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

Proceeding	91156321
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

<p>In Re Application Serial No. 78/081,731 for U.S. HISPANIC CHAMBER OF COMMERCE FOUNDATION & Design</p> <p>THE CHAMBER OF COMMERCE OF THE UNITED STATES OF AMERICA,</p> <p style="text-align: center;">Opposer,</p> <p style="text-align: center;">vs.</p> <p>UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION,</p> <p style="text-align: center;">Applicant.</p>	<p>Opposition No. 91-156,321</p> <p>APPLICANT UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION’S REPLY IN SUPPORT OF ITS MOTION TO COMPEL RESPONSES TO INTERROGATORIES AND REQUESTS FOR PRODUCTION OF DOCUMENTS, AND TO PRODUCE DOCUMENTS</p>
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I. INTRODUCTION

Pursuant to 37 C.F.R. § 2.127(a), Applicant United States Hispanic Chamber of Commerce Foundation (“Applicant”) hereby requests that the Board consider its reply brief in response to Opposer The Chamber of Commerce Of The United States Of America’s (“Opposer”) Opposition to Applicant’s motion to compel. Applicant’s reply should be considered because it clarifies the issues under consideration in the motion to compel. *See Seculus da Amazonia S/S v. Toyota Jidosha Kaisha*, 66 U.S.P.Q.2d 1154, n.4 (TTAB 2003).

The Opposition to Applicant’s motion to compel was served almost a month past the statutory deadline. Opposer did not even attempt to provide reasons for its violation of the procedural rules, which happens repeatedly with Opposer. The Board should not condone this flagrant disregard of the rules; it should reject the Opposition and grant Applicant’s motion in its entirety.

In addition to being served late, the Opposition did not offer sufficient explanation for Opposer’s failure to comply with its discovery obligations. Opposer provided no reasons for its

failure to respond to Applicant's first set of interrogatories and document requests. Opposer then used an implausible and legally unsupportable argument to explain its substantially late responses to Applicant's second set of interrogatories and document requests. Such an argument should be rejected by the Board. As a result, Opposer waived all of its objections, including those based on privileges, and must now provide full and complete responses to Applicant's two sets of discovery requests.

Even if Opposer is allowed to maintain its objections, such objections are improper and do not shield Opposer from disclosure of the sought information and documents. Most of the objections that Opposer attempts to support in its Opposition are based on the lack of relevancy. Each and every one of such relevancy objections is baseless and expressly contradicted in the TBMP Discovery Guidelines and case law. The remaining objections, such as those made on the grounds that the discovery requests are premature or seek confidential information, are similarly unsubstantiated and should be rejected.

Accordingly, the Board should order Opposer to provide responses to Applicant's first set of discovery requests, and to supplement Opposer's responses to Applicant's second set of discovery requests, and to produce documents requested in these sets of discovery requests.

II. THE OPPOSITION FAILED TO OFFER SUFFICIENT BASES FOR OPPOSER'S FAILURE TO COMPLY WITH ITS DISCOVERY OBLIGATIONS

After listing a string of excuses in its late Opposition, Opposer ultimately did not offer adequate reasons for its failure to respond to Applicant's first sets of discovery and its substantially late and insufficient responses to Applicant's second sets of discovery.

A. The Opposition Is Almost a Month Late

Opposer submitted its Opposition almost a month after the deadline set in the TBMP. Applicant served its motion by mail on July 31, 2006. Pursuant to 37 CFR §§ 2.119(c) and 2.127(a) and TBMP §§ 113.05 and 502.02, Opposer's Opposition was due on August 20, 2006. Instead, in violation of these rules, Opposer served its Opposition on September 15, 2006. The Opposition contains no explanation or excuse whatsoever for Opposer's failure to serve the

Opposition on time. In addition to rendering the Opposition improper on its face, this unexplained late service is yet another instance in Opposer's pattern of continuous¹, entirely unexplained, or ill-substantiated violations of the deadlines set forth in the TBMP and CFR. In any case, Opposer should not be allowed to proceed with impunity. The Opposition was late and Opposer chose not to even try to explain its lateness. The Opposition therefore should be rejected as being late and not considered by the Board.

