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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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June 3, 2020

Opposition No. 91241109

eBay Inc.

v.

Edutec Limited

Before Kuhlke, Shaw, and Hudis,
Administrative Trademark Judges.

By the Board:

This opposition proceeding comes before the Board for consideration of the following submissions: (1) Opposer's contested motion, filed January 24, 2020, for sanctions in the nature of judgment, 35 TTABVUE;[1] and (2) the request of Applicant's counsel, Nikita Tepikin, filed February 5, 2020, for permission to withdraw as Applicant's counsel. 38 TTABVUE. Opposer opposes counsel's request to withdraw.

I. Relevant Background

On May 14, 2019, Applicant, Edutec Limited, a Limited Liability Company of Malta, filed a change of correspondence address and a power of attorney appointing

[1] Applicant filed its response to the motion for sanctions on February 12, 2020 and an amended response the following day. Applicant's amended response does not include the attachments in the original.

Mariia Feigina, to represent Applicant in this proceeding. 15 TTABVUE.[2] Because Ms. Feigina appeared to be a foreign attorney, on June 14, 2019 the Board issued an order advising Applicant that a foreign attorney could not practice before the United States Patent and Trademark Office (USPTO) (17 TTABVUE). Because Applicant stated that it intended to represent itself, the Board allowed Applicant time to identify an officer of Applicant authorized to represent it under Patent and Trademark Rule 11.14, 37 C.F.R. § 11.14(c). 17 TTABVUE 3. In response to the order, Applicant filed a document confirming that "Ms. Mariia Feigina is an officer of Applicant." 18 TTABVUE 2.

On August 15, 2019, Opposer filed a motion to compel discovery. 23 TTABVUE. Because Applicant failed to file a brief in response to the motion, the Board, on September 25, 2019, issued an order granting the motion as conceded. 25 TTABVUE. In addition, as a result of an amendment to Trademark Rule 2.11(a), 37 C.F.R. § 2.11(a), effective August 3, 2019, requiring applicants, registrants, or parties to proceedings before the Board not domiciled within the U.S. or its territories to be represented by an attorney who is licensed to practice law in the United States ("U.S. Counsel Rule"), the Board allowed Applicant time to secure U.S. counsel. *Id.* at 3. Applicant responded to the Board's order by filing a power of attorney authorizing Nikita Tepikin, an attorney licensed in the state of New York, to represent it in this

[2] Applicant's previous attorneys, Laura Popp-Rosenberg and Melissa Goldstein, filed a request to withdraw as counsel for Applicant on April 9, 2019 citing, among other reasons, failure of Applicant to provide instructions and fulfill certain obligations to counsel. 12 TTABVUE 3.

proceeding. 26 TTABVUE 2.[3] Because Applicant's response did not include any contact information for its U.S. attorney, the Board issued an additional order requiring Applicant to provide Mr. Tepikin's address, email address, and telephone number for correspondence in this proceeding. 32 TTABVUE.[4]

II. Opposer's Motion for Judgment Sanctions

Opposer's motion for judgment sanctions is based on allegations that (1) Applicant failed to meet its discovery obligations and comply with the Board's September 25 discovery order; and (2) Applicant committed fraud in circumventing the U.S. Counsel Rule requiring foreign domiciled applicants and registrants to be represented by an attorney licensed in the United States. 35 TTABVUE 2. In the event the Board declines to enter judgment against Applicant, Opposer requests that the Board set an oral hearing on its motion for sanctions at the Denver office of the USPTO, require counsel for both parties to attend in person, and that "Mr. Tepikin be put to proof for why he should not be disqualified from representing Applicant in this proceeding." *Id.* at 2-3.

A. Request for Sanctions for Failure to Comply with Discovery Order

Opposer states that Applicant responded to the Board's discovery order by providing "copies of its previous incomplete and unverified discovery response" and

[3] On October 28, 2019, Applicant filed with the Board a "Certificate of good standing of its attorney, Nikita Aleksandrovich Tepikin," dated April 17, 2014, and issued by the State of New York Supreme Court, Appellate Division, Third Judicial Department. 30 TTABVUE 3-4.

[4] Applicant provided the correspondence information on November 8, 2019. 33 TTABVUE. Although Mr. Tepikin provided a physical correspondence address located in Rye, New York, he provided a telephone number in Russia.

submitting supplemental responses and new documents. *Id.* at 4.[5] Opposer argues that Applicant's responses remain deficient because, among other reasons: (i) Applicant's incomplete responses are incomprehensible; (ii) Applicant failed to withdraw its objections and asserted new objections despite forfeiting its right to object to Opposer's discovery requests; (iii) Applicant failed to produce documents in response to several requests but did not affirmatively state that no documents exist; (iv) Applicant did not produce a privilege log, but maintained discovery objections based on privilege; (v) Applicant did not verify its interrogatory responses despite numerous reminders; (vi) Applicant did not provide any indicia of authenticity with its document production despite Opposer's requests; and (vii) Applicant willfully destroyed materially relevant information by admitting that it does not store marketing information despite notice of its obligation to preserve documents since May 2018. *Id.* at 6.

