

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

Faint

Mailed: December 12, 2008

Cancellation No. 92047661

Live Ventures Inc.

v.

Saroj International, Inc.

**Before Hairston, Kuhlke and Ritchie,
Administrative Trademark Judges.**

Before the Board is petitioner's motion, filed April 9, 2008, for sanctions for respondent's failure to comply with the Board's February 21, 2008 order compelling discovery.¹ No response to the motion had been received, and on May 19, 2008 the Board issued an order to show cause why the Board should not treat respondent's apparent loss of interest as a concession of the case.

¹ Petitioner's motions for a protective order relieving it from respondent's discovery requests and to extend the discovery period were previously denied as moot. Proceedings have been suspended, however, since April 9, 2008.

Response to Order to Show Cause

Respondent replied on June 18, 2008 to the show cause order stating it had not lost interest in the case, and it had "complied with all conditions set forth in the Board's February 21, 2008 Order, including submission of signatures for the interrogatory responses, supplemental discovery responses, and supplemental admission responses." Respondent notes it had requested an address in a "non-residential area" for mailing to petitioner, and had offered to forward documents using Federal Express, if petitioner provided its account number. Respondent argues, however, it has never received a copy of petitioner's motion for sanctions, despite petitioner's attachment of a certificate of service to the motion. Respondent did not support its response with an affidavit or declaration, nor any evidence of its responses to petitioner, and requested an additional sixty days to respond to petitioner's motion for sanctions.

In its June 23, 2008 reply to respondent's response to the show cause order, petitioner attached a declaration stating it had never received anything from respondent pursuant to the

Board's order compelling discovery.² Petitioner also declared that respondent has the correct address for petitioner's attorney, there is no other address, and that its law firm routinely received mailings from the USPTO, other counsel in other matters, and various other sources, and no such mailings have ever gone missing.

The Board finds that respondent has failed to establish that a sixty-day extension of time is warranted. Once respondent received the Board's show cause order, it was on notice that a motion for sanctions had been filed. While respondent moved promptly for additional time, if respondent had in fact complied with the order compelling discovery, some evidence of that compliance could, and should, have been attached to the response to the show cause order. Likewise, on the record presented here, the Board finds respondent's allegation that it never received the motion for sanctions less than credible. Petitioner included a certificate of service with its motion, and respondent has presented no evidence to rebut receipt of service. Instead, the Board finds that respondent has engaged in a pattern of non-cooperation and nonresponsiveness in this proceeding.

While respondent has discharged the show cause order by stating it has not lost interest in the case, the Board denies the request for a sixty-day extension of time. The Board will now consider petitioner's motion for sanctions on the merits.

² In its filing petitioner argues respondent has failed to show it is still interested in the case. To the extent that petitioner is

Motion for Sanctions

In its February 21, 2008 order compelling discovery and testing the sufficiency of certain admission responses, the Board allowed respondent thirty days, or until March 22, 2008,³ to serve signed copies of its supplementary interrogatory responses, its supplementary responses to petitioner's first request for documents and things, and its supplemental admissions, and to further supplement its responses to certain interrogatories and document requests. In its motion for sanctions and the accompanying declaration of counsel, petitioner declares that it tried to contact respondent's counsel via telephone regarding supplemental responses pursuant to the Board's order on three occasions between March 24 through 28, 2008, leaving messages each time, and did not receive responses to any of these messages from respondent. Petitioner declares it sent email and facsimile communications to respondent inquiring about the required responses on March 28 and 31, 2008, and received a facsimile communication from respondent on April 2, 2008. In that unsigned communication respondent states it had provided all necessary responses and signatures that were required via U.S. Mail, but would be happy to resend them if petitioner had not received them. On that same date petitioner responded via facsimile that it had not

requesting the Board treat respondent's reply to the show cause order as a concession of the case, the request is denied.

³ March 22, 2008 was a Saturday, so respondent's responses would have been timely if served on March 24, 2008, the next Monday. See Patent and Trademark Rule 1.7 (when a date for taking action falls on a Saturday, Sunday, or holiday, action may be taken on the next business day).

been served with any additional discovery or responses as ordered by the Board. Petitioner requested of respondent that any such responses that had been sent via U.S. Mail be sent via facsimile or as a PDF file via email. On April 4 and 7, 2008 petitioner sent additional facsimile communications to respondent stating it still had not received anything in response to the Board's order. Petitioner declared that as of April 9, 2008 it had not received any response of any kind from respondent to its requests.

Petitioner requests sanctions in the form of: 1) respondent's supplemental responses to petitioner's first sets of interrogatories, document requests and requests for admissions be deemed signed; 2) respondent be estopped from arguing a date of first use of its mark that is prior to the date respondent gave in its applications regarding the marks at issue; 3) respondent be precluded from relying on any information responsive to petitioner's first set of interrogatories, other than information respondent has provided in its supplemental responses; and 4) respondent be precluded from relying on any documents except the 174 pages it has already produced, and that those documents be deemed authentic and genuine business records of respondent.

"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 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." Trademark Rule 2.120(g)(1). In this case, it looks as though respondent failed to comply with the Board's order compelling discovery. Although respondent has stated it did comply, this statement was not accompanied by an affidavit or declaration. Moreover, as indicated, petitioner declares that it has not received any supplemental discovery responses as ordered by the Board. Accordingly, the Board finds respondent's statements less than credible.

Because it appears respondent failed to comply with the Board's order, sanctions are appropriate. *See, e.g., MCI Foods Inc. v. Bunte*, 86 USPQ2d 1044, 1047 (finding sanctions appropriate where partial response to Board's order made before deadline imposed by motion compelling discovery, but responses without objection and additional documents in compliance with Board's order never provided).

Accordingly, we find in this case that the following sanctions are appropriate, and we grant petitioner's motion for sanctions to the following extent:

- (1) within **TWENTY DAYS** of the mailing date of this order as shown above, respondent shall (a) serve signed copies of its supplementary interrogatory responses, its supplementary responses to petitioner's first request for documents, and its supplemental admissions; (b) serve supplemental responses to interrogatories in compliance with the Board's February 21, 2008 order; (c) copy all responsive documents ordered to be produced in the Board's February 21, 2008 order at respondent's expense and deliver them to petitioner; all of the above to be served via email. *Cf.* Trademark Rule 2.119(b)(6).

- (2) Respondent is estopped from claiming a date of first use prior to the dates of use shown in the registrations at issue in this proceeding.
- (3) The Board will accept any documents produced by respondent, if filed during trial by petitioner, as authentic and admissible.
- (4) Respondent is prohibited from relying at trial on any documents requested by petitioner during discovery but not produced by respondent within the time set for complying in the Board's February 21, 2008 order.

As a result of this prohibition, respondent may not introduce documents requested by petitioner during discovery as an exhibit to a testimonial deposition or by notice of reliance. Petitioner may rely on any and all documents produced by respondent. Respondent is not precluded from relying on documents which were reasonably not part of a document production request by petitioner during trial.⁴

Respondent should note that if it fails to comply with the Board's order above, judgment will be entered against it and in favor of petitioner.

Dates are reset as set out below.

DISCOVERY PERIOD TO CLOSE:	January 20, 2009
30-day testimony period for party in position of plaintiff to close:	April 20, 2009
30-day testimony period for party in position of defendant to close:	June 19, 2009
15-day rebuttal testimony period for plaintiff to close:	August 3, 2009

⁴ Respondent's registrations are of record as they are the subject of this proceeding. Trademark Rule 2.122(b)(1).

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.
