

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

Baxley

Mailed: November 25, 2009

Opposition No. 91166487

Hasbro, Inc.

v.

Creative Action, LLC

Andrew P. Baxley, Interlocutory Attorney:

This case now comes up for consideration of applicant/counterclaim plaintiff Creative Action, LLC's ("Creative") motion (filed October 6, 2009) to compel discovery. The motion has been fully briefed.¹

As an initial matter, the Board finds that Creative made a good faith effort to resolve the parties's discovery dispute, in compliance with Trademark Rule 2.120(e)(1), prior to seeking Board intervention.

A single document request is at issue in Creative's motion. In document request no. 22, Creative seeks "[a]ll documents that relate to any inter partes proceedings or

¹ In view of the Board's expedited decision on the motion to compel, Hasbro, Inc.'s ("Hasbro") request that the Board hold the motion to compel in abeyance and resume proceedings so that it can file a motion for leave to file an amended notice of opposition is moot. Moreover, any arguments in connection with Hasbro's apparent intent to seek leave to file an amended notice of opposition are not germane to Creative's motion to compel and have therefore received no consideration. See the Board's October 8, 2009 suspension order.

litigation in which ... [Hasbro] has been or is involved that refers to or relates to the mark MEMORY." Hasbro responded with a series of objections, including that such request is overly broad and unduly burdensome, but also indicated that it would produce publicly filed responsive documents. Hasbro later indicated that it would produce publicly available documents associated with *Hasbro, Inc. v. MGA Entertainment, Inc.*, Docket No. CA-06-262S (D.R.I.), so long as Creative agreed to pay for the expense of copying such documents.

Information concerning litigation and controversies including settlement and other contractual agreements between a responding party and third parties based on the responding party's involved mark is discoverable. See *J.B. Williams Co. v. Pepsodent GmbH*, 188 USPQ 577, 580-81 (TTAB 1975); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 172 (TTAB 1975); TBMP Section 414(10) (2d ed. rev. 2004). However, it is well-settled that the only information which must be provided with respect to a legal proceeding is the names of the parties thereto, the jurisdiction, the proceeding number, the outcome of the proceeding, and the citation of the decision (if published). See *Interbank Card Ass'n v. United States National Bank of Oregon*, 197 USPQ 127, 128 (TTAB 1975); TBMP Section 414(10) (2d ed. rev. 2004).

Creative's assertion that this limitation on information that must be provided applies to responses to interrogatories and not to responses to document requests is unsupported and is not well-taken. "Information," as used throughout TBMP Section 414, encompasses both information sought through interrogatories and documents which provide responsive information. Further, the Board, in *Johnson & Johnson v. Rexall Drug Co.*, *supra* at 172, determined that a responding party need not identify all documents pertaining to litigation with third parties. Because a responding party is not required to identify such documents, it follows that the responding party is also not required to produce those documents.

Moreover, if said litigation was dismissed on the basis of an agreement between the parties, representations made as an incident to compromise agreements can afford no rights to either of the parties and do not have a proper bearing on the merits of this case. If the parties involved in such litigation are prohibited from the exploitation of information obtained as a result of their attempts to settle the case, a nonparty to that litigation may not be provided with such information. See *Interbank Card Ass'n v. United States National Bank of Oregon*, *supra*. See also Fed. R. Evid. 408.

Based on the foregoing, Hasbro's objections that such request is overly broad and that such request is unduly burdensome are sustained. Creative's motion to compel is denied.

Proceedings herein are resumed. Dates are reset as follows.

THE PERIOD FOR DISCOVERY TO CLOSE: December 24, 2009

30-day testimony period for plaintiff in the opposition to close: March 24, 2010

30-day testimony period for defendant in the opposition and as plaintiff in the counterclaim to close: May 23, 2010

30-day testimony period for defendant in the counterclaim and its rebuttal testimony as plaintiff in the opposition to close: July 22, 2010

15-day rebuttal testimony period for plaintiff in the counterclaim to close: September 5, 2010

Briefs shall be due as follows:
[See Trademark rule 2.128(a)(2)].

Brief for plaintiff in the opposition shall be due: November 4, 2010

Brief for defendant in the opposition and as plaintiff in the counterclaim shall be due: December 4, 2010

Brief for defendant in the counterclaim and its reply brief (if any) as plaintiff in the opposition shall be due: January 3, 2011

Reply brief (if any) for plaintiff in the counterclaim shall be due: January 18, 2011

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.

If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.