

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

In the Matter of Application Serial No. 76/575,509

Filed: February 13, 2004

Published on March 29, 2005

Mark: PF (AND DESIGN) – Class 025

New Balance Athletic Shoe, Inc.,	:	
	:	
Opposer,	:	Opposition No. 91165451
	:	
v.	:	
	:	
S.A.S.C.O. Trading, Inc.,	:	
	:	
Applicant.	:	

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited on June 6, 2007 with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to:

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

By: 
Yamuna Bhaskaran
Attorney for Applicant

**APPLICANT'S MEMORANDUM IN OPPOSITION TO OPPOSER'S
MOTION TO COMPEL DISCOVERY RESPONSES BY APPLICANT**

Applicant S.A.S.C.O. Trading, Inc. ("SASCO") submits this memorandum in opposition to Opposer New Balance Athletic Shoe, Inc.'s ("New Balance") Motion to Compel Discovery Responses by Applicant, dated April 17, 2007 (the "Motion").



SASCO has diligently undertaken to respond to the issues raised in the Motion, and to that end, has served two supplemental document productions, the first on April 26, 2007 and the second on May 3, 2007 (the "May Letter"), producing nearly 400 additional pages. Copies of the transmittal letters are annexed hereto as Exhibits 1 and 2, respectively. The May Letter provides the date of first use of the PF mark; namely August 27, 1999. Subsequently, SASCO received a letter from New Balance's counsel identifying its concerns with the supplemental production and interrogatory responses. A copy of the letter, dated July 10, 2007, is annexed hereto as Exhibit 3 (the "New Balance Letter").

The New Balance Letter effectively concedes that SASCO has satisfied essentially all of the matters raised in the Motion, save one. As stated in the New Balance Letter, New Balance argues it is "entitled to know on which of the goods listed in the application [has SASCO] used the mark, and how, and since when, and to what extent," (Ex. 3, p.1), referring to the 12 categories of items identified in SASCO's application. These 12 categories are jackets, coats, pants, shirts, shorts, t-shirts, swimwear, underwear, sweat shirts, sweat pants, jogging suits, and vests (the "12 Categories"). As a purported compromise, New Balance states that if SASCO does not produce the information, New Balance "would require in return [SASCO's] waiver of any right to produce evidence that the applied-for mark was, or is, in use." (Ex. 3, p. 2).

New Balance's position is untenable. As stated in the May Letter, SASCO is simply not in a position to supply the information requested by New Balance. The PF mark has been in use for nearly eight years as part of SASCO's "Pacific Flyer" line of clothes, and there are over 2,000 product styles that have been created since that time. Notably, not all "Pacific Flyer" goods carry the "PF" mark – "PF" is shorthand for "Pacific Flyer," and while "Pacific Flyer" garments say "Pacific Flyer," the "PF" shorthand does not appear on every such garment. Thus,

use of the PF mark varies drastically among the individual products, and because the records do not always identify whether the “PF” mark was used, finding the information concerning the “annual sales figures for each product or service from the date of first use,” as requested in New Balance’s Interrogatory 6(f), would be extremely burdensome for our client, if not altogether impossible. SASCO’s business would come to a grinding halt for a protracted period of time, and even then, it would still be virtually impossible to provide the information sought by New Balance. SASCO’s records are not organized or maintained in a “litigation-friendly” manner, so to speak – locating the sought-after documents would be time-consuming and potentially fruitless.

In any event, New Balance is not entitled to this information, and certainly not in the form it seeks. The dates of first use for the 12 Categories are simply irrelevant to the opposition proceeding, and the utility of the information sought is far outweighed by the burden of producing it. New Balance’s request is overbroad, unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence. SASCO has been using the PF mark on over 2000 styles of clothing since 1999, as already borne out in the documents it has produced. Producing the overbroad categories of documents requested by New Balance is impractical and extremely burdensome. The Trademark Trial and Appeal Board Manual of Procedure provides that

The right to discovery is not unlimited. Even if the discovery sought by a party is relevant, it will be limited, or not permitted, where, inter alia, it ... is unduly burdensome or obtainable from some other source that is more convenient, less burdensome, or less expensive; or “where harm to the person from whom discovery is sought outweighs the need of the person seeking discovery of the information.

TBMP § 402.02 Limitations on Right to Discovery; *see also* 8A Charles Alan Wright, Arthur R. Miller and Richard L. Marcus, Federal Practice and Procedure, § 2174 (2d ed. 1994) (observing

that "interrogatories that require a party to make extensive investigations, research, or compilation or evaluation of data for the opposing party are in many circumstances improper"). New Balance is seeking nearly eight years of business records on over 2,000 products. This information, which is ultimately irrelevant to the outcome of this action, is more economically and expeditiously obtained in the course of a deposition. If New Balance seeks any further information concerning the 12 Categories, it should obtain that information in the course of a deposition (to date, New Balance has not noticed any depositions during the course of this litigation), or during the testimony period. SASCO cannot be expected to indefinitely suspend its business operations to look for the documents sought by New Balance, nor should SASCO be prohibited from submitting evidence of the use of its products, as requested by New Balance.

