

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

Mailed: March 31, 2012

Opposition No. 91198750

Cargill, Incorporated

v.

Sempio Food Service, Inc.

**M. Catherine Faint,
Interlocutory Attorney:**

On March 28, 2012 the Board held a telephone conference involving William D. Schultz, counsel for Cargill, Inc.¹ [hereinafter "Cargill"], and Frederic M. Douglas, counsel for Sempio Food Service, Inc. [hereinafter "Sempio"]. Before the Board is Cargill's motion to compel adequate responses to interrogatories. The motion is contested.

The Board carefully considered the arguments raised, 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 parties were each allowed to make further statements, and the Board made the following findings and determinations.

1. Cargill's Motion to Compel

¹ Heather Kliebenstein also appeared on the telephone line on behalf of Cargill, Inc.

By its motion to compel Cargill seeks to have Sempio provide "adequate" responses Cargill's first set of interrogatories. According to Cargill, it served its first set of interrogatories on June 3, 2011, and Sempio served its responses on July 8, 2011. Cargill argues that Sempio's 119 pages contained not a single substantive response, but instead contained several objections, including that the number of interrogatories exceeds the limit under Fed. R. Civ. P. 33; that it would provide documents in lieu of written responses to the interrogatories pursuant to Fed. R. Civ. P. 33(d), without making the showing required for exercise of that rule; and that Sempio failed to produce documents and specify by category and location, the records from which the answers to interrogatories can be found.

Sempio contends that Cargill did not make a good faith effort to resolve the dispute prior to filing its motion to compel; that Cargill's interrogatories exceed the limitation of 75 provided under Trademark Rule 2.120(d)(1); that Sempio served on October 10, 2011 its "supplemental response" in which it addresses in detail how Cargill's interrogatories "grossly exceed" the numerical limits for interrogatories, and provided a copy of that response with its October 22, 2011 filing with the Board.

In reply, Cargill argues that the Board should strike Sempio's brief as untimely; that Cargill made a good faith

effort to resolve this dispute prior to filing its motion to compel; Sempio did not properly object to what it believed was an excessive number of interrogatories, and that Cargill's interrogatories are within the limit allowed under Trademark Rule 2.120(d)(1).

2. Good Faith Effort

Cargill submitted a declaration together with copies of email correspondence arguing that it has made a good faith effort to resolve the discovery dispute before filing its present motion to compel. Sempio argues that Cargill should have discussed Sempio's allegation of excessive interrogatories prior to filing its motion to compel. The Board discusses this issue more fully below. The Board has reviewed the exchange of emails between the parties and finds that Cargill has made a good faith effort prior to the filing of its motion to compel. Trademark Rule 2.120(e).

3. Sempio's Response Brief is Untimely

Cargill served its motion to compel on September 16, 2011, and Sempio filed its response brief on October 22, 2011. Pursuant to Trademark Rules 2.127 and 2.119(c) Sempio's response was due October 6, 2011. Even taking into consideration Sempio's attempt to supplement its responses on October 10, 2011, Sempio has failed to comply with the Rules. Nonetheless, the Board elects to exercise its discretion to consider Cargill's motion on the merits.

4. Count of Interrogatories

Cargill served interrogatories numbered 1-24. Sempio appears to allege the total count of interrogatories as 90, while Cargill provides a count totaling 67. In its responses Sempio sets out the reasoning for some of its counting methodology, and in its supplemental responses to interrogatories sets out some additional methodologies. Sempio contends, for instance that Interrogatory No. 1 is excessive on its face because it asks for information about "each good on which [Sempio] has used its mark" and this number is then effectively doubled by the second part of the question which asks "the first date on which such use began." The Board notes that the goods shown in Sempio's identification appear to number only three, namely, "vegetable oils and fats" and "salad dressings." While these may include a variety of goods, the count of interrogatories is not driven by the number of Sempio's goods. Rather, the Board looks to the substance of the interrogatories and counts each *question* as a separate interrogatory. See *Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, 19 USPQ2d 1636, 1637 (TTAB 1990); see also TBMP § 405.03(d) and cases cited therein.

Further, Trademark Rule 2.120(d)(1) provides that, "[i]f a party upon which interrogatories have been served believes that the number of interrogatories served exceeds"

the limits of the rule, "the party shall, within the time for and instead of, answering or objecting to the interrogatories, file a motion for protective order."

(Emphasis added.) This Sempio did not do, but instead proposed to answer the interrogatories by producing documents. Thus, by answering the interrogatories, although incompletely, Sempio has waived its objection that Cargill has exceeded the number allowed under the Rule. See *Allahverdi v. Regents of University of New Mexico*, 228 F.R.D. 696, 698 (D.N.M. 2005) (finding when responding party believes requesting party has propounded too many interrogatories, responding party should object to all interrogatories or file motion for protective order; by answering some interrogatories, responding party has waived its objection.)

Further, the Board has determined that the number of interrogatories propounded by Cargill is not excessive in number, and does not exceed the limit of 75 interrogatories.

We turn next to whether Sempio may respond by producing documents in lieu of written answers.

