

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

Mailed: September 4, 2013

Cancellation No. 92056168

Legend Pictures LLC

v.

Quentin Davis

**Cheryl S. Goodman, Interlocutory Attorney:**

This case now comes up on the following motions:

- 1) Respondent's motion to quash and objection to petitioner's interrogatories, filed April 13, 2013;
- 2) Petitioner's motion to amend, filed May 30, 2013;  
and
- 3) Petitioner's motion to compel, filed May 30, 2013.<sup>1</sup>

The Board turns first to petitioner's motion to compel and respondent's motion to quash.

Respondent's motion to quash and objection to petitioner's interrogatory requests and requests for production are identical, in that respondent has simply filed an objection that the interrogatory requests and requests for production are excessive in number.

With regard to the motion to compel, petitioner seeks answers to its first and second set of interrogatories (nos.

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<sup>1</sup> Opposer's also filed a motion to compel on May 22, 2013

1-21) and answers without objection to its first set of requests for production nos. 2-5, 6(a), 7, 12-29, 31-39; and answers to its first set of requests for production nos. 1, 6(b), 8-11, 30 and 40-42. Petitioner also seeks production of all documents with regard to request for production nos. 1-42.

With regard to its good faith effort to resolve the discovery dispute, petitioner advises that it sent two letters on April 29, 2013, and May 2, 2013 "to explain Davis' duties in discovery and pointing out relevant precedent" when no discovery responses were forthcoming. According to petitioner, although respondent "appeared to agree to produce some of the documents," no documents were produced, and respondent refused to answer any interrogatories and failed to provide written responses to the requests for production. Petitioner seeks a sixty-day extension of discovery for itself.

In its motion, petitioner submits that its twenty-one interrogatory requests do not exceed the 75 interrogatory requests provided for under the Trademark Rule.

With regard to the requests for production, petitioner complains that "Davis has failed and refused to answer these discovery requests or produce the requested documents for any reason whatsoever." Petitioner asserts that "[a]n

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but withdrew the motion on May 30, 2013 in view of respondent's

objection to interrogatories on the ground that they exceed 75 does not constitute an objection to unrelated requests for production." Petitioner further seeks production of a privilege log or waiver of any objections based on privilege.

Lastly, petitioner seeks an extension or reopening of discovery solely for its benefit for 60 days due to respondent's failure to provide discovery and as a result, its inability to take follow-up discovery.

In response, respondent complains that "Petitioner offered no response whatsoever to Registrant's objection for a period of sixteen days." Respondent submits it cannot be accused of hindering discovery when petitioner "deprived itself of over 2 additional weeks of discovery for no apparent reason at all." Respondent also complains about petitioner's delay in commencing formal discovery.

Respondent submits that it provided counts for petitioner's interrogatory requests and "offered to answer a properly revised set of interrogatories and document requests in these [sic] correspondence" in good faith. Respondent advises that it "did offer to respond to production requests which were not linked to interrogatories" but "Petitioner declined this offer . . . ." Respondent "asks that the Board recognize the actions

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withdrawal of Notification of Expert Testimony.

of the Registrant as rightfully compliant with . . . TBMP 405.03(d), 405.03(e). . . . "

In reply, petitioner argues that it "acted entirely timely and appropriately in initiating discovery and attempting to resolve the dispute" and that respondent has "refused to answer" any of petitioner's interrogatories and requests for production. Petitioner asserts that its motion to compel should be granted.

The Board finds that petitioner made a good faith effort to resolve the discovery dispute.

With regard to document request nos. 40-42, the motion to compel is denied inasmuch as petitioner has submitted no copies of request for production nos. 40-42 in connection with the motion, as required by Trademark Rule 2.120.<sup>2</sup> With regard to the interrogatory requests nos. 1-21, the Board finds that interrogatory requests nos. 1-21 do not exceed 75 in number, including subparts.

Accordingly, petitioner's motion to compel is granted with regard to the first and second interrogatory requests nos. 1-21. In view thereof, respondent's motion to quash is denied. Respondent is allowed until THIRTY DAYS from the mailing date of this order to serve written responses to interrogatory requests nos. 1-21.

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<sup>2</sup> The first requests for production in exhibit B are numbered 1-39.

With regard to the requests for production, there is no limit on the number of document requests that can be propounded, and therefore, respondent has not interposed a valid objection to responding to these requests. Requests for production nos. 2, 3, 4, 5, 6(a), 7, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 31, 32, 33, 34, 35, 36, 37, 38 and 39 do not relate to any interrogatory requests. Therefore, the Board finds that objections to these requests were waived. TBMP Section 406.04(a) (3d ed.rev.2 2013). With regard to requests for production nos. 1, 6(b), 8-11, and 30 these requests do relate to the interrogatory requests, and to the extent these objections could be considered as interposed with regard to these requests they are overruled.

The Board finds that respondent failed to produce written responses to the requests for production and failed to produce responsive documents.

