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

In the Matter of Application Serial No. 75/810,043  
Published in the Official Gazette on May 30, 2000

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HEARST COMMUNICATIONS, INC. and :  
HEARST MAGAZINES PROPERTY, INC., :  
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Opposers, :  
:  
v. :  
:  
CHARLES BROWNING WILSON, :  
:  
Applicant. :  
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Opposition No. 120,453

U.S. Patent & TMO/TM Mail Rcpt. Dt. #57

[REDACTED]

10-17-2002

**OPPOSERS' OPPOSITION TO MOTION TO COMPEL RESPONSES  
TO APPLICANT'S SECOND SET OF INTERROGATORIES TO APPLICANT AND  
OPPOSERS' CROSS-MOTION TO COMPEL RESPONSES TO OPPOSERS'  
THIRD REQUESTS FOR PRODUCTION OF DOCUMENTS TO APPLICANT**

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Opposers, Hearst Communications, Inc. and Hearst Magazines Property, Inc., by and through their attorneys, Ostrolenk, Faber, Gerb & Soffen, LLP, hereby oppose the Motion to Compel Responses to Applicant's Second Set of Interrogatories to Opposers ("Applicant's Motion to Compel") and, in the alternative, to compel responses to Opposers' Third Requests for Production of Documents to Applicant ("Opposers' Third Requests").

**BACKGROUND**

Opposers are the owners of the famous trademark COSMOPOLITAN as used and registered for magazines among other things. Opposers' COSMOPOLITAN publication is also

widely known under the mark COSMO. Indeed, Opposers own registered and common law rights in their well-known COSMO mark.

On October 18, 1999, Applicant filed U.S. service mark application serial number 75/810,043 (the “‘043 Application”) to register the identical mark COSMO.COM (the .COM suffix being generic) for the provision of Internet services in the field of entertainment. Although the ‘043 Application was filed on the basis of intent-to-use, discovery in this opposition has revealed that Applicant has used, and continues to use, the mark COSMO.COM in connection with an Internet web site located at www.cosmo.com. Indeed, discovery has disclosed that the use of COSMO.COM as a domain name and trademark by Applicant has caused substantial consumer confusion.

Applicant now has objected to Opposers’ further discovery requests directed toward obtaining additional evidence of actual confusion. As a result of the already existing evidence of actual confusion, however, Applicant should not be heard to object to Opposers’ further and reasonable discovery requests.

## **ARGUMENT**

### **A. Applicant’s Motion to Compel is Premature**

Applicant’s Motion to Compel is premature. The Board suspended proceedings by its Order mailed on May 30, 2002. The parties have been engaged in settlement discussions during the suspension. Opposers need not have responded, and still need not respond, to Applicant’s discovery requests while the proceedings remained suspended.

In reply, Applicant may argue that it filed a Motion for Resumption of Proceedings on September 6, 2002. However, until the Board issues an Order resuming proceedings and setting

new response dates, proceedings still remain suspended. See Trademark Board Manual of Procedure § 510.03(b).

**B. Opposers' Cross-Move to Compel**

In the alternative, if the Board decides that proceedings are no longer suspended, Opposers hereby cross-move to compel Applicant to withdraw its unwarranted objections and fully respond to Opposers' Third Requests.<sup>1</sup> Applicant's Responses and Objections to Opposers' Third Requests for Production of Documents to Applicant ("Applicant's Responses")<sup>2</sup> are deficient. Specifically, Applicant unjustly raised general objections to all of Opposers' requests and refused to produce documents responsive to each of its requests numbered 1 through 4.

Applicant's withholding of documents responsive to Opposers' Third Requests is wholly unacceptable in light of the fact that Applicant has already admitted that actual confusion exists between the marks at issue in this opposition. In response to each of Opposers' Third Requests, Applicant unequivocally stated that it has provided the undersigned attorneys for Opposers with evidence of actual confusion. In fact, in Applicant's Responses to Opposers' First Set of Requests for Admissions to Applicant ("Applicant's Responses to Requests for Admissions"),<sup>3</sup> Applicant even admitted that actual confusion exists between the marks at issue in this opposition. Specifically, in response to Request No. 1, Applicant admitted that e-mails it has received have been intended for Opposers.

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<sup>1</sup> A copy of Opposers' Third Requests is attached as Exhibit A.

