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

Mailed: February 27, 2018

Cancellation No. 92060308

SFM, LLC

v.

Corcamore, LLC

Katie W. McKnight,
Interlocutory Attorney:

This case now comes up for consideration of (1) Petitioner's motion (filed October 25, 2017) to compel Respondent's supplemental responses to Document Request Nos. 4, 6-16, 17-21 and 24 and Interrogatory Nos. 1, 2 and 6-19; and (2) Respondent's motion (filed November 15, 2017)[1] to reopen its time to file a response to Petitioner's motion to compel.[2] Both motions are fully briefed.[3]

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[1] Respondent's response to Petitioner's motion to compel was due November 14, 2017, one day before it filed its motion to extend. Trademark Rule 2.127(a). "The Board construes a motion to extend an expired time as a motion to reopen such period." *Vital Pharm., Inc. v. Kronholm*, 99 USPQ2d 1708, 1710 n.10 (TTAB 2011).

[2] The Board notes that Respondent separately filed its certificate of service with respect to its response to Petitioner's motion to compel. *See* 50 TTABVUE. Respondent is advised that the certificate of service must appear on, or be securely attached to, the document being filed. TBMP § 113.03 (June 2017).

[3] Inasmuch as Petitioner's Response to Respondent's Motion to File Opposition *Nunc Pro Tunc* (filed December 7, 2017) is effectively a second response to Respondent's motion to reopen, it is an improper surreply brief under Trademark Rule 2.127(a) and will receive no consideration. *See Pioneer Kabushiki Kaisha v. Hitachi High Techs. America, Inc.*, 74 USPQ2d 1672, 1677 (TTAB 2005).

Relevant Background

After the Board issued an order on October 27, 2017 suspending proceedings pending disposition of Petitioner's motion to compel, and instructing the parties not to file any paper that is not germane to Petitioner's motion, Respondent filed several motions. On October 30, 2017, Respondent filed a motion to compel responses to its interrogatories and documents in response to its document requests. *See* 39 TTABVUE. On November 13, 2017, Respondent filed a motion for a protective order, requesting that the Board defer a deposition properly noticed to take place the following day until the Board has ruled on Respondent's motion to compel. *See* 40 TTABVUE. On November 13, 2017, the Board denied Respondent's motion for a protective order and advised that Respondent's 30(b)(6) witness was expected to appear for its noticed deposition. *See* 41 TTABVUE. That same day, Respondent requested reconsideration of the Board's order denying its motion for a protective order. *See* 42 TTABVUE.

On November 14, 2017, Respondent filed a motion to consolidate this proceeding with Proceeding No. 92061193. *See* 43 TTABVUE. Also on November 14, 2017, the Board denied Respondent's motion to compel without prejudice, inasmuch as it was filed while proceedings were suspended, and noted that proceedings remain suspended except for briefing on Respondent's request for reconsideration. *See* 44 TTABVUE. Respondent later withdrew its request for reconsideration and its motion to consolidate on November 15, 2017. *See* 45 TTABVUE, 46 TTABVUE. As a result,

the only motions that remain pending are Petitioner's motion to compel and Respondent's motion to reopen its time to respond to Petitioner's motion to compel.

Respondent's Motion to Reopen

Respondent failed to file and serve a brief in response to Petitioner's motion to compel by the November 14, 2017 deadline in accordance with Trademark Rule 2.127(a). By its motion to reopen, Respondent requests additional time to prepare and serve supplemental responses to Petitioner's discovery requests which would potentially narrow the issues in dispute in Petitioner's motion to compel. *See* 47 TTABVUE 2. In support of its motion, Respondent argues that counsel simply miscalculated the deadline to respond. *See* 49 TTABVUE 2.

In response to Respondent's motion, Petitioner argues that Respondent's statement that it wants more time to prepare and serve supplemental responses to Petitioner's discovery fails to set forth with particularity the facts said to constitute good cause for the requested extension, and fails to explain why it could not previously serve supplemental responses. *See* 48 TTABVUE 6. Petitioner further argues that Respondent is not acting in good faith, inasmuch as Respondent's motion to reopen is another instance of its pattern of delay. *See id.* at 6-7. In support of its argument, Petitioner details Respondent's pattern of filing frivolous motions, and notes that Respondent's 30(b)(6) witness failed to appear for its deposition noticed for November 14, 2017, despite the Board's November 13, 2017 order warning

Respondent that the witness was expected to appear for the noticed deposition.[4] *See id.* at 8-9; *see also* 41 TTABVUE 2-3.

The Board may, in its discretion, permit a party to reopen an expired time period where the failure to act is due to excusable neglect. *See* Fed. R. Civ. P. 6(b)(1)(B). Such a determination is an equitable one that must take into account all relevant circumstances surrounding the party's omission including, but not limited to: (1) the danger of prejudice to the nonmovant; (2) the length of the delay and its potential impact on the case; (3) the reason for the delay, including whether it was within the reasonable control of the movant; and (4) whether the movant acted in good faith. *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1586 (TTAB 1997) (citing *Pioneer Inv. Servs. Co. v. Brunswick Assocs., Ltd. P'ship*, 507 U.S. 380 (1993)). The reason for the delay may be considered the most important factor. *See id.* at 1586 n.7.

Prejudice to the nonmovant must be more than the mere inconvenience and delay caused by the movant's failure to take timely action, and more than the nonmovant's loss of any tactical advantage which it otherwise would enjoy as a result of the movant's delay or omission. *See Pratt v. Philbrook*, 109 F.3d 18, 22 (1st Cir. 1997). Rather, the first factor contemplates prejudice to the nonmovant's ability to litigate the case due to, for example, the loss or unavailability of evidence or witnesses which otherwise would have been available. *Pumpkin*, 43 USPQ2d at 1587. Although Petitioner argues that it was not able to depose Respondent's 30(b)(6) witness as a

[4] To the extent Petitioner, by its response to Respondent's motion to reopen, also attempts to seek relief for failure of Respondent's 30(b)(6) witness to appear for its deposition, a motion to compel attendance at a deposition is not currently before the Board.

result of Respondent's delay tactics, it does not argue that this witness has become unavailable. Inasmuch as Petitioner filed its motion to compel before the close of discovery, this case is in the pre-trial stage, and any potential prejudice can be mitigated by extending the discovery period as necessary to accommodate the deposition. *Cf. Giersch v. Scripps Networks*, 85 USPQ2d 1306, 1309 (TTAB 2007). Accordingly, this factor is neutral.

As to the second factor, the length of delay, it is appropriate to consider the time required for briefing and deciding the motion to reopen. *Pumpkin*, 43 USPQ2d at 1587-88. As noted above, Respondent was allowed until November 14, 2017 in which to file its response to Petitioner's motion to compel, missed this deadline, and filed the instant motion the next day. Briefing on this motion concluded three weeks later. The length of Respondent's delay is not overly significant; this factor weighs slightly in favor of reopening time.

However, with respect to the fourth factor, Petitioner's arguments that the instant motion is just another delay tactic are well-taken. Respondent's overall pattern of delay since at least as early as July 19, 2017, the due date for service of Respondent's discovery responses, has caused delay in this proceeding and has resulted in unnecessary motion practice.[5] Accordingly, the second factor weighs against reopening time. Moreover, Respondent has also disregarded Board orders suspending

[5] Respondent is reminded that, under Patent and Trademark Rule 11.18(b), by presenting to the Office any paper, the party presenting such paper is certifying that to the best of the party's knowledge, information and belief, "[t]he paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office."

proceedings and advising that the discovery deposition of Respondent's 30(b)(6) witness should continue as scheduled. Respondent's delay tactics and inattention to Board orders certainly indicate a lack of good faith, and this factor weighs against reopening time. *See Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1851 (TTAB 2000).

As to the third factor, Respondent's reason for delay, it is well settled that docketing errors and breakdowns do not constitute excusable neglect. *Id.* at 1851. Respondent has shown that it is capable of filing motions in this proceeding, but simply failed to file a motion to suspend or extend before its deadline to respond. *See Vital Pharm., Inc.*, 99 USPQ2d at 1711. The Board finds that the reason relied upon by Respondent for its failure to timely respond – namely, that it miscalculated deadlines clearly set forth under Trademark Rule 2.127(a) – was wholly within Respondent's reasonable control, weighing heavily against a finding of excusable neglect. *Pumpkin*, 43 USPQ2d at 1586-87.

