TTAB

Docket No. 926536-922812

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

YOSHIDA METAL INDUSTRY CO., LTD.	)	
	)	
Opposer,	)	Opposition No. 91/156,618
	)	Appln. Serial No. 76/179,674
v.	)	Mark: GLOBAL DECOR
	)	
GLOBAL DECOR, INC.	)	TTAB Attorney: Nancy O'Melco, Ext. 23
	)	
Applicant.	)	

APPLICANT'S RESPONSE TO OPPOSER'S MOTION FOR FURTHER DISCOVERY UNDER FEDERAL RULE CIV. P. 56(f) AND FOR AN ORDER COMPELLING DISCOVERY

Opposer has filed its motion in complete disregard of case law, TTAB Rules, and Orders issued by the Board on this case. The portion of Opposer's motion asking for an order compelling discovery, in substance a separate motion to compel, is in violation of this Board's order suspending all proceedings on September 12, 2003. (Copy attached as Exhibit A). It further violates TTAB Rule 2.120(e) expressly requiring the parties make a good faith effort to meet and confer to resolve objections over which discovery is sought. Moreover, Opposer's discovery lacks merit.

The portion of Opposer's motion seeking further discovery under Rule 56(f) also contravenes case law and the Rules set up to prohibit a party from dragging another party, with a right to file for summary judgment, through needless time-consuming and expensive discovery.

The Board must deny both Opposer's motion for order compelling discovery and motion for further discovery under Rule 56(f).

I.

Opposer Has No Grounds to Compel Discovery From Applicant

The motion seeking to compel discovery is in violation of the Board's order of September 12, 2003 suspending all proceedings. (See attached Exhibit A).

The motion further disrespects TTAB Rule 2.120(e) which lays down the framework to ensure fairness and efficiency govern discovery disputes. For example, the rule requires that the moving party include copies of the requests and responses on which their motion seeks to compel further responses. Opposer has failed to provide a copy of its requests. The copies of Applicant's responses do not fairly disclose Opposer's requests. Opposer's requests use defined terms. The definitions for these terms can only be found in Opposer's actual discovery requests. Applicant has based its general objections and its objections to specific requests, in part, on the use of overbroad and confusing defined terms. For example, the requests define "Applicant's Products" to mean any products sold with the mark Global Décor regardless of whether the product has anything to do with the products in dispute. See Exhibit B, Item A of Opposer's Interrogatories. As explained in more detail below, the request is overbroad and not permissible. Also by failing to provide copies of its requests, Opposer conceals the fact that its document request demanded production in an improper manner. See Exhibit C.

Rule 2.120(e) requires that a motion to compel be supported by a written statement that the attorney therefore has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefore, the issues presented in the motion and has been unable to reach agreement. The requirement of a good faith meet and confer means the parties are to get together to narrow down their differences and only present to the Board the requests which despite best efforts, remain in dispute. See *Sentrol v. Sentex*, 231 USPQ 666, TTAB 1986). It is generally the policy of

the Board to intervene in disputes concerning discovery by determining motions to compel only where it is clear the parties have in fact followed the aforesaid process and have narrowed the amount of disputed requests for discovery. *Id.* Merely paying lip service to the "meet and confer" requirement does not satisfy the requirement. The Board in *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 299 USPQ 955 (TTAB May 7, 1986) found simply sending correspondence charging a party with providing responses does not constitute a meet and confer.

Like the movants in the above-referenced cases, Opposer in the present case has utterly failed to attempt to resolve Applicant's timely and well-founded objections to Opposer's discovery. For instance, over Applicant's objections and without ever addressing the objections, Opposer still demands production, in violation of the rules, at its Alexandria, Virginia offices; still demands information concerning all of Applicant's Products, regardless of whether the products have anything to do with the products in dispute, still demands information, even though Applicant has advised Opposer that its use of defined terms is confusing.

The record, however, is clear that Applicant was willing and ready to resolve, in good faith, all objections. Applicant's responses to document requests specifically stated:

> The production will be at an agreeable time and place in accordance with this response. The documents subject to production, if any, will be ... See Opposer's Exhibit D, Applicant's response to request 1.

