

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

MBA

Mailed: April 27, 2012

Opposition No. 91194870

Bell's Brewery, Inc.

v.

Edward R. Weiner

**Michael B. Adlin, Interlocutory Attorney:**

This case now comes up for consideration of opposer's fully-briefed motion, filed November 29, 2011, to compel applicant to serve supplemental written responses to opposer's interrogatories and document requests, and to produce documents. On April 24, 2012, the Board held a teleconference with the parties to hear additional argument and rule on the motion, at which Sarah Robertson appeared on opposer's behalf and Jack H. Weiner appeared on applicant's behalf; the interlocutory attorney assigned to this proceeding conducted the teleconference. In addition, because the parties failed to meet the deadline for conducting the discovery conference mandated under Fed. R. Civ. P. 26(f) and Trademark Rule 2.120(a)(1) and (a)(2), and at applicant's request, the Board also participated in the

parties' discovery conference during the teleconference regarding the motion to compel.

Background and Undisputed Facts

Applicant seeks registration of the mark shown below,



with a color claim, for "Cabarets."<sup>1</sup> In its notice of opposition, opposer alleges prior use and registration of OBERON, in standard characters, for "Beer, Ale, and Malt Liquor,"<sup>2</sup> and that use of applicant's mark is likely to cause confusion with opposer's mark. In his answer, applicant denies the salient allegations in the notice of opposition and counterclaims for cancellation of opposer's pleaded registration on the grounds of nonuse and abandonment. Opposer denies the salient allegations in the counterclaim.

Pursuant to the Board's order of September 2, 2010, discovery was originally scheduled to close on May 9, 2011. The parties then requested, and were granted, multiple suspensions and extensions of the discovery period, including for settlement negotiations, and ultimately,

---

<sup>1</sup> Application Serial No. 77802169, filed August 11, 2009 based on an alleged intent to use the mark in commerce.

<sup>2</sup> Registration No. 3043604, issued January 17, 2006 from an application filed May 20, 2004, based on first use dates of May 28, 1997.

pursuant to the Board's order of September 28, 2011, discovery was rescheduled to close on December 5, 2011. All told, and without counting the time that this proceeding was suspended for settlement negotiations, the parties have thus far had approximately eight months to engage in discovery. Opposer did not serve its written discovery requests until June 7, 2011, after discovery had already been open for approximately four months, not counting when this proceeding was suspended for settlement negotiations. At the time, approximately two months remained in the discovery period. Applicant timely served written responses to opposer's discovery requests, and applicant apparently served his own written discovery requests on opposer. Neither party met the deadline for serving initial disclosures, and neither party served initial disclosures prior to serving discovery requests, however.

Motion to Compel

Opposer's motion to compel is hereby **DENIED**, because opposer failed to serve initial disclosures before serving its discovery requests. Indeed, "[a] party must make its initial disclosures prior to seeking discovery, absent modification of this requirement by a stipulation of the parties approved by the Board, or a motion granted by the Board, or by order of the Board." Trademark Rule 2.120(a)(3); Dating DNA LLC v. Imagini Holdings Ltd., 94

USPQ2d 1889, 1993 (TTAB 2010). Here, there is no stipulation by the parties to waive this requirement, much less one approved by the Board, and the Board has not issued any orders waiving this requirement, which is strictly enforced.<sup>3</sup>

Opposer's arguments to the contrary are unavailing. Any waiver of the requirement that initial disclosures be served prior to discovery requests must be explicit and in writing. TBMP § 401.04 (3d ed. 2011). In other words, the parties' "mutual inadvertent failure to serve initial disclosures," cited by opposer, is irrelevant absent a Board order excusing the prerequisite of serving initial disclosures. While it certainly would have been preferable for applicant to have specifically objected to opposer's discovery requests on the grounds that opposer failed to first serve initial disclosures, Amazon Technologies, Inc. v. Wax, 93 USPQ2d 1702 (TTAB 2009), applicant's failure in this regard does not excuse opposer's failure. Moreover, Amazon Technologies is readily distinguishable to the extent that it granted the movant's motion to compel based on the nonmovant's failure to make specific objections. Indeed, in Amazon Technologies, unlike this case, the movant had in

---

<sup>3</sup> It does not escape notice that opposer was fully aware of the initial disclosure requirement, having asked applicant for an extension of the initial disclosure deadline on December 9, 2010. Applicant's Response to Motion to Compel Ex. F.

fact served initial disclosures prior to serving discovery requests. Finally, opposer's argument that "dismissing" its motion to compel is a "sanction" is not well-taken.

