

ESTTA Tracking number: **ESTTA548284**

Filing date: **07/12/2013**

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

Proceeding	91176065
Party	Plaintiff Lenovo (Singapore) Pte. Ltd
Correspondence Address	STANLEY D FERENCE III FERENCE & ASSOCIATES LLC 409 BROAD STREET PITTSBURGH, PA 15143 UNITED STATES uspto@ferencelaw.com, bmalkin@ferencelaw.com
Submission	Opposition/Response to Motion
Filer's Name	Brian Samuel Malkin
Filer's e-mail	uspto@ferencelaw.com
Signature	/Brian Samuel Malkin/
Date	07/12/2013
Attachments	Opposition.pdf(758563 bytes )

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

In the matter of trademark application Serial No. 78/636,480  
For the mark THINKCP  
Published in the Official Gazette on November 7, 2006

Lenovo (Singapore) PTE Ltd.	)	
	)	Opposition No. 91176065
Opposer ,	)	
	)	
vs.	)	
	)	
H. Co. Computer Products	)	
	)	
Applicant.	)	
<hr/>		
H. Co. Computer Products	)	
	)	
Counterclaimant,	)	
	)	
vs.	)	
	)	
Lenovo (Singapore) PTE Ltd.	)	
	)	
Respondent.	)	
<hr/>		

**OPPOSITION TO APPLICANT'S  
MOTION FOR SANCTIONS**

**INTRODUCTION**

Applicant surprisingly filed a Motion for "Terminating" Sanctions after arranging for a consented Motion to Extend Deadlines to "align" the remaining discovery and trial dates in the related Oppositions involving THINK! MEMORY PRODUCTS (Opp. No. 91200138) and THINK! NETWORKING PRODUCTS (Opp. No. 91200140). (collectively referred to as "other THINK Oppositions"). In essence, Applicant filed this motion while lulling Opposer into the false belief that the parties were still cooperating

and working towards a cost-effective and amicable resolution to this long-standing dispute over the priority of use of THINK as a trademark on hardware. The motion should be denied because it is the result of “hiding the ball”.

Terminating sanctions are within the discretion of the Board. In this case, the circumstances and Applicant’s behavior do not warrant such sanctions. Moreover, the circumstances in this case do not warrant any sanctions. Applicant cannot demonstrate any prejudice because it has all the relevant answers and documents, has had them since February 9, 2011 and has been repeatedly told that there is nothing else to produce. Opposer has hidden nothing in this case.

**1. THE BOARD SHOULD DENY THIS MOTION BECAUSE BY COMMUNICATING ABOUT ALIGNING REMAINING DATES ON THE RELATED CASE APPLICANT LULLED OPPOSER INTO BELIEVING THAT ALL THE CASES WOULD BE GLOBALLY SETTLED WITHOUT THE NEED FOR FURTHER LITIGATION**

Throughout this case, Applicant and Opposer have been engaged in settlement negotiations and Opposer remains hopeful that this case will resolve amicably without the need for further expense and litigation. To that end, the Applicant and Opposer have cooperated in re-setting deadlines in this case and the related Oppositions. (See **Exhibit A**, attached hereto, and incorporated herein by reference). Moreover, granting Termination Sanctions in the context of this case would be unfair and reward Applicant for “hiding the ball”. The issue of “outstanding discovery” was never raised by Applicant despite the cooperative efforts undertaken by the parties. The current motion is even more surprising given that the parties agreed to extend and align the discovery deadlines in the related cases so as to coincide with each other.

Considering Applicant's historical behavior in this litigation, the equities do not warrant the sanctions requested by Applicant. The Board has never sanctioned the type of behavior from which Applicant seeks to benefit. For example, in the case of *Amazon Technologies, Inc. v. Wax*, Opp. No. 91187118) (mailed November 4, 2009) (copy attached hereto as "**Exhibit B**"), the Board specifically refused to reward the behavior of "hiding the ball". In that case, Amazon mistakenly believed that Wax failed to timely serve its Initial Disclosures with the Interrogatories and Requests for Production it served upon opposer. After Amazon provided responses that were merely "boilerplate" objections and after the "meet and confer", Amazon simply cryptically maintained that it had no obligation to respond. The Board rejected Amazon's approach and likened it to "hiding the ball". Like the Opposer in *Amazon*, Applicant has essentially hidden the ball by giving the impression that it was cooperating towards a settlement and then filing this motion. The Board should not reward Applicant's behavior and this motion should be denied.

Another example of Applicant's behavior is seen in how the original motions for extending the deadlines were handled during an earlier motion to compel brought by Applicant.<sup>1</sup> In this case, the prior Interlocutory Attorney called Opposer out for not having the details of the extension of time in writing. Namely, that the parties had stipulated to not serving any more discovery during the extension. This stipulation occurred in each of the consent motions filed by Applicant but Applicant never confirmed that fact though it was of record in each of the consent motions (See for

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<sup>1</sup> Opposer's counsel would welcome the opportunity to discuss this motion with the Interlocutory Attorney and Applicant's counsel to further elucidate the issues and to try to resolve this case and the other related pending oppositions in a global settlement.

example, Docket No. 45 wherein the motion contains the stipulation “As a condition of this extension, the parties agree that they will use this period to complete all outstanding discovery and they will not serve additional discovery requests during this time.”)

Moreover, Applicant has not been prejudiced in any way in this case. All of the documents and answers have been provided long before this. Indeed, the Opposer provided everything to Applicant without any copy charges or other expenses. Thus, Opposer has scrupulously undertaken to comply with all the requirements of the discovery guidelines of this Board and Applicant has been deprived of no information.

