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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 Brink's Network, Incorporated 203 Bancroft Building3411 Silverside Road Wilmington, DE 19810 UNITED STATES
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

BRINK'S NETWORK, INCORPORATED)	
)	
Opposer)	
v.)	
THE BRINKMANN CORPORATION)	Opposition No. 91164764
)	
Applicant)	
)	
)	

OPPOSER'S MEMORANDUM IN RESPONSE TO
APPLICANT'S MOTION TO COMPEL DISCOVERY

I. INTRODUCTION

This matter is before the Board on the motion of Applicant, The Brinkmann Corporation, to compel Opposer, Brink's Network Incorporated, to respond to Applicant's Amended First Set of Interrogatories. Applicant also requests the Board to stay proceedings in this opposition pending disposition of its motion to compel and to reset discovery and testimony periods.

As discussed below, Opposer should not be required to respond to Applicant's Amended First Set of Interrogatories because: (1) Applicant failed to follow Board procedure in serving the Amended First Set of Interrogatories that are intended to replace its excessive First Set of Interrogatories; and (2) Applicant is attempting to profit from its own abuse of the discovery process by serving amended interrogatories at this late stage, having failed to timely respond to Opposer's Objection to Applicant's First Set of Interrogatories.

Accordingly, Opposer requests that the Board deny both Applicant's motion to compel and request to stay proceedings.

II. FACTUAL BACKGROUND

On January 17, 2003, Applicant filed Application Serial No. 76/483,115 (the "Opposed Application") seeking to register the mark BRINKMANN for, among other goods, a variety of products in Class 9 as follows: "home security systems and components therefor, namely, motion sensitive home security lights, detectors, receivers, transmitters, adapters and wall mount brackets, batteries, wall mount brackets for battery chargers and flashlight, cooking thermometers." Opposer filed a timely Notice of Opposition to the Opposed Application on April 1, 2005, directed to registration of the mark BRINKMANN for the aforesaid home security systems and components in Class 9.

After filing its Answer to the Notice of Opposition on May 16, 2005, Applicant filed what purported to be an Amendment to the Opposed Application, seeking to revise the description of goods in Class 9 at issue in the subject opposition.¹ Applicant characterized its amendment as one which corrected "minor typographical errors" and "clarifie[d]" the original description.

In its Response to Applicant's Amendment, Opposer pointed out that Applicant's unilateral attempt to amend the application ignored Rule 2.133 of the Trademark Rules of Practice and that the proposed "correction" altered the substance and meaning of the description of goods in Class 9 at issue in the

¹ Applicant's Amendment also purported to change the description of goods in several Classes listed in the Opposed Application, in addition to in Class 9, which are not the subject of this opposition.

subject opposition. Nonetheless, Opposer did not object to the substance of the proposed amendment and requested that the Board deem its Notice of Opposition amended to include the description consistent with the Amendment filed by Applicant. In its Order dated June 28, 2005, the Board found that Applicant failed to follow proper procedure, but because Opposer did not object to the substance of the proposed Amendment, the Board entered the Amendment and deemed Opposer's Notice of Opposition amended to be consistent with the Amendment filed by Applicant.

During the discovery period, Applicant served its First Set of Interrogatories on September 22, 2005. On October 24, 2005, Opposer interposed its General Objection on the ground that Applicant's First Set of Interrogatories exceeded the 75 limit prescribed by Rule 2.120(d)(1) of the Trademark Rules of Practice. Applicant did not take any action to address or resolve that Objection; specifically, Applicant did not file a motion to compel Opposer to answer the interrogatories in question nor did Applicant seek Opposer's consent to the service of a revised set of interrogatories. Rather, Applicant simply ignored this situation and allowed the discovery period to close on December 21, 2005, without taking any action directed to Opposer's objection to Applicant's First Set of Interrogatories.

