

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: August 1, 2016

Opposition No. 91220573

*Miss Universe L.P., LLLP and  
IMG Universe, LLC,*

*v.*

*Linda Grandia*

**Geoffrey M. McNutt, Interlocutory Attorney:**

This case comes before the Board for consideration of Opposer's March, 21, 2016, motion to join IMG Universe, LLC, as a party-opposer and April 5, 2016, motion to compel discovery. Both motions have been fully briefed.<sup>1</sup>

**Opposer's Motion to Join a Party**

Opposer moves to join IMG Universe, LLC, as a party-opposer in this proceeding. As the basis for its motion, Opposer indicates that after the commencement of this proceeding, Opposer assigned its pleaded Registration Nos. 620557 and 1597876 to IMG Universe, LLC, by an assignment document dated September 10, 2015, and recorded with the Assignment Recordation Branch of the USPTO on October 28, 2015

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<sup>1</sup> As discussed *infra*, at n.9, Applicant's motion for a sixty-day extension of all dates, which was embedded in Applicant's response to Opposer's motion to join a party, is moot in view of this order. Accordingly, Applicant's motion and Opposer's response in opposition thereto have been given no consideration.

at Reel/Frame 5654/0923. With its motion, Applicant has submitted a copy of the assignment. *See* 26 TTABVUE 6–15. Applicant, in her response to Opposer’s motion, “does not dispute Plaintiffs Motion to Join Parties under ... TBMP 512” *See* 28 TTABVUE 2.

When a registered mark pleaded by a plaintiff is assigned after commencement of the proceeding, and a copy of the assignment is filed with the Board, it is generally the policy of the Board to join the assignee in situations where the discovery and testimony periods have not closed and the assignor is still in existence. *See* TBMP § 512.01 (2016). Accordingly, Opposer’s motion to join IMG Universe, LLC, as a party-opposer is granted as unopposed and for good cause. The caption of this proceeding has been updated to reflect the joinder.

**Opposer’s Motion to Compel**

Opposer has moved the Board to compel Applicant to more fully respond to Opposer’s Interrogatory Nos. 4–8, 15–16, 19–22, 25, 27–29, 35, 37 – 38, and 40, and to produce documents responsive to Opposer’s Document Request Nos. 1–19, 21–35, and 38.

Ordinarily, the sheer number of discovery requests in dispute would indicate that the parties had not fulfilled their obligation to meet and confer in good faith in an effort to resolve, or at least narrow, the matters in dispute. In this instance, however, Opposer has submitted copies of correspondence sufficient to establish that Opposer made a good faith effort to resolve the parties’ discovery dispute prior to seeking Board intervention. *See* Trademark Rule 2.120(e)(1).

Opposer received Applicant's initial discovery responses on December 20, 2015, five days after they were due. *See* 27 TTABVUE 3. On January 12, 2016, Opposer's counsel sent Applicant a letter in which Opposer set forth in detail its position regarding alleged deficiencies in Applicant's discovery responses. *Id.*, at 30–40. After Applicant provided supplemental discovery responses, Opposer's counsel sent Applicant an email dated January 29, 2016, in which Opposer indicated that it believed Applicant's supplemental responses remained inadequate. *Id.*, at 41. Opposer's counsel then followed up on March 15, 2016, with a more comprehensive letter setting forth in detail Opposer's position regarding alleged deficiencies in Applicant's supplemental discovery responses. *Id.*, at 48–58. Opposer's counsel further requested that Applicant address the issues raised in Opposer's deficiencies letter by May 30, 2016. *Id.*, at 4. Opposer subsequently extended its deadline until April 4, 2016. *Id.* Opposer asserts that to date Applicant has not provided discovery proper responses or responsive documents. *Id.* Applicant does not dispute the substance of the chronology outlined by Opposer, but instead raises other arguments, discussed below.

Based on the record, the Board finds that Opposer has made the requisite good faith effort to resolve the parties' discovery dispute prior to filing its motion to compel. *See* Trademark Rule 2.120(e)(1).

Turning to the motion to compel, Applicant contends that Opposer's motion is premature because Opposer filed the motion prior to the expiration of the sixty-day

extension of the discovery period granted by Board in an order dated March 10, 2016.<sup>2</sup> Applicant's argument misconstrues the Board's order as extending her time to supplement her discovery response or otherwise respond to Opposer's deficiencies letter. The Board did, in fact, grant Opposer's motion for an extension on the grounds set forth in Opposer's motion, namely, to allow the parties time to attempt to resolve their discovery dispute. *See* 25 TTABVUE 4–5. However, the Board also directed the parties to “*promptly* endeavor to exchange their remaining discovery requests and responses, and to resolve any outstanding discovery disputes that may exist.” *Id.*, at 5. Nowhere in its order did the Board reset or extend the parties' time for responding to previously-served discovery requests or to supplement previous discovery responses.

