

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

Mailed: February 1, 2015

Opposition No. 91213286

Starbuzz Tobacco, Inc.

v.

SIS Resources Ltd.

**George C. Pologeorgis,
Interlocutory Attorney:**

This case now comes before the Board for consideration of (1) Opposer's combined motion (filed September 29, 2014) to compel written discovery and to extend the close of discovery by sixty days for Opposer only, and (2) Applicant's motion to extend the close of discovery by ninety days filed on September 22, 2014.¹ The Board notes that Applicant filed a timely response to Opposer's combined motion on October 14, 2014, but Opposer did not file a response to Applicant's motion to extend.

For purposes of this order, we presume the parties' familiarity with the pleadings, the history of the proceeding and the arguments and evidence submitted with respect to each party's motion.

¹ Opposer's change of correspondence address and appearance of new counsel filed on January 16, 2015 is noted. Board records have been updated accordingly.

Opposer's Motion to Compel

The Board first turns to Opposer's motion to compel. As a threshold matter, the Board will evaluate whether Opposer has satisfied its obligation under Trademark Rule 2.120(e) to make a good faith effort to resolve the discovery dispute herein prior to seeking Board intervention. Trademark Rule 2.120(e) provides in pertinent part:

[A motion to compel] must be supported by a written statement from the moving party that such party or the attorney therefore has made a good-faith effort, by conference or correspondence, to resolve with the other party or the attorney therefore the issues presented in the motion and has been unable to reach agreement.

In its motion to compel, Opposer asserts that it made a good faith effort to resolve the discovery dispute with Applicant during an alleged "discovery conference" held on September 10, 2014. Specifically, Opposer maintains that, during the conference, Opposer raised the issues of Applicant's non-responsive answers to Opposer's written discovery, but to no avail.

Shortly thereafter, on September 29, 2014, counsel for Opposer filed its motion to compel.

In response, Applicant maintains that Opposer's counsel made no effort to meet-and-confer with Applicant prior to filing its motion to compel and his claim that he did so is untrue. Applicant further contends that Opposer's counsel never initiated any discussion about discovery deficiencies in a letter or an email to counsel for Applicant, nor did he request a call for this purpose

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or set a deadline for Applicant to produce documents. To the contrary, Applicant maintains that it was its own counsel who requested the telephone conference which ultimately occurred on September 10, 2014 for the purpose of introducing Applicant's new counsel to Opposer's counsel and to discuss the parties' claims and defenses and prior settlement discussion, if any, and was not a meet-and-confer regarding Applicant's discovery responses as Opposer mischaracterizes in its motion.² Applicant further contends that, during the September 10, 2014, telephone conference, the parties did discuss the nature and basis of the parties' claims and defenses, the possibilities for settlement, as well as consenting to service of papers by email. Applicant also maintains that, during the conference call, Opposer's counsel did inquire as to the status of Applicant's document production, which Applicant's counsel said was in process and anticipated producing in the coming weeks. Applicant further maintains that the delay in producing the documents was due to the fact that Applicant is an Israeli company based in Israel, that the client contact is in Israel, and there was significant unrest in Israel around the time that Applicant was responding to Opposer's discovery requests.

Applicant also contends that, the week following the parties' September 10, 2014, telephone conference, Applicant's counsel sent emails to Opposer's counsel requesting consent to a sixty-day extension of pending deadlines. Applicant contends that Opposer's counsel responded with a request for a

² Applicant's current counsel of record made an appearance on behalf of Applicant on April 29, 2014 in this matter.

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ninety-day extension, as well as an extension of the expert disclosure deadline. Applicant, however, would not agree to extend the expert disclosure deadline by consent since Applicant believed it would be improper to do so because the deadline had already expired. Applicant maintains that after Applicant did not consent to extend the deadline for expert disclosures, Opposer's counsel indicated that he would file a motion to compel.

The Board finds that, based on the record, Opposer has not satisfied its obligation under Trademark Rule 2.120(e) to make a good faith effort to resolve the discovery dispute herein prior to seeking the Board's intervention. The Board notes that Opposer did not file a reply brief in support of its motion to compel contesting the representations made by Applicant in regard to Opposer's lack of a good faith effort to resolve the parties' alleged discovery dispute prior to filing its motion to compel. Moreover, Opposer did not submit any documentary evidence or declaration with its motion to compel which demonstrates that Opposer advised Applicant of any deficiencies in Applicant's responses to Opposer's written discovery requests and/or requesting that the parties' meet-and-confer to resolve any discovery dispute. Although Opposer was not required to wait indefinitely for further communication from Applicant following the parties' September 10, 2014, telephone conference, it was incumbent upon Opposer, prior to filing its motion to compel, to make at least one additional inquiry directed to not only ascertaining why Applicant had not yet fully responded to Opposer's

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discovery requests, but also determining any underlying circumstances that might have contributed to the non-response, and whether any problems could be resolved. Instead, based upon the record, Opposer filed its motion to compel because Applicant would not agree to extend the deadline for expert disclosures.

