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

Proceeding	91180471
Party	Plaintiff Marc Vianello
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Submission	Motion for Summary Judgment
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Signature	/Arthur K. Shaffer/
Date	06/11/2009
Attachments	summaryjudgment.pdf ( 14 pages )(2563220 bytes ) Exhibit A.pdf ( 110 pages )(152045 bytes ) Exhibit B.pdf ( 2 pages )(39981 bytes ) Exhibit C.pdf ( 6 pages )(32627 bytes ) Exhibit D.pdf ( 23 pages )(345085 bytes ) Exhibit E.pdf ( 3 pages )(844692 bytes ) Exhibit F.pdf ( 1 page )(312364 bytes ) Exhibit G.pdf ( 4 pages )(1475582 bytes ) Exhibit H.pdf ( 3 pages )(1008946 bytes ) Exhibit I.pdf ( 3 pages )(250496 bytes ) Exhibit J.pdf ( 7 pages )(1028903 bytes ) Exhibit K.pdf ( 3 pages )(214543 bytes ) Exhibit L.pdf ( 7 pages )(22058 bytes ) Exhibit M.pdf ( 3 pages )(108098 bytes ) Exhibit N.pdf ( 4 pages )(78805 bytes ) Exhibit O.pdf ( 4 pages )(140345 bytes ) Exhibit P.pdf ( 3 pages )(25483 bytes )

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

MARC VIANELLO	)	
	)	Opposition No. 91180471
Opposer,	)	
v.	)	Mark: JUDICIAL REVIEW
	)	
SANDRA L. NUDELMAN,	)	
	)	
Applicant.	)	

**OPPOSER’S MOTION FOR SUMMARY JUDGMENT**

Opposer, Marc Vianello (“Opposer” or “Vianello”), through his undersigned counsel, hereby moves pursuant to Federal Rule of Civil Procedure 56 and Trademark Rule 2.127 for entry of summary judgment in his favor in this Opposition proceeding on the grounds that the JUDICIAL REVIEW mark depicted in Application Serial No. 77/110,266 (the “Application”) by Applicant Sandra L. Nudelman (“Applicant”), is likely to be confused with Vianello’s THE JUDICIAL VIEW marks in U.S. Registration No. 3402464 and Serial No. 77/212,172 (hereinafter, collectively, “Vianello’s Marks”), in violation of § 2(d) of the Lanham Act, 15 U.S.C. § 1052(d); and that Applicant has refused to comply with the Opposer’s right to discovery during Opposition and several Motions to Compel Discovery.

**I. STATEMENT OF UNDISPUTED FACTS**

**A. The Parties**

Marc Vianello is the founder and head officer of The Judicial View, LLC (“TJV”). TJV is engaged in, among other things, the business of online publication of categorized summaries of recent court decisions, categorized articles regarding the law, people, and entities of interest to the legal profession, and to provide a means for the exchange of ideas regarding the foregoing in

connection with Vianello's Marks. Vianello's Marks are registered for goods and services under International Classes 038 and 041 for newspaper publication, providing on-line publications in the nature of publication of text and graphics in the field of law, classified advertising, display and text advertising, law review, legal case summaries, feature articles, current events, civil rights, finance and banking, communications, immigration, education, politics, administrative law, agriculture, intellectual property, antitrust, bankruptcy, civil procedure, civil remedies, commercial contracts, computer/technology, conflicts at law, constitutional law, criminal justice, corporate/shareholder law, employment law, energy/utilities, environmental law, expert witness, family law, health, immigration, international law, lost profits, maritime/marine, military, products liability, professional malpractice, real and personal property, securities law, federal, state and local taxation, torts/personal injury, veterans, wills/trusts/estates, sports, entertainment, art, government, insurance, transportation, business valuation, alternative dispute resolution and topics of general public and legal interests; on-line journals, namely, blogs featuring topics of general public and legal interests; and providing e-mail notification alerts of recent court decisions to others. *See* U.S. Registration No. 3402464 and Serial No. 77/212,172. TJV began using Vianello's Marks as early as September 2007, and these marks have been continuously used in the United States since that time. TJV has used and continues to use THE JUDICIAL VIEW mark as the dominant component of its trademarks, and THE JUDICIAL VIEW mark has acquired fame and distinctiveness of great value to TJV.

Applicant, a Boston, Massachusetts individual, is in the business of providing a database of judicial decisions and services to track and trend of the data therein. *See* Deposition of Sandra L. Nudelman, attached as Exhibit A at 10: 6-8. JUDICIAL REVIEW has been described as "a legal research service tool that could be used to help attorneys optimize their litigation strategies

through judicial opinion analysis.”<sup>1</sup> See *Washington University News*, <http://law.wustl.edu/news/index.asp?id=5674>, April 2007. (Attached as Exhibit B). Nudelman has applied for registration in “background investigation and research services” and “legal services,” without restriction. See Serial No. 77/110,266. (Attached as Exhibit C). These services overlap Opposer’s marks which include, but are not limited to, providing legal case summaries, articles in the field of law, and court decisions.

**B. Procedural History**

On February 18, 2007, Applicant filed an intent-to-use trademark registration application for the mark JUDICIAL REVIEW under International Class 045 for “background investigation and research services” and “legal services” with the USPTO. See Serial No. 77/110,266. The USPTO sent Applicant a Notice of Publication on July 25, 2007 to be published August 14, 2007. On September 6, 2007, Opposer timely filed in opposition requesting an extension of time. That same day, an extension of time for opposition was granted. This Opposition was filed and instituted on October 31, 2007. On December 10, 2007, Applicant answered Opposer, denying the allegations set forth in the Notice of Opposition. From April 14, 2008 to June 19, 2008, Opposer made several attempts to obtain discovery from Applicant. On April 14, 2008, Opposer served Applicant with Opposer’s First Set of Interrogatories (attached as Exhibit D), and Opposer’s First Set of Document Requests (attached as Exhibit E). On April 19, 2008, Opposer served Applicant with Notice of Deposition, designated to occur on May 15, 2008. On May 7, 2008, Applicant faxed Opposer’s counsel and informed them that she would be unavailable for deposition on May 15, 2008 and would have to reschedule. (Attached as Exhibit F.) On May 27, 2008, Applicant, by letter, contended that Opposer’s discovery requests were

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<sup>1</sup> Michelle Nudelman, Applicant’s sister, attended Washington University School of Law and helped develop the business plan that eventually became “Judicial Review.”

improper and therefore was unwilling to provide discovery. (Attached as Exhibit G). That same day, Opposer's counsel responded to Applicant's contentions, informing Applicant that her unwillingness to provide discovery was baseless as the law which she cited was inapplicable. (Attached as Exhibit H). On June 2, 2008, Applicant responded to Opposer's letter, via facsimile, of May 27, 2008, and stated that she would not be participating in Opposer's deposition. (Attached as Exhibit I). In addition to Applicant's refusal to attend Opposer's deposition, Applicant failed to properly respond to Opposer's First set of Interrogatories, (attached as Exhibit J) and Opposer's First Set of Document Requests (attached as Exhibit K). Applicant's responses to these discovery requests were minimal and insufficient with no documents produced whatsoever. On June 19, 2008, Opposer filed his Combined Motion to Compel and Motion to Extend Discovery and Trial Dates (attached as Exhibit L). The TTAB granted Opposer's Motion on August 6, 2008 and reset trial dates at that time (attached as Exhibit M).

Subsequently, on August 29, 2008, Applicant finally made herself available for deposition pursuant to the August 6, 2008 Order of the TTAB. During the deposition, Applicant provided contradicting responses. In addition, Applicant stated there were documents available for production. *See*, Exhibit A 14-16; 19; 90. Opposing Counsel made a request for these documents on the record. *See*, Exhibit A 14:22; 15:17; 16:12; 19-20; 90:8. On September 24, 2008, Opposer made a follow up request for documents (attached as Exhibit N). To date, no documents have ever been produced in response to these requests, or any other discovery request. On October 9, 2008, Opposer filed a Second Motion to Compel Discovery (attached as Exhibit O). On October 21, 2008, Opposer filed a Second Amended Motion to Compel, clarifying the October 9 filing (not attached). On December 31, 2008, the Interlocutory Attorney

granted the Second Motion to Compel based upon Applicant's refusal to comply with discovery, giving the Applicant thirty days to respond in full (attached as Exhibit P). To date, Applicant has demonstrated a complete disregard for the Orders of the TTAB and Opposer's discovery requests.

## II. ARGUMENT

### A. The Standard for Granting Summary Judgment

A party seeking summary judgment must "show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c); see also *Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986). Opposer bears the initial burden of demonstrating the absence of any genuine issue of material fact. See, *Celotex*, 477 U.S. at 323 (1986); *Sweats Fashions, Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 1563, 4 USPQ2d 1793, 1796 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. See, *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 850, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 202, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

In this case, Applicant has failed to provide any evidence to dispute any factual statement of Opposer. While the evidence on summary judgment must be viewed in a light most favorable to the non-movant, here Applicant has introduced none. *Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 767, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA, supra*. When an Applicant withholds evidence, "it cannot ... rely upon such withheld evidence, if any there be, as a basis for claiming the presence of a disputed issue of material fact so as to defeat summary

judgment.” *Monoplastics, Inc. v. Caldor*, 264 F.Supp. 57 (D. Conn. 1966), 153 USPQ 328, affirm’d. 328 F.2d 20, 153 USPQ 826 (1967).

The threshold inquiry on a motion for summary judgment is whether there are disputes over any factual issues. If there are none, then the motion is ripe for consideration. *See, Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 250 (1986) (noting that without sufficient evidence favoring the nonmoving party from which a jury could return a favorable verdict, there is no issue for trial and a motion for summary judgment is proper). In deciding whether triable issues of fact exist, the Court must view the underlying facts and draw reasonable inferences in favor of the non-moving party. *See, Matsushita Elec. Indus. Co., Ltd. v. Zenith Radio Corp.*, 475 U.S. 574, 587 (1986). Here, the Applicant provided the Opposer with no documents in response to any discovery request; the Applicant’s response to Opposer’s seventeen (17) interrogatories was a mere five (5) pages long, which simply denied the existence of any documents or evidence. (*See*, Exhibit J). Additionally, Applicant produced no other evidence in this proceeding to dispute any of Opposer’s contentions and assertions. Applicant produced nothing to dispute Opposer’s claim of confusion, nothing to dispute Opposer’s claim of similarity, and nothing to dispute Opposer’s claim of overlapping channels of trade. While Opposer has presented a prima facie case opposing Applicant’s registration, Applicant has failed to present any evidence to challenge or in any way refute Opposer’s pleadings. In addition, Opposer has expended substantial time, effort, and money during this proceeding, only to be encumbered by Applicant’s constant and deliberate refusal to adequately and fairly respond. Accordingly, because there is no factual dispute of Applicant’s prima face opposition, summary judgment should be entered against the Applicant.

**B. Failure to Comply With Board Orders**

This Opposition was instituted over a year and a half ago, and to date, Opposer has only been able to obtain one set of insufficient interrogatory responses and one set of document request responses (which denied the existence of discovery documents). In addition, after several requests and motions to compel, Opposer was finally able to depose Applicant three full months after the original deposition date, in which Applicant gave contradictory responses.

Applicant has presented absolutely no evidence, through discovery or otherwise, regarding any actual use of the JUDICIAL REVIEW mark. Applicant indicated in her response to Opposer's document requests, under oath and notary seal, that no documents existed. (*See*, Exhibit J). However, during deposition, Applicant contradicted herself, admitting to having documents that were requested by Opposer's first document request. *See*, Exhibit A 14-16; 19; 90. Despite Opposer making a request on the record for the identified documents during deposition, and following up with a second request for documents, Applicant has continued to refuse to respond and otherwise participate in the discovery process. Concurrent with this Motion for Summary Judgment, Opposer has filed a Motion for Entry of Judgment as Discovery Sanctions for Failure to Comply with Discovery Order. Since Applicant has failed to introduce any evidence in support of her claim, she has failed to factually refute any claim made against her by the Opposer. Accordingly, summary judgment should be entered against the Applicant.

**C. No Genuine Issues of Fact Exist Regarding Likelihood of Confusion Created by Applicants Mark**

Even though Applicant has refused to comply with the TTAB Orders in this case, the evidence on the record supports Opposer's claim that Applicant's mark is likely to cause confusion. Section 2(d) of the Trademark Act provides that the Trademark Office may refuse registration of any mark that so resembles the mark of another that it is likely to cause confusion,

mistake, or deception. 15 U.S.C. § 1502. Courts evaluate a likelihood of confusion under Section 2(d) by weighing the relevant factors identified in *In re E.I. DuPont de Nemours & Co.*, 177 USPQ 563, 567 (C.C.P.A. 1973). *In re Majestic Distilling Co., Inc.*, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). Not all of the *DuPont* factors may be relevant or of equal weight, and the likelihood of confusion analysis may turn on dispositive factors such as similarity of the marks and relatedness of the goods. *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002).

The likelihood of confusion analysis ultimately weighs the similarity or dissimilarity of the marks in their entireties, but the analysis places greater weight on dominant features of the marks. *Herbko Int'l*, 64 USPQ2d at 1380; *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 218 USPQ 390, 395. The likelihood of confusion analysis focuses on the marks and goods described in the Opposer's applications and registrations and the Applicant's application. *Hewlett-Packard Co. v. Packard Press, Inc.*, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) ("The identification of goods/services statement in the registration, not the goods/services actually used by the registrant frames the issue."). Here, each of the relevant *DuPont* factors irrefutably weighs in favor of a likelihood of confusion.

Particularly probative are the similarity of the marks; similar services; and the similar, if not identical trade channels. The marks at issue are almost identical - THE JUDICIAL VIEW and JUDICIAL REVIEW; the channels of trade both include attorneys and other legal professionals; and both services include publication and research. As demonstrated below, an examination of the relevant *DuPont* factors demonstrates that no material questions of fact

remain and no reasonable finder of fact could ignore the likelihood of confusion between Applicant's JUDICIAL REVIEW mark and Opposer's THE JUDICIAL VIEW mark.

**1. The Common Use of JUDICIAL and VIEW in Opposer's and Applicant's Marks Creates an Overall Similarity for the Marks as a Whole.**

The first *DuPont* factor is the similarity or dissimilarity of the marks in their entireties as to the appearance, sound, connotation, and commercial impression. *Majestic Distilling*, 65 USPQ2d at 1203. Marks should be compared in the ordinary way in which prospective customers would be exposed to the marks, and a side-by-side comparison is not appropriate when the marks do not appear side-by-side in the marketplace. *Spoons Rest., Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991). When marks would appear on visually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines. *Century 21 Real Estate Corp., v. Century Life of America*, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Hard Rock Cafe Int'l (USA), Inc., v. Elsea*, 56 USPQ2d 1504, 1521 (TTAB 2000).

Further, when a particular feature or word in a mark is dominant, similarities in the dominant part are given greater weight in the likelihood of confusion analysis. *Kangol Ltd. v., Kangaroos U.S.A., Inc.*, 23 USPQ2d 1945, 1946 (Fed. Cir. 1992); *Giant Food*, 218 USPQ at 395.

Here, the opposed mark is JUDICIAL REVIEW. JUDICIAL is the first and most prominent word in both the Applicant's JUDICIAL REVIEW mark and the Opposer's THE JUDICIAL VIEW mark. *See Palm Bay Imports, Inc. v. Veuve Cliquot Ponsardin*, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (finding confusion regarding VEUVE when it is the first and most prominent word in both marks VEUVE CLICQUOT and VEUVE ROYALE). On its face, Applicant's mark is almost identical to Opposer's; both marks are in typed form and the word

portions JUDICIAL and VIEW are dominant in both marks. In addition, applicant's mark contains a mere two letters more – “RE” in REVIEW – for identical if not overlapping services. During the deposition, the Applicant even admitted that she thought the term “JUDICIAL REVIEW” would be better suited for a newspaper publication, which is covered by Opposer's mark. See, Exhibit A 55:2-4. Furthermore, JUDICIAL REVIEW and THE JUDICIAL VIEW are almost phonetically identical and pronounced the same.<sup>2</sup>

There can be no doubt that given the strong similarities between the two marks, confusion is likely. See *G.D. Searle & Co. v. Chas. Pfizer & Co.*, 265 F.2d 385, 387, 121 USPQ 74, 76 (7th Cir. 1959), cert. denied, 361 U.S. 819, 80 S. Ct. 64, 4 L. Ed. 2d 65 (1959) (BONAMINE is phonetically similar to DRAMAMINE as they contain the same number of syllables, they have the same stress pattern, with primary accent on the first syllable and secondary accent on the third, and the last two syllables are identical); *Crown Radio Corp. v. Soundsciber Corp.*, 506 F.2d 1392, 184 USPQ 221, 223 (CCPA 1974) (CROWNSCRIBER held confusingly similar to SOUNDSCRIBER); and *Hoffman-La Roche Inc. v. Knoll Pharm. Co.*, 167 USPQ 183, 185 (TTAB 1970) (TARUXAN and TARACTAN, both coined terms comprising the same number of syllables, bear a strong resemblance in sound). Accordingly, the first *DuPont* factor weighs in favor of a likelihood of confusion and in favor of summary judgment.

## **2. Opposer's and Applicant's Services are Identical**

The second *DuPont* factor is the nature and similarity or dissimilarity of the goods or services on which the marks are used. Consideration of this, and the other *DuPont* factors,

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<sup>2</sup> The Merriam Webster Dictionary pronunciation guide for the term “review” is \ri-'vyü\ while the term “view” is \vyü\ - they have both phonetically and alphabetically identical base structures. “view.” Merriam-Webster Online Dictionary. 2008. Merriam-Webster Online. 1 June 2009 <<http://www.merriam-webster.com/dictionary/view>>. “review.” Merriam-Webster Online Dictionary. 2008. Merriam-Webster Online. 1 June 2009 <<http://www.merriam-webster.com/dictionary/review>>.

focuses on the way Applicant's goods and services are identified in the opposed application. *G-Mar Development Corp. v. Tully's Coffee Corp.*, 2001 TTAB LEXIS 89, at \*8. As mentioned above, Applicant seeks registration of the JUDICIAL REVIEW mark for "legal services," without restriction. Opposer's registrations identify several services specifically limited to the legal community and industry.

Both Opposer and Applicant make their products available through the World Wide Web which would be accessible by consumers in a highly similar manner – through a web browser. Opposer operates a website available on the World Wide Web at uniform resource locator (“URL”) <http://www.judicialview.com>. Applicant has operated a website for the mark JUDICIAL REVIEW on the World Wide Web at URL <http://www.judicialintelligence.com>, (screenshot attached as Exhibit Q) and, upon information and belief, has registered and intends to use the URL <http://www.judicialreview.com>. Applicant’s registration is for “background investigation and research” and “legal services” without restriction. Opposer’s registration includes newspaper publication, providing on-line publications, providing legal case summaries, articles in the field of law, and court decisions. As admitted by Applicant, the JUDICIAL REVIEW registration for “legal services” which is targeted towards attorneys and overlaps services for which Opposer has registered and is using in commerce.

Accordingly, the evidence demonstrates that there is a high degree of similarity between Opposer's use of THE JUDICIAL VIEW mark and Applicant’s intended use of the JUDICIAL REVIEW mark, this factor weighing heavily in favor of a finding of likelihood of confusion and in favor of summary judgment.

### **3. Opposer and Applicant Market Their Services Through Similar If Not Identical Trade Channels.**

The third *DuPont* factor is the similarity or dissimilarity of established, likely-to-continue trade channels. Absent restrictions in the application and registrations, goods and services are presumed to travel in all appropriate trade channels to all potential purchasers of such goods, *Cunningham*, 55 USPQ2d at 1846. Again, Applicant seeks registration of the JUDICIAL REVIEW mark for "legal services." Applicant has admitted that site would be selling services targeting attorneys and bearing the JUDICIAL REVIEW mark. *See*, Exhibit J at ¶ 3. Applicant further stated that the trade channels may include magazines or trade journals. *See*, Exhibit J at ¶ 2(B)(7). Opposer's services also include the legal community and industry. It is obvious that there will be an overlap in trade channels in that both are targeted towards the legal services industry, attorneys and their clients. Opposer and Applicant will therefore market services through similar trade channels and this factor weighs heavily in a *DuPont* analysis, in favor of a likelihood of confusion and in favor of summary judgment.

### **4. The Potential for Confusion is Substantial.**

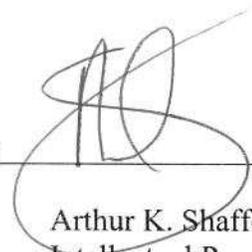
The twelfth *DuPont* factor is the extent of potential confusion, whether de minimis or substantial. Here, the potential confusion is substantial as both marks are promoted and available on the internet through a website. The marks at issue are not only the identity of the parties' services, but also the URL by which the public accesses these marks on the World Wide Web, one being found at URL [www.judicialview.com](http://www.judicialview.com) and the other at URL [www.judicialreview.com](http://www.judicialreview.com). Once Applicant makes the commercial product available, a simple typographical mistake of two letters, would send the consumer to a wholly different website, offering substantially similar

services under a substantially similar mark. Accordingly, this *DuPont* factor weighs in favor of a likelihood of confusion and in favor of summary judgment.

### III. CONCLUSION

Applicant has failed to dispute any factual issue in this proceeding. In addition, no questions of fact have been introduced with respect to any relevant *DuPont* factor, and each relevant factor weighs in favor of a likelihood of confusion between Opposer's THE JUDICIAL VIEW mark and Applicant's JUDICIAL REVIEW mark. Indeed, in view of the identity of Applicant's services and the identity of the parties' trade channels, any reasonable trier of fact would conclude that a likelihood of confusion exists. Because no genuine issues exist and Section 2(d) of the Lanham Act presents a statutory ground barring registration of Applicant's mark, the Board should grant Opposer's Motion for Summary Judgment and sustain this Opposition.

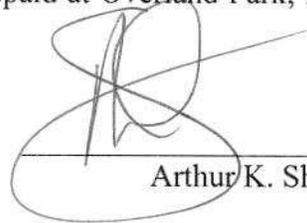
By: \_\_\_\_\_



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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Opposer's Motion for Summary Judgment has been served upon the attorney for Applicant Sandra L. Nudelman, by deposit with the U. S. Mail, first class postage prepaid at Overland Park, Kansas, the 3rd day of June, 2009.



