

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

BUO

Mailed: January 27, 2015

Opposition No. 91213584

*Jaguar Land Rover Ltd.*

*v.*

*Toys Tekk*

**Benjamin U. Okeke, Interlocutory Attorney:**

Now before the Board are Opposer's motions, filed September 26, 2014, to compel Applicant to respond to Opposer's first set of interrogatories and document production requests, and to extend the discovery period for 60 days following resolution of the motion to compel.

The Board, in its discretion, suggested that the issues raised in the motions be resolved by telephone conference as permitted by TBMP § 502.06 (2014). The conference was held at 12:30 p.m. ET, on Thursday, January 22, 2015. Participating in the conference were Opposer's counsel, Jennifer Ziegler, Applicant's counsel, Shun Chen, and Board interlocutory attorney, Benjamin U. Okeke.

The Board carefully considered the arguments raised by the parties during the telephone conference, as well as the briefs on the motions and

exhibits attached thereto, and the record of this case in coming to a determination regarding the issues presented in the motions.

During the telephone conference, the Board made the following findings and determinations:

***Motion to Compel***

Initially, the Board found that Opposer made a sufficient good faith effort to resolve the parties' discovery disputes prior to seeking Board intervention. *See* Trademark Rule 2.120(e)(1). Inasmuch as Applicant's request to have consideration of the motion to compel deferred was based on Applicant's allegation that Opposer had not met its burden to make such good faith effort, the request is denied. Additionally, the Board finds that the motion has been timely made. *Id.*

The Board reminded the parties that a party may take discovery not only as to matters specifically raised in the pleadings, but also as to any matter which might serve as the basis for an additional claim, defense, or counterclaim. *See Varian Assoc. v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975) (discussing general scope of discovery); *Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 181 USPQ 286, 287 (TTAB 1974) (opposer must answer interrogatories concerning allegations in notice of opposition); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 187 (TTAB 1974) ("applicant is entitled to take discovery not only as to the matters specifically raised in the pleadings but also as to any matters which might serve as the basis for

an affirmative defense or for a counterclaim.”). While the scope of discovery is therefore somewhat broad, parties may not engage in “fishing expeditions” and must act reasonably in framing discovery requests. Fed. R. Civ. P. 26(b). *See Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1305 (TTAB 1987).

As to the specific discovery requests at issue in Opposer’s motion to compel, the Board found:

- *Interrogatory 16*

Generally, a party’s foreign activities and uses of its marks are irrelevant to the issues in a Board proceeding, and are thus, with few exceptions, not discoverable. *See Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1612-13 (TTAB 1991). Opposer has not advanced a compelling explanation for allowing the discovery of this information, or convinced the Board that this circumstance warrants an exception to the general rule. Therefore, Opposer’s motion to compel is **DENIED** with regard to its Interrogatory No. 16.

- *Discovery Requests 1-4, 10, 12-16, 21, and 26-31*

Applicant provided a practically “boilerplate” response to many of these requests. This response, with few variations, included a general objection indicating that the requests sought privileged and confidential materials, without any indication as to whether privileged materials actually exist, and if so, on what ground(s) Applicant claimed privilege. Moreover, Applicant has not provided a privilege log of the documents being withheld. *See Fed. R. Civ.*

P. 26(b)(5). Applicant's general objection also asserts that the requests were overly broad and unduly burdensome, without providing any specifics to support this contention. This practice is improper, therefore, these general objections are **OVERRULED** and will be given no further consideration. *See* Fed. R. Civ. P. 34(b)(2)(B); *See Medtronic, Inc. v. Pacesetter Sys., Inc.*, 222 USPQ 80, 83 (TTAB 1984) (party must articulate objections to interrogatories with particularity).

Moreover, for *inter partes* proceedings pending or commenced on or after August 31, 2007, the Board's standard protective order is automatically in place to govern the exchange of information. *See* Trademark Rule 2.116(g); TBMP § 412.01. Therefore, the terms of the Board's standard protective order have been, and remain, in effect since the commencement of this proceeding. *See e.g., Amazon Techs., Inc. v. Wax*, 93 USPQ2d 1702, 1706 n.6 (TTAB 2009). The very purpose of the standard protective order is to permit the exchange of confidential discovery materials without having to delay the proceeding in order for the parties to negotiate a protective order or for the Board to issue one upon a motion such as this. The standard protective order is online at: <http://www.uspto.gov/trademarks/process/appeal/guidelines/stndagmnt.jsp>.

Indeed, the Board has determined that, with the exception of Document Request No. 31, which is improper for the same reasons as Interrogatory No. 16, Opposer's discovery requests seek properly discoverable documents to which Applicant was obliged to respond within the allotted time. However,

Opposer asserts, and Applicant does not refute, that the responses remain deficient and responsive documents have yet to be served.

