

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

WBC

Mailed: December 26, 2017

Opposition No. 91234467

Blue Ivy

v.

BGK Trademark Holdings, LLC

Wendy Boldt Cohen, Interlocutory Attorney:

This case comes before the Board on the following:

1. Applicant's motion to amend the Board's standard protective order; and
2. Opposer's motion to compel responses to its discovery served July 20, 2017 and to compel attendance of Beyoncé Knowles Carter in a Rule 30(b)(6) discovery deposition.

The motions are fully briefed.¹

PROTECTIVE ORDER

In *inter partes* proceedings before the Board, the Board's standard protective order is automatically in place to govern and facilitate the exchange of information. Trademark Rule 2.116(g). The terms of the Board's standard protective order may be modified, upon motion or upon stipulation approved by the Board, to govern the exchange of confidential, highly confidential, and

¹ The Board has considered the parties' submissions and presumes the parties' familiarity with the factual bases for the motion, and does not recount them here except as necessary to explain the Board's order. See *Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019-20 (TTAB 2015).

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trade secret/commercially sensitive information. TBMP § 412.02 (June 2017); Wright, Miller & Kane, 8A *Fed. Prac. and Proc.: Civ.* § 2043 (3d ed. 2016). Additionally, on motion pursuant to Trademark Rule 2.120(g), showing good cause, by a party from which discovery is sought, the Board may make any order which justice requires to protect a party from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the types of orders described in clauses (A) through (H) of Fed. R. Civ. P. 26(c). *See, e.g., Pioneer Kabushiki Kaisha v. Hitachi High Technologies America, Inc.*, 74 USPQ2d 1672, 1674 (TTAB 2005).

In short, Applicant seeks an order modifying the Board's standard protective order regarding "private information concerning Applicant" and further "any and all information and material of any kind concerning and/or related to ... Beyoncé Knowles Carter ... Blue Ivy Carter, and/or Shawn Carter ... (collectively 'Artists') and/or any person, firm, partnership, corporation and/or any other entity in any way related to or affiliated and/or associated with Artists." 9 TTABVUE 16. Applicant's motion is predicated on its purported need to protect personal information "irrelevant to this proceeding" and that sanctions be available for violations of this protective order. 9 TTABVUE 5. Applicant further notes that protection of certain information is necessary to "ensure [Mrs. Carter's] and her family's physical safety, to minimize the intrusive (and costly) use of extensive security, and to reduce the dangerous pandemonium that so often marks Mrs. Carter's public appearances." *Id.*

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Applicant further asserts that “the requested protective orders seek only to seal the *logistics* of depositions from public disclosures, not prophylactically seal the testimony which may be adduced therein.” 9 TTABVUE 7 n.6. However, the proposed amendments are broadly written with no such restrictions included.

As noted by Applicant, much of the information sought to be kept confidential by its proposed amendments to the Board’s standard protective order is information that is “irrelevant to this proceeding.” Pursuant to Fed. R. Civ. P. 26(b)(1), 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. Accordingly, if Opposer seeks information that is irrelevant to this proceeding, Applicant may object to such request.

Furthermore, Applicant has not cited to any caselaw, and the Board is unaware of any caselaw, which gives the Board jurisdiction over parties, such as Mr. Carter, who are not parties to this proceeding. *See* 9 TTABVUE 4 n.3 (“Mr. Carter is ... [not] an employee or officer of [Applicant].”); *see also Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1787 n.5 (TTAB 2001) (“the Board’s jurisdiction over the parties ends when this proceeding does and the Board will not be involved in enforcing provisions of the [protective] agreement after conclusion of the opposition.”). Applicant’s proposed amendments not only seek to include parties which are not parties to this proceeding, but broadly seek to keep confidential “any and all information and material of any kind” of Applicant and additionally named parties. Such broad

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language is in contravention to the Board's general policy that all papers in a proceeding be public. *See Ayoub, Inc. v. ACS Ayoub Carpet Serv.*, 118 USPQ2d 1392, 1398 n.39 (TTAB 2016).

Applicant also seeks amendment to the Board's standard protective order to specifically include language about sanctions. Such an amendment is unnecessary. The Board has the authority to enter a variety of sanctions, including sanctions for failure to comply with a Board discovery order, for violation of Fed. R. Civ. P. 11, and its inherent authority to sanction, regardless of whether the parties agree to issuance of sanctions. *See* TBMP § 527 and authorities cited therein. Indeed, Applicant asserts in its motion that the Board has the authority to enter sanctions, including default judgment; and that its "proposal does nothing more than state the law." 9 TTABVUE 10.

