

UNITED STATES PATENT AND TRADEMARK
OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

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Mailed: April 22, 2011

Cancellation No. 92044624

J. Christopher Carnovale

v.

The Brand Experience LLC

Before Walters, Zervas and Wellington,
Administrative Trademark Judges.

By the Board:

This cancellation proceeding is before the Board for consideration of petitioner's motion (filed November 2, 2010) for judgment and for postponement of testimony. The motion is fully briefed.¹

As background, petitioner seeks cancellation of respondent's Registration Nos. 2384600,² 2477694³ and 2593603⁴

¹ The Certificate of Mailing on petitioner's motion indicates an incorrect address for the USPTO; specifically, said Certificate indicates "Washington, DC" rather than "Alexandria, Virginia." The Certificate of Mailing on respondent's brief indicates "Washington, DC" as well. For the parties' clarification, as set forth in the caption above, and in previous Board orders issued herein, the correct city is Alexandria, Virginia.

The parties are encouraged to use the Board's online filing system, ESTTA, in future filings in this proceeding, inasmuch as doing so will lead to more expeditious processing, more accurate submissions, and fewer lost or misrouted filings.

² Registered September 12, 2000, for the mark THE 50+ SUNSCREEN THAT WON'T RUB OFF, for "sun protective, clothing, namely, swim wear, hats, shirts, shorts, and shoes" in International Class 25.

³ Registered August 14, 2001, for the mark THE SUNSCREEN THAT WON'T RUB OFF, for "sun protective clothing, namely swimwear, long and short sleeved shirts, T-shirts, jackets, cover-ups,

on the grounds of priority and likelihood of confusion, and abandonment, asserting common law rights in the mark THE SUNSCREEN THAT NEVER WEARS OFF! for "a variety of clothing products," as well as ownership of application Serial No. 76599475 for this mark for "men's, ladies' and children's clothing, namely, shirts, tops, blouses, jackets, cover-ups, skirts, pants, jumpsuits, robes and hats" in International Class 25.

Under Fed. R. Civ. P. 60(b), the Board granted respondent's motion for relief from final judgment and vacated a default judgment for failure to answer. Once discovery was underway, petitioner filed a motion to compel respondent to serve responses to several requests in his first set of interrogatories, and to his entire first request for production of documents; rather than filing a brief in response to said motion in compliance with Trademark Rule 2.126, respondent filed a "Reservation of Rights" and a copy of supplemental written responses to the discovery requests at issue in petitioner's motion to compel. The Board granted petitioner's motion, directed respondent to provide responses without objection, and allowed petitioner a unilateral 30-day discovery

shorts, pants, dresses, footwear and headwear" in International Class 25.

⁴ Registered July 16, 2002, for the mark SUNSCREEN KIDS WANT TO WEAR (SUNSCREEN disclaimed), for "sun protective clothing, namely swimwear, long and short sleeved shirts, T-shirts, jackets, cover-ups, shorts, pants, dresses, footwear and headwear" in International Class 25.

period. Thereafter, 1) petitioner was granted a 30-day suspension, and then a 180-day suspension of said discovery period to pursue settlement and to address "open discovery issues" (petitioner's January 9, 2009 and February 9, 2009 motions, p. 1); and 2) the parties stipulated to a further 90-day suspension to finalize a written settlement agreement, noting the need for additional time "to resolve open discovery issues that have been deferred while the parties attempt to amicably resolve the matter" (petitioner's November 3, 2009 motion, p. 1). After the suspension periods expired, proceedings resumed and discovery closed, petitioner moved for a 30-day delay of the opening of testimony, asserting that respondent's answers to his second set of discovery requests had not been received, that respondent's counsel "indicated that responses would be served," and that "additional time is needed to enable the parties to continue their discussions, and in the event that it becomes necessary to file a motion to compel" (petitioner's July 1, 2010 motion, p. 1). Respondent consented to the motion; the Board granted the motion.

Thereafter, petitioner filed a motion to compel responses to his second set of interrogatories and second request for production. In granting the motion as conceded on September 15, 2010, and directing respondent to serve responses without objection, the Board noted that in the event of respondent's

noncompliance, petitioner's remedy may lie in a motion for judgment pursuant to Trademark Rule 2.120(g).

