

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: October 27, 2015

Opposition No. 91218280 (**Parent Case**)
Cancellation No. 92060249

Mya Saray, LLC

v.

Ibrahim Dabes dba Dabes Egyptian Imports

**George C. Pologeorgis,
Interlocutory Attorney:**

Consolidation

It has come to the Board's attention that the above-captioned proceedings involve common questions of law and fact and the parties are the same. When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases. *See* Fed. R. Civ. P. 42(a); *see also, Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991) and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991).

Accordingly, the Board, *sua sponte*, orders the consolidation of the above-captioned proceedings.

In view thereof, Opposition No. 91218280 and Cancellation No. 92060249 are hereby consolidated.

The consolidated cases may be presented on the same record and briefs. *See Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989)

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and *Hilson Research Inc. v. Society for Human Resource Management*, 26 USPQ2d 1423 (TTAB 1993).

The Board file for these consolidated cases will be maintained in Opposition No. 91218280 as the "parent" case. As a general rule, from this point on only a single copy of any paper or motion should be filed in the parent case of the consolidated proceedings, but that copy should bear both opposition proceeding numbers in its caption. The only exception is that the answer to each notice of opposition must be filed in the respective corresponding proceeding.

The parties are further advised that despite being consolidated, each proceeding retains its separate character. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings and a copy of the final decision shall be placed in each proceeding file.¹

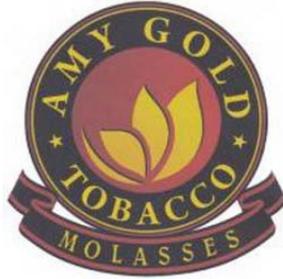
Opposition No. 91218280

Ibrahim Dabes dba Dabes Egyptian Imports ("Applicant") seeks to register the mark AMY GOLD TOBACCO MOLASSES and design, as displayed below, for "tobacco; smoking articles, namely, cigarettes, cigars, smoking pipes, and shishas" in International Class 34.²

¹ The parties should promptly inform the Board in writing of any other related *inter partes* proceedings. See Fed. R. Civ. P. 42(a).

² Application Serial No. 86023182, filed on July 31, 2013, based on a *bona fide* intention to use the mark in commerce under Section 44(e) of the Trademark Act. The terms "TOBACCO" and "MOLASSES" are disclaimed. Applicant's application is based on German Registration No. 302012000345 registered on July 23, 2012.

On January 20, 2015, Applicant filed a motion to amend the identification of goods from the current identification to "tobacco." The Board construed the motion as unconsented and deferred consideration of the motion until final decision or until the case is decided upon summary judgment. See Board order dated May 19, 2015 at 11 TTABUVE.



On September 10, 2014, Mya Saray, LLC (“Opposer”) filed a notice of opposition opposing registration of Applicant’s involved mark on the ground of likelihood of confusion under Section 2(d) of the Trademark Act. In support of its asserted claim, Opposer has pleaded ownership of the registered marks below used in association with various tobacco products including hookahs and water pipes for smoking:

1. MYA;

2.  ;

3. ECONO-MYA;

4. *Econo-MYA*; and

5. 

Opposer’s Motion to Compel in Opposition No. 91218280

This case now comes before the Board for consideration of Opposer’s motion (filed May 28, 2015) to compel written discovery filed in Opposition No. 91218280. The motion is fully briefed.

For purposes of this order, we presume the parties' familiarity with the pleadings, the history of the proceeding and the arguments and evidence submitted with respect to Opposer's motion.

Initially, the Board finds that Opposer has made a good faith effort to resolve the parties' discovery dispute prior to seeking Board intervention and that Opposer's motion is timely. *See* Trademark Rule 2.120(e)(1).

The Board further notes that, in its initial motion papers, Opposer identifies certain discovery requests which are in dispute. In response to Opposer's motion, Applicant maintains that most of Opposer's concerns have been addressed through supplemental responses provided to Opposer concurrently with its response to Opposer's motion, and that the only discovery requests that remain in dispute concern: (1) alternative brand designations, (2) the design differences between Opposer's hookah and Applicant's hookahs, and (3) physical specimens of Applicant's hookahs. In its reply brief, Opposer does not contest that Applicant's supplementation addresses most of its concerns and that the only issues remaining are those identified by Applicant in its response to Opposer's motion to compel. In view of the foregoing and because Opposer failed to identify with specificity which discovery requests remain at issue,³ the Board will entertain Opposer's motion with regard to the discovery requests specifically identified below.

