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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
Correspondence Address	William M. Merone Kenyon & Kenyon 1500 K Street N.W., Suite 700 Washington, DC 20005 UNITED STATES ekane@kenyon.com
Submission	Other Motions/Papers
Filer's Name	Erik C. Kane
Filer's e-mail	ekane@kenyon.com, tmdocketdc@kenyon.com
Signature	/Erik C. Kane/
Date	11/07/2007
Attachments	Reply ISO Mot Reuse Testimony.pdf (54 pages)(1387101 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 *Petitioner,* v. UNITED STATES HISPANIC CHAMBER OF COMMERCE *Respondent.*	Cancellation No.: 92/045,876 Registration No. 2,886,207
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

PETITIONER/OPPOSER'S REPLY IN SUPPORT OF ITS MOTION FOR LEAVE TO USE TRIAL TESTIMONY FROM OPPOSITION NO. 91/156,321 IN CANCELLATION NO. 92/045,876

and

PETITIONER/OPPOSER'S REPLY IN SUPPORT OF ITS MOTION TO CONSOLIDATE OPPOSITION NO. 91/156,321 WITH CANCELLATION NO. 92/045,876 FOR ALL PURPOSES

Pursuant to TBMP Section 530, Petitioner/Opposer ("Petitioner") has moved to use the trial testimony it submitted in Opp. No. 91156321 in closely related Cancellation No. 92045876, which involves the same parties (or those in privity with them), the same counsel, the same or

similar marks, the same legal issues, the same counterclaims, the same or similar services, and the same evidence. Further, pursuant to TBMP Section 511, Petitioner has moved to consolidate the two proceedings, which the Board has described as being "closely related" to one another, and which have trial schedules that are now (as a result of repeated requests by Respondent/Applicant to push back its own testimony period) in alignment with one another, thus avoiding any possible delay.

Despite previously conceding that it was "not in principle opposed to the consolidation of the two proceedings," *see* Docket No. 27 (June 22, 2006), Opp. No. 91156321, p. 3, though, Respondent is opposing the motion and seeks to force to have Petitioner put on the exact same witnesses (and submit the exact same brief) twice. As will be discussed, Respondent's arguments are meritless. Respondent's has not denied (and in fact has *alleged*) that it is in privity with Applicant; the marks at issue in this case are either the same or similar in all material respects; Respondent will not be prejudiced as it has the right to recall the witnesses for further cross examination (a right provided in 37 CFR 2.122(f)); and the past scheduling "delays" of which Respondent/Applicant complains were a result of *its own action* (and in any event are not relevant to the *current* schedule of the parties going forward). This sensible motion should thus be granted.

A. Applicant Has Admitted That It Is In Privity With Respondent

Although Respondent/Applicant suggests that the pending motion should be denied because Petitioner has not sufficiently supported its assertion that there is privity between Respondent, the U.S. Hispanic Chamber of Commerce, and Applicant, the U.S. Hispanic Chamber of Commerce Foundation, *see Opp. to Mot.* at 8, it is interesting to note that Respondent/Applicant has never denied that privity actually exists. Indeed, given the undeniable

similarities between Respondent's UNITED STATE HISPANIC CHAMBER OF COMMERCE & Design mark and Applicant's UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION & Design mark, it is understandable why privity has not been denied. *Cf.* 15 USC §1052(d).

In fact, far from *denying* privity, Applicant has relied upon its privity with Respondent when asserting its claims and defenses in this case.[1] Specifically, in its *Answer*, Applicant asserted the equitable defenses of laches and acquiescence based on Petitioner's supposed knowledge of (and alleged inaction relating to) Respondent's use of the "U.S. Hispanic Chamber of Commerce" name. *See Applicant's Answer* at 3-5 (claiming that Respondent's "use [of the U.S. Hispanic Chamber of Commerce name] and peaceful coexistence [with Petitioner] has inured to the benefit of Applicant"). As the Board has explained, however, it is a "well-settled general rule, in *inter partes* cases, that laches and estoppel are *personal* defenses which may not be asserted by a third party ... who lacks privity with the person entitled to assert the defense." *In re Wilson*, 47 U.S.P.Q. 2d 1863, 1872 n.13 (TTAB 2001); *accord, e.g., Procter & Gamble Co. v. Keystone Automotive Warehouse, Inc.*, 191 U.S.P.Q. 468, 474 (TTAB 1976). Applicant's factual and legal allegations of record in this case—including the express representation that Respondent is Applicant's "parent corporation"[2], *see Applicant's Answer* at 3—are thus more than sufficient to support privity, especially in the absence of any denial.

However, less there be any doubt that Respondent and Applicant are in privity, one need only review Respondent's discovery responses and Applicant's corporate documents. For example, Respondent has admitted that (1) "Respondent … authorized the creation of

[1] Respondent and Applicant have also acted as if in privity, such as by filing one brief by the same counsel.

[2] Although a non-profit organization cannot be "owned" by a third party, the complete control that Respondent has over Applicant (discussed *infra*) is tantamount to a parent-child corporate relationship.

[Applicant]"; (2) "[Applicant's] corporate bylaws convey authority to Respondent to determine [Applicant's] members of the board"; and (3) "certain provisions of [Applicant's] bylaws cannot be revised without the approval of Respondent." *See* Ex. A. In addition, Applicant's *Articles of Incorporation* gives Respondent the sole right to appoint all of Applicant's board members and to remove any or all board members, with or without cause. *See* Ex. B. In addition, Respondent has the power to alter, amend, or repeal Applicant's Articles of Incorporation. *Id.* Finally, Applicant has admitted in Internal Revenue Service filings that it is affiliated with or related to Respondent. *See* Ex. C.

It therefore cannot be disputed that Respondent has complete control over Applicant, thus explaining Applicant's statement that Respondent is its "parent" and establishing privity. *Cf.* 15 U.S.C. §§1055, 1127; *see also* TBMP 206.02. ("the concept of privity generally includes, *inter alia*, … the relationship of 'related companies' within the meaning of … 15 U.S.C. §§ 1055 and 1127"). Respondent/Applicant's surprising claim that there is no "evidence" of privity in this case—a claim that Respondent/Applicant made despite knowing of all of the above—is thus contrary to the pleaded facts.

B. The Marks at Issue in the Two Proceedings are Either the Same or Legally Similar in All Material Respects

Respondent also argues that both motions should be denied because "the mark at issue in the Opposition is not the same as that in the Cancellation." *See Opp. to Mot.* at 6-8. As was the case with "privity," this argument also borders on the frivolous.

To begin with, of course, whether the marks at issue in two proceedings are the "same" or "similar" is legally irrelevant to the question of whether testimony offered in one proceeding may be used in another. Under Rule 2.122(f), the standard is whether the testimony from one proceeding would be "relevant and material" to the other proceeding. *Accord* TBMP, §530.

And here, no one is disputing that the evidence Petitioner offered in the Opposition proceeding—namely, evidence of (1) the strength of Petitioner's U.S. CHAMBER and U.S. CHAMBER OF COMMERCE marks (which are being asserted by Applicant in both proceedings); (2) the breadth of the services Petitioner has offered under the mark(s); (3) instances of actual confusion resulting from Respondent's use of the name "U.S. Hispanic Chamber of Commerce" (which is the very name at issue in the Cancellation); and (4) other topics relevant to the common claims and defenses asserted in both action, including as relates to the identical counterclaims and defenses raised by both Respondent and Applicant—is highly relevant to the Cancellation. *See generally Pet. Mot. to Reuse/Consolidate*, Exs. A-H (testimony on which Petitioner intends to rely).

Turning then to the motion to consolidate, Respondent's argument is not only flawed as applied to the marks of Respondent/Applicant (discussed *infra*), it wholly overlooks the fact that there are two sets of marks at issue in these related proceedings. Specifically, in both the Opposition and the Cancellation, Respondent/Applicant has asserted identical **counterclaims** against Petitioner, through which Respondent/Applicant seeks to cancel the same four registrations owned by Petitioner. *Compare Applicant's Answer* at 5-7 *with Respondent's Answer* at 4-5. On that basis alone consolidation is warranted, especially given that privity exists between Respondent and Applicant.

