

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

EJW

Mailed: September 2, 2015

Opposition No. 91210506 (parent)

Opposition No. 91217286

Opposition No. 91217287

Ovation LLC

v.

E! Entertainment Television, LLC

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

These cases now come up for consideration of Opposer's fully briefed combined motion (filed April 3, 2015) (i) to compel supplementary responses to certain of its interrogatories and requests for production of documents and to produce all documents responsive to Opposer's requests and (ii) to test the sufficiency of Applicant's responses to Opposer's requests for admission and to order Applicant's supplementary responses thereto.

For purposes of this order, the Board presumes the parties' familiarity with the pleadings, and the parties' arguments and materials submitted in connection with the subject combined motion.

Findings of Fact

Before addressing Opposer's specific requests and arguments, the Board finds it appropriate to make the following findings of fact with respect to the parties' discovery dispute pertaining to Opposer's propounded discovery:

- 1) Opposer's interrogatories and requests for production of documents were served on January 24, 2014; thus, were due no later than February 28, 2014;
- 2) Opposer's requests for admission were served on Applicant on February 12, 2014; thus, Applicant's responses thereto were due no later than March 19, 2014.
- 3) The parties agreed to an extension of Applicant's due dates to April 9, 2014.
- 4) On April 9, 2014, Applicant filed a motion to compel and a request for an extension of time until May 9, 2014, to serve its written responses for Opposer's discovery served on January 24, 2014 (*i.e.*, Opposer's interrogatories and requests for production of documents).
- 5) On April 29, 2014, Opposer informed Applicant, *inter alia*, that its responses were untimely, and stated that Applicant should respond without objection.
- 6) Applicant served its responses to all of Opposer's discovery requests, including its requests for admission, on May 9, 2014.
- 7) On July 1, 2014, Opposer sent Applicant a letter explaining the alleged deficiencies in Applicant's discovery responses and requesting a "meet and confer" regarding said deficiencies. Opposer's letter addressed virtually all of Opposer's discovery requests alleged to be insufficient.
- 8) On July 9, 2014, Opposer filed two additional notices of opposition regarding application Serial Nos. 85937423 and 85937399; and Opposition Nos. 91217286 and 91217287, involving said applications respectively, were instituted.

- 9) On July 11, 2014, Applicant served supplementary discovery responses on Opposer.
- 10) On July 22, 2014, the parties conducted a “meet and confer” by telephone concerning Applicant’s assertedly deficient responses and supplementary responses.
- 11) In its order dated July 31, 2014, the Board extended Applicant’s time to respond to Opposer’s previously propounded discovery for thirty days from the mailing date of that order (see 18 TTABVUE 29).¹ Inasmuch as an extension of time was not requested or granted with respect to Opposer’s requests for admission and Applicant’s responses were due on April 9, 2014, but no responses were served until May 9, 2014, said requests are admitted by operation of Fed. R. Civ. P. 36(a)(3).

Decision

A. Motion to Test the Sufficiency of Applicant’s Admissions

A matter is admitted unless, within 30 days after being served, the party to whom the request is directed serves on the requesting party a written answer or objection addressed to the matter and signed by the party or its attorney. Fed. R. Civ. P. 36(a)(3). Further, a matter admitted under this rule is conclusively established unless the court, on motion, permits the admission to be withdrawn or amended. Fed. R. Civ. P. 36(b).

¹ To the extent the Board’s July 31, 2014, order may have been unclear, insofar as Applicant only sought an extension of time with respect to the discovery propounded by Opposer on January 24, 2014, the Board’s order granting the extension of time only applied to the discovery served on that date, and not to Opposer’s requests for admission served on February 12, 2014.

