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

DUNN

Mailed: May 10, 2012

Cancellation No. 92054551

Andrey Pinsky

v.

Douglas Burda

Before Grendel, Wellington, and Kuczma, Administrative Trademark Judges:

By the Board:

This case comes up on the following motions[1]:

i. respondent's motion for sanctions, filed February 15, 2012;

ii. petitioner's motion to compel discovery responses, filed February 20, 2012; and

iii. respondent's motion to extend time to respond to the motion to compel, filed March 9, 2012.

All motions are contested. Proceedings are considered to have been suspended as to all matters unrelated to the motions with the filing of the motion to compel.

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[1] Petitioner's second request for removal of the Board attorney assigned to this proceeding, filed January 25, 2012 and also lacking proof of service, has been referred to the Chief Administrative Trademark Judge, who has authorized this panel to deny the request.

No consideration has been given to petitioner's February 13, 2012 filing which lacked proof of service pursuant to Trademark Rule 2.119, or petitioner's sur-reply on the motion for sanctions, barred by Trademark Rule 2.127.

MOTION FOR SANCTIONS DENIED

Because respondent's statutory bases for seeking sanctions are lacking in several key respects,[2] we deny his motion. However, we have reviewed the circumstances in this proceeding and decided to consider sanctions pursuant to our inherent authority. See Chambers v. NASCO, Inc., 501 U.S. 32 (1991) (stating that this inherent power "stems from the very nature of courts and their need to be able to manage their own affairs so as to achieve the orderly and expeditious disposition of the cases."); Trademark Trial and Appeal Board Manual of Procedure (TBMP) §527.03 (3rd ed. 2011). In particular, we note that petitioner has repeatedly acted in contravention of specific Board orders and the rules governing this proceeding, namely his failure to include proof of service; filing a discovery request with the Board; and the submission of papers which do not comply with the Board's formatting rules. Indeed, petitioner does not dispute that its two earlier filings (respectively, a request for removal of the Board attorney assigned to this case, and copies of discovery requests served on respondent)

[2] Contrary to respondent's contention, because there has been neither a prior discovery order nor compliance with Fed. R. Civ. P. 11(c)(2)'s safe harbor provision, sanctions are not available pursuant to Trademark Rule 2.120(g)(1) or Fed. R. Civ. P. 11. See Nobelle.com LLC v. Qwest Communications International Inc., 66 USPQ2d 1300, 1303 (TTAB 2003) and Baron Philippe de Rothschild S.A. v. Styl-rite Optical Mfg. Co., 55 USPQ2d 1848, 1854 (TTAB 2000).

were not compliant with the Board's orders on service, discovery, and formatting but refers to them as "informal letters," implying that these filings are not part of the record for this proceeding. While the second request for removal is not part of the proceeding file (and has been designated as confidential by the Board), petitioner has already been advised that discovery requests should only be submitted as an exhibit to a motion. As noted above, the Board has not considered petitioner's discovery requests.

Petitioner's opposition to the motion for sanctions contains personal attacks on respondent which do nothing to advance the legal issues in this proceeding.[3] In the December 1, 2011 discovery conference order, the Board clearly instructed the parties to curb such attacks:

> As discussed, one party's opinion about the conduct or character of the other party is irrelevant to this proceeding and should not be expressed orally or in writing to the Board. If pertinent to a motion requesting specific action from the Board, specific actions by the other party should be described without comment.

Petitioner's inflammatory descriptions of respondent's family and business in his opposition to the motion for sanctions have no place in this proceeding, and were filed in violation of the aforementioned Board order. **If petitioner files**

[3] In view of the personal nature of petitioner's attacks on respondent, the Board has designated petitioner's opposition as "confidential."

another paper which violates a Board order, the Board may sua sponte dismiss this proceeding with prejudice.

We note that respondent alleges that petitioner failed to serve initial disclosures. In response, petitioner argues that respondent refused delivery of his initial disclosures. Petitioner's response includes a copy of his initial disclosures, certificates of service by FedEx courier dated December 29, 2011 and January 6, 2012, and FedEx tracking information showing that a package sent from petitioner on January 6, 2012 to respondent was refused delivery on January 9, 2012. Respondent's reply brief states "Petitioner is playing games with the methods of service of papers in this Proceeding, and seems to have concocted a complex scheme utilizing the limitations of Federal Express as a means of doing so." However, because respondent offers no explanation to rebut petitioner's FedEx tracking information showing that the delivery was refused, the alleged failure to serve initial disclosures is not a basis for sanctions. Service of papers is addressed further in connection with the motion to compel.

