

MTAB

FAXED
7/31/03

CISLO & THOMAS LLP
Attorneys at Law
A PARTNERSHIP INCLUDING A PROFESSIONAL CORPORATION
SUITE 900
233 WILSHIRE BOULEVARD
SANTA MONICA, CALIFORNIA 90401

PROCUREMENT AND ENFORCEMENT
OF INTELLECTUAL PROPERTY

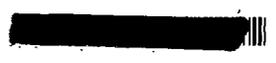
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July 31, 2003

VIA TELECOPIER AND FIRST CLASS MAIL
TRANSMISSION FAX NUMBER: (703) 308-9333
TOTAL PAGES: 48

Peter Cataldo; Interlocutory Attorney
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513



Re: Lawrence Music, Inc. v. Samick Music Corporation
Opposition No. 91-156,310
Our Docket No. 03-12289

08-04-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

Dear Mr. Cataldo:

Pursuant to your notice dated July 25, 2003 and your telephone conversation with our office on July 31, 2003, enclosed please find copies of Samick Music's Answer to Opposer's Notice of Opposition, Applicant's Opposition to Opposer's Motion to Suspend Proceeding and to Opposer's Request for Extension of Time to Oppose for Extraordinary Cause, and the supporting documents, as previously filed with the TTAB on June 23, 2003.

Please do not hesitate to call me if you have any questions or comments or if any other documents are needed in order to conclude this matter.

Very truly yours,

CISLO & THOMAS LLP

Daniel M. Cislo

03 SEP 15 AM 9:22
FEDERAL BUREAU OF INVESTIGATION
U.S. DEPARTMENT OF JUSTICE

DMC/SAB/sd

Enclosures

As listed above

Z:\TMD\03-12289\LTR CATALDO RE ANSWER TO OPPOSITION REDUX 073103.DOC

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08-04-2003

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #22

OPPOSITION Samick Music Corporation 03-12289
LAWRENCE MUSIC, INC. v. SAMICK MUSIC CORPORATION
Opposition No.: 91,156,310

25189

PATENT TRADEMARK OFFICE

RECEIVED THIS DAY BY THE U.S. PATENT AND TRADEMARK OFFICE, THE FOLLOWING:

- 1 Transmittal Letter (1 page);
- 2 Answer to Opposer's Notice of Opposition (7 pages);
- 3 Applicant's Opposition to Opposer's Motion to Suspend Proceeding and to Opposer's Request for Extension of Time to Oppose for Extraordinary Cause (6 pages);
- 4 Certificate of Express Mail EV 288347331 US
- 5 Acknowledgment Postcard

Declaration of Sarah A. Brown

Via Express Mail
23 June 2003
DMC/SAB:sd

Follow up 23 July 2003

z:\tmoca\03-12289\postcard re answer to opposition 062303.doc



06-23-2003

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #22

Kindly acknowledge receipt of above by stamping and returning this postcard.
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09/14/2003 11:45

OPPOSITION Samick Music Corporation 03-12289
LAWRENCE MUSIC, INC. v. SAMICK MUSIC CORPORATION
Opposition No.: 91,156,310



25189

PATENT TRADEMARK OFFICE

RECEIVED THIS DAY BY THE U.S. PATENT AND TRADEMARK OFFICE, THE FOLLOWING:

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Via Express Mail
23 June 2003
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<input type="checkbox"/> AM <input type="checkbox"/> PM	Int'l Alpha Country Code	Total Postage & Fees	\$	<input type="checkbox"/> WAVES OF SIGNATURE (Consent Only) Additional merchandise insurance is void if used. I, with delivery, to be made without obtaining signature of addressee or addressee's agent (if delivery employee judges that article can be left in secure location) and I authorize that delivery employee's signature constitutes valid proof of delivery.			
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You are making 3 copies.

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CISLO & THOMAS LLP

Attorneys at Law

A PARTNERSHIP INCLUDING A PROFESSIONAL CORPORATION

SUITE 900

233 WILSHIRE BOULEVARD

SANTA MONICA, CALIFORNIA 90401

(310) 451-0647

L. A. (323) 870-1163

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INTERNET WWW.CISLO.COM

PROCUREMENT AND ENFORCEMENT
OF INTELLECTUAL PROPERTY

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June 23, 2003

Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513
BOX TTAB NO FEE

Re: Opposition re Lawrence Music, Inc. v. Samick Music Corporation
Opposition No. 91,156,310
Serial No. 76/342,386
Our Docket No. 03-12289

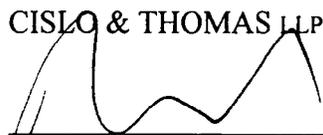
Dear Sir/Madam:

Please find enclosed an Answer to Opposer's Notice of Opposition, Applicant's Opposition to Opposer's Motion to Suspend Proceeding and to Opposer's Request for Extension of Time to Oppose for Extraordinary Cause, declaration of Sarah A. Brown and a certificate of express mail for the above referenced matter. Kindly acknowledge receipt thereof by returning the enclosed postcard.

It is our belief that no fees are due at this time, however, any additional fees which may be required may be charged to our deposit account no. 03-2030.

