

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

EJW

**Mailed: July 30, 2009**

**Opposition No. 91181380**

Opposition No. 91181381

Opposition No. 91181383

Opposition No. 91181384

Opposition No. 91181385

Opposition No. 91181386

Opposition No. 91181388

**E. & J. GALLO WINERY**

**v.**

**MIMULANI AG**

**ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:**

On July 30, 2009, at 2:00 p.m. (EST), the parties, E. & J. GALLO WINERY (represented by Seth Appel of Harvey Siskind LLP)<sup>1</sup> and MIMULANI AG (represented by Mark Lebow and Jeffrey Goehring of Young & Thompson), and Elizabeth Winter, the assigned Interlocutory Attorney, participated in a telephone conference regarding applicant's fully briefed motion (filed December 30, 2008) to compel and opposer's unopposed motion (filed December 31, 2008) to reopen its time for discovery. See Trademark Rules 2.120(i)(1) and 2.127(c); and TBMP §

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<sup>1</sup> The Board notes the appearance of Seth Appel of Harvey Siskind LLP on behalf of opposer on July 20, 2009.

**Opposition No. 91181380**

502.06 (2d ed. rev. 2004). This proceeding has been suspended since December 31, 2008.<sup>2</sup>

This order summarizes the conference and the Board's orders regarding said motion to compel and opposer's motion to reopen the discovery period.

Motion to Compel

Applicant's motion requests that the Board issue an order compelling<sup>3</sup> responses or sufficient responses to certain interrogatories, requests for production of documents, and requests for admission.<sup>4</sup>

*Good Faith Requirement*

Trademark Rules 2.120(e)(1) and 2.120(h)(1),

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<sup>2</sup> As mentioned at the outset of the conference, the Board regrets the delay in addressing the subject motions.

<sup>3</sup> At the outset, the Board noted that the proper method for addressing insufficient responses to requests for admission is the filing of a motion to determine the sufficiency of an answer or objection to admission requests, not a motion to compel. See Fed. R. Civ. P. 36(a); and Trademark Rule 2.120(h), 37 C.F.R. § 2.120(h). See also TBMP § 411.02 (2d ed. rev. 2004). Nonetheless, the Board advised the parties that it would construe applicant's motion to compel in regard to its requests for admission to opposer as a motion to test the sufficiency of opposer's responses to applicant's requests for admission. See *Watercare Corp. v. Midwesco-Enterprise, Inc.*, 171 USPQ 696, 697 n.7 (TTAB 1971) ("As to the propriety of applicant's answers thereto, if opposer, upon receipt of the answers, was of the opinion that they were a sham or non-responsive, the appropriate action would have been to request the Board to require applicant to fully respond thereto").

<sup>4</sup> Applicant seeks sufficient responses to interrogatory nos. 3 and 4; to requests for production of documents nos. 1, 4 and 5; and to the following requests for admission: 5, 23 and 26 from applicant's first set and 53 requests from three groups of requests for admission from applicant's second set of requests for admission.

**Opposition No. 91181380**

respectively, require that a motion to compel and a motion to determine the sufficiency of an answer or objection to admission requests must be supported by a written statement from the moving party that such party or its attorney has made a good faith effort, by conference or correspondence, to resolve with the other party or its attorney the issues presented by the motion, and has been unable to reach an agreement. See TBMP §§ 523.01 and 524.01 (2d ed. rev. 2004).

Upon careful review of the motion to compel, the Board finds that applicant did not satisfy its obligation under the Trademark Rules to make a good faith effort to resolve discovery dispute between the parties prior to seeking the Board's intervention. In particular, the Board finds that applicant did not allow sufficient time for the parties to 'meet and confer' to resolve the discovery dispute as it requested in its December 16, 2008 email to opposer's counsel. During the conference, the Board noted that opposer's counsel stated in his December 16, 2008 email to applicant's counsel that he would be unable to respond to applicant's concerns until the following week. In view of the Christmas holiday during the week subsequent to the exchange of emails, before burdening the Board with the present motion, applicant should have inquired of opposer as to when it would respond to applicant's email regarding

**Opposition No. 91181380**

opposer's discovery responses. A party seeking discovery has a duty to make a good faith effort to determine why no response has been made before coming to the Board with a motion to compel. *See, e.g., MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 954 (TTAB 1979). *See also* TBMP § 523.02 (2d ed. rev. 2004). Further, upon receiving the phone messages from Mr. Harvey left for applicant's counsel (*i.e.* for both Mr. Lebow and Mr. Goehring) on December 29, 2008 and Mr. Harvey's emailed correspondence sent on the same date (see Harvey declaration ¶¶ 2-3), applicant should have requested that new counsel file an appearance with the Board and should have made an effort to arrange a conference to 'meet and confer' with opposer's new counsel, rather than ignoring the communications of opposer's new counsel and filing the motion to compel. The Board is not persuaded that opposer's correspondence shows that "it is clear" that opposer's new counsel "was interested only in discussing its issues with Mimulani's discovery and had no intention of making a response to Mimulani's email of December 16 that would narrow the issue[s]" (reply brief, p. 4). In view of the foregoing, the Board finds that applicant has not complied with the good faith requirement set forth in Trademark Rules 2.120(e)(1) and 2.120(h)(1). Accordingly, applicant's motion to compel is denied.

