

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

wbc

Mailed: February 17, 2016

Opposition No. 91207525

Taza Systems, LLC

v.

*Starbucks Corporation DBA
Starbucks Coffee Company*

Wendy Boldt Cohen, Interlocutory Attorney:

This case now comes up for consideration of Applicant's renewed motion to test the sufficiency of Opposer's responses to Applicant's Requests for Admission (filed November 3, 2015). The motion is contested by Opposer.

The Board has considered the parties' submissions and presumes the parties' familiarity with the factual bases for the motion and does not recount them here except as necessary to explain the Board's order.

As an initial matter, the Board finds that Applicant has made a good faith effort to resolve the parties' discovery dispute prior to seeking Board intervention. *See* Trademark Rule 2.120(e)(1) and 2.120(h)(1); TBMP §§ 523.02 and 524.02 (2015).

"The purpose of discovery is to advance the case by requiring parties to share certain relevant information upon request, so that the issues for trial may be focused and the case may proceed in an orderly manner within reasonable time constraints." *The Phillies v. Phila. Consol. Holding Corp.*, 107 USPQ2d 2149, 2152 (TTAB 2013). In serving

requests for admission, a party asks its adversary to stipulate to certain matters as a means of reducing issues for trial. *Id.*; see TBMP § 407.02. An admission in response to a request for admission “conclusively establishe[s]” the matter that is the subject of that request while a denial in response to a request for admission is merely a refusal to stipulate to certain matter, thus leaving that matter to be resolved on the merits. Fed. R. Civ. P. 36(b); *The Phillis*, 107 USPQ2d at 2152 (citing *Sinclair Oil Corp. v. Kendrick*, 85 USPQ2d 1032, 1036 n.8 (TTAB 2007)). A motion to test the sufficiency of responses to admission requests is solely a test of the legal sufficiency of those responses. See Fed. R. Civ. P. 36(a); Trademark Rule 2.120(h). Disagreements regarding the veracity of such responses are matters to be determined at trial and are not properly the subject of a motion to test their sufficiency. See *National Semiconductor Corp. v. Ramtron Int’l Corp.*, 265 F.Supp.2d 71 (D.D.C. 2003). Generally, if there is an admission or denial, the Board will not find the response to be insufficient even if the responding party included an explanation or clarification of the admission or denial, or admitted after first denying. See TBMP § 524.01.

If the Board, upon motion to test the sufficiency of a response to a request for admission, determines that an answer does not comply with the requirements of Fed. R. Civ. P. 36(a), it may order either that the matter is deemed admitted, or that an amended answer be served. See TBMP § 524.01. Pursuant to Fed. R. Civ. P. 36(a)(4), “[i]f a matter is not admitted, the answer must specifically deny it or state in detail why the answering party cannot truthfully admit or deny it.” Further, Fed. R. Civ. P. 36(a)(4) allows an answering party to “assert lack of knowledge or information as a reason for failing to

admit or deny” if that party states that it has made a “reasonable inquiry and that the information it knows or can readily obtain is insufficient to enable it to admit or deny.”

Applicant seeks an order directing Opposer to fully respond to Request Nos. 72-78, 81-82, 84, 91, 93, 95-96, 99-100, 105-113, 115-122, 124, 131-133, 135-139, 141-142, 149-150, 156-160, 166-167, 169-171, and 177-178. In response to these requests, Opposer specifically objected on the basis that the requests are, *inter alia*, “irrelevant and inadmissible”; that the requests are “not germane to this proceeding”; that with respect to certain third party marks, the marks have been abandoned;¹ that Opposer’s “subjective beliefs at some point in the distant past is not germane to this proceeding”; and/or that the requests call for a “legal conclusion.”²

Upon review of the responses Opposer provided, inasmuch as they set forth neither an admission nor a denial, and inasmuch as the contents of the responses do not substitute for an admission or denial, do not detail a reason for an inability to truthfully admit or deny, and do not assert lack of knowledge or information supported by the required statement regarding reasonable inquiry, the responses are insufficient.

In view thereof, Opposer is directed to serve a supplemental response, which specifically admits or denies the request or details a reason for an inability to admit or deny, to Requests for Admission Nos. 72-78, 81-82, 84, 91, 93, 95-96, 99-100, 105-113, 115-122, 124, 131-133, 135-139, 141-142, 149-150, 156-160, 166-167, 169-171, and 177-

¹ Information concerning a party’s awareness of third-party use and/or registration of the same or similar marks for the same or closely related goods or services as an involved mark, is discoverable. *See* TBMP § 414(9) and cases cited therein.

² A request for discovery is not necessarily objectionable merely because it requires a party or a witness to give an opinion or contention that relates to fact or the application of law to fact. *See* TBMP § 414(21) and cases cited therein.

178. Opposer is allowed **fifteen (15) days** from the date of this order to provide Applicant with its supplemental responses as noted herein. In the event of Opposer's failure to do so, the Board will entertain a timely motion for sanctions which may include judgment against Opposer, as appropriate. *See* Trademark Rule 2.120(g)(1).

As a final matter, "it is well settled that [Fed. R. Civ. P.] 36 which governs requests for admission], is not a discovery device. That is to say, the purpose of said rule is not to discover facts but rather to establish for the record facts of a peripheral nature which cannot reasonably be said to be in dispute, and thereby to avoid the expense and effort required to establish these facts at trial." *Mick v. Universal Oil Prods. Co.*, 180 USPQ 799, 800 (TTAB 1974); see also Fed. R. Civ. P. 36, Notes of Advisory Committee on Rules -- 1970 Amendment (recognizing that the purpose of requests for admission is "first, to facilitate proof with respect to issues that cannot be eliminated from the case, and secondly, to narrow the issues by eliminating those that can be."); TBMP § 407.02. The parties are warned to avoid using requests for admission as a substitute for discovery limiting the use of requests for admission to reduce issues for trial. The Board will not expend its limited resources to consider a motion concerning requests for admission on inconsequential matters that do not seek to narrow the issues for trial.

The parties are reminded that the Board may, upon final decision, preclude a party from introducing or relying on any requested or ordered information, documents, exhibits, things or materials which that party is determined to have impermissibly withheld in the course of discovery. *See Panda Travel, Inc. v. Resort Option Enterprises*,

Inc., 94 USPQ2d 1789 (TTAB 2009); *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715 (TTAB 2008); TBMP § 527.01(e).

Dates are reset as follows:³

30-day testimony period for plaintiff's testimony to close	March 10, 2016
Defendant/Counterclaim Plaintiff's Pretrial Disclosures	March 25, 2016
30-day testimony period for defendant and plaintiff in the counterclaim to close	May 9, 2016
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	May 24, 2016
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	July 8, 2016
Counterclaim Plaintiff's Rebuttal Disclosures Due	July 23, 2016
15-day rebuttal period for plaintiff in the counterclaim to close	August 22, 2016
Brief for plaintiff due	October 21, 2016
Brief for defendant and plaintiff in the counterclaim due	November 20, 2016
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	December 20, 2016
Reply brief, if any, for plaintiff in the counterclaim due	January 4, 2017

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. An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

³ The Board considers the filing of the motion to compel as tolling the dates. In view of the Board's order herein, the motion to extend dates filed October 30, 2015 is moot.