

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Mailed: August 30, 2015

Cancellation No. 92054171

Valeritas, Inc.

v.

VGO Communications, Inc.

**Robert H. Coggins,
Interlocutory Attorney:**

Now before the Board is Petitioner's combined motion to compel discovery, to determine the sufficiency of responses to requests for admission, and to reopen discovery.

Background

Discovery in this case originally opened September 6, 2011. *See* institution order (2 TTABVUE 2). After Petitioner filed seventeen consented motions to extend the close of discovery and one consented motion to reopen discovery, the Board firmly reset discovery to close September 10, 2014, and stated that no further extension of discovery would be granted absent a showing of extraordinary circumstances. *See* May 12, 2014 Order (51 TTABVUE 2).

On the last day of discovery as reset (i.e., September 10, 2014), Petitioner filed a combined motion to compel responses to various interrogatories and document requests and to extend the close of discovery. The Board quickly denied the motion without prejudice the next day for lack of sufficient good faith effort required under Trademark Rule 2.120(e)(1) for motions to compel; the Board also noted that proceedings would not be suspended and that dates remained as set.

On November 7, 2014, three days before its testimony period was scheduled to open, Petitioner filed a combined motion to compel responses to fewer interrogatories and document requests than presented in the September 10th motion, to newly test the sufficiency of responses to two requests for admission, and to reopen discovery. The next day, two days before the opening of testimony, Petitioner filed a motion for summary judgment. Proceedings were eventually suspended pending disposition of the motion for summary judgment, and consideration of the motion to compel was deferred until a decision on the potentially dispositive motion for summary judgment could be made. *See* March 3, 2015 Order (65 TTABVUE). Upon denial of the motion for summary judgment, the Board continued suspension for the motion to compel and allowed Petitioner time to inform the Board whether any issues raised therein had been subsequently resolved by the parties. *See* March 27, 2015 Order (66 TTABVUE). On April 10, 2015, Petitioner filed a response indicating that three interrogatories, two

document requests, and two requests for admission were still in dispute, as was the request to reopen discovery.

Motion to Compel and Determine Sufficiency

In the renewed motion, Petitioner moves to compel responses to Interrogatory Nos. 15 and 16, and Document Request Nos. 20, 22, and 29; and to test the sufficiency of Request for Admission Nos. 24 and 25.

Given the discovery history between the parties and the multiple filings related to the outstanding motion to compel, the Board presumes the parties' familiarity with the issues. For the sake of efficiency, the Board will not recite in this order each party's argument with regard to the seven discovery requests at issue; instead, after careful consideration of the motion to compel, brief in opposition thereto, statement of continuing viability, and response thereto, this order summarizes the determinations made by the Board.

Good faith effort

The Board finds that under the specific circumstance of this case Petitioner made the requisite good faith effort prior to filing the statement of continuing viability. *See* Trademark Rules 2.120(e)(1) and (h)(1).

Interrogatories and document requests

As an initial matter, the Board reminds Respondent that a party served with a request for discovery has a duty to thoroughly search its records for all information properly sought in the request, and to provide such information

to the requesting party within the time allowed for responding to the request. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000).

To the extent Respondent maintains its objections based on privilege, it must produce a privilege log. Fed. R. Civ. P. 26(b)(5)(A)(ii). Respondent's objections as to confidentiality are overruled. Respondent must produce allegedly confidential or proprietary information pursuant to the protective order that is automatically in place in this proceeding by operation of Trademark Rule 2.116(g). To the extent that Respondent believes a request would be burdensome to complete, Respondent may offer a representative sample, with an explanation why the total number of responsive documents would be burdensome to produce. *See, e.g., Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147, 148 (TTAB 1985) (reasonably representative sample of some items is sufficient where there are so many items as to make the responding party's task burdensome).

Interrogatory No. 15: The motion to compel is **granted** to the extent that Respondent's objections are overruled. Although the current substantive response appears otherwise reasonable and adequate, Respondent must serve an amended response not subject to the objections which have been overruled – even if such response is the same as the substantive response already given.

Interrogatory No. 16: The motion to compel is **granted** to the extent that Respondent's objections are overruled except for the one objection that

the interrogatory may suggest that PositiveID's device works in conjunction with Respondent's goods. Respondent must serve an amended response not subject to the objections which have been overruled. Respondent should explain facts, perhaps as it did in its response to the statement of continuing viability of the motion; such information belongs in an amended response to this interrogatory, not merely in a brief in opposition to a motion seeking to compel a better response.

Document Request No. 20: The motion to compel is **granted** to the extent that Respondent must produce its marketing plans for 2012, 2013, 2014, and 2015, or affirmatively state that such annual marketing plans do not exist.

Document Request No. 22: The motion to compel is **denied** to the extent it seeks to compel additional documents under this request.

Document Request No. 29: The motion to compel is **granted** to the extent that Respondent must produce a representative sample, with an explanation why the total number of responsive documents would be burdensome to produce.

Requests for admission

Fed. R. Civ. P. 36(a) requires that the answering party admit or deny the matter set forth in the requests for admission, or detail the reasons why the party can do neither.

