OS Book

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
www.uspto.gov

05-196

RA Brands, LLC

v.

Frederic Remington Trust 1861

Opposition Nos. 91152945, 91153093, 91153719, 91159969, 91159998, 91160041, and 91160064

On Petition to the Director
Filed: July 28, 2005

Decision

Frederic Remington Trust 1861 has petitioned the Director to reverse a decision of the Trademark Trial and Appeal Board in the above-identified consolidated opposition proceedings. The petition is denied.

Facts

Petitioner filed eight applications to register the mark FREDERIC REMINGTON for various goods and services. After the applications were published for opposition, opposer timely filed notices of opposition. By order dated July 6, 2004, the Board consolidated the proceedings under Opposition No. 91152945.

Opposer served petitioner with interrogatories and requests for documents on June 4, 2003, and petitioner has filed numerous objections to opposer's discovery requests. Opposer filed a motion to compel discovery on June 30, 2004. The proceedings have been suspended and resumed several times,[1] and the discovery and trial dates have been reset numerous times.

[1] Proceedings were suspended on January 22, 2004 to give petitioner time to obtain new counsel after the withdrawal of its attorney; on April 27, 2004 pending disposition of petitioner's motion to dismiss; on February 15, 2005 pending disposition of opposer's first motion for discovery sanctions; and on August 19, 2005 pending disposition of opposer's second motion for sanctions and petitioner's motion to stay.

In an order dated July 6, 2004, the interlocutory attorney at the Board, *inter alia,* denied a series of motions to dismiss filed by petitioner; reset the discovery and trial dates; and advised the parties that they had a duty to cooperate with one another in the discovery process. On November 8, 2004, the interlocutory attorney issued an order in which she denied petitioner's motion for judgment on the pleadings; reset the period for discovery; ordered petitioner to respond to all outstanding discovery requests, without objection, within 30 days of the mailing date of the order; and advised the parties that "[s]hould applicant not cooperate in discovery, opposer will be within their right to move for discovery sanctions in the form of dismissal" (Order, p. 6).

On January 7, 2005, opposer filed a motion for sanctions. On January 21, 2005, petitioner filed a response to that motion in which it requested that a three judge panel of the Board declare the November 8, 2004 order null and void; dismiss the opposition; deny opposer's motion for sanctions; and *de novo* decide applicant's dispositive motions.

On June 30, 2005, the Board issued a decision in which it stated that "[t]o the extent that these motions could have been dispositive, the better procedure was to have them decided by a three-judge panel" (Order, p. 2), and granted petitioner's request to reconsider the decisions.[2] The Board denied petitioner's motion to dismiss and motion for judgment on the pleadings; denied opposer's motion for sanctions; ratified the conclusions reached in the decisions dated July 6, 2004 and November 8, 2004; and granted petitioner 30 days in which to answer all outstanding discovery requests without objection.

With respect to discovery, the Board stated that a review of petitioner's discovery responses showed them to be clearly insufficient; that petitioner had been advised of its duty in discovery and warned that a refusal to cooperate in discovery was a sanctionable matter; and that the Board would exercise its discretion and allow petitioner one final opportunity to comply with the order for discovery. The Board warned petitioner that it would not tolerate any further attempts to delay this case or to frustrate opposer's right to discovery; that it was imperative that petitioner cooperate in the discovery process and refrain from filing any further potentially dispositive motions without prior leave of the Board; and that petitioner's failure to comply fully and completely with the Board's order would, upon motion by opposer, result in the entry of default judgment against petitioner.

This petition followed. Opposer filed a response to the petition on August 15, 2005, and petitioner filed a reply to opposer's response on August 31, 2005.

Request for Stay Pending Decision on Petition

In the petition, petitioner requests that the Director stay the opposition proceeding pending a decision on this petition. A motion to stay or suspend a Board proceeding pending a decision on petition should be addressed to the Board, not the Director. 37 C.F.R. §2.117(c); *Trademark Manual of Examining Procedure* ("TMEP") §1705.06; *Trademark Trial and Appeal Board Manual of Procedure* ("TBMP") §510.03(a). It is noted that petitioner filed such a motion with

[2] The Board noted that petitioner's request to review the orders dated July 6,2004 and November 8, 2004 was untimely under 37 C.F.R. §2.127(b), because it was not filed within one month of the date of the orders, but exercised its discretion to reconsider the orders despite the untimely filing of petitioner's request.

the Board on August 3, 2005, and that the Board denied the motion on October 7, 2005. The Board's decision dated October 7, 2005 is not the subject of this petition. For the reasons explained below, that decision may not be reviewed by the Director on petition.

Default Judgment Dated October 7, 2005 May Not Be Reviewed on Petition

Opposer filed another motion for sanctions in the form of default judgment on August 9, 2005, and petitioner filed an objection to the motion on August 31, 2005. In the decision dated October 7, 2005, the Board granted the motion, thereby entering judgment against petitioner and sustaining the opposition. Under 15 U.S.C. §1071 and 37 C.F.R. §2.145, petitioner has the right to appeal the Board's decision to the Court of Appeals for the Federal Circuit or commence a civil action within two months of the date of the Board's decision. See TBMP §§902 *et seq.* and 903 *et seq.* This decision may not be reviewed by petition to the Director, because it is a final decision that puts an end to the litigation before the Board, and as such is improper subject matter for petition.

