

ESTTA Tracking number: **ESTTA760582**

Filing date: **07/26/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91228195
Party	Plaintiff Disney Enterprises, Inc.
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Attachments	Final - Motion to Strike Answer.pdf(409960 bytes )



paragraphs arguing the merits of Opposer's claim. For example, Applicant states under the argumentative heading "THERE IS NO LIKELIHOOD OF CONFUSION:"

4. Opposer has never registered or applied for registration in Class 3 for its mark "MULAN." The focus of Opposer's product lines is films and TV related goods.
5. Opposer has offered no proof or evidence of any consumer confusion or damage. A vague and ambiguous belief is not a valid basis to prevent Applicant from doing business/making a living.
6. Applicant's customers are primarily sophisticated adults and Applicant has not documented any confusion. If Opposer had evidence of confusion, it would have submitted it in its Opposition.
7. There is no intent to deceive. There is no value for Applicant to palm-off or piggy-back on Opposer's Mark.

(Dkt. 4. at ¶¶ 4-7) Applicant's Answer also argues under the heading "THE MARKS ARE DISSIMILAR:"

9. Applicant received a notice from the USPTO that no registered or pending marks would bar registration to its mark.
10. Opposer makes a claim of common law trademark in "Disney Dare to Dream Mulan (make-up)," but the MULAN Mark is buried deep in the product title.

(Dkt. 4 at ¶¶ 9-10.) Further, Applicant argues in its answer under "ORDER REQUEST":

12. Applicant sees no reason or legal basis for Opposer's claim asserting confusion and Applicant should not be allowed to extend its franchise so broadly to stop Applicant (or anyone else) from making a living in areas that have no conflict. The Board should not allow Opposer to squat in random classes and claim rights so broadly. It is a Restraint of Trade violation and should not be sanctioned by this Board.

(Dkt. 4 at ¶ 12.)

## **II. ARGUMENT**

Fed. R. Civ. P. 8(b) provides that "a party shall state in short and plain terms the party's defenses to each claim asserted. . . ." Allegations that are argumentative and

more in the nature of a brief on the case than a responsive pleading do not comply with this rule, and are subject to a motion to strike. See TBMP § 311.02(a) (“The defendant should not argue the merits of the allegations in a complaint...”). *Nat’l Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212, 1214 n.2 (TTAB 1990) (recognizing as improper answers that are more in the nature of argument than answer). Further, under Fed. R. Civ. P. 12(f), any insufficient defense or redundant, immaterial, impertinent, or scandalous matter may be stricken from a pleading. See TBMP § 506.01. The Board may grant a motion to strike or, on its own initiative, strike from a pleading any insufficient defense. See *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1292 (TTAB 1999).

For the reasons set forth below, Applicant’s Answer should be stricken in its entirety under TBMP § 311.02(a) and Fed. R. Civ. P. 8, and default judgment should be entered under Fed. R. Civ. P. 55 or, in the alternative, the Board should issue an order deeming all allegations in the Notice of Opposition admitted

**A. Applicant’s “General Denial” is Improper and Not Made in Good Faith**

Under Fed. R. Civ. P. 8(b), a party responding to a complaint must ordinarily “admit or deny the allegations asserted against it by an opposing party.” Subject to Fed. R. Civ. P. 11, and only where a defendant “intends in *good faith* to controvert all of the allegations contained in a complaint, including the jurisdictional grounds,” may the defendant do so by general denial. Fed. R. Civ. P. 8(b)(3); TBMP § 311.02(a). Otherwise, “the defendant may make its denials as specific denials of designated allegations or paragraphs, or may generally deny all the allegations except those designated allegations or paragraphs which are expressly admitted.” TBMP § 311.02(a). If an answer fails to deny a portion of an allegation, that portion may be

deemed admitted. *See Grupo Marti, S.A. Grupo Marti, S.A. v. Marti's S.A.*, CANCELLATION 9204460, 2008 WL 9718104 (TTAB Jan. 31, 2008) (Exhibit A).

Here, Applicant sets forth in one prefatory paragraph, a “general denial” as to “each and every allegation set forth by Opposer in its Opposition.” (Dkt. 4 at p. 1.) Such “general denial” can hardly be said to have been made in good faith, as it necessarily extends to allegations concerning factual recitations from Applicant’s own MULAN V BEAUTY application. (Dkt. 1 at ¶¶8-10.) Further, by failing to specifically respond to Opposer’s allegations, Applicant does not provide Opposer or the Board with notice as to which of the allegations in this proceeding are genuinely disputed and/or which may not require discovery. *See* TBMP § 506.01 (“The primary purpose of pleadings . . . is to give fair notice of the claims or defenses asserted.”). Applicant’s general denial of “each and every allegation” should thus be stricken as improper and made in bad faith, and default judgment should be entered under Fed. R. Civ. P. 55<sup>1</sup> or, in the alternative, all allegations in the Notice of Opposition should be deemed admitted.

