

UNITED STATES PATENT AND TRADEMARK OFFICE  
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September 23, 2021

Opposition No. 91256082

*Softek Illuminate, Inc.*

*v.*

*Merck Sharp & Dohme Corp.*

JLE

**Jennifer L. Elgin, Interlocutory Attorney:**

This proceeding comes up for consideration of the motions filed by (1) Applicant/Counterclaim Petitioner Merck Sharp & Dohme Corp. (“Applicant”) to compel discovery responses and oral discovery depositions of Opposer’s witnesses (filed May 28, 2021),<sup>1</sup> and (2) Opposer/Counterclaim Respondent Softek Illuminate, Inc. (“Opposer”) for a protective order prohibiting the oral discovery depositions of Opposer’s witnesses (filed June 7 and 8, 2021).<sup>2</sup> Opposer did not file a brief in response to Applicant’s motion to compel within the time provided under Trademark Rule 2.127(a). Applicant opposes Opposer’s motion for a protective order.

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<sup>1</sup> 14 TTABVUE. Record citations are to TTABVUE, the Board’s publicly available docket history system. *See, e.g., New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, at \*2 n.1 (TTAB 2020).

<sup>2</sup> 15 TTABVUE (motion, filed June 7, 2021); 16 TTABVUE (exhibits to declaration, filed June 8, 2021).

The Board has considered the parties' submissions and presumes the parties' familiarity with the arguments made therein. The parties' arguments are not summarized herein except as necessary to explain the Board's decision. *Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

## I. Background

Opposer claims is the assignee and owner of two registrations for the mark ILLUMINATE in standard characters for (1) computer software goods in International Class 9<sup>3</sup> and (2) computer software goods in International Class 9 and business consulting services in International Class 35.<sup>4</sup> Opposer asserts its predecessor in interest commenced use of ILLUMINATE in 2008.<sup>5</sup>

Opposer opposes registration of Applicant's application for the mark ILLUMINATE and design, shown below, for "Providing medical information, namely, clinical study results to doctors and patients" in International Class 44:<sup>6</sup>

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<sup>3</sup> Registration No. 3608560, registered April 21, 2009 and renewed April 20, 2019, for "computer software for managing patient medical information; computer software for indexing, searching, displaying, and managing electronic health records and electronic medical records; computer software for indexing, searching, displaying, and managing radiology images, radiology examinations, radiology reports, radiology data, and patient data" in International Class 9.

<sup>4</sup> Registration No. 6023126, registered March 31, 2020, for "downloadable and recorded computer software for managing patient medical information, specifically software for generating automatic follow-up notices for primary care physicians regarding radiological findings; computer software for tracking pre-screened patient data and patient diagnoses" in International Class 9 and "business consulting services provided to the healthcare industry, namely, the collection, reporting, and analysis, both real-time and post-completion, of productivity, efficiency, and completeness in the provision of healthcare services" in International Class 35.

<sup>5</sup> 8 TTABVUE 14, ¶ 1 (First Amended Notice of Opposition).

<sup>6</sup> Application Serial No. 88732936, filed December 19, 2019 based on a claim of bona fide intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C.



Opposer asserts a claim of priority and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).<sup>7</sup>

Applicant denies the salient allegations of the complaint and asserts affirmative defenses. Applicant also asserts counterclaims for cancellation of Opposer's pleaded registrations based on claims of nonuse as to Registration No. 3608560, abandonment, and fraud, and restriction of Opposer's pleaded registrations to the field of radiology under Section 18 of the Trademark Act, 15 U.S.C. § 1068.<sup>8</sup> Opposer denies the salient allegations of the counterclaims.<sup>9</sup>

## **II. Sua Sponte Review of Nonuse Counterclaim**

As an initial matter, Applicant asserts a counterclaim to cancel Opposer's Registration No. 3608560 on the basis of nonuse as of the filing date of the underlying application.<sup>10</sup> Once a registration is more than five years old, the only grounds available upon a petition to cancel are those enumerated in Trademark Act

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§ 1051(b). The mark consists of the word "ILLUMINATE" in black block letters. To the left of the word is a gray-colored outline of the left side of a serif capital letter "I", and to the left of that, a drawing of an orange sun, being a solid circle with 9 short, straight lines radiating from the circle, with the partial outline of the "I" letter obscuring the lower right quarter of the sun. The colors orange, black and gray are claimed as a feature of the mark.

