

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

Mailed: January 3, 2012

Opposition No. 91188736

Anastasia Beverly Hills,  
Inc., Anastasia Soare, and  
Anastasia Skin Care Inc.

v.

Anastasia Marie Laboratories,  
Inc.

**M. Catherine Faint,  
Interlocutory Attorney:**

This case comes up on applicant/counterclaim petitioner's ("AML") motion, filed April 26, 2011, to compel supplemental discovery responses relating largely to the issues of priority and use, and/or abandonment, of opposer/counterclaim respondent's ("ABH") marks for "all of the goods and services" identified in the application underlying ABH's four pleaded registrations, two of which are the subject of counterclaims for fraud as to Class 3 only.<sup>1</sup> Also before the Board is AML's motion to extend discovery by 60 days. These contested motions are fully-briefed and the Board held a phone hearing on December 30, 2011. The participants were Allan Z. Litovsky,

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<sup>1</sup> The Board previously reviewed the pleadings and amended counterclaims in its prior order of June 30, 2010 order denying summary judgment.

attorney for ABH, Brewster Taylor attorney for AML, and Catherine Faint, Interlocutory Attorney for the Board.

The Board carefully considered the arguments raised by counsel for both parties, as well as the supporting correspondence and the record of this case, in coming to a determination regarding the above matters. During the telephone conference, the Board made the following findings and determinations.

**I. Revocation and Appointment of Counsel for ABH**

On December 21, 2011, Raluca Carp, identified as "Business Administrator" for ABH submitted through counsel an executed revocation of attorney and appointment of new attorney. Accordingly, Allan Z. Litovsky of Greenberg Traurig, LLP is recognized as attorney of record for ABH.<sup>2</sup> Trademark Rule 2.19(a).

**II. Motion to Compel**

As part of its response to the motion, ABH provided additional documents and interrogatory responses. In its reply, AML narrowed its requests slightly, but maintains that ABH should be ordered to produce additional documents responsive to Document Request Nos. 3, 9, 10 and 23 of its Third Request for Production; and provide complete responses to Interrogatory Nos. 10 and 11.

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<sup>2</sup> John May and Berliner Associates are no longer counsel of record for ABH.

**A. Background**

By way of background, the Board notes that two of ABH's registrations subject to counterclaims have been amended by prior order of the Board, deleting certain of the goods. AML's motion to compel seeks supplementation of discovery related to all of the goods and services as originally identified in the four registrations pleaded by ABH.

**B. Documents Relating to Claims of First Use and Priority**

AML's Document Request Nos. 3 and 23 in its Third Set of Document Requests seek documents to show the first sale of each product which has been sold under any of ABH's claimed marks and documents that would support ABH's claim of priority.

Document Request No. 3: For each of opposer's products, produce those documents sufficient to show the earliest sale of the product under any of the Opposer's Marks anywhere, and the sale the product under any of Opposer's Marks in commerce.

Document Request No. 23: Produce any and all documents that support Opposer's position of having prior rights with respect to the use of "ANASTASIA" as or in a mark for skin care products.

In its response ABH states that its Exhibit C (filed under seal) reflects the sale and shipment to a specific store of each type of Class 3 product described in ABH's amended registrations for ABH Marks. AML argues that ABH has produced documents which purport to show first sales only as to those goods in the amended registrations, while the document request

seeks documents to show first sales of *all* products with which the marks have been used.

With regard to Document Request No. 23, ABH argues that the documents produced in response to Request No. 3 also reflect that ABH used the marks on one specific product, "After Tweeze Cream," at least as early as March 2000. AML argues that this answer does not clarify whether ABH has additional documents in its possession with which it will support its claim of priority as to the more general category of skin care products.

Information regarding a party's first use of its involved marks is discoverable. *See, e.g., Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193, 195-96 (TTAB 1976) (dates petitioner's plants first began production of goods bearing mark are pertinent to claim of priority); and *Miller & Fink Corp. v. Servicemaster Hospital Corp.*, 184 USPQ 495, 496 (TTAB 1975) (must provide name, address and affiliation of persons to whom service was first rendered). By its answers, ABH has effectively stated that it has produced the documents requested. However, if new counsel for ABH becomes aware of any documents responsive to these requests, it must produce those documents. Fed. R. Civ. P. 26(e). If there are documents which have not been produced, and ABH submits them at trial, AML may seek to preclude ABH from relying on information or documents which should have been produced in response to any

of AML's discovery requests, but were not. *See, Panda Travel, Inc. v. Resort Option Enterprises, Inc.*, 94 USPQ2d 1789, 1792, (TTAB 2009) (granting motion to strike where party provided no reason for failing to serve documents responsive to discovery requests before trial opened).

Accordingly, ABH's motion to compel is **denied** with respect to Document Request Nos. 3 and 23.

**C. Documents Showing Sales of Goods and Rendering of Services Under the Marks**

Document Request Nos. 9 and 10 seek documents relating to the sale of goods and income from services rendered under ABH's marks from the dates of first use to the present.

Document Request No. 9: Produce those documents sufficient to show the dollar value of actual sales of each of Opposers' Products for each year beginning with the date of first use of any of Opposers' Marks in connection with the sale of the product.

