

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

BUO

Mailed: June 1, 2015

Cancellation No. 92058638

Lisa Alyn

v.

Southern Land Company, LLC

Benjamin U. Okeke, Interlocutory Attorney:

Now before the Board are Petitioner's combined motions, filed February 6, 2015, to compel Respondent to "(i) provide for inspection documents identified in [Respondent's] responses to [Petitioner's] document requests; ... (ii) produce for deposition certain corporate employees and the appropriate corporate representatives pursuant to Rule 30(b)(6);" for "an extension of the discovery period for the limited purpose of allowing Petitioner time to review [Respondent's] documents made available for inspection and, if necessary, pursue follow-up discovery," with a corresponding rescheduling of the testimony dates; and Petitioner's motion, filed May 27, 2015, to suspend this proceeding pending determination of a civil action. 12 TTABVUE 2.

Additionally, on March 27, 2015, Respondent filed a motion for discovery sanctions, based upon Petitioner's failure to comply with the Board's February 4,

2015 order, directing Petitioner 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, and Requests for Admission Nos. 21-24 and 34, without objection on the merits.

The Board, in its discretion, suggested that the issues raised in the motions be resolved by telephone conference as permitted by TBMP § 502.06 (2014). The conference was held at 1:00 p.m. ET, on Friday, May 29, 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 arguments made in their submissions, the facts of the proceeding, and particularly the facts that occasioned the filing of the respective motions; therefore, those arguments and facts will only be recounted as necessary to explain the Board's decision. During the telephone conference, the Board made the following findings and determinations:

Petitioner's Motion to Compel

Prior to the taking of a discovery deposition on notice alone, the party seeking to take the deposition ("the deposing party") must give reasonable notice in writing to

every adverse party. Fed. R. Civ. P. 30(b)(1); Trademark Rules 2.124(b)(2) and 2.124(c).

- (1) ... A party who wants to depose a person by oral questions must give reasonable written notice to every other party. The notice must state the time and place of the deposition and, if known, the deponent's name and address. If the name is unknown, the notice must provide a general description sufficient to identify the person or the particular class or group to which the person belongs.

...

- (6) ... In its notice or subpoena, a party may name as the deponent a public or private corporation, a partnership, an association, a governmental agency, or other entity and must describe with reasonable particularity the matters for examination.

Fed. R. Civ. P. 30(b)(1) and (6).

In support of her motion to compel, Petitioner attached, *inter alia*, a string of email messages sent between Petitioner's counsel and Respondent's counsel. These email messages discuss possible dates and times to schedule an inspection of documents identified by Respondent in response to Petitioner's discovery requests and attempt to schedule the depositions of Respondent under Fed. R. Civ. P. 30(b)(6), Mary Lee Bennett, and Tim Downey. However, Petitioner did not provide a formal deposition notice. Nonetheless, "formal" notice is not required. However, inspecting the email messages, the messages cannot be construed as providing sufficient notice to treat them as properly noticing a Rule 30(b)(6) deposition, which must include: (i) the time and place of the deposition, (ii) the deponent's name and address, and (iii) *a description with reasonable particularity of the matters for*

examination. See Fed. R. Civ. P. 30(b)(6); *Red Wing Co. v. J.M. Smucker Co.*, 59 USPQ2d 1861, 1864 (TTAB 2001) (subject matter of deposition to be described with reasonable particularity in the notice).

Although the email messages contain the name of the parties to be deposed (albeit without providing the addresses of those parties), there is no specified date, merely an inquiry regarding “convenient dates/times.” 12 TTABVUE 31. Indeed, although Respondent replied providing possible dates for the deposition(s) to occur, this cannot reasonably be construed as a date certain, such as to properly notice the deposition, particularly in the absence of an email from Petitioner agreeing to those dates.

However, notwithstanding any contention that may be made regarding the date of the deposition, no such contention can be made regarding the absence of any information regarding the topics to be examined during the deposition(s). The chain of emails between the parties’ counsel is devoid of any mention of this information.

Accordingly, inasmuch as Petitioner failed to provide the information required by Fed. R. Civ. P. 30(b) for properly noticing a deposition, Petitioner’s motion to compel is **DENIED** with respect to the request to produce for deposition certain corporate employees and the appropriate corporate representatives on behalf of Respondent pursuant to Rule 30(b)(6).

