

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

Butler

Mailed: February 16, 2011

Opposition No. 91195527

EVERETT W. JAMES aka TAD JAMES

v.

ALICE DENDINGER ALLIANCE GROUP, LLC

Before Cataldo, Bergsman and Wolfson, Administrative Trademark Judges.

By the Board:

In accordance with the institution order dated July 1, 2010, the deadline for the parties' discovery conference was September 9, 2010 and the due date for the exchange of initial disclosures was set as October 9, 2010. This case now comes up on opposer's fully briefed motion, filed October 6, 2010, for entry of sanctions in the nature of default judgment for applicant's failure to participate in the discovery conference.¹

In support of his motion, opposer indicates that his attorney sent an email on September 7, 2010 to applicant's attorney. The email asks applicant's attorney to contact opposer's attorney to discuss the opposition proceeding, includes

¹ No consideration is given to applicant's communication dated November 9, 2010, which appears to be a sur-reply. While the Board may consider a reply brief, the Board will not consider any further papers in support of or in opposition to a motion. Trademark Rule 2.127(a); 37 C.F.R. § 2.127(a).

an introduction of counsel, and states "[t]he deadline for the discovery conference is set for 9/9/10." Opposer's counsel indicates that he received no response; that on September 9, 2010 he phoned applicant's counsel, was informed that applicant's counsel was attending a hearing and left a message asking that applicant's counsel return the call "to discuss the above-captioned proceeding." Opposer's counsel also sent another email on that day to applicant's counsel confirming that a telephone message was left and again asking applicant's counsel to return the call to "discuss this matter." Opposer's counsel, on September 17, 2010, sent a letter to applicant's counsel as a follow-up on the earlier messages in an effort to discuss "the discovery and related conference issues." On September 30, 2010, opposer's counsel sent another letter to applicant's counsel, following up on the earlier communications, in which opposer's counsel noted that he has not received any response from applicant's counsel concerning the earlier communications and expressly stated that, if no response was provided by October 5, 2010, "we will proceed to file a motion pursuant to Trademark Rule 2.120(g)."

Opposer's attorney argues that he attempted to schedule the conference, attempted to contact applicant's counsel numerous times, and has not received any response from applicant's attorney. Opposer asks for entry of default judgment against

applicant for applicant's failure to participate in the conference.

In response,² applicant's attorney states that the failure to hold the conference was not due to conscious indifference but to an extremely full litigation calendar, exacerbated by the locations for the parties' attorneys. Opposer's attorney is located in Hawaii while applicant's attorney is located in Texas. Applicant's attorney indicates he has now taken steps to rectify the matter by leaving a phone message for opposer's attorney to schedule the conference. Applicant's attorney, referencing TBMP § 403.02, argues that opposer is not prejudiced because a conference is not a prerequisite to conducting discovery.³

In reply, opposer argues that applicant ignored the deadline for the conference, ignored opposer's attempts to schedule the conference, and ignored the due date for a response to opposer's

² Applicant's response, filed October 27, 2010, is one day late. Opposer's objection to consideration of the response on that basis is overruled. In accordance with Trademark Rule 2.127(a), a response to a motion is due 15 days from service of that motion. In accordance with Trademark Rule 2.119(c), where a paper to which a response is due is served by First Class Mail (as here), an additional five days is allowed. Thus, applicant's response was due on October 26, 2010, twenty days from the date of service. However, because the proceeding is in the early stages and there is an opportunity to correct the misperceptions of applicant's attorney concerning Board proceedings and get the case back on track, the Board will exercise its discretion to consider applicant's late response. Counsel should not, however, again fail to respond to a motion within the time frame allowed by the rules, particularly a motion which, if granted would result in entry of judgment. Failure to timely respond to a motion may result in the motion being granted as conceded.

³ As discussed herein, counsel's statement regarding required procedures is in error.

motion. Opposer believes that applicant has established a pattern of delay. Opposer points out that applicant's attempts to "rectify the situation" occurred on October 21 and October 27, long after the deadline for the discovery conference had passed and that applicant's attempts to schedule such conference after opposer's motion was filed, and after the Board issued its suspension order, are too late. Opposer argues that default judgment should be entered for applicant's conduct.