However, even if one were to take Respondent/Applicant's argument on face value and look only at the similarities of the "U.S. Hispanic Chamber of Commerce" marks involved in this case, there is still no factual or legal justification for denying consolidation (and thus requiring two separate trials). In both proceedings, Petitioner asserts that its block-letter registrations for the **word marks** U.S. CHAMBER and U.S. CHAMBER OF COMMERCE

(U.S. Reg. Nos. 1430627 and 1522157) should block issuance of the registrations sought by Respondent/Applicant for its two design marks because the design marks include the words "UNITED STATES HISPANIC CHAMBER OF COMMERCE." *See In re Appetito Provisions Co. Inc.,* 3 U.S.P.Q. 2d 1553, 1554 (TTAB 1987) ("[I]f one of the marks comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services."); *CBS Inc. v. Morrow,* 708 F.2d 1579, 1581-82 (Fed. Cir. 1983) ("in a composite mark comprising a design and words, the verbal portion of the mark is the one most likely to indicate the origin of the goods"). Petitioner has not alleged that the designs of Respondent/Applicant's marks contribute to the likelihood of confusion, thus rendering any supposed differences between those two designs irrelevant.

It is for this reason that Respondent's reliance on *Environtech Corp. v. Solaron Corp.*, 211 U.S.P.Q. 724 (TTAB 1981) is misplaced. *Cf. Opp. to Mot.* at 6-7. In *Environtech*, the opposer was asserting a design mark against three different design marks, none of which contained any wording. *See id.* at 726. As such, the particular differences between each of the applicant's designs and the opposer's design was a relevant consideration, leading the Board to conclude that the applicant would be at a disadvantage if it had to assert three different grounds for lack of similarity in the same proceeding. *See id.* In the present case, though, the designs of Respondent/Applicant's marks will play no role in Petitioner's confusion analysis as it is Petitioner's word mark that has been bodily incorporated into both of Respondent/Applicant's marks. Thus, the differences between Applicant's and Respondent's design marks are immaterial to Petitioner's arguments of similarity in its likelihood of confusion analysis.

Finally, it must be noted that the alleged "differences" between Respondent's and Applicant's marks are exceedingly minor and almost unnoticeable. *See Pet. Mot. to*

Reuse/Consolidate, p. 2. In fact, all of the design elements present in Respondent's design—specifically, two concentric circles with the name "United States Hispanic Chamber of Commerce" arrayed between them; the inner circle have a dark, solid background color; eighteen stars encircling a letter "H" with an eagle's head—can be found in Applicant's design. Thus, *even if* differences in the two designs could somehow be legally relevant even though Petitioner is only asserting a word mark (*but see supra*), the reality is that there are no real relevant differences between the two designs, and certainly not enough differences to justify having separate proceedings.

C. Respondent Will Have an Opportunity to Cross-Examine Any Witnesses Whose "Opposition" Testimony is Reused

Respondent/Applicant also argues Petitioner's motion to use trial testimony from the Opposition in the Cancellation should be denied because Respondent/Applicant supposedly would be denied an opportunity to cross-examine the witnesses. *See Opp. to Mot.*, p. 8. Once again, Petitioner/Applicant is making a baseless argument.

As provided by the express language of Rule 2.122(f), the grant of a motion to reuse testimony is "subject … to the right of any adverse party to recall or demand the recall for examination or cross-examination of any witness whose prior testimony has been offered and to rebut the testimony." Thus, Respondent/Applicant in fact will have the opportunity to recall Petitioner's witnesses should Respondent/Applicant believe that the multiple hours of cross-examination it already conducted of every witness (and which, contrary to the allegations made in Respondent/Applicant's filing, went into all of the subject areas that Respondent/Applicant claims that it was "deprived" from exploring; *see generally Pet. Mot. to Reuse/Consolidate*, Exs. A-H) was somehow insufficient.

D. Petitioner is Not Seeking (Nor Does it Wish) to Reopen Discovery

Respondent also wrongly claims that should the case be consolidated Petitioner will reopen discovery in the Opposition proceeding. *See Opp. to Mot.* at 5-6. Discovery has closed in both proceedings, with the only outstanding issuing being the Rule 30(b)(6) discovery deposition that Petitioner noticed of Respondent back in July. However, that deposition would be limited to the deposition topics noticed therein, and would be confined to the issues raised in the Cancellation proceeding.[3]

E. The Reason the Two Proceeding Schedules Are Aligned is Because Respondent/Applicant Kept Pushing Back its Testimony Period

Finally, it is ironic that Respondent/Applicant accuses Petitioner of somehow "maneuvering" to extend the Opposition, *see Opp. to Mot.* at 2-6 (alleging that Petitioner engaged in "a number of improper maneuvers"), when it has been Respondent/Applicant that has continuously engaged in dilatory tactics. Of course, *how* the two trial schedules wound up being aligned should be of no consequence to the question of consolidation—the relevant fact is that the schedules *are* now aligned, thus removing the only possible obstacle to consolidation. *Accord Order* (July 7, 2006), p. 1 (the only reason why the Board refused to consolidate previously was because the two proceeding were then at "considerably different stages in their proceedings") (the Board, however, acknowledged that "it appears clear that the facts and legal issues presented in [the two proceedings are] closely related"). Nonetheless, a brief response to the spurious allegations lodged by Respondent/Applicant would appear to be warranted here.

[3] "In places, Respondent/Applicant suggests that Petitioner's *Motion to Compel* is somehow connected to, or that it should be considered when deciding, the present Motion to Consolidate. *See Opp. to Mot.* at 5-6. That is most certainly untrue. As the Board is aware, Petitioner has believed from the very beginning on this case that consolidation was appropriate, *see generally Pet. Mot. to Reuse/Consolidate*, pp. 3-4, and continues to believe so regardless of how the Board may rule on the co-pending *Motion to Compel*. However, should the Board believe that the existence of that discovery dispute (which dates back to July) precludes the grant of consolidation, Petitioner would be willing to withdraw the co-pending motion if the Board so orders, even though Petitioner believes that the basis for the motion is sound and that the requested discovery would be both relevant and helpful to the issues raised in the Cancellation proceeding."

Respondent/Applicant's testimony period in the Opposition was originally set to close on August 29, 2007. *See Opp. Docket No. 35 and 39.* During that time, Petitioner was fully prepared to attend any trial depositions that Respondent/Applicant noticed for that period, but none were ever noticed. Instead, on August 13, 2007, Respondent/Applicant requested that its Opposition testimony period be extended until September 28th. *See* Ex. D. Petitioner agreed to accommodate that request, but because it knew that it might have scheduling conflicts on certain dates, Petitioner conditioned its consent on Respondent/Applicant working with Petitioner when choosing the September deposition dates. *See id.* At the same time, Petitioner also insisted that Respondent/Applicant provide a date for the Rule 30(b)(6) deposition that Petitioner had originally noticed in July as part of the Cancellation proceeding. *See id.* Respondent/Applicant agreed to those terms, and proceeded to file a consent motion to extend testimony until the end of September.

Immediately thereafter, though, Respondent/Applicant reneged on its promises. On short notice (and without consulting Petitioner), it noticed depositions for September 12, 13, and 19. *See* Ex. E. Petitioner quickly responded that although it was available on the 19th, it could not do the 12th or 13th because of a variety of other commitments and requested that Respondent reschedule those dates.[4] *See* Ex. H. Respondent/Applicant, though, informed Petitioner that if

[4] Respondent/Applicant's claim that Petitioner's objections to the deposition scheduling were unfounded, *see Opp. to Mot.* at 4-5, is yet another unfounded character attack. While Petitioner initially complained of the exceedingly short notice (for which Respondent/Applicant later apologized, *see* Ex. G), subsequent communications between the parties make it clear that Petitioner was willing to attend the September 12th and 13th depositions provided that Respondent/Applicant could reschedule them for a more convenient time (either later in September, as Petitioner originally proposed, or in November, after Respondent/Applicant's counsel's conflict was supposed to have been resolved, *see e.g.* Ex. H). Respondent/Applicant raises red herrings such as whether any Petitioner's counsel are Jewish (the answer is "yes"), and accuses Petitioner's counsel of engaging in chicanery. *See Opp. to Mot.* at 3-4. The fact of the matter, though, is that Mr. Kane told counsel for Respondent/Applicant why he could not attend on the scheduled deposition dates, and he then conferred with co-counsel as to their availability, both of who also had conflicts on September 12 and 13. Nonetheless, Petitioner remained willing to work with Respondent, and even inquired as to possible later dates, only to be told that no dates were available *before February*. *See* Ex. I. Moreover, it should be noted that it was only *after* Petitioner consented to Respondent/Applicant's request to extend

the depositions did not go forward on the September dates it had proposed (and with which Petitioner had a legitimate conflict), it would not take those depositions until sometime *in February*, even though Petitioner had indicated a willingness and ability to attend on earlier dates. *See* Exs. H and I (at p.2). Thus, quite contrary to Respondent/Applicant's baseless allegation, Petitioner in no way "maneuvered" the trial schedules into alignment. The simple fact is that counsel for Respondent/Applicant made it clear that it not available to attend any depositions in either the Opposition or Cancellation at anytime **from October through January**, thus ensuring that no testimony would be presented before February 2008 in either case. *See* Ex. I.