<sup>2</sup> A copy of Applicant's Responses is attached as Exhibit B.

<sup>3</sup> A copy of Applicant's Responses to Requests for Admissions is attached as Exhibit C.

Yet, despite the existing evidence of actual confusion, Applicant has resisted Opposers' discovery requests targeted toward eliciting corroborating evidence of actual confusion. Opposers' Third Requests called for Applicant to produce (1) all e-mails sent to, and/or received at, the e-mail address feedback@cosmo.com since March 1, 2001, (2) all e-mails sent to, and/or received at, the Internet web site located at www.cosmo.com since March 1, 2001 (3) all e-mails sent to, and/or received by, Applicant since March 1, 2001 and (4) all e-mails sent to, and/or received by, Applicant relating to the web site at www.cosmo.com since March 1, 2001. In response, Applicant raised a wide variety of general objections from relevance to attorney-client privilege. Applicant also objected to producing documents and things responsive to each specific request merely because it has already turned over some evidence of actual confusion and admitted that actual confusion exists. However, when it has been established that actual confusion between the marks in an opposition exists, such as here, it is not for Applicant to selectively review documents requested by Opposers to selectively decide which to produce and which to withhold.

Opposers' Third Requests are hardly unreasonable. Applicant is an individual who runs a small company comprised of no more than two or three people. The e-mails that he and his company have received through their web site should not prove overwhelmingly large. Moreover, Opposers have reasonably date restricted their document requests to only e-mails received on or after March 1, 2001. The reasonableness of the requests is made clear by the fact the Opposers' initial document requests have turned up evidence damaging to Applicant such that Opposers' further and more carefully targeted requests are likely to elicit even more relevant documents that will help support their opposition.

The undersigned attorneys for Opposers have attempted to resolve this issue in good faith with the attorney for Applicant. However, in a telephone conversation today, the attorney for Applicant declined to withdraw his objections to Opposers' Third Requests.

In light of the evidence of actual confusion, the Board should order Applicant to withdraw its objections and produce documents and things responsive to Opposers' Third Requests. At the very least, Applicant should not be permitted to rely without more upon its objections and Applicant should be held to demonstrating that its objections are warranted.

With the above, Opposers respectfully request that the Board deny Applicant's Motion to Compel or, in the alternative, grant Opposers' cross-motion to compel responses to Opposers' Third Requests.

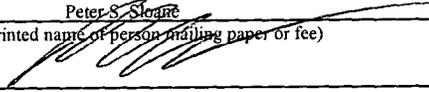
Dated: New York, New York  
October 17, 2002

"Express Mail" mailing label No. EL613554645US

Date of Deposit: October 17, 2002

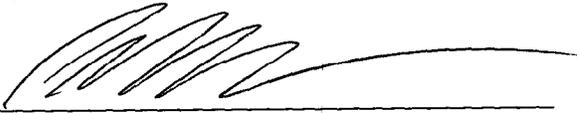
I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.

Peter S. Sloane  
(Printed name of person mailing paper or fee)

  
(Signature)

PSS:sks

Respectfully submitted,

  
Andrew V. Galway  
Peter S. Sloane

OSTROLENK, FABER, GERB & SOFFEN, LLP  
1180 Avenue of the Americas  
New York, New York 10036-8403  
Tel: (212) 382-0700

Attorneys for Opposers

**CERTIFICATE OF SERVICE**

It is hereby certified that a true copy of the foregoing **OPPOSERS' OPPOSITION TO MOTION TO COMPEL RESPONSES TO APPLICANT'S SECOND SET OF INTERROGATORIES TO APPLICANT AND OPPOSERS' CROSS-MOTION TO COMPEL RESPONSES TO OPPOSERS' THIRD REQUESTS FOR PRODUCTION OF DOCUMENTS TO APPLICANT** was served by First Class mail, postage prepaid, upon attorney to Applicant, this 17<sup>th</sup> day of October, 2002, at the following address:

James F. Gossett, Esq.  
ARNSTEIN & LEHR  
120 South Riverside Plaza, Suite 1200  
Chicago, Illinois 60606-3910



Peter S. Sloane

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

In the Matter of Application Serial No. 75/810,043  
Published in the Official Gazette on May 30, 2000