**B. Applicant’s Answer Should be Stricken as Improper, Insufficient, Immaterial, Impertinent, and Argumentative**

Alternatively, Applicant’s Answer should be stricken because it is improper, argumentative, and argues the merits of Opposer’s claim. Under Fed. R. Civ. P. 12(f), any insufficient defense or redundant, immaterial, impertinent, or scandalous matter may be stricken from a pleading. *See* TBMP § 506.01. Allegations that are argumentative and/or more in the nature of a brief on the merits than a responsive pleading do not comply with this rule, and are subject to a motion to strike. *See* TBMP

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<sup>1</sup> The Board may treat an improper and incomplete Answer as a default of the proceedings under Fed. R. Civ. P. 55. *See* 10A Wright & Miller, *Federal Practice and Procedure*, §2685 (1998) (The decision to enter default lies within the district court's discretion).

§ 311.02(a) (“The defendant should not argue the merits of the allegations in a complaint...”).

Nearly all paragraphs in Applicant’s Answer are either rife with impertinent statements, baselessly fault Opposer for not producing “evidence” to support its allegations, or contain improper arguments and accusations. For example, in Paragraph 4, Applicant argues that Opposer’s rights to MULAN did not include “cosmetics – or surely it would have also registered in that category to preserve its rights/brand.” (Dkt. 4 at ¶ 4.). In Paragraph 6, Applicant argues “if Opposer had any solid evidence of consumer confusion or actual damages it would have attached that evidence to its Opposition.” ( Id. at ¶ 6.) In Paragraph 7, moreover, Applicant argues “it would be a turn-off” if customers associated Applicant’s products with Opposer’s. (Id. at ¶ 7.)

Paragraphs 9-10 and 12 also attack the merits of Opposer’s claims and are similarly improper. For example, Paragraph 9 argues that the examining attorney had “found no conflicting marks that would bar registration” and Paragraph 10 alleges that “the use of the Disney Mark is buried deep in the product title.” (Id. at ¶¶ 9-10.). Further, Paragraph 12 argues that “[t]he Board should not allow Opposer to squat in random Classes” and accuses Opposer of a “Restraint of Trade violation.” (Id. at ¶ 12.).

Based on the foregoing, it is clear that Applicant’s argumentative Answer, including paragraphs 3 -12, is improper, and contrary to the mandate set forth by Fed. R. Civ. P. 8. See TBMP § 311.02(a) (“The defendant should not argue the merits of the allegations in a complaint....”).<sup>2</sup>

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<sup>2</sup> Applicant has not pleaded any affirmative defenses. However, to the extent any of its impertinent allegations are broadly construed as a defense, Opposer requests that they, too, be stricken for failing to

### III. CONCLUSION

For the reasons and authorities discussed above, Opposer respectfully requests that the Board grant Opposer's Motion to Strike Applicant's Answer & Enter Default Judgment.

Respectfully Submitted,

Dated: July 26, 2015

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provide specific notice of such defenses. *See* Fed. R. Civ. P. 8, (an affirmative defense must be specific enough to provide the opponent "fair notice" of the basis for the defense); *see also Ohio State Univ*, 51 USPQ2d at 1292 (primary purpose of pleadings "is to give fair notice of the claims or defenses asserted"); *IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009) (claim or defense must be specific enough to provide fair notice to adverse party); TBMP § 311.02(b).

**CERTIFICATE OF SERVICE**

I certify that a true and correct copy of the foregoing OPPOSER'S MOTION TO STRIKE APPLICANT'S ANSWER was served by first class mail, postage prepaid, on July 26, 2016, upon Applicant at the address below:

Ben McLane  
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/Larry L. White/  
Larry L. White  
Litigation Case Manager

# **EXHIBIT A**

2008 WL 9718104 (Trademark Tr. & App. Bd.)

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

GRUPO MARTI, S.A. GRUPO MARTI, S.A.

v.

MARTI'S S.A.

