applicant "did not serve any discovery responses [to you] by mail" and Applicant's counsel was "not yet in a position to do so." *See id.*, Ex. A.

More than six weeks have passed since the Board's June 25, 2010 teleconference and the Board's Order, and Opposer has yet to receive Applicant's Initial Disclosures, Applicant's discovery responses, or a single document from Applicant, more than one year after Opposer

first served its initial discovery requests. *See id.* ¶ 3. Despite the Board’s Order, Applicant has failed to serve Initial Disclosures or to respond to Applicant’s discovery requests. *See id.* Accordingly, the Board should enter default judgment against Applicant.

II. ARGUMENT AND CITATION OF AUTHORITY

Default judgment is appropriate because Applicant has failed to comply with the Board’s Order compelling Applicant to fulfill its discovery obligations. “If a party fails to comply with an order of the Board relating to discovery, including an order compelling discovery, the Board may order appropriate sanctions as defined in Trademark Rule 2.120(g)(1) and Fed. R. Civ. P. 37(b)(2), including entry of default judgment.” *Baron Philippe de Rothschild, S.A. v. Style-Rite Optical Mfg. Co.*, 55 U.S.P.Q.2d 1848, 1854 (T.T.A.B. 2000) (granting opposer’s motion for sanctions, entering judgment against applicant sustaining the opposition). “Unlike a motion to compel discovery, there is no requirement that a party make a good faith effort to resolve the parties’ dispute prior to filing a motion for entry of discovery sanctions.” *HighBeam Mktg. LLC v. Highbeam Research LLC*, 85 U.S.P.Q.2d 1902, 1904 (T.T.A.B. 2008).

The Board often applies these rules to enter default judgment in cases like this involving a complete failure to participate in discovery. *See, e.g., Wahl v. Fusco*, 39 U.S.P.Q.2d 1223 (T.T.A.B. 1996) (entering default judgment where “nearly a year and a half has elapsed since [a party’s] discovery requests were served on [its adversary]” and the adversary “persisted in [its] course of nonresponsive conduct, deliberately ignoring the Board’s warnings and instructions . . .”); *Unicut Corp. v. Unicut, Inc.*, 222 U.S.P.Q. 341 (T.T.A.B. 1984) (entering default judgment where party engaged in “willful evasion” of discovery); *Regent Baby Prods. Corp. v. Dundee Mills, Inc.*, 199 U.S.P.Q. 571 (T.T.A.B. 1978) (dismissing with prejudice an opposition in which the opposer “chose merely to ignore the Order of the Board” and “repeatedly failed to follow the

applicable rules of practice”); *Caterpillar Tractor Co. v. Catfish Anglers Together, Inc.*, 194 U.S.P.Q. 99 (T.T.A.B. 1977) (entering default judgment where party failed to comply with the Rules of Practice and offered no explanation of its failure to respond to discovery).

Opposer is forced to file this Motion for Sanctions because of Applicant’s failure to comply with the Board’s Order. Throughout this proceeding, Opposer has made legitimate requests that Applicant serve the required Initial Disclosures and respond to propounded discovery requests. Applicant repeatedly has failed to provide any substantive information whatsoever. The Board ordered Applicant to serve the required Initial Disclosures and to respond to Opposer’s interrogatories and request for production of documents, but Opposer still has not received Applicant’s Initial Disclosures, any response to Opposer’s discovery requests, or even a single responsive document from Applicant. *See* Second Jones Decl. ¶ 3.

Moreover, while there is no obligation for Opposer to confer with Applicant prior to filing this Motion, Opposer nevertheless sought to resolve this dispute with Applicant before filing this Motion. Specifically, counsel for Opposer contacted Applicant’s counsel to request copies of Applicant’s discovery responses and responsive documents. *See* Second Jones Decl. ¶ 4, Ex. A. Applicant’s counsel advised that Applicant “did not serve any discovery responses” and Applicant’s counsel was “not yet in a position to do so.” *See id.*

In light of Applicant’s willful and longstanding disregard of its discovery obligations and of the Board’s Order, the Board should enter default judgment against Applicant.

III. CONCLUSION

For the foregoing reasons, Opposer respectfully requests that the Board sanction Applicant in the form of default judgment for its failure to participate in discovery, including its violation of the Board's June 28, 2010 Order.

This 17th day of August, 2010.

