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

Mailed: July 2, 2013

Cancellation No. 92056362

Milano Series International Products, Ltd.

v.

Milano Bags Inc.

Andrew P. Baxley, Interlocutory Attorney:

On April 17, 2013, petitioner filed a combined motion to compel discovery and to extend the close of discovery by ninety days. The motion has been fully briefed.

Although not raised by respondent in its brief in response, pages 5 through 20 of petitioner's twenty-two page brief in support of the combined motion consist of single-spaced block quotations of the individual discovery requests and responses at issue followed by single-spaced legal arguments in support of the motion to compel.[1] The

[1] In the motion to compel, petitioner essentially copies the nineteen-page deficiency letter that petitioner's attorney sent to respondent's attorney on March 11, 2013. In that letter, petitioner's attorney demanded supplemental responses by March 27, 2013. In a March 29, 2013 e-mail, respondent's attorney stated that respondent was "working on" supplemental responses and that petitioner would receive them by April 1, 2013. Petitioner filed its motion after respondent failed to provide the supplemental responses and did not respond to petitioner's attorney's April 4, 2013 e-mail and and April 10, 2013 voicemail message.

rules applicable to all Board proceedings require double-spaced text in written submissions.[2] Trademark Rules 2.126(a)(1) and (b), 37 C.F.R. §§ 2.126(a)(1) and (b).

Petitioner may not circumvent the applicable page limit for a brief on a motion, Trademark Rule 2.127(a), 37 C.F.R. § 2.127(a), by single-spacing its legal arguments in its brief in support of its combined motion. *Cf. Consorzio del Prosciutto di Parma Sausage Products Inc.,* 23 USPQ2d 1894, 1896 n.3 (TTAB 1992) (single-spaced footnotes containing substantial discussion may be viewed as a subterfuge to avoid page limit). Had petitioner's legal arguments been double-spaced, as required by Rule 2.126, petitioner's brief in support of its combined motion would have exceeded the twenty-five page limit for briefs in support of motions in Board proceedings. Accordingly, the merits of petitioner's motion to compel will receive no consideration, and that motion therefore is denied without prejudice. See *Saint-Gobain Corp. v. Minnesota Mining and Mfg. Co.*, 66 USPQ2d 1220 (TTAB 2003).

Notwithstanding that the motion has not been considered on its merits, the Board takes notice that of the seventeen numbered interrogatories and thirty-one

[2] However, quotes of fifty or more words should be single-apaced. See *A Uniform System of Citation*, Rule 5.1 (19th ed. 2010) (quotation formatting).

document requests served by petitioner, petitioner seeks further responses to fifteen interrogatories and twenty-six document requests, i.e., forty-one of forty-eight discovery requests. Had the Board considered the motion to compel on the merits, it would have been denied without prejudice based on the excessive number of discovery requests at issue therein. Petitioner appears merely to have assumed that it is entitled to all information and documents requested and, based thereon, has requested supplemental response to every response that it considers deficient, apparently without regard to whether or not it needs the requested information and/or documents to prove its pleaded claim under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d).[3] Petitioner filed the motion to compel with more than ten weeks remaining in the discovery period, without the parties having conferred in any meaningful way to discuss the deficiencies alleged in its attorney's March 11, 2013 letter.

At the same time, the Board finds that respondent is also blameworthy for the circumstances presented in the motion to compel. Respondent's attorney, in a March 29, 2013 e-mail, stated that respondent would supplement its

[3] Petitioner does not cite to any case law to support the alleged discoverability of any of the information and documents sought through any of the discovery requests at issue in the motion to compel.

discovery responses on April 1, 2013. In doing so, respondent implicitly acknowledged that at least some of petitioner's objections to its discovery responses were valid. Respondent then failed to provide the promised supplemental discovery and later failed to respond to petitioner's attorney's e-mail and voicemail messages. Respondent's actions in this case indicate that it has not met its duty to make a good faith effort to satisfy petitioner's discovery needs. See TBMP Section 408.01 (3d ed. rev. 2 2013).

When they disagree about discovery matters, the parties must adhere to the strictures set forth in *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986), and repeated below:

> [W]here the parties disagree as to the propriety of certain requests for discovery, they are under an obligation to get together and attempt in good faith to resolve their differences and to present to the Board for resolution only those remaining requests for discovery, if any, upon which they have been unable, despite their best efforts, to reach an agreement. Inasmuch as the Board has neither the time nor the personnel to handle motions to compel involving substantial numbers of requests for discovery which require tedious examination, it is generally the policy of the Board to intervene in disputes concerning discovery, by determining motions to compel, only where it is clear that the parties have in fact followed the aforesaid process and have narrowed the amount of disputed requests for discovery, if any, down to a reasonable number.

The Board finds that, in view of the parties' failure to confer in any meaningful way to reduce the number of discovery requests at issue to a reasonable number prior to the filing of that motion, the parties failed to make a sufficient good faith effort to resolve their discovery dispute prior to petitioner's seeking Board intervention.[4] The parties could have significantly reduced the number of discovery requests at issue by actually conferring prior to the filing of petitioners' combined motion; and they should have referred throughout such conference to TBMP Section 414, which provides information regarding the discoverability of various categories of information in Board *inter partes* proceedings, and cases cited therein.