5. Documents in Lieu of Interrogatory Responses Fed. R. Civ. P. 33(d)

Sempio responds to each of Cargill's interrogatories by invoking Fed. R. Civ. P. 33(d).²

To respond with documents in lieu of written answer to interrogatories the responding party must, "[specify] the records that must be reviewed, in sufficient detail to enable the interrogating party to locate and identify them as readily as the responding party could." Fed. R. Civ. P. 33(d)(1). This is considered "an important limitation on this procedure," and is available only "if the burden of deriving or ascertaining the answer will be substantially the same" for the party serving the interrogatory as for the party served, and further the responding party must specify which records contain the information sought. Fed. R. Civ. P. 33(d); see also 8B Wright and Miller, *Federal Practice and Procedure Civ.* § 2178 (3d ed. Westlaw update 2011).

A party responding to an interrogatory by producing business records must identify documents which the responding party knows to contain the responsive information, and may not merely agree to provide access to a voluminous collection of records which may contain the responsive information. *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000). In addition, a party may not rely on the option to produce business records unless it can

² During the teleconference, Sempio clarified that its Supplemental Responses continue to invoke this Rule as to all of its interrogatory responses.

establish that providing written responses would impose a significant burden on the party. Further, even if the responding party can meet this test and can identify particular documents in which the inquiring party will find its answers, the inquiring party must not be left with any greater burden than the responding party when searching through and inspecting the records. Often, this requirement will not be met, because the responding party will have greater familiarity with its own records and will generally have a lesser burden than the inquiring party when searching through the relevant records. *Id.*

Finally, a responding party cannot, as Sempio has, simultaneously invoke the option to produce business records and claim the protection of a privilege as to the documents. *Id.*; see also 8A *Federal Practice and Procedure Civil* 3d § 2178.

Even by its supplemental responses, Sempio has made no effort to comply with the Rule, and further Sempio's reliance on this Rule is improper.

6. Board's Standard Protective Order; Privileged Documents

The Board's standard protective order is in place, and governs this proceeding. See Trademark Rule 2.116(g); see also *M.C.I. Foods, Inc. v. Bunte*, 86 USPQ2d 1044, 1046 (TTAB 2008). Even with its Supplemental Responses, Sempio has not

provided documents or provided any detail regarding the location of the records.

Further, to the extent that Sempio is objecting to discovery requests by asserting that the information is protected by attorney-client privilege or attorney work product, Sempio must provide a privilege log³ and a particularized explanation of the privilege relied on. Fed. R. Civ. P. 26(b)(5)(A)(ii); *No Fear* at 1556 (such objections require particularized explanation sufficient to allow inquiring party to assess applicability of relevant privilege).

7. Duty to Cooperate

The Board noted during the teleconference that Sempio's Supplemental Responses appear to contain numerous objections as to relevancy, overbreadth, or vagueness. While those objections were not a part of the motion to compel, the Board cautions Sempio that it has a duty to cooperate in the discovery process. Further, a party ordinarily will not be heard to contend that a request for discovery is proper when propounded by the party itself but improper when propounded by its adversary. See Fed. R. Civ. P. 26(g); see also *Johnston Pump/General Valve Inc. v. Chromalloy American*

³ The Board notes that Sempio stated in its Supplemental Responses that it would provide a privilege log, but no such log has been provided to date, as discussed during the teleconference.

Corp., 13 USPQ2d 1719, 1721 n.4 (TTAB 1989) (Board warned counsel for opposer that its conduct of discovery in the case was "uncooperative" and "improper" and that any further misconduct may result in the imposition of the estoppel sanction).

The Board looks with extreme disfavor on those who do not cooperate. Each party and its attorney has a duty to make a good faith effort to satisfy the discovery needs of its adversary, to search its records thoroughly for all information properly sought in a discovery request, and to supplement its discovery responses if the party learns that its information is incomplete or incorrect. See Fed. R. Civ. P. 26; TBMP § 408 (2d ed. rev. 2004).

Further, in the event Sempio fails to provide Cargill with full and complete responses to the outstanding discovery, as required by this order, Sempio may 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).⁴

8. Summary

Cargill's motion to compel is granted to the extent that Sempio must serve proper written responses to Cargill's

⁴ If Sempio fails to comply with this order, Cargill's 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).

interrogatories within **TWENTY DAYS** of this teleconference. While Sempio may also produce documents in response to the interrogatories, they must be in addition to the written responses, and must include a description in sufficient detail to enable the Cargill to locate and identify the relevant documents as readily as Sempio could.⁵ Cargill's motion to extend discovery by 60 days is granted.

9. Dates Reset

Disclosure, discovery and trial dates are reset as set out below.⁶

Expert Disclosures Due	6/13/2012
Discovery Closes	7/13/2012
Plaintiff's Pretrial Disclosures Due	8/27/2012
Plaintiff's 30-day Trial Period Ends	10/11/2012
Defendant's Pretrial Disclosures Due	10/26/2012
Defendant's 30-day Trial Period Ends	12/10/2012
Plaintiff's Rebuttal Disclosures Due	12/25/2012
Plaintiff's 15-day Rebuttal Period Ends	1/24/2013

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.

⁵ The Board further clarified during the teleconference that if Sempio references particular documents as part of its interrogatory responses, it must produce those documents, subject to appropriate objections and confidentiality restrictions.

⁶ The Board recited slightly different dates for expert disclosures and the close of discovery during the teleconference, and apologizes for any confusion. Dates are as set out in this written order.

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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.
