

Fernstrum's witnesses. See, Opposer's Memorandum in support of its **first** motion to compel discovery, at page 3.

2. This proceeding was suspended by Order of the Board on November 29, 2001. That Order, which was entered in response to Opposer's above-noted initial Motion To Compel Discovery (dated November 9, 2001) expressly stated:

"Proceedings herein are suspended pending disposition of the motion to compel, except as discussed below. The parties should not file any paper which is not germane to the motion to compel."

3. On December 7, 2001, Opposer filed its **second** discovery motion. See, Opposer's Motion To Compel Applicant To Answer Opposer's Third And Fourth Sets Of Interrogatories.

4. On January 8, 2002, the Board held a telephone conference with the parties to determine whether it should modify the November 29, 2001 suspension order. During that telephone conference, Opposer's counsel stated that there was a discovery issue related to the first motion to compel discovery for which he had prepared another motion to compel. Under the circumstances, counsel for Fernstrum indicated that he would not object to that motion on the basis of timeliness. In its January 8, 2002 Order, the Board again stated that proceedings remained suspended pursuant to the November 29, 2001 Order and that the parties should inform the Board when all the discovery motions have been fully briefed and ready for decision.

5. On January 8, 2002, Opposer filed a **third** discovery motion. See, Opposer's Motion To Compel Applicant To Answer Opposer's Fifth Set Of Request For Admissions (Opposer arguing that the answers to the Request For Admissions would

establish that Paul Fernstrum is a resident of Michigan and, therefore, could be deposed in Michigan).

6. On July 3, 2002, Opposer filed its **fourth** discovery motion. See, 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 Set Request For Production Of Documents. By way of this latest motion, Opposer asserts that the information sought and documents requested will be used at the depositions of Fernstrum's witnesses.

The Board is requested to take note that Fernstrum had served its responses to Opposer's First Set Of Interrogatories And Document Requests on August 28, 2001 and its responses to Opposer's Second Set Of Interrogatories And Document Requests on October 3, 2001. The last correspondence between the parties concerning the issues now raised in this motion was Opposer's letter dated November 2, 2001 (seven days **prior** to its **initial** motion to compel discovery). In other words, all issues raised in Opposer's four different motions to compel discovery were discussed by, and known to, Opposer **before** it filed its first discovery motion on November 9, 2001 and **before** the Board suspended these proceedings on November 29, 2001.

II. ARGUMENT

Opposer's latest motion (filed **seven** months after the initial suspension order and **six** months after the Board's telephone conference with the parties) is directly contrary to the Board's express admonition against the filing of "any paper" that was not

germane to the motion to compel already then under review by the Board.¹ Indeed, the **repeated** filing of subsequent motions to compel discovery **after** the Board's November 29, 2001 suspension order can only be interpreted as an effort on the part of Opposer to misuse the opposition process in order to harass Fernstrum and vexatiously increase the litigation costs of that company.

"Vexatious" means "without reasonable or probable cause or excuse." Black's Law Dictionary, p. 1565 (6th ed. 1990). In discussing "vexatious" behavior in relation to 28 U.S.C. §1927, it has been observed that:

Behavior is "vexatious" when it is harassing or annoying, regardless of whether it is intended to be so. Thus, if an attorney's conduct in multiplying proceedings is unreasonable and harassing or annoying, sanctions may be imposed under section 1927. The attorney need not intend to harass or annoy by his conduct nor be guilty of conscious impropriety to be sanctioned. It is enough that that an attorney acts in disregard of whether his conduct constitutes harassment or vexation, **thus displaying a "serious and studied disregard for the orderly process of justice"**. (Emphasis added).

Cruz v. Savage, 896 F.2d 626, 632 (1st Cir. 1990). Opposer has displayed a serious and studied disregard for the orderly judicial process in this proceeding by filing a series of discovery motions over the past seven months **after** the proceedings had been suspended.

