

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
General Email: TTABInfo@uspto.gov

LTS

January 13, 2021

Opposition No. 91234539 (Parent)

Birds Eye Foods LLC

v.

Del Rio Vineyards, LLC

Opposition No. 91235518

Birds Eye Foods LLC

v.

Robert Wallace DBA Del Rio Vineyards, LLC

Lawrence T. Stanley, Jr., Interlocutory Attorney:

Now before the Board is Opposer's motion, filed September 16, 2020, to compel Applicant's further discovery responses and document production in Opposition No. 91235518 ("the '518 Opposition"). The motion to compel is fully briefed.¹

The Board has carefully considered all of the parties' arguments, presumes the parties' familiarity with the bases for their filings, and does not recount the facts or

¹ The parties in the '518 Opposition are also parties to Opposition No. 91234539 ("the '539 Opposition"). On December 4, 2020, the Board denied Applicant's motion for summary judgment in that proceeding and suspended the proceeding pending resolution of Opposer's motion to compel in the '518 Opposition so that the Board may consider whether consolidation of the '539 and '518 Oppositions is appropriate. '539 Opposition, 65 TTABVUE 9. The Board addresses consolidation of the proceedings *infra* at 11-13.

arguments here except as necessary to explain this decision. *See Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

I. Motion to Compel in the '518 Opposition

A. Background

On December 17, 2019, Opposer served its First Set of Requests for Production, First Set of Interrogatories, and First Set of Requests for Admissions (collectively, “Opposer’s Discovery Requests”). ’518 Opposition, 49 TTABVUE 14. On January 15, 2020, Applicant requested an extension of time to respond to Opposer’s Discovery Requests from January 16, 2020 to February 10, 2020. *Id.* at 16. Opposer consented to the extension request. *Id.* at 5. Over the next several weeks, the parties exchanged a settlement proposal and counter-proposal, and during this time the parties mutually consented to the extension of discovery and other Board deadlines in an effort to work towards settlement. *Id.* On February 14, 2020, Applicant requested an extension of time to March 16, 2020 to respond to Opposer’s Discovery Requests. *Id.* at 19. Opposer consented to the extension request. *Id.* at 5. On March 26, 2020, Applicant served its responses to Opposer’s Discovery Requests. *Id.* at 20-56.

For the next several months, the parties conferred with their respective clients regarding proposed additions and revisions to the parties proposed settlement terms. *Id.* at 5-6. On May 5, 2020, Applicant and Opposer held a telephone conference regarding the status of the matter and the need to produce documents in the event settlement talks could not be concluded. *Id.* at 6. Later the same day, Opposer sent a letter memorializing that it would produce documents within a week and requesting Applicant’s document production as soon as possible. *Id.* at 58.

Over the next several months, the parties continued discussing settlement and exchanging proposed settlement terms. *Id.* at 6. On September 1, 2020, Opposer sent Applicant a request to extend Board deadlines while Opposer reviewed and considered Applicant’s proposed settlement terms. *Id.* On September 10, 2020, Applicant declined to consent to further extensions of pending deadlines, notwithstanding the parties’ ongoing settlement discussions and efforts to finalize a written agreement. *Id.* On September 11, 2020, Opposer provided its comments and proposed revisions to the latest draft of the settlement agreement. *Id.* On Saturday, September 12, 2020, Opposer sent a letter identifying purported deficiencies in Applicant’s responses to Opposer’s Discovery Requests and requesting Applicant’s document production and supplemental written responses to Opposer’s Discovery Requests by Tuesday, September 15, 2020. *Id.* at 60-62.

Without any further communication between the parties, Opposer filed the current motion to compel on September 16, 2020. In the motion, Opposer asks the Board to compel Applicant to: (1) “produce documents in response to Requests Nos. 2, 3, 4, 5, 6, 7, 8, 10, 11, 12, 13, 14, 16, 17, 19, 20, 21, 22, 23, 24, and 30” (’518 Opposition, 49 TTABVUE 8); (2) “supplement[] and/or amend[]” Applicant’s responses to Request for Production Nos. 9, 15, 18, 25, 27, 28 and 29 (*id.*); (3) “full[y] answer[]” Interrogatory Nos. 1, 2, 6, 7, 9, 16, 20, 22, 24, 25, 28, 29 and 30 (*id.*); and (4) provide a sufficient response to Request for Admission No. 8 (*id.*).

