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

Proceeding	91231574
Party	Plaintiff Institut National de l'Origine et de la Qualite
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Submission	Motion for Discovery Sanctions
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

_____)	
INSTITUT NATIONAL DE L'ORIGINE)	
ET DE LA QUALITÉ,)	Opposition No. 91231574
)	
Opposer,)	Application Serial No. 86/937,249
)	
v.)	Mark: MACON CARSON
)	
THE OSAGE GROUP)	Published in the Official Gazette
)	of August 16, 2016
Applicant.)	
_____)	

OPPOSER'S MOTION FOR SANCTIONS

Pursuant to TBMP § 527, Trademark Rule 2.120(h)(1), and Rule 37(b)(2) of the Federal Rules of Civil Procedure, Opposer, Institut National de l'Origine et de la Qualité ("Opposer"), respectfully moves the Board for sanctions against Applicant The Osage Group ("Applicant") in the form of a default judgment sustaining the opposition and refusing registration of the subject mark, for failure to comply with its discovery obligations and with the Board's order of July 10, 2018. In support of this motion, Opposer states as follows:

I. BACKGROUND & FACTS

On April 25, 2017, Opposer served the Applicant with Opposer's Requests for the Production of Documents and Things and Opposer's Interrogatories. See Exhibits A to Motion to Compel (Docket Doc. 16). The Applicant's responses to Opposer's discovery requests were due May 25, 2017. No response was received. See attached Declaration of Peter M. Brody, Esq. ("Brody Declaration"), ¶ 3.

Shortly thereafter, Opposer granted Applicant a *nunc pro tunc* extension of time to serve responses to Opposer's discovery requests. After Applicant failed to meet the new deadline, a

further extension was granted in late June 2017 and again in September 2017. On September 26, 2017, the parties agreed to suspend all then-pending deadlines in this Opposition for ninety days, and the Board, on Opposer's consented motion, entered a suspension order on the same day.

The parties did not resolve the dispute during the suspension period, which expired on December 25, 2017. Prior to that, on November 21, 2017, Opposer had filed a Combined Motion to Compel and Motion to Extend Discovery and Trial Dates. On January 22, 2018, the Board denied the Motion to Compel as premature and granted Applicant until February 21, 2018 to serve discovery responses and to produce documents responsive to Opposer's document requests. The Board expressly commented that, "if Applicant fails to comply with this order, Opposer's remedy is to file a renewed motion to compel." Order at 2 n. 2. The Board also reopened the discovery period and reset the trial dates.

On February 27, 2018, Opposer, having still received no documents or other responses to its discovery requests from Applicant, filed a renewed Motion to Compel. Opposer also requested, as part of the same motion, that the Board again extend discovery and trial dates.

On March 3, 2018, the Board denied the Motion to Compel without prejudice, on the basis that Opposer had not indicated in its motion that it had undertaken any additional efforts to resolve the parties' discovery dispute after the February 21, 2018 due date for discovery responses.

To address this point, Opposer, on March 9, 2018, sent a letter via e-mail to Applicant's counsel, Anthony Martin, containing courtesy copies of Opposer's discovery requests, as well as a request that Applicant confirm that it would serve discovery responses and produce documents

by no later than March 16, 2018. Brody Dec. ¶ 6. Applicant did not respond to that letter in any fashion. Brody Dec. ¶ 6.

On March 22, 2018, Opposer filed a third Motion to Compel. Opposer also requested that the Board again extend discovery and trial dates.

On March 27, 2018, the Board granted Opposer's motion to extend the close of discovery period but denied without prejudice Opposer's motion to compel. The Board noted Opposer's requirement to make additional attempts, through telephone communication and correspondence, to elicit a response from Applicant, and further, to provide documentation, where applicable, of all such attempts.

On April 10, 2018, Opposer sent a second letter via e-mail to Applicant's counsel, Anthony Martin, again containing courtesy copies of Opposer's discovery requests, as well as a request that Applicant confirm that it would serve discovery responses and produce documents by no later than April 17, 2018. Brody Dec. ¶ 7 and Exhibit C. Applicant did not respond to that letter in any fashion. Brody Dec. ¶ 7.

