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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91240594
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Application Serial No.: 87/428,224

Filed: April 27, 2017

For the mark:



GROWMARK, Inc.,)
)
)
 Opposer,)
 v.)
)
First State Bank of Middlebury,)
)
)
 Applicant.)

Opposition No: 91240594

Opposer's File No.: M270416

Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

GROWMARK'S OPPOSITION TO APPLICANT'S MOTION TO COMPEL DISCOVERY

Opposer and Counterclaim Defendant GROWMARK, Inc. ("Opposer" or "GROWMARK"), by and through its attorneys, Dorsey & Whitney LLP, hereby submits its Opposition to the Motion to Compel filed by Applicant and Counterclaim Plaintiff First State Bank of Middlebury. ("Applicant").

I. Factual Background and Procedural History

GROWMARK filed its Notice of Opposition to Applicant's purported registration of the FS|B Design Mark on April 11, 2018 (TTABVUE 1). The basis of the Opposition is that Applicant's mark is highly similar to GROWMARK's FS (Reg. No. 5360625) and FS AGRI-FINANCE (Reg. No. 2371319) marks (which also have priority), and thus poses a significant likelihood of confusion.

On May 18, 2018, Applicant filed a counterclaim for partial cancellation of GROWMARK's marks (TTABVUE 4), which GROWMARK duly answered on July 5, 2018 (TTABVUE 6). Applicant filed the instant Motion to Compel Discovery on January 17, 2019 (TTABVUE 9). The parties subsequently agreed to extend GROWMARK's time to file an opposition to the motion by thirty days on February 4, 2019, and GROWMARK filed a consented motion to that effect the same day (TTABVUE 10). The Board issued a ruling on February 28, 2019, providing GROWMARK ten days to file its opposition. Because ten days from the ruling – March 10 – fell on a Sunday, this Opposition is timely pursuant to 35 U.S.C. § 21(b) (“When the day, or the last day, for taking any action . . . in the United States Patent and Trademark Office falls on Saturday, Sunday, or a federal holiday within the District of Columbia, the action may be taken . . . on the next succeeding secular or business day.”); *see also* Trademark Board Manual of Procedure (“TBMP”) § 112 (“For example, if, as set by the Board, an answer to a complaint falls due on a Saturday, Sunday, or federal holiday within the District of Columbia, an answer filed on the next business day will be considered timely.”).

The parties exchanged discovery in the late Summer of 2018 and subsequently met and conferred regarding discovery responses concerning a number of topics. GROWMARK has produced over 200 documents to date in response to 34 various document production requests, and has responded to 26 Interrogatories. The instant motion concerns two document discovery requests and several interrogatories that are grossly over burdensome and essentially constitute a fishing expedition by Applicant. For the reasons set forth herein, GROWMARK's objections to the discovery at issue are proper and Applicant's motion should be denied in its entirety.

II. Argument

A. The Requests for Production are plainly Overbroad and are not Calculated to lead to the Discovery of Admissible Evidence

Applicant's Request for Production No. 19 seeks “[a]ll documents and things evidencing or referring to any contract, license, agreement, litigation or opposition between GROWMARK

and any third party regarding or involving GROWMARK's FS Marks." Similarly, Applicant's Request for Production No. 32 seeks "[a]ll documents and things commenting on infringement or potential infringement, of GROWMARK's FS Marks or FSB's FS B & Design trademark." GROWMARK objected to these requests as being overbroad, unduly burdensome and expensive, and not reasonably calculated to lead to the discovery of admissible evidence. GROWMARK further pointed out that requests were particularly overburdensome due to the lack of any temporal limitation in light of GROWMARK's fifty-year plus business existence and use of the marks at issue. In meet and confer correspondence, GROWMARK further asked Applicant to articulate how such information is relevant to the instant proceeding between GROWMARK and Applicant. Applicant asserts, in conclusory fashion, that the requested material would shed light on GROWMARK's "control" over the usages of the marks and is thus somehow "relevant to validity of the asserted marks." (TTABVUE 10, p. 6). This argument must be rejected.

