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

Proceeding	92052150
Party	Plaintiff Wonderbread 5
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD**

In re Registration No. 3691948 for the Word Mark WONDERBREAD 5
(Registered on October 6, 2009)

_____)	
WONDERBREAD 5,)	
)	Cancellation No. 92052150
Petitioner,)	
)	
v.)	
)	
PATRICK GILLES,)	
)	
Registrant.)	
_____)	

**REPLY MEMORANDUM IN SUPPORT OF
PETITIONER’S MOTION FOR SANCTIONS**

Petitioner Wonderbread 5 (“Petitioner”) brought the instant motion for sanctions (“Motion”) as a result of Registrant Patrick Gilles’s (“Registrant”) unjustified refusal to appear for a properly noticed deposition. Registrant twice cancelled his deposition, each time less than 24 hours before the deposition was scheduled to begin. On the second occasion, Registrant’s counsel stated “we are not prepared to attend the deposition” – “**which we will not permit to happen.**”¹

Registrant failed to timely oppose Petitioner’s Motion. He did not seek an extension of time for filing an opposition from Petitioner or from the Board, and he has not even attempted to demonstrate any excuse for his failure to comply with the Board’s timing requirements. The Board should therefore disregard Registrant’s untimely opposition. Even if the Board considers the untimely-filed brief, Petitioner’s Motion should be granted on its merits.

I. FACTS AND PROCEDURAL HISTORY

As set forth in detail in Petitioner’s moving papers, Petitioner filed its Motion for sanctions only after many weeks of attempting to secure Registrant’s deposition, after Registrant’s representations that he would provide acceptable deposition dates repeatedly turned out to be untrue, and after Registrant twice failed to appear for properly noticed depositions. The motion was filed and served by mail on May 22, 2012.

Pursuant to TBMP 502.02(b), if Registrant intended to oppose the motion, such opposition was required to be filed within 20 days (15 days, extended by 5 days for mail service), *i.e.*, by June 11, 2012. No opposition was filed by the deadline. Registrant obtained neither a stipulation from Petitioner nor an order from the Board extending the deadline, yet on

¹ See Exhibit J to the Declaration of Cari A. Cohorn in Support of Petitioner’s Motion for Sanctions, filed May 22, 2012.

June 15, 2012, Registrant filed a document entitled “Opposition to Petitioner’s Motion for Sanction/Cross-Motion for Sanctions and/or Motion to Compel.”

II. REGISTRANT’S UNTIMELY OPPOSITION SHOULD BE DISREGARDED

Absent a stipulation of the parties (with Board approval) or a Board order, the filing deadlines of TBMP 502.02(b) are mandatory. *See id.* (“time periods for responding to motion **shall apply...**”) (emphasis added). The Board will only grant an extension of time “on motion for good cause.” The Board may also reopen the time for filing a response on a motion made after the time has expired if the party failed to act because of excusable neglect. Here, Registrant has made no such motion. As such, the opposition is indisputably untimely.

“If the nonmoving party has not given its consent to a motion, but does not file a brief in opposition thereto during the time allowed therefore, the Board, in its discretion, may grant the motion as conceded.” TMBP § 502.04. The Board has properly exercised its discretion to treat an unopposed dispositive motion, such as the one at issue here, as conceded, thereby ruling in favor of the moving party without regard to the merits of the motion. *E.g., Chesebrough-Ponds, Inc. v. Faberge, Inc.*, 618 F.2d 776 (C.C.P.A. 1980) (treating motion for summary judgment as conceded); *Central Mfg., Inc. v. Third Millennium Tech., Inc.*, 61 U.S.P.Q.2d 1210 (treating motion to dismiss as conceded). As the Court of Customs and Patent Appeals stated in *Faberge*:

Litigation is run by rules designed to assure orderly conduct of the proceedings. **One of those rules is the timely submission of briefs unless an extension of time has been granted.**

618 F.2d at 780 (emphasis added).

Here, it is proper to disregard Registrant’s untimely opposition and grant the Motion as conceded. By filing his opposition after the deadline – without the Board’s authorization and without any suggestion that his failure to comply with the filing deadline was justified –

Registrant has impermissibly disregarded an important rule of procedure, and has effectively conceded the Motion.

