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

BUTLER

Mailed: August 19, 2011

Opposition No. 91196425

DEMAND MEDIA, INC.

v.

GLOBAL MEDIA ARTS and GLOBAL DIGITAL LLC

Applicant[1] seeks to register the following mark

for services in Classes 35 (*e.g.*, an interactive website, subscriptions of online golf games and social networks, online retail store services, and a website for management of account information); 38 (*e.g.*, providing telecommunications connections to a global computer network; 41 (*e.g.*, production of video and computer game software, advice and training services, arranging and conducting gaming competitions, entertainment services); and 42 (*e.g.*, design and development of computer golf game software,

[1] The Board is aware that there are two named applicants. However, the position of defendant is referred to in the singular in this order.

virtual reality software, video golf gaming program development).[2]

As grounds for the opposition, opposer alleges priority of use and likelihood of confusion. Opposer asserts its ownership of the following registered mark:

for "promoting the goods and services of others by providing advertising space on websites; design and preparation of advertisements for the promotion of goods and services of others; placing advertising banners for others products and services on web sites accessed through a global computer network."[3] Opposer also asserts ownership of the previously used mark GOLFLINK, which is the subject matter of pending application Serial No. 85125255, for numerous goods and services (*e.g.*, computer software, promotional and advertising services for others, database tracking, television transmission services, providing a website).

In its answer, applicant denies the essential allegations of the notice of opposition and asserts affirmative defenses.

This case now comes up on the following motions and matters:

1) applicant's representation;

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[2] Application Serial No. 77699474, filed on March 25, 2009, claiming a bona fide intent to use the mark in commerce.

[3] Registration No. 2447530.

2) applicant's affirmative defenses, which the Board considers sua sponte;

3) opposer's motion, filed February 1, 2011, to strike applicant's communication of November 20, 2011 and to strike applicant's "initial disclosures," filed December 18, 2011;

4) opposer's motion, February 1, 2011, for modification of the Board's standardized protective order to include a clawback provision;

5) opposer's motion, filed February 17, 2011, and supplemented on March 3, 2011 to provide the missing exhibits, to compel applicant's responses to opposer's interrogatory and production requests;

6) applicant's motion, filed May 9, 2011, for entry of sanctions against opposer.

Applicant's representation

In response to the Board's order dated May 20, 2011, applicant informs the Board that it is representing itself through its majority and managing partner, Matthew Harper.

It should be noted that while Patent and Trademark Rule 10.14 permits any person to represent itself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in an opposition proceeding to secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney. In addition, as the impartial decision maker, the Board may not provide legal advice, though may provide information as to procedure.

Later in this order, the Board provides additional information about its proceedings.

Applicant's affirmative defenses

The Board sua sponte considers applicant's affirmative defenses because applicant has submitted groundless filings (*e.g.,* its initial disclosures and motion for sanctions, addressed later in this order) based on its mistaken belief that the defenses provide it an opportunity to prevail in this case.

1. First and Second Affirmative Defenses

Trademark Act § 19 provides, in relevant part, that the equitable principle of estoppel may be considered and applied. However, there are various types of estoppel recognized by law, including: collateral estoppel, estoppel by laches, equitable estoppel, licensee estoppel, contract estoppel. Applicant has not indicated which type of estoppel it is asserting affirmatively or provided enough information concerning the nature of the purported estoppel and the underlying factual circumstances, at least in general terms, which may give rise to the asserted estoppel. The affirmative defense of unclean hands is available in a Board proceeding. *See Seculus Da Amazonia S/A v.Toyota Jidosha Kabushiki Kaisha*, 66 USPQ2d 1154, 1157 (TTAB 2003). Again, applicant has not provided any factual information concerning the unclean hands affirmative defense. Similarly, applicant has not provided any information concerning the asserted "consent." Thus, applicant simply has not provided sufficient allegations of fact to put opposer (or the Board) on notice of the bases upon which the unclean hands, estoppel and

consent affirmative defenses are being asserted. *See Heller Finance, Inc. v. Midwhey Powder Co.*, 883 F.2d 1286, 1294 (7th Cir. 1989) (upholding motion to strike affirmative defenses because they were bare bones, conclusory allegations); and *Fleet Business Credit Corp. v. National City Leasing Corp.*, 191 F.R. D. 568, 570 (N.D. Ill. 1999) (bare bones waiver and estoppel defenses fail to sufficiently plead the affirmative defenses).

Accordingly, applicant's first and second affirmative defenses are stricken.

