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

Lykos

Mailed: August 13, 2007

Opposition No. 91157248
Opposition No. 91157250
Cancellation No. 92043186

Top Tobacco, L.P.

v.

North Atlantic Operating Co., Inc.

(as consolidated)

Angela Lykos, Interlocutory Attorney

This case now comes up for consideration of plaintiff's motions (filed May 12, 2006) to compel and to extend the discovery and testimony periods in this case. The motion to compel is fully briefed.[1]

I. *Background*

On September 8, 2005, plaintiff filed a motion to compel defendant to provide further responses to certain interrogatories and document production requests contained in plaintiff's first set of interrogatories, and first and second set of requests for production of documents. On

[1] Plaintiff has submitted a reply brief which the Board has considered because it clarifies the issues herein. Consideration of a reply brief is discretionary on the part of the Board. *See* Trademark Rule 2.127(a).

November 14, 2005, the Board granted plaintiff's motion to compel in part and denied the motion in part. By that same order, the Board also imposed the Board's standardized protective order on the parties to govern the disclosure of confidential information, and reset the dates for the close of discovery and trial periods in these consolidated proceedings. Thereafter, on February 14, 2006, plaintiff filed a motion to extend discovery and trial dates which the Board granted as uncontested on March 16, 2006. By that order, discovery was reset to close May 16, 2006 and plaintiff's first testimony period was reset to close August 14, 2006. Plaintiff's motions which are the subject of this order then followed.

II. *Plaintiff's Motion to Extend Discovery and Testimony*

First, the Board will consider plaintiff's motion to extend the discovery and testimony periods in this case. The Board notes that defendant in its responsive brief has stated that it has no objections to plaintiff's motion to extend.

In view thereof, plaintiff's motion to extend is granted. *See* Trademark Rule 2.127(a).

III. *Plaintiff's Motion to Compel*

Next, the Board turns to plaintiff's motion to compel. As a threshold matter, we find that plaintiff has made a good-faith effort pursuant to Trademark Rule 2.120(e) to

resolve the present discovery dispute prior to seeking to Board intervention. Based on the evidence before us, plaintiff made a good-faith effort by correspondence dated February 27, 2006 and April 4, 2006 to resolve with defendant's counsel the issues presented herein and was unable to reach an agreement.

The Board now turns to the merits of plaintiff's motion to compel. The discovery requests at issue are as follows:

Interrogatory No. 9: This interrogatory requests that defendant "[i]dentify every trade show at which each product identified in response to Interrogatory No. 5 has been or will be advertised and/or promoted." Defendant initially objected to the request as "overly broad" but subsequently supplemented its response with a document listing only trade shows for the year 2005 and asserting that the document produced is "privileged." Thereafter, in communications with plaintiff, defendant asserted that the document was "confidential and proprietary." Plaintiff seeks clarification as to whether the document is privileged or confidential and whether defendant had additional information or documentation responsive to the request, and also request that defendant be ordered to either supplement its response or state that it has no further additional information or documents responsive to Interrogatory No. 9.

The Board agrees with plaintiff. Fed. R. Civ. P. 26(b)(5), made applicable to Board proceedings by Trademark Rule 2.116(a), provides that where a claim of privilege is invoked, a party must make the claim expressly and provide a description or privilege log of the documents, communications or things not disclosed in such a manner that will enable other parties to assess the applicability of the privilege or protection. Defendant must clarify whether the document is privileged or confidential, and whether its has further additional information or documents responsive to the interrogatory.

Interrogatory No. 21: This interrogatory requests that defendant "[d]escribe in detail each poll, survey, consumer study or market research effort initiated by or on behalf of Applicant relating in any way to the designation CLASSIC AMERICAN BLEND, or to the packaging, labeling or advertising of the products identified in response to Interrogatory No. 5, and identify all persons involved in or knowledgeable of such poll, survey, consumer study or market research, as well as documents relating thereto." Defendant initially responded with "none." Thereafter, in its supplemental response, defendant provided a document described as a survey conducted by defendant's counsel and claimed as "privileged."

