UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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GMM

Mailed: July 20, 2016

Opposition No. 91203258

Gary W. Stuckle

v.

Gregory Merkel

Before Mermelstein, Bergsman, and Heasley,
Administrative Trademark Judges.

By the Board:

This case is before the Board for consideration of Gregory Merkel's motion for sanctions in the form of judgment against Gary Stuckle.[1] The motion has been fully briefed.[2]

For purposes of this order, we presume the parties' familiarity with the pleadings and documents in this proceeding, as well as the parties' arguments and materials submitted in connection with the motion.

[1] Initially Stuckle was in the position of opposer and counterclaim respondent and Merkel was in the position of applicant and counterclaim petitioner. However, Stuckle ultimately withdrew his opposition without Merkel's consent, resulting in dismissal of the opposition with prejudice. Thus, only Merkel's petition for cancellation of Stuckle's pleaded registration remains pending.

[2] As discussed *infra*, Stuckle's brief in opposition to Merkel's motion for sanctions was untimely. However, given the severity of the sanction being sought by Merkel – *i.e.*, entry of judgment – we have exercised our discretion to consider Stuckle's untimely brief.

Introduction

Merkel filed applications to register the marks FLYING MERKEL (Serial No. 85258016, in standard character form, filed on March 4, 2011); and THE FLYING MERKEL and Design (Serial No. 85277394, filed on March 25, 2011), as shown below.

Both applications were filed based on Merkel's allegation of his bona fide intent to use the marks in commerce for the goods listed below:

> Watches; wrist watches; watch straps; stopwatches; watch movements; watchbands; watch glasses; chronometers; chronographs for use as watches; clocks; electronic clocks; mechanical clocks; quartz clocks; alarm clocks; clock cases; watch cases; clocks incorporating radios; cufflinks; tie clips; pins being jewelry; charms being personal jewelry; precious stones, jewels being jewelry; key-rings of precious metal; pendants of precious metal; earrings; bracelets; necklaces; pocket watches; wall clocks; table clocks; electric timepieces; electronic timepieces; atomic timepieces, measuring watches in the nature of timepieces, ornamental pins, tie pins, digital alarm clocks, in International Class 14;
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> Diaries; notebooks and exercise book; pens; fountain pens; rolling pens; pencils; felt pens; writing pens; pen-holders not of precious metal; adhesive labels; stickers and decal transfers; flags made from paper; calendars; paper atlases, brochures about travels, lifestyle, and entertainment; booklets about travel, lifestyle, entertainment; document folders for cards and documents; albums for stamps, stickers, coins, and photographs; magazines about travel, lifestyle, entertainment; lithographs; photographs; newspapers; printed periodicals in the field of travel, lifestyle, and entertainment; books in the field of travel,

> lifestyle, and entertainment; photographic prints, posters, postcards; erasers; cardboard boxes; agendas; note papers; photo albums; greeting cards; note pads; passes made of paper being printed tickets; envelopes; business cards, in International Class 16;
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> Trunks; suit cases; carry-on trolley bags; book bags not of paper for carrying catalogs; leather shopping bags for carrying catalogs; duffle bags; carry on bags; hanging garment bags for airline travel; leather shopping bags; textile shopping bags; traveling bags; leather key cases; umbrellas; attaché cases; briefcases; leather suit bags; wallets; purses; business card cases; credit card cases; toiletry cases and vanity cases sold empty; rucksacks; rucksacks for school; school bags; belt bags; saddlery, in International Class 18;
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> T-shirts; sweat shirts; polo shirts; ties; caps; overalls; wind resistant jackets; waterproof jackets; blazers; Bermuda shorts; pullovers; fleece pullovers; fleece jackets; fleece shorts; fleece vests; coats; robes; scarves; shoes; boots; ski boots; sweaters; shirts; trousers; belts; raincoats; track suits; shorts; gloves; pajamas; slippers; swimming costumes, in International Class 25.

On January 5, 2012, Stuckle filed a notice of opposition against Merkel's applications, asserting claims of false suggestion of a connection under 15 U.S.C. § 1052(a) and likelihood of confusion under 15 U.S.C. § 1052(d) based on his ownership of Registration No. 3782299[3] for the mark FLYING MERKEL (in standard character form) for "motorcycles" in International Class 12 and his prior use of the mark FLYING MERKEL for motorcycles and clothing.

