

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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Mailed: April 12, 2015

Cancellation No. 92057510

*Consuelo Ongpauco Cauton*

*v.*

*Barrio Fiesta International, Inc.*

Before Bucher, Zervas, and Hightower, Administrative Trademark Judges:

By the Board:

This case comes up on Petitioner's motion, filed October 21, 2014, for judgment as a discovery sanction. The motion has been fully briefed.

On September 1, 1992, Reg. No. 1712454 issued to Barrio Fiesta International, Inc. for the mark for the mark shown at right for restaurant services.



On July 9, 2013, Consuelo Ongpauco Cauton filed a petition to cancel Registration No. 1712454 on the ground that the mark was abandoned, and Respondent committed fraud in its 2011 trademark maintenance filing with its averment of continued use. On August 26, 2013, Respondent filed an answer

denying the salient allegations of the petition to cancel and pleading various affirmative defenses.

On February 7, 2014, Petitioner served discovery requests. On March 10, 2014, Respondent served objections to the number of interrogatories, and responses to the document requests and requests for admission, but produced no responsive documents. On March 21, 2014, Petitioner sent a discovery deficiencies letter to Respondent in which Petitioner withdrew a number of its interrogatories to meet Respondent's objection, and requested supplemental responses and document production. On March 28, 2014, Respondent stated the requested documents would be produced in the next few weeks. Thereafter, no documents having been received, Petitioner filed a motion to compel.

On August 25, 2014, the Board granted Petitioner's motion to compel, and ordered Respondent, within thirty days, to serve (i) written responses to Interrogatory Nos. 1-14, without objection; (ii) responsive documents or to provide supplemental written responses indicating no responsive documents exist pursuant to Request for Production Nos. 1-2, 6-11, 13, 15, 17- 23, 25-89, and 91-93; and (iii) responsive documents or to provide supplemental written responses indicating no responsive documents exist "to the extent that Petitioner seeks documents sufficient to show Reynaldo Ongpauco's, Cecilia Ongpauco's and Nelson Reyes' interest to registrant or companies related to registrant," pursuant to Request for Production Nos. 3-5. The order reset discovery to close December 19, 2014, and advised

Respondent that the failure to comply with the order could result in discovery sanctions.

There is no dispute that, as of the October 21, 2014 filing date of the motion for sanctions, almost four weeks after the Board's deadline for serving the compelled discovery responses, Respondent had not complied with the Board order. Respondent served neither the compelled responses, nor the compelled responsive documents. Petitioner contends that entry of judgment is appropriate because Respondent has delayed this proceeding, and has made Petitioner's attempts to obtain discovery "an expensive, damaging, and futile exercise," and Respondent's deleterious actions are now compounded by Respondent's deliberate disregard for the Board's order.

Respondent opposes entry of judgment, and submits the November 10, 2014 sworn statement of attorney Christopher Shiplett averring that, in the good faith belief that an imminent change of Respondent's ownership would change the discovery responses, and to avoid later supplementation of discovery responses, Attorney Shiplett withheld responses to the discovery requests until the change of Respondent's ownership was completed on November 7, 2014; that Respondent "was acting on the good faith advice of counsel," and that Respondent "is providing a full set of discovery responses, including prior and current ownership documents today, and is withholding no documents on grounds of objections."<sup>1</sup> Respondent contends

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<sup>1</sup> Respondent's opposition uses a case title for this proceeding which lists Respondent as "101 Domain, Inc." in lieu of "Barrio Fiesta International, Inc." This is improper, as only the Board can order the substitution or joinder of parties to its proceedings. *See Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1955 n.1 (TTAB 2008) (Board will not add or

that any prejudice to Petitioner caused by the delay could be remedied by an extension of discovery.

Petitioner filed a reply brief on its motion, including the November 24, 2014 declaration of attorney Albert Wu. The Wu declaration denies that Petitioner was served with any responses. More specifically, attorney Wu avers that as of November 24, 2014, the date the reply brief was filed, two months after the Board's deadline for serving compelled discovery responses and documents, Petitioner has yet to receive any documents or supplementary responses from Respondent.

