

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

MW

Mailed: December 22, 2015

Opposition No. 91213597

Caterpillar, Inc.

v.

Tigercat International Inc.

Marc A. Bergsman, Administrative Trademark Judge:

On November 20, 2013, Opposer, Caterpillar Inc., filed a notice of opposition opposing registration of application Serial No. 85814584 for the mark TIGERCAT (in standard characters) for “off road industrial vehicles, namely, skidders and purpose-built prime movers, carrying aerial devices, mulchers and sprayers,” in Class 12, filed by Applicant, Tigercat International Inc. As grounds for opposition, Opposer pleads priority and likelihood of confusion and dilution. Applicant, in its answer, denied the salient allegations in the petition for cancellation.

This case now comes up for consideration of the following motions:

1. Opposer’s motion (filed February 24, 2015) for leave to amend the pleading;
2. Applicant’s motion (filed April 7, 2015) for sanctions; and

3. Applicant's motion (filed June 3, 2015) for leave to take depositions by video conference.¹

The motions are fully briefed.

Motion for Leave to Amend Pleading

The Board first considers Opposer's motion for leave to amend the notice of opposition to add a claim under Trademark Act Section 18, 15 U.S.C. 1068, in the alternative, to restrict or limit the goods in the subject application. Opposer's alternative allegation seeks to limit the identification of goods in application Serial No. 85814584 to "Off road industrial vehicles, namely, skidders and purpose-built prime movers, carrying aerial devices, mulchers and sprayers, all of the foregoing used exclusively in the forestry and vegetation management fields."²

Pursuant to Fed. R. Civ. P. 15, the Board should freely grant leave to amend pleadings "when justice so requires." However, if allowance of the amendment would cause undue prejudice to the nonmoving party or be futile, amendment will be denied. *See Foman v. Davis*, 371 U.S. 178, 182 (1962); *American Optical Corp. v. American Olean Tile Co., Inc.*, 168 USPQ 471, 473 (TTAB 1971). Therefore, the Board must consider whether there is any undue prejudice to Respondent and whether the amendment is legally sufficient.

Prejudice to Applicant by the Proposed Amendment

¹ On June 16, 2015, Applicant filed a motion to quash Opposer's 30(b)(6) notice of deposition. However, on June 23, 2006, Opposer filed a response to the motion to quash withdrawing its 30(b)(6) notice of deposition. Accordingly, Applicant's motion to quash is moot.

² Underlined wording represents the wording sought to be added to the identification of goods.

The timing of a motion to amend the pleading plays a significant role in the Board's determination of whether the adverse party would be prejudiced by allowance of the proposed amendment. *See* TBMP § 507.02(a) (2015) *and cases cited therein*.

Here, Opposer states that information regarding whether Applicant's use of its mark was restricted to the fields of forestry and vegetation management was obtained during discovery. 19 TTABVUE at 6. Additionally, Opposer contends that inasmuch as "the restriction effectively narrows, rather than broadens the scope of the allegations in this proceeding" there can be no undue prejudice to Applicant. 19 TTABVUE at 6. Moreover, Applicant is free to produce evidence of its use of its mark outside the restricted fields during discovery or through testimony.

Applicant argues that Opposer has unreasonably delayed because Opposer already knew, or should have known, that Applicant does not limit its goods to the forestry industry. Applicant further contends that the record in this proceeding "will be sufficiently voluminous on Opposer's likelihood of confusion and dilution claims." 20 TTABVUE at 13.

After carefully considering the arguments raised by the parties, the Board finds that Opposer did not unduly delay in filing its motion for leave to amend the complaint. Opposer sought leave to amend to add the new claim based on information learned during discovery. *Karsten Manufacturing Corp. v. Editoy AG*, 79 USPQ2d 1783, 1786 (TTAB 2006) (motion for leave to amend pleading granted because grounds for new claim was learned during discovery). Additionally, the

discovery period is still open. Further, inasmuch as Applicant is likely to have information regarding the fields of use of its goods on hand, no further discovery on the subject should be necessary. Moreover, even if the Board were to find that Opposer delayed in filing its motion, Applicant has identified no specific prejudice in allowing the amendment. *See Prosper Business Development Corp. v. International Business Machines, Corp.*, 113 USPQ2d 1148, 1152 (TTAB 2014) (motion for leave to amend to file second amended notice of opposition granted where nonmoving party could point to no specific prejudice in allowing the amendment).

