

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

Baxley

Mailed: April 15, 2016

Opposition No. 91217589

Rhythm Holding Limited

v.

J & N Sales, LLC

Andrew P. Baxley, Interlocutory Attorney:

This case now comes up for consideration of: (1) Applicant's second motion (filed January 8, 2016) to compel discovery; and (2) Opposer's combined motion (filed January 29, 2016) to compel discovery and to test the sufficiency of responses to requests for admissions.¹ The motions have been fully briefed.

As an initial matter, Applicant essentially contends in its brief in response to Opposer's combined motion that, because the Board, in its January 12, 2016 suspension order, indicated that any submission filed during the pendency of Applicant's motion to compel that was not relevant to Applicant's motion would receive no consideration the Board, the Board erred in its February 5, 2016 order by allowing briefing of Opposer's combined motion wherein. 36 TTABVUE 3-4. However, not considering Opposer's combined motion likely would have resulted in

¹ Opposer's motion is captioned as a motion to compel discovery. However, a motion to compel procedure is unavailable in connection with requests for admission. *See* TMBP § 523.01. Accordingly, to the extent that Opposer's motion alleges deficiencies in Applicant's responses to requests for admissions, that motion will be treated as a motion to test the sufficiency of responses to requests for admission. *See* Trademark Rule 2.120(h); TBMP § 524.

a refiling of that combined motion shortly after a decision on Applicant's motion; any such refiling would have led to another suspension that would have further delayed this proceeding. *See* Trademark Rules 2.120(e)(2) and 2.120(h)(2). Accordingly, the Board, being mindful of its inherent authority to control the scheduling and conduct of cases on its docket, is not persuaded that allowing both parties' discovery motions to be briefed while proceedings were suspended was improper.

Case background

A review of this case is warranted under the circumstances herein. Applicant has applied to register the mark RHYTHM IN BLUES in standard characters for "Coats; Denim jackets; Denims; Gloves; Hats; Head wear; Hooded sweatshirts; Jackets; Jeans; Knit tops; Mittens; Pants; Rain wear; Scarves; Shirts; Shorts; Sweat shirts; Sweaters; T-shirts; Woven tops" in International Class 25. Opposer filed a notice of opposition to registration of Applicant's mark on the ground of likelihood of confusion with its previously used and registered mark RHYTHM in standard characters for "backpacks and day packs[;] ... clothing, namely, shirts, t-shirts, shorts; headgear, namely hats, caps"² and "Clothing, namely, footwear, casual footwear, sandals; bathing suits and trunks, beachwear, swimwear, beach and bathing coverups, Bermuda shorts, pants, polo shirts, slacks, sweatshirts, tank tops,

² Registration No. 3610417, issued April 21, 2009, Section 8 affidavit accepted, Section 15 affidavit acknowledged.

tops, trousers, knit shirts, caps; sleepwear, namely, undershirts.”³ Applicant, in its answer, denied the salient allegations of the notice of opposition.

In this proceeding, Opposer submitted copies of its pleaded registrations obtained from a USPTO electronic database which show current status and title thereof as of the filing date of the notice of opposition with its notice of opposition.⁴ In view of such submission, standing is most likely established, and priority is highly unlikely to be an issue. *See* Trademark Act Section 2(d); Trademark Rule 2.122(d)(1); *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).

In deciding likelihood of confusion cases, the Board considers the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), for which there is evidence in the record.⁵ Two factors that are crucial in

³ Registration No. 3884199, issued November 30, 2010, Section 8 affidavit accepted, Section 15 affidavit acknowledged.

⁴ The registration copies that Opposer submitted with the notice of opposition indicate that they were obtained from the USPTO’s Trademark Status and Document Retrieval (TSDR) database on July 18, 2014, five days prior to the filing of the notice of opposition. *See Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010); *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) (2015).

After the filing of the notice of opposition, Opposer filed Section 8 and 15 affidavits in both pleaded registrations. *See* Trademark Rule 2.122(d). In accordance with Board policy, the Board has ascertained the current status of the registrations. *See North Face Apparel Corp. v. Sanyang Indus. Co.*, 116 USPQ2d 1217, 1224 n.14 (TTAB 2015).

