

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

December 11, 2019

Opposition No. 91244034

Sean Griffin and GriffinWorx, Inc.

v.

*Fenox Venture Capital, Inc.
DBA Fenox Venture Capital*

J. Krisp, Interlocutory Attorney:

This proceeding is before the Board for consideration of Opposer's August 7, 2019 motion to compel discovery, and September 16, 2019 motion for a protective order. The motion to compel is fully briefed.

Motion for Protective Order

Opposer's motion is granted as conceded pursuant to Trademark Rule 2.127(a). The motion is also granted as meritorious. Applicant served discovery the requests at issue on August 15, 2019, after the proceeding was suspended pursuant to Trademark Rule 2.120(f)(2). 8 TTABVUE 1; 11 TTABVUE 3, 9-35. Service of the discovery was untimely and improper. Opposer need not serve responses thereto.

Motion to Compel

Trademark Rule 2.120(f)(1) sets forth the special requirements for a motion to compel. TBMP §§ 523.02 - 523.03 (June 2019). Opposer's motion is timely, and it

includes a copy of the relevant discovery requests, as well as Applicant's responses and objections thereto.

The Board finds that by way of email and summaries of conferences held, Opposer satisfied the requirement to make a good faith effort to resolve the issues presented in the motion to compel prior to seeking the Board's intervention. Trademark Rule 2.120(f). Also, Opposer served the discovery requests at issue appropriately early in the discovery period such that responses thereto were due no later than the close of discovery. Trademark Rule 2.120(a)(3); TBMP § 413.02; *Estudi Moline Dissey, S.L. v. BioUrn Inc.*, 123 USPQ2d 1268 (TTAB 2017).

Lastly, inasmuch as this opposition involves the sole claim of likelihood of confusion under Section 2(d), and after thorough review of Opposer's discovery requests, the Board finds that the discovery is proportional to the issues in this proceeding. Fed. R. Civ. P. 26(b)(1); Trademark Rule 2.120(a)(1).

In its motion, Opposer seeks an order compelling Applicant to serve responses or supplemental responses to: Request for Production Nos. 1, 2, 3 and 4; and Interrogatory Nos. 2, 3, 4, 6, 8, 14, 19 and 20. In its reply brief, Opposer argues that with respect to Requests for production, and Interrogatory Nos. 2, 4, 6 and 8, Applicant admits in its brief that its responses and document production were limited and/or agrees to supplement. 11 TTABVUE 2-3. Indeed, Applicant states in its brief that it can perform a new or additional search for documents and produce documents which satisfy several requests and/or will supplement its responses. 10 TTABVUE 4-6.

The Board finds that the discovery Opposer seeks is relevant and discoverable, and that Applicant's responses were insufficient or unresponsive. Accordingly, Opposer's motion is granted with respect to Request for Production Nos. 1, 2, 3 and 4, and Interrogatory Nos. 2, 4, 6 and 8.

Opposer notes that the discovery requests that remain at issue in its motion are Interrogatory Nos. 3, 14, 19 and 20.

With regard to Interrogatory No. 3, Opposer seeks details of the circumstances surrounding clearance, selection and adoption. Applicant's response is deficient because, at a minimum, it does not include information regarding its selection, clearance and adoption. The response only generally references use of a third party for conducting a selection campaign which neither the response nor the accompanying documents further explain, and the document merely references a "sample image" about which Applicant provided no information that would be responsive to this interrogatory. Based on these findings, Opposer's motion to compel is granted.

With respect to Interrogatory Nos. 14 and 19, Applicant identified, in an earlier interrogatory, an individual, Harumi Akimoto, of Pegasus Tech Ventures, as a person who may be called to testify on its behalf. Applicant's responses and documents show, on their face, a discrepancy with respect to the information requested - the relationship between Applicant and Pegasus Tech Ventures. Opposer's summary of matters discussed during the parties' conference reflects generally that it discussed this matter, and Applicant's repeated argument that Opposer has not shown how the documents produced contradict Applicant's answers is untenable. 10 TTABVUE 6-7;

11 TTABVUE 5-6. As Opposer notes, Applicant's responses and produced documents are unclear as to whether Pegasus Tech Ventures is the Applicant itself by change of name, is a different entity owned by Applicant, or is a successor in interest to Applicant. The Board finds Applicant's responses to be, at a minimum, inconsistent and unclear, and therefore insufficient. Based on these findings, Opposer's motion to compel is granted.

With respect to Interrogatory No. 20, Applicant's objection on the ground that the interrogatory includes two subparts is overruled. Subject to the prescribed limit, a party to a Board proceeding may serve requests that have subparts. Trademark Rule 2.120(d); TBMP § 405.03(a). As for the repeated objection based on relevance, Harumi Akimoto of Pegasus Tech Ventures is an intended witness for Applicant, and the relationship between Applicant and these entities is at issue. Information regarding the potentially related mark or version of the involved mark that Applicant may be presently using is sufficiently relevant, and the interrogatory is reasonably calculated to lead to the discovery of admissible evidence. Opposer's interrogatory seeks information supporting Applicant's anticipated contention that the marks are the same or substantially the same, an inquiry that is relevant to this matter. Based on these findings, Opposer's motion is granted.

In summary, Opposer's motion to compel is granted. Applicant is allowed until **twenty (20) days from the date of this order** to serve supplemental responses to Request for Production Nos. 1, 2, 3 and 4; and Interrogatory Nos. 2, 3, 4, 6, 8, 14, 19

and 20, to include its production of documents in supplementation to its responses to document requests that correlate with or support its answers to the interrogatories.

In the event that Applicant fails to serve responses as directed herein, a remedy lies in a motion for sanctions, as appropriate, pursuant to Trademark Rule 2.120(h)(1). In particular, under certain circumstances, a party may be barred by its own objections or responses from later introducing or relying on the information sought in the request as part of its evidence on the case. Similarly, a party that fails to provide information, or provides an untimely supplement, may be precluded from using that information or witness at trial. Fed. R. Civ. P. 37(b)(2); TBMP § 527.01(e), and cases cited therein. The application of this preclusion sanction, lies within the Board's discretion. *Midwestern Pet Foods Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1439 (Fed. Cir. 2012).

Schedule

Proceedings are resumed. Discovery is extended for Opposer only, to allow for the service and review of Applicant's supplementation. Dates are reset as follows:

Discovery Closes	1/27/2020
Plaintiff's Pretrial Disclosures Due	3/12/2020
Plaintiff's 30-day Trial Period Ends	4/26/2020
Defendant's Pretrial Disclosures Due	5/11/2020
Defendant's 30-day Trial Period Ends	6/25/2020
Plaintiff's Rebuttal Disclosures Due	7/10/2020
Plaintiff's 15-day Rebuttal Period Ends	8/9/2020
Plaintiff's Opening Brief Due	10/8/2020
Defendant's Brief Due	11/7/2020
Plaintiff's Reply Brief Due	11/22/2020
Request for Oral Hearing (optional) Due	12/2/2020

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).