

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

Mailed: September 24, 2008

Opposition No. **91180460**

E. I. du Pont de Nemours and
Company

v.

Melissa J. Terzis,

Cheryl Goodman, Interlocutory Attorney:

This case now comes up on the following filings:

- 1) applicant's objection to opposer's first request for production of document and things, filed May 27, 2008;
- 2) applicant's objection to opposer's first request for admissions, filed May 27, 2008;
- 3) applicant's objection to opposer's first set of interrogatories, filed June 4, 2008;
- 4) applicant's supplemental objection to opposer's first request for admission, filed June 12, 2008;
- 5) applicant's supplemental objection to opposer's first request for production of documents and things, filed June 16, 2008;
- 6) opposer's motion to strike, filed July 3, 2008; and
- 7) opposer's motion to compel, filed July 3, 2008.

The Board turns first to applicant's objection to opposer's first request for production, first request for admissions and first set of interrogatories.

It is applicant's position that opposer's discovery requests, with a certificate of service date of May 19, 2008, were untimely. Applicant seeks an order sustaining its objections. Applicant also seeks sanctions against opposer for failure to comply with the discovery schedule in

the Board's institution order dated October 31, 2007. In particular, applicant seeks entry of judgment dismissing the opposition, granting of its registration, and an award of attorney's fees and costs.

In response, opposer argues that applicant's claim that opposer's discovery requests were untimely is without merit. Opposer points out that discovery may be served through the last day of the discovery period and that in this case, because the close of discovery fell on Sunday, May 18, 2008, opposer, in accordance with Trademark Rule 2.196, was allowed to serve its discovery requests on Monday, May 19, 2008. With respect to applicant's motion for sanctions, opposer argues that there is no support for sanctions as there has been no discovery order issued by the Board. Opposer also points out that the Board has no authority to award attorney's fees or other monetary sanctions.

In reply, applicant has reiterated the arguments in its earlier papers.

The Board agrees with opposer that its discovery was timely served in accordance with Trademark Rules 2.119(c)¹, 2.120(a), and 2.196 and TBMP Sections 112, 113, and 403.02 (2d. ed. rev. 2004). Accordingly, applicant's objections

¹ See *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1295 (TTAB 1997) ("the Board ordinarily accepts as prima facie proof of the date of mailing, the statement signed by the filing party or its attorney . . . as to the date and manner of service").

with respect to opposer's first request for production, first request for admissions, and first set of interrogatories are overruled.

With respect to applicant's request for sanctions, opposer is correct that attorneys fees and costs are unavailable. See Trademark Rules 2.120(g) and TBMP Section 502.05 and 527.02. The Board also agrees with opposer that no discovery order has issued in this case and the Board's notice of institution of this proceeding does not constitute a discovery order. Therefore, discovery sanctions are also unavailable. See Trademark Rule 2.120(g)(1).

In view thereof, applicant's request for sanctions will be given no consideration.

The Board now turns to applicant's supplemental objections with respect to opposer's first request for admissions.

It is applicant's position that "no useful purpose is served" by the request for admissions which applicant submits ask for the same information alleged in the notice of opposition. Applicant states it has already denied these allegations in its answer and preliminary statement.

In response, opposer argues that applicant's arguments that its answer is a proper response to opposer's request for admissions "is in direct contradiction" to Fed. R. Civ. P. 36, "which requires a separate written answer to each

request . . . and contains no provision that would permit any statements made in prior pleadings to prospectively serve as responses to future Requests for Admissions."

In reply, applicant argues that the requests for admissions were "totally unnecessary."

The Board finds applicant's objection is unjustified. During the discovery period, any party may serve written requests for admission on the other party. TBMP Section 407.01. Responses to the requests must be separately provided in writing. TBMP Section 407.03(b). Reference to the denials in applicant's answer are not sufficient. Fed. R. Civ. P. 36 and TBMP 407.03; *Cf., Zink v. Blakey*, Civ. No. 07-9503, 2007 WL 2733729 (10th Cir. September 14, 2007) (denials in answer did not trump insufficient responses to request for admissions by which administrative law judge deemed certain facts admitted in context of a motion for summary judgment).

In view thereof, applicant's supplemental objection to opposer's first request for admissions is overruled.

The Board turns next to applicant's supplemental objections to opposer's first request for production of documents and things.

It is applicant's position that opposer is seeking "evidence that is within the record but also within Opposer's own executed and signed legal documents."

Applicant argues that opposer "can obtain all, if any, of the requested evidence, documents and information . . . with substantially greater facility than it could otherwise be obtained by the Applicant."

In response, opposer argues that applicant's supplemental objection provides a "new and equally baseless claim that applicant is not required to produce documents." With regard to applicant's contention that opposer can obtain the documents sought from governmental agencies or using its computers, opposer asserts there is no factual basis for this claim as opposer seeks documents that are "primarily, if not exclusively, in the possession of Applicant and its agents." Opposer submits that "it would be difficult, if not impossible to obtain these documents from third-party sources and it would be far easier and more certain for Applicant to simply produce them." Opposer argues that "applicant . . . can make no reasonable showing that the Opposer should be required to conduct its own investigation . . . to locate documents . . . that Applicant already has in its possession."

