

UNITED STATES PATENT AND TRADEMARK OFFICE
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September 22, 2022

Opposition No. 91273187

Pacific Sunwear of California, LLC

v.

Pashun Products Ltd.

Before Wolfson, Goodman and Hudis,
Administrative Trademark Judges.

By the Board:

This case now comes up for consideration of Opposer's renewed motion (filed June 21, 2022, 18 TTABVUE) for default judgment in view of Applicant's failure to obtain United States counsel and to establish representation by that counsel.¹ The motion has been fully briefed.

Applicant's domicile is located in Great Britain. Applicant therefore must be represented by a United States attorney in this proceeding. *See* Trademark Rule 2.11(a), 37 C.F.R. § 2.11(a).

Following the withdrawal of Applicant's attorney as counsel on February 22, 2022 (9 TTABVUE), the Board, in a March 21, 2022 order (11 TTABVUE), allowed Applicant until April 20, 2022 to obtain United States counsel and to establish

¹ Pursuant to the Board's June 22, 2022 order (19 TTABVUE), Opposer's original motion for default judgment (17 TTABVUE) will receive no consideration.

representation by that counsel. Applicant has sought, and received, two extensions of time within which to comply with the Board's order. First, on April 17, 2022, Applicant filed a motion to extend its time to comply with the Board's March 21, 2022 order (12 TTABVUE) by fourteen days, which the Board granted on April 19, 2022 (13 TTABVUE). Next, on May 3, 2022, Applicant filed a motion to extend its time to comply with the Board's March 21, 2022 order (14 TTABVUE) by seven days, which the Board granted on May 9, 2022 (16 TTABVUE). Accordingly, Applicant's compliance with the Board's March 21, 2022 order was last due on May 16, 2022. Applicant has yet to comply with the Board's order.

In support of its motion for default judgment, Opposer contends that Applicant is in default for failure to comply with the Board's March 21, 2022 order. Opposer therefore asks, pursuant to Fed. R. Civ. P. 37(b)(2), that a default judgment be entered herein.

In response, Applicant contends that it has contacted "[m]ultiple paid lawyers," but has been "unable to find a suitable attorney of suitable experience and cost in good time." 20 TTABVUE 2. Applicant further contends that it has contacted "[m]ultiple suitable university law departments recommended by USPTO under the Law School Clinic Certification Program," but none of those programs were able to take its case "due to them receiving the request outside their semesters, or being inundated with requests." 20 TTABVUE 3. Applicant also contends that it contacted the International Trademark Association's pro bono clearinghouse, but was unable to obtain representation in time. 20 TTABVUE 3. Accordingly, Applicant asks that the

Board “[e]xtend time to allow a further opportunity for [Applicant] to acquire an attorney from one of the aforementioned organizations[, e.g.,] during a semester when services are available” or deny Opposer’s motion because “no proof of trademark infringement has been presented and it would be unjust.” 20 TTABVUE 4.

In reply, Opposer contends that, because Applicant still has not appointed United States counsel, entry of judgment is appropriate under Trademark Rule 2.120(h)(1), 37 C.F.R. § 2.120(h)(1). 21 TTABVUE 3.

Opposer’s reliance upon Fed. R. Civ. P. 37(b)(2) and Trademark Rule 2.120(h)(1) in support of its motion is inappropriate. Those rules provide for sanctions in connection with disclosure and discovery matters and are inapplicable to the present circumstances.

Likewise, Applicant’s argument that the Board should deny Opposer’s motion for failure to prove infringement is also inappropriate. To begin, this proceeding is concerned solely with Applicant’s right to register its involved mark. *See* TBMP § 102.01. The Board does not have authority to decide infringement issues. *See Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1771 n.5 (TTAB 1994). Moreover, the parties have completed only the pleading stage of this case. Whether Opposer can prevail on its claim is a matter for resolution after introduction of evidence at trial, or in connection with a properly filed motion for summary judgment. *See Focus 21 Int’l Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1318 (TTAB 1992).

On the other hand, Trademark Rule 2.11(a) **requires** parties domiciled outside of the United States or its territories, such as Applicant, to be represented by United States counsel. Applicant has been aware of this requirement throughout this proceeding. 2 TTABVUE 6. Six months have passed since the issuance of the Board's March 21, 2022 order. Applicant still has not obtained United States counsel to represent it in this proceeding. Opposer is entitled to have this proceeding go forward on the merits without undue delay. Because Applicant provides examples of its ongoing efforts to obtain representation by United States counsel, however, we find that imposition of a sanction in the form of entry of default judgment for failure to comply with Rule 2.11(a) would be an unduly harsh remedy at this time. Therefore, Opposer's motion for default judgment is hereby denied.

Applicant is allowed until **October 31, 2022** to comply with the Board's March 21, 2022 order. That is, Applicant must retain the services of a United States attorney who will enter an appearance on Applicant's behalf in this Opposition. Applicant's appointed attorney must, when making their appearance, provide to the Board the attorney's date and state or territory of admission and bar license number and indicate that the attorney is in good standing in that state or territory.² See Trademark Rule 2.17(b)(3), 37 C.F.R. § 2.17(b)(3). **Applicant will not be permitted**

² An attorney can enter an appearance by filing, in ESTTA, either 1) the Appearance of Counsel/Power of Attorney form, which requires a written power of attorney signed by the party the attorney represents; or 2) a document (e.g. motion, brief) that satisfactorily identifies the individual as attorney for the party AND the Change of Address form wherein the bar information is required. The bar info entered on the Change of Address form will be masked from TTABVUE.

any extensions of time to comply without first obtaining and filing with the Board Opposer's written consent thereto.

The burden of complying with this order lies with Applicant. If Applicant does not comply, judgment will be entered against it upon motion by Opposer. Cf. *Unicut Corp. v. Unicut, Inc.*, 222 USPQ 341, 343-44 (TTAB 1984) (entry of judgment as a sanction for repeated noncompliance with Board discovery orders).

Except as noted in the foregoing, proceedings herein remain **suspended**.