

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

Mailed: December 22, 2008

Opposition No. 91181035

Tiffany (NJ) LLC

v.

Koury, Tiffany C.

Frances S. Wolfson, Interlocutory Attorney:

This case now comes before the Board for consideration of opposer's motion (filed August 1, 2008) to compel applicant to provide better answers to its first and second sets of interrogatories, provide better answers to its first set of requests for production of documents, and to respond to its second set of requests for production of documents. The motion has been fully briefed.

Opposer's motion and supporting documents show that opposer has sought to resolve the discovery disputes with applicant by correspondence, including e-mail correspondence. Accordingly, the Board finds that opposer has complied with the good faith efforts requirement set forth in Trademark Rule 2.120(e)(1).

GENERAL OVERVIEW OF DISCOVERY DISPUTE

Interrogatories: With respect to opposer's first set of interrogatories, opposer seeks more complete responses to

Interrogatory Nos. 4-6, 15-18, 19-20, and 24. In addition, opposer seeks answers without reference to Fed. R. Civ. P. 33(d) in response to interrogatory nos. 1, 2 and 23 and responses to its second set of interrogatories (nos. 28-30).

Production Requests: Opposer seeks relief specifically in connection with Document Request Nos. 1, 2, 3, 4-6, 14-16, 23, 27-33, and 36 (first set). Opposer further seeks documents responsive to its second set of production requests.

OPPOSER'S INTERROGATORIES

As a threshold matter, applicant contends that the interrogatories impermissibly number more than 75 total.

In determining whether the number of interrogatories served by one party upon another exceeds the limit of Trademark Rule 2.120(d)(1), the Board will look to the substance of the interrogatories, and count each question as a separate interrogatory, regardless of whether the subpart is separately numbered or lettered, with the exception that the propounding party will be bound by its own numbering system and each separately designated subpart will be counted by the Board as a separate interrogatory even if the interrogatory concerns a single transaction, state of facts, etc., or because the division was made for clarification or convenience. See TBMP §406.03(d) (2d ed. rev. 2004); *Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, 19 USPQ2d 1636 (TTAB 1990); and Carla Calcagno, TIPS FROM THE TTAB:

Discovery Practice Under Trademark Rule 2.120(d)(1), 80
Trademark Rep. 285 (1990).

The Board has carefully counted the interrogatories and determined that they do not number more than 75 total. Applicant's objection to the interrogatories on this ground is overruled. Accordingly, applicant must provide proper written responses to opposer's second set of interrogatories, Nos. 28-30, which have not yet been answered.

We next turn to opposer's first set of interrogatories.

Interrogatory Nos. 1, 2 and 23

Opposer seeks answers to Interrogatory Nos. 1, 2 and 23 without applicant's reliance on Fed. R. Civ. P. 33(d). Under Fed. R. Civ. P. 33(d), a party may produce documents in lieu of making a written response to an interrogatory, but the party must first establish that "providing written responses would impose a significant burden on the party. Further, even if the responding party can meet this test ... the inquiring party must not be left with any greater burden than the responding party when searching through and inspecting the records." *No Fear Inc. v. Ruede D. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000).

Applicant fails to properly invoke Fed. R. Civ. P. 33(d). In response to Interrogatory Nos. 1 and 2, which seek information regarding applicant's product lines and dates of use of same, applicant states: "Opposer is referred to

applicant's document production for viewing of product lines etc." In response to Interrogatory No. 23, which seeks information regarding applicant's basis for contending that she is "associated with couture fashion," applicant states: "Opposer is also referred to applicant's document production." Applicant's document production includes a disk apparently downloaded from her website.

The interrogatories are straightforward and unambiguous. Applicant has failed to show that responding in a traditional manner would impose a significant burden on applicant. Moreover, applicant's response leaves opposer with a greater burden than applicant in distilling information from applicant's webpage, as applicant is familiar with her website and how to navigate its pages while opposer is not.

Accordingly, applicant's reliance on Fed. R. Civ. P. 33(d) is improper. Applicant is ordered to provide proper written responses to Interrogatory Nos. 1, 2 and 23.

Interrogatory Nos. 4-6

Opposer seeks information regarding applicant's sales and advertising. This information is relevant to show the nature and extent of applicant's use, if any, of her mark on the goods recited in her trademark application. The nature and extent of applicant's use is relevant to a fraud claim, inasmuch as it is not just the date of first use that is in issue, but also the nature of the claimed use. Applicant is

ordered to provide written responses to Interrogatory Nos. 4-6.

Interrogatory Nos. 15-20

By the referenced interrogatories, opposer seeks information regarding the bases for applicant's denials of the contentions stated in opposer's notice of opposition, paragraphs 14-19. Applicant objects to the interrogatories on the ground that there is a mistake in the date set forth in Interrogatory No. 14 and that the interrogatories exceed the permitted number of 75.

We have overruled applicant's objection on the ground of excessive number. As for applicant's objection to Interrogatory Nos. 15-20 on the ground that there is a mistake in the date set forth in Interrogatory No. 14, this objection is also overruled. Interrogatory Nos. 15-20 do not depend upon the date referenced in Interrogatory No. 14 (which appears to be an inadvertent reference to applicant's claimed date of first use rather than date of first use in commerce.) Applicant is ordered to provide proper written responses to Interrogatory Nos. 15-20.¹

¹ Rather than fail to answer the interrogatories, applicant should have clarified the date with opposer. The Board expects parties and their attorneys to make a good faith effort to satisfy the discovery needs of its adversary and looks with extreme disfavor on those who do not. See TBMP § 408.01 (2d ed. rev. 2004).

