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

Mailed: November 3, 2013

Opposition No. 91208855

Greater Louisville Convention
& Visitors Bureau

v.

The Wine Group LLC

George C. Pologeorgis,
Interlocutory Attorney:

This case now comes before the Board for consideration of (1) applicant's motion (filed April 5, 2013) for reconsideration of the Board's April 5, 2013, order, and (2) applicant's combined motion (filed July 15, 2013) to compel and to test the sufficiency of responses to applicant's requests for admission. The motions are fully briefed.

Applicant's Motion for Reconsideration

As background, on February 26, 2013, opposer filed its answer to applicant's counterclaim and asserted certain affirmative defenses. On March 6, 2013, applicant filed a motion to strike opposer's Affirmative Defenses 2-4 asserted in opposer's answer to applicant's counterclaim. Opposer filed a response to applicant's motion to strike, as well as a cross-motion to amend its

answer which opposer maintained addressed all the issues raised in applicant's motion to strike.

By order dated April 5, 2013, the Board granted opposer's cross-motion to amend its answer because the amended answer cured all the deficiencies raised in applicant's motion to strike. Additionally, by the same order, the Board deemed applicant's motion to strike moot and gave it no further consideration.

We now turn to applicant's motion for reconsideration of the Board's April 5, 2013, order. In support thereof, applicant maintains that the Board erred in granting opposer's cross-motion to amend its answer to applicant's counterclaim prior to the time applicant was permitted under Board rules to file its opposition to opposer's motion to amend. Applicant further contends that, in effect, the Board treated opposer's cross-motion to amend its answer as conceded. Alternatively, applicant requests that if the Board believes that it acted in a procedurally proper manner, that its opposition to opposer's cross-motion to amend be treated as a renewed motion to strike opposer's Affirmative Defenses No. 2-4.

It has often been stated that the premise underlying a request for reconsideration under Trademark Rule 2.144 is that, based on the evidence of record and the prevailing authorities, the Board erred in reaching the decision it issued. *See* TBMP § 518 (3d ed. rev. 2 2013) and authorities cited therein. The request may not be used to introduce additional evidence, nor should it be devoted simply to a reargument of the points presented in the requesting party's

brief on the case. *See Amoco Oil Co., supra.* Rather, the request normally should be limited to a demonstration that, based on the evidence properly of record and the applicable law, the Board's ruling is in error and requires appropriate changes. *See Steiger Tractor Inc. v. Steiner Corp.*, 221 USPQ 165 (TTAB 1984), *different results reached on reh'g*, 3 USPQ2d 1708 (TTAB 1984).

It was unnecessary for the Board to wait for applicant's response to opposer's cross-motion to amend because, based upon the record, the Board found that the amendment would neither violate settled law nor be prejudicial to the rights of applicant. Further, the Board found that opposer's proposed amended answer cured the deficiencies raised in applicant's motion to strike. Even if we were now to consider applicant's response to opposer's cross-motion to amend its answer, we nonetheless find the arguments set forth in applicant's opposition unpersuasive inasmuch the arguments are essentially directed to the merits of opposer's Affirmative Defenses Nos. 2 and 3[1] instead of whether opposer has provided a sufficient factual foundation for the affirmative defenses at issue.

In view of the foregoing, opposer's motion for reconsideration of the Board's April 5, 2013, order is **DENIED**. The Board's April 5, 2013, order stands as issued.

Moreover, to the extent that applicant has requested that the Board treat applicant's opposition to opposer's cross-motion to amend as a renewed motion to

[1] The Board notes that, by way of its motion to amend its answer, opposer deleted in its entirety Affirmative Defense No. 4 raised in its original answer.

strike opposer's Affirmative Defenses 2-3, the renewed motion to strike is **DENIED** for the reasons discussed above.

Applicant's Motion to Compel

Initially, the Board finds that applicant has made a good faith effort to resolve the parties' discovery dispute prior to seeking Board intervention and that applicant's motion is timely. *See* Trademark Rule 2.120(e)(1).

We first turn to the portion of applicant's motion to compel which requests that opposer be compelled to copy and produce non-privileged, responsive documents to applicant's written document requests in lieu of making the documents available at opposer's place of business. The request is **DENIED**. *See Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1777 (TTAB 1998)("A party is not required to copy responsive documents and forward them to its adversary in response to document requests. Parties often do this as a reciprocal courtesy, but it is sufficient for a responding party to make documents available, at the place they are normally kept, for inspection and copying by the inquiring party.").

As to the merits of applicant's motion to compel responses to the document requests at issue, the motion is **GRANTED**, in part, and **DENIED**, in part, to the extent set forth below:

Document Requests

Document Request No. 26

All documents concerning the quality control exercised by the licensor of registered mark No. 3,932,986 as pleaded in paragraph 2 of the Notice of Opposition.

