

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

Baxley

Mailed: April 30, 2013

Opposition No. **91176065**

Lenovo (Singapore) Pte. Ltd

v.

H. Co. Computer Products

Before Bucher, Taylor, and Mermelstein,
Administrative Trademark Judges.

By the Board:

In a September 30, 2011, order, the Board granted in part and denied in part the motion to compel that applicant/counterclaim plaintiff H. Co. Computer Products' ("H. Co.") filed on September 23, 2011. In that order, the Board, rejecting opposer/counterclaim defendant Lenovo (Singapore) Pte. Ltd's ("Lenovo") assertions that interrogatories that H. Co. served on March 2, 2011, were untimely and that H. Co.'s interrogatories exceed the numerical limit of seventy-five for Board proceedings, allowed Lenovo until February 3, 2012, to:

(1) serve responses to H. Co.'s Interrogatory Request Nos. 1-2, 4-47, 50-54, 56-57;¹

(2) respond to document request no. 1 by producing responsive non-privileged documents requested to be identified in, or actually identified in Lenovo's responses to H. Co.'s interrogatory nos. 1-2; 4-47; 50-54; and 56-57; and

(3) serve a privilege log to the extent that Lenovo claims privilege to any of H. Co.'s discovery requests, if it has not yet done so.

In that order, the Board further stated that, if "Lenovo fails to provide H. Co. [] 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." As a result of extensions that the Board granted in January 5, 2012, and February 28, 2012, orders, Lenovo's time to comply with the September 30, 2011, order was extended to August 3, 2012.

¹ In the September 30, 2011, order, the Board denied the motion to compel with regard to interrogatory nos. 3, 48, 49, and 55.

This case now comes up for consideration of H. Co.'s motion (filed August 27, 2012) for entry of sanctions under Trademark Rule 2.120(g)(1) based on Lenovo's failure to comply with the Board's September 30, 2011 order. The motion has been fully briefed.

In support of the motion for sanctions, H. Co. contends that Lenovo responded on August 3, 2012, to the interrogatories and document request at issue in the September 30, 2011, order by renewing objections that the Board already overruled in that order and "direct[ing H. Co.] to the corresponding Requests for Production and Documents produced therewith"; and that Lenovo's responses "smack of bad faith" and disregard the September 30, 2011, order.² Accordingly, H. Co. contends that sanctions in the nature of the preclusion sanctions expressly mentioned in the September 30, 2011, order or entry of judgment against Lenovo is warranted.

In response, Lenovo contends that H. Co. failed to meet and confer with Lenovo prior to filing the motion for entry of sanctions; that the interrogatories at issue in

² H. Co. also alleges in the motion for sanctions that Lenovo improperly relied upon and applied the option to produce business records under Fed. R. Civ. P. 33(d) in responses to several interrogatories, including interrogatory nos. 5, 6, 10, 13, 17, 19, and 26. However, Lenovo's responses to those interrogatories were not at issue in the motion to compel that resulted in the September 30, 2011, order.

the motion to compel and the motion for entry of sanctions were untimely served; and that Lenovo produced more than 10,000 pages of discovery documents in February 2011 which provide all the relevant information that H. Co. seeks. Accordingly, Lenovo asks that the Board deny the motion for entry of sanctions.

In reply, H. Co. contends that it is not required to meet and confer with Lenovo prior to filing a motion for entry of sanctions under Trademark Rule 2.120(g)(1); that Lenovo's objection that H. Co.'s interrogatories were untimely was already overruled in the September 30, 2011, order; that Lenovo failed to timely file a request for reconsideration of the September 30, 2011, order; and that, instead of arguing that the requested sanctions are "too severe," Lenovo has argued that sanctions are not warranted.

