

ESTTA Tracking number: **ESTTA160228**

Filing date: **08/31/2007**

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

Proceeding	91175892
Party	Defendant Daniel, Mark T
Correspondence Address	DANIEL, MARK T 2316 YORK RD SW ROANOKE, VA 24015-3906 UNITED STATES mtdesq@hotmail.com
Submission	Other Motions/Papers
Filer's Name	Mark Tyson Daniel
Filer's e-mail	mtdesq@hotmail.com
Signature	/Mark Tyson Daniel/
Date	08/31/2007
Attachments	Microsoft_Opposition_91175892_-_Motion_for_Protective_Order_8.31.2007[1].pdf (12 pages)(52752 bytes)

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

_____	:	
MICROSOFT CORPORATION,	:	
	:	
Opposer,	:	Opposition No. 91175892
	:	Opposition No. 91175893
	:	
v.	:	
	:	
DANIEL, MARK T.,	:	
	:	
Applicant.	:	
_____	:	

ORDER

AND NOW, this ____ day of _____ 2007, upon consideration of Applicant Mark Tyson Daniel's Motion for Protective Order and Motion to Stay Discovery Pending Resolution of Applicant's Motion to Dismiss, and any Response thereto,

IT IS HEREBY ORDERED that Applicant's Motion for Protective Order is GRANTED. IT IS FURTHERED ORDERED that Applicant's Motion to Stay Discovery Pending Resolution of Applicant's Motion to Dismiss is GRANTED. Following resolution of Applicant's Motion to Dismiss, the Board will reset discovery deadlines. Applicant shall be permitted to submit full and complete responses to Opposer Microsoft Corporation's discovery requests with objections.

BY THE TRADEMARK TRIAL
AND APPEAL BOARD:

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

MICROSOFT CORPORATION,	:	
	:	
Opposer,	:	Opposition No. 91175892
	:	Opposition No. 91175893
	:	
v.	:	
	:	
DANIEL, MARK T.,	:	
	:	
Applicant.	:	

APPLICANT MARK TYSON DANIEL’S MOTION FOR PROTECTIVE ORDER AND
MOTION TO STAY DISCOVERY PENDING RESOLUTION OF APPLICANT’S
MOTION TO DISMISS

Pursuant to Fed. R. Civ. Proc. 26(c) and Trademark Rule of Practice 2.120(f), Applicant Mark Tyson Daniel (“Applicant”) hereby moves the Trademark Trial and Appeal Board (“the Board”) to enter a protective order precluding Opposer Microsoft Corporation (“Microsoft”) from seeking to compel responses to Microsoft’s several discovery requests propounded on April 12, 2007, including two sets of interrogatories, two sets of requests for production of documents, and two sets of requests for admission, each set corresponding respectively to the consolidated oppositions referenced above.

The specific grounds for this motion are set forth in the attached memorandum of law, which is fully incorporated herein by reference. In sum, those grounds include: (1) Microsoft’s error in contending that responses were due on May 17, 2007 when the Board suspended the proceedings in its Order dated May 8, 2007; (2) Microsoft cannot allege prejudice; (3) case law supports Applicant’s motion to suspend discovery pending resolution of the motion to dismiss; and (4) the timing of Microsoft’s demand is suspicious, appearing to be used as a litigation tactic,

coming just four days before its response to Applicant's motion to dismiss is due. Furthermore, Applicant possesses no information concerning the two primary reasons to dismiss Microsoft's Opposition: Applicant has no information concerning whether Microsoft can assert priority under the Paris Convention and no information whether Microsoft, in fact, used its mark in commerce on or before July 2006.

Wherefore, Applicant respectfully requests that the Board grant this motion for protective order and motion to stay discovery pending resolution of Applicant's motion to dismiss.

Respectfully submitted,

By: /s/ Mark Tyson Daniel
Mark Tyson Daniel
2316 York Road SW
Roanoke, VA 24015-3906
Applicant, *pro se*

Date: August 31, 2007

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

MICROSOFT CORPORATION,	:	
	:	
Opposer,	:	Opposition No. 91175892
	:	Opposition No. 91175893
	:	
v.	:	
	:	
DANIEL, MARK T.,	:	
	:	
Applicant.	:	

MEMORANDUM IN SUPPORT OF APPLICANT MARK TYSON DANIEL’S MOTION
FOR PROTECTIVE ORDER AND MOTION TO STAY DISCOVERY PENDING
RESOLUTION OF APPLICANT’S MOTION TO DISMISS

BACKGROUND

These consolidated Oppositions were initially filed by Microsoft on February 27, 2007. On April 12, 2007, Microsoft propounded two sets of discovery on Applicant, each set corresponding respectively to the two consolidated Oppositions in these proceedings with each set containing 23 interrogatories, 19 requests for the production of documents, and 11 requests for admission.¹

On August 27, 2007, having made no prior demand since April 12, 2007, Microsoft sent to Applicant a letter, demanding that Applicant submit responses to Microsoft’s interrogatories and document requests by August 31, 2007, four days after the date of its letter, yet four months after propounding the discovery requests in April 2007. In the August 27 letter, Microsoft also asserts that because it has not received responses to its requests for admission, the admissions are therefore “deemed admitted.”

