ESTTA Tracking number: **ESTTA286921**
Filing date: **06/01/2009**

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

Proceeding	91179480
Party	Plaintiff Plasti-Fab Ltd.
Correspondence Address	David E. Sipiora Townsend and Townsend and Crew LLP 1400 Wewatta Street, Suite 600 Denver, CO 80202 UNITED STATES denverteas@townsend.com, desipiora@townsend.com
Submission	Reply in Support of Motion
Filer's Name	Shelley B. Mixon
Filer's e-mail	denverteas@townsend.com
Signature	/sbm/
Date	06/01/2009
Attachments	2009 0601 Reply re Motion for Default Judgment.pdf (8 pages)(354242 bytes)

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

In re: Application Ser. Nos. 79/023,935 and 79,023,934
Published: August 7, 2007, in the Official Gazette
Mark: **GEOSPEC and ACERA GEOSPEC (and design)**
Filed: March 30, 2006

PLASTI-FAB, LTD.,

Opposer,

v.

Consolidated Opposition Nos. 91179480 (parent) and 91179842

KOBELCO CONSTRUCTION MACHINERY CO., LTD.

Applicant.

OPPOSER PLASTI-FAB'S REPLY IN SUPPORT OF MOTION FOR DEFAULT JUDGMENT AND PERMISSION TO FILE FOR SUMMARY JUDGMENT OUTSIDE OF THE DISCOVERY PERIOD

Opposer hereby files its reply in support of Opposer Plasti-Fab's Motion for Default Judgment And, In the Alternative, For Permission to File Motion for Summary Judgment Outside the Discovery Period ("Motion").

I. Applicant Has Willfully Evaded Discovery in This Proceeding and Continues to Disobey the Board's Orders, For Which it Offers No Explanation.

In seeking relief from its inexcusable failure to respond to discovery and its defiance of a Board Order, Applicant has come nowhere close to providing a legally sufficient justification for its omissions. As shown in the Motion, Applicant repeatedly has failed to participate in discovery in this proceeding. The very day its first discovery responses were due in October 2008, without any attempt to seek the consent of Opposer, Applicant filed a request for a 30-day

extension to respond (Omission #1).[1] *See* Motion of 10/7/08. Even after filing its unilateral motion, however, Applicant failed to respond to the discovery requests by the extended deadline of November 6, 2008, *that it requested.* (Omission #2). Not having received any discovery responses from Applicant according to the time set in the rules, or even on Applicant's requested time table, Opposer incurred the expense of preparing and filing a Motion to Compel. (*See* Renewed Motion to Compel of 11/26/08.) Applicant then failed to respond to that motion. (Omission #3). After the Board issued an Order compelling Applicant to provide discovery responses "without objection," (*see* Order of 1/27/09), Applicant ignored the Order and failed to provide any responses. (Omission #4). After the Board issued a second Order, Applicant finally provided some responses, but in violation of the Board's Order, loading its response with many objections. (Omission/violation #5). Thus, on at least five separate occasions, Applicant has failed to respond to the outstanding discovery requests, has failed to indicate that it *intends* to respond to discovery requests, or has ignored the Board's Orders.

It is fair to say that Applicant has made a mockery of the Opposition process and has done so with indifference. It is also fair to say that Applicant's repeated violation of the Rules and this Board's Orders has come at substantial expense to Opposer. Specifically, Opposer has incurred expense in terms of time and money filing motions and chasing discovery from Applicant. In its First Order, the Board noted that "opposer is free to file a motion for entry of default judgment" if Applicant failed to comply with the Order. In view of Applicant's repeated disobedience, Opposer filed this motion for default judgment.

In responding to the Motion, Applicant offers *no justification for any of these omissions or violations.* Instead, Applicant seeks to rely on the Board's second Order (Order of 3/9/09) –

[1] The rules provide that the "time for responding to a request for discovery may be extended or reopened by stipulation of the parties, or on motion ... granted by the Board, or by order of the Board." 37 C.F.R. § 1.120(a).

the purpose of which is not apparently clear – for legitimizing its untimely discovery responses. However, by the time of the Board's second Order, Applicant already had failed to serve discovery responses, failed to comply with the extended discovery deadline, failed to respond to a motion to compel, and failed to comply with a Board order compelling discovery. Given its misconduct, Applicant should not be heard to claim compliance with the rules and procedures of this forum as the basis for denial of the relief sought in the Motion. Applicant owed much more, such as an explanation or attempt to offer justification for its behavior, yet none has been provided.

