

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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June 24, 2019

Opposition No. 91240594

Growmark, Inc.

v.

First State Bank of Middlebury

Lawrence T. Stanley, Jr., Interlocutory Attorney:

This case now comes up on Applicant's motion to compel, filed January 17, 2019. The motion is fully briefed.

The Board has carefully considered all of the parties' arguments, presumes the parties' familiarity with the factual bases for their filings, and does not recount the facts or arguments here except as necessary to explain this decision. *See Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

As an initial matter, the Board finds that Applicant made a good faith effort to resolve its discovery dispute with Opposer before filing its motion as required by Trademark Rule 2.120(f)(1) and that its motion is timely.

Turning to the merits of the motion, Applicant seeks an order compelling Opposer to:

- produce documents responsive to Applicant’s Document Request Nos. 19 and 32 (9 TTABVUE 6-8); and
- serve supplemental responses to Applicant’s Interrogatory Nos. 2, 5, 8-13, 18-19, 22, 24-26, including responses in compliance with Fed. R. Civ. P. 33(d) (*id.* at 8-11).

Document Request Nos. 19 and 32

Document Request No. 19 is directed to “[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” (9 TTABVUE 46), and Document Request No. 32 is directed to “[a]ll documents and things commenting on infringement or potential infringement, of GROWMARK’s FS Marks or FSB’s FS B & Design trademark” (*id.* at 53).

Opposer objects to both requests on the grounds that the requests are “overbroad, unduly burdensome and expensive and not reasonably calculated to lead to the discovery of admissible evidence” and “unlimited in temporal or practical scope, as Opposer has been in business for over fifty years and has been using the FS Marks for over fifty years[.]” *Id.* at 46 and 53-54. Opposer further objects to Document Request No. 32 on the ground that Applicant’s use of the phrase “commenting on” is “impermissibly vague.” *Id.* at 54. Opposer argues that the requests are overbroad because (i) Opposer “is not required to undertake any investigation to uncover and provide documents regarding usages of which it is not aware” (12 TTABVUE 4), (ii) Opposer is not required to produce materials that are publicly available via the

Internet (*id.* at 5), and (iii) the onus should be on Applicant to narrow the timeframe of its requests (*id.* at 6-7).

Information concerning contractual agreements between a responding party and third parties based on the responding party's involved mark is discoverable. TBMP § 414(10). *See also Johnston Pump/Gen. Valve Inc. v. Chromalloy Am. Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (licensing agreements and arrangements between opposer and third parties and amount of sales thereto are relevant); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 172 (TTAB 1975) (contacts with third parties, such as through litigation or agreements, based on pleaded mark for involved goods, are relevant). Likewise, information concerning litigation and controversies between a responding party and third parties based on the responding party's involved mark is also discoverable. TBMP § 414(10). *See also Am. Soc'y of Oral Surgeons v. Am. Coll. of Oral & Maxillofacial Surgeons*, 201 USPQ 531, 533 (TTAB 1979) ("information concerning communications or controversies between a party to a proceeding before the Board and third parties based upon the party's involved mark may be relevant for such purposes as to show admissions against interest, limitations on the party's rights in such mark, a course of conduct amounting to what could be considered an abandonment of rights in the mark, that the mark has been carefully policed and protected, etc."); *J.B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 580-81 (TTAB 1975) (identity of all civil and USPTO proceedings involving mark is not objectionable).

Although Opposer bases its “overbroad and unduly burdensome” objection in part of the lack of a temporal scope to the document requests and the allegation that Opposer has been in business for over fifty years, Opposer does not attempt to quantify the amount of material that exists. Furthermore, to the extent Opposer argues that it “is not required to undertake any investigation to uncover and provide documents regarding usages of which it is not aware” (12 TTABVUE 4), Opposer is correct, but these requests only concern third party uses of which Opposer is aware (i.e., by way of contract, license, agreement, or effort to police or enforce Opposer’s rights in the pleaded marks). Nevertheless, Applicant’s request for “**all** documents” “**referring** to any contract, license, agreement, litigation or opposition” between Opposer and any third party “**regarding or involving**” Opposer’s pleaded marks is overbroad, as is Applicant’s request for “**all** documents” “**commenting on** infringement or potential infringement” of Opposer’s pleaded marks or Applicant’s involved mark. *Johnson & Johnson*, 186 USPQ at 172 (“opposer need not, as applicant has requested, identify all documents pertaining to such litigation [involving opposer and third parties in respect to ownership of its pleaded registration], such request being too broad and burdensome”).

