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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91207428
Party	Plaintiff Texas Children's Hospital
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Attachments	Mtn to Compel Discovery.pdf (18 pages)(106635 bytes) Ex 1 - Appl UT Resp to Opp TCH RFP.pdf (31 pages)(143334 bytes) Ex. 2 - Appl UT Resp to Opp TCH Rogs.pdf (12 pages)(1477407 bytes) Ex. 3 - Appl UT Priv Log.pdf (4 pages)(517392 bytes) Ex. 4 - Amazon.pdf (5 pages)(82579 bytes) Ex. 5 - Pep Boys.pdf (5 pages)(80780 bytes) Ex. 6 - Upjohn.pdf (11 pages)(155711 bytes) Ex. 7 - Fisher.pdf (22 pages)(236579 bytes) Ex. 8 - DK Jain.pdf (9 pages)(110379 bytes) Ex. 9 - Huber Suhner.pdf (11 pages)(60659 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 85/431,881
Published in the Official Gazette on September 11, 2012

<i>TEXAS CHILDREN’S HOSPITAL, INC.,</i>	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No. 91/207,428
	:	
<i>U.T. PHYSICIANS,</i>	:	
	:	
Applicant.	:	

**OPPOSER’S MOTION TO COMPEL SUPPLEMENTATION OF APPLICANT’S
WRITTEN RESPONSE TO OPPOSER’S AMENDED FIRST SET OF REQUESTS FOR
THE PRODUCTION, APPLICANT’S WRITTEN RESPONSE TO OPPOSER’S
AMENDED FIRST SET OF INTERROGATORIES TO APPLICANT, AND APPLICANT
U.T. PHYSICIANS’ PRIVILEGE LOG**

Comes Now, Texas Children’s Hospital (“TCH” or “Opposer”) and files this Motion to Compel Supplementation of Applicant’s Written Response to Opposer’s Amended First Set of Requests for the Production (Exhibit 1), Applicant’s Written Response to Opposer’s Amended First Set of Interrogatories to Applicant (Exhibit 2), and Applicant U.T. Physicians’ Privilege Log (Exhibit 3).

I. ISSUES TO BE DECIDED

Are the responses in Applicant’s Written Response to Opposer’s Amended First Set of Requests for the Production (Exhibit 1) insufficient and do the responses require supplementation?

Are the responses in Applicant’s Written Response to Opposer’s Amended First Set of Interrogatories to Applicant (Exhibit 2) insufficient and do the responses require supplementation?

Are the entries in Applicant U.T. Physicians' Privilege Log (Exhibit 3) insufficient and do the responses require supplementation?

II. STATEMENT OF FACTS

Opposer's first use and first use in commerce of the mark TEXAS CHILDREN'S FETAL CENTER was on May 13, 2007.

Applicant filed a trademark application (85/431,881) for the mark TEXAS FETAL CENTER on September 26, 2012 based on Applicant's intent to use the mark.

Opposer filed a trademark application (85/693,602) for the mark TEXAS CHILDREN'S FETAL CENTER on August 2, 2012.

Applicant's mark published for opposition on September 11, 2012.

Opposer filed a Notice of Opposition on October 10, 2012.

Applicant filed an Answer in Opposition No. 91/207,428 on November 29, 2012.

Opposer and Applicant executed a Joint Stipulation to Waive Initial Disclosures on January 16, 2013.

Opposer served Requests for Production on January 18, 2013.

Opposer served Interrogatories on January 18, 2013.

Opposer served Amended Requests for Production on January 31, 2013.

Opposer served Interrogatories on January 31, 2013.

Applicant served Requests for Production on February 20, 2013.

Applicant served Interrogatories on February 20, 2013.

Applicant responded to Amended Requests for Production on March 4, 2013.

Applicant responded to Interrogatories on March 4, 2013.

Opposer responded to Requests for Production on March 29, 2013.

Opposer responded to Interrogatories on March 29, 2013.

Applicant served its Privilege Log on April 1, 2013.

III. LEGAL STANDARDS

A. Requests for Production

Requests for Production are covered by Fed. R. Civ. P. 34 and at least the case law discussed in the Argument below.

B. Interrogatories

Interrogatories are covered by Fed. R. Civ. P. 33 and at least the case law discussed in the Argument below.

C. Privilege Logs

Privilege logs are covered by Fed. R. Civ. P. 26(b)(5) and the case law in this section and the Argument below.

The TTAB has noted the requirements for a privilege log. *Amazon Technologies, Inc. v. Jeffrey S. Wax*, Opposition No. 91187118 at n. 6 (TTAB November 4, 2009) (Exhibit 4) (stating “Of course, to the extent opposer maintains its objections based on the attorney-client privilege or attorney work product doctrine, it must produce a privilege log. Fed. R. Civ. P. 26(b)(5)(A)(ii).¹”). Attorney-client privilege protects communications between a client and their attorney for seeking legal advice. *The Pep Boys Manny, Moe & Jack of California v. Teera Hanharutaivan and Krieng Wongtangjai*, Opposition No. 105,133, 2002 TTAB LEXIS 552 (TTAB August 28, 2002) (not precedential) (Exhibit 5) (“The purpose of the attorney-client

¹ Fed. R. Civ. P. 26(b)(5)(A)(ii).

(5) Claiming Privilege or Protecting Trial-Preparation Materials.

(A) Information Withheld. When a party withholds information otherwise discoverable by claiming that the information is privileged or subject to protection as trial-preparation material, the party must:

(i) expressly make the claim; and

(ii) *describe the nature of the documents, communications, or tangible things not produced or disclosed*—and do so in a manner that, without revealing information itself privileged or protected, will *enable other parties to assess the claim*. (emphasis added).

privilege is to encourage full and frank communication between attorneys and their clients by assuring clients that their disclosures will be held in confidence. *Upjohn Co. v. United States*, 449 U.S. 383, 389 (1981) (Exhibit 6); and *Fisher v. United States*, 425 U.S. 391, 403 (1976) (Exhibit 7). The privilege protects communications made in confidence by clients to their lawyers for the purpose of obtaining legal advice. *Upjohn*, 449 U.S. at 395 n7 (Exhibit 6); *Fisher*, 425 U.S. at 403” (Exhibit 7).

IV. ARGUMENT

Applicant’s Written Response to Opposer’s Amended First Set of Requests for the Production (Exhibit 1), Applicant’s Written Response to Opposer’s Amended First Set of Interrogatories to Applicant (Exhibit 2), and Applicant U.T. Physicians’ Privilege Log (Exhibit 3) are insufficient. Opposer TCH hereby prays that the Court order Applicant to supplement their responses and privilege log.

A. Supplementation of Applicant’s Responses to Opposer’s Requests for Production is Necessary

Requests for Production 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, and 25 the pricing and cost of advertising and creation are relevant to this Opposition and Applicant’s Responses require supplementation. (Exhibit 1); *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147, 148 (TTAB 1985); *Neville Chemical Co. v. The Lubrizol Corp.*, 183 USPQ 184, 1974 TTAB LEXIS 110 at *20 (TTAB June 14, 1974) (“opposer can satisfy applicant's discovery needs in such event by preparing, from its records, a listing of its advertising and promotional expenses, in approximate figures, in connection with the mark "LX" for each of the years since the first advertisement or promotion thereof”); *Johnson & Johnson v. Diamond Medical, Inc.*, 183 USPQ 615, 1974 TTAB LEXIS 156, *8-9 (TTAB Sept. 24, 1974) (“it appears that the material requested may be relevant to the issue of likelihood of confusion, it is adjudged that the

following should be produced for inspection and/or copying . . . 3. As to the request that applicant furnish figures of advertising expenditures incurred in promoting the mark for goods identified in the application, round figures in the thousands of dollars during the years of use since 1971 are deemed sufficient to serve the needs of opposer.”); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167 (TTAB 1975); *Huber + Suhner Ltd. V. Champlain Cable Corp.*, Opposition No. 91166320 at *4 (TTAB December 31, 2009) (Exhibit 9) (“applicant must also clarify whether an advertising agency is involved in the creation of its product information sheets and/or any website advertising.” and “Applicant must clarify whether it provides advertising on its website and, to the extent it does so, applicant must (i) explain to opposer how advertising is conducted via the website, e.g. hyperlinks to product information sheets or single-page product summaries, and (ii) provide the annual costs of said advertising”); and *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 123 (TTAB 1974). Applicant’s Response to Interrogatory 14, regarding the total number of dollars spent in advertisements containing the Applicant’s Mark requires supplementation for the same reasons as above. Moreover, discovery is allowed on any matter that may serve as a basis for an affirmative defense or counterclaim or is reasonably calculated to lead to the discovery of admissible evidence. *Neville Chemical Co. v. The Lubrizol Corp.*, 183 USPQ 184, 1974 TTAB LEXIS 110 at *3-4 (TTAB June 14, 1974). Likewise, discovery is allowed on any matter that might serve as the basis for an additional claim. *Id.*

Applicant’s Responses to Requests for Production 28, 29, 30, 31, and 67 for communications related to the creation, adoption, design, and development of Applicant’s Mark respectively as well as all documents related to trademark searches related to Applicant’s Mark are within the scope of discovery require supplementation. (Exhibit 1); *Neville Chemical Co. v. The Lubrizol Corp.*, 183 USPQ 184, 1974 TTAB LEXIS 110 at *20-21 (TTAB June 14, 1974)

(“oppose must produce those documents pertaining to applications to register, in the United States Patent Office, the mark “LX” in connection with any of the goods listed in the notice of opposition.”); *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147, 148 (TTAB 1985); *Volkswagenwerk Aktiengesellschaft v. MTD Products, Inc.*, Opposition No. 54,211, 181 USPQ 471, 473 (TTAB Mar. 28, 1974) (“opposer requests that applicant furnish the names and business addresses of the person or persons who first suggested use by applicant of the mark “MUD BUG”. . . the question is not improper if it is limited to applicant's mark “MUD BUG” for all-terrain vehicles.” and “whether applicant has at any time sought a legal opinion with respect to its use of the mark “MUD BUG” is likewise deemed to be relevant, and the interrogatory is accordingly proper”); *American Optical Corp. v. Exomet, Inc.*, Opposition No. 54,396, 181 USPQ 120, 123-24 (TTAB Feb. 13, 1974) (“opposer has asked applicant to identify, by name, title and address, the person or persons having material knowledge of applicant's adoption and use of its mark. Applicant has objected to the interrogatory on the ground that it is vague and indefinite. Applicant has nevertheless gone on to say that Darrell Maukonen and Michael Bock II are the persons having most knowledge of the adoption and use of applicant's mark. This is construed to be an adequate response to the interrogatory and applicant's objection is therefore sustained.” and “a trademark search report and comments and/or opinions relating thereto are not deemed to be privileged information within the context of the criteria set forth in the above-noted Federal Rules of Civil Procedure”); and *Johnson & Johnson v. Diamond Medical, Inc.*, 183 USPQ 615, 1974 TTAB LEXIS 156, *8-9 (TTAB Sept. 24, 1974) (“since it appears that the material requested may be relevant to the issue of likelihood of confusion, it is adjudged that the following should be produced for inspection and/or copying. 1. Trademark search reports, if any, made preceding the filing of the application”); *Johnson & Johnson v. Rexall Drug Co.*, 186

USPQ 167 (TTAB 1975); *TBC Corp. v. Grand Prix Ltd.*, 16 USPQ2d 1399, 1400 (TTAB 1990); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988); *Miles Laboratories, Inc. v. Instrumentation Laboratory, Inc.*, 185 USPQ 432, 434 (TTAB 1975); *Van Dyk Research Corp. v. Xerox Corp.*, 181 USPQ 346, 348 (TTAB 1974); and *Fisons Ltd. v. Capability Brown Ltd.*, 209 USPQ 167, 170-71 (TTAB 1980).

Regarding Request 34, response to this Request is not an undue burden. *D.K. Jain v. Ramparts, Inc.*, Opposition No. 98,307, 1998 TTAB LEXIS 433 at *16-17 (TTAB Nov. 30, 1998) (Exhibit 8) (“INTERROGATORY NO. 10: (a) Explain how Applicant's mark is used and promoted to create a public perception of the Mark as an indication of source. (b) Identify the documents that evidence, refer to or otherwise relate to your response to subparagraph (a) of this interrogatory. . . .the Board finds that applicant has failed to establish that it would be unduly burdensome for applicant to provide written answers to these interrogatories.”). (Exhibit 1).

Supplementation of the Responses to Requests 35, 36, 37, 37, 38, and 39 relating to use of the mark, good and services sold under the mark, and the market for the mark is required. (Exhibit 1); *Neville Chemical Co. v. The Lubrizol Corp.*, 183 USPQ 184, 1974 TTAB LEXIS 110 (TTAB June 14, 1974); *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147, 148 (TTAB 1985); *American Optical Corp. v. Exomet, Inc.*, Opposition No. 54,396, 181 USPQ 120, 123-24 (TTAB Feb. 13, 1974) (“opposer has asked applicant to identify, by name, title and address, the person or persons having material knowledge of applicant's adoption and use of its mark. Applicant has objected to the interrogatory on the ground that it is vague and indefinite. Applicant has nevertheless gone on to say that Darrell Maukonen and Michael Bock II are the persons having most knowledge of the adoption and use of applicant's mark. This is construed to be an adequate response to the interrogatory and applicant's objection is therefore sustained.” and

“a trademark search report and comments and/or opinions relating thereto are not deemed to be privileged information within the context of the criteria set forth in the above-noted Federal Rules of Civil Procedure”); and *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167 (TTAB 1975).

The Responses to Requests 42, 43, 44, 45 require supplementation. (Exhibit 1). *Neville Chemical Co. v. The Lubrizol Corp.*, 183 USPQ 184, 1974 TTAB LEXIS 110 at *20-21 (TTAB June 14, 1974) (“oppose must produce those documents pertaining to applications to register, in the United States Patent Office, the mark “LX” in connection with any of the goods listed in the notice of opposition.”); *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147, 148 (TTAB 1985); *American Optical Corp. v. Exomet, Inc.*, Opposition No. 54,396, 181 USPQ 120, 123-24 (TTAB Feb. 13, 1974) (“opposer has asked applicant to identify, by name, title and address, the person or persons having material knowledge of applicant's adoption and use of its mark. Applicant has objected to the interrogatory on the ground that it is vague and indefinite. Applicant has nevertheless gone on to say that Darrell Maukonen and Michael Bock II are the persons having most knowledge of the adoption and use of applicant's mark. This is construed to be an adequate response to the interrogatory and applicant's objection is therefore sustained.” and “a trademark search report and comments and/or opinions relating thereto are not deemed to be privileged information within the context of the criteria set forth in the above-noted Federal Rules of Civil Procedure”); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167 (TTAB 1975); *TBC Corp. v. Grand Prix Ltd.*, 16 USPQ2d 1399, 1400 (TTAB 1990); and *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988).

Applicant’s Response to Request No. 47 regarding all documents related to U.T. Physician’s right to use Applicant’s Mark must be supplemented for at least the reasons stated in

American Optical (opinions relating to a trademark search report) and *Volkswagenwerk* (whether applicant has sought a legal opinion with respect to the use of its mark). (Exhibit 1); *American Optical Corp. v. Exomet, Inc.*, Opposition No. 54,396, 181 USPQ 120, 123-24 (TTAB Feb. 13, 1974); *Volkswagenwerk Aktiengesellschaft v. MTD Products, Inc.*, Opposition No. 54,211, 181 USPQ 471, 473 (TTAB Mar. 28, 1974); *Neville Chemical Co. v. The Lubrizol Corp.*, 183 USPQ 184, 1974 TTAB LEXIS 110 (TTAB June 14, 1974); *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147, 148 (TTAB 1985); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167 (TTAB 1975); *TBC Corp. v. Grand Prix Ltd.*, 16 USPQ2d 1399, 1400 (TTAB 1990); and *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988).

The Response to Request 56, regarding all documents related to surveys of the Applicant's Mark requires supplementation. (Exhibit 1); *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America, Inc.*, Opposition No. 91125458 at *19-21, 74 USPQ2d 1672 (TTAB April 27, 2005) ("parties have been found to have a legal right to obtain requested documents that have been turned over to the party's attorney, its insurer, a related company, or a former employee who receives compensation" and "to the extent that the requested supplemental documents are under Pioneer's control as the party commissioning the survey, Pioneer is ordered to serve Hitachi with copies of any documents responsive to Document Request Nos. 32, 36, and 37"²).

²*Pioneer Kabushiki Kaisha v. Hitachi High Technologies America, Inc.*, Opposition No. 91125458 at *16-17 (TTAB April 27, 2005)

("Document Request No. 32

All documents referring or relating to any survey or study Opposer has conducted or has caused to be conducted regarding recognition of or reaction to Opposer's mark or Applicant's Mark, or any confusion among the marks.

Document Request No. 36

All documents and things reviewed, exchanged with, sent to, or relied upon by any expert retained by Opposer in relation to this opposition proceeding.

Document Request No. 37

The fact that materials were prepared for trial or by an attorney does not prohibit production of those materials. *American Optical Corp. v. Exomet, Inc.*, *Opposition No. 54,396*, 181 USPQ 120, 124 (TTAB Feb. 13, 1974) (“Rule 26(b)(3) asserts that a party may obtain discovery of documents and tangible things prepared in anticipation of litigation or for trial by or for another party or by or for that other party's attorney upon a showing that the party seeking discovery has substantial need of the materials in the preparation of his case and that he is unable without undue hardship to obtain the substantial equivalent of the materials by other means.”). The Responses to Requests 69, 70, 71, and 72 state that “a full and complete response calls for production of documents that are beyond the scope of discovery pursuant to...the civil rules concerning the production of trial preparation materials”. (Exhibit 1) The Responses to Requests 69, 70, 71, and 72 require supplementation as based on *American Optical*, the fact that the communications were prepared in anticipation of litigation or for trial does not prohibit the production of those materials. (Exhibit 1); *See Neville Chemical Co. v. The Lubrizol Corp.*, 183 USPQ 184, 1974 TTAB LEXIS 110 (TTAB June 14, 1974); *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147, 148 (TTAB 1985); *American Optical Corp. v. Exomet, Inc.*, *Opposition No. 54,396*, 181 USPQ 120, 123-24 (TTAB Feb. 13, 1974); and *Johnson & Johnson v. Diamond Medical, Inc.*, 183 USPQ 615, 1974 TTAB LEXIS 156, *8-9 (TTAB Sept. 24, 1974) (“since it appears that the material requested may be relevant to the issue of likelihood of confusion, it is adjudged that the following should be produced for inspection and/or copying. 1. Trademark search reports, if any, made preceding the filing of the application”); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167 (TTAB 1975); *TBC Corp. v. Grand Prix Ltd.*, 16 USPQ2d 1399, 1400 (TTAB 1990); *Johnston Pump/General Valve Inc. v. Chromalloy American*

All documents and things to be utilized by any expert witness in any testimony connected with this opposition proceeding.”)

Corp., 10 USPQ2d 1671, 1675 (TTAB 1988); *Miles Laboratories, Inc. v. Instrumentation Laboratory, Inc.*, 185 USPQ 432, 434 (TTAB 1975); *Van Dyk Research Corp. v. Xerox Corp.*, 181 USPQ 346, 348 (TTAB 1974); and *Fisons Ltd. v. Capability Brown Ltd.*, 209 USPQ 167, 170-71 (TTAB 1980).

The Responses to Requests 73, 74, 75, 76, and 77 require supplementation. These Request relate to employment files of and documents related to Dr. Anthony Johnson and Dr. Kenneth J. Moise. (Exhibit 1). The Request also relate to documents related to Dr. Michael Belfort. .Exhibit 1). Moreover, discovery is allowed on any matter that may serve as a basis for an affirmative defense or counterclaim or is reasonably calculated to lead to the discovery of admissible evidence. *Neville Chemical Co. v. The Lubrizol Corp.*, 183 USPQ 184, 1974 TTAB LEXIS 110 at *3-4 (TTAB June 14, 1974) and *Johnson & Johnson v. Diamond Medical, Inc.*, 183 USPQ 615, 1974 TTAB LEXIS 156, *8-9 (TTAB Sept. 24, 1974) (“since it appears that the material requested may be relevant to the issue of likelihood of confusion, it is adjudged that the following should be produced for inspection and/or copying.”).

The Response to Request 79 requires supplementation. (Exhibit 1) Request 79 states “please produce all documents related to the intended audience for Applicant’s Mark.” The opinion in *D.K. Jain* requires production on how the mark is used and promoted, as well as documents that evidence the use and promotion. *D.K. Jain v. Ramparts, Inc.*, Opposition No. 98,307, 1998 TTAB LEXIS 433 at *16-17 (TTAB Nov. 30, 1998) (Exhibit 8). The opinion in *D.K. Jain* also requires a description of “the circumstances of such first use, including the manner of use, the details of any sale involved, the type and/or class of customers, the trade, sale and/or distribution channels, number of units sold, and price charged”. *D.K. Jain v. Ramparts, Inc.*, Opposition No. 98,307, 1998 TTAB LEXIS 433 at *22-23 (TTAB Nov. 30, 1998) (Exhibit

8). The opinion in *Huber + Suhner* requires that applicant must provide “documents in its custody, possession or control which show geographic areas of distribution of the involved goods sold in connection with the RADXL mark and specific classes of customers for said goods.” *Huber + Suhner Ltd. v. Champlain Cable Corp.*, Opposition No. 91166320 at *7 (TTAB December 31, 2009) (Exhibit 9). Other cases support the production of the documents requested in Request 29. *See Neville Chemical Co. v. The Lubrizol Corp.*, 183 USPQ 184, 1974 TTAB LEXIS 110 (TTAB June 14, 1974); *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147, 148 (TTAB 1985); *American Optical Corp. v. Exomet, Inc.*, Opposition No. 54,396, 181 USPQ 120, 123-24 (TTAB Feb. 13, 1974); and *Johnson & Johnson v. Diamond Medical, Inc.*, 183 USPQ 615, 1974 TTAB LEXIS 156, *8-9 (TTAB Sept. 24, 1974) (“since it appears that the material requested may be relevant to the issue of likelihood of confusion, it is adjudged that the following should be produced for inspection and/or copying. 1. Trademark search reports, if any, made preceding the filing of the application”); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167 (TTAB 1975); *TBC Corp. v. Grand Prix Ltd.*, 16 USPQ2d 1399, 1400 (TTAB 1990); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988).

Applicant’s Responses to Request 80 requires supplementation. Request 80 requests production of a complete description of services offered under Applicant’s Mark. (Exhibit 1); *Neville Chemical Co. v. The Lubrizol Corp.*, 183 USPQ 184, 1974 TTAB LEXIS 110 at *3-4 (TTAB June 14, 1974) (“Opposer again has answered by referring applicant to one of opposer’s publications, and applicant again objects that this leaves applicant to speculate as to the nature of opposer’s goods. applicant maintains that it simply wants to know the intended uses of opposer’s hydrocarbon resins, and no reason is seen why opposer should not furnish this

information to applicant. Interrogatories 14, 15 and 16 must similarly be specifically answered. Accordingly, applicant's motion to compel answer to interrogatories is granted . . .”).

The Responses to Requests 81, 82, 83, and 84 require supplementation. (Exhibit 1). Requests relate to communications related to the description of services offered under Applicant's Mark, and all documents and communications used or referred to in responding to Interrogatories 1, 2, or 3. (Exhibit 1). The Responses require supplementation as based on *American Optical*, the fact that the communications were prepared in anticipation of litigation or for trial does not prohibit the production of those materials. *American Optical Corp. v. Exomet, Inc.*, Opposition No. 54,396, 181 USPQ 120, 123-24 (TTAB Feb. 13, 1974); *Neville Chemical Co. v. The Lubrizol Corp.*, 183 USPQ 184, 1974 TTAB LEXIS 110 (TTAB June 14, 1974); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167,171 (TTAB 1975); *TBC Corp. v. Grand Prix Ltd.*, 16 USPQ2d 1399, 1400 (TTAB 1990); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988).

The Responses to Request 88, 92, 93, 96, 98, 99, 100, 101, 102, 103, 104, 105, 107, and 109 relating to all documents and communications used or referred to in responding to Interrogatories 7, 11, 12, 15, 17, 18, 19, 20, 21, 22, 23, 24, 26, and 28, require supplementation. (Exhibit 1). The Responses requires supplementation based on *American Optical*, the fact that the communications were prepared in anticipation of litigation or for trial does not prohibit the production of those materials. *American Optical Corp. v. Exomet, Inc.*, Opposition No. 54,396, 181 USPQ 120, 123-24 (TTAB Feb. 13, 1974).

The Responses to Requests 108, 110, 111, and 112, relating to all documents and communications used or referred to in responding to Interrogatories 27, 29, 30, and 31, require supplementation. (Exhibit 1). Regarding Responses 108 and 112, discovery is allowed on any

matter that may serve as a basis for an affirmative defense or counterclaim or is reasonably calculated to lead to the discovery of admissible evidence. *Neville Chemical Co. v. The Lubrizol Corp.*, 183 USPQ 184, 1974 TTAB LEXIS 110 at *3-4 (TTAB June 14, 1974). Regarding Responses 110 and 111, it is necessary for Applicant to disclose how UT Physicians first became aware of Opposer's Mark. *Neville Chemical Co. v. The Lubrizol Corp.*, 183 USPQ 184, 1974 TTAB LEXIS 110 at *5 (TTAB June 14, 1974) ("opposer need answer interrogatory 3 only to the extent of stating when and how it first became aware of applicant's use of "LZ" as a trademark for the goods listed in its application").

B. Supplementation of Applicant's Responses to Opposer's Interrogatories is Necessary

Applicant's Responses to Interrogatories 1, 2, and 3 require supplementation. (Exhibit 2); *Neville Chemical Co. v. The Lubrizol Corp.*, 183 USPQ 184, 1974 TTAB LEXIS 110 at *3-4 (TTAB June 14, 1974) ("Opposer again has answered by referring applicant to one of opposer's publications, and applicant again objects that this leaves applicant to speculate as to the nature of opposer's goods. applicant maintains that it simply wants to know the intended uses of opposer's hydrocarbon resins, and no reason is seen why opposer should not furnish this information to applicant. Interrogatories 14, 15 and 16 must similarly be specifically answered. Accordingly, applicant's motion to compel answer to interrogatories is granted . . .").

Applicant's Response to Interrogatory 14, regarding the total number of dollars spent in advertisements containing the Applicant's Mark requires supplementation for the same reasons as above. (Exhibit 2). Moreover, discovery is allowed on any matter that may serve as a basis for an affirmative defense or counterclaim or is reasonably calculated to lead to the discovery of admissible evidence. *Neville Chemical Co. v. The Lubrizol Corp.*, 183 USPQ 184, 1974 TTAB LEXIS 110 at *3-4 (TTAB June 14, 1974).

Applicant's Responses to Interrogatory 17, 18, 19, and 20, regarding identification of persons responsible for the creation, adoption, design and development of Applicant's Mark, require supplementation. (Exhibit 2); *Volkswagenwerk Aktiengesellschaft v. MTD Products, Inc.*, Opposition No. 54,211, 181 USPQ 471, 473 (TTAB Mar. 28, 1974) ("opposer requests that applicant furnish the names and business addresses of the person or persons who first suggested use by applicant of the mark "MUD BUG". . . the question is not improper if it is limited to applicant's mark "MUD BUG" for all-terrain vehicles." and "whether applicant has at any time sought a legal opinion with respect to its use of the mark "MUD BUG" is likewise deemed to be relevant, and the interrogatory is accordingly proper"); *American Optical Corp. v. Exomet, Inc.*, *Opposition No. 54,396*, 181 USPQ 120, 124 (TTAB Feb. 13, 1974) ("opposer has asked applicant to identify, by name, title and address, the person or persons having material knowledge of applicant's adoption and use of its mark. Applicant has objected to the interrogatory on the ground that it is vague and indefinite. Applicant has nevertheless gone on to say that Darrell Maukonen and Michael Bock II are the persons having most knowledge of the adoption and use of applicant's mark. This is construed to be an adequate response to the interrogatory and applicant's objection is therefore sustained.")

Regarding Interrogatory 29, related to identifying with particularity the date and circumstances of Applicant UT Physicians first awareness of Opposer TCH's Mark, Applicant is required to identify the date and circumstances of its awareness of Opposer's Mark. (Exhibit 2); *Neville Chemical Co. v. The Lubrizol Corp.*, 183 USPQ 184, 1974 TTAB LEXIS 110 at *5 (TTAB June 14, 1974) ("opposer need answer interrogatory 3 only to the extent of stating when and how it first became aware of applicant's use of "LZ" as a trademark for the goods listed in its application"). The Response does not state the date or particular circumstances of UT Physicians

first awareness of Opposer's Mark. Based on Applicant's Response, it is clear that Anthony Johnson, Kenneth Moise, and Karen Moise were not employees of UT Physicians at the time they became aware of Opposer's Mark. These individuals were employees or associated with the Opposer and therefore would have become aware of Opposer's Mark during their employ or association with Opposer. Interrogatory 29 asks the date and circumstances of *UT Physicians* (defined in the Definitions section of Schedule A to the Interrogatories as "the 501(c)(3) organization that is the clinical practice of The University of Texas Medical School at Houston with hospital affiliations at Memorial Hermann – Texas Medical Center and Children's Memorial Hermann Hospital and others") first awareness of Opposer's Mark. (emphasis added) (Exhibit 2).

C. Supplementation of Applicant's Privilege Log is Necessary

Applicant's privilege log does not comply with Fed. R. Civ. P. 26(b)(5)(A)(ii) and therefore requires supplementation. (Exhibit 3). The text in the subject column of Applicant's Privilege Log does not *describe the nature of the documents, communications, or tangible things not produced or disclosed* and in a sufficient manner to enable Opposer *to assess the claim of privilege*. Fed. R. Civ. P. 26(b)(5)(A)(ii).

Moreover, at least two entries in Applicant's Privilege Log do not list an attorney as sending or receiving the email. Exhibit 3, Entry 1, dated 9/12/2011 is from Susan Distefano, CEO of Children's Memorial Hermann to Andrew Casas, COO and VP of U.T. Physicians. Amanda Spielman, Chief of Hospital Operations for Memorial Hermann, is an additional recipient. None of the above are attorneys or an attorney's agent. Exhibit 3; Entry 32, dated 7/18/2012 is from Tracy Fry-Longoria, Chief Ambulatory Care Officer at U.T. Physicians, to Sean Blackwell, Chair of the Department of Obstetrics, Gynecology and Reproductive Sciences at UTHealth Medical School, KuoJen Tsao, Assistant Professor at UTHealth Medical School,

and Andrew Casas, COO and V.P. of U.T. Physicians. None of the above are attorneys or an attorney's agent. A communication or document is not rendered privileged even if it is later forwarded to an attorney. *The Goodyear Tire & Rubber Co. v. Uniroyal, Inc.*, 183 USPQ 372, 1974 TTAB LEXIS 122 at *12 (TTAB Sept. 18, 1974) ("A document, the production of which may otherwise be required, may not be rendered privileged by delivering it to the attorney for one of the parties. (citations omitted)").

V. CONCLUSION

TCH respectfully prays that this Court grant this Motion to Compel and order Applicant U.T. Physicians to supplement Applicant's Written Response to Opposer's Amended First Set of Requests for the Production, Applicant's Written Response to Opposer's Amended First Set of Interrogatories to Applicant, and Applicant U.T. Physicians' Privilege Log.

Respectfully submitted,

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Attorney for Opposer
Texas Children's Hospital, Inc.

CERTIFICATE OF CONFERENCE

Counsel for Opposer first notified Applicant on March 27, 2013 of the deficiencies in Applicants Responses. Counsel for Applicant would not supplement responses at that time. Opposer has been awaiting additional production for over 4 weeks. Counsel for the Opposer contacted counsel for the Applicant on April 30, 2013 concerning supplementation of Applicant's Written Response to Opposer's Amended First Set of Requests for the Production, Applicant's Written Response to Opposer's Amended First Set of Interrogatories to Applicant, and Applicant U.T. Physicians' Privilege Log. As of May 1, 2013, no further documents had been produced by Applicant. Opposer needs the documents as soon as possible and has already waited for over 4 weeks.

/William P. Ramey, III/
Counsel for Opposer
Texas Children's Hospital, Inc.

CERTIFICATE OF SERVICE

A copy of the foregoing Motion to Compel was served, by agreement of the parties, via e-mail to RRundelli@Calfee.com, this 1st day of May, 2013, on counsel of record for Applicant, Raymond Rundelli, Calfee, Halter & Griswold, LLP, 1405 East Sixth Street, The Calfee Building, Cleveland, Ohio 44114.

/William P. Ramey, III/
Counsel for Opposer
Texas Children's Hospital, Inc.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 85/431,881
Published in the Official Gazette on September 11, 2012

TEXAS CHILDREN’S HOSPITAL, INC.,	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No. 91/207,428
	:	
U. T. PHYSICIANS,	:	
	:	
Applicant.	:	

**APPLICANT’S WRITTEN RESPONSE TO OPPOSER’S
AMENDED FIRST SET OF REQUESTS FOR THE PRODUCTION**

Pursuant to Rule 34 of the Federal Rules of Civil Procedure, Applicant hereby responds in writing to Opposer’s Amended First Set of Requests for the Production of Documents (the “Requests”) within the time permitted by Rule 34.

General Objections

Applicant responds to each of the Requests subject to the General Objections set forth below. These objections form a part of and are specifically incorporated into each of Applicant’s Specific Responses to the Requests, even though they may not be specifically referred to in each and every response to each request. Failure to specifically refer to any of these General Objections in any specific response should not be construed as a waiver of same.

A. Applicant objects to Opposer’s Definitions and Instructions and each and every Request to the extent that they purport to impose any requirement to respond or other obligation upon Applicant greater than those imposed by Rule 34 of the Federal Rules of Civil Procedure and 37 C.F.R. § 2.120.

B. Applicant objects to the time and location specified by Opposer for the production of documents. Documents will be produced for inspection and copying at such a reasonable time and place and in such a reasonable manner as is mutually agreeable to the parties. If the parties cannot mutually agree on a reasonable time, place and manner for production, the documents shall be produced at the offices of counsel for Applicant within thirty days of the time this Written Response is served.

C. Applicant objects to the Requests to the extent that they seek the disclosure of documents or information protected by the attorney-client privilege or any other privilege.

D. Applicant objects to the Requests to the extent that they seek the disclosure of documents or information which is entitled to protection from disclosure under the attorney work product doctrine or that otherwise constitutes trial preparation materials as defined by the applicable rules of procedure.

E. Applicant objects to the Requests to the extent that they call for information protected from disclosure by FED.R.EVID. 408.

F. Applicant objects to the Requests to the extent that they purport to require disclosure of information not within Applicant's possession, custody or control.

G. Applicant objects to the Requests to the extent that they seek information generated after the filing of the above-captioned Proceeding.

H. In providing these responses to the Requests, Applicant does not waive or intend to waive, but to the contrary, preserves and intends to preserve:

- (i) all questions as to competency, relevancy, materiality, privilege, immunity and admissibility as evidence for any purpose of the responses or subject matter thereof, in any subsequent proceeding in the trial or any other action;
- (ii) the right to object further on any ground to this or any further discovery request in this proceeding;

- (iii) the right to object on any ground to the use of the responses, or the subject matter thereof, in any subsequent proceeding in the trial of this or any other action; and
- (iv) the right to object on any ground at any time to other requests or other discovery procedures involving or relating to the subject matter of these requests.

I. Applicant objects to Instruction No. 5 to the extent it imposes a duty to produce a privilege log within five days of providing written responses to the Requests. Applicant will provide a privilege log of documents withheld on the basis of any claim of privilege or work product in conjunction with its production of responsive documents.

SPECIFIC OBJECTIONS AND RESPONSES TO DOCUMENT REQUESTS

1. Please produce the complete trademark application file as kept at the United States Trademark Office for Applicant's Mark.

Response: Objection as to the form of the question and on the grounds of undue burden. As to form, it is not possible for Applicant to produce the requested documents "as kept" by the United States Patent and Trademark Office ("USPTO") as Applicant has no way of determining the exact manner in which the file is kept. As to burden, the documents that are the subject of the foregoing Request are a matter of public record in the USPTO and are as readily accessible for inspection and copying by Opposer as they are by Applicant. No legitimate discovery purpose is served by requiring Applicant to produce the requested documents.

2. Please produce all specimens of advertising that use the Applicant's Mark.

Response: Objection on the grounds of overbreadth and undue burden. Notwithstanding and without waiving any of the objections asserted, Applicant will produce for inspection and copying representative specimens of advertising in which Applicant's Mark appears.

3. Please produce all written specimens that use the Applicant's Mark.

Response: Objection on the grounds of overbreadth and undue burden. The foregoing Request is also duplicative of Request No. 2 to the extent that the term “use” is a defined term for service marks that refers to use in advertising. Notwithstanding and without waiving any of the objections asserted, Applicant will produce for inspection and copying representative specimens of use of Applicant’s Mark appears as part of its production of documents in response to Request No. 2.

