

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

Mailed: November 7, 2008

Cancellation No. 92044624

J. Christopher Carnovale

v.

The Brand Experience LLC

Jennifer Krisp, Interlocutory Attorney:

This proceeding is before the Board for consideration of petitioner's motion (filed August 14, 2008) to compel discovery. The motion is fully briefed.

On November 4, 2008, the Board convened a telephone conference in order to resolve and rule on the issues presented in the motion. Participating were Michael Grow, counsel for petitioner, Wayne Harper, counsel for respondent, and the above-assigned interlocutory attorney.

Petitioner's motion is in compliance with Trademark Rule 2.120(e) inasmuch as it is timely, is supported by a showing of a good faith effort to resolve, by communication, the underlying discovery dispute, and includes a copy of the discovery requests at issue.

Initially, the Board notes that respondent interposed an objection to several discovery requests which was based on the lack of and/or insufficiency of a confidentiality

agreement between the parties. Respondent's objections are misplaced. As the Board informed the parties at page 2 of its July 19, 2008 order, and page 2 of its August 21, 2008 suspension order, and as restated during the conference with counsels, the Board's standard protective order is applicable to all inter partes proceedings pending or commenced on or after August 31, 2007, and thus has been imposed on the parties to this proceeding as of that date. See Trademark Rule 2.116(g). As the Board has noted, "(A)bsent a stipulation to vary the terms of the standard protective order, approved by the Board, or an order by the Board granting a party's motion to use an alternative order, the parties must abide by the standard order." See *Notice of Final Rulemaking, Miscellaneous Changes to Trademark Trial and Appeal Board Rules*, 72 Fed. Reg. 42242, 42244 (Aug. 1, 2007).

Respondent's objections based on relevancy are similarly unpersuasive. The Board finds that the discovery sought by petitioner is relevant to its claims and is neither unreasonably cumulative nor unduly burdensome.

Furthermore, answers to interrogatories must be signed by the person making them, and objections to interrogatories must be signed by the attorney making them. Fed. R. Civ. P. 33(b)(2). See also TBMP §§ 405.04(b) and (c) (2d ed. rev. 2004). Accordingly, respondent must properly verify all

responses to interrogatories which respondent is directed to provide under this order.

Interrogatories

Petitioner seeks complete or more sufficient answers to its First Set of Interrogatories with respect to its Interrogatories Nos. 2, 4, 6, 7, 8, 9, 10, 11, 13, 15, 16, 20, 22, 25, 27, 28, 30 and 31. Petitioner states that, in instances where respondent states, in its brief in opposition to the motion to compel, that respondent has provided or will provide the information sought, petitioner has not received such information.

With respect to Interrogatory No. 2, the Board finds that respondent's answer, provided in its brief in opposition to the motion to compel, is adequate. However, respondent is directed to repeat and to properly verify its response to Interrogatory No. 2.

Respondent is directed to provide verified answers in full to Interrogatories Nos. 4, 6, 7, 8, 9, 10, 11, 13, 15, 16, 20, 22, 25, 27, 28, 30, and 31. If respondent, in its answer to any such interrogatory, states that one or more documents, or information in document form, are responsive thereto, respondent must specifically identify each document, as well as specific pages or portions thereof, as appropriate, by Bates stamp number or by other means which

includes sufficient detail to permit petitioner to readily locate and identify respondent's answer.

Request for Production of Documents

Petitioner seeks answers and documents in response to its First Request for Production, which comprises Document Requests Nos. 1 through 37.

Petitioner's motion is denied with respect to Document Request No. 32 inasmuch as the names of customers are not discoverable. See TBMP § 414(3) (2d ed. rev. 2004).

Petitioner's motion is granted with respect to Document Requests Nos. 1 through 37, exclusive of Document Request No. 32. Respondent is directed to respond in full to, and to provide the documents requested in Document Requests Nos. 1 through 37. Where providing documents, or information in document form, respondent must specifically identify each document, as well as specific pages or portions thereof, as appropriate, by Bates stamp number or by other means which includes sufficient detail to permit petitioner to readily locate and identify respondent's answer.

Accordingly, petitioner's motion to compel is granted to the extent indicated herein. Respondent is directed, within thirty (30) days of the mailing date of this order, to serve on petitioner verified responses, in full and without objection on the merits thereof, to petitioner's discovery requests as directed herein. See *No Fear Inc. v.*

Rule, 54 USPQ2d 1551, 1554 (TTAB 2000). Petitioner is thereafter allowed a unilateral thirty (30) day discovery period for the sole purpose of permitting petitioner to conduct follow-up discovery after review of respondent's discovery responses.

Both parties are reminded that a party that has responded to discovery requests has a continuing duty to supplement or correct such responses. See Fed. R. Civ. P. 26(e). See also TBMP § 408.03 (2d ed. rev. 2004).

Finally, both parties are placed on notice that the Board expects parties and their attorneys or other authorized representatives to cooperate with one another in the discovery process, and notes with extreme disfavor those parties who do not. Each party and its attorney or other authorized representative has a duty to make a good faith effort to satisfy the discovery needs of its adversary, and to seek only such discovery as is proper and relevant to the issues in the case. See TBMP § 402.01 (2d ed. rev. 2004), and authorities cited therein.

Proceedings are resumed. Petitioner's unilateral discovery period of thirty (30) days, and trial dates, are reset as follows:

PETITIONER'S UNILATERAL DISCOVERY PERIOD TO
CLOSE: **01/09/09**

30-day testimony period for party in position of
plaintiff to close: **04/09/09**

30-day testimony period for party in position of
defendant to close: 06/08/09

15-day rebuttal testimony period to close: 07/23/09

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.

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>
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:

Cancellation No. 92044624

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