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HEARST MAGAZINES PROPERTY, INC.,	:	Opposition No. 120,453
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Opposers,	:	
	:	
v.	:	
	:	
CHARLES BROWNING WILSON,	:	
	:	
Applicant.	:	
-----X	:	

**OPPOSERS' THIRD REQUESTS FOR  
PRODUCTION OF DOCUMENTS TO APPLICANT**

Opposers, by their attorneys, pursuant to Rule 2.120(a) of the Trademark Rules of Practice and Rule 34 of the Federal Rules of Civil Procedure, request that Applicant produce the documents and things hereinafter described for inspection and copying by forwarding true copies of each document and thing covered by this Request to Opposers' counsel, Ostrolenk, Faber, Gerb & Soffen, 1180 Avenue of the Americas, New York, New York 10036, thirty (30) days after service of this Request.

**DEFINITIONS AND INSTRUCTIONS**

As used herein, the following definitions apply:

"Communication": The term "communication" means the transmittal of information (in the form of facts, ideas, inquiries or otherwise);

"Document": The term "document" is defined to be synonymous in meaning and equal in scope to the usage of this term in Federal Rule of Civil Procedure 34(e). A draft or non-identical copy is a separate document within the meaning of this term;

"Identify" (With Respect to Persons): When referring to a person, to "identify" means to give, to the extent known, the person's full name, present or last known address and, when referred to a natural person, additionally the present or last known place of employment. Once a person has been identified in accordance with this subparagraph, only the names of that person need be listed in response to subsequent discovery requesting the identification of that person;

"Identify" (With Respect to Documents): When referring to documents, to "identify" means to give to the extent known, the (i) type of document; (ii) general subject matter; (iii) date of the document; and (iv) author(s), addressee(s) and recipient(s). Should Applicant deem any document to be privileged or confidential, Applicant is requested to so state, to identify such documents by supplying the above noted information concerning such document, and to identify the grounds on which such claim of privilege or confidentiality rests;

"Identify" (With Respect to Any Other Thing): "Identify" in this context shall mean a description with sufficient particularity that such thing may thereafter be specified and recognized as such;

"Person": The term "person" is defined as any natural person or any business, legal or governmental entity, or associate;

"Concerning": The term "concerning" means which refer or relate to, referring to, describing, evidencing, or constituting;

"All"/"Each": The terms "all" and "each" shall be construed as all and each;

"And"/"Or": The terms "and" and "or" shall be construed either disjunctively or conjunctively as necessary to bring within the scope of the discovery request all responses that might otherwise be construed to be outside of its scope;

"Number": The use of the singular form of any word includes the plural and vice versa;

"Applicant": The term "Applicant" means Charles Browning Wilson, any entity in which Charles Browning Wilson has an ownership interest, any entity in which Charles Browning Wilson is a partner, any licensee or assignee of Charles Browning Wilson, and any entity or person acting or purporting to act on his behalf.

"COSMO.COM" shall mean the mark claimed in U.S. application serial number 75/810,043 and any other marks of Applicant that consist of or comprise the term "COSMO" including, but not limited to, "COSMOPOLITAN."

### **DOCUMENTS REQUESTED**

#### **REQUEST NO. 1:**

All e-mails sent to, and/or received at, the e-mail address [feedback@cosmo.com](mailto:feedback@cosmo.com) since March 1, 2001.

#### **REQUEST NO. 2:**

All e-mails sent to, and/or received at, the Internet web site located at [www.cosmo.com](http://www.cosmo.com) since March 1, 2001.

REQUEST NO. 3:

All e-mails sent to, and/or received by, Applicant since March 1, 2001.

REQUEST NO. 4:

All e-mails sent to, and/or received by, Applicant relating to the web site at  
www.cosmo.com since March 1, 2001.

Dated: New York, New York  
August 23, 2002

Respectfully submitted,



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Andrew V. Galway  
Peter S. Sloane

OSTROLENK FABER GERB & SOFFEN, LLP  
1180 Avenue of the Americas  
New York, New York 10036-8403  
(212) 382-0700

Attorneys for Opposers

**CERTIFICATE OF SERVICE**

It is hereby certified that a true copy of the foregoing **OPPOSERS' THIRD REQUESTS FOR PRODUCTION OF DOCUMENTS TO APPLICANT** was served by first class mail, postage prepaid, upon Applicant, this 23rd day of August, 2002, as follows:

James F. Gossett, Esq.  
ARNSTEIN & LEHR  
120 South Riverside Plaza, Suite 1200  
Chicago, Illinois 60606-3910



Peter S. Sloane



subject matter thereof in any subsequent proceeding, and/or the trial of, this or any other action;

b. The right to object to the use of any answers or the subject thereof in any subsequent proceeding in, or trial of, this or any other action; and

c. The right to object on any ground at any time to a demand for further response to these or any other requests.