4. Please produce all press releases that use the Applicant’s Mark.

Response: There are no documents known to Applicant that are responsive to the foregoing Request.

5. Please produce copies of all Internet advertising that use the Applicant’s Mark.

Response: Objection on the grounds of overbreadth and undue burden. Also, many of the requested documents are available online through the use of an internet search engine and as such are as readily accessible for inspection and copying by Opposer as they are by Applicant. The foregoing Request is also duplicative of Request No. 2 to the extent that the term “use” is a defined term for service marks that refers to use in advertising. Notwithstanding and without waiving any of the objections asserted, Applicant will produce for inspection and copying representative specimens of use of Applicant’s Mark in Internet advertising as part of its production of documents in response to Request No. 2.

6. Please produce all catalogs that use the Applicant’s Mark.

Response: There are no documents known to Applicant that are responsive to the foregoing Request.

7. Please produce copies of all webpages that use the Applicant’s Mark.

Response: Objection on the grounds of overbreadth and undue burden. Also, many of the requested documents are available online by way of internet search engine and as such are as readily accessible for inspection and copying by Opposer as they are by Applicant. The foregoing Request is also duplicative of Request No. 2 to the extent that the term “use” is a defined term for service marks that refers to use in advertising.

Notwithstanding and without waiving any of the objections asserted, Applicant will produce for inspection and copying representative specimens of use of Applicant's Mark in Internet advertising as part of its production of documents in response to Request No. 2.

8. Please produce copies of all journals that use the Applicant's Mark.

Response: There are no documents known to Applicant that are responsive to the foregoing Request.

9. Please produce all promotional material that uses the Applicant's Mark.

Response: Applicant incorporates by reference its response to Request No. 2.

10. Please produce all documents that relate to the creation of the Applicant's Mark.

Response: All unprivileged documents requested will be produced for inspection and copying.

11. Please produce all documents that relate to the adoption of the Applicant's Mark.

Response: All unprivileged documents requested will be produced for inspection and copying.

12. Please produce all documents that relate to the design of the Applicant's Mark.

Response: All unprivileged documents requested will be produced for inspection and copying.

13. Please produce all documents that relate to the development of the Applicant's Mark.

Response: All unprivileged documents requested will be produced for inspection and copying.

14. Please produce all documents that relate to the pricing for all advertisements using Applicant's Mark as referred to in the Response to Request for Production #2.

Response: Objection on the grounds of relevance. The documents requested by the foregoing Request are not material to any claim or defense raised by the averments of the Notice of Opposition or the Answer thereto.

15. Please produce all documents that relate to pricing for all written specimens that use the Applicant's Mark as referred to in the Response to Request for Production #3.

Response: Objection on the grounds of relevance. The documents requested by the foregoing Request are not material to any claim or defense raised by the averments of the Notice of Opposition or the Answer thereto.

16. Please produce all documents that relate to pricing for all press releases that use the Applicant's Mark as referred to in the Response to Request for Production #4.

Response: Objection on the grounds of relevance. The documents requested by the foregoing Request are not material to any claim or defense raised by the averments of the Notice of Opposition or the Answer thereto. Notwithstanding and without waiving the objections asserted, Applicant further responds by stating that there are no documents known to Applicant that are responsive to the foregoing Request.

17. Please produce all documents that relate to pricing for all Internet advertising that use the Applicant's Mark as referred to in the Response to Request for Production #5.

Response: Objection on the grounds of relevance. The documents requested by the foregoing Request are not material to any claim or defense raised by the averments of the Notice of Opposition or the Answer thereto.

18. Please produce all documents that relate to pricing for all catalogs that use the Applicant's Mark as referred to in the Response to Request for Production #6.

Response: Objection on the grounds of relevance. The documents requested by the foregoing Request are not material to any claim or defense raised by the averments of the Notice of Opposition or the Answer thereto. Notwithstanding and without waiving the objections asserted, Applicant further responds by stating that there are no documents known to Applicant that are responsive to the foregoing Request.

19. Please produce all documents that relate to pricing for all webpages that use the Applicant's Mark as referred to in the Response to Request for Production #7.

Response: Objection on the grounds of relevance. The documents requested by the foregoing Request are not material to any claim or defense raised by the averments of the Notice of Opposition or the Answer thereto.

20. Please produce all documents that relate to pricing for all journals that use the Applicant's Mark as referred to in the Response to Request for Production # 8.

Objection on the grounds of relevance. The documents requested by the foregoing Request are not material to any claim or defense raised by the averments of the Notice of Opposition or the Answer thereto. Notwithstanding and without waiving the objections asserted, Applicant further responds by stating that there are no documents known to Applicant that are responsive to the foregoing Request.

21. Please produce all documents that relate to the cost for all promotional material that uses the Applicant's Mark as referred to in the Response to Request for Production #9.

Response: Objection on the grounds of relevance. The documents requested by the foregoing Request are not material to any claim or defense raised by the averments of the Notice of Opposition or the Answer thereto.

22. Please produce all documents that relate to the cost for the creation of the Applicant's Mark.

Response: Objection on the grounds of relevance. The documents requested by the foregoing Request are not material to any claim or defense raised by the averments of the Notice of Opposition or the Answer thereto.

23. Please produce all documents that relate to the cost for the adoption of the Applicant's Mark by U.T. Physicians.

Response: Objection on the grounds of relevance. The documents requested by the foregoing Request are not material to any claim or defense raised by the averments of the Notice of Opposition or the Answer thereto.

24. Please produce all documents that relate to the cost of the design of the Applicant's Mark.

Response: Objection on the grounds of relevance. The documents requested by the foregoing Request are not material to any claim or defense raised by the averments of the Notice of Opposition or the Answer thereto.

25. Please produce all documents that relate to the cost of the development of the Applicant's Mark.

Response: Objection on the grounds of relevance. The documents requested by the foregoing Request are not material to any claim or defense raised by the averments of the Notice of Opposition or the Answer thereto.

26. Please produce all documents sufficient to establish a date of first use of the Applicant's Mark.

Response: All unprivileged documents requested will be produced for inspection and copying.

27. Please produce all documents sufficient to establish a date of first use of the Applicant's Mark in commerce.

Response: Applicant incorporates by reference its response to Request No. 26 as its response to the foregoing Request.

28. Please produce all communications related to the creation of the Applicant's Mark.

Response: Objection. A full and complete response calls for the production of documents that are beyond the scope of discovery pursuant to the attorney client privilege and the civil rules concerning the production of trial preparation materials. All unprivileged documents requested will be produced for inspection and copying.

29. Please produce all communications related to the adoption of the Applicant's Mark.

Response: Objection. A full and complete response calls for the production of documents that are beyond the scope of discovery pursuant to the attorney client privilege and the civil rules concerning the production of trial preparation materials. All unprivileged documents requested will be produced for inspection and copying.

30. Please produce all communications related to the design of the Applicant's Mark.

Response: Objection. A full and complete response calls for the production of documents that are beyond the scope of discovery pursuant to the attorney client privilege and the civil rules concerning the production of trial preparation materials. All unprivileged documents requested will be produced for inspection and copying.

31. Please produce all communications related to the development of the Applicant's Mark.

Response: Objection. A full and complete response calls for the production of documents that are beyond the scope of discovery pursuant to the attorney client privilege and the civil rules concerning the production of trial preparation materials. All unprivileged documents requested will be produced for inspection and copying.

32. Please produce all documents related to the trademark application file as kept at the United States Trademark Office for the Applicant's Mark.

Response: Applicant incorporates by reference its response to Request No. 1.

33. Please produce all documents related to the Applicant's Mark.

Response: Objection on the grounds of lack of particularity, overbreadth and undue burden. The foregoing Request lacks the specificity required to make the Request amenable to an intelligent response. As currently phrased, the Request could be construed as relating to every document relating to every aspect of the business operations of Applicant involving the services described in the application that is the subject of the above-captioned proceeding since the time of the selection of the Applicant's Mark.

Notwithstanding and without waiving any of the objections asserted, Applicant states that the foregoing Request appears to request at least some documents that are responsive to other more particularized Requests and Applicant will produce for inspection and copying representative documents responsive to the foregoing Request as part of the production in response to those other more particularized Requests.

34. Please produce all documents related to the use of the Applicant's Mark.

Response: Objection on the grounds of lack of particularity, overbreadth and undue burden. The foregoing Request lacks the specificity required to make the Request amenable to an intelligent response. As currently phrased, the Request could be construed as relating to every document relating to every aspect of the business operations of Applicant involving the services described in the application that is the subject of the above-captioned proceeding since the time of the selection of the Applicant's Mark.

Notwithstanding and without waiving any of the objections asserted, Applicant states that the foregoing Request appears to request at least some documents that are responsive to other more particularized Requests and Applicant will produce for inspection and copying representative documents responsive to the foregoing Request as part of the production in response to those other more particularized Requests.

35. Please produce all documents related to instructions on how to use the Applicant's Mark.

Response: Objection. A full and complete response calls for the production of documents that are beyond the scope of discovery pursuant to the attorney client privilege. All unprivileged documents requested will be produced for inspection and copying.

36. Please produce all documents related to instructions on how to use the Applicant's Mark.

Response: The foregoing Request appears to be duplicative of Request No. 35 and Applicant incorporates its response to Request No. 35 as its response to the foregoing Request.

37. Please produce all documents related to services performed under the Applicant's Mark.

Response: Objection on the grounds of lack of particularity, overbreadth and undue burden. The foregoing Request lacks the specificity required to make the Request amenable to an intelligent response. As currently phrased, the Request could be construed as relating to every document relating to every aspect of the business operations of Applicant involving the services described in the application that is the subject of the above-captioned proceeding since the time of the selection of the Applicant's Mark. Notwithstanding and without waiving any of the objections asserted, Applicant states that the foregoing Request appears to request at least some documents that are responsive to other more particularized Requests and Applicant will produce for inspection and copying representative documents responsive to the foregoing Request as part of the production in response to those other more particularized Requests.

38. Please produce all documents related to goods sold under the Applicant's Mark.

Response: Objection on the grounds of relevance. The documents requested by the foregoing Request are not material to any claim or defense raised by the averments of the Notice of Opposition or the Answer thereto.

39. Please produce all documents related to the market for the Applicant's Mark.

Response: Objection on the grounds of lack of particularity, overbreadth and undue burden. The foregoing Request lacks the specificity required to make the Request amenable to an intelligent response. As currently phrased, the Request could be construed as relating to every document relating to every aspect of the business operations of Applicant involving the services described in the application that is the subject of the above-captioned proceeding since the time of the selection of the Applicant's Mark. Notwithstanding and without waiving any of the objections asserted, Applicant states that the foregoing Request appears to request at least some documents that are responsive to other more particularized Requests and Applicant will produce for inspection and copying representative documents responsive to the foregoing Request as part of the production in response to those other more particularized Requests.

40. Please produce all documents related to assignments of the Applicant's Mark.

Response: There are no documents known to Applicant that are responsive to the foregoing Request.

41. Please produce all documents related to discussions with advertising agencies concerning the Applicant's Mark.

Response: There are no documents known to Applicant that are responsive to the foregoing Request.

42. Please produce all documents related to discussions related to advertising of the Applicant's Mark.

Response: Objection. A full and complete response calls for the production of documents that are beyond the scope of discovery pursuant to the attorney client privilege. All unprivileged documents requested will be produced for inspection and copying.

43. Please produce all documents related to discussions concerning the advertising of the Applicant's Mark.

Response: The foregoing Request appears to be duplicative of Request No. 42 and Applicant incorporates its response to Request No. 42 as its response to the foregoing Request.

44. Please produce all documents related to discussions with U.T. Physician's media group related to the Applicant's Mark.

Response: Objection. A full and complete response calls for the production of documents that are beyond the scope of discovery pursuant to the attorney client privilege. All unprivileged documents requested will be produced for inspection and copying.

45. Please produce all documents related to discussions with UT Health's media group related to the Applicant's Mark.

Response: Objection. A full and complete response calls for the production of documents that are beyond the scope of discovery pursuant to the attorney client privilege. All unprivileged documents requested will be produced for inspection and copying.

46. Please produce all documents related to responses from advertising with the Applicant's Mark.

Response: There are no documents known to Applicant that are responsive to the foregoing Request.

47. Please produce all documents related to U.T. Physician's right to use the Applicant's Mark.

Response: Objection. The foregoing Request is not sufficiently particularized to make a search for responsive document practicable. Applicant further objects to the foregoing Request on the grounds of relevance. The sole issue presented in the above-referenced proceeding is Applicant's right to registration. Applicant's right to use Applicant's Mark is not material to any claim or defense raised by the averments of the Notice of Opposition or the Answer thereto.

48. Please produce all documents related to litigation concerning the right to use the Applicant's Mark.

Response: Objection. The term "litigation" is vague and ambiguous. If "litigation" relates to the above-captioned proceeding, a full and complete response calls for the production of documents that are beyond the scope of discovery pursuant to the attorney client privilege and the civil rules concerning the production of trial preparation materials. Moreover, if "litigation" relates to the above-captioned proceeding, Applicant further objects on the grounds of lack of particularity, overbreadth, undue burden and duplicativeness. The foregoing Request lacks the specificity required to make the Request amenable to an intelligent response. As currently phrased, the Request could be construed as being duplicative of many, if not all, of the other Requests propounded by Opposer. Notwithstanding and without waiving any of the objections asserted, Applicant states that

the foregoing Request appears to request at least some documents that are responsive to other more particularized Requests and Applicant will produce for inspection and copying representative documents responsive to the foregoing Request as part of the production in response to those other more particularized Requests.

If “litigation” relates to litigation by or against third parties, whether in the form of *inter partes* proceedings before the Trademark Trial and Appeal Board other than the above-captioned proceeding or civil actions in state or federal courts, there are no documents known to Applicant that are responsive to the foregoing Request.

49. Please produce all documents related to demand letters concerning the right to use the Applicant’s Mark.

Response: Applicant adopts by reference its response to Request No. 47.

50. Please produce all documents related to the use by third parties of a mark related to the Applicant’s Mark.

Response: There are no documents known to Applicant that are responsive to the foregoing Request.

51. Please produce all documents related to expert witness testimony concerning Applicant’s Mark.

Response: Objection. The foregoing Request appears on its face to request the production of documents that would not be subject to discovery, such as privileged attorney client communications and trial preparation materials. Notwithstanding and without waiving any of the objections asserted, Applicant states that it has not yet made a determination as to whether it will rely on expert testimony in the above-captioned proceeding. If and when it does so, and if the determination is that Applicant will rely on expert testimony, Applicant will comply with the expert disclosure requirements that apply to the above-captioned proceeding.

52. Please produce all documents related to expert witness opinions and Applicant’s Mark.

Response: Objection. The foregoing Request appears on its face to request the production of documents that would not be subject to discovery, such as privileged attorney client communications and trial preparation materials. Notwithstanding and without waiving any of the objections asserted, Applicant states that it has not yet made a determination as to whether it will rely on expert testimony in the above-captioned proceeding. If and when it does so, and if the determination is that Applicant will rely on expert testimony, Applicant will comply with the expert disclosure requirements that apply to the above-captioned proceeding.

53. Please produce all documents related to market studies of the Applicant's Mark.

Response: Objection. The foregoing Request appears on its face to request the production of documents that are not subject to discovery, such as privileged attorney client communications and trial preparation materials. Notwithstanding and without waiving any of the objections asserted, Applicant states that it has not yet made a determination as to whether it will rely on expert testimony in the above-captioned proceeding. If and when it does so, and if the determination is that Applicant will rely on expert testimony, Applicant will comply with the expert disclosure requirements that apply to the above-captioned proceeding. To the extent that the foregoing Request is directed to documents that are not privileged or otherwise outside the scope of discovery, Applicant states that there are no such documents responsive to the foregoing Request.

54. Please produce all documents related to focus groups related to the Applicant's Mark.

Response: Objection. The foregoing Request appears on its face to request the production of documents that are not subject to discovery, such as privileged attorney client communications and trial preparation materials. Notwithstanding and without waiving any of the objections asserted, Applicant states that it has not yet made a determination as to whether it will rely on expert testimony in the above-captioned proceeding. If and when it does so, and if the determination is that Applicant will rely on expert testimony, Applicant will comply with the expert disclosure requirements that apply to the above-captioned proceeding. To the extent that the foregoing Request is directed to

documents that are not privileged or otherwise outside the scope of discovery, Applicant states that there are no such documents responsive to the foregoing Request.

55. Please produce all documents related to market surveys of the Applicant's Mark.

Response: Objection. The foregoing Request appears on its face to request the production of documents that are not subject to discovery, such as privileged attorney client communications and trial preparation materials. Notwithstanding and without waiving any of the objections asserted, Applicant states that it has not yet made a determination as to whether it will rely on expert testimony in the above-captioned proceeding. If and when it does so, and if the determination is that Applicant will rely on expert testimony, Applicant will comply with the expert disclosure requirements that apply to the above-captioned proceeding. To the extent that the foregoing Request is directed to documents that are not privileged or otherwise outside the scope of discovery, Applicant states that there are no such documents responsive to the foregoing Request.

56. Please produce all documents related to surveys of the Applicant's Mark.

Response: Objection. The foregoing Request appears on its face to request the production of documents that are not subject to discovery, such as privileged attorney client communications and trial preparation materials. Notwithstanding and without waiving any of the objections asserted, Applicant states that it has not yet made a determination as to whether it will rely on expert testimony in the above-captioned proceeding. If and when it does so, and if the determination is that Applicant will rely on expert testimony, Applicant will comply with the expert disclosure requirements that apply to the above-captioned proceeding. To the extent that the foregoing Request is directed to documents that are not privileged or otherwise outside the scope of discovery, Applicant states that there are no such documents responsive to the foregoing Request.

57. Please produce all documents related to consumer research U.T. Physicians performed on the Applicant's Mark.

Response: Objection. The foregoing Request appears on its face to request the production of documents that are not subject to discovery, such as privileged attorney

client communications and trial preparation materials. Notwithstanding and without waiving any of the objections asserted, Applicant states that it has not yet made a determination as to whether it will rely on expert testimony in the above-captioned proceeding. If and when it does so, and if the determination is that Applicant will rely on expert testimony, Applicant will comply with the expert disclosure requirements that apply to the above-captioned proceeding. To the extent that the foregoing Request is directed to documents that are not privileged or otherwise outside the scope of discovery, Applicant states that there are no such documents responsive to the foregoing Request.

58. Please produce all consumer research documents related to the Applicant's Mark in your possession.

Response: Objection. The foregoing Request appears on its face to request the production of documents that are not subject to discovery, such as privileged attorney client communications and trial preparation materials. Notwithstanding and without waiving any of the objections asserted, Applicant states that it has not yet made a determination as to whether it will rely on expert testimony in the above-captioned proceeding. If and when it does so, and if the determination is that Applicant will rely on expert testimony, Applicant will comply with the expert disclosure requirements that apply to the above-captioned proceeding. To the extent that the foregoing Request is directed to documents that are not privileged or otherwise outside the scope of discovery, Applicant states that there are no such documents responsive to the foregoing Request.

59. Please produce documents identifying the corporate managers of U.T. Physicians.

Response: Objection as to the form of the question. The term "corporate managers" is vague and ambiguous. Notwithstanding and without waiving any of the objections asserted, Applicant states that it does not have any employees with the title "corporate manager." As such, there are no documents responsive to the foregoing Request.

60. Please produce all communications from the corporate managers' identified from the response to Request for Production # 59 evidencing knowledge of the Applicant's Mark.

Response: Objection as to the form of the question. The term “corporate managers” is vague and ambiguous. Notwithstanding and without waiving any of the objections asserted, Applicant states that it does not have any employees with the title “corporate manager.” As such, there are no documents responsive to the foregoing Request..

61. Please produce all documents that you intend to rely upon in this Opposition.

Response: Objection. The selection of which particular documents amongst all available documents a party intends to rely on in a contested proceeding necessarily reveals attorney mental impressions work product/trial preparation materials. Accordingly, a discovery request that seeks the disclosure of such mental impressions is impermissible absent the showing required by the applicable rules for the pre-trial disclosure of work product or trial preparation materials. Notwithstanding and without waiving any of the objections asserted, Applicant states that it has not made any determinations at this time as to which documents it intends to rely on and will likely not do so until shortly before its trial testimony period opens. Applicant will comply with the pre-trial disclosure requirements that apply to the above-captioned proceeding but will not otherwise respond to the foregoing Request.

62. Please produce all documents related to Board of Director’s Meetings of U.T. Physicians discussing the Applicant’s Mark.

Response: There are no documents known to Applicant that are responsive to the foregoing Request.

63. Please produce all documents related to minutes of the Board of Director’s Meetings of U.T. Physicians discussing the Applicant’s Mark.

Response: There are no documents known to Applicant that are responsive to the foregoing Request.

64. Please produce all documents related to the destruction of documents that relate to the Applicant’s Mark.

Response: Objection. A full and complete response calls for the production of documents that are beyond the scope of discovery pursuant to the attorney client privilege and the civil rules concerning the production of trial preparation materials. All unprivileged documents requested will be produced for inspection and copying.

65. Please produce all communications between U.T. Physicians and a third party concerning the Applicant's Mark.

Response: There are no documents known to Applicant that are responsive to the foregoing Request.

66. Please produce all communications between U.T. Physicians and a third party concerning the Opposer's Mark.

Response: There are no documents known to Applicant that are responsive to the foregoing Request.

67. Please produce all documents related to trademark searches related to the Applicant's Mark.

Response: Objection. A full and complete response calls for the production of documents that are beyond the scope of discovery pursuant to the attorney client privilege and the civil rules concerning the production of trial preparation materials. All unprivileged documents requested will be produced for inspection and copying.

68. Please produce all U.T. Physicians' internal communications concerning Opposer's Mark.

Response: Objection. A full and complete response calls for the production of documents that are beyond the scope of discovery pursuant to the attorney client privilege and the civil rules concerning the production of trial preparation materials. All unprivileged documents requested will be produced for inspection and copying.

69. Please produce all communications between you and Dr. Anthony Johnson related to Opposer's Mark.

Response: Objection. A full and complete response calls for the production of documents that are beyond the scope of discovery pursuant to the attorney client privilege and the civil rules concerning the production of trial preparation materials. All unprivileged documents requested will be produced for inspection and copying.

70. Please produce all communications between you and Dr. Kenneth J. Moise, Jr. related to Opposer's Mark.

Response: Objection. A full and complete response calls for the production of documents that are beyond the scope of discovery pursuant to the attorney client privilege and the civil rules concerning the production of trial preparation materials. All unprivileged documents requested will be produced for inspection and copying.

71. Please produce all communications between you and Dr. Anthony Johnson related to Applicant's Mark.

Response: Objection. A full and complete response calls for the production of documents that are beyond the scope of discovery pursuant to the attorney client privilege and the civil rules concerning the production of trial preparation materials. All unprivileged documents requested will be produced for inspection and copying.

72. Please produce all communications between you and Dr. Kenneth J. Moise, Jr. related to Applicant's Mark.

Response: Objection. A full and complete response calls for the production of documents that are beyond the scope of discovery pursuant to the attorney client privilege and the civil rules concerning the production of trial preparation materials. All unprivileged documents requested will be produced for inspection and copying.

73. Please produce the complete employment file for Dr. Anthony Johnson with U.T. Physician.

Response: Objection on the grounds of relevance. The documents requested by the foregoing Request are not material to any claim or defense raised by the averments of the Notice of Opposition or the Answer thereto.

74. Please produce the complete employment file for Dr. Kenneth J. Moise, Jr. with U.T. Physician.

Response: Objection on the grounds of relevance. The documents requested by the foregoing Request are not material to any claim or defense raised by the averments of the Notice of Opposition or the Answer thereto.

75. Please produce all documents related to Dr. Anthony Johnson in U.T. Physician's possession.

Response: Objection on the grounds of relevance. The documents requested by the foregoing Request are not material to any claim or defense raised by the averments of the Notice of Opposition or the Answer thereto.

76. Please produce all documents related to Dr. Kenneth J. Moise, Jr. in U.T. Physician's possession.

Response: Objection on the grounds of relevance. The documents requested by the foregoing Request are not material to any claim or defense raised by the averments of the Notice of Opposition or the Answer thereto.

77. Please produce all documents related to Dr. Michael A. Belfort in U.T. Physician's possession.

Response: Objection on the grounds of relevance. The documents requested by the foregoing Request are not material to any claim or defense raised by the averments of the Notice of Opposition or the Answer thereto.

78. Please produce all communications between you and Dr. Michael A. Belfort related to Applicant's Mark.

Response: All unprivileged documents requested will be produced for inspection and copying.

79. Please produce all documents related to the intended audience for Applicant's Mark.

Response: Objection. The intended audience for Applicant's Mark are all of the consumers and potential consumers of Applicant's medical clinic services. A full and

complete response to the foregoing Request would require a massive effort and the responsive documents would include documents that are privileged or otherwise statutorily protected from disclosure. Applicant further objects to the foregoing Request on the grounds of a lack of particularity.

80. Please produce a complete description of services offered under Applicant's Mark.

Response: Applicant incorporates its response to Interrogatory No. 1 as its response to the foregoing Request. Applicant also refers Opposer to <http://childrens.memorialhermann.org/Services/texas-fetal-center/>.

81. Please produce all communications related the description of services offered under Applicant's Mark.

Response: Objection. A full and complete response calls for the production of documents that are beyond the scope of discovery pursuant to the attorney client privilege and the civil rules concerning the production of trial preparation materials. The foregoing Request is duplicative of Request Nos. 1, 32, 37, and 80. Notwithstanding and without waiving any of the objections asserted and subject to the objections raised in response to Request Nos. 1, 32, 37, and 80, all unprivileged documents requested will be produced for inspection and copying.

82. Please produce all documents and communications you used or referred to in responding to Interrogatory #1.

Response: With respect to the portion of the foregoing request that relates to communications, Applicant objects on the basis of the attorney client privilege and the immunity of trial preparation materials from discovery. With respect to the portion of the foregoing Request that relates to documents, Applicant refers Opposer to the file wrapper of the application that is the subject of the above-captioned proceeding, a publicly available document that is as readily accessible to Opposer as it is to Applicant. Applicant also refers Opposer to <http://childrens.memorialhermann.org/Services/texas-fetal-center/>.

83. Please produce all documents and communications you used or referred to in responding to Interrogatory #2.

Response: With respect to the portion of the foregoing request that relates to communications, Applicant objects on the basis of the attorney client privilege and the immunity of trial preparation materials from discovery. With respect to the portion of the foregoing Request that relates to documents, Applicant incorporates its response to Request No. 2 as its response to the foregoing Request.

84. Please produce all documents and communications you used or referred to in responding to Interrogatory #3.

Response: With respect to the portion of the foregoing request that relates to communications, Applicant objects on the basis of the attorney client privilege and the immunity of trial preparation materials from discovery. With respect to the portion of the foregoing Request that relates to documents, Applicant incorporates its response to Request No. 2 as its response to the foregoing Request.

85. Please produce all documents and communications you used or referred to in responding to Interrogatory #4.

Response: With respect to the portion of the foregoing request that relates to communications, Applicant objects on the basis of the attorney client privilege and the immunity of trial preparation materials from discovery. With respect to the portion of the foregoing Request that relates to documents, Applicant states that there are no known unprivileged documents responsive to the foregoing Request.

86. Please produce all documents and communications you used or referred to in responding to Interrogatory #5.

Response: Applicant incorporated by reference its response to Interrogatory No. 5 as its response to the foregoing Request.

87. Please produce all documents and communications you used or referred to in responding to Interrogatory #6.

Response: Applicant incorporates by reference its response to Request No. 82 as its response to the foregoing Request.

88. Please produce all documents and communications you used or referred to in responding to Interrogatory #7.

Response: With respect to the portion of the foregoing request that relates to communications, Applicant objects on the basis of the attorney client privilege and the immunity of trial preparation materials from discovery. With respect to the portion of the foregoing Request that relates to documents, Applicant refers Opposer to <http://childrens.memorialhermann.org/Services/texas-fetal-center/>.

89. Please produce all documents and communications you used or referred to in responding to Interrogatory #8.

Response: With respect to the portion of the foregoing request that relates to communications, Applicant objects on the basis of the attorney client privilege and the immunity of trial preparation materials from discovery. With respect to the portion of the foregoing Request that relates to documents, Applicant states that there are no known unprivileged documents responsive to the foregoing Request.

90. Please produce all documents and communications you used or referred to in responding to Interrogatory #9.

Response: With respect to the portion of the foregoing request that relates to communications, Applicant objects on the basis of the attorney client privilege and the immunity of trial preparation materials from discovery. With respect to the portion of the foregoing Request that relates to documents, Applicant states that there are no known unprivileged documents responsive to the foregoing Request.

91. Please produce all documents and communications you used or referred to in responding to Interrogatory #10.

Response: With respect to the portion of the foregoing request that relates to communications, Applicant objects on the basis of the attorney client privilege and the immunity of trial preparation materials from discovery. With respect to the portion of the foregoing Request that relates to documents, Applicant states that there are no known unprivileged documents responsive to the foregoing Request.

92. Please produce all documents and communications you used or referred to in responding to Interrogatory #11.

Response: With respect to the portion of the foregoing request that relates to communications, Applicant objects on the basis of the attorney client privilege and the immunity of trial preparation materials from discovery. With respect to the portion of the foregoing Request that relates to documents, Applicant states that there are no known unprivileged documents responsive to the foregoing Request.

93. Please produce all documents and communications you used or referred to in responding to Interrogatory #12.

Response: With respect to the portion of the foregoing request that relates to communications, Applicant objects on the basis of the attorney client privilege and the immunity of trial preparation materials from discovery. With respect to the portion of the foregoing Request that relates to documents, Applicant states that there are no known unprivileged documents responsive to the foregoing Request.

94. Please produce all documents and communications you used or referred to in responding to Interrogatory #13.

Response: Applicant incorporates by reference its response to Interrogatory Nos. 2, 5 and 7 as its response to the foregoing Request.

95. Please produce all documents and communications you used or referred to in responding to Interrogatory #14.

Response: Applicant incorporates by reference its response to Interrogatory No. 14 as its response to the foregoing Request.

96. Please produce all documents and communications you used or referred to in responding to Interrogatory #15.

Response: With respect to the portion of the foregoing request that relates to communications, Applicant objects on the basis of the attorney client privilege and the immunity of trial preparation materials from discovery. With respect to the portion of the foregoing Request that relates to documents, Applicant states that there are no known unprivileged documents responsive to the foregoing Request.

97. Please produce all documents and communications you used or referred to in responding to Interrogatory #16.

Response: Applicant incorporates by reference its response to Interrogatory No. 16 as its response to the foregoing Request.

98. Please produce all documents and communications you used or referred to in responding to Interrogatory #17.

Response: With respect to the portion of the foregoing request that relates to communications, Applicant objects on the basis of the attorney client privilege and the immunity of trial preparation materials from discovery. With respect to the portion of the foregoing Request that relates to documents, Applicant states that there are no known unprivileged documents responsive to the foregoing Request.

99. Please produce all documents and communications you used or referred to in responding to Interrogatory #18.

Response: With respect to the portion of the foregoing request that relates to communications, Applicant objects on the basis of the attorney client privilege and the immunity of trial preparation materials from discovery. With respect to the portion of the foregoing Request that relates to documents, Applicant states that there are no known unprivileged documents responsive to the foregoing Request.

100. Please produce all documents and communications you used or referred to in responding to Interrogatory #19.

Response: With respect to the portion of the foregoing request that relates to communications, Applicant objects on the basis of the attorney client privilege and the immunity of trial preparation materials from discovery. With respect to the portion of the foregoing Request that relates to documents, Applicant states that there are no known unprivileged documents responsive to the foregoing Request.

101. Please produce all documents and communications you used or referred to in responding to Interrogatory #20.

Response: With respect to the portion of the foregoing request that relates to communications, Applicant objects on the basis of the attorney client privilege and the immunity of trial preparation materials from discovery. With respect to the portion of the foregoing Request that relates to documents, Applicant states that there are no known unprivileged documents responsive to the foregoing Request.

102. Please produce all documents and communications you used or referred to in responding to Interrogatory #21.

Response: With respect to the portion of the foregoing request that relates to communications, Applicant objects on the basis of the attorney client privilege and the immunity of trial preparation materials from discovery. With respect to the portion of the foregoing Request that relates to documents, Applicant states that there are no known unprivileged documents responsive to the foregoing Request.

103. Please produce all documents and communications you used or referred to in responding to Interrogatory #22.

Response: With respect to the portion of the foregoing request that relates to communications, Applicant objects on the basis of the attorney client privilege and the immunity of trial preparation materials from discovery. With respect to the portion of the foregoing Request that relates to documents, Applicant states that there are no known unprivileged documents responsive to the foregoing Request.

104. Please produce all documents and communications you used or referred to in responding to Interrogatory #23.

Response: With respect to the portion of the foregoing request that relates to communications, Applicant objects on the basis of the attorney client privilege and the immunity of trial preparation materials from discovery. With respect to the portion of the foregoing Request that relates to documents, Applicant states that there are no known unprivileged documents responsive to the foregoing Request.

105. Please produce all documents and communications you used or referred to in responding to Interrogatory #24.

Response: With respect to the portion of the foregoing request that relates to communications, Applicant objects on the basis of the attorney client privilege and the immunity of trial preparation materials from discovery. With respect to the portion of the foregoing Request that relates to documents, Applicant states that there are no known unprivileged documents responsive to the foregoing Request.

106. Please produce all documents and communications you used or referred to in responding to Interrogatory #25.

Response: Applicant incorporates by reference its response to Interrogatory No. 25 as its response to the foregoing Request.

107. Please produce all documents and communications you used or referred to in responding to Interrogatory #26.

Response: With respect to the portion of the foregoing request that relates to communications, Applicant objects on the basis of the attorney client privilege and the immunity of trial preparation materials from discovery. With respect to the portion of the foregoing Request that relates to documents, Applicant states that there are no known unprivileged documents responsive to the foregoing Request.

108. Please produce all documents and communications you used or referred to in responding to Interrogatory #27.

Response: Applicant incorporates by reference its response to Interrogatory No. 27 as its response to the foregoing Request.

109. Please produce all documents and communications you used or referred to in responding to Interrogatory #28.

Response: With respect to the portion of the foregoing request that relates to communications, Applicant objects on the basis of the attorney client privilege and the immunity of trial preparation materials from discovery. With respect to the portion of the foregoing Request that relates to documents, Applicant states that there are no known unprivileged documents responsive to the foregoing Request.

110. Please produce all documents and communications you used or referred to in responding to Interrogatory #29.

Response: Applicant incorporates by reference its response to Interrogatory No. 29 as its response to the foregoing Request.

111. Please produce all documents and communications you used or referred to in responding to Interrogatory #30.

Response: Applicant incorporates by reference its response to Interrogatory No. 30 as its response to the foregoing Request.

112. Please produce all documents and communications you used or referred to in responding to Interrogatory #31.

Response: Applicant incorporates by reference its response to Interrogatory No. 31 as its response to the foregoing Request.

Respectfully submitted,

/Raymond Rundelli/

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Attorneys for Applicant

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing APPLICANT'S WRITTEN RESPONSE TO AMENDED FIRST SET OF REQUESTS FOR PRODUCTION was served on counsel of record for Opposer by email on this 4th day of March, 2013, counsel for the parties having agreed to serve papers on the parties by way of email.

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/Raymond Rundelli/
An attorney for Applicant

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 85/431,881
Published in the Official Gazette on September 11, 2012

TEXAS CHILDREN'S HOSPITAL, INC.,	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No. 91/207,428
	:	
U.T. PHYSICIANS,	:	
	:	
Applicant.	:	

**APPLICANT'S WRITTEN RESPONSE TO
OPPOSER'S AMENDED FIRST SET OF INTERROGATORIES TO APPLICANT**

Pursuant to Rule 33 of the Federal Rules of Civil Procedure, Applicant hereby responds in writing to Opposer's Amended First Set of Interrogatories to Applicant (the "Interrogatories") within the time permitted by Rule 33.

General Objections

Applicant objects generally to the Instructions and Definitions included by Opposer in the Interrogatories and to the Interrogatories themselves to the extent that Opposer seeks thereby to impose on Applicant a burden to respond that is greater than that imposed by the governing rules of procedure. Applicant is disregarding the Instructions and Definitions to that extent and will respond to the Interrogatories and supplement its responses only as required by the governing rules of procedure or Orders of the Board.

**SPECIFIC RESPONSES AND OBJECTIONS
TO INTERROGATORIES**

1. Please identify each service marketed under the Applicant's Mark.

Response: Objection based on relevance. The subject of the foregoing Interrogatory, namely the services marketed under Applicant's Mark, is not relevant to any of the claims or defenses asserted in the above-captioned opposition proceeding. The

only services of Applicant that are relevant to those claims and defenses are the services identified in the application that is the subject of the above-captioned proceeding, U.S. Application No. 85/431,881 (the “881 Application”), namely “medical clinics” in International Class 44.

