

ESTTA Tracking number: **ESTTA730353**

Filing date: **02/29/2016**

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

Proceeding	92053315
Party	Plaintiff American University
Correspondence Address	EDWARD W GRAY JR FITCH EVEN TABIN FLANNERY 120 S LASALLE ST STE 1600 CHICAGO, IL 60603 UNITED STATES trademark@fitcheven.com, asimmons@fitcheven.com
Submission	Motion for Sanctions
Filer's Name	Alisa C. Simmons
Filer's e-mail	trademark@fitcheven.com, asimmons@fitcheven.com
Signature	/Alisa Simmons/
Date	02/29/2016
Attachments	Feb 29 2016 Motion for Sanctions Due to Respondent's Failure to Comply with Board Order and to Suspend.pdf(67265 bytes )

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

American University,

Petitioner,

v.

CANCELLATION NO. 92053315

The American University for Science and  
Technology

Respondent.

---

Supplemental Reg. No. 3836388

**PETITIONER’S MOTION FOR SANCTIONS  
DUE TO RESPONDENT’S FAILURE TO COMPLY WITH BOARD ORDER AND TO SUSPEND**

Petitioner, American University (“Petitioner”), by and through its counsel, hereby moves pursuant to 37 C.F.R. 2.120(g) and TBMP §527.01 for an order striking the answer of Respondent The American University for Science and Technology (“Respondent”) and entering judgment against Respondent as sanctions for Respondent’s repeated failure to comply with the Rules of this Board, as well as expressly disregarding the Board’s December 30, 2015, Discovery Order (“Order”). In the alternative, Petitioner moves for an order designating that certain facts be taken as established for purposes of this action, prohibiting the Respondent from supporting or opposing designated claims and defenses, and prohibiting the Respondent from introducing designated matters in evidence. Because this motion constitutes a potentially dispositive motion depending upon the relief to be afforded by the Board, the Petitioner respectfully requests that the Board suspend this proceeding pending the disposition of this motion. In support of its motion, Petitioner states as follows.

**I. Background and the Board's December 30, 2015 Order to Respondent to Respond to Petitioner's Discovery Requests.**

Petitioner American University is a Congressionally chartered, non-profit corporation which, for more than one hundred years, provides undergraduate and graduate level education services in the fields of politics, science, history, languages, computer technology, math, arts, and music. Petitioner American University owns U.S. Registration No. 4774583 for its AMERICAN UNIVERSITY trademark for education services, as well as for use on other goods and services. Petitioner American University filed the Petition to Cancel the Respondent's Supplemental Registration No. 3836388 for the mark THE AMERICAN UNIVERSITY FOR SCIENCE AND TECHNOLOGY for, "Education services, namely, providing courses of instruction at the graduate level," on the basis of a likelihood of confusion with American University's AMERICAN UNIVERSITY trademark, as well as on the grounds of dilution, failure to make a lawful use of the mark, fraud, void ab initio, and abandonment (Docket No. 46).

On April 7, 2015, Petitioner served on Respondent its Second Set of Interrogatories to Defendant, its Second Set of Document Requests to Defendant, and its Second Set of Requests for Admission to Defendant. The Petitioner served these discovery requests, following the March 13, 2015, consolidated discovery deposition of Respondent's principal and 30(b)(6) designee, to clarify, learn, and identify more relevant facts and information from the Respondent about its customers and students, its service offerings, its use of affiliates to provide its service offerings, its authority to operate as a non-accredited degree granting institution in California, its faculty, board, and staff, and its advertising of its service offerings.

Because of service by first class mail, the Respondent's answers and responses to the second sets of Interrogatories, Document Requests, and Requests for Admission were due May 12, 2015. As set forth in Docket No. 55, the Respondent failed to respond in any manner to the Petitioner's second set of discovery requests or to any communications from Petitioner's counsel. Consequently, on November 19, 2015, Petitioner was forced to file a motion to compel discovery responses from the Respondent (Docket No. 55). The Respondent conceded the motion to compel and filed no response with the Board. On December 30, 2015, the Board issued an Order granting Petitioner's motion to compel, giving the Respondent another thirty days, or until January 29, 2016, to serve upon Petitioner complete responses to Petitioner's Second Set of Interrogatories and Petitioner's Second Set of Document Requests, without objections on the merits (Docket No. 57). The December 30, 2015 Order ("Order") also noted that both sets of the Petitioner's Requests for Admission are deemed admitted by the Respondent by operation of Fed. R. Civ. P. 36(a).

