

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
General Contact Number: 571-272-8500  
General Email: [TTABInfo@uspto.gov](mailto:TTABInfo@uspto.gov)

EJW

October 18, 2021

Opposition No. 91245118

*Audemars Piguet Holding SA*

*v.*

*Oakcoins*

**ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:**

**I. Background**

On August 24, 2020, the Board granted as uncontested Opposer's motion (filed May 29, 2020, 34 TTABVUE<sup>1</sup>) to compel responses to Opposer's requests for production of documents. 37 TTABVUE 2. Thereafter, on September 24, 2020, Opposer sought entry of judgment against Applicant as a sanction in view of Applicant's alleged failure to respond to the Board's compel order. 38 TTABVUE. On December 31, 2020, the Board denied Opposer's motion for sanctions, stating that (i) Applicant had tried to respond to Opposer's discovery as required; and (ii) Applicant

---

<sup>1</sup> 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.

had responded in full to Opposer's request for production no. 20, by which Opposer sought "all documents and things concerning Applicant's Mark." 41 TTABVUE 4-5 (referring to 30 TTABVUE 2-8, 32 TTABVUE 2, 35 TTABVUE 2-69, and 39 TTABVUE 2-4).

On January 28, 2021, Opposer filed another motion to compel responses to Opposer's interrogatories and requests for production of documents, 42 TTABVUE, which, on July 14, 2021, the Board denied with prejudice because the Board had previously determined that Applicant had tried to respond to Opposer's discovery as required and there was no reason for Opposer to submit yet another motion to compel, other than for harassment. 44 TTABVUE 2.

This case now comes up for consideration of Opposer's uncontested motion (filed July 30, 2021) for reconsideration of the Board's order issued on July 14, 2021. 45 TTABVUE.

## **II. Opposer's Motion for Reconsideration**

As an initial matter, although Applicant did not respond to Opposer's motion for reconsideration, the Board exercises its discretion to consider the merits of Opposer's motion, rather than granting said motion as conceded. *See* Trademark Rule 2.127(a). Additionally, the Board considers this proceeding to have been suspended since the filing date of Opposer's motion for reconsideration. *See* Trademark Rule 2.117(c).

### **A. 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. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 518 (2021).

### **B. Analysis and Order**

Opposer explains that in the Board order issued on August 24, 2020, the Board determined that Applicant had not responded to Opposer's requests for production of documents; the Board ordered Applicant to serve responses thereto, and informed Opposer that its remedy, should Applicant fail to serve discovery responses, was a motion for sanctions, including for entry of default judgment. 45 TTABVUE 3-4. Opposer asserts that "under no stretch of the imagination could Oakcoins' response to the default judgment motion be considered as responding in full to [Opposer's] production requests or answering its interrogatories, as the Board ordered." *Id.* at 4. Additionally, Opposer argues at length why Opposer's various discovery requests have not been responded to by Applicant, *id.* at 4-7; why Applicant did not respond fully to Opposer's request for production request no. 20 in particular, *id.* at 6; and asserts there has been no change to the status of Applicant's responses since the Board's August 24, 2020 order. *Id.* at 6. In view of Applicant's alleged failure to

respond to Opposer's requests for production of documents and interrogatories, Opposer argues that it was forced to file another motion to compel. *Id.* at 8.

**(1) Opposer's Requests for Production**

In its order issued on December 31, 2020, the Board addressed both Applicant's discovery responses to Opposer's previously served requests for production and Opposer's remedies in connection with those responses. 41 TTABVUE 4-6. In particular, regarding Applicant's responses, the Board concluded after considering the record, including documents at 30 TTABVUE 2-8, 32 TTABVUE 2, 35 TTABVUE 2-69, and 39 TTABVUE 2-4, that Applicant had tried to respond to Opposer's requests for production as required, 41 TTABVUE 4, meaning that the Board construed all of Applicant's submitted documents to be the entirety of responsive documents in Applicant's possession. Further, the Board determined that Applicant had responded in full to Opposer's overly broad and burdensome request for production no. 20, which sought "all documents and things concerning Applicant's mark." *Id.* at 5.

To be clear, based on the documents Applicant had previously submitted to the Board, including those served on Opposer,<sup>2</sup> the Board concluded that Applicant had satisfied its obligations vis-à-vis Opposer with respect to its requests for production of documents.<sup>3</sup> For that reason, the Board next addressed in the December 31, 2020

---

<sup>2</sup> Three of Applicant's four submissions at 30 TTABVUE, 32 TTABVUE and 39 TTABVUE include proof of service on Opposer's counsel. See 30 TTABVUE 2, 32 TTABVUE 3, and 39 TTABVUE 5.

<sup>3</sup> Where documents responsive to a request for production do not exist, the responding party is not obligated to create them. See *Washington v. Garrett*, 10 F.3d 1421, 1437-38 (9th Cir. 1993).

order Applicant's possible future discovery obligations as regards Opposer by specifically advising Applicant that it had a duty to supplement any previous responses and that it cannot rely at trial on any documents not previously provided to Opposer's counsel. 41 TTABVUE 5.

