UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Baxley

Mailed: May 2, 2003

Opposition No. 91/121,151

AMERICAN HONDA MOTOR CO., INC.

v.

TBC CORPORATION

Andrew P. Baxley, Interlocutory Attorney:[1]

This case now comes up for consideration of opposer's motion (filed January 16, 2003) to compel discovery. Applicant has filed a brief in opposition thereto.[2]

In support of its motion, opposer contends that it served its first request for production on January 18, 2001; that applicant served responses thereto on October 9, 2001 and, in those responses, agreed to produce responsive documents; that applicant has subsequently refused to arrange a mutually convenient time to produce documents and things in response to its first request for production. Accordingly, opposer asks that applicant be compelled to

[1] Cindy B. Greenbaum, the interlocutory attorney assigned to this case, is away from the Board for an extended period on a detail.

[2] Although opposer filed a reply brief, the Board in its discretion has elected not to consider it. See Trademark Rule 2.127(a).

produce such documents and things so that it can determine whether follow-up discovery and depositions are necessary.

In response, applicant contends that opposer's motion is intended solely to delay the commencement of trial herein; that it properly objected under Fed. R. Civ. P. 34(b) to opposer's first request for production because that request called for production of the requested documents and things to be made at the offices of opposer's counsel; that equity demands that opposer's motion to compel be denied because the commencement of trial had earlier been delayed by opposer's failure to respond to applicant's discovery requests and applicant's filing of a motion to compel;[3] that, while applicant filed a motion to compel on January 14, 2002, the Board did not suspend proceedings herein pending disposition of that motion until January 17, 2002, i.e., two days after opposer's testimony period had commenced; that opposer's motion is untimely inasmuch as opposer's testimony period had commenced; and that, inasmuch as opposer's request for production was served two years prior to the filing of the motion to compel and thus was not filed within a reasonable time after its failure to respond to the discovery requests at issue, opposer's motion to compel is untimely. Accordingly, applicant asks that the motion to compel be denied.

[3] Such motion was granted on March 11, 2002.

The Board finds initially that opposer made a good faith effort to resolve the parties' discovery dispute prior to filing its motion to compel. See Trademark Rule 2.120(e)(1).

With regard to applicant's contention that opposer's motion to compel is untimely, under the 1998 amendment to Trademark Rule 2.120(e)(1), a motion to compel is timely filed so long as it is filed prior to the commencement of plaintiff's testimony period.[4] Once plaintiff's testimony period commences, however, any motion to compel filed thereafter is untimely, even if it is filed prior to the opening of a rescheduled testimony period-in-chief for plaintiff. Cf. Trademark Rule 2.127(e)(1); TBMP Section 528.02.

Under these circumstances, the Board deems that applicant's filing of its motion to compel on January 14, 2002 had effectively tolled the running of all dates in this proceeding.[5] Accordingly, the Board finds that,

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[4] Applicant's contention that opposer's motion to compel is untimely because it was not filed within a reasonable time after applicant's failure to produce documents and things is not well-taken. That contention is based on an earlier version of Trademark Rule 2.120(e)(1), which was amended, effective October 9, 1998, by a final rule notice published in the Federal Register on September 9, 1998 at 63 Fed. Reg. 48081, 1214 TMOG 145 (Sept. 29, 1998).

[5] Applicant correctly notes that the mere filing of a motion to compel does not automatically suspend proceedings and that proceedings do not become suspended until the Board issues its suspension order following the filing of the motion to compel. See 63 Fed. Reg 48081, 1214 TMOG 145. Nonetheless, in exercising

notwithstanding the fact that the Board did not issue a suspension order in connection with applicant's motion to compel until January 17, 2002, opposer's testimony period did not commence on January 15, 2002. In addition, it is noted that opposer's testimony period did not commence under the discovery and trial schedules that the Board set in its March 11, 2002 order, in which it granted applicant's motion to compel, and the subsequent orders in this proceeding. Accordingly, the Board finds that opposer's motion to compel was timely filed.

Turning to the merits of opposer's motion to compel, applicant is reminded that the Board expects parties and their attorneys to cooperate with one another in the discovery process and looks with disfavor upon those who do not. Each party and its attorney has a duty to make a good faith effort to satisfy the discovery needs of its adversary. See TBMP Section 412.01.

