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

Proceeding	91167991
Party	Plaintiff The H.D. Lee Company, Inc. The H.D. Lee Company, Inc. The H.D. Lee Company, Inc. 3411 Silverside Road201 Baynard Building Wilmington, DE 19810 UNITED STATES
Correspondence Address	Paul J. Kennedy Pepper Hamilton LLP Eighteenth and Arch Streets, 3000 Two Logan Square Philadelphia, PA 19103-2799 UNITED STATES kennedyp@pepperlaw.com, kearneyc@pepperlaw.com, mulligar@pepperlaw.com
Submission	Reply in Support of Motion
Filer's Name	Cara M. Kearney, Esquire
Filer's e-mail	kennedyp@pepperlaw.com, kearneyc@pepperlaw.com, mulligar@pepperlaw.com
Signature	/CMK/
Date	03/28/2007
Attachments	ONE FABULOUS FIT - Reply to Applicant's Response to Motion to Compel.PDF (22 pages)(565659 bytes)

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

In the Matter of Serial No. 78/363,351 For the Mark: ONE FABULOUS FIT	:	
The H.D. Lee Company, Inc., Opposer	:	
v.	:	Opposition No. 91167991
Maidenform, Inc., Applicant.	:	

REPLY TO APPLICANT'S RESPONSE TO MOTION TO COMPEL

Opposer H.D. Lee Company, Inc. ("Opposer"), by and through its undersigned counsel, hereby submits this reply to Applicant's Response to Opposer's Motion to Compel ("Applicant's Brief"), and in support hereof, states as follows:

I. INTRODUCTION

Opposer's Motion to Compel and Motion to Extend Testimony are both based on the underlying premise that there was an understanding between the Parties that the proceeding was de facto suspended until the Parties either settled the case or decided that settlement between the Parties would be impossible to attain. Based on this understanding,[1] Opposer had no reason to file a motion to compel before the commencement of the testimony period.

Applicant claims that there was no such understanding, and suggests that Opposer in bad faith created an after-the-fact email to support its position. This unfounded allegation is both untrue and unwarranted.

[1] This understanding was further cemented by Opposer's generous professional courtesy in allowing Applicant to not just extend, but *reopen* the discovery period so that it could serve discovery requests upon Opposer.

II. ARGUMENT

A. Opposer had a Good Faith Belief It Responded to Applicant's Settlement Proposal.

Opposer believed in good faith that it sent an email to Applicant on November 14, 2006 in response to Applicant's settlement proposal. Declaration of Helen L. Winslow, Esquire ("Winslow Dec.") ¶ 6, attached hereto as Exhibit A. As soon as Opposer realized the email was never sent, it informed Applicant of this inadvertent oversight. *Id.* at ¶ 7.

In Applicant's Brief, Applicant goes out on a limb and suggests that Opposer never actually drafted the November 14 email. Applicant's Brief alleges that Opposer was "simply trying to make excuses" by claiming that Opposer believed it sent Applicant a settlement proposal on November 14. Applicant's Brief at 18. This attack on Opposer's integrity is unfounded and unwarranted. Because Opposer's word is obviously not sufficient to satisfy Applicant's concerns, Opposer submits the Declaration of Helen Winslow, Esquire, Assistant General Counsel, Vice President, and Secretary of Opposer. Ms. Winslow, under penalty of perjury, affirms that she drafted an email on November 14, 2006 and believed that she sent the email to Jennifer Prioleau, Esquire, counsel for Applicant, on or about November 14, 2006. Winslow Dec. ¶ 6. In view of this unrefuted Declaration, it is apparent that the Parties were engaged in active settlement negotiations.

B. The Exhibits to Applicant's Brief Should Be Placed Under Seal.

In violation of Federal Rule of Evidence 408, Applicant attached to its publicly available brief printouts of electronic settlement communications between the parties. While Opposer does not object to the Board's review of those communications, Opposer respectfully requests that those communications be placed under seal.

