

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

LABELTEX MILLS, INC.	)	
	)	
Opposer	)	
	)	
v.	)	
	)	
LABELTEX S.R.L.	)	
	)	
Applicant	)	

76 - 154 474

Opposition No. 91161944

**OPPOSER'S REPLY TO APPLICANT'S RESPONSE IN OPPOSITION TO OPPOSER'S UNCONSENTED MOTION FOR EXTENSION OF TIME**

Opposer, Labeltex Mills, Inc., replies to Applicant's Response in Opposition to Opposer's Unconsented Motion for Extension of Time as follows:

The issue before the Board is not whether a vast majority or only a small majority of the 413 documents submitted by Applicant were in Italian, but rather whether Opposer is to have a reasonable opportunity to carry out meaningful discovery. Despite Applicant's representations concerning those documents, of the 31 invoices provided by Applicant which by their dates could have any relevance in this case, all 31 are entirely in Italian. Exhibit A to Applicant's Response is typical of those invoices. The remaining 382 documents, while albeit many of them contain English entries, are either all in Italian or contain what appears to be significant entries in that language. To the extent they are legible, the three invoices submitted by Applicant as Exhibit B to its Response contain examples of such entries. The Board's attention is drawn to the typed or something referred to as "SCAD," and to the contents of the barely readable stamp in the lower right hand corner of document No. LM 0356. True, Opposer had the questioned documents for



12-09-2005

many months, but they were of little use to Opposer without the requested translation.

Applicant would have the Board believe Opposer has been dilatory in carrying out its discovery. The fact is quite the opposite. Opposer served the first set of discovery requests propounded by either side in these proceedings on 1 November 2004. Although they were due by 6 December 2004, in response to Applicant's counsel's repeated representations that she was having difficulty obtaining the requested materials from Applicant, Opposer allowed Applicant to delay the completion of its document production and provision of the information requested by Opposer until 21 June 2005.

On 28 July 2005, recognizing that the most pertinent of Applicant's documents were unintelligible, the undersigned requested Applicant to provide translations. (See attached facsimile of 28 July 2005.) The request was denied, and for the next month, Opposer's counsel met and conferred with Applicant's counsel by telephone and letter in what proved to be an unsuccessful attempt to obtain translated documents.

In July, the undersigned advised Applicant's counsel Opposer had retained a certified interpreter to translate the documents, that the translator had informed the undersigned that she could not complete the translations without an explanation of the meaning of certain abbreviations that appeared in the documents, and that two critical invoices were illegible and needed to be replaced by Applicant. (See enclosed facsimile of 28 July 2005.) Despite the undersigned's subsequent facsimile requests and voice mail message to Applicant's counsel, neither the translations of the abbreviations nor the requested copies of the two illegible invoices were forthcoming. (See facsimile transmission of 9 August 2005.) As a result of the undersigned's suggestion in his letter of 9 August that the proceedings should be continued to permit the completion of discovery, the parties stipulated to and on 23 August 2005 the Board granted a

90-day extension of the discovery period and all of the trial dates.

On 30 September 2005, still not having received the requested translations, the undersigned once again wrote to Applicant's counsel, this time voicing the hope it would not be necessary to file a motion to compel. (See facsimile of 30 September 2005.) In that letter the undersigned made reference to a recent telephone conversation in which the subject of settlement had arisen.

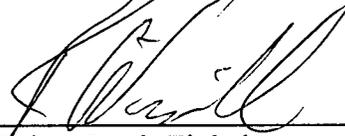
On 25 October 2005, in frustration and desperation the undersigned sought the Board's assistance in obtaining Applicant's cooperation. In a three-way telephone conference that day, Applicant's counsel assured Cheryl Goodman, Board Attorney, that he would use his best efforts to obtain the translations from his client. The following day, 26 October 2005, the undersigned received a facsimile message from Applicant's counsel containing the long-sought translations.