Here, because Applicant did not serve its responses to Opposer's requests for admission until May 9, 2014, rather than April 9, 2014, and Applicant's motion to extend time did not apply to Opposer's requests for admission, Opposer's requests are deemed admitted. Fed. R. Civ. P. 36(a)(3). In view thereof, there was no need for Opposer to file its motion to test the sufficiency of Applicant's responses as they are not the operative responses in this matter. *See American Automobile Association (Inc.) v. AAA Legal Clinic of Jefferson Crooke, P.C.*, 930 F.2d 1117, 19 USPQ2d 1142, 1144 (5th Cir. 1991) (court may not *sua sponte* withdraw or ignore admissions without a motion to withdraw or amend). *See also* TBMP § 407.04 (any matter admitted, either expressly or for failure to timely respond, is conclusively established unless Board permits otherwise) (2015); TBMP § 525. Accordingly, Opposer's motion to test the sufficiency of Applicant's responses is moot and will be given no further consideration.

B. Motion to Compel

As a threshold matter, the Board finds that Opposer made a sufficient effort to resolve the matters in dispute prior to filing its motion to compel by setting forth the deficiencies in its letter dated July 1, 2014, and by its subsequent meet and confer on July 22, 2014, regarding Applicant's initial and supplementary responses (26 TTABVUE 20, declaration of Paul Bost, ¶11). *See* Trademark Rule 2.120(e)(1). The fact that the proceeding was suspended for settlement afterwards does not diminish Opposer's efforts to resolve the parties' discovery dispute.²

² Opposer also furnished complete copies of the propounded discovery and Applicant's responses in accordance with Trademark Rule 2.120(e)(1).

Based on the Board's review of the parties' arguments and materials, the Board issues the following summary orders with respect to the specific interrogatories and requests for production of documents identified in Opposer's motion to compel. Where Applicant is ordered to respond to the particular interrogatory or production request, the motion to compel is granted; and where no response is required, the motion is denied. Thus, Opposer's motion is **granted in part and denied in part** to the extent discussed below:

- *Interrogatories*

- 1) Nos. 2 and 3: Applicant's objections are **OVERRULED**. Opposer is entitled to know the first use dates in commerce and anywhere for all of Applicant's identified services. Such information is relevant to issues of priority and to use/abandonment. Applicant is **ORDERED** to respond to this interrogatory in regard to the services identified in the opposed application for the mark POP OF CULTURE. *See* TBMP § 414(5).
- 2) No. 9: Information concerning a defendant's actual knowledge of plaintiff's use of the plaintiff's involved mark, including whether defendant has actual knowledge thereof, and, if so, when and under what circumstances it acquired such knowledge, is discoverable. *See* TBMP § 414(19). Applicant's response fails to state under what circumstances, including by whom, Applicant learned of Opposer's use of the CULTUREPOP mark and the www.culturepop.com website. Insofar as Opposer gave specific examples of the type of information sought, Applicant's objection that the interrogatory is

overly broad is **OVERRULED**. Applicant is **ORDERED** to respond to this interrogatory by providing information as to who learned of Opposer's use and specifically when that person learned of Opposer's use of its mark and/or website. "On or about 2012" is an insufficient response.

- 3) No. 12: Applicant objected to the alternative request made by Opposer, rather than answering the initial straightforward query asked by Opposer, *i.e.*, "state separately the annual total amount spent by or on behalf of Applicant for advertising promoting, or marketing the POP OF CULTURE goods and services from the date of first use to present." Applicant's objections are thus **OVERRULED**. Applicant is **ORDERED** to provide to Opposer information on Applicant's annual advertising figures, stated in round numbers, for Applicant's involved services sold under its involved mark. *See* TBMP § 414(18) and cases cited therein. If Applicant considers such information to be confidential, disclosure may be made under protective order.
- 4) No. 19: Opposer has agreed to narrow the scope of this interrogatory to seeking identification and description of cross-marketing and related agreements or arrangements between Applicant and third parties resulting in the use of Applicant's marks on advertisements or promotional materials, in particular those agreements related to the advertising campaigns mentioned in Applicant's response to interrogatory no. 17. Read in conjunction with the original interrogatory, Opposer is requesting information on such agreements relating to the POP OF CULTURE goods or

