

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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JK

October 2, 2018

Opposition No. 91228289

Padraic C. McFreen

v.

Mitac International Corp.

By the Board:

This proceeding is before the Board for consideration of Applicant's June 15, 2018 motion for discovery sanctions and to extend discovery. The motion is fully briefed.¹

Analysis

Trademark Rule 2.120(h)(1) provides, in pertinent part:

¹ Opposer's surreply (53 TTABVUE) has been given no consideration. Trademark Rule 2.127(a); TBMP § 502.02(b).

The Board notes Applicant's June 18, 2018 submission of confidential documents in connection with its motion for sanctions, and Opposer's June 19, 2018 response in the form of a motion for permission to correct the record. Neither party has exercised the appropriate care and due diligence that the Board expects in submitting filings with confidential content. The Board refers both parties to the required procedure for filing motions, briefs and materials that include information designated as confidential, as set forth in Trademark Rule 2.126(c) and TBMP §§ 412.04, and the parties shall note in particular the following: "A copy of the submission for public viewing with the confidential portions redacted must be submitted *concurrently*." A rule of reasonableness dictates what information should be redacted, and only in very rare instances should an entire submission be deemed confidential. TBMP §§ 412.02(d) and 703.01(p). Furthermore, Trademark Rule 2.116(g) provides that "[T]he Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party."

The Board suspended proceedings pending disposition of Applicant's motion for sanctions. Opposer's July 1, 2018 request for reconsideration was filed in violation of the suspension order and accordingly will be given no consideration.

If a party fails to ... comply with an order of the Trademark Trial and Appeal Board relating to disclosure or discovery, including a protective order, the Board may make any appropriate order, including those provided in Rule 37(b)(2) of the Federal Rules of Civil Procedure, ...

A motion for sanctions for failure to comply with an order of the Board lies only when the Board has entered an order relating to discovery (*i.e.*, an order compelling discovery or a protective order) and the order has been violated. TBMP §§ 411.05 and 527.01(a) (June 2018), and cases cited therein. The sanctions that may be entered by the Board include, *inter alia*, striking all or part of the pleadings of the disobedient party; refusing to allow the disobedient party to support or oppose designated claims or defenses; prohibiting the disobedient party from introducing designated matters in evidence; and entering judgment against the disobedient party. *Id.*

Applicant seeks an order sanctioning Opposer, arguing that Opposer failed to timely and properly respond to discovery, pointing specifically to Opposer's fourth amended responses, served June 13, 2018, to Applicant's first set of interrogatories. 45 TTABVUE 7. Applicant bases its motion on said responses insofar as they include invoices from 2013 through 2017, with Opposer's customers' names redacted. 45 TTABVUE 12-36. It argues the asserted belated nature of the responses, namely, that "to the extent they have been available throughout the course of these proceedings, Opposer long had a duty to produce said invoices" since June 5, 2017 when Applicant first requested sample invoices in Document Request No. 9, and since the Board's November 21, 2017 order granting Applicant's August 22, 2017 motion to compel (45 TTABVUE 2; 30 TTABVUE; 19 TTABVUE). Applicant further argues

that it is “entitled to Opposer’s customer’s names” that Opposer redacted in response to Applicant’s Interrogatory No. 2(b), which requests “[W]ith respect to each of Opposer’s Marks, identify the customer who purchased the goods.” 45 TTABVUE 3, 8. The related inquiry, Document Request No. 9, reads: “[A] sampling of invoices showing sales of each of Opposer’s Goods under each of Opposer’s Marks since the date of first use in commerce to the present.” 19 TTABVUE 29. Applicant points out that the interrogatory and document request were part of its earlier motion to compel. 45 TTABVUE 3. Applicant maintains that it “questions the authenticity of these invoices” and that “it should be entitled to Opposer’s customer’s (sic) names.” 45 TTABVUE 3. It argues that it has spent a year seeking discovery regarding Opposer’s alleged use of the mark on its goods in commerce, that Opposer is not acting in good faith and that the delay in producing the redacted invoices is an example of Opposer’s “obstructionist conduct.” 45 TTABVUE 4. Applicant also submits June 14, 2018 email communications with Opposer. 45 TTABVUE 4, 38-39. Applicant argues that “the only appropriate sanction should be dismissal,” (45 TTABVUE 2, 4), but seeks in the alternative that discovery be extended to allow it to conduct further discovery with respect to authenticating the invoices. 45 TTABVUE 2, 4.

