

EXPRESS MAIL LABEL NO.: EV343637172US

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

In the matter of Application Serial No. 75/845,350, INTELLIWEAR  
Published in the *Official Gazette* on October 30, 2001



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MARK D. TANNEN,	:	
	:	
Opposer,	:	
	:	Opposition No. 91151109
vs.	:	
	:	
JAY MACK,	:	
	:	
Applicant.	:	
-----X	:	

**OPPOSER'S REPLY TO APPLICANT'S OBJECTION TO OPPOSER'S  
MOTION TO EXTEND TIME TO OBJECT AND/OR RESPOND TO  
DISCOVERY AND TO EXTEND TERMS FOR DISCOVERY AND  
TESTIMONY AND OPPOSER'S OPPOSITION TO APPLICANT'S  
MOTION TO COMPEL REPOSSES TO DISCOVERY WITHOUT OBJECTION**

Opposer, Mark D. Tannen, doing business as American Intelliware, ("Opposer" or American Intelliware), respectfully submits this brief in reply and opposition to "Applicant's Objection to Opposer's Motion to Extend Time to Object and/or Respond to Discovery and to Extend Terms for Discovery and Testimony; Motion to Compel Response to Discovery Without Objections."<sup>1</sup>

Opposer requests that the Trademark Trial and Appeal Board ("Board") consider this reply in its determination of "Opposer's Motion to Extend Time to Object and/or Respond to Discovery and to Extend Terms for Discovery and Testimony." (Hereinafter "Motion to Extend") This reply is being submitted to address certain misleading or inappropriate characterizations and assertions set forth in the Applicant's Opposition. In sum, Opposer has set

<sup>1</sup> Hereinafter referred to as "Applicant's Opposition at \_\_\_\_".

forth good and sufficient cause in order for the Board to grant an extension in this case and has timely filed its motion for an extension.

With respect to Applicant's motion to compel discovery responses without objection, Opposer submits that the motion essentially calls for Opposer to be sanctioned despite the fact that it timely and properly moved for an extension of time when his requests for Applicant's consent to such extension went unanswered. Opposer has not violated any order of the Board and is within its rights to move for an extension. Moreover, Opposer served objections and responses to Applicant's document requests and interrogatories on August 25, 2003, essentially, mooted Applicant's motion to compel.<sup>2</sup> Applicant's motion should be denied. A more detailed discussion follows.

### ARGUMENT

#### **I. Opposer Has Good Cause To Seek an Extension**

Contrary to Applicant's assertions, Opposer has established the requisite goods cause for an eighteen (18) day extension of time to object and/or respond to Applicant's document requests 1-36 and Interrogatories numbered 1-31, which when all subparts were added, exceed the limit of 75.

Opposer's bases for requesting the extension were spelled out and sufficiently detailed in Opposer's Motion to Extend. Specifically, Opposer asserted:

The bases for the extension is that Opposer has been traveling and the discovery sought is extensive. Opposer requires

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<sup>2</sup> Copies of Opposer's objections and responses to Applicant's document requests and general objection to Applicant's interrogatories are attached as Exhibits 1 and 2 to the Declaration of Paul J. Reilly which is being submitted in support of Opposer's reply and opposition brief. (hereinafter "Reilly ¶ \_\_\_\_, Ex. \_\_\_\_"). While Opposer has objected generally to Applicant's interrogatories on the grounds that they exceed the limit of 75, Opposer is willing to raise specific objections and response if granted additional time or if Applicant will reserve a revised set of interrogatories not in excess of 75.

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additional time to review the discovery sought by Applicant and his files in order to properly object and/or respond to same.

(See Motion to Extend at 2) In his opposition, Applicant neglected to identify the full bases for Opposer's requested extension which are specific enough to warrant an extension.

For example, in the matter of The Toro Co. v. Grassmaster, Inc., 2001 WL 253601 (TTAB March 14, 2001), Opposer, The Toro Company, filed a motion to extend the deadline for responding to Applicant, Grassmaster, Inc.'s discovery requests, requesting an additional thirty (30) days. In support of its motion to extend, Toro stated that it was unable to respond to Grassmaster's outstanding discovery requests because the paralegal handling the requests had been out of town for part of the thirty-day response period, and because Toro needed additional time not only to determine the existence of files several decades old, but also to locate the files and review them for respective documents. Id. Grassmaster argued that Toro's motion did not demonstrate good cause. Id. The Board disagreed and held that Toro had shown good cause for the extension of its discovery response deadline. Id. The case presently before the Board is analogous and the extension should be granted.

Here, Applicant's document requests and numerous interrogatories call for documents and information concerning Opposer, his predecessor in interest, Opposer's business, his products and services and Opposer's use and registration of the AMERICAN INTELLIWARE Marks, among other things. Being that Applicant's discovery requests are unlimited as to any particular time, Opposer must search for files, documents and things and information dating back nearly two decades. Opposer is a sole proprietor.<sup>3</sup> He runs his own business with no other employees. (See Tannen ¶2) He handles all advertising, promotions,

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<sup>3</sup> See paragraphs one and two (¶¶1-2) of the Declaration of Mark D. Tannen submitted herewith and incorporated by reference herein in support of Opposer's Motion to Extend (hereinafter Tannen ¶\_\_\_\_")

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marketing and sales of the goods offered and services rendered in connection with the AMERICAN INTELLIWARE Marks. Id. Opposer travels often to market and promote his goods and services and provide onsite computer hardware and software services to his clients. Id. In fact, he was traveling during the majority of the time allotted to respond to Applicant's discovery. (See Tannen ¶3) As a result, it was and is difficult to respond to Applicant's discovery requests because Opposer must also commit significant time, effort and resources away from his business. (See Tannen ¶2) If it is difficult for a large corporation like Toro within many employees to respond to discovery within thirty (30) days because one of its paralegals is absent and years of files must be reviewed, it is even more of a burdensome to an individual businessman like Opposer to respond within such time.<sup>4</sup>

Accordingly, Opposer has good and sufficient cause for seeking a mere 18 day extension of time. Further, Opposer already served its objections and responses to Applicant's document requests and interrogatories on August 25, 2003, a mere two weeks after the initial due date, and produced over six hundred documents on August 27, 2003. (See Reilly Exs. A, B and C) All within the 18 day period initially requested. This is not unreasonable.

That Opposer sought an extension of time on August 8, three days, before his objections and responses were due does not evidence a lack of diligence, particularly in view of Opposer's business travel during the month of July. Indeed, Opposer's service of his objections and responses as well as over 600 documents (at his expense) within two weeks of seeking an

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4 The case of Baron Philippe de Rothschild, S.A. v. Styl-Rite Optical Mfg. Co, 55 U.S.P.Q.2d 1848 (TTAB) cited by Applicant is distinguishable. In Rothschild, the parties had postponed responding to each others discovery for over four years and there Applicant failed to serve its discovery responses by a date agreed upon with Opposer. Further at Opposer's request, the Board had issued an order compelling Applicant to serve its responses and it was from that order that Applicant was seeking additional time to serve its responses to Opposer's discovery requests. Here, proceedings have not been prolonged to such a degree; there was no agreement between the parties concerning the services of objections and responses to discovery; nor a Board order compelling discovery.

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extension demonstrates his strong desire to be as diligent as possible. Even if Opposer had sought an extension two weeks earlier, there is nothing to suggest that Applicant would have been more willing to grant an extension at that time with or without Opposer waiving his right to raise objections.<sup>5</sup>

Inapposite to Applicant’s conclusory allegations that Opposer has unreasonably delayed in responding to Applicant’s discovery, Opposer has presented good and sufficient cause for requesting the extension of time to raise objections and respond to Applicant’s document requests and interrogatories.

**II. Opposer Timely Filed His Motion Requesting an Extension**

Pursuant to TBMP §509.01, “a party may file a motion for an enlargement of time in which an act is required or allowed to be done.” (emphasis added) There is no dispute that Opposer’s motion for an extension of time to object and/or respond to Applicant’s discovery was due on August 11, 2003. Opposer timely filed its motion on August 11, 2003. Applicant’s assertion that Opposer motion was not timely filed is specious.

