

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

Mailed: October 2, 2013

Opposition No. 91206026

Victualic Company

v.

Shurjoint Piping Products,  
Inc.

**Cheryl S. Goodman, Interlocutory Attorney:**

This case now comes up on the following motions:

- 1) Opposer's motion, filed July 8, 2013, for protective order.<sup>1</sup>

The motion is fully briefed.

With regard to its good faith effort to resolve the dispute as to applicant's third set of requests for admissions, opposer states that it sent an e-mail to applicant to request a telephone conference on June 27, 2013, with regard to the requests for admissions and counsel responded by e-mail. The parties "attempted to reach a compromise on the requests, one could not be met."

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<sup>1</sup> Although the Board stated in its order of March 11, 2013, that all other discovery disputes would be heard by telephone conference, the motion for protective relief was fully briefed. In such a case, the Board will consider the matter on the briefs. See TBMP Section 502.03 (3d ed. rev. 2013) (oral hearing on fully briefed motion generally not held).

The Board finds that opposer made a good faith effort to resolve the dispute.

The Board now turns to the merits of the motion.

In support of the motion, opposer argues that for each of these third-party marks identified in the requests, applicant seeks an admission that opposer "did not file an extension of time to oppose these federal registrations; did not file an opposition to the application of these marks; did not telephone these registrants in connection with the use of these marks; did not write any correspondence to these registrants in connection with the use of these marks; did not file a petition to cancel their marks; did not file a lawsuit against the registrants of these marks; and did not file a lawsuit regarding use of these marks." Opposer argues that none of these requests are relevant to the question of "whether a likelihood of confusion exists between Victaulic's Mark and the mark for which Shurjoint seeks registration" and "there is no doubt that the Third Requests were propounded for no other purpose than to harass Victaulic."

In response, applicant argues "that the requests for admissions are highly relevant" and relate to 'JOINT' and 'SNAP' formative marks for identical and/or highly related goods that co-exist in the marketplace and on the register,

and against which Victaulic has taken no action.”

Applicant submits that the strength of the mark is “the single most important factor in this likelihood of confusion analysis . . . . Victaulic’s inaction as to that diluted marketplace, bears directly on the strength of the mark asserted in this proceeding.”

In reply, opposer argues that even if there is a “modicum of relevancy for some third party registrations,” this information is available through USPTO records. Opposer further submits that “many of the trademarks for which Shurjoint seeks admissions are not even arguably related products even though in the same class of goods.” Opposer references Registrations nos. 2792527, 4307353, 3601922, 1803055, 4207995, 1930930, 1497401, 3229162, 1372116, 1360400, and 4036461, identified in the requests for admissions, as examples of unrelated goods. Opposer submits that even if some third party registrations are relevant, applicant’s “utter disregard for the similarity of the products, similarity of the industries and similarity of channels of trade in crafting its requests demonstrates” that the admissions were for purpose of harassment.

A party may move for a protective order “to protect a party or person from annoyance, embarrassment, oppression,

or undue burden or expense . . . . " Rule 26(c)(1). The party requesting the protective order carries the burden of demonstrating good cause; the moving party can satisfy that burden by showing some plainly adequate reason for the order.

To establish good cause, a movant must provide "a particular and specific demonstration of fact, as distinguished from stereotyped and conclusory statements." *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1761 (TTAB 1999). A party opposing a discovery request cannot make conclusory allegations that a request is irrelevant, immaterial, unduly burdensome, or overly broad. Instead, the party resisting discovery must show specifically how each discovery request is irrelevant, immaterial, unduly burdensome or overly broad. *Gheesling v. Chater*, 162 F.R.D. 649, 650 (D.Kan. 1995). Thus, an objecting party cannot sustain its burden with boilerplate claims that the requested discovery is for example, oppressive, burdensome or harassing. *Klesch & Co. Ltd. v. Liberty Media Corp.*, 217 F.R.D. 517 (D. Colo. 2003). If a motion includes only conclusory statements seeking a protective order with regard to discovery requests or requests for admissions, then written objections to the discovery requests must be plain and specific to show a basis in fact for protective

relief.<sup>2</sup> *White v. Wirtz*, 402 F.2d 145 (10<sup>th</sup> Cir. 1968). In this case, no objections have been made to the requests, because opposer filed a motion for protective relief in lieu of responding to the requests.