On February 13, 2012, Merkel filed an answer denying the salient allegations in the notice of opposition and a counterclaim petitioning for cancellation of Stuckle's

[3] Issued on April 27, 2010; Section 8 declaration of continued use accepted on August 26, 2015.

pleaded Registration No. 3782299 on the grounds that the registration was procured fraudulently and that under 15 U.S.C. § 1052(a) the mark consists of deceptive matter that misdescribes the origin of the goods and falsely suggests a connection with Merkel, his family, and his great-uncle, who founded Merkel Motor Company in 1902 to produce motorcycles. *See* 5 TTABVUE 4–9.

On June 24, 2015, Stuckle withdrew his opposition without Merkel's consent (*see* 31 and 34 TTABVUE), resulting in dismissal of the opposition with prejudice. *See* 35 TTABVUE. Merkel subsequently elected to proceed with his counterclaim petition for cancellation of Stuckle's registration. *See* 36 TTABVUE. Accordingly, only Merkel's petition for cancellation remains pending. *See* 37 TTABVUE.

Procedural History

On August 27, 2012, after pleadings closed, Stuckle's initial attorney, William Jeckel, filed a request for leave to withdraw, in which Mr. Jeckel indicated that Stuckle had discharged him. *See* 9 TTABVUE 2. In an order dated September 27, 2012, the Board granted Mr. Jeckel's motion to withdraw as counsel, suspended proceedings, and allowed Stuckle time to appoint new counsel or indicate that he would represent himself. *See* 10 TTABVUE. On October 9, 2012, Stuart West of West & Associates entered his appearance as Stuckle's attorney. *See* 11 TTABVUE. The Board then resumed proceedings in an order dated October 30, 2012. *See* 12 TTABVUE.

Between December 14, 2012, and November 11, 2014, the parties requested and were granted seven suspensions in order to allow them time to engage in settlement

discussions. *See* 13 TTABVUE – 27 TTABVUE. The last two suspension requests also cited Stuckle's health problems as a basis for the suspension requests. 23 TTABVUE 2–3 and 26 TTABVUE 2–3. In an order dated November 14, 2014, the Board granted the last of the parties' consented motions to suspend, and further advised the parties:

> While the Board is sympathetic to the medical issues confronted by [Stuckle], the Board notes that, including the suspension granted herein, these proceedings will have been suspended for settlement for over 2 ½ years, yet settlement has still not been reached. The Board finds that it has now provided the parties ample time to settle this matter. **Accordingly, the Board will not entertain any further requests to extend or suspend for settlement, whether consented to or not.**
>
> The parties will need to make a business decision within the next six months whether they wish to settle this matter and, if not, be prepared to either proceed to prosecute this case or, alternatively, dismiss the opposition and/or corresponding counterclaim.

27 TTABVUE 3 (emphasis in original).

On April 8, 2015, the day after proceedings resumed, Stuckle, citing "an impromptu and prolonged hospital visit," filed an unconsented motion for a ninety-day suspension. *See* 28 TTABVUE 2. Although the Board's records indicated that Stuckle was represented by counsel at the time, Stuckle filed the suspension request himself.[4] *Id*. The motion to suspend failed to include proof of service on Merkel's counsel. *Id*. The Board, in an order dated April 10, 2015, noted Stuckle's failure to indicate proof of service, but elected to expedite consideration of Stuckle's motion by forwarding a copy of it to Merkel's counsel and allowing Merkel until May 10, 2015,

[4] Stuckle did not file a revocation of power attorney until July 6, 2015. *See* 33 TTTABVUE.

in which to file a brief in response to the motion. *See* 29 TTABVUE 1. However, the Board also advised Stuckle that "[s]trict compliance with [the service requirements of] Trademark Rule 2.119 is required in all future filings." *Id*. On May 1, 2015, during Merkel's time for filing a brief in response to Stuckle's unconsented motion to suspend, Stuckle re-filed the motion, again without including proof of service. *See* 30 TTABVUE 2. Stuckle again filed the motion on his own, even though he was represented by counsel. *Id*.

