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

Proceeding	91168756
Party	Defendant Ebel International Limited
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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FEDERATION DES INDUSTRIES DE LA PARFUMERIE	:	
Opposer	:	
v.	:	Opposition No. 91168756
EBEL INTERNATIONAL LIMITED	:	
Applicant	:	

APPLICANT'S OPPOSITION TO OPPOSER'S MOTION TO COMPEL

Applicant Ebel Internation Limite ("Ebel") hereby opposes the motion of Opposer Federation Des Industries De La Parfumarie ("FDI") to compel answers to Interrogatories and Document Requests.

FDI's motion should be denied as untimely since FDI has not made a good faith effort to resolve the issues presented in the motion with Ebel. Ebel believes that this motion is an attempt by Opposer to delay the case unnecessarily and avoid having to present its case to the Board. Moreover, FDI seeks discovery on issues that have no relevance in this proceeding.

FACTS

Ebel is a multi-brand international corporation with over 40 years of experience in the manufacturing and sale of beauty products. Ebel is committed to the self-fulfillment and wellbeing of thousands of women in the countries where its products are sold. FDI claims to be a French association of cosmetics and perfume manufacturers with an address in Paris, France.

FDI initiated this proceeding on January 20, 2006 opposing the registrations for Ebel's L'BEL PARIS family of marks, Application Serial Nos. 76/628,453, 78/561,766, 78/561,789, 78/562,491, 78/562,530, 78/562,515, 78/564,029, 78/565,366, and 78/697,339 ("Ebel's Marks").

FDI alleges that such marks are geographically misdescriptive and deceptive in violation of §2(e)(2) of the Lanham Act, and that registration of Ebel's Marks will damage FDI. Ebel filed its Answer on March 1, 2006 asserting various affirmative defenses including failure to state a claim, and acquiescence.

As documented by Opposer in it Motion to Compel, FDI served its first set of discovery requests on July 28, 2006. Ebel served timely responses on September 1, 2006. On May 3, 2007 and May 24, 2007, FDI's counsel sent Ebel's counsel a one and a half page letter expressing concern about Ebel's discovery responses. On May 18, 2007 and June 8, 2007, Ebel's counsel sent a reply addressing each of the concerns raised by FDI's counsel in its correspondence and reiterating Ebel's objections to some of the requests contained therein. On November 13, 2007, or five (5) months after Ebel's response to FDI's counsel's request, FDI's counsel sent another letter reiterating some of its prior concerns with regards to Ebel's discovery responses. On December 18, 2007, Ebel's counsel sent FDI's counsel an additional reply addressing each of the concerns raised by FDI's counsel in its correspondence and once again reiterating Ebel's objections raised since 2006. It was not until July 11, 2008, or seven (7) months after Ebel's response to FDI's counsel's request and one day prior to the close of discovery, that FDI's counsel sent yet another letter raising the same concerns that had been addressed by Ebel in December of the previous year. Notwithstanding this undue delay, Ebel's counsel sent a timely response on July 18, 2008 once again addressing each of the concerns raised by FDI's counsel in its correspondence and once again reiterating Ebel's objections raised since 2006. On July 28, 2008, and without making any further attempts to resolve this matter, by conference or correspondence, FDI filed this Motion to Compel responses to Interrogatories and Requests for Production.

I. THE MOTION TO COMPEL SHOULD BE DENIED BECAUSE FDI HAS NOT MADE A GOOD FAITH EFFORT TO RESOLVE THESE ISSUES.

FDI's Motion to Compel should be denied because FDI has failed to make the requisite good faith effort, by conference or correspondence, to resolve with Ebel the issues presented in the motion. As has been the case since FDI's original correspondence from May, 2007, Ebel has continuously raised and maintained its objections to the evidence requested by FDI. FDI has made no other efforts to contact Ebel to discuss these issues, and has let months go by in between its various letters only to follow-up with the same requests to and raise concerns about objections raised by Ebel for over two years. Thus, FDI has not made a good faith effort. *See* 37 CFR 2.120(e). *Giant Food, Inc. v. Standard Terry Mills, Inc.,* 231 U.S.P.Q. 626 (TTAB 1986). For this reason, FDI's motion should be denied.

A Motion to Compel must be supported by a written statement from the moving party that such party or its attorney has made a good faith effort, by conference or correspondence, to resolve with the other party or its attorney the issues presented in motion and has been unable to reach an agreement. *Id.* As the Board has stated, "no motion to compel should be filed unless the parties are truly unable, after making their best efforts to work out a mutually acceptable solutions to their discovery problems without the Board's help." *Bioshield Technologies, Inc. v. Bio-Lab,* 2000 TTAB Lexis 341 (TTAB 2000).