Document Request No. 10: Produce those documents sufficient to show the dollar value of income received from rendering each of Opposers' Services for each year beginning with the first use of any of Opposers' Marks in connection with the rendering of services.

AML argues that ABH's supplemental documents supplied with its response to the motion to compel 1) do not provide sufficient explanation about what is shown by the now "discovered" QuickBooks file report for the period 2000-2004; 2) still do not include sales records for ABH-branded products for the period 2005-2010, but only shipments of products, which

ABH claims is a more accurate picture of sales; and 3) do not show annual income from salon services under the marks.

With regard to the QuickBooks sales records for 2000-2004, ABH provides declarations under seal from ABH employees Raluca Carp and Constantin Stan which appear to provide the explanation AML seeks in its reply brief as to why the records are incomplete, and why products are identified only as "product." ABH also states that it does not have, and does not know of a way to generate complete and accurate reports of yearly revenue for sales prior to 2005, but that it would make the electronic file available for forensic analysis. During the teleconference counsel for AML stated that the electronic QuickBooks file for 2000-2004 had not yet been produced.

With regard to sales records for 2005-2010, to the extent that ABH has records to show sales by item for the years 2005-2010, those records must be produced, although they may be annual sales in round numbers. *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689, 690 (TTAB 1975) (compelled to provide figures for each of last five years by category). Annual sales, in volume and dollar amount, in round numbers, are discoverable. *See American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 123 (TTAB 1974) (compelled to furnish round figures concerning sales under mark for period of five years); *see also* TBMP § 414(18).

With regard to annual sales of salon services, ABH argues that it has provided what documents it has breaking down the dollar value per year of each individual service rendered in the ABH salon, and knows of no way to generate reports summarizing the dollar value of total sales of each of its services rendered in the salon. AML argues in reply that this misrepresents what was requested. AML seeks documents showing annual income from rendering salon services under the marks. To the extent it has such documents, ABH must provide documents to show annual sales from rendering salon services. *Id.*

Accordingly, the motion to compel is **granted in part** with regard to Document Request Nos. 9 and 10, to the extent that ABH must provide, within **THIRTY DAYS** of the mailing date of this order, the electronic QuickBooks file of sales records for the years 2000-2004, records to show annual sales by item, in round numbers, for the years 2005-2010, and annual sales for the years 2000-2010 from rendering salon services. The motion is otherwise **denied** as to these requests. ABH is again cautioned, however, that to the extent there are documents or things that are responsive and have not been produced, ABH has a duty to supplement its discovery if any additional responsive documents are discovered.

**D. Responses to Interrogatories Relating to Interruption of Use**

With regard to Interrogatory Nos. 10 and 11, ABH supplemented its responses, under seal, at the time of filing its response to the motion to compel. AML acknowledges those supplemental responses but argues that the answers remain misleading and incomplete. In view of the supplemental responses and documentary evidence provided, the Board finds the responses adequate. Accordingly, AML's motion to compel is **denied** as to Interrogatory Nos. 10 and 11.

### **III. Motion to Extend Discovery**

AML seeks an extension of discovery for an additional sixty days from the date of this order to enable it to follow-up on the discovery that resulted from the motion to compel and to allow time for amendment of the counterclaims to add claims of priority and likelihood of confusion and abandonment. ABH allows that it would consent to a thirty day extension, but contends that AML has "squandered" the discovery period.

The standard for allowing an extension of a prescribed period prior to the expiration of that period is good cause. See Fed. R. Civ. P. 6(b)(1) and TBMP Section 509.01 (2d ed. rev. 2004). Ordinarily, the Board is liberal in granting extensions of time before the period to act has elapsed, so long as the moving party has not been guilty of negligence or bad faith and the privilege of extensions is not abused. *American Vitamin*

*Products Inc. v. DowBrands Inc.*, 22 USPQ2d 1312, 1314 (TTAB 1992).

The Board finds that on the facts presented here, AML is not guilty of bad faith or negligence, nor has it abused the privilege of extensions. The Board also notes that ABH appears to have provided its supplemental discovery in response to this motion to compel, but must make further responses as ordered herein. In view thereof, the motion to extend time is granted.

As discussed during the teleconference, AML contemplates filing its motion to further amend the counterclaims, at which point the Board may also consider consolidation of this case with the other related Board proceedings, Cancellation Nos. 92052119, 92053884 and 92053888.

Dates are reset as set out below.

Discovery Closes	February 28, 2012
Plaintiff's Pretrial Disclosures	April 13, 2012
30-day testimony period for plaintiff's testimony to close	May 28, 2012
Defendant/Counterclaim Plaintiff's Pretrial Disclosures	June 12, 2012
30-day testimony period for defendant and plaintiff in the counterclaim to close	July 27, 2012
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	August 11, 2012
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	September 25, 2012
Counterclaim Plaintiff's Rebuttal Disclosures Due	October 10, 2012
15-day rebuttal period for plaintiff in the counterclaim to close	November 9, 2012

Brief for plaintiff due	January 8, 2013
Brief for defendant and plaintiff in the counterclaim due	February 7, 2013
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	March 9, 2013
Reply brief, if any, for plaintiff in the counterclaim due	March 24, 2013

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. A copy of this order has been sent to all persons listed below.

**cc:**

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