

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

Mailed: September 28, 2007

Opposition No. 91165451

NEW BALANCE ATHLETIC SHOE, INC.

v.

S.A.S.C.A. TRADING, INC.

Cheryl Butler, Attorney, Trademark Trial and Appeal Board:

Applicant seeks to register the following mark



for "jackets, coats, pants, shirts, shorts, t-shirts, swimwear, underwear, sweat shirts, sweat pants, jogging suits, and vests."¹ Opposer, as grounds for the opposition, alleges priority and likelihood of confusion with its registered marks P.F. (stylized) for "footwear, specifically rubber-soled canvas footwear"² and PF (standard character) for "footwear" and "sporting articles-namely, skates and athletic shoes."³

This case now comes up on opposer's fully-briefed motion, filed April 19, 2007, to compel "supplemental and adequate responses" to

¹ Application Serial No. 76575509, filed on February 13, 2004, claiming a *bona fide* intent to use the mark in commerce.

² Registration No. 0429057.

³ Registration No. 1236457.

its first set of Interrogatory Nos. 6, 6(f) and 11 and first requests for production of Documents Nos. 1, 4, 5, 6, and 7.

In response, applicant indicates that it has supplemented its discovery responses twice since opposer filed its motion to compel; that, as shown by its May 22, 2007 letter, opposer "effectively concedes" that applicant has provided adequate discovery responses to most of the matters raised by opposer's motion; that only one matter remains in dispute; and that to provide the information sought by the remaining outstanding matter imposes an undue burden on applicant. More specifically, applicant contends that there are twelve categories of clothing items identified in the application; that the PF mark has been in use for nearly eight years as part of applicant's "Pacific Flyer" line of clothes; and that over 2000 product styles have been created during the eight-year period, but not all items carry the PF mark. Applicant argues that its records do not always identify whether the PF mark was used; that finding the "annual sales figures for each product or service from the date of first use" would be extremely burdensome and bring applicant's business "to a grinding halt for a protracted period of time"; that opposer is not entitled to the information in the form it seeks because the dates of first use of the twelve categories of listed items are irrelevant to this proceeding; and that "there is no dispute that SASCO has been using the PF mark in its various clothing items since 1999" as shown by other documents already produced. Applicant argues that opposer's proposal that, in

exchange for applicant not providing the information sought, applicant waive its right to produce any evidence that "the applied-for mark was, or is, in use" is untenable. Applicant suggests a discovery deposition as a means to provide the additional information sought about the items listed in the application.

According to its letter, opposer is seeking the following information, attributed to portions of Interrogatory No. 6:

For each different type of product or service offered by Applicant, or partner or any Affiliate, in the United States, with which the Applicant, partner or any Affiliate, currently uses or plans to use the mark PF:

- a. identify each product or service by supplying its generic name;
- e. give the inclusive dates during which Applicant or any Affiliate has offered or sold each product or service in the United States, if such offers or sales have occurred;
- f. provide the annual sales figures of each product or service from the date of first use of the mark "PF" in the United States on or in association with each product or service, if any such sales have occurred.

In its letter, opposer states that a dispute as to applicant's use exists because applicant's application is based on intent-to-use. Opposer suggests that, should applicant not respond to the outstanding discovery sought, applicant waive its right to produce evidence that its mark was or is in use and rely instead on the filing date of the application.

In its motion to compel, opposer's articulated complaint is that applicant "has not described the dates of use of its mark for each of the products listed in the application" but provides a

general date of "since 1999." Opposer seeks the dates of use, if any, for each product listed in the application.

Applicant's response to Interrogatory No. 6(a), "applicant's products include men's, boy's and women's polo shirts, woven shirts, t-shirts, active wear, bottoms, and denim wear," is not disputed by the parties despite reference to it in opposer's May 22, 2007 letter. Opposer has not said why it believes the response is inadequate and, combined with the items listed in the application, the response appears sufficient on its face. It is not necessary that applicant list the specific styles for each clothing items, which number 2000 according to applicant. After all, any determination of likelihood of confusion will be made on the basis of the identification of goods set forth in the application. See *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 63 USPQ 1303, 1311 (Fed. Cir. 2002) (registrability must be determined "on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of the goods are directed."), citing *Octocom Sys., Inc. v. Houston Computer Serv., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Accordingly, to the extent opposer's motion to compel includes applicant's response to Interrogatory No. 6(a), the motion is denied. Applicant is reminded that, while it need not provide discovery with respect to those of its marks and goods

that are not involved in the proceeding, information that applicant may sell the same goods (if accurate) as those sold by opposer, even if under a different mark, is relevant to the issue of likelihood of confusion. See TBMP §414(11) (2d ed. rev. 2004).