⁵ The *du Pont* factors are the following:

(1) The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.

resolving Section 2(d) claims are the degree of similarity of the parties' marks and the degree of similarity of their respective goods and/or services at issue. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). The Board must find likelihood of confusion as to the entire class if it finds likelihood of confusion with respect to any item within the identification of goods or services in a particular class.⁶ *See Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

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- (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
 - (3) The similarity or dissimilarity of established, likely-to-continue trade channels.
 - (4) The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.
 - (5) The fame of the prior mark (sales, advertising, length of use).
 - (6) The number and nature of similar marks in use on similar goods.
 - (7) The nature and extent of any actual confusion.
 - (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
 - (9) The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).
 - (10) The market interface between applicant and the owner of a prior mark:
 - (a) a mere "consent" to register or use.
 - (b) agreement provisions designed to preclude confusion, i.e. limitations on continued use of the marks by each party.
 - (c) assignment of mark, application, registration and good will of the related business.
 - (d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.
 - (11) The extent to which applicant has a right to exclude others from use of its mark on its goods.
 - (12) The extent of potential confusion, i.e., whether de minimis or substantial.
 - (13) Any other established fact probative of the effect of use.

In re E. I. du Pont de Nemours & Co., 177 USPQ at 567.

⁶ The Section 2(d) claim in this case is between Opposer and Applicant and not between Opposer and any unrelated third party. Accordingly, Opposer need not be the exclusive user of the mark RHYTHM or be the prior user with respect to the whole world; Opposer need

Because Opposer is relying on registrations in support of its Section 2(d) claim, any analysis of the degree of similarity of the goods at issue must be based on the goods identified in Applicant's involved application and Opposer's pleaded registrations and not on what the parties' goods are asserted, or actually shown, to be. *See, e.g., Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1814-15 (Fed. Cir. 1987). "When marks would appear on virtually identical goods or services, the degree of similarity [of those marks] necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

The involved application and pleaded registrations contain at least the following identical goods: hats, shirts, shorts, and T-shirts. Because the goods in the application and registrations at issue overlap, the Board "must presume that the scope of the goods encompasses all of the goods of the nature and type described, that they would travel in all channels of trade normal for those goods and to all classes of prospective purchasers for those goods." *Dan Foam ApS v. Sleep Innovations Inc.*, 106 USPQ2d 1939, 1945 (TTAB 2013). *See also Fram Trak Industries Inc. v. WireTracks LLC*, 77 USPQ2d 2000, 2006 (TTAB 2006).

Fed. R. Civ. P. 26(b) defines the scope of discovery, "[u]nless otherwise limited," as including "nonprivileged matter that is relevant to any party's claim or defense

only be the prior registrant and/or user as to Applicant. *See BAF Industries v. Pro-Specialties, Inc.*, 206 USPQ 166, 174 (TTAB 1980).

and **proportional to the needs of the case...**” (emphasis added). The Board has applied the principle of proportionality to define the proper subjects of and expanse of inquiry in *inter partes* proceedings under various circumstances. *Cf. Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1268 (TTAB 2015) (proportionality principle applied to interrogatories, document requests and requests for admission); *Phillies v. Philadelphia Consol. Holding Corp.*, 107 USPQ2d 2149, 2153 (TTAB 2013) (proportionality discussed with respect to requests for admissions). “[P]arties may not engage in ‘fishing expeditions’ and must act reasonably in framing discovery requests.” TBMP § 402.01. “[B]ecause the parties’ goods are identical in part, the disposition of this case will likely turn on the similarity of the marks and the scope of protection to be accorded each of the involved marks.” *Dan Foam ApS*, 106 USPQ2d at 1945. The parties should focus their discovery accordingly.

Neither party made a good faith effort to resolve discovery disputes

Regarding Applicant’s second motion to compel, Applicant filed its first motion to compel on May 5, 2015. In an August 29, 2015 order, the Board determined that the first motion was moot with regard to Opposer’s interrogatory responses and denied that motion without prejudice with regard to Opposer’s responses to document requests. On September 28, 2015, Applicant filed a request for reconsideration of that order with the Board and a petition to the Director in connection with that order. Opposer served a first revised set of responses to Applicant’s interrogatories on October 30, 2015 and a second set of revised responses on December 9, 2015.