KILPATRICK STOCKTON LLP

By: /s/ Alicia Grahn Jones

Joseph Petersen
Alicia Grahn Jones
Allison M. Scott

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New York, New York 10019
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Attorneys for Opposer Apple Inc.

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

In the matter of Application Serial No. 77/460,315
For the mark: APPLSTRU DL
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| Applicant. | : | |
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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing OPPOSER’S MOTION AND MEMORANDUM IN SUPPORT FOR SANCTIONS IN THE FORM OF DEFAULT JUDGMENT has been served on Applicant by mailing a copy on August 17, 2010, via first-class mail, postage pre-paid, and addressed as follows:

Stewart J. Bellus
Collard & Roe, P.C.
1077 Northern Blvd
Roslyn, NY 11576-1614

This the 17th day of August, 2010.

/s/Allison M. Scott

Allison M. Scott
Attorney for Opposer Apple Inc.

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**DECLARATION OF ALICIA GRAHN JONES IN SUPPORT OF
OPPOSER’S MOTION FOR SANCTIONS IN THE FORM OF DEFAULT JUDGMENT**

I, Alicia Grahn Jones, declare as follows:

1. I am an attorney at the law firm of Kilpatrick Stockton LLP and am one of the attorneys representing Apple Inc. (“Opposer”) in this action against Applicant Fabasoft AG (“Applicant”). I am over the age of twenty-one, I am competent to make this Declaration, and the facts set forth in this Declaration are based on my personal knowledge.

2. I participated in the June 25, 2010 teleconference that the Board held with counsel for both parties to the above-captioned proceeding. During the conference, the Board granted Opposer’s Motion to Compel and ordered Applicant to serve its Initial Disclosures and to respond to Opposer’s outstanding interrogatories and request for production of documents (without objection) by no later than July 25, 2010. The Board later issued a written Order on June 28, 2010 memorializing its decision issued in the June 25, 2010 conference (the “Board’s Order”).

3. Despite the Board's Order, to date, Applicant has yet to serve its Initial Disclosures or any response to Opposer's discovery requests or produce any responsive documents.

4. On July 27, 2010, I emailed counsel for Applicant following up on Applicant's overdue Initial Disclosures and discovery responses. A true and correct copy of my email to Applicant's counsel and his response is attached as **Exhibit A**.

I declare under penalty of perjury of the laws of the United States that the foregoing is true and correct.

Dated: August 17, 2010

/s/ Alicia Grahn Jones
Alicia Grahn Jones

EXHIBIT A

From: Stewart Bellus [sbellus@collardroe.com]
Sent: Tuesday, July 27, 2010 3:16 PM
To: Jones, Alicia
Subject: RE: Apple v Fabasoft AG//Opposition Number 91188903

I did not serve any discovery responses to you by mail and am not yet in a position to do so.

Stewart J. Bellus
Collard & Roe, P.C.
1077 Northern Boulevard
Roslyn, NY 11576
Tel. (516) 365-9802
Fax. (516) 365-9805
Web: <http://www.collardroe.com>
Email: sbellus@collardroe.com

From: Jones, Alicia [mailto:AlJones@kilpatrickstockton.com]
Sent: Tuesday, July 27, 2010 2:20 PM
To: Stewart Bellus
Cc: Vogel, Jason; Petersen, Joe; 366783.eml.us2008@wcs.kilpatrickstockton.com
Subject: Apple v Fabasoft AG//Opposition Number 91188903

Dear Stewart,

I'm writing to follow up on Fabasoft's discovery responses, document production, and initial disclosures, which were due yesterday pursuant to the Board's June 28th Order. Were they served by mail? If so, could you please send me a courtesy copy by email?

Thanks,
Alicia

Alicia Grahn Jones
Kilpatrick Stockton LLP
Suite 2800 | 1100 Peachtree Street | Atlanta, GA 30309-4528
office 404 815 6164 | fax 404 541 3292
aljones@kilpatrickstockton.com | [My Profile](#)

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I hereby certify that a true and correct copy of the foregoing DECLARATION OF ALICIA GRAHN JONES IN SUPPORT OF OPPOSER’S MOTION FOR SANCTIONS IN THE FORM OF DEFAULT JUDGMENT has been served on Applicant by mailing a copy on August 17, 2010, via first-class mail, postage pre-paid, and addressed as follows:

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This the 17th day of August, 2010.

/s/Allison M. Scott

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Attorney for Opposer Apple Inc.