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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91212268
Party	Plaintiff Diesel S.p.A.
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Submission	Motion for Sanctions
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Signature	/Robert S. Pierce/
Date	09/16/2014
Attachments	I06745 motion for sanctions and suspension.pdf(412398 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

DIESEL S.P.A.,

Opposer,

v.

FRONTIER FASHION, INC.,

Applicant

Opposition No. 91212268

**OPPOSER’S MOTION FOR SANCTIONS AND TO SUSPEND**

The Opposer, Diesel S.p.A. [hereinafter “Diesel” or “Opposer”], through its undersigned counsel, respectfully moves for an Order from the Trademark Trial and Appeal Board (the “Board”) sanctioning Applicant Frontier Fashion, Inc. [hereinafter “Frontier” or “Applicant”] for non-compliance with the Board’s July 28, 2014, Order by entering a default judgment against Applicant and suspending the opposition while its Motion is pending.

**I. Introduction and Background**

According to the Board’s scheduling order, mailed September 3, 2013, discovery opened November 12, 2013. The parties were required to exchange initial disclosures on December 12, 2013. Diesel timely served its initial disclosures on December 12, 2013, sending them by first class mail to Mr. Victor Wu at Law Offices of Victor Wu, Post Office Box 3188, Riverside, California 91761. Diesel also advised that it was looking forward to receiving Frontier’s Initial Disclosures.

Frontier did not make its Initial Disclosures despite Diesel’s attempts to procure them. Diesel then filed a Motion to Compel them on April 11, 2014. The Board granted the Motion as conceded on July 28, 2014, ordering Frontier to make its Initial Disclosures within 30 days of the

Order's mailing date. Thus, Frontier's Initial Disclosures were due on or before August 27, 2014.

On July 29, 2014, Diesel sent a letter by first class mail to Frontier's counsel, Mr. Victor Wu, advising him of the Order and the upcoming deadline for making the Initial Disclosures. Diesel also advised Mr. Wu of its intention to seek any available sanction including default judgment if the Disclosures were not made. Frontier did not make its Disclosures, so on August 28, 2014, Diesel sent another letter by first class mail to Mr. Wu advising him that Frontier's Disclosures were past due. It also advised him that Diesel intended to seek sanctions including default judgment if Mr. Wu did not reply to the letter by September 12, 2014. Diesel sent a second reminder to Mr. Wu by first class mail and email on September 5, 2014. Frontier has not replied to the letters or made its Initial Disclosures. See Exhibit A for copies of the letters.

The discovery period is still open and not scheduled to close until January 25, 2015.

Accordingly, Diesel respectfully requests the Board to grant its Motion for Sanctions, as set forth more fully below.

## **II. Argument**

Diesel respectfully requests this Board to sanction Frontier's failure to comply with the Board's July 28<sup>th</sup> Order compelling its Initial Disclosures. If a party does not comply with an order of the Board relating to discovery, the Board may impose against a party any of the sanctions provided by Fed. R. Civ. Pr. Rule 37(b)(2) except that the Board will not award damages or hold a person in contempt. 37 C.F.R. § 2.120(g)(1). Default judgment is an available remedy. *See* 37 C.F.R. § 2.120(g)(1); Fed. R. Civ. Pr. Rule 37(b)(2)(A)(vi). Not only is default judgment an available remedy, it is the only appropriate remedy in this case.

Diesel's request for sanctions is appropriate under 37 C.F.R. § 2.120(g)(1). On July 28,

2014, the Board issued an order compelling Frontier to make its Initial Disclosures to Diesel by August 27, 2014. The Board issued a discovery order, and Frontier failed to respond, making appropriate an award of sanctions under 37 C.F.R. § 2.120(g)(1). *See Kairos Institute of Sound Healing, LLC v. Doolittle Gardens, LLC*, 88 USPQ2d 1541 (TTAB 2008) [precedential][sanctions not available for failing to make Initial Disclosures absent the Board's order compelling them].

