

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

CME

Mailed: April 29, 2016

Opposition No. 91220956

Unique Photo Inc.

v.

Sanjay Agarwal

Christen M. English, Interlocutory Attorney:

This case now comes up on Opposer's motion, filed January 28, 2016, to compel Applicant to: (1) supplement his responses to Interrogatory Nos. 5, 7, 10, 11, 14, 15, 17-20 and 26; (2) produce documents in response to Document Request Nos. 1, 6, 7, 20, 22, and 29; and (3) verify his interrogatory responses "without qualification." 10 TTABVUE 14. Applicant opposes the motion.

The Board has carefully considered all of the parties' arguments, presumes the parties' familiarity with the factual bases for their filings, and does not recount the facts or arguments, except as necessary to explain the decisions herein.

As an initial matter, the Board finds that Opposer made a good faith effort to resolve its discovery dispute prior to filing the motion to compel. Nonetheless, in many instances, Opposer quibbles over semantics. Such arguments elevate form over substance and needlessly expend the Board's limited resources. Opposer also argues that "Applicant has continually evaded Opposer's requests [to extend proceedings] in

what amounts to a greatly reduced chance for successful completion of discovery.” 10 TTABVUE 12-13. This argument is not well-taken. Opposer did not serve discovery requests until the last day of the discovery period, and therefore, Opposer has itself to blame if the “successful completion of discovery” has been “greatly reduced.” *Cf. Am. Vitamin Prods. Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1316 n.4 (TTAB 1992) and TBMP §403.04 (2015).

With the foregoing in mind, the Board addresses in turn below each of the discovery requests at issue in Opposer’s motion.

Interrogatory No. 5

The Board finds that Applicant’s response to this interrogatory, as clarified in Applicant’s letter of January 25, 2016, is sufficient. Accordingly, Opposer’s motion to compel is **DENIED** with respect to Interrogatory No. 5.

Interrogatory No. 7

This interrogatory asks Applicant to identify “all advertising and promotional activities conducted by Applicant or Applicant’s business(es) with respect to Applicant’s goods and services using the mark UUNIQUE in the United States, and provide all documents which refer or relate to such advertising and promotional activities.” 10 TTABVUE 25. Because the request seeks both information and documents, it is in the nature of a combined interrogatory and document request. While the better approach would have been to serve an interrogatory requesting only information and a separate document request seeking documents, this is not a basis on which to deny Opposer’s motion.

In response to this discovery request, Applicant indicates that “[t]he trademark UUnique was represented at CES 2015 organised [sic] by Brightstar in Las Vegas....” 10 TTABVUE 40. Applicant, however, has not described the specific promotional activities in which he engaged at the conference (e.g. operating a trade show booth, handing out and/or testing product samples, distributing promotional literature, giving a speech about  products, etc.). Applicant also has not produced any documents or stated that he does not have any documents “which refer or relate to such advertising and promotional activities.”

Accordingly, Opposer’s motion to compel is **GRANTED** with respect to Interrogatory No. 7. Within **THIRTY DAYS** from the mailing date of this order, Applicant is ordered to serve: (i) a supplemental written and verified response to Interrogatory No. 7 describing the activities in which he engaged at the CES 2015 conference and indicating whether he has any responsive documents; and (ii) any responsive documents.¹

Interrogatory No. 10

Applicant is an individual. It is reasonable to read Applicant’s response to Interrogatory No. 10 as identifying himself as the person most knowledgeable about his use or plans to use the mark . For this reason, the Board finds that

¹ The Board cannot compel a party to produce what he does not have, but it is foreseeable that Applicant may have responsive documents given that his mark  “was represented at CES 2015.” 10 TTABVUE 40.

Applicant's response needs no further supplementation, and Opposer's motion is **DENIED** with respect to Interrogatory No. 10.

Interrogatory No. 11

The Board has reviewed Applicant's response to this interrogatory and finds that it is sufficient. Accordingly, Opposer's motion is **DENIED** with respect to Interrogatory No. 11.

Interrogatory Nos. 14 and 15

Interrogatory 14 asks Applicant to "[i]dentify and describe each poll, survey, consumer study, or other market research project directed to the United States commenced or completed by Applicant or by Applicant's business(es) with respect to the UUNIQUE mark." 10 TTABVUE 26. Interrogatory 15 asks Applicant to identify any third parties who "cooperated with" him in any polls, surveys, consumer studies or market research identified in response to Interrogatory No. 14 and to "describe the nature and details of such cooperation." 10 TTABVUE 27.

In response to Interrogatory No. 14, Applicant stated that he "made a survey on the trademarks that have already been registered that [contain] the word 'unique[,]'" and he reproduced the results of this "survey" in the form of a chart. 10 TTABVUE 41-44. With respect to Interrogatory No. 15, Applicant indicated that "[t]here have been on [sic]² third parties that cooperated in any way with me in relation to the above table." 10 TTABVUE 44.

