

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

wbc

Mailed: March 15, 2013

Opposition Nos. 91178927  
91180771  
91180772  
91183482  
91185755  
91186579  
91189847  
91190658

Royal Crown Company, Inc.  
and Dr. Pepper/Seven Up,  
Inc. (joined as party  
plaintiff)

v.

The Coca-Cola Company

Opposition No. 91184434

The Coca-Cola Company

v.

Royal Crown Company, Inc.  
and Dr. Pepper/Seven Up,  
Inc. (joined as party  
Defendant)

**Andrew P. Baxley, Interlocutory Attorney:**

This case now comes up for consideration of: (1) Royal Crown Company, Inc.'s ("RC") motion (filed November 15, 2012) to substitute Dr. Pepper/Seven Up, Inc. ("DPSU") as party plaintiff and opposer in Opposition Nos. 91178927, 91180771,

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91180772, 91183482, 91185755, 91186579, 91189847, and 91190658  
and as party defendant and applicant in Opposition No. 91184434; and (2) and its combined motion (filed November 30, 2012) to compel and to test the sufficiency of responses to requests for admission whereby RC seeks (a) production of documents in response to RC's January 14, 2010 and February 23, 2010 document requests; (b) responses without objection to discovery requests that RC served on August 17, 2012; and (c) supplemental responses to requests for admission nos. 50-51, 68, 70-98, 101, 106-113, 124-125, and 132-137, document request nos. 7-9, 12-19, 21-22, 24-27, 30-33, 35-36 and 38, and interrogatory nos. 8-14. The motions have been fully briefed.

Motion to Substitute

The Board turns first to RC's motion to substitute. The record herein indicates that RC assigned to DPSU various trademarks and applications and registrations therefor, including the pleaded DIET RITE PURE ZERO and PURE ZERO marks and pleaded application Serial Nos. 78576257 (for DIET RITE PURE ZERO) and 78581917 (for PURE ZERO), in an assignment document dated April 28, 2010, during the pendency of this proceeding.<sup>1</sup>

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<sup>1</sup> The assignment document was recorded with the USPTO's Assignment Branch on April 30, 2010 at Reel 4196/Frame 0881.

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In keeping with Board practice, the motion to substitute is granted to the extent that DPSU is hereby joined, rather than substituted. See Patent and Trademark Rule 3.73(b); TBMP Section 512.01 (3d ed. rev. 2012). DPSU is hereby joined as a party plaintiff and opposer in Opposition Nos. 91178927, 91180771, 91180772, 91183482, 91185755, 91186579, 91189847, and 91190658 and as a party defendant and applicant in Opposition No. 91184434.

Motion to Compel and to Test the Sufficiency of Responses to Requests for Admission

By the combined motion to compel and to test the sufficiency of responses to requests for admission, RC and DPSU seek (a) production of documents in response to RC's January 14, 2010 and February 23, 2010 document requests; (b) responses without objection to the nineteen document requests and seventy-five requests for admission that RC served on August 17, 2012; and (c) supplemental responses to requests for admission nos. 50-51, 68, 70-98, 101, 106-113, 124-125, and 132-137, document request nos. 7-9, 12-19, 21-22, 24-27, 30-33, 35-36 and 38, and interrogatory nos. 8-14.

As an initial matter, the Board finds that RC made a good faith effort to resolve the parties' discovery dispute prior to seeking Board intervention. See Trademark Rule 2.120(e)(1) and 2.120(h)(1); TBMP Sections 523.02 and 524.02.

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The Board will first consider such motion in connection with discovery requests that RC served on August 17, 2012. Pursuant to the Board's April 15, 2010 order, the discovery period closed on April 24, 2010. Between May 14, 2010 and March 30, 2011, the parties filed a series of consented motions to extend or suspend for settlement negotiations which called for proceedings to commence with the next applicable date being the due date for RC's pretrial disclosures.

On June 8, 2011, RC filed the parties' stipulation to suspend the above-captioned proceedings pending final determination of Opposition No. 91178953 styled *Companhia de Bebidas das Americas - AMBEV v. The Coca-Cola Company*, which the Board granted in a June 20, 2011 order. In that stipulation, the parties "request[ed] additional time following [issuance of the] decision in [Opposition No. 91178953] ... so that they can resolve some open discovery ... issues that the parties have placed on hold during the time these proceedings have been suspended."

Opposition No. 91178953 was dismissed with prejudice in a May 2, 2012 final decision and was terminated on July 18, 2012. In a notice to the Board that RC filed on May 22, 2012, RC informed the Board of the decision in Opposition No. 91178953 and did not request that the discovery period be reopened. Notwithstanding that neither party requested a

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reopening of the discovery period, the Board, in a July 19, 2012 order, as corrected by a July 23, 2012 order, resumed proceedings and, without explanation, reopened the discovery period, with a reset closing date of August 17, 2012. On August 17, 2012, RC served nineteen document requests and seventy-five requests for admissions. On October 12, 2012, the Coca-Cola Company ("CC") timely served responses thereto,<sup>2</sup> consisting of general objections that the discovery period was improperly reopened in the July 19 and 23, 2012 orders and that the August 17, 2012 discovery requests are therefore untimely.

