

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

GMM/APB

Mailed: June 17, 2015

Opposition No. 91212653

Nautica Apparel, Inc.

v.

Majestique Corporation

Andrew P. Baxley, Interlocutory Attorney:

In compliance with the Board's February 13, 2015 order, Opposer, on March 9, 2015, filed copies of Applicant's discovery responses. In view of such filing, this case now comes before the Board for consideration of Opposer's motion (filed October 31, 2014) to compel discovery. The motion has been fully briefed.¹

A brief review of the relevant history of discovery in this proceeding is warranted. Opposer prematurely and improperly served discovery requests on December 23, 2013, while this proceeding was suspended and prior to the opening of the discovery period. Applicant served responses to those requests on February 20, 2014, also while this proceeding was suspended. In accordance with the Board's April 16, 2014 order, Opposer re-served those discovery requests by mail on April 17, 2014. Applicant's responses thereto were due by May 22, 2014. *See* Trademark Rules 2.119(c) and 2.120(a)(3).

¹ In its brief in response to the motion to compel, Applicant incorporated a cross-motion to compel and to dismiss. The Board, in the February 13, 2015 order, indicated that the cross-motion would receive no consideration.

Although Applicant's time to respond to Opposer's discovery requests was not extended, Applicant did not serve its responses until July 7, 2014. Those responses are allegedly identical to Applicant's earlier discovery responses thereto.

In view of the July 22, 2014 and October 2, 2014 letters from Opposer's attorney to Applicant's attorney to which Applicant's attorney did not reply, the Board finds that Opposer made a good faith effort to resolve the parties' discovery dispute prior to seeking Board intervention. *See* Trademark Rule 2.120(e)(1); TBMP § 523.02 (2014). The Board notes, however, that, with fourteen interrogatory responses and eleven document request responses at issue in the motion to compel, there is an excessive number of discovery requests at issue in Opposer's motion.² *See Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986).

In its motion, Opposer asks the Board to compel Applicant's responses to Interrogatory Nos. 3, 5-9, 15-16, 19-22, 24, and 28 and Request for Production of Documents and Things Nos. 4-5, 14-22 and 24. Opposer further seeks sworn interrogatory responses under Fed. R. Civ. P. 33(b).

² Inasmuch as Opposer alleges in the notice of opposition ownership of registrations for similar marks for identical or substantially similar goods, Opposer's discovery needs in this case would appear to be minimal. *See* Trademark Act Section 2(d), 15 U.S.C. § 1052(d); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (standing based on ownership of registration); *Octocom Sys. Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (when pleaded registrations are of record, likelihood of confusion is determined based on the express wording of the identifications of goods in the applications and registrations at issue); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974) (when pleaded registration is of record, plaintiff need not establish prior use). Opposer is reminded that it has a duty to seek only such discovery as is proper and relevant to the issues in this case. *See* TBMP § 408.01.

Applicant's interrogatory responses are not signed under oath, as required by Fed. R. Civ. P. 33(b).³ Responses to interrogatories must be signed by the person making them, and objections to interrogatories must be signed by the attorney making them. Fed. R. Civ. P. 33(b)(5). Each interrogatory served to a corporation, unless objected to, must be answered separately and fully in writing under oath by an officer, partner, or agent. Fed. R. Civ. P. 33(b). Applicant is allowed until thirty days from the mailing date of this order to serve signed and sworn answers as required under Fed. R. Civ. P. 33(b).

Throughout Opposer's interrogatories, it seeks the identity of each person with certain types of information. Applicant need only identify a reasonable number of officers who are most knowledgeable of the requested information. *See Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975); *J.B. Williams Co. v. Pepsodent GmbH*, 188 USPQ 577, 580 (TTAB 1975). Moreover, any alleged inconsistencies in Applicant's responses goes to the probative weight of those responses, which is a matter for trial. Applicant is reminded, however, that it has a duty to amend or correct its responses, and that it may be precluded, upon objection from Opposer, from relying at final hearing upon information and documents which

³ In addition, the interrogatory responses are signed by Applicant's attorney. An attorney may sign his client's interrogatory responses, even if he has no personal knowledge of the facts stated therein. Fed. R. Civ. P. 33(b); *Allstate Insurance Co. v. Healthy America Inc.*, 9 USPQ2d 1663, 1665 (TTAB 1988); TBMP § 405.04(c) (2014). However, the attorney's answers, like the answers of a corporate officer, must provide the information available to the corporation as the responding party. *Id.* An attorney who answers interrogatories on behalf of a corporation may thereafter be exposed to additional discovery and possibly even disqualification *See Allstate Insurance*, 9 USPQ2d 1663 n.4.; TBMP § 405.04(c).

were sought but not disclosed during discovery. *See* Fed. R. Civ. P. 26(e) and 37(c)(1).