² In his letter of January 25, 2016, Applicant acknowledged that his use of the word "on" was a typographical error and that "there have been **no** third parties that cooperated in any way

To “survey” means “to ask (many people) a question or a series of questions in order to gather information about what most people do or think about something.” <http://www.merriam-webster.com/dictionary/survey> (last visited April 27, 2016). In the context of trademark litigation “a survey is designed to prove the state of mind of a prospective purchaser.” 6 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, §32:163 (4th ed. March 2016 update). It is clear that Applicant’s search for registered trademarks incorporating the word “unique” is not a survey.³ Nor does the search qualify as a poll, consumer study, or market research because the search did not require any inquiries or research of consumers. Accordingly, the trademark search that Applicant identified is not responsive to Interrogatory No. 14.

For this reason, Opposer’s motion to compel with respect to Interrogatory No. 14 is **GRANTED** only to the extent that Applicant is ordered within **THIRTY DAYS** of the mailing date of this order to provide a written supplemental and verified response identifying any surveys, polls, consumer studies or market research (all of which require either consumer inquiry or research) that he has conducted with respect to his involved mark UUNIQUE. To the extent Applicant has not engaged in any such

with [him] in relation to the table [identified in response to Interrogatory No. 14].” 10 TTABVUE 97 (emphasis added).

³ Opposer, who is represented by counsel, surely knew that the search that Applicant identified in response to Interrogatory No. 14 did not qualify as a survey, particularly as Applicant identified the same search in response to Interrogatory No. 16, which specifically inquired as to trademark searches. By bringing a motion to compel with respect to Interrogatory Nos. 14 and 15, Opposer has wasted the Board’s limited time and resources.

activities, Applicant shall so state. Opposer's motion with respect to Interrogatory Nos. 14 and 15 is otherwise **DENIED**.

Interrogatory No. 17

Interrogatory No. 17 is overbroad to the extent that it is not limited to Applicant's involved mark. The interrogatory also is encompassed by Interrogatory No. 7, and the Board has ordered Applicant to supplement his response to Interrogatory 7, particularly with respect to his activities at the CES 2015 trade show.

Accordingly, Opposer's motion with respect to Interrogatory No. 17 is **DENIED** to the extent Opposer seeks information regarding marks other than Applicant's mark involved in this proceeding⁴ and **MOOT** to the extent this interrogatory is encompassed by Interrogatory No. 7.

Interrogatory No. 18

The Board has reviewed Applicant's response to this interrogatory and finds it sufficient. Accordingly, Opposer's motion with respect to Interrogatory No. 18 is **DENIED**.

Interrogatory No. 19

This interrogatory seeks the "correct phonetic pronunciation of Applicant's mark UUNIQUE, its phonetic usage by consumers, and its intended meaning in the context of the goods offered under this mark." 10 TTABVUE 27. The Board finds that

⁴ Applicant did not object to this interrogatory on the ground that it is overbroad, but the Board will not compel a party to produce information that falls outside the scope of this proceeding.

Applicant's response regarding the "correct phonetic pronunciation of the mark"⁵ and its "intended meaning" is sufficient. Applicant, however, has not responded to the interrogatory to the extent it seeks information regarding the "phonetic usage [of Applicant's mark] by consumers." 10 TTABVUE 48. Accordingly, Opposer's motion with respect to Interrogatory 19 is **GRANTED**.

Applicant is ordered within **THIRTY DAYS** of the mailing date of this order to supplement his response to Interrogatory No. 19 regarding consumers' phonetic usage of Applicant's mark. The Board notes that the involved application was not filed based on use, but rather was filed pursuant to Section 66(a) of the Trademark Act, and therefore, it is feasible that there has been no consumer usage of Applicant's mark in the United States. If this is the case, Applicant must so state in his supplemental written and verified response.

Interrogatory No. 20

This interrogatory asks Applicant to "[s]tate all known facts in support of Applicant's contentions in paragraphs 11 through 34 of the Answer to Notice of Opposition dated April 30, 2015." 10 TTABVUE 27. This request is comparable to asking Applicant to present his case-in-chief, which is premature at this time because Applicant's trial period has not yet opened. Accordingly, Opposer motion is **DENIED** with respect to Interrogatory 20.

⁵ The parties should note that "[f]or purposes of [a] § 2(d) analysis, there is no 'correct' pronunciation of a mark because it is impossible to predict how the public will pronounce a particular mark[.]" TMEP § 1207.01(b)(iv) (Oct. 2015) and case cited therein.

