

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Baxley

Mailed: August 29, 2015

Opposition No. 91217589

Rhythm Holding Limited

v.

J & N Sales, LLC

Andrew P. Baxley, Interlocutory Attorney:

After Opposer, on March 27, 2015, served discovery responses, including a general objection to Applicant's first set of interrogatories on based on an excessive number of interrogatories (*see* Trademark Rule 2.120(d)), Applicant, on May 5, 2015, filed a motion to compel discovery, wherein it sought substantive responses to those interrogatories and amended responses to some of its document requests. In response, Opposer indicated that it served responses to Applicant's interrogatories and otherwise stood by its objections to Applicant's document requests. Applicant, in its reply brief, newly asserts that certain of Opposer's interrogatory responses are insufficient.

In view of Opposer's service of responses to Applicant's first set of interrogatories, the motion to compel is moot with regard to those interrogatories.

To the extent that Applicant, in its reply brief, newly alleges that certain of Opposer's interrogatory responses are insufficient, Applicant did not indicate that it made a good faith effort to resolve the parties' dispute with regard to those

responses prior to seeking Board intervention, as required by Trademark Rule 2.120(e)(1). Further, the alleged insufficiency of certain interrogatory responses is a new basis for seeking to compel discovery that should not have been raised in a reply brief because Opposer is precluded by Trademark Rule 2.127(a) from responding thereto in a surreply brief. Rather, any allegations with regard to those responses should have been raised in a new motion to compel after making the required good faith effort to resolve the parties' dispute with regard thereto.

Turning to the motion to compel with regard to Applicant's document requests, the Board finds that Applicant failed to make a sufficient good faith effort to resolve the parties' discovery dispute prior to seeking Board intervention. In particular, Applicant sent a single letter to Opposer's attorney to address the alleged deficiencies in Opposer's responses to those requests, and Opposer responded to that letter with a single e-mail. *See* Trademark Rule 2.120(e)(1); TBMP § 523 (2015). The Board expects parties to adhere to the requirements of *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986), prior to seeking Board intervention, i.e.,

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.

Further, Opposer has not cited to any authority to support its assertion that the document requests at issue seek information that is properly discoverable in this case. *See* TBMP § 414 and cases cited therein regarding the discoverability of

various types of information in Board proceedings. In addition, Applicant has made no showing that, where it requests “[a]ll documents” regarding a particular subject, production of all documents is necessary to meet its discovery needs.

The scope of discovery in Board proceedings is generally narrower than in civil proceedings. *See* TBMP § 402.01. Each party has a duty to seek only such discovery as is proper and relevant to the issues in the case. *See* TBMP § 408.01. Based on the foregoing, Applicant’s motion to compel is denied without prejudice with regard to Applicant’s document requests.¹

In the interest of resolving the parties’ discovery dispute, the Board notes the following. In the notice of opposition, Opposer alleges that Applicant’s mark RHYTHM IN BLUES is likely to cause of confusion with its previously used and registered mark RHYTHM for overlapping clothing items in International Class 25 under Trademark Act Section 2(d), 15 U.S.C. § 1052(d).² Applicant, in its answer, denied the salient allegations of the notice of opposition and asserted no affirmative defenses.

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See*

¹ In any further motion to compel in this proceeding, the movant must cite to authority to support its contention that the information sought through each discovery request at issue in that motion is properly discoverable in a Board proceeding.

² Although Opposer pleads prior use and registration of the mark RHYTHM LIVIN’ for clothing items as part of its alleged standing, the likelihood of confusion claim as set forth in paragraph 6 of the notice of opposition is based on the RHYTHM mark only. Unless tried by consent of the parties, Opposer may be precluded at trial from relying upon other marks in support of that claim. *See Fossil Inc. v. Fossil Group*, 49 USPQ2d 1451, 1454-55 (TTAB 1998).

Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). Because some of the goods are legally identical, the degree of similarity of the marks necessary to find likelihood of confusion need not be as great as where there are recognizable differences between the goods. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

If Opposer's pleaded registrations are properly of record,³ standing and priority will likely not be issues in this case, and likelihood of confusion will be decided based on the identifications of goods in the registrations and application at issue. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). The Board must presume that Applicant's goods encompass all goods of the type identified, and that they are or will be sold in all normal channels of trade and to all of the usual customers for such goods. *See Octocom Sys. Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). If Opposer's pleaded

³ Opposer included status and title copies of its pleaded registrations that were obtained online from the USPTO's Trademark Status and Document Retrieval (TSDR) database as exhibits to the notice of opposition. *See* Trademark Rule 2.122(d)(1). However, those copies do not include the date of publication or the date on which they were accessed and printed and therefore may not be properly of record. *See Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010). The publication or access dates are necessary to making the registrations of record because the issuance date of status and title copies filed with a complaint must be reasonably contemporaneous with the filing date of the complaint. *See Hard Rock Café Int'l (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1511 (TTAB 2000) (status and title copies prepared three years prior to opposition not reasonably contemporaneous); *Royal Hawaiian Perfumes, Ltd. v. Diamond Head Products of Hawaii, Inc.*, 204 USPQ 144, 146 (TTAB 1979) (status and title copy of registration prepared two months prior to filing of opposition is reasonably contemporaneous); TBMP § 704.03(b)(1)(A).

registrations are of record, the Board must make the same presumptions with regard to Opposer's pleaded goods. In view of the foregoing, this case will likely turn on the similarity or dissimilarity of the parties' marks in their entireties, the strength of Opposer's pleaded marks, and the extent of third-party use of similar marks on related goods, and the parties' discovery needs would appear to be limited.

Proceedings herein are resumed. Remaining dates are reset as follows.

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| Discovery Closes | 9/28/2015 |
| Plaintiff's Pretrial Disclosures Due | 11/12/2015 |
| Plaintiff's 30-day Trial Period Ends | 12/27/2015 |
| Defendant's Pretrial Disclosures Due | 1/11/2016 |
| Defendant's 30-day Trial Period Ends | 2/25/2016 |
| Plaintiff's Rebuttal Disclosures Due | 3/11/2016 |
| Plaintiff's 15-day Rebuttal Period Ends | 4/10/2016 |

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. If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.