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EJW

December 26, 2019

Opposition No. 91242213 (parent)
Opposition No. 91242238

AUDEMARS PIGUET HOLDING S.A.

v.

Haas Outdoors, Inc.

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

These consolidated cases now come up for consideration of Opposer's motion (filed July 15, 2019) for partial reconsideration of the Board's order issued on July 14, 2019, and of Opposer's motion (filed July 15, 2019) to compel better responses to certain of its interrogatories and requests for production of documents from Applicant. Both motions are fully briefed.

The Board has considered the parties' briefs and materials submitted with both motions, but addresses the record only to the extent necessary to set forth the Board's analysis and findings, and does not repeat or address all of the parties' arguments or materials. *Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015). For purposes of this order, the Board presumes the parties' familiarity with the pleadings, and the arguments and materials submitted in connection with the subject motions.

I. Motion for Partial Reconsideration

By way of background, on July 14, 2019, the Board issued an order regarding Applicant's motion to compel Opposer's responses to certain of Applicant's production requests and to require that Opposer produce responsive documents in the United States. 24 TTABVUE 15. The Board also granted Opposer's motion for leave to use expert testimony. 24 TTABVUE 16.

A. Opposer's Arguments

Opposer requests that the Board reconsider the manner and place of document production set forth in the Board's previous order.[1] In support of its motion, Opposer explains that in its response to Applicant's motion, Opposer had withdrawn its inadvertently included "General Objections," in particular General Objection No. 4, to Applicant's requests for production. Therefore, there was no "convoluted production mechanism" discussed by Applicant in its motion to compel. Opposer also states that it withdrew its General Objections in its responsive brief, stating that production "should be straightforward." 25 TTABVUE 3 (citing to Opposer's response, 10 TTABVUE 6). Additionally, Opposer states that it emphasized in its response that if Opposer did not specifically object to any particular request, then it did not object to it. Opposer also repeats its waiver of any such objections now, and states further that Opposer does not seek protection under either The Hague Convention and/or Swiss law. Rather, Opposer only seeks to proceed "as authorized under the Federal

[1] To the extent that Opposer requests that the Board stay the production order because Audemars Piquet is closed each year from July 22-August 6, said request is moot, given the date of this order.

Rules of Civil Procedure," namely, Fed. R. Civ. P. 34 and longstanding Board precedent, which allow for the responding party to make documents available for inspection and copying at the place they are normally kept. Opposer also posits that the procedure discussed in Objection no. 4 (which was withdrawn) only applied to when the request at issue was deemed to be overly broad, namely, Applicant's requests for production nos. 9 and 12.

Opposer states that it is willing to reword (and has reworded) its responses to request nos. 2, 3, 7, 11-19, and 21-23, as previously ordered by the Board; however, Opposer also emphasizes that inspection and copying of responsive documents to those requests should proceed "in the normal, straightforward manner," that is, inspection and copying at the place where Opposer's documents are located. 25 TTABVUE 5. As further justification for its position, Opposer points out that Applicant has insisted that Opposer come to Applicant's headquarters in West Point, Mississippi to inspect and copy documents.

In essence, while Opposer states that it is not seeking protection under the Hague Convention and/or under Swiss law, Opposer insists that is appropriate that the Board require Applicant to inspect and copy Opposer's responsive documents where such documents are kept, namely, at its corporate offices in Le Brassus, Switzerland. With its reply brief, Opposer has submitted the declaration of its Senior IP Legal Counsel, Sarah Morellon, who avers, inter alia, that Opposer's employees have at least a working knowledge of English and will be available to assist Applicant's counsel with inspection and copying. (dec. ¶¶ 4-5, 33 TTABVUE 38).

B. Legal Standard

The premise underlying a motion for reconsideration is that, based on the facts before the Board at the time a party's original motion was under consideration, the Board erred in reaching the order it issued. A motion for reconsideration may not properly be used to simply reargue the points that were presented or should have been presented in a brief on the original motion. Rather, the motion for reconsideration should be limited to a demonstration that, based on the facts before it at such time and the applicable law, the Board's ruling is in error and requires appropriate change. *See Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 518 (2019). To determine whether Opposer is rearguing the points that were presented or should have been presented in its responsive brief on the original motion, the Board will examine and compare Opposer's brief in response to Applicant's motion, and Opposer's motion for reconsideration.