To the extent Opposer argues in its motion for reconsideration that Applicant's responses to Opposer's requests for production are inadequate, Opposer is not only arguing form over substance, but is also, in effect, arguing reconsideration of the Board's December 31, 2020 order in which the Board determined that Applicant had been sufficiently responsive to production request no. 20 and to all other requests, as discussed supra. 41 TTABVUE 4-5. In view thereof, as regards Opposer's requests for production of documents, Opposer's motion for reconsideration filed on July 30, 2021, is untimely because any objection to the Board's findings regarding Applicant's responses to Opposer's requests for production had to be submitted no later than January 30, 2021. *See* Trademark Rule 2.127(b).

Furthermore, to the extent it may be have unclear, the Board clarifies in this order that by stating in the December 31, 2020 order that Applicant's responses (i.e., documents) were responsive to Opposer's overly broad request no. 20, the Board concluded that Applicant had submitted all available documents.

In view of the foregoing, Opposer's submission of a second motion to compel regarding its requests for production was improper; therefore, there was no error in denying the second motion to compel with prejudice as regards Opposer's requests for

production. Accordingly, in regarding to Opposer's requests for production, the motion for reconsideration is **denied**.

**(2) Opposer's Interrogatories**

By Opposer's second motion to compel (filed January 28, 2021), which the Board denied with prejudice (i.e., the subject of Opposer's motion for reconsideration), Opposer sought an order compelling Applicant to respond all of its discovery requests without objection. 42 TTABVUE 5. With respect to Opposer's interrogatories only, the Board prematurely denied Opposer's second motion to compel because those discovery requests had not been specifically addressed in Opposer's first motion to compel or in the Board's order on the first motion to compel, other than by the Board's issuance of a scheduling order (deadline) to Applicant to respond to the interrogatories. 37 TTABVUE 3. Accordingly, with respect to Opposer's interrogatories only, the motion for reconsideration is **granted**; and the Board now reconsiders Opposer's second motion to compel only with respect to Opposer's interrogatories.

Upon further review of the record, the Board notes that on May 21, 2020,<sup>4</sup> Applicant filed its unsigned responses to Opposer's interrogatories with the Board, 32 TTABVUE 2-3; and that in an order dated May 27, 2020, the Board noted Applicant's submission of a series of statements numbered 1-38, indicating that the document might be Applicant's responses to Opposer's interrogatories. 33 TTABVUE 1.

---

<sup>4</sup> Applicant's submission to the Board may have been in response to Opposer's correspondence to Applicant emailed on May 21, 2020. 42 TTABVUE 37.

Notwithstanding the certificate of service on Applicant's submission indicating its service of the "answers" on Opposer's counsel, 32 TTABVUE 3, and the Board's order referring to same, 33 TTABVUE, Opposer, on the one hand, asserts that it never received Applicant's responses to its interrogatories. ¶¶ 6-12, 42 TTABVUE 3-4. Yet, on the other hand, Opposer mentioned Applicant's submission to the Board in its June 10, 2020 correspondence to Applicant, stating, "if your submission [was] intended to be interrogatory ... responses, please note that neither submission meets the procedural or substantive requirements for discovery responses under the rules." 42 TTABVUE 38.

On review of Opposer's correspondence to Applicant following Applicant's submission of its statements numbered 1-38, the Board notes that Opposer's counsel never explained to Applicant that its representative failed to sign its responses under oath, nor did Opposer explain that the responses were not in the usual format (i.e., setting forth the response after the interrogatory posed). 42 TTABVUE 38, 40, and 41. Opposer only stated, to a party not represented by counsel, that the responses do not meet "procedural or substantive requirements ... under the rules." *Id.* at 38; *see also id.* at 40, 41. Opposer also did not explain with the requisite particularity any of the alleged problems with Applicant's specific responses. *See* Fed. R. Civ. P. 33(b)(4); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984). Merely repeating the same uninformative information to the responding party in successive letters does not satisfy a party's obligation to act in good faith during discovery.