<sup>7</sup> 8 TTABVUE 14-22 (First Amended Notice of Opposition).

<sup>8</sup> 11 TTABVUE (Answer to First Amended Notice of Opposition and Counterclaims).

<sup>9</sup> 9 TTABVUE.

<sup>10</sup> The pleaded allegations under the heading "COUNT I – Void Ab Initio for Nonuse,"

11 TABVUE 14-16, ¶¶ 45-58, appear to be duplicative of Applicant's fraud claim. Applicant's claim of nonuse appears to be stated in paragraphs 10-12 of its counterclaims. *Id.* at 8.

Sections 14(3) and 14(5), 15 U.S.C. §§ 1064(3), 1064(5). A claim of nonuse of the mark as of the application filing date is not available against a registration that is more than five years old. *See Maids to Order of Ohio, Inc. v. Maid-to-Order, Inc.*, 78 USPQ2d 1899, 1906 n.6 (TTAB 2006) (noting registration more than five years old may not be challenged on ground mark was not used in commerce at time of application filing); *Pennwalt Corp. v. Sentry Chem. Co.*, 219 USPQ 542, 550 (TTAB 1983) (finding nothing in Section 14 allows nonuse as a separate ground for cancellation of registration after five years have elapsed, unless misstatement was made with fraudulent intent, which would be grounds for a fraud claim).

At the time Applicant filed the instant counterclaim, Opposer's Registration No. 3608560 was more than five years old; therefore, Applicant's counterclaim for cancellation of Registration No. 3608560 based on nonuse of the mark as of the filing date of the underlying application is sua sponte **dismissed with prejudice**.

### **III. Discovery Responses**

Opposer seeks an order compelling Applicant to provide full responses to Opposer's discovery requests, as follows:

1. Responsive information and documents for all Interrogatories and Requests for Production Nos. 11–13 dating back to 2008;
2. A full description of Applicant's goods and services in response to Interrogatory No. 4;
3. Relevant third-party marks in response to Interrogatory No. 11;
4. A full description of Applicant's chain of title in response to Interrogatory No. 14;
5. A full description of Applicant's classes of consumers in response to Interrogatory No. 18; and

6. Documents sufficient to identify Applicant's classes of consumers in response to Document Request No. 9.<sup>11</sup>

Applicant did not file a response to the motion to compel, but instead filed a motion for a protective order which largely concerns Opposer's deposition notices. However, to the extent Applicant discusses at least the sufficiency of the parties' efforts to resolve their written discovery dispute in its motion, in its discretion the Board does not treat the motion to compel as conceded.

#### **A. The Parties' Communications**

Applicant's motion, supported by the declaration of its counsel Robert N. Hunziker, details the communications between the parties regarding their dispute.<sup>12</sup> On February 19, 2021, Opposer served written responses to Applicant's discovery requests and responsive documents. On March 29, 2021, Applicant sent a letter to Opposer detailing deficiencies in Opposer's responses and requesting that the parties confer to discuss a resolution. The parties met and conferred on April 1, 2021, and Applicant reports that Opposer represented it would supplement its responses. On May 13, 2021, Applicant sent a follow-up letter requesting that Opposer provide the promised supplementation. On May 24, 2021, Opposer served supplemental discovery responses, which Applicant complains did not resolve the six issues that are the subject of this motion. Applicant wrote again to Opposer on May 26, 2021 to complain of the deficiencies and to inform Opposer of Applicant's intention to file the instant motion if supplementation was not complete by May 28, 2021. Applicant states that,

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<sup>11</sup> 14 TTABVUE 5.

<sup>12</sup> *Id.* at 4-5.

on the evening of May 28, Opposer indicated that it would not be “timely supplementing” its responses.<sup>13</sup> Without any further communication between the parties, Applicant filed the current motion to compel on the same date.

