

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

Mailed: November 8, 2004

Opposition No. 91153220

MJCM, LLC

v.

F.N.B. CORPORATION

David Mermelstein, Attorney:

On November 3, 2003, opposer filed a motion to compel discovery and a motion to determine the sufficiency of applicant's responses to requests for admission. What has happened (and has come to light) thereafter is a virtual handbook on how not to conduct discovery in proceedings before the Board. Both parties have taken extreme positions, filed unnecessary and duplicative papers, and have failed to cooperate in good faith at nearly every juncture.

Facts

We start with the discovery requests at issue. On August 1, 2003, opposer served upon applicant twenty-five numbered interrogatories, nineteen requests for the production of documents, and eleven requests for admission. On November 3, 2003, opposer served a second set of three requests for the production of documents.

Opposition No. 91153220

Under the current trial schedule, discovery was set to close on September 8, 2003. Responses to opposer's discovery requests were due on September 5. Applicant requested additional time to respond to the discovery requests, which opposer granted. On August 27, opposer sent applicant a letter, agreeing to an extension of time and canceling a scheduled Rule 30(b)(6) deposition.¹ Applicant assented to the terms of the letter, informing opposer's counsel that he could cancel the arrangements he had previously made for the September 5 deposition.

Apparently the parties engaged in some settlement discussions, the exact nature of which are unimportant. These activities, however, led to a disagreement between the parties when, on October 2, applicant sent an e-mail to opposer stating that "[s]ince we are holding discovery at this moment for both sides pending settlement discussion, may I suggest we seek a short suspension, otherwise we will need to seek to reset discovery dates based upon our earlier discussions."

By letter dated October 7, 2003, opposer pointed out that applicant's discovery responses were overdue, and that

¹ Opposer had also noticed a 30(b)(6) deposition for September 5, and instructed applicant that the requested documents were to be produced at the time and place set for the deposition. While parties are free to agree to copy and produce documents elsewhere (and the Board encourages such cooperation), the rules provide that document production is to take place where the documents are usually kept. Trademark Rule 2.120(d)(2).

Opposition No. 91153220

applicant had sought no discovery during the scheduled discovery period. Opposer stated that it would not consent to a reopening of the discovery period, and that it did not consent to stay discovery during the parties' settlement discussions. Opposer further stated - for the first time - that notwithstanding its extension of time for applicant to respond as memorialized in the August 27 letter, that "by failing to serve objections by September 5, 2003, F.N.B. Corporation has forfeited its right to object to MJCM's First Request for Admissions, First Set of Interrogatories and First Request for Production on their merits." Nonetheless, opposer offered to accept applicant's substantive responses if received by October 17, 2003, "without objection as to the timeliness of the service or delivery thereof."

After an apparent telephone discussion, applicant confirmed its understanding of an agreement by e-mail: "[w]e have agreed that your request to receive discovery response [sic] by 10/17/03 is amended to request service by me, FedEx, on or before 10/24/03."

Finally, on October 24, 2003, applicant served responses to opposer's discovery. But if opposer thought it was to learn anything from such responses, it was mistaken. In response to opposer's first set of interrogatories, applicant interposed ten general objections and four

Opposition No. 91153220

specific objections to various groups of interrogatories. Not a single interrogatory was responded to in substance.

Likewise, applicant's response to opposer's first and second requests for the production of documents comprised nine general objections and four specific objections to various groups of requests. Applicant apparently objects to the disclosure of some documents on the basis of confidentiality, although no log of withheld documents was produced.² The response concluded as follows:

Subject to the above objections, inspection will be permitted as to those documents not confidential, privileged or otherwise objectionable with regard to Opposer's First Requests numbered 1-19 and Second Requests numbered 1-3 at the offices of the undersigned at a mutually agreeable time.

