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

Mailed: December 22, 2015

Opposition No. 91219616

Prudential Insurance Company of America

v.

Daryl Bank

Before Mermelstein, Kuczma and Adlin,
Administrative Trademark Judges.

By the Board:

This case now comes up on Opposer's motion for sanctions, filed August 4, 2015. The motion is fully briefed.[1]

Opposer's Motion

Opposer seeks sanctions on the ground that Applicant brandished a gun against Opposer's process server, who was attempting to serve subpoenas in this proceeding, and that Applicant has been generally uncooperative during discovery, including during his discovery deposition. We have carefully considered all of the parties' arguments and presume the parties' familiarity with the factual bases for their filings, and do not recount the facts or arguments here, except as necessary to explain our decision.

[1] We give no consideration to Applicant's surreply, filed October 5, 2015, because surreplies are prohibited. *See* Trademark Rule 2.127(a) and TBMP § 517 (2015).

With respect to Applicant's conduct during his discovery deposition, Opposer attached to its motion portions of the transcript demonstrating that Applicant asserted his own purported objections, notwithstanding that he is represented by counsel, including during his deposition, and purported to "read" a newspaper upside down during his deposition, while advising Opposer's counsel that he could "multitask." Motion, Exhibit I, 5:16-23, 11:21-25, 49:23-25, and 96:20-25. This conduct is wildly inappropriate at best, and it is troubling that Applicant's counsel did not even attempt to rein in his client, much less succeed in doing so. But Opposer has not filed a motion to compel Applicant to answer any specific questions, and indeed has acknowledged that "[d]espite [Applicant's] lack of cooperation" it learned valuable information during the deposition. *Id.* at p. 6.

Opposer also asserts that Applicant served his initial disclosures 11 days late, produced only two documents in response to 37 document requests, failed to verify his interrogatory responses and did not provide a privilege log despite objecting to many of Opposer's requests for production on grounds of attorney client privilege and attorney work product.[2] *See id.* at pp. 4-5. Sanctions based on such deficiencies, however, are in the nature of discovery sanctions, and a party may not obtain discovery sanctions unless its adversary has violated "an order of the Trademark

[2] Opposer also argues that Applicant's discovery responses were untimely. In support of this position, Opposer asserts that it served its first set of interrogatories and document requests via email on February 19, 2015, and that Applicant did not serve responses until March 24, 2015. Opposer's discovery requests, however, were procedurally improper because Opposer served them prior to serving its initial disclosures on March 13, 2015. *See* Motion, Exhibit C and Trademark Rule 2.120(a)(3) ("A party must make its initial disclosures prior to seeking discovery…."). We deem Opposer's discovery requests as having been served on March 13, 2015 – the day Opposer served its initial disclosures – and as such, Applicant's discovery responses, served March 24, 2015, are timely.

Trial and Appeal Board relating to disclosure or discovery," Trademark Rule 2.120(g)(1), or flatly refuses to participate in discovery, Trademark Rule 2.120(g)(2). Here, the Board has not issued any discovery order nor has Opposer requested such an order. Further, although Opposer complains of the adequacy of Applicant's discovery responses, Applicant has not refused to provide any responses at all. Accordingly, Opposer's motion is premature.

We now turn to the disheartening incident between Applicant and Opposer's process server. On July 14, 2015, pursuant to Opposer's request, the United States District Court for the Southern District of Florida (the "District Court") issued subpoenas for: (1) Dominion Diamonds, LLC ("DDL") – a third-party company that Applicant has identified as having an ownership interest in the involved mark – "c/o Daryl Bank," Motion at Exhibit G, Applicant's Responses to Interrogatories 1 and 2 and Exhibit L; and (2) Applicant's wife, Catrina Davis, whom Applicant has identified as "the point person" for DDL's marketing. *Id.* at Exhibit I, 63:25 - 64:17 and Exhibit L.

