TTAB Exhibits

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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THE COCA-COLA COMPANY, Opposer,	Opposition No. 116,244
v.	
WALBAUR GMBH, Applicant.	

05-30-2001
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #34

OPPOSER'S MOTION FOR AN ORDER
TO COMPEL DISCOVERY AND TO
EXTEND TESTIMONY DATES

Opposer, The Coca-Cola Company ("opposer"), respectfully moves the Hon. Trademark Trial and Appeal Board under Fed.R.Civ.P. 37(a) and 36(a) and Trademark Rule 2.120(e) and (h) for an order compelling applicant, Waldbaur GmbH ("applicant"), to provide complete responses to Opposer's First Set of Interrogatories to Applicant, Opposer's First Request to Applicant for Production of Documents and Things and Opposer's First Requests for Admission (collectively "opposer's Discovery Requests").

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner of Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 on the date which appears below:

Lena Cassano
Name

May 25, 2001
Date of the Signature and Deposit

The grounds for this motion are that applicant has failed both to timely and adequately respond to opposer's Discovery Requests.

In addition, opposer respectfully requests that the Board reset the testimony periods to commence at least thirty (30) days from the date on which applicant's supplemental discovery responses are due. This extension is necessary to allow opposer sufficient time to review applicant's responses and to prepare its case in chief.

Respectfully submitted,

FISH & NEAVE

Dated: May 25, 2001

By: Susan Progoff

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

THE COCA-COLA COMPANY, Opposer, v. WALBAUR GMBH, Applicant.	Opposition No. 116,244

OPPOSER'S MEMORANDUM IN SUPPORT OF
ITS MOTION FOR AN ORDER TO COMPEL DISCOVERY
AND TO EXTEND THE TIME FOR TAKING TESTIMONY

I. INTRODUCTION

Opposer, The Coca-Cola Company ("Opposer"), respectfully moves the Hon. Trademark Trial and Appeal Board under Rules 36(a) and 37(a) of the Federal Rules of Civil Procedure and Trademark Rules 2.120(e) and (h) for an order compelling applicant, Waldbaur GmbH ("applicant"), to provide complete responses to Opposer's First Set of Interrogatories to Applicant, Opposer's First Request to Applicant for Production of Documents and Things and Opposer's First Requests for Admission (collectively "opposer's Discovery Requests"). Copies of these requests are attached to the accompanying Declaration of Susan Progoff as Exhibit 1, 2 and 3, respectively, and copies of applicant's responses are attached to that declaration as Exhibits 6, 7 and 8, respectively.

Applicant has failed to provide adequate responses to many of opposer's Discovery Requests. In response to opposer's comprehensive interrogatories, document requests and requests for admission, applicant produced only one product sample, and provided virtually no information on how applicant uses its mark or intends to use its mark. It did not produce a single document in response to opposer's document requests. Nor did it admit or deny opposer's requests for admissions.

These responses fall far short of what is required under the Federal of Civil Procedure and the Trademark Rules of Practice. Applicant raised no objections any of these requests. Accordingly applicant should be ordered to furnish opposer with complete and proper responses.

In view of the inadequacy of applicant's responses to opposer's discovery requests, opposer has been prejudiced in preparing this matter for trial. For this reason, opposer also requests the Board to reset the testimony periods to commence thirty days after applicant responds fully to opposer's discovery requests.

II. FACTS

This dispute involves applicant's right to register SCHO-KO-KOLA for chocolate, candy, cakes and pastries. Opposer brought this opposition on the grounds that SCHO-KA-KOLA is likely to cause confusion with and to dilute opposer's famous trademark COCA-COLA, which has long been used and registered for beverages and a wide range of other products.

Opposer's Discovery Requests were served on applicant on July 31, 2000. (Progoff Decl.* ¶ 2). Applicant's responses were originally due on September 4, 2000. Applicant obtained, with opposer's consent, three 60-day extensions of time to respond to opposer's Discovery Requests. As a result of these extensions, applicant's responses were due on March 3, 2001 (Progoff Decl. ¶ 3).

When applicant finally responded to opposer's Discovery Requests, more than a month after they were due, the responses were woefully inadequate. Applicant provided virtually no information concerning its use of the mark in issue or its intent to use the mark in the United States. It produced no documents responsive to any of opposer's document requests. And applicant avoided either admitting or denying any of opposer's requests for admission.

