

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

Lykos

Mailed: March 31, 2009

Opposition Nos. 91178356
91179491

Cosmetic Warriors Ltd.

v.

Cygen Cosmeceuticals, Inc.

(as consolidated)

Angela Lykos, Interlocutory Attorney

This case now comes before the Board for consideration of (1) applicant's motion to take the Fed. R. Civ. P. 30(b)(6) discovery deposition of opposer's corporate representative by telephone (filed April 23, 2008); and (2) opposer's motion to compel (filed July 8, 2008), both filed in Opposition No. 91178356.¹ The motion to take the discovery deposition orally is contested; the motion to

¹ On May 8, 2008, opposer filed a motion to compel. Thereafter, on June 9, 2008, applicant filed a motion to reopen its time to file a brief in response to opposer's motion to compel on the grounds that it did not become aware of the motion until it received the Board's suspension order. Opposer filed its consent thereto on June 11, 2009. Opposer thereafter filed an "amended motion to compel" on July 8, 2008. The Board therefore construes opposer's motion to compel filed May 8, 2008 as withdrawn, and has only considered the "amended" motion to compel in this order.

compel is fully briefed.²

I. *Consolidation*

As a preliminary matter, the parties' stipulation (filed April 18, 2008) to consolidate the above referenced proceedings is granted. See Fed. R. Civ. P. 42(a); Trademark Rule 2.127(a) and TBMP § 511 (2d ed. rev. 2004) and authorities cited therein. Consequently, the parties' future submissions should be captioned in the above manner.

The Board file will be maintained in Opposition No. 91178356 as the "parent" case. From this point on, only a single copy of any submission or motion should be filed herein; but that copy should bear both proceeding numbers in its caption.

Despite being consolidated, each proceeding retains its separate character. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings; a copy of the decision shall be placed in each proceeding file.

II. *Applicant's Motion to Take the Fed. R. Civ. P. 30(b)(6) Discovery Deposition of Opposer's Corporate Representative by Telephone*

Opposer is a corporation duly organized and existing under the laws of the United Kingdom. During the discovery period (which was reset to close August 1, 2008), applicant

² Applicant's motion filed April 14, 2008 in Opposition No. 91178356 to amend its answer to opposer's counterclaim by withdrawing its third affirmative defense is granted. See Fed. R. Civ. P. 15(a) and Trademark Rule 2.127(a).

noticed the taking of a discovery deposition of opposer's corporate representative pursuant to Fed. R. Civ. P. 30(b)(6). Applicant has moved to take the deposition orally by telephone pursuant to Fed. R. Civ. P. 30(b)(7). Opposer objects, arguing that because opposer is a foreign entity, and because applicant has failed to make the requisite showing of good cause, the deposition must be taken by way of written questions.

Before reaching the question of whether applicant may take the deposition by telephone, the Board must first decide whether applicant is entitled to oral examination of opposer's designated Rule 30(b)(6) witness. Trademark Rule 2.120(c)(1) which provides in relevant part:

The discovery deposition of a natural person residing in a foreign country who is a party or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, shall, if taken in a foreign country, be taken in the manner prescribed by section 2.124 unless the Trademark Trial and Appeal Board, upon motion for good cause, order or the parties stipulate, that the deposition be taken by oral examination.

Trademark Rule 2.124 provides for the taking of depositions upon written questions. What constitutes good cause for a motion to take a discovery deposition orally must be determined on a case-by-case basis, upon consideration of the particular facts and circumstances in each situation.

Orion Group Inc. v. The Orion Insurance Co. P.L.C., 12

USPQ2d 1923 (TTAB 1989). In determining such a motion, the Board weighs the equities, including the advantages of an oral deposition and any financial hardship that the party to be deposed might suffer if the deposition were taken orally in the foreign country. *Id.* The Board will not order a natural person residing in a foreign country to come to the United States for the taking of a discovery deposition. *Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998).

Applicant argues that good cause exists to take the deposition by oral examination instead of telephone due to "the particular issues raised in this proceeding, namely, the [purported] descriptiveness of Opposer's marks and the need to use this deposition to identify documents produced by Opposer." Applicant maintains that otherwise it "would be deprived of spontaneous answers to live deposition questions."

