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

Proceeding	91162780
Party	Defendant Cangiarella, Keith Cangiarella, Keith 331 N. Harrington Drive Fullerton, CA 92831
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Application		Opposition No. 91162780
Serial No.: 78/229,875		
Mark: MESSAGE IN A BOTTLE		
GOLD SHELLS, INC.,		
a California corporation,		
Opposer,		
v.		
KEITH CANGIARELLA,		
Applicant.		

In the Matter of Trademark		
Registration No.: 2,243,269		
Mark: MESSAGE IN A BOTTLE		
KEITH CANGIARELLA,		
Petitioner,		
v.		
ROGER ROJAS,		
Registrant		

APPLICANT’S RESPONSE TO OPPOSER’S MOTION TO COMPEL
RESPONSE TO OPPOSER’S FIRST REQUESTS FOR PRODUCTION OF
DOCUMENTS NUMBERED 19 & 22.

Comes now, Applicant, Keith Cangiarella, through counsel, in opposition to Opposer Gold Shells Inc.’s Motion to compel responses to Opposer’s Request Numbers 19 and 22 of Opposer’s first request to Applicant for production of documents and things.

As a preliminary matter, Applicant notes that prior to the filing and service of its motion to compel, Opposer simply failed to make any good faith effort by conference or correspondence, to meet and confer to attempt to resolve the issues presented, as required by 37 C.F.R. § 2.120(e). Therefore, as described below, such failure to even attempt to

meet and confer and to otherwise clarify, explain or limit the disputed requests is adequate grounds for denial of Opposer's motion.

Moreover, Applicant has raised one or more good faith objections to the two Requests for Production, namely request numbers 19 and 22 in that such requests (1) seek material constituting attorney-client communications; (2) seek materials that constitute attorney work product; (3) that such requests are vague, ambiguous, and uncertain; (4) that such requests are not properly limited in terms of time or scope. As such, Opposer's Motion should be denied.

Finally, it should be noted that although the Applicant's responses to Opposer's First Request for Documents was served on Opposer's counsel back on August 12, 2005, and although the period for discovery to close elapsed on September 30, 2005; Opposer's counsel delayed in filing the instant motion until December 06, 2005, notably, after the first testimony period has opened. As such, and as described below, Opposer has failed to file the motion to compel within a reasonable time including within the time provided for in 37 C.F.R. §2120(3) (1). Therefore, the motion should be denied as untimely.

Applicant's Memorandum in Support of its Response to Opposer's Motion to
Compel Discovery

FACTUAL BACKGROUND

On June 29, 2005, Opposer served Applicant's counsel, by mail, with its First Request for Production of Documents and Things. Such requests included REQUEST NO. 19, which sought "*All trademark search and evaluation documents which make reference to the Trademark.*"

On August 12, 2005, Applicant served on Opposer his responses to Opposer's First Request for Production of Documents which included his response to Request No. 19, which stated:

RESPONSE: The request is vague, ambiguous and uncertain. The request is insufficient, compound and fails to separately set forth each requested item and category with reasonable particularity, and therefore fails to comply with FRCP 34 (b). The request is unduly burdensome, and overbroad. In addition, many of the specifications in the request would require the production of attorney work product prepared in anticipation of litigation and/or material covered by the attorney-client privilege and/or other commercially and competitively sensitive information which should not be produced without the showing of undue hardship, need and inability as well as subject to the protection of a court order restricting access.

In addition, Opposer's First Set of Document Requests included REQUEST NO. 22, which sought: *"All documents referring to use or registration of the Trademark by Opposer and Roger Rojas."*

To such request, Applicant responded:

RESPONSE: Objection. This request is unduly burdensome and overbroad. In addition, many of the specifications in the request would require the production of attorney work product prepared in anticipation of litigation and/or refer to or reflect the contents of communications between attorney and client herein, which shall not be produced herein, without the showing of undue hardship, need and inability as well as subject to the protection of a court order restricting access.