As an initial matter, if Lenovo believed that the September 30, 2011, order was in error, it should have timely filed a request for reconsideration of that order no later than October 30, 2011, instead of renewing its already overruled untimeliness objection in its brief in response to the motion for entry of sanctions. See Trademark Rule 2.127(b). To the extent that Lenovo's arguments in the brief in response to the motion for entry

of sanctions are intended as a request for reconsideration of the September 30, 2011, order, that request is untimely. However, the Board notes that the September 30, 2011, contains an error that warrants modification. See TBMP Section 518.

In the September 30, 2011, order, the Board states as follows:

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 [H. Co.'s interrogatories] were timely served on March 2, 2011.

Under the Board's January 18, 2011, order, the discovery period was reset to close on February 13, 2011. In H. Co.'s February 11, 2011, consented motion to extend the close of discovery, which the Board granted in a February 14, 2011, order, H. Co. stated as follows: "As a condition of this extension, the parties agree that they will use this period to complete all outstanding discovery and that they will not serve additional discovery requests

during this time.”³ This statement was repeated in H. Co.’s April 12, 2011, June 13, 2011, and June 27, 2011, consented motions to extend discovery, which were granted on April 13, 2011, June 23, 2011, and July 6, 2011. In addition, in Lenovo’s June 27, 2011, consented motion to extend discovery, Lenovo stated that the “[p]arties have stipulated that additional time will be used only to respond to outstanding discovery and not for propounding additional discovery.” Accordingly, the record clearly indicates that the parties had agreed that they would not serve new discovery requests after February 13, 2011.

The record indicates that H. Co. served its first set of interrogatories by mail on December 14, 2010.⁴ The certificate of service of the interrogatories served on December 14, 2010, is signed by Roxanne Gaines, a senior legal assistant for H. Co.’s attorney, and indicates that such interrogatories were sent to Lenovo’s attorney of record as his address of record by first-class mail on that date. This certificate is accepted as *prima facie* proof of

³ Usually, a party is allowed until the closing date of the discovery period to serve interrogatories, document requests, and requests for admission. See Trademark Rule 2.120(a)3). Under the circumstances, the better practice would have been to seek to extend dates so as to postpone the commencement of trial after the close of discovery.

⁴ H. Co submitted a copy of these interrogatories as an exhibit to the motion to compel.

service, which H. Co. has not rebutted. See Trademark Rule 2.119(a). H. Co. further supported the certificate of service by submitting a declaration of Ms. Gaines in which she avers to her service of the first set of interrogatories on that date.

H. Co. also served a courtesy copy of those interrogatories on March 2, 2011, after Lenovo claimed not to have received them. Although the courtesy copy was served after the agreed-upon deadline for service of new discovery requests, the Board finds that the March 2, 2011, service was merely a courtesy copy and that the December 14, 2010, interrogatories were timely served, notwithstanding Lenovo's nonreceipt thereof. Accordingly, Lenovo's objection to those interrogatories as untimely is again overruled. The Board will entertain no further arguments regarding the timeliness of H. Co.'s first set of interrogatories.

Turning to the motion for entry of sanctions, Trademark Rule 2.120(g)(1) states, in relevant part, as follows: "If a party fails to comply with an order of the Trademark Trial and Appeal Board relating to discovery, ... the Board may make any appropriate order, including any of the orders provided in Rule 37(b)(2) of the Federal Rules of Civil Procedure...." "[T]here is no requirement that a

party make a good faith effort to resolve the parties' dispute prior to filing a motion for entry of discovery sanctions." *HighBeam Marketing LLC v. Highbeam Research LLC*, 85 USPQ2d 1902, 1904 (TTAB 2008). Compare Trademark Rules 2.120(e)(1) with 2.120(g)(1). See TBMP Section 527.01(a).