Consistent with its failure to take any action in response to Opposer's general objection, Applicant also failed to respond to Opposer's First Request for Production and to designate a witness in response to Opposer's Rule 30(b)(6)

Notice of Taking Deposition of Applicant.² As a consequence of Applicant's failure to cooperate in discovery despite Opposer's repeated requests, Opposer was forced to file a motion to compel seeking an Order from the Board requiring Applicant to produce documents and designate a Rule 30(b)(6) deposition witness. On December 12, 2006, the Board granted Opposer's motion, requiring Applicant to produce responsive documents by January 1, 2007 and, within two weeks of producing such documents, to provide Opposer with two proposed dates for the deposition of Applicant's Rule 30(b)(6) witness. The Board also reset the discovery period to close on February 15, 2007, to enable the parties to carry out actions required by the Order.

On December 13, 2006, Applicant served its Amended First Set of Interrogatories. Opposer interposed its General Objection on January 11, 2007, setting forth the following reasons as to why it was not required to respond to the Amended First Set of Interrogatories: (1) the total number of interrogatories in Applicant's First Set of Interrogatories and Applicant's Amended First Set of Interrogatories, counting subparts, exceeds seventy-five (75) in violation of Rule 2.120(d)(1); and (2) the Board did not reset the discovery period for the purpose of permitting Applicant to serve additional discovery at this late date and thereby profit from its own abuse of the discovery process.

On January 18, 2007, Opposer's counsel and Applicant's counsel conferred by telephone to discuss Opposer's objection to Applicant's Amended

² Opposer's First Request for Production of Documents and Things and Opposer's Notice of Taking Discovery Deposition were served on September 6 and 19, 2005, respectively.

First Set of Interrogatories. During that conversation, Applicant's counsel could not point to a single rule or case to demonstrate that Applicant had followed proper procedure in serving its Amended First Set of Interrogatories following Opposer's objection to the Applicant's First Set of Interrogatories. In the absence of any substantive or procedural law to the contrary, Opposer's counsel advised Applicant's counsel that Opposer would stand by its General Objection to the Amended First Set of Interrogatories.

III. ARGUMENT

Rule 2.120(d)(1) of the Trademark Rules of Practice provides, in pertinent part, that "the total number of written interrogatories which a party may serve upon another party pursuant to Rule 33 of the Federal Rules of Civil Procedure, in a proceeding, shall not exceed seventy-five, counting subparts." Equally important, the numerical limit prescribed by Rule 2.120(d)(1) "pertains to the total number of interrogatories that one party may serve on another party over the course of an entire proceeding, not just per set of interrogatories." TBMP § 405.03(b).³ Although TBMP § 405.03(a) provides that the Board "may allow additional interrogatories on motion therefor showing good cause, or on stipulation of the parties," such motion "must be filed and granted *prior* to service of the proposed additional interrogatories." TBMP § 519 (emphasis added).

Applicant served its First Set of Interrogatories on September 22, 2005. As noted above, on October 24, 2005, Opposer interposed its General Objection

³ If a party serves over the entire course of the proceeding two or more separate sets of interrogatories directed to the same party, the interrogatories in the separate sets would be added together for the purpose of determining whether the numerical limit specified in the rule has been exceeded. TBMP § 405.03(b).

on the ground that the interrogatories were exceeded the limit prescribed by Rule 2.120(d)(1). At that point, Applicant had the option of testing Opposer's objection by either moving to compel responses to its First Set of Interrogatories, or seeking Opposer's consent to the service of a revised set of interrogatories. See TBMP § 405.03(e). Applicant, however, neither moved to compel discovery nor sought Opposer's consent to service of revised interrogatories.⁴ Rather, consistent with its failure to respond to Opposer's discovery requests, Applicant did nothing and allowed the discovery period to close eight weeks later on December 21, 2005.

As the total number of interrogatories, counting subparts, set forth in Applicant's First Set of Interrogatories and Applicant's Amended First Set of Interrogatories far exceeds the maximum number of seventy-five, Opposer served its General Objection based on Rule 2.120(d)(1) on January 11, 2007. By virtue of Applicant's failure to take appropriate steps (or any steps within the past year) to dispute or correct the excessive nature of its interrogatories, it has waived any right to do so now.

