

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

MBA

Mailed: March 12, 2009

Cancellation No. 92045648

FreemantleMedia North
America, Inc.

v.

Idol Writer, LLC

**Before Quinn, Drost and Mermelstein, Administrative
Trademark Judges**

By the Board:

This case now comes up for consideration of petitioner's motion, filed November 26, 2008, requesting judgment as a sanction for respondent's alleged failure to comply with the Board's order of October 3, 2008 (the "Prior Order"). The motion is fully briefed.

Background

Pro se respondent owns a registration of IDOL WRITER, in standard characters, for "Entertainment in the nature of song writing contests."¹ In its petition for cancellation, petitioner alleges prior use and registration of AMERICAN

¹ Registration No. 3049295, issued January 24, 2006, with WRITER disclaimed, based on a date of first use in commerce of January 1, 2004. Respondent acquired the registration by assignment, recorded at Reel 3739, Frame 0702, the last in a long series of assignments of the registration.

IDOL, with and without a design, for a variety of products and services, including "entertainment services in the nature of a continuing television talent show,"² and that respondent's mark is likely to cause confusion with petitioner's marks. Respondent denies the salient allegations in the petition for cancellation.

In the Prior Order, the Board granted petitioner's motion to compel discovery responses as conceded and allowed respondent thirty days to serve its responses, without objection, to petitioner's first sets of interrogatories and document requests. The Board also granted petitioner's request to deem as admitted petitioner's first set of requests for admission, based on respondent's failure to timely respond to them.

Petitioner's Motion and Respondent's Opposition Thereto

In its motion for sanctions, petitioner claims that respondent failed to respond, in any manner, to petitioner's first sets of interrogatories and document requests, within the time provided in the Prior Order or thereafter. Furthermore, according to petitioner, respondent "has made no attempt to contact Petitioner to explain its failure to

² See, e.g., Registration Nos. 2751431, issued May 13, 2003, and 2715725, issued August 12, 2003, for AMERICAN IDOL and AMERICAN IDOL & Design, respectively, based on dates of first use in commerce of June 11, 2002; see also, Registration Nos. 2955077 and 2951733.

respond to discovery or to engage in this proceeding in any meaningful way."

In its opposition to the motion,³ respondent claims that it "has had all intention of complying with the Board's October Order," but could not do so "due to the inaccessibility of information directly bearing on those discovery requests." Specifically, respondent contends that documents responsive or relevant to petitioner's discovery requests were produced in an unidentified civil action, and that after that litigation terminated, the documents were "in storage of third parties who were unavailable."

Declaration of Phillip Elden (respondent's principal) in Support of Respondent's Opposition to Petitioner's Motion ¶¶ 3-4. Respondent claims that shortly before it filed its opposition to petitioner's motion, it finally "obtained access to the information needed in order for [it] to comply with Petitioner's discovery requests." Id. ¶ 8.

Respondent disputes petitioner's claim that respondent has been uncommunicative, claiming that it "telephoned

³ Respondent's opposition is captioned "Opposition to Petitioner's Motion for Sanctions in the Form of Default Judgment and Motion for Leave to File Responses to Petitioner's Discovery Requests." The purported cross "motion for leave to file responses to petitioner's discovery requests" will be given no consideration because its basis is entirely unexplained, and, more importantly, because leave to respond to the discovery requests is not required. Instead, respondent is automatically required to respond by operation of rule (not to mention the Prior Order). See, e.g., Fed. R. Civ. P. 33 and 34; Trademark Rule 2.120(a)(3); TBMP §§ 403.03, 405.04(a) and 406.04(a) (2d ed. rev. 2004).

Petitioner's counsel on at least three (3) occasions," but that "[p]etitioner's counsel has ignored and refused to return my telephone calls." Id. ¶ 6. Finally, respondent requests that petitioner's requests for admission not be deemed admitted, but does not explain the basis for this request or acknowledge that the requests were already deemed admitted in the Prior Order.

In its reply brief, petitioner claims that respondent "declines to account for the overwhelming number of chances Registrant has already been given to respond to [petitioner's] discovery requests." Petitioner claims that respondent's excuse for not responding "rings hollow" because respondent would not require documents in order to respond to petitioner's interrogatories. Relying on the declaration of one of its attorneys, petitioner disputes respondent's claim that it attempted to telephone petitioner's counsel, and claims that, in fact, none of petitioner's attorneys received any communications from respondent after the Prior Order and before petitioner filed its motion for sanctions. Supplemental Declaration of Wendy M. Mantell in Support of Petitioner's Motion ¶¶ 2-3.

Decision

"If a party fails to comply with an order of the [Board] relating to discovery ... the Board may make any appropriate order, including any of the orders provided in

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Rule 37(b)(2) of the Federal Rules of Civil Procedure ...”
Trademark Rule 2.120(g)(1); see also, M.C.I. Foods Inc. v. Bunte, 86 USPQ2d 1044, 1047 (TTAB 2008); HighBeam Marketing, LLC v. Highbeam Research, LLC, 85 USPQ2d 1902, 1904 (TTAB 2008). Potential sanctions include entering judgment against the disobedient party or prohibiting the disobedient party from introducing designated matters into evidence. HighBeam Marketing, 85 USPQ2d at 1904.

In this case, it is clear that respondent violated the Prior Order by failing to respond in any manner to petitioner’s interrogatories or document requests. While respondent attempts to excuse its failure to respond by claiming that responsive documents were unavailable, we agree with petitioner that this excuse “rings hollow.” Indeed, as petitioner points out, documents would not be necessary to respond to many of petitioner’s interrogatories, including but by no means limited to those concerning why petitioner chose to adopt IDOL WRITER and what services are offered under the mark. Declaration of Wendy M. Mantell in Support of Petitioner’s Motion Ex. A, Interrogatory Nos. 1, 3. Furthermore, even if respondent believed that it required the documents in order to respond to some of petitioner’s discovery requests, respondent provides no excuse for its failure to discuss this with petitioner within thirty days of the Prior Order, or for its

failure to seek from the Board an extension of time in which to comply with the Prior Order. While respondent asserts that it contacted petitioner's counsel three times, it fails to provide the dates of any of the alleged telephone calls, or even to indicate whether the alleged calls were made after issuance of the Prior Order. Furthermore, petitioner amply demonstrates that respondent's failures to act are part of a pattern of dilatory conduct. See, Petitioner's Motion to Compel at pp. 3-4 and Motion for Sanctions at pp. 2-3. In short, respondent was ordered to respond to petitioner's discovery requests, and not only did respondent fail to do so, but it also failed to seek an extension of time in which to do so.

Accordingly, petitioner's motion for the sanction of judgment is hereby **GRANTED**. See e.g., Fed. R. Civ. P. 37(b)(2); Trademark Rule 2.120(g)(1); MHW Ltd. v. Simex, Aussenhandelsgesellschaft Savelsberg KG, 59 USPQ21d 1477 (TTAB 2000). Judgment is hereby entered against respondent, the petition to cancel is granted, and Registration No. 3049295 will be cancelled in due course.⁴

⁴ Respondent's request that petitioner's requests for admission not be deemed admitted, to the extent it could be interpreted as a motion for reconsideration of the Prior Order, is moot and will be given no further consideration.