

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Mailed: May 10, 2018

Cancellation No. 92060308

SFM, LLC

v.

Corcamore, LLC

**Katie W. McKnight,
Interlocutory Attorney:**

In its February 27, 2018 order, the Board, *inter alia*, prohibited Respondent from filing any additional unconsented or unstipulated motions without first obtaining prior Board permission. *See* 52 TTABVUE 23. In seeking such permission, the Board specified that Respondent must contact the Board interlocutory attorney by telephone, with counsel for Petitioner also present, to conduct a case conference. *See id.* (emphasis added). Without first seeking Board permission, on March 30, 2018, Respondent filed an “objection” to the schedule set forth in the Board’s February 27, 2018 order. On April 9, 2018, Respondent also filed a letter seeking Board permission to file a variety of motions, and included evidence which Respondent asserts supports its purported good faith effort to resolve the parties’ discovery dispute in accordance with Trademark Rule 2.120(f)(1).¹

¹ The March 30, 2018 and April 9, 2018 filings both fail to indicate proof of service on Petitioner via email, signed by Respondent, as required by Trademark Rule 2.119. In order

On April 30, 2018, Petitioner filed a motion for sanctions in the form of judgment for Respondent's repeated failure to comply with several Board orders. On May 1, again without seeking prior Board permission in accordance with the Board's February 27, 2018 order, Respondent filed: (1) a request to file a cross-motion for discovery sanctions; (2) a request to file a motion for summary judgment, together with its proposed motion for summary judgment; and (3) a request to file a motion to strike Petitioner's motion for sanctions.

Respondent's "Objection" to the Board's February 27, 2018 Order

Respondent's "objection" is **denied** on the procedural ground that Respondent failed to comply with the sanction imposed upon Respondent by the Board's February 27, 2018 order. Specifically, Respondent did not telephone the assigned interlocutory attorney, with counsel for Petitioner on the phone, to seek permission prior to filing its March 30, 2018 "objection." Moreover, to the extent Respondent's March 30, 2018 filing can be construed as a request for reconsideration of the Board's February 27, 2018 order, it is untimely and as such is also denied on that basis. Trademark Rule 2.127(b).

Respondent's April 9, 2018 Letter

Respondent's letter seeking permission to file a variety of motions is **denied** on the procedural ground that Respondent failed to comply with the sanction imposed

to expedite this matter, Petitioner is directed to the following URLs where it may view copies of the filings:

<http://ttabvue.uspto.gov/ttabvue/v?pno=92060308&pty=CAN&eno=53>.

<http://ttabvue.uspto.gov/ttabvue/v?pno=92060308&pty=CAN&eno=54>.

Strict compliance with Trademark Rule 2.119 is required by Respondent in all future papers filed with the Board.

upon Respondent by the Board's February 27, 2018 order. Specifically, Respondent did not telephone the assigned interlocutory attorney, with counsel for Petitioner on the phone, to seek permission prior to filing its letter. To the extent Respondent attempts to put forward evidence of a good faith effort to resolve a discovery dispute between the parties in support of a future motion to compel, it has failed to do so.

A motion to compel must be supported by a written statement that the moving party has made a good faith effort, by conference or correspondence, to resolve with the other party or its attorney the issues presented in the motion, and has been unable to reach agreement. Trademark Rule 2.120(f)(1). The purpose of the good faith effort requirement is to "promote a frank exchange between counsel to resolve issues by agreement or to at least narrow and focus the matters in controversy before judicial resolution is sought." *Amazon Tech., Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009), quoting *Dondi Properties Corp. v. Commerce Savings and Loan Ass'n*, 121 F.R.D. 284, 289 (N.D. Tex. 1988) (construing a local rule less demanding than Trademark Rule 2.120(f)(1)). Moreover, "[w]here it is apparent that the effort toward resolution is incomplete, establishing the good faith effort that is a prerequisite for a motion to compel necessitates that the inquiring party engage in additional effort toward ascertaining and resolving the substance of the dispute." *Hot Tamale Mama ... and More, LLC v. SF Investments, Inc.*, 110 USPQ2d 1080, 1081 (TTAB 2014).

