



Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
www.uspto.gov

Rhythm Holding Company

v.

J & N Sales, LLC

Opposition No. 91217589
On Petition to the Director
Filed: September 28, 2015

Decision

On September 28, 2015, J & N Sales, LLC (“Petitioner”) petitioned the Director of the United States Patent and Trademark Office (“Director”) to reverse an interlocutory order issued by the Trademark Trial and Appeal Board (“TTAB” or “Board”). The Director has the authority to review Petitioner’s request.¹ *See* 37 C.F.R. §§ 2.146(a)(3) and (e)(2). The petition is denied.

FACTS²

Rhythm Holding Company (“Opposer”) filed a notice of opposition against U.S. Application Serial No. 86050581 on July 23, 2014. In the Notice of Opposition, Opposer alleged priority of use and likelihood of confusion, relying on pleaded

¹ Authority to decide any trademark petitions to the Director under 37 C.F.R. § 2.146 was delegated to the Commissioner for Trademarks. Subsequently, authority to decide petitions to the Director under 37 C.F.R. §§ 2.146(e)(1) and (e)(2), involving review of the granting or denial of an extension of time to file a notice of opposition, review of interlocutory orders and petitions involving requests to waive the Rules of Practice in Trademark cases relating to TTAB cases was delegated to the Chief Administrative Trademark Judge. Under such delegation, the authority to decide this petition was further delegated.

² This decision recites only the facts relevant to the issue on petition.

registrations for the mark RHYTHM³ and further referencing its registered mark RHYTHM LIVIN⁴ under Trademark Act § 2(d); 15 U.S.C. § 1052(d).

On August 29, 2015, the TTAB issued an interlocutory order (“Order”) denying Petitioner’s motion to compel responses to interrogatories and document requests. As background, Opposer, on March 17, 2015, served a general objection to Petitioner’s first set of interrogatories (numbered as twenty-one) on the basis that they exceeded the limit. Opposer subsequently withdrew its objection and, with its response to Petitioner’s motion to compel, served responses and objections to Petitioner’s interrogatory requests. In its reply brief, Petitioner, with respect to the interrogatory responses served May 22, 2015, argued that responses to certain requests were insufficient. The TTAB determined that the motion to compel was moot with respect to interrogatories. The TTAB explained that, because the newly articulated deficiencies to certain responses were brought up by Petitioner in its reply, the parties did not have an opportunity to engage in a good faith effort to resolve the dispute; and, further, Opposer did not have an opportunity to respond to Petitioner’s arguments as it is prohibited under Board practice from filing a sur-reply. The TTAB indicated a new motion to compel should be filed if the parties did not resolve the perceived dispute.

With respect to Petitioner’s requests for production, the TTAB, in denying Petitioner’s motion without prejudice, found that Petitioner failed to make a sufficient good faith effort to resolve the dispute, specifically referencing a single letter sent by Petitioner to Opposer and a single responsive email sent from Opposer to Petitioner. The TTAB also directed Petitioner to TBMP § 414, which provides discovery guidelines, stating that Petitioner did not provide references supporting its position that the information sought is discoverable or that “all documents,” where requested, were necessary to meet its discovery needs.

On September 28, 2015, Petitioner filed a request for reconsideration of the August 29 order with the TTAB and this petition to the Director. On December 4, 2015, the TTAB denied Petitioner’s request for reconsideration (“Recon”) and suspended proceedings pending disposition of this instant petition.

Petitioner asserts that the TTAB committed clear error in finding its motion to compel moot with respect to the interrogatories and in finding that Petitioner did not make a good faith effort to resolve the dispute with respect to the production requests. More specifically, Petitioner contends that it is only required to file one motion to compel interrogatories regardless of the objection posed. Petitioner contends that, based on the content of the single communication to Opposer and

³ U.S. Registration Nos. 3610417 and 3884199,

⁴ U.S. Registration No. 3890579. In its August 29, 2015 order (fn. 2), the TTAB informed Opposer that paragraph No. 6 of the notice of opposition asserted that the likelihood of confusion claim was based solely on the pleaded RHYTHM marks.

Opposer's response indicating a "rigid stance that it will stand by its objections," it made a sufficient good faith effort to resolve the production dispute; that it was wrongly criticized for not referencing the discovery guidelines in TBMP § 414, which are simply exemplary, not exhaustive; and that the TTAB let Opposer's improper objections stand.

DISCUSSION

Standard of Review

The Director may exercise supervisory authority in appropriate circumstances. 35 U.S.C. § 2; 37 C.F.R. § 2.146(a)(3); TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1707. In an inter partes proceeding before the Board, a party may petition the Director to review an order or decision of the Board that concerns a matter of procedure and does not put an end to the litigation before the Board. TTAB MANUAL OF PROCEDURE (TBMP) §§ 901.02(a), 905; TMEP §1704. However, the Director will reverse an interlocutory order issued by the Board in an inter partes proceeding only upon a showing of clear error or abuse of discretion. *Kimberly Clark Corp. v. Paper Converting Industry, Inc.*, 21 USPQ2d 1875, 1877 (Comm'r Pats. 1991); *Paolo's Associates Ltd. Partnership v. Bodo*, 21 USPQ2d 1899, 1902 (Comm'r Pats. 1991); *Jonergin Co. Inc. v. Jonergin Vermont Inc.*, 222 USPQ 337 (Comm'r Pats. 1983); *Riko Enterprises, Inc. v. Lindsley*, 198 USPQ 480 (Comm'r Pats. 1977). For the reasons set forth below, the circumstances presented in this case do not demonstrate that the Board committed clear error or abused its discretion.

