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

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|------------------------|---|
| Proceeding | 91220281 |
| Party | Plaintiff Iron Horse Saloon, Inc. |
| Correspondence Address | KELLY PARSONS KWIA TEK COBB COLE PA 149 S RIDGEWOOD AVENUE DAYTONA BEACH, FL 32114 UNITED STATES heather.vargas@cobbcole.com, kelly.parsons@cobbcole.com, sharon.rosati@cobbcole.com, michele.staples@cobbcole.com |
| Submission | Motion for Sanctions |
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| Signature | /Kelly Parsons Kwiatek/ |
| Date | 11/02/2015 |
| Attachments | Motion to TTAB for Sanctions against Wentura (01933822).PDF(507765 bytes) |

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

Iron Horse Saloon, Inc.,

**Opposition No. 91220281
Serial No 86208174**

Opposer,

v.

**Mark Wentura
d/b/a The Iron Horse Clothing, Inc.,**

Applicant.

OPPOSER'S MOTION FOR SANCTIONS

Pursuant to 37 C.F.R. §1.120(g)(1) of the Trademark Rules of Practice, Trademark Trial and Appeal Board Manual of Procedure §411.05, and Fed. R. Civ. P. 37(b)(2), Opposer, Iron Horse Saloon, Inc., moves the Trademark Trial and Appeal Board ("TTAB") to sanction Applicant, Mark Wentura d/b/a The Iron Horse Clothing Company for failing to provide his Initial Disclosures or respond to discovery requests and states as follows:

Background

1. Opposer is the owner of the mark *Iron Horse Saloon* (Registration No. 2,365,882) in International Class 25 for clothing, namely t-shirts, jackets, bandanas, sweatshirts, sweatpants, sports shirts, and caps. Opposer disclaimed the exclusive right to use "Saloon" apart from in the mark.

2. Opposer's filing date for its registration of the mark *Iron Horse Saloon* is November 24, 1998, with its first use in commerce in 1979.

3. Applicant filed an application to register the phrase *The Iron Horse Clothing Company* on February 28, 2014, and claims first use in commerce as August 15, 2011.

4. Applicant filed its application for the phrase *The Iron Horse Clothing Company* (Serial No. 86,208,174), disclaiming "Clothing Company," in International Class 25 for clothing, namely, belts, denim jackets, denims, shirts, and tops.

Procedural History

5. On January 21, 2015, Opposer timely filed its Notice of Opposition, and on February 23, 2015, Applicant filed its Answer to Notice of Opposition.

6. After an extension of time was granted, discovery opened on April 13, 2015, and the deadline for serving initial disclosures was set for May 13, 2015.

7. On May 13, 2015 Opposer promptly served its initial disclosures on Applicant. To date, Applicant has not served its initial disclosures.

8. On June 18, 2015, Opposer served Opposer's First Set of Interrogatories to Applicant and Opposer's First Request for Production to Applicant, which were due on July 21, 2015. To date, there has been no response by Applicant to either Opposer's First Set of Interrogatories to Applicant or Opposer's First Request for Production.

9. Opposer made a good faith effort to resolve the discovery dispute with Applicant by e-mailing him on July 23, 2015, at the e-mail address on file and used by Applicant in the instant matter, and Applicant did not and has not responded in any way. A copy of that email is attached as Exhibit A.

10. On July 28, 2015, Opposer filed a motion compel initial disclosures and discovery responses.

11. On August 3, 2015 the TTAB issued an order suspending the proceedings pending disposition of Opposer's motion to compel. The order specifically noted that it did

not toll the time to respond to outstanding discovery requests. No response of any kind whatsoever was received from Applicant.

Applicant's Answer to Notice of Opposition

12. As it has not participated in the discovery process, Applicant's filings in this matter are limited to its Answer to Notice of Opposition ("Answer"), where it listed five separate so-called affirmative defenses but all of which are denials or not applicable to this proceeding.

13. Applicant's First Affirmative Defense states that Opposer will not suffer any damages by the registration of Applicant's mark. However, there is a substantial likelihood of confusion between the two marks, as evidenced by the use of "Iron Horse" in both marks all in association with clothing. This leads to lost sales and damage to the goodwill and reputation of the Iron Horse Saloon, Inc.

14. Applicant's Second Affirmative Defense alleges that there is no likelihood of confusion, mistake, or deception between the opposed mark and the mark of Opposer. Applicant also alleges that there are sufficient differences between the marks and the trade channels used.

- a. Opposer contends that the phrase *The Iron Horse Clothing Company* is very similar in sight, sound, connotation and commercial impression to the mark, *Iron Horse Saloon*, which is owned and used by the Opposer on and in association with clothing.
- b. Upon information and belief, Applicant is offering goods bearing the phrase *The Iron Horse Clothing Company* in the same trade channels and to the same consumers as Opposer, including retail and online sales throughout the country.

Applicant's failure to participate in the discovery process in any meaningful way has prejudiced Opposer in their efforts to verify Applicant's trade channels.

15. Applicant's Third Affirmative Defense is that the mark was applied for in good faith. Applicant's alleged good faith in its application has no bearing on the mark being similar to that of Opposer. Further, Applicant's complete unwillingness to participate in the discovery process is not reflective of good faith intent.