## **II. The Respondent Failed to Comply with the Board's December 30, 2015 Order.**

The Respondent has violated the Order and failed to serve upon Petitioner any responses to Petitioner's Second Set of Interrogatories and Petitioner's Second Set of Document Requests by the January 29, 2016 deadline. The Respondent has not requested of the Petitioner, nor has it sought from the Board, an extension of time to comply with the Order. Petitioner has consistently demonstrated tolerance for the failure of the Respondent in this proceeding and given the Respondent great leniency. However, the Petitioner's trial period now opens on March 1, 2016, and Petitioner still has been prevented from obtaining the discovery to which it is entitled. The Petitioner should have the opportunity to rely on the Respondent's answers to its

interrogatories and responses to its document requests for purposes of trial. Doing so, however, is not possible because the Respondent has not complied with the Board's Order.

In this proceeding, the Board and the Petitioner have taken many steps to accommodate the Respondent, which has chosen to represent itself pro se. While the Respondent is not an attorney, the time is now well past to continue to allow that fact to be the reason to let the Respondent or its pro se representative skirt the Board's orders or the Trademark Rules.

### **III. Argument**

Failure to comply with a discovery order of the Board enables the Board to enter appropriate sanctions against the disobedient party. 37 C.F.R. 2.120(g)(1). These sanctions may include: (1) entering judgment against the disobedient party, (2) striking all or part of the pleadings of the disobedient party, (3) prohibiting the disobedient party from supporting or opposing designated claims or defenses, (4) drawing adverse inferences against the uncooperative party, and (5) prohibiting the disobedient party from introducing designated matters in evidence. *Id.*; TBMP §527.01. Therefore, under 37 C.F.R. 2.120(g) and TBMP §527.01, the Board has the authority to strike the Respondent's pleadings and to enter judgment against the Respondent for failure to comply with its Order. *Super Bakery Inc. v. Benedict*, 96 USPQ 2d 1134, 1136 (TTAB 2010) (entering default judgment against Respondent for failure to comply with the Board's order to respond to discovery requests and with Board's discovery rules and orders), *aff'd, Benedict v. Super Bakery, Inc.*, 101 USPQ 2d 1089, 1092-93 (Fed. Cir. 2011) (affirming Board's entry of default judgment against Respondent for failure to comply with the Board's discovery orders); *MHW Ltd. v. Simex Aussenhandelsgesellschaft Savelsberg KG*, 59 USPQ 2d 1477, 1478-79 (TTAB 2001) (entering default judgment against oppose for failure to comply with order to respond to discovery requests and for setting up obstacles to applicant's

receipt of relevant information); *Caterpillar Tractor Co. v. Catfish Anglers Together, Inc.*, 194 USPQ 99, 100 (TTAB 1977) (sanctions of default judgment entered against applicant for failure to comply with order to respond to discovery requests and for providing no reason for its failure to do so.)

The Respondent clearly failed to comply with the Order. Because the Respondent has not complied, the Petitioner and the Board are left to presume that the Respondent may have abandoned interest in this proceeding, as well as the underlying challenged Supplemental registration. If the Respondent has abandoned this case, the Petitioner submits that it should not have to go through the expense and effort of a trial just because the Respondent filed an answer to the amended petition for cancellation prior to deciding to abandon its registration.

The Respondent's deliberate inaction and choice not to serve responses to the discovery requests as ordered by the Board illustrates that the Respondent has no intention of complying with the Board's Order or its discovery obligations in this proceeding. As a result, the Board should sanction the Respondent by striking its answer filed on November 18, 2015, and then entering judgment in Petitioner's favor pursuant to 37 C.F.R. 2.120(g) and TBMP §527.01.

