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

July 3, 2019

Cancellation No. 92068992

Prime Direct Brands, LLC

v.

IQ Products Company

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

This case now comes up for consideration of Petitioner's motion (filed February 1, 2019) to compel responses to its document requests. Respondent contests Petitioner's motion.

The Board has considered the parties' briefs on the contested motion, but does not repeat or discuss all of the arguments. *Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015). For purposes of this order, the Board presumes the parties' familiarity with the pleadings and the parties' arguments and materials submitted in connection with the subject motion.

Petitioner's Motion to Compel

Petitioner requests that the Board issue an order requiring Respondent to serve better responses, including responsive documents, to Petitioner's First Set of Document Requests served on December 18, 2018. Accompanying its motion are a

copy of the documents requests, Respondent's responses thereto, a copy of Respondent's initial disclosures, and emailed correspondence between counsel concerning Petitioner's request to meet and confer regarding Respondent's responses.

- **Showing of Good Faith Effort**

The record shows that Petitioner's counsel, Michael Hickey, emailed Respondent's counsel, Mark Gilbreth, within minutes of having received Respondent's responses in which Respondent objected to all of Petitioner's requests and refused to produce responsive documents to any of them. 5 TTABVUE 51. Mr. Hickey asked Mr. Gilbreth to let him know when he is available for a meet and confer regarding Petitioner's requests. In response, Mr. Gilbreth responded that he would discuss with his client and let Mr. Hickey know, to which Mr. Hickey immediately queried why Mr. Gilbreth needed to talk with Respondent insofar as Petitioner is requesting if Mr. Gilbreth is available. Mr. Gilbreth responded that he needed to confirm that Respondent wanted him to speak with Mr. Hickey. 5 TTABVUE 50. Mr. Hickey responded, requesting Mr. Gilbreth to confirm that Respondent does not want Mr. Gilbreth to talk with Mr. Hickey; otherwise, he would call Mr. Gilbreth at 2:00 p.m. the next day. Mr. Hickey also posed other questions, seeking to clarify Respondent's position regarding the Board's standard protective order and its willingness to make confidential documents available. 5 TTABVUE 49. The next morning, Mr. Gilbreth informed Mr. Hickey that "IQ does not see a reason for us to talk today." *Id.* Mr. Hickey confirmed receipt of the message that Respondent does not want counsel to discuss the merits of their objections to Petitioner's document requests. Further, Petitioner's counsel sought to

correct by email typographical errors in 4 requests, to which Respondent had objected. 5 TTABVUE 48. Mr. Gilbreth responded that Respondent does not "acquiesce" to the suggested amendments and essentially required Petitioner to serve a second set of discovery requests. *Id.*

Respondent contends that it only refused to discuss the merits of the motion to compel on that particular day, and "did not mean the message to foreclose all discussion related to the Requests for Production." 6 TTABVUE 8. Insofar as there is no showing that Respondent offered to meet and confer any other day or to otherwise cooperate with Petitioner regarding its discovery, the Board finds Respondent's contention totally unpersuasive. In view of Respondent's refusal to participate in a meet and confer regarding its responses to Petitioner's discovery requests, the Board finds that Petitioner has made the requisite showing of having made a good faith effort to resolve the discovery dispute before filing its motion to compel.

- **Boilerplate Objections Overruled; Order**

Before turning to the Petitioner's discovery requests and Respondent's responses thereto, the Board will address three general issues. First, to the extent that Respondent objects to a request for production based on privilege or the attorney work product doctrine, **Respondent is ORDERED to produce a privilege log**. There is no indication in the record that Respondent has done so. *See* Fed. R. Civ. P. 26(b)(5)(A)(ii); *Amazon Techs. Inc. v. Wax,* 93 USPQ2d 1702, 1706 n.6 (TTAB 2009). Respondent is strongly urged to review TBMP § 414 (2019) before supplementing any responses or creating its privilege log.