Notwithstanding and without waiving any objections asserted to the foregoing Interrogatory, Applicant states that the medical clinic services being marketed under Applicant’s Mark can be more particularly described as “medical services to mothers with high risk pregnancies and babies with congenital anomalies or genetic conditions.”

2. For each service identified in Interrogatory #1, please identify how the Applicant’s Mark is used.

Response: Objection based on the form of the question. There are no services identified in Interrogatory No. 1. Assuming that the foregoing Interrogatory seeks a response with respect to the services identified in the response to Interrogatory No. 1, Applicant states that Applicant’s Mark is used in signage at the physical place where those services are rendered, as well as in advertising and promotional materials for those services. In this regard, Applicant refers Opposer to the use of Applicant’s Mark at: <http://childrens.memorialhermann.org/Services/texas-fetal-center/>. Also, representative samples of the use of Applicant’s Mark are being produced in response to one or more of requests included in Opposer’s Amended First Set of Requests for Production.

3. For each service identified in Interrogatory #1, please identify if the Applicant’s Mark is in use in commerce.

Response: Objection based on the form of the question. There are no services identified in Interrogatory No. 1. Assuming that the foregoing Interrogatory seeks a response with respect to the services identified in the response to Interrogatory No. 1, Applicant states that Applicant’s Mark is use in commerce for the services identified in the response to Interrogatory No. 1. In this regard, Applicant refers Opposer to the use of Applicant’s Mark at: <http://childrens.memorialhermann.org/Services/texas-fetal-center/>. Also, representative samples of the use of Applicant’s Mark are being produced in response

to one or more of requests included in Opposer's Amended First Set of Requests for Production.

4. Please identify the ten (10) most knowledgeable people concerning the use of the Applicant's Mark in commerce for each service identified in Interrogatory #1.

Response: Objections on the form of the question and on undue burden. As to the form of the question, there are no services identified in Interrogatory No. 1. As to burden, and assuming that the foregoing Interrogatory seeks a response with respect to the services identified in the response to Interrogatory No. 1, surveying all of the persons employed by Applicant or otherwise with knowledge concerning the use of Applicant's Mark and comparing what each knows so as to determine which ten are "most knowledgeable" would be unduly burdensome.

Notwithstanding and without waiving any objections asserted to the foregoing Interrogatory, Applicant states that the persons known to it to be most knowledgeable concerning the use in commerce of Applicant's Mark are:

Anthony Johnson, DO;

Kenneth J. Moise, Jr., M.D.;

KuoJen Tsao, M.D.;

Karen Moise, RN; and

M. Darla Brown.

Each of the foregoing persons is an employee of Applicant, and has as their business address and telephone number: 6410 Fannin St., Houston, TX 77030, (832) 325-7288.

5. Please identify all channels of trade used under which the Applicant's Mark is used.

Response: Objections as to the form of the question and relevance. As to the form of the question, the foregoing Interrogatory is difficult to understand as it appears to include a surplus word. Assuming that the foregoing Interrogatory seeks an identification of the channels of trade through which the services rendered under Applicant's Mark travel, Applicant objects further that the information requested is not relevant to any of the claims or defenses asserted in the above-captioned opposition proceeding because the

identification of Applicant's services does not contain a channel of trade restriction. Where there is no such restriction, the Trademark Trial and Appeal Board as fact-finder must assume that the services in question travel in all of the channels of trade through which such services ordinarily travel. Assuming in the alternative that the foregoing Interrogatory seeks an identification of the channels of trade in which Applicant's Mark is used, Applicant again objects that the information requested is not relevant to any of the claims or defenses asserted in the above-captioned action for the same reason -- there is no channel of trade restriction in the identification of Applicant's services.

Notwithstanding and without waiving any objections asserted to the foregoing Interrogatory, Applicant states that Applicant's services travel primarily through a professional referral channel whereby the consumers of Applicant's services are referred to Applicant (and/or the medical specialists employed by Applicant) by a physician, typically either the potential consumer's primary care physician or a specialist such as an obstetrician, gynecologist or pediatrician.

6. Please identify the class of consumers for the Applicant's Mark.

Response: Objection based on the form of the question. There are no consumers for the Applicant's Mark as the mark is neither a good nor a service that is offered to consumers for purchase or consumption. Assuming that the foregoing Interrogatory seeks an identification of the class of consumers for the services rendered under Applicant's Mark, Applicant states that that class of consumers for such services is the class of consumers of medical clinic services generally and the specifically targeted class of consumers is mothers with high risk pregnancies and babies with congenital anomalies or genetic conditions.

7. Please produce the geographical area which the Applicant's Mark is used.

Response: Objection based on the form of the question. The geographic area in which the Applicant's Mark is used cannot be "produced" in the ordinary sense of that word. Assuming that the foregoing Interrogatory seeks an identification or description of the geographic area in which Applicant's Mark is used, Applicant states that its mark is used primarily in the Greater Houston area but is also used throughout the United

States and even outside the United States inasmuch as one of the mediums through which Applicant advertises the services identified in the '881 Application is through a website associated with Applicant and its services.

8. Please identify whether the Applicant's Mark is the subject of an assignment.

Response: Applicant's Mark is not the subject of an assignment.

9. Please identify whether the Applicant's Mark is the subject of a license.

Response: Applicant's Mark is not the subject of a license.

10. Please identify whether the Applicant's Mark is the subject of a co-existence agreement.

Response: Applicant's Mark is not the subject of a co-existence agreement.

11. Please identify whether the Applicant's Mark is the subject of a use agreement.

Response: Applicant's Mark is not the subject of a use agreement.

12. Please identify and describe all documents referred to in Interrogatories 8-11.

Response: There are no known documents responsive to the foregoing Interrogatory.

13. Please identify all geographical areas in which the Applicant's Mark has been used in advertising.

Response: Applicant incorporates by reference its responses to Interrogatory Nos. 2, 5 and 7.

14. Please identify the total number of dollars spent in advertisements containing the Applicant's Mark.

Response: Objection based on relevance. The information requested by the foregoing Interrogatory is not material to any claim or defense asserted in the Notice of Opposition or the Answer thereto.

15. Please identify all people responsible for promoting the Applicant's Mark.

Response: Objection based on the form of the question. Applicant's Mark is neither a good nor a service that is promoted by Applicant. Assuming the foregoing Interrogatory requests the identification of persons responsible for promoting the services identified in the '881 Application, Applicant states that the persons responsible for promoting such services are:

Anthony Johnson, DO;

Kenneth J. Moise, Jr., M.D.;

KuoJen Tsao, M.D.;

Each of the foregoing persons is an employee of Applicant, and has as their business address and telephone number: 6410 Fannin St., Houston, TX 77030, (832) 325-7288.

16. Please identify all channels of advertising for the Applicant's Mark.

Response: Objection based on the form of the question. Applicant's Mark is not advertised by Applicant. Assuming the foregoing Interrogatory requests identification of the channels of advertising in which the Applicant's Mark is used or the channels through which the services rendered under that mark are advertised, the Applicant incorporates by reference its response to Interrogatory No. 2.

17. Please identify the person or persons responsible for the creation of the Applicant's Mark.

Response: Anthony Johnson, DO; Kenneth J. Moise, Jr., M.D.; KuoJen Tsao, M.D.; Sean Blackwell, M.D.; Karen Moise, RN; and M. Darla Brown. Each of these persons is an employee of Applicant, and has as their business address and telephone number: 6410 Fannin St., Houston, TX 77030, (832) 325-7288.

18. Please identify the person or persons responsible for the adoption of the Applicant's Mark.

Response: Anthony Johnson, DO; Kenneth J. Moise, Jr., M.D.; KuoJen Tsao, M.D.; Sean Blackwell, M.D.; and Karen Moise, RN. Each of these persons is an employee of Applicant, and has as their business address and telephone number: 6410 Fannin St., Houston, TX 77030, (832) 325-7288.

19. Please identify the person or persons responsible for the design of the Applicant's Mark.

Response: Applicant incorporates by reference its response to Interrogatory No. 17.

20. Please identify the person or persons responsible for the development of the Applicant's Mark.

Response: Applicant incorporates by reference its response to Interrogatory No. 17.

21. Please identify the person or persons responsible for the first use of the Applicant's Mark.

Response: Applicant incorporates by reference its response to Interrogatory No. 18.

22. Please identify the person or persons responsible for the selection of the Applicant's Mark.

Response: Applicant incorporates by reference its response to Interrogatory No. 18.

23. Please identify all instances of confusion in the marketplace concerning the Applicant's Mark and Opposer's Mark.

Response: Applicant is not aware of any instances of confusion in the marketplace concerning the Applicant's Mark and Opposer's Mark.

24. Please identify all instances of confusion in the marketplace concerning the Applicant's Mark.

Response: Applicant is not aware of any instances of confusion in the marketplace concerning the Applicant's Mark.

25. Please identify all communications intended for TCH but directed towards U.T. Physicians by mistake.

Response: Objection based on relevance. The subject of the foregoing Interrogatory, namely communications intended for TCH but directed towards U.T. Physicians by mistake, is not relevant to any of the claims or defenses asserted in the above-captioned opposition proceeding.

26. Please identify all communications intended for TCH but directed towards U.T. Physicians because of Applicant's Mark.

Response: Applicant is not aware of any instances of communications intended for TCH but directed towards Applicant because of Applicant's Mark.

27. Please identify all faxes intended for TCH but directed towards U.T. Physicians by mistake.

Response: Objection based on relevance. The subject of the foregoing Interrogatory, namely faxes intended for TCH but directed towards U.T. Physicians by mistake, is not relevant to any of the claims or defenses asserted in the above-captioned opposition proceeding.

28. Please identify all faxes intended for TCH but directed towards U.T. Physicians because of Applicant's Mark.

Response: Applicant is not aware of any instances of faxes intended for TCH but directed towards Applicant because of Applicant's Mark.

29. Please identify with particularity the date and circumstances of U.T. Physicians first awareness of Opposer's Mark.

Response: Objection based on undue burden. Applicant has many current employees and many former employees who were employed by Applicant at some point in time during the time period in which Opposer claims to have been using Opposer's Mark. Surveying each and every employee and former employee in order to ascertain which of them had an awareness of Opposer's Mark and then sorting those with an awareness to determine which first acquired an awareness of Opposer's Mark and the circumstances relating thereto would be unduly burdensome, especially in light of the fact that it is not clear what relevance an awareness of Opposer's Mark by Applicant has to the claims and defenses asserted in the above-captioned opposition proceeding.

Notwithstanding and without waiving any of the objections asserted to the foregoing Interrogatory, Applicant states that the following current employees of Applicant were formerly employees of and/or associated with Opposer at a time when Opposer claims it was using Opposer's Mark and were involved in providing the services that Opposer claims to be providing under that mark: Anthony Johnson, DO; Kenneth J. Moise, Jr. M.D. and Karen Moise, RN. Each of the persons identified in response to the foregoing Interrogatory is an employee of Applicant, and has as their business address and telephone number: 6410 Fannin St., Houston, TX 77030, (832) 325-7288.

30. Please identify the person or person who had the first awareness of Opposer's Mark.

Response: Applicant incorporates by reference its response to Interrogatory No. 29.

31. Please identify all people who worked on the trademark application file for Applicant's Mark, including the person or persons who drafted the application, prosecuted the application, and searched the application.

Response: Objection based on relevance. Neither the identity of persons who worked on the '881 Application nor the particulars of the drafting, prosecuting and searching done relating to that application is relevant to any claim or defense asserted in the above-captioned proceeding.

Notwithstanding and without waiving any of the objections asserted to the foregoing Interrogatory, Applicant states that it had the assistance of outside legal counsel in connection with the searching of Applicant's Mark and the drafting and prosecuting of the '881 Application and Applicant states further that the identity of the outside counsel that assisted Applicant is the person identified as the correspondent of record for the '881 Application in the public records of the United States Patent and Trademark Office, which are as readily accessible to Opposer as they are to Applicant. Applicant states further outside counsel was assisted by Tracy L. Fry-Longoria, an employee of Applicant whose business address and telephone number is 6410 Fannin St., Houston, TX 77030, (832) 325-7288.

Respectfully submitted,
/Raymond Rundelli/
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Attorneys for Applicant

VERIFICATION

I, Andrew Casas, hereby verify that I have read the foregoing Applicant's Answers and Objections to Opposer's Amended First Set of Interrogatories, and that the foregoing answers are true and correct based on my own personal knowledge and belief.

I hereby declare under penalty of perjury that the foregoing is true and correct.

Executed on March 4, 2013 at Houston, Texas.

A handwritten signature in dark ink, appearing to read "Andrew Casas", is written over a horizontal line.

CERTIFICATE OF SERVICE

A copy of the foregoing Written Response to Opposer's Amended First Set of Interrogatories was served, via email, this 4th day of March, 2013, on counsel of record for Opposer:

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/Raymond Rundelli/
An attorney for Applicant

Applicant U.T. Physicians' Privilege Log

Entry No	Docdate	To	From	Additional Recipients	Subject	Privilege Basis
1	9/12/2011	Casas, Andrew	Distefano, Susan	Spielman, Amanda	Correspondence regarding legal advice and request for legal advice.	Attorney Client
2	9/28/2012	Staller, Arlene McBride, Scott	Casas, Andrew		Request for legal advice.	Attorney Client/Work Product
3	9/26/2012	Casas, Andrew	Blackwell, Sean	Elliot, Holly Distefano, Susan McBride, Scott	Attachment to request for legal advice, request for legal advice and correspondence regarding legal advice.	Attorney Client/Work Product
4	9/28/2012	Staller, Arlene McBride, Scott	Casas, Andrew		Request for legal advice.	Attorney Client/Work Product
5	9/26/2011	Casas, Andrew	Blackwell, Sean	Elliot, Holly Distefano, Susan McBride, Scott	Attachment to request for legal advice, request for legal advice and correspondence regarding legal advice.	Attorney Client/Work Product
6	9/27/2012	Staller, Arlene D	McBride, Scott	Casas, Andrew Blackwell, Sean Elliot, Holly Distefano, Holly	Correspondence regarding legal advice and request for legal advice.	Attorney Client/Work Product
7	8/14/2012	Fry-Longoria, Tracy McBride, Scott	Casas, Andrew		Request for legal advice.	Attorney Client/Work Product
8	8/14/2012	Fry-Longoria, Tracy McBride, Scott	Casas, Andrew	Colasurdo, Giuseppe Hochner, Rose Distefano, Susan Elliot, Holly Cordola, Craig Staller, Arlene Dymond, Darlene	Attachment to request for legal advice, request for legal advice and correspondence regarding legal advice.	Attorney Client/Work Product
9	8/14/2012	Wilcox, Deborah	Fry-Longoria, Tracy		Request for legal advice.	Attorney Client/Work Product

10	8/14/2012	Wilcox, Deborah	Fry-Longoria, Tracy	Colasurdo, Giuseppe Hochner, Rose Distefano, Susan Elliot, Holly Cordola, Craig Staller, Arlene Dymond, Darlene	Attachment to request for legal advice, request for legal advice and correspondence regarding legal advice.	Attorney Client/Work Product
11	8/14/2012	Fry-Longoria, Tracy McBride, Scott Wolin, Robert	Wilcox, Deborah		Response to request for legal advice.	Attorney Client/Work Product
12	8/14/2012	Wilcox, Deborah	Fry-Longoria, Tracy		Request for legal advice.	Attorney Client/Work Product
13	8/14/2012	Wilcox, Deborah	Fry-Longoria, Tracy	Casas, Andrew McBride, Scott Colasurdo, Giuseppe Hochner, Rose Distefano, Susan Elliot, Holly Cordola, Craig Staller, Arlene Dymond, Darlene	Attachment to request for legal advice, request for legal advice and correspondence regarding legal advice.	Attorney Client/Work Product
14	8/14/2012	Wilcox, Deborah McBride, Scott	Fry-Longoria, Tracy		Request for legal advice.	Attorney Client/Work Product
15	8/14/2012	Wilcox, Deborah	Fry-Longoria, Tracy	Casas, Andrew McBride, Scott Colasurdo, Giuseppe Hochner, Rose Distefano, Susan Elliot, Holly Cordola, Craig Staller, Arlene Dymond, Darlene	Attachment to request for legal advice, request for legal advice and correspondence regarding legal advice.	Attorney Client/Work Product
16	9/19/2012	Casas, Andrew Blackwell, Sean	Fry-Longoria, Tracy	Wilcox, Deborah Waltos, Theresa Wolin, Robert	Legal advice.	Attorney Client
17		Casas, Andrew Blackwell, Sean	Fry-Longoria, Tracy	Wilcox, Deborah Waltos, Theresa Wolin, Robert	Attachment to legal advice.	Attorney Client

18	Casas, Andrew Blackwell, Sean	Fry-Longoria, Tracy	Wilcox, Deborah Waltos, Theresa Wolin, Robert	Attachment to legal advice.	Attorney Client
19	Casas, Andrew Blackwell, Sean	Fry-Longoria, Tracy	Wilcox, Deborah Waltos, Theresa Wolin, Robert	Attachment to legal advice.	Attorney Client
20	Casas, Andrew Blackwell, Sean	Fry-Longoria, Tracy	Wilcox, Deborah Waltos, Theresa Wolin, Robert	Attachment to legal advice.	Attorney Client
21	8/14/2012 Dymond, Darlene	Staller, Arlene D	Elliot, Holly	Correspondence regarding legal advice.	Attorney Client/Work Product
22	8/14/2012 Staller, Arlene Elliot, Holly	Casas, Andrew		Request for legal advice.	Attorney Client/Work Product
23	8/14/2012 Staller, Arlene Elliot, Holly	Casas, Andrew	Distefano, Susan Cordola, Craig Colasurdo, Giuseppe	Attachment to request for legal advice, request for legal advice and correspondence regarding legal advice.	Attorney Client/Work Product
24	9/28/2012 Staller, Arlene McBride, Scott	Casas, Andrew		Request for legal advice.	Attorney Client/Work Product
25	9/26/2012 Casas, Andrew	Blackwell, Sean	Elliot, Holly Distefano, Susan McBride, Scott	Attachment to request for legal advice, request for legal advice and correspondence regarding legal advice.	Attorney Client/Work Product
26	9/27/2012 Staller, Arlene D	McBride, Scott	Casas, Andrew Blackwell, Sean Elliot, Holly Distefano, Holly Elliot, Holly	Correspondence regarding legal advice and request for legal advice.	Attorney Client/Work Product
27	8/14/2012 Dymond, Darlene	Staller, Arlene D		Correspondence regarding legal advice.	Attorney Client/Work Product
28	8/14/2012 Staller, Arlene Elliot, Holly	Casas, Andrew		Request for legal advice.	Attorney Client/Work Product
29	8/14/2012 Staller, Arlene Elliot, Holly	Casas, Andrew	Distefano, Susan Cordola, Craig Colasurdo, Giuseppe	Attachment to request for legal advice, request for legal advice and correspondence regarding legal advice.	Attorney Client/Work Product
30	8/13/2012 Elliot, Holly Dymond, Darlene	Staller, Arlene		Correspondence regarding legal advice.	Attorney Client/Work Product

31	Elliot, Holly Dymond, Darlene	Staller, Arlene	Attachment to correspondence regarding legal advice.	Attorney Client/Work Product
32	7/18/2012 Blackwell, Sean C Tsao, Kuojen Casas, Andrew	Fry-Longoria, Tracy	Correspondence regarding legal advice.	Attorney Client
33	8/13/2012 Elliot, Holly Dymond, Darlene	Staller, Arlene	Correspondence regarding legal advice.	Attorney Client/Work Product
34	Elliot, Holly Dymond, Darlene	Staller, Arlene	Attachment to correspondence regarding legal advice.	Attorney Client/Work Product
35	9/19/2012 Fry-Longoria, Tracy L Waltos, Theresa Wolin, Robert Fry-Longoria, Tracy	Wilcox, Deborah	Legal advice.	Attorney Client
36	L Waltos, Theresa Wolin, Robert Fry-Longoria, Tracy	Wilcox, Deborah	Attachment to legal advice.	Attorney Client
37	L Waltos, Theresa Wolin, Robert Fry-Longoria, Tracy	Wilcox, Deborah	Attachment to legal advice.	Attorney Client
38	L Waltos, Theresa Wolin, Robert Fry-Longoria, Tracy	Wilcox, Deborah	Attachment to legal advice.	Attorney Client
39	L Waltos, Theresa Wolin, Robert Fry-Longoria, Tracy	Wilcox, Deborah	Attachment to legal advice.	Attorney Client
40	4/8/2011 Waltos, Theresa Wolin, Robert Reat, Daniel Tsao, Kuojen Meade, Donald	Brown, Darla	Request for legal advice and correspondence regarding legal advice.	Attorney Client
41	4/13/2011 Tsao, Kuojen Brown, Darla Meade, Donald	Daniel Reat	Correspondence regarding legal advice.	Attorney Client
42	9/27/2011 Meade, Donald	Wilcox, Deobrah	Legal advice.	Attorney Client



3 of 100 DOCUMENTS

Amazon Technologies, Inc. v. Jeffrey S. Wax

Opposition No. 91187118

Trademark Trial and Appeal Board

2009 TTAB LEXIS 712; 93 U.S.P.Q.2D (BNA) 1702

November 4, 2009, Decided

SUBSEQUENT HISTORY:

Summary judgment denied by, Summary judgment granted by, Claim dismissed by, Sanctions allowed by *Amazon Techs., Inc. v. Wax*, 2010 TTAB LEXIS 366 (Trademark Trial & App. Bd., Aug. 31, 2010)

OPINION BY: [*1]

ADLIN

OPINION:

THIS OPINION IS A PRECEDENT OF THE T.T.A.B.

Michael B. Adlin, Interlocutory Attorney:

This case now comes up for consideration of applicant's fully-briefed motion, filed June 29, 2009, to: (1) compel responses to his first sets of interrogatories and document requests; (2) test the sufficiency of opposer's responses to applicant's first requests for admission; (3) extend the discovery period for applicant only; and (4) enter various sanctions against opposer.

Applicant contends that opposer's responses to applicant's interrogatories, requests for production of documents and requests for admission are inadequate, because opposer served only "boilerplate objections" to the discovery requests, and opposer did not substantively respond to any of applicant's discovery requests. Applicant argues that opposer's objections are "unfounded," especially because many of applicant's discovery requests are "virtually identical to Discovery requests that Opposer served upon" applicant (emphasis in original). Applicant requests an extension of time so that he may conduct follow-up discovery, and that a variety of sanctions be imposed on opposer, for its "blatant [*2] disregard and abuse of the Discovery rules"

In its response to the motion, opposer does not dispute that it failed to substantively respond to any of applicant's discovery requests, or that some of applicant's requests were virtually identical to some of the discovery requests which opposer previously served on applicant. Opposer claims, however, that under Trademark *Rule 2.120(a)(3)*, it was not required to respond to any of applicant's discovery requests because applicant failed to serve initial disclosures, which is a prerequisite to serving discovery. In fact, opposer "notes that in its objections to Applicant's Discovery Requests, [opposer] stated that it was exempt from responding (at this time), due to Applicant's failure to comply with the applicable rules." n1 Opposer requests that applicant's motion be denied in its entirety, and that when dates are reset, applicant be allowed "the same period of time it had under the prior order, namely, one (1) day remaining in the discovery period."

n1 In its General Objections to applicant's first sets of interrogatories, document requests and requests for admission, opposer asserts that the requests "seek the disclosure of information that Opposer is exempt from providing at this time due to Applicant's failure to comply with the applicable rules." However, in its specific

objections to applicant's various discovery requests, opposer claims that the requests are "premature, particularly in that Opposer has not completed its factual discovery."

[*3]

In his reply brief, applicant claims that he timely served initial disclosures on January 30, 2009, and submits a copy thereof, including the certificate of service indicating timely service on opposer's address of record. Declaration of Theresa Zogakis P 3 and Ex. A to applicant's Reply Brief. Applicant also points out that during the meet and confer process leading up to the filing of applicant's motion, opposer never specified the basis of its "general objections" that applicant failed "to comply with the applicable rules." Indeed, during the meet and confer process, opposer sent a letter to applicant simply arguing that its objections are "valid" and that opposer "is not obligated to provide substantive responses to Applicant's Discovery Requests." However, it appears that opposer never provided a specific reason for withholding substantive responses to applicant's discovery requests, never mentioned applicant's alleged failure to serve initial disclosures during the meet and confer process and failed to raise the issue at all until it filed its response to applicant's motion to compel. In any event, applicant contends that opposer's remedy for applicant's alleged failure to serve [*4] initial disclosures was to file a motion to compel, not to refuse to respond to discovery requests. Finally, applicant claims that he responded to "at least" 800 written discovery requests served by opposer, and that he and a former owner n2 of the subject application appeared for two days of discovery depositions noticed by opposer.

n2 Applicant and another individual filed the subject application as co-applicants, and the other individual eventually assigned his interest in the application to applicant.

Opposer's claim that it was not required to substantively respond to applicant's discovery requests is based entirely on its mistaken belief that applicant failed to serve initial disclosures, n3 and Trademark *Rule 2.120(a)(3)*, which provides that "[a] party must make its initial disclosures prior to seeking discovery." See, *Kairos Institute of Sound Healing, LLC v. Doolittle Gardens, LLC*, 88 USPQ2d 1541 (TTAB 2008). In other words, opposer suggests that this is a simple case requiring [*5] nothing more than the application of Trademark *Rule 2.120(a)(3)*. It is not that simple, however.

n3 While it appears that applicant timely served his initial disclosures, we have no reason to doubt opposer's claim that it did not receive the disclosures even though they were apparently served on opposer's address of record.

Even if opposer honestly believed that applicant had failed to serve initial disclosures, opposer's apparent conclusion that all it needed to do was relay its understanding to applicant by making an obtuse reference to applicant's failure to comply with unspecified "rules" fails to recognize that the discovery rules go well beyond Trademark *Rule 2.120(a)(3)*. In fact, the rules impose duties and obligations not only on the party serving discovery, but also the party responding to discovery.

For example, "it is incumbent upon a party who has been served with interrogatories to respond by articulating his objections (with particularity) to those interrogatories which he believes to be [*6] objectionable, and by providing the information sought in those interrogatories which he believes to be proper." *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984)(emphasis supplied); see also, *Fed. R. Civ. P. 33(b)(4)* ("The grounds for objecting to an interrogatory must be stated with specificity. Any ground not stated in a timely objection is waived ...") and Advisory Committee Note to 1993 Amendment thereto ("Paragraph (4) is added to make clear that objections must be specifically justified, and that unstated or untimely grounds for objection ordinarily are waived."); *Redland Soccer Club, Inc. v. Department of the Army*, 55 F.3d 827, 856 (3d Cir. 1995); *McLeod, Alexander, Powell & Appfel, P.C. v. Quarles*, 894 F.2d 1482, 1485 (5th Cir. 1990); *St. Paul Reinsurance Co., Ltd. v. Commercial Financial Corp.*, 198 F.R.D. 508, 514 (N.D. Iowa 2000); *Safeco Insurance Co. of America v. Rawstrom*, 183 F.R.D. 668 (C.D. Cal. 1998).

In this case, opposer's objections were anything but specific. In fact, opposer made a total of 35 "General Objections" to applicant's interrogatories, document [*7] requests and requests for admission, and opposer made 171 "spe-

cific" objections to each of applicant's 171 written discovery requests, but opposer never once, in any of these purported general or purportedly "specific" objections, mentioned applicant's alleged failure to serve initial disclosures.

Opposer then compounded the problem by continuing to "hide the ball" during the meet and confer process. For example, in its June 25, 2009 letter to applicant, opposer stated:

We believe that the objections raised in [opposer's] Responses to Applicants' Discovery Requests are valid and that [opposer] is not obligated to provide substantive responses to Applicant's Discovery Requests. However, if you disagree, please advise us which objections you believe are without merit and we will attempt to discuss those issues with you.

Declaration of Jeffrey S. Wax P 7 and Ex. H. When applicant tried to address the objections specifically, opposer "merely restated Opposer's position," but again failed to mention the initial disclosures. Id. P 9. This was improper. See, e.g., *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986) (addressing parties' [*8] duties during meet and confer process).

In order for the meet and confer process to be meaningful and serve its intended purpose, "the parties must present to each other the merits of their respective positions with the same candor, specificity, and support during informal negotiations as during the briefing of discovery motions." *Nevada Power Co. v. Monsanto Co.*, 151 F.R.D. 118, 120 (D. Nev. 1993) (emphasis supplied) (construing a local rule containing meet and confer requirements similar to those in Trademark Rule 2.120(e)(1)). The meet and confer process cannot be truly complete until "after all the cards have been laid on the table," by both parties. *Id.*; see also, *Dondi Properties Corp. v. Commerce Savings and Loan Ass'n*, 121 F.R.D. 284, 289 (N.D. Tex. 1988) (construing a local rule less onerous than Trademark Rule 2.120(e)(1) and stating "The purpose of the conference requirement is to promote a frank exchange between counsel to resolve issues by agreement or to at least narrow and focus the matters in controversy before judicial resolution is sought.") (emphasis supplied). While it was initially applicant's obligation to confer [*9] with opposer prior to filing his motion, opposer was under an equal obligation to participate in good faith in applicant's efforts to resolve the matter.

Here, however, opposer failed to lay its cards on the table. Indeed, it essentially made a litany of boilerplate objections to all of applicant's discovery requests as a bluff, to disguise its true but unstated objection, and then when applicant called the bluff in the meet and confer process, opposer still failed to lay its cards down, resulting in the filing and consideration of an unnecessary motion to compel. n4 This dispute could and should have been resolved without the necessity of filing a motion to compel.

n4 By offering to "attempt to discuss" certain specific objections with applicant, opposer gave the impression that it might be productive for the parties to discuss particular objections individually, even though opposer knew full well that its refusal to substantively respond to the discovery requests was based on a single, but unstated, argument, i.e., that applicant failed to comply with Trademark Rule 2.120(a)(3).

[*10]

Opposer's mistaken but apparently honest belief that applicant failed to serve initial disclosures is no excuse. Where a party believes that it need not respond to discovery requests because the propounding party has not served initial disclosures, it has a duty to object, specifically, on that basis. Proceeding as opposer did here, by serving a litany of boilerplate objections and refusing to reveal the true basis for withholding responsive information, only serves to waste the parties' and the Board's time. Cf. Trademark Rule 2.120(d) ("If a party upon which interrogatories have been served believes that the number of interrogatories exceeds the limitation ... the party shall, within the time for (and instead of) serving answers and specific objections to the interrogatories, serve a general objection on the ground of their excessive number."); TBMP § 405.03(e) (2d ed. rev. 2004).

In short, because applicant timely served his initial disclosures, and because opposer, even if unaware of those disclosures, failed to specifically state its true objection to applicant's discovery requests, applicant's motion to compel and to test the sufficiency of opposer's responses to applicant's [*11] requests for admissions are hereby **GRANTED**. To the extent opposer's various boilerplate objections could be construed as specific to individual discovery requests, they

are **OVERRULED**, for two reasons. First, opposer has not even claimed, much less established, that any of applicant's individual discovery requests are objectionable in any specific manner or that any of opposer's boilerplate objections are valid. Second, applicant's discovery requests are in large part identical to requests which opposer served on applicant, and "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." TBMP § 402.01; see also, *Sentrol*, 231 USPQ at 667; *Medtronic*, 222 USPQ at 83. Accordingly, opposer is hereby ordered to serve, no later than **THIRTY DAYS** from the mailing date of this order, its responses, without objection on the merits, n5 to applicant's first sets of interrogatories, requests for production and requests for admission. See, *No Fear*, 54 USPQ2d at 1551. In the event opposer fails to respond to applicant's [*12] discovery requests as ordered herein, opposer may be subject to sanctions, potentially including entry of judgment against it. *Fed. R. Civ. P. 37(b)(2)*; Trademark Rule 2.120(g). n6

n5 The Board has previously distinguished objections on the merits of a discovery request from other types of objections:

Objections going to the merits of a discovery request include those which challenge the request as overly broad, unduly vague and ambiguous, burdensome and oppressive, as seeking non-discoverable information on expert witnesses, or as not calculated to lead to the discovery of admissible evidence. In contrast, claims that information sought by a discovery request is trade secret, business-sensitive or otherwise confidential, is subject to attorney-client or a like privilege, or comprises attorney work product, goes not to the merits of the request but to a characteristic or attribute of the responsive information.

No Fear, 54 USPQ2d 1551, 1554 (TTAB 2000).

n6 Of course, to the extent opposer maintains its objections based on the attorney-client privilege or attorney work product doctrine, it must produce a privilege log. *Fed. R. Civ. P. 26(b)(5)(A)(ii)*. Furthermore, opposer must produce allegedly confidential or proprietary information pursuant to the protective order applicable to this proceeding by operation of Trademark Rule 2.116(g).

[*13]

Turning next to applicant's motion for sanctions, it is premature, and therefore will be given no further consideration, because opposer has not, at this point, failed "to comply with an order of the Trademark Trial and Appeal Board relating to disclosure or discovery." Trademark Rule 2.120(g)(1).

Turning finally to applicant's request for an extension of the discovery period for applicant only, there are competing interests at stake. On the one hand, "the Board will, upon motion, reopen or extend discovery solely for the benefit of a party whose opponent, by ... delaying its responses to [d]iscovery, has unfairly deprived the propounding party of the right to take follow-up." *Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067, 1070 (TTAB 1990). Here, there is no question that, as a result of opposer's conduct, applicant's efforts to obtain timely and substantive discovery responses have been stymied. On the other hand, "[i]f a party wishes to have an opportunity to take 'follow-up' discovery after it receives responses to its initial requests for discovery, it must serve its initial requests early in the discovery period" TBMP § 403.05(a). [*14] In this case, applicant did not serve his discovery requests early, and in fact left himself only two weeks after opposer's discovery responses were due in order to conduct follow-up discovery. Under the circumstances of this case, a brief extension of the discovery period for applicant only is warranted, but applicant will not be given more time than he would have had if opposer had timely and properly responded to the discovery requests, and accordingly, applicant's motion for extension is **GRANTED**, to the extent that applicant is allowed two weeks to conduct follow-up discovery, subsequent to the due date for service of the responses opposer has been ordered to provide.

Conclusion

Applicant's motions to compel and to test the sufficiency, and to extend, are granted. Opposer shall respond to applicant's written discovery requests without objection on the merits within **thirty days** of the mailing date of this order. Proceedings herein are resumed and discovery, disclosure, trial and other dates are reset as follows:

Follow-Up Discovery Period for Applicant Only Opens	December 7, 2009
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Follow-Up Discovery Period for Applicant Only Closes	December 21, 2009
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Plaintiff's Pretrial Disclosures	February 4, 2010
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Plaintiff's 30-day Trial Period Ends	March 21, 2010
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Defendant's Pretrial Disclosures	April 5, 2010
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Defendant's 30-day Trial Period Ends	May 20, 2010
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Plaintiff's Rebuttal Disclosures	June 4, 2010
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Plaintiff's 15-day Rebuttal Period Ends [*15]	July 4, 2010
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Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark LawLikelihood of ConfusionSimilarityAppearance, Meaning & SoundGeneral OverviewTrademark LawU.S. Trademark Trial & Appeal Board ProceedingsOppositionsGeneral Overview



8 of 100 DOCUMENTS

The Pep Boys Manny, Moe & Jack of California v. Teera Hanharutaiwan and Krieng Wongtangjai

Opposition No. 105,133

Trademark Trial and Appeal Board

2002 TTAB LEXIS 552

August 28, 2002, Decided

JUDGES: [*1]

Before Cissel, Chapman and Bucher, Administrative Trademark Judges.

OPINION:

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

By the Board:

This case now comes up on opposer's combined "renewed" motion for summary judgment n1 or alternative motion to compel, filed October 15, 2001. The motion is fully briefed. n2

n1 Opposer filed its first motion for summary judgment on April 7, 1998 on the ground that applicants' application is void ab initio. The Board denied opposer's first motion for summary judgment in an order dated April 26, 2001.

n2 Applicants have requested that the Board disregard opposer's reply brief as untimely. Applicants' motion is not well taken, and accordingly, is denied. Trademark Rule 2.127(e)(1) provides fifteen days for the filing of a reply brief, and Trademark Rule 2.119(c) provides for an additional five days to be added to the fifteen-day time period when the response to a motion has been served by first class mail. In this case, applicants served their opposition to opposer's renewed motion for summary judgment by first class mail on November 13, 2001, and opposer was allowed fifteen days plus five days (for first class mail), or until December 3, 2001, to file a response. See Trademark Rules 2.127(e)(1) and 2.119(c). Accordingly, opposer's reply brief, filed December 3, 2001, was timely and applicants' request that it be disregarded is denied. We have considered opposer's reply brief pursuant to our discretion under Trademark Rule 2.127(e)(1).