Here, FDI filed a motion to compel only days after receipt of Ebel's response to its lastest correspondence. FDI's counsel could have contacted Ebel's counsel by telephone to discuss this matter, but chose not to do so. A "meet and confer" between counsel is usually the best way to resolve discovery issues. Because no such effort was made, the motion should be denied. In

other cases, the Board has held that such efforts fall far short of the good faith required before filing a Motion to Compel Discovery. See *Giant Food,* 231 U.S.P.Q. 626.

Further, TMBP §523.03 provides that a 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..." In this case, FDI received Ebel's additional discovery responses on August 6, 2007. Additionally, FDI's counsel received Ebel's answer to the concerns raised by FDI to such responses on December 18, 2007. FDI then proceeded to wait seven months to once again raise the same concerns in its correspondence dated July 11, 2008 and later that same month file this Motion to Compel. Ebel believes that such correspondence was only a tolling mechanism to then argue that this Motion to Compel is timely when FDI has in fact known of Ebel's objections to the discovery requests and interrogatories in questions since at least August of 2007. Accordingly, the motion should be denied as untimely.

II. EBEL HAS FULLY RESPONDED TO THE INTERROGATORIES AND DOCUMENT REQUESTS AND ADDITIONAL REQUESTS ARE NOT RELEVANT TO THE ISSUES IN THIS PROCEEDING

Ebel has provided responses and clarifications to FDI with regards to the Interrogatories and Document Requests at issue. Specifically, FDI seeks information in connection with sales and advertising figures for goods sold by Ebel under Ebel's Marks and other marks owned by Ebel. Ebel has continuously objected to such requests as they are not relevant to this proceeding, unduly burdensome, and do not seek the production of discoverable evidence. Ebel has also stated that there are no issues of likelihood of confusion to be resolved in this proceeding to warrant the production of such sensitive financials and advertising figures for both Ebel's Marks and other marks owned by Ebel. Moreover, FDI seeks information in connection to marks owned by Ebel, which are not covered by this proceeding. In turn, Ebel believes that such

requests are meant to harass Ebel and will not resolve any issues in question within this proceeding.

Further, and as FDI correctly states in its Motion to Compel, this case concerns whether Ebel's Marks are geographically deceptively misdescriptive and geographically deceptive. Therefore, Ebel fails to see how sales and advertising figures for either Ebel's Marks, or other marks owned by Ebel resolve the above concerns. Additionally, FDI states in its Motion to Compel that such information is specifically relevant because "a comparison may well serve to demonstrate that the presence of PARIS enhances the perception/success/popularity and consumer's desire for Ebel's goods." Ebel submits that such reasons have no bearing on the issues in question in FDI's Opposition, and FDI offers none.

Moreover, while FDI states that such information may be probative of some significance of the word PARIS, it has failed to demonstrate how or why such significance is related to the issues in this case. In fact, Ebel submits that not only Ebel's Marks, but all of the marks it owns are designed to enhance the perception, success, popularity and consumer's desire for Ebel's products. Yet, such trademark strategy, with or without use of the term PARIS, or any enhancement that the term PARIS may provide to Ebel's goods, are not probative or provide any evidence as to the public's good-place association for products bearing Ebel's Marks.

Further, products sold by Ebel under marks other than Ebel's Marks are different that the products sold under Ebel's Marks. Thus, any attempted comparison, would be like comparing apples to oranges. Ebel's use of different marks is simply not relevant to whether the public makes a goods-place association with the goods sold under the marks at issue. Therefore, this motion is unnecessary, outside the subject-matter of this case, and should be denied with prejudice.

CONCLUSION

Ebel submits that FDI has shown a pattern of delay and lack of good faith efforts in its efforts to obtain discovery. Additionally, it now files this Motion to Compel seeking evidence that is neither relevant nor discoverable based on the issues that concern the Opposition proceedings at hand. Therefore, Ebel further submits that this Motion to Compel is just a delay tactic to prevent this case from moving forward to trial, rather than a good faith effort to obtain discoverable evidence. For all the foregoing reasons FDI's Motion to Compel should be denied.

Dated: August 18, 2008

EBEL INTERNATIONAL LIMITED

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CERTIFICATE OF SERVICE

I hereby certify that on August 18, 2008, a true and correct copy of Applicant's Opposition to Opposer's Motion to Compel was placed in the U.S. mail, postage prepaid, addressed to:

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