¹ Applicant did not attach to this motion Microsoft’s discovery requests, as permitted by Rule 2.120(j)(8).

Microsoft asserts in its August 27 letter that the discovery requests were due on May 17, 2007, yet Microsoft fails to mention in its letter that on May 8, 2007, in an Order finding that Microsoft's "notices of opposition fail[ed] to present a claim of priority based on 'use analogous to trademark use,'" the Board "suspended" the proceedings.²

ARGUMENT

1. Microsoft asserts incorrectly that discovery responses were due on May 17, 2007

Microsoft is wrong that discovery responses were due on May 17, 2007. Simply put, Microsoft either forgot to, or chose not to, consider the Board's May 8, 2007 Order, suspending the proceedings. Thus, Microsoft should be precluded from making such demands.

2. Microsoft cannot show prejudice

Even if Microsoft is correct that the discovery responses were due on May 8, which they were not, Microsoft's assertion that the requests for admission are deemed admitted is misplaced in light of prior board rulings because policy promotes deciding cases on their merits and because Microsoft cannot allege any prejudice. *See Giersch v. Scripps Networks, Inc.*, 2007 WL 1653585 (TTAB June 6, 2007) (finding party that had "failed to show excusable neglect" after missing discovery deadline following two previous extensions because party *assumed* he would receive a third extension was nevertheless permitted to serve responses to requests for admission). *Id.* at * 3-4.

Microsoft cannot assert any prejudice because, at this stage of the proceedings, no substantive events have transpired, neither party has produced any documents, and Applicant has not even Answered the Oppositions. In *Giersch*, the TTAB noted that because the case was in

² In the May 8 Order, the Board explained that "Opposer has not adequately stated the 'use analogous to trademark use' grounds to support a claim of priority on this basis," noting that "Opposer states that it first used its mark 'on or in July 2006' (paragraph 6). Inasmuch as applicant filed the earliest of its applications on July 16, 2006, opposer must plead use prior thereto or it would not have any use onto which it could tack its later use." (emphasis added).

the pre-trial stage, “any potential prejudice can be mitigated by extending the discovery period as necessary to permit petitioners to take any additional follow-up discovery based on respondent’s amended admissions.” *Id.* at * 4 (adding “petitioners have pointed to no particular prejudice in the form of special difficulties it could potentially face caused by the need to obtain evidence”).

Id.

3. Case law supports suspending discovery pending resolution of a motion to dismiss

There is absolutely no reason for discovery, in this case, to take place at this time; on the other hand, there is every reason to stay discovery pending resolution of Applicant's motion to dismiss. Applicant's pending motion to dismiss has merit. It demonstrates that Microsoft has failed to comply with the Board’s May 8 Order and that Microsoft does not enjoy priority under the Paris Convention.

Pursuant to Fed. R. Civ. P. 26(c),³ the Board may stay discovery upon a showing of “good cause.” The Sixth Circuit, for example, has repeatedly held that “[t]rial courts have broad discretion and inherent power to stay discovery until preliminary questions that may dispose of the case are determined.” *Gettings v. Building Laborers Local 310 Fringe Benefit Fund*, 349 F.3d 300, 304 (6th Cir. 2003) (quoting *Hahn v. Star Bank*, 190 F.3d 708, 719 (6th Cir. 1999)). Moreover, “[I]mitations on pretrial discovery are appropriate where claims may be dismissed ‘based on legal determinations that could not have been altered by any further discovery.’” *Gettings*, 349 F.3d at 304 (quoting *Muzquiz v. W.A. Foote Memorial Hosp., Inc.*, 70 F.3d 422,

³ Fed. R. Civ. P. 26(c) provides, in pertinent part:

Upon motion by a party or by the person from whom discovery is sought, accompanied by a certification that the movant has in good faith conferred or attempted to confer with other affected parties in an effort to resolve the dispute without court action, and for good cause shown, the court in which the action is pending ... may make any order which justice requires to protect a party or person from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the following:

- (1) that the disclosure or discovery not be had;
- (2) that the disclosure or discovery may be had only on specified terms and conditions, including a designation of the time or place; ...