After Applicant's request for reconsideration of the Board's August 29, 2015 order was denied in a December 4, 2015 order and Applicant's petition to the Director in connection with that order was denied in a December 30, 2015 decision, the Board resumed proceedings in a January 2, 2016 order. On January 7, 2016, Applicant's attorney sent a letter to Opposer's attorney, wherein it alleged deficiencies in and filed the second motion to compel the next day. Under the circumstances herein, the Board finds that Applicant failed to make a good faith effort to resolve the parties' discovery dispute prior to seeking Board intervention. By filing the second motion to compel on the day after Applicant's deficiency letter, Applicant failed to allow a meaningful opportunity to cure the defects in the second revised interrogatory responses alleged in that letter prior to seeking Board intervention. While the Board understands Applicant's concern over the running of dates, a motion to extend time to allow the parties to engage in an effort to settle the discovery dispute would have been proper. *See Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986).

Likewise, following the resumption of proceedings, Opposer's attorney sent a deficiency letter to Applicant's attorney on January 14, 2016 to which Applicant's attorney responded on January 25 and 27, 2016, and filed its motion to compel on January 29, 2016. In view of Opposer's rush to file its motion to compel in the absence of any follow-up conference, the Board finds that Opposer also failed to make a good faith effort to resolve the parties' discovery dispute prior to seeking Board intervention. *See id.* The Board further notes that, in its August 29, 2015

order, the Board stated that “[i]n 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.” August 29, 2015 order at 3 n.1. The only cited authority in Opposer’s brief and reply brief in support of its motion are two general references to Federal Rule of Civil Procedure 36 in the initial brief. Nonetheless, in the interest of avoid further discovery motions in this case, the Board, in its discretion, will review both parties’ motions.⁷

Applicant’s motion to compel granted in part

Regarding the discovery requests at issue in Applicant’s motion, Applicant asks, with regard to Applicant’s interrogatories no. 1, 2 and 4, that Opposer be required to “complete its answers [thereto] by identifying and producing documents concerning its due diligence and other deliberation, consideration and investigation in acquiring its marks and registrations asserted in this proceeding, as well as related documents of its predecessors in its possession, custody or control.”⁸

⁷ The Board will not entertain any further discovery motions from the parties without obtaining prior leave from the Board in a telephone conference between the parties’ attorneys and the Board attorney assigned to this case.

⁸ In interrogatory no. 1, Applicant asks Opposer to “[i]dentify each person who participated in the consideration, deliberation, selection, adoption and/or approval by Opposer [of] a word or phrase comprising the word ‘rhythm’ as a trademark for the marketing and sale of wearing apparel, and identify each document concerning such participation and the nature and extent thereof.”

In interrogatory no. 2, Applicant asks Opposer to “[i]dentify each document concerning consideration by Opposer of the use or registration of any phrase comprising the word ‘rhythm’ as a trademark for wearing apparel.”

In interrogatory no. 4, Applicant asks Opposer to “[i]dentify each person who participated in, reviewed, directed, solicited or was aware of any search or opinion concerning Opposer’s use or registration of a trademark comprising the word ‘rhythm’ in connection with the

However, Applicant did not expressly request such information in those interrogatories and will not be heard to use its motion to compel as a means of amending those interrogatories to so request. In addition, Opposer's responses to these interrogatories that it does not have any responsive documents is acceptable. *See Washington v. Garrett*, 10 F.3d 1421, 1437-38 (9th Cir. 1993) (responding party need not create documents solely to satisfy propounding party's discovery requests).

In the notice of opposition, Opposer alleged that, "for several years and since long prior to any date of first use upon which Applicant rely, has adopted and continuously used the term 'RHYTHM' ... as a trademark for clothing." 1 TTABVue 2, paragraph 1. A party generally may take discovery with regard to matters raised in its adversary's pleadings. *See Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 181 USPQ 286, 287 (TTAB 1974) (opposer must answer interrogatories concerning allegations in notice of opposition). However, because Opposer has already made its registrations of record and there is no pending counterclaim, standing will likely be established and priority is unlikely to be an issue in this case. *See Cunningham, supra; King Candy Co., supra; Vital Pharmaceuticals Inc. v. Kronholm*, 99 USPQ2d 1708, 1712 (TTAB 2011). Accordingly, requiring Opposer to identify and produce such documents is disproportionate to the needs of this case. *See Fed. R. Civ. P.*

marketing and sale of wearing apparel, and identify each document concerning such search or opinion."

