

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

BUO

Mailed: February 4, 2016

Cancellation No. 92061571

Gestion Diane Lanctot Ltee

v.

Ivo N Njabe

Benjamin U. Okeke, Interlocutory Attorney:

Now before the Board are: (1) Respondent's motion, filed January 11, 2016, to compel Petitioner's responses to his discovery requests;¹ (2) Petitioner's motion, filed February 1, 2016, for an extension of the discovery period without consent; and (3) Respondent's motion, filed February 1, 2016, for discovery sanctions.

The Board, in its discretion, suggested that the issues raised in the motions be resolved by telephone conference as permitted by TBMP § 502.06 (2015).² The conference was held on Wednesday, February 3, 2016. Participating in the

¹ Respondent's motion does not evidence service of the paper on Petitioner. Respondent is cautioned that every paper filed in this proceeding must also be served on Petitioner pursuant to Trademark Rule 2.119. Any future submissions that do not include a certificate of service may not be considered.

² Patent and Trademark Rule 1.2, 37 C.F.R. § 1.2, which requires all business with the USPTO be transacted in writing, is waived to the extent that Board attorneys or judges may accept from parties, or direct parties to present, oral recitations of procedural facts and presentations of argument.

conference were Petitioner's counsel, Peter D. Siddoway, Respondent, Ivo N. Njabe, appearing *pro se*,³ and Board interlocutory attorney, Benjamin U. Okeke.

The Board carefully considered the comments made by the parties during the telephone conference, as well as the briefs on the motions, 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:

Respondent's Motion to Compel

Respondent's "motion to compel" is **DENIED**, inasmuch as it did not actually contain a motion, or a statement that amounted to a request for relief from any particular deficiencies in Petitioner's discovery responses. Instead, Respondent merely submitted a copy of his discovery requests propounded on Petitioner, without any supporting argument or request for relief.⁴

³ Respondent is encouraged to seek legal counsel, and to review the "Pro Se Information" section at the end of this order.

⁴ Respondent is again reminded that discovery requests, as well as discovery responses, materials obtained through the discovery process, and the parties' initial disclosures should not be filed with the Board except when submitted: (1) with a motion relating to discovery (e.g., motion to compel, motion to determine the sufficiency of an answer or objection to a request for admission, motion for leave to serve additional interrogatories, motion to challenge the sufficiency of initial or expert disclosures); (2) in support of or in response to a motion for summary judgment; (3) under a notice of reliance during a party's testimony period, to the extent that the discovery response or disclosure may properly be submitted by notice of reliance; or (4) as exhibits to a testimony deposition.

The “motion” would have nonetheless been denied for Respondent’s failure to assert that he made a good faith effort to resolve his discovery issues with Petitioner prior to seeking Board intervention. When parties disagree about discovery matters, the parties must adhere to the strictures set forth in *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986), and repeated below:

[W]here the parties disagree as to the propriety of certain requests for discovery, they are under an obligation to get together and attempt in good faith to resolve their differences and to present to the Board for resolution only those remaining requests for discovery, if any, upon which they have been unable, despite their best efforts, to reach an agreement. Inasmuch as the Board has neither the time nor the personnel to handle motions to compel involving substantial numbers of requests for discovery which require tedious examination, it is generally the policy of the Board to intervene in disputes concerning discovery, by determining motions to compel, only where it is clear that the parties have in fact followed the aforesaid process and have narrowed the amount of disputed requests for discovery, if any, down to a reasonable number.

The record does not reflect that Respondent made his “best efforts” to resolve the instant discovery dispute. The parties are encouraged to openly communicate regarding their outstanding discovery and makes efforts to satisfy the discovery needs of each party.

A. Discovery

The purpose of discovery is to advance the case by requiring parties to share certain relevant information upon request, so that the issues for trial may be focused and the case may proceed in an orderly manner within reasonable time constraints. A cancellation proceeding before the Board is similar in many ways to a

civil action in a Federal district court. There are pleadings (petition to cancel, answers, and, sometimes, a counterclaim), a wide range of possible motions; discovery (a party's use of discovery depositions, interrogatories, requests for production of documents and things, and requests for admission to ascertain the facts underlying its adversary's case), a trial, and briefs, followed by a decision on the case.

