

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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Goodman

Mailed: May 14, 2012

Opposition No. 91199018

Amylin Pharmaceuticals, Inc.

v.

Amlin Health, LLC

Before Zervas, Wellington and Shaw, Administrative Trademark Judges.

By the Board:

This case comes up on the following motions:

- 1) opposer's motion for sanctions, filed April 2, 2012;
- 2) applicant's motions, filed April 5, 2012 and April 15, 2012, to compel initial disclosures; and
- 3) applicant's motion to suspend, filed April 25, 2012.<sup>1</sup>

Motion to Suspend

We turn first to the motion to suspend. Applicant seeks suspension from April 30, 2012 until mid-July 2012 because its authorized representative Mr. Zhang will be out of the country to visit and take care of his elderly mother and on return to the United States on June 20, 2012, Mr. Zhang seeks to relocate or move from Maryland. Applicant

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<sup>1</sup> Applicant also filed on April 23, 2012, a copy of discovery requests served on opposer on April 23, 2012. However, written discovery should not be filed with the Board except under circumstances specified in Trademark Rule 2.120(j)(8).

states that "[i]t is inconvenient [for Mr. Zhang] to access Internet while overseas" and that with regard to Mr. Zhang's move "[i]t will take about one week for moving and . . . some time to settle down . . . . Applicant may not be able to work properly as usual."

A party may seek suspension of proceedings for good cause upon motion. Trademark Rule 2.117(c).

Upon considering the matter, we find that applicant has not established good cause for suspension. As we advised applicant previously, in the October 28, 2012 order, if applicant's representative was out of the country it had a duty to "appoint someone in its representative's absence." In the March 9, 2012 order we reiterated "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." In respect to the motion to suspend, applicant has not provided sufficient factual information to establish that another authorized representative cannot act on its behalf during Mr. Zhang's period of unavailability. Accordingly, we find that applicant has failed to establish good cause for suspension.

In view thereof, the motion to suspend is denied.

Motion to Compel

We turn next to applicant's motions to compel. Applicant's initial motion to compel (filed April 5, 2012) sought opposer's initial disclosures, while applicant's second motion to compel (filed April 15, 2012)<sup>2</sup> seeks a "recent version of the Initial Disclosure."

With regard to applicant's first motion to compel, applicant complains that opposer "failed to properly serve" initial disclosures as the disclosures were not served on applicant directly but were served on applicant's counsel.

In response, opposer argues that applicant failed to make a good faith effort to resolve the dispute. Opposer further argues that it "timely served Applicant's then counsel with Opposer's Rule 26 Initial Disclosures by e-mail and mail." Opposer argues that applicant's motion to compel should be denied.<sup>3</sup>

We find that applicant failed to make a good faith effort to resolve the discovery dispute prior to filing the motion as the record reflects that applicant did not contact opposer to discuss the discovery dispute prior to filing the motion but contacted opposer after it filed the motion with

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<sup>2</sup> The motion was contained in applicant's response to opposer's motion for sanctions.

<sup>3</sup> Opposer states that upon receipt of this motion, opposer's counsel provided applicant with another copy of these June 23, 2011 disclosures and requested that applicant withdraw its motion.

the Board. Opposer's Exhibit B, opposer's April 19, 2012 response. But even if we were to consider the motion, it is not well taken, inasmuch as opposer properly and timely served the initial disclosures on counsel since applicant was represented by counsel at the time. See Trademark Rule 2.119(b) ("Service of papers must be on the attorney or other authorized representative of the party if there be such or on the party if there is no attorney or other authorized representative"). Accordingly, the motion to compel opposer's initial disclosures is denied.

With regard to applicant's second motion to compel, which seeks opposer's "recent" initial disclosures, the Board construes this motion as one to compel supplemental initial disclosures.

Applicant argues that opposer "disregarded and did not comply with the Board's March 9, 2012 Order" and that applicant had to request the disclosure from opposer as opposer failed to meet the March 29, 2012 deadline set by the Board. Applicant further states that the June 23, 2011 initial disclosures that opposer provided were not the "correct requested document" or a "recent version of the Initial Disclosure."

In response, opposer argues that applicant failed to confer with opposer prior to filing the motion as required by the Trademark Rules. Opposer further argues that

applicant has a "misguided view that the Board's March 9 Order applied to Opposer" and that applicant's request for initial disclosures is "bogus" and should be denied.