On May 8, 2015, Merkel served his initial disclosures, first set of interrogatories, first set of document requests, and first set of requests for admission upon Stuckle.[5] *See* Merkel's Motion for Sanctions, 45 TTABVUE 4. Stuckle did not serve his initial disclosures or any discovery requests. *Id*. Stuckle's written responses and objections to Merkel's discovery requests were due by June 12, 2015. *Id*. at 5. When Stuckle failed to serve his responses or objections to Merkel's discovery requests, Merkel's counsel emailed Stuckle's counsel[6] on June 16, 2015, June 23, 2015, and June 30, 2015, to inquire about the status of both Stuckle's initial disclosures and his responses to Merkel's discovery requests. *Id*. at 5. *See also*, Ex. B to Merkel's July 6, 2015, motion to compel (32 TTABVUE 51–55). In response, Stuckle's counsel advised Merkel's counsel that he had been "instructed to take no action," that he would forward the correspondence to Stuckle, and that he "likely … [would] be filing a

[5] Merkel previously submitted copies of the discovery requests with his motion to compel, filed on July 6, 2015. *See* 32 TTABVUE 15–49

[6] Stuckle currently is proceeding *pro se*. *See* 33 TTABVUE.

motion to withdraw" as counsel. *See* 32 TTABVUE 51–55. In the interim, on June 24, 2014, Stuckle himself filed a withdrawal of the opposition without Merkel's consent. *See* 31 TTABVUE. After Stuckle filed the withdrawal of the opposition, on July 6, 2015, Merkel filed a motion to compel Stuckle's initial disclosures and discovery responses. *See* 32 TTABVUE. On the same day, Stuckle filed a revocation of power of attorney and again filed the withdrawal of the opposition without Merkel's consent. *See* 33 TTABVUE and 34 TTABVUE.

In an order dated July 16, 2015, the Board dismissed Stuckle's opposition with prejudice pursuant to Trademark rule 2.106(c) and allowed Merkel time to inform the Board whether he wished to proceed with his counterclaim for cancellation of Stuckle's Registration No. 3782299. *See* 35 TTABVUE. The Board further informed the parties that if Merkel elected to proceed with his counterclaim, then the Board would consider Merkel's motion to compel. *Id*. Merkel subsequently informed the Board that he wished to proceed with his counterclaim for cancellation, and the Board allowed Stuckle until August 17, 2015, to respond to Merkel's motion to compel. *See* 36 and 37 TTABVUE. Stuckle did not file a response to the motion to compel until September 4, 2015, and his belated response consisted merely of copies of his overdue discovery responses and document production (consisting of six pages). *See* 38 TTABVUE. Stuckle did not file a brief in opposition to Merkel's motion to compel, and his submission was not accompanied by proof of service on Merkel.[7] *Id*. Stuckle's

[7] Eleven days later Stuckle filed a putative certificate of service stating that '[i]t is hereby certified that a copy of the preceding documents in response to Board Order to Applicant/Petitioner's documents request was sent via email Sept. 3, 2015." *See* 39

interrogatory responses were not signed and verified under oath as required by Fed. R. Civ. P. 33(b)(3) and (5). The six documents produced by Stuckle consisted of one handwritten note signed by Stuckle purporting to reflect the sale of a motorcycle bearing the mark FLYING MERKEL, and five "certificates of origin," in identical declaration form and signed by Stuckle, also purporting to reflect sales of motorcycles under the mark. *See* 38 TTABVUE 14–19.

