UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

csg

Mailed: September 17, 2003

Concurrent Use No. 94001250

CDS, Applicant[1]

v.

I.C.E.D. Management, Inc., Exception

This case now comes up on excepted user I.C.E.D.'s (hereinafter I.C.E.D.) motion to compel; filed February 3, 2003; I.C.E.D.'s motion to extend dates, filed, February 3, 2003, and I.C.E.D.'s motion to dismiss, filed July 11, 2003. The motions are fully briefed.

The Board turns first to I.C.E.D.'s motion for judgment. I.C.E.D. has moved for involuntary dismissal under Trademark Rule 2.132(a) based on applicant CDS's (hereinafter "CDS") failure to take testimony or submit evidence during its testimony period. CDS has responded by

[1] The parties are advised that inasmuch as Opposition No. 91121374 was dismissed in favor of this concurrent use proceeding on July 30, 2002, no further reference should be made to this opposition proceeding in any of the parties' papers. Any filings in this concurrent use proceeding should only reference the concurrent use proceeding number, 94001250. Additionally, the parties are advised that the junior party (concurrent use applicant CDS) stands as plaintiff in this proceeding and the senior party (excepted user I.C.E.D.) stands as defendant as provided for under Trademark Rule 2.116(b). See also TBMP

arguing that the filing of I.C.E.D.'s motion to compel suspended all matters not germane to the motion to compel as provided for in Trademark Rule 2.120(e)(2), even though no suspension order was issued, and therefore, I.C.E.D.'s request for dismissal should be denied.

It is standard Board practice to suspend proceedings when a motion to compel is filed. See Trademark Rules 2.120(e)(2) and (h)(2). Although the Board did not have the opportunity to mail out a suspension order sooner, proceedings herein are considered to have been suspended retroactive to February 3, 2003, the date of filing of I.C.E.D.'s motion to compel. See Trademark Rule 2.120(e)(2). In view thereof, I.C.E.D.'s motion for judgment for failure to prosecute is denied.

The Board now turns to the motion to compel. Preliminarily we note that I.C.E.D. requested better responses to Interrogatory Nos. 6, 7, 8, 9, 11-15, and 16, 22, 23 and 27; production of Document Request Nos. 4-10, 17, 18, 19, 20 and 29. CDS responded to the motion to compel by serving better responses to opposer's interrogatories and document requests and filing a response to opposer's motion to compel, asserting that the motion to compel was now moot. In reply, I.C.E.D. advised the Board that despite

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Section 1107. All future filings in this concurrent use proceeding should follow the proper captioning as shown above.

supplementation, applicant's responses to some of the interrogatory requests and some of the document requests "remain inadequate."[2]

In particular I.C.E.D. states that in Interrogatory Nos. 9-15, CDS has failed to describe the manner of use; that CDS must produce documents showing use in each claimed state or confirm that no such documents exist; that CDS cannot limit its response to the seven states where actual use is occurring and "must be compelled to disclose geographic areas where prior use of THE COPY CLUB mark occurred" and must identify cities within the geographic areas named; that CDS's privilege log submitted with the supplemental responses is deficient; that CDS must identify its customers or at least the first customer in each state where CDS has used the mark and in each state in which it seeks a concurrent use registration; and that CDS must disclose relevant facts in Interrogatory Nos. 22 and 27 and Document Request No. 23.

Interrogatory Nos. 9-15

With regard to these interrogatories, I.C.E.D. seeks information about "the manner of all such use" of CDS's THE

[2] It is unclear exactly which interrogatories and document requests are still at issue because except for Interrogatory Nos. 9-15, I.C.E.D. has failed to identify specific interrogatories and document requests that it claims are still deficient and has spoken only in general terms about deficiencies in CDS's responses.

COPY CLUB mark. Applicant has stated that its supplemental responses are complete. However, I.C.E.D. argues that the supplemental responses are insufficient and that CDS be "compelled to describe how THE COPY CLUB mark has been used in each state with regard to each good or service claimed."

Although the Board is not entirely clear exactly what information I.C.E.D. is requesting with regard to the term "manner of use", the reference back to Interrogatory No. 2 makes CDS's responses somewhat unclear. In view thereof, I.C.E.D.'s motion to compel with regard to Interrogatory Nos. 9-15 is granted to the extent that CDS must specify, within THIRTY DAYS of the mailing date of this order, exactly what goods or services it has used THE COPY CLUB mark within each state as identified in Interrogatory Nos. 9-15, and produce corresponding documents to indicate such use, if those documents exist. If no documents exist, applicant should so state in writing.

Interrogatory Nos. 22, 27, Document Request No. 23

CDS's supplemental response to these interrogatories and this document request is sufficient.

Accordingly, I.C.E.D.'s motion to compel is denied as to these requests.

Document Request Nos. 4-10

I.C.E.D. asserts in its motion to compel that CDS should be compelled to produce documents showing first use in the states claimed in the concurrent use application.

In response, CDS states that its responses are sufficient and that it has provided supplemental responses that set forth further specific regarding dates of first use.

In reply, I.C.E.D. argues that applicant must confirm that no such documents exist.

The Board finds that despite I.C.E.D.'s supplementation of its discovery responses, it is apparently unclear to opposer whether any other responsive documents exist that have not already been provided. Obviously, CDS cannot produce documents that do not exist. In view thereof, I.C.E.D.'s motion to compel is granted to the extent that CDS must assert in writing within THIRTY DAYS of the mailing date of this order that it has provided all documents responsive to these document requests and that no other responsive documents exist.