Initially, the Board notes that Opposer already argued in its response to Applicant's motion to compel that it had withdrawn its General Objections. 10 TTABVUE 6. Thus, Opposer is improperly rearguing part of its previous response.

Moreover, in the Board's order at issue, the Board specifically recognized that Opposer had withdrawn its general objections. 24 TTABVUE 4. Further, as discussed in that order, although Opposer stated that it had withdrawn its General Objections, it was evident to the Board that not all statements within those objections were

actually withdrawn. For example, the Board noted that Opposer did not indicate that the following statement was withdrawn, 24 TTABVUE 5:

> [T]he fact that Audemars Piguet agrees to produce documents in a certain request shall not be interpreted to be an admission or inference that any such documents exist or that Audemars Piguet has any such documents in its possession, custody, or control.
>
> Para. 14, 9 TTABVUE 16.

In fact, Opposer reiterated in its response to Applicant's motion that "for those requests [to which it does not specifically object, Audemars Piguet] will permit inspection and copying **of any non-privileged responsive documents they have**." 10 TTABVUE 6. Therefore, in both its responses to Applicant's requests for production nos. 2-3, 7, 11-19, and 21-23, **and** in Opposer's response to Applicant's motion to compel, notwithstanding Opposer's "withdrawal"of its General Objections, Opposer maintained its position that it is permissible to not unequivocally state whether any responsive documents actually exist. In view thereof, it was appropriate for the Board to address in its order the improper limitations to or parameters of production set forth by Opposer within its General Objections or elsewhere in the record regarding how Opposer should provide responsive documents to Applicant. 24 TTABVUE 4 ("apart from how Opposer intends to produce documents discussed within the general objections, discussed infra, the Board considers Opposer's general objections … to be withdrawn"). Accordingly, not only is Opposer's renewed request improper, but the Board made no error.

Turning to the second request in Opposer's motion for reconsideration related to the means by which Opposer seeks to produce its responsive documents, i.e., by

inspection and copying by Applicant's counsel in Switzerland, Opposer likewise set forth the same arguments in its response. *Compare* 10 TTABVUE 2-5 to 25 TTABVUE 3-4. Further, Opposer seeks to **add evidence to the record**, specifically, the declaration of Opposer's IP counsel.[2] For these reasons, Opposer's motion for partial reconsideration regarding the Board's order requiring Opposer to copy and transmit responsive documents to Applicant is improper.

Additionally, Opposer's contention that the Board should require Applicant's counsel to go to Opposer's office in Switzerland simply because Opposer does not seek protection under Swiss law or The Hague Convention is not persuasive. Opposer's position effectively ignores the Board's lengthy discussion regarding the Board's concerns, case law subsequent to *Elec. Indus. Ass'n v. Potega*, 50 USPQ2d 1775, 1777 (TTAB 1999), Trademark Rule 2.120(e)(1),[3] and how counsel's appearance in Switzerland may have certain consequences under Swiss law, regardless of Opposer's intent. Moreover, as said in the previous order, requiring Applicant's counsel to travel abroad for this purpose would be prohibitively and unnecessarily expensive. 24 TTABVUE 7-12.

Accordingly, Opposer's motion for reconsideration is **DENIED**.

[2] In any event, such evidence was submitted improperly in its reply brief, which is improper rebuttal.

[3] The time, place, and manner for production of documents, electronically stored information, and tangible things shall comport with … where and in the manner which the Trademark Trial and Appeal Board, upon motion, orders.

II. Opposer's Motion to Compel

Opposer's narrowly tailored motion to compel seeks better responses to eight of its interrogatories and complete documentation in response to one request for production, as well as better-identified responsive documents.

