

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

Mailed: May 11, 2016

Cancellation No. 92059235

Nite Ize, Inc.

v.

Zhangwei Mo

Jennifer Krisp, Interlocutory Attorney:

The Board notes Petitioner's January 11, 2016 combined motion to compel and motion to extend discovery and trial dates. The Board exercises its discretion to consider the motion on the merits notwithstanding that Respondent did not file a brief in response. TBMP § 502.04 (2015) (Board may decline to treat an uncontested motion as conceded and may grant or deny motion on its merits).¹

Analysis

Trademark Rule 2.120(e)(1) requires as follows:

A motion to compel discovery shall include a copy of the request for designation or of the relevant portion of the discovery deposition; or a copy of the interrogatory with any answer or objection that was made; or a copy of the request for production, any proffer of production or

¹ In 41 TTABVue, the publicly-available copy of the motion filed pursuant to Trademark Rule 2.126(c), Petitioner included in its redaction material that clearly is not confidential. Petitioner's filings will stand as submitted. However, with respect to any future filings, the Board may order a party to submit a corrected filing in which only truly confidential material is redacted. TBMP § 412.04 n.4 (2015); Standard Protective Order § 12 (*Redaction; Filing Material With the Board*).

objection to production in response to the request, and a list and brief description of the documents or things that were not produced for inspection and copying. A motion to compel ... discovery must be supported by a written statement from the moving party that such party or the attorney therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion but the parties were unable to resolve their differences.

See also TBMP § 523.02 (2015).

Petitioner requests that the Board compel Respondent “to respond to various parts of” its first and second sets of requests for admission, interrogatories and requests for production of documents, arguing that “Respondent has provided incomplete responses that do not address material issues”² and that “[P]artial responses were provided by Respondent on November 12, 2015.”³ Petitioner did not include a copy of the written discovery requests and answers and objections thereto that are at issue. Petitioner included in its brief the text of Interrogatory No. 16 and Request for Production No. 6, and the answers and objections thereto, and asks that the Board compel Respondent “to answer the discovery requests completely, especially those highlighted above.”⁴ Petitioner does not limit its motion to only this interrogatory and this request. In addition, given Petitioner’s reference to “Respondent’s untimely response,”⁵ it is unclear whether Petitioner seeks

² 40 TTABVUE 2; 41 TTABVUE 1.

³ 40 TTABVUE 3; 41 TTABVUE 2.

⁴ 40 TABVUE 6; 41 TTABVUE 5.

⁵ 40 TTABVUE 3; 41 TTABVUE 2.

relief on the basis of insufficiency, untimeliness, or on both bases. Furthermore, the lacking record on the motion does not permit the Board to ascertain whether Petitioner's discovery requests are proportional to the needs of the case consistent with Fed. R. Civ. P. 26(b)(1), and whether Respondent's answers and objections (if any) to the interrogatories and requests for production are in compliance with Fed. R. Civ. P. 33(b) and 34(b). TBMP § 402.01, 412.06(b), 405.04(b) and 406.04 (2015).

In addition, Petitioner did not support its motion with a recitation of the communications conducted (*e.g.* dates and summaries of telephone conversations, copies of emails or letters exchanged, notes to the file, etc.) to demonstrate whether and to what extent it engaged in conference or correspondence with Respondent directed to resolving the issues brought to the Board for resolution. *Hot Tamale Mama...and More, LLC v. SF Investments, Inc.*, 110 USPQ2d 1080, 1081 (TTAB 2014). Petitioner asserts that it "made a good faith effort to work with Respondent and provide additional time for response,"⁶ but does not attest, or provide documentation to demonstrate, that it addressed with Respondent the substantive or timeliness deficiencies that it perceived in Respondent's responses. Thus, Petitioner did not comply with Rule 2.120(e)(1) and prevailing authorities that require a showing of a good faith effort to resolve the issues prior to filing a motion to compel.

⁶ 40 TTABVUE 3; 41 TTABVUE 2.

Turning to the motion insofar as Petitioner seeks an order compelling Respondent to respond to its first and second sets of requests for admissions, the motion is procedurally inappropriate. If a propounding party is dissatisfied with a responding party's answers or objections to requests for admission and wishes to obtain a ruling on the sufficiency thereof, the propounding party may file a motion to determine the sufficiency of the responses. Trademark Rule 2.120(h); Fed. R. Civ. P. 36(a); TBMP § 524.01 (2015). Petitioner did not file a motion to determine or test the sufficiency of the responses and objections (if any) that Respondent served.

Even if the Board were to construe Petitioner's motion as one to determine or test the sufficiency of responses to its requests for admissions, the motion is deficient for the same reasons as set forth above. Trademark Rule 2.120(h)(1) requires as follows:

The motion shall include a copy of the request for admission and any exhibits thereto and of the answer or objection. The motion must be supported by a written statement from the moving party that such party or the attorney therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion and has been unable to reach agreement.

Again, Petitioner did not include a copy of the requests for admissions, and responses and objections (if any) thereto. It merely argues that Respondent "has wrongfully denied requests for admissions,"⁷ and includes only Requests for Admission Nos. 16 and 17, along with Petitioner's own characterization

⁷ 40 TTABVUE 2; 41 TTABVUE 1.

that these requests “have been denied.”⁸ Consequently, the Board cannot determine the merits of the motion, including whether Petitioner’s requests are proportional to the needs of the case consistent with Fed. R. Civ. P. 26(b)(1), and whether the responses and objections (if any) are in compliance with Fed. R. Civ. P. 36(a). TBMP § 402.01, 412.06(b) and 407.03(b) (2015).

In addition, Petitioner failed to demonstrate that it made the required good faith effort to resolve the perceived insufficiency of the responses to requests for admissions. Trademark Rule 2.120(h)(1).

Summary and Ruling

In view of the findings of procedural and substantive deficiencies set forth above, Petitioner’s motion to compel is denied.⁹

In view of the denial on the merits of Petitioner’s motion to compel, its request for a sixty-day extension of discovery under Fed. R. Civ. P. 6(b), to review Respondent’s responses and pursue follow-up discovery, is denied. To maintain order in this proceeding, the request to reset trial dates is granted.

To that end, proceedings are resumed and dates are reset as follows:

Discovery Closes	5/13/2016
Plaintiff’s Pretrial Disclosures Due	6/27/2016
Plaintiff’s 30-day Trial Period Ends	8/11/2016
Defendant’s Pretrial Disclosures Due	8/26/2016
Defendant’s 30-day Trial Period Ends	10/10/2016
Plaintiff’s Rebuttal Disclosures Due	10/25/2016

⁸ 40 TTABVUE 5; 41 TTABVUE 4.

⁹ To be clear, a finding of either type of deficiency in the motion may form the basis for denying the motion. For example, the lack of good faith effort to resolve the discovery issues prior to filing the motion is, alone, a basis for denial. *Cf. Emilio Pucci Int’l BV v Sachdev*, 118 USPQ2d 1383, 1386 (TTAB 2016) (lack of good faith effort, alone, is sufficient to deny motion for protective order).

Plaintiff's 15-day Rebuttal Period Ends

11/24/2016

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.