

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: September 22, 2015

Opposition No. 91217273

Monster Energy Company

v.

Three Notch'd Brewing Company, LLC

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

This case now comes before the Board for consideration of Opposer's motion to compel filed on May 18, 2015. Applicant filed timely response on June 8, 2015.¹

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 Opposer's motion to compel.

Opposer's Motion to Compel

The Board finds that Opposer has made a good faith effort to resolve the parties' discovery dispute prior to seeking Board intervention and that Opposer's motion is timely. *See* Trademark Rule 2.120(e)(1).

¹ Under Trademark Rule 2.127, Applicant's response was due on June 7, 2015. However, since June 7th fell on a Sunday, Applicant was allowed until the next business day, i.e., June 8, 2015, in which to file its response. *See* Trademark Rule 2.196.

As to the merits of Opposer's motion to compel responses to the interrogatory and document requests at issue, the motion is **GRANTED** to the extent noted below:

Interrogatory Requests

Interrogatory No. 10

Motion is **GRANTED** to the extent that Applicant must state its net and gross sales (in units and dollars) and net and gross profits, **on a yearly basis**, for each variety of Applicant's beer sold under its involved mark since the date of first sale of each variety of beer.

Interrogatory No. 13

Motion is **GRANTED** to the extent that Applicant must identify, on an annual basis, the dollar amount Applicant spent on advertising Applicant's beer under its involved mark.

Document Requests

Document Request No. 1

Motion is **GRANTED** to the extent that Applicant must produce non-privileged documents concerning the origin, conception, derivation, selection and/or adoption of Applicant's Mark, including, but not limited to, how Applicant created, conceived, selected, cleared and acquired Applicant's Mark, in the United States. The motion is **DENIED** to the extent that the request seeks documents on how Applicant created, conceived, selected and acquired its mark **outside** of the United States.

Document Request Nos. 4 and 5

Motion is **GRANTED** to the extent that Applicant must produce non-privileged documents responsive to the above-identified requests.

Document Request No. 8

Motion is **GRANTED** to the extent that Applicant must produce non-privileged documents responsive to the above-identified request. While the Board recognizes that a party need not provide discovery with respect to those of its marks and goods and/or services that are not involved in the proceeding and have no relevance thereto, *see* TBMP § 414(11) (2015), the Board finds that Applicant's use or intent to use other marks that include the portion of Applicant's mark constituting three thick lines to the left of the literal wording of Applicant's involved mark on different products than those identified in its application does have relevance to the issues in this case, particularly if Applicant uses or intends to use the aforementioned portion of its involved mark on goods identical to or highly similar to Opposer's pleaded goods.

Document Request No. 20

Motion is **GRANTED** to the extent that Applicant must produce non-privileged marketing and business plans relating to Applicant's beer sold under its involved marks.

Document Request No. 21

Motion is **GRANTED** to the extent that Applicant must produce non-privileged documents concerning Applicant's efforts and/or intent to expand use of Applicant's

involved mark on different product lines or geographic areas in the United States. While a party need not provide discovery with respect to those of its marks and goods and/or services that are not involved in the proceeding and have no relevance thereto, *see* TBMP § 414(11) (2015), information that a party sells the same goods or services as the propounding party, even if under a different mark, is relevant to the issue of likelihood of confusion for purposes of establishing the relationship between the goods or services of the parties. *Id.*

Document Request No. 22

Motion is **GRANTED** to the extent that Applicant must produce non-privileged documents sufficient to show, on a yearly basis, Applicant's total net and gross profits for Applicant's beer sold under Applicant's involved mark in the United States.

Document Request No. 23

Motion is **GRANTED** to the extent that Applicant must produce non-privileged documents sufficient to show, on a yearly basis, Applicant's total net and gross sales (both in units and dollars) for Applicant's beer sold under Applicant's involved mark by geographic area in the United States.

Document Request No. 24

Motion is **GRANTED** to the extent that Applicant must produce non-privileged documents which constitute sales summaries or sales reports for Applicant's beer sold under its involved mark in the United States.

Document Request No. 25

Motion is **GRANTED** to the extent that Applicant must produce non-privileged documents sufficient to show the prices charged for Applicant's beer sold under its involved mark, including, but not limited to, price lists for the beer sold under its involved mark in the United States.

Document Request No. 26

Motion is **GRANTED** to the extent that Applicant must produce non-privileged documents referring or relating to any and all advertising agencies, public relations agencies, marketing firms, market research agencies or other person(s) which Applicant has used, participated with or cooperated with in advertising, marketing or promoting Applicant's beer under its involved mark in the United States.

Summary

In view of the foregoing, Opposer's motion to compel written discovery is **GRANTED** to the extent noted herein.

Applicant is allowed until **thirty (30) days** from the mailing date of this order in which to provide (1) responses to Opposer's Interrogatory Request Nos. **10 and 13**, to the extent indicated herein, and (2) its verification of the interrogatory responses compelled by this order, if it already has not done so. *See* Fed. R. Civ. P. 33(b)(5) and TBMP § 405.04(c).

Applicant is also allowed until **thirty (30) days** from the mailing date of this order to copy and to produce non-privileged documents responsive to Opposer's

Document Request Nos. **1, 4-5, 8, and 20-26**, to the extent set forth by this order.² Applicant must organize and label, by bates stamp number, the documents responsive to each of the above-identified document requests.

If there are no responsive, non-privileged documents in Applicant's possession, custody or control which are responsive to any of the above-identified document requests, Applicant must so state affirmatively in its response to the corresponding document request.

To the extent Applicant has already **fully** produced documents responsive to any of the above-identified document requests, Applicant must so state in its response to the particular document request and **identify, by bates number, the documents which are responsive to each request.**

Additionally, Applicant is required to provide Opposer a privilege log within the same **thirty (30) days** provided above to the extent that Applicant claims privilege to **any** of Opposer's written discovery requests, if it has not already done so.³

In the event Applicant fails to provide Opposer with full and complete responses to the outstanding discovery, as required by this order, Applicant will be barred

² To the extent the production of documents to any of the document requests identified above is voluminous in nature, Applicant may produce a representative sampling of documents responsive to the corresponding document request. Such representative sampling, however, must be sufficient to meet Opposer's discovery needs.

³ The Board expects the parties (and their attorneys) to cooperate with one another in the discovery process and looks with extreme disfavor on those who do not. TBMP § 408 (2015). Each party and its attorney have a duty to make a good faith effort to satisfy the discovery needs of its adversary. *Id.*

from relying upon or later producing documents or facts at trial withheld from such discovery.⁴ *See* Fed. R. Civ. P. 37(c)(1).

Trial Schedule

Proceedings are hereby **RESUMED**. Discovery remains ongoing. Remaining trial dates are reset as follows:

Discovery Closes	11/6/2015
Plaintiff's Pretrial Disclosures Due	12/21/2015
Plaintiff's 30-day Trial Period Ends	2/4/2016
Defendant's Pretrial Disclosures Due	2/19/2016
Defendant's 30-day Trial Period Ends	4/4/2016
Plaintiff's Rebuttal Disclosures Due	4/19/2016
Plaintiff's 15-day Rebuttal Period Ends	5/19/2016

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

⁴ If Applicant fails to comply with this order, Opposer's remedy lies in a motion for sanctions, pursuant to Trademark Rule 2.120(g)(1). Furthermore, the parties are 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).