

**THIS OPINION IS A
PRECEDENT OF THE TTAB**

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

BUO

Mailed: February 28, 2014

Cancellation No. 92055787

Patagonia, Inc.

v.

Joseph Azzolini

**Before Quinn, Mermelstein and Adlin, Administrative Trademark
Judges.**

By the Board:

On June 10, 2013, the Board issued an order requiring respondent to show cause why judgment should not be entered against him as a sanction for his failure to attend the discovery conference required by Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2). We now consider respondent's response.

As background, this proceeding was instituted on June 28, 2012, after Patagonia, Inc. ("petitioner") filed a petition to cancel respondent's Registration No. 3424446 for the mark EL CAP.¹ Respondent's answer was due on August 7, 2012. On August 1, 2012, *pro se* respondent filed a poorly-supported motion for a sixty-day extension of time to answer the petition for

¹ Issued May 6, 2008, from an application filed March 13, 2006, for goods identified as "[c]lothing, namely, hats, shirts, tops, pants, shorts, bottoms, and jackets." The word "CAP" is disclaimed apart from the mark as shown.

Cancellation No. 92055787

cancellation due to respondent being “on vacation and ... returning at the end of August.” However, the paper was not accompanied by a certificate of service. Respondent re-filed the motion on August 6, 2012, this time with the requisite certificate of service and petitioner opposed the motion. The Board determined that it would be appropriate to resolve the motion by way of teleconference and contacted both parties to identify possible dates and times to conduct the conference. In its order of September 11, 2012, the Board noted respondent’s lack of responsiveness, uncooperative behavior, and “refusal to comply with clear Board instructions to arrange a teleconference,” and ultimately denied respondent the requested *sixty-day* extension for failure to show good cause for such an extension. Order, pp. 2-3. The Board informed respondent that his continued failure to comply with Board orders and rules would not be excused by his decision to not retain counsel. Order, p. 2. Respondent was then allowed until September 20, 2012, to file an answer.

Between October 2012 and January 2013, the Board issued three additional orders attempting to move the proceeding forward, respondent having not yet filed his answer to the petition for cancellation.²

² More specifically, on October 9, 2012, the Board issued an order for respondent to show cause why default judgment should not be entered against him pursuant to Fed. R. Civ. P. 55(b). On November 8, 2012, respondent filed a response to the show cause order in the form of a letter from a doctor’s office indicating that respondent was not in condition to file an answer due to a recent surgery. The letter, however, indicated that respondent would be in condition to respond by November 20, 2012. Respondent again failed to forward a service copy of this paper, despite prior Board warnings in orders dated August 3, 2012 and September 11, 2012. On December 7, 2012, the Board issued an order construing respondent’s filing as a motion to set aside default and forwarded a copy of respondent’s

Cancellation No. 92055787

In its January 25, 2013, order, the Board informed respondent that it was troubled by what appeared to be a pattern of delay. The Board noted that respondent had up to that point been unresponsive and continued to ignore the Board's orders to send service copies of his papers to petitioner.

Notwithstanding respondent's conduct, the Board once again reset respondent's time in which to file his answer, and finally, on February 24, 2013, respondent filed his answer. However, respondent again failed to attach the required certificate of service, and only belatedly and in response to the Board's issuance of a notice of default³ did respondent serve the answer (on March 26, 2013) and file a certificate of service (on April 1, 2013). The Board accepted respondent's answer as his pleading on April 24, 2013, and reset the conferencing, disclosure, discovery and trial dates, making May 24, 2013, the deadline to conduct the discovery conference mandated by Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2).

By written submission on May 10, 2013, petitioner requested that a Board interlocutory attorney participate in the discovery conference. The

filing to petitioner. Petitioner did not file a response to the filing, and respondent's motion was granted as conceded on January 25, 2013. Trademark Rule 2.127(a).