Opposer's requests for admission met with a similar fate, as by applicant's response objections were interposed as to all but Request No. 11, which was denied. In sum, out of twenty-five interrogatories, twenty-two requests for the production of documents, and eleven requests for admission, applicant has answered exactly one request for admission, and may (or may not)³ permit inspection and copying of some documents.

² Following a telephone conversation on October 24, 2003 in which applicant's counsel raised concerns about confidential materials, opposer drafted, signed, and transmitted to applicant a proposed confidentiality agreement, prior to applicant's response. Nonetheless, the agreement apparently remains unexecuted by applicant or its counsel, and no confidential materials were produced.

³ None of applicant's objections referred to specific documents or sets of documents, and - as noted - no privilege log was

Opposition No. 91153220

Following the service of applicant's responses, opposer sent to applicant on October 28, a letter outlining its position, namely that applicant's original time for responses had passed, and that opposer had granted extensions of time only for the service of "**substantive** discovery responses." (emphasis in original.)

Because [applicant's] objections are untimely, the objections cannot now be interposed by [applicant], but even if [applicant] could now raise the objections, its response does not come close to meeting its obligations under the Federal Rules of Civil Procedure and the rules of practice before the Board.

* * *

Because [applicant] has completely failed to reciprocate [opposer's] cooperation in connection with discovery in this manner, I must now insist that [applicant] provide, without objection, complete responses to [opposer's discovery requests]. If by noon on Friday, October 31, 2003, I do not have in my possession [applicant's] complete responses as set forth above, I shall be forced to file with the Board a motion to compel such responses and to grant such further relief to which [opposer] may be entitled.

In its e-mail response of the same day, applicant complains that opposer "provided no means with which to protect the confidentiality of the documents you requested until Friday, October 24, 2003." "There is no reason," applicant continues, "for hysteria surrounding what is truly

produced. Applicant's response to opposer's document requests specifically warned that "[a] representation that Applicant will produce any non-privileged, responsive documents that are within Applicant's possession, custody or control is not a representation to Opposer that any such documents exist." Thus, although applicant promised to produce any such documents, it is not clear that such papers actually exist, or that applicant has even searched its records to determine whether they exist.

Opposition No. 91153220

a standard and unremarkable discovery exchange with counsel who has been completely agreeable and cooperative with you at all times."

True to its word, on November 3, 2003, opposer filed a motion to compel, a motion to determine the sufficiency of objections, and a "statement of opposer's counsel," with attachments totaling one hundred fifty-six pages. Applicant filed a motion to extend its time to respond to the motion to compel. Needless to say, even this routine motion has been opposed in a ten-page brief.

When applicant ultimately filed its response to opposer's motions, opposer filed on January 5, 2004, a motion to strike the paper, or in the alternative, for consideration of a reply brief with a proffered reply brief attached (including attachments, a total of fifty-four pages). Not to be outdone, applicant filed an opposition to opposer's January 5 motion.

Discussion

Before turning to opposer's motion to compel, we consider two preliminary matters. First, we note that opposer filed three papers on November 3, 2003: A 17-page motion to compel and memorandum, a 9-page motion to test sufficiency and memorandum, and an 8-page "statement of opposer's counsel." All three papers included attachments.

Opposition No. 91153220

The total submission amounted to 34 pages of motions and related papers with 122 pages of attachments. Needless to say, there is considerable redundancy among the November 3, filings.

The Board has previously cautioned parties who have split motions to compel into several motions in order to avoid the Board's 25-page limit on the length of motions. *Estate of Shakur v. Thug Life Clothing Co.*, 57 USPQ2d 1095, 1096 (TTAB 2000). Although a motion to determine the sufficiency of responses to admissions is technically a different motion than a motion to compel, it appears that all three November 3 submissions - which do arise out of the same facts - could easily have been submitted as one combined motion, within the applicable 25-page limit.⁴ Counsel are cautioned that the Board will henceforth strictly enforce its page limits, and that attempts to evade the rule will likely result in the Board's refusal to consider any of the papers so filed.

