

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

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Mailed: December 27, 2011

Cancellation No. 92052625

Nautica Apparel, Inc.

v.

AirNautic Watch Company

Yong Oh (Richard) Kim, Interlocutory Attorney:

This matter comes up on respondent's motion (filed April 29, 2011) to compel petitioner's discovery responses to respondent's first request for production of documents in accordance with Fed. R. Civ. P. 34. The motion is contested.¹

The crux of respondent's motion to compel is that petitioner produced "13,000+ pages of uncategorized documents and elusive written responses" to its first request for production of documents; and respondent asks the Board "for an order requiring Petitioner to label and organize the 13,439 documents already produced on the flash drive and to fully respond to ... production requests ... 12-14, 17-21, 23, 24, 26, 27, 33, 34, 36-41, 44, 47-49, 49, 51, 52, 56, 59-65 and 67." *Motion to Compel*, pp. 1-2. In response, petitioner contends

¹ It is noted that petitioner's response to the motion is one day late. As respondent has not raised any objection to the response, the Board has, in its discretion, considered petitioner's responsive brief.

that respondent's motion to compel is "premature" in that respondent has not made the requisite good faith effort to resolve the issues presented by the motion as required under Trademark Rule 2.120(e) and that petitioner is "fully prepared to discuss and attempt to resolve all discovery disputes."

Petitioner's Response, pp. 3 and 6.

Decision

A motion to compel must be supported by a written statement from the moving party that such party, or its attorney, has made a good faith effort, by conference or correspondence, to resolve with the other party, or its attorney, the issues presented in its motion, and has been unable to reach agreement. See Trademark Rule 2.120(e)(1); and TBMP § 523.02 (3d ed. 2011).

As part of its motion to compel, respondent's counsel certified that she "made a good faith effort, through U.S. mail correspondence, to resolve the issues in this motion with Neil B. Friedman, counsel for Petitioner" and that "Mr. Friedman disagreed with Registrant's position, and thus, the issue here remains unresolved." *Motion to Compel*, p. 6. In reviewing respondent's correspondence of April 11, 2011, respondent's counsel objects to petitioner's failure (1) "to produce documents as they are kept in the normal course of business ... or to identify by number/category the production request to which the documents are responsive," (2) to include a privilege

log, and (3) to respond to Document Request No. 29.²

Respondent's Correspondence of April 11, 2011. In its responsive correspondence of April 13, 2011, petitioner agreed to make available "the produced documents as they are kept," enclosed a privilege log and supplemented its response to Document Request No. 29 with additional documents and information. However, as petitioner points out, respondent's motion to compel "raises new allegations concerning Request Nos. 12-14, 17-21, 23, 24, 26, 27, 33, 34, 36-41, 44, 47-49, 51, 52, 56, 59-65 and 67 which were never the subject of any prior communication or Registrant's April 11th letter." *Petitioner's Response*, p. 5.

Trademark Rule 2.120(e)(1) is clear that a motion to compel discovery must be preceded by a good faith effort by the parties to resolve the *issues presented in the motion*. As there is nothing in the record to indicate that respondent has made a good faith effort to resolve the particular discovery requests that are the subject of its motion to compel, the motion to compel is **DENIED, without prejudice**, as to the enumerated discovery requests. As to compelling petitioner's categorization of the documents produced, the Board notes that petitioner has categorized the documents into sixteen

² Respondent's correspondence also concerns a dispute concerning the number of interrogatories served by respondent. However, as respondent's motion to compel is limited to its request for production of documents, that aspect of the correspondence between the parties has no bearing on the good faith certification related to respondent's motion to compel.

categories with corresponding Bates numbers as part of its response to respondent's motion to compel. Notably, respondent did not file a reply brief on its motion to compel and has not contested petitioner's contention that no good faith effort was made to resolve differences as to the specific discovery requests discussed in the motion to compel; and as respondent has not requested further categorization of the documents produced by petitioner and has not otherwise objected to the categorization of the documents, the Board will assume that categorization, or the lack thereof, is no longer in issue. Accordingly, the motion to compel is also **DENIED, without prejudice**, on this point, too.

However, as discovery issues remain, the parties are ordered to orally confer no later than **January 16, 2012**, to resolve any remaining discovery issues. The parties may not utilize mail, email or fax to comply with this order to meet and confer, and must discuss the remaining issues by phone or in person. In conferencing, the parties should keep in mind that discovery in this case should not be extensive. Petitioner and respondent both have registrations of their respective marks for watches. While petitioner has pleaded many other marks, and respondent has served many discovery requests, the crux of this dispute necessarily relates to the similarity of the parties' marks registered and used for

watches.³ And under well-established law and practice, the parties' respective watches are presumed to include watches at all price points, to travel in all customary channels of trade for such products, and to all potential consumers for such products, without regard to the actual cost, channels of trade or classes of consumers. The parties should also keep in mind that while the Board's manual of procedure explains that many types of information are discoverable, that does not mean that they should be the subject of discovery in every Board case. Finally, both parties are reminded of their duty to cooperate during discovery and to facilitate progress of the case to trial and eventual disposition on its merits.

Proceedings are **RESUMED** and dates are **RESET** as follows, including the date for the parties' compliance with the Board's order to meet and confer:

Deadline for Meet and Confer	1/16/2012
Expert Disclosures Due	2/15/2012
Discovery Closes	3/16/2012
Plaintiff's Pretrial Disclosures Due	4/30/2012
Plaintiff's 30-day Trial Period Ends	6/14/2012
Defendant's Pretrial Disclosures Due	6/29/2012
Defendant's 30-day Trial Period Ends	8/13/2012
Plaintiff's Rebuttal Disclosures Due	8/28/2012
Plaintiff's 15-day Rebuttal Period Ends	9/27/2012

³ Petitioner's registrations claim earlier dates of first use of petitioner's NAUTICA mark for watches than does respondent's registration for AIRNAUTIC for watches. Thus, while dates of first use are subject to proof in a cancellation proceeding such as this, it would not appear that priority is in issue in this case. While respondent included many affirmative defenses in its answer, it did not allege that it has priority of use.

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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