

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

Mailed: August 4, 2010

Opposition No. 91192318

JOSE A. COPIN, JR.

v.

TROIKA DOMOVARI GmbH

Cheryl Butler, Attorney, Trademark Trial and Appeal Board:

Applicant seeks to register the marks HEROIKA for "precious metals and their alloys," "paper, cardboard and stationery," and "leather and imitation leather";¹ and TROIKA for:

unfitted vanity cases, key cases, diaper bags, athletic bags for climbers, name card cases, back packs, Boston bags, purses, beach bags, brief cases, suitcases, document cases, namely, ticket cases, card cases, namely, credit card cases and business card cases, traveling bags, traveling trunks, leather binders for travel purposes, leather bags for merchandise packaging, school bags, hand bags, boxes of leather for writing utensils, boxes of vulcanized fiber for writing utensils, bags of leather for packaging, leather leashes for animals.²

As grounds for the opposition, opposer alleges priority of use and likelihood of confusion with his registered TROIKA and design marks. Opposer also alleges that applicant's marks "... will falsely suggest a connection with opposer in violation of

¹ Application Serial No. 77569857, filed on September 15, 2008, claiming a bona fide intent to use the mark in commerce.

² Application Serial No. 77450485, filed on April 17, 2008, claiming a bona fide intent to use the mark in commerce.

Section 2(a) of the Trademark Act..." Opposer asserts ownership of six registrations for the mark



for the following goods:

shaving brushes, compact sold empty, atomizers sold empty, flasks, champagne buckets, napkin rings not of precious metal, cork screws, bottle openers, pepper mills and shoe horns;³

memo pads, letter openers, bookmarks, pens, and paperweights;⁴

money clips, metal locks, metal locks and keys therefor, key fobs, key rings, jewelry boxes, and money boxes; all made of metal;⁵

watches, clocks, cuff-links, cigarette cases and cigarette lighters of precious metal;⁶

pocket knives, nut crackers not of precious metal, manicure sets, non-electric razors, cases, and razor blades;⁷ and

thermometers not for medical use, monoculars, telescopes, eyeglass cases, magnifying glasses and portable traffic beacon lights.⁸

The discovery period was last set to close on June 26, 2010.

This case now comes up on applicant's motion, filed May 5, 2010, to compel more complete responses to its interrogatory Nos. 2-7, 14, and 21. Opposer filed a response thereto.

³ Registration No. 2256787.

⁴ Registration No. 2256788.

⁵ Registration No. 2256789.

⁶ Registration No. 2266575.

⁷ Registration No. 2268514.

Request Nos. 2-7

Applicant asked opposer to 1) state the approximate last date upon which the mark was used in commerce for each identified good or 2) state which specific goods, if any, the mark has never been used on.

Opposer posed objections and further responded by directing applicant to opposer's website and informing applicant that he would produce documents responsive to the interrogatory. In response to applicant's motion, opposer argues that the "date of last use" for any of the goods listed in his registrations is completely irrelevant to the issues presented in this proceeding; and that the validity of his pleaded registrations is not at issue. Opposer states that he produced the file histories of his registrations which included his declarations of continued use of the goods listed in the registrations. Opposer also states that his responses to applicant's requests for admission, denying that he 1) has never sold or used specific items, 2) has not sold or used specific items in commerce in the past three years, and 3) presently does not sell or use specific items in commerce, essentially answers the interrogatories in question.

The mere taking of discovery on matters concerning the validity of a pleaded registration, under any circumstances, is not objectionable on the basis that it constitutes a collateral attack on the registration. See TBMP §414(22) (2nd ed. rev.

⁸ Registration No. 2268515.

2004). A defendant is allowed to seek discovery concerning a pleaded registration to ascertain, for example, whether there are grounds for a compulsory counterclaim. Such discovery also may assist the parties in coming to settlement.