For the foregoing reasons, SASCO respectfully requests that the T.T.A.B. deny New Balance's Motion in its entirety.

Dated: June 6, 2007
New York, New York

Respectfully submitted,

COHEN TAUBER SPIEVACK & WAGNER LLP



By: _____
Esther S. Trakinski

Attorneys for Applicant
420 Lexington Avenue, Suite 2400
New York, New York 10170
(212) 586-5800

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing APPLICANT'S MEMORANDUM IN OPPOSITION TO OPPOSER'S MOTION TO COMPEL DISCOVERY RESPONSES BY APPLICANT has been served on June 6, 2007, via First Class Mail, postage prepaid, to

Thomas V. Smurzynski
Lahive & Cockfield, LLP
One Post Office Square
Boston, Massachusetts 02109

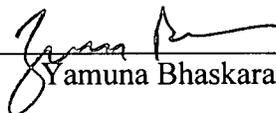

Yamuna Bhaskaran

EXHIBIT 1

C | T | S | W

COHEN TAUBER SPIEVACK & WAGNER LLP

Yamuna Bhaskaran

Direct: 212-381-8728

Email: ybhaskaran@ctswlaw.com

By Overnight Delivery

April 26, 2007

Thomas V. Smurzynski, Esq.
Lahive & Cockfield LLP
One Post Office Square
Boston, MA 02109

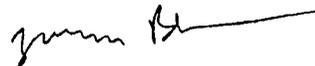
Re: New Balance v. SASCO, T.T.A.B. Opposition No. 91165451

Dear Tom:

I enclose documents Bates numbered SASCO 00127 through 00488, in further response to Opposer's First Set of Requests to Applicant for Production of Documents and Things. In accordance with the Stipulated Protective Order, submitted to the T.T.A.B. on May 15, 2006, some of the documents have been marked "CONFIDENTIAL / ATTORNEY'S EYES ONLY." In addition, documents Bates numbered SASCO 00374 through 00488 were sent to us by Ezra Sutton & Associates, P.A. We have redacted certain portions of the documents among those pages on the grounds of attorney work-product or attorney-client privilege, and will send you a privilege log next week.

Some of the documents contain irrelevant information or information pertaining to styles that are not the subject of this litigation (e.g., SASCO 00142). Although we are currently producing those documents in an unredacted form in the interest of getting the documents to you as quickly as possible, we reserve the right to replace those pages with redacted versions. We expect to produce updated versions of some of the documents contained herein next week. All documents produced by SASCO have been and will continue to be produced as they are kept in the usual course of business, unless otherwise indicated.

Sincerely,



Yamuna Bhaskaran

Encl.

EXHIBIT 2



COHEN TAUBER SPIEVACK & WAGNER LLP

Yamuna Bhaskaran

Direct: 212-381-8728

Email: ybhaskaran@ctswlaw.com

By Overnight Delivery

May 3, 2007

Thomas V. Smurzynski, Esq.
Lahive & Cockfield LLP
One Post Office Square
Boston, MA 02109

Re: New Balance v. SASCO, T.T.A.B. Opposition No. 91165451

Dear Tom:

I enclose SASCO's final document production, Bates stamped SASCO 00490 through 00513. Again, some of the documents have been marked "Confidential / Attorney's Eyes Only" in accordance with the Stipulated Protective Order, submitted to the T.T.A.B. on May 15, 2006. I also enclose SASCO's privilege log.

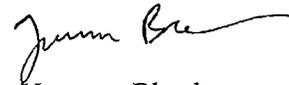
In response to the concerns you raised in your Motion to Compel Discovery Responses by Applicant, dated April 17, 2007, we have conferred with SASCO about supplementing its answers to Interrogatory No. 6.

The date of SASCO's first use of the PF Mark is August 27, 1999, as demonstrated in document Bates stamped SASCO 00493. However, because of the extensive breadth of the PF product lines, the fact that not all "Pacific Flyer" goods carry the "PF" mark, and the staggered first use of the PF mark among the individual products, providing the information you requested concerning the "annual sales figures for each product or service from the date of first use" in Interrogatory 6(f) will be extremely burdensome for our client, if not altogether impossible. Over the course of nearly eight years, SASCO has carried over 2,000 product styles that have the PF mark. Determining the dates of first use for each of those products would require SASCO's business to come to a grinding halt for a protracted period of time, and even then, it would still be virtually impossible to determine the dates of first use for all of those products.

