UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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EJW

February 9, 2021

Opposition No. 91242213 (parent)
Opposition No. 91242238

Audemars Piguet Holding S.A.

v.

Haas Outdoors, Inc.

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

These cases now come up for consideration of (1) Opposer's combined motions (filed August 11, 2020) to compel and to reset discovery, disclosure and trial dates, 42 TTABVUE,[1] and (2) Applicant's combined cross-motion (filed September 8, 2020) to strike Opposer's combined third motion to compel and for a protective order. 51 TTABVUE. Both motions are fully briefed.

The Board has considered the parties' briefs and materials or evidence submitted therewith, but addresses the record only to the extent necessary to support the

[1] Citations to the record or briefs in this order include citations to the publicly available documents on the Trademark Trial and Appeal Board Inquiry System (TTABVUE), the Board's electronic docketing system. *See, e.g., Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). The number preceding "TTABVUE" corresponds to the docket entry number; the number(s) following "TTABVUE" refer to the page number(s) of that particular docket entry. All citations to documents contained in the TTABVUE database are to the downloadable .pdf versions of the documents in the USPTO TTABVUE Case Viewer. Parties should use the same method to refer to the record in their submissions to the Board.

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.

Initially, insofar Applicant's combined motion to strike and for protective order relates to Opposer's conduct related to its discovery requests that are the subject of the motion to compel, the Board finds that Applicant's motion is germane to Opposer's combined motions to compel. In view thereof, Applicant's combined motion will be considered. *Cf. Nestle Co. v. Joyva Corp.*, 227 USPQ 477, 478 n.4 (TTAB 1985) (cross-motion for summary judgment is a proper filing even after proceeding is suspended).

Further, inasmuch as the Board's order on Opposer's combined motion to compel may be affected by its order on Applicant's combined motion to strike and for protective order, the Board turns first to Applicant's motion.

I. Applicant's Combined Motion to Strike and for Protective Order

A. Parties' Arguments

Applicant requests that the Board strike Opposer's most recently filed combined motion to compel and to issue a protective order closing discovery and prohibiting Opposer from serving any additional discovery or discovery motions. As grounds for its combined motion, Applicant asserts that in these proceedings, Opposer has engaged in a pattern of filing unnecessary and dilatory motions, sending numerous letters to Applicant's counsel regarding alleged discovery deficiencies, engaging in

"fishing expeditions," and propounding unnecessary additional, informal discovery requests, all of which raise Applicant's costs to defend its applications. Further, Applicant asserts that, in addition to filing the instant oppositions, Opposer has filed 17 other oppositions against a variety of marks that contain the term "oak," and in these and in the 17 other oppositions, Opposer has filed a series of motions apparently designed to harass and fatigue the applicant. 51 TTABVUE 3. Applicant explains, by way of example, that Opposer's most recently filed combined motions to compel relates to discovery responses and documents served in September 2018, and that Opposer's counsel has sent "voluminous and lengthy letters, requesting additional documents, alleging countless imagined failures to respond to discovery, and threatening further actions." *Id.* at 8. In support of its assertions, Applicant has submitted multiple exhibits, including the following:

- The parties' correspondence regarding Applicant's discovery responses and depositions from January 31, 2020, through August 25, 2020, including 18[2] letters from Opposer's counsel, 51 TTABVUE 52-152;
- A copy of the Board's order in Opposition No. 91245118, discussing Opposer's repetitive improper conduct, 51 TTABVUE 20;
- A copy of the Board's order in Opposition No. 91244316, explaining that Opposer's correspondence did not satisfy the good faith requirement of

[2] Opposer's exhibits to its combined motions to compel show two additional letters sent by Opposer on December 5, 2018, and July 7, 2020. See 42 TTABVUE 84, 134. Therefore, the record shows that Opposer's counsel sent at least 20 letters to Applicant's counsel during this period in 2020, plus one letter shortly after receiving responses and initial production in 2018.

Trademark Rule 2.120(f)(1) and that Opposer's motion to compel was premature, 51 TTABVUE 33-35;

- A copy of Applicant's brief in Opposition No. 91244316, in which it asserts, inter alia, the following:

> "In addition to the general question whether potential future plans are germane to this opposition proceeding, … the Opposer is also trying to use inconsequential editorial mistakes to portray Applicant, or his counsel, as trying to hide something, but that is simply not the case. The excessive amount of deficiencies letters sent by Opposer … clearly indicate that Opposer is trying to make mountains out of molehills and find alleged discrepancies in Applicant's responses, but there are none."

51 TTABVUE 45;

- A printout of a TTABVUE search showing 21 proceedings before the Board filed by Opposer against marks that include the word "oak," 51 TTABVUE 14-16; and
- A copy of a district court order granting Applicant's motion to quash a subpoena because the request for Applicant's third-party witness to appear personally during pandemic was unreasonable. 51 TTABVUE 149.

