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

April 22, 2023

Opposition No. 91267937

Alpha Kappa Alpha Sorority

v.

Stroll to the Polls, Inc.

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

This case now comes up for consideration of Applicant's fully briefed combined motion (filed January 26, 2023) for discovery sanctions, or alternatively, to compel deposition of Dr. Nicole Barrett and to reopen discovery. 46 TTABVUE.[1]

The Board has considered the parties' briefs and materials or evidence submitted therewith, but addresses the record only to the extent necessary to support the Board's analysis and findings, and does not repeat or address all of the parties'

[1] Citations to the record or briefs in this order include citations to the publicly available documents on the Trademark Trial and Appeal Board Inquiry System (TTABVUE), the Board's electronic docketing system. *See, e.g., New Era Cap Co., Inc. v. Pro Era, LLC,* 2020 USPQ2d 10596, at *2 n.1 (TTAB 2020) (citing *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014)). To allow the Board and readers to easily locate materials in the record, the parties should cite to facts or evidence in the proceeding record by referencing the TTABVUE entry and downloadable PDF page number, e.g., "1 TTABVUE 2," and not attach previously-filed evidence to their briefs. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) §§ 106.03, 801.01 and 801.03 (2022). For material or testimony that has been designated confidential and which does not appear on TTABVUE, the TTABVUE docket entry number where such material or testimony is located should be included in any citation.

arguments or materials. *Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015). For purposes of this order, the Board presumes the parties' familiarity with the arguments and materials submitted in connection with the subject motion.

I. Applicant's Motion for Sanctions, or alternatively, to Compel

By way of background, on December 31, 2022, Applicant filed a notice with the Board indicating that it would remotely via video teleconference take the deposition upon written questions of Opposer's witness, Nicole Barrett, outside of the discovery period. 42 TTABVUE 2-3. However, the Board noted that discovery closed in this proceeding on December 22, 2022. 37 TTABVUE. In view thereof, on January 11, 2023, the Board issued an order reminding the parties that discovery depositions must be taken during the discovery period, *see* Trademark Rule 2.120(a)(3), and *sua sponte* reopened the discovery period through January 20, 2023, to accommodate the parties' apparent agreement to conduct the deposition upon written questions of Ms. Barrett on that date.[2] *Cf.* Trademark Rule 2.124(d)(1). 43 TTABVUE 2. The Board also suspended the proceeding, and required Applicant to advise the Board within twenty days of the completion of the deposition, so that this proceeding could be resumed. *Id.*

[2] The Notice to Take Deposition Upon Written Questions stated, in part, Applicant "withdrew its earlier notice of deposition upon oral examination of Nicole Barrett in connection with the above-captioned proceeding in response to Opposer's request for a deposition date of January 20, 2023; Opposer's consent to the deposition of Nicole Barrett outside of the discovery period; Opposer's confirmation that Nicole Barrett will serve as Opposer's Rule 30(b)(6) witness; and Opposer's stipulation to the deposition of its Rule 30(b)(6) witness, Nicole Barrett, via written questions." 42 TTABVUE 2.

Applicant asserts that Opposer refused to produce Nicole Barrett for a deposition upon written questions on January 20, 2023, and in view thereof, Applicant requests that the Board either enter judgment against Opposer for "Opposer's unwarranted obstructionist objections to discovery that denied Applicant the opportunity to depose Opposer," 46 TTABVUE 15, or to compel Opposer to produce Ms. Barrett for her discovery deposition and reopen the discovery period solely for the purpose of allowing Applicant to conduct that deposition.

Initially, to the extent Applicant requests entry of judgment against Opposer as a discovery sanction, under Trademark Rule 2.120(h)(1), a Board may issue a sanctions order, including those provided in Fed. R. Civ. P. 37(b)(2), only if a party fails to comply with a prior Board order relating to disclosure or discovery, including a protective order. An order related to discovery has not been issued against Opposer in this case. Further, entry of judgment is warranted in cases of repeated failure to comply with orders of the Board, where a lesser sanction would not be effective, neither of which circumstances are applicable here. *See, e.g., Benedict v. Super Bakery, Inc.*, 665 F.3d 1263, 101 USPQ2d 1089, 1093 (Fed. Cir. 2011); *MHW Ltd. v. Simex, Aussenhandelsgesellschaft Savelsberg KG,* 59 USPQ2d 1477, 1478-79 (TTAB 2000) (repeated failure to comply with orders and unpersuasive reasons for delay resulted in entry of judgment; sanctions in the nature of entry of judgment granted after finding that non-movant engaged for years in delaying tactics, including willful disregard of the Board's orders); *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, 344 (TTAB 1984) (judgment appropriate sanction for violating prior Board order compelling appearance at deposition and responses to document requests); *Caterpillar Tractor Co. v. Catfish Anglers Together, Inc.*, 194 USPQ 99 (TTAB 1976); *see also* TBMP § 527.01. None of the foregoing circumstances exist in this case. Accordingly, **Applicant's motion for discovery sanctions will not be considered because it is premature**.

