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

Mailed: December 12, 2012

Cancellation No. 92053501

Christian M. Ziebarth

v.

Del Taco, LLC

**Before Holtzman, Bergsman and Shaw, Administrative Trademark Judges.**

**By the Board:**

As background, on January 21, 2012, the Board issued an order granting respondent's motion to compel discovery with respect to respondent's discovery requests: interrogatory requests nos. 1-15 and requests for production nos. 1-26. The Board also granted respondent's motion to test the sufficiency of admissions: requests for admissions nos. 1-67. The Board found these discovery requests relevant because petitioner bears the ultimate burden of proof on the standing issue and discovery may be had relating to the basis for standing, including petitioner's bona fide intent to use the applied for mark for which petitioner's standing is based. *See Kaplan v. Brady*, 98 USPQ2d 1830, 1834 n.7 (TTAB 2011) (a respondent may rely on an affirmative defense that petitioner lacks standing to maintain this proceeding

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because he did not have a bona fide intent to use his pleaded mark when he filed the intent-to-use application to register the mark, but such defense must be pleaded).

On August 22, 2012, respondent filed a motion for sanctions arguing that petitioner failed to comply with the Board's discovery order of January 21, 2012. Alternatively, respondent seeks an order precluding petitioner from offering any evidence in which full discovery has not been provided, namely relating to petitioner's bona fide intent to use the mark NAUGLES and petitioner's alleged standing based on the application for that mark.

Respondent contends that the supplemental responses to the interrogatory requests "indicate a deliberate intent to evade any substantive response at all on the part of Petitioner." Respondent argues that petitioner improperly maintains objections lodged in its initial response to these interrogatory requests and that "only a portion" of petitioner's responses to these interrogatory requests "could feasibly be deemed responsive." Respondent complains that some of petitioner's responses to these requests are neither "concise [n]or relevant" and that other responses are "deliberately" "incomplete and inconsistent." Respondent also argues that respondent's document production is "woefully deficient" and that the documents include "inconsistent redactions" of what appears to be information

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not "subject to any claim of privilege and visible references to communications with an attorney, including the information that was conveyed by said attorney, but not redacted" which indicates an "intent to deliberately withhold certain chosen information from the document production by Petitioner." Respondent also points to an inconsistency between petitioner's response to interrogatory request no. 7 and amended response to request for admission no. 1 which respondent contends evidences a willful noncompliance of the Board's discovery order.

In response, petitioner argues that his supplemental responses "were genuine and not meant to evade any response to the admissions, questions and documents requested" and that any deficiencies were the result of excusable neglect and harmless error.<sup>1</sup> With regard to the requests for admissions, petitioner advises that he misread the requests as being posed in the affirmative rather than in the negative and that the majority of admissions were denied in error. Petitioner advises that he will provide supplemental responses "to its [sic] further responses to request for Admissions Set One to address the confusion resulting from the negative statements for admissions" and that he will

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<sup>1</sup> Petitioner has spent the majority of his response arguing the merits of his standing as relates to his bona fide intent to use the NAUGLES mark, see pages 1-5.

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provide additional supplemental responses to respondent's discovery requests, including a privilege log.

In reply, respondent reiterates the arguments in its motion.

If a party fails to comply with an order of the Board relating to discovery, including an order compelling discovery, a party may file a motion for sanctions, and the Board may order appropriate sanctions as defined in Trademark Rule 2.120(g)(1) and Fed. R. Civ. P. 37(b)(2), including entry of judgment. See TBMP § 527.01 (3d ed. rev. 2012); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848 (TTAB 2000). Sanctions which may be entered by the Board 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. TBMP § 527.01. Default judgment is a harsh sanction but is justified where no less drastic remedy would be effective and there is a strong showing of willful evasion. *Unicut Corporation v. Unicut, Inc.*, 222 USPQ 341 (TTAB 1984). Sanctions are available even absent a finding of willfulness or bad faith as "failure to comply with

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. . . discovery 'occur[s] along a continuum of fault-ranging from innocent through degrees of negligence to intentionality.'" *Linde v. Arab Bank, PLC*, 269 F.R.D. 186, 196-7 (E.D.N.Y. 2010) citing *Residential Funding Corp. v. DeGeorge Financial Corp.* 306 F.3d 99 (2d Cir. 2002).

We agree that the interposing of objections to these discovery requests after the Board's ruling that these requests were relevant is improper and such objections should not have been included in petitioner's supplemental responses. However, in addition to lodging improper objections, petitioner otherwise did provide substantive responses to the interrogatories and proper written responses to the requests for production.