Respectfully submitted,

KENYON & KENYON LLP

Date: November 7, 2007

By: /Erik C. Kane/

Edward T. Colbert
William M. Merone
Erik C. Kane
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1500 K Street, N.W.; Suite 700
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Tel.: (202) 220 – 4200
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Counsel for Petitioner/Opposer,
THE CHAMBER OF COMMERCE OF THE UNITED STATES OF AMERICA

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trial into September that Respondent/Applicant indicated the only dates that it could offer in September would be the "take-it-or-leave it" dates of September 12th and 13th. Knowing this, Respondent/Applicant should have put on its testimony period as originally scheduled in August, which Petitioner had blocked out for this case.

Exhibit A

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, Petitioner, vs. UNITED STATES HISPANIC CHAMBER OF COMMERCE, Respondent.	Cancellation No.: 92/045,876 Reg. No.: 2,886,207 **RESPONDENT UNITED STATES HISPANIC CHAMBER OF COMMERCE'S RESPONSE TO PETITIONER'S FIRST SET OF INTERROGATORIES**

Pursuant to Federal Civil Procedure Rules 26 and 33 and the Rules of the Trademark Trial and Appeal Board, Respondent United States Hispanic Chamber of Commerce ("Respondent") responds to Petitioner The Chamber of Commerce of the United States of America ("Petitioner") First Set of Interrogatories as follows.

PRELIMINARY STATEMENT

These responses are made solely for the purposes of this action. Any information supplied in response to any particular interrogatory is or will be supplied by Respondent subject to all objections as to competence, relevance, materiality, propriety, admissibility, and any and all other objections on any grounds that would require the exclusion of the information or portion thereof if such information were offered into evidence, all of which objections and grounds are hereby expressly reserved and may be interposed at the time of trial.

No incidental or implied admissions are intended by the responses herein. The fact that Respondent has supplied, or hereafter supplies, information in response to any particular interrogatory should not be taken as an admission that Respondent accepts or admits the existence of any fact set forth or assumed by such interrogatory or that such information constitutes admissible evidence. The fact that Respondent has supplied or hereafter supplies

12/4/06

INTERROGATORY NO. 2:

Describe the corporate relationship (including issues such as annual funding and corporate control) between Respondent and the United States Hispanic Chamber of Commerce Foundation, and identify all documents relating thereto.

RESPONSE TO INTERROGATORY NO. 2:

Respondent incorporates by reference its General Objections as though set forth in full herein. Respondent objects to this interrogatory because it is vague, ambiguous and does not describe the information sought with reasonable particularity. Respondent further objects to this interrogatory on the grounds that it seeks information and documents protected by the attorney-client privilege and the work product doctrine. Respondent further objects to this interrogatory on the grounds that it seeks confidential commercial information of Respondent. Respondent further objects to this interrogatory because it seeks irrelevant information and is not reasonably calculated to lead to the discovery of admissible evidence.

Without waiving such objections, Respondent responds as follows: Respondent and the United States Hispanic Chamber of Commerce Foundation (the "USHCCF") are independent entities. Respondent has authorized the creation of USHCCF, USHCCF's

corporate bylaws convey authority to Respondent to determine USHCCF's members of the board, and certain provisions of USHCCF's bylaws cannot be revised without the approval of Respondent. The documents related to these issues are USHCCF's and Respondent's bylaws and articles of incorporation.

Exhibit B

GOVERNMENT OF THE DISTRICT OF COLUMBIA
DEPARTMENT OF CONSUMER AND REGULATORY AFFAIRS

CERTIFICATE

THIS IS TO CERTIFY that the attached is a true and correct copy of the documents for this entity as shown by the records of this office.

UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION, INC.

IN TESTIMONY WHEREOF I have hereunto set my hand and caused the seal of this office to be affixed this **30th** day of **October, 2007**.

LINDA K. ARGO
Director

PATRICIA E. GRAYS
Superintendent of Corporations
Corporations Division

Adrian M. Fenty
Mayor

GOVERNMENT OF THE DISTRICT OF COLUMBIA
DEPARTMENT OF CONSUMER AND REGULATORY AFFAIRS

CERTIFICATE

THIS IS TO CERTIFY that all applicable provisions of the District of Columbia NonProfit Corporation Act have been complied with and accordingly, this ***CERTIFICATE OF AMENDMENT*** is hereby issued to:

UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION, INC.

IN WITNESS WHEREOF I have hereunto set my hand and caused the seal of this office to be affixed as of the **25th** day of **October, 2000.**

Carlynn M. Fuller
Acting Director

Patricia E. Grays
Acting Administrator
Business Regulation Administration

William L. Ables Jr.
Act. Assistant Superintendent of Corporations
Corporations Division

Anthony A. Williams
Mayor

931123

ARTICLES OF AMENDMENT
UNITED STATES HISPANIC CHAMBER
OF COMMERCE FOUNDATION, INC.
(A District of Columbia Non-Profit Corporation)

1. The name of the corporation is: United States Hispanic Chamber of Commerce Foundation, Inc.

2. Article Fifth of the Articles of Incorporation is hereby amended to read as follows:

   The Directors of the Foundation shall be elected by the Board of Directors of the United States Hispanic Chamber of Commerce ("USHCC"). The number of Directors shall be no less than six (6) and no more than twenty-one (21), and there shall be at least one (1) USHCC Board member from each USHCC Region elected to the Foundation Board. A Director of the Foundation may be elected or removed (with or without cause) as set forth in Article IV, Section 9 of the Bylaws.

3. Article Tenth is hereby added to the Articles of Incorporation and reads as follows:

   The Bylaws of this Foundation shall be altered, amended, or repealed only as set forth in the Foundation's Bylaws, Article XIV but cannot be altered, amended or repealed so as to conflict with these Articles of Incorporation. These Articles of Incorporation may only be altered, amended or repealed by resolution of the United States Hispanic Chamber of Commerce Board of Directors and in addition by a vote of two-thirds (2/3) of the Foundation directors present at any meeting with a quorum present.

4. This corporation has no members.

5. This corporation has no corporate seal.

6. These amendments reflected above were adopted at a meeting of the board of directors of both the USHCC and Foundation Board on January 20, 2000, and these amendments received a vote of a majority of the directors in office of the USHCC and two-thirds (2/3) of the Foundation directors present at a meeting with a quorum present.

IN WITNESS WHEREOF, the undersigned have caused this document to be duly executed as of the date first above written.

UNITED STATES HISPANIC CHAMBER OF COMMERCE, INC.

Ray Arvizu
Chairperson and Secretary

UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION, INC.

Lilliam Lujan Hickey
Chairperson and Secretary

Jane Garcia
President and C.E.O.

FILE
OCT 25 2000

GOVERNMENT OF THE DISTRICT OF COLUMBIA
DEPARTMENT OF CONSUMER AND REGULATORY AFFAIRS

C E R T I F I C A T E

THIS IS TO CERTIFY that the attached is a true and correct copy of the documents for this entity as shown by the records of this office.

UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION, INC.