**2. THE BOARD SHOULD DENY THIS MOTION BECAUSE APPLICANT HAS NOT BEEN PREJUDICED BECAUSE IT HAS BEEN IN POSSESSION OF RELEVANT, RESPONSIVE DOCUMENTS SINCE FEBRUARY 14, 2011.**

As outlined in Opposer’s February 14, 2011 transmittal letter (**Exhibit C**), Opposer took great care to comply with all the rules of discovery, including Trademark Rule TBMP §414. All of the documents provided to Applicant were carefully Bates Numbered and were correlated to each Request for Production made by Applicant. The Bates Numbers span **LSP 0001** through **LSP 010148**, contain over 10,000 individual pages, including 6,882 confidential pages, are contained in 343 files and 29 folders, and occupy almost 9 GB of hard drive space. In comparison, Applicant produced a mere 744 Bates Numbered pages of which 524 pages comprise a trademark search report.

All of Applicant’s documents were electronically produced at no additional cost to Applicant. (See February 9, 2011 invoice, attached hereto, and incorporated herein as **Exhibit D**). Thus, Opposer had no intention then and has no intention now to surprise or

prejudice Applicant with further documents. To the contrary, all the relevant information is provided, including dates of first use, advertising expenditures, gross revenues, advertising exemplars, price lists, proof of family of marks, third party reviews, and trade channels and consumers. See **Exhibit C** for specific description of categories of documents.

Thus, Opposer has not violated any discovery order because all of the responsive documents have already been produced. See Fed. Rule Civ. Pro. 33(d). Moreover, back when the Board issued its order, Opposer had already produced all of its responsive documents which answered all the salient questions in the case. Applicant has never once complained that it could not find the answers in the documents provided by Opposer. Opposer has had every salient relevant responsive document since February 9, 2011 and has been repeatedly told that there is nothing else to be produced. Opposer has hidden nothing in this case. This case does not warrant the sanctions requested by Applicant.

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**CONCLUSION**

For all of the above reasons, the Applicant's Motion for Sanctions should be denied.

Respectfully submitted,

Dated: 7-12-2013



Stanley D. Ference III  
Registration No. 33,879  
Brian Samuel Malkin  
Registration No. 48,329

FERENCE & ASSOCIATES LLC  
409 Broad Street  
Pittsburgh, PA 15143  
(412) 741-8400 - Phone  
(412) 741-9292 - Facsimile

Attorneys for Opposer  
Lenovo (Singapore) Pte. Ltd.

**CERTIFICATE OF TRANSMISSION AND SERVICE**

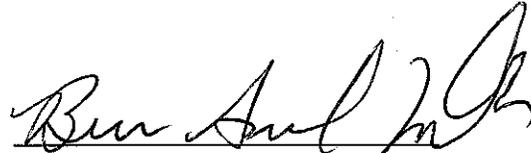
I certify that the foregoing Opposition to Motion for Sanctions is being electronically filed with:

Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

and that the forgoing is being served by first-class mail, postage pre-paid, to:

Raymond R. Tabendeh, Esquire  
Christie Parker & Hale, LLP  
PO Box 7068  
Pasadena, CA 91109-7068  
Attorneys for Applicant

this 12<sup>th</sup> day of July, 2013.



Stanley D. Ference III  
Brian Samuel Malkin

# **EXHIBIT A**

## Brian Samuel Malkin

---

**From:** Steven E. Lauridsen [Steven.Lauridsen@cph.com]  
**Sent:** Tuesday, May 28, 2013 4:28 PM  
**To:** Brian Samuel Malkin; Stanley Ference  
**Cc:** Gary Nelson; Diane Zlatoper  
**Subject:** RE: Lenovo v. HCCP - THINK MEMORY and THINK NETWORKING Oppositions

Thanks, Brian. In duplicating the motions for the other proceedings, I noted that one sentence erroneously mentions discovery dates, but there are no discovery dates listed in the motion since we agreed not to move those dates. I'll delete that sentence so as not to confuse the Board and will file these today.

**From:** Brian Samuel Malkin [mailto:bmalkin@ferencelaw.com]  
**Sent:** Tuesday, May 28, 2013 1:03 PM  
**To:** Steven E. Lauridsen; Stanley Ference  
**Cc:** Gary Nelson; Diane Zlatoper  
**Subject:** RE: Lenovo v. HCCP - THINK MEMORY and THINK NETWORKING Oppositions

Hey Steve,  
I just got to review these dates and the motion looks good. Thanks so much.  
Best regards,  
Brian.

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**From:** Steven E. Lauridsen [mailto:Steven.Lauridsen@cph.com]  
**Sent:** Thursday, May 23, 2013 8:26 PM  
**To:** Brian Samuel Malkin; Stanley Ference  
**Cc:** Gary Nelson; Diane Zlatoper  
**Subject:** RE: Lenovo v. HCCP - THINK MEMORY and THINK NETWORKING Oppositions

Brian

I am attaching a draft motion that would affect the dates for the MEMORY PRODUCTS and NETWORKING PRODUCTS marks. As you can see, we try to avoid the entire summary to account for vacations.

The THINKCP proceeding doesn't require disclosures and has some additional testimony periods because of the counterclaims. We could still align these and have just have the extra periods at the end. Thus the dates would be:

Opposer testimony closes (30 days)	10/24/2013
Defendant/Counterclaimant testimony closes (30 days)	12/23/2013
Counterclaim defendant/Opposer rebuttal (30 days)	2/21/2014
15-day rebuttal period for counterclaimant	4/7/2014

Let me know if this is acceptable, and I will get all three motions on file.

