

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

DUNN

Mailed: July 24, 2018

Opposition No. 91226340

American Council on Exercise

v.

William John Martin

Elizabeth A. Dunn, Attorney (571-272-4267):

This case comes up on Opposer's motion filed January 19, 2018 to compel Applicant, acting pro se, to produce supplemental responses to discovery requests.¹ As noted in the Board's last order, based on his failure to comply with the Board's rules, Applicant's response to the motion will be given no consideration. However, inasmuch as the motion has not been conceded, the Board exercises its discretion and addresses the motion on the merits.

¹ On the same date Opposer filed a motion to amend the notice of opposition to clarify one of the numbered allegations supporting its claim that Applicant lacked a bona fide intent to use. No opposition thereto having been submitted by Applicant, the motion to amend is granted. The second amended notice of opposition (23 TTABVUE 10- 16) is accepted as the operative pleading.

In view of the minor amendment, the Board will not require a new answer, and Applicant's answer to the first amended notice of opposition (18 TTABVUE 1-8) remains operative. However, if he wishes to file a new answer responding to the second amended notice of opposition, Applicant is ordered to do so within TWENTY DAYS of the mailing date of this order.

BACKGROUND

Applicant seeks registration pursuant to Trademark Act Sec. 1(b) for the mark ACE PATHWAY for “bottled water; drinking water”, and Opposer filed a notice of opposition contending that registration should be refused on the grounds that Applicant lacks a bona fide intent to use the mark with the goods, that there is a likelihood of confusion with, and dilution of, Opposer’s five pleaded registrations including the term ACE for goods and services in the area of health and fitness.

On November 27, 2017, Applicant served his responses to Opposer’s eight interrogatories and twenty seven document requests. On December 4, 15, 17, 27 and 28, 2017, the parties conferred by phone on the alleged deficiencies of Applicant’s responses. Opposer conducted the deposition of Applicant on January 3, 2018.

OPPOSER’S MOTION TO COMPEL

As a preliminary matter the Board notes with disapproval Opposer’s failure to provide Applicant with written notice of the alleged deficiencies of his discovery responses, and Opposer’s related failure to enumerate the contested responses in its motion to the Board. There appears to be no dispute regarding Applicant’s responses to the interrogatories. To the extent that the Board ascertained this by reading the requests and responses, this is a waste of the Board’s time which would have been avoided if Opposer supported its motion by including copies ONLY of the disputed discovery requests. *See* Trademark Rule 2.120(f)(1).

In addition, Opposer seeks an order to compel Applicant to reappear for deposition. However, the motion does not identify specific questions left unanswered

and indicate that a second deposition would be limited to those questions. In addition, the excerpts of testimony submitted with the motion generally relate to Applicant's failure to provide the requested documents. It is not clear why a second deposition would be necessary if Applicant complies with Board's order regarding written discovery. In sum, Opposer has not properly supported its motion to compel answers to deposition questions, and the requested remedy is overly broad. The motion to compel will be given no further consideration with respect to interrogatories or the deposition.

LEGAL STANDARD

Under Federal Rule of Civil Procedure 26(b) (1), parties "may obtain discovery regarding any nonprivileged matter that is relevant to any party's claim or defense and proportional to the needs of the case" 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). Information includes electronically-stored information and documents ("ESI"), such as email communications. *See Fed. R. Civ. P. 26(b)(2)(B); Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1905 (TTAB 2011)

Pursuant to Trademark Rule 2.120(f)(1), "If a party fails ... to answer any question propounded in a discovery deposition, or any interrogatory, or fails to produce and permit the inspection and copying of any document, electronically

stored information, or tangible thing, the party ... seeking discovery may file a motion to compel ... attendance at a deposition, or an answer, or production and an opportunity to inspect and copy. ...” The attorney-client privilege encourages disclosure from the client to the attorney with the assurance of nondisclosure. *The Goodyear Tire and Rubber Co. v. Uniroyal, Inc.*, 183 USPQ 372 (TTAB 1974). By definition, the attorney-client privilege is inapplicable to information held by a party who is not represented by counsel.

Information subject to the claim of attorney-client privilege is different from confidential information. Information subject to the claim of attorney-client privilege does not have to be produced in discovery. *See* Fed. R. Civ. P. 26(b)(5). Confidential information, even trade secrets, must be produced in discovery, but access to the information is restricted under the Board’s standard protective order. The requirement that confidential information has to be produced was explained at the discovery conference with Board, and is summarized in the Board’s April 28, 2017 order.

Discovery responses provided by the adverse party may be submitted as evidence by the requesting party under Trademark Rule 2.120(k)(3)(i). Responsive documents may be authenticated for the purposes of submission at trial by an admission or stipulation from the producing party. Trademark Rule 2.120(k)(3)(ii). A party obtaining the same information on its own has a more difficult time having the information admitted at trial. As a result, unless the responding party obtains a protective order on the ground that production would be unduly burdensome, the

responding party must produce requested and relevant non-privileged information, even if the information is available to the requesting party. The Board also notes that Applicant as well as Opposer rejected the Board's suggestion that the parties stipulate to use of the record in the prior opposition (No. 91203539). The parties agreed they would discuss methods to avoid unnecessary discovery requests, but this apparently was not the case. While the parties may agree to limit discovery, and are encouraged to do so, absent agreement, relevant and non-privileged information must be provided upon request.

With respect to Opposer's Document Request Nos. 1-15, 17-19, 21-27, Applicant impermissibly objects to responding to document requests and producing responsive documents on the grounds that the requested information is privileged, confidential, or already available to, or possessed by, Opposer. These objections are overruled.

DECISION

The motion to compel Applicant to produce new responses and all responsive documents as to Opposer's Document Request Nos. 1-15, 17-19, 21-27 without objection is GRANTED.

Accordingly, Applicant is directed to serve, within THIRTY DAYS of the date of this order, new responses and all responsive documents as to Opposer's Document Request Nos. 1-15, 17-19, 21-27.

Applicant must respond in full and without objection on the merits thereof. If Applicant has no responsive documents, this must be plainly stated. There is no need to describe responsive documents which are not in Applicant's possession.

Applicant may not limit his response by providing “an example” in lieu of what was requested.

In the event that Applicant fails to serve full responses as ordered herein, Opposer’s remedy may lie in a motion for sanctions, as appropriate. *See* Trademark Rule 2.120(h)(1); TBMP § 411.05.

PROCEEDINGS ARE RESUMED

Discovery Closes	8/31/2018
Plaintiff's Pretrial Disclosures Due	10/15/2018
Plaintiff's 30-day Trial Period Ends	11/29/2018
Defendant's Pretrial Disclosures Due	12/14/2018
Defendant's 30-day Trial Period Ends	1/28/2019
Plaintiff's Rebuttal Disclosures Due	2/12/2019
Plaintiff's 15-day Rebuttal Period Ends	3/14/2019
Plaintiff's Opening Brief Due	5/13/2019
Defendant's Brief Due	6/12/2019
Plaintiff's Reply Brief Due	6/27/2019
Request for Oral Hearing (optional) Due	7/7/2019

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.