In response, Opposer contends that Applicant's motion should be denied because it is not germane to Opposer's combined motion to compel, its motions do not contain redundant, immaterial, impertinent, or scandalous matter, and its motions to compel have a bearing on issues in this matter. In particular, Opposer asserts that the issues involve "Mossy Oak watch and jewelry press releases, advertisements, retail distribution points, and unit and dollar sales. 42 TTABVUE." 55 TTABVUE 4. Further, Opposer argues that it has not propounded excessive discovery; rather, it

has only been diligent in addressing unresolved issues, and that it is Applicant who has caused the delays in discovery. In particular, Opposer points out how many more objections Applicant has made to Opposer's discovery, in contrast to the number of objections Opposer has made to Applicant's discovery; contends that Applicant has prevented Opposer from reviewing various pertinent documents, such as advertisements for Applicant's goods and information regarding Applicant's licensees; and, inter alia, states that Applicant has refused to provide an index/correspondence table as required by the Board's previous order and Fed. R. Civ. P. 34(b)(E)(i). Opposer also argues that its several oppositions and diligent conduct are appropriate to protect its ROYAL OAK marks, and that many of Applicant's documents served in response to Opposer's discovery are not responsive.

In reply, Applicant argues that the Board has the authority to protect a party from undue burden or expense under TBMP[3] § 526, that its combined motion is germane to Opposer's pending combined motions to compel, and that the documents it has produced have been both responsive and voluminous, notwithstanding Opposer's complaint to the contrary, in view of the broad nature of the requests posed by Opposer. Applicant also reiterates one of its principal concerns regarding Opposer's conduct, i.e., gamesmanship exemplified by Opposer filing new motions on the day of or shortly after the Board issues an order, thus, triggering the continued suspension of these proceedings.

[3] TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) (2020).

B. Analysis and Order

(1) Legal Standard

To the extent Applicant seeks a protective order, Trademark Rule 2.120(g), 37 C.F.R. § 2.120(g), provides, in pertinent part:

> Upon motion by a party … from whom discovery is sought, and for good cause, the Trademark Trial and Appeal Board may make any order which justice requires to protect a party from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the types of orders provided by clauses (A) through (H), inclusive, of Rule 26(c)(1) of the Federal Rules of Civil Procedure.

A motion for protective order may be issued where it is readily apparent that discovery requests are so oppressive as to constitute clear harassment. *See Domond v. 37.37, Inc.,* 113 USPQ2d 1264, 1266 (TTAB 2015). In such a case, a party may properly move for a protective order that disclosure or discovery not be had, or be had only on specified terms and conditions. *Emilio Pucci Int'l BV v. Sachdev*, 18 USPQ2d 1383, 1386 (TTAB 2016) (citing *Domond v. 37.37, Inc.,* 113 USPQ2d at 1266). Among the types of protective orders that may be entered, the Board has the discretion, for instance, to limit the number of discovery depositions, *see Pioneer Kabushiki Kaisha v. Hitachi High Tech. Am., Inc.*, 74 USPQ2d 1672, 1674-77 (TTAB 2005); to restrict the number of requests of admission because they are either duplicative or sought admissions regarding irrelevant matter, *see The Phillies v. Phila. Cons. Holding Corp.*, 107 USPQ2d 2149, 2154 (TTAB 2013); and to prohibit the taking of depositions of high level executive officers, *see FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1764 (TTAB 1999). In these cases, a movant must establish good cause as set forth in Fed. R. Civ. P. 26(c)(1) for the issuance of a protective order by providing "a particular

and specific demonstration of fact, as distinguished from stereotyped and conclusory statements." *The Phillies v. Philadelphia Consol. Holding Corp.*, 107 USPQ2d at 2152 (citing *FMR Corp. v. Alliant Partners*, 51 USPQ2d at 1761).

In addition to issuing an order under Trademark Rule 2.120(g), 37 C.F.R. § 2.120(g), the Board has authority to enter appropriate sanctions, up to and including judgment, against a party under (1) Fed. R. Civ. P. 11, applicable to these proceedings under Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a); (2) Trademark Rule 2.120(h), 37 C.F.R. § 2.120(h); (3) Fed. R. Civ. P. 37(b)(2) governing discovery; or (4) the Board's inherent authority to sanction, to protect the integrity of the judicial process, and to manage its docket. The Board has broad discretion in managing discovery in its proceedings. *Spliethoff's Bevrachtingskantoor B.V. v. United Yacht Transport LLC dba United Yacht Transport*, 2020 USPQ2d 10605 (TTAB 2020) (citing *FMR Corp. v. Alliant Partners*, 51 USPQ2d at 1761 ("Both the Trademark Rules and the Federal Rules of Civil Procedure grant the Board discretion to manage the discovery process.")).[4]

Under the Board's inherent authority, the Board may issue a broad range of orders (1) to address a wide array of conduct including, a party's dilatory conduct, misconduct, bad faith conduct, and fraudulent submissions to the Board, and (2) to regulate the discovery process and manage the trial schedule. *See, e.g., SFM, LLC v. Corcamore, LLC,* 129 USPQ2d 1072, 1075 (TTAB 2018) (when alleged misconduct

[4] **"**The Board must limit the extent or frequency of discovery if it finds that: … (i) the discovery sought is unreasonably cumulative or duplicative." *Spliethoff's v. United Yacht Transport*, 2020 USPQ2d 10605 *3 (citing Fed. R. Civ. P. 26(b)(2)(C)(i)-(iii)).

does not squarely fall within reach of the Federal Rules of Civil Procedure or Board rules, the Board may invoke its inherent authority to enter sanctions); *see also Optimal Chemical Inc. v. Srills LLC,* 2019 USPQ2d 338409, *19 (TTAB 2019) (citing *In re Bailey,* 182 F.3d 860, 864-65 (Fed. Cir. 1999) (non-Article III tribunals have inherent authority to control proceedings and enter sanctions[5])); *NSM Res. Corp. v. Microsoft Corp.*, 113 USPQ2d 1029, 1038 (TTAB 2014) ("The Board has discretion to tailor sanctions appropriate to the violations and may consider any measure designed to serve this purpose."); *Carrini Inc. v. Carla Carini S.R.L.*, 57 USPQ2d 1067, 1071 (TTAB 2000) ("Although the Board is not a court, the Board possesses the inherent authority to control the disposition of cases on its docket, which necessarily includes the inherent power to enter sanctions."). To the extent Applicant requests that the Board strike Opposer's third combined motion to compel, to close discovery, and to prohibit Opposer from serving any additional discovery or discovery motions, given the reasons given for the motion and the relief sought, these requests are more akin to a motion for sanctions under the Board's inherent authority and are construed as such.

