

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

Baxley

Mailed: April 13, 2011

Opposition No. 91195442
Cancellation No. 92052985

Watermill Express, LLC

v.

Gwynne 5 Beverage, LLC

Andrew P. Baxley, Interlocutory Attorney:

On April 6, 2011, plaintiff filed a motion to compel discovery and requested that such motion be resolved in an expedited manner by telephone conference. On April 11, 2011, the Board convened a telephone conference between plaintiff's attorney Marc C. Levy, defendant's attorney Arlana S. Cohen, and Board attorney Andrew P. Baxley.

By the motion, plaintiff seeks to compel further responses and/or production of documents responsive to its interrogatory nos. 7-12 and document request nos. 3, 8, 10-15, and 21. Plaintiff contends that, without such documents, it cannot adequately prepare to take a discovery deposition of defendant's principal, which it has noticed for April 14, 2011 in New York, New York.

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Defendant, in response, contends that it is a startup business with minimal documents that are responsive to plaintiff's discovery requests.

The Board finds initially that plaintiff made a good faith effort to resolve the parties' discovery dispute prior to seeking Board intervention. See Trademark Rule 2.120(e)(1). Nonetheless, the Board is disturbed by the overly broad and unduly burdensome nature of the discovery requests at issue. Plaintiff appears merely to have presumed that its discovery requests are appropriate and that it is entitled to all information and documents sought thereby without citing to case law or sections of the Trademark Board Manual of Procedure (TBMP) that support its alleged entitlement.¹ Plaintiff could have avoided many of the issues presented in its motion to compel by reviewing TBMP Section 414 (2d ed. rev. 2004), which provides information concerning the discoverability of various types of information in Board *inter partes* proceedings, and cases cited therein in the preparation of its discovery requests.

Defendant's involved application Serial No. 77765851 was filed based on an assertion of a bona fide intent to use

¹ Plaintiff is reminded that the Board is an administrative tribunal that is empowered to determine whether a party may obtain or maintain a registration. See TBMP Section 102.01 (2d ed. rev. 2004). Plaintiff is further reminded that it has a duty 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 Section 402.01.

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the THE WATERMILLER and design mark in commerce, and its involved Registration No. 3843172 alleges June 10, 2010 as the date of first use anywhere and date of first use in commerce. Accordingly, responsive information and documents regarding use and promotion of that mark may be limited. If responsive documents do not exist, defendant need not create such documents solely to satisfy plaintiff's discovery requests.² See *Washington v. Garrett*, 10 F.3d 1421, 1437-38 (9th Cir. 1993).

Further, to the extent that plaintiff seeks information regarding defendant's goods and services other than the identified goods in the involved application and registration, i.e., "temperature controlled beverage dispensing systems comprised of filtering, processing and storing units, for drinking water, spring water, flavored water, table water, aerated water, mineral water, soda water, carbonated water, non-carbonated water, and soft drinks," those goods and services are not involved in these consolidated proceedings and are irrelevant thereto. See *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975); *Neville Chemical Co. v. Lubrizol Corp.*, 183

² At the same time, defendant is reminded that it has a duty to supplement or correct its earlier discovery responses. See Fed. R. Civ. P. 26(e). Defendant is further reminded that, when a party, without substantial justification, fails to disclose information required, or fails to amend or supplement a prior response, as required, that party may, upon objection by its

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USPQ 184, 190 (TTAB 1974); TBMP Section 414(11).

Accordingly, plaintiff's discovery requests are hereby narrowed to seek discovery only with regard to defendant's involved marks as used on the identified goods. In deciding plaintiff's motion, the Board, in exercising its inherent authority to control the conduct of its proceedings, will review the discovery requests at issue to determine whether the information and documents sought thereby is discoverable in the context of Board *inter partes* proceedings.

By document request no. 3, plaintiff seeks documents regarding "any wording, style, font, design, logo, or other indicia used in connection with respondent's involved marks." Likelihood of confusion in this case will be determined on the basis of defendant's marks as presented in the drawings thereof in defendant's involved application and registration without regard to any additional matter or trade dress used in connection with those marks. See *United Foods Inc. v. J.R. Simplot Co.*, 4 USPQ2d 1172, 1174 (TTAB 1987); TBMP Section 414(11). Accordingly, this request is irrelevant, and defendant need not respond further thereto.