IN TESTIMONY WHEREOF I have hereunto set my hand and caused the seal of this office to be affixed this **30th** day of **October, 2007 .**

LINDA K. ARGO
Director

PATRICIA E. GRAYS
Superintendent of Corporations
Corporations Division

Adrian M. Fenty
Mayor

GOVERNMENT OF THE DISTRICT OF COLUMBIA
DEPARTMENT OF CONSUMER AND REGULATORY AFFAIRS

CERTIFICATE

THIS IS TO CERTIFY that all applicable provisions of the District of Columbia NonProfit Corporation Act have been complied with and accordingly, this ***CERTIFICATE OF AMENDMENT*** is hereby issued to:

UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION, INC.

IN WITNESS WHEREOF I have hereunto set my hand and caused the seal of this office to be affixed as of the **25th** day of **October, 2002.**

David Clark
DIRECTOR

Elizabeth O. Kim
Administrator
Business Regulation Administration

William L. Ables Jr.
Act. Assistant Superintendent of Corporations
Corporations Division

Anthony A. Williams
Mayor

931123

ARTICLES OF AMENDMENT TO THE ARTICLES OF INCORPORATION OF UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION, INC.

A District of Columbia Non-Profit Corporation

TO:
DEPARTMENT OF CONSUMER AND REGULATORY AFFAIRS
BUSINESS REGULATION ADMINISTRATION
CORPORATIONS DIVISION
941 NORTH CAPITOL STREET, N.E.
WASHINGTON, D.C. 20002

Pursuant to the provisions of the District of Columbia non-profit Corporation Act, the undersigned adopts the following Articles of Amendment to its Articles of Incorporation:

1. The name of the corporation is: **United States Hispanic Chamber of Commerce Foundation, Inc.**

2. The following amendment of the Articles of Incorporation was adopted by the Corporation in the manner prescribed by the District of Columbia Non-profit Corporation Act:

   Article Fifth of the Articles of Incorporation is hereby amended to read as follows:

   > **The Directors of the Foundation shall be elected by the Board of Directors of the United States Hispanic Chamber of Commerce ("USHCC"). The number of Directors shall be no less than six (6) and no more than twenty-one (21), and there shall be at least one (1) and not more than two (2) USHCC Board members from each USHCC Region elected to the Foundation Board. A Director of the Foundation may be elected or removed (with or without cause) as set forth in Article IV, Section 9 of the Bylaws.**

3. The amendment was adopted at a meeting of the Board of Directors of the Foundation held on November 1, 2001, and received the vote of two-thirds of the Directors in office, there being no members having voting rights in respect thereof; in addition, in compliance with the Foundation's Articles of Incorporation, the amendment was unanimously approved by resolution of the United States Hispanic Chamber of Commerce Board of Directors.

Dated: June 27, 2002

UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION, INC.

By: Liliam Lujan-Hickey, President

ATTEST:

By: Maria Guadalupe Taxman, Secretary

FILE
OCT 25 2002

J:\CLIENTS\60737\00001\K0251018.DOC

Exhibit C

Form **990**

Department of the Treasury
Internal Revenue Service

Return of Organization Exempt From Income Tax

Under section 501(c), 527, or 4947(a)(1) of the Internal Revenue Code (except black lung benefit trust or private foundation)

► The organization may have to use a copy of this return to satisfy state reporting requirements.

OMB No. 1545-0047

2005

Open to Public Inspection

A For the 2005 calendar year, or tax year beginning 4/01, 2005, and ending 3/31, 2006

B Check if applicable.
- [ ] Address change
- [ ] Name change
- [ ] Initial return
- [ ] Final return
- [ ] Amended return
- [ ] Application pending

Please use IRS label or print or type. See specific instructions.

UNITED STATES HISPANIC CHAMBER
OF COMMERCE FOUNDATION, INC.
2175 K STREET, N.W. #320
WASHINGTON, DC 20037

D Employer identification number: 52-1754621

E Telephone number: (202) 429-0516

F Accounting method: [ ] Cash [X] Accrual [ ] Other (specify) ►

• **Section 501(c)(3) organizations and 4947(a)(1) nonexempt charitable trusts must attach a completed Schedule A (Form 990 or 990-EZ).**

H and I are not applicable to section 527 organizations

H (a) Is this a group return for affiliates? [ ] Yes [X] No

H (b) If 'Yes,' enter number of affiliates ►

H (c) Are all affiliates included? [ ] Yes [ ] No (If 'No,' attach a list. See instructions.)

H (d) Is this a separate return filed by an organization covered by a group ruling? [ ] Yes [X] No

I Group Exemption Number ►

G Web site: ► WWW.USHCCFOUNDATION.ORG

J Organization type (check only one) ► [X] 501(c) 3 ◄ (insert no.) [ ] 4947(a)(1) or [ ] 527

K Check here ► [ ] if the organization's gross receipts are normally not more than $25,000. The organization need not file a return with the IRS; but if the organization chooses to file a return, be sure to file a complete return. **Some states require a complete return.**

M Check ► [X] if the organization is not required to attach Schedule B (Form 990, 990-EZ, or 990-PF).

L Gross receipts: Add lines 6b, 8b, 9b, and 10b to line 12 ► 1,504,357.

Part I Revenue, Expenses, and Changes in Net Assets or Fund Balances (See Instructions)

REVENUE	1 Contributions, gifts, grants, and similar amounts received:				
	a Direct public support	1a	1,246,421.		
	b Indirect public support	1b			
	c Government contributions (grants)	1c			
	d Total (add lines 1a through 1c) (cash $ 1,246,421. noncash $)			1d	1,246,421.
	2 Program service revenue including government fees and contracts (from Part VII, line 93)			2	
	3 Membership dues and assessments			3	
	4 Interest on savings and temporary cash investments			4	1,616.
	5 Dividends and interest from securities			5	
	6a Gross rents	6a			
	b Less: rental expenses	6b			
	c Net rental income or (loss) (subtract line 6b from line 6a)			6c	
	7 Other investment income (describe ►)			7	

	(A) Securities		(B) Other
8a Gross amount from sales of assets other than inventory		8a	
b Less: cost or other basis and sales expenses		8b	
c Gain or (loss) (attach schedule)		8c	

	d Net gain or (loss) (combine line 8c, columns (A) and (B))			8d	
	9 Special events and activities (attach schedule). If any amount is from **gaming**, check here ► [ ]				
	a Gross revenue (not including $ of contributions reported on line 1a)	9a	255,170.		
	b Less: direct expenses other than fundraising expenses	9b	99,934.		
	c Net income or (loss) from special events (subtract line 9b from line 9a) STATEMENT 1			9c	155,236.
	10a Gross sales of inventory, less returns and allowances	10a			
	b Less: cost of goods sold	10b			
	c Gross profit or (loss) from sales of inventory (attach schedule) (subtract line 10b from line 10a)			10c	
	11 Other revenue (from Part VII, line 103)			11	1,150.
	12 **Total revenue** (add lines 1d, 2, 3, 4, 5, 6c, 7, 8d, 9c, 10c, and 11)			12	1,404,423.
EXPENSES	13 Program services (from line 44, column (B))			13	718,773.
	14 Management and general (from line 44, column (C))			14	168,894.
	15 Fundraising (from line 44, column (D))			15	
	16 Payments to affiliates (attach schedule)			16	
	17 **Total expenses** (add lines 16 and 44, column (A))			17	887,667.
NET ASSETS	18 Excess or (deficit) for the year (subtract line 17 from line 12)			18	516,756.
	19 Net assets or fund balances at beginning of year (from line 73, column (A))			19	399,807.
	20 Other changes in net assets or fund balances (attach explanation)			20	
	21 Net assets or fund balances at end of year (combine lines 18, 19, and 20)			21	916,563.

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BAA For Privacy Act and Paperwork Reduction Act Notice, see the separate instructions.