(2) Order

As a general matter, to the extent Opposer asserts that its filing of the instant oppositions and others to defend its ROYAL OAK marks and its counsel's conduct vis-à-vis Applicant are proper, trademark owners are entitled to protect rights in their

[5] "Although we have never addressed the underlying issue of the authority of the Court of Appeals for Veterans Claims **to discipline attorneys practicing before it**, we have no doubt that the Court of Appeals for Veterans Claims does indeed have such power." *In re Bailey,* 182 F.3d 860, 864 (Fed. Cir. 1999) (Board emphasis).

registered trademarks by seeking to preclude registration of what they believe to be confusingly similar marks, "a right which every trademark owner possesses under the common law and the Lanham Act." *Cook's Pest Control, Inc. v. Sanitas Pest Control Corp.,* 197 USPQ 265, 268 (TTAB 1977). Further, the fact that Opposer has opposed registration of unrelated third-party marks and Applicant's applied-for marks based on its pleaded marks merely indicates that Opposer actively polices its marks. Additionally, with respect to discovery, when a party produces documents in stages, as in this case, or on a rolling basis, it is reasonable for the propounding party to respond in tandem with such production regarding any deficiencies with the documents produced.

Nonetheless, defending one's trademark rights and diligently pursuing discovery when involved in a Board proceeding does not give a party or its counsel license to makes excessive demands, harass and bully the adverse party, or tax the Board's resources. Importantly, the scope of discovery in Board proceedings is generally narrower than in court proceedings, therefore, the parties' discovery should be tailored accordingly. *See, e.g., Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 100 USPQ2d 1904, 1907 (TTAB 2011) ("it is well-settled that [a party] 'need not provide discovery of [ESI] from sources that [it] identifies as not reasonably accessible because of undue burden or cost.'"); *Pioneer v. Hitachi*, 74 USPQ2d at 1674 ("In view of the limited jurisdiction of the Board in deciding only issues of registrability, each party and its attorney has a duty … to make a good faith effort to seek only such discovery as is proper and relevant to the specific issues involved in the case.");

Luehrmann v. Kwik Kopy Corp., 2 USPQ2d 1303, 1305 (TTAB 1987); *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986).

Unfortunately, after carefully reviewing the parties' arguments and the record of these proceedings as a whole, the Board finds that Opposer, through its counsel,[6] has not merely been advocating to protect its trademark rights or following up concomitantly with Applicant's production of documents. On the contrary, Opposer, through its counsel, has engaged in a willful pattern of harassment of Applicant during discovery, which has consumed unnecessarily Applicant's resources and negatively impacted those of the Board. To demonstrate the inexorable and bad faith conduct of Opposer's counsel, the Board summarizes the relevant history of these proceedings and the parties' correspondence, as shown in the following table:

Periods during which Proceedings were Suspended	**Applicant's counsel's correspondence to Opposer's counsel**	**Opposer's counsel's correspondence to Applicant's counsel**
Opposer served discovery on Applicant, September 14, 2018; **Applicant produced documents to Opposer on October 15, 2018**, 26 TTABVUE 10		
December 3, 2018 Suspended; Applicant's motion to compel production of Opposer's documents in the U.S., not inspection in Switzerland (and Opposer's motion to extend		

[6] Counsel for Opposer's conduct is attributable to Opposer as a party. *See, e.g., Link v. Wabash Railroad*, 370 U.S. 626 (1962); *HighBeam Marketing, LLC v. Highbeam Research, LLC*, 85 USPQ2d 1902, 1906 (TTAB 2008); *Syosset Laboratories, Inc. v. TI Pharmaceuticals*, 216 USPQ 330 (TTAB 1982); and *Williams v. The Five Platters, Inc.*, 510 F.2d 963, 184 USPQ 744 (CCPA 1975), *aff'g* 181 USPQ 409 (TTAB 1974).

time to serve expert disclosures)		
		1-Emailed **first deficiency letter** dated December 5, 2018, 42 TTABVUE 84, regarding Applicant's responses to both interrogatories and requests for production of documents, including Req. Nos. 26, 27, 28, 30, 32, 33, 34, 36, 37, 38, 39, 41, 44, 46, and 51
July 14, 2019 Resumed; Applicant's motion to compel granted		
July 15, 2019 Suspended; Opposer's separate motions for partial reconsideration and to compel; as to requests for production of documents, **Opposer's motion to compel concerned only Applicant's response to Request No. 30 and a request to organize and label already-produced documents**, 26 TTABVUE 10-12		
December 26, 2019 Resumed; Motion for Partial Reconsideration denied; **Opposer's first motion to compel denied** with respect to **Request no. 30, finding it "overly broad, vague and burdensome**," 34 TTABVUE 12; but, granted in part regarding Interrogatory no. 10, requiring Applicant to produce **sufficient documentation in Applicant's possession, custody or control showing sales revenue from "[Applicant's] licensing of watches and jewelry** … over the five years preceding the filing of the notices of opposition," 34 TTABVUE 10, and as to also granted **as regards its Interrogatory Nos. 4, 30 and 32, i.e., to**		