In the meantime, on December 21, 2012, respondent filed, but again failed to serve, yet another request for an extension of an unspecified amount of time to file an answer, based on a duplicate of the doctor's letter that was attached to respondent's November 8, 2012, filing. Again, that doctor's letter indicated that respondent would be able to participate in this proceeding by November 20, 2012, i.e. a date long prior to the filing date of respondent's second motion seeking an extension based on the same letter.

³ Notice of default issued March 21, 2013, allowing respondent thirty days to file a certificate of service, failing which "judgment [would] be entered against respondent, and the subject registration [would] be cancelled."

Cancellation No. 92055787

assigned Board interlocutory attorney contacted the parties by email advising them of his availability during the week of May 20-24 and requested that the parties confer and determine a mutually agreeable time to conduct the conference from among several potential dates and times.⁴ In an email dated Tuesday, May 21, 2013, respondent replied to the interlocutory attorney's email, stating that he had "informed and agreed to May 24th Thursday at 11:00am for the conference call" (emphasis added).⁵

The Board attempted to contact both parties on Thursday, May 23, 2013, at respondent's proposed time of 11:00 a.m. While petitioner's counsel was contacted, respondent could not be reached.⁶ Later, at 8:34 p.m. on May 23, petitioner's counsel sent respondent an email stating that he would "make [him]self available all day [Friday, the following day] during regular business hours ... to speak with [respondent]."⁷

⁴ As a general rule, the Board does not accept email from the parties; however, a rare exception is made to facilitate the procedural matter of setting-up telephone conferences. In any event, any direct email communication between the parties and the Board must be initiated by the Board. Any such communication not initiated by the Board may not be considered. Parties would be well advised to file all communication with the Board through the Board's ESTTA filing system.

⁵ May 24, 2013, actually fell on Friday. For that reason, both petitioner's counsel and the Board interlocutory attorney sent responsive emails to respondent seeking to clarify whether respondent intended the conference to be held on Thursday May 23 or Friday May 24, with both their emails interpreting respondent's email as intending the conference to be held on Thursday, May 23. Respondent failed to respond to the emails.

⁶ Petitioner's counsel and the interlocutory attorney made several more attempts on May 23 to contact respondent, to no avail.

⁷ Although the interlocutory attorney's initial email made clear that his schedule would only allow his participation in a conference held between the hours of 9:00 a.m. and 11:30 a.m. on Friday, May 24, petitioner's May 23 email indicated his desire to hold the conference on that day even if the Board was not available to participate.

Cancellation No. 92055787

The interlocutory attorney sent both parties an email at 10:10 p.m. on May 23, stating that the parties would be required to conduct the conference regardless of whether the Board participated and that the parties should inform the Board of the “status of the discovery conference by email tomorrow,” i.e., Friday, and “update [the Board] by days-end as to whether the conference was conducted and any stipulations that may have been reached.” At 8:54 a.m. on May 24, respondent sent an email to petitioner’s counsel and the interlocutory attorney “apologiz[ing] for any confusion [he] may have caused.” Respondent indicated that he would confer with petitioner’s counsel and conduct “the discovery conference at [petitioner’s] convenience” that day sometime after 12:00 p.m.

Notwithstanding respondent’s latest agreement to conference, on the evening of Friday, May 24, 2013, petitioner’s counsel sent an email to the Board, copying respondent, stating that:

Unfortunately, I was not able to reach [respondent] today to conduct the discovery conference. I tried to contact him four times at the cell phone number he provided ... the earliest at 10:30 am PST, the last just recently at 4:45 PST. I also sent two emails trying to contact him today, at 10:35 and 2:45, in addition to this email.

Despite the trouble with scheduling the discovery conference, petitioner made yet another offer to conference, stating:

though the Board’s rules require a discovery conference by today’s date, I remain willing to schedule a conference with you as soon as possible provided that you (a) set the time, and (b) contact me to initiate the conference. I will be available next

Cancellation No. 92055787

Tuesday, and should be responsive to email over the holiday weekend.