TEEA0109L 02/03/06 Form 990 (2005)

p 9

Part V-A Current Officers, Directors, Trustees, and Key Employees *(continued)*

		Yes	No
75 a Enter the total number of officers, directors, and trustees permitted to vote on organization business as board meetings ► 13			
b Are any officers, directors, trustees, or key employees listed in Form 990, Part V-A, or highest compensated employees listed in Schedule A, Part I, or highest compensated professional and other independent contractors listed in Schedule A, Part II-A or II-B, related to each other through family or business relationships? If 'Yes,' attach a statement that identifies the individuals and explains the relationship(s)	75b		X
c Do any officers, directors, trustees, or key employees listed in form 990, Part V-A, or highest compensated employees listed in Schedule A, Part I, or highest compensated professional and other independent contractors listed in Schedule A, Part II-A or II-B, receive compensation from any other organizations, whether tax exempt or taxable, that are related to this organization through common supervision or common control?	75c		X
Note. Related organizations include section 509(a)(3) supporting organizations. If 'Yes,' attach a statement that identifies the individuals, explains the relationship between this organization and the other organization(s), and describes the compensation arrangements, including amounts paid to each individual by each related organization			
d Does the organization have a written conflict of interest policy?	75d	X	

Part V-B Former Officers, Directors, Trustees, and Key Employees That Received Compensation or Other Benefits (If any former officer, director, trustee, or key employee received compensation or other benefits (described below) during the year, list that person below and enter the amount of compensation or other benefits in the appropriate column. See the instructions.)

(A) Name and address	(B) Loans and Advances	(C) Compensation	(D) Contributions to employee benefit plans and deferred compensation plans	(E) Expense account and other allowances

Part VI Other Information *(See the instructions.)*

		Yes	No
76 Did the organization engage in any activity not previously reported to the IRS? If 'Yes,' attach a detailed description of each activity	76		X
77 Were any changes made in the organizing or governing documents but not reported to the IRS? If 'Yes,' attach a conformed copy of the changes.	77		X
78 a Did the organization have unrelated business gross income of $1,000 or more during the year covered by this return?	78a		X
b If 'Yes,' has it filed a tax return on **Form 990-T** for this year?	78b	N/A	
79 Was there a liquidation, dissolution, termination, or substantial contraction during the year? If 'Yes,' attach a statement	79		X
80 a Is the organization related (other than by association with a statewide or nationwide organization) through common membership, governing bodies, trustees, officers, etc, to any other exempt or nonexempt organization?	80a	X	
b If 'Yes,' enter the name of the organization ► U. S. HISPANIC CHAMBER OF COMMERCE and check whether it is [X] exempt or [ ] nonexempt.			
81 a Enter direct and indirect political expenditures. (See line 81 instructions.) 81a 0.			
b Did the organization file **Form 1120-POL** for this year?	81b		X

Part VII Information Regarding Transfers To and Transactions and Relationships With Noncharitable Exempt Organizations (See instructions)

51 Did the reporting organization directly or indirectly engage in any of the following with any other organization described in section 501(c) of the Code (other than section 501(c)(3) organizations) or in section 527, relating to political organizations?

		Yes	No
a Transfers from the reporting organization to a noncharitable exempt organization of:			
(i) Cash	51a (i)		X
(ii) Other assets	a (ii)		X
b Other transactions:			
(i) Sales or exchanges of assets with a noncharitable exempt organization	b (i)		X
(ii) Purchases of assets from a noncharitable exempt organization	b (ii)		X
(iii) Rental of facilities, equipment, or other assets	b (iii)		X
(iv) Reimbursement arrangements	b (iv)	X	
(v) Loans or loan guarantees	b (v)		X
(vi) Performance of services or membership or fundraising solicitations	b (vi)		X
c Sharing of facilities, equipment, mailing lists, other assets, or paid employees	c	X	

d If the answer to any of the above is 'Yes,' complete the following schedule. Column (b) should always show the fair market value of the goods, other assets, or services given by the reporting organization. If the organization received less than fair market value in any transaction or sharing arrangement, show in column (d) the value of the goods, other assets, or services received:

(a) Line no.	(b) Amount involved	(c) Name of noncharitable exempt organization	(d) Description of transfers, transactions, and sharing arrangements
		UNITED STATES HISPANIC	
BIV		CHAMBER OF COMMERCE	ADVANCES RECEIVED
C		SAME AS ABOVE	OFFICE FACILITIES

52a Is the organization directly or indirectly affiliated with, or related to, one or more tax-exempt organizations described in section 501(c) of the Code (other than section 501(c)(3)) or in section 527? ► [X] Yes [ ] No

b If 'Yes,' complete the following schedule:

(a) Name of organization	(b) Type of organization	(c) Description of relationship
SAME AS LINE 51 ABOVE	501(C)(6)	THIRTEEN MEMBERS OF THE BOARD OF DIRECTORS OF THE UNITED STATES HISPANIC CHAMBER OF COMMERCE SERVE AS THE BOARD OF DIRECTORS OF THE FOUNDATION

Exhibit D

KENYON & KENYON LLP
Intellectual Property Law

Erik C. Kane
Direct 202.220.4294
ekane@kenyon.com

1500 K Street, NW
Washington, DC 20005-1257
202.220.4200
Fax 202.220.4201

August 14, 2007

By Facsimile: (310) 312-4224 ***Confirmation by U.S. Mail***

Andrew Eliseev
MANATT, PHELPS & PHILLIPS L.P.
11355 West Olympic Blvd.
Los Angeles, California 90064-1614

Re: *The Chamber of Commerce of the United States v. U.S. Hispanic Chamber of Commerce,* Cancellation No. 92/045,876

Dear Andrew:

I am writing in response to your fax of July 30 and our telephone conversation of yesterday.

In response to your request for a thirty day extension in the Opposition proceeding, we have consented to extend the testimony period until September 30. In return, you have agreed that if we have any conflicts that prevent us from attending any of the testimony depositions you may notice, you will work with us to find a mutually-agreeable alternative date(s).

Regarding our request in the Cancellation proceeding for a 30(b)(6) deposition, you are now agreeing to produce your 30(b)(6) witness during your testimony period in the Opposition proceeding. We are amenable to this, and request that you provide us with proposed deposition dates. We will continue to insist, however, that the 30(b)(6) deposition be held in Washington, DC, where Respondent is based, but are amendable to having it take place here concurrently with your testimony depositions in the Opposition so as to avoid unnecessary travel.

I also confirm that you have agreed that you will produce your 30(b)(6) witness(es) for all the topics noticed in our Notice of Deposition. While I understand that you have certain objections to the deposition categories, you have not indicated that those objections in any way prevent you from fully preparing your witness to testify as to the subject matters raised.

For your convenience and for purposes of further clarification, I have attached a copy of the categories enumerated in Schedule A of the Notice of Deposition. Beneath some of those categories, I have provided specific examples of areas of inquiry that likely will be addressed during the 30(b)(6) deposition. While this list is by no means meant to be exclusive, it is my hope that this further clarification will obviate any objections you may have with respect to the

wording of those topics, thus allowing the deposition to proceed smoothly. If you need further clarification, please provide me with a detailed outline of your specific concerns in writing.

If your understanding as to these issues in any way conflict with what I have set forth, please contact me immediately so that we can discuss.

Very truly yours,

KENYON & KENYON LLP

Erik C. Kane

Erik C. Kane

ECK

cc: Jill M. Pietrini, Esq.

SCHEDULE A

The DEFINITIONS and INSTRUCTIONS contained in Petitioner's First Request For Production of Documents, which was served on counsel for Respondent on October 19, 2006, are incorporated by reference and shall apply to the matters listed below.

1. The organization and structure of Respondent, including its relationship with any affiliate organizations.

POSSIBLE AREAS OF INQUIRY:

Respondent's officers, management, and directors and their responsibilities, as well as Respondent's connection with the U.S. Hispanic Chamber of Commerce Foundation.

2. The adoption and first use of Respondent's Mark (including the UNITED STATES HISPANIC CHAMBER OF COMMERCE name) in the United States.

POSSIBLE AREAS OF INQUIRY:

How, when, and why Respondent adopted its mark. Alternates considered. Respondent's first use of the mark. The geographic extent of first use.

3. The nature and extent of use of the Respondent's Mark (including the UNITED STATES HISPANIC CHAMBER OF COMMERCE name) in the United States from its date of first use to the present, including the various types of activities, goods, and services with which the mark has been used.

POSSIBLE AREAS OF INQUIRY:

The nature of the use of Respondent's Mark over time. The various goods and services with which the mark has been used, and how that has changed. The geographic extent of use.

4. The nature and extent of any use of any shortened variations of Respondent's Mark (including the UNITED STATES HISPANIC CHAMBER OF COMMERCE name) in the United States from its date of first use to the present, including the various types of activities, goods, and services with which the mark has been used.