On balance, Respondent's inattention to the schedule governing this proceeding, failure to seek timely extensions or suspensions or take other action and the attendant delay do not lead to a finding of excusable neglect. As such, Respondent's motion to reopen time to respond to Petitioner's motion to compel is **denied**.

Even though Respondent will not be afforded an opportunity to respond to Petitioner's motion to compel, the Board notes that Respondent clearly opposes Petitioner's motion. As such, the Board will not grant Petitioner's motion to compel as conceded, but will entertain Petitioner's motion on the merits.

Petitioner's Motion to Compel

Initially, the Board finds that Petitioner has made the required good faith effort to resolve the parties' discovery dispute prior to seeking Board intervention and that Petitioner's motion is timely. *See* Trademark Rule 2.120(f)(1).

As to the merits of Petitioner's motion to compel, the motion is **granted in part**, and **denied in part**, to the extent noted below.

1. Motion to Compel Written Discovery

In support of its motion to compel, Petitioner argues, *inter alia*, that Respondent's late-served responses to Document Request Nos. 4, 6-21 and 24 consisted primarily of boilerplate objections, and requests that the Board overrule Respondent's objections and compel production of responsive documents. Petitioner further notes that Respondent failed to provide any response whatsoever to Document Request No. 16.

The record demonstrates that Respondent's August 3, 2017 responses to Petitioner's document requests served June 19, 2017 were late. Fed. R. Civ. P. 34(b)(2)(A); 37 TTABVUE 11-12, Exs. B, D, L. Accordingly, inasmuch as nothing in the record indicates that Respondent's failure to respond timely to Petitioner's written discovery was the result of excusable neglect, Respondent has waived its right to object to Respondent's document requests on the merits,[6] except for objections

[6] Objections going to the merits of a discovery request include those which challenge the request as overly broad, unduly vague and ambiguous, burdensome and oppressive, as seeking non-discoverable information on expert witnesses, or as not calculated to lead to the discovery of admissible evidence. In contrast, claims that information sought by a discovery request is trade secret, business-sensitive or otherwise confidential, is subject to attorney-client or a like privilege, or comprises attorney work product, goes not to the merits of the

based on privilege. *See No Fear, Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000). To the extent Respondent has interposed objections not based on privilege, those objections are hereby **overruled**.

Within **thirty days** of the mailing date of this order, Respondent is ordered to serve on Petitioner amended responses to Petitioner's first set of document requests **without objection on the merits**,[7] and to produce non-privileged documents responsive to Petitioner's first set of document requests,[8] except to the following extent:

a) Petitioner's document requests are limited in scope to the services identified in Registration No. 3708453.[9] *See* TBMP § 414(11) (June 2017).

b) Petitioner's document requests are limited in scope to use within the United States. *See* TBMP § 414(13).

request but to a characteristic or attribute of the responsive information. *No Fear, Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000). Objections based on confidentiality are expected to be extremely limited because the Board's standard protective order is in place for all Board *inter partes* proceedings. Trademark Rule 2.116(g).

[7] A proper response should state whether or not there are responsive documents and, if there are responsive documents, whether they will be produced by the deadline set forth in this order or withheld on a claim of privilege. If accurate, Respondent may respond that the requested documents are not in existence (e.g., lost or destroyed or that the documents are not within its possession, custody, or control). *See* TBMP § 406.04(c).

[8] A party served with a request for discovery has a duty to thoroughly search its records for information properly sought in the request. *See* TBMP § 408.02.

[9] However, the information that a party sells the same goods or services as the propounding party, even if under a different mark, is relevant to the issue of likelihood of confusion for purposes of establishing the relationship between the goods or services of the parties. TBMP § 414(11).

c) To the extent Petitioner's document requests seek "all documents," Respondent may provide a representative sampling of the information sought. *See* TBMP § 414(2). Such representative sampling must be sufficient to meet Petitioner's discovery needs.

To the extent Respondent contends that documents responsive to Petitioner's first set of document requests are privileged, Respondent is required to provide Petitioner with a privilege log within **thirty days** of the mailing date of this order. *See Victor Stanley, Inc. v. Creative Pipe, Inc.*, 250 F.R.D. 251, 264-67 (D.Md. 2008); TBMP § 406.04(c).