First, the Board's guidance provides that information regarding a "party's awareness of third-party use and/or registration of the same or similar marks for the same or closely related services as the involved mark is discoverable to the extent that the responding party **has actual knowledge thereof (without performing an investigation) and that the information appears to be reasonably calculated to lead to the discovery of admissible evidence.**" TBMP § 414(9). Here, according to Applicant's own admission, GROWMARK has already provided Applicant with certain instances of purported third-party usage (TTABVUE 10, pp. 5-6 and Exhibits 11-12). GROWMARK is not required to undertake any investigation to uncover and provide documents regarding usages of which it is not aware. *See, e.g., Kate Spade LLC v. Thatch, LLC*, 2018 TTAB LEXIS 82, 126 U.S.P.Q.2D (BNA) 1098, 1103 (T.T.A.B. 2018) (recognizing that there is no obligation to conduct an investigation of third-party use); *Sheetz of Delaware, Inc. v. Doctor's Assocs. Inc.*, 2013 TTAB LEXIS 468, 108 U.S.P.Q.2D (BNA) 1341, 1348 (T.T.A.B. 2013) ("A party need not investigate third-party use to respond to discovery requests.") (citations omitted); *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 U.S.P.Q.2D (BNA) 1066, 1072 (T.T.A.B. 2011) (same).

Second, while information regarding instances of litigation between a party and third-parties concerning a mark are potentially discoverable (TBMP § 414(10)), Applicant effectively admits that much of the materials Applicant seeks are equally available to Applicant via the Internet. (TTABVUE, p. 6 and Exhibit 13). Accordingly, GROWMARK is not required to produce such materials. *See, e.g., Avco Corp. v. Turn & Bank Holdings, Inc.*, No. 12-cv-01313, 2015 U.S. Dist. LEXIS 188161, at *7-8 (M.D. Pa. Oct. 7, 2015) (holding that a party's filings with the USPTO constituted publicly available materials that need not be produced in discovery, and observing that under Fed. R. Civ. P. 26(b)(2)(C) "the court must limit the frequency or extent of discovery otherwise allowed by these rules . . . if it determines that . . . the discovery sought . . . can be obtained from some other source that is more convenient, less burdensome, or less expensive[.]"); *Ayyad v. Holder*, No. 05-cv-02342, 2014 WL 4084165, 2014 U.S. Dist. LEXIS 115084, at *5 (D. Colo. Aug. 19, 2014) (observing that discovery "is not required of documents of public records which are equally accessible to all parties") (citations omitted); *SEC v. Strauss*, No. 09-cv-4150, 2009 WL 3459204, 2009 U.S. Dist. LEXIS 101227, at *29-30 (S.D.N.Y. Oct. 28, 2009) ("Even when the documents at issue are within the opposing party's possession, custody or control, it may be inappropriate to compel discovery when the discovering party could easily obtain the documents elsewhere without any of the difficulties that might result from compelled production **[This] analysis requires a determination as to whether the information should be discovered through the requesting party's chosen discovery method** Courts have declined to compel production of documents in the hands of one party when the material is equally available to the other party from another source.") (citations omitted, emphasis added); *Goodrich Corp. v. Emhart Indus.*, No. 04-cv-00759, 2005 U.S. Dist. LEXIS 25160, at *16 (C.D. Cal. Oct. 6, 2005) (denying motion to compel based on fact that information sought was equally available to moving party); *Bleecker v. Standard Fire Ins. Co.*, 130 F. Supp. 2d 726, 738 (E.D.N.C. 2000) ("Discovery is not required when documents are in the possession of or are readily obtainable by the party seeking a motion to compel."); *cf. Johnson & Johnson v. Rexall Drug Co.*,

186 U.S.P.Q. 167, 172 (T.T.A.B. 1975) (recognizing that a party is under no obligation to identify all documents pertaining to litigation it may be involved in; to the extent disclosure is found to be appropriate, party may simply “nam[e] the parties involved, list[] the jurisdiction and proceeding number, and stat[] the outcome; that is, opposer need not, as applicant has requested, identify all documents pertaining to such litigation”).

