

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)

KGC

August 1, 2022

Cancellation No. 92070611

*Willdan Energy Solutions and The Weidt  
Group, Inc.*

*v.*

*Schneider Electric USA, Inc.*

**Kevin G. Crennan, Interlocutory Attorney:**

This proceeding is before the Board for consideration of Petitioners' motion to compel discovery and to test the sufficiency of Respondent's answers to Petitioners' requests for admission. 35 TTABVUE. The motion is fully briefed.<sup>1</sup>

**I. Timeliness and Good-Faith Effort**

The motion was filed before the deadline for Petitioners' pretrial disclosures as last reset and, thus, is timely. 34 TTABVUE 2; *see* Trademark Rules 2.120(f)(1), (i)(1). Further, Petitioners have shown, and Respondent does not appear to contest, their good-faith effort to resolve the issues presented in the motion prior to seeking the

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<sup>1</sup> The Board has considered the parties' submissions and presumes the parties' familiarity with the factual bases for the motion, and does not recount the facts or arguments here, except as necessary to explain the Board's order. *See Guess? IP Holder L.P. v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

Board's involvement.<sup>2</sup> 35 TTABVUE 2-5, 27-32, ¶¶ 3-38; *see* Trademark Rules 2.120(f)(1), (i)(1).

In their motion, Petitioners request that Respondent be compelled to:

- (1) conduct a thorough search of its records for all information and documents requested in Petitioners' second set of requests for production of documents;
- (2) produce all responsive, non-privileged documents revealed in such a search;
- (3) serve amended responses to Petitioners' second set of interrogatories to the extent Respondent's answers contained unsupported objections or relied on Fed. R. Civ. P. 33(d);
- (4) serve amended responses to Petitioners' second set of requests for production of documents to the extent Respondent's answers contained unsupported objections or referenced representative samples;<sup>3</sup>
- (5) deem Request for Admission Nos. 33-34, 36, 47-49, and 57-58 admitted; and
- (6) serve amended responses to Petitioners' first sets of interrogatories, requests for production of documents, and requests for admission to the extent the aforementioned search "has rendered previous answers and responses inaccurate or incomplete."

35 TTABVUE 25. Petitioners also request that the Board not consider any of Respondent's evidence that may be submitted at trial if such evidence was properly sought in Petitioners' discovery requests but not proffered. *Id.* at 25-26.

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<sup>2</sup> Though Petitioners submitted a declaration of their counsel containing a recitation of the communications between the parties' counsel and the dates thereof, Petitioners also should have included copies of the correspondence. *See Hot Tamale Mama...& More, LLC v. SF Invs., Inc.*, 110 USPQ2d 1080, 1081 (TTAB 2014) ("The Board expects that ... the statement will 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)."); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 523.02 (2022).

<sup>3</sup> Petitioners request that such amended responses identify, by Bates number, which documents are responsive to which request, and, if no documents exist, for Respondent to state as such. 35 TTABVUE 25.

## II. Objections

Fed. R. Civ. P. 33(b)(4) provides that “[t]he grounds for objecting to an interrogatory must be stated with specificity.” Similarly, Fed. R. Civ. P. 34(b)(2)(B) and Fed. R. Civ. P. 36(a)(5) require, respectively, that “the grounds for objecting to” a request for production of documents be “state[d] with specificity” and “[t]he grounds for objecting to a request [for admission] ... be stated.” The Board reviews Respondent’s objections to Petitioners’ discovery requests in light of these Rules.

### a. General Objections

A “responding party may not rely on conclusory statements when objecting [to discovery], but rather must state specifically the underlying basis for the objection.” *Hewlett Packard Enter. Dev. LP v. Arroware Indus., Inc.*, 2019 USPQ2d 158663, at \*4 (TTAB 2019) (citations omitted). In particular, and with respect to the “general objections” referenced throughout Respondent’s discovery responses (*see* 35 TTABVUE 53-66, 83-114, 126-137), such objections are “anything but specific.” *Amazon Techs., Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009).