Contesting the motion,² Opposer argues, *inter alia*, that Applicant is proposing that the Board apply a double-sanction for the same behavior for which it previously sanctioned Opposer, and that it is “too late for Applicant to raise a legitimate legal

² Without explanation, Opposer appears to have filed its brief twice. 46 TTABVUE, 47 TTABVUE. The Board has given consideration to and refers to 47 TTABVUE. Duplicate submissions should not be filed.

basis” for relief. 47 TTABVUE 3. Opposer further argues that the Board already dealt with the issue of customer identification, and that Applicant also produced invoices with redacted customer names and invoice numbers. 47 TTABVUE 6, 13-64. Opposer also maintains that Applicant made no attempt to coordinate discovery with Opposer between June 1 and June 15, 2018, and that Applicant did not communicate its concerns or coordinate with Opposer regarding Opposer’s time to serve responses. 47 TTABVUE 5.

Turning to the record, as the Board previously noted in its June 1, 2018 order,

Whereas the classes of customers for a party’s involved goods or services are discoverable, the names of customers, including dealers, constitute confidential information and generally are not discoverable, even under a protective order. TBMP § 414(3).

44 TTABVUE 5. In its reply brief (52 TTABVUE 2) Applicant relies on TBMP § 414(3) insofar as that provision further states:

However, the name of the first customer for a party’s involved goods or services sold under its involved mark, and, if there is a question of abandonment, the names of a minimal number of customers for the period in question, may be discoverable under protective order.

Applicant’s Interrogatory No. 2(b) is reasonably read to seek the identity of the customer(s) who purchased the goods on *the date of first use* of Opposer’s mark in commerce, and the specific good(s) on which the mark was first used, and Document Request No. 9 seeks a sampling of invoices showing sales of each of Opposer’s goods under each of Opposer’s marks since *the date of first use in commerce* to the present (emphasis added). To the extent that the discovery seeks the names of the first customer(s) for each of Opposer’s goods sold under Opposer’s mark, this is

discoverable. A party usually is required to furnish the name and address of its first customer(s) in order to verify its claimed date of first use. *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988). However, names of customers “to the present” is not discoverable. Applicant has not set forth abandonment as a defense in which it articulates a period in question during which it alleges that Opposer ceased use of his mark. Thus, Applicant, having not identified a period in question, similarly is not entitled to “the names of a minimal number of customers for the period in question.” On this record, Opposer’s redaction of the names of customers on the invoices that he does not offer to shown his *first use of his mark in commerce on his goods* is not sanctionable conduct.

Notwithstanding, Fed. R. Civ. P. 26(e)(1) firmly charges parties with a duty to supplement their discovery responses. TBMP § 408.03. If Opposer has not already done so, Opposer is expected to serve a supplemental production, unredacted and under the protective order, providing the discoverable information sought - the name of the first customer for each of his goods sold under his mark - in order to verify or assist in verifying his claimed date of first use of its mark in commerce. TBMP § 414(3). Moreover, the Board takes notice that Opposer should have produced the invoices earlier, and has provided substantive information in an essentially piecemeal fashion in this proceeding, including information regarding the basic issue of his use of his asserted mark and his goods in commerce.

Also in support of the sanction of dismissal, Applicant posits that it is entitled to the customer names and invoice numbers in order to enable it to authenticate the

invoices themselves. However, Opposer's redaction of this information does not warrant the sanction of dismissal. The record does not support a finding that Opposer has willfully evaded its discovery obligations, and Applicant has not persuaded the Board that the harsh remedy of judgment is justified. Moreover, Opposer can properly authenticate the invoices by, for example, submitting an appropriate affidavit or declaration of an affiant who has firsthand knowledge of them, *e.g.* their identity, dates and contents. Indeed, Opposer would normally do so if he intends to rely on the documents for any purpose at trial.³

In view of these findings, Applicant's motion for the sanction of dismissal is **denied**.

Applicant has, however, demonstrated that its request in the alternative for a reasonable extension of the discovery period is warranted. Accordingly, the motion to extend is **granted as modified** to the extent that discovery is extended for 45 days. Dates are reset accordingly.

Schedule

Proceedings are resumed. Discovery and trial dates, are hereby reset as follows:

Discovery Closes [FOR APPLICANT]	11/13/2018
Plaintiff's Pretrial Disclosures Due	12/28/2018
Plaintiff's 30-day Trial Period Ends	2/11/2019
Defendant's Pretrial Disclosures Due	2/26/2019
Defendant's 30-day Trial Period Ends	4/12/2019
Plaintiff's Rebuttal Disclosures Due	4/27/2019

³ To reiterate what the Board stated in a previous order, Opposer bears the burden of proof at trial. Opposer would presumably rely, at least in part, on the invoices and related documentation to prove his first use of the mark on commerce in order to establish priority, a necessary element of the likelihood of confusion claim under Trademark Act Section 2(d).

Plaintiff's 15-day Rebuttal Period Ends	5/27/2019
Plaintiff's Opening Brief Due	7/26/2019
Defendant's Brief Due	8/25/2019
Plaintiff's Reply Brief Due	9/9/2019
Request for Oral Hearing (optional) Due	9/19/2019

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).