UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3514

Greenbaum

Mailed: November 4, 2005

Opposition No. 91156858

CENTRAL MFG. CO.

v.

DREAMWORKS L.L.C. AND
DREAMWORKS ANIMATION
L.L.C.

Before Hairston, Holtzman and Rogers, Administrative Trademark Judges.

By the Board.

This case now comes up on applicants' motion for discovery sanctions in the form of judgment against opposer, pursuant to Trademark Rule 2.120(g)(1).[1] In addition to dismissal of this proceeding, applicants seek entry of judgment against opposer on applicants' counterclaim for cancellation of Registration No. 1623790. The parties have fully briefed the issues, and we have considered applicants' reply. See Trademark Rule 2.127(a).

[1] Applicants submitted the declaration of their attorney, Christopher C. Larkin, in support of the instant motion. Applicants attached as exhibits to the Larkin Declaration copies of three faxes from opposer's principal, Leo Stoller, to Mr. Larkin. We discuss these faxes below.

By way of relevant background, the July 14, 2005 Board order granted, in its entirety, applicants' motion to compel responses to applicants' first set of interrogatories and first set of document requests. In particular, the Board uniformly overruled as without merit opposer's objections to applicants' discovery requests, ordered opposer to provide full and complete responses to 26 interrogatories and 55 document requests, and ordered opposer to "verify its original and supplemental responses to applicants' first set of interrogatories pursuant to Fed. R. Civ. P. 33(b)(1)." In the event that opposer had "no responsive documents or information regarding any of the enumerated discovery requests, or if opposer has already produced all such responsive documents and provided all such responsive information," the Board required opposer to "affirmatively so state, under oath."

Opposer's efforts to comply with the July 14, 2005 Board order were minimal, at best, consisting of three inconsistent faxed statements. The faxes were transmitted to applicants at 2:41 a.m., 9:41 p.m. and 11:01 p.m. on August 4, 2005, but dated August 3, 2005, August 4, 2005 and August 2, 2005, respectively, and a separate transmission was received by applicants on August 8, 2005.

In the first transmitted fax ("August 3, 2005 fax"), opposer states that: "[o]pposer has no responsive documents

or information regarding any of the enumerated discovery requests . . . . Opposer has already produced all such responsive documents and provided all such responsive information."[2] This fax includes a declaration from opposer's principal, Leo Stoller, verifying the statements therein.[3]

In the second transmitted fax ("August 4, 2005 fax"), opposer states that: "[y]our [sic] on notice that I have also forwarded yesterday documents in response to your discovery request evidencing where opposer's HAVOC brand products are being sold, in all the major retailors [sic] in the US."[4]

The third transmitted fax ("August 2, 2005 fax") purportedly covers "57 pages of documents evidencing use of

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[2] Opposer also states in the fax that "Opposer's responses also apply to DreamWorks Second Set of [discovery requests], pursuant to your letter of July 25, 2005. Opposer has no responsive documents or information regarding any of the enumerated discovery requests and Interrogatories outlined in your letter of July 25, 2005."

[3] Opposer's August 18, 2005 response to the instant motion ("August 18, 2005 response") contains an additional verification of "its original and supplemental responses to applicants' first set of interrogatories pursuant to FRCP 33(b)(1) and affirmatively states that it has producted [sic] all such responsive documents and aprovided [sic] all such responsive information regarding 'any of the enumerated discovery requests' contained in th [sic] Board Order of July 14, 2005." We accept the additional verification as opposer's clarification and amendment of the August 3, 2005 fax.

[4] Mr. Larkin states that he "believe[s] that Mr. Stoller was referring to Interrogatory No. 21, which requested the identification of five representative retailers in which 'HAVOC' products are currently available. The Board had ordered a full and complete response to this interrogatory in the Discovery Order. No supplemental response to that interrogatory was ever received by Applicants."

opposer's HAVOC mark [and] names of leading retailers where customers can purchase opposer's goods." In his declaration, Mr. Larkin states that this fax only covered one page.[5] Mr. Larkin further states that on August 8, 2005, he received 57 pages of documents that appear to be downloads from Internet websites.

Opposer did not specify a document request and/or interrogatory for which the one page attached to the August 2, 2005 fax or the 57 pages of documents received on August 8, 2005 were intended as a response, as required by Fed. R. Civ. P. 34(b). Therefore, and because opposer produced said documents after opposer had verified in the August 3, 2005 fax that it had no further responsive information or documents, the faxed documents do not constitute an effective response to any of applicants' discovery requests. In addition, the August 3, 2005 fax, as clarified by the verification contained in opposer's August 18, 2005 response to the instant motion, constitute opposer's only statements under oath regarding its discovery responses.

We therefore consider the August 3, 2005 fax, as clarified by the verification contained in opposer's August

[5] We note that the one page bears an August 3, 2005 date, but was attached to the August 2, 2005 fax that was transmitted at 11:01 p.m. on August 4, 2005.

18, 2005 response to the instant motion, as the operative response to the July 14, 2005 Board order.[6]

For the reasons discussed above, we find that opposer did not fully comply with the July 14, 2005 Board order. In view thereof, applicants' motion for discovery sanctions is granted to the extent that opposer is prohibited from introducing at trial the one page attached to the August 2, 2005 fax and the 57 pages of documents received on August 8, 2005.

Further, opposer is reminded that a party that withholds responsive documents or information or, due to an incomplete search of its records, fails to provide a complete response to a discovery request, may not thereafter rely at trial on information from its records which was properly sought by any discovery request of its adversary but was not included in the response thereto (provided that the requesting party raises the matter by objecting to introduction of the evidence in question). See Bison Corp. v. Perfecta Chemie B.V., 4 USPQ2d 1718 (TTAB 1987). Opposer is also reminded that, when a party, without substantial justification, fails to amend or supplement a prior response, as required, that party may be prohibited from

[6] Inasmuch as opposer has verified under oath that it has no further documents or information responsive to applicants' first or second sets of discovery, the Board would not favorably view a motion to compel by applicants with regard to applicants' second set of discovery requests.

using as evidence the information not produced during discovery. See Fed. R. Civ. P. 37(c)(1).

Proceedings are RESUMED. The parties are allowed THIRTY DAYS from the mailing date of this order to serve responses to any outstanding discovery requests. Trial dates, including the close of discovery, are reset as follows:[7]

THE PERIOD FOR DISCOVERY TO CLOSE:	12/31/2005
Thirty-day testimony period for the plaintiff to close:	3/31/2006
Thirty-day testimony period for the party in position of defendant and plaintiff in the counterclaim to close:	5/30/2006
Thirty-day testimony period for defendant in the counterclaim, and for rebuttal testimony as plaintiff to close:	7/29/2006
Fifteen-day rebuttal testimony period for plaintiff in the counterclaim to close:	9/12/2006
Briefs shall be due as follows. *See* Trademark Rule 2.128(a)(2)	
Brief for plaintiff due:	11/11/2006
Brief for defendant, and plaintiff in the counterclaim due:	12/11/2006
Brief for defendant in the counterclaim and its reply brief (if any) as plaintiff due:	1/10/2007
Reply brief (if any) for plaintiff in the counterclaim due:	1/25/2007

[7] The parties must note that this is not an order compelling discovery.

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.l25.

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.l29.