

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Baxley

Mailed: January 29, 2004

Cancellation No. 92041652

AMERICAN RICE, INC.

v.

DUNMORE PROPERTIES S.A.

Andrew P. Baxley, Interlocutory Attorney:

This case now comes up for consideration of petitioner's motion (filed August 18, 2003) to compel discovery. The motion has been fully briefed.¹

After reviewing the parties' arguments and submissions with respect to the motion to compel, the Board finds that petitioner did not satisfy its obligation under Trademark Rule 2.120(e) to make a good faith effort to resolve the issues presented therein prior to seeking the Board's intervention. The Board notes that, after petitioner received respondent's responses to its written discovery requests, petitioner's attorney had a single telephone discussion with respondent's attorney with regard to the alleged deficiencies in applicant's responses and, in that discussion, does not appear to have discussed specific

¹ Inasmuch as petitioner's reply brief clarifies the issues before the Board, the Board, in its discretion, has considered the reply brief. See Trademark Rule 2.127(a).

Opposition No. 92041652

deficiencies in those responses. Further, the Board notes that petitioner alleges that respondent's responses to all thirty-three of its requests for production are deficient. Based on the substantial number of discovery requests at issue, it is clear to the Board that petitioner failed to make a genuine, good faith effort to resolve by agreement the issues raised in the motion to compel.

Where the parties disagree as to the propriety of certain requests for discovery, they are under an obligation to get together and attempt in good faith to resolve the 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, it is the Board's policy 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 number of disputed requests to a reasonable number. See *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666 (TTAB 1986). Many of the issues presented in the motion to compel should be resolved without

Opposition No. 92041652

Board intervention,² and the Board strongly urges that the parties make greater effort to avoid or resolve such controversies.

In view thereof, petitioner's motion to compel is hereby denied without prejudice.

Nonetheless, respondent is reminded that a party which has responded to a discovery request has a duty to supplement or correct that response. See Fed. R. Civ. P. 26(e). Respondent is also reminded that, when a party, without substantial justification, fails to disclose information required, or fails to amend or supplement a prior response, as required, that party may be prohibited from using as evidence the information not so disclosed. See Fed. R. Civ. P. 37(c)(1).

Proceedings are hereby resumed. The parties are allowed until **thirty days** from the mailing date of this order to serve responses to any outstanding discovery requests.³ Discovery and trial dates reset as follows:

DISCOVERY PERIOD TO CLOSE: 4/2/04

² The parties are directed to review carefully TBMP Section 414 (2d ed. June 2003) regarding the discoverability of various matters in Board *inter partes* proceedings.

³ The parties are advised, however, that this statement does not constitute an order relating to discovery, as contemplated by Trademark Rule 2.120(g)(1). See TBMP Section 527.01. Accordingly, each party's remedy for failure to comply with this statement is to file a motion to compel. See Trademark Rule 2.120(e)(1); TBMP Section 523 (2d ed. June 2003).

Opposition No. 92041652

Plaintiff's thirty-day testimony period to close: **7/1/04**

Defendant's thirty-day testimony period to close: **8/30/04**

Fifteen-day rebuttal testimony period to close: **10/14/04**

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 Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.