

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

January 4, 2021

Cancellation No. 92065883 (Parent Case)

*Joseph Valenti,
NERO International Holding Co., Inc., and
NERO Live Adventure Games, LLC*

v.

William J. Bearden dba NERO Central

Cancellation No. 92065911

*Joseph Valenti,
NERO International Holding Co., Inc., and
NERO Live Adventure Games, LLC*

v.

NERO World, LLC

Lawrence T. Stanley, Jr., Interlocutory Attorney:

This case now comes before the Board on Respondents' motion, filed August 14, 2020, to compel discovery and extend deadlines. The motion is fully briefed.

The Board has carefully considered all of the parties' arguments, presumes the parties' familiarity with the bases for their filings, and does not recount the facts or arguments here except as necessary to explain this decision. *See Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

I. Background

On March 31, 2019, Respondents served their first set of interrogatories and first set of requests for production (collectively, “Respondents’ Discovery Requests”). 64 TTABVUE 65-75. On May 1, 2019, Petitioners served their responses to Respondents’ document requests.¹ *Id.* at 28-41.

On August 1, 2020, Respondents emailed Petitioners, requesting, inter alia, that Petitioners: (1) remove their general and boilerplate objections from their interrogatory responses; (2) produce all documents responsive to the document requests; and (3) identify any terms that Petitioners contend they need defined. *Id.* at 26-27. On August 4, 2020, Petitioners responded that they intend to “update [their] discovery, as needed” but that “no objections will be removed.” *Id.* at 23. Petitioners undertook to update their discovery and produce documents by August 10, 2020. *Id.* On August 5, 2020, Respondents responded that Petitioners’ “objections need to be removed or [Respondents] will have to file motions.” *Id.* at 21. On August 6, 2020, Respondents again requested that Petitioners remove their objections. *Id.* at 19-20. The same day, Petitioners responded, again saying that they will supplement their discovery responses but that “[a]ny objection timely made will remain.” *Id.* at 19. Respondents responded the same day, asking for confirmation that Petitioners were unwilling to remove their objections. *Id.* at 16-18. The parties thereafter

¹ Respondents did not attach a copy of Petitioners’ initial responses to Respondents’ interrogatories, and it is unclear from the record when Petitioners served their initial responses to Respondents’ interrogatories. However, Respondents did attach a copy of Petitioners’ supplemental responses to Respondents’ interrogatories, served August 10, 2020, which include Petitioners’ initial and supplemental responses. 64 TTABVUE 42-64.

communicated regarding the definitions in their respective discovery requests (*id.* at 13-16), and on August 10, 2020, Petitioners served supplemental responses to Respondents' interrogatories (*id.* at 42-64).²

On August 14, 2020, Respondents filed the present motion to compel, in which they seek an order:

(1) compelling Petitioners to respond to to [sic] Respondents' discovery requests without objection and barring them from using responsive facts or documents at trial unless they are now produced,

(2) extending the discovery deadline by at least forty-five (45) days from the date of the Board's order on this motion for the sole purpose of allowing Respondents the opportunity to review Petitioners' produced documents and supplemental discovery responses and to take depositions or pursue other discovery based on such documents and responses; and

(3) granting such other relief as the Board deems just and proper.

64 TTABVUE 2.

II. Good Faith Effort

Trademark Rule 2.120(f)(1) requires that a motion to compel discovery "must be supported by a showing from the moving party that such party or the attorney therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion but the parties were unable to resolve their differences." *See, e.g., Hot Tamale Mama...and More, LLC v. SF Invs., Inc.*, 110 USPQ2d 1080, 1081 (TTAB 2014); *see also*

² Throughout the parties' correspondence, they also discuss concerns that Petitioners have with Respondents' responses to Petitioners' discovery requests. 64 TTABVUE 13-24; 67 TTABVUE 7-19.

TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 523.02 (2020).

Respondents' counsel submitted a declaration, which details the correspondence between counsel, together with copies of that correspondence. 64 TTABVUE 10-27. In that correspondence, Respondents repeatedly request that Petitioners withdraw their objections to Respondent's Discovery Requests. Although Petitioners supplemented their responses to Respondents' interrogatories and have produced documents in response to Respondents' requests for production since Petitioners raised their concerns, Petitioners do not state that they have not withheld any documents based on their objections, and they have not withdrawn any of their objections to Respondents' Discovery Requests.

The Board has reviewed the briefs, arguments, declaration, and attachments, and the Board finds that, with respect to Petitioners' objections to Respondents' Discovery Requests, Respondents have satisfied the good faith effort requirement prior to the filing of their motion to compel.³

³ Respondents' motion to compel is limited in scope to seeking a Board order overruling Petitioners' objections. Although Respondents cite Petitioners' responses to Interrogatory Nos. 1, 3, 4, 28, and 29 as examples where allegedly improper objections were raised (64 TTABVUE 6-8, n. 15-17 and 21-25), Petitioners argue in their response to Respondents' motion to compel, inter alia, that their responses to Interrogatory Nos. 1 and 4 are sufficient notwithstanding their objections and that the information requested in response to Interrogatory No. 29 is "moot" as a result of the Board's July 30, 2020 order (67 TTABVUE 3-4). In reply to their motion to compel, Respondents argue, inter alia, that the information sought in Interrogatory Nos. 20, 28, and 29 is relevant and that Petitioners' responses are insufficient. 68 TTABVUE 3-5. Respondents did not move to compel regarding the sufficiency of any specific response to Respondents' Discovery Requests; nor did Respondents satisfy the good faith effort requirement of Trademark Rule 2.120(f)(1) sufficient to challenge the sufficiency of any specific response.

The Board next proceeds to the merits of the discovery dispute at issue in Respondents' motion to compel.

III. Determination

A. Petitioners' General and Boilerplate Objections

In response to Respondents' requests for production, Petitioners include a list of "Preliminary Statements" and "General Objections." 64 TTABVUE 29-31. In response to at least Request for Production Nos. 1-19 and 22-23, Petitioners object that the request is "premature in light of the fact that discovery is still ongoing and that it is overly broad and unduly burdensome." *Id.* at 32-40. In response to at least Request for Production Nos. 1-21, Petitioners object because "no definitions have been provided." *Id.* In response to at least Request for Production Nos. 10, 19, 22, and 23, Petitioners object that the requested documents are "equally accessible and within the possession, custody and/or control of Defendants." *Id.* at 35 and 38-40.

In response to Respondents' interrogatories, Petitioners include a list of "Preliminary Statements" and "General Objections." 64 TTABVUE 43-45. In response to at least Interrogatory Nos. 1-38, Petitioners object because "no definitions have been provided." *Id.* at 45-63. In response to at least Interrogatory Nos. 1-2, 4, 8, 28-30, and 35-37, Petitioners object that the interrogatory is "premature in light of the fact that discovery is still ongoing and reserves its right to modify or supplement this response." *Id.* In response to at least Interrogatory Nos. 1-2, 28, and 35-37, Petitioners object that the interrogatory is "unduly burdensome and do[es] not identify with particularity the information sought." *Id.* In response to at least Interrogatory Nos. 5-7, 10-14, 19-27,

31-34, and 38, Petitioners object that the interrogatory “is vague, [is] ambiguous, do[es] not identify with particularity the information sought, [is] unduly burdensome, or [is] otherwise incomprehensible.” *Id.*

Each of these objections is **overruled**. It is incumbent upon a party who has been served with discovery requests to respond by articulating its objections with particularity to each request which it believes to be objectionable, and by providing the information sought which it believes to be proper. *See Medtronic, Inc. v. Pacesetter Sys., Inc.*, 222 USPQ 80, 83 (TTAB 1984). The burden of persuasion is on the objecting party to show that the request should not be answered. *See id.*

Petitioners’ general and boilerplate objections do not claim that the requests are objectionable in any **specific** manner, including specifically that the above-identified requests: (1) “are premature in light of the fact that discovery is still ongoing,” (2) are “overly broad,” “unduly burdensome,” “vague,” “ambiguous,” and/or “indecipherable,” (3) require speculation because “no definitions have been provided” but without identifying any words that need to be defined, and (4) seek documents that are “equally accessible and within the possession, custody and/or control of Defendants.” *See Amazon Techs., Inc. v. Wax*, 93 USPQ2d 1702, 1705-06 (TTAB 2009) (“general objections” to interrogatories and document requests found to be “anything but specific”); *Medtronic, Inc.*, 222 USPQ at 83 (party must articulate objections with particularity). Indeed, in response to Respondents’ motion to compel, Petitioners do not argue in support of any of these objections. *See Medtronic, Inc.*, 222 USPQ at 83;

TBMP § 402.02 (“[T]he party resisting discovery must show that the material sought is not reasonably accessible because of undue burden or cost.”).

B. Petitioners’ Specific Objections

Although the vast majority of Petitioners’ objections were improper boilerplate objections, Petitioners did include certain specific objections, which the Board addresses next.

First, in response to at least Interrogatory Nos. 3 and 9, Petitioners object that the interrogatory “is vague, [is] ambiguous, do[es] not identify with particularity the information sought, or [is] otherwise incomprehensible since it is unclear which Amended Petition for Cancellation Defendants are referring to.” 64 TTABVUE 47 and 50. Respondents do not specifically address this objection in their motion to compel, but they do request that Petitioners be compelled to respond without objection to Respondents’ Discovery Requests and this objection is mentioned in both Petitioners’ response to Respondents’ motion to compel (67 TTABVUE 4) and Respondents’ reply in support of their motion (68 TTABVUE 4). In the parties’ meet and confer correspondence, Respondents clarified that the interrogatories refer to the “operative petition” (64 TTABVUE 18), and Respondents did the same in their reply to their motion to compel (68 TTABVUE 4). The Board notes that Petitioners served a supplemental response to Interrogatory No. 3 (64 TTABVUE 47) and substantively responded to Interrogatory No. 9 (*id.* at 50). Accordingly, to the extent Respondents intended their motion to compel to challenge this objection, the Board finds that Respondents’ motion to compel is **moot**.

Second, in response to at least Interrogatory Nos. 15-18, Petitioners object to the extent the interrogatory “is vague, [is] ambiguous, do[es] not identify with particularity the information sought, [is] unduly burdensome, or [is] otherwise incomprehensible since it is unclear as to the definition of ‘advertisements.’” 64 TTABVUE 53-54. Petitioners’ objection is **overruled**. Petitioners do not explain why the term “advertisements” is unclear, and in their response to each of these interrogatories, Petitioners use the allegedly disputed term by stating that Respondents may view Petitioners’ “advertisements” on certain websites. *Id.*

In response to at least Interrogatory Nos. 4, 8, 29, and 30, Petitioners object to the interrogatory “as unduly burdensome since the Trademark Trial and Appeal Board does not issue monetary amounts for damages.” *Id.* at 47-50 and 59-60. The Board is empowered to determine only the right to register. *See* Trademark Act Section 17. The Board cannot assess monetary damage awards. *General Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1591 (TTAB 2011) (no authority to determine the right to use, or the broader questions of infringement, unfair competition, damages or injunctive relief). Indeed, Fed. R. Civ. P. 26(a)(1)(A)(iii) (regarding computation of damages) is inapplicable to Board proceedings. TBMP § 401.02. Accordingly, to the extent that Respondents have sought an itemized computation of damages in Interrogatory Nos. 4, 8, 29, and/or 30, Petitioners’ objection is **sustained**.

C. Petitioners' Privilege Objections

In response to at least Request for Production Nos. 1-9, 11-18, and 20-21 (64 TTABVUE 32-39) and Interrogatory Nos. 1-2, 28, and 35-37 (*id.* at 45-46, 59, and 62-63), Petitioners object that the request “calls for privileged information protected by the attorney-client privilege and/or work product doctrine.”

The parties do not dispute that Petitioners have not served a privilege log, and in response to Respondents' motion to compel, Petitioners do not contend that they are withholding any information on the basis of the attorney-client privilege or work product doctrine.⁴ If a party objects on the grounds of privilege, that party must produce a privilege log identifying the withheld information. *See Hewlett Packard Enter. Dev. LP v. Arroware Indus., Inc.*, 2019 USPQ2d 158663, 2019 BL 158663, *10 (TTAB 2019) (“If a party is withholding responsive documents on the basis of a claim of privilege, that party must ‘(i) expressly make the claim; and (ii) describe the nature of the documents, communications, or tangible things not produced or disclosed — and do so in a manner that, without revealing information itself privileged or protected, will enable other parties to assess the claim.’”) (quoting Fed. R. Civ. P. 26(b)(5)(A)(i)-(ii)); *Amazon Techs., Inc.*, 93 USPQ2d at 1706 n.6 (“[T]o the extent opposer maintains its objections based on the attorney-client privilege or attorney

⁴ In response to Respondents' Discovery Requests, Petitioners included a general objection that they object to the requests “generally to the extent they call for discovery into matters protected by the attorney/client privilege, work product immunity, and/or any other applicable privileges or immunities.” 64 TTABVUE 30 (responses to requests for production) and 44 (supplemental responses to interrogatories). As noted *supra* at p. 5-6, Petitioners' general objections are overruled. Furthermore, the Board does not construe Petitioners' inclusion of a broad, general objection as an indication that they are actually withholding privileged information responsive to Respondents' Discovery Requests.

work product doctrine, it must produce a privilege log.”); *No Fear, Inc. v. Rule*, 54 USPQ2d 1551, 1556 (TTAB 2000) (privilege objections require “a particularized explanation of the privilege relied on, and a description of the documents which, without revealing the privileged information, is sufficient to allow the inquiring party to assess the applicability of the privilege”); *see also* TBMP § 406.04(c).

Accordingly, to the extent that Petitioners are withholding any information responsive to any of Respondents’ Discovery Requests on the basis of privilege, Petitioners are ordered to provide Respondents a privilege log within **thirty days** from the date of this order, if they have not already done so.

D. Fed. R. Civ. P. 33(d)

In response to at least Interrogatory Nos. 3, 5-7, 9-27, 31, 33, 34, and 38, Petitioners rely on Fed. R. Civ. P. 33(d) in that Petitioners state that they will produce documents responsive to the interrogatories and that “[t]he answer to [the] interrogatory may be ascertained from the produced documents and the burden of ascertaining that answer is substantially the same for [Respondents] as it would be for Petitioners.” 64 TTABVUE 47-63.

Fed. R. Civ. P. 33(d) permits a responding party, under certain circumstances, to respond to an interrogatory by specifying its business records from which the information may be derived or ascertained. *See* TBMP § 405.04(b). “The Board has repeatedly explained that a party must comply with three specific requirements to invoke Rule 33(d).” *Hewlett Packard Enter. Dev. LP*, 2019 BL 158663 at *8. “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.” *Id.* (quoting *No Fear*, 54 USPQ2d at 1555). “Second, ‘a party who responds to interrogatories by invoking Rule 33(d) ... has the duty to specify, by category and location, the records from which the answers to [the] interrogatories can be derived.” *Id.* (quoting *Jain v. Ramparts, Inc.*, 49 USPQ2d 1429, 1433 (TTAB 1998)). “Third, even if the responding party can meet the first two requirements, ‘the inquiring party must not be left with any greater burden than the responding party when searching through and inspecting the records.” *Id.* (quoting *No Fear*, 54 USPQ2d at 1555)). “Factor three is considered only where ‘the first two prerequisites ... have been met by the party seeking to invoke Rule 33(d).” *Id.* (quoting *Jain*, 49 USPQ2d at 1434).

Petitioners have not met these requirements. As an initial matter, Petitioners fails to specify why providing written responses would impose a significant burden. *See Jain*, 49 USPQ2d at 1433 (the burden must be “above and beyond the normal burden involved in providing written responses to interrogatories.”).

Petitioners also fail to specify in sufficient detail where the answers to the interrogatories can be ascertained. In their initial responses to Interrogatory Nos. 3, 5, 6, 7, 10-27, 31, 33, 34 and 38 (64 TTABVUE 47-63), Petitioners fail to identify any documents responsive to the interrogatories. In their supplemental responses to Interrogatory Nos. 3, 10, 11, 19, 20, and 23 (*id.*), Petitioners generally refer to their motion for summary judgment at 42 TTABVUE, which comprises over 1000 pages of documents, including exhibits also attached at 43, 44, and 45 TTABVUE. These

responses lack sufficient specificity. Because Petitioners do not meet the first two prerequisites, the Board does not need to address the third requirement.

Accordingly, Petitioners have not satisfied the requirements of Fed. R. Civ. P. 33(d) as a means of responding to Interrogatory Nos. 3, 5-7, 9-27, 31, 33, 34, and 38. Respondents' motion to compel is **granted** with respect to Interrogatory Nos. 3, 5-7, 9-27, 31, 33, 34, and 38 to the extent that Petitioners must provide sworn, complete, and narrative responses to each of these interrogatories.

IV. Motion to Extend

Pursuant to Fed. R. Civ. P. 6(b)(1)(A), made applicable to Board proceedings by Trademark Rule 2.116(a), the appropriate standard for allowing an extension of a specified time period prior to the expiration of that period is "good cause." Here, Respondents filed their request to extend the discovery period before the discovery period expired on November 28, 2020. Therefore, the proper standard to apply is good cause.

Generally, "the Board is liberal in granting extensions of time before the period to act has elapsed, so long as the moving party has not been guilty of negligence or bad faith and the privilege of extensions is not abused." *Am. Vitamin Prods. Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1315 (TTAB 1992). The Board does not find bad faith or negligence on the part of Respondents in seeking the extension. Nor have Respondents abused the privilege of extensions. However, the Board notes that nearly one hundred days remained in the discovery period when proceedings were suspended for Respondents' motion to compel. 65 TTABVUE. The Board finds that

Respondents' requested extension of an additional forty-five days is excessive under the circumstances. The Board finds good cause to extend the proceeding dates but for only **twenty-one days**. Accordingly, Respondents' request to extend is **granted in part**, and dates are extended as set forth in the schedule below.

V. Summary

In view of the foregoing, Respondents' motion to compel is **granted in part, denied in part**, and **moot in part**, to the extent indicated herein.

Petitioners allowed until **thirty days** from the date of this order in which to provide full and complete **written** supplemental responses to Respondents first set of interrogatories, and said responses must be **verified**.

Petitioners are allowed until **thirty days** from the date of this order in which to provide full and complete **written** supplemental responses Respondents' first set of requests for production. To the extent Petitioners have already **fully** produced documents responsive to any of the requests for production, Petitioners must so state in their response to the particular request and identify, by Bates number, the documents that are responsive to each request. If Petitioners have no further documents to produce in response to any such requests for production, Petitioners are ordered to confirm that Petitioners have no additional, unproduced responsive documents.

Petitioners are also allowed until **thirty days** from the date of this order to copy and produce all unproduced non-privileged documents responsive to Respondents' requests for production, to the extent set forth by this order. If the production of

documents to any particular request is voluminous, Petitioners may produce a representative sampling of documents. Such representative sampling, however, must be sufficient to meet Respondents' discovery needs.

Additionally, Petitioners are required to provide Respondents with a privilege log within the same **thirty days** provided above to the extent that Petitioners claim privilege to any of Respondents' Discovery Requests, if they have not already done so.

Should Petitioners not comply with the Board's orders herein, Respondents may seek appropriate sanctions. *See* Trademark Rule 2.120(h); and TBMP §§ 411.05 and 527.01.

Respondents' request to extend the discovery period is **granted in part**.

Petitioners are reminded that, upon timely objection from Respondents, they may be precluded from relying at trial upon information or documents that were properly sought, but not disclosed, during discovery, unless such failure to disclose "was substantially justified or is harmless." Fed. R. Civ. P. 37(c)(1); *Panda Travel Inc. v. Resort Option Enters. Inc.*, 94 USPQ2d 1789, 1792 (TTAB 2009).

The Board emphasizes that the parties have a duty to thoroughly search their respective records for all documents and information properly sought in the other party's discovery requests. TBMP § 408.02. The parties are further reminded that each party and its attorney has a duty to make a good faith effort to satisfy the legitimate discovery needs of its adversary, and the Board expects parties and their attorneys to cooperate with one another in the disclosure and discovery process. *See Sentrol, Inc. v. Sentex Sys., Inc.*, 231 USPQ 666, 667 (TTAB 1986); *Panda Travel Inc.*,

94 USPQ2d at 1791 (“Each party has a duty to make a good faith effort to satisfy the reasonable and appropriate discovery needs of its adversary.”); *see also* TBMP § 408.01. A party will not be heard to contend that its discovery request is proper but that its adversary’s similar request is not. *See* TBMP § 402.01 and Note 11 thereto. Failure to cooperate saddles the Board with needless motions and burdens it with resolving disputes which should be resolved by the parties. *See Domond v 37.37, Inc.*, 113 USPQ2d 1264, 1265 (TTAB 2015).

The Board notes Petitioners’ request for a telephone conference on this motion. 66 TTABVUE. While the Board did not find a telephone conference necessary to resolve this motion, **from this point forward, prior to filing any future unconsented motions, the parties must first contact the assigned Interlocutory Attorney by telephone to schedule a telephone conference.**⁵ The parties should be prepared to discuss the “good faith effort” that has been made to resolve any discovery disputes prior to seeking the Board’s intervention.

VI. Trial Schedule

Proceedings herein are hereby **resumed**. Remaining trial dates are reset as follows:

Expert Disclosures Due	4/5/2021
Discovery Closes	5/5/2021
Plaintiff’s Pretrial Disclosures Due	6/19/2021
Plaintiff’s 30-day Trial Period Ends	8/3/2021
Defendant’s Pretrial Disclosures Due	8/18/2021
Defendant’s 30-day Trial Period Ends	10/2/2021

⁵ The assigned Interlocutory Attorney, Lawrence T. Stanley, Jr., may be reached at 571-272-6442.

Plaintiff's Rebuttal Disclosures Due	10/17/2021
Plaintiff's 15-day Rebuttal Period Ends	11/16/2021
Plaintiff's Opening Brief Due	1/15/2022
Defendant's Brief Due	2/14/2022
Plaintiff's Reply Brief Due	3/1/2022
Request for Oral Hearing (optional) Due	3/11/2022

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 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).