

TTAB

Attorney Docket 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



07-29-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #70

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

Opposition No. 119,899

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

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TRADEMARK TRIAL AND
APPEAL BOARD

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Commissioner for Trademarks
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Opposer Duramax Marine, L.L.C. (hereinafter referred to as "Duramax Marine" or "Opposer"), through its undersigned counsel, hereby responds to Applicant R.W. Fernstrum & Company's (hereinafter referred to as "Fernstrum" or "Applicant") "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."

ARGUMENT

The brief summary of the facts set forth by counsel for Fernstrum in the “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” is essentially correct. However, each response by Applicant to each previously filed Motion filed by Opposer had a plurality of interrogatories or requests which were not answered or objected to on frivolous grounds. Specifically, Applicant refused to provide responses to such a numerous amount of requests, particularly ones seeking important details and points, that each motion to compel in reply to each refusal to provide responses by Applicant was a laborious task.

As was pointed out by Applicant in Paragraph No. 4 of their Response, the parties were required to inform the Board and the other respective party when all discovery actions had been fully briefed and ready for discussion. However, neither Duramax Marine nor counsel for Duramax Marine received any communication from Fernstrum to this effect (i.e. that all pleadings by Fernstrum had been completed). Furthermore, counsel for Opposer telephoned the Board to receive advice about the filing of the present Motion to Compel and to ask if it would be proper to serve a Notice of Deposition. Counsel for Opposer was advised by the Board to file the present Motion to Compel, but not to file the Notice of Deposition. The Board did advise Opposer that Fernstrum might object to the present Motion to Compel; however, it is again noted that neither Duramax Marine nor its counsel ever received any information that motions were briefed and ready for discussion.

Opposer submits that the present Motion to Compel was particularly difficult and laborious to complete in that Applicant refused to answer thirty-six (36) out of eighty-two (82) requests and interrogatories (including various subparts) based on various grounds. This equates to nearly 50% of the first and second requests for the production documents and interrogatories submitted by Opposer which were unanswered or objected to by Applicant. Each refusal to answer or comply had to be meticulously analyzed and scrutinized individually. Moreover, many of the unanswered questions were vital for proving and supporting Opposer's grounds for opposing Application Serial No. 75/701,707 and/or were not answered for purely frivolous reasons. For example, numerous interrogatories were objected to as being "unduly vague and ambiguous." Applicant additionally claimed that Applicant could not answer many of these requests and interrogatories as they did not know the meaning of certain terms and phrases, each of which are well known and common in the English language, such as "realistic" (Answer to Interrogatory No. 15) and "in the public domain" (Answer to Interrogatory No. 22). All specific examples of this are noted in Opposer's "Memorandum in Support of its Final Motion to Compel." Yet another example, as noted in Opposer's "Memorandum in Support of its Final Motion to Compel," Applicant further objected to numerous requests for the production of documents on the basis that reviewing its own files would be too burdensome of a task and therefore supplied only a sample of the files which were sought to be produced by Opposer. Also as noted in Opposer's "Memorandum in Support of its Final Motion to Compel," Applicant may very well have supplied only a portion of the documents that were requested that were in fact beneficial, or at least not harmful, to Applicant. In other words, Applicant may have selected the

documents for its own benefit, and may have deliberately hidden documents which were detrimental to itself in this opposition.

Applicant has wrongfully accused Opposer of attempting to prolong the discovery process to the detriment of the Applicant, specifically by filing its various Motions *seriatim*. Opposer firmly denies such an allegation. To the contrary, Opposer submits that the Motions to Compel were filed *seriatim* in order to give the Board an opportunity to commence its review early, rather than having to wait until each and every discovery request was complete. The actions of Opposer were in fact intended to expedite the present proceedings and to mitigate both the time and effort that the Board, as well as Applicant, would have to expend in this action. This is specifically true since Opposer has been diligently trying to take the deposition of Paul Fernstrum, the president of Applicant, during the summer or fall of 2002. Furthermore, Applicant states that Opposer's motions being filed *seriatim* has incurred additional costs to Fernstrum because Applicant was forced to respond to those motions *seriatim*. Opposer fails to understand how this would cause additional costs to Fernstrum, as alleged by Applicant. The same cost would incur to Fernstrum if Applicant had to respond to a single Motion to Compel, that being the equivalent of the combination of each Motion to Compel filed *seriatim*, or whether multiple Motions to Compel were filed *seriatim*. Applicant would have had to respond to the same amount of information in either situation and therefore expend the same amount of time in either situation.

In actuality, Applicant is the true reason the present proceedings are being delayed or prolonged. Applicant has deliberately and without reason provided no and/or scant responses to many discovery requests and has refused to permit entry into its

facilities or to present Paul Fernstrum for deposition in the town where Fernstrum is located and where the records necessary for the current proceeding are located. Had Applicant provided proper and sufficient responses, permitted the Motion to Inspect and made Paul Fernstrum available for his deposition, the entire opposition would be completed or largely completed at this time. It is plainly apparent that Applicant's refusal to cooperate with such routine requests and refusal to provide sufficient answers to routine interrogatories that Opposer's hand was forced to file its final Motion to Compel, on advice of the Board.

Accordingly, Opposer respectfully submits that the "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" be granted.

Respectfully submitted,

Date: July 26, 2002

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing "OPPOSER'S RESPONSE TO APPLICANT'S RESPONSE TO OPPOSER'S MEMORANDUM IN SUPPORT OF ITS "MOTION TO COMPEL APPLICANT TO ANSWER 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 first class, postage prepaid, U.S. mail upon:

Samuel D. Littlepage, Esq.
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ATTORNEYS FOR APPLICANT

Date: July 26, 2002

By: Sean Mellino
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 26, 2002

By: Sean Mellino
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