

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

Goodman

Mailed: March 9, 2012

Opposition No. 91199018

Amylin Pharmaceuticals, Inc.

v.

Amlin Health, LLC

Before Zervas, Wellington and Shaw, Administrative Trademark Judges.

By the Board:

As background, on October 28, 2011, the Board granted opposer's motion to compel applicant's initial disclosures, denying applicant's motion to reopen, and granting applicant's motion to extend time to serve its responses to opposer's discovery requests. The Board ordered applicant to serve its initial disclosures and discovery responses within fifteen days of the order.

This case now comes up on the following motions:

1) opposer's motion, filed November 18, 2011, for sanctions, and, in the alternative, motion to compel; and

2) applicant's motion to extend time to serve initial disclosures and discovery responses, filed December 7, 2011.¹

¹ Although opposer expresses some confusion as to whether this filing is a new motion rather than a response to its motion for sanctions and alternative motion to compel, the Board construes this motion as in effect a response to the motion for sanctions

We turn first to opposer's motion to compel, in the alternative, and applicant's motion to extend. We construe applicant's motion to extend as a motion to reopen because the time for complying had already passed before applicant filed said motion. TBMP § 509.01 (3d ed. 2011) ("Where the time for taking required action, as originally set or as previously reset, has expired, a party desiring to take the required action must file a motion to reopen the time for taking that action"). Opposer has opposed the motion to extend, arguing that applicant has not established excusable neglect.

Motion to Compel; Applicant's Motion to Reopen Time -
Initial Disclosures and Discovery Responses

Motion to Compel - Outstanding Discovery Responses

Opposer has sought, in the alternative to its motion for sanctions, to compel responses to its discovery requests due to applicant's failure to serve responses within the extension of time granted by the Board. Opposer's motion is denied because it has failed to include the copies of the discovery requests with its motion as required by Trademark Rule 2.120(e). See also TBMP § 523.02.

and to compel and a cross-motion to reopen. Also, applicant's reply to its motion to extend was served on January 11, 2012, but not filed until January 12, 2012 via ESTTA. The reply to the motion to extend is therefore untimely and has not been considered.

Motion to Reopen

The Board previously denied applicant's motion to reopen time to serve initial disclosures, finding no excusable neglect. To the extent that applicant seeks reconsideration of the Board's October 28, 2011, order denying its July 28, 2011, motion to reopen time, such request for reconsideration is untimely. Trademark Rule 2.127(b).

To the extent that applicant seeks to reopen its time to serve discovery responses, as discussed below, the Board finds that applicant has failed to establish excusable neglect. Fed. R. Civ. P. 6(b)(1)(B) (" . . . the court may for good cause extend the time . . . on motion made after the time has expired if the party failed to act because of excusable neglect").

The Board considers the following factors as set forth in *Pioneer Investment Services Company v. Brunswick Associates Ltd. Partnership*, 507 U.S. 380 (1993), and adopted by the Board in *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997) with regard to excusable neglect:

(1) the danger of prejudice to the non-moving party; (2) the length of delay and its potential impact on judicial proceedings; (3) the reason for the delay, including whether it was within the reasonable control of the moving party; and (4) whether the moving party has acted in good faith.

With regard to the first and second *Pioneer* factors, the Board finds that applicant's overall pattern of delay with regard to discovery has caused some prejudice to opposer and has had an administrative impact on this proceeding as applicant's failure to serve discovery responses has resulted in motion practice (extend/reopen, compel, sanctions) which required suspension of this proceeding. *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848 (TTAB 2000) (finding prejudice to opposer and administrative impact on the Board under *Pioneer* due to applicant's failure to serve discovery responses by agreed date). With regard to the fourth *Pioneer* factor, the Board finds no indication of bad faith on applicant's part.

With regard to the third *Pioneer* factor, the reason for delay, the Board finds the delay was within applicant's control. Applicant's basis for its failure to serve discovery responses was that its representative was out of the country from September 10 to November 30, 2011. As the Board stated in a prior order, even if applicant's representative was out of the country, applicant had a duty to appoint someone in its representative's absence to assist in compiling and responding to discovery. At the very least, applicant's representative, being aware it would be out of the country, could have notified opposing counsel and

the Board and sought a brief extension of time from the due date set by the Board for service of its discovery responses by filing such a motion with the Board.

On balance, the Board finds that applicant has not established excusable neglect to reopen time. Accordingly, the motion to reopen is denied.