Default judgment is the appropriate sanction in this case. In 37 C.F.R. § 2.120(g)(1), the Board incorporates the sanctions set out in Fed. R. Civ. Pr. Rule 37(b)(2). This rule provides a range of sanctions including default judgment. *See Fed. R. Civ. Pr. Rule 37(b)(2)(A)(vi)*. While this is a harsh remedy, it is justified where a less drastic remedy is ineffective and there is strong showing of willful evasion. *See Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 U.S.P.Q.2d 1848, 1854 (T.T.A.B. 2000).

A no less drastic remedy is available. Under the Federal Rules that are incorporated by the Board, the available remedies include the following:

- (i) directing that the matters embraced in the order or other designated facts be taken as established for purposes of the action, as the prevailing party claims;
- (ii) prohibiting the disobedient party from supporting or opposing designated claims or defenses, or from introducing designated matters in evidence;
- (iii) striking pleadings in whole or in part;
- (iv) staying further proceedings until the order is obeyed;
- (v) dismissing the action or proceeding in whole or in part; and
- (vi) rendering a default judgment against the disobedient party. 37 C.F.R. § 2.120(g)(1)

Frontier has not advanced any counterclaims, and its affirmative defenses are reiterations or amplifications of the denials in its Answer. Because Frontier has not even met the minimal requirement of making its Initial Disclosures, the Board's order compelling production does not embrace any facts or matters that could be established to advance Diesel's claims. So the first three remedies are not relevant. Meanwhile, merely staying the proceeding rewards Frontier's dilatory conduct and hinders Diesel's ability to get a speedy resolution of its opposition. Dismissing the action or proceeding is not a relevant remedy because Diesel brought this action. Therefore, the only remaining remedy is a default judgment in Diesel's favor.

The parties' obligation to make Initial Disclosures is necessary to the efficient conduct of Board proceedings and should not be taken lightly by the parties. *See Kairos* at 1543. It is intended to facilitate the parties' exchange of information regarding the existence and location of documents and evidence and to lessen the burden of discovery. *Id.* So failing to make Initial Disclosures frustrates the rule's purpose.

As a result, Diesel is harmed by Frontier's conduct. It does not know if Frontier has any intention to rely on witnesses, and it does not what evidence, if any, it has to support its contentions. This increases the both parties' discovery burden and costs. Besides those associated with the Motion to Compel and this Motion for Sanctions, Diesel will need to draft broad requests, including ones that may not yield relevant information, and Frontier will need to respond to those because Frontier has not met its obligation. Diesel is driving in an unknown country without map. This result is the opposite one intended by the Board's 2007 rule changes to discovery.

Moreover, Frontier's behavior is willful. It has had since December 12, 2013, to produce

its Initial Disclosures, yet it has not. It failed to produce them despite Diesel's reminders. It did not respond to Diesel's Motion to Compel. It failed to respond to the Board's Order compelling them and to Diesel's reminders since the Order.

This lengthy delay combined with Diesel's reminders and the Board's Order to compel demonstrates that Frontier's failure to respond is willful and a less drastic remedy is not available. Therefore, a sanction in the form of default judgment is appropriate.

### **III. Request for Suspension**

Diesel respectfully requests the Board to suspend the opposition. Its Motion is dispositive of the proceedings, justifying suspension under Rule 2.127(d) ("When any party files a motion to dismiss, or a motion for judgment on the pleadings, or a motion for summary judgment, or any other motion which is potentially dispositive of a proceeding, the case will be suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion . . ."). *See also* TBMP §510.03(a). Additionally, pursuant to Rule 2.117(c), good cause exists for suspension of this proceeding in light of Frontier's non-compliance with the Board's Order. Thus, Diesel requests that the Board to continue the proceedings' suspension pending disposition of the present Motion.

WHEREFORE all of the foregoing reasons, Diesel S.p.A. respectfully requests that the Board suspend these proceedings while it considers the present Motion; and to ultimately grant its Motion for Sanctions, and enter sanctions in the form of default judgment against Applicant.

Respectfully Submitted,

DIESEL S.P.A.

