

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: June 14, 2005

Opposition No. 92042614

Jackson/Charvel
Manufacturing, Inc.

v.

Prins, Lloyd A.

Nancy L. Omelko, Interlocutory Attorney:

With discovery closed and petitioner's testimony period yet to open, this case now comes up on respondent's motion (filed December 13, 2004) to compel discovery; and petitioner's combined motion (filed January 4, 2005) to compel discovery and to test the sufficiency of respondent's responses to petitioner's requests for admissions.

Cross Motions To Compel

We turn first to respondent's motion to compel. Petitioner has filed a response thereto, in which it argues that respondent has failed to certify his good faith effort to resolve the discovery disputes and that, in fact, has failed to make a good faith effort. The Board has reviewed the arguments of both parties and agree with petitioner that no good faith effort has been made by respondent to resolve the discovery disputes before bringing its motion to compel

to this Board as required by Trademark Rule 2.120(e)..

Accordingly, respondent's motion to compel is denied.

We turn next to petitioner's motion to compel respondent to fully and completely answer petitioner's Interrogatory Nos. 1-7, 10-15, 19, 21, 23, 28, 30 and 31; and produce documents in response to petitioner's Document Request Nos. 21, 22, 26-30, 37 and 38.

In the clear from the number of interrogatories and document requests presented by petitioner in its motion that petitioner has failed to make a good faith effort to resolve by agreement the issues raised by petitioner in its motion to compel. Petitioner has asked that the Board consider nineteen of thirty-two interrogatories; and nine of its forty-three document requests, that is, twenty-eight discovery requests out of seventy-five still in dispute. Accordingly, petitioner's motion to compel responses to its first set of interrogatories and first set of document requests is denied.

Scope of Discovery:

That having been said, it is clear that pro se respondent is unfamiliar with discovery practice before the Board, especially where it diverges from discovery practice under the Federal Rules of Civil Procedure. Respondent is directed to Chapter 400 of the Trademark Board Manual of Procedure. (2d. ed, rev. 2004).

As provided by Fed. R. Civ. P. 33 and 26(b), the parties may obtain discovery regarding any matter, not privileged, which is relevant to the subject matter involved in the pending action. Fed. R. Civ. P. 26 governs the scope of document requests served by either party under Fed. R. Civ. P. 34, and provides that parties may obtain discovery regarding any matter, not privileged, which is relevant to the subject matter involved in the pending action. It has been generally held in this regard that the requirement of relevancy must be construed liberally and that discovery should, therefore, be generously allowed unless it is clear beyond a reasonable doubt, that the information which is sought can have no possible bearing upon the issues involved in the particular proceeding. See also *Johnston Pump/General Valve Inc. V. Chromalloy American Corp.*, supra. Therefore a party may take discovery not only as to matters specifically raised in the pleadings (see *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581 (TTAB 1975), and *Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 181 USPQ 286 (TTAB 1974)), but also as to any matter which might serve as the basis for an additional claim, defense, or counterclaim. See *J. B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577 (TTAB 1975); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167 (TTAB 1975); and *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184 (TTAB 1974). See TBMP 402.01. However,

generally a party need not provide discovery with respect to those of its marks and goods/services which are not involved in the proceeding and have no relevance thereto. See *TBC Corp. v. Grand Prix Ltd.*, 16 USPQ2d 13899 (TTAB 1990).

Respondent is specifically directed to TBMP § 414 (2d. ed., rev. 2004) for guidelines concerning discovery. For example, (4) Information concerning a party's selection and adoption of its involved mark is generally discoverable; and (7) A party need not, in advance of trial, specify in detail the evidence it intends to present, or identify the witnesses it intends to call, except that the names of expert witnesses intended to be called are discoverable.

The parties are allowed **thirty days** from the date of this order to make a good faith effort to resolve these discovery disputes and supplement their responses to discovery requests where warranted.

Stipulated Protective Order:

To the extent that the parties deem any of the requested discovery herein to be of a confidential or proprietary nature, the parties may provide this discovery pursuant to an appropriate protective order. See, for example FRCP 26(c); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671 (TTAB 1988); *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147 (TTAB 1985). In this connection, the Board refers the

parties to the Standardized Protective Agreement created by the Board which can be found at the USPTO website, www.uspto.gov/web/office/dcom/ttab/ttabdocs.htm. The parties may use this agreement in its entirety, or as a template for their own document. The parties are allowed **thirty days** from the date of this order to sign a protective agreement and file a copy of same with the Board. If the parties are unable to agree on a protective agreement, the Board may impose one on them.

Motion To Test Sufficiency of Response to Admission Requests

Petitioner requests that Admission Requests Nos. 11, 16, 21, 22 and 38 be deemed admitted due to respondent's failure to sufficiently answer the requests.

• **Request No. 11**

Jackson/Charvel used the SAN DIMAS mark in connection with the sales of guitars in 2003.

Answer: Denied

Petitioner argues that respondent affirmatively stated, in response to Interrogatory No. 23, "[d]escribe and explain Prins' understanding and contentions relating to when and how Jackson/Charvel used the mark SAN DIMAS," that petitioner used the term SAN DIMAS in a trademark in 2003. Petitioner argues that this statement contradicts respondent's denial of this admission request.

A motion to test the sufficiency of an admission goes to the sufficiency of the admission, not to its veracity. To the extent, if any, that respondent's answer to an interrogatory may be inconsistent with a denial of this request for admission is not the issue. Respondent's response Admission Request No. 11 is deemed sufficient.

- **Request No. 16**

Jackson/Charvel has not authorized Prins to incorporate the SAN DIMAS mark into any of Prins' marks.

Answer: Prins cannot truthfully admit or deny this request as Prins contends that Jackson/Charvel has no rights to a San Dimas mark that entitles Jackson/Charvel to grant such authorization.

- **Request No. 21**

Jackson/Charvel has not authorized Prins to use the SAN DIMAS mark.

Answer: Prins cannot truthfully admit or deny this request as Prins contends that Jackson/Charvel has no rights to a San Dimas mark that entitles Jackson/Charvel to grant such authorization.

- **Request No. 22**

Jackson/Charvel has not authorized Prins to use the SAN DIMAS mark in connection with Prins' guitar products.

Answer: Prins cannot truthfully admit or deny this request as Prins contends that Jackson/Charvel has no rights to a

Cancellation No. 92042614

San Dimas mark that entitles Jackson/Charvel to grant such authorization.

- **Request No. 38**

Prins' SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY mark is likely to cause confusion with Jackson/Charvel's SAN DIMAS mark.

Answer: Prins cannot truthfully admit or deny this request as Prins contends that Jackson/Charvel has no rights to a San Dimas mark that entitles Jackson/Charvel to grant such authorization.

As to Admission Requests Nos. 16, 21, 22 and 38, respondent has set forth in detail why respondent cannot admit or deny these requests. See Wright & Miller. *Federal Practice and Procedure*: Civil 2d § 2261 (1999).

Accordingly, respondent's responses to Admission Requests Nos. 16, 21, 22 and 38 are deemed sufficient.

Accordingly, proceedings herein are resumed and trial dates are reset as follows:

THE PERIOD FOR DISCOVERY TO CLOSE:	CLOSED
30-day testimony period for party in position of plaintiff to close:	September 15, 2005
30-day testimony period for party in position of defendant to close:	November 14, 2005
15-day rebuttal testimony period to close:	December 29, 2005

Cancellation No. 92042614

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.