### **GENERAL OBJECTIONS**

Each of the following General Objections is made part of Applicant's Responses and Objections set forth below:

1. Applicant objects to Opposers' document requests to the extent that they seek to impose a duty to provide discovery beyond that required by the Federal Rules of Civil Procedure.

2. Applicant objects to Opposers' document requests on the grounds that they are overly broad, vague, ambiguous, unduly burdensome, oppressive and/or harassing, and/or call upon Applicant to investigate, collect and disclose information which is neither relevant to the subject matter of this action nor reasonably calculated to lead to the discovery of admissible evidence. The burden and expense of responding to such requests far outweigh the utility of the discovery sought, and the discovery sought is obtainable from other sources that are more convenient, less burdensome, and less expensive. To the extent that responses are provided, it is in an effort to expedite discovery in this action and is not an indication or admission by Applicant of the relevancy thereof.

3. Applicant objects to Opposers' document requests to the extent that they call upon Applicant to disclose information immune from discovery because of the attorney/client privilege or because of the attorney work product doctrine, or because they otherwise call upon Applicant to disclose the mental impressions, conclusions, opinions, or legal theories of an attorney or other representatives of Applicant concerning this opposition.

4. Applicant objects to Opposers' document requests to the extent that they call for the identity or production of "all" documents or items of information or "each" document or item of information that exists in the possession, custody or control of Applicant, including any agents, employees, attorneys, or other representatives. To the extent not objected to, Applicant will produce representative documents that are not duplicative of other produced documents and discovery already provided. Applicant will not search for files of persons that are not reasonably likely to have had significant contact with the subject matter of a request. To the extent that Opposers request that Applicant engage in a more extensive search for documents than indicated, Opposers' requests are over broad, unduly burdensome, oppressive and harassing. The burden of such a search would be grossly out of proportion to the prospect of discovering admissible evidence or materials that would lead to the discovery of admissible evidence.

5. Applicant reserves the right to supplement his responses to the document requests, if necessary, pursuant to Rule 26(e) of the Federal Rules of Civil Procedure.

### **RESPONSES TO DOCUMENTS AND THINGS REQUESTED**

#### **REQUEST NO. 1:**

All e-mails sent to, and/or received at, the e-mail address [feedback@cosmo.com](mailto:feedback@cosmo.com) since March 1, 2001.

**RESPONSE TO REQUEST NO. 1:**

See General Objections Nos. 1 through 4. Applicant further states that it has provided Opposers' counsel with copies of all e-mail in Applicant's possession or control that relates to Opposers, the magazine COSMOPOLITAN, or any other goods or services sold or licensed by Opposers under the marks COSMOPOLITAN or COSMO, as well as all e-mail in Applicant's possession or control that refers to any actual confusion between Applicant's use of the mark COSMO.COM and Opposers, the magazine COSMOPOLITAN, or any other goods or services sold or licensed by Opposers under the marks COSMOPOLITAN or COSMO. Moreover, in response to a request for admissions directed to Applicant by Opposers, Applicant has already admitted that some e-mail inquiries to Applicant at COSMO.COM have apparently been intended for Opposers.

**REQUEST NO. 2:**

All e-mails sent to, and/or received at, the Internet web site located at [www.cosmo.com](http://www.cosmo.com) since March 1, 2001.

**RESPONSE TO REQUEST NO. 2:**

See General Objections Nos. 1 through 4. Applicant further states that it has provided Opposers' counsel with copies of all e-mail in Applicant's possession or control that relates to Opposers, the magazine COSMOPOLITAN, or any other goods or services sold or licensed by Opposers under the marks COSMOPOLITAN or COSMO, as well as all e-mail in Applicant's possession or control that refers to any actual confusion between Applicant's use of the mark COSMO.COM and Opposers, the magazine COSMOPOLITAN,

or any other goods or services sold or licensed by Opposers under the marks COSMOPOLITAN or COSMO. Moreover, in response to a request for admissions directed to Applicant by Opposers, Applicant has already admitted that some e-mail inquiries to Applicant at COSMO.COM have apparently been intended for Opposers.