C. The Special Requirements for Motion to Compel Were Met

Applicant asserts that Opposer's Motion to Compel "must be Denied because it does not comply with the special requirements for motions to compel…." Specifically, Applicant argues that Opposer's Motion to Compel was insufficient because it did not include: (1) a copy of the discovery requests and responses and (2) a written statement from the moving party that such party or its attorney has made a good faith effort to resolve the issues presented in the motion. Further, Applicant claims Opposer was "simply too late" to force Applicant to comply with its obligations under the rules.

First, Applicant failed to submit *anything* in response to Opposer's discovery requests. Opposer's Motion to Compel is not an ordinary motion to compel protesting an applicant's responses to one or several of the discovery requests. Rather, Opposer's Motion to Compel points out that Applicant has provided no response whatsoever to Opposer's discovery requests, and seeks an order from the Board requiring Applicant to respond. The content of the requests were not at issue, so Opposer did not burden the Board with excess paper. In any event, in an abundance of caution, the discovery requests are attached hereto as Exhibit B.

Second, as Applicant's counsel is well aware, Opposer has made a good faith effort to resolve the issues set forth in its Motion to Compel through telephonic and email communications with opposing counsel Jennifer Prioleau. *See, e.g.,* Opposer's Motion to Compel at 2 (stating that Applicant has refused to produce the requested information in a timely fashion).

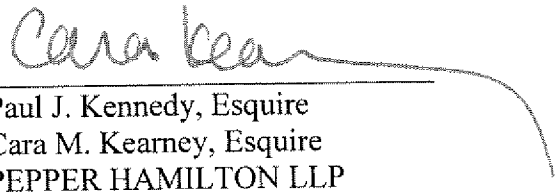
Finally, while it is true that Opposer did not file its Motion to Compel prior to the commencement of the testimony period, given the understanding between the parties that further extensions would be granted (as demonstrated, at a minimum, the numerous extensions granted by Opposer and Opposer's *reopening* the discovery period in order for *Applicant* to serve

discovery), a motion to compel was unnecessary prior to the time Applicant refused to consent to an extension of the testimony period and refused to timely produce documents. In the interest of a fair resolution of this proceeding on the merits, the Motion to Compel should be granted.

III. CONCLUSION

For the foregoing reasons, Opposer respectfully requests that the Board (1) order that Applicant respond to Opposer's discovery requests and (2) place under seal the exhibits to Applicant's Brief.

Respectfully submitted,



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Cara M. Kearney, Esquire
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3000 Two Logan Square
Eighteenth and Arch Streets
Philadelphia, PA 19103-2799
(215) 981-4000

Attorneys for Opposer,
The H.D. Lee Company, Inc

Date: March 28, 2007

CERTIFICATE OF SERVICE

I, Cara M. Kearney, hereby certify that on March 28, 2007 a true and correct copy of the foregoing Reply to Applicant's Response to Motion to Compel was served via U.S. first class mail, postage prepaid, upon the following:

Jennifer A. Prioleau, Esquire
Maidenform, Inc.
154 Avenue E
Bayonne, NJ 07002

Cara Kearney

Cara M. Kearney

EXHIBIT A

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

In the Matter of Serial No. 78/363,351 For the Mark: ONE FABULOUS FIT	)	
The H.D. Lee Company, Inc., Opposer	)	Opposition No. 91167991
v.	)	
Maidenform, Inc., Applicant.	)	

DECLARATION OF HELEN L. WINSLOW, ESQUIRE

I, Helen L. Winslow, declare:

1. I am Assistant General Counsel, Vice President, and Secretary of The H.D. Lee Company, Inc. ("Lee"), the Opposer in the above-referenced opposition proceeding. My duties and responsibilities include enforcement of Lee's many trademark equities, including the ONE TRUE FIT® and THE BRAND THAT FITS® trademarks and branded products. I have served as Assistant General Counsel and Secretary of Lee since 2001 and as Vice President since 2005. The facts recited in this Declaration come from my own personal knowledge or from my personal involvement in this matter.

2. I submit this Declaration in support of Lee's (1) Reply to Applicant's Response to Opposer's Motion to Compel and (2) Reply to Applicant's Response to Opposer's Motion to Extend Testimony Period. I believe that a response is needed, given opposing counsel's accusation that I manufactured an email after the fact. Besides the fact that this is simply not true, it is quite disappointing to me, personally and professionally, that opposing counsel has chosen to make such an accusation.