Process server Elizabeth McIntyre attempted to serve the subpoenas on DDL and Ms. Davis at DDL's business address on Friday July 17, 2015 and again on Monday, July 20, 2015, but she was unsuccessful. *See id.* at Exhibit M, McIntyre Affidavit, ¶¶ 4-6. Accordingly, Ms. McIntyre's colleague Marcia Gillings attempted to serve Ms. Davis and DDL at Applicant's home in Florida. *See id.* at Exhibit N, Gillings Affidavit, ¶ 6.

Ms. Gillings attests that: (1) she went to the front door of Applicant's home, which was open, and as she was attempting to serve the subpoenas, Applicant pointed a handgun at her, accused her of trespassing, and called her a "whore," *id.* at ¶¶ 14-15; (2) she "immediately turned, dropped the papers and walked back to [her] car," but Applicant started "running toward" her car "in a menacing manner carrying the papers," *id.* at ¶ 16; (3) Applicant "ran to the passenger side window" of her car and "threw some of the papers into [her] car" as she drove away, *id.*; and (4) she called 911 and reported the incident to police. *Id.* at ¶ 17 and Exhibit 2 thereto. After speaking with both Ms. Gillings and Applicant, the police concluded that Ms. Gillings did not commit burglary or trespass, and found probable cause to arrest Applicant for resisting an officer with violence to his or her person, aggravated assault, and assault or battery on a person 65 years old or older. *See id.* at Exhibit R, p. 3. Applicant was subsequently arrested and charged with aggravated assault with a deadly weapon and assault on a person 65 years old or older – both felonies – and the court issued a restraining order prohibiting Applicant from coming within close proximity of Ms. Gillings. *See id.* at pp. 5 and 7.

Opposer argues that this "outrageous act … deserves the harshest sanction [of judgment against Applicant] to protect the sanctity of this process and the safety of its participants." *Id.* at p. 1. If the Board does not enter judgment against Applicant, Opposer requests that the Board:

- Deem all previously noticed witnesses as served and compel their appearance for deposition, *id.* at p. 14;

- Order that "[a]ll depositions be conducted at Applicant's expense at the Sheriff's Office or police department closest to the deponent's residence or place of employment," *id.*;
- Prohibit Applicant from being designated as the 30(b)(6) witness for DDL or third-party company Dominion Investment, *id.*;
- Order that "Applicant not be allowed to be within 1,000 yards of any of Opposer's agents and representatives during the remainder of these proceedings," *id.* at p. 15; and
- Extend discovery by two months. *Id.* at pp. 2 and 17.

The Board finds Opposer's allegations shocking, but we decline to make any factual determinations regarding exactly what happened at Applicant's home in Florida. Opposer's grievance is more properly before the District Court that issued the subpoena because Applicant's alleged conduct is an affront to the District Court's authority. *See PRD Elecs. Inc. v. Pac. Roller Die Co.*, 169 USPQ 318, 319 n.3 (TTAB 1971) (opposer's allegation that applicant defied a subpoena to produce witnesses is a matter that opposer should have pursued before the court that issued the subpoena). *Cf. Ate My Heart v. GA GA Jeans*, 111 USPQ2d 1564, 1565 n.5 (TTAB 2014) ("The Board has no jurisdiction over depositions of non-parties by subpoena…."). The District Court will no doubt want to learn about Applicant's conduct and has the jurisdiction and powers necessary to fully address it.

Moreover, short of judgment, the range of sanctions that we may impose is limited. For example, we cannot compel a third party witness to appear for

deposition or issue a restraining order, as Opposer requests. The District Court may impose such remedies, and more if it deems them justified, and therefore is the necessary and appropriate forum for addressing Opposer's concerns.

In view of the foregoing, Opposer's motion for sanctions is **DENIED WITHOUT PREJUDICE** pending Opposer bringing Applicant's conduct to the attention of the District Court.[3] Nevertheless, we understand Opposer's reluctance to further engage Applicant in this proceeding. For this reason, as well as those discussed below, the parties should utilize Accelerated Case Resolution in an attempt to resolve this dispute.