In view thereof, Respondent’s general objections are **overruled**.

### b. Other Objections

Respondent also objected to a number of interrogatories and requests for admission and production of documents on a variety of grounds (*see* 35 TTABVUE 53-66, 83-114, 126-137), including that the interrogatory or request:

- (1) seeks documents or information protected by the attorney-client privilege or work-product doctrine;

This objection is **overruled** insofar as Respondent has not produced a privilege log. See *M.C.I. Foods, Inc. v. Bunte*, 86 USPQ2d 1044, 1047 (TTAB 2008) (“Specifically, M.C.I. objected to a large number of Bunte’s discovery requests asserting that the information requested is protected by the attorney-client privilege or attorney work product doctrine. However, M.C.I. failed to produce the required privilege log.”) (citing Fed. R. Civ. P. 26(b)(5)(A)(ii)); *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1556 (TTAB 2000) (“Any claim that otherwise responsive documents are privileged requires 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.”) (citation omitted)).

(2) contains wording that is vague, ambiguous, or overly broad;

“The party objecting to discovery as vague or ambiguous has the burden to show such vagueness or ambiguity.” *McCoo v. Denny’s, Inc.*, 192 F.R.D. 675, 694 (D. Kan. 2000) (citation omitted); see also *Hewlett Packard Enter. Dev.*, 2019 USPQ2d 158663, at \*4 (“[T]o the extent Respondent refused to provide substantive responses on the grounds that the requests are ... ambiguous, it was incumbent on Respondent to detail with specificity the reasons for its objections. Absent such a showing, Respondent is required to provide substantive responses.”). Further, the responding party “should exercise reason and common sense to attribute ordinary definitions to terms and phrases utilized,” and, if necessary for clarification purposes, “the responding party may include any reasonable definition of the term or phrase at issue.” *McCoo*, 192

F.R.D. at 694 (citation and internal quotation marks omitted). Inasmuch as Respondent failed to explain why particular wording in certain requests is vague, ambiguous, or overly broad, this objection is **overruled**.<sup>4</sup>

- (3) seeks information that is readily available to Petitioners, including from their own document production and website, easily obtainable by them, such as by searching online, or in their possession;

This objection is **overruled** because “it is not usually a ground for objection that the information is equally available to the interrogator or is a matter of public record.”<sup>5</sup>

*Petruska v. Johns-Manville*, 83 F.R.D. 32, 35 (E.D. Pa. 1979) (citation and internal quotation marks omitted).

- (4) is overly broad, unduly burdensome, or not proportional to the needs of the case to the extent the request seeks “all” documents or information;

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<sup>4</sup> Even if Respondent provided an explanation, it is questionable whether it would hold weight. For example, Request for Production of Documents No. 4 asked Respondent to produce “[a]ll documents concerning [its] [g]oods and [s]ervices that concern energy efficiency, asset optimization, or building owners,” to which Respondent objected, among other reasons, on the basis that “energy efficiency,” “asset optimization,” and “building owners” are vague and ambiguous. *Id.* at 56-57. Yet, Respondent not only used “asset optimization” and “building owners” in the identification to its registration, it did not assert a similar objection with respect to Request for Production of Documents No. 28, which asked Respondent to produce “[a]ll documents concerning *energy efficiency* solutions promoted by [it] in connection with the NEO NETWORK platform.” *Id.* at 102 (emphasis added).

In addition, Respondent objected to Request for Production of Documents No. 5 on the basis that, among other reasons, the wording “energy efficiency,” “asset optimization,” and “building owners” are vague and ambiguous, though this wording does not appear in the request: “All documents concerning any [s]oftware that has been promoted through Respondent’s [g]oods and [s]ervices.” *Id.* at 57. A similar issue is found with respect to Request for Production of Documents No. 14 and Request for Admission No. 35. *Id.* at 61-62, 108.