As to respondent's complaints with respect to these discovery responses, respondent has specifically complained about two interrogatory responses and generally complained that the other interrogatory responses are vague, incomplete, or inconsistent. However, respondent has not specifically identified the other interrogatory responses which are vague, incomplete or inconsistent. Respondent has identified no specific requests for production as evidencing willful evasion, but generally complained about deficient production and inconsistent redactions, namely redacted information which appears not to be privileged and unredacted information relating to attorney-client

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communications. However, the redacted documents have not been supplied for our review. With respect to the requests for admissions, respondent has identified one request for admission which is inconsistent with an interrogatory response.

We find that petitioner has provided acceptable interrogatory responses for interrogatory requests nos. 2, 3, 4, 5, 7, 12 and 15 and non-responsive or vague interrogatory responses to interrogatory requests nos. 1, 6, 13, and 14, and interrogatory responses that require clarification, namely, interrogatory nos. 8 and 9--more clearly state he has not identified the territorial areas in the United States; interrogatory nos. 10 and 11--specify the type of retail food outlets. However, the Board does not find that such responses evidence a deliberate attempt to evade discovery such that default judgment should be entered or that such responses require a prohibition of introduction of certain evidence at trial.<sup>2</sup>

With respect to petitioner's responses to respondent's requests for production, respondent complains about the

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<sup>2</sup> Respondent complained that interrogatory no. 3 includes a single email address for four of the names identified. However a review of the interrogatory response indicates that four different e-mail addresses were provided for four of the five individuals identified. The fifth name identified is Barbara Caruso who is Del Taco's PR representative and contact information is within the possession of respondent. Respondent also complained that the response to interrogatory no. 7 is inconsistent with the response to request for admission no. 1 but

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responses to the document requests being "woefully deficient" due to the production of only seven documents. However, for the majority of the requests, petitioner indicates no responsive documents exist.<sup>3</sup> The Board finds that the written responses on their face do not demonstrate a deliberate attempt by petitioner to evade his discovery obligations, as aside from the improper objections, the responses otherwise properly state whether responsive documents exist and will be produced, or whether no responsive documents exist. With regard to the supplemental production that occurred after the March 14, 2012 deadline, the Board does not find a willful attempt to evade discovery inasmuch as petitioner's counsel states that these documents were not in existence prior to the March 14, 2012 deadline. Accordingly, the Board finds no willful evasion with respect to the requests for production such that default judgment should be entered or that the introduction of certain evidence should not be permitted at trial.

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otherwise did not specify a deficiency with this interrogatory response.

<sup>3</sup> With respect to the written responses to document request nos. 1-6, 23-26, petitioner stated that responsive documents would be produced. With respect to the written responses to document request nos. 7-22, petitioner stated that no responsive documents exist. Respondent has not identified any category of documents that have not been produced, and while respondent complains about improper objections, respondent has not stated that the written responses to the document requests are improper or otherwise deficient.

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Respondent has also complained about the inconsistency of request for admission no. 1 with interrogatory response interrogatory no. 7.

With regard to this request for admission, the Board does find an attempt by petitioner to evade his discovery obligations with respect to this request in light of the inconsistency with interrogatory response no. 7 which states that petitioner is not currently providing products to the public.

This improper response does warrant a sanction, although a lesser one than respondent has sought. As a sanction for this improper amended response, we deem this request for admission ADMITTED. Specifically, for purposes of this proceeding, petitioner is not providing to the public the products identified in its application.

In view thereof, respondent's motion for discovery sanctions is granted in part and denied in part as set forth above.

Petitioner's counsel has represented in his response to the motion for sanctions that petitioner will provide amended responses to the requests for admissions and will provide additional supplemental responses to the interrogatories and requests for production, including a privilege log. To the extent that these supplemental discovery responses have not been provided, petitioner is

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allowed until TWENTY DAYS from the mailing date of this order to serve supplemental responses. Such supplemental responses should include those interrogatory responses identified as deficient or requiring clarification herein. Supplemental responses shall omit the improper objections interposed by petitioner as well as extraneous irrelevant verbiage.

Finally, petitioner is reminded that it is bound by its responses to respondent's discovery requests. Respondent is advised to notify the Board in respondent's brief if petitioner's evidence and argument at trial exceed the information provided during discovery. In so doing, respondent should include copies of its discovery requests and petitioner's responses.

Proceedings are resumed.

Dates are reset as follows:

Discovery	<b>CLOSED</b>
Plaintiff's Pretrial Disclosures Due	<b>1/24/2013</b>
Plaintiff's 30-day Trial Period Ends	<b>3/10/2013</b>
Defendant's Pretrial Disclosures Due	<b>3/25/2013</b>
Defendant's 30-day Trial Period Ends	<b>5/9/2013</b>
Plaintiff's Rebuttal Disclosures Due	<b>5/24/2013</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>6/23/2013</b>

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.

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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.