Second, Respondent's objections that certain requests for production seek confidential information are **OVERRULED** to the extent that the Board's standard protective order[1] automatically applies to all *inter partes* proceedings as of institution of the proceeding. *See* Trademark Rule 2.116(g); *see also Amazon Techs.,* 93 USPQ at 1706 n.6. Respondent is not entitled to withhold discovery responses or documents on the grounds that they contain confidential business information. *See Intex Recreation Corp. v. The Coleman Co.*, 117 USPQ2d 1799, 1801 (TTAB 2016) ("To the extent any of the documents at issue contain confidential information, Applicant should have designated those documents under the appropriate tier of confidentiality as set forth in the Board's standard protective order."). Therefore, discovery of confidential material may be conducted in accordance with the standard order.

Third, Respondent responded with 4 pages of "boilerplate" objections in response to the production requests at issue. This practice is improper; therefore, these general objections are **OVERRULED** and will be given no consideration. *See* Fed. R. Civ. P. 34(b)(2)(B); *see also Medtronic, Inc. v. Pacesetter Sys., Inc.,* 222 USPQ 80, 83 (TTAB 1984) (party must articulate objections to interrogatories with particularity).

- **Summary Orders regarding Petitioner's Document Requests**

Respondent has objected to all 36 of Petitioner's requests for documents and stated that "no documents will be produced." Notwithstanding that certain requests are improper, discussed *infra*, the Board finds that Respondent has failed to cooperate with Petitioner, as is it duty in Board proceedings. *See* TBMP § 408.01. Moreover,

[1] The Board's Standard Protective Order may be found at the TTAB's web page. http://www.uspto.gov/trademarks/process/appeal/index.jsp.

Respondent's explanations regarding certain requests belonged in its responses to the requests. The Board expects parties (and their attorneys or other authorized representatives) to cooperate with one another in the discovery process, *see, e.g., Cadbury UK Ltd. v. Meenaxi Enter., Inc.,* 115 USPQ2d 1404, 1408 (TTAB 2015) (parties expected to demonstrate good faith and cooperation during discovery; party cannot avoid discovery obligations due to an obvious typographical error in discovery requests), and looks with extreme disfavor on those who do not. *See, e.g., Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1721 n.4 (TTAB 1989) (Board warned counsel for opposer that its conduct of discovery in the case was "uncooperative" and "improper" and that any further misconduct may result in the imposition of the estoppel sanction). 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 as is proper and relevant to the issues in the case. *See Amazon Technologies Inc. v. Wax*, 93 USPQ2d at 1705 (parties expected to cooperate in the meet and confer process by presenting to each other the merits of their respective positions with candor, specificity and support).

Turning to the Petitioner's specific document requests, the Board issues the following summary rulings:

1) **Request Nos. 1, 4, 5, 6, 7, 25, 28, 30, 33, and 36**: Petitioner's motion to compel is **denied** with respect to these requests. No response is required to these production

requests because they seek documents that are not relevant to Petitioner's claims or are related to other possible marks that are not the subject of this proceeding.

2) **Request Nos. 2, 3, and 8**: Petitioner seeks "all documents" pertaining to particular information sought in each request. These requests are overly broad and burdensome insofar the type of documents sought, *i.e.*, those "related to the use of Registrant's Mark" (No. 2), "related to the renewal of Registrant's Mark" (No. 3), and "related to the use or intended use of the Mark …" (No. 8), is unclear. In view thereof, Petitioner's motion to compel is **denied without prejudice** with respect to these three requests.

Nonetheless, Respondent should note for the future that referring Petitioner to the USPTO database for responsive documents is not an acceptable response. "It is 'not usually a ground for objection that the information is equally available to the interrogator or is a matter of public record.'" *Petruska v. Johns-Manville*, 83 F.R.D. 32, 34 (E.D. Pa. 1979) (quoting 8 Wright and Miller, Federal Practice and Procedure, Civil § 2014). Therefore, had Request No. 3 been properly tailored, Respondent's objection in connection with that request, *i.e.*, that the requested information may be found online at the USPTO website or in another publicly available source, would not excuse Respondent from substantively responding or producing responsive, non-privileged documents.