The Board finds that these reasons do not constitute good cause to take the deposition by oral examination. No potentially dispositive motion dependent upon the testimony of a single witness is pending before the Board. *See Orion, supra* (applicant moved for summary judgment based on the affidavit of one person, applicant's corporate secretary who resided and worked in England). Applicant points to no unique circumstances with regard to its descriptiveness counterclaim that would require the taking of an oral

discovery deposition. Thus, applicant has failed to demonstrate the need to confront and examine opposer's designated Rule 30(b)(6) witness by oral examination.

In view of our determination that applicant has failed to demonstrate the requisite good cause to take the discovery deposition orally, applicant's motion to take or attend the deposition by telephone is denied. As such, the discovery deposition will take place by way of written questions.

III. *Opposer's Motion to Compel*

Opposer has moved to compel applicant to provide amended responses to opposer's first set of interrogatories, first set of requests for production of documents and things, and first set of requests for admissions. In response to opposer's "amended motion to compel," applicant has filed and served "better" responses contemporaneously therewith, which the Board construes as amended responses to the discovery requests. It is these amended responses which have been reviewed in this order.

The Board notes that the motion to compel procedure does not apply to requests for admissions. See Trademark Rule 2.120(h). However, in order to expedite this matter, the Board is construing opposer's motion as it applies to opposer's first set of requests for admissions as a motion to test the sufficiency of the admission requests.

A. *Good Faith Effort*

As a preliminary matter, the Board finds that opposer has made a good-faith effort pursuant to Trademark Rules 2.120(e) and (h) by written correspondence and oral communication to resolve the present discovery dispute prior to seeking to Board intervention. Notwithstanding the above, the Board reminds the parties that they are expected to cooperate with each other so that the case may proceed in an orderly manner within reasonable time constraints.

B. *Newly Asserted Objections in Applicant's Amended Responses*

Applicant's amended responses to opposer's written discovery requests are replete with newly asserted objections on the merits. Absent a showing of excusable neglect, objections on the merits must be made during the time allowed therefore. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551 (TTAB 2000). Accordingly, all such newly asserted objections are overruled.

C. *Objections Based on Confidentiality and Trade Secret*

Applicant initially objected to many of opposer's written discovery requests on the grounds that they seek confidential or trade secret information. Trademark Rule 2.116(g) was amended to provide that effective as of August 31, 2007, the Board's standardized protective order is automatically in place in all pending cases where the

parties have not otherwise entered into their own protective order. Applicant's objections to the discovery requests based on confidentiality are improper in light of the recent rule change, and are therefore overruled.

D. Privilege Log Reminder

Fed. R. Civ. P. 26(b)(5), made applicable to Board proceedings by Trademark Rule 2.116(a), provides that where a claim of privilege is invoked, a party must make the claim expressly and provide a description or privilege log of the documents, communications or things not disclosed in such a manner that will enable other parties to assess the applicability of the privilege or protection. In that regard, applicant is required to provide a privilege log where applicable.

E. Duty to Supplement Reminder

Pursuant to Fed. R. Civ. P. 26(e)(2), made applicable to Board proceedings by Trademark Rule 2.116(a), "a party is under a duty seasonably to amend a prior response to an interrogatory, request for production, or request for admission if the party learns that the response is in some material respect 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." In addition, a duty to supplement responses

may be imposed by order of the Board. See TBMP § 408.03 (2d ed. rev. 2004) and cases cited therein.

F. Interrogatories

The interrogatories that remain at issue may be categorized as follows:

Interrogatory No. 5(4): Applicant objects to this interrogatory as requiring a projection of future revenues. Applicant's objection is sustained. While current and past sales figures for a party's involved goods or services sold under its involved mark are proper matters for discovery (See TBMP Section 414(18) (2d ed. rev. 2004) and cases cited therein), a party is not required to speculate as to future sales revenues. However, to the extent that applicant now has available sales figures for the entire year of 2008, applicant must supplement its response. See Fed. R. Civ. P. 26(e)(2).