[*2]

We turn first to opposer's "renewed" motion for summary judgment. Opposer's "renewed" motion for summary judgment is brought on the same ground as its prior summary judgment motion, namely, that there is no genuine issue of material fact that applicants did not use their [SEE ILLUSTRATION IN ORIGINAL] mark n3 in commerce prior to the filing date of the involved application, and that as a result, the application is void ab initio.

n3 Application Serial No. 74/519,445, filed April 22, 1994, claiming use in commerce since March 1994 for "truck accessories, namely front and rear bumper, vehicle seats, camper shell, gear shift lock, wheel house liner, anti-theft door security lock, anti-sway bar, finished safety glass windows for vehicles and side bumper" in International Class 12, and "fit floor tray, namely floor mats for vehicles," in International Class 27. This opposition involves both classes of goods.

In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issues of material fact and that it is entitled to judgment as a matter of law. See *Fed. R. Civ. P. 56(c)*. All reasonable [*3] inferences must be viewed in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). In considering the propriety of summary judgment, the Board may not resolve issues of material fact against the non-moving party; it may only ascertain whether such issues are present. See *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1993).

Having carefully considered the arguments and evidence submitted by the parties in connection with opposer's "renewed" motion for summary judgment, we find that there are genuine issues of material fact which preclude disposition of this matter by summary judgment. In particular, opposer has failed to establish that there is no genuine issue of material fact that applicants' use of their mark prior to the filing date of the application does not constitute use in commerce. Accordingly, we conclude that opposer has made an insufficient showing based on the undisputed facts herein to support a finding that, as a matter of law, the involved application is void ab initio.

In view thereof, opposer's "renewed" [*4] motion for summary judgment is denied.

In view of the fact that this is opposer's second motion for summary judgment on the same ground, both motions having been denied by the Board, opposer is hereby ordered not to file any further summary judgment motions in this case.

We now turn to opposer's alternative motion to compel in which opposer seeks an order compelling applicant to provide further responses to opposer's interrogatory Nos. 38 and 39 of its third set of interrogatories; to compel better responses from applicants to opposer's interrogatory Nos. 52 and 53 of its third set of interrogatories; to compel applicants to provide privileged information responsive to interrogatory Nos. 35 and 36 of opposer's third set of interrogatories; and to compel privileged documents responsive to opposer's third set of document request Nos. 55-60 and 62-64 as a result of applicants' waiver of their attorney-client privilege with respect to use in commerce.

We turn first to opposer's interrogatory Nos. 38 and 39. These requests respectively ask that applicants "identify (by number) each request of opposer's first, second and third requests for production of documents to applicant [sic] [*5] in this proceeding for which applicant [sic] has produced no documents" and "to identify (by number) each request of opposer's first, second and third requests for production of documents to applicant [sic] in this proceeding for [which] there are no responsive documents." Opposer argues that applicants have refused to provide this information and have offered "no legitimate reason for this refusal."

In response, applicants argue that opposer's interrogatory Nos. 38 and 39 "do not involve applicants' use in commerce allegations, are not directed to applicants' use in commerce allegations" but appear to be designed to "harass, burden, and annoy applicants."

In reply, opposer argues that applicants' reason for not answering opposer's interrogatory Nos. 38 and 39 is "unjustified."

Opposer's motion to compel is denied with regard to interrogatory Nos. 38 and 39. Applicants have provided opposer with this information in their responses to opposer's first, second and third document requests, and it is not necessary for applicants to provide a cumulative or duplicative response. See *Fed. R. Civ. P. Rule 26(b)(2)(i)*. n4 Moreover, this information [*6] is easily discernible to opposer from applicants' original responses; and accordingly, applicants need provide nothing further. In view thereof, opposer's motion to compel a further response to interrogatory Nos. 38 and 39 is denied.

n4 Under *Fed. R. Civ. P. 26(b)(2)(i)*, made applicable by Trademark Rule 2.116, the Board may limit discovery if it is found to be unreasonably cumulative, duplicative, or available to the parties from another source.

We now turn to opposer's interrogatory Nos. 52 and 53, seeking "for each product identified in the application opposed herein, identify separately each of the following time periods, each shipment of such product bearing or in connection with the CARRYBOY mark, by providing the date, shipper/carrier, number of units shipped, and name and address where shipped: (a) September 1, 1993 to March 31, 1994; (b) April 1, 1994 to December 31, 1995; (c) January 1, 1996 to December 31, 1996; and (d) January 1, 1997 to December 31, 1997" and "for each product identified in the application opposed herein, identify separately for each of the following time periods, each sale of such product bearing or in connection [*7] with the CARRYBOY mark, by providing the date, identity of the person to whom sold, number of units sold, and name and address where shipped: (a) September 1, 1993 to March 31, 1994; (b) April 1, 1994 to De-

ember 31, 1995; (c) January 1, 1996 to December 31, 1996; and (d) January 1, 1997 to December 31, 1997." Opposer argues that applicants' responses to interrogatory Nos. 52 and 53 are insufficient because applicants produced business records from which opposer cannot easily obtain the information, and because applicants have provided "no further information or guidance" with regard to these business records. n5

n5 Opposer's exhibit L contains the two invoices provided by opposer as applicants' response to opposer's interrogatory Nos. 52 and 53.

In response, applicants argue that with regard to interrogatory Nos. 52 and 53, applicants have "provided opposer with a breakdown by period time [and] by document number, which discloses the available information."

In reply, opposer's argue that applicants cannot rely on documents to respond to interrogatories if the documents do not include the information requested.

With regard to interrogatory Nos. 52 and 53, opposer has submitted [*8] two documents for Board review (as opposer's exhibit L), which applicants served as responses to interrogatory Nos. 52 and 53. We have reviewed the two documents, identified as invoice numbers 10004 and 10101. We agree with opposer that, with regard to these particular invoices, the description of goods is unclear.

Accordingly, opposer's motion to compel further responses to interrogatory Nos. 52 and 53 is granted to the extent that applicants must identify the goods listed in their invoice numbers 10004 and 10101, as shown in opposer's exhibit L. Applicants are ordered to supplement their responses to interrogatory Nos. 52 and 53 as indicated above within THIRTY days of the mailing date of this order.

We now turn to opposer's arguments that applicants have waived their attorney-client privilege with regard to "communications with and advise [sic] from counsel, and conversations about those communications" with respect to applicants' use in commerce by relying extensively on these communications with "both their prior counsel and present counsel" when opposing opposer's first motion for summary judgment; that applicants refused to provide information about these communications [*9] when opposer sought discovery of applicants' or their agent's communications with both prior and present counsel; and that since the attorney-client privilege has been waived, applicants should be compelled to produce all of the documents contained on applicants' privilege log, and any other assertedly privileged documents and/or information responsive to opposer's interrogatory Nos. 35 and 36 and document request Nos. 55-60 and 62-64.

In response, applicants argue that that they have complied with their discovery obligations and "confirmed that they have produced all non-privileged documents in their possession, custody and control with respect to all of opposer's requests for documents," including non-privileged documents from applicants' prior counsel; that applicants have provided supplemental responses regarding applicants' agent Mr. Tantiyavarong n6; and that the Board order of August 26, 2000, denying opposer's first motion for summary judgment, did not order applicants to disclose attorney-client communications or attorney work product documents to opposer nor find that the attorney-client privilege or attorney work product privilege had been waived.

n6 Vachara Yi Tantiyavarong has been identified by applicants as their agent. Applicants state in their response to opposer's motion for summary judgment that Mr. Tantiyavarong is the manager of Truck Style, the California corporation (owned 95 percent by applicants and 5 percent by Mr. Tantiyavarong) which represents applicants' product line in the United States. In their declarations, submitted with opposer's first motion for summary judgment, applicants averred that Mr. Tantiyavarong was asked by applicants to secure a United States registration for the involved application on behalf of applicants by hiring an attorney. Defendants' exhibits 2 and 3. Applicants further averred that "nearly all communications" with the attorney (with regard to the involved application) took place through Mr. Tantiyavarong. *Id.* Additionally, when the involved application was opposed, applicants averred that they requested that Mr. Tantiyavarong retain local counsel to assist them in the proceeding. *Id.* Lastly, Mr. Tantiyavarong's declaration, also filed in opposition to opposer's first motion for summary judgment, indicates that he had conversations with the retained attorneys on behalf of applicants. See defendants' exhibit 4.

[*10]

In reply, opposer asserts that it specifically seeks a ruling that applicants waived their attorney-client privilege by relying on attorney-client communications to defend against opposer's claims on opposer's first motion for summary judgment.

We now turn to the question of whether applicants waived their attorney-client privilege by opposing opposer's first motion for summary judgment with their argument and declarations in support thereof explaining that their misunderstanding of the meaning of the phrase "use in commerce" resulted in an initially incorrect answer to opposer's notice of opposition as well as incorrect responses to opposer's requests for admission.

The purpose of the attorney-client privilege is to encourage full and frank communication between attorneys and their clients by assuring clients that their disclosures will be held in confidence. *Upjohn Co. v. United States*, 449 U.S. 383, 389 (1981); and *Fisher v. United States*, 425 U.S. 391, 403 (1976). The privilege protects communications made in confidence by clients to their lawyers for the purpose of obtaining legal advice. n7 *Upjohn*, 449 U.S. at 395; *Fisher*, 425 U.S. at 403; [*11] and *In re Walsh*, 623 F.2d 489, 492 (7th Cir.), cert. denied, 449 U.S. 994 (1980). "The privilege only protects disclosure of communications; it does not protect disclosure of the underlying facts by those who communicated with the attorney." *United States v. El Paso Co.*, 682 F.2d 530, 538 n.10 (5th Cir. 1982), cert. denied, 466 U.S. 944 (1984). Thus, public disclosure of certain facts does not destroy attorney-client privilege with respect to attorney-client communications about those facts. See *In re Pioneer Hi-Bred International Inc.*, 238 F.3d 1370, 1374, 57 USPQ2d 1658, 1661 (Fed. Cir. 2001) (attorney-client privilege not waived with respect to merger by disclosure of existence of the merger, negotiations between the parties concerning the merger, or property rights of the respective parties); and *United States v. Rakes*, 136 F.3d 1, 5 (1st Cir. 1998) ("the privileged communication and the facts recounted within it are two different things" . . . "a client does not normally lose the [attorney-client] privilege as to communications with his attorney merely because he testifies at [*12] trial to the same events discussed with his lawyer.") A waiver of the attorney-client privilege occurs only when a party relies on or discloses advice of counsel or other privileged information in connection with the communication. See *Upjohn Co.*, 449 U.S. at 395; and *In re Pioneer Hi-Bred*, 238 F.3d at 1374, 57 USPQ2d at 1661.

n7 Although the attorney-client privilege exists, quintessentially, to shield communications between attorney and client, it sometimes reaches further and covers statements to and from third parties. See *United States v. Kovel*, 296 F.2d 918, 922 (2d Cir. 1961); see also *Westinghouse Electric Corp. v. Republic of the Philippines*, 951 F.2d 1414, 1424 (3rd Cir. 1991). Attorney-client privilege attaches to communications involving a third party agent of a client if the agent is involved in making information available to the attorney which is needed for the legal advice. 81 Am. Jur. 2d Witnesses, Sec. 382, 418-26, 428. Thus, to qualify for protection, statements to and from third parties must "be made in confidence for the purpose of obtaining legal advice from the lawyer." *Kovel*, 296 at 922 (emphasis supplied); *United States v. Adlman*, 68 F.3d 1495, 1499 (2d Cir. 1995) (recognizing that "the privilege . . . can extend to shield communications to others when the purpose of the communication is to assist the attorney in rendering advice to the client"). In this case, applicants' agent, Mr. Tantiavarong, had conversations with the attorneys on behalf of applicants for purposes of obtaining legal advice, see note 7 supra, and such communications would be covered by the privilege.

[*13]

Thus, the question here is whether any waiver of a privilege occurred when applicants and their agent submitted their declarations in opposition to opposer's first motion for summary judgment and disclosed information regarding their misunderstanding of the phrase "use in commerce." We have reviewed the original declarations provided by applicants and their agent in opposition to opposer's first motion for summary judgment and find nothing in the declarations indicates that applicants or their agent were relying on the content of any legal opinion or disclosing any legal opinion in their submissions. The information provided by applicants and their agent in their declarations is nothing more than a recitation of underlying facts regarding their misunderstanding of the phrase "use in commerce." As the Board stated in its order of April 26, 2001: "here applicants have adequately shown that *certain facts* relating to transportation of their goods to the United States . . . were previously not considered in making their discovery responses" [emphasis added] Further, disclosure of the privileged communications would appear duplicative since opposer was free to inquire about [*14] the underlying facts with respect to these communications involving use in commerce during the reopened discovery period, and in fact, did so. See *Upjohn*, 449 U.S. at 395-396.

In this case, we find no waiver of the attorney-client privilege with regard to the privileged communications, or privileged documents involving applicants' use in commerce. In view thereof, opposer's motion to compel production of

privileged information with regard to opposer's interrogatory Nos. 35 and 36, document request Nos. 55-60 and 62-64, and any privileged documents contained on applicants' privilege log relating to applicants' use in commerce is denied.

In summary, opposer's motion for summary judgment is denied, and opposer's motion to compel is denied in part and granted in part. Opposer's motion to compel is denied with respect to interrogatory Nos. 35, 36, 38, 39 and document request Nos. 55-60 and 62-64, but it is granted with respect to interrogatory Nos. 52 and 53 to the extent that applicants must identify the goods listed in invoice numbers 10004 and 10101, as shown in opposer's exhibit L, within THIRTY days of the mailing date of this order.

Proceedings are resumed. Trial [*15] dates are reset as follows:

DISCOVERY PERIOD TO CLOSE:

CLOSED

30-day testimony period for party in position of plaintiff
to close:

October 31, 2002

30-day testimony period for party in position of defendant
to close:

December 30, 2002

15-day rebuttal testimony period for party in position of
plaintiff to close:

February 13, 2003

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.

Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark Law Infringement Actions Summary Judgment Standards Trademark Law U.S. Trademark Trial & Appeal Board Proceedings Oppositions Grounds

GRAPHIC:

Illustration, no caption



UPJOHN CO. ET AL. v. UNITED STATES ET AL.

No. 79-886

SUPREME COURT OF THE UNITED STATES

449 U.S. 383; 101 S. Ct. 677; 66 L. Ed. 2d 584; 1981 U.S. LEXIS 56; 49 U.S.L.W. 4093; 81-1 U.S. Tax Cas. (CCH) P9138; 1980-81 Trade Cas. (CCH) P63,797; Fed. Sec. L. Rep. (CCH) P97,817; 47 A.F.T.R.2d (RIA) 523; 30 Fed. R. Serv. 2d (Callaghan) 1101

November 5, 1980, Argued
January 13, 1981, Decided

PRIOR HISTORY: CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT.

DISPOSITION: *600 F.2d 1223*, reversed and remanded.

DECISION:

Communications between corporate general counsel and corporate employees, held protected by attorney-client privilege; work-product doctrine, held applicable to Internal Revenue Service summons.

SUMMARY:

After a corporation's general counsel was informed of certain questionable payments made by one of the corporation's foreign subsidiaries to foreign government officials, he began an internal investigation which included the sending of questionnaires to foreign managers seeking detailed information concerning the payments. Interviews were also conducted with the managers and other corporate officers and employees. The Internal Revenue Service, during the course of an investigation to determine the tax consequences of the payments, issued a summons pursuant to *26 USCS 7602* demanding production of, among other things, the questionnaires and the general counsel's notes on the interviews. The corporation declined to produce the material sought on the grounds that it was protected from disclosure by the attorney-client privilege and constituted the "work product" of an attorney prepared in anticipation of litigation. The United States sought enforcement of the summons in the United States District Court for the Western District of Michigan, which adopted a magistrate's conclusion

that the summons should be enforced. On appeal, the United States Court of Appeals for the Sixth Circuit held that the attorney-client privilege did not apply to the extent the communications were made by officers and agents not responsible for directing the corporation's actions in response to legal advice, because the communications were not those of the "client," and that the work-product doctrine did not apply to IRS summonses (*600 F.2d 1223*).

On certiorari, the United States Supreme Court reversed and remanded. In an opinion by Rehnquist, J., joined by Brennan, Stewart, White, Marshall, Blackmun, Powell, and Stevens, JJ., and joined in pertinent part by Burger, Ch. J., it was held that (1) the communications between the corporation's employees and the general counsel, which were evidenced both by the responses to the questionnaires and by notes taken by the general counsel reflecting employee responses during the interviews, were protected by the attorney-client privilege, and accordingly disclosure of such communications could not be compelled by the Internal Revenue Service pursuant to an administrative summons under 7602 since the communications at issue were made by the employees to the general counsel, acting as such, at the direction of corporate superiors, in order to secure legal advice from counsel, and concerned matters within the scope of the employees' corporate duties, and (2) the work-product doctrine may be applied to tax summonses issued by the Internal Revenue Service under 7602, and therefore the work product of the corporation's general counsel, including notes and memoranda based on the oral statements of employees interviewed by the attorney, to the extent such material did not reveal communications already protected by the attorney-client privilege, did not have to be disclosed to the Internal Revenue Service simply on a showing of "substantial need" and the

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inability to obtain the equivalent "without undue hardship," especially in view of *Rule 26 of the Federal Rules of Civil Procedure* which accords special protection to work product revealing an attorney's mental processes.

Burger, Ch. J., concurring in part and concurring in the judgment, agreed with the court's holding as to the work-product doctrine, and expressed the view that the court, although properly holding that the communications in the case at bar were protected by the attorney-client privilege, should have made clear that, as a general rule, a communication is privileged at least when an employee or former employee speaks with an attorney at the direction of the management regarding conduct or proposed conduct within the scope of employment, provided the attorney is one authorized by the management to inquire into the subject and is seeking information to assist counsel in evaluating whether the employee's conduct has bound or would bind the corporation, assessing the legal consequences, if any, of that conduct, or formulating appropriate legal responses to actions that have been or may be taken by others with regard to that conduct.

LAWYERS' EDITION HEADNOTES:

[***LEdHN1]

REVENUE §74.5

IRS summons -- corporate communications -- attorney-client privilege --

Headnote:[1A][1B]

Communications between corporate employees and a corporation's general counsel--which are evidenced both by responses to questionnaires made by the corporation's foreign managers in connection with a corporate investigation into questionable payments made to foreign government officials, and by notes taken by the general counsel reflecting responses in interviews with corporate employees--are protected by the attorney-client privilege, and accordingly disclosure of such communications may not be compelled by the Internal Revenue Service pursuant to an administrative summons issued under *26 USCS 7602* during the course of an investigation into the tax consequences of the payments, where the communications at issue were made by the corporation's employees to the general counsel, acting as such, at the direction of corporate superiors in order to secure legal advice from counsel, and where the communications concerned matters within the scope of the employees' corporate duties.

[***LEdHN2]

REVENUE §74.5

IRS summons -- work-product doctrine --

Headnote:[2A][2B]

The work-product doctrine is applicable to tax summonses issued by the Internal Revenue Service under *26 USCS 7602*; accordingly, the work product of a corporation's general counsel including notes and memoranda based on the oral statements of corporate employees interviewed by the attorney in connection with an investigation into questionable payments made to foreign government officials--to the extent such materials do not reveal communications already protected by the attorney-client privilege--need not be disclosed to the Internal Revenue Service during the course of a tax investigation into the payments, simply on a showing by the Service of "substantial need" and the inability to obtain the equivalent "without undue hardship," especially in view of *Rule 26 of the Federal Rules of Civil Procedure*, which accords special protection from disclosure to work product revealing an attorney's mental processes, such as the general counsel's notes and memoranda.

[***LEdHN3]

EVIDENCE §699

attorney-client privilege -- scope of protection --

Headnote:[3]

The attorney-client privilege exists to protect not only the giving of professional advice to those who can act on it, but also the giving of information to the lawyer to enable him to give sound and informed advice.

[***LEdHN4]

EVIDENCE §699

attorney-client privilege -- scope of protection -- facts underlying communications --

Headnote:[4]

The attorney-client privilege only protects disclosure of communications; it does not protect disclosure of the underlying facts by those who communicated with the attorney.

[***LEdHN5]

REVENUE §74.5

tax summons -- traditional privileges and limitations --

Headnote:[5]

The obligation imposed by a tax summons remains subject to the traditional privileges and limitations.

SYLLABUS

When the General Counsel for petitioner pharmaceutical manufacturing corporation (hereafter petitioner) was informed that one of its foreign subsidiaries had made questionable payments to foreign government officials in order to secure government business, an internal investigation of such payments was initiated. As part of this investigation, petitioner's attorneys sent a questionnaire to all foreign managers seeking detailed information concerning such payments, and the responses were returned to the General Counsel. The General Counsel and outside counsel also interviewed the recipients of the questionnaire and other company officers and employees. Subsequently, based on a report voluntarily submitted by petitioner disclosing the questionable payments, the Internal Revenue Service (IRS) began an investigation to determine the tax consequences of such payments and issued a summons pursuant to 26 U. S. C. § 7602 demanding production of, *inter alia*, the questionnaires and the memoranda and notes of the interviews. Petitioner refused to produce the documents on the grounds that they were protected from disclosure by the attorney-client privilege and constituted the work product of attorneys prepared in anticipation of litigation. The United States then filed a petition in Federal District Court seeking enforcement of the summons. That court adopted the Magistrate's recommendation that the summons should be enforced, the Magistrate having concluded, *inter alia*, that the attorney-client privilege had been waived and that the Government had made a sufficient showing of necessity to overcome the protection of the work-product doctrine. The Court of Appeals rejected the Magistrate's finding of a waiver of the attorney-client privilege, but held that under the so-called "control group test" the privilege did not apply "[to] the extent that the communications were made by officers and agents not responsible for directing [petitioner's] actions in response to legal advice . . . for the simple reason that the communications were not the 'client's.'" The court also held that the work-product doctrine did not apply to IRS summonses.

Held:

1. The communications by petitioner's employees to counsel are covered by the attorney-client privilege insofar as the responses to the questionnaires and any notes reflecting responses to interview questions are concerned. Pp. 389-397.

(a) The control group test overlooks the fact that such privilege exists to protect not only the giving of professional advice to those who can act on it but also the giving of information to the lawyer to enable him to give sound and informed advice. While in the case of the individual client the provider of information and the

person who acts on the lawyer's advice are one and the same, in the corporate context it will frequently be employees beyond the control group (as defined by the Court of Appeals) who will possess the information needed by the corporation's lawyers. Middle-level -- and indeed lower-level -- employees can, by actions within the scope of their employment, embroil the corporation in serious legal difficulties, and it is only natural that these employees would have the relevant information needed by corporate counsel if he is adequately to advise the client with respect to such actual or potential difficulties. Pp. 390-392.

(b) The control group test thus frustrates the very purpose of the attorney-client privilege by discouraging the communication of relevant information by employees of the client corporation to attorneys seeking to render legal advice to the client. The attorney's advice will also frequently be more significant to noncontrol employees than to those who officially sanction the advice, and the control group test makes it more difficult to convey full and frank legal advice to the employees who will put into effect the client corporation's policy. P. 392.

(c) The narrow scope given the attorney-client privilege by the Court of Appeals not only makes it difficult for corporate attorneys to formulate sound advice when their client is faced with a specific legal problem but also threatens to limit the valuable efforts of corporate counsel to ensure their client's compliance with the law. Pp. 392-393.

(d) Here, the communications at issue were made by petitioner's employees to counsel for petitioner acting as such, at the direction of corporate superiors in order to secure legal advice from counsel. Information not available from upper-echelon management was needed to supply a basis for legal advice concerning compliance with securities and tax laws, foreign laws, currency regulations, duties to shareholders, and potential litigation in each of these areas. The communications concerned matters within the scope of the employees' corporate duties, and the employees themselves were sufficiently aware that they were being questioned in order that the corporation could obtain legal advice. Pp. 394-395.

2. The work-product doctrine applies to IRS summonses. Pp. 397-402.

(a) The obligation imposed by a tax summons remains subject to the traditional privileges and limitations, and nothing in the language or legislative history of the IRS summons provisions suggests an intent on the part of Congress to preclude application of the work-product doctrine. P. 398.

(b) The Magistrate applied the wrong standard when he concluded that the Government had made a sufficient

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showing of necessity to overcome the protections of the work-product doctrine. The notes and memoranda sought by the Government constitute work product based on oral statements. If they reveal communications, they are protected by the attorney-client privilege. To the extent they do not reveal communications they reveal attorneys' mental processes in evaluating the communications. As *Federal Rule of Civil Procedure 26*, which accords special protection from disclosure to work product revealing an attorney's mental processes, and *Hickman v. Taylor*, 329 U.S. 495, make clear, such work product cannot be disclosed simply on a showing of substantial need or inability to obtain the equivalent without undue hardship. P. 401.

COUNSEL: Daniel M. Gribbon argued the cause and filed briefs for petitioners.

Deputy Solicitor General Wallace argued the cause for respondents. With him on the brief were Solicitor General McCree, Assistant Attorney General Ferguson, Stuart A. Smith, and Robert E. Lindsay.*

* Briefs of amici curiae urging reversal were filed by Leonard S. Janofsky, Leon Jaworski, and Keith A. Jones for the American Bar Association; by Thomas G. Lilly, Alfred F. Belcuore, Paul F. Rothstein, and Ronald L. Carlson for the Federal Bar Association; by Erwin N. Griswold for the American College of Trial Lawyers et al.; by Stanley T. Kaleczyc and J. Bruce Brown for the Chamber of Commerce of the United States; and by Lewis A. Kaplan, James N. Benedict, Brian D. Forrow, John G. Koeltl, Standish Forde Medina, Jr., Renee J. Roberts, and Marvin Wexler for the Committee on Federal Courts et al.

William W. Becker filed a brief for the New England Legal Foundation as amicus curiae.

JUDGES: REHNQUIST, J., delivered the opinion of the Court, in which BRENNAN, STEWART, WHITE, MARSHALL, BLACKMUN, POWELL, and STEVENS, JJ., joined, and in Parts I and III of which BURGER, C. J., joined. BURGER, C. J., filed an opinion concurring in part and concurring in the judgment, post, p. 402.

OPINION BY: REHNQUIST

OPINION

[*386] [***589] [**681] JUSTICE REHNQUIST delivered the opinion of the Court.

[***LEdHR1A] [1A] [***LEdHR2A] [2A] We granted certiorari in this case to address important ques-

tions concerning the scope of the attorney-client privilege in the corporate context and the applicability of the work-product doctrine in proceedings to enforce tax summonses. 445 U.S. 925. With respect to the privilege question the parties and various *amici* have described our task as one of choosing between two "tests" which have gained adherents in the courts of appeals. We are acutely aware, however, that we sit to decide concrete cases and not abstract propositions of law. We decline to lay down a broad rule or series of rules to govern all conceivable future questions in this area, even were we able to do so. We can and do, however, conclude that the attorney-client privilege protects the communications involved in this case from compelled disclosure and that the work-product doctrine does apply in tax summons enforcement proceedings.

I

Petitioner Upjohn Co. manufactures and sells pharmaceuticals here and abroad. In January 1976 independent accountants conducting an audit of one of Upjohn's foreign subsidiaries discovered that the subsidiary made payments to or for the benefit of foreign government officials in order to secure government business. The accountants so informed petitioner Mr. Gerard Thomas, Upjohn's Vice President, Secretary, and General Counsel. Thomas is a member of the Michigan and New York Bars, and has been Upjohn's General Counsel for 20 years. He consulted with outside counsel and R. T. Parfet, Jr., Upjohn's Chairman of the Board. It was decided that the company would conduct an internal investigation of what were termed "questionable payments." As part of this investigation the attorneys prepared a letter containing a questionnaire which was sent to "All Foreign General and Area Managers" over the Chairman's signature. The letter [*387] began by noting recent disclosures that several American companies made "possibly illegal" payments to foreign government officials and emphasized that the management needed full information concerning any such payments made by Upjohn. The letter indicated that the Chairman had asked Thomas, identified as "the company's General Counsel," "to conduct an investigation for the purpose of determining the nature and magnitude of any payments made by the Upjohn Company or any of its subsidiaries to any employee or official of a foreign government." The questionnaire sought detailed information concerning such payments. Managers were instructed to treat the investigation as "highly confidential" and not to discuss it with anyone other than Upjohn employees [***590] who might be helpful in providing the requested information. Responses were to be sent directly to Thomas. Thomas and outside counsel also interviewed the recipients of the questionnaire and some 33

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other Upjohn officers or employees as part of the investigation.

On March 26, 1976, the company voluntarily submitted a preliminary report to the Securities and Exchange Commission on Form 8-K disclosing certain questionable payments.¹ A copy of the report was simultaneously submitted to the Internal Revenue Service, which immediately began an investigation to determine the tax consequences of the payments. Special agents conducting the investigation were given lists by Upjohn of all those interviewed and all who had responded to the questionnaire. On November 23, 1976, the Service issued a summons pursuant to 26 U. S. C. § 7602 demanding production of:

"All files relative to the investigation conducted under the supervision of Gerard Thomas to identify payments to employees of foreign governments and any [*682] political [*388] contributions made by the Upjohn Company or any of its affiliates since January 1, 1971 and to determine whether any funds of the Upjohn Company had been improperly accounted for on the corporate books during the same period.

"The records should include but not be limited to written questionnaires sent to managers of the Upjohn Company's foreign affiliates, and memorandums or notes of the interviews conducted in the United States and abroad with officers and employees of the Upjohn Company and its subsidiaries." App. 17a-18a.

The company declined to produce the documents specified in the second paragraph on the grounds that they were protected from disclosure by the attorney-client privilege and constituted the work product of attorneys prepared in anticipation of litigation. On August 31, 1977, the United States filed a petition seeking enforcement of the summons under 26 U. S. C. §§ 7402 (b) and 7604 (a) in the United States District Court for the Western District of Michigan. That court adopted the recommendation of a Magistrate who concluded that the summons should be enforced. Petitioners appealed to the Court of Appeals for the Sixth Circuit which rejected the Magistrate's finding of a waiver of the attorney-client privilege, 600 F.2d 1223, 1227, n. 12, but agreed that the privilege did not apply "[to] the extent that the communications were made by officers and agents not responsible for directing Upjohn's actions in response to legal advice . . . for the simple reason that the communications were not the 'client's.'" *Id.*, at 1225. The court reasoned that accepting petitioners' claim for a broader application of the privilege would encourage upper-echelon management to ignore unpleasant facts and create too broad a "zone of silence." Noting that Upjohn's counsel had interviewed officials such as the Chairman and President, the Court of Appeals remanded

to the District [***591] Court so that a determination of who was [*389] within the "control group" could be made. In a concluding footnote the court stated that the work-product doctrine "is not applicable to administrative summonses issued under 26 U. S. C. § 7602." *Id.*, at 1228, n. 13.

1 On July 28, 1976, the company filed an amendment to this report disclosing further payments.

II

Federal Rule of Evidence 501 provides that "the privilege of a witness . . . shall be governed by the principles of the common law as they may be interpreted by the courts of the United States in light of reason and experience." The attorney-client privilege is the oldest of the privileges for confidential communications known to the common law. 8 J. Wigmore, *Evidence* § 2290 (McNaughton rev. 1961). Its purpose is to encourage full and frank communication between attorneys and their clients and thereby promote broader public interests in the observance of law and administration of justice. The privilege recognizes that sound legal advice or advocacy serves public ends and that such advice or advocacy depends upon the lawyer's being fully informed by the client. As we stated last Term in *Trammel v. United States*, 445 U.S. 40, 51 (1980): "The lawyer-client privilege rests on the need for the advocate and counselor to know all that relates to the client's reasons for seeking representation if the professional mission is to be carried out." And in *Fisher v. United States*, 425 U.S. 391, 403 (1976), we recognized the purpose of the privilege to be "to encourage clients to make full disclosure to their attorneys." This rationale for the privilege has long been recognized by the Court, see *Hunt v. Blackburn*, 128 U.S. 464, 470 (1888) (privilege "is founded upon the necessity, in the interest and administration of justice, of the aid of persons having knowledge of the law and skilled in its practice, which assistance can only be safely and readily availed of when free from the consequences or the apprehension of disclosure"). Admittedly complications in the application of the privilege arise when the client is a corporation, which in theory is an artificial creature of the [*390] [*683] law, and not an individual; but this Court has assumed that the privilege applies when the client is a corporation, *United States v. Louisville & Nashville R. Co.*, 236 U.S. 318, 336 (1915), and the Government does not contest the general proposition.

[***LEdHR3] [3]The Court of Appeals, however, considered the application of the privilege in the corporate context to present a "different problem," since the client was an inanimate entity and "only the senior management, guiding and integrating the several operations, . . . can be said to possess an identity analogous to the

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corporation as a whole." 600 F.2d, at 1226. The first case to articulate the so-called "control group test" adopted by the court below, *Philadelphia v. Westinghouse Electric Corp.*, 210 F.Supp. 483, 485 (ED Pa.), petition for mandamus and prohibition denied *sub nom. General Electric Co. v. Kirkpatrick*, 312 F.2d 742 (CA3 1962), cert. denied, 372 U.S. 943 (1963), reflected a similar conceptual approach:

"Keeping in mind that the question is, Is it the corporation which is seeking the lawyer's advice [***592] when the asserted privileged communication is made?, the most satisfactory solution, I think, is that if the employee making the communication, of whatever rank he may be, is in a position to control or even to take a substantial part in a decision about any action which the corporation may take upon the advice of the attorney, . . . then, in effect, *he is (or personifies) the corporation* when he makes his disclosure to the lawyer and the privilege would apply." (Emphasis supplied.)

Such a view, we think, overlooks the fact that the privilege exists to protect not only the giving of professional advice to those who can act on it but also the giving of information to the lawyer to enable him to give sound and informed advice. See *Trammel, supra*, at 51; *Fisher, supra*, at 403. The first step in the resolution of any legal problem is ascertaining the factual background and sifting through the facts [*391] with an eye to the legally relevant. See ABA Code of Professional Responsibility, Ethical Consideration 4-1:

"A lawyer should be fully informed of all the facts of the matter he is handling in order for his client to obtain the full advantage of our legal system. It is for the lawyer in the exercise of his independent professional judgment to separate the relevant and important from the irrelevant and unimportant. The observance of the ethical obligation of a lawyer to hold inviolate the confidences and secrets of his client not only facilitates the full development of facts essential to proper representation of the client but also encourages laymen to seek early legal assistance."

See also *Hickman v. Taylor*, 329 U.S. 495, 511 (1947).

In the case of the individual client the provider of information and the person who acts on the lawyer's advice are one and the same. In the corporate context, however, it will frequently be employees beyond the control group as defined by the court below -- "officers and agents . . . responsible for directing [the company's] actions in response to legal advice" -- who will possess the information needed by the corporation's lawyers. Middle-level -- and indeed lower-level -- employees can,

by actions within the scope of their employment, embroil the corporation in serious legal difficulties, and it is only natural that these employees would have the relevant information needed by corporate counsel if he is adequately to advise the client with respect to such actual or potential difficulties. This fact was noted in *Diversified Industries, Inc. v. Meredith*, 572 F.2d 596 (CA8 1978) (en banc):

"In a corporation, it may be necessary to glean information relevant to a legal problem from middle management or non-management personnel as well as from top executives. The attorney dealing with a complex legal problem 'is thus faced with a "Hobson's choice". If he [*684] interviews employees not having "the very highest authority", [*392] their communications to him will not be privileged. If, on the other hand, he interviews *only* those employees with "the very highest authority", he may find it [***593] extremely difficult, if not impossible, to determine what happened." *Id.*, at 608-609 (quoting Weinschel, Corporate Employee Interviews and the Attorney-Client Privilege, 12 B. C. Ind. & Com. L. Rev. 873, 876 (1971)).

The control group test adopted by the court below thus frustrates the very purpose of the privilege by discouraging the communication of relevant information by employees of the client to attorneys seeking to render legal advice to the client corporation. The attorney's advice will also frequently be more significant to non-control group members than to those who officially sanction the advice, and the control group test makes it more difficult to convey full and frank legal advice to the employees who will put into effect the client corporation's policy. See, e. g., *Duplan Corp. v. Deering Milliken, Inc.*, 397 F.Supp. 1146, 1164 (SC 1974) ("After the lawyer forms his or her opinion, it is of no immediate benefit to the Chairman of the Board or the President. It must be given to the corporate personnel who will apply it").

