Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
www.uspto.gov

Team Air Express, Inc.

v.

America's Team Properties, Inc.

Opposition No. 91163900
On Petition to the Director
Filed: November 7, 2006

Decision

America's Team Properties, Inc. (petitioner) has petitioned the Director reverse an interlocutory order issued by the Trademark Trial and Appeal Board (Board) on October 5, 2006. The petition is denied.

FACTS

Trademark Application Serial No. 78340679 for the mark AMERICA'S TEAM is the subject of an opposition proceeding instituted on January 6, 2005.

Discovery and testimony periods were set, with the discovery period closing on October 31, 2005 and opposer's testimony period closing on January 29, 2006.[1]

On January 25, 2006, petitioner filed a motion to quash the testimony deposition of Team Air Express, Inc.'s (opposer) expert witness. Petitioner argued that opposer failed to timely disclose the identity of its expert witness, and its reliance on expert testimony, despite a request to disclose such information made during the discovery period. Disclosure of the expert's identity was made on January 20, 2006, nine days prior to the close of the testimony period, when opposer supplemented its discovery response.

In an order dated October 5, 2006, the Board denied the motion to quash and reset the trial dates for the opposition proceedings. The order indicated that five days remained in opposer's testimony period because the motion to quash was filed five days before the close of the period.

---

[1] Because January 29, 2006 was a Sunday, opposer's testimony period was permitted to close on the next succeeding business day, January 30, 2006. 37 C.F.R. §2.196.

On November 6, 2006, petitioner filed the present petition in which it argued that the Board's order denying the motion to quash was clear error and abuse of discretion. Petitioner asserted that the Board's finding that opposer did not intend to call its expert until January 18, 2006 was not supported by any evidence. Petitioner argued further that the Board abused its discretion in denying the motion to quash because it ignored the rules related to opposer's obligation to provide timely discovery responses.

Finally, petitioner asserted that only one day remained in opposer's testimony period because the Board had suspended the opposition proceedings one day before the close of the period. In a separate motion, petitioner requested that the opposition proceeding be suspended pending a decision on its petition. The Board granted the motion and suspended the proceeding on November 28, 2006.

ANALYSIS

Pursuant to 35 U.S.C. §2 and 37 C.F.R. §2.146(a)(3), the Director may invoke supervisory authority in appropriate circumstances. However, the Director will reverse an interlocutory order issued by the Board in an inter partes proceeding only upon a showing of clear error or abuse of discretion. *Jonergin Co. Inc. v. Jonergin Vermont Inc.*, 222 USPQ 337 (Comm'r Pats. 1983); *Riko Enterprises, Inc. v. Lindsley,* 198 USPQ 480 (Comm'r Pats. 1977). For the reasons set forth below, the circumstances presented in this case do not show an abuse of discretion on the part of the Board.

A party in a Board proceeding generally has no obligation to identify its fact witnesses or other trial evidence prior to trial.[2] *Trademark Trial and Appeal Board Manual of Procedure* (TBMP) §414. However, a party that has responded to a request for discovery is under a duty to supplement or correct a response that is in some material respect incomplete or incorrect to include information that has not otherwise been made known to the other party during the discovery process or in writing. Fed. R. Civ. P. 26(e)(2); TBMP §408.03.

Here, petitioner has presented no convincing evidence that the Board's decision regarding the date on which opposer intended to call its expert witness was clear error or abuse of discretion. Opposer was under no obligation to identify its witnesses prior to trial. Based on the record before it, which included the expert's sworn statements regarding the date on which he first discussed the possibility of testifying with opposer, the Board determined that opposer did not intend to call the expert as a witness until January 18, 2006. In compliance with Fed. R. Civ. P. 26(e)(2), opposer supplemented its discovery response to include the identity of the expert witness within two days of discussing its intentions with the witness. Therefore, the Board did not commit a clear error when it determined that

---

[2] *See Time Warner Entertainment Co. v. Jones,* 65 USPQ2d 1650, 1657 (TTAB 2002) (interrogatory requesting that opposer "identify each and every fact, document and witness in support of its pleaded allegations" was equivalent to a request for identification of fact witnesses and trial evidence prior to trial, and therefore improper); *Milliken & Co. v. Image Industries, Inc.,* 39 USPQ2d 1192, 1197 (TTAB 1996) (need only identify expert witnesses); *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1201 (TTAB 1993) (need not disclose entirety of proposed evidence), *aff'd, Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); *Charrette Corp. v. Bowater Communication Papers Inc.*, 13 USPQ2d 2040, 2041 (TTAB 1989) (motion to exclude testimony of witness for failure to identify witness during discovery denied); *Polaroid Corp. v. Opto Specs, Ltd.*, 181 USPQ 542, 543 (TTAB 1974) (opposer need not describe evidence it will rely on to support allegations in opposition); and *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 124 (TTAB 1974).

opposer did not intend to call its expert witness until January 18, 2006, and thereafter complied with the applicable procedural rules.

There are several remedies available to a party who believes that an adversary has not complied with the language, if not the spirit, of the discovery rules. Under certain circumstances, the discovery period may be extended, that is, by stipulation of the parties approved by the Board, on motion (pursuant to Fed. R. Civ. P. 6(b)) granted by the Board, or by order of the Board. A delay or improper response to a discovery request received early in the discovery period, thereby forcing the requesting party to file a motion to compel discovery, constitutes an example of good cause for an extension of the discovery period. TBMP §403.04. When a party fails to provide discovery requested by means of discovery depositions, interrogatories, and requests for production of documents and things, the requesting party may file a motion to compel discovery. 37 C.F.R. §2.120(e); TBMP §523.01. In addition, a motion for sanctions related to discovery requests is available when the responding party (1) has failed to respond and (2) has informed the party seeking discovery that no response will be made. 37 C.F.R. §2.120(g)(2); TBMP §527.01(b).

Here, petitioner presented no evidence that opposer both failed to respond to petitioner's discovery requests *and* had informed petitioner that no response would be made. Moreover, if petitioner believed that opposer failed to adequately answer its discovery requests, or did so in an untimely manner, petitioner should have utilized the available remedies. Although petitioner's frustration with opposer's tactics is understandable, the Director finds that the Board was within its discretion to determine that sanctions were not proper in this case.

Finally, the Board's usual practice is to consider suspension of a proceeding to be effective nunc pro tunc to the date the relevant motion was filed. It is also within the Board's discretion to reset dates appropriately after a suspension. Here, the motion to quash was filed January 25, 2006, which was five days before the close of opposer's testimony period. Therefore, the Board considered the proceeding to be suspended as of January 25, 2006. In its decision, the Board stated that five days remained in opposer's testimony period. The Director finds that the Board properly exercised its discretion to grant opposer the time it had left in its testimony period upon resumption of the proceedings.

DECISION

The petition is denied. The decision will be forwarded to the Board so that the opposition proceeding can be resumed.

Sharon R. Marsh
Deputy Commissioner for
Trademark Examination Policy

SRM:CPC

Date: MAY 31 2007

Attorney for Petitioner:

Stephen R. Baird
Winthrop & Weinstine, P.A.
225 South Sixth Street
Suite 3500
Minneapolis, MN 55402

Attorney for Opposer:

Diane K. Lettelleir
Winstead Sechrest & Minick P.C.
P.O. Box 50784
Dallas, TX 75201