Petitioner also argues that, despite the averment of "good faith" by counsel for Respondent, Respondent provides no explanation how the failure to produce responses to avoid later supplementation was permissible; how any necessary supplementation regarding the change in ownership would alter the necessity of providing the responses already ordered; or why, if Respondent believed supplementation would be burdensome and its alleged postponement was warranted by the change in ownership, it did not seek an extension or communicate with Petitioner in any way.

Finally, Petitioner submits website printouts indicating that the purported new owner of the subject registration is not a restaurant, but a business for registering

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substitute an applicant as party to an opposition without motion and submission of either proof of name change or assignment, or proof of recordation of same with the USPTO). Notwithstanding counsel's statement that ownership of the subject registration has changed, no proof of assignment was submitted with the opposition or recorded with the USPTO Assignment Branch. Absent proof of the change, the owner of the mark at the time the petition to cancel was filed remains party defendant. Moreover, if proof of the ownership change had been submitted or recorded, the Board's general practice would be to join (and not substitute) the new owner of the mark, to facilitate discovery. See Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 512 (2014).

domain names, and contends that Respondent's unilateral attempt to substitute the purported new owner of the registration as a party is a plain effort to avoid producing discovery entirely, and Respondent's prolonged waste of the time of Petitioner and the Board should end with entry of judgment as a discovery sanction.

Trademark Rule 2.120(g)(1) permits sanctions provided under Fed. R. Civ. P. 37(b)(2). Rule 37(b)(2) 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). "Moreover, the Board has the authority to control the disposition of cases, which necessarily includes the inherent power to enter sanctions." *Patagonia, Inc. v. Azzolini*, 109 USPQ2d 1859, 1861 n.8 (TTAB 2014) (citing *Carrini Inc. v. Carla Carini S.R.L.*, 57 USPQ2d 1067, 1071 (TTAB 2000)). Client and counsel share the duty to advance prosecution of the case before the Board, and counsel's failures are imputed to the party which counsel represents. See *CTRL Systems, Inc. v. Ultraphonics of North America*, 52 USPQ2d 1300, 1302 (TTAB 1999) (citing *Pioneer Inv. Servs. v. Brunswick Assocs. Ltd. Partnership*, 507 U.S. 380, 392 (1993) ("clients must be held accountable for the acts and omissions of their attorneys")). See also *Caymus Vineyards v. Caymus Medical Inc.*, 107 USPQ2d 1519, 1523 n. 5 (TTAB 2013); *DeLorme Publishing Co. v. Eartha's Inc.*, 60 USPQ2d 1222, 1223 n.3. (TTAB 2000); and *Gaylord Entertainment Co. v. Calvin Gilmore Productions Inc.*, 59 USPQ2d 1369, 1372 (TTAB 2000).

After careful consideration of the parties' arguments and explanations, and in light of Respondent's admission that it did not comply with the Board's September

deadline to produce the compelled discovery responses and documents; the paucity of convincing detail or corroborating evidence for Respondent's explanation for its failure to timely comply with the Board's order; Petitioner's sworn statement that Respondent has never complied with the Board's order; and the absence of any evidence that Respondent ever served Petitioner with any compelled responses, we conclude Respondent's conduct deserves sanction. Any sanction short of judgment would be futile and unfair to Petitioner. *See Benedict v. Super Bakery Inc.*, 665 F.3d 1263, 101 USPQ2d 1089, 1093 (Fed. Cir. 2011) ("The possession of a trademark registration places a routine obligation on the possessor to participate in reasonable procedures concerning rights or interests affected by that registration. ... The remedy of default judgment was within the Board's discretion in view of Mr. Benedict's repeated failures to comply with established and reasonable procedures orders."); *Patagonia, Inc.*, 109 USPQ2d at 1862 ("[G]iven 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."); *MySpace Inc. v. Mitchell*, 91 USPQ2d 1060, 1061-62 (TTAB 2009) ("In view of our previous warning that we would enter judgment unless he complied with our order and his continued blatant non-compliance, the sanction of entry of judgment is now warranted.").

We have previously warned Respondent that it would be subject to sanctions if it did not comply with our order granting Petitioner's motion to compel. Therefore, and in view of the foregoing, Petitioner's motion for judgment as a discovery sanction is GRANTED.

Accordingly, judgment is entered against Respondent, the petition to cancel is granted, and Registration No. 1712454 will be cancelled in due course by the Commissioner for Trademarks.