

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

Mailed: March 15, 2007

Opposition No. **91156321**

THE CHAMBER OF COMMERCE OF THE
UNITED STATES OF AMERICA

v.

United States Hispanic Chamber
of Commerce Foundation

Linda Skoro, Interlocutory Attorney

This case now comes up on applicant's motion, filed August 3, 2006, to compel responses to its first set of interrogatories and further responses to its second set of interrogatories and requests for production of documents.

In support of its motion to compel, applicant states that because opposer failed to respond to applicant's first set of discovery requests and was late in responding to the second set, that opposer has waived all of its objections and should be compelled to respond. Opposer states that applicant's motion as to the first set of discovery requests is untimely; that it responded to the second set and all responsive documents have been made available for inspection to applicant. As its good faith effort to resolve the

dispute, applicant alleges a letter to opposing counsel on July 26, 2006.

A review of the timeline in this proceeding is relevant to this decision. This proceeding was instituted on May 15, 2003. Since then proceedings have had time extensions and suspensions for a variety of reasons. As last reset, the discovery period closed on June 1, 2006. Applicant filed this motion on August 3, 2006, right before opposer's testimony period was scheduled to open on August 15, 2006. Of more significance is that applicant served its first round of discovery on opposer on January 12, 2004¹ and its second round of discovery on March 13, 2006. Opposer responded to the second set of requests on June 1, 2006, after a suspension was lifted.

In its motion, applicant seeks to compel opposer to provide full and complete responses to all of the discovery requests. Opposer, on the other hand, states that it responded to applicant's discovery; that applicant has failed to make the good faith effort to resolve this dispute required by 37 C.F.R. § 2.120(e); and that all its responses and objections are valid.

In the instant case, it is the Board's view that applicant has failed to make the required good faith effort

¹ It is noted that at the time each of the parties were represented by different counsel. Both have since changed their legal representation.

to resolve by agreement the issues raised by its motion to compel. In the case of Sentrol, Inc. v. Sentex Systems, Inc., 231 USPQ 666 (TTAB 1986), the Board stated:

"[E]ach party and its attorney has a duty not only to make a good faith effort to satisfy the discovery needs of its opponent but also to make a good faith effort to seek only such discovery as is proper and relevant to the specific issues involved in the case. Moreover, where the parties disagree as to the propriety of certain requests for discovery, they are under an obligation to get together and attempt in good faith to resolve their differences and to present to the Board for resolution only those remaining requests for discovery, if any, upon which they have been unable, despite their best efforts, to reach an agreement. Inasmuch as the Board has neither the time nor the personnel to handle motions to compel involving substantial numbers of requests for discovery which require tedious examination, it is generally the policy of the Board to intervene in disputes concerning discovery, by determining motions to compel, only where it is clear that the parties have in fact followed the aforesaid process and have narrowed the amount of disputed requests for discovery, if any, down to a reasonable number.

First of all, applicant waited years to compel opposer to answer the first round of discovery. A motion to compel should be filed within a reasonable time after the failure of a party to respond to a request for discovery. Further, applicant not only failed to make a good faith effort to resolve the lack of responses by opposer as to the first round of discovery, it failed to make any effort at all.

As to the second round of discovery, opposer's responses were provided to applicant on June 1, 2006. Believing the responses to be inadequate, applicant sent a letter to opposing counsel on July 26, 2006 to raise its objections and request supplementation and suggesting he was available by telephone. Opposer responded on July 27, 2006, setting forth its position and suggesting a conference call should be scheduled. This appears to be the only communication applicant had with opposing counsel prior to filing its motion to compel.² Not only did the letter fail to specify applicant's specific objections to the responses to enable opposer to resolve the differences, applicant failed to make any effort to set up its suggested telephone conference.³ As for applicant's request for the production

² See supporting declaration of Erik C. Dane, Counsel for opposer, wherein he avers that following his reply letter of July 27, he left several voicemail messages for both Andrew Eliseev and Jill Pietrini indicating a desire to discuss the outstanding discovery dispute. No response was received until August 3, 2006 when he learned that a motion to compel had been filed.

³ It is noted that applicant contends that "considering opposer's position adamantly denying the possibility of any deficiencies in opposer's discovery responses, and in light of the fast approaching opposer's testimony period, applicant was forced to forgo [sic] a likely futile meeting with opposer's counsel, and go forward with the present motion." (brief at 4). Such an explanation is unfounded considering opposer's numerous attempts to communicate with applicant's counsel.

of documents, opposer states⁴ that it made all documents available for inspection at opposer's counsel's office and offered to copy and send the documents to applicant, to which applicant also failed to respond to.

It is the opinion of the Board that writing one letter to opposing counsel regarding dissatisfaction with the responses, does not constitute the required good faith effort to resolve the outstanding discovery issues before coming to the Board. Opposer provided answers and objections to the discovery requests. It was incumbent upon applicant to clearly state why it disagreed with opposer's objections. It failed to do so. Opposer made the relevant documents responsive to the requests for production available for applicant's inspection. It was incumbent upon applicant to make arrangements to see and/or copy those documents.⁵ It failed to do so. In view of the above, applicant's motion to compel is DENIED.

⁴ See opposer's discovery responses to the second round of discovery which provides counsel would "permit the inspection and copying of the documents produced in response to [Applicant's] requests...at the office of Kenyon & Kenyon LLP [in] Washington, D.C. at a time and date mutually convenient to counsel for opposer and applicant." Opposer further offered "if you would like us to send a copy of the documents at your expenses, we would be happy to do so in return for you sending us your responsive documents."

⁵ Applicant now argues that making the documents available in counsel's office, rather than in the file cabinets in which they are kept at opposer's offices, is not proper discovery. Applicant's position on this issue is incorrect. See Fed. R. Civ. Pro. 34(b).

Trial dates are reset as indicated below.

THE PERIOD FOR DISCOVERY TO CLOSE:	CLOSED
30-day testimony period for plaintiff in the opposition to close:	4/20/2007
30-day testimony period for defendant in the opposition and as plaintiff in the counterclaim to close:	6/19/2007
30-day testimony period for defendant in the counterclaim and its rebuttal testimony as plaintiff in the opposition to close:	8/18/2007
15-day rebuttal testimony period for plaintiff in the counterclaim to close:	10/2/2007
Briefs shall be due as follows: [See Trademark rule 2.128(a)(2)].	
Brief for plaintiff in the opposition shall be due:	12/1/2007
Brief for defendant in the opposition and as plaintiff in the counterclaim shall be due:	12/31/2007
Brief for defendant in the counterclaim and its reply brief (if any) as plaintiff in the opposition shall be due:	1/30/2008
Reply brief (if any) for plaintiff in the counterclaim shall be due:	2/14/2008

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.

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