The narrow scope given the attorney-client privilege by the court below not only makes it difficult for corporate attorneys to formulate sound advice when their client is faced with a specific legal problem but also threatens to limit the valuable efforts of corporate counsel to ensure their client's compliance with the law. In light of the vast and complicated array of regulatory legislation confronting the modern corporation, corporations, unlike most individuals, "constantly go to lawyers to find out how to obey the law," Burnham, The Attorney-Client Privilege in the Corporate Arena, 24 Bus. Law. 901, 913 (1969), particularly since compliance with the law in this area is hardly an instinctive matter, see, e. g., *United States v. United States Gypsum Co.*, 438 U.S. 422, 440-441 (1978) ("the behavior proscribed by the [Sherman] Act is [*393] often difficult to distinguish from the gray zone of socially acceptable and

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economically justifiable business conduct").² The test adopted by the court below is difficult to apply in practice, though no abstractly formulated and unvarying "test" will necessarily enable courts to decide questions such as this with mathematical precision. But if the purpose of the attorney-client privilege is to be served, the attorney and client must be able to predict with some degree of certainty whether particular discussions will be protected. An uncertain privilege, or one which purports to be certain but results in widely varying applications by the courts, is little better than no privilege at all. The very terms of the test adopted by the court below suggest the unpredictability of its application. The test restricts the availability of the privilege to those officers [***594] who play a "substantial role" in deciding and directing a corporation's legal response. Disparate decisions in cases applying this test illustrate its unpredictability. Compare, *e. g.*, *Hogan v. Zletz*, 43 F.R.D. 308, 315-316 (ND Okla. 1967), *aff'd in part sub nom. Natta v. Hogan*, 392 F.2d 686 (CA10 1968) (control group includes managers and assistant managers of patent division and research and development department), with *Congoleum Industries, Inc. v. GAF Corp.*, 49 F.R.D. 82, 83-85 (ED Pa. 1969), *aff'd*, 478 F.2d 1398 (CA3 1973) (control group includes only division and corporate [**685] vice presidents, and not two directors of research and vice president for production and research).

2 The Government argues that the risk of civil or criminal liability suffices to ensure that corporations will seek legal advice in the absence of the protection of the privilege. This response ignores the fact that the depth and quality of any investigations to ensure compliance with the law would suffer, even were they undertaken. The response also proves too much, since it applies to all communications covered by the privilege: an individual trying to comply with the law or faced with a legal problem also has strong incentive to disclose information to his lawyer, yet the common law has recognized the value of the privilege in further facilitating communications.

[*394] [***LEdHR1B] [1B] The communications at issue were made by Upjohn employees³ to counsel for Upjohn acting as such, at the direction of corporate superiors in order to secure legal advice from counsel. As the Magistrate found, "Mr. Thomas consulted with the Chairman of the Board and outside counsel and thereafter conducted a factual investigation to determine the nature and extent of the questionable payments *and to be in a position to give legal advice to the company with respect to the payments.*" (Emphasis supplied.) 78-1 USTC para. 9277, pp. 83,598, 83,599. Information, not available from upper-echelon management, was needed to supply a basis for legal advice con-

cerning compliance with securities and tax laws, foreign laws, currency regulations, duties to shareholders, and potential litigation in each of these areas.⁴ The communications concerned matters within the scope of the employees' corporate duties, and the employees themselves were sufficiently aware that they were being questioned in order that the corporation could obtain legal advice. The questionnaire identified Thomas as "the company's General Counsel" and referred in its opening sentence to the possible illegality of payments such as the ones on which information was sought. App. 40a. A statement of policy accompanying the questionnaire clearly indicated the legal implications of the investigation. The policy statement was issued "in order that there be no uncertainty in the future as to the policy with respect to the practices which are the subject of this investigation." [*395] It began "Upjohn will comply with all laws and regulations," and stated that commissions or payments "will not be used as a subterfuge for bribes or illegal payments" and that all payments must be "proper and legal." Any future agreements with foreign distributors or agents were to be approved "by a company attorney" and any questions concerning the policy were to be referred "to the company's General Counsel." *Id.*, at 165a-166a. This statement was issued to Upjohn employees worldwide, so that even those interviewees not receiving a questionnaire were aware of the legal implications of [***595] the interviews. Pursuant to explicit instructions from the Chairman of the Board, the communications were considered "highly confidential" when made, *id.*, at 39a, 43a, and have been kept confidential by the company.⁵ Consistent with the underlying purposes of the attorney-client privilege, these communications must be protected against compelled disclosure.

3 Seven of the eighty-six employees interviewed by counsel had terminated their employment with Upjohn at the time of the interview. App. 33a-38a. Petitioners argues that the privilege should nonetheless apply to communications by these former employees concerning activities during their period of employment. Neither the District Court nor the Court of Appeals had occasion to address this issue, and we decline to decide it without the benefit of treatment below.

4 See *id.*, at 26a-27a, 103a, 123a-124a. See also *In re Grand Jury Investigation*, 599 F.2d 1224, 1229 (CA3 1979); *In re Grand Jury Subpoena*, 599 F.2d 504, 511 (CA2 1979).

5 See Magistrate's opinion, 78-1 USTC para. 9277, p. 83,599: "The responses to the questionnaires and the notes of the interviews have been treated as confidential material and have not been disclosed to anyone except Mr. Thomas and outside counsel."

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[***LEdHR4] [4]The Court of Appeals declined to extend the attorney-client privilege beyond the limits of the control group test for fear that doing so would entail severe burdens on discovery and create a broad "zone of silence" over corporate affairs. Application of the attorney-client privilege to communications such as those involved here, however, puts the adversary in no worse position than if the communications had never taken place. The privilege only protects disclosure of communications; it does not protect disclosure of the underlying facts by those who communicated with the attorney:

"[The] protection of the privilege extends only to *communications* and not to facts. A fact is one thing and a communication concerning that fact is an entirely different [*396] [**686] thing. The client cannot be compelled to answer the question, 'What did you say or write to the attorney?' but may not refuse to disclose any relevant fact within his knowledge merely because he incorporated a statement of such fact into his communication to his attorney." *Philadelphia v. Westinghouse Electric Corp.*, 205 F.Supp. 830, 831 (ED Pa. 1962).

See also *Diversified Industries*, 572 F.2d, at 611; *State ex rel. Dudek v. Circuit Court*, 34 Wis. 2d 559, 580, 150 N. W. 2d 387, 399 (1967) ("the courts have noted that a party cannot conceal a fact merely by revealing it to his lawyer"). Here the Government was free to question the employees who communicated with Thomas and outside counsel. Upjohn has provided the IRS with a list of such employees, and the IRS has already interviewed some 25 of them. While it would probably be more convenient for the Government to secure the results of petitioner's internal investigation by simply subpoenaing the questionnaires and notes taken by petitioner's attorneys, such considerations of convenience do not overcome the policies served by the attorney-client privilege. As Justice Jackson noted in his concurring opinion in *Hickman v. Taylor*, 329 U.S., at 516: "Discovery was hardly intended to enable a learned profession to perform its functions . . . on wits borrowed from the adversary."

Needless to say, we decide only the case before us, and do not undertake to draft a set of rules which should govern challenges to investigatory subpoenas. Any such approach would violate the spirit of *Federal Rule of Evidence 501*. See S. Rep. No. 93-1277, p. 13 (1974) ("the recognition of a privilege based on a confidential relationship . . . should be determined on a case-by-case basis"); *Trammel*, 445 U.S., at 47; *United States v. Gillock*, 445 U.S. 360, 367 (1980). [***596] While such a "case-by-case" basis may to some slight extent undermine desirable certainty in the boundaries of the attorney-client [*397] privilege, it obeys the spirit of the Rules. At the same time we conclude that the narrow

"control group test" sanctioned by the Court of Appeals in this case cannot, consistent with "the principles of the common law as . . . interpreted . . . in the light of reason and experience," *Fed. Rule Evid. 501*, govern the development of the law in this area.

III

Our decision that the communications by Upjohn employees to counsel are covered by the attorney-client privilege disposes of the case so far as the responses to the questionnaires and any notes reflecting responses to interview questions are concerned. The summons reaches further, however, and Thomas has testified that his notes and memoranda of interviews go beyond recording responses to his questions. App. 27a-28a, 91a-93a. To the extent that the material subject to the summons is not protected by the attorney-client privilege as disclosing communications between an employee and counsel, we must reach the ruling by the Court of Appeals that the work-product doctrine does not apply to summonses issued under 26 U. S. C. § 7602. ⁶

6 The following discussion will also be relevant to counsel's notes and memoranda of interviews with the seven former employees should it be determined that the attorney-client privilege does not apply to them. See n. 3, *supra*.

The Government concedes, wisely, that the Court of Appeals erred and that the work-product doctrine does apply to IRS summonses. Brief for Respondents 16, 48. This doctrine was announced by the Court over 30 years ago in *Hickman v. Taylor*, 329 U.S. 495 (1947). In that case the Court rejected "an attempt, without purported necessity or justification, to secure written statements, private memoranda and personal recollections prepared or formed by an adverse party's counsel in the course of his legal duties." *Id.*, at 510. The Court noted that "it is essential that a lawyer work with [*398] a certain degree of privacy [**687] " and reasoned that if discovery of the material sought were permitted

"much of what is now put down in writing would remain unwritten. An attorney's thoughts, heretofore inviolate, would not be his own. Inefficiency, unfairness and sharp practices would inevitably develop in the giving of legal advice and in the preparation of cases for trial. The effect on the legal profession would be demoralizing. And the interests of the clients and the cause of justice would be poorly served." *Id.*, at 511.

The "strong public policy" underlying the work-product doctrine was reaffirmed recently in *United States v. Nobles*, 422 U.S. 225, 236-240 (1975), and has been substantially incorporated in *Federal Rule of Civil Procedure 26 (b)(3)*. ⁷

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7 This provides, in pertinent part:

"[A] party may obtain discovery of documents and tangible things otherwise discoverable under subdivision (b)(1) of this rule and prepared in anticipation of litigation or for trial by or for another party or by or for that other party's representative (including his attorney, consultant, surety, indemnitor, insurer, or agent) only upon a showing that the party seeking discovery has substantial need of the materials in the preparation of his case and that he is unable without undue hardship to obtain the substantial equivalent of the materials by other means. In ordering discovery of such materials when the required showing has been made, the court shall protect against disclosure of the mental impressions, conclusions, opinions, or legal theories of an attorney or other representative of a party concerning the litigation."

***LEdHR5] [5] As ***597] we stated last Term, the obligation imposed by a tax summons remains "subject to the traditional privileges and limitations." *United States v. Euge*, 444 U.S. 707, 714 (1980). Nothing in the language of the IRS summons provisions or their legislative history suggests an intent on the part of Congress to preclude application of the work-product doctrine. Rule 26 (b)(3) codifies the work-product doctrine, and the Federal Rules of Civil Procedure are made applicable [*399] to summons enforcement proceedings by Rule 81 (a)(3). See *Donaldson v. United States*, 400 U.S. 517, 528 (1971). While conceding the applicability of the work-product doctrine, the Government asserts that it has made a sufficient showing of necessity to overcome its protections. The Magistrate apparently so found, 78-1 USTC para. 9277, p. 83,605. The Government relies on the following language in *Hickman*:

"We do not mean to say that all written materials obtained or prepared by an adversary's counsel with an eye toward litigation are necessarily free from discovery in all cases. Where relevant and nonprivileged facts remain hidden in an attorney's file and where production of those facts is essential to the preparation of one's case, discovery may properly be had. . . . And production might be justified where the witnesses are no longer available or can be reached only with difficulty." 329 U.S., at 511.

The Government stresses that interviewees are scattered across the globe and that Upjohn has forbidden its employees to answer questions it considers irrelevant. The above-quoted language from *Hickman*, however, did not apply to "oral statements made by witnesses . . . whether presently in the form of [the attorney's] mental impres-

sions or memoranda." *Id.*, at 512. As to such material the Court did "not believe that any showing of necessity can be made under the circumstances of this case so as to justify production. . . . If there should be a rare situation justifying production of these matters, petitioner's case is not of that type." *Id.*, at 512-513. See also *Nobles*, *supra*, at 252-253 (WHITE, J., concurring). Forcing an attorney to disclose notes and memoranda of witnesses' oral statements is particularly disfavored because it tends to reveal the attorney's mental processes, 329 U.S., at 513 ("what he saw fit to write down regarding witnesses' remarks"); *id.*, at 516-517 ("[*688] the statement would be his [the [*400] attorney's] language, permeated [*598] with his inferences") (Jackson, J., concurring).⁸

8 Thomas described his notes of the interviews as containing "what I considered to be the important questions, the substance of the responses to them, my beliefs as to the importance of these, my beliefs as to how they related to the inquiry, my thoughts as to how they related to other questions. In some instances they might even suggest other questions that I would have to ask or things that I needed to find elsewhere." 78-1 USTC para. 9277, p. 83,599.

***LEdHR2B] [2B]Rule 26 accords special protection to work product revealing the attorney's mental processes. The Rule permits disclosure of documents and tangible things constituting attorney work product upon a showing of substantial need and inability to obtain the equivalent without undue hardship. This was the standard applied by the Magistrate, 78-1 USTC para. 9277, p. 83,604. Rule 26 goes on, however, to state that "[in] ordering discovery of such materials when the required showing has been made, the court shall protect against disclosure of the mental impressions, conclusions, opinions or legal theories of an attorney or other representative of a party concerning the litigation." Although this language does not specifically refer to memoranda based on oral statements of witnesses, the *Hickman* court stressed the danger that compelled disclosure of such memoranda would reveal the attorney's mental processes. It is clear that this is the sort of material the draftsmen of the Rule had in mind as deserving special protection. See Notes of Advisory Committee on 1970 Amendment to Rules, 28 U. S. C. App., p. 442 ("The subdivision . . . goes on to protect against disclosure the mental impressions, conclusions, opinions, or legal theories . . . of an attorney or other representative of a party. The *Hickman* opinion drew special attention to the need for protecting an attorney against discovery of memoranda prepared from recollection of oral interviews. The courts have steadfastly safeguarded against disclosure of lawyers' mental impressions and legal theories . . .").

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[*401] Based on the foregoing, some courts have concluded that *no* showing of necessity can overcome protection of work product which is based on oral statements from witnesses. See, e. g., *In re Grand Jury Proceedings*, 473 F.2d 840, 848 (CA8 1973) (personal recollections, notes, and memoranda pertaining to conversation with witnesses); *In re Grand Jury Investigation*, 412 F.Supp. 943, 949 (ED Pa. 1976) (notes of conversation with witness "are so much a product of the lawyer's thinking and so little probative of the witness's actual words that they are absolutely protected from disclosure"). Those courts declining to adopt an absolute rule have nonetheless recognized that such material is entitled to special protection. See, e. g., *In re Grand Jury Investigation*, 599 F.2d 1224, 1231 (CA3 1979) ("special considerations . . . must shape any ruling on the discoverability of interview memoranda . . . ; such documents will be discoverable only in a 'rare situation'"); cf. *In re Grand Jury Subpoena*, 599 F.2d 504, 511-512 (CA2 1979).

We do not decide the issue at this time. It is clear that the Magistrate applied the wrong standard when he concluded that the Government had made a sufficient showing of necessity to overcome the protections of the work-product doctrine. The Magistrate applied the "substantial [***599] need" and "without undue hardship" standard articulated in the first part of *Rule 26 (b)(3)*. The notes and memoranda sought by the Government here, however, are work product based on oral statements. If they reveal communications, they are, in this case, protected by the attorney-client privilege. To the extent they do not reveal communications, they reveal the attorneys' mental processes in evaluating the communications. As *Rule 26* and *Hickman* make clear, such work product cannot be disclosed simply on a showing of substantial need and inability to obtain the equivalent without undue hardship.

While we are not prepared at this juncture to say that such material is always protected by the work-product rule, we [*402] [**689] think a far stronger showing of necessity and unavailability by other means than was made by the Government or applied by the Magistrate in this case would be necessary to compel disclosure. Since the Court of Appeals thought that the work-product protection was never applicable in an enforcement proceeding such as this, and since the Magistrate whose recommendations the District Court adopted applied too lenient a standard of protection, we think the best procedure with respect to this aspect of the case would be to reverse the judgment of the Court of Appeals for the Sixth Circuit and remand the case to it for such further proceedings in connection with the work-product claim as are consistent with this opinion.

Accordingly, the judgment of the Court of Appeals is reversed, and the case remanded for further proceedings.

It is so ordered.

CONCUR BY: BURGER (In Part)

CONCUR

CHIEF JUSTICE BURGER, concurring in part and concurring in the judgment.

I join in Parts I and III of the opinion of the Court and in the judgment. As to Part II, I agree fully with the Court's rejection of the so-called "control group" test, its reasons for doing so, and its ultimate holding that the communications at issue are privileged. As the Court states, however, "if the purpose of the attorney-client privilege is to be served, the attorney and client must be able to predict with some degree of certainty whether particular discussions will be protected." *Ante*, at 393. For this very reason, I believe that we should articulate a standard that will govern similar cases and afford guidance to corporations, counsel advising them, and federal courts.

The Court properly relies on a variety of factors in concluding that the communications now before us are privileged. See *ante*, at 394-395. Because of the great importance of the issue, in my view the Court should make clear now that, as a [*403] general rule, a communication is privileged at least when, as here, an employee or former employee speaks at the direction of the management with an attorney regarding conduct or proposed conduct within the scope of employment. The attorney must be one authorized by the management to inquire into the subject and must be seeking information to assist counsel in performing any of the following functions: (a) evaluating [***600] whether the employee's conduct has bound or would bind the corporation; (b) assessing the legal consequences, if any, of that conduct; or (c) formulating appropriate legal responses to actions that have been or may be taken by others with regard to that conduct. See, e. g., *Diversified Industries, Inc. v. Meredith*, 572 F.2d 596, 609 (CA8 1978) (en banc); *Harper & Row Publishers, Inc. v. Decker*, 423 F.2d 487, 491-492 (CA7 1970), *aff'd* by an equally divided Court, 400 U.S. 348 (1971); *Duplan Corp. v. Deering Milliken, Inc.*, 397 F.Supp. 1146, 1163-1165 (SC 1974). Other communications between employees and corporate counsel may indeed be privileged -- as the petitioners and several *amici* have suggested in their proposed formulations * -- but the need for certainty does not compel us now to prescribe all the details of the privilege in this case.

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* See Brief for Petitioners 21-23, and n. 25; Brief for American Bar Association as *Amicus Curiae* 5-6, and n. 2; Brief for American College of Trial Lawyers and 33 Law Firms as *Amici Curiae* 9-10, and n. 5.

Nevertheless, to say we should not reach all facets of the privilege does not mean that we should neglect our duty to provide guidance in a case that squarely presents the question in a traditional adversary context. Indeed, because *Federal Rule of Evidence 501* provides that the law of privileges "shall be governed by the principles of the common law as they may be interpreted by the courts of the United States in the light of reason and experience," this Court has a special duty to clarify aspects of the law of privileges properly [*404] before us. Simply asserting that this failure "may to some slight extent undermine desirable certainty," *ante*, at 396, neither minimizes the consequences [**690] of continuing uncertainty and confusion nor harmonizes the inherent dissonance of acknowledging that uncertainty while declining to clarify it within the frame of issues presented.

REFERENCES

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11 Am Jur Pl & Pr Forms (Rev), Federal Practice and Procedure, Form 1093.2

13 Am Jur Trials 1, Defending Federal Tax Evasion Cases

26 USCS 7602

RIA Federal Tax Coordinator 2d T-1135 et seq.

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L Ed Index to Annos, Attorney and Client; Income Taxes

ALR Quick Index, Discovery; Income Taxes; Privileged and Confidential Matters

Federal Quick Index, Privileged Communications; Tax Enforcement; Work Product Doctrine

Annotation References:

What matters are protected by attorney-client privilege or are proper subject of inquiry by Internal Revenue Service where attorney is summoned in connection with taxpayer-client under federal tax examination . 15 ALR Fed 771.

Attorney-client privilege in federal courts: under what circumstances can corporation claim privilege for communications from its employees and agent corporation's attorney. 9 ALR Fed 685.

Development, since *Hickman v Taylor*, of "work product" doctrine , 35 ALR3d 412.



FISHER ET AL. v. UNITED STATES ET AL.

No. 74-18

SUPREME COURT OF THE UNITED STATES

425 U.S. 391; 96 S. Ct. 1569; 48 L. Ed. 2d 39; 1976 U.S. LEXIS 98; 76-1 U.S. Tax Cas. (CCH) P9353; 37 A.F.T.R.2d (RIA) 1244

**November 3, 1975, Argued
April 21, 1976 ***

* Together with No. 74-611, *United States et al. v. Kasmir et al.*, on certiorari to the United States Court of Appeals for the Fifth Circuit.

PRIOR HISTORY: CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

DISPOSITION: The court affirmed the judgment of the Third Circuit and reversed the judgment of the Fifth Circuit. The accountant's documents at issue were not privileged either in the hands of the lawyers or of the clients since papers demanded were not clients' private papers; production of the documents would involve no incriminating testimony within the protection of the *Fifth Amendment*.

SUMMARY:

These cases presented the question whether enforcement of summonses served by the Internal Revenue Service on taxpayers' attorneys in investigations of possible civil or criminal liability under the federal income tax laws--which summonses directed the attorneys to produce relevant documents of the taxpayers' accountants that had been given to the attorneys by the taxpayers for the purpose of obtaining legal advice in the tax investigations--violated the taxpayers' *Fifth Amendment* privilege against self-incrimination. In case No. 74-18, the United States District Court for the Eastern District of Pennsylvania granted enforcement of the summons (352 *F Supp* 731), and the United States Court of Appeals for the Third Circuit affirmed, holding that the taxpayers there involved had never acquired a possessory interest in the documents, and that the documents were not immune in the hands of their attorney (500 *F2d* 683). In case No. 74-611, the United States District Court for the Northern District of Texas granted enforcement of the

summons against the taxpayer's attorney (enforcement also being granted as to a summons that had been served on the taxpayer's accountant), but the United States Court of Appeals for the Fifth Circuit reversed in pertinent part, holding that under the *Fifth Amendment*, the documents would have been privileged if production had been sought from the taxpayer while he retained possession of the documents, and that in light of the confidential nature of the attorney-client relationship, the taxpayer retained constructive possession of the evidence and thus retained *Fifth Amendment* protection (499 *F2d* 444).

On certiorari, the United States Supreme Court affirmed as to case No. 74-18, and reversed as to case No. 74-611. In an opinion by White, J., expressing the view of six members of the court, it was held that (1) enforcement of the summonses against the taxpayers' attorneys did not violate the taxpayers' *Fifth Amendment* privilege against self-incrimination, since such enforcement did not "compel" the taxpayers to be "witnesses" against themselves, and did not deprive them of any privilege not to be compelled to testify and not to be compelled to produce private papers in their personal possession, and (2) although the attorney-client privilege applied to documents in an attorney's hands which would have been privileged in his client's hands by reason of the *Fifth Amendment* privilege against self-incrimination, nevertheless the attorney-client privilege did not bar enforcement of the summonses in the instant cases, where the taxpayers, if production of the documents had been sought from them, could not have invoked the *Fifth Amendment* privilege against self-incrimination, since even though by producing the documents the taxpayers would have tacitly conceded their existence, their possession or control by the taxpayer, and the taxpayer's

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belief that the documents were those described in the subpoenas, nevertheless the taxpayers' acts of producing the documents would not have involved testimonial self-incrimination within the protection of the *Fifth Amendment*.

Brennan, J., concurred in the judgment, expressing the view that (1) given the prior access by the taxpayers' accountants to the papers involved in the instant proceedings, and given the wholly business nature of the papers, the privilege against self-incrimination did not protect the papers from production, but (2) the privilege should be construed to safeguard against governmental intrusions on personal privacy to compel either self-incriminating oral statements or the production of self-incriminating evidence recorded in one's private books and papers.

Marshall, J., concurring in the judgment, expressed the view that the court's new approach for deciding when the *Fifth Amendment* privilege could be asserted to bar production of documentary evidence--resting on the tacit verification inherent in the act of production that the document existed, was in the possession of the producer, and was the one sought by the subpoena--should be applied to provide substantially the same protection as the court's prior focus on the contents and private nature of the document subpoenaed.

Stevens, J., did not participate.

LAWYERS' EDITION HEADNOTES:

***LEdHN1]

WITNESSES §76

self-incrimination -- documents in attorney's possession --

Headnote:[1A][1B][1C]

Enforcement of a summons served by the Internal Revenue Service on a taxpayer's attorney in an investigation of possible civil or criminal liability under the federal income tax laws--which summons directed the attorney to produce relevant documents of the taxpayer's accountant that had been given to the attorney by the taxpayer for the purpose of obtaining legal advice--does not violate the taxpayer's *Fifth Amendment* privilege against self-incrimination, since enforcement against the attorney does not "compel" the taxpayer to be a "witness" against himself or to do anything, it being immaterial whether the *Fifth Amendment* would have barred a subpoena directing the taxpayer to produce the documents while they were in his hands, or that the attorney was the taxpayer's agent and the taxpayer might have had a reasonable expectation of privacy for the records in the attorney's hands; the situation is not one where construc-

tive possession is so clear or relinquishment of possession so temporary and insignificant as to leave the personal compulsion upon the taxpayer substantially intact, since the documents sought were obtainable without personal compulsion on the taxpayer, who retained any privilege he had not to be compelled to testify against himself and not to be compelled himself to produce private papers in his possession.

***LEdHN2]

WITNESSES §72

privilege against self-incrimination --

Headnote:[2]

Under the *Fifth Amendment* privilege against self-incrimination, a party is privileged from producing evidence but not from its production.

***LEdHN3]

WITNESSES §72

privilege against self-incrimination -- protection of privacy --

Headnote:[3]

Although one of the purposes served by the *Fifth Amendment* privilege against compelled testimonial self-incrimination is that of protecting personal privacy, nevertheless not every invasion of privacy violates the privilege, and the *Fifth Amendment* will not be applied to prevent the otherwise proper acquisition or use of evidence which does not involve compelled testimonial self-incrimination of some sort.

***LEdHN4]

SEIZURE §5

WITNESSES §72

privilege against self-incrimination -- reasonableness --

Headnote:[4]

The *Fifth Amendment's* strictures against self-incrimination, unlike the *Fourth Amendment's* strictures against unreasonable searches and seizures, are not removed by showing reasonableness.

***LEdHN5]

SEIZURE §3

invasion of privacy -- warrant --

Headnote:[5]

425 U.S. 391, *; 96 S. Ct. 1569, **;
48 L. Ed. 2d 39, ***; 1976 U.S. LEXIS 98

When the government's reason to believe incriminating evidence will be found becomes sufficiently great, an invasion of privacy becomes justified and a warrant to search and seize will issue.

[***LEdHN6]

WITNESSES §72

privilege against self-incrimination --

Headnote:[6]

The *Fifth Amendment* privilege against self-incrimination protects against compelled testimony, not the disclosure of private information.

[***LEdHN7]

LAW §925

EVIDENCE §698

SEIZURE §25

WITNESSES §72

private information -- constitutional protection --

Headnote:[7]

Insofar as private information not obtained through compelled self-incriminating testimony is legally protected, its protection stems from sources other than the *Fifth Amendment* privilege against self-incrimination, such as (1) the *Fourth Amendment's* protection against seizures without warrant or probable cause and against subpoenas which suffer from too much indefiniteness or breadth in the things required to be "particularly described," (2) the *First Amendment*, or (3) evidentiary privileges such as the attorney-client privilege.

[***LEdHN8]

SEIZURE §26

validity of IRS summons --

Headnote:[8A][8B]

A summons served by the Internal Revenue Service on a taxpayer's attorney in an investigation of possible civil or criminal liability, which summons directed the attorney to produce relevant documents of the taxpayer's accountant that had been given to the attorney by the taxpayer for the purpose of obtaining legal advice, does not violate the *Fourth Amendment*, where such summons is narrowly drawn and seeks only documents of unquestionable relevance to the tax investigation.

[***LEdHN9]

EVIDENCE §699

WITNESSES §76

attorney-client privilege -- self-incrimination --
documents in attorney's hands --

Headnote:[9A][9B][9C]

Although the attorney-client privilege applies to documents in an attorney's hands which would have been privileged in his client's hands by reason of the *Fifth Amendment* privilege against self-incrimination, nevertheless the attorney-client privilege does not bar enforcement of a summons served by the Internal Revenue Service on a taxpayer's attorney in an investigation of possible civil or criminal liability under the federal income tax laws--which summons directed the attorney to produce relevant documents of the taxpayer's accountant that had been given to the attorney by the taxpayer to obtain legal advice in the tax investigation--since enforcement of a summons addressed to the taxpayer while the documents were in his possession would have involved no incriminating testimony and thus would not have been barred by the *Fifth Amendment* privilege against self-incrimination.

[***LEdHN10]

EVIDENCE §699

attorney-client privilege --

Headnote:[10A][10B]

The attorney-client privilege may be raised by the attorney.

[***LEdHN11]

EVIDENCE §699

attorney-client privilege -- purpose --

Headnote:[11]

Confidential disclosures made by a client to his attorney in order to obtain legal assistance are privileged; the purpose of the privilege is to encourage clients to make full disclosure to their attorneys, but since the privilege has the effect of withholding relevant information from the fact-finder, it applies only where necessary to achieve its purpose and protects only those disclosures which might not have been made absent the privilege.

[***LEdHN12]

EVIDENCE §699

attorney-client privilege -- production of documents

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Headnote:[12]

425 U.S. 391, *; 96 S. Ct. 1569, **;
48 L. Ed. 2d 39, ***; 1976 U.S. LEXIS 98

Under the attorney-client privilege, when the client himself would be privileged from production of a document, either as a party at common law or as exempt from self-incrimination, his attorney having possession of the document is not bound to produce it, where the transfer of the document to the attorney was for the purpose of obtaining legal advice.

[***LEdHN13]

SEIZURE §8

evidentiary matters --

Headnote:[13]

Purely evidentiary materials, as well as contraband and fruits and instrumentalities of crime, may be searched for and seized under proper circumstances.

[***LEdHN14]

WITNESSES §88

privilege against self-incrimination --

Headnote:[14]

The *Fifth Amendment* privilege against self-incrimination does not independently proscribe the compelled production of every sort of incriminating evidence, but applies only when the accused is compelled to make a testimonial communication that is incriminating.

[***LEdHN15]

WITNESSES §81

privilege against self-incrimination -- partnership records --

Headnote:[15]

Neither a partnership nor the individual partners are shielded from compelled production of partnership records on self-incrimination grounds.

[***LEdHN16]

WITNESSES §76

privilege against self-incrimination -- production of taxpayer's records --

Headnote:[16]

Although a subpoena served on a taxpayer in an investigation of possible civil or criminal liability under the federal income tax laws--which subpoena requires the taxpayer to produce his accountant's workpapers in the taxpayer's possession--involves substantial compulsion, nevertheless it does not compel oral testimony, nor does it ordinarily compel the taxpayer to restate or affirm

the truth of the documents sought, and thus the *Fifth Amendment* privilege against self-incrimination is not violated by the fact alone that the papers on their face might incriminate the taxpayer, the privilege protecting a person only against being incriminated by his own compelled testimonial communications; the taxpayer cannot avoid compliance with the subpoena merely by asserting that the documents contain incriminating writing, whether his own or that of someone else, since even though by producing the documents the taxpayer tacitly concedes their existence, their possession or control by the taxpayer, and the taxpayer's belief that the documents are those described in the subpoena, nevertheless the act of producing the documents, which is the only thing that the taxpayer is compelled to do, does not itself involve testimonial self-incrimination within the protection of the *Fifth Amendment*.

[***LEdHN17]

WITNESSES §76

privilege against self-incrimination -- production of documents --

Headnote:[17A][17B]

The fact that subpoenaed documents may have been written by the person asserting the *Fifth Amendment* privilege against self-incrimination is insufficient to trigger the privilege; unless the government has compelled the subpoenaed person to write the document, the fact that it was written by him is not controlling with respect to the *Fifth Amendment* privilege.

[***LEdHN18]

WITNESSES §93.5

privilege against self-incrimination -- handwriting exemplar --

Headnote:[18]

Although a handwriting exemplar, required to be furnished by the accused, may be incriminating to the accused, and although he is compelled to furnish it, nevertheless his *Fifth Amendment* privilege against self-incrimination is not violated because nothing he has said or done is sufficiently testimonial for purposes of the privilege.

[***LEdHN19]

EVIDENCE §532

subpoenaed documents -- authentication --

Headnote:[19A][19B]

425 U.S. 391, *; 96 S. Ct. 1569, **;
48 L. Ed. 2d 39, ***; 1976 U.S. LEXIS 98

In producing his accountant's work papers and letters pursuant to a subpoena, a taxpayer merely indicates his belief that the documents are those described in the subpoena, but does not "authenticate" the documents; the taxpayer is not competent to authenticate the documents either by producing them or by testifying orally, since he did not prepare the documents and cannot vouch for their accuracy; the documents are not admissible in evidence against the taxpayer without authenticating testimony by the accountant.

SYLLABUS

In each of these cases taxpayers, who were under investigation for possible civil or criminal liability under the federal income tax laws after having obtained from their respective accountants certain documents relating to the accountants' preparation of their tax returns, transferred the documents to their respective attorneys to assist the taxpayers in connection with the investigations. Subsequently, the Internal Revenue Service served summonses on the attorneys directing them to produce the documents, but the attorneys refused to comply. The Government then brought enforcement actions, and in each case the District Court ordered the summons enforced. In No. 74-18 the Court of Appeals affirmed, holding that the taxpayers had never acquired a possessory interest in the documents and that the documents were not immune from production in the attorney's hands. But in No. 74-611 the Court of Appeals reversed, holding that by virtue of the *Fifth Amendment* the documents would have been privileged from production pursuant to a summons directed to the taxpayer if he had retained possession, and that, in light of the attorney-client relationship, the taxpayer retained such privilege after transferring the documents to his attorney. Held:

1. Compelled production of the documents in question from the attorneys does not implicate whatever *Fifth Amendment* privilege the taxpayer-clients might have enjoyed from being themselves compelled to produce the documents. Pp. 396-401.

(a) Whether or not the *Fifth Amendment* would have barred a subpoena directing the taxpayers to produce the documents while they were in their hands, the taxpayers' privilege under that Amendment is not violated by enforcing the summonses because enforcement against a taxpayer's lawyer would not "compel" the taxpayer to do anything, and certainly would not compel him to be a "witness" against himself, and the fact that the attorneys are agents of the taxpayers does not change this result. *Couch v. United States*, 409 U.S. 322. Pp. 396-398.

(b) These cases do not present a situation where constructive possession of the documents in question is

so clear or relinquishment of possession so temporary and insignificant as to leave the personal compulsion upon the taxpayer substantially intact, since the documents sought were obtainable without personal compulsion upon the taxpayers. *Couch, supra*. P. 398.

(c) The taxpayers, by transferring the documents to their attorneys, did not lose any *Fifth Amendment* privilege they ever had not to be compelled to testify against themselves and not to be compelled themselves to produce private papers in their possession, and this personal privilege was in no way decreased by the transfer. Pp. 398-399.

(d) Even though the taxpayers, after transferring the documents to their attorneys, may have had a reasonable expectation of privacy with respect to the documents, the *Fifth Amendment* does not protect private information obtained without compelling self-incriminating testimony. Pp. 399-401.

2. Although the attorney-client privilege applies to documents in the hands of an attorney which would have been privileged in the hands of the client by reason of the *Fifth Amendment*, the taxpayer-clients in these cases would not be protected by that Amendment from producing the documents in question, because production of such documents involves no incriminating testimony and therefore the documents in the hands of the taxpayers' attorneys were not immune from production. Pp. 402-414.

(a) The *Fifth Amendment* does not independently proscribe the compelled production of every sort of incriminating evidence but applies only when the accused is compelled to make a testimonial communication that is incriminating. P. 408.

(b) Here, however incriminating the contents of the accountants' workpapers might be, the act of producing them - the only thing that the taxpayers are compelled to do - would not itself involve testimonial self-incrimination, and implicitly admitting the existence and possession of the papers does not rise to the level of testimony within the protection of the *Fifth Amendment*. Pp. 409-414.

No. 74-18, 500 F. 2d 683, affirmed; *No. 74-611*, 499 F. 2d 444, reversed. S

WHITE, J., delivered the opinion of the Court, in which BURGER, C.J., and STEWART, BLACKMUN, POWELL, and REHNQUIST, JJ., joined. BRENNAN, J., post, p. 414, and MARSHALL, J., post, p. 430, filed opinions concurring in the judgment. STEVENS, J., took no part in the consideration or decision of the cases.

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COUNSEL: Richard L. Bazelon argued the cause for petitioners in No. 74-18. With him on the brief was Solomon Fisher. Deputy Solicitor General Wallace argued the cause for petitioners in No. 74-611 and respondents in No. 74-18. With him on the briefs were Solicitor General Bork, Assistant Attorney General Crampton, Stuart A. Smith and Robert E. Lindsay. Robert E. Goodfriend argued the cause for respondents in No. 74-611. With him on the brief were Edward A. Copley and Cyril D. Kasmir. ⁺

⁺ Stanley H. Stearman filed a brief for the National Society of Public Accountants as amicus curiae urging affirmance in No. 74-611. Richard H. Appert, Louis Bender, Michael I. Saltzman, and James D. Fellers filed a brief for the American Bar Association as amicus curiae in both cases.

JUDGES: BURGER, BRENNAN, STEWART, MARSHALL, BLACKMUN, POWELL, REHNQUIST; STEVENS took no part in the consideration or decision of the case.

OPINION BY: WHITE

OPINION

[*393] [***45] [**1572] MR. JUSTICE WHITE delivered the opinion of the Court.

