

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

WINTER

Mailed: July 26, 2014

Cancellation No. 92056168

Legend Pictures LLC

v.

Quentin Davis

**Before Taylor, Ritchie, and Lykos,
Administrative Trademark Judges.**

By the Board:

This case now comes up for consideration of Petitioner's fully briefed¹ motions for discovery sanctions (filed April 22, 2014) and for a unilateral extension of the discovery period (filed March 10, 2014).

For purposes of this order, we presume the parties' familiarity with the arguments and materials submitted in connection with the motions. Insofar as our ruling on the motion for sanctions will affect whether it is necessary to consider Petitioner's motion for an extension of the discovery period, we shall

¹ Respondent's second brief filed on June 2, 2014, in response to Petitioner's reply brief in support of its motion for sanctions and Respondent's second brief filed on April 18, 2014, in connection with Petitioner's motion for an extension of the discovery period will not be considered because these submissions constitute impermissible sur-replies. *See* Trademark Rule 2.127(a) (after the response and reply brief, "[t]he Board will consider no further papers in support of or in opposition to a motion.").

first consider Petitioner's motion for sanctions. However, before doing so, it is appropriate to review the procedural history of this matter which precipitated the filing of Petitioner's motion for sanctions.

Motion for Sanctions

- *Background*

Petitioner served Respondent with interrogatories and document requests on March 14, 2013. On September 4, 2013, the Board, *inter alia*, granted Petitioner's motion to compel Respondent's responses to the foregoing discovery, ordering Respondent to within thirty days respond to (i) Petitioner's first and second interrogatory requests (numbers 1-21) (order at 4), (ii) Petitioner's document requests (numbers 2-5, 6(a), 7, 12-29, 31-39) without objection (order at 5), and (iii) Petitioner's document requests (numbers 1, 6(b), 8-11, 30) (*Id.*). The Board also ordered Respondent to provide a privilege log to Petitioner (order at 6). Rather than responding to the Board's order, Respondent filed a petition to the Director, arguing, *inter alia*, that the Board's September 4, 2013 order was improper and was the product of "subjective favoritism" for Petitioner in view of the prior employment of Petitioner's counsel with the USPTO. The Director denied Respondent's petition on December 31, 2013, finding, *inter alia*, "no merit" in Respondent's allegation of favoritism (order at 3). Thereafter, in its order resuming the proceedings mailed January 7, 2014, the Board allowed Respondent fifteen days, that is, until January 22, 2014, to respond to the

Board's order mailed on September 4, 2013, failing which Respondent may be subject to sanctions under Trademark Rule 2.120(g). Respondent served responses to Petitioner's interrogatories on January 23, 2014, one day after the due date, and served responses to Petitioner's document requests on February 19, 2014. It is noted that while Respondent responded to some of the interrogatories and document requests, contrary to the Board's September 4, 2013 order, he asserted many objections to Petitioner's discovery requests.

- *Legal Standard*

If a party fails to comply with an order of the Board relating to discovery, the Board may order appropriate sanctions as defined in Trademark Rule 2.120(g)(1) and Fed. R. Civ. P. 37(b)(1) and (2), including entry of judgment. *See MHW Ltd. v. Simex, Aussenhandelsgesellschaft Savelsberg KG*, 59 USPQ2d 1477 (TTAB 2000). The sanctions which may be entered by the Board pursuant to Rule 2.120(g)(1) include 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. *See Highbeam Marketing, LLC v. Highbeam Research, LLC*, 85 USPQ2d 1902, 1904 (TTAB 2008). *See also* TBMP Section 527.01(a) (2014).

- *Decision*

Petitioner requests that the Board enter default judgment against Respondent in view of his failure to timely respond to the Board's two discovery orders and other assertedly dilatory tactics. Based on the record before us, we agree with Petitioner that discovery sanctions in this case are warranted, but not to the extreme of entry of judgment. For instance, although Respondent has inappropriately withheld responses based on assertions of various privileges, such conduct appears to be the result of Respondent's misunderstanding of the function of the Board's standardized protective agreement, which is applicable to this proceeding and provides guidelines for parties to protect confidential information and materials.² Nonetheless, "*pro se* or not, Respondent ... bears responsibility for following the rules and Board requirements, including the schedule set by the Board." *Patagonia, Inc. v. Azzolini*, 109 USPQ2d 1859, 1862 (TTAB 2014) (default judgment entered against *pro se* applicant after repeatedly failing to participate in discovery conference). Clearly, Respondent should have, but did not respond fully or timely to the Board's orders regarding discovery. In view thereof, Petitioner's motion for discovery sanctions is granted, but only to the extent enumerated below.

