

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

Mailed: September 20, 2005

Opposition No. 91161603

Allergan, Inc.

v.

BioCentric Laboratories,
Inc.

Cindy B. Greenbaum, Attorney:

This case now comes up on opposer's second motion to compel, filed August 30, 2005. The Board construes applicant's August 30, 2005 filing as a response to the motion to compel.

As background, the June 28, 2005 Board order denied opposer's first motion to compel for failure to make a sufficient good faith effort, as Trademark Rule 2.120(e) requires. Said order reset trial dates, but did not reopen discovery, which had closed on June 15, 2005. Subsequently, based on opposer's acknowledgement in its July 1, 2005 reply brief that applicant might not have received opposer's original discovery requests, and to allow opposer time to serve additional discovery requests on applicant, the July 7, 2005 Board order vacated the June 28, 2005 order with

respect to the close of discovery, such that discovery was reopened until August 31, 2005.

The record establishes that (i) on July 1, 2005, opposer served applicant with the discovery requests underlying opposer's second motion to compel, (ii) applicant received said requests, but believed there was no need to respond because opposer served said requests in the period between the two noted Board orders, i.e., while discovery was closed, (iii) opposer did not contact applicant before sending a representative on August 8, 2005 to applicant's former street address and to the home of applicant's former registered agent to retrieve applicant's discovery responses, (iv) applicant did not respond to opposer's July 1, 2005 discovery requests, and (v) opposer served the same discovery requests on applicant on August 22, 2005 or August 23, 2005.¹

Opposer's decision to send a representative to personally retrieve applicant's discovery responses is inappropriate, to say the least. The pertinent portion of Fed. R. Civ. P. 34(b) specifically states that the party responding to a document request "shall serve a written

¹ Opposer's motion to compel references August 22, 2005 as the date of service of the motion to compel on applicant. However, opposer's August 24, 2005 email to applicant (attached as Exhibit 2 to the motion to compel) states that "yesterday we served a third copy of the discovery." The Board notes that applicant states that it received said requests on August 25, 2005.

response within 30 days after the service of the request. . . . The response shall state, with respect to each item or category, that inspection and related activities will be permitted as requested, unless the request is objected to, in which event the reasons for the objection shall be stated." Nowhere does Rule 34 state that the requesting party may appear, unannounced, to demand documents from the responding party. See also Trademark Rule 2.120(d)(2).

Under the circumstances, it was reasonable for applicant to believe that opposer's July 1, 2005 discovery requests were untimely, and that there was no need to respond thereto. Thus, to the extent opposer's motion to compel pertains to opposer's July 1, 2005 discovery requests, the motion is denied. To the extent opposer's motion to compel pertains to opposer's August 23, 2005 discovery requests, the motion to compel is denied as premature. Moreover, opposer's requests for admission do not stand admitted by operation of law.²

Applicant's written responses to opposer's discovery requests are due on September 27, 2005, i.e., thirty-five

² If a party on which requests for admission have been served fails to timely respond thereto, the requests will stand admitted unless the party is able to show that its failure to timely respond was the result of excusable neglect, or unless a motion to withdraw or amend the admissions is filed pursuant to Fed. R. Civ. P. 36(b) and granted by the Board. See *Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064, 2064 n.1 (TTAB 1990), and authorities cited in TBMP 407.03(a) (2nd ed. rev. 2004).

days after August 23, 2005, the later of the two possible dates of service of opposer's discovery requests on applicant. Of course, the parties may agree, in writing, to an earlier or later date for applicant's written responses. See Fed. R. Civ. P. 33(a)(3), 34(b) and 36(a).

The Board expects the parties to arrange a mutually convenient time and place for applicant to produce the requested information, after applicant responds, in writing to opposer's discovery requests. Trademark Rule 2.120(d)(2) governs the location for document production. However, in Board cases, parties often extend each other the courtesy of producing requested documents by copying the documents and forwarding them to the requesting party. See *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000). If applicant has not already done so, applicant must read and become familiar with the Federal Rules of Civil Procedure, the Trademark Rules of Practice, and the TBMP.³

Applicant has a duty to thoroughly search its records for all information properly sought in opposer's discovery requests, and to provide such information to opposer within the time allowed for responding to the requests. If, due to an incomplete search of its records, applicant provides an

³ The relevant rules and procedures regarding opposer's currently outstanding discovery requests are set forth in Fed. R. Civ. P. 33, 34 and 36, Trademark Rule 2.120, and TBMP §400 (2nd ed. rev. 2004).

incomplete response to a discovery requests, applicant may not thereafter rely at trial on information from its records which was properly sought in the discovery requests but was not included in the response thereto (provided that opposer raises the matter by objecting to the evidence in question) unless applicant supplements the response in a timely fashion pursuant to Fed. R. Civ. P. 26(e). See *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1720 (TTAB 1987). See also TBMP § 408.02 (2d ed. rev. 2004).

The parties are again directed to work together to resolve their discovery problems, in the spirit of good faith and cooperation that is required of all litigants in Board proceedings. In particular, opposer should not file another motion to compel unless, after making its best efforts, it truly is unable to work out mutually acceptable solutions to its discovery problems without the Board's help. If opposer chooses to file a third motion to compel that is either premature, or without first making a sufficient good faith effort to resolve the issues with applicant, the Board may deny the motion with prejudice.

Finally, to prevent further confusion regarding applicant's receipt of any documents relating to this proceeding, opposer is advised to fax or email copies to applicant of all future filings and discovery requests in addition to serving copies thereof to applicant's post

Opposition No. 91161603

office box of record, in accordance with Trademark Rule 2.119.

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

DISCOVERY PERIOD TO CLOSE: **October 27, 2005**

Thirty-day testimony period for party in position of plaintiff to close: **January 25, 2006**

Thirty-day testimony period for party in position of defendant to close: **March 26, 2006**

Fifteen-day rebuttal testimony period to close: **May 10, 2006**

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.