In an order dated November 25, 2015, the Board granted Merkel's motion to compel. *See* 40 TTABVUE. In doing so, the Board determined that Stuckle's responses to Merkel's discovery requests were both late and "wholly inappropriate." *Id*. at 2. In addition to the tardiness of Stuckle's discovery responses, the Board determined that the interrogatory responses were not signed and verified; many of Stuckle's responses to Merkel's document requests contained inappropriate objections, including unsupported assertions of "work product protection"; and Stuckle still had failed to provide his initial disclosures. *Id*. The Board further noted that it was not proper for Stuckle to file his discovery responses with the Board because the issue raised in Merkel's motion to compel was not the sufficiency of Stuckle's discovery responses, but rather his failure to provide any responses. *Id*. at 2–3. Finally, the Board noted that the deficiencies cited in the order were not exhaustive of the deficiencies contained in the responses, but merely illustrative of the general inadequacy of Stuckle's discovery responses. *Id*. at n. 2. The Board therefore granted Merkel's

TTABVUE 2. *See* TBMP § 113.03 (a certificate of service "should . . . specify the name of each party or person upon whom service was made, and the address").

motion to compel and ordered Stuckle to, by December 25, 2015, serve supplemental verified responses to Merkel's first set of interrogatories, supplemental responses to Merkel's document requests, and supplemental responses to Merkel's requests for admission.[8] *Id*. at 3, 5–8. The Board also provided Stuckle with a comprehensive explanation of the guidelines and requirements for proper discovery responses. *Id*. Stuckle was further ordered to, at his own expense, copy and send all responsive documents to Merkel. *Id*. The parties were further advised that if Stuckle failed to comply with the Board's order, then Merkel's remedy would lie in a motion for sanctions, pursuant to Trademark Rule 2.120(g)(1). *Id*. at 4, n. 5. However, the Board required that Merkel must first obtain leave of the Board before filing a motion for sanctions. *Id*. Finally, the Board noted that Stuckle now was proceeding *pro se* and thus provided Stuckle with information concerning, *inter alia*, the location of the Board's electronic resources, including the Trademark Trial and Appeal Board Manual of Procedure ("TBMP"). *See* 40 TTABVUE 9. Additionally, Stuckle was advised that "[c]ompliance 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," and he was again reminded of the requirements for service of papers pursuant to Trademark Rule 2.119. *Id*.

[8] Stuckle further was directed that his supplemental discovery responses must be made "without objections on the merits." 40 TTABVUE 3.

Following the Board's November 25, 2015, order, on December 28, 2015, Stuckle again filed his discovery responses with the Board.[9] *See* 41 TTABVUE. Stuckle's responses consisted solely of copies of five invoices. *Id.* at 2–7. Stuckle did not provide supplemental verified responses to Merkel's first set of interrogatories, document requests, and requests for admission, as required by the Board in its November 25, 2015 order. Stuckle's submission also contained a defective certificate of service that failed to identify the documents being served or the date on which they were served. *Id. at* 7.

On December 31, 2015, Merkel filed a request for conference before the Board for purposes of addressing Stuckle's ongoing discovery deficiencies and to request leave to file a motion for sanctions. *See* 42 TTABVUE. A conference subsequently was conducted before the Board on February 5, 2016, and following the conference the Board issued an order dated February 10, 2016, in which Stuckle was allowed thirty days in which to provide documents and supplemental written answers responsive to Petitioner's first set of interrogatories and first request for production of documents. *See* 44 TTABVUE 2. In the post-conference order, the Board again provided Stuckle with comprehensive guidelines for proper discovery answers; reminded Stuckle that the requirements set forth in the Board's November 11, 2015, order remained operative; that he was required to sign and verify his interrogatory responses; and

[9] Contrary to Merkel's assertion, Stuckle's December 28, 2015, response was not late. The deadline of Friday, December 25, 2015 was a federal holiday, and Monday, December 28, 2015, was the next business day following the holiday. *See* 35 U.S.C. § 21(b); Trademark Rule 2.196.

that both his written responses and his production of documents must be made without objection, except for objections based on a claim that the information sought by a discovery request is subject to attorney-client or a like privilege, or comprises attorney work product.[10] *Id. at* 2–5. Further, Stuckle was advised that because the Board's standardized protective order was automatically in place, he could designate responsive information or documents as confidential pursuant to the protective order, but could not use such a designation as a basis for refusing to provide them. *Id*. at 3. The Board also provided Stuckle with suitable verification language for his interrogatory answers. *Id*. at 3. Additionally, Stuckle was again directed to conduct a search of his records to locate responsive documents, and was further directed that in his supplemental written responses to Merkel's document requests, Stuckle must affirmatively state whether or not responsive documents exist. *Id*. Finally, the Board again provided Stuckle with information concerning Board resources and again cautioned him that "[s]trict compliance with the Trademark Rules of Practice, and the Federal Rules of Civil Procedure (where applicable), is required of all parties before the Board, whether or not they are represented by counsel." *See* 44 TTABVUE 5–7. The Board also advised Merkel that if he believed Stuckle had failed to comply with the Board's November 25, 2015, and February 10, 2016, orders, and thus believed a motion for sanctions still was warranted, then Merkel could file such motion without further leave of the Board. *Id*. at 5.

