

ESTTA Tracking number: **ESTTA99628**

Filing date: **09/15/2006**

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

Proceeding	91156321
Party	Plaintiff THE CHAMBER OF COMMERCE OF THE UNITED STATES OF AMERICA THE CHAMBER OF COMMERCE OF THE UNITED STATES OF AMERICA ,
Correspondence Address	William M. Merone Kenyon & Kenyon 1500 K Street, N.W., Suite 700 Washington, DC 20005
Submission	Opposition/Response to Motion
Filer's Name	Erik C. Kane
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Signature	/Erik C. Kane/
Date	09/15/2006
Attachments	Response to Motion to Compel as FILED.PDF (26 pages)(616796 bytes)

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

THE CHAMBER OF COMMERCE OF
THE UNITED STATES OF AMERICA

Opposer,

v.

UNITED STATES HISPANIC CHAMBER
OF COMMERCE FOUNDATION,

Applicant.

Opposition No.: 91/156,321

Serial No.: 78/081,731

OPPOSITION TO APPLICANT'S MOTION TO COMPEL

Applicant, United States Hispanic Chamber of Commerce Foundation, has filed a motion to compel, based upon two sets of discovery requests, that is moot, meritless, and untimely all at the same time. More specifically, it is moot because, regardless of the temporal issues surrounding Opposer's discovery responses, Opposer responded to Applicant's Second Set of Discovery requests long prior to Applicant filing the present motion. Moreover, The Chamber of Commerce of the United States of America, has on numerous occasions made available for inspection documents responsive to Applicant's Second Set of Discovery requests. It is meritless in that Opposer has made only proper objections to Applicant's Second Set of Discovery requests. Finally, it is untimely in that Applicant attempts to resurrect issues surrounding the First Set of Discovery requests, that should have been addressed over two and a half years ago.

In response to Applicant's initial complaints, Opposer accepted Applicant's invitation to resolve discovery issues by teleconference. Rather than initiating such

discussions, which were at Applicant's request, Applicant chose to respond with silence and file the instant motion. Now after discussing possible settlement with Opposer for the past month, Applicant has once again gone silent, forcing Opposer to respond to the instant motion.

Applicant's *Motion to Compel* should thus be denied. In further support of its opposition, Opposer states as follows:

I. BACKGROUND

The parties' dispute centers upon the desire of Applicant to register UNITED STATES HISPANIC CHAMBER OF COMMERCE for services that would be regarded by consumers as being similar to services offered by Opposer under its registered U.S. CHAMBER OF COMMERCE mark (U.S. Reg. No. 1,522,157).

Starting in 2004, the proceedings had been suspended on consent so as to allow the parties to pursue settlement discussions, which continued into early-2006. During the settlement discussions in January 2004, Applicant propounded the First Set of Discovery Requests. On March 13, 2006, at the close of discovery, Applicant propounded the Second Set of Discovery requests. Applicant's discovery forced Opposer to file the same day for an extension of the suspension period, in order to provide additional time to respond in pending settlement discussions. On April 21, 2006, Applicant broke off settlement discussions, without informing Opposer, by filing an opposition to Opposer's Motion to Suspend Proceedings Pending Settlement Negotiations. This came to the complete surprise of Opposer, which at that time was still waiting for a response from

Applicant to an October 12, 2005 settlement offer Opposer had made.¹ Based on this turn of events, the Board lifted the suspension on April 26, 2006.

After lifting the suspension, Opposer responded to Applicant's Second Set of Discovery requests on June 1, 2006. Opposer responded to all of Applicant's requests and stated that it was making all documents available for inspection at Opposer's counsel's office. Silence followed from Applicant.

Opposer did not hear from Applicant until nearly two months later, in a July 26 letter to Opposer's counsel. *See Kane Decl.*, Ex. A. In the letter, Applicant raised several discovery issues and offered to discuss the matters over the telephone. Opposer promptly responded in a letter the next day. *See Kane Decl.*, Ex. B. In its letter, Opposer once again invited Applicant to come to Opposer's counsel's office to inspect the documents and even offered to copy and ship all the documents to Applicant. Opposer then inquired as to the merits of Applicant's objections and accepted Applicant's offer to discuss the matter over the telephone. Silence from Applicant again followed. Opposer even attempted several times to contact Applicant but those messages went unanswered. Finally, in a fax letter of August 3, 2006 Opposer restated its willingness to resolve the discovery matters by telephone, as suggested by Applicant. Opposer was surprised to learn later that day that Applicant filed the instant motion, since Opposer had not heard one word from Applicant.