Sufficiency of the Claim

Regarding the legal sufficiency of Opposer's Section 18 claim, Applicant argues that 1) Opposer cannot establish that the proposed restriction would be commercially significant, 20 TTABVUE at 9; and 2) Opposer cannot establish that Applicant is not using its mark on its goods in the trade channels sought to be excluded by the proposed restriction. 20 TTABVUE at 9.

Opposer contends, however, that Applicant does not assert that the pleading is legally insufficient, only that Opposer will not be able to prove its claim. 24 TTABVUE at 3. Additionally, Opposer contends that the weight of the evidence supports Opposer's claim. 24 TTABVUE at 5.

On a motion for leave to amend, the Board need not determine the merits of the proposed claims, but merely satisfy itself that the plaintiff alleged sufficient facts to state a claim upon which, if proved, relief can be granted. *Polaris Industries Inc. v. D.C. Comics*, 59 USPQ2D 1798, 1799 n.4 (TTAB 2000); *Focus 21 International Inc.*

v. Pola Kasei Kogyo Kabushiki Kaisha, 22 USPQ2d 1316, 1318 (TTAB 1992); *Flatley v. Trump*, 11 USPQ2d 1284, 1286 (TTAB 1989). All of a plaintiff's well-pleaded allegations in the amended complaint must be accepted as true and the amended complaint must be construed in the light most favorable to the plaintiff. See *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038 (Fed. Cir. 1993).

In a case involving likelihood of confusion, a party seeking to establish an alternative case for restriction of an application or registration must plead (and later prove) that 1) the entry of a proposed restriction in its opponent's application or registration will avoid a finding of likelihood of confusion; and 2) the opponent is not using its mark on those goods or services that will be effectively excluded from the application or registration if the proposed restriction is entered. See *Board of Regents, University of Texas System v. Southern Illinois Miners, LLC*, 110 USPQ2d 1182, 1196-97 (TTAB 2014); *Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266, 1270 (TTAB 1995).

We note, initially, that much of Applicant's arguments merely address Applicant's contention that its products are used in a variety of industries beyond the fields in the proposed restricted identification of goods. 20 TTABVUE at 6-9. Inasmuch as these arguments relate to whether Opposer can actually prove that likelihood of confusion will be avoided with the proposed restriction, and not the legal sufficiency of the claim, the Board has not considered these arguments or the

evidence submitted in support thereof.³ See *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d at 1318.

Turning to the pleading, Opposer alleges, in paragraph 32 of the amended notice of opposition, that “Applicant is not using Applicant’s Mark for any goods other than the Restricted Goods, and entry of the proposed restriction will be helpful in avoiding a likelihood of confusion with Opposer’s CAT mark for Opposer’s Products and Services.” 19 TTABVUE at 23.

While Opposer has sufficiently alleged facts that, if proved, establish that Applicant is not using the mark in commerce on the goods sought to be restricted from the identification, Opposer’s contention that entry of the restriction “will be *helpful* in avoiding a likelihood of confusion” does not satisfy the first element of a legally sufficient claim under Section 18, namely, that likelihood of confusion “will be avoided” if the restriction is entered. See *Eurostar Inc. v. “Euro-Star” Reitmoden GmbH & Co. KG*, 34 USPQ2d at 1272.