Unlike the case in a civil proceeding, the Board does not preside at the taking of testimony. Rather, all testimony is taken by deposition during the assigned testimony, or trial, periods, and the written transcripts, together with any exhibits, are then filed with the Board. No paper, document, or exhibit will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules. *See* TBMP § 703.

- Interrogatories

Ordinarily, a party on which interrogatories have been served should respond to them by stating, with respect to each interrogatory, either an answer or an objection. If an interrogatory is answered, the answer must be made separately and fully, in writing under oath. If an interrogatory is objected to, the reasons for objection must be stated in lieu of an answer. Fed. R. Civ. P. 33(b)(3), (b)(4); TBMP § 405.04(b). Objections based on confidentiality are expected to be extremely limited because the Board's standard protective order is automatically instituted for all Board *inter partes* proceedings. *See* Trademark Rule 2.116(g).

The Board prefers that the responding party reproduce each interrogatory immediately preceding the answer or objection thereto.

The duty to supplement disclosures and discovery responses in proceedings before the Board is governed by Fed. R. Civ. P. 26(e)(1) and (2). *See* Trademark Rule 2.116(a). Under that rule, a party that has made an initial or expert disclosure or has responded to a request for discovery with a response is under a duty to supplement or correct the response in a timely manner to include information under the particular circumstances specified in paragraphs (e)(1) and (2). *See Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1326-27 (TTAB 2011) (opposer was under a duty to supplement its discovery responses and disclosing for the first time in its pretrial and amended pretrial disclosures the identities of twenty-seven witnesses resulted in surprise to applicant). In addition, as in the present case, a duty to supplement disclosures or responses may be imposed by order of the Board. *See Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d 1175, 1179 (TTAB 2010).

- Document Requests

A party served with a request for documents has a duty to thoroughly search its records for all information properly sought in the request, and to provide such information to the requesting party within the time allowed for responding to the request. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551 (TTAB 2000). 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; or the party may raise an appropriate objection. *Id.* at 1556.

The place of production is governed by Trademark Rule 2.120(d)(2). *See Elec. Indus. Ass'n v. Potega*, 50 USPQ2d 1775, 1777 (TTAB 1998). A party is only obliged to make documents and materials available for inspection and copying, where the documents are stored, and as they are kept in the ordinary course of business, unless otherwise ordered by the Board as herein, *No Fear Inc.*, 54 USPQ2d at 1555, or as organized and labeled to correspond to the requests. Fed. R. Civ. P. 34(b)(2)(E)(i). However, 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. *See No Fear Inc.*, 54 USPQ2d at 1555. Indeed, the Board believes this is more efficient and thus encourages this method of producing documents. *Id.*

Motion to Extend Discovery Period

It is noted initially that Petitioner indicated that it had contacted Respondent to secure Respondent's consent to the extension of dates, but that Respondent's consent was withheld. Petitioner asserts that additional time is required to allow the parties to complete the exchange of their respective discovery responses. 8 TTABVUE 2-3.

Because Petitioner filed its motion to extend prior to the close of the discovery period, Petitioner need only establish "good cause" for the requested extension. Fed. R. Civ. P. 6(b)(1)(A); TBMP § 509.01 (2015). Generally, "the Board is liberal in

granting extensions of time before the period to act has elapsed, so long as the moving party has not been guilty of negligence or bad faith and the privilege of extensions is not abused.” *Am. Vitamin Prods. Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992).

The record does not indicate, and Respondent does not argue that Petitioner has previously abused the privilege of extensions for this purpose,⁵ acted in bad faith or negligently, or that the motion is being brought for purposes of delay. Instead, it appears that Respondent created a deadline for responses that fell short of the time allowed to respond to discovery requests set by Trademark Rule 2.120(a)(3) and Fed. R. Civ. P. 33(b)(2). Respondent’s limiting of Petitioner’s time to respond to its discovery requests to a time less than 30 days is inappropriate and not supported by law.