Applicant's argument that it was improper for Opposer to file a motion for an extension of time and then proceed to file a motion to compel similarly is not well taken. It was not improper for Opposer to file a motion to extend time in order to preserve the case schedule while it attempted to resolve the discovery parties' discovery dispute. *Cf. Sentrol, Inc. v. Sentex Sys., Inc.*, 231 USPQ 666, 667 (TTAB 1986) (the Board noting that in lieu of a motion to compel, a motion to extend time to allow the parties to engage in an effort to settle the discovery dispute would have been a proper approach).

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<sup>2</sup> In its order, the Board granted Opposer's motion for a sixty day extension of the deadline to submit expert disclosures, the close of the discovery period, and all subsequent trial dates.

Applicant, in her response, also argues the merits of the case; alleges that Opposer is “abusing the trademark rules to engage in fishing expeditions and company espionage”; accuses Opposer of failing to promptly disclose the assignment of the pleaded registrations to IMG Universe, LLC; and requests a protective order to govern the production of confidential or proprietary information or documents. With the exception of the issue of the protective order,<sup>3</sup> none of these arguments are germane to the issue of the motion to compel, and thus they will be given no further consideration.

Turning to the issue of Applicant’s responses to Opposer’s discovery requests, Applicant has not submitted any arguments or authorities addressing the issues raised by Opposer in its motion. Moreover, a review of Applicant’s responses reveals they are inadequate. Many of Applicant interrogatories answers, and the majority of her responses Opposer document requests, contain inappropriate objections and evasive or partial answers. As non-exhaustive examples, Applicant makes unsubstantiated objections that requests are unduly broad or burdensome and objects to the disclosure of confidential business information despite the fact that the Board’s standard protective order is in effect automatically by operation of Trademark Rule 2.116(g).<sup>4</sup>

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<sup>3</sup> As discussed *infra*, the Board’s standard protective order is automatically in place by operation of Trademark Rule 2.116(g). *See* TBMP 412.01.

<sup>4</sup> In the February 11, 2015, order instituting this proceeding, the Board informed the parties that “[t]he Board’s Standard Protective Order is applicable.” 2 TTABVUE 4.

Because Applicant has failed to make a good faith effort to satisfy the discovery needs of Opposer and has not submitted any arguments or authorities addressing the discovery issues raised by Opposer in its motion, Opposer's motion to compel is **granted**. In view of the excessive number of requests and answers that are in dispute, the Board will not individually discuss each request. Applicant is ordered to provide supplemental responses to all of Opposer's interrogatories and document requests identified by Opposer in its motion, to conduct a search of her records, and to produce responsive, non-privileged documents in her possession, custody, or control.

In providing her supplemental discovery responses, Applicant is directed to review TBMP § 414, which provides selected guidelines relating to the discoverability of various information and documents.<sup>5</sup> Additionally, Applicant should note the following rules governing discovery.

Fed. R. Civ. P. 26(b) governs the scope of discovery served by either party under Fed. R. Civ. P. 33, 34, or 36, and provides that “[p]arties may obtain discovery regarding any nonprivileged matter that is relevant to any party’s claim or defense and proportional to the needs of the case,” and further that “[i]nformation within this scope of discovery need not be admissible in evidence to be discoverable.” The requirement of relevancy is generally construed liberally and discovery generously allowed unless it is clear that the information which is sought can have no possible

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<sup>5</sup> The TBMP is available online at:  
<https://mpep.uspto.gov/RDMS/TBMP/current#/current/tbmpd1e2.html>

bearing on the issues involved in the particular proceedings. *See, e.g., Varian Assocs. v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (1975); *Johnston Pump/Valve*, 10 USPQ2d at 1675 (“[d]uring discovery, a party may seek not only testimony and exhibits which would be admissible evidence but also information that would be inadmissible at trial if the information appears reasonably calculated to lead to the discovery of admissible evidence.”); TBMP § 402.01. *See also* 8B Wright, Miller, Kane, Marcus, Spencer & Steinman, *Fed. Prac. & Proc. Civ.* § 2008 (3d ed. 2016). A party cannot refuse to produce a requested document or information simply because it is relevant to a claim or defense on which the producing party believes that it will prevail. *See* 8 Wright & Miller, at § 2008 (“Discovery is not to be denied because it relates to a claim or defense that is being challenged as insufficient.”)

