

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

EJW

Mailed: April 16, 2009

Opposition No. 91170091

ALPINA TOVARNA OBUTVE,
D.D. ZIRI

v.

TSA CORPORATE SERVICES, INC.

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

By consent of the parties, opposer's testimony period was last set to begin on October 17, 2008. See Trademark Rule 2.121(c), 37 C.F.R. § 2.121(c). This case now comes up for consideration of opposer's combined motion (filed October 15, 2008) to compel discovery responses, to test the sufficiency of certain of applicant's admissions, and to suspend this proceeding and reset trial dates upon resumption of the proceeding.¹ The motion is fully briefed.

To expedite the decision on the subject motion, the Board presumes the parties' familiarity with the issues presented and does not provide a complete recitation of the allegations and arguments of each party.

¹ This proceeding was suspended on November 1, 2008. In view thereof, opposer's motion to suspend is moot.

Opposer's Good Faith Effort

Trademark Rules 2.120(e)(1) and 2.120(h)(1) require, respectively, that a motion to compel and motion to determine the sufficiency of an answer or objection to an admission request be supported by a written statement from the moving party that such party or its attorney has made a good faith effort, by conference or correspondence, to resolve with the other party or its attorney the issues presented by the motion, and has been unable to reach an agreement. See discussion in TBMP §§ 523.02 and 524.02 (2d ed. rev. 2004).

Opposer's motion and supporting documents show that it sought to amicably resolve the discovery dispute by advising applicant in two letters of certain deficiencies in applicant's responses to opposer's discovery and by discussing those issues with applicant's counsel during at least two telephone conversations, including during a "meet and confer" discovery conference (see motion pp. 2-3 and Exh. C & D; reply brief, p. 2). In view thereof, the Board finds that opposer has complied with the good faith effort requirement set forth in Trademark Rules 2.120(e)(1) and 2.120(h)(1).

Motion to Compel

At the outset, the Board notes that opposer, in its reply brief, states that applicant has addressed certain of the deficiencies alleged in the combined motion to compel and

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motion to test the sufficiency of applicant's answers in its supplemental discovery responses provided with its brief in opposition to the combined motion. In view thereof, the Board will address only those issues remaining, as follows: requests for information/documents to which an objection regarding confidentiality and/or privilege was raised; the nature of information provided in regard to identified persons; interrogatory numbers 2(a), 2(c), 12, 15, 17 and 18; requests for production of documents numbers 5, 15-17, 18-21, 48, 51, 52, 53-54, 58-60; and requests for admission numbers 48-50 and 52.

Privilege Log

At page 2 of its responsive brief, applicant states that it is preparing a privilege log and that "it will produce to Alpina as soon as it is completed." As of the submission date of opposer's reply brief to the subject motion, applicant has not produced a privilege log. Applicant's responses to interrogatory nos.² 2(a), 2(c), 12, 15, 17 and

² Applicant's continued objections to Interrogatory Nos. 2, 12, 15, 17 and 18 refer to applicant's response to Interrogatory No. 1, which includes the following objection based on the grounds that the information sought is protected against disclosure by various privileges and seeks confidential information:

"TSA further objects to this Interrogatory on the grounds that it requests information that is protected against disclosure by the attorney-client, work-product or other applicable privileges and seeks proprietary or other confidential commercial information that is not yet subject to an acceptable protective order agreed to between the parties and entered by the TTAB."

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18, and responses to requests for production of documents nos. 5 and 48 maintain its previous objections based on attorney/client and work product privileges. Therefore, to the extent that applicant may have not fully responded to the above-referenced or any other interrogatories or requests for production of documents because of said privilege objections, applicant must provide a privilege log setting forth descriptions of the type of information and documents that will not be produced in connection said interrogatories or requests for production of documents and must detail which specific privilege allows for withholding of the described information or documents. See Fed. R. Civ. P. 26(b)(5); and Wright & Miller, 8 *Fed. Prac. & Pro. Civ.*2d § 2016.1 (2007) ("...if a party claims privilege it shall "make the claim expressly and shall describe the nature of the documents, communications, or things not produced or disclosed in a manner that, without revealing information itself privileged or protected, will enable other parties to assess the applicability of the privilege or protection"). Applicant need not provide privileged or protected information or produce privileged or protected documents within the meaning of Fed. R. Civ. P. 26(b)(5) as its right to claim privilege

In view thereof, Interrogatory Nos. 2(a), 2(c), 12, 15, 17 and 18, and requests for production of document nos. 5 and 48 are referenced in this section of the order.

