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Mailed: September 19, 2019

Opposition No. 91244593

Cytozyme Laboratories, Inc.

v.

JH Biotech, Inc.

Wendy Boldt Cohen, Interlocutory Attorney:

This case now comes up for consideration of Applicant's motion to compel discovery responses to its previously served requests for admission nos. 5 and 6, interrogatory nos. 3, 5, 6, 10-11, 26, 28-32, 34-37 and 40-42 and requests for documents nos. 2 and 8. *See* 7 TTABVUE. 2; 9 TTABVUE 4. The motion is fully briefed.¹

Preliminary Matter

Applicant's motion to compel seeks responses to requests for admission nos. 5 and 6.² The motion to compel procedure is not applicable to requests for admission. If a propounding party is dissatisfied with a responding party's answer or objection to a request for admission, and wishes to obtain a ruling on the sufficiency thereof, the

¹ The Board has considered the parties' submissions and presumes the parties' familiarity with the factual bases for the motion, and does not recount them here except as necessary to explain the Board's order. *See Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019-20 (TTAB 2015).

² Although Applicant's reply brief does not reiterate its request for responses to the noted requests for admission, inasmuch as Applicant has not expressly removed the requests for admission from the parties' dispute, the Board has addressed the matter in this order.

propounding party may file a motion with the Board to determine the sufficiency of the response or objection. *See* Fed. R. Civ. P. 36(a); Trademark Rule 2.120(i).

In view thereof and to the extent requests for admission nos. 5 and 6 remain in dispute, the motion is **denied** as it pertains to Applicant's requests for admission. *See* TBMP §§ 411.03 and 523.01 (2019) and authorities cited therein.

Compel

A motion to compel discovery must be supported by a written statement from the moving party that such party or its attorney has made a good faith effort, by conference or correspondence, to resolve with the other party or its attorney the issues presented in the motion, and has been unable to reach agreement. Trademark Rule 2.120(e); *see also* TBMP § 523.02 and authorities cited therein. "The good faith efforts of the parties should be directed to understanding differences and actually investigating ways in which to resolve the dispute." *Hot Tamale Mama ... and More, LLC v. SF Invs., Inc.*, 110 USPQ2d 1080, 1081 (TTAB 2014); *see MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 953 (TTAB 1979). "In determining whether a good faith effort to resolve the discovery dispute has been made, the Board may consider, among other things, whether the moving party has investigated the possibility of resolving the dispute, whether, depending on the circumstances, sufficient effort was made towards resolution, and whether attempts at resolution were incomplete." TBMP § 523.02. "Where it is apparent that the effort toward resolution is incomplete, establishing the good faith effort that is a prerequisite for a motion to compel necessitates that the inquiring party engage in additional effort

toward ascertaining and resolving the substance of the dispute.” *Hot Tamale Mama*, 110 USPQ2d at 1081.

In support of Applicant’s efforts to resolve the parties’ dispute in good faith, Applicant asserts that it corresponded with Opposer on April 5, 2019 “highlighting the inadequacies of Opposer’s responses.” 7 TTABVUE 6. On April 30, 2019, Opposer communicated with Applicant about Opposer’s purported deficiencies and noted that Opposer would need additional time to supplement its responses. 8 TTABVUE 4. On May 3, 2019, the same day the motion to compel was filed, Opposer sent supplemental responses to Applicant. *Id.* On May 6, 2019, Applicant emailed Opposer indicating that it had received Opposer’s supplemental responses, was withdrawing some its objections and asserting some responses remain inadequate. 8 TTABVUE 56.

Based on the foregoing, it does not appear that Applicant provided Opposer with a meaningful opportunity to resolve the parties’ dispute prior to seeking Board intervention. Based on the parties’ filings, it is clear that Opposer was willing to discuss its purportedly deficient responses with Applicant. Further, upon receipt of Applicant’s letter of deficiency, Opposer noted that it would need additional time to supplement its responses and shortly thereafter, provided supplemented responses. The apparent lack of impasse indicates that Applicant should have, at a very minimum, further discussed the parties’ dispute before filing its motion to compel. The Board is not persuaded that Applicant made sufficient efforts to resolve the parties’ dispute prior to filing the motion to compel. In short, Applicant’s efforts toward resolution were incomplete and insufficient.