Motion is **GRANTED** to the extent that opposer must make available for inspection non-privileged responsive documents to the above-identified document request. Opposer's confidentiality objection to the above-identified document request is overruled inasmuch as the Board's standard protective order has been automatically imposed upon this proceeding. Opposer's objections based upon vagueness/ambiguity and that the requests seek information not reasonably calculated to lead to the discovery of admissible evidence are also overruled. Clearly, this request seeks documents which demonstrate how the licensor of the mark identified in opposer's pleaded Registration No. 3932986 exercises quality control over the mark and the associated goods.

Document Request No. 30

Each document concerning or reflecting the use of term "bourbon" as or as part of a trademark.

Motion is **DENIED** because the request, as currently worded, is overly broad and could include documents that may not be relevant to this proceeding. This case concerns a claim of priority and likelihood of confusion and a counterclaim of abandonment. Neither party has asserted a claim of dilution. Accordingly, even if opposer may have in its possession, custody or control

documents which show use of the term "bourbon" as a trademark/service mark for goods and/or services not related to the parties' respective goods and/or services, such documents are not relevant to the issues in this proceeding and, therefore, opposer need not produce them.

Document Request No. 32

All documents constituting, reflecting or discussing communications between YOU and the owner of registration no. 3,932,986.

Motion is **DENIED** because the request., as currently worded, is overly broad and could include documents that may not be relevant to the issues in this proceeding. Specifically, the request improperly seeks documents regarding communications between opposer and the owner of Reg. No. 3,932,986 on any matter and not to the limited issues in this case.

Applicant's Motion To Test Sufficiency Of Admission Responses

Admission Requests No. 3, 36, and 37

Applicant's motion to test the sufficiency of opposer's responses to each of the above-identified admission requests is **DENIED** in its entirety. The Board notes that opposer has provided an unquailed denial to each of the above admission requests. Generally, if there is an admission or denial to a particular request for admission, the Board will not find the response to be insufficient even if the responding party included an explanation or clarification of the admission or denial, or admitted after first denying. See TBMP § 524.01 (3d ed. rev. 2 2013). The fact that applicant contests the

veracity of opposer's denial does not constitute grounds to test the sufficiency of the response to the admission request.

Summary

1. Applicant's motion for reconsideration of the Board's April 5, 2013, order is **DENIED**;
2. Applicant's renewed motion to strike Affirmative Defenses No. 2 and 3 asserted in applicant's amended answer to opposer's counterclaim is **DENIED**;
3. Applicant's motion to test the sufficiency of responses to its admission requests is **DENIED** in its entirety; and
4. Applicant's motion to compel is **GRANTED**, in part, and **DENIED**, in part, as discussed above.

Opposer is allowed until **thirty (30) days** from the mailing date of this order to make available for inspection documents responsive to applicant's document requests, excluding Document Request Nos. 30 and 32. If there are no responsive, non-privileged documents in opposer's possession, custody or control which are responsive to any of applicant's document requests (except for Document Request Nos. 30 and 32), opposer, within the same **thirty (30) days** provided above, must so advise applicant by identifying the specific document requests to which opposer does possess non-privileged, responsive documents.

Additionally, opposer is required to provide applicant a privilege log within the same **thirty (30) days** provided above to the extent that opposer

claims privilege to any of applicant's written discovery requests, if it has not already done so.[2]

In the event opposer fails to provide applicant with full and complete responses to the outstanding discovery, as required by this order, opposer will be barred from relying upon or later producing documents or facts at trial withheld from such discovery.[3] *See* Fed. R. Civ. P. 37(c)(1).

Trial Schedule

Proceedings herein are resumed. Discovery is open. Remaining trial dates are reset as follows:

Expert Disclosures Due	**February 1, 2014**
Discovery Closes	**March 3, 2014**
Plaintiff's Pretrial Disclosures Due	**April 17, 2014**
30-day testimony period for plaintiff's testimony to close	**June 1, 2014**
Defendant/Counterclaim Plaintiff's Pretrial Disclosures Due	**June 16, 2014**
30-day testimony period for defendant and plaintiff in the counterclaim to close	**July 31, 2014**
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	**August 15, 2014**

[2] The Board expects the parties (and their attorneys) to cooperate with one another in the discovery process and looks with extreme disfavor on those who do not. TBMP § 408 (3d ed. rev. 2 2013). Each party and its attorney have a duty to make a good faith effort to satisfy the discovery needs of its adversary. *Id.*

[3] If opposer fails to comply with this order, applicant's remedy lies in a motion for sanctions, pursuant to Trademark Rule 2.120(g)(1). Furthermore, the parties are reminded that a party that has responded to a discovery request has a duty to supplement or correct that response. *See* Fed. R. Civ. P. 26(e).

30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	**September 29, 2014**
Counterclaim Plaintiff's Rebuttal Disclosures Due	**October 14, 2014**
15-day rebuttal period for plaintiff in the counterclaim to close	**November 13, 2014**
Brief for plaintiff due	**January 12, 2015**
Brief for defendant and plaintiff in the counterclaim due	**February 11, 2015**
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	**March 13, 2015**
Reply brief, if any, for plaintiff in the counterclaim due	**March 28, 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.l25.

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.