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has not been waived. See, e.g., *American Standard, Inc. v. Pfizer*, 3 USPQ2d 1817 (Fed. Cir. 1987).

Objections in regard to Confidentiality

As noted by opposer, this proceeding is subject to the Board's standard protective order, which is binding on the parties.³ Thus, any objections to production of information or documents withheld and/or not identified, based on the confidential or proprietary nature of the information or documents sought, are now moot. Accordingly, applicant must provide substantive discovery responses where it objected based on the confidential nature of the information or materials sought. Specifically, applicant must provide discovery responses to interrogatory nos. 2(a) and 2(c), 15, 17 and 18 and to requests for production of documents nos. 5, 48 and 58-60, where applicant previously posed

³ On August 1, 2007, the USPTO published a Notice of Final Rulemaking at 72 Federal Register 42242 ("Final Rule"), which effectively made the Board's standard protective order applicable to this case on August 31, 2007.

Accordingly, the parties are referred, as appropriate, to TBMP §§ 412.03 (Signature of Protective Order), 412.04 (Filing Confidential Materials With Board), 412.05 (Handling of Confidential Materials by Board). In addition, the Final Rule includes a lengthy discussion of comments received in regard to the automatic application of the standard protective order in all Board cases, and the Office's responses to such comments.

The parties are advised that only confidential or trade secret information should be filed pursuant to the standard protective order. Neither such order, nor any alternative stipulated protective agreement may 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 issued registration, and all proceedings relating thereto, should otherwise be available for public inspection.

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confidentiality objections and it has not provided complete amended responses.

Interrogatories

Opposer requests that the Board issue an order requiring applicant to provide responses or supplemental responses to certain interrogatories. The following determinations are made regarding opposer's interrogatories in dispute.

The motion to compel is:

- granted in part with regard to Interrogatory No. 2(a), which seeks the period of time (from first sale to last sale) that the involved marks (or marks using the term "alpine") have been used with "each product and/or service." The wording "each product and/or service" is overly broad and burdensome. Applicant must identify its first use of the involved marks in regard to only the goods described in the involved applications. See TBMP §§ 414(5) and (11) (2d ed. rev. 2004). Applicant has provided the date 2004 for ski poles, snowshoes and air mattresses. Thus, applicant must identify the date of first use of the involved marks, if any, specifically with the goods not already identified, namely, snowboard boots, ski boot bags, snowboards, snowboard bindings, snowboard bags, and ski bags. If there is no use of the involved marks with the other goods described in the applications, applicant should state so explicitly.

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Furthermore, to the extent that applicant may be relying on its trademark registrations (*i.e.*, nos. 0946381, 2747925, 2748078 and 2882312) to establish priority in its ALPINE DESIGN marks,⁴ applicant must provide the first use date of those marks in connection with the goods recited in those registrations. See TBMP §§ 414(5) and 414(22) (2d ed. rev. 2004) and cases cited therein. See, *e.g.*, *Georgia-Pacific Corporation v. Great Plains Bag Co.*, 190 USPQ 193, 195-196 (TTAB 1976) (an interrogatory requesting date when petitioner's plants began producing goods bearing mark and seeking identity of all documents that petitioner will rely on to establish that any plant began such production prior to respondent's alleged first date of use seeks discoverable information relevant to issue of priority of use).

- Granted in part with regard to Interrogatory No. 2(c), which seeks applicant's sales, on an annual basis, in terms of dollar volume and units from the date of first use of the mark[s] through the present. Even though applicant has provided a document in response to No.

⁴ The Board notes applicant's response to opposer's interrogatory no. 1, which states, *inter alia*, that "its right to TSA's Marks vis-à-vis Opposer arise [*sic*] from its trademark registrations with the [USPTO] ... including Registration Numbers 0946,381; 2,747,925; 2,748,078; and 2,882,312, which are based on recognized trademark usage of the ALPLINE DESIGN Mark dating back to November 1969."

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2(c), viz. the table or spreadsheet of "Alpine Design" sales from 2005 through October 25, 2008 (opposition brief, Exh. G), such response is insufficient.