In addition, Opposer alleges, in paragraphs 3 and 4 of the amended notice of opposition, which are incorporated into the Section 18 claim by paragraph 31, that it provides “a large number of forestry machines” and “offers a complete line of forestry equipment under the CAT name and mark that help with . . . reforestation activities.” 19 TTABVUE at 12. Moreover, Opposer’s pleaded Registration No. 4193027 includes machines, machine tools and land vehicles “for use in . . . forestry.” In view thereof, leave to amend the pleading to add the proposed

³ Applicant has submitted two declarations and several exhibits as evidence of the expanded fields of use of Applicant’s goods. 21, 22 and 23 TTABVUE.

restriction would serve no useful purpose. *See Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1785 (Fed. Cir. 1990) (motion to amend to restrict goods would serve no purpose); *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998) (“proposed restriction would not serve to avoid likelihood of confusion and must be rejected.”).

Accordingly, Opposer’s motion for leave to amend the pleading to add the Section 18 claim is **denied**.

Motion for Discovery Sanctions

Turning to Applicant’s motion for sanctions, Applicant argues that Opposer failed to comply with the Board’s February 4, 2015 discovery order compelling responses to several interrogatory requests and requests for production of documents.⁴ Applicant contends that Opposer’s supplemental responses to Applicant’s Interrogatory Nos. 9, 11, 12 and 19,⁵ and Requests for Production Nos. 24, 26, 27 and 28 do not comply with the Board’s Order. 27 TTABVUE at 3.

Applicant’s Interrogatory No. 12 requests that Opposer “identify all third party uses of ‘CAT’ as a mark or name or compound of a mark or name or domain name in connection with any goods or services identified in Opposer’s Registrations.”⁶ For Opposer’s alleged failure to comply with the Board’s order compelling response to this interrogatory, Applicant requests sanctions in the nature of an order precluding

⁴ See Board’s order compelling responses to discovery at 16 TTABVUE.

⁵ Applicant’s Interrogatory No. 19 was not subject to the motion to compel or the Board’s order compelling discovery. Additionally, Applicant has not addressed it in its brief. Therefore, Interrogatory No. 19 is not subject to Applicant’s motion for sanctions.

⁶ In the Board’s order compelling discovery responses, the Board limited this request to exclude domain names. 16 TTABVUE at 5.

Opposer from denying that there are third party users of the term “CAT” for goods and services identified in Opposer’s pleaded registrations.

The remaining interrogatories and requests for production, collectively, seek “market research and consumer studies done by or on behalf of Opposer or any third party related to Opposer’s Marks, documents referring or relating to purchaser recognition of Opposer’s Marks, market research and consumer studies done by or for Opposer or by any third party related to the fame or recognition or awareness of Opposer’s Marks, and documents referring or relating to consumer recognition of Opposer’s Marks.”⁷ 25 TTABVUE at 6; 8 TTABVUE at 13, 47-8. As sanctions for Opposer’s alleged failure to adequately respond to these discovery requests, Applicant requests that Opposer be precluded from relying on any evidence related to the Interrogatory Nos. 9 and 11 and Requests for Production Nos. 24, 26, 27 and 28. 25 TTABVUE at 9. In addition, Applicant requests an adverse inference against Opposer related to the market research and consumer studies.⁸

If a party fails to comply with an order of the Board relating to discovery, including an order compelling discovery, the Board may order appropriate sanctions as defined in Trademark Rule 2.120(g)(1) and Fed. R. Civ. P. 37(b)(2). The sanctions which may be entered by the Board include, *inter alia*, refusing to allow the disobedient party to support or oppose designated claims or defenses and

⁷ In the Board’s order compelling discovery, the Board limited the temporal scope of the requests to the previous five years. 16 TTABVUE at 4, 10.