As to the second preliminary matter, on November 24, 2003, applicant filed a motion for extension of time in

⁴ Likewise the statement of good faith efforts to resolve the dispute as required under Trademark Rule 2.120(e)(1), should be included in the motion for purposes of the Board's page limit. This is rarely an issue, since most motions to compel are more concise than that at issue here, and the statement of good faith efforts can easily be included in the body of the motion. It is further noted that opposer's "statement of counsel," while including a recitation of the facts, is also argumentative, and thus might properly be included in the page count for the motion.

Opposition No. 91153220

which to respond to opposer's motion to compel. Applicant states that its counsel was occupied with other matters, and was thus unable to file its response within the time set out in the Trademark Rules. Opposer filed a response to the motion to extend, arguing at length that applicant's motion was not specific enough. Finally, after the filing of applicant's response to the motion to compel, opposer filed a "motion to strike and alternative motion for consideration of reply brief."

Good cause having been shown, applicant's motion to extend is GRANTED. While applicant could have been more specific in its motion to extend, its motion was adequate. Opposer's motion to strike is accordingly DENIED.⁵ We have considered opposer's reply brief.

We turn next to the requirements for a motion to compel discovery or to test the sufficiency of responses to requests for admission, and in particular, to the requirement that the "motion must be supported by a written statement from the moving party that such party ... has made a

⁵ Opposer's motion to strike and alternative motion to consider its reply brief were entirely unnecessary. The issue of the timeliness of applicant's response to the motion to compel was squarely raised by applicant's motion to extend and opposer's brief in response. Had the Board seen fit to deny the motion to extend, applicant's response would have been untimely and thus given no consideration. Thus, the motion to strike was of no utility. Likewise, opposer's motion to consider its reply brief was not necessary. While consideration of a reply brief is discretionary with the Board, Trademark Rule 2.127(a), it is neither necessary nor appropriate to engage in separate motions practice on whether a reply brief should be considered.

Opposition No. 91153220

good faith effort, by conference or correspondence, to resolve with the other party ... the issues presented in the motion and has been unable to reach agreement." Trademark Rule 2.120(e), 2.120(h)(1).

Discovery before the Board is intended to proceed largely independent of Board intervention, and parties are required to cooperate in good faith toward that end. See TBMP § 408.01 (2d ed. rev. 1 2004), and authorities cited therein. Accordingly, the movant is required to certify that it has been unable to resolve a discovery dispute before bringing it before the Board.

Despite opposer's lengthy statement, its actual efforts to resolve this dispute have been meager, at best. This dispute arose upon the service of applicant's responses to opposer's discovery requests, on October 24, 2003. While we have not ignored the lengthy record of previous correspondence between the parties, it appears that the sole attempt by opposer to resolve this dispute once it arose was its letter dated October 28, 2003. That letter simply set out opposer's position that all objections had been waived, and demanded satisfactory responses to discovery no later than "noon on Friday, October 31, 2003," failing which a motion to compel would be filed. Applicant's brief response added little to the discourse.

Opposition No. 91153220

This is not the kind of good faith effort to resolve discovery disputes that the Board expects. Opposer sent one letter stating its position in unequivocal terms, and demanded full responses without objection in less than three days, a deadline which would have been difficult to meet even if applicant had been willing to try. Opposer appears not to have made any attempt to call applicant to discuss the matter or to have left any room for discussion of its views.

Trademark Rule 2.120(e)(1) places the burden for making a good faith effort to resolve the dispute squarely on the shoulders of the movant. The rule does not specify what constitutes a "good faith effort," leaving that determination to be made on a case-by-case basis, considering the attendant circumstances. A letter clearly setting out the movant's position is often a necessary step; but such a letter may not in itself be sufficient when - as here - it consists simply of an inflexible demand coupled with an unrealistic deadline.⁶ And even though applicant responded by e-mail on the same day to opposer's October 28

⁶ On the other hand, when the recipient of a reasonable and thoroughly supported demand letter adamantly refuses to respond in any way, evidence of a demand letter and the unequivocal response might together be all the evidence necessary to establish a movant's good faith, as the Board will not condition the right to file a motion to compel upon the movant's knocking of its head against a wall.