Regarding the specific requests at issue in Opposer's motion to compel, Opposer, in interrogatory no. 3, asks Applicant to "identify each person who was responsible for or who participated in the conception, selection, or adoption of Applicant's Mark." In response thereto Applicant identified itself and its President, Mr. Moises Zebede. Applicant's response identifies both a juristic person and a natural person. *See* Fed. R. Civ. P. 30(b)(6). Because the Board presumes that the identified legal persons are most knowledgeable of the requested information, this response is acceptable.

In interrogatory no. 5, Opposer asks Applicant to "identify each person who assisted, advised or otherwise participated in conducting trademark searches or any other search for the Applicant's Mark prior to Applicant's filing of its trademark application." Applicant responds, "our attorney." The Board presumes by such response that Applicant is identifying the attorney who has represented it since the filing of the involved application, Gino Negretti.⁴ This response is acceptable.

In interrogatory no. 6, Opposer asks Applicant to "describe each product that has been, is being, or will be sold or offered or sale using Applicant's mark in the United States." In response thereto, Applicant identified "clothing (25)." To the extent that Applicant seeks information regarding goods other than those identified in the involved application, the interrogatory is overly broad and irrelevant. *See* Fed. R.

⁴ If Applicant meant otherwise, it has a duty to correct its response. *See* Fed. R. Civ. P. 26(e).

Civ. P. 26(b)(1); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 190 (TTAB 1979) (applicant's use of mark on goods other than those identified in application irrelevant). Rather, the Board presumes that Applicant's response to this interrogatory is the identification of goods set forth in Applicant's application. To the extent that Opposer elsewhere in discovery seeks information and documents for goods identified in response to this interrogatory, the Board will treat those discovery requests as seeking information and documents regarding each of the goods identified in the involved application.

In document request no. 4 seeks a specimen, including packaging, for each of Applicant's identified goods. In response, Applicant directs Opposer to Applicant's involved application file. However, in the application, Applicant recited an extensive list of goods in that application, but submitted two specimens in support of the involved application. To the extent that Opposer seeks a specimen of each item set forth in the identification of goods of the involved application, this document request is proper. Applicant is directed to produce one specimen showing use of the mark for each good identified in the involved application. Applicant need not provide packaging for each identified good.

In interrogatory nos. 7 and 16 and document request nos. 21 and 22, Opposer seeks information regarding the identity of persons and businesses that sell or distribute Applicant's identified goods and customers and purchasers of those goods. To the extent these interrogatories and document requests seek the identity of all responsive persons and business entities, and customers, they are overly broad and

unduly burdensome. *See* Fed. R. Civ. P. 26(b)(2)(C); TBMP § 402.02. To the extent that Opposer seeks the names of dealers, distributors and employees thereof, customers and purchasers, such names are confidential and generally not discoverable even under protective order. *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988); TBMP 414(3). However, the name of the first customer for a party's involved goods or services sold under its involved mark is discoverable. *Id.* Further, the names and addresses of a reasonable number of officers most knowledgeable on the subject of Applicant's sale and/or distribution of its products identified in the involved application are discoverable. *J.B. Williams Co.*, 188 USPQ at 580; *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 122 (TTAB 1974). Accordingly, Applicant is directed to serve a supplemental response to interrogatory no. 7, wherein it identifies at least one officer with knowledge of Applicant's sale and/or distribution of its products bearing the involved mark, and to interrogatory no. 16 wherein it identifies the first retail establishment at which each of the identified goods were sold under the involved mark. In addition, Applicant is directed to produce documents sufficient to identify the first customer for each of its identified goods.

In interrogatory no. 8 and document request no. 5, Opposer seeks information and documents regarding the first sale of each of the identified goods and any discontinuation or resumption of such sales. Such information is discoverable. Applicant is directed to serve supplemental responses in which it provides responsive information and documents for each of its identified goods.

In interrogatory no. 9, Opposer asks Applicant to identify magazine, newspaper, and trade publication articles concerning goods sold under its mark. In response, Applicant's one-word answer, "no," does not clearly indicate whether Applicant is setting forth an objection or a substantive answer that no such advertising has occurred. Applicant is directed to serve a supplemental answer in which it answers the interrogatory.

In interrogatory no. 15, Opposer seeks retail prices for each of Applicant's identified goods. Applicant's response is incomplete because it provides the retail price for only one of the identified goods. Applicant is directed to respond fully by providing the retail prices for each of its identified goods.

In Interrogatory Nos. 19 and 20 and document request nos. 14 and 16, Opposer seeks information and documents regarding sales and advertising figures for each of Applicant's identified goods sold under its mark. Annual sales and advertising figures in round numbers are discoverable and may be disclosed under protective order. *Id. at* 123; TBMP § 414(18). Applicant is directed to answer these discovery requests by providing information and documents sufficient to show annual sales and advertising figures, stated in round numbers, for each of its involved goods since the alleged date of first use of the goods, June 27, 2012. If providing such figures for each of the involved goods is unduly burdensome, Applicant may provide the requested figures for the entirety of its goods.