In these two cases we are called upon to decide whether a summons directing an attorney to produce documents delivered to him by his client in connection with the attorney-client relationship is enforceable over claims that the documents were constitutionally immune from summons in the hands of the client and retained that immunity in the hands of the attorney.

[***46] I

In each case, an Internal Revenue agent visited the taxpayer or taxpayers ¹ and interviewed them in connection [*394] with an investigation of possible civil or criminal liability under the federal income tax laws. Shortly after the interviews - one day later in No. 74-611 and a week or two later in No. 74-18 - the taxpayers obtained from their respective accountants certain documents relating to the preparation by the accountants of their tax returns. Shortly after obtaining the documents - later the same day in No. 74-611 and a few weeks later in No. 74-18 - the taxpayers transferred the documents to their lawyers - respondent Kasmir and petitioner Fisher, respectively - each of whom was retained to assist the taxpayer in connection with the investigation. Upon

learning of the whereabouts of the documents, the Internal Revenue Service served summonses on the attorneys directing them to produce documents listed therein. In No. 74-611, the documents were described as "the following records of Tannebaum Bindler & Lewis [the accounting firm]. S

" [**1573] 1. Accountant's work papers pertaining to Dr. E. J. Mason's books and records of 1969, 1970 and 1971. [?]

"2. Retained copies of E. J. Mason's income tax returns for 1969, 1970 and 1971.

"3. Retained copies of reports and other correspondence between Tannebaum Bindler & Lewis and Dr. E. J. Mason during 1969, 1970 and 1971."I

In No. 74-18, the documents demanded were analyses by the accountant of the taxpayers' income and expenses which had been copied by the accountant from the taxpayers' canceled checks and deposit receipts. ³ In No. [*395] 74-611, a summons was also served on the accountant directing him to appear and testify concerning the documents to be produced by the lawyer. In each case, the lawyer declined to comply with the summons directing production of the documents, and enforcement actions were commenced by the Government under 26 U.S.C. §§ 7402 (b) and 7604 (a). In No. 74-611, the attorney raised in defense of the enforcement action the taxpayer's accountant-client privilege, his attorney-client privilege, and his *Fourth* and *Fifth Amendment* rights. In No. 74-18, the attorney claimed that enforcement would involve compulsory self-incrimination of the taxpayers in violation of their *Fifth Amendment* privilege, would involve a seizure of the papers without necessary compliance with the *Fourth Amendment*, and would violate the taxpayers' right to communicate in confidence with their attorney. In No. 74-18 the taxpayers intervened and made similar claims.

1 In No. 74-18, the taxpayers are husband and wife who filed a joint return. In No. 74-611, the taxpayer filed an individual return.

2 The "books and records" concerned the taxpayer's large medical practice.

3 The husband taxpayer's checks and deposit receipts related to his textile waste business. The wife's related to her women's wear shop.

In each case the summons was ordered enforced by the District Court and its order was stayed pending appeal. In *No. 74-18*, 500 F. 2d 683 (CA3 1974), petitioners' appeal raised, in [***47] terms, only their *Fifth*

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Amendment claim, but they argued in connection with that claim that enforcement of the summons would involve a violation of the taxpayers' reasonable expectation of privacy and particularly so in light of the confidential relationship of attorney to client. The Court of Appeals for the Third Circuit after reargument en banc affirmed the enforcement order, holding that the taxpayers had never acquired a possessory interest in the documents and that the papers were not immune in the hands of the attorney. In No. 74-611, a divided panel of the Court of Appeals for the Fifth Circuit reversed the enforcement order, 499 F. 2d 444 (1974). The court reasoned that by virtue of the *Fifth Amendment* the documents would have been privileged [*396] from production pursuant to summons directed to the taxpayer had he retained possession and, in light of the confidential nature of the attorney-client relationship, the taxpayer retained, after the transfer to his attorney, "a legitimate expectation of privacy with regard to the materials he placed in his attorney's custody, that he retained constructive possession of the evidence, and thus... retained *Fifth Amendment* protection." ⁴ *Id.*, at 453. We granted certiorari to resolve the conflict created. 420 U.S. 906 (1975). Because in our view the documents were not privileged either in the hands of the lawyers or of their clients, we affirm the judgment of the Third Circuit in No. 74-18 and reverse the judgment of the Fifth Circuit in No. 74-611.

4 The respondents in No. 74-611 did not, in terms, rely on the attorney-client privilege or the *Fourth Amendment* before the Court of Appeals.

II

All of the parties in these cases and the Court of Appeals for the Fifth Circuit have concurred in the proposition that if the *Fifth Amendment* would have excused a taxpayer from turning over the accountant's papers had he possessed them, [**1574] the attorney to whom they are delivered for the purpose of obtaining legal advice should also be immune from subpoena. Although we agree with this proposition for the reasons set forth in Part III, *infra*, we are convinced that, under our decision in *Couch v. United States*, 409 U.S. 322 (1973), it is not the taxpayer's *Fifth Amendment* privilege that would excuse the attorney from production.

[***LEdHR1A] [1A]The relevant part of that Amendment provides: S

"No person... shall be compelled in any criminal case to be a witness against himself." (Emphasis added.)I

[*397] The taxpayer's privilege under this Amendment is not violated by enforcement of the summonses involved in these cases because enforcement against a taxpayer's lawyer would not "compel" the tax-

payer to do anything - and certainly would not compel him to be a "witness" against himself. The Court has held repeatedly that the *Fifth Amendment* is limited to prohibiting the use of "physical or moral compulsion" exerted on the person asserting the privilege, *Perlman v. United States*, 247 U.S. 7, 15 (1918); *Johnson v. United States*, 228 U.S. 457, 458 (1913); *Couch v.* [***48] *United States*, *supra*, at 328, 336. See also *Holt v. United States*, 218 U.S. 245, 252-253 (1910); *United States v. Dionisio*, 410 U.S. 1 (1973); *Schmerber v. California*, 384 U.S. 757, 765 (1966); *Burdeau v. McDowell*, 256 U.S. 465, 476 (1921); *California Bankers Assn. v. Shultz*, 416 U.S. 21, 55 (1974). In *Couch v. United States*, *supra*, we recently ruled that the *Fifth Amendment* rights of a taxpayer were not violated by the enforcement of a documentary summons directed to her accountant and requiring production of the taxpayer's own records in the possession of the accountant. We did so on the ground that in such a case "the ingredient of personal compulsion against an accused is lacking." 409 U.S., at 329.

Here, the taxpayers are compelled to do no more than was the taxpayer in *Couch*. The taxpayers' *Fifth Amendment* privilege is therefore not violated by enforcement of the summonses directed toward their attorneys. This is true whether or not the Amendment would have barred a subpoena directing the taxpayer to produce the documents while they were in his hands.

The fact that the attorneys are agents of the taxpayers does not change this result. *Couch* held as much, since the accountant there was also the taxpayer's agent, and in this respect reflected a long standing view. In [*398] *Hale v. Henkel*, 201 U.S. 43, 69-70 (1906), the Court said that the privilege "was never intended to permit [a person] to plead the fact that some third person might be incriminated by his testimony, even though he were the agent of such person.... [T]he Amendment is limited to a person who shall be compelled in any criminal case to be a witness against himself." (Emphasis in original.) 0">"It is extortion of information from the accused himself that offends our sense of justice." *Couch v. United States*, *supra*, at 328. Agent or no, the lawyer is not the taxpayer. The taxpayer is the "accused," and nothing is being extorted from him.

[***LEdHR1B] [1B]Nor is this one of those situations, which *Couch* suggested might exist, where constructive possession is so clear or relinquishment of possession so temporary and insignificant as to leave the personal compulsion upon the taxpayer substantially intact. 409 U.S., at 333. In this respect we see no difference between the delivery to the attorneys in these cases and delivery to the accountant in the *Couch* case. As was true in *Couch*, the documents sought were obtainable without personal compulsion on the accused.

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[**1575] [***LEdHR2] [2] Respondents in No. 74-611 and petitioners in No. 74-18 argue, and the Court of Appeals for the Fifth Circuit apparently agreed, that if the summons was enforced, the taxpayers' *Fifth Amendment* privilege would be, but should not be, lost solely because they gave their documents to their lawyers in order to obtain legal advice. But this misconceives the nature of the constitutional privilege. The Amendment protects a person from being compelled to be a witness against himself. Here, the taxpayers retained any privilege they ever had not to be compelled to [***49] testify against themselves and not to be compelled themselves to produce private papers in their possession. This personal privilege was in no way decreased by the transfer. It is simply that by [*399] reason of the transfer of the documents to the attorneys, those papers may be subpoenaed without compulsion on the taxpayer. The protection of the *Fifth Amendment* is therefore not available. "A party is privileged from producing evidence but not from its production." *Johnson v. United States*, *supra*, at 458.

[***LEdHR1C] [1C] [***LEdHR3] [3] The Court of Appeals for the Fifth Circuit suggested that because legally and ethically the attorney was required to respect the confidences of his client, the latter had a reasonable expectation of privacy for the records in the hands of the attorney and therefore did not forfeit his *Fifth Amendment* privilege with respect to the records by transferring them in order to obtain legal advice. It is true that the Court has often stated that one of the several purposes served by the constitutional privilege against compelled testimonial self-incrimination is that of protecting personal privacy. See, e.g., *Murphy v. Waterfront Comm'n*, 378 U.S. 52, 55 (1964); *Couch v. United States*, *supra*, at 332, 335-336; *Tehan v. United States ex rel. Shott*, 382 U.S. 406, 416 (1966); *Davis v. United States*, 328 U.S. 582, 587 (1946). But the Court has never suggested that every invasion of privacy violates the privilege. Within the limits imposed by the language of the *Fifth Amendment*, which we necessarily observe, the privilege truly serves privacy interests; but the Court has never on any ground, personal privacy included, applied the *Fifth Amendment* to prevent the otherwise proper acquisition or use of evidence which, in the Court's view, did not involve compelled testimonial self-incrimination of some sort.⁵

⁵ There is a line of cases in which the Court stated that the *Fifth Amendment* was offended by the use in evidence of documents or property seized in violation of the *Fourth Amendment*. *Gouled v. United States*, 255 U.S. 298, 306 (1921); *Agnello v. United States*, 269 U.S. 20, 33-34 (1925); *United States v. Lefkowitz*, 285

U.S. 452, 466-467 (1932); *Mapp v. Ohio*, 367 U.S. 643, 661 (1961) (Black, J., concurring). But the Court purported to find elements of compulsion in such situations. "In either case he is the unwilling source of the evidence, and the *Fifth Amendment* forbids that he shall be compelled to be a witness against himself in a criminal case." *Gouled v. United States*, *supra*, at 306. In any event the predicate for those cases, lacking here, was a violation of the *Fourth Amendment*. Cf. *Burdeau v. McDowell*, 256 U.S., 465, 475-476 (1921).

[*400] [***LEdHR4] [4] [***LEdHR5] [5] The proposition that the *Fifth Amendment* protects private information obtained without compelling self-incriminating testimony is contrary to the clear statements of this Court that under appropriate safeguards private incriminating statements of an accused may be overheard and used in evidence, if they are not compelled at the time they were uttered, *Katz v. United States*, 389 U.S. 347, 354 (1967); *OsBorn v. United States*, 385 U.S. 323, 329-330 (1966); and *Berger v. New York*, 388 U.S. 41, 57 [***50] (1967); cf. *Hoffa v. United States*, 385 U.S. 293, 304 [**1576] (1966); and that disclosure of private information may be compelled if immunity removes the risk of incrimination. *Kastigar v. United States*, 406 U.S. 441 (1972). If the *Fifth Amendment* protected generally against the obtaining of private information from a man's mouth or pen or house, its protections would presumably not be lifted by probable cause and a warrant or by immunity. The privacy invasion is not mitigated by immunity; and the *Fifth Amendment's* strictures, unlike the *Fourth's*, are not removed by showing reasonableness. The Framers addressed the subject of personal privacy directly in the *Fourth Amendment*. They struck a balance so that when the State's reason to believe incriminating evidence will be found becomes sufficiently great, the invasion of privacy becomes justified and a warrant to search and seize will issue. They did not seek in still another Amendment - the Fifth - to achieve a general protection of privacy but to deal with the more specific issue of compelled self-incrimination.

[*401] [***LEdHR6] [6] We cannot cut the Fifth Amendment completely loose from the moorings of its language, and make it serve as a general protector of privacy - a word not mentioned in its text and a concept directly addressed in the *Fourth Amendment*. We adhere to the view that the *Fifth Amendment* protects against "compelled self-incrimination, not [the disclosure of] private information." *United States v. Nobles*, 422 U.S. 225, 233 n. 7 (1975).

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[**LEdHR7] [7] [**LEdHR8A] [8A]Insofar as private information not obtained through compelled self-incriminating testimony is legally protected, its protection stems from other sources⁶ - the *Fourth Amendment's* protection against seizures without warrant or probable cause and against subpoenas which suffer from "too much indefiniteness or breadth in the things required to be 'particularly described,'" *Oklahoma Press Pub. Co. v. Walling*, 327 U.S. 186, 208 (1946);d">In re Horowitz, 482 F.2d 72, 75-80 (CA2 1973) (Friendly, J.); the *First Amendment*, see *NAACP v. Alabama*, 357 U.S. 449, 462 (1958); or evidentiary privileges such as the attorney-client privilege.⁷

6 In *Couch v. United States*, 409 U.S. 322 (1973), on which taxpayers rely for their claim that the *Fifth Amendment* protects their "legitimate expectation of privacy," the Court differentiated between the things protected by the *Fourth* and *Fifth Amendments*. "We hold today that no *Fourth* or *Fifth Amendment* claim can prevail where, as in this case, there exists no legitimate expectation of privacy and no semblance of governmental compulsion against the person of the accused." *Id.*, at 336.

[**LEdHR8B] [8B]

7 The taxpayers and their attorneys have not raised arguments of a *Fourth Amendment* nature before this Court and could not be successful if they had. The summonses are narrowly drawn and seek only documents of unquestionable relevance to the tax investigation. Special problems of privacy which might be presented by subpoena of a personal diary, *United States v. Bennett*, 409 F. 2d 888, 897 (CA2 1969) (Friendly, J.), are not involved here.

First Amendment values are also plainly not implicated in these cases.

[*402] III

[**LEdHR9A] [9A] [**LEdHR10A] [10A]Our above holding is that compelled production of documents [**51] from an attorney does not implicate whatever *Fifth Amendment* privilege the taxpayer might have enjoyed from being compelled to produce them himself. The taxpayers in these cases, however, have from the outset consistently urged that they should not be forced to expose otherwise protected documents to summons simply because they have sought legal advice and turned the papers over to their attorneys. The Government appears to agree unqualifiedly. The difficulty is that the taxpayers have erroneously relied on the *Fifth Amendment* without urging the attorney-client priv-

ilege in so many words. They have nevertheless invoked the relevant body of law and policies that govern the attorney-client privilege. [**1577] In this posture of the case, we feel obliged to inquire whether the attorney-client privilege applies to documents in the hands of an attorney which would have been privileged in the hands of the client by reason of the *Fifth Amendment*.⁸

8 *Federal Rule Evid. 501*, effective January 2, 1975, provides that with respect to privileges the United States district courts "shall be governed by the principles of the common law... interpreted... in the light of reason and experience." Thus, whether or not *Rule 501* applies to this case, the attorney-client privilege issue is governed by the principles and authorities discussed and cited *infra*. *Fed. Rule Crim. Proc. 26*.

[**LEdHR10B] [10B]In No. 74-611, the taxpayer did not intervene, and his rights have been asserted only through his lawyer. The parties disagree on the question whether an attorney may claim the *Fifth Amendment* privilege of his client. We need not resolve this question. The only privilege of the taxpayer involved here is the attorney-client privilege, and it is universally accepted that the attorney-client privilege may be raised by the attorney, C. McCormick, Evidence § 92, p. 193, § 94, p. 197 (2d ed. 1972) (hereinafter McCormick); *Republic Gear Co. v. Borg-Warner Corp.*, 381 F. 2d 551 (CA2 1967); *Bouschor v. United States*, 316 F. 2d 451 (CA8 1963); *Colton v. United States*, 306 F. 2d 633 (CA2 1962); *Schwimmer v. United States*, 232 F. 2d 855 (CA8), cert. denied, 352 U.S. 833 (1956); *Baldwin v. Commissioner*, 125 F. 2d 812 (CA9 1942).

[*403] [**LEdHR11] [11] [**LEdHR12] [12]Confidential disclosures by a client to an attorney made in order to obtain legal assistance are privileged. 8 J. Wigmore, Evidence § 2292 (McNaughton rev. 1961) (hereinafter Wigmore); McCormick, § 87, p. 175, (hereinafter McCormick). The purpose of the privilege is to encourage clients to make full disclosure to their attorneys. 8 Wigmore § 2291, and § 2306, p. 590; McCormick § 87, p. 175, § 92, p. 192; *Baird v. Koerner*, 279 F. 2d 623 (CA9 1960);d">*Modern Woodmen of America v. Watkins*, 132 F. 2d 352 (CA5 1942);d">*Prichard v. United States*, 181 F. 2d 326 (CA6), affd per curiam, 339 U.S. 974 (1950); *Schwimmer v. United States*, 232 F. 2d 855 (CA8 1956); *United States v. Goldfarb*, 328 F. 2d 280 (CA6 1964). As a practical matter, if the client knows that damaging information could more readily be

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obtained from the attorney following disclosure than from himself in the absence of disclosure, the client would be reluctant to confide in his lawyer and it would be difficult to obtain fully informed legal advice. However, since the privilege has the effect of withholding relevant information from the factfinder, it applies only where necessary to achieve its purpose. Accordingly it protects only those disclosures - necessary to obtain informed legal advice - which might not have been made absent the privilege. *In re Horowitz*, *supra*, at 81 (Friendly, J.); *United States v. Goldfarb*, *supra*; 8 Wigmore § 2291, p. 554; McCormick § 89, p. 185. This Court and the lower courts have [***52] thus uniformly held that pre-existing documents which could have been obtained by court process from the client when he was in possession may also be obtained from the attorney by similar process following transfer by client in order [*404] to obtain more informed legal advice. *Grant v. United States*, 227 U.S. 74, 79-80 (1913); 8 Wigmore § 2307, and cases there cited; McCormick § 90, p. 185; *Falsone v. United States*, 205 F. 2d 734 (CA5 1953); *Sovereign Camp, W. O. W. v. Reed*, 208 Ala. 457, 94 So. 910 (1922); *Andrews v. Mississippi R. Co.*, 14 Ind. 169, 98 N.E. 49 (1860); *Palatini v. Sarian*, 15 N.J. Super. 34, 83 A. 2d 24 (1951); *Pearson v. Yoder*, 39 Okla. 105, 134 P. 421 (1913); *State ex rel Sowers v. Olwell*, 64 Wash. 2d 828, 394 P. 2d 681 (1964). The purpose of the privilege requires no broader rule. Pre-existing documents obtainable from the client are not appreciably easier to obtain from the attorney after transfer to him. Thus, even absent the attorney-client privilege, clients will not be discouraged from disclosing the documents to the attorney, and their ability to obtain informed legal advice will remain unfettered. It is otherwise if the documents are not obtainable by subpoena duces tecum or summons while in the exclusive possession of the client, for the client will then be reluctant to transfer possession to the lawyer unless the documents are also privileged [**1578] in the latter's hands. Where the transfer is made for the purpose of obtaining legal advice, the purposes of the attorney-client privilege would be defeated unless the privilege is applicable. "It follows, then, that when the client himself would be privileged from production of the document, either as a party at common law... or as exempt from self-incrimination, the attorney having possession of the document is not bound to produce." 8 Wigmore § 2307, p. 592. Lower courts have so held. *Id.*, § 2307, p. 592 n. 1, and cases there cited; *United States v. Judson*, 322 F. 2d 460, 466 (CA9 1963); *Colton v. United States*, 306 F. 2d 633, 639 (CA2 1962). This proposition was accepted by the Court of Appeals for the Fifth Circuit below, is asserted by petitioners [*405] in No. 74-18 and respondents in No. 74-611, and was conceded by the Government in its brief and at oral argument. Where

the transfer to the attorney is for the purpose of obtaining legal advice, we agree with it.

[***LEdHR9B] [9B] Since each taxpayer transferred possession of the documents in question from himself to his attorney, in order to obtain legal assistance in the tax investigations in question, the papers, if unobtainable by summons from the client, are unobtainable by summons directed to the attorney by reason of the attorney-client privilege. We accordingly proceed to the question whether the documents could have been obtained by summons addressed to the taxpayer while the documents were in his possession. The only bar to enforcement of such summons asserted by the parties or the courts below is the *Fifth Amendment's* privilege against self-incrimination. On this question the Court of Appeals for the Fifth Circuit in No. 74-611 is at odds with the Court of Appeals for the Second Circuit in *United States v. Beattie*, 522 F. 2d 267 (1975), cert. pending, Nos. 75-407, 75-700.

IV

The proposition that the *Fifth Amendment* prevents compelled production [***53] of documents over objection that such production might incriminate stems from *Boyd v. United States*, 116 U.S. 616 (1886). *Boyd* involved a civil forfeiture proceeding brought by the Government against two partners for fraudulently attempting to import 35 cases of glass without paying the prescribed duty. The partnership had contracted with the Government to furnish the glass needed in the construction of a Government building. The glass specified was foreign glass, it being understood that if part or all of the glass was furnished from the partnership's existing duty-paid inventory, [*406] it could be replaced by duty-free imports. Pursuant to this arrangement, 29 cases of glass were imported by the partnership duty free. The partners then represented that they were entitled to duty-free entry of an additional 35 cases which were soon to arrive. The forfeiture action concerned these 35 cases. The Government's position was that the partnership had replaced all of the glass used in construction of the Government building when it imported the 29 cases. At trial, the Government obtained a court order directing the partners to produce an invoice the partnership had received from the shipper covering the previous 29-case shipment. The invoice was disclosed, offered in evidence, and used, over the *Fifth Amendment* objection of the partners, to establish that the partners were fraudulently claiming a greater exemption from duty than they were entitled to under the contract. This Court held that the invoice was inadmissible and reversed the judgment in favor of the Government. The Court ruled that the *Fourth Amendment* applied to court orders in the nature of subpoenas duces tecum in the same manner in which it applies to search warrants, *id.*,

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at 622; and that the Government may not, consistent with the *Fourth Amendment*, seize a person's documents or other property as evidence unless it can claim a proprietary interest in the property superior to that of the person from whom the property is obtained. *Id.*, at 623-624. The invoice in question was thus held to [**1579] have been obtained in violation of the *Fourth Amendment*. The Court went on to hold that the accused in a criminal case or the defendant in a forfeiture action could not be forced to produce evidentiary items without violating the *Fifth Amendment* as well as the *Fourth*. More specifically, the Court declared, "a compulsory production of the private books and papers of the owner of goods sought to be forfeited... is compelling him to be a witness against himself, [*407] within the meaning of the *Fifth Amendment to the Constitution*." *Id.*, at 634-635. Admitting the partnership invoice into evidence had violated both the *Fifth* and *Fourth Amendments*.

Among its several pronouncements, Boyd was understood to declare that the seizure, under warrant or otherwise, of any purely evidentiary materials violated the *Fourth Amendment* and that the *Fifth Amendment* rendered these seized materials inadmissible. *Gouled v. United States*, 255 U.S. 298 (1921); *Agnello v. United States*, 269 U.S. 20 (1925); *United States v. Lefkowitz*, 285 U.S. 452 (1932). That rule applied to documents as well as to other evidentiary items - "[t]here is [***54] no special sanctity in papers, as distinguished from other forms of property, to render them immune from search and seizure, if only they fall within the scope of the principles of the cases in which other property may be seized..." *Gouled v. United States*, *supra*, at 309. Private papers taken from the taxpayer, like other "mere evidence," could not be used against the accused over his *Fourth* and *Fifth Amendment* objections.

[***LEdHR13] [13]Several of Boyd's express or implicit declarations have not stood the test of time. The application of the *Fourth Amendment* to subpoenas was limited by *Hale v. Henkel*, 201 U.S. 43 (1906), and more recent cases. See, e.g., *Oklahoma Press Pub. Co. v. Walling*, 327 U.S. 186 (1946). Purely evidentiary (but "nontestimonial") materials, as well as contraband and fruits and instrumentalities of crime, may now be searched for and seized under proper circumstances, *Warden v. Hayden*, 387 U.S. 294 (1967).⁹ Also, any notion that "testimonial" evidence may never be seized and used in evidence is [*408] inconsistent with *Katz v. United States*, 389 U.S. 347 (1967); *Osborn v. United States*, 385 U.S. 323 (1966); and *Berger v. New York*, 388 U.S. 41 (1967),"/> approving the seizure under appropriate circumstances of conversations of a person suspected of crime. See also *Marron v. United States*, 275 U.S. 192 (1927).

9 Citing to *Schmerber v. California*, 384 U.S. 757 (1966), *Warden v. Hayden*, 387 U.S., at 302-303, reserved the question "whether there are items of evidential value whose very nature precludes them from being the object of a reasonable search and seizure."

[***LEdHR14] [14] [***LEdHR15] [15]It is also clear that the *Fifth Amendment* does not independently proscribe the compelled production of every sort of incriminating evidence but applies only when the accused is compelled to make a testimonial communication that is incriminating. We have, accordingly, declined to extend the protection of the privilege to the giving of blood samples, *Schmerber v. California*, 384 U.S. 757, 763-764 (1966);¹⁰ to the giving of handwriting exemplars, *Gilbert v. California*, 388 U.S. 263, 265-267 (1967); voice exemplars, *United States v. Wade*, 388 U.S. 218, 222-223, [**1580] (1967); or the donning of a blouse worn by the perpetrator, *Holt v. United States*, 218 U.S. 245 (1910). Furthermore, despite Boyd, neither a partnership nor the individual partners are shielded from compelled production of partnership records on self-incrimination grounds. *Bellis v. United States*, 417 U.S. 85 (1974). It would appear that under that case the precise claim sustained in Boyd would now be rejected for reasons not there considered.

10 The Court's holding was: "Since the blood test evidence, although an incriminating product of compulsion, was neither petitioner's testimony nor evidence relating to some communicative act or writing by petitioner, it was not inadmissible on privilege grounds." 384 U.S., at 765.

The pronouncement in Boyd that a person may not be forced to produce his private papers has nonetheless often appeared as dictum in later opinions of this Court. See, e.g., *Wilson v. United States*, 221 U.S. 361, 377 (1911); [***55] d">*Wheeler v. United States*, 226 U.S. 478, 489 (1913); *United States v. White*, 322 U.S. 694, 698-699 (1944); [*409] *Davis v. United States*, 328 U.S., at 587-588; *Schmerber*, *supra*, at 763-764; *Couch v. United States*, 409 U.S., at 330; *Bellis v. United States*, *supra*, at 87. To the extent, however, that the rule against compelling production of private papers rested on the proposition that seizures of or subpoenas for "mere evidence," including documents, violated the *Fourth Amendment* and therefore also transgressed the *Fifth*, *Gouled v. United States*, *supra*, the foundations for the rule have been washed away. In consequence, the prohibition against forcing the production of private papers has long been a rule searching for a rationale consistent with the proscriptions of the *Fifth Amendment* against compelling a person to give "testimony" that incrimi-

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nates him. Accordingly, we turn to the question of what, if any, incriminating testimony within the *Fifth Amendment's* protection, is compelled by a documentary summons.

[**LEdHR16] [16] [**LEdHR17A] [17A]A subpoena served on a taxpayer requiring him to produce an accountant's workpapers in his possession without doubt involves substantial compulsion. But it does not compel oral testimony; nor would it ordinarily compel the taxpayer to restate, repeat, or affirm the truth of the contents of the documents sought. Therefore, the *Fifth Amendment* would not be violated by the fact alone that the papers on their face might incriminate the taxpayer, for the privilege protects a person only against being incriminated by his own compelled testimonial communications. *Schmerber v. California*, *supra*; *United States v. Wade*, *supra*; and *Gilbert v. California*, *supra*. The accountant's workpapers are not the taxpayer's. They were not prepared by the taxpayer, and they contain no testimonial declarations by him. Furthermore, as far as this record demonstrates, the preparation of all of the papers sought in these cases was wholly voluntary, and they cannot be said to contain compelled [*410] testimonial evidence, either of the taxpayers or of anyone else. ¹¹ The taxpayer cannot avoid compliance with the subpoena merely by asserting [*1581] that the item of evidence which he is required to produce contains incriminating writing, whether his own or that of someone else.

[**LEdHR17B] [17B]

11 The fact that the documents may have been written by the person asserting the privilege is insufficient to trigger the privilege, *Wilson v. United States*, 221 U.S. 361, 378 (1911). And, unless the Government has compelled the subpoenaed person to write the document, cf. *Marchetti v. United States*, 390 U.S. 39 (1968); *Grosso v. United States*, 390 U.S. 62 (1968), the fact that it was written by him is not controlling with respect to the *Fifth Amendment* issue. Conversations may be seized and introduced in evidence under proper safeguards, *Katz v. United States*, 389 U.S. 347 (1967); *Osborn v. United States*, 385 U.S. 323 (1966); *Berger v. New York*, 388 U.S. 41 (1967); *United States v. Bennett*, 409 F. 2d, at 897 n. 9, if not compelled. In the case of a documentary subpoena the only thing compelled is the act of producing the document and the compelled act is the same as the one performed when a chattel or document not authored by the producer is demanded. McCormick § 128, p. 269.

The [***56] act of producing evidence in response to a subpoena nevertheless has communicative aspects of its own, wholly aside from the contents of the papers produced. Compliance with the subpoena tacitly concedes the existence of the papers demanded and their possession or control by the taxpayer. It also would indicate the taxpayer's belief that the papers are those described in the subpoena. *Curcio v. United States*, 354 U.S. 118, 125 (1957). The elements of compulsion are clearly present, but the more difficult issues are whether the tacit averments of the taxpayer are both "testimonial" and "incriminating" for purposes of applying the *Fifth Amendment*. These questions perhaps do not lend themselves to categorical answers; their resolution may instead depend on the facts and circumstances of particular cases or classes thereof. In light of the records now before us, we are confident that however incriminating the [*411] contents of the accountant's workpapers might be, the act of producing them - the only thing which the taxpayer is compelled to do - would not itself involve testimonial self-incrimination.

It is doubtful that implicitly admitting the existence and possession of the papers rises to the level of testimony within the protection of the *Fifth Amendment*. The papers belong to the accountant, were prepared by him, and are the kind usually prepared by an accountant working on the tax returns of his client. Surely the Government is in no way relying on the "truth-telling" of the taxpayer to prove the existence of or his access to the documents. ⁸ Wigmore § 2264, p. 380. The existence and location of the papers are a foregone conclusion and the taxpayer adds little or nothing to the sum total of the Government's information by conceding that he in fact has the papers. Under these circumstances by enforcement of the summons "no constitutional rights are touched. The question is not of testimony but of surrender." *In re Harris*, 221 U.S. 274, 279 (1911).

[**LEdHR18] [18]When an accused is required to submit a handwriting exemplar he admits his ability to write and impliedly asserts that the exemplar is his writing. But in common experience, the first would be a near truism and the latter self-evident. In any event, although the exemplar may be incriminating to the accused and although he is compelled to furnish it, his *Fifth Amendment* privilege is not violated because nothing he has said or done is deemed to be sufficiently testimonial for purposes of the privilege. This Court has also time and again allowed subpoenas against the custodian of corporate documents or those belonging to other collective entities such as unions and partnerships and those of bankrupt businesses over claims that the documents will incriminate the custodian despite the fact that producing the documents tacitly admits their existence and their location in the [*412] hands of their possessor. E.g.,

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Wilson v. United States, 221 U.S. 361 (1911); *Dreier v. United States*, 221 U.S. 394 (1911); *United States v. White*, 322 U.S. 694 (1944); *Bellis v. United States*, 417 U.S. 85 (1974); *In re Harris*, *supra*. [***57] The existence and possession or control of the subpoenaed documents being no more in issue here than in the above cases, the summons is equally enforceable.

Moreover, assuming that these aspects of producing the accountant's papers have some minimal testimonial significance, surely it is not illegal to seek accounting help in connection with one's tax returns or for the accountant to prepare workpapers and deliver them to the taxpayer. At this juncture, we are quite unprepared to hold that either the fact of existence of the papers or of their possession by the taxpayer poses any realistic threat of incrimination to the taxpayer.

[**1582] [***LEdHR19A] [19A]As for the possibility that responding to the subpoena would authenticate¹² the workpapers, production would [*413] express nothing more than the taxpayer's belief that the papers are those described in the subpoena. The taxpayer would be no more competent to authenticate the accountant's workpapers or reports¹³ by producing them than he would be to authenticate them if testifying orally. The taxpayer did not prepare the papers and could not vouch for their accuracy. The documents would not be admissible in evidence against the taxpayer without authenticating testimony. Without more, responding to the subpoena in the circumstances before us would not appear to represent a substantial threat of self-incrimination. Moreover, in *Wilson v. United States*, *supra*; *Dreier v. United States*, *supra*; *United States v. White*, *supra*; *Bellis v. United States*, *supra*; and *In re Harris*, *supra*, the custodian of corporate, union or partnership books or those of a bankrupt business was ordered to respond to a subpoena for the business' books even though doing so involved a "representation that the documents produced are those demanded by the subpoena," *Curcio v. United States*, [***58] 354 U.S., at 125.¹⁴

12 The "implicit authentication" rationale appears to be the prevailing justification for the *Fifth Amendment's* application to documentary subpoenas. d">*Schmerber v. California*, 384 U.S., at 763-764 ("the privilege reaches... the compulsion of responses which are also communications, for example, compliance with a subpoena to produce one's papers. *Boyd v. United States*, 116 U.S. 616"); *Couch v. United States*, 409 U.S., at 344, 346 (MARSHALL, J., dissenting) (the person complying with the subpoena "implicitly testifies that the evidence he brings forth is in fact the evidence demanded."); *United*

States v. Beattie, 522 F. 2d 267, 270 (CA2 1975) (Friendly, J.) ("[a] subpoena demanding that an accused produce his own records is... the equivalent of requiring him to take the stand and admit their genuineness"), cert. pending, Nos. 75-407, 75-700; 8 Wigmore § 2264, p. 380 (the testimonial component involved in compliance with an order for production of documents or chattels "is the witness' assurance, compelled as an incident of the process, that the articles produced are the ones demanded"); McCormick § 126, p. 268 ("[t]his rule [applying the *Fifth Amendment* privilege to documentary subpoenas] is defended on the theory that one who produces documents (or other matter) described in the subpoena duces tecum represents, by his production, that the documents produced are in fact the documents described in the subpoena"); *People v. Defore*, 242 N.Y. 13, 27, 150 N.E. 585, 590 (1926) (Cardozo, J.) ("A defendant is 'protected from producing his documents in response to a subpoena duces tecum, for his production of them in court would be his voucher of their genuineness.' There would then be 'testimonial compulsion'").

[***LEdHR19B] [19B]

13 In seeking the accountant's "retained copies" of correspondence with the taxpayer in No. 74-611, we assume that the summons sought only "copies" of original letters sent from the accountant to the taxpayer - the truth of the contents of which could be testified to only by the accountant.

14 In these cases compliance with the subpoena is required even though the books have been kept by the person subpoenaed and his producing them would itself be sufficient authentication to permit their introduction against him.

[*414] [***LEdHR9C] [9C]Whether the *Fifth Amendment* would shield the taxpayer from producing his own tax records in his possession is a question not involved here; for the papers demanded here are not his "private papers," see *Boyd v. United States*, 116 U.S., at 634-635. We do hold that compliance with a summons directing the taxpayer to produce the accountant's documents involved in these cases would involve no incriminating testimony within the protection of the *Fifth Amendment*.

The judgment of the Court of Appeals for the Fifth Circuit in No. 74-611 is reversed. The judgment of the

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Court of Appeals for the Third Circuit in No. 74-18 is affirmed.

So ordered.

MR. JUSTICE STEVENS took no part in the consideration or disposition of these cases.

CONCUR BY: BRENNAN; MARSHALL

CONCUR

[**1583] MR. JUSTICE BRENNAN, concurring in the judgment.

