

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
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Mailed: May 31, 2013

Cancellation No. 92056125

U.S.A. Dawgs, Inc.

v.

James B. Sanders

By the Board:

James B. Sanders ("respondent") owns a registration for the mark GDOGGS (standard characters) for the following International Class 25 goods:

footwear and apparel, namely, boots, shoes, sandals, socks, shorts, pants, shirts, jerseys, jackets, coats, sweaters, hats, visors, caps, pullovers, swimwear, jump suits, T-shirts, sweatshirts, sweatpants, tights, skirts, dresses, and warm-up suits.¹

U.S.A. Dawgs, Inc. ("petitioner") filed a petition to cancel the registration, alleging 1) fraud, 2) abandonment under Trademark Act Section 45, and 3) "[T]he registration is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used."

Respondent denied the salient allegations in the petition to cancel.

¹ Registration No. 3842092, registered August 31, 2010.

Petitioner filed a motion for summary judgment on the basis that respondent was not using the mark on any of the identified goods when respondent filed his statement of use.

Respondent opposes the motion for summary judgment on the basis that it is premature, citing Trademark Rule 2.127(e)(1), and asserting that petitioner had not made its initial disclosures, and did not make such disclosures prior to or concurrent with the filing of the summary judgment motion.²

In reply, petitioner asserts, inter alia, that during the parties' discovery and settlement conference, petitioner informed respondent that petitioner "had already attached and served all relevant documents that Petitioner intended to rely on to the Petition for Cancellation" (petitioner's reply brief, p. 2). It thus argues that its "initial disclosures were already attached as exhibits to the Petition for Cancellation." *Id.* With its reply brief, petitioner attached what it terms "Petitioner's Initial Disclosure memo." *Id.* Petitioner also asserts that it has produced all of the discoverable information currently in its custody that it intends to use to support its claims, and has disclosed the existence and location of documents it intends to use to support its claims

² Respondent filed its initial disclosures with the Board. Written disclosures may be filed with the Board in support of or in response to a motion for summary judgment. See Trademark Rule 2.120(j)(8); TBMP § 704.09. Here, inasmuch as the Board denies petitioner's motion as premature, the Board gives no consideration to respondent's initial disclosures in determination of the motion or for any other purpose.

(petitioner's reply brief, p. 4). It further argues that its summary judgment motion should be granted as conceded based on a finding that respondent did not file a brief addressing the substantive arguments in the motion.³

Analysis

Trademark Rule 2.127(e)(1) provides, in pertinent part, as follows:

A party may not file a motion for summary judgment until the party has made its initial disclosures.

The requirement that a party must serve initial disclosures prior to or concurrently with the filing of a motion for summary judgment cannot be waived. *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1769-70 (TTAB 2010).

Here, in the manner in which dates were reset by the Board, the parties were under obligation to serve initial disclosures on or before January 15, 2013. Petitioner filed its motion seeking summary judgment on January 7, 2013.

The record that is before the Board by way of petitioner's filing of its motion for summary judgment does not reflect that petitioner served its initial disclosures prior to or concurrently with its motion. Petitioner has

³ On March 15, 2013, respondent filed a paper captioned "Respondent's Supplemental Motion to Deny Petitioner's Motion for Summary Judgment." It is an impermissible surreply to petitioner's motion. See TBMP § 528.03 ("The Board will consider no further papers beyond a timely reply brief in support of or in opposition to a motion for summary judgment."). The filing has been given no consideration. For completeness, upon cursory review of the filing, as a motion

provided no copy of what it asserts that it served in specific fulfillment of its initial disclosure duty, such as a copy authenticated by way of affidavit or declaration. To the extent that petitioner relies on its verbal communication to respondent during their discovery conference, the record does not unequivocally reflect that petitioner served its initial disclosures with its petition to cancel, let alone the contents of said disclosures. To the extent that petitioner made statements during the parties' discovery conference in a manner such as to, or in a manner intended to, identify or characterize its petition and/or attachments thereto, in whole or in part, as constituting the service of its initial disclosures, said effort was insufficient. The substance of any such communication is not now clear, and furthermore was not reduced to writing. The petition to cancel, itself, does not reference or identify any contents therein, in whole or in part, as including or constituting initial disclosures.

