

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](mailto:TTABInfo@uspto.gov)

JK

November 5, 2018

Opposition No. 91236165

*Vina Concha y Toro S.A.*

*v.*

*Citadel Trading Corp.*

**J. Krisp, Interlocutory Attorney:**

This proceeding is before the Board for consideration of Applicant's July 2, 2018 motion to compel discovery. The motion is fully briefed.<sup>1</sup>

This proceeding involves Applicant's application Serial No. 87254798, a Section 1(b) intent-to-use application to register the mark MYLIA (standard characters) for "sangria; wines" in International Class 33. Opposer opposes on the ground of likelihood of confusion pursuant to Trademark Act Section 2(d), pleading common law rights, and ownership of Registration No. 2917361 for the mark AMELIA for "wines and sparkling wines" in International Class 33.

**Analysis**

---

<sup>1</sup> The Board has considered the parties' briefs on the contested motion, but does not repeat or discuss all of the arguments and submissions, and does not address irrelevant arguments. *Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

Trademark Rule 2.120(f)(1) sets forth particular requirements for motions to compel. TBMP §§ 523.02 - 523.03 (June 2018). Applicant's motion is timely, and Applicant submitted a copy of the relevant discovery requests, as well as Opposer's responses and objections thereto. 9 TTABVUE 28. By way of the contents of emails of April through May, 2018, Applicant sufficiently demonstrates that it satisfied the requirement to make a good faith effort to resolve with Opposer the issues presented in the motion to compel prior to seeking the Board's intervention. 9 TTABVUE 38-59.

Furthermore, Applicant served the discovery requests at issue sufficiently early in the discovery period that Opposer's responses thereto were due no later than the close of discovery. Trademark Rule 2.120(a)(3); TBMP § 413.02; *Estudi Moline Dissey, S.L. v. BioUrn Inc.*, 123 USPQ2d 1268 (TTAB 2017). 9 TTABVUE 7-16. Moreover, the discovery requests are proportional to the claims and defenses in this proceeding. Fed. R. Civ. P. 26(b)(1); Trademark Rule 2.120(a)(1).

In its motion, Applicant seeks an order compelling Opposer to serve verified answers to Interrogatory Nos. 1, 6, 8, 13, 14 and 15; to produce all documents identified in the answer or referred to or relied upon in preparing answers to the interrogatories; to produce all documents referred to in Opposer's initial disclosures, and evidence of sales of Viña Concha y Toro wine sold under the AMELIA mark, evidence of marketing, advertising and promotion of Vina Concha y Toro wine sold under the AMELIA mark, and downloaded printouts of articles appearing on the

Internet. Opposer filed a brief in response, and in its reply brief Applicant maintains its motion with respect to Interrogatory Nos. 8, 14 and 15. 11 TTABVUE 4.

Trademark Rule 2.120(f)(1) directs movants to inform the Board if any issues raised in the motion are subsequently resolved. Thus, the Board construes the reply brief as indicating that the issues regarding Interrogatory Nos. 1, 6 and 13 no longer require adjudication.

Applicant's motion is devoid of substantive content in support of the relief it requests regarding its interrogatories. The motion consists of a timeline account of deadlines and efforts taken to resolve the dispute. However, instead of setting forth its points and authorities, and substantive arguments explaining the basis for its motion - perceived inadequacies in Opposer's responses and objections - Applicant refers the Board to its pre-motion communications between counsels, as in the following:

As part of Applicant's good faith effort to resolve the discovery issues, on April 30, Applicant's counsel forwarded to Opposer's counsel details of the inadequacies in Opposer's responses to Applicant's discovery requests. (Exhibit H, attached).

On May 10, 2018 Applicant's counsel forwarded a further email regarding document production and referencing two telephone calls to Opposer's counsel made as part of its good faith effort to resolve the discovery issues. (Exhibit I, attached).

9 TTABVUE 4, 44-47. Although inclusion of the exhibits – here, April 30, 2018 and May 10, 2018 emails sent to Opposer's counsel – is proper, Applicant's reliance on them in full to set forth its substantive arguments is contrary to the Board's expectation that all arguments shall be set forth in a motion and accompanying brief.