Moreover, while technically providing written responses by the deadline of the Second Order, Applicant's responses still are in violation of the Order. First, Applicant proffers objections that go to the merits of the requests. *See* Exhibit A and B of Opposer's Motion; TBMP §527.01(c). Such objections are not proper in view of the Board's Orders requiring responses "without objections."[2] *See* Orders of 1/27/09 and 3/9/09. Applicant's recent supplementation to its interrogatory responses (filed in conjunction with its opposition to this Motion) make similar objections. Second, Applicant objects based on the absence of a protective order to requests for which a protective order cannot reasonably be required, such as those that seek public information or documents.[3] Third, Applicant does not indicate for any document

---

Thus, the mere filing of a unilateral motion to extend did not stay the deadline for Applicant to respond to discovery.

[2] Applicant cites *Elec. Indus. Assoc. v. Potega*, 50 U.S.P.Q.2d 1775 (T.T.A.B. 1999) for the proposition that default judgment is not an appropriate sanction when a requesting party disagrees with the objections of the responding party. However, the *Potega* case is distinguishable because the request for sanctions in that case was based solely on improper objections. In addition, the defendant was *pro se* and the pro se defendant *timely responded* to the Board's order compelling discovery. In this case, the motion for sanctions is based on Applicant's repeated failures to respond to discovery, including a Board order compelling the discovery. Further, Applicant is represented by counsel and has been throughout this proceeding.

[3] *See* Exhibits A and B to Opposer's Motion at ROG 7 (date of first use of the mark), ROG 14 (advertising methods used by Applicant), ROG 15 (websites that display or use the Mark), ROG 16 (geographic areas in which the Mark is being used and dates of such use), ROG 17 (channels of trade), ROG 25 (third party uses of GEOSPEC), RFP 5 (documents showing use of Mark), RFP 11 (documents concerning trademark applications and registrations), RFP 12 (documents showing state or county name filings that incorporate GEOSPEC), RFP 19 (documents showing

request that it intends to produce responsive documents. While Applicant has recently produced 10 pages of documents, it has not supplemented its production to produce all responsive documents or to indicate that such documents do not exist (*e.g.*, documents regarding advertising, channels of trade, etc.) Thus, Applicant's responses that allegedly comply with the Board's second order incorporate further evasion and/or delay tactics and do not constitute complete responses.[4]

Hence, the fact that Applicant now has condescended to respond to Opposer's Motion and even recognize the Board's Orders is far from adequate justification to save Applicant from entry of judgment by default. It was Applicant who invoked the authority of the U.S. Patent and Trademark Office in seeking registration of its two alleged marks. Having flaunted the authority of the Board at every turn, and having shirked its responsibilities in these proceedings, Applicant should not now be allowed to avoid the consequences of its actions. Under TMBP Section 527.01(a), given this set of facts, the only appropriate order is entry of an order of judgment by default.

II. Applicant Should Not be Relieved From Its Admissions.

In its renewed motion to compel, Opposer noted that its Requests for Admissions Nos. 1-20 were deemed admitted pursuant to Applicant's failure to respond. *See* Motion of 11/26/08 (citing TBMP § 527.01(d)). Subsequently, the Board confirmed *twice* that the Requests for Admissions were deemed admitted. *See* Orders 1/27/09 and 3/9/09 ("Any unanswered requests

---

publication of the Mark), and RFP 22 (documents showing third party use of GEOSPEC). Tellingly, in response to Opposer's motion for default judgment, still with no protective order in place, Applicant provided some substantive supplemental responses to these same requests, showing that a protective order was not necessary for a response. Applicant provides no explanation why these substantive response were not produced earlier in alleged compliance with the Board's second order.

[4] Opposer would like to clarify that, contrary to its prior statement that Applicant failed to provide a substantive response to any discovery request in its April 8, 2009, responses (Motion at 2), Applicant did provide minimal responses on a handful of requests. However, this fact has little to no bearing on Opposer's motion for default

for admissions are hereby deemed admitted.") Thus, Applicant had three separate occasions to object to the deemed admissions and did not do so.