On Tuesday, May 28, 2013, respondent sent an email to the interlocutory attorney, once again failing to copy petitioner's counsel, informing the Board that:

On Friday May 24th, I went up to the Pocono Mountains, PA for Memorial Day Weekend. At about 1pm [sic] just upon arriving there, I was speaking on the phone with someone and lost connection. When attempting to redial, my phone service was not available in that area. I couldn't even listen to the voicemail Mr. Bromaghim left. To make matters worse. [sic] When I came home this morning I realized that I had left my phone there.

Respondent did not contact petitioner to reschedule the discovery conference, nor did he respond to petitioner's offer in any respect.

Trademark Rule 2.120(g)(1) provides:

[i]f a party fails to participate in the required discovery conference ... the Board may make any appropriate order, including those provided in Rule 37(b)(2) of the Federal Rules of Civil Procedure, except that the Board will not hold any person in contempt or award expenses to any party.

The referenced Federal Rule allows entry of a variety of sanctions including "dismissing the action or proceeding in whole or in part." Fed. R. Civ. P.

37(b)(2)(A)(v).⁸

Noting respondent's history of ignoring Board orders and making this case more difficult than necessary, the Board issued another notice of default

⁸ Moreover, the Board has the authority to control the disposition of cases on its docket, which necessarily includes the inherent power to enter sanctions. *See Carrini Inc. v. Carla Carini S.R.L.*, 57 USPQ2d 1067, 1071 (TTAB 2000) (citing *In re Bailey*, 182 F.3d 860, 864-65 (Fed. Cir. 1999) (Court of Appeals for Veterans Claims (a non-Article III tribunal) has inherent power to discipline attorneys practicing before it)).

Cancellation No. 92055787

on June 10, 2013, allowing respondent thirty days to show cause why default judgment should not be entered against him for failure to participate in the mandatory discovery conference.

In response to the Board's order, respondent argues that "[i]t's patently inequitable to issue a Notice of Default on [his] trademark on the basis of communications confusement [sic] not of [his] own making." Respondent explains that "May 24, as we all know – and knew - was Memorial Day Weekend this past year. My family and I had a long-planned three-day trip scheduled to Blue Mountain Lake, Pennsylvania." Respondent also takes exception to the interlocutory attorney's "*sua sponte* ruling" in issuing the show cause order.

Though Board participation may be requested, it is the responsibility of the parties to ensure that a discovery conference takes place by the assigned deadline. *Guthy-Renker Corp. v. Boyd*, 88 USPQ2d 1701, 1703 (TTAB 2008). The parties carry this burden mutually. *Influence Inc. v. Zuker*, 88 USPQ2d 1859, 1860 n.2 (TTAB 2008).

Here, the record establishes that petitioner met its burden by: 1) timely requesting Board participation in the conference;⁹ 2) participating in emails to set-up the conference, making its counsel available on both May 23 and May 24, and attempting on both days to reach respondent; and 3) offering to hold the conference on Tuesday, May 28, 2013, if respondent

⁹ Trademark Rule 2.120(a)(2) provides that a party may request Board participation in the conference "after answer but no later than ten days prior to the deadline for the conference."

Cancellation No. 92055787

would simply set the time and contact petitioner's counsel to initiate the conference. In *Guthy-Renker*, 88 USPQ2d at 1703-04 (TTAB 2008), the Board found that applicant failed to discharge its burden in its "lackluster" attempts at scheduling and conducting the required conference, but that opposer could have mitigated the prejudice it allegedly suffered by requesting Board participation. In this case, by contrast, petitioner has not only requested Board participation in a timely manner, it has made a number of efforts to contact respondent and has remained flexible in scheduling the conference despite respondent's making things quite difficult for petitioner and the Board.

Respondent has been, to say the least, much less diligent. In fact, respondent has unfortunately continued what is by now a longstanding pattern of dilatory behavior, cavalier disregard for the time and resources of the Board and opposing counsel, and flouting of Board rules. Both the Board and petitioner have bent over backwards to provide respondent with multiple opportunities to comply with the applicable rules and requirements. In return, respondent — on those occasions when he has bothered to offer any explanation — has offered a series of mostly unsupported excuses which, to put it mildly, strain credulity.