430 (6th Cir. 1995). The Sixth Circuit has consistently held that the pendency of a motion to dismiss which, if granted, would end the case, and therefore obviate the need for discovery, constitutes good cause for staying discovery. *Gettings*, 349 F.3d at 304; *Muzquiz*, 70 F.3d at 430; *Hahn*, 190 F.3d at 719. Obviously then, the stronger the motion to dismiss, the more appropriate it is to enter a stay. *See e.g., Flaim v. Medical College of Ohio*, 418 F.3d 629, 644 (6th Cir. 1999) (upholding the district court’s *sua sponte* stay of discovery because “it was not unreasonable for the district court to conclude that the case could be disposed of on the face of the complaint and that discovery would not affect the outcome.”).

Moreover, a stay of discovery will not prejudice Microsoft. Microsoft asserts that it sent Applicant discovery requests on April 12, 2007, three days *after* Applicant filed its Motion for Suspension; yet, Microsoft did not contact Applicant regarding discovery after the passing of May 17, 2007 – the date Microsoft inaccurately contends the discovery was due. In fact, Microsoft did not contact Applicant on June 17, July 17 or August 17. Microsoft cannot contend that it sought discovery responses with great diligence.

4. Microsoft’s letter is suspicious in light of the timing of the demand

The most likely reason that Microsoft now demands discovery responses, in addition to using it as a strong-arm tactic to cause Applicant the undue burdens and unnecessary costs of responding to discovery, is to shift the focus of these proceedings away from Microsoft’s deficient trademark application that fails to put Microsoft’s German application within the priority umbrella of the Paris Convention and that fails to show that Microsoft first used its mark in commerce before July 2006. Granting Applicant’s motion for protective order and Applicant’s motion to stay discovery will preclude Microsoft from wielding these improper

tactics pending the decision of Applicant's motion to dismiss, and Microsoft will suffer no prejudice.

CONCLUSION

In light of (1) the strength of Applicant's motion to dismiss thus obviating the need for discovery; (2) the lack of prejudice to Microsoft from a stay of discovery; (3) the burdensome and expensive discovery costs Applicant would unnecessarily incur; and (4) the fact that Microsoft appears to be using strong-arm litigation tactics clearly inappropriate in proceedings before an administrative agency, Applicant has shown "good cause" under Fed. R. Civ. P. 26(c) to be granted a protective order and to stay discovery pending resolution of his motion to dismiss. For the reasons set forth above, Applicant Mark Tyson Daniel respectfully requests that the Board grant his Motion for Protective Order and Motion to Stay Discovery Pending Resolution of Applicant's Motion to Dismiss.

Respectfully submitted,

By: /s/ Mark Tyson Daniel
Mark Tyson Daniel
2316 York Road SW
Roanoke, VA 24015-3906
Applicant, *pro se*

Date: August 31, 2007

CERTIFICATE OF SERVICE

I, Mark Tyson Daniel, hereby certify that on this 31th day of August 2007, I caused a true and correct copy of Applicant Mark Tyson Daniel's Motion for Protective Order and Motion to Stay Discovery Pending Resolution of Applicant's Motion to Dismiss to be served via first class U.S. Mail and via electronic mail on counsel for Opposer Microsoft Corporation at the address below:

William O. Ferron, Jr.
Seed IP Law Group
Suite 5400
701 Fifth Avenue
Seattle, WA 98104

/s/ Mark Tyson Daniel
Mark Tyson Daniel

EXHIBIT A.

August 27, 2007

William O. Ferron, Jr.
Direct Line: (206) 694-4832
BillF@SeedIP.com

By Email (mtdesq@hotmail.com)
Confirmation By U.S. Mail

Mr. Mark Tyson Daniel
2316 York Road
Roanoke, Virginia 24015

Re: *Microsoft v. Daniel*
TTAB Opposition No. 91175892
Seed IP Ref. 664005.898

Dear Mr. Daniel:

On April 12, 2007, we served you with copies of Opposer's First Set of Interrogatories, First Set of Requests for Production and First Set of Requests for Admission. Pursuant to the Federal Rules of Civil Procedure and the Trademark Rules of Practice, your responses to these interrogatories and document and admissions requests were due May 17, 2007. To date, we have not received your responses and you have not requested any additional time within which to respond.

The Requests of Admission are therefore deemed admitted pursuant to Trademark Board Manual of Procedure 407.03(a) because you failed to timely respond.

Please provide us, without objection, your complete responses to Microsoft's First Set of Interrogatories and First Set of Requests for Production by no later than August 31, 2007 or we will file a motion to compel.

Please call me as soon as possible if you have questions or wish to discuss this matter.

Very truly yours,

Seed IP Law Group PLLC


William O. Ferron, Jr.

1013841_1.DOC