**REQUEST NO. 3:**

All e-mails sent to, and/or received by, Applicant since March 1, 2001.

**RESPONSE TO REQUEST NO. 3:**

See General Objections Nos. 1 through 4. Applicant further states that it has provided Opposers' counsel with copies of all e-mail in Applicant's possession or control that relates to Opposers, the magazine COSMOPOLITAN, or any other goods or services sold or licensed by Opposers under the marks COSMOPOLITAN or COSMO, as well as all e-mail in Applicant's possession or control that refers to any actual confusion between Applicant's use of the mark COSMO.COM and Opposers, the magazine COSMOPOLITAN, or any other goods or services sold or licensed by Opposers under the marks COSMOPOLITAN or COSMO. Moreover, in response to a request for admissions directed to Applicant by Opposers, Applicant has already admitted that some e-mail inquiries to Applicant at COSMO.COM have apparently been intended for Opposers.

**REQUEST NO 4:**

All e-mails sent to, and/or received by, Applicant relating to the web site at [www.cosmo.com](http://www.cosmo.com) since March 1, 2001.

**RESPONSE TO REQUEST NO. 4:**

See General Objections Nos. 1 through 4. Applicant further states that it has provided Opposers' counsel with copies of all e-mail in Applicant's possession or control

that relates to Opposers, the magazine COSMOPOLITAN, or any other goods or services sold or licensed by Opposers under the marks COSMOPOLITAN or COSMO, as well as all e-mail in Applicant's possession or control that refers to any actual confusion between Applicant's use of the mark COSMO.COM and Opposers, the magazine COSMOPOLITAN, or any other goods or services sold or licensed by Opposers under the marks COSMOPOLITAN or COSMO. Moreover, in response to a request for admissions directed to Applicant by Opposers, Applicant has already admitted that some e-mail inquiries to Applicant at COSMO.COM have apparently been intended for Opposers.

Dated: SEPTEMBER 6, 2002  
Chicago, Illinois

Respectfully submitted,

By: James F. Gossett

James F. Gossett  
Arnstein & Lehr  
120 South Riverside Plaza, Suite 1200  
Chicago, Illinois 60606  
Tel. (312) 876-7833

Attorney for Applicant

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing APPLICANT'S RESPONSES AND OBJECTIONS TO OPPOSERS' THIRD REQUESTS FOR PRODUCTION OF DOCUMENTS TO APPLICANT was served upon counsel for Opposers by depositing same with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to:

Peter S. Sloane  
OSTROLENK, FABER, GERB & SOFFEN, LLP  
1180 Avenue of the Americas  
New York, New York 10036-8403

on September 6 2002.

  
James F. Gossett



**REQUEST NO. 2:**

Admit that Applicant is familiar with Opposers and their marks COSMOPOLITAN and COSMO.

**RESPONSE:**

Applicant admits that he is familiar with Opposers and the marks COSMOPOLITAN and COSMO. Applicant denies the remainder of this request.

**REQUEST NO. 3:**

Admit that Opposers' marks COSMOPOLITAN and COSMO are famous.

**RESPONSE:**

Applicant objects to this request, as it calls for a conclusion on a point of law.

Dated: Chicago, Illinois  
August 22, 2002

Respectfully submitted,

CHARLES BROWNING "COSMO"  
WILSON

By: James F. Gossett  
Attorney for Applicant

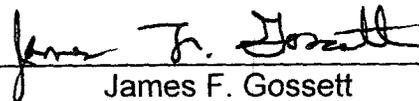
James F. Gossett  
Arnstein & Lehr  
120 S. Riverside Plaza, Suite 1200  
Chicago, Illinois 60606  
Tel. (312) 876-7833

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing **APPLICANT'S RESPONSES TO OPPOSERS' FIRST SET OF REQUESTS FOR ADMISSIONS TO APPLICANT** was served upon counsel for Opposers by depositing same with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to:

Peter S. Sloane  
OSTROLENK, FABER, GERB & SOFFEN, LLP  
1180 Avenue of the Americas  
New York, New York 10036-8403

on August 22, 2002.

  
James F. Gossett