

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

Mailed: February 7, 2014

Cancellation No. 92057344

Cloudpath Networks, Inc.

v.

Racemi, Inc.

Andrew P. Baxley, Interlocutory Attorney:

Pursuant to the Board notice instituting this proceeding, the discovery period was set to close on February 23, 2014. This case now comes up for consideration of petitioner's motion (filed December 3, 2013) to compel production of discovery documents. The motion has been fully briefed.

The record herein indicates that petitioner served its first set of document requests on September 20, 2013 and that respondent served written responses thereto on October 25, 2013, but has yet to produce discovery documents. In view of respondent's failure to produce any discovery documents as of the filing of the motion, petitioner asks that respondent: (1) be compelled to fully respond to petitioner's first set of document requests; (2) be found to have forfeited the right to object to discovery requests on

the merits; and (3) be precluded from relying at trial upon certain documents.

In response, respondent contends that it timely served written responses to petitioner's document requests; that it is entitled to a reasonable time after service of written responses to document requests to produce responsive documents; that a reasonable time after service of its responses to petitioner's document requests has not passed; and that petitioner's motion to preclude respondent from relying upon certain documents at trial is premature. Accordingly, respondent asks that the motion to compel be denied.

In reply, petitioner contends that respondent has been allowed a reasonable time in which to produce documents.

The Board finds that petitioner made a good faith effort to resolve the parties' discovery dispute prior to seeking Board intervention. See Trademark Rule 2.120(e)(1). Nonetheless, petitioner's motion is not well-taken.

In responding to document requests, a party need only state (1) whether it has responsive documents in its possession, custody and control; and (2) if so, either that responsive documents "will be produced" or withheld based on a claim of privilege or a specific objections. *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555-56 (TTAB 2000) (emphasis added). That is, a party is not required to produce

discovery documents concurrently with its written responses to document requests.¹ See *id.*; Fed. R. Civ. 34(b); Trademark Rule 2.120(a)(3). Further, neither Federal Rule of Civil Procedure 34(b) nor Trademark Rule 2.120(a)(3) provides a specific time in which discovery documents must be produced. Rather, the Board expects parties to cooperate in the discovery process. See TBMP Section 408.01 (3d ed. rev.2 2013).

The record herein indicates that respondent served full written responses in a timely manner to petitioner's first set of document requests.² Accordingly, petitioner has not forfeited the right to object on the merits to those document requests. See TBMP Sections 403.03 and 406.04(a). Likewise, to the extent that petitioner seeks to preclude respondent from relying upon certain documents at trial, the Board does not prospectively exclude evidence that might be

¹ To the extent that petitioner, in the general instructions of its document requests, requested that respondent produce all responsive documents concurrently with written responses to those requests, that request is unreasonable.

² To the extent that petitioner contends that any of respondent's written responses are improper, petitioner's remedy is to file a renewed motion to compel further responses to specific discovery requests after having made a good faith effort to resolve the parties' discovery dispute. See Trademark Rule 2.120(e)(1). Any such motion should include citation to specific authority which supports the discoverability of the information sought through each discovery request at issue. See TBMP Section 414 regarding the discoverability of various types of information in Board proceedings.

introduced at trial.³ See *Greenhouse Systems Inc. v. Carson*, 37 USPQ2d 1748, 1750 (TTAB 1995); TBMP Section 527.01(f). To the extent that petitioner seeks to preclude respondent from relying on certain documents at trial as a discovery sanction, the Board notes that no order compelling discovery has been issued in this case, and that respondent has not affirmatively stated that no responsive documents will be produced. See Trademark Rule 2.120(g); TBMP Sections 527.01(a) - (b).

Based on the foregoing, petitioner's motion to compel is denied in full.⁴ Nonetheless, in the interest of minimizing further discovery disputes herein, respondent is allowed until thirty days from the mailing date set forth in this order to select, designate and identify the items and documents, or categories of items and documents, to be produced in response to petitioner's first set of document requests and to notify petitioner that the selection, designation and identification of such items and documents has been completed. If the materials are voluminous, respondent may produce a representative sampling and inform

³ Rather, if respondent seeks to use as trial evidence documents which were properly sought, but not produced, in discovery, petitioner's remedy is to timely object at trial. See Fed. R. Civ. P. 37(c)(1).

⁴ Nonetheless, respondent is reminded that it has a duty to correct and/or supplement its discovery responses as necessary. See Fed. R. Civ. P. 26(e).

petitioner that a representative sampling has been produced. Petitioner may then inspect and copy the produced materials, as provided for in Fed. R. Civ. P. 34(b) and Trademark Rule 2.120(d)(2), unless the parties otherwise agree.⁵ If respondent fails to comply with this order, petitioner's remedy lies in a renewed motion to compel, pursuant to Trademark Rule 2.120(e)(1).⁶

Proceedings herein are resumed. Remaining dates are reset as follows.

Expert Disclosures Due	3/30/2014
Discovery Closes	4/29/2014
Plaintiff's Pretrial Disclosures Due	6/13/2014
Plaintiff's 30-day Trial Period Ends	7/28/2014
Defendant's Pretrial Disclosures Due	8/12/2014
Defendant's 30-day Trial Period Ends	9/26/2014
Plaintiff's Rebuttal Disclosures Due	10/11/2014
Plaintiff's 15-day Rebuttal Period Ends	11/10/2014

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.

⁵ In Board cases, parties often extend each other the courtesy of producing requested documents by copying the documents and forwarding them to the requesting party at the requesting party's expense. The Board believes this is more efficient and thus encourages this method of producing documents. See TBMP Section 406.04.

⁶ The foregoing is in the nature of a schedule and is not an order relating to discovery, as contemplated by Trademark Rule 2.120(g)(1). Because the Board denied petitioner's motion to compel in this order, a motion for sanctions under Trademark Rule 2.120(g)(1) would be inappropriate.

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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.

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