

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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General Contact Number: 571-272-8500

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Opposition Nos. **91207333 (parent)**
91207598

RxD Media, LLC

v.

IP Application Development LLC

Yong Oh (Richard) Kim, Interlocutory Attorney:

This consolidated matter comes up on Opposer's motion to compel discovery (filed March 20, 2015¹) and Applicant's cross-motion for a protective order (filed April 16, 2015).

The Board presumes the parties' familiarity with the pleadings, the history of the proceedings and the arguments and evidence submitted with the motions. Furthermore, due to the redactions in the parties' filings, this order will not summarize the proceeding background or recount the parties' arguments except as necessary.

Decision

As an initial matter, the motion to compel is timely as it was filed prior to the commencement of Opposer's testimony period. See Trademark Rule 2.120(e)(1).

¹ Only a confidential copy of the motion was filed with the Board. A redacted copy was subsequently filed on April 6, 2015, by order of the Board.

As part of any motion to compel, the moving party must certify that it made a good faith effort to resolve with the other party the issues presented in the motion but was unable to resolve them. *Id.* In view of the parties' correspondences relating to the discovery in dispute as well as the telephone conference of February 25, 2015, between the parties, the Board finds Opposer's good faith requirement discharged.

Before turning to the discovery in dispute, the parties are reminded of their duty to not only make a good faith effort to satisfy the discovery needs of their adversary but also to make a good faith effort to seek only such discovery as is proper and relevant to the particular issues involved in the proceeding, including any matter reasonably calculated to serve as the basis for an additional claim, defense or counterclaim. *See* Fed R. Civ. P. 26(g); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1305 (TTAB 1987); *Neville Chem. Co. v. Lubrizol Corp.*, 183 USPQ 184, 187 (TTAB 1974) ("applicant is entitled to take discovery not only as to the matters specifically raised in the pleadings but also as to any matters which might serve as the basis for an affirmative defense or for a counterclaim"). In seeking discovery, the parties are expected to take into account the principles of proportionality such that the volume and scope of the requests do not render them harassing or oppressive. *See Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1268 (TTAB 2015).

Deposition of Douglas Vetter

Opposer seeks to compel the deposition of Douglas Vetter “solely because he appeared to be one of only four persons with knowledge that has been disclosed in any manner in Applicant’s discovery responses.” *Opposer’s Reply*, 46 TTABVUE 3. Opposer served its notice of deposition on January 20, 2015. *See Motion to Compel*, 39 TTABVUE 36. However, Apple, Inc. (“Apple”), is not a party to these proceedings. As such, Mr. Vetter, who is the Vice President, Associate General Counsel, and Assistant Secretary of Apple, *see Declaration of Douglas Vetter*, 42 TTABVUE 109 ¶ 1, is a non-party deponent whose attendance, unless willing, must be secured by subpoena pursuant to 35 U.S.C. § 24 and Fed. R. Civ. P. 45. *See, e.g., Ate My Heart v. GA GA Jeans*, 111 USPQ2d 1564, 1565 n.5 (TTAB 2014) (notice of deposition of unwilling non-party witness must include subpoena). Although Opposer contends that Applicant “has agreed to treat Apple ... as a party for purposes of these proceedings,” *Motion to Compel*, 39 TTABVUE 2, n.1, that notion has been objected to by Applicant, *see Applicant’s Opposition*, 42 TTABVUE 7, n.2, and does not operate to join Apple as a party-defendant in these proceedings.

As the Board has no jurisdiction over depositions of third parties by subpoena, *see Luehrmann*, 2 USPQ2d at 1304 n.3, Opposer’s motion to compel the deposition of Mr. Vetter is hereby **DENIED**. In view thereof, Applicant’s motion for a protective order is **MOOT**.

Interrogatory No. 21

Identify any and all advertising or marketing agencies, including in the identification the name of the employee(s) of such agencies having the most relevant knowledge, engaged by you to advertise, promote, or market services offered under the IPAD Mark.

The Board has recognized that the identity of any advertising agency engaged by a party to advertise and promote the party's involved goods or services under its involved mark is a proper area of inquiry, as is the identity of employees most knowledgeable of such advertising and promotion. *See J. B. Williams Co. v. Pepsodent GmbH*, 188 USPQ 577, 579 (TTAB 1975) (may lead to relevant information concerning circumstances surrounding selection of mark and its distinctiveness or lack thereof). That the interrogatory seeks the identity of "any and all" advertising or marketing agencies does not automatically make the request "overly broad and unduly burdensome" and Applicant has made no showing to the contrary.

