

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

EJW

Mailed: January 13, 2014

Opposition No. 91200327

James Murta

v.

Victor Suarez

**ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:**

This case now comes up for consideration of opposer's fully briefed motion (filed October 7, 2013) to compel complete responses to its requests for production of documents served on June 18, 2013, and on August 1, 2013.<sup>1</sup>

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<sup>1</sup> In the final paragraph of opposer's motion, opposer requests that applicant be ordered to comply completely with opposer's discovery requests provided in Exhibits G and K (see ¶36). Inasmuch as those exhibits are comprised of opposer's requests for production of documents served on June 18, 2013 and on August 1, 2013, the Board construes opposer's motion as seeking relief solely with regard to the requests for production of documents contained therein.

For the same reason, although it appears that opposer may be concerned with "documents and information alluded to but not produced in [applicant's] initial disclosures" (motion at 1), the sufficiency of applicant's initial disclosures *per se* is not addressed herein. Nonetheless, to the extent that applicant may not have identified known potential witnesses in his initial disclosures, applicant is reminded that unless seasonably remedied, a party's failure to identify a witness in its initial disclosures deprives the adverse party of the opportunity to seek discovery of the identified witness, and this fact "must [be] consider[ed] ... as one of the relevant circumstances ... in determining whether to strike [the witness's] testimony deposition." *Jules Jurgensen/Rhapsody, Inc. v. Baumberger*, 91 USPQ2d 1443, 1444-45 (TTAB 2009), cited in *Sheetz of Delaware, Inc.*

For purposes of this order, the Board presumes the parties' familiarity with the subject motion and the parties' arguments and materials submitted in connection therewith.

As an initial matter, it is noted that opposer sent two emails to applicant's counsel (on July 26, 2013, and on September 16, 2013) and telephoned applicant's counsel on September 9, 2013, in order to resolve the impasse between the parties with respect to their discovery dispute. In view thereof, the Board finds that opposer made the appropriate good faith effort to resolve this dispute with applicant prior to the filing of the instant motion. See Trademark Rule 2.127(e)(1).

Turning to the motion to compel, the Board notes that the remaining claims in this proceeding are non-use and fraud regarding applicant's use of the mark and the geographic source of the goods (see Board's order dated April 19, 2013). In that context, the Board issues the following determinations on the motion to compel with respect to opposer's two requests for production of documents:

**I. Requests for Production of Documents (served June 18, 2013)**

- (1) **Request no. 1:** *"All documents relating to the adoption, use and registration of the DOSF Mark by*

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*v. Doctors Associates Inc.*, 108 USPQ2d 1341 (TTAB 2013). Furthermore, applicant is also reminded that Section 120.02 of the TBMP applies to *submissions* to the Board, which could be public record, and not to documents served on the adverse party.

*Applicant as identified in the Applicant's Initial Disclosures of May 20, 2013."*

**Denied.** The request is over broad and unduly burdensome. Although information concerning a party's selection and adoption of its involved mark is discoverable (see TBMP § 414(4) (3d ed. rev. 2 2013)), and information concerning a party's first use of its involved mark is discoverable (see *id.* at § 414(5)), the specific type of information or materials sought by opposer, e.g., trademark search reports, is unstated and is thus unclear. Furthermore, applicant stated in his response that he has produced all documents in his possession, custody, or control relating to the adoption, use, and registration of the applied-for mark in response to opposer's first request for production of documents (served December 9, 2011). This response is sufficient. Where documents responsive to a request for production do not exist, the responding party is not obligated to create them. See *Washington v. Garrett*, 10 F.3d 1421, 1437-38 (9th Cir. 1993).

(2) **Request no. 2:** *"All documents relating to Opposer's knowledge of the adoption and use of the [applied-for] Mark by Applicant as identified in the Applicant's Initial Disclosures of May 20, 2013."*

**Denied.** The request is over broad and unduly burdensome. It is also unclear why opposer would seek information from applicant regarding *opposer's* knowledge of the use of the involved mark even though applicant refers to same in its May 20, 2013 disclosures. In any event, applicant states that he has produced all documents in his possession, custody, or control relating to applicant's adoption, use, and registration of the involved mark, and has no further documents to produce. This response is sufficient.

II. **Requests for Production of Documents (served August 1, 2013)**

- (1) ***Request No. 1:*** "Please produce all documents identified in any if [sic] the Defendant's answers to the Interrogatories dated 08.01.2013 and served concurrently herewith."

