

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

CME/WF

October 3, 2019

Cancellation No. 92065178 (parent)

Cancellation No. 92065255

*Philanthropist.com, Inc.*

*v.*

*The General Conference Corporation of  
Seventh-day Adventists*

**Christen M. English, Administrative Trademark Judge:**

This case now comes up on Respondent's motion to reopen discovery, filed April 18, 2019. 31 TTABVUE. The motion is fully briefed.

**I. BACKGROUND AND THE BASIS FOR RESPONDENT'S MOTION**

In these consolidated proceedings, Petitioner seeks cancellation of Respondent's registrations for the mark ADVENTIST on the ground that the mark is generic for the goods and services identified in Respondent's registrations.<sup>1</sup> Discovery closed in these consolidated proceedings on August 16, 2018. 18 TTABVUE and 19 TTABVUE. On September 29, 2018, the day before Petitioner's deadline to serve pretrial disclosures, Respondent filed a motion for summary judgment. 22 TTABVUE. On

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<sup>1</sup> Registration Nos. 1176153 and 1218657, issued November 3, 1981 and November 30, 1982, respectively.

March 28, 2019, the Board denied Respondent's motion for summary judgment and reset deadlines starting with Petitioner's deadline to serve pretrial disclosures on April 19, 2019. 30 TTABVUE 10. On April 16, 2019, Petitioner served pretrial disclosures. 31 TTABVUE 38-41.

Respondent argues that discovery should be reopened because "it has recently become clear that Petitioner failed to comply with its discovery obligations during the original discovery period." 31 TTABVUE 2. Specifically, Respondent argues that it was "blindsided" when Petitioner referenced in its summary judgment brief four publications that Respondent asserts were "directly responsive to several of [its] discovery requests," but not produced, namely: (1) J. Gordon Melton's ENCYCLOPEDIA OF AMERICAN RELIGIONS, (2) the Fourteenth Edition of the HANDBOOK OF DENOMINATIONS IN THE UNITED STATES; (3) WILLIAM MILLER AND THE RISE OF ADVENTISM, and (4) THE GREAT SECOND ADVENT MOVEMENT, ITS RISE AND PROCESS (collectively the "Four Publications"). 31 TTABVUE 4-5. Respondent further argues that discovery should be reopened because Petitioner, in its pretrial disclosures, has indicated that it may rely on other documents that it has not produced "such as 'media, news and opinion articles'; 'scholarly journals and publications'; and 'documents reflecting consumer views or comments about the word 'Adventist,'" along with 'as yet unascertained' documents allegedly showing the genericness of [Respondent's] mark." *Id.* at TTABVUE 9.

## II. ANALYSIS<sup>2</sup>

Contrary to Respondent's assertion, it is not at all clear that Petitioner failed to comply with its discovery obligations during the "original discovery period." Indeed, the Board finds no basis on the current record to consider reopening discovery.

Petitioner has explained that the Four Publications "were not in Petitioner's possession, custody, or control during the discovery period[, which closed August 16, 2018]. They were purchased by Petitioner ... on October 15, 2018 ... for the narrow purpose of refuting assertions made by Drs. Wahlen and Reid" in Respondent's motion for summary judgment. 32 TTABVUE 3. Accordingly, Petitioner could not have produced the publications during discovery. Moreover, Respondent's assertion that it was "blindsided" by Petitioner's reference to the Four Publications in its summary judgment opposition brief strains credulity because the Four Publications are typical of the types of documents that parties rely on in genericness cases. "The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question." *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986); *see also Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1830 (Fed. Cir. 2015). "[E]vidence of the public's perception may be obtained from 'any competent source, such as consumer surveys, dictionaries, newspapers and other publications.'"

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<sup>2</sup> The Board has carefully considered all of the parties' arguments.

*Princeton Vanguard*, 114 USPQ2d at 1833. These circumstances do not constitute a basis to reopen discovery that has been closed for more than one year.

Turning to Petitioner's pretrial disclosures, Petitioner has identified the categories of documents that it **may** rely on at trial; it is not required to identify each document or exhibit it plans to introduce prior to trial. Trademark Rule 2.121(e); *Kate Spade LLC v. Thatch, LLC*, 126 USPQ2d 1098, 1103 (TTAB 2018); TBMP § 702.01. It should come as no surprise to Respondent that Petitioner may rely at trial on media, news, and opinion articles and scholarly journals as it is common practice to introduce these types of documents in genericness cases. *Princeton Vanguard*, 114 USPQ2d at 1833. Moreover, the record does not establish that Petitioner had such documents in its possession, custody, or control during discovery, and the Board does not make such a presumption because it is not uncommon for parties to collect such documents during or in imminent anticipation of trial. *Cf. Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066 (TTAB 2011) (denying motion to strike evidence of third-party use because applicant had no duty to investigate such evidence in response to discovery requests, applicant collected the evidence during trial, and such evidence is commonly introduced in likelihood of confusion cases).

The Board will not reopen discovery based on the mere possibility that Petitioner may introduce documents at trial that it should have, but did not produce. *Cf. RTX Scientific Inc. v. Nu-Calgon Wholesaler Inc.*, 106 USPQ2d 1492, 1493 ("The Board does not make prospective or hypothetical evidentiary rulings"). If the facts warrant, Respondent's remedy lies in objecting to Petitioner's evidence in its main brief or in

a motion to strike.<sup>3</sup> *Panda Travel, Inc. v. Resort Options Enters., Inc.*, 94 USPQ2d 1789, 1792-93 (TTAB 2009); TBMP § 527.01(e).

In view of the foregoing, Respondent's motion to reopen is **denied**. But Petitioner has a duty to supplement its discovery responses if it is now in possession of documents responsive to properly propounded discovery requests<sup>4</sup> that were not in its possession, custody, or control during discovery.<sup>5</sup> Fed. R. Civ. P. 26(e); TBMP § 408.03.

### III. PROCEEDING RESUMED

Proceedings are resumed and dates are reset as follows:

Plaintiff's Pretrial Disclosures Due <sup>6</sup>	11/8/2019
Plaintiff's 30-day Trial Period Ends	12/23/2019
Defendant's Pretrial Disclosures Due	1/7/2020
Defendant's 30-day Trial Period Ends	2/21/2020
Plaintiff's Rebuttal Disclosures Due	3/7/2020
Plaintiff's 15-day Rebuttal Period Ends	4/6/2020
Plaintiff's Opening Brief Due	6/5/2020

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<sup>3</sup> A motion to strike evidence will be deferred until final hearing if it requires the Board to examine the evidence. TBMP § 707.02(c).

<sup>4</sup> A discovery request is improper if it is the equivalent of asking a party to identify its trial evidence. *Time Warner Entm't Co. v. Jones*, 65 USPQ2d 1650, 1657 (TTAB 2002).

<sup>5</sup> Petitioner may not withhold responsive documents within its possession, custody or control on the ground that they are publicly available documents. If Petitioner is withholding responsive documents based on the attorney work product doctrine, it must specifically assert the privilege in response to the relevant discovery request(s) and produce a privilege log. Fed. R. Civ. P. 26(b)(5)(A). The Board notes that work product may be "factual, or the result of mental processes such as plans, strategies, tactics, and impressions." *In re Seagate Tech. LLC*, 497 F.3d 1360, 83 USPQ2d 1865, 1874 (Fed. Cir. 2007) (explaining Fed. R. Civ. P. 26(b)(3)), abrogated on the other grounds by *Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 136 S.Ct. 1923, (2016).

<sup>6</sup> The Board treats proceedings suspended as of April 18, 2019, when Respondent filed its motion to reopen. Although Petitioner has served pretrial disclosures, because Petitioner's pretrial disclosure deadline had not yet passed when Respondent filed its motion, the Board includes the deadline for the first testimony period in the proceeding schedule.

Defendant's Brief Due	7/5/2020
Plaintiff's Reply Brief Due	7/20/2020
Request for Oral Hearing (optional) Due	7/30/2020

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, 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).