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

Mailed: September 30, 2011

Opposition No. 91176065

Lenovo (Singapore) Pte. Ltd

v.

H. Co. Computer Products

George C. Pologeorgis,
Interlocutory Attorney:

This case now comes before the Board for consideration of applicant/counterclaim plaintiff's ("H. Co. Computer") motion to compel discovery filed on September 23, 2011.

The Board, in its discretion, suggested that the issues raised in H. Co. Computer's motion should be resolved by telephonic conference as permitted by TBMP § 502.06 (3d ed. 2011). The Board contacted the parties to discuss the date and time for holding the phone conference. While the Board notes that opposer/counterclaim defendant's ("Lenovo") time to respond to the motion has yet to expire, the Board advised that it would permit Leveno to respond on the merits during the telephone conference. See TBMP 413.01 (3d. ed. 2011).

The parties agreed to hold a telephone conference at 1:30 p.m., Eastern Time on Friday, September 30, 2011. The

conference was held as scheduled among Gary J. Nelson and Steven E. Lauridsen, as counsel for H. Co. Computer, Steven D. Ference III and Brian Malkin, as counsel for Lenovo, and George C. Pologeorgis, as a Board attorney responsible for resolving interlocutory disputes in this case.

The Board carefully considered the arguments raised by the parties, as well as the supporting correspondence and the record of this case, in coming to a determination regarding the above matters. During the telephone conference, the Board made the following findings and determinations:

H. Co. Computer's Motion to Compel

Initially, the Board finds that H. Co. Computer has made a good faith effort to resolve the parties' discovery dispute prior to seeking Board intervention, as required by Trademark Rule 2.120(e)(1).

By way of its motion to compel, H. Co. Computer seeks responses to its Document Request No. 1 and its First Set of Interrogatory Requests. In its motion papers, H. Co. Computer contends that it served its document requests on July 1, 2010 and its interrogatory requests on December 14, 2010. H. Co. Computer further maintains that Lenovo has yet to respond to H. Co. Computer's interrogatory requests because it claims they were untimely served and nonetheless exceed the 75 limit provided under Board rules. Moreover,

H. Co. Computer maintains that Lenovo has not responded to its Document Request No. 1, which seeks documents used by Lenovo in preparing its responses to H. Co. Computer's interrogatory requests.

During the telephone conference, Lenovo's counsel maintained that Lenovo never received H. Co. Computer's interrogatory requests that were served on December 14, 2011; but did receive said requests when H. Co. Computer re-served the requests on March 2, 2011. Lenovo's counsel further argued that the interrogatories served on March 2, 2011 were untimely because the discovery period, at the time the interrogatories were received, was extended not for the purposes of propounding any further discovery but for the limited purpose of finalizing discovery already propounded. In addition to his contention that the interrogatory requests were untimely, Lenovo's counsel argued that the interrogatory requests nonetheless exceed the 75 limit permitted under Board rules.

The Board notes that discovery closed in this proceeding on July 27, 2011. The Board further notes that the parties' stipulations to extend discovery filed from November 2010 until June 2011 only state that the parties need more time to complete discovery, which could include propounding discovery in the first instance. Whether the parties agreed amongst themselves to extend discovery for

discrete limited purposes was never relayed to the Board in their stipulations to extend. In view thereof and since discovery closed on July 27, 2011, we find that C. Co. Computer's interrogatory requests were timely served on March 2, 2011.

Based upon the foregoing, the Board makes the following rulings regarding the discovery requests in dispute:

1. Interrogatory Requests

Interrogatory No. 3

Identify each owner, co-owner, shareholder, director, officer, and managing agent of Lenovo and all of its subsidiaries, local chapters, and affiliates.

The Board finds this interrogatory overly broad and burdensome. Accordingly, motion is **denied** with this particular interrogatory request.

Interrogatory No. 48

Identify all documents upon which Lenovo intends to rely in this proceeding.

Regardless of when proceedings commenced (i.e., before or after November 1, 2007), a party is not required, in advance of trial, to disclose each document or other exhibit it plans to introduce. TBMP § 414(7) (3d ed. 2011). Accordingly, motion is **denied** in regard to this interrogatory request.

Interrogatory No. 49

Identify all witnesses from whom Lenovo intends to present evidence in this proceeding.

For proceedings commenced prior to November 1, 2007, as is the case here, a party need not in advance of trial, identify the witnesses it intends to call, except that the names of expert witnesses intended to be called are discoverable. TBMP § 414(7) (3d ed. 2011). Inasmuch as H. Co. Computer has propounded a separate interrogatory request seeking the identity of expert witnesses, the motion is **denied** with regard to this interrogatory request.