Accordingly, Opposer's motion to compel is **GRANTED in part**, and **DENIED in part**, to the extent that Applicant is ordered, within **TWENTY DAYS** of the mailing date of this order, to serve upon Opposer supplemental verified responses to Opposer's Document Request Nos. 1-4, 10, 12-16, 21, and 26-30,<sup>1</sup> without objection on the merits.<sup>2</sup> *See, No Fear, Inc. v. Rule*, 54 USPQ2d 1551 (TTAB 2000). Further, Applicant is ordered to copy and send all responsive documents to Opposer, at its own expense. *See Unicut Corp. v. Unicut, Inc.*, 220 USPQ 1013 (TTAB 1983); *No Fear*, 54 USPQ2d at 1556.

If, after a thorough search has been completed, no such documents are found to exist, then Applicant must so state clearly. A proper written response to a document request requires the responding party to state whether responsive documents exist or not, and if so, that either they will be

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<sup>1</sup> Applicant is reminded that its obligation to conduct a thorough search of its records and produce any responsive materials includes a search of electronically stored information. Electronically stored information may be produced in the form specified by the request. If no specification is made, Applicant must produce the electronically stored information in the form in which it is ordinarily maintained, or in a reasonably usable form. *See Fed. R. Civ. P. 34(b)(2)(E)(ii)*. Fed. R. Civ. P. 34(a) "requires that, if necessary, a responding party 'translate' information it produces into a 'reasonably usable' form." However, the option to produce in a reasonably usable form does not mean that a responding party is free to convert electronically stored information from the form in which it is maintained to a different form that makes it more difficult or burdensome for the requesting party to use the information efficiently in the litigation.

<sup>2</sup> Objections going to the merits of a discovery request include those which challenge the request as overly broad, unduly vague and ambiguous, burdensome and oppressive, as seeking non-discoverable information on expert witnesses, or as not calculated to lead to the discovery of admissible evidence. In contrast, claims that information sought by a discovery request is trade secret, business-sensitive or otherwise confidential, is subject to attorney-client or a like privilege, or comprises attorney work product, goes not to the merits of the request but to a characteristic or attribute of the responsive information. *See No Fear*, 54 USPQ2d at 1554.

produced or will be withheld on a claim of privilege. *See No Fear*, 54 USPQ2d at 1556.

However, Applicant is reminded that it may be barred from relying upon or later producing documents or information at trial, or to use any information or witnesses to supply evidence on a motion or at a hearing, where such documents, information, or witnesses were withheld from discovery.<sup>3</sup> *See* Fed. R. Civ. P. 37(c)(1); *Panda Travel, Inc. v. Resort Option Enters., Inc.*, 94 USPQ2d 1789, 1792 (TTAB 2009); *Quality Candy Shoppes/Buddy Squirrel of Wisconsin Inc. v. Grande Foods*, 90 USPQ2d 1389, 1392 (TTAB 2007); *Presto Prods. v. Nice-Pak Prods.*, 9 USPQ2d 1895, 1896 n.5 (TTAB 1988); TBMP § 527.01(e).

The parties are expected to move this case forward efficiently, and to cooperate with one another going forward to avoid unnecessary motions that tax the Board's limited resources.

The parties are encouraged to review Sections 408 and 414 of the TBMP for further guidance on discovery in Board proceedings.

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<sup>3</sup> Opposer is reminded that it must raise this matter by objecting to the evidence in question during the trial period and preserving its objection in its brief on the case. *See Panda Travel, Inc.* 94 USPQ2d at 1792-93; *General Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1593-94 (TTAB 2011); TBMP § 527.01(e).

However, if Applicant fails to comply with this order, the remedy lies in a motion for sanctions, pursuant to Trademark Rule 2.120(g)(1). Should Opposer seek to file such a motion *it must first seek leave to file the motion by contacting the assigned Board interlocutory attorney*. Failure to obtain such leave may result in the motion being given no consideration. Furthermore, Applicant is reminded that a party that has responded to a discovery request has a duty to supplement or correct that response. *See* Fed. R. Civ. P. 26(e).

***Motion to Extend***

Applicant has consented to Opposer's motion. Therefore, the Board treats this as a stipulated motion for an extension of the discovery period for 60 days, and accordingly the motion is **GRANTED**.

***Schedule***

The proceeding is **RESUMED**. Remaining discovery, disclosure, and trial dates are reset as follows:

Discovery Closes	<b>3/27/2015</b>
Plaintiff's Pretrial Disclosures	<b>5/11/2015</b>
Plaintiff's 30-day Trial Period Ends	<b>6/25/2015</b>
Defendant's Pretrial Disclosures	<b>7/10/2015</b>
Defendant's 30-day Trial Period Ends	<b>8/24/2015</b>
Plaintiff's Rebuttal Disclosures	<b>9/8/2015</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>10/8/2015</b>

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 Trademarks Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.