

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

Mailed: February 3, 2014

Opposition No. 91204897  
(**Parent Case**)  
Opposition No. 91204941

John G. Marino

v.

Laguna Lakes Community  
Association, Inc.

**George C. Pologeorgis,  
Interlocutory Attorney:**

These consolidated proceedings now come before the Board for consideration of (1) opposer's motion (filed October 11, 2013) to compel the discovery deposition of applicant's counsel, Donna Flammang or, alternatively, a 30(b)(6) witness knowledgeable of certain topics identified in opposer's 30(b)(6) deposition notice, and (2) opposer's motions (filed on August 26, 2013 and October 11, 2013) to extend the close of discovery. Applicant filed timely responses to all of opposer's motions.

**Opposer's Motion to Compel**

In support of its motion, opposer maintains that opposer conducted a 30(b)(6) discovery deposition of applicant's corporate representative, Mr. Patrick Tardiff, on August 26, 2013. Opposer further maintains that applicant's 30(b)(6)

witness did not have knowledge regarding certain topics identified in opposer's 30(b)(6) discovery deposition notice. Specifically, opposer contends that applicant's 30(b)(6) witness did have knowledge regarding (1) the dates of first use of applicant's involved marks, (2) the information contained in applicant's involved applications, and (3) information regarding any transfers and/or assignments of the subject marks by Transeastern Homes or any TOUSA entity to applicant.

In view of the foregoing, opposer requests that the Board compel applicant to produce applicant's counsel, Donna Flammang, as a witness on the ground that Ms. Flammang is most knowledgeable of the subject matters identified in opposer's 30(b)(6) deposition notice. Alternatively, opposer requests that the Board compel applicant to produce another 30(b)(6) witness with knowledge regarding the three topics identified above.

In response, applicant argues that its 30(b)(6) witness provided complete, knowledgeable responses concerning all of the noticed categories in the 30(b)(6) deposition notice following a good faith, conscientious preparation. Further, applicant maintains that opposer is not entitled to choose a substitute 30(b)(6) witness to the extent the Board finds that applicant's original 30(b)(6) witness did not have sufficient knowledge regarding the subject matter identified by opposer.

An organization served with a Fed. R. Civ. P. 30(b)(6) notice of deposition has an obligation not only to pick and produce persons that have knowledge of

the subject matter identified in the notice, see *Kellogg Co. v. New Generation Foods Inc.*, 6 USPQ2d 2045, 2049 n.5 (TTAB 1988), but also to prepare those persons so that they can give complete, knowledgeable, and binding answers as to matters known or reasonably available to the organization. *A&E Products Group L.P. v. Mainetti USA Inc.*, 70 USPQ2d 1080, 1086 (S.D.N.Y. 2004) (and cases cited therein). The organization may either produce as many deponents as are necessary to respond to the areas of inquiry in the notice if there is no witness with personal knowledge of all areas of inquiry *International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1605 (TTAB 2002), or alternatively, may produce a witness who reviews the organization's records to become familiar with the topics for the deposition so that he or she may give knowledgeable and binding answers for the organization. *Id.* If more than one Fed. R. Civ. P. 30(b)(6) witness will be designated, those individuals should be identified and the areas on which each person will testify be described. Fed. R. Civ. P. 30(b)(6). Even if no current employees have knowledge of matters identified in the notice, an organization is not relieved of preparing a Fed. R. Civ. P. 30(b)(6) designee for deposition to the extent that such matters are reasonably available to the organization from past documents, past employees or other sources. *United Technologies Motor Systems Inc. v. Borg-Warner Automotive Inc.*, 50 USPQ2d 1060, 1062 (E.D. Mich. 1998).

If it becomes obvious during the course of a Fed. R. Civ. P. 30(b)(6) deposition that the organization's designee is deficient regarding his or her

knowledge of matters reasonably known to the organization, the organization is obliged to provide a substitute and to prepare a designee to provide testimony in areas as to which its other representatives were uninformed. *Id.*

Following a careful review of the deposition transcript of applicant's 30(b)(6) witness, the Board finds, as explained more fully below, that applicant's 30(b)(6) witness was deficient regarding his knowledge of (1) applicant's dates of first use of its involved marks, and (2) any transfers/assignments of the subject marks by Transeastern Homes or any TOUSA entity to applicant. The Board finds, however, that applicant's 30(b)(6) witness had sufficient knowledge regarding the contents of applicant's involved applications for the reasons stated below.

#### Dates of First Use

When questioned whether applicant was using its involved logo at the time the articles of incorporation for applicant were filed, i.e., September 2003, applicant's 30(b)(6) witness responded that he was not sure if applicant was using the mark at such time. *See Tardiff Tr. at 87:1-14.* When questioned whether it was true that the first time applicant actually used its logo was in 2006, applicant's 30(b)(6) witness responded that he couldn't say one way or another if that was the first time or not. *Id. at 88:5-18.* Notwithstanding the foregoing, when applicant's 30(b)(6) witness was questioned at another point during the deposition regarding when the first time applicant used its applied-for mark, applicant's 30(b)(6) witness testified that it was September 2003. *Id.*

85:3-5. This inconsistency in testimony demonstrates that applicant's 30(b)(6) witness did not have sufficient knowledge regarding applicant's first use of its involved marks.

