

UNITED STATES PATENT AND TRADEMARK OFFICE
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November 25, 2020

Opposition No. 91250353 (Parent case)
Opposition No. 91263692

The Men's Wearhouse, Inc.

v.

Mark's Work Wearhouse Ltd.

Mary Beth Myles, Interlocutory Attorney:

This proceeding comes before the Board on Applicant's motion to compel in Opposition No. 91250353, and Opposer's motion to consolidate Opposition Nos. 91250353 and 91263692, filed in Opposition No. 91263692. Both motions were filed on September 2, 2020, and are fully briefed.¹

The Board has considered the parties' briefs filed in connection 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. *Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

¹ Opposer's change of correspondence address, filed September 24, 2020, in Opposition No. 91250353, and Opposer's notice of appearance, filed September 3, 2020, in Opposition No. 91263692, are noted and records have been updated.

I. Opposer's Motion to Consolidate

Opposer moves to consolidate Opposition No. 91250353, wherein it opposes the mark WORK WEARHOUSE, with Opposition No. 91263692, wherein it opposes the mark MARK'S WORK WEARHOUSE. Opp. No. 91263692, 5 TTABVUE. Applicant opposes consolidation, and argues that it will cause delay and further expense in resolving Opposition No. 91250353. *Id.*, 7 TTABVUE. The Board notes initially that Applicant has filed answers in both proceedings.

When cases involving common questions of law or fact are pending before the Board, the Board may order consolidation of the cases. *See* Fed. R. Civ. P. 42(a); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991); and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991). In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense which may be gained from consolidation, against any prejudice or inconvenience which may be caused thereby.

Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative. *See, e.g., Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *Regatta Sport*, 20 USPQ2d 1154.

The parties in the two opposition proceedings are identical and the issues are similar or related. Although Applicant argues that the marks, services, and allegations in the notices of opposition are not identical, the Board finds that the

proceedings involve largely common questions of law and fact. The marks and services need not be entirely identical for consolidation to be appropriate and efficient. Additionally, Opposer has pleaded likelihood of confusion as a ground for opposition in each proceeding and has pleaded ownership of the same registrations as the bases for this claim.

Applicant further contends that consolidation will delay proceedings in Opposition No. 91250353, which was filed almost a year before Opposition No. 91263692 was instituted. However, because the parties agreed to multiple suspensions of Opposition No. 91250353 for settlement discussions, at the time Opposer filed its motion to consolidate, discovery remained open in Opposition No. 91250353. Moreover, the Board suspended proceedings pending disposition of Applicant's motion to compel discovery in Opposition No. 91250353, so the discovery period in that proceeding remains open. Although the Board recognizes that consolidation will delay proceedings in Opposition No. 91250353 to some extent, the savings in efficiency outweigh the slight delay. Applicant also argues that it will be prejudiced by consolidation because the marks and services in each proceeding are not identical.² Despite consolidation, each proceeding retains its separate character and requires entry of a separate judgment. Accordingly, no prejudice can result based solely on the fact that the proceedings involve different marks and services.

² Opp. No. 91263692, 7 TTABVue 3. Applicant also briefly states that "prejudice will occur because the '353 proceeding is impacting Applicant's entry into the United States market," but provides no explanation or supporting evidence for this statement. *Id.*

Accordingly, the motion to consolidate is **granted**. Opposition Nos. 91250353 and 91263692 are consolidated and may be presented on the same record and briefs. *See Hilson Research, supra*; and *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989).

The Board file will be maintained in Opposition No. 91250353 as the “parent case.” From this point on, only a single copy of all motions and submissions should be filed, and each submission should be filed in the parent case only, but caption all consolidated proceeding numbers, listing and identifying the parent case first. Despite being consolidated, each proceeding retains its separate character and requires entry of a separate judgment. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings; a copy of the decision shall be placed in each proceeding file.

II. Applicant’s Motion to Compel

As an initial matter, the Board finds that Applicant’s motion to compel is timely inasmuch as it was filed prior to the day of the deadline for Opposer’s pretrial disclosures. *See Trademark Rule 2.120(f)(1)*. The Board finds, however, that Applicant had not made the required good faith effort to resolve the parties’ discovery dispute prior to seeking Board intervention, and consequently has not sufficiently narrowed the issues or set them forth in a clear, consistent, or concise manner.

A motion to compel must be supported by a written statement that the moving party 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(f)(1). The purpose of the good faith effort requirement is to “promote a **frank exchange between counsel** to resolve issues by agreement or to at least narrow and focus the matters in controversy before judicial resolution is sought.” *Amazon Tech., Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009) (emphasis in original; internal citation omitted). Moreover, “[w]here 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 ... and More, LLC v. SF Investments, Inc.*, 110 USPQ2d 1080, 1081 (TTAB 2014).