services; and Opposer seeks in particular the date of each such agreement/arrangement, the term of said agreements, a description of the rights licensed or granted, and the types of goods or services relating to each such agreement. In view thereof, Applicant's objection that the interrogatory is overly broad is **OVERRULED**. Additionally, information concerning contractual agreements between a responding party and third parties based on the responding party's involved mark is discoverable. *See* TBMP § 414(10); and *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (licensing agreements and arrangements between opposer and third parties and amount of sales thereto are relevant); *American Society of Oral Surgeons v. American College of Oral & Maxillofacial Surgeons*, 201 USPQ 531, 533 (TTAB 1979) (relevant to show admissions against interest, limitations on rights in mark, course of conduct leading to abandonment, that the mark has been carefully policed, etc.); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 172 (TTAB 1975) (contacts with third parties, such as through litigation or agreements, based on pleaded mark for involved goods, are relevant). *See also* TBMP § 414(17) (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 discoverable, as is the identity of the advertising agency employees having the most knowledge of such advertising and promotion). Accordingly, Applicant is **ORDERED** to provide the specific information requested in this

interrogatory (*i.e.*, date, term, rights licensed, goods/services involved), but limited to those agreements and arrangements discussed in interrogatory no. 17 *and* which are related to the POP OF CULTURE mark.

- 5) No. 20: Opposer has agreed to narrow the requested information to seek only keywords and electronic tags that include Opposer's mark or marks similar thereto or any other references to Opposer, *i.e.*, the name "ovation." In view thereof, Applicant's objections are **OVERRULED**. Applicant is **ORDERED** to provide such information to Opposer.
- 6) No. 24: Applicant's response is sufficient. There is no obligation for Applicant to investigate information related to sales and advertising of goods/services sold in connection with third-party marks. *See* TBMP § 414(9) and cases cited therein.
- 7) No. 31: Applicant's objections are **OVERRULED**. Information regarding the amount of annual sales or revenue generated from services offered in connection with a mark is discoverable. *See* TBMP § 414(18) and cases cited therein. Applicant is **ORDERED** to provide information responsive to the interrogatory, specifically, annual sales figures related to the POP OF CULTURE mark for the services identified in the involved application.
- 8) No. 32: Applicant's objections are **OVERRULED**. This interrogatory is sufficiently clear. Applicant is **ORDERED** to identify all persons who provided information on Applicant's responses to Opposer's propounded discovery.

- *Requests for Production of Documents*

Opposer seeks responses or supplementary responses to the following requests for production of documents: 7, 10, 14-16, 21, 22, 24, 29, 32, 33, 36, 40, 42, 45-49, 54, 58-76, 78, 81 and 82.

- 1) No. 7: Opposer's request is sufficiently tailored and requests representative samples of the requested documents. Applicant's objections are **OVERRULED**. Applicant is **ORDERED** to provide Opposer with responsive documents.
- 2) No. 10: Insofar as Opposer requests "all documents," Applicant's objection that the request is overly broad and unduly burdensome is **SUSTAINED**. Nonetheless, Applicant is **ORDERED** to serve on Opposer *sufficient* documents to demonstrate Applicant's actual and intended channels of trade for Applicant's services rendered in connection with the POP OF CULTURE mark.
- 3) No. 14: Applicant's objection that the request is overly broad and unduly burdensome is **SUSTAINED**. Nonetheless, Applicant is **ORDERED** to serve on Opposer *material* documents related to surveys, public opinion polls, or any other forms of consumer or market research that relate to the POP OF CULTURE marks, the services advertised or rendered in connection with the involved marks, the CULTUREPOP mark, the CulturePop.com website, marks including the term CULTURE and/or POP, or Opposer.

- 4) No. 15: Opposer's request is sufficiently tailored and requests representative samples of the requested documents. Applicant's objections are **OVERRULED**. Applicant is **ORDERED** to provide Opposer with responsive documents.
- 5) No. 16: The Board fails to see the relevance of the requested documents. No response is required.
- 6) No. 21: Applicant's objections are **SUSTAINED**. "All documents relating to marketing ..." is overly broad and vague and Opposer has not supported this request. Additionally, request no. 21 appears cumulative of request no. 23 insofar as Opposer properly requests in request No. 23 representative samples of all advertisements and marketing material for the POP OF CULTURE services. No response is required.
- 7) No. 22: Applicant's objections are **OVERRULED**. However, Applicant is **ORDERED** to serve on Opposer *sufficient and material* documents that demonstrate or discuss the method of marketing for each of the POP OF CULTURE services.
- 8) No. 24: Information concerning contractual agreements between a responding party and third parties based on the responding party's involved mark is discoverable. *See* TBMP § 414(10). Applicant is **ORDERED** to provide copies of the requested third-party agreements related to the POP OF CULTURE marks. If the number of such agreements is too burdensome to produce, Applicant may produce a representative sampling of said agreements, but