Transfer of Involved Marks from Transeastern to Applicant

When questioned whether applicant's 30(b)(6) witness was aware of any documentation which demonstrates a transfer or assignment of rights to the subject marks from the Transeastern entity to applicant, applicant's 30(b)(6) witness responded, "I'm not sure of that, no. I don't know." *Id.* at 83:13-19. Applicant's 30(b)(6) witness also testified that he had no knowledge whether Transamerican ever had any proprietary interests in the subject marks. *Id.* at 86:13-18.

Contents of the Involved Applications

With regard to the contents of applicant's involved applications, the Board notes that applicant's 30(b)(6) witness testified regarding the dates of first use in the application, *id.* at 110:2-13, as well as a website listed in one of the involved applications. *Id.* at p. 115:24-116:2; 123:21-125:5. Additionally, applicant's 30(b)(6) witness testified that he reviewed the application before it was filed with the USPTO. *Id.* at 122:8-12. Moreover, the Board notes that it would appear that applicant's 30(b)(6) would have been able to testify further as to the contents of the application had he been given an opportunity to do so. Instead of continuing with questions regarding the contents of applicant's involved applications, opposer's counsel began asking about "who would have the most

knowledge as to what was put in the applications and why. *Id.* at p. 121:15-18.

If opposer needed additional testimony regarding the contents of applicant's involved applications, opposer's counsel should have continued his questioning of applicant's 30(b)(6) witness about the contents of the applications instead of inquiring who would be most knowledgeable about the contents.

In view of the forgoing, opposer has established that applicant's 30(b)(6) witness failed to provide knowledgeable responses regarding (1) the dates of first use of applicant's involved marks, and (2) any transfers/assignments of the subject marks by Transeastern Homes or any TOUSA entity to applicant.

Accordingly, opposer's motion to compel is **GRANTED** solely to the extent that applicant must produce another 30(b)(6) witness who has sufficient knowledge regarding (1) applicant's first use of its subject marks, and (2) information regarding any transfers/assignments of the subject marks by Transeastern Homes or any TOUSA entity to applicant, by the deadline set forth below.

**Opposer's Motions To Extend The Close Of Discovery**

In support of his motions to extend, opposer contends that, because he has not obtained full and complete responses to discovery he served upon applicant on April 2013 and because applicant's 30(b)(6) witness was deficient in his knowledge regarding certain topics identified on the notice of deposition, opposer requires an extension of the close of the discovery period.

Inasmuch as the Board has granted opposer's motion to compel to the limited extent noted above, opposer's motions to extend are **GRANTED**

solely to the extent the close of discovery is extended until **March 5, 2014** for opposer only for the sole purpose of taking and completing the deposition of another 30(b)(6) witness of applicant limited to the two topics identified above. Discovery is otherwise closed.<sup>1</sup>

As a final matter, opposer also requests that the Board enter an estoppel sanction against applicant under Fed. R. Civ. P. 37(c)(1). Specifically, opposer requests that, because opposer has still not received complete discovery from applicant, applicant should be precluded from introducing any witness testimony during its assigned testimony regarding applicant's dates of first use of its involved marks, information regarding the contents of applicant's applications, and any information regarding any assignment(s) of the involved marks by applicant's predecessor-in-interest to applicant.

Imposition of an estoppel sanction is not automatic, and may be "unduly harsh" in circumstances where there has been no "unequivocal[] refus[al] to provide the requested information." *Vignette Corp. v. Marino*, 77 USPQ2d 1408, 1412 (TTAB 2005) (declining to apply sanction). Based on the record of this case,

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<sup>1</sup> To the extent opposer seeks to extend the close of discovery on the ground that it has yet to receive complete responses to its outstanding written discovery requests, the request is **denied** since it is unnecessary to extend the close of discovery on such ground inasmuch as the mere close of discovery does not preclude either party from subsequently serving responses to interrogatories, documents requests, or requests for admission. See TBMP § 403.03 (3d ed. rev. 2 2013). Notwithstanding the foregoing, both parties are allowed until **fifteen (15) days** from the mailing date of this order in which to respond to any outstanding written discovery. This allotment of time does not constitute an order to compel discovery responses but merely serves as a scheduling order.

the Board finds that opposer has failed to demonstrate that applicant has unequivocally declined to (1) respond to any of opposer's written discovery,<sup>2</sup> or (2) cooperate with regard to discovery depositions. Accordingly, opposer's request for the application of the estoppel sanction is **DENIED**.

### **Trial Schedule**

These consolidated proceedings are resumed. Discovery is **closed**, except to the extent indicated herein. Remaining trial dates for this consolidated case are reset as follows

Plaintiff's Pretrial Disclosures Due	<b>4/15/2014</b>
Plaintiff's 30-day Trial Period Ends	<b>5/30/2014</b>
Defendant's Pretrial Disclosures Due	<b>6/14/2014</b>
Defendant's 30-day Trial Period Ends	<b>7/29/2014</b>
Plaintiff's Rebuttal Disclosures Due	<b>8/13/2014</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>9/12/2014</b>

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 Trademarks 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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<sup>2</sup> The Board notes that applicant, in its response to opposer's motion to compel entertained herein, stated that it provided supplemental responses to opposer's discovery requests on September 10, 2013 and that since that time opposer has not complained that applicant's responses to date are not complete.