Opposition No. 91153220

demand letter,⁷ opposer appears to have made no further efforts "by conference or correspondence, to resolve ... the issues presented in the motion...", Trademark Rule 2.120(e)(1), despite applicant's counsel's response that she had "no doubt that you will get your documents."

Accordingly, opposer's motions to compel and to test the sufficiency of applicant's admissions are DENIED for failure to engage in good faith efforts to resolve the dispute prior to filing.

Further Remarks

Because the parties - and the Board - have expended so much effort on the filings to date, it seems appropriate to offer further guidance, notwithstanding our denial of opposer's motion on procedural grounds. As noted at the beginning of this order, the Board finds much that is lacking in the practice of both parties. The Board cannot resolve here all of the disputes raised in the parties' many filings, but in the interests of getting this proceeding back on track, we offer the following comments:

To begin with, we note that opposer's discovery requests are hardly the picture of clarity. For instance, applicant cites interrogatory number 2:

⁷ Applicant's counsel indicated that she had not been able to review opposer's draft protective agreement. ("I will review the draft timely and have no doubt that you will get your documents.") Applicant also objected to "both the tone and the content of [opposer's demand] letter."

Opposition No. 91153220

For each of the Specified Services for which the specimen submitted in the Application does not constitute a specimen of the Applicant's use of the mark BOUNCE GUARD on or in connection with such Specified Service, with respect to the use of the mark BOUNCE GUARD on or in connection with such service for which Applicant relies to establish its date of first use of the mark in connection with such service as stated in the Application, please provide a detailed description and explanation of all relevant facts and circumstances of such use, including the manner of such use by Applicant of the mark BOUNCE GUARD and complete quotation of any identification, description or explanation of such service associated with that use.

As confusing as this 122-word sentence is by itself, a number of the terms used therein are themselves subject to lengthy definitions in the accompanying "instructions and definitions." While Interrogatory No. 2 is probably the worst example, it is not the only one of opposer's discovery requests that is difficult to parse.

Responding to discovery requests should not require the complex sentence diagramming task which would be necessary to understand some of opposer's requests. We have no doubt that opposer could - with the investment of some thought and time - draft clear and concise discovery requests which could be answered with certainty and relative ease.

Next, we find opposer's position with regard to the timeliness of applicant's objections unwarranted. Opposer claims that applicant initially waived its right to object to opposer's discovery requests by agreeing to the terms of opposer's August 27, 2003, letter. Opposer now claims that the August 27 letter only allowed applicant an extension of

Opposition No. 91153220

time to provide "**substantive responses.**" See Letter, October 28, 2003 (emphasis in original).

We have read the August 27 letter several times. Not only does the word "substantive" not appear in that letter, but we are unable to discern any waiver (explicit or otherwise) of applicant's right to object to opposer's discovery requests. To the extent that opposer argues that applicant agreed to forgo its right to object based on the August 27 letter, we see no basis for such a claim.⁸

As a general matter, the Board views an appropriate objection as an "answer" or "response" to a discovery request, and the right to interpose a timely and appropriate objection is inherent in the right to respond. Thus, if an extension to respond is granted, such extension is just as much an extension to object as it is an extension to provide a substantive response. We do not believe that such a waiver can be found in clever wording or in semantic arguments over the difference between an answer and an objection.

⁸ Opposer argues that applicant confirmed opposer's waiver theory by its October 14, 2003, e-mail. That message accepted opposer's offer of the same day of a further extension. Opposer stated in its offer that "I continue to maintain that all other matters stand as stated in my October 7, 2003, letter to you."