3) **Request No. 29**: With respect to No. 29, the request for "*all* invoices, purchase orders, or documents showing the sale of Products bearing the Mark from June 6, 2012 to May 30, 2018" is overly broad and unduly burdensome insofar as Respondent

estimates its sales of ENVI products at approximately 40 million units. 6 TTABVUE 9. Nonetheless, Petitioner's request for documents is relevant to this proceeding. *See Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147, 149 (TTAB 1985) (relevant to issues of abandonment; response that these figures have been "substantial" is insufficient). Therefore, as to Request No. 29, Petitioner's motion to compel is **granted in part**, to the extent that Respondent is **ORDERED** to produce to Petitioner's counsel a sufficient number of invoices, purchase orders, or documents showing the continuous sale of the products identified in the involved registration under the mark ENVI from June 6, 2012 to May 30, 2018. *See J. B. Williams Co. v. Pepsodent GmbH*, 188 USPQ 577, 579 (TTAB 1975) (relevant to issue of abandonment); *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689, 690 (TTAB 1975) (allowed to provide figures for each of last five years and a statement that there have been sales for the other years).

If Respondent has no documents showing sales for any goods for any particular time period due its alleged document retention policy, it must state so explicitly and also explain how and when such documents were destroyed.

4) **Request Nos. 9-10, 11-14, 15-16**: In these requests, Petitioner seeks samples of the products bearing the involved mark that were offered for sale or sold in interstate commerce between certain time periods or during certain years. Even though request nos. 11-14 included a typographical error (using the term "between [YEAR]" instead of "*in* [YEAR]"), given the fact that those requests were virtually identical to request nos. 9-10, Petitioner's use of the wrong preposition was a

typographical error that could have been easily ignored. *See Cadbury UK Ltd. v. Meenaxi Enter., Inc.,* 115 USPQ2d at 1408. Respondent's insistence that Petitioner re-serve corrected discovery requests, notwithstanding Petitioner's clarification regarding those requests, is nothing but uncooperative and dilatory conduct. Additionally, the information sought is relevant to this proceeding. *See J. B. Williams Co. v. Pepsodent GmbH*, 188 USPQ at 579; *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ at 690. Therefore, as to Request Nos. 9-16, Petitioner's motion to compel is **granted**. Accordingly, Respondent is **ORDERED** to produce to Petitioner's counsel samples of a variety of Respondent's goods (or packaging of said goods) sold in connection with the mark ENVI. Such production should comprise sufficient samples or packaging to show the sale of said goods during the time periods identified in each request. In addition, for any samples produced, Respondent must designate which year or years any particular were sold.

If Respondent has no samples or packaging for any of its identified goods sold under the mark ENVI for any particular time period due its alleged document retention policy, it must state so explicitly and also explain how and when such packaging or samples were destroyed.

5) **Request Nos. 17-24**: Petitioner seeks documents, specifically, examples ("specimens") of advertising for the products sold in connection with the mark ENVI. Each of the foregoing requests relate to a particular year or time period. These requests are relevant to Petitioner's claims. *See* TBMP §§ 414(17) and 414(18) and cases cited therein. In view thereof, Petitioner's motion to compel is **granted** with

respect to these requests, and Respondent is **ORDERED** to produce to Petitioner's counsel samples of advertising used by Respondent to advertise the goods identified in its registration. *See Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 181 USPQ 286, 288 (TTAB 1974) (representative samples of advertisements permitted). In addition, Respondent must designate which year or years any particular advertising was used in connection with any of its goods.

If Respondent has no responsive documents for any particular time period due its alleged document retention policy, it must state so explicitly and also explain how and when such documents were destroyed.

6) **Request Nos. 27 and 31:** Petitioner requests, respectively, documents and things relating or referring to Respondent's marketing and promotion of its products bearing the mark from June 6, 2012 to May 30, 2018 (no. 27) and documents relating or referring to trade shows, exhibitions, and similar events where Respondent exhibited or promoted the goods identified in the involved registration (no. 31). Although Request No. 27 *may* include documentation provided in response to Request Nos. 17-24, it is conceivable that other types of documents responsive to No. 27 exist, such as press releases, photos of sales displays, transcripts of radio advertising, and the like. Additionally, documents responsive to Request No. 31 would constitute another type of advertising or promotion of ENVI goods that are relevant to Petitioner's claims. In view thereof, Petitioner's motion to compel is **granted** to the extent Respondent is **ORDERED** to produce to Petitioner's counsel any documents

and things responsive to Request Nos. 27 and 31, which are not included in its responses to Petitioner in connection with Requests Nos. 17-24.