Respondent chose the date and time initially set to conduct the conference — "May 24th Thursday at 11:00am." Although the date may have been stated in error and created one cause of confusion, petitioner and the

Cancellation No. 92055787

assigned Board interlocutory attorney attempted to clarify the date and conduct the conference, leaving several voicemail messages and sending emails to respondent spanning normal business hours and into the evening on Thursday, May 23. Notwithstanding any potential confusion over the date, petitioner's counsel made himself available on *both* dates, extending his efforts until the evening of Friday, May 24, and thereafter. It is quite clear, considering respondent's statements that Friday, May 24 was Memorial Day Weekend, and that his family had a "long-planned" trip scheduled to occur on that date, that he meant Thursday, May 23 when he set the date and time for the conference, a conference that he failed to attend. Even if we were to assume that respondent did, in fact, intend for the conference to be held on Friday, May 24, that is the day *he chose*.

Pro se or not, respondent, as he has been repeatedly warned, bears responsibility for following the rules and Board requirements, including the schedule set by the Board. The Board has patiently informed respondent of his obligations many times, but our patience is now exhausted.

Respondent complains that it was inappropriate for the Board to issue a show cause order *sua sponte*. Under Trademark Rule 2.120(g)(1), "[i]f a party fails to participate in the required discovery conference, ... the Board may make any appropriate order, including those provided in Rule 37(b)(2) of the Federal Rules of Civil Procedure." The Board need not first issue an order compelling participation in the discovery conference. *Kairos Inst. of*

Cancellation No. 92055787

Sound Healing LLC v. Doolittle Gardens LLC, 88 USPQ2d 1541, 1543 n.4 (TTAB 2008). Further, by issuing the June 10, 2013 order to show cause, the Board gave respondent notice of our intention to impose sanctions and gave him an opportunity to respond prior to entry of any sanctions. The Board thus acted within its authority to issue the show cause order *sua sponte* and respondent has had ample notice and an opportunity to be heard on the issue.

After careful consideration of respondent's arguments and explanations, in light of respondent's failure to participate in the required discovery conference, and given the continuing nature of respondent's violations despite multiple prior admonitions from the Board, we conclude that any sanction short of judgment would be futile and unfair to petitioner, which brought this case well over a year ago and has been unable, despite diligent efforts, to move it forward, due to respondent's intransigence. See *Benedict v. Super Bakery Inc.*, 665 F.3d 1263, 101 USPQ2d 1089 (Fed. Cir. 2011) (Board appropriately entered judgment where respondent repeatedly failed to respond to petitioner's discovery requests and Board's discovery orders, since record supported Board's finding that respondent would not comply with his discovery obligations if given additional opportunities to do so); *MySpace Inc. v. Mitchell*, 91 USPQ2d 1060 (TTAB 2009) (petition for cancellation granted as sanction where respondent engaged in a course of delay, failing to comply with discovery requests and disregarding a Board order compelling responses to those discovery requests); *MHW Ltd. v. Simex*,

Cancellation No. 92055787

Aussenhandelsgesellschaft Savelsberg KG, 59 USPQ2d 1477 (TTAB 2000) (review of the record revealed that opposer had been engaged in dilatory tactics, including the willful disregard of the Board's orders resulting in an entry of judgment as a sanction); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848 (TTAB 2000) (judgment entered against applicant for engaging in a pattern of dilatory tactics and having willfully failed to comply with Board discovery order); *Unicut Corp. v. Unicut, Inc.*, 222 USPQ 341 (TTAB 1984) (Board noted that entry of judgment as a sanction, while harsh, was justified where no less drastic remedy would be effective).

Respondent's latest filing simply fails to establish good cause for not entering the sanction of judgment. Therefore, the sanction of judgment is hereby entered against respondent, the petition to cancel is **GRANTED**, and Registration No. 3424446 will be cancelled in due course. *See* Fed. R. Civ. P. 37(b)(2)(A)(v), and Trademark Rule 2.120(g).