Best regards,  
Steven

**From:** Brian Samuel Malkin [mailto:bmalkin@ferencelaw.com]  
**Sent:** Wednesday, May 22, 2013 10:54 AM  
**To:** Steven E. Lauridsen; Stanley Ference  
**Cc:** Gary Nelson; Diane Zlatoper  
**Subject:** RE: Lenovo v. HCCP - THINK MEMORY and THINK NETWORKING Oppositions

Dear Steve,  
We are amenable to your proposal.  
Could you provide a draft so we can be sure that our vacation schedule is matching up too?  
Thanks for your work on this.  
Best regards,  
Brian.

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**From:** Steven E. Lauridsen [<mailto:Steven.Lauridsen@cph.com>]  
**Sent:** Wednesday, May 22, 2013 1:52 PM  
**To:** Brian Samuel Malkin; Stanley Ference  
**Cc:** Gary Nelson; Diane Zlatoper  
**Subject:** RE: Lenovo v. HCCP - THINK MEMORY and THINK NETWORKING Oppositions

Stand and Brian,

I am writing to follow up on my message below. As I stated, I will be out of the country for the first part of June. In the past, we have moved dates in these proceedings to accommodate Stan's vacation schedule, so I am hopeful that you will extend the same courtesy in this instance. We have delayed filing the papers to align the trial dates because, if we are going to push all dates back, we'd rather do so by filing one set of papers. Please let me know if Lenovo is amenable to adjusting the schedule.

Best regards,  
Steven

**From:** Steven E. Lauridsen  
**Sent:** Friday, May 17, 2013 3:47 PM  
**To:** 'Brian Samuel Malkin'; Stanley Ference  
**Cc:** Gary Nelson; Roxanne Gaines; Diane Zlatoper  
**Subject:** RE: Lenovo v. HCCP - THINK MEMORY and THINK NETWORKING Oppositions

Thanks, Brian, we will prepare the paperwork. In doing so, I noted that the THINKCP deadlines have a lot going on during the summer. I know summers are generally busy for both clients and attorneys, particularly given that a large number of people plan vacations. I'm not sure what Lenovo's availability is, but I think it might make sense to avoid a summer trial in these three matters (I know I for one will be leaving the country soon, and while a the current trial dates are doable, they're not preferable). We can keep all discovery deadlines the same (so, for instance the parties will still serve their responses that are coming due and still produce documents, etc. so that we keep the cases moving), but I would suggest that we move the other pretrial dates. Let me know if you are amenable to this, and if so, we will prepare a proposed schedule for your review.

Also, any update on settlement?

Best regards,  
Steven

**From:** Brian Samuel Malkin [<mailto:bmalkin@ferencelaw.com>]  
**Sent:** Friday, May 17, 2013 5:03 AM  
**To:** Steven E. Lauridsen; Stanley Ference  
**Cc:** Gary Nelson; Roxanne Gaines; Diane Zlatoper  
**Subject:** RE: Lenovo v. HCCP - THINK MEMORY and THINK NETWORKING Oppositions

Dear Steve,

We are not adverse to re-setting to coordinate the cases.

Thanks.

Best regards,

Brian.

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**From:** Steven E. Lauridsen [<mailto:Steven.Lauridsen@cph.com>]  
**Sent:** Wednesday, May 15, 2013 4:30 PM  
**To:** Brian Samuel Malkin; Stanley Ference  
**Cc:** Gary Nelson; Roxanne Gaines  
**Subject:** Lenovo v. HCCP - THINK MEMORY and THINK NETWORKING Oppositions

Stan and Brian,

Quite some time ago, we had agreed to keep the two MEMORY and NETWORKING oppositions running in parallel with the THINKCP opposition. Due to the Board imposed suspension in the THINKCP proceeding, the former two proceeding have advanced well ahead of the latter.

We expect that there will be a good deal of overlapping witnesses, testimony, and evidence for both parties, though some witnesses may need to be questioned on some additional topics in certain proceedings. We therefore propose resetting the dates in the MEMORY and NETWORKING proceedings to align with the THINKCP dates. This will allow us all, without consolidation, to better manage the trial of these cases and, at the appropriate time, to stipulate regarding streamlining the taking of testimony and the introduction of evidence. It will also allow us time to further discuss a global settlement as I know that Brian indicated that a proposal is in the works.

Either way, we still intend to serve our discovery responses by the May 22 due date.

Please let me know your thoughts on the above.

Best regards,  
Steven E. Lauridsen  
Christie, Parker & Hale, LLP  
655 North Central Avenue, Suite 2300  
Glendale, California 91203  
Telephone: (626) 795-9900  
Facsimile: (626) 577-8800

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ESTTA Tracking number: **ESTTA541117**

Filing date: **05/31/2013**

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

Proceeding	91176065
Party	Defendant H. Co. Computer Products
Correspondence Address	STEVEN E LAURIDSEN CHRISTIE PARKER & HALE LLP P. O. Box 29001 GLENDALE, CA 91209-9001 UNITED STATES pto@cph.com, steven.lauridsen@cph.com, gary.nelson@cph.com
Submission	Stipulated/Consent Motion to Extend
Filer's Name	Steven E. Lauridsen
Filer's e-mail	pto@cph.com
Signature	/Steven E. Lauridsen/
Date	05/31/2013
Attachments	AMENDED Consent Mtn to Reset Dates (H644 2) (05 31 2013).pdf(52406 bytes )

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

LENOVO (SINGAPORE) PTE LTD  Opposer,  v.  H. CO. COMPUTER PRODUCTS  Applicant.
H. CO. COMPUTER PRODUCTS  Counterclaimant  v.  LENOVO (SINGAPORE) PTE. LTD.  Counter-Respondent

Opposition No. 91176065

**AMENDED CONSENT MOTION TO RESET AND EXTEND DISCOVERY AND TRIAL  
DATES**

Applicant and Opposer have determined that they need additional time to conduct settlement negotiations and prepare for trial. Applicant filed a motion but included an incorrect date. This amended motion states the date correctly.

The parties believe that resetting and extending the trial dates will afford them adequate time to discuss settlement and further conserve valuable Board resources by avoiding the need to decide this case.

If a settlement is not reached, the parties also wish to align the trial dates in this proceeding and two related proceedings (Opposition Nos. 91200138 and 91200140). These proceedings, while not necessarily appropriate for consolidation, will involve overlapping evidence and testimony. Aligning the trial dates would conserve the parties' resources and assist in creating judicial efficiency.

Accordingly, the parties now jointly so move to set the new dates as follows:

<u>Event</u>	<u>Current</u>	<u>Proposed</u>
30-day testimony period for plaintiff in the opposition to close:	07/29/2013	10/24/2013
30-day testimony period for defendant in the opposition and as plaintiff in the counterclaim to close:	09/27/2013	12/23/2013
30-day testimony period for defendant in the counterclaim and its rebuttal testimony as plaintiff in the opposition to close:	11/26/2013	02/21/2014
15-day rebuttal testimony period for plaintiff in the counterclaim to close:	01/10/2014	04/07/2014

Briefs shall be filed in accordance with trademark Rules 2.128(a)(2).

The grounds for the motion are that the parties need more time for settlement discussions and prepare for trial, and that they would prefer to align the schedules in three related proceedings to conserve resources.

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Opposition No. 91176065

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All parties to this proceeding have provided their express consent for this motion re-setting the dates. Applicant and Opposer have each provided an e-mail address so that any order on this motion may be issued directly by the Board: [pto@cph.com](mailto:pto@cph.com); [uspto@ferencelaw.com](mailto:uspto@ferencelaw.com).

Respectfully submitted,  
CHRISTIE, PARKER & HALE, LLP

Date May 31, 2013

By: /s/ Steven E. Lauridsen

Steven E. Lauridsen  
Attorneys for Applicant  
P.O. Box 29001  
Glendale, California 91209-9001  
626/795-9900

SEL/rg

RG PAS1238145.1-\* -05/31/13 2:35 PM

TRADEMARK  
Docket No. 110.2\*2/H644  
Opposition No. 91176065

**CERTIFICATE OF TRANSMISSION AND SERVICE**

I certify that on May 31, 2013, the foregoing **AMENDED CONSENTED MOTION TO RESET AND EXTEND DISCOVERY AND TRIAL DATES** is being electronically filed with:

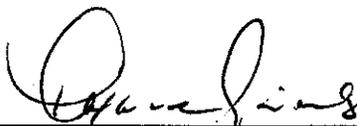
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

It is further certified that on May 31, 2013, the foregoing **AMENDED CONSENTED MOTION TO RESET AND EXTEND DISCOVERY AND TRIAL DATES** is being served by mailing a copy thereof by first-class mail addressed to:

Stanley D. Ference III  
FERENCE & ASSOCIATES  
409 Broad Street  
Pittsburgh, PA 15143  
(412) 741-8400 (telephone)  
(412) 741-9292 (facsimile)  
uspto@ferencelaw.com

Attorneys for Opposer

By: \_\_\_\_\_

  
Roxanne Gaines  
CHRISTIE, PARKER & HALE, LLP  
P.O. Box 7068  
Pasadena, CA 91109-7068  
pto@cph.com

ESTTA Tracking number: **ESTTA540306**

Filing date: **05/28/2013**

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

Proceeding	91176065
Party	Defendant H. Co. Computer Products
Correspondence Address	STEVEN E LAURIDSEN CHRISTIE PARKER & HALE LLP P. O. Box 29001 GLENDALE, CA 91209-9001 UNITED STATES pto@cph.com, steven.lauridsen@cph.com, gary.nelson@cph.com
Submission	Stipulated/Consent Motion to Extend
Filer's Name	Steven E. Lauridsen
Filer's e-mail	pto@cph.com
Signature	/Steven E. Lauridsen/
Date	05/28/2013
Attachments	Consented Motion to Reset & Extend (05 28 2013) H644 2).pdf(50726 bytes )

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

LENOVO (SINGAPORE) PTE LTD.

Opposer,

v.

H. CO. COMPUTER PRODUCTS

Applicant.

Opposition No. 91176065

**CONSENTED MOTION TO RESET AND EXTEND DISCOVERY AND TRIAL DATES**

Applicant and Opposer have determined that they need additional time to conduct settlement negotiations and prepare for trial.

The parties believe that resetting and extending the trial dates will afford them adequate time to discuss settlement and further conserve valuable Board resources by avoiding the need to decide this case.

If a settlement is not reached, the parties also wish to align the trial dates in this proceeding and two related proceedings (Opposition Nos. 91200138 and 91200140). These proceedings, while not necessarily appropriate for consolidation, will involve overlapping evidence and testimony. Aligning the trial dates would conserve the parties' resources and assist in creating judicial efficiency.