Additionally, Applicant's assertion that "evidence relating to distinctiveness or secondary meaning of [Applicant's] mark is wholly irrelevant" because Opposer "has not challenged the distinctiveness" of Applicant's mark is an overly restrictive view of the scope of discovery. As noted *supra*, a party may take discovery on any matter reasonably calculated to serve as the basis for an additional claim, defense, or counterclaim. Since Applicant's involved marks were published for opposition pursuant to a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, it can hardly be said that the question of distinctiveness is "wholly irrelevant."

In view thereof, Opposer's motion to compel further responses to its Interrogatory No. 21 is hereby **GRANTED**.

Interrogatory No. 27

Identify and explain any decision by you to reject any alternative marks considered by you for use in connection with the services described in Applicant's Applications, including in the explanation the identity of the alternative marks that were considered, all persons involved in selecting and rejecting the alternative marks, and the bases for rejection of the alternative marks.

While a party is entitled to take discovery concerning its opponent's selection and adoption of an involved mark, *see Varian Assocs. v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975), Opposer's inquiry is overbroad and not appropriately tailored to elicit discoverable information, particularly as it relates to Opposer's contention that "there is evidence that Applicant may have acted inequitably in adopting the IPAD mark, which is directly relevant to the issue of likelihood of confusion and the affirmative equitable defenses expressly pled by Applicant." *Motion to Compel*, 39 TTABVUE 15. That is not to say that there is no discoverable information to be had in Opposer's request as Applicant's consideration and rejection of alternative marks that incorporate the term IPAD may very well be relevant to issues in these proceedings. As such, Opposer's motion to compel further responses to this interrogatory is **GRANTED in part** to the extent that the interrogatory is limited to those alternative marks that contain the term IPAD.

Interrogatory No. 28 & Document Request No. 41

28. Identify all officers, directors and managing agents of IP Application Development, LLC from the time the Trinidad & Tobago Application was filed through to the present.

41. Produce documents sufficient to identify all officers, directors, members, and managing agents of IP Application Development.

In response to these discovery requests, Applicant identified Thomas La Perle as Manager of Applicant and as the person most knowledgeable concerning the involved marks. *Declaration of Thomas La Perle*, 42 TTABVUE 113-114, ¶¶ 1 and 7. Although Applicant argues that its identification of Mr. La Perle should be held sufficient, the identities of a party's officers or management are discoverable and Applicant has made no showing of "a large number of officers" or that "many of these individuals are not involved in the selection, adoption, and day-to-day use of the mark" so as to justify limiting its response to a single individual. *See J. B. Williams Co.*, 188 USPQ at 580. Notwithstanding the inapplicability of certain titles, e.g., officers, directors, to a limited liability company, Opposer's motion to compel further responses to Interrogatory No. 28 and Document Request No. 41 is hereby **GRANTED** to the extent that Applicant is directed to supplement its response and production with the identities of any additional managing members who are knowledgeable concerning the selection, adoption and use of the IPAD mark.

Document Request Nos. 21-23

21. Produce all consumer or market studies or surveys that you possess or are aware of, that evidence the connotations that the IPAD Mark produces in the minds of Apple, Inc.'s consumers.

22. Produce any consumer or market studies or surveys that you have conducted, reviewed, or relied on regarding the selection of services to be offered under the IPAD Mark.

23. Produce all consumer or market studies or surveys that you have ever relied on, or used, in your efforts to market and sell the iPad.

The Board finds these requests acceptable. Consumer and market survey evidence is relevant to inquiries concerning likelihood of confusion and secondary meaning. *See, e.g., Nextel Commc'ns, Inc. v. Motorola, Inc.*, 91 USPQ2d 1393 (TTAB 2009) (surveys as evidence of acquired distinctiveness); *Helene Curtis Indus., Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989) (use of survey in likelihood of confusion determination). Although Applicant objects that the distinctiveness of its mark is not at issue in these proceedings and that the requests are overbroad as they encompass "goods and services other than those described in the challenged applications and relat[e] to uses outside of the United States," the question of distinctiveness is relevant as the marks in the involved applications were approved for publication pursuant to a claim of acquired distinctiveness under Section 2(f). Additionally, as the subject applications are both intent-to-use applications, Applicant's claim of acquired distinctiveness necessarily relies on use of the mark with goods and services outside of the services in the subject applications. *See In re Rogers*, 53 USPQ2d 1741, 1744 (TTAB 1999) (outlining

requirements for establishing acquired distinctiveness of a mark in an intent-to-use application).

