

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

RK

Mailed: July 7, 2014

Cancellation No. **92054496**

Hat World, Inc.

v.

Pass The Roc Athletics, Inc.

**Before Kuhlke, Cataldo and Masiello,
Administrative Trademark Judges**

By the Board:

This matter comes up on petitioner's motion (filed February 21, 2014) for sanctions in the form of judgment and petitioner's motion (filed April 4, 2014) to suspend this proceeding pending disposition of a civil action between the parties. The motion for sanctions is fully briefed.

Background

As last reset, discovery was scheduled to close on July 13, 2013. On May 8, 2013, petitioner filed a motion to compel respondent's initial disclosures and responses to petitioner's first set of interrogatories and document requests served on January 17, 2013. Having received no response thereto from respondent, the Board granted the motion as conceded on December 6, 2013, and ordered respondent to serve its responses to petitioner's outstanding discovery requests within thirty days. On February

21, 2014, petitioner filed a motion for sanctions after respondent failed to provide its discovery responses as ordered by the Board. Shortly thereafter, on March 3, 2014, respondent filed a change of correspondence identifying newly hired counsel Flann Lippincott as its correspondent.¹ Respondent then served its initial disclosures and discovery responses via email on March 6, 2014, and via first-class mail on March 7, 2014. Respondent also filed its opposition to the motion for sanctions on March 13, 2014. Petitioner filed its reply on April 1, 2014.

Decision

Where a party fails to comply with an order of the Board relating to discovery, the Board may order appropriate sanctions, including entry of default judgment. Trademark Rule 2.120(g)(1) and Fed. R. Civ. P. 37(b)(2). We note, however, that default judgment is a harsh remedy that is granted where no less drastic remedy would be effective and where there is a strong showing of willful evasion. *See Unicut Corp. v. Unicut, Inc.*, 222 USPQ 341, 344 (TTAB 1984).

Notwithstanding the protracted history of this proceeding, as ably recounted by petitioner in its motion, we do not find the kind of willful evasion on the part of respondent that would warrant the entry of default judgment. Respondent secured the services of new counsel and served petitioner with its initial disclosures and responses to petitioner's discovery

¹ Respondent's second change of correspondence (filed April 30, 2014) is noted and respondent's correspondence address has been accordingly updated.

requests, albeit late. Respondent was ordered to provide its responses without objection on the merits and petitioner has failed to articulate any prejudice from respondent's delay. This is particularly true considering that petitioner seeks to suspend this proceeding in favor of a civil action between the parties in the United States District Court for the District of New Jersey.²

In view thereof, petitioner's motion for sanctions in the form of judgment is hereby **DENIED**. Further, as petitioner's motion to suspend this matter is uncontested, the motion to suspend is hereby **GRANTED** as conceded. See Trademark Rules 2.127(a) and 2.117(a). Accordingly, proceedings herein are **SUSPENDED** pending final disposition of the civil action.

Within **TWENTY DAYS** after the final determination of the civil action, the parties shall so notify the Board and call this case up for any appropriate action. During the suspension period, the parties shall notify the Board of any address changes for the parties or their attorneys.

* * *

² *Hat World, Inc. v. Pass the Roc Athletics, Inc.*, Civil Action No. 2:14-cv-02063-CCC-MF.