

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

Baxley

Mailed: February 2, 2009

Opposition No. 91178682

Franciscan Vineyards, Inc.

v.

Domaines Pinnacle, Inc.

Andrew P. Baxley, Interlocutory Attorney:

On January 13, 2009, the Board issued an order wherein it denied the motion to strike that opposer filed on October 24, 2008 and resumed proceedings. On January 20, 2009, opposer filed a request for reconsideration of the January 13, 2009 order, followed on January 22, 2009 by a motion to compel responses without objection to all of the discovery requests that opposer served on September 24, 2008. Although applicant's time to respond to the motion to compel has not expired, the Board, in exercising its inherent authority to regulate the conduct of its proceedings, will consider the motion to compel at this time.

As a result of a November 15, 2008 order, in which proceedings were suspended pending the Board's decision on the motion to strike, the parties' discovery obligations were tolled between the issuance of that order and the January 13, 2009

order.¹ By filing the motion to compel only nine days after the Board resumed proceedings in the January 13, 2009 order, opposer failed to allow applicant a meaningful opportunity to supplement its discovery following the resumption of proceedings herein prior to filing the motion to compel. Accordingly, the Board finds that opposer did not make a good faith effort to resolve the parties' discovery dispute prior to seeking Board intervention. See Trademark Rules 2.120(e)(1) and (h)(1).

Moreover, the record indicates that applicant served timely responses to opposer's discovery requests on November 28, 2008.² See Trademark Rules 2.119(b) and (c) and 2.120(a)(3).

Nonetheless, opposer asks that applicant be compelled to serve responses without objection to all of the discovery requests that opposer served on September 24, 2008 because applicant

¹ Except when proceedings are suspended pending the Board's decision on a motion to compel, a suspension order effectively tolls discovery obligations. Compare Trademark Rules 2.117 and 2.120(e)(2). Although the parties are free to agree continue supplementing their discovery responses on an informal basis while a case is suspended, the record indicates that the parties had no such agreement in this case.

² Opposer served its first sets of interrogatories, document requests and requests for admission by e-mail and first class mail on September 24, 2008. Because the record is not clear as to whether service by e-mail was merely as a courtesy or was mutually agreed upon by the parties as a form of service, the Board will treat applicant's discovery responses as having been initially due by October 29, 2008. See Trademark Rules 2.119(b) and (c) and 2.120(a)(3). During a discovery conference, the parties agreed to a thirty-day extension which allowed applicant until November 28, 2008 to serve discovery responses. That deadline, however, was made moot by the November 15, 2008 suspension order.

allegedly failed to serve supplemental responses to three requests for admission and failed to produce responsive documents in a timely manner.

In support of its motion, opposer relies upon *Envirotech Corp. v. Compagnie Des Lampes*, 219 USPQ 448, 449 (TTAB 1979); *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 953 (TTAB 1979); and *Crane Co. v. Shimano Industrial Co.*, 184 USPQ 691, 691 (TTAB 1975). These cases are distinguished from the circumstances herein because, in them, the Board compelled responses without objection because no timely discovery responses had been served. In this case, opposer does not assert that applicant's initial discovery responses were untimely. Rather, opposer contends that applicant failed to supplement those responses in a timely manner. The Board generally does not require a party to serve responses without objection to discovery requests when a party has served timely initial responses to discovery requests.³

Contrary to opposer's assertion, the Trademark Rules of Practice do not set a specific time within which a party must supplement its discovery responses. Rather, a party's duty to supplement its discovery responses is ongoing. See Fed. R. Civ.

³ Rather, if a party believes that certain responses to its discovery requests are insufficient, its remedy is to file a motion to compel amended responses to those requests. See Trademark Rule 2.120(e); TBMP Section 523 (2d ed. rev. 2004).

P. 26(e); TBMP Section 408.03 (2d ed. rev. 2004). Such supplementation shall be "seasonabl[e]." Fed. R. Civ. P. 26(e)(2). Because applicant served timely initial responses to the discovery requests at issue, the relief requested by opposer in the motion to compel is inappropriate in this case.

Further, opposer contends in the motion to compel that certain of applicant's responses to requests for admission are insufficient. However, the motion to compel procedure is not available with regard to requests for admission. See TBMP Section 523.01 (2d ed. rev. 2004). If a party believes that responses to its requests for admission are insufficient, that party's remedy is to file a motion to test the sufficiency of responses to requests for admission. See Trademark Rule 2.120(h); TBMP Section 524 (2d ed. rev. 2004).

In addition, opposer contends that applicant's responses to document requests are unacceptable because applicant has merely stated that it will produce documents responsive to each request. In responding to document requests, a party need only state, with respect to each item or category of documents or things requested to be produced, whether or not responsive documents exist and, if so, that inspection and related activities will be permitted as requested, unless the request is objected to, in which case the reasons for objection must be

stated.⁴ See Fed. R. Civ. P. 34(b); TBMP Section 406.04(b) (2d ed. rev. 2004). Although parties often forward responsive documents concurrently with responses to document requests, responding parties frequently do not, and so forwarding is not required. Accordingly, applicant's responses to opposer's responses to opposer's document requests are acceptable.

Based on the foregoing, the motion to compel is denied.

Proceedings herein are suspended pending disposition of opposer's request for reconsideration of the Board's January 13, 2009 order. See Trademark Rule 2.117(c). The parties should not file any paper which is not germane to the request for reconsideration.

⁴ Documents shall be produced as they are kept in the ordinary course of business or shall be organized and labeled to correspond with the individual requests. See Fed. R. Civ. P. 34(b)(i); TBMP Section 406.04(b) (2d ed. rev. 2004).