On April 25, 2018, Attorney for Opposer, Peter Brody, placed a phone call to Applicant's counsel, Anthony Martin, at 415-314-1958. A message was left on voice mail asking Mr. Martin to return the call to discuss his client's overdue discovery responses and documents. No response to this message was received. Brody Dec. ¶ 8.

On May 1, 2018, Attorney for Opposer, Peter Brody, again placed a phone call to Applicant's counsel, Anthony Martin, at 415-314-1958. A similar message was left on voice mail. No response to this message was received by that day's end. Brody Dec. ¶ 9.

At day's end, May 1, 2018, Opposer sent an e-mail to Applicant's counsel, Anthony Martin, requesting a response via telephone or e-mail "as soon as possible." Applicant did not respond to that e-mail in any fashion then, or later. Brody Dec. ¶ 10.

On May 25, 2018, Opposer filed a fourth Motion to Compel. Opposer also requested that the Board again extend discovery and trial dates. On July 10, 2018 the Board granted the Motion to Compel stipulating "Applicant is allowed until thirty days from the mailing date set forth in this order to serve responses without objection to Opposer's interrogatories and document requests and to produce documents responsive to the document requests. See Trademark Rule 2.120(h)(1)." Applicant did not serve any responses.

Once again, Applicant failed to comply with the Board's order compelling responses to Opposer's discovery requests and the production of documents. On August 13, 2018, Opposer sent a letter via e-mail to Applicant's counsel, Anthony Martin, requesting that Applicant confirm that it would serve discovery responses and produce documents by no later than August 17, 2018. Applicant did not respond to that letter in any fashion. Brody Dec. ¶ 11.

On August 21, 2018, Opposer's counsel sent an e-mail to Applicant's counsel, Anthony Martin, stating as follows:

I have received no response from you to my letter dated August 13, 2018. Unless you advise otherwise by close of business **August 23, 2018**, I will assume that you do not intend to respond to the letter and that your client does not intend to comply with the TTAB's order compelling responses to our discovery requests by August 9, 2018. **Please be advised that, absent a response by August 23, we will renew our motion for sanctions in the form of a judgment sustaining the opposition and refusing registration of the subject mark.**

Applicant did not respond to that e-mail in any fashion then, or later. Brody Dec. ¶ 12.

In short, as of this date, and despite two orders from this Board directing Applicant to serve responses to Applicant's April 2017 discovery requests and produce its documents, Applicant has not done so and has not otherwise responded to any of the numerous communications from Opposer in any manner since early November 2017.

II. ARGUMENT & RELIEF REQUESTED

Pursuant to TBMP § 527.01(a), "If a party fails to comply with an order of the Board relating to discovery, including a protective order or an order compelling discovery, the Board may enter appropriate sanctions, as defined in 37 CFR § 2.120(h)(1)." TBMP § 527.01(a); *accord id.* § 411.05. In a situation where there has been continuing avoidance of discovery, the Board will enter a default judgment against the disobedient party. *See, e.g., 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); and TBMP § 527.01.

Applicant has clearly and continuously failed to comply with its discovery obligations and with the Board's July 10, 2018 order. Applicant has been represented by counsel throughout this proceeding, and its disregard of its discovery obligations and the Board's express order must be deemed to be willful. Sanctions in the form of default judgment against Applicant therefore are appropriate.

Accordingly, Opposer respectfully moves this Board to enter judgment for Opposer pursuant to Trademark Rule 2.120. Opposer further moves this Board for any other relief it deems appropriate.

WHEREFORE, Opposer respectfully requests that the Trademark Trial and Appeal Board grant the Motion for Sanctions, enter judgment for Opposer, and grant all other appropriate relief.

Respectfully submitted,

Dated: August 31, 2018

/Peter M. Brody/

Peter M. Brody, Esq.
ROPES & GRAY LLP
2099 Pennsylvania Ave., NW
Washington, D.C. 20006-6807

Attorneys for Institut National de l'Origine
et de la Qualité

period, which expired on December 25, 2017. Prior to that, on November 21, 2017, Opposer had filed a Combined Motion to Compel and Motion to Extend Discovery and Trial Dates. On January 22, 2018, the Board denied the Motion to Compel as premature and granted Applicant until February 21, 2018 to serve discovery responses and to produce documents responsive to Opposer's document requests. The Board expressly commented that, "if Applicant fails to comply with this order, Opposer's remedy is to file a renewed motion to compel." Order at 2 n. 2.