Requests for Admissions

In its motion for sanctions and to compel, opposer has also sought an order from the Board that its requests for admissions be deemed admitted. However, an order by the Board deeming the requests "admitted" is unnecessary inasmuch as those requests are deemed admitted by operation of Fed. R. Civ. P. 36(a) in view of applicant's failure to respond, and our denial of applicant's motion to reopen. TBMP § 407.03(a). Accordingly, the motion is denied as moot. *Id.*

We now turn to the motion for sanctions.

Motion for Sanctions - Initial Disclosures and Responses to Discovery Requests

Responses to Discovery Requests

Opposer has moved for sanctions for applicant's failure to serve responses to opposer's outstanding discovery requests under Trademark Rule 2.120(g)(1). Although opposer filed no prior motion relating to its discovery requests, and the Board issued no order on these discovery requests, opposer seeks sanctions based on the Board's order granting

applicant's motion to extend time to serve its discovery responses.

Traditionally, discovery orders are considered to be those orders which resolve discovery disputes between the parties involving one of the enumerated discovery devices, for which the Board fashions relief, based on the nature and circumstances of the discovery devices at issue. See *In re San Juan Dupont Plaza Hotel Fire Litigation*, 859 F.2d 1007, 1012 (1st Cir. 1988) (discussing the court's powers with respect to discovery under Fed. R. Civ. P. 26).

A grant of an extension of time to respond to discovery requests is not the type of order contemplated that would give rise to sanctions, based on a failure to comply, under Trademark Rule 2.120(g). Because no Board discovery order has issued with respect to opposer's discovery requests, the motion for sanctions with respect to applicant's failure to serve responses to opposer's discovery requests is denied.

Initial Disclosures

The Board granted opposer's motion to compel applicant's initial disclosures on October 28, 2011. Opposer has moved for sanctions under Trademark Rule 2.120(g)(1) and Fed. R. Civ. P. 37(b) due to applicant's failure to provide the required initial disclosures "pursuant to the Board Order and the Federal Rules" stating that when opposer inquired of applicant as to when to expect

its disclosures, applicant "failed to provide information as to when the disclosures ... would be provided." Opposer also submits that applicant's "pattern of ignoring deadlines, then filing improper and incomplete papers is prejudicial to Opposer and inhibits its ability to resolve this matter promptly in a manner consistent with the prescribed rules" and that applicant's excuse of being out of the country "cannot be used over and over."²

In response, applicant argues that the motion for discovery sanctions "needlessly involve[sic] the Board, its time and resources" and applicant "made a good faith effort to communicate with Opposer via e-mails to resolve the issue with Opposer although Applicant was abroad" "for professional business" and "was not able to correspond to the Board and opposer with its required disclosures" by the deadline.³ Applicant also disagrees with opposer's

² Exhibits accompanying opposer's motion include a November 5, 2011 e-mail sent to opposer and the USPTO (usptoinfo@uspto.gov) where applicant advised of limited e-mail access and requested that the Board proceeding be put on "HOLD" until the end of November while applicant's representative was abroad, which e-mail was the result of receiving an October 29, 2011 e-mail from the USPTO advising of the issuance of the October 28, 2011 Board order. However, applicant filed no such request to suspend or extend via ESTTA, the Board has not received any motion papers by mail, and the Board does not accept filings by e-mail. TBMP § 107 (3d ed. 2011).

³ Applicant appears confused regarding the date it was required to serve its initial disclosures after the Board granted the motion to compel, referencing the date of December 8, 2011 in its response to the motion for sanctions/compel and motion to extend. However, the order was unambiguous; applicant was required to have served the initial disclosures by November 12, 2011.

assertions in the motion for sanctions that applicant failed to comply or violated the Board's October 28, 2011 order, ignored the deadline and disregarded its duty, complaining that opposer "does not respect" and "ignored" the fact that applicant's representative was out of the country and did not make an effort to correspond with opposer while abroad despite limited e-mail access. Applicant states that it "will follow the rules that the Board sets" and that it "hopes to move the case forward."

If a party fails to comply with an order of the Board relating to disclosures or discovery, a party may file a motion for sanctions, and 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 judgment. See TBMP § 527.01 (3d ed. 2011); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d at 1848. Sanctions which may be entered by the Board include, inter alia, striking all or part of the pleadings of the disobedient party; refusing to allow the disobedient party to support or oppose designated claims or defenses; prohibiting the disobedient party from introducing designated matters in evidence; and entering judgment against the disobedient party. TBMP § 527.01. Default judgment is a harsh sanction but is justified where no less drastic remedy would be effective and there is a strong showing of willful evasion.