Applicant, in the alternative, seeks amendments to the Board's protective order as purportedly proposed by Opposer and found in Exhibit B of Applicant's motion along with an order mandating certain information be kept confidential. *See* 9 TTABVUE 11, 26. However, Applicant's arguments in support of its proposed amendments focus on its proposed version found in Exhibit A and is largely silent as to Exhibit B.²

² Applicant proposes two versions of the standard protective order, each with different amendments. *See* 9 TTABVUE 15; 25. Applicant further asserts that the amendments in Exhibit B are proposed by Opposer; however, Opposer has not provided its approval or consent of those amendments. *See* 9 TTABVUE 25-35. Rather, Opposer argues that the "Board reject and not enter any of [Applicant's] proposed revisions." 11 TTABVUE 12. Although Applicant has provided a comparison of the two amended versions of the standard protective order in Exh. C, it has not provided the Board with a comparison of either version of proposed amendments in Exh. A and Exh. B, as compared to the

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In view thereof, the Board does not find Applicant's arguments in support of either version of the proposed amendments or additional security measures persuasive. Taking into account the parties' arguments, it is apparent that the Board's standard protective order, as written, as well as the Board's ability to sanction, will provide the parties with adequate protection against any harassing discovery requests or as may otherwise be appropriate under the circumstances. In view thereof and because Opposer does not consent to the proposed changes, Applicant's motion to amend the standard protective order and for an order requiring Opposer to keep the logistics of any deposition of Ms. Carter confidential is **denied**.

The Board's standard protective order remains the operative protective order in this proceeding.

Given the unique circumstances of this case, the Board reminds the parties that there are certain situations (such as, for example, when a request for discovery constitutes clear harassment, or when a party has not provided its initial disclosures, or when a defendant upon which a request for discovery has been served is not and was not, at the time of the commencement of the proceeding, the real party in interest) in which a party may properly respond to a request for discovery by filing a motion for a protective order that the discovery not be had, or be had only on specified terms and conditions. *See Trademark*

current standard protective order. Failure to provide such a comparison makes it unclear what amendments are proposed to the Board's standard protective order.

To be clear, this order denies both proposed amended versions of the standard protective order found in Exh. A and Exh. B of Applicant's motion.

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Rule 2.120(g); *Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1268 (TTAB 2015); *The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2154 (TTAB 2013); *C.H. Stuart Inc. v. S.S. Sarna, Inc.*, 212 USPQ 386, 387 (TTAB 1980) (protective order granted as to discovery not tailored to issues in Board proceeding, including those seeking information regarding whether officers of applicant had been convicted of a crime or subject to a proceeding before the U.S. government).

MOTION TO COMPEL

The Board now turns to Opposer's motion to compel responses to its July 20, 2017 discovery and to compel the attendance of Ms. Carter at a deposition.

A motion to compel discovery must be supported by a written statement from the moving party that such party or its attorney has made a good faith effort, by conference or correspondence, to resolve with the other party or its attorney the issues presented in the motion, and has been unable to reach agreement. Trademark Rule 2.120(e); *see also* TBMP § 523.02 and authorities cited therein. "The good faith efforts of the parties should be directed to understanding differences and actually investigating ways in which to resolve the dispute." *Hot Tamale Mama ... and More, LLC v. SF Invs., Inc.*, 110 USPQ2d 1080, 1081 (TTAB 2014); *see MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 953 (TTAB 1979). "In determining whether a good faith effort to resolve the discovery dispute has been made, the Board may consider, among other things, whether the moving party has investigated the possibility

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of resolving the dispute, whether, depending on the circumstances, sufficient effort was made towards resolution, and whether attempts at resolution were incomplete.” TBMP § 523.02. “Where it is apparent that the effort toward resolution is incomplete, establishing the good faith effort that is a prerequisite for a motion to compel necessitates that the inquiring party engage in additional effort toward ascertaining and resolving the substance of the dispute.” *Hot Tamale Mama*, 110 USPQ2d at 1081.

In support of Opposer’s efforts to resolve the parties’ dispute in good faith, Opposer alleges that it called Applicant and discussed, by telephone, on August 28, 2017, Opposer’s outstanding discovery requests. 10 TTABVUE 17.³

The evidence of record and Opposer’s actions do not persuade the Board that Opposer made sufficient efforts to resolve the parties’ dispute. The parties had just one discussion about Opposer’s discovery. Opposer should have engaged in additional effort toward ascertaining and resolving the substance of the dispute. Inasmuch as Opposer addressed the parties’ dispute just once with Applicant before filing its motion, it is clear a good faith effort was not made. Applicant was not given a meaningful opportunity to resolve the parties’ dispute prior to seeking Board intervention. Opposer’s efforts toward resolution were incomplete and insufficient.