Accordingly, the parties now jointly so move to set the new dates as follows:

<u>Event</u>	<u>Current</u>	<u>Proposed</u>
30-day testimony period for plaintiff in the opposition to close:	07/09/2013	10/24/2013
30-day testimony period for defendant in the opposition and as plaintiff in the counterclaim to close:	09/27/2013	12/23/2013
30-day testimony period for defendant in the counterclaim and its rebuttal testimony as plaintiff in the opposition to close:	11/26/2013	02/21/2014
15-day rebuttal testimony period for plaintiff in the counterclaim to close:	01/10/2014	04/07/2014

Briefs shall be filed in accordance with trademark Rules 2.128(a) and (b).

The grounds for the motion are that the parties need more time for settlement discussions and prepare for trial, and that they would prefer to align the schedules in three related proceedings to conserve resources.

All parties to this proceeding have provided their express consent for this motion re-setting the dates. Applicant and Opposer have each provided an e-mail address so that any order on this motion may be issued directly by the Board: pto@cph.com; uspto@ferencelaw.com.

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Opposition No. 91176065

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Respectfully submitted,  
CHRISTIE, PARKER & HALE, LLP

Date May 28, 2013

By: /s/ Steven E. Lauridsen  
Steven E. Lauridsen  
Attorneys for Applicant  
P.O. Box 29001  
Glendale, California 91209-9001  
626/795-9900

SEL/rg

SEL PAS1237702.1-\*-05/28/13 1:46 PM

TRADEMARK  
Docket No. 110.2\*2/H644  
Opposition No. 91176065

**CERTIFICATE OF TRANSMISSION AND SERVICE**

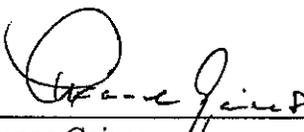
I certify that on May 28, 2013, the foregoing **CONSENTED MOTION TO RESET AND EXTEND DISCOVERY AND TRIAL DATES** is being electronically filed with:

Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

It is further certified that on May 28, 2013, the foregoing **CONSENTED MOTION TO RESET AND EXTEND DISCOVERY AND TRIAL DATES** is being served by mailing a copy thereof by first-class mail addressed to:

Stanley D. Ference III  
FERENCE & ASSOCIATES  
409 Broad Street  
Pittsburgh, PA 15143  
(412) 741-8400 (telephone)  
(412) 741-9292 (facsimile)  
uspto@ferencelaw.com

Attorneys for Opposer

By:   
Roxanne Gaines  
CHRISTIE, PARKER & HALE, LLP  
P.O. Box 7068  
Pasadena, CA 91109-7068  
pto@cph.com

# **EXHIBIT B**

**THIS OPINION IS A  
PRECEDENT OF THE  
T.T.A.B.**

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

MBA

Mailed: November 4, 2009

Opposition No. 91187118

Amazon Technologies, Inc.

v.

Jeffrey S. Wax

**Michael B. Adlin, Interlocutory Attorney:**

This case now comes up for consideration of applicant's fully-briefed motion, filed June 29, 2009, to: (1) compel responses to his first sets of interrogatories and document requests; (2) test the sufficiency of opposer's responses to applicant's first requests for admission; (3) extend the discovery period for applicant only; and (4) enter various sanctions against opposer.

Applicant contends that opposer's responses to applicant's interrogatories, requests for production of documents and requests for admission are inadequate, because opposer served only "boilerplate objections" to the discovery requests, and opposer did not substantively respond to any of applicant's discovery requests. Applicant argues that opposer's objections are "unfounded," especially because many of applicant's discovery requests are

"virtually identical to Discovery requests that Opposer served upon" applicant (emphasis in original). Applicant requests an extension of time so that he may conduct follow-up discovery, and that a variety of sanctions be imposed on opposer, for its "blatant disregard and abuse of the Discovery rules ...."

In its response to the motion, opposer does not dispute that it failed to substantively respond to any of applicant's discovery requests, or that some of applicant's requests were virtually identical to some of the discovery requests which opposer previously served on applicant. Opposer claims, however, that under Trademark Rule 2.120(a)(3), it was not required to respond to any of applicant's discovery requests because applicant failed to serve initial disclosures, which is a prerequisite to serving discovery. In fact, opposer "notes that in its objections to Applicant's Discovery Requests, [opposer] stated that it was exempt from responding (at this time), due to Applicant's failure to comply with the applicable rules."<sup>1</sup> Opposer requests that applicant's motion be denied

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<sup>1</sup> In its General Objections to applicant's first sets of interrogatories, document requests and requests for admission, opposer asserts that the requests "seek the disclosure of information that Opposer is exempt from providing at this time due to Applicant's failure to comply with the applicable rules." However, in its specific objections to applicant's various discovery requests, opposer claims that the requests are "premature, particularly in that Opposer has not completed its factual discovery."

in its entirety, and that when dates are reset, applicant be allowed "the same period of time it had under the prior order, namely, one (1) day remaining in the discovery period."

In his reply brief, applicant claims that he timely served initial disclosures on January 30, 2009, and submits a copy thereof, including the certificate of service indicating timely service on opposer's address of record. Declaration of Theresa Zogakis ¶ 3 and Ex. A to applicant's Reply Brief. Applicant also points out that during the meet and confer process leading up to the filing of applicant's motion, opposer never specified the basis of its "general objections" that applicant failed "to comply with the applicable rules." Indeed, during the meet and confer process, opposer sent a letter to applicant simply arguing that its objections are "valid" and that opposer "is not obligated to provide substantive responses to Applicant's Discovery Requests." However, it appears that opposer never provided a specific reason for withholding substantive responses to applicant's discovery requests, never mentioned applicant's alleged failure to serve initial disclosures during the meet and confer process and failed to raise the issue at all until it filed its response to applicant's motion to compel. In any event, applicant contends that opposer's remedy for applicant's alleged failure to serve

initial disclosures was to file a motion to compel, not to refuse to respond to discovery requests. Finally, applicant claims that he responded to "at least" 800 written discovery requests served by opposer, and that he and a former owner<sup>2</sup> of the subject application appeared for two days of discovery depositions noticed by opposer.

