

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

Mailed: June 28, 2010

Opposition No. 91188903

Apple Inc.

v.

Fabasoft AG

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

On June 25, 2010 the Board held a telephone conference involving Alicia Grahn Jones and Joseph Petersen, counsel for Apple, Inc., Stewart J. Bellus, counsel for Fabasoft AG, and Interlocutory attorney Catherine Faint.

The Board thanks the parties for their participation in the telephone conference.

Before the Board is opposer's motion to compel service of initial disclosures, responses to interrogatories and production of documents, and for an order deeming its requests for admissions admitted. In response to the motion, applicant filed a motion to suspend for a civil action in a foreign court. Opposer filed a response in opposition to the motion to suspend, and a reply brief in support of its motion to compel. The Board ordered applicant to submit a copy of the pleadings in the German court. Applicant submitted a response stating

that the German pleadings comprise a large number of pages with a translation charge of 50 euros per page, and thus it was submitting an "abstract" instead of the pleadings.

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.

Applicant's Motion to Suspend Pending Determination of German proceeding.

The involved application Serial No. 77460315 was filed based on Trademark Act § 44(e). The Board inquired whether the German proceeding involved applicant's underlying Austrian Registration No. 240 545.

Counsel responded that the underlying Austrian registration was not involved in the German proceeding, but applicant's position is that the German litigation would have an impact on how the parties perceived their positions in the USPTO proceedings.

Normally the Board may suspend a proceeding pending final determination of a foreign action between the parties, wherein one party challenges the validity of a foreign registration upon which the party's subject application is based. *See Marie Claire Album S.A. v. Kruger GmbH & Co. KG*, 29 USPQ2d 1792, 1794 (TTAB 1993) (opposition proceeding suspended pending decision

of German court on validity of foreign registration which is basis of U.S. application involved in same opposition).

As the German proceeding does not involve the underlying Austrian registration, the motion to suspend is denied.

Opposer's motion to order service by applicant of its initial disclosures

Applicant's initial disclosures were due May 29, 2009. No initial disclosures have been served on opposer. Applicant is hereby ordered to serve, no later than **THIRTY (30) DAYS** from the date of this teleconference, its initial disclosures.

Applicant is reminded that a party must make its initial disclosures prior to seeking discovery. Trademark Rule 2.120(a)(3).

Opposer's first set of interrogatories and first set of requests for production of documents

Opposer declares that it served initial discovery requests on applicant on June 25, 2009. Responses were due July 31, 2009. No responses have been served on opposer. In response to the Board's inquiry, applicant's counsel responded that discovery responses have not been served.

Opposer's motion to compel is granted. Moreover, applicant, by failing to timely respond to the discovery requests, has forfeited its right to object to the requests on their merits.¹ See *Envirotech Corp. v. Compagnie Des*

¹ Applicant is not required to produce privileged documents or provide privileged information, as its right to claim privilege has not been waived. See e.g., *American Standard, Inc. v. Pfizer*, 3 USPQ2d 1817 (Fed. Cir. 1987). However, where a claim of privilege is invoked, a party must make the claim expressly and provide a description or privilege log, unless the parties otherwise agree.

Lampes, 219 USPQ 448 (TTAB 1979). Thus, applicant is allowed **THIRTY DAYS** from the date of this teleconference to respond to opposer's outstanding first set of interrogatories and first request for production of documents without objection.

Opposer's first request for admissions

Opposer's first request for admissions was also served on June 25, 2009. Once requests for admissions are served, the matters are deemed admitted unless, within thirty days after service of the requests (unless said date is modified by order of the court or stipulation of the parties), the party to whom the requests are directed serves upon the party requesting the admission a written answer or objection addressed to the matter. See Fed. R. Civ. P. 36(a); and TBMP § 524 (2d ed. rev. 2004). No response to the request for admissions has been served.

In view thereof, opposer's first requests for admission are deemed admitted by operation of rule.

Dates are reset

Proceedings are resumed. Dates are reset as set out below.

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| Expert Disclosures Due | 7/25/2010 |
| Discovery Closes | 8/24/2010 |
| Plaintiff's Pretrial Disclosures | 10/8/2010 |
| Plaintiff's 30-day Trial Period Ends | 11/22/2010 |
| Defendant's Pretrial Disclosures | 12/7/2010 |
| Defendant's 30-day Trial Period Ends | 1/21/2011 |
| Plaintiff's Rebuttal Disclosures | 2/5/2011 |
| Plaintiff's 15-day Rebuttal Period Ends | 3/7/2011 |

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.