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Arthur K. Shaffer

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

In the matter of application )  
Serial No.: 77/110,266 )  
Filed: February 18, 2007 )  
Applicant: Sandra L. Nudelman )  
Mark: JUDICIAL REVIEW )  
----- )  
MARC VIANELLO, )  
Opposer, )  
v. )  
SANDRA L. NUDELMAN, )  
Applicant. )

Opposition No.  
91180471

DEPOSITION OF SANDRA L. NUDELMAN  
FRIDAY, AUGUST 29, 2008 - 11:00 A.M TO 1:30 P.M  
THE McCORMACK FIRM, ONE INTERNATIONAL PLACE  
BOSTON, MASSACHUSETTS  
Reporter: Donna J. Whitcomb, CSR/ RPR/ RMR

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I N D E X

EXAMINATION OF: DIRECT CROSS REDIRECT RECROSS  
SANDRA NUDELMAN  
By Mr. Sonnabend 4

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\*Original exhibits returned to Attorney Sonnabend  
and Exhibit No. 8-2 retained by the witness.

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P R O C E E D I N G S

SANDRA L. NUDELMAN, having been satisfactorily identified was duly sworn by the Notary Public that her testimony will be the truth, the whole truth and nothing but the truth testified as follows in answer to direct interrogatories by Mr. Sonnabend:

Q Thank you for coming, Ms. Nudelman. Today this is the deposition of Sandra Nudelman in the matter of application Serial No. 77/110,266, Proceeding No. 91180471 before the Trademark Trial And Appeal Board. Ms. Nudelman, have you ever been deposed before?

A. No.

Q Let me tell you real quickly what this is all about and how it works and why it's not really as scary as people make it out to be. You've just been sworn in and I'm going to now ask you a series of questions. You're going to be answering them pursuant to the oath you just took. The swearing, the oath, you've sworn to tell the truth. I don't want you to answer things you don't know. I don't want you to offer conjecture or guesses. If you don't know the answer to something, that's what you

1 should tell me. If there are any questions I ask  
2 that aren't clear, which there's a possibility,  
3 please let me know, I will do everything I can to  
4 clarify them. And also being a New Yorker, I tend  
5 to speak too fast so if you don't understand  
6 something I say because I've spoken too fast, please  
7 let me know and I will try to slow down.

8 A. Uh-hum

9 Q. Do you have any questions before we start  
10 about how this works or anything?

11 A. Nope.

12 Q. Then let's just jump in. I'd like to  
13 start with just some background, some easy stuff.  
14 Can you tell me about your education post high  
15 school?

16 A. Harvard College, Harvard Business School.

17 Q. And Harvard College, you got a degree from  
18 Harvard College?

19 A. Yes.

20 Q. What degree was that?

21 A. A Bachelor of Arts.

22 Q. Bachelor of Arts in what field?

23 A. Behavioral Economics.

24 Q. What is Behavioral Economics?

1 A. It's the study of the intersection of  
2 psychology and economics.

3 Q Things like consumer behavior and the  
4 like?

5 A. Sort of.

6 Q Did you get a master's from Harvard  
7 Business School?

8 A. Master's in Business Administration.

9 Q An MBA. What year did you get your MBA?

10 A. 2007.

11 Q What about your BA?

12 A. 2003.

13 Q 2003. And you graduated high school in  
14 '99?

15 A. Yes.

16 Q Were you from the Boston area?

17 A. Long Island, New York.

18 Q I think I saw Dix Hills somewhere?

19 A. Uh-hum

20 Q I have an old college roommate from Dix  
21 Hills. You graduated from the high school in Dix  
22 Hills?

23 A. Home Ec. high school.

24 Q Where are you living currently?

1 A. 131 Sewall Ave., Apartment 46, Brookline,  
2 Mass.

3 Q S-E-W --

4 A. S-E-W A-L-L.

5 Q Sewall ?

6 A. Ave.

7 Q Brookline?

8 A. Yeah, Apartment 46.

9 Q Are you currently employed?

10 A. Yes.

11 Q Where are you employed?

12 A. McKenzie & Company.

13 Q What does McKenzie & Company do?

14 A. Management consulting firm

15 Q They're a rather large firm?

16 A. Yes.

17 Q What's your position there?

18 A. Associate, consultant.

19 Q What kind of things do you consult on?

20 A. How I do explain that -- strategy  
21 questions.

22 Q Things like product positioning, market  
23 evaluation?

24 A. Growth strategy --

1 Q The areas I mentioned are they --

2 A Not as much. Growth strategy, some back  
3 office operations.

4 Q What is growth strategy?

5 A Determining how to pursue a new market.

6 Q A new market for products and services?

7 A Uh-hum

8 Q You have to answer verbally.

9 A Yes, yes. And I do this for financial  
10 services companies.

11 Q What kind of products and services do  
12 these financial services companies have that you  
13 work with?

14 A I concentrate mostly in the payment  
15 sector. So things like unsecured and secured loans,  
16 sometimes deposits.

17 Q When you're helping one of your clients  
18 with their growth strategy, does that help include  
19 looking for new market for their products and  
20 services?

21 A In the cases I've been involved, they have  
22 generally identified the market they want to look at  
23 and I help them size it and assess it. But it  
24 could.

1 Q In connection with that market assessment  
2 do you explore what demands there might be for the  
3 products and services of the clients?

4 A Yes.

5 Q The trademark at issue which we will --  
6 market issue, application market issue which we'll  
7 get into in a little more detail a bit later is  
8 Judicial Review, is that correct?

9 A Yes.

10 Q Okay, I have the right case then.

11 Judicial Review covers -- is going to  
12 be used in connection with certain services. I'm  
13 correct?

14 A Uh-hum

15 Q That was a, "yes"?

16 A Yes.

17 Q It's all right, depositions are very  
18 different from normal conversation. It takes some  
19 time. Are you currently developing a business in  
20 connection with the services that will be branded  
21 with the Judicial Review mark?

22 A Yes.

23 Q Let's start kind of at the beginning then.  
24 Well, let's -- maybe let's do this first. Can you

1 give me a brief explanation as to what the services  
2 are?

3 A. Yes, I can.

4 Q Okay.

5 A. \*I'm trying to think of the best way to  
6 describe it. It is a database of judicial decisions  
7 that allows you to track and trend and find patterns  
8 in judicial decision making. So it renders  
9 statistical data in the forms of graphs and charts  
10 in an online, on demand format for the user.

11 MR. SONNABEND: Can you just reread  
12 the answer? I want to make sure that I got the  
13 right buzz words there.

14 (\*Record read as requested)

15 MR. SONNABEND: Thank you.

16 Q When did you first have the idea for this  
17 business?

18 A. Some time around October and November of  
19 2006.

20 Q How did you come to this idea?

21 A. I was attending a oral argument on  
22 behalf -- that my mother was making in Appellate  
23 Court and I asked her some questions about her  
24 preparation and realized that her preparation was

1 inadequate and there was a potential market for  
2 something.

3 Q Your mother's an attorney?

4 A Yes.

5 Q Do you remember where the oral argument  
6 was?

7 A Brooklyn.

8 Q Is it federal court or state court, do you  
9 know?

10 A I don't remember.

11 Q After you had this genesis of an idea in  
12 October or November of 2006, what was your next  
13 step, what did you do next in connection with  
14 developing this service?

15 A I applied to the business plan contest at  
16 Harvard Business School.

17 Q Can you explain to me what this business  
18 plan contest was, what it involved, what was it  
19 about?

20 A So the business plan contest is an  
21 academic exercise where everyone submits a business  
22 plan and presentation to a closed group of judges  
23 who are ostensibly under confidentiality. And  
24 they're rated by those judges and someone wins.

1 Q What do you win, what does the winner win?

2 A. Cash prize.

3 Q So in connection with the Harvard Business  
4 Plan Contest you submitted a business plan?

5 A. Uh-hum

6 Q At the time you submitted the business  
7 plan had you already come up with the mark, Judicial  
8 Review?

9 A. At that time I had, yes.

10 Q Do you remember when you came up with the  
11 mark, Judicial Review?

12 A. I believe I first thought of them when I  
13 was coming up with the business idea, but I didn't  
14 bother to file because I wasn't sure whether it was  
15 something I was going to pursue. So in terms of  
16 actual filing date, that was sometime in February of  
17 2007.

18 Q I want to understand about the business  
19 plan, the actual document -- well, let me ask that  
20 question. The business plan is a document, correct?

21 A. Yes.

22 Q And you created one yourself for the  
23 contest?

24 A. Uh-hum

1 Q That was a, "yes"?

2 A Yes.

3 Q In the business plan does it talk in part  
4 about the mark, Judicial Review?

5 A It doesn't talk about it as a mark. I  
6 brought up different names for the product.

7 Q Names of the product. In your  
8 understanding how does a name of a product differ  
9 from a mark if at all?

10 A At that point I was purely doing an  
11 academic exercise and I was filing more for the  
12 purposes -- I wasn't sure that I was taking the  
13 business idea seriously. I didn't know how it would  
14 be perceived and I was using the business plan  
15 contest as a way to gauge whether there was a market  
16 and there was interest in this idea. And so I filed  
17 the mark simultaneously with filing the business  
18 plan, so that I could be able to say that I had  
19 filed some sort of intellectual property.

20 Q Okay, let me make sure I understand the  
21 answer. In your view is the name of a product  
22 different from a mark?

23 A I'm guessing that's a legal definition  
24 that I don't know.

1 Q Is it fair to call your offering under the  
2 name "Judicial Review" a product?

3 A. You could call it a tool and I would guess  
4 a tool could be construed as either a product or  
5 service.

6 Q So it has aspects of both product and  
7 service.

8 A. Uh-hum

9 Q Okay, in the business plan though, to get  
10 back to the actual document, you do mention the name  
11 "Judicial Review," correct?

12 A. I believe I did.

13 Q Do you still have a copy of the business  
14 plan?

15 A. The one I submitted to the business plan  
16 contest?

17 Q Correct.

18 A. I believe I do.

19 Q As far as I understand that was not  
20 produced in response to the document requests and I  
21 believe it falls under the request. So I'm going to  
22 request here on the record that we get a copy of  
23 that.

24 A. Portions of that are confidential and have

1 trade secrets and so that would have to be redacted.

2 Q Well, we can talk about that. Certainly I  
3 don't want to turn over any confidential or  
4 sensitive information to the other side. Generally  
5 speaking, we can enter into a confidentiality  
6 agreement. We can tailor it so that things are  
7 protected when documents are very sensitive, which  
8 as I mentioned you deem this to be. That's fine, we  
9 can make those portions or the whole document  
10 "Attorneys' Eyes Only," so I'd be able to see it and  
11 counsel in Missouri would be able to see it, but the  
12 client would not see it.

13 And to the extent it was entered into  
14 the proceedings it's done so under all kinds of  
15 rules to make sure that only judges see it and no  
16 one else basically. We can get that set up. Just  
17 to be clear I'm going to request that business plan.  
18 I do request that business plan.

19 I take it from your answer, if I  
20 understood correctly, that there might have been  
21 some business plans later -- there was a business  
22 plan for the contest, correct?

23 A. Uh-hum

24 Q. And then were there subsequent revisions

1 of the business plan?

2 A. Yes.

3 Q Those also discussed the product and the  
4 mark, Judicial Review?

5 A. Those do not include the name "Judicial  
6 Review." So I did not use the name "Judicial  
7 Review" after the business plan contest.

8 Q Understood. So the subsequent revision  
9 they talk about the product that you intend to brand  
10 with the name "Judicial Review"?

11 A. Yes.

12 Q So I'm going to request those as well.  
13 And, again, you can get in touch with either me or  
14 the counsel for -- or Mr. Shaffer, I should call him  
15 by name, to work out a confidentiality agreement  
16 that you're comfortable with before this closes.  
17 But we should get that going as soon as possible.  
18 We have some limits time wise that the Board has put  
19 in place.

20 A. I would assume that the confidentiality  
21 agreement would include some sort of noncompete as  
22 well?

23 Q Yes, we can hit all those terms, but it  
24 never gets into his hands. But, yes, both Shaffer

1 and -- all counsel involved will be ethically banned  
2 to otherwise not compete, yes, absolutely.

3 In connection with the contest, did  
4 you do any kind of market study?

5 A. What do you mean by "market study"?

6 Q. Well, let me throw that back at you. The  
7 term "market study" is generally a term that I think  
8 a business consultant might come across, yes?

9 A. There are multiple definitions for what  
10 you would mean.

11 Q. Okay, under any of the definitions that  
12 you commonly use -- strike it, let me ask it this  
13 way. Did you do anything in connection with the  
14 business plan under the contest that you considered  
15 a market study?

16 A. I researched other competitors who offered  
17 similar types of products. I tried to understand in  
18 general who the major players were in legal  
19 services. I tried to understand the major  
20 customers' needs.

21 Q. What competitors did you research during  
22 this time?

23 A. The major ones. So Wolters Kluwer, Reed  
24 Elsevier, Thomson.

1 Q Thomson is -- you have to wait. Thomson  
2 is Westlaw?

3 A. Westlaw.

4 Q Reed Elsevier is Lexis.

5 A. Westlaw is Loislaw -- no, sorry, Wolters  
6 Kluwer is -- yes, Wolters Kluwer is Loislaw.

7 Q Right. I'm not even familiar with  
8 Loislaw. It must be a state law thing.

9 A. It's federal.

10 Q Is it?

11 A. It's a similar service to Westlaw, Lexis.

12 Q I'm very brand loyal. I'm a Westlaw guy.

13 You call them competitors, these  
14 are -- Westlaw's a publisher, Lexis is a publisher?

15 A. They have multiple products, so portions  
16 of their platforms could be construed for uses  
17 similar to what my product would be used for.

18 Q Which portions of their platforms would  
19 that be?

20 A. Specifically I -- I don't remember the  
21 exact names but the portions that are tailored for  
22 litigators to research judicial backgrounds.

23 Q So Westlaw has a product, if I understand  
24 your testimony correctly, Westlaw has a product that

1 allows its customers to research judicial  
2 backgrounds?

3 A. Well, in theory you could go and search a  
4 judge's name and bring up all of their cases and  
5 read through all of their cases.

6 Q. Okay, understood. So their case law  
7 database competes at some level with your product,  
8 if I understand correctly?

9 A. It's a very poor competitor, but it is a  
10 competing offer.

11 Q. Okay, understood, understood. And Lexis,  
12 I guess, is the same thing; they have a case law  
13 database as well, so the same applies for Lexis?

14 A. Yes, and a biography of the judge.

15 Q. Okay, understood. So let me see -- so by  
16 publishing this database of judges' biographies, the  
17 database of decisions, etc., Westlaw is a  
18 competitor, albeit a poor one, with your product  
19 branded under the Judicial Review name?

20 A. Yes.

21 Q. When you did these studies of these  
22 competitors, did you produce any written work  
23 product? Were there market study reports or  
24 competitor reports or anything you did?

1 A. It's all part of the business plan.

2 Q. It's all in the business plan.

3 Is a market analysis different from a  
4 market study or am I totally mangling terms of art  
5 here?

6 A. I would consider a market analysis to be  
7 more quantitative, so in terms of sizing demand.

8 Q. Okay, did you do a market analysis in  
9 connection with your business plan?

10 A. Yes.

11 Q. Was there a written product for that?

12 A. It's in the business plan.

13 Q. So there were never separate documents  
14 prepared for the market study or the market  
15 analysis?

16 A. No.

17 Q. I'm correct that there were no other  
18 documents?

19 A. There were no other documents.

20 Q. In performing your market study and your  
21 market analysis, did you generate any working  
22 documents, notes, spreadsheets or the like?

23 A. Probably, but I never really kept interim  
24 work product. Everything -- I tried to keep

1 everything in a version of the business plan.

2 Q Understood. Have you kept multiple  
3 versions of the business plan?

4 A I used to but I had a hard drive that died  
5 and so a lot of those have been discarded.

6 Q Okay, to the extent that you have multiple  
7 revisions I request the revisions as well. You used  
8 the term before, if I understood correctly, the term  
9 "legal services" to refer to the field in which  
10 Westlaw and Lexis operated; am I correct?

11 A Yes.

12 Q Is it the legal services industry, what is  
13 legal services?

14 A So "legal services" is a broad industry  
15 definition for all those companies.

16 Q Does your product fall in the legal  
17 services industry rubric as well?

18 A Yes.

19 Q What's the current state of development of  
20 your product?

21 A We have a prototype that is operational  
22 and development is continuing.

23 Q And development is continuing?

24 A Development is continuing.

1 Q You have software developers writing the  
2 software for you?

3 A I had one who was working for me but she's  
4 going back to school soon so...

5 Q Who is that?

6 A Elli Lobach.

7 Q Do you have the spelling of her name?

8 A E-L-L-I, Lobach, L-O-B-A-C-H.

9 Q And she's located in the U.S.?

10 A Yes.

11 Q Have you filed any patent applications to  
12 cover the product?

13 A No.

14 Q Have you filed any provisional  
15 applications to cover the product?

16 A No.

17 Q Have you spoken to any attorneys about  
18 filing an application?

19 A Yes.

20 Q When did you speak to an attorney about  
21 that?

22 A As part of the business plan contest there  
23 was an attorney who came to campus. I don't even  
24 recall his name.

1 Q But you never actually filed an  
2 application?

3 A No.

4 Q Did you ever tell anyone you filed an  
5 application?

6 A No.

7 Q You had a Delaware corporation?

8 A I had one.

9 Q And it's no longer --

10 A I had to dissolve it because of my current  
11 employment at McKenzie. They do not allow me to  
12 have a permanent position on a board of directors.

13 Q Are you on the business side as opposed to  
14 the product development side? Are you still  
15 actively developing your business?

16 A I am self funded so I am attempting to  
17 develop my business at this point.

18 Q How active would you say you are right now  
19 in this business?

20 A Getting more active. So the more I -- my  
21 savings account grows the more active I become.

22 Q I know that feeling. I take it then for a  
23 while things were developing -- development of the  
24 business was slow?

1 A. It goes on and off depending on my  
2 finances.

3 Q Understood. Did you at any time have a  
4 board in connection with the Delaware corporation?

5 A. Yes.

6 Q Who was on the board?

7 A. Me.

8 Q Small board.

9 A. Yes, I think Elli may have been on the  
10 board. I don't remember.

11 Q I imagine there was very little infighting  
12 on the board?

13 A. Well, there was but it was just between  
14 myself and I.

15 Q Did you ever have -- I don't know if the  
16 right word is a board of advisers or group of  
17 advisers?

18 A. Not official.

19 Q Did you have an unofficial group of  
20 advisers?

21 A. I had people I consulted on a one op.  
22 basis.

23 Q Are you presently seeking private funding?

24 A. Today? No, in the next few months, yes, I

1 am going to try again. The market environment is  
2 not very good.

3 Q Yes, I agree with that. Up until now have  
4 you made any pushes to get funding for the product?

5 A I did make a push after the business plan  
6 contest, yes.

7 Q Did you contact people in connection with  
8 this push for funding?

9 A Yes, there was a contest at a local  
10 venture capital firm called Highland Capital  
11 Partners.

12 Q Highland Capital Partners?

13 A Yes.

14 Q And they had a contest?

15 A Yes.

16 Q They're a VC firm and they had a contest?

17 A Yes. And I incubated there for a few  
18 months.

19 Q I always thought that was a strange  
20 phrase. When you say you incubated there for a few  
21 months, can you explain what you mean by that?

22 A They gave me office space, advice as  
23 needed. Just -- and they gave me money in order --  
24 not directly to the company but just to me to fund

1 me in developing the idea.

2 Q Understood. Did you have a particular  
3 mentor there or mentors?

4 A I had someone who was assigned to me I met  
5 with twice.

6 Q Do you remember who that was?

7 A Peter Bell.

8 Q Peter Bell?

9 A Yeah.

10 Q B-E-L-L?

11 A Yeah.

12 Q Is Highland Capital Partners still in  
13 existence?

14 A I believe so.

15 Q Where are they located?

16 A I should know that. I don't remember the  
17 exact town. It's near Waltham or it might be in  
18 Waltham

19 Q Up here, though?

20 A Yeah.

21 Q So says the New Yorker.

22 You incubated Highland Capital  
23 Partners after the Harvard Business Plan contest,  
24 yes?

1 A. Yes.

2 Q Do you know roughly month and year that  
3 you started incubating there?

4 A. Roughly it would have been June '07 to --  
5 through August '07.

6 Q And why did you leave?

7 A. It was a summer program

8 Q Did you ever prepare any prospectus or  
9 similar documents in connection with the funding  
10 drive?

11 A. The business plan, same plan. Everything  
12 is in one document. I try to keep organized.

13 Q Let's dive into the product a little more,  
14 the product -- the Judicial Review product. And let  
15 me start by asking a question, and make sure I'm  
16 using the right terminology. If I say the "Judicial  
17 Review product," do you understand that to mean the  
18 product, slash, service that you described earlier  
19 in connection with the -- let me get the right  
20 wording here -- connection with the tracking and the  
21 trending, the finding of patterns in judicial  
22 decision making?

23 A. Yes, that's fine.

24 Q So the Judicial Review product, was there

1 a problem, was there something lacking in what  
2 Westlaw, for instance, or Lexis provided that the  
3 Judicial Review product does? Was there a shortfall  
4 that it solves, a problem that it solves?

5 A. Yes.

6 Q. What is that?

7 A. They don't provide statistical  
8 quantitative analyses of these patterns. The  
9 attorney has to find them themselves.

10 Q. You're using some kind of statistical  
11 analysis on data pulled from a review of the  
12 judicial record?

13 A. So it's data created by reviewing the  
14 judicial record that is then statistically analyzed.

15 Q. Okay, so you start with the review of the  
16 judicial record, yes?

17 A. Yes.

18 Q. You pull out certain data points?

19 A. Uh-hum

20 Q. "Yes"?

21 A. Yes.

22 Q. And then you perform statistical analyses  
23 on these data points?

24 A. Yes.

1 Q In order to determine whether there are  
2 trends in the judicial decision making on a  
3 judge-by-judge basis?

4 A Yes. Or jurisdiction by jurisdiction  
5 basis.

6 Q I take it that, from your earlier  
7 testimony, that an attorney if he were so inclined,  
8 so motivated, could review the judicial record that  
9 exists in the Westlaw database; is that correct?

