

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

RK

Mailed: June 5, 2012

Opposition No. 91199529

Hunter Boot Limited

v.

Georgia Pellegrini Media
Group, LLC

Yong Oh (Richard) Kim, Interlocutory Attorney:

On June 4, 2012, the Board held a telephone conference to hear argument and rule on opposer's motion (filed April 20, 2012) to compel discovery. Tali Alban, Esq., of Kilpatrick Townsend and Stockton LLC, appeared as counsel for opposer and Robert Kleinman, Esq., of Kleinman Law Firm PLLC, appeared as counsel for applicant.

As a preliminary matter, applicant's counsel was advised to review Trademark Rule 2.119 and TBMP § 113 (3d ed. 2011) concerning the requirements of a proper certificate of service as applicant's certificates of service, thus far, have not provided the required information.

The Board then inquired as to the status of initial disclosures. Counsel for each party confirmed that initial disclosures were mutually served.

Turning, then, to the motion at hand, opposer's motion to compel relates to numerous interrogatories and document requests propounded by opposer on December 5, 2011.¹ After an extension granted by opposer, applicant timely responded to said discovery requests on February 3, 2012. On March 12, 2012, opposer, via email and first class mail, conveyed to applicant the numerous deficiencies it perceived in applicant's responses and demanded supplemental responses to its discovery requests no later than March 23, 2012. On March 22, 2012, applicant indicated via email that supplemental responses would be forthcoming but that it would need an additional ten days from the date of its email. On March 23, 2012, opposer responded by email agreeing to the extension and confirming its understanding that supplemental responses would be provided by April 2, 2012.

On April 4, 2012, applicant sent its supplemental responses to opposer via certified mail which opposer received on April 10, 2012. After reviewing said responses, opposer filed its motion to compel on April 20, 2012.

Decision

Pursuant to Trademark Rule 2.120(e), the party seeking to compel discovery must demonstrate and certify that it made a good faith effort to resolve the issues raised in its motion to

¹ The portion of opposer's motion seeking to toll opposer's discovery obligations pending the Board's disposition of its motion to

compel. This requirement was made explicit by the Board during the discovery conference held on June 27, 2011, and memorialized in the Board's order of June 28, 2011, wherein the parties were put on notice that a motion to compel would not be entertained and good faith would not be found where the parties have failed to previously conduct at least one telephone conference to resolve the discovery in dispute.

During the conference, the Board asked the parties to recap the sequence of events that led to this motion to compel. Aside from the initial correspondence from opposer outlining the deficiencies it perceived in applicant's initial responses to opposer's discovery requests, the correspondence that followed between the parties' respective counsels merely concerned the timing of applicant's supplemental responses. Further, after applicant served its supplemental responses on April 4, 2012, which opposer's counsel received on April 10, 2012, opposer's counsel failed to follow up with applicant's counsel in any manner to resolve any remaining requests opposer believed to be in issue and simply filed a motion to compel. Indeed, from the sheer number of interrogatories and document requests that are at issue in opposer's motion, it is apparent that a good faith effort to resolve, let alone discuss, the outstanding discovery issues was not made by opposer prior to filing a motion to compel. *Cf. Medtronic, Inc. v. Pacesetter*

compel and applicant's compliance with applicant's discovery obligations

Systems, Inc., 222 USPQ 80, 83 (TTAB 1984) (number and nature of discovery requests demonstrates that no good faith effort had been made).

As the Board does not find that opposer made a good faith effort to resolve the issues that are the subject of its motion to compel, the motion is hereby **DENIED without prejudice**.

It is noted that opposer's responses to applicant's discovery requests are due on June 8, 2012. For the sake of efficiency, and as discussed during the hearing, each party is ordered to mutually serve in writing their respective objections, if any, to the other party's discovery responses no later than **June 22, 2012**, and to meet and confer regarding said discovery deficiencies no later than **June 29, 2012**. It is recommended that counsels review the selected discovery guidelines and supporting case law outlined in TBMP § 414 (3d ed. 2011) so as to facilitate the parties' upcoming conference.

The parties are reminded that they are obligated to cooperate in discovery in good faith and to exchange appropriate discovery materials. The parties are further reminded that if proper discoverable matter is withheld from the requesting party, the responding party will be precluded from relying on such matter and from adducing testimony with regard thereto during its testimony period. *See Presto*

was previously denied as part of the Board's order of May 15, 2012.

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

If the parties remain unable to resolve their discovery dispute, a presumably more narrow motion to compel may be filed.² Dates are **RESET** as follows:

Expert Disclosures Due	8/15/2012
Discovery Closes	9/14/2012
Plaintiff's Pretrial Disclosures Due	10/29/2012
Plaintiff's 30-day Trial Period Ends	12/13/2012
Defendant's Pretrial Disclosures Due	12/28/2012
Defendant's 30-day Trial Period Ends	2/11/2013
Plaintiff's Rebuttal Disclosures Due	2/26/2013
Plaintiff's 15-day Rebuttal Period Ends	3/28/2013

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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² Any future motion to compel will not be considered without demonstrative evidence of the steps taken to resolve the dispute.