Shortly thereafter, the undersigned wrote to Applicant's counsel requesting an early meeting to discuss setting dates for the stipulated extension they had discussed with Ms. Goodman on 15 October. The letter contained Opposer's tentative outline of a settlement agreement. On 17 November 2005, the undersigned received the attached facsimile message from Applicant's counsel, withdrawing Applicant's agreement to any further extension of the discovery period. The undersigned immediately prepared and filed Opposer's pending motion.

The evidence suggests that Applicant's withdrawal of its previously expressed willingness to stipulate to a continuance and its opposition to Opposer's motion are motivated not by foot-dragging on Opposer's part, but rather by Applicant's pique at Opposer's inadequate settlement offer. Be that as it may, although Applicant's counsel acknowledges Applicant has had sufficient time to complete its discovery, Applicant's conduct has prevented Opposer from carrying on, much less completing, its discovery. It would be a travesty if Opposer were punished and

Applicant rewarded for Applicant's unjustified delay in conducting its discovery. Opposer's motion should be granted.

Respectfully submitted,



---

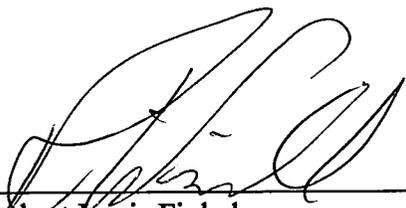
Robert Louis Finkel  
5215-2 White Oak Ave.  
Encino, CA 91316  
P. O. Box 19276  
Encino, CA 91436-9276  
818-705-9861  
Fax 818-705-7811  
[belchfire@sprintmail.com](mailto:belchfire@sprintmail.com)

Attorney for Opposer

### **CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing Opposer's Reply to Applicant's Response in Opposition to Opposer's Unconsented Motion for Extension of Time (re Opposition No. 91161944) is being served on Applicant's counsel on December 7, 2005 by United States mail, first class, with postage prepaid, addressed as follows:

Michael A. Grow, Esq.  
Arent Fox  
1050 Connecticut Avenue NW  
Washington, DC 20036-5339



---

Robert Louis Finkel

### **CERTIFICATE OF FILING BY MAIL**

I hereby certify that the foregoing Opposer's Reply to Applicant's Response in Opposition to Opposer's Unconsented Motion for Extension of Time (re Opposition No. 91161944) is being filed with the Trademark Trial and Appeal Board by first class mail addressed to United States Patent and Trademark Office, Trademark Trial and Appeal Board, P. O. Box 1451, Alexandria, VA 22313-1451, on 7 December 2005.



---

Robert Louis Finkel

**ROBERT LOUIS FINKEL**  
**ATTORNEY AT LAW**  
**PATENTS, TRADEMARKS, COPYRIGHTS & RELATED CAUSES**  
**5215-2 White Oak Avenue, Encino, California 91316**  
**P. O. Box 19276**  
**Encino, California 91416-9276**  
**(818) 705-9861**  
**FAX (818) 705-7811**  
*belchfire@sprintmail.com*

**FACSIMILE TRANSMISSION**

Privileged and Confidential—The information contained in this transmission is intended solely for the use of the addressee named below. If you are not the intended recipient or the employee or agent responsible for delivering the message to the intended recipient, please note that any copying or distribution of this communication is strictly prohibited. Anyone who receives this communication in error should notify us immediately by telephone and return the original to us at the address above by U.S. mail.

DATE: 28 July 2005

TO: Michael A. Grow, Esq.  
Arent Fox  
1050 Connecticut Avenue NW  
Washington, DC 20036-5339

FAX NUMBER: 202-857-6395

RE: Labeltex Mills, Inc. v. Labeltex S.r.l.  
Opposition No. 91161944

Dear Michael:

It is my understanding documents Nos. LM 0358-LM 0413 that accompanied Ms. Giuliani's letter to me of 21 June 2005 complete Applicant's responses to Opposer's First Set of Interrogatories to Applicant (Nos. 1-17) and Opposer's First Request for Production of Documents served upon Applicant on 1 November 2004. If such is not the case and Applicant has still further answers or additional documents to provide, please so inform me at once. Failing to hear from you to the contrary, I shall proceed with Opposer's discovery in reliance on the information you have furnished.