B. Good Faith Effort

Trademark Rule 2.120(f)(1) requires that a motion to compel discovery “must be supported by a showing from the moving party that such party or the attorney

therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion but the parties were unable to resolve their differences.” *See, e.g., Hot Tamale Mama...and More, LLC v. SF Invs., Inc.*, 110 USPQ2d 1080, 1081 (TTAB 2014); *see also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 523.02 (2020). Based on Opposer’s own accounting of its good faith efforts and the parties’ correspondences relating thereto, the Board finds that Opposer has not discharged its obligation to make a good faith effort to resolve the issues raised in its motion prior to seeking Board intervention.

A party seeking discovery has a duty to contact the adverse party to ascertain why it has received incomplete or insufficient responses to its discovery requests and to determine whether the matter can be resolved amicably. *See Hot Tamale Mama*, 110 USPQ2d at 1081 (*citing MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 954 (TTAB 1979)). “The purpose of the conference requirement is to promote a **frank exchange between counsel** to resolve issues by agreement or to at least narrow and focus the matters in controversy before judicial resolution is sought.” *Amazon Techs. Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009) (emphasis in original) (quoting *Dondi Props. Corp. v. Commerce Sav. and Loan Ass’n*, 121 F.R.D. 284, 289 (N.D. Tex. 1988) (construing a local rule less demanding than Trademark Rule 2.120(f)(1))); *see also Hot Tamale Mama*, 10 USPQ2d at 1081 (quoting *Amazon Techs. Inc.*).

In this regard, the Board has stated that

[M]ere dissatisfaction with the adversary's answer to an initial inquiry, in itself, does not discharge the duty to undertake a good faith effort to resolve the dispute, particularly where the inquiring party has received no, minimal or incomplete substantive information in response to its initial inquiry. Rather, the point is to investigate the possibility of resolving the dispute. Although the reason why no discovery responses were served can be part — possibly an important part — of the discussion, it may be irrelevant to resolving the dispute in many cases. Regardless, the good faith efforts of the parties should be directed to understanding differences and actually investigating ways in which to resolve the dispute. Where it is apparent that the effort toward resolution is incomplete, establishing the good faith effort that is a prerequisite for a motion to compel necessitates that the inquiring party engage in additional effort toward ascertaining and resolving the substance of the dispute.

Hot Tamale Mama, 10 USPQ2d at 1081.

Here, that was not done. Although Opposer appears to have requested the status of Applicant's document production multiple times after Applicant served its responses to Opposer's Discovery Requests, the record shows that Opposer first identified alleged deficiencies with Applicant's written responses to Opposer's Discovery Requests in its letter dated Saturday, September 12, 2020, and Opposer requested a response two business days later, by September 15, 2020. When Opposer did not receive supplemental responses and document production by that deadline, it filed its motion to compel the next day.

Opposer essentially maintains that its good faith obligation was discharged by its document production status inquiries and single deficiency letter, and that any issue not addressed by Applicant to Opposer's satisfaction was ripe for Board adjudication.

The Board does not agree. Although a deficiency letter may be a good means to outline and frame the issues for a substantive meet and confer conference between the parties, “mere dissatisfaction with the adversary’s answer to an initial inquiry, in itself, does not discharge the duty to undertake a good faith effort to resolve the dispute” *Hot Tamale Mama*, 10 USPQ2d at 1081. Opposer should have sent a follow-up request when Applicant failed to respond by Opposer’s deadline (which was unreasonably short by any measure). *See id.* at 1082.

Furthermore, “it is generally the policy of the Board to intervene in disputes concerning discovery, by determining motions to compel, only where it is clear that the parties have in fact followed the aforesaid [meet and confer] process and have narrowed the amount of disputed requests for discovery, if any, down to a reasonable number.” *Sentrol, Inc. v. Sentex Sys., Inc.*, 231 USPQ 666, 667 (TTAB 1986). The fact that more than twenty discovery requests are at issue, by itself, indicates that the meet and confer requirement has not been satisfactorily discharged. *See Medtronic, Inc. v. Pacesetter Sys., Inc.*, 222 USPQ 80, 83 (TTAB 1984) (the nature and number of discovery requests at issue demonstrated that neither party engaged in discovery in good faith). Where the effort toward resolution is incomplete, establishing the good faith effort necessitates that the inquiring party engage in additional effort toward ascertaining and resolving the substance of the dispute. *Hot Tamale Mama*, 10 USPQ2d at 1081; *see also* TBMP § 523.02 (“In determining whether a good faith effort to resolve the discovery dispute has been made, the Board may consider, among other things ... whether attempts at resolution were incomplete”). Under these

circumstances, and given the number of discovery requests at issue, the meet and confer process required at least one telephone conference between the parties' counsel regarding all of the discovery matters in dispute. Such a telephone conference may have at least narrowed the amount of disputed requests to a reasonable number.

Under the circumstances, Opposer has failed to satisfy the good faith effort requirement of Trademark Rule 2.120(f)(1). Accordingly, Opposer's motion to compel is **denied without prejudice**.

It is the Board's belief that the parties' efforts to resolve their discovery dispute are incomplete, and that they should be able to resolve, or at least significantly narrow, the disputed issues. In addition to whatever additional written correspondence the parties may elect to exchange following this order, the Board expects the parties to confer by telephone as part of their efforts to resolve their discovery dispute. In the event that the parties are unable to fully resolve the issues in dispute, any new motion to compel must include a showing that the parties' attorneys conducted at least one telephone conference as part of their meet and confer efforts.

This is not to say, however, that Opposer must wait indefinitely for Applicant to participate in a meet and confer telephone conference. As discussed below, the parties are under an **equal** obligation both to cooperate in discovery and to meet and confer in good faith to resolve any discovery disputes. Therefore, if Applicant does not participate in a meet and confer telephone conference, and if Opposer files a new motion to compel, then in the motion Opposer should set forth its efforts to schedule and conduct the conference.

C. Discovery Guidelines

The Board cautions that Applicant should not interpret this order as approving of its objections and responses to Opposer's Discovery Requests. Applicant is reminded that each party and its attorney has a duty to make a good faith effort to satisfy the legitimate discovery needs of its adversary, and the Board expects parties and their attorneys to cooperate with one another in the disclosure and discovery process. *See Sentrol, Inc.*, 231 USPQ at 667; *Panda Travel Inc. v Resort Option Enters., Inc.*, 94 USPQ2d 1789, 1791 (TTAB 2009) ("Each party has a duty to make a good faith effort to satisfy the reasonable and appropriate discovery needs of its adversary."); *see also* TBMP § 408.01. Failure to cooperate saddles the Board with needless motions and burdens it with resolving disputes which should be resolved by the parties. *See Domond v 37.37, Inc.*, 113 USPQ2d 1264, 1265 (TTAB 2015); *Johnston Pump/General Valve Inc. v. Chromalloy Am. Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988).

Further, the parties are under an **equal** obligation to participate in good faith to resolve any discovery or to at least narrow and focus the matters in controversy before Board resolution is sought. *See, e.g., Amazon Techs. Inc.*, 93 USPQ2d at 1705 (quoting *Nevada Power Co. v. Monsanto Co.*, 151 F.R.D. 118, 120 (D. Nev. 1993)) ("In order for the meet and confer process to be meaningful and serve its intended purpose, 'the parties must present to each other the merits of their respective positions with the same candor, specificity, and support during informal negotiations as during the briefing of discovery motions.'").

To facilitate more productive communications between the parties, their respective counsel are ordered to review TBMP §§ 402 (scope of discovery); 405.04(b) (nature of responses to interrogatories), 406.04(c) (nature of responses to requests for documents), 407.03(b) (nature of responses to requests for admission), 408 (duties to cooperate, search records, and supplement), and 414 (selected discovery guidelines). Additionally, the parties are reminded of the following general discovery guidelines.

