

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

wbc

Mailed: February 24, 2014

Cancellation No. 92048732

Altvater Gessler - J.A. Baczewski
International (USA) Inc. and
Altvater Gessler - J.A. Baczewski
GmbH

v.

Ronald Beckenfeld

Wendy Boldt Cohen, Interlocutory Attorney:

This case now comes up for consideration of petitioner's motion to compel further discovery responses filed December 6, 2013. The motion has been fully briefed.

The Board has considered the parties' submissions¹ and presumes the parties' familiarity with the factual bases for the motion and does not recount them here except as necessary to explain the Board's order.

After reviewing the parties' arguments and submissions with respect to the motion to compel, the Board finds that petitioner has not satisfied its obligation under Trademark Rule 2.120(e) to

¹ Inasmuch as petitioner's amended petition to cancel filed January 9, 2014 was filed in compliance with the Board's December 20, 2013 order, it is the operative pleading. Respondent's answer, filed February 10, 2014 is noted and made of record.

make a good faith effort to resolve discovery disputes before seeking the Board's intervention. Notably, petitioner served forty document requests in its third set of requests and now seeks further responses to all forty document requests.² The Board further notes that petitioner and respondent had one telephone conversation, followed by an email summarizing that conversation.

Based on the excessive number of discovery requests at issue, and the parties' failure to confer (except as noted *supra*), the Board finds that petitioner failed to make a sufficient good faith effort to resolve the parties' discovery dispute prior to seeking Board intervention. See Trademark Rule 2.120(e)(1); *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984). The vast majority of issues raised herein should have been resolved without Board intervention, and the Board suggests greater effort to avoid or resolve such controversies. The parties are directed to review carefully TBMP § 414 regarding the discoverability of various matters in Board *inter partes* proceedings.

The parties are reminded that the purpose of discovery is to advance the case so that it may proceed in an orderly manner

² The motion to compel seeks "documents responsive to those Discovery Requests concerning the Trust" but does not specify by number, except to illustrate by example the parties' dispute, which requests those are.

within reasonable time constraints. To this end, the parties must adhere to the strictures set forth in *Sentrol, Inc.*, 231 USPQ at 667, and repeated below:

[E]ach party and its attorney has a duty not only to make a good faith effort to satisfy the discovery needs of its opponent but also to make a good faith effort to seek only such discovery as is proper and relevant to the specific issues involved in the case. Moreover, 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 their 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 which require tedious examination, **it is generally the policy of the Board 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 amount of disputed requests for discovery, if any, down to a reasonable number.**

(emphasis added).³

For these reasons, the Board finds that petitioner failed to make the requisite good faith effort to resolve the issues raised by its motion to compel prior to involving the Board in the

³ The parties are reminded that the Board is an administrative tribunal of limited jurisdiction which is empowered only to determine the right to receive and keep trademark registrations. See TBMP § 102.01. Accordingly, the parties should avoid using discovery in this case as a means of seeking information which is not relevant to this case and appears is intended to provide a possible basis for other contemplated litigation.

parties' dispute. Accordingly, petitioner's motion to compel is **DENIED**.

Notwithstanding the foregoing, it has not escaped the Board's notice that respondent's discovery responses indicate that respondent does not appear to have made the requisite good faith effort to satisfy petitioner's discovery needs. See TBMP § 408.01. The Board expects the parties to cooperate with one another in the discovery process. *Id.*; see *Panda Travel Inc. v. Resort Option Enterprises, Inc.*, 94 USPQ2d 1789, 1791 (TTAB 2009). In discovery, a party must articulate its objections, with particularity, to those discovery requests it believes to be objectionable and provide the information sought which the responding party believes to be proper. See *Amazon Technologies Inc. v. Wax*, 94 USPQ2d 1702, 1704 (TTAB 2009) (quoting *Medtronic, Inc.*, 222 USPQ at 83). "Parties must present to each other the merits of their respective positions with the same candor, specificity, and support during informal negotiations as during the briefing of discovery motions." *Id.* (quoting *Nevada Power Co. v. Monsanto Co.*, 151 F.R.D. 118, 120 (D. Nev. 1993)).

Here, respondent has made a litany of boilerplate objections and in many cases, failed to provide with candor and specificity the grounds for its objections. Given the parties' dispute regarding the nature of petitioner's discovery requests, the

Cancellation No. 92048732

Board provides the following comments to assist the parties in resolving their discovery dispute.

Central to the parties' controversy, in short, is the discoverability of documents related to the alleged assignment of the involved mark through respondent's trust account. Because ownership of the registration is at issue in this proceeding, the information sought by petitioner appears reasonably calculated to lead to the discovery of admissible evidence. See Fed. R. Civ. P. 26(b)(1); Trademark Rule 2.116(a). Cf. *Double J of Broward, Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1612 (TTAB 1991) ("The contracts and agreements between the parties are proper matters for discovery because they relate to ownership of the mark and applicant's affirmative defenses. In addition, they may show limitations on a party's rights in the mark or reveal inconsistencies with statements subsequently made by a party thereto in the pending proceeding"); *Varian Assoc. v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975) ("Furthermore, the extent of ownership or control by [respondent] of another corporation or firm, the identity thereof, and the name of each person, whether natural or juristic, that owns or controls a certain percentage of the stock of said entity are matters which generally have no bearing on the question of registrability in an opposition proceeding **unless it has been shown or it appears that**

the company has used or is using the mark in question.”)

(emphasis added).

Nonetheless, many of petitioner's document requests are overly broad and unduly burdensome in that they seek "all" documents that respondent may have that are responsive to a particular request. In those cases where complete compliance with a particular request would be unduly burdensome, the responding party may comply by providing a representative sampling of the information sought which is nevertheless sufficient to meet the propounding party's discovery needs. See TBMP § 414(2) and cases cited therein. Additionally, respondent need not create responsive documents solely to satisfy petitioner's discovery requests. See *Washington v. Garrett*, 10 F.3d 1421, 1437-38 (9th Cir. 1993). Nonetheless, respondent has an ongoing duty to supplement or correct its discovery responses. See Fed. R. Civ. P. 26(e). If respondent fails to disclose properly discoverable information or documents, respondent may, upon timely objection from petitioner, be precluded from using such information or documents at trial, unless such failure is substantially justified or is harmless. See Fed. R. Civ. P. 37(c)(1).

Furthermore, requests such as "all correspondence between [respondent] and Lillian Beckenfeld," "all correspondence between [respondent] and Mickey Beckenfeld," or "all federal and state

tax returns of [respondent] filed since 2009" are not clearly limited to the claims at issue in this proceeding and petitioner has not introduced any evidence or persuasively established that these requests have anything to do with petitioner's claims in this case or trademarks in general. Therefore, these discovery requests do not appear to be reasonably calculated to lead to the discovery of admissible evidence. See Fed. R. Civ. P. 26(b)(1).

Accordingly, should petitioner wish to obtain responses to its discovery from respondent, petitioner is **ORDERED** to modify the subject requests for production, as necessary, to conform to the Board's Selected Discovery Guidelines, see TBMP § 414, and to any other applicable case law.

Proceedings herein are resumed. Dates are reset as follows:

Plaintiff's Pretrial Disclosures	3/23/2014
Plaintiff's 30-day Trial Period Ends	5/7/2014
Defendant's Pretrial Disclosures	5/22/2014
Defendant's 30-day Trial Period Ends	7/6/2014
Plaintiff's Rebuttal Disclosures	7/21/2014
Plaintiff's 15-day Rebuttal Period Ends	8/20/2014

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.