First, however, Applicant's documents, which are in Italian and therefore unintelligible to me, require translation. Your refusal to provide translations necessitates my having them translated. Since all of Applicant's documents contain the notation "Confidential Attorney's Eyes Only," (which I take to be the equivalent of the designation "Restricted – Outside Counsel's Eyes Only" referred to in the Stipulated Protective Order), pursuant to Paragraph 5 of the Protective Order, I notified you in our telephone conversation last week that I have retained a court certified interpreter for that purpose. I informed you that she has executed an acknowledgment of receipt and agreement to be bound by the terms of the Protective Order in the form of Exhibit A to the Protective Order. You indicated, and

again I thank you for, your acquiescence in my disclosing the designated documents to her for the stated purpose. For the record and for your information, the interpreter is

Martitia Palmer  
Eurasia Translations, Inc.  
16530 Ventura Boulevard, Suite 206  
Encino, CA 91436  
888-887-1884

Ms. Palmer informs me that a number of abbreviations in the documents furnished by Applicant do not have standard dictionary meanings and cannot be reliably identified. She has asked me to obtain from you the English translation of the following terms:

CART.  
DDT.  
IMP. AND IMPI.  
EDC.

Additionally, portions of Applicant's Invoices bearing Bates Nos. LM 016 and LM 017 are illegible. If you have legible copies, please fax them to me as soon as possible. If you do not, I would appreciate your getting legible copies for me from your client.

As soon as I receive and am able to review translations of your documents, I anticipate sending you Opposer's objections to Applicant's responses, and requests for more complete answers to Opposer's First Set of Interrogatories and First Requests for Documents. When you provide me the additional information we have requested and to which I believe Opposer is entitled, I anticipate following up on your responses with Opposer's Second Set of Interrogatories, Requests for Documents and Requests for Admissions.

With regard to Applicant's Second Set of Interrogatories and Requests for Production, which we received on 28 June 2005, Opposer was searching for and assembling the information and documents called for when your letter dated 21 July 2005 arrived. While some of your objections to Opposer's answers and documents supplied in response to Applicant's First Set of Interrogatories and First Request for Production of Documents may be well founded, others I think are groundless. Still others require clarification before I can evaluate and respond to them. Suffice, all of them may have a bearing on Opposer's responses to the outstanding Interrogatories and Requests for Documents.

We recognize our mutual obligation to engage in a good faith effort to settle any discovery disputes. Toward this end, I hope to fax you a detailed written reply to your 21 July letter by the middle of next week. Until we resolve the issues you raise, it makes no sense for Opposer to speculate how to respond to Applicant's Second Set of Interrogatories and Requests for Production.

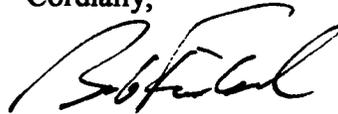
I cannot estimate how long it will take to resolve the issues, but certainly Opposer's Responses to Applicant's Second Set of Interrogatories and Document Requests will require additional time for completion. Likewise, Opposer cannot possibly comply with

your request that it produce the documents referred to in your 21 July letter by 1 August 2005.

In light of the length of time it has taken to get to this point in the proceedings, I propose that we explain the circumstances briefly to the TTAB and stipulate to an order for another 90-day extension. I am sure the Board will agree that our plan to complete discovery by 18 August was unrealistic and that the discovery period needs to be extended. If you would like to discuss the matter first, please don't hesitate to call me. If you agree with me that a 90-day extension is necessary and reasonable, let me know and I'll be pleased to prepare a stipulated order.

In any event, I look forward to being in touch with you again soon, to resolving the discovery issues amicably, and to bringing the Opposition to a conclusion without undue delay.

