

**UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513**

Mailed: February 5, 2003

Opposition No. 119,899

DURAMAX MARINE, LLC

v.

R.W. FERNSTRUM & COMPANY

Cindy B. Greenbaum, Attorney:

This case now comes up on the following contested motions: (1) opposer's combined motions (filed November 9, 2001, six days before discovery closed) to (a) allow opposer to enter applicant's property pursuant to a Fed. R. Civ. P. 34(a)(2) request ("Rule 34(a)(2) motion"), (b) compel applicant's president, Paul W. Fernstrum, to attend his deposition, and (c) stay the depositions of Sean W. Fernstrum, Todd S. Fernstrum and applicant's designated witness(es) under Fed. R. Civ. P. 30(b)(6) until after opposer obtains the discovery requested in its Rule 34(a)(2) motion; (2) opposer's motion (filed November 15, 2001) to stay the close of discovery and to further extend the discovery period; (3) opposer's combined motions (filed December 7, 2001) to compel answers to its third and fourth

**Opposition No. 119,899**

sets of interrogatories;<sup>1</sup> (4) applicant's motion (filed January 7, 2002) to compel opposer to produce two documents; (5) opposer's motion (filed January 10, 2002) to test the sufficiency of applicant's responses to opposer's fifth set of requests for admissions; and (6) opposer's combined motion (filed July 5, 2002) to compel answers to its first and second sets of document requests and interrogatories. The parties have fully briefed the issues, and, in its discretion, the Board has considered all replies.

Before turning to the contested motions, the Board addresses two preliminary matters. First, the Board notes opposer's consent to applicant's motion (filed January 7, 2002) for leave to file a motion to compel. The motion is granted. See Trademark Rule 2.127(a).

Second, Trademark Rule 2.120(e) provides that the Board suspend proceedings upon the filing of a motion to compel. Although proceedings are not automatically suspended when such a motion is filed, the Board usually treats the case as if it had been suspended as of the filing date of the motion. Thus, in this case, when dates are reset, the trial schedule will be resumed at the point it had reached when opposer's first combined motion to compel was filed (i.e., with six days remaining in the discovery period).

---

<sup>1</sup> On December 11, 2001, opposer filed a substitute motion to compel to correct typographical errors. The Board accepts the substitute motion to compel.

The Board now addresses the contested matters in turn.

**(1) Opposer's Combined Motions to: (a) Allow Opposer to Enter Applicant's Property Pursuant to Fed. R. Civ. P. 34; (b) Compel Applicant's President, Paul Fernstrum, to Attend a Deposition; and (c) Stay the Depositions of Sean Fernstrum, Todd Fernstrum and the Rule 30(b)(6) Deponent(s) Until Opposer Completes the Discovery Sought Under Fed. R. Civ. P. 34.**

(a) Opposer seeks an order allowing it to enter applicant's property in Menominee, Michigan to inspect documents on applicant's premises pursuant to Rule 34(a)(2). Opposer set forth the categories of requested documents in an attachment to its Rule 34(a)(2) motion.

Opposer's Rule 34(a)(2) motion is denied for the following reasons. First, since Board proceedings involve only the right to register trademarks, a Rule 34(a)(2) motion is rarely, if ever, used. See TBMP Section 408.02. Opposer has not persuaded the Board to make an exception in this case. Second, the Board has reviewed the document request associated with opposer's Rule 34(a)(2) motion. As written, the document request is impermissibly vague and overly broad. Third, the information opposer seeks by way of its Rule 34(a)(2) motion can be obtained through other, less intrusive methods. Fourth, to the extent opposer seeks the same information from applicant which applicant sought from opposer, but to which opposer objected as confidential, opposer cannot now move to compel that same type of information from applicant. See *Miss America Pageant v.*

**Opposition No. 119,899**

Petite Productions Inc., 17 USPQ2d 1067 (TTAB 1990);  
Sentrol, Inc. v. Sentex Systems, Inc., 231 USPQ 666 (TTAB  
1984).