Opposer requested applicant to supplement its responses, but was told that applicant's counsel had not received instructions from his client, and therefore could not agree to supplement applicant's responses. (Progoff Decl. ¶¶ 8-9).

III. APPLICANT'S DISCOVERY REQUESTS

A. Applicant's Responses to Opposer's First Set of Interrogatories to Applicant are Insufficient

Applicant has failed to fully provide much of the information requested in Opposer's First Set of Interrogatories and has not had its answers signed under oath "by the person making them" as is required by Fed. R. Civ. P. 33. Applicant's unverified responses were signed by its U.S. attorney, who purportedly obtained the paltry information provided from applicant's German counsel. Opposer is entitled to have

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* "Progoff Decl. " refers to the Declaration of Susan Progoff dated May 25, 2001 and submitted in support of this motion.

applicant's responses signed under oath by an officer or agent having the authority to bind applicant. Fed. R. Civ. P. 33(b).

The specific requests at issue are the following:

1. Interrogatory 1(b)(ii)

For each product or service the identification of which is requested in Interrogatory 1(a) identify applicant's first use and first use in commerce, as that term is defined in 15 U.S.C.§ 1127, of the designation SCHO-KA-KOLA for the product or service.

Response

First use in the world occurred prior to March 22, 1951.

Applicant did not fully answer the question, which requested applicant's first use of SCHO-KA-KOLA in commerce. Opposer is entitled to obtain this information.

2. Interrogatory 1(b) (iii)

For each product or service the identification of which is requested in answer to Interrogatory 1(a), identify the purchasers thereof.

Response

Chocolate lovers.

Opposer is entitled to obtain the identification of the first purchasers of applicant's product in issue. If this information is unavailable, applicant should be required to so state. "Chocolate lovers," the answer applicant provided, is a meaningless response that deliberately avoids providing opposer with any useful information.

3. Interrogatory 1(c)

For each product or service the identification of which is requested in answer to Interrogatory 1(a), identify any periods of time since applicant's first sale or offering thereof during which applicant did not advertise, offer, sell, provide or distribute the product or service under the designation SCHO-KA-KOLA.

Response

Continuous offer, sell, provide or distribute. No advertising for some time.

Applicant's answer does not fully respond to the question. If applicant discontinued advertising the product in issue for some period of time, opposer is entitled to know the dates.

4. Interrogatory 3

Identify the class or classes of purchasers for each product or service whose identification is requested in answer to Interrogatory 1(a).

Response

Chocolate lovers.

As with applicant's response to Interrogatory 1(b)(ii), this response provides opposer with no meaningful information. Applicant should be required to specify whether its product is targeted to consumers or the trade; men, women, or both; adults or children, and the like.

5. Interrogatory 6

Identify each person who participated in the creation or design of any advertisement or promotional material used or intended for use in connection with each product or service identified in response to Interrogatory 1(a).

Response

Unknown to the American Attorney.

If applicant's U.S. attorney does not have sufficient information to respond to opposer's interrogatory, applicant has an obligation to conduct a reasonable investigation to obtain the requested information. Bison Corporation v. Pefecta Chemie BV., 4 USPQ2d 1718, 1720 (T.T.A.B. 1987); Colts Towne Trails, Inc. v. Marriott

Corporation, 1993 U.S. Dist. LEXIS 6549, *10-*11 (E.D.Pa. 1993) ("Where an answering party does not have personal knowledge based upon which to answer an interrogatory, that party nonetheless has a duty under Fed. R. Civ. P. 36 to 'make reasonable inquiry and secure such knowledge and information as is readily obtainable by him.'"). Applicant should be ordered to furnish opposer with the requested information.

6. Interrogatories 7, 9, 10, 11, 13, 14, 15, 16 and 20

Interrogatory 7

Identify each person who participated in the selection or adoption of the designation SCHO-KA-KOLA.

Response

No such person known.

Interrogatory 9

If the form in which applicant has displayed the designation SCHO-KA-KOLA has changed since applicant's adoption thereof, describe each such change, identify the person or persons responsible for each such change and set forth the date on which each such change occurred.

Response

No change known.

Interrogatory 10

If applicant has acquired any rights in or to the designation SCHO-KA-KOLA from any predecessor in interest, identify each such predecessor in interest, the date of each such acquisition and the rights acquired.

Response

No predecessor known.

