

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

Mailed: June 2, 2011

Opposition No. 91188035

Guess? IP Holder L.P. and
Guess?, Inc.

v.

Advance Watch Company Ltd.

**George C. Pologeorgis,
Interlocutory Attorney:**

This case now comes before the Board for consideration of opposers' combined motion to compel discovery and to test the sufficiency of responses to opposers' requests for admissions filed on February 9, 2011. The combined motion is fully briefed.

The Board, in its discretion, suggested that the issues raised in opposers' combined motion should be resolved by telephonic conference as permitted by TBMP § 502.06 (3d ed. 2011). The Board contacted the parties to discuss the date and time for holding the phone conference.

The parties agreed to hold a telephone conference at 2:30 p.m., Eastern Time on Wednesday, May 25, 2011. The conference was held as scheduled among Steven E. Lauridsen, as counsel for opposers, Matthew R. Mowers and Hope Shovein,

as counsel for applicant, and George C. Pologeorgis, as a Board attorney responsible for resolving interlocutory disputes in this case.

The Board carefully considered the arguments raised by the parties, as well as the supporting correspondence and the record of this case, in coming to a determination regarding the above matters. During the telephone conference, the Board made the following findings and determinations:

Opposers' Motion to Compel

Initially, the Board finds that opposers have made a good faith effort to resolve the parties' discovery dispute prior to seeking Board intervention and that opposers' combined motion is timely. See Trademark Rule 2.120(e)(1).

We first turn to the merits of opposers' motion to compel discovery. Opposers' motion to compel responses to the interrogatory and document requests at issue is granted, in part, and denied, in part, as set forth below.

1. Interrogatory Requests

Interrogatory Nos. 1-3, 9, 14-21, 23-24, 28-30, 33 and 36

Motion **granted** to the extent that applicant must provide formal **verified** responses limited to those responses provided by applicant in opposition to opposers' motion to compel.

Interrogatory No. 31

Motion is **granted** to the extent that applicant must supplement its response and explain in detail the basis for its denial of Paragraph 6 of opposers' amended notice of opposition filed on November 2, 2009.

Interrogatory No. 32

Motion **granted** to the extent that applicant must identify all channels of trade in the United States for the goods identified in applicant's subject application which are sold or offered for sale in conjunction with applicant's involved GC and design mark.

Interrogatory Nos. 26

Motion **denied** with respect to the above-identified interrogatory request.

Additionally, applicant must provide verification of the responses ordered above, as well as verification of any prior interrogatory responses provided to opposers that are not subject to opposers' motion to compel.

2. Document Requests

Document Request No. 1-2, and 4

Motion is **granted** to the extent that applicant must produce responsive non-privileged documents to the above-identified document requests.

Document Request No. 11

Motion is **granted** to the extent that applicant must produce responsive non-privileged documents that relate to the conception, development, selection and/or adoption of applicant's involved mark as identified in its subject application.

Document Request No. 12

Motion is **granted** to the extent that applicant must supplement its production and produce responsive non-privileged documents referring or relating to applications to register applicant's involved mark as identified in its subject application in connection with the goods identified therein in any state of the United States or in the United States Patent and Trademark Office.

Document Request No. 13

Motion is **granted** to the extent that applicant must produce responsive non-privileged documents relating to the geographic scope of use in the United States of applicant's involved mark as identified in its subject application in connection with the goods identified therein.

Document Request No. 14

Motion is **granted** to the extent that applicant must produce responsive non-privileged documents sufficient to identify any authorization, license, franchise, assignment, or grant from applicant to any other person or entity the right to

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use applicant's involved mark in the United States as identified in its subject application in connection with the goods identified therein.

Document Request No. 15

Motion is **granted** to the extent that applicant must produce responsive non-privileged documents that refer or relate to any surveys, market studies, opinion polls, or other sampling of attitudes or opinions referring or relating to (i) applicant's involved mark as identified in its subject application, (ii) opposers' pleaded GC marks, and/or (iii) any other mark containing GC.

Document Request No. 19

Motion is **granted** to the extent that applicant must produce responsive non-privileged documents sufficient to show the condition under which goods identified in applicant's application are sold, offered for sale or provided in the United States under applicant's subject mark.