Applicant argues that it provided "multiple sets of information and documents" and that "[a]ll purported discovery deficiencies alleged by the Opposer are attributable to either the nonexistence of applicable documents and related information [or information] that is not within Applicant's possession custody or control." 41 TTABVUE 5. In addition, Applicant contends that it "has [no] duty to make changes to documents to make them more comprehensible to Opposer." *Id.* Applicant also states that "it does not nor has it withhold [sic] any documents or information which are at its disposal and that could have or can be provided in

[5] Applicant filed its original responses and supplemental responses with the Board at 28 TTABVUE and 31 TTABVUE, respectively.

accordance with the applicable law, and it has made and continues to make its best efforts to comply with its discovery obligations including stating that it has no relevant documents." *Id.* at 8.

B. Request for Sanctions for Circumventing the U.S. Counsel Rule

Opposer states that after the appointment of Mr. Tepikin as Applicant's U.S. counsel, Ms. Feigina continued to act as Applicant's counsel by signing, filing and serving documents in the Board proceeding. *Id.* at 9-11.[6] Opposer asserts that Applicant has thus committed fraud in attempting to circumvent the U.S. Counsel Rule.

Opposer contends that the results of its investigations into Mr. Tepikin and the various entities with which he appears to be associated show that "Mr. Tepikin was either complicit in allowing Applicant to use his U.S.-licensure information (without his oversight or control) and/or that Mr. Tepikin's information was misappropriated …." *Id.* at 15. Based on its investigations, Opposer argues that (1) Applicant, likely via Ms. Feigina, is filing papers on behalf of Applicant and is possibly controlling the correspondence email address associated with Mr. Tepikin; and (2) "there are at least two different people claiming to be Nikita Tepikin and acting on behalf of Applicant in this proceeding." *Id.* at 21.

In addition, Opposer argues that Mr. Tepikin is not authorized to practice in New York as a nonresident attorney because he does not maintain a physical office as

[6] As evidence, Opposer refers to the documents filed at 27 TTABVUE, 28 TTABVUE, and 29 TTABVUE which appear to include the signature of Mr. Tepikin, but also include Ms. Feigina's email address in the "Filer's email" on the ESTTA generated cover page.

required under N.Y. Judiciary Law § 470 (2019). *Id.* at 22. Opposer provided evidence that Mr. Tepikin and his firm do not conduct business at the provided residence address in Rye, New York. *Id.* at 17-20, 148-49. Thus, Opposer contends that Mr. Tepikin should be disqualified from representing Applicant in this proceeding. *Id.* at 21.

In response, Applicant states that Mr. Tepikin agreed to provide legal services for Applicant in August, 2019, but that he did not commence providing services in the opposition until after filing his appearance. 41 TTABVUE 2. Applicant and Mr. Tepikin, however, "initiated termination of the Agreement upon mutual consent of the parties" at the end of December 2019. *Id.*[7] In addition, Applicant states that upon Mr. Tepikin's recognition that he was not in compliance with N.Y. Judiciary Law § 470, he submitted his request to withdraw as Applicant's attorney in the proceeding. *Id.* at 4.

Applicant further states that although he has not been to the United States since 2014, Mr. Tepikin is a lawyer licensed in the State of New York and has constantly re-registered as such since 2014 by paying mandatory professional fees." *Id.* at 13. Applicant states that Mr. Tepikin has "passed all continuing law education courses (CLE) required for all attorneys in New York" for the period of 2018-2019. *Id.*[8] Mr. Tepikin admits that he was "mistaken and did not know anything about Judiciary Law § 470." *Id.* Applicant argues, however, that "[t]he presence of an office for

[7] See emails submitted with Applicant's original Response to the motion. 40 TTABVUE 17-20. (Attachments A and B).

[8] *See id.* at 21-24. (Attachments C and D).

administration of justice in the USPTO becomes meaningless" since all correspondence with the Board and the opposing party is, with limited exceptions, in electronic form. *Id.* at 14. Applicant further argues that the use of a "'mail drop' is absolutely legal and customary practice in the vast majority of jurisdictions in the world." *Id.* at 19.

In its reply, in addition to rearguing the points made in its motion, Opposer argues that neither Applicant nor Mr. Tepikin refute that he was complicit in allowing Applicant to use his credentials to continue to represent itself. 42 TTABVUE 9-10.