As regards Applicant's alternative motion to compel, as a threshold matter, Applicant has provided no showing whatsoever that it made a good faith effort to resolve the parties' discovery dispute prior to filing its motion. *See* Trademark Rule 2.120(f)(1); *see, e.g., Giant Food, Inc. v. Standard Terry Mills, Inc.,* 231 USPQ 626 (TTAB 1986) (failed to submit documentary evidence of good faith effort). The Board expects that the movant's showing will comprise a recitation of the communications conducted, including dates, a summary of telephone conversations, and copies of any correspondence exchanged, where applicable (e.g., emails, letters, notes to file). *Hot Tamale Mama … and More, LLC v. SF Inv., Inc.*, 110 USPQ2d 1080, 1081 (TTAB 2014); *see also* TBMP § 523.02 (in determining whether a good faith effort to resolve the discovery dispute has been made, the Board may consider, among other things, whether the moving party has investigated the possibility of resolving the dispute, whether, depending on the circumstances, sufficient effort was made towards resolution, and whether attempts at resolution were incomplete).

In addition to not providing any showing that Applicant made a good faith effort to resolve the parties' discovery dispute, the record shows that Applicant failed to

cooperate with Opposer, notwithstanding Opposer's counsel's attempts to arrange the deposition sought by Applicant:

(i) In an email sent on December 20, 2022, Opposer agreed to stipulate to the deposition of its Rule 30(b)(6) witness, Dr. Nicole Barrett, via written questions, but reminded Applicant that it would need to abide by the requirements for Opposer to submit questions on cross and re-cross as set forth under Fed. R. Civ. P. 31(a)(5),[3] 48 TTABVUE 10, ¶ 6 to the Declaration of Jessica Ekhoff, Opposer's counsel ("Ekhoff dec.") (Exh. 5 and 48 TTABVUE 57);

(ii) In a January 24, 2023 email from Opposer's counsel, Ms. Ekhoff, Opposer explained to Applicant that Opposer had a right to serve cross-questions until January 20, 2023, and that the deposition could not have proceeded on January 20th, as long as Opposer's time to serve cross-questions remained open, 48 TTABVUE 4, 10, and ¶ 4, Ekhoff dec. (Exh. 3, 48 TTABVUE 53);

(iii) Opposer provided to Applicant on January 23, 2023, six new dates to Applicant on which Dr. Barrett is available, 48 TTABVUE 5, 10, and ¶ 7, Ekhoff dec. (Exh. 6, 48 TTABVUE 59); and

[3] Opposer refers to Fed. R. Civ. P. 31 in connection with the rules governing depositions upon written questions. Opposer is reminded that, pursuant to Trademark Rule 2.116(a), **except as otherwise provided**, and wherever applicable and appropriate, procedure and practice in *inter partes* proceedings shall be governed by the Federal Rules of Civil Procedure (emphasis added). Because Trademark Rules 2.119 and 2.124 address service and depositions upon written questions, the Trademark Rules of Practice, not the Federal Rules of Civil Procedure, apply in this case.

(iv) on January 31, 2023, Opposer provided to Applicant an additional 12 dates on which Dr. Barrett was available for deposition. Ekhoff dec. ¶ 8, 48 TTABVUE 11 (Exh. 7, 48 TTABVUE 61).

Nevertheless, Applicant has never sought to serve an amended notice of deposition. Ekhoff dec. ¶ 9, 48 TTABVUE 11. Instead, Applicant filed the subject motion.

In view of the foregoing, the record shows that Applicant failed to make a good faith effort to resolve the parties' dispute related to the deposition of Opposer's witness prior to filing the subject motion, and there is no showing in Applicant's motion to compel demonstrating otherwise that Applicant made the requisite good faith effort. Accordingly, Applicant's alternative motion to compel is **DENIED**. *See* Trademark Rule 2.120(f)(1).

II. Applicant Prohibited from Filing Additional Pretrial Motions without Board Authorization

Although the Board has denied Applicant's motion to compel, the Board finds it necessary to address the circumstances revealed in the parties' submissions. Simply put, the Board finds that the subject discovery dispute is entirely the result of Applicant's failure to cooperate during discovery and its misunderstanding of the Trademark Rules and how a deposition by written questions is conducted.