Applicant's supplemental response does not readily provide annual sales information, stated in round numbers, for applicant's particular goods involved in this proceeding, namely, "snowboard boots and ski boot bags" and "snowboards, snowboard bindings, snowboard bags, ski poles, ski bags, snowshoes, [and] air mattresses for recreational use," to which opposer is entitled. See TBMP *Id.* at § 414(18). Review of such a complex document is overly burdensome because more than one item on the list could fit within the goods listed in the involved identifications of goods. For instance, even though there is a category of "ski hardgoods" on page 17 of the table, it is unclear whether mens' "WINTERBO" "Alpine Design [Shelter II]" shown on page 1 of the table may also comprise a snowboard boot or a snowshoe. Similarly, on page 4 thereof, it is unclear whether any of the "STUFFBAG" or "DUFFLEBA" items could be used as ski boot bags. In view thereof, applicant must either (1) specify which goods on the table provided relate to the goods set forth in the involved applications and which numbers (*i.e.*, annual sales figures) it is relying on, or (2) applicant must specify

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the annual sales figures sold in connection with the involved marks, stated in round numbers, for applicant's particular goods involved in this proceeding.

- Denied with regard to Interrogatory No. 12, which seeks information on "each and every trademark and service mark registration you believe [sic] relevant to this Opposition" Notwithstanding the overly broad and burdensome nature of this request, in its response to Int. No. 12, applicant identified its own registrations, namely, U.S. Reg. Nos. 946381, 2747925, 2748078 and 2882312, explained why it believes those registrations are relevant, and provided various specifically identified documentation related thereto. Except as discussed *supra* in connection with applicant's privilege objection, no further response is required.
- Denied with regard to Interrogatory No. 15, which seeks "each and every actual, present use of a trademark consisting of or containing the term "alpine or "alpine" of which Applicant is aware and which Applicant contends is relevant ... ," including various specific information regarding those marks. Opposer also asks applicant to identify "each individual having knowledge of such use and whether that knowledge is personal knowledge or information and belief." To the extent that opposer requests applicant to identify "each and every" actual

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use of the alpine trademarks, such request is unduly burdensome. Opposer is reminded that it should not propound requests that are overbroad and unduly burdensome, e.g., those that request applicant to identify "all facts" or "all documents" on a particular subject matter. The parties have an obligation to make a good faith effort to seek only such discovery as is proper and relevant to the specific issues involved in the proceeding. See TBMP § 402.01 (2d ed. rev. 2004).

Moreover, the Board notes that opposer did not specifically request information regarding third-party use and the Board will not speculate as to the actual information sought by opposer, nor will applicant be required to respond to an overly broad request.

Further, as to opposer's request that applicant identify the persons having knowledge of such use, applicant does not need to identify in advance of trial potential witnesses it intends to call in connection with the requested information. See TBMP *Id.* at § 414(7). As to the question whether such knowledge is based on personal knowledge or information or belief, this information can be acquired during a deposition, if necessary.

Nonetheless, in regard to applicant's identification of knowledgeable persons (response, Exh. E), applicant must provide additional information, see *infra*. Accordingly,

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except to the extent discussed *supra* in connection with applicant's privilege and confidentiality objections, no further response is required.

- Denied as to Interrogatory Nos. 17 and 18, which request, respectively, that applicant state "each fact and all information (including, but not limited to, each witness with personal knowledge of same) which evidences or supports applicant's denials to the Notice of Opposition as stated in paragraphs 6, 8 and 10" of the answer, and applicant's affirmative defenses. Applicant does not need to identify in advance of trial the evidence it intends to present or potential witnesses it intends to call. TBMP *Id.* at § 414(7). Accordingly, except to the extent that applicant must respond to these interrogatories in regard to any information previously withheld on the basis of privilege or confidentiality, as discussed *supra*, applicant has adequately responded to these interrogatories.

Identification of Persons in Interrogatories

The Board notes applicant's response directing that communications to certain individuals identified in discovery should be sent to applicant's counsel. Applicant's response is inadequate inasmuch as specific addresses for the named persons were not provided. *Cf., Pioneer Kabushiki Kaisha DBA Pioneer Corporation V. Hitachi High Technologies America,*

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Inc., 74 USPQ2d 1672 (TTAB 2005) (each party must be able to serve a subpoena on any given adverse witness). Applicant must provide the name and address of persons identified in its discovery responses. Nonetheless, applicant is not required to provide the occupation and business position held of the persons identified, as requested by opposer.

Requests for Production of Documents

Opposer also requests that the Board issue an order requiring applicant to provide responses or supplemental responses to certain requests for production of documents. The following determinations are made regarding the requests in dispute.