With respect to interrogatories, “[a]n interrogatory may relate to any matter that may be inquired into under Rule 26(b)” and “is not objectionable merely because it asks for an opinion or contention that relates to fact or the application of law to fact[.]” Fed. R. Civ. P. 33(a)(2).

In responding to interrogatories and document requests, boilerplate “general objections” are not proper. Objections, if any, must be specifically asserted in response to each interrogatory or document request and the ground for objecting must be stated with specificity. Fed. R. Civ. P. 33(b)(4) and 34(b)(2)(B); *see also Medtronic, Inc. v. Pacesetter Sys., Inc.*, 222 USPQ 80, 83 (TTAB 1984). Responses to specific discovery

requests that refer to and incorporate general objections therefore are improper<sup>6</sup> because they fail to specify which of the general objections, if any, are being asserted in response to a specific interrogatory or document request, or why each general objection is applicable to each request. *See, e.g., Medtronic*, 222 USPQ at 83 (answering party must articulate objections with particularity); *Amazon Techs.*, 93 USPQ2d at 1705-06 (“general objections” to interrogatories and document requests found to be “anything but specific”).

Further “[i]t is incumbent upon a party who has been served with interrogatories to respond by articulating his objections (with particularity) to those interrogatories which he believes to be objectionable, and by providing the information sought in those interrogatories which he believes to be proper.” *See, Medtronic*, 222 USPQ at 83. The burden of persuasion is on the objecting party to show that the interrogatories should not be answered. *Id.* (citation omitted). *See also, Volkswagenwerk Aktiengesellschaft v. MTD Prods. Inc.*, 181 USPQ 471 (TTAB 1974); 8B Wright & Miller at § 2173.

Requests for production of documents can be served on a party to the proceeding and are proper to the extent that the requested documents are “in the responding party’s possession, custody, or control.” Fed. R. Civ. P. 34(a). Courts and the Board have defined control “not only as possession, but as the legal right to obtain the

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<sup>6</sup> A general objection is appropriate only when the objection relates to the discovery requests as a set, as opposed to an objection to the form of a request or the nature of the responsive information.

documents requested upon demand.” *Pioneer Kabushiki Kaisha v. Hitachi High Tech. Am. Inc.*, 74 USPQ2d 1672, 1679 (TTAB 2005) (citing cases and authorities).

In responding to each document request, a party must state whether or not it has responsive documents in its possession, custody or control and, if so, state that such documents will be produced or that such documents are being withheld, based on a claim of privilege or a specified objection. *See* Fed. R. Civ. P. 34(b)(2)(B)– (C); *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000); TBMP § 406.04(c).

If objection is made to only part of an item or category, the part must be specified. For example, with respect to the objection of undue burden, “[a]n objection may state that a request is overbroad, but if the objection recognizes that some part of the request is appropriate the objection should state the scope that is not overbroad.” Fed. R. Civ. P. 34(b)(2)(B), Advisory committee notes (2015 amendment).

Further, a party withholding responsive documents on the basis of a claim of privilege must “(i) expressly make the claim; and (ii) describe the nature of the documents, communications, or tangible things not produced or disclosed—and do so in a manner that, without revealing information itself privileged or protected, will enable other parties to assess the claim.” Fed. R. Civ. P. 26(b)(5)(A)(i)–(ii).<sup>7</sup> *See also Cadbury UK Ltd. v. Meenaxi Enter., Inc.*, 115 USPQ2d 1404, 1408 n.7 (Board

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<sup>7</sup> Fed. R. Civ. P. 26(b)(5) does not specify exactly how the party asserting privilege 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 claimed, the name of the person making/receiving the communication, the date and place of the communication, and the document’s general subject matter. *See* TBMP § 406.04(c).

compelling plaintiff to provide defendant with a privilege log, to the extent applicable).

Finally, with respect to the disclosure of confidential or proprietary business information, the Board's standard protective order is automatically in place by operation of Trademark Rule 2.116(g). *See* TBMP 412.01. Therefore, Applicant may not withhold properly discoverable information or documents on the grounds that they are confidential or proprietary. *See, e.g., Amazon Techs.*, 93 USPQ2d 1702 at 1706 n.6; *Intex Recreation Corp. v The Coleman Co.*, 117 USPQ2d 1799, 1801 (TTAB 2016) (party may not redact confidential information from documents responsive to document requests). Applicant is directed to TBMP § 412 for further information regarding the Board's standard protective order.

