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

Proceeding	91205331
Party	Plaintiff Ms. Teresa H. Earnhardt
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Date	12/20/2013
Attachments	Earnhardt Response to Motion to Dismiss 91205331_1.PDF(100982 bytes)

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

Teresa H. Earnhardt,

Opposer,

v.

Kerry Earnhardt, Inc.,

Applicant.

Consolidated Opposition Nos.
91205331 (parent) and 91205338

In the matter of:

Application Serial No. 85/383,910
Mark: EARNHARDT COLLECTION
(Intl. Class 20)

Application Serial No. 85/391,456
Mark: EARNHARDT COLLECTION
(Intl. Class 37)

**OPPOSER'S RESPONSE TO APPLICANT'S
MOTION TO DISMISS OR COMPEL**

Opposer, Teresa H. Earnhardt, hereby responds to *Applicant's Motion To Dismiss As A Sanction For Opposer's Failure To Appear At Her Deposition And Alternative Second Motion To Compel* (the "Motion") filed December 4, 2013, by Applicant, Kerry Earnhardt, Inc. In doing so, Opposer will demonstrate that Applicant's request for sanctions is procedurally premature. Accordingly, Applicant's motion to dismiss should be denied.

In support of its motion for dismissal, Applicant relies upon and purports to quote verbatim from 37 CFR § 2.120(g)(2). More particularly, Applicant argues as follows:

Trademark Rule 2.120(g) provides, in pertinent part, that the Board may impose sanctions in the event "a party...fails to attend the party's...discovery deposition, after being served with proper notice." See 37 C.F.R. § 2.120(g)(2). These sanctions include

* * *

“dismissing the action or proceeding in whole or in part”...*See* 37 C.F.R. § 2.120(g)(1) (providing that Board may impose the sanctions set forth in Fed. R. Civ. P. 37(b)(2)).

Motion, pp. 4-5.

However, Applicant misreads 37 CFR § 2.120(g)(2) which actually provides, in relevant part:

If a party...fails to attend the party’s...discovery deposition, after being served with proper notice...the Board may make any appropriate order, as specified in paragraph (g)(1) of this section.

37 CFR 2.120(g)(2). In turn, paragraph (g)(1) of 37 CFR § 2.120 provides:

If a party fails to comply with an *order* of the Trademark Trial and Appeal Board relating to discovery...the Board may make any appropriate order, including those provided in Rule 37(b)(2) of the Federal Rules of Civil Procedure.

37 CFR 2.120(g)(1) (emphasis added). Accordingly, it is paragraph (g)(1) of 37 CFR § 2.120 which permits the Board to enter a sanctions order, including an order for dismissal or one of the other sanctions identified in Rule 37(b)(2), F.R.Civ.P., *after* a party fails to comply with an *order* of the Trademark Trial and Appeal Board.

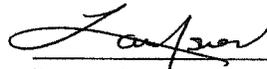
Thus, the procedural requirement for obtaining a discovery-related sanctions order from the Board in an opposition proceeding mirrors the procedural requirement for such an order under the Federal Rules of Civil Procedure. *I.e.*, the movant must first seek and obtain from the Board an order compelling specific discovery before the movant may seek or obtain an order sanctioning the respondent for a discovery-related failure. *See, e.g., Nobelle.com LLC v. Quest Communications International Inc.*, 66 USPQ2d 1300, 1303 (request to preclude party from submitting trial evidence as a sanction for its alleged failure to comply with discovery obligations was procedurally baseless where no discovery order was violated or even issued). *See also Amazon Technologies v. Wax*, 93

USPQ2d 1702, 1706 (TTAB 2009) (motion for sanctions under 37 CFR § 2.120(g)(1) denied as premature where no Board order in place compelling discovery); *Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC*, 88 USPQ2d 1541, 1543 (TTAB 2008) (sanction premature without preceding order compelling discovery).

Accordingly, Applicant's request for sanctions, in the form of dismissal or otherwise, is procedurally baseless and should be denied.

Dated: December 20, 2013

Respectfully submitted,

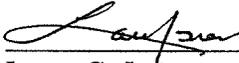


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CERTIFICATE OF SERVICE

I hereby certify that on the foregoing *Opposer's Response to Applicant's Motion to Dismiss or Compel* was duly served on Applicant by depositing a copy of same in the United States mail, first-class postage prepaid, on the 20th day of December, 2013 addressed to Applicant's attorneys of record as follows:

D. Blaine Sanders
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By: 

Larry C. Jones