The only manner in which the written record reflects petitioner's asserted service of initial disclosures is by way of a filing submitted concurrently with petitioner's February 13, 2013 reply brief, which includes a Certificate of Service dated February 13, 2013. Inasmuch as said

under Fed. R. Civ. P. 56(d) it is both untimely and statutorily noncompliant. See Trademark Rule 2.127(e)(1); TBMP § 528.06.

document includes the prefatory language "[A]s identified in the Petition, and in the Discovery Conference...," petitioner could not have served this same document on respondent when it served its petition for cancellation, or coincident with the discovery conference.

Had petitioner provided substantiation with its summary judgment motion that supports its assertion that it had served on respondent a clearly identifiable document or set of documents or exhibits, readily discernible as setting forth its initial disclosures, the Board might be in a position to find that petitioner had fulfilled its duty. Petitioner's mere assertion that documents and/or exhibits attached to its petition for cancellation were intended to serve as its initial disclosures is not sufficient for the Board to find that petitioner satisfied its obligation under Trademark Rule 2.127(e)(1).

The duty to comply with the disclosure requirements set forth in Fed. R. Civ. P. 26(a)(1)(A)(i) and (ii) is a separate requirement. *Miscellaneous Changes to Trademark Trial and Appeal Board Rules*, 72 Fed. Reg. 42242, 42246 (August 1, 2007). See also TBMP § 401.02. While the Board is not overly-rigid in its application of Rule 2.120(a)(2), and encourages parties to treat the initial disclosure obligation as an issue to specifically discuss during the discovery conference, a party which elects to seek summary

judgment prior to the deadline for serving initial disclosures, but fails to substantiate that it timely and specifically served on its adversary the names of potential witnesses and basic information about documents and things it may use to support its claims or defenses, does so at its peril.

In summary, the record does not reflect that petitioner complied with Trademark Rule 2.127(e)(1) prior to or concurrent with the filing of its motion for summary judgment. In view of these findings, for failure to comply with said rule, petitioner's motion for summary judgment is premature, and is denied without prejudice on that basis.⁴

Suspension

It is the policy of the Board to suspend proceedings when a party or the parties are involved in a federal or state civil action, which may be dispositive of or may have a bearing on the Board proceeding. A decision in a civil action is often binding upon the Board, and suspension of a Board proceeding pending the final determination of another proceeding is solely within the discretion of the Board.⁵ See TBMP § 510.02(a).

⁴ To be considered at final hearing, any evidence submitted in connection with the summary judgment motion must be properly introduced in evidence during the appropriate trial period. See, e.g., *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1438 n.14 (TTAB 2007); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).

⁵ The Board may give consideration to a potentially dispositive motion before taking up the issue of suspension. See TBMP § 510.02(a).

The prevailing authority, Trademark Rule 2.117(a), reads:

Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.

See also TBMP § 510.02(a); *Marie Claire Album S.A. v. Kruger GmbH & Co. KG*, 29 USPQ2d 1792, 1793 (TTAB 1993); *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933, 1937 (TTAB 1992).

Based on an exhibit filed with the petition to cancel, it appears that a civil action between the parties is pending. In particular, petitioner attached to its pleading a copy of the Complaint for Compensatory and Punitive Damages ("Complaint") filed on April 20, 2010, in a matter filed and pending before the District Court of Clark County, Nevada, captioned *James Sanders and Jeffrey Olian v. U.S.A. Dawgs, Inc. and Barrie Mann*, Case No. A-10-614785-B. Further pleadings filed in the civil action are not of record at this time.

Upon review of said complaint, respondent, as plaintiff in the civil action, is seeking judgment and damages against petitioner (defendant in the civil action) with respect to claims of, inter alia, breach of contract, misappropriation, unfair competition, unjust enrichment and conversion. Certain of said claims involve allegations surrounding

ownership, use, incorporation, adaptation and/or imitation of, for example, "aspects of the GDOGGS design" (Complaint, p. 10), "valuable trade secrets in the form of the GDOGGS shoe design" (Complaint, p. 11), and "various design concepts of the GDOGGS shoe design" (Complaint, p. 12). Thus, the determination in the civil action may have a bearing on or be dispositive of the issues that have been brought before the Board in this cancellation proceeding.

Based on this finding, suspension is appropriate pursuant to Trademark Rule 2.117(a).

Accordingly, proceedings in this cancellation are suspended pending final disposition of the civil action between the parties.

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.⁶

During the suspension period, the parties shall notify the Board of any address changes for the parties or their attorneys.

⁶ A proceeding is considered to have been finally determined when a decision on the merits of the case (i.e., a dispositive ruling that ends litigation on the merits) has been rendered, and no appeal has been filed therefrom, or all appeals filed have been decided. See TBMP § 510.02.