UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: September 29, 2006

Cancellation No. 92043340

A.V. IMPORTS, INC.

v.

SPIRITS INTERNATIONAL N.V.

Jyll S. Taylor, Attorney:

By way of background, On March 7, 2005, respondent served its first set of interrogatories and document requests ("discovery requests") on petitioner. On April 12, 2005, petitioner served its responses to respondent's discovery requests. On May 19, 2005, petitioner moved for summary judgment and, on May 23, 2005, this proceeding was suspended pending decision on the motion for summary judgment. On September 19, 2005, petitioner's motion for summary judgment was denied and proceedings were resumed. On October 31, 2005, respondent filed the motion to compel.

This case now comes up for consideration of respondent's combined motion, filed October 31, 2005, for an order compelling petitioner to produce documents and things called for by respondent's first set of interrogatories and first set of requests for production of document and to

extend the current schedule by at least sixty days.[1] The motion is fully briefed.

Turning first to the motion to compel, respondent contends that "[i]t defies logic that the 121 pages of documents produced by Petitioner are the only relevant, non-privileged documents in Petitioner's possession, custody or control"; that petitioner relied on many documents that it did not produce during discovery in its summary judgment; that the few documents produced by petitioner allude to other documents that have not been produced; and that accordingly, petitioner should be ordered to supplement its responses to Interrogatory Nos. 3 and 7 and Document Requests Nos. 1, 2, 3, 4, 9, 10, 11, 12, 13, 14, 15, 16, 17, 19, 20, 21, 22, 24, 25, 26, 29, 30, 31, 32, 33, 34 and 35.

Respondent also argues that petitioner has not produced a privilege log and, as such, it "would appear" that petitioner is not withholding documents on the basis of attorney client privilege or work product. If petitioner is withholding such documents, respondent contends that respondent should produce such a log.

Respondent states that its "attempt to meet and confer with Petitioner to resolve the issues raised by the motion have been unsuccessful." More specifically, counsel for

[1] The Board regrets any inconvenience to the parties occasioned by the delay in considering the motion.

respondent counsel states that on October 21, 2005, she contacted petitioner's counsel and requested petitioner's consent to extend the testimony periods, so that she could transition this matter to another law firm or to new lead counsel (because she was leaving her current firm); that on October 28, 2005, respondent's counsel placed a call to opposing counsel to find out the status on the extension request and to raise discovery concerns; that also on October 28, 2005, respondent's counsel received a fax notice of testimony deposition of Justin Pierce, and that this was the first indication counsel received that opposing counsel may not consent to the requested extension; and that respondent's counsel's efforts to resolve the matter without Board intervention have been unavailing, as opposing counsel has not returned her telephone calls or responded to the October 28, 2005 email.

In response, petitioner contends that the motion should be denied because it is untimely, it fails to comply with Trademark Rule 2.120(e) because respondent did not meet and confer, and it lacks merit. As regards the timing of the motion, petitioner essentially argues that the motion is untimely because respondent did not raise any objections to the sufficiency of the responses until five and a half months after receiving the responses; and that accordingly,

the motion was not filed within a reasonable period of time after the responses were received.

As regards respondent's good faith effort to resolve this dispute, respondent argues that petitioner has not met its burden. Respondent specifically argues that respondent's email, received at 6:29pm Friday October 28, 2005 by counsel for petitioner, raised for the first time issues with respect to petitioner's document production; and that on the following business day, petitioner confirmed by letter that it did not have the majority of the documents that respondent sought, and would address respondent's newly raised issues in a separate letter; that respondent's lack of good faith effort in resolving this "so-called" discovery dispute is particularly evident because respondent filed its motion to compel the next business day after raising the alleged dispute for the first time; and that respondent did not give petitioner an adequate chance to respond to its newly raised discovery issues.

In reply, respondent contends that it did "endeavor" to meet and confer with opposing counsel before filing the instant motion; that eight days after receiving petitioner's responses (without any actual document production), respondent's counsel sent a letter to petitioner's counsel pointing out "apparent" deficiencies and inquiring as to when petitioner would produce the requested documents; that

respondent faced an October 31, 2005 deadline to file the motion to compel; and that because respondent did not return telephone calls or respond to emails prior to the deadline for filing the motion to compel, the parties were not able to reach an agreement [with regard to the alleged discovery dispute].

As an initial matter, the Board finds respondent's motion to compel timely. For much of the time between respondent's receipt of petitioner's responses and the filing of the motion to compel, this proceeding was suspended pending decision on petitioner's motion for summary judgment. Further, respondent filed its motion soon after the resumption of this case. Under these circumstances, the delay between respondent's receipt of the discovery responses and its filing of the motion to compel is reasonable.

However, the Board finds that respondent has not satisfied its obligation under Trademark Rule 2.120(e) to make a good faith effort to resolve discovery disputes prior to seeking the Board's intervention. As set forth in Trademark Rule 2.120(e), a party moving for an order compelling discovery must make a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion. In this regard, respondent's after hours email

notice to petitioner of the discovery dispute one business day prior to its filing of the motion to compel does not satisfy petitioner's obligations under Trademark Rule 2.120(e). Nor does the Board infer from this email, or the letter sent to petitioner's counsel on April 20, 2005, that opposer made a sufficient good faith attempt to resolve the instant discovery dispute.[2] It is clear that petitioner did not have an opportunity to respond to discovery, or confer with respondent's counsel, regarding the matters at issue, as set forth in repondent's counsel's email of October 28, 2005, prior to respondent's filing of the motion to compel on October 31, 2005, one business day after the correspondence was sent. While the Board can appreciate the time constraints that petitioner was under as regards its filing of the motion to compel, the better practice would have been for petitioner to seek only a resetting of the testimony periods to allow the parties time to attempt to resolve the discovery dispute before filing its motion.

Moreover, it is apparent from the total number of discovery requests in dispute that the parties have failed to make a substantial effort to resolve by agreement the issues raised in opposer's motion to compel. *See* Trademark Rule 2.120. At least some of the problems herein should be resolved without Board intervention, and the Board suggests that the

[2] Petitioner's counsel, however, could have been more responsive to opposing counsel's telephone calls.

parties make a greater effort to avoid or resolve such controversies.

In view of the foregoing, respondent's motion to compel is denied.[3]

The Board notes petitioner's claim that it "does not have the documents responsive to the majority of Respondent's discovery requests."[4] If, however, petitioner is withholding documents on the basis of an express claim of attorney-client privilege and/or work product, petitioner must provide a privilege log, or inform respondent that such documents or information do not exist. See Fed. R. Civ. P. 26(b)(5).

We also remind the parties that the Board expects parties to cooperate with one another in the discovery process, and looks with extreme disfavor upon those who do not. Each party and its attorney or other authorized representative has a duty not only to make a good faith effort to satisfy the discovery needs of its adversary, but also to make a good faith effort to seek only such discovery

---

[3] Respondent's motion that petitioner be precluded from relying on documents or information responsive to Request Nos. 1, 2, and 35 that it has not produced in discovery, buried in the conclusion of respondent's reply brief, is improper, and premature, and will not be further considered.

[4] It is hoped that the documents to be produced, including, a copy of petitioner's COLA for RUSSKAYA vodka and a copy of petitioner's trademark application for RUSSKAYA have been produced in the time that has elapsed since the filing of the motion to compel.

as is proper and relevant to the issues in this case. TBMP § 402.01 (2d ed. rev. 2004).

No further motions to compel should be filed unless the parties are truly unable, after making their best efforts, to work out mutually acceptable solutions to all of their discovery problems without the Board's help.

The parties are also reminded of the duty to supplement discovery responses in proceedings before the Board. Under Fed. R. Civ. P. 26(e)(2), a party, which has responded to a request for discovery, with a response, is under a duty to supplement or correct the response to include information thereafter acquired under the particular circumstances specified in paragraph (e)(2). See TBMP Section 408.03. (2d ed. rev. 2004). Contrary to petitioner's position, this duty extends beyond the close of discovery.

Moreover, the parties are cautioned that if proper discoverable matter is withheld from the requesting party, then the responding party will be precluded from relying on such information and from adducing testimony with regard thereto during its testimony period. See *Shoe Factory Supplies Co. v. Thermal Engineering Company*, 207 USPQ 517 (TTAB 1980); and *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, at fn.5 (TTAB 1988).

Considering now the motion to extend, respondent contends that it would be severely prejudiced if the current

deadlines are not extended. Respondent specifically argues that its lead counsel who, at the time the motion was filed, was in the process of transferring firms, learned that her new firm may have a conflict of interest that would prevent her from continuing to handle this matter; and that given the complicated nature of the dispute, the matter could not be transitioned to the new firm, or new counsel, overnight.

In response, petitioner essentially argues that respondent will suffer no prejudice in this proceeding if the motion were denied because counsel has since confirmed that she will be representing respondent with her new firm; and that counsel could have "easily" began transitioning this proceeding to her new firm, or to another attorney familiar with the proceeding at her old firm, as early as September 29, 2005, when she first announced her intention to change firms.[5]

In reply, petitioner essentially reiterates its position that the extension is needed to allow its lead counsel to transition to a new firm.

Notwithstanding petitioner's arguments to the contrary, the Board finds that respondent has shown good cause for the requested extension, inasmuch as respondent has not abused

[5] The Board notes petitioner's request for a telephone hearing on the matter. However, inasmuch as the motion was fully briefed, telephone disposition is not appropriate. Petitioner is advised to review TBMP § 502.06(a)(2d ed. rev. 2004), regarding telephone conferences.

its privilege of extension and because there is no evidence of negligence or bad faith on the part of respondent or its counsel. See, *e.g.*, *American Vitamin Products Inc., v. DowBrands Inc.*, 22 USPQ2d 1313 (TTAB 1992); and *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147 (TTAB 1985). However, inasmuch as almost a year has passed since the motion was filed, counsel should have completed her transition, and the Board need not further delay this case.

Proceedings herein are resumed and trial dates are reset below:

THE PERIOD FOR DISCOVERY TO CLOSE:	CLOSED
30-day testimony period for party in position of plaintiff to close:	December 5, 2006
30-day testimony period for party in position of defendant to close:	February 3, 2007
15-day rebuttal testimony period to close:	March 20, 2007

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.l25.

Briefs shall be filed in accordance with Rule 2.l28(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.

****