- Fed. R. Civ. P. 26(b) governs the scope of discovery, and provides that “[p]arties 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,” and that “[i]nformation within this scope of discovery need not be admissible in evidence to be discoverable.” The requirement of relevancy is generally construed liberally and discovery generously allowed unless it is clear that the information which is sought can have no possible bearing on the issues involved in the particular proceedings. *See, e.g., Varian Assocs. v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975); *Johnston Pump/General Valve*, 10 USPQ2d at 1675 (“[d]uring discovery, a party may seek not only testimony and exhibits which would be admissible evidence but also information that would be inadmissible at trial if the information appears reasonably calculated to lead to the discovery of admissible evidence.”). *See also* 8 Charles Alan Wright, et al., FED. PRAC. & PROC. CIV. § 2008 (3d ed. Oct. 2020 Update). In addition to the proportionality limitation of Fed. R. Civ. P. 26(b)(1), however, Fed. R. Civ. P. 26(b)(2)(C)(i) allows for limitations on discovery where such discovery is “unreasonably cumulative or duplicative, or can be obtained from another source that is more convenient, less burdensome, or less expensive.” *See Domond*, 113 USPQ2d at 1266. Accordingly, although Fed. R. Civ. P. 26 contemplates liberal discovery, the right to discovery is not unlimited. *Id.*
- In responding to interrogatories and document requests, boilerplate objections are not proper. Objections, if any, must be specifically asserted in response to each interrogatory or document request and the ground for objecting must be stated with specificity. Fed. R. Civ. P. 33(b)(4) and 34(b)(2)(B); *see also Medtronic, Inc. v. Pacesetter Sys., Inc.*, 222 USPQ 80, 83 (TTAB 1984). Additionally, responses to specific discovery requests that refer to and incorporate all of the responding party’s general objections are improper because they fail to specify which of the general objections, if any, are being asserted in response to a specific interrogatory or document

request, or why each general objection is applicable to each request.² *Id.* at 83 (answering party must articulate objections with particularity); *see also Amazon Techs., Inc.*, 93 USPQ2d at 1705-06 (“general objections” to interrogatories and document requests found to be “anything but specific”).

- “[I]t is incumbent upon a party who has been served with interrogatories to respond by articulating [its] objections (with particularity) to those interrogatories which [it] believes to be objectionable, and by providing the information sought in those interrogatories which [it] believes to be proper.” *See, Medtronic*, 222 USPQ at 83. The burden of persuasion is on the objecting party to show that the interrogatories should not be answered. *Id.* (citation omitted). *See also Volkswagenwerk Aktiengesellschaft v. MTD Prods. Inc.*, 181 USPQ 471, 472 (TTAB 1974); 8B Charles Alan Wright, et al., *FED. PRAC. & PROC. CIV.* § 2173 (3d ed. Oct. 2020 Update).
- In responding to each document request, a party must state whether or not it has responsive documents in its possession, custody or control and, if so, state that such documents will be produced or that such documents are being withheld, based on a claim of privilege or a specified objection. *Fed. R. Civ. P.* 34(b)(2)(C); *see also No Fear Inc.*, 54 USPQ2d at 1555. “The production must then be completed no later than the time for inspection specified in the request or another reasonable time specified in the response.” *Fed. R. Civ. P.* 34(b)(2)(B).
- If objection is made to only part of an item or category, the part must be specified. For example, with respect to the objection of undue burden, “[a]n objection may state that a request is overbroad, but if the objection recognizes that some part of the request is appropriate the objection should state the scope that is not overbroad.” *Fed. R. Civ. P.* 34(b)(2)(B), Advisory committee notes (2015 amendment).
- If the production of documents to any particular request is voluminous, the responding party may produce a representative sampling of documents. Such representative sampling, however, must be sufficient to meet the requesting party’s needs.
- An answer to a request for admission must admit the matter of which an admission is requested; deny the matter; or state in detail the reasons why the responding party cannot truthfully admit or deny the matter. *Fed. R. Civ. P.* 36(a)(4). A denial shall fairly meet the substance of the requested admission, and when good faith requires that a party qualify an answer or

² Ordinarily, a general objection is appropriate only when the objection relates to the discovery requests as a set, as opposed to an objection to the form of a specific request or the nature of the responsive information sought by a specific request.

deny only a part of the matter of which an admission is requested, the party must specify so much of it as is true and qualify or deny the remainder. *Id.* An answering party may not give lack of information or knowledge as a reason for failure to admit or deny unless the party states that the party has made reasonable inquiry and that the information known or readily obtainable by the party is insufficient to enable the party to admit or deny. *Id.* If the responding party objects to a request for admission, the reasons for objection must be stated. Fed. R. Civ. P. 36(a)(5).