Opposer's claim that it was not required to substantively respond to applicant's discovery requests is based entirely on its mistaken belief that applicant failed to serve initial disclosures,<sup>3</sup> and Trademark Rule 2.120(a)(3), which provides that "[a] party must make its initial disclosures prior to seeking discovery." See, Kairos Institute of Sound Healing, LLC v. Doolittle Gardens, LLC, 88 USPQ2d 1541 (TTAB 2008). In other words, opposer suggests that this is a simple case requiring nothing more than the application of Trademark Rule 2.120(a)(3). It is not that simple, however.

Even if opposer honestly believed that applicant had failed to serve initial disclosures, opposer's apparent conclusion that all it needed to do was relay its understanding to applicant by making an obtuse reference to

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<sup>2</sup> Applicant and another individual filed the subject application as co-applicants, and the other individual eventually assigned his interest in the application to applicant.

<sup>3</sup> While it appears that applicant timely served his initial disclosures, we have no reason to doubt opposer's claim that it did not receive the disclosures even though they were apparently served on opposer's address of record.

applicant's failure to comply with unspecified "rules" fails to recognize that the discovery rules go well beyond Trademark Rule 2.120(a)(3). In fact, the rules impose duties and obligations not only on the party serving discovery, but also the party responding to discovery.

For example, "it is incumbent upon a party who has been served with interrogatories to respond by articulating his objections (with particularity) to those interrogatories which he believes to be objectionable, and by providing the information sought in those interrogatories which he believes to be proper." Medtronic, Inc. v. Pacesetter Systems, Inc., 222 USPQ 80, 83 (TTAB 1984) (emphasis supplied); see also, Fed. R. Civ. P. 33(b)(4) ("The grounds for objecting to an interrogatory must be stated with specificity. Any ground not stated in a timely objection is waived ...") and Advisory Committee Note to 1993 Amendment thereto ("Paragraph (4) is added to make clear that objections must be specifically justified, and that unstated or untimely grounds for objection ordinarily are waived."); Redland Soccer Club, Inc. v. Department of the Army, 55 F.3d 827, 856 (3d Cir. 1995); McLeod, Alexander, Powel & Apffel, P.C. v. Quarles, 894 F.2d 1482, 1485 (5<sup>th</sup> Cir. 1990); St. Paul Reinsurance Co., Ltd. v. Commercial Financial Corp., 198 F.R.D. 508, 514 (N.D. Iowa 2000); Safeco Insurance Co. of America v. Rawstrom, 183 F.R.D. 668 (C.D. Cal. 1998).

In this case, opposer's objections were anything but specific. In fact, opposer made a total of 35 "General Objections" to applicant's interrogatories, document requests and requests for admission, and opposer made 171 "specific" objections to each of applicant's 171 written discovery requests, but opposer never once, in any of these purported general or purportedly "specific" objections, mentioned applicant's alleged failure to serve initial disclosures.

Opposer then compounded the problem by continuing to "hide the ball" during the meet and confer process. For example, in its June 25, 2009 letter to applicant, opposer stated:

We believe that the objections raised in [opposer's] Responses to Applicants' Discovery Requests are valid and that [opposer] is not obligated to provide substantive responses to Applicant's Discovery Requests. However, if you disagree, please advise us which objections you believe are without merit and we will attempt to discuss those issues with you.

Declaration of Jeffrey S. Wax ¶ 7 and Ex. H. When applicant tried to address the objections specifically, opposer "merely restated Opposer's position," but again failed to mention the initial disclosures. Id. ¶ 9. This was improper. See, e.g., Sentrol, Inc. v. Sentex Systems, Inc., 231 USPQ 666, 667 (TTAB 1986) (addressing parties' duties during meet and confer process).

In order for the meet and confer process to be meaningful and serve its intended purpose, "the parties must present to each other the merits of their respective positions with the same candor, specificity, and support during informal negotiations as during the briefing of discovery motions." Nevada Power Co. v. Monsanto Co., 151 F.R.D. 118, 120 (D. Nev. 1993) (emphasis supplied) (construing a local rule containing meet and confer requirements similar to those in Trademark Rule 2.120(e)(1)). The meet and confer process cannot be truly complete until "after all the cards have been laid on the table," by both parties. Id.; see also, Dondi Properties Corp. v. Commerce Savings and Loan Ass'n, 121 F.R.D. 284, 289 (N.D. Tex. 1988) (construing a local rule less onerous than Trademark Rule 2.120(e)(1) and stating "The purpose of the conference requirement is to promote a frank exchange between counsel to resolve issues by agreement or to at least narrow and focus the matters in controversy before judicial resolution is sought.") (emphasis supplied). While it was initially applicant's obligation to confer with opposer prior to filing his motion, opposer was under an equal obligation to participate in good faith in applicant's efforts to resolve the matter.

Here, however, opposer failed to lay its cards on the table. Indeed, it essentially made a litany of boilerplate

objections to all of applicant's discovery requests as a bluff, to disguise its true but unstated objection, and then when applicant called the bluff in the meet and confer process, opposer still failed to lay its cards down, resulting in the filing and consideration of an unnecessary motion to compel.<sup>4</sup> This dispute could and should have been resolved without the necessity of filing a motion to compel.