**Denied.** Insofar as applicant did not identify any documents responsive to opposer's interrogatories, there are no documents responsive to this request.<sup>2</sup>

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<sup>2</sup> Although opposer did not ask specifically for relief with respect to the interrogatories referenced in request for production no. 1, for completeness and to avoid any further motions to compel, the Board observes that opposer has inappropriately requested customer information in interrogatory no. 2, that interrogatory nos. 1 and 3 are overly broad and unduly burdensome, and that the information requested in interrogatory nos. 4 and 6 is not relevant to opposer's claims remaining in this proceeding. With respect to interrogatory no. 5, applicant has essentially responded to that query at pp. 13-14 of its response to the instant motion. However, opposer is entitled to have such information from applicant in compliance with Fed. R. Civ. P. 33(b). In that regard, applicant is reminded that he is obligated to supplement his responses to opposer's discovery requests as necessary. See TBMP § 408.03, discussed *infra*.

(2) **Requests Nos. 2 through 7** request that applicant produce "all documents including but not limited to invoices, purchase orders, proposals, quotes, photographs, email conversations, written communications, recorded verbal communications and advertising and marketing materials," with respect to the following:

(a) **Request No. 2:** "relating to the use in commerce of the Mark for the four years prior to the filing date of the subject application in association with each specific good recited in the application."

**Granted in part.** Inasmuch as opposer claims that applicant was not using his mark in connection with any of the identified goods on the application filing date, applicant's objection that such documents are irrelevant to opposer's claims is overruled. However, the request is over broad to the extent that it unnecessarily requests an overly broad range of documents and information for four years preceding the filing date of the application. Accordingly, opposer's motion is granted to the extent that applicant is ORDERED to produce to opposer sufficient documents showing use of the applied-for mark in connection with each of the goods recited in the application as of the filing date of the

application. However, insofar as applicant stated with respect to Request Nos. 3 that he had "produced all documents in his possession, custody, or control relating to the use of the [applied-for] Mark by Applicant at the time of filing the subject application, and Applicant has no further documents to produce at this time," applicant may, alternatively, respond to request no. 2 by stating that he has no other documents to produce in support of his use anywhere of the applied-for mark in connection with the identified goods.

- (b) **Request No. 3:** *"relating to the continued use in commerce of the Mark since the filing date of the subject application in association with each specific good recited in the application."*

**Denied.** Evidence related to applicant's use of the mark after the filing date of the instant application is not relevant to opposer's claims.

- (c) **Request No. 4:** *"relating to the use of the Mark in interstate commerce for the four years prior to the filing date in association with each specific good recited in the application."* For the reasons discussed *supra*, para. II.(2)(a),

applicant's objection that such documents are irrelevant to opposer's claims is overruled. Accordingly, applicant is ORDERED to produce to opposer sufficient documents showing use in interstate commerce of the applied-for mark in connection with each of the goods recited in the application. However, insofar as applicant stated with respect to Request No. 5 that he had "produced all documents in his possession, custody, or control relating to the use of the [applied-for] Mark in interstate commerce by Applicant at the time of filing the subject applicant, and Applicant has no further documents to produce at this time," applicant may, alternatively, respond to request no. 4 by stating that he has no other documents to produce in support of his use in commerce of the applied-for mark in connection with the identified goods.

- (d) **Request No. 5:** *"relating to the use of the Mark in interstate commerce since the filing date of the subject application in association with each specific good recited in the application."*

**Denied.** See *supra* para. II(2)(b).

- (e) **Request No. 6:** *"relating to the supplier(s) and manufacturer(s) Defendant used dating from four years before the filing date until the filing date, that are located in San Francisco, for each specific good recited in the application sold under the Mark."*

**Granted in part.** Insofar as opposer's fraud claim is based on the alleged material misrepresentation that applicant's goods were made in the San Francisco area (amended notice of opp., ¶41), the location of the manufacturers and suppliers of applicant's goods is relevant to that claim. *Cf. Caymus Vineyards v. Caymus Medical Inc.*, 107 USPQ2d 1519, 1523 (TTAB 2013) (finding a sufficiently pleaded fraud claim based on allegation of incomplete information provided to examining attorney). Additionally, information regarding applicant's manufacturers and suppliers may lead to discoverable information relevant to whether applicant used its mark prior to the filing date of the instant application. Therefore, applicant's objection that such documents are irrelevant to opposer's claims is overruled. Accordingly, applicant is

ORDERED to provide to opposer sufficient documentation showing the names and addresses of his suppliers and manufacturers of the identified goods (which are located in the San Francisco area) used by applicant prior to the filing date of the application.