Very truly yours,

CISLO & THOMAS LLP


Daniel M. Cislo

DMC/SAB/sd

Enclosures

Answer to Opposer's Notice of Opposition
Applicant's Opposition to Opposer's Motion to Suspend Proceeding and to Opposer's Request for Extension of Time to Oppose for Extraordinary Cause
Declaration of Sarah A. Brown
Certificate of Express Mail
Acknowledgement Postcard

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

**IN THE MATTER OF APPLICATION SERIAL NO. 76/342,386
PUBLISHED IN THE OFFICIAL GAZETTE ON DECEMBER 31, 2002**

LAWRENCE MUSIC, INC., a Pennsylvania corporation,)	OPPOSITION NO. 91,156,310
)	
OPPOSER,)	
vs.)	
)	ANSWER TO OPPOSER'S NOTICE OF
)	OPPOSITION
SAMICK MUSIC CORPORATION, California corporation,	a)	
)	
APPLICANT.)	
)	

Applicant, Samick Music Corporation, ("Applicant"), hereby responds to Opposer Lawrence Music, Inc.'s ("Opposer") Notice of Opposition as follows:

1. As to Paragraph 1 of the Notice of Opposition, Applicant lacks information sufficient to truthfully admit or deny the averment and therefore denies each and every allegation in Paragraph 1 of the Notice of Opposition.

2. As to Paragraph 2 of the Notice of Opposition, Applicant admits that it is a California corporation. Applicant's business name is "Samick Music Corporation," with a business address of 18521 Railroad Street, City of Industry, California, 91748.

06/10/2008TTAD

Applicant therefore denies the remaining averments in Paragraph 2 of the Notice of Opposition.

3. As to Paragraph 3 of the Notice of Opposition, Applicant is aware that Opposer has opposed registration of U.S. Trademark Application No. 76/342,386. Applicant lacks information sufficient to truthfully admit or deny the remaining averments in Paragraph 3 of the Notice of Opposition and therefore denies each and every remaining allegation therein.

4. As to Paragraph 4 of the Notice of Opposition, Applicant admits that Opposer and Applicant are parties in Civil Case No. 01 1029, in the Western District of Pennsylvania. As to the remaining averments in Paragraph 4 of the Notice of Opposition, Applicant either lacks information sufficient to truthfully admit or deny the allegations, or Opposer's averments are so unclear, ambiguous and compound to the point that Applicant cannot truthfully admit or deny the remaining allegations in Paragraph 4 of the Notice of Opposition. Applicant therefore denies each and every remaining allegation set forth in Paragraph 4 of the Notice of Opposition.

AFFIRMATIVE DEFENSES

Applicant, Samick Music Corporation, asserts the following affirmative defenses, reserving the right to modify and expand these affirmative defenses up to and throughout the time of adjudication.

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5. Paragraphs 1-4 of Applicant's Answer are hereby incorporated in their entirety to these affirmative defenses by reference.

6. Opposer has filed a Notice of Opposition against Applicant's Application Serial No. 76/342,386 alleging that Applicant has abandoned its trademark. Applicant affirmatively alleges that it has not abandoned its mark because, *inter alia*, the mark that is the subject of Applicant's Application Serial No. 76/342,386 has been in continuous use and has not been subject to a period of non-use with no intent to resume use of the mark.

7. Opposer has also asserted that it is the "senior user to the mark in question for the goods claimed in the applicant [sic]." Applicant affirmatively alleges that it, and not Opposer, is the prior user of the mark covered by Application Serial No. 76/342,386, which is the subject of the instant opposition. Upon information and belief, Applicant alleges that Opposer was aware of this fact upon filing the instant opposition. Opposer admitted in a proceeding in the Federal District Court, Western District of Pennsylvania (Civil Case No. 01 1029) that Applicant was the prior user of the SAMICK mark. (see Exhibit A, Opposer's Response to Request for Admission No. 11, attached herein and the Declaration of Sarah A. Brown in support thereof).

09/10/2000TTAD

8. Upon information and belief, Opposer's pleadings in this proceeding are being presented to harass Applicant, to cause unnecessary delay and needless increase in the cost of litigation, and its allegations are lacking in likely evidentiary support, all in violation of TBMP §314 and §529.01.

9. In view of the foregoing, Applicant contends that this opposition is groundless and baseless in fact and that Opposer has not shown in any manner whatsoever wherein it will be, or is likely to be, damaged by the registration of Applicant's trademark, i.e. Opposer has failed to allege grounds sufficient to establish standing and to maintain the Opposition.

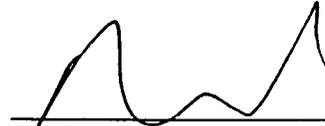
WHEREFORE, Applicant prays that:

- (a) The Opposition against U.S. Trademark Application No. 76/342,386 be dismissed in its entirety and that registration issue to Applicant for its mark.

Please apply any charges or credits to Deposit Account No. 03-2030.

Respectfully submitted,

Date: June 23rd, 2003



Daniel M. Cislo, Esq.

CISLO & THOMAS LLP
233 Wilshire Boulevard, Suite 900
Santa Monica, California 90401
Telephone: (310) 451-0647
Telefax: (310) 394-4477

Attorney for Applicant

Z:\TMD\DOCS\03-12289\ANSWER TO NOTICE OF OPPOSITION 061803.DOC

CERTIFICATE OF SERVICE

I hereby certify that I caused a true and correct copy of the foregoing Answer to Opposer's Notice of Opposition to be served this 23 day of June, 2003, by First Class U.S. Mail, postage prepaid, on counsel for Opposer, Lawrence Music, Inc., as follows:

Gregg Zegarelli, Esquire
Technology & Entrepreneurial
Ventures Law Group P.C.
Allegheny Building, 12th Floor
429 Forbes Avenue
Pittsburgh, Pennsylvania 15219-1616

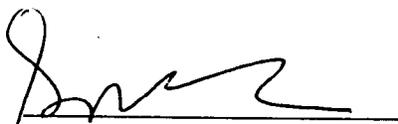

Sharon Duncan

Express
CERTIFICATE OF FIRST CLASS MAILING

I hereby certify that the original and one (1) copy of this document is being deposited with the United States Postal Service as *EXPRESS MAIL* ~~First Class Mail~~, postage affixed, in an envelope addressed to:

BOX TTAB NO FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Dated: June 23, 2003



Sarah A. Brown
Reg. No. 47,455

CISLO & THOMAS LLP
233 Wilshire Boulevard, Suite 900
Santa Monica, California 90401-1211
Tel: (310) 451-0647
Fax: (310) 394-4477
www.cislo.com

Z:\TMDOCS\03-12289\ANSWER TO NOTICE OF OPPOSITION 061803.DOC

EXHIBIT A

09/19/2000TTAD

612

**UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF PENNSYLVANIA**

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3
4 **LAWRENCE MUSIC, INC., a Pennsylvania**)
5 **corporation,**)

6
7 **Plaintiff,**)

8 **vs.**)

9
10 **SAMICK MUSIC CORPORATION, a**)
11 **California corporation,**)

12
13 **Defendant**)

14
15 **SAMICK MUSIC CORPORATION, a**)
16 **California corporation,**)

17
18 **Counterclaimant,**)

19 **vs.**)

20
21 **LAWRENCE MUSIC, INC., a Pennsylvania**)
22 **corporation,**)

23
24 **Counter Defendant.**)
25
26
27
28

CASE NO. 1029

**DEFENDANT'S FIRST SET OF
REQUEST FOR ADMISSIONS TO
PLAINTIFF**

09/10/2000 07:00
CV 11000703700
SUITÉ 900
233 WILSHIRE BOULEVARD
SANTA MONICA, CALIFORNIA 90401
TELEPHONE: (310) 451-0847
FACSIMILE: (310) 394-4477

1 Request for Admission Number 10.

2 Admit that You have sold Non-Samick goods through the SAMICKGUITARS.COM
3 Internet site.

4
5 Request for Admission Number 11.

6 Admit that, as to You and Samick, that Samick is the prior user of the SAMICK marks.

7
8 Request for Admission Number 12.

9 Admit that a significant purpose of a domain name is to identify the entity that owns the
10 Internet site.

11
12 Request for Admission Number 13.

13 Admit that you know of no written document or tangible communication in which
14 Samick gives You express permission to use the SAMICKGUITARS.COM domain name in
15 connection with Your business or services.

16
17 Request for Admission Number 14.

18 Admit that you do not possess a written document memorializing the alleged September
19 1999 royalty-free license to use the Domain Name, which is referred to in Paragraph 18 of
20 Your Amended Complaint.

21
22 Request for Admission Number 15.

23 Admit that you know of no written document or tangible communication in which
24 Samick gives You implied permission to the SAMICKGUITARS.COM domain name in
25 connection with Your business or services.

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Leland P. Schermer, Esq.
LELAND SCHERMER & ASSOCIATES
11 Stanwix Street, 7th Floor
Pittsburgh, Pennsylvania 15222
Telephone: (412) 642-5000
Telefax: (412) 642-5010

Attorneys for Defendant/Counterclaimant,
SAMICK MUSIC CORPORATION

\\NTSERVER\ARCHIVE\TMD\DOCS\01-10260\SAMICK 1ST SET OF REQ FOR ADMISSIONS 051502.DOC

SANTA MONICA, CALIFORNIA 90401
TELEPHONE: (310) 451-0847
FACSIMILE: (310) 394-4477

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PROOF OF SERVICE

I am over the age of eighteen (18) years, employed in the County of Los Angeles, and not a party to the above-entitled action. My business address is 233 Wilshire Boulevard, Suite 900, Santa Monica, California 90401.

On Thursday, May 16, 2002, I served:

DEFENDANT'S FIRST SET OF REQUESTS FOR ADMISSIONS TO PLAINTIFF

addressed as follows to:

Gregg R. Zegarelli, Esquire
Technology & Entrepreneurial
Ventures Law Group, P.C.
Allegheny Building, 12th Floor
Pittsburgh, PA 15219-1616
Telephone: (412) 765-0401
Telefax: (412) 765-0531

BY MAIL: I am readily familiar with the Firm's practice of collecting and processing correspondence for mailing. Under that practice, it would be deposited with the United States Postal Service on the same day with a postage thereon fully prepaid at Santa Monica, California, in the ordinary course of business. I am aware that, on the motion of the party served, service is presumed invalid if the postal cancellation date or postage meter date is more than one (1) day after the date of deposit for mailing shown on this proof of service.

BY FEDERAL EXPRESS/OVERNIGHT DELIVERY: I caused a copy of such document to be sent via overnight delivery to the office(s) of the addressee(s) shown above.

BY FACSIMILE: I caused a copy of such document to be sent via facsimile machine to the office(s) of the addressee(s) at the phone number(s) shown above.

BY PERSONAL SERVICE

FEDERAL COURT: I caused such envelope to be delivered by hand to the offices of the addressee(s).

STATE COURT: I caused such envelope to be delivered by hand to the offices of the addressee(s).

FEDERAL: I declare, under penalty of perjury under the laws of the United States that the foregoing is true and that I am employed in the office of a member of the Bar of this Court at whose direction the service was made.

Executed on Thursday, May 16, 2002, at Santa Monica, California.


Sharon Duncan, Legal Assistant

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF PENNSYLVANIA

LAWRENCE MUSIC, INC.,

CIVIL ACTION NUMBER: 01 1029

Plaintiff,

Hon. William L. Standish

v.

SAMICK MUSIC CORPORATION,

Defendant.

