

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

MBA

Mailed: April 27, 2010

Cancellation No. 92050685

Renee Shatanoff

v.

Executive Development
Architects LLC

Michael B. Adlin, Interlocutory Attorney:

Now before the Board are: (1) respondent's motion for summary judgment, filed May 22, 2009, consideration of which was deferred by order of the Board dated August 20, 2009 (the "Prior Order"); (2) respondent's August 31, 2009 combined response to the Prior Order and "motion to accept Rule 26 disclosures as previously filed;" and (3) petitioner's September 8, 2009 cross-motion for sanctions for respondent's failure to participate in the required discovery conference. All three motions are untimely and/or otherwise contrary to the applicable Rules, as explained herein.

Turning first to respondent's motion for summary judgment, the Prior Order controls. The Prior Order noted that respondent's motion for summary judgment was apparently filed prior to the service of initial disclosures, and

allowed respondent time to indicate whether respondent had made initial disclosures before filing its motion. As stated in the Prior Order: "If initial disclosures were not made, the Board will deny the motion for summary judgment without prejudice on procedural grounds." Because respondent's response to the Prior Order indicates that respondent did not serve initial disclosures before filing its motion for summary judgment, respondent's motion for summary judgment is hereby **DENIED, WITHOUT PREJUDICE**.

Trademark Rule 2.120(a)(3).

Respondent's motion to accept its Rule 26 disclosures as if previously, i.e. timely, filed is **DENIED**. First, respondent's claim that the parties "tacitly" agreed to forego initial disclosures is factually incorrect. Petitioner's Response to Registrant's Motion to Accept Rule 26 Disclosures as Previously Filed, p. 2. Second, even if there was such an agreement, which there was not, "[p]arties must inform the Board, by stipulation or motion, any time they agree to modify their obligations under the rules governing disclosures and discovery ... Such modifications are subject to Board approval." Boston Red Sox Baseball Club LP v. Chaveriat, 87 USPQ2d 1767 (TTAB 2008). Here, there was no such notification to the Board, much less Board approval of any agreement to waive initial disclosures. Third, respondent's argument that its initial disclosures

were "incorporated within" its motion for summary judgment is not well-taken. Assuming, for the sake of argument, that respondent means to suggest that it met its initial disclosure obligation by disclosing the identities of Lisa Niederman and Renee Shatanoff by filing its motion,¹ there is no indication that these are the only individuals "likely to have discoverable information" that respondent "may use to support its ... defenses." Fed. R. Civ. P. 26(a)(1)(A)(i). Nor does the motion constitute an identification of "the subjects of that information," as required by the Rule. Further assuming, again for the sake of argument, that respondent means to suggest that the documents attached to the Niederman Declaration satisfy the requirements of Fed. R. Civ. P. 26(a)(1)(A)(ii), there is no indication that these attachments are sufficient to identify "all documents" or things which respondent "has in its possession, custody, or control and may use to support its claims or defenses ...," as required by the Rule. In fact, petitioner had no way of knowing what portions of the motion for summary judgment, if any, were intended to constitute respondent's initial disclosures. Fourth, while respondent filed and served its initial disclosures with its motion to accept, that was too late. Indeed, "[a] party may not file a motion for summary

¹ Renee Shatanoff is the named plaintiff and referenced in the motion. A declaration from Lisa Niederman supports the motion.

judgment until the party has made its initial disclosures ...” Trademark Rule 2.127(e)(1).

Finally, we must consider whether petitioner’s cross-motion for sanctions is timely, for if it is untimely, it too violates the applicable Rules and will therefore receive no further consideration. The operative Rule provides that “[a] motion for sanctions against a party for its failure to participate in the required discovery conference must be filed prior to the deadline for any party to make initial disclosures.” Trademark Rule 2.120(g)(1). Petitioner filed its cross-motion well after this deadline.

Petitioner argues, however, that its cross-motion is timely and should be considered because it “considered these proceedings to have been effectively suspended as of the date of filing of” respondent’s motion for summary judgment, and therefore did not earlier move for sanctions, but instead filed a substantive response to respondent’s motion. If petitioner believed that the Board would treat respondent’s motion as one for summary judgment, it should have simply pointed out that respondent failed to comply with Trademark Rule 2.127(e)(1), and moved for sanctions before initial disclosures were due on June 25, 2009. And while petitioner may intend to suggest that it believed respondent’s motion would be treated as some type of motion

to dismiss under Fed. R. Civ. P. 12,² such a suggestion is not credible, given petitioner's substantive response to the motion, which is based on respondent's alleged failure "to meet its burden of demonstrating the absence of any genuine issue of material fact." Therefore, petitioner's cross-motion is untimely and will be given no further consideration.

It may be instructive to point out that even if considered, the motion might very well have been denied. Indeed, while petitioner claims without supporting evidence that it made "repeated requests" for respondent to participate in the required discovery conference, petitioner does not provide any excuse for not seeking the Board's assistance in arranging, and participation in, the discovery conference. In this case, "had either party requested Board participation in the discovery conference, as provided for in Trademark Rule 2.120(a)(2) ... the Board could have facilitated a resolution of the parties' problems in scheduling the necessary discovery conference discussions ..." Promgirl, Inc. v. JPC Co., Ltd., ___ USPQ2d ___, 2009 WL 5194995 * 4 (TTAB Dec. 24, 2009).

Although both parties are represented by counsel, neither has followed clear and unambiguous Board Rules.

² Respondent's motion is couched in places like one to dismiss for failure to state a claim under Fed. R. Civ. P. 12(b)(6), and on page 1 indicates that it "falls under" Fed. R. Civ. P. 12(f).

Even more importantly, the parties' violations of the Rules are not merely technical, but instead have resulted in the filing of unnecessary and inappropriate motions which have drained Board resources and delayed resolution of this dispute. It is apparent that if the parties had been discussing this proceeding and their intentions openly and candidly, both of them, and the Board, would have been better served. Under the circumstances, the parties are hereby warned that any future failures to comply with the letter or spirit of the applicable Rules will be looked upon with extreme disfavor, and may result in appropriate adverse action by the Board. Disclosure, discovery, trial and other dates are reset as follows:

Deadline for Discovery Conference	May 12, 2010
Discovery Opens	May 12, 2010
Initial Disclosures Due	June 11, 2010³
Expert Disclosures Due	October 9, 2010
Discovery Closes	November 8, 2010
Plaintiff's Pretrial Disclosures	December 23, 2010
Plaintiff's 30-day Trial Period Ends	February 6, 2011
Defendant's Pretrial Disclosures	February 21, 2011
Defendant's 30-day Trial Period Ends	April 7, 2011
Plaintiff's Rebuttal Disclosures	April 22, 2011

³ This new deadline applies to petitioner only, as respondent has now served its formal initial disclosures.

Plaintiff's 15-day Rebuttal Period Ends

May 22, 2011

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 Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.