Accordingly, the motion to compel is granted with regard to requests for production nos. 2, 3, 4, 5, 6(a), 7, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 31, 32, 33, 34, 35, 36, 37, 38 and 39 to the extent that respondent must provide written responses to these requests without objection. The motion to compel is granted with regard to requests for production nos. 1, 6(b), 8-11, 30 to the extent that respondent must provide written

responses to these requests. Respondent is allowed until THIRTY DAYS from the mailing date of this order to serve his written responses to the requests for production. In view thereof, respondent's motion to quash is denied.

Additionally, inasmuch as no responsive documents have been produced with regard to any of these requests, and no valid objections have been interposed, the motion to compel is granted to the extent that respondent is allowed until THIRTY DAYS from the mailing date of this order to produce responsive document with respect to these requests, and to the extent that responsive documents are deemed subject to privilege, respondent shall produce a privilege log in accordance with Fed. R. Civ. P. 26(b)(5).

The Board turns next to petitioner's request to reopen discovery.

The Board finds that due to respondent's failure to timely serve responses to discovery, petitioner was deprived of an opportunity to conduct follow-up discovery. Reopening discovery would afford petitioner the opportunity to take follow-up discovery once respondent's responses to discovery are received.

Accordingly, petitioner's motion to extend/reopen discovery by sixty days is granted. However, the Board grants the reopening of discovery for both parties, in view

of petitioner's motion for leave to amend as discussed  
infra.

The Board turns next to petitioner's motion for leave to amend. Petitioner seeks to amend the petition to cancel to allege that its pleaded Registration No. 3412677 has become incontestable, that its pleaded Registration nos. 3656926 and 3621043 have been amended, and that petitioner has used the terms LEGENDARY and LEGENDARY PICTURES as trade names.

Petitioner asserts that its amendment regarding Registration No. 3412677 is timely as the registration became incontestable on May 15, 2013. With regard to Registration Nos. 3656926 and 3621043 petitioner argues that the amendment is timely because the Section 7(e) requests filed on August 29, 2012 were pending at the time of the filing of the petition to cancel, and were "properly identified." Petitioner also points to respondent's answer which acknowledges the pending Section 7(e) requests and respondent's discovery requests which sought the basis for amendment as evidence of respondent's awareness of the status of these registrations prior to petitioner's filing of the amendment.

Petitioner further submits that justice requires amendment of the pleading to amplify petitioner's allegations regarding the use of the trade names LEGENDARY

and LEGENDARY PICTURES. Petitioner asserts that it is evident that respondent understood petitioner's pleading to allege use of LEGENDARY and LEGENDARY pictures as part of its trade name since "half of Defendant's discovery requests . . . were directed to Petitioner's use of the term LEGENDARY and LEGENDARY PICTURES as a trade name" arguing that it is evident that respondent understood petitioner's pleading to allege use of the terms LEGENDARY and LEGENDARY PICTURES as part of its trade names.

In response, respondent argues that the amendment is untimely and he has provided no consent for leave to amend. Respondent further argues that justice does not require amendment.

In reply, petitioner submits that respondent cannot be prejudiced since "he has been aware of these issues by Petitioner since he filed his Answer and has taken discovery on these issues."

The Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party. Fed. R. Civ. P. 15(a); TBMP Section 507.02 (3d ed. rev.2 2013). The timing of a motion for leave to amend is a major factor in determining whether the adverse party would be prejudiced by allowance of the proposed amendment. *Commodore Electronics*

*Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1505-6 (TTAB 1993). The Board will generally grant a motion for leave to amend when the proceedings are still in the pre-trial phase. See e.g., *Polaris Industries v. DC Comics*, 59 USPQ2d 1798, 1799 (TTAB 2001) (finding no prejudice in allowing amendment of complaint where motion was filed prior to the close of discovery and opposer stipulated to an extension of discovery). In deciding petitioner's motion for leave to amend, the Board must consider whether there is any undue prejudice to applicant and whether the amendment is legally sufficient. See *Cool-Ray, Inc. v. Eye Care, Inc.*, 183 USPQ 618 (TTAB 1974).

In this case, petitioner has provided an explanation for the timing of its amendments, and although it could have filed amendments with regard to Registration Nos. 3656926 and 3621043 and its trade name use sooner, respondent was on notice regarding these issues and already has taken discovery on these matters. Accordingly, the Board finds no prejudice to respondent in allowing these clarifying and amplifying amendments, and because discovery is reopened by sixty days, respondent is not prejudiced by the amendment, should respondent need additional discovery on these matters. Additionally, the amendments are sufficiently pleaded. In view thereof, leave to amend is granted.

**Cancellation No. 92056168**

The amended petition to cancel is accepted. Respondent is allowed until THIRTY DAYS from the mailing date of this order to file an answer to the amended petition to cancel.

Proceedings are resumed.

Dates are reset as follows:

Expert disclosures due	9/12/13
Discovery Closes	<b>10/31/2013</b>
Plaintiff's Pretrial Disclosures Due	<b>12/15/2013</b>
Plaintiff's 30-day Trial Period Ends	<b>1/29/2014</b>
Defendant's Pretrial Disclosures Due	<b>2/13/2014</b>
Defendant's 30-day Trial Period Ends	<b>3/30/2014</b>
Plaintiff's Rebuttal Disclosures Due	<b>4/14/2014</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>5/14/2014</b>

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.