A statement from the moving party that such party or its attorney has made a good faith effort to resolve the parties' dispute "should contain a recitation of the communications conducted including dates, a summary of telephone conversations,

and where applicable, copies of any correspondence exchanged such as email and letters, or notes to the file.” TBMP § 523.02 (June 2017). Here, Respondent attached copies of Petitioner’s responses to Respondent’s discovery requests, as well as predominantly unilateral emails from Respondent to Petitioner regarding what Respondent argues are deficiencies in Petitioner’s responses. However, inasmuch as Respondent’s attached emails do not include any substantive responses from Petitioner,² the emails do not suggest any disagreement between the parties regarding such deficiencies, or any indication that sufficient effort was made towards resolution, and whether attempts at resolution were incomplete. *See id.*; *see also Hot Tamale Mama*, 110 USPQ2d at 1082.

Petitioner’s Motion for Sanctions

Proceedings are **suspended** pending disposition of Petitioner’s motion for judgment as a sanction for Respondent’s failure to comply with multiple Board orders.³ *See* Trademark Rule 2.120(h)(1). The parties should not file any paper that is not germane to the motion for sanctions.⁴ *See* Trademark Rule 2.127(d). Respondent’s brief in response to Petitioner’s motion is due in accordance with Trademark Rule 2.127(a).

² To the extent the emails include any responses from Petitioner, the responses serve only to schedule a phone call or to serve Petitioner’s production on Respondent.

³ Proceedings are suspended as of April 30, 2018. *See* Trademark Rule 2.127(d) (“When any party timely files a potentially dispositive motion ... the case is suspended by the Trademark Trial and Appeal Board ...”).

⁴ Respondent is advised that while proceedings are suspended pending disposition of Petitioner’s motion for sanctions, the Board may not grant Respondent permission to file any other unconsented or unstipulated motions.

The parties may not serve any additional discovery until the period of suspension is lifted or expires by order of the Board. The filing of the motion for sanctions shall not toll the time for a party to respond to any outstanding discovery requests or to appear for any noticed discovery deposition. The schedule for expert disclosures and discovery is also suspended by this order and will be reset in the event that the Board resumes proceedings.⁵

The motion for sanctions will be decided in due course.

Respondent's May 1, 2018 Submissions

Respondent's three filings on May 1, 2018 are each **denied** on the procedural ground that Respondent failed to comply with the sanction imposed upon Respondent by the Board's February 27, 2018 order. Specifically, Respondent did not telephone the assigned interlocutory attorney, with counsel for Petitioner on the phone, to seek permission prior to filing its May 1, 2018 submissions. Respondent's filings are also denied to the extent that proceedings were suspended as of April 30, 2018 and its requests are not germane to the pending motion for sanctions.

Sanctions

In view of its continued failure to comply with the sanctions imposed by the Board's February 27, 2018, the Board finds it necessary to remind Respondent of those sanctions.

Respondent is prohibited from filing any additional unconsented or unstipulated motions without first obtaining prior Board permission. *See, e.g., Int'l Finance Corp.*

⁵ The expert disclosures deadline is also suspended by this order.

v. Bravo Co., 64 USPQ2d 1597, 1605 (TTAB 2002); *see also* TBMP § 527.03 and cases cited in Note 4. In seeking such permission, counsel for Respondent is required to **contact by telephone** the Board interlocutory attorney assigned to this case to conduct a case conference **with counsel for Petitioner also present**. In the event that after the service of discovery, Respondent seeks to file a motion to compel or any other motions related to discovery or disclosures, it is also required to provide to the Board in writing, **with proper service on Petitioner**, a statement of good faith effort made under Trademark Rule 2.120(f)(1), a copy of each discovery request or notice of deposition in dispute, and a copy of all correspondence and emails involving the discovery request(s) or notice(s) of deposition prior to the telephone conference. Counsel for Respondent must also be prepared to identify each conversation with Petitioner regarding the discovery request(s), notice(s) of deposition or disclosures and describe the substance thereof.