

**THIS OPINION IS NOT
CITABLE
AS PRECEDENT OF
THE TTAB**

**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3514**

butler

Mail date: March 4, 2004

Opposition No. 91153180

Takara Co. Ltd.

v.

**Juan Collado and Picture
Entertainment Corporation**

**Before Hanak, Hairston and Drost, Administrative Trademark
Judges.**

By the Board:

Applicant seeks to register the mark MICRONAUTS for "printed materials, namely, posters, comic books, trading cards and booklets featuring stories in illustrated form."¹ As grounds for the opposition, opposer alleges that applicant's mark, when used on the identified goods, so resembles opposer's previously used and registered mark MICRONAUTS for "miniature dolls, doll clothing, playsets, and simulated accessories therefore," as to be likely to cause confusion, mistake or to deceive.²

¹ Application Serial No. 75024433, filed on November 24, 1995, claiming a *bona fide* intention to use the mark in commerce.

² U.S. Registration No. 2663465, registered on December 17, 2002, and claiming first use and first use in commerce since December 10, 2001. The underlying application, Serial No. 74372240, that matured into this registration was filed on March 26, 1993, claiming a *bona fide* intention to use the mark in commerce.

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In his answer, applicant admits he has assigned all the rights, title and interest, and accompanying goodwill, in the MICRONAUTS trademark to Picture Entertainment Corporation. Applicant otherwise denies the salient allegations of the notice of opposition.

As a preliminary matter, the Board hereby joins Picture Entertainment Corp. as a party defendant. The assignment from Mr. Collado to Picture Entertainment Corporation is recorded at Reel 2544, Frame 0417. See TBMP Section 512 (2nd ed. June 2003).

The Board, on September 11, 2003, considered opposer's motion to compel (filed May 12, 2003) on its merits, even though applicant had not filed a response thereto.³ The Board exercised its discretion to do so in view of applicant's overall substantial responses to opposer's discovery requests and because a limited number of requests were in dispute. In its order, the Board made the following determinations:

- 1) opposer's motion to compel was granted as to interrogatories nos. 10, 15 and 26;
- 2) opposer's motion to compel was denied as to interrogatory no. 2;
- 3) opposer's motion to compel was granted as to document request nos. 9, 10, 17, 19, 23, 24, 32, 33, 46, and 58. Applicant was further ordered to provide a privilege log with respect to those document requests for which documents were being withheld under a claim of privilege;
- 4) opposer's motion to compel was granted with a qualification as to document request nos. 14, 15, 16, 18, and 21. The Board acknowledged applicant's statement that he was not aware of any documents in response to these requests, but that he will produce

³ When a party fails to file a brief in response to a motion, the Board may treat the motion as conceded. See Trademark Rule 2.127(a).

any non-privileged documents. Applicant was ordered to produce the documents or state affirmatively in writing that no responsive documents exist with respect to these requests;

- 5) opposer's motion to compel was denied as to document request no. 34;
- 6) opposer's motion to compel was granted as to document request nos. 3 and 12 upon imposition of the Board's standardized protective order concerning the exchange of confidential information.

The Board, in its September 11, 2003 order, allowed applicant until October 14, 2003 to respond to some of the discovery requests. See Patent & Trademark Office Rule 1.7. Realizing that the time to respond to interrogatories nos. 10, 15 and 26 and document request nos. 3 and 12 was not set in the September 11th order, the Board issued a supplemental order on September 22, 2003 allowing applicant until October 22, 2003 to respond to these specified requests.

This case now comes up on opposer's combined motion, filed October 27, 2003, for discovery sanctions in the nature of judgment in its favor and for summary judgment. Applicant (Mr. Collado) has filed a response, and opposer replied thereto.

Opposer's motion for discovery sanctions

In support of its motion, opposer argues that applicant failed to comply with the Board's order of September 11, 2003 by failing to produce the documents and answer the interrogatories as ordered. Opposer contends that it did not receive any of the ordered responses. Opposer requests entry of judgment against

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applicant for his failure to comply with the Board order compelling discovery responses.

In his declaration accompanying his response to opposer's motion for discovery sanctions, Mr. Collado states (at paragraph no. 14) as follows:

With regard to discovery herein, the Answers to Interrogatories I served on Opposer and the documents I produced in response to Opposer's request constituted all of the information and documents that I have at this time. That was how I answered the discovery. There was no need for a motion to compel since my answers made it clear that I did not have any further information.