Unicut Corporation v. Unicut, Inc., 222 USPQ 341 (TTAB 1984).

It is clear that applicant has not complied with the Board's order compelling applicant's initial disclosures. However, this failure to serve initial disclosures, under the circumstances in this case, does not warrant the most severe sanction ... entry of judgment. Applicant is allowed one more opportunity to comply with its initial disclosure obligation since dismissal is "the most severe sanction available" and a party "should have warning of that consequence."⁴ *Gardner v. AMF Bowling Centers, Inc.* 271 F. Supp.2d 732, 733 (D. Md. 2003); see e.g., *Unicut Corporation v. Unicut, Inc.*, 222 USPQ at 344 (sanction of default judgment entered after respondent was clearly warned in prior Board order of possible consequences for further delays in discovery).

Applicant's disregard of a Board order relating to disclosures, however, does warrant a sanction to deter further misconduct. Accordingly, applicant shall not receive any additional extensions of time to (i) provide applicant's initial disclosures, and (ii) respond to any of opposer's present or future discovery requests, absent the written consent of opposer which applicant must file with

⁴ The Board's order of October 28, 2011, did not warn applicant of the potential consequences for failure to comply with the Board's order.

the Board and serve a copy thereof on opposer. See *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1778 n.11 (TTAB 1999) ("a sanction need not result in entry of a complete and final judgment or even an action which would be akin to a partial judgment. A sanction can consist of requiring a party to take an action which it would not otherwise be required to take by applicable rules, or to refrain from taking an action it otherwise could take"). Any future motion applicant files to extend the time to provide its initial disclosures and/or to extend its time to respond to opposer's present or future discovery requests, absent opposer's written consent, is to be considered denied.

Applicant is allowed until TWENTY DAYS from the mailing date of this order to serve its initial disclosures. As stated above, no further extensions shall be entertained or granted, nor will dates be reset with regard to service of initial disclosures and therefore, applicant should file no such motion with respect to its initial disclosures.

To comply with its initial disclosure obligation, applicant must provide the following information to opposer:

The names of individual officials or employees of a party, and contact information therefor, who are known to have the most extensive knowledge of subjects to support applicant's defenses to the claims in this case; and

General descriptions of and the probable locations of non-privileged documents and things maintained by the party or related to applicant's defenses to the claims in this case.

Service of Outstanding Discovery Responses

Applicant is allowed until TWENTY DAYS from the mailing date of this order to serve responses to opposer's interrogatory requests and requests for production of documents. Applicant will now have had eight months to serve its responses to opposer's interrogatory requests and requests for production, when the federal rules and Board rule allow for 30 days. Fed. R. Civ. P. 33(b)(2) and 34(b)(2)(A); Trademark Rule 2.120(a)(3).

If applicant fails to provide the disclosures and the discovery responses to the current discovery requests, the Board will be favorably disposed to consider any motion for sanctions in the nature of judgment brought by opposer regarding applicant's failure to provide such disclosures and discovery. *Super Bakery Inc. v. Benedict*, 96 USPQ2d 1134, 1136 (TTAB 2010) (noting that failure to serve discovery responses under a Board order specifically directing a party to respond to discovery by a date certain upon pain of further sanctions is very different from the routine obligations arising from the service of discovery requests by an opposing party and can be viewed as an effort to further obstruct the adverse party's rights to obtain discovery under the Board's rules).

Pro se Party

As has been previously stated in the Board's October 28, 2011 order, applicant, as a pro se party, is expected to

comply with all applicable rules and Board practices during the remainder of this case. Applicant is directed to review the Board's order dated October 28, 2011 regarding proceeding on a pro se basis, and to immediately familiarize itself with Board practices and procedures governing this proceeding. Applicant is reminded that it is held to the same standard with regard to compliance with Board practices and procedures as a party represented by counsel.

Proceedings are resumed.

Dates are reset as follows:

Expert Disclosures Due	5/21/12
Discovery Closes	6/20/12
Plaintiff's Pretrial Disclosures	8/4/12
Plaintiff's 30-day Trial Period Ends	9/18/12
Defendant's Pretrial Disclosures	10/3/12
Defendant's 30-day Trial Period Ends	11/17/12
Plaintiff's Rebuttal Disclosures	12/2/12
Plaintiff's 15-day Rebuttal Period Ends	1/1/13

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.