Opposer is reminded that the purpose of discovery is to advance the case so that it may proceed in an orderly manner within reasonable time constraints. To this end, the parties must adhere to the strictures set forth in *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666 (TTAB 1986), and repeated below:

[E]ach party and its attorney has a duty not only to make a good faith effort to satisfy the discovery needs of its opponent but also to make a good faith effort to seek only such discovery as is proper and relevant to the specific issues involved in the case. Moreover, where the parties disagree as to the propriety of certain requests for discovery, they are under an obligation to get together and attempt in good faith to resolve their differences and to present to the Board for resolution only those remaining requests for discovery, if any, upon which they have been unable, despite their best efforts, to reach an agreement. Inasmuch as the Board has neither the time nor the personnel to handle motions to compel involving substantial numbers of requests for discovery which require tedious examination, it is generally the policy of the Board to intervene in disputes concerning discovery, by determining motions to compel, only where it is clear that the parties have in fact followed the aforesaid process and have narrowed the amount of disputed requests for discovery, if any, down to a reasonable number.

Under the circumstances of this proceeding, Opposer failed to satisfy the good faith effort requirement of Trademark Rule 2.120(e) for the reasons set

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forth above. Accordingly, Opposer's motion to compel is **DENIED without prejudice**.³

In consequence of the above, the parties are directed to work together to resolve their discovery problems, in the spirit of good faith and cooperation which is required of all litigants in Board proceedings. No motion to compel should be filed unless the parties are truly unable, after making their best efforts, to work out mutually acceptable solutions to their discovery problems without the Board's assistance.

Applicant's Motion to Extend

Applicant's motion to extend the close of discovery by ninety days and to reset all subsequent dates accordingly is **GRANTED** as conceded to the extent noted below.⁴ Trademark Rule 2.127(a).

As a final matter, the stipulated protective agreement filed on October 13, 2014 is noted and its use in this proceeding is approved. *See* Trademark Rule 2.116(g). The parties are referred, as appropriate, to TBMP §§ 412.04 (Filing Confidential Materials With Board), and 412.05 (Handling of Confidential Materials by the Board).

³ Although the Board has denied Opposer's motion to compel without prejudice, it appears that Opposer's motion is apparently moot because Applicant, in response to Opposer's motion to compel, has advised that it has now responded to all of Opposer's written discovery and Opposer failed to file a reply brief in support of its motion to compel indicating that Applicant's responses were deficient in any manner.

⁴ In light of this ruling, Opposer's motion to extend the close of discovery will be given no further consideration, particularly since Opposer's request that discovery be extended only for Opposer was unsubstantiated.

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The parties are advised that only confidential or trade secret information should be filed pursuant to a stipulated protective agreement. Such an agreement may not be used as a means of circumventing Trademark Rules 2.27(d) and (e), which provide that the file of a published application or issued registration, and all proceedings relating thereto, should otherwise be available for public inspection.

Trial Schedule

Proceedings herein are resumed and trial dates, including the close of discovery, are reset as follows:

Expert Disclosures Due ⁵	3/31/2015
Discovery Closes	4/30/2015
Plaintiff's Pretrial Disclosures	6/14/2015
Plaintiff's 30-day Trial Period Ends	7/29/2015
Defendant's Pretrial Disclosures	8/13/2015
Defendant's 30-day Trial Period Ends	9/27/2015
Plaintiff's Rebuttal Disclosures	10/12/2015
Plaintiff's 15-day Rebuttal Period Ends	11/11/2015

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 2.125.

⁵ Because the Board has granted Applicant's motion to extend the close of discovery by ninety days, the Board, in its discretion, has also reset the deadline for expert disclosures even though said deadline had already expired at the time Applicant filed its motion to extend trial dates. Generally, the Board will reset the deadline for expert disclosures in tandem with the close of discovery if the close of discovery is reset far enough in the future to accommodate the thirty days between the expert disclosure deadline and the close of discovery, as is the case here.

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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.