In view of the foregoing, the Board finds that Opposer failed to make a sufficient showing that it made a good faith effort to resolve the discovery matter as it relates to its interrogatories as required under Trademark Rule 2.120(f)(1). *Cf. Amazon Tech., Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009) (finding that the discovery dispute could and should have been resolved without the necessity of filing a motion to compel, the Board noted that opposer never once ... mentioned Applicant's alleged failure to serve initial disclosures and continued to "hide the ball"; party receiving discovery has a duty to object, specifically, on that basis).<sup>5</sup>

In any event, because Applicant did respond to Opposer's interrogatories, albeit unsigned, to the extent Opposer sought by its second motion to compel only to obtain Applicant's responses to Opposer's interrogatories, the motion is **denied as moot**.<sup>6</sup>

Notwithstanding the foregoing, Applicant is **ORDERED** to serve on Opposer's counsel **NO LATER THAN MONDAY, NOVEMBER 15, 2021**<sup>7</sup> a copy of its responses to Opposer's interrogatories **and** the responses must be signed **under oath**. *See* Fed. R. Civ. P. 33(b)(3); Trademark Rule 2.116(a); *see also* TBMP § 405.04(c). In lieu of an oath, Applicant may submit the following statement along with its responses to Opposer's interrogatories:

---

<sup>5</sup> In view thereof, if the second motion to compel with respect to the interrogatories were not moot, *see infra*, the motion would have been denied on this basis.

<sup>6</sup> Because Opposer's second motion to compel is moot with respect to Opposer's interrogatories, there is no need to determine whether Applicant's responses, which were served 18 days late, should be revised to not include any objections on the merits of the requests, as Opposer requests. In any event, Applicant only objected to 4 out of 38 interrogatories and its only objection will be addressed *infra*.

<sup>7</sup> This is a scheduling order, not a compel order.



**“All statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.”**

Should Applicant fail to serve properly executed responses to Opposer’s interrogatories, the Board may, upon motion, issue sanctions against Applicant, including making factual inferences against Applicant with respect to the information sought by Opposer through its interrogatories. *See* Trademark Rule 2.120(h)(1). *See, e.g., Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 38 USPQ2d 1551, 1556 (Fed. Cir. 1996) (When the calculation of damages is impeded by incomplete records of the infringer, adverse inferences are appropriately drawn); *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372, 217 USPQ 505, 510 (Fed. Cir. 1983) (no error in drawing an adverse inference where witnesses inappropriately refused to answer relevant questions), *aff’g* 213 USPQ 594 (TTAB 1982); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1467 (TTAB 1993) (where opposer’s objections were found to be not well taken, Board presumed that the answers would have been adverse to opposer’s position).

Additionally, the Board notes that in response to interrogatory nos. 10, 14, 17 and 32, Applicant objected to those interrogatories by stating, “that’s privileged information.” 32 TTABVUE 2. Pursuant to applicable case law, except to the extent these four interrogatories seek information related to “each good/service,” rather than information related only to the goods identified in the opposed application,<sup>8</sup> the information sought by Opposer is appropriate. *See* § 414(3) (“the classes of customers

---

<sup>8</sup> 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.).

for a party's involved goods or services are discoverable"; and 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.").

Additionally, the Board's automatic standard protective order<sup>9</sup> applies to all proceedings and governs in this case. *See* TBMP § 412.01. The Board's standard protective order covers confidential and trade secret information. *Id.* It is therefore improper for Applicant to refuse to provide discovery responses or documents on the grounds that the information requested is confidential business information.

Therefore, to keep this matter moving forward and to avoid further motions practice, Applicant is **ORDERED** to respond completely **NO LATER THAN MONDAY, NOVEMBER 15, 2021**,<sup>10</sup> to interrogatory nos. 10, 14, 17 and 32 in addition to executing its previous interrogatory responses under oath, as discussed above. Alternatively, Applicant must state that such information does not exist.

Applicant is reminded that its discovery responses should be served on Opposer's counsel and not filed with the Board. *See* Trademark Rule 2.120(k)(8).

---

<sup>9</sup> See the following URL:

[https://www.uspto.gov/sites/default/files/documents/Standard%20Protective%20Order\\_02052020.pdf](https://www.uspto.gov/sites/default/files/documents/Standard%20Protective%20Order_02052020.pdf)

<sup>10</sup> This is a scheduling order, not a compel order.

### III. Proceeding Resumed; Trial Dates Reset

This proceeding is resumed. Trial dates are reset as shown in the following schedule:

<b>Expert Disclosures Due</b>	<b>12/18/2021</b>
<b>Discovery Closes</b>	<b>1/17/2022</b>
<b>Plaintiff's Pretrial Disclosures Due</b>	<b>3/3/2022</b>
<b>Plaintiff's 30-day Trial Period Ends</b>	<b>4/17/2022</b>
<b>Defendant's Pretrial Disclosures Due</b>	<b>5/2/2022</b>
<b>Defendant's 30-day Trial Period Ends</b>	<b>6/16/2022</b>
<b>Plaintiff's Rebuttal Disclosures Due</b>	<b>7/1/2022</b>
<b>Plaintiff's 15-day Rebuttal Period Ends</b>	<b>7/31/2022</b>
<b>Plaintiff's Opening Brief Due</b>	<b>9/29/2022</b>
<b>Defendant's Brief Due</b>	<b>10/29/2022</b>
<b>Plaintiff's Reply Brief Due</b>	<b>11/13/2022</b>
<b>Request for Oral Hearing (optional) Due</b>	<b>11/23/2022</b>

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).

☼☼☼