

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: March 31, 2016

Opposition No. 91220166

*Flowers Vineyard and Winery, LLC*

v.

*The Wine Group, LLC*

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

Now before the Board is Applicant's motion (filed December 31, 2015) to compel discovery responses. The motion is fully briefed.

Motion to Compel

Applicant seeks an order compelling Opposer to (1) provide sales and promotional information responsive to Interrogatory Nos. 1 and 2, and Document Request Nos. 1, 16, and 22; (2) specify which documents are responsive to which document request and to provide an unqualified statement of the existence or non-existence of responsive documents; (3) produce all "witness statements" responsive to Document Request No. 35; and (4) produce documents concerning the declaration of Jay M. Behmke which was submitted in support of Opposer's earlier Section 7 request to

correct a mistake in the legal name of the owner of Opposer's pleaded registration, responsive to Document Request No. 2.

For purposes of this order, the Board presume the parties' familiarity with the pleadings, the history of the proceeding, and the arguments and evidence submitted with respect to the motion to compel. Therefore, for the sake of efficiency the Board does not summarize the parties' arguments raised in the respective briefs or evidence submitted therewith.

*Good faith effort*

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); TBMP § 523.02. Based on the motion, briefs, and exhibits thereto, the Board finds under the specific circumstances of this case that Applicant made the requisite good faith effort as to the four issues raised in the motion to compel prior to filing that motion.<sup>1</sup> In reaching this determination, the Board has resolved any doubt in favor of Applicant in an effort to consider the matters efficiently without the need for a prospective second motion to compel the same matters.

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<sup>1</sup> Trademark Rule 2.120(e)(1) also requires, in relevant part, that the movant include with its motion to compel a copy of the requests for production at issue. Applicant has also complied with this provision.

*Sales and promotional information*

Inasmuch as Opposer pleaded ownership of a registration, annual sales and advertising amounts (in round numbers) for the goods under the registered mark are relevant and proportional. Opposer must provide the requested information for each year since (and including) the year in which the application underlying the registration was filed (i.e., 1999). Opposer's argument that it can establish priority through evidence of common law use of its mark fails to recognize that Opposer may also establish priority by way of its registration, which registration may be subject to any permissible attack. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 182 USPQ 108 (CCPA 1974); Trademark Rule 2.122(d)(2). By pleading ownership of a registration, Opposer has opened to discovery issues relevant to the registration.<sup>2</sup>

The motion to compel is **granted** as to Interrogatory Nos. 1 and 2, and Document Request Nos. 1 and 22, but only as to annual sales and promotional expenses from 1999 to present. The motion is **denied** to the extent Applicant seeks information prior to 1999 (i.e., between the date of first use of the mark and the date of filing).

The motion to compel is similarly **granted** as to Document Request No. 16. To the extent that Opposer believes a request would be burdensome to complete, Opposer may offer a representative sample, with an explanation why the total number of responsive documents would be burdensome to produce.

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<sup>2</sup> Opposer's pleaded registration is not currently in evidence. *See United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1041 (TTAB 2014); TBMP § 317. Exhibit A to the Notice of Opposition fails to meet the requirements of Trademark Rule 2.122(d)(1).

*Specification and unqualified statement*

In responding to document requests, a party should indicate whether or not it has in its possession, custody and control responsive documents and, if so, that inspection and related activities will be permitted as requested, unless the request is objected to, in which case the reasons for objection must be stated (but an objection must state whether any responsive materials are being withheld on the basis of that objection). *See* Fed. R. Civ. P. 34(b)(2)(B) and (C); *No Fear Inc. v. Rule*, 54 USPQ2d 1551 (TTAB 2000); TBMP §§ 406.04(c) and 408.02. This means that a proper written response to each of Applicant's document requests requires Opposer to include a statement that there are responsive documents or that no responsive documents exist. In view thereof, the motion to compel is **granted** to the extent that Opposer must state for each request whether there are responsive documents or whether there are no responsive documents.

In responding to document requests, a party must produce responsive discovery documents as they are kept in the usual course of business or must organize and label them to correspond with the categories in each document request. *See* Fed. R. Civ. P. 34(b)(2)(E)(i); TBMP § 406.04(c). Opposer claims that it produced documents as they are kept in the ordinary course of business, and that it produced only 345 pages.

Opposer was obliged only to make documents and materials available for inspection and copying, where the documents are stored, and as they are kept in the ordinary course of business (or to organize and label them to correspond to the requests). Opposer extended to Applicant the courtesy of producing requested

documents by copying the documents and forwarding them to Applicant at Opposer's own expense. The Board encourages this method of production and believes it is more efficient than meeting only the minimum requirement of having Applicant itself inspect and copy the documents where they are stored. It appears that Applicant overlooked Opposer's courtesy and efficiency. Similarly, Applicant has requested documents spanning at least eighteen years, and Opposer produced 345 pages; that is not a large a number of pages covering such a span of time – or even over a six-year period which appears to be the effective span of time for the documents already produced. Inasmuch as Opposer produced documents as they are kept in the usual course of business, and delivered them to Applicant at Opposer's own expense, the motion is **denied** to the extent it seeks to require Opposer to organize and label the documents.

*Witness statements*

The motion is **denied** as to Document Request No. 35. Opposer's objections are sustained.

*Documents concerning the declaration of Jay M. Behmke*

The motion is **granted** as to Document Request No. 2 to the extent that Opposer's privilege objections are overruled as to any documents Opposer may have in its possession, custody, or control relating to Mr. Behmke's statements that the "client told [him] about the change of name in early February 2009" (para. 5), that Mr. Behmke was aware the "client's corporate counsel had formed a California entity with that name" (para. 5), and that "[i]t has ... come to [his] attention that [he] made

several errors when [he] prepared the assignment document in February 2009” (para. 6). The motion is **denied** as to Document Request No. 35 to the extent of any communication not associated with the three identified statements.

Opposer may not assert that certain factors caused it to file a Section 7 request and then invoke the attorney-client privilege to prevent an interested party from examining the situation further. Applicant is correct to note that “[t]he privilege which protects attorney-client communications may not be used both as a sword and a shield.” *Chevron Corp. v. Pennzoil Co.*, 974 F.2d 1156, 1162 (9th Cir. 1992) (citing *United States v. Bilzerian*, 926 F.2d 1285, 1292 (2d Cir. 1991)).

*Time to comply*

Opposer is allowed until **thirty days** from the mailing date of this order in which to provide the compelled, supplemental discovery ordered herein.

Schedule

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

Expert Disclosures Due	5/21/2016
Discovery Closes	6/20/2016
Plaintiff’s Pretrial Disclosures	8/4/2016
Plaintiff’s 30-day Trial Period Ends	9/18/2016
Defendant’s Pretrial Disclosures	10/3/2016
Defendant’s 30-day Trial Period Ends	11/17/2016
Plaintiff’s Rebuttal Disclosures	12/2/2016
Plaintiff’s 15-day Rebuttal Period Ends	1/1/2017

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

Opposition No. 91220166

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.