

ESTTA Tracking number: **ESTTA65329**

Filing date: **02/07/2006**

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

Proceeding	91164764
Party	Plaintiff Brink's Network, Incorporated Brink's Network, Incorporated 203 Bancroft Building3411 Silverside Road Wilmington, DE 19810 UNITED STATES
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Attachments	Opposer's Notice of Discovery Issues Resolved.pdf (5 pages)

1. On December 23, 2005, Applicant provided Opposer proposed revisions to Opposer's draft Protective order;
2. On December 28, 2005, Applicant produced non-confidential and redacted documents (labeled BM 000001 – BM 001706), which appear to be responsive to Request No. 4 in Opposer's First Request for Production regarding representative examples of materials used by Applicant in the advertising and/or promotion of the home security systems and components therefor, namely, motion sensitive home security lights, detectors, receivers, transmitters, adapters and wall mount brackets described in the Opposed Application; and
3. On December 28, 2005, Applicant informed Opposer that its Rule 30(b)(6) witness is generally available for deposition in January 2006.

Opposer and Applicant are currently negotiating the terms of a Protective Order acceptable to both parties. Although Applicant indicated that it will generally make its Rule 30(b)(6) witness available for deposition, Opposer will not be in a position to take such deposition until the Protective Order is in place, and Applicant has responded to all of Opposer's requests for production, including production of confidential documents covered by the protective order. Accordingly, there no longer is any need for the Board to rule on Opposer's motion to compel Applicant to supplement its response to Request No. 4 or to provide comments to Opposer's proposed protective order.

Applicant should, however, be denied the opportunity to object to the merits of Opposer's discovery requests because Applicant *initiated* efforts to satisfy its discovery obligations only after Opposer filed its motion to compel discovery. "A party which fails

to respond to a request for discovery (except for a request for admission) during the time allowed therefor, and which is unable to show that its failure was the result of excusable neglect, may be found, upon motion to compel filed by the propounding party, to have forfeited its right to object to the discovery request on its merits.” TBMP § 527.01(c); see also *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000) (the Board has great discretion in determining whether such forfeiture should be found); TBMP § 527.03 (“[f]ollowing from the Board's inherent authority to manage the cases on its docket is the inherent authority to enter sanctions against a party”).

In its opposition papers, Applicant did not even attempt to make any showing of excusable neglect for failing to satisfy its discovery obligations in a timely manner. In addition, Applicant remains dilatory in several of its discovery responses, thus impeding the progress of discovery in this proceeding. If Applicant timely responded to Opposer's discovery requests, there would have been no need for Opposer to move the Board to compel discovery. Accordingly, Applicant should not be permitted to object to the merits of Opposer's discovery requests except to the extent that any such request is subject to an attorney-client or work product objection.

For the reasons stated above, Opposer modifies its request for relief pursuant to the Motion to Compel Discovery as follows:

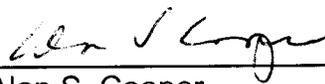
- (1) Applicant shall be required to produce all of the non-privileged documents responsive to Request Nos. 1-3, and 5-15 in Opposer's First Request for Production within two (2) weeks following the Board's Order granting this motion;

- (2) Applicant shall be required to provide notice of at least two proposed dates for the deposition of Applicant's Rule 30(b)(6) witness within two weeks following the Board's Order granting this motion. The two proposed dates shall be within a four-week period following said notification. The date selected for the deposition of Applicant's Rule 30(b)(6) witness must be mutually agreeable to Opposer and Applicant;
- (3) Applicant shall be directed to endeavor in good faith to complete negotiations with respect to Opposer's proposed Protective Order within two weeks following the Board's Order granting this motion; and
- (4) Applicant shall be precluded from objecting to the merits of Opposer's discovery requests except on the grounds of attorney-client or attorney work product privilege.

The current discovery period ended on December 21, 2005. Accordingly, Opposer reiterates its request that the Board stay proceedings pending disposition of this motion and reset the discovery and testimony periods.

BRINK'S NETWORK, INCORPORATED

Dated: February 7, 2006

By: 
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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing OPPOSER'S NOTICE OF ISSUES RESOLVED AND NO LONGER REQUIRING ADJUDICATION IN OPPOSER'S MOTION TO COMPEL DISCOVERY was served on the following counsel of record for Applicant by Federal Express, with confirming service by depositing the same in the U.S. Mail, first class mail postage prepaid, this 7th day of February, 2006:

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