10 A They could.

11 Q And an attorney could perform a judicial  
12 review of the database that Lexis has; is that  
13 correct?

14 A Yes.

15 Q And there was a third company?

16 A Walters Kluwer.

17 Q Walter?

18 A Walters Kluwer.

19 Q So an attorney could do a judicial review  
20 of the database that Walters Kluwer has if they were  
21 motivated?

22 A If they were motivated and had the time  
23 and their client had the money.

24 Q Understood. Do you think there's a lot of

1 demand for the product, the Judicial Review product?

2 A. I believe there is, yes.

3 Q Can you describe, can you characterize for  
4 us and for the Board what that demand is?

5 A. The demand is for -- in high value  
6 litigation.

7 Q Who would be the demanders?

8 A. Most likely corporate clients and then  
9 because of that their attorneys.

10 Q It's basically a litigators' tool,  
11 correct?

12 A. Yes.

13 Q Did your business plan discuss any  
14 specifics about rolling out the product and where  
15 you would -- who you would target first or  
16 subsectors of the market you would target first;  
17 that kind of thing?

18 A. Yes.

19 Q What did it talk about in that regard?

20 A. We would target lawyers at corporations  
21 first to generate demand at larger corporate firms  
22 that do litigation second.

23 Q So in house counsel first?

24 A. Uh-hum

1 Q And then large law --

2 A Large external counsel as pull-through  
3 demand.

4 Q Pull-through demand?

5 A (Nods head)

6 Q Sometimes I think the MBA vernacular is as  
7 foreign to a patent attorney as patent vernacular  
8 must be to an MBA student. "Pull-through demand,"  
9 okay. Large external counsel as a pull-through  
10 demand market.

11 A Uh-hum

12 Q Do you have a characterization or  
13 quantization of what a large external firm is as to  
14 a large firm, is there a cutoff that you have, for  
15 instance?

16 A I went back and forth on this a lot. I  
17 think -- I don't remember where I ended up in the  
18 most current version of the business plan but my  
19 intuition now says something around -- you know,  
20 more than 250 attorneys is a large firm

21 Q And at any time did you have a different  
22 definition?

23 A It may have gone down as low as 50 but  
24 that would be in secondary and tertiary phases of

1 roll out.

2 Q Did you ever analyze or did you ever come  
3 to a conclusion as to what the total market would be  
4 for, say, law firms, 50 or more attorneys?

5 A. So in that inter-- so 50 or more total?

6 Q Right.

7 A. Yes, probably in several hundred million  
8 dollars if done appropriately.

9 Q Okay, that sounds like a reasonable size  
10 market.

11 A. Yeah.

12 Q Did you do the same thing for in-house  
13 general counsel?

14 A. I assumed that the in-house counsel would  
15 be receiving their reports through their external  
16 counsel. So it's a single -- single payment.

17 Q Does the Judicial Review product publish  
18 information to attorneys?

19 A. No.

20 Q It provides information to attorneys?

21 A. Yes, in an on-demand fashion. So in the  
22 same way that in Westlaw you type in a word to  
23 search and based on the word you search different  
24 information comes up; that is how it works.

1 Q Is the Judicial Review product -- strike  
2 that, let me ask it this way. Let's back up. The  
3 company that you had formed, was that Judicial  
4 Intelligence?

5 A. Yes.

6 Q Sounds like a nazi want to be, but I  
7 shouldn't say that on the record. All right,  
8 Judicial Intelligence was the business or the -- was  
9 the intended business of Judicial Intelligence a  
10 consulting business?

11 A. No.

12 Q How would you characterize the intended  
13 business of Judicial Intelligence?

14 A. It's the holding company for the product  
15 that we have previously defined as Judicial Review.

16 Q Is it unfair to characterize it as  
17 judicial consulting?

18 A. It is unfair in the sense that we would  
19 not be doing any specific consulting work. We would  
20 provide information that an attorney could interpret  
21 for themselves.

22 Q Okay, I see. I see. So it differs from  
23 say, trial consulting?

24 A. Yes.

1 Q And I take it that you're familiar with  
2 trial consulting at least in a general sense?

3 A. Yes.

4 Q What's your understanding, just so I'm  
5 sure we're on the same page, as to what trial  
6 consulting comprises?

7 A. So my understanding of trial consulting is  
8 that there's really two forms: You have jury  
9 consultants who can come in and can give  
10 psychographic profiling, in other words, to select  
11 specific jurors generally, I guess, for criminal  
12 cases. And you also have sometimes expert witnesses  
13 that are pulled in for these companies that are  
14 called "trial consulting firms" and so providing  
15 expert witness testimony.

16 Q What is -- you said "psychographic"?

17 A. And I guess demographic profiling.

18 Q What is psychographic profiling?

19 A. So trying to -- using the demographics and  
20 the information you have about that juror, potential  
21 juror, trying to ascertain how you think that person  
22 would decide and potentially get them thrown out if  
23 you don't think that they would be fair for your  
24 client.

1 Q Okay.

2 A At least that's my understanding of how it  
3 works.

4 Q Okay, fair enough. The Judicial Review  
5 product would provide information to attorneys to  
6 help them start forming the psychographic profile of  
7 a judge, for instance; is that fair to say?

8 A It's different. Jury consulting relies  
9 purely on a couple of pieces of data about ZIP codes  
10 and income and education level and then tries to  
11 ascertain what that person will decide. This is  
12 based purely on the judge's previous decision  
13 history and cases.

14 Q Okay, but you provide that information  
15 that you just mentioned to attorneys; that's what  
16 the Judicial Review product does?

17 A Yes.

18 Q Okay, and in your opinion is there a  
19 difference between providing information and  
20 publishing information?

21 A Yes, because publishing information is  
22 inherently static. So, for example, the New York  
23 Times publishes an article, it goes online; that is  
24 the article. Whereas providing information -- the

1 information is different for any user that tries to  
2 pull it. It's completely customized.

3 Q So the difference is a level of  
4 customization of the information given; am I  
5 understanding correctly?

6 A. So, for example, would you consider Google  
7 a publisher?

8 Q Well, let me ask you that question. Would  
9 you consider Google a publisher?

10 A. No, not unless -- no.

11 Q If Google created custom reports and  
12 provided those to its customers, would you consider  
13 it a publisher?

14 A. If the reports are static and provided to  
15 more than one customer, yes, they would be a  
16 publisher. So if I'm creating an article and  
17 handing it out to five people; that's a publisher.

18 Q You if you create an article and hand it  
19 out to one person, in your opinion are you not a  
20 publisher?

21 A. I suppose you would be.

22 Q What makes a report static versus, I  
23 suppose, dynamic? Let me just ask this, strike  
24 that. What makes a report in your opinion static?

1           A.     That there are no dynam -- that there's no  
2 flexibility to it, there's no dynamicism. So, for  
3 example, we're using an online format that, you  
4 know, basically displays statistical information.  
5 It has tic marks and the user can customize the way  
6 that chart looks and the information that's being  
7 pulled right then and there. So the chart is very  
8 unlikely to ever look the same way twice to that  
9 user or to anyone else unless they do the exact same  
10 search pattern.

11           Q.     Okay. I take it, based on your testimony,  
12 you're fairly well familiar with Westlaw's services  
13 and Lexis' services; is that correct?

14           A.     Yes.

15           Q.     In your opinion does Westlaw publish any  
16 static content?

17           A.     Well, their bound books are certainly  
18 static.

19           Q.     Fair enough.

20           A.     Their bound copies are certainly static.

21           Q.     How about in their online offerings?

22           A.     Yes, because the case law you're pulling  
23 is always the same. So if I'm searching for a  
24 specific decision from a specific date, whether I

1 pull it today or you pull it today or I pull it a  
2 week from now or you pull it a week from now it's  
3 going to look exactly the same. It's not updated  
4 continuously and it's something that is very likely  
5 to look the same to everyone.

6 Q In your understanding of the market, is  
7 demand driven by the static versus dynamic  
8 differential?

9 A Yes.

10 Q Can you explain how?

11 A People want to know that their decision --  
12 or their -- the decision criteria they're using is  
13 completely up to date.

14 Q Running a search on Westlaw on a topic  
15 will provide that, correct?

16 A In theory, yes. But the amount of time it  
17 would take to absorb all of that information maybe  
18 is not feasible from a usability perspective.

19 Q In the absence of your product being on  
20 the market, the Judicial Review product, if an  
21 attorney has the resources, I take it that he can go  
22 to Westlaw and run a search on the Westlaw database,  
23 pull the information from the Westlaw database, and  
24 crunch the numbers, again, if he has the resources;

1 am I correct, is that accurate?

2 A. He could and would be doing a great  
3 disservice to his client because it would take  
4 thousands of hours.

5 Q Fair enough. Fair enough.

6 MR. SONNABEND: Let's mark as Exhibit  
7 1 a TEAS Plus application for Serial #77110266,  
8 filing date February 18, 2007.

9 (Document marked as Exhibit No. 1  
10 for identification.)

11 Q I'm going to hand you what's been marked  
12 as Exhibit No. 1. Take as much time as you need  
13 just to familiarize yourself just generally with the  
14 document. And when you've done that the first  
15 question I'm going to ask you is: Does this  
16 document look familiar to you, do you recognize it?

17 A. Yes.

18 Q What is Exhibit No. 1?

19 A. This is the trademark application I  
20 submitted for the mark Judicial Review.

21 Q Who prepared the application?

22 A. I did.

23 Q Did anyone help you prepare the  
24 application?

1 A. No.

2 Q Do you remember when you prepared the  
3 application?

4 A. Must have been the same day that I filed  
5 it. So February 18th.

6 Q Are you familiar with the phrase "I.D." as  
7 it's used in connection with a trademark  
8 application?

9 A. No.

10 Q Are you familiar with the phrase "Goods  
11 and Services" as it's used in connection with a  
12 trademark application?

13 A. It sounds vaguely familiar.

14 Q Do you see about two-thirds of the way  
15 down the first page a heading, "Goods And/ Or  
16 Services And Basis Information"?

17 A. Yes.

18 Q Under that do you see an entry that says,  
19 "Description"?

20 A. Yes.

21 Q What is your understanding of what that  
22 field is, what information do you understand that to  
23 be asking for?

24 A. I'm guessing that that was what you

1 mentioned is goods and services.

2 Q Do you know substantively what is being  
3 requested of you for that field?

4 A I believe so, yes.

5 Q What's your understanding?

6 A A description of the goods and services  
7 that the mark is intended to provide.

8 Q Did you fill in the information that  
9 appears next to, "Description"?

10 A Yes.

11 Q Just for the record I'll read it:  
12 "Background investigation and research services;  
13 Legal services." Did I read that correctly?

14 A Yes.

15 Q What is background investigation -- strike  
16 that. Let me ask this. I'm not clear about the  
17 conjunction "and," is it background investigation  
18 services and research services or is it research  
19 background and investigation services; is it two  
20 separate services or is it one service there?

21 A You might want to ask the Trademark Board  
22 because that was one of the prefabricated items in  
23 the application.

24 Q It was. So this you took from the I.D.

1 manual --

2 A. Yes.

3 Q -- from the list of approved --

4 A. Yes.

5 Q What did you understand that to mean when  
6 you picked that from the list?

7 A. That it was any service that allowed you  
8 to better understand someone's background.

9 Q Did you disclose to the Trademark Office  
10 anywhere in this application that the background  
11 that you would be searching was background for the  
12 judiciary?

13 A. (Witness perusing document.)

14 Q Take as much time as you need to look  
15 through it.

16 A. I don't believe that was requested in the  
17 application.

18 Q So if I understand correctly you did not  
19 disclose to the Trademark Office in this application  
20 that you will be doing judicial background review  
21 under the mark; is that correct?

22 A. I don't know if there was -- I don't  
23 remember if there's anything else that I submitted  
24 in addition to this application.

1 Q Sitting here today do you recall  
2 disclosing that information to the Trademark Office?

3 A. I don't remember.

4 Q Do you think that information is relevant  
5 to the Trademark Office's review of your  
6 application?

7 A. I don't know.

8 Q Let's look at the second of the two  
9 descriptions. You have, "legal services." What is  
10 your understanding of what that means as used in the  
11 description field?

12 A. Services provided to lawyers or services  
13 provided by lawyers to their clients.

14 Q So it's not legal services as in providing  
15 legal counsel?

16 A. Under the broadest definition you could  
17 construe it that way but it also incorporates any  
18 services to lawyers.

19 Q So as you used it in this application you  
20 didn't intend it to mean being a lawyer?

21 A. No.

22 Q Correct?

23 A. You are correct.

24 Q Do you see under "Description" it says,

1 "Filing Basis"?

2 A. Yes.

3 Q Do you have an understanding of what that  
4 is?

5 A. That is the basis under which I filed.

6 Q And what basis did you file under?

7 A. Under Section 1(b).

8 Q Which means what to you?

9 A. According to the page in the exhibit, it  
10 says: If the applicant is filing under Section  
11 1(b), intent to use, the applicant declares that it  
12 has a bona fide intention to use or use through the  
13 applicant's related company or licensee the mark in  
14 commerce or in connection with the identified goods  
15 and services.

16 Q And that was your understanding of what it  
17 meant to file this as a 1(b) application?

18 A. Yes.

19 Q At the time you filed this back in  
20 February of '07 when did you intend to start using  
21 the mark?

22 A. After graduation.

23 Q Okay, let me make sure I'm clear, because  
24 "after graduation" I suppose could mean any time

1 between now and the time my grandchildren graduate.  
2 Let's narrow it down. When you say "after  
3 graduation" I take it you mean shortly after  
4 graduation?

5 A. Once I began working on it full time.

6 Q. After you graduated from Harvard with your  
7 MBA?

8 A. Uh-hum

9 Q. Which was what 2007, you said, right?

10 A. Uh-hum

11 Q. Let me ask just to clear up dates, you  
12 graduated -- you got your MBA from Harvard Business  
13 School in the spring of '07?

14 A. June of '07.

15 Q. So after you graduated with your MBA from  
16 Harvard Business School in June of 2007 did you --  
17 we know you went that summer to the venture  
18 capitalist, right?

19 A. Uh-hum

20 Q. After you left the venture capitalist in  
21 August of '07, did you continue working actively on  
22 the Judicial Review product?

23 A. Yes.

24 Q. In August of '07 -- strike that, let me

1 ask this: At what point did you go to work, and I  
2 apologize if I asked this before, at what point did  
3 you start working at McKenzie?

4 A. January of '08.

5 Q From August of '07 to January of '08 did  
6 you have any other employment?

7 A. No, I was working full time on Judicial  
8 Intelligence and Judicial Review.

9 Q So from graduation or before your  
10 graduation from Harvard Business School through the  
11 time you started at McKenzie you were actively  
12 working on Judicial Review?

13 A. Well, at the time we were calling it  
14 "Judicial Intelligence" but, yes.

15 Q At that time you were working on the  
16 Judicial Review product?

17 A. But we were just calling the company  
18 "Judicial Intelligence" and we weren't referring to  
19 the product.

20 Q Okay, understood. I take it from your  
21 testimony that at some point you pulled back the  
22 active development of the Judicial Review product;  
23 is that correct?

24 A. Yes.

1 Q Did you ever completely cease your  
2 activities, your development activities of Judicial  
3 Review?

4 A No.

5 Q What was the nadir, the low point, in  
6 terms of amount of activity in connection with the  
7 Judicial Review product?

8 A Do you mean the time or a description?

9 Q You tell me. Was there a point, looking  
10 back now, that you would say for X amount of time I  
11 was doing almost nothing on this or very little  
12 or --

13 A It's kind of a consistent buzz since  
14 January.

15 Q Since January of '08?

16 A Right.

17 Q You've been working on it consistently  
18 although levels of how much you were working on it  
19 changed?

20 A It's not full time anymore. Can't be.

21 Q Understood, we have to eat.

22 A Yeah.

23 Q Do you still intend to bring this to  
24 market?

1 A. Yes.

2 Q Do you still intend to use the Judicial  
3 Review mark?

4 A. Yes, as long as this goes away.

5 Q Let me ask you this question. In your  
6 understanding does a federal trademark registration  
7 give you the right to use the mark and register it?

8 A. That sounds like a legal question so I  
9 don't know.

10 Q You have no understanding?

11 A. My understanding is you probably could use  
12 any word you want and any mark you want as long as  
13 you don't get sued.

14 Q The reason I ask is if you still intend to  
15 use the Judicial Review mark depending on the  
16 outcome of this proceeding?

17 A. Yes.

18 Q In your understanding if this proceeding  
19 ends favorably to you, do you understand that that  
20 gives you the right to use the mark?

21 A. I assume so.

22 Q Let me ask you some questions about the  
23 mark itself. How did you come up with the name  
24 "Judicial Review"?

1           A.    \*I envisioned the use of my product be  
2 something that could be used to be a check and  
3 balance against the judiciary and judicial review;  
4 that is the definition of it.

5                           MR. SONNABEND: Can I have that  
6 answer back again, please?

7                                   (\* Record read as requested)

8           Q.    So Judicial Review is the definition of  
9 the process of --

10          A.    Judicial Review is the ability of the  
11 judiciary to have checks and balances on the other  
12 branches of the government. So inherently it brings  
13 about the sensitive checks and balances in the  
14 system

15          Q.    The definition of judicial review in  
16 connection with your product, that's a sort of  
17 judicial review of the judiciary?

18          A.    I didn't understand that.

19          Q.    I'm not sure I did either. So let's  
20 strike that.

21                           I'm trying to understand -- you chose  
22 the name "Judicial Review" because the definition of  
23 "judicial review" is a sort of checks and balances  
24 that the judicial branch asserts over the other

1 branches; is that correct?

2 A. Uh-hum

3 Q How does that relate to your product I  
4 guess is the simpler question?

5 A. I view my product as also creating a check  
6 and balance on the judiciary.

7 Q So it's sort of a judicial review, in  
8 quotes, of the judiciary?

9 A. I guess you could say that.

10 Q Your product, the Judicial Review product,  
11 reviews judicial records; you testified to that  
12 earlier, is that correct?

13 A. Yes.

14 Q Let's take each of the two words  
15 separately. Starting with the word "judicial," does  
16 that describe an aspect of your product?

17 A. It -- having to do with the judiciary.

18 Q I just want to be clear, so the answer is,  
19 "yes"?

20 A. Yes.

21 Q Okay. How about the word "review," your  
22 process includes or your product under the hood, so  
23 to speak, reviews the judicial record; that's  
24 correct, yes?

1           A.    It aggregates a judicial record and  
2 creates a statistical analysis.

3           Q.    And that's done through a review of the  
4 record as you testified to earlier, correct?

5           A.    It's done by a machine, so I don't know if  
6 you'd call it -- yes, sure.

7           Q.    Is it fair to say then that the Judicial  
8 Review product is a product that undertakes a review  
9 of sorts?

10          A.    It depends how you define "review."

11          Q.    Okay.

12          A.    I don't think so because, you know, a  
13 review of a show tries to pass judgment on a show.

14          Q.    I see.

15          A.    \*We're not passing judgment on a judge.  
16 I'm not taking a perspective on a particular judge.  
17 I'm just aggregating information and publish -- I  
18 guess I'm publishing the information statistically.

19          Q.    Understood, okay.

20                   MR. SONNABEND: Can I ask you to read  
21 back the last answer? I was talking over her and I  
22 want to make sure I got it.

23                   (\* Record read as requested)

24          Q.    I understand the issue you had with the

1 word "review," certainly I didn't mean it as a  
2 critique in that sense as in review of a Broadway  
3 play. I jotted down a definition for "review" --  
4 why I did that, I'm not sure, but I did -- from the  
5 American Heritage Dictionary: To look at or to  
6 watch, verb. Examination or an inspection as a  
7 noun. Would you agree that those are fairly common  
8 definitions for "review"?

9 A. I'll have to rely on the fact that that's  
10 the definition, yes.

11 Q Yes, and I'm not asking you to confirm  
12 that's what the American Heritage Dictionary says,  
13 but would you agree just in your understanding of  
14 English that if I said that a "view" is an  
15 examination and inspection, that that's at least one  
16 definition for word "view" as a noun?

17 A. "Review" you mean.

18 Q No -- right, so let's strike that. Let's  
19 back up. "Review," a reexamination or  
20 reconsideration. Would you agree that that's a fair  
21 definition at least of one context of the word  
22 "review"?

23 A. Yes.

24 Q And as far as a verb it's fair to say that

1 "review" is to look over or study or examine again?

2 A. Yes.

3 Q Under that definition that we just talked  
4 about, I don't know if I totally clouded things up,  
5 under those common definitions would you say that  
6 the Judicial Review product undertakes a review of  
7 the judicial record?

8 A. So you have to differentiate between the  
9 engine of what is done prior to giving the product  
10 to the customer. So in the background we are  
11 reviewing the judicial record, but the product  
12 itself -- what is given to customers is not a  
13 review.

14 Q It's a report based on a statistical  
15 analysis that's based on data pulled from the  
16 review?

17 A. Was one of the words there you used  
18 something like examination.

19 Q Yes.

20 A. Actually, can you just read it again?

21 Q Sure, and you and I maybe can agree on a  
22 definition that we agree, leaving the American  
23 Heritage aside.

24 A. Yeah.

1 Q Review: To look over, study or examine  
2 again.

3 A. Yeah, see, my issue with the definition as  
4 to describe our process is that in reality the data  
5 being pulled it's automated. So you have these  
6 decisions and records and it's not as though a  
7 person is going in and looking at anything or  
8 examining anything. There's specific fields that  
9 are pulled into a database which is then  
10 statistically analyzed.

11 Q So let's start with a definition. If I  
12 handed you, and I may have done this already with  
13 Exhibit 1, if I handed you a document and said take  
14 a moment and review this, what would you understand  
15 me to be instructing you to do?

16 A. To read through it and comprehend it.

17 Q And is it safe to say, is it fair to say  
18 that in some sense your computer algorithm, your  
19 computer program does that with the judicial record?