7) **Request No. 26:** Insofar as the issue of Respondent's use of its mark is at issue, documents relating to any assignments, licensing agreements, or similar contractual agreements between Respondent and third parties related to the use of the ENVI mark in connection with the identified goods is relevant to this proceeding. *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (licensing agreements and arrangements between opposer and third parties and amount of sales thereto are relevant). In view thereof, Petitioner's motion to compel is **granted** to the extent that Respondent is **ORDERED** to produce responsive documents related to the use of Respondent's mark by third parties in connection with the goods identified in the involved registration.

8) **Request No. 32:** Insofar as Respondent's initial disclosures, 5 TTABVUE 41, do not provide any information regarding persons knowledgeable about the sales and marketing of Respondent's goods sold under the mark ENVI, Petitioner's request is proper, and the motion to compel is **granted** with respect to this request. Therefore, Respondent is **ORDERED** to produce to Petitioner's counsel documentation sufficient to identify the names and business addresses of its representatives who can provide information related to the sales and marketing of Respondent's identified goods sold under the mark ENVI.

9) **Request Nos. 34 and 35:** Petitioner seeks documents sufficient to identify all stores and retail establishments (whether on-line or brick-and-mortar) that have sold

or sold Respondent's goods bearing the mark ENVI during two different time periods. The names of customers (including dealers) constitute confidential information, and generally are not discoverable, even under protective order. However, the name of the first customer for a party's involved goods or services sold under its involved mark, and, if there is a question of abandonment, the names of a minimal number of customers for the period in question, may be discoverable under protective order. *See Fisons Ltd. v. Capability Brown Ltd.,* 209 USPQ 167, 169 (TTAB 1980) (possible harm outweighed where issue is abandonment); TBMP § 414(3). In view thereof, Petitioner's motion to compel is **granted in part**, namely, to the extent that Respondent is **ORDERED** to produce to Petitioner's counsel under the terms of the Board's standard protective order that is applicable to this proceeding, a sample of names of retail stores, including salons, where its identified goods sold under the mark ENVI are sold.

Summary; Possible Sanctions

Petitioner's motion to compel is **granted in part** and **denied in part**, as discussed herein. Respondent is allowed until **THIRTY (30) DAYS** from the mailing date of this order to serve on Petitioner's counsel documents and things, as ordered *supra*, **without further objection**. In the event that Respondent fails to serve full responses to Petitioner's document requests as ordered herein, Petitioner's remedy may lie in a motion for sanctions, as appropriate. *See* Trademark Rule 2.120(h)(1), 37 C.F.R. § 2.120(h)(1); TBMP § 411.05.

Proceeding Resumed; Trial Dates Reset

This proceeding is resumed. Trial dates are reset as shown in the following schedule:

Expert Disclosures Due	**8/17/2019**
Discovery Closes	**9/16/2019**
Plaintiff's Pretrial Disclosures Due	**10/31/2019**
Plaintiff's 30-day Trial Period Ends	**12/15/2019**
Defendant's Pretrial Disclosures Due	**12/30/2019**
Defendant's 30-day Trial Period Ends	**2/13/2020**
Plaintiff's Rebuttal Disclosures Due	**2/28/2020**
Plaintiff's 15-day Rebuttal Period Ends	**3/29/2020**
Plaintiff's Opening Brief Due	**5/28/2020**
Defendant's Brief Due	**6/27/2020**
Plaintiff's Reply Brief Due	**7/12/2020**
Request for Oral Hearing (optional) Due	**7/22/2020**

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, 37 C.F.R. §§ 2.121-2.125. 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), 37 C.F.R. §§ 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), 37 C.F.R. § 2.129(a).

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