

ESTTA Tracking number: **ESTTA592459**

Filing date: **03/13/2014**

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

Proceeding	92054496
Party	Defendant Pass The Roc Athletics, Inc.
Correspondence Address	Flann Lippincott, Esq. Lippincott IP LLC 107 Van Lieus Road Ringoos, NJ 08551 UNITED STATES flann@lippincottip.com
Submission	Opposition/Response to Motion
Filer's Name	Flann Lippincott
Filer's e-mail	flann@lippincottip.com
Signature	/Flann Lippincott, Esq./
Date	03/13/2014
Attachments	Pet Opp Mot Sanc.pdf(29672 bytes)

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

In the Matter of :
Registration No: 3,016,764
Mark: PASS THE ROC
Filed: December 13, 2003
Registered: November 22, 2005

HAT WORLD, INC.,

Petitioner,

vs.

PASS THE ROC ATHLETICS, INC.,

Registrant.

Opposition No. 92054496

REGISTRANT'S OPPOSITION TO PETITIONER'S MOTION
FOR SANCTIONS IN THE FORM OF ENTRY OF JUDGMENT

The Registrant, Pass The Roc Athletics, Inc ("Registrant"), through its counsel, hereby submits this Opposition to Petitioner's Motion for Sanctions in the Form of Entry of Judgment.

On March 6, 2014 (before expiration of discovery deadline contained in the Board's December 6, 2014 Order), Registrant's newly-retained counsel served Petitioner's counsel with Registrant's Initial disclosures, Registrant's Responses to Petitioner's First Set of Requests for Documents and Things, and Registrant's Responses to Petitioner's First Set of Interrogatories. Registrant acknowledges that it had not earlier responded to Petitioner's discovery requests and that Registrant was out of compliance with the Board's December 6, 2013 Order.

However, Petitioner's motion for sanctions - the most punitive remedy available - does not demonstrate (as it must) that Petitioner has been so prejudiced by Registrant's delayed discovery responses that it would be unfair to require Petitioner to proceed further in this matter; or that an intolerable burden has been, and will continue to be, placed on the Board by requiring the Board to

modify its docket and operations in order to accommodate the delay; or that any lesser sanction than default against Registrant will be ineffective or obviously futile. Webb v. Dist. of Columbia, 146 F.3d 964, 971-72 (1998).

BACKGROUND AND PROCEDURAL HISTORY

Registrant is the holder of the Mark, PASS THE ROC, Registration No. 3,016,764. PASS THE ROC was registered on November 22, 2005. PASS THE ROC was renewed on June 2, 2012 under Section 8 of the Trademark Act, 15 U.S.C. §1058. Registrant has maintained continuous, active use in interstate commerce of PASS THE ROC from the time of its initial registration to the present.

For the essential procedural history of this cancellation proceeding, Registrant yields to the docket ably chronicled by Petitioner in its motion for sanctions. Likewise Registrant does not dispute the occurrence of the events and correspondence in the rendition of "Facts" detailed in Petitioner's motion - absent Petitioner's gratuitous editorialization. Registrant does reject all of Petitioner's state-of-mind characterizations such as, "active refusal to engage," "willful disregard," "clear interest only in delay," "dilatory tactics," and "purposeful avoidance." None is accurate and none is supported. Two additional, essential items are not reflected in Petitioner's statement of procedural history. First, Registrant now has complied with all of Petitioner's discovery requests within the Board's discovery deadline. Second, the USPTO issued a Section 8 renewal to Registrant of PASS THE ROC on June 2, 2012.

ADDITIONAL FACTS

Jarrod Greene submits a declaration accompanying Registrant's opposition to the present motion in which Mr. Greene describes his background, his development of his business around PASS THE ROC and the reasons for his delay in providing discovery to Petitioner. Flann Lippincott submits a declaration affirming that Registrant has retained her firm as counsel and that Registrant now has served replies to Petitioner's discovery requests. Ms. Lippincott's declaration also provides a narrative of how in August 2010 Petitioner's parent company, retailing giant Genesco Inc. (with Fiscal 2013 net sales of more than \$2.6 billion) bought regional sporting goods retailer Anaconda Sports along with Anaconda's trademark, THE ROCK. Genesco recorded an assignment of THE ROCK from the newly-acquired Anaconda in

favor of Petitioner that October and literally within days Petitioner initiated a blunderbuss campaign to clear the field of any registration looking or sounding like the word "rock," no matter when filed or how long (before Petitioner's assignment) the registration had been in use. Petitioner now is prosecuting literally dozens of cancellation or revocation proceedings, along with this one, for purposes that Petitioner has not yet made expressly clear.