Opposer, in its motion for protective order, states that no certain time frame for the promised supplementation was agreed upon.<sup>14</sup> Opposer argues that, at approximately 6:00 p.m. on Friday, May 28, 2021, “the arbitrary due date for [Applicant’s] third baseless set of objections,” Opposer informed Applicant that it would respond to Applicant’s May 26, 2021 deficiency letter “either tonight or tomorrow morning.”<sup>15</sup> Opposer reports that it received Applicant’s motion to compel at 7:16 pm on May 28, 2021; Opposer responded to Applicant’s May 26 correspondence approximately 20 minutes later and further stated, “We should have the second amended interrogatory responses to you over the weekend after my client’s CEO has reviewed the same.”<sup>16</sup> Although the referenced amended responses are not of record, Opposer’s correspondence indicates its agreement to some of Applicant’s demands and confirms it does not have documents responsive to certain requests.<sup>17</sup>

### **B. Good Faith Effort to Confer**

Pursuant to Trademark Rule 2.120(f)(1), 37 C.F.R. § 2.120(f)(1), a party seeking to compel discovery is required to demonstrate that it made a good faith effort to

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<sup>13</sup> *See id.*; *see also id.* at 18-20 (Hunziker Decl. ¶¶ 1-12).

<sup>14</sup> 15 TTABVUE 3-4.

<sup>15</sup> *Id.* at 6. *See also* 16 TTABVUE 119 (email from Robert Reynolds to Ryan Miller).

<sup>16</sup> 16 TTABVUE 128.

<sup>17</sup> *See id.* at 123-24.

resolve the issues presented in the motion and that the parties were unable to resolve their differences. *Hot Tamale Mama...and More, LLC v. SF Invs., Inc.*, 110 USPQ2d 1080, 1081 (TTAB 2014). An important purpose of this rule “is to relieve the Board of the burden of ruling on motions to compel in proceedings where the parties can resolve their discovery disputes if they make a good faith effort to do so.” *Id.*

A party seeking discovery has a duty to contact the adverse party to ascertain why it has received incomplete or insufficient responses to its discovery requests and to determine whether the matter can be resolved amicably. *See id.* at 1081 (citing *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 953-54 (TTAB 1979)). “The purpose of the conference 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 Techs., Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009) (emphasis in original) (quoting *Dondi Props. Corp. v. Commerce Sav. and Loan Ass’n*, 121 F.R.D. 284, 289 (N.D. Tex. 1988) (construing a local rule less demanding than Trademark Rule 2.120(f)(1))); *see also Hot Tamale Mama*, 10 USPQ2d at 1081 (quoting *Amazon Techs. Inc.*, *supra*).

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. *Hot Tamale Mama*, 10 USPQ2d at 1081. Where the effort toward resolution is incomplete, establishing the good faith effort necessitates

that the inquiring party engage in additional effort toward ascertaining and resolving the substance of the dispute. *Id. See also* TBMP § 523.02.

Applicant essentially maintains that its good faith obligation was discharged when Opposer indicated it would not be meeting Applicant's self-selected May 28, 2021 deadline for supplemental responses. The Board disagrees.

This is not a case where Opposer entirely failed to respond to Applicant's discovery requests or deficiency letters. Opposer responded substantively to Applicant's letters and supplemented its written responses. Notably, at no time did Opposer indicate that it was unwilling to meet and confer. Opposer promised a substantive response would be forthcoming within hours; nonetheless, Applicant preemptively filed its motion. Nor was Applicant under any deadline to file the instant motion, as the discovery period was open. *See* Trademark Rule 2.120(f) (a motion to compel discovery must be filed before the day of the deadline for pretrial disclosures for the first testimony period); *see also* TBMP § 523.01. Accordingly, the Board finds Applicant has failed to satisfy the good faith effort requirement of Trademark Rule 2.120(f)(1).

Accordingly, Applicant's motion to compel further written discovery responses and documents is **denied without prejudice**.<sup>18</sup>

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<sup>18</sup> Any renewed motion must demonstrate that the parties have engaged in at least one additional telephone conference after Applicant reviews Opposer's amended written discovery responses and document production but are unable to reach agreement as to the disputed matters.

