

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

MBA

Mailed: March 5, 2009

Cancellation No. 92048879

Nor-Cal Beverage Co., Inc.

v.

Irene J. Ortega d/b/a Gogirl  
Activewear

**Michael B. Adlin, Interlocutory Attorney:**

This case now comes up for consideration of petitioner's motion to compel responses to certain of its interrogatories and requests for production, filed January 16, 2009. The motion is fully briefed.

Background

Respondent owns a registration of the mark GO GIRL for "clothing and headgear for women and girls, namely, hats, caps sweatshirts, sweatpants, leggings, T-shirts, shirts and shorts" (the "Registration").<sup>1</sup> The Registration is more than five years old. Petitioner seeks to cancel the Registration, alleging that respondent issued a "cease and desist demand" to petitioner based on petitioner's use of GO GIRL SUGAR FREE ENERGY DRINK for clothing, and that because

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<sup>1</sup> Registration No. 2227005, issued March 2, 1999 based on a date of first use in commerce of June 21, 1996. [Renewed; Section 15 Affidavit acknowledged].

the assignment of the Registration to respondent was "void and legally ineffective," respondent's Section 8 affidavit was also ineffective and the Registration should be cancelled. Respondent denies the salient allegations in the petition for cancellation, asserts as an affirmative defense that petitioner "lacks standing" and counterclaims for cancellation of petitioner's registration of GO GIRL for "Non-alcoholic beverages, namely, energy drinks,"<sup>2</sup> alleging priority of use and likelihood of confusion between petitioner's mark and the mark in the Registration. Petitioner denies the salient allegations in the counterclaim.

The Parties' Dispute

By its motion, petitioner alleges that respondent failed to respond or failed to respond completely to certain interrogatories, failed to produce responsive documents and made an "overly inclusive designation of each and every requested document as 'TRADE SECRET/COMMERCIALY SENSITIVE.'" "

In opposing the motion, respondent indicates that she "prepared and served [her] Supplemental Responses to Interrogatories and Production of Documents on January 16, 2009, the same day that Petitioner's counsel filed this

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<sup>2</sup> Registration No. 3235947, issued May 1, 2007, based on a date of first use in commerce of May 15, 2005.

Motion to Compel discovery" (emphasis in original).

Respondent claims that in addition to producing documents on January 16, 2009, she appropriately "re-categorized" documents as "confidential" pursuant to the Protective Order governing this proceeding which was approved by the Board on December 31, 2008, but that "[t]o the extent a particular document is public record, then Respondent's counsel will be glad to redesignate when the issue is brought to its attention." Respondent otherwise argues that its discovery responses are sufficient.

In its reply brief, petitioner claims that "the infirmities of [respondent's] original responses to the discovery have not been corrected ...." Specifically, petitioner complains of the "extreme over-inclusiveness," and unresponsive nature, of documents identified in response to certain interrogatories, apparently under Fed. R. Civ. P. 33(d). Petitioner also contends that respondent failed to produce documents in response to certain discovery requests, but petitioner often fails to specify precisely which discovery requests. Finally, petitioner contends that respondent improperly designated a number of documents as "Confidential."

### Decision

Before addressing the specific discovery requests at issue, petitioner has introduced a sampling of documents

allegedly "over-designated" as "Confidential." These include newspaper and other advertisements, Web site printouts and public clinic sign-up sheets, which, as petitioner points out, cannot be considered "Trade Secrets under California law, or ... Material [which] constitutes or includes confidential and proprietary business information ..." Stipulated Protective Order ¶ 1. Accordingly, petitioner's motion is **GRANTED**, to the extent that within **THIRTY DAYS** of the mailing date of this order, respondent shall remove the "Confidential" designation from all produced documents which are or were ever publicly distributed or available, and reproduce the documents without the designation. Id. To the extent any disputes remain after respondent complies with this requirement, petitioner shall first proceed under Paragraph 5 of the Stipulated Protective Order before bringing any such dispute to the Board's attention.

Interrogatory No. 1(f)

Petitioner claims that respondent identified too many documents in response to this interrogatory and that she failed to identify documents establishing the claimed date of first use in the Registration. According to petitioner, respondent should "supplement her responses and delete all references to documents which do not evidence or support her first use of" her mark. While respondent should not "over-

designate" documents, and any attempt to do so in the future will be closely scrutinized upon motion and addressed as appropriate, it would be pointless to require respondent to remove its designation of certain documents. The parties may and likely do disagree as to the relevance and meaning of many of them. The point is, respondent has identified documents which it claims are responsive to petitioner's discovery requests. To the extent that respondent failed to identify documents or information supporting its claimed date of first use, then respondent may find itself precluded from establishing its claimed date of first use at trial. Indeed, petitioner may seek to preclude respondent from relying on information or documents which should have been produced in response to this or any other discovery request, but were not. See, Presto Products v. Nice-Pak Products, 9 USPQ2d 1895, 1896 n. 5 (TTAB 1988). As a result, there is no need or basis upon which to compel a supplemental response to this interrogatory, and accordingly petitioner's motion is **DENIED** with respect to this interrogatory.<sup>3</sup>