PLAINTIFF'S RESPONSE TO DEFENDANT'S FIRST SET OF REQUEST FOR ADMISSION

GENERAL OBJECTIONS

Applicant identifies the following General Objections. One or more General Objections are referred to in certain of Plaintiff's specific responses to Defendant's discovery requests, and any said reference to General Objections shall be deemed to be incorporated into the specific response by the existence of the reference thereto. Objections shall be deemed to be supplemental to each other and not contradictory to the fullest extent possible. All responses are made subject to the objections and without waiver thereof. Also, the nature of the requests require significant duplication of responses, and an indexing method has been used to facilitate organization of responses; however, the response to any request at issue shall not be deemed to be exclusive of the applicability of any other response to the request at issue.

1. Burdensomeness.

Plaintiff objects to certain of Defendant's discovery requests as a whole and to specific individual requests on the grounds that they are oppressive, vexatious, duplicative, overbroad, burdensome and calculated, as a practical matter, to harass Plaintiff rather than to lead to the discovery of admissible evidence. Plaintiff objects to certain of Defendant's discovery requests to the extent they are repetitive or request information already in Defendant's possession or are available as public records.

2. Vagueness.

Plaintiff objects to certain of Defendant's discovery requests to the extent that they are so vague that a reasoned response cannot be framed thereto.

RESPONSES

Plaintiff hereby incorporates into this response the Deposition of Bradford R. Johnson, June 18, 2002 and June 19, 2002, with the full interrogation by Counsel for Defendant, and the review with the deponent of documents produced. As a result of said deposition, and Plaintiff's production of documents, the request for admissions is duplicative of the questions asked at said deposition, Plaintiff's answers to the averments of Defendant in the pleadings, affirmative defenses of Plaintiff and the other discovery responses of Plaintiff, except as otherwise provided below. Plaintiff incorporates its answers to Defendants averments in its counterclaim, Plaintiff's affirmative defenses, responses to Defendant's Request for Production and its responses to Defendant's Interrogatories. Plaintiff hereby refers to and incorporates General Objection 1.

Subject to said objection and the above, Plaintiff additionally responds to certain requests below. If Defendant believes that the combination of the responses in said deposition, other discovery responses, and the responses below do not fulfill Plaintiff's obligation under the Federal Rules of Civil Procedure, Defendant is requested to discuss that matter prior to filing a Motion to Compel.

For ease of reference, there are generally three categories of responses that are referred to:

RESPONSE CATEGORY A:

Plaintiff hereby refers to and incorporates the preamble and General Objection 1. Subject to said objection, and subject to the limitations and objections in the deposition testimony, Plaintiff qualifiedly admits the request.

RESPONSE CATEGORY D:

Plaintiff hereby refers to and incorporates the preamble and General Objection 1. Subject to said objection, and subject to the deposition testimony, Plaintiff denies the request.

RESPONSE CATEGORY K:

Plaintiff hereby refers to and incorporates General Objection 1 and 8. Discovery is continuing, Plaintiff is without information or knowledge sufficient to form a belief.

RESPONSE #1-2, 4, 6, 8, 21, 25, 29, 30, 31, 32, 35, 40, 42, 43, 44, 45.

Plaintiff hereby incorporates Response Category A.

RESPONSE #3, 5, 12, 15, 16, 17, 20, 27, 28, 36, 37, 38, 39, 41, 46.

Plaintiff hereby incorporates Response Category D.

RESPONSE #7

Plaintiff admits having discussed settlement amounts with Defendant.

RESPONSE #9-10, 22

Plaintiff hereby incorporates Response Category A, but not competing goods.

RESPONSE #11

Plaintiff hereby incorporates Response Category A, except that Samick is not the prior user of "samickguitars.com".

RESPONSE #13, 14

Plaintiff hereby incorporates Response Category A in that Plaintiff relies upon the express permission of Defendant by way of verbal communications of Dee Hoyte and John Wobbe with Plaintiff and the course of conduct between and among them.

RESPONSE #18

Plaintiff hereby incorporates Response Category A to the extent that Plaintiff is licensed to sell the Samick guitars on the subject website and the domain name is "samickguitars.com".

RESPONSE #19

Plaintiff hereby incorporates Response Category D. Plaintiff was requested by Defendant to make the changes identified, and Plaintiff used Defendant's "PRS" designation.

RESPONSE #23

Plaintiff hereby incorporates Response Category D; Defendant was on or about May 25, 2001.

RESPONSE #24, 26, 30

Plaintiff hereby incorporates Response Category A, except that the back references for each is understood to mean #23, 25 and 29, respectively.

RESPONSE #33

Plaintiff hereby incorporates Response Category K.

RESPONSE #34

Plaintiff hereby incorporates Response Category A, except the reference is "SamickGuitars.com is a division of Lawrence Music, Inc.".

Respectfully submitted,

Gregg R. Zegarelli, Esq.
Attorney for Plaintiff
Z E G A R E L L I
Technology & Entrepreneurial
Law Ventures Group, P.C.
Allegheny Building, 12th Floor
Pittsburgh, PA 15219-1616
412.765.0401
grz@zegarelli.com

09/14/2000TTAD

VERIFICATION

Bradford R. Johnson, President of Lawrence Music, Inc., aver that the statements and facts contained in the attached document are true and correct to the best of my information, knowledge and belief and are made subject to the penalties of 18 Pa. Cons. Stat. Ann. § 4904 relating to unsworn verification to authorities.

LAWRENCE MUSIC, INC.

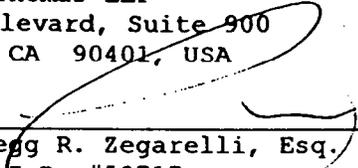
Date: June 20, 2000


Bradford R. Johnson
President

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing document was served on the following person this 20th day of June, 2002, by depositing the same in the United States Mail, First Class, Postage Pre-Paid, upon the following:

Daniel M. Cislo, Esq.
Cislo & Thomas LLP
233 Wilshire Boulevard, Suite 900
Santa Monica, CA 90401, USA



Gregg R. Zegarelli, Esq.
PA I.D. #52717
Attorney for Plaintiff

Z E G A R E L L I
Technology & Entrepreneurial
Ventures Law Group, P.C.
Allegheny Building, 12th Floor
Pittsburgh, PA 15219-1616
412.765.0401

00/10/2000TTAD

in Civil Action 01 1029, titled *Lawrence Music, Inc. v. Samick Music Corporation* (U.S. Federal District Court, Western District of Pennsylvania).

I declare under penalty of perjury that the foregoing statements made of my own knowledge are true and correct and that all statements made on information and belief are believed to be true and correct.

Executed on June 23, 2003 in Santa Monica, California.



Sarah A. Brown

09/14/2003TTAB

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

**IN THE MATTER OF APPLICATION SERIAL NO. 76/342,386
PUBLISHED IN THE OFFICIAL GAZETTE ON DECEMBER 31, 2002**

LAWRENCE MUSIC, INC., a Pennsylvania corporation,)	OPPOSITION NO. 91,156,310
)	
)	
OPPOSER,)	
)	
vs.)	APPLICANT'S OPPOSITION TO
)	OPPOSER'S MOTION TO SUSPEND
SAMICK MUSIC CORPORATION, California corporation,	a)	PROCEEDING AND TO OPPOSER'S
)	REQUEST FOR EXTENSION OF TIME
)	TO OPPOSE FOR EXTRAORDINARY
APPLICANT.)	CAUSE
)	

Applicant, Samick Music Corporation, by and through its counsel, hereby opposes Opposer's Motion to Suspend the instant proceedings and for Extension of Time to Oppose for Extraordinary Cause.

After two extension requests, totaling approximately three (3) months, Opposer filed the instant opposition on April 29, 2003 claiming that it would be damaged "for the reasons set forth in the pleadings filed by it in the United States District Court for the Western District of Pennsylvania, *Lawrence Music, Inc. v. Samick Music Corporation*, Case No. 01 1029, in which Opposer is Plaintiff (Notice of Opposition at ¶4, p. 1-2). Opposer based its request to suspend the instant opposition, filed by Opposer, because "[i]t is the usual practice of the Trademark Trial and Appeal Board to stay registration proceedings pending the outcome of

09/10/2000TTAB

court actions...” (Notice of Opposition at ¶2, p. 1-2). Opposer filed its request to suspend the instant proceedings on June 13, 2003.

The Trademark Rules provide for the suspension of Board proceedings.

- a) Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceedings which *may have a bearing on the case*, proceedings before the Board *may* be suspended until termination of the civil action or the other Board proceeding. 37 CFR §2.117, TBMP 510(a) (emphasis added).

Opposer’s conclusion that the Board automatically suspends proceedings when civil litigation is pending between the parties involved in an inter partes proceeding is manifestly incorrect. Suspension under such circumstances is granted only after both parties have been heard on the question and the Board has carefully reviewed the pleadings in the civil suit to determine if the outcome thereof will have a bearing on the question of the rights of the parties in the TTAB proceeding. *Martin Beverage Co., Inc. v. Colita Beverage Corp.*, 169 USPQ 518, 570 (TTAB 1971.) Manifestly, this does not constitute a policy of automatically suspending a TTAB proceeding when civil litigation is pending between the parties. Id.

The Board is an administrative tribunal which is empowered to determine only the right to register; it may not determine the right to use, or broader questions of infringement or unfair competition. See TBMP §102.01. Thus, a plaintiff in a proceeding before the board can attack only the defendant’s right to register.

09/10/2008TTAB

In the instant case, the civil action that Opposer relies upon for suspension is based upon Applicant's claim that Opposer infringed its marks. Apparently, the only common question to both proceedings involves Opposer's unfounded allegation that Applicant abandoned its mark. Opposer has made numerous allegations in the instant opposition, which will not be addressed in the civil proceedings. It would be unfair to Applicant to delay issuance of its registration when a decision in the civil action would have little bearing on the Opposition and would not decide all of the issues presented therein. Should Opposer's Motion to Suspend be granted, Applicant would unfairly have to wait until a final decision is rendered in the civil proceedings and then would have to proceed through an opposition at the TTAB. The TTAB proceedings are unlikely to be shortened in any significant way because there are minimal issues in common to both proceedings and the Board will have to address numerous issues not addressed in the civil action.

Further, TBMP 314 and 529.01 prohibit filing and advocating any pleading, paper or Motion presented to harass, cause unnecessary delay or needless increase in the cost of litigation. Parties are also prohibited from presenting allegations that are unlikely to have evidentiary support.

The instant Opposition, Opposer's previous requests for extensions, its Request for Extension of Time to Oppose for Extraordinary Cause, and the instant Motion for Suspension of Proceedings are all undisguised attempts to unnecessarily delay issuance of Applicant's registration, and to harass Applicant. Such tactics on Opposer's part are evidenced by, for example, its claim in its Notice of Opposition that it is "the senior user" of the mark at issue. In the civil action relied upon by Opposer in the instant Motion to Suspend, however, Opposer admitted, pursuant to Federal Rule of Civil Procedure 36, that it was not the prior user of the

SAMICK mark (see Exhibit A, attached herein and the declaration of Sarah A. Brown in support thereof).