Applicant asks the Board to compel Opposer to “[p]roduce documents responsive to the Discovery Requests.” 16 TTABVUE 10. The record shows that on July 7, 2020, Opposer and Applicant conferred by telephone. *See id.* at 84. Per the confirmation email from Applicant to Opposer sent that same day, Opposer agreed to begin producing documents by the end of that week, and complete document production and provide updated responses to Applicant’s interrogatories by the end of July. *Id.* On July 10, Opposer produced publicly available documents related to prior Board proceedings. *Id.* at 14. Opposer did not produce any additional documents in July or at any point prior to the time Applicant filed its motion to compel. *Id.* Applicant filed its motion to compel on September 2 with no further communication with Opposer.

On this record, the Board finds that Applicant was required to make at least one additional inquiry prior to filing its motion to determine whether Opposer intended

to produce additional documents, as well as to ascertain any underlying circumstances that might have contributed to the delay in production and whether any problems could be resolved. *Hot Tamale Mama...and More*, 110 USPQ2d at 1082. The potential fruitfulness of a supplemental inquiry is plainly evident here. Opposer, in its brief opposing the motion to compel, explained that it was in bankruptcy proceedings, and that this process, along with difficulties arising from the COVID-19 pandemic, had delayed its production efforts. 17 TTABVUE 2-3. Had Applicant followed up with Opposer before filing this motion to inquire whether Opposer intended to produce additional documents, and had Opposer provided information regarding its situation, Applicant would have known enough to assess whether the situation was of the type that could be resolved without Board intervention. “The record does not reflect an unresolvable situation – such as would have been the case if Opposer were a defiant adversary who simply refused to engage in discovery or to provide Applicant with any answer regarding the failure to serve discovery responses.” *Hot Tamale Mama...and More*, 110 USPQ2d at 1082. On the contrary, the record shows that Opposer had prepared an additional document production which it served on Applicant the same day that it received Applicant’s motion to compel.

Additionally, the relief sought by the motion to compel is unclear. In the introductory paragraph of its motion to compel, Applicant seeks substantive responses to its first set of document requests and interrogatories. 16 TTABVUE 2. In the body of the motion however, Applicant only argues for supplementation of

Opposer's responses to Interrogatory Nos. 12 and 13. *See id.* at 7-10. Finally, in the conclusion of its motion, Opposer requests only that the Board compel Opposer to produce documents and to "[s]erve full, substantive responses to Applicant's Documents Requests as outlined above." 16 TTABVUE 10. The relief sought by the motion to compel is therefore unclear and to the extent Applicant seeks supplemental responses to **all** of its document requests and/or interrogatories, the motion to compel is not sufficiently narrowed. *See Sentrol, Inc. v. Sentex Sys., Inc.*, 231 USPQ 666 (TTAB 1986) (parties must narrow disputed requests for discovery to a reasonable number).

In view thereof, the Board finds that Applicant has failed to satisfy the good faith effort requirement of Trademark Rule 2.120(f)(1). Accordingly, Applicant's motion to compel is **denied without prejudice**. No further motion to compel may be filed unless the parties are truly unable, after making their best efforts, to work out mutually acceptable solutions. In consequence of the above, the parties are directed to review the select discovery guidelines below, and to work together to resolve their discovery problems in the spirit of good faith and cooperation, as required of all litigants in Board proceedings.

III. Select Discovery Guidelines

The Board notes that the parties appear to have a remaining disagreement regarding the production of electronically stored information ("ESI"). To assist the parties in future efforts to confer, the Board provides the following guidance.³

³ The following discussion does not constitute a determination as to whether or not emails or any other documents must be produced in response to any specific discovery request.

Fed. R. Civ. P. 34(a) states that a party may serve on any other party a request for “any designated documents or electronically stored information.” *See also* Fed. R. Civ. P. 33(d) (“answer to an interrogatory may be determined by examining, auditing, compiling, abstracting, or summarizing a party’s business records (including electronically stored information)”). ESI includes emails. *See Frito-Lay N. Am., Inc. v. Princeton Vanguard, LLC*, 100 USPQ2d 1904, 1908 (TTAB 2011). A party served with a request for discovery has a duty to thoroughly search its records for all information properly sought in the request, and to provide such information to the requesting party within the time allowed for responding to the request. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000). *See also* TBMP § 408.02.

