

ESTTA Tracking number: **ESTTA252168**

Filing date: **12/02/2008**

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

Proceeding	92048480
Party	Plaintiff Sinbad Grand Cafe, LLC
Correspondence Address	Natu J. Patel The Patel Law Firm, P.C. 2532 Dupont Drive Irvine, CA 92612 UNITED STATES NPatel@thePatelLawFirm.com
Submission	Motion for Sanctions
Filer's Name	Natu J. Patel
Filer's e-mail	npatel@thePatelLawFirm.com
Signature	/natupatel/
Date	12/02/2008
Attachments	Motion for Sanctions 120208.pdf ( 9 pages )(32407 bytes )



30, 2008 deadline set by the Board passed without any conference taking place. Again, Respondent disobeyed the Board' s scheduling order.

On February 5, 2008, Petitioner propounded Special Interrogatories and Request for Production of Documents (“RFD”) on Respondent. On March 14, 2008, more than 35 days after the RFD was propounded and at which point any response was tardy, Registrant provided utterly deficient responses to the RFD.

After undertaking extensive meet and confer negotiations, on May 21, 2008, Petitioner, out of no choice, filed a motion to compel discovery responses from Respondent based on Respondent' s evasive and incomplete answers. On October 28, 2008, the Board ordered that Respondent provide Petitioner with full and complete responses to its RFD within thirty (30) days of the mailing date of the order. (the “Order”) The Board ordered Respondent to produce documents responsive to Document Request No. 4, 8, 9, 10, 11, 12, 16, 17, 24, 25, 27, 29, 30, 31, 41, 43, 45, 46, 47, 49 and 50.

In the event Respondent failed to provide full and complete responses, signed under oath and without objections, to the document production requests 30 days from the mailing date of the Board' s order, the Board further authorized Petitioner to move for sanctions, including the entry of judgment, pursuant to Trademark Rule 2.120(g).

### **CURRENT STATUS**

Documents pursuant to the Order were due on or before November 27, 2008 (November 28, 2008 after factoring in an additional day for the Thanksgiving holiday). To date, Petitioner has not received any responses or any documents from Respondent.

Additionally, Petitioner has received no correspondence from Respondent indicating that any documents were being prepared or were forthcoming in compliance with the Order. In other words, Respondent has not made any efforts to comply with the Board' s Order.

## **ARGUMENT**

If a party fails to comply with an order of the Board relating to discovery, including a protective order or an order compelling discovery, the Board may enter appropriate sanctions, as defined in 37 CFR § 2.120(g)(1). TBMP § 527.01(a). Such sanctions 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, prohibiting the disobedient party from introducing designated matters in evidence, and entering judgment against the disobedient party. *Id.*

### **I. PETITIONER RESPECTFULLY REQUESTS THAT THE BOARD ENTER JUDGMENT IN FAVOR OF PETITIONER BASED UPON RESPONDENT' S FAILURE TO OBEY THE BOARD' S ORDER.**

A court may enter a judgment as a sanction where no less drastic remedy would be effective and there is a strong showing of willful evasion. *Id.*; See also *MHW Ltd. v. Simex, Aussenhandelsgesellschaft Savelsberg KG*, 59 USPQ2d 1477 (TTAB 2000) (repeated failure to comply with orders and unpersuasive reasons for delay resulted in entry of judgment); *Baron Philippe de Rothchild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1854 (TTAB 2000) (pattern of dilatory conduct indicated willful disregard of Board order and resulted in entry of judgment); and *Caterpillar Tractor Co. v. Catfish Anglers Together, Inc.*, 194 USPQ 99 (TTAB 1976) (judgment entered where applicant provided no reason for not complying with Board order compelling discovery).

More than 30 days have passed since the mailing date of the Order, but Petitioner has not received any documents or responses in compliance with the Order. Respondent has not even bothered to notify Petitioner that documents were being prepared or that an extension was necessary. Therefore Respondent has not provided Petitioner with documents and/or responses in compliance with the Order.

In addition to Respondent's willful disregard of the Order in this instance, Respondent has consistently engaged in a pattern of dilatory conduct which should not be tolerated by the Board. Petitioner has filed many documents with the Board evidencing Petitioner's patience with Respondent, and Respondent's consistent failure to provide meaningful responses and observe deadlines. For example, Respondent failed to file its Answer on a timely basis, it failed to comply with the Board's discovery scheduling order, it failed to conduct a discovery conference in compliance with the scheduling order, and it also failed to reply to the RFD before the statutory deadline.

Since Respondent failed to comply with the Order, and Respondent's actions demonstrate a pattern of dilatory conduct, Petitioner respectfully requests that the Board enter judgment in favor of Petitioner by cancelling registration of the trademark.

**II. ALTERNATIVELY, THE BOARD SHOULD PROHIBIT RESPONDENT FROM PRODUCING THE EVIDENCE SOUGHT IN THE RFD, WHICH ULTIMATELY WARRANTS A CANCELLATION OF THE TRADEMARK.**

The Board may prohibit the disobedient party from supporting or opposing designated claims or defenses, or from introducing designated matters in evidence. Fed. R. Civ. Proc. 37(b)(2)(ii).

- A. If the Board Prohibits Respondent From Introducing Evidence In the RFD, The Trademark Should Be Cancelled On the Grounds of Non-Use, Abandonment, And/Or Fraud.