must explain in its response why the actual number is too burdensome to produce. Applicant may also produce said documents in accordance with the parties' standard protective agreement.

- 9) No. 29: Insofar as Opposer requests "all documents," Applicant's objection that the request is overly broad and unduly burdensome is **SUSTAINED**. However, to the extent that *privileged* documents exist which are responsive to Opposer's request, Applicant is **ORDERED** to provide a privilege log that delineates which documents are being withheld.
- 10) No. 32: The Board fails to see the relevance of this request. No response is required.
- 11) No. 33: Insofar as Opposer requests "all documents," Applicant's objection that the request is overly broad and unduly burdensome is **SUSTAINED**. However, as discussed *supra*, information concerning contractual agreements between a responding party and third parties based on the responding party's involved mark is discoverable. *See* TBMP § 414(10). Therefore, Applicant is **ORDERED** to provide copies of the requested licensing agreements or assignments related to the POP OF CULTURE marks. If the number of such agreements is too burdensome to produce, Applicant may produce a representative sampling of said agreements, but must explain in its response why the actual number is too burdensome to produce. Applicant may also produce said documents in accordance with the parties' standard protective agreement.

- 12) No. 36: Applicant's objections are **SUSTAINED**. However, if Applicant has documents indicating plans for expansion of its use of the POP CULTURE marks, Applicant must provide copies of such documents. To the extent that privileged documents exist which are responsive to Opposer's request, Applicant is **ORDERED** to provide a privilege log that delineates which documents are being withheld.
- 13) No. 40: This request is somewhat cumulative with request no. 24. Therefore, to the extent Applicant has not already responded to request no. 24, Applicant is **ORDERED** to provide copies of licensing agreements and like (as mentioned in the request) relating to the POP OF CULTURE marks, the services provided with said mark, or any mark including the terms POP or CULTURE between Applicant and a third-party.
- 14) No. 42: This request is overly broad, unduly burdensome, and oppressive in nature. Applicant's objections are **SUSTAINED**. No response is required.
- 15) No. 45: This request is cumulative of other requests and is overly broad and unduly burdensome. Applicant's objections are **SUSTAINED**. No response is required.
- 16) No. 46: This request is cumulative of other requests and is overly broad and unduly burdensome. Applicant's objections are **SUSTAINED**. No response is required.
- 17) No. 47: This request is overly broad and unduly burdensome and potentially cumulative. However, to the extent Applicant has not already provided the

same documents in response to other requests for production, Applicant is **ORDERED** to provide to Opposer any non-privileged documents Applicant relied upon in preparation of its responses to Opposer's first set of interrogatories. If there are any privileged documents, said documents should be identified in a privilege log.

18)No. 48: This request is overly broad to the extent it asks for "all" documents and refers to "or any other name." However, Applicant is **ORDERED** to provide to Opposer material documents relating to the registration, purchase, acquisition, bid, or use of the involved marks, including the words "POP" or "CULTURE," as specifically discussed in this request.

19)No. 49: Applicant's objections to this request are **OVERRULED**. The Board finds this request to be clearly drafted and not ambiguous. To the extent the request assumes incorrectly that Applicant has utilized or utilizes "electronic tags or markings, or search terms attached to, associated with, or flagged for the POP OF CULTURE services," Applicant may respond that no documents exist that are responsive to this request.

20)No. 54. This request is overly broad and unduly burdensome. Further, Opposer has not supported this request. No response is required.