Based on the parties' April 10, 2012 e-mail exchange, we find that applicant made a good faith effort to resolve the dispute prior to filing the motion. Exhibit C, opposer's April 19, 2012 response.

However, we find that applicant's motion is not well taken inasmuch as opposer was not required by the Board's March 9, 2012 order to serve supplemental initial disclosures, and in any event, applicant has failed to establish that the original disclosures are incomplete and incorrect such that supplementation is necessary.

In view thereof, applicant's motion to compel opposer's supplemental initial disclosures is denied.

Motion for sanctions

We now turn to the motion for sanctions.

The Board's order dated March 9, 2012, ordered applicant to serve its initial disclosures and to provide discovery responses to opposer's outstanding discovery requests within 20 days from the mailing date of the order. The order further stated that "[i]f 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. . . ."

In support of its motion for sanctions, opposer argues that applicant failed to comply with the Board's March 9, 2012 discovery order. In particular, opposer submits that while it did receive applicant's initial disclosures, they were served by e-mail, which was not the agreed method of service (first class mail), and therefore the disclosures were not properly served on opposer. With regard to the outstanding discovery responses, opposer advises that it has received no discovery responses from applicant and that "Applicant has made no mention of the discovery responses" in e-mails sent by applicant since the deadline. Opposer argues that judgment should be entered against applicant due to its failure to comply with the Board's March 9, 2012 order.

In response, applicant "requests the Board refuses and does not grant [sic] Opposer's Motion for Discovery Sanctions to prevent any misuse of the Board's time and resources." Applicant also argues that "[t]he way to better communicate and serve between Applicant and Opposer should be re-discussed and rethought" as applicant prefers e-mail.

In reply, opposer argues that "Applicant has not provided any explanation for its failure to respond to Opposer's discovery requests" and that applicant "in no way

addresses Opposer's Motion for Sanctions for violation of the Board's Order . . . and offers no argument to rebut Opposer's Motion."

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 judgment. *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848 (TTAB 2000); and TBMP Section 527.01 (3d ed. 2011). Entry of judgment is a harsh remedy, but it is justified where no less drastic remedy would be effective and there is a strong showing of willful evasion. *See Unicut Corp. v. Unicut, Inc.*, 222 USPQ 341 (TTAB 1984).

Courts have found noncompliance with a discovery order to be willful "when the court's orders have been clear, when the party has understood them, and when the party's noncompliance is not due to factors beyond the party's control." *Nieves v. City of New York*, 208 F.R.D. 531, 536 (S.D.N.Y. 2002) citations omitted.

We find that the Board's order of March 9, 2011, was clear in that it directed applicant to serve its initial disclosures and responses to opposer's current discovery within twenty days of the mailing date of the March 9, 2012 order, i.e., no later than March 29, 2012. We also find

that applicant understood the order. Applicant did provide its initial disclosures to opposer by the March 29, 2012 deadline; however, applicant failed to serve discovery responses by the March 29, 2012 deadline, and it did not seek an extension of time to respond.

We do not find that applicant's improper service by e-mail of the initial disclosures resulted in substantial noncompliance of the Board's March 9, 2012 order. However, we do find that applicant failed to substantially comply with the Board's March 9, 2012 discovery order by not serving responses to opposer's outstanding discovery requests by March 29, 2012.

Applicant's response to the motion for sanctions provides no explanation for its failure to comply with the Board's March 9, 2012 order. Applicant's response does not indicate an inability to comply with the Board's order due to circumstances outside of its control; applicant has not indicated any problems it encountered that prevented it from serving responses to opposer's outstanding discovery requests by the March 29, 2012 deadline.

We warned applicant that noncompliance with the Board's March 9, 2011, order risked the sanction of entry of judgment. We find that applicant's unexplained failure to serve responses to opposer's outstanding discovery requests under the Board's March 9, 2012 discovery order is

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unjustified in the face of an explicit warning from the Board. Applicant's persistent failure in complying with the discovery in this proceeding, and its failure to serve discovery responses as ordered, even after an admonition that judgment could be entered against it as a sanction for noncompliance, compels the conclusion that applicant's noncompliance in serving discovery responses was willful.

Accordingly, the Board finds that applicant has willfully evaded the Board's March 9, 2012 discovery order and the sanction of dismissal is appropriate.

In view thereof, opposer's motion for sanctions in the form of entry of judgment is granted.

Judgment is hereby entered against applicant, the opposition sustained, and registration to application Serial No. 85094790 is refused.