

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

In the matter of Trademark Application Serial No. 76/362,977
Published in the Official Gazette of June 3, 2003 on page TM 441
International Class: 030
Filed: January 24, 2002
Mark: ALPINE CONFECTIONS



09-16-2004
U.S. Patent & TMO/c/TM Mail Rpt Dt. #22

<p>WORLD CONFECTIONS, INC. Opposer,</p> <p>vs.</p> <p>KENCRAFT, INC. Applicant.</p>	<p>Opposition No. 91158237</p> <p>REPLY IN SUPPORT OF RULE 56(F) MOTION FOR ADDITIONAL DISCOVERY</p>
---	---

Applicant, Kencraft, Inc. submits this reply in support of its motion for additional discovery pursuant to 37 CFR §2.127(e)(1), TBMP §528.06, and FRCP 56(f).

I. ADDITIONAL FACTUAL BACKGROUND

1. WCI's opposition cites again to the invoices selectively submitted by Mr. Cohen. The invoices may evidence sales of gummi candy, but they do not do so under a trademark ALPINE CONFECTIONS. Only some of the invoices up to November 30, 2001 indicate that a company using the trade name Alpine Confections was involved for a period of time up through November 2001.

2. WCI maintains that it has offered inspection of documents on August 13, 20 and September 3. This, however, only tells part of the story. WCI, a New York-based company, is thousands of miles from Utah-based Kencraft. Kencraft has repeatedly asked to review documents *and* depose Mr. Cohen. WCI lead Kencraft to believe that

dates for document inspection *and* deposition would be forthcoming in e-mail exchanges. WCI's recent offers of August 13, August 20 or September 3 did not include offers to depose Mr. Cohen, but only to inspect documents. It is not reasonable to require Kencraft to make two (2) trips to New York to seek discovery. Hence, Kencraft's ongoing demand to depose Mr. Cohen during the same trip for document inspection. WCI has refused and now continues to refuse to make Mr. Cohen, the sole factual affiant of WCI, available for deposition, a deposition that would test the factual bases of his self-serving factual assertions.

3. The undersigned acknowledges a typing error in its motion paper at page 4. The undersigned correctly stated in the Declaration, paragraph 17: "Shortly after receiving WCI's June 15, 2004 discovery responses (mailed to counsel), Kencraft sought to further discover information only in the possession of WCI by way of document inspection and by deposing Mr. Cohen. Ex. B, page 3." This statement was incorrectly transferred to the motion paper at page 4.

4. Kencraft's reference to deferred discovery responses were WCI's repeated deferral to Kencraft's follow up on discovery responses; the follow up to discovery responses cited in paragraphs 17-20 of the Zenger Declaration. Kencraft pointed out that between June 25, 2004 and July 26, 2004 Kencraft attempted follow up on discovery, to which WCI repeatedly deferred responding. This is true. Kencraft has not and does not contend that WCI's formal discovery responses were improperly delayed.

5. Kencraft has repeatedly asked in writing to depose Mr. Cohen. On June 25, June 28, July 2, July 6, July 19 and July 26, 2004, Kencraft sent correspondence to WCI expressly seeking dates to depose Mr. Cohen. Kencraft sought agreeable dates to avoid setting a date contrary to the travel demands of Mr. Cohen. The lack of a formal notice of deposition is of no moment. Kencraft had requested the deposition. When asked for available dates for document inspection *and* depositions, WCI responded:

June 25: "Todd: I can't reach Mr. Cohen, however his office advises that he will be in Spain the entire week of July 5-9. I hope to have

a list of other dates for you on Monday [June 28]. You may want to consider an additional extension of discovery and testimony dates to fit all this in. I have no objection.”

July 12: “Dear Todd: I am advised by WCI’s office that Mr. Cohen is returning from Europe tonight and will be in his office tomorrow. I will obtain dates of availability and let you know tomorrow.”

Any attempt of WCI to hide behind formalities is disingenuous.

6. The parties have twice stipulated to extensions of time for discovery, up to and including September 17, 2004, acknowledged by the TTAB July 21, 2004. All this before the July 14, 2004 filing of WCI’s motion for summary judgment which stayed all other events.

II. REBUTTAL ARGUMENT

A. Unhelpful Invoices¹; Lack Of Evidence Of Continued Use.

WCI argues that the selected invoices (Ex. A, exhibit 2) submitted in opposition to the present motion establish senior, continued use. This is erroneous. First, up to November 2001, use of the term ALPINE CONFECTIONS was trade name use, not trademark use. Second, use of the term ALPINE CONFECTIONS ceased in the exhibits provided, and after November 2001, the invoices provide no evidence of use of ALPINE CONFECTIONS.

B. Kencraft May, If Necessary, Amend It Application.

WCI argues that the issues of fact pointed out by Kencraft are of no moment based upon the Kencraft intent-to-use application for “candy.” First, WCI only addresses channels of trade and class of purchasers. It appears that other questions of fact are conceded. Second, Kencraft may seek to amend its application. Absent the discovery withheld by WCI, the ability of Kencraft to distinguish or amend its application is improperly prevented. This exposes the strategic attempt of WCI to avoid discovery and prematurely seek summary judgment.