The motion to compel is:

- Denied as to request for production no. 5 to the extent that it requests "all documents which list, show, explain or describe the products sold and/or services offered by Applicant under Applicant's Mark(s), and/or planned to be offered and/or sold under Applicant's Mark(s), including without limitation, each catalogue, brochure, or other printed materials or video/audio tapes." As discussed *supra*, opposer's request for "all" or "each" document is overly broad and burdensome. Applicant's supplementary response comprises the table of goods and the identification of other "bates"-numbered documents. Applicant's response is sufficient

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except to the extent that applicant must, as discussed *supra*, clarify which goods on the table provided comprise the goods identified in the involved applications. Nonetheless, applicant must respond to this request for production of documents by providing to opposer copies of any documents previously withheld on the basis of privilege or confidentiality, as discussed *supra*. See TBMP § 414(8) (2d ed. rev. 2004) ("a party's plans for expansion may be discoverable under protective order"). Applicant may provide a representative sampling of such documents, if necessary.⁵

- Denied as to requests for production nos. 15, 16 and 17, which request "all documents which evidence, support, show, and/or were reviewed and/or relied upon by Applicant in making the denials in Applicant's answer," in connection with paragraphs 6, 8 and 10 of the notice of opposition, respectively. Again, as discussed *supra*, opposer's requests for "all documents" is overly broad and burdensome. Additionally, the allegations set forth in paragraphs 6, 8 and 10 of the notice of opposition are so broad that the request for documents relative to

⁵ Applicant is reminded that production of "representative" documents must truly be a representative sampling, and not merely a self-serving selection of favorable documents. See, e.g., *The Procter & Gamble Company v. Keystone Automotive Warehouse, Inc.*, 191 USPQ 468 (TTAB 1976). An evasive or incomplete response is the equivalent of a failure to disclose. Fed. R. Civ. P. 26(g) and 37(a) (3).

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the allegations within those paragraphs is effectively overly broad and burdensome. See TBMP § 414(7) (2d ed. rev. 2004).

- Denied as to requests for production nos. 18, 19, 20 and 21, which request "all documents which evidence, support, show, and/or were reviewed and/or relied upon by Applicant in pleading" applicant's first, second, third and fourth affirmative defenses, respectively. Request for production no. 21 relates to a statement that is not an affirmative defense and is denied. As to the three affirmative defenses, as written, opposer's requests are not limited to those documents that would provide factual support for and may be relied upon by applicant; rather, the request seeks all documents reviewed, relevant or not; thus, is overly broad and unreasonable. Compare *Cardenas v. Dorel Juvenile Group, Inc.*, 231 F.R.D. 616 (D.C.Kan. 2005) (interrogatory allowed where the defendant sought particularized statements as to each element of the product design involved that plaintiffs contended to be defective, and an explanation how it was defective). Moreover, applicant is not required to identify its witnesses, other than expert witnesses. See TBMP § 414(7) (2d ed. rev. 2004).

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- Granted in part with regard to request for production no. 48. Opposer seeks "all marketing plans, marketing projections or other marketing, market share, or sales approach documents prepared by or for Applicant relating to its sale or proposed sale of products bearing, and/or in connection with which Applicant uses Applicant's Mark(s)." Applicant objected to the request on the grounds of privilege and confidentiality, but stated that "it will produce responsive documents currently available to it." To date, applicant has not provided any marketing plans to opposer. In view thereof, applicant must produce any marketing plans, which are in its possession, custody or control, that are related to the sale of the involved goods or goods related thereto, unless applicant states why producing all said documents would be burdensome, in which case, applicant may provide a representative sampling of marketing plans. See TBMP § 414(8) (2d ed. rev. 2004) ("a party's plans for expansion may be discoverable under protective order"). As discussed *supra*, applicant must also respond to this request for production of documents by providing to opposer copies of any documents previously withheld on the basis of privilege or confidentiality, which are in its possession, custody or control, that are responsive to the discovery requests discussed. If

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applicant does not have any marketing plan documents, it must state so explicitly.

- Granted in part as to request for production nos. 51 and 52. Opposer seeks "a complete copy of each version of any web site linked to a domain name registered to Applicant, including but not limited to the HTML code for same, from the creation of the web site through the present" and "a complete copy of each version of the web site linked to Applicant's Website, including but not limited to the HTML code for same, from creation of the web site through the present." At the outset, the scope of these requests is overly broad and burdensome. It is also unclear why opposer is requesting HTML code for the <sportsauthority.com> website. Nonetheless, applicant's response that it does not own the website located at www.sportsauthority.com, but "merely licenses the use of the sportauthorirty.com [sic] domain name to a third-party" and does not have the documents requests by opposer (opp. brief, pp. 5-6), is neither cooperative nor sufficient. Given applicant's admissions (supplemental responses to admission request nos. 49, 50 and 52), namely, that it has reviewed content, has authorized content and has exercised control over certain content at the <sportsauthority.com> website, applicant should be able to provide copies of all pages

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that it has reviewed, authorized content and/or over which it has exercised control. In view thereof, applicant must provide to opposer copies of web pages (or a representative sampling of said documents), which are in its possession, custody or control, from the <sportsauthority.com> website that it has reviewed, authorized content and/or over which it has exercised control since the website became active as said pages relate to the goods and marks involved in this proceeding.