Document Request No. 21

Motion is **granted** to the extent that applicant must produce responsive non-privileged documents evidencing the channels of distribution of the goods identified in applicant's application with which applicant uses or intends to use its subject mark, including the channels of trade through which applicant offers, has offered, or intends to offer its identified goods in connection with its subject mark.

Document Request No. 22

Motion is **granted** to the extent that applicant must produce responsive non-privileged documents evidencing the types or classes of consumers and/or ultimate users in the United States of the goods identified in applicant's application sold under applicant's subject mark.

Document Request No. 23

Motion is **granted** to the extent that applicant must produce responsive non-privileged documents sufficient to show the total and annual dollar volume applicant has expended promoting and/or advertising its subject mark in the United States in connection with the goods identified in applicant's application.

Document Request No. 24

Motion is **granted** to the extent that applicant must produce responsive non-privileged documents sufficient to show the dollar volume of sales in the United States of each of the goods identified in applicant's involved application for which applicant has been using its subject mark.

Document Request No. 25

Motion is **granted** to the extent that applicant must produce responsive non-privileged documents sufficient to show the amount of units sold in the United States for each of the goods identified in its involved application sold in connection with applicant's subject mark.

Document Request No. 26

Motion is **granted** to the extent that applicant must produce responsive non-privileged documents referring or relating to applicant's knowledge or awareness of opposers' pleaded GC marks, including but not limited to when applicant first became aware of opposers' pleaded GC marks.

Document Request No. 28

Motion is **granted** to the extent that applicant must produce responsive non-privileged documents to the above-identified document requests.

Document Request No. 29

Motion is **granted** to the extent that applicant must produce responsive non-privileged documents referring or relating to any objection made by any person regarding applicant's use or attempts to register applicant's subject mark used in association with the goods identified in applicant's application in the United States.

Document Request No. 32

Motion is **granted** to the extent that applicant must produce responsive non-privileged documents concerning any market research, solicitation and /or collection of public comment, polls, and/or consumer studies performed by on or behalf of applicant concerning applicant's subject mark and opposers' pleaded common law and registered GC marks.

Document Request No. 33

Motion is **granted** to the extent that applicant must produce responsive non-privileged documents sufficient to show the dollar value of applicant's actual and projected sales on an annual basis of the goods identified in applicant's application sold under applicant's subject mark in the United States.

Document Request No. 35

Motion is **granted** to the extent that applicant must produce responsive non-privileged documents concerning any proceedings in which applicant is or was a party in the United States Patent and Trademark Office, or in any other court or before any administrative agency in the United States, that involves or involved applicant's subject mark as identified in its involved application.

Document Request No. 36

Motion is **granted** to the extent that applicant must produce responsive non-privileged documents concerning any agreements between applicant and any third party concerning (a) ownership rights in or (b) the right to use and/or register applicant's subject mark as identified in its involved application.

Document Request No. 37

Motion is **granted** to the extent that applicant must produce responsive non-privileged documents concerning any

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agreements between applicant and any third-party that resulted from any trademark dispute in the United States that involved applicant's subject mark as identified in its involved application.

Document Request No. 40

Motion is **granted** to the extent that applicant must produce responsive non-privileged documents sufficient to show applicant's advertising expenditures regarding applicant's subject mark as identified in its involved application used in connection with the goods identified therein in the United States.

Document Request No. 41

Motion is **granted** to the extent that applicant must produce responsive non-privileged documents referring or relating to any instances of actual or possible confusion between applicant's subject mark and opposers' pleaded GC marks.

Document Request No. 43

Motion is **granted** to the extent that applicant must produce responsive non-privileged documents consisting of written or electronic communications between parties referring or related to opposers' pleaded GC marks.

Document Request No. 44

Motion is **granted** to the extent that applicant must produce a representative sampling of responsive non-privileged documents depicting applicant's use of its subject mark in

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connection with the goods identified in applicant's application from applicant's first use in U.S. commerce of said mark to the present.

Document Request No. 45

Motion is **granted** to the extent that applicant must produce a representative sampling of responsive non-privileged documents depicting applicant's first use in U.S. commerce of its subject mark in connection with the goods identified in applicant's application.

Document Request No. 49

Motion is **granted** to the extent that applicant must supplement its production in response to this document request by producing a representative photograph showing applicant's subject mark affixed to the good or to the container of the goods for each good identified in applicant's application which applicant has not already produced.