specify which documents are responsive to these three interrogatories and the particular location thereof in the documents already provided to Opposer		
	Emailed letter dated January 31, 2020, 51 TTABVUE 52, clarifying interrogatory responses pursuant to Board's 12/26/2019 order	
		2-Emailed letter dated February 3, 2020, 51 TTABVUE 54, seeking contact info of watch and jewelry licensees per order and index of documents
		3-Emailed letter dated February 6, 2020, 51 TTABVUE 56, **repeats 2/3/2020 letter**
	Emailed letter dated February 10, 2020, 51 TTABVUE 58, **responding to Opposer's letters dated 2/3, [2/5], 2/6 and [2/7]**, providing addresses of licensees for 5 years prior to opposition	**4, 5** [2/5 and 2/7 letters][7]
	Emailed letter dated February 11, 2020, 51 TTABVUE 60, objecting to date of 30(b)(6) deposition, to **Opposer's NEW request for numerous documents requested for deposition in less than 30 days**, and to several topics of deposition	

[7] Dates in brackets indicate correspondence not included with Applicant's motion.

	Emailed letter dated February 13, 2020, 51 TTABVUE 62, **producing chart that groups documents to particular document requests**; all "are responsive to Req. No. 2"; and setting forth addresses of all former licensees of jewelry and/or watches; Index at 51 TTABVUE 64	
February 17, 2020 Suspended; Opposer files **second motion to compel** to obtain contact information for licensees and an address for one licensee, per Board's previous order, **and "the employee at the licensee who has the most knowledge of such promotion"**		
		6-Emailed letter dated February 20, 2020, 51 TTABVUE 65, stating in part "no requirement to discuss deposition notice … beforehand"; maintains that noticed topics for dep. are proper
March 4, 2020, Opposer's **inspection of 2500 documents** at Applicant's headquarters in Mississippi		
	Emailed letter dated March 9, 2020, 51 TTABVUE 69, maintaining objections to depositions and that requested documents have been produced at recent inspection in MS	
March 13 2020, **discovery depositions** of Applicant's witnesses, Jesse Raley and Cindy Reed, in West Point, Mississippi		**7**-Emailed **2nd deficiency letter** dated March 20, 2020, 51 TTABVUE 70, asserting that no documents have been previously produced for 2018 Req. Nos. 2, 32, 33, 36, 37, 41, 44, 46, 47, and 56 (see Supp. Index 51 TTABVUE 73)

PANDEMIC SHUTDOWN 		**8**-Emailed **3rd deficiency letter** dated March 24, 2020, 51 TTABVUE 75, stating **26 different deficiencies exist** in document production as **raised by deposition**
	Email dated March 24, 2020, 51 TTABVUE 74, stating counsel has received deposition transcripts and 3/24/2020 letter; will respond as soon as possible given circumstances	
	Emailed letter dated March 31, 2020, 51 TTABVUE 78, responding to Opposer's 3/20 & 3/24 letters; explained difficulty in obtaining documents during pandemic; will stipulate to extend discovery as necessary	
		9-Emailed letter dated April 8, 2020, 51 TTABVUE 79, **asserting missing license agreements given date discrepancies at deposition**
	Emailed letter dated April 21, 2020, 5 TTABVUE 82, objecting to "haphazard" prying and poking for additional documents; questioning purpose of need for expired license agreements; provides additional information on licensees (past & present)	
		10-Emailed letter dated April 24, 2020, 51 TTABVUE 85, discussing status of information on licensees; document production remains insufficient (referring to 3/20 & 3/24 letters); **requests additional information on consumer complaints**
	Emailed letter dated May 1, 2020, 51 TTABVUE 89, responding to letters of 3/20, 3/24 and 4/24, explaining delay due to pandemic, and problem that search retrieved over **11,000 emails with**	

	licensees, many of which are not relevant; **objects to repeated letters which cause confusion**	
		11-Emailed letter dated May 8, 2020, 51 TTABVUE 91, noting that discovery matters pending before suspension must be addressed and that **Mississippi (MS) "Safer at Home" order ends 5/11, with copy of state order**
		12-Emailed letter dated May 11, 2020, 51 TTABVUE 98, noting that **MS "Safer at Home" order ends 5/25**
		13-Emailed **4th deficiency letter** dated May 15, 2020, 51 TTABVUE 99, explaining **new objections to previously produced documents**, asserting that some are not responsive or do not refer to MOSSY OAK
	Emailed letter dated May 22, 2020, 51 TTABVUE 104, responding to letter of 3/20, addressing document Req. Nos. 2, 32, 33, 36, 37, 41, 44, 46, 47 and 56; **serves additional documents**	
	Emailed letter dated May 22, 2020, 51 TTABVUE 106, responding to letter of 3/24, stating that **many requested documents were made for the first time after the deposition** and responding to each concern	
		14-Emailed letter dated June 2, 2020, 51 TTABVUE 109, re Applicant's 1st 5/22 letter, **objecting again to Applicant's responses to document req. nos. 33, 36, 37, 41, 44, 46, 56** (repeat of no. 7 supra); insists that Applicant has not provided documents as promised; **wants "retail distribution points"; wants**