On November 30, 2005, Applicant's counsel received from Opposer's counsel Opposer's motion to Compel Production of Documents from Applicant which was attached to Opposer's counsel Peter Smith's "meet and confer" letter dated November 28, 2005 concerning same. Curiously, this was the Opposer's first and only attempt to meet and confer as required by 37 C.F.R. §2.120 (e), and was served not before the filing of this motion, but concurrently therewith. Further, Opposer had never even made a telephone call concerning same to the undersigned counsel, nor did Opposer ever make any good faith effort to meet and confer concerning these requests, nor did they ever attempt to communicate with Applicant's counsel in order to clarify or limit same.

Argument

I. Opposer Failed to Meet and Confer prior to the filing of this Motion to Compel and therefore this motion should be denied.

According to 37 CFR § 2.120(e) (1), "the motion (to compel) must be supported by a written statement from the moving party that such party or the attorney therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion and has been unable to reach agreement."

More simply, prior to bring a motion to compel, a moving party, must first make a good faith effort to meet and confer in order to resolve the discovery dispute. F.R.C.P. Rule 37.2(a) requires that *before* a Motion to Compel is served, that the movant declare it has in good faith "conferred or attempted to confer with the party not making the disclosure in an effort to secure the disclosure *without court action*."

In his moving papers, Opposer's counsel has conceded that "on November 28, 2005 (the same date in which the motion to compel was served on Applicant) in an

attempt to informally resolve this dispute prior to filing, Opposer's counsel sent a letter to Applicant's counsel asking him to "meet and confer" in regard to his failure to document request numbers 19 and 22. A copy of this letter is attached hereto as Exhibit C. Because of the deadline for filing this motion to compel, and the need to mail the motion by November 28, 2005, Applicant's counsel has not yet had an opportunity to respond."

Notably, Opposer's attorney did not send the "meet and confer" letter attached to Opposer's motion Exhibit "C" by facsimile or e-mail, nor did Opposer's counsel, in good faith, even pick up the telephone to discuss the matters addressed in the motion prior to the filing and service thereof.

Any deadline which may have required Opposer to immediately file a motion to compel, was strictly the result of Opposer's counsel's own delay, inasmuch as he had the Applicant's responses for well over 105 days before such deadline became an issue.

More importantly, the public policy issues strongly favor the Applicant herein.

That is to say, that had Opposer complied with the Rules and attempted to meet and confer in good faith, he might have had an opportunity to reasonably explain and/or clarify his newly stated position contained in the motion to the effect that with respect to Request No. 19, that the his client's vague and ambiguous request for "[a]ll trademark search and evaluation documents which make reference to the trademark" "are intended to refer to those documents relating to any search conducted by or on behalf of Applicant as to the availability of MESSAGE IN A BOTTLE as a trademark or service mark, including any evaluation of the search." (Such clarification as contained in the Opposer's motion at page 5, is much clearer than was the original request.)

Further, had Opposer's counsel met and conferred prior to the bringing of this motion, the parties might also have had the opportunity to limit such request to exclude the non-discoverable material which was objected to, particularly including any attorney-client communications or comments and/or opinions of counsel with respect to any such evaluations of the search.

Finally, had Opposer's counsel followed the Rules and met and conferred, the Board and Applicant would likely not have been burdened with Opposer's meritless motion herein.

For such reasons, Opposer's failure to meet and confer prior to the filing of such a motion is more than adequate grounds for denial of this motion. (See: 37 C.F.R. §2120(e); and *for example*, *Giant Food v. Standard Terry Mills, Inc.* 231 U.S.P.Q. 626 (TTAB 1986); *Sentrol, Inc. v. Sentex Systems, Inc.* 231 U.S.P.Q. 666, 667, (TTAB 1986) *Medtronic, Inc. v. Pacesetter Systems, Inc.* 222 U.S.P.Q. 80, 83 (TTAB 1984) *Envirotech Corp. v. Compagnie Des Lampes*, 219 U.S.P.Q. 448, 450 (TTAB 1979) *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 U.S.P.Q. 952, 954 (TTAB 1979).