In view thereof, Opposer's motion to compel further responses to Document Request Nos. 21, 22 and 23 is hereby **GRANTED**. However, to the extent the requests encompass studies and surveys that relate to uses outside of the United States, they are not relevant and need not be produced.

The Board adds that a proper response to a document request "requires *either* stating that there are responsive documents and they will be produced or withheld on a claim [of] privilege or stating that [the party] has no responsive documents." *See No Fear, Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000) (emphasis in original). In view thereof, equivocal responses, like those provided by Applicant wherein it states that "it is not aware" of responsive documents but "reserves its right to supplement or amend the foregoing response later in these proceedings," are improper as they raise the question of whether Applicant actually searched for responsive documents prior to responding to the requests. *Id.* at 1555.

Document Request Nos. 30-32

30. Produce all documents and correspondence evidencing your knowledge of the use of the IPAD Mark by any third party, regardless of the type of goods and/or services offered under the IPAD Mark, at the time of the filing of the Trinidad & Tobago Application.

31. Produce all documents, search reports or investigation reports, conducted by you or on your behalf prior to the filing of Trinidad & Tobago Application regarding the use of the IPAD Mark by others.

32. Produce all documents and correspondence relating to any evaluation or assessment of the IPAD Mark as owned or used by others including, but not limited to, your valuation of any such IPAD Mark.

Information concerning a party's awareness of third-party use and/or registration of the same or similar mark for goods or services that are the same or closely related to those of the involved mark is discoverable to the extent that the responding party has actual knowledge thereof. *See Am. Soc'y of Oral Surgeons v. Am. Coll. of Oral & Maxillofacial Surgeons*, 201 USPQ 531, 533 (TTAB 1979). However, a party need not investigate third-party use in order to respond to discovery requests. *See Sheetz of Delaware, Inc. v. Doctor's Assocs. Inc.*, 108 USPQ2d 1341, 1348 (TTAB 2013).

Although Applicant's responses to Document Request Nos. 30 and 31 are noted, they remain equivocal and do not constitute proper responses in accordance with the Board's guidelines in *No Fear*. **Applicant is therefore directed to supplement and otherwise update its responses to Document Request Nos. 30 and 31 as noted *supra*.**

As for the information requested via Document Request No. 32, the Board sees little relevance of valuation information to these proceedings. However, documents and correspondence pertaining to Applicant's evaluation or assessment of third-party use or ownership of the subject mark is relevant and **Applicant is directed to supplement and otherwise update its response to Document Request No. 32.**

Document Request No. 35

35. Produce all testimony by the Applicant regarding the acquisition of rights in the IPAD mark, including the testimony offered in or regarding the dispute between the Applicant and Shenzhen Proview Technology.

Information concerning litigation and controversies with third parties, including settlement and other contractual agreements, based on the involved mark is discoverable. *See Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 172 (TTAB 1975). However, with respect to legal proceedings, the responding party “need merely identify the legal proceedings by naming the parties involved, listing the jurisdiction and proceeding number, and stating the outcome.” *Id.*

Since Opposer is aware of the proceeding and its proceeding number, Opposer is already in possession of all the information to which it is entitled. Opposer’s motion to compel Document Request No. 35 is therefore **DENIED**.

Document Request No. 36

36. Produce all documents and correspondence relating to the purchase of the IPAD Mark by the Applicant from Fujitsu, Inc.

Documents relating to Applicant’s acquisition of rights in the involved mark from a third-party are relevant. *See Johnston Pump/Gen. Valve Inc. v. Chromalloy Am. Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988). As such, Opposer’s motion to compel Document Request No. 36 is **GRANTED**. However, as the purchase price bears little relevance to the issues herein, such information may be redacted from any documents produced in response to this request.

Document Request Nos. 38-39

38. Produce all documents and correspondence to and/or from Steve Jobs regarding the adoption of the IPAD Mark.

39. Produce all documents and correspondence to and/or from Steve Jobs regarding the use of the IPAD Mark for the services described in Applicant's Applications.

As the parties recognize, information concerning a party's selection and adoption of its involved mark is generally discoverable, particularly as it concerns a defendant. *See Goodyear Tire & Rubber Co. v. Tyrco Indus.*, 186 USPQ 207, 208 (TTAB 1975). Since Applicant identified Apple's CEO Steve Jobs as knowledgeable on the subject matter of these requests, Opposer's motion to compel Document Request Nos. 38 and 39 is **GRANTED**. To the extent responsive documents are in Applicant's possession, custody or control, Applicant must produce them. However, any other documents that are responsive to these requests not within Applicant's possession, custody or control but within the possession, custody or control of Apple, a non-party, Opposer must seek their production pursuant to a subpoena. *See Fed. R. Civ. P. 34(c) and 45.*

Document Request No. 42

42. Produce any assignments relating to or regarding any rights Applicant purports to have in the IPAD Mark.

As previously noted, documents concerning Applicant's acquisition of rights in the involved mark are relevant and subject to discovery. To the

extent this request is not duplicative of Request No. 36, Opposer's motion to compel Document Request No. 42 is hereby **GRANTED**.

