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

wbc

Mailed: August 11, 2016

Opposition No. 91223510

Symplicity Corporation

v.

Acelero Learning Data and Technical Assistance, Inc.

Wendy Boldt Cohen, Interlocutory Attorney:

This case now comes up for consideration of Applicant's May 20, 2016 motion to compel discovery responses and to test the sufficiency of responses to requests for admission. The motion is fully briefed.[1]

After reviewing the parties' arguments and submissions with respect to the motion to compel, the Board finds that Applicant has not satisfied its obligation under Trademark Rule 2.120(e) to make a good faith effort to resolve its discovery disputes before seeking the Board's intervention. A motion to compel discovery must be supported by a written statement from the moving party that such party or its attorney has made a good faith effort, by conference or correspondence, to resolve with the other party or its attorney the issues presented in the motion, and has been unable to reach

[1] The Board has considered the parties' submissions and presumes the parties' familiarity with the factual bases for the motion and does not recount them here except as necessary to explain the Board's order.

agreement. Trademark Rule 2.120(e); *see also* TBMP § 523.02 (2016) and cases cited therein. "The good faith efforts of the parties should be directed to understanding differences and actually investigating ways in which to resolve the dispute." *Hot Tamale Mama … and More, LLC v. SF Invs., Inc.,* 110 USPQ2d 1080, 1081 (TTAB 2014); *see MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 953 (TTAB 1979). "Where it is apparent that the effort toward resolution is incomplete, establishing the good faith effort that is a prerequisite for a motion to compel necessitates that the inquiring party engage in additional effort toward ascertaining and resolving the substance of the dispute." *Id*.

In support of Applicant's purported good faith efforts, Applicant alleges, *inter alia*, that it wrote to Opposer on April 14, 2016 demanding it supplement its discovery responses.[2] On May 19, 2016, in response thereto, Opposer indicated that while it disagreed that its responses were deficient, it would supplement its interrogatory responses by May 23, 2016. A mere one day after receipt of Opposer's letter and before May 23, 2016, Applicant filed its motion on May 20, 2016.

Based on the foregoing, Applicant did not provide Opposer with a meaningful opportunity to resolve the parties' dispute prior to seeking Board intervention. Although Applicant was not required to wait indefinitely, given Opposer's request for

[2] Applicant includes with its motion copies of email exchanges between the parties, all of which predate Opposer's May 19, 2016 letter. Although there is an email exchange between the parties dated May 19, 2016, Applicant alleges Opposer's letter of May 19, 2016 was received after the email exchange. *See* 12 TTABVUE p. 4 ("Applicant again conferred with Opposer's counsel on May 19, 2016 … Later on May 19, 2016, Opposer served a responsive letter on Applicant's counsel").

additional time to supplement some of its discovery responses,[3] Applicant should have, at a minimum, awaited receipt of the supplemental responses. Furthermore, after receipt of Opposer's May 19, 2016 letter disagreeing with Applicant regarding the alleged deficiency of Opposer's responses, Applicant should have engaged in additional effort toward ascertaining and resolving the substance of the dispute. Inasmuch as Applicant filed its motion one day after receipt of Opposer's letter, it is clear such effort was not made. In view thereof, the Board hereby **denies** Applicant's motion. *See* Trademark Rule 2.120(e)(1). A frank exchange between counsels, given the parties' equal obligations to make efforts to resolve the discovery dispute, could have obviated this motion. *Cf. Amazon Technologies Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009). The vast majority of issues raised herein should have been resolved without Board intervention, and the Board suggests greater effort to avoid or resolve such controversies. The parties are directed to review carefully TBMP § 414 regarding the discoverability of various matters in Board *inter partes* proceedings.

The parties are reminded that the purpose of discovery is to advance the case so that it may proceed in an orderly manner within reasonable time constraints. To this end, the parties must adhere to the strictures set forth in *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986), and repeated below:

> [E]ach party and its attorney has a duty not only to make a good faith effort to satisfy the discovery needs of its opponent but also to make a good faith effort to seek only such discovery as is proper and relevant to the specific issues involved in the case. Moreover, where the parties disagree as to the propriety of certain requests for discovery, they are

[3] Indeed, Opposer alleges it has already provided supplemental responses to Applicant's discovery. 14 TTABVUE p. 2. Applicant does not dispute this allegation, noting in its reply that "Opposer has supplemented its various discovery responses." 15 TTABVUE p.1.