In view thereof, the Board **denies** Opposer’s motion to compel. A frank exchange between counsels, given the parties’ equal obligations to make efforts

³ Opposer’s allegations are supported by a declaration from its attorney, Ryan Hatch.

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to resolve the discovery dispute, could have obviated this motion. *Cf. Amazon Technologies Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009). The vast majority of issues raised herein should have been resolved without Board intervention, and the Board suggests greater effort to avoid or resolve such controversies. The parties are directed to review carefully TBMP § 414 regarding the discoverability of various matters in Board *inter partes* proceedings.

Inasmuch as the parties include arguments about whether certain parties can be properly deposed,⁴ the Board reminds the parties that a party to an *inter partes* proceeding before the Board may file a motion, prior to the taking of a noticed discovery or testimonial deposition, to quash the notice of deposition, as appropriate. For example, a party may move to quash a notice of deposition on the ground that: the proposed deposition constitutes harassment or is without proper basis or that the deposing party seeks to take the testimonial deposition of a witness who was not identified or who was improperly identified in that party's pretrial disclosures. *See Kellogg Co. v. New Generation Foods Inc.*, 6 USPQ2d 2045, 2049 (TTAB 1988); *Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1328 (TTAB 2011); *Jules Jurgenson/Rhapsody Inc. v. Baumberger*, 91 USPQ2d 1443, 1444-45 (TTAB 2009). Alternatively, as already noted, in the case of a notice of discovery deposition and under appropriate

⁴ For example, Applicant argues that “[o]thers who work at [Applicant] are the persons most knowledgeable of facts relevant to this proceeding,” not “Mr. or Mrs. Carter.” 9 TTABVUE 7 n.6.

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circumstances, the party may file a motion for a protective order. A motion to quash may be filed on a variety of grounds.

The Board is troubled by the parties' allegations made in connection with the instant motions and the tenor of the parties filings, which evidences an apparent lack of cooperation. All parties in matters before the Board are expected to conduct their business with decorum and courtesy. *See MySpace Inc. v. Mitchell*, 91 USPQ2d 1060, 1062 n.4 (TTAB 2009). The Board expects parties (and their attorneys or other authorized representatives) to cooperate with one another in the disclosure and discovery process, and looks with extreme disfavor on those who do not. A party and its attorney or other authorized representative has a duty not only to make a good faith effort to satisfy the discovery needs of its adversary, but also to make a good faith effort to seek only such discovery as is proper and relevant to the issues in the case. *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1721 n.4 (TTAB 1989); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1304-05 (TTAB 1987). If it becomes clear to the Board that either party has failed to cooperate or otherwise conduct itself with decorum and courtesy, the Board may require permission before filing any unconsented or unstipulated motions, in addition to any other sanctions that may be appropriate. *See Schering-Plough Animal Health Corp. v. Aqua Gen AS*, 90 USPQ2d 1184, 1185 (TTAB 2009); *International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1604 n.23 (TTAB 2002); *Carrini Inc. v. Carla Carini S.R.L.*,

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57 USPQ2d 1067, 1071-72 (TTAB 2000); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1721 n.4 (TTAB 1989).

Proceedings will automatically resume December 30, 2017; dates are reset as follows:

Initial Disclosures Due	December 30, 2017
Expert Disclosures Due	April 29, 2018
Discovery Closes	May 29, 2018
Plaintiff's Pretrial Disclosures Due	July 13, 2018
Plaintiff's 30-day Trial Period Ends	August 27, 2018
Defendant's Pretrial Disclosures Due	September 11, 2018
Defendant's 30-day Trial Period Ends	October 26, 2018
Plaintiff's Rebuttal Disclosures Due	November 10, 2018
Plaintiff's 15-day Rebuttal Period Ends	December 10, 2018
BRIEFS SHALL BE DUE AS FOLLOWS:	
Plaintiff's Main Brief Due	February 8, 2019
Defendant's Main Brief Due	March 10, 2019
Plaintiff's Reply Brief Due	March 25, 2019

In each instance, a copy of the transcript of any oral testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of taking of testimony. Trademark Rule 2.125. 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 2.129.