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

Lykos

Mailed: August 26, 2008

Opposition No. 91177345

Bridge Bank, N.A.

v.

East West Bank

Angela Lykos, Interlocutory Attorney

On May 23, 2006, applicant applied to register the mark BUSINESS BRIDGE for "banking; cash management" in International Class 36.[1] Opposer has opposed registration on the grounds that applicant's applied-for mark is descriptive under Section 2(e)(1) of the Lanham Act, or alternatively generic. In the notice of opposition, opposer alleges that it offers "commercial banking and cash management services to business entities and could describe such services using the phrase BUSINESS BRIDGE." Opposer did not plead use or ownership of any registered or unregistered marks in its pleading. In its answer, applicant denied the salient allegations and asserted the

[1] Application Serial No. 78890654, alleging May 15, 1997 as the date of first use anywhere and in commerce, with a disclaimer of the term BUSINESS.

affirmative defenses of failure to state a claim and lack of standing.

This case now comes up for consideration of applicant's motion to compel filed February 13, 2008. The motion is fully briefed.

Applicant has moved to compel opposer to provide full and complete responses to Interrogatory Nos. 1-16, 18, 20, 22, 24, and 26-30 of applicant's first set of interrogatories and Request Nos. 3-23, 25, 26, 28, and 29 of applicant's first set of document production requests. In its motion, applicant notes that opposer has objected to many of the aforementioned discovery requests on the grounds of attorney-client and/or work product privilege, but has failed to produce a privilege log. For that reason, applicant also seeks an order compelling opposer to produce a privilege log.

The Board will first consider the issue of whether applicant has made a good faith effort to resolve this dispute prior to seeking Board intervention. Trademark Rule 2.120(e) provides that a motion to compel must be supported by a written statement from the moving party that such party or 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. Counsel for

applicant attempted to resolve the discovery dispute between the parties by communicating in writing its concerns regarding opposer's discovery responses prior to seeking Board intervention and by conferring over the telephone. The Board finds that this is sufficient to satisfy applicant's obligation under Trademark 2.120(e).

Next, the Board notes that applicant contends that opposer failed to verify its responses to applicant's first set of interrogatories. Fed. R. Civ. P. 33(a) requires that interrogatories be answered by the party under oath. Responses to interrogatories must be signed by the person making them, and objections to interrogatories must be signed by the attorney making them. Fed. R. Civ. P. 33(b)(2). Opposer therefore must submit

The Board now turns to the merits of applicant's motion to compel. The discovery requests at issue may be categorized as follows:

Interrogatory Nos. 1-5, 7-15, 26-28 and Document Production Request Nos. 3-9, 12-17, 25-26, and 28: Opposer has objected to these discovery requests on the ground that each "concerns [opposer's] use of the BRIDGE BANK MARKS [which] are not involved in this Opposition and have no relevance to the issue of descriptiveness of [applicant's] BUSINESS BRIDGE mark." A party need not provide discovery with respect to those of its marks that are not involved in

the proceeding and have no relevance thereto. TBMP Section 414(11) (2d ed. rev. 2004). Opposer's BRIDGE BANK mark is not at issue in this proceeding. Opposer did not plead ownership or use of its BRIDGE BANK mark in its notice of opposition, nor did applicant raise in its answer any affirmative defenses relating to opposer's BRIDGE BANK mark. Hence, requests pertaining to opposer's mark or pending application for the mark BRIDGE BANK are not relevant to this case. Thus, opposer's objections on relevancy grounds are sustained.

Interrogatory No. 6: Interrogatory No. 6 seeks information concerning all communications between opposer and applicant regarding applicant's services. Opposer has objected on relevancy grounds. The objection is sustained. The Board finds that the information sought is not relevant to either opposer's asserted claims or applicant's affirmative defenses.

Interrogatories Nos. 16, 18, 20, 22, 24, 29, and 30: These discovery requests involve the duty to supplement pursuant to Fed. R. Civ. P. 26(e)(2). Under this rule, a party has an obligation to supplement or correct discovery responses. Opposer has agreed to provide supplemental responses but toward the end of the discovery period on the grounds that many of the above interrogatories constitute contention interrogatories. The Board has the authority to

order a party to provide supplemental responses in a timely manner, and will exercise its discretion to do so in this case. See TBMP Section 408.03 (2d ed. rev. 2004).

Document Production Requests Nos. 10-11: Request No. 10 requests all documents and things in opposer's possession referring to applicant's services. Request No. 11 request all documents and things in opposer's possession that relate or refer to applicant's suppliers or customers with respect to applicant's services. Opposer objects to these requests as vague, ambiguous, overbroad, and irrelevant.

Insofar as applicant's services are at issue in this proceeding, opposer's objection regarding Document Production Request No. 10 is overruled. However, as to Document Production Request No. 11, while the classes of customers for a party's involved services are discoverable, the names of customers constitute confidential information and are generally not discoverable, even under protective order. See TBMP Section 414(3) (2d ed. rev. 2004). By analogy, this would hold true with regard to suppliers. As such, opposer's objection is sustained.

Document Production Requests Nos. 18-22, and 29: Opposer has objected to these requests on the grounds that the requests are vague, ambiguous, and unduly burdensome. The Board disagrees and therefore overrules opposer's objections.

Opposer has also objected on the basis that the documents sought are protected by the attorney-client privilege and/or the attorney work product doctrine. 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. As such, opposer is ordered to provide a privilege log in conformance with Fed. R. Civ. P. 26(b)(5) where appropriate.

Document Production Requests No. 23: Opposer has objected to these requests on the grounds that the requests are vague, ambiguous, and unduly burdensome. The Board does not find the term "public recognition" in the request to be vague or ambiguous. The Board therefore overrules opposer's objections, and finds that applicant's request is narrowly tailored to a specific category of documents. Opposer is required to identify with particularity the document[s] which are directly responsive.

In summary, applicant's motion to compel is granted in part and denied in part. Opposer is hereby ordered to serve supplemental responses to Interrogatory Nos. 16, 18, 20, 22, 24, 29 and 30 of applicant's first set of interrogatories,

and supplemental responses to Document Production Request Nos. 10, 18-22, 23, and 29 of applicant's first set of document production requests, and to identify the particular privilege and to provide a full and complete privilege log with respect to those discovery requests for which information and documents are being withheld under a claim of privilege, **TWENTY-FIVE (25) days** from the mailing date of this order. In the event opposer fails to comply with the Board's order, applicant may move for sanctions, including the entry of judgment, pursuant to Trademark Rule 2.120(g).

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

THE PERIOD FOR DISCOVERY TO CLOSE:	10/15/08
30-day testimony period for party in position of plaintiff to close:	1/13/09
30-day testimony period for party in position of defendant to close:	3/14/09
15-day rebuttal testimony period for plaintiff to close:	4/28/09

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.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

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