26(b)(1). Based on the foregoing, Opposer need not respond further to these interrogatories.⁹

In interrogatory no. 7, Applicant essentially seeks the identity of documents concerning the trade channels and classes of consumers of Opposer's goods. Such documents are generally discoverable in Board proceedings. *See, e.g., J.B. Williams Co. v. Pepsodent GmbH*, 188 USPQ 577, 580 (TTAB 1975). However, because the goods in the application and registrations at issue in this proceeding overlap, the Board is required to presume that the trade channels and classes of consumers of those goods also overlap. *See Octocom Systems Inc.*, 16 USPQ2d at 1787; *Canadian Imperial Bank of Commerce, N.A.*, 1 USPQ2d at 1814-15; *Dan Foam ApS*, 106 USPQ2d at 1945; *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). Accordingly, requiring Opposer to identify such documents is disproportionate to the needs of this case. *See Fed. R. Civ. P. 26(b)(1)*. Based on the foregoing, Opposer need not respond further to this interrogatory.¹⁰

In responding to interrogatory nos. 12, 14, 15 and 19 and document requests nos. 1, 3, 11, and 14, Applicant contends that Opposer omitted information and documents concerning "communications between [O]pposer and third parties concerning objections to use or registration of marks comprising RHYTHM, including objections, cease and desist letters, lawsuits, trademark opposition or

⁹ However, if Opposer does not produce such documents, it may be, upon timely objection from Applicant, precluded from relying upon them at trial. *See Fed. R. Civ. P. 37(c)(1); TBMP § 527.01(e)*.

¹⁰ *See* footnote 9.

cancellation proceedings threatened or commenced, settlement negotiations and agreements, co-existence agreements, and related correspondence.” 28 TTABVUE 6. Information concerning litigation and controversies including settlement and other contractual agreements between a responding party and third parties based on the responding party’s involved mark is generally discoverable. *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB1988) (licensing agreements and arrangements between opposer and third parties and amount of sales thereto are relevant); *American Society of Oral Surgeons v. American College of Oral & Maxillofacial Surgeons*, 201 USPQ 531, 533 (TTAB 1979) (relevant to show admissions against interest, limitations on rights in mark, course of conduct leading to abandonment, that the mark has been carefully policed, etc.); *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193, 197 (TTAB 1976) (settlement agreements that have avoided litigation may show limitations on party’s rights in mark or reveal inconsistent statements); TBMP § 414(10). In this case, such information and documents are relevant to the scope of protection to be accorded Opposer’s pleaded mark RHYTHM. *See Dan Foam ApS*, 106 USPQ2d at 1945. In addition, information concerning a party’s awareness of third-party use and/or registration of the same or similar marks for the same or closely related goods or services as an involved mark, is discoverable to the extent that the responding party has actual knowledge thereof (without performing an investigation) and that the information appears to be reasonably calculated to lead to the discovery of admissible evidence. *See American Society of Oral Surgeons v.*

American College of Oral & Maxillofacial Surgeons, 201 USPQ531, 533 (TTAB 1979) (awareness of third-party use and/or registration relevant to show mark is weak); TBMP § 414(9). However, the only information which must be provided with respect to any legal proceeding is the names of the parties thereto, the jurisdiction, the proceeding number, the outcome of the proceeding, and the citation of the decision (if published). See *Interbank Card Association v. United States National Bank of Oregon*, 197 USPQ 127, 128 (TTAB1975) (need not reveal reasons for dismissal of prior opposition against third party) and *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 172 (TTAB 1975) (need not identify all documents pertaining to such litigation). In addition, Opposer need only provide information and documents sufficient to show the third-party use of marks similar to its pleaded mark for clothing of which it is aware, the third parties to whom it sent cease and desist letters in which it alleged confusing similarity to its pleaded RHYTHM mark, and the resolution of any conflicts arising from such letters. See TBMP § 402.02. Opposer is directed to supplement its responses to these discovery requests in accordance with the foregoing.