Interrogatory 11

If applicant, or any person or persons acting for or on its behalf, has conducted any investigation, search, survey or poll which refers or relates in any way to applicant's use of the designation SCHO-KA-KOLA or opposer's use of its trademark COCA-COLA, identify the person or persons who conducted each such investigation, search, survey or poll, and the date or dates on which it was conducted.

Response

No searcher known.

Interrogatory 13

Identify all persons not employed by applicant or acting on applicant's behalf who have communicated with applicant concerning opposer and state the substance and date of each such communication.

Response

No such person known.

Interrogatory 14

Identify each advertising, public relations and market research agency retained by applicant that is or was responsible for any of applicant's products or services sold or offered or intended to be sold or offered under the designation SCHO-KA-KOLA.

Response

No advertising, public relations and market research agency known.

Interrogatory 15

Identify each legal or administrative proceeding to which applicant has been a party, other than the present opposition, which pertained in any way to applicant's use, intended use, registration, attempted registration or claimed rights in the designation SCHO-KA-KOLA.

Response

Any legal or administrative proceeding is unknown except for point 3a of the Opposition Filing in the instant case and the registration of SCHO-KA-KOLA in Germany.

Interrogatory 16

If applicant has ever protested or objected to any person's use or registration of a designation which applicant claimed was confusingly similar to the designation SCHO-KA-KOLA, identify each person to whom such a protest or objection was directed, and the exact designation and goods and/or services for which the objected to mark was being used, registered or was attempted to be registered.

Response

No protest or objection to any person's use or registration of a designation which applicant claimed was confusingly similar to the designation SCHO-KA-KOLA is known.

Interrogatory 20

Identify the witnesses applicant intends to call to testify on its behalf in connection with this proceeding and state the facts or subject matter concerning which each witness is expected to testify.

Response

No known at this time.

Applicant's response to all of these questions was that this information is not known. Applicant has an obligation to undertake a reasonable investigation of records in its possession to determine the relevant facts. See Bison Corporation, supra, 4 USPQ2d at 1720; Colts Towne Trails, supra, 1993 U.S. Dist. LEXIS 6549 at *10-*11. The facts requested by these interrogatories, such as whether an investigation has been conducted concerning the parties to this proceeding or their respective trademarks or products, whether applicant has had any communications with third parties concerning opposer, the identity of any advertising or market research agencies applicant has retained, and whether applicant has ever objected to a third party's use of a mark it claims is likely to cause confusion with the mark it seeks to register here, are facts that should be readily available to applicant after a reasonable investigation. Accordingly, applicant should be

ordered to furnish the information requested by Interrogatories 7, 9, 10, 11, 13, 14, 15, 16 and 20.

7. Interrogatory 21

Identify each person who supplied information used in responding to any of the foregoing interrogatories and identify the interrogatory or interrogatories with respect to which each such person supplied information.

Response

Information was supplied by Rechtsanwalt Stephan Hucke.

Applicant has not completely identified Mr. Hucke, and should be required to do so. Opposer believes Mr. Hucke to be applicant's counsel in Germany. It is improper to identify only the German attorney who relayed information to applicant's counsel in the United States. Opposer is entitled to the identity of the persons having personal knowledge of the facts, or who had access to applicant's records from which such information can be obtained.

B. Applicant's Responses to Opposer's First Request to Applicant for Production of Documents and Things are Insufficient

Applicant's responses to opposer's requests for production of documents and things are woefully inadequate and fall far short of what is required under the Federal Rules of Civil Procedure or the Trademark Rules of Practice. Applicant has failed to produce even a single document in response to opposer's requests. The only thing that applicant has produced is a few samples of one of its products. Under the circumstances, applicant should be ordered to respond fully to opposer's document requests.

The specific requests in issue are as follows:

1. Request 1

A sample of each package, sign, label and other piece of printed material upon which applicant has used the designation SCHO-KA-KOLA.

Response

A sample of the product of the applicant has been sent by Priority Mail to the Opposer's Attorney on or about March 30, 2001.

Although applicant has produced a sample of its product, it has not responded to the remainder of this request. These items are relevant to show the manner in which applicant's mark is used.

2. Request 4

Documents sufficient to identify the classes of potential purchasers and users for each product or service applicant has offered or sold under the designation SCHO-KA-KOLA.

Response

Potential purchasers and users remain undetermined.