		documents sufficient to show promotional spending over last 5 years; and documents supporting allegations
		15-Emailed letter dated June 4, 2020, 51 TTABVUE 113, re Applicant's 2nd 5/22 letter; **accuses Applicant of misleading Opposer; and wants documents concerning the design and approval process for licensees' watches and jewelry**, press releases, all other catalogs, and **communications between Applicant and licensees concerning advertising & promotion**; discrepancies re who are past versus present licensees; details re licenses; "**will review" just- produced documents to see if sufficient**; follow-up questions to responses during the deposition; re no. 26: **wants drawings or representations of licensees' watches or jewelry sent to Applicant**
	Emailed letter dated June 19, 2020, 51 TTABVUE 118, responding to 6/2 and 6/4 letters: asserts that Opposer's letters comprise duplicate deficiencies or concerns; **no complaints about 2500 documents at time of inspection or prior to depositions**; Opposer used only 9[8] exhibits during depositions; production of electronic discovery is overly burdensome; advises that will respond to no more deficiency letters	

[8] Applicant's counsel points out in his letter that 2 of the exhibits were the Federal Rules of Civil Procedure and the notices of deposition. 51 TTABVUE 19.

6/27/2020 Resumed; Opposer's motion to compel granted in part; the Board noted: "**Opposer is requesting more that it asked for in the interrogatory and more than the Board ordered** …" 41 TTABVUE 4; both parties found to be "intransigent and uncooperative" *Id.*	[June 26, 2020 Letter]	
	Emailed letter dated June 30, 2020, 51 TTABVUE 123, confirming that it complied with Board's order with Applicant's letter mailed 5/22/2020	
	Emailed letter dated July 2, 2020, 51 TTABVUE 124; **provided additional documents**	
	Emailed letter dated July 6, 2020, 51 TTABVUE 125; objected to **service of third-party witness deposition notices (subpoenas) while proceedings were suspended**, scheduling of licensees **in-person depositions** without consulting with Applicant's counsel, **ex parte contact with expert witness**, and problems with service of subpoena and payment of expert witness	
		16-Emailed letter dated July 6, 2020, 51 TTABVUE 128, response to 7/6 letter, disputing Applicant's concerns re expert witness, etc.
		17-Emailed letter dated July 7, 2020, 42 TTABVUE 134, responding to Applicant's 6/19/2020 letter with respect to its responses to Opposer's production requests
		18-Emailed letter dated July 9, 2020, 51 TTABVUE 131, **requesting confirmation that contacts**

		at licensees are "current" and if there are any other contacts
	Emailed letter dated July 13, 2020, 51 TTABVUE 137, objections to scheduled in-person deposition and to scope of documents requested	
		19-Emailed letter dated July 15, 2020, 15 TTABVUE 140, **requesting index** for additional documents served
	Emailed letter dated July 13, 2020, **producing additional documents, i.e., emailed communications between Applicant and its licensees**, 51 TTABVUE 139	
	Emailed letter dated July 20, 2020, 51 TTABVUE 142, responding to 7/9 letter	
	Emailed letter dated July 20, 2020, 51 TTABVUE 142, responding to 7/13 letter	
	Emailed letter dated July 20, 2020, 51 TTABVUE 144, responding to 7/15 letter; reiterating that Applicant has **responded fully** to Opposer's discovery and that Opposer seeks production of documents not proportional or within original requests; **documents organized by licensee and relate to Req. Nos. 33, 44 & 56**	
8/11/2020 Suspended; Opposer files combined third motion to compel (comprising 3 motions)		
		20-Emailed letter dated August 14, 2020, 51 TTABVUE 146, requesting information pertaining to expert witness deposition
		21-Emailed letter dated August 25, 2020, 51 TTABVUE 147, **repeating concerns of Opposer's 5/15 letter**

The record of these proceedings shows that Opposer, through its counsel, has overly burdened Applicant's counsel and misused the Board's resources by:

- requiring Applicant's counsel to inspect documents in Switzerland, which required Applicant to file a motion to compel to obtain documents from Opposer;[9]
- repeatedly corresponding to Applicant's counsel about different and often duplicative discovery issues and addressing concerns piecemeal over a period of several months such that the concerns to be addressed were often unclear, 51 TTABVUE 70, 75, 79, 85, 89, 99, 106, 118, 131, 135, 143, 144, 146, 147;
- failing to cooperate during discovery by requesting additional documents and information that are not proportional to these proceedings, such as Applicant's agreements with former licensees, 51 TTABVUE 82, and obtaining advertising proposed (but not used) by licensees, as well as representations of proposed jewelry or watches sent to Applicant, 52 TTABVUE 113-116;
- failing to cooperate during discovery by asserting new alleged deficiencies in and demands related to previously served discovery responses and depositions, 51 TTABVUE 75 (e.g., nos. 1, 4, 5, 14, 23), 79, 82, 85, 99, 113-115 (e.g., nos. 4, 8, 11, 26),[10] 131, 136, 142, 144;

[9] Opposer's demand was denied by the Board in its order on Applicant's motion to compel issued on July 14, 2019, 24 TTABVUE 12.