- (1) To the extent that Respondent has to date failed to respond to Petitioner's discovery requests, we impose the estoppel sanction.

² The Board's standard protective order may be viewed at the following URL: <http://www.uspto.gov/trademarks/process/appeal/guidelines/stndagmnt.jsp>.

Specifically, Respondent is advised that **he cannot submit at trial or rely on as evidence at trial, any information or documents that were the subject of Petitioner's discovery requests, but which were not served on Petitioner prior to the filing of Petitioner's motion for sanctions.** See Fed. R. Civ. P. 37(c)(1). See also *National Aeronautics and Space Administration v. Bully Hill Vineyards Inc.*, 3 USPQ2d 1671, 1672 n.3 (TTAB 1987) (opposer's exhibits identified in applicant's brief as within the scope of documents requested by applicant but not produced by opposer during discovery, excluded from consideration); and TBMP § 527.01(e) (2014).

- (2) Respondent is **prohibited** from filing any unconsented pre-trial motions or papers with the Board without first obtaining the prior written consent of the assigned Interlocutory Attorney.³ See *Int'l Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1604 n.23 (TTAB 2002) (Board prohibited opposer from filing any further motions to compel without prior Board permission).

Respondent is also reminded that parties have a continuous duty to supplement discovery responses “in a timely manner if the party learns that in some material respect the disclosure or response is incomplete or incorrect, and if the additional or corrective information has not otherwise been made known to the other parties during the discovery process or in writing.” Fed.

³ Elizabeth Winter may be contacted at the following telephone number: 571-272-9240.

R. Civ. P. 26(e)(1)(A). *See, e.g., Hunter Indus., Inc. v. The Toro Company*, 110 USPQ2d 1651 (TTAB 2014); *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc. dba Watermark Cruises*, 107 USPQ2d 1750 (TTAB 2013); and TBMP § 408.03 (2014). Therefore, **should Respondent find additional information or materials that are responsive to Petitioner's previously served discovery, Respondent should promptly supplement his responses.**

Motions to Extend the Discovery Period

On October 31, 2013, in combination with its motion requesting that the Board suspend this proceeding pending the Director's decision on Respondent's petition, Petitioner requested that once the Director denies Respondent's petition, the Board extend discovery for sixty days solely for Petitioner so that it may conduct follow-up discovery. Respondent did not file a response to Petitioner's combined motion.

Petitioner, by its fully briefed motion to extend discovery filed March 10, 2014, requests that the Board grant as conceded its previous motion to extend the discovery period solely for Petitioner. Petitioner also argues that there is no need to extend the discovery period for Respondent because Petitioner responded to Respondent's discovery in July, 2013, Respondent has not served any follow-up discovery, and Respondent assertedly will use any further extension of the discovery period to further delay the proceeding.

Respondent explains in response, *inter alia*, that he did not understand that he needed to respond to Petitioner's motion until after the decision was issued on his petition. Respondent also asks for additional time for discovery at the close of his response to Petitioner's motion for sanctions.

We have carefully reviewed the parties' arguments and decline to exercise our discretion to grant Petitioner's October 31, 2013 motion as conceded. *See* Trademark Rule 2.127(a). Further, based on our review of Petitioner's motions to extend and the materials submitted by both parties in connection with Petitioner's motion for sanctions, we do not find good cause for an extension of the discovery period for either party. Rather, we find that this proceeding should move forward, commencing with the due date for Petitioner's pre-trial disclosures. *See Carrini Inc. v. Carla Carini S.R.L.*, 57 USPQ2d 1067, 1071 (TTAB 2000) ("Board possesses the inherent authority to control the disposition of cases on its docket").

- *Legal Representation Is Strongly Encouraged*

No paper, document, or exhibit will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules. Furthermore, strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, is expected of all parties before the Board, whether or not they are represented by counsel. In view thereof, Respondent should note that while Patent and Trademark Rule 10.14

permits any person to represent him or herself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in an opposition or cancellation proceeding to secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney.

Proceeding Resumed; Trial Dates Reset

This proceeding is resumed. Trial dates are reset as shown in the following schedule:

Plaintiff's Pretrial Disclosures Due	9/9/2014
Plaintiff's 30-day Trial Period Ends	10/24/2014
Defendant's Pretrial Disclosures Due	11/8/2014
Defendant's 30-day Trial Period Ends	12/23/2014
Plaintiff's Rebuttal Disclosures Due	1/7/2015
Plaintiff's 15-day Rebuttal Period Ends	2/6/2015

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. *See* Trademark Rule 2.125, 37 C.F.R. § 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b), 37 C.F.R. §§ 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129, 37 C.F.R. § 2.129.