Regarding form of production, Petitioner moves the Board to compel Respondent to produce its documents (and re-produce those already produced) as separate documents as they exist in the usual course of business, with a Bates Stamp or production number. *See* 37 TTABVUE 15-16. During their discovery conference, the parties indicated they would discuss specific parameters for producing documents. *See* 36 TTABVUE 5. It is not clear that the parties agreed upon any such parameters. Petitioner's document requests specify that documents should be produced "as a DAT file, with Opticon.log load files of TIFFs with searchable text and OCR control text, except that Excel® files, other large spreadsheets, and documents incorporating track changes shall be included in the Opticon.log load file in native format." *See* 37 TTABVUE 48. Respondent objected to this form of production, and instead produced a single 667-page PDF. *See* 37 TTABVUE 31. Petitioner argues that it cannot discern where one document ends and the next begins in the single PDF, and requests that

Respondent reproduce responsive documents as separate, Bates-Stamped documents. *See* 37 TTABVUE 15.

In federal courts (where discovery is generally expected to be more extensive than in Board proceedings), there is an increasing focus on the question of proportionality, and on whether the type of ESI discovery Petitioner proposes in its document requests is always justified. *See Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 100 USPQ2d 1904, 1908 (TTAB 2011). In view of the Board's limited jurisdiction, and the narrowness of the issues to be decided by the Board, Petitioner's requests for production in specific file formats, and reproduction as separate documents, are disproportionate to the needs of the case; such specific forms of production are not required by the rules. *See id.*; Fed. R. Civ. P. 34(a). Moreover, it is unclear how Respondent's production of a single PDF document puts Petitioner at a significant disadvantage in light of the fact that a PDF is usually a collection of scanned documents, and the Board and the Federal Rules allow parties to produce hard copies of responsive documents. *See No Fear,* 54 USPQ2d at 1555. Accordingly, Petitioner's motion to compel is **denied** to the extent that it seeks to compel production of documents as separate DAT files, with Opticon.log load files of TIFFs with searchable text and OCR control text, or reproduction of separate PDFs.

Petitioner's arguments regarding organizing and Bates Stamping documents contained within a PDF, however, are well-taken. Petitioner's motion to compel is **granted** to the extent that Respondent must organize and label, by Bates Stamp number, the documents responsive to each of Petitioner's first set of document

requests. *See FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1761 (TTAB 1999) (Board has discretion to manage the discovery process). If there are no non-privileged documents in Respondent's possession, custody or control which are responsive to any of the above-identified document requests, Respondent must so state affirmatively in its response to the corresponding document request. In the event Respondent fails to provide Petitioner with full and complete responses to the outstanding discovery, as required by this order, Respondent will be barred from relying upon or later producing documents or facts at trial withheld from such discovery. *See* Fed. R. Civ. P. 37(c)(1); TBMP § 408.02.

2. Motion to Compel Interrogatory Responses

Petitioner contends that Respondent's responses to Petitioner's Interrogatory Nos. 1, 2 and 6-19 are inadequate because Respondent asserts general objections to all of Petitioner's requests and only substantively responds to Interrogatory Nos. 6-10 and 13, although not in any meaningful manner. 37 TTABVUE 16-17. Respondent also objects on the basis that "Petitioner has provided no discovery to support its contentions," which Petitioner argues is irrelevant to Respondent's duty to provide the requested discovery. 37 TTABVUE 18. Moreover, Respondent incorporates into its responses its briefing with respect to its motions to dismiss, which Petitioner argues is irrelevant. 37 TTABVUE 20-21. Petitioner further argues that Respondent improperly invokes Fed. R. Civ. P. 33(d). 37 TTABVUE 18-19. Petitioner also requests the Board to overrule Respondent's objection to its definition of "Respondent" as well

as its objections that several "plain English terms" used in Petitioner's requests are vague and ambiguous. 37 TTABVUE 21-23.