The Board may, on its own initiative, reconsider and modify one of its orders or decisions if it finds error therein. See *Avedis Zildjian Company v. D.H. Baldwin Company*, 181 USPQ 736 (Comm'r Pat. 1974); TBMP Section 518.

The Board finds that the discovery period was reopened in error in the July 19, 2012 order, as modified by the July 23, 2012 order. Although the parties, in their June 8, 2011 stipulation, "request[ed] additional time following [issuance of the] decision in [Opposition No. 91178953] ... so that they can resolve some open discovery ... issues," that request is not one to reopen the discovery period. In

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<sup>2</sup> RC's motion indicates that the parties agreed to extend CC's time to respond to the August 17, 2012 discovery requests to October 12, 2012.

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addition, the Board, in the July 19 and 23, 2012 orders, failed to provide any reason for reopening the discovery period.

Because parties can serve written discovery requests until the closing date of the discovery period, responses to discovery requests are often not due until after the close of the discovery period.<sup>3</sup> See Trademark Rule 2.120(a)(3); TBMP Section 403.02. Thus, a need, asserted after the close of the discovery period, for time to resolve issues regarding discovery responses that have long since been served and responded to does not, by itself, warrant a reopening of the discovery period.

Further, the Board's general practice when resuming proceedings following a suspension is to place the parties in roughly the same position where they stood when proceedings were suspended. See, e.g., *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1776 n.4 (TTAB 1999) (dates reset beginning with the period that was running when the potentially dispositive motion was filed). That is, the Board generally does not *sua sponte* reopen a time to act without explanation more than two years after

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<sup>3</sup> The Board notes, however, that CC's responses to RC's discovery requests other than those served on August 17, 2012 were served prior to the April 24, 2010 close of discovery.

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that time to act has closed.<sup>4</sup> Cf. Fed. R. Civ. P.

6(b)(1)(B); TBMP Section 509.01(b) (reopening of time to act other than time to file an answer requires a showing of excusable neglect).

In view thereof, the July 19 and 23, 2012 orders are hereby modified to vacate the reopening of the discovery period. Accordingly, the discovery period is again treated as having closed on April 24, 2010. Based on the foregoing, the discovery requests that RC served on August 17, 2012 are untimely,<sup>5</sup> and the motion to compel and to test

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<sup>4</sup> Notwithstanding the Board error, CC could have avoided the service of the August 17, 2012 discovery requests and subsequent motion with regard thereto by taking prompt action in response to the July 19 and 23, 2012 orders. The July 19 and 23, 2012 orders clearly and unambiguously reopened the discovery period. Thus, if CC believed that so reopening was in error, it should have timely filed a request for reconsideration of those orders. See Trademark Rule 2.127(b); TBMP Section 518. In addition, the parties could have avoided the time and expense related to RC's August 17, 2012 discovery requests by seeking clarification from the Board in a telephone conference shortly after issuance of the July 19 and 23, 2012 orders.

<sup>5</sup> A responding party may only be compelled to serve responses without objection to discovery requests by order of the Board following a motion to compel by the propounding party after that party has failed to timely respond to those discovery requests. See *No Fear Inc. v. Rule*, 54 USPQ2d 1551 (TTAB 2000); TBMP Section 403.03. CC timely served general objections to those discovery requests on October 12, 2012. Thus, had the August 17, 2012 discovery requests been timely served, compelling full responses to those discovery requests without objection would have been unwarranted.

Further, the motion to compel procedure is not available with regard to requests for admission. See TBMP Section 523.01. Thus, the Board does not compel responses without objection to requests for admission.

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the sufficiency of responses to requests for admissions is denied to the extent that RC seeks substantive responses without objection to the nineteen document requests and seventy-five requests for admissions that it served on August 17, 2012. CC need not respond further to those discovery requests. See TBMP Section 403.01.

To the extent that RC seeks to compel CC to produce documents in response to its January 14 and February 23, 2010 document requests, CC states that it is prepared to produce those documents. RC's motion to compel is therefore granted to the extent that CC is allowed until thirty days from the mailing of this order to: 1) select, designate and identify the items and documents, or categories of items and documents, to be produced in response to RC's January 14, 2010 and February 23, 2010 document requests,<sup>6</sup> and 2) notify RC that the selection, designation and identification of such items and documents has been completed. RC and DPSU are allowed until thirty days from receipt of notification from CC that the items or documents have been selected, designated and identified to inspect and copy the produced

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<sup>6</sup> If responsive materials are voluminous, CC may produce a representative sampling and inform RC and DPSU that a representative sampling has been produced. See TBMP Section 402.02. CC need not create documents to respond to RC's document requests. See *Washington v. Garrett*, 10 F.3d 1421, 1437-38 (9th Cir. 1993).

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materials as provided for in Fed. R. Civ. P. 34(b) and Trademark Rule 2.120(d)(2), unless the parties otherwise agree.