Interrogatory No. 24

Opposer seeks information concerning applicant's basis for its affirmative defenses of acquiescence and estoppel. Applicant objects on the ground that the interrogatory exceeds the number permissible and that it is irrelevant. We have already overruled applicant's objection on the ground of excessive number. We further overrule applicant's objection that the request is irrelevant. Interrogatories seeking facts underlying a party's contentions are permissible under Fed. R. Civ. P. 33(a)(2). Applicant is not required to disclose the entirety of any evidence she expects to present in support of her case or present evidence tending to prove opposer's case, but applicant must provide a proper written response to Interrogatory No. 24, explaining the basis for her contention. See TBMP § 414(7) (2d ed. rev. 2004).

OPPOSER'S DOCUMENT PRODUCTION REQUESTS

We now turn to the specific document production requests contained in opposer's first and second sets of requests for production of documents. As to the second set, opposer asserted in its motion to compel that applicant had failed to produce any responses thereto. However, applicant responded by showing that she submitted documents in response to these requests prior to the date opposer filed its motion to compel. Inasmuch as opposer did not indicate

in its reply brief that the responses were deficient, applicant is not ordered herein to produce further documents responsive to opposer's second set. However, applicant is advised that she is under a continuing obligation to supplement her discovery responses, and that any documents responsive to proper document requests that are not produced may not be relied upon at trial. See Fed. R. Civ. P. 26(e)(2); and *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718 (TTAB 1987); *Presto Products Inc. v. Nice Pak Products Inc.*, 9 USPQ2d 1895, at fn. 5 (TTAB 1988).

Request Nos. 1, 2, 4, 5, and 6

These requests seek documents showing the nature of applicant's business, her use of her mark and any other versions of the mark, and request samples of the goods and a sample of each label, package, tag, brochure, price list, catalog, display or other item bearing applicant's mark. Instead of providing documents, applicant has merely referred opposer to her website. Applicant must produce the specific website pages that she contends are responsive to opposer's document production requests Nos. 1, 2, 4, 5 and 6. In addition, applicant must produce samples of items bearing her mark.

Request No. 3

Request No. 3 seeks documents sufficient to show applicant's date of first use of her mark and the manner in

which the mark was used as of the date of first use. Applicant produced "Invitations to Trunk Shows" and printouts of its trademark application from the USPTO website in response to this request. Applicant's response is sufficient and applicant is not ordered herein to produce further documents responsive to this request. However, applicant is advised that documents withheld from production in response to this request may not be relied upon at trial. See Fed. R. Civ. P. 26(e)(2).

Request Nos. 14-16

These requests seek documents relating to the sale and advertising of applicant's goods under her mark. These requests are relevant to show the manner in which applicant's mark has been used as well as the dates of use, which factors are relevant to a fraud inquiry. Accordingly, applicant must produce non-privileged documents responsive to these requests. As the matter involved regarding these requests may be confidential, production may be made under the terms of a suitable protective agreement. If the parties have not yet entered into a protective agreement, they are advised that the Board's standard protective order governs this proceeding. The standard protective order can be viewed using the following web address:
<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>

Request No. 23

Request No. 23 seeks communications, including e-mails, concerning opposer. Applicant responds that "producing said e-mails would violate attorney/client privilege." Applicant must produce any non-privileged documents responsive to this request, or affirmatively state that none exist. With respect to privileged documents, applicant is ordered to prepare a privilege log to identify the documents and explain the bases for the privilege. Fed. R. Civ. P. 26(b) (5) (A) (ii).

Request Nos. 27-33

These requests seek documents relied upon by applicant that support or contravene her denials of allegations contained in the notice of opposition in paragraphs 13-19. Applicant objects to responding on the ground that request No. 27 contains an error in the date. In view thereof, the date in request No. 27 is hereby construed as either June 25, 2005 or October 1, 2005, and applicant is ordered to respond to the request as amended, providing information with respect to both dates (as noted earlier, applicant should have clarified the intended date with opposer). Applicant is further ordered to supplement her response to requests Nos. 28-33 or affirmatively state that no further responsive documents exist. Applicant need not produce

documents that contravene her case or tend to prove opposer's case.

Request No. 36

This request seeks documents that support or contravene applicant's affirmative defenses of acquiescence and estoppel. Applicant need not produce documents that contravene her case or tend to prove opposer's case. Applicant produced "items from the Trademark Electronic Search System (TESS)." The response is sufficient; however, applicant is reminded of her continuing duty to supplement her response and that she may be estopped from producing any documents at trial which have not been produced during discovery that are responsive to this request. See TBMP § 527.01(e) (2d ed. rev. 2004).

SUMMARY

Opposer's motion to compel is hereby granted. Applicant is allowed until THIRTY DAYS from the mailing date of this order to supplement her responses to Interrogatory Nos. 1, 2, 4-6, 15-18, 19-20, 23 and 24; to answer Interrogatory Nos. 28-30; and to produce documents and/or a privilege log in response to Document Production Request Nos. 1, 2, 3, 4-6, 14-16, 23, 27-33, and 36.

Dates, including pretrial disclosures and the close of discovery, are reset as follows:²

Discovery Closes	2/20/09
Plaintiff's Pretrial Disclosures Due	4/6/09
Plaintiff's 30-day Trial Period Ends	5/21/09
Defendant's Pretrial Disclosures Due	6/5/09
Defendant's 30-day Trial Period Ends	7/20/09
Plaintiff's Rebuttal Disclosures Due	8/4/09
Plaintiff's 15-day Rebuttal Period Ends	9/3/09

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.

² Because the motion to compel was filed after the date the parties' expert disclosures were due, the Board presumes the parties exchanged the appropriate expert disclosures.