<sup>5</sup> Even if the requested information is in Petitioners’ possession, Petitioners may be unaware which particular facts support Respondent’s claims. For example, Interrogatory No. 26 asked Respondent to “[i]dentify all facts that [it] is aware of that establish that ... Petitioners subjectively believed that Respondent had superior rights over Petitioners with respect to the NEO mark.” *Id.* at 89-90.

Generally, it is the Board's standard practice that a party responding to discovery is allowed produce a reasonable representative sampling in response to a request to produce "all" documents or information if the production would otherwise be so voluminous as to be unduly burdensome. *See Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 149, 149 (TTAB 1985) ("If the information is so voluminous as to be burdensome, representative samples may be provided."); TBMP § 414(2) ("In those cases where complete compliance with a particular request for discovery would be unduly burdensome, the Board ... may permit the responding party to comply by providing a representative sampling of the information sought, or some other reduced amount of information which is nevertheless sufficient to meet the propounding party's discovery needs.") (footnote omitted). However, inasmuch as Respondent advances this same objection against most of the requests without an explanation as to why complete compliance therewith would be unduly burdensome, it is effectively "boilerplate."<sup>6</sup> Thus, the objection is **overruled**. *See Hewlett Packard Enter. Dev.*, 2019 USPQ2d 158663, at \*4 ("Respondent's boilerplate objections are improper and accordingly are overruled").

(5) is premature; and

Respondent raised this objection against Interrogatory Nos. 25 and 26, which asked Respondent to, respectively:

- "Identify all facts that [it] is aware of that establish that, at the time Petitioners made the allegedly false statements identified in Respondent's

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<sup>6</sup> This objection was asserted against Request for Production of Documents No. 10, notwithstanding that this request did not ask for "all" documents. *Id.* at 59-60.

answer to Interrogatory Number 19, Petitioners did not have a good faith belief that Petitioners had superior rights over Respondent.”; and

- “Identify all facts that [it] is aware of that establish that, at the time Petitioners made the allegedly false statements identified in Respondent’s answer to Interrogatory Number 19, Petitioners subjectively believed that Respondent had superior rights over Petitioners with respect to the NEO mark.”

35 TTABVUE 89-90. Inasmuch as Respondent failed to explain why these interrogatories are premature, this objection is conclusory and, thus, **overruled**.<sup>7</sup> See *Hewlett Packard Enter. Dev.*, 2019 USPQ2d 158663, at \*4 (“[T]he responding party may not rely on conclusory statements when objecting ..., but rather must state specifically the underlying basis for the objection”) (citing *Medtronic, Inc. v. Pacesetter Sys., Inc.*, 222 USPQ 80, 83 (TTAB 1984) (“[I]t is incumbent upon a party who has been served with interrogatories to respond by articulating his objections (with particularity) to those interrogatories which he believes to be objectionable, and by providing information sought in those interrogatories which he believes to be proper”) (citations omitted)) (other citations omitted).

(6) seeks information that is beyond the scope of or irrelevant to this cancellation.

The scope of discovery in a Board inter partes proceeding is governed by Fed. R. Civ. P. 26(b)(1), which provides that “parties may obtain discovery regarding any nonprivileged matter that is relevant to any party’s claim or defense and proportional to the needs of the case.” “Relevancy is broadly construed, and a request for discovery

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<sup>7</sup> Even if Respondent provided an explanation, it is questionable whether these interrogatories are premature inasmuch as they seek facts pertaining to Respondent’s fraud counterclaim against Petitioners.

should be considered relevant if there is ‘any possibility’ that the information sought may be relevant to the claim or defense of any party.” *Hammond v. Lowe’s Home Ctrs., Inc.*, 216 F.R.D. 666, 670 (D. Kan. 2003) (footnote omitted).