3. On October 20, 2006, I received an e-mail from opposing counsel Jennifer Prioleau containing a settlement proposal.

4. On November 6, 2006, I sent an e-mail to Jennifer Prioleau, informing her that I was in the middle of moving my office and that I would respond to her settlement proposal after the move.

5. On November 14, 2006, after my move, I reviewed Jennifer Prioleau's settlement offer and drafted my e-mail response to her. By e-mail on November 14, 2006, I requested and received input on my draft response from outside counsel and from the trademark paralegal working with me on this matter. I then decided the e-mail was ready to go to Jennifer Prioleau.

6. From November 14, 2006 through February 16, 2007, I believed that I had sent my November 14, 2006 email to Jennifer Prioleau. I waited patiently for a reply from her. While waiting for a reply from her, I granted Jennifer Prioleau's requests for extensions.

7. On February 16, 2007, realizing that I had not received a response from Jennifer Prioleau, I prepared to call Jennifer Prioleau by reviewing my most recent e-mail correspondence with her. I could not find a sent copy of my November 14, 2006 e-mail, however, so I telephoned Jennifer Prioleau and asked her whether she had received my November 14, 2006 e-mail. She stated that she had not. I apologized, explained that I had written her an e-mail on November 14, 2006 that I believed I had sent to her, but that I could not find a sent copy of it, and promised to look into the matter further and get back to her. I searched further among my e-mails, and the only copy of my November 14, 2006 e-mail that I could find was the copy I had e-mailed to outside counsel and to my trademark paralegal on

November 14, 2006 for comment. Since I knew I had received their sign-off the same day I requested it, I concluded that I had been interrupted between receiving their sign-off and sending the November 14, 2006 e-mail to Jennifer Prioleau, such that I failed to send it to her. On February 16, 2007, the same day that I telephoned Jennifer Prioleau, I sent her an e-mail, explaining my inadvertent omission and forwarding the November 14 counterproposal to her. Jennifer Prioleau did not respond.

8. On February 21, 2007, I sent an email to Jennifer Prioleau requesting an extension of the testimony period.

9. On February 23, 2007, I received an email from Jennifer Prioleau denying my request.

10. On February 26, 2007, at my request, Pepper Hamilton LLP called and later emailed Jennifer Prioleau to see whether unnecessary litigation costs could be avoided by stipulating to a final extension with the hope of either effectuating settlement or moving forward with litigation. Jennifer Prioleau denied this request as well.

11. On February 27, 2007 Lee filed its Motion to Extend Testimony Period and Motion to Compel in the ONE FABULOUS FIT proceeding.

12. On March 2, 2007 Lee filed its Motion to Extend Testimony Period and Motion to Compel in the ONE FAB FIT proceeding.

Pursuant to 28 U.S.C. § 1746, I declare under penalty of perjury under the laws of the United States of America that the foregoing statements are true and correct to the best of my knowledge, information or belief.

Helen L. Winslow

HELEN L. WINSLOW

EXHIBIT B

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

In re Trademark Application of Maidenform, Inc.	:	
Serial No. 78/363,351	:	
Filed: February 5, 2004	:	Opposition No.: 91167991
Published in the Official Gazette on August 9, 2005	:	
Mark: ONE FABULOUS FIT	:	

OPPOSER'S INTERROGATORIES AND REQUESTS FOR PRODUCTION OF DOCUMENTS ADDRESSED TO APPLICANT -- FIRST SET

The H.D. Lee Company, Inc. ("Opposer"), by its attorneys, Paul J. Kennedy and Cara M. Kearney, propound the following written interrogatories to be answered separately and fully in writing under oath in accordance with the Trademark Rules of Practice and the Federal Rules of Civil Procedure, where applicable.

DEFINITIONS AND INSTRUCTIONS

The following definitions are applicable to terms employed herein:

1. The term "Applicant" refers to Maidenform, Inc.

2. The term "Opposer" or "H.D. Lee" refers to The H.D. Lee Company, Inc. its officers, employees, attorneys, agents and representatives, and any predecessor, successor, parent or subsidiary entity, either foreign or domestic.