Opposer has submitted exhibits and other evidence in support of its arguments. The Board has considered the arguments and evidence submitted in connection with the motion, but does not repeat or discuss all of the arguments and submissions, except as necessary to explain the decision. *Guess? IP Holder L.P. v. Knowluxe LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

III. Decision

A. Intent to Circumvent U.S. Counsel Rule

We turn first to Opposer's request for sanctions based on Applicant's failure to comply with the U.S. Counsel Rule. The United States Patent and Trademark Office (USPTO) amended its rules, effective August 3, 2019, to require applicants, registrants, or parties to trademark proceedings whose domicile is not located within the U.S. or its territories to be represented by an attorney as defined by Section 11.1 of the Patent and Trademark Rules of Practice, 37 C.F.R. § 11.1. *See* Trademark Rule 2.11(a), 37 C.F.R. § 2.11(a). Under Rule 11.1, an "attorney" is defined as "an

individual who is an active member in good standing of the bar of the highest court of any State." Once a qualified attorney has been recognized to represent an applicant or registrant, the USPTO will not conduct business directly with the applicant or registrant. Trademark Rule 2.18(a)(7), 37 C.F.R. § 2.18(a)(7).

Here, Opposer provided evidence that conflicts with Applicant's statement regarding the date Mr. Tepikin was retained as counsel and his appearance in this proceeding.[9] In addition, documents filed in this proceeding that include Mr. Tepikin's signature appear to have been filed by Applicant's representative, Ms. Feigina.[10] Although we find the evidence troubling, in light of Mr. Tepikin's request to withdraw, and because it is unclear whether Mr. Tepikin was complicit or his information was misappropriated, we decline to enter the extreme sanction of judgment at this time based on Applicant's alleged circumvention of the U.S. Counsel Rule.

In addition, Opposer's argument that Mr. Tepikin is not authorized to practice law before the USPTO is inapposite. Section 470 of N.Y. Judiciary Law, by its terms, requires an attorney practicing "in the courts of record of [New York] state" to maintain an office in New York. *See Shoenefeld v. Schneiderman*, 821 F.3d 273, 283 (2d Cir. 2016) (the in-state office requirement was enacted so that "nonresident lawyers could practice in the state's courts …."), *cert. denied*, 137 S. Ct. 1580 (2017).

[9] *See* Declaration of Hope Hamilton at ¶¶ 9-15, 35 TTABVUE 29-30.

[10] *See* 27 TTABVUE, 28 TTABVUE, and 29 TTABVUE

Thus, Section 470 of N.Y. Judiciary Law does not apply to attorneys licensed and in good standing in New York seeking to practice before the USPTO.

In view of the foregoing, Opposer's motion for judgment sanctions based on grounds that Applicant intentionally circumvented the U.S. Counsel Rule is **DENIED**.[11]

B. Failure to Comply with Discovery Order

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(h) and Fed. R. Civ. P. 37(b)(2), including entry of judgment. *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1854 (TTAB 2000); *see also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 527.01 (2019). Entry of judgment is a harsh remedy, but is justified where no less drastic remedy would be effective and there is a strong showing of willful evasion. *See Unicut Corp. v. Unicut, Inc.*, 222 USPQ 341, 344 (TTAB 1984). The question of the proper sanction is left to the sound discretion of the Board. *See Ingalls Shipbuilding, Inc. v. U.S.*, 857 F.2d 1448, 1450-51 (Fed. Cir. 1988).

Here, although Applicant provided supplemental responses and produced documents, Applicant clearly failed to comply with the Board's September 25, 2019 order requiring Applicant to, among other things, provide responses to Opposer's

[11] Although we decline to enter judgment at this time, as noted above, the evidence here is troubling. Applicant is warned that noncompliance with the U.S. Counsel Rule can result in judgment.

interrogatories and document requests without objection on the merits.[12] 25 TTABVUE 2. Under the circumstances, however, we do not find that the sanction of judgment against Applicant is warranted at this time. Accordingly, Opposer's motion for judgment sanctions is **DENIED**.[13]

C. Counsel's Request to Withdraw

Notwithstanding Opposer's opposition to the request, we find Mr. Tepikin's withdrawal from the proceeding appropriate.[14] Applicant and Mr. Tepikin have agreed to his withdrawal. Thus, we **GRANT** Mr. Tepikin's request to withdraw as counsel on grounds that his withdrawal will not adversely affect the interests of Applicant under Patent and Trademark Rule 11.116(b)(1), 37 C.F.R. § 11.116(b)(1). Accordingly, Nikita Tepikin no longer represents Applicant in this proceeding. In view thereof, Opposer's request for an oral hearing is moot.