Contrary to opposer's argument, we see its October 14 offer as being nothing more than a restatement of the position set out in opposer's October 7 letter - a position we find incorrect and unreasonable. Applicant's acceptance did not evidence its agreement to a waiver of any right to object but - at most - only an acknowledgement of opposer's argument.

Opposition No. 91153220

Parties may, of course, agree to waive their right to object to improper discovery requests if they so wish. But the essence of an agreement is a meeting of the minds, and the waiver of such a fundamental right must be clear and explicit. We find no meeting of the minds evident in applicant's agreement to the terms in opposer's August 27 letter, because that letter nowhere mentions the waiver of applicant's right to object to opposer's discovery requests.

By virtue of its position as movant, we have so far focused mainly on opposer's conduct in this dispute. We do not mean thereby to imply that applicant's behavior in this matter has been exemplary. After receiving extensions of time to respond, applicant served responses to opposer's discovery which were replete with objections. Indeed, it appears that - other than a single request for admission, which was denied - applicant has refused to answer or produce documents responsive to every single one of opposer's discovery requests.

Some of applicant's objections appear to have merit. Applicant has, for instance, objected to some of opposer's vague and unclear discovery requests (including interrogatory number 2, discussed above). On the other

Opposition No. 91153220

hand, many of applicant's objections are themselves vague and unclear.⁹

Discovery objections are not magical incantations to be muttered in response to discovery requests. Just as a discovery request must clearly identify what information is sought, an objection must clearly state the specific reason why that requested information is being withheld.

Here, applicant makes liberal use of "general objections" set out at the beginning of each of its discovery responses. Because any objection must be applied specifically to the language of each discovery request complained of, we view most general objections as essentially useless, because they do not inform either the Board or the party seeking discovery of the specific reason that each request is viewed as being improper.¹⁰

Nor are objections academic exercises. An objection may not be made when there is nothing to object to. For instance, "[a]pplicant objects to the discovery requests to the extent that they call for the disclosure of information

⁹ Applicant's responses do not conform with the Board's preference that the responding party reproduce each discovery request immediately preceding the answer or objection thereto. See TBMP § 405.04(b). The resulting lack of structure makes it difficult to determine the grounds pertaining to each request.

¹⁰ Some general objections are clearly appropriate, such as an objection to the timeliness of discovery requests, or an assertion that interrogatories exceed the maximum number permitted. Such objections, however, must apply to the entire set of discovery requests, and be made prior to, and in lieu of, any specific objections or substantive answers. See Trademark Rule 2.120(d)(1).

Opposition No. 91153220

protected by the attorney-client privilege, the attorney work-product doctrine, or any other applicable privilege. (emphasis added). While this is unremarkable as a general statement of principle, such an objection is inappropriate, because it is not clear whether opposer's discovery requests actually call for the disclosure of such information.

When a party resists a discovery request on the ground that it would result in the disclosure of privileged or confidential information, a proper response must (1) identify what part of the discovery request calls for such information; (2) clearly identify all documents or information which are responsive, but deemed subject to privilege or confidence; and (3) produce all non-privileged or confidential material. Neither the requesting party nor the Board should be required to guess what information has been withheld.¹¹

In this regard, the Board finds particularly offensive applicant's "general objection" No. 6 to opposer's requests for production of documents:

A representation that Applicant will produce any non-privileged, responsive documents that are within

¹¹ Applicant's October 28, 2003, e-mail implied that applicant had delayed in responding to opposer's discovery because opposer had not provided a draft agreement for the protection of confidential documents. Applicant's delay in this regard was unwarranted. Absent an agreement to the contrary, the lack of a confidentiality agreement is not an excuse for the failure to timely respond to discovery. When discovery requests call for disclosure of protected information and a confidentiality agreement or order has not been executed, the proper procedure is to respond with an objection as outlined above.

Opposition No. 91153220

Applicant's possession, custody or control is not a representation to Opposer that any such documents exist.

