

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

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Mailed: October 1, 2013

Opposition Nos. 91197504 (parent)
91197505

Omega SA (Omega AG) (Omega Ltd.)

v.

Alpha Phi Omega

Yong Oh (Richard) Kim, Interlocutory Attorney:

This matter comes up on applicant's motion (filed June 11, 2013) to compel opposer's supplemental responses to applicant's interrogatories and requests for production and to test the sufficiency of opposer's responses to applicant's requests for admission. The motion is fully briefed.

Discovery was due to close on June 19, 2013, as reset. As applicant's motion was filed on June 11, 2013, it is timely. See Trademark Rules 2.120(e)(1) and (h)(1).

A motion to compel and a motion to test the sufficiency of a response must be supported by a written statement from the movant that such party, or its attorney, has made a good faith effort, by conference or correspondence, to resolve with the other party, or its attorney, the issues presented in its motion, and has been unable to reach agreement. See

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Trademark Rules 2.120(e)(1) and (h)(1) and TBMP §§ 523.02 and 524.02 (2013). Applicant is obviously aware of the good faith requirement as applicant has certified, as part of its motion, that it made a good faith attempt to resolve the discovery disputes that form the basis of its motion via correspondence to opposer's counsel dated May 24, 2013, describing the alleged deficiencies in opposer's discovery responses. A copy of the correspondence was provided by applicant as part of its motion. Applicant further certifies that this motion was filed upon receiving no response to its correspondence from opposer.

In reviewing applicant's correspondence and the circumstances surrounding it, it is apparent that a good faith effort to resolve the issues in applicant's motion was not made. The good faith requirement of Trademark Rule 2.120 requires applicant, as the moving party, to make an effort to obtain the discovery responses it seeks by engaging in meaningful discussions prior to filing a motion to compel. This requirement is not discharged by a unilateral correspondence, no matter how detailed, sent to the non-moving party demanding further responses. While such a letter may serve as a good framework and overture for future meaningful discussions, it is insufficient to demonstrate a good faith effort to actually resolve the

matter as it is, standing alone, nothing more than a demand for further responses.

Of course, if the non-moving party refuses to engage in good faith discussions to resolve the moving party's discovery concerns despite the moving party's best efforts to engage, the Board will consider the good faith requirement discharged. However, such is not the case here. Applicant's claim in its motion that "Opposer has elected to ignore the letter describing the deficiencies" in order to justify the filing of its motion is nothing more than conjecture. *Applicant's Motion*, p. 8. Indeed, applicant has failed to specify what efforts it made to follow up on its May 24, 2013, correspondence upon receiving no response from opposer and there is nothing in the record to indicate that any effort was made.

Finally, that applicant failed to engage in a meaningful discussion of the discovery issues that are the subject of its motion is evident in the nature and number of discovery requests/responses at issue. *See Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984). The parties are reminded that they have a duty not only to make a good faith effort to satisfy the discovery needs of the other but also 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 Luehrmann v. Kwik*

Kopy Corp., 2 USPQ2d 1303, 1305 (TTAB 1987). Board intervention should only be sought in relation to those discovery disputes that the parties have been unable to resolve **despite their best efforts to do so**. If such good faith efforts were put forward, then there is no reason why applicant should present to the Board such a large number of requests for resolution.

Accordingly, the Board finds that applicant has failed to discharge the good faith requirement of Trademark Rules 2.120(e)(1) and (h)(1) and hereby **DENIES without prejudice** applicant's motion to compel. Both counsels are hereby ordered to confer¹ regarding the discovery requests that remain in dispute within **THIRTY DAYS** of the mailing date of this order. If the parties remain unable to resolve their discovery dispute, a second (and more narrow) motion to compel and/or to test the sufficiency of responses may be filed. Any future failure to cooperate or to otherwise act in good faith in the discovery process by either party will be looked upon by the Board with extreme disfavor.

The parties are reminded that if proper discoverable matter is withheld from the requesting party, the responding party may be precluded from relying on such matter and from adducing testimony with regard thereto during its testimony

¹ Any future motion to compel will not be considered without an oral conference between the parties discussing each and every discovery request and/or response/production in dispute.

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period. See *Presto Products Inc. v. Nice-Pak Products Inc.*,
9 USPQ2d 1895, 1896 n.5 (TTAB 1988).

Dates are **RESET** as follows:

Discovery Closes	11/29/2013
Plaintiff's Pretrial Disclosures Due	1/13/2014
Plaintiff's 30-day Trial Period Ends	2/27/2014
Defendant's Pretrial Disclosures Due	3/14/2014
Defendant's 30-day Trial Period Ends	4/28/2014
Plaintiff's Rebuttal Disclosures Due	5/13/2014
Plaintiff's 15-day Rebuttal Period Ends	6/12/2014

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 taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 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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