Applicant claims to have been using its mark for more than 50 years. It is inconceivable that it does not know the classes of potential purchasers and users of its product. This information is highly relevant to the issue of likelihood of confusion. Opposer, therefore, requests that applicant be ordered to search its files and produce all documents called for by this request.

3. Request 5

Documents sufficient to show the channels of distribution through which each of applicant's products or services bearing the designation SCHO-KA-KOLA is or has been offered or sold.

Response

No such documents are known at this time for the United States.

Applicant seeks to hide behind its status as a foreign company to avoid providing discovery. Yet, at the same time, applicant relies upon its overseas activities to support its claim that its use of SCHO-KA-KOLA allegedly is not likely to cause confusion with opposer's trademark COCA-COLA (see response to Document Request 24). If this is applicant's position, the manner in which its product is marketed and sold overseas is relevant to this proceeding. In addition, because applicant has not used its mark in the United States, the trade channels through which it has sold its product in other countries may reveal the trade channels it plans to use in the United States, which is one of the factors the Board must consider in determining whether a likelihood of confusion exists. Thus, this request is reasonably calculated to lead to the discovery of admissible evidence, and applicant should be required to furnish opposer with a complete response.

4. Requests 15 and 16

Request 15

All documents which refer or relate to applicant's decision to adopt the designation SCHO-KA-KOLA.

Request 16

All documents that applicant, or any person acting for or on applicant's behalf, reviewed or considered in connection with applicant's decision to adopt the designation SCHO-KA-KOLA.

Response

The decision was made more than 50 years ago and was not made in the United States.

The fact that applicant may have selected SCHO-KA-KOLA some time ago and made its decision to adopt this mark outside the United States does not mean that these events are irrelevant to this proceeding. These requests seek documents relevant to

applicant's intent in selecting its mark, and its knowledge of other marks when it selected SCHO-KA-KOLA. These matters are relevant to the issue of likelihood of confusion, and should be produced.

5. Request 23

All documents which refer or relate to opposer, opposer's trademark COCA-COLA or any of opposer's products offered or sold under its trademark COCA-COLA.

Response

The applicant has not been concerned about the different trademark of the opposer.

Applicant's answer does not respond to this request. The fact that applicant may have been "not concerned" about opposer does not mean that it has no documents that refer or relate to opposer, its trademark or products. At a minimum, these documents are relevant to applicant's intent in selecting its mark and in seeking to protect its mark in the United States. They also relate to the likelihood of confusion caused by applicant's selection of a mark that sounds like opposer's well-known trademark COCA-COLA. Accordingly, applicant should be required to produce all documents called for by this request.

6. Request 26

All documents which refer or relate to any contested proceedings which involved or pertained to applicant's use, registration, attempted registration or claimed rights in the designation SCHO-KA-KOLA.

Response

There have been no contested proceedings in the United States except for the present one.

The fact that there may be no contested proceedings involving SCHO-KA-KOLA other than this opposition is not the end of the inquiry. This request also calls for documents which discuss the present opposition, including any internal documents in which applicant's employees or agents discussed this dispute. These documents are relevant and should be produced.

7. Request 27

All documents which refer or relate to or which show any statement by any person regarding any issue in this proceeding.

Response

There are no such public documents in the United States.

As with Request 26, this request encompasses internal or other non-public documents in addition to public documents. Applicant is under an obligation to search its files and to produce all documents called for by this request.

8. Request 40

All documents referred to or relied on in preparing applicant's response to "Opposer's First Set of Interrogatories To Applicant".

Response

Such documents have been referred to.

It is unclear what applicant means by this response. If applicant has relied on documents in responding to opposer's interrogatories, those documents, and any additional documents on which applicant relies in supplementing its interrogatory answers,

should be produced. If, on the other hand, applicant did not refer to any documents in preparing its interrogatory answers, applicant should be required to so state.*

C. Applicant's Responses to Opposer's First Requests for Admission are Insufficient

Applicant's responses to opposer's Requests for Admission are insufficient under Rule 36(a), Fed. R. Civ. P. Accordingly, all of opposer's requests should be deemed admitted.

Applicant has neither admitted nor denied any of opposer's requests (Progoff Decl. Exh. 8). Instead, it substituted a non-responsive statement concerning unrelated matter in place of an admission or denial.