[10] Stuckle further was provided with guidelines for producing a privilege log pursuant to Fed. R. Civ. P. 26(b)(5)(A)(i)–(ii), in the event that he withheld responsive documents based on a claim of privilege. *See* 44 TTABVUE 4.

On March 10, 2016, Stuckle provided Merkel with additional supplemental responses. Stuckle again failed to verify his interrogatory answers, instead merely signing the top corner of each page of the answers, and Stuckle again failed to provide proof of service.[11] 45 TTABVUE 8, 18–26. Moreover, a review of Merkel's supplemental responses indicates that they remain evasive. For example, Stuckle continues to object to certain document requests (*e.g.*, Nos. 24, 31–32) on the ground of "work product protection," without factual basis for the objections.[12] *See* 45 TTABVUE 25.

On March 17, 2016, Merkel filed a motion for sanctions. In large part the motion recites the history of Stuckle's discovery conduct as set forth above.

Stuckle's response to Merkel's motion for sanctions was due by April 1, 2016. Trademark Rule 2.127(a).[13] Stuckle did not file a response until April 18, 2016. *See* 46 TTABVUE. Then, on April 20, 2016, Stuckle filed another paper explaining that his late response was "a mistake," that he was recovering from surgery, and that his "caregiver called PTO for [*sic*] time frame on response, they said 30 days, when indeed

[11] As noted *supra*, at note 5, Stuckle has repeatedly failed to indicate proof of service with his submissions to the Board or to Merkel, and has been reminded on multiple occasions of the service requirements under Trademark Rule 2.119. *See* 29 TTABVUE; 40 TTABVUE 9; and 44 TTABVUE 6.

[12] Even in the unlikely event that the work product privilege applied, there is no indication that Stuckle provided a privilege log, as directed. Moreover, to the extent Stuckle's references to "work product privilege" may have been intended to invoke an objection on the basis of trade secrets, he previously was instructed that while he may designate responsive information or documents as confidential pursuant to the Board's standardized protective order, he may not use such designation as a basis for refusing to produce them.

[13] Because the parties agreed to service of papers by electronic mail, the additional five days for responding provided by Trademark Rule 2.119(c) was not applicable.

it was 20 on this particular one." *See* 47 TTABVUE 1. This explanation is unsatisfactory for two reasons. First, it is based on an unverified communication between an unnamed caregiver and an unnamed PTO employee. Second, the business of the Board is to be conducted exclusively on the written record and "[n]o attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt." Trademark Rule 2.191, TBMP § 104. Nevertheless, given the severity of the sanction being sought by Merkel – *i.e.*, entry of judgment – we have exercised our discretion and considered Stuckle's untimely brief. However, we note the tardiness of Stuckle's brief as further illustration of his repeated and ongoing disregard of Board rules, orders, and deadlines.

In his response to Merkel's motion for sanctions, Stuckle largely argues the merits of Merkel's claims. To the extent Stuckle addresses his conduct which forms the basis of Merkel's motion, Stuckle essentially contends that "he has answered and provided all documents to the best of his ability" and "[his] answers or documents cannot be augmented or changed to suit [Merkel]." *See* 46 TTABVUE 4.

Stuckle further attributes his initial delay in responding to Merkel's discovery requests to the fact that he first learned of them through the TTABVUE website after he terminated his prior counsel. *Id*. Stuckle goes on to contend that Merkel had Stuckle's contact information, but declined to mail the discovery requests to Stuckle. *Id*. This argument ignores the fact that Merkel's counsel was not required to re-serve his discovery requests directly upon Stuckle; in fact, it would have been improper for Merkel's counsel to have done so while Stuckle was represented by counsel. Whatever

relationship existed between Stuckle and his attorney, Stuckle did not file a revocation of his power of attorney and indicate that he would represent himself until July 6, 2015, the same day Merkel filed his motion to compel and almost one month after Stuckle's discovery responses were due.

