

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

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Mailed: October 1, 2010

Cancellation No. 92050920

Intellect Technical
Solutions, Inc.

v.

Milena Soni

Elizabeth A. Dunn, Attorney (571-272-4267):

This case comes up on petitioner's motions to amend the petition to cancel and to compel discovery responses. The motions are contested, and the Board held a phone conference with the parties on September 30, 2010.¹ The participants were Todd Giltinan, attorney for petitioner, Ronald Perez, attorney for respondent, and Elizabeth Dunn, attorney for the Board.²

In this case petitioner claims priority of use and likelihood of confusion between its mark INTELLECT for "placement services, namely placing information technology

¹ Respondent's motion, filed April 13, 2010, to extend its time to respond to the motion to compel is granted. Trademark Rule 2.127(a).

² Attorney Soni also attended the conference.

professionals into information technology positions", the subject of pending application Serial No. 77363060, and respondent's mark ENTELLECT for:

Int. Cl. 35
employment counseling and recruiting, business consultation, business management and consultation, business management consultation, personnel management consultation, psychological

Int. Cl. 41
testing for the selection of personnel in career counseling.

Respondent's registration No. 3009990 also includes "psychological counseling, psychological consultation, psychological testing services, psychological testing" in Int. Cl. 44 but those services were not the subject of the petition to cancel. Respondent's answer denied the salient allegation of the petition to cancel, and as extended by the parties with the approval of the Board, initial disclosures were due September 14, 2009 and discovery was to close February 11, 2010.³

³ On January 7, 2010, respondent filed copies of the certificates of service which apparently accompanied its November 9, 2009 responses to petitioner's discovery requests, its privilege log, its document production, and its January 7, 2010 discovery requests served on petitioner. On March 16, 2010, respondent filed copies of the certificates of service which apparently accompanied its March 15, 2010 discovery responses.

Respondent is ordered to cease such filings, which serve no purpose. See Trademark Rule 2.120(j)(8) ("Written disclosures or disclosed documents, requests for discovery, responses thereto, and materials or depositions obtained through the disclosure or discovery process should not be filed with the Board, except when submitted with a motion relating to disclosure or discovery, or in support of or in response to a motion for summary judgment, or under a notice of reliance, when permitted, during a party's testimony period.").

AMENDED PETITION TO CANCEL ACCEPTED

On March 10, 2010, based on information disclosed during a February 9, 2010 discovery deposition, petitioner moved to amend the petition to cancel to add Int. Cl. 44 to the petition to cancel, and the claim of nonuse or, alternatively, abandonment, with respect to all three classes listed in the registration. Petitioner's motion included the filing fee for Int. Cl. 44. In opposition to the motion, respondent contends that addition of the claim will delay this proceeding and that the testimony in question is insufficient to warrant new grounds of nonuse or abandonment.

When justice so requires, the courts and the Board look favorably on motions to amend. Fed. R. Civ. P. 15(a). In deciding such a motion, the Board will grant the motion unless entry of the proposed amendment would violate settled law or would be prejudicial to applicant. *Karsten Manufacturing Corp. v. Editoy AG*, 79 USPQ2d 1783, 1785 (TTAB 2006). Thus, if the proposed pleading is legally insufficient, or would serve no useful purpose, the Board normally will deny the motion. *Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1309-1310 (TTAB 2007). In determining whether applicant would be prejudiced by allowance of the proposed amendment, the timing of the motion for leave to

amend plays a large role. *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1486 (TTAB 2007).

Here, we find that the proposed amended petition to cancel was timely filed and sufficiently states the claim of nonuse or, in the alternative, abandonment. We need not address whether the deposition testimony supports petitioner or respondent's positions regarding use of the mark with the services. Whether or not the moving party can actually prove the claim sought to be added to a pleading is a matter to be determined after the introduction of evidence. *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1318 (TTAB 1992). As to prejudice, we find none here. Petitioner has not moved for an extension of discovery, and the facts regarding respondent's nonuse or abandonment are already available to respondent. Accordingly, petitioner's motion to amend is granted, and the accompanying amended petition to cancel is the operative pleading for this case.

Respondent is allowed until forty days from the mailing date of this order to file its answer to the amended petition to cancel.

MOTION TO COMPEL GRANTED IN PART AND DENIED IN PART

Petitioner moves to compel responses to specified requests in two sets of discovery served on respondent. The motion is supported by evidence of communication between the

parties sufficient to show petitioner's good faith effort to resolve the discovery issues before filing its motion.

a) First Set of Interrogatories, Nos. 4-5, 7-8, 10

Interrogatory No. 4 (amount spent by respondent on advertising and promotion of services listed in registration for years 2002-2009)

Interrogatory No. 5 (amount earned by respondent by providing services listed in registration for years 2002-2009)

Interrogatory No. 7 (identify persons for whom respondent has provided employment counseling, recruiting and/or career counseling services during the years 2002, 2008, and 2009.)

Interrogatory No. 8 (list persons for whom respondent has found employment by virtue of recruiting services offered in connection with respondent's alleged mark for each year between 2002 and 2009)

Interrogatory No. 10 (describe in detail all services respondent has offered in connection with the ENTELLECT mark between the years 2002 and 2009.)

As to Nos. 4-5, annual sales and advertising figures, stated in round numbers, for a party's involved services sold under its involved mark are proper matters for discovery. If a responding party considers such information to be confidential, disclosure may be made under protective order. *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147, 149 (TTAB 1985). Respondent's objection that it does not have to respond to interrogatories after deposition testimony has been given is not persuasive. Addressing the same subject through interrogatories and depositions is not duplicative or burdensome.

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With respect to Nos. 7-8, the names of customers constitute confidential information, and generally are not discoverable, even under protective order. See *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988).

With respect to No. 10, the requested description is obviously relevant to the issues of likelihood of confusion and nonuse.

b) Second Set of Interrogatories, Nos. 14-21, 24-25

c) First Request for Production of Documents, No. 7

All written contracts and agreements between Respondent and Kenneth G. Neils, or between Respondent and any business entity reasonable believed by respondent to be owned, operated, or controlled by Kenneth G. Neils, concerning any disputed services offered or sold by respondent.

The listed interrogatories and document request require respondent to identify all written and unwritten contracts and agreements between respondent and third parties, or to describe the business relationship between respondent and third parties.

Contractual agreements between a responding party and third parties based on the responding party's involved mark is discoverable. See *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, *supra* at 1675. The Board notes that only Nos. 24-25 are limited to performance of the services listed in the registration. The Board sua sponte

restricts Nos. 14-21 to specify that agreements and relationships involve the services identified in the registration.

d) Second Request for Production of Documents, Nos. 1-2

1. All federal and state income tax returns filed by or for Respondent between January 1, 2003 and the present that list income derived from the Respondent's performance of the Disputed Services.

2. All federal and state income tax returns filed by or for Respondent between January 1, 2003 and the present that list expenses incurred in the performance of the Disputed Services.

Respondent's written response to the discovery request objects on the basis of confidentiality, which is not a reasonable objection in view of the Board's standard protective order and its provisions for the exchange of confidential information. However, in its response to the motion, respondent also contends that the tax returns cannot provide the desired information because an aggregate of business income was reported, and the returns do not specify which income was derived from the ENTELLECT services identified in the registration. Accordingly the Board orders respondent, in lieu of the tax returns, to serve an amended response to this document request which includes the explanation why the requested information cannot be derived from the tax returns, and to provide any documentation upon which respondent relied in coming up with the amount of

income derived from the ENTELLECT services which formed part of the aggregate business income for each year.

A party is required to respond completely to discovery to the best of its ability and to supplement discovery responses as soon as it becomes aware of new information. *Quality Candy Shoppes/Buddy Squirrel of Wisconsin Inc. v. Grande Foods*, 90 USPQ2d 1389, 1392 (TTAB 2007); Fed. R. Civ. P. 26(e)(1) ("A party ... who has responded to an interrogatory, request for production, or request for admission must supplement or correct its disclosure or response (A) in a timely manner if the party learns that in some material respect the disclosure or response is incomplete or incorrect, and if the additional or corrective information has not otherwise been made known to the other parties during the discovery process or in writing.").

In sum, the motion to compel is granted as to First Set of Interrogatories, Nos. 4-5, and 10; Second Set of Interrogatories, Nos. 14-21, 24-25 except that the responses to 14-21 are limited to those agreements and business relationships involving the ENTELLECT services; First Request for Production of Documents, No. 7; and Second Request for Production of Documents, Nos. 1-2 except that respondent, in lieu of the tax returns, is ordered to serve an amended response to the document request which includes the explanation why the requested information cannot be

derived from the tax returns, and to provide any documentation upon which respondent relied in coming up with the amount of income derived from the ENTELLECT services which formed part of the aggregate business income for each year; and the motion to compel is denied as to First Set of Interrogatories, Nos. 7-8.

Proceedings herein are resumed. Applicant is allowed until thirty days from the mailing date of this order to serve the response compelled herein, and is allowed until forty days from the mailing date of this order to file its answer to the amended petition to cancel. Dates are reset below.

Plaintiff's Pretrial Disclosures	12/17/10
Plaintiff's 30-day Trial Period Ends	1/9/11
Defendant's Pretrial Disclosures	1/24/11
Defendant's 30-day Trial Period Ends	3/10/11
Plaintiff's Rebuttal Disclosures	3/25/11
Plaintiff's 15-day Rebuttal Period Ends	4/24/11

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.

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