In reply, opposer argues that applicant had an opportunity to respond to the motion to compel previously; and that applicant did not comply with the Board's September 11, 2003 order by producing the documents or answering the interrogatories as ordered.

If a party fails to comply with an order of the Board compelling discovery, the Board may enter appropriate sanctions. See Trademark Rule 2.120(g)(1); and TBMP Section 527.01 (June 2003). However, default judgment is a harsh remedy, justified where no less drastic remedy would be effective and where there is a strong showing of willful evasion. See *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1854 (TTAB 2000).

The circumstances of this case do not warrant the harsh remedy sought by opposer. Applicant stated that he provided opposer will all responsive information and documents prior to

opposer's motion to compel. Applicant appears to have interpreted the Board's order compelling discovery responses to require further action by applicant only in the event he had not previously provided full and complete responses.⁴ Thus, there is no showing of willful evasion on the part of applicant.

Accordingly, opposer's motion for discovery sanctions in the nature of judgment against applicant is denied.

Nonetheless, applicant failed to comply with the Board's September 11, 2003 order by not, at least, informing opposer in writing that applicant has no further information and documents. Sanctions are warranted for applicant's non-compliance with the Board's order.

Accordingly, opposer's motion for discovery sanctions against applicant is granted in part, and the following sanction is imposed: applicant may not introduce into evidence matters for which information was found to be withheld.

Opposer's motion for summary judgment

Opposer seeks judgment in its favor as a matter of law, arguing that no genuine issues of material fact exist, and that likelihood of confusion exists.

In support of its motion for summary judgment, opposer argues that the Examining Attorney assigned to applicant's

⁴ The better practice would have been to inform opposer in writing that applicant had previously provided all known responsive information and documents.

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application Serial No. 75024433 "... specifically noted the possibility of likelihood of confusion [] between Applicant's intent-to-use application and Opposer's senior trademark application number 74/372,240 (issued as registration 2663465)." Opposer argues that applicant's application was suspended pending the outcome of opposer's prior application. According to opposer, its prior pending application was inadvertently abandoned on October 15, 2001, reinstated on November 14, 2001; and it was during this one-month period of abandonment of opposer's prior application that applicant's application was approved for publication (on November 7, 2001). It is opposer's position that applicant's application was only approved for publication because the Examining Attorney mistakenly believed opposer's prior application was abandoned.

In response, applicant contends that opposer has not submitted evidence in support of its motion other than what is of record in the application file; and that opposer has not submitted evidence that the approval of applicant's application for publication was under the "mistaken belief" that opposer's application was abandoned.⁵ Applicant argues that the Office properly approved his application for publication.

⁵ Applicant's arguments, that opposer obtained its registration fraudulently and that opposer did not have a bona fide intent to use the mark MICRONAUTS on the good identified now in Registration No. 2663465, attack the validity of opposer's pleaded registration. Such attacks cannot be considered by the Board outside of a timely counterclaim or separate petition to cancel the pleaded registration. See Trademark Rules 2.106(b)(2)(i) and 2.114(b)(2)(i); and TBMP Section 313.01 (June 2003). Inasmuch as applicant has not brought a

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In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issue of material fact and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56. A genuine dispute with respect to a material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any particular factual issues are genuinely in dispute must be resolved in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ 1542 (Fed. Cir. 1992).

Opposer relies almost exclusively on the record of applicant's application during the *ex parte* examination of the application for its position that no genuine issues of material fact exist and that there is a likelihood of confusion between opposer's mark and applicant's mark. However, it is well established that the Board is not bound by the actions and determinations of the Trademark Examining Attorney. See *McDonald's Corp. v. McClain*, 37 USPQ2d 1274 (TTAB 1995); and *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993).

counterclaim to cancel opposer's registration, the Board is not considering these arguments made by applicant.

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Thus, opposer has not established that it is entitled to summary judgment or the absence genuine issues of material fact exist with respect to the relatedness of the parties' respective goods and the channels of trade for the parties' respective goods.

Accordingly, opposer's motion for summary judgment is denied.

Proceedings are resumed, and dates are reset as follows:

THE PERIOD FOR DISCOVERY TO CLOSE:	June 1, 2004
30-day testimony period for party in position of plaintiff to close:	August 30, 2004
30-day testimony period for party in position of defendant to close:	October 29, 2004
15-day rebuttal testimony period to close:	December 13, 2004

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. Rule 2.125.

Briefs shall be filed in accordance with Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Rule 2.129.