In sum, while we have decided not to enter specific sanctions at this point resulting from the aforementioned misconduct, petitioner is hereby put on notice that this proceeding is subject to dismissal with prejudice should he file any further papers containing personal attacks on

respondent or that are deemed completely irrelevant to the merits of this proceeding. The Board will also consider further sanctions, as appropriate, based on any failure to adhere to other directions from the Board or the rules governing this proceeding.

EXTENSION TO RESPOND TO MOTION TO COMPEL GRANTED

On February 20, 2012, petitioner moved to compel responses to its request for the production of documents served December 29, 2011 with its initial disclosures. Petitioner's motion to compel was filed five days after respondent's motion seeking entry of judgment as a sanction. Respondent moved to suspend proceedings, including its time to respond to the motion to compel, pending the disposition of the motion for sanctions.[4] Petitioner opposed suspension, alleging that respondent was aware of the imminent motion to compel, and filed the motion for sanctions to mask his failure to timely provide requested discovery.[5] On March 16, 2012, respondent filed a response to the motion to compel. Accordingly, respondent's motion to suspend is granted to the

[4] Pursuant to Trademark Rule 2.127(d), the filing of a potentially dispositive motion results in suspension of the proceeding "with respect to all matters not germane to the motion."

[5] Because petitioner's 324-page opposition to the extension includes the same inflammatory material included with its opposition to the motion for sanctions, it also has been designated as confidential.

extent that respondent's response to the motion to compel is accepted as timely.

MOTION TO COMPEL DENIED

Petitioner alleges that respondent failed to provide discovery responses due February 2, 2012. As the required proof of his good faith effort to resolve the matter with respondent before filing the motion, petitioner includes a copy of his February 13, 2012 letter to respondent indicating that a motion to compel would be filed if no responses were forthcoming.[6] In response, respondent states that petitioner never served initial disclosures, that petitioner falsified certificates of service indicating that he did serve the disclosures, but "in the best interest of the Board and the parties" respondent served responses to the petitioner's discovery requests with its opposition to the motion to compel. Petitioner filed a reply brief indicating that respondent's responses to the discovery requests are insufficient. However, the copy of respondent's response included with petitioner's reply brief does not include the referenced attachments.

[6] Because it is not necessary to this order, we do not address the sufficiency of petitioner's good faith effort to resolve this discovery dispute.

Because one of the exhibits to the motion to compel is a copy of the request for removal which the Chief Administrative Trademark Judge for the Board designated as confidential, that filing is also designated as confidential.

Inasmuch as the original motion to compel sought responses and responses have been served, the original motion to compel is moot. See Luehrmann v. Kwik Kopy Corp., 2 USPQ2d 1303 (TTAB 1987) (late responses rendered motion to compel, based on complete non-responsiveness, moot). Because the disputed responsive documents were not included with petitioner's reply brief, the Board has no basis upon which to rule on the sufficiency of respondent's response. Accordingly, petitioners' motion to compel discovery responses is denied without prejudice.

Absent extraordinary circumstances, no papers may be filed with the Board by either party for forty-five days from the mailing date of this order.

As detailed more fully below, the conduct of this proceeding by both parties remains unsatisfactory and inappropriate for attorneys who should be focused on advancing determination of a case on its merits not disposition through attempts to frustrate and annoy each other.

Petitioner, who filed more than a thousand pages since the last Board order, is ordered to cease submitting copies of prior orders and filings in this proceeding as exhibits to motions; to cease making arguments or submitting evidence regarding respondent's use or registration of his unrelated PANDA marks; and to cease arguing the merits of past Board

orders.[7] Any paper filed by petitioner which includes documents already of record, or refers to respondent's unrelated marks, or argues the merits of past orders, will be refused consideration. To be clear, if a filing by petitioner violates any of these prohibitions, in its text or in attachments thereto, the entirety of the filing shall be refused consideration. See Blackhorse v. Pro Football Inc., 98 USPQ2d 1633, 1634 (TTAB 2011).

Further, inasmuch as this proceeding is still in its early stages but the proceeding file has nonetheless expanded to thirty-nine docket entries, the parties are barred from filing any unconsented motion without the express permission of the Board, which must be obtained by calling Board attorney Elizabeth Dunn at 571-272-4267.

