

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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General Contact Number: 571-272-8500

BUO

Mailed: February 4, 2015

Cancellation No. 92058638

*Lisa Alyn*

*v.*

*Southern Land Co., LLC*

**Benjamin U. Okeke, Interlocutory Attorney:**

Now before the Board is Respondent's motion, filed October 6, 2014, to: (1) compel Petitioner to fully respond to Respondent's first set of interrogatories, including a signed verification from Petitioner, and document production requests; (2) have certain of Respondent's requests for admission deemed admitted in light of Petitioner's failure to appropriately respond to those requests; and (3) compel Petitioner to serve its initial disclosures in this proceeding.

The Board, in its discretion, suggested that the issues raised in the motion be resolved by telephone conference as permitted by TBMP § 502.06 (2014). The conference was held at 12:30 p.m. EST, on Friday, January 30, 2015. Participating in the conference were Petitioner's counsel, Gregory D. Latham and Brandon Frank, Respondent's counsel, James R. Michels, and Board interlocutory attorney, Benjamin U. Okeke.

The Board carefully considered the arguments raised by the parties during the telephone conference, as well as the briefs on the motions and exhibits attached thereto, and the record of this case in coming to a determination regarding the issues presented in the motions.

The Board presumes the parties' familiarity with the factual background and arguments with respect to this motion, particularly in light of the telephone conference, and therefore will only recount the facts and arguments as necessary to discuss this motion.

During the telephone conference, the Board made the following findings and determinations:

***Motion to Compel***

Initially, the Board finds that Respondent made a sufficient good faith effort to resolve the parties' discovery disputes prior to seeking Board intervention. *See* Trademark Rule 2.120(e)(1). Notwithstanding Petitioner's contention that "[t]he parties have never conferred on" the matter of Petitioner's initial disclosures, indeed Respondent's letter to Petitioner, dated August 8, 2014, includes a paragraph addressing Petitioner's initial disclosures and pointing out that they "have yet to be produced." Motion, Ex. C, p.9. Therefore, a good faith effort has been made by Respondent as to each issue raised in its motion. Additionally, the Board finds that the motion has been timely made. *Id.*

The Board reminded the parties that a party may take discovery not only as to matters specifically raised in the pleadings, but also as to any matter which might serve as the basis for an additional claim, defense, or counterclaim. *See Varian Assoc. v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975) (discussing general scope of discovery); *Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 181 USPQ 286, 287 (TTAB 1974) (opposer must answer interrogatories concerning allegations in notice of opposition); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 187 (TTAB 1974) (“applicant is entitled to take discovery not only as to the matters specifically raised in the pleadings but also as to any matters which might serve as the basis for an affirmative defense or for a counterclaim.”). While the scope of discovery is therefore rather broad, parties may not engage in “fishing expeditions” and must act reasonably in framing discovery requests. Fed. R. Civ. P. 26(b). *See Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1305 (TTAB 1987).

The Board will take up each category of information at issue in this motion in turn:

- **Interrogatories and Document Requests**

A. *Petitioner’s Awareness of Respondent and Its Marks; Interrogatory Nos. 9-10 and Document Request Nos. 6-8 and 25-26.*

It is unclear, and Respondent offers no compelling explanation as to what relevance this category of information carries in a cancellation proceeding involving a claim of fraud based upon Petitioner’s allegation that Respondent misinformed the USPTO regarding the geographic significance of its mark.

Indeed, as Petitioner points out, this is a line of questioning more appropriate for a determination of a likelihood of confusion claim. In fact, Respondent itself has couched much of its argument regarding the motion to compel and its objected-to discovery requests on the misplaced notion that this proceeding by virtue of Petitioner's pleading of its standing implicates "the likelihood of confusion factors set forth in *In re E.I. DuPont DeNemours & Co.*, 177 USPQ 563 (CCPA 1973)." Motion, Ex. C, p.1. This is simply not true as explained further *infra*.