In view thereof, Applicant’s motion to compel in regard to Document Request Nos. 19 and 32 is **granted in part**. Opposer is **ordered** to produce to Applicant copies of documents sufficient to show its contracts, licenses, or agreements between Opposer and third parties concerning Opposer’s pleaded marks in connection with the services identified in Opposer’s notice of opposition and Applicant’s counterclaim (i.e., services

within International Class 36), including consent agreements. Opposer is further **ordered** to produce to Applicant copies of documents sufficient to show Opposer's efforts to police or enforce its pleaded marks against third parties in connection with the services identified in Opposer's notice of opposition and Applicant's counterclaim (i.e., services within International Class 36), including cease and desist letters. With respect to legal proceedings between Opposer and third parties, Opposer is **ordered** to produce documents sufficient to identify the names of the parties to such proceedings, the jurisdiction, the proceeding number, the outcome of the proceeding, and the citation of the decision (if published), but only for proceedings between Opposer and third parties concerning Opposer's pleaded marks in connection with the services identified in Opposer's notice of opposition and Applicant's counterclaim (i.e., services within International Class 36).

Interrogatory Nos. 2, 5, 8-13, 18-19, 22, and 24-26 - Invocation of Fed. R. Civ. P. 33(d)

Applicant asserts that Opposer's responses to Interrogatory Nos. 2, 5, 8-13, 18-19, 22, and 24-26, as supplemented by its letter dated October 11, 2018 (9 TTABVUE 93-96), are deficient because Opposer improperly relies upon Fed. R. Civ. P. 33(d), and Opposer should be required to provide sworn, complete, narrative responses. Applicant argues that Opposer's responses to Interrogatory Nos. 22, 24, and 25 are particularly "egregious" because these interrogatories seek information concerning Opposer's affirmative defenses, and without explicitly referencing Fed. R. Civ. P. 33(d), Opposer responds that information responsive to these interrogatories "can be

derived or adduced from documents produced in this action” and that Opposer is not aware of “additional facts” at this time. *Id.* at 11.

Opposer argues that its responses are proper because Opposer “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)” and “Applicant’s attempt to seek cumulative and duplicative discovery [via its interrogatories] should be rejected.” 12 TTABVUE 7.

Fed. R. Civ. P. 33(d) permits a responding party, under certain circumstances, to respond to an interrogatory by specifying its business records from which the information may be derived or ascertained. *See* TBMP § 405.04(b). “The Board has repeatedly explained that a party must comply with three specific requirements to invoke Rule 33(d).” *Hewlett Packard Enter. Dev. LP v. Arroware Indus., Inc.*, 2019 USPQ2d 158663, 2019 BL 158663, *8 (TTAB 2019). “First, ‘a party may not rely on the option to produce business records unless it can establish that providing written responses would impose a significant burden on the party.’” *Id.* (quoting *No Fear, Inc. v. Rule*, 54 USPQ2d 1551, 1555) (TTAB 2000)). “Second, ‘a party who responds to interrogatories by invoking Rule 33(d) ... has the duty to specify, by category and location, the records from which the answers to [the] interrogatories can be derived.’” *Id.* (quoting *Jain v. Ramparts, Inc.*, 49 USPQ2d 1429, 1433 (TTAB 1998)). “Third, even if the responding party can meet the first two requirements, ‘the inquiring party must not be left with any greater burden than the responding party when searching

through and inspecting the records.” *Id.* (quoting *No Fear*, 54 USPQ2d at 1555)). “Factor three is considered only where ‘the first two prerequisites ... have been met by the party seeking to invoke Rule 33(d).” *Id.* (quoting *Jain*, 49 USPQ2d at 1434).

Opposer has not met these requirements. As an initial matter, Opposer fails to specify why providing written responses would impose a significant burden. *See Jain*, 49 USPQ2d at 1433 (the burden must be “above and beyond the normal burden involved in providing written responses to interrogatories.”). Opposer objected on the ground that “the burden of ascertaining [the requested information] is substantially the same for Applicant as it would be for [Opposer]” (9 TTABVUE 93-96), but does not establish that the provision of written responses would pose a “significant burden,” as that burden has been defined. *Hewlett Packard Enter. Dev. LP*, 2019 BL 158663 at *8.

Opposer also fails to specify in sufficient detail where the answers to the interrogatories can be ascertained. Respondent repeats the same response to Interrogatory Nos. 2, 5, 8-13, 18-19 and 26, namely that “pursuant to Fed. R. Civ. P. 33(d), [Opposer] refers Applicant to [Opposer’s] Production of Documents” and that “[i]nformation responsive to this Request may be ascertained from produced documents[,]” and for Interrogatory Nos. 22, 24, and 25, Respondent states that “[a]t this time, [Respondent] is not of aware of any additional facts – other than those that can be derived or adduced from documents produced in this action by both parties – in support of this affirmative defense.” 9 TTABVUE at 93-96. Opposer, however, does

not specify any documents. Since Opposer does not meet the first two prerequisites, the Board does not need to address the third requirement.