In the motion presently before the Board, petitioner asserts that respondent never served complete responses as ordered, and "has willfully violated the Board's September 15 order" (petitioner's motion, p. 2). He asserts that the only reply came in the form of an email from respondent wherein it informally notified petitioner that its counsel would no longer represent it, and stated that respondent "has already complied with and provided all information" and "does not understand what additional information is being requested" (petitioner's motion, p. 2; Exhibit A, respondent's email of October 15, 2010).

During the time provided by Trademark Rule 2.127(a) to file a brief in opposition to petitioner's motion for judgment, respondent filed a paper informing the Board that it will proceed without the assistance of counsel, which does not include proof of service as required by Trademark Rule 2.119(a).⁵ Thereafter respondent, proceeding pro se, filed a brief which also fails to include proof of service, and is nine days late.

In his reply, petitioner objects to respondent's brief on the basis that it was not served and is untimely.

⁵ Respondent was represented by counsel since early in this proceeding, specifically, from the time it filed its motion to vacate default judgment for failure to answer.

Turning first to the timeliness of respondent's brief, respondent states therein, with respect to its change in representation, that "(p)etitioner's Counsel was notified of this fact on October 15,"⁶ and that "(a)ny delays are due to transition issues caused by this change of representation" (respondent's brief, unnumbered p. 1).

While it is unclear whether respondent's statement refers to any delay in responding to petitioner's second set of discovery requests, the delay in filing a brief on the motion for judgment, or both, it is apparent that respondent maintains that its change in representation affected (at some point in time, and to an extent that is unclear to the Board) its ability to take action in this proceeding.

Accordingly, the Board construes respondent's statements as a request to accept its late-filed brief. Said request is granted, and the Board has considered respondent's brief.

Analysis

Turning to the merits of petitioner's motion, Trademark Rule 2.120(g)(1) states, in pertinent part:

(g) *Sanctions*. (1) 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.

⁶ To be clear, respondent did not file with the Board its notice of this until November 19, 2010.

The Board's authority to impose a range of sanctions for failure to provide discovery is rooted in Fed. R. Civ. P. 37(b)(2), which is made applicable to inter partes proceedings by Trademark Rule 2.116(a). The sanctions that may be imposed include the entry of judgment against a disobedient party. See *Central Mfg. Inc. v. Third Millennium Technology Inc.*, 61 USPQ2d 1210, 1213 (TTAB 2001). See also TBMP § 527.01 (2d ed. rev. 2004). Default judgment is a harsh measure that is justified where no less drastic remedy would be effective and there is a strong showing of willful evasion of the judicial process. See *Unicut Corp. v. Unicut, Inc.*, 222 USPQ 341, 344 (TTAB 1984). The entry of judgment may be justified in such cases. See *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1854 (TTAB 2000).

Petitioner's motion follows a Board order compelling discovery from respondent, and thus is appropriate and timely. See *Amazon Technologies v. Wax*, 93 USPQ2d 1702, 1706 (TTAB 2009).

In responding to the merits of petitioner's motion, respondent maintains that it "has provided Petitioner unambiguous, verifiable, and continuous Proof of Use of the Marks in Commerce" (respondent's brief, unnumbered p. 1). In referring to its October 15, 2010 email to petitioner, respondent states that it "did, in fact, reply within the

thirty (30) day time period" (respondent's brief, unnumbered p. 2).

To the extent that respondent claims that its October 15, 2010 email fulfilled its discovery duty with respect to petitioner's second set of discovery requests, a reading of said email (which is of record as Exhibit A to petitioner's motion for judgment) indicates that respondent merely stated that it had already provided answers, and that it "does not understand what additional information is being requested." While respondent's email can be viewed as documentary proof that it responded to petitioner's second request for documents, it remains unclear whether said responses are in compliance with Fed. R. Civ. P. 34(a)(1), which requires that a responding party produce and permit the requesting party to inspect, copy, test or sample the items in the responding party's possession, custody or control.

With respect to petitioner's second set of interrogatories, said email fails to demonstrate compliance with the obligation to respond thereto. Specifically, Fed. R. Civ. P. 33(b)(3) and (b)(5) require that a party answer each interrogatory separately and fully in writing under oath, and that the person who makes the answers must sign them.