In its most recent Order, the Board advised and cautioned the Respondent that its failure to comply with the Order may subject the Respondent to this very type of sanction. On numerous other occasions the Board also informed and cautioned the Respondent that it must comply with the Board's directives and deadlines and with the Trademark Rules of Practice, including, where applicable, the Federal Rules of Civil Procedure. During the November 17, 2015 telephone discussion conducted by the assigned Interlocutory Attorney with the parties' representatives, the Interlocutory Attorney personally reminded the Respondent of these requirements and obligations. In its December 8, 2015 Order, memorializing the November 17

telephone discussion and ordering the Respondent to answer the amended petition for cancellation, the Board advised the Respondent that it is "...expected to fully comply with the directives and the deadlines set by this order...failure to do so could result in the entry of judgment against Respondent." (Docket No. 56). In its August 31, 2015 Order (granting Petitioner's motion to amend its petition for cancellation), the Board also cautioned that while the Respondent could represent itself in this case, "strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, is expected." (Docket No. 49). The Respondent violated the Board's Order and repeatedly disregards the Trademark Rules in its filings before the Board. The Board has repeatedly informed and advised the Respondent that it is not to file responses to discovery requests with the Board, yet the Respondent continues to file its woefully inadequate responses with the Board.

In its August 31, 2015 Order, the Board specifically explained to the Respondent that the Respondent should not file responses to written discovery requests with the Board. (Docket No. 49.) In footnote 1 of its February 24, 2015 Order requiring the Respondent to produce its witness for discovery depositions, the Board previously cautioned the Respondent "that written discovery requests or responses, including the production of responsive documents, should not be filed with the Board..." citing the relevant Trademark Rule and explaining that the Respondent's submissions "are not considered part of the record and will be given no consideration unless filed at the appropriate time." (Docket No. 42.) Both of these explanations followed the Board's previous explanation of this same issue in footnote 2 of its September 2, 2014 Order (Docket No. 40).

Despite these repeated explanations by the Board about how to respond to discovery requests, the Respondent again filed non-responsive discovery documents with the Board on

January 28, 2016, *while not serving or providing them to date to the Petitioner.* (Docket No. 58.) These materials provided by the Respondent only to the Board are late responses to Petitioner's Second Set of Requests for Admission (which, as noted in footnote 3 of the December 30, 2015 Order, were already deemed as admitted) and entirely incomplete and late answers to the Petitioner's Second Set of Document Requests to Defendant. The January 28, 2016 filing includes no responses to the Petitioner's Second Set of Interrogatories to the Defendant. The Petitioner only became aware of the January 28, 2016 filing by the Respondent with the Board in the Petitioner's independent review of the online records of this proceeding. This further illustrates the Respondent's continued unwillingness to cooperate and follow the Board's Order and the Trademark Rules, while continuing to unreasonably burden the Petitioner. With this filing, the Respondent ignores the Board's repeated earlier explanations and instructions and makes misrepresentations about its service of such documents on Petitioner.<sup>1</sup>

The Petitioner also respectfully submits that even if the January 28, 2016 filing was intended by the Respondent to be discovery responses the filing is confusing and woefully inadequate and incomplete, following none of the Trademark Rules or Federal Rules of Civil Procedure for responding to discovery requests. The filing demonstrates the Respondent's continued and deliberate disregard for the Trademark Rules and Federal Rules of Civil Procedure, including Rules 33 and 34, as well as TBMP Sections 405 and 406. Obvious additional shortcomings are the Respondent's not serving the documents on the Petitioner despite contrary representations in the certificates of service on such documents.

---

<sup>1</sup> Petitioner notes discrepancies in the certificates of service for the Respondent's January 28, 2016 filing of Docket No. 58. The certificates of service are dated January 27, 2016, but the Respondent did not file Docket No. 58 with the Board until January 28, 2016. Also, in Docket No. 58, the Respondent indicated service by email in one instance (though Respondent did not send a corresponding email to Petitioner and Petitioner had granted no consent to service by email of discovery responses, nor had the Respondent sought such agreement). The Respondent indicated service by mail in another instance (though Respondent included no mailing address in that certificate indicating to where that service copy was allegedly mailed).



Respondent cannot pick and choose what facts and documentary evidence it makes available to the Petitioner in this case. Permitting the Respondent to continue to behave and act in this manner is entirely unfair to the Board and to the Petitioner. During the March 13, 2015 discovery deposition of the principal of the Respondent (a deposition that Petitioner had to pursue a motion to compel and resulting Board order even to take), the Respondent testified to not providing services to students in the U.S. and to using affiliates to provide services to students residing in foreign countries. That deposition necessitated the Petitioner to issue second sets of interrogatories, document requests, and requests for admission to obtain the facts supporting the Petition for Cancellation.

