

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Mailed: April 14, 2015

Opposition No. 91218304

*Kosan Kozmetik Sanayi Ve Ticaret Anonim
Sirketi*

v.

Marcus Asam, Mirjam Asam, and Ruth Axel

**George C. Pologeorgis,
Interlocutory Attorney:**

On Tuesday, April 14, 2015 at 10:00 a.m. EDT, the Board, at the request of Applicants' counsel, held a telephone conference with counsel for each party regarding a discovery dispute between the parties.

During the telephone conference, Applicants maintained that, although Opposer responded to Applicant's document requests, Opposer has refused to specify which documents relate to specific document requests. Applicants argued that Opposer's document production is therefore insufficient and thus request that the Board order Opposer to identify (by the bates numbers affixed to each document) which documents Opposer contends are responsive to each specific document request.¹

¹ The Board construes Applicants' request as a motion to compel proper production of documents responsive to their document requests.

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Opposer argued that its document production was proper because the documents were produced on Applicants “as they are kept in the usual course of business” and, therefore, is in compliance with Fed. R. Civ. P. 34(b).

Decision

Under Fed. R. Civ. P. 34(b)(2)(E)(i), a party has two options to respond to a request for documents. The party can “produce documents as they are kept in the usual course of business *or* must organize and label them to correspond to the categories in the request.” Fed. R. Civ. P. 34(b)(2)(E)(i) (emphasis added). The provision authorizing production in accordance with the second option was added to Rule 34(b) to prevent parties from “deliberately ... mix[ing] critical documents with others in the hope of obscuring significance.” *See* Advisory Committee Note for 1980 Amendment to Rule 34 (quoting Report of the Special Committee for the Study of Discovery Abuse, Section of Litigation of the American Bar Association (1977)).

A party who elects to produce documents as they are kept in the usual course of business bears the burden of proving that the documents were in fact produced in that manner. *Pass & Seymour, Inc. v. Hubbell Inc.*, 255 F.R.D. 331, 334 (N.D.N.Y.2008) (citing *Johnson v. Kraft Foods North America, Inc.*, 236 F.R.D. 535, 540 (D.Kan.2006); *Cardenas v. Dorel Juvenile Group, Inc.*, 230 F.R.D. 611, 618 (D.Kan.2005)). “To carry this burden, a party must do more than merely represent to the court and the requesting party that the documents have been produced as they are maintained.” *Id.* (citing *Johnson*, 236 F.R.D. at 540–41; *Cardenas* 230 F.R.D. at 618). Indeed, when a party chooses to produce documents as they are

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kept in the usual course of business, Rule 34 “contemplates that [the responding] party ... disclose information to the requesting party regarding how the documents are organized in the [responding] party's ordinary course of business.” *Pass & Seymour*, 255 F.R.D. at 335. Such information should include where the documents were maintained, the identity of the custodian of the documents, and whether the documents were from a single source or multiple sources or files. See *Johnson*, *supra*, 236 F.R.D. at 541.

During the telephone conference, the parties advised that Applicants propounded 54 document requests on Opposer. Opposer’s counsel advised that it timely produced 84 responsive documents to Applicants’ document requests on March 8, 2015. Opposer’s counsel further stated during the telephone conference that he advised Applicants’ counsel via email (but only after the document production was made) that the responsive documents were produced as they are maintained in the usual course of Opposer’s business.

Upon careful review of the circumstances of this case and the information now provided by the parties during the telephone conference, the Board finds that Opposer has failed to provide any information about the manner in which the referenced documents were produced, i.e., where these documents were maintained or who maintained them and whether the documents came from one single source or file or from multiple sources or files. Indeed, Opposer merely stated that it produced responsive documents as they are kept in Opposer’s usual course of business. However, as noted above, merely representing to the Board and to

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Applicants that responsive documents have been produced as they are maintained is insufficient without a showing on how the documents are organized in Opposer's ordinary course of business.

In light of the foregoing, the Board finds that Opposer has not met its burden to establish that it produced these documents "as they are kept in the usual course of business." As the documents have already been provided, the Board finds that the most appropriate remedy is to require Opposer to identify by Bates number which documents are responsive to each request.

Accordingly, Applicants' construed motion to compel is **GRANTED** to the extent that Opposer is allowed until **April 24, 2015** to serve amended discovery responses to Applicants' document requests by identifying by Bates stamp number which documents are responsive to which requests.²

Trial Schedule

Trial dates remain as set forth in the Board's September 11, 2014, institution order.

² If Opposer fails to comply with this order, Applicants' remedy lies in a motion for sanctions, pursuant to Trademark Rule 2.120(g)(1). Furthermore, the parties are reminded that a party that has responded to a discovery request has a duty to supplement or correct that response. *See* Fed. R. Civ. P. 26(e).