¹ In its April 21 filing, Respondent/Applicant claimed that Petitioner/Opposer was delaying the proceedings, and that Opposer "had not contacted Applicant regarding settlement ... since the parties agreed to the ... 90-day extension requested by Applicant in December 2005." That is quite misleading. As the written correspondence between the parties would confirm, when Applicant approached Opposer and requested the December 2005 extension, Applicant represented that it was "considering [the] October 12, 2005 letter." and that it "continue[d] to believe that a settlement can be reached." Evidently, Applicant decided sometime in early-2006 to reject Opposer's offer, but chose not to inform Opposer of that fact.

During August, Opposer continued to communicate on a number of occasions with Applicant in furtherance of the settlement discussions, but aside from one initial offer of settlement from Applicant, Opposer has not heard from Applicant one way or the other. Opposer, consequently had no option but to respond to the Motion To Compel, which seems to have been pursued for tactical litigation purposes, rather than for any legitimate need.

II. ARGUMENT

Applicant raises several alleged deficiencies in Opposer's discovery responses, which will each be addressed.

A. Inspection of Documents

Applicant incorrectly argues that Opposer failed properly to produce documents in response to its document requests. On the contrary, Opposer has repeatedly offered to allow Applicant to come inspect the documents. *See Eliseev Decl.*, Ex. 5, p.2; *see also Kane Decl.*, Ex. B, p. 1. Opposer even offered to copy and ship the documents to Applicant at their expense. *See id.* To date, Opposer has not received one request from Applicant to inspect or ship the documents to them. *See* 37 C.F.R. § 2.120(d)(2). Opposer has offered two methods of production, Applicant has failed to respond.

While Applicant argues that Opposer's tactics would delay discovery, on the contrary it is Applicant's refusal to inspect, and continued silence in response to Opposer's offers that is the cause of any delay in Applicant obtaining documents. The documents have been available, organized, and labeled in a discrete set of boxes for easy review. Applicant has simply failed to come get them – or even to look at them.

Applicant argues that making the documents available in counsel's office, rather

than in the file cabinets in which they kept at the offices Opposer, is not proper discovery. They sight no authority for this novel, and insupportable position. “A party who produces documents for inspection shall produce them as they are kept in the usual course of business or shall organize and label them to correspond with the categories in the request.” Fed. R. Civ. Pro. 34(b). Opposer has complied with the letter and the intent of Rule 34 and organized the business records to identify and produce only responsive documents. There is no requirement that records be produced *where* they are kept in the ordinary course of business, and Applicant also fails to point out that – far from being inconvenient - Opposer’s counsel’s office is a mere few blocks away from both Opposer and from Applicant.

B. Applicant’s Two And a Half Year Old First Set of Discovery

Applicant has dusted off discovery, served by former counsel for Applicant on former counsel for Opposer, more than two and a half years ago. And did so in the middle of settlement discussions between current counsel. Applicant waited more than two and a half years before raising these discovery issues for the first time. While there have been periodic suspensions in this matter, this excuse of Applicant for not having filed earlier is simply wrong. There also have been plenty of times when the proceedings have not been suspended, and during which Applicant could have filed the instant motion.

In fact, during at least one of the periods when the matters was not suspended, Applicant filed a second set of discovery requests, substantially duplicative of the first set of requests, rather than file a motion to compel. Considering the Board’s admonition that a motion to compel “should be filed within a reasonable time after the failure to respond

to a request for discovery (*see TBMP*, § 523.03), the motion ought be denied, and certainly the requested sanction of “waiver” of objections would be wholly unwarranted.

Indeed, even though discovery had already closed, Opposer offered nevertheless to respond to any specific discovery requests from the two and ½ year old set of discovery, which Applicant might identify as not duplicative of the second set of discovery. *See Kane Decl.*, Ex. B, p. 2. Applicant, again, never responded.

C. Applicant’s Second Set of Discovery

1. Opposer Did Not Waive All Objections

Applicant attempts to argue that Opposer has waived all objections to the Second Set of Discovery owing to its submitting responses beyond the thirty day period. First, Opposer was not late in its submissions. Applicant served its requests on March 13, 2006, by mail, the same day Opposer moved to suspend the proceedings owing to settlement negotiations. Hence, absent suspension, Opposer’s responses would have been due in 35 days. Once the Board ruled on that motion on April 26, 2006, Opposer had the same period to respond, and Opposer calculated its response date as due on June 1, 2006.