Nonetheless, inasmuch as Petitioner has not pleaded any property that may be the subject of a counterclaim alleging priority and likelihood of confusion, the Board construes these questions as supporting a potential defense of laches. However, laches, while a viable defense to a claim of likelihood of confusion under Trademark Act Section 2(d), will not lie as a defense to a fraud claim. *See Hornby v. Tjx Cos. Inc.*, 87 USPQ2d 1411, 1419 (TTAB 2008) (*citing Treadwell's Drifters Inc. v. Marshak*, 18 USPQ2d 1318 (TTAB 1990)). Therefore, it would be futile for Respondent to attempt to pursue such a defense, and thus discovery aimed at a defense of laches would be imprudent.<sup>1</sup>

Accordingly, Respondent's motion to compel is **DENIED** with respect to Interrogatory Nos. 9-10 and Document Request Nos. 6-8 and 25-26.

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<sup>1</sup> This is equally applicable to the other equitable defenses relating to Petitioner's knowledge of Respondent, its use of the challenged mark, and any perceived delay in opposing such use. This is because it is in the public interest to prohibit registrations procured or maintained by fraud, but the defenses are available when the rights asserted by a petitioner are personal in nature.

*B. Petitioner's Use of the WESTHAVEN Mark; Interrogatory No. 2 and Document Request Nos. 4 and 20-21.*

Both parties miss the mark in their respective discussions regarding the relevance of Petitioner's use of the WESTHAVEN mark. As previously stated, Respondent's discovery requests appear primarily geared toward a likelihood of confusion analysis; and in response, Petitioner argues that these requests are inapposite to its fraud claim and are equally irrelevant to its standing to bring this proceeding. Neither position is tenable.

Indeed, the petition to cancel alleges that "Petitioner will be damaged by the continued existence of United States Trademark Registration No. 3,101,151 and No. 3,101,150 because they will give color of rights to the Respondent and will continue to be an impediment to Petitioner's ability to use 'Westhaven' in regards to her business services and advertising." Petition to Cancel, ¶ 14. However, this does not implicate the likelihood of confusion analysis of *DuPont* as argued by Respondent, but instead the commercial interest and mere intermeddler standard found in *Herbko Int'l Inc. v. Kappa Books Inc.*<sup>2</sup> and *Jansen Enters. Inc. v. Rind.*<sup>3</sup> That is, Petitioner's allegation of standing relies on its commercial interest in the use of the mark WESTHAVEN, thus, without proof of such commercial interest the Board would not reach the merits of the fraud claim in this cancellation due to Petitioner's lack of standing.

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<sup>2</sup> 64 USPQ2d 1375 (Fed. Cir. 2002)

<sup>3</sup> 85 USPQ2d 1104, 1107 (TTAB 2007).

Inasmuch as standing remains an issue to be proven at trial, evidence regarding Petitioner's commercial interest in the WESTHAVEN mark, despite Petitioner's objections, is clearly a proper subject of discovery. Therefore, inquiries regarding Petitioner's use of the mark WESTHAVEN are appropriate given the circumstances presented.

Accordingly, Respondent's motion to compel is **GRANTED** with respect to Interrogatory No. 2 and Document Request Nos. 4 and 20-21.

*C. Petitioner's Target Customers; Interrogatory No. 7 and Document Request No. 31*

Again, it appears that Respondent's misinterpretation of the implications of Petitioner's pleaded standing has resulted in objectionable discovery requests. Respondent failed in its motion or during the conference to advance a reasonable explanation for the relevance of this category of questions with regard to Petitioner's claim of fraud. Indeed, and as Petitioner asserts, the single case cited in support of Respondent's argument is one involving a claim of likelihood of confusion.

Accordingly, Respondent's motion to compel is **DENIED** as to Interrogatory No. 7 and Document Request No. 31.

*D. Petitioner's Sales and Advertising; Interrogatory No. 8 and Document Request Nos. 14-19 and 34-35.*

Inasmuch as this information appears at least reasonably related to Petitioner's use of the WESTHAVEN mark, its relevance has been determined with respect to Petitioner's standing.