20 A. I don't know.

21 Q Does "judicial review," the phrase, does  
22 it describe, do you think, the Judicial Review  
23 product?

24 A. I think it has interesting connotations

1 that makes it good for marketing the product. I  
2 don't think it's a definite description of it. It  
3 would be a better description of a newspaper  
4 publication, like the National Review.

5 Q Do you think that your customers will  
6 understand that the results they get, work product  
7 that they get from the Judicial Review product is  
8 the result of a review of the judicial record or  
9 results from a review of the judicial record?

10 A. I don't know; that's for them to figure  
11 out for themselves.

12 Q Well, when you market it to them -- in  
13 your plans to market it to them will you explain to  
14 them that you have an algorithm that goes through  
15 and reviews the judicial record?

16 A. I think I just have a problem with the  
17 word "review" because it's the algorithm pulls down  
18 data into a database, then runs statistical analyses  
19 on it. It's not a review, it's a statistical  
20 analysis.

21 Q Do you think it's important for customers  
22 to know, your potential customers, to know that your  
23 product bases the work product on substance of the  
24 judicial record?

1 A. Of course.

2 Q You testified earlier that the -- an  
3 attorney if he had the resources and wanted to waste  
4 his client's money could do the same thing through  
5 the Westlaw database through brute force; am I  
6 characterizing your testimony fairly?

7 A. In some cases he could do it. In some  
8 cases it would be humanly impossible.

9 Q And in the cases that he could do it, even  
10 though it's a monumental task, he would be required  
11 to review the judicial records that he pulls down;  
12 is that correct?

13 A. He could or if he was smart enough he  
14 could also figure out a way to download the data the  
15 way we do and parse it.

16 Q But he could do the same thing by  
17 reviewing the judicial record; is that correct?

18 A. (Pause)

19 Q Through brute force, perhaps?

20 A. By reading through all of the documents,  
21 creating quantitative coding of those documents,  
22 inputting those codes into a database and then  
23 running an analysis he could do it.

24 Q We've been going for a little over an

1 hour. I don't know if you want to take a break?

2 A. No, I'm fine.

3 Q Are you familiar with the term "trade  
4 channel" or "channel of trade"?

5 A. Not the precise definition.

6 Q Have you heard the phrase before, either  
7 of those two phrases?

8 A. Possibly but I don't have a clear sense of  
9 the definition.

10 Q How about "field of a product"; does that  
11 mean anything to you?

12 A. Not beyond a layperson definition.

13 Q In the business consulting world, in the  
14 vernacular you're familiar with, comfortable with  
15 professionally, is there a term that is used to  
16 describe the boundaries of a market for a product?

17 A. "Scope," the scope of a product.

18 Q In that context does the scope of a  
19 product include how the product makes its way to  
20 market?

21 A. No, that's something different.

22 Q Does scope of the product cover how the  
23 consumer obtains the product?

24 A. No.

1 Q Is there a term for that?

2 A I guess it would be channel, "channel to  
3 market."

4 Q Okay, "channel to market." So that we're  
5 clear or that the record's clear, how would you  
6 define "channel to market"?

7 A Are you asking how would I market this?

8 Q No, I want to make sure that when we say  
9 "channel to market," because I have some questions  
10 about that, but I want to make sure that we're  
11 talking about the same thing.

12 A Okay.

13 Q So as you're using it can you kind of give  
14 me a definition back as to what a "channel to  
15 market" is?

16 A It is the mechanism by which you're  
17 selling the product to the customer.

18 Q So one channel to market might be through  
19 big box retailers, another channel to market might  
20 be direct sales via the internet?

21 A Yeah.

22 Q Another channel to market might be door to  
23 door?

24 A Yes.

1 Q So when we talk about that, those are all  
2 different channels to market?

3 A. Yes.

4 Q What is the channel to market that you see  
5 for your Judicial Review product; what do you  
6 anticipate the channel to market to be?

7 A. Direct sales, door to door.

8 Q So speaking kind of colloquially knocking  
9 on a law firm's door and saying: I've got this  
10 great tool, check it out?

11 A. Yes.

12 Q Is that the same channel to market, do you  
13 believe, as the channel to market for Westlaw's  
14 services?

15 A. That is a difficult question because  
16 Westlaw's penetration in the market is already  
17 something like 85 to 90 percent, so they don't rely  
18 on direct sales. They have relationship managers  
19 who manage relationships as opposed to engage in  
20 active sales at this point.

21 Q Do you believe that Westlaw is still  
22 developing new accounts?

23 A. Not many.

24 Q Okay, do you have any understanding based

1 on your market research or any other basis as to how  
2 Westlaw, for instance, develops new accounts?

3 A. They would most likely rely on a direct  
4 sales model, door to door.

5 Q. Knocking on a door, picking up the  
6 telephone, sending an email; that kind of thing?

7 A. I assume that's how they do it.

8 Q. The same would hold true, I imagine, both  
9 the Westlaw's online offerings as well as to their  
10 hard copy, old fashioned book products; am I  
11 correct?

12 A. I don't know.

13 Q. Do you see, sitting here today, do you  
14 have any reason to believe that the channels of  
15 trade for their online would be different from  
16 their books?

17 A. No.

18 Q. In your business plan did you assess the  
19 channel to market for your product?

20 A. Yes.

21 Q. And the channel to market that you  
22 identified as being the best opportunity was a  
23 direct sales channel to market, correct?

24 A. Yes.

1 Q Does that mean contacting lawyers  
2 directly?

3 A. It's a bit more nuanced than that.

4 Q Okay.

5 A. In a large law firm you wouldn't contact  
6 an individual lawyer, you're more likely to contact  
7 the law librarian.

8 Q The law librarian. That's interesting.  
9 Well, let me explore that; why the law librarian?

10 A. Because they control the contracts for the  
11 tools.

12 Q Have you ever been in a law library of a  
13 large law firm, say a 50 attorney or more law firm?

14 A. Directly in the library? No.

15 Q Do you have any understanding of what a  
16 law library comprises in a larger law firm?

17 A. Physically?

18 Q Yes.

19 A. There's -- it's very unlikely to have a  
20 physical location at this point.

21 Q You testified just a moment ago that law  
22 librarians, I'm going to paraphrase, they hold the  
23 keys or -- the "purse strings" maybe is a better  
24 expression -- law librarians hold the purse strings

1 for new research tools for law firms; is that  
2 correct?

3 A. They're the first ones to look at them

4 Q Do you have an understanding as to whether  
5 the law librarians also make decisions or are  
6 involved -- strike that, let me make sure the  
7 question's clear. Do you have an understanding as  
8 to whether law librarians are also involved in  
9 decision making regarding hard copy publications  
10 that a law firm subscribes to?

11 A. It depends on the firm

12 Q How did you come to determine that law  
13 librarians were a good point of contact as far as  
14 channel to market?

15 A. In speaking to friends who were attorneys.  
16 Law librarians are the only ones who know all the  
17 different types of tools that are out there.  
18 They're supposed to be the experts.

19 Q In your discussions about the role of the  
20 law librarians in law firms, did anyone ever talk to  
21 you about paper periodicals, paper publications that  
22 law librarians manage?

23 A. No.

24 Q If law librarians do, in fact, also manage

1 paper periodical subscriptions for the law firms,  
2 would that mean that the channel of trade is the  
3 same for the periodical as it is for the Judicial  
4 Review product?

5 A. It depends on whether the librarian sees  
6 the two items as being -- what's the right word --  
7 it depends on whether the law librarian sees two  
8 different items as being able to replace one  
9 another.

10 Q Okay. If you were to add to the offerings  
11 of Judicial Intelligence a monthly newsletter, would  
12 you think that a law librarian is still the best  
13 first point of contact in your channel to market?

14 A. It depends on what type of subscription  
15 I'm charging or what the plan is for it. So, for  
16 example, if it's something that is free and I'm  
17 making my money off advertising revenue, I wouldn't  
18 bother. I'd mail it to every attorney I know.

19 Q What if it's a pay for that subscription,  
20 would that change the answer?

21 A. Yes, but only in so far as -- it depends  
22 on how unique the data is. So if it's a very niche  
23 market, for example, it's only geared towards very  
24 specific types of attorneys who specialize in a very

1 tiny portion of the law, there's not a real reason  
2 to contact the law librarian because that individual  
3 attorney will have the budget to go after that  
4 himself, you don't need to contact the librarian.  
5 If it's something of mass interest, he'd probably go  
6 through the law library.

7 MR. SONNABEND: Well, I think I'm  
8 going to take a break.

9 (A brief recess was taken.)

10 Q I wanted to follow up on the channel to  
11 market a little bit. We have been talking some  
12 about law librarians, it's a topic dear to my heart.  
13 My best memory is with the law librarians, good  
14 group of people.

15 A. Yeah.

16 Q We're talking about channels to market.  
17 If a -- well, I don't want to say "competitor" so  
18 let's strike that. If another company started a  
19 weekly newspaper for lawyers that talked about the  
20 judiciary and they called it the "Judicial Review"?

21 A. Yeah.

22 Q How would you feel about that in light of  
23 your product, the Judicial Review?

24 A. I wouldn't care.

1 Q You wouldn't care?

2 A Nope.

3 Q Do you think that law librarians might  
4 think that this weekly periodical was put out by  
5 your company?

6 A I would make it clear that it wasn't.

7 Q Do you think that they might have that  
8 initial impression until you cleared it up?

9 A I don't know. Possibly.

10 MR. SONNABEND: We're going to mark  
11 now as Exhibit No. 2 a document marked as or titled  
12 "Opposer's First Set Of Interrogatories To  
13 Applicant."

14 (Document marked as Exhibit No. 2  
15 for identification.)

16 MR. SONNABEND: And to save some time  
17 let us mark at the same time Exhibit No. 3. Well,  
18 we'll have to characterize it on the record to  
19 figure out exactly what we'll call it.

20 (Document marked as Exhibit No. 3  
21 for identification.)

22 Q So I'm going to hand you now what's been  
23 marked as Exhibit No. 2 which we have said is  
24 entitled "Opposer's First Set Of Interrogatories To

1 Applicant." And I'm also going to hand you Exhibit  
2 No. 3 which, at least appears on the first page,  
3 appears to be a letter from you to Marc Vianello,  
4 Care of Arthur Shaffer.

5 So if you'll take just a few moments  
6 and review these two documents? The first question  
7 I'm going to ask you once you're done with your  
8 review is do you recognize one or both of these  
9 documents?

10 A. Yes, both of these documents.

11 Q Okay, let's start with No. 2. Exhibit No.  
12 2, what is Exhibit No. 2?

13 A. This is the Opposer's First Set Of  
14 Interrogatories.

15 Q So these were the interrogatories served  
16 on you by opposer in the present action; is that  
17 correct?

18 A. Yes.

19 Q And you remember receiving these?

20 A. Yes.

21 Q And you remember preparing responses to  
22 them, correct?

23 A. Yes.

24 Q Okay, what is Exhibit No. 3?

1           A.     Exhibit No. 3 is a cover letter and my  
2 responses to the set of interrogatories listed in  
3 Exhibit No. 2.

4           Q     If you could turn to Exhibit No. 3 --  
5 well, before you do that I may ask just one more  
6 foundational question. The Exhibit No. 3 contains  
7 in part your responses to Exhibit No. 2; is that  
8 correct?

9           A.     Yes, but there's a random page stuck in  
10 the middle.

11          Q     You're referring to the page that does not  
12 have the fax across -- the fax banner across the  
13 top?

14          A.     Yes.

15          Q     I will represent to you, and you can  
16 doublecheck this, that it is, in fact, the proper  
17 page of the document in the proper order. It was  
18 omitted from the fax that was originally sent to me.  
19 And if you read through in context you'll see that  
20 it is, I believe.

21          A.     Okay.

22          Q     Do you want to take a minute and just look  
23 through and confirm that so that you're comfortable  
24 that everything is on the up and up here?

1 (Witness perusing document.)

2 A. That's correct.

3 Q Turn to the fifth page of Exhibit No. 3.  
4 Do you see in the upper right-hand corner there's a  
5 fax banner that says P 5/13?

6 A. Yes.

7 Q And you see on the upper left, it says,  
8 2008-06-02 15:42?

9 A. Under the staple in --

10 Q Yes.

11 A. Yes.

12 Q In the middle of the page, it says, Sandra  
13 L. Nudelman's Answer To Opposer's Interrogatories?

14 A. Yes.

15 Q This is the first page of the actual  
16 interrogatory responses you prepared in response to  
17 opposer's first set of interrogatories, correct?

18 A. Yes.

19 Q Let's look at Interrogatory Response No.  
20 1. Do you see that on the page here?

21 A. Yes.

22 Q Interrogatory No. 1 reads in pertinent  
23 part, quote: Identify by common commercial  
24 descriptive name each product and/or service which

1 has been or is intended to be sold, offered for  
2 sale, manufactured, advertised, and/or rendered by  
3 Applicant in the United States under the Judicial  
4 Review mark. Do you see that in Exhibit No. 2?

5 A. Yes.

6 Q. So No. 1 on the page that we're looking on  
7 right now of Exhibit 3 is answering in part the  
8 passage I just read, correct?

9 A. Yes.

10 Q. Your answer reads, quote: 1. A. Legal  
11 services, specifically involving background research  
12 on judges and their opinions. Is that correct?

13 A. Yes.

14 Q. We looked earlier at Exhibit No. 1 which  
15 I'll make sure you have available to you and under  
16 the description there it doesn't mention anywhere  
17 judges and their opinions; is that correct?

18 A. No, it does not.

19 Q. It is not correct?

20 A. No, it does not say anything about judges  
21 on Exhibit 1.

22 Q. Okay. Why in answering Interrogatory No.  
23 1 did you include the phrase, "On judge's and their  
24 opinions" but not include it in the description of

1 your application for registration?

2 A. Because in the application that was  
3 available here these were the common names that were  
4 available and so I used the common names that were  
5 available and the checkmarks for the application.

6 Q. Do you have any understanding as to the  
7 difference between a TEAS, T-E-A-S, Plus application  
8 and a TEAS application?

9 A. I vaguely remember looking into the  
10 difference but right now I don't remember.

11 Q. Do you have an understanding as to whether  
12 or not you are limited to the list of descriptions  
13 provided by the Trademark Office?

14 A. I don't think you are.

15 Q. So it's your understanding that you're  
16 allowed to formulate your own description if the  
17 descriptions in the Trademark Office list are not  
18 sufficiently specific; is that correct?

19 A. Yes.

20 Q. Is the answer you gave to 1.A. accurate?

21 A. Yes.

22 Q. Is it correct?

23 A. Those would be the common descriptive  
24 names that I would use. It can go more detailed

1 than that. There are different levels of  
2 specificity.

3 Q Is there anything -- strike that. Let me  
4 ask it this way. Is it under inclusive, the  
5 description that you provided in the answer to  
6 1. A. ?

7 A. I would probably include the word  
8 "statistical" in there.

9 Q Statistical research on judges?

10 A. Uh-hum

11 Q Is that a, "yes"?

12 A. Yes.

13 Q So statistical research on judges is  
14 actually narrower, though, than on research on  
15 judges; is that correct?

16 A. Yes, but I also wanted to make sure that I  
17 was being broad enough to include all the different  
18 ideas that I had not yet developed.

19 Q Fair enough. I just want to make sure  
20 that it's broad enough to cover those and doesn't  
21 leave anything out?

22 A. Yes.

23 Q So it is broad enough to cover all the  
24 ideas you had for products under the Judicial

1 Review?

2 A. So some of the things that I thought of  
3 were not statistical, so in reality this is  
4 inclusive of everything. The ones that are most  
5 developed are statistical.

6 Q Understood, but it's not under inclusive,  
7 it doesn't leave anything out; am I correct?

8 A. No.

9 Q I'm not correct?

10 A. No, you're correct. It doesn't exclude  
11 anything.

12 Q Okay. You understand that the examiner  
13 has allowed your application for the Judicial Review  
14 mark; is that correct?

15 A. I believe so.

16 Q Do you think the examiner's decision to  
17 allow your mark, your application, would have been  
18 different if you had used the description in 1.A. in  
19 your application?

20 A. I don't know.

21 Q The services you describe in 1.A. --

22 A. Well, actually I'm just thinking.

23 Q Okay.

24 A. 1.A. is actually slightly under inclusive.

1 Q Okay, what does it exclude?

2 A It should technically be judges,  
3 jurisdictions, and also lawyers themselves.

4 Q So background research on judges,  
5 jurisdictions, and lawyers and their opinions?

6 A Well, judges and their opinions as well as  
7 jurisdictions and lawyers.

8 Q Okay. What products do you foresee using  
9 the Judicial Review mark on that involve background  
10 research on lawyers?

11 A It's the same product. It can be used  
12 multiple ways. That is a much later stage of  
13 development.

14 Q Who do you think would be interested in  
15 buying the product, the Judicial Review product,  
16 that's described in 1.A.?

17 A Lawyers.

18 Q Lawyers in their professional capacity?

19 A Yes.

20 Q The same group of people who would be  
21 interested in, for example, in buying a subscription  
22 to the New York Law Journal; is that correct?

23 A Well, I'm assuming that most of the people  
24 who read the New York Law Journal are in New York so

1 it would be a broader group of attorneys than just  
2 New York attorneys.

3 Q Okay, same group of people who would be  
4 interested in buying the National Law Journal weekly  
5 publication, correct?

6 A I can't answer that. I know in my  
7 professional capacity I subscribe to certain  
8 database products and I don't read the Wall Street  
9 Journal. So some people read those things and use  
10 database products and some people don't use database  
11 products and read journals. So I can't comment on  
12 what the overlap in the market is.

13 Q Is your Judicial Review product  
14 subscription based?

15 A We're attempting to figure out what the  
16 best model is but it most likely model would be a  
17 subscription basis.

18 Q Have you ever analyzed the exit potential  
19 for your Judicial Review product or the business  
20 pertaining to it?

21 A What do you mean by "exit potential"?

22 Q Is that a term you're familiar with?

23 A Do you mean in terms of selling the  
24 company? I'm trying to clarify what -- is that the

1 question?

2 Q Well, let me ask you, "exit potential" is  
3 a term I've heard bandied about but it is not  
4 exactly my expertise. Is it a term that you know of  
5 in your --

6 A I would define it as somehow selling a  
7 company either through a public offering or to a  
8 private owner.

9 Q Okay, so under that definition have you  
10 ever analyzed the exit potential for the business of  
11 Judicial Review?

12 A Yes.

13 Q What were the results of that analysis?

14 A It was in several hundreds of millions of  
15 dollars if you could actually get to the sales you  
16 wanted.

17 Q Who would be the potential buyers?

18 A Westlaw, Lexis or Wolters Kluwer.

19 Q Legal publishers?

20 A They are -- they are conglomerates that  
21 have publication arms, yes.

22 Q You wouldn't call Westlaw or their parent  
23 company Thomson West a legal publisher?

24 A Yes, but they wouldn't -- this wouldn't go

1 under their publication unit. They have several  
2 business units that would go in through their  
3 on-line media unit.

4 Q Okay, so turning back to Exhibit No. 3,  
5 let's look at answer to No. 2. In particular on the  
6 next page, the page that's marked page 6 of 13 in  
7 the upper right, P 6/13? Under -- let me see if I  
8 can get the numbering right here -- 2., capital A.,  
9 lower case (a), your response reads -- let me just  
10 read it into the record: While Opposer registered  
11 THE JUDICIAL VIEW under U.S. Serial #77031981 on  
12 March 25, 2008, the scope of this registration is  
13 limited to International Class 041 for, quote,  
14 Publication of an online legal newspaper, unquote,  
15 which is unrelated to the class under which the  
16 applicant filed Judicial Review, namely Class 045  
17 for, quote, Legal Services, and Background  
18 investigative research and services, unquote. Did I  
19 read that correctly?

20 A. Yes.

21 Q What did you mean in your answer that --  
22 these two classes here Class 041 for publication of  
23 an online legal newspaper and Class 045 for legal  
24 services and background investigative research and

1 services are unrelated; what did you mean by that?

2 A. Obviously, this is something that a judge  
3 would need to rule on but from my perspective, in  
4 common perspective, an online legal newspaper has  
5 nothing to do with what my product is doing.

6 Q. Is that because one is in Class 41 and one  
7 is in Class 45?

8 A. Because one is a publication and one is an  
9 online database that is used for legal services and  
10 background research.

11 Q. So it has nothing to do with the classes  
12 that they're in?

13 A. I don't know whether the Trademark Board  
14 views different classes as being distinct from a  
15 commoner's perspective. It would appear that they  
16 would be.

17 Q. If the two descriptions were in the same  
18 class would your answer change?

19 A. Probably not because they're still  
20 different. The fact that they're so -- they're in  
21 different classes and they are so different just  
22 exacerbates it.

23 Q. Okay, moving to lower case (b), the next  
24 paragraph, it reads: Opposer's second application

1 concerning THE JUDICIAL VIEW, U.S. Serial #77212172,  
2 was filed on June 21, 2007, four months after  
3 Applicant's filing date for Judicial Review. Did I  
4 read that correctly?

5 A. Yes.

6 Q. The phrase "four months after Applicant's  
7 filing date" is in italics; is that correct?

8 A. Yes.

9 Q. Why?

10 A. Just to draw attention to the fact that it  
11 was after the filing date for Judicial Review.

12 Q. So opposer for his mark, "The Judicial  
13 View," filed after you filed your application for  
14 "Judicial Review"; is that correct?