2. Fourth and Fifth Affirmative Defenses

Applicant's fourth and fifth affirmative defenses, that opposer has abandoned the mark in its asserted Registration No. 2447530 and that opposer is "barred because of fraud on the Trademark Office arising out of … Opposer's filings in connection with its trademark registration(s)" are improper. Such defenses, as asserted against opposer's pleaded registration, attack the validity of such registration. An attack on the validity of a pleaded registration must be made in the context of a counterclaim or a separate petition to cancel. *See* TBMP §§ 311.02(b) and 313 (3d ed. 2011). To the extend applicant is asserting these defenses against opposer's pending application, the defenses are not relevant because the Board does not have jurisdiction over the application before the Trademark Examining Operation. *See* TBMP § 212.01 (3d ed. 2011).

Accordingly, applicant's fourth and fifth affirmative defenses are stricken.

3. Third Affirmative Defense

Applicant's third affirmative defense, that opposer's marks are weak, is considered only a reassertion of applicant's denial of opposer's likelihood of confusion claim. It provides some additional information to opposer concerning applicant's potential theory of defense. Accordingly, the third affirmative defense remains as stated.

Opposer's motion to strike certain filings

Opposer seeks to strike applicant's filing of November 20, 2010 on the basis that it consists only of a single page which is incomplete. Opposer notes that the filing is not accompanied by a certificate of service on opposer and that opposer was not served with a copy. Opposer's seeks to strike applicant's filing of December 18, 2010, titled "initial disclosures," on the bases that it is not, in fact, applicant's initial disclosures; it does not provide the information required by Fed. R. Civ. P. 26(a)(1); it does not include certificate of service on opposer; and that opposer did not receive a service copy. Applicant did not respond to opposer's motion to strike these filings.

1. Applicant's November 20, 2010 filing

Applicant's filing appears to be a mistake. As opposer observed, the filing is a single page, displaying a partial title. Opposer's motion to strike is well taken and is hereby

granted. The filing of November 20, 2010 is stricken from the record and no further consideration will be given thereto. *See also* Trademark Rule 2.127(a).

2. Applicant's "Initial Disclosures"

In accordance with Fed. R. Civ. P. 26(a)(1)(A), a party's initial disclosures are:

> (i) the name and, if known, the address and telephone number of each individual likely to have discoverable information — along with the subjects of that information — that the disclosing party may use to support its claims or defenses, unless the use would be solely for impeachment;
>
> (ii) a copy — or a description by category and location — of all documents, electronically stored information, and tangible things that the disclosing party has in its possession, custody, or control and may use to support its claims or defenses, unless the use would be solely for impeachment.[4]

Simply put, applicant was required to disclose 1) the names (and contact information if known) of the persons most likely to have discoverable information concerning applicant's defense and 2) a copy (or location and description) of the documents applicant may use in its defense.

A review of applicant's filing indicates that it in no way conforms to the requirements of the Rule or provides the information necessary for initial disclosures. Instead, applicant argues matters that are not before the Board, including

[4] Subsections (iii) and (iv) do not apply to Board proceedings. *See* TBMP § 401.02 (3d ed. 2011).

that opposer abandoned its registered mark and committed fraud on the USPTO in seeking to register its marks.

Accordingly, opposer's motion to strike applicant's December 18, 2010, mislabeled as "initial disclosures," is granted.[5] Such filing is hereby stricken and no further consideration will be given thereto.

A party may not seek discovery through traditional devices (*e.g.*, interrogatories, document requests, admissions requests, and discovery depositions) until after it has made it initial disclosures. *See* Trademark Rule 2.120(a)(3); and TBMP § 401.02 (3d ed. 2011). Nor may a party file a motion for summary judgment until it has made its initial disclosures (with certain exceptions, not present here). *Id.* Accordingly, applicant may not seek discovery by traditional devices or file a summary judgment until it has made proper initial disclosures.

Opposer's motion for modification of the standard protective order

Opposer seeks to include a clawback provision, which allows any party that inadvertently provided or produced privileged information or documents to continue protection of such information and documents. That is, no waiver of the privilege or protection will occur and, in the case of documents and things, the materials will be returned. The proposed provision is found at paragraph No. 13 of the proposed protective order,

[5] The Board's order of January 10, 2011, noting applicant's "initial disclosures," is hereby vacated.

modifying the existing language in the standard protective order. Such a provision is not unusual in litigated proceedings. Applicant did not file a response to opposer's motion.

In view thereof, opposer's motion for a modification of the standard protective order is granted. *See also* Trademark Rule 2.127(a). The proposed protective order, submitted on February 1, 2011, is noted and entered and now governs the conduct of this proceeding for the exchange of confidential and proprietary information and materials.