Interrogatory No. 26

In response to this interrogatory, Applicant stated that he “consulted a number of persons” in responding to Opposer’s interrogatories, but Applicant did not identify those persons as required by the interrogatory. 10 TTABVUE 49. Accordingly, Opposer’s motion to compel is **GRANTED** with respect to Interrogatory No. 26. Within **THIRTY DAYS** of the mailing date of this order, Applicant must provide Opposer with a supplemental written and verified response to Interrogatory No. 26 identifying the persons with whom he consulted to answer Opposer’s interrogatories.⁶

Document Request No. 1

This request seeks “[a]ll documents identified, or the identification of which is requested, in Interrogatories Nos. 1-27 to Applicant.” 10 TTABVUE 29. Applicant has responded that he has “not identified any documents in relation to the Interrogatories Nos. 1-27 to Applicant.” 10 TTABVUE 52.

As stated, the Board cannot compel a party to produce documents that he does not have. But to the extent the Board orders Applicant herein to supplement his interrogatory responses and Applicant identifies documents in his supplemental responses, Applicant must produce them. Accordingly, Opposer’s motion with respect to Document Request No. 1 is **GRANTED** to the extent that if Applicant identifies any documents in his supplemental interrogatory responses as ordered herein,

⁶ As noted, Opposer served discovery on the last day of the discovery period, and therefore, discovery closed before Applicant’s response deadline. As such, the usefulness of Interrogatory No. 26 and Opposer’s other discovery requests seeking the identity of persons with potentially discoverable information is unclear as Opposer will not have the opportunity to take the discovery depositions of any identified persons.

Applicant must supplement his written response to Document Request No. 1 and produce responsive documents within **THIRTY DAYS** of the mailing date of this order.

Document Request No. 6

This document request asks Applicant to produce “[s]uch documents as will permit the identification of:

- (a) All outlets in the United States or accessible from the United States for sale or proposed sale of each good and service which has been offered by Applicant or Applicant’s business(es) under or by reference to Applicant's UUNIQUE mark;
- (b) All present, proposed or contemplated distributors and/or licensees offering goods or services in the United States under or by reference to Applicant’s UUNIQUE mark; and
- (c) Any other outlets where any good or service has been offered or will be offered in the United States by Applicant or Applicant’s business(es), under or by reference to Applicant's UUNIQUE mark.”

10 TTABVUE 30.

Applicant has responded that he has never used the  mark “in relation to any sales in the United States so far ... and [that he has] no specific plans related to the elements of my prospective business plan.” 10 TTABVUE 57. This response suggests that Applicant has no documents responsive to this request, but because Applicant has not expressly stated that he has no responsive documents, Opposer’s motion is **GRANTED** with respect to Document Request No. 6. Accordingly, within **THIRTY DAYS** of the mailing date of this order, Applicant is ordered to serve a

supplemental written response expressly stating whether he has documents responsive to this request, and if he has responsive documents, to produce them.⁷

Document Request No. 7

This document request seeks “[r]epresentative specimens or samples of all advertising of any form, commercial material, brochures, product description materials, and other literature which refer or relate to all goods sold or distributed or services offered, or intended to be offered, in the United States by Applicant or Applicant's business(es) in connection with any mark consisting in whole or in part of UUNIQUE, including but not limited to, newspapers, magazines, trade journals, catalogs, packaging, price lists, packaging, labels, signs, containers, boxes, bags, tags, wrappers, package inserts and other business materials which have been distributed by or on behalf of Applicant for each year from the date Applicant claims he first shipped orders for goods to the United States under the UUNIQUE mark or otherwise used the mark in the United States to the present date.” 10 TTABVUE 30.

Applicant responded that he has no documents responsive to this request, and the Board cannot compel a party to produce what he does not have. Accordingly Opposer’s motion to compel with respect to Document Request No. 7 is **DENIED**.⁸

⁷ Opposer argues that Brightstar, who Applicant identified in response to Interrogatory No. 7, is a distributor, and therefore, Applicant must have documents responsive to this request. 10 TTABVUE 40. If Brightstar is in fact a distributor or potential distributor of Applicant’s UUNIQUE products, and Applicant has documents identifying Brightstar as such, he must produce them in response to this document request.

⁸ Notwithstanding this determination, the Board questions whether Applicant has responsive documents given that his mark UUNIQUE “was represented at CES 2015.” 10 TTABVUE

Document Request No. 20

By this request, Opposer seeks “[s]uch documents as will permit the identification of all persons and firms, including but not limited to, advertising or sales agents, that have promoted or will promote the sale of the Applicant’s, or Applicant’s business(es), goods or services in the United States.” 10 TTABVUE 32. Applicant responded: “I have never used [the] UUNIQUE trademark in relation to any sales in the United States so far and I have not identified any advertising or sales agents that will promote the sale of goods under the trademark UUNIQUE.” 10 TTABVUE 60.