The Board expects parties (and their attorneys or other authorized representatives) to cooperate with one another in the discovery process. *Panda Travel Inc. v Resort Option Enters., Inc.*, 94 USPQ2d 1789, 1791 (TTAB 2009) ("Each party has a duty to make a good faith effort to satisfy the reasonable and appropriate discovery needs of its adversary."); TBMP § 408.01. To this end, each party and its attorney or other authorized representative has a duty to make a good faith effort to satisfy the legitimate discovery needs of its adversary. TBMP § 408.01.

Applicant is cautioned that it may be barred from relying upon or later producing documents or information at trial, or to use any information or witnesses to supply evidence on a motion or at a hearing, where such documents, information, or

witnesses were withheld from discovery.<sup>8</sup> See Fed. R. Civ. P. 37(c)(1); *Panda Travel*, 94 USPQ2d at 1792; *Quality Candy Shoppes/Buddy Squirrel of Wisconsin Inc. v. Grande Foods*, 90 USPQ2d 1389, 1392 (TTAB 2007); *Presto Prods. v. Nice-Pak Prods.*, 9 USPQ2d 1895, 1896 n.5 (TTAB 1988); TBMP § 527.01(e).

In sum, Opposer's motion to join IMG Universe, LLC, as a party-opposer is **granted**.

Opposer motion to compel is **granted** and Applicant is directed to provide supplemental written responses to Opposer's Interrogatory Nos. 4–8, 15–16, 19–22, 25, 27–29, 35, 37 – 38, and 40 and supplemental written responses to Opposer's Document Request Nos. 1–19, 21–35, and 38. Applicant is further directed to conduct a search of her records and to produce copies of responsive, non-privileged documents in its possession, custody or control.

In her supplemental written responses to Opposer's document requests, Applicant must expressly state that she conducted a search of her records; affirmatively state whether or not she has responsive documents in her possession, custody or control; indicate whether any responsive documents are being withheld based on a claim of privilege or a specified objection; and produce all responsive documents in her possession, custody, or control, that are not being withheld based on a claim of privilege or a specified objection. With respect to any responsive document that

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<sup>8</sup> Opposer must raise this matter by objecting to the evidence in question during the trial period and preserving its objection in its brief on the case. See *Panda Travel*, 94 USPQ2d at 1792-93; *General Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1593-94 (TTAB 2011); TBMP § 527.01(e).

Applicant withholds based on a claim of privilege, Applicant must provide Opposer with a privilege log in which Applicant identifies each document withheld, information regarding the nature of the privilege claimed, the name of the person making/receiving the communication, the date and place of the communication, and the document's general subject matter. *See* Fed. R. Civ. P. 26(b)(5); TBMP § 406.04(c).

Applicant must serve Opposer with Applicant's supplemental interrogatory responses, supplemental written responses to Opposer's document requests, supplemental production of documents, and privilege log (if applicable) by no later than **September 14, 2016**.

Proceedings are resumed and dates are reset as follows:<sup>9</sup>

Expert Disclosures Due	<b>11/14/2016</b>
Discovery Closes	<b>12/14/2016</b>
Plaintiff's Pretrial Disclosures	<b>1/28/2017</b>
Plaintiff's 30-day Trial Period Ends	<b>3/14/2017</b>
Defendant's Pretrial Disclosures	<b>3/29/2017</b>
Defendant's 30-day Trial Period Ends	<b>5/13/2017</b>
Plaintiff's Rebuttal Disclosures	<b>5/28/2017</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>6/27/2017</b>

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.

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<sup>9</sup> In view of the new schedule, Applicant's motion for a sixty-day extension of all dates (filed April 6, 2016) is moot. The Board notes, however, that Applicant's motion for an extension of time was embedded in her response to Opposer's motion to join a party. Applicant is advised that in the future she should not embed a motion in another filing. All new motions should be separately filed and briefed, to ensure they receive the proper attention. *See, e.g., Prakash Melwani v. Allegiance Corp.*, 97 USPQ2d 1537 (TTAB 2010); TBMP § 502.02(b) ("In general, all motions should be filed separately, or at least be captioned separately, to ensure they receive attention.").

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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.