

TTAB

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

X/OPEN COMPANY LIMITED,

Opposer,

Opposition No.: 122,524

vs.

Application Serial No.: 75/680,034

WAYNE R. GRAY,

Applicant.

**APPLICANT'S REPLY TO OPPOSER'S OPPOSITION TO APPLICANT'S MOTION
TO TEST SUFFICIENCY OF OPPOSER'S RESPONSE TO ADMISSION REQUESTS**

I. INTRODUCTION

Applicant, in its Motion to Test Sufficiency of Opposer's Response to Admission Requests (herein referred to as "motion to test") asserts that Opposer continues to conceal evidence from Applicant through obstruction and unjust delays, evidence that is relevant to Applicant's revised affirmative defenses and counterclaim—evidence that will eliminate the necessity of proving facts that are not in substantial dispute and narrow the scope of disputed issues. Opposer obliquely responded to Applicant's notice of said motion in a one-page letter¹ dated December 17, 2004 in which it again makes general and unsubstantiated reference to new confidentiality claims, and produced unsubstantiated (and in some cases, non-responsive) documents. Applicant, having received improper, evasive and inadequate responses to Admission Requests, then filed its brief with addendum and exhibits on December 19, 2004 in support of said motion. Opposer's opposition brief dated December 30, 2004, continues the refusal to substantiate its new objections.

¹ See Exhibit J to Opposer's combined opposition brief dated December 30, 2004.



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Applicant's Motion to Test details Opposer's response deficiencies, yet Opposer in its opposition brief, still presenting no substantive objections, merely attacks Applicant's Motion to Test on technical grounds, stating that Applicant has not made a good-faith effort to resolve issues presented in his motion and did not include a statement in the briefs that he did so, and Applicant's briefs were not filed with the motions and are in excess of the 25 page limit. As Opposer does not deny that its responses to Applicant's Admission Requests are deficient, the Board must conclude that Opposer concedes that its discovery response deficiencies are admitted.

Opposer's scheme is to deny Applicant discovery evidence, obstructing discovery relevant to the Unix marks in suit by refusing to fully and directly respond to Applicant's Admission Requests, claiming untimely and improper new privileges after a delay of over 5 months. Opposer demonstrates a cavalier attitude regarding the Board's July 22 order and the discovery rules. Opposer's new privilege claims are intended as a sword and shield, perpetuating a continuing cover-up of its misleading and fraudulent acts relevant to said marks, and are contrived to obstruct, delay and deny Applicant justice. The Board should rule that Opposer has waived all its new objections and privilege claims and order Opposer to respond fully and directly to Applicant's Admission Requests with specificity.

II. ARGUMENT

Opposer's opposition to this motion again attempts to distort the facts in this case, ignoring the fact that its protective order motion dated May 20, 2004 did not object to many of Applicant's admission requests that it now objects to, ignoring Applicant's August 11, 2004 admission requests revisions and withdrawals pursuant to the Board's July 22, 2004 order, ignoring that its objections to Applicant's discovery were already denied by this Board in its July 22 order and, although Applicant believes that it has complied with the good-faith "meet and confer" rule, said Board order actually precludes the need to meet and confer as required under Rule 37(a) Fed.R.Civ.P.

Applicant received Opposer's response to Admission Requests on November 1, 2004, about 5 months after the original requests were served. Opposer's evasive and inadequate responses and improper

new privilege claims clearly reveal its scheme of obstruction and delay. As a prime example, Opposer in its filing² dated May 20, 2004 implies that it does not object to Admission Requests Nos. 59-63, 65, 118, 119, and 123, but now cavalierly claims new privileges and objects to all.

Applicant's motion to test identifies 6 events³ that appear to relate directly to the Unix marks in suit and Applicant's amended affirmative defense and counterclaims, and many of these events involve contracts and amendments, communications between Opposer and Novell and other parties, and communications internal to Opposer's organization, all relevant to naked licensing, lack of standing and abandonment of the marks in suit, and establishing a state of mind and intent to commit fraud. In Applicant's preparation for depositions, we have determined that several hundred discovery documents may exist, and proper responses to Applicant's admission requests may eliminate the necessity of proving facts that are not in substantial dispute and narrow the scope of disputed issues. Opposer's improper and evasive responses are calculated to perpetuate its scheme of obstruction and unjust delays.

Pursuant to TBMP § 502.02(b); 37 C.F.R. § 2.127(a), "No further papers (including surreply briefs) will be considered by the Board and any such papers filed in violation of this rule may be returned...". Opposer's improper 40 day extension request to file yet a second response to this motion is a veiled attempt to file, and have the Board consider, an improper surreply brief, and must be denied.