Applicant, in fact, specifically told Opposer that it considered Opposer's suggestion concerning a protective order sufficient to resolve Applicant's concerns over the need for a protective order. See Opposer's Exhibit A. Applicant also specifically invited Opposer to discuss Applicant's remaining objections to Opposer's discovery once Opposer had a chance to consider the objections. See Opposer's Exhibit A. Opposer never even bothered to discuss the offer with Applicant or ever discussed any of Applicant's objections to Opposer's discovery. The only issue considered was

Applicant's desire for a protective order which was raised by Applicant prior to serving its discovery responses. See Opposer's Exhibit A.

Opposer's statement that "the undersigned has made a good faith effort, by correspondence to resolve the discovery issues presented in the accompanying motion is simply not correct. Opposer never attempted to resolve any of Applicant's objections to Opposer's discovery, let alone those which are now in dispute; the only issue considered was the need for a protective order. The issue was raised by Applicant prior to Applicant serving its response and later resolved. See Opposer's Exhibit A.

An examination of Applicant's responses demonstrates its objections, all ignored by Opposer, are well-founded and that Applicant's responses provide Opposer with significant information. Applicant has, for instance, properly objected to the document requests in part because they demand production to take place at Opposer's attorney's offices in Alexandria, Virginia. See Exhibit C. Trademark Rule 2.120(d)(2) prohibits such a demand unless agreed to by Applicant. Opposer never even bothered to discuss the manner of production with Applicant. Applicant also properly objected to Opposer's request because they are overbroad. For example, the requests define "Applicant's Products" to mean any products sold with the mark Global Decor regardless of whether the products have anything to do with the products in dispute. (See Exhibit B, Opposer's definition of "Applicant's Products" Item F). Applicant specifically made the objection both in its general and its specific objections. See for example, Opposer's Exhibit C, Applicant's responses to interrogatories 5-9 and Opposer's Exhibit D, Applicant's response to document requests.[1] The TTAB has repeatedly held this type of question asked by Opposer is overbroad. See *TBC Corporation v. Grand Prix, Ltd.*, 16 USPQ 2d 1399 (TTAB 1990),citing *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581

[1] Applicant in its general objections, as a result of a scrivener's error, referred to the defined term, erroneously as "Accused Products."

[*3] (TTAB 1975); *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120 (TTAB 1974); *Volkswagenwerk Aktiengesellschaft v. MTD Products, Inc.*, 181 USPQ 471 (TTAB 1974); and *Volkswagenwerk Aktiengesellschaft v. Thermo-Chem Corp.*, 176 USPQ 493 (TTAB 1973). The remaining objections set forth by Applicant, also ignored by Opposer, are valid.

II.

Opposer Mischaracterizes the Discovery

Opposer's motion misstates Applicant's objections. For instance, Opposer makes it appear that the only objection Applicant had to answering Opposer's discovery was the fact that Applicant had filed a Motion for Summary Judgment and the need for a protective order. See Opposer's motion, page 3, line 15; page 4 line 8. Applicant, however, had significant other well-founded objections as already outlined above and set forth in Applicant's responses. In addition to ignoring Applicant's objections, Opposer's motion misstates the breadth of its own discovery. For instance, Opposer states that its Document Request No. 1 only asks for representative specimens of Applicant's current and proposed advertising. See Opposer's motion, page 3, line 4. A look at Request No. 1, however, reveals it requests far more. It also requests promotional documents and electronic media, even if the items were only used on behalf of Applicant. See Opposer's motion, Exhibit D. Thus, Opposer wants Applicant to produce more than its own advertising. Opposer claims its Document Request No. 7 only asks for assignments, consents or licenses involving Applicant's mark. See Opposer's motion, page 3, line 8. The request asks for much more including authorizations or permissions. See Opposer's motion, Exhibit D. These terms are vague and could include virtually any sales receipt or sales document. Opposer characterizes its Interrogatory No. 8 as only asking for the amount budgeted and expanded to promote Applicant's mark. Opposer's motion page 3, last paragraph. The interrogatory, however, asks that Applicant state for each

product ever sold by Applicant in connection with the mark, by calendar quarter, the dollar volume budgeted and expended by Applicant to promote Applicant's mark. Opposer's motion further claims its Interrogatory No. 9 only asks for income from sales of Applicant's products bearing Applicant's mark. It requests much more. It requests by calendar quarter both income and anticipated income.