To the extent that respondent's statement that it "does not understand" is intended as an objection to the discovery on the grounds of vagueness, said objection is noncompliant,

impermissible, and in violation of the Board's order. Pursuant to Fed. R. Civ. P. 33(b)(4), the grounds for objecting must be stated with specificity. Furthermore, the Board made clear by way of its previous order that respondent, who was directed to serve responses "without objection," had waived its right to object to petitioner's discovery requests on the merits.

Moreover, the record does not indicate any manner in which respondent was hindered or prevented from responding to this discovery. Respondent cannot claim that it is unfamiliar with the rules of procedure that are applicable to the discovery process; respondent was represented by counsel of record from the time it moved to vacate default judgment for failure to answer, until two weeks after petitioner filed the present motion for judgment. Moreover, in its notification to the Board of its decision to discharge its counsel, respondent did not request time in which to seek new counsel or to comply with the most recent order, and made no mention of the discovery issues or attempts, if any, to resolve them. In general, the Board takes a dim view of any party who fails to comply in full and in good faith with its obligations to provide appropriate discovery.⁷

⁷ Throughout all stages of an inter partes proceeding, the Board expects of all parties their compliance with the Trademark Rules of Practice and, where applicable, the Federal Rules of Civil Procedure, whether or not they are represented by counsel. See *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, n.2 (TTAB 2006).

The Board also acknowledges that some of the time delay in this proceeding was due to earnest settlement efforts on the part of both parties, and that the record does not evidence that respondent is solely responsible for the nearly six-year pendency of this proceeding. Notwithstanding the unjustified lapses in respondent's duty to provide discoverable information and documents, or to provide proper written responses in conformance with the federal rules, the record does not demonstrate a pattern of willful evasion of the judicial process or bad-faith conduct on respondent's part. While it is unclear why respondent's former counsel did not assure respondent's fulfillment of its discovery obligations, the record does not show intentionally obstructive misconduct to the extent that would warrant the entry of default judgment. Furthermore, petitioner, as the party with the burden of proof on his motion for judgment, provides little detail to lend support to his assertion that respondent "willfully" acted in violation of the Board's order.

Nevertheless, lesser sanctions are clearly appropriate inasmuch as respondent's failure to cooperate in the discovery process, and failure to respond in conformance with the federal rules, have had an adverse effect both on petitioner's ability to prepare his case, and on the timeliness with which the Board can advance this case to a determination on the merits. Moreover, the Board finds it necessary to exercise its

discretion to tailor sanctions in order to deter further wrongdoing or inattentiveness to this proceeding, and it clearly has the authority to sanction a pro se party. See, e.g., *Central Mfg. Inc.*, 61 USPQ2d at 1213.

In view thereof, petitioner's motion for default judgment is denied. The motion for sanctions is granted to the extent that:

(1) respondent is prohibited from contesting the authenticity of any document(s) or things provided during discovery and introduced by petitioner at trial or on any motion, such as a summary judgment motion;

(2) respondent is ordered to serve responses, without objection, and in compliance with Fed. R. Civ. P. 33, to petitioner's second set of interrogatories, as ordered by the Board in its September 15, 2010 order, within fifteen (15) days of the mailing date of this order, failing which the Board will entertain a motion for default judgment against respondent;

(3) respondent, in complying with (2) above, and if any documents are located by respondent which are responsive to petitioner's second set of document requests under Fed. R. Civ. P. 34, or which supplement its responses to the first set of document requests,⁸ must produce any and all responsive

⁸ Respondent is reminded that it maintains a continuing duty to supplement or correct in a timely manner any disclosure or response that it has made. See Fed. R. Civ. P. 26(e)(1).

documents to counsel for petitioner at his Washington, D.C. office, or at a location to which the parties mutually agree.

Respondent is reminded that, by operation of its previous uncooperativeness, it has forfeited its right to object to the discovery on the merits thereof, such as on the basis that the information sought is irrelevant, overly broad, unduly vague, ambiguous, burdensome, oppressive, or not likely to lead to the discovery of admissible evidence.

Schedule

Proceedings are resumed. To the extent that petitioner moved for an extension of the opening of testimony periods, said motion is granted. Discovery has closed; trial dates are reset as follows:

30-day testimony period for party in position of plaintiff to close:	07/01/11
30-day testimony period for party in position of defendant to close:	08/30/11
15-day rebuttal testimony period to close:	10/14/11

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.

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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.