Opposer's mistaken but apparently honest belief that applicant failed to serve initial disclosures is no excuse. Where a party believes that it need not respond to discovery requests because the propounding party has not served initial disclosures, it has a duty to object, specifically, on that basis. Proceeding as opposer did here, by serving a litany of boilerplate objections and refusing to reveal the true basis for withholding responsive information, only serves to waste the parties' and the Board's time. Cf. Trademark Rule 2.120(d) ("If a party upon which interrogatories have been served believes that the number of interrogatories exceeds the limitation ... the party shall, within the time for (and instead of) serving answers and specific objections to the interrogatories, serve a general

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<sup>4</sup> By offering to "attempt to discuss" certain specific objections with applicant, opposer gave the impression that it might be productive for the parties to discuss particular objections individually, even though opposer knew full well that its refusal to substantively respond to the discovery requests was based on a single, but unstated, argument, i.e., that applicant failed to comply with Trademark Rule 2.120(a)(3).

objection on the ground of their excessive number."); TBMP § 405.03(e) (2d ed. rev. 2004).

In short, because applicant timely served his initial disclosures, and because opposer, even if unaware of those disclosures, failed to specifically state its true objection to applicant's discovery requests, applicant's motion to compel and to test the sufficiency of opposer's responses to applicant's requests for admissions are hereby **GRANTED**. To the extent opposer's various boilerplate objections could be construed as specific to individual discovery requests, they are **OVERRULED**, for two reasons. First, opposer has not even claimed, must less established, that any of applicant's individual discovery requests are objectionable in any specific manner or that any of opposer's boilerplate objections are valid. Second, applicant's discovery requests are in large part identical to requests which opposer served on applicant, and "a party ordinarily will not be heard to contend that a request for discovery is proper when propounded by the party itself but improper when propounded by its adversary." TBMP § 402.01; see also, Sentrol, 231 USPQ at 667; Medtronic, 222 USPQ at 83. Accordingly, opposer is hereby ordered to serve, no later than **THIRTY DAYS** from the mailing date of this order, its

responses, without objection on the merits,<sup>5</sup> to applicant's first sets of interrogatories, requests for production and requests for admission. See, No Fear, 54 USPQ2d at 1551. In the event opposer fails to respond to applicant's discovery requests as ordered herein, opposer may be subject to sanctions, potentially including entry of judgment against it. Fed. R. Civ. P. 37(b)(2); Trademark Rule 2.120(g).<sup>6</sup>

Turning next to applicant's motion for sanctions, it is premature, and therefore will be given no further consideration, because opposer has not, at this point, failed "to comply with an order of the Trademark Trial and

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<sup>5</sup> The Board has previously distinguished objections on the merits of a discovery request from other types of objections:

Objections going to the merits of a discovery request include those which challenge the request as overly broad, unduly vague and ambiguous, burdensome and oppressive, as seeking non-discoverable information on expert witnesses, or as not calculated to lead to the discovery of admissible evidence. In contrast, claims that information sought by a discovery request is trade secret, business-sensitive or otherwise confidential, is subject to attorney-client or a like privilege, or comprises attorney work product, goes not to the merits of the request but to a characteristic or attribute of the responsive information.

No Fear, 54 USPQ2d 1551, 1554 (TTAB 2000).

<sup>6</sup> Of course, to the extent opposer maintains its objections based on the attorney-client privilege or attorney work product doctrine, it must produce a privilege log. Fed. R. Civ. P. 26(b)(5)(A)(ii). Furthermore, opposer must produce allegedly confidential or proprietary information pursuant to the protective order applicable to this proceeding by operation of Trademark Rule 2.116(g).

Opposition No. 91187118

Appeal Board relating to disclosure or discovery.”

Trademark Rule 2.120(g)(1).

Turning finally to applicant's request for an extension of the discovery period for applicant only, there are competing interests at stake. On the one hand, “the Board will, upon motion, reopen or extend discovery solely for the benefit of a party whose opponent, by ... delaying its responses to [d]iscovery, has unfairly deprived the propounding party of the right to take follow-up.” Miss America Pageant v. Petite Productions, Inc., 17 USPQ2d 1067, 1070 (TTAB 1990). Here, there is no question that, as a result of opposer's conduct, applicant's efforts to obtain timely and substantive discovery responses have been stymied. On the other hand, “[i]f a party wishes to have an opportunity to take ‘follow-up’ discovery after it receives responses to its initial requests for discovery, it must serve its initial requests early in the discovery period ...” TBMP § 403.05(a). In this case, applicant did not serve his discovery requests early, and in fact left himself only two weeks after opposer's discovery responses were due in order to conduct follow-up discovery. Under the circumstances of this case, a brief extension of the discovery period for applicant only is warranted, but applicant will not be given more time than he would have had if opposer had timely and properly responded to the discovery requests, and

Opposition No. 91187118

accordingly, applicant's motion for extension is **GRANTED**, to the extent that applicant is allowed two weeks to conduct follow-up discovery, subsequent to the due date for service of the responses opposer has been ordered to provide.