Rule 36 is not a discovery tool in the truest sense, but rather, is a procedure for obtaining admissions for the record of facts already known. 8 C. Wright & A. Miller, *Federal Practice and Procedure: 3d Civil Section* 2253 (2013, Westlaw). Neither the Federal Rules of Civil Procedure, nor the Trademark Rules set a presumptive limit on the number of requests for admission that may be propounded by a party.

Although opposer identified the categories of questions posed by the admissions, opposer's arguments in its initial brief are general, and not specific, as opposer has not made reference to any specific requests for admissions with regard to its arguments regarding relevance or harassment. Similarly, in the reply brief, opposer identified third party registrations which it argued were

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<sup>2</sup> Opposer did not serve objections to these requests, but filed a motion for protective relief on the due date for responses to be served, if first class mail is the parties' primary method of service. The failure to respond to discovery requests may be excused if the party failing to act has a pending motion for protective order. Fed.R.Civ.P. 37(d)(2). In order not to waive one's objections, a motion for a protective order "must be served before the date set for production." *United States v. Int'l Bus. Mach. Corp.*, 70 F.R.D. 700, 701 (S.D.N.Y. 1976).

"not even arguably related" but failed to associate these registrations with any specific requests, also indicating there are many more unrelated third party registrations identified in the requests.<sup>3</sup> Opposer has conceded that the requests may have a "modicum of relevancy."

Presumably, the Board was supposed to review all of 525 requests, identify the listed registrations and look up their goods, and decide whether each request was relevant or not, without any specific argument from opposer other than that the requests were not relevant and were harassing.

However, it is not in the Board's province to sua sponte review all of the individual requests generally referenced in opposer's brief to determine whether each one is in fact objectionable. Simply stated, opposer has not

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<sup>3</sup> The Board notes that newly raised arguments in a reply brief are deemed waived since they were not asserted in the initial brief on the motion. *Acker v. Burlington Northern & Santa Fe Ry. Co.*, 388 F.Supp.2d 1299, 1302 (D.Kan.2005) (citing *Minshall v. McGraw Hill Broad. Co.*, 323 F.3d 1273, 1288 (10th Cir.2003) (argument raised for the first time in reply brief is waived). The relevance of a failure of a trademark owner to enforce its rights against third parties goes to strength. Thomas McCarthy, *Trademarks and Unfair Competition*, § 17:17 (4<sup>th</sup> ed. 2013 Westlaw). However, third-party uses unrelated to opposer's goods, are irrelevant. *In re Melville Corp.*, 18 USPQ2d 1386, 1388-89 (TTAB 1991) ["Registrations for goods unrelated to the clothing field are irrelevant to our discussion"]; *SBS Products Inc. v. Sterling Plastic & Rubber Products Inc.*, 8 USPQ2d 1147, 1149 n.6 (TTAB 1988) ["E]ven if evidence of such third-party use were submitted, it would be of no aid to respondent herein where the third-party usage was for goods unrelated to either petitioner's skin care products or respondent's stuffing box sealant"].

met its substantive burden in seeking protective relief for the requests for admissions at issue. *See Gheesling v. Chater*, 162 F.R.D. at 650 (citations omitted). ("The Court will not assume to make Defendants' arguments for them, nor will the Court on its own review all of the [remaining 424] requests to see which ones might possibly be objectionable"). Nor have opposers convinced the Board that applicant is abusing the use of requests for admissions simply because of the number of requests that were served. There is no argument in the record, for example, that the admissions are frivolous, vexatious, or argumentative such that they are unreasonably harassing to opposer.

In view thereof, the motion for protective relief is denied.

Opposer is allowed until THIRTY DAYS from the mailing date of this order to respond to the third set of requests for admissions.

Dates remain as last reset. See September 30, 2013 Board order.