

THIS OPINION IS NOT A  
PRECEDENT OF THE  
TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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Alexandria, VA 22313-1451  
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BUO

Mailed: May 28, 2015

Opposition No. 91214649

*Noodle Time, Inc.*

*v.*

*Benny Hodge*

**Before Kuhlke, Taylor, and Hightower, Administrative Trademark Judges.**

**By the Board:**

This case comes up on Opposer's motion for discovery sanctions, filed January 29, 2015. Applicant filed an opposition to the motion on February 13, 2015.<sup>1</sup> The motion has been fully briefed.<sup>2</sup>

On January 27, 2014, Noodle Time, Inc. filed a notice of opposition alleging likelihood of confusion with, and dilution of, Opposer's registered marks BENIHANA, in standard character format,<sup>3</sup> and:

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<sup>1</sup> On January 25, 2015, Applicant filed a motion to suspend the proceeding pending disposition of a civil action involving the parties, 10 TTABVUE; however, Applicant withdrew the motion on February 13, 2015. 14 TTABVUE.

<sup>2</sup> Applicant's "Response To Reply In Support Of Opposer's Motion For Entry Of Judgement [sic] As A Sanction," filed February 25, 2015, has been given no consideration because a nonmovant is only entitled to file an opposition to a motion, and is not entitled to file a "reply" brief or a surreply. See Trademark Rule 2.127(a) (after the movant's reply brief, "[t]he Board will consider no further papers in support of or in opposition to a motion"); TBMP § 502.02(b) (2014). Consequently, Opposer's motion to strike Applicant's surreply, filed February 26, 2015, and Applicant's response thereto, filed March 6, 2015, are rendered moot.



and



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<sup>3</sup> Registration No. 1230609, issued March 8, 1983, from an application filed April 13, 1982, for “restaurant services.”

Registration No. 1371624 , issued November 19, 1985, from an application filed December 10, 1982, for “sake.”

Registration No. 1412570, issued October 7, 1986, from an application filed March 5, 1986, for “wines, namely, plum wine; and spirits, namely, sake.”

Registration No. 3784161, issued May 4, 2010, from an application filed September 17, 2009, for “drinking mugs.”

Registration No. 3928737, issued March 8, 2011, from an application filed September 8, 2010, for “franchise services, namely, offering business management assistance in the establishment and operation of restaurant and bar services.”

All of the foregoing registrations contain a statement that the English translation of the word BENIHANA is “red flower.”

<sup>4</sup> Registration No. 2029115, issued January 7, 1997, from an application filed April 29, 1994, for “edible oils and fats.” The registration contains a statement that the non-Latin characters in the mark transliterate to “BENI HANA”, and this translates into English as “red flower.”

<sup>5</sup> Registration No. 2058184, issued April 29, 1997, from an application filed July 18, 1995, for “restaurant services.” The registration contains a disclaimer of the term GRILL.

<sup>6</sup> Registration No. 2119770, issued December 9, 1997, from an application filed December 6, 1996, for “restaurant services.” The registration contains a disclaimer of the term GRILL, and a statement that the English translation of BENIHANA is “red flower.”

Opposer served Applicant with a first set of discovery requests on June 13, 2014. Applicant responded to those requests on July 13, 2014. However, Opposer noted certain deficiencies in Applicant's responses to its requests in a letter dated July 29, 2014, outlining the outstanding discovery requests that Opposer contended needed to be supplemented. In addition to several interrogatories which Opposer alleged Applicant to have insufficiently responded to, Opposer also noted that Applicant had not produced any documents in response to its document requests. Opposer made a subsequent status inquiry as to the deficient responses by email on August 19, 2014. On September 4, 2014, Opposer filed a motion to compel responses to its outstanding discovery requests. On November 4, 2014, having received no response from Applicant, the Board granted Opposer's motion as conceded and ordered Applicant to serve responses to Opposer's cited discovery requests without objection within thirty days.

On November 19, 2014, Applicant requested reconsideration of the Board's order, and asserted newly raised arguments contesting the motion to compel. The Board, in its order issued December 5, 2014, noted that Applicant failed to articulate any error in the Board's application of the relevant law in its granting of the motion to compel as conceded; and that Applicant had yet to offer any viable explanation as to his failure to respond to Opposer's motion to compel. Instead, Applicant, in his request for reconsideration, advanced arguments directed against the motion to compel that could have, and should have, been advanced during the time allowed to respond to that motion. The Board consequently denied Applicant's

request for reconsideration, and ordered Applicant to serve its supplemental responses as directed in the prior order within twenty days of the issuance of that order. In both its November 4, 2014, and December 5, 2014 orders, the Board informed Applicant that failure to comply with its orders may result in the entry of sanctions against him pursuant to Trademark Rule 2.120(g) and Fed. R. Civ. P. 37(b), including the entry of judgment. Additionally, Applicant was specifically instructed that interrogatories were to be answered fully and completely and proper response to a document request requires the responding party to state whether responsive documents exist or not, and if so, that either they will be produced or will be withheld on a claim of privilege. 9 TTABVUE 6 and 8.

On January 29, 2015, Opposer filed a motion for sanctions based on Applicant's failure to comply with the Board's November 4, 2014, and December 5, 2014 orders.