6. Applicant did not serve discovery responses or product documents in compliance with the Board's January 22, 2018 order. On March 9, 2018 I sent a letter via e-mail to Applicant's counsel, Anthony Martin, requesting that Applicant confirm that it would serve discovery responses and produce documents by no later than March 16, 2018 (see Exhibit A). I received no response to this letter.

7. On April 10, 2018 I sent a follow-up letter via e-mail to Applicant's counsel, Anthony Martin, asking that Applicant confirm that it would serve discovery responses and produce documents by no later than April 17, 2018 (see Exhibit B). Again, I received no response to this letter.

8. On April 25, 2018 I placed a phone call to Applicant's counsel, Anthony Martin, and left a message on voice mail asking Mr. Martin to return the call to discuss his client's overdue discovery responses and documents. I received no response to this call.

9. On May 1, 2018 I placed another phone call to Applicant's counsel, Anthony Martin, and left a message on voice mail asking Mr. Martin to return the call to discuss his client's overdue discovery responses and documents. I received no response to this call, either.

EXHIBIT A



ROPES & GRAY LLP
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WASHINGTON, DC 20006-6807
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Peter M. Brody
T +1 202 508 4612
peter.brody@ropesgray.com

March 9, 2018

BY E-MAIL (acm.alt@gmail.com)

Anthony Martin
The Osage Group
5002 SW Blairmont
Bentonville, Arkansas 72712

Re: MACON CARSON – Trademark Opposition No. 91231574

Dear Martin:

As you are aware, on January 22, 2018, the TTAB issued an order providing that “Applicant is allowed until thirty days from the mailing date set forth in this order to serve discovery responses and to produce documents responsive to Opposer’s document requests.” Courtesy copies of my client’s discovery requests are attached.

As of the deadline set by the TTAB (February 21, 2018), we had received no discovery responses or documents from you, nor have we received them to this date.

Please confirm ASAP that you will serve discovery responses and product documents by no later than March 16, 2018.

This e-mail constitutes Opposer’s good-faith effort to resolve this discovery dispute. If you wish to discuss this matter, please let me know. If I do not hear anything from you by March 16, I will assume your client does not intend to respond to our discovery requests and does not wish to discuss the matter, and we will promptly proceed to renew our motion to compel.

Regards,

Peter M. Brody

Attachments

EXHIBIT B



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WASHINGTON, DC 20006-6807
WWW.ROPESGRAY.COM

Peter M. Brody
T +1 202 508 4612
peter.brody@ropesgray.com

April 10, 2018

BY E-MAIL (acm.alt@gmail.com)

Anthony Martin
The Osage Group
5002 SW Blairmont
Bentonville, Arkansas 72712

Re: MACON CARSON – Trademark Opposition No. 91231574

Dear Martin:

On behalf of Opposer, I write in a further good-faith effort to resolve the discovery dispute in this matter.

As you are aware, on January 22, 2018, the TTAB issued an order providing that “Applicant is allowed until thirty days from the mailing date set forth in this order to serve discovery responses and to produce documents responsive to Opposer’s document requests.” Courtesy copies of my client’s discovery requests are attached.

As of the deadline set by the TTAB (February 21, 2018), we had received no discovery responses or documents from you, nor have we received them to this date.

On March 9, I wrote to you asking you to confirm ASAP that you would serve discovery responses and product documents by no later than March 16, 2018. Again, I received no response from you.

If you wish to schedule a conference to discuss this matter, please let me know. If I do not hear anything from you by April 17, I will assume your client does not intend to respond to our discovery requests and does not wish to discuss the matter, permitting us to renew our motion to compel.

Regards,

Peter M. Brody

Attachments

EXHIBIT C

Duvernay, Ronald M.