Cordially,



Robert Louis Finkel

RLF/k

cc: Mr. David Pourshamtobi

Grow. fax.014

Kindly examine the accompanying facsimile following receipt of the last page. If the copy is unclear, or if you had or are having problems with our transmission, please call us as soon as possible at (818) 706-9861.

**ROBERT LOUIS FINKEL  
ATTORNEY AT LAW**

**PATENTS, TRADEMARKS, COPYRIGHTS & RELATED CAUSES  
5215-2 White Oak Avenue, Encino, California 91316**

**P. O. Box 19276**

**Encino, California 91416-9276**

**(818) 705-9861**

**FAX (818) 705-7811**

***belchfire@sprintmail.com***

**FACSIMILE TRANSMISSION**

**Privileged and Confidential--The information contained in this transmission is intended solely for the use of the addressee named below. If you are not the intended recipient or the employee or agent responsible for delivering the message to the intended recipient, please note that any copying or distribution of this communication is strictly prohibited. Anyone who receives this communication in error should notify us immediately by telephone and return the original to us at the address above by U.S. mail.**

**DATE: 9 August 2005**

**TO: Michael A. Grow, Esq.  
Arent Fox  
1050 Connecticut Avenue NW  
Washington, DC 20036-5339**

**FAX NUMBER: 202-857-6395**

**RE: Labeltex Mills, Inc. v. Labeltex S.r.l.  
Opposition No. 91161944**

**Dear Michael:**

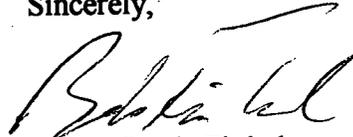
**This is a follow-on to my letter to you dated 28 July 2005 and my voicemail message to you this morning.**

**Labeltex Mills' response to your client's second set of interrogatories and request for production, reply to your letter to me of 21 June 2005, request for further responses from your client to its first set of interrogatories and document requests, and second set of interrogatories and document requests to Labeltex Srl all await your providing me the English translation of CART., DDT., IMP., IMPI., and EDC. Labeltex Mills is anxious to proceed with all of these matters, but we need to learn the meaning of the aforementioned terms. Please let me know when you think you'll be able to get them to me.**

**In any event, it will be necessary to extend the discovery period and trial dates. As I mentioned in my letter of 28 July, a 90-day extension seems reasonable. If you concur, tell**

me whether you want to prepare the stipulated order or would prefer that I do so. If you disagree, please advise me at once.

Sincerely,



Robert Louis Finkel

RLF/k

cc: Mr. David Pourshamtobi

Grow. fax.015

Kindly examine the accompanying facsimile following receipt of the last page. If the copy is unclear, or if you had or are having problems with our transmission, please call us as soon as possible at (818) 705-9861.

**ROBERT LOUIS FINKEL  
ATTORNEY AT LAW**

**PATENTS, TRADEMARKS, COPYRIGHTS & RELATED CAUSES  
5215-2 White Oak Avenue, Encino, California 91316**

**P. O. Box 19276**

**Encino, California 91416-9276**

**(818) 705-9861**

**FAX (818) 705-7811**

***belchfire@sprintmail.com***

**FACSIMILE TRANSMISSION**

**(Confirmation copy by mail)**

**Privileged and Confidential--The information contained in this transmission is intended solely for the use of the addressee named below. If you are not the intended recipient or the employee or agent responsible for delivering the message to the intended recipient, please note that any copying or distribution of this communication is strictly prohibited. Anyone who receives this communication in error should notify us immediately by telephone and return the original to us at the address above by U.S. mail.**

**DATE: 30 September 2005**

**TO: Michael A. Grow, Esq.  
Arent Fox  
1050 Connecticut Avenue NW  
Washington, DC 20036-5339**

**FAX NUMBER: 202-857-6395**

**SUBJECT: Labeltex Mills, Inc. v. Labeltx S.r.l.  
Opposition No. 91161944**

**Dear Michael:**

Further to my letter to you dated 9 August 2005 and our telephone conversation of 15 August, Chiara Giuliani and you have both assured me that although you will not provide English translations of your answers to Labeltex Mills' first set of interrogatories and document requests, you "will clarify any words which may be unintelligible, and any code, abbreviation, acronym or other symbol used by [your] client to identify its products."