Interrogatory Nos. 15-32: Applicant objects to these contention interrogatories pursuant to the work product doctrine. It appears that applicant may be confusing the work product doctrine with the attorney/client privilege. In that regard, applicant is required to provide a privilege log where applicable. See Fed. R. Civ. P. 26(b)(5). Applicant also maintains in its responsive brief that these contention interrogatories are similar to the

interrogatories at issue in *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650 (TTAB 2002) which the Board found to be improper. The Board disagrees. Opposer's interrogatories do not ask for "each and every fact, document and witness in support" of applicant's contentions. Rather, these interrogatories ask applicant to "fully state the factual and legal basis" for its various contentions. As such, the interrogatories are acceptable.

Opposer maintains that applicant's amended responses to the contention interrogatories remain unacceptable. After reviewing applicant's amended responses, the Board disagrees, finding that applicant's amended responses adequately respond to each interrogatory. To that extent, opposer's motion to compel is denied.

G. Document Production Requests

A proper response to a document production request requires stating as to each request either that there are responsive documents and they will be produced or (withheld on a claim of privilege) or stating that no responsive documents exist. See *No Fear, Inc. v. Rule, supra*. The majority of applicant's amended responses include such a response (for example, that applicant has made a diligent search of its records and has either found no documents responsive thereto, or has found documents responsive thereto and has produced such documents). However, as

discussed below, insofar as the Board has overruled numerous of applicant's original objections, and has noted that the newly asserted objections on the merits are deemed waived, applicant has a duty to supplement its responses where appropriate.

The document production requests that remain at issue may be categorized as follows:

Document Production Request Nos. 1 and 2: Applicant's objections on the grounds that the requests are unduly broad, burdensome and seek documents and things that are not reasonably calculated to lead to any relevant evidence are overruled. See TBMP Section 414 (2d ed. rev. 2004) and cases cited therein.

Document Production Request Nos. 6, 12-15, 21, 24-31, 47, and 50: Applicant's objections on the grounds that the requests are unduly broad, burdensome and seek documents and things that are not reasonably calculated to lead to any relevant evidence are overruled.

In response to Document Production Request No. 31, applicant has left a blank space. As such, the response is unacceptable.

In response to Document Production Request Nos. 47 and 50, applicant has failed to make adequate responses to these requests by either stating that there are responsive

documents and they will be produced or (withheld on a claim of privilege) or stating that no responsive documents exist.

Document Production Request Nos. 5, 7-9, 19-20, 32, 33-46: Applicant's original objections asserting the work product doctrine are overruled. As discussed above, applicant is required to provide a privilege log where applicable pursuant to Fed. R. Civ. P. 26(b)(5).

Applicant's newly asserted objections on the grounds that the request is unduly broad, burdensome and seeks documents and things that are not reasonably calculated to lead to any relevant evidence is hereby deemed waived and therefore overruled.

With regard to the above requests, the parties should note the following guidelines. Information concerning a party's selection and adoption of its involved mark is generally discoverable. See TBMP Section 414(4) (2d ed. rev. 2004) and cases cited therein. Search reports are discoverable, but the comments or opinions of attorneys relating thereto are privileged and not discoverable. See TBMP Section 414(6) (2d ed. rev. 2004) and cases cited therein.

Document Production Request Nos. 17-18: Applicant's newly asserted objections on the grounds that the request is unduly broad, burdensome and seek documents and things that are not reasonably calculated to lead to any relevant

evidence is hereby deemed waived and therefore overruled. The newly asserted objections on the grounds of confidentiality and trade secret are overruled as well (see discussion above regarding Trademark Rule 2.116(g)).

In view of the foregoing, opposer's motion to compel is granted to the extent that applicant is ordered to supplement its response to Interrogatory No. 5(4) and all document production requests noted above (if appropriate in light of the Board's determination to overrule applicant's objections), provide responses to Document Production Request Nos. 5, 17, 19, 31, 47, and 50 without objection, and provide a privilege log where appropriate, THIRTY (30) days from the mailing date of this order.

In the event that applicant fails to comply with this Board order compelling discovery, the Board may entertain a formal motion for sanctions from opposer, including judgment. See Trademark Rule 2.120(g).

