

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Baxley

Mailed: November 14, 2014

Opposition No. 91205896

Beau L. Tardy

v.

Wild Brain Entertainment, Inc.

Andrew P. Baxley, Interlocutory Attorney:

This case now comes up for consideration of Applicant's motion (filed July 11, 2014) to compel discovery. The motion has been fully briefed.

Applicant served thirteen interrogatories (including subparts) and forty-two document requests and now seeks further responses to all of those interrogatories and requests for production. Inasmuch as all of Opposer's responses to Applicant's interrogatories and document requests are in dispute, the Board finds that Applicant failed to make a substantive effort to resolve by agreement the issues raised in its motion to compel. *See* Trademark Rule 2.120. At least some of the problems herein should be resolved without Board intervention, and the Board suggests greater effort to avoid or resolve such controversies. The parties are directed to meet and confer to discuss Applicant's discovery requests after having reviewed TBMP § 414 (2014), which sets forth guidelines regarding the discoverability of various types of information in Board proceedings.

Applicant is reminded that the purpose of discovery is to advance the case so that it may proceed in an orderly manner within reasonable time constraints. To this end, Applicant must adhere to the strictures set forth in *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986), and repeated below:

[E]ach party and its attorney has a duty not only to make a good faith effort to satisfy the discovery needs of its opponent 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 case. Moreover, where the parties disagree as to the propriety of certain requests for discovery, they are under an obligation to get together and attempt in good faith to resolve their differences and to present to the Board for resolution only those remaining requests for discovery, if any, upon which they have been unable, despite their best efforts, to reach an agreement. Inasmuch as the Board has neither the time nor the personnel to handle motions to compel involving substantial numbers of requests for discovery which require tedious examination, it is generally the policy of the Board to intervene in disputes concerning discovery, by determining motions to compel, only where it is clear that the parties have in fact followed the aforesaid process and have narrowed the amount of disputed requests for discovery, if any, down to a reasonable number.

In view of the substantial number of discovery requests at issue, it is evident to the Board that the parties have failed to make a genuine, good faith effort to resolve by agreement the issues raised herein. Accordingly, Applicant's motion to compel is denied without prejudice.

To assist the parties in resolving their discovery dispute, the Board notes the following. Opposer's refusal to participate in the parties' meet and confer conference without participation by Board personnel is not well-taken. Although Opposer correctly notes that the Board, in its November 6, 2013

discovery conference report, stated that “[a]ny party filing an unconsented motion to extend or suspend should notify the Board by telephone upon the filing thereof so that such motion can be resolved promptly by telephone conference,” that statement clearly applies only to unconsented motions to extend or suspend and has no bearing upon motions to compel. The Board has neither the time nor the personnel to participate in meet and confer conferences to resolve parties’ discovery disputes as a matter of course and generally only participates in such conferences when it has previously advised the parties that it will not permit any further filing of motions to compel unless the filing party obtains leave of the Board in a telephone conference prior to such filing.

In the fourth amended notice of opposition, the operative complaint herein, Opposer alleges standing based on his being “a competitor of Applicant.” Opposer further alleges that “DIZZY is the brand name owned by [Opposer] as an individual and as several business entities and has been a company name, merchandise, pop culture websites, cartoon character, TV show, comics, and web streaming entertainment;” that “Dizzy went from being the name of a business that provided production services, to a brand on its own;” and that “[b]oth parties produce cartoon characters for entertainment purposes and use these characters to advertise collateral goods and entertainment services.” Opposer relies in addition on his pending

trademark application Serial No. 85741800 for the mark DIZZY for goods in International Class 9.

Applicant included a copy of the USPTO file for that application as an exhibit to its motion. In that application, Opposer alleges use of the DIZZY mark anywhere and in commerce since December 31, 1996. However, dates of use set forth in an application are not evidence of use; dates of use must be established by competent evidence. *See* Trademark Rule 2.122(b)(2). Further, in the “DBA/AKA” section of that application, Opposer states “FORMERLY Dizzy Productions, Dizzy Worldwide Corp., Dizzy TV, [and] Aquarium Creative Agency.” This statement does not clearly indicate whether the recited names are names under which Opposer formerly did business or was known as or whether the recited names identify predecessors-in-interest of Opposer’s pleaded DIZZY mark.

In the motion to compel, Applicant seeks to compel further responses to discovery requests through which it seeks information regarding Opposer’s standing to maintain this proceeding. Opposer’s assertion in response that “Applicant’s admission in its initial Answer of visiting Opposer’s URL Dizzythecat.com and finding DIZZY cartoons that were created in 2006 should be enough to establish Opposer’s interest beyond that of the general public” is not well taken. Use of the mark in 2006 does not preclude subsequent abandonment of that mark.¹ *See* Trademark Act Section 45, 15

¹ Standing is an issue of fact to be determined at trial. *See Am. Vitamin Products Inc. v. DowBrands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992).

U.S.C. § 1127. Further, Applicant's answer to the original notice of opposition is no longer the operative responsive pleading herein, having been superseded by Applicant's answer to the fourth amended notice of opposition that Applicant filed on May 28, 2014.² *See* TBMP § 507.02 (2014).

Likewise, Applicant's original notice of opposition is no longer the operative complaint herein, having been superseded by the fourth amended notice of opposition. *See* TBMP § 507.02. Although Opposer referred to Registration Nos. 2339835 and 2339836 in the original notice of opposition,³ Opposer does not mention those registrations in the fourth amended notice of opposition.