Trademark Rule 2.120(a)(1), 37 C.F.R. § 2.120(a)(1), which sets forth the provisions for a discovery conference, states, in pertinent part:

...The provisions of Federal Rule of Civil Procedure 26 relating to required disclosures, the conference of the parties to discuss settlement and to develop a disclosure and discovery plan, the scope, timing and sequence of discovery, protective orders, signing of disclosures and discovery responses, and supplementation of disclosures and discovery responses, are applicable to Board proceedings in modified form..."

The requirement for parties to participate in the required discovery conference was introduced into Board inter partes proceedings by amendments to the Trademark Rules, and is applicable to all proceedings which commenced on or after November 1, 2007. See Notice of Final Rulemaking, Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242 (Aug. 1, 2007). The stated purpose of the conference is to allow the parties to discuss "the nature and basis of the involved claims and defenses, the possibility of settlement of the case or modification of the pleadings, and plans for

disclosures and discovery." 72 Fed. Reg. at 42252. The parties shall discuss the subjects outlined in Federal Rule 26(f) and any other subjects that the Board may, in an institution order, require to be discussed. *Id.* at 42252.

Trademark Rule 2.120(g)(1), 37 C.F.R. § 2.120(g)(1), provides, in pertinent part:

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.

The obligation for parties to hold a discovery conference is a mutual obligation. See *Influence, Inc. v. Zucker*, 88 USPQ2d 1859 n.2 (TTAB 2008). The responsibility to schedule a conference and to confer on each of the topics outlined in Rule 26 and the institution order is a shared responsibility. See *Promgirl, Inc. v. JPC Co.*, 94 USPQ2d 1759, 1762 (TTAB 2009). The Board has adopted the requirement for discovery conferences to avoid needless disputes and motions and to facilitate either prompt and genuine settlement discussions or a smooth and timely transition to disclosures, discovery and trial. See *Guthy-Renker Corporation v. Boyd*, 88 USPQ2d 1701, 1704 (TTAB 2008). However, the Board's 2007 adoption of a model requiring conferencing and disclosures was not meant to provide opportunities for one party to find procedural deficiencies or technical failures upon which to obtain an advantage over its adversary. Instead, the adoption of such a model was intended to provide an early engagement in communication, an opportunity to ascertain if the dispute may be

settled amicably, and an orderly administration of the proceeding as it moves toward trial. *See General Council of the Assemblies of God dba Gospel Publishing House v. Heritage Music Foundation*, ___ USPQ2d ___ (TTAB 2011) (Cancellation No. 92051525, February 3, 2011).

It is clear that opposer's attorney made several attempts to reach applicant's attorney to discuss the opposition proceeding just before, on the day of, and in the weeks after the due date for the discovery conference. Although the first two emails (September 7 and 9) may not have been immediately clear that opposer's attorney was also seeking to coordinate schedules for the discovery conference, applicant had the schedule and was aware of the deadline for the discovery conference. In addition, by the final letter (September 30), opposer's attorney made it very clear that he would be filing a motion with the Board over this matter. Applicant's attorney did not provide the courtesy of any response - not even a single email indicating he had scheduling conflicts, asking for an extension, or offering some possible dates and times for the conference. It was reasonable for opposer to assume applicant had lost interest in this case and seek to end the proceeding as expeditiously as possible, *i.e.*, through the filing of a motion for entry of judgment.

Applicant is incorrect in its assumption that a discovery conference is not a requirement in Board proceedings. In addition, applicant's reliance on TBMP § 403.02 for the position

that a discovery conference is not a prerequisite to conducting discovery is misplaced. The Board acknowledges that the TBMP posted at its webpage is out of date. However, online access to the manual requires the viewer to navigate through a page providing notice that some of the information is out of date and that the manual must be read in conjunction with the August 1, 2007 changes to the rules of procedure. Links to the 2007 rules and a chart of the rules changes are provided. A visitor to the Board's web page cannot proceed directly to the manual without first being presented with this notification. If applicant's counsel "clicked through" this warning without reading it, counsel erred. Even without the warning, any attorney practicing before the Board is expected to be familiar with current Board rules. Finally, the institution order explained in some detail the requirement for a conference and it should have been entirely clear to counsel that the instructions of the institution order had to be followed.