A. Good Faith Effort

Initially, the Board finds that Opposer made the requisite showing of having made a good faith effort to resolve the discovery dispute before filing its motion to compel. *See* Trademark Rule 2.120(f)(1), 37 C.F.R. § 2.120(f)(1). Specifically, Opposer's counsel sent three deficiency letters to Applicant's counsel, explaining Opposer's concerns regarding Applicant's responses to Opposer's interrogatories and requests for production of documents (Exh. 9, 10 and 12), 26 TTABVUE 130, 135, and 147; and Applicant's counsel did not address sufficiently certain of Opposer's concerns. See 26 TTABVUE 142, 158.

B. SUMMARY ORDERS

Opposer's motion to compel is **granted in part, and denied in part**, as discussed in the following summary orders:

1. **Interrogatory Nos. 4, 30, and 32:** Applicant failed to specifically identify the documents that are responsive to these interrogatories. For instance, regarding interrogatory no. 4, Applicant should have responded by referring to specific documents by Bates number (or similar identifying detail) that are comprised of "USPTO printouts of the MOSSY OAK marks used by Haas," 29 TTABVUE 3; and regarding no. 30, Applicant should have identified by Bates number (or similar

identifying detail) the documents describing any third-party trademark(s) that Applicant may rely on in connection with the opposition. *See* TBMP § 414(9) ("Information concerning a party's awareness of third-party use and/or registration of the same or similar marks for the same or closely related goods or services as an 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.").

As for Applicant's response to No. 32, the response appears evasive insofar as merely identifying (e.g., by list) the type or classes of customers would be far simpler for Applicant, than for Opposer to guess while examining Applicant's broadly identified "marketing data" provided by Applicant to Opposer. *See* TBMP § 414(3).

In sum, the current responses, in which documents are referred to only generally, do not comply with Fed. R. Civ. P. 33(d). Rule 33(d) expressly provides that the responding party's specification of business records must be "in sufficient detail to permit the interrogating party to locate and to identify, as readily as can the party served the records from which the answer may be ascertained." In particular, "a party who responds to interrogatories by invoking Rule 33(d)'s option to produce business records 'has the duty to specify, by category and location, the records from which answers to [the] interrogatories can be derived.'" *Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1433 (TTAB 1998) (citing Advisory Committee Notes (1980 Amendment)); *see also* Fed. R. Civ. 34(b)(E)(i) (the responding party must organize and label the responsive documents to correspond to the categories in the request); Trademark

Rule 2.116(a). Accordingly, Opposer's motion to compel is **granted** as regards its Interrogatory Nos. 4, 30 and 32. Applicant is ORDERED to specify which documents are responsive to these three interrogatories and the particular location thereof in the documents already provided to Opposer.

2. **Interrogatory No. 10:** Opposer requests annual U.S. dollar sales for Applicant's goods/services in connection with which Applicant has used "Applicant's mark" (defined by Opposer to mean the mark as described in the application) since the date of first use of the mark, but Applicant asserts that the request is overbroad because it relates to goods/services not in the application(s). Additionally, Applicant states that it does not maintain separate sales figures by categories such as watches and jewelry and that Opposer would need to inspect sales records of watch and jewelry licenses and assemble such sales figures directly. 29 TTABVUE 4.

The Board finds that Opposer's request for 10 years of annual sales data to be disproportionate to the needs of this case, and that Opposer's request with respect to "goods/services in connection with which Applicant has used Applicant's Mark" is overly broad insofar as such description could include goods and services that are not relevant to this consolidated proceeding. *See* TBMP § 414(11) (A party need not provide discovery with respect to those of its marks and goods and/or services that are not involved in the proceeding and have no relevance thereto.).

Nonetheless, Applicant's objections are **overruled in part**. *See* TBMP § 414(18) ("Annual sales and advertising figures, stated in round numbers, for a party's involved goods or services sold under its involved mark are proper matters for

discovery; if a responding party considers such information to be confidential, disclosure may be made under protective order."); *see also Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1267 (TTAB 2015) (annual sales and advertising figures, stated in round numbers, for a party's involved goods are proper matters for discovery); *Neville Chemical Co. v. Lubrizol Corp.,* 184 USPQ 689, 690 (TTAB 1975) (allowed to provide figures for each of last five years and a statement that there have been sales for the other years); *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 123 (TTAB 1974) (required to furnish round figures concerning sales under mark for period of five years as well as advertising expenditures relating thereto).