Now, when faced with a demand for default judgment, Applicant requests that the Board accept the responses it served on April 8, 2009. *See* Response at 3. To the extent this constitutes a request to have the deemed admissions withdrawn, the request is insufficient under TBMP §§ 525 and 502.02(a) which require a motion for the withdrawal of admissions. *See also* Fed. R. Civ. P. 36(b) (admission is "conclusively established unless the court, *on motion*, permits the admission to be withdrawn or amended") (emphasis added). Furthermore, Applicant has provided no explanation for its failure to timely serve responses, much less why any such explanation would constitute "excusable neglect." *See* TBMP § 525.[5] To permit Applicant's untimely responses to the admissions now would reward Applicant (additional time to respond) at Opposer's expense (forced to file a motion to compel and further delay). Having (a) not cared enough to provide responses in a timely manner, (b) failed to respond to a motion to compel, (c) ignored this Board's Orders, and (d) ignored the rules on how it might possibly seek to save itself from its bad faith behavior (*i.e.*, by filing a proper motion under the rules), it would be a travesty to allow Applicant to redeem itself now and reverse the Board's past rulings on the admissions based on such a tardy and feeble effort by Applicant. Opposer respectfully requests that Applicant's request be denied.

---

judgment because such responses were still not timely in view of the Board's January 27, 2009, order and are inadequate for the reasons discussed herein.

[5] Applicant's reliance on *Johnston Pump/Gen. Valve Inc. v. Chromalloy Am. Corp.*, 13 U.S.P.Q.2d 1719 (T.T.A.B. 1989) is misplaced. In *Johnston*, the Board permitted the withdrawal of a *single* admission of the opposer when the opposer discovered facts during the discovery period that were contrary to the admission. Here, Applicant failed to respond to twenty (20) Requests for Admission. It was not an error or a recent discovery which spurred Applicant's desire to seek relief. Applicant had all the available information on which to answer the requests for admission, yet failed to timely do so. Further, the Board held that because the *Johnston* case was still "in the pre-trial stage..., prejudiced can be avoided or mitigated. A more restrictive standard applies to relieving a party of an admission when the case is in the trial phase." *Id.* The trial stage of the proceedings, began on April 8, 2009, with the opening

IV. Conclusion

Applicant has only trickled out discovery responses Opposer sought in September 2008, and has done so only after the entry of an order compelling discovery and when facing a motion for default judgment. The discovery produced continues to be inadequate. Such conduct constitutes an abuse of and disrespect for this opposition process and the authority of the Board, and has resulted in the unnecessary waste of the Board's and Opposer's resources and time. Applicant has not shown that a lesser remedy would be effective in obtaining full and complete discovery and without prejudicing Opposer. And, even now, Applicant has offered not a shred of justification for its bad faith conduct.

In view of the foregoing, Opposer respectfully requests the entry of an order of default judgment be entered against Applicant. While this Motion contains a request, in the alternative, for leave to file a motion for summary judgment outside of the discovery period (and a stay of all deadlines pending disposition of such motion), it is apparent from Applicant's response that this alternative request is not necessary. Default judgment is the only appropriate remedy for Applicant's behavior, particularly in light of the Board's lack of statutory authority to enter monetary sanctions.

Respectfully submitted,

Dated: June 1, 2009

By: Shelley B. Mixon

David E. Sipiora
Shelley B. Mixon
Townsend and Townsend and Crew LLP
1400 Wewatta Street, Suite 600

---

of Opposer's testimony period. Applicant seeks relief from its admissions far too late to avoid imposing severe prejudice on Opposer.

Denver, Colorado 80203
Telephone: (303) 571-4000
Facsimile: (303) 571-4321
Attorneys for Opposer Plasti-Fab, Ltd.

CERTIFICATE OF SERVICE

I hereby certify that on June 1, 2009, I served the foregoing **OPPOSER'S REPLY IN SUPPORT OF MOTION FOR DEFAULT JUDGMENT AND, IN THE ALTERNATIVE, FOR PERMISSION TO FILE MOTION FOR SUMMARY JUDGMENT OUTSIDE OF THE DISCOVERY PERIOD** on counsel for Applicant by depositing a true and correct copy of the same with the United States Postal Service, first class mail, postage prepaid, in an envelope addressed to:

Bassam N. Ibrahim
Buchanan, Ingersoll & Rooney, PC
1737 King Street, Suite 500
Alexandria, Virginia 22314-2727

Kara E. Fulder

61949905 v3