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

EJW

Mailed: September 19, 2015

Opposition No. 91211205 (parent)

Frank Lin Distillers Products, Ltd.

v.

NJoy Spirits, LLC. dba NJoy Spirits, LLC.

Cancellation No. 92060288

NJoy Spirits, LLC. dba NJoy Spirits, LLC.

v.

Frank Lin Distillers Products, Ltd.

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

These cases now come up for consideration of the fully briefed motion to compel filed April 29, 2015, by Applicant/Petitioner NJoy Spirits, LLC (hereafter "NJoy").

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

NJoy requests that the Board issue an order compelling Opposer/Respondent Frank Lin Distillers Products, Ltd. (hereafter "Frank Lin") to produce information and documents constituting Frank Lin's trademark search reports and settlement agreements entered into by Frank Lin with third parties who use the term "BUCK"

as part of their marks. Specifically, NJoy seeks information and documents responsive to interrogatory no. 3, and requests for production nos. 6, 24, and 25 (shown below), and asserts that NJoy's counsel has asked for these documents on multiple occasions.[1] NJoy contends that said documents are (i) relevant to its position that Frank Lin's mark is diluted and (ii) necessary to determine the complete nature of Frank Lin's enforcement efforts, including why it chose to permit coexistence with third parties in certain cases. The discovery requests at issue are as follows:[2]

- Interrogatory No. 3: Identify all documents, correspondence and e-mails relating to Atelier Vie's use of BUCK 25 after the letter attached as Exhibit A to Applicant's First Set of Interrogatories.
- Request No. 6: All search reports, documents and relevant reports concerning or relating to the selection or adoption of "BUCK" by Opposer.
- Request No. 24: All documents, correspondence and e-mails relating to Opposition No. 91/216,860 between Opposer/Respondent and Sazerac Company, Inc. regarding Sazerac's BUCK HORN mark.

[1] Although NJoy did not provide copies of its counsel's communications with Frank Lin's counsel regarding the discovery dispute, some communications between the parties' counsel are attached to the declaration of Ann Nguyen, Frank Lin's counsel. In view of this record and because Frank Lin does not dispute that NJoy made a good faith effort to resolve the issues discussed in the motion, the Board finds that NJoy made the required good faith effort prior to filing the subject motion. *See* Trademark Rule 2.120(g)(1).

[2] A copy of the relevant discovery requests was attached to NJoy's motion.

- Request No. 25: All documents, correspondence and e-mails relating to enforcement efforts against any third party based on Opposer/Respondent's BUCK mark.

Frank Lin has objected to the document production requests on the grounds that the queries are vague, ambiguous, overly broad and unduly burdensome, and has objected to all four discovery requests on the basis that they seek documents and things that are protected by the attorney-client privilege and the work product doctrine. As to interrogatory no. 3 and document request no. 6, Frank Lin has responded that it has no documents, except privileged documents which will not be produced; and as to document requests nos. 24 and 25, Frank Lin responded that it has provided some non-privileged documents (*i.e.*, cease and desist letters and opposition pleadings), that it will produce additional non-privileged documents, and that all documents are provided under the parties' protective order. In response to NJoy's motion, Frank Lin's counsel (Ann Nguyen) states in her declaration that a trademark search report relating to the selection or adoption of the BUCK mark was not ordered by Frank Lin or by anyone on its behalf (22 TTABVUE 9; Nguyen dec. ¶3). Frank Lin also argues, *inter alia*, that attorney's notes regarding trademark searches constitute attorney work-product and that settlement agreements with third parties are not relevant to the issues involved in this proceeding and are protected by Federal Rule of Evidence 408. The Board notes that Frank Lin provided a privilege log to NJoy.

In reply, NJoy asserts that even if Frank Lin did not conduct a third-party search for its mark, any internal search performed for the purpose of adopting its trademark is discoverable as a trademark clearance search. NJoy emphasizes that it does not seek to obtain communications that constitute attorney work-product or privileged communications between counsel and Frank Lin. Additionally, NJoy argues that under applicable case law of the Federal Circuit and the Board, Frank Lin's past settlement agreements are relevant and discoverable, and that whether or not said agreements are admissible is not the standard for obtaining discovery.

- *Decision*

At the outset, the Board finds NJoy's interrogatory no. 3 and production request no. 25 to be overly broad and ambiguous. Nonetheless, NJoy, in its motion, has explained specifically what information and documents it seeks in all four identified discovery requests, *i.e.*, any trademark search reports related to Frank Lin's use of the mark BUCK and any third-party settlement agreements regarding third-party use of BUCK and BUCK formative marks, and Frank Lin has responded in terms of the narrowly focused requests. In view thereof, the Board shall consider NJoy's motion in terms of the clarified requests.

