

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

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Mailed: February 4, 2009

Opposition No. 91180212

SCHERING CORPORATION

v.

IDEA AG

Jennifer Krisp, Interlocutory Attorney:

This proceeding is before the Board for consideration of the following motions: opposer's motion (filed September 26, 2008) to reschedule trial dates; opposer's motion (filed September 29, 2008) to compel discovery and to test the sufficiency of applicant's responses to opposer's first request for admissions; applicant's motion (filed October 14, 2008) for modification of the Board's standard protective order; opposer's motion (filed October 17, 2008) to strike applicant's brief in opposition to opposer's motion to compel discovery and test the sufficiency of responses; applicant's counter-motion (filed October 21, 2008) to strike opposer's motions to compel and to test the sufficiency of responses; and applicant's motion (filed December 3, 2008) for judgment and dismissal for failure to

prosecute under Trademark Rule 2.132(a). The motions are fully briefed.

Although the Board does not repeat the parties' complete arguments on each of the outstanding contested motions, the Board has carefully reviewed the motions and the parties' respective arguments pertaining thereto.

Applicant's motion for modification of the Board's standard protective order

We first address the parties' dispute with regard to the applicable protective order. Applicant views the Board's standard protective order as inadequate for this proceeding in certain respects. Applicant asserts, *inter alia*, that the order poses risks inasmuch as it does not impose post-proceeding confidentiality obligations, and inasmuch as the wording is unclear regarding the duties of the parties with respect to confidential information. While certain changes proposed by applicant to the standard protective order appear to be acceptable to opposer, opposer's counter-offer includes a "Court Jurisdiction; Venue" section designating the law of the State of New Jersey, and U.S. District Court for the District of New Jersey, as the applicable law and venue for disputes between the parties arising from any breach of the protective order, a section with which applicant takes issue.

Applicant requests a Board order, pursuant to TBMP 412.02(a) entering the revised protective order which applicant's counsel provided on August 8, 2008 and which appears as Exhibit 8 to opposer's September 29, 2008 motion to compel. Opposer asserts that the Board has no authority to modify the standard protective order in response to a contested motion or over the objection of one of the parties.

By operation of Trademark Rule 2.116(g), the Board's standard protective order is currently applicable to this proceeding, and was applicable as of August 31, 2007. Parties must utilize its provisions to protect confidential information, and Trademark Rule 2.120(g)(1) provides for sanctions, including those provided in Fed. R. Civ. P. 37(b)(2), if a party fails to comply with a protective order. The standard protective order may be modified by stipulation of the parties, subject to Board approval, or upon motion by a party. Trademark Rule 2.116(g).

It appears that the parties have not substantively agreed on any one of the possible sets of modifications to the terms of the standard protective order, and the record suggests that the parties have not had a meeting of the minds with respect to the reasons underlying their dispute(s). Inasmuch as the Board will not impose on the parties a modified protective order to which they have not achieved agreement, the parties are encouraged to confer and to seek actual agreement with respect to the version

of protective order that will govern this proceeding. In view thereof, applicant's motion for modification of the Board's standard protective order is denied without prejudice.¹

Opposer's motion to compel discovery and to test the sufficiency of applicant's responses to opposer's first request for admissions; Opposer's motion to strike applicant's response to opposer's motion to compel; Applicant's counter-motion to strike opposer's motion to compel

In its motion to compel and to test the sufficiency of applicant's responses, opposer seeks full and complete responses to its first set of Interrogatories Nos. 4, 8-10, 12-14, 19, 20 and 22, and to Production Requests 1-37, and seeks to test the sufficiency of applicant's responses to Requests for Admission Nos. 1-11, 16-18, and 20-23.

As movant, opposer has the burden of demonstrating that it has made a good faith effort, by conference or correspondence, to resolve with applicant's counsel the issues presented in the motion. Trademark Rules 2.120(e)(1) and 2.120(h)(1); *see also* TBMP §§ 523.02 and 524.02 (2d ed. rev. 2004).

¹ The Board's standard protective order remains applicable. While parties are free to negotiate supplemental or substitute terms on which they agree, the standard protective order does include a provision governing the return or alternative handling of protected disclosed information *upon termination of this proceeding*, and the Board's jurisdiction over the parties and their attorneys terminates when the proceeding is terminated, thereby limiting the Board's authority to determine or oversee what choice of laws or forum would be proper in the event of any post-termination disputes between the parties.

It appears that opposer's counsel sent applicant's counsel a September 12, 2008 letter outlining specific alleged deficiencies in discovery responses, counsel for both parties agreed to conference by telephone, and attempted to schedule a day and time for such conference to take place prior to the October 2, 2008 commencement of opposer's testimony period, as reset. Nonetheless, the record indicates that substantive communication with respect to the discovery matters never actually took place.

Under these circumstances, opposer has not complied with the applicable conference or correspondence requirements of Trademark Rules 2.120(e)(1) and 2.120(h)(1). The failure of the parties to confer in an attempt to resolve the disputes is particularly relevant where, as here, the motion to compel and to test sufficiency involves a substantial number of discovery responses, and engaging in discussion with respect to each such concern might narrow the number and/or scope of requests and responses in dispute that require Board adjudication. *See Id.* The Board anticipates that good faith substantive communication regarding the asserted discovery deficiencies may prove to narrow the issues ultimately requiring Board intervention.

In view thereof, opposer's motion to compel and to test the sufficiency of applicant's responses to opposer's first request for admissions is hereby denied without prejudice.²

The parties are reminded that a party that has responded to discovery requests has a continuing duty to supplement or correct such responses. See Fed. R. Civ. P. 26(e); see also TBMP § 408.03 (2d ed. rev. 2004). The Board expects parties and their attorneys to cooperate in the discovery process, and looks with extreme disfavor at those parties who do not. Each party and its attorney or other authorized representative has a duty to make a good faith effort to satisfy the legitimate discovery needs of its adversary, and to seek only such discovery as is proper and relevant to the issues in the case. See TBMP § 402.01 (2d ed. rev. 2004), and authorities cited therein.

Proceedings are resumed and trial dates are reset as indicated below:³

Schedule

² Inasmuch as opposer's motion to compel and to test the sufficiency of applicant's responses is denied without prejudice, opposer's motion to strike applicant's response to opposer's motion to compel, and applicant's counter-motion to strike opposer's motion to compel, are denied as moot.

³ Opposer's motion, filed September 26, 2008, to reschedule trial dates is granted to the extent indicated above. Moreover, in view of the above, and inasmuch as opposer's September 29, 2008 filing of the motion to compel suspended proceedings (*Cf. Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1430 (TTAB 1998), Trademark Rules 2.120(e)(2) and 2.120(h)(2), and TBMP § 510.03(a) (2d ed. Rev. 2004), applicant's motion, filed December 3, 2008, to dismiss for failure to prosecute is denied as moot.

Proceedings are resumed. Trial periods are reset as follows:

30-day testimony period for party in position of plaintiff to close: 06/07/09

30-day testimony period for party in position of defendant to close: 08/06/09

15-day rebuttal testimony period to close: 09/20/09

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 Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.