

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
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Lykos

Mailed: February 5, 2009

Opposition No. 91170202

Russell G. Weiner

v.

JMBP, Inc.

Before Rogers, Cataldo, and Wellington, Administrative
Trademark Judges.

By the Board:

This case now comes before the Board for consideration of opposer's motion (filed September 9, 2008) for discovery sanctions pursuant Trademark Rule 2.120(g)(1), or in the alternative, motion to compel. The motion is fully briefed.

By way of relevant background, on June 9, 2006, opposer served his first set of interrogatories and document production requests. In response to opposer's first set of interrogatories, applicant objected to each interrogatory on the grounds that the information sought was "overbroad, unduly burdensome, oppressive" and outside the scope of discovery for an opposition proceeding. Applicant also interposed similar objections to opposer's first set of document production requests as well as objecting to several requests on the basis of attorney-client privilege. On

December 14, 2006, opposer moved to compel amended responses. Applicant then cross-moved for entry of a protective order pursuant to Trademark Rule 2.120(f) and Fed. R. Civ. P. 26(c) to limit opposer's discovery requests to information regarding applicant's prior actual use of the mark and intent-to-use application at issue in this opposition proceeding: ROCKSTAR for "beverage glassware, namely glasses and mugs, and beverage accessories namely swizzle sticks" in International Class 21.¹ Applicant further sought to bar discovery regarding the use of the mark ROCKSTAR, or any other marks used by applicant on or in connection with any other goods or services not at issue in this proceeding.

On April 1, 2008, the Board granted opposer's motion to compel, denied applicant's motion for protective order, and ordered applicant to provide amended responses consistent with the following principles:

A party need not provide discovery with respect to those of its marks and goods and/or services that are not involved in the proceeding and have no relevance thereto. See TBMP § 414(11) (2d ed. rev. 2004). However, this general rule is tempered by the principle that information that a party sells the same goods or services as the propounding party, even if under a different mark, is relevant to the issue of likelihood of confusion. See *TBC Corp. v. Grand Prix Ltd.*, 16 USPQ2d 1399, 1400 (TTAB 1990) (where goods of parties differ, determining whether parties market goods of same type is relevant to establishing relationship between the goods). Thus, to the

¹ Application Serial No. 78976392, filed June 7, 2004.

extent opposer's discovery requests seek information of this type, such information is relevant to opposer's Section 2(d) claim, and applicant's motion for protective order is therefore denied. For this same reason, applicant's objections are overruled.

On August 8, 2008, over three months after the due date, applicant served amended responses to three of opposer's interrogatories and twelve of opposer's document production requests. Applicant did not provide amended responses to the remaining nine interrogatories and twelve document production requests. Opposer has requested the entry of judgment in his favor as a discovery sanction, arguing that applicant has effectively stalled the proceeding by refusing to cooperate in the discovery process.

Applicant maintains that it is only obligated to provide discovery responses regarding current use of its ROCKSTAR mark in connection with "beverage glassware, namely glasses and mugs, and beverage accessories namely swizzle sticks," and that because it does not currently offer any of these products, it need not provide substantive responses. Applicant further contends that since according to opposer's supplemental responses to applicant's first set of interrogatories, opposer has licensed its ROCKSTAR marks in connection only with energy drinks and alcoholic beverages, insofar as applicant does not use its applied-for ROCKSTAR

mark in connection with energy drinks or alcoholic beverages, it has no further information to provide under the "same goods" principle articulated in *TBC Corp. v. Grand Prix Ltd.*, *supra*.

In reply, opposer maintains that applicant has misconstrued the Board's order.

Pursuant to Trademark Rule 2.120(g)(1), if a party fails to comply with a Board order relating to discovery, the Board may make any appropriate order, including any of the orders provided in Rule 37(b)(2) of the Federal Rules of Civil Procedure, except that the Board will not hold any person in contempt or award expenses to any party. The sanctions which may be entered by the Board include, *inter alia*, striking all or part of the pleadings of the disobedient party; refusing to allow the disobedient party to support or oppose designated claims or defenses; prohibiting the disobedient party from introducing designated matters in evidence; and entering judgment. Default judgment is a harsh remedy but may be justified where no less drastic remedy would be effective and there is a strong showing of willful evasion.

The Board finds that at this juncture in the proceeding, applicant's conduct does not rise to the level

of warranting the imposition of sanctions in the form of judgment.

Nonetheless, based on the record before us, it is clear that applicant's position is inconsistent with the instruction provided by the Board in our prior order. By taking this untenable position, applicant has engaged in conduct which appears to have been pursued solely with delay in mind. For this reason, applicant is warned that any further misconduct will likely lead to entry of judgment. While applicant is not obliged to produce documents not in its possession, it must to produce all relevant documents in its possession as explained by the Board in its previous order. Applicant is reminded that a proper response to a document production request requires either stating that there are responsive documents and they will be produced or withheld on a claim privilege, or stating that it has no responsive documents. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1556 (TTAB 2000), *citing* 8A Wright, Miller & Marcus, *Federal Practice and Procedure: Civil 2d* Section 2213 (2d ed. 1994). Applicant is further reminded that 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.

However, while the Board declines to impose the sanction of judgment at this time, in view of the delay caused by applicant's conduct, the Board finds it necessary to impose an alternate sanction on applicant. Applicant is hereby forbidden from serving any further discovery of its own in this case, in order to obviate the possibility of causing further delay, with the exception that it may take a single discovery deposition pursuant to Fed. R. Civ. P. 30(b)(6).

Further, and in accordance with the Board's April 1, 2008 order, applicant is hereby ordered to serve supplemental responses to opposer's first set of interrogatories and produce all documents responsive to opposer's first set of document production requests, in full and without objections, **thirty (30) days** from the mailing date of this order, failing which opposer may move for sanctions in the form of judgment, pursuant to Trademark Rule 2.120(g). In addition, with its responses, applicant is also ordered to produce a stipulation that any documents it has, or may yet produce, are genuine and opposer may, at trial, introduce into the record by notice of reliance any documents produced by applicant.

Proceedings herein are resumed and trial dates, including the close of discovery, are reset as follows:

THE PERIOD FOR DISCOVERY TO CLOSE:	3/4/09
30-day testimony period for party in position of plaintiff to close:	6/2/09
30-day testimony period for party in position of defendant to close:	8/1/09
15-day rebuttal testimony period for plaintiff to close:	9/15/09

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.

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 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>