Therefore, due to the Opposer's failure to even attempt to meet and confer in good faith, the Opposer's motion to compel should be denied.

II. Opposer's Motion to Compel is Untimely and must be denied on such basis.

Pursuant to 37 C.F.R. § 2.120(e) 37 CFR § 2.120(e)(1) "... The motion must be filed prior to the commencement of the first testimony period as originally set or as reset."

In this case, the Applicant's responses to Opposer's First Request For Production of Documents were served on Opposer on August 12, 2005. Further, according the

TTAB's Order resetting trial dates dated July 12, 2005, the Period for Discovery to Close was set on September 30, 2005 and the testimony period for plaintiff in the opposition is to close on December 29, 2005. As such, the Opposer's instant motion to compel which was served by mail on November 28, 2005, and filed with the TTAB on December 06, 2005 is untimely and therefore must be denied.

According to the Trademark Trial And Appeal Board Manual of Procedure (TBMP) section 523.03, "the motion (to compel) should be filed within a reasonable time after the failure to respond to a request for discovery or after service of the response believed to be inadequate and must, in any event, be filed before the first testimony period opens. (See 37 CFR § 2.120(e); and, *for example, Societa Per Azioni Chianti Ruffino Esportazione Vinicola Toscana v. Colli Spolentini Spoletoducale SCRL*, 59 USPQ2d 1383, 1383 (TTAB 2001)).

As is conceded by Opposer in its moving papers, (page 7), the discovery period closed on September 30, 2005. Opposer's counsel apparently filed this motion on December 06, 2005. Thus, this motion was made more than 60 days after the discovery period elapsed and well over 105 days after the Applicant's responses were served on Opposer. . There has not been any evidence of an extension of time of the discovery period by the Board, nor has Opposer's counsel submitted a request to do so. Because of the unreasonable delay in filing the motion until after the discovery period had already elapsed, and after the testimony period had opened, Opposer's motion to compel further responses to document requests No. 19 and 22 must be denied as untimely filed.

III. Opposer's Requests Numbered 19 and 22 were Vague, Ambiguous and Uncertain.

In response to the Opposer's Requests, Applicant raised valid and good faith objections thereto, including, inter alia that Request No. 19, which sought "*All trademark search and evaluation documents which make reference to the Trademark*" was "vague, ambiguous, and uncertain" and further that such request was "insufficient, compound and fails to separately set forth each requested item and category with reasonable particularity."

Under F.R.C.P. Rule 34 (b), as related to requests for production of documents and things, " the request shall set forth, either by individual item or by category, the items to be inspected and describe each *with reasonable particularity.*"

Notwithstanding, Opposer's request No. 19, for all trademark search and evaluation documents which make reference to the Trademark" was simply too vague and ambiguous for Applicant to frame any reasonable response thereto. Contrary to Opposer's counsel's position, "trademark search and evaluation documents" is not a term of art used in the industry, and its meaning is subject to interpretation. Moreover, Opposer's allegedly inserted definition of "the Trademark" as contained in its definitions and instructions section as "the mark MESSAGE IN A BOTTLE regardless of (a) the style of lettering in which the mark appears, (b) the spacing or capitalization of the letters, and (c) whether or not the mark is used in connection with any design" violated Rule 34's requirement that the request be separately set forth and described with reasonable particularity.

Had Opposer actually and timely refined such request as he has attempted to do so in the motion, Applicant would likely have agreed to respond thereto. However, based

strictly on the text of the vague, ambiguous and compound request, no response could have been made.

With respect to Opposer's Request No. 22, which sought "*All documents referring to use or registration of the Trademark by Opposer and Roger Rojas,*" such request was not only vague, ambiguous and compound, but also was overbroad and unduly burdensome for Applicant to respond to such unparticularized request.

Indeed, any and all documents that refer to use of registration of the Trademark as defined in Opposer's definitions and instructions section as "the mark MESSAGE IN A BOTTLE regardless of (a) the style of lettering in which the mark appears, (b) the spacing or capitalization of the letters, and (c) whether or not the mark is used in connection with any design" violated Rule 34's requirement that the request be separately set forth and described with reasonable particularity. Moreover, such a request was not properly limited in time or scope and is not designed to seek relevant and discoverable information herein. In essence, such request is nothing more than a fishing expedition which ostensibly requires Applicant to respond with any material that contains the words "MESSAGE IN A BOTTLE", or any material that contains the names Gold Shells, Inc. and/or Roger Rojas.

Such requests were not properly drafted or limited and therefore, the motion should be denied.

Moreover, as stated below, well within any such responsive information or documents would exist undiscoverable, privileged and protected Attorney-Client communications and Attorney Work product. Because the rules of discovery prohibit such expeditions, this motion should be dismissed.

IV. Opposer's Requests Numbered 19 and 22 Sought Material Protected by the Attorney Client Privilege and Attorney Work-Product Doctrine And As Such is not Discoverable.

In this case, Opposer's counsel has asked for in Document Request # 19 "All trademark search and evaluation documents which make reference to the Trademark."

Clearly, as was objected to in Applicant's responses to the two requests at issue herein, a request for "all trademark search and evaluation documents which make reference to the Trademark" would necessarily encompass the communications between the Applicant and his counsel, and would further constitute protected attorney work product. (See *Fisons Ltd. v. Capability Brown, Ltd.*, 209 U.S.P.Q. 167, 170 (TTAB 1980); *Miles Laboratories, Inc. v. Instrumentation Laboratory, Inc.*, 185 U.S.P.Q. 432, 434 (TTAB 1975); and *Amerace Corp. v. USM Corp.*, 183, U.S.P.Q. 506, 50-7 (TTAB 1974) (attorney comments on search report or prosecution of application are privileged.)

Opposer also requested under number 22 "[a]ll documents referring or relating to use or registration of the Trademark by Opposer and Roger Rojas." Applicant properly objected to these requests as Attorney-Work Product under Rule 26(B)(3).

Under Hickman v. Taylor, 329 U.S. 495, 511 (1947)," [p]roper preparation of a client's case demands that he assemble information, sift what he considers to be the relevant from the irrelevant facts, prepare his legal theories and plan his strategy without undue and needless interference... aptly though roughly termed by the Circuit Court of Appeals in this case as the "work product of the lawyer." Applicant's objected to the question because it would violate the work-product doctrine under F.R.C.P. 26 and Hickman.). These documents were gathered by Applicant's counsel in anticipation of litigation and contain the attorney's strategies and thoughts regarding Opposer's use of the

mark. In addition, Opposer's counsel has the very same information and can easily obtain it through its client. The purpose of such a question is not to advance Opposer's knowledge of the surrounding facts, but to find out what Applicant and its counsel presently know about Opposer. As such Opposer's request was improper and properly objected to under Rule 26.

Opposer's counsel's belated attempt to limit his requests to "exempt" from the requests "any attorney work product or attorney-client privileged communications" (as stated at page 6 of his moving papers.

CONCLUSION

Based on the foregoing, Opposer's untimely motion to compel further responses to Opposer's vague and compound requests, which was made without benefit of any good faith effort to meet and confer thereon should be denied.

Respectfully submitted,

ANDERSON & ASSOCIATES

Dated: December 12, 2005

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Certificate of Service

I hereby certify that a copy of the foregoing APPLICANT'S RESPONSE TO OPPOSER'S MOTION TO COMPEL RESPONSE TO OPPOSER'S FIRST REQUESTS FOR PRODUCTION OF DOCUMENTS NUMBERED 19 & 22. was mailed on the date set forth below, via First Class mail, postage prepaid as addressed to Peter H. Smith, Attorney at law, 1535 J Street, Suite A, Post Office Box 1867, Modesto, California, 95353, attorney for Opposer,

December 12, 2005

/StevenJohnson/ _____
Steven Johnson