

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

BUO

Mailed: October 16, 2013

Opposition No. 91205803

Vertex Pharmaceuticals
Incorporated

v.

Hercules Brand Corporation

Benjamin U. Okeke, Interlocutory Attorney:

On September 30, 2013, the Board conducted a telephone conference with the parties, at the request of opposer's counsel. During the telephone conference the parties discussed certain outstanding discovery issues and confirmed applicant's representation in this proceeding. Participating in the call were opposer's counsel, Sharona H. Sternberg, applicant's Vice President, Henry P. Cheatham, representing applicant *pro se*, and Board interlocutory attorney, Benjamin U. Okeke.

Initially, applicant stated its intention to represent itself in this proceeding going forward.¹

¹ The Board's records have been updated accordingly, to reflect applicant's correspondence information. If applicant should

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By opposer's account, opposer served applicant's prior counsel with written discovery requests in February 2013, including interrogatories and document requests. Opposer asserted that applicant's prior counsel served responses in June 2013, but that several of applicant's responses to the interrogatories were deficient and included several improper objections; and that applicant failed to respond to the document requests whatsoever. Applicant indicated that it had forwarded several documents to its prior counsel in response to the document request, but was unsure of whether those documents were ever actually transmitted to opposer.

The Board carefully considered the remarks of the parties during the telephone conference in coming to a determination regarding the issues presented. During the telephone conference, the Board made the following findings and determinations:

Applicant is allowed until **THIRTY DAYS** from the mailing date of this order to review the responses previously provided to opposer's interrogatories, and supplement any deficient responses, retracting any unjustified objections, and answering with full narrative

retain counsel at any future point during this proceeding, applicant should promptly notify the Board.

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responses. Additionally, applicant is allowed the same **THIRTY DAYS** to respond to opposer's outstanding document requests.² Applicant would be well-advised to review the information provided below regarding responding to interrogatories and document requests and the cited sections of the Trademark Board Manual of Procedure ("TBMP").

Should applicant fail to meet its obligations within the dates set out in this order, opposer is invited to file a motion to compel to satisfy its discovery needs.

Finally, the parties' stipulated motion to extend the discovery period by **FORTY-FIVE** days in light of applicant's recent change in representation is **GRANTED**. Dates are reset as follows:

Discovery Closes	12/1/2013
Plaintiff's Pretrial Disclosures	1/15/2014
Plaintiff's 30-day Trial Period Ends	3/1/2014
Defendant's Pretrial Disclosures	3/16/2014
Defendant's 30-day Trial Period Ends	4/30/2014
Plaintiff's Rebuttal Disclosures	5/15/2014
Plaintiff's 15-day Rebuttal Period Ends	6/14/2014

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

² As discussed during the telephone conference, opposer should promptly, but no later than **FIVE DAYS** from the mailing date of this order, provide applicant with a copy of the outstanding set of interrogatories and document requests, noting which interrogatories remain at issue.

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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.

Interrogatories

Ordinarily, a party on which interrogatories have been served should respond to them by stating, with respect to each interrogatory, either an answer or an objection. If an interrogatory is answered, the answer must be made separately and fully, in writing under oath. If an interrogatory is objected to, the reasons for objection must be stated in lieu of an answer. Fed. R. Civ. P. 33(b)(3), (b)(4); TBMP § 405.04(b) (3d ed. rev. 2013). Objections based on confidentiality are expected to be extremely limited because the Board's standard protective order is automatically instituted for all Board *inter partes* proceedings. See Trademark Rule 2.116(g).

The Board prefers that the responding party reproduce each interrogatory immediately preceding the answer or objection thereto.

The duty to supplement disclosures and discovery responses in proceedings before the Board is governed by Fed. R. Civ. P. 26(e)(1) and (2). See Trademark Rule

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2.116(a). Under that rule, a party that has made an initial or expert disclosure or has responded to a request for discovery with a response is under a duty to supplement or correct the response in a timely manner to include information under the particular circumstances specified in paragraphs (e)(1) and (2). See *Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1326-27 (TTAB 2011) (opposer was under a duty to supplement its discovery responses and disclosing for the first time in its pretrial and amended pretrial disclosures the identities of twenty-seven witnesses resulted in surprise to applicant). In addition, as in the present case, a duty to supplement disclosures or responses may be imposed by order of the Board. See *Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d 1175, 1179 (TTAB 2010).

Document Requests

A party served with a request for documents has a duty to thoroughly search its records for all information properly sought in the request, and to provide such information to the requesting party within the time allowed for responding to the request. See *No Fear Inc. v. Rule*, 54 USPQ2d 1551 (TTAB 2000). A proper written response to a document request requires the responding party to state whether responsive documents exist or not, and if so, that

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either they will be produced or will be withheld on a claim of privilege; or the party may raise an appropriate objection. *Id.* at 1556.

The place of production is governed by Trademark Rule 2.120(d)(2). *See Elec. Indus. Ass'n v. Potega*, 50 USPQ2d 1775, 1777 (TTAB 1998). A party is only obliged to make documents and materials available for inspection and copying, where the documents are stored, and as they are kept in the ordinary course of business, *No Fear Inc.*, 54 USPQ2d at 1555, or as organized and labeled to correspond to the requests. Fed. R. Civ. P. 34(b)(2)(E)(i). However, in Board cases, parties often extend each other the courtesy of producing requested documents by copying the documents and forwarding them to the requesting party at the requesting party's expense. *See No Fear Inc.*, 54 USPQ2d at 1555. Indeed, the Board believes this is more efficient and thus encourages this method of producing documents. *Id.*

Applicant was cautioned during the telephone conference that opposer may seek to preclude applicant from relying on information, documents, or witnesses which should have been produced or identified in response to any of opposer's discovery requests, but were not. *See Panda Travel Inc., v. Resort Option Enters., Inc.*, 94 USPQ2d

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1789, 1792 (TTAB 2009); *Quality Candy Shoppes/Buddy Squirrel of Wisconsin Inc. v. Grande Foods*, 90 USPQ2d 1389, 1392 (TTAB 2007); *Presto Prods. Inc. v. Nice-Pak Prods. Inc.*, 9 USPQ2d 1895, 1896 n.5 (TTAB 1988); TBMP § 527.01(e).

Discovery

The purpose of discovery is to advance the case by requiring parties to share certain relevant information upon request, so that the issues for trial may be focused and the case may proceed in an orderly manner within reasonable time constraints. An opposition before the Board is similar in many ways to a civil action in a Federal district court. There are pleadings (notice of opposition, answers, and, sometimes, a counterclaim), a wide range of possible motions; 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.

Unlike the case in a civil proceeding, the Board does not preside at the taking of testimony. Rather, all testimony is taken by deposition during the assigned testimony, or trial, periods, and the written transcripts,

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together with any exhibits, 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. See TBMP § 703.

PRO SE INFORMATION

A. Representation

The Board notes that applicant currently represents itself *pro se*, i.e. without assistance from a licensed attorney. It should be noted that, while Patent and Trademark Rule 11.14 permits any party to represent itself, it is 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 it may provide general procedural information.

B. Electronic Resources

All parties may refer to the Trademark Trial and Appeal Board Manual of Procedure ("TBMP"), the Trademark Act, and the Trademark Rules of Practice, all available on the USPTO website, www.uspto.gov. The TTAB homepage

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provides electronic access to the Board's standard protective order, and answers to frequently asked questions. Other useful resources include the ESTTA filing system³ for Board filings and TTABVUE for status and prosecution history.

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.

C. Service of Papers

Trademark Rule 2.119(a) and (b) 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 the other party itself, if unrepresented, and proof of such service must be made before the paper will be considered by the Board.

³ Use of electronic filing with ESTTA—as the parties have done so far—is strongly encouraged. This electronic file system operates in real time and provides filers with confirmation that the filing has been received. When papers are filed through ESTTA the papers must still be served on the other party to the proceeding.

If the parties have questions about or need assistance with ESTTA, they may call the Board at (571) 272-8500 or (800) 786-9199 (toll free) from 8:30 a.m. until 5:00 p.m. (EST).

While electronic filing is preferred, papers may also be filed by mail. The parties should refer to TBMP §§ 107-111 for information on filing by mail. If ESTTA filing is not possible for any reason, the filer should submit its papers by mail, with a certificate of mailing. See TBMP § 110 et. seq.

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Consequently, copies of all papers which applicant may file in this proceeding must be accompanied by a signed statement indicating the date and manner in which such service was made. The statement, whether attached to or appearing on the paper when filed, will be accepted as *prima facie* proof of service.

The following is an example of an acceptable Certificate of Service:

Certificate of Service

The undersigned certifies that a copy of the attached <describe filing> was served, by first class mail, upon opposer at the following address:

Steven A Abreu
Sunstein Kann Murphy Timbers LLP
125 Summer Street
Boston, MA 02110-1618,

on <insert date>.

/Henry Cheatham/