

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

Mailed: April 1, 2009

Opposition No. 91176901

Bodyonics, Ltd.

v.

Jeffrey Lee Kaplan, and
Ilie Iconcescu

**Robert H. Coggins,
Interlocutory Attorney:**

This case now comes up on applicants' motion (filed September 11, 2008) to compel discovery responses. Opposer filed an untimely brief in opposition thereto. The Board exercises its discretion to consider opposer's late brief.¹

Motion to Compel

By way of the motion, applicants seek a Board order requiring opposer to respond to Interrogatory Nos. 2, 4, 6, 7, 8, 12, 13, 14, 15, and 16, and to produce responsive documents for Document Request Nos. 1, 3, 4, 5, 8, 9, 10, and 11.

Opposer's brief in opposition to the motion to compel is based on opposer's statement that it has previously

¹ The parties were previously advised (in the November 14, 2008 suspension order) of the possibility of the exercise of the Board's discretion to consider opposer's late brief.

provided applicants with product labels which list the ingredients in opposer's products, and a belief that the channels of trade for the goods of the parties must be presumed to be the same in the absence of any limitation by either party to the channels of trade.

As a preliminary matter, the Board finds that applicants have shown that they made a good faith effort, pursuant to Trademark Rules 2.120(e)(1) and 2.120(h)(1), to resolve with opposer the outstanding discovery issues presented in the aforementioned motion prior to seeking Board intervention.

Interrogatories

Interrogatory No. 2 seeks the identity of documents involved in the evolution, selection, searching, and registration of opposer's POPPERS mark. Information concerning a party's selection and adoption of its involved mark is generally discoverable. TBMP § 414(4) (2d ed. rev. 2004). Search reports are discoverable, but the comments or opinion of attorneys relating thereto are privileged and not discoverable (unless the privilege is waived). TBMP § 414(6). Opposer's objection is overruled. Opposer is directed to amend its response accordingly.

Interrogatory No. 4 seeks the identity of documents involved in the selection of ingredients used in opposer's dietary supplements. Opposer's objection is sustained. In

Opposition No. 91176901

its brief in opposition to the motion, opposer states that it has provided applicants with a list of ingredients contained in opposer's dietary supplements. Applicants did not file a brief in reply to dispute that they have a list of opposer's ingredients. While the ingredients of the parties' respective goods may be relevant to the extent they comprise the end goods, the process of selecting those ingredients is not. Accordingly, opposer need not respond further to Interrogatory No. 4.

Interrogatory No. 6 seeks the identity of persons who have responsibility for researching, developing, and manufacturing opposer's goods. Opposer's objection is sustained. Applicants' contention that this information is necessary to determine the channels of trade and whether opposer's product has energy-producing properties is untenable. As previously noted, opposer has provided applicants with a list of ingredients contained in opposer's dietary supplements. While these ingredients may be relevant to the issues in this proceeding to the extent they comprise the end goods, the people who developed them are not. Accordingly, opposer need not respond further to Interrogatory No. 6.

Interrogatory No. 7 seeks the ingredients of opposer's dietary supplements. Opposer's objection based on relevance is overruled. However, because opposer has previously

Opposition No. 91176901

provided applicants with a list of ingredients contained in opposer's dietary supplements, opposer need not respond further to Interrogatory No. 7.

Interrogatory No. 8 seeks the policies and identity of documents related to opposer's use, display, and advertising of the term POPPERS. Opposer's objection as to ambiguity is sustained to the extent of stating its policies on use, display, and advertising of the term POPPERS, and identifying documents concerning use; however, opposer's other objections are overruled. To the extent opposer claims a likelihood of confusion based on its use of the term POPPERS and claims that term is descriptive or generic, the requested identification of documents concerning the display and advertising of that term by opposer is relevant. Opposer is directed to amend its response accordingly.

Interrogatory No. 12 seeks the periods of use, specific products on which were used, and the annual number used for each label, tag, decal, imprint or other means by which opposer sold goods under the POPPERS mark. Opposer's objection is overruled to the extent that the information sought relates to the number of units (stated in round numbers) for opposer's involved goods (those listed in opposer's pleaded application and registration) sold under the involved POPPERS mark; to such an extent, the

Opposition No. 91176901

information is relevant. Opposer is directed to amend its response accordingly.

Interrogatory No. 13 seeks the identity of each advertisement, catalog, brochure or other advertising means by which POPPERS has been used by opposer. Advertisements and the like are discoverable. Opposer's objection is overruled to the extent the interrogatory seeks the identity of advertisements, catalogs, brochures or other advertising material for which opposer has used the term POPPERS on the goods in opposer's pleaded application and registration. Opposer is directed to amend its response accordingly.

Interrogatory No. 14 seeks the period of use; the goods in connection with the use; the publication, radio station, web page, or television station which published or broadcast the use; and for brochures and catalogs, to whom and the time when such items were sent; for those materials identified in Interrogatory No. 13. Opposer's objection is overruled to the extent this interrogatory seeks to identify the classes of customers for the goods in opposer's pleaded application and registration, that is, to whom the material was directed. Opposer is directed to amend its response accordingly.

Interrogatory No. 15 seeks information concerning the advertising agencies and individuals at the agencies responsible for opposer's advertising account. Opposer's

Opposition No. 91176901

objection is overruled. The identity of any advertising agency engaged by opposer to advertise and promote the goods in opposer's pleaded application and registration and using the marks therein is discoverable, as is the identity of the advertising agency employees having the most knowledge of such advertising and promotion. See *J.B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577 (TTAB 1975) (may lead to relevant information concerning circumstances surrounding selection of mark and distinctiveness of mark). Opposer is directed to amend its response accordingly.