By document request no. 8, plaintiff seeks documents relating to the creation, selection and adoption of defendant's involved marks. Limited information concerning

adversary, be prohibited at trial from using as evidence the information not so disclosed. See Fed. R. Civ. P. 37(c)(1).

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defendant's creation, selection and adoption of its involved marks -- such as the names of knowledgeable employees and persons who suggested use of a mark, the identification of documents concerning adoption of a mark, and search reports -- is discoverable. See *Fisons Ltd. v. Capability Brown Ltd.*, 209 USPQ 167, 170 (TTAB 1980); *Varian Associates v. Fairfield-Noble Corp.*, *supra*; *Goodyear Tire & Rubber Co. v. Tyrco Industries*, 186 USPQ 207, 208 (TTAB 1975); *Volkswagenwerk AG v. MTD Products Inc.*, 181 USPQ 471, 473 (TTAB 1974); TBMP Sections 414(4) and (6). However, respondent need not produce attorney opinions relating to search reports (unless the attorney-client privilege has been waived) and documents relating to the selection of mark which indicate what third parties' marks may have been considered and extent to which respondent believed its mark conflicted therewith. See *Goodyear Tire & Rubber Co. v. Tyrco Industries*, *supra*; *Neville Chemical Co. v. Lubrizol Corp.*, *supra*. Defendant is directed to produce responsive documents consistent with the foregoing. If defendant does not have any such documents in its possession, custody, or control, it should amend its response to state accordingly. See *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000).

By document request nos. 10 and 11, plaintiff seeks documents regarding features and technical details and specifications of goods and services offered under

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defendant's involved marks. To the extent that plaintiff seeks information concerning the specific nature of defendant's identified goods, the Board's determination of likelihood of confusion based upon the parties' goods as they are identified in the application and registrations at issue and is not based on the parties' actual goods. See *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992). The Board must presume that the scope of the goods at issue encompasses all of the goods of the nature and type described, that they travel in all channels of trade normal for those goods, and that they are sold to all classes of prospective purchasers for those goods. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). Accordingly, defendant is directed to provide documents sufficient to explain the general nature of goods contemplated by the identification at issue. If defendant does not have any such documents in its possession, custody, or control, it should amend its response to state accordingly. See *No Fear Inc. v. Rule*, *supra*.

By document request no. 12 and 15 and interrogatory nos. 7(b) and 10, plaintiff seeks documents showing monthly and annual advertising expenditures and monthly and annual unit and dollar sales and for the identified goods sold under the involved marks. These document requests and interrogatories are overly broad and unduly burdensome.

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Defendant need only provide annual sales and advertising figures in round numbers for the identified goods sold under the involved marks and may provide those figures under protective order. See *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147, 149 (TTAB 1985); TBMP Section 414(18). Defendant is directed to produce documents and serve amended interrogatory responses in accordance with the foregoing. If defendant does not have any such documents in its possession, custody, or control, it should amend its response to state accordingly. See *No Fear Inc. v. Rule*, *supra*.

By document request no. 14, plaintiff seeks all documents relating to communications between defendant and third parties regarding advertising and promoting the involved marks in connection with defendant's goods and services. This request is unduly burdensome. Defendant need only provide documents sufficient to identify any advertising agency that defendant engaged by advertise and promote defendant's identified goods sold under its involved mark and the identity of the advertising agency employees having the most knowledge of such advertising and promotion. See *J.B. Williams Co. v. Pepsodent GmbH*, 188 USPQ 577, 579-80 (TTAB 1975); TBMP Section 414(17). Defendant is therefore directed to produce documents consistent with the foregoing. If defendant does not have any such documents in

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its possession, custody, or control, it should amend its response to state accordingly. See *No Fear Inc. v. Rule*, *supra*.

By interrogatory no. 11, plaintiff seeks information regarding the nature and type of all advertising and promotional efforts that defendant has undertaken in connection with the sales of goods and services under the involved marks. By interrogatory no. 12, plaintiff seeks information regarding every advertisement for the identified goods sold under the involved marks. Such information goes to the trade channels of the goods at issue and is therefore discoverable. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Defendant is directed to respond by identifying in general terms the advertising and promotional efforts that defendant has undertaken in connection with the sales of the identified goods under the involved marks³ and providing the requested information regarding a representative sample of advertisements for the identified goods sold under the involved marks. See TBMP Section 402.02.