3. The term "person" refers both to natural persons, whether or not in the employ of Applicant and the "acts and knowledge" of a person are defined to include the acts and knowledge of that person's employees, representatives, agents and attorneys.

4. The term "trademark" or "mark" includes trademarks, service marks, collective marks, certification marks and trade names as defined in 15 U.S.C. § 1127.

5. The term "document" refers to written, printed, typed and visually or aurally reproduced material of any kind, whether or not privileged, and includes, but is not limited to, letters, telegrams, facsimile transmissions, electronic mail, work papers, handwritten or other notes, memoranda, inter-office communications, notices, books, studies, analyses, evaluations, statements, summaries, opinions, records, minutes or transcriptions or notations of meetings, telephone conversations or other communications of any type, photographs, bills, contracts, invoices, agreements, orders, receipts, drawings or sketches, advertising or promotional literature, operating manuals or instruction bulletins, cables, tape and other recordings, test data, reports, questionnaires, surveys, charts, graphs, pamphlets and catalogs.

6. "Interrogatory" shall refer to the specific Interrogatory contained in Opposer's Interrogatories Addressed to Applicant -- First Set.

7. To "identify" a person means to state the person's name and business address and, in the case of a natural person, his or her home address and occupation or job title.

8. To "identify" or "describe" a document means to provide a brief description of the document sufficient to support a request for production, including the general nature of the subject matter, the date, identification of the author and recipient, if any, and, if the document embodies an agreement, the parties to such agreement. In answer to those Interrogatories requiring the identification of any document or documents, such document or documents may be produced by Applicant for inspection and copying along with the answers to these Interrogatories in lieu of identification. To "identify" a thing means to provide a brief description of the thing sufficient to support a request for production, including any numbers, markings or other identifying characteristics. To "locate" documents or things means to state the present whereabouts of each document or thing, and to identify the person having possession, custody or control thereof.

9. Wherever a "date" is requested to be identified it shall mean the exact date, month and year, if ascertainable, or if not, the best approximation (including relationship to other events).

10. Should Applicant deem to be privileged any documents concerning which information or inspection is requested by any of the following Interrogatories, Applicant shall indicate that she claims privilege therefore, briefly state the grounds on which the claim of privilege rests, indicate the position held by the person who prepared and/or possesses the document, indicate the position held by the addressee, and identify all persons (and their positions) who received copies of such documents, either at the time of initial distribution or at any subsequent time, all in order that Opposer may have the actual basis to determine whether such documents are, in fact, privileged.

11. Applicant has the duty to supplement its responses to these Interrogatories at such times and to the extent required by Rule 26(e) of the Federal Rules of Civil Procedure.

INTERROGATORIES

1. Identify the person or persons most familiar with the use by Applicant of the mark ONE FABULOUS FIT (Applicant Serial No. 78/363,351) (the "Mark"), including the person or persons who has oversight of the intellectual property issues subject to the opposition.

ANSWER:

2. Describe in detail the nature of Applicant's business, including the goods and services offered by Applicant.

ANSWER:

3. Identify all goods, products, services and items ever sold, intended to be sold, offered for sale, presently sold, or manufactured for use by others by or on behalf of Applicant under or in connection with the Mark, and for each, supply the date of first use of the mark on the goods and services, and identify all documents related thereto.

ANSWER:

4. Identify the dates on which Applicant decided to adopt and first used the Mark, and identify all documents related thereto.

ANSWER:

5. Describe the circumstances and methods by which Applicant selected and first used the Mark for each type of goods and services for which the mark is used, and identify all documents related thereto.

ANSWER:

6. Describe the circumstances and methods by which Applicant selected and first used the Mark for each type of goods and services for which the mark is used or is intended to be used, and identify all documents related thereto.

ANSWER:

7. Identify whether any searches or investigations were conducted by Applicant or any person on its behalf (including its attorneys) to determine whether the Mark was available as a trademark or used in exact or similar form by others, and, if so, identify each such search or investigation, and identify all documents related thereto.

ANSWER:

8. Identify the person or persons employed by Applicant who had, or has, primary responsibility for maintenance and protection of the Mark.