Interrogatory Nos. 55

For each of HCCP's First Set of Requests for Admission denied by Leveno, state in reasonable detail the basis for such denial.

The Board notes that allowing service of an interrogatory which requests disclosure of all the information which the denials of each request for admission is based essentially transforms each request for admission into an interrogatory. This is not the purpose requests for admissions were intended to serve, and because Fed. R. Civ. P. 36 imposes no numerical limit on the number of requests for admissions that may be served, condoning such a practice would circumvent the numerical limit of interrogatories permitted in Board proceedings. *See generally*, *Colony Insurance Co.*

v. Harold Kuehn, 2011 U.S. Dist. LEXIS 06884 (D.C. Nev. September 20, 2011). In view of the foregoing, the motion is **denied** in regard to this interrogatory request.

Interrogatory Nos. 1-2, 4-47, 50-54, 56-57

Motion **granted** with respect to each of the above-identified interrogatory requests.

In view of the above rulings, the Board finds that H. Co. Computer's Interrogatory Request Nos. 1-2, 4-47, 50-54, 56-57, the responses of which are now compelled by this order, do not exceed the 75 limit of interrogatory requests permitted in Board proceedings.

2. Document Requests

Document Request No. 1

Motion is **granted** to the extent that opposer must produce responsive non-privileged documents requested to be identified in, or actually identified by Lenovo, in responding to C. Co. Computer's Interrogatory Nos. 1-2; 4-47; 50-54; and 56-57. Motion is **denied**, however, to the extent the above-identified document request relates to C. Co. Computer's Interrogatory Nos. 3, 48-49 and 55.

In view of the foregoing, C. Co. Computer's motion to compel is **granted**, in part, and **denied**, in part.

During the telephone conference, the parties indicated that they have been conducting serious settlement negotiations. In view thereof, the Board inquired whether

the parties desired to suspend this proceeding so they can concentrate on their settlement efforts. The parties agreed to a three month suspension period for settlement.

Accordingly, proceedings herein remain suspended until **January 3, 2012** for settlement, subject to the right of either party to request resumption at any time. See Trademark Rule 2.117(c).[1]

In the event that there is no word from either party concerning the progress of their negotiations, upon conclusion of the suspension period, proceedings shall resume without further notice or order from the Board, upon the schedule set out below.

Proceedings resume: **January 4, 2012**

Lenovo is allowed **thirty days** from resumption to produce non-privileged responsive documents to H. Co. Computer's Document Request No. 1 to the extent indicated herein, if it has not already done so.

Lenovo is allowed the same **thirty days** upon resumption, as provided above, to serve upon H. Co. Computer responses to H. Co. Computer's Interrogatory Request Nos. 1-2, 4-47, 50-54, 56-57.

[1] In light of this order, H. Co. Computer's consented motion (file September 22, 2011) to extend trial dates is deemed moot and will be given no further consideration.

Additionally, Lenovo is required to provide H. Co. Computer a privilege log within the same **thirty days** set forth above to the extent that Lenovo claims privilege to any of H. Co. Computer's discovery requests, if it has not yet done so.

Similarly, in the event Lenovo fails to provide H. Co. Computer with full and complete responses to the outstanding discovery, as required by the instant order, Lenovo will be barred from relying upon or later producing documents or facts at trial withheld from such discovery. *See* Fed. R. Civ. P. 37(c)(1).[2]

Trial dates are reset as follows:

THE PERIOD FOR DISCOVERY TO CLOSE:	**CLOSED**
Testimony period for plaintiff in the opposition to close: (opening thirty days prior thereto)	**3/30/2012**
Testimony period for defendant in the opposition and as plaintiff in the counterclaim to close: (opening thirty days prior thereto)	**5/29/2012**
Testimony period for defendant in the counterclaim and its rebuttal testimony as plaintiff in the opposition to close: (opening thirty days prior thereto)	**7/28/2012**

[2] If Lenovo fails to comply with this order, H. Co. Computer's remedy lies in a motion for sanctions, pursuant to Trademark Rule 2.120(g)(1). Furthermore, the parties are reminded that a party that has responded to a discovery request has a duty to supplement or correct that response. See Fed. R. Civ. P. 26(e).

Rebuttal testimony period for plaintiff in the counterclaim to close: (opening fifteen days prior thereto)	**9/11/2012**

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

Brief for plaintiff in the opposition shall be due:	**11/10/2012**
Brief for defendant in the opposition and as plaintiff in the counterclaim shall be due:	**12/10/2012**
Brief for defendant in the counterclaim and its reply brief (if any) as plaintiff in the opposition shall be due:	**1/9/2013**
Reply brief (if any) for plaintiff in the counterclaim shall be due:	**1/24/2013**

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 Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.