15 A. For Serial #77212172, yes.

16 Q. Why is that relevant?

17 A. Again, this is something that a lawyer or  
18 a judge would have to figure out as opposed to me.

19 Q. Why did you decide to include that there  
20 in your response?

21 A. Just to draw attention to the facts.

22 Q. In your opinion does that fact have any  
23 legal bearing on who has senior rights to their  
24 mark?

1 A. That's for the judge to decide.

2 Q Do you know under U.S. law whether the  
3 first file or the first to use a mark has senior  
4 rights?

5 A. I don't know. I'm guessing, it depends.

6 Q Did anyone help you prepare these  
7 responses?

8 A. Nope.

9 Q Your sister's an attorney, correct?

10 A. No.

11 Q She's not an attorney?

12 A. She's in law school.

13 Q Is your sister, Michele?

14 A. Yes.

15 Q Is she still in law school?

16 A. Yes.

17 Q At Washington University?

18 A. Yes.

19 Q When does she graduate?

20 A. This year.

21 Q Did she help you at all with this  
22 response?

23 A. No. I wish she had.

24 Q Why do you wish she had?

1 A. It would have been helpful.

2 Q Let's look at lower case (c) and I'll read  
3 it again, and don't worry, I don't think I'm going  
4 to be reading the whole exhibit. It's almost a page  
5 long but let's read C: Opposer's second application  
6 concerning THE JUDICIAL VIEW, U.S. Serial #77212172,  
7 filed on June 21, 2007, is of uncertain status, as  
8 an ex parte appeal of a final refusal to register  
9 the applied for mark is pending before the Trademark  
10 Trial and Appeal Board. Did I read that correctly?

11 A. Yes.

12 Q Why did you include that as part of your  
13 answer?

14 A. Again, drawing attention to the fact --

15 Q The fact that --

16 A. That the mark had not been accepted as of  
17 that time.

18 Q Are you aware of the status of that mark  
19 now -- of that application, I should say?

20 A. No.

21 Q If I told you that it had been allowed,  
22 would that change your answer to (c)?

23 A. (Pause)

24 Q I should say would that change your answer

1 (c)?

2 A. Yes.

3 Q. Okay, how would it change it?

4 A. It had been allowed.

5 Q. Does that change your basis for stating  
6 that opposer has failed to state a legally  
7 sufficient ground for sustaining the opposition?

8 A. I don't know.

9 MR. SONNABEND: Let's mark as Exhibit  
10 No. 4 a document first page of which is an  
11 Examiner's Amendment dated July 7, 2008. And the  
12 last page of which is a Notice of Publication under  
13 Section 12(a) dated July 23rd, 2008.

14 (Document marked as Exhibit No. 4  
15 for identification.)

16 Q. I just hand you Exhibit No. 5. Take a  
17 moment to review that document.

18 A. (Witness perusing document.)

19 Q. Have you ever seen Exhibit No. 5 before?

20 A. No, this is No. 4.

21 MR. SONNABEND: I'm sorry, we're on  
22 No. 4?

23 THE REPORTER: Yes.

24 MR. SONNABEND: Just so the record's

1 clear, Exhibit No. 4 is a three-page document, first  
2 page of which is entitled, "Examiner's Amendment"  
3 dated July 7, 2008. Third page of which is Notice  
4 of Publication under Section 12(a) dated July 23rd,  
5 2008. And as of yet there is no Exhibit 5.

6 Q Do you have an understanding as to what  
7 Exhibit 4 is?

8 A I believe so.

9 Q And what is that understanding?

10 A That the mark "The Judicial View" was  
11 allowed for publication on August 12th, 2008 -- or  
12 was published on August 12th, 2008.

13 Q Okay. Do you believe now that your  
14 Affirmative Defense No. 1 in connection with Serial  
15 No. 77212172 is no longer a tenable affirmative  
16 defense?

17 A I don't know.

18 Q Do you intend to oppose Application  
19 77212172?

20 A I don't know.

21 Q Turning to the next page of Exhibit 3, do  
22 you see at the bottom a paragraph numbered 3?

23 A Yes.

24 Q That reads: Even if the components of the

1 term JUDICIAL REVIEW are abstracted and taken to  
2 mean a, quote, review, unquote, of the, quote,  
3 judiciary, unquote, this is still substantively  
4 different from the meaning implied by the term  
5 Judicial Review because this would mean JUDICIAL  
6 REVIEW implies a third-party perspective ON the  
7 judiciary, whereas THE JUDICIAL VIEW implies the  
8 perspective of the judiciary. End-users would  
9 expect entirely different services based on these  
10 meanings. Did I read that correctly?

11 A. Yes.

12 Q. What do you mean by "abstracted and taken  
13 to mean a review of the judiciary"?

14 A. In looking at each word in isolation and  
15 then aggregating those definitions -- the  
16 definitions of the two isolated words as opposed to  
17 looking at Judicial Review giving the specific  
18 definition of balances, checks -- checks and  
19 balances of powers. Looking at judicial and then  
20 review separately.

21 Q. And if you look at "judicial" and "review"  
22 separately, that would mean a third-party  
23 perspective on the judiciary; is that correct?

24 A. Yes.

1 Q And that's what you said in Paragraph No.  
2 3 on the page we're looking at; is that correct?

3 A. Yes.

4 Q Is that what your product does?

5 A. (Pause)

6 Q Provide a third-party perspective on the  
7 judiciary?

8 A. Not really because the database provides  
9 statistical information that a user can interpret  
10 themselves.

11 Q And it allows the user to get a  
12 perspective on the judiciary?

13 A. Yes.

14 Q Is it safe to say or is it fair to say  
15 that your product allows an attorney to perform a  
16 Judicial Review of the judiciary under the  
17 definition of paragraph 3?

18 A. Under the definition in paragraph 2, not  
19 3. So to perform a check and balance on the  
20 judiciary, yes. But in terms of actually -- they  
21 are not developing a third-party perspective; they  
22 are developing their own perspective on that judge  
23 based on data.

24 Q They're a third party to the judiciary;

1 aren't they?

2 A. A third -- a third party is not the self.

3 Q Does the Judicial Review product give an  
4 attorney the ability to establish a perspective on  
5 the judiciary?

6 A. It gives them data from which they can  
7 create their own perspective.

8 Q On the judiciary?

9 A. Yes.

10 Q Let's look on the next page of Exhibit 3,  
11 on the top right-hand corner, it says, page 7 of 13,  
12 P 7/13?

13 A. Yeah.

14 Q Interrogatory No. 4, your response to  
15 Interrogatory No. 4. I'm just going to read the  
16 first paragraph just so we're clear we're looking at  
17 the same response. Paragraph 4 reads: Applicant  
18 was solely involved in the origination, clearance,  
19 selection and adoption of the Judicial Review mark  
20 to identify the services outlined in 1.A. above.  
21 Applicant initially applied for a trademark for the  
22 term on February 18, 2007, open paren, U.S. Serial  
23 #77110266, close paren. The term "Judicial Review"  
24 was selected for two reasons. Did I read that

1 paragraph correctly?

2 A. Yes.

3 Q When you say, "applicant," are you  
4 referring to yourself there in Paragraph No. 4?

5 A. Yes.

6 Q The second -- I don't know what part of  
7 the sentence that is -- after "origination," it  
8 says, "clearance"; so you were solely involved in  
9 the clearance of the Judicial Review mark; is that  
10 correct?

11 A. Yes.

12 Q What does that mean, "clearance"?

13 A. In going on the U.S. P.T.O. web site and  
14 typing in "Judicial Review" and making sure that  
15 there wasn't an application out there for the same  
16 term for the same services.

17 Q And is that sufficient to clear a mark?

18 A. From a legal perspective, I don't know.

19 Q Do you know what Lanham Act Section 2D  
20 says?

21 A. No.

22 Q Do you know what the Lanham Act is?

23 A. No.

24 Q Are you familiar with the phrase, "Likely

1 to cause confusion," as it's used in connection with  
2 the determination of whether a mark is registerable  
3 or not?

4 A. I've heard of it.

5 Q. Do you have any understanding as to what  
6 it means?

7 A. In a precise definition, no.

8 Q. In any definition at all?

9 A. From the common definition if it's likely  
10 to cause confusion. Will it confuse people?

11 Q. And if it is likely to cause confusion  
12 what does that mean about the registerability to  
13 you, if anything?

14 A. It may or may not be approved depending  
15 upon what the Trademark Board thinks.

16 Q. Are you familiar with the Dupont Factors?

17 A. No.

18 Q. In your opinion as a result of your  
19 efforts to clear the mark "Judicial Review" --  
20 strike that. Let me ask you this way. Did you  
21 conclude from your efforts to clear the mark that  
22 the mark was, in fact, clear to register?

23 A. It appears that you may be using a  
24 different definition of what "clearance" means so I

1 don't know.

2 Q Presently does Westlaw have a product  
3 that's the same as yours?

4 A No.

5 Q If you called your product "West Judicial  
6 Review," do you think they'd have a problem with  
7 that?

8 A Yes.

9 Q Why?

10 A Because "West" is a well-known publicly  
11 traded company, and it would be confusing to people  
12 to have a smaller, lesser known company using the  
13 term "West" for a very specific legal online product  
14 that might fit into their portfolio of products.

15 Q Let's turn to the next page of Exhibit  
16 3 -- I don't know why I can't remember this is  
17 Exhibit 3 -- I keep turning to the first page. In  
18 the upper right-hand corner of the page we're  
19 looking at now you see it says, P 8/13?

20 A Yeah.

21 Q Do you see paragraph No. 7?

22 A Yeah.

23 Q I want to ask you specifically about one  
24 of those subsections of your response. I just need

1 to figure out which one that is. You have 7. A.,  
2 I'm going to read 7. A. It reads: 7. A. Neither  
3 Applicant, nor the corporation in which she holds a  
4 majority stake, Judicial Intelligence, Inc., has  
5 advertised services under the JUDICIAL REVIEW mark  
6 in a magazine or trade journal, but reserves the  
7 right to do so in the future. You reserved the  
8 right to do so in the future, why?

9 A. Because I see no reason to waive that  
10 right.

11 Q. You believe that you might advertise the  
12 Judicial Review product in a magazine or trade  
13 journal in the future?

14 A. I don't know, maybe.

15 Q. Have you given any thought to doing that?

16 A. It is not high on my list.

17 Q. Why not?

18 A. It's not a very effective means of  
19 advertising.

20 Q. Do you have in mind any magazines or trade  
21 journals you would consider advertising in?

22 A. No.

23 Q. Any class?

24 A. No, as I mentioned before I want to rely

1 on direct sales. So marketing and advertising is  
2 not really a huge component of the business plan.

3 Q If you were to advertise your product in  
4 Time Magazine, would that be a good use of your  
5 resources, your financial resources?

6 A. Yes.

7 Q Why is that?

8 A. Because the product is interesting and  
9 compelling enough that doing that would generate a  
10 lot of free advertising in other venues.

11 Q How would it generate free advertising in  
12 other venues?

13 A. News coverage.

14 Q Of an advertisement placed in Time  
15 Magazine?

16 A. It would generate interest in the product  
17 in general.

18 Q How about an advertisement in National Law  
19 Journal, would that be a good use of your resources,  
20 financial resources?

21 A. Possibly, but I haven't really thought  
22 about law journals. I haven't really thought about  
23 advertising and marketing. I really do want to rely  
24 on direct sales.

1 Q There is an expense associated with  
2 creating a print advertisement, correct?

3 A. Yes.

4 Q If Automotive Weekly, the magazine, said  
5 they would give you free advertising and all you had  
6 to pay for was the cost of preparing the  
7 advertisement, would you take them up on the offer?

8 A. No.

9 Q Why not?

10 A. Not a big enough circulation for me to  
11 worry about.

12 Q How about the profile of the average  
13 reader of Automotive Weekly, would that affect your  
14 decision?

15 A. No, I'd want to get as mass a distribution  
16 as possible.

17 Q If the publishers of the National Law  
18 Journal made you the same offer, would you take them  
19 up on it?

20 A. If they were doing it for free?

21 Q You only have to pay the cost of preparing  
22 the advertisement.

23 A. It would really depend on whether I could  
24 have very specific control over what was said to

1 that audience.

2 Q It's your advertisement.

3 A I would rather it be covered in a news  
4 article and not journal as opposed to an  
5 advertisement.

6 Q So you would not take them up on the offer  
7 of free advertisement?

8 A I don't think advertising for this is  
9 going to make a huge difference one way or the  
10 other. Direct sales is really the way to go.

11 Q Okay, let me ask you this question. If  
12 Field And Stream -- what did I use before,  
13 Automotive Weekly?

14 A Uh-hum

15 Q If Automotive Weekly invited you to submit  
16 a 1,000 word article on your product that they would  
17 publish, would you think that would be helpful to  
18 the sales of your product?

19 A I guess it depends on the demographics of  
20 the readers.

21 Q If Automotive Weekly was read primarily by  
22 car manufacturers and people in the auto industry  
23 and not by lawyers, would it be worth the effort?

24 A No.

1 Q And if the National Law Journal made you  
2 the same offer, would you do it?

3 A. Sure.

4 Q Why, yes, to National Law Journal and, no,  
5 to Automotive Weekly?

6 A. Because based on the description you gave  
7 I'd be reaching more attorneys in the second  
8 publication as opposed to the first.

9 Q 7. B. reads: Neither Applicant, nor the  
10 corporation in which she holds a majority stake,  
11 Judicial Intelligence, Inc., has made trade  
12 presentations, seminar or meetings under the  
13 Judicial Review mark, but reserves the right to do  
14 so in the future. Did I read that correctly?

15 A. Yes.

16 Q Why do you reserve the right to make  
17 presentation -- trade presentations, seminars or  
18 meetings under the mark "Judicial Review" in the  
19 future?

20 A. Because I see no reason to waive that  
21 right.

22 Q Is that an important right to retain?

23 A. Possibly.

24 Q It sounds like that's much closer to

1 direct sales than the advertisements we were just  
2 talking about; am I correct?

3 A. Yes, although my vision of direct sales  
4 truly is door knocking. Direct sales participation  
5 in events like this is table stakes. You have to do  
6 more than that.

7 Q Meetings, you say in 7. B. that you  
8 reserve the right, among other rights, to have  
9 meetings under the Judicial Review mark in the  
10 future; is that correct?

11 A. Yes.

12 Q Would that include meetings of the  
13 door-to-door selling variety?

14 A. I suppose that would be a meeting.

15 Q Okay.

16 A. "Meeting" is a very broad definition.

17 Q Where would you look to have these  
18 meetings in the future, the ones you're reserving  
19 the rights to have?

20 A. In people's offices, lawyers' offices, law  
21 librarians' offices, I suppose.

22 Q How about in offices of engineers at  
23 General Motors?

24 A. If it's a tool they want to use and

1 they're willing to buy it, sure.

2 Q Do you think that the engineers at General  
3 Motors would want this tool?

4 A No, but there are uses for non-lawyers as  
5 well. Side point.

6 Q You said it's a side point?

7 A Yeah.

8 Q Your business plan doesn't call for  
9 pushing this out to non-lawyers, correct?

10 A It mentions the fact that there are  
11 applications beyond lawyers.

12 MR. SONNABEND: Let's mark as Exhibit  
13 No. 5 a document entitled, "Opposer's First Set Of  
14 Document Requests To Applicant."

15 (Document marked as Exhibit No. 5  
16 for identification.)

17 BY MR. SONNABEND:

18 Q I'm going to hand you what's been marked  
19 as Exhibit No. 5. I believe on the first page is  
20 Opposer's First Set Of Document Requests To  
21 Applicant; do you see that?

22 A Yes.

23 Q I want you to take a moment to review this  
24 document.

1 (Witness complies)

2 A. Uh-hum

3 Q. And first question I'm going to ask you  
4 after you've finished your review is do you  
5 recognize this document?

6 A. Yes.

7 Q. What is Exhibit No. 5?

8 A. This is the opposer's first set of  
9 document requests to applicant.

10 Q. And you received this earlier in these  
11 proceedings?

12 A. Yes.

13 Q. On the first page do you see -- I'm sorry,  
14 on the second page do you see four enumerated  
15 requests?

16 A. Yes.

17 Q. Did you personally search for documents  
18 requested on this page?

19 A. Yes.

20 Q. Where did you search?

21 A. In my file.

22 Q. You maintain a file somewhere?

23 A. Yes.

24 Q. How big is the file?

1 A. About that big (indicating). About 2  
2 inches wide.

3 Q So it's like an accordion folder?

4 A. Pretty much, yes.

5 Q Do you also maintain documents  
6 electronically?

7 A. Yes.

8 Q Do you have those collected in --

9 A. One file folder.

10 Q One file folder?

11 A. Uh-hum

12 Q Okay. When you did your trademark search  
13 did you generate any printed results either  
14 electronic, printed, or printed in hard copy?

15 A. No.

16 Q Would you say that Judicial Review is part  
17 of the legal services industry?

18 A. (Pause)

19 Q And I apologize if I've asked that before.

20 A. Yes.

21 Q Would you say that the legal services  
22 industry is comprised of the legal publishing  
23 industry?

24 A. I think it's a different part of the

1 industry. But it's a service to lawyers in the same  
2 way that a court reporter is a service and it's to  
3 lawyers.

4 Q It's fair to say that both legal  
5 publishing and judicial consulting comprise the  
6 legal services industry; is that correct?

7 A. They are subsegments. There are other  
8 segments, too.

9 Q And the services offered by the National  
10 Law Journal is another segment, correct?

11 A. Uh-hum

12 Q That's a, "yes"?

13 A. Yes.

14 Q What was the cash prize for the contest?

15 A. I'm trying to remember. Maybe \$10,000.

16 Q In connection with the contest you gave a  
17 presentation, correct?

18 A. Yes.

19 Q Do you remember how long it was?

20 A. 15 minutes.

21 Q Is it possible it was, oh, 7 to 8 minutes?

22 A. It might have been shorter. I think I was  
23 allowed 15 minutes.

24 Q Do you remember if it was videotaped or

1 otherwise recorded?

2 A. The final presentation was.

3 Q. In the presentation did you use Power  
4 Point slides or anything of that sort?

5 A. Yes, Power Point slides.

6 Q. Do you still have those?

7 A. I think so.

8 Q. I'd like to request those as well. I  
9 think they were --

10 A. That's a portion of the business plan.

11 Q. The Power Point slides are in the business  
12 plan?

13 A. Uh-hum

14 Q. That's a, "yes"?

15 A. Yes.

16 Q. Did you have any notes with you when you  
17 were giving the presentation, the final  
18 presentation?

19 A. Yes, those were copies of the slides.

20 Q. Okay. Where was the final presentation  
21 given?

22 A. It was given in the business school  
23 auditorium

24 Q. That's the Harvard Business School

1 auditorium, yes?

2 A. Yes.

3 Q. To whom was it given?

4 A. To students.

5 Q. Do you remember --

6 A. And faculty.

7 Q. I'm sorry, I didn't mean to interrupt you,  
8 student and faculty?

9 A. Yes.

10 Q. And anyone else?

11 A. I guess the judges who were mostly  
12 faculty.

13 Q. Do you remember roughly how many people  
14 were there?

15 A. Maybe 30 to 40.

16 Q. And where is the Harvard Business School  
17 auditorium, on the campus?

18 A. Yes.

19 Q. Do you remember approximately when it was  
20 given?

21 A. No, I don't remember the exact date.

22 Q. Did your sister, Michele have any role in  
23 developing the concept for the Judicial Review  
24 product?

1 A. She helped validate certain things.

2 Q. Did she advise you in any way?

3 A. In terms of legal terminology, yes.

4 Q. Anything else?

5 A. No.

6 Q. All right, let me see -- before I move on  
7 to the part I don't know how to do, let me just get  
8 a couple more documents into the record.

9 MR. SONNABEND: First one, let's mark  
10 as Exhibit 6, it's a one-page document with a  
11 heading, "Law Student Wins Harvard Business Plan  
12 Contest."

13 (Document marked as Exhibit No. 6  
14 for identification.)

15 Q. I've handed you Exhibit No. 6. Take a  
16 moment to review it and my first question is going  
17 to be: Have you ever seen Exhibit No. 6 before?

18 A. Yes.

19 Q. What is Exhibit No. 6?

20 A. It was an article that was published in  
21 WashU about the business plan contest at Harvard.

22 Q. And "WashU" is Washington University in  
23 Saint Louis?

24 A. Yes.

1 Q Where your sister is presently attending  
2 law school?

3 A. Yes.

4 Q Do you see where it says: Michele  
5 Nudelman, JD/MBA '09 and her sister, Sandra, an MBA  
6 student at Harvard, won the prestigious Harvard  
7 Business School's Business Plan Contest for their  
8 proposal for a Judicial Review opinion research  
9 tool. Do you see that?

10 A. Yes.

11 Q Was your sister a co-entrant with you?

12 A. Yes.

13 Q So I guess she was also a corecipient of  
14 the award that you won?

15 A. Yes.

16 Q What qualified her to be a co-entrant?

17 A. She helped me by validating very specific  
18 things that I needed to know.

19 MR. SONNABEND: Let's mark as Exhibit  
20 7 a document that says, "Judicial Intelligence" in  
21 the upper, left-hand corner and has a title, "About  
22 Us."

23 (Document marked as Exhibit No. 7  
24 for identification.)

1 Q Okay, I hand you Exhibit 7. Have you ever  
2 seen Exhibit 7 before?

3 A. Yes.

4 Q What is Exhibit 7?

5 A. It is a screen shot of the "About Us" page  
6 of the Judicial Intelligence web site.

7 Q Www.judicialintelligence.com?

8 A. Yes.

9 Q That's "judicial intelligence" all one  
10 word with no punctuation, correct?

11 A. Yes.

12 Q Do you still own that domain?

13 A. Yes.

14 Q What are you presently doing with that  
15 domain?

16 A. I have it down in order to continue to  
17 develop it.

18 MR. SONNABEND: Okay, I have as the  
19 next exhibit -- I guess it will be Exhibit No. 8,  
20 two copies of a DVD, of a video on DVD. Each of the  
21 two DVDs is labeled, "Judicial Intelligence Business  
22 Plan Presentation," copy 1 -- I'm sorry. Each is  
23 labeled "Judicial Intelligence Business Plan  
24 Presentation." One is labeled "Copy 1" and one is

1 labeled "Copy 2." Let's go off the record for just  
2 a second.

3 (Discussion of the record)

4 (DVDs marked as Exhibit Nos. 8-1 and  
5 8-2 for identification.)

6 (Viewing DVD No. 8-1.)

7 Q So I've shown you the first 40 seconds of  
8 the video that we have marked as Exhibit 8; do you  
9 recognize what this video is depicting?