Document Request Nos. 17, 18, 19, 20, and 29

In its motion to compel, I.C.E.D. complained that CDS failed to produce a privilege log with regard to Document Request Nos. 17, 18, 19, 20 and 29 so as to allow I.C.E.D. to determine whether the documents claimed as privileged

were created in the context of giving legal advice. I.C.E.D. has also complained about CDS's confidentiality objections with regard to Document Request Nos. 17 and 18, advising that the parties have not yet agreed to a protective order.

In response to the motion to compel, CDS advises that it has provided I.C.E.D. with a privilege log in support of all objections based on attorney-client privilege and that it has signed a protective agreement.

In reply, I.C.E.D. argues that the privilege log must be clarified because "many entries in the privilege log give no indication of why any privilege applies."

The Board has reviewed the privilege log provided by CDS to I.C.E.D. and has determined that with regard to the documents complained about in I.C.E.D.'s letter of February 21, 2003, the privilege log is facially inadequate for determining whether a privilege exists. In view thereof, I.C.E.D.'s motion to compel is granted to the extent that CDS must provide, within THIRTY DAYS of the mailing date of this order, a more detailed log of the documents identified in I.C.E.D.'s letter of February 21, 2003 by 1) listing the individuals who were authors or addressees or copied on the documents, (or were informed of the documents substance), and 2) providing counsel's representation as to whether the documents were prepared: (a) ...to assist in anticipated or

pending litigation or (b) contain information reflecting communications between (i) counsel or counsel's representatives and (ii) the client or the client's representatives, for the purpose of facilitation in the rendition of legal services to the client.

In view of the signing of the protective agreement, I.C.E.D.’s motion to compel with regard to applicant’s confidentiality objections is moot.

Interrogatory Nos. 6, 7, 8, and 16

I.C.E.D. argues in its motion to compel that CDS cannot limit its discovery responses to information related solely to geographic territory claimed in its concurrent use application and must be based on actual use; that CDS should provide information regarding its prior use; and that therefore, CDS’s responses are insufficient.

In response, applicant states that opposer has cited no authority that expands the scope of a likelihood of confusion analysis in a concurrent use proceeding to areas of prior use; that its claimed area of use and its actual use are “one in the same”; and that it has provided “supplemental responses to further specify an clarify that its actual use of “THE COPY CLUB” is indeed limited to those seven states identified in its concurrent use application.”

In reply, opposer argues that prior use of THE COPY CLUB mark is highly relevant to the likelihood of confusion analysis and therefore should be provided.

Because relevancy for discovery purposes is broader than trial, the Board finds that inquiry into applicant's prior use is relevant. However, I.C.E.D. is cautioned against using the discovery process for purposes of harassment. Moreover, I.C.E.D. is advised that simply because the Board finds that the inquiry is relevant for discovery purposes does not mean that this information is relevant for trial purposes. If I.C.E.D. plans to argue at trial that CDS prior overlapping use is relevant, there has to be a compelling reason to do so, not just a theory that because past overlapping use was likely to cause confusion, there may again be such overlapping use in the future.

Accordingly, I.C.E.D.'s motion to compel is granted to the extent that CDS must disclose within THIRTY DAYS of the mailing date of this order the geographic areas of prior use (i.e., cities and states where CDS has shipped goods under the marks or serviced clients under the mark) which have now been discontinued. CDS is not required to provide I.C.E.D. with client lists with regard to its areas of prior use.

I.C.E.D. also complains that CDS's original and supplemental interrogatory responses to Interrogatory no. 6

"fail to sufficiently identify cities within geographic areas already named."

The Board agrees with I.C.E.D. that with respect to Interrogatory No. 6, CDS's supplemental responses are somewhat unclear. In particular, the areas "greater Kansas City metropolitan area"; "greater St. Louis metropolitan area", and "greater New York City metropolitan area" identify areas which encompass more than one city.

Accordingly, I.C.E.D.'s motion to compel a better response to Interrogatory No. 6 is granted to the extent that CDS must specify, within THIRTY DAYS of the mailing date of this order, the cities comprising the greater metropolitan areas of Kansas City, St. Louis and New York.

Identity of CDS's customers

I.C.E.D. argued in its motion to compel that CDS must provide the names of its customers in each state CDS has used its mark.

In response, CDS states that it has no obligation to provide confidential customer information; that this request is made for purposes of harassment; that the request is unlimited as to time and involves common law rights that applicant established in certain geographic territories prior to I.C.E.D.'s filing for federal registration of its mark.

In reply, I.C.E.D. states that the Board should compel applicant to reveal names of at least the first customer in each state where applicant has used its mark and in each state in which applicant seeks a concurrent use registration.

The Board agrees with CDS that as a general rule, the names of customers are not discoverable. However a party may be required to furnish the name and address of its first customer in order to verify its claimed date of use. *Johnston Pump/General Valve, Inc. v. Chromalloy American Corporation*, 10 USPQ2d 1671 (TTAB 1988).

In view thereof, I.C.E.D.'s motion to compel is granted to the extent that CDS must furnish, within THIRTY DAYS of the mailing date of this order, the name of its first customer in each state where applicant seeks a concurrent use registration (Connecticut, Kansas, Missouri, New Jersey, New York, Pennsylvania & Utah).

As stated above, CDS is allowed until THIRTY DAYS from the mailing date of this order to serve supplemental responses to the discovery requests for which the motion to compel is granted.

I.C.E.D.'s motion to extend is granted.

Proceedings are resumed. Trial dates, including the close of discovery, are reset as follows:

DISCOVERY PERIOD TO CLOSE:	**November 26, 2003**
30-day testimony period for party in position of plaintiff to close:	**February 24, 2004**
30-day testimony period for party in position of defendant to close:	**April 24, 2004**
15-day rebuttal testimony period for party in position of plaintiff to close:	**June 8, 2004**

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.l25.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.

By the Trademark Trial and Appeal Board