Lenovo's contention that H. Co. was required to meet and confer with Lenovo prior to filing the motion for entry of sanctions is incorrect. *HighBeam Marketing LLC v. Highbeam Research LLC*, *supra*; TBMP Section 527.01(a). Lenovo's reliance upon Fed. R. Civ. P. 37(d)(2) is inappropriate. This is not a motion to compel discovery, but a motion for sanctions for failure to comply with the Board's prior order compelling discovery. To the extent it is relevant, the analogous Federal Rule is Fed. R. Civ. P. 37(b), not 37(d).⁵ In any event, Trademark Rule 2.120(e)(1) expressly requires a good faith effort to resolve a discovery dispute prior to the filing of a motion to compel; however, Trademark Rule 2.120(g)(1), which is the relevant authority, includes no such requirement prior to

⁵ Fed. R. Civ. P. 37(d), which has no direct analog in Board procedure, permits the filing of a motion for sanctions when, *inter alia*, the non-movant has failed to serve any response to interrogatories, even in the absence of a previous order compelling discovery. That is clearly not the basis for H. Co.'s current motion.

the filing of a motion for discovery sanctions. See TBMP Section 527.01(a).

Further, under the circumstances herein, it was incumbent upon Lenovo to comply fully and promptly with the September 30, 2011, order or to timely file a request for reconsideration of that order. Instead of complying with that order, Lenovo responded to the interrogatories and document requests at issue in the motion to compel on August 3, 2012, by renewing an objection that the Board had overruled ten months earlier. This response indicates a clear disregard for the requirements of the September 30, 2011, order.

We are convinced that Lenovo has deliberately sought to evade and frustrate H. Co.'s attempts to secure discovery. Lenovo's conduct tries our patience and has delayed this proceeding unnecessarily. However, because the Board erred in its analysis, but not in its ultimate conclusion, regarding the timeliness of the service of H. Co.'s first set of interrogatories, we find that entry of a sanction against Lenovo would be an unduly harsh remedy at this time. In view thereof, H. Co.'s motion for entry of sanctions is hereby denied.

Notwithstanding the foregoing, Lenovo is allowed until thirty days from the mailing date set forth in this order

to: (1) serve upon H. Co. **full and complete responses** to H. Co.'s Interrogatory Request Nos. 1-2, 4-47, 50-54, 56-57; (2) respond to document request no. 1 by (a) serving upon H. Co. all responsive, non-privileged documents that were requested to be identified in, or were actually identified in Lenovo's responses to H. Co.'s interrogatory nos. 1-2; 4-47; 50-54; and 56-57 that have not yet been produced, indicating the interrogatory to which each newly produced document is responsive; and (b) producing an index which specifies, by Bates number, the documents already produced that are responsive to each interrogatory at issue; and (3) serve upon H. Co. a privilege log to the extent that Lenovo claims privilege to any of H. Co.'s discovery requests, if it has not yet done so. See Fed. R. Civ. P. 33(d)(1). Lenovo will not be permitted any extensions of time to so serve without first obtaining and filing with the Board H. Co.'s written consent thereto. The burden of complying with this order lies with Lenovo. If Lenovo fails to comply fully with this order, judgment may be entered against it, upon motion by H. Co. See *Unicut Corporation v. Unicut, Inc.*, 222 USPQ 341 (TTAB 1984).

Proceedings herein are resumed. Dates are reset as follows.

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30-day testimony period for
plaintiff in the opposition to close: July 29, 2013

30-day testimony period for defendant in the opposition
and as plaintiff in the counterclaim to close: September 27, 2013

30-day testimony period for defendant
in the counterclaim and its rebuttal testimony
as plaintiff in the opposition to close: November 26, 2013

15-day rebuttal testimony period for plaintiff
in the counterclaim to close: January 10, 2014

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

Brief for plaintiff in the opposition shall be due: March 11, 2014

Brief for defendant in the opposition and as
plaintiff in the counterclaim shall be due: April 10, 2014

Brief for defendant in the counterclaim and its reply
brief (if any) as plaintiff in the opposition
shall be due: May 10, 2014

Reply brief (if any) for plaintiff in the
counterclaim shall be due: May 25, 2014

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. An oral hearing will be set only upon request
filed as provided by Trademark Rule 2.129.

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