For instance, as regards Applicant's objection that Opposer improperly waited until the date of the scheduled deposition to send its objections to the list of questions served on Opposer, this contention is incorrect because Opposer's objections were not untimely. Pursuant to Trademark Rule 2.124(d)(1), Opposer had "**twenty days from**

the date of service of the notice of taking direct examination … [to] serve cross questions upon the party who proposes to take the deposition … Written objections to questions may be served on a party propounding questions" (emphasis added). Because Applicant did not serve Opposer with a complete set of Applicant's proposed questions with the appendices referenced therein until January 6, 2023, 46 TTABVUE 71, 73 and 48 TTABVUE 4, **January 26, 2023** was Opposer's deadline to serve its objections (and/or any cross-examination questions) to Applicant's examination questions. *See* Trademark Rule 2.124(d)(1); *Nahshin v. Prod. Source Int'l, LLC*, 107 USPQ2d 1257, 1259 (TTAB 2013) (discussing depositions upon written questions[4]); and TBMP § 404.07(f). TBMP § 404.07(e) explains the process:

> Within 20 days from the date of service of the notice in accordance with 37 C.F.R. § 2.119(b), any adverse party may serve cross questions on the deposing party. … Within 10 days from the date of service of the cross questions in accordance with 37 C.F.R. § 2.119(b), the deposing party may serve redirect questions on every adverse party. Within 10 days from the date of service of the redirect questions in accordance with 37 C.F.R. § 2.119(b), any party that served cross questions may serve recross questions on the deposing party … Written objections to questions may be served on the party that propounded the questions. … In response to objections, substitute questions may be served on the objecting party within 10 days from the date of service of the objections.

Further, Opposer did not "refuse" to produce Ms. Barrett, as Applicant suggests, 46 TTABVUE 10; rather, Opposer only reserved its objections, which are reserved for

[4] The party taking the deposition serves its notice of taking testimony, accompanied by its written questions, on the adverse party, who then may serve cross-questions and any objections on the party taking the deposition. Redirect questions may then be served, followed by re-cross questions. In response to objections, substitute questions may be served. … Thus, in the normal course of a deposition on written questions, there is no opportunity to object to the responses to any questions until after the deposition is completed. TBMP § 703.02(k) ("Unless waived, objections to questions and answers in depositions on written questions, as in oral depositions, generally are considered by the Board at final hearing.").

trial. 48 TTABVUE 5, 45 TTABVUE 275-295, 49 TTABVUE 15-36. *See* Trademark Rule 2.124(d)(1). Therefore, Applicant's contention that Opposer's response to Applicant's examination questions was improper is also unfounded.

In view of the foregoing, the Board concludes that Applicant's failure to comply with applicable Trademark Rules of Practice in this matter has clearly delayed this proceeding. Further, the subject motion is Applicant's second improper discovery-related motion. *See* 41 TTABVUE.

Applicant is reminded that **strict compliance 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.** *See Hole In 1 Drinks, Inc. v. Lajtay*, 2020 USPQ2d 10020, at *1 (TTAB 2020) (quoting TBMP Section 114.01, and noting that compliance with the Trademark Rules of Practice, and where applicable, the Federal Rules of Civil Procedure and the Federal Rules of Evidence, is required of all parties even those who assume the responsibility and risk of representing themselves). Applicant was advised previously of the Board's expectations in that regard in its order instituting this proceeding issued on March 2, 2021. *See* 2 TTABVUE 3.

The Board will not tolerate any further delay to this proceeding arising from Applicant's failure to adhere to applicable rules. In view thereof, **IT IS ORDERED:** Applicant is **PROHIBITED** from filing any unconsented pretrial motion without the written consent of (including an order issued by) the assigned Interlocutory Attorney. *See Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626, 632 (TTAB 1986)

("the Board [may] exercise its inherent power to control the progress of proceedings before it"). Therefore, should Applicant seek to file another motion before trial, Applicant must contact the assigned Interlocutory Attorney[5] and Opposer's counsel to arrange for an inter partes conference to discuss any proposed motion. *Cf. Carrini Inc. v. Carla Carini S.R.L.*, 57 USPQ2d 1067, 1071 (TTAB 2000) (entering sanctions against both parties for failing to adhere to Board's order stating that no further papers should be filed by either party without prior leave of the Board).

If Applicant fails to comply with the foregoing order, the Board will decline to consider any such motion.

III. Limited Discovery Period Reopened; Proceeding Remains Suspended

Opposer states that it "does not object to the re-opening of the discovery period solely for the purpose of conducting the combined Rule 30(b)(6) deposition of AKA and individual deposition of Dr. Nicole Barrett on a mutually-agreeable date." 48 TTABVUE 3, footnote 1.

In view thereof, Applicant's alternative request that the discovery period be reopened so that it may conduct the Rule 30(b)(6) deposition of Opposer's witness, Dr. Nicole Barrett, is **GRANTED**. *See* Trademark Rules 2.124(d)(2) and 2.127(a). Accordingly, as of the mailing date of this order, the discovery period is hereby **reopened** for the sole purpose of conducting that deposition.

Applicant must advise the Board within **TWENTY DAYS** of the completion of the deposition on written questions of said completion so that the Board can resume

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proceedings and reset dates. During the suspension of this proceeding, the parties should not file any submission that is not germane to the above-referenced discovery deposition on written questions.

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