Opposer's motion to compel

Opposer seeks to compel applicant's responses to opposer's first set of interrogatories and first request for production, served on January 7, 2011. Opposer argues that applicant's single-page response, constituting a boilerplate objection covering all requests is improper. Opposer explains its difficulty in making a good faith effort to resolve the dispute because applicant's representation had not been resolved. In particular, opposer states it contacted applicant's counsel, then of record, but communications came directly from applicant putting opposer in a difficult position for resolving the dispute. Applicant has not responded to opposer's motion.

In view of the unsettled state of applicant's representation at the time, which affected opposer's ability to make a good faith effort to resolve the dispute, opposer's motion is denied.

Nonetheless, applicant's time to respond to the discovery requests is reset later in this order.

The Board now provides information which should assist applicant in responding.

1. Opposer's discovery requests

The Board has briefly reviewed opposer's interrogatory and document requests. They are typical requests where a priority of use and likelihood of confusion claim has been asserted. Applicant is referred also to TBMP § 412 (3d ed. 2011), which lists typical discovery topics in Board proceedings. The listing, though comprehensive, is not exclusive.

2. Discovery Expectations

Each party has a duty to make a good faith effort to satisfy the discovery needs of its adversary and to cooperate in the discovery process. *See* TBMP §§ 402.01 and 408.01(c) (3d ed. 2011). A responding party has a duty to search its records thoroughly for all information properly sought by the request, and to provide such information and documents to the requesting party. *See* TBMP § 408.02 (3d ed. 2011).

In this case, applicant's single-page objection to all requests at issues does not fulfill applicant's discovery duties.

3. General objections

Objections to discovery requests must be specific to the requests for which the objections are being interposed. That is, in addition to posing the objection, the objecting party must

explain why the objection applies to the discovery request at issue. *See* Wright, Miller & Marcus, 8A Fed. Prac. & Pro. Civ. §§ 2173, 2213 and 2262 (3d ed. 2011). As a consequence, very little, if any, consideration will be given by the Board to general objections or to a listing of objections. This is so because the Board cannot guess why a particular objection or set of objections may apply, although occasionally the basis for an objection may be obvious.

As noted, opposer argues that applicant stated a single-page, boilerplate, general objections. Such objection stated, specifically in response to the discovery requests, as follows:

> Applicant objects to said discovery requests to the extent that any or all such requests are burdensome, overbroad, vague and ambiguous, are not reasonably calculated to lead to the discovery of admissible evidence, call for material protected by the attorney-client or work product privilege, and/or call for confidential or trade secret information. Without waiving such objections, Applicant is in the process of obtaining new counsel and will respond to the discovery in full as soon as practicable.

Applicant's general objection to all the discovery requests is improper. Moreover, the objection based on "confidential or trade secret information" is not relevant because the Board's standard protective order, now modified, is in place to govern the exchange of confidential and proprietary information and materials. *See* Trademark Rule 2.116(g); and TBMP § 412 (3d ed. 2011). As discussed later in this order, when a party invokes privilege, it is expected to provide a privilege log.

Accordingly, no further consideration is given to applicant's general objection. In addition, any future assertions of objections that have not been adequately explained with respect to the discovery responses that may become in dispute, or for which the objection is not obvious, will not be considered.

4. Claim of privilege

With respect to any claim of privilege, a "privilege log" is expected unless the parties otherwise agree. *See* Fed. R. Civ. P. 26(b)(5); and Wright & Miller, 8 Fed. Prac. & Pro. Civ. § 2016.1 (3d ed. 2011) ("…if a party claims privilege it shall "make the claim expressly and shall describe the nature of the documents, communications, or things not produced or disclosed in a manner that, without revealing information itself privileged or protected, will enable other parties to assess the applicability of the privilege or protection.")

Here, neither party is deemed to have waived its right to the claim of privilege and need not provide privileged or protected information or produce privileged or protected documents within the meaning of Fed. R. Civ. P. 26(b)(5). *See e.g., American Standard, Inc. v. Pfizer*, 3 USPQ2d 1817 (Fed. Cir. 1987). However, unless the parties otherwise agree, where a claim of privilege is made, a privilege log is to be produced.

Applicant's motion for sanctions

Applicant has moved for sanctions against opposer, accusing opposer of "exceptional abuse of process & aggressive trademark litigation tactics, also known as trademark bullying," "spoliation of client-attorney relationship," and "spoliation of evidence." Opposer has not filed a response.