> under an obligation to get together and attempt in good faith to resolve their differences and to present to the Board for resolution only those remaining requests for discovery, if any, upon which they have been unable, despite their best efforts, to reach an agreement. Inasmuch as the Board has neither the time nor the personnel to handle motions to compel involving substantial numbers of requests for discovery which require tedious examination, **it is generally the policy of the Board to intervene in disputes concerning discovery, by determining motions to compel, only where it is clear that the parties have in fact followed the aforesaid process and have narrowed the amount of disputed requests for discovery, if any, down to a reasonable number.**

(emphasis added).

The Board expects the parties to cooperate with one another in the discovery process and looks with extreme disfavor on those who do not. *Id.*; *see Panda Travel Inc. v. Resort Option Enterprises, Inc.*, 94 USPQ2d 1789, 1791 (TTAB 2009); *Amazon Technologies Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009).

Given the parties' dispute regarding the nature of Opposer's responses, the Board provides the following comments.

A party on which interrogatories have been served should respond to them by stating, with respect to each interrogatory, either an answer or an objection. *See* TBMP § 405.04(b). If an interrogatory is answered, the answer must be made separately and fully, in writing under oath. *Id.* A party which fails to respond to interrogatories during the time allowed therefor, and which is unable to show that its failure was the result of excusable neglect, may be found, on motion to compel filed by the propounding party, to have forfeited its right to object to the interrogatories on their merits. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000).

Responses to requests for admission must be made in writing, and should include an answer or objection to each matter of which an admission is requested. An answer must admit the matter of which an admission is requested; deny the matter; or state in detail the reasons why the responding party cannot truthfully admit or deny the matter. *See* Fed. R. Civ. P. 36(a). If a party on which requests for admission have been served fails to timely respond thereto, the requests will stand admitted by operation of law unless the party is able to show that its failure to timely respond was the result of excusable neglect or unless a motion to withdraw or amend the admissions is filed pursuant to Fed. R. Civ. P. 36(b) and granted by the Board. *See Giersch v. Scripps Networks Inc.,* 85 USPQ2d 1306, 1307 (TTAB 2007); *Fram Trak Industries v. Wiretracks LLC*, 77 USPQ2d 2000, 2005 (TTAB 2006); *Pinnochio's Pizza Inc. v. Sandra Inc.*, 11 USPQ2d 1227, 1228 n.5 (TTAB 1989). It is not necessary to file a motion to deem requests for admissions admitted when no response is served, since the admissions are deemed admitted by operation of Fed. R. Civ. P. 36(a).

In preparing responses to discovery requests, a responding party must conduct a thorough search of its records. *See* TBMP § 408.02. A party served with a request for discovery has a duty to thoroughly search its records for all information properly sought in the request, and to provide such information to the requesting party within the time allowed for responding to the request. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000). The responding party must state with regard to each document request: (1) whether or not there are responsive documents in its possession,

custody and control,[4] and, (2) if so, that such documents will be produced or state any objections. *See* Fed. R. Civ. P. 34(b)(2); *No Fear Inc.*, 54 USPQ2d at 1555. A responding party "must produce [responsive] documents as they are kept in the usual course of business or must organize and label them to correspond to the categories in the request[s]." Fed. R. Civ. P. 34(b)(2)(E)(i). Opposer need not create responsive documents solely to satisfy Applicant's discovery requests. *See Washington v. Garrett*, 10 F.3d 1421, 1437-38 (9th Cir. 1993).

Opposer has an ongoing duty to supplement or correct its discovery responses. *See* Fed. R. Civ. P. 26(e). If Opposer fails to disclose properly discoverable information or documents, Opposer may, upon timely objection from Applicant, be precluded from using such information or documents at trial, unless such failure is substantially justified or is harmless. *See* Fed. R. Civ. P. 37(c)(1).

Proceedings are resumed and dates are reset as follows:

Expert Disclosures Due	**9/17/2016**
Discovery Closes	**10/17/2016**
Plaintiff's Pretrial Disclosures	**12/1/2016**
Plaintiff's 30-day Trial Period Ends	**1/15/2017**
Defendant's Pretrial Disclosures	**1/30/2017**
Defendant's 30-day Trial Period Ends	**3/16/2017**
Plaintiff's Rebuttal Disclosures	**3/31/2017**
Plaintiff's 15-day Rebuttal Period Ends	**4/30/2017**

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

[4] Responses to document requests which indicate that the responding party may not have conducted a thorough search of its records, e.g., "responsive documents, if any, will be produced," are improper. *See No Fear Inc.*, 54 USPQ2d at 1555.

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.