This response suggests that Applicant has no documents responsive to this request, but because Applicant has not expressly stated that he has no responsive documents, Opposer’s motion is **GRANTED** with respect to Document Request No. 20. Accordingly, within **THIRTY DAYS** of the mailing date of this order, Applicant is ordered to serve: (i) a supplemental written response expressly stating whether he has documents responsive to this request; and (ii) any responsive documents.⁹

Document Request No. 22

This request seeks “[d]ocuments which refer or relate to any search or investigation by Applicant or Applicant’s business(es) of any uses of names or marks containing the word UUNIQUE by any other company.” 10 TTABVUE 32.

40. If Applicant has documents responsive to this request, he must promptly serve a supplemental written response to this document request and produce responsive documents.

⁹ Given Applicant statement that he was his mark  “was represented at CES 2015,” Applicant may have documents responsive to this request. 10 TTABVUE 40.

Applicant responded identifying the same trademark search that he identified in response to Interrogatory Nos. 14 and 16, but Applicant did not state whether he has any documents related to the search. 10 TTABVUE 60-61. Accordingly, Opposer's motion to compel is **GRANTED** with respect to Document Request No. 22. Within **THIRTY DAYS** of the mailing date of this order, Applicant is ordered to serve a supplemental written response indicating whether he has documents responsive to Document Request No. 22, and to produce any responsive documents.

Document Request No. 29

This document request seeks “[a]ll documents which support any allegation in Applicant’s ‘Answer to Notice of Opposition’ dated April 30, 2015.” 10 TTABVUE 33. This request is similar to asking Applicant to produce the documents on which he plans to rely at trial, and a party is not required to produce such documents. *See CareFirst of Maryland, Inc. v. FirstHealth of the Carolinas, Inc.*, 77 USPQ2d 1492, 1500 (TTAB 2005) (“It is settled that a party in a Board proceeding generally has no obligation to identify all of its trial evidence prior to trial.”); Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42246 (August 1, 2007). Accordingly, Opposer’s motion to compel with respect to Document Request No. 29 is **DENIED**.

Qualification and Verification

Applicant’s responses to Opposer’s discovery requests are preceded by the following (referred to as the “Preamble”): “I reserve my right to change my opinion regarding any answer at any time, including about past facts, stated opinions about

any past or future facts, circumstances or persons. No liability will be accepted based on any of the answers.” 10 TTABVUE 38. Opposer argues that the Preamble renders meaningless Applicant’s verification of his interrogatories, served January 25, 2016, and the Board agrees. 10 TTABVUE 7. Although Applicant has reserved the right to change his opinions as opposed to facts, a party may serve a discovery request that requires its adversary to give an opinion that relates to fact or the application of the law to the facts. *See* TBMP § 414(21) and cases cited in footnote 29 therein. Moreover, by signing interrogatory responses under oath, a party attests to the truth of the interrogatory responses. Applicant’s Preamble suggests that his interrogatory responses may not be truthful, with respect to any opinions stated therein.

Accordingly, Opposer’s motion to compel is **GRANTED** with respect to Applicant’s verification. Applicant is ordered within **THIRTY DAYS** of the mailing date of this order to re-serve his interrogatory responses of December 29, 2015, without the Preamble, and with a verification.¹⁰

Summary

In sum, Opposer’s motion is **GRANTED** to the extent that within **THIRTY DAYS** of the mailing date of this order, Applicant is ordered to serve on Opposer:

- Supplemental written and verified responses to Interrogatory Nos. 7, 14, 19, and 26;

¹⁰ Responses to document requests and requests for admission are not required to be made under oath, and therefore, Applicant does not need to re-serve his responses to such discovery requests.

- Supplemental written responses to Document Request Nos. 1, 6, 20, and 22;
- Copies of any documents (copied at Applicant's own expense) responsive to Interrogatory No. 7 and Document Request Nos. 1, 6, 20 and 22; and
- A revised and verified copy of his December 29, 2015 responses to Opposer's interrogatories without the Preamble.

Opposer's motion is otherwise **DENIED**.

At trial, Opposer may seek to preclude Applicant from relying on information or documents that should have been produced or identified in response to Opposer's discovery requests, but were not. *See Panda Travel, Inc. v. Resort Option Enters., Inc.*, 94 USPQ2d 1789, 1792 (TTAB 2009); *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 §§ 408.02 and 527.01(e).

Dates Reset

Proceedings remain suspended through **THIRTY DAYS** from the mailing date of this order and shall resume upon the schedule set forth below:

Plaintiff's Pretrial Disclosures Due	6/17/2016
Plaintiff's 30-day Trial Period Ends	8/1/2016
Defendant's Pretrial Disclosures Due	8/16/2016
Defendant's 30-day Trial Period Ends	9/30/2016
Plaintiff's Rebuttal Disclosures Due	10/15/2016
Plaintiff's 15-day Rebuttal Period Ends	11/14/2016

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.