¹ The product packaging (Ex. 3) by itself is not helpful for the reasons already discussed in Kencraft’s motion paper. Their use would be the proper subject of the deposition of Mr. Cohen or of a 30(b)(6) witness.

C. WCI's Discontinued Efforts And Use Vis-À-Vis Alpine Confections

WCI abandoned its trademark application for ALPINE CONFECTIONS in early 2001. In late 2001, it appears Opposer discontinued use of ALPINE CONFECTIONS as a trade name. In spring 2003, WCI discontinued making product bearing the mark ALPINE CONFECTIONS. This evidences abandonment, not continued use.

D. Material Issues Of Fact Exist And Preclude Summary Judgment

WCI argues that Kenkraft is in a "might find" mode. This ignores the issues of fact shown in the declaration supporting the Rule 56(f) motion. Under the *Keebler* standard, Kenkraft has made the required showing of need as to specific, genuine issues of material fact. For example, the timing and extent of WCI's abandonment of the term ALPINE CONFECTIONS is shown, a material issue of fact which WCI attempts to skirt with the self-serving declaration of Mr. Cohen and by refusing to let Mr. Cohen or another 30(b)(6) witness be deposed on those very facts. Kenkraft has made timely requests to properly and thoroughly discover this issue and the others pointed out in its motion papers. WCI has withheld and continues to withhold material, relevant information directed to genuine issues of material fact.

E. Opportunities For Discovery Are Not Run.

When Kenkraft sought dates for document inspection *and* depositions, WCI, on June 25, 2004 suggested extension of time to the scheduling order for discovery and indicated no objection. All this before the July 15, 2004 expiration of discovery. An appropriate request for further extension for discovery up to September 17, 2004 was sought July 12, 2004. Such an extension may be sought upon stipulation of the parties. 37 C.F.R. § 2.120. WCI so stipulated. Indeed, by order of the TTAB, discovery has been extended to September 17, 2004. WCI's July 14, 2004 filing of its motion for summary judgment has resulted in the stay of all other matters, including discovery. Discovery was open, and is now stayed while the pending motions are decided. Formal discovery opportunities under scheduling orders of the TTAB remain available.

III. CONCLUSION

Accordingly, a Rule 56(f) motion should generally be granted because Kenkraft has shown diligence in pursuing discovery before the summary judgment motion was made. E.g.

Ayala-Gerena v. Bristol Meyers-Squibb Co., 95 F.3d 86, 92 (1st Cir. 1996) (“Rule 56(f) is designed to minister to the vigilant, not to those who slumber upon perceptible rights”). Kencraft should be permitted to inspect documents *and* depose Mr. Cohen and/or another 30(b)(6) witnesses as to issues material to the Notice of Opposition and WCI’s pending motion for summary judgment

DATED this 13th day of September, 2004.

KIRTON & McCONKIE

By: 

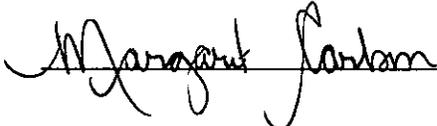
Todd E. Zenger, Reg. No. 33,610
KIRTON & McCONKIE
1800 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111
Phone: (801) 328-3600
Fax: (801) 31-4893

Attorney for Applicant
KENCRAFT, INC.

CERTIFICATE OF SERVICE

I hereby certify that on this 13th day of September, 2004, a true and correct copy of the foregoing **Reply in Support of Rule 56(f) Motion for Additional Discovery** was served on the following counsel, by United States mail, postage prepaid, in an envelope addressed as follows:

John Rannells
BAKER & RANNELLS, PA
626 North Thompson Street
Raritan, New Jersey 08869



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TRANSMITTAL LETTER (GENERAL)
(With Certificate of Mailing by First Class Mail)

Applicant/Registrant: **Kencraft, Inc.**
Serial No.: **76/362,977**
Registration No.:
Trademark: **ALPINE CONFECTIONS**

Docket No.
8598.131

TTAB

TO THE COMMISSIONER FOR TRADEMARKS:

Transmitted herewith is the following:

Reply in Support of Rule 56 Motion for Additional Discovery (5 pgs); and postcard

Opposer: World Confections, Inc.

Opposition No. 91158237

- No fee is required.
- Please charge Deposit Account No. _____ in the amount of _____
- A check in the amount of _____ is attached.
Any excess or insufficiency should be credited or debited to Deposit Account No. _____



09-16-2004

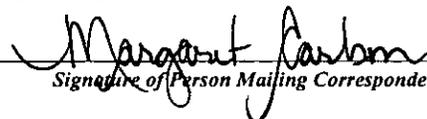
U.S. Patent & TMO for TM Mail Rpt Dt. #22


Signature

Dated: September 13, 2004

Todd E. Zenger,
Attorney for Applicant
Registration No. 33,610
KIRTON & McCONKIE
1800 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111
(801) 328-3600

I certify that this document and fee is being deposited on September 13, 2004 with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514.


Signature of Person Mailing Correspondence

Margaret Carlson

Typed or Printed Name of Person Mailing Correspondence

cc: