

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

In the Matter of Ser. No. 76/245,902 - OG 12/11/01

SAVATAR, INC.,

Opposer,

-v-

SAVITAR CORPORATION,

Applicant.

Opposition No. 124,976

TRADEMARK TRIAL AND
APPEAL BOARD

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**SAVITAR'S REPLY IN SUPPORT OF ITS MOTION TO COMPEL DOCUMENTS
FROM OPPOSER AND IN OPPOSITION TO PROTECTIVE ORDER**

Comes now the Applicant, Savitar Corporation ("Savitar"), and submits its Reply in Support of Its Motion to Compel Documents from Opposer and in Opposition to parts of Opposer's Motion for Protective Order.

As delineated in its original motion, Savitar served a set of short interrogatories and requests for production upon Opposer regarding Opposer's claimed use of a mark. Opposer refused to fully answer and respond to Savitar's interrogatories and requests. Savitar attempted to resolve these issues in good faith. However, Opposer refused to cooperate – first ignoring such request and then stating that it simply and inexplicably would provide no more information. Savitar was forced to file a motion to compel. Opposer objected to the motion by continuing to ignore some of the requests and, for the first time, requesting a protective order. As explained below, Opposer's pleading is without merit.

Interrogatory Nos. 7 & 8 – Location of Publicly Disclosed Customers.

Interrogatory numbers 7 and 8 asked Opposer to list the location of the customers using Opposer's software development services and using Opposer's consulting services. Opposer unilaterally decided to ignore the discovery as written and to only list "recent" clients who have been "publicly disclosed." Opposer completely ignored the portion of the discovery which sought the location of any such customer. Accordingly, after receiving Opposer's discovery responses, Savitar asked that Opposer complete its answer by at least "providing the location of these customers." Opposer completely ignored this request. After Savitar further requested that Opposer reconsider this objection, Opposer abruptly stated that it would provide no more information.

In its opposition brief, Opposer fails to explain why it is unwilling to provide the location of its publicly disclosed customers. Obviously if Opposer has disclosed these customers to the public, this information simply cannot be confidential.

The location of these customers is necessary for Savitar to complete discovery. First, Opposer claims that its mark is used throughout the nation. Savitar is entitled to information regarding this geographical scope since Opposer placed it at issue. Furthermore, Savitar is entitled to research Opposer's claims that it has used a mark with customers since 1997 and that its customers somehow recognize the alleged mark (i.e. the mark has goodwill). Opposer put the issue of goodwill into this action by making its claim in its opposition. Many of Opposer's customers that Savitar has been able to locate have stated that they can find **no evidence** of having dealt with Opposer. Some of these customers stated that a location may help them find any information which may exist regarding Opposer. (See letter dated July 1, 2002 (seeking additional information on the location Opposer's product was used), and letter dated May 29,

2002, a copy of each which is attached hereto). Opposer continues to refuse to provide the location of these publicly disclosed customers.

Opposer cannot have it both ways. It cannot attempt to use alleged transactions with customers to support its opposition while estopping Savitar from investigating the alleged use of a mark with its customers. Savitar does not have to rely on the self-serving statements of Opposer provided in Opposer's affidavit. Rather, Savitar is entitled to conduct discovery in connection with Opposer's claims. Opposer's allegation that the location of its publicly disclosed customers is confidential is completely without merit and is merely an attempt to interfere with Savitar's discovery. If Opposer continues to refuse to provide such information, it should be prohibited from offering any evidence/claims regarding the alleged use of its mark with any such customers.

Interrogatory Nos. 7 & 8 – Identification of Remaining Customers.

Savitar's discovery requested the identity of customers for the last five years. Opposer's discovery answers stated that the request was "overly broad" and "unduly burdensome." It unilaterally decided to only supply the identity of "recent" customers which have been publicly disclosed. Opposer does not explain, whatsoever, why it would not provide the identity of the remaining publicly disclosed customers. If any such customers exist, Opposer should be compelled to identify the same.

Furthermore, Opposer states that the identity of its remaining "non-public" customers is confidential. The specific name, location and affiliation of the first claimed customer of each of Opposer's software development services and Opposer's consulting services is discoverable.

Miller & Fink Corp. v. Servicemaster Hospi. Corp., 184 U.S.P.Q. 495, 1975 WL 20769

(Trademark Tr. & App. Bd. 1975). Because this information concerns an opposer's claims of first use, it has been found discoverable without reference to any type of protective order. See e.g. Miller & Fink Corp. v. Servicemaster Hospi. Corp., 184 U.S.P.Q. 495, 1975 WL 20769 (Trademark Tr. & App. Bd. 1975); Varian Associates v. Fairfield-Noble Corp., 188 U.S.P.Q. 581, 1975 WL 20871 (Trademark Tr. & App. Bd. 1975).

Finally, Opposer states that it will provide the identity of the remaining customers upon the execution of a protective order.¹ Opposer first raised the issue of a protective order in its opposition to Savitar's motion to compel. Savitar has reviewed the proposed protective order and will not dispute if Opposer wants to use the protective order attached to its pleading in connection with its providing the identity and location of this last group of customers.

Interrogatories Nos. 9 & 10 – Number of Customers

Opposer still fails to give the number of customers who use Opposer's services and products. This information is vital in Savitar's discovery. Opposer claims that it has used its mark continuously. Savitar is entitled to determine if such is the case. Furthermore, Opposer put into issue the strength of its mark by claiming that its mark has developed "goodwill." The number of customers it had each year is relevant to such a claim.

Opposer claimed that this interrogatory was "overly broad, not limited in time, unduly burdensome and seeks the disclosure of information that is neither relevant to the claim or

¹ In its application for a Protective Order, Opposer unilaterally states that Opposer and Savitar are competitors. It is believed that this is an inaccurate statement. Confirmation of this inaccuracy should be available when Savitar is able to complete its discovery. Furthermore, there is no evidence that Savitar has or will "harass" Opposer's customers. In connection with Opposer's claim that it never received copies of Savitar's non-party subpoenas, Savitar was not made aware of this claim prior to receiving Opposer's pleading. Since such time, the undersigned has forwarded copies of the subpoenas to Opposer's counsel.

defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.” Because Opposer has alleged use of the mark for only five years, this interrogatory cannot be overly broad, unduly burdensome or too broad in time. Opposer completely failed to provide the number of customers. Opposer fails to explain how providing such numbers would be burdensome or prejudicial. Rather, it just refuses to provide any such information. Accordingly, Opposer should be required to complete this interrogatory.

Interrogatory No. 14 – Money Attributed To Goodwill

In its opposition, Opposer claims that its mark has goodwill value. Accordingly, interrogatory number 14 sought the value that any such goodwill had been given in any financial documents. One of the Opposer’s objections was that this interrogatory was irrelevant. Obviously, because Opposer has but its goodwill at issue, Savitar is entitled to discover information about it.

Opposer also claimed that the interrogatory was overly broad, not limited in time and unduly burdensome. As indicated above, this interrogatory only covers a time period of five years. It is stated with particularity and, therefore, not objectionable.

Opposer also claims that “precise details of financial information concerning the company are confidential.” If Opposer is claiming that it has developed goodwill in its mark, then Savitar is entitled to know at what amount such goodwill has been valued. Since Opposer has made public its claim that it has a valuable goodwill (i.e. in its public filing of its opposition), it is hard to understand why the amount of this goodwill would be confidential.

Savitar is also entitled to determine the amount of money spent in developing its mark. Savitar does not have to rely on the self-serving testimony of its officer for this information.

Opposer claims that its self-proclaimed figure is not unsubstantiated because it submitted an affidavit produced solely for this litigation. The affidavit is not supported by any documents. Accordingly, it remains an unsubstantiated/undocumented number. Opposer should be required to produce the requested goodwill information. Furthermore, Opposer should be required to produce any documents supporting such claims. As the case cited by Opposer holds, annual sales figures are relevant in connection with claims that there have been sales and advertising under the mark in each category in each of the relevant years. Neville Chemical Company v. Lubrizol, 184 U.S.P.Q. 689, 1975 WL 20772 (Trademark Tr. & App. Bd. 1975).

In its opposition, Opposer for the first time raises the issue of a protective order. Savitar has reviewed the proposed protective order and will not dispute if Opposer wants to use the protective order attached to its pleading in connection with its providing Savitar with the dollar amounts invested in its mark as well as any goodwill values assigned to the mark in financial documents.

Requests For Production Nos. 1 & 2 – Samples of Mark

Request for Production numbers 1 and 2 simply sought copies of Opposer's advertising, sample brochure, product packaging and stationary. Opposer listed several improper objections, and produced items "subject to" said objections. Accordingly, Savitar asked Opposer to reconsider its objections and produce any remaining documents, if they existed. Opposer simply ignored this request. Later, Opposer stated that it was unwilling to produce any additional information.

