

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

Mailed: December 4, 2008

Opposition No. 91173385

MARKS AND SPENCER, P.L.C.

v.

Wilkinson Warburton, Inc.

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

As set forth in the Board's order mailed June 13, 2007, discovery was reset to close on September 1, 2007 and opposer's testimony period was set to begin on November 1, 2007. See Trademark Rule 2.121(c), 37 C.F.R. § 2.121(c). This case now comes up for consideration of opposer's motion (filed August 28, 2007) to compel discovery responses from applicant.¹ Specifically, opposer seeks responses to its first set of interrogatories and first set of requests for production of documents and things, both served on applicant on November 8, 2006. The motion is fully briefed.

To expedite the decision on the subject motion, the Board presumes the parties' familiarity with the issues presented

¹ The Board's consideration of the subject motion was twice deferred after the withdrawal of applicant's counsel on September 4, 2007 and again on May 29, 2008. The proceeding has been suspended since September 27, 2007. Applicant notified the Board on July 2, 2008 that it is representing itself.

and does not provide a complete recitation of the allegations and arguments of each party.

Opposer's Good Faith Effort

Trademark Rule 2.120(e)(1), 37 C.F.R. § 2.120(e)(1), requires that a motion to compel 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 § 532.02 (2d ed. rev. 2004).²

Opposer's motion and supporting documents show that it sought to amicably resolve the discovery dispute by advising applicant in two letters of the deficiencies in its responses to opposer's discovery and by discussing those issues with applicant's counsel during two telephone conversations (see motion, Exh. E & F; and declaration of Thomas H. Curtin, ¶20). In view thereof, the Board finds that opposer has complied with the good faith effort requirement set forth in Trademark Rule 2.120(e)(1).

² Now that applicant has chosen to represent itself in this proceeding, it is applicant's responsibility to become familiar with, and comply with, the applicable Federal Rules of Civil Procedure and Trademark Rules of Practice. As a resource, the Board includes a link on its website to an unofficial listing of the Trademark Rules. The Board also has its manual of procedure, the TBMP, available on its website, the address for which was provided to the parties in the order instituting this proceeding.

Motion to Compel

At the outset, the Board notes that applicant's responses to opposer's discovery requests were served late on opposer, *i.e.*, twenty-four days after the second extended deadline to respond that was agreed to by the parties (see declaration of Thomas H. Curtin, ¶7). A party which fails to respond to discovery during the time allowed therefor, which has not shown that its failure was the result of excusable neglect, may be found to have forfeited its right to object to the interrogatories and requests for production of documents on their merits. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000); *Envirotech Corp. v. Compagnie De Lampes*, 219 USPQ 448, 449 (TTAB 1979). *See also* TBMP §§ 403.03, 405.04(a) and 406.04(a) (2d ed. rev. 2004).

Applicant has neither argued nor demonstrated excusable neglect for its initial failure to timely respond to opposer's discovery requests. Accordingly, applicant has forfeited its right to object to opposer's interrogatories and document requests on their merits. *See Pioneer Investment Services Company v. Brunswick Associates Limited Partnership*, 407 U.S. 380 (1993), and *Pumpkin, Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997), in regard to the excusable neglect standard. *See also, No Fear Inc., supra*, in regard to the forfeiture of the right to object to discovery requests on their merits. Nor has applicant explained why its service of amended

Opposition No. 91173385

responses to opposer's discovery requests were not served on opposer until the filing date of applicant's brief in response to the subject motion (response, Exh. A and B).³ In view of thereof, except with regard to privileged information or documents, *see discussion infra*, applicant must serve amended responses to opposer's discovery requests as put, *i.e.*, without objection.

Opposer's Interrogatories

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

Opposer's motion to compel is:

- granted in part with regard to Interrogatory Nos. 2, 6, 10, 12, 13, and 15. In view of the passage of time since the service of applicant's amended responses to opposer's discovery, applicant must clarify whether the current business address⁴ of Darshan Chhabra, Abha Chhabra, Amit

³ Applicant is reminded of its *continuing duty* to thoroughly search its records for all information properly sought in discovery, and to provide such information to the requesting party. TBMP § 408.02 (2d ed. rev. 2004). Further, a party that has responded to a request for discovery remains under a *continuing duty* to supplement or correct the response to include information thereafter acquired or uncovered. *Id.* at § 408.03.