Opposer's motion to compel is denied because opposer failed to meet a prerequisite to serving discovery, which is not a sanction. Cf. Trademark Rule 2.120(g) (sanctions may be appropriate where a party "fails to comply with an order ... relating to disclosure or discovery" or "informs" its adversary "that required disclosures will not be made").

Because the parties did not serve discovery requests until after four months of the discovery period had passed, served their discovery requests prior to serving initial disclosures, and opposer did not file its motion to compel until barely one week remained in the discovery period, there is no reason to allow the parties significant additional time for discovery. This is especially so because this case is uncomplicated and the relevant facts are limited. During the teleconference, opposer indicated that it has significant travel and other commitments during the upcoming six weeks, and was therefore advised to begin working with applicant now to schedule depositions, to ensure that any desired depositions can be completed prior to the close of discovery as scheduled herein. A lack of planning on one or both parties' part will make it extremely

difficult, or impossible, to establish the requisite "good cause" for an extension of the discovery period.<sup>4</sup>

In any event, because it was clear from the teleconference that the parties intend to re-serve their discovery requests, or versions thereof, the parties should first carefully consider several points discussed during the teleconference. First, pursuant to Trademark Rule 2.116(g), the Board's standard protective order, available here, <http://www.uspto.gov/trademarks/process/appeal/guidelines/stndagmnt.jsp> "is applicable during disclosure, discovery and at trial in all opposition, cancellation, interference and concurrent use registration proceedings, unless the parties, by stipulation approved by the Board, agree to an alternative order, or a motion by a party to use an alternative order is granted by the Board." As a result, "[p]arties cannot withhold properly discoverable information on the basis of confidentiality ..." TBMP § 412.01 (3d ed. 2011). Rather, they must produce the information, subject to the protective order, as appropriate. In the event that the parties reach agreement on an alternative protective order, then that protective order will govern this proceeding, but unless and until the parties reach agreement, the standard protective order applies.

---

<sup>4</sup> While opposer argued during the teleconference for a long extension of the discovery period, in its motion it requests only

Second, the parties should consider the discovery guidelines set forth in TBMP § 414, many of which are directly relevant to the discovery requests served to date. For example, "[t]rademark search reports are discoverable, but the comments or opinions of attorneys relating thereto are privileged and not discoverable (unless the privilege is waived)." TBMP § 414(6). A party's expansion plans, if any, agreements with third parties related to the involved mark, "[a]nnual sales and advertising figures," and enforcement efforts, if any, may also be discoverable. TBMP § 414(8), (10), (18). On the other hand, "where complete compliance with a particular request for discovery would be unduly burdensome, the Board may permit the responding party to comply by providing a representative sampling of the information sought ...." TBMP § 414(2).

Third, applicant must produce information or documents in its "possession, custody or control." Fed. R. Civ. P. 34(a)(1) (emphasis supplied). And "[c]ontrol with respect to the production of documents" is defined "'not only as possession, but as the legal right to obtain the documents requested upon demand.'" Pioneer Kabushiki Kaisha v. Hitachi High Technologies, 74 USPQ2d 1672, 1679 (TTAB 2005) (quoting Cochran Consulting, Inc. v. Uwatec USA, Inc., 102 F.3d 1224, 41 USPQ2d 1161, 1166 (Fed. Cir. 1996)); see also,

---

a 60 day extension, Opposer's Motion p. 8, and pursuant to the

Sedona Corp. v. Open Solutions, Inc., 249 F.R.D. 19, 22 (D. Conn. 2008) and In re Hallmark Capital Corp., 534 F.Supp.2d 981, 982-83 (D. Minn. 2008). Here, applicant licenses the involved mark to a third party or parties, and oftentimes, if not always, a trademark licensor has the right to obtain trademark-related documents and information from his licensee.

Fourth, to the extent that applicant objects to discovery requests based on the attorney-client privilege or attorney work product doctrine, he must produce a privilege log. Specifically, applicant must "describe the nature of the documents, communications or tangible things not produced or disclosed ... in a manner that, without revealing information itself privileged or protected, will enable other parties to assess the claim" of privilege. Fed. R. Civ. P. 26(b)(5)(A)(ii).