It is incumbent upon a party who has been served with interrogatories to respond by articulating its objections with particularity to each interrogatory which it believes to be objectionable, and by providing the information sought in those interrogatories 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 interrogatories should not be answered. *See id*. Here, Respondent's responses include many boilerplate objections, including, *inter alia*, that Petitioner's requests (1) are overly broad, unduly burdensome, not proportional to the needs of the case, and impose duties or burdens beyond those allowed by the applicable rules; (2) seek information already in Petitioner's possession or that could be more easily obtained from less burdensome sources; (3) seek, imply, rely upon, and/or require legal conclusions; and (4) seek confidential information. Such boilerplate objections to each interrogatory, as well as Respondent's blanket general objections, do not claim that Petitioner's interrogatories are objectionable in any specific manner, and are **overruled**.[10] *See Amazon Techs., Inc. v. Wax*, 93 USPQ2d 1702, 1705-06 (TTAB

[10] Petitioner argues that Respondent may not object to the definition of "Respondent" in Petitioner's first set of interrogatories. 37 TTABVUE 21. Respondent's objection to the definition of "Respondent" is contained within its general objections, which, as set forth above, are overruled. However, Petitioner is advised that the Board's determination of the adequacy of an interrogatory answer will not be governed by the introductory instructions or preamble in the interrogatories. *See Avia Group Int'l, Inc. v. Faraut*, 25 USPQ2d 1625, 1626 (TTAB 1992). Interrogatories may be served upon and demanded only of parties under Fed. R. Civ. P. 26(b) and 33. *See* Charles A. Wright, Arthur R. Miller et al., 8B Federal Practice and Procedure: Civil 23d § 2171 (April 2017).

2009); *Medtronic*, 222 USPQ at 83 (party must articulate objections with particularity); TBMP § 407.03(b). Moreover, to the extent Respondent objects that the requests seek confidential information, it is advised that the Board's standard protective order is automatically applicable to this proceeding, and in view thereof, objections on the ground of confidentiality are improper.[11] Trademark Rule 2.116(g); TBMP § 410.

> In response to Interrogatory Nos. 1, 2, 6-11 and 13-15, Respondent states that
>
> [s]ubject to and without waiver of the foregoing general and specific objections, and reserving the right to assert additional objections, Corcamore LLC responds that [P]etitioner has provided no discovery to support its contentions, and Respondent reserves the right to supplement its discovery responses when and if Petitioner provides some basis for its contention.

Respondent effectively states that it will not respond until Petitioner substantiates its claims. Respondent is advised that its response is **not well taken** and **overruled**. Discovery before the Board is not governed by the concept of priority of discovery – that is, a party is not relieved of its discovery obligations, including its duties to cooperate and search its records, regardless of whether the adverse party has fulfilled its own discovery obligations. *See Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067, 1070 (TTAB 1990); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626, 632 (TTAB 1986) ("It is imperatively not the prerogative . . . for parties or their counsel to unilaterally impose conditions upon the sequence and timing of

[11] If Respondent believed that the provisions of the Board's standard protective order were not sufficient to protect its confidential information, the proper procedure would have been to seek modification of the order, which it did not do. *See* ¶ 17 of the Board's standard protective order, available at https://www.uspto.gov/sites/default/files/documents/TTAB%20Standard%20Protective%20Order%20-%20FINAL_2016.pdf.

discovery which are not provided by the rules governing practice before the Board"); *see also* TBMP § 408.01. The Board expects parties (and their attorneys) to cooperate with one another in the discovery process, and looks with **extreme disfavor** on those who do not. TBMP § 408.01. Moreover, a responding party may not reserve the right to raise objections in the future; any objection not timely made may be waived. Fed. R. Civ. P. 33(b)(4).

Additionally, in response to Interrogatory Nos. 1, 2, 6-11 and 13-16, Respondent "incorporates by reference its Motions to Dismiss the Petitions to Cancel." This response is also **not well-taken**. *See Vazquez-Fernandez v. Cambridge College, Inc.*, 269 F.R.D. 150, 156 (D.Puerto Rico 2010) (generally, answering an interrogatory by referring to pleadings is insufficient); *cf. Emilio Pucci Int'l BV v. Sachdev*, 118 USPQ2d 1383, 1385 (TTAB 2016) (it is generally inappropriate for a party to respond to interrogatories by filing a motion attacking them). The Board denied Respondent's motion (filed December 12, 2014) to dismiss on April 30, 2015, and denied Respondent's motion for reconsideration of its April 30, 2015 order on May 5, 2017. Trademark Rule 2.127(b) does not contemplate a second request for reconsideration of the same basic issue. *See Giant Food*, 231 USPQ at 631. Moreover, the Board's May 31, 2017 order memorializing the parties' discovery conference specifically notes that discovery should focus on priority and likelihood of confusion of the respective marks. *See* 36 TTABVUE 4-5. Respondent's objection is **overruled**.