ANSWER:

9. Identify the person or persons employed by Applicant and each outside agent or agency retained by Applicant who had, or has, primary responsibility for adopting, maintaining and protecting the Mark, and the marketing, advertising and promotion of any goods and services affiliated with the mark.

ANSWER:

10. State any policy (written or unwritten) Applicant may have, identifying and locating any documents, concerning the use, display and advertising of the Mark.

ANSWER:

11. Describe all marketing, advertising, solicitation, promotion and distribution programs and methods, identifying and locating any documents, used by Applicant, or intended to be used by Applicant, in the United States and abroad, for services affiliated with and products bearing the Mark from the date of first use to the present, and identify all documents related thereto.

ANSWER:

12. Identify the general and specific media through which Applicant intends to or has advertised, marketed or promoted its good and services affiliated with the Mark or any variation thereof.

ANSWER:

13. Describe all promotional, charitable and sponsorship activities of Applicant involving the Mark, identifying and locating any documents.

ANSWER:

14. Describe the geographic market areas, or intended geographic market areas, specifying each state or country, for services affiliated with and products bearing the Mark since the date of first use to the present.

ANSWER:

15. Identify and describe any and all packaging, containers, hang tags, labels, decals, imprints and any other goods bearing the Mark and identify all samples.

ANSWER:

16. State whether or not Applicant has ever received any misdirected mail, telephone calls, orders, inquiries, complaints, or similar communications that were intended for Opposer, or one of its affiliated companies, and, if so, for each such incident, state or describe all of the circumstances surrounding the event.

ANSWER:

17. Give the date and describe the circumstances under which Applicant first became aware of Opposer's mark, and identify each person connected to or associated with Applicant who first learned of such use.

ANSWER:

18. Identify each class of customers for products and services affiliated with the Mark, including without limitation, manufacturers, wholesalers and retailers to whom the goods and services affiliated with the Mark have been sold, offered for sale, marketed, distributed, and advertised since the date of first use to the present.

ANSWER:

19. Identify the channels of trade and distribution within which the products and services affiliated with the Mark are offered or intended to be offered.

ANSWER:

20. State whether Applicant or any person acting for or on its behalf has conducted any type of inquiry or investigation of Opposer or their adoption or registration of the Mark, and, if so, state the date the inquiry or investigation was conducted; identify each person who conducted and reviewed it; and state with specificity the findings that were made.

ANSWER:

21. State whether Applicant or any person acting for or on its behalf has obtained any statements or opinions, either oral or written, regarding any issues in this opposition proceeding, and, if so, state the date the statement or opinion was obtained by Applicant; identify the person or persons who rendered each statement or opinion; identify the person or persons who received each statement or opinion; and describe the subject matter about which the persons rendering such statements or opinions were consulted or retained.

ANSWER:

22. State whether Applicant or any person acting for or on its behalf has consulted with or retained the services of any expert or intends to consult with as an expert witness regarding any issues in this opposition proceeding, and, if so, state the date the expert opinion was obtained by Applicant; identify each such expert; identify all documents upon which said expert will base his or her opinion; and describe the subject matter about which the expert was consulted or retained.

ANSWER:

23. Identify each person Applicant intends to call as a witness during the testimony period in connection with this opposition proceeding and state the facts or subject matter about which each witness is expected to testify.

ANSWER:

24. Identify the documents upon which Applicant intends to rely in connection with this opposition proceeding.

ANSWER:

25. With regard to the response to each Interrogatory herein, state the name of each employee or agent of Applicant to whom the information is a matter of personal knowledge, the name of each employee or agent who furnished information pertaining to such responses and the basis upon which affiant relies in whole or in part for such response.

ANSWER:

26. Identify all documents relating to the subject matter of the foregoing interrogatories and the preparation of Applicant's responses thereto.

ANSWER:

REQUEST FOR PRODUCTION OF DOCUMENTS - FIRST SET

Opposer, pursuant to Trademark Rule 2.120 and Rule 34 of the Federal Rules of Civil Procedure, hereby requests that Applicant produce for inspection and copying the following documents at the offices of Cara M. Kearney, Esquire Pepper Hamilton LLP, 3000 Two Logan Square, Eighteenth and Arch Streets, Philadelphia, Pennsylvania 19103-2799, or, in the alternative, that Applicant photocopy and forward copies of the following documents to Opposer's attorney, within thirty (30) days of service hereof.