Cancellation No. 92044602

January 31, 2008

\*1 [Jyll S. Taylor](#)

Administrative Trademark Judge:

This case now comes up for consideration of petitioner's combined motion, filed July 12, 2007, for leave to file a second amended petition for cancellation and to strike respondent's affirmative defenses set forth in its answer to the first amended petition to cancel. Petitioner also seeks rulings by the Board directing respondent to file a "proper" answer to the second amended petition for cancellation and deeming "admitted" the allegations in paragraphs 3, 8, 9 and 10 of the second amended petition for cancellation. Also under consideration is petitioner's combined motion, filed July 17, 2007, to compel discovery, to test the sufficiency of responses to certain admission requests, and to reset the close of discovery pending disposition of the motion to compel.<sup>1</sup> Both motions have been fully briefed and petitioner has filed a reply brief in support of each motion. These replies have been considered in this decision.<sup>2</sup> See, e.g., *Harjo v. Pro-Football, Inc.*, 45 USPQ2d 1789, 1791 (TTAB 1998); *Avon Products, Inc. v. MarCon, Ltd.*, 225 USPQ 977, 979 (TTAB 1985).

#### Motion for Leave to File Second Amended Petition

We turn first to petitioner's motion for leave to file a second amended petition for cancellation. Petitioner seeks to amend its first amended petition for cancellation to add a claim of ownership of its pending application Serial No. 77213554<sup>3</sup> for the mark MARTI and to correct four typographical errors. In particular, paragraph 5 of the petition currently reads: "Petitioner intends to use and register the mark MARTI in the United States for retail sporting goods stores." Petitioner seeks to amend paragraph 5 by adding the following language: "Petitioner has filed Application Ser. No. 77/213,554 to register the mark MARTI for 'retail sporting goods stores.' 'DD' In addition, petitioner has proposed a new paragraph 6 which states: "Petitioner believes that Application Ser. No. 77/213,554 will be refused on the basis of Registration No. 1,866,585, just as petitioner's earlier application was refused." Petitioner also seeks to amend the date that its original service mark application for MARTI was filed and the name of the city in which respondent allegedly does business in Mexico.

In support of its proposed amendments, petitioner contends that the proposed amendments will clarify the issues, prevent confusion as to the basis of petitioner's claims, and narrow the scope of discovery. Further, petitioner asserts that its motion to amend is timely because the case is still in the discovery stage, and that entry of the proposed amendments will not violate settled law or prejudice the rights of respondent.

\*2 In opposition, respondent essentially argues that petitioner's motion is untimely and has been filed to delay these proceedings. Specifically, respondent argues *inter alia* that the proposed amendment to add the claim of ownership of the recently-filed trademark application would establish petitioner's standing, and that the issue of standing should have been addressed in November 2006 (when petitioner filed its first amended petition to cancel) in response to respondent's

answer, which set forth the affirmative defense of lack of standing; and that the amendment would be highly prejudicial to respondent because it would “establish” petitioner's standing for this proceeding.<sup>4</sup>

In reply, petitioner points out that it filed the subject motion less than three weeks after filing its application for registration of MARTI, within six days after respondent filed its answer to the first amended pleading (which revealed the four typographical errors), and long before the close of discovery. Petitioner also contends that it already has standing based on the rejection of its earlier-filed application.<sup>5</sup>

The Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment(s) would violate settled law, would be prejudicial to the rights of the adverse party or parties, or would serve no useful purpose. *Fed. R. Civ. P. 15(a)*. See *Polaris Industries v. DC Comics*, 59 USPQ2d 1789 (TTAB 2001); *Boral Ltd. v. FMC Corp.*, 59 USPQ2d 1701 (TTAB 2000); and *Institut National des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1896 (TTAB 1998); TBMP § 507.02 (2d ed. rev. 2004).

The timing of a motion for leave to amend under *Fed. R. Civ. P. 15(a)* is a major factor in determining whether the adverse party would be prejudiced by allowance of the proposed amendment. See *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993). For that reason, a motion for leave to amend should be filed as soon as any ground for such amendment becomes apparent. See 6 *Fed. Prac. & Proc. Civ.2d* § 1488 (2007); Chapman, “Tips from the TTAB: Amending Pleadings: The Right Stuff,” 81 *Trademark Reporter* 302, 307 (1991).

On review, as regards the typographical errors they only appeared in the first amended petitioner for cancellation. As regards petitioner's assertion of ownership of its subject trademark application, petitioner's motion was filed less than three weeks after the filing of the application, and thus, we find that there has been no undue delay in petitioner's filing of the motion to amend. Additionally, due to the suspensions of this proceeding following the filing of respondent's motion for summary judgment and the withdrawal of respondent's counsel, nearly five months remained in the discovery period at the time petitioner filed its motion. The Board also finds that allowing the amendment would not result in substantial prejudice to respondent. Notably, prejudice that warrants denying an amendment may be found by delay in bringing an amendment that denies the non-moving party an adequate opportunity to prepare its case on the new issues raised by the amended pleading, or results in the loss of valuable evidence or an important witness becoming unavailable. *Trek Bicycle Corporation v. Styletrek Limited*, 64 USPQ2d 1540, 1541 (TTAB 2001). See also *Wright & Miller*, 6 *Fed. Prac. & Proc. Civ.2d* § 1488 (2007). That is not the case at hand. Further, the proposed amendments merely correct typographical errors or amplify the allegations set forth in the original pleading and therefore are permissible. See *Avedis Zildjian Co. v. D.H. Baldwin Co.*, 180 USPQ 539, 541 (TTAB 1973).