Accordingly, Opposer's motion to compel is **granted in part**, as follows: Applicant is ORDERED to serve on Opposer's counsel sufficient documentation in its possession, custody or control showing sales revenue from "[Applicant's] licensing of watches and jewelry", 29 TTABVUE 5, over the five years preceding the filing of the notices of opposition. Such documentation should be sufficient to show continuous use of the applied-for marks with the goods identified in the involved applications.

3. **Interrogatory No. 19:** the motion to compel is **granted in part**. *See* TBMP § 414(17) (The identity of any advertising agency engaged by a party to advertise and promote the party's involved goods or services under its involved mark is discoverable, as is the identity of the advertising agency employees having the most knowledge of such advertising and promotion.). To the extent Applicant uses any outside businesses and/or licensees to promote its watches and jewelry offered under

the applied-for marks, Applicant is ORDERED to provide the addresses and contact information for those businesses and/or licensees.

4. **Interrogatory No. 20:** the motion to compel is **denied**. Opposer's request that Applicant "describe in detail the agreements which Applicant has entered or plans to enter into relating to offering of goods/services in connection with Applicant's Mark" is overly broad and vague. This interrogatory could refer to a wide variety of agreements, including licensing, logistical, employment or manufacturing arrangements, and is therefore vague and burdensome. Moreover, the interrogatory refers to "goods/services" that could include such goods or services that are not identified in the involved applications.

5. **Interrogatory No. 31:** Opposer requests that Applicant "describe in detail any facts that tend to support Applicant's contentions in its answer and any affirmative defenses in the present opposition(s)." This interrogatory is overly broad and burdensome. Opposer's interrogatory should be specifically tailored to particular facts alleged in the answer, if any, or to its denial of specific allegations in the notices of opposition. Accordingly, the motion to compel is **denied**.

6. **Interrogatory No. 34:** Opposer requests that Applicant identify entities who have an ownership interest in Applicant. Applicant's response is sufficient. Such information is not relevant to the issues in these proceedings. *See* TBMP § 414(14) (Generally, the names and addresses of the stockholders of a corporate party or other entities owned or controlled by the party are irrelevant, and not discoverable, unless there is a question as to whether that party and another entity are "related

companies" within the meaning of Trademark Act § 5, 15 U.S.C. § 1055.). Accordingly, as to this interrogatory, the motion to compel is **denied**.

7. **Production Request No. 30:** Opposer seeks "all documents and things concerning any trade show attended by Applicant where goods under Applicant's Mark were promoted." Opposer asserts that Applicant inappropriately provided a "representative sampling," without explaining why a limited sample was necessary. Insofar as Applicant has explained that the request involves over 15 years of trade shows, 29 TTABVUE 9, and the request for **all documents and things** is overly broad, vague and burdensome, the Board finds that Applicant's response is sufficient. Accordingly, Opposer's motion to compel regarding request no. 30 is **denied**.

III. Summary; Proceedings Resumed; Trial Dates Reset

Opposer's motion for reconsideration is denied; and Opposer's motion to compel is denied in part and granted in part, as discussed herein.

The proceedings are resumed. Trial dates are reset as shown in the following trial schedule:

Opposer's Discovery Responses Due per July 14, 2020 order	**1/31/2020**
Amended Expert Disclosures Due, if Any	**3/18/2020**
Discovery Closes	**4/17/2020**
Plaintiff's Pretrial Disclosures Due	**6/1/2020**
Plaintiff's 30-day Trial Period Ends	**7/16/2020**
Defendant's Pretrial Disclosures Due	**7/31/2020**
Defendant's 30-day Trial Period Ends	**9/14/2020**

Plaintiff's Rebuttal Disclosures Due	**9/29/2020**
Plaintiff's 15-day Rebuttal Period Ends	**10/29/2020**
Plaintiff's Opening Brief Due	**12/28/2020**
Defendant's Brief Due	**1/27/2021**
Plaintiff's Reply Brief Due	**2/11/2021**
Request for Oral Hearing (optional) Due	**2/21/2021**

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, 37 C.F.R. §§ 2.121-2.125. 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), 37 C.F.R. §§ 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), 37 C.F.R. § 2.129(a).

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