Inasmuch as the purpose of discovery is the fair and complete exchange of information, and in light of the Board’s preference to decide its cases on the merits, and where practicable to produce a full and complete record for consideration, the Board is inclined to favor the open exchange of information. Accordingly, Petitioner’s motion for a sixty-day extension of the discovery period is **GRANTED in part**, to the extent that the discovery period is extended until March 20, 2016.

Petitioner (and Respondent) should promptly serve responses to any outstanding discovery requests. The parties are encouraged to resolve any discovery disputes before the reset date for the closure of discovery.

⁵ Indeed, the record reflects that this is the first extension request filed Petitioner, and in fact by either party in this proceeding.

Motion for Sanctions

Respondent's motion for sanctions has been prematurely filed, and has therefore been given no consideration.

Schedule

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

Discovery Closes	3/20/2016
Plaintiff's Pretrial Disclosures	5/4/2016
Plaintiff's 30-day Trial Period Ends	6/18/2016
Defendant's Pretrial Disclosures	7/3/2016
Defendant's 30-day Trial Period Ends	8/17/2016
Plaintiff's Rebuttal Disclosures	9/1/2016
Plaintiff's 15-day Rebuttal Period Ends	10/1/2016

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

Pro Se Information

A. Representation

The Board notes that Respondent currently represents himself *pro se*, *i.e.* without assistance from a licensed attorney. It should be noted that, while Patent and Trademark Rule 11.14 permits any party to represent himself, it is advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in an opposition proceeding to secure the services of an

attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney. In addition, as the impartial decision maker, the Board may not provide legal advice, though it may provide general procedural information.

B. Electronic Resources

All parties may refer to the Trademark Trial and Appeal Board Manual of Procedure (“TBMP”), the Trademark Act, and the Trademark Rules of Practice, all available on the USPTO website, www.uspto.gov. The TTAB homepage provides electronic access to the Board’s standard protective order, and answers to frequently asked questions. Other useful resources include the ESTTA filing system⁶ for Board filings and TTABVUE for status and prosecution history.

Compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, is expected of all parties before the Board, whether or not they are represented by counsel.

C. Service of Papers

Trademark Rule 2.119(a) and (b) require that every paper filed in the Patent and Trademark Office in a proceeding before the Board must be served upon the

⁶ Use of electronic filing with ESTTA — as the parties have done so far — is strongly encouraged. This electronic file system operates in real time and provides filers with confirmation that the filing has been received. When papers are filed through ESTTA the papers must still be served on the other party to the proceeding.

If the parties have questions about or need assistance with ESTTA, they may call the Board at (571) 272-8500 or (800) 786-9199 (toll free) from 8:30 a.m. until 5:00 p.m. (EST).

While electronic filing is preferred, papers may also be filed by mail. The parties should refer to TBMP §§ 107-111 for information on filing by mail. If ESTTA filing is not possible for any reason, the filer should submit its papers by mail, with a certificate of mailing. *See* TBMP § 110 et. seq.

attorney for the other party, or the other party itself, if unrepresented, and proof of such service must be made before the paper will be considered by the Board. Consequently, copies of all papers which Respondent may file in this proceeding must be accompanied by a signed statement indicating the date and manner in which such service was made. The statement, whether attached to or appearing on the paper when filed, will be accepted as *prima facie* proof of service.

The following is an example of an acceptable Certificate of Service:

Certificate of Service

The undersigned certifies that a copy of the attached <describe filing> was served, by first-class mail, upon Petitioner at the following address:

Peter D. Siddoway
Myers Bigel Sibley & Sajovec PA
4140 Parklake Avenue, Suite 600
Raleigh, NC 27612

on <insert date>.

/Ivo N. Njabe/