DEFINITIONS

The Definitions to the Interrogatories above are incorporated by reference.

Applicant has the duty to produce supplemental documents and things, as additional information becomes known to the extent required by Rule 26(e) of the Federal Rules of Civil Procedure.

DOCUMENT REQUESTS

1. Produce all documents identified in Applicant's responses to the Interrogatories set forth above, for which identification is sought therein.

2. Produce all documents that record, reflect, relate, refer to, or contain information used in preparation of the responses to the Interrogatories set forth above.

3. Produce samples of all forms of packaging, containers, hang tags, labels, decals, imprints and any other goods bearing the Mark.

4. Produce samples of all forms of current and proposed advertising, informational, promotional and marketing materials bearing the Mark, including without limitation, catalogues, circulars, brochures, directories, trade journals, newspaper and magazine advertisements, online screen displays, websites, sales sheets, price lists, pamphlets, direct mail pieces, press releases and any such other materials bearing the Mark covered by Application

Serial No. 78/363,351 used or to be used by Applicant or any predecessor, related company, or third party.

5. Produce all documents which evidence, refer or relate to the creation, selection, and adoption of the Mark by Applicant.

6. Produce all documents relating or referring to any searches undertaken by or on behalf of Applicant, which relate or refer to the Mark.

7. Produce all documents which evidence, refer or relate to the earliest use or anticipated use, and the earliest use or anticipated use in interstate commerce, of the Mark by Applicant or any third party.

8. Produce all documents which evidence, refer or relate to consent, authorization or permission given to Applicant by any individual and/or entity to use the Mark and the scope of that consent.

9. Produce all documents which evidence, refer or relate to statements, inquiries, comments or other communications by or from Applicant's customers, competitors or other third parties, either written or oral, evidencing any confusion, suspicion, belief or doubt on the part of said customer, competitor or other third party as to the relationship between Applicant and Opposer or their respective goods and/or services.

10. Produce all documents sufficient to identify the type of publication in which Applicant has advertised or promoted, is advertising or promoting, or plans to advertise or promote any and all of its goods and/or services with the Mark.

11. Produce all documents relating or referring to and/or showing the channels of distribution through which Applicant's products or services are sold, are intended to be sold, are under consideration to be sold and/or were under consideration to be sold, and the categories

of consumers with whom Applicant does or intends to do business or to whom Applicant offers or intends to offer its products or services under the Mark.

12. Produce all studies, surveys, market research tests or memoranda including, but not limited to demographic or consumer profile studies, relating to the purchasers or potential purchasers of Applicant's products and/or services sold, offered for sale, advertised or promoted under the Mark or intended to be sold, advertised or promoted under the Mark.

13. Produce all documents in support of Applicant's Answer to Opposer's Notice of Opposition.

PAUL J. KENNEDY
NATHAN W. DEAN
CARA M. KEARNEY
PEPPER HAMILTON LLP
3000 Two Logan Square
Eighteenth and Arch Streets
Philadelphia, PA 19103-2799
(215) 981-4000

Date: July 24, 2006

Attorneys for Opposer
The H.D. Lee Company, Inc.

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

In re Trademark Application of Maidenform, Inc.	:	
Serial No. 78/363,351	:	
Filed: February 5, 2004	:	Opposition No.: 91167991
Published in the Official Gazette on August 9, 2005	:	
Mark: ONE FABULOUS FIT	:	

CERTIFICATE OF SERVICE

I, Nathan W. Dean, counsel for Opposer, The H.D. Lee Company, Inc., hereby certify that on July 24, 2006, I caused a true and correct copy of Opposer's Interrogatories and Requests for Production of Documents Addressed to Applicant -- First Set to be served via *First Class Mail* to:

Jennifer A. Prioleau
Maidenform, Inc.
154 Avenue E
Bayonne, NJ 07002

By: _____
Nathan W. Dean