\*3 We also find respondent's argument that petitioner filed the motion to amend to delay this proceeding so that it could establish its standing without merit. Petitioner has had standing to bring this proceeding since it filed its petition for cancellation. See *infra*, pages 10-12. Further, inasmuch as respondent did not file a separate motion to dismiss under Section 12(b)(6) for failure to state a claim based on lack of standing, petitioner was under no obligation to respond to respondent's affirmative defenses. See *Trademark Rule 2.114(b)(1)*, 37 C.F.R. § 2.114(b)(1). (A reply to an affirmative defense need not be filed.)

In view thereof, petitioner's motion for leave to file a second amended petition for cancellation is **granted** and petitioner's second amended petition for cancellation is now petitioner's operative pleading in this case. Respondent is allowed until **THIRTY DAYS** from the mailing date of this order to file an answer thereto.

#### Petitioner's Motion to Strike

By this order, the Board has granted petitioner's motion to amend and the second amended petition for cancellation is now petitioner's pleading of record. Accordingly, petitioner's motion to strike the affirmative defenses set forth in

respondent's answer to petitioner's first amended petition to cancel is moot, respondent having been allowed, by this order, time to file an answer to the second amended petition. However, and as recognized by petitioner, respondent's answer to the petitioner's current pleading will presumably include the same affirmative defenses. As such, we will address them in this decision.

The affirmative defenses set forth in respondent's answer to the first amended petition for cancellation are as follows:

“First Affirmative Defense. The Amended Petition for Cancellation fails to state a claim upon which relief may be granted. Therefore, in accordance with [Fed. R. Civ. P. 12\(b\)\(6\)](#) the Amended Petition for Cancellation should be dismissed for failure to state a claim upon which relief can be granted because Petitioner has failed to demonstrate Registrant's failure to use the mark in commerce.”

Second Affirmative Defense. The Amended Petition for Cancellation should be denied on the ground of laches. Petitioner has acquiescence to Registrant's mark since Petitioner failed to object to Registrant's mark for a long time since abandoning its claimed application on “October 10, 1994.” Registrant has built up a valuable business under its mark, and would be prejudiced.

Third Affirmative Defense. The Amended Petition for Cancellation should be denied on the ground that Petition lacks standing to bring this Petition.”

We first discuss respondent's first and third affirmative defenses. As regards respondent's claim that the petition fails to state a claim upon which relief may be granted, we must consider whether the petition for cancellation sets forth facts which, if proved, would establish that (1) petitioner has standing to challenge the continued presence on the register of the named registration and (2) petitioner has set forth a valid ground why registrant is not entitled to maintain its registration. The purpose of a motion to dismiss or defense under [Rule 12\(b\)\(6\)](#) is to test the formal sufficiency of the statement of the claim for relief. See *Wright & Miller*, 5B Fed. Prac. & Proc. Civ.3d § 1356 (2007).

\*4 Standing at the pleading stage is reviewed by determining whether petitioner has alleged facts, which if later proven, would establish that petitioner has a real interest in the proceeding. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 213 USPQ 185 (CCPA 1982); and *The Hartwell Company v. James A. Shane*, 17 USPQ2d 1569, 1570 (TTAB 1990). Further, all well pleaded allegations of the nonmoving party must be accepted as true. See *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048 (TTAB 1992). The facts so pled must be sufficient to show a personal interest in the outcome of the case beyond that of the general public. See *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, (Fed. Cir. 1987); *International Order of Job's Daughters v. Lindeburg and Company*, 727 F2d. 1087, 220 USPQ1017 (Fed. Cir. 1984).

In petitioner's second amended petition for cancellation, which we have now accepted as its pleading of record, petitioner alleges that it intends to use and register the mark MARTI in the United States for retail sporting goods stores; that its prior service mark application for the same mark was refused on the basis of respondent's service mark registration (U.S. Reg. No. 1866585) for the mark MARTIS;<sup>6</sup> that petitioner has filed application Serial No. 77213554 to register the mark MARTIS for “retail sporting goods stores”; and that petitioner believes that said application will be refused on the basis of respondent's registration, just as petitioner's previous application was refused.