Opposer, in addition to mischaracterizing its own discovery, mischaracterizes the amount of information Applicant has already provided to Opposer. Opposer, for instance, states that Applicant has not provided Opposer with dates of first use. Applicant in response to Interrogatory No. 3 made it clear that it did not adopt its mark until May of 1999. Opposer's motion, Exhibit C. The response obviates the need for Applicant to provide further information regarding first use. Opposer also tries to make it appear as though Applicant could have information demonstrating intent which Opposer needs. Applicant, however in responding to Interrogatories Nos. 12 and 13 stated that it had zero knowledge of Opposer and Opposer's mark prior to filing its application to register Global Decor. Opposer's motion, Exhibit C. Opposer also incorrectly asserts that Applicant has indicated responsive documents exist. Applicant has made no such indication. Applicant's statement that "It will not produce documents at this time" is an indication that Applicant stands on its objections. It is not an indication that Applicant has responsive documents. Had Opposer bothered to meet and confer with Applicant, Opposer would not have misunderstood Applicant's response. Further, Opposer's motion ignores Applicant's offer to provide for inspection at Applicant's offices promotional material it has on hand. (See Opposer's motion, Exhibit C, Applicant's response to Interrogatory No. 10). Opposer's need to misstate the scope of its own discovery and the import of Applicant's answers to its discovery evidences both the impropriety of the discovery and its unrelatedness to facts essential for Opposer to respond to Applicant's Motion for Summary Judgment.

III.

Opposer Has Failed to Set Forth the Essential Facts It Needs to Justify Further Discovery Under Rule 56(f)

Rule 56(f) does not permit a party to complete discovery sufficient to go to trial. Rule 56(f) rather only allows a party to obtain additional discovery if the party can establish by affidavit or declaration that the party cannot for reasons stated present by affidavit, facts essential to justify the parties' opposition. A Rule 56(f) declaration must set forth focused discovery which seeks essential facts. *See Keebler Company v. Murray Bakery Products*, 866 F2d. 1386, 1390; 9 USPQ 2nd 1736 (Fed. Cir. 1989). An affidavit which merely sets forth unfocused requests does not satisfy Rule 56(f) criteria. *Id.* In *Keebler* the Court specifically noted that Keebler's unfocused requests set forth in affidavits did not meet Rule 56(f) requirements. The petitioner under Rule 56(f) must show more than a mere speculative hope of finding evidence that might tend to support a claim. *See Brubaker Amusements Co. v. U.S.* 304 F3d 1349, 1361 (Fed. Cir. 2002).

Opposer's declaration at ¶ 11 states that it needs all of the paper discovery it propounded to respond to applicant's motion for summary judgment. Opposer fails to point out why it needs all of the discovery. For instance, Opposer fails to point out why it is essential that it needs information about all of Applicant's products regardless of whether the products have anything to do with the goods in dispute. See Exhibit B, Item F. Opposer fails to point out why, in rebutting Applicant's Motion for Summary Judgment, it is essential that it have those documents regarding the dollar value of actual and projected sales of Applicant products, the amount of money expended or budgeted to promote Applicant products, Opposer's Exhibit D; Request No. 12; copies of any surveys market research tests, demographic or consumer profile studies and focus groups inquiry regarding the ultimate purchases or potential of the purchases of Applicant products, Opposer's Exhibit D, Request

No. 15. Opposer also fails to set forth why in order to rebut Applicant's Motion for Summary Judgment it needs interrogatory answers calling for the identity of Applicant's supervisory employees responsible for the promotion, sale and distribution of Applicant's products promoted and/or sold under Applicant's mark, Opposer's Exhibit C, Interrogatory No. 2; the identity of any agreement such as assignments, licenses, authorizations, permissions or consents entered into by Applicant regarding Applicant's mark. Opposer's Exhibit C, Interrogatory No. 19. Additionally, Opposer fails to set forth the essential nature of the myriad of sales information and first use information it requests from Applicant.

