

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF OHIO
EASTERN DIVISION

The Ohio State University, :
 :
Plaintiff : Civil Action 2:12-cv-00662
 :
v. : Judge Frost
 :
Skreened, Ltd. and Daniel Fox, : Magistrate Judge Abel
 :
Defendants :

Discovery Dispute Conference Order

On October 15, 2013, counsel for the parties participated in a discovery dispute conference with the Magistrate Judge. During the conference, the following arguments and rulings on those arguments were made.

Defendant Skreened, Ltd's First Set of Interrogatories. Plaintiff The Ohio State University ("OSU") argued that it should not be required to answer these interrogatories because Skreened, Ltd. and Daniel Fox are one party for purposes of the 25 interrogatory limitation imposed by Rule 33(a)(1), Fed. R. Civ. P. In December 2012, defendant Fox served a set of 21 interrogatories. Although served by defendant Fox, these interrogatories and the answers to them by their terms applied to both defendants. Plaintiff characterizes these as 64 interrogatories, including discrete subparts. That characterization is not accurate. While there may be more than 21 interrogatories, including discrete subparts, most subparts just more particularly describe the information sought by that interrogatory and do not impose any additional burden on the answering party. For example, Interrogatory 13 asks: "Do you know of any instance when a person has been confused,

mistaken, or deceived as to the source of Defendants' goods or services? If so, for each instance state or identify" the date and place, goods or services involved, the way the person was confused, the means you received notice of the instance, the address and occupation of the person who gave notice of the instance, and any record or document of the instance.

I do agree that Fox and Skreened are one party. I recognize that OSU seeks to impose individual liability on Fox, but he is the president and 80% owner of Skreened. He was personally involved in the business. Both Fox and Skreened are alleged to have violated OSU's trademarks by the way Skreened, subject to Fox's direction and control, operated, its business. Under Rule 33(a)(1) they are one party.

Nonetheless, I agree with defendants that they are entitled to propound additional interrogatories. OSU did not identify its three common law marks—OSU, Go Bucks, and Brutus—until ordered to do so by Judge Frost's September 17, 2013 Order. On October 4, 2013, Skreened served 15 interrogatories. Given the number of marks at issue in this lawsuit and OSU's late identification of the three common law marks, I do not believe a total of 36 interrogatories is excessive or burdensome.

I will now discuss the October 4 interrogatories. Interrogatories 1-3 ask OSU to identify all licenses granted for the three common law marks from July 23, 2007. OSU's counsel stated during the October 15 conference that their client has produced in response to Judge Frost's September 17, 2013 Order everything in its current offices responsive to these interrogatories. OSU has several hundred licenses. OSU does not license specific

marks. A licensee can use any and all of OSU's marks, subject to OSU's prior approval of the licensee's design. The licenses are renewed annually. During the course of each annual contract, the licensee is required to submit to OSU for its prior approval the designs it intends to use. OSU keeps no records of those designs by trademarks used in them.

OSU searched its current files for all information requested regarding all of its marks—common law and registered—and produced those documents. The production included all licenses. After Judge Frost's Order, OSU produced examples of the licensed use of its three common law marks found in the search of its current files. Because the license contracts are for one year, most files are stored off-site in boxes. The boxes are not indexed. OSU represented that there is no non-burdensome way the stored boxes could be searched for additional information responsive to defendants' interrogatories and document requests. Accepting OSU's counsel's representations, I conclude that no further response to Interrogatories Nos. 1-3 is required.

Interrogatories Nos. 4-9 ask OSU to identify what actions it has taken from July 23, 2007 to the present to police its three common law marks. OSU's counsel represented that in response to defendants' December 2012 discovery requests their client provided a spreadsheet maintained by its trademark enforcement counsel identifying each person sent a cease and desist letter and indicating whether the infringing conduct ceased. The spreadsheet does not identify the allegedly infringing mark that was the subject of the cease and desist letter. The spreadsheet does include all marks, common law and registered, for which cease and desist letters were sent. Further, OSU's Rule 30(b)(6)

deponent, Mr. Cleveland, testified about OSU's enforcement practices. OSU both shops the marketplace and receives tips from licensees/competitors, then follows up with cease and desist letters. OSU's counsel represented that the above is their client's complete response to the information sought by Interrogatories Nos. 4-9. I accept that representation and conclude that no further response to the interrogatories is required.

Interrogatories Nos. 10-15 are contention interrogatories that have not previously been propounded. During the discovery conference, OSU's counsel communicated the facts responsive to these interrogatories. It would not be burdensome for OSU to respond to them. Consequently, OSU is ORDERED to answer Interrogatories 10-15 setting out the facts responsive to each.

s/Mark R. Abel
United States Magistrate Judge