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

Brown

Mailed: October 28, 2008

Cancellation No. 92048480

Sinbad Grand Cafe, LLC

v.

AL-FAKHER FOR TABACCO
TRADING & AGENCIES CO. LTD.

Brian D. Brown, Interlocutory Attorney:

This case now comes before the Board for consideration of petitioner's motion to compel respondent to provide full and complete responses to petitioner's first set of interrogatories and document production requests.[1]

Preliminarily, the Board finds that under Trademark Rule 2.120(e), petitioner has made a good-faith effort by written correspondence as well as telephonic communication to resolve the present discovery dispute prior to seeking Board intervention. Notwithstanding the above, the Board

[1] As a reminder, the motion to compel procedure does not apply to admission requests. Rather, the appropriate mechanism is a motion to test the sufficiency of a party's responses. As a further reminder, by rule, the Board will not hold any party in contempt, or award attorneys' fees, other expenses or damages to any party. *See* Trademark Rule 2.127(f) and *Central Manufacturing Inc. v. Third Millenium Technology Inc.*, 61 USPQ2d 1210, 1213 (TTAB 2001).

reminds the parties that they are obligated to cooperate with one another so that this case may proceed in an orderly manner within reasonable time constraints.

In its motion, petitioner sought full and complete responses to its first set of interrogatories and document production requests. While respondent has served supplemental discovery responses, according to petitioner, full and complete responses to a number of discovery requests still remain outstanding. The outstanding discovery requests at issue as well as the Board's corresponding findings are summarized below as follows:

Doc. Req. Nos. 4 in petitioner's first set of document production requests: Petitioner state that respondent has indicated use in "the Middle East and the United States" since January 10, 1995, but has only produced documents relating to use of the involved mark for only 2006, 2007 and 2008. As defined by petitioner in its document production requests, registrant refers to respondent as well as its "predecessors or successors in-interest." Moreover, given that respondent has mentioned use of the involved mark since January 10, 1995, respondent must supplement its responses and produce documents relating to use of the involved mark in connection with the goods or services sold under the mark by its predecessors between the dates in question. If respondent does not possess those documents, at the very

least, it must state so for the record. In addition, where complete compliance would be unduly burdensome, respondent may provide a representative sampling or some other reduced amount of information that addresses this production request. To the extent that documents concern respondent's use of its involved mark outside of the United States and the fact that foreign use of a mark creates no rights in the United States, they are not discoverable and need not be provided by respondent. *See Johnson & Johnson v. Salve*, 183 USPQ 375, 376 (TTAB 1976).[2]

Doc. Req. Nos. 8, 9, 10, 11, 12, 16 and 17 in petitioner's first set of document production requests: Petitioner state that respondent has not produced documents that show use of the involved mark in connection with the advertising or promotion or intended advertising or promotion for all of the products that respondent currently uses, intends to use or has used. Assuming that the "CD" produced by respondent does not depict use of the involved mark in connection with any advertising or promotion, or intended advertising or promotion of all of its products, the submission is deemed inadequate and in the Board's view, requires further supplementation. In the event that respondent does not have such documents, at the very least,

[2] Exceptions may arise for example where the foreign mark is "famous" albeit not in the United States.

respondent must state so for the record and accompany its statement with an explanation. In an effort to avoid unreasonable hardship or burden on respondent, respondent may provide a representative sample or reduced amount of information as long as it is sufficient to satisfy the relevant discovery needs of its adversary.

Doc. Req. Nos. 24, 25, 27, 29, 30, 31, 41, 43, 45, 46, 47, 49 and 50 in petitioner's first set of request for production of documents: Petitioner states that respondent has failed to provide a adequate responses thereto and that respondent has had more than enough time to obtain the relevant documents. Upon review, the Board agrees with petitioner that respondent has had sufficient time to obtain the relevant documents and the continued delay, without some reasonable indication as to when the search for the documents will be completed, has adversely impacted the proceeding. Likewise, the Board has held that information for example, relating to the area's of distribution for a party's involved goods sold under its involved mark including the number of salesman, locations of sale representatives and the geographic location of dealers who market and distribute the products under the mark is discoverable matter. *See Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193 (TTAB 1976). Moreover, annual sales and advertising figures, stated in round numbers, for

a party's involved goods or services sold under its involved mark remain proper matters for discovery. *See Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 9ttab 1975). Therefore, the Board agrees with petitioner that the responses provided thus far to the document production requests listed above are incomplete and inadequate. Respondent therefore must produce all documents which are responsive to requests nos. 24, 25, 27, 29, 30, 31, 41, 43, 45, 46, 47, 49 and 50 and at the very least, submit a representative sample of the information sought or reduced amount which is sufficient to meet petitioner's discovery needs. To address any concern regarding the disclosure of proprietary confidential information, disclosure can be made under the protective order automatically in place.

In closing, petitioner's motion to compel with respect to receiving from respondent, full and complete responses to the outstanding document production requests, namely, request nos. **4, 8, 9, 10, 11, 12, 16, 17, 24, 25, 27, 29, 30, 31, 41, 43, 45, 46, 47, 49** and **50** is granted. Respondent is therefore ordered to provide full and complete responses, signed under oath and without objections, to those document production requests thirty (**30**) days from the mailing date of this order, failing which petitioner may then move for sanctions, including the entry of judgment, pursuant to Trademark Rule 2.120(g). In view thereof,

petitioner's motion for sanctions, filed prior to its motion to compel, is denied as premature.

Previously suspended, proceedings herein are resumed and trial dates, including the close of discovery, are reset as follows:

DISCOVERY PERIOD TO CLOSE:	**March 27, 2009**
30-day testimony period for party in position of plaintiff to close:	**June 25, 2009**
30-day testimony period for party in position of defendant to close:	**August 24, 2009**
15-day rebuttal testimony period for plaintiff to close:	**October 8, 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.

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