As a general proposition, information concerning a party's first use of its involved mark is discoverable. See TBMP §414(5) (2d ed. rev. 2004). It is not necessary for applicant to provide dates of use for each of its 2000 product styles. However, applicant should be able to provide a date of first use, and information about whether such use is current or has ceased, for each of the twelve "categories" of items listed in its application. At a very minimum, applicant should be able to provide an estimated date in good faith. Thus, if applicant has not yet used its mark on "jackets" but has used its mark on "shirts" since 1999, it should so state. After all, if applicant is willing to produce a 30(b)(6) witness, as it suggested as an alternative, to provide this information, the information must be known or be reasonably ascertainable.

The Board notes that any information about applicant's use of its mark has no bearing on priority should opposer introduce evidence of its ownership of its pleaded registrations and evidence that such registrations are valid and subsisting. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). However, the information may

have some relevance in a likelihood of confusion analysis, including whether the marks have coexisted, and for how long, in the marketplace without incidents of actual confusion. The information may have some relevance, as well, to any settlement possibilities the parties may contemplate.

Applicant has stated that "the dates of first use for the 12 Categories are simply irrelevant to this opposition proceeding." This statement is inconsistent with its argument that opposer's suggestion of applicant waiving its right to produce any evidence of use of its mark and relying instead on its application filing date in exchange for not providing the information sought is "untenable."

Accordingly, opposer's motion to compel is granted, as discussed above, with respect to Interrogatory No. 6(e). Applicant's time to respond is set later in this order.

In general, annual sales figures, stated in round numbers, for a party's involved goods or services sold under its involved mark are proper matters for discovery. See TBMP §414(18) (2d ed. rev. 2004). However, where complete compliance with a particular request for discovery would be unduly burdensome, the Board may permit the responding party to comply by providing some reduced amount of information which is nevertheless sufficient to meet the propounding party's discovery needs. See TBMP §414(2) (2d ed. rev. 2004).

Here, applicant has explained that providing "annual sales figures for each product or service from the date of first use" would be extremely burdensome. Applicant is reminded that it need not provided annual sales figures for each of the 2000 product styles. Instead, the information sought pertains to any of twelve items, referred to by applicant as "categories," listed in the application for which applicant has commenced use. The Board understands that applicant does not keep separate records for the clothing items by mark. However, applicant likely keeps annual sales figures and has an idea of what percentage of its annual sales are under the PF mark. Thus, applicant should, at a minimum, be able to give a good faith estimate of its annual sales under the PF mark as a gross figure. If known, or reasonable ascertainable, applicant should be able to provide a good faith estimate of the percentage of annual sales by clothing items listed in the application (e.g., two percent of the annual sales in 1999 under the PF mark were for "jackets"). Another option is to limit the period for the information sought, for example to the past five years. The parties, may yet mutually agree to any other reasonable option.

Again, the information may have some relevance in a likelihood of confusion analysis, including the extent of applicant's use and any overlap with opposer. The information also may have a bearing on any potential settlement discussions between the parties.

Accordingly, applicant's objection that the information sought is unduly burdensome is sustained in part. Applicant is not required to cease its operations to find the information and is not required to provide the information as to 2000 product styles. However, opposer's motion to compel is granted in part, under the guidelines set forth above, with respect to Interrogatory No. 6(f). The parties are to work together to provide opposer with at least a good faith estimate of applicant's annual sales under the PF mark for the goods listed in the application. (Of course, where applicant has not yet used its mark on the goods, it is understood that no annual sales figures are available.) Applicant's time to respond is set later in this order.

The parties are commended for the cooperation in narrowing the discovery dispute presented herein. To the extent the Board's guidelines with respect to Interrogatory No. 6(f) do not provide adequate alternatives to reduce or eliminate any undue burden on applicant in responding, the Board believes that the parties should be able to work together to find a mutually agreeable solution.

Applicant is allowed until **THIRTY DAYS** from the mailing date of this order to supplement its responses to Interrogatory Nos. 6(e) and (f), as discussed above.

Proceedings are resumed. Discovery, which has been open for about two years, is closed.⁴ Trial dates are reset as follows:

THE PERIOD FOR DISCOVERY TO CLOSE:	CLOSED
30-day testimony period for party in position of plaintiff to close	December 15, 2007
30-day testimony period for party in position of defendant to close:	February 13, 2008
15-day rebuttal testimony period to close:	March 29, 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 Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

⁴ The Board has the inherent authority to schedule the disposition of cases on its docket. See *Carrini, Inc. v. Carla Carini, S.r.L.*, 57 USPQ2d 1067, 1071 (TTAB 2000). See also *Opticians Ass'n of America v. Independent Opticians of America, Inc.*, 734 F.Supp. 1171, 14 USPQ2d 2021 (D. N.J. 1990), rev'd on other grounds, 920 F.2d 187, 17 USPQ2d 1117 (3d Cir. 1990).