D. Further Responses Required and Sanctions Entered

In view of the withdrawal of its U.S. counsel, Applicant is hereby **ORDERED** to obtain new U.S. counsel and establish representation in this proceeding in accordance with Trademark Rule 2.11(a), by filing a written power of attorney within **THIRTY DAYS** of the mailing date of this order. Applicant's new U.S. counsel must provide: (i) the name of the state or territory in which he or she is an active member; (ii) the date of admission to the bar of the named state; (iii) the attorney's bar license number,

[12] Under Fed. R. Civ. P. 33(b)(1), the responses must be signed by the person answering them.

[13] Although we decline to enter judgment at this time, again the evidence here is troubling. Applicant is warned that continued noncompliance with the Board's September 25, 2019 discovery order can result in judgment.

[14] We find Opposer's arguments in opposition to the request to withdraw unpersuasive.

if one is issued by the named state or territory; and (iv) a current statement of good standing on the bar of the specified state. *See* Trademark Rule 2.17(b)(3), 37 C.F.R. § 2.17(b)(3). Within **FIVE DAYS** of the filing of the power of attorney, Applicant's counsel must contact the assigned Interlocutory Attorney by telephone.[15]

In addition, except for stipulated ESTTA-generated form filings, Applicant may not sign with an electronic signature. Each correspondence, pleading, motion or discovery response from Applicant, filed with the Board or served on Opposer, must a bear the handwritten signature in ink of Applicant's attorney. *See* Trademark Rule 2.193(a)(1), 37 C.F.R. § 2.193(a)(1). Failure to comply with the foregoing may result in additional sanctions against Applicant.

Although we decline at this time to enter the ultimate sanction of judgment against Applicant, with respect to Applicant's failure to comply fully with the Board's September 25, 2019 discovery order we find the following sanctions are appropriate. Trademark Rule 2.120(h).

Applicant is hereby **ORDERED** to fully comply with the Board's previous discovery order, at 25 TTABVUE, within **FORTY DAYS** of the mailing date of this order. In particular, Applicant shall:

1) Provide full and complete responses to Opposer's interrogatories, without objection on the merits, by reproducing each interrogatory in numbered

[15] Interlocutory Attorney Michael Webster can be reached at 571-272-9266.

sequence immediately followed by Applicant's answer thereto. *See* Fed. R. Civ. P. 33(b)(3);[16]

2) Verify the responses (i.e., signed under oath by an officer or managing agent of Applicant). *See* Fed. R. Civ. P. 33(b)(3) and (5);

3) Produce non-privileged responsive documents and/or electronically stored information ("ESI") regarding each of Opposer's production requests and respond in full, without objection on the merits, to each request. If there are no documents or ESI that are responsive to any of Opposer's production requests, Applicant must so state affirmatively in its response to the corresponding request. *See* Fed. R. Civ. P. 34(b)(2)(A)-(E); and

4) If Applicant claims privilege to any of Opposer's discovery requests, Applicant must provide Opposer with a privilege log simultaneously with its supplemental responses pursuant to this Order.[17]

In addition, Applicant is prohibited from relying at trial on any documents or ESI requested by Opposer during discovery, but which have not been produced prior to January 24, 2020 (the filing date of the motion for sanctions). *See, e.g., Busy Beauty v. JPB Grp., LLC*, 2019 USPQ2d 338392, at *7 (TTAB 2019) (in view of petitioner's

[16] Objections on the merits include those that challenge the request as, for example, overly broad, unduly vague and ambiguous, burdensome and ambiguous, or as not calculated to lead to the discovery of admissible evidence. *See No Fear, Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000). Claims that information sought is subject to attorney/client privilege or comprise attorney work are not merits-based objections and are not deemed to be waived.

[17] A privilege log typically identifies each document withheld, information regarding the nature of the privilege/protection claimed, the name of the person making/receiving the communication, the date and place of the communication, and the document's general subject matter. *See* TBMP § 406.04(c).

failure to preserve the content, petitioner was precluded from relying on the evidence at trial).

Should Applicant's discovery transgressions continue, judgment may be an appropriate sanction upon motion by Opposer. *See Benedict v. Superbakery Inc.*, 665 F.3d 1263, 101 USPQ2d 1089, 1093 (Fed. Cir. 2011) (affirming judgment sanctions for repeated failure to comply with deadlines); *Elec. Indus. Assoc. v. Potega*, 50 USPQ2d 1775, 1778 (TTAB 1999).

IV. Suspension

Proceedings are suspended for 30 days pending Applicant's response to the requirement to obtain U.S. counsel.