By document request no. 13, plaintiff seeks prices lists for defendant's involved goods sold under the involved marks. Price lists go to the sales conditions of the goods

³ In so responding, defendant need not identify any customers. See *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988); TBMP Section 414(3).

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at issue and are therefore discoverable. See *In re E. I. du Pont de Nemours & Co.*, *supra*. Defendant is directed to provide price lists for the identified goods sold under its involved marks. If defendant does not have any such price lists in its possession, custody, or control, it should amend its response to state accordingly. See *No Fear Inc. v. Rule*, *supra*.

By interrogatory no. 7(a), (c), and (d), plaintiff seeks information regarding periods of use of defendant's involved marks and the states in which defendant has sold, and to which it has shipped, the identified goods under the involved marks. Such information is discoverable. See *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193, 195-96 (TTAB 1976); *J.B. Williams Co. v. Pepsodent GmbH*, *supra*; TBMP Sections 414(5) and (16). Defendant is directed to serve an amended response or to produce documents which provide responsive information.

By document request no. 21 and interrogatory nos. 8 and 9, plaintiff seeks the identity of locations where defendant's identified goods have been installed and all distributors, resellers and persons who have sold or offered products sold under defendant's involved marks. These discovery requests seek the identity of customers, the names of which are not discoverable, even under protective order. See *Johnston Pump/General Valve Inc. v. Chromalloy American*

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Corp., 10 USPQ2d 1671, 1675 (TTAB 1988); TBMP Section 414(3). Defendant need not respond further thereto.

In view thereof, the motion to compel is granted with regard to document request nos. 8 and 10-15 and interrogatory nos. 7(a)-(d) and 10-12, to the extent modified by this order, but is denied with regard to interrogatory nos. 8-9 and document request nos. 3 and 21. Defendant is allowed until thirty days from the mailing date set forth in this order to serve amended responses to interrogatory nos. 7(a)-(d) and 10-12 or, in the alternative, to select, designate and identify the items and documents, or categories of items and documents, to be produced in response thereto and to notify plaintiff that the selection, designation and identification of such items and documents has been completed. Defendant is also allowed until thirty days from the mailing date set forth in this order to serve amended responses to document request nos. 8 and 10-15 and to select, designate and identify the items and documents, or categories of items and documents, to be produced in response thereto and to notify plaintiff that the selection, designation and identification of such items and documents has been completed. Plaintiff is allowed until thirty days from receipt of notification from defendant that the items or documents have been selected, designated and identified to inspect and copy the produced

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materials, as provided for in Fed. R. Civ. P. 34(b) and Trademark Rule 2.120(d)(2), unless the parties otherwise agree.⁴

Defendant is reminded that it has a duty to supplement or correct its earlier responses to discovery requests. See Fed. R. Civ. P. 26(e). Defendant is reminded in addition that, if it fails to provide information that is properly sought during discovery, defendant may be precluded, by way of plaintiff's objection, from relying upon that information as evidence at trial. See Fed. R. Civ. P. 37(c).

Under the circumstances, the Board deems it appropriate to extend the discovery period for plaintiff to allow plaintiff time in which to take a discovery deposition of defendant's principal after defendant has complied with this order. See TBMP Section 403.04. Accordingly, remaining dates herein are reset as follows.

Defendant's Expert Disclosures Due	4/16/11
Discovery Period Closes for Defendant	5/16/11
Plaintiff's Expert Disclosures Due	6/16/11
Discovery Period Closes for Plaintiff	7/16/11
Plaintiff's Pretrial Disclosures	8/30/11
Plaintiff's 30-day Trial Period Ends	10/14/11
Defendant's Pretrial Disclosures	10/29/11
Defendant's 30-day Trial Period Ends	12/13/11
Plaintiff's Rebuttal Disclosures	12/28/11
Plaintiff's 15-day Rebuttal Period Ends	1/27/12

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served

⁴ If defendant fails to comply with this order, plaintiff's remedy lies in a motion for sanctions, pursuant to Trademark Rule

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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.

If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.

2.120(g)(1). See TBMP Section 527.01(a).