Based on the foregoing, Applicant's second motion to compel is granted with regard to interrogatory nos. 12, 14, 15 and 19 and document requests nos. 1, 3, 11, and 14 to the extent set forth above and denied with regard to interrogatory nos. 1, 2, 4, and 7. Opposer is allowed until **thirty days** from the mailing date set forth in this order to serve amended responses to interrogatory nos. 12, 14, 15 and 19 and

document requests nos. 1, 3, 11, and 14 and to serve copies of documents responsive to t document requests nos. 1, 3, 11, and 14 in accordance with the foregoing.

Opposer's motion to test the sufficiency of responses to requests for admissions denied

Turning to Opposer's motion to test the sufficiency of responses to requests for admission, a party may serve on its adversary written requests to admit, for purposes of the pending action only, relevant facts, the application of law to fact, or opinions about either; and the genuineness of any described documents. *See* Fed. R. Civ. P. 36(a)(1). Requests for admission are useful for determining which facts are not in dispute prior to trial, thereby narrowing the matters that must be tried. *See* TBMP § 407.02. Requests for admission may also facilitate the introduction into evidence of documents produced by an adversary in response to a request for document production. *See id.*

A party responding to a request for admission must admit or deny the request or explain in detail why it cannot so admit or deny. *See* Fed. R. Civ. P. 36(a)(4); TBMP § 407.03(b). Any grounds for objection to a request must also be stated. *See* Fed. R. Civ. P. 36(a)(5). An admission in response to a request for admission “conclusively establishe[s]” the matter that is subject of that request. Fed. R. Civ. P. 36(b). “However, a denial in response to a request for admission is merely a refusal to stipulate to certain matter.” *Sinclair Oil Corp. v. Kendrick*, 85 USPQ2d 1032, 1036 n.8 (TTAB 2007). A responding party is not required to stipulate to any fact. *Nat'l Semiconductor Corp. v. Ramtron Int'l Corp.*, 265 F.Supp.2d 71, 74 (D.D.C. 2003).

A motion to test the sufficiency of responses to admission requests is solely a test of the legal sufficiency of those responses. *See* Fed R. Civ. P. 36(a); Trademark Rule 2.120(h); TBMP § 524. Disagreements regarding the veracity of such responses are matters to be determined at trial and are not properly raised by way of a motion to test their sufficiency. *See Nat'l Semiconductor Corp.*, 265 F.Supp.2d at 74.

All of the responses at issue in Opposer's motion to test the sufficiency end with the words "and denies the matter." As such, each of the responses at issue is an unqualified denial and is therefore legally sufficient. *See* Fed. R. Civ. P. 36(a)(3). The objections set forth in these responses are essentially beside the point. Based on the foregoing, Opposer's motion to test the sufficiency of Applicant's responses to requests for admission is denied.

Opposer's motion to compel granted in part

Turning to the discovery requests at issue in Opposer's motion to compel, in Opposer's interrogatory no. 19 and document request no. 36, Opposer seeks information and documents that support each of Applicant's sixty-three denials of Opposer's requests for admission. Opposer's first set of interrogatories consists of eighteen numbered interrogatories.¹¹ Applicant has objected to Opposer's second set of interrogatories, which consisted solely of interrogatory no. 19 on the ground that, through such interrogatory, Opposer has exceeded the numerical limit of seventy-five interrogatories, including subparts, under Trademark Rule 2.120(d)(1).

¹¹ The parties should not infer that the numerical count of Opposer's first set of interrogatories is eighteen for purposes of determining whether that set exceeds the numerical limit under Trademark Rule 2.120(d)(1).

In counting interrogatories, the Board is not bound by the propounding party's numbering system. Rather, the Board looks to the substance of the interrogatories and counts each question as a separate interrogatory. *See* TBMP § 405.03(d). If an interrogatory requests information concerning more than one issue, such as information concerning both "sales and advertising figures," or both "adoption and use," the Board will count each issue on which information is sought as a separate interrogatory. *See id.* In interrogatory no. 19, Opposer requests information concerning sixty-three separate issues, i.e., each of Applicant's denials of its requests for admission. When considered in combination with Opposer's first set of interrogatories, the Board finds that Opposer has exceeded the numerical limit of seventy-five interrogatories, including subparts. Applicant's general objection to Opposer's second set of interrogatories based on excessive number is therefore sustained.