As regards NJoy's request for copies of any trademark search reports relating to the selection or adoption of "BUCK" by Frank Lin, it is well-settled that search reports are not privileged and thus are discoverable. *See Fisons Limited v. Capability Brown Limited,* 209 USPQ 167, 170 (TTAB 1980); and *Amerace Corp. v.*

USM Corp., 183 USPQ 506, 507 (TTAB 1974). *See also* TBMP § 414(7) (2015). Clearly, Frank Lin's counsel conducted a trademark search. Ms. Nguyen states in her declaration that "[a]ny due diligence research needed before Frank Lin filed its application was conducted by myself or another attorney in my office" (22 TTABVUE 9; Nguyen dec. ¶3), and that "my correspondence to my client *regarding the searches I conducted* myself constitute privileged attorney-client communication" (*Id.* ¶5; emphasis added).

In view of the foregoing, NJoy's motion to compel is **granted** to the extent that Frank Lin must provide to NJoy's counsel within **TWENTY-ONE DAYS** from the mailing date of this order copies of any trademark searches which relate to or pertain to its selection or adoption of the mark "BUCK" by Frank Lin. If no such search result documents exist, that is, if the search results were not printed, Frank Lin must so state. If said search results exist, but are annotated by attorney's comments, Frank Lin is expected to provide a redacted copy of the search completed by its attorneys or others on its behalf.

Turning to whether Frank Lin must produce copies of its settlement agreements with third parties, the Board is not persuaded by Frank Lin's arguments that such agreements are neither relevant nor admissible, or by the decision it cited from District Court of the Southern District of New York. Whatever the state of the law in other circuits, the Board is bound by the decisions of the Federal Circuit (and its predecessor, the Court of Customs and Patent Appeals), which directly reviews the Board's decisions on appeal (*see In re The Government of the District of Columbia*,

101 USPQ2d 1588, 1596 n.12 (TTAB 2012)) and by the Board's own precedential decisions. *See* TBMP § 101.03 (2015).

As to the relevancy of settlement agreements with third parties, it is well-settled that such agreements are relevant and questions regarding same must be answered. *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (questions concerning licensing agreements and arrangements between opposer and third parties and amount of sales thereto should be answered); *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.); *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193, 197 (TTAB 1976) ("such agreements are proper matters for discovery since they may tend to show limitations on a party's rights in its mark or reveal inconsistencies with statements subsequently made by a party thereto in the pending proceeding"); *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 inasmuch as it might tend to show limitations on opposer's rights or inconsistencies with opposer's statements in this proceeding). *See also* TBMP § 414(10) (Information concerning litigation and controversies including settlement and other contractual agreements between a responding party and third parties based on the responding party's involved mark is discoverable.).

Moreover, with respect to Frank Lin's argument that such evidence is not admissible, it is well-established that relevant information need not be admissible at trial if the discovery appears reasonably calculated to lead to the discovery of admissible evidence. *See* Fed. R. Civ. P. 26(b)(1); Trademark Rule 2.116(a). *See also Johnston Pump/General Valve Inc.,* 10 USPQ2d at 1675 ("[d]uring discovery, a party may seek not only testimony and exhibits which would be admissible evidence but also information that would be inadmissible at trial if the information appears reasonably calculated to lead to the discovery of admissible evidence."). In any event, while "it is well settled that evidence of statements or any evidence of conduct made during the course of negotiations to amicably settle a case are generally not admissible in evidence, where parties have actually entered into written agreements, including licensing agreements and other written contractual understandings, on the basis of which a dispute has been settled in avoidance of litigation or as a settlement thereof, such agreements are proper matters for discovery since they may tend to show limitations on a party's rights in its mark or reveal inconsistencies with statements subsequently made by a party thereto in the pending proceeding." *Georgia-Pacific Corp.*, 190 USPQ at 197.

In view of the foregoing, NJoy's motion to compel copies of any trademark settlement agreements pertaining to the use of BUCK or BUCK formative marks is **granted**. Accordingly, Frank Lin is allowed until **TWENTY-ONE DAYS** from the mailing date of this order to provide to NJoy's counsel copies of Frank Lin's trademark settlement agreements regarding third-party use of the marks

BUCK 25, BUCKRUN, and BUCK HORN, and to the extent "documents relating to enforcement efforts against any third party" include third-party trademark settlement agreements, Frank Lin must also produce within the same period copies of any other of its trademark settlement agreements pertaining to third-party marks that use the term "BUCK."

Proceedings Resumed; Trial Dates Reset

These proceedings are resumed. Trial dates are reset in accordance with the following trial schedule:

Expert Disclosures Due	**November 24, 2015**
Discovery Closes	**December 24, 2015**
Plaintiff's Pretrial Disclosures Due	**February 7, 2016**
30-day testimony period for plaintiff's testimony to close	**March 23, 2016**
Defendant/Counterclaim Plaintiff's Pretrial Disclosures	**April 7, 2016**
30-day testimony period for defendant and plaintiff in the counterclaim to close	**May 22, 2016**
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	**June 6, 2016**
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	**July 21, 2016**
Counterclaim Plaintiff's Rebuttal Disclosures Due	**August 5, 2016**
15-day rebuttal period for plaintiff in the counterclaim to close	**September 4, 2016**
Brief for plaintiff due	**November 3, 2016**

Brief for defendant and plaintiff in the counterclaim due	**December 3, 2016**
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	**January 2, 2017**
Reply brief, if any, for plaintiff in the counterclaim due	**January 17, 2017**

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.

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