Interrogatory No. 2

This interrogatory requested the identification of witnesses and documents supporting respondent's claim of

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<sup>3</sup> Petitioner's claim that respondent failed to comply with Fed. R. Civ. P. 33(d) is moot given respondent's eventual identification of document numbers to support responses made under the Rule.

likelihood of confusion. Respondent eventually identified a number of documents and "Irene Ortega and others familiar with Ortega's brand and business." While petitioner claims that the documents identified are unresponsive, it is unnecessary to compel the production of responsive documents (or what petitioner might deem responsive documents), because petitioner may seek to preclude respondent from relying on information or documents which should have been produced in response to this or any other discovery request, but were not. Id. However, petitioner's argument that respondent's identification of witnesses is inadequate is well-taken, and petitioner's motion is **GRANTED**, to the extent that within **THIRTY DAYS** of the mailing date of this order, respondent shall specifically identify, by name and address, the "others familiar with Ortega's brand and business" who are "most knowledgeable regarding" respondent's claim of likelihood of confusion.

Interrogatory No. 3

Petitioner claims, without explanation, that respondent's response to this interrogatory is "inadequate and evasive," because "[s]pecific information is not provided." Because petitioner fails to explain what information it believes it is entitled to, or how respondent's response to this interrogatory is inadequate, and because a review of the response does not readily reveal

any deficiencies, petitioner's motion is **DENIED** with respect to this interrogatory.<sup>4</sup>

Interrogatory Nos. 9 and 10

In her response to Interrogatory No. 9 concerning actual confusion, respondent identified a single individual, by name only, and stated that unidentified "new customers" have also been actually confused. In her response to Interrogatory No. 10, respondent failed to identify a single individual. Petitioner's motion is **GRANTED** with respect to these interrogatories, because the identifications are inadequate. Within **THIRTY DAYS** of the mailing date of this order, respondent shall serve an address for the identified individual, and names and addresses for the unidentified "new customers" and witnesses with knowledge regarding Interrogatory Nos. 9 and/or 10.

Interrogatory No. 11(b)

Petitioner claims that the documents identified in response to this interrogatory are unresponsive. As set forth herein with respect to other interrogatory responses, petitioner may seek to preclude respondent from relying on any information or documents which should have been produced in response to this interrogatory but were not, but its

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<sup>4</sup> Similarly, petitioner claims, without explanation, that respondent's response to Interrogatory No. 4 is somehow deficient. The Board will not (and in any event cannot) rule on deficiencies not fully explained in petitioner's motion. See e.g., Trademark Rule 2.120(e); TBMP § 523.02 (2d ed. rev. 2004).

motion to compel the production of responsive documents is hereby **DENIED**.

Document Requests

Petitioner argues that certain documents "which would have been anticipated" were not produced, and that if respondent "has additional documents, she should be ordered to produce them by a date certain - and not allowed to withhold documents to be produced later." For the reasons stated herein, petitioner's motion is **DENIED** with respect to this request. However, respondent is reminded that she may not rely on information or documents which should have been produced but were not, and that she is under a continuing duty to timely supplement her discovery responses. Fed. R. Civ. P. 26(e).

Motion for Extension

Petitioner's request for an extension of the discovery and testimony periods is granted as conceded. Trademark Rule 2.127(a).

Conclusion

Petitioner's motion to compel is **GRANTED IN PART**, to the extent that within **THIRTY DAYS** of the mailing date of this order, respondent shall:

1. remove the "Confidential" designation from all produced documents which are or were ever publicly distributed or available, and reproduce the documents without the designation, by photocopying them and mailing them to petitioner at

respondent's expense; TBMP § 406.03 (2d ed. rev. 2004);

2. properly identify those most knowledgeable regarding Interrogatory No. 2; and
3. properly identify witnesses and "new customers" in response to Interrogatory Nos. 9 and 10.

Opposer's motion to compel is otherwise **DENIED**. Proceedings herein are resumed, and disclosure, discovery, trial and other dates are reset as follows:

|   |                           |
|---|---------------------------|
| Expert Disclosures Due                  | <b>May 6, 2009</b>        |
| Discovery Closes                        | <b>June 5, 2009</b>       |
| Plaintiff's Pretrial Disclosures        | <b>July 20, 2009</b>      |
| Plaintiff's 30-day Trial Period Ends    | <b>September 3, 2009</b>  |
| Defendant's Pretrial Disclosures        | <b>September 18, 2009</b> |
| Defendant's 30-day Trial Period Ends    | <b>November 2, 2009</b>   |
| Plaintiff's Rebuttal Disclosures        | <b>November 17, 2009</b>  |
| Plaintiff's 15-day Rebuttal Period Ends | <b>December 17, 2009</b>  |

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](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>

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