In response to Request for Production of Documents Nos. 4 and 5, Respondent objected, among other reasons, on the basis of relevance because they “concern[] Respondent’s [g]oods and [s]ervices not offered under Respondent’s [m]ark.” 35 TTABVUE 56-57. It raised a similar objection in response to:

- Interrogatory No. 27: “Petitioner[s] do[] not offer goods or services related to clean energy .... [and] seek information unrelated to consumer perception of the NEO NETWORK mark,” in particular, “the onsite clean energy opportunities that can be recommended in connection with the Station A technology available on the NEO NETWORK platform” (*id.* at 90-91);
- Interrogatory No. 31: Petitioners “seek[] information beyond the scope of this proceeding,” in particular, “whether Respondent has ever offered any good or service through the NEO NETWORK platform that assists a user to decrease electricity usage in buildings” (*id.* at 92); and
- Interrogatory Nos. 32 and 33: Petitioners “seek[] information beyond the scope of this proceeding and not tied to consumer perception of either Petitioner[s] or Respondent’s marks at issue in this proceeding,” in particular, “how the NEO NETWORK platform assists its users in reducing the energy use of operations in building” (Interrogatory No. 32), and “what aspects of electricity the Station A technology promoted through the Neo Network platform will analyze” (Interrogatory No. 33) (*id.* at 93-94).

Inasmuch as these requests concern the identification of goods and services as set forth in the parties’ involved registrations and Petitioners’ pleaded application, the information these interrogatories seek is relevant to Petitioners’ likelihood of confusion claim for purposes of establishing the relationship between the parties’ goods and services. *See* TBMP § 411(11) and authority cited therein. Thus, these objections are **overruled**.



Finally, a third party—Station A—is referenced in a number of requests or their corresponding answer: Interrogatory Nos. 27, 30, and 33-34, Request for Production of Documents Nos. 23 and 29, and Request for Admission Nos. 38, 45, 48-52, and 55. 35 TTABVUE 90, 92-94, 100, 103, 109, 112-13, 129-34. In response to these interrogatories and Request for Production of Document 23, in particular, Respondent objected, among other reasons, because of relevance.<sup>8</sup>

In support of its objection, Respondent argues that Station A “is a product offered by a third party to members of the NEO NETWORK platform.” Thus, “the goods and services offered under the STATION A mark both are not offered by [Respondent] under the NEO NETWORK mark and information about those goods and services would be in Station A’s possession not” Respondent’s. 38 TTABVUE 11.

Petitioners, however, contend that,

[a]lthough the service[s] currently use[] Station A [t]echnology, the services are still provided by [Respondent] through [Respondent’s] platform. Also, the services are prominently branded, marketed, and presented to consumers under the NEO NETWORK mark. Based on the foregoing, Station A technology is integrated into [Respondent’s] services and is provided under the NEO NETWORK mark.

35 TTABVUE 19 (citations omitted).

In view of Respondent’s answers to the requests for admission, the Board finds that the information and documents sought in Interrogatory Nos. 27, 30, and 33-34 and Request for Production of Documents No. 23 are relevant to Petitioners’ likelihood of confusion claim for purposes of establishing the relationship between the

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<sup>8</sup> Notably, the same objection was not raised against Request for Production of Documents No. 29 and the requests for admission, when those requests also concern Station A.

parties' goods and services. Thus, Respondent's objection on the ground of relevancy as it pertains to these discovery requests is **overruled**.

### **III. Responses to Requests for Admission**

Petitioners seek to test the sufficiency of Respondent's answers to Request for Admission Nos. 33-34, 36, 47-49, and 57-58 and have them deem admitted. *Id.* at 20-24.