Conclusion

Applicant's motions to compel and to test the sufficiency, and to extend, are granted. Opposer shall respond to applicant's written discovery requests without objection on the merits within **thirty days** of the mailing date of this order. Proceedings herein are resumed and discovery, disclosure, trial and other dates are reset as follows:

Follow-Up Discovery Period for Applicant Only Opens	<b>December 7, 2009</b>
Follow-Up Discovery Period for Applicant Only Closes	<b>December 21, 2009</b>
Plaintiff's Pretrial Disclosures	<b>February 4, 2010</b>
Plaintiff's 30-day Trial Period Ends	<b>March 21, 2010</b>
Defendant's Pretrial Disclosures	<b>April 5, 2010</b>
Defendant's 30-day Trial Period Ends	<b>May 20, 2010</b>
Plaintiff's Rebuttal Disclosures	<b>June 4, 2010</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>July 4, 2010</b>

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# **EXHIBIT C**

PATENTS,  
TRADEMARKS,  
COPYRIGHTS  
AND RELATED MATTERS

LAW OFFICES  
**FERENCE & ASSOCIATES LLC**  
409 BROAD STREET  
PITTSBURGH, PENNSYLVANIA 15143  
WWW.FERENCELAW.COM

TELEPHONE  
(412) 741-8400  
FACSIMILE  
(412) 741-9292

February 14, 2011

**VIA FedEx**

Gary J. Nelson  
Christie, Parker Hale, LLP  
350 West Colorado Blvd., Suite 500  
P.O. Box 7068  
Pasadena, CA 91109-7068

**Re: *Lenovo v. H.Co. Computer Products***  
***Opp. No. 91176065***  
***U.S. Appl. Ser. No. 78/636,480***  
***Our File No. 740.043 THINKCP***

Dear Mr. Nelson,

This letter will serve to supplement our earlier discovery production. As you know, we have now extended discovery for 60 days in order to respond to all outstanding discovery issues. The consent motion ensures that all discovery enclosed is timely served.

Accordingly, enclosed please find a USB Pen Drive containing all of our document production to date. We also enclose Opposer's Objections and Responses to Applicant's First Request for Admissions and Opposer's Opposer's Objections and Responses to Applicant's Second Set of Requests for Production.

We note that we have checked our correspondence files both soft and hard as well as e-mail and have no evidence that you served us with Interrogatories. Nonetheless, we feel that our responses and documents are sufficient and comply with all the rules of discovery, including the Trademark Rules, in particular TBMP §414.

You will note that Bates Numbers LSP-00001-000030 are substitute color copies of the original black and white exhibits bearing the same numbers. Also, in response to your discovery requests, we have produced the following:

Copy of Watch Notice for THINKCP (LSP00031);

Copies of File Wrappers of the relevant marks (LSP-000033 - 001114);

Mr. Nelson  
February 14, 2011  
Page 2 of 3

USPTO records of the relevant marks (LSP-001115-002103);

Selected Copies of Applicant's Web Site Pages (LSP-002238-002241);

Printout from Internet Archive (LSP-002242);

Results from Search of WHOIS database (LSP-002243-002245);

Exemplars of Search results for various THINK products  
on LENOVO's web site (LSP-002249-002317);

Selected Documents from Opposition No. 125,553 (LSP-009248-009942);

Selected Third Party Write Ups for THINK products (LSP-010102-010147);

Selected Results from Search on Google for various THINK products (LSP-002161-002237);

Lenovo Company History (LSP-002246-002248);

**CONFIDENTIAL -TRADE SECRET-COMMERCIALLY SENSITIVE-ATTORNEY EYES**  
comprising 2006 to 2011 Watch Notices (LSP-002319-009064);

Print-Out of Trademark Trial and Appeal Board Docket for Lenovo's opposition  
of THINK marks (LSP-009065-009068);

**CONFIDENTIAL -TRADE SECRET-COMMERCIALLY SENSITIVE-ATTORNEY EYES**  
comprising Settlement Agreements and Amendments (LSP-009117-009247);

Selected Results of Searches (with price lists) for various THINK products on selected  
Lenovo's Retail Partner's web sites (LSP-009943-010101).

Lenovo's Products and Prices Lists for Government purchasers (LSP-0100149-010166).

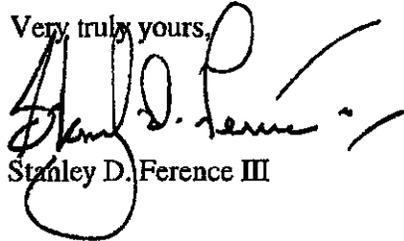
We have also produced **CONFIDENTIAL -TRADE SECRET-COMMERCIALLY SENSITIVE-ATTORNEY EYES ONLY** data.(LSP-0032 and LSP-010148)

Please understand that we continue to reserve the right to continue to supplement our production in accordance with the Rules.

Mr. Nelson  
February 14, 2011  
Page 3 of 3

We trust that we have fairly met all of the issues you raised in your prior letter. We continue to look forward to receiving the documents you have promised to produce.

Very truly yours,

A handwritten signature in black ink, appearing to read "Stanley D. Ference III". The signature is written in a cursive style with a large, prominent initial "S".

Stanley D. Ference III

# **EXHIBIT D**

740.043

**Invoice**



Ditto Document Solutions

610 Smithfield Street  
Suite 200  
Pittsburgh, PA 15222  
412-434-6666

DATE	INVOICE #
2/9/2011	117482

<b>BILL TO</b>
Ference & Associates 409 Broad Street Pittsburgh, PA 15143 Attn: Kate Murray

REFERENCE	TERMS	DUE DATE	JOB #	BUYER
740.043	Net 30	3/11/2011	82563	Kate Murray
QUANTITY	DESCRIPTION	RATE	AMOUNT	
10,115	Electronic Bates Labeling	0.02	202.30T	
1	DVD Master	25.00	25.00T	
6,882	Confidential Endorsing	0.01	68.82T	
	Sales Tax	7.00%	20.73	
			<b>Total</b>	<b>\$316.85</b>