To assist the parties in their effort to resolve the issues involved in the present discovery dispute, the following matters are noted in addition to those noted above.[5] A cursory review of respondent's discovery responses indicates that many of them are inadequate. For

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[4] Had petitioner complied with the page limit and limited the discovery requests at issue in its motion to a reasonable number that sought information that was essential to proving its pleaded Section 2(d) claim, the Board would have found that petitioner made a good faith effort to resolve the parties' dispute prior to seeking Board intervention and would have considered the motion to compel on the merits.

[5] Such observations are intended as general guidance and are not a comprehensive review of respondent's discovery responses.

example, respondent's interrogatory responses are not under oath, as required by Fed. R. Civ. P. 33(b)(3).[6]

In addition, several of respondent's interrogatory responses do not answer the question posed. For example, in interrogatory no. 2, petitioner seeks the identity of the persons most knowledgeable of the marketing, advertising, distribution and/or sale of the identified goods under the involved mark. In interrogatory no. 3, petitioner seeks the identity of the persons who conceived the involved mark. In response to both interogatories, respondent states that "Ana Silvana Diaz Suarez and Andres Haaker Velaochaga are the owners of the company." If the owners of the company are the persons to be identified in responses to these interrogatories, respondent should say so in amended responses.

Moreover, many of respondent's responses to document requests consist of objections that the particular request is "overly broad and burdensome," followed by "[p]lease see the attached." Concurrently with its discovery responses,

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[6] Respondent's interrogatory respones are signed by respondent's attorney. While respondent's attorney may answer interrogatories even though he has no personal knowledge of the facts stated therein, the attorney's answers, like an officer's answers, must be based on the information available to respondent itself. See *Allstate Insurance Co. v. Healthy America Inc.*, 9 USPQ2d 1663 (TTAB 1988). Moreover, an attorney who answers interrogatories on behalf of a corporation becomes a fact witness and thus may face disqualification. See Patent and Trademark Rule 11.307; *id.*

respondent served a small stack of numbered documents which do not specify the response(s) to which each document is responsive.

In responding to each document request, a party must state whether or not it has responsive documents in its possession, custody or control and, if so, state that such documents will be produced or that such documents are being withheld, based on a claim of privilege or a specified objection. See Fed. R. Civ. P. 34(b)(2)(B); *No Fear Inc. v. Rule,* 54 USPQ2d 1551 (TTAB 2000). Merely stating objections to document requests without explaining the reasons therefor is insufficient. See Fed. R. Civ. P. 34(b)(2)(B).

"A party must produce documents as they are kept in the usual course of business or must organize and label them to correspond to the categories in the request." Fed. R. Civ. P. 34(b)(2)(E)(i). Although respondent appears to have produced responsive documents concurrently with its discovery responses, production of a stack of numbered documents without indicating the document request(s) to which any of the documents are responsive is insufficient. Respondent should identify the document request to which each produced document is responsive.

In response to document request nos. 19 and 20, respondent states that responsive documents "may be subject to the Attorney Work Product Doctrine." A responsive document is either subject to the attorney work product doctrine, or it is not. Merely raising the possibility that responsive documents may be subject to a claim of privilege is insufficient because it indicates that respondent may not have conducted a thorough search of its records. See TBMP Section 408.02. In addition, respondent did not serve a privilege log in compliance with Fed. R. Civ. P. 26(b)(5).

Respondent is reminded that it has a duty to supplement and/or correct its discovery responses. See Fed. R. Civ. P. 26(e)(1). Respondent is further reminded that it 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).[7]

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[7] The foregoing is not an order relating to discovery as contemplated by Trademark Rule 2.120(g)(1). See TBMP Section 527.01(a). Petitioner's remedy in the event that respondent does not supplement its discovery based on the foregoing is to file a renewed motion to compel.

If petitioner files a renewed motion to compel, greater effort to resolve the outstanding issues will be expected than was exhibited prior to the filing of the subject motion. That is, the Board will not entertain any further motion to compel from petitioner that does not state that the parties have actually conferred in an attempt to resolve their discovery dispute[8] and that 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. See TBMP Section 414; *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.,* 10 USPQ2d 1671 (TTAB 1988). Any such motion should be reduced to a reasonable number of discovery requests which seek information and/or documents which are crucial to petitioner's pleaded Section 2(d) claim.

Proceedings herein are resumed. In view of petitioner's consent in its brief in response to the motion to extend the discovery period by ninety days, the Board finds that a ninety-extension of the discovery period is appropriate. Dates herein are reset as follows.

Expert Disclosures Due	**11/9/2013**
Discovery Closes	**12/9/2013**

[8] Respondent's attorney is directed to promptly make himself available for such a conference.

Plaintiff's Pretrial Disclosures Due	**1/23/2014**
Plaintiff's 30-day Trial Period Ends	**3/9/2014**
Defendant's Pretrial Disclosures Due	**3/24/2014**
Defendant's 30-day Trial Period Ends	**5/8/2014**
Plaintiff's Rebuttal Disclosures Due	**5/23/2014**
Plaintiff's 15-day Rebuttal Period Ends	**6/22/2014**

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.l25.

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.l29.

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