

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

MBA

Mailed: December 7, 2009

Opposition No. 91187118

Amazon Technologies, Inc.

v.

Jeffrey S. Wax

Michael B. Adlin, Interlocutory Attorney:

This case now comes up for consideration of: (1) opposer's motion, filed November 19, 2009, for reconsideration of the Board's order of November 4, 2009 (the "Prior Order"); and (2) applicant's motion, filed November 25, 2009, to substitute Jeffrey S. Wax for Steven M. Freeland. In addition, on November 25, 2009, opposer filed a combined motion for leave to amend its notice of opposition to add new claims, and for summary judgment on the proposed new claims. Applicant has not yet responded to opposer's motions for reconsideration or for leave to amend and for summary judgment, while applicant's motion to substitute is effectively conceded and is therefore **GRANTED**.¹ Trademark Rule 2.127(a). Accordingly, Jeffrey S. Wax is substituted for

¹ In its response to applicant's motion to substitute, opposer "agrees that Mr. Wax should now be the sole Applicant," but "clarifies" that "the proper action would be to substitute Jeffrey S. Wax as sole Applicant ..." (emphasis in original).

Steven M. Freeland as the sole applicant herein, and the caption of this proceeding is amended accordingly.²

Motion for Reconsideration³

Turning to the motion for reconsideration, in its Prior Order⁴ the Board granted applicant's motions to compel responses to his written discovery requests and to test the sufficiency of opposer's responses to applicant's requests for admission. The Board found that opposer's stated reason for refusing to substantively respond to applicant's discovery requests -- its mistaken belief that applicant failed to serve initial disclosures -- was invalid under the circumstances of this case, for two primary reasons. First, applicant did in fact timely serve his initial disclosures, and thus complied with Trademark Rule 2.120(a)(3), which provides that "[a] party must make its initial disclosures prior to seeking discovery." Second, opposer failed to specifically state the basis for its refusal to substantively respond to applicant's discovery requests,

² The involved application was assigned to Mr. Wax as recorded with the Office on June 17, 2009 at Reel 4007, Frame 0486.

³ The Board exercises its discretion to decide the motion for reconsideration prior to receiving applicant's response thereto.

⁴ While the Prior Order did not address any potentially dispositive motions and was therefore not issued by a panel of Administrative Trademark Judges, it nevertheless issued as Board precedent. Therefore, in accordance with standard Board procedure, it issued as a precedent only after being reviewed and approved by the Chief Administrative Trademark Judge and then circulated for additional review by all of the Board's Administrative Trademark Judges.

either in its objections to the discovery requests themselves, or during the "meet and confer" process leading to the filing of opposer's motions to compel and to test the sufficiency. The Board found that opposer's failure to state its objection specifically resulted "in the filing of and consideration of an unnecessary motion to compel."

Prior Order at p. 8.

Opposer requests reconsideration of the Prior Order, arguing that "the decision of the Board was in error." Essentially, opposer contends that because Trademark Rule 2.120(a)(3) is one of the Board's "new rules," which went into effect two years ago, the cases and rules upon which the Prior Order is based, all of which predate the "new rules," are inapposite. Opposer further argues that "the plain language of the rules and prior Board decisions have shown that a party's failure to make initial disclosures ... **forecloses** the ability of such party to propound discovery ..." (emphasis in original). According to opposer, "[t]his is a one-step analysis," but the Board erred in adopting a second step, i.e. considering "whether the responding party had sufficiently objected to the failure of the propounding party to make its initial disclosures." Opposer claims that the Board erroneously "held that Opposer had an affirmative duty to provide proactive legal counsel

to Applicant," even though applicant "is an attorney specializing in Board proceedings."

Finally, opposer claims that the Board erred in overruling opposer's additional objections which were not based on applicant's "failure to comply with the applicable rules." Specifically, opposer argues that it "believed it had provided appropriate general and specific objections," and that "Applicant should be estopped from challenging Opposer's objections to Applicant's discovery requests to the extent that Applicant has itself objected to identical discovery requests."

A motion for reconsideration "may not properly be used to introduce additional evidence, nor should it be devoted simply to a reargument of the points presented in a brief on the original motion." TBMP § 518 (2d ed. rev. 2004). Instead, a motion for reconsideration "should be limited to a demonstration that based on the facts before it and the applicable law, the Board's ruling is in error and requires appropriate change." Id.

Opposer's motion for reconsideration is hereby **DENIED**. First, and perhaps most importantly, opposer does not specifically dispute that applicant timely served his initial disclosures and thus met Trademark Rule 2.120(a)(3)'s prerequisite for serving discovery. Applicant's compliance with the Rule was, by itself, a

sufficient basis upon which to overrule opposer's objection that applicant did not comply with the Rule. It was also, by itself, sufficient basis upon which to grant applicant's motions to compel and to test the sufficiency, because opposer's opposition to applicant's motions was based entirely on opposer's mistaken belief that applicant failed to comply with the Rule. Therefore, the Prior Order was not in error.

