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

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Mailed: September 27, 2013

Opposition No. **91207428**

Texas Children's Hospital

v.

U.T. Physicians

Yong Oh (Richard) Kim, Interlocutory Attorney:

This matter comes up on opposer's motion (filed May 1, 2013) to compel applicant's supplemental discovery responses and supplementation of its privilege log. The motion is fully briefed.

Discovery was due to close on July 18, 2013, as reset. As opposer's motion was filed on May 1, 2013, it is timely. *See* Trademark Rule 2.120(e)(1).

A motion to compel must be supported by a written statement from the movant 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 in its motion, and has been unable to reach agreement. *See* Trademark Rule 2.120(e)(1) and TBMP § 523.02 (2013). As part of its motion, opposer has attached a "Certificate of Conference" wherein opposer

attests to two notifications sent to applicant on March 27 and April 30, 2013, concerning deficiencies in applicant's responses. Copies of this correspondence were provided as part of applicant's response as well as opposer's reply.

In reviewing the correspondence and the circumstances surrounding them, it is apparent that a good faith effort to resolve the issues in opposer's motion to compel was not made. The good faith requirement of Trademark Rule 2.120 requires opposer, as the moving party, to make an effort to obtain the discovery responses it seeks by engaging in meaningful discussions prior to filing a motion to compel. This requirement is not discharged by a unilateral email sent to the non-moving party backed with the threat of a motion to compel should applicant fail to comply. Indeed, it is apparent from the parties' correspondences that no meaningful discussion concerning the particular discovery disputes at hand occurred or that such a discussion was facilitated by opposer.

For instance, the March 27 email demanding supplementation of the majority of applicant's responses to opposer's 112 document requests by April 1, 2013, consists largely of opposer's boilerplate claims of deficiency and requests for additional information. Applicant sent a detailed response to the email on March 28, 2013, noting that applicant "stand[s] ready to confer." *Applicant's*

Correspondence of March 28, 2013, p. 5. Rather than taking applicant up on its offer to confer, on March 29, 2013, opposer simply responded "Thank you for your letter. Our motion to compel will follow." *Opposer's Email of March 29, 2013*. Such a response is bereft of any effort to resolve the discovery dispute of which opposer complains and demonstrates that opposer views the good faith requirement as a mere formality. Indeed, it is apparent from opposer's subsequent email of April 30, 2013, that opposer had already drafted a motion to compel since the majority of the email consists of portions of the motion which opposer appears to have "cut and paste" from the motion into the email, and that the purpose of the email was not to secure a meeting with applicant but rather to perfect the good faith requirement of Trademark Rule 2.120 by covering all of the areas of dispute not covered by its prior email of March 27, 2013, but which were included in the motion to compel, which opposer served and filed the following day on May 1, 2013, prior to receiving any response from applicant. *Rundelli Declaration*, ¶ 11.

Finally, that opposer failed to engage in a meaningful discussion of the discovery issues that are the subject of opposer's motion is evident in the nature and number of discovery requests/responses at issue. *See Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984).

Each party has a duty not only to make a good faith effort to satisfy the discovery needs of its adversary but also 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 Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1305 (TTAB 1987). Board intervention should only be sought in relation to those discovery disputes that the parties have been unable to resolve ***despite their best efforts to do so***. Had such good faith efforts been put forward by the parties, then there is no reason why opposer should present to the Board such a large number of requests for resolution.

Accordingly, the Board finds that opposer has failed to discharge the good faith requirement of Trademark Rule 2.120(e)(1) and hereby **DENIES without prejudice** opposer's motion to compel. Both counsels are hereby ordered to confer[1] regarding the discovery requests that remain in dispute within **THIRTY DAYS** of the mailing date of this order. If the parties remain unable to resolve their discovery dispute, a second (and more narrow) motion to compel may be filed. Any future failure to cooperate or to otherwise act in good faith in the discovery process by

[1] Any future motion to compel will not be considered without a telephonic conference between the parties discussing each and every discovery request or response/production in dispute.

either party will be looked upon by the Board with extreme disfavor.

The parties are reminded that if proper discoverable matter is withheld from the requesting party, the responding party may be precluded from relying on such matter and from adducing testimony with regard thereto during its testimony period. *See Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1896 n.5 (TTAB 1988).

Dates are **RESET** as follows:

Expert Disclosures Due	**11/29/2013**
Discovery Closes	**12/29/2013**
Plaintiff's Pretrial Disclosures Due	**2/12/2014**
Plaintiff's 30-day Trial Period Ends	**3/29/2014**
Defendant's Pretrial Disclosures Due	**4/13/2014**
Defendant's 30-day Trial Period Ends	**5/28/2014**
Plaintiff's Rebuttal Disclosures Due	**6/12/2014**
Plaintiff's 15-day Rebuttal Period Ends	**7/12/2014**

IN EACH INSTANCE, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within **thirty days** after completion of taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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