Document Request Nos. 50-52

Motion is **granted** to the extent that applicant must produce responsive non-privileged documents and/or samples to the above-identified document requests.

Document Request Nos. 53-80

Motion is **granted** to the extent that applicant must produce responsive non-privileged documents demonstrating proof of use of applicant's subject mark in U.S. commerce in

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connection with the goods identified in each of the above-identified document requests.

Document Request Nos. 81-94

Motion is **granted** to the extent that applicant must produce invoices evidencing the sale of the goods identified in each of the above-identified document requests by applicant in connection with applicant's subject mark prior to the filing date of applicant's involved application. Applicant may redact the name of the customer from the responsive invoices.

If there are no responsive, non-privileged documents in applicant's possession, custody or control which are responsive to any of the aforementioned document requests, applicant must so state in its response to the corresponding document request. To the extent respondent has already produced all documents responsive to any of the above-identified requests, respondent must so state in its response to the corresponding document request.

Document Request Nos. 3, 5, 9, 17, 20, 27, 38, 42, and 48

Motion **denied** with respect to the above-identified document requests.

**Opposers' Motion to Test Sufficiency of Responses to
Requests for Admissions**

Admission Request Nos. 5-32

Motion **granted** to the extent that applicant must provide formal supplemental responses to the above-identified admission requests limited to those responses provided by applicant in opposition to opposers' motion to test the sufficiency of responses to opposers' admission requests.

Admission Request Nos. 33-36, 40-51, 60-67, 69, and 71-72

Motion is **granted** to the extent that applicant must provide supplemental responses to each of the above-identified requests with the limitation that applicant need only respond to the requests as they pertain to applicant's subject mark in connection with the goods identified in applicant's application and only in regard to applicant's use of its subject mark in U.S. commerce.

Admission Request Nos. 77-119

Motion is **granted** to the extent that applicant must provide supplemental responses to the above-identified requests with the limitation that the requests only concern uses in the United States or registrations issued in the United States.

In view of the foregoing, opposers' motion to compel is granted, in part, and denied, in part.

Applicant is allowed until **forty-five (45) days** from the mailing date set forth in the caption of this order to

serve upon opposers responses to opposers' Interrogatory Request Nos. 1-3, 9, 14-21, 23-24, 28-30, 31-33 and 36 to the extent indicated herein. As noted above, applicant must also provide verification of the responses ordered above, as well as verification of any prior interrogatory responses provided to opposers that are not subject to opposers' motion to compel within the same forty-five days provided above.

Applicant is also allowed until **forty-five (45) days** from the mailing date set forth in the caption of this order to produce documents responsive to opposers' Document Request Nos. 1-2, 4, 11-15, 19, 21-26, 28-29, 32-33, 35-37, 40-41, 43-45, and 49-80 to the extent indicated herein.

Additionally, applicant is required to provide opposers a privilege log within the same **forty-five (45) days** set forth above to the extent that applicant claims privilege to any of opposers' discovery requests, if it has not already done so.

Applicant is also allowed the same **forty-five (45) days** set forth above to respond to opposers' Admissions Request Nos. 5-36, 40-51, 60-67, 69, 71-72 and 77-119 to the extent ordered herein.

Finally, in the event applicant fails to provide opposers with full and complete responses to the outstanding discovery, as required by the instant order, applicant will

be barred from relying upon or later producing documents or facts at trial withheld from such discovery. See Fed. R. Civ. P. 37(c)(1).¹

Proceedings herein are resumed. Discovery is closed. Trial dates, beginning with the deadline for opposers' pretrial disclosures, are reset as follows:

Plaintiff's Pretrial Disclosures	8/17/2011
Plaintiff's 30-day Trial Period Ends	10/1/2011
Defendant's Pretrial Disclosures	10/16/2011
Defendant's 30-day Trial Period Ends	11/30/2011
Plaintiff's Rebuttal Disclosures	12/15/2011
Plaintiff's 15-day Rebuttal Period Ends	1/14/2012

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.

¹ If applicant fails to comply with this order, opposers' remedy lies in a motion for sanctions, pursuant to Trademark Rule 2.120(g)(1). Furthermore, the parties are reminded that a party that has responded to a discovery request has a duty to supplement or correct that response. See Fed. R. Civ. P. 26(e).