In support of its pending motion for discovery sanctions, Opposer asserts that following the Board's December 5, 2014 order, Applicant served Opposer with "his Supplemental Answers to [Opposer's] First Set of Interrogatories and Production of Document Request [sic] ("Supplemental Responses")." 11 TTABVUE 4. However, Opposer contends that Applicant's Supplemental Responses "are virtually identical in substance to Applicant's initial discovery responses," and "also fail to include ANY documents in response to Opposer's First Set of Document Requests." *Id.* at 4-5. Opposer asserts that prior to filing its motion for sanctions it made an additional effort to resolve this issue with Applicant by emailing Applicant again on January 20, 2015, but that it has received no further communication, including responses to

Interrogatory Nos. 1-3, 5-8, and 11 and Document Request Nos. 1-4, 9-12, 14 and 15. Because Applicant has not complied with the Board's orders of November 4, 2014, or December 5, 2014, Opposer seeks entry of judgment as a sanction.

In the event the Board does not grant its motion, Opposer requests that, because it "cannot realistically proceed to summary judgment or trial until the Board determines an appropriate sanction ... [the] proceedings be suspended pending determination of this Motion ... [and] the discovery period be reset for [Opposer] only to provide a reasonable time (at least 30 days from any deadline for actual receipt of responsive documents or other information) for [Opposer] to take depositions." 11 TTABVUE 6. Finally, Opposer requests "such other relief as the Board deems appropriate." *Id.* at 7.

In response to the motion, Applicant asserts that "[t]o the best of Applicants [sic] knowledge documents that were available where [sic] served to Opposer." 14 TTABVUE 3. Applicant indicates that the "Definitions and Instructions" included in Opposer's First Set of Interrogatories to Applicant contributed to the deficient responses inasmuch as they described "documents" as "Internet websites, social media accounts, [and] social media profiles," which presumably prompted Applicant to respond with URL links. This contention is apparently meant to justify Applicant's response to Opposer's Document Request No. 4, which requested "documents sufficient to identify all trade channels through which" Applicant intends to offer the services covered by the applied-for mark, to which Applicant responded with a string of URL links. Nonetheless, Applicant offers no explanation

for his failure to appropriately respond to the cited interrogatories, e.g. Interrogatory No. 11, which includes five subparts, to which Applicant provided a scant one-sentence response; or to properly address and produce documents responsive to Opposer's nine other document requests. Instead, Applicant submits that no sanction is warranted because Applicant "[t]o the best of [his] knowledge and resources" has provided "all documents ... that are available to [him] and/or exist" as required by the Board's orders. 14 TTABVUE 4.

Trademark Rule 2.120(g)(1) provides, in pertinent part:

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

"The sanctions which may be entered by the Board pursuant to Rule 2.120(g)(1) include striking all or part of the pleadings of the [noncomplying] party; refusing to allow the noncomplying party to support or oppose designated claims or defenses; prohibiting the [noncomplying] party from introducing designated matters in evidence; and entering judgment against the [noncomplying] party." *HighBeam Marketing, LLC v. Highbeam Research, LLC*, 85 USPQ2d 1902, 1904 (TTAB 2008).

Here, the Board did not order Applicant to re-serve its initial responses to Opposer's First Set of Interrogatories and Document Requests, but instead to supplement its responses with complete and accurate responses to the inquiries cited by Opposer in its motion to compel and to produce such responsive documents as may exist, or to indicate in its responses that no such documents exist. Notably,

Applicant makes little effort to contest Opposer's assertions that many of Applicant's responses to the cited interrogatories remain deficient. Accordingly, Opposer's motion for sanctions is **GRANTED** in part.

Opposer requests the sanction of judgment in its favor, but because Applicant made an effort to comply with the Board's order, albeit an insufficient effort, entering judgment in Opposer's favor is inappropriate under these circumstances. *Amazon Techs. Inc. v. Wax*, 95 USPQ2d 1865, 1868-69 (TTAB 2010).

Therefore, as Opposer requested, and as is within the Board's discretion in such an instance, we will grant relief as we deem appropriate. In doing so we recognize the difficulty Opposer has had in obtaining relevant information regarding Applicant's defense of the allegations contained in the notice of opposition, and find that Applicant should be barred from producing evidence on certain points or relying in any way on discovery produced after the Board's extended deadline of December 26, 2014.

Accordingly, as a sanction for Applicant's failure to comply with the Board's discovery order issued December 5, 2014, Applicant is prohibited from introducing at trial or relying upon any answers or documents not produced to Opposer prior to the December 26, 2014 deadline. Additionally, Opposer's alternative request to have discovery reopened for the limited purpose of allowing Opposer to depose Applicant is **GRANTED**. Accordingly, the discovery period is reopened for **THIRTY DAYS for Opposer only**, for the limited purpose of conducting the deposition of

Applicant. Moreover, Applicant remains under a duty to supplement his responses to Opposer's discovery requests pursuant to Fed. R. Civ. P. 26(e)(1) and (2).

Applicant is again reminded that **strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, is expected of all parties before the Board, whether or not they are represented by counsel.** If Applicant should run afoul of these rules, this order, or any future orders issued by the Board, judgment may be entered in Opposer's favor and against Applicant on both of Opposer's claims.

Remaining disclosure and trial dates are reset as follows:

Plaintiff's Pretrial Disclosures	<b>7/20/2015</b>
Plaintiff's 30-day Trial Period Ends	<b>8/3/2015</b>
Defendant's Pretrial Disclosures	<b>8/18/2015</b>
Defendant's 30-day Trial Period Ends	<b>10/2/2015</b>
Plaintiff's Rebuttal Disclosures	<b>10/17/2015</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>11/16/2015</b>

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.