To justify its claim that all of its paper discovery is essential, Opposer simply states in conclusory format that it needs the information because the information may have relevance to some of the Dupont factors. See Declaration in support of Opposer's motion, ¶ 9. According to Opposer it needs the information because the information concerns Applicant's intent, Applicant's advertising and promotions, Applicant's intended consumers and Applicant's trade channels. Opposer's motion, page 5. First, the myriad of sales information and first use information requested does not concern any of these categories. In fact, Applicant does not need any more information concerning first use as Applicant has stated in response to Interrogatory No. 3 that it adopted its mark in May of 1999. Additionally, Applicant has provided Opposer with all of the information it needs concerning Applicant's intent. Applicant specifically responded to Interrogatories 12 and 13. The answers make it clear that Applicant had no knowledge of Opposer or Opposer's mark.

Some of Opposer's paper discovery does relate to Applicant's marketing activities. Opposer, however, fails to show why it needs all of its paper discovery responded to obtain supposed essential facts, concerning Applicant's marketing activities. In fact, Opposer does not need additional information concerning Applicant's advertising and promotions and intended consumers and trade

channels to respond to Applicant's Motion for Summary Judgment. Applicant does not base its motion on facts concerning Applicant's trade channels, marketing, etc. Applicant's Motion for Summary Judgment, rather, seeks judgment based on the objective differences between the sight, sound and meaning of the marks as evidenced by objective third party factors such as dictionary definitions and definitions adopted by third parties. See Applicant's Motion for Summary Judgment, page 2, second to last paragraph. In fact, Applicant stresses that the Board can decide its Motion for Summary Judgment by simply considering the first Dupont factor similarity of marks. See Applicant's Motion for Summary Judgment, page 3, last paragraph. Thus, Applicant has conceded, for the purposes of Summary Judgment that the Board can consider trade channels, etc. in a light most favorable to Opposer. The particulars of Applicant's usages are simply not relevant. Se *CBS v. Morrow*, 708 F.2nd 1579, 218 USPQ 2nd 198 (Fed. Cir. 1983); *Cunningham v. Laser Golf*, 222 F. 3rd 943 (Fed. Cir. 2000). The issue is whether Applicant has a right to register its mark for the goods in its registration. The registration is accorded its broadest scope without regard to Applicant's particulars, *Id.*

Opposer has utterly failed to provide sufficient reasons why it should be allowed to further complete all of its paper discovery prior to responding to Applicant's motion for summary judgment. Granting Opposer's request would essentially gut one of the primary purposes of allowing a party to move for summary judgment.

Respectfully submitted,

James B. Conte
Barnes & Thornburg
One North Wacker Drive, Suite 4400
Chicago, Illinois 60606-2809
Attorneys for Applicant

CERTIFICATE OF MAILING

I hereby certify that the attached correspondence is being deposited with the United States Postal Service as first class mail in an envelope with sufficient postage addressed to:

BOX - TTAB
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Jeffrey H. Kaufman, Esq.
Amy C. Sullivan, Esq.
Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, Virginia 22314

on this 21st day of October, 2003.

Rose Ranegar

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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Mailed: September 12, 2003

Opposition No. 91156618

Yoshida Metal Industry Co., Ltd

v.

Global Decor, Inc.

Nancy L. Omelko, Interlocutory Attorney:

Applicant's consented motion filed July 25, 2003 and resubmitted on August 11, 2003 to extend time to file its answer to the notice of opposition is granted. Trademark Rule 2.127(a).

The answer and counterclaim filed by applicant on August 11, 2003 is noted. The counterclaim to cancel opposer's pleaded Registration No. 2,419,827 cannot be considered at this time because the proper fee has not been paid. See Trademark Rules 2.106(b)(2) and 2.111.

Applicant is allowed until **thirty days** from the mailing date of this order to perfect the counterclaim by submitting the proper fee, failing which the counterclaim will not be further considered herein.

Proceedings herein are otherwise suspended pending disposition of the motion for summary judgment. Any paper filed during the pendency of this motion, other than the fee

for the counterclaim, which is not relevant thereto will be given no consideration. See Trademark Rule 2.127(d).