IV. *Motion to Test the Sufficiency of Applicant's Responses to Opposer's Requests for Admission*

Fed. R. Civ. P. 36(a) requires that the answering party admit or deny the matter set forth in the requests for admission, or detail the reasons why the party can do neither. "A denial shall fairly meet the substance of the

requested admission, and when good faith requires that a party qualify an answer or deny only a part of the matter of which an admission is requested, the party shall specify so much of it as is true and qualify or deny the remainder." Fed. R. Civ. P. 36(a). If an answer does not comply with the requirements of Fed. R. Civ. P. 36(a), the Board may order either that the matter is admitted or that an amended answer be served. See also Trademark Rule 2.120(h).

Applicant's responses to opposer's requests for admission that remain at issue here may be categorized as follows:

Admission Request Nos. 4 and 5: These admission requests ask applicant to admit or deny that the term BUST is "merely descriptive" or "highly descriptive." Applicant has stated that it can neither admit nor deny each request as worded and has explained why it cannot do either. Applicant's responses are deemed sufficient.

Admission Request Nos. 7 and 8: These admission requests ask applicant compare "the dominant portion" of applicant's mark with opposer's mark. Applicant has stated that it can neither admit nor deny each request as worded and has explained why it cannot do either. Applicant's responses are deemed sufficient.

Admission Request Nos. 11, 14-19, 41-44, 49:

These admission requests ask applicant to admit or deny matters that either pertain to opposer's business or the authentication of documents obtained or filed by opposer in connection with this proceeding. Applicant has stated that it can neither admit nor deny each request as worded and has explained why it cannot do either. Applicant's responses are deemed sufficient.

Admission Request Nos. 22, 23, 26, 28, 31, 38, 45, 58, 61, and 63: In its amended responses, applicant has denied each of the admission requests at issue herein. Applicant's amended responses are deemed sufficient.

Admission Request Nos. 39-40: Applicant's objections to these admission requests are overruled. Whether applicant conducted a trademark search or investigation prior to filing its application or whether applicant engaged a person to conduct a trademark search or investigation is discoverable. See TBMP Section 414(6) (2d ed. rev. 2004).

Admission Request Nos. 60 and 71: Applicant has stated that it can neither admit nor deny each request as worded and has explained why it cannot do either. Applicant's responses are deemed sufficient.

Admission Request Nos. 68-70: Applicant has admitted with qualifications each of the admission requests at issue herein. Applicant's admissions are deemed sufficient.

In view thereof, opposer's motion to test the sufficiency of applicant's responses to its requests for admission is denied.

III. Deposition of Giselle Reinbergs

On June 19, 2008, opposer took the discovery deposition of Giselle Reinbergs, president of applicant. During the deposition, counsel for applicant objected to, and instructed Ms. Reinbergs not to answer, numerous questions posed by counsel for opposer on the grounds of relevance and that they had been "asked and answered." The questions pertained to the nature of applicant's advertising of the product bearing the LUSHBUST mark at issue in this proceeding. Specifically, Ms. Reinbergs did not answer questions about the studies advertised on the product packaging and brochures used to mark the LUSHBUST product. Opposer then adduced its own evidence on this same subject at the close of its questioning of the witness. As a remedy, opposer requests that "all references to studies, test, and results made on the LUSHBUST packaging or on LUSHBUST product advertisements or brochures be deemed unsupported by scientific evidence," or in the alternative, that Ms. Reinbergs be required to sit for another deposition.

Applicant, in its responsive brief, does not address the issues raised by opposer in connection with the deposition of Ms. Reinbergs.

The Board declines to grant opposer's initial request, that is that "all references to studies, test, and results made on the LUSHBUST packaging or on LUSHBUST product advertisements or brochures be deemed unsupported by scientific evidence," and instead **orders that Ms. Reinbergs be made available for another deposition THIRTY days from the mailing date of this order.**

IV. *Suspension of Proceedings*

Proceedings are otherwise suspended to allow for the completion of the deposition upon written questions of opposer's Rule 30(b)(6) witness(es). Applicant is reminded that it must serve notice of the deposition on counsel for opposer and filed a copy of the notice with the Board. See Trademark Rule 2.124. Upon completion of the deposition, the parties are to inform the Board so that proceedings may be resumed.

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

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>