Fed. R. Civ. P. 36(a) permits the following responses to such requests: (1) an objection that the request is beyond the scope of permissible discovery, *see* Fed. R. Civ. P. 26(b)(1); (2) an admission; (3) a denial; (4) a detailed explanation why the request cannot be admitted or denied; or (5) a good-faith qualified admission or denial that admits certain matters, if possible, but denies or gives a qualified answer to the rest. *See Nat'l Semiconductor Corp. v. Ramtron Int'l Corp.*, 265 F. Supp. 2d 71, 73 (D.D.C. 2003). Generally, if there is an admission or a denial, the Board will not find the response to be insufficient even if the responding party included an explanation or clarification of the admission or denial, or admitted after first denying. *See* TBMP § 524.

Respondent answered the requests as follows:

- No. 33: a qualified admission "to the extent that Respondent understands this request" followed by a denial to "the remainder of this [r]equest" (35 TTABVUE 107);
- No. 34: a denial as Respondent "does not understand this [r]equest" (*id.*);
- No. 36: a qualified admission "to the extent that Respondent understands this request" followed by a denial to "the remainder of this [r]equest" (*id.* at 108-09);

- No. 47: a qualified admission “to the extent that Respondent understands this request” (*id.* at 128-29);
- No. 48: same as the preceding response (*id.* at 129);
- No. 49: a qualified admission (*id.*);<sup>9</sup>
- No. 57: a qualified admission “to the extent that Respondent understands this request” (*id.* at 135); and
- No. 58: same as the preceding response (*id.* at 135-36).

Petitioners argue that Respondent “does not fairly respond to the substance of” certain requests, which, in good faith, “do[] not require any qualification” (*id.* at 20); that certain requests are “not vague or difficult to understand” (*id.* at 21); that Respondent’s answers to certain requests are, in essence, “maybe,” and, thus, “do not fairly respond to the substance of” the requests (*id.* at 23); and that Respondent “essentially rewrote” certain requests (*id.* at 23).

Notwithstanding Petitioners’ contentions, inasmuch as Respondent’s answers to these requests consist of permissible qualified admissions or denials, and Petitioners proffer no evidence that Respondent’s qualifications were made in bad faith, the Board declines to require Respondent to submit supplemental answers to these requests. *See Nat’l Semiconductor*, 265 F. Supp. 2d at 73 (“The Federal Rules of Civil Procedure permit the following responses to such a request: ... a good faith qualified admission that admits certain matters, if possible, but denies or gives a qualified answer to the rest.”); TBMP § 524 (“Generally, if there is an admission or a denial,

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<sup>9</sup> Respondent admitted this request but essentially qualified it by adding matter to its answer, i.e., “powered by Station A,” which does not appear in the request. *Id.* at 129.

the Board will not find the response to be insufficient even if the responding party included an explanation or clarification of the admission or denial, or admitted after first denying.”) (footnote omitted).

In view thereof, Petitioners’ motion to test the sufficiency of Respondent’s answers to the requests for admission is **denied**.

#### **IV. Responses to Requests for Production of Documents**

##### **a. Request No. 25**

This request asked Respondent to produce “[s]creenshots of all software that demonstrate [its] use of the NEO NETWORK mark in connection with each aspect of the identification of goods description listed in International Class 9 for Respondent’s [r]egistration.” 35 TTABVUE 101. Respondent purportedly “produced two screenshots of [its] website displaying the NEO NETWORK DER Calculator,” but, according to Petitioners,

[i]t is unclear whether [Respondent] intends for these two website screenshots to display use of the entirety of the capabilities referenced in the ‘software platform’ portion of the Class 9 goods listed in [Respondent’s] [g]oods and [s]ervices [d]escription because websites are generally not considered to be a software good classified in Class 9.

*Id.* at 13. Respondent argues that it “complied with this request by producing screenshots of its use of the NEO NETWORK mark directly relevant to its registered goods and services,” and then goes on to list the software features set forth in International Class 9 of the identification to its registration. 38 TTABVUE 10-11.