POSSIBLE AREAS OF INQUIRY:

Any use (including use on "second reference", e.g. abbreviating your name in a newspaper after first reciting the full name) of shortened forms of Respondent's mark, including, for example, referring to Respondent as "U.S. Hispanic," "U.S. Chamber," "The National Chamber," "The Hispanic Chamber," or the like. This is not limited to authorized uses (such as uses in

compliance with any guidelines of Respondent), but is intended to cover all uses of shortened forms in any literature, presentation, etc.

5. Any third party use of any shortened variations of Respondent's Mark (including the UNITED STATES HISPANIC CHAMBER OF COMMERCE name) when referring to Respondent in the United States.

POSSIBLE AREAS OF INQUIRY:

See above, but applied to media reference, statements made by conference attendees to officers or agents of Respondent, etc.

6. Respondent's membership from its date of first use of Respondent's Mark to the present, including information on total membership and ethnic breakdown.

POSSIBLE AREAS OF INQUIRY:

How Respondent's membership has changed over time. The number and ethnic composition of Respondent's membership at the time of Respondent's adoption of its Mark and for each year thereafter. The various ways that Respondent classifies or categorizes members (whether based on type of business – such as small business, sole proprietors, mid-size business, etc. – or based on ethnicity – such as Hispanic versus non-Hispanic. How Respondent defines "Hispanic".

7. Any instances of which Respondent (and/or any parent or affiliated organization) is aware of any request, communication, action, belief, inquiries, media inquiries, or statements from, of, or by any person, organization, or entity suggesting, stating, reporting on, relating to, or concerning whether or that there is or was any relationship, association, affiliation, connection, license or other agreement (including any perception of sponsorship or approval) between Respondent (including any employee, agent, or representative thereof), and Petitioner (including any employee, agent, or representative thereof).

8. Any instances of which Respondent (and/or any parent or affiliated organization) is aware of any request, communication, action, belief, inquiries, media inquiries, or statements from, of, or by any person, organization, or entity suggesting, stating, reporting on, relating to, or concerning whether or that there is or was any relationship, association, affiliation, connection, license or other agreement (including any perception of sponsorship or approval) between Respondent (including any employee, agent, or representative thereof), and Petitioner's marks or any other indicia of origin used by Petitioner.

9. Any instances of which Respondent (and/or any parent or affiliated organization) is aware of any request, communication, action, belief, inquiries, media inquiries, or statements from, of, or by any person, organization, or entity suggesting, stating, reporting on, relating to, or concerning whether or that there is or was any relationship, association, affiliation, connection, license or other agreement (including any perception of sponsorship

or approval) between Respondent (including any employee, agent, or representative thereof), and any goods or services offered by Petitioner.

10. Any instances of which Respondent (and/or any parent or affiliated organization) is aware of any request, communication, action, belief, inquiries, media inquiries, or statements from, of, or by any person, organization, or entity suggesting, stating, reporting on, relating to, or concerning whether or that there is or was any relationship, association, affiliation, connection, license or other agreement (including any perception of sponsorship or approval) between any of Respondent's marks, and Petitioner (including any employee, agent, or representative thereof).

11. Any instances of which Respondent (and/or any parent or affiliated organization) is aware of any request, communication, action, belief, inquiries, media inquiries, or statements from, of, or by any person, organization, or entity suggesting, stating, reporting on, relating to, or concerning whether or that there is or was any relationship, association, affiliation, connection, license or other agreement (including any perception of sponsorship or approval) between any of Respondent's marks and Petitioner's marks, any other indicia of origin used by Petitioner.

12. Any instances of which Respondent (and/or any parent or affiliated organization) is aware of any request, communication, action, belief, inquiries, media inquiries, or statements from, of, or by any person, organization, or entity suggesting, stating, reporting on, relating to, or concerning whether or that there is or was any relationship, association, affiliation, connection, license or other agreement (including any perception of sponsorship or approval) between Respondent's marks and any goods or services offered by Petitioner.

POSSIBLE AREAS OF INQUIRY:

Although broken out as six separate inquiries (each of which is slightly different), Categories 7-12 are intended to cover collectively any instances of actual confusion of which Respondent may be aware. This would include any events or interactions of the type(s) testified to during the Opposition proceeding by Ms. Olivera, Ms. Logan, and/or Ms. Perlman, even if Respondent may not regard those instances as constituting "confusion" per se. So, for example, these categories would cover, but are in no way limited to, any casual (or initial) inquiries Respondent (or anyone working on its behalf) has ever received about any affiliation between Respondent (or any event sponsored by, or any service provided by, Respondent) and Petitioner (or its events, etc.); any "misattributions" or "misidentifications" ever made by anyone in the media; or stated belief by a third party that Respondent and Petitioner (or their events) were somehow connected.

13. Any surveys, public opinion polls or other consumer research known to Respondent (and/or any parent or affiliated organization) relating to Respondent's Mark, Petitioner, or Petitioner's marks listed in its Petition for Cancellation.

POSSIBLE AREAS OF INQUIRY:

Any research relating to Respondent's mark or to Petitioner or any of Petitioner's marks.

14. All evidence that supports or contradicts Respondent's counterclaims.

15. The basis and underlying theory for Respondent's claim that the Petitioner's marks represented by Reg. Nos. 1,686,865, 1,522,157, 1,436,813 and 1,430,627 should be cancelled and all evidence relating thereto.

16. The basis and underlying theory for Respondent's claim that there is not likely to be any confusion as between Respondent's mark and one or more of Petitioner's Marks and all evidence relating thereto.

POSSIBLE AREAS OF INQUIRY:

None of these categories 14-16 would seem to require further clarification.

Exhibit E

Docket No. 27206-060

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

In Re Application Serial No. 78/081,731 for U.S. HISPANIC CHAMBER OF COMMERCE FOUNDATION & Design THE CHAMBER OF COMMERCE OF THE UNITED STATES OF AMERICA, Opposer, vs. UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION, Applicant.	Opposition No. 91-156,321 **APPLICANT UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION'S NOTICE OF TAKING TESTIMONY DEPOSITION OF FRANK LOPEZ**

TO OPPOSER AND ITS ATTORNEYS OF RECORD:

Pursuant to 37 C.F.R. § 2.123(c) and the Federal Rules of Civil Procedure, Applicant United States Hispanic Chamber of Commerce Foundation ("Applicant") will take the testimony deposition, by oral examination, of Frank Lopez on **September 12, 2007,** beginning at 9:30 a.m., at the following address:

Manatt, Phelps & Phillips, LLP
One Metro Center
700 12th Street, N.W., Suite 1100
Washington, D.C. 20005

The deposition will be conducted before an officer authorized to administer oaths and will be recorded by stenographic methods. Opposer is invited to attend and cross-examine.

MANATT, PHELPS & PHILLIPS, LLP
Jill M. Pietrini
Andrew Eliseev

Dated: August 29, 2007

By: _____
Jill M. Pietrini
Attorneys for Applicant United States Hispanic Chamber of Commerce Foundation

9/4/07

CERTIFICATE OF SERVICE

I hereby certify that the foregoing **APPLICANT UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION'S NOTICE OF TAKING TESTIMONY DEPOSITION OF FRANK LOPEZ** has been served upon the attorney for Opposer by depositing a copy thereof in an envelope addressed to:

Erik Kane
KENYON & KENYON
1500 K Street, N.W., Suite 700
Washington, DC 20005

on this 29th day of August, 2007.

LaTrina Martin

41151115.1

Docket No. 27206-060

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

In Re Application Serial No. 78/081,731 for U.S. HISPANIC CHAMBER OF COMMERCE FOUNDATION & Design THE CHAMBER OF COMMERCE OF THE UNITED STATES OF AMERICA, Opposer, vs. UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION, Applicant.	Opposition No. 91-156,321 **APPLICANT UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION'S NOTICE OF TAKING TESTIMONY DEPOSITION OF JOSÉ NINO**

TO OPPOSER AND ITS ATTORNEYS OF RECORD:

Pursuant to 37 C.F.R. § 2.123(c) and the Federal Rules of Civil Procedure, Applicant United States Hispanic Chamber of Commerce Foundation ("Applicant") will take the testimony deposition, by oral examination, of José Nino on **September 13, 2007,** beginning at 9:30 a.m., at the following address:

Manatt, Phelps & Phillips, LLP
One Metro Center
700 12th Street, N.W., Suite 1100
Washington, D.C. 20005

The deposition will be conducted before an officer authorized to administer oaths and will be recorded by stenographic methods. Opposer is invited to attend and cross-examine.