³ In the event that issues raised in a motion to compel are subsequently resolved by the parties, the moving party should inform the Board in writing, filed through ESTTA, of the issues in the motion which no longer require determination. Trademark Rule 2.120(e); TBMP § 523.02 (2015). As noted above, Opposer failed to do so.

Interrogatory Requests

Interrogatory No. 3

If the Defendant utilizes alternative brand designations in connection with Defendant Products, identify such alternative brand designations by its literal elements (e.g. words) and design elements (e.g., illustrated components).

Interrogatory No. 4

Explain other inspiration and meaning of the alternative brand designations responsive to Interrogatory No. 3 how the Products for such other alternative brand designations related to Defendant Products sold under the AMY brand with specific referent to Defendant Product quality, Defendant product quantity (generally at this time), Defendant Product manufacturing source, the characteristics of prospective purchases of the Defendant Products, and other significant criteria.

Motion is **DENIED** with regard to Interrogatory Nos. 3 and 4 since the only mark at issue in this proceeding is Applicant's involved AMY GOLD TOBACCO MOLASSES and design mark. The Board notes that a party need not provide discovery with respect to those of its marks and goods and/or services that are not involved in the proceeding and have no relevance thereto. See TBMP § 414(11) (2015).

Opposer maintains that the above requests are relevant to the issue of Applicant's intent to counterfeit Opposer's goods. The Board notes, however, that Opposer has not asserted claims of unfair competition or trade dress infringement or that Applicant's goods constitute counterfeit goods nor does the Board have jurisdiction to entertain such claims. *See Board of Trustees of University of Alabama v. Pitts*, 107 USPQ2d 2001, 2022 (TTAB 2013) (no jurisdiction to consider questions of infringement or unfair competition); *see also The E.E. Dickinson Co. v. The T.N. Dickenson Company*, 221 USPQ 713, 714 (TTAB 1984) ("...trade dress infringement

and unfair competition are matters which are not within the Board's jurisdiction.”).

The only issue before the Board is whether Applicant's AMY GOLD TOBACCO MOLASSES and design mark, when used in connection with the goods identified in Applicant's subject application, is likely to cause confusion with Opposer's pleaded MYA marks. Accordingly, the Board finds that Opposer has failed to demonstrate the relevance of the information sought in Interrogatory Nos. 3 and 4 to the issues in this proceeding.

Interrogatory No. 14

Identify the individual most knowledgeable about the appearance and aesthetic properties of each hookah identified of Interrogatory No. 8.

Interrogatory No. 33

Describe each product design difference perceptible to Defendant between the Subject Hookah labeled as AMY-018 and the Econo-MYA QT depicted in Exhibit 4.

Interrogatory No. 34

Describe each product design difference perceptible to Defendant between the Subject Hookah labeled as Jinn and the MYA QT depicted in Exhibit 5.

Motion is **DENIED** with regard to Interrogatory Nos. 14, 33 and 34 inasmuch as the appearance of a party's goods is not relevant to the question of likelihood of confusion in an *inter partes* proceeding before the Board. *See Gen. Foods Corp. v. Costa Ice Cream Company*, 165 USPQ 797 (TTAB 1970); *Crawford Fitting Co. v. C.B. Crawford Company*, 135 USPQ 381 (TTAB 1962).

Document Requests

Document Request No. 9

A physical sample of each Subject Hookah.

Motion is **GRANTED** solely to the extent that Applicant must produce a physical sample of the hookahs it intends to sell in the United States, if any currently exist, or currently sells in the United States under its involved AMY GOLD TOBACCO MOLASSES and design mark.

Document Request No. 14

All documents and things that refer or relate to the creation, design, and appearance of the Subject Hookahs, including the creation design and appearance alternatives.

Motion is **DENIED** to the above document request because, as noted above, the appearance of a party's goods is not relevant to the question of likelihood of confusion in an *inter partes* proceeding before the Board. *See Gen. Foods Corp. v. Costa Ice Cream Company*, 165 USPQ 797 (TTAB 1970); *Crawford Fitting Co. v. C.B. Crawford Company*, 135 USPQ 381 (TTAB 1962).