However, the email messages do indicate that Respondent has not fulfilled its duty to make responsive documents reasonably available to Petitioner for inspection. Pursuant to Trademark Rule 2.120(e)(1), the signature of a party or

attorney constitutes a certification as to a discovery request, response or objection and disclosure as set forth in Fed. R. Civ. P. 26(g)(1). *See Miss Am. Pageant v. Petite Prods., Inc.*, 17 USPQ2d 1067, 1069 (TTAB 1990). Moreover, this signature also certifies that the party or lawyer has made a reasonable effort to assure that all available information and documents responsive to the discovery demand have been provided. *See Fed. R. Civ. P. 26 Advisory Committee's Notes (1983 Amendment Rule 26, Subdivision (g))*.

Unlike the deposition scheme described above, there is no burden of notice on Petitioner, and Petitioner need only propound the discovery seeking such information in order to trigger Respondent's duty to make responsive documents available should Respondent choose not to simply copy and forward the responsive documents to Petitioner, which could have been done at Petitioner's expense. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000).

While Respondent's contention that it has not "fail[ed] to permit inspection and copying of any document or thing," may be accurate, it appears that Respondent has been much less than cooperative or forthcoming in the production of responsive documents. This is in contravention of Respondent's duty to not only produce such materials or make them reasonably available for inspection, but also the continuing duty to cooperate in the conduct of discovery. *See Panda Travel Inc. v Resort Option Enters., Inc.*, 94 USPQ2d 1789, 1791 (TTAB 2009) ("Each party has a duty to make a good faith effort to satisfy the reasonable and appropriate discovery needs of its adversary.").

Accordingly, Petitioner's motion to compel is **GRANTED** with respect to Respondent's production of documents responsive to Petitioner's document requests. Consequently, Respondent is ordered, within **TWENTY DAYS** of the issuance of this order, to copy and forward such responsive documents as exist to Petitioner at Respondent's own expense. *See, No Fear*, 54 USPQ2d at 1554.

In the event Respondent fails to produce documents identified as responsive to Petitioner's discovery requests as ordered herein, Respondent may be subject to sanctions, potentially including entry of judgment against it. Trademark Rule 2.120(g); Fed. R. Civ. P. 37(b)(2).

Respondent's Motion for Sanctions

On February 4, 2015, the Board issued an order granting in part Respondent's motion to compel, to the extent that Petitioner was ordered, within thirty days of the mailing date of that order, to serve upon Respondent supplemental responses to Respondent's Interrogatory Nos. 2, 8, and 15, Document Request Nos. 4, 14-21, 24, and 34-35, and Requests for Admission Nos. 21-24 and 34, without objection on the merits. 11 TTABVUE 9-10.

On March 27, 2015, Respondent filed a motion for sanctions, citing Petitioner's failure to comply with the Board's prior order. Respondent seeks to preclude Petitioner 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.

As noted in the Board's April 3, 2015 suspension order, neither the filing of Petitioner's motion to compel nor the suspension of the proceeding would toll the time for Petitioner to make required discovery disclosures, or to respond to any outstanding discovery requests. Inasmuch as Petitioner failed to comply with the Board's prior order and did not oppose Respondent's motion, the motion is **GRANTED** as conceded.

Accordingly, as a sanction for Petitioner's failure to comply with the Board's discovery order issued February 4, 2015, Petitioner is prohibited from introducing at trial or relying upon any answers or documents not produced to Respondent in response to Interrogatory Nos. 2, 8, and 15, Document Request Nos. 4, 14-21, 24, and 34-35. Additionally, Requests for Admission Nos. 21-24 and 34 are deemed admitted.

Petitioner's Motion for Suspension for Civil Action

Consideration of Petitioner's motion, filed May 27, 2015, for suspension of this proceeding pending resolution of a civil action is deferred pending Petitioner's service of the complaint in that action on Respondent. It is noted, however, that any such suspension would nonetheless begin to run following the twenty day period within which Respondent has been directed to copy and serve responsive documents to Petitioner.

Schedule

The proceeding is resumed, and the remaining discovery, disclosure, and trial dates are reset as follows:

Discovery Closes	6/6/2015
Plaintiff's Pretrial Disclosures	7/21/2015
Plaintiff's 30-day Trial Period Ends	9/4/2015
Defendant's Pretrial Disclosures	9/19/2015
Defendant's 30-day Trial Period Ends	11/3/2015
Plaintiff's Rebuttal Disclosures	11/18/2015
Plaintiff's 15-day Rebuttal Period Ends	12/18/2015

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.