Attorney Docket No.: 231555US-33 **TTAB**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

YOSHIDA METAL INDUSTRY CO., LTD.,	)	
	)	
Opposer,	)	
	)	Opposition No. 91/156,618
v.	)	Appln. Serial No.: 76/179,674
	)	Mark: GLOBAL DECOR
GLOBAL DECOR, INC.	)	
	)	
Applicant.	)	
	)	

OPPOSER'S FIRST SET OF INTERROGATORIES

Opposer, Yoshida Metal Industry Co., Ltd. ("Opposer"), serves the following interrogatories under Rule 33, Fed.R.Civ.P., and Trademark Rules 2.116(a) and 2.120(d)(1), to be answered separately and fully in writing under oath by an officer or agent of Applicant, Global Decor, Inc. ("Applicant"). Each separately numbered or lettered sub-part of each interrogatory requires a separate answer thereto. Furthermore, these interrogatories shall be deemed to be continuing to the fullest extent permitted by the Rules, and Applicant shall provide Opposer with any supplemental answers and additional information that are requested herein which shall become available to Applicant at a later date.

DEFINITIONS AND INSTRUCTIONS

The following interrogatories and Opposer's accompanying requests are subject to the definitions set forth below:

A. The term "document" shall be construed in its broadest permissible sense, and shall include any and all means of conveying, storing, or memorializing information, whether in paper or other tangible physical form, or in electronic form, in the possession, custody, or control of

Applicant. Each comment, or addition to, or deletion from, a document shall constitute a separate document.

B. If Applicant refuses to identify and/or produce any document(s) based upon a claim of confidentiality, privilege, or work product immunity, Applicant shall, in log form, (i) identify each document by its author, intended recipient(s), the date of the document, and its general subject matter, and (ii) set forth for each withheld document the particular basis for the refusal of production.

C. As used herein, the term "regarding" means relating or referring to, incorporating, comprising, touching upon, indicating, evidencing, affirming, denying, concerned with, relevant to, or likely to lead to admissible evidence concerning.

D. As used herein, the term "Opposer's Mark" shall refer to the registered GLOBAL trademark set forth in Paragraph 4 of the Notice of Opposition.

E. As used herein, the term "Applicant's Mark" shall mean the GLOBAL DECOR trademark of Application Serial No. 76/179,674.

F. As used herein, the phrase "Applicant's Products" shall refer to products actually and/or intended to be advertised, promoted, and/or sold in connection with the GLOBAL DECOR trademark which is the subject of Application Serial No. 76/179,674.

G. As used herein, the phrase "Opposers Products" shall refer to products advertised, promoted, and/or sold in connection with Opposer's GLOBAL trademark described in Paragraphs 3 and 4 of the Notice of Opposition.

INTERROGATORIES

INTERROGATORY NO. 1

State the address of each location at which Applicant maintains a place of business for the promotion, sale, and distribution of Applicant's Products promoted and/or sold under Applicant's

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OPPOSER'S FIRST REQUEST FOR
PRODUCTION OF DOCUMENTS AND THINGS

Opposer, Yoshida Metal Industry Co., Ltd. ("Opposer"), hereby requests, pursuant to Rule 34, Fed.R.Civ.P., and Trademark Rules 2.116(a) and 2.120(d)(2), that Applicant, Global Decor, Inc. ("Applicant"), produce the documents and things listed below for inspection and copying, and that said production be made accompanying Applicant's service of its responses to this Request upon Opposer at the offices of Oblon, Spivak, McClelland, Maier & Neustadt, P.C., 1940 Duke Street, Alexandria, Virginia 22314.

DEFINITIONS AND INSTRUCTIONS

A. The definitions and instructions contained in Opposer's First Set of Interrogatories (the "interrogatories") are incorporated herein by reference.

B. With respect to any document requested below for which a claim of privilege, work product or confidentiality is made, specify (in log form) the nature of the document, identify by name, address, title and business affiliation, the writer, the addressee and all recipients thereof, and set forth the general subject matter to which the document relates, and its date.