To the extent that RC asks the Board to order supplemental responses to requests for admission nos. 50-51, 68, 70-98, 101, 106-113, 124-125, and 132-137, the Board will treat RC's motion as one to test the sufficiency of CC's responses to the requests for admission at issue.<sup>7</sup> See Fed. R. Civ. P. 36(a)(6); TBMP Section 524. A review of CC's responses to the requests for admission at issue indicates that those responses are in compliance with Fed. R. Civ. P. 36(a)(4) and (5). See TBMP Section 524. Accordingly, RC's motion to test the sufficiency of responses to requests for admission nos. 50-51, 68, 70-98, 101, 106-113, 124-125, and 132-137 is denied.

To the extent that RC asks the Board to order supplemental responses to document request nos. 7-9, 12-19, 21-22, 24-27, 30-33, 35-36 and 38 and interrogatory nos. 8-14, RC, in its briefing in connection with its motion, has not alleged specific deficiencies in CC's responses beyond the fact time has passed since those responses were served. Further, RC has not cited to any authority in support of its

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<sup>7</sup> As noted *supra*, the motion to compel procedure is not available with regard to requests for admission. See TBMP Section 523.01.

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contention that a motion to compel supplemental responses to discovery requests is appropriate. Accordingly, RC's motion to compel is denied to the extent that RC seeks to compel supplemental responses to document request nos. 7-9, 12-19, 21-22, 24-27, 30-33, 35-36 and 38, and interrogatory nos. 8-14.<sup>8</sup>

Rather, as CC acknowledges in its brief in response, the parties have an ongoing duty to correct or supplement their discovery responses, as necessary.<sup>9</sup> See Fed. R. Civ. P. 26(e). That duty requires supplementation in a timely manner, if the party learns that in some material respect the disclosure or response is incomplete or incorrect, and if the additional or corrective information has not otherwise been made known to the other parties during the discovery process or in writing.<sup>10</sup> See TBMP Section 408.03. The parties are strongly urged to cooperate in promptly

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<sup>8</sup> RC and DPSU may not file any further motions to compel or to test the sufficiency of responses to requests for admission unless they first obtain leave of the Board to so file in a telephone conference with the Board attorney assigned to these proceedings.

<sup>9</sup> RC asserts in its reply brief that it has supplemented its document production since the resumption of proceedings on July 19, 2012.

<sup>10</sup> If a party fails to disclose properly discoverable information and documents during discovery, it may, upon objection by its adversary at trial, be precluded from relying upon such information and documents as evidence. See Fed. R. Civ. P. 37(c)(1).

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supplementing their discovery responses as necessary. See

TBMP Section 408.01.

Proceedings are resumed. Dates are reset as follows:

Plaintiff in Opposition Nos. 91178927, 91180771, 91180772, 91183482, 9118755, 91186579, 91189847, and 91190658 pretrial disclosures due May 15, 2013

30-day testimony period for plaintiff in Opposition Nos. 91178927, 91180771, 91180772, 91183482, 9118755, 91186579, 91189847, and 91190658 to close June 29, 2013

Defendant in Opposition Nos. 91178927, 91180771, 91180772, 91183482, 9118755, 91186579, 91189847, and 91190658 and counterclaim plaintiff in Opposition No. 91184434 pretrial disclosures due July 14, 2013

30-day testimony period for defendant in Opposition Nos. 91178927, 91180771, 91180772, 91183482, 9118755, 91186579, 91189847, and 91190658 and counterclaim plaintiff in Opposition No. 91184434 to close August 28, 2013

Counterclaim defendant in Opposition No. 91184434 and Plaintiff in Opposition Nos. 91178927, 91180771, 91180772, 91183482, 9118755, 91186579, 91189847, and 91190658 rebuttal disclosures due September 12, 2013

30-day testimony period for counterclaim defendant in Opposition Nos. 91184434 and rebuttal testimony for plaintiff in Opposition Nos. 91178927, 91180771, 91180772, 91183482, 9118755, 91186579, 91189847, and 91190658 to close October 27, 2013

Counterclaim plaintiff in Opposition No. 91184434 rebuttal disclosures due November 11, 2013

15-day rebuttal period for counterclaim plaintiff in Opposition No. 91184434 to close December 11, 2013

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Brief for plaintiff in Opposition Nos. February 9, 2014  
91178927, 91180771, 91180772, 91183482,  
9118755, 91186579, 91189847, and 91190658 due

Brief for defendant in Opposition Nos. March 11, 2014  
91178927, 91180771, 91180772, 91183482,  
9118755, 91186579, 91189847, and 91190658 and  
counterclaim plaintiff in Opposition 91184434  
due

Brief for counterclaim defendant in April 10, 2014  
Opposition No. 91184434 and reply brief, if  
any, for plaintiff in Opposition Nos.  
91178927, 91180771, 91180772, 91183482,  
9118755, 91186579, 91189847, and 91190658 due

Reply brief, if any, for counterclaim April 25, 2014  
plaintiff in Opposition No.91184434 due

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.