### C. Selected Discovery Guidance

The Board cautions that Opposer should not interpret this order as approving of its stated objections and responses to Applicant's discovery requests. For example, it is well established that the classes of customers for a party's involved goods or services are discoverable. In contrast, the names of customers constitute confidential information, and generally are not discoverable, even under a protective order. *See Johnston Pump/Gen. Valve Inc. v. Chromalloy Am. Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (need not reveal names of customers, including dealers); *see also* TBMP § 414(3). A party, however, usually is required to furnish the name and address of its first customer in order to verify its claimed date of first use and may be required to furnish, under the Board's standard protective order, the names of one or two of its customers for each year of a specified period of years, if (as is the case here) there is a question of abandonment. *Johnston Pump*, 10 USPQ2d at 1675 (citing *Fisons Ltd. v. Capability Brown Ltd.*, 209 USPQ 167 (TTAB 1980)).

Similarly, information regarding Opposer's awareness of third party uses of similar marks is discoverable, though Opposer need not investigate third-party uses. *See Sheetz of Del., Inc. v. Doctor's Assocs. Inc.*, 108 USPQ2d 1341, 1348 (TTAB 2013) (a party need not investigate third-party use to respond to discovery requests); *see also* TBMP § 414(9).

Further, merely because information may be found in produced or publicly available documents does not obviate the requirement to respond to an interrogatory under oath, unless a party relies on the option to produce business records in

accordance with Fed. R. Civ. P. 33(d).<sup>19</sup> Moreover, the rules require parties to produce all responsive documents and things (including electronically stored information) in their possession, custody, or control that are not subject to a claim of privilege or an appropriate, specified objection. *See* Fed. R. Civ. P. 34(a). “Control with respect to the production of documents is defined as ‘not only as possession, but as the legal right to obtain the documents requested upon demand.’” *Pioneer Kabushiki Kaisha v. Hitachi High Techs. Am., Inc.*, 74 USPQ2d 1672, 1679 (TTAB 2005) (quoting *Cochran Consulting, Inc. v. Uwaterc USA, Inc.*, 102 F.3d 1224, 41 USPQ2d 1161, 1166 (Fed. Cir. 1996)). Thus, “[a] party can be required to produce documents and things that it possesses even though they belong to a third person who is not a party to the action.” 8B Wright & Miller, *FED. PRAC. AND PROC. CIV.* § 2210 (3d. ed. Apr. 2021 update).

#### **IV. Oral Depositions**

##### **A. Arguments of the Parties**

Applicant seeks an order compelling Opposer to produce witnesses in response to three noticed discovery depositions: Opposer’s Chief Executive Officer Matt McLenon

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<sup>19</sup> The Board has explained repeatedly that a party must comply with three requirements to invoke Rule 33(d). *Johnson & Johnson v. Obschestvo s ogranitchennoy; otvetstvennostiu “WDS,”* 95 USPQ2d 1567, 1568-59 (TTAB 2010); *No Fear v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000); and *Jain v. Ramparts, Inc.*, 49 USPQ2d 1429, 1433 (TTAB 1998). First, “a party may not rely on the option to produce business records unless it can establish that providing written responses would impose a significant burden on the party.” *No Fear*, 54 USPQ2d at 1555. Second, the responding party has the duty to specify, by category and location, the records from which the answers to the interrogatories can be derived. *Jain*, 49 USPQ2d at 1433. Third, “the inquiring party must not be left with any greater burden than the responding party when searching through and inspecting the records.” *No Fear*, 54 USPQ2d at 1555. Factor three is considered only where the first two prerequisites are met, and the responding party’s greater familiarity with its business records may be determinative. *Jain*, 49 USPQ2d at 1434.

and its Controller/Secretary Mary McLenon in their personal capacities pursuant to Federal Rule of Civil Procedure 30(b)(1), and Opposer via its corporate designee(s) pursuant to Federal Rule of Civil Procedure 30(b)(6).<sup>20</sup> Applicant contends that, although Opposer identified these witnesses as possessing relevant and discoverable information upon which Opposer may rely to support its claims, Opposer refuses to them for oral deposition unless Applicant first serves further written interrogatories or depositions on written questions.<sup>21</sup> Applicant details the parties' correspondence and a telephonic meet and confer on May 20, 2021 to attempt to resolve the issue.<sup>22</sup>

Applicant contends oral depositions are a standard discovery tool "that do not require the consent of the party to be deposed," and are "particularly suited to cases such as this, where candid discussions with knowledgeable officers from [Opposer] are necessary to obtain critical, relevant, and admissible information that is not readily obtained through written responses and to test the veracity of written responses produced otherwise to develop [Applicant's] defenses and claims."<sup>23</sup> Applicant further argues "there is little reason to believe that written deposition questions or further interrogatories, filtered through counsel, would provide meaningful additional information" given Opposer's deficient discovery responses.<sup>24</sup>

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<sup>20</sup> 14 TTABVUE 6-7, 13-15.

