

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

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Mailed: February 25, 2015

Opposition No. **91210643 (parent)**
Cancellation No. **92057408**

Tristar Products, Inc.

v.

Blue Gentian, LLC

Yong Oh (Richard) Kim, Interlocutory Attorney:

This matter comes up on Applicant/Respondent's ("Gentian") motion to compel discovery (filed October 7, 2014). By its motion, Gentian seeks further responses to Interrogatory Nos. 5-16 and 20, and Document Request Nos. 1, 8-19, 22 and 25. The motion is fully briefed.

As a preliminary matter, it is noted that the parties conferred on September 12, 2014, concerning Opposer/Petitioner's ("Tristar") objections and responses to Gentian's discovery requests. Absent evidence to the contrary, the Board herein presumes that the parties attempted to resolve their discovery dispute in good faith thereby discharging the good faith requirement of Trademark Rule 2.120(e)(1).¹

¹ It is noted that Tristar served supplemental responses to Interrogatory Nos. 1, 17, 20 and 21 on September 26, 2014. While Interrogatory Nos. 1, 17 and 21 are not part of Gentian's motion to compel, Interrogatory No. 20 remains in dispute. Yet there is no indication that Gentian followed up with Tristar concerning this

Interrogatory Nos. 5-16 and Document Request Nos. 8-19

As summarized by Gentian, these discovery requests seek “1) sales of the Flex-Able Hose, in units; 2) sales, in dollar amounts; and 3) Tristar’s profits from such sales,” collectively “for the time periods before and after July 23, 2012, the filing date of the application to register the ‘030 Mark,² and June 11, 2013, the registration date for the ‘590 Mark.³” *Motion to Compel*, pp. 2-3 (footnotes added). Gentian asserts that this information is relevant because Tristar has alleged “that the registration of the ‘030 and ‘590 Marks would prevent it from competing effectively in the marketplace” and therefore such information is “a relevant indicator of the Flex-Able Hose’s performance in the marketplace.” *Id.* This argument is not well taken.

Tristar’s allegations in its pleadings concerning its ability to compete effectively in the marketplace relate to its claim of damage and therefore its standing. Tristar has sufficiently pleaded its standing by virtue of alleging it is a competitor and that it has an equal right to use the marks involved herein. *See Books on Tape, Inc. v. Booktape Corp.*, 836 F.2d 519, 520, 5 USPQ2d 1301, 1302 (Fed. Cir. 1987); *DeWalt, Inc. v. Magna Power Tool Corp.*, 289 F.2d 656, 661, 129 USPQ 275, 280 (CCPA 1961) (“damage to an

interrogatory prior to filing its motion to compel. Nevertheless, in the interest of moving this proceeding forward, the Board will consider Gentian’s arguments as to Interrogatory No. 20 on the merits.

² Application Serial No. 85684030.

³ Registration No. 4351590.

opposer or injury to a petitioner for cancellation ... will be presumed or inferred when the mark sought to be registered is descriptive of the goods and the opposer or petitioner is one who has a sufficient interest in using the descriptive term in its business”). Gentian’s reliance on *Sunkist Growers, Inc. v. Benjamin Ansehl, Co.*, 229 USPQ 147 (TTAB 1985) for the blanket proposition that “sales information is relevant to issues in an opposition or cancellation proceeding” is misplaced. *Sunkist Growers* and the cases cited therein for such a proposition all concerned issues of abandonment and/or likelihood of confusion, neither of which are involved in the proceedings herein. Rather, Tristar’s allegations concern claims of mere descriptiveness, genericness, functionality, and failure to function as a trademark, none of which require Tristar to establish a proprietary right in a mark. Thus, Gentian’s discovery requests concerning Tristar’s sales is neither relevant nor reasonably calculated to lead to the discovery of admissible evidence.

Accordingly, Gentian’s motion to compel further responses to Interrogatory Nos. 5-16 and Document Request Nos. 8-19 is hereby **DENIED**.

Document Request Nos. 22 and 25

These requests seek the following:

Document Request No. 22: All documents and things pertaining to the market for the Flex-Able Hose, including, but not limited to, price points, market segments, customer base, competition, and anticipated and actual market share.

Document Request No. 25: All annual reports, financial statements, prospectuses, business plans, and strategic plans related to the Flexible Hose in the United States.

To the extent that Gentian, again, asserts that these requests are relevant to Tristar's allegation that Gentian's marks would prevent Tristar from competing effectively in the marketplace, the assertion is not well taken for the same reasons noted *supra*. As such, Gentian's motion to compel responses to Document Request Nos. 22 and 25 is hereby **DENIED**.

Interrogatory No. 20

The basis of Gentian's motion to compel further responses to this interrogatory is Tristar's failure to provide a description of the subject matter about which the individuals identified by Tristar would have knowledge regarding the allegations set forth in Tristar's notice of opposition and petition for cancellation.

As mentioned earlier in this order, had Gentian conferred with Tristar after receiving Tristar's supplemental responses, the necessity of filing a motion to compel a supplemental response to this interrogatory may have been obviated. To the extent that Tristar has noted in its brief that the identified individuals are both familiar with all the allegations set forth in Tristar's pleadings, the motion to compel further responses to Interrogatory No. 20 is now **MOOT**.

Document Request No. 1

This request seeks all documents and things identified in Tristar's initial disclosures served on August 8, 2014. With the exception of Disclosure No. 3 which relates to Tristar's trademark registration, Disclosure Nos. 1-10 concern file histories of Gentian's own trademark and patent applications and registrations and Disclosure No. 11 relates to the file history of the civil action between the parties, of which Gentian is obviously a part. Much of this information is already in Gentian's possession and to the extent that such information is not, Tristar has informed Gentian of where such information can be obtained. As such, Tristar's objections to the document request, insofar as it relates to these disclosures, are **SUSTAINED**.

As to documents relating to Disclosure Nos. 12-15, Tristar asserts that it has "produced all the documents in its possession that are not already public documents" and that Tristar "is not obligated to produce copies of documents already in [] Gentian's possession or are otherwise public documents that [] Gentian can retrieve itself." *Tristar's Opposition*, p. 6. To the extent that Tristar is referring to "public documents" not previously identified, as in the case of specific records of the USPTO, the objection is **OVERRULED**. Gentian's motion to compel is, therefore, **GRANTED in part** as to Document Request No. 1 and Tristar is ordered to produce those "public documents," if any, within its possession, custody or control not

previously identified and pertaining to Disclosure Nos. 12-15 within **TWENTY DAYS** from the mailing date of this order.

Dates are **RESET** as follows:

Expert Disclosures Due	4/24/2015
Discovery Closes	5/24/2015
Plaintiff's Pretrial Disclosures Due	7/8/2015
Plaintiff's 30-day Trial Period Ends	8/22/2015
Defendant's Pretrial Disclosures Due	9/6/2015
Defendant's 30-day Trial Period Ends	10/21/2015
Plaintiff's Rebuttal Disclosures Due	11/5/2015
Plaintiff's 15-day Rebuttal Period Ends	12/5/2015

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 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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