Assuming *arguendo* that Opposer was late in its responses, Opposer’s delay was excusable neglect owing to the period of time the parties were engaged in settlement discussions and the pending motion to suspend the proceedings. Even if Opposer was wrong as to the time to answer and miscalculated the time by one day as Applicant suggests, such delays would still be excusable neglect. *See Luehrmann v. Kwik Kopy Corp.*, 2 U.S.P.Q.2d 1303, 1303 (TTAB 1987) (Right to object not waived where

although discovery responses were late, there was some confusion regarding time to answer.).

Moreover, Notwithstanding these facts, Opposer served its responses over two months prior to Applicant raising the issue or filing the instant motion – in fact, prior to any inquiry at all from Applicant regarding Opposer’s responses. Applicant can hardly argue it has been prejudiced from such a delay. 37 C.F.R. § 2.120(e); *See Luehrmann* at 1303 (Late responses rendered motion to compel, based on complete non-responsiveness, moot). Finally, despite Opposer’s repeated overtures to resolve the matter, Applicant failed even to attempt a good faith effort to meet and confer to resolve the discovery disputes prior to filing this motion as required. *See MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 U.S.P.Q. 952, 953 (TTAB 1979) (party seeking discovery is required to make good faith effort to determine why no response has been made before coming to Board with motion to compel).

Applicant can hardly request sanctions under 37 C.F.R. § 2.120(e) for “[failure] to answer any question propounded in ... any interrogatory, or [failure] to produce and permit the inspection and copying of any document or thing” when Opposer has in fact answered the propounded questions.

2. *Opposer’s Responses Were Adequate*

Many of Applicant’s issues arise from a misunderstanding of Trademark Trial and Appeal Board practice. While some of the issues raised by Applicant might be relevant in a trademark infringement suit in a District Court, they are inapposite to an Opposition proceeding before the TTAB where the Opposer’s federal registration carries certain

presumptions. Regarding the document request responses, Applicant's arguments are also premature given that they have failed to even inspect a single documents produced in response to the requests.

a. Channels of Trade, Classes of Customers

Applicant has argued that Opposer has failed to fully respond to several interrogatory and document requests relating to Opposer's channels of trade and classes of customers. As Opposer pointed out in its responses, its registrations in no way restricts its channels of trade or classes of customers. Thus as a matter of law, Opposer's registrations would cover all channels of trade, including marketing, advertising, and distribution customary for the registered class of goods and services. "Because the parties' respective application and registrations are unrestricted, and applicant's goods and services are identical to some of opposers' goods and services, we must presume that at such time as applicant were to use his mark on the identified goods and recited services, the parties' respective goods and services will be traveling through the same channels of trade to the same classes of consumers." *Starbucks U.S. Brands LLC v. Ruben*, 78 U.S.P.Q.2d 1741 , 1751-52 (TTAB 2006); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 U.S.P.Q. 198, 199 (Fed. Cir. 1983); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 U.S.P.Q.2d 1001, 1005 (Fed. Cir. 2002) ("[A]bsent restrictions in the application and registration, goods and services are presumed to travel in the same channels of trade to the same class of purchasers."); *Kangol Ltd. v. KangaRoos U.S.A.*, 974 F.2d 161, 23 U.S.P.Q.2d 1945, 1946 (Fed. Cir. 1992). "Both applicant's application and the cited registration are, in part, for the same items, namely t-shirts and sweatshirts. Because the goods are legally identical, they must be presumed to travel in the same

channels of trade, and be sold to the same class of purchasers. ... [S]ince the identification is unrestricted as to channels of distribution, we must consider the goods to travel in all channels appropriate for goods of this type.” *In re Smith and Mehaffey*, 31 U.S.P.Q.2d 1531, 1532 (TTAB 1994); *see also In re Elbaum*, 211 U.S.P.Q. 639 (TTAB 1981); *In re Optica International*, 196 U.S.P.Q. 775 (TTAB 1977).

Thus, Opposer gets the benefit of its unrestricted registration. For purposes of determining likelihood of confusion in an Opposition proceeding, Opposer’s registration is presumed to cover all channels of trade to all classes of purchasers.