I concur in the judgment. Given the prior access by accountants retained by the taxpayers to the papers involved in these cases and the wholly business rather than personal nature of the papers, I agree that the privilege against compelled self-incrimination did not in either of these cases protect the papers from production in response to the summonses. See *Couch v. United States*, 409 U.S. 322, 335-336 (1973); *id.*, at 337 (BRENNAN, J., concurring). I do not join the Court's opinion, however, because of the portent of much of what is said of a serious crippling of the protection secured by the privilege against compelled production of one's private books and papers. Like today's decision in *United States v. Miller*, post, p. 435, it is but another step in the denigration of privacy principles settled nearly 100 years ago in *Boyd v. United States*, 116 U.S. 616 [*415] (1886). According to the Court, "[w]hether the *Fifth Amendment* would shield the taxpayer from producing his own tax records in his possession is a question not involved here; for the papers demanded here are not his 'private papers.'" Ante, at 414. This implication that the privilege might not protect against compelled production of tax records that are his "private papers" is so contrary to settled constitutional jurisprudence that this and other like implications throughout the opinion¹ prompt me to conjecture that once again the Court is laying the groundwork for future [***59] decisions that will tell us that the question here formally reserved was actually answered against the availability of the privilege. *Semble*, *Hudgens v. NLRB*, 424 U.S. 507 (1976). It is therefore appropriate to recall that history and this Court have construed the constitutional privilege to safeguard against governmental intrusions of personal privacy to compel either self-incriminating oral statements or the production of self-incriminating evidence recorded in one's private books and papers. Although as phrased in the *Fifth Amendment* - "nor shall [any person] be compelled in any criminal case to be a witness against himself" - the privilege makes no express reference, as does the *Fourth Amendment*, to "papers, and effects," private papers have long been held to have the protection of the privilege, designed as it is "to maintain inviolate large

areas of personal privacy." *Feldman v. United States*, 322 U.S. 487, 490 (1944).

1 For example, the Court's notation that "[s]pecial problems of privacy which might be presented by subpoena of a diary... are not involved here," ante, at 401 n. 7, is only made in the context of discussion of the *Fourth Amendment* and thus may readily imply that even a subpoena of a personal diary containing forthright confessions of crime may not be resisted on grounds of the privilege.

[*416] I

Expressions are legion in opinions of this Court that the protection of personal privacy is a central purpose of the privilege against compelled self-incrimination. "[I]t is the invasion of [a person's] indefeasible right of personal security, personal liberty and private property" "that constitutes the essence of the offence" that violates the privilege. *Boyd v. United States*, *supra*, at 630. The privilege reflects "our respect for the inviolability of the human personality and of the right of each individual 'to a private enclave where he may lead a private life.'" *Murphy v. Waterfront Comm'n*, 378 U.S. 52, 55 (1964). "It respects a private inner sanctum of individual feeling and thought and proscribes state intrusion to extract self-condemnation." *Couch v. United States*, *supra*, at 327. See also *Tehan v. United States ex rel. Shott*, 382 U.S. 406, 416 (1966); *Miranda v. Arizona*, 384 U.S. 436, 460, [**1584] (1966). "The *Fifth Amendment* in its *Self-Incrimination Clause* enables the citizen to create a zone of privacy which government may not force him to surrender to his detriment." *Griswold v. Connecticut*, 381 U.S. 479, 484 (1965). See also *Katz v. United States*, 389 U.S. 347, 350 n. 5 (1967).

The Court pays lip service to this bedrock premise of privacy in the statement that "[w]ithin the limits imposed by the language of the *Fifth Amendment*, which we necessarily observe, the privilege truly serves privacy interests," ante, at 399. But this only makes explicit what elsewhere highlights the opinion, namely, the view that protection of personal privacy is merely a by product and not, as our precedents and history teach, a factor controlling in part the determination of the scope of the privilege. This cart-before-the-horse approach is fundamentally at odds with the settled principle that the scope of the privilege is not constrained by the limits of the [*417] wording of the *Fifth Amendment* but has the reach necessary to protect the cherished value of privacy which it safeguards. See *Schmerber v. California*, 384 U.S. 757, 761-762, n. 6 [***60] (1966). The "Court has always construed provisions of the Constitution having regard to the principles upon which it was established. The direct operation or literal meaning of

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the words used do not measure the purpose or scope of its provisions...." *United States v. Lefkowitz*, 285 U.S. 452, 467 (1932). "It has been repeatedly decided that [the *Fifth Amendment*] should receive a liberal construction, so as to prevent stealthy encroachment upon or 'gradual depreciation' of the rights secured by [it], by imperceptible practice of courts or by well-intentioned but mistakenly over-zealous executive officers." *Gouled v. United States*, 255 U.S. 298, 304 (1921). See *Maness v. Meyers*, 419 U.S. 449, 461 (1975). History and principle, not the mechanical application of its wording, have been the life of the Amendment. ²

2 "The privilege against self-incrimination is a specific provision of which it is peculiarly true that 'a page of history is worth a volume of logic.'" *Ullmann v. United States*, 350 U.S. 422, 438 (1956) (Frankfurter, J.). "The previous history of the right, both in England and America, proves that it was not bound by rigid definition." L. Levy, *Origins of the Fifth Amendment* 428 (1968).

That the privilege does not protect against the production of private information where there is no compulsion, or where immunity is granted, or where there is no threat of incrimination in nowise supports the Court's argument demeaning the privilege's protection of privacy. The unavailability of the privilege in those cases only evidences that, as is the case with the *First* and *Fourth Amendments*, the protection of privacy afforded by the privilege is not absolute. The critical question then is the definition of the scope of privacy that is sheltered by the privilege.

[*418] History and principle teach that the privacy protected by the *Fifth Amendment* extends not just to the individual's immediate declarations, oral or written, but also to his testimonial materials in the form of books and papers. ³ "The right was originally a 'right of silence'... only in the sense that legal process could not force incriminating statements from the defendant's [**1585] own lips. Beginning in the early eighteenth century the English courts widened that right to include protection against the necessity of producing books and documents that might tend to incriminate the accused.. .. Lord Mansfield summed up the law by declaring that the defendant, in a criminal case, could not be compelled to produce any incriminating documentary evidence 'though he should hold it in his hands in Court.'" L. Levy, *Origins of the Fifth Amendment* 390 (1968). ⁴ [***61] Thus, in recognizing [*419] the privilege's protection of private books and papers, *Boyd v. United States*, 116 U.S., at 633, 634-635, was faithful to this historical conception of the privilege. Boyd was reaffirmed in this respect in *Ballmann v. Fagin*, 200 U.S. 186 (1906),

which held that an individual could not be compelled to produce a personal cashbook containing incriminating evidence. *Schmerber v. California*, 384 U.S., at 761, most recently expressly held "that the privilege protects an accused... from being compelled to testify against himself, or otherwise provide the State with evidence of a testimonial or communicative nature...." (Emphasis supplied.) Indeed, Boyd's holding has often been reiterated without question. E.g., *Bellis v. United States*, 417 U.S. 85, 87 (1974); *United States v. Calandra*, 414 U.S. 338, 346 (1974); *Couch v. United States*, 409 U.S. 322 (1973); *United States v. Wade*, 388 U.S. 218, 221 (1967); *Gilbert v. California*, 388 U.S. 263, 266 (1967); *Davis v. United States*, 328 U.S. 582, 587-588 (1946); *United States v. White*, 322 U.S. 694, 698-699 (1944); *Wheeler v. United States*, 226 U.S. 478, 489 (1913); *Wilson v. United States*, 221 U.S. 361, 375 (1911); *ICC v. Baird*, 194 U.S. 25, 45 (1904). It may therefore be emphatically stated that until today, there was no room to doubt that it is the *Fifth Amendment's* "historic function [to protect an individual] from compulsory incrimination through his [*420] own testimony or personal records." *United States v. White*, *supra*, at 701 (emphasis supplied).

3 Indeed, *Schmerber v. California*, 384 U.S. 757, 764 (1966), held:

"Some tests seemingly directed to obtain 'physical evidence,' for example, lie detector tests measuring changes in body function during interrogation, may actually be directed to eliciting responses which are essentially testimonial. To compel a person to submit to testing in which an effort will be made to determine his guilt or innocence on the basis of physiological responses, whether willed or not, is to evoke the spirit and history of the *Fifth Amendment*. Such situations call to mind the principle that the protection of the privilege 'is as broad as the mischief against which it seeks to guard.'..."

4 "The language of the Constitution cannot be interpreted safely except by reference to the common law and to British institutions as they were when the instrument was framed and adopted." *Ex parte Grossman*, 267 U.S. 87, 108-109 (1925). But, "the common law rule invoked shall be one not rejected by our ancestors as unsuited to their civil or political conditions." *Grosjean v. American Press Co.*, 297 U.S. 233, 249 (1936). Without a doubt, the common-law privilege against self-incrimination in England extended to protection against the production of

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incriminating personal papers prior to the adoption of the United States Constitution. See, e.g., *Roe v. Harvey*, 98 Eng. Rep. 302, 305 (K.B. 1769); *King v. Heydon*, 96 Eng. Rep. 195 (K.B. 1762); *King v. Purnell*, 95 Eng. Rep. 595, 597 (K.B. 1748); *King v. Cornelius*, 93 Eng. Rep. 1133, 1134 (K.B. 1744); *Queen v. Mead*, 92 Eng. Rep. 119 (K.B. 1703); *King v. Worsenham*, 91 Eng. Rep. 1370 (K.B. 1701). The significance of this English development on the construction of our Constitution is not in any way diminished by this country's experience with the privilege prior to the Constitution's adoption. See *Levy*, *supra*, at 368-404.

The common-law and constitutional extension of the privilege to testimonial materials, such as books and papers, was inevitable. An individual's books and papers are generally little more than an extension of his person. They reveal no less than he could reveal upon being questioned directly. Many of the matters within an individual's knowledge may as easily be retained within his head as set down on a scrap of paper. I perceive no principle which does not permit compelling one to disclose the contents of one's mind but does permit compelling the disclosure of the contents of that scrap of paper by compelling its production. Under a contrary view, the [***62] constitutional protection [**1586] would turn on fortuity, and persons would, at their peril, record their thoughts and the events of their lives. The ability to think private thoughts, facilitated as it is by pen and paper, and the ability to preserve intimate memories would be curtailed through fear that those thoughts or the events of those memories would become the subjects of criminal sanctions however invalidly imposed. Indeed, it was the very reality of those fears that helped provide the historical impetus for the privilege. See *Boyd v. United States*, *supra*, at 631-632; E. Griswold, *The Fifth Amendment Today* 8-9 (1955); 8 J. Wigmore, *Evidence* § 2250, pp. 277-281 (McNaughton rev. 1961); *id.*, § 2251, pp. 313-314; McKay, *Self-Incrimination and the New Privacy*, 1967 *Supreme Court Review* 193, 212. ⁵

5 "And any compulsory discovery by extorting the party's oath, or compelling the production of his private books and papers, to convict him of crime, or to forfeit his property, is contrary to the principles of a free government. It is abhorrent to the instincts of an Englishman; it is abhorrent to the instincts of an American. It may suit the purposes of despotic power; but it cannot abide the pure atmosphere of political liberty and personal freedom." *Boyd v. United States*, 116 U.S., at 631-632.

The proposition, *ante*, at 409, that *Boyd's* holding ultimately rested on the *Fourth Amendment* could not be more incorrect. *Boyd* did observe that the purposes to be served by the *Fourth* and *Fifth Amendments* shed light on each other, 116 U.S., at 633, but the holdings that the compelled production of the papers involved there violated the *Fourth* and *Fifth Amendments* were independent of each other. In holding that "a compulsory production of the private books and papers of the owner of goods sought to be forfeited in such a suit is compelling him to be a witness against himself, within the meaning of the *Fifth Amendment to the Constitution*, and is the equivalent of a search and seizure - and an unreasonable search and seizure - within the meaning of the *Fourth Amendment*," *id.*, at 634-635, the Court plainly did not make the *Fourth Amendment* violation a predicate, let alone an essential predicate, for its holding that there was also a *Fifth Amendment* violation. The Court is incorrect in suggesting that "the rule against compelling production of private papers rested on the proposition that seizures of or subpoenas for 'mere evidence,' including documents, violated the *Fourth Amendment* and therefore also transgressed the Fifth." *Ante*, at 409. The relation of the *Fourth Amendment* to the *Fifth Amendment* violation in *United States v. Lefkowitz*, 285 U.S. 452 (1932); *Agnello v. United States*, 269 U.S. 20 (1925); and *Gouled v. United States*, 255 U.S. 298 (1921), was merely that the illegal searches and seizures in those cases were held to establish the element of compulsion essential to a *Fifth Amendment* violation. See *ante*, at 399-400, n. 5. Even if the *Fourth Amendment* violations were now held not to establish the element of *Fifth Amendment* compulsion, it, of course, would not follow that the *Fifth Amendment's* protection against compelled production of incriminating private papers is lost.

Furthermore, that purely evidentiary material may have been seized in those cases was neither relied upon to establish the *Fourth Amendment* violations nor, in turn, to establish the *Fifth Amendment* violations. Indeed, in *Agnello*, contraband, not mere evidence, was illegally seized. Subsequent decisions modifying the "mere evidence" rule, therefore, have left untouched the *Fifth Amendment's* prohibition against the compelled production of incriminating testimonial evidence. Indeed, citing *Warden v. Hayden*, 387 U.S. 294 (1967), the Court notes, that the question is open whether the legal search and seizure of some forms of testimonial evidence would vi-

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olate the *Fifth Amendment*, ante, at 407 n. 9. Warden v. Hayden observed: "The items of clothing involved in this case are not 'testimonial' or 'communicative' in nature, and their introduction therefore did not compel respondent to become a witness against himself in violation of the *Fifth Amendment*.... This case thus does not require that we consider whether there are items of evidential value whose very nature precludes them from being the object of a reasonable search and seizure." 387 U.S., at 302-303. That observation was plainly addressed not to application of the *Fourth Amendment* but to application of the *Fifth*.

Contrary to the Court's intimations, ante, at 407-408, neither *Katz v. United States*, 389 U.S. 347 (1967); *Osborn v. United States*, 385 U.S. 323 (1966); nor *Berger v. New York*, 388 U.S. 41 (1967), all involving the *Fourth Amendment*, lends support to an argument that the *Fifth Amendment* would not protect the seizure of the private papers of a person suspected of crime. *Fifth Amendment* challenges to the seizure and use of private papers were not involved in those cases.

[*421] [***63] [**1587] The Court's treatment of the privilege falls far short of giving it the scope required by history and our precedents. ⁶ It is, of course, true "that the *Fifth Amendment* [*422] protects against 'compelled self-incrimination, not [the disclosure of] private information,'" ante, at 401, but it is also true that governmental compulsion to produce private information that might incriminate violates the protection of the privilege. Similarly, although it is necessary that the papers "contain no testimonial declarations by [the taxpayer]" in order for the privilege not to operate as a bar to production, ante, at 409, it does not follow [*423] that papers are not "testimonial" and thus producible because they contain no declarations. And while it may be that the unavailability of the privilege depends on a showing that "the preparation of all of the papers sought in these cases was wholly voluntary," *ibid.*, again it does not follow that the protection is necessarily unavailable if the papers were prepared voluntarily, for it is the compelled production of testimonial evidence, not just the compelled creation of such evidence, against which the privilege protects.

6 The grudging scope the Court today gives the privilege against self-incrimination is made evident by its observation that "[i]n the case of a documentary subpoena the only thing compelled is the act of producing the document..." Ante, at 410 n. 11. Obviously disclosure or production of

testimonial evidence is also compelled, and the heart of the protection of the privilege is in its safeguarding against compelled disclosure or production of that evidence.

Though recognizing that a subpoena served on a taxpayer involves substantial compulsion, the Court concludes that since the subpoena does not compel oral testimony or require the taxpayer to restate, repeat, or affirm the truth of the contents of the documents sought, compelled production of the documents by the taxpayer would not violate the privilege, even though the documents might incriminate the taxpayer. Ante, at 409. This analysis is patently incomplete: the threshold inquiry is whether the taxpayer is compelled to produce incriminating papers. That inquiry is not answered in favor of production merely because the subpoena requires neither oral testimony from nor affirmation of the papers' contents by the taxpayer. To be sure, the Court correctly observes that "[t]he taxpayer cannot avoid compliance with the subpoena merely by asserting that the item of evidence which he is required to produce contains incriminating writing, whether his own or that of someone else." Ante, at 410 (emphasis supplied). For it is not enough that the production of a writing, or books and papers, is compelled. Unless those materials are such as to come within the zone of privacy recognized by the Amendment, the privilege against compulsory self-incrimination does not protect against their production.

[*424] [***64] We are not without guideposts for determining what books, papers, and writings come within the zone of privacy recognized by the Amendment. In *Wilson v. United States*, 221 U.S. 361 (1911), for example, the Court held that the *Fifth Amendment* did not protect against the subpoena of corporate records in the possession and control of the president of a corporation, even though the records might have incriminated him. Though the evidence was testimonial, though its production was compelled, and though it would have incriminated the party producing it, the *Fifth Amendment* was no bar. The Court recognized that the Amendment "[u]ndoubtedly... protected [the president] against the compulsory production of his private books and papers," *id.*, at 377, but with respect to corporate records, the Court held: S

"[T]hey are of a character which subjects them to the scrutiny demanded.... This was clearly implied in the Boyd Case where the fact that the papers involved were the private papers of the claimant was constantly emphasized. Thus, in the case of public records and official documents, made or kept in the [**1588] administration of public office, the fact of actual possession or of lawful custody would not justify the officer in resisting inspection, even though the record was made by himself

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and would supply the evidence of his criminal dereliction." *Id.*, at 380 (emphasis in original).I

Couch v. United States expressly held that the *Fifth Amendment* protected against the compelled production of testimonial evidence only if the individual resisting production had a reasonable expectation of privacy with respect to the evidence. 409 U.S., at 336. Couch relied on *Perlman v. United States*, 247 U.S. 7 (1918), [*425] where the Court permitted the use against the defendant of documentary evidence belonging to him because "there was a voluntary exposition of the articles" rather than "an invasion of the defendant's privacy." *Id.*, at 14."/> Under Couch, therefore, one criterion is whether or not the information sought to be produced has been disclosed to or was within the knowledge of a third party. 409 U.S., at 332-333. That is to say, one relevant consideration is the degree to which the paper holder has sought to keep private the contents of the papers he desires not to produce.

Most recently, *Bellis v. United States*, 417 U.S. 85 (1974), followed the approach taken in *Wilson*. Bellis held that the partner of a small law firm could not invoke the privilege against self-incrimination to justify his refusal to comply with a subpoena requiring production of the partnership's financial records. Bellis stated: "It has long been established? that the *Fifth Amendment* privilege against compulsory self-incrimination protects an individual from compelled production of his personal papers and effects as well as compelled oral testimony.... The privilege applies to the business records of the sole proprietor or sole practitioner as well as to personal documents containing more intimate information about the individual's private life." 417 U.S., at 87-88. [***65] Bellis also recognized that the Court's "decisions holding the privilege inapplicable to the records of a collective entity also reflect... the protection of an individual's right to a 'private enclave where he may lead a private life.'... Protection of individual privacy was the major theme running through the Court's decision in *Boyd*... and it was on this basis that the Court in *Wilson* distinguished the corporate records involved in that case from the private papers at issue in *Boyd*." *Id.*, at 91-92. "[C]orporate [*426] records do not contain the requisite element of privacy or confidentiality essential for the privilege to attach." *Id.*, at 92. Bellis concluded that the same considerations which precluded reliance upon the privilege with respect to corporate records also precluded reliance upon it with respect to partnership records in the circumstances of that case. ⁷

7 With respect to a partnership invoice, it thus seems fair to say, as the Court does, ante, at 408, "that under [Bellis] the precise claim sustained in *Boyd* would now be rejected for reasons not there

considered." Bellis, however, took care to point out: "We do not believe the Court in *Boyd* can be said to have decided the issue presented today," 417 U.S., at 95 n. 2, thereby leaving unaltered *Boyd*'s more general or "imprecise" holding protecting against the compelled production of private papers.

A precise cataloguing of private papers within the ambit of the privacy protected by the privilege is probably impossible. Some papers, however, do lend themselves to classification. See generally Comment, The Search and Seizure of Private Papers: *Fourth and Fifth Amendment* Considerations, 6 Loyola (LA) L. Rev. 274, 300-303 (1973). Production of documentary materials created or authenticated by a State or the Federal Government, such as automobile registrations or property deeds, would seem ordinarily to fall outside the protection of the privilege. They hardly reflect an extension of the person.

[**1589] Economic and business records may present difficulty in particular cases. The records of business entities generally fall without the scope of the privilege. But, as noted, the Court has recognized that the privilege extends to the business records of the sole proprietor or practitioner. Such records are at least an extension of an aspect of a person's activities, though concededly [*427] not the more intimate aspects of one's life. Where the privilege would have protected one's mental notes of his business affairs in a less complicated day and age, it would seem that that protection should not fall away because the complexities of another time compel one to keep business records. Cf. *Olmstead v. United States*, 277 U.S. 438, 474 (1928) (Brandeis, J., dissenting). Nonbusiness economic records in the possession of an individual, such as canceled checks or tax records, would also seem to be protected. They may provide clear insights into a person's total lifestyle. They are, however, like business records and the papers involved in these cases, frequently, though not always, disclosed to other parties; and disclosure, in proper cases, may foreclose reliance upon the privilege. Personal letters constitute an integral aspect of a person's private enclave. And while letters, being necessarily interpersonal, are [***66] not wholly private, their peculiarly private nature and the generally narrow extent of their disclosure would seem to render them within the scope of the privilege. Papers in the nature of a personal diary are a fortiori protected under the privilege.

The Court's treatment in the instant cases of the question whether the evidence involved here is within the protection of the privilege is, with all respect, most inadequate. The gaping hole is in the omission of any reference to the taxpayer's privacy interests and to whether the subpoenas impermissibly invade those in-

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terests. The observations that the "accountant's workpapers are not the taxpayer's" and "were not prepared by the taxpayer," ante, at 409, touch on matters relevant to the taxpayer's expectation of privacy, but do not of themselves determine the availability of the privilege. *Wilson v. United States*, 221 U.S., at 378, stated: "[T]he mere fact that [*428] the appellant himself wrote, or signed, the [documents], neither conditioned nor enlarged his privilege. Where one's private documents would tend to incriminate him, the privilege exists although they were actually written by another person." ⁸ Thus, although "[t]he fact that the documents may have been written by the person asserting the privilege is insufficient to trigger the privilege," ante, at 410 n. 11, and "the fact that it was written by him is not controlling...," ibid., this is not to say that the privilege is available only as to documents written by him. For the reasons I have stated at the outset, however, I do not believe that the evidence involved in these cases falls within the scope of privacy protected by the *Fifth Amendment*.

8 Similarly, *United States v. Nobles*, 422 U.S. 225 (1975), held that the *Fifth Amendment* did not bar production of a defense investigator's summaries of interviews with witnesses. The Court carefully noted, however, that there was no indication that the summaries contained any information conveyed by the defendant to the investigator. *Id.*, at 234.

II

I also question the Court's treatment of the question whether the act of producing evidence is "testimonial." I agree that the act of production implicitly admits the existence of the evidence requested and possession or control of that evidence by the party producing it. It also implicitly authenticates the evidence as that identified in the order to compel. I disagree, however, that implicit admission of the existence and possession or control of the papers in this case is not "testimonial" merely because the Government could readily have otherwise proved existence and possession or control in these cases. [*429] I know of no *Fifth Amendment* principle which makes [**1590] the testimonial nature of evidence and, therefore, one's protection against incriminating himself, turn on the strength of the Government's case against him.

Nor do I consider the taxpayers' implicit authentication an insubstantial threat of self-incrimination. Actually, authentication of the papers as those described in the subpoenas establishes the papers as the taxpayers', thereby supplying an incriminatory link in the chain of evidence against them. It is not the less so [***67] because the taxpayers' accountants may also provide the link, since the protection against self-incrimination can-

not, I repeat, turn on the strength of the Government's case.

This Court's treatment of handwriting exemplars is not supportive of its position. See *Gilbert v. California*, 388 U.S. 263 (1967). The Court has only recognized that "[a] mere handwriting exemplar..., like the voice or body itself, is an identifying physical characteristic outside its protection." *Id.*, at 266-267. It is because handwriting exemplars are viewed as strictly nontestimonial, not because they are insufficiently testimonial, that the *Fifth Amendment* does not protect against their compelled production. Also not supportive of the Court's position is the principle that the custodian of documents of a collective entity is not protected from the act of producing those documents. Nothing in the language of those cases, either expressly or impliedly, indicates that the act of production with respect to the records of business entities is insufficiently testimonial for purposes of the *Fifth Amendment*. At most, those issues, though considered, were disposed of on the ground, not that production was insufficiently testimonial, but that one in control of the records of an artificial organization [*430] undertakes an obligation with respect to those records foreclosing any exercise of his privilege. ⁹

9 Individuals acting as representatives of a collective group "assume the rights, duties and privileges of the artificial entity or association of which they are agents or officers and they are bound by its obligations." *United States v. White*, 322 U.S. 694, 699 (1944). "In view of the inescapable fact that an artificial entity can only act to produce its records through its individual officers or agents, recognition of the individual's claim of privilege with respect to the financial records of the organization would substantially undermine the unchallenged rule that the organization itself is not entitled to claim any *Fifth Amendment* privilege, and largely frustrate legitimate governmental regulation of such organizations." *Belis v. United States*, 417 U.S., at 90. Indeed, in one of the more recent corporate records cases, *Curcio v. United States*, 354 U.S. 118, 125 (1957), the Court expressly recognized that "[t]he custodian's act of producing books or records in response to a subpoena duces tecum is itself a representation that the documents produced are those demanded by the subpoena." The Court in *Curcio*, however, apparently did not note any self-incrimination problem because of the undertaking by the custodian with respect to the documents. (One charged with failure to comply with an order to produce, however, may not thereafter be compelled to testify as to the existence or his control of the documents. See *Cur-*

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cio v. United States, supra.) In the present cases, of course, the taxpayers are not representatives of any artificial entity and have not undertaken any obligation with respect to that entity or its documents. They have stipulated, however, that the documents involved here exist and are those described in the subpoenas, thereby obviating any problem as to self-incrimination in these cases resulting from the act of production itself.

MR. JUSTICE MARSHALL, concurring in the judgment.

Today the Court adopts a wholly new approach for deciding when the *Fifth Amendment* privilege against self-incrimination can be asserted to bar production of documentary evidence. ¹ This approach has, in various [*431] forms, been discussed by commentators for some time; nonetheless, as I noted a few years ago, the theory "has an odd sound to it." *Couch v. United States*, 409 U.S. 322, 348 (1973) (dissenting). The *Fifth Amendment* [***68] basis for resisting production [**1591] of a document pursuant to subpoena, the Court tells us today, lies not in the document's contents, as we previously have suggested, but in the tacit verification inherent in the act of production itself that the document exists, is in the possession of the producer, and is the one sought by the subpoena.

1 The Court's theory would appear to apply to real evidence as well.

This technical and somewhat esoteric focus on the testimonial elements of production rather than on the content of the evidence the investigator seeks is, as MR. JUSTICE BRENNAN demonstrates, contrary to the history and traditions of the privilege against self-incrimination both in this country and in England, where the privilege originated. A long line of precedents in this Court, whose rationales if not holdings are overturned by the Court today, support the notion that "any forcible and compulsory extortion of a man's... private papers to be used as evidence to convict him of crime" compels him to be a witness against himself within the meaning of the *Fifth Amendment to the Constitution*. d">*Boyd v. United States*, 116 U.S. 616, 630 (1886). See also *Bellis v. United States*, 417 U.S. 85, 87 (1974); *Couch v. United States, supra*, at 330; *Schmerber v. California*, 384 U.S. 757, 763-764 (1966); *Davis v. United States*, 328 U.S. 582, 587-588 (1946); *United States v. White*, 322 U.S. 694, 698-699 (1944); *Wheeler v. United States*, 226 U.S. 478, 489 (1913); d">*Wilson v. United States*, 221 U.S. 361, 377 (1911).

However analytically imprecise these cases may be, they represent a deeply held belief on the part of the Members of this Court throughout its history that there

[*432] are certain documents no person ought to be compelled to produce at the Government's request. While I welcome the Court's attempt to provide a rationale for this longstanding rule, it is incumbent upon the Court, I believe, to fashion its theory so as to protect those documents that have always stood at the core of the Court's concern. Thus, I would have preferred it had the Court found some room in its theory for recognition of the import of the contents of the documents themselves. See *Couch v. United States, supra*, at 350 (MARSHALL, J., dissenting).

Nonetheless, I am hopeful that the Court's new theory, properly understood and applied, will provide substantially the same protection as our prior focus on the contents of the documents. The Court recognizes, as others have argued, that the act of production can verify the authenticity of the documents produced. See, e.g., *United States v. Beattie*, 522 F. 2d 267 (CA2 1975), cert. pending, Nos. 75-407, 75-700. But the promise of the Court's theory lies in its innovative discernment that production may also verify the documents' very existence and present possession by the producer. This expanded recognition of the kinds of testimony inherent in production not only rationalizes the cases, but seems to me to afford almost complete protection against compulsory production of our most private papers.

Thus, the Court's rationale provides a persuasive basis for distinguishing between the corporate-document [***69] cases and those involving the papers of private citizens. Since the existence of corporate record books is seldom in doubt, the verification of their existence, inherent in their production, may fairly be termed not testimonial at all. On the other hand, there is little reason to assume the present existence and possession of most private papers, and certainly not those MR. JUSTICE BRENNAN places at the top of his list of documents that the privilege should protect. See ante, at 426-427 (concurring in judgment). [*433] Indeed, there would appear to be a precise inverse relationship between the private nature of the document and the permissibility of assuming [**1592] its existence. Therefore, under the Court's theory, the admission through production that one's diary, letters, prior tax returns, personally maintained financial records, or canceled checks exist would ordinarily provide substantial testimony. The incriminating nature of such an admission is clear, for while it may not be criminal to keep a diary, or write letters or checks, the admission that one does and that those documents are still available may quickly - or simultaneously - lead to incriminating evidence. If there is a "real danger" of such a result, that is enough under our cases to make such testimony subject to the claim of privilege. See *Rogers v. United States*, 340 U.S. 367 (1951); *Brown v. Walker*, 161 U.S. 591

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(1896); *Counselman v. Hitchcock*, 142 U.S. 547 (1892). Thus, in practice, the Court's approach should still focus upon the private nature of the papers subpoenaed and protect those about which Boyd and its progeny were most concerned.

The Court's theory will also limit the prosecution's ability to use documents secured through a grant of immunity. If authentication that the document produced is the document demanded were the only testimony inherent in production, immunity would be a useful tool for obtaining written evidence. So long as a document obtained under an immunity grant could be authenticated through other sources, as would often be possible, reliance on the immunized testimony - the authentication - and its fruits would not be necessary, and the document could be introduced. The Court's recognition that the act of production also involves testimony about the existence and possession of the subpoenaed documents mandates a different result. Under the Court's theory, if the document is to be obtained the [*434] immunity grant must extend to the testimony that the document is presently in existence. Such a grant will effectively shield the contents of the document, for the contents are a direct fruit of the immunized testimony - that the document exists - and cannot usually be obtained without reliance on that testimony. ² Accordingly, the Court's theory offers [***70] substantially the same protection against procurement of documents under grant of immunity that our prior cases afford.

2 Similarly, the Court's theory affords protection to one who possesses documents that he cannot authenticate. If authentication were the only relevant testimony inherent in the act of production, such a person would be forced to relinquish his documents, for he provides no authentication testimony of relevance by producing them in response to a subpoena. See *United States v. Beattie*, 522 F. 2d 267 (CA2 1975), cert. pending, Nos. 75-407, 75-700. Under the Court's theory, however, if the existence of these documents were in question, the custodian would still be able to assert a claim of privilege against their production.

In short, while the Court sacrifices our pragmatic, if somewhat ad hoc, content analysis for what might seem an unduly technical focus on the act of production itself, I am far less pessimistic than MR. JUSTICE BRENNAN that this new approach signals the end of *Fifth Amendment* protection for documents we have long held to be privileged. I am not ready to embrace the approach myself, but I am confident in the ability of the trial judges who must apply this difficult test in the first instance to

act with sensitivity to our traditional concerns in this uncertain area.

For the reasons stated by MR. JUSTICE BRENNAN, I concur in the judgment of the Court.

REFERENCES

Supreme Court's views as to application of *Fifth Amendment* privilege against self-incrimination to compulsory production of documents

21 Am Jur 2d, *Criminal Law* 349, 353- 355; 34 Am Jur 2d, *Federal Taxation* 9024; 81 Am Jur 2d, *Witnesses* 30-35, 44, 176, 204, 205

13 Am Jur Trials 1, *Defending Federal Tax Evasion Cases*

USCS, *Constitution*, 5th Amendment

US L Ed Digest, Evidence 699, 701; Witnesses 76

ALR Digests, Evidence 1006, 1010; Witnesses 78

L Ed Index to Annos, Attorney and Client; Production of Books and Papers; Witnesses

ALR Quick Index, Privileged Communications; Production of Books and Papers; Self-Incrimination

Federal Quick Index, Self-Incrimination; Tax Enforcement; Tax Returns and Records

Annotation References:

Supreme Court's views as to application of *Fifth Amendment* privilege against self-incrimination to compulsory production of documents. 48 L Ed 2d 852.

Supreme Court's views as to the federal legal aspects of the right of privacy. 43 L Ed 2d 871.

Physical examination or exhibition of, or test upon, suspect or accused, as violating rights guaranteed by *Federal Constitution*. 16 L Ed 2d 1332, 22 L Ed 2d 909.

What matters are protected by attorney-client privilege or are proper subject of inquiry by Internal Revenue Service where attorney is summoned in connection with taxpayer-client under federal tax examination. 15 ALR Fed 771.

Propriety of requiring accused to give handwriting exemplar. 43 ALR3d 653.

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Privilege against self-incrimination as ground for refusal to produce noncorporate documents in possession of person asserting privilege but owned by another. 37 *ALR3d* 1373.

Privilege against disclosure of matters arising out of transactions or relationship between accountant and client. 38 *ALR2d* 670.



2 of 7 DOCUMENTS



Positive

As of: Apr 22, 2013

D.K. Jain d/b/a Luxor Pen Company v. Ramparts, Inc.

Opposition No. 98,307

Trademark Trial and Appeal Board

1998 TTAB LEXIS 433; 49 U.S.P.Q.2D (BNA) 1429

November 30, 1998, Decided

CORE TERMS: opposer, interrogatory, business records, deposition, discovery, ascertained, responsive, motion to compel, responding party, responding, pen, Trademark Rule, interrogating, invoke, registration, deriving, mail, prerequisite, advertising, trademark, burdensome, reset, reasonable opportunity, party served, specification, inspect, order requiring, oral testimony, unduly, invocation

JUDGES: [*1]

Before Sams, Rice, and Hairston, Administrative Trademark Judges.

OPINION:

THIS OPINION IS CITABLE AS PRECEDENT OF THE T.T.A.B.

By the Board:

By its intent-to-use application Serial No. 74/423,899, applicant, a Nevada corporation, seeks registration of the mark LUXOR for Class 16 goods identified as "postcards, posters, pens, pencils, paperweights and letter openers." Opposer has opposed registration of applicant's mark, alleging as grounds for opposition that he has superior rights in the designation LUXOR as used in connection with writing instruments, and that confusion is likely to result from applicant's use of its mark on its identified goods. Applicant has denied the allegations of the notice of opposition which are essential to opposer's claim.

This case now comes up on: (1) opposer's motion for an order requiring applicant to either provide written answers to opposer's Interrogatory Nos. 2, 8, 9 and 10 or produce and mail to opposer's counsel the documents which are asserted by applicant, under *Fed. R. Civ. P. 33(d)*, to contain information responsive to those interrogatories; (2) opposer's motion under Trademark Rule [*2] 2.120(d) (2) to compel applicant to produce and mail to opposer copies of the documents responsive to opposer's Document Production Request Nos. 1-3, 6, 10, 11, 14-17, 26, 30, 31 and 34; (3) opposer's motion to suspend proceedings pending disposition of the above-referenced motions to compel, and to reset testimony periods after decision of the motions; and (4) applicant's motion to dismiss the opposition under Trademark Rule 2.132(a) and/or Rule 2.128(a)(3), and alternative motion to compel the testimony deposition of opposer. Each party has contested the other's motions.

First, we grant opposer's motion to suspend proceedings pending disposition of opposer's motions to compel and to reset trial dates, good cause therefor having been shown. *See* Trademark Rules 2.117(c) and 2.121(a)(1); *Fed. R. Civ. P.*

6(b)(1). Proceedings herein are deemed to have been suspended as of the filing of those motions. Testimony periods are reset as indicated below.

Next, we deny applicant's motion to dismiss the opposition under Trademark Rules 2.132(a) and/or 2.128(a)(3). The pendency of opposer's motions to compel discovery, which expressly included opposer's [*3] requests (now granted by the Board) for suspension of proceedings and for a resetting of testimony periods after decision of the motions to compel, constitutes good cause for opposer's failure to present testimony or file a brief in this case.

We also deny applicant's alternative motion to compel opposer, a resident of India, to appear for what applicant calls a "duly noticed 30(b)(6)" oral testimony deposition in the United States. The discovery devices and remedies applicant seeks to utilize, i.e., a notice of discovery deposition under *Fed. R. Civ. P. 30(b)(6)* and a motion to compel discovery under Trademark Rule 2.120(e), are inapplicable and unavailable in the context of testimony depositions. The rules applicable to the Board's proceedings provide no basis for the noticing of a testimony deposition under Rule 30(b)(6), nor is there any basis in the Board's rules for the filing or granting of a "motion to compel" a witness's appearance at a testimony deposition. Applicant inexcusably n1 failed to avail itself of those discovery devices and remedies during the previously-scheduled and now-closed discovery period, and may not use them during [*4] the trial phase of this case.

n1 See the Board's order of October 1, 1996, wherein the Board, inter alia, denied applicant's motion to reopen the discovery period, finding that applicant had not met its burden of showing that its failure to either conduct discovery or to file a timely motion to extend discovery was the result of excusable neglect.