Neither discovery sanctions under Trademark Rule 2.120(g) nor sanctions pursuant to Fed. R. Civ. P. 11 are available. *See also* TBMP §§ 527.01 and 527.02 (3d ed. 2011). As to the imposition of sanctions as an exercise of the Board's inherent authority, applicant has not shown any reason that an entry of sanctions would be appropriate. *See* TBMP § 527.03 (3d ed. 20110). As addressed earlier in this order, the validity of opposer's pleaded registration (as abandoned or as obtained through fraud) is not before the Board. The Board does not have jurisdiction over opposer's application pending before the Trademark Examining Operation. There is nothing sanctionable in bringing an opposition asserting a statutorily available claim. Trademark Act § 13 expressly provides for an opposition proceeding. There is nothing improper in alerting adverse counsel that a conflict of interest may exist. Knowledge of the existence (even if true) of applicant's foreign registrations (and/or use) is generally irrelevant to proceedings before the Board. *See* TBMP § 414(13) (3d ed. 2011). Asking that applicant

withdraw its application does not amount to spoliation of evidence.[6]

In view thereof, applicant's motion for entry of sanctions is denied.

Applicant submitted a meritless filing which amounts to nothing short of a tantrum. Applicant's filing contains unsubstantiated and groundless accusations. As such, it is an improper filing. The motions for sanctions is not the first improper filing. As discussed earlier in this order, applicant's filing titled "initial disclosures" was also improper. Applicant is put on notice that it may be sanctioned if it continues to file such meritless motions and communications.

Applicant is reminded that the Board is an administrative tribunal empowered only to determine the right to register. *See* TBMP § 102.01 (3d ed. 2011). Applicant is to focus on defending its position in this proceeding which involves a priority of use and likelihood of confusion claim. The Board provides some additional information to assist applicant.

Nature Of Board Proceedings

Applicant is advised that an inter partes proceeding before the Board is similar to a civil action in a Federal district court. There are pleadings, a wide range of possible motions;

[6] Applicant is reminded that trademark records at the USPTO are public records. The record for an opposition proceeding may be obtained using TTABVUE. The record for an application or registration involved in a Board proceeding may be obtained by selecting "application file" in TTABVUE or by selecting "Trademark Document Retrieval" using the TARR database.

discovery (a party's use of discovery depositions, interrogatories, requests for production of documents and things, and requests for admission to ascertain the facts underlying its adversary's case), a trial, and briefs, followed by a decision on the case. The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board during the assigned testimony, or trial, periods, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. No paper, document, or exhibit will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules.

Requirement For Service Of Papers

The service requirements are set forth in Trademark Rule 2.119. Trademark Rules 2.119(a) and (b) and require that every paper filed in the Patent and Trademark Office in a proceeding before the Board must be served upon the attorney for the other party, or on the party if there is no attorney, and proof of such service must be made before the paper will be considered by the Board.

Consequently, copies of all papers which either party may subsequently file in this proceeding must be accompanied by a signed statement indicating the date and manner in which such service was made. Strict compliance with Trademark Rule 2.119 is required in all further papers filed with the Board.

The Board will accept, as prima facie proof that a party filing a paper in a Board inter partes proceeding has served a copy of the paper upon every other party to the proceeding, a statement signed by the filing party, or by its attorney or other authorized representative, clearly stating the date and manner in which service was made. This written statement should take the form of a "certificate of service" which should read as follows:

> The undersigned hereby certifies that a true and correct copy of the foregoing [insert title of document] was served upon opposer by forwarding said copy, via first class mail, postage prepaid to: [insert name and address].

The certificate of service must be signed and dated. *See also* TBMP § 113 (3d ed. 2011).

Electronic Resources

All parties may refer to the Trademark Trial and Appeal Board Manual of Procedure (TBMP) and the Trademark Rules of Practice, both available on the USPTO website, www.uspto.gov. The TTAB homepage provides links to numerous electronic databases, information about accelerated case resolution (ACR), and answers to frequently asked questions. Other useful databases include the ESTTA filing system for Board filings and TTABVUE for status and prosecution history.

Strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, is expected of all parties before the Board, whether or not they are represented by counsel.

The Reset Schedule

Proceedings are resumed and dates are reset as follows:

Due date for applicant's proper initial disclosures	**9/15/2011**
Due date for applicant's substantive responses to opposer's first set of interrogatories and first request for production	**10/1/2011**
Expert Disclosures Due	**12/17/2011**
Discovery Closes	**1/15/2012**
Plaintiff's Pretrial Disclosures	**2/29/2012**
Plaintiff's 30-day Trial Period Ends	**4/14/2012**
Defendant's Pretrial Disclosures	**4/29/2012**
Defendant's 30-day Trial Period Ends	**6/13/2012**
Plaintiff's Rebuttal Disclosures	**6/28/2012**
Plaintiff's 15-day Rebuttal Period Ends	**7/28/2012**

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.l25.

Briefs shall be filed in accordance with Trademark Rules 2.l28(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.

By the Trademark Trial and Appeal Board