Request for Admission No. 24: The motion to test the sufficiency is **granted** to the extent that Respondent's objection as to the meaning of "collaborated with" is overruled. Respondent should apply the commonly used dictionary definitions of the individual words. In view of the objection that has been overruled, the Board finds Respondent's response currently inadequate. Respondent must serve an amended response.

Request for Admission No. 25: The motion to test the sufficiency is **denied** as to this request. Although Respondent objected to meaning of "hosted a joint demonstration," Respondent's response explains that it did participate in a demonstration but the event did not include a wireless communication device. The Board finds Respondent's response is sufficient.

Respondent is allowed until **September 25, 2015**, in which to serve amended discovery responses in compliance with this order.

Motion to Reopen

The standard that applies to the motion to reopen discovery under Fed. R. Civ. P. 6(b)(1)(B) is whether Petitioner has demonstrated excusable neglect. *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997). In view thereof, Petitioner must establish that its failure to act in a timely manner (i.e., prior to the close of discovery) was the result of excusable neglect. See *Vital Pharm. Inc. v. Kronholm*, 99 USPQ2d 1708, 1710 (TTAB 2011). In *Pioneer Invs. Servs Co. v. Brunswick Assocs. L.P.*, 507 U.S. 380 (1993), as discussed by the Board in *Pumpkin, Ltd., supra*, the Supreme Court clarified

the meaning and scope of “excusable neglect,” as used in the Federal Rules of Civil Procedure and elsewhere. The Court held that the determination of whether a party’s neglect is excusable is:

at bottom an equitable one, taking account of all relevant circumstances surrounding the party's omission. These include. . . [1] the danger of prejudice to the [nonmovant], [2] the length of the delay and its potential impact on judicial proceedings, [3] the reason for the delay, including whether it was within the reasonable control of the movant, and [4] whether the movant acted in good faith.

Pioneer, 507 U.S. at 395. In subsequent applications of this test, several courts have stated that the third *Pioneer* factor, namely the reason for the delay and whether it was within the reasonable control of the movant, might be considered the most important factor in a particular case. *See Pumpkin, Ltd.*, 43 USPQ at 1586 n.7 and cases cited therein.

Petitioner fails to go through any analysis in the motion to reopen; instead, Petitioner states that it made good faith efforts to obtain discovery prior to the close of discovery. However, as the Board pointed out in its September 11, 2014 order, Petitioner had not made the requisite good faith effort to resolve the discovery conflict between the parties prior to the close of discovery. Petitioner’s statement of continuing viability of the motion to reopen is similar deficient; it merely recites a conclusive statement that there were “scheduling conflicts” related to the depositions of Bern Terry and Ned Semonite. The lack of any analysis by Petitioner weighs against granting the

motion. Nonetheless, the Board will attempt the appropriate analysis with the information before it.

With regard to the first *Pioneer* factor, there does not appear to be any evidence of prejudice to Respondent, and Respondent does not argue that it will be prejudiced.

With regard to the second *Pioneer* factor, the Board finds that the fifty-eight-day lapse (from the September 10th close of discovery until the November 7th filing of the motion to reopen) is not insignificant. Petitioner filed the motion after its pretrial disclosures were due and three days before its testimony period was scheduled to open. It appears that Petitioner rushed to file the motion to reopen and, indeed, the motion for summary judgment. Moreover, the Board cannot overlook the delay arising from the time required for briefing and deciding those motions. *See PolyJohn Enter. Corp. v. 1-800-Toilets Inc.*, 61 USPQ2d 1860 (TTAB 2002). It has now been almost one year since discovery closed.

With regard to the third *Pioneer* factor, the Board cannot determine that Petitioner was not responsible for its failure to serve any additional discovery requests or to take any additional discovery depositions before discovery closed. Petitioner did not rebut Respondent's statement that Respondent made certain of its employees available for depositions but that Petitioner chose not to conduct depositions of those employees. Petitioner was aware that due to the significant delay caused by the multiple consented requests to

extend and reopen time, any further motion to extend (and, consequently, to reopen) discovery would require extraordinary circumstances. Petitioner was aware of the heightened need to act within the time allowed. The Board finds that Petitioner's failure to provide an excusable neglect analysis weighs against Petitioner and a finding of excusable neglect.

With regard to the fourth *Pioneer* factor, the Board finds that there is no evidence of bad faith on the part of Petitioner. Respondent's arguments as to petitioner's own conduct and delay in providing responses to discovery requests have not been considered in determining this factor since they are misplaced; discovery before the Board is not governed by any concept of priority of discovery. *See* TBMP § 403.03.

On balance, and giving appropriate weight to the third *Pioneer* factor, the Board finds that Petitioner has not demonstrated excusable neglect. Accordingly, Petitioner's motion to reopen the discovery period is **denied**.

Schedule

Proceedings are resumed. Dates are reset on the following schedule:

Compelled Discovery Due	9/25/2015
Plaintiff's Pretrial Disclosures	9/30/2015
Plaintiff's 30-day Trial Period Ends	11/14/2015
Defendant's Pretrial Disclosures	11/29/2015
Defendant's 30-day Trial Period Ends	1/13/2016
Plaintiff's Rebuttal Disclosures	1/28/2016
Plaintiff's 15-day Rebuttal Period Ends	2/27/2016

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.