We find that petitioner's allegations of intent to do business in the United States and its filing of a service mark application based on its *bona fide* intent to use the mark in commerce, when coupled with an allegation of a reasonable basis for its belief that it will be damaged by the continued existence of respondent's registration sought to be cancelled or partially cancelled, set forth a legally sufficient pleading of standing, namely, petitioner's real interest in the proceeding beyond that of the general public.

Petitioner has also alleged that respondent has abandoned its mark inasmuch as respondent does not use its mark in connection with “retail department stores services” in the United States. Further, petitioner alleges under Section 18 of the Trademark Act, [15 U.S.C. § 1068](#), that restriction of the services set forth in the registration would avoid a finding of likelihood of confusion and permit petitioner's application to move forward to registration. Proof of these allegations, of course, is a matter for trial. See *American Vitamin Products Inc. v. DowBrands Inc.*, [22 USPQ2d 1313, 1314 \(TTAB 1992\)](#). See also *Flatley v. Trump*, [11 USPQ2d 1284, 1286 \(TTAB 1989\)](#).

\*5 In view thereof, inasmuch as the second amended petition for cancellation includes sufficient allegations to show that petitioner has standing and a valid ground for cancellation, respondent's first and third affirmative defenses would be without merit.

We next consider respondent's second affirmative defense of laches. It is well established that the equitable defense of laches is not available against claims of genericness, descriptiveness, fraud and abandonment. *Saint-Gobain Abrasives, Inc. v. Unova Industrial Automation Systems Inc.*, [66 USPQ2d 1355, 1359 \(TTAB 2003\)](#), citing *TBC Corp. v. Grand Prix Ltd.*, [12 USPQ2d 1311 \(TTAB 1989\)](#) and related cases. Inasmuch as petitioner's pleading is based on respondent's alleged abandonment of its mark, respondent's second affirmative defense of laches similarly would be without merit.

Accordingly, these defenses should not be included in respondent's answer to the second amended petition for cancellation.

#### Motion to Deem Allegations in Answer Admitted

Petitioner also sought an order stating that the allegations set forth in paragraphs 3, 8, 9 and 10 of the second amended petition for cancellation are deemed admitted. As previously noted, respondent has yet to answer the second amended petition for cancellation.

We nonetheless remind respondent that it is incumbent on it to respond to each allegation of the second amended petition by either admitting the truth of the allegation or denying that the allegation is true. A denial of an allegation should fairly meet the substance of the allegation denied, and the denial may take any of the forms described in [Fed. R. Civ. P. 8\(b\)](#). See [Trademark Rule 2.114\(b\)\(1\), 37 C.F.R. § 2.114\(b\)\(1\)](#). If an answer fails to deny a portion of an allegation, that portion may be deemed admitted. [Fed. R. Civ. P. 8\(b\)](#).

For example, on review of respondent's answers to ¶¶3 and 8 of the first amended petition for cancellation, we note that respondent clearly denies petitioner's allegations therein in compliance with [Fed. R. Civ. Rule 8\(b\)](#). However, we note that respondent has failed to either admit or deny the allegations set forth in ¶¶9 and 10 of the first amended petition for cancellation, as required by [Fed. R. Civ. P. 8\(b\)](#). Specifically, paragraph 9 of the first amended petition states as follows:

“9. On information and belief, registrant does not operate, and has never operated, a retail department store located in the United States.”

In the answer, respondent first states, “in the past, it did not operate a retail department store located in the United States.” Respondent then makes various factual allegations and argument, admits and denies allegations not set forth in the allegation, and “denies the remaining allegations.” The response is non-responsive because it does not directly address the allegation, i.e., registrant does not operate, and has never operated, a retail department store in the United States. Similarly, the response to the allegation set forth in ¶10 of the pleading does not clearly admit or deny that allegation.

#### Petitioner's Motion to Compel and to Test the Sufficiency of Responses to Admission Requests

\*6 Petitioner seeks an order compelling responses to its first set of interrogatories and first set of document requests, served on respondent on June 29, 2005, and to which respondent has provided no responses. In connection with the motion to compel, petitioner also requests that registrant be required to respond to the interrogatories and document requests as put, and that respondent be required to mail photocopies of required documents to petitioner's counsel. Petitioner also moves to test the sufficiency of respondent's responses to certain admission requests, specifically, request nos. 1, 2 and 4, and requests that the Board deem those statements admitted under [Fed. R. Civ. P. 36\(a\)](#) and [Trademark Rule 2.120\(h\)\(1\)](#).