The party seeking to file a paper in the next forty-five days or an unconsented motion for the remainder of this proceeding must (i) discuss with the other party and agree on three alternative dates and times when a conference with the Board attorney could be held; (ii) arrange the conference with the Board and the other party; and (iii) during the

[7] Because the period for filing a petition to the Director seeking review of an interlocutory order pursuant to Trademark Rule 2.146 runs concurrently with the period for filing a request for reconsideration of an interlocutory order pursuant to Trademark Rule 2.127, once the thirty-day period following issuance of the order has passed, the party who disagrees with a Board order is limited to seeking reversal of the order as part of its trial brief to the panel at final hearing. See Harley-Davidson Motor Company, Inc. v. Pierce Foods Corp., 231 USPQ 857, 859 n.13 (TTAB 1986).

conference, explain the circumstances warranting the filing. If appropriate, the Board will authorize filing or addressing by phone the paper within the next forty-five days or, for the remainder of this proceeding, the unconsented motion.

Within TWENTY DAYS of the mailing date of this order, respondent is ordered to provide proof of the first date of use of his mark in commerce pursuant to the parties' stipulation for expanded initial disclosures approved during the discovery conference.[8]

Effective immediately, respondent is ordered to cease unsubstantiated allegations that petitioner falsified certificates of service. Petitioner provided tracking information indicating refusal of delivery by FedEx courier at respondent's address of record. Respondent has not addressed this tracking information except to repeat that petitioner's initial disclosures were not served.

Within TWENTY DAYS of the mailing date of this order, respondent must communicate with FedEx to ensure service to respondent's address of record. If service is not possible, respondent must file a new address of record to which FedEx

[8] Respondent only expanded his initial disclosures by including a copy of the subject registration. Ownership of a registration establishes priority in an opposition only. See King Candy Co., Inc. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Therefore, respondent's service of a copy of his registration is not sufficient to comply with the stipulation that respondent would provide evidence of its first use, and such evidence must now be provided as a supplement to the initial disclosures, as ordered herein.

will deliver. As discussed in the prior Board order, a Canadian party does not have as many options for service under the Board's rules as parties located in the United States.

Effective immediately, both parties are ordered to supplement their service of papers with a phone call made the same day of service to the receiving party to notify them that papers have been served. The parties remain under Board order to promptly return all phone calls; and the parties are expected to maintain logs or records of all phone calls placed to or received from the other party. If respondent is notified by phone of service and no service is effected, respondent must call petitioner to seek the tracking information and rectify any new problems with Federal Express service to its address of record. Any subsequent motion by respondent to adjust response times based on service problems must be supported by respondent's sworn statement regarding the required communications with FedEx and petitioner.

Within TWENTY DAYS of the mailing date of this order, respondent must supplement his response to petitioner's discovery requests in accordance with the following:

- The request for documents in support of the affirmative defenses pleaded in the second amended answer is not overly broad or vague and therefore, non-privileged responsive documents shall be produced.
- The claim of attorney-client privilege must be accompanied by a privilege log. See Fed. R. Civ. P. 26(b)(5)(ii)("When a party withholds information otherwise discoverable by claiming that the information is privileged or subject to protection as trial-

preparation material, the party must describe the nature of the documents, communications, or tangible things not produced or disclosed—and do so in a manner that, without revealing information itself privileged or protected, will enable other parties to assess the claim."); Red Wing Co. v. J.M. Smucker Co., 59 USPQ2d 1861, 1864 (TTAB 2001) (party making claim of privilege must do so expressly and otherwise describe the nature of the withheld information as provided in Rule 26(b)(5)).

- Respondent's discovery response does not indicate the volume of responsive documents and thus does not support the conclusion that the request is burdensome. Bison Corp. v. Perfecta Chemie B.V., 4 USPQ2d 1718, 1720 (TTAB 1987) (production of representative sample was not appropriate where full production, that is, a total of eleven documents, was clearly not burdensome).
- Because the second amended answer is the operative pleading in this proceeding, the request for documents in support of the first amended answer is irrelevant.
- Trademark search reports are discoverable, but the comments or opinions of attorneys relating thereto are generally privileged and not discoverable. See TBMP §414 (3rd ed. 2011).

Respondent's document production must make clear to which affirmative defense each document is responsive.

If petitioner finds the discovery supplementation ordered herein deficient, petitioner must promptly communicate to respondent in writing the reasons why the discovery response remains deficient.

PROCEEDINGS RESUMED

Expert Disclosures Due	**7/18/2012**
Discovery Closes	**8/17/2012**
Plaintiff's Pretrial Disclosures	**10/1/2012**
Plaintiff's 30-day Trial Period Ends	**11/15/2012**
Defendant's Pretrial Disclosures	**11/30/2012**
Defendant's 30-day Trial Period Ends	**1/14/2013**
Plaintiff's Rebuttal Disclosures	**1/29/2013**
Plaintiff's 15-day Rebuttal Period Ends	**2/28/2013**

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

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