[10] By way of example, based on Opposer's Request for Production No. 33 ("all communications between Applicant and any entity that has been engaged to promote Applicant's goods under Applicant's Mark," 42 TTABVUE 27), Opposer demanded that Applicant produce "documents concerning the design and approval process for licensees' watch and jewelry products," 113 TTABVUE 1; "Documents concerning the approval process for licensees' advertisements and

- failing to coordinate with Applicant's counsel regarding the scheduling of third-party witness discovery depositions after Applicant's counsel informed Opposer's counsel that he preferred to be consulted prior to service of notices of deposition, 51 TTABVUE 60, 125;
- repeating demands regarding production of documents even though Applicant's counsel had previously addressed the demands, e.g., in connection with Request for Production Nos. 36 and 37, 42 TTABVUE 28, Applicant explained that it is its licensees that advertise MOSSY OAK products, and that the licensees have possession of most advertising, as well as information on "retail distribution points," 51 TTABVUE 53, 104-105, 106-107 and 118;
- seeking and/or serving subpoenas on a third-party witness for conducting an out-of-state in-person deposition during a pandemic, 51 TTABVUE 125, 133, 149;
- demanding that Applicant produce difficult to find electronically-stored documents within over 11,000 documents found, 51 TTABVUE 89, 104, 114, 118;
- badgering Applicant's counsel regarding when additional documents should be produced by sending Applicant's counsel pandemic "safer at home" information for the state where Applicant and its counsel are located, 51 TTABVUE 91, 98,

promotions," *id.* at 114; and "Communications between Haas and its watch and jewelry licensees concerning the licensing process and product approval," *id.* at 115. Notably, Opposer has never sought relief from the Board in connection with Request No. 33, which the Board finds to be overly burdensome and vague.

notwithstanding Applicant's correspondence requesting additional time, 51 TTABVUE 74, 78;

- filing an unnecessary second motion to compel about a single issue, which unnecessarily suspended the forward progress of these cases, 26 TTABVUE and 41 TTABVUE 4;
- making *ex parte* contact with Applicant's expert witness and requesting consultation regarding electronically-stored information under the guise that Opposer's counsel is allowed to do so under Fed. R. Civ. P. 26(b)(4)(C), 51 TTABVUE 125, potentially in violation of Patent and Trademark Office Rule 11.402(a)[11]; and,
- notwithstanding (i) the Board's admonition to both parties to cooperate, set forth in its order on Opposer's second motion to compel (issued June 27, 2020, 41 TTABVUE 4), and (ii) Applicant's counsel correspondence (dated May 1, 2020, and June 19, 2020, 51 TTABVUE 89, 118) demanding that Opposer's barrage of correspondence cease, Opposer's counsel continued to harass Applicant's counsel by sending six individual letters *seriatim* regarding discovery, which could have been included in a single letter. 51 TTABVUE 131, 135, 136, 140, 146, and 147.

Clearly, Opposer, through its counsel, has not made a good faith effort to seek only discovery from Applicant that is relevant to the specific issues of this case or to seek discovery in a manner that facilitates actual resolution of discovery issues. Applicant

[11] The Board makes no decision on this issue.

produced documents in response to Opposer's requests for production of documents on at least seven occasions during these proceedings,[12] viz., on October 15, 2018, within 30 days of service of Opposer's discovery; on March 4, 2020, at Opposer's inspection of Applicant's documents; on May 22, 2020, in response to Applicant's March 20, 2020 correspondence; and on June 26, July 2, July 10, and July 13, 2020, 51 TTABVUE 142, in response to Opposer's previous correspondence seeking Applicant's emailed correspondence with its licensees. Yet, rather than addressing Applicant's documents in a comprehensive manner as they were produced, Opposer addressed the asserted deficiencies by taking a piecemeal approach, by sending repetitive and sometimes condescending or disparaging correspondence, by failing to promptly inform Applicant's counsel of Opposer's concerns with inspected documents, including those provided prior to the depositions of Applicant's witnesses, by failing to discuss timing of depositions in advance with Applicant's counsel during a pandemic, and by relentlessly pursuing documents from Applicant that are in the hands of third parties. In view of the foregoing, when viewing the totality of circumstances, the Board concludes that Opposer, through its counsel, has failed to comply with its obligation to cooperate during discovery. *See Emilio Pucci Int'l BV v. Sachdev*, 118 USPQ2d at 1385 (parties have affirmative duty to cooperate in the discovery process); *Cadbury UK Ltd. v. Meenaxi Enter., Inc.*, 115 USPQ2d 1404, 1408 (TTAB 2015) (parties expected to demonstrate good faith and cooperation during discovery; party cannot avoid discovery obligations due to an obvious typographical

[12] In connection with its request for an index, Opposer's motion to compel refers to production on June 26, July 2, July 10, and July 13, 2020. 42 TTABVUE 10.

error in discovery requests); *Panda Travel Inc. v Resort Option Enterp., 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.

Further, in these proceedings and in other Board proceedings, the Board has admonished Opposer for its repetitive, premature, burdensome, or unnecessary submissions to the Board. 51 TTABVUE 20, 33-35, 45. "The Board cannot ignore its past experience with [Opposer and Opposer's counsel] and considers the bad-faith actions taken in this case against that backdrop." *See Central Mfg. Inc. v. Third Millennium Tech. Inc.*, 61 USPQ2d 1210, 1215 (TTAB 2001).