In this case, applicant's query for the "date of last use" appears to seek information which may be relevant to abandonment or nonuse of opposer's marks, and thus potential grounds for a compulsory counterclaim, with respect to specified goods even though the "date of last use" is likely a continuously changing date (as opposed to the date of first use). Whether opposer never has used the mark, as asked with respect to each item named in the request, is also an appropriate inquiry. However, with respect to its admissions requests, apparently for each item listed in opposer's registrations, applicant asked opposer to admit he "has never sold or used in commerce, "has not sold or used in commerce for at least three years," and "presently does not sell or use in commerce" such item bearing the mark. Opposer denied each such admission request.⁹ Thus, applicant effectively has the answer to its interrogatory requests on the topic queried by interrogatory Nos. 2-7 by way of opposer's responses to applicant's requests for admissions. Accordingly, applicant's

⁹ The Board is aware that the opposer's responses to applicant's interrogatories were served before applicant served its admissions requests. Nonetheless, the responses to the admissions requests effectively answer the inquiries posed at interrogatory Nos. 2-7.

motion to compel is **denied** with respect to interrogatory Nos. 2-7.

Request No. 14

This request asks opposer to state, both in units and in dollars, the annual sales for each product bearing the mark for each year in which the mark has been sold. Opposer posed objections and further stated it would produce documents sufficient to show summary sales information for a reasonable and relevant time period.

Applicant argues that opposer has provided "some minor sales sheets" which are "wholly lacking and a minor ... of information." Opposer argues that the information sought is irrelevant to the claims and could only bear on fame, which opposer has not asserted. Opposer argues that he asserted common law rights with respect to goods otherwise classified in Class 18 (the only class which opposer believes may be relevant) and, consequently, has provided applicant with a summary listing sales figures in units of goods by product number, as well as exemplary invoices, for goods that would be classified in Class 18.

Annual sales, stated in round numbers, for a party's involved goods or services sold under its involved mark are proper matters for discovery. If a responding party considers such information to be confidential, disclosure may be made under protective order. See TBMP §414(18) (2nd ed. rev. 2004). Where appropriate, a representative sampling or some other reduced

amount of information may be provided. See TBMP §414(2) (2nd ed. rev. 2004).

Opposer's registrations are involved in this proceeding because opposer has asserted his rights under such registration. Thus, applicant's inquiry concerning annual sales under opposer's mark is within the scope of discovery for this proceeding. However, in view of opposer's asserted long period of use (since 1990), and applicant's more recent constructive use dates (2008), figures from 2005 to present are appropriate.

Accordingly, applicant's motion to compel with respect to interrogatory No. 14 is **granted** as modified.

Interrogatory No. 21

Applicant asks opposer which of the goods listed in the identification of goods for the asserted registration are not presently in use in commerce by opposer. Again, this information is discoverable and is relevant to a potential counterclaim. However, as with interrogatory Nos. 2-7, opposer has, by way of his responses to applicant's requests for admissions, provided the information sought. (That is, opposer denied each request seeking an admission that opposer does not presently sell or use in commerce each item named specifically in each of the pleaded registrations.)

Accordingly, applicant's motion to compel is **denied** with respect to interrogatory No. 21.

The schedule

Proceedings are resumed as described. Opposer is allowed until **THIRTY DAYS** from the mailing date of this order in which to supplement his response to interrogatory No. 14 as indicated above. Operative dates are reset as follows:

The discovery period to resume:	9/7/10
Expert Disclosures Due	9/19/2010
Discovery Closes	10/19/2010
Plaintiff's Pretrial Disclosures	12/3/2010
Plaintiff's 30-day Trial Period Ends	1/17/2011
Defendant's Pretrial Disclosures	2/1/2011
Defendant's 30-day Trial Period Ends	3/18/2011
Plaintiff's Rebuttal Disclosures	4/2/2011
Plaintiff's 15-day Rebuttal Period Ends	5/2/2011

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.

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