In response to Interrogatory Nos. 1, 2, 6-11 and 13-17, Respondent states that

> [s]ubject to and without waiver of the foregoing general and specific objections, and reserving the right to assert additional objections, Corcamore LLC will

produce responsive, nonprivileged, discoverable documents pursuant to Fed. R. Civ. P, Rule 33(d).

Under Fed. R. Civ. P. 33(d), where information sought in an interrogatory may be derived or ascertained from an examination, audit, or inspection of the business records of the responding party when the burden of deriving or ascertaining the information is substantially the same for the propounding party as for the responding party, the responding party may answer the interrogatory by specifying the records from which the information may be derived or ascertained, and affording to the propounding party reasonable opportunity to examine, audit, or inspect the records and make copies, compilations, abstracts, or summaries. Respondent's response under Fed. R. Civ. P. 33(d) is improper for several reasons. First, a responding party cannot simultaneously invoke the option to produce business records and claim the protection of a privilege as to the documents, which Respondent has done by incorporating its general objections. *See No Fear*, 54 USPQ2d at 1554. Second, a party responding to an interrogatory by producing business records or agreeing to produce business records must identify specific documents which the responding party knows to contain the responsive information, and "may not merely agree to provide access to a voluminous collection of records which may contain the responsive information." *See id*. "In addition, 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. Further, even if the responding party can meet this test and can identify particular documents in which the inquiring party will find its answers, the inquiring party must not be left with any greater burden than the responding party

when searching through and inspecting the records." *See id*. Respondent's reliance on Fed. R. Civ. P. 33(d) is improper and Respondent may not invoke Fed. R. Civ. P. 33(d) without addressing the necessary elements recited above.

Respondent also asserts various objections as to vagueness in response to Interrogatory Nos. 1, 2, 6-13 and 15-17, arguing that phrases that refer to, *inter alia*, "Respondent's goods and services," "channels of trade," and "price for" or "sales volume for goods and services" are unclear. Inasmuch as these terms are generally understood in trademark law, these objections as to vagueness are not well-taken. *See, e.g., Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (question of registrability must be decided on the basis of the identification of goods set forth in the application); *Autac Inc. v. Viking Indus., Inc.*, 199 USPQ 367, 374 (TTAB 1978) (question of likelihood of confusion in cancellation proceedings must be determined on the basis of the goods as described in the subject registration including, in the absence of a restriction, a presumption of sale in all of the markets for all goods comprehended by the description to all potential users of the goods).

Turning to the particular Interrogatories at issue in Petitioner's motion to compel, the motion is **granted in part** and **denied in part** to the extent noted below:

Interrogatory No. 1

Motion is **granted** to the extent that Respondent must provide a full and complete response to this interrogatory.[12] TBMP § 414(21).

[12] Interrogatories may ask for the material or principal facts that support a party's contentions. Contention interrogatories such as Interrogatory No. 1 that do not encompass

Interrogatory No. 2

Motion is **granted** to the extent that Petitioner is entitled to a description of Respondent's selection, adoption, and decision to apply for registration of Respondent's Mark in connection with Respondent's vending machine services in the United States, including all Persons involved and their roles. TBMP § 414(4).

Interrogatory No. 6

Motion is **granted** to the extent that Petitioner is entitled to a description of Respondent's use of Respondent's Mark in the United States. *See Double J of Broward, Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1613 (TTAB 1991).

Interrogatory No. 7

Motion is **granted** to the extent that Petitioner is entitled to a description of the vending machine services which Respondent currently sells or distributes under Respondent's Mark in the United States, and must (1) state the date of first use in commerce; (2) state the dates any such use in the United States ceased; and (3) describe Respondent's channels of trade and classes of target customers with respect to Respondent's vending machine services sold or distributed under Respondent's Mark. TBMP § 414(5), (3).