When reviewing the record as a whole, the Board also finds that Applicant has clearly demonstrated good cause for a protective order against further correspondence from Opposer's counsel, Opposer's discovery requests, or Opposer's motions related to discovery. In particular, Opposer, through its counsel, has failed to inform Applicant as to Opposer's discovery concerns in a reasonable number of correspondence; rather, Opposer, through its counsel, has barraged and harassed Applicant's counsel over a period of seven months with a series of disjointed and repetitive letters, some with disproportional discovery demands. Accordingly, Applicant's combined motion for a protective order and for sanctions is **GRANTED** to the following extent. Specifically, under Trademark Rule 2.120(g), 37 C.F.R. § 2.120(g), and the Board's inherent authority to sanction, to protect the integrity of the judicial process, and to manage its docket, it is **ORDERED** that:

- Opposer has waived any further objections to Applicant's responses to Opposer's discovery;
- Applicant's responses to Opposer's discovery requests are sufficient;
- Opposer is prohibited from serving any additional discovery or discovery-related motions on Applicant; and
- The discovery period in these proceedings is hereby **CLOSED**.[13]

Additionally, Opposer is advised that should it, through its counsel, recommence the dilatory and bullying pattern of conduct discussed in this order during the remainder of these proceedings, this order and past conduct will be considered should Applicant file a motion for sanctions. Further, future sanctions may include, inter alia, requiring under Trademark Rule 2.120(j)(2), 37 C.F.R. § 2.120(j)(2), that Opposer's counsel meet with a panel of Administrative Trademark Judges for a pretrial conference, *see, e.g., General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591 n.5 (TTAB 2011) ("where the Board identifies overly contentious advocacy or the potential for the creation of excessive records, it may in the future exercise its authority under Trademark Rule 2.120(j)(2) to order a pretrial conference in person at the office of the Board"), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential), TBMP § 413.02; or entry of judgment. *See, e.g., SFM, LLC v. Corcamore, LLC*, 129 USPQ2d at 1079

[13] The discovery and trial schedule was last reset by the Board in its order mailed June 27, 2020, 41 TTABVUE, on Opposer's second motion to compel in this proceeding. Discovery was set to close on August 27, 2020. 41 TTABVUE 5. As noted supra, on August 11, 2020, Opposer filed its third motion to compel. Therefore, only 16 days remained in the discovery period when Opposer filed its third motion to compel.

("Respondent's conduct indicates that entry of any sanction short of judgment would be futile. It is obvious from a review of the record that Respondent has been engaging for years in delaying tactics, … taxing Board resources and frustrating Petitioner's prosecution of this case."); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1854 (TTAB 2000) (granting judgment as a sanction under Trademark Rule 2.120(g)(1) where "applicant and its counsel have engaged in a pattern of dilatory tactics, have purposely avoided applicant's discovery responsibilities in this case, and have willfully failed to comply with the Board's ... order.").

II. Opposer's Combined Motions to Compel and to Reset Discovery, Disclosure and Trial Dates

Opposer has submitted essentially three motions to compel in its combined motion, seeking to obtain an order: (1) addressing allegedly deficient document production to Opposer's Document Request Nos. 34,[14] 36,[15] 37,[16] and 41[17]; (2) ordering Applicant to explain a discrepancy regarding whether AVT Leather is a current licensee; and (3) ordering Applicant to provide an index or correspondence table for

[14] Doc. Req. No. 34: "Each press release issued by Applicant which refers to Applicant's Mark." 42 TTABVUE 28, 45 (the two different pages indicate the two sets of requests for production served for each proceeding prior to consolidation).

[15] Doc. Req. No. 36: "All advertisements in any publication concerning Applicant's Mark." *Id.*

[16] Doc. Req. No. 37: "All documents and things sufficient to identify each retail distribution point through which goods under Applicant's Mark are provided." *Id.*

[17] Doc. Req. No. 41: "All documents sufficient to identify the unit and dollar sales of each good offered in connection with Applicant's Mark annually by calendar year from Applicant's first use of the Applicant's Mark to the present." *Id.* at 29, 46.

documents produced on June 26, July 2, July 10, and July 13, 2020, under Fed. R. Civ. P. 34(b)(E)(i).[18]

As a threshold matter, the Board must determine whether Opposer has made a sufficient showing under Trademark Rule 2.120(f)(1), 37 C.F.R. § 2.120(f)(1), that Opposer or its attorney has made a good faith effort, by conference or correspondence, to resolve with Applicant or its attorney the issues presented in the motion, but the parties were unable to resolve their differences.

In addition to the facts set forth in the section of this order related to Applicant's combined motion for protective order and construed motion for sanctions, the Board notes the following:

- On May 22, 2020, Applicant responded to Opposer's previous correspondence in two letters, 51 TTABVUE 104-105, 106-107, regarding the four document requests with which Opposer is concerned in its combined motions to compel, namely, Req. Nos. 34, 36, 37 and 41, in which Applicant stated, inter alia, that it already produced the nine press releases related to watches or jewelry (Req. No. 34, ¶ 3, 51 TTABVUE 106); Applicant has already produced samples of advertising in publications (Req. No. 36, 51 TTABVUE 104); Applicant has no documents regarding retail distribution points (Req. No. 37, 51 TTABVUE 105) or promotional materials (¶ 6, 51 TTABVUE 107)), both of which are in the hands of

[18] Opposer submitted copies of its requests for production of documents for each proceeding, along with Applicant's responses thereto, as required under Trademark Rule 2.120(f)(1), 37 C.F.R. § 2.120(f)(1).