Accordingly, Respondent's motion to compel is **GRANTED** with respect to Interrogatory No. 8 and Document Request Nos. 14-19 and 34-35.

*E. Petitioner's Agreements Regarding the WESTHAVEN Mark; Interrogatory No. 15 and Document Request No. 24.*

These inquiries also implicate Petitioner's claim of use or interest in the WESTHAVEN mark. Accordingly, Respondent's motion to compel is **GRANTED** with respect to Interrogatory No. 15 and Document Request No. 24.

*F. Petitioner's Selection and Adoption of the WESTHAVEN mark; Interrogatory Nos. 1 and 4-5, and Document Request Nos. 2, 10, and 44.*

Petitioner does not allege ownership of the WESTHAVEN mark, and its pleading of standing does not constitute such a claim. Again, Respondent appears to confuse the pleading of a commercial interest for a claim of likelihood of confusion. The Board rejects this construction, and in the absence of a compelling argument regarding some ancillary relevance of the information sought, Respondent's motion to compel must be **DENIED** as to Interrogatory Nos. 1 and 4-5, and Document Request Nos. 2, 10, and 44.

*G. Signed Verification of Interrogatories*

The parties indicated during the conference that this issue has been resolved. Therefore, Respondent's motion to compel is rendered **MOOT** with respect to Petitioner's signed verification of its responses.<sup>4</sup>

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<sup>4</sup> Petitioner is reminded however, that she must also provide a signed verification of the supplemental responses served pursuant to this order.

- **Initial Disclosures**

Additionally, the parties indicated that Petitioner has served sufficient initial disclosures, and that this issue is no longer in dispute. Therefore, Respondent's motion to compel is rendered **MOOT** with respect to Petitioner's initial disclosures.

***Sufficiency of Admissions***

Respondent moves to have Requests for Admission Nos. 12, 13, 14, 17, 18, 19, 20, 21, 22, 23, 24, and 34 deemed admitted. However, Requests Nos. 12-14 and 17-20, appear to assume a likelihood of confusion claim in this proceeding (relatedness of services, similarity of marks, priority, etc.). However, as previously discussed, many inquiries aimed at a likelihood of confusion, absent further explanation, are wholly irrelevant to this proceeding involving only a claim of fraud.

Requests Nos. 21-24 on the contrary, inquire about the geographic significance of the term WESTHAVEN and its origin. This is squarely within the purview of this proceeding inasmuch as Petitioner's fraud claim is based upon alleged misinformation provided by Respondent to the USPTO regarding the geographic significance of the mark WESTHAVEN. Contrary to Petitioner's contention, it is incumbent upon Petitioner to have made a reasonable inquiry into this information before ever filing its petition to cancel; therefore, Petitioner should carefully consider the efficacy of maintaining its objections to responding to these requests.

Similarly, Request No. 34 is the proper subject of a request for admission to the extent that it is directed at Petitioner's use, and thus its commercial interest in the term WESTHAVEN, which as previously discussed implicates Petitioner's standing in this proceeding. Therefore, Petitioner's objection to responding to this request is **OVERRULED**.

Based on the foregoing, Respondent's motion to test the sufficiency of Petitioner's admissions is **GRANTED** in part and **DENIED** in part, to the extent that while the requests are not deemed admitted, Petitioner is allowed until the date set forth below to serve amended responses to Respondent's Request for Admission Nos. 21-24 and 34.

***Summary***

Accordingly, Respondent's motion to compel is **GRANTED in part**, and **DENIED in part**, to the extent that Petitioner is ordered, within **THIRTY DAYS** of the mailing date of this order, to serve upon Respondent supplemental verified responses to Respondent's Interrogatory Nos. 2, 8, and 15, Document Request Nos. 4, 14-21, 24, and 34-35,<sup>5</sup> and Requests for

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<sup>5</sup> Petitioner is reminded that its obligation to conduct a thorough search of its records and produce any responsive materials includes a search of electronically stored information. Electronically stored information may be produced in the form specified by the request. If no specification is made, Petitioner must produce the electronically stored information in the form in which it is ordinarily maintained, or in a reasonably usable form. *See* Fed. R. Civ. P. 34(b)(2)(E)(ii). Fed. R. Civ. P. 34(a) "requires that, if necessary, a responding party 'translate' information it produces into a 'reasonably usable' form." However, the option to produce in a reasonably usable form does not mean that a responding party is free to convert electronically stored information from the form in which it is maintained to a different form that makes it more difficult or burdensome for the requesting party to use the information efficiently in the litigation.