In that regard, I have requested the English translation and an explanation of the abbreviations CART., DDT., IMP., IMPI., and EDC, all of which appear repeatedly in your client's answers and documents. Despite my several written and telephonic reminders, I still have not received the translations and explanations. As you know, the time for filing objections has long since expired.

Because the translations and explanations are crucial to our further discovery and preparation of the case, and due to the fact that the TTAB rules are quite strict with

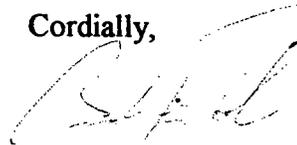
respect to discovery time limits, unless I am provided with full and complete translations and explanations, I may be required to file a motion to compel your response. This, in turn, will entail a needless waste of time and expenditure of costs and attorney fees. If my request poses some special problem, I invite you to contact me to confer on means for resolving it as soon as possible.

As a separate matter, when we last spoke, I told you I believed the treatment of information concerning matters that occurred in 1990 as subject to the strictest confidence ("Attorneys' Eyes Only") under the Protective Order is unnecessary and unduly burdensome. I asked you to consider stipulating to the exclusion of information predating, say, the year 2000 entirely from the Protective Order. Again, I am still waiting for your reply. If you have some reason for extending confidentiality to matters that occurred more than five or six years ago, share your thoughts with me and let's see if we can't work out a mutually agreeable accommodation. If, as I suspect, there is no reason for maintaining confidentiality as to pre-2000 matters, let's stipulate to an exclusion so that both of us can go forward with our discovery.

Finally, at the conclusion of our last conversation, you broached the subject of settlement. I told you I was sure my client would be interested in considering the possibility, but I was not sure of what you had in mind. Why don't we plan to discuss the matter by phone within the next week or two. For all we know, an amicable solution may be closer to hand than either of us imagines.

Since I think you are bearing the laboring oar, I look forward to hearing from you soon.

Cordially,



Robert Louis Finkel

RLF/k

cc: Mr. David Pourshamtobi

Grow.fax.016

Kindly examine the accompanying facsimile following receipt of the last page. If the copy is unclear, or if you had or are having problems with our transmission, please call us as soon as possible at (818) 705-9861.

*Discovery Conference*

# Facsimile

**Arent Fox**  
ATTORNEYS AT LAW

**Date:** November 17, 2005  
**Pages (including cover):** 1  
**Attorney #:** 1177  
**Client.Matter #:** 023586-013

**Michael A. Grow**  
202.857.6389 DIRECT  
202.857.6395 FAX  
grow.michael@arentfox.com

**PLEASE DELIVER TO:**

<b>Name/Company</b>	<b>Fax #</b>	<b>Verify #</b>
Robert Louis Finkel, Esq.	818-705-7811	818-705-9861

**MESSAGE/INSTRUCTIONS**

---

Dear Bob:

I reviewed your fax settlement proposal. Unfortunately, this differs dramatically from the proposal we discussed. You initially proposed having our client abandon its application in return for which your client would not object to our client's use of Labeltex in connection with the sale of products in the United States so long as our client did not open an office here.

In view of your client's change of position, our client is unwilling to agree to any further extension of the discovery period.

PLEASE CALL OUR FAX OPERATOR AS SOON AS POSSIBLE IF TRANSMISSION IS NOT COMPLETE: 202.857.6119

This facsimile contains privileged and confidential information intended only for the use of the addressee(s) named above. If you are not the intended recipient of this facsimile, or the employee or agent responsible for delivering it to the intended recipient, you are hereby notified that any dissemination or copying of this facsimile is strictly prohibited. If you have received this facsimile in error, please immediately notify us by telephone and return the original facsimile to us at the address below via the postal service. Thank you.