¹ While it is true that Applicant filed Motion To Compel Discovery shortly after the suspension order, that motion was directed at whether the suspension order itself "stayed" Opposer's duty to respond to previously-served discovery requests. The Board, in its order of January 8, 2002 held that such a "stay" was required by the suspension order of November 29, 2001.

All of the outstanding discovery issues in this proceeding could have -- and should have -- been the subject of one motion to compel, rather than a series of motions filed sequentially every few months. Opposer filed its **initial** motion on November 9, 2001, its **second** motion on December 7, 2001, and its **third** motion on January 8, 2002. Now, seven months after filing its initial motion, Opposer filed yet another motion to compel discovery (the **fourth** motion), arguing again that the information sought was necessary for its planned depositions (which were the subject of Opposer's **first** motion). It is noteworthy that the last correspondence between Opposer and Fernstrum concerning **all** of Opposer's discovery requests was November 2, 2001 -- one week before Opposer filed its initial motion to compel discovery.

Opposer has proffered **no** reason why Fernstrum's responses to the first and second set of interrogatories and document requests (purportedly necessary for the planned depositions) were not included in its initial motion to compel discovery or the subject of a separate motion filed at the same time. Moreover, Opposer has proffered **no** reason why it waited seven month after filling its initial motion to file its fourth motion to compel discovery. Opposer's conduct in waiting seven months to file this motion to compel discovery is "vexatious" because there is no reasonable or probable cause or excuse for the delay and it has multiplied these proceedings in an unreasonable, inexcusable manner.

Moreover, Fernstrum is clearly being prejudiced by Opposer's oppressive conduct in this proceeding, to wit:

1. The proceeding is being unreasonably delayed;
2. Fernstrum is incurring additional costs by having to respond to Opposer's motions *seriatim*; and,
3. Fernstrum's trademark is not being registered.

III. CONCLUSION

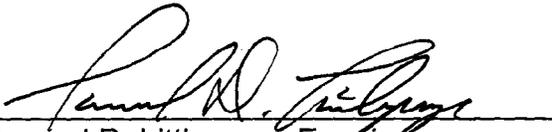
Opposer filed its first motion to compel discovery to obtain access to Fernstrum's manufacturing facility and unfettered access to Fernstrum business and manufacturing documents (allegedly to prepare for depositions). At the time Opposer filed its first motion, it was presumably aware that it allegedly needed further responses to its first and second set of interrogatories and document requests to prepare for those depositions. Rather than file a comprehensive motion to compel, Opposer elected to file a series of four separate motions over a seven month period of time. Opposer has clearly demonstrated a total disregard for the orderly conduct of this proceeding and, by unnecessarily complicating the discovery process, has inexcusably compounded the time and effort that both the Board and Fernstrum have been forced to expend in this action. In view thereof, Opposer's motion to compel responses to its first and second set of interrogatories and document requests should be stricken.

If the Board does **not** grant Fernstrum's motion to strike Opposer's latest motion to compel discovery, then Fernstrum requests that it not be required to respond to such an improperly-filed motion until a reasonable period of time after the Board has ordered a resumption of these proceedings.

R. W. FERNSTRUM & COMPANY

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on this 10th day of July, 2002, a true and correct copy of the foregoing **APPLICANT'S RESPONSE TO OPPOSER'S MOTION TO COMPEL APPLICANT'S ANSWER TO OPPOSER'S FIRST SET OF INTERROGATORIES AND INITIAL REQUEST FOR PRODUCTION OF DOCUMENTS AND OPPOSER'S SECOND SET OF INTERROGATORIES AND SECOND REQUEST FOR PRODUCTION OF DOCUMENTS** was served via U.S. certified mail, return receipt requested upon:

D. Peter Hochberg, Esquire
D. Peter Hochberg Co., L.P.A.
The Baker Building, Sixth Floor
1940 East Sixth Street
Cleveland, Ohio 44114



A handwritten signature in cursive script, appearing to read "D. Peter Hochberg", is written over a horizontal line.