B. Opposer's Violations of the Procedural Rules Resulted in a Waiver of All Objections to Applicant's Two Sets of Discovery Requests

The Opposition mentions numerous extensions applied for and granted in this proceeding. None of such extensions, however, can explain Opposer's failure to entirely ignore Applicant's first set of interrogatories and document requests. Opposer points a finger at Applicant for not complaining to the Board earlier, yet the bottom-line result is that Applicant served a set of discovery requests and received nothing in response. The procedural rules clearly state that if a party does not serve timely responses to discovery requests, all objections, including those based on attorney-client privilege and work product doctrine, are waived. FRCP, Rules 33(b)(4) and 34(b); *Environtech Corp. v. Compagnie Des Lampes*, 219 U.S.P.Q. 448, 449 (TTAB 1979); *Crane Co. v. Shimo Industrial Co., Ltd.*, 184 U.S.P.Q. 691 (TTAB 1975). Further, Opposer failed to provide legal support for its argument that discovery requests somehow became stale. Opposer is represented by knowledgeable counsel, which specializes in intellectual property cases. Its counsel undoubtedly are well aware of the obligations of the Federal Rules of Civil Procedure and the Trademark Rules of Practice. However, Opposer decided unilaterally that it did not have to respond to Applicant's first discovery requests.

The above rules apply equally to Opposer's late service of its responses to Applicant's second sets of interrogatories and document requests. Opposer failed to offer any authority allowing it to toll the deadline to respond to Applicant's discovery by merely *filing* a motion to

¹ Without providing any explanations, Opposer entirely failed to provide its responses to Applicant's first set of interrogatories and documents requests. Opposer then responded to Applicant's second set of interrogatories and document requests a month and a half past the deadline.

suspend. In its Opposition, Opposer continued to maintain that such filing effected an immediate suspension of the proceeding. Making up its own rules, Opposer went as far as to characterize the Board's denial of Opposer's motion to suspend as "lifting the suspension." (Opposition at p. 3.) Opposer's argument has no support in the rules. Opposer's filing of a motion to suspend did not suspend the proceeding, and Opposer's deadline to respond to Applicant's second sets of discovery remained at April 12, 2006. Opposer served its responses over a month and a half later, on June 1, 2006. According to the above authorities, a party serving its discovery responses past the statutory 30-day period and not having secured any extensions, waives all of its objections to the subject discovery requests. Therefore, Opposer should not be allowed to rely on its objections, and be ordered to fully respond to Applicant's second set of discovery requests.

C. Opposer's Boilerplate Relevancy and Other Objections Are Unfounded and Otherwise Inappropriate

Even if Opposer is allowed to maintain its objections to Applicant's discovery requests, such objections are largely inappropriate and should not be used by Opposer to hide the requested information and documents. The objection that Opposer most frequently overused in its responses is the one based on relevancy.

1. Opposer Must Produce Information and Documents Related to Channels of Trade and Classes of Customers

While accusing Applicant of "misunderstanding of Trademark Trial and Appeal Board practice," (Opposition at p. 7), Opposer overlooked or ignored the TBMP's Discovery Guidelines. Opposer argues in its Opposition that the information related to channels of trade and classes of customers is irrelevant to any issues in this proceeding. Opposer is incorrect: TBMP § 414(3) expressly provides that "[t]he classes of customers for a party's involved goods or services are discoverable." Also, the requested information is directly relevant to at least two factors in the likelihood of confusion inquiry. *See, e.g., In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (the likelihood of confusion factors include the similarity or

dissimilarity of established, likely-to-continue trade channels, and the conditions under which and buyers to whom sales are made, *i.e.*, “impulse” vs. careful, sophisticated purchasing). None of the cases cited in the Opposition in support of Opposer’s argument were decided in the context of discovery. The requested information and documents are clearly relevant and discoverable, and Opposer should be ordered to provide them.

2. Opposer Must Disclose Its Advertising and Sales Expenditures

Opposer’s position with respect to the information and documents related to its advertising and sales is untenable. In disregard of case law and TBMP’s Discovery Guidelines, Opposer argues that its sales and advertising figures are irrelevant to this proceeding. (Opposition at p. 10.) The TBMP Discovery Guidelines state that “[a]nnual sales and advertising figures, stated in round numbers, for a party’s involved goods or services sold under its involved mark are proper matters for discovery; if a responding party considers such information to be confidential, disclosure may be made under protective order.” TBMP § 414(18) (emphasis added) (citing cases ordering disclosure of sales and/or advertising information, and holding that such information is relevant to the issues of, *inter alia*, likelihood of confusion and registrability).

In its Opposition, Opposer also asserted the confidentiality of its sales figures and (apparently for the lack of a better excuse) stated that “[a]t no point did Applicant approach Opposer during discovery to request that a protective order be entered.” (Opposition at p. 10.) Opposer failed to explain why it was Applicant’s burden to raise the protective order issue when it was Opposer, which apparently felt the need for protection. Opposer seems to be grasping for the last straw to save itself from having to disclose the requested information.

