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

Baxley

Cancellation No. 92051659

Nowlan Family Trust

v.

The Trustees of the Dille Family Trust

Andrew P. Baxley, Interlocutory Attorney:

This case now comes up for consideration of petitioner's fully briefed motion (filed June 4, 2010) to compel discovery. By such motion, petitioner asks that respondents be required to: (1) provide responses to petitioner's first and second sets of interrogatories and first and second sets of requests for admission; (2) produce without objection all documents responsive to petitioner's first and second sets of document requests; and (3) produce supplemental documents responsive to petitioner's first sets of interrogatories and requests for admissions.

The motion to compel procedure is not available with regard to requests for admission. See TBMP Section 523.01 (2d ed. rev. 2004). In any event, respondents served timely and acceptable responses to petitioner's first set of requests for admission on February 8, 2010. See Fed. R.

Civ. P. 36(a)(4); Trademark Rules 2.119(c) and 2.127(a)(3); TBMP Section 407.03(b) (2d ed. rev. 2004).

Further, in a March 26, 2010 letter from petitioner's attorney to respondents' former attorney ("the March 26, 2010 letter"), petitioner seeks production of documents in response to request for admissions nos. 3 and 4. These requests do not ask respondents to identify or produce any documents. See TBMP Section 402.02. Moreover, requests for admission are not a proper means of requesting documents from an adversary. See Fed. R. Civ. P. 36(a)(1); TBMP Section 407.02. Accordingly, respondents need not produce any documents in response thereto.

Regarding petitioner's second set of requests for admissions, which petitioner served on April 27, 2010 by mail, concurrently with second sets of interrogatories and document requests, respondents were required to serve responses thereto by June 1, 2010. See Trademark Rules 2.119(c) and 2.120(a)(3); TBMP Section 407.03(a). The Board deems the filing of respondents' former attorney's request to withdraw as counsel herein on June 2, 2010 to have tolled the running of all dates herein. However, because no responses to the second set of requests for admission were timely served prior to the filing of that request, that second set stands admitted by operation of applicable rules.

See Fed. R. Civ. P. 36(a)(3) and (b); TBMP Section 407.03(a).

Turning to the motion to compel as it relates to petitioner's second sets of interrogatories and document requests, the Board finds that petitioner did not make a good faith effort to resolve the parties' discovery dispute prior to seeking Board intervention. See Trademark Rule 2.120(e)(1); TBMP Section 523.02. Although respondents' responses thereto were due by June 1, 2010, petitioner has not identified any specific effort that it made to resolve the parties' discovery dispute with regard to the second sets of interrogatories and document requests prior to filing the motion to compel three days later. See *Envirotech Corp. v. Compagnie Des Lampes*, 219 USPQ 448, 450 (TTAB 1979). Accordingly, the motion to compel is denied without prejudice with regard to petitioner's second set of interrogatories and document requests.

On the other hand, the Board finds, with regard to petitioner's first sets of interrogatories and document requests, that petitioner made a good faith effort to resolve the parties' discovery dispute, as required by Trademark Rule 2.120(e)(1), prior to seeking Board intervention. Nonetheless, the parties should have resolved many of the issues raised in the motion to compel and

exhibits attached thereto without the need for Board intervention.[1]

Respondents served timely responses to petitioner's first sets of interrogatories and document requests on February 8, 2010. See Trademark Rules 2.119(c) and 2.120(a)(3). Accordingly, to the extent that petitioner, in its motion to compel, requests that respondents be required to produce without objection documents responsive to petitioner's first set of document requests, that motion is denied.[2] See *No Fear Inc. v. Rule*, 54 USPQ2d 1551 (TTAB 2000); TBMP Section 406.04(a).

Because respondents served timely responses to petitioner's first set of interrogatories, the Board will address only the deficiencies with regard to those responses that petitioner's attorney alleged in the March 26, 2010

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[1] This proceeding is concerned solely with whether or not respondents can maintain their Registration No. 714184 for the mark BUCK ROGERS in typed form for a "newspaper comic strip" in International Class 16 and its Registration No. 1555871 for the mark BUCK ROGERS in typed form for "boardgames" in International Class 28. See TBMP Section 102.01 (2d ed. rev. 2004). As such, petitioner is reminded that it has a duty to make a good faith effort to seek only such discovery as is proper and relevant to the issues of this case. See TBMP Section 408.01. The parties are directed to review TBMP Section 414 regarding the discoverability of various types of information in Board proceedings.

[2] Although parties frequently serve copies of responsive documents concurrently with their responses to document requests, they are not required to do so. See Fed. R. Civ. P. 34(b)(2); TBMP Section 406.03 and 406.04. Rather, parties often arrange for document production at a mutually convenient time following service of responses to document requests that allows ample time for trial preparation. See Trademark Rule 2.120(d)(2); TBMP Section 406.03.

letter. Through such letter, petitioner asks respondents to produce documents in response to interrogatory nos. 21-26 and 35. However, in these interrogatories, respondent was asked neither to identify nor to produce any documents.[3] Petitioner may not use a motion to compel to obtain discovery that is broader in scope than the discovery requests at issue. See TBMP Section 402.02. Inasmuch as petitioner's attorney did not otherwise object to respondents' responses to these interrogatories in the March 26, 2010 letter, petitioner's motion to compel is denied with regard thereto.