In its opposition to Savitar's motion to compel, Opposer finally completes its responses to these requests. Accordingly, this issue is no longer before the Board.

Opposer has failed to cooperate in discovery. It ignored the undersigned's letter requesting that they discuss the delineated objections. Upon further inquiries, Opposer finally responded with a single statement that it had no intention of providing any further information to Savitar. Because Savitar was forced to file its motion to compel in order to get Opposer to respond to discovery, costs should be awarded against Opposer.

WHEREFORE, Applicant, Savitar Corporation, prays that this Board enter an order requiring Opposer to fully answer the Interrogatories and fully respond to the Requests for Production of Documents served on March 8, 2002, within fifteen (15) days of entering such order and award sanctions, as this Board deems proper, and for all other just and proper relief in the premises.

Respectfully submitted,



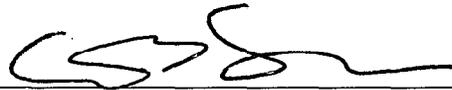
Elizabeth B. Searle
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300 Main Street, Suite 800
P.O. Box 1010
Lafayette, Indiana 47902-1010
Telephone: 765-423-1561
Fax: 765-742-8175
Attorney for Savitar Corporation

CERTIFICATE OF SERVICE

I certify that on the 24th day of July, 2002, service of a true and complete copy of the above and foregoing pleading or paper was made upon:

Mary M. Luria
DAVIS & GILBERT LLP
1740 Broadway
New York, NY 10019

by depositing the same in the United States mail in an envelope properly addressed and with sufficient first-class postage affixed.



Elizabeth B. Searle

Michael P. O'Malley
(908) 306-7791



July 1, 2002

VIA U.S. MAIL

Sandy M. Normington
Stuart & Branigin
300 Main Street, Suite 800
P.O. Box 1010
Lafayette, Indiana 47902

Re: **Savatar, Inc. v. Savitar Corporation, In the Matter of Ser. No. 76/245,902-OG 12/11/01**, United States Patent and Trademark Office
before the Trademark Trial and Appeal Board, Opposition No. 124,976

Dear Ms. Normington:

Per our conversation on June 24, 2002, I am writing to you in response to your subpoena dated April 24, 2002. Based on the limited information provided, we have reviewed our records for information relating to Savatar and asked relevant departments within our organization whether they have any such information. Unfortunately, we have been unsuccessful in locating any of the requested information concerning "**Savatar, Inc.**"

In the event that you can provide us with additional information relating to Savatar's relationship with Verizon Wireless (such as account information, VZW contacts, geographic location, etc.), we will perform a follow up review.

Please feel free to contact me if you should have any questions. My direct dial is (908) 306-7791.

Very truly yours,

A handwritten signature in black ink that reads "Michael P. O'Malley". The signature is written in a cursive style with a large, sweeping "M" and "O".

Michael P. O'Malley
Sr. Legal Analyst



Unilever

Stuart M. Cobert
Associate General Counsel - Litigation

May 29, 2002

VIA FACSIMILE

Sandy M. Normington
Paralegal
Stuart & Branigin
300 Main Street
Suite 800
Lafayette, IN 47902

Re: Savitar, Inc. v. Savitar Corporation

Dear Ms. Normington:

Conopco has conducted a reasonable good faith search for documents responsive to your subpoena in the above matter and we have located no responsive documents.

Sincerely,

Stuart M. Cobert

TTAB

**STUART &
BRANIGIN**
LLP
LAWYERS

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July 24, 2002

CERTIFIED MAIL

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Arlington, VA 22202-3513

02 AUG -1 AM 8:33
TRADEMARK TRIAL AND
APPEAL BOARD
07-29-2002
U.S. Patent & TMO/TM Mail Report #74

Re: Savatar, Inc. v. Savitar Corporation
Ser. No. 76/245,902 - OG 12/11/01
Opposition No. 124,976

Dear Sir:

Enclosed please find an original of Savitar's Reply in Support of Its Motion to Compel Documents from Opposer and in Opposition to Protective Order. Please file this document and return a proof of filing in the enclosed self-addressed, stamped envelope.

By copy of this letter, I am serving Opposer's counsel with a copy of this pleading. Thank you for your assistance in this matter.

Very truly yours,



Elizabeth B. Searle

EBS:sjc

Enclosures

cc: Mary M. Luria (w/ encl.)

282556.1

Reply to Lafayette Office

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