- A party withholding responsive documents on the basis of a claim of privilege must “(i) expressly make the claim; and (ii) describe the nature of the documents, communications, or tangible things not produced or disclosed—and do so in a manner that, without revealing information itself privileged or protected, will enable other parties to assess the claim.” Fed. R. Civ. P. 26(b)(5)(A)(i)–(ii).

The parties are reminded of their ongoing duty to supplement or correct their discovery responses in a timely manner. *See* Fed. R. Civ. P. 26(e)(1). When a party fails to disclose information or amend or supplement a prior response, as required, it may, upon timely objection from the other party, be precluded from relying at trial upon information or documents that were properly sought, but not disclosed, during discovery, unless such failure to disclose “was substantially justified or is harmless.” Fed. R. Civ. P. 37(c)(1); *Panda Travel, Inc.*, 94 USPQ2d at 1791-92.

II. Proceedings Consolidated

When cases involving common questions of law or fact are pending before the Board, the Board may order consolidation of the cases. *See* Fed. R. Civ. P. 42(a) and TBMP § 511. *See Wis. Cheese Grp., LLC v. Comercializadora de Lacteos y Derivados, S.A. de C.V.*, 118 USPQ2d 1262, 1264 (TTAB 2016); *Venture Out Props. LLC v. Wynn Resorts Holding LLC*, 81 USPQ2d 1887, 1889 (TTAB 2007). In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense which may be gained from consolidation, against any prejudice or

inconvenience which may be caused thereby. *See World Hockey Ass'n v. Tudor Metal Prods. Corp.*, 185 USPQ 246, 248 (TTAB 1975); TBMP § 511.

Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative. *See, e.g., Wis. Cheese Grp., LLC*, 118 USPQ2d at 1264.

The parties to the '539 and '518 Oppositions are the same, and the involved marks, allegations, and claims are similar or identical. For these reasons, the Board finds that consolidation is appropriate. Accordingly, the '539 and '518 Oppositions are consolidated and may be presented on the same record and briefs. *See Hilson Research Inc. v. Soc'y for Human Res. Mgmt.*, 27 USPQ2d 1423, 1424 n.1 (TTAB 1993); *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1619 n.1 (TTAB 1989).

The Board file will be maintained in the '539 Opposition as the "parent case." As a general rule, from this point on, the parties should no longer file separate papers in connection with each proceeding, but file only a single copy of each paper in the parent case. Each paper filed should bear the numbers of all consolidated proceedings in ascending order.³

Despite being consolidated, each proceeding retains its separate character and requires entry of a separate judgment. The decision on the consolidated cases shall

³ The parties should promptly inform the Board of any other Board proceedings or related cases within the meaning of Fed. R. Civ. P. 42, so that the Board can consider whether further consolidation is appropriate.

take into account any differences in the issues raised by the respective pleadings; a copy of the decision shall be placed in each proceeding file. *See Dating DNA LLC v. Imagini Holdings Ltd.*, 94 USPQ2d 1889, 1893 (TTAB 2010).

III. Summary

Opposer's motion to compel discovery in the '518 Opposition is **denied without prejudice** as to its right to file a renewed motion to compel after it has discharged its duty to meet and confer with Applicant in good faith in accordance with Trademark Rule 2.120(f)(1) and consistent with this order and the guidelines provided above.

Upon consolidation, the Board generally will reset dates for the consolidated proceeding. When Applicant filed its motion for summary judgment in the '539 Opposition, approximately thirty days remained in the discovery period. Accordingly, the Board has reset the deadlines for the consolidated proceedings, starting with the close of discovery.

Proceedings are **resumed**, and remaining dates are reset as indicated in the schedule set forth below.

Discovery Closes	2/11/2021
Plaintiff's Pretrial Disclosures Due	3/28/2021
Plaintiff's 30-day Trial Period Ends	5/12/2021
Defendant's Pretrial Disclosures Due	5/27/2021
Defendant's 30-day Trial Period Ends	7/11/2021
Plaintiff's Rebuttal Disclosures Due	7/26/2021
Plaintiff's 15-day Rebuttal Period Ends	8/25/2021
Plaintiff's Opening Brief Due	10/24/2021
Defendant's Brief Due	11/23/2021

Plaintiff's Reply Brief Due	12/8/2021
Request for Oral Hearing (optional) Due	12/18/2021

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, matters in evidence, the manner and timing of taking testimony, 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).