Further, Opposer's allegation that its pleaded application was refused registration based on likelihood of confusion with the mark in Applicant's involved application does not preclude Applicant from challenging Opposer's assertions in that application regarding use of the DIZZY mark, names under which Opposer formerly did business or was known, and any predecessors-in-interest of the pleaded DIZZY mark, particularly when that pleaded application was not pending until after this proceeding was commenced. *Cf. Salacuse v. Ginger Spirits Inc.*, 44 USPQ2d 1415 (TTAB 1997) (Respondent entitled to take discovery regarding the nature of Petitioner's alleged bona fide intent to use pleaded mark). Opposer's pleaded application was filed on

² Applicant filed two answers to the fourth amended notice of opposition on May 28, 2014. Those answers appear to differ only in the date set forth in the signature blocks thereof.

³ USPTO records indicates that both registrations have been cancelled.

September 28, 2012, nearly three months after the July 3, 2012 commencement of this proceeding. Opposer must establish that he had standing at the commencement of this proceeding which has continued throughout its pendency. *See Arizonans for Official English v. Arizona*, 520 U.S. 43, 68 n.22 (1997). Because Opposer bears the ultimate burden of proof on the standing issue and relies in part on the filing of his application as a basis for alleging his ongoing standing herein, Opposer may be required to establish his entitlement to file that application. *See Salacuse, supra*.

In response to the vast majority of Applicant's interrogatories, Opposer set forth essentially identical objections that each request is "neither relevant to the claims or defense of any party or the subject matter involved in this opposition, nor reasonably calculated to lead to the discovery of admissible evidence." Such responses indicate a failure to participate in good faith in the discovery process in this case. *See* TBMP § 408.01. Opposer brought this case and, in doing so, should have expected that he would be required to respond to discovery requests and produce documents to support the allegations upon which relies to plead standing and claims herein.

At the same time, a review of Applicant's discovery requests indicates that at least some of them are clearly excessive. In particular, Applicant seeks discovery dating back to 1996 in connection with Opposer's pleading of standing, notwithstanding that it did not file its involved intent-to-use application until January 5, 2012. Applicant is reminded that it has a duty

only to seek such discovery as is proper and relevant to the issues in this case. *See id.*

The following is merely intended as providing a few examples of such excessiveness. The parties should not infer that discovery requests not expressly mentioned in this order seek properly discoverable information or that such discovery requests seek information that is not discoverable in Board proceedings.

In interrogatory no. 4, Applicant asks Opposer to identify every outlet where goods and services sold under DIZZY mark were sold or offered for sale in the United States. This interrogatory essentially asks Opposer to identify its customers, the names of which are generally not discoverable, even under a protective order. *See Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147, 149 (TTAB 1985) (need for customer names does not outweigh possible harm, such as harassment of customers); TBMP § 414(3).

In interrogatory nos. 6 and 8, Applicant asks Opposer for quarterly sales and advertising/promotional figures for each good or service sold under the DIZZY mark in the United States and to identify all documents relating thereto. Opposer need only provide annual figures in round numbers for each year since 2009 and may so provide under the Board's standard protective order, which is operative herein. *See Trademark Rule 2.116(g); Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975); *J. B. Williams Co. v. Pepsodent GmbH*, 188 USPQ 577, 579 (TTAB 1975) (relevant

to issue of abandonment); *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689, 690 (TTAB 1975) (allowed to provide figures for each of last five years and a statement that there have been sales for the other years); TBMP § 414(18).

In interrogatory no. 7, Applicant seeks information regarding each city and state for each year for each good or service that Opposer distributed, sold, or offered for sale goods under his pleaded DIZZY mark. Opposer need only identify the states in which he has distributed, sold, or offered for sale goods or services under the pleaded mark for each year since 2009. *See Miller & Fink Corp. v. Servicemaster Hospital Corp.*, 184 USPQ 495, 495 (TTAB 1975) (year by year, state by state break down of numbers of magazines distributed is proper); TBMP § 414(16).

In responding to Applicant's document requests, Opposer may comply by producing a representative sample of responsive documents where responsive documents are voluminous. *See* TBMP § 402.02. If responsive documents do not exist, Opposer is not obligated to create such documents solely to satisfy Applicant's discovery requests. *See Washington v. Garrett*, 10 F.3d 1421, 1437-38 (9th Cir. 1993). At the same time, Opposer has a duty to correct or supplement his discovery responses as needed. *See* Fed. R. Civ. P. 26(e). Further, if Opposer fails to disclose properly discoverable information and documents, he may be precluded from relying upon such information and documents as evidence at trial. *See* Fed. R. Civ. P. 37(c)(1).

Proceedings herein are resumed. Remaining dates are reset as follows.

Expert Disclosures Due	12/1/2014
Discovery Closes	12/31/2014
Plaintiff's Pretrial Disclosures Due	2/14/2015
Plaintiff's 30-day Trial Period Ends	3/31/2015
Defendant's Pretrial Disclosures Due	4/15/2015
Defendant's 30-day Trial Period Ends	5/30/2015
Plaintiff's Rebuttal Disclosures Due	6/14/2015
Plaintiff's 15-day Rebuttal Period Ends	7/14/2015

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. If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.