Introduction of evidence of nonuse of the mark for three consecutive years constitutes a prima facie showing of abandonment, whereby intent not to resume use is inferred, and shifts the burden to the party contesting the abandonment to show either evidence sufficient to disprove the underlying facts showing three years nonuse, or evidence of an intent to resume use to overcome the presumed fact of no intent to resume use. *Rivard v. Linville*, 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998); *Imperial Tobacco Ltd. v. Philip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990); *Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989); and *Stromgren Supports, Inc. v. Bike Athletic Company*, 43 USPQ2d 1100 (TTAB 1997).

The Board specifically stated that Respondent had only “produced documents relating to use of the involved mark for only 2006, 2007 and 2008.” (Order, p. 2) Correspondingly, Respondent should be prohibited from introducing any evidence of use of the Trademark for the years 1995 to 2005. The statement of use of the Trademark identifies January 15, 2001 as the date of first use in commerce. If Respondent is prohibited from presenting evidence, Respondent cannot prove that the mark was in use from 2001 to 2005. Since this period is longer than three years, a prima facie case of abandonment would be established. Since Respondent could not produce evidence of use within this period, Respondent could not rebut the prima facie case, and the Trademark will have been abandoned before 2006. Therefore registration of the Trademark should be cancelled.

Furthermore, Document Request No. 29 requested documents relating to sales of Respondent's products bearing the Trademark from 2001 to the present. If Respondent is prohibited from introducing evidence of sales from 2001 to the present, Respondent will not be able to prove that the Trademark was used in commerce from 2001 to the present. Therefore the Trademark should be cancelled on grounds of non-use and abandonment.

Additionally, since no evidence will be able to support the Trademark's date of first use in commerce of January 15, 2001, Petitioner respectfully requests the Board to cancel the registration of the Trademark on the grounds that such registration was fraudulently obtained from the USPTO.

B. If the Board Prohibits Respondent From Introducing Evidence In the RFD, Respondent Cannot Establish Ownership of the Trademark, Thereby Warranting a Cancellation of the Trademark.

Document requests No. 41, 43, 45, 46, 47, and 49 requested documents to support Respondent's denial of paragraphs 17, 19, 24, 25, 26, and 29 of the Petition. Since Respondent has not produced documents to support its denials, Petitioner urges the Board to prohibit Respondent from contesting Petitioner's claims in paragraphs 17, 19, 24, 25, 26 and 29 of the Petition.

Petitioner alleges in paragraphs 17 and 19 that the registration was fraudulently obtained. Because of Respondent's non-compliance with the Order, if the Board prohibits Respondent from introducing the evidence sought in the above RFD, these allegations will be uncontested. Accordingly, Petitioner will have proven that the Trademark was fraudulently obtained and hence should be cancelled.

Similarly, Petitioner alleges in paragraphs 24, 25, and 26 that none of the assignments of trademark rights were valid, and therefore the assignment to Respondent

was invalid. Since Respondent cannot deny this claim if it cannot introduce evidence from the RFD, Respondent cannot establish that it is the owner of the Trademark. Again, on these grounds, cancellation of the Trademark registration is justified.

Finally, Petitioner alleges in paragraph 29 that one of the assignments of the trademark was a naked assignment. Again, if the Board prohibits Respondent from introducing evidence sought in the RFD, Respondent will not be able to disprove this allegation. Since the assignment was naked, it was invalid, and Respondent is therefore not the owner of the Trademark, and the registration of the Trademark should be cancelled.

///

///

///

///

///

## CONCLUSION

Because of Respondent's non-compliance with the Board's Order and a consistent pattern of flagrant dilatory conduct, Petitioner respectfully requests the Board to issue sanctions against Respondent by entering a judgment in favor of Petitioner.

Alternatively, Petitioner requests that the Board issue sanctions against Respondent prohibiting Respondent from introducing any evidence sought in the RFD, which will warrant the cancellation of the Trademark Registration.

Respectfully Submitted,

/natupatel/

Dated: December 1, 2008

By: \_\_\_\_\_

Natu J. Patel  
Attorney for Petitioner  
Sinbad Grand Cafe, LLC

The Patel Law Firm, P.C.  
2532 Dupont Drive  
Irvine, CA 92612  
Telephone: (949) 955-1077  
Facsimile: (949) 955-1877  
npatel@thePatelLawFirm.com

**CERTIFICATE OF SERVICE**

It is hereby certified that a true and correct copy of the foregoing PETITIONER' S MOTION FOR SANCTIONS FOR FAILURE TO COMPLY WITH AN ORDER OF THE TRADEMARK TRIAL AND APPEAL BOARD was served by electronic mail and first class mail, upon attorneys for Respondent (old address and the new address), this 2nd day of December, 2008 as follows:

Christopher Q. Pham, Esq.  
Gareeb | Pham LLP  
Aon Center  
707 Wilshire Blvd., 53rd Floor  
Los Angeles, CA 90017  
[cpham@gareebpham.com](mailto:cpham@gareebpham.com)

Christopher Pham, Esq.  
Johnson & Pham, LLP  
6355 Topanga Canyon Blvd, Suite 115  
Woodland Hills, California 91367  
[cpham@johnsonpham.com](mailto:cpham@johnsonpham.com)

/natupatel/

---