Second, the Prior Order is in no way "inconsistent with" MySpace Inc. v. Mitchell, 91 USPQ2d 1060 (TTAB 2009) or Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC, 88 USPQ2d 1541 (2008), as opposer alleges. In MySpace, the defendant failed to serve initial disclosures, and its motion to compel discovery responses was therefore denied, while the plaintiff's motion to compel initial disclosures was granted. Here, of course, and by sharp contrast, applicant timely served initial disclosures, and if opposer had merely stated its mistaken belief that applicant had not done so, there presumably would have been no motion to compel in the first place. In Kairos, the Board simply indicated that parties must comply with Trademark Rule 2.120(a)(3) by timely serving initial disclosures, something applicant did here.

Third, opposer is simply wrong in arguing that there is no duty to object specifically to discovery requests, and it

simply does not matter whether the objection is based on the mistaken belief that initial disclosures were not served, or on other grounds. See, e.g., Fed. R. Civ. P. 33(b)(4) and Advisory Committee Note to 1993 Amendment thereto; Redland Soccer Club, Inc. v. Department of the Army, 55 F.3d 827, 856 (3d Cir. 1995); McLeod, Alexander, Powel & Apffel, P.C. v. Quarles, 894 F.2d 1482, 1485 (5th Cir. 1990); St. Paul Reinsurance Co., Ltd. v. Commercial Financial Corp., 198 F.R.D. 508, 514 (N.D. Iowa 2000); Safeco Insurance Co. of America v. Rawstrom, 183 F.R.D. 668 (C.D. Cal. 1998); and Medtronic, Inc. v. Pacesetter Systems, Inc., 222 USPQ 80 (TTAB 1984). Opposer utterly fails to address, let alone contradict or distinguish, any of this authority supporting the Prior Order.⁵ Furthermore, while the cited authorities predate the Board's "new rules," this case perfectly illustrates why they are applicable here nonetheless and why they support the Prior Order. The cited authority makes clear that a party must specifically state its objections to discovery requests with particularity. Had opposer stated its objection specifically and with particularity in this

⁵ While opposer contends that Medtronic is "not applicable" herein because it addresses interrogatories alleged to be excessive in number, the Prior Order cited Medtronic only for the propositions that: (1) objections must be stated with particularity; and (2) a party may not contend that a discovery request is proper when propounded by the party itself, but improper when propounded by its adversary. Prior Order at pp. 5, 9.

case, there would have been no need for the Board to consider a motion to compel, and this proceeding would be much farther along than it is. In fact, the point of the Prior Order was not that opposer had an obligation to respond to the discovery requests when it mistakenly believed that applicant failed to serve initial disclosures, but rather that if opposer had simply stated its belief, as it was required to do under the applicable rules and cases, opposer would have quickly discovered that its belief was, in fact, mistaken, and that it therefore was obligated to respond to applicant's discovery requests.⁶

Fourth, the Board did not, as opposer contends, hold that opposer "had an affirmative duty to provide proactive legal counsel to Applicant." There are no words in the Prior Order approximating or even implying such a statement. The Prior Order merely held that opposer was required to object specifically, so as to not obstruct applicant, its counsel or the Board in its efforts to advance this proceeding.⁷ Stating an objection specifically is necessary if discovery is to be conducted efficiently. And discovery

⁶ Even opposer concedes that where a party believes that the number of interrogatories served exceeds the Board's limit, the party must serve an objection "on the ground of their excessive number," i.e. a specific and particular objection. Opposer's Motion for Reconsideration at 2 n. 1.

⁷ Opposer's claim that stating its objection specifically would result in a violation of opposer's counsel's "duties of loyalty and zealous advocacy to Opposer" is frivolous and would turn the discovery process on its head.

should not be treated as a shell game, especially during the meet and confer process, the purpose of which "is to promote a frank exchange between counsel to resolve issues by agreement or to at least narrow and focus the matters in controversy before judicial resolution is sought." Dondi Properties Corp. v. Commerce Savings and Loan Ass'n, 121 F.R.D. 284, 289 (N.D. Tex. 1988) (emphasis in original); see also, Nevada Power Co. v. Monsanto Co., 151 F.R.D. 118, 120 (D. Nev. 1993); Sentrol, Inc. v. Sentex Systems, Inc., 231 USPQ 666, 667 (TTAB 1986). Opposer once again does not address, much less contradict or distinguish, this authority. Furthermore, it cannot escape notice that although opposer contends that its non-specific objection that applicant failed "to comply with the applicable rules" was appropriate and sufficient, opposer did not state its objection in that manner in its response to applicant's motions to compel and to test the sufficiency. Rather, in its response to applicant's motions, opposer was for the first time specific, and mentioned, for the first time, its mistaken belief that applicant failed to serve initial disclosures. There is simply no valid reason for opposer to cloak its objection in responding to applicant's discovery requests and during the meet and confer process, and only reveal it in its response to applicant's motions. As the Prior Order held and opposer does not dispute, "the parties

must present to each other the merits of their respective positions with the same candor, specificity, and support during informal negotiations as during the briefing of discovery motions." Nevada Power, 151 F.R.D. at 120 (emphasis supplied)