3. Opposer’s Relevancy Objection Regarding the Third-Party Use of CHAMBER OF COMMERCE Marks Is Without Merit

Opposer made yet another attempt to use a relevancy objection to hide the information and documents related to Opposer’s knowledge of the use of the CHAMBER OF COMMERCE marks by third parties. (Opposition at p. 11.) Once again, TBMP’s Discovery Guidelines are

right on point: “Information concerning a party’s awareness of third-party use and/or registration of the same or similar marks ... is discoverable to the extent that the responding party has actual knowledge thereof” TBMP § 414(9). The genericness of the mark CHAMBER OF COMMERCE can readily be used to show the genericness of Opposer’s mark, U.S. CHAMBER OF COMMERCE. Opposer’s arguments to the contrary are therefore without merit.

4. Opposer Should Produce All Available Information and Documents Related to the Adoption of Its Mark

Opposer argues that the information related to the adoption of its mark is “wholly irrelevant.” (Opposition at p. 12.) The TBMP once again comes to the rescue. “Information concerning a party’s selection and adoption of its involved mark is generally discoverable” TBMP § 414(4). Contrary to Opposer’s arguments, such information is relevant and would otherwise lead to admissible evidence at least regarding the genericness of Opposer’s mark.

5. Search Reports and Assignment/Licensing Documents Are Also Discoverable

In refusing to produce search reports, Opposer uses the relevancy and privilege objections. Such objections are not sufficient to protect Opposer from producing the reports. “Search reports are discoverable, but the comments or opinions of attorneys relating thereto are privileged and not discoverable (unless the privilege is waived).” TBMP § 414(6). Opposer therefore must produce any and all search reports related to its mark.

Any information and documents related to Opposer’s assignment and licensing of its mark is relevant at least to the issue of genericness. Opposer admitted as much in its Opposition when it stated that “evidence of Opposer’s licensing would only refute any allegations of the generic nature of its marks.” (Opposition at p. 13.) If in fact Opposer licensed its mark, Applicant is entitled to know it to properly analyze and evaluate its genericness claim.

6. Evidence of Coexistence of the Parties' Marks Is Relevant At Least to Show the Lack of Likelihood of Confusion

Opposer cannot reasonably claim that the parties' marks' peaceful coexistence over the period of several decades has no relevance to this proceeding. At the very least, information related to such coexistence is directly relevant to show the lack of likelihood of confusion between the marks. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d at 1361 (one of the factors in the likelihood of confusion inquiry is the length of time during, and the conditions under, which there has been concurrent use without evidence of actual confusion); *In re Gen. Motors Corp.*, 23 U.S.P.Q.2d 1465, 1471 (TTAB 1992). Such information may also lead to admissible information in support of Applicant's laches, acquiescence and estoppel defenses. Any information and documents in Opposer's possession therefore should be ordered produced to Applicant.

7. Opposer Should Not Be Allowed to Postpone Its Responses to Applicant's Contention Interrogatory

Applicant's Interrogatory No. 29 requests that Opposer state all facts to support and rebut Opposer's likely claim that Applicant acted with the intent to trade on Opposer's alleged goodwill in any of Opposer's Marks. In its Opposition, Opposer argues that the interrogatory is premature as, among other things, "further facts may come through discovery." (Opposition at p. 12.) Opposer's statement is disingenuous: its responses were served on June 1, 2006, the last day of the discovery period. Any information Opposer may have needed to prove its case should have been obtained by Opposer by the close of discovery. If Opposer does not have any evidence in support of the claim at issue in Interrogatory No. 29, Opposer could and should have stated so. Otherwise, Opposer should be ordered to disclose it to Applicant.

III. CONCLUSION

For the foregoing reasons, Applicant respectfully submits that Opposer was not able to adequately substantiate its failure to timely and sufficiently respond to Applicant's two sets of

discovery requests, and therefore, Applicant's motion to compel should be granted in its entirety.

Respectfully submitted,

MANATT, PHELPS & PHILLIPS, LLP

Dated: October 5, 2006

By: /s/ Jill M. Pietrini
Jill M. Pietrini
Andrew Eliseev
Attorneys for Applicant United States Hispanic
Chamber of Commerce Foundation

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service, postage prepaid, in an envelope addressed to: Commissioner for Trademarks, Attn: Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, VA 2313-1451, on this 5th day of October, 2006.

/s/ Monica Danner _____
Monica Danner

CERTIFICATE OF SERVICE

I hereby certify that the foregoing **APPLICANT UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION'S REPLY IN SUPPORT OF ITS MOTION TO COMPEL RESPONSES TO INTERROGATORIES AND REQUESTS FOR PRODUCTION OF DOCUMENTS, AND TO PRODUCE DOCUMENTS** has been served upon the attorney for Opposer by depositing a copy thereof in an envelope addressed to:

William Merone
KENYON & KENYON
1500 K Street, N.W., Suite 700
Washington, DC 20005

on this 5th day of October, 2006.

/s/ Monica Danner _____
Monica Danner

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