Not complying with the Board's Order and concealing relevant facts and evidence fairly requested by the Petitioner via discovery mechanisms, the Respondent is deliberately acting unfairly and with utter disregard of the Trademark Rules. The Respondent's continued elusive actions delay and halt discovery in this case and hinder and prevent the Petitioner from creating and building an evidentiary record on which the parties and the Board may rely. The consequence of the Respondent's actions clearly prejudice the Petitioner. Without adequate discovery responses, Petitioner cannot prepare adequately for trial. The Respondent's actions and lack of cooperation, despite the Petitioner's counsel's past efforts to point out the Trademark Rules to the Respondent and all of the Board's previous guidance and direction provided directly to the Respondent, increase the cost and resources that the Petitioner and the Board must put towards this case. Because the Respondent violated the Board's order and regularly disregards the Board's directives and the Trademark Rules, the Petitioner respectfully requests and moves that the Board strike the Respondent's answer and enter judgment in favor of the Petitioner.

At a minimum, the Respondent should be precluded from offering evidence at trial on the factual issues which it has been found to be delinquent in its discovery responses, including its customers and students, its service offerings, its use of affiliates to provide its service offerings, its authority to operate as a non-accredited degree granting institution in California, its faculty, board, and staff, and its advertising of its service offerings. *HighBeam Marketing LLC v. Highbeam Research LLC*, 85 USPQ 2d 1902, 1905 (TTAB 2008) (entering evidentiary sanctions against opposer for failure to comply with discovery order, precluding from use as evidence at trial any information related to certain facts in its possession, custody and control that were not produced prior to applicant's filing of its motion for discovery sanctions). Further, because the Respondent provided no responses as to the discovery requests seeking confirmation of its authority to operate as a non-accredited degree granting institution in California and its use of affiliates to provide its service offerings and because the Respondent offered no contrary information, the Board should order a presumption that the Respondent is not authorized to operate as a non-accredited degree granting institution in California and that the Respondent has no affiliates that aid with the Respondent's providing of its service offerings. Similarly, because the Respondent provided no responses to the discovery requests seeking confirmation of the geographic locations of its students, as well as representative customer and student names and locations and because the Respondent offered no contrary information, the Board should order a presumption that the Respondent has no customers or students. The Board should also order that the Respondent is prohibited from introducing evidence contrary to these presumptions.

Finally, because this motion constitutes a potentially dispositive motion, Petitioner respectfully requests that the Board suspend this proceeding pending the disposition of this motion and reset the proceeding schedule, if necessary, after ruling on this motion.

#### **IV. Conclusion**

The Respondent's refusal to obey the Board's Order, the Board's directions, or the Trademark Rules amply justifies striking the Respondent's answer and granting judgment in favor of the Petitioner. Alternatively, the Respondent should be precluded from offering evidence on the factual issues on which the Petitioner sought further discovery. The Petitioner also respectfully requests that the Board suspend this proceeding pending the disposition of this motion and reset the proceeding schedule, if necessary, after ruling on this motion.

Respectfully submitted,

February 29, 2016

By: s/Alisa C. Simmons/  
Alisa C. Simmons  
FITCH, EVEN, TABIN & FLANNERY  
120 South LaSalle Street, Suite 1600  
Chicago, Illinois 60603-3406  
Telephone: 312.577.7000  
Facsimile: 312.577.7007

*Attorneys for Petitioner*

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing *Petitioner's Motion for Sanctions Due to Respondent's Failure to Comply with Board Order and to Suspend* was served via first class mail, postage paid, upon:

Dr. M.A. Wahab  
The American University for Science and Technology  
18345 Ventura Blvd, Suite 210  
Tarzana, CA 91356

on this 29<sup>th</sup> day of February, 2016.

s/Alisa Simmons/  
Alisa C. Simmons  
FITCH, EVEN, TABIN & FLANNERY  
120 South LaSalle Street, Suite 1600  
Chicago, Illinois 60603-3406  
Telephone: 312.577.7000  
Facsimile: 312.577.7007

*Attorneys for Opposer*