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EXHIBITS

TTAB

Attorney Checket DX-3 (#90545)

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

In the Matter of:

Application Serial No. 75/701,707
Mark: Drawing of a Marine Heat Exchanger
Published in the Official Gazette at Page TM 400 on May 9, 2000

DURAMAX MARINE, LLC)
)
Opposer,)
)
v.)
)
R.W. FERNSTRUM & COMPANY,)
)
Applicant)

Opposition No. 119,899

02 JUL 11 AM 12:56
TRADEMARK TRIAL AND
APPEAL BOARD

**OPPOSER'S MOTION TO COMPEL APPLICANT TO ANSWER OPPOSER'S
FIRST SET OF INTERROGATORIES AND INITIAL REQUESTS FOR
PRODUCTION OF DOCUMENTS AND OPPOSER'S SECOND SET OF
INTERROGATORIES AND SECOND REQUEST FOR PRODUCTION OF
DOCUMENTS**

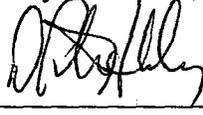
Box TTAB
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Opposer, hereby moves this Board pursuant to 37 C.F.R. 2.120(e)(1) for an order compelling Applicant, R.W. Fernstrum & Company, to respond to selected interrogatories and requests for the production of documents from (1) "Opposer's First Set of Interrogatories and Initial Requests for Production of Documents" served August 1, 2001 and attached herewith as Exhibit A, and (2) "Opposer's Second Set of Interrogatories and Second Request for Production of Documents" served August 31, 2001 and attached herewith as Exhibit B.

The accompanying memorandum supports this Motion.

Respectfully submitted,

Date: July 2, 2002

By: 
D. Peter Hochberg
Reg. No. 24,603
Counsel for Opposer

Att. Exhibits A & B

D. PETER HOCHBERG
The Baker Building – 6th Floor
1940 East Sixth Street
Cleveland, Ohio 44114
(216) 771-3800

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing "OPPOSER'S MOTION TO COMPEL APPLICANT TO ANSWER OPPOSER'S FIRST SET OF INTERROGATORIES AND INITIAL REQUESTS FOR PRODUCTION OF DOCUMENTS AND OPPOSER'S SECOND SET OF INTERROGATORIES AND SECOND REQUEST FOR PRODUCTION OF DOCUMENTS" was served via first class, postage prepaid, U.S. mail upon:

Samuel D. Littlepage, Esq.
Dickinson Wright PLLC
1901 "L" Street, N.W., Suite 800
Washington, D.C. 20036-3541

ATTORNEYS FOR APPLICANT

Date: July 3, 2002

By: 
Sean F. Mellino

CERTIFICATE OF MAILING

I hereby certify that this document is being deposited with the United States Postal Service as First Class mail in an envelope addressed: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA, 22202-3513, on the date noted below:

Date: July 3, 2002


Sean Mellino

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

In the Matter of:

Application Serial No. 75/701,707
Mark: Drawing of a Marine Heat Exchanger
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| | | |
|---------------------------|---|------------------------|
| DURAMAX MARINE, LLC |) | |
| |) | |
| Opposer, |) | |
| |) | |
| v. |) | Opposition No. 119,899 |
| |) | |
| R.W. FERNSTRUM & COMPANY, |) | |
| |) | |
| Applicant |) | |

**OPPOSER'S MEMORANDUM IN SUPPORT OF ITS MOTION TO COMPEL
APPLICANT TO ANSWER OPPOSER'S FIRST SET OF INTERROGATORIES
AND INITIAL REQUESTS FOR PRODUCTION OF DOCUMENTS AND
OPPOSER'S SECOND SET OF INTERROGATORIES AND SECOND REQUEST
FOR PRODUCTION OF DOCUMENTS**

Box TTAB
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Sir:

The Rule 33 and Rule 34 documents regarding the first and second sets of interrogatories and requests for production of documents to parties were served on the attorney representing Applicant on August 1, 2001 and August 31, 2001 respectively. The Applicant's attorney sent a Response to Opposer's First Set of Interrogatories and Initial Requests for the Production of Documents dated September 4, 2001, a Response to Opposer's Second Set of Interrogatories dated October 3, 2001 and a Response to