While applicant's objection to opposer's request that responsive documents and things be produced at the offices of opposer's counsel is well-taken, applicant's contention that opposer's motion to compel was filed solely to delay

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its inherent authority to retain control over the running of the suspension period, the Board generally considers the suspension order to relate back to the filing date of the motion to compel. Further, a motion to compel "deals with pre-trial matters and should be filed and determined prior to trial." 63 Fed. Reg. 48081, 48088.

the commencement of trial herein is not. See Fed. R. Civ. P. 34(b). Rather, the Board is troubled by applicant's failure to produce any documents or things, despite having indicated in its responses to opposer's first request for production that it would so produce.[6] Applicant should have been more cooperative in attempting to reach agreement about a time and place for production of the requested documents and things and will not be permitted to gain an advantage from its refusal to produce such documents and things.[7] To the extent that applicant agreed in its responses to opposer's first request for production to produce the documents and things requested in opposer's first request for production, the Board finds that applicant must produce such documents and things without further delay. However, such production shall be made at the place where those documents and things are usually kept, as provided for in

[6] Applicant's argument that opposer's motion to compel should be denied because of opposer's conduct with regard to responding to its discovery requests is not well-taken. Notwithstanding the fact that opposer only responded to applicant's discovery requests after the Board had granted applicant's motion to compel in the March 11, 2002 order, applicant remained under an obligation to respond to opposer's discovery requests during the time allowed therefor under the applicable rules, regardless of opposer's conduct with regard to to its discovery requests. See Fed. R. Civ. P 26(d); *Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067 (TTAB 1990); TBMP Section 403.03.

[7] Applicant is also reminded 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).

Fed. R. Civ. P. 34(b) and Trademark Rule 2.120(d)(2), unless the parties otherwise agree.

In view thereof, opposer's motion to compel is hereby granted. Applicant is allowed until **thirty days** from the mailing date hereof to select, designate and identify the items and documents, or categories of items and documents, to be produced in response to opposer's first request for production and to notify opposer that the selection, designation and identification of such items and documents has been completed. Opposer is allowed until **thirty days** from receipt of notification from applicant that the items or documents have been selected, designated and identified to inspect and copy the produced materials.

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).

Opposer has indicated in its motion that, until its motion to compel is resolved, it cannot determine if follow-up discovery is necessary. The Board notes that opposer served its first request for production on January 18, 2001, i.e., with five months remaining in the discovery period as originally set in the order instituting this proceeding, and finds that applicant's failure to produce responsive documents and things has deprived opposer of an opportunity to take follow-up discovery that it would have had ample

time to take had applicant produced such documents and things. Accordingly, the Board finds that, notwithstanding the fact that discovery, as last reset in the Board's September 4, 2002 order, closed on December 15, 2002, it is appropriate to reopen discovery for opposer only to allow opposer time to take such follow-up discovery.[8] See *Miss America Pageant v. Petite Productions, Inc., supra*; TBMP Section 403.04. Discovery for applicant, however, remains closed.

Proceedings herein are resumed, and discovery and trial dates are reset as follows:

PLAINTIFF'S DISCOVERY PERIOD CLOSES:	**7/18/03**
Plaintiff's 30-day testimony period closes:	**10/16/03**
Defendant's 30-day testimony period closes:	**12/15/03**
15-day rebuttal testimony period closes:	**1/29/04**

[8] The Board notes that, while opposer's motion to suspend was filed on January 16, 2003, the Board did not issue the order suspending this proceeding pending disposition thereof until April 14, 2003, i.e., nearly three months later, and that opposer's thirty-day testimony period as last reset in the Board's September 4, 2002 order was scheduled to close on Saturday, March 15, 2003. The Board considers the April 14, 2003 suspension order to relate back to the filing date of opposer's motion to compel. Nonetheless, to eliminate any potential confusion caused by opposer's reliance upon the September 4, 2002 trial schedule after the filing of its motion to compel, the notice of reliance that opposer filed on the following Monday, March 17, 2003 is deemed timely filed. See Patent and Trademark Rule 1.7; Trademark Rule 2.121(d)(2). In addition, if the deposition of Robert Gurga that opposer noticed on March 3, 2003 for March 17, 2003 was taken on or before March 17, 2003, that deposition is deemed timely taken. See Patent and Trademark Rule 1.7; Trademark Rule 2.121(a)(1).

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.l25.

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.l29.