(b) Opposer served four notices of deposition, including one to each of the three Fernstrums, individually, and one 30(b)(6) deposition notice. Each of the depositions was scheduled to occur at 9:00 a.m. on November 13, 2001 in Menominee, Michigan. Applicant designated Sean Fernstrum and Todd Fernstrum as applicant's 30(b)(6) witnesses, and informed opposer that Paul Fernstrum would not appear for a deposition in Michigan (where applicant is located), noticed during a month when he resides in Florida.

To the extent opposer argues that Paul Fernstrum should be applicant's designated 30(b)(6) witness, opposer does not have the power to make this determination; applicant is required to designate the individual(s) it believes is/are best qualified to appear on behalf of applicant in a 30(b)(6) deposition. 8A Wright, Miller & Marcus, Federal Practice and Procedure: Civil 2d Section 2103, page 32 (1994). Further, without first taking the depositions of Sean Fernstrum and Todd Fernstrum, opposer has no basis to conclude that they cannot answer whatever questions opposer wishes to pose to Paul Fernstrum. See *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759 (TTAB 1999). Accordingly, to the extent opposer seeks to compel the attendance of Paul

**Opposition No. 119,899**

Fernstrum as applicant's 30(b)(6) witness, the motion is denied.

Turning now to the deposition of Paul Fernstrum, although opposer is entitled to take the discovery deposition of applicant's president, Paul Fernstrum, on notice alone,<sup>2</sup> the deposition "shall be taken in the Federal judicial district where the person resides or is regularly employed or at any place on which the parties agree by stipulation." Trademark Rule 2.120(b). Upon receipt of the notices of deposition, applicant informed opposer that Paul Fernstrum resides in Florida approximately six months each year, including the date set forth in the deposition notice, and offered to make Paul Fernstrum available in Florida for his deposition on the noticed date. Opposer did not amend or change the original notice of Paul Fernstrum's deposition to address the fact that he would not be resident in Michigan on the date set forth in the notice of deposition, nor did opposer make arrangements to depose Paul Fernstrum in Florida, preferring instead to file a motion to compel Paul Fernstrum's attendance in Michigan.

Opposer's arguments to support this position are not persuasive. Accordingly, to the extent opposer seeks to compel Paul Fernstrum's attendance for a discovery deposition in Michigan on a date when Paul Fernstrum does

---

<sup>2</sup> See TBMP Sections 404.03(b)(1) and 404.04.

**Opposition No. 119,899**

not reside in Michigan, the motion is denied. Opposer is allowed until THIRTY days from the mailing date of this order to re-notice the deposition of Paul Fernstrum to occur during one of the six days remaining in the discovery period, as reset below. The deposition will occur where Mr. Fernstrum resides on the date set forth in the notice of deposition, or anywhere the parties agree by stipulation.

On a related issue, if opposer still wishes to depose Sean Fernstrum and/or Todd Fernstrum, and/or to take a deposition under Fed. R. Civ. P. 30(b)(6), opposer must re-notice those depositions within the same THIRTY day period from the mailing date hereof, said depositions to occur during one of the six days remaining in the discovery period, as reset below.

(c) Opposer served its Rule 34(a)(2) motion on the same day it served the four deposition notices discussed above, and called for the Rule 34(a)(2) inspection to be made on the same date and at the same time as the aforementioned depositions, though in a different location.<sup>3</sup> Opposer now argues that it intended to first review the documents it obtained through its Rule 34(a)(2) motion and then to take the noticed depositions.

---

<sup>3</sup> Opposer's Rule 34(a)(2) motion would have occurred at applicant's premises in Menominee, while the four depositions would have occurred at a law office in Menominee.

Opposer's motion to stay the depositions is directly tied to opposer's Rule 34(a)(2) motion. Inasmuch as the Board denied opposer's Rule 34(a)(2) motion hereinabove, the motion to stay is denied as moot.