<sup>21</sup> *Id.* at 6, 13.

<sup>22</sup> *Id.* at 6-7 and 20-22 (Hunziker Declaration, ¶¶ 13-18).

<sup>23</sup> *Id.* at 13-14.

<sup>24</sup> *Id.* at 14.

Finally, Applicant observes that Opposer has not moved to quash the deposition notices or filed a motion for a protective order.<sup>25</sup>

In lieu of a response to the motion to compel, Opposer (supported by the declaration of its counsel Robert C. Reynolds) moves for a protective order as to the oral depositions. Opposer contends Applicant's notices of deposition are part of a "pattern of harassment" and a "fishing expedition" to support Applicant's counterclaims by "seeking to depose Illuminate's CEO twice to ask the same questions already answered by the CEO. In doing so it explicitly rejected requests to limit its inquiries to new questions and requests to use less burdensome alternative methods of inquiry."<sup>26</sup> Opposer argues the notices of deposition are "unrestricted in scope and time, while the third, containing 26 Topics of Examination, was served upon [Opposer] itself, a request that [Applicant] knew via pretrial disclosures and prior conferences and communications can only be fulfilled by [Opposer's] CEO, Matt McLenon."<sup>27</sup> Opposer maintains the topics "are overwhelmingly duplicative of the interrogatories and requests for production . . . ."<sup>28</sup>

In addition, Opposer contends Applicant's discovery requests relating to its counterclaims have imposed an undue burden on Opposer's small business.<sup>29</sup> Opposer further asserts that "two full day depositions of Illuminate's CEO would be incredibly

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<sup>25</sup> *Id.* at 14.

<sup>26</sup> 15 TTABVUE 3.

<sup>27</sup> *Id.* at 4.

<sup>28</sup> *Id.* at 7.

<sup>29</sup> *Id.* at 8.

disruptive of Illuminate’s business” and the depositions are not proportional to Applicant’s discovery needs.<sup>30</sup> Opposer requests, therefore, that the Board issue a protective order “enjoining [Applicant] to first provide written questions and allow for a seven-day response period to the same for all topics sought through deposition notices.”<sup>31</sup>

In opposition to Applicant’s motion for a protective order, Opposer argues Applicant has not met its burden to “establish good cause for issuance of the order” by providing “a particular and specific demonstration of fact, as distinguished from stereotyped and conclusory statements.”<sup>32</sup> First, Opposer contends that “discovery depositions serve a different purpose from written discovery requests.”<sup>33</sup> Second, Opposer argues that the noticed depositions do not constitute “harassment” merely because “it may be burdensome for the head of a small business to sit for a deposition.”<sup>34</sup> Opposer maintains this does not meet the standard of “extraordinary circumstances” warranting issuance of a protective order preventing a deposition.”<sup>35</sup>

### **B. Good Faith Effort to Confer**

As with Trademark Rule 2.120(f)(1) (applicable to motions to compel), Fed. R. Civ. P. 26(c)(1) and Trademark Rule 2.120(g), 37 C.F.R. § 2.120(g), also require that a

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<sup>30</sup> *Id.* at 8-9.

<sup>31</sup> *Id.* at 9.

<sup>32</sup> 18 TTABVUE 4.

<sup>33</sup> *Id.* at 6 (citations omitted).

<sup>34</sup> *Id.*

<sup>35</sup> *Id.* (citing *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759 (TTAB 1999)). Opposer is reminded that citation to decisions of the Board should be to the United States Patent Quarterly (USPQ), if the decision appears therein. *See* TBMP § 101.03.

party moving for a protective order include a certificate that the movant has in good faith conferred or attempted to confer with the other affected parties in an effort to resolve the dispute without court action. *See Phillies v. Phila. Consol. Holding Corp.*, 107 USPQ2d 2149, 2151 (TTAB 2013); *see also* TBMP § 412.06.