Moreover, Applicant improperly argues that Opposer’s price or fees charged for its services is relevant. As mentioned before, Opposer’s registration is not restricted as to channels of trade or classes of customers. Thus, customer sophistication becomes irrelevant since Opposer’s registration is presumed to cover all classes of customers. *Shen Mfg. Co., Inc. v. Ritz Hotel, Ltd.*, 393 F.3d 1238 , n.3 (Fed. Cir. 2004) (We assume that the channels of trade and the sophistication of the purchasers are identical.); *See Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 U.S.P.Q.2d 1001 (Fed. Cir. 2002) (“[A]bsent restrictions in the application and registration, goods and services are presumed to travel in the same channels of trade to the same class of purchasers.”)

b. Advertising and Sales Expenditures

Applicant then argues that Opposer’s responses to interrogatory and document requests regarding marketing and advertising expenditures is insufficient. In fact, Opposer did direct Applicant to a specific document in its document production.

Applicant somehow argues that such a production is insufficient, without having even reviewed the document production, despite its availability. *Johnson & Johnson v. Diamond Medical, Inc.*, 183 U.S.P.Q. 615 (TTAB 1974) (Applicant only required to produce "Representative samples of invoices, labels, advertising and other promotional materials concerning the mark SURG-O-SAFE for the goods specified in the application;" and "As to the request that applicant furnish figures of advertising expenditures incurred in promoting the mark for goods identified in the application, round figures in the thousands of dollars during the years of use since 1971 are deemed sufficient to serve the needs of opposer.").

Moreover, Applicant argues that Opposer should reveal its sales figures. Such information is wholly irrelevant to the issues in this proceeding. In addition, such information was properly objected to as confidential business information. At no point did Applicant approach Opposer during discovery to request that a protective order be entered. Applicant did not even in good faith attempt to discuss these matters with Opposer.

c. Referring to Bates Production

Applicant has argued that Opposer's reference to its document production in its responses to interrogatories is inadequate. However, in every case, Opposer has specifically identified narrow Bates ranges of documents responsive to the interrogatory request. "Where the answer to an interrogatory may be derived or ascertained from the business records of the party upon whom the interrogatory has been served or from an examination, audit or inspection of such business records, and the burden of deriving or ascertaining the answer is substantially the same for the party serving the interrogatory as

for the party served, it is a sufficient answer to such interrogatory to specify the records from which the answer may be derived or ascertained and to afford to the party serving the interrogatory reasonable opportunity to examine, audit or inspect such records and to make copies, compilations, abstracts or summaries.” *In re Urethane, slip op.*, 2006 WL 1895456 *3 (D. Kan. 2006); Fed. R. Civ. Pro. 33(d). “[I]n this case, Plaintiffs are representing that all of the records they have identified provide the information necessary to answer these interrogatories. The Court therefore concludes that Plaintiffs’ reference to various Bates-stamped documents was proper under Rule 33(d).” *Urethane* at *4.

d. Use of the Term “Chamber of Commerce” as a Trademark

Applicant argues that Opposer’s objection to the relevancy of the use of the term “Chamber of Commerce” has direct bearing on Applicant’s genericness counterclaim. Opposer’s trademark however is not “Chamber of Commerce” but rather “U.S. CHAMBER OF COMMERCE.” In its registration, Opposer has in fact disclaimed the phrase “Chamber of Commerce” used alone. Thus, any inquiry into genericness cannot result from merely using the phrase “Chamber of Commerce” but rather inquiring into Opposer’s mark as a whole. Requiring Opposer to identify every third party that uses the phrase “Chamber of Commerce”, or to define the phrase, something Opposer itself disclaimed, is wholly irrelevant. Such a request would also be overbroad.

e. Opposer’s Adoption of Its Mark

Applicant argues that information concerning Opposer’s adoption of its mark is relevant to genericness. However, Opposer adopted its mark more than 100 years ago. Applicant’s contention is that Opposer’s mark has lapsed into genericness today. Thus

any inquiry into how Opposer selected its mark or what alternatives were considered, a century ago, is wholly irrelevant.

f. Applicant's Contention Interrogatories

Applicant argues that Opposer's interrogatory responses to its contention interrogatories as to what facts Opposer will rely upon are not premature. In fact, Opposer did respond by referring Applicant to its factual contentions in the Notice of Opposition. Any further facts may come through discovery and trial preparation, and thus Opposer could not be expected to respond to such interrogatory until after having reviewed Applicant's responses to Opposer's discovery. "An interrogatory otherwise proper is not necessarily objectionable merely because an answer to the interrogatory involves an opinion or contention that relates to fact or the application of law to fact, *but the court may order that such an interrogatory need not be answered until after designated discovery has been completed or until a pre-trial conference or other later time.*" Fed. R. Civ. Pro. 33(c) (emphasis added).