Inasmuch as this registration also identifies services in International Classes 35 and 42—“[p]roviding an interactive website” and “[p]roviding an interactive website

featuring technology,” respectively—the submission of two *website* screenshots coupled with Respondent’s assertion that it produced documents “directly relevant to its registered goods *and services*” (emphasis added) make it unclear whether these screenshots reflect the previously identified services rather than, as the request asked, “use of the NEO NETWORK mark in connection with each aspect of the identification of goods description listed in International Class 9.” Respondent, therefore, must supplement its document production in accordance with this request or, to the extent it is unable to do so, indicate that no additional documents exist.

**b. Request No. 29**

This request asked Respondent to produce “[a] representative sample of reports generated by the Station A technology available through the NEO NETWORK platform.” 35 TTABVUE 103. Respondent purportedly produced “sixteen website printouts and the two screenshots” referenced in Request No. 25, but “has yet to produce any reports.” *Id.* at 13-14. Respondent argues that “the information sought by Petitioners has no bearing on the issues in this proceeding because STATION A is a product offered by a third party to members of the NEO NETWORK platform,” and that “information about those goods and services would be in Station A’s possession not” Respondent’s. 38 TTABVUE 11.

Notably, though Respondent now objects to this request as being irrelevant, a relevancy objection was not raised in Respondent’s written response to the request; rather, Respondent objected only on the basis of attorney-client privilege or work-

product doctrine.<sup>10</sup> 35 TTABVUE 103. Notwithstanding, as discussed above in the context of Respondent's objection to certain requests concerning Station A, the Board finds that this request is relevant to Petitioners' likelihood of confusion claim for purposes of establishing the relationship between the parties' goods and services. Respondent, therefore, must supplement its document production in accordance with this request or, to the extent it is unable to do so,<sup>11</sup> indicate that no additional documents exist.

## V. Responses to Interrogatories

In response to Interrogatory Nos. 19-26, 28, and 31-33, Respondent answered that it will identify and produce documents pursuant to Fed. R. Civ. P. 33(d) from which Petitioners can derive an answer to these interrogatories. *Id.* at 85-94.

Fed. R. Civ. P. 33(d) permits a party, under certain circumstances, to respond to an interrogatory by producing business records from which the answer may be gleaned. *See also* TBMP § 405.04(b). To do so, however, three conditions must be met.

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<sup>10</sup> This is not the first instance where Respondent's objections diverge between the written responses to the requests and the brief in response to the motion. For example, in response to Request Nos. 8, 9, and 21, Respondent objected on a number of grounds, none of which included relevancy. *Id.* at 59, 99. Yet, in its brief in response, Respondent essentially contends that these requests seek irrelevant information. 38 TTABVUE 8 (Respondent's "EcoStruxure IT software ... is unrelated to Petitioners' online energy modeling tool and the issues underpinning this opposition"), 9 ("[T]he identity of [certain entities] ... has no bearing on this opposition.... [The entities do not] have any relevance to [Respondent's] use of the NEO NETWORK mark or its presentation to the public or potential customers. Petitioners have made no showing why this information would be relevant to the determination of likelihood of confusion.").

<sup>11</sup> If such documents are solely in a third party's (Station A's) possession, not Respondent's, then the Board "cannot compel a party to produce documents that ... are not in that party's possession, custody, or control." *Sonnino v. Univ. of Kan. Hosp. Auth.*, 220 F.R.D. 633, 640 (D. Kan. 2004) (footnote omitted).

*See Johnson & Johnson v. Obschestvo s Ogranitchennoy*, 95 USPQ2d 1567, 1569 (TTAB 2010); *No Fear*, 54 USPQ2d at 1555; *Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1433-34 (TTAB 1998). The responding party, first, must “establish that providing written responses would impose a significant burden on” it. *No Fear*, 54 USPQ2d at 1555; *see Jain*, 49 USPQ2d at 1433 (“[A] burden [that] is above and beyond the normal burden involved in providing written responses to interrogatories”). Second, the party must “specify, by category and location, the records from which answers to [the] interrogatories can be derived.” *Jain*, 49 USPQ2d at 1433 (citation and internal quotation marks omitted). If the first two prerequisites are satisfied, then for the third, “the inquiring party must not be left with any greater burden than the responding party when searching through and inspecting the records.” *No Fear*, 54 USPQ2d at 1555. The third element, though, need not be considered absent the first two being satisfied. *See Jain*, 49 USPQ2d at 1434 (“However, this determination, i.e., the substantial similarity, vel non, of the parties’ respective burdens in deriving or ascertaining responsive information from the responding party’s business records, need not be made unless the first two prerequisites, discussed above, have been met by the party seeking to invoke Rule 33(d).”).

