

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

January 3, 2023

Opposition No. 91275604

*Barefoot Dreams, Inc.*¹

v.

QVC, Inc.

Rebecca Stempien Coyle, Interlocutory Attorney:

This proceeding now comes before the Board for consideration of Applicant's September 1, 2022, motion to test the sufficiency of Opposer's responses to certain requests for admission. The motion is fully briefed.

The Board has considered the parties' briefs and materials submitted in connection with the motions, but addresses the record only to the extent necessary to set forth its analysis and findings, and does not repeat or address all of the parties' arguments or evidence. *See Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

I. Warning to the Parties – Courtesy and Decorum

The parties' briefing on Applicant's motion is replete with vituperative accusations against one another, use of wording that is obviously exaggerated to the

¹ The notice of appearance and updated correspondence address filed on behalf of Opposer (10 TTABVUE) is noted. Board records have been updated accordingly.

point of being pointless, and generally displays a distressing lack of courtesy. This is further shown in a review of the parties' correspondence and declarations summarizing their meet and confer efforts.

This proceeding presents the issue of the registrability of one mark, in view of an opposition asserting one ground. The Board's resolution of this proceeding will turn on the evidence, not on hyperbole. This proceeding is not of such a complexity that the parties cannot focus on properly gathering, designating and presenting their evidence, or arguing that there is a lack of evidence, as appropriate. The Board expects the parties to conduct their business with decorum and courtesy. Trademark Rule 2.192; *MySpace Inc. v. Mitchell*, 91 USPQ2d 1060, 1061 n.4 (TTAB 2009) (referencing Rule 2.192); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 115.01 (2022).

As a reminder to the parties, "[t]he purpose of the conference requirement [for discovery motions] 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) (quoting *Dondi Properties Corp. v. Commerce Savings and Loan Ass'n*, 121 F.R.D. 284, 289 (N.D. Tex. 1988)). "[T]he 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). "The meet and confer process cannot be truly complete until 'after all the cards have been laid on the table,' by both parties."

Amazon Techs., 93 USPQ2d at 1702 (quoting *Nevada Power Co. v. Monsanto Co.*, 151 F.R.D. 118, 120 (D. Nev. 1993)).

Parties are under an **equal** obligation to cooperate in discovery and uncooperative behavior during the discovery process is not well-taken. The parties' conduct to date has been unacceptable. The Board expects better cooperation going forward including **good faith** participation in the discovery process, and the parties shall refrain from ad hominem attacks. The Board has the authority, including the inherent authority, to sanction parties for failing to comply with the Board's rules and orders, including, where appropriate, the authority to enter judgment as a sanction. *See* TBMP 527.

II. Parties' Arguments

Applicant served its first set of requests for admission on June 29, 2022.² Opposer served responses, with objections, on July 29, 2022.³ The parties met and conferred regarding the original responses, and on August 8, 2022, Opposer served supplemental responses and objections to Request for Admission Nos. 14 and 16-20.⁴

Through its motion Applicant seeks an order determining the sufficiency of Opposer's responses to Requests for Admission Nos. 14-20, including overruling Opposer's objections based on privilege and to the terms "COZY-Formative Marks" and "adopted".⁵

² 5 TTABVUE 16, ¶ 2, *see also id.* at 21-27.

³ *Id.* at 16, ¶¶ 4-7, *see also id.* at 29-42.

⁴ *Id.* at 56-61.

⁵ In their briefs the parties refer to the possibility of another dispute as to the number of requests served by Applicant. However, this issue is not presently before the Board. If a dispute remains on this issue, the Board expects the parties to participate in good faith in

Requests for Admission Nos. 14-18 ask Opposer to admit it “was aware of at least one third-party registration for a COZY-Formative Mark at the time Opposer first adopted Opposer’s COZYCHIC Mark”, “THE COZY Mark”, “COZYCHIC Plus Marks”, or “Alleged COZYCHIC KNIT Mark”, or “at the time Opposer first objected to Applicant’s Mark.”⁶ Requests for Admission Nos. 19 and 20 ask Opposer to admit it did, or did not, “conduct a trademark search prior to adopting the first of Opposer’s Marks.”⁷

Opposer’s operative responses to each of the requests include several objections. While Opposer’s response to Request for Admission No. 15 consists solely of objections,⁸ its supplemental responses to Requests for Admission Nos. 14 and 16-20 each state:

Subject to Opposer’s specific and general objections, Opposer supplements its response as follows: Based on its reasonable inquiry, Opposer is without sufficient information to admit or deny this Request, and therefore Denies it.⁹

Applicant argues that responses to the contested requests for admission are inconsistent with the purpose of Fed. R. Civ. P. 36, and are “illogical”; particularly when Opposer was able to provide a definitive answer to other requests for admission that sought similar admissions but for third-party use.¹⁰ Applicant also maintains

their meet and confer efforts to narrow the dispute, including being forthcoming on counting methods and reasons therefor. The Board also expects that any further motion practice by the parties will be focused on the issues raised in the motion.

⁶ 5 TTABVUE 23-24.

⁷ *Id.* at 24.

⁸ *Id.* at 37.

⁹ *Id.* at 57-60.

¹⁰ *Id.* at 7-8.

Opposer's privilege-based objections are improperly asserted since the requests seek factual information, and Opposer's objections to Applicant's definitions of "COZY-Formative Marks" and "adopted" are improper and should be withdrawn.

In response, Opposer maintains its responses to Requests for Admission Nos. 14 and 16-20 are proper pursuant to Fed. R. Civ. P. 36(a)(4), it is not required to further explain its response, and that in view of the nature of the requests it cannot provide an unambiguous admission or denial. As for Request for Admission No. 15, Opposer contends its objection on the basis of privilege, and resulting response, are proper inasmuch as requiring a further response would require Opposer to disclose the substance of privileged communications. Opposer also asserts its objections to the terms "COZY-Formative Marks" and "adopted" are proper, regardless Opposer answered the requests and therefore the motion is moot. Opposer further maintains Applicant never met and conferred on the objection to "adopted", and therefore the motion as to that term should not be considered.

In reply, Applicant asserts that a party must explain the inquiry taken under Fed. R. Civ. P. 36(a)(4), this inquiry must be for information it knows or can readily obtain, and Opposer has not met this obligation. Applicant further maintains Opposer's privilege objection is unfounded, and that even if Opposer's arguments were accepted the privilege would not apply because the requests for admission seek facts, not the substance of advice. Applicant also argues that while Opposer states it has responded to the requests despite its objections to Applicant's terms, it remains unclear if its responses were impacted by its objections.

III. Motion to Test Sufficiency of Responses to Requests for Admission
A. Good Faith Effort Requirement

Pursuant to Trademark Rule 2.120(i)(1), a party seeking to test the sufficiency of a request for admission response is required to demonstrate that it made a good faith effort to resolve the issues presented in the motion and that the parties were unable to resolve their differences. *See also Hot Tamale Mama*, 110 USPQ2d at 1081. An important purpose of this rule “is to relieve the Board of the burden of ruling on [discovery motions] in proceedings where the parties can resolve their discovery disputes if they make a good faith effort to do so.” *Id.* Accordingly, the Board first determines whether Applicant made the requisite good faith effort prior to filing its motion.

The Board has reviewed the briefs, arguments, declarations of Jeremy Berman and Merri Moken, and the attachments thereto. Counsel for the parties exchanged several emails and conducted at least two telephone calls regarding alleged deficiencies in Opposer’s responses to the requests for admission and were unable to resolve their differences. The Board finds that Applicant made the requisite good faith effort to resolve the parties’ dispute as to Opposer’s objections based on privilege and to the term “COZY-Formative Marks”, as well as Opposer’s responses to Requests for Admission Nos. 14 through 20.

However, the record does not support a finding that Applicant raised, let alone made a good faith effort to resolve, the issue with Opposer’s objection to the term “adopted” prior to bringing its motion. A review of the parties’ submission does not

indicate the parties discussed this issue, nor does Applicant dispute Opposer's assertion that Applicant failed to raise any issue with this objection during the parties' meet and confer efforts.¹¹ Accordingly, Applicant's motion as to Opposer's objection to the term "adopted" is **denied without prejudice**. Applicant may renew its motion, if necessary, after engaging in the meet and confer process with Opposer.¹²

B. Sufficiency of Opposer's Responses

Under Fed. R. Civ. P. 36(a)(1), a party may serve on any other party requests to admit "the truth of any matters within the scope of Rule 26(b)(1) relating to: (A) facts, the application of law to fact, or opinions about either; and (B) the genuineness of any described documents." Under Rule 36(a)(4), an answer to a request for admission must either admit the matter requested, deny the matter, or state in detail the reason why the responding party cannot truthfully admit or deny the matter. *See* TBMP § 407.03(b). The answering party may not give lack of information or knowledge as a reason for failure to admit or deny unless the party states that it has made reasonable inquiry and that the information known or readily obtainable by the party is insufficient to enable the party to admit or deny. Fed. R. Civ. P. 36(a)(4).

If an answer does not comply with the requirements of Fed. R. Civ. P. 36(a), the Board may order either that the matter is admitted or that an amended answer be served. A motion to test the sufficiency of a response to an admission request is solely a test of the legal sufficiency of that response. *See* Fed. R. Civ. P. 36(a); *see also* TBMP

¹¹ *See* 7 TTABVUE 9.

¹² Again, the Board expects both parties to lay all their cards on the table during the meet and confer process and work together to reach a resolution.

§ 524 (and the cases cited therein). Disagreements regarding the veracity of such responses are matters to be determined at trial and are not properly the subject of a motion to test their sufficiency. *Hewlett Packard Enterprise Dev. LP v. Arroware Indus., Inc.*, 2019 USPQ2d 158663 at *6 (TTAB 2019) (“The Board does not determine the accuracy, or factual support, of an admission or a denial of a request for admission.”).

1. Opposer’s Objections

The Board first addresses Opposer’s objection to the term “COZY-Formative Marks”. Applicant’s discovery requests define this term as “any mark comprising or containing the term COZY or a phonetic equivalent.”¹³ Opposer’s objection is **overruled**. The Board finds Applicant’s definition to be sufficient, and Opposer’s arguments to the contrary are unpersuasive.¹⁴ Nor is the Board persuaded that the issue is moot. Opposer prefaces each of its responses with the phrase “subject to Opposer’s specific and general objections”. This type of response is confusing, and leaves the requesting party guessing as to whether the responding party actually provided a complete and accurate response.

The Board further notes Applicant maintains it explained the objected-to term during the parties’ meet and confer on August 17, 2022,¹⁵ and Opposer’s counsel did

¹³ 5 TTABVUE 66, *see also id.* at 21.

¹⁴ To the extent Opposer remains unclear on whether a mark would fall under the defined term, Opposer should clearly raise the question with Applicant in advance of its deadline to serve amended answers as ordered herein.

¹⁵ 5 TTABVUE 19. (Applicant’s counsel explained “that Applicant explicitly is referring to marks that either solely comprise the term COZY or a phonetic equivalent, or longer marks that contain the term COZY or a phonetic equivalent.”)

not give any indication that they did not understand the explanation. Opposer does not dispute this,¹⁶ but rather makes various, truncated arguments in its response brief as to why the term remains unclear.¹⁷ Opposer failed to lay its cards on the table during the meet and confer process regarding its objection. “In order for the meet and confer process to be meaningful and serve its intended purpose, ‘the parties must present to each other the merits of their respective positions with the same candor, specificity, and support during informal negotiations as during the briefing of discovery motions.’” *Amazon Tech*, 93 USPQ2d at 1705 (quoting *Nevada Power Co.*, 151 F.R.D. at 120). Had Opposer raised its arguments during the August 17, 2022, telephone call, or even in the subsequent days, the parties may have been able to resolve this issue.

The Board next addresses Opposer’s objections based on privilege. As an initial matter, the attorney-client privilege applies to communications and not facts, even if the facts are learned from counsel. *See Upjohn Co. v. United States*, 449 U.S. 383, 385-86 (1981) (“The protection of the privilege extends only to communications and not to facts. A fact is one thing and a communication concerning the fact is an entirely different thing.”); *see also Kansas Wastewater, Inc. v. Alliant Techsystems, Inc.*, 217 F.R.D. 525, 528 (D. Kan. 2003) (“the privilege does not protect facts that an attorney conveys to his client”); *Thurmond v. Compaq Computer Corp.*, 198 F.R.D. 475, 483 (E.D.Tex.2000) (“[A]ttorney-client privilege does not reach facts within the client’s

¹⁶ Opposer’s counsel’s vague statement in her declaration that “the parties were unable to resolve their disagreement regarding” this term notably does not state that Opposer presented any of its current arguments during the meet and confer. *Id.* at 31, ¶ 18.

¹⁷ 7 TTABVUE 21.

knowledge, even if the client learned those facts through communications with counsel.”); *B.C.F. Oil Refin., Inc. v. Consol. Edison Co. of N.Y.*, 168 F.R.D. 161, 165 (S.D.N.Y.1996) (“attorney-client privilege simply does not extend to facts known to a party that are central to that party’s claims, even if such facts came to be known through communications with counsel”); *Standard Chartered Bank, PLC v. Ayala Int’l Holdings (U.S.), Inc.*, 111 F.R.D. 76, 80 (S.D.N.Y.1986) (the privilege does not protect facts that an attorney obtains and then conveys to his client; defendant was required to disclose all facts of which it was aware, regardless of whether defendant learned those facts from counsel).¹⁸

The disputed requests seek admissions that Opposer was aware of third-party registrations at specific time frames, or that Opposer did (or did not) conduct a trademark search at a certain time frame. The Board disagrees that the disputed requests necessarily reveal the content of communications between Opposer and its counsel.¹⁹ Even if Opposer’s admission or denial of the requests is based solely on facts communicated by counsel, nothing in the requests require disclosure of this information, let alone any legal advice or other privileged communication. In view of the foregoing, Opposer’s objections based on attorney-client privilege are **overruled**.

¹⁸ Inasmuch as Opposer’s responses do not assert the work-product doctrine, the Board does not address Opposer’s discussion of the doctrine in its efforts to distinguish *Standard Chartered Bank*.

¹⁹ For example, it is well-settled that search reports are discoverable, even though attorney opinion is privileged. See *Fisons Ltd. v. Capability Brown Ltd.*, 209 USPQ 167 (TTAB 1980); *Goodyear Tire & Rubber Co. v. Tyrco Industries*, 186 USPQ 207 (TTAB 1975); and *Miles Laboratories, Inc. v. Instrumentation Laboratory, Inc.*, 185 USPQ 432 (TTAB 1975).

In view of the foregoing, Applicant's motion is **granted** as to Opposer's objections. Opposer must serve amended answers to Request for Admissions No. 14 through 20 within thirty days from the date of this order, in accordance with the above.

2. Opposer's Responses to Requests for Admission Nos. 14, 16-20

As noted above, "[a]n answering party may assert lack of knowledge or information as a reason for failing to admit or deny only if the party states that it has made reasonable inquiry and that the information it knows or can readily obtain is insufficient to enable it to admit or deny." Fed. R. Civ. P. 36(a)(4); *see also* TBMP § 407.03(b). Moreover, "[t]he purpose of a request for admission is to determine what facts are or are not at issue for trial. A request for admission should not be used to seek discovery of the unknown" and a party is not required "to explain the basis of an admission or denial." *Hewlett Packard Enterprise Dev.*, 2019 USPQ2d 158663 at *5-6 (citing, *inter alia*, Fed. R. Civ. P. 36; TBMP § 407).

Accordingly, Applicant's motion seeking an explanation from Opposer as to the scope of its inquiry is denied. Moreover, although it strains Applicant's incredulity that Opposer cannot simply admit or deny the requests, Opposer contends that the relevant time frame is for a period in the past, "in some cases dat[ing] back 15 or 20 years", and that the "findings after a reasonable inquiry" were insufficient.²⁰ Nor is the Board persuaded that Opposer must necessarily be able to admit or deny knowledge of third-party registrations simply because it was able to admit or deny knowledge of third-party use.

²⁰ 7 TTABVUE 13-14.

However, Opposer's operative responses are problematic insofar as Opposer does not state that the information known or readily obtainable to it was insufficient to allow Opposer to either admit or deny the requests for admission. In view of the foregoing, Applicant's motion is **granted in part**, and Opposer must serve amended answers to Requests for Admission Nos. 14 and 16-20 addressing this deficiency.

IV. Summary

Applicant's motion is **granted in part** and **denied in part**, as indicated herein. Opposer is allowed **THIRTY DAYS** from the date of this order in which to serve amended answers to Requests for Admission Nos. 14-20 which delete all overruled objections and address the deficiencies discussed herein, failing which the Requests for Admission Nos. 14-20 may be deemed admitted.

The Board expects the parties (and their attorneys) to cooperate with one another in the discovery process and looks with extreme disfavor on those who do not. TBMP § 408. Each party and its attorney has a duty to make a good faith effort to satisfy the discovery needs of its adversary. *Id.* The parties are also reminded of their ongoing duty to supplement their discovery responses in a timely manner. Fed. R. Civ. P. 26(e)(1)(A).

Proceedings are **resumed** and dates reset as follows:

Expert Disclosures Due	3/25/2023
Discovery Closes	4/24/2023
Plaintiff's Pretrial Disclosures Due	6/8/2023
Plaintiff's 30-day Trial Period Ends	7/23/2023
Defendant's Pretrial Disclosures Due	8/7/2023
Defendant's 30-day Trial Period Ends	9/21/2023
Plaintiff's Rebuttal Disclosures Due	10/6/2023

Plaintiff's 15-day Rebuttal Period Ends	11/5/2023
Plaintiff's Opening Brief Due	1/4/2024
Defendant's Brief Due	2/3/2024
Plaintiff's Reply Brief Due	2/18/2024
Request for Oral Hearing (optional) Due	2/28/2024

The Federal Rules of Evidence generally 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).