Dated: September 16, 2014

By: /Robert S. Pierce/  
John C. Holman and Robert S. Pierce  
JACOBSON HOLMAN PLLC  
400 Seventh Street, N.W.  
Washington, D.C. 20004  
(202) 638-6666  
Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing *Opposer's Motion for Sanctions* was served on this 16<sup>th</sup> day of September 2014, by first class mail to Victor Wu, Law Offices of Victor Wu, Post Office Box 3188, Riverside, California 91761, Attorney for Applicant.

/Robert S. Pierce/

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

DIESEL S.P.A.,

Opposer,

v.

FRONTIER FASHION, INC.,

Applicant

Opposition No. 91212268

**EXHIBIT A**





Law Offices  
**Jacobson Holman**  
Professional Limited Liability Company  
400 Seventh Street, N.W.  
Washington, D.C. 20004-2218

(202) 638-6666  
(202) 393-5350 (fax)  
www.jhip.com  
Firm e-mail: ip@jhip.com

July 29, 2014

Mr. Victor Wu  
Law Offices of Victor Wu  
Post Office Box 3188  
Riverside, California 91761

**BY FIRST CLASS MAIL**

Re: Opposition to Trademark Serial No. 85796946  
Mark: **D and Greek Cross Design**  
Our Ref: 38/I06745

Dear Mr. Wu:

The Trademark Trial and Appeal Board has granted our motion to compel your client's initial disclosures by August 27, 2014. Please tell us when your client intends to provide them. If we do not receive them by the deadline, we will seek from the Board all available sanctions including a default judgment.

Meanwhile, we thank you for your attention to this matter.

Sincerely,

Robert S. Pierce  
JACOBSON HOLMAN PLLC  
[rpierce@jhip.com]

JCH/RSP/



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Firm e-mail: ip@jhip.com

August 28, 2014

Mr. Victor Wu  
Law Offices of Victor Wu  
Post Office Box 3188  
Riverside, California 91761

**BY FIRST CLASS MAIL**

Re: Opposition to Trademark Serial No. 85796946  
Mark: **D and Greek Cross Design**  
Our Ref: 38/I06745

Dear Mr. Wu:

The Trademark Trial and Appeal Board granted our motion to compel your client's initial disclosures by August 27, 2014. They are now past due.

Please tell us when your client intends to provide them. If we do not receive a reply to this letter by **September 12, 2014**, we will seek from the Board all available sanctions including a default judgment.

Meanwhile, we thank you for your attention to this matter.

Sincerely,

Robert S. Pierce  
JACOBSON HOLMAN PLLC  
[rpierce@jhip.com]

JCH/RSP/



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August 28, 2014

REMINDER

Mr. Victor Wu  
Law Offices of Victor Wu  
Post Office Box 3188  
Riverside, California 91761

BY FIRST CLASS MAIL

Re: Opposition to Trademark Serial No. 85796946  
Mark: **D and Greek Cross Design**  
Our Ref: 38/I06745

REMINDER

09/05/2014

Dear Mr. Wu:

The Trademark Trial and Appeal Board granted our motion to compel your client's initial disclosures by August 27, 2014. They are now past due.

Please tell us when your client intends to provide them. If we do not receive a reply to this letter by **September 12, 2014**, we will seek from the Board all available sanctions including a default judgment.

Meanwhile, we thank you for your attention to this matter.

Sincerely,

Robert S. Pierce  
JACOBSON HOLMAN PLLC  
[rpierce@jhip.com]

JCH/RSP/

**Robert Pierce**

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**From:** Robert Pierce  
**Sent:** Friday, September 05, 2014 4:32 PM  
**To:** 'victorwutrademark@gmail.com'  
**Subject:** Opposition to Trademark Ser. No. 85796946 D and Greek Cross Design; Our ref: I06745  
**Attachments:** I06745 oc ttab order reminder.pdf

Dear Mr. Wu,

Please see the attached reminder.

Kind regards,  
Robert Pierce

Robert S. Pierce  
Jacobson Holman PLLC  
400 7th Street, NW  
Washington, District of Columbia 20004  
United States of America  
Telephone: 202-638-6666  
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Confidentiality Notice

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