⁴ The Board notes applicant's original response directing that communications to individuals identified in discovery should be sent to applicant's counsel. Even if the law firm of Malloy & Malloy, P.A. and its attorneys were still applicant's counsel, applicant's response was inadequate inasmuch as specific addresses for the named persons were not provided. *Cf., Pioneer*

Opposition No. 91173385

Chhabra, and Ileana Zays remains 5603 N.W. 159 Street, Miami Lakes, FL 33014 (as set forth in its amended response to Interrogatory No. 1). Applicant must provide any change in business address for said persons and the last known addresses of Gloria Gonzalez and Yvonne Gonzalez.

- denied with regard to Interrogatory No. 9. Applicant responded that it has not decided on a date of first use for clothing other than "golf shirts, dress shirts, jackets, and fleece tops," which were referenced in applicant's response to Interrogatory No. 4.
- granted with regard to Interrogatory No. 16. Information concerning a defendant's actual knowledge of plaintiff's use of the plaintiff's involved mark, and when and under what circumstances defendant acquired such knowledge, is discoverable. See TBMP § 414(19) (2d ed. rev. 2004). Applicant's response "when Opposer opposed Applicant's application," is not sufficiently specific. Applicant must specify how and when (including the person(s) involved) it acquired knowledge of opposer's use of opposer's mark *anywhere*. See *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120 (TTAB 1974) (applicant

Kabushiki Kaisha DBA Pioneer Corporation V. Hitachi High Technologies America, Inc., 74 USPQ2d 1672 (TTAB 2005) (each party must be able to serve a subpoena on any given adverse witness).

Opposition No. 91173385

required to go through its files to determine when it acquired actual knowledge of opposer's marks). Applicant may not limit the scope of its response, e.g., as to applicant's knowledge of opposer's alleged accrued rights in the United States or under the Lanham Act, as previously submitted.

- denied with regard to Interrogatory No. 23. Applicant has identified Darshan Chhabra as the person who assisted in preparing responses to all interrogatories for which a response was provided.
- granted with regard to Interrogatory Nos. 3, 8, 14, and 18. As noted by opposer in its reply brief, this proceeding is now subject to the Board's standard protective order, which is binding on the parties.⁵ Thus, any objections to production of information or documents

⁵ 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.

Opposition No. 91173385

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. 3, 8, 14, and 18 where it previously posed objections and it has not provided complete amended responses.

- granted with regard to Interrogatory Nos. 3, 14, 18, and 24. Applicant's amended responses to these interrogatories maintain its previous objections based on attorney/client and work product privileges. Therefore, as to Interrogatory Nos. 3, 14, 18 and 24,⁶ to the extent that applicant may have not fully responded to said interrogatories 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 and must detail which specific privilege allows for withholding of the described information or

⁶ Opposer also requested a proper response in regard to Interrogatory No. 16; however, applicant has not repeated its objection thereto based on privilege, so the Board has addressed applicant's response to No. 16 otherwise, see *supra*.

Opposition No. 91173385

documents.⁷ 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 has not been waived. See, e.g., *American Standard, Inc. v. Pfizer*, 3 USPQ2d 1817 (Fed. Cir. 1987).

⁷ Unlike Int. Nos. 3, 14 and 18, Int. No. 24 requests that applicant identify all documents relating to the subject matter of the interrogatories and [documents] used or referred to in the preparation of applicant's responses. In its amended response to Int. No. 24, applicant identifies "a trademark search conducted for Applicant's mark and documents demonstrating use of Applicant's mark." Further, the Board notes that in its amended response to Prod. Request No. 1, which requests "all documents and things referenced or identified in Applicant's response to Opposer's First Set of Interrogatories," applicant states that it will produce representative documents demonstrating use of applicant's mark and will also provide opposer with the results of the initial Federal and State trademark search directed to the involved mark. Thus, to the extent that applicant has only identified and agreed to provide opposer with the named documents and has refrained from identifying others based on alleged privilege, applicant is now required to identify such documents in the privilege log discussed herein.