Petitioners argue that Respondent may not rely on Fed. R. Civ. P. 33(d) because it “did not even attempt to comply with the requirements” therefor. 35 TTABVUE 14. Respondent, however, contends that Petitioners “fail to point out that [Respondent] provided information and documents in response to” the interrogatories at issue. 38 TTABVUE 12. For example, with respect to Interrogatory No. 20, Respondent

answered that “it will identify and produce documents, including Bates Nos. Pet00037 and Pet00072”;<sup>12</sup> thus, according to Respondent, it “identifie[d] documents responsive to this interrogatory.” *Id.*

Inasmuch as Respondent fails to establish that written responses to these interrogatories would pose a significant burden on it, the first condition of Fed. R. Civ. P. 33(d) has not been met, and, thus, the Board need not consider the second or third elements.<sup>13</sup> Accordingly, Respondent has not satisfied the requirements of utilizing Fed. R. Civ. P. 33(d) as an alternative means of providing written responses to these interrogatories.

## VI. Decision

In view of the foregoing, and upon careful consideration of the parties’ arguments and evidence on the matter, Petitioners’ motion to compel is **granted** as follows:<sup>14</sup>

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<sup>12</sup> Respondent’s use of the indefinite word “including,” however, suggests that more responsive documents may exist.

<sup>13</sup> Though Respondent argues that “[p]roducing all of this information and documents in response to Petitioners’ overly broad requests would be unduly burdensome” (38 TTABVUE 9), this statement is non-specific inasmuch as it is not tied to particular interrogatories. Further, it is dubious whether providing a written response to certain interrogatories would pose a significant burden. For example, Interrogatory No. 31 asked Respondent to “[i]dentify whether [it] has ever offered any good or service through the NEO NETWORK platform that assists a user to decrease electricity usage in buildings” (35 TTABVUE 92); a question that may only require a “yes” or “no” response.

<sup>14</sup> This relief does not extend to Petitioners’ first set of interrogatories (*id.* at 35-44) inasmuch as Respondent’s answers thereto were not included with the motion, in contravention of Trademark Rule 2.120(f)(1) (“A motion to compel discovery shall include ... a copy of the interrogatory with any answer or objection that was made”). Thus, the Board declines to compel Respondent to serve amended responses thereto. *See id.* at 25. Notwithstanding, and as will be discussed, Respondent has a continuing duty to supplement or correct incomplete or incorrect discovery responses. *See* Fed. R. Civ. P. 26(e)(1)(A); *see also* TBMP § 408.03.



With respect to the interrogatories and requests for production of documents, to the extent they were discussed in this order and insofar as Respondent has withheld documents or information based on an objection that has been overruled herein, Respondent is **directed** to supplement its responses thereto. In particular, Respondent must produce and serve on Petitioners any non-privileged documents that are responsive to the requests for production of documents and in Respondent's possession, custody, or control. Further, Respondent must provide Petitioners with full and complete written, narrative, and verified responses to the interrogatories. This must be done within **thirty (30) days** from the date of this order.

Inasmuch as Respondent has a duty to thoroughly search its records for all information properly sought in the requests, and to provide such information to the propounding party, to the extent Respondent has done this, Respondent must so state in response to the requests and identify, by Bates or production number, the documents that correspond to each request. *See Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1720 (TTAB 1987) ("Each party has an obligation to thoroughly check its records in order to provide the requested discovery, assuming of course, that the requests were within the scope of the discovery rules."); TBMP § 408.02.

