

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: November 10, 2015

Opposition No. 91219077

Tristar Products, Inc.

v.

Telebrands Corp.

**Robert H. Coggins,  
Interlocutory Attorney:**

Now before the Board is Opposer's motion (filed September 24, 2015) to compel discovery. Applicant has filed a brief in opposition thereto.

Motion to Compel

The motion to compel seeks supplemental responses from Applicant to various interrogatories and document requests, and either a "suitable" (proposed) protective order from Applicant or a production of documents under the Board's standard protective order.

Trademark Rule 2.120(e)(1) requires that a motion to compel discovery 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 has been unable to resolve those issues.

*See Hot Tamale Mama...and More, LLC v. SF Invs., Inc.*, 110 USPQ2d 1080 (TTAB 2014). *See also* TBMP § 523.02 (2015). The Board expects that the statement will be supported by a recitation of the communications conducted, including dates, a summary of any telephone conversations, and copies of any correspondence exchanged, where applicable. *Hot Tamale*, 110 USPQ2d at 1081.

In support of its good faith effort, Opposer states that it sent to Applicant a letter dated August 6, 2015, and that it received a responsive email from Applicant on August 21, 2015. Opposer attached the August 6th letter to the motion to compel as Exhibit C (15 TTABVUE 43-45), and the August 21st email as Exhibit D (15 TTABVUE 46-48). A review of the August 6th letter reveals that Opposer made a wholesale statement to Applicant that Opposer found Applicant's discovery "responses to be inadequate," but that Opposer would "accommodate [Applicant's] objection that certain information as confidential" by agreeing to enter into a stipulated protective order. 15 TTABVUE 44. A review of the August 21st response reveals that Applicant made a similarly wholesale statement that it "disagrees that its discovery responses were inadequate," and that it, too, is agreeable to the entry of a stipulated protective. Applicant then asked Opposer to "[p]lease send us a draft at your earliest convenience."

The Board reminds the parties that the Board's standard protective order is automatically in place and governs the exchange of information unless the

parties, by stipulation approved by the Board, agree to an alternative order, or a motion by a party to use an alternative order is granted by the Board. *See* Trademark Rule 2.116(g). *See also* TBMP § 412.01. It is not necessary for the parties to sign copies of the Board's standard protective order for it to take effect.

The present record does not demonstrate that the parties had reached the point of "an unresolvable situation" prior to the filing of the motion to compel. *Hot Tamale*, 110 USPQ2d at 1082. Specifically, as to the issue of the protective order, the parties were both in agreement that they would consider a presumably modified, alternative protective order. Instead of responding in any way to Applicant's request for a draft protective order, Opposer simply filed the motion to compel. The motion to compel is, therefore, premature, and is denied without prejudice for lack of a good faith effort. Had the parties worked together to develop an alternative protective order, some of the issues in the motion to compel related to Applicant's objections as to confidentiality and privilege may have been resolved. Inasmuch as the Board will not carve out from the motion to compel only issues that may be ripe (*cf. O.C. Seacrets Inc. v. Hotelplan Italia S.p.A.*, 95 USPQ2d 1327, 1329 (TTAB 2010) (Board will not parse a pleading to see if any of the elements that go to one ground would independently state a separate ground); and *Ballet Tech Found. Inc. v. Joyce Theater Found. Inc.*, 89 USPQ2d 1262 (TTAB 2008) (Board not inclined to parse depositions to separate admissible from inadmissible testimony)),

and the motion to compel seeks, at least in part, relief that is premature, the denial without prejudice is made of the motion *in toto*.

Notwithstanding the denial of the motion, the Board directs the parties to TBMP § 414 for selected discovery guidelines which will help the parties as they continue their good faith effort to resolve the issues raised in Opposer's motion to compel. For example, § 414(4) recognizes that "[i]nformation concerning a party's selection and adoption of its involved mark is generally discoverable (particularly of a defendant)"; this may help Applicant in formulating a prospective supplemental answer to Interrogatory No. 1. Similarly, § 414(1) recognizes that "[t]he identification of discovery documents (as opposed to their substance) is not privileged or confidential" while § 414(6) recognizes that "[s]earch reports are discoverable, but the comments or opinions of attorneys relating thereto are privileged and not discoverable (unless the privilege is waived)"; these sections may help Applicant in formulating a prospective supplemental answer to Interrogatory No. 2, and Opposer in understanding at least some of Applicant's objections thereto. The parties should review each guideline and apply it to the discovery requests (and answers thereto) at issue.<sup>1</sup>

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<sup>1</sup> This is not an order compelling supplemental responses. The information is educational for the parties so they may resolve their discovery dispute without the need for another motion to compel. The Board expects parties (and their attorneys or other authorized representatives) to cooperate with one another in the discovery process and looks with extreme disfavor on those who do not. *See* TBMP § 408.01.

In addition, Applicant is reminded that a party that responds to a request for discovery by indicating that it does not have the information sought, or by stating objections thereto, may be barred by its own action from later introducing the information sought in the request as part of its evidence on the case, provided that the propounding party raises the matter by objecting to the evidence in question on that ground, and preserves the objection in its brief on the case (it is not necessary that the objecting party file a motion asking for application of this sanction). *See* TBMP § 527.01(e). Similarly, a party that fails to provide information, or provides an untimely supplement, may be precluded from using that information or witness at trial.

Applicant is also reminded that, although Fed. R. Civ. P. 26(b)(5) does not specify exactly how a party asserting privilege/protection must particularize its claim, the most common way is by using a privilege log, which identifies each document withheld, information regarding the nature of the privilege/protection claimed, the name of the person making/receiving the communication, the date and place of the communication, and the document's general subject matter. In view thereof, to the extent that Applicant has withheld information or documents based on privilege, Applicant should consider producing a privilege log.<sup>2</sup>

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<sup>2</sup> Again, this is not an order compelling a privilege log. As stated earlier, this is merely information for the parties to consider in working toward a resolution of their discovery dispute without the need for Board intervention.

Schedule

Proceedings are resumed. Dates are reset on the following schedule.

<u>Expert Disclosures Due</u>	<u>1/11/2016</u>
<u>Discovery Closes</u>	<u>2/10/2016</u>
<u>Plaintiff's Pretrial Disclosures</u>	<u>3/26/2016</u>
<u>Plaintiff's 30-day Trial Period Ends</u>	<u>5/10/2016</u>
<u>Defendant's Pretrial Disclosures</u>	<u>5/25/2016</u>
<u>Defendant's 30-day Trial Period Ends</u>	<u>7/9/2016</u>
<u>Plaintiff's Rebuttal Disclosures</u>	<u>7/24/2016</u>
<u>Plaintiff's 15-day Rebuttal Period Ends</u>	<u>8/23/2016</u>

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.