Opposer's Second Request for the Production of Documents having answered selected interrogatories and requests and refusing to answer the remaining interrogatories and requests, also dated October 3, 2001. These are each attached as Exhibits C, D and E respectively to this "Opposer's "Memorandum in Support of Its Motion to Compel Applicant to Answer Opposer's First Set of Interrogatories and Initial Request for the Production of Documents and Opposer's Second Set of Interrogatories and Second Request for the Production of Documents" under Rule 2.120(e)(1)). The Applicant sent the first response to Opposer's attorney dated September 4, 2001, having answered interrogatory Nos. 1-4, 8, 11(b)-(e), 12-14, 16-17, 19-23 and 25-32 but objecting to interrogatory Nos. 5-7, 9-10, 11(a), 15, 18 and 24. The Applicant first objected to Nos. 5-7, 9-10, 18 and 24 as seeking confidential information. The objections to each of Nos. 5-7, 9-10, 11(a), 15, 18 and 24 further alleged that the respective interrogatories sought answers to purported facts that are not relevant to any issue in the Opposition or that the interrogatory is unduly vague and ambiguous.

The Applicant improperly objected to request Nos. 5, 10-12, 13 (b) and (c) and 14-15. The objections to these requests alleged that the requests are vague and ambiguous and fail to describe the documents with "reasonable particularity."

The "Response to Opposer's Second Set of Interrogatories" (Exhibit D) answered interrogatory Nos. 33 and 42 and objected to interrogatory Nos. 34-41, alleging that each of interrogatory Nos. 34-41 is vague and ambiguous, is not relevant to any issue in this proceeding and therefore not calculated to lead to the discovery of relevant evidence, overly-broad and burdensome and "particularly egregious."

The “Applicant’s Response to Opposer’s Second Set of Requests for the Production of Documents” (Exhibit E) had a response to request Nos. 16 and 26-34, but objected to request Nos. 17-25 and 35-36. The latter requests were stated as being unduly vague and ambiguous, overly broad and unduly burdensome, seeking confidential information and seeking information neither relevant to the issues in this proceeding nor likely to lead to the discovery of admissible evidence.

As stated in FRCP 26(b)(1), parties may obtain discovery *regarding any matter*, not privileged, which is relevant to the subject matter involved in the pending action whether it relates to the claim or defense of the party seeking discovery or to the claim or defense of any other party...*including the...location of persons having knowledge of any discoverable matter* (Emphasis added). The rule further states that the information sought need not be admissible at trial if the information sought appears reasonably calculated to lead to the discovery of admissible evidence.

Interrogatory No. 5 asks for the identification and description of goods and/or services which are planned to be promoted, sold, etc. by Applicant in connection with the drawing in Serial No. 75/701,707 (the “Keel Cooler Drawing”). Opposer of course knew that Applicant had already used the drawing, but needed further identity of the goods and services in an effort to determine if the Keel Cooler Drawing is functional and/or merely descriptive. Applicant alleges that the information sought in the interrogatory Nos. 5-7, 9-10 and 18 relate to purported facts not relevant to any issue in this Opposition and are not calculated to lead to the discovery of any admissible evidence at trial in this proceeding. Moreover, in each respective Answer provided by the Applicant, it is stated that Application Serial No. 75/701,707 is a “use based” application rather than an “intent

to use” application and that Applicant fails to understand how its future business plans are of any potential relevance in this proceeding. The information Opposer seeks in the these interrogatories that are at issue each relate to elements of establishing descriptiveness and functionality of the goods that are the subject of the mark of Application Serial No. 75/701,707. Applicant has gone out of its way not to answer Interrogatory No. 5 and Interrogatory Nos. 6-7 and 9-10, which refer to Interrogatory No. 5, for the foregoing reasons.