Although Opposer does not certify that the parties have met and conferred in good faith, Opposer appears to agree that the parties have reached an impasse in their discussions.<sup>36</sup> Here, based on the accounting by the parties, the Board finds the parties made a good faith effort to resolve the parties' dispute regarding the oral depositions of Opposer's witnesses prior to seeking Board intervention.

### **C. Legal Analysis**

As a general rule, parties are entitled to seek such discovery as they may deem necessary to help them prepare for trial. *See FMR Corp.*, 51 USPQ2d at 1761; *Dow Corning Corp. v. The Doric Corp.*, 183 USPQ 377, 378 (TTAB 1974). Trademark Rule 2.120(f)(1) provides that a motion to compel is available where a responding party "fails to designate a person pursuant to Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, or if a party, or such designated person, or an officer, director or managing agent of a party fails to attend a deposition or fails to answer any question propounded in a discovery deposition[.]"<sup>37</sup>

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<sup>36</sup> *See* 15 TTABVUE 3-6.

<sup>37</sup> Sanctions may be appropriate where a party fails to produce a witness after receiving proper notice, even if counsel indicates the witness will not attend, in the absence of a motion to quash filed prior to the deposition date. Trademark Rule 2.120(h)(2), 37 C.F.R. § 2.120(h)(2); *Fifth Generation Inc. v. Titomirov Vodka LLC*, 2019 USPQ2d 418666, at \*5 (TTAB 2019). *See also* TBMP § 404.06(b). Applicant has not moved for the imposition of sanctions in this case.

The Board has the power to limit or bar a deposition, however, if it determines that the discovery sought is obtainable from other sources that are more convenient and less burdensome or duplicative. Trademark Rule 2.120(g); *Pioneer Kabushiki Kaisha*, 74 USPQ2d at 1674 (citing Fed. R. Civ. P. 26 and *FMR Corp.*, 51 USPQ2d at 1761. *See also* TBMP § 412.06. The Board is empowered to “specify[ ] terms, including time and place, for the disclosure or discovery” at issue upon a showing of good cause. Fed. R. Civ. P. 26(c)(1)(B).

“To establish good cause, a movant must provide ‘a particular and specific demonstration of fact, as distinguished from stereotyped and conclusory statements.’” *Phillies*, 107 USPQ2d at 2152 (quoting *FMR Corp.*, 51 USPQ2d at 1761). The movant must demonstrate that its ability to litigate will be prejudiced, not merely that the difficulty of managing the litigation will increase. *Id.* at 2152-53. A protective order that prohibits the taking of a deposition altogether rarely is granted in the absence of extraordinary circumstances. *FMR Corp.*, 51 USPQ2d at 1761. *See also* TBMP § 412.06(a).

At bottom, Opposer’s argument is that it should not have to provide any witnesses for oral deposition because Applicant already has obtained information and documents in response to written discovery, and the depositions present an outsized burden. Both the Board’s and the Federal Rules of Civil Procedure, however, contemplate several different methods of obtaining discovery from an opponent. Opposer is entitled to discovery depositions, as well as written responses, with respect to subject matter which is discoverable under Fed. R. Civ. P. 26(b)(1). Methods of

discovery are complementary, rather than alternative or exclusive. *In re Dana Corp.*, 574 F.3d 129, 150 (2d Cir. 2009) (opining that “the various discovery methods are more complementary than fungible” and “[n]o one type of discovery is necessarily an adequate substitute for another”). Indeed, “[b]ecause of its nature, the deposition process provides a means to obtain more complete information and is, therefore, favored.” *Marker v. Union Fidelity Life Ins. Co.*, 125 F.R.D. 121, 126 (M.D.N.C. 1989) (rejecting party’s argument that the information sought by a Rule 30(b)(6) deposition had already been produced in its written answers to interrogatories). *See also* TBMP § 404.01.

Further, Opposer’s unsupported and conclusory argument that its CEO should not bear the burden of appearing for depositions because he heads a small business is not convincing.<sup>38</sup> A motion for a protective order that a discovery deposition not be had usually is denied when the only grounds advanced are that the deponent is too busy, or that the examination would cause undue labor, expense or delay. *FMR Corp.*, 51 USPQ2d at 1761. Although courts have granted a motion for protective order when a party seeks to initiate its discovery “at the top” before exhausting less intrusive discovery methods, in such cases the prospective deponent has been shown to have no direct knowledge of the facts of the case or no unique or superior personal knowledge of the facts. *See id.* Opposer has not made such a particularized showing here. Indeed, Opposer identified both Mr. McLenon and Ms. McLenon as two of only

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<sup>38</sup> The Board notes Opposer presents no such argument regarding Ms. McLenon.

a few witnesses with knowledge of relevant facts, and Mr. McLenon verified Opposer's amended interrogatory responses.<sup>39</sup>

Finally, Opposer's insistence that depositions on written questions would be less time consuming and burdensome is unsupported. Applicant has noticed only three depositions. As the Board recognizes, "A deposition on written questions is a cumbersome, time-consuming procedure. . . . Moreover, it deprives an adverse party of face-to-face confrontation and the opportunity to ask follow-up questions based on answers to previous questions." TBMP § 404.07(j) (citing cases in n.1). It would be unjust for Applicant to be deprived of the valuable aid of confronting the witnesses by way of oral examination in view of the nature of the testimony to be elicited. *Cf. Century 21 Real Estate Corp. v. Century Life of Am.*, 15 USPQ2d 1079, 1080 (TTAB 1990), corrected at 19 USPQ2d 1479 (TTAB 1990) (ordering oral testimony deposition of expert witness).

The Board cannot help but recognize, furthermore, that Opposer brought this proceeding knowing that Applicant would be entitled to take discovery, including oral depositions. Having made the choice to initiate the proceeding, Opposer should not be heard to complain about the natural consequences permitted by the Federal Rules of Civil Procedure and the Trademark Rules. Accordingly, the Board finds Opposer must present its witnesses for oral deposition.

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<sup>39</sup> See 14 TTABVUE 95-96, 101, 103, 105 (Amended Responses to Interrogatory Nos. 1, 3, 15, 22, Verification of Matthew McLenon).

However, the Board also recognizes the burden on Opposer's CEO to appear for two days of deposition, and finds this would be disproportional to the needs of the case. *See Spliethoff's Bevrachtingskantoor B.V. v. United Yacht Transport LLC*, 2020 USPQ2d 10605, at \*3 (TTAB 2020) ("Before noticing any deposition, a party should assess whether it would be proportional to the needs of the case and truly necessary, taking into account the time and expense involved for even one deposition."). Accordingly, the Board orders that, in the event Opposer also designates Mr. McLenon as its Rule 30(b)(6) witness, Applicant take the individual and corporate depositions simultaneously, not to exceed a single day of seven hours. *See Fed. R. Civ. P. 30(d)(1)*; *see also Pioneer Kabushiki Kaisha*, 74 USPQ2d at 1673 (noting Board ordered continuation of deposition of witness as a Fed. R. Civ. P. 30(b)(6) witness and in his individual capacity).

In view thereof, both Applicant's motion to compel the noticed depositions and Opposer's motion for a protective order are **granted in part**, as specified herein. Opposer is directed to contact Applicant within **ten days** of the date of this order and provide Opposer with available dates and times for the taking of the noticed depositions.<sup>40</sup>

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<sup>40</sup> Opposer should note that neither the Trademark Rules nor the Federal Rules of Civil Procedure permit a party duly served with a Rule 30(b)(6) notice to refuse to produce a witness on topics it decides are objectionable. Instead, a responding party that is unable to resolve its objections with the serving party, and is unwilling to waive them, is required to produce a witness on the noticed topics and re-assert its objections during the deposition. *See Fed. R. Civ. P. 30(c)(2)* ("An objection at the time of the examination . . . must be noted on the record, but the examination still proceeds; the testimony is taken subject to any objection."). *See also TBMP §§ 404.08, 523.01.*

## V. Extension of Discovery Period

Finally, Applicant requests in its motion to compel that the Board extend the discovery period by sixty days, but only for Applicant. Applicant argues that the additional time is needed for Applicant to conduct the noticed depositions and any necessary follow-up discovery based on those depositions.<sup>41</sup>

Opposer counters in its motion for protective order that the Board should extend the discovery period for both parties. Opposer contends that an extension of the discovery period is necessary because Applicant took 90 days to serve discovery responses and documents which are “deficient in several ways”. Opposer claims that Opposer “deserves the same ability to continue its discovery as [Applicant] has had for well over 100 days . . . .”<sup>42</sup>

Because the requests for extensions were filed prior to the close of the relevant period, the relevant standard is “good cause” for the extension sought. *See* Fed. R. Civ. P. 6(b)(1)(A); *see also* TBMP § 509.01(a). Ordinarily, the Board is liberal in granting extensions before the period to act has lapsed, so long as the moving party has not been guilty of negligence or bad faith and the privilege of extensions is not abused. *See, e.g., Am. Vitamin Prods., Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1315 (TTAB 1992).

A motion to extend must set forth with particularity the facts said to constitute good cause. *Instruments SA Inc. v. ASI Instruments, Inc.*, 53 USPQ2d 1925, 1927

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<sup>41</sup> 14 TTABVUE 15-16.

<sup>42</sup> 15 TTABVUE 10.

(TTAB 1999); *see also Luemme, Inc. v. D.B. Plus, Inc.*, 53 USPQ2d 1758, 1760 (TTAB 1999). A party moving to extend time also must demonstrate that the requested extension of time is not necessitated by the party's own lack of diligence or unreasonable delay in taking the required action during the time previously allotted therefor. *See Nat'l Football League v. DNH Mgmt., LLC*, 85 USPQ2d 1852, 1854 (TTAB 2008).

After reviewing the parties' arguments and keeping in mind the Board's liberal application of the Rule 6(b) standard, the Board finds that the circumstances herein are appropriate to **grant** a sixty-day extension of the discovery period for both parties. The requests are not necessitated by lack of diligence. In addition, the Board finds there is no evidence of negligence or bad faith on the part of either party, and neither party has abused the privilege of extensions.

In view thereof, the discovery period is extended by sixty days, as set forth further below.

## **VI. Proceedings Resumed**

Proceedings are **resumed**. Discovery, disclosure, and trial dates are reset as indicated below:

Expert Disclosures Due	11/10/2021
Discovery Closes	12/10/2021
Pretrial Disclosures Due for Party in Position of Plaintiff in Original Claim	1/24/2022
30-day Trial Period Ends for Party in Position of Plaintiff in Original Claim	3/10/2022
Pretrial Disclosures Due for Party in Position of Defendant in Original Claim and in Position of Plaintiff in Counterclaim	3/25/2022

30-day Trial Period Ends for Party in Position of Defendant in Original Claim, and in Position of Plaintiff in Counterclaim	5/9/2022
Pretrial Disclosures Due for Rebuttal of Party in Position of Plaintiff in Original Claim and in Position of Defendant in Counterclaim	5/24/2022
30-day Trial Period Ends for Rebuttal of Party in Position of Plaintiff in Original Claim, and in Position of Defendant in Counterclaim	7/8/2022
Pretrial Disclosures Due for Rebuttal of Party in Position of Plaintiff in Counterclaim	7/23/2022
15-day Trial Period Ends for Rebuttal of Party in Position of Plaintiff in Counterclaim	8/22/2022
Opening Brief for Party in Position of Plaintiff in Original Claim Due	10/21/2022
Combined Brief for Party in Position of Defendant in Original Claim and Opening Brief as Plaintiff in Counterclaim Due	11/20/2022
Combined Rebuttal Brief for Party in Position of Plaintiff in Original Claim and Brief as Defendant in Counterclaim Due	12/20/2022
Rebuttal Brief for Party in Position of Plaintiff in Counterclaim Due	1/4/2023
Request for Oral Hearing (optional) Due	1/14/2023

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, matters in evidence, the manner and timing of taking testimony, 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.<sup>43</sup> The Board will not extend or reset proceeding schedule dates or other deadlines to allow time to re-file documents. For more tips and helpful filing information, please visit the **ESTTA help** webpage.

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<sup>43</sup> To facilitate accuracy, ESTTA provides thumbnails to view each page before submitting.