The better practice would have been for Applicant to fully explain its position, and support therefor, within its brief. The Board expects parties to fully set forth therein their points, authorities and arguments, and to avoid filings of a piecemeal nature that result in a party's arguments not being in one document, that unnecessarily burden the Board, and that complicate the record. A party abandons the preferred and ordinary practice at its peril, particularly in view of the several requirements of Trademark Rules 2.126 and 2.127 (*e.g.*, the page limits set forth in Trademark Rule 2.127(a)).<sup>2</sup>

Nevertheless, to the extent that the Board can gather Applicant's substantive arguments from its pre-motion emails and other exhibits, the Board has given them consideration in support of the motion. Thus, the Board turns to the merits of Applicant's motion.

*Interrogatories*

*Interrogatory No. 8:* Summarize the substance of Italo Jofré's knowledge relating to the promotion and distribution of wines under Opposer's Marks in the United States.

*Response:* Mr. Italo Jofré has been the Fine Wine Export Manager of Viña Concha y Toro S.A. since at least 2008 and has knowledge of the promotion and distribution of wines under Opposer's Marks in the United States during the relevant reasonable period.

In its pre-motion email, Applicant indicated to Opposer that the response does not include a summary of the substance of Mr. Jofre's knowledge. 9 TTABVue 44. Contesting the motion, Opposer merely restated that "[A]pplicant has been advised"

---

<sup>2</sup> Furthermore, the Board will not undertake the task of ascertaining the parties' respective arguments for them. If a party believes its position to be sound and supportable, it should be willing to explain its position in a motion for relief.

of Mr. Jofre's position and that he "has knowledge of the promotion and distribution of wines under Opposer's Marks in the United States." 10 TTABVUE 3. Thus, Opposer essentially repeats its response.

Opposer's response is insufficient in that it does not set forth any substantive information detailing or further describing Mr. Jofre's knowledge. The record shows that this is an individual whom Opposer identified in its initial disclosures as likely to have discoverable information to support Opposer's claims, though no actual information is provided in response to the interrogatory. Opposer's response is obfuscating at best. Applicant is entitled to probe the specifics of the disclosed individual's knowledge. To allow Opposer, during discovery, to merely stand on what is essentially a restatement of the initial disclosure would be incongruous with the purpose of discovery. In view of these findings, Applicant's motion is **granted**.

*Interrogatory No. 14:* Set forth the actual gross wholesale and retail sales, by month and year, of of (sic) Opposer's wines other than those sold under Opposer's Marks in the United States for each year since 2010 and identify all documents related thereto.

*Response:* Opposer objects to this Interrogatory on the grounds that it is irrelevant, overbroad, ambiguous, unduly burdensome in that it seeks "all" documents and is not restricted to the U.S., seeks to discover facts or information outside the possession and control of the Opposer and not reasonably calculated to disclose relevant information.

In its pre-motion email, Applicant appears to have indicated to Opposer that the information sought would be in the hands of Opposer's distributor, and contained in the export and production records of Italo Jofré. With respect to relevance, Applicant noted that in Paragraph No. 1 of the notice of opposition, Opposer alleged: "Opposer is America's largest exporter of wine from Chile." 9 TTABVUE 44; 1 TTABVUE 3.

Applicant contended that it “is clearly entitled to discovery which could refute” this allegation in Opposer’s notice of opposition. 9 TTABVUE 44.

In its motion, Applicant provided no explanation, such as an actual nexus between gross wholesale and retail sales of Opposer’s wines other than those sold under Opposer’s marks in the United States, and Opposer’s claim to be the largest importer of wine from Chile. As the Board notes above, the motion is substantively sparse. Nonetheless, it is apparent that Applicant is entitled to discovery that could test and refute Opposer’s allegation regarding Opposer’s size and overall wine business, which it elected to make generally relevant by way of its pleading. Finally, Opposer entirely failed to substantiate its objection that the interrogatory is overbroad, ambiguous and unduly burdensome, and contesting the motion it merely repeated the objection. 10 TTABVUE 4. In view of these findings, Applicant’s motion is **granted**.

*Interrogatory No. 15:* Identify all negative comments relating to Opposer’s wines from wine rating entities, publications, consumers, retailers and distributors.

*Response:* Opposer objects to this Interrogatory on the grounds that it is irrelevant, overbroad, ambiguous and unduly burdensome, not restricted to the U.S. and seeks to discover facts or information outside the possession and control of the Opposer and not reasonably calculated to disclose relevant information.