MANATT, PHELPS & PHILLIPS, LLP
Jill M. Pietrini
Andrew Eliseev

Dated: August 29, 2007

By: _____
Jill M. Pietrini
Attorneys for Applicant United States Hispanic Chamber of Commerce Foundation

9/4/07

CERTIFICATE OF SERVICE

I hereby certify that the foregoing **APPLICANT UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION'S NOTICE OF TAKING TESTIMONY DEPOSITION OF JOSÉ NINO** has been served upon the attorney for Opposer by depositing a copy thereof in an envelope addressed to:

Erik Kane
KENYON & KENYON
1500 K Street, N.W., Suite 700
Washington, DC 20005

on this 29th day of August, 2007.

LaTrina Martin

41151122.1

Docket No. 27206-060

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

In Re Application Serial No. 78/081,731 for U.S. HISPANIC CHAMBER OF COMMERCE FOUNDATION & Design THE CHAMBER OF COMMERCE OF THE UNITED STATES OF AMERICA, Opposer, vs. UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION, Applicant.	Opposition No. 91-156,321 **APPLICANT UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION'S NOTICE OF TAKING TESTIMONY DEPOSITION OF MONICA DANNER**

TO OPPOSER AND ITS ATTORNEYS OF RECORD:

Pursuant to 37 C.F.R. § 2.123(c) and the Federal Rules of Civil Procedure, Applicant United States Hispanic Chamber of Commerce Foundation ("Applicant") will take the testimony deposition, by oral examination, of Monica Danner on **September 19, 2007,** beginning at 9:30 a.m., at the following address:

Manatt, Phelps & Phillips, LLP
11355 West Olympic Boulevard
Los Angeles, CA 90064-1614

The deposition will be conducted before an officer authorized to administer oaths and will be recorded by stenographic methods. Opposer is invited to attend and cross-examine.

MANATT, PHELPS & PHILLIPS, LLP
Jill M. Pietrini
Andrew Eliseev

Dated: August 29, 2007

By: _____
Jill M. Pietrini
Attorneys for Applicant United States Hispanic Chamber of Commerce Foundation

9/4/07

CERTIFICATE OF SERVICE

I hereby certify that the foregoing **APPLICANT UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION'S NOTICE OF TAKING TESTIMONY DEPOSITION OF MONICA DANNER** has been served upon the attorney for Opposer by depositing a copy thereof in an envelope addressed to:

Erik Kane
KENYON & KENYON
1500 K Street, N.W., Suite 700
Washington, DC 20005

on this 29th day of August, 2007.

LaTrina Martin

41151123.1

Exhibit F

KENYON & KENYON LLP
Intellectual Property Law

Erik C. Kane
Direct 202.220.4294
ekane@kenyon.com

1500 K Street, NW
Washington, DC 20005-1257
202.220.4200
Fax 202.220.4201

September 5, 2007

By Facsimile: (310) 312-4224 ***Confirmation by U.S. Mail***

Andrew Eliseev
MANATT, PHELPS & PHILLIPS L.P.
11355 West Olympic Blvd.
Los Angeles, California 90064-1614

Re: *The Chamber of Commerce of the United States v. U.S. Hispanic Chamber of Commerce,*

Dear Andrew:

I am writing in response to the Notices of Deposition that you mailed to us, and which I received just today in the Opposition proceeding. To begin with, it is somewhat surprising that you chose to mail the Notices to us (over a holiday weekend no less) without also faxing them, as has usually been done with correspondence in this matter. The net result is that we have a mere seven days notice of your first scheduled deposition, which is presumptively improper.

Be that as it may, and as you will recall, you previously agreed that in return for Opposer agreeing to a thirty day extension of time in the testimony period, Applicant would work with us to find mutually agreeable testimony dates in the event Opposer had conflicts with the proposed dates. In view of that, we are currently investigating whether we can attend the depositions you noticed for September 12th and 13th in Washington, but it is not looking promising as the dates you selected conflict with the Jewish holidays. We will let you know by the end of tomorrow.

Separately, you also agreed back in August that you would provide us with dates for the 30(b)(6) deposition we had noticed in the cancellation proceeding for late July. You have been aware of our request for more than six weeks, but as of our telephone conference of today, you still have not provided us with any dates. And although you indicated that you would get back to us, you made similar representations in August. As such, we must insist that you let us know by the close of business on Thursday, September 6th, whether you will be producing witnesses in response to the 30(b)(6) notice and when you will be making those witness available.

Very truly yours,

KENYON & KENYON LLP

Erik C. Kane

Erik C. Kane

Exhibit G

manatt
manatt | phelps | phillips

Andrew Eliseev
Manatt, Phelps & Phillips, LLP
Direct Dial: (310) 312-4384
E-mail: AEliseev@Manatt.com

September 6, 2007

Client-Matter: 27206-030

VIA FACSIMILE

Erik C. Kane, Esq.
Kenyon & Kenyon
1500 K Street, N.W.
Washington, D.C. 20006

Re: ***The Chamber of Commerce of the United States of America v. United States Hispanic Chamber of Commerce***
Opposition No. 91-156321

Dear Erik:

This is in response to your letters of August 14, 2007 and September 5, 207. We believe that our letter responsive to your letter of August 14, 2007 had gone out, but it apparently did not. Accordingly, we apologize for the delay in responding to that letter.

Regarding the Notices of Taking Testimony in the opposition, I regret that they did not reach you earlier, as they were mailed on August 29, 2007, which was fourteen, fifteen, and nineteen days prior to the noticed testimony dates, respectively. Nevertheless, even if you only received them on September 5, 2007, the Notices still afford you seven, eight, and twelve days of notice, respectively. Because the earliest two depositions are scheduled in Washington, D.C., quite close to your office, and thus would not require any travel on your and your colleagues' part, the amount of notice we gave you is reasonable and not contrary to the TTAB guidelines. *See, e.g., Hamilton Burr Publishing Co. v. E.W. Communications, Inc.*, 216 U.S.P.Q. 802, 804 n.6 (TTAB 1982); TBMP §703.01(e).

Although two of the noticed dates conflict with Jewish holidays, we chose them because both witnesses, Ms. Pietrini or I are not Jewish, and we assumed that neither are the U.S. Chamber of Commerce's Kenyon & Kenyon team of attorneys. We do stand by our commitment to work with you on finding convenient deposition dates. However, due to the upcoming United States Hispanic Chamber of Commerce 2007 Annual Convention starting mid-September in Puerto Rico, the designated dates are the only dates on which one of our witnesses will be available for deposition in September. Further, October is not available because Ms. Pietrini will be out of the country almost the entire month. Therefore, we intend to go forward with these depositions, and we hope you are able to attend them as well. If we could provide alternate dates to you in September, we would. But the National Convention of our client has caused scheduling issues. In addition, one of the witnesses had a scheduling conflict early in September because of the marriage of his daughter.

As to the FRCP 30(b)(6) deposition in the cancellation proceeding, we have provided to you our objections to the topics designated in the notice of that deposition. Your August

manatt
manatt | phelps | phillips

14, 2007 letter restated the topics under the name "Possible Areas of Inquiry" in Schedule A attached to that letter. Do those topics now constitute new deposition topics? If so, please confirm that immediately, and we will serve our objections to them. If not, we stand by our objections to each particular topic in Schedule A attached to the deposition notice. Those objections should be resolved before a discovery deposition is taken. If we cannot come to an agreement, we will file a motion for protective order to limit the scope of the FRCP 30(b)(6) deposition.

Very truly yours,

Andrew Eliseev

Andrew Eliseev

AE/pes
cc: Melinda Guzman-Moore, Esq.