ARGUMENT

"Three basic justifications . . . support the use of dismissal as a default judgment as a sanction for misconduct:" if the "errant party's behavior has severely hampered the other party's ability to present his case," if "the party's misconduct has put an intolerable burden on a district court by requiring the court to modify its own docket and operations in order to accommodate the delay," or if the Court finds the need "to sanction conduct that is disrespectful to the court and to deter similar misconduct in the future." Compton v. Alpha Kappa Alpha Sorority Inc., 938 F.Supp.2d 103, 106 (2013) (quoting Webb v. District of Columbia, 146 F.3d 964, 971 (D.C.Cir.1998)); see Shea v. Donohoe Constr. Co., 795 F.2d 1071, 1074-77 (D.C.Cir. 1986). The rare sanction of cancellation must not be imposed to denude an otherwise meritorious defense where a lesser sanction may be warranted and would be effective. Webb, 141 F.3d at 971-72. Compare Kaplan v. Brady, 98 USPQ2d 1830 (TTAB 2011) (lesser sanction warranted despite Board's finding of affirmative obstruction) with Benedict v. Super Bakery, Inc., 665 F.3d. 1263, 1268-69, 101 USPQ2d 1089 (Fed. Cir. 2011) (Discovery never provided even after Motion to Sanction); MHW Ltd. V. Simex Aussenhandelsgesellschaft Savelsberg KG, 59 USPQ2d 1477 (TTAB 2000) (not mere delay; contrived and willful conduct demonstrated with evidence); Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co., 55 USPQ2d 1848, 1854 (TTAB 2000) (oft-cited but procedurally idiosyncratic decision with ample demonstration of contrived, "dilatatory conduct" and "willful evasion" by counsel); MySpace, Inc Mitchell, 91 USPQ2d 1060 (TTAB 2009) (ad hominem attacks against opposing counsel's family infused with personal attacks against the Board); Patagonia, Inc. v. Azzolini, 109 USPQ2d 1859 (TTAB 2014) (failure to respond even to sanctions motion combined with willful, cavalier attitude).

"Fundamentally penal" sanctions such as "dismissals and default judgments, as well as contempt orders, awards of attorneys' fees, and the imposition of fines" require proof of conduct by clear and convincing evidence. A court may enter a punitive sanction (such as cancellation) "only if it finds, first, that there is clear and convincing evidence that the fraudulent or bad faith misconduct occurred, and second, that a lesser sanction 'would not sufficiently punish and deter the abusive conduct while allowing a full and fair trial on the merits' . . . provid[ing] a specific reasoned explanation for rejecting lesser sanctions." Compton, 938 F.Supp.2d at 106 (quoting Young v. Office of U.S. Senate Sergeant at Arms, 217 F.R.D. 61, 66 (D.D.C.2003) (internal citations omitted).

Petitioner provides no evidence, let alone clear and convincing evidence, how Registrant's delay (until now) in providing discovery has "severely hampered" Petitioner's ability to present its case. Petitioner points to no evidence that Registrant has "put an intolerable burden" on the Board by requiring it to modify its docket and operations. (Conversely, Petitioner's own conduct - filing and pursuing dozens and dozens of actions, perhaps regardless of merit - hardly seems to tip the scale of equity in Petitioner's direction.) Petitioner has not even tried to demonstrate that a sanction less than cancellation will not be effective going forward. In fact, existing sanctions on Registrant already have produced the desired effect: Registrant has served its discovery responses; Petitioner's unhelpful say-so regarding Registrant's "willful disregard" and "purposeful avoidance" does not rise to a "clear and convincing" level merely through the invocation of inflammatory rhetoric.

For these reasons, Registrant respectfully request that the Board deny Petitioner's Motion for Sanctions in the Form of Entry of Judgment, and permit Registrant to establish its meritorious defenses to the Petition to Cancel.

Dated: March 6, 2014

Respectfully submitted,

LIPPINCOTT IP LLC

By: /s/ Flann Lippincott
Flann Lippincott

107 Van Lieus Road
Ringoes, New Jersey 08551
Telephone: (908) 237-0400
Facsimile: (908) 237-0401
flann@lippincottip.com

Counsel for Registrant