Applicant's general objection No. 6 raises the prospect that - notwithstanding its objections and promise to permit inspection of "documents not confidential, privileged or otherwise objectionable," - no such documents exist, and clearly contemplates the possibility that applicant does not even know whether or not they exist because applicant has not made a sufficient search of its records. The current discovery dispute has clearly incurred a very substantial investment in time and money by both parties, not to mention the time spent by the Board and the delay in this proceeding. If no responsive documents exist for some or all of opposer's discovery requests, much of the current dispute is moot, making this matter nothing more than a grand waste of time.

As noted, discovery is not an academic exercise, and the Board does not appreciate wasting its time on meaningless tasks. Accordingly, we do not view hypothetical objections ("If I had any documents, I would object to their production...") as being made in good faith; if no responsive documents exist, the parties must so state.

Conclusion

Discovery before the Board is expected to be conducted without the need for Board intervention, except for *bona*

Opposition No. 91153220

fide disputes which the parties are unable to resolve after genuine attempts to do so. As we have stated in the past, parties before the Board have an obligation to cooperate in both seeking and providing appropriate discovery, and in resolving any disputes over discovery. As should be clear from this order, we find that both parties have fallen far short of this standard.

As noted, we deny opposer's motion to compel for failure to certify that it made a good faith effort to resolve the matter. Nonetheless, given the other issues raised by the matter at bar, the Board orders as follows:

Opposer is allowed THIRTY DAYS from the mailing date of this order in which to reformulate and re-serve any of its discovery requests which have been objected to as being vague, ambiguous, unclear (or any similar objection). Such discovery requests should, to the extent possible, clarify the requests and should be within the scope of the corresponding original discovery requests.

Applicant is allowed THIRTY-FIVE DAYS from the service of opposer's revised discovery requests to fully respond. With respect to opposer's requests for the production of documents, applicant is ordered to copy and deliver to opposer (by mail or otherwise) any responsive documents.

Discovery is otherwise CLOSED.

Opposition No. 91153220

It is noted that - despite applicant's blanket objections that opposer's discovery requests call for the disclosure of confidential or proprietary information - the parties have apparently still not reached agreement on a stipulated protective order. Accordingly, the Board is separately entering such an order.¹² The parties may make any appropriate modification to the terms of the protective order by agreement only. Any such agreement should be signed by both parties and filed with the Board.

In formulating and responding to discovery, the parties should be guided by the Trademark Rules, any applicable Federal Rule of Civil Procedure, and relevant decisional law. In particular, however, the parties must cooperate promptly and in good faith to resolve any discovery dispute. We remind the parties that the Board possesses ample authority if necessary to convene a hearing before the Board pursuant to Trademark Rule 2.120(i)(2), and to sanction one or both parties for inappropriate conduct or discovery abuses. Trademark Rule 2.120(g); Fed. R. Civ. P. 37. See also, *Carrini Inc. v. Carla Carini S.R.L.*, 57 USPQ2d 1067 (TTAB 2000).

¹² The parties are referred, as appropriate, to Trademark Rule 2.126(d) and TBMP §§ 412.02, et seq. (2d ed. June 2003). The parties are advised that only confidential or trade secret information should be filed pursuant to a stipulated protective agreement. Such an agreement may not be used as a means of circumventing paragraphs (d) and (e) of 37 CFR § 2.27, which provide, in essence, that the file of a published application or

Opposition No. 91153220

Dates Reset

Proceedings are RESUMED. Trial dates, including the close of discovery, are reset as follows:

DISCOVERY PERIOD TO CLOSE:	CLOSED
Thirty-day testimony period for party in position of plaintiff to close:	March 20, 2005
Thirty-day testimony period for party in position of defendant to close:	May 19, 2005
Fifteen-day rebuttal testimony period to close:	July 3, 2005

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.

.oOo.

issued registration, and all proceedings relating thereto, should otherwise be available for public inspection.