Thomas V. Smurzynski, Esq.
May 3, 2007
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Moreover, there is no dispute that SASCO has been using the PF mark in its various clothing products since 1999, and the specific first use dates for specific components of that line are simply not relevant. Thus, there is no value to providing specific dates of first use for each of those products, particularly when compared to the incredible burden placed on SASCO in gathering that information. *See, e.g.*, 8A Charles Alan Wright, Arthur R. Miller and Richard L. Marcus, Federal Practice and Procedure, § 2174 (2d ed. 1994) (observing that “interrogatories that require a party to make extensive investigations, research, or compilation or evaluation of data for the opposing party are in many circumstances improper”). In light of these circumstances, we stand on our response to Interrogatory 6(f), and we respectfully request that New Balance withdraw its Motion to Compel.

Sincerely,



Yamuna Bhaskaran

Encl.

EXHIBIT 3

LAHIVE & COCKFIELD LLP

COUNSELLORS AT LAW ONE POST OFFICE SQUARE BOSTON, MASSACHUSETTS 02109-2127

JOHN A. LAHIVE, JR. (1928-1897) JAMES E. COCKFIELD (1830-2000) GIULIO A. DeCONTI, JR. ELIZABETH A. HANLEY AMY BAKER MANDRAGOURAS ANTHONY A. LAURENTANO KEVIN J. CANNING JANE E. REMILLARD DEBRA J. MILASINIC, Ph.D. MEGAN E. WILLIAMS, Ph.D. WILLIAM A. SCOFIELD, JR. BIBLEY P. REPPERT MARIA LACCOTRIPE ZACHARAKIS, Ph.D. SEAN D. DETWEILER DANIELLE L. HERRITT DAVID R. BURNS JOHN S. CURRAN EUIHDOON LEE * MANEEGH GULATI CYNTHIA M. BOROOS PETER W. DINI, Ph.D. JAMES M. MCKENZIE

JILL GORNY SLOPER SAPNA MEHTANI, Ph.D. CRISTIN HOWLEY COWLES, Ph.D. ALISSA H. FARIS

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OF COUNSEL JEREMIAH LYNCH JEANNE M. DIGIORGIO CYNTHIA L. KANIK, Ph.D. BENEDICT A. MONACHINO

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TECHNICAL SPECIALISTS CATHERINE M. BISHOP ANNE JACQUELINE WIZEMAN, Ph.D. MEAGHAN L. RICHMOND, Ph.D. SHARON M. WALKER, Ph.D. ANITA M. BOWLES, Ph.D. MARCIE B. CLARKE, Ph.D. NEBLIHAN I. DORAN ISHNA NEAMATULLAH BRIANA M. ERICKSON, Ph.D. ANDREW T. WILKINS, Ph.D. JERMAINE A. LAWRENCE JOSHUA K. ROTH

* Admitted in CT only

VIA FAX

May 22, 2007

Yamuna Bhaskaran, Esq. Cohen Tauber Speivack & Wagner, LLP 420 Lexington Avenue, 24th Floor New York, NY 10170 FAX NO.: (212) 586-5095

Re: New Balance Athletic Shoe, Inc. v. S.A.S.C.O. Trading, Inc. Opposition No. 91165451 (Our Ref: NBK-334-036)

Dear Ms. Bhaskaran:

Thank you for your letter of May 3, 2007.

I have noted your comments about supplementing your client's responses to my Interrogatory 6. You mentioned 6(f), but my letter of July 10, 2006, where I initially objected to the completeness of your discovery responses, dealt with 6(a) and 6(e) as well.

The application in dispute here is an intent-to-use application to register a "PF" logo for "jackets, coats, pants, shirts, shorts, T-shirts, swimwear, underwear, sweat shirts, sweat pants, jogging suits, and vests."

The application is automatically in the record in the opposition proceeding, where it has the benefit of its filing date.

Our discovery requests were to ascertain something we are entitled to know: on which of the goods listed in the application have you used the mark, and how, and since when, and to what extent?

Yamuna Bhaskaran, Esq.
Cohen Tauber Speivack & Wagner, LLP
May 22, 2007
Page 2

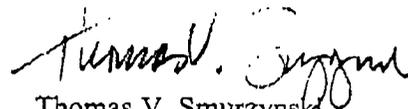
Interrogatory 6 was directed to these matters. I expected your answer to Interrogatory 6(a) ("identify each product") to be the list you supplied in your trademark application. Then 6(e) asked a normal question, about the dates of use (or lack thereof) for each product in that list, and 6(f) asked for the extent of the use.

Your letter suggests all this is impossible, and says that "there is no dispute that SASCO has been using the PF mark in its various clothing products since 1999." Actually, there is a dispute, since your application is an intent-to-use application, and we will object to any testimony that relies on facts and figures you were unwilling to produce in discovery.

I also do not find the sales summaries you produced in document production to be understandable or complete (and some pages, such as SASCO 00220-00224, 00234-00239 and 00247, are illegible).

I can accept your decision not to inconvenience your client by requiring his production of the information we request, but I would require in return your waiver of any right to produce evidence that the applied-for mark was, or is, in use. You may rely on the filing date of the application instead.

Very truly yours,



Thomas V. Smurzynski
FAX NO.: (617) 742-4214

TVS/pr

NUMBER OF PAGES INCLUDING THIS PAGE: TWO