This is not the first time that Applicant has failed to follow proper procedure and mischaracterized its conduct in an attempt to contravene the relevant rules applicable to contested proceedings before the Board.⁵ In this

⁴ Obviously, Applicant never filed a motion for leave to serve additional interrogatories pursuant to TBMP § 519.

⁵ As noted above in Section II, Applicant ignored Rule 2.133, unilaterally sought to amend the description of goods in its application after the opposition proceeding commenced and misconstrued its amendment as a "correction" of "minor typographical errors" when, in fact, the proposed amendment altered the substance of the description.

instance Applicant again has ignored the explicit procedures set forth in Rule 2.120(d)(1) and TBMP §§ 405.03 and 519 for dealing with this situation.

Moreover, Applicant's motion mischaracterizes its service of the Amended First Set of Interrogatories as a "formal invitation" to discuss the interrogatories. Formal invitations are not part of opposition proceedings before the Board; compliance with the relevant rules is what is required in this instance. Those rules clearly state that Applicant should have sought Opposer's consent or filed a motion *prior* to serving the amended interrogatories. See TBMP §§ 405.03 and 519. It failed to do so.

Applicant's act of serving amended interrogatories at this late date also is an improper attempt to benefit from its own abuse of the discovery process. As noted above, Opposer was forced to file a motion to compel which the Board granted on December 12, 2006, and directed Applicant to produce responsive documents and designate a Rule 30(b)(6) witness. The Board also reset the discovery period to close on February 15, 2007, so as to provide the parties with a time frame to carry out actions required by the Order granting Opposer's motion. In light of the circumstances that forced Opposer to file its motion to compel and the Board's disposition of that motion, it seems clear that the December 12, 2006 Order did not contemplate giving Applicant a second chance at serving discovery.

Applicant apparently misconstrues the Board's Order of December 12, 2006, as authorization to restart the discovery process at this late date. That Order admonished Applicant by characterizing its responses to Opposer's

discovery requests as “too little, too late.” By propounding its excessive Amended First Set of Interrogatories, Applicant’s conduct now is too much, too late and in clear contravention of Board procedures. Accordingly, Applicant is not entitled to additional discovery.

While Opposer recognizes the value of the recommendation for voluntary agreement by the parties set forth in TBMP § 405.03(e), Opposer respectfully submits that § 405.03(e) does not contemplate the specific facts currently before the Board. Certainly, § 405.03(e) is not intended to allow a party to disregard and then manipulate the discovery process. Applicant failed to take any action in response to Opposer’s General Objection to the First Set of Interrogatories during the eight weeks remaining in the discovery period after that Objection was served. Contemporaneously, Applicant refused to respond to Opposer’s Request for Production and produce a witness in response to Opposer’s Rule 30(b)(6) Notice of Deposition, thus necessitating the filing of Opposer’s motion to compel. Consequently, the extended discovery period set by the Board’s Order is a direct, proximate result of Applicant’s failure to comply with its obligations during the discovery period. Certainly, the recommendation for voluntary agreement contemplated by § 405.03(e) does not encompass a situation such as this where Applicant refuses to comply with its discovery obligations, circumvents the clearly established rules of procedure, and then tries to manipulate the discovery process for its own benefit.

IV. CONCLUSION

Contrary to Applicant's assertions, Opposer has cited to specific rules of practice and procedures which govern the discovery dispute currently before the Board. Applicant did not follow those rules, thus continuing a pattern of ignoring its obligations in the discovery process. Accordingly, Opposer should not be compelled to answer the Amended First Set of Interrogatories and a stay of proceedings is unnecessary.

BRINK'S NETWORK, INCORPORATED

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Opposer's Memorandum in Response to Applicant'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 16th day of January, 2007:

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