Fifth, it is unhelpful to state in response to a document request that "[t]o the extent that such documents are in Applicant's possession, Applicant will produce whatever documents he has within his control." This type of written response calls into question whether a party actually searched for documents and whether he has any responsive documents to produce. For the sake of clarity, increasing the usefulness of discovery and avoiding the

---

schedule herein, it has been granted almost that much time.



necessity of contested discovery motions, the parties should simply indicate whether or not responsive documents exist, and if they exist, the documents should be identified by Bates number or produced as kept in the ordinary course of business.<sup>5</sup> Amazon Technologies Inc. v. Wax, 95 USPQ2d 1865, 1868 (TTAB 2010).

Finally, to the extent that applicant seeks to rely on the "common interest privilege," he should ensure that the privilege is in fact applicable. Indeed, the privilege appears to be inapplicable to Board proceedings, where usually only the owner of the involved application or registration is a defendant, and where the only issue is whether that owner is entitled to obtain or maintain a trademark registration. Furthermore, the record does not reveal that there is prospective litigation beyond this proceeding, or that applicant has been discussing any such prospective litigation with third parties, much less third parties who share an "identical legal interest" with applicant. And given applicant's failure to produce a privilege log, it is not even clear whether any such communications with third parties are even otherwise subject

---

<sup>5</sup> All too often, parties view discovery not as a means for obtaining relevant information needed to prepare for trial, but instead as a tool to harass or inflict pain. Based on the information provided during the teleconference and in this order, the Board does not expect that either party will have to resort to filing another discovery motion. To the extent that future

to the attorney-client privilege or attorney work product doctrine. See e.g., Mainstreet Collection, Inc. v. Kirkland's, Inc., 270 F.R.D. 238, 242-43 (E.D.N.C. 2010); Corning Inc. v. SRU Biosystems, LLC, 223 F.R.D. 189, 190-91 (D. Del. 2004). In short, applicant may face a steep uphill climb in attempting to establish that there is other threatened litigation about which it specifically communicated with its licensee or others, in communications which included otherwise-privileged information or documents.

Discovery Conference Summary

The parties have effectively covered much of the ground required to be covered during a discovery conference, in their discovery responses, negotiations leading up to the motion to compel, earlier settlement discussions and the teleconference. In addition, during the teleconference, the parties agreed to accept service of papers by e-mail under Trademark Rule 2.119(b)(6), provided that "confirmation" copies are also sent by first-class mail. The parties also restated their current settlement positions, and applicant was reminded that opposer need not respond to applicant's discovery requests until after applicant serves his initial disclosures.

---

discovery disputes arise, however, the parties will be expected to have studied this order.

In any event, during the teleconference, the Board indicated that this case appears quite straightforward, and the relevant facts appear quite limited. Therefore, the Board reminded the parties of their option to stipulate to limits on discovery, abbreviated procedures for submission of evidence and other ways to expedite resolution of this case. See, Target Brands Inc. v. Hughes, 85 USPQ2d 1676 (TTAB 2007). While applicant was interested in pursuing these possibilities, opposer indicated that it was not at this time, and would require applicant to produce additional documents prior to considering these possibilities further.

On a related note, the Board indicated that this case appears particularly appropriate for Accelerated Case Resolution ("ACR"). While the parties were not willing to agree to ACR during the teleconference, they agreed to consider resolving this case by ACR if certain conditions are met, and are directed to:

<http://www.uspto.gov/trademarks/process/appeal/Accelerated Case Resolution ACR notice from TTAB webpage 12 22 11.pdf>

[http://www.uspto.gov/trademarks/process/appeal/Accelerated Case Resolution \(ACR\) FAQ updates 12 22 11.doc](http://www.uspto.gov/trademarks/process/appeal/Accelerated Case Resolution (ACR) FAQ updates 12 22 11.doc)

[http://www.uspto.gov/trademarks/process/appeal/ACR Case List 01 9 11\).do](http://www.uspto.gov/trademarks/process/appeal/ACR Case List 01 9 11).doc)  
[c](#)

Conclusion

Opposer's motion to compel is denied. Proceedings herein are resumed, and disclosure, discovery and trial dates are reset as follows:

Expert Disclosures Due	<b>May 14, 2012</b>
Discovery Closes	<b>June 13, 2012</b>
Plaintiff's Pretrial Disclosures	<b>July 28, 2012</b>
Plaintiff's 30-day Trial Period Ends	<b>September 11, 2012</b>
Defendant's Pretrial Disclosures	<b>September 26, 2012</b>
Defendant's 30-day Trial Period Ends	<b>November 10, 2012</b>
Plaintiff's Rebuttal Disclosures	<b>November 25, 2012</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>December 25, 2012</b>

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

\*\*\*