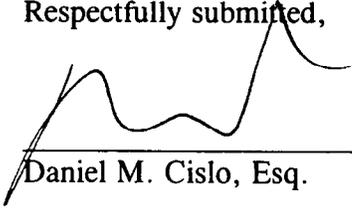
As such, Opposer has at the very least presented allegations in its Notice of Opposition that contradict its own prior admissions, and has presented allegations that it knows are lacking in evidentiary support. Further, as noted, Applicant maintains that the instant Motion to Suspend, as well as the instant Opposition, were filed to cause unnecessary delay and to harass Applicant.

Applicant additionally objects to Opposer's Request for Extension of Time for the reasons noted above and because Opposer's request, for all practical purposes, appears to be a Motion. Opposer has not served the Motion upon Applicant, nor has it included a proof of service with the request, as required by 37 C.F.R. §2.119(a)(b) and TBMP §113.

Wherefore Applicant prays that Opposer's Motion to Suspend the Proceedings be DENIED and that Opposer's Request for Extension of Time to Oppose for Extraordinary Cause be DENIED.

Respectfully submitted,

Date: June ^{23rd} __, 2003



Daniel M. Cislo, Esq.

CISLO & THOMAS LLP
233 Wilshire Boulevard, Suite 900
Santa Monica, California 90401
Telephone: (310) 451-0647
Telefax: (310) 394-4477

Attorney for Applicant

CERTIFICATE OF SERVICE

I hereby certify that I caused a true and correct copy of the foregoing Applicant's Opposition to Opposer's Motion to Suspend Proceeding and to Opposer's Request for Extension of Time to Oppose for Extraordinary Cause to be served this 23 day of June, 2003, by First Class U.S. Mail, postage prepaid, on counsel for Opposer, Lawrence Music, Inc., as follows:

Gregg Zegarelli, Esquire
Technology & Entrepreneurial
Ventures Law Group P.C.
Allegheny Building, 12th Floor
429 Forbes Avenue
Pittsburgh, Pennsylvania 15219-1616


Sharon Duncan

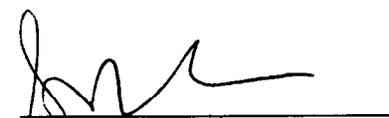
06/19/2003TTAB

EXPRESS
CERTIFICATE OF FIRST CLASS MAILING

I hereby certify that the original and one (1) copy of this document is being deposited with the United States Postal Service as ^{EXPRESS}~~First Class~~ Mail, postage affixed, in an envelope addressed to:

BOX TTAB NO FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Dated: June 23, 2003



Sarah A. Brown
Reg. No. 47,455

CISLO & THOMAS LLP
233 Wilshire Boulevard, Suite 900
Santa Monica, California 90401-1211
Tel: (310) 451-0647
Fax: (310) 394-4477
www.cislo.com

Z:\TMDOCS\03-12289\OPPOSITION TO MOTION TO SUSPEND.DOC

C C

EXHIBIT A

09/10/2000TTAD

66

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF PENNSYLVANIA

LAWRENCE MUSIC, INC., a Pennsylvania
corporation,

Plaintiff,

vs.

SAMICK MUSIC CORPORATION, a
California corporation,

Defendant

CASE NO. 1029

**DEFENDANT'S FIRST SET OF
REQUEST FOR ADMISSIONS TO
PLAINTIFF**

SAMICK MUSIC CORPORATION, a
California corporation,

Counterclaimant,

vs.

LAWRENCE MUSIC, INC., a Pennsylvania
corporation,

Counter Defendant.

09/10/2000TTAD

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1 Request for Admission Number 10.

2 Admit that You have sold Non-Samick goods through the SAMICKGUITARS.COM
3 Internet site.

4
5 Request for Admission Number 11.

6 Admit that, as to You and Samick, that Samick is the prior user of the SAMICK marks.
7

8 Request for Admission Number 12.

9 Admit that a significant purpose of a domain name is to identify the entity that owns the
10 Internet site.

11
12 Request for Admission Number 13.

13 Admit that you know of no written document or tangible communication in which
14 Samick gives You express permission to use the SAMICKGUITARS.COM domain name in
15 connection with Your business or services.

16
17 Request for Admission Number 14.

18 Admit that you do not possess a written document memorializing the alleged September
19 1999 royalty-free license to use the Domain Name, which is referred to in Paragraph 18 of
20 Your Amended Complaint.

21
22 Request for Admission Number 15.

23 Admit that you know of no written document or tangible communication in which
24 Samick gives You implied permission to the SAMICKGUITARS.COM domain name in
25 connection with Your business or services.

26
27 ///

28 ///

091100037037790
SUITE 900
233 WILSHIRE BOULEVARD
SANTA MONICA, CALIFORNIA 90401
TELEPHONE: (310) 451-0647 FACSIMILE: (310) 394-4477

1 Request for Admission Number 43.

2 Admit that You have not ordered goods from Samick since October 31, 2001.

4 Request for Admission Number 44.

5 Admit that You have not ordered goods from Samick since October 1, 2001.

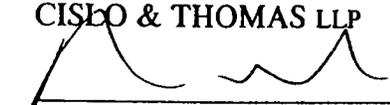
7 Request for Admission Number 45.

8 Admit that the document attached herein as Exhibit C is a true and correct copy of the
9 document with Your signature.

11 Request for Admission Number 46.

12 Admit that the document attached herein as Exhibit D is a true and correct copy of the
13 document with Your signature.