**Opposition No. 91181380**

Nonetheless, the parties are directed to work together to resolve their discovery problems, in the spirit of good faith and cooperation which is required of all litigants in Board proceedings. No further motions to compel should be filed unless the parties are truly unable after making their best efforts, to work out mutually acceptable solutions to all of their discovery problems without the Board's help.

The Board also offered general comments and reminders regarding issues raised by the parties' discovery dispute, which are repeated as follows.

Opposer was reminded that information concerning settlement and contractual agreements between it and third parties based on the involved mark is discoverable. However, the Board also clarified that information related to a party's foreign use of its involved mark is usually irrelevant to Board proceedings. See TBMP §§ 414(10) and (13) (2d ed. rev. 2004) and cases cited therein.

The Board reminded applicant that requests for "all documents" without any temporal or geographic limitation is not in conformance with the parties' obligation to make a good faith effort to seek only such discovery as is proper and relevant to the specific issues involved in the proceeding. See TBMP *Id.* at § 402.01. Furthermore, a party need not provide discovery with respect to marks or to goods and/or services that are not involved in the proceeding and

**Opposition No. 91181380**

have no relevance thereto. *Id.* at § 414(11). As to discovery requests that are allegedly "unduly burdensome," the Board reminded opposer that where complete compliance with a particular request would be so burdensome, a representative sampling may be provided. *Id.* at § 414(12).

The Board instructed the parties that, in general, if a party states that there are no documents available in response to a particular request for production of documents, such a response is sufficient. Nonetheless, opposer was also reminded that, if a party provides an incomplete response to a discovery request, that party, upon a timely raised objection, may not thereafter rely at trial on information from its records which was properly sought in the discovery request, but which was not included in the response thereto, unless the response is supplemented in a timely fashion pursuant to Fed. R. Civ. P. 26(e). *See Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718 (TTAB 1987); and TBMP § 408.02 (2d ed. rev. 2004). Opposer was further reminded that, should it be later found to have willfully withheld discovery responses, introduction of such withheld evidence may be precluded upon a motion to strike.

Both parties are reminded of their duty to thoroughly search their records for all information properly sought in discovery, and to provide such information to the requesting party. *See TBMP Id.* at § 408.02. Further, a party that has

**Opposition No. 91181380**

responded to a request for discovery with a response is under a duty to supplement or correct the response to include information thereafter acquired or uncovered. *Id.* at § 408.03.

Motion to Reopen Discovery

In accordance with the Board's rescheduling order mailed August 20, 2008, discovery was set to close on December 25, 2008. In its motion to reopen discovery filed on December 31, 2008, opposer requests that the Board reopen the discovery period for ninety days.

As a preliminary matter, the Board determined that opposer's motion to reopen was germane to the motion to compel and is properly before the Board. In this particular instance, inasmuch as the motion to reopen may directly affect the Board's resetting of the trial periods in this matter and potentially further clarifies the entirety of the parties' discovery disputes, opposer's motion to reopen is germane to the previously filed motion to compel.

The Board also advised the parties that, in view of the standard applicable to opposer's motion, the Board would not grant opposer's motion to reopen as uncontested. See *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership*, 507 U.S. 380 (1993), as discussed by the Board in *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997). The Board notes further that applicant had

**Opposition No. 91181380**

argued implicitly in its reply brief to the motion to compel that opposer's motion to reopen was improperly filed "even after the Board suspended the proceeding" (reply brief, p. 5). Thus, applicant clearly opposes opposer's motion to reopen discovery and did not file an opposition brief based on the Board's suspension order. In view thereof, the Board will exercise its discretion to review opposer's motion on the merits.

However, during the course of the conference, applicant asserted, *inter alia*, that it had documentation that would show that opposer had indeed received applicant's responses to opposer's discovery requests in October, 2008 and that, consequently, opposer's allegations in support of its motion to reopen were based on bad faith and essentially constituted evidence of opposer's alleged failure to conduct discovery earlier in the discovery period. Applicant requested that the Board allow it time to submit a brief in opposition to opposer's motion to reopen.

Inasmuch as "... the determination of excusable neglect is at bottom an equitable one, taking account of all relevant circumstances surrounding the party's omission," including whether the movant acted in good faith, the Board granted applicant's request to file an opposition brief. See *Pioneer*, 507 U.S. at 395.

**Opposition No. 91181380**

Accordingly, applicant is allowed until **FIFTEEN DAYS** from the date of the subject teleconference, that is, until August 14, 2009 to file its brief in response to opposer's motion to reopen discovery; and opposer is allowed until **FIFTEEN DAYS** from the date of service of said brief, if any, to file its reply brief thereto. See Trademark Rule 2.127(a).

Proceedings herein remain otherwise **SUSPENDED**.



**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>