In view thereof, the Board hereby **denies** Applicant's motion to compel. *See* Trademark Rule 2.120(e)(1).

General Guidance

Notwithstanding the foregoing, the Board provides the following guidance:

A party may take discovery as to matters relevant to the claims or defenses raised in the pleadings. *See Mack Trucks, Inc. v. Monroe Auto Equip. Co.*, 181 USPQ 286, 287 (TTAB 1974). However, parties are expected to take into account the principles of proportionality with regard to discovery. *See Emilio Pucci International BV v. Sachdev*, 118 USPQ2d 1383, 1386 (TTAB 2016).

Objections to discovery requests must be specific to the requests for which the objections are being interposed. That is, in addition to posing the objection, the objecting party must explain why the objection applies to the discovery request at issue. *See* 8B Wright, Miller, Kane & Marcus, *Fed. Prac. & Proc. Civ. 3d* §§ 2173 and 2213 (Westlaw update 2019). As a consequence, very little, if any, consideration will be given by the Board to general objections or to a rote listing of objections. This is so because the Board cannot guess why a particular objection or set of objections may apply.

If a document request seeks "all documents" and production of same would be unduly burdensome, the responding party may provide a representative sample of the requested documents. *Frito-Lay North America Inc. v. Princeton Vanguard, LLC*, 100 USPQ2d 1904, 1910 (TTAB 2011); *cf. Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1720 (TTAB 1987).

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 Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147, 149 (TTAB 1985) (relevant to issues of likelihood of confusion and abandonment; response that these figures have been "substantial" is insufficient); *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975) (sales and advertising expenditures have bearing on registrability).

The parties are reminded that the purpose of discovery is to advance the case so that it may proceed in an orderly manner within reasonable time constraints. To this end, the parties must adhere to the strictures set forth in *Sentrol, Inc.* and repeated below:

[E]ach party and its attorney has a duty not only to make a good faith effort to satisfy the discovery needs of its opponent but also to make a good faith effort to seek only such discovery as is proper and relevant to the specific issues involved in the case. Moreover, where the parties disagree as to the propriety of certain requests for discovery, they are under an obligation to get together and attempt in good faith to resolve their differences and to present to the Board for resolution only those remaining requests for discovery, if any, upon which they have been unable, despite their best efforts, to reach an agreement. Inasmuch as the Board has neither the time nor the personnel to handle motions to compel involving substantial numbers of requests for discovery which require tedious examination, **it is generally the policy of the Board to intervene in disputes concerning discovery, by determining motions to compel, only where it is clear that the parties have in fact followed the aforesaid process and have narrowed the amount of disputed requests for discovery, if any, down to a reasonable number.**

231 USPQ at 667 (TTAB 1986) (emphasis added).

The Board expects the parties to cooperate with one another in the discovery process and looks with extreme disfavor on those who do not. *Id.*; see *Panda Travel Inc. v. Resort Option Enterprises, Inc.*, 94 USPQ2d 1789, 1791 (TTAB 2009); *Amazon Technologies Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009).

The parties are reminded that they have an ongoing duty to supplement or correct their discovery responses. See Fed. R. Civ. P. 26(e). If a party fails to disclose properly discoverable information or documents, that party may, upon timely objection from the other party, be precluded from using such information or documents at trial, unless such failure is substantially justified or is harmless. See Fed. R. Civ. P. 37(c)(1).

Dates

Proceedings are resumed and dates are reset as follows:

Expert Disclosures Due	October 26, 2019
Discovery Closes	November 25, 2019
Plaintiff's Pretrial Disclosures Due	January 9, 2020
Plaintiff's 30-day Trial Period Ends	February 23, 2020
Defendant's Pretrial Disclosures Due	March 9, 2020
Defendant's 30-day Trial Period Ends	April 23, 2020
Plaintiff's Rebuttal Disclosures Due	May 8, 2020
Plaintiff's 15-day Rebuttal Period Ends	June 7, 2020
BRIEFS SHALL BE DUE AS FOLLOWS:	
Plaintiff's Main Brief Due	August 6, 2020
Defendant's Main Brief Due	September 5, 2020
Plaintiff's Reply Brief Due	September 20, 2020

General Information

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).