Document Request No. 15

All documents and things that refer or relate to the creation, design, and appearance of the AMY logo, including the creation design and appearance of alternatives.

Motion is **GRANTED** to the extent that Applicant must produce non-privileged documents which refer or relate to the creation, design, and appearance of Applicant's involved mark and design, i.e., AMY GOLD TOBACCO MOLASSES and

design. Motion is **DENIED** to the extent that it seeks documents regarding creation design and appearance of alternative logos or marks not at issue in this proceeding.

Document Request No. 16

All documents and things that refer or relate to the creation, design, and appearance of the AMY brand, including the creation, design, and appearance alternatives.

Motion is **DENIED** to the above identified document request. The only mark at issue in this proceeding is Applicant's involved AMY GOLD TOBACCO MOLASSES and design and such information is addressed in Document Request No. 15.

Document Request No. 17

All documents and things relating or referring to design differences between the Subject Hookahs and any Plaintiff hookah.

Motion is **DENIED** with regard to the above-identified document request. As noted above, the appearance of a party's goods is not relevant to the question of likelihood of confusion in an *inter partes* proceeding before the Board.

Summary

As restricted by this order, Opposer's motion to compel is **DENIED** with regard to Interrogatory Nos. 3, 4, 14, 33, and 34 and Document Request Nos. 14, 15 (in part), 16, and 17.⁴ Opposer's motion to compel is **GRANTED** with regard to Document Request No. 9 and with regard to Document Request 15, in part, as set forth below.

⁴ Additionally, for the reasons explained herein, Applicant is not required to respond to any of Opposer's written discovery already propounded in Opposition No. 91218280 that are not specifically identified by this order and which seek information or documents that concern (1) use of Applicant's marks other than Applicants involved AMY GOLD TOBACCO MOLASSES and design mark, (2) the design of Applicant's hookahs, or (3) the differences between the design of Opposer's hookahs

Applicant is also allowed until **thirty (30) days** from the mailing date of this order to copy and to produce non-privileged documents responsive to Opposer's Document Request Nos. **9 and 15**, to the extent set forth by this order.⁵ Applicant must organize and label, by bates stamp number, the documents responsive to each of the above-identified document requests.

If there are no responsive, non-privileged documents in Applicant's possession, custody or control which are responsive to any of the above-identified document requests, Applicant must so state affirmatively in its response to the corresponding document request.

To the extent Applicant has already **fully** produced documents responsive to Document Request Nos. 9 and 15, Applicant must so state in its response to the particular document request and **identify, by bates number, the documents which are responsive to each request.**

Additionally, Applicant is required to provide Opposer a privilege log within the same **thirty (30) days** provided above to the extent that Applicant claims privilege to **any** of Opposer's written discovery requests, if it has not already done so.⁶

In the event Applicant fails to provide Opposer with full and complete responses to the outstanding discovery, as required by this order, Applicant will be barred

⁵ To the extent the production of documents to any of the document requests identified above is voluminous in nature, Applicant may produce a representative sampling of documents responsive to the corresponding document request. Such representative sampling, however, must be sufficient to meet Opposer's discovery needs.

⁶ The Board expects the parties (and their attorneys) to cooperate with one another in the discovery process and looks with extreme disfavor on those who do not. TBMP § 408 (2015). Each party and its attorney have a duty to make a good faith effort to satisfy the discovery needs of its adversary. *Id.*

from relying upon or later producing documents or facts at trial withheld from such discovery.⁷ *See* Fed. R. Civ. P. 37(c)(1).

Trial Schedule For Consolidated Proceedings

Proceedings in Opposition No. 91218280 are resumed and will proceed as a consolidated case with Cancellation No. 92060249 upon the trial schedule set forth below.

Expert Disclosures Due	2/27/2016
Discovery Closes	3/28/2016
Plaintiff's Pretrial Disclosures	5/12/2016
Plaintiff's 30-day Trial Period Ends	6/26/2016
Defendant's Pretrial Disclosures	7/11/2016
Defendant's 30-day Trial Period Ends	8/25/2016
Plaintiff's Rebuttal Disclosures	9/9/2016
Plaintiff's 15-day Rebuttal Period Ends	10/9/2016

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

⁷ If Applicant fails to comply with this order, Opposer's remedy lies in a motion for sanctions, pursuant to Trademark Rule 2.120(g)(1). Furthermore, the parties are 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).