Admission Nos. 21-24 and 34, without objection on the merits.<sup>6</sup> *See, No Fear, Inc. v. Rule*, 54 USPQ2d 1551 (TTAB 2000). Further, Petitioner is ordered to copy and send all responsive documents to Respondent, at its own expense. *See Unicut Corp. v. Unicut, Inc.*, 220 USPQ 1013 (TTAB 1983); *No Fear*, 54 USPQ2d at 1556.

If, after a thorough search has been completed, no such documents are found to exist, then Petitioner must so state clearly. A proper written response to a document request requires the responding party to state whether responsive documents exist or not, and if so, that either they will be produced or will be withheld on a claim of privilege. *See No Fear*, 54 USPQ2d at 1556.

However, Petitioner is reminded that it may be barred from relying upon or later producing documents or information at trial, or to use any information or witnesses to supply evidence on a motion or at a hearing, where such documents, information, or witnesses were withheld from discovery.<sup>7</sup> *See Fed. R. Civ. P. 37(c)(1); Panda Travel, Inc. v. Resort Option*

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<sup>6</sup> Objections going to the merits of a discovery request include those which challenge the request as overly broad, unduly vague and ambiguous, burdensome and oppressive, as seeking non-discoverable information on expert witnesses, or as not calculated to lead to the discovery of admissible evidence. In contrast, claims that information sought by a discovery request is trade secret, business-sensitive or otherwise confidential, is subject to attorney-client or a like privilege, or comprises attorney work product, goes not to the merits of the request but to a characteristic or attribute of the responsive information. *See No Fear*, 54 USPQ2d at 1554.

<sup>7</sup> Respondent must raise this matter by objecting to the evidence in question during the trial period and preserving its objection in its brief on the case. *See Panda Travel, Inc.* 94 USPQ2d at 1792-93; *General Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1593-94 (TTAB 2011); TBMP § 527.01(e).

*Enters., Inc.*, 94 USPQ2d 1789, 1792 (TTAB 2009); *Quality Candy Shoppes/Buddy Squirrel of Wisconsin Inc. v. Grande Foods*, 90 USPQ2d 1389, 1392 (TTAB 2007); *Presto Prods. v. Nice-Pak Prods.*, 9 USPQ2d 1895, 1896 n.5 (TTAB 1988); TBMP § 527.01(e).

The parties are expected to move this case forward efficiently, and to cooperate with one another going forward to avoid unnecessary motions that tax the Board's limited resources.

***Schedule***

The proceeding is **RESUMED**. Remaining discovery, disclosure, and trial dates are reset as follows:

Discovery Closes	<b>2/10/2015</b>
Plaintiff's Pretrial Disclosures	<b>3/27/2015</b>
Plaintiff's 30-day Trial Period Ends	<b>5/11/2015</b>
Defendant's Pretrial Disclosures	<b>5/26/2015</b>
Defendant's 30-day Trial Period Ends	<b>7/10/2015</b>
Plaintiff's Rebuttal Disclosures	<b>7/25/2015</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>8/24/2015</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.

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However, if Petitioner fails to comply with this order, the remedy lies in a motion for sanctions, pursuant to Trademark Rule 2.120(g)(1). Should Respondent seek to file such a motion *it must first seek leave to file the motion by contacting the assigned Board interlocutory attorney*. Failure to obtain such leave may result in the motion being given no consideration. Furthermore, Petitioner is reminded that a party that has responded to a discovery request has a duty to supplement or correct that response. *See Fed. R. Civ. P. 26(e)*.

Cancellation No. 92058638

Briefs shall be filed in accordance with Trademarks Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.