The TTAB Did Not Commit Clear Error or Abuse Its Discretion

1. Petitioner's interrogatory requests

Trademark Rule 2.120(d)(1), 37 C.F.R. § 2.120(d)(1) provides in relevant part as follows:

If a party upon which interrogatories have been served believes that the number of interrogatories exceeds the limitation specified in this paragraph, and is not willing to waive this basis for objection, *the party shall, within the time for (and instead of) serving answers and specific objections to the interrogatories, serve a general objection on the ground of their excessive number.* (Emphasis added.)

Trademark Rule 2.120(e)(1), 37 C.F.R. § 2.120(e)(1) provides in relevant part as follows

A motion to compel discovery shall include a copy of ... the interrogatory with any answer or objection that was made.

Trademark Rule 2.127(a), 37 C.F.R. § 2.127(a) provides for the filing of a brief on a motion, a brief in response to a motion, a reply brief, and otherwise provides in relevant part as follows:

The Board will consider no further papers in support of or in opposition to a motion.

There is no prohibition in TTAB practice against bringing more than one motion to compel interrogatories.

As the TTAB stated in its Order and Recon, the arguments directed to the perceived insufficiencies to the answers and objections are new (i.e., not based on the general objection that the number of interrogatories was purportedly excessive, which was resolved by Opposer's withdrawal of the objection); the alleged insufficiencies raised in the reply brief formed a new basis for seeking to compel discovery, to which Opposer could not respond, requiring a new motion to compel in order to permit a response from Opposer; and the parties had not discussed the alleged deficiencies and, thus, had not yet engaged in a good faith effort to resolve the new dispute pursuant to Trademark Rule 2.120(e)(1), 37 C.F.R. § 2.120(e)(1).

The TTAB did not abuse its discretion or commit clear error in denying as moot Petitioner's motion to compel interrogatories.

2. Petitioner's production requests

Trademark Rule 2.120(e)(1), 37 C.F.R. § 2.120(e)(1), provides in relevant part as follows:

A motion to compel ... discovery must be supported by a written statement from the moving party that such party or the attorney therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion but the parties were unable to resolve their differences.

The Board may consider, among other things, whether the moving party has investigated the possibility of resolving the dispute, whether, depending on the circumstances, sufficient effort was made towards resolution, and whether attempts at resolution were incomplete. *See Hot Tamale Mama...and More, LLC v. SF Investments, Inc.*, 110 USPQ2d 1080, 1081 (TTAB 2014).

Recognizing that Petitioner sent a letter to Opposer's attorney concerning the alleged deficiencies in the responses to Petitioner's production requests, and that Opposer responded with a single email, the TTAB found the single exchange to be

inadequate in establishing that good faith effort was made to resolve the dispute. In its Recon, the TTAB describes other steps it expected should have been undertaken in attempting to resolve the dispute. The TTAB did not abuse its discretion or commit clear error in finding that a good faith effort to resolve the production dispute had not been established.

TBMP § 414 provides discovery guidelines, providing examples and references addressing the discoverability of various matters. The section states that the list is not exhaustive. Noting that Petitioner had not cited authority to support that the production it sought was properly discoverable, the TTAB directed Petitioner to TBMP § 414, further requiring Petitioner to cite to authority in any future motion to compel. The TTAB has the inherent power to schedule disposition of cases on its dockets. *Opticians Association of America v. Independent Opticians of America Inc.*, 734 F. Supp. 1171, 14 USPQ2d 2021, 2029 (D.N.J. 1990); *Carrini Inc. v. Carla Carini S.R.L.*, 57 USPQ2d 1067, 1071-72 (TTAB 2000). In this case, the requirement assists the TTAB in making a determination on any motion to compel, particularly where, as here, the producing party indicates it produced more than 4000 documents. The requirement is not recognized as criticism of Petitioner and is not recognized as limiting the discovery that is permitted in TTAB cases.

As to Petitioner's argument that the TTAB "lets stand opposer's objections," the TTAB denied without prejudice the motion to compel production for lack of a good faith effort to resolve the dispute. A determination was not made on the objections and Petitioner is not precluded from seeking to compel production in the future, should an effort made in good faith not resolve the dispute.

The TTAB did not abuse its discretion or commit clear error in denying without prejudice Petitioner's motion to compel production.

DECISION

The petition is denied. This case will be forwarded to the assigned interlocutory attorney for resumption of proceedings.

/Cheryl Butler/

Cheryl Butler
Senior Counsel
Trademark Trial and Appeal Board

Date: December 30, 2015

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