

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

Baxley

Mailed: March 3, 2014

Cancellation No. 92056362

Milano Series International
Products, Ltd.

v.

Milano Bags Inc.

Andrew P. Baxley, Interlocutory Attorney:

This case now comes up for consideration of petitioner's second motion (filed January 13, 2014) to compel discovery and to suspend this proceeding until petitioner receives the information and documents requested in that motion. The motion has been fully briefed.

In a July 2, 2013 order, wherein the Board denied without prejudice petitioner's first motion to compel, petitioner was warned that the Board "will not entertain any further motion[s] to compel from petitioner" in which petitioner "does not cite to specific authority which establishes that the information and/or documents sought through each discovery request at issue is properly discoverable in Board proceedings." July 2, 2013 order at 9. Notwithstanding the clear requirement of that order,

petitioner, in its second motion to compel, does not cite to any such specific authority in support thereof; a general reference to Federal Rule of Civil Procedure 26 toward the end of the brief in support of that motion is insufficient.¹

In addition, petitioner did not include copies of its discovery requests and respondent's initial and supplemental responses thereto as exhibits to the second motion to compel, as required by Trademark Rule 2.120(e)(1). Although petitioner included copies of the discovery requests and initial responses at issue as

¹ A cursory review of petitioner's second motion to compel indicates that petitioner contends that respondent's responses to certain interrogatories are insufficient because they do not comply with petitioner's instructions. The Board, in deciding a motion to compel, is not governed by the introductory instructions of discovery requests. See *Avia Group Int'l Inc. v. Faraut*, 25 USPQ2d 1625, 1626 (TTAB 1992); TBMP Section 405.03(d). Accordingly, mere noncompliance with instructions is not a basis for compelling a supplemental response.

Petitioner also contends that these responses are insufficient because two of the persons identified in respondent's responses reside in Peru, while respondent is a Florida corporation. Presuming these responses are accurate, such identification is acceptable.

Regarding respondent's responses to certain document requests, respondent need only produce responsive documents and things that are in its possession, custody, or control. See Fed. R. Civ. P. 34(a)(1). Respondent is not obligated to create documents solely to satisfy petitioner's document requests. See *Washington v. Garrett*, 10 F.3d 1421, 1437-38 (9th Cir. 1993). However, respondent may, upon timely objection from petitioner, be precluded from relying at trial upon information and/or documents that were properly sought, but not disclosed, during discovery, unless such failure to disclose "was substantially justified or is harmless." Fed. R. Civ. P. 37(c)(1).

exhibits to its first motion to compel and quoted its discovery requests and respondent's responses thereto in the second motion to compel, no copies of respondent's actual supplemental responses are of record. Based on the foregoing, the second motion to compel is denied without prejudice, and petitioner's motion to suspend is denied.²

Further, although not raised by respondent in its brief in response, pages 5 through 9 of petitioner's brief in support of the motion to compel are improperly formatted because they consist of quotations of the individual discovery requests and responses at issue followed by

² In the above-captioned proceeding, petitioner seeks cancellation respondent's involved registration on the Supplemental Register for the mark MILANO BAGS in standard character form under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), based on likelihood of confusion with its registered MILANO SERIES marks. Petitioner can prove its standing by making of record status and title copies of its pleaded registrations. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); Trademark Rule 2.122(d)(1). In addition, because both parties own registrations, petitioner must prove priority of use. In view of the September 19, 1986 constructive use filing date of the application for petitioner's pleaded Registration No. 1478357, which precedes the application filing date and dates of first use set forth in the involved registration by more than two decades, priority is not likely to be an issue herein. See Trademark Act Section 7(c), 15 U.S.C. Section 1057(c); *M.C.I. Foods Inc. v. Bunte*, 96 USPQ2d 1544, 1550 (TTAB 2010). Moreover, petitioner's pleaded registrations and respondent's involved registration all consist of the word MILANO and a disclaimed word.

As such, the following issues are likely to be crucial in deciding this case: (1) the strength of the pleaded MILANO SERIES mark; (2) the scope of protection to which that mark is entitled; (3) the extent of third party use of similar marks on related goods and services; and (4) whether the goods at issue are related in a manner that is likely to cause source confusion. The parties are urged to concentrate their discovery on these areas.

single-spaced legal arguments in support of the motion to compel. Although block quotes of fifty or more words should be single-spaced, quotes of less than fifty words and legal arguments "must be ... double-spaced." Trademark Rules 2.126(a)(1) and (b). Petitioner was previously told not to present legal arguments in single spacing. See July 2, 2013 order at 1-2.

Pursuant to the Board's January 13, 2014 order, proceedings will resume on March 7, 2014 under the following schedule:

Expert Disclosures Due	4/15/2014
Discovery Closes	5/15/2014
Plaintiff's Pretrial Disclosures Due	6/29/2014
Plaintiff's 30-day Trial Period Ends	8/13/2014
Defendant's Pretrial Disclosures Due	8/28/2014
Defendant's 30-day Trial Period Ends	10/12/2014
Plaintiff's Rebuttal Disclosures Due	10/27/2014
Plaintiff's 15-day Rebuttal Period Ends	11/26/2014

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