Plaintiff asserts that the supplemental response was deficient because it failed to identify any persons "most involved in or knowledgeable of such poll, survey, consumer study or market research, as well as documents relating thereto" about the survey, but that thereafter in subsequent communications with plaintiff, defendant identified the person as Mr. Thomas Helms III and asserted that the document was "highly confidential." Defendant, however, failed to formally supplement its response with this new information or to provide any contact information for Mr. Helms. Plaintiff seeks clarification regarding whether the document is confidential and proprietary, and a supplemental response.

In its responsive brief, defendant asserts that insofar as Mr. Helms is an employee of defendant, no further contact information is required, and that if plaintiff wanted to take his deposition, plaintiff need only have him, or simply request the contact information directly from defendant without seeking Board intervention. Defendant further asserts that it has provided a complete response to the interrogatory.

In reply, plaintiff maintains that defendant's response is deficient because it fails to provide a sufficient amount of detail as requested by the interrogatory.

The Board agrees with plaintiff. The interrogatory explicitly requests the name of the person familiar with such surveys, and relates to information relevant to this proceeding.

Document Production Request No. 9: This document production request seeks "all documents that identify or otherwise relate to the person most knowledgeable concerning the date when applicant first used as a designation CLASSIC CANADIAN BLAND in (i) interstate commerce; (ii) interstate commerce; (iii foreign commerce (if applicable). Defendant initially responded by raising no objections and stating that responsive non-privileged documents would be produced. However, in its supplement response, defendant objected to the request as "overly broad, unduly burdensome and not calculated to lead to the discovery of admissible evidence" and that because priority of use was not an issue in this proceeding, the request is not relevant."

A party which fails to respond to a request for discovery during the time allowed therefor, and which is unable to show that its failure was the result of excusable neglect, may be found, upon motion to compel filed by the propounding party, to have forfeited its right to object to the discovery requests on its merits. *See No Fear Inc. v. Rule,* 54 USPQ2d 1551 (TTAB 2000) ("No Fear"). Objections going to the merits of the discovery requests include claims

that the information sought by the request is irrelevant, overly broad, unduly vague and ambiguous, burdensome and oppressive, or not likely to lead the to the discovery of the admissible evidence. *See Id.* In contrast, objections based on claims of privilege or confidentiality or attorney work product do not go to the merits of the request, but instead to a characteristic of the information sought. *See Id.*

Insofar as defendant failed to assert the objections going to the merits of plaintiff's request and to show excusable neglect, defendant is deemed to have waived its right to object to the document production request on its merits.

In view of the foregoing, plaintiff's motion to compel is granted. Defendant is ordered to provide supplemental responses consistent with the terms of this order as noted above to Interrogatory Nos. 9, 21, and Document Production Request No. 9 and a privilege log where appropriate twenty-five (25) days from the mailing date of this order. In the event defendant fails to comply, the Board may entertain from plaintiff a motion for sanctions, including judgment, pursuant to Trademark Rule 2.120(g).

The Board reminds the parties again of the good faith effort requirements set forth in Trademark Rule 2.120 and *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666 (TTAB

1986). That is, the parties must cooperate with each other so that the case may proceed in an orderly manner within reasonable time constraints.

The parties are also advised that if proper discoverable matter is withheld from the requesting party, then the responding party will be precluded from relying on such information and from adducing testimony with regard thereto during its testimony period. *See Shoe Factory Supplies Co. v. Thermal Engineering Company*, 207 USPQ 517 (TTAB 1980).

IV. *Trial Dates Reset*

In accordance with plaintiff's motion to extend, trial dates, including the close of discovery, are reset as follows:

THE PERIOD FOR DISCOVERY TO CLOSE:	11/20/07
30-day testimony period for party in position of plaintiff to close:	2/18/08
30-day testimony period for party in position of defendant to close:	4/18/08
15-day rebuttal testimony period for plaintiff to close:	6/2/08

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 Rules 2.128(a) and (b).

An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.