If there are no responsive, non-privileged documents in Respondent's possession, custody, or control, Respondent must affirmatively state this in its response to the corresponding request.

To the extent Respondent asserts privilege against any of the requests, Respondent must provide Petitioners with a privilege log.

If Respondent's response to any request is so voluminous as to be unduly burdensome, Respondent must explain with particularity why that may be the case with respect to the particular request. Upon a proper showing, Respondent may produce a representative sampling. Petitioners must be apprised of this, however, and any sampling must still be sufficient to meet Petitioners' needs.

Respondent is reminded of its continuing duty to supplement or correct its discovery responses "in a timely manner if the party learns that in some material respect the ... response is incomplete or incorrect, and if the additional or corrective information has not otherwise been made known to [Petitioners] during the discovery process or in writing." Fed. R. Civ. P. 26(e)(1)(A); *see also* TBMP § 408.03.

In the event Respondent fails to supplement its responses to the requests as ordered herein, Petitioners' remedy may lie in a motion for sanctions, if appropriate. *See* Trademark Rule 2.120(h)(1).

Notwithstanding, the Board expects the parties to cooperate in the discovery process, and looks with extreme disfavor on those who do not. *See Panda Travel, Inc. v. Resort Option Enters., Inc.*, 94 USPQ2d 1789, 1791 (TTAB 2009) ("The Board expects parties to cooperate during discovery."). Failing to properly respond to discovery and cooperate in the discovery process only serves to waste the parties' and the Board's time and resources, particularly in this proceeding, which has been pending for over three years. *Amazon Techs.*, 93 USPQ2d at 1705 ("Proceeding as opposer did here, by serving a litany of boilerplate objections and refusing to reveal

the true basis for withholding responsive information, only serves to waste the parties' and the Board's time.") (citations omitted).

Upon Petitioners' timely objection, Respondent may be precluded from relying at trial on information or documents that were properly sought, but not disclosed, during discovery "unless the failure [to disclose] was substantially justified or is harmless." Fed. R. Civ. P. 37(c)(1).

## VII. Schedule

Proceedings remain **suspended** for **thirty (30) days** from the date of this order for Respondent's compliance therewith, and will automatically **resume** thereafter with the following schedule:

Pretrial Disclosures Due for Party in Position of Plaintiff in Original Claim	9/9/2022
30-day Trial Period Ends for Party in Position of Plaintiff in Original Claim	10/24/2022
Pretrial Disclosures Due for Party in Position of Defendant in Original Claim and in Position of Plaintiff in Counterclaim	11/8/2022
30-day Trial Period Ends for Party in Position of Defendant in Original Claim, and in Position of Plaintiff in Counterclaim	12/23/2022
Pretrial Disclosures Due for Rebuttal of Party in Position of Plaintiff in Original Claim and in Position of Defendant in Counterclaim	1/7/2023
30-day Trial Period Ends for Rebuttal of Party in Position of Plaintiff in Original Claim, and in Position of Defendant in Counterclaim	2/21/2023
Pretrial Disclosures Due for Rebuttal of Party in Position of Plaintiff in Counterclaim	3/8/2023
15-day Trial Period Ends for Rebuttal of Party in Position of Plaintiff in Counterclaim	4/7/2023
Opening Brief for Party in Position of Plaintiff in Original Claim Due	6/6/2023
Combined Brief for Party in Position of Defendant in Original Claim and Opening Brief as Plaintiff in Counterclaim Due	7/6/2023
Combined Rebuttal Brief for Party in Position of Plaintiff in Original Claim and Brief as Defendant in Counterclaim Due	8/5/2023
Rebuttal Brief for Party in Position of Plaintiff in Counterclaim Due	8/20/2023

### **VIII. General Information**

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).