In interrogatory nos. 21 and 22, Opposer seeks information regarding actual confusion between any of the parties' products. Applicant's responses to these

interrogatories do not indicate whether those responses are intended as an objection or a statement that it is not aware of any actual confusion between the marks. Evidence of actual confusion is relevant to the determination of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 177 USPQ 563, 567 (CCPA 1973). Applicant is directed to serve full responses to these interrogatories.

In interrogatory no. 24, Opposer seeks information concerning print advertising of Applicant's identified goods. Applicant's response, "there is none," is acceptable.⁵ In document request no. 20, Opposer seeks a representative sample of various types of advertising and promotional materials. Applicant's answer, that "the product has not been sold in Puerto Rico," is non-responsive. The advertising and promotional materials sought by Opposer are discoverable. Applicant is directed to produce a representative sample of advertising and promotional materials or, alternatively, indicate that responsive materials do not exist.

In interrogatory no. 28 and document request no. 24, Opposer seeks information and documents regarding the identification of, and communications with, Applicant's importers, distributors, manufacturers, and suppliers of its identified goods. Applicant objects on the grounds that the requested information is irrelevant and a business secret and further responds by identifying itself as a wholesaler and the importer of the goods.

⁵ This response is contradicted by its answer to Interrogatory No. 10, wherein Applicant states that the mark has been advertised in Puerto Rico. Applicant is reminded of its duty to thoroughly search its records for all information properly sought in the request. *See* TBMP § 408.02.

Applicant has satisfactorily identified itself as the importer of its products. Applicant's objection on the ground of confidentiality is well-taken with respect to distributors. The names of customers, including distributors, constitute confidential information and generally are not discoverable even under protective order. *See Johnston Pump/General Valve Inc.*, 10 USPQ2d at 1675; TBMP 414(3). With respect to "suppliers," Opposer's interrogatory is unduly vague because "suppliers" could encompass dealers or distributors, the identities of which are not discoverable. Further, to the extent that the suppliers in question are suppliers of ingredients or components of Applicant's identified goods, those suppliers are irrelevant to this case.

However, the identity of manufacturers of Applicant's goods sold under its involved mark is discoverable. *American Optical Corp.*, 181 USPQ at 122. Applicant is directed to supplement its response by identifying the manufacturers of the goods in the involved application. If Applicant treats this information as confidential, it may produce it under the standard Board protective order in place in this case.

In document request nos. 15 and 17, Opposer seeks documents concerning "estimated or projected gross income" and "estimated or projected number of units of products," respectively. Applicant indicates that there are no documents responsive to Request No. 15 (estimated or projected income) and objects to Request No. 17 (estimated or projected units) as speculative. These responses are acceptable.

In document request nos. 18 and 19, Opposer seeks documents concerning geographic locations in which Applicant offers products using Applicant's mark (No.

18) and intends to offer products using Applicant's mark (No. 19). Applicant indicates it has no documents responsive to document request no. 18. In response to document request no. 19 it simply states "Puerto Rico." Information concerning the geographic scope of sales of the involved products is discoverable. Applicant's response to Request No. 18 indicating no documents exist is acceptable. Applicant's answer to Request No. 19 is non-responsive. Applicant is directed to supplement its answer by stating whether or not responsive documents exist. If responsive documents exist, Applicant is further directed to produce a representative sample sufficient to disclose the geographic locations in which it intends to offer the products identified in the involved application. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000).

Based on the foregoing, Opposer's motion to compel is granted in part and denied in part. Applicant is allowed until **thirty days** from the mailing date set forth in this order to: (1) serve a complete set of interrogatory responses under oath, which includes supplemental responses to Interrogatory Nos. 7-9, 15-16, 19-22, and 28; (2) serve amended written responses for Document Request Nos. 4-5, 14, 16 and 19-22, and 24; (3) select, designate, and identify the items and documents, or categories of items and documents, to be produced in response to Document Request Nos. 4-5, 14, and 19-22; and (4) notify Opposer that the selection, designation and identification of such items and documents has been completed.

Opposer is allowed until **thirty days** from receipt of notification from Applicant that the items or documents have been selected, designated and identified to inspect

and copy the produced materials, as provided for in Fed. R. Civ. P. 34(b) and Trademark Rule 2.120(d)(2), unless the parties otherwise agree.

Proceedings herein are resumed. Dates herein are reset as follows.

Expert Disclosures Due	7/6/2015
Discovery Closes	8/5/2015
Plaintiff's Pretrial Disclosures Due	9/19/2015
Plaintiff's 30-day Trial Period Ends	11/3/2015
Defendant's Pretrial Disclosures Due	11/18/2015
Defendant's 30-day Trial Period Ends	1/2/2016
Plaintiff's Rebuttal Disclosures Due	1/17/2016
Plaintiff's 15-day Rebuttal Period Ends	2/16/2016

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. Trademark Rule 2.125. Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.