Opposer seeks to establish that the goods that are the subject of the mark in Application Serial No. 75/701,707 are functional, and that the mark itself is merely descriptive of the goods to which it relates. Opposer fears that the mark of Application Serial No. 75/701,707 depicts a functional and actual photograph (or an accurate drawing) of its keel cooler, and if used in conjunction with the sale of said keel cooler, will potentially prevent Opposer from being able to sufficiently advertise and promote the sale of its own keel cooler (sold under the trademark “DURACOOILER”). Opposer believes that Applicant is using the drawing of Application Serial No. 75/701,707 in its designing, manufacturing and quality control efforts, and is functional in this respect as well. For these reasons it is necessary for Applicant to identify and describe, and Opposer to be able to inspect if necessary, any and all goods and/or services which have been or are even planned to be promoted, sold, distributed or otherwise provided by Applicant, or any licensee of Applicant, in connection with the mark of the Keel Cooler Drawing, as well as the particular channels of distribution, and how extensive, both economically and geographically, the sale of any and all goods will be which will be advertised, distributed or promoted in connection with the picture depicted in Application

Serial No. 75/701,707. Applicant's goods are not trade secrets since they have been disclosed to and bought by many customers and potential customers. They are not new products, other than with regard to size and known configurations. In this respect, customers inform Applicant of the dimensions of the hull of the vessel where the keel cooler is to be placed and of the type of engine in the vessel, and Applicant designs its keel cooler with these factors taken into consideration – they are not really different models as Applicant has alleged. The information requested is easy for Applicant to divulge, but Applicant has nevertheless refused to do so for groundless reasons.

Interrogatory No. 15 asks if the Keel Cooler Drawing is a realistic drawing of a marine heat exchanger, and Interrogatory No. 24 asks the reason for Applicant's Answer to No. 4. (Ground No. 4 in the Notice said that Applicant was making and selling heat exchangers like those shown in Serial No. 75/701,707. Applicant has refused to provide a response to interrogatory No. 24 on the basis that Applicant does not understand what is meant by the term "like" as used in paragraph 4 of the "Notice of Opposition"). As anyone speaking English understands, the term "like" is intended to include at least "identical to," "similar to," and "resembling." As this term is explained, Opposer requests that Applicant be compelled to prepare a response to this inquiry.

Applicant has also refused to provide a complete response to Interrogatory No. 11(a) on the basis that the requests are unduly broad and burdensome. No. 11(a) asked for an identification and sample of each form of usage of the mark. Without waiving the objection, Applicant provided eighty four (84) representative specimens showing actual use of the mark in Application Serial No. 75/701,707. It is Opposer's belief that this is an incomplete response in that Opposer seeks to establish that the goods that are the subject

of the mark in Application Serial No. 75/701,707 are functional, and that the mark itself is merely descriptive of the goods to which it relates. It is vital that Opposer be able to review and inspect each type of the mark that Applicant has used that is the subject of Application Serial No. 75/701,707, rather than mere "representative specimens", which Applicant has admittedly provided. Applicant could very well have provided specimens which support its position, rather than truly representative specimens showing exactly how Applicant is using the mark of Serial No. 75/701,707. Applicant should answer Interrogatory No. 11(a) as asked.

Turning now to the "Initial Request for the Production of Documents", Applicant has objected to request Nos. 1, 5, 10, 11 and 14-15 as being vague and ambiguous, failing to describe the documents sought with reasonable particularity, for not understanding certain terms employed by Opposer, for being overbroad and being unduly burdensome for requesting documents over at least the past three decades. Document Request Nos. 1, 5, 10, 11 and 14-15 request documents identified in Interrogatory Nos. 1-32, used by persons other than the Applicant of the Keel Cooler Drawing, documents relating to users of the goods or services of Applicant in conjunction with the Keel Cooler Drawing, documents relating to the Keel Cool Drawing; documents identified or requested in Applicant's response to Interrogatory Nos. 1-30, and documents upon which Applicant intend to submit or rely on in this opposition proceeding.