**(2) Opposer's Motion to Stay the Close of Discovery and to Extend the Discovery Period**

Although applicant did not file a separate response to opposer's motion to stay the close of discovery and to extend the discovery period, applicant raised its objections to the requested stay and extension when addressing a related issue in applicant's response to opposer's first combined motion to compel. In view thereof, the Board will not treat opposer's motion to stay and extend as conceded, pursuant to Trademark Rule 2.127(a). Instead, the Board will address the merits of opposer's motion.

It is well settled that a party is to notice and take all discovery depositions during the discovery period (absent other arrangements between the parties). See *Smith International, Inc. v. Olin Corp.* 201 USPQ 250 (TTAB 1978). Here, opposer noticed all four depositions (and the Rule 34(a)(2) inspection) to occur two days before the close of discovery. Given the acrimonious relationship between the parties, detailed at length by both parties in their various filings now before the Board, there is no reason for opposer to believe that applicant would agree to an extension of the discovery period so that opposer could first review the

documents it sought to obtain through its Rule 34(a)(2) motion, and then take the four noticed depositions.

Opposer has offered no reason for waiting until the final month of the discovery period to notice and take the four discovery depositions, and to serve its Rule 34(a)(2) motion. By its own actions, opposer denied itself the opportunity to take follow-up discovery within the discovery period. Moreover, opposer has not established the requisite good cause to extend the discovery period beyond the six days that still remain. See *Luehermann v. Kwik Kopy Corp.*, 2 USPQ2d 1303 (TTAB 1987).

In view of the foregoing, to the extent opposer seeks an extension of discovery, the motion is denied. To the extent opposer seeks a stay of discovery, the motion is granted such that both parties will be allowed an abbreviated six day discovery period.<sup>4</sup>

**(3) Opposer's Combined Motions to Compel--Third and Fourth Sets of Interrogatories**

Applicant has asserted a general objection to the third and fourth sets of interrogatories on the ground that they exceed the limit specified in 37 C.F.R. §2.120(d)(1). The Board has reviewed all four sets of interrogatories, and

---

<sup>4</sup> See the preliminary section of this order for a fuller discussion of this point.

finds that the limit of 75 interrogatories, counting subparts, set forth in 37 C.F.R. §2.120(d)(1), was exceeded in opposer's second set of interrogatories. Inasmuch as opposer only seeks responses to its third and fourth sets of interrogatories, and opposer exceeded the statutory limit with regard to the permitted number of interrogatories before it served the third and fourth sets of interrogatories, the motion to compel is denied. Moreover, the Board will not grant opposer leave to file a revised third and fourth set of interrogatories, as such leave would further exceed the statutory limit.

**(4) Applicant's Motion to Compel Opposer to Produce Two Documents**

By this motion, applicant seeks two documents that opposer initially listed, but then withdrew, from opposer's privileged documents log, namely, document numbers 537 and 621. With regard to these two documents, opposer now claims that the associated document requests are overly broad and the documents are not relevant to the issues in this proceeding.

Opposer did not initially object on grounds of relevancy or overbreadth, and later raised these objections in an untimely manner. It is not clear whether document numbers 537 and 621 are relevant to the instant proceeding, but it is clear that the attorney-client privilege does not apply to either document. As the two documents purportedly

involve business sensitive information, which may or may not be relevant to this proceeding, applicant's offer to conduct its own "in camera" review, stated in opposer's December 31, 2001 email to applicant, is reasonable.

Accordingly, applicant's motion to compel is granted to the extent that opposer has until THIRTY DAYS from the mailing date of this order to produce document numbers 537 and 621 to applicant. Applicant has until FIFTEEN DAYS from the date on which opposer produces said documents to either (1) return the document(s) to opposer with a certification that no copies were made, or (2) inform opposer that applicant believes the document(s) is/are are relevant and/or may reasonably lead to the discovery of admissible evidence. If applicant avails itself of option (2), the Board's standardized protective order automatically will be in effect with regard to said document(s) without the need for further action by either party or by the Board.<sup>5</sup>

**(5) Opposer's Motion to Test the Sufficiency of Applicant's Responses to Opposer's Fifth Set of Requests for Admissions**

By this motion, opposer seeks to obtain admissions regarding the state of residency of Paul Fernstrum to support opposer's position, in its first motion to compel,

---

<sup>5</sup> The Board's standardized protective order is available on the internet at [www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm](http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm)

**Opposition No. 119,899**

that Paul Fernstrum is a resident of Michigan, and, therefore, his deposition should occur in Michigan. However, applicant has repeatedly told opposer that Paul Fernstrum resides in Florida for approximately six months every year, including the date set forth in his deposition notice. The Board sees no reason to question applicant's representation.