10 A. Yes.

11 Q What is it depicting?

12 A. This is my presentation -- final  
13 presentation in the business plan contest.

14 Q Okay. Right now we're looking at 43rd  
15 second. I don't know if you can see that?

16 A. Uh-hum

17 Q There's a single person on the screen?

18 A. Yes.

19 Q Is that you?

20 A. Yes.

21 Q I would have not have recognized you, your  
22 hair was curly back then?

23 A. Yes.

24 Q Okay. What I'd like to do is the video is

1 7 minutes and 29 seconds in length I'm just going to  
2 play it through. I want to make sure that you have  
3 a chance to review it and make sure that you are  
4 comfortable that this is accurately depicting what  
5 it purports to show. And then I think that should  
6 be it. I may have one or two quick questions on it  
7 but that really should be it. Let me see if I can  
8 get it playing again.

9 (Viewing Video DVD No. 8-1.)

10 Q Okay, so you've just watched all 7 or so  
11 minutes of Exhibit 8; was that your entire  
12 presentation?

13 A Yes, I've never actually seen it before.

14 Q Sometimes it's hard, I think, to watch  
15 yourself in that kind of situation. Was it, in your  
16 recollection, is there anything missing, was there  
17 any edits in there that you are aware of?

18 A What do you mean by "edits"?

19 Q Let me back up. I want to make sure that  
20 you agree that this is -- that is an accurate  
21 videoing of your presentation?

22 A That seems like an accurate video of the  
23 presentation.

24 Q Towards the end, and I've watched that

1 several times now, I missed -- in the presentation  
2 you said that you had an advisory board. I thought  
3 you testified earlier you never had a formal  
4 advisory forum?

5 A. Exactly because this was still when I was  
6 in a very academic version. This is an academic  
7 contest. The business plan is submitted to an  
8 academic contest. Therefore, the advisers were  
9 academic advisers. This plan at that point was not  
10 yet a fully fleshed out plan for commerce. It was a  
11 plan to within a contest.

12 Q Understood. I thought that you had said  
13 that your advisory board included judges. I'm  
14 assuming that's judicial judges, not judges from the  
15 contest?

16 A. Yes, there was a judge.

17 Q I think you also said in your presentation  
18 that you had retained a patent attorney?

19 A. Yes, so I had hired one. I had one  
20 conversation which included a deposit and then had  
21 the deposit refunded. So we never actually went  
22 through with anything.

23 Q Is this the same attorney that you  
24 mentioned earlier?

1 A. It was at the same firm

2 Q. It looked to me like you did not have in  
3 the video a script you were reading from, it sounded  
4 like you were speaking very naturally. Am I  
5 correct, there was no script?

6 A. There was no script.

7 Q. Let me just doublecheck my notes. I think  
8 that maybe it.

9 (Pause)

10 Who is Ivory Tower Associates?

11 A. Oh, that was me. I had a college  
12 consulting business very briefly in college.

13 Q. Did you and your sister, Michele,  
14 correspond at any time regarding this project, the  
15 Judicial Review project, the Judicial Intelligence  
16 project?

17 A. You mean on the phone?

18 Q. Other than on the phone. For instance, by  
19 email or by written mail?

20 A. I don't think so. I mostly just asked her  
21 questions around how to, you know, understand very  
22 specific legal terms and put them into the business  
23 plan.

24 Q. Okay, that's it. Normally there's an

1 opportunity for cross-examination. I don't know if  
2 there's anything you want to cross-examine yourself  
3 on. Is there anything you want to clarify?

4 A. No, I think I'm okay.

5 Q. Okay, that's it. We'll go off the record.

6 (Whereupon the proceedings concluded  
7 at 1:55 p.m.)

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C E R T I F I C A T E

Commonwealth of Massachusetts

Suffolk, ss.

I, Donna J. Whitcomb, Certified Shorthand Reporter, CSR #135593, and Notary Public in and for the Commonwealth of Massachusetts, do hereby certify that SANDRA L. NUDELMAN, the witness whose deposition is hereinbefore set forth, was duly sworn by me and that such deposition is a true record of the testimony given by the witness to the best of my skill and ability.

I further certify that I am neither related to or employed by any of the parties in or counsel to this action, nor am I financially interested in the outcome of this action.

I witness whereof, I have hereunto set my hand this 5th day of September, 2008.

-----  
Donna J. Whitcomb, CSR/ RPR/ RMR

My commission expires: 12/ 13/ 13

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Washington University in St. Louis | Law School | Anheuser-Busch Hall | One Brookings Drive | St. Louis, Missouri 63130 | 314.935.6400

## Law Student Wins Harvard Business Plan Contest

Michele Nudelman, JD/MBA '09, and her sister, Sandra, an MBA student at Harvard, won the prestigious Harvard Business School's Business Plan Contest for their proposal for a judicial opinion research tool.

The Nudelman sisters submitted a detailed business plan for the development of "Judicial Intelligence," a legal research service tool that could be used to help attorneys optimize their litigation strategies through judicial opinion analysis.

"My legal education here at Washington University definitely contributed to our team's success and our ability to complete a coherent proof of concept and business plan," Michele noted. "I am honored that I was able to successfully represent the Washington University community."

In addition to submitting a business plan that included financial projections and market analysis, the Nudelmans presented their proposals to a panel of judges in the semi-final and final rounds.

Winners of the contest receive a cash prize and in-kind donations of legal and accounting services. The proposals are judged by professionals from various industries, including venture capitalists and entrepreneurs, and are evaluated on the basis of whether they present a viable business opportunity.



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6/1/2009

WULS: Law Student Wins Harvard Bu...

## Contact Information

Ann Nicholson

Email: [anicholson@wustl.edu](mailto:anicholson@wustl.edu)

Phone: 314.935.6430

# Trademark/Service Mark Application, Principal Register

## TEAS Plus Application

Serial Number: 77110266

Filing Date: 02/18/2007

**NOTE: Data fields with the \* are mandatory under TEAS Plus. The wording "(if applicable)" appears where the field is only mandatory under the facts of the particular application.**

The table below presents the data as entered.

Input Field	Entered
<b>TEAS Plus</b>	<b>YES</b>
<b>MARK INFORMATION</b>	
*MARK	<a href="#">Judicial Review</a>
*STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	Judicial Review
*MARK STATEMENT	The mark consists of standard characters, without claim to any particular font, style, size, or color.
<b>APPLICANT INFORMATION</b>	
*OWNER OF MARK	Nudelman, Sandra L
*STREET	92 Stone Hurst Lane
*CITY	Dix Hills
*STATE (Required for U.S. applicants)	New York
*COUNTRY	United States
*ZIP/POSTAL CODE (Required for U.S. applicants only)	11746-7934
PHONE	(617) 921-4080
EMAIL ADDRESS	snudelman@mba2007.hbs.edu

AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
<b>LEGAL ENTITY INFORMATION</b>	
*TYPE	INDIVIDUAL
* COUNTRY OF CITIZENSHIP	United States
<b>GOODS AND/OR SERVICES AND BASIS INFORMATION</b>	
*INTERNATIONAL CLASS	045
*DESCRIPTION	Background investigation and research services; Legal services
*FILING BASIS	SECTION 1(b)
<b>ADDITIONAL STATEMENTS INFORMATION</b>	
*TRANSLATION (if applicable)	
*TRANSLITERATION (if applicable)	
*CLAIMED PRIOR REGISTRATION (if applicable)	
*CONSENT (NAME/LIKENESS) (if applicable)	
*CONCURRENT USE CLAIM (if applicable)	
<b>CORRESPONDENCE INFORMATION</b>	
*NAME	Nudelman, Sandra L
*STREET	92 Stone Hurst Lane
* CITY	Dix Hills
* STATE (Required for U.S. applicants)	New York
* COUNTRY	United States
* ZIP/POSTAL CODE (Required for U.S. applicants only)	11746-7934
PHONE	(617) 921-4080
* EMAIL ADDRESS	snudelman@mba2007.hbs.edu
* AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes

<b>FEE INFORMATION</b>	
NUMBER OF CLASSES	1
FEE PER CLASS	275
TOTAL FEE DUE	275
<b>SIGNATURE INFORMATION</b>	
* SIGNATURE	/Sandra Nudelman/
* SIGNATORY'S NAME	Sandra Nudelman
SIGNATORY'S POSITION	Owner
* DATE SIGNED	02/18/2007
<b>FILING INFORMATION SECTION</b>	
SUBMIT DATE	Sun Feb 18 10:43:22 EST 2007
TEAS STAMP	USPTO/FTK-69.114.151.202- 20070218104322480685-7711 0266-36049afb0c9979397d8b 7a4823a4e1c6-CC-1279-2007 0218103940856491

## **Trademark/Service Mark Application, Principal Register**

### **TEAS Plus Application**

**Serial Number: 77110266**

**Filing Date: 02/18/2007**

To the Commissioner for Trademarks:

MARK: Judicial Review (Standard Characters, see [mark](#))

The literal element of the mark consists of Judicial Review. The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, Sandra L Nudelman, a citizen of United States, having an address of 92 Stone Hurst Lane,

Dix Hills, New York, United States, 11746-7934, requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended.

**For specific filing basis information for each item, you must view the display within the Input Table.**

International Class 045: Background investigation and research services; Legal services

If the applicant is filing under Section 1(b), intent to use, the applicant declares that it has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(b), as amended.

If the applicant is filing under Section 1(a), actual use in commerce, the applicant declares that it is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended.

If the applicant is filing under Section 44(d), priority based on foreign application, the applicant declares that it has a bona fide intention to use the mark in commerce on or in connection with the identified goods and/or services, and asserts a claim of priority based on a specified foreign application(s). 15 U.S.C. Section 1126(d), as amended.

If the applicant is filing under Section 44(e), foreign registration, the applicant declares that it has a bona fide intention to use the mark in commerce on or in connection with the identified goods and/or services, and submits a copy of the supporting foreign registration(s), and translation thereof, if appropriate. 15 U.S.C. Section 1126(e), as amended.

Correspondence Information: Nudelman, Sandra L

92 Stone Hurst Lane

Dix Hills, New York 11746-7934

(617) 921-4080(phone)

snudelman@mba2007.hbs.edu (authorized)

A fee payment in the amount of \$275 will be submitted with the application, representing payment for 1 class(es).

**Declaration**

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: /Sandra Nudelman/ Date: 02/18/2007

Signatory's Name: Sandra Nudelman

Signatory's Position: Owner

RAM Sale Number: 1279

RAM Accounting Date: 02/20/2007

Serial Number: 77110266

Internet Transmission Date: Sun Feb 18 10:43:22 EST 2007

TEAS Stamp: USPTO/FTK-69.114.151.202-200702181043224

80685-77110266-36049afb0c9979397d8b7a482

3a4e1c6-CC-1279-20070218103940856491

# Judicial Review



### Instructions and Definitions

Unless otherwise indicated, the following definitions and instructions shall be applicable:

A. "Opposer" means Marc Vianello and each of his employees, agents or representatives, accountants, attorneys or other individuals acting or purporting to act on her behalf.

B. "Applicant" means Sandra L. Nudelman. and each of her employees, agents or representatives, accountants, attorneys or other individuals acting or purporting to act on her behalf.

C. "Use" of the JUDICIAL REVIEW mark shall infer to the actual use of the mark and/or the intended use of the mark.

D. Reference to Applicant's JUDICIAL REVIEW mark refers to the mark identified in U. S. trademark application Serial No. 77/110,266 and/or any variations of such mark.

E. "Documents" shall have the same meaning and scope as in Rule 34(a) of the Federal Rules of Civil Procedure and shall include without limitation correspondence, memoranda, reports, minutes of meetings, agreements, notes, studies, plans, analyses, work papers, statistical and financial records, stationery, letterhead, press releases, records or notes of meetings, conferences, telephone calls, or other conversations, invoices, checks, printouts, videos, photographs, microfilms, microfiche, data processing tapes, disks, or other records, phonographs, tapes, product prototypes, or other recordings, data compilations and all copies of any documents that contain any notation or otherwise differ from the original and other copies, in the possession, custody or under the control of Applicant and specifically including any and

all drafts of the above and any and all handwritten notes or notations in whatever form.

F. When used in connection with a person, "identify" means to state the person's full name, present (or last known) address, present place of business or employment, present position, present phone number, and email address.

G. When used in connection with a document, "identify" means to state the document's title or other subject matter identification, date, author(s) and recipient(s) (including all recipients of copies).

H. When used in connection with an occurrence, "identify" means to state the date of the occurrence, the person or persons involved in the occurrence, if the occurrence was recorded, each and every document related to the occurrence, and any follow up activities related to the occurrence.

I. When used in connection with a company, "identify" means to state the company's full legal name, its trading name(s) if any, its place of incorporation if any, its principal business address, and the identity of the person or persons having knowledge of the matter with respect to which the company is named.

J. Wherever used herein, the singular shall be deemed to include the plural, the plural shall be deemed to include the singular; the masculine shall be deemed to include the feminine and the feminine shall be deemed to include the masculine; the disjunctive ("or") shall be deemed to include the conjunctive ("and"), and the conjunctive ("and") shall be deemed to include the disjunctive ("or").

K. A document "relating," "related," or "which relates" to any given subject includes any document that constitutes, contains, embodies, evidences, reflects, identifies, states, refers to, deals with, or is in any way pertinent to that subject, including without limitation,

documents concerning the preparation of other documents.

L. If a claim of privilege is asserted concerning any document for which identification is requested, please:

1. Identify the document with sufficient particularity so the matter may be brought before the Board. This identification should include its date, author, recipients, length and subject matter;
2. State the nature of the privilege asserted; and
3. State in detail the basis for the claim of privilege.

M. To the extent that you consider any of the following interrogatories subject to objection, respond to that part of each interrogatory to which you do not object, and separately describe that part of each interrogatory to which you object and each ground for objection.

## Interrogatories

### Interrogatory No. 1

A. Identify by common commercial descriptive name each product and/or service which has been or is intended to be sold, offered for sale, manufactured, advertised and/or rendered by Applicant in the United States under the JUDICIAL REVIEW mark.

B. For each type of product and service identified in answering subpart "A" above:

i. State the date of first use by Applicant in the United States of the JUDICIAL REVIEW mark in connection with the product or service;

ii. Describe the circumstances surrounding such first use;

iii. Identify the geographical location of such first use;

iv. State the date and geographical location of last use in the United States of the JUDICIAL REVIEW mark in conjunction with the product or service;

v. State the dollar volume of sales of the product or service bearing the JUDICIAL REVIEW mark from the date of first use to the present, on a yearly basis;

vi. State the dollar volume expended by Applicant in advertising the product or service bearing the JUDICIAL REVIEW mark from the date of first use to the present, on a yearly basis;

vii. Describe the wholesale, retail and/or other channels of trade in the United States through which the product or service is distributed, rendered and/or sold;

viii. State the intended end use of the product or service;

ix. Identify each type or class of consumers and/or end users for the

product or service and/or the characteristics of the consumers and/or end users for the product or service, and the class or type of purchaser or end user to which Applicant concentrates its marketing efforts.

Answer:

Interrogatory No. 2

In connection with Applicant's Affirmative Defenses, explain with particularity each fact known to Applicant which it asserts is a basis for such Affirmative Defenses.

Answer:

Interrogatory No. 3

A. Identify individuals and/or businesses and identify the nature of such individuals and/or businesses who buy, sell and/or use and/or are intended to buy, sell and/or use Applicant's services bearing the JUDICIAL REVIEW mark.

B. For each service listed in Applicant's application, explain with particularity the purpose of such services, the uses of such services and those who are intended to receive such services.

Answer:

Interrogatory No. 4

Identify each person who supervised, participated in or was involved in the origination, clearance, selection, and adoption of the JUDICIAL REVIEW mark to identify Applicant and Applicant's services, and describe with particularity the circumstances surrounding the origination, clearance, selection, and adoption of the JUDICIAL REVIEW mark including, but not limited to, the date of origination, the derivation of the mark, the meaning or suggestive connotation of the mark, if any, and identify any searches that were conducted for third party uses or registrations of the JUDICIAL REVIEW mark.

Answer:

Interrogatory No. 5

State the date Applicant first became aware of Opposer's use of THE JUDICIAL VIEW mark, and describe the circumstances surrounding this first awareness, including, but not limited to, the identity of the person(s) associated with Applicant who first became aware of Opposer's use thereof.

Answer:

Interrogatory No. 6

Identify all occurrences of actual confusion known to Applicant resulting from the contemporaneous use or offering of the JUDICIAL REVIEW mark by Applicant and THE JUDICIAL VIEW mark by Opposer, giving the date of, location of, and circumstances surrounding each such occurrence, including the persons confused in each case and the persons witnessing each such occurrence.

Answer:

Interrogatory No. 7

A. Identify each magazine and trade journal in which Applicant has advertised or plans to advertise or promote itself or its services under the JUDICIAL REVIEW mark.

B. Identify each trade presentation, seminar, and meeting Applicant has attended or plans to attend at which it promoted itself or its services under the JUDICIAL REVIEW mark.

C. Identify any other media, including internet websites Applicant has used or intends to use to promote itself or its services under the JUDICIAL REVIEW mark, including the dates of such use, the name of each media, and the person who has custody of the copy of each use.

Answer:

Interrogatory No. 8

Identify each individual, employee, agent or representative of Applicant, from the earliest date of use of the JUDICIAL REVIEW mark asserted by Applicant to the present, who was and/or is primarily responsible for marketing, advertising, sales or other distribution, or manufacturing of any products or services made, rendered, sold, offered for sale, distributed by Applicant, or intended for sale or distribution under the JUDICIAL REVIEW mark and briefly describe their respective duties and the products or services for which they are or were responsible.

Answer:

Interrogatory No. 9

Identify all advertising agencies, marketing agencies or other business entities, and the account executives at each such agency or other entity, that have been responsible for the advertising and promotion of Applicant's goods or services bearing the JUDICIAL REVIEW mark and state the time period when each was so responsible.

Answer:

Interrogatory No. 10

Identify all agreements, including licenses and assignments, entered into by Applicant relating to the JUDICIAL REVIEW mark, and identify all persons participating in the negotiation and creation of each such agreement and the parties to each such agreement.

Answer:

Interrogatory No. 11

Identify all interviews, surveys, or public opinion polls conducted by or on behalf of Applicant pertaining or relating to the JUDICIAL REVIEW mark by date, title, and company or other entity conducting the interview, survey, or public opinion poll and the person requesting the survey.

Answer:

Interrogatory No. 12

A. Identify with particularity all trademark registrations of, and all trademark applications to register the JUDICIAL REVIEW mark or other designations including the formative "JUDICIAL REVIEW" owned and/or filed by Applicant in the United States (including state applications and registrations) by date of registration or filing date, status, registration or serial number, country or state, the goods and/or services listed in the application or registration, and the date or dates of first use claimed in the application or registration.

B. If any application identified in answering subpart "A" above was abandoned without a registration issuing therefrom, identify each such application, state the date of abandonment, and state why the application was abandoned.

Answer:

Interrogatory No. 13

Identify all objections by Applicant and all legal proceedings instituted by Applicant against third parties' use of trade names, trademarks, service marks or other designations based on Applicant's perceived rights in the JUDICIAL REVIEW mark and provide:

- (a) Country or state in which the objection was made or in which the legal proceeding was filed;
- (b) Name and address of the third party;
- (c) Date of objection or institution of the legal proceeding;
- (d) Court, governmental agency or other forum in which the objection or legal proceeding was filed;
- (e) Status or outcome of the objection or legal proceeding;
- (f) The mark(s) employed by the third party which was (were) the subject of the objection or legal proceeding.

Answer:

Interrogatory No. 14

Identify all objections by third parties made to Applicant and all legal proceedings instituted by third parties against Applicant related in any way to Applicant's use of the JUDICIAL REVIEW mark, including the marks and goods and services involved and the outcome of the controversy.

Answer:

Interrogatory No. 15

Identify each person who had more than a clerical role in preparing the answers to these interrogatories and the responses to the contemporaneously served first requests for production of documents, stating specifically the number of each interrogatory or request for production for which such person supplied information or documents.

Answer:

Interrogatory No. 16

If documents and things identified in answering these interrogatories are known or believed to exist but are not in Applicant's possession, custody or control, identify each such document and thing insofar as it is possible to do so, and identify who has possession, custody or control of such document or thing.

Answer:

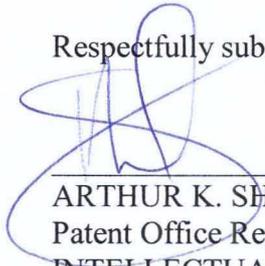
Interrogatory No. 17

Identify any expert witnesses expected to testify in this opposition and set forth the substance of each expert's testimony.

Answer:

MARC VIANELLO

Respectfully submitted,



---

ARTHUR K. SHAFFER  
Patent Office Reg. No. 50,257  
INTELLECTUAL PROPERTY CENTER, LLC  
9233 Ward Parkway, Suite 100  
Kansas City, Missouri 64114  
Telephone: (816) 363-1555  
Facsimile: (816) 363-1201

Attorney for Opposer

Certificate of Service

I hereby certify that a copy of the foregoing Opposer's First Set of Interrogatories to Applicant has been served by first class mail, postage prepaid, on Sandra L. Nudelson 92 Stone Hurst Lane, Dix Hills, NY 11746-7934, this 14<sup>th</sup> day of April, 2008.

  
\_\_\_\_\_  
Jeffrey Sonnabend

SonnabendLaw  
600 Prospect Avenue  
Brooklyn, NY 11215  
718-832-8810  
JSonnabend@SonnabendLaw.com



Requests

Request No. 1

All documents identified by Applicant in her responses to Opposer's First Set of Interrogatories to Applicant.

Request No. 2

All documents relating to the use of the JUDICIAL REVIEW in commerce by Applicant.

Request No. 3

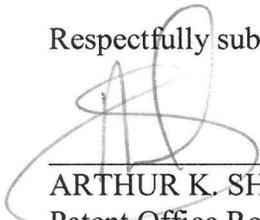
All documents concerning any trademark searches that Applicant or its representatives or agents (including without limitation attorneys) performed in connection with the mark JUDICIAL REVIEW.

Request No. 4

All documents comprising, constituting, concerning or relating to advertising, promoting or marketing of any services under the mark JUDICIAL REVIEW by Applicant.