Accelerated Case Resolution ("ACR")

The ACR process is similar to summary judgment whereby parties submit briefs with evidence attached; however in an ACR proceeding, the parties agree to try the case via their briefs, declarations, and other evidence, and to allow the Board to resolve any genuine disputes of material fact raised by their filings or the record. As such, in cases where the parties adopt ACR, the Board is able to weigh the parties' evidence, make factual determinations and issue a final judgment.

The Board specifically proposes bifurcating Opposer's likelihood of confusion and dilution claims and utilizing ACR with respect to Opposer's likelihood of confusion claim.[4] *See Franpovi, S.A. v. Rosalinda Wessin and Daniel Pena*, 89 USPQ2d 1637,

[3] After the District Court issues or declines to issue any order arising out of Applicant's conduct, the Board may invite Opposer to renew its motion, if appropriate, depending on what action the District Court takes. Suffice it to say, the Board has an interest in ensuring that this proceeding is conducted appropriately, and perhaps even more importantly, that incidents like the one at issue do not recur.

[4] The parties, however, may choose to pursue ACR with respect to both of Opposer's claims.

1638 and 1640 (TTAB 2009) (acknowledging prior order bifurcating opposer's claims, deciding the parties' cross-motions for summary judgment on opposer's claim under the Santiago Convention and resuming proceedings with respect to opposer's bifurcated claim under the foreign well-known mark doctrine). Proceeding in this manner may significantly reduce costs for both parties and obviate the need for Opposer to have further significant contact with Applicant.

Opposer's likelihood of confusion claim is straightforward and particularly well-suited to ACR. In any likelihood of confusion case, the most important factors are typically the similarities between the parties' marks and the relationship between their respective goods or services.[5] *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

The parties' marks are as depicted in the drawings of the involved application and in Opposer's pleaded registrations, and no additional evidence on this factor is required. Similarly, in assessing the similarities between the parties' goods and services we may consider only the goods and services as set forth in the intent to use application, so no additional evidence on this factor is necessary. We may not consider any evidence regarding the particular nature of Applicant's goods and services, the particular channels of trade, or the classes of purchasers to which sales of the goods and services are directed. *See Octocom Syst. Inc. v. Houston Computers*

[5] The Board recognizes that the parties may submit evidence probative of additional *duPont* factors.

Svcs. Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Moreover, absent trade channel restrictions in the parties' identifications of goods and services we must presume that the parties' goods and services move in all channels of trade normal for those goods and services of that type, and that they are available to all classes of purchasers for those goods and services. *See Paula Payne Prods. Co. v. Johnson Publ'g Co.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973); *Kalart Co. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958); *In re Linkvest S.A.,* 24 USPQ2d 1716, 1716 (TTAB 1992).

If Opposer prevails on ACR, the opposition will be sustained and registration to Applicant will be refused, making it unnecessary to resolve Opposer's other claims. If, however, Opposer's likelihood of confusion claim is dismissed, Opposer will be allowed thirty days to inform the Board whether it wishes to proceed with its dilution claim, and if Opposer decides to proceed, the Board will resume proceedings and extend discovery.

The parties are required, within **THIRTY DAYS** from the mailing date of this order, to contact the Interlocutory Attorney assigned to this case to arrange an ACR conference. In view of the serious allegations regarding Applicant's conduct in this proceeding, Applicant, who is represented by counsel, may not participate in the teleconference.

Finally, the parties are strongly reminded that proceedings before the Board are to be "conducted with decorum and courtesy." Trademark Rule 2.192. Although out of the physical presence of the Board during nearly all of a proceeding, parties are

nonetheless expected to meet the standard of Trademark Rule 2.192 in their activities taken in prosecuting or defending a Board proceeding.

Proceedings otherwise remain suspended.

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