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every allegation made by a party reasonably place upon the answering party "the duty to answer them by setting forth the material or principal facts." *Hiskett v. Wal-Mart Stores, Inc.*, 180 F.R.D. 403, 405 (D.Kan. 1998) (citing *IBP, Inc. v. Mercantile Bank*, 179 F.R.D. 316 (D.Kan. 1998)). Respondent "shall, therefore, provide the principal or material facts upon which [it] supports the [identified allegations]. The interrogatory is not objectionable to that extent." *Id*.

Interrogatory No. 8

Motion is **granted** to the extent that Petitioner is entitled to a description of the goods and services which Respondent intends to sell or distribute under Respondent's Mark in the United States and for each good or service, (1) state the intended date of first use in commerce; and (2) describe Respondent's intended channels of trade and classes of target customers. TBMP § 414(8).

Interrogatory No. 9

Motion is **granted** to the extent that Petitioner is entitled to (1) the name of the first customer to whom Respondent provided its vending machine services bearing Respondent's Mark in the United States. TBMP § 414(3). Disclosure may be made under protective order.

Interrogatory No. 10

Motion is **granted** to the extent that Respondent must identify the channels of trade for Respondent's vending machine services bearing Respondent's Mark in the United States, including current and intended future channels.

Interrogatory No. 11

Motion is **granted** to the extent that Respondent must identify and describe all instances of actual confusion involving the parties' SPROUT, SPROUTS FARMERS MARKET, and SPROUTS marks in the United States. *See Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193, 196-97 (TTAB 1976).

Interrogatory No. 12

Motion is **granted** to the extent that search reports are discoverable, but the comments or opinions of attorneys relating thereto are privileged and not discoverable (unless the privilege is waived). TBMP § 414(6).

Interrogatory No. 13

Motion is **granted** to the extent that Respondent must identify the price for Respondent's vending machine services bearing Respondent's Mark and the projected price for goods or services intended to be sold by Respondent bearing Respondent's Mark in the United States.

Interrogatory No. 14

Motion is **granted** to the extent Petitioner is entitled to Respondent's annual sales, stated in round numbers, for Respondent's vending machine services rendered in connection with Respondent's Mark for the preceding five years and the persons most knowledgeable about Respondent's sales. TBMP § 414(18).

Interrogatory No. 15

Motion is **granted** to the extent Petitioner is entitled to Respondent's annual marketing or advertising expenditures, stated in round numbers, for Respondent's vending machine services rendered in connection with Respondent's Mark for the preceding five years and the persons most knowledgeable about Respondent's marketing or advertising. TBMP § 414(17), (18).

Interrogatory No. 16

Motion is **granted**. *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988).

Interrogatory No. 17

Motion is **granted** to the extent that Respondent must describe enforcement efforts taken by Respondent against others with respect to marks that are the same as or similar to Respondents' Mark, to the extent that Respondent has actual knowledge thereof (without performing an investigation). However, the only information which must be provided with respect to a legal proceeding is the names of the parties thereto, the jurisdiction, the proceeding number, the outcome of the proceeding, and the citation of the decision (if published). TBMP § 414 (9), (10).

Interrogatory Nos. 18 and 19

Motion is **denied**. Respondent's "[t]o be determined" response is sufficient. *See Hansel v. Shell Oil Corp.*, 169 F.R.D. 303, 305 (E.D. Pa 1996); *cf. Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1715 (TTAB 1999) (generally, a party does not have an obligation to locate documents that are not in its possession, custody, or control). Respondent is reminded that it has a duty to supplement its response in a timely manner to include information under the particular circumstances specified in Fed. R. Civ. P. 26(e).[13] TBMP § 408.03; *see also Great Seats, Inc. v. Great Seats, Ltd.*, 100

[13] However, if the information has otherwise been made known to Petitioner during the discovery process or was otherwise made known in writing, Respondent need not amend its prior response. TBMP § 408.03.

USPQ2d 1323, 1328 (TTAB 2011) (plaintiff estopped from taking testimony of twenty-six late-disclosed witnesses).