Fed. R. Civ. P. 26(f)(3)(C) requires the parties to discuss “any issues about disclosure, discovery, or preservation of electronically stored information, including the form or forms in which it should be produced.” Aspects of ESI production that should be discussed, either at the discovery conference or when it becomes apparent that ESI will be produced, include a protocol for identifying and segregating potentially responsive ESI, who should review the ESI to determine whether the production of particular documents or information would be appropriate, and methods of searching the ESI, such as the use of “keywords,” to identify documents and information responsive to the discovery requests. *Frito-Lay*, 100 USPQ2d at 1905.

Where complete compliance with a particular discovery request would be unduly burdensome, an explanation must be made describing why the request is unduly

burdensome. *See Frito-Lay*, 100 USPQ2d at 1910 (production of “all” documents overly burdensome where the record showed that production involved tens of thousands of documents and expenditures of hundreds of thousands of dollars). Accordingly, if the objecting party properly explains why a representative sampling is provided, such a response is permissible. *See* TBMP § 414(2). *Cf. The Procter & Gamble Co. v. Keystone Automotive Warehouse, Inc.*, 191 USPQ 468, 471 (TTAB 1976) (“[I]t has been the practice of the Board to hold that the submission of representative samples of invoices, labels and advertising would satisfy a request for all such documents,” as long as the documents produced are truly representative). Nonetheless, a production of “representative” documents must truly be a representative sampling, and not merely a self-serving selection of favorable documents. An evasive or incomplete response is the equivalent of a failure to disclose. *See* Fed. R. Civ. P. 26(g) and 37(a)(3)(B).

A responding party that, due to an incomplete search of its records, provides an incomplete response to a discovery request, may not thereafter rely at trial on information from its records which was properly sought in the discovery request but was not included in the response thereto (provided that the requesting party raises the matter by objecting to the evidence in question) unless the response is supplemented in a timely fashion pursuant to Fed. R. Civ. P. 26(e). *See Panda Travel, Inc. v. Resort Option Enterprises, Inc.*, 94 USPQ2d 1789, 1791-92 (TTAB 2009). *See also* TBMP § 408.02.

IV. Proceedings Resumed; Trial Dates Reset

Proceedings in Opposition No. 91250353 are resumed and consolidated with Opposition No. 91263692.

Upon consolidation, the Board will reset dates for the consolidated proceeding, usually by adopting the dates as set in the most recently instituted of the cases being consolidated. Accordingly, remaining dates in the consolidated proceedings are reset as follows:⁴

Expert Disclosures Due	2/22/2021
Discovery Closes	3/24/2021
Plaintiff's Pretrial Disclosures Due	5/8/2021
Plaintiff's 30-day Trial Period Ends	6/22/2021
Defendant's Pretrial Disclosures Due	7/7/2021
Defendant's 30-day Trial Period Ends	8/21/2021
Plaintiff's Rebuttal Disclosures Due	9/5/2021
Plaintiff's 15-day Rebuttal Period Ends	10/5/2021
Plaintiff's Opening Brief Due	12/4/2021
Defendant's Brief Due	1/3/2022
Plaintiff's Reply Brief Due	1/18/2022
Request for Oral Hearing (optional) Due	1/28/2022

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

⁴ When parties stipulate to the rescheduling of a deadline for pretrial disclosures and subsequent testimony periods or to the rescheduling of the closing date for discovery and the rescheduling of subsequent deadlines for pretrial disclosures and testimony periods, a stipulation presented in the form used in a trial order, signed by the parties, or a motion in said form signed by one party and including a statement that every other party has agreed thereto, shall be submitted to the Board through ESTTA, with the relevant dates set forth and an express statement that all parties agree to the new dates. *See* Trademark Rule 2.121(d).

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).

TIPS FOR FILING EVIDENCE, TESTIMONY, OR LARGE DOCUMENTS

The Board requires each submission to meet the following criteria before it will be considered: 1) pages must be legible and easily read on a computer screen; 2) page orientation should be determined by its ease of viewing relevant text or evidence, for example, there should be no sideways or upside-down pages; 3) pages must appear in their proper order; 4) depositions and exhibits must be clearly labeled and numbered – use separator pages between exhibits and clearly label each exhibit using sequential letters or numbers; and 5) the entire submission should be text-searchable. Additionally, submissions must be compliant with Trademark Rules 2.119 and 2.126. Submissions failing to meet all of the criteria above may require re-filing. **Note:** Parties are strongly encouraged to check the entire document before filing.⁵ The Board will not extend or reset proceeding schedule dates or other deadlines to allow

⁵ To facilitate accuracy, ESTTA provides thumbnails to view each page before submitting.

Opposition Nos. 91250353 and 91263692

time to re-file documents. For more tips and helpful filing information, please visit the [ESTA help](#) webpage.