Applicant mistakenly claims that “because Opposer did not respond to the propounded discovery within 35 days, and because [Opposer’s] motion was not filed (based on the postmarked date) within 35 days, the time to respond or object may not be extended by Opposer’s late filed motion.” (Applicant’s Opposition at 6 (emphasis added)). Applicant incorrectly relies on the postmark appearing on the envelope of the service copy of the motion

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<sup>5</sup> Applicant asserts that on August 8, 2003 Opposer could have spoken with others at Applicant’s counsel’s offices in his counsel’s absence, but no one else was an attorney of record in this case authorized to grant Opposer’s consent. See TBMP § 114.03 (An attorney, as defined in 37 CFR § 10.1(c), will be accepted as a representative of a party in a proceeding before the Board if the attorney either (1) makes an appearance in the proceeding (as, for example, by filing a paper) on behalf of the party and satisfactorily identifies himself or herself as an attorney, or (2) files a written power of attorney signed by the party to the attorney represents.) Further, Applicant’s counsel of record never even contacted Opposer on August 11, 2003 after reviewing his email.

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and disregards the Certificate of Mailing which identifies that the motion was timely filed and served on August 11, 2003. (See Reilly ¶5)

Further, the return postcard from the Board, which is attached to Paul J. Reilly's Declaration, confirms that the Opposer's motion was timely filed on August 11, 2003. (See Reilly Declaration ¶5, Ex. D).

In view of the evidence submitted herewith, Opposer submits that its motion for an extension of time to raise objections and/or respond to Applicant's discovery requests was timely filed with the Board and should be granted.

**III. Opposer's Motion to Extend Discovery Should Be Granted**

Since this proceeding was initiated, Opposer has indicated his desire to have discovery and get to the merits of the case.

When the Board issued the initial scheduling order, it authorized 180 days for discovery as required by Trademark Rule 2.120, 37 C.F.R. §2.120. As a result of the filing of Applicant's motions to dismiss and for summary judgment on April 26, 2002, proceedings were suspended which in effect precluding discovery pending the disposition of Applicant's motions. The Board's order denied Applicant's motions and granted three month period for discovery, rather than 180 days.

Being that Opposer's initial motions to extend discovery were rendered moot by the Board's Order, this is Opposer's first substantive request to extend the discovery period for another ninety (90) days which would in effect merely provide Opposer with the allotted time typically granted in any opposition proceeding.<sup>6</sup>

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<sup>6</sup> On August 26, 2003, Opposer served document requests and interrogatories and the Board's rules clearly authorize the service of such discovery requests up to and including the last day of discovery. See TBMP §403.02. In addition, Opposer provided Applicant with a draft stipulated protective order in order to avoid withholding of confidential materials and further motion practice regarding same.

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In view of the foregoing, Opposer submits his motion for a ninety (90) day extension of the discovery period is reasonable and should be granted because it comports with the Board initial scheduling order and Trademark Rule 2.120(a) which states that the discovery period will be set for a period of 180 days.

**IV. Opposer Should Not Be Compelled to Answer Discovery Requests Without Object Since Opposer Has Responded to Applicant's Discovery**

In spite of Opposer's timely motion for an extension of time to object and/or respond to Applicant's document requests and interrogatories, Applicant seeks (i) an order compelling Opposer to respond to its discovery requests and (ii) an order imposing upon Opposer the sanction of forfeiting his right to raise objections to Applicant's discovery requests.

As noted above, Opposer has already served its objections and responses to Applicant's discovery requests rendering moot the motion to compel and leaving only Applicant's request for sanctions. Since Opposer has not violated any order of the Board, Applicant can only be moving for sanctions under Trademark Rule 2.120(g)(2), 37 C.F.R. §2.120(g)(2). Such a motion for sanctions is available "only where the responding party (1) has failed to respond, and (2) has informed the party seeking discovery that no response will be made." See Trademark Rule 2.120(g)(2), 37 C.F.R. §2.120(g)(2). Opposer has not failed to respond but rather has served responses and has never informed Applicant nor indicated in any way that no responses would be served. (See Reilly ¶2)

Accordingly, Opposer submits that the motion to compel is moot and the sanction of forfeiting its right to object unwarranted.

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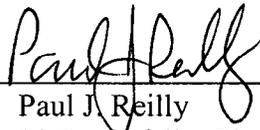
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**CONCLUSION**

In view of the foregoing, Opposer respectfully requests that its motion to extend time to object and/or respond to discovery be granted and that Applicant's motion to compel and for sanctions be denied.

Respectfully submitted,  
BAKER BOTTS L.L.P.

Dated: September 4, 2003

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