The Board further rejects Opposer's argument that its responses are proper because Opposer "identified by Bates range several instances of documents which are responsive to Applicant's [document] requests" and the interrogatories are "cumulative and duplicative." 12 TTABVUE 7. Opposer does not cite any authority for its proposition, nor is the Board aware of any such authority, that a party is only required to respond to one form of discovery requests. *Hewlett Packard Enter. Dev. LP*, 2019 BL 158663 at *9. The Federal Rules of Civil Procedure and the Board's rules both explicitly permit both types of discovery requests, and the requests can serve different purposes. *Id.* For example, a document request seeking documentation on the same topic as an interrogatory request may serve as a means of corroborating the interrogatory response and vice versa. *Id.* Accordingly, Opposer's argument that the interrogatories are "cumulative and duplicative" of the document requests is unavailing.

Opposer has not satisfied the requirements of Fed. R. Civ. P. 33(d) as a means of responding to Applicant's Interrogatory 2, 5, 8-13, 18-19, 22, and 24-26. Accordingly, Applicant's motion to compel is **granted** with respect to Interrogatory Nos. 2, 5, 8-13, 18-19, 22, and 24-26 to the extent that Opposer must provide sworn, complete, and narrative responses to each of these interrogatories.

Summary

In view of the foregoing, Applicant's motion to compel is **granted in part** to the extent indicated herein. Additionally, the February 28, 2019 suspension order is retroactive to the filing date of Applicant's motion to compel.

Because the motion was filed prior to the deadline for expert disclosures, the Board will reset dates accordingly, including the deadline for expert disclosures.

Applicant's motion to compel in regard to Document Request Nos. 19 and 32 is **granted in part**. Opposer is **ordered** to produce to Applicant copies of documents sufficient to show its contracts, licenses, or agreements between Opposer and third parties concerning Opposer's pleaded marks in connection with the services identified in Opposer's notice of opposition and Applicant's counterclaim (i.e., services within International Class 36), including consent agreements. Opposer is further **ordered** to produce to Applicant copies of documents sufficient to show Opposer's efforts to police or enforce its pleaded marks against third parties in connection with the services identified in Opposer's notice of opposition and Applicant's counterclaim (i.e., services within International Class 36), including cease and desist letters. With respect to legal proceedings between Opposer and third parties, Opposer is **ordered** to produce documents sufficient to identify the names of the parties to such proceedings, the jurisdiction, the proceeding number, the outcome of the proceeding, and the citation of the decision (if published), but only for proceedings between Opposer and third parties concerning Opposer's pleaded marks in connection with

the services identified in Opposer's notice of opposition and Applicant's counterclaim (i.e., services within International Class 36).

If Opposer has no non-privileged documents in its possession, custody or control that are responsive to the above-identified requests for production of documents, Opposer must so state affirmatively in its response to the corresponding request.

To the extent Opposer has already fully searched for and produced documents responsive to the above-identified requests for production of documents, Opposer must so state in its response to the particular request and identify, by Bates number, the documents that are responsive to each request.

Additionally, Opposer is required to provide Applicant with a privilege log within the same **thirty days** provided above to the extent that Opposer claims privilege to any of Applicant's written discovery requests, if it has not already done so.

Applicant's motion to compel is **granted** with respect to Interrogatory Nos. 2, 5, 8-13, 18-19, 22, and 24-26. Opposer is allowed until **thirty days** from the mailing date of this order in which to provide full and complete written and verified responses to Interrogatory Nos. 2, 5, 8-13, 18-19, 22, and 24-26.

The Board expects the parties (and their attorneys) to cooperate with one another in the discovery process and looks with extreme disfavor on those who do not. TBMP § 408. Each party and its attorney has a duty to make a good faith effort to satisfy the discovery needs of its adversary. *Id.* The parties are also reminded of their ongoing duty to supplement their discovery responses in a timely manner. Fed. R. Civ. P. 26(e)(1)(A).

Should Opposer not comply with the Board’s orders herein, Applicant may seek appropriate sanctions. *See* Trademark Rule 2.120(h); TBMP §§ 411.04 and 527.01.

Opposer is reminded that it may, upon timely objection from Applicant, 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. v Resort Option Enters., Inc.*, 94 USPQ2d 1789, 1792 (TTAB 2009).

Trial Schedule

Proceedings herein are hereby **resumed**. Remaining trial dates are reset as follows:

Expert Disclosures Due	8/23/2019
Discovery Closes	9/22/2019
Plaintiff’s Pretrial Disclosures Due	11/6/2019
Plaintiff’s 30-day Trial Period Ends	12/21/2019
Defendant’s Pretrial Disclosures Due	1/5/2020
Defendant’s 30-day Trial Period Ends	2/19/2020
Plaintiff’s Rebuttal Disclosures Due	3/5/2020
Plaintiff’s 15-day Rebuttal Period Ends	4/4/2020
Plaintiff’s Opening Brief Due	6/3/2020
Defendant’s Brief Due	7/3/2020
Plaintiff’s Reply Brief Due	7/18/2020
Request for Oral Hearing (optional) Due	7/28/2020

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).