Petitionable Subject Matter

A petition to the Director to review a decision of the Trademark Trial and Appeal Board is appropriate only where the Board's decision concerns matters of procedure, rather than the central issue(s) before the Board, and does not put an end to the litigation before the Board. *Chesebrough-Pond's Inc. v. Faberge, Inc.*, 618 F.2d 776, 205 USPQ 888 (C.C.P.A. 1980); *Miss Nude Florida, Inc. v. Drost*, 198 USPQ 485 (Comm'r Pats. 1977); *Scovill Manufacturing Co. v. Stocko Metallwarenfabriken Henkels und Sohn KG*, 191 USPQ 124 (Comm'r Pats. 1976); *Outdoor Sports Industries, Inc. v. Joseph & Feiss Co.*, 177 USPQ 533 (Comm'r Pats. 1973); TBMP §905; TMEP §1704.

In this case, petitioner's requests to review the Board's actions with respect to petitioner's motion to dismiss the opposition, motion for summary judgment, motion for judgment on the pleadings, and its arguments that there is no likelihood of confusion between the marks owned by petitioner and opposer must be denied as improper subject matter for petition. Whether the opposition should be dismissed, whether judgment on the pleadings should be granted, and whether there is a likelihood of confusion are all questions that are central to the case and put an end to the litigation before the Board, and these questions are clearly not appropriate subject matter for review by the Director. Petitioner may appeal these issues to federal court within two months of the Board's final decision dated October 7, 2005. 15 U.S.C. §1071; 37 C.F.R. §2.145. The Director can review only the procedural matters raised in the petition.

Standard of Review

The Director will reverse an action of the Board only upon a showing of clear error or abuse of discretion. *Jonergin Co. Inc. v. Jonergin Vermont Inc.*, 222 USPQ 337 (Comm'r Pats. 1983); *Riko Enterprises, Inc. v. Lindsley*, 198 USPQ 480 (Comm'r Pats. 1977); TMEP §1706; TBMP §906.02. After a careful review of the record in this case, the Director has determined that petitioner has not established that the Board clearly erred or abused its discretion in this proceeding.

Consideration of Dispositive Motions By Three Judge Panel

Petitioner asserts that its dispositive motions should have been decided by a three-judge panel rather than a single interlocutory attorney. However, as noted above, the Board has acknowledged that the better practice would have been to have the potentially dispositive motions decided by a three-judge panel, and these motions have now been considered and decided *de novo* by a three-judge panel. Upon issuance of the panel's decision, petitioner was given an additional 30 days to comply with opposer's requests for discovery. Therefore, this issue is moot.

Sanctions

Petitioner's assertion that the Board does not have the authority to impose sanctions for failure to comply with discovery is without support. Under 37 C.F.R. §2.120(g), if a party fails to comply with an order relating to discovery, the Board may make any appropriate order, including the entry of default judgment, as provided in Rule 37(b) of the Federal Rules of Civil Procedure. *MHW Ltd. v. Simex, Aussenhandelsgesellschaft Savelsberg KG*, 59 USPQ2d 1477 (TTAB 2000); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848 (TTAB 2000). See TBMP §§527.01 *et seq.*

After a careful review of opposer's discovery requests and petitioner's responses thereto, as well as petitioner's objections to opposer's discovery requests, the Director sees no clear error or abuse of discretion in the Board's order dated June 30, 2005, providing petitioner one final opportunity to comply with all outstanding requests for discovery in order to avoid a default judgment.

Petitioner suggests that the Board is without authority to impose discovery sanctions because "at all times relevant the proceedings were suspended..., due to outstanding dispositive motions...." (Applicant's Objection to Opposer's Motion for Default, filed Aug. 31, 2005, p. 2). First, it is noted that the filing of a potentially dispositive motion does not in and of itself operate to suspend a proceeding, and that all deadlines remain in effect unless and until the Board issues a suspension order. *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955 (TTAB 1986); *Consultants & Designers, Inc. v. Control Data Corp.*, 221 USPQ 635, 637 n. 8 (TTAB 1984); TBMP §§510.03(a) and 528.03. Moreover, this question is moot, because petitioner was given additional time to comply with opposer's discovery requests after the Board ruled on petitioner's dispositive motions.

Request to Review Earlier Actions of the Board Denied as Untimely

Petitioner asserts that the interlocutory attorney should have suspended the proceedings pending disposition of petitioner's dispositive motions, and that the interlocutory attorney's orders are "all void and a nullity" (Petition, p. 4). Petitioner asks that the Director "grant the Petition, reversing the both [sic] Panel and Skoro decisions, orders, and failures...." (Applicant's Reply to Opposer's Response to Applicant's Petition, p. 5).

Proceedings were suspended on April 27, 2004 pending disposition of petitioner's motion to dismiss, and resumed on May 27, 2004. Petitioner filed a motion for further suspension on August 2, 2004, which the interlocutory attorney denied in an order dated September 13, 2004. The request to review

the order dated September 13, 2004, or any other actions taken by the Board prior to June 28, 2005, is denied as untimely. Under 37 C.F.R. §2.146(e)(2), a petition to review an order or decision of the Board must be filed within thirty days of the mailing date of the decision from which relief is requested, and this petition was not filed until July 28, 2005.

Decision

The petition is denied.

Sharon R. Marsh
Acting Deputy Commissioner
for Trademark Examination Policy

SRM:MEH

Date: NOV 29 2005

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