⁸ Applicant requests an inference that “Opposer has no market research conducted prior to the filing of the application for registration herein opposed that establishes: 1) that the asserted marks of Opposer are famous among the general public in the United States; and 2) that the term ‘CAT’ as used by Opposer is associated with anything other than “CATERPILLAR” in the relevant markets.” 25 TTABVUE at 9-10.

prohibiting the disobedient party from introducing designated matters into evidence. *M.C.I. Foods Inc. v. Bunte*, 86 USPQ2d 1044, 1048 (TTAB 2008) (sanctioned party prohibited from relying on documents it produced only after sanctions entered); *HighBeam Marketing LLC v. HighBeam Research LLC*, 85 USPQ2d 1902, 1905 (TTAB 2008) (opposer may not rely at trial on discovery materials disclosed only after entry of sanctions against it).

Interrogatory No. 12

In its second supplemental response to Interrogatory No. 12, Opposer referenced third-party applications and registrations incorporating “CAT” and produced two charts containing “all trademark applications containing ‘cat’ that have been filed in the last four years.” In addition, Opposer produced its most recent trademark “dilution searches” referencing all pending applications and current or former registrations containing “cat.” Opposer also provided a list of third parties who use marks or names similar to Opposer’s marks but did not file trademark applications for the mark or name. 31 TTABVUE at 6-7; 28 TTABVUE at 35-6. Opposer states that the list includes “all third parties” that it is aware of that use similar marks. 31 TTABVUE at 18.

Applicant complains that the supplemental response and documents produced by Opposer are unresponsive to Interrogatory No. 12 because they do not specifically identify marks having “CAT” as a component that have been in use for the goods and/or services set forth in Opposer’s registrations. Inasmuch as the

existence of a trademark application does not establish that the mark is in use, Applicant argues, the search reports are inadequate to identify third party use.

The Board finds that Opposer's response to Interrogatory No. 12 is sufficient and not a basis for discovery sanctions. While Opposer's provision of information regarding all trademark applications containing the term "CAT," including applications for goods and services outside the scope of the goods and services in its pleaded registrations, was clearly unnecessary and beyond the scope of the request, Applicant has not been prejudiced by Opposer's submission of additional unresponsive materials. Indeed, Applicant stated that "Tigercat is prepared to ignore the unresponsive documents." 36 TTABVUE at 5. Additionally, we do not agree with Applicant that Opposer has intentionally limited its response to Interrogatory No. 12 in any way. Opposer states that "to the best of its knowledge, Caterpillar has identified all third-party uses of a mark or name containing 'cat' known to it." 31 TTABVUE at 18.

In view thereof, Applicant's motion for sanctions related to Interrogatory No. 12 seeking an order precluding Opposer from denying the existence of third-party users of the term "CAT" for goods and services identified in the its pleaded registrations in **denied**.

Interrogatory Nos 9 and 11 and Request for Production Nos. 24, 26, 27 and 28

With respect to Applicant's interrogatories and requests for production seeking market research and consumer studies, Applicant states that "Opposer has produced only two scripts for a limited category of surveys, namely, purchaser

satisfaction surveys of purchasers of Opposer's goods" which, Applicant contends, are not responsive to Applicant's requests for "market research directed to recognition of the asserted marks and the alleged fame of the asserted marks." Applicant further argues that Opposer's five additional documents relating to product use and initial purchase surveys for Opposer's customer loyalty program produced in its April 3, 2015 supplemental production are also not responsive to Applicant's requests. Applicant claims that it has been prejudiced by Opposer's failure to comply with the Board's order regarding these requests because its experts have not had the opportunity to consider material which may bear on the subject of their expert disclosures. 36 TTABVUE at 8.

In response, Opposer states that it conducts a variety of market research and consumer studies related to its brands and the products sold under its marks and, to date, it has produced all representative documents falling within Applicant's requests. 31 TTABVUE at 8. In addition, Opposer states that it has supplemented its responses to Interrogatory Nos. 9 and 11 "to reflect the specific request to which each of these production documents are responsive." 31 TTABVUE at 19. Opposer contends that its survey documents are market research and consumer studies which comply with its discovery obligations and that it "knows of no additional representative documents responsive to these document requests." 31 TTABVUE at 24. Opposer further states that "[n]either Caterpillar nor its counsel has conducted a survey specifically measuring the fame of the CAT mark in the United States in the last five years." 31 TTABVUE at 28.

