ESTTA Tracking number: **ESTTA258299**
Filing date: **12/31/2008**

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

Proceeding	91181380
Party	Plaintiff E. & J. Gallo Winery
Correspondence Address	Paul W. Reidl E. & J. Gallo Winery 600 Yosemite Boulevard Modesto, CA 95354 UNITED STATES paul.reidl@ejgallo.com
Submission	Motion to Reopen
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Signature	/Seth I. Appel/
Date	12/31/2008
Attachments	Mot.Reopen+Declarations.081231.pdf (17 pages)(687996 bytes)

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

E. & J. GALLO WINERY, Opposer, v. MIMULANI AG Applicant.	**Opposition No. 91181380** Opposition No. 91181381 Opposition No. 91181383 Opposition No. 91181384 Opposition No. 91181385 Opposition No. 91181386 Opposition No. 91181388 (Consolidated)

OPPOSER'S MOTION TO REOPEN DISCOVERY PERIOD

Opposer E. & J. Gallo Winery ("Opposer") respectfully moves the Board to reopen the discovery period in this matter pursuant to Rule 6(b) of the Federal Rules of Civil Procedure and 37 CFR § 2.116(a). Opposer served its first sets of discovery requests on Applicant Mimulani AG ("Applicant") on August 18, 2008, yet it did not receive any responses from Applicant until December 19—more than two months after they were due, and less than a week before the discovery period closed. Under these circumstances, Opposer's failure to serve additional discovery during the discovery period is entirely excusable and justifies the reopening of the discovery period.

FACTS

Opposer served its first sets of document requests, interrogatories, and requests for admission on Applicant on August 18, 2008. Applicant's responses were due on September 22. On September 19, Applicant's counsel, Mark Lebow, sent an email to Opposer's counsel, Paul W. Reidl, requesting two additional weeks to respond. Mr. Reidl granted this request, making Applicant's responses due on October 6. [Declaration of Paul W. Reidl ("Reidl Decl."), ¶ 2]

Opposer did not receive any discovery responses from Applicant on October 6, or in the two months that followed. [Reidl Decl., ¶ 3]

As a result of Applicant's failure to respond to Opposer's first set of discovery requests, Opposer did not conduct additional discovery. It could not conduct follow up discovery, in the nature of depositions or otherwise, since there were no responses to follow up on. Moreover, Opposer reasonably concluded that additional discovery was unnecessary, since it could establish its claims based on Applicant's failure to respond to Opposer's requests for admission, which had the effect of all requests being deemed admitted.[1] [Reidl Decl., ¶ 4]

On December 9, 2008, Opposer served a second set of requests for admission. In his cover letter, Mr. Reidl referenced Applicant's failure to serve any responses to Opposer's first set of discovery requests. [Reidl Decl., ¶ 5]

Ten days later, on December 19, Applicant's counsel, Jeffrey Goehring, sent an email to Mr. Reidl claming that Applicant had in fact served responses to Opposer's first set of discovery requests. Mr. Goehring's email included as attachments written responses that he claimed were served by mail on October 6. Opposer had not previously received these written responses. [Reidl Decl., ¶ 6 and Ex. A]

In his email, Mr. Goehring stated that the responses had been mailed to the wrong address, *i.e.*, a P.O. Box in the wrong zip code. This was reflected by the proofs of service. [*Id.*]

Opposer was shocked by Mr. Goehring's December 19 email, and by his claim that Applicant had attempted to timely serve discovery responses. This claim was particularly suspect since the responses attached to Mr. Goehring's email stated that Applicant would produce documents in response to many of Opposer's document requests, yet Applicant has never produced any documents, nor has it contacted Opposer about arrangements for an inspection. [Reidl Decl., ¶ 7]

The discovery period in this matter closed on December 25. Whether Applicant mailed discovery responses to the wrong address (as Opposer now claims), or whether Applicant did not attempt to serve discovery responses at all prior to December 19 (as Applicant suspects), there is no

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[1] FRCP 36. *See Fram Trak Indus., Inc. v. WireTracks LLC*, 2006 TTAB LEXIS 21, at *15 (TTAB 2006).

dispute that Applicant did not properly serve timely discovery responses.[2]

Assuming *arguendo* Applicant's discovery responses sent via email on December 19 are valid, Opposer will have to take follow up discovery concerning matters revealed therein. Moreover, when Applicant produces the documents that it has promised, Opposer will probably have to take follow up discovery concerning those documents, as well. Opposer may also need to conduct additional discovery concerning matters not covered by its initial requests.

After receiving Mr. Goehring's December 19 email, Opposer promptly retained outside counsel, D. Peter Harvey and Seth I. Appel of Harvey Siskind LLP. On December 29, Mr. Harvey left voicemails for, and then sent an email to, Mr. Lebow and Mr. Goehring, requesting that Applicant stipulate to extending the existing discovery and trial periods so that Opposer could complete its discovery. He received no response. [Declaration of D. Peter Harvey, ¶ 2 and Ex. A]

ARGUMENT

Reopening the discovery period is proper where a party's failure to complete discovery was the result of excusable neglect. FRCP 6(b); 37 CFR § 2.116(a).

In determining excusable neglect, the Board considers all relevant circumstances including (1) the danger of prejudice to the nonmovant; (2) the length of the delay and its potential impact on judicial proceedings; (3) the reason for the delay, including whether it was within the reasonable control of the movant; and (4) whether the movant acted in good faith. *Pumpkin, Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1997 TTAB LEXIS 24, at *12 (TTAB 1997) (*citing Pioneer Investment Services Co. v. Brunswick Associates Limited Partnership*, 507 U.S. 380 (1993)). The determination is "at bottom an equitable one." *Id.*

Here, all four *Pioneer* factors support reopening the discovery period. In short, it would be inequitable to deny Opposer the opportunity to take additional discovery.

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[2] Applicant does not claim that it emailed discovery responses to Opposer prior to December 19, even though the parties' counsel have corresponded via email throughout this proceeding.

1. Reopening the Discovery Period Will Not Cause Any Prejudice to Applicant.

Prejudice in this context means prejudice to Applicant's ability to litigate the case, such as the loss or unavailability of evidence or witnesses that otherwise would have been available. TBMP §509.01(b)(1). It does not mean inconvenience or loss of any tactical advantage. *Id.*

Reopening the discovery period cannot possibly prejudice Applicant's ability to defend against Opposer's claims. There is no reason for the Board to conclude that a single witness, or a single piece of evidence, will be unavailable because of rescheduled discovery or testimony periods. On the contrary, reopening the discovery period will allow the parties to uncover additional witnesses and evidence that may be relevant to this proceeding. *See HKG Industries, Inc. and Floodtronics, Inc. v. Perma-Pipe, Inc.*, 49 USPQ2d 1156, at *3 (TTAB 1998) (finding no "measurable prejudice" where "Respondent has made no showing of lost evidence or unavailable witnesses"); *Pumpkin*, 1997 TTAB LEXIS 24, at *19 (TTAB 1997) (finding first *Pioneer* factor supports excusable neglect because registrant "has made no showing of lost evidence or unavailable witnesses").

2. The Length of Opposer's Delay was Minimal.

Upon receiving Mr. Goehring's December 19 email claiming that Applicant had served discovery responses, Opposer immediately sprung to action. Opposer retained outside counsel and on December 29, Mr. Harvey reached out to Mr. Lebow and Mr. Goehring seeking a stipulation. Having received no responses, Opposer began preparing the present motion.

Opposer is filing this motion less than two weeks after receiving Mr. Goehring's email, and only six days after the close of the discovery period. This delay is minimal, especially in light of the holidays.

3. Opposer's Delay was Reasonable, and its Basis was Beyond the Control of Opposer.

Opposer's failure to serve additional discovery was not caused by circumstances within Opposer's control. Rather, Opposer reasonably relied on Applicant's apparent failure to serve responses to Opposer's first set of discovery requests. Opposer did not receive any responses to its first set of discovery requests until twelve days ago, even though the requests were served in

August. Even if the Board chooses to credit Applicant's claim that it mailed responses to an incorrect P.O. Box on October 6, there is no dispute that Applicant did not properly serve responses at that time. Mailing documents to the wrong address cannot constitute proper service. It would be completely inequitable to penalize Opposer for Applicant's error.

Pumpkin provides a revealing contrast. There, the Board found no excusable neglect where opposer did not present evidence during the testimony period due to the failure of opposer's counsel's docketing system. The Board explained that "opposer's failure to present evidence during its assigned testimony period was solely the result of counsel's negligence," and opposer "failed to show that anyone other than opposer and its counsel are responsible." *Pumpkin*, 1997 TTAB 24, at *18. Here, by contrast, Applicant was responsible for Opposer's failure to serve additional discovery. Opposer was prepared to conduct follow up discovery and discovery on issues not covered by its first set of discovery requests, and it would have done so if it had received any responses to its initial requests.[3]

4. Opposer has Acted in Good Faith.

Opposer has acted in good faith throughout this proceeding. Opposer served timely responses to Applicant's discovery requests; it has cooperated with Applicant's counsel for the purpose of filing two stipulations/consent motions; and it has engaged in good faith settlement negotiations. In the interest of conserving the resources of both parties, as well as the Board, Opposer contacted Applicant prior to filing the present motion in the hope of working out a stipulation.

Applicant, on the other hand, has acted in bad faith. It now claims that it mailed responses to Opposer's first set of discovery requests on October 6 (albeit to the wrong address), yet this claim appears to be untrue. If Applicant had mailed discovery responses in October,

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[3] "In undertaking the *Pioneer* analysis, several courts have stated that the third *Pioneer* factor, namely, the reason for the delay and whether it was within the reasonable control of the movant, might be considered the most important of the *Pioneer* factors in a particular case." *HKG Industries,* 1998 TTAB LEXIS 399, at *3.

Applicant also presumably would have provided documents in response to Opposer's document requests by now. Moreover, Applicant would not have needed a full ten days to resend the discovery responses after receiving Mr. Reidl's December 9 email. At any rate, if Applicant had properly served responses on October 6, Opposer would have received them long ago.

Applicant's counsel has not even bothered to respond to Opposer's counsel's communications regarding a stipulation.

CONCLUSION

For the reasons stated above, the Board should grant Opposer's motion and reopen the discovery period for ninety days.

Dated: December 31, 2008

Respectfully submitted,

HARVEY SISKIND LLP

/s/

By: Seth I. Appel

Four Embarcadero Center, 39th Floor
San Francisco, CA 94111
Telephone: (415) 354-0100
Facsimile: (415) 391-7124

Attorneys for Opposer
E. & J. Gallo Winery

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

E. & J. GALLO WINERY, Opposer, v. MIMULANI AG Applicant.	**Opposition No. 91181380** Opposition No. 91181381 Opposition No. 91181383 Opposition No. 91181384 Opposition No. 91181385 Opposition No. 91181386 Opposition No. 91181388 (Consolidated)

DECLARATION OF PAUL W. REIDL
IN SUPPORT OF OPPOSER'S MOTION TO REOPEN DISCOVERY PERIOD

I, Paul W. Reidl, declare as follows:

1. I am Associate General Counsel for Opposer E. & J. Gallo Winery ("Opposer"). I make this declaration freely and of my own personal knowledge. If I were called as a witness, I could and would competently testify to the matters set forth.

2. Opