

UNITED STATES PATENT AND TRADEMARK OFFICE  
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April 23, 2021

Cancellation No. **92068467**

*U.G.A. Nutraceuticals SRL*

*v.*

*Maple Mountain Group, Inc.*

**Yong Oh (Richard) Kim, Interlocutory Attorney:**

On April 13, 2021, the Board held a telephone conference to hear argument and rule on the parties' cross-motions to compel discovery.<sup>1</sup> George R. Spatz, Esq., and Sanjay S. Karnik, Esq., of Amin Talati Wasserman, LLP appeared as counsel for Petitioner and Robyn L. Phillips, Esq., and John C. Stringham, Esq., of Workman Nydegger appeared as counsel for Respondent.

Petitioner's Motion to Compel

Turning first to Petitioner's motion, Petitioner served its first set of requests for production of documents on March 25, 2019.<sup>2</sup> On April 24, 2019, Respondent served objections on the ground that the requests exceeded the limit as provided under Trademark Rule 2.120(e), 37 C.F.R. § 2.120(e).<sup>3</sup> On August 12, 2019, Petitioner

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<sup>1</sup> 32 TTABVUE and 34 TTABVUE.

<sup>2</sup> 34 TTABVUE 8-17.

<sup>3</sup> *Id.* at 18-35.

served an amended set of requests for production<sup>4</sup> to which Respondent responded on October 11, 2019,<sup>5</sup> pursuant to a thirty-day extension for response granted by Petitioner.<sup>6</sup> During that time, the proceedings were otherwise suspended pending disposition of a motion to compel filed by Respondent<sup>7</sup> and resumed on February 3, 2020.<sup>8</sup> Following a meet and confer on April 30, 2020,<sup>9</sup> Respondent supplemented its document production on May 16, 2020.<sup>10</sup> However, the parties discovered on July 30, 2020, that Petitioner did not receive the documents because the email serving the documents was quarantined “due to the unknown status of the paralegal’s email address” from which service was made, so Respondent re-served the documents the following day on July 31, 2020.<sup>11</sup>

On November 19, 2020, Petitioner moved to compel further production on the ground that Respondent “produced a total of 17 documents making up 183 pages, consisting almost exclusively of publicly available documents related to the prosecution and assignment of the trademark” and that “[n]o documents were produced that were responsive to Petitioner’s requests concerning current and past use, or intent to use (the central issue to this case).”<sup>12</sup>

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<sup>4</sup> *Id.* at 38-35.

<sup>5</sup> *Id.* at 46-73, 76.

<sup>6</sup> *Id.* at 3.

<sup>7</sup> 19 TTABVUE.

<sup>8</sup> 23 TTABVUE.

<sup>9</sup> 34 TTABVUE 77.

<sup>10</sup> *Id.* at 78,

<sup>11</sup> *Id.* at 4.

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

As noted during the conference, Trademark Rule 2.120(f)(1), 37 C.F.R. § 2.120(f)(1), requires the party moving to compel discovery responses to support its motion with a showing that a good faith effort was made to resolve with the other party the issues presented in the motion but that it was unable to do so. A mere statement of a good faith effort is insufficient. Rather, the statement must be “supported by a recitation of the communications conducted, including dates, a summary of telephone conversations, and copies of any correspondence exchanged, where applicable (e.g., emails, letters, notes to file).” *Hot Tamale Mama...and more, LLC v. SF Invs., Inc.*, 110 USPQ2d 1080, 1081 (TTAB 2014); *see also Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626, 632 (TTAB 1986) (failure to submit documentary evidence of good faith effort).

Here, Petitioner asserts nothing more than that the issue of Respondent’s failure to produce responsive documents was “raised ... with counsel for [Respondent] on a July 31, 2020 meet and confer conference via telephone.”<sup>13</sup> Setting aside that Petitioner received Respondent’s re-served documents the same day as the meet and confer and that the original purpose of the meet and confer was to discuss Petitioner’s responses to Respondent’s interrogatories,<sup>14</sup> Petitioner submitted no declaration, correspondence, or other documentary evidence to support its claim of a good faith effort. Indeed, Petitioner fails to even identify in its motion the particular document requests at issue or to provide an accounting of the requests that were putatively discussed during the meet and confer. Moreover, aside from an email on

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<sup>13</sup> *Id.*

<sup>14</sup> 32 TTABVUE 86.

October 29, 2020, nearly three (3) months after the meet and confer, wherein Petitioner asked Respondent to confirm that “documents requested on the issue of current or recent use ... don’t exist, or [to provide] a date certain on which [Petitioner] can expect to receive them,”<sup>15</sup> there is no indication that Petitioner followed up on the request or that anything further was done by Petitioner to resolve the issue prior to the filing of its motion to compel on November 19, 2020.

Since Petitioner failed to make adequate good faith efforts to resolve the discovery dispute raised in its motion, Petitioner’s motion to compel is **DENIED** as premature.

Respondent’s Motion to Compel

By its motion, Respondent seeks to compel Petitioner’s further responses to its first sets of interrogatories and requests for production of documents served on April 5, 2019. These were the subject of a previous motion to compel filed by Respondent on August 15, 2019, due to Petitioner’s failure to respond.<sup>16</sup> On October 16, 2019, prior to the Board’s decision on the motion, Petitioner untimely served its written responses to Respondent’s discovery requests.<sup>17</sup> On February 3, 2020, the Board granted Respondent’s motion to compel and allowed Petitioner until March 6, 2020, to respond in full and without objection on the merits to Respondent’s discovery requests.<sup>18</sup> As no deficiencies regarding Petitioner’s previously served

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<sup>15</sup> 35 TTABVUE 15.

<sup>16</sup> 18 TTABVUE.

<sup>17</sup> 32 TTABVUE 50-62, 64-74.

<sup>18</sup> 23 TTABVUE 3.

written responses were raised by Respondent, Petitioner did not amend or otherwise supplement its discovery responses and limited its response to Respondent's discovery requests to a production of documents.<sup>19</sup>

On April 3, 2020, Respondent dispatched a deficiency letter concerning Petitioner's responses to certain of Respondent's interrogatories.<sup>20</sup> A meet and confer was held on April 30, 2020, during which the parties narrowed the putative deficiencies in Petitioner's responses to Interrogatory Nos. 21-25 and 27, and mutually agreed to supplement their respective discovery responses.<sup>21</sup> On May 12 and July 29, 2020, Respondent inquired as to when Petitioner would supplement its responses to the previously discussed interrogatories and held a meet and confer on the issue on July 31, 2020.<sup>22</sup>

On October 26, 2020, in the absence of any supplementation by Petitioner, Respondent dispatched an email demanding Petitioner's supplementation to Interrogatory Nos. 21-25 and 27 by October 28, 2020.<sup>23</sup> On October 29, 2020, Petitioner responded that it would supplement its responses by November 5, 2020.<sup>24</sup> Notwithstanding such response, Respondent proceeded with its motion to compel discovery on October 30, 2020.

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<sup>19</sup> 33 TTABVUE 6.

<sup>20</sup> 32 TTABVUE 76-79.

<sup>21</sup> *Id.* at 81.

<sup>22</sup> *Id.* at 22.

<sup>23</sup> *Id.* at 90.

<sup>24</sup> 35 TTABVUE 15.

As with Petitioner's motion, the Board finds Respondent's motion to compel premature. First, to the extent Respondent seeks to compel further responses to certain of its requests for production of documents, i.e., Request Nos. 1-3, 7, 9-14, 20-26, and 28, there is no indication in any of Respondent's submissions that any putative deficiency with Petitioner's responses to these requests was ever identified or raised by Respondent to Petitioner. Although Respondent references the Board's prior order granting Respondent's motion to compel as the basis for its current motion to compel supplemental responses, Respondent cannot rely on such order to discharge or otherwise exempt Respondent from the good faith effort requirement that is a necessary prerequisite to any motion to compel since the purpose of the 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 Savings and Loan Ass'n*, 121 F.R.D. 284, 289 (N.D. Tex. 1988) (construing a local rule less onerous than Trademark Rule 2.120(f)(1)). Thus, even though Petitioner's discovery responses were served prior to the issuance of the Board's order compelling responses, those responses were not necessarily mooted by the Board's order as a matter of course. Rather, under these circumstances, it was incumbent upon Respondent to at least determine if Petitioner intended to serve new responses or to stand on its previously served responses in which case the Board would expect that Respondent would review the responses and confer with Petitioner to resolve any

perceived deficiencies prior to seeking resolution from the Board. This is particularly true where, as here, the only responses to document requests identified by Respondent as deficient, i.e., that documents will be produced “to the extent such documents exist,” are the same type of responses Respondent itself made to Petitioner’s document requests.<sup>25</sup> *Cf. Sentrol Inc. v. Sentex Sys., Inc.*, 231 USPQ 666, 667-68 (TTAB 1986) (parties who served identical discovery requests on each other in effect waived right to object and must answer each request completely).

In the absence of any effort by Respondent to confer on, let alone raise, the issue of deficiency regarding Petitioner’s responses, Respondent’s motion to compel as it relates to its requests for production of documents is **DENIED** as premature.

As to Respondent’s interrogatories, it is clear from the record that the issue of Petitioner’s deficient responses to certain of the interrogatories was raised and discussed between the parties. While Respondent’s frustration with Petitioner’s failure to supplement its interrogatory responses despite Respondent’s efforts, i.e., meet and confer on April 30, 2020; follow-up emails on May 12 and July 29, 2020; meet and confer on July 31, 2020; final demand email on October 26, 2020, is understandable, the filing of the motion was premature in view of Petitioner’s October 29 email stating that it would serve supplemental responses to the interrogatories at issue by November 5, 2020.<sup>26</sup> There was no impasse between the parties and the circumstances did not present such “an unresolvable situation” so as

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<sup>25</sup> See Registrant’s Responses to Petitioner’s Amended First Set of Requests for Production, 34 TTABVUE 46-73.

<sup>26</sup> 35 TTABVUE 15.

to warrant elevating the matter to the Board for resolution. *Hot Tamale Mama*, 110 USPQ2d at 1982. To the extent the timing of the motion was driven in part by approaching discovery deadlines, Respondent would have been better served seeking a brief extension of time to allow for a further and potential resolution of the discovery dispute rather than filing a motion to compel.

In view thereof, Respondent's motion to compel as it relates to its interrogatories is **DENIED** as premature.<sup>27</sup>

### Conclusion

As discussed during the conference, the parties shall meet and confer on the parties' outstanding discovery issues no later than **APRIL 27, 2021**, with each party's supplementation, if any, to occur within **THIRTY (30) DAYS** of the meet and confer.<sup>28</sup> Proceedings herein are **RESUMED** and the proceeding schedule, beginning with the expert disclosure deadline, is **RESET** as follows:

Expert Disclosures Due

**6/12/2021**

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<sup>27</sup> As part of its motion to compel, Respondent also requested the imposition of sanctions against Petitioner for Petitioner's failure to comply with the Board's order of February 3, 2020, compelling discovery responses. *See* Trademark Rule 2.120(h)(1), 37 C.F.R. § 2.120(h)(1). However, considering that Petitioner did serve discovery responses, albeit prior to the Board's order, it cannot be said on the record herein that there was a complete failure to comply with or disregard of the Board's order so as to warrant the imposition of sanctions. Moreover, to the extent that the basis for Respondent's motion for sanctions also relies on the same set of facts relied on by Respondent to demonstrate its good faith efforts in support of its motion to compel which has been deemed herein as premature, it follows that Respondent's request for sanctions is also premature and is, therefore, **DENIED**.

<sup>28</sup> To that end, the parties are reminded that they each have an affirmative duty to cooperate with the other in the discovery process. *See Emilio Pucci Int'l BV v. Sachdev*, 118 USPQ2d 1383, 1385 (TTAB 2016). At a minimum, it is expected that each party will amend its responses to the other's requests for production of documents in compliance with the guidelines set forth in the Board's order of February 3, 2020, and that Petitioner will amend its responses to the interrogatories identified in Respondent's motion to compel, the extent of which the parties are to discuss in their meet and confer.



Discovery Closes	7/12/2021
Plaintiff's Pretrial Disclosures Due	8/26/2021
Plaintiff's 30-day Trial Period Ends	10/10/2021
Defendant's Pretrial Disclosures Due	10/25/2021
Defendant's 30-day Trial Period Ends	12/9/2021
Plaintiff's Rebuttal Disclosures Due	12/24/2021
Plaintiff's 15-day Rebuttal Period Ends	1/23/2022
Plaintiff's Opening Brief Due	3/24/2022
Defendant's Brief Due	4/23/2022
Plaintiff's Reply Brief Due	5/8/2022
Request for Oral Hearing (optional) Due	5/18/2022

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, 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).

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