Through interrogatory no. 19 and document request no. 36, Opposer is essentially asking Applicant to reveal its evidence in advance of trial. Applicant is not required, in advance of trial, to disclose documents it plans to introduce in support of any such denials. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007); TBMP § 414(7). Applicant need only, as part of its pretrial disclosures, provide a general summary or list of documents that may be introduced during the testimony of its witness(es). *See* Trademark Rule 2.121(e); TBMP §§ 414(7) and 702. Moreover, bearing in mind that Applicant has denied sixty-three of Opposer's sixty-six requests for admission,

the Board finds that these discovery requests are unduly burdensome. Applicant need not respond further thereto.

Likewise, in document request nos. 37 and 38, Opposer seeks documents from Applicant “supporting or substantiating any contention” regarding the alleged strength or weakness of Opposer’s mark. The Board notes initially that it is incumbent upon Opposer, as the plaintiff, to establish that its pleaded mark is strong. Although the requested documents are relevant to the scope of protection to which Opposer’s pleaded mark is entitled (see *Dan Foam ApS*, 106 USPQ2d at 1945), the requests are worded in a manner that essentially asks Applicant to reveal its evidence in advance of trial. See *Miscellaneous Changes to Trademark Trial and Appeal Board Rules*, 72 Fed. Reg. at 42246 (August 1, 2007); TBMP § 414(7). Applicant need not respond further to these document requests.

Turning to the remaining document requests in Opposer’s motion, Applicant, in responses to document request nos. 10, 11, 16, 21, and 25 through 30 dated December 31, 2014, stated that it “will produce” non-privileged, responsive documents; however, Opposer contends that Applicant has yet to produce documents responsive to these requests.¹² To the extent that Applicant has not done so already, Applicant is allowed until **thirty days** from the mailing date set forth in this order to serve copies of documents responsive to document request nos. 10, 11, 16, 21, and 25 through 30.

¹² Opposer filed its combined motion prior to the commencement of trial. See Trademark Rule 2.120(e)(1); TBMP § 523.03. Accordingly, Applicant’s assertion that Opposer unduly delayed in alleging deficiencies in its document production is unpersuasive.

In document request no. 23, Opposer seeks documents regarding “authorization, license, franchise, assignment, or grant” from Applicant to another entity regarding use of Applicant’s involved mark. Applicant’s response that “a more complete response is subject to further search and investigation” is unacceptable. *See* TBMP § 408.02 (a responding party has a duty to thoroughly search its records in preparing discovery responses). In responding to a document request, a party must state whether or not there are responsive documents and, if so, that they will be produced or that they are being withheld based on an objection or claim of privilege. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000); *id.* Applicant is allowed until **thirty days** from the mailing date set forth in this order to serve an amended response to document request no. 23 and to serve copies of documents responsive to that document request.

In sum and in accordance with the foregoing, Opposer’s motion to test the sufficiency of responses to requests for admissions is denied, and Opposer’s motion to compel is granted with regard to document request nos. 10, 11, 16, 21, 23, 25 through 30, and denied with regard to interrogatory no. 19 and document request nos. 36 through 38.

Proceedings resumed

Proceedings herein are resumed. Under the circumstances, the Board finds that it is appropriate to extend the discovery period briefly to allow the parties time in which to resolve their discovery disputes. Remaining dates are reset as follows.

Expert Disclosures Due
Discovery Closes

4/30/2016
5/30/2016

Plaintiff's Pretrial Disclosures Due	7/14/2016
Plaintiff's 30-day Trial Period Ends	8/28/2016
Defendant's Pretrial Disclosures Due	9/12/2016
Defendant's 30-day Trial Period Ends	10/27/2016
Plaintiff's Rebuttal Disclosures Due	11/11/2016
Plaintiff's 15-day Rebuttal Period Ends	12/11/2016

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.