Applicant's licensees; and that it has provided documentation on the units sold and sales (royalties) data (Req. No. 41, 51 TTABVUE 105);

- In Applicant's correspondence of May 22, 2020, 51 TTABVUE 107, Applicant informed Opposer that "AVT Leather is still an active licensee," *id.*, ¶ 11;
- Notwithstanding the foregoing correspondence from Applicant's counsel, Opposer argues in its June 2, 2020 correspondence that Applicant's counsel is "misleading" Opposer's counsel regarding documents responsive to Request Nos. 33, 36, 37, 41, 44, 46, and 56, 51 TTABVUE 109-111;
- Opposer sent another letter on June 4, 2020, arguing that production regarding Request No. 33 and other matters remain unresolved, 51 TTABVUE 31;
- Applicant responded to Opposer's June 4, 2020 letter on June 19, 2020, setting forth again Applicant's objections to Req. Nos. 33, 36 and 41, repeating that documents related to Req. Nos. 37, 41, 44, 46, and 56 have been previously produced, 51 TTABVUE 118-122;
- On July 9, 2020, Opposer requested confirmation that the licensee contact information previously provided is "current" and that the identified contact is the only person with whom Applicant contacts for each licensee, 51 TTABVUE 131;

- Applicant's counsel reiterated in its letter dated July 20, 2020, that all documents were produced in response to Req. Nos. 33, 44 and 56, 51 TTABVUE 144;
- In Opposer's letter dated August 24, 2020, it repeated concerns set forth in its May 15, 2020 letter, 51 TTABVUE 99, asserting that documents are not responsive. 51 TTABVUE 147.

The foregoing correspondence shows that by May 22, 2020, Applicant had responded fully to Opposer's document request Nos. 34, 36, 37 and 41, and to the inquiry regarding AVT Leather. Applicant also responds to Opposer's motion by stating that it can furnish no further press releases or documents on specific stores or retail outlets. 52 TTABVUE 3, 4. Nonetheless, Opposer, through its counsel, apparently, does not accept Applicant's responses. Opposer's conduct, through its counsel, is untenable. Merely because Opposer did not obtain the specific documents it wanted does not mean that Applicant has not been responsive. In fact, in this instance, the Board finds that Applicant has substantially complied with Opposer's discovery requests.[19] In particular, with respect to document request No. 41, the Board finds that the table of jewelry and royalties paid to Applicant shown at "HAAS 001218,"[20] together with the royalty reports served on Opposer, see, e.g., 52 TTABVUE 22-24, satisfy the request for "documents sufficient to identify the unit and dollar sales of each good offered in connection with Applicant's Mark." *Cf. Candor*

[19] See also 52 TTABVUE 3, regarding production of press releases. Applicant reiterates in its response that it has no additional press releases other than those already produced.

[20] Confidential Exh. 25, 54 TTABVUE 2.

Hosiery Mills, Inc. v. Int'l Networking Group, Inc., 35 F.Supp.2d 476, 477-78 (M.D. N.C. 1998) (calculating sales based on sum of royalties owed under licensing agreements). Further, Applicant is not obligated to create responsive documents solely to satisfy Opposer's discovery requests. *See Washington v. Garrett*, 10 F.3d 1421, 1437-38 (9th Cir. 1993). Similarly, a party cannot be compelled to produce a document that it does not have. *See Ogden v. Bumble Bee Foods, LLC,* 292 F.R.D. 620, 628 (N.D. Cal. 2013) ("Absent evidence that [the responding party] is withholding documents in its possession, the court cannot issue an order compelling [the responding party] to produce documents it states it does not have."). Moreover, the Board only previously ordered Applicant to provide "sufficient documentation in its possession, custody or control showing sales revenue" from Applicant's licensing. 34 TTABVUE 10. Applicant clearly has provided the documents it has in its possession, custody or control, or has provided to Opposer what Applicant has received from its licensees.

Finally, as regards Opposer's motion that Applicant be required to provide an index of documents served, the record indicates that in addition to producing two tables earlier in the proceedings, 42 TTABVUE 98, 99, Applicant also served the documents at issue as they are kept in the usual course of business. 51 TTABVUE 144; 52 TTABVUE 7. This is all that Fed. R. Civ. P. 34(b)(2)(E)(i) requires. Additionally, in at least one letter, Applicant's counsel matched produced documents (by Bates number) to the particular document requests. See, e.g., 51 TTABVUE 104,

144. Therefore, the Board finds this demand, under the totality of the circumstances discussed herein, to be overreaching.

In view of the foregoing, the Board finds that Opposer has failed to make a sufficient showing that it sought to resolve the identified issues in good faith before filing a motion to compel. Opposer has also failed to demonstrate that any of its motions to compel should be granted on the merits. Accordingly, Opposer's combined motions to compel are **DENIED**.

Additionally, because the Board has closed discovery in these proceedings, Opposer's motion to reset the discovery period, disclosure due dates and the trial schedule, 42 TTABVUE 3, is moot.

III. Proceedings Resumed; Trial Dates Reset

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

Plaintiff's Pretrial Disclosures Due	**3/23/2021**
Plaintiff's 30-day Trial Period Ends	**5/7/2021**
Defendant's Pretrial Disclosures Due	**5/22/2021**
Defendant's 30-day Trial Period Ends	**7/6/2021**
Plaintiff's Rebuttal Disclosures Due	**7/21/2021**
Plaintiff's 15-day Rebuttal Period Ends	**8/20/2021**
Plaintiff's Opening Brief Due	**10/19/2021**
Defendant's Brief Due	**11/18/2021**
Plaintiff's Reply Brief Due	**12/3/2021**
Request for Oral Hearing (optional) Due	**12/13/2021**

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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