3. Summary

Petitioner's motion to compel is **granted in part** and **denied in part**. Respondent's responses to Petitioner's first set of document requests were late-served and therefore Respondent has waived its right to object to Respondent's document requests on the merits, except for objections based on privilege. To the extent Respondent has interposed objections not based on privilege, those objections are **overruled**. Respondent is allowed until **thirty days** from the mailing date of this order in which to provide: (1) amended responses to Petitioner's first set of document requests without objection on the merits as discussed above; (2) supplemental responses to Interrogatory Nos. 1, 2 and 6-17; and (3) a privilege log, to the extent Respondent contends that documents responsive to Petitioner's first set of document requests are privileged.

Respondent must organize and label, by Bates Stamp number, the documents responsive to each of Petitioner's first set of document requests. If there are no non-privileged documents in Respondent's possession, custody or control which are responsive to any of the above-identified document requests, Respondent must so state affirmatively in its response to the corresponding document request. To the extent Respondent has already fully produced documents responsive to any document request, Respondent must so state in its response to the particular document request

and identify, by Bates Stamp number, the documents which are responsive to each request.

Respondent is reminded that an evasive or incomplete response is the equivalent of a failure to disclose. *See* Fed. R. Civ. P. 37(a)(4). In the event Respondent fails to provide Petitioner with full and complete responses to the outstanding discovery, as required by this order,[14] Respondent will be barred from relying upon or later producing documents or facts at trial withheld from such discovery. *See* Fed. R. Civ. P. 37(c)(1).

Respondent is also reminded of its continuing duty to thoroughly search its records for all information properly sought in discovery, and to provide supplementary information to the requesting party. TBMP §§ 408.01 and 408.02. Further, a party that has responded to a request for discovery remains under a continuing duty to supplement or correct the response to include information thereafter acquired or uncovered. TBMP § 408.03.

Should Respondent fail to comply with the Board's orders herein, Petitioner may seek appropriate sanctions. *See* Trademark Rule 2.120(h)(1); TBMP §§ 411.05 and 527.01.

Sanctions

Respondent has already been warned that its extensive motion practice has no place in any Board proceeding. *See* 28 TTABVUE 8-9. Still, Respondent continues to

[14] The parties are again advised that TBMP § 414 contains an extensive, but not exhaustive, guideline of typical discovery topics in Board proceedings.

file eleventh-hour and unnecessary motions, deferring and withdrawing several of these motions.

Respondent is once again prohibited from filing any additional unconsented or unstipulated motions without first obtaining prior Board permission. *See, e.g., Int'l Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1605 (TTAB 2002); *see also* TBMP § 527.03 and cases cited in Note 4. In seeking such permission, counsel for Respondent is required to contact by telephone the Board interlocutory attorney assigned to this case to conduct a case conference with counsel for Petitioner also present. In the event that after the service of discovery, Respondent seeks to file a motion to compel or any other motions related to discovery or disclosures, it is also required to provide to the Board in writing, with proper service on Petitioner, a statement of good faith effort made under Trademark Rule 2.120(f)(1), a copy of each discovery request or notice of deposition in dispute, and a copy of all correspondence and emails involving the discovery request(s) or notice(s) of deposition prior to the telephone conference. Counsel for Respondent must also be prepared to identify each conversation with Petitioner regarding the discovery request(s), notice(s) of deposition or disclosures and describe the substance thereof.

Schedule

Proceedings are **resumed**. Dates are reset on the following schedule:

Expert Disclosures Due	**March 31, 2018**
Discovery Closes	**April 30, 2018**
Plaintiff's Pretrial Disclosures Due	**June 14, 2018**
Plaintiff's 30-day Trial Period Ends	**July 29, 2018**
Defendant's Pretrial Disclosures Due	**August 13, 2018**
Defendant's 30-day Trial Period Ends	**September 27, 2018**

Plaintiff's Rebuttal Disclosures Due	**October 12, 2018**
Plaintiff's 15-day Rebuttal Period Ends	**November 11, 2018**
BRIEFS SHALL BE DUE AS FOLLOWS:	
Plaintiff's Main Brief Due	**January 10, 2019**
Defendant's Main Brief Due	**February 9, 2019**
Plaintiff's Reply Brief Due	**February 24, 2019**

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).