g. Search Reports

While non-privileged search reports are normally discoverable, the scope of Applicant's request is overbroad and irrelevant to the proceeding. Opposer adopted its mark over 100 years ago, so it would not have any relevant search reports regarding its mark. Any subsequent search reports for Opposer's marks would have been conducted by Opposer's attorney as privileged work product. Search reports for just the phrase "Chamber of Commerce" is irrelevant as Opposer has disclaimed that portion of its mark. Thus such a request would also be overbroad.

h. Assignment/Licensing/Rights of Opposer's Marks

Applicant's requests for Opposer's assignment and licensing records for its marks are also irrelevant. Applicant has not contested Opposer's ownership of its mark. In fact, its marks have achieved incontestable status, so Applicant could not even challenge a lack of secondary meaning or challenge Opposer's right to use its marks. 15 U.S.C. § 1065. Moreover, they have not alleged abandonment of Opposer's mark. Thus, Opposer's licensing arrangements would be irrelevant to the single issue that Applicant raises with respect to Opposer's marks, genericness. In fact, evidence of Opposer's licensing would only refute any allegations of the generic nature of its marks.

i. Documents Used in Preparation of Interrogatory and Admission Responses

Opposer has already made available in its document production all non-privileged, non-confidential documents responsive to this request. Applicant simply has not yet availed itself of the ability to inspect the documents.

j. Laches, Estoppel, Acquiescence

Applicant argues that Opposer's relevancy objections are improper for these requests. However, Opposer has fully answered the requests by specifying when it became aware of Applicant's intention to register its mark as a trademark. Applicant argues that the long time co-existence of Applicant and Opposer is relevant to these affirmative defenses. However, Applicant confuses the issue. In an Opposition proceeding, the defenses of laches, estoppel or acquiescence would only go to delays in Opposer's opposition of an applicant's *application* for a *trademark*. The length of time Opposer was aware of Applicant's use of its trade name is irrelevant. "It is clear,

therefore, that the equitable defense of acquiescence in an opposition or cancellation proceeding does not begin to run until the mark is published for opposition.” *Chester L. Krause v. Krause Publications, Inc.*, 76 U.S.P.Q.2d 1904, 1914 (TTAB 2005). Thus, the only relevant delay would have been if Opposer waited to oppose the application *after the mark was published for opposition*. In fact, Opposer filed its extension of time to file the opposition within one month of the publication for opposition. Thus, Applicant has no claim that Opposer unduly delayed filing its opposition; *see also National Cable Television Association, Inc. v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 U.S.P.Q.2d 1424 (Fed. Cir. 1991) (laches runs from the time from which action could be taken against the trademark rights inhering from registration).

k. Documents Relied Upon By Experts

Applicant’s request was premature. Of course should Opposer retain experts, Opposer will of course comply with its disclosure obligations pursuant to Fed. R. Civ. Pro. 26 and 34.

III. CONCLUSION

Based on the above, Applicant’s motion should be denied. While Opposer was willing to confer with Applicant in good faith to resolve these disputes, Applicant has forgone discussions to present the instant motion. Such a motion not only fails to meet the prerequisite rules of the TBMP, but also is wholly without merit. Applicant has failed to timely move to compel responses to its first set of discovery. Opposer has made available for inspection all its responsive documents to Applicant’s Second Set of Discovery and repeatedly informed Applicant of this. Applicant has simply failed to pick up the documents. Finally, Opposer has properly responded to all of Applicant’s

outstanding discovery requests. Its objections are proper. If Applicant had issues with specific objections, it should have conferred with Opposer to resolve the issues. Having failed to do so, despite Opposer's willingness, Applicant cannot now argue that it has been unduly prejudiced by any alleged deficiencies in Opposer's responses, of which there are none.

Consequently, Applicant's motion should be denied and the Board should rule that Opposer has not waived its objections to any of Applicant's requests.