From: Brody, Peter M.
Sent: Tuesday, May 01, 2018 4:47 PM
To: acm.alt@gmail.com
Cc: Brody, Peter M.; Duvernay, Ronald M.; Yirrah, Abbie
Subject: RE: MACON CARSON - Trademark Opposition No. 91231574

Mr. Martin –

I have received no response to my letter to you of April 10, nor to the telephone messages I left for you on April 25 and May 1, asking you to call.

Please call me to discuss your long overdue discovery responses, or reply by email with your response to my April 10 letter, as soon as possible.

I hope to hear from you shortly. If I do not, I intend to renew my motion for an order compelling you to respond to our outstanding discovery requests.

Regards,
Peter Brody

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2099 Pennsylvania Avenue, N.W.
Washington, DC 20006-6807
peter.brody@ropesgray.com
www.ropesgray.com

From: Yirrah, Abbie
Sent: Tuesday, April 10, 2018 4:05 PM
To: acm.alt@gmail.com
Cc: Brody, Peter M. ; Duvernay, Ronald M.
Subject: MACON CARSON - Trademark Opposition No. 91231574

Dear Mr. Martin:

Please see the attached correspondence sent to you on behalf of Mr. Peter Brody.

Regards,
Abbie

Abbie Yirrah
Legal Executive Assistant
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EXHIBIT D



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Peter M. Brody
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peter.brody@ropesgray.com

August 13, 2018

BY E-MAIL (acm.alt@gmail.com)

Anthony Martin
The Osage Group
5002 SW Blairmont
Bentonville, Arkansas 72712

Re: MACON CARSON – Trademark Opposition No. 91231574

Dear Mr. Martin:

As you should be aware, on July 10, 2018, the TTAB issued an order granting my client's motion to compel discovery and providing that "Applicant is allowed until thirty days from the mailing date set forth in this order to serve discovery responses and to produce documents responsive to Opposer's document requests." That thirty-day time period expired on August 9, 2018. As of that date, and as of today, your client has failed to comply with the order.

Please advise me by close of business August 17, 2018, whether your client intends to rectify this failure. If you wish to schedule a conference to discuss this matter, please let me know prior to that date. If I do not hear anything from you by August 17, I will assume your client does not intend to respond or to rectify the failure to comply with the TTAB's order, and we will proceed accordingly.

Regards,

Peter M. Brody

EXHIBIT E

Duvernay, Ronald M.

From: Brody, Peter M.
Sent: Tuesday, August 21, 2018 9:01 AM
To: acm.alt@gmail.com
Cc: Duvernay, Ronald M.
Subject: RE: MACON CARSON – Trademark Opposition No. 91231574

Follow Up Flag: Follow up
Flag Status: Flagged

Mr. Martin –

I have received no response from you to my letter dated August 13, 2018. Unless you advise otherwise by close of business **August 23, 2018**, I will assume that you do not intend to respond to the letter and that your client does not intend to comply with the TTAB's order compelling responses to our discovery requests by August 9, 2018. **Please be advised that, absent a response by August 23, we will renew our motion for sanctions in the form of a judgment sustaining the opposition and refusing registration of the subject mark.**

Regards,
Peter Brody

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peter.brody@ropesgray.com
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From: Yirrah, Abbie
Sent: Monday, August 13, 2018 9:22 AM
To: acm.alt@gmail.com
Cc: Brody, Peter M. <Peter.Brody@ropesgray.com>
Subject: MACON CARSON – Trademark Opposition No. 91231574

Good morning Mr. Martin—

Please see the attached correspondence, sent to you on behalf of Mr. Peter Brody in my capacity as his assistant.

Thanks!

Abbie Yirrah
Legal Executive Assistant
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Abbie.Yirrah@ropesgray.com
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Applicant.))	
_____))	

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on this 31st day of August, 2018, a true and correct copy of this Opposer's Motion for Sanctions was served upon Applicant's counsel by e-mail, in accordance with 37 CFR 2.119, to:

Anthony Martin
Acm.alt@gmail.com
The Osage Group
5002 SW Blairmont
Benronville, Arkansa 72712



Ronald M. Duvernay
ROPES & GRAY LLP