The Board finds that Opposer has provided documents and information responsive to Applicant's requests and has denied knowledge of any additional responsive documents. Applicant's dissatisfaction with Opposer's production is not a valid basis for discovery sanctions.

Accordingly, Applicant's motion for sanctions related to Interrogatory Nos. 9 and 11 and Requests for Production Nos. 24, 26, 27 and 28 is **denied**. In the event that Opposer's evidence at trial exceeds scope of the information providing during discovery, Opposer may be precluded from using that information at trial. *See Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239, 1242, 1246 (TTAB 2012) (party that fails to provide information via disclosure or discovery or supplements may be precluded from using that information or witness at trial unless failure was substantially justified or harmless); *Panda Travel, Inc. v. Resort Option Enterprises, Inc.*, 94 USPQ2d 1789, 1792-93 (TTAB 2009) (documents not produced until after the start of trial stricken); TBMP § 527.01 (2015).

Motion for Leave to Take Depositions by Video Conference

Applicant seeks leave from the Board to take and attend the discovery depositions of Kurt Tisdale, Ed Stembridge, Diane Lantz-Rickard, by video conference. According to Opposer, the individuals are to be produced for deposition in Peoria, Illinois. Applicant also seeks leave to take and attend the following depositions of Opposer's expert witnesses by video conference: Roy Chipley of Florence, South Carolina; Dave Foster, of Henniker, New Hampshire; and Terry Moren, of Longview, Texas. Applicant states that allowing it to take and attend the

depositions by video conference would minimize the burden and cost of travelling to four different states. 40 TTABVUE at 2.

Opposer contends that remote depositions are inappropriate in this case “given the breadth of issues and potentially large volume of documents involved in these depositions” and that the process “has the potential to be extremely cumbersome for the witnesses.” 46 TTABVUE at 3.

Rule 30(b)(4) of the Federal Rules of Civil Procedure provides that “[t]he parties may stipulate — or the court may on motion order — that a deposition be taken by telephone or other remote means.” *See also Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1654 (TTAB 2007) (noting that parties may resolve conflict concerning the scheduling of deposition where travel for one party is involved by conducting deposition by telephone or other electronic means). “[F]ederal practice favors the use of technological benefits in order to promote flexibility, simplification procedure and reduction of cost to parties.” *Hewlett-Packard Co. v. Healthcare Personnel Inc.*, 21 USPQ2d 1552, 1553 (TTAB 1991); *see also, Brown v. Carr*, 253 F.R.D. 410, 412 (S.D. Tex. 2008) (“Generally, leave to take depositions by remote electronic means should be granted liberally.”).

Here, Opposer has not pointed to any undue prejudice to Opposer that would result from deposing the parties by video conference. Potential inconvenience for the witnesses is insufficient to establish good cause to deny provision for deposition by video conference. *See Brown v. Carr*, 253 F.R.D. at 412.

Accordingly, Applicant's motion for leave to take and attend the noticed discovery depositions by video conference is **granted**. The Board expects the parties to cooperate in arranging the technical details of the depositions, including premarking and providing documents to the defending party that the deposing party intends to use at the depositions. This is not the time for game playing. Additionally, Applicant's counsel may utilize whatever real-time, electronic transcription services may be available from the court reporter. If real-time, electronic transcription is utilized the additional cost for such services will be borne by Applicant.

Proceedings are resumed

Discovery and trial dates are reset as follows.

Expert Disclosures Due	12/23/2015
Discovery Closes	1/22/2016
Plaintiff's Pretrial Disclosures	3/7/2016
Plaintiff's 30-day Trial Period Ends	4/21/2016
Defendant's Pretrial Disclosures	5/6/2016
Defendant's 30-day Trial Period Ends	6/20/2016
Plaintiff's Rebuttal Disclosures	7/5/2016
Plaintiff's 15-day Rebuttal Period Ends	8/4/2016

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.