It is clear, nonetheless, that applicant has not lost interest in this case and has not expressly refused to participate altogether in the parties' required discovery conference. Consequently, at this early stage in the proceeding, entry of default judgment for applicant's failure to participate in the discovery conference on September 9, 2010 is too harsh a sanction. Accordingly, opposer's motion for entry of sanctions in the nature of default judgment is denied. However, opposer's

motion for entry of appropriate sanctions is granted. The following requirements are imposed on applicant as a sanction for its failure to participate in the required discovery conference and for ignoring opposer's overtures in attempting to arrange such conference:

1) Henceforth in this proceeding, applicant's attorney is ordered to respond to opposer's attorney's phone messages and email communications as quickly as reasonably possible and at least within two (2) business days of receipt.

2) In the case of an extended absence or unavailability, applicant's attorney is ordered to notify opposer's attorney and is to provide opposer's attorney with an alternate means of contact.

3) Applicant's attorney is ordered to familiarize himself with the information available on the TTAB's home page,⁴ particularly the chart summarizing the 2007 rules changes, the Federal Register publication of the rules changes, and TBMP § 502.02(b) (2d ed. rev. 2004) which provides information concerning the due dates for responsive briefs and reply briefs to motions.⁵ Applicant's attorney is allowed until **THIRTY DAYS** from the mailing date of this order in which to do so and is

⁴ <http://www.uspto.gov/trademarks/process/appeal/index.jsp>

⁵ Should the parties elect to effectuate service of process by email, the additional 5 days available under Trademark Rule 2.119(c) is not available.

ordered to notify the Board in writing (served on opposer) that he has reviewed such material.

Applicant's course of noncommunication has caused delay to this proceeding. Applicant is reminded to adhere to the deadlines. In the event applicant believes it needs an extension of a deadline, applicant should seek such an extension before the deadline expires. Under Fed. R. Civ. P. 6, which is applicable to this proceeding, a deadline may be extended for good cause shown but may be reopened after it has passed only on a showing of excusable neglect or on consent of the parties. The Board expects the parties to adhere to the schedule set and, if a modification of the schedule is necessary, to first work together to see if the desired modification will be with the consent of the adverse party before filing an unconsented scheduling motion with the Board.⁶

Proceedings are suspended until the due date for the discovery conference, except that the parties are to coordinate to schedule the conference. If the parties would like the participation of a Board attorney in the conference, they are to contact the Board by **March 15, 2011** so that the conference will be set for a mutually convenient date and time for all participants given the disparity of the involved time zones. During the suspension period, applicant's attorney is to

⁶ Ordinarily a consented motions to extend or reopen will be granted by the Board. TBMP § 509.02 (2d ed. rev. 2004).

familiarize himself with the information available at the TTAB homepage, as ordered. Dates otherwise are reset as follows:

Deadline for Discovery Conference	3/31/2011
Discovery Opens	3/31/2011
Initial Disclosures Due ⁷	4/30/2011
Expert Disclosures Due	8/28/2011
Discovery Closes	9/27/2011
Plaintiff's Pretrial Disclosures	11/11/2011
Plaintiff's 30-day Trial Period Ends	12/26/2011
Defendant's Pretrial Disclosures	1/10/2012
Defendant's 30-day Trial Period Ends	2/24/2012
Plaintiff's Rebuttal Disclosures	3/10/2012
Plaintiff's 15-day Rebuttal Period Ends	4/9/2012

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 the taking of testimony. Trademark Rule 2.125.

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

⁷ If either party has already served initial disclosures, it need not do so again. Instead, such party should notify its adversary that it is relying on the previously served initial disclosures. Of course, the disclosures are to be supplemented by the due date if supplementation is necessary. Fed. R. Civ. P. 26(e)(1).