MARC VIANELLO

Respectfully submitted,



---

ARTHUR K. SHAFFER  
Patent Office Reg. No. 50,257  
INTELLECTUAL PROPERTY CENTER, LLC  
9233 Ward Parkway, Suite 100  
Kansas City, Missouri 64114  
Telephone: (816) 363-1555  
Facsimile: (816) 363-1201

Attorney for Opposer

Certificate of Service

I hereby certify that a copy of the foregoing Opposer's First Set of Document Requests to Applicant has been served by first class mail, postage prepaid, on Sandra L. Nudelson 92 Stone Hurst Lane, Dix Hills, NY 11746-7934, this \_\_\_ day of April, 2008.

---

Jeffrey Sonnabend

SonnabendLaw  
600 Prospect Avenue  
Brooklyn, NY 11215  
718-832-8810  
JSonnabend@SonnabendLaw.com

Sandra Nudelman  
131 Sewall Ave. #46  
Brookline, MA 02446  
May 7, 2008

Arthur Shaffer  
Intellectual Property Center, LLC  
9233 Ward Parkway, Suite 100  
Kansas City, MO 64114  
VIA FACSIMILE: (816) 363-1201

Dear Mr. Shaffer:

I just received your letter regarding the deposition scheduled for May 15, 2008. Unfortunately, I will have to re-schedule given that I have since moved to Massachusetts, and am currently out-of-state on business in Illinois until the end of June. If it is more convenient, I would be happy to answer any questions you have in a written format. If so, please send them to my home address above so that I can have them forwarded to me more directly.

Sincerely,



Sandra Nudelman

Sandra L. Nudelman  
131 Sewall Ave. #46  
Brookline, MA 02446  
May 27, 2008

Via Priority Mail and Facsimile

Marc Vianello  
c/o Arthur K. Shaffer  
Intellectual Property Center, I.I.C  
9233 Ward Parkway, Suite 100  
Kansas City, MO 64114

**Re: Marc Vianello v. Sandra L. Nudelman**  
**91/180471**

Dear Mr. Vianello:

As you know, on May 7, 2008, in response to a voicemail from the attorney representing the Opposer, Applicant sent Opposer a facsimile noting that she would be unable to attend the deposition that Opposer had unilaterally scheduled for May 15, 2008 in Brooklyn, NY. At the time Applicant sent the facsimile response, she noted that she had recently moved from Dix Hills, NY to Brookline, MA and because of this move, and because of significant out-of-town travel, she had not had the opportunity to consult or retain new counsel there. Applicant has since filed a Change of Correspondence Address Form with the Court, which will be served to

Opposer under separate cover. Applicant has not received any response to her facsimile communication from the Opposer or attorneys representing the Opposer.

Applicant has since been advised that the discovery demands sent by Opposer to Applicant on April 14, 2008 were premature and improper because the Opposer failed to comply with FRCP 26(d), FRCP 26(f) and 37 CFR 2.120. The Opposer never attempted, in good faith, to hold the required discovery plan conference or work out a discovery schedule with the Applicant, pursuant to FRCP 26(f), prior to initiating discovery demands, as required by CFR 2.120 and FRCP 26(d). The rule set forth in 37 CFP 2.120 expressly states:

**(2) The discovery conference shall occur *no later than the opening of the discovery period*, and the parties must discuss the subjects set forth in Federal Rule of Civil Procedure 26(f) and any subjects set forth in the Board's institution order. [Emphasis added.]**

Similarly, as stated in FRCP 26(d), unless leave of Court is obtained, interrogatories may not be served prior to the meeting of the parties under FRCP Rule 26(f):

**(1) *A party may not seek discovery from any source before the parties have conferred as required by Rule 26(f)*, except in a proceeding exempted from initial disclosure under Rule 26(a)(1)(B), or when authorized by these rules, by stipulation, or by court order. [Emphasis added.]**

Applicant holds that:

1. The Opposer had a burden to schedule and hold a discovery plan conference, as required by rule FRCP 26(f), prior to initiating any discovery demands, including interrogatories and document requests, as required by CFR 2.120 and FRCP 26(d).

2. Contrary to CFR 2.120 FRCP 26(d), no discovery plan conference was scheduled or held, no mutually-agreeable discovery plan was stipulated to by Applicant and Opposer, and the leave of the Court was not obtained before the Opposer's unilateral demands for discovery were made to the Applicant.
3. No attempt was made by Opposer to schedule or hold a discovery plan conference, and no mutually-agreeable discovery plan stipulated to by Applicant and Opposer after Applicant's facsimile response to Opposer on May 7, 2008 or prior to the close of the discovery period on May 18, 2008.
4. Since the discovery period has now expired, and no discovery plan conference was initiated or held by the Opposer, Opposer has waived any right to further discovery under CFR 2.120 and FRCP 26(d).

Sincerely,



Sandra Nudelman

131 Sewall Ave. #46

Brookline, MA 02446

*Applicant*

Certificate of Service

I hereby certify that a copy of the foregoing letter has been served by Priority Mail, postage prepaid, to Arthur K. Shaffer, Intellectual Property Center, LLC, 9233 Ward Parkway Suite 100, Kansas City, MO 64114 and by facsimile to Arthur K. Shaffer, Intellectual Property Center, LLC at (816) 363-1201 on this 27<sup>th</sup> day of May, 2008.



**Sandra L. Nudelman**

**131 Sewall Ave. #46**

**Brookline, MA 02446**



Sent Via First Class Mail  
May 27, 2008

Sandra L. Nudelman  
131 Sewall Ave. # 46  
Brookline, MA 02446

Re: Marc Vianello v. Sandra Nudelman  
Opposition No. 91/180471

Ms. Nudelman:

In response to your letter dated May 27, 2008, Applicant's failure to provide the requested discovery, which includes interrogatories, document requests, and your duly noticed deposition, is noted. Your basis for refusing to comply with Opposer's discovery requests, however, is baseless, and Opposer requests immediate compliance in providing the requesting discovery.

Contrary to your contentions, Opposer's discovery demands were proper and in compliance with 37 CFR 2.120 and the Federal Rules of Civil Procedure in force at the time the above referenced opposition proceeding was filed. Specifically, the amended provisions at 37 CFR 2.120 you cite in your letter are applicable only to cases commenced on or after November 1, 2007 (see:[http://www.uspto.gov/web/offices/com/sol/notices/72fr42242\\_FinalRuleChart.pdf](http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf)).

The case in question was commenced on October 31, 2007, and so the amended rules do not apply.

Therefore, Opposer requests immediate compliance with the discovery requests. Compliance includes: (1) production of responsive documents; (2) providing proper written responses to Opposer's interrogatories; and (3) rescheduling your deposition, which you have unilaterally cancelled. In addition, Opposer has received notice that Applicant's address has changed from that previously provided in the record and hopes Applicant will notify the board in advance of any further changes of correspondence.

Finally, we understand you have refused to obtain counsel; however, your decision to proceed *pro se* does not excuse you from compliance with the rules applicable to the present matter. We trust that you will conduct yourself accordingly in the future and will not make additional frivolous objections.

Sincerely,

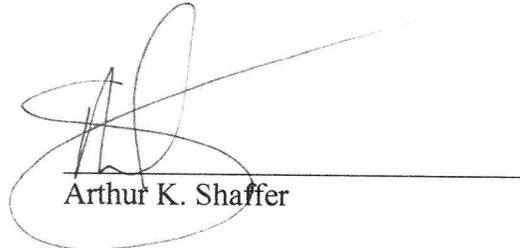
INTELLECTUAL PROPERTY CENTER, LLC

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

Arthur K. Shaffer

Certificate of Service

I hereby certify that a copy of the foregoing Opposer's First Set of Interrogatories to Applicant has been served by first class mail, postage prepaid, on Sandra L. Nudelman, 131 Sewall Ave. #46, Brookline, MA 02446 this 27<sup>th</sup> day of May, 2008.



Arthur K. Shaffer

INTELLECTUAL PROPERTY CENTER, LLC  
9233 Ward Parkway  
Suite 100  
Kansas City, MO 64114  
Phone: (816) 363-1555  
Facsimile: (816) 363-1201  
E-mail: [ashaffer@theIPCenter.com](mailto:ashaffer@theIPCenter.com)

Sandra L. Nudelman  
131 Sewall Ave. #46  
Brookline, MA 02446  
June 2, 2008

Via Priority Mail and Facsimile

Marc Vianello  
c/o Arthur K. Shaffer  
Intellectual Property Center, LLC  
9233 Ward Parkway, Suite 100  
Kansas City, MO 64114

**Re: Marc Vianello v. Sandra L. Nudelman**

**91/180471**

Dear Mr. Vianello:

I would first like to correct some of the misstatements in the letter of your counsel dated May 27, 2008:

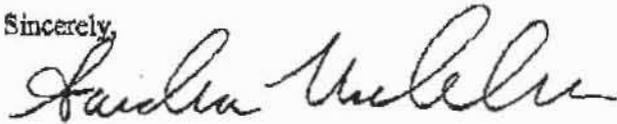
1. I did not unilaterally cancel my deposition. As noted in my fax to your counsel on May 7, 2008, which I referenced in my letter dated May 27, and which you did not deny receiving thereafter, I was willing at that time to re-schedule the deposition that your counsel had unilaterally scheduled for May 15. However, neither you nor your counsel responded to that request for re-scheduling by the close of the discovery period on May 18, 2008. As such, I hold that you have

waived the right to conduct a deposition. As a show of good faith, however, I am willing to provide answers to your requested written interrogatories and to provide the requested documentation.

2. **I have not refused to obtain counsel.** Again, as stated in my fax to your counsel dated May 7, 2008, between my move to Massachusetts and the fact that my job requires me to be out of town ~75% of the time, and nearly the entire work week, it has been difficult for me to find appropriate representation at my new location.

Furthermore, I would like to stipulate that all future service to me be conducted via e-mail in addition to traditional mail service, as this will significantly expedite my ability to respond to your requests in a timely fashion. Also, please do not use facsimile as a means of communication with me again, as I do not have a regular facsimile number.

Sincerely,



Sandra Nudelman

sandranudelman@gmail.com

131 Sewall Ave. #46

Brookline, MA 02446

*Applicant*

Certificate of Service

I hereby certify that a copy of the foregoing letter has been served by Priority Mail, postage prepaid, to Arthur K. Shaffer, Intellectual Property Center, LLC, 9233 Ward Parkway Suite 100, Kansas City, MO 64114 and by facsimile to Arthur K. Shaffer, Intellectual Property Center, LLC at (816) 363-1201 on this 2nd day of June, 2008.



Sandra L. Nudelman

131 Sewall Ave. #46

Brookline, MA 02446



A. With respect to Applicant's Affirmative Defense #1, that Opposer's Notice of Opposition fails to state a claim for which relief can be granted, and fails to state legally sufficient grounds for sustaining the opposition:

(a) While Opposer registered THE JUDICIAL VIEW under U.S. Serial #77031981 on March 25, 2008, the scope of this registration is limited to International Class 041 for "Publication of an online legal newspaper" which is unrelated to the class under which the Applicant filed JUDICIAL REVIEW, namely Class 045 for "Legal services, and Background investigative research and services."

(b) Opposer's second application concerning THE JUDICIAL VIEW, U.S. Serial #77212172, was filed on June 21, 2007, *four months after Applicant's filing date* for JUDICIAL REVIEW.

(c) Opposer's second application concerning THE JUDICIAL VIEW, U.S. Serial #77212172, filed on June 21, 2007, is of uncertain status, as an ex parte appeal of a final refusal to register the applied for mark is pending before the Trademark Trial and Appeal Board.

(d) Even given the uncertain status of Opposer's second application concerning THE JUDICIAL VIEW, U.S. Serial #77212172, the scope of said application is limited to International Class 038 for "providing *e-mail notification alerts* of recent court decisions to others," and International Class 041 for "Providing *on-line publications in the nature of newspapers, newsletters, magazines, and articles in the field of law*, classified advertising, display and text advertising, law review, legal case summaries, feature articles, current events, civil rights, finance and banking, communications, immigration, education, politics, administrative law, agriculture, intellectual property, antitrust, bankruptcy, civil procedure, civil remedies, commercial contracts, computer and technology, conflicts at law, constitutional law, criminal justice, corporate and shareholder law, employment law, energy and utilities, environmental law, expert witness, family law, health, immigration, international law, lost profits, *maritime* and marine, military, products liability, professional malpractice, real and personal property, securities law, federal, state and local taxation, torts and personal injury, veterans, wills, trusts and estates, sports, entertainment, art, government, insurance, transportation, business valuation, alternative dispute resolution and legal matters; on-line journals, namely, blogs featuring information on recent court decisions, current events, civil rights, finance and banking, communications, immigration, education, politics, administrative law, agriculture, intellectual property, antitrust, bankruptcy, civil procedure, civil remedies, commercial contracts, computer and technology, conflicts at law, constitutional law, criminal justice, corporate and shareholder law, employment law, energy and utilities, environmental law, expert witness, family law, health, immigration, international

law, lost profits, maritime and marine, military, products liability, professional malpractice, real and personal property, securities law, federal, state and local taxation, torts and personal injury, veterans, wills, trusts and estates, sports, entertainment, art, government, insurance, transportation, business valuation, alternative dispute resolution and legal matters” [emphasis added]. Again, this is very different from Applicant’s application for JUDICIAL REVIEW under International Class 045 for “Legal services, and Background investigative research and services.”

(e) Finally, as Applicant filed for the mark JUDICIAL REVIEW under Section 1(b), and asserts that she has not yet used the mark in commerce yet, and has not yet received a notice of allowance, there is no basis for which the Opposer to assert past customer confusion, or damages to which he might claim potential relief.

B. With respect to Applicant’s Affirmative Defenses #2-4, that Applicant’s use of the mark JUDICIAL REVIEW is not likely to cause confusion with THE JUDICIAL VIEW name for three reasons:

(1) Opposer’s applications for THE JUDICIAL VIEW, U.S. Serial #77031981 and #77212172, are both filed under International Class 041 for “newspaper publications.” Applicant does not intend to use the mark JUDICIAL REVIEW for newspaper publications. In order to provide online content, Applicant properly registered under the International Class pertaining to that content, Class 045 for “Background investigation and research services” and “Legal services.” Given that Opposer’s services primarily pertain to newspaper publications, and Applicant’s services primarily pertain to legal services and research, customers are unlikely to be confused by the two offerings, unless Opposer seeks to encroach upon International Class 045 in his offerings.

(2) Further, unlike THE JUDICIAL VIEW, the term JUDICIAL REVIEW carries a specific definition, separate and apart from the definitions of its component terms. JUDICIAL REVIEW is defined in the Oxford English Dictionary (for the U.S.) as “review by the Supreme Court of the constitutional validity of a legislative act.” Therefore, the primary connotation of JUDICIAL REVIEW is a reference to the power granted to the judiciary that enforces a balance of power between the three branches of government. Applicant wanted to imply the ability to create such a “balance of power” between judges and the attorneys before them through the use of Applicant’s services. THE JUDICIAL VIEW does not have a specific definition in the Oxford English Dictionary apart from definitions that could be implied by its component terms (e.g., the perspective of the judiciary), which is very different from the literal definition of JUDICIAL REVIEW.

(3) Even if the components of the term JUDICIAL REVIEW are abstracted and taken to mean a “review” of the “judiciary,” this is still substantively different from the meaning implied by THE JUDICIAL VIEW because this would mean JUDICIAL REVIEW implies a third-party perspective **ON** the judiciary, whereas THE JUDICIAL

VIEW implies the perspective OF the judiciary. End-users would expect entirely different services based on these meanings.

3. A. Applicant and the corporation in which she holds a majority stake, Judicial Intelligence, Inc., are expected to sell services bearing the Judicial Review mark. All end-users, as identified in B(7-9) above, are expected to buy or intend to buy services bearing the Judicial Review mark.

B. As stated in I.B.(vii-viii) above, attorneys are intended to use the services described in I(A), above.

4. Applicant was solely involved in the origination, clearance, selection and adoption of the Judicial Review mark to identify the services outlined in I(A) above. Applicant initially applied for a trademark for the term on February 18, 2007 (U.S. Serial #77110266). The term JUDICIAL REVIEW was selected for two reasons:

(1) it contained the word "judicial," which was indicative of the underlying judicial research facilitated by her services, and

(2) as stated in 2.B.(2), the term JUDICIAL REVIEW carries a specific definition, separate and apart from the definitions of its component terms. JUDICIAL REVIEW is defined in the Oxford English Dictionary (for the U.S.) as "review by the Supreme Court of the constitutional validity of a legislative act." Therefore, the primary connotation of JUDICIAL REVIEW is a reference to the power granted to the judiciary that enforces a balance of power between the three branches of government. Applicant wanted to imply the ability to create such a "balance of power" between judges and the attorneys before them through the use of Applicant's services.

Applicant conducted two searches when applying for her mark on February 18, 2007-- one for the exact term "Judicial Review," and a second for the exact term "Judicial Intelligence." The second of these resulted in application U.S. Serial # 77110263, which was given a Notice of Allowance on November 6, 2007. No other searches were conducted, and no records were retained of those searches, as no active applications appeared in the Trademark Electronic Search System (TESS) at the time under class 045.

5. Applicant first became aware of Opposer's use of THE JUDICIAL VIEW mark on September 13, 2007 after the opposition papers against Applicant's application. Applicant received a phone call (to the number listed in the Applicant's trademark application) on September 12, 2007, asking suspicious questions regarding Applicant's business and the names of the services rendered. At the time, the Applicant was only in the process of fundraising for her company, and presentations regarding the nature of the services rendered had been exceedingly limited, leading her to question whether the inquiry had been prompted by a competitor who may have noticed her trademark application. This prompted Applicant to check on the status of her trademark application on the Trademark Applications and Registrations Retrieval (TARR) website on September 12, 2007, and found that Opposer had filed an opposition to the application.

Applicant denies having any prior or additional knowledge of, or interest in Opposer's use or offering of services under THE JUDICIAL VIEW mark.

6. Applicant has no knowledge of any occurrences of actual confusion resulting from contemporaneous use or offering of the JUDICIAL REVIEW mark by the Applicant and THE JUDICIAL VIEW mark by Opposer.

7. A. Neither Applicant, nor the corporation in which she holds a majority stake, Judicial Intelligence, Inc., has advertised services under the JUDICIAL REVIEW mark in a magazine or trade journal, but reserves the right to do so in the future.

B. Neither Applicant, nor the corporation in which she holds a majority stake, Judicial Intelligence, Inc., has made trade presentations, seminar or meetings under the JUDICIAL REVIEW mark, but reserves the right to do so in the future.

C. Neither Applicant, nor the corporation in which she holds a majority stake, Judicial Intelligence, Inc., has used the JUDICIAL REVIEW mark to promote itself or its services using any other media, but reserves the right to do so in the future.

8. Applicant is primarily responsible for marketing, advertising, sales and distribution of all services made or intended for sale.

9. Neither Applicant, nor the corporation in which she holds a majority stake, Judicial Intelligence, Inc., has engaged any advertising agencies, marketing agencies or other business entities to advertise or promote Applicant's services bearing the JUDICIAL REVIEW mark.

10. Applicant has no knowledge of any agreements entered into relating to the JUDICIAL REVIEW mark.

11. Applicant has no knowledge of any interview, surveys or public opinion polls pertaining to the JUDICIAL REVIEW mark.

12. A. Applicant has only registered JUDICIAL REVIEW through the current trademark application (U.S. Serial #77110266) to the United States Patent and Trademark Office. Application was filed under Section 1(b) on an intent to use basis on February 18, 2007, pertaining to International Class 045 for background investigation and research services and legal services.

B. No applications listed in subpart "A" above were abandoned.

13. Applicant has not made any objections or instituted legal proceeding against any third parties' use of trade names, trademarks, service marks or other designations based on Applicant's rights to the JUDICIAL REVIEW mark.

14. Applicant has no knowledge of any objections made by third parties or legal proceedings instituted by third parties against the Applicant, aside from Opposer's

current opposition to the JUDICIAL REVIEW trademark (Opposition # 91180471, mailed October 31, 2007).

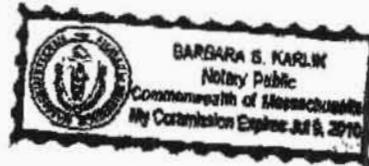
15. The Applicant had sole responsibility in preparing the answers to these interrogatories and the responses to the contemporaneously served first requests for production of documents.

16. Applicant has no knowledge of such documents.

17. None identified so far, but Applicant reserves the right to retain expert witnesses going forward.

*Sandra Nudelman*

Sandra Nudelman  
131 Sewall Ave #46  
Brookline, MA 02446  
Applicant



Certificate of Service

I hereby certify that a copy of the foregoing answer to the Opposer's First Set of Interrogatories to Applicant has been served by priority mail, postage prepaid, and facsimile to Arthur K. Shaffer, Intellectual Property Center, LLC, 9233 Ward Parkway Suite 100, Kansas City, MO 64114, this 2<sup>nd</sup> day of June, 2008.



SANDRA NUDELMAN

131 Sewall Ave. #46

Brookline, MA 02446

Applicant



DATE: June 2, 2008

Respectfully submitted,



SANDRA NUDELMAN

sandranudelman@gmail.com

131 Sewall Ave. #46

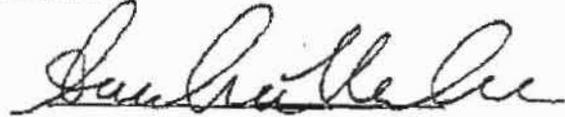
Brookline, MA 02446

Applicant



Certificate of Service

I hereby certify that a copy of the foregoing answer to the Opposer's First Set of Document Requests to Applicant has been served by priority mail, postage prepaid, and facsimile to Arthur K. Shaffer, Intellectual Property Center, LLC, 9233 Ward Parkway Suite 100, Kansas City, MO 64114, this 2<sup>nd</sup> day of June, 2008.



SANDRA NUDELMAN

131 Sewall Ave. #46

Brookline, MA 02446

Applicant

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

Marc Vianello	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No.:91180471
	)	
Sandra Nudelman	)	
	)	
Applicant.	)	

**OPPOSER’S COMBINED MOTION TO COMPEL  
AND MOTION TO EXTEND DISCOVERY AND TRIAL DATES**

Pursuant to Rules 26 and 37 of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice, Opposer Marc Vianello (“Opposer”) respectfully moves the Board for an order compelling Applicant Sandra Nudelman. (“Applicant”) to make herself available to Opposer’s Deposition Request without objections.