Date: 9/15/06

Respectfully submitted,

Erik C. Kane

Edward T. Colbert

William M. Merone

Erik C. Kane

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Counsel for Opposer,

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States of America*

CERTIFICATE OF SERVICE

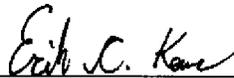
I hereby certify that the required number of copies of the foregoing *Opposition to Applicant's Motion to Compel* was served on the parties or counsel on the date and as indicated below:

By Federal Express (Postage Prepaid)

Jill M. Pietrini
Attorney for Applicant
UNITED STATES HISPANIC
CHAMBER OF COMMERCE
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Date:

9/15/06



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

THE CHAMBER OF COMMERCE OF
THE UNITED STATES OF AMERICA

Opposer,

v.

UNITED STATES HISPANIC CHAMBER
OF COMMERCE FOUNDATION,

Applicant.

Opposition No.: 91/156,321

Serial No.: 78/081,731

DECLARATION OF ERIK C. KANE

The undersigned, Erik C. Kane, states that the following is true and accurate to the best of his information and belief and if called to testify, could and would testify competently as follows:

1. I am an associate with the law firm of Kenyon & Kenyon LLP. Included among my duties is representation of The Chamber of Commerce of the United States of America ("Opposer") in the above captioned opposition proceeding.

2. Attached hereto as Exhibit A is a true and correct copy of the July 26, 2006 letter from Andrew Eliseev to William Merone.

3. Attached as Exhibit B is a true and correct copy of the July 27, 2006 letter from myself to Andrew Eliseev.

4. After my July 27 letter, I called Andrew Eliseev multiple times and Jill Pietrini at least one time. On all occasions, I left messages on their respective voicemail systems indicating a desire to discuss the outstanding discovery disputes. The first communication I received from Applicant's counsel was not until I received a letter from Andrew Eliseev on August 3, 2006, shortly after I left him yet another voicemail and sent a follow up facsimile. Only then did I learn that Applicant filed a motion to compel. At no point was I ever able to talk with Applicant's counsel on the telephone.

I declare under penalty of perjury that the foregoing is true and correct.

Dated: 9/15/06 Eric C. Kane

CERTIFICATE OF SERVICE

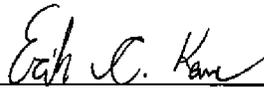
I hereby certify that the required number of copies of the foregoing *Declaration of Erik C. Kane* was served on the parties or counsel on the date and as indicated below:

By Federal Express (Postage Prepaid)

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Exhibit A

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July 26, 2006

Client-Matter: 27206-030

VIA FACSIMILE

William Merone, Esq.
Kenyon & Kenyon
1500 K Street, N.W.
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**Re: *The Chamber of Commerce of the United States of America v. United States Hispanic Chamber of Commerce*
Opposition No. 91-156321**

Dear Mr. Merone:

We believe that The Chamber of Commerce of the United States' ("Opposer") objections and responses to United States Hispanic Chamber of Commerce's ("Applicant") interrogatories and document requests are inadequate and request that the parties telephonically meet and confer pursuant to TBMP § 523.02.

Opposer failed to provide responses to any of the interrogatories and requests for production contained in Applicant's First Set of Discovery to Opposer (Interrogatories and Requests for Production of Documents and Things) served on Opposer on January 12, 2004. Opposer also failed to properly respond to Interrogatory Nos. 1, 3-11, 13, 17-21, 23-25, and 29-31 from Applicant's Second Set of Interrogatories served on Opposer on March 13, 2006, as well as Request Nos. 3, 4, 7, 8, 10, 11, 13, 14, 16-24, 28, 30, 33-37, 39-42, 46, 47, and 50 from Applicant's Second Set of Requests for Documents and Things served on Opposer on March 13, 2006. Because Opposer failed to provide any responses to Applicant's first set of discovery requests, and was substantially late responding to Applicant's second set of discovery requests, any objections that Opposer might have to Applicant's discovery requests were waived. Therefore, Applicant is entitled to all information and documents responsive to the above interrogatories and document requests.

Further, Opposer failed to produce any documents that it agreed to produce in its responses to the remaining production requests in Applicant's Second Set of Requests for Production of Documents and Things. Such responsive documents should have already been produced to Applicant.

I am available to meet and confer on this matter any time today, or tomorrow, July 27, 2006 between 2 p.m. and 5 p.m. P.D.T. Please let me know if you are available and what

manatt

manatt | phelps | phillips

William Merone, Esq.

July 26, 2006

Page 2

time you would like to begin our discussions.

