

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

CME

Mailed: August 5, 2013

Opposition No. 91202696

Seiko Holdings Kabushiki
Kaisha, t/a Seiko Holdings
Corporation

v.

Choice Fortune Holdings Limited

Christen M. English, Interlocutory Attorney:

This case now comes up on (i) opposer's motion to compel, filed April 3, 2013, and applicant's opposition thereto, (ii) opposer's filing of May 15, 2013, which we construe not as a reply brief but as a filing to satisfy opposer's obligation under Trademark Rule 2.120(e) to inform the Board in writing of issues in the motion to compel "which no longer require adjudication,"¹ and (iii) opposer's motion to extend, incorporated on page 9 of its May 15, 2013 filing.

Motion to Compel

Trademark Rule 2.120(e)(1), 37 C.F.R. § 2.120(e)(1), requires that a motion to compel be supported by a written statement from the moving party that such party or its attorney

¹ The parties' stipulated motion to extend opposer's deadline to file a reply brief is moot. However, the parties should note that

has made a good faith effort, by conference or correspondence, to resolve with the other party or its attorney the issues presented by the motion, and has been unable to reach an agreement. See, e.g., *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626 (TTAB 1986) (failed to submit documentary evidence of good faith effort); see also TBMP § 523.02 (3d ed. rev.2 2013). “[I]t is generally the policy of the Board to intervene in disputes concerning discovery, by determining motions to compel, only where it is clear that the parties have in fact [met and conferred in an attempt to resolve their differences] and have narrowed the amount of disputed requests for discovery, if any, down to a reasonable number.” *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666 (TTAB 1986) (emphasis added).

In support of its argument that it made a good faith effort to resolve its discovery disputes with applicant, opposer asserts that (i) it sent applicant a letter detailing the deficiencies in its discovery responses on November 9, 2012, (ii) having received no response to its letter, opposer followed up with applicant’s counsel; (iii) applicant’s counsel responded via e-mail on November 26, 2012 indicating that he would follow-up with his client, (iv) having received

pursuant to Trademark Rule 2.127(a), “[t]he time for filing a reply brief will not be extended.” (emphasis added).

no further communication from applicant, opposer followed up with applicant's counsel on January 23, 2013, and (v) applicant's counsel responded admitting that applicant's responses were overdue, but never provided a substantive response to the issues raised in opposer's November 9, 2012 letter.

Applicant contends that opposer did not make a good faith effort to resolve its discovery disputes with applicant. Specifically, applicant asserts that the parties were involved in settlement negotiations for over a year, but that on March 25, 2013, applicant sent an e-mail to opposer indicating that it did not believe settlement was "feasible." Response, Exhibit C. In that same e-mail, applicant's counsel suggested that the parties discuss "the status of the matter and moving it forward" and offered specific dates for a conference. *Id.* Applicant asserts that opposer never responded to its e-mail, but instead filed the instant motion to compel. Response, p. 2. Opposer does not dispute applicant's assertions, but contends that on April 5, 2013, it reached out to applicant to request "a timetable for addressing discovery responses" and that the parties held a conference on May 13, 2013 in which they were able to resolve many of the issues raised in the motion to compel.

The Board finds that opposer did not make a good faith effort to resolve the issues presented by the motion with applicant as required by Trademark Rule 2.120(e)(1). Although opposer made an effort between November 9, 2012 and January 23, 2013 to resolve its discovery disputes with applicant, opposer waited more than two months after such efforts to file its motion to compel. In the intervening time, applicant rejected opposer's settlement proposal and offered specific dates for a conference to move the case "forward." Opposer's decision to file the instant motion rather than respond to applicant's offer to discuss this proceeding undercuts any effort opposer may have made before hand to resolve its discovery disputes with applicant and suggests that opposer may have been attempting to retaliate against applicant for rejecting its settlement proposal. Moreover, opposer's effort to discuss its discovery disputes with applicant *after* it filed its motion to compel does not satisfy the requirements of Trademark Rule 2.120(e). Indeed, the fact that the parties were able to resolve many of their discovery disputes so soon after the filing of the motion to compel underscores that opposer did not make a good faith effort prior to filing its motion. For these reasons, opposer's motion to compel is hereby **DENIED**.

Nonetheless, in the interest of moving this case forward, the Board makes the following observations regarding the parties' outstanding discovery disputes:

1. The parties should be able to resolve many if not all of the outstanding discovery issues raised in the motion if they simply review TBMP § 414 and Board law and rules, and cooperate with one another in the discovery process. See TBMP § 408.01. **The parties are expected to cooperate with one another in the future to avoid unnecessary motions that tax the Board's limited resources and to move this case forward efficiently.**
2. The parties are instructed to pay careful attention to TBMP §§ 414(2), (3) and (13), and the cases cited therein. TBMP § 414(2) addresses unduly burdensome discovery requests. TBMP § 414(3) indicates that while the "classes of customer's for a party's involved goods or services are discoverable ... the names of customers ... constitute confidential information, and generally are not discoverable, even under [the Board's standard] protective order," which is automatically in place in this proceeding. And TBMP § 414(13) addresses that "a party's foreign use of its involved mark is usually irrelevant to the issues in a Board proceeding, and thus, not discoverable...."

3. The parties are **strongly encouraged** to produce documents by copying and forwarding them to the requesting party. See TBMP § 406.04(b).
4. A party may seek to preclude its adversary from relying at trial on information or documents which should have been produced or identified in responses to discovery requests, but were not. See *Panda Travel, Inc. v. Resort Option Enterprises, Inc.*, 94 USPQ2d 1789, 1792 (TTAB 2009); *Quality Candy Shoppes/Buddy Squirrel of Wisconsin Inc. v. Grande Foods*, 90 USPQ2d 1389, 1392 (TTAB 2007); *Presto Products v. Nice- Pak Products*, 9 USPQ2d 1895, 1896 n. 5 (TTAB 1988); TBMP §§ 408.02 and 527.01(e).
5. Opposer's interrogatory requests **do not** exceed the limit of seventy-five set out in Trademark Rule 2.120(d)(1). See TBMP § 405.03(c) (interrogatories with respect to many marks "will be counted the same as if they pertained to only one mark").

Motion to Extend

Opposer has moved to extend the expert disclosure deadline by ninety days and to reset all other dates accordingly. Given the parties' discovery dispute, the Board finds that there is good cause for an extension of the deadlines in this proceeding, albeit less than the ninety days that opposer requests. See

Fed. R. Civ. P. 6(b)(1)(A); TBMP § 509.01(a). Accordingly, opposer's motion to extend is **GRANTED**, in part, to the extent that all deadlines are extended by forty-five days as follows:

Expert Disclosures Due	11/15/2013
Discovery Closes	12/15/2013
Plaintiff's Pretrial Disclosures	1/29/2014
Plaintiff's 30-day Trial Period Ends	3/15/2014
Defendant's Pretrial Disclosures	3/30/2014
Defendant's 30-day Trial Period Ends	5/14/2014
Plaintiff's Rebuttal Disclosures	5/29/2014
Plaintiff's 15-day Rebuttal Period Ends	6/28/2014

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 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.
