

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

Brown

Mailed: April 29, 2008

Opposition No. 91178593  
Cancellation No. 92047863

CKX, Inc.

v.

Edward Kolos

**Angela Lykos, Interlocutory Attorney**

This case now comes before the Board for consideration of plaintiff's motion to compel (filed November 14, 2007). This motion is contested.

Concurrent with his response to plaintiff's motion to compel, defendant filed a cross-motion to reopen his time to respond to plaintiff's first set of interrogatories and first request for production of documents. This motion is uncontested.

For the following reasons, both motions are denied.

***I. Plaintiff's Motion to Compel***

As a threshold matter, the Board will evaluate whether plaintiff has satisfied its obligation under Trademark Rule 2.120(e) to make a good faith effort to resolve the discovery dispute herein prior to seeking Board

intervention. Trademark Rule 2.120(e) provides in pertinent part:

[A motion to compel] must be supported by a written statement from the moving party that such party or the attorney therefore has made a good-faith effort, by conference or correspondence, to resolve with the other party or the attorney therefore the issues presented in the motion and has been unable to reach agreement.

In its motion, plaintiff asserts that it made a good faith effort to resolve this dispute with an e-mail transmitted on November 5, 2007 to defendant.

Based on the record, however, the Board finds that plaintiff has not satisfied its obligation under Trademark Rule 2.120(e) to make a good faith effort to resolve the discovery dispute herein prior to seeking the Board's intervention. A single e-mail, inquiring about the status of the outstanding discovery responses, falls short of the good faith effort required of a moving party seeking to compel responses to outstanding discovery requests. This is especially true given that defendant was traveling overseas on business and did not receive plaintiff's e-mail until he returned to the United States. Moreover, instead of offering additional time to discuss the matter further or to obtain the requested discovery, plaintiff resorted to filing the instant motion to compel only nine days after transmitting the November 5, 2007 e-mail.

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In that regard, plaintiff is reminded that the purpose of discovery is to advance the case so that it may proceed in an orderly manner within reasonable time constraints. To this end, both parties must adhere to the strictures set forth in *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666 (TTAB 1986), and repeated below:

[E]ach party and its attorney has a duty not only to make a good faith effort to satisfy the discovery needs of its opponent but also to make a good faith effort to seek only such discovery as is proper and relevant to the specific issues involved in the case. Moreover, where the parties disagree as to the propriety of certain requests for discovery, they are under an obligation to get together and attempt in good faith to resolve their differences and to present to the Board for resolution only those remaining requests for discovery, if any, upon which they have been unable, despite their best efforts, to reach an agreement. Inasmuch as the Board has neither the time nor the personnel to handle motions to compel involving substantial numbers of requests for discovery which require tedious examination, it is generally the policy of the Board to intervene in disputes concerning discovery, by determining motions to compel, only where it is clear that the parties have in fact followed the aforesaid process and have narrowed the amount of disputed requests for discovery, if any, down to a reasonable number.

Accordingly, plaintiff's motion to compel is denied without prejudice.

In consequence of the above, the parties are directed to work together to resolve any future discovery problems, in the spirit of good faith and cooperation which is required of all litigants in Board proceedings. The Board believes that the parties should be able to resolve most, if

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not all, of the discovery disputes identified in their current motions. In particular, no subsequent motion to compel should be filed unless the parties are truly unable, after making their best efforts, to work out mutually acceptable solutions to their discovery problems without the Board's help.

***II. Defendant's Cross-Motion to Reopen his Time to Respond to Plaintiff's Outstanding Discovery Requests***

Although defendant's cross-motion is uncontested, the Board is exercising its discretion to consider the motion on the merits. See Trademark Rule 2.127(a).

A party which fails to respond to a request for discovery during the time allowed therefor, and which is unable to show that its failure was the result of excusable neglect, may be found, upon motion to compel filed by the propounding party, to have forfeited its right to object to the discovery requests on its merits. See *No Fear Inc. v. Rule*, 54 USPQ2d 1551 (TTAB 2000) ("No Fear"). Objections going to the merits of the discovery requests include claims that the information sought by the request is irrelevant, overly broad, unduly vague and ambiguous, burdensome and oppressive, or not likely to lead the to the discovery of the admissible evidence. See *Id.* In contrast, objections based on claims of privilege or confidentiality or attorney work product do not go to the merits of the request, but

instead to a characteristic of the information sought. See *Id.*

In this case, defendant indicates that after returning from his business trip that he served his responses to plaintiff's first set of interrogatories and request for production of documents. However, as defendant also admits, these responses were served after the agreed upon deadline of October 31, 2007 and therefore are late.

Insofar as defendant's responses and objections to plaintiff's discovery requests are late, and defendant has failed to show excusable neglect, defendant is deemed to have waived his right to object to the discovery requests on their merits and his request to reopen his time to respond is denied. See Fed. R. Civ. P. 6(b); *Pumpkin, Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997). Any objections pertaining to confidentiality are obviated to the extent that the Board's standardized protective order is now in place.<sup>1</sup>

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<sup>1</sup> In its discovery responses, defendant cited "confidentiality" and objected to Interrogatory Nos. 6 through 11 and Requests for Production of Document Nos. 6, 7, 16, 18, 23, 24 and 27 on that basis. The parties are reminded that effective August 31, 2007, the Board's standardized protective order governing the disclosure of confidential information is automatically in place in proceedings pending before the Board. See *Miscellaneous Changes to Trademark Trial and Appeal Board Rules*, FR Vol. 72, No. 147 (August 1, 2007).

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Pursuant to Fed. R. Civ. P. 26(e)(2), a party is under a duty to supplement its discovery responses when it learns that the information previously provided is incorrect or incomplete. In view thereof, defendant is ordered to provide amended responses, without objections, to plaintiff's first set of interrogatories and first set of document production requests **THIRTY (30)** days from the mailing date of this order. In the event that defendant fails to comply with this Board order compelling discovery, the Board may entertain a formal motion for sanctions from plaintiff, including the entry of judgment. See Trademark Rule 2.120(g).

In closing, the Board notes that proceedings were suspended on November 16, 2007 pending disposition of the motion to compel. Per the Board's institution order, the discovery period was scheduled to remain open until February 11, 2008. With proceedings herein resumed, trial dates are now reset as follows:

DISCOVERY PERIOD TO CLOSE:	<b>July 17, 2008</b>
30-day testimony period for party in position of plaintiff to close:	<b>October 15, 2008</b>
30-day testimony period for party in position of defendant to close:	<b>December 14, 2008</b>
15-day rebuttal testimony period for plaintiff to close:	<b>January 28, 2009</b>

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