In addition, Opposer requests an extension of the discovery period for the limited purpose of allowing Opposer (and not Applicant) time to consider Applicant’s deposition testimony as ordered by the Board, and to pursue follow-up discovery if necessary.

Such an order is appropriate because Applicant failed entirely to respond to Opposer’s Interrogatories and Document Requests prior to the Discovery cut-off date and Applicant failed to make herself available for the scheduled Deposition and has since stated that she will not comply with Opposer’s deposition request. Counsel for Opposer has made good faith efforts to resolve the issues with Applicant but, to date, such efforts have been unsuccessful.

## I. BACKGROUND

On October 31, 2007, Opposer filed a Notice of Opposition against Application Serial No. 77/110,266 for Ms. Nudelman's mark for "background investigation and research services" and "legal services." Opposer asserts, among other things, that it owns the distinctive marks shown in Serial Nos. 77/031,981, 77/212,172, ("the Vianello Marks") for various electronic and print publication needs<sup>1</sup>. Opposer also asserts that he has extensively used and promoted the Vianello marks in the United States since at least as early as September 1, 2007 (Not. of Opp. ¶¶ 2-5), well prior to the date of Applicant's use of Applicant's mark which was filed as an Intent to Use and no Statement of Use has been entered. As grounds for the opposition, Opposer alleges priority of use and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C § 1052(d) and dilution under Section 43(c) of the Trademark Act 15 U.S.C. § 1125(c). (Not. of Opp. ¶¶ 6-8).

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<sup>1</sup> THE JUDICIAL VIEW, U.S. Application Serial No. 77/031,981, filed October 30, 2006, in international class 041 for "publication of an online legal newspaper," and THE JUDICIAL VIEW, U.S. Application Serial No, 77/212,172, filed June 21, 2007, in international class 038 for "providing e-mail notification alerts of recent court decisions to others" and in international class 041 for "providing on-line publications in the nature of newspapers, newsletters, magazines, and articles in the field of law, classified advertising, display and text advertising, law review, legal case summaries, feature articles, current events, civil rights, finance and banking, communications, immigration, education, politics, administrative law, agriculture, intellectual property, antitrust, bankruptcy, civil procedure, civil remedies, commercial contracts, computer and technology, conflicts at law, constitutional law, criminal justice, corporate and shareholder law, employment law, energy and utilities, environmental law, expert witness, family law, health, immigration, international law, lost profits, maritime and marine, military, products liability, professional malpractice, real and personal property, securities law, federal, state and local taxation, torts and personal injury, veterans, wills, trusts and estates, sports, entertainment, art, government, insurance, transportation, business valuation, alternative dispute resolution and legal matters; on-line journals, namely, blogs featuring information on recent court decisions, current events, civil rights, finance and banking, communications, immigration, education, politics, administrative law, agriculture, intellectual property, antitrust, bankruptcy, civil procedure, civil remedies, commercial contracts, computer and technology, conflicts at law, constitutional law, criminal justice, corporate and shareholder law, employment law, energy and utilities, environmental law, expert witness, family law, health, immigration, international law, lost profits, maritime and marine, military, products liability, professional malpractice, real and personal property, securities law, federal, state and local taxation, torts and personal injury, veterans, wills, trusts and estates, sports, entertainment, art, government, insurance, transportation, business valuation, alternative dispute resolution and legal matters."

On October 31, 2007, the Board instituted this proceeding and set discovery to open on November 20, 2007, and to close on May 18, 2008. Applicant's Answer to the Notice of Opposition was due December 10, 2007.

On December 10, 2007, Applicant filed an answer denying the essential allegations in the Notice of Opposition. On April 14, 2008, Opposer served the Applicant with Opposer's First Request for the Production of Documents and Opposer's First Set of Interrogatories to Applicant. (Copies of these Requests are attached as Exhibit A.) Responses to Opposer's discovery requests were due May 14, 2008. On April 19, 2008 Opposer served Applicant with Opposer's Request for Deposition (copy of which is attached as Exhibit B). This deposition was scheduled to be conducted in Brooklyn, NY on May 15, 2008 near Applicant's address in the city of Applicant's residence as listed with the TTAB.

Opposer's requests were all served on Applicant within the time permitted by 37 CFR § 2.120(a) and were in compliance with all applicable discovery rules. The deposition was noticed in compliance with Fed. R. Civ. P. 30(b) and 37 CFR § 2.120(a). The deposition was scheduled to be completed at an appropriate venue in accordance with 37 CFR § 2.120(b) based on Applicant's residential address contained in the record.

On May 7, 2008, after a phone call by Opposer on May 6 confirming receipt of said notices, Applicant sent Opposer notice via fax (attached as Exhibit C) indicating that Applicant needed to reschedule the deposition because she was unavailable. In addition, she notified Applicant that it would be more convenient if Opposer would send future communications to Applicant's home address, which was different from that listed with the TTAB.

More than ten days after a response was due, On May 27, 2008, Applicant sent Opposer's attorney a letter refusing to provide discovery (attached as Exhibit D). In the letter, Applicant stated that Opposer's discovery demands were premature and improper because "Opposer never attempted, in good faith, to hold required Discovery Plan Conference or work out a Discovery schedule with the Applicant...prior to initiating Discovery demands..." In addition, Applicant stated that because leave of court was not obtained prior to Opposer's "unilateral discovery demands" and because Opposer made no attempt to schedule or hold a Discovery Plan Conference, Opposer had waived any right to further Discovery.

Opposer then responded via First Class Mail on May 27, 2008 (attached as Exhibit E) to Applicant's May 27, 2008 letter demanding compliance with Opposer's Discovery Requests, referring Applicant to the relevant rules and suggesting she obtain counsel. Specifically, Opposer requested compliance by (1) producing documents responsive to Opposer's request for production, (2) providing written responses to Opposer's interrogatories, and (3) rescheduling her deposition.

On June 2, 2008, via facsimile, Applicant provided written responses to Opposer's First Set of Document Requests and Interrogatories. However, Applicant has still refused to comply with Opposer's Deposition request as stated in her June 2, 2008 transmittal letter (attached as Exhibit F).

## **II. MOTION TO COMPEL**

### **A. Opposer Has Made a Good Faith Effort to Work with Applicant**

In accordance with Trademark Rule 2.120(e), Opposer submits that it has made a good faith effort to resolve with Applicant the issues presented in the motion.

Specifically, Opposer has contacted Applicant and requested that she comply with Discovery Demands and that she obtain competent counsel, but Applicant has not responded timely to Opposer's Requests and has made it abundantly clear that she will not. As detailed above, Applicant has not responded timely to Opposer's discovery requests, and has informed Opposer that such testimony will not be forthcoming in the foreseeable future.

### **B. Applicant Forfeited its Right to Object**

The Trademark Trial and Appeal Board Manual of Procedure ("TBMP") provides that a party that fails to comply with discovery requests and deposition requests during the time allowed therefor, and which is unable to show that its failure was the result of excusable neglect, may be found, upon motion to compel filed by the propounding party, to have forfeited its right to object to discovery on the merits. See TBMP §§ 403.03 and 407.01, citing Bison Corp. V. Perfecta Chemie B.V., 4 U.S.P.Q.2d 1718 (TTAB 1987); Luehrmann v. Kwik Kopy Corp., 2 U.S.P.Q.2d 1303 (TTAB 1987).

Notice was sent on April 19, 2008 scheduling Applicant's deposition for May 15, 2008, prior to the close of discovery. Applicant failed to appear or make herself available pursuant to the notice. Applicant's discovery responses were due on or before May 14, 2008. Applicant's belated responses were received on June 2, 2008, more than ten days after discovery had closed and more than three weeks after they were due. As we are now more than three weeks beyond the close of discovery and into the testimony period without receiving the requested discovery, Opposer is placed at a disadvantage in determining what testimony to seek in order to bolster its claims and rebut Applicant's assertions. Accordingly, Opposer respectfully requests that the Board order Applicant to fully respond to Opposer's Notice of Deposition without objections within the first twenty days from the mailing date of the Board's order on this motion.

### **III. MOTION TO EXTEND**

In accordance with Fed. R. Civ. P. 6(b), Opposer hereby moves the Board for a thirty (30) days extension of the discovery period for the limited purpose of allowing Opposer (and not Applicant) time to review Applicant's deposition responses as ordered by the Board, and to pursue follow-up discovery if necessary. Opposer also requests an extension of its testimony periods.

As detailed above, Opposer has been diligent during the discovery period. Opposer served discovery prior to the discovery cut-off and after receipt of Applicant's Answer to the Notice of Opposition. Opposer has also expended considerable expense in obtaining local counsel and making counsel available for the Scheduled Deposition.

Opposer also made a good faith effort to resolve this matter before filing a motion to compel. Applicant, on the other hand, has not proceeded in good faith, denying all of Opposer's discovery requests and failing to review the rules governing this proceeding.

Opposer does not seek an extension of time for purposes of delay. It is requested that the limited thirty (30) day extension run from the date of service of Applicant's discovery responses as ordered by the Board, and that the discovery period be otherwise closed.

#### **IV. CONCLUSION**

For the reasons stated above, Opposer respectfully requests that the Board grant Opposer's motion to compel and order Applicant to respond to Opposer's Notice of Deposition without objections within twenty days from the mailing date of the Board's ruling on the motion. Opposer also respectfully requests that the Board grant Opposer's motion for an extension of the discovery period for the limited purpose of allowing Opposer (and not Applicant) time to review Applicant's discovery responses as ordered by the Board, and to pursue follow-up discovery if necessary. Opposer requests that the extension run from the date of service of Applicant's discovery responses as ordered by the Board, and that the discovery period be otherwise closed. Opposer requests that its testimony period be re-set to follow close of its discovery.

Dated: \_\_\_\_\_

Respectfully submitted,

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Attorney for Opposer,  
Marc Vianello

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

Mailed: August 6, 2008

Opposition No. 91180471

Marc Vianello

v.

Sandra L. Nudelman

George C. Pologeorgis, Interlocutory Attorney:

This case now comes up on opposer's motion, filed June 19, 2008, to compel the discovery deposition of applicant, Sandra L. Nudelman, as well as to reopen discovery and reset trial dates. Applicant has failed to file a brief in response to opposer's motion. Accordingly, opposer's motion to compel the discovery deposition of Sandra L. Nudelman, reopen discovery and reset trial dates is hereby granted as conceded.<sup>1</sup> See Trademark Rule 2.127(a).

In view thereof, applicant is required to make herself available and to attend the discovery deposition which must

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<sup>1</sup> Trademark Rule 2.127(a) reads, in relevant part, as follows: "When a party fails to file a brief in response to a motion, the Board may treat the motion as conceded." Moreover, the Board finds that opposer has made a good faith effort to resolve the parties' discovery dispute prior to seeking Board intervention, as required by Trademark Rule 2.120(e) (1).

be re-noticed and completed by opposer within **thirty days** from the mailing date of this order. Should applicant fail to appear or make herself available for the discovery deposition ordered herein, then opposer's remedy will lie in a motion for entry of sanctions, in the form of entry of judgment sustaining the opposition. See Trademark Rule 2.120(g)(1).

Proceedings are hereby resumed. Although discovery was already closed when proceedings were suspended pending disposition of opposer's motion to compel, the discovery period is reset as indicated below for the limited purpose of allowing opposer to take follow-up discovery, if necessary. Applicant is precluded from propounding any discovery at this juncture. Trial dates are also reset as follows:

DISCOVERY TO CLOSE (limited to opposer's follow-up discovery and to notice and take the discovery deposition of Sandra L. Nudelman)	<b>October 10, 2008</b>
Thirty-day testimony period for party in position of plaintiff to close:	<b>January 8, 2009</b>
Thirty-day testimony period for party in position of defendant to close:	<b>March 9, 2009</b>
Fifteen-day rebuttal testimony period for plaintiff to close:	<b>April 23, 2009</b>

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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**NEWS FROM THE TTAB:**

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:  
<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>  
[http://www.uspto.gov/web/offices/com/sol/notices/72fr42242\\_FinalRuleChart.pdf](http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf)

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:  
<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>

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

In the matter of application )  
Serial No.: 77/110,266 )  
 )  
Filed: February 18, 2007 )  
 )  
Applicant: Sandra L. Nudelman )  
 )  
Mark: JUDICIAL REVIEW )  
 )  
Published: August 14, 2007 )  
 )  
\_\_\_\_\_)  
MARC VIANELLO, )  
 )  
Opposer, )  
 )  
v. )  
 )  
SANDRA L. NUDELMAN, )  
 )  
Applicant, )  
\_\_\_\_\_)

Opposition No. 91180471

OPPOSER’S SECOND NOTICE OF DOCUMENT REQUESTS TO APPLICANT

Pursuant to Fed. R. Civ. P. 34 and 37 C.F.R. § 2.120(d)(2), Opposer, Marc Vianello, by its undersigned attorneys, hereby serves the following Motion to Compel Production of Documents on Applicant.

Instructions and Definitions

The definitions provided in Opposer’s First Set of Interrogatories to Applicant are incorporated herein by reference.

Opposer reincorporates all requests provided in Opposer’s First Set of Document Requests to Applicant and supplements requests.

## Requests

### Request No. 1

All documents identified by Applicant in her responses to Opposer's Deposition to Applicant.

### Request No. 2

All documents relating to the use of the JUDICIAL REVIEW in commerce by Applicant.

### Request No. 3

All documents concerning any trademark searches that Applicant or its representatives or agents (including without limitation its attorneys) performed in connection with the mark JUDICIAL REVIEW.

### Request No. 4

All documents comprising, constituting, concerning or relating to advertising, promoting or marketing of any services under the mark JUDICIAL REVIEW by Applicant.

### Request No. 5

All documents referenced by Applicant and/or requested by Opposer during the deposition of Sandra L. Nudelman on August 29, 2008, comprising, constituting, concerning or relating to the mark JUDICIAL REVIEW including, but not limited to: the Business Plan (Nudelman Dep. 14:18-22, 15:16-18, August 29, 2008) (including, but not limited to all Copies of the Business Plan, Market Study Reports, Competitor Reports, Marketing Analysis, Marketing Plan, Development Plan, and Detail of Subscription Based Model, Exit Strategy), all Subsequent revisions of the Business Plan (Nudelman Dep. 16:12, 21:7, August 29, 2008), and PowerPoint slides of the Business Plan as used in the Presentation at the Harvard Business School Business Plan Contest (Nudelman Dep. 99:8, August 29, 2008).

MARC VIANELLO

Respectfully submitted,

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ARTHUR K. SHAFFER  
Patent Office Reg. No. 50,257  
INTELLECTUAL PROPERTY CENTER, LLC  
9233 Ward Parkway, Suite 100  
Kansas City, Missouri 64114  
Telephone: (816) 363-1555  
Facsimile: (816) 363-1201

Attorney for Opposer

Certificate of Service

I hereby certify that a copy of the foregoing Opposer's Second Set of Document Requests to Applicant has been served via electronic mail and first class mail, postage prepaid, on Sandra L. Nudelman 131 Sewall Ave. #46, Brookline, Massachusetts 02446, this 24 day of September, 2008.

---

Arthur K. Shaffer  
Intellectual Property Center, LLC  
9233 Ward Parkway, Suite 100  
Kansas City, MO 64114  
Telephone: (816) 363-1555  
Facsimile: (816) 363-1201  
ashaffer@theipcenter.com

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

Marc Vianello	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No.:91180471
	)	
Sandra Nudelman	)	
	)	
Applicant.	)	

**OPPOSER’S MOTION TO COMPEL**

Pursuant to Rules 26 and 37 of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice, Opposer Marc Vianello (“Opposer”) respectfully moves the Board for an order compelling Applicant Sandra Nudelman (“Applicant”) to comply with Opposer’s Second Request to produce documents without objections.

Applicant has failed to respond and provide any requested documents prior to the Extended Discovery cut-off date. Counsel for Opposer has made good faith efforts to resolve the issues with Applicant, but, to date, such efforts have been unsuccessful, including sending email and letters to Applicant requesting the same.

Opposer incorporates by reference Opposer’s Motion to Compel and to Extend Discovery and Trial Dates and is attached as Exhibit A.

**I. BACKGROUND**

As stated in Exhibit A, the present matter was initiated on October 31, 2007 when Opposer filed an opposition with the United States Patent and Trademark Office. Without reciting in detail all the facts associated with this case, Applicant will simply

rely upon the previously stated facts in the attached Exhibit A. However, background information related to the present dispute includes the filing of Opposer's Motion to Compel and Extend Discovery and Trial Dates filed by Opposer on June 19, 2008. This was filed after several attempts to resolve failures and refusal of Applicant to provide the requested Discovery.

As a result, on August 6, 2008, the Trademark Trial and Appeals Board ("TTAB") granted Opposer's Motion to Compel the Discovery Deposition of Applicant (attached as Exhibit B). Trial dates were also reset at the same time, reflecting Applicant's lack of cooperation.

Opposer's Second Notice of Deposition was served on Applicant on August 21, 2008 (attached as Exhibit C). On August 29, 2008, Applicant made herself available pursuant to the August 6, 2008 Order of the TTAB, and was deposed.

Applicant's June 2, 2008 Answer in Response to Opposer's Interrogatories and Applicant's Answer in response to Opposer's Document Requests stated that no documents were available for production (attached as Exhibit D). However, during the August 29, 2008 Discovery Deposition, Applicant stated on the record that there were documents available for production, but she did not produce them (attached as Exhibit E).

As a result, a formal request was made during the deposition for production of such documents. On September 24, 2008, Applicant was served a Second Notice of Document Request (attached as Exhibit F). To date, merely one day from the expiration of discovery, Applicant has still not produced any documents as requested in the Notice of Document Request dated April 18, 2008, on the record during the discovery deposition, and as contained in Opposer's Second Notice of Document Request.

Pursuant to F.R.C.P. 34(b)(2)(A), Ms. Nudelman has thirty days to respond and has failed to do so. Because of Applicant's failure to produce the required documents, Opposer is unable to conduct follow-up discovery and is therefore being prejudiced in its attempt to effectively oppose Applicant's registration.

The extended Discovery closing date had been previously reset to October 10, 2008 by Order of the TTAB on August 6, 2008. At this time it is unforeseeable that any response will be received from Applicant, and even if prior to such date the requested discovery is produced, Opposer will still be placed at a disadvantage in determining what follow-up discovery or testimony to seek in order to bolster its claims and rebut Applicant's assertions. Accordingly, Opposer respectfully requests that the Board order Applicant to fully respond to Opposer's Notice of Document Request without objections or any further delay within ten days from the mailing date of the Board's order on this motion.

## **II. MOTION TO COMPEL**

### **A. Opposer Has Made a Good Faith Effort to Work with Applicant**

In accordance with Trademark Rule 2.120(e), Opposer submits that it has made a good faith effort to resolve with Applicant the issues presented in the motion. Specifically, Opposer has contacted Applicant to request that she comply with its discovery demands and that she obtain competent counsel to advise her regarding her compliance. Not only has Applicant not responded timely to Opposer's Requests, but she has also made it abundantly clear that she will not. Despite the numerous requests and attempts to obtain discovery, Applicant has repeatedly refused and obstructed Opposer's discovery requests.

**B. Applicant Forfeited its Right to Object**

TBMP §§ 403.03 and 407.01 provide that a party who fails to comply with discovery requests and deposition requests during the time allowed therefore, and which is unable to show that its failure was the result of excusable neglect, may be found, upon motion to compel to have forfeited its right to object to discovery on the merits. See Bison Corp. V. Perfecta Chemie B.V., 4 U.S.P.Q.2d 1718 (TTAB 1987); Luehrmann v. Kwik Kopy Corp., 2 U.S.P.Q.2d 1303 (TTAB 1987). Therefore we respectfully request that the Applicant be compelled to respond fully to Opposer's discovery request without any further delay or any objections thereto.

**III. CONCLUSION**

For the reasons stated above, Opposer respectfully requests that the Board grant Opposer's motion to compel and order Applicant to respond to Opposer's Second Request to Produce Documents without objections within ten days from the mailing date of the Board's ruling on the present motion.

Dated: October 9, 2008

Respectfully submitted,

/s/Arthur K. Shaffer  
Attorney for Opposer,  
Marc Vianello

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

Mailed: December 31, 2008

Opposition No. 91180471

Marc Vianello

v.

Sandra L. Nudelman

**George C. Pologeorgis, Interlocutory Attorney:**

This case now comes up on opposer's motion, filed October 9, 2008 and revised on October 21, 2008, to compel applicant to answer opposer's second request for production. Applicant has failed to file a brief in response to opposer's motion. Accordingly, opposer's motion to compel discovery is hereby granted as conceded. See Trademark Rule 2.127(a).

Applicant is allowed until thirty days of the mailing date of this order to respond to opposer's second set of document requests. Moreover, these responses must be made in full and without objection because applicant failed either to timely respond or to object to opposer's discovery requests. See *No Fear Inc. v. Rule*, 54 USPQ2d 1551 (TTAB 2000). Should applicant fail to provide the ordered responses, then opposer's remedy will lie in a motion for

entry of sanctions, in the form of entry of judgment sustaining the opposition. See Trademark Rule 2.120(g)(1).

Proceedings are hereby resumed. The discovery period is reset as indicated below for the limited purpose of allowing opposer to take follow-up discovery, if necessary. Applicant is precluded from propounding any discovery at this juncture. Trial dates are also reset as follows:

DISCOVERY PERIOD TO CLOSE: (limited to opposer's follow-up discovery, if necessary)	<b>3/1/2009</b>
Testimony period for party in position of plaintiff to close: (opening thirty days prior thereto)	<b>5/30/2009</b>
Testimony period for party in position of defendant to close:(opening thirty days prior thereto)	<b>7/29/2009</b>
Rebuttal testimony period to close: (opening fifteen days prior thereto)	<b>9/12/2009</b>

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

**NEWS FROM THE TTAB:**

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:  
<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>  
[http://www.uspto.gov/web/offices/com/sol/notices/72fr42242\\_FinalRuleChart.pdf](http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf)

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:  
<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>