#### Good Faith Requirement

[Trademark Rules 2.120\(e\)\(1\) and 2.120\(h\)\(1\)](#), [37 C.F.R. §§ 2.120\(e\)\(1\) and 2.120\(h\)\(1\)](#), require that a motion to compel and a motion to test the sufficiency of answers to requests for admission 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 by the motion, and has been unable to reach an agreement. See [TBMP § 532.02 \(2d ed. rev. 2004\)](#).

The Board finds that petitioner has shown that it has sought to resolve amicably the discovery disputes with respondent by seeking to communicate with respondent's new counsel by telephone and by written or electronic mail. Further, there is no record of any response by respondent's counsel to petitioner's counsel's correspondence or messages concerning the previously served interrogatories and document requests or the responses to petitioner's requests for admission.<sup>7</sup> Accordingly, the Board finds that petitioner has complied with the requirements set forth in [Trademark Rules 2.120\(e\)\(1\) and 2.120\(h\)\(1\)](#). See [Envirotech Corp. v. Compagnie Des Lampes](#), 219 USPQ 448, 450 (TTAB 1979).

#### a. Motion to Compel

Petitioner argues in support of its motion to compel that over two years have passed since its served its interrogatories and document requests on respondent, and that respondent has failed to indicate when, if ever, it plans to serve its responses to the outstanding requests.

In opposition, respondent argues that it did not know “the nature and scope of the requests” until petitioner filed the motion to compel, and that it has “sought at every turn to be forthcoming in the discovery process.” Respondent also alleges that petitioner's counsel “never told” respondent's new counsel that discovery was outstanding. In reply, petitioner denies that respondent's counsel was uninformed and reiterates that said counsel did not respond to petitioner's letter of June 15, 2007, follow-up email, voice mail messages or messages left with the assistant to respondent's counsel.

\*7 In considering whether petitioner's motion to compel should be granted and, in particular, if said motion were granted, whether respondent should be required to respond to the outstanding discovery as put, a review of the relevant history of this proceeding is appropriate. The Board notes that this proceeding was suspended for approximately eleven months one week prior to the original due date for serving the responses to the interrogatories and requests for production of documents; that, subsequent to said suspension period, the parties filed two consented motions to extend the discovery and testimony periods and agreed informally to extend the discovery due date until December 4, 2006; that this proceeding was effectively suspended approximately three weeks prior to said agreed upon due date for serving the discovery responses upon the resignation of respondent's prior counsel; that over five months elapsed (from November, 15, 2006 until April 26, 2007) between the time respondent's first counsel filed a motion to withdraw and respondent's new counsel made an appearance; and that this proceeding was not resumed until June 12, 2007. Notably, no new deadline for responding to the outstanding discovery was set by the Board upon resumption of this proceeding following the appointment by respondent of new counsel. Nor was a new due date agreed upon by the parties.

Respondent states that it does not request any relief from its discovery obligations, but only requests that the Board allow enough time to provide the discovery sought. However, neither party has notified the Board that respondent has responded to petitioner's discovery requests since the filing of the subject motion to compel.

Because the Board finds that respondent has had more than adequate time to respond to petitioner's outstanding interrogatories and document requests, petitioner's motion to compel is **granted** to the extent that respondent is ordered to, no later than **THIRTY DAYS** from the mailing date of this order, serve on petitioner its responses to petitioner's outstanding discovery requests. However, because the due date for its responses was not reset upon the last resumption of this proceeding, and given the change of counsel and resulting confusion as to the status of discovery, we find that respondent has not forfeited its right to interpose objections to the requests.

Also, petitioner's request that respondent be ordered to mail photocopies of responsive documents to petitioner's counsel is **denied** as unwarranted on this record.

We feel compelled to add that, with respect to the manner of production in Board cases, parties often extend each other the courtesy of copying documents and materials responsive to their respective requests for production; they then forward the copies to the requesting party. Notwithstanding the practicality of this approach, a responding party is within its right to choose, instead, to make documents available for copying and inspection, as they are kept in the usual course of business, by the inquiring party.

a. (i) Protective Order

\*8 In regards to any discovery served by the parties, petitioner and respondent should note that this proceeding is governed by [Trademark Rule 2.116\(g\)](#), [37 C.F.R. § 2.116\(g\)](#) (effective August 31, 2007), which provides that the Board's standard protective order is made applicable to all TTAB *inter partes* cases.<sup>8</sup>

a. (ii) Potential Claims of Privilege

With respect to any potential claim of privilege, a “privilege log” is expected unless the parties otherwise agree. *See Fed. R. Civ. P. 26(b)(5)*; and *Wright & Miller*, 8 *Fed. Prac. & Pro. Civ.2d* § 2016.1 (2007).

b. Motion to Test Sufficiency of Responses

Petitioner also requests that the Board test the sufficiency of respondent's responses to request for admissions, nos. 1, 2 and 4.<sup>9</sup> To the extent that petitioner requests that the Board “deem admitted” respondent's responses to the statements therein, such request is unwarranted on this record inasmuch as respondent has provided a responses to these requests and the sufficiency of the responses has yet to be determined. *See Fed. R. Civ. P. 36(a)*.<sup>10</sup> Accordingly, the Board will only review whether respondent's responses are sufficient. *See TBMP* § 524 (2d ed. rev. 2004).