Rule 36(a) requires a party who denies a request for admission to specifically deny the matter or set forth detailed reasons why the party cannot admit or deny the matter. Applicant has done neither. Its responses plainly are insufficient under Rule 36. Accordingly, opposer requests that the matters set forth in opposer's requests for admission be deemed admitted.

IV. MOTION TO EXTEND TESTIMONY DATES

Opposer further moves that the testimony periods be reset to begin at least thirty (30) days after applicant furnishes opposer with complete discovery responses. To date, opposer has received virtually no discovery from applicant. Opposer is entitled to have applicant's responses for sufficient time to conduct a meaningful analysis of the relevant facts in preparing its case for trial.

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* In view of the specific first use date that applicant provided in response to Interrogatory 1(b)(ii), it is difficult to believe that applicant has not relied on any documents in responding to opposer's interrogatories.

V. CONCLUSION

For the foregoing reasons, opposer requests that applicant be ordered to respond fully to opposer's discovery requests, and that the testimony periods be rescheduled to commence at least thirty (30) days after applicant's responses are served.

Respectfully submitted,

FISH & NEAVE

Dated: May 25, 2001

By: Susan Progoff

Herbert F. Schwartz
Susan Progoff
Cori Anscher

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Attorneys for Opposer,
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

THE COCA-COLA COMPANY,	:	
Opposer,	:	Opposition No. 116,244
v.	:	
WALBAUR GMBH,	:	
Applicant.	:	

DECLARATION OF SUSAN PROGOFF

SUSAN PROGOFF declares as follows:

1. I am a member of the bar of the State of New York and a partner with the firm of Fish & Neave, attorneys for opposer, The Coca-Cola Company, in this opposition proceeding. I make this affidavit in support of opposer's motion for an order to compel responses to Opposer's First Set of Interrogatories to Applicant, Opposer's First Request to Applicant for Production of Documents and Things and Opposer's First Requests for Admission, and to extend the time for taking testimony in this proceeding.

2. Copies of Opposer's First Set of Interrogatories to Applicant, Opposer's First Request to Applicant for Production of Documents and Things and Opposer's First Requests for Admission (collectively "opposer's Discovery Requests"), all of which were served by first class mail on Horst M. Kasper, counsel for applicant, on July 31, 2000, are attached as Exhibits 1, 2 and 3, respectively.

3. After three 60-day extensions of time to respond to opposer's Discovery Requests, applicant's responses were due on March 3, 2001. However, applicant did not respond by that date.

4. On March 14, 2001, opposer sent applicant a letter requesting that it immediately provide its responses to opposer's Discovery Requests. A copy of that letter is attached as Exhibit 4.

5. Subsequent to March 14, 2001, opposer continued to communicate with applicant's attorney both orally and in writing to try to agree upon an acceptable date upon which applicant would provide its responses to opposer's Discovery Requests. However, applicant claimed to be unable to provide opposer with an answer as to when it would furnish its responses and asked opposer in a letter dated March 30, 2001 to "bear with" it for a further period of time. A copy of this letter is attached as Exhibit 5.

6. Opposer told applicant by telephone on March 30, 2001 that it believed applicant had defaulted and it would not agree to a further extension of time for applicant to provide its responses to Opposer's Discovery Requests.

7. Applicant served opposer with its responses on April 4, 2001, more than a month after they were due. Copies of applicant's responses to opposer's interrogatories, document requests and requests for admission are attached as Exhibits 6, 7 and 8, respectively.

8. In an attempt to avoid the necessity of filing a motion to compel discovery, on April 24, 2001 opposer sent applicant a letter requesting complete responses to opposer's Discovery Requests. A copy of opposer's April 24, 2001 letter to applicant

is attached as Exhibit 9. Applicant did not respond to this letter or supplement its discovery responses as requested.

9. On May 24, 2001, I called Horst Kasper, applicant's counsel, to confer as required under Trademark Rule 2.120(e) in good faith in an attempt to resolve this dispute. Mr. Kasper told me that he had forwarded our April 24 letter to his client, who was directing discovery, and had not yet received a response. He told me that because he had no instructions from his client, he could not consent to our request that applicant supplement its discovery responses. I told Mr. Kasper that, in view of his response, opposer would proceed with a motion to compel discovery.

I declare under penalty of perjury that the foregoing is true and correct.

Dated: May 25, 2001

Susan Progoff

Susan Progoff