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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: August 31, 2016

Cancellation No. 92062923

Topiclear, Inc.

v.

K & N Distributors

Ann Linnehan, Interlocutory Attorney

This case now comes up for consideration of Petitioner's motion (filed June 22, 2016) to compel discovery. The motion is fully briefed and the Board has considered these briefs.¹

In its motion, Petitioner asks that the Board compel Respondent to submit full and proper responses to its Interrogatory Nos. 7-8, 12-13, 15-19 which were served on March 21, 2016. Petitioner states that although answers to some of the interrogatories were provided, the response was not submitted under oath as required by Fed. R. Civ. P. 33(b)(3); that for Interrogatory Nos. 7-8, 12-13, 15-19

¹ Petitioner alleges that Respondent's brief in opposition to the motion is untimely because it was not filed within 15 days of service of the motion. The Board observes that it is timely. A brief in response to a motion must be filed within 15 days from the date of service of the motion, but within 20 days if service of the motion was made by first class mail, Priority Mail Express, or overnight courier. See Trademark Rule 2.119(c). The certificate of service for Petitioner's motion indicates that Petitioner served its motion by first class mail. Trademark Rule 2.119(c), therefore, allows for a 20 day response time. Although the certificate of service for Petitioner's motion also states that the motion was served by email, there is no indication that an agreement between the parties was made concerning electronic transmission of papers. See Trademark Rule 2.119(b)(6).

Respondent provided a boilerplate response indicating that it was working to find responsive information and would supplement its response as a reasonable time prior to trial; and that Respondent's "evasion of providing prompt answers as required by law is an unreasonable attempt to prevent the Petitioner to obtain [sic] basic information...." Petitioner seeks an order requiring Respondent to respond to these discovery requests without objection.

In its response, Respondent concedes the issue of priority of use to Petitioner; states that it served supplemental responses to Interrogatory Nos. 7-8, 12-13, 15-19 on July 12, 2016; and argues that "Given the supplemental responses in conjunction with the stipulation provided it is submitted that Registrant has now sufficiently answered Petitioner's interrogatories."

In reply, Petitioner argues that the original and supplemental responses were improperly signed by counsel and not an officer of Respondent or other knowledgeable party under oath as required by Fed. R. Civ. P. 33(b)(3). Petitioner also argues that the questions contained in Interrogatory Nos. 7-8, 12-13, 15-19 "clearly are within the permissible scope as defined by the law" and the "mere fact that Registrant...now concedes priority to Petitioner, does not exclude the requirement to respond to these inquiries."

As a preliminary matter, the Board finds that Petitioner has shown that it made a good faith effort, pursuant to Trademark Rule 2.120(e)(1), to resolve with Respondent the issues presented in the motion prior to seeking the Board's intervention.

The Board has carefully reviewed Respondent's original and supplemental responses to Petitioner's interrogatories. With regard to Petitioner's assertion that the Respondent failed to submit its responses to Petitioner's interrogatories under oath as required by Fed. R. Civ. P. 33(b)(3), the Board observes that the copy of the original responses submitted with Petitioner's motion fails to include the signature page of Respondent's responses. The Board, however, does observe that Respondent's supplemental responses served on July 12, 2016 do not include an indication that the such answers were made under oath as required by the federal rule and TBMP 405.04(b). Respondent is allowed time by this order to submit answers which comply with Fed. R. Civ. 33(b)(3).²

With regard to Interrogatory Nos. 7-8, 12-13, 15-19, the Board has carefully reviewed the supplemental answers to these requests and finds that Respondent's supplemental answers to Interrogatory No. 8, 12, 17 are sufficient. Respondent need not respond further.

With regard to Interrogatory No. 7 and 13, the Board finds that Respondent's supplemental answers are insufficient. Such questions seek to obtain discoverable information. See TBMP Section 414(4-5). With regard to Interrogatory No. 15-16, the Board finds that Respondent's supplemental answers are also insufficient. Respondent must respond fully and completely to the extent that the locations of those places of business where a party manufactures its involved goods, or conducts its involved services, under its mark, are discoverable. See TBMP Section 414(15).

² Interrogatories may be answered by an attorney even though he has no personal knowledge of the facts stated in the answers. TBMP Section 405.04(c).

With regard to the Interrogatory Nos. 18-19, the Board assumes the entities cited in these interrogatories are third-parties. Information concerning a party's awareness of third-party use and/or registration of the same or similar marks for the same or closely related goods or services as an involved mark is discoverable. Respondent must answer these interrogatories in full. The fact that Respondent concedes priority does not excuse Respondent from now answering these interrogatories in full.

In view thereof, Petitioner's motion to compel is granted as to Interrogatory Nos. 7, 13, 15-16, and 18-19, but denied as to Interrogatory Nos. 8, 12, and 17.

Respondent is allowed until **thirty days** from the mailing date of this order to serve upon Petitioner supplemental and complete responses to Interrogatory Nos. 7, 13, 15-16, and 18-19 as specifically indicated above as well as a signed copy of all answers in writing under oath.

If Respondent fails to comply with this order, Petitioner's remedy lies in a motion for discovery sanctions, pursuant to Trademark Rule 2.120(g)(1).

Respondent is reminded that it has a duty to make a good faith effort to satisfy Petitioner's discovery needs. See Fed. R. Civ. P. 26. Respondent is further reminded that a party which has responded to a discovery request has a duty to supplement or correct that response as new information becomes available. See Fed. R. Civ. P. 26. Respondent is reminded in addition that, when a party, without substantial justification, fails to disclose information required, or fails to amend or

supplement a prior response, as required, that party may be prohibited from using as evidence the information not so disclosed. See Fed. R. Civ. P. 37(c)(1).

Proceedings herein are resumed and dates are reset as follows:

Expert Disclosures Due	11/12/2016
Discovery Closes	12/12/2016
Plaintiff's Pretrial Disclosures Due	1/26/2017
Plaintiff's 30-day Trial Period Ends	3/12/2017
Defendant's Pretrial Disclosures Due	3/27/2017
Defendant's 30-day Trial Period Ends	5/11/2017
Plaintiff's Rebuttal Disclosures Due	5/26/2017
Plaintiff's 15-day Rebuttal Period Ends	6/25/2017

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 of 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.