Third, as the Board has made clear, “[t]he right to discovery is not unlimited. Both the Trademark Rules and the Federal Rules of Civil Procedure grant the Board discretion to manage the discovery process in order to balance the requesting party's need for information against any injury that may result from discovery abuse While it is a general rule that parties involved in an adversary proceeding are entitled to seek discovery as they may deem necessary to help them prepare for trial, it is not the practice of the Board to permit unlimited discovery to the point of harassment and oppressiveness.” *Domond v. 37.37, Inc.*, 2015 TTAB LEXIS 26, 113 U.S.P.Q.2D (BNA) 1264, 1265-66 (T.T.A.B. 2015) (citations and quotation marks omitted). Moreover, “the parties are expected to take into account the principles of proportionality with regard to discovery requests such that the volume of requests does not render them harassing and oppressive[.]” *Id.* at 1266. In terms that are equally applicable to the instant case, the Board in *Domond* observed:

Many of Petitioner's document requests ***seek all documents from the last seventeen years. Complete compliance with a request for “all documents” from such an extended period of time may be unduly burdensome***, and the Board has found it appropriate in such cases to require production of only a representative sampling [A]ny representative sampling ought to correspond to the dates necessary to prove Petitioner's claims. Information that is not relevant to a party's claim or defense, even if it relates to a relevant time period, is not subject to discovery ***Moreover, to propound such a broad, untailed request is not consistent with maintaining an orderly and focused proceeding and is therefore not properly tailored.***

Id. at 1267 (citations omitted, emphasis added); *cf. Frito-Lay N. Am. Inc. v. Princeton Vanguard, LLC*, 2011 TTAB LEXIS 364, 100 U.S.P.Q.2d 1904, 1910 (T.T.A.B. 2011) (where party had spent hundreds of thousands of dollars and created thousands of documents over the course of its operations, it was required to produce only a representative sample with respect to the specific

requests at issue); *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 U.S.P.Q. 147, 148 (T.T.A.B. 1985) (party allowed to provide representative samples of invoices from each calendar quarter); *Neville Chemical Co. v. Lubrizol Corp.*, 1975 TTAB LEXIS 5, 184 U.S.P.Q. 689, 689-90 (T.T.A.B. 1975) (sales and advertising figures for six different categories of goods since 1936 limited to five-year period and a statement that there have been sales for the other years).

Here, GROWMARK's document production encompasses materials dating back at least ten years - from 2008¹, and which go back more than eight years from Applicant's alleged first use of its purported mark in May 2016. In the event the Board elects to allow further discovery, the onus should be on Applicant to specify those limited timeframes for which it seeks additional materials.

B. GROWMARK Properly Objected to the Interrogatories at Issue

Applicant further takes issue with many of GROWMARK's responses to its interrogatories. Applicant's contentions are without merit. In its letter dated Oct. 11, 2018, GROWMARK specifically identified by Bates range several instances of documents which are responsive to Applicant's discovery requests (including – by extension - many of its interrogatories, which significantly overlap with its document requests) (See TTABVUE 10, Ex. 6). Applicant's attempt to seek cumulative and duplicative discovery should be rejected. See Fed. R. Civ. P. 26(b)(2)(C)(i); see also, e.g., *Strauss, supra*, 2009 U.S. Dist. LEXIS 101227, at * 30 (recognizing that court may limit the party's chosen method of discovery where it is unreasonably cumulative); *Richlin v. Sigma Design West, Ltd.*, 88 F.R.D. 634 (E.D. Cal. 1980) (denying motion to compel answers to interrogatories where the information sought was duplicative, oppressive, and overly burdensome).

III. Conclusion

¹ See, e.g., TTABVUE 10, Exh. 12.

Based on the foregoing reasons, GROWMARK respectfully requests that the Board deny Applicant's motion in its entirety.

Dated: March 10, 2019

Respectfully submitted,
GROWMARK, INC.

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **OPPOSITION TO APPLICANT'S MOTION TO COMPEL** is being served upon Applicant First State Bank of Middlebury by mailing said copy on March 11, 2019, via first-class mail, postage prepaid, addressed to:

Charles J. Meyer
Woodard Emhardt Moriarty McNett & Hen
111 Monument Circle, Suite 3700
Indianapolis, IN 46204

/s/ Navdeep K. Singh_____

Navdeep K. Singh