

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

Mailed: September 26, 2011

Opposition No. 91197754

WOLF-PETER GRAESER

v.

LAVATEC, INC.

Cheryl Butler, Attorney, Trademark Trial and Appeal Board:

In accordance with the Board's order of March 7, 2011, granting opposer's consented scheduling motion of the same day, the discovery period was last set to close on October 14, 2011. This case now comes up on 1) applicant's fully briefed motion, filed August 2, 2011, to compel discovery responses to its first and second set of interrogatories and first set of production requests, and to deem admitted applicant's first request for admission; 2) opposer's fully briefed motion, also filed August 2, 2011, for entry of a protective order and to compel more complete initial disclosures; and 3) opposer's notification, filed August 23, 2011, that it served responses to applicant's discovery requests on August 19, 2011. Proceedings were suspended on August 8, 2011 pending disposition of each party's discovery motion.

In support of its motion, applicant indicates that it served its discovery requests on June 17 and 22, 2011; that, on July 14,

2011, opposer requested an extension of time until August 19, 2011; that applicant agreed on condition "that the false and disparaging statements made by Opposer be stopped"; that opposer's attorney, after speaking with opposer, denied that anything was improper; that, on July 25, 2011, applicant contacted opposer's attorney reminding her that the responses were overdue; that the parties communicated further and applicant agreed to an extension only until July 29, 2011; and that, on July 29, 2011, opposer served his discovery requests, but not responses to applicant's discovery requests. Applicant also states that, during the parties' discovery conference, it requested a copy of the sale agreement upon which opposer bases his claim to the U.S. trademark; that opposer's attorneys stated the document was in their possession; and that such document was not produced with initial disclosures or any time thereafter.

In response, opposer explains that the extension was sought because of the large volume of documents that were being gathered by opposer, because the documents are located overseas; and because opposer needed to analyze an archive of documents dating to 1986; and of which he is not familiar, because opposer recently acquired the business. Opposer's attorney explains that she responded to the concerns raised by applicant's "condition" to the extension request and believed the matter was resolved. Specifically, counsel explained that opposer is the registered owner of the mark in Europe; that any positions or statements

made by opposer are believed by him to be true; and that this opposition proceeding will not be concluded until some time in the future. Opposer's attorney argues that there was no disparagement and further points out that the condition was based on unsubstantiated allegations, the disparaging nature of which would be subjective; and that opposer had previously objected to applicant's disparagement of opposer and affiliates. However, even if the matter of the extension was not resolved by the explanation, opposer argues that the "condition" was unreasonable because the extension was requested to allow opposer's counsel time to review the voluminous materials that opposer was gathering, and not for any improper purpose. As to the sale agreement, opposer's counsel explains that she was waiting for a partial English translation that was not received until after applicant served its discovery requests and that she planned to produce the document with all other responses.

Opposer also cross moves for entry of a protective order that applicant was not entitled to serve discovery requests because it has not served adequate initial disclosures. Specifically, opposer argues that applicant's initial disclosure does not comply with the requirements because it is "limited to extremely generic categories of documents" and does not provide the location where the documents and things are kept.

In response to opposer's cross motion for entry of a protective order, applicant argues that its initial disclosure

complies with the requirements and points out that it identified eight specific categories of documents and things that may be used in support of its claims. Applicant explains it inadvertently omitted the address at which the documents and things were located and now provides the address. Applicant argues that the first time opposer brought this matter up was in its cross motion for entry of a protective order. In reply to its motion to compel, applicant emphasizes that it did not consent to an extension past July 29, 2011 for opposer to serve discovery responses.

Opposer informed the Board that, on August 19, 2011, it served responses to the applicant's discovery requests.

It is clear that the parties' acrimony has affected the orderly administration of this proceeding. In order to get this case back on track, the following determinations are made.

Opposer's motion to compel complying initial disclosures from applicant is denied in part and is moot in part. That is, applicant's description by category of its document and things is adequate and opposer's motion to compel is denied with respect to requiring more specificity; and applicant now has provided the location for the documents and things identified, making opposer's motion moot as to such item. Opposer's motion for entry of a protective order that discovery responses not be required until applicant supplements its initial disclosures is denied.

It was clear that confusion arose over the disputed extension request, the due date for the discovery responses, and the time necessary for opposer to fulfill his discovery responsibilities. In view of opposer's explanation of what was involved, including translations, extensive review of more than twenty years of records, opposer's unfamiliarity with the records, and the need for opposer's counsel to review the documents transmitted, the Board grants opposer an extension of the requested time, until August 19, 2011, to serve responses. Accordingly, the responses served by opposer on August 19, 2011 are considered timely.

In view of opposer's notification that it served discovery responses, applicant's motion to compel is deemed moot. Applicant's request that its first request for admissions be deemed admitted is denied as opposer's response to such requests are now considered timely.

Proceedings are resumed. Each party has until **THIRTY DAYS** from the due date of this order to respond to any outstanding discovery requests of its adversary.¹ Dates are reset as follows:

Expert Disclosures Due	11/2/2011
Discovery Closes	12/1/2011
Plaintiff's Pretrial Disclosures	1/15/2012
Plaintiff's 30-day Trial Period Ends	2/29/2012
Defendant's Pretrial Disclosures	3/15/2012
Defendant's 30-day Trial Period Ends	4/29/2012
Plaintiff's Rebuttal Disclosures	5/14/2012
Plaintiff's 15-day Rebuttal Period Ends	6/13/2012

¹ This is simply a scheduling order, not an order compelling discovery.

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.