The Board may limit discovery if it determines, among other things, that the discovery is unreasonably cumulative or duplicative, obtainable from another source that is more convenient, less burdensome, or less expensive, or the burden or expense of the proposed discovery outweighs its

likely benefit. Fed. R. Civ. P. 26(b). In considering the matter, the Board will balance the competing interests of the parties i.e., one party's right to obtain relevant discovery versus the hardship to the other party in responding to discovery.

In reviewing opposer's requests for production of documents and things, the Board finds that the majority of requests relate specifically to documents that would be within applicant's possession, custody or control. Applicant has not met its burden in establishing that opposer with reasonable effort can find this information on its own nor has applicant established that all these documents are equally available to both parties or obtainable from some other source more convenient or less burdensome or less expensive than applicant. While some information may be publicly available to both parties, the Board finds that seeking this information from one source i.e., applicant is more convenient, and less burdensome to opposer. *See e.g., Snowden v. Connaught Labs., Inc.*, 137 F.R.D. 325, 333 (D.Kan.1991) (finding that it was more convenient and less costly to have defendant provide some of the documents that were available publicly as the documents were at one location). Therefore, the Board finds that

opposer is entitled to responses to its first request for production of documents from applicant.²

Accordingly, the Board overrules applicant's supplemental objection to opposer's first request for production of documents and things.

The Board now turns to opposer's motion to compel.

Opposer seeks an order compelling applicant to respond to its first set of interrogatories, first request for production of documents and things, and first request for admissions. Opposer asserts that it "attempted in good faith, to resolve the issues with Applicant" but that applicant's attorney indicated that a motion to compel would be "premature" and "made no offers to otherwise resolve the discovery issues."

In response, applicant argues that opposer's statement of good faith effort is "disingenuous" and that any motion to compel is premature prior to any Board ruling on its objections to discovery. Applicant also argues that the

² The Board does find, however, document request no. 33 to be overbroad as it requests "all documents and things Applicant intends to rely or introduce into evidence at trial." TBMP Section 414(7) provides that "[a] party need not, in advance of trial specify in detail the evidence it intends to present." See e.g., *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1657 (TTAB 2002) (interrogatory requesting that opposer "identify each and every fact, document and witness in support of its pleaded allegations" was equivalent to a request for identification of fact witnesses and trial evidence prior to trial and therefore was improper.)

motion to compel is "moot" and "frivolous" and should be denied.

To the extent that applicant argues that there was no good faith effort, the Board finds that applicant's objections and supplemental objections to discovery were essentially in the nature of a motion under Trademark Rule 2.120(f) that discovery not be had and that opposer's motion to compel was filed under that rule. Trademark Rule 2.120(f) does not require that a party make a good faith effort before the Board may, under that rule, order a party to provide discovery. *See Miss America Pageant v. Petite Productions Inc.*, 17 USPQ2d 1067, 1070 n. 1 (TTAB 1990). Additionally, to the extent that the motion to compel is in response to applicant's motion under Trademark Rule 2.120(f), such motion, (although not encouraged by the Board), is not premature. *Miss American Pageant*, 17 USPQ2d at 1070 n.1. Lastly, inasmuch as the Board has overruled all of applicant's objections to discovery and found the discovery timely, opposer's motion to compel is neither moot nor frivolous. In view thereof, opposer's motion to compel is granted to the extent that applicant is allowed until THIRTY DAYS from the mailing date of this order to serve discovery responses to opposer's outstanding discovery requests.

The Board turns next to opposer's motion to strike. Opposer moves to strike all portions of applicant's Reply dated June 10, 2008 in which applicant claims opposer falsified certificates of service "and from all other future submissions in which Applicant may make that claim." Opposer asserts that applicant's claims of falsified certificates of service are "baseless and without merit" and are "extremely prejudicial to Opposer and Opposer's Attorneys."

In response, applicant argues that the "Motion to Strike is clearly intended by the Opposer . . . to confuse, perplex, mix indiscriminately and jumble the facts in a clear attempt to mislead."

A motion to strike a brief or a portion of a brief may be granted, or in the alternative, the objectionable matter may be ignored in reaching a decision on the merits. *Application of Harrington*, 392 F.2d 653, 157 USPQ 387 (CCPA 1968).

Inasmuch as the Board ignored the objectionable matter in applicant's papers in reaching the decision on its merits, opposer's motion to strike is denied.

In summary applicant's objections and supplemental objections to opposer's discovery requests are overruled, applicant requests for sanctions have been given no

consideration, opposer's motion to compel is granted and opposer's motion to strike is denied.

The Board finds that the flurry of filings between the parties has delayed this case and increased the cost of this proceeding to both parties. For this reason, the parties are advised that prior to filing any further pretrial motions, the parties must obtain leave from the Board. Such leave can be obtained by requesting a telephone conference with the interlocutory attorney assigned to this case.

Proceedings are resumed.

Trial dates are reset as follows:

DISCOVERY PERIOD TO CLOSE:	October 4, 2002
30-day testimony period for party in position of plaintiff to close:	December 23, 2008
30-day testimony period for party in position of defendant to close:	February 21, 2009
15-day rebuttal testimony period for party in position of plaintiff to close:	April 7, 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 after 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.