Applicant is to supplement its discovery responses as ordered herein no later than **OCTOBER 30, 2015**.

Privilege Log

To the extent that Applicant claims that any information or document is privileged, Applicant must state with specificity the basis for the assertion of privilege. In the case of documents withheld from production, Applicant must identify and describe each such document with particularity, in order to permit the Board and the parties to assess the propriety of the claim. *See* Fed. R. Civ. P. 26(b)(5); *No Fear*, 54 USPQ2d at 1556.

Applicant appears to recognize its obligations in regard thereto but has yet to produce one. Applicant is therefore ordered to serve Opposer with its privilege log no later than **OCTOBER 30, 2015**.

Confidentiality Designations

As to Applicant's latest responses to discovery, Opposer challenges their "Trade Secret/Commercially Sensitive" designation pursuant to the parties' stipulated protective order (filed February 4, 2013, and approved by the Board on February 14, 2013). By the terms of that protective order, the parties are obligated to negotiate in good faith concerning the designation and to raise any challenges to the designation within fourteen (14) days of the production. *Stipulated Protective Order*, 5 TTABVUE 9-10. When the

designation is timely challenged, the designating party bears the burden of proving that the information should be protected. *Id.*

Applicant contends that Opposer's challenge of the designation is untimely. The Board disagrees. Here, the subject responses, all of which Applicant designated as "Trade Secret/Commercially Sensitive," were served on January 28, 2015. By correspondence dated February 5, 2015, Opposer challenged the designation and by correspondence dated February 19, 2015, Applicant rejected the challenge.

The Board does not read the "challenge" provision of the parties' stipulation so restrictively as to limit a "challenge" to only that made to the Board by way of motion. To do so, in view of the short time frame provided, would eviscerate the parties' obligation to negotiate in good faith before bringing the dispute to the Board for resolution. Indeed, under the circumstances herein where Applicant itself took fourteen (14) days to reject Opposer's concerns, it is unclear when Opposer could have "timely" challenged Applicant's designation.

With that being said, Applicant's wholesale designation of its responses to Opposer's third sets of interrogatories and document requests as "Trade Secret/Commercially Sensitive" appear to be unwarranted, *see General Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1591 n.4 (TTAB 2011) (excessive markings of various information as confidential often indicates that matter is improperly designated or not useful to case),

judgment set aside on other grounds, 110 USPQ2d 1679 (TTAB 2014), and to run contrary to the parties' understanding that "[o]ccasions when a whole document or brief must be submitted under seal should be very rare." *Stipulated Protective Order*, 5 TTABVUE 9.

Applicant is reminded of its duty to make a meaningful good faith effort to designate only that information that warrants the designated level of protection, if any, and within the scope of and consistent with the protective order entered in these proceedings. *See Blackhorse v. Pro Football Inc.*, 98 USPQ2d 1633, 1635 (TTAB 2011) (party to be circumspect and to limit the "confidential" designation only to information that is truly confidential or commercially sensitive). Applicant is therefore ordered to redesignate its responses to Opposer's third set of discovery requests in keeping with the parties' stipulated protective order, no later than **OCTOBER 30, 2015**.

Extension of Discovery

As noted by Applicant, Opposer's request for an extension of discovery was made prior to the close of the discovery period, as reset. As such, Opposer need only show good cause for the requested extension. *See Fed. R. Civ. P. 6(b)*. Here, as there is no indication of undue delay or lack of diligence on the part of Opposer in taking discovery and in view of the discovery ordered herein, the Board finds good cause to extend the discovery period.

Proceedings herein are **RESUMED** and dates are **RESET** as follows:

Discovery Closes	11/30/2015
Plaintiff's Pretrial Disclosures Due	1/14/2016

Plaintiff's 30-day Trial Period Ends	2/28/2016
Defendant's Pretrial Disclosures Due	3/14/2016
Defendant's 30-day Trial Period Ends	4/28/2016
Plaintiff's Rebuttal Disclosures Due	5/13/2016
Plaintiff's 15-day Rebuttal Period Ends	6/12/2016

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 taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 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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