Applicant makes three arguments in support of its motion to compel, none of which are unpersuasive. Applicant cites no authority for its first argument, i.e., that a foreign opposer whose opposition is based on a claim of prior use (or analogous use) of the mark in the United States is, by reason of such claim, obligated to appear in the United States for either a discovery or a testimony deposition. Indeed, that argument ignores the Board's specific rules and procedures governing such depositions of foreign-resident witnesses. See, e.g., TBMP §§ 404.03(c)(1) and 713.06.

Applicant does cite certain authorities for its second argument in support of its motion to compel, i.e., that, as a general rule, a plaintiff will be required to make himself or herself available for discovery deposition in the district in which the suit was [*5] brought. See *Wright, Miller & Marcus, Federal Practice and Procedure: Civil 2d* § 2112; *Irwin Co., Inc. et al. v. Tide Pub. Co., Inc.*, 13 FRD 18 (SDNY 1952); *Taejon Bristle Mfg. Co., Limited v. Omnex Corp.*, 13 FRD 448 (SDNY 1953). However, those authorities are inapposite to this proceeding and to Board proceedings in general, for the following reasons.

First, the cases cited by applicant in support of its second argument involved discovery depositions, not trial testimony, and thus are inapposite on their facts to the present case. Second, even if it were a discovery deposition at issue in the present case, rather than a testimony deposition, the Board will not order a natural person residing in a foreign country to come to the United States for the taking of his or her discovery deposition. Under the Board's practice, discovery depositions of foreign-resident witnesses may be taken only by way of written questions, unless the parties stipulate otherwise or unless the Board, upon motion for good cause shown, orders that the deposition be taken orally in the foreign country. See TBMP § 404.03(c)(1). Third, even if the present dispute involved [*6] a discovery deposition, and even if the deponent were a United States resident, the "general rule" apparently applied in federal district court litigation, i.e., that a plaintiff will be required to make himself or herself available for examination in the district in which the suit was brought, does not apply in Board proceedings. See Trademark Rule 2.116(a). Trademark Rule 2.120(b) expressly provides that, unless the parties stipulate otherwise, a discovery deposition shall be taken in the judicial district where the deponent resides or is regularly employed. In short, applicant's second argument in support of its motion to compel is not persuasive.

Applicant's third argument in support of its motion to compel is that opposer should be required to appear in the United States for an oral testimony deposition because "to require the applicant to take the deposition of the Opposer in India may require service of letters rogatory through the Hague Convention to permit the deposition to be lawfully taken." (Applicant's motion to compel, at p. 6). Applicant is correct in noting that it must resort to the relatively uncertain and onerous letters rogatory procedure in order to depose [*7] opposer at this stage of the proceeding. See TBMP §§ 713.06 and 404.03(c) (2). However, it does not follow therefrom that applicant is entitled to issuance of an order requiring opposer to come to the United States for an oral testimony deposition. As discussed above, the Board will not order a foreign-resident witness to appear for a deposition in the United States. See TBMP § 404.03(c) (1). Furthermore, during the discovery period, applicant could have taken opposer's discovery deposition on written questions on notice

alone. See Trademark Rule 2.124(b) (2). Applicant failed to avail itself of that opportunity, and will not be heard to argue now that it should not be required to resort to the letters rogatory procedure in order to secure opposer's appearance (as an adverse witness) for a testimony deposition on written questions.

In short, and for the reasons discussed above, applicant's motion to compel opposer's appearance in the United States for an oral testimony deposition is denied.

We turn next to opposer's motions to compel discovery. By way of background, the Board notes that opposer served applicant with its discovery requests on May 31, 1996. On October 28, 1996, when [*8] applicant still had not responded to the discovery requests, opposer moved to compel applicant's responses. On January 21, 1997, the Board granted opposer's motion to compel, allowing applicant twenty days to respond, fully and without objection, to opposer's discovery requests. It appears that applicant subsequently served its discovery responses within the time allotted by the Board's order.

After careful consideration of the parties' arguments and of the circumstances herein, the Board grants opposer's motion under Trademark Rule 2.120(d) (2) n2 for an order requiring applicant to copy and mail to opposer the documents which are responsive to opposer's Document Production Request Nos. 1-3, 6, 10, 11, 14-17, 26, 30, 31 and 34. Applicant is allowed until thirty days from the date stamped on this order to serve opposer with the responsive documents.

n2 Trademark Rule 2.120(d) (2) reads as follows:

(2) The production of documents and things under the provisions of *Rule 34 of the Federal Rules of Civil Procedure* will be made at the place where the documents and things are usually kept, or where the parties agree, or where and in the manner which the Trademark Trial and Appeal Board, upon motion, orders.

[*9]

With respect to opposer's Interrogatory Nos. 2, 8, 9 and 10, the Board notes that applicant has responded to those interrogatories, in part, by exercising its option to produce business records under *Fed. R. Civ. P. 33(d)*. n3 Dissatisfied with that response, opposer argues in its present motion that a party may invoke the "business records" option of Rule 33(d) only if the burden of deriving or ascertaining the answer to the interrogatory is substantially the same for the interrogating party as it is for the responding party. In this case, opposer argues, it would be significantly more burdensome, both in terms of time and expense, for opposer's counsel to travel to Nevada to review applicant's documents than it would be for applicant to copy its own records and mail the copies to opposer's counsel in Washington, D.C. Accordingly, opposer contends, applicant cannot invoke Rule 33(d), and should be required to either provide complete written responses to the referenced interrogatories, or to copy and mail to opposer's counsel the documents from which the answers to the interrogatories can be ascertained.

n3 *Fed. R. Civ. P. 33(d)* provides as follows:

(d) Option to Produce Business Records.

Where the answer to an interrogatory may be derived or ascertained from the business records of the party upon whom the interrogatory has been served or from an examination, audit or inspection of such business records, including a compilation, abstract or summary thereof, and the burden of deriving or ascertaining the answer is substantially the same for the party serving the interrogatory as for the party served, it is a sufficient answer to such interrogatory to specify the records from which the answer may be derived or ascertained and to afford to the party serving the interrogatory reasonable opportunity to examine, audit or inspect such records and to make copies, compilations, abstracts or summaries. A specification shall be in sufficient detail to permit the interrogating party to locate and to identify, as readily as can the party served, the records from which the answer may be ascertained.

[*10]

In opposition to opposer's motion, applicant argues that it has properly invoked Rule 33(d) in its responses to opposer's Interrogatory Nos. 2, 8, 9 and 10. Applicant contends that it would be burdensome for applicant to compile the information required to respond to those interrogatories, inasmuch as applicant is a large, ongoing business concern which opened in October of 1993 and which accordingly has business records extending from well before that date to the present, and because applicant would have to "comb through" those records in order to provide written answers to opposer's interrogatories. Applicant also argues that opposer has not shown that the burden of reviewing applicant's business records and deriving therefrom the information which is responsive to opposer's interrogatories would be substantially greater for opposer than it would be for applicant, and that opposer therefore cannot object to applicant's invocation of Rule 33(d) with respect to those interrogatories. n4

n4 Specifically in this regard, applicant argues that because opposer already must travel to Las Vegas to review the documents produced in response to opposer's document production requests, the necessity of such travel cannot serve as a basis for finding that opposer's burden would be substantially greater than applicant's burden. However, this argument is not persuasive, inasmuch as the Board has granted opposer's motion under Trademark Rule 2.120(d) (2) for an order requiring applicant to copy and mail to opposer the documents which are responsive to opposer's document production requests. See *supra* at page 7.

[*11]

The courts and commentators which have addressed Rule 33(d) have identified a number of prerequisites to allowing a party to respond to an interrogatory by referring the interrogating party to the responding party's business records, in lieu of providing a written answer to the interrogatory. See generally Wright, Miller & Marcus, *supra*, at § 2178. Of particular relevance to the present case are the following general principles.

First, the availability of Rule 33(d)'s "business records" option is limited to situations in which requiring a party served with interrogatories to provide a traditional written answer to those interrogatories would impose a significant burden on the responding party, a burden which is above and beyond the normal burden involved in providing written responses to interrogatories. That is, the rule is not made applicable merely by the fact that the responding party would be required to review or refer to its records in order to provide a written answer to the interrogatory. Rather, Rule 33(d) contemplates situations in which the responding party shows that it would have to undertake "burdensome and expensive research" into its own business records [*12] in order to provide a written answer to the interrogatory. See Advisory Committee Notes (1970 Amendment).

In what has been described by Wright, Miller & Marcus, *supra* at § 2178, note 17, as "a leading case" on this question, i.e., *Pascale v. G. D. Searle & Co.*, 90 F.R.D. 55, 1981 U.S. Dist. LEXIS 12176, 31 Fed. R. Serv. 2d (Callaghan) 1251 (D.R.I. 1981), this first prerequisite to the application of Rule 33(d) has been explained by the court as follows:

Before determining whether the burden of deriving information from business records is substantially the same for both parties, the first question under Rule 33(c) [redesignated Rule 33(d) in 1993] is whether there exists a 'burden' at all within the meaning of the rule. An interrogated party can rely on Rule 33(c) [now Rule 33(d)] only if there is some burden involved in compiling or extracting the requested information, above and beyond the simple task of referring to the records in order to answer the interrogatories. * * * Answering interrogatories often requires the interrogated party to refer to written documents, particularly where the party is a corporate entity. If a party could invoke [*13] Rule 33(c) [now Rule 33(d)] in every such case, by claiming that the 'burden' of 'deriving' the information from the records is substantially the same for both parties, discovery would be thwarted at every turn. Referring to a document in order to answer an interrogatory is not the kind of burden contemplated by the rule.

90 F.R.D. at 60, 31 Fed. R. Serv. 2d at 1255.

The second general principle applicable to Rule 33(d) is that a party who responds to interrogatories by invoking Rule 33(d)'s option to produce business records "has the duty to specify, by category and location, the records from which answers to [the] interrogatories can be derived." Advisory Committee Notes (1980 Amendment) to Fed. R. Civ. P. 33(c) [redesignated 33(d) in 1993 Amendments]. Rule 33(d) expressly provides that the responding party's specifica-

tion of business records must be "in sufficient detail to permit the interrogating party to locate and to identify, as readily as can the party served, the records from which the answer may be ascertained." *Fed. R. Civ. P. 33(d)*. A party which responds to [*14] an interrogatory "by directing the interrogating party to a mass of business records or by offering to make all of their records available, justifying the response by the option provided by this subdivision," is abusing the option provided by Rule 33(d). *See Advisory Committee Notes (1980 amendment), supra; see also Rainbow Pioneer #44-18-04 A v. Hawaii-Nevada Investment Corp., 711 F.2d 902 (9th Cir. 1983).* n5

n5 Implicit in this "specificity" requirement, and explicit in the language of Rule 33(d), is the requirement that the documentary materials to which a responding party refers the interrogating party must be, in fact, "business records" of the responding party. *See In re Bilzerian, 190 Bankr. 964, 33 Fed. R. Serv. 3d (Callaghan) 825 (Bankr. M.D. FL 1995); Hoffman v. United Telecommunications, Inc., 117 F.R.D. 436 (D. Kan. 1987)*. In this regard, see *infra* at footnotes 9 and 10.

The third prerequisite to the applicability of Rule 33(d) is that the burden of compiling the information from the responding party's business records must be substantially the same for the interrogating party and the responding party. Several [*15] factors may be considered and balanced in making this determination, including the nature of the responding party's business records and the parties' respective costs of conducting the necessary research into those business records. The responding party's greater familiarity with its own business records may, in appropriate cases, be the determinative factor in this analysis. n6

n6 *See, e.g., T.N. Taube Corp. v. Marine Midland Mortgage Corp., 136 F.R.D. 449, 19 Fed. Rules Serv. 3d (Callaghan) 698 (WDNC 1991)* (where the responding party's business records offered in lieu of a written answer to interrogatories are asserted by the responding party to consist of many separate documents relating to different aspects of the responding party's operations, and where the responding party estimates that it would require a very time-consuming, expensive effort for the responding party to compile from those records the information necessary to answer the interrogatories, the court finds that it would be even more time-consuming and costly for the interrogating party, who lacks the responding party's familiarity with the records, to undertake the necessary review of the records; "it becomes clear that defendant's familiarity with its own records is the critical factor to be considered by the court" in determining whether the parties' respective burdens under Rule 33(d) are substantially the same).

[*16]

However, this determination, i.e., the substantial similarity, *vel non*, of the parties' respective burdens in deriving or ascertaining responsive information from the responding party's business records, need not be made unless the first two prerequisites, discussed above, have been met by the party seeking to invoke Rule 33(d). That is, the determination and weighing of the parties' respective burdens is only necessary and appropriate if the responding party already has established that it would be unduly burdensome for it to provide written answers to the interrogatories, and if its responses to the interrogatories have specified in sufficient detail the business records from which the answers to the interrogatories can be ascertained. *See Pascale v. G. D. Searle & Co., supra*.

Applying these principles to the present case, the Board finds that applicant has not established its entitlement to invoke Rule 33(d), and that its answers to opposer's Interrogatory Nos. 2, 8, 9 and 10 accordingly are insufficient to the extent that they consist of such invocation of Rule 33(d). n7

n7 Those interrogatories, and applicant's responses thereto, read as follows:

INTERROGATORY NO. 2:

Identify and describe in detail each product on which Applicant has at any time used its Mark, and for each such product:

(a) state the date when and geographic location where Applicant's Mark was first used in commerce in the United States;

(b) describe the circumstances of such first use, including the manner of use, the details of any sale involved, the type and/or class of customers, the trade, sale and/or distribution channels, number of units sold, and price charged; and

(c) for each such product or service identified above, state whether the use (i) has continued to the present date, (ii) has changed in any respect and describe all such changes, or (iii) state the inclusive dates during which use of the mark was discontinued for any period of time;

(d) if Applicant's Mark is not yet in use for Applicant's Products, identify the date on which Applicant anticipates commencing use of Applicant's Mark for Applicant's Products.

RESPONSE TO INTERROGATORY NO. 2:

The responses to the subparts of this interrogatory can be ascertained from the business records of Applicant. Applicant responds by affording the Opposer a reasonable opportunity to inspect and copy such records pursuant to F.R.Civ.P. 33(d) subject to the execution of an appropriate confidentiality agreement.

Applicant also provides the following:

(a) Applicant's Mark was first publically [sic] announced in a press release dated April 21, 1992 which was published in local, Nevada, media and, on information and belief, nationally via media wire services. Applicant also attaches copies of Federal and State trademark/service mark registrations for various goods and services which reflect dates of use thereof. Furthermore in or about August 1992 Applicant received its first shipment of pens bearing the Luxor mark for use by employees and for promotional distribution. Between August 1992 and November 1993 approximately 500,000 such pens were received and distributed by Applicant.

(b) The circumstances of first use was the press announcement. As for the individual goods and services, Applicant refers Opposer to its business records and to its Federal and State trademark/service mark registrations and applications. As for pens, a reasonable review of the records indicates that pens bearing the Mark were distributed at least as early as August 1992 as promotional items and were provided in the guest rooms of the hotel upon opening in October 1993. Such articles have also been sold at the on-site gift shop since at least as early as the opening of the facility in October 1993.

(c) The use of the Mark for goods and services has remained unchanged since use first began and has expanded to further uses with designs.

(d) Applicant is continually expanding use of the Mark to other goods and services. In October 1994 Applicant distributed a mail order catalog describing and depicting various goods bearing the Mark. Applicant distributes many other goods and provides a myriad of services under The Mark at its property in Las Vegas. Applicant also continues to advertise in print media and television using the Mark.

INTERROGATORY NO. 8:

Identify and describe in detail all types of media, including publications, radio and television, where Applicant has advertised or offered for sale in the United States each of Applicant's Products under Applicant's Mark, and state the amounts, by type of media and by date, which have been or will be expended by Applicant in promoting, advertising or offering each of Applicant's Products under Applicant's Mark for each calendar year from 1990 to date.

RESPONSE TO INTERROGATORY NO. 8:

Applicant uses and has used print media as well as television and radio advertising. Detailed responses to this interrogatory can be ascertained from the business records of Applicant. Applicant responds by affording the Opposer a reasonable opportunity to inspect and copy such records pursuant to F.R. Civ. P. 33(d).

INTERROGATORY NO. 9:

For each of Applicant's Products, state, by number of units and dollar volume, the amount of sales in the United States for each calendar year from 1990 to date.

RESPONSE TO INTERROGATORY NO. 9:

Responses to this interrogatory can be ascertained from the business records of Applicant. Applicant responds by affording the Opposer a reasonable opportunity to inspect and copy such records pursuant to F.R. Civ.

P. 33(d). With regard to pens, Applicant refers Opposer to the invoice showing pen purchases from August 1992 to October 1993 provided in response to Opposer's Request for Production of Documents.

INTERROGATORY NO. 10:

(a) Explain how Applicant's mark is used and promoted to create a public perception of the Mark as an indication of source.

(b) Identify the documents that evidence, refer to or otherwise relate to your response to subparagraph (a) of this interrogatory.

RESPONSE TO INTERROGATORY NO. 10:

(a) Applicant uses and has used the Mark in association with the sale, advertising and promotion of goods and services provided by Applicant to the public. The Mark appears on goods themselves, tags and labels therefor and in advertising and promotional items in association with those goods and services. Applicant advertises its services with reference to the Mark, on signage, in television and radio advertisements, in print media, in telephone directories and the like.

(b) The responses to the subparts of this interrogatory can be ascertained from an examination of the goods of Applicant and an examination of signage as well as an inspection of advertising copy and exemplars used by Applicant. Applicant responds by affording the Opposer a reasonable opportunity to inspect and copy such records and goods pursuant to F.R.Civ.P. 33(d).

[*17]

As a preliminary matter, the Board notes that both parties appear to have focused primarily on the third of the above-discussed principles or prerequisites, i.e., whether opposer and applicant would face substantially the same burden in deriving the answers to the interrogatories from applicant's business records. The parties have slighted the threshold issues of whether applicant, in the first instance, would be unduly burdened by providing written answers to the interrogatories and whether applicant's interrogatory responses themselves satisfy Rule 33(d)'s requirement for a detailed specification of the business records asserted to contain information responsive to the interrogatories. Because the Board finds that these threshold prerequisites to the applicability of Rule 33(d) have not been met in this case, the Board need not and does not reach the issue of the relative weight of the parties' respective burdens.

Turning to those threshold issues, the Board finds that applicant has failed to establish that it would be unduly burdensome for applicant to provide written answers to these interrogatories. The circumstances recited by applicant in support of its "burdensomeness" [*18] claim, i.e., that applicant is a large, ongoing concern with business records dating from before 1993 to the present, are not so unusual as to entitle applicant to invoke the relief contemplated by Rule 33(d), i.e., the option to produce business records in lieu of providing written answers to opposer's interrogatories.

In this regard, the Board notes that the interrogatories in question are straightforward in form and unexceptional in subject matter and scope for this type of proceeding. They are the types of interrogatories to which parties routinely are able to respond without having to invoke Rule 33(d). Applicant has not shown that providing written answers to opposer's interrogatories would require it to do anything more than simply refer to its business records to obtain the responsive information, nor does it appear that requiring applicant to provide written answers to opposer's interrogatories would impose upon applicant any special burden which is above and beyond the burden normally faced by parties responding to such interrogatories. In the absence of any showing of the existence of such special burden, applicant is not entitled to the relief provided by Rule 33(d). [*19] n8

n8 Additionally, the Board has already determined, in view of applicant's initial failure to serve timely answers or objections to opposer's discovery requests, that applicant has waived its right to object to opposer's interrogatories and must respond to those interrogatories fully and without objection. See the Board's January 27, 1997 order compelling discovery. To the extent that applicant's present invocation of Rule 33(d) is a belated attempt to assert a general "burdensomeness" objection to opposer's interrogatories (as opposed to the more specialized burden which is a prerequisite to relief under Rule 33(d)), that attempt is unavailing.

Second, the Board finds that applicant is not entitled to invoke Rule 33(d) because, for the most part, applicant has failed to comply with that rule's express requirement that "[a] specification [of the records from which the answer to the interrogatory may be derived or ascertained] shall be in sufficient detail to permit the interrogating party to locate and to

identify, as readily as can the party served, the records from which the answer may be ascertained." *Fed. R. Civ. P. 33(d)*. To [*20] the extent that applicant's responses to opposer's interrogatories consist of applicant's assertion that the information responsive to the interrogatories "can be ascertained from the business records of applicant," those responses are insufficient. See, e.g., applicant's prefatory response to opposer's Interrogatory No. 2 and its responses to opposer's Interrogatory Nos. 8 and 9, quoted *supra* at footnote 7.

The Board also finds that applicant's generalized reference, in its response to opposer's Interrogatory No. 10, to applicant's "advertising copy" and "exemplars" is an insufficiently detailed specification of the business records from which the answer to opposer's Interrogatory No. 10 can be derived or ascertained. n9

n9 The Board is assuming that "advertising copy" and "exemplars" are in fact "business records" within the meaning of Rule 33(d). Clearly, the other items referred to in applicant's response to Interrogatory No. 10, i.e., applicant's "goods" and "signage," are not "business records," and applicant's citation to those materials under Rule 33(d) is inappropriate. See discussion *supra* at footnote 5.

The Board notes that applicant's responses to opposer's [*21] Interrogatory Nos. 2(b) and 9 include relatively specific references to certain materials from which the answers to those interrogatories purportedly may be ascertained. In its response to Interrogatory No. 2(b), applicant states that applicant's trademark and service mark applications and registrations contain responsive information regarding the circumstances of applicant's first use of its mark on particular goods and services. In its response to Interrogatory No. 9, applicant refers opposer to a previously-produced invoice for responsive information regarding applicant's sales figures for pens bearing the mark. However, even assuming that applicant's responses to Interrogatory Nos. 2(b) and 9 satisfy the "specificity" requirement of Rule 33(d), n10 it is apparent that, as discussed above, it would not be unduly burdensome to require applicant to provide written answers to Interrogatory Nos. 2(b) and 9. The records cited by applicant in its responses to these interrogatories, i.e., the trademark and service mark applications and registrations and the single invoice, appear to be quite limited in number and specific in nature, and applicant has not shown that it cannot provide written [*22] answers to the interrogatories by making simple reference to these limited, specific documents.

n10 Likewise, the Board is assuming *arguendo* (a) that the trademark and service mark applications and registrations cited by applicant in its response to Interrogatory No. 2(b) are in fact "business records" within the meaning of Rule 33(d) - see discussion *supra* at footnote 5; (b) that the information requested by Interrogatory No. 2(b), i.e., the circumstances of applicant's first use of its mark on its goods and services, "including the manner of use, the details of any sale involved, the type and/or class of customers, the trade, sale and/or distribution channels, number of units sold, and price charged," can in fact be derived or ascertained from applicant's trademark and service mark applications and registrations; and (c) that the information requested by Interrogatory No. 9, i.e., applicant's sales figures for pens, in terms of number of units and dollar volume, for each calendar year from 1990 to date, can in fact be derived or ascertained from an invoice showing applicant's purchases of pens from August 1992 to October 1993.

In short, for the reasons discussed above, [*23] the Board finds that applicant's responses to opposer's Interrogatory Nos. 2, 8, 9 and 10 are insufficient to the extent that those responses consist of applicant's invocation of *Fed. R. Civ. P. 33(d)*. Accordingly, the Board grants opposer's motion to compel, to the extent that applicant is allowed until thirty days from the date stamped on this order to serve supplemental written answers to opposer's Interrogatory Nos. 2, 8, 9 and 10. Such supplemental written answers shall include the information asserted by applicant (in its original interrogatory responses) to be ascertainable by reference to applicant's business records. Any evidence submitted by applicant during trial which consists of information which should have been, but was not, provided in its discovery responses shall be subject to being stricken, upon appropriate motion filed by opposer. See *Fed. R. Civ. P. 37*.

In accordance with the Trademark Rules of Practice, testimony periods are reset as follows:

THE PERIOD FOR DISCOVERY TO CLOSE:

CLOSED

Testimony period for party in
position of plaintiff to close
(opening thirty days prior thereto)

Feb. 15, 1999

Testimony period for party in
position of defendant to close

April 16, 1999

THE PERIOD FOR DISCOVERY TO CLOSE:
(opening thirty days prior thereto)

CLOSED

Rebuttal testimony period to close
(opening fifteen days prior thereto)
[*24]

May 31, 1999

Briefs are due in accordance with Trademark Rule 2.128. An oral hearing will be set only upon written request in accordance with Trademark Rule 2.129. See Trademark Rule 2.124 regarding the noticing and conducting of depositions on written questions.

In summary, **IT IS HEREBY ORDERED THAT:**

1. Opposer's motion to suspend proceedings pending disposition of its motions to compel, and its motion to reset testimony periods after such disposition of those motions, is granted.
2. Applicant's motion to dismiss the opposition under Trademark Rules 2.132 and/or 2.128 is denied.
3. Applicant's alternative motion to compel the testimony deposition of opposer is denied.
4. Opposer's motion to compel applicant to copy and mail to opposer the documents which are responsive to opposer's Document Production Request Nos. 1-3, 6, 10, 11, 14-17, 26, 30, 31 and 34 is granted. Applicant is allowed until thirty days from the date stamped on this order to serve the responsive documents.
5. Opposer's motion to compel applicant's further answers to opposer's Interrogatory Nos. 2, 8, 9 and 10 is granted, to the extent that applicant is allowed until thirty days from the date stamped on this order [*25] to serve supplemental answers to said interrogatories, in writing and without objection.
6. Trial dates, commencing with opposer's testimony period, are reset as indicated above.

J. D. Sams

J. E. Rice

P. T. Hairston

Administrative Trademark Judges, Trademark Trial and Appeal Board

Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark LawProtection of RightsPriorityGeneral OverviewTrademark LawProtection of RightsRegistrationGeneral OverviewTrademark LawU.S. Trademark Trial & Appeal Board ProceedingsOppositionsGrounds

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

EJW

Mailed: December 31, 2009

Opposition No. 91166320

Huber + Suhner Ltd.

v.

CHAMPLAIN CABLE CORPORATION

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

Telephone Conference

On December 29, 2009, the parties, Huber + Suhner Ltd. (represented by Julie B. Seyler of Abelman Frayne & Schwab) and Champlain Cable Corporation (represented by Heather V. Miller of Hinman, Howard & Kattel, LLP), and Elizabeth Winter, the assigned Interlocutory Attorney, all participated in a telephone conference regarding opposer's motion to compel.¹ See Trademark Rules 2.120(i)(1) and 2.127(c); and TBMP § 502.06 (2d ed. rev. 2004). This order summarizes the conference and sets forth the status of the proceeding.

¹ The motion to compel was originally filed on March 13, 2008, but was deemed moot by the Board in an order mailed October 22, 2008. The motion was reinstated by the Board in its order mailed May 11, 2009. This proceeding has remained suspended since that date.

To expedite the decision on the subject motion, the Board presumes the parties' familiarity with the issues presented and does not provide a complete recitation of the allegations and arguments of each party.

Opposer's Motion to Compel

In its reply brief, opposer specified that only applicant's responses to Interrogatory Nos. 6, 7(a) and 7(b), and to Requests for Production of Documents Nos. 6, 8, 9, 14 and 19 remain in dispute. In view thereof, during the telephone conference, the Board addressed those discovery requests and applicant's responses thereto.

- *Good Faith Effort Requirement*

At the outset, the Board addressed the requirement of Trademark Rule 2.120(e)(1), 37 C.F.R. § 2.120(e)(1), viz. that a motion to compel must be supported by a written statement from the moving party that such party or its attorney 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 TBMP §532.02 (2d ed. rev. 2004). Specifically, the Board noted the letters from opposer's counsel to applicant's counsel dated December 26, 2007, February 19, 2008, March 7, 2008 and October 8, 2008, and a telephone call between counsel that apparently occurred in late September or October 2008, with which

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opposer sought to resolve the initial lack of response from applicant and, later, alleged deficient responses from applicant. Notwithstanding opposer's seven-month delay in following up regarding the alleged deficiencies in applicant's responses, the Board stated that opposer had complied with the good faith effort requirement set forth in Trademark Rule 2.120(e)(1).

- *Interrogatories*

The following determinations were made regarding opposer's interrogatories. Opposer's motion to compel is:

(1) Granted in part, with respect to interrogatory no. 6. The Board discussed the list of goods on applicant's document "Bates No. 00136", which sets forth sales in dollar units from May 26, 2006 through 2008. Applicant clarified that the description of goods in the involved application includes all the goods listed on said document. The Board stated that providing annual sales figures (rather than the monthly figures requested) for the described goods in connection with the involved mark is sufficient. However, applicant is required to provide annual sales figures for the last five years (i.e. including and subsequent to May 26, 2004), which were not already provided. See *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 123 (TTAB 1974) (required to furnish round figures concerning sales under mark for period of five years as well as advertising

expenditures relating thereto; and TBMP § 414(18) (2d ed. rev. 2004).

(2) Granted in part, with regard to interrogatory nos. 7(a) and 7(b). Applicant's response as to whether it engages in advertising or other promotional activities relative to applicant's goods with applicant's mark was that it does not engage in print advertising, but has sales literature and brochures and maintains a website. Applicant also stated the approximate cost of its sales brochures as \$30,000 annually. Such responses are sufficient but for the wording "and maintains a website", which begs the question as to whether applicant provides advertising on its website. This question is supported by evidence provided by applicant, *i.e.* product summaries shown at applicant's website as shown in applicant's documents, Bates Nos. 00038-00039.

Applicant must clarify whether it provides advertising on its website and, to the extent it does so, applicant must (i) explain to opposer how advertising is conducted via the website, e.g. hyperlinks to product information sheets or single-page product summaries, and (ii) provide the annual costs of said advertising to the extent that such advertising and promotional costs can be separated from the costs of creating and maintaining the website for general purposes, and to the extent applicant's expenditures, if

any, for website advertising exceeds the \$30,000 annual advertising expenditures for printing its brochures, applicant must provide annual advertising figures incurred for website advertising for the last five years. See Id. If such data is unavailable, applicant should state so explicitly.

As discussed, applicant must also clarify whether an advertising agency is involved in the creation of its product information sheets and/or any website advertising. If such an entity is so involved, applicant must identify the advertising agency employees having the most knowledge of such advertising and promotion. See TBMP § 414(17) (2d ed. rev. 2004).

- *Requests for Production of Documents*

Before addressing the particular requests for production in dispute, the Board noted opposer's requests for "all documents" in several of its requests. To the extent opposer requests copies of "all documents" that relate to the production of applicant's goods, such request is denied for being overly broad and unduly burdensome. In general, a request for "all documents" without any temporal limitation is not in conformance with the parties' obligation to make a good faith effort to seek only such discovery as is proper and relevant to the specific issues involved in the proceeding. See TBMP § 402.01 (2d ed. rev.

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2004). Furthermore, a party need not provide discovery with respect to goods that are not involved in the proceeding and have no relevance thereto. *Id.* at § 414(11).

The following determinations were made regarding opposer's requests for production of documents in dispute. Opposer's motion to compel is:

(1) Granted in part, with respect to request for production no. 6. In regard to opposer's request for documents concerning "the production of applicant's goods ...," the Board notes that applicant has stated that all its goods are produced in Colchester, Vermont. Applicant also has provided an invoice history list (shown in applicant's documents, Bates Nos. 00138-00139), which sets forth a list of buyers of "automotive products" for the year 2004, and numerous product information sheets (shown in applicant's documents, Bates Nos. 00038-00090). Applicant's counsel stated that actual invoices are kept in storage and are unavailable without undue burden to applicant. The Board notes also the declaration of Rick Antic, which avers that applicant "markets and sells wire and cable products to the automotive and transportation industry under the RADXL mark" and that applicant's customer base "includes" original equipment manufacturers for the automotive industry. Nonetheless, these references to the "automotive industry" or "transportation industry" are insufficient insofar as

such wording is overly vague as to the identity of customer types in the context of such complex industries. Moreover, the term "includes" implies that there exist other types or classes of customers. Opposer is entitled to more specific information on classes of customers of applicant's involved goods sold in connection with the RADXL mark (TBMP § 414(3)) and on geographic areas of distribution of goods sold under the involved mark (TBMP § 414(16)). Therefore, to the extent it has not already done so, applicant must provide documents in its custody, possession or control which show geographic areas of distribution of the involved goods sold in connection with the RADXL mark and specific classes of customers for said goods.²

As noted during the conference, where complete compliance with this or any other granted discovery request discussed in this order would be unduly burdensome, a representative sampling may be provided (TBMP § 414(2)); however, an explanation must be made describing why the request is unduly burdensome. (For example, the responding party has tens of thousands of documents spanning decades.) Furthermore, a production of "representative" documents must truly be a representative sampling, and not merely a self-

² The Board has already addressed *supra*, in connection with Interrogatory no. 6, the manner in which applicant is to provide to opposer additional information regarding annual sales of its goods sold in connection with the RADXL mark.

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serving selection of favorable documents. *See, e.g., The Procter & Gamble Company v. Keystone Automotive Warehouse, Inc.*, 191 USPQ 468 (TTAB 1976). An evasive or incomplete response is the equivalent of a failure to disclose. Fed. R. Civ. P. 26(g) and 37(a)(3).

(2) Granted in part, with respect to request for production no. 8. In regard to opposer's request for documents relating to the implementation of applicant's advertising program, applicant stated in its supplemental response that it "does not advertise its products in print media. Samples of Applicant's product information sheets which are directed to customers are attached (Bates numbers 00038-00090). Applicant is responsible for printing the product information sheets." This response is sufficient to the extent applicant has provided representative samples of its product advertising. However, in tandem with applicant's responses to Interrogatory Nos. 7(a) and 7(b) and document request no. 6 discussed *supra*, applicant must provide documents in its custody, possession or control which show the classes of customers who have received or receive the product information sheets or who access applicant's website advertising. As noted, *supra*, opposer is entitled to information on the classes of customers for a party's involved goods. *See* TBMP § 414(3) (2d ed. rev. 2004). If such data is unavailable, applicant should state so

explicitly. Applicant is not obligated to create responsive documents solely to satisfy opposer's discovery requests.

See Washington v. Garrett, 10 F.3d 1421, 1437-1438 (9th Cir. 1993).

(3) Denied, with respect to request for production no. 9, except as agreed between the parties. In regard to opposer's request for documents regarding applicant's first use of its RADXL mark in the United States, the Board noted that priority is not an issue in this case (see, e.g., notice of opp. ¶6). Opposer asserted that such information may be relevant to the prior relationship between the parties. Applicant agreed to research whether original invoices of applicant's *first use* of the mark RADXL with the involved goods and, if available, provide such document(s) to opposer.

(4) Denied as being overly broad and burdensome, with respect to request for production no. 14, except as agreed to by the parties. Applicant already provided a sample label (applicant's document with Bates No. 00091), but agreed during the conference to provide an actual label showing how the mark is actually presented in connection with the involved goods.

(5) Denied, with respect to request for production no. 19, which requested "all documents showing that applicant was affiliated with opposer." Applicant's response is sufficient

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(see applicant's documents, Bates Nos. 00092-00124); and other documents should be in opposer's control or possession.

Duty to Supplement Responses

Applicant is reminded of its continuing duty to thoroughly search its records for all information properly sought in discovery, and to provide such information to the requesting party. TBMP § 408.02 (2d ed. rev. 2004). A party that has responded to a request for discovery with a response is under a *continuing* duty to supplement or correct the response to include information thereafter acquired or uncovered. *Id.* at § 408.03.

Applicant is also reminded that, if a party provides an incomplete response to a discovery request, that party, upon a timely raised objection by an adverse party, may not thereafter rely at trial on information from its records which was properly sought in the discovery request, but which was not included in the response thereto, unless the response is supplemented in a timely fashion pursuant to Fed. R. Civ. P. 26(e). *See Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718 (TTAB 1987); and TBMP §408.02. Applicant is further reminded that, should it be later found to have willfully withheld discovery responses, introduction of such evidence withheld may be precluded upon a motion to strike.

Proceedings Resumed; Trial Dates

Opposer's motion to compel is granted to the extent discussed herein. Proceedings are resumed. Applicant is allowed until **THIRTY DAYS** from the mailing date of this order in which to respond to the interrogatories, as discussed, and to identify and copy all documents and materials responsive to opposer's document requests, as discussed herein, and forward such information and materials to opposer. Trial dates are reset as follows:

DISCOVERY PERIOD TO CLOSE:	CLOSED
Thirty-day testimony period for party in position of plaintiff to close:	March 31, 2010
Thirty-day testimony period for party in position of defendant to close:	May 30, 2010
Fifteen-day rebuttal testimony period to close:	July 14, 2010

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.