A. Applicant Acted in Good Faith Prior to Filing its Motion to Test

Opposer informed Applicant in a letter dated May 19, 2004 of its objections to Applicant's discovery requests, filed a protective order motion dated May 20, 2004 attacking Applicant's discovery requests, and in the Board's July 22, 2004 order, its objections were mostly denied.

Applicant's June 7, 2004 letter revised and withdrew several discovery requests in response to Opposer's discover objections and, in a letter to Opposer dated August 11, 2004, which operated as an estoppel letter, Applicant further revised and withdrew discovery requests.

² Opposer's Motion for a Protective Order filed May 20, 2004 at 10.

³ Applicant believes additional events yet to be discovered relevant to the marks in suit may exist.

Opposer's response dated November 1, 2004 to Applicant's Admission Requests includes new objections and new privilege claims to requests it previously represented to Applicant and this Board as not objecting to, refuses to provide any answer to many requests, and represents a re-argument of the Board's July 22 order denying its motion for a protective order. Applicant's letter dated December 3, 2004 to Opposer (attached hereto as Exhibit 1 at 2) reminds Opposer of Applicant's prior good faith discovery efforts, including its August 11, 2004 estoppel letter, informing Opposer that all its new objections and privilege claims are untimely and improper, and stating "we have a fundamental difference in our approach to discovery". Having received no response from Opposer other than a promise to "respond by the end of the week" and even then a continuing refusal to substantiate new objections and new privilege claims, Applicant filed its Motion to Test Friday evening December 10, stating therein at 2 that a resolution attempt had been made.

Furthermore, Opposer's technical reliance on any absence of a Rule 37(a)(2)(A) certification is misplaced. Applicant complied with the certification requirement in its opposition to Opposer's protective order motion and prior discovery revisions of precisely the same materials that are still at issue here. Pursuant to that motion, the Board's July 22 order intervened, ordering Applicant to narrow certain discovery requests and ordering Opposer to produce the discovery at issue, but Opposer still refuses to comply. "The prior issuance of a court order obviates the need to meet and confer as required under Rule 37(a)." *Royal Maccabees Life Ins. Co. v. Malachinski*, No. 96 C 6135, 2001 WL 290308, (N.D. Ill. Mar. 20, 2001); *see also Moore's Fed. Pract.* § 37.40, at 37-59 (explaining that Rule 37(b) does not carry a "meet and confer" requirement because Rule 37(b) is available "only if a court has first entered an order compelling the discovery in question" - a requirement that "obviates the need for the meet and confer").

Failure to include a Rule 37(a)(2)(A) certification, even when required on a party's motion to compel, does not constitute a fatal flaw. Instead, a court is to exercise "its discretion to consider the instant motion despite the absence of a certification from the moving party in light of the "track record of

the parties" and the "nature and substance of the instant motion." *United States v. Rempel*, No. A00-0069-CV (HRH), 2001 WL 1572190, (D. Alaska July 5, 2001). Applicant, although not required, complied (in his separate motion), and now permitting Opposer to further delay its discovery obligation through a technical reliance objection would turn Rule 37(a)(2) on its head.

B. Timeliness of Applicant's Brief in Support of Motion to Test

Opposer has claimed in its opposition brief that Applicant's motion should be denied procedurally because, *inter alia*, the supporting briefs were not filed concurrently therewith but instead were filed 10 days later.⁴ While that is the strict construction of the cited rule, it was obvious that the supporting brief and related documents would entail a considerable amount of work by counsel for Applicant, not to mention the additional effort on the part of counsel for Opposer as well as the TTAB, and it was hoped that the mere filing of the motion would be sufficient to secure cooperation and immediately obtain meaningful responses, thereby enabling the withdrawal of the motion. As to timing, Opposer's clock for the response could not have reasonably started earlier than the service of the supporting brief, not the service of the motion, and if Opposer was unsure of that, it could have sought a stipulation from Applicant.

C. Applicant's Motion to Test Brief Does Not Exceed 25 Pages

Applicant's brief in support of this motion is 15 pages and is well within the 25 page limit as "[e]xhibits submitted with the brief are not counted in determining the length of the brief", TBMP § 502.02(b); 37 C.F.R. § 2.127(a).

Applicant's brief in support of this motion clearly argues its objections to Opposer's new privilege claims and identifies response deficiencies with respect to all discovery requests with examples, and includes Addendum A as a supporting document organized so as to simplify and ease the Board's assessment of Opposer's response deficiencies in this complex proceeding. The addendum

⁴ See Opposer's combined opposition brief at 1, 5, and 7-8.

should not be counted as an integral part of Applicant's brief as it serves to simplify and is not presented separately to circumvent the 25 page limit; a ruling as such only rewards a responding party for numerous and wordy discovery objections in complex proceedings such as this. Indeed, considering the number and length of Opposer's objections, 25 pages would not be enough.

D. Opposer's Suggested Protective Order Is in Bad Faith

Opposer's confidentiality and privilege claims are new and untimely and any discussions of a protective order as initiated by Opposer on November 19, 2004 relating to the same discovery requests are inappropriate, especially as Opposer engages in bad faith in its assertions of new objections regarding the same admission requests it had previously indicated to Applicant and this Board as not objecting to, and as Opposer continues in its refusal to substantiate its new privilege claims.

Applicant believes that Opposer's suggested protective order dated November 19, 2004 is not in good faith and he does not wish to stipulate to an order that improperly places the discovery burden upon Applicant. For example, Opposer's suggested protective order intentionally and improperly does not include provisions for information pursuant to TBMP 412.02(d)(5-7), and does not properly impose any time restrictions in privilege designation disputes pursuant to TBMP 412.02(d)(11), merely stating "the parties will make a good faith effort to resolve any disputes over any confidentially designation"⁵, and is only intended to facilitate Opposer's discovery delays. Applicant can no longer accept that Opposer will act in good faith and believes its protective order intent is to perpetuate its continuing scheme of obstruction and delay, continue concealment of fraud, and deny Applicant justice.

Applicant suggests that Opposer, rather than filing its improper Protective Order motion dated May 20, 2004 in response to Applicant's discovery requests should have requested an initial extension to respond to discovery and therein filed a Motion to Join Novell as a defendant in counterclaims in this proceeding pursuant to Fed.R.Civ.P. 20(a) to support all privilege claims with respect to the events in

⁵ See Exhibit C at 6 of Opposer's combined opposition brief dated December 30, 2004.

question relating to the marks in suit as the joint transactions of Opposer and Novell. Only then should they have jointly responded fully and completely to Applicant's discovery requests and, as necessary, filed a Protective Order motion with privilege log properly supporting Opposer's new privilege claims.

E. Opposer Does Not Deny its Discovery Responses are Improper and Deficient

In Applicant's letter to Opposer dated December 3, 2004, Applicant made it clear that Opposer's delay in asserting its new objections, not its answer delay, waived said objections and are in fact separate issues, stating "An extension of any time to provide answers, as you are aware, does not extend the time to make objections of any type", and Opposer does not now argue that it has not clearly waived its new objections and new privilege claims. *See Ritacca v. Abbott Laboratories*, 203 F.R.D. 332, 335 n.4 (N.D. Ill. 2001) ("As courts have repeatedly pointed out, blanket objections are patently improper,... [and] we treat [the] general objections as if they were never made." (internal citation omitted)). *See also U.S. ex rel. Burroughs v. Denardi Corp.*, 167 F.R.D. 680, 687 (S.D. Cal. 1996) ("Generally, a party's failure to serve timely objections to document production requests constitutes waiver of any objections which the party might have to the requests.")

Waiver of the right to assert a privilege objection due to conduct (or lack thereof) is a harsh sanction utilized where that party has unjustifiably delayed discover. *Ritacca*, supra, at 235. *See Eureka Financial Corp v. Hartford Acc. and Indem. Co.*, 136 F.R.D. 179, 185 (E.D. Cal. 1991). The Court should analyze the circumstances of such delay on a case by case basis. "Minor procedural violations, good faith attempts at compliance, and other such mitigating circumstances mitigate against finding waiver. In contrast, evidence of foot-dragging or cavalier attitude towards following the courts orders and the discovery rules supports finding waiver." *Ritacca*, supra, at 335 (citations omitted). For example in *Denardi*, supra, the court found that although a party's failure to serve timely objections to document production requests generally constitutes waiver of any objections which the party might have to the requests, a six-day delay in responding to the propounding party's requests was not unfair and thus did not

equate to a waiver. *Denardi*, at 687. Conversely, in *Ritacca, supra*, the court found the defendant's five month delay, during which time it never mentioned its privilege objections, to be inexcusable and unjustified. *Ritacca, supra*, at 336. That court concluded that the defendant's "casual disregard for the discovery rules in this litigation can only be characterized as unjustified, inexcusable, and in bad faith."

Opposer has had many opportunities to assert its new privilege claims, including its fully briefed prior Protective Order motion, and Opposer's new privilege claims, over 5 months after its discovery requests were originally due, are patently out of order. Even now, Opposer continues in its refusal to substantiate new and improper objections and privilege claims, an unjust delay of 7 months, and thus demonstrating a cavalier and arrogant attitude toward this Board's July 22 order and discovery rules.

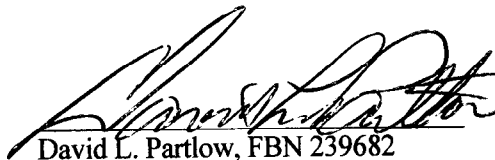
Considering Opposer's new privilege claims delay is 5 months as in *Ritacca*, Opposer's many prior opportunities to assert said claims and their complete surprise to Applicant, and Opposer's continuing refusal to substantiate new privilege claims, *Ritacca* is squarely on point and the Board should deny Opposer's new discovery response objections and its new privilege claims.