Interrogatory No. 16 seeks the identity of documents involved in the evolution, selection, searching, and registration of the ingredients of opposer's goods. Opposer's objection is sustained. Applicants' contention that this information is necessary to determine the channels of trade and whether opposer's products have energy-producing properties is untenable. As previously noted, opposer has provided applicants with a list of ingredients contained in opposer's goods. Opposer need not provide information on the evolution, selection, searching, or registration of those ingredients. Accordingly, opposer need not respond further to Interrogatory No. 16.

Requests for Production of Documents

Document Request No. 1 seeks documents relating to the creation and adoption of the POPPERS mark for those goods

Opposition No. 91176901

identified in Interrogatory No. 2. Although Interrogatory No. 2 sought information relating to the selection of opposer's mark -not opposer's goods- the Board interprets this document request to involve the goods identified in opposer's pleaded application and registration. To the extent this request seeks documents concerning opposer's selection and adoption of its involved mark for the goods identified in opposer's pleaded application and registration, such documents are discoverable. TBMP § 414(4). Opposer's objection is overruled. Opposer is directed to amend its response to this request accordingly.

Document Request Nos. 3 and 4 seek documents relating to the selection of the ingredients that comprise opposer's goods. Opposer's objection is sustained. As noted, *supra*, in the discussion of Interrogatory No. 4 (on which interrogatory Document Request No. 3 is based), opposer has stated that it has provided applicants with a list of ingredients contained in opposer's dietary supplements. While the ingredients of the parties' respective goods may be relevant to the extent they comprise the end goods, the process of selecting those ingredients is not relevant. Accordingly, opposer need not respond further to these document requests.

Document Request Nos. 5, 10, and 11 seek documents relating to advertisements, promotional materials,

publicity, and web pages used in connection with the sale of opposer's goods. Advertisements and the like are discoverable. Opposer's objections are overruled to the extent these requests seek a copy of the advertisements, promotional materials, and opposer's own web pages that opposer has used in the sale of the goods in opposer's pleaded application and registration bearing the term POPPERS. Opposer is directed to amend its responses to these requests accordingly.

Document Request No. 8 seeks documents relating to the exhibition of opposer's goods at trade shows and conventions. Opposer's objection is sustained. Applicants' contention that this information is necessary to determine the channels of trade is untenable as the consuming public purchases goods at the retail level. Opposer need not respond further to this document request.

Document Request No. 9 seeks documents relating to the evolution, selection, and registration of the individual ingredients of opposer's goods. Opposer's objection is sustained. As discussed, supra, at Interrogatory No. 16 (on which interrogatory Document Request No. 9 is based), applicants' contention that this information is necessary to determine the channels of trade and whether opposer's product has energy-producing properties is untenable. As previously noted, opposer has provided applicants with a

list of ingredients contained in opposer's goods. Opposer need not provide documentary evidence on the evolution, selection, or registration of those ingredients; therefore, opposer need not respond further to this document request.

Time to Respond

Opposer is allowed until thirty days from the mailing date of this order to fully respond to the discovery compelled herein.

Protective Order

The parties are informed that Trademark Rules 2.116(g) and 2.120(f) were amended effective August 31, 2007, to make the Board's standard protective order applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. *See Miscellaneous Changes to Trademark Trial and Appeal Board Rules*, 72 Fed. Reg. 42242 (Aug. 1, 2007). The Board's standard protective order is automatically in place in the instant opposition proceeding.

Duties of Parties

The parties are reminded that each has a duty to make a good faith effort to satisfy its adversary's discovery needs and to make a good faith effort to seek only such discovery as is proper and relevant to the issues in the case. *See* TBMP Section 408.01 (2d ed. rev. 2004). Furthermore, 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). The parties are also reminded that, when a party, without substantial justification, fails to disclose information required, or fails to amend or supplement a prior response, as required, that party may be prohibited from using as evidence the information not so disclosed. See Fed. R. Civ. P. 37(c)(1).

Motions for Sanctions

Applicants' motion included a request that the Board sanction opposer for delaying this proceeding, and opposer's brief also included a cross-motion for "appropriate" sanctions against applicants. The parties' cross-motions for sanctions are denied. The Board does not believe that either opposer's objections to the discovery sought or applicants' motion to compel discovery rises to a level of behavior that is -by itself- sanctionable. Notwithstanding this denial, the Board remains acutely aware that both parties have previously filed motions lacking in merit. The Board will not hesitate to sanction either party under appropriate circumstances. See *Chambers v. NASCO, Inc.*, 501 U.S. 32, 111 S.Ct. 2123, 115 L.Ed.2d 27, *rehearing denied*, 501 U.S. 1269, 112 S.Ct. 12, 115 L.Ed.2d 1097 (1991).

Resumption of Proceedings

Proceedings are resumed. As noted earlier, opposer is allowed until thirty days from the date of this order in which to amend its responses in accordance with the

discovery compelled herein. The close of discovery and trial dates are reset according to the schedule below.

Discovery period to close:	6/12/2009
30-day testimony period for party in position of plaintiff to close:	9/10/2009
30-day testimony period for party in position of defendant to close:	11/9/2009
15-day rebuttal testimony period to close:	12/24/2009

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 of 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.

News from the TTAB

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

Opposition No. 91176901

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>

http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>