- (f) **Request No. 7:** *"relating to the supplier(s) and manufacturer(s) Defendant has been using since the filing date, which are located in San Francisco, for each specific good recited in the application sold under the Mark."* **Granted in part.** For the reasons discussed in II(2)(e), applicant's objection that such documents are irrelevant to opposer's claims is overruled. Accordingly, applicant is ORDERED to provide to applicant sufficient documentation showing the names and addresses of his suppliers and manufacturers (of the identified goods) which are located in the San Francisco area and were used by applicant since the filing date of the application until August 6, 2010 (the date

applicant filed its response to the March 16, 2010 Office Action<sup>3</sup>).

However, with respect to the Board's orders in sections II(2)(e) and (f), in view of the concerns voiced by applicant in connection with safeguarding the privacy of its potential witnesses,<sup>4</sup> **opposer is reminded that information on applicant's manufacturers and suppliers is protected by the Board's standard protective agreement, which governs this proceeding by operation of Trademark Rule 2.116(g). See Amazon Technologies, Inc. v. Wax, 93 USPQ2d 1702, 1706 n.6 (TTAB 2009). Therefore, such information, which applicant believes to be "trade secret/commercially sensitive," is viewable only by opposer's counsel.**

In view of the foregoing, applicant is allowed until **THIRTY (30) DAYS** from the mailing date of this order to serve copies (at applicant's expense) of non-privileged documents and

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<sup>3</sup> In the March 16, 2010, the examining attorney required applicant to provide information as to whether his goods are manufactured, packaged, shipped from, sold in, or have any other connection with the geographic location named in the mark.

<sup>4</sup> It is noted that opposer did not file a reply denying applicant's allegations regarding opposer's behavior toward applicant's customers.

materials<sup>5</sup> responsive to these production requests as ordered herein by serving them upon opposer at his correspondence address of record.

Additionally, as to any requests for production of documents to which applicant has not responded based on an allegation of privilege, **applicant is allowed until THIRTY DAYS from the mailing date of this order to serve on opposer at the address of opposer's counsel a "privilege log"**, which must include the following information: the specific privilege that assertedly applies to the particular discovery request, the basis for the objection to response or production, and a description of the privileged document(s). Fed. R. Civ. P. 26(b) (5) (A) (ii).

**Duties to Cooperate and to Supplement**

Applicant is reminded of his duty to make a good faith effort to satisfy the discovery needs of opposer and of his *continuing duty* to thoroughly search his records for all information properly sought in discovery, and to provide such information to the requesting party or to correct the response to include information thereafter acquired or uncovered. See TBMP §§ 402.01, 408.01, 408.02 and 408.03 (3d ed. rev. 2 2013).

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<sup>5</sup> Applicant is not required to produce privileged documents or to provide privileged information, as its right to claim privilege has not been waived. See, e.g., *American Standard, Inc. v. Pfizer*, 3 USPQ2d 1817 (Fed. Cir. 1987).

Applicant is also reminded that, if a party provides an incomplete response to a discovery request, that party, upon a timely raised objection by an adverse party, may not thereafter rely at trial on information from its records which was properly sought in the discovery request, but which was not included in the response thereto, unless the response is supplemented in a timely fashion pursuant to Fed. R. Civ. P. 26(e). *See Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718 (TTAB 1987); and TBMP § 408.02 (3d ed. rev. 2 2013). Additionally, should a party be later found to have willfully withheld discovery responses, introduction of such evidence withheld may be precluded upon a motion to strike.

The parties should resolve any future discovery disputes promptly and allow the case to go forward to trial without further Board intervention. *Non-cooperation by either party, resulting in further delay, will be viewed with extreme disfavor by the Board.*

**Summary; Proceeding Resumed; Trial Dates Reset**

Opposer's motion to compel is **granted in part**, to the extent discussed herein. Applicant is allowed until **THIRTY DAYS** from the mailing date of this order to serve on opposer's counsel responsive documents and materials to opposer's requests for production as set forth hereinabove.

In the event applicant fails to respond to opposer's discovery requests as ordered herein, opposer's remedy lies in a motion for sanctions pursuant to Trademark Rule 2.120(g)(1), 37 C.F.R. § 2.120(g)(1).

This proceeding is resumed. Trial dates are reset as shown in the following schedule.

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| Discovery Closes                        | 1/20/2014 |
| Plaintiff's Pretrial Disclosures Due    | 3/6/2014  |
| Plaintiff's 30-day Trial Period Ends    | 4/20/2014 |
| Defendant's Pretrial Disclosures Due    | 5/5/2014  |
| Defendant's 30-day Trial Period Ends    | 6/19/2014 |
| Plaintiff's Rebuttal Disclosures Due    | 7/4/2014  |
| Plaintiff's 15-day Rebuttal Period Ends | 8/3/2014  |

**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 the taking of testimony. See Trademark Rule 2.125, 37 C.F.R. § 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b), 37 C.F.R. §§ 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129, 37 C.F.R. § 2.129.

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