Very truly yours,



Andrew Eliseev

AE

cc: Melinda Guzman-Moore, Esq.

41022612.1

Exhibit B



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July 27, 2006

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Re: The Chamber of Commerce of the United States v. United States
Hispanic Chamber of Commerce Foundation (Opposition No.
91/156,321) (TTAB)

Dear Mr. Eliseev:

I am in receipt of your letter of July 26 to William Merone requesting that a conference call be scheduled for today regarding discovery issues and have been asked to respond. As an initial matter, though, I must note that it is our position the U.S. Chamber of Commerce is in no way deficient on any of its discovery responses. As such, there would not seem to be much to discuss. Still, given that we have concerns as to your client's responses to our requests, perhaps a conference call should be scheduled at a mutually convenient date and time.

Turning first to the issues you raised in your letter, I'll address them in reverse order:

Production of Documents:

You suggest that the U.S. Chamber has "failed to produce any documents that it agreed to produce" in its discovery responses. This is incorrect. In our discovery responses, we clearly stated that we would "permit the inspection and copying of the documents produced in response to [Applicant's] requests ... at the offices of Kenyon & Kenyon LLP [in] Washington, DC, at a time and date mutually convenient to counsel for Opposer and Applicant." To date, however, you have not contacted us and scheduled a time to inspect and copy the documents.

If you would like to inspect the documents (which have been available for some time), please let us know. Alternately, if you would like us to send you a copy of the documents at your expense, we would be happy to do so in return for you sending us your responsive documents.



Applicant's Second Set of Interrogatories / Requests for Production

You also claim that the U.S. Chamber failed to "properly respond" to a litany of interrogatories and document requests, but you do not detail why any particular response is deficient. Each of our responses contains a proper objection, and we stand behind them. Still, if you wish to discuss the reasons why each response is proper, we can do so during a global conference.

Regarding your assertion that our responses were "substantially late," I am afraid we must disagree. We moved to suspend proceedings on March 13th, which was before we received any requests from you, and that motion was not denied until April 26th. Therefore, as your discovery effectively was only served on that day (and accounting for the delay associated with the issuance of the Order), our responses were not due until May 31st, and we timely responded.

All of this, however, is a moot point. Even if our responses were due in late April, the fact remains that we fully responded to all of your discovery requests long before you ever raised any concern as to "delay." As such, under TTAB precedent, our objections were not waived.

Applicant's First Set of Interrogatories / Requests for Production

Finally, you have dusted off discovery from more than two years ago that had been served by former, former counsel for Applicant to former counsel for Opposer, and you claim once more that we have "waived" our objections thereto. Again, we disagree.

Assuming for the moment that no responses were ever served by former counsel (and we cannot be certain one way or the other), you nonetheless apparently waited more than two and a half years before raising this issue for the first time. Meanwhile, in the interim, you served a second set of discovery requests that were in part substantially duplicative of the first request set of requests (*compare, e.g.,* Req. No. 14 (first set) *with* Req. No. 12 (second set); Req. No. 21 (first set) *with* Req. No. 49 (second set); Interrog. No. 6 (first set) *with* Interrog. No. 7 (second set)), thus suggesting that even you recognized that the original requests had long turned stale. Considering that we timely responded to the second set, and in view of the Board's admonition that a motion to compel "should be filed within a reasonable time after the failure to respond to a request for discovery" (*see TBMP, §523.03*), a sanction of "waiver" would be wholly unwarranted.

Be that as it may, however, if you believe that there are specific discovery requests (or portions thereof) relating to topics that (1) were not already covered by your second set of discovery, and (2) are relevant to the issues in this case, please identify them with particularity and we will consider providing expedited responses thereto. I must note, however, that having reviewed the first set and compared it to the second, I find that there is little in the way of nonobjectionable and relevant requests that we have not already responded to through the second set. Still, if there is specific and discrete information that you still seek, we will try to accommodate you.



Separately, I wish to address briefly your responses to our discovery requests. Having reviewed them, I find them to be deficient on multiple grounds. Typically, my preference would be to set forth such concerns in detail through a formal discovery letter, but in view of your preference to hold a telephonic conference as to discovery issues (which is permitted under Trademark Rule 120(e)), I will agree to go that route as well.

To that end, please let me know your availability for a conference at some point over the next few days. I am available tomorrow early afternoon, or most of Monday or Tuesday of next week. I look forward to speaking with you then.

Regards,

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