III. CONCLUSION

Opposer was ordered by the Board to respond to Applicant's discovery requests in the order dated July 22, 2004, yet its response is essentially a re-argument of its prior protective order motion, amounting to an objection to the Board's ruling, and it is simply designed to obstruct, delay and deny Applicant justice. Opposer engages in bad faith in asserting new objections to certain requests that it had previously indicated to this Board and Applicant as having no objection to, and Opposer even now continues its refusal to substantiate its new objections and untimely and improper new privilege claims. For the foregoing reasons, Applicant respectfully requests that the Board issue an order denying Opposer's new objections and its new privilege claims, and ruling Opposer's answers to Applicant's Admission

Requests as non-responsive and order Opposer to directly respond with specificity.

Respectfully submitted,



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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true and correct copy of the foregoing document has been furnished by C.S. Mail to Evan A. Raynes, Esquire, at Finnegan, Henderson, Farabow, Garrett, & Dunner, L.L.P., 901 New York Ave., N.W., Washington, D.C. 20001-4413, this 12th day of

January, 2008.



David L. Partlow

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**NOTICE OF FILING EXHIBIT IN SUPPORT OF REPLY ON
MOTION TO TEST SUFFICIENCY OF ADMISSIONS RESPONSES**

COMES NOW the applicant, Wayne R. Gray, by and through his undersigned counsel, and hereby gives notice of filing the attached Exhibit 1 in support of his reply brief on his motion to test sufficiency of admissions responses.

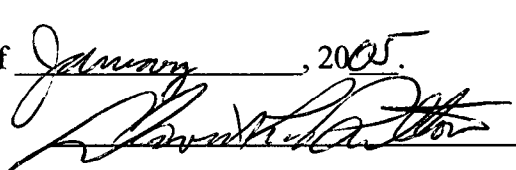
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A handwritten signature in cursive script, appearing to read "David L. Partlow", written over a horizontal line.

David L. Partlow

EXHIBIT 1

DAVID L. PARTLOW, P.A.
ATTORNEYS AT LAW

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December 3, 2004

Evan Raynes, Esq.
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VIA FACSIMILE

Re: X/Open Company Limited v. Wayne R. Gray

Dear Mr. Raynes:

In looking over your various discovery responses, I believe there are significant problems with them. It is my position that your objections are all improper because they are untimely. These discovery requests, as revised according to my August 11, 2004 letter, presented you with the opportunity to make your legal objections within 30 days, as required. An extension of time to provide the answers, as you are well aware, does not extend the time to make objections of any type. Accordingly, I believe all of your objections have been waived. For example, certainly you could have foreseen that a confidentiality objection might be raised, and early on proposed a confidentiality agreement on a timely basis, but you did not do so. At this point, such a maneuver seems more like a delaying tactic. In addition, I don't see, even without the waiver, how a confidentiality agreement could operate in this case, if you have any intention of limiting my client's access to documents and information; after all, it is he who must make the ultimate decisions in this case, and he cannot be expected to do so without being fully informed.

As to your objection regarding the date range, you certainly accepted my deletion of certain items in my August 11, 2004 letter, which operates as an estoppel letter. Similarly, the same letter would operate as a date range estoppel letter since it also contained the appropriate date range restriction conforming to the relevant order of the TTAB.

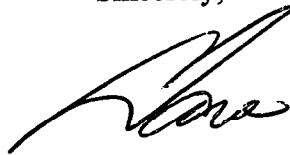
In addition, for example, your statement in response to some of the document production requests to the effect that your client will look for the requested documents some time in the future is unacceptable and in fact unresponsive. Likewise, your responses to my requests for admissions was largely unresponsive. As a further example, although you claimed privilege, you utterly failed to produce a privilege log which is required, as you know, and consequently you again face waiver on that ground.

Evan Raynes, Esquire
December 3, 2004
Page 2

I began to go through these things one at a time to spell them out for you, but upon further reflection I believe we have a fundamental difference in our approach to discovery, as borne out by the fact that your client has not produced one single scrap of paper, for example, in response to my requests, while we produced over 2500 pages in our initial response alone.

Accordingly, I would like a full and complete response to all of my discovery requests, without objection, by noon on Wednesday of next week, which by the way is well over six months since the initial promulgation of my discovery requests. Failing such a response in my office, I don't think I'll have any choice but to file a motion to compel.

Sincerely,

A handwritten signature in black ink, appearing to read 'D. Partlow', written in a cursive style.

David L. Partlow

DLP:ac