16. Applicant's Fourth Affirmative Defense states that Opposer's mark is not famous. Opposer's mark being famous is not relevant to these proceedings, as Opposer is not claiming dilution.

17. Applicant's Fifth Affirmative Defense references its right to amend its Answer based upon discovery and further factual investigation. Applicant has not participated in discovery in any meaningful way. Applicant has not responded to any discovery requests, nor filed any requests of its own.

Request for Sanctions

18. 37 C.F.R. §2.120(g)(1) of the Trademark Rules of Practice provides, in relevant part:

“If a party fails to participate in the required discovery conference, or 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, except that the Board will not hold any person in contempt or award expenses to any party. The Board may impose against a party any of the sanctions provided in Rule 37(b)(2) in the event that said party or any attorney, agent, or designated witness of that party fails to comply with a protective order made pursuant to Rule 26(c) of the Federal Rules of Civil Procedure.”

19. The TTAB Manual of Procedure §411.05 provides, in relevant part:

“In inter partes proceedings before the Board, a variety of sanctions may be imposed, in appropriate cases, for failure to provide disclosures or discovery pursuant to 37 CFR § 2.120(g)...The range of sanctions listed in Fed. R. Civ. P. 37(b)(2), and 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; drawing adverse inferences against uncooperative party; prohibiting the disobedient party from introducing designated matters in evidence; and entering judgment against the disobedient party.”

20. Fed. R. Civ. P. 37(b)(2) provides for the following applicable sanctions:

“(i) directing that the matters embraced in the order or other designated facts be taken as established for purposes of the action as the prevailing party; (ii) prohibiting the disobedient party from supporting or opposing designated claims or defenses, or from introducing designated matters in evidence; (iii) striking pleadings in whole or in part; (iv) staying further proceedings until the order is obeyed; (v) dismissing the action or proceeding in whole or in part; (vi) rendering a default judgment against the disobedient party.”

21. Counsel for Opposer has made a good faith effort to resolve the discovery dispute via e-mail prior to filing its motion to compel discovery. A copy of that e-mail is attached as Exhibit A.

22. Opposer requests that this Court enter a default judgment against Applicant because of Applicant’s willful evasion of the discovery process.

23. Judgment is a proper remedy when a party fails to make initial disclosures or respond to discovery requests. *See Myspace, Inc. v. Donnell Mitchell*, 91 U.S.P.Q.2d 1060 (P.T.O. May 11, 2009); *Baron Philippe De Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 U.S.P.Q.2d 1848 (P.T.O. June 23, 2000); *Unicut Corp. v. Unicut, Inc.*, 222 U.S.P.Q. (P.T.O. Feb. 22, 1984).

24. The TTAB has held that judgment is a proper remedy when a *pro se* litigant fails to participate in the discovery process. “*Pro se* or not, respondent, as he has been repeatedly warned, bears responsibility for following the rules and Board requirements, including the schedule set by the Board.” *Patagonia, Inc. v. Joseph Azzolini*, 109 U.S.P.Q.2d 1859 (P.T.O. Feb. 28, 2014) (granting the sanction of judgment).

25. The Federal Circuit has also held that judgment is a proper remedy when a *pro se* litigant fails to participate in discovery. *Benedict v. Super Bakery, Inc.*, 665 F.3d 1263, 1269 (Fed. Cir. 2011). The court stated that, “The possession of a trademark registration places a routine obligation on the possessor to participate in reasonable procedures concerning rights or interests affected by that registration.”

26. Because Applicant has willfully evaded the discovery process and failed to articulate any reason for doing so, this Court should enter judgment against Applicant cancelling the registration of *The Iron Horse Clothing Company* (Serial No. 86,208,174) mark.

WHEREFORE, Opposer, Iron Horse Saloon, Inc., requests this Court enter judgment against Applicant, Mark Wentura d/b/a The Iron Horse Clothing Inc., terminating Applicant’s application, declaring the marks are confusingly similar, and any other such relief this Court deems proper.

Respectfully Submitted,

Dated: November 2, 2015

By: /s/ Kelly Parsons Kwiatek
Heather Bond Vargas, Esq.
Kelly Parsons Kwiatek, Esq.
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ATTORNEYS FOR OPPOSER

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing has been served this 2nd day of November, 2015, via E-mail and U.S. Mail, on:

Mark Wentura
2239 Black Canyon Road, Spc 97
Ramona, CA 92605-5570
markw@ironhorsejeans.com

By: /s/ Kelly Parsons Kwiatek
Kelly Parsons Kwiatek, Esq.

Susi Swisher

From: Kelly Parsons Kwiatek
Sent: Thursday, July 23, 2015 3:26 PM
To: Mark Wentura (markw@ironhorsejeans.com)
Cc: evahlsing@xbrlassociates.com; leonard@sdcorporatelaw.com; Heather Bond Vargas; Michele Staples
Subject: Initial Disclosures and Discovery Responses

Mark,

Good afternoon. In a good faith effort to resolve the issues, I wanted to reach out to you about your service of Initial Disclosures (due May 13) and the responses to our First Set of Interrogatories and First Request for Production (both due July 21). Are you planning on providing this information for the TTAB action, and if so, when?

Thanks,
Kelly



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