III. IF THE BOARD REACHES THE MERITS OF THE MOTION, SANCTIONS SHOULD BE AWARDED

Should the Board choose not to treat the Motion as conceded, the Motion should nonetheless be granted on its merits. As detailed in the Motion, Registrant ignored multiple attempts to schedule a deposition on a mutually agreeable date and on two occasions informed Petitioner's counsel – just a day before the scheduled depositions – that he would not appear for properly noticed depositions. This conduct warrants severe sanctions.

A. The Facts Demonstrate a Clear Pattern of Evasion

Registrant seeks to avoid sanctions through a recitation of revisionist history inconsistent with the parties' written communications (which have been presented to the Board as Exhibits to the Declaration of Cari A. Cohorn in Support of Petitioner's Motion for Sanctions ("Counsel Dec."), filed May 22, 2012) and by attempting to justify his own misconduct by alleging misconduct by Petitioner.

Contrary to Registrant's assertions, it is Registrant – not Petitioner – who misrepresents the facts. For instance, Registrant claims that counsel for Petitioner "stated that the deposition would not be able to move forward" on the day it was originally noticed. (Opp. at p. 6.) Incorrect: Petitioner's counsel actually stated that "we *may* need to change the date *or the location*" of the deposition. (Counsel Dec., Ex B, emphasis added.) Similarly, Registrant claims "subsequent emails place some ambiguity as to whether the deposition could actually have moved forward on that date." (Opp. at p. 6.) Wrong again: Petitioner's counsel straightforwardly informed Registrant's counsel that "[s]ince you have not contacted us to

indicate your client is unavailable for his noticed deposition on Friday, April 20, *the deposition is going forward.*” (Counsel Dec., Ex. D, emphasis added.)

Most importantly, Registrant’s contention that counsel for both parties agreed that the deposition would not take place until after a separate discovery dispute had been resolved (and after Petitioner had provided additional responses and documents) is contradicted by the evidence. The parties’ agreement – as confirmed by Registrant’s counsel in writing – said nothing whatsoever about conditioning Registrant’s appearance for deposition on the receipt of further discovery responses from Petitioner. (Counsel Dec., Ex. E.) In confirming that Petitioner’s counsel’s recitation of the agreement was correct, Registrant’s counsel stated “I will be in touch next week to re-schedule the deposition.” (*Id.*) He did not mention *any* condition precedent to doing so. It was only after Registrant’s counsel again failed to follow through on his promise to provide deposition dates, and Petitioner renoticed the deposition, that Registrant’s counsel raised *for the first time* his purported entitlement to receive further discovery responses before providing dates for deposition. (Counsel Dec., Exs. H, I, J.)

The written record before the Board is clear: Registrant is attempting to use an ancillary discovery dispute as a *post hoc* rationalization for his improper and wholly unjustified refusal to appear for deposition. Sanctions are necessary to deter this type of gamesmanship.

B. No Authority Whatsoever Supports Registrant’s Assertion That His Refusal to Appear for Deposition was Excusable

Despite all his efforts to justify his failure to appear, Registrant’s opposition does not address *any* of the authorities cited in the Motion for the proposition that an ongoing discovery

dispute² cannot justify a failure to appear for a deposition. *E.g., HighBeam Marketing, LLC v. Highbeam Research, LLC*, 85 USPQ2d 1902 (TTAB 2008); *Nat'l Academy of Recording Arts & Sciences, Inc. v. On Point Events, LP*, 256 F.R.D. 678 (C.D. Cal. 2009); *Criterion 508 Solutions, Inc. v. Lockheed Martin Services, Inc.*, 255 F.R.D. 489 (S.D. Iowa 2009). **Similarly, he fails to acknowledge that the Board's own rules expressly contradict his contention.** Specifically, TBMP section 403.03 states in pertinent part:

Discovery in proceedings before the Board is not governed by any concept of priority of right to take discovery or depositions. That is, a party which is the first to serve a request for discovery does not thereby gain an absolute right to receive a response to its request before it must respond to its adversary's subsequently served request for discovery, and this is so even if its adversary fails to respond, or respond completely to the first party's request for discovery. **Rather, each party is under an obligation to respond to an adversary's request for discovery ... irrespective of the sequence of requests for discovery, or of an adversary's failure to respond to a pending request for discovery.**

Id. (citing Fed. R. Civ. P. 26(d); *Miss America Pageant v. Petite Prods., Inc.*, 17 USPQ2d 1067, 1070 (TTAB 1990); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626, 632 (TTAB 1986) (emphasis added). **In short, Registrant does not – and cannot – cite a single authority supporting his position because none exists.** Registrant's refusal to appear for deposition cannot be justified, and sanctions should be issued.

² As discussed in Petitioner's Memorandum in Opposition to Registrant's "Cross-Motion for Sanctions and/or Motion to Compel," filed concurrently herewith, Petitioner has fully complied with its discovery obligations. However, the authorities cited herein and in Petitioner's Motion state with unmistakable clarity that – even assuming, *arguendo*, that Petitioner had committed discovery misconduct – the existence of a dispute over Petitioner's discovery responses cannot justify Registrant's refusal to appear for deposition or protect him from the imposition of sanctions.

Registrant's history of failing to comply with discovery obligations – dating back to his improper concealment of the fact that he had registered the mark at issue in these proceedings³ – combined with his *post hoc* efforts to excuse his conduct make clear that he never intended to appear for deposition. This conclusion is further bolstered in that – even *after* receiving responses to the written discovery to which he claimed to be entitled to receive prior to deposition – Registrant *still* did not provide dates on which he would be available for deposition.⁴ Sanctions are the proper remedy for this pattern of obstruction.

IV. CONCLUSION

For all of the reasons set forth above, Petitioner respectfully requests that the Board disregard Registrant's untimely opposition brief, treat the Motion for Sanctions as conceded, and grant the Motion. Alternatively, even if the Board chooses not to treat the Motion as conceded, the Motion should nonetheless be granted on the merits. In any event, Petitioner respectfully

³ See Petitioner's Motion for Judgment on the Pleadings and the supporting Declaration of Counsel, both filed in this proceeding on July 30, 2010, and Petitioner's Opposition to Registrant's Rule 56(f) Motion for Discovery and the supporting Declaration of Counsel, both filed September 22, 2010 (detailing Registrant's concealment of the registration, despite both written discovery and deposition questioning on the subject). See also *Smith v. Smith*, 145 F.3d 335, 344 (5th Cir. 1998) (in ruling on motion for sanctions, it is appropriate to consider the non-compliant party's "dilatory and obstructive" discovery conduct in a related case).

⁴ See Declaration of Cari A. Cohorn in Opposition to Registrant's "Cross-Motion for Sanctions and/or Motion to Compel," filed concurrently herewith, at ¶¶ 13-15 and Ex. G.

requests that the Board issue terminating, evidentiary, and/or issue preclusion sanctions against Registrant.

Respectfully submitted,

WONDERBREAD 5

Dated: July 5, 2012

PHILLIPS, ERLEWINE & GIVEN LLP

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CERTIFICATE OF SERVICE

I, Rosemary A. Comisky Culiver, certify that on July 5, 2012, a true and correct copy of the following:

REPLY MEMORANDUM IN SUPPORT OF PETITIONER'S MOTION FOR SANCTIONS

PETITIONER'S MEMORANDUM IN OPPOSITION TO REGISTRANT'S "CROSS-MOTION FOR SANCTIONS AND/OR MOTION TO COMPEL"

DECLARATION OF CARI A. COHORN IN OPPOSITION TO REGISTRANT'S "CROSS-MOTION FOR SANCTIONS AND/OR MOTION TO COMPEL"

was sent by U.S. Mail to:

Matthew H. Swyers, Esq.
The Trademark Company
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Dated: July 5, 2012

PHILLIPS, ERLEWINE & GIVEN LLP

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