As stated earlier, Opposer seeks to establish that the goods that are the subject of the mark in Application Serial No. 75/701,707 are functional, and that the mark itself is merely descriptive of the goods to which it relates. In order to do so, it is necessary to inspect and review each and every instance that Applicant has used the mark that is the

subject of Application Serial No. 75/701,707. Opposer contends that it so happens that Applicant has been using such advertising in relation to the Keel Cooler Drawing for at least the past three decades, and as long as the past fifty years. Any burden that Applicant claims it will be subject to by having to review and produce documents, as Opposer has requested, spanning this time period is not a result of Opposer's failing to describe or specify documents requested with specificity or with reasonable particularity, but rather is a direct result of Applicant's failure to apply for the trademark which is the subject of the mark in Application Serial No. 75/701,707 in a timely manner, such as when it was first used in advertising and promotion of the Keel Cool at least three decades ago.

In addition, Applicant states that it is unsure as to the meaning of the terms " 'documents relating' not only to other parties' use of the mark," " 'portions' of such other marks" in request No. 5, " 'documents relating or referring to the users' of goods provided by Applicant" in request No. 10 and " 'document[s] relating or referring to the use' of the Keel Cooler Drawing". Opposer contends that such objections are thinly disguised attempts by Applicant to avoid providing potentially crucial documents that may facilitate the advancement of this opposition. These terms which Applicant claims to not understand are clearly understood on their face and as they read in each respective interrogatory. As these terms are clearly understandable, Opposer respectfully requests that Applicant prepare a response to each of these requests.

Applicant states in its response to request No. 1 that it has produced copies of the documents that it identified in its responses to Opposer's interrogatories. Opposer states that Applicant, as stated above, merely provided "representative specimens" rather than a

complete collection of the relevant documents. As such, Opposer respectfully requests that Applicant be compelled to provide each and every document employing the mark that is the subject of Application Serial No. 07/701,707, rather than simple representative specimens.

Regarding request Nos. 12 and 13 (b) and (c), Applicant again objects on the basis that Opposer is attempting to obtain information that is neither relevant to the issues of the proceeding nor likely to lead to the discovery of admissible evidence and that Applicant fails to understand how its future business plans are of potential relevancy in this proceeding. Opposer refers to the reasons as stated above to explain the relevance of Applicant's future advertising, promotion and sales plans and how they relate to the present proceedings.

Turning next to the "Response to Opposer's Second Set of Interrogatories" (Exhibit D), Applicant has objected to interrogatory Nos. 34-41 also on the basis that they are vague and ambiguous, seek information that is allegedly not relevant to the present proceedings and seek information spanning the past fifty (50) years. Interrogatory No. 34 asks for methods for making Applicant's one-piece keel cooler, No. 35 asks for the persons responsible for the methods, No. 36 asks for the designs used in making the relevant keel coolers, No. 37 asks for the persons responsible for the designs, No. 38 relates to business strategies used for making the one-piece keel cooler, No. 39 is directed to the persons responsible for making business planning strategies, No. 40 seeks advertising strategies relating to a comparison of the party's one-piece keel cooler and No. 41 asks for the identity of the persons responsible for the advertising strategies. Each of these interrogatories are directed to uncovering evidence of the functional and/or

merely descriptive use of the Applicant's Keel Cooler Drawing, and to identify persons who may be deposed during this proceeding. Applicant may use the Keel Cooler Drawing in the process of making its one-piece keel cooler. The Keel Cooler Drawing may be identical with or closely similar to the designs of Applicant's Keel Cool Drawing. Applicant may use its Keel Cooler Drawing in its advertising as a picture of its product, and thus be functional and/or merely descriptive. Opposer is not seeking proprietary information from Applicant, but does need the information sought to find supporting evidence for its contention that the drawing used by Applicant in Serial No. 75/701,717 is functional and/or merely descriptive. Opposer has stated at various times in this opposition proceeding and in other inter partes proceedings with Applicant that Applicant's statements about its confidential information are in fact illusory – Opposer unequivocally states that it has no interest in Applicant's manufacturing processes, designs, advertisements or business operations – all Opposer wants is a showing of how Applicant uses the Keel Cooler Drawing.