Opposition No. 91173385

Opposer's Requests for Production of Documents and Things

Opposer also requests that the Board require applicant to provide responses to certain requests for production of documents and things. The following summary determinations are made regarding opposer's requests. Opposer's motion to compel is:

- granted with respect to Request Nos. 2, 3, 4, 6, 7, 8, and 9. Applicant must provide copies of all documents responsive to said document requests, including those documents to which it had previously objected on the basis of confidentiality and those documents that applicant states in its amended responses that it will provide to opposer or make available to opposer for copying and/or inspection; and, for the reasons discussed *supra*, for any documents responsive to the document requests but withheld because of a claim of privilege, applicant must provide a privilege log that sets forth descriptions of such documents and an explanation for each description of which specific privilege is applicable thereto. Further, in respect to Request No. 3, applicant must state unequivocally whether any advertising invoices exist.
- granted in part with respect to Request No. 5. Inasmuch as applicant states that "no documents related to the service mark applications exist in Applicant's

Opposition No. 91173385

possession, custody, or control," no further response is required. However, as discussed *supra*, to the extent that applicant objects to Request No. 5 on the grounds of privilege and has not provided a complete response to said request, applicant must set forth in the privilege log required herein the type of documents relevant to Request No. 5, if any, that will not be produced and which specific privilege is applicable thereto.

The Board also notes applicant's amended response to Document Request No. 1, in which applicant states that it will provide opposer with representative documents demonstrating use of applicant's mark [responsive to Int. No. 4] and the results of the initial Federal and State trademark search directed to the involved mark [responsive to Int. No. 14]. Inasmuch as applicant has not yet provided any such documents, applicant must actually produce the offered documents according to the schedule set forth herein.

Accordingly, in view of the foregoing, applicant is allowed until **FORTY DAYS** from the mailing date of this order in which to serve amended discovery responses to all of opposer's discovery requests, without objections based on the merits of the discovery requests; and such amended responses must not only be devoid of such objections but must provide the additional information or documents ordered as discussed herein where opposer's motion to compel is

Opposition No. 91173385

granted or granted in part. More specifically, in regard to responsive documents, applicant is allowed until **FORTY DAYS** from the mailing date of this order to identify and copy all documents and materials responsive to opposer's document requests and forward them to opposer; applicant is allowed until **FORTY DAYS** from the mailing date of this order to serve any responses to discovery requests that are not privileged, but which may have been withheld because a protective agreement had not yet been entered by the Board; and applicant is allowed until **FORTY DAYS** from the mailing date of this order in which to provide amended discovery responses in lieu of those wherein it objected on the basis that the interrogatories and document requests seek information that is protected from disclosure by providing a privilege log setting forth the type of information and/or documents that will not be produced and which specific privilege is applicable thereto.

Should applicant not comply with this order, opposer may seek appropriate sanctions. See Trademark Rule 2.120(g), 37 C.F.R. § 2.120(g), and TBMP §§ 411.04 and 527.01 (2d ed. rev. 2004).

Supplementation of responses

Applicant is again reminded of its continuing duty to thoroughly search its records for all information properly sought in discovery, and to provide such information to the

Opposition No. 91173385

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 *continuing* duty to supplement or correct the response to include information thereafter acquired or uncovered. *Id.* at § 408.03.

Applicant is also reminded that, if a party provides an incomplete response to a discovery request, that party, upon a timely raised objection by an adverse party, may not thereafter rely at trial on information from its records which was properly sought in the discovery request, but which was not included in the response thereto, unless the response is supplemented in a timely fashion pursuant to Fed. R. Civ. P. 26(e). *See Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718 (TTAB 1987); and TBMP §408.02. Applicant is further reminded that, should it be later found to have willfully withheld discovery responses, introduction of such evidence withheld may be precluded upon a motion to strike.

Summary; Proceeding Resumed; Dates Reset

Opposer's motion to compel is granted to the extent discussed herein.

This proceeding is resumed. Trial dates are reset as shown below:⁸

⁸ While opposer, at the end of counsel's declaration offered in support of the motion to compel requested an extension of discovery for opposer, the request was not included in the motion to compel or referenced in the title to either document. Accordingly, the request was buried in the declaration and may

Opposition No. 91173385

DISCOVERY PERIOD TO CLOSE:	CLOSED
Thirty-day testimony period for party in position of plaintiff to close:	April 16, 2009
Thirty-day testimony period for party in position of defendant to close:	June 15, 2009
Fifteen-day rebuttal testimony period to close:	July 30, 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 FORTY 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 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

have been overlooked by applicant. Accordingly, although applicant did not object to the request, it is denied.

Opposition No. 91173385

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>