In support of its motion, petitioner contends that respondent did not admit, deny, or state in detail the reasons why it cannot truthfully admit or deny the matter set forth in Requests Nos. 1, 2 and 4. Petitioner essentially argues that while respondent admits it has an online retail store service “in commerce in the United States,” such a response is not directly responsive to the statements posed regarding respondent's retail store that is allegedly located in the United States.

Respondent, in opposition to the motion, essentially argues that its answers are sufficient inasmuch as it has formally objected to the terms “operate,” “retail store,” “retail department store” and “located,” and petitioner failed to clarify those terms.

In reply, petitioner states that respondent did not request clarification from petitioner as regards the terms in question, and also failed to respond to petitioner's written requests for amendment of respondent's responses to the admission requests.

After careful review, we find that respondent's responses to petitioner's request for admissions nos. 1, 2 and 4 are ambiguous, at best, because respondent neither admits nor denies petitioner's propounded statements, nor has respondent set forth in detail the reasons why it cannot truthfully admit or deny the matter.<sup>11</sup> Further, to the extent that the wording "retail store located in" is unclear to respondent, that wording is understood to refer to a "brick and mortar" store, *i.e.* one having an actual physical location.

\*9 In view thereof, petitioner's motion to test the sufficiency of respondent's responses to its request for admissions nos. 1, 2 and 4 is **granted**. Respondent is hereby ordered to serve, no later than **THIRTY DAYS** from the mailing date of this order, substitute answers to admission request nos. 1, 2 and 4 which comply with the above, failing which those requests may be deemed admitted.

#### Discovery Guidelines; Duty of Good Faith; Duty to Supplement

The Board reminds the parties that discovery guidelines covering a variety of matters are found at TBMP § 414 (2d ed. rev. 2004). Such guidelines are not exhaustive, but may offer the parties some assistance in the scope of discovery requests and the nature of any responses thereto.

Each party is reminded that it has a duty to make a good faith effort to satisfy the discovery needs of its adversary. *See* TBMP §§ 402.01 and 408.01 (2d ed. rev. 2004). A party served with a discovery request 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. *Id.* at § 408.02.

The parties are also reminded of the duty to supplement discovery responses in proceedings before the Board. Under [Fed. R. Civ. P. 26\(e\)\(2\)](#), a party, which has responded to a request for discovery, with a response, is under a duty to supplement or correct the response to include information thereafter acquired under the particular circumstances specified in paragraph (e)(2). *See* TBMP § 408.03. (2d ed. rev. 2004). This duty extends beyond the close of discovery.

Where complete compliance with a particular request would be unduly burdensome, a representative sampling may be provided. TBMP § 414(2) (2d ed. rev. 2004). In addition, an explanation must be made describing why the request is unduly burdensome. (For example, the responding party has tens of thousands of documents spanning decades.) It is the responsibility of the objecting party to explain why any posed objection applies, and failure to do so may result in an objection being overruled. Furthermore, a production of "representative" documents must truly be a representative sampling, and not merely a self-serving selection of favorable documents. *See, e.g., The Procter & Gamble Company v. Keystone Automotive Warehouse, Inc.*, 191 USPQ 468 (TTAB 1976). An evasive or incomplete response is the equivalent of a failure to disclose. [Fed. R. Civ. P. 26\(g\)](#) and [37\(a\)\(3\)](#).

Last, the parties are cautioned that if a party provides an incomplete response to a discovery request, that party, upon a timely raised objection, may not thereafter rely at trial on information from its records which was properly sought in the discovery request, but which was not included in the response thereto, unless the response is supplemented in a timely fashion pursuant to [Fed. R. Civ. P. 26\(e\)](#). *See* [Bison Corp. v. Perfecta Chemie B.V.](#), 4 USPQ2d 1718 (TTAB 1987); and TBMP §408.02.

#### Dates Reset; Proceeding Resumed

\*10 In sum, petitioner's motion for leave to amend file a second amended petition for cancellation is **granted** and respondent is allowed until **THIRTY DAYS** from the date of this order to file an answer thereto; petitioner's motion to strike is **moot**; petitioner's motion to compel is **granted to the extent** that respondent is ordered to serve its responses to petitioner's outstanding discovery requests no later than **THIRTY DAYS** from the mailing date of this order; and petitioner's motion to test the sufficiency of certain admission requests is **granted**.

All matters having been decided, proceedings herein are **RESUMED**. Trial dates, including the close of discovery, are reset as follows:

DISCOVERY PERIOD TO CLOSE:	July 1, 2008
Thirty-day testimony period for party in position of plaintiff to close:	September 29, 2008
Thirty-day testimony period for party in position of defendant to close:	November 28, 2008
Fifteen-day rebuttal testimony period to close:	January 12, 2009

**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. *See* Trademark Rule 2.125, [37 C.F.R. §2.125](#).

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b), [37 C.F.R. §§2.125\(a\) and \(b\)](#). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129, [37 C.F.R. §2.129](#).

#### **NEWS FROM THE TTAB:**

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at [72 F.R. 42242](#). By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>

\*11 [http://www.uspto.gov/web/offices/com/sol/notices/72fr42242\\_FinalRuleChart.pdf](http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf)

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>

Footnotes

1 Petitioner also requested that the Board suspend this proceeding pending decision on the motion to compel. Although the  
Board did not issue a suspension order, proceedings are considered to have been suspended since the filing date of the motion  
to compel. *See Trademark Rules 2.120(e)(2) and 2.120(h)(2); 37 C.F.R. § 2.120(e)(2) and 2.120(h)(2)*. Accordingly, petitioner's  
request will not be further considered.

2 \* \* \*

3 Application Serial No. 77213554, filed June 22, 2007, based on applicant's alleged *bona fide* intent to use the mark in commerce,  
for use in connection with "retail sporting goods stores," and claiming priority under Section 44(d), 15 U.S.C. § 1126(d), in  
connection with its application no. 862911 filed in Mexico on June 20, 2007.

4 Respondent also extensively argued that petitioner's motion to amend is untimely under *Fed. R. Civ. P. Rule 16(b)*.  
Respondent's argument is not well taken inasmuch as *Rule 16(b)* clearly does not apply to Board proceedings. *See TBMP*  
§ 401 (2d ed. rev. 2004). *See also Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242,*  
*42245 (2007)*(effective August 31, 2007 and November 1, 2007, and to be codified at 37 C.F.R. Part 2.

5 Petitioner's first application for the mark MARTI for "retail sporting goods store services," Serial No. 74583550, was filed on  
October 7, 1994 based on petitioner's *bona fide* intent to use the mark in commerce and was abandoned on May 13, 1999.

6 These two assertions establish that petitioner has a real interest in the proceeding.

7 Notably, respondent's counsel does not state that he did not receive the June 15, 2007 letter or July 5, 2007 email from  
petitioner's counsel.

8 In view thereof, petitioner's request for imposition of the Board's protective order is moot. Moreover, petitioner's request, set  
forth for the first time in its reply brief, would not have been considered. *See TBMP § 502.02(b)* (2d ed. rev. 2004).

9 Petitioner's admission requests nos. 1, 2 and 4 are as follows:

Request No. 1: Registrant does not operate a retail store located in the United States; Request No. 2: Registrant has never  
operated a retail store located in the United States; and Request No. 4: Registrant's only retail store is located in Nuevo  
Laredo, Mexico.

10 Moreover, the Board does not find that the responses are late inasmuch as petitioner served said requests for admission  
on respondent after its counsel filed a motion to withdraw and respondent's new counsel served the responses shortly after  
entering an appearance with the Board.

11 Further, it is not apparent to the Board how the words and phrases, "operate," "retail store," "retail department store,"  
and "located," are unclear. *See, e.g.*, reference to "retail department stores" in the USPTO's *US Acceptable Identification*  
*of Goods and Services Manual*, which may be reviewed at the following web address: [http://tess2.uspto.gov/netacgi/  
nphbrs?sect2=THESOFF&sect3=PLURON&pg1=ALL&s1=retail+department&l=MAX&sect1=IDMLICON&sect4=  
HITOFF&op1=AND&d=TIDM&p=1&u=%2Fnethtml%2Ftidm.html&r=0&f=S](http://tess2.uspto.gov/netacgi/nphbrs?sect2=THESOFF&sect3=PLURON&pg1=ALL&s1=retail+department&l=MAX&sect1=IDMLICON&sect4=HITOFF&op1=AND&d=TIDM&p=1&u=%2Fnethtml%2Ftidm.html&r=0&f=S).

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