Opposer reiterates that it seeks to establish that the goods that are the subject of the mark in Application Serial No. 75/701,707 are functional, and that the mark itself is merely descriptive of the goods to which it relates. In order to do so, it is necessary to inspect and review each and every instance that Applicant has used the mark that is the subject of Application Serial No. 75/701,707. Opposer contends that it so happens that Applicant has been using such advertising in relation to the Keel Cooler Drawing for at least the past three decades, and as long as the past fifty years. Any burden that Applicant claims it will be subject to by producing documents as Opposer has requested spanning this time period is not a result of Opposer's failing to describe or specify

documents requested with specificity or with reasonable particularity, but rather is a direct result of Applicant's failure to apply for the trademark which is the subject of the mark in Application Serial No. 75/701,707 in a timely manner, such as when it was first used in advertising and promotion of the Keel Cool fifty years ago. Therefore, Opposer respectfully urges that Applicant be compelled to respond to each of these aforementioned interrogatories.

Applicant has lastly objected to the request for the production of documents Nos. 17-25 and 35-36 as being allegedly overly burdensome in seeking information spanning the past fifty (50) years, seeking information that is allegedly not relevant and not likely to lead to the discovery of relevant evidence and as being vague and ambiguous. These document requests, all relating to one-piece keel coolers, asked for advertising and promotional material, documents describing the manufacturing process, design and construction documents, documents directed to problems that may be encountered by Applicant relating to its advertising and promoting the one-piece keel cooler if the Opposer also advertises and promotes its one-piece keel cooler, documents explaining why the respective party's products are better or worse than the other party's products, documents evidencing sales of the one-piece keel cooler, Applicant's memoranda relating to Applicant's mark and pictures of Opposer's one piece keel cooler which Applicant believes Opposer would not be prohibited from showing if Applicant gets a registration from Serial No. 75/701,707. Opposer again repeats the statements from above referring the any requests being over burdensome for spanning a significant amount of time, i.e. fifty (50) years. Such requests are, if at all, overly burdensome to Applicant merely because of Applicant's failure to secure trademark protection for the aforementioned

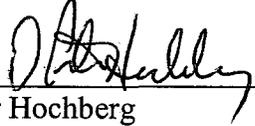
mark in a timely manner. Documents that may be relevant to the instant proceedings may date back nearly fifty (50) years, but they must nevertheless be produced as requested. In addition, Opposer points out that Applicant has supplied documents to Opposer for purposes of other requests for the production of documents. However, Opposer fears that these documents are not inclusive and do not include each and every instance where a document may be applicable, as Applicant has not provided documents from the entire range of documents spanning the past fifty (50) years. Opposer fears that such omitted documents may potentially be crucial to demonstrating the functionality of the Keel Cooler depicted in the drawing of the mark of Applicant Serial No. 75/701,707 or the mere descriptiveness thereof.

The information sought and documents requested are additionally important with respect to the depositions Opposer plans on taking during the summer of 2002. They will be used at the depositions to ask the witness to testify about the information and documents, and to provide additional admissible evidence.

The undersigned has made a good faith effort, by telephone and email correspondences, to resolve with the attorney for the Applicant the issues presented in this motion and has been unable to reach agreement. It is, therefore, respectfully requested that the present Motion to Compel be granted.

Respectfully submitted,

Date: July 2, 2002

By: 
D. Peter Hochberg
Reg. No. 24,603
Counsel for Opposer

Att. Exhibits C – E
D. PETER HOCHBERG
The Baker Building – 6th Floor
1940 East Sixth Street
Cleveland, Ohio 44114
(216) 771-3800

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing "OPPOSER'S MEMORANDUM IN SUPPORT OF ITS MOTION TO COMPEL APPLICANT TO ANSWER OPPOSER'S FIFTH SET OF REQUESTS FOR ADMISSIONS" was served via first class, postage prepaid, U.S. mail upon:

Samuel D. Littlepage, Esq.
Dickinson Wright PLLC
1901 "L" Street, N.W., Suite 800
Washington, D.C. 20036-3541

ATTORNEYS FOR APPLICANT

Date: July 3, 2002

By: 
Sean F. Mellino

CERTIFICATE OF MAILING

I hereby certify that this document is being deposited with the United States Postal Service as First Class mail in an envelope addressed: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA, 22202-3513, on the date noted below:

Date: July 3, 2002


Sean Mellino