Finally, opposer is incorrect in arguing that the Board did not cite authority for the proposition that opposer's boilerplate, non-specific objections were waived. See e.g., Fed. R. Civ. P. 33(b)(4); Prior Order at p. 5 and 9-10. Furthermore, opposer has not, either in its response to applicant's motions or in its motion for reconsideration of the Prior Order, argued that any particular discovery request was objectionable in any specific manner, and as held in the Prior Order and herein, its objection based on its mistaken belief that applicant failed to comply with Trademark Rule 2.120(a)(3) was invalid.⁸ Opposer's claim that applicant "should be estopped from challenging Opposer's objections to Applicant's discovery requests to the extent Applicant has itself objected to identical

⁸ Opposer's mere claim that it made certain specific objections does not make it so. A review of opposer's discovery objections reveals that it made virtually identical, boilerplate objections to each and every one of opposer's discovery requests. The boilerplate, virtually identical objections were anything but specific, and instead asserted vaguely and without reference to any particular request or issue in this case, that the requests were, for example, "not reasonably calculated to lead to the discovery of admissible evidence," "overbroad and unduly burdensome" and "vague and ambiguous." Such objections are asserted far too often in Board proceedings, apparently merely because they exist and are available for use.

discovery requests" misapprehends the applicable rule, which applies to the objecting party who is attempting to avoid responding to discovery requests, in this case opposer.

TBMP § 402.01 (2d ed. rev. 2004). If opposer believed that applicant's objections to opposer's discovery requests were improper, its remedy, which it chose not to pursue, was to file its own motion to compel.

While opposer's motion for reconsideration effectively tolled opposer's deadline for complying with the Prior Order, its motion has now been denied. Accordingly, opposer is hereby ordered to serve, no later than **TWENTY DAYS** from the mailing date of this order, its responses, without objection on the merits, to applicant's first sets of interrogatories, requests for production and requests for admission. In the event opposer fails to respond to applicant's discovery requests as ordered herein, opposer may be subject to sanctions, potentially including entry of judgment against it. Fed. R. Civ. P. 37(b)(2); Trademark Rule 2.120(g).

Opposer's Motion for Leave to Amend and for Summary Judgment

Opposer filed its motion for leave to amend and for summary judgment before it complied with the Prior Order. The motion for summary judgment, because it seeks entry of judgment on the proposed new claims, cannot be considered unless and until the new claims are allowed. Accordingly,

consideration of the motion for summary judgment is deferred, and this case shall proceed for consideration only of the motion to amend the notice of opposition. Such motion, not being potentially dispositive of the proceeding, does not result in suspension of proceedings, including opposer's obligation to comply with the Prior Order and this order.

Within **TWENTY DAYS** of the mailing date of this order, applicant shall respond to opposer's motion for leave to amend only, and opposer's reply brief, if any, shall be due in accordance with Trademark Rule 2.127(a). The Board will then decide opposer's motion for leave to amend, for only if that motion is granted will the Board need to reach the motion for summary judgment. In the event opposer's motion for leave to amend is granted, the Board will then suspend proceedings and set the remaining briefing schedule for opposer's motion for summary judgment.

Meet and Confer Requirement Imposed for All Motions

From this point forward, the Board will not entertain any new pre-trial motion, whether presented in a formal filing or made orally by teleconference with both parties, unless the moving party certifies, in a written statement, that it has made a good faith effort, **by both correspondence and oral discussion**, to resolve the issues presented but was unable to do so. This requirement will be strictly

enforced, and any failure by either or both parties to conduct a full and candid discussion of all issues presented by the motion will be grounds upon which to deny or decline to consider any motion.

Conclusion

Opposer's motion for reconsideration is denied and applicant's motion to substitute is granted. Consideration of opposer's motion for leave to amend is deferred. Opposer's motion for summary judgment will be considered only if opposer's motion for leave to amend is granted. Discovery, disclosure, trial and other dates are reset as follows:

Follow-Up Discovery Period for Applicant Only Closes	January 21, 2010
Plaintiff's Pretrial Disclosures	March 7, 2010
Plaintiff's 30-day Trial Period Ends	April 21, 2010
Defendant's Pretrial Disclosures	May 6, 2010
Defendant's 30-day Trial Period Ends	June 20, 2010
Plaintiff's Rebuttal Disclosures	July 5, 2010
Plaintiff's 15-day Rebuttal Period Ends	August 4, 2010

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.

Opposition No. 91187118

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.