21)Nos. 58-76: Except for request for production nos. 63 and 76,³ Applicant must produce *sufficient, principal or material non-confidential* documents upon which Applicant supports the allegations in the referenced allegation, along with a privilege log, if applicable. *See Hiskett v. Wal-Mart Stores, Inc.*, 180

³The Boards finds these requests to be overly broad and/or unduly burdensome.

F.R.D. 403, 405 (D.Kan. 1998). In the event that Applicant has already provided the appropriate document(s) in response to an interrogatory or to another request for production of documents, it may state so in its response, as required by Fed.R.Civ.P. 26(a). Such answer will fulfill Applicant's obligation to answer the request for production of documents without the necessity of duplicating its previous disclosures. *Id.*

22)Nos. 78, 82: Opposer has limited its requests to "documents reflecting Applicant's royalty and advertising revenue earned or generated from the offering of services under its marks at issue in round numbers." Therefore, Applicant must respond to these requests to the extent that Applicant is **ORDERED** to provide responsive documents that are *sufficient* to demonstrate Applicant's annual royalty or advertising revenue for its services offered under the involved marks, stated in round numbers.

23)Nos. 81: Applicant's objection that the request is overly broad and unduly burdensome is **SUSTAINED**. Nonetheless, Applicant is **ORDERED** to serve on Opposer documents that are sufficient to demonstrate Applicant's uses of the POP OF CULTURE mark in connection with streaming or broadcasting services on the internet or to mobile devices.

In view of the foregoing, Applicant is **ORDERED** to serve on Opposer's counsel *at its offices* within **THIRTY (30) DAYS** from the mailing date of this order information and documents that are responsive to Opposer's interrogatories and document requests, as discussed herein. Should no other information or documents

exist which are responsive to Opposer's interrogatories or requests for production other than that already provided or produced, Applicant must state so explicitly as to each discovery request. Where Applicant is or will withhold documents due to privilege, it must produce a privilege log to Opposer, also within thirty days of the mailing date of this order. *See* Fed. R. Civ. P. 26(b)(5)(A)(ii); and *Amazon Techs. Inc. v. Wax*, 93 USPQ2d 1702, 1706 n.6 (TTAB 2009).

Applicant is reminded that an evasive or incomplete response is the equivalent of a failure to disclose. *See* Fed. R. Civ. P. 37(a)(4); Trademark Rule 2.116(a). Further, should a party, due to an incomplete search of its records, provide an incomplete response to a discovery request, it may not thereafter rely at trial on information from its records which was properly sought in the discovery request but was not included in the response thereto, unless the response is supplemented in a timely fashion pursuant to Fed. R. Civ. P. 26(e). *See Panda Travel, Inc. v. Resort Option Enterprises, Inc.*, 94 USPQ2d 1789, 1791 (TTAB 2009); *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1720 (TTAB 1987). *See also* TBMP § 527.01(e) (“Estoppel Sanction”).

Applicant is also reminded of its *continuing duty* to thoroughly search its records for all information properly sought in discovery, and to provide supplementary information to Opposer. TBMP §§ 408.01 and 408.02. Further, a party that has responded to a request for discovery remains under a *continuing duty* to supplement or correct the response to include information thereafter acquired or uncovered. *Id.* at § 408.03.

Should Applicant not comply with the Board's orders herein, Opposer may seek appropriate sanctions. *See* Trademark Rule 2.120(g); and TBMP §§ 411.04 and 527.01 (2015).

Proceedings Resumed; Trial Dates Reset

These proceedings are resumed. Trial dates are reset as shown in the following schedule:

Discovery Closes	10/17/2015
Plaintiff's Pretrial Disclosures Due	12/1/2015
Plaintiff's 30-day Trial Period Ends	1/15/2016
Defendant's Pretrial Disclosures Due	1/30/2016
Defendant's 30-day Trial Period Ends	3/15/2016
Plaintiff's Rebuttal Disclosures Due	3/30/2016
Plaintiff's 15-day Rebuttal Period Ends	4/29/2016

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 the taking of testimony. *See* Trademark Rule 2.125, 37 C.F.R. § 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b), 37 C.F.R. §§ 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129, 37 C.F.R. § 2.129.