It is opposer's obligation to notice the deposition for the location where Paul Fernstrum resides on the date of the deposition. The requests for admissions now in issue have no bearing on establishing the location where Paul Fernstrum resided on November 13, 2001, nor where he will reside on the date of the deposition to be scheduled pursuant to the terms of this order. In view thereof, the motion to test the sufficiency of applicant's responses to opposer's fifth set of requests for admissions is denied.

**(6) Opposer's Combined Motion to Compel-First and Second Sets of Document Requests and Interrogatories**

Approximately six months after opposer had filed the series of discovery motions discussed hereinabove, opposer filed a motion to compel responses to its first and second sets of document requests and interrogatories.

Trademark Rule 2.120(e) provides that a motion to compel must be supported by a written statement from the moving party that it has made a good faith effort, by conference or correspondence, to resolve with the other

**Opposition No. 119,899**

party the issues presented in the motion, and has been unable to reach agreement. See *Sentrol, Inc. v. Sentex Systems, Inc.*, supra, 231 USPQ 666 (TTAB 1986).

Although opposer's motion to compel includes a statement regarding opposer's purported good faith effort, the number of interrogatories and document requests at issue make it clear that opposer has failed to make a substantive effort to resolve by agreement said issues before coming to the Board. See Trademark Rule 2.120(e).

In addition, opposer purportedly intended to use the information and documents it had hoped to obtain by its final motion to compel at depositions that opposer states it had planned to take during the summer of 2002. However, by virtue of filing the instant motion in July 2002, opposer delayed issuance of the resulting Board order until after the summer of 2002, given the time required for the parties to complete briefing the motion and for the Board's docketing system to alert the Board attorney assigned to this case that the pending motions finally were ready for decision. If opposer believed it required the information it seeks by this motion to take depositions in the summer of 2002, opposer should have filed the instant motion earlier in the year. In this vein, opposer has not adequately explained why it did not file this motion to compel at least

**Opposition No. 119,899**

by January 2002, when it filed the last of its other discovery motions addressed in this order.

Accordingly, opposer's motion to compel responses to its first and second sets of document requests and interrogatories is denied.

Notwithstanding the foregoing, to the extent applicant's responses to interrogatory no. 11(a) and document request no. 1 comprise "representative samples," applicant is allowed until THIRTY DAYS from the mailing date hereof to supplement, as appropriate, the two responses as follows: the "representative samples" must include responsive, non-privileged documents from regularly spaced intervals of years, as well as sufficient to show changes in the use of the involved mark in connection with the services recited in the involved application. The supplemental production, if any, will be limited in time from 1975, the date of applicant's first claimed use of the mark as set forth in the involved application, to the present.

**DATES RESET**

The parties are allowed THIRTY DAYS from the mailing date of this order to serve responses to any outstanding discovery requests not already addressed in this order. The parties are advised that if proper discoverable matter is withheld from the requesting party, the responding party will be precluded from relying on such information and from

**Opposition No. 119,899**

adducing testimony with regard thereto during its testimony period. See *Shoe Factory Supplies Co. v. Thermal Engineering Company*, 207 USPQ 517 (TTAB 1980); and *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895 (TTAB 1988).

Trial dates, including the close of discovery, are reset as follows:

**DISCOVERY PERIOD TO CLOSE** **April 30, 2003**  
(opening April 24, 2003):

Testimony period for party in position of plaintiff to close: **July 29, 2003**

Testimony period for party in position of defendant to close: **September 27, 2003**

Rebuttal testimony period to close: **November 11, 2003**

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.