41153633.1

Exhibit H

KENYON & KENYON LLP
Intellectual Property Law

Erik C. Kane
Direct 202.220.4294
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1500 K Street, NW
Washington, DC 20005-1257
202.220.4200
Fax 202.220.4201

September 7, 2007

By Facsimile: (310) 312-4224
And e-mail

Confirmation by U.S. Mail

Andrew Eliseev
MANATT, PHELPS & PHILLIPS L.P.
11355 West Olympic Blvd.
Los Angeles, California 90064-1614

Re: *The Chamber of Commerce of the United States v. U.S. Hispanic Chamber of Commerce,* Opp. No. 91/156,321

Dear Andrew:

I am writing in further response to your fax of yesterday.

We thank you for your commitment to work with us on finding convenient deposition dates. Unfortunately, due to the very short notice given for the depositions on the 12th and 13th, we already have other commitments which prohibit attending the depositions on those dates. We understand your client's unavailability this month due to their Annual Convention and Ms. Pietrini's unavailability during the month of October. Therefore, we agree to resetting your testimony period dates to a later time, which appears to be in the month of November, in order to accommodate everyone's schedules. Please go ahead with our permission and file a consent request for extension of time to cover that change.

We are available to attend the deposition currently noticed for the 19th, and can go forward with it if you wish. However, we would understand if you desire to group all of your depositions together. Therefore, please let us know if you plan on proceeding with your deposition currently scheduled for the 19th, or if you will reschedule it to coincide with your other depositions in November.

Very truly yours,

KENYON & KENYON LLP

Erik C. Kane

Erik C. Kane

ECK

Exhibit I

Kane, Erik

From: Pietrini, Jill [JPietrini@manatt.com]
Sent: Friday, September 07, 2007 4:59 PM
To: Kane, Erik; Eliseev, Andrew
Cc: Colbert, Edward; Merone, William
Subject: RE: USCOC v. USHCOC

Erik:

It is interesting to note that you refuse to provide **any** legal authority for your position. We have provided it to you, and that authority is directly on point and demonstrates that we could proceed with those depositions despite your objections. Apparently, you have no authority for your position as to the length of notice provided.

As for your contention about an express agreement between counsel, we do not agree with your interpretation of the communications between the parties, particularly about your selection of dates for testimony depositions over a two week period on Washington DC.

With respect to the religion of the lawyers, **you** brought up the Jewish holidays. If you are going to rely upon the Jewish holidays as a bases not to appear at scheduled testimony depositions, it is distasteful if you and your colleagues are not even Jewish. And if that were truly an issue, of course we move the testimony depositions without anything further said. We explained our position in selecting next week for the depositions.

That being said, since you and your colleagues cannot attend next week's testimony depositions for whatever reason it *may be today* (notably you have been intentionally vague on your alleged reasons and those "reasons" have changed), and even though there is **no question that there was adequate notice** of the same under the FRCP and the TBMP, we will agree to extend the testimony dates. However, those dates must be extended to late January/February 2008. We have a trial out of state in early December and cannot conduct the testimony depositions in November or December for obvious reasons. If you have any dates in January or February 2008 that are definitely not available, I suggest that you give them to us now so that we can consider them, lest there be some other unspecified excuse why you cannot attend.

We will file a stipulated motion as to those dates next week. I am already late for the firm event because of this issue and I need to leave my office.

Jill Pietrini
manatt | phelps | phillips
11355 W. Olympic Blvd.
Los Angeles, CA 90064
(310) 312-4325
jpietrini@manatt.com

From: Kane, Erik [mailto:Ekane@kenyon.com]
Sent: Friday, September 07, 2007 1:19 PM

To: Pietrini, Jill; Eliseev, Andrew
Cc: Colbert, Edward; Merone, William
Subject: RE: USCOC v. USHCOC
Importance: High

Jill:

I am not going to argue the legal sufficiency of your notice, we can save that for another time if need be.

Our understanding has been that you would work with us to accommodate everyone's schedules in scheduling your depositions, a position reiterated in Andrew's letter of September 6.

We previously accommodated your schedules during our testimony period and moved dates and witnesses around to work for everyone. We acted on the basis that you would extend us the same courtesy.

When your testimony period was closing in August, we made an agreement with Andrew that we would consent to extend your testimony period through the end of September on condition that you work with us on the dates for those depositions, and that you would accommodate us with a concurrent date for our 30(b)(6) deposition in the Cancellation proceeding. See my letter of August 14. While we are not questioning the timing of the 30(b)(6), we can address that another time.

With this agreement, you filed the consent motion to extend your period and Andrew acknowledged our agreement in his fax of September 6. Despite these express undertakings, we were then served with your notices a mere week before the first deposition, and without any discussion on availability. Whether legally sufficient or not, it was very short notice and contrary to our explicit agreement on setting dates.

With regard to our conflicts, yes it is the Jewish holidays. However, I am not going to speak to either Mr. Colbert's or Mr. Merone's religion. Suffice it to say, both they and I have various prior conflicts for those dates, which you would have known had you but asked prior to sending out the notices. We are, as we have agreed and have done in the past, willing to work with you to set a schedule that works for all parties and attorneys.

Thus, we will need to work out alternative dates for everyone. As your client is unavailable this month and you indicated your unavailability next month, we have suggested November. Of course, if Mr. Eliseev or you is, in fact, available during October, we can certainly work on dates in that month. We only mentioned November to accomodate your calendars.

Please confirm that you will honor our agreement and work with us to set a schedule, rather than pick arbitrary dates that simply do not.

Regards,
Erik

Erik C. Kane
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202.220.4294 Phone | 202.220.4201 Fax
ekane@kenyon.com | www.kenyon.com

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From: Pietrini, Jill [mailto:JPietrini@manatt.com]
Sent: Friday, September 07, 2007 3:11 PM
To: Kane, Erik; Eliseev, Andrew
Subject: RE: USCOC v. USHCOC
Importance: High

Erik:

Andrew is not here as you know. I am responding during the short window of time that I have today.

What is your legal authority (case citations) that seven and eight days actual notice and fourteen and fifteen days notice by mail is insufficient for the testimony depositions? We have provided you with a case that supports our position that the notice was more than sufficient, but maybe we are unaware of other authority that speaks otherwise.

You mentioned the Jewish holidays in one of your letters as a basis for the dates not being available. Yet when we stated that we did not believe that you, Ed Colbert or Bill Merone were Jewish and therefore selected Sept. 13th as the date for one of the depositions, you avoided that issue and are stating now that all of you have "other commitments" for September 12th and 13th.

In order to evaluate your position -- we need to know immediately -- if you, Mr. Colbert, or Mr. Merone are Jewish, and therefore are celebrating the Jewish holiday on the 13th --- AND we need your legal authority for the argument that seven and eight days actual notice and fourteen and fifteen days notice by mail is insufficient, particularly, where our DC office whether the depositions will be taken is walking distance from your office.

Please respond as soon as possible.

Jill Pietrini
manatt | phelps | phillips
11355 W. Olympic Blvd.
Los Angeles, CA 90064
(310) 312-4325
jpietrini@manatt.com

From: Kane, Erik [mailto:Ekane@kenyon.com]
Sent: Friday, September 07, 2007 11:05 AM
To: Eliseev, Andrew
Cc: Pietrini, Jill
Subject: USCOC v. USHCOC

Andrew,

Attached please find my letter of today also send by fax and U.S. Mail.

Regards,
Erik

Erik C. Kane
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202.220.4294 Phone | 202.220.4201 Fax
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CERTIFICATE OF SERVICE

I hereby certify that the required number of copies of the foregoing *Petitioner/Opposer's Reply In Support Of Its Motion For Leave To Use Trial Testimony From Opposition No. 91/156,321 In Cancellation No. 92/045,876* and *Petitioner/Opposer's Reply In Support Of Its Motion To Consolidate Opposition No. 91/156,321 With Cancellation No. 92/045,876 For All Purposes* was served on counsel on the date and as indicated below:

By Overnight Federal Express

Jill M. Pietrini
Andrew Eliseev
MANATT PHELPS & PHILLIPS, LLP
11355 W. Olympic Boulevard
Los Angeles, CA 90064-1614

Date: November 7, 2007

/Erik C. Kane/
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Counsel for Petitioner/Opposer,
THE CHAMBER OF COMMERCE OF THE UNITED STATES OF AMERICA