

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

alv/apb

Mailed: June 8, 2006

Opposition No. 91154268

Monster Cable Products, Inc.
and Monster Cable
International, Ltd.

v.

eMarkmonitor Inc.

Andrew P. Baxley, Interlocutory Attorney:

This case now comes up for consideration of (1) opposers' combined motion (filed February 9, 2004) to compel discovery, to test the sufficiency of applicant's responses to requests for admission, and for entry of sanctions; (2) applicant's motion (filed February 13, 2004) to strike opposers' combined motion; and (3) opposers' consented motion (filed May 2, 2006) to suspend this proceeding for settlement negotiations.¹

The Board turns first to opposers' consented motion (filed May 2, 2006) to suspend proceedings herein for settlement negotiations. That motion is hereby granted to

¹The Board construes applicant's motion to strike as a response to opposers' combined motion. Although opposers' time to respond to the motion to strike has not lapsed, the Board, in the interest of moving this proceeding forward, elects to decide both motions on the merits at this time.

the extent that proceedings are deemed suspended as of May 2, 2006. See Trademark Rule 2.117(c).

Turning next to applicant's motion to strike, the Board notes that the combined motion was timely filed and that opposers' brief in support thereof does not exceed the page limit for briefs on motions in Board inter partes proceedings. See Trademark Rules 2.120(a) and 2.127(a). Further, applicant's arguments in support of the motion to strike essentially address the merits of the combined motion, which form a basis for denying, rather than striking, that motion. See TBMP Section 517 (2d ed. rev. 2004). Accordingly, the motion to strike is denied. The Board will consider the combined motion on the merits.

Turning to the combined motion, after reviewing the parties' arguments and exhibits,² the Board finds that opposers failed to make a good faith effort to resolve the parties' discovery dispute prior to seeking Board intervention, as required by Trademark Rules 2.120(e)(1) and 2.120(h)(1). In particular, we note that the discovery responses at issue in the combined motion were served roughly five months prior to any effort by opposers to

² The Board notes that, in support of their combined motion, opposers filed three copies of their first set of requests for admission and two copies of their first set of interrogatories. Filing more than one copy of a particular set of discovery requests in support of a motion to compel or a motion to test the sufficiency of responses to requests for admission is unnecessary

address specific deficiencies therein; that the parties were negotiating to settle this case while dates herein continued to run and the case moved forward toward trial; that opposers only effort to resolve the discovery dispute consisted of a February 5, 2006 letter from its attorney to applicant's attorney that set forth specific alleged deficiencies in applicant's discovery responses; and that such letter was sent one day prior to opposers' service of the combined motion and less than a week prior to the commencement of trial as last reset.³ As the Board stated in *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666 (TTAB 1986):

[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.

and should be avoided. See Trademark Rules 2.120(e)(1) and 2.120(h)(1).

³As such, opposers' combined motion appears intended, at least in part, to delay the commencement of trial.

In view of opposers' failure to confer with applicant regarding the parties' discovery dispute, and noting that opposers only sought Board intervention on the eve of trial after settlement discussions ended, it is clear that opposers failed to make a good faith effort to resolve the parties discovery dispute prior to seeking Board intervention. Accordingly, the combined motion to compel discovery and to test the sufficiency of responses to requests for admission is hereby denied.⁴ Inasmuch as no motion compelling discovery has been granted herein, opposers' motion for sanctions is inappropriate and will receive no consideration. See Trademark Rule 2.120(g)(1).

Notwithstanding the foregoing, applicant is reminded that it has a duty to make a good faith effort to satisfy

⁴ Opposers' contention in their attorney's September 10, 2003 letter to applicant's attorney that applicant automatically waived its right to object on the merits to applicant's interrogatories and document requests by failing to timely respond thereto is not well taken. Rather, a party that has failed to timely respond to discovery requests and which does not show that its failure to timely respond was the result of excusable neglect may be found by the Board, upon the filing of a motion to compel, to have forfeited such right. See TBMP Section 403.03 (2d ed. rev. 2004) and cases cited therein. The Board, however, has great discretion in determining whether such forfeiture should be found. See *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000). Under the circumstances herein, the Board finds that granting opposers the windfall of requiring applicant to serve discovery responses without objection is unwarranted.

Opposers' request for fees in connection with its combined motion is likewise not well taken. It is well settled that the Board will not award fees to any party. See Trademark Rule 2.127(f).

opposers' discovery needs. See Fed. R. Civ. P. 26(g).

Applicant is further reminded that a party which has responded to a discovery request has a duty to supplement or correct that response. See Fed. R. Civ. P. 26(e).

Applicant 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).

The suspension period having expired with no word from either party concerning the status of their negotiations, the Board concludes that efforts to reach an amicable settlement in this case were unsuccessful. Accordingly, proceedings herein are resumed. Testimony periods are reset as follows.

Plaintiff's 30-day testimony period to close: **8/11/2006**

Defendant's 30-day testimony period to close: **10/10/2006**

Plaintiff's 15-day rebuttal testimony period to close: **11/24/2006**

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.

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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.