- Denied as to request for production no. 53. In connection with each mark identified by applicant in response to interrogatory no. 15, opposer requests "all documents" (related to marks using the term "alpine" or "alpina") which demonstrate the dates of use, the goods/services sold in connection with each mark, the identity of the party so using the mark and "where (name and address) these goods/services can be found in the marketplace." Inasmuch as interrogatory no. 15 has been deemed to be overbroad and unduly burdensome, and applicant has nevertheless provided specifically identified documents in response to interrogatory no. 15, no further response is required.
- Denied as to request for production no. 54. Opposer has requested that applicant produce a copy of the

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certificates of registration for the registrations identified in response to interrogatory no. 12. Applicant identified in its response its four registrations, namely, U.S. Reg. Nos. 946381, 2747925, 2748078 and 2882312. Records regarding these registrations are publicly available. Applicant's response is sufficient.

- Granted in part as to request for production nos. 58-60, which essentially seek documents sufficient to show whether applicant's use of its ALPINE DESIGN marks has been continuous and the dates of first use of said marks in connection with the involved goods. To the extent that applicant may be relying on its trademark registrations (*i.e.*, nos. 0946381, 2747925, 2748078 and 2882312) to establish continuous use of ALPINE DESIGN marks, applicant must provide representative samples of invoices or labels which are in its possession, custody or control (or a declaration of a knowledgeable person) which evidences use of the involved mark(s) for each year since 1969. If applicant does not intend to rely on use of the relevant marks since 1969, applicant may provide documentation showing annual sales of the involved goods since 2003, when applicant acquired the oldest trademark registration upon which it intends to rely to establish priority. The Board has held that

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annual sales and advertising figures of recent years given in round numbers for specific goods bearing the involved mark(s) are proper matters for discovery since the information may well have a bearing upon the issues in an opposition or cancellation proceeding. *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147, 148-149 (TTAB 1985) (allowed to provide representative samples of invoices from each calendar quarter) (internal citations omitted). Applicant must also respond to these requests for production of documents by providing to opposer copies of any documents, which are in its possession, custody or control, previously withheld on the basis of confidentiality, as discussed *supra*. If applicant does not have any documents showing use for any specific year, applicant must state so explicitly.

Requests for Admission

Opposer also requests that the Board issue an order that deems admission request nos. 48-50 and 52 admitted or that requires applicant to provide supplemental responses to those admission requests. As discussed *supra* in connection with production request nos. 51 and 52, applicant has already provided supplementary responses to said admission requests, which the Board finds to be sufficient. No further response is required. Accordingly, opposer's motion to test the

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sufficiency of applicant's answers to the requests for admissions is denied.

Discovery Obligations

In addition to the discovery obligations and responsibilities discussed herein, both parties are reminded of their duty to thoroughly search their records for all information properly sought in discovery, and to provide such information to the requesting party. TBMP § 408.02 (2d ed. rev. 2004). A party that has responded to a request for discovery with a response is under a duty to supplement or correct the response to include information thereafter acquired or uncovered. *Id.* at § 408.03.

Proceeding Resumed; Dates Reset

Opposer's motion to compel is granted to the extent discussed herein. Applicant is allowed until **THIRTY DAYS** from the mailing date of this order in which to respond to or to supplement its responses to the interrogatories and requests for production of documents listed above where opposer's motion to compel is granted or granted in part, including providing substantive discovery responses where it had objected based on the confidential nature of the information or materials sought; and applicant is allowed **THIRTY DAYS** from the mailing date of this order in which to provide a proper privilege log, as detailed herein.

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This proceeding is resumed. Discovery closed October 15, 2006. Accordingly, only trial dates are reset as follows:

DISCOVERY PERIOD TO CLOSE:	CLOSED
Thirty-day testimony period for party in position of plaintiff to close:	July 20, 2009
Thirty-day testimony period for party in position of defendant to close:	September 18, 2009
Fifteen-day rebuttal testimony period to close:	November 2, 2009

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. See Trademark Rule 2.125, 37 C.F.R. § 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b), 37 C.F.R. §§ 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129, 37 C.F.R. § 2.129.



NEWS FROM THE TTAB:

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected

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rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>

http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>