Moreover, Stuckle's transgressions go beyond simply failing to timely respond to Merkel's discovery requests in the first instance. Stuckle's transgressions include:

- repeatedly failing to comply with the Board's schedule and deadlines;
- repeatedly asserting improper objections to Merkel's discovery requests; and
- ignoring two Board orders requiring verified interrogatory answers and proper written responses to document requests.[14]

Analysis

If a party fails to comply with an order of the Board relating to discovery, including an order compelling discovery, the Board may order appropriate sanctions as defined in Trademark Rule 2.120(g)(1) and Fed. R. Civ. P. 37(b)(2), including entry of judgment against the disobedient party. *See, e.g., 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); *Unicut Corp. v. Unicut, Inc.*, 222 USPQ 341 (TTAB 1984); *Caterpillar Tractor Co. v. Catfish Anglers Together, Inc.*, 194 USPQ 99 (TTAB 1976); and TBMP § 527.01

[14] As noted above, in addition to failing to comply with the Board's orders regarding his discovery responses, Stuckle also has repeatedly failed to indicate proof of service when filing papers with the Board or serving papers upon Merkel, and has repeatedly filed his discovery responses and supplemental responses with the Board.

(2016). Judgment is a harsh remedy, but it is justified where no less drastic remedy would be effective and there is a strong showing of willful evasion. *See. e.g.*, *Unicut,* 222 USPQ at 344; *MHW Ltd.*, 59 USPQ2d at 1478.

That is the case here. Stuckle brought this action over 4 ½ years ago, on January 5, 2012, and should have been prepared to pursue it. Since Stuckle terminated his prior counsel and advised the Board that he would represent himself, he has been repeatedly warned that compliance with the Trademark Rules of Practice, and the Federal Rules of Civil Procedure, is required of all parties before the Board, whether or not they are represented by counsel. The Board has patiently informed Stuckle of his obligations many times, even going so far as to direct Stuckle to Board resources, and to provide detailed guidelines for proper discovery responses, certificates of service, and verification of answers to interrogatories. Moreover, the Board previously warned Stuckle twice – in the November 25, 2015, order granting Merkel's motion to compel and in the February 10, 2016, order following the conference preceding Merkel's motion for sanctions – that if he failed to comply with the Board's orders then Merkel's remedy would lie in a motion for sanctions under Trademark Rule 2.120(g)(1). *See* 40 TTABVUE 4 n. 5 and 44 TTABVUE 5. Despite such warnings, and despite the Board's order granting Merkel's motion to compel and the Board's subsequent order preceding Merkel's motion for sanctions, Stuckle still has not verified his interrogatory answers or provided proper supplemental written responses to Merkel's document requests. Further, Stuckle has continued to ignore Board deadlines and the service requirements of Trademark Rule 2.119.

Stuckle's contentions that his attempts at compliance have been diligent are unconvincing, and undermined by the history of his conduct to date. After careful consideration of Stuckle's arguments and explanations, and given the continuing nature of Stuckle's violations despite multiple prior admonitions from the Board, we conclude that any sanction short of judgment would be futile and unfair to Merkel, who, despite diligent efforts, has been unable to move the case forward due to Stuckle's intransigence. *See, e.g.*, *MHW Ltd.*, 59 USPQ2d at 1478–79 (review of the record revealed that opposer had been engaged in dilatory tactics, including the willful disregard of the Board's orders, resulting in an entry of judgment as a sanction); *Baron Philippe de Rothschild S.A.*, 55 USPQ2d at 1854 (judgment entered against applicant for engaging in a pattern of dilatory tactics and having willfully failed to comply with Board discovery order).

Therefore, the sanction of judgment is hereby entered against Stuckle, the petition to cancel is **GRANTED**, and Registration No. 3782299 will be cancelled in due course. *See* Fed. R. Civ. P. 37(b)(2)(A)(vi) and Trademark Rule 2.120(g)(1).