20 Dated: May 16th, 2002

18 Respectfully submitted,
19 CISLO & THOMAS LLP
20 By: 
21 Daniel M. Cislo, Esq.
22 No. 125,378
23 Sarah A. Brown, Esq.
24 No. 200,442
25 CISLO & THOMAS LLP
26 233 Wilshire Boulevard, Suite 900
27 Santa Monica, California 90401
28 Telephone: (310) 451-0647
Telefax: (310) 394-4477

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Leland P. Schermer, Esq.
LELAND SCHERMER & ASSOCIATES
11 Stanwix Street, 7th Floor
Pittsburgh, Pennsylvania 15222
Telephone: (412) 642-5000
Telefax: (412) 642-5010

Attorneys for Defendant/Counterclaimant,
SAMICK MUSIC CORPORATION

\\NTSERVER\ARCHIVE\TMD\DOCS\01-10260\SAMICK 1ST SET OF REQ FOR ADMISSIONS 051502.DOC

233 MILBURN BOULEVARD
SANTA MONICA, CALIFORNIA 90401
TELEPHONE: (310) 451-0647 FACSIMILE: (310) 394-4477

09/10/2002 11:00 AM
233 WILSHIRE BOULEVARD
SANTA MONICA, CALIFORNIA 90401
TELEPHONE: (310) 451-0647
FACSIMILE: (310) 394-4477

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PROOF OF SERVICE

I am over the age of eighteen (18) years, employed in the County of Los Angeles, and not a party to the above-entitled action. My business address is 233 Wilshire Boulevard, Suite 900, Santa Monica, California 90401.

On Thursday, May 16, 2002, I served:

DEFENDANT'S FIRST SET OF REQUESTS FOR ADMISSIONS TO PLAINTIFF

addressed as follows to:

Gregg R. Zegarelli, Esquire
Technology & Entrepreneurial
Ventures Law Group, P.C.
Allegheny Building, 12th Floor
Pittsburgh, PA 15219-1616
Telephone: (412) 765-0401
Telefax: (412) 765-0531

BY MAIL: I am readily familiar with the Firm's practice of collecting and processing correspondence for mailing. Under that practice, it would be deposited with the United States Postal Service on the same day with a postage thereon fully prepaid at Santa Monica, California, in the ordinary course of business. I am aware that, on the motion of the party served, service is presumed invalid if the postal cancellation date or postage meter date is more than one (1) day after the date of deposit for mailing shown on this proof of service.

BY FEDERAL EXPRESS/OVERNIGHT DELIVERY: I caused a copy of such document to be sent via overnight delivery to the office(s) of the addressee(s) shown above.

BY FACSIMILE: I caused a copy of such document to be sent via facsimile machine to the office(s) of the addressee(s) at the phone number(s) shown above.

BY PERSONAL SERVICE

FEDERAL COURT: I caused such envelope to be delivered by hand to the offices of the addressee(s).

STATE COURT: I caused such envelope to be delivered by hand to the offices of the addressee(s).

FEDERAL: I declare, under penalty of perjury under the laws of the United States that the foregoing is true and that I am employed in the office of a member of the Bar of this Court at whose direction the service was made.

Executed on Thursday, May 16, 2002, at Santa Monica, California.


Sharon Duncan, Legal Assistant

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF PENNSYLVANIA

LAWRENCE MUSIC, INC.,

CIVIL ACTION NUMBER: 01 1029

Plaintiff,

Hon. William L. Standish

v.

SAMICK MUSIC CORPORATION,

Defendant.

PLAINTIFF'S RESPONSE TO DEFENDANT'S FIRST SET OF REQUEST FOR ADMISSION

GENERAL OBJECTIONS

Applicant identifies the following General Objections. One or more General Objections are referred to in certain of Plaintiff's specific responses to Defendant's discovery requests, and any said reference to General Objections shall be deemed to be incorporated into the specific response by the existence of the reference thereto. Objections shall be deemed to be supplemental to each other and not contradictory to the fullest extent possible. All responses are made subject to the objections and without waiver thereof. Also, the nature of the requests require significant duplication of responses, and an indexing method has been used to facilitate organization of responses; however, the response to any request at issue shall not be deemed to be exclusive of the applicability of any other response to the request at issue.

1. **Burdensomeness.**

Plaintiff objects to certain of Defendant's discovery requests as a whole and to specific individual requests on the grounds that they are oppressive, vexatious, duplicative, overbroad, burdensome and calculated, as a practical matter, to harass Plaintiff rather than to lead to the discovery of admissible evidence. Plaintiff objects to certain of Defendant's discovery requests to the extent they are repetitive or request information already in Defendant's possession or are available as public records.

2. **Vagueness.**

Plaintiff objects to certain of Defendant's discovery requests to the extent that they are so vague that a reasoned response cannot be framed thereto.

RESPONSES

Plaintiff hereby incorporates into this response the Deposition of Bradford R. Johnson, June 18, 2002 and June 19, 2002, with the full interrogation by Counsel for Defendant, and the review with the deponent of documents produced. As a result of said deposition, and Plaintiff's production of documents, the request for admissions is duplicative of the questions asked at said deposition, Plaintiff's answers to the averments of Defendant in the pleadings, affirmative defenses of Plaintiff and the other discovery responses of Plaintiff, except as otherwise provided below. Plaintiff incorporates its answers to Defendants averments in its counterclaim, Plaintiff's affirmative defenses, responses to Defendant's Request for Production and its responses to Defendant's Interrogatories. Plaintiff hereby refers to and incorporates General Objection 1.

Subject to said objection and the above, Plaintiff additionally responds to certain requests below. If Defendant believes that the combination of the responses in said deposition, other discovery responses, and the responses below do not fulfill Plaintiff's obligation under the Federal Rules of Civil Procedure, Defendant is requested to discuss that matter prior to filing a Motion to Compel.

For ease of reference, there are generally three categories of responses that are referred to:

RESPONSE CATEGORY A:

Plaintiff hereby refers to and incorporates the preamble and General Objection 1. Subject to said objection, and subject to the limitations and objections in the deposition testimony, Plaintiff qualifiedly admits the request.