In its pre-motion email, Applicant merely stated that this information is relevant to the allegations of paragraphs 3, 4, 7, 8, 9 of the notice of opposition, and Opposer’s reputation referred to in paragraph 14. 9 TTABVUE 44-45. For its part, Opposer states that it “has produced documents relating to all reviews and ratings in its possession and control,” (10 TTABVUE 4); however, the record does not reflect that

Opposer appropriately identified the documents, if any, that it believes are responsive to this specific interrogatory. Moreover, Opposer failed to substantiate its objections that the interrogatory is irrelevant, overbroad, ambiguous and unduly burdensome.

In view of the allegations in the notice of opposition, Applicant is entitled to the discovery, which, again, Opposer made relevant by way of the allegations in its pleading. In view thereof, Applicant's motion is **granted**.

*Requests for Production of Documents*

In its motion, Applicant states that counsel received Opposer's production on May 22, 2018, comprising 1032 numbered images, without any indication as to the document request to which each pertains. It further states: "[M]any images were duplicate copies of photographs of unknown and unidentified people as well as duplicate images of wine bottles and documents in a foreign language which apparently were intended for use in foreign countries." 9 TTABVUE 4-5. In the pre-motion emails, counsel also mentioned the deficiencies.

Contesting the motion, Opposer states that it has produced all responsive documents in its possession and control. 10 TTABVUE 3. It does not otherwise refute Applicant's assertion that Opposer failed to designate which documents it believes to be responsive to which interrogatory(ies) or document request(s).

Based on this record, which does not include any arguments or exhibits from which the Board can conclude that Opposer's production was sufficient, or that its objections were in compliance with Fed. R. Civ. P. 34(b)(2)(C)<sup>3</sup>, Applicant's motion is **granted**.

Among other things, Opposer is obligated to identify all produced documents, such as by Bates stamping if it has not previously done so, and to designate which specific documents in its production are responsive to which interrogatory(ies) or document request(s). Fed. R. Civ. P. 33(d); *Jain v. Ramparts, Inc.*, 49 USPQ2d 1429, 1435 (TTAB 1998)

In summary, Applicant's motion to compel is **granted**. Opposer is allowed until **twenty days from the date of this order** to serve 1) verified supplemental responses to Interrogatory Nos. 8, 14 and 15; 2) verified responses or supplemental responses, as appropriate, to all other interrogatories in response to which its previously-served responses were not verified; and 3) a document production in response to the document requests served on Opposer on February 1, 2018 (9 TTABVUE 15-16), said document production being in compliance with Fed. R. Civ. P. 34(b) in all respects.

In the event that Opposer fails to serve responses as directed herein, Applicant's remedy lies in a motion for sanctions, as appropriate, pursuant to Trademark Rule 2.120(h)(1). Under certain circumstances, a party may be barred by its own objections or responses from later introducing the information sought in the request as part of

---

<sup>3</sup> The Rule states: "An objection must state whether any responsive materials are being withheld on the basis of that objection. An objection to part of a request must specify the part and permit inspection of the rest."

its evidence on the case. Similarly, a party that fails to provide information, or provides an untimely supplement, may be precluded from using that information or witness at trial. Fed. R. Civ. P. 37(b)(2); TBMP § 527.01(e), and cases cited therein. The application of the preclusion sanction, lies within the Board's discretion. *Midwestern Pet Foods Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1439 (Fed. Cir. 2012).

### **Schedule**

Proceedings are deemed suspended as of July 2, 2018, and are now resumed.

Discovery and trial dates are reset as indicated below:

Discovery Closes	12/17/2018
Plaintiff's Pretrial Disclosures Due	1/31/2019
Plaintiff's 30-day Trial Period Ends	3/17/2019
Defendant's Pretrial Disclosures Due	4/1/2019
Defendant's 30-day Trial Period Ends	5/16/2019
Plaintiff's Rebuttal Disclosures Due	5/31/2019
Plaintiff's 15-day Rebuttal Period Ends	6/30/2019
Plaintiff's Opening Brief Due	8/29/2019
Defendant's Brief Due	9/28/2019
Plaintiff's Reply Brief Due	10/13/2019
Request for Oral Hearing (optional) Due	10/23/2019

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

Opposition No. 91236165

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).