In interrogatory no. 6, petitioner seeks the date of first use of each product sold, offered for sale, and/or distributed in the United States under the involved BUCK ROGERS mark. This request is overly board because it is not limited to the dates of first use for the goods identified in respondents' involved registrations, i.e., newspaper comic strips and board games. Use of the BUCK ROGERS mark on, or in connection with, goods and services other than newspaper comic strips and board games is not at issue in this proceeding and has no relevance thereto. See *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147, 149 n.2 (TTAB 1985); TBMP Section 414(11). By incorporating

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[3] Further, petitioner has not specified any document request(s) to which these interrogatories correspond.

respondents' response to interrogatory no. 3, respondents' response to interrogatory no. 6 provides dates of first use of the mark on newspaper comic strips and board games. Such response is therefore acceptable.

In interrogatory nos. 10-13, petitioner seeks information regarding the identity of "all documents" upon which respondents intend to rely to establish the first use and continuous use of the BUCK ROGERS mark on newspaper comic strips and board games. Respondents' objections that these requests are overly board and unduly burdensome are sustained. See Fed. R. Civ. P. 26(b)(2)(C)(i). Respondents' responses that they will make available for inspection documents from which the requested information can be obtained are acceptable.

In interrogatory no. 16, petitioner asks respondent to identify all applications and registrations that respondents own "anywhere in the world." Neither respondents' other applications and registrations nor respondents' foreign trademark rights have any bearing upon the claims in this proceeding. See *Oland's Breweries [1971] Ltd. v. Miller Brewing Co.*, 189 USPQ 481, 489 n.7 (TTAB 1975), *aff'd, Miller Brewing Co. v. Oland's Breweries*, 548 F.2d 349, 192 USPQ 266 (CCPA 1976); *Volkswagenwerk AG v. Thermo-Chem Corp.*, 176 USPQ 493, 493 (TTAB 1973); TBMP Section 414(13). Accordingly, respondents' objection that this interrogatory

is irrelevant is sustained. Respondents need not respond further to interrogatory no. 16.

In interrogatory no. 27, petitioner asks respondents to explain in detail the basis for respondents' assertion that it has not abandoned the mark at issue. Although petitioner, in the March 26, 2010 letter, seeks further information regarding respondents' statement concerning periods of nonuse, this interrogatory does not expressly seek an explanation regarding such periods. See TBMP Section 402.02. Respondents' response to this interrogatory is otherwise acceptable.

In interrogatory no. 28, petitioner asks respondents to identify all documents which support the allegations and contentions in respondents' answer. In the answer, respondents admit or deny the allegations that petitioner set forth in the petition to cancel and set forth affirmative defenses regarding the pleading of claims in the petition to cancel. As such, the only allegations and contentions in the answer are affirmative defenses, which are based solely upon petitioner's petition to cancel. Moreover, respondents need not identify during discovery all documents that it intends to rely upon in this case. See *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650 (TTAB 2002); TBMP Section 414(7). Based on the foregoing, respondents need not respond further thereto.

In interrogatory no. 35, petitioner asks respondents to identify all media in which it has advertised or promoted its goods. Respondents' objection that this request is unduly burdensome is sustained. See Fed. R. Civ. P. 26(b)(2)(c)(i). Respondents' response that they will make available documents which contain the requested information is acceptable.[4]

Based on the foregoing, petitioner's motion to compel is denied. Proceedings herein are resumed. Respondents are allowed until thirty days from the mailing date set forth in this order to serve responses to petitioner's second sets of interrogatories and document requests.[5] The parties are urged to work out a mutually convenient time for petitioner to inspect respondents' discovery documents.

Notwithstanding the foregoing, respondents are reminded that they have a duty to supplement or correct their earlier responses to discovery requests. See Fed. R. Civ. P. 26(e). Respondents are reminded in addition that, if they fail to provide information that is properly sought during

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[4] In so making, respondents need only provide documents which identify a representative sample of media in which respondents have advertised or promoted its newspaper comic strips and board games under the involved BUCK ROGERS mark. See TBMP Section 402.02.

[5] This statement merely resets respondents' time in which to respond to petitioner's second sets of interrogatories and document requests and is not an order compelling discovery for purposes of Trademark Rule 2.120(g)(1). See TBMP Section 527.01(a). Respondent may include objections on the merits in their responses. See *No Fear Inc. v. Rule, supra.*

discovery, respondents may be precluded, by way of petitioner's objection, from relying upon that information as evidence at trial. See Fed. R. Civ. P. 37(c).

Dates herein are reset as follows.

Expert Disclosures Due	**12/20/10**
Discovery Closes	**1/19/11**
Plaintiff's Pretrial Disclosures	**3/5/11**
Plaintiff's 30-day Trial Period Ends	**4/19/11**
Defendant's Pretrial Disclosures	**5/4/11**
Defendant's 30-day Trial Period Ends	**6/18/11**
Plaintiff's Rebuttal Disclosures	**7/3/11**
Plaintiff's 15-day Rebuttal Period Ends	**8/2/11**

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.

If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.