RESPONSE CATEGORY D:

Plaintiff hereby refers to and incorporates the preamble and General Objection 1. Subject to said objection, and subject to the deposition testimony, Plaintiff denies the request.

RESPONSE CATEGORY K:

Plaintiff hereby refers to and incorporates General Objection 1 and 8. Discovery is continuing, Plaintiff is without information or knowledge sufficient to form a belief.

RESPONSE #1-2, 4, 6, 8, 21, 25, 29, 30, 31, 32, 35, 40, 42, 43, 44, 45.

Plaintiff hereby incorporates Response Category A.

RESPONSE #3, 5, 12, 15, 16, 17, 20, 27, 28, 36, 37, 38, 39, 41, 46.

Plaintiff hereby incorporates Response Category D.

RESPONSE #7

Plaintiff admits having discussed settlement amounts with Defendant.

RESPONSE #9-10, 22

Plaintiff hereby incorporates Response Category A, but not competing goods.

RESPONSE #11

Plaintiff hereby incorporates Response Category A, except that Samick is not the prior user of "samickguitars.com".

RESPONSE #13, 14

Plaintiff hereby incorporates Response Category A in that Plaintiff relies upon the express permission of Defendant by way of verbal communications of Dee Hoyte and John Wobbe with Plaintiff and the course of conduct between and among them.

RESPONSE #18

Plaintiff hereby incorporates Response Category A to the extent that Plaintiff is licensed to sell the Samick guitars on the subject website and the domain name is "samickguitars.com".

RESPONSE #19

Plaintiff hereby incorporates Response Category D. Plaintiff was requested by Defendant to make the changes identified, and Plaintiff used Defendant's "PRS" designation.

RESPONSE #23

Plaintiff hereby incorporates Response Category D; Defendant was on or about May 25, 2001.

RESPONSE #24, 26, 30

Plaintiff hereby incorporates Response Category A, except that the back references for each is understood to mean #23, 25 and 29, respectively.

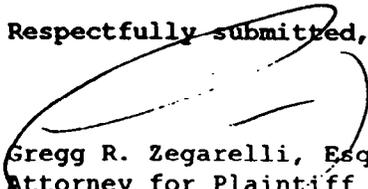
RESPONSE #33

Plaintiff hereby incorporates Response Category K.

RESPONSE #34

Plaintiff hereby incorporates Response Category A, except the reference is "SamickGuitars.com is a division of Lawrence Music, Inc.".

Respectfully submitted,


Gregg R. Zegarelli, Esq.
Attorney for Plaintiff
~~Z E G A R E L L I~~
Technology & Entrepreneurial
Law Ventures Group, P.C.
Allegheny Building, 12th Floor
Pittsburgh, PA 15219-1616
412.765.0401
grz@zegarelli.com

VERIFICATION

Bradford R. Johnson, President of Lawrence Music, Inc., aver that the statements and facts contained in the attached document are true and correct to the best of my information, knowledge and belief and are made subject to the penalties of 18 Pa. Cons. Stat. Ann. § 4904 relating to unsworn verification to authorities.

LAWRENCE MUSIC, INC.

Date: June 20, 20


Bradford R. Johnson
President

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing document was served on the following person this 20th day of June, 2002, by depositing the same in the United States Mail, First Class, Postage Pre-Paid, upon the following:

Daniel M. Cislo, Esq.
Cislo & Thomas LLP
233 Wilshire Boulevard, Suite 900
Santa Monica, CA 90401, USA

Gregg R. Zegarelli, Esq.
PA I.D. #52717
Attorney for Plaintiff

Z E G A R E L L I
Technology & Entrepreneurial
Ventures Law Group, P.C.
Allegheny Building, 12th Floor
Pittsburgh, PA 15219-1616
412.765.0401

09/10/2003 11:49
in Civil Action 01 1029, titled *Lawrence Music, Inc. v. Samick Music Corporation* (U.S. Federal District Court, Western District of Pennsylvania).

I declare under penalty of perjury that the foregoing statements made of my own knowledge are true and correct and that all statements made on information and belief are believed to be true and correct.

Executed on June 23, 2003 in Santa Monica, California.



Sarah A. Brown

TRADEMARK
03-12289



25189

PATENT TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the opposition of:

LAWRENCE MUSIC, INC. v. SAMICK MUSIC CORPORATION

Opposition No. 91,156,310

Serial Number: 76/342,386

For: **SAMICK**

Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513
BOX TTAB NO FEE

EV288347331US

CERTIFICATE OF MAILING BY EXPRESS MAIL

Express Mailing Label No. EV 288347331 US

Deposited: June 23, 2003

Dear Sir/Madam:

Enclosed herewith are the following:

1. Transmittal Letter (1 page);
2. Answer to Opposer's Notice of Opposition (7 pages);
3. Applicant's Opposition to Opposer's Motion to Suspend Proceeding and to Opposer's Request for Extension of Time to Oppose for Extraordinary Cause (6 pages);
4. Declaration of Sarah A. Brown (2 pages); and
5. Acknowledgement Postcard.

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 C.F.R., Section 1.10, on the date indicated above and is addressed to:

Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202
BOX TTAB NO FEE

Respectfully submitted,

CISLO & THOMAS LLP

Date: June 23, 2003


Sarah A. Brown
Reg. No. 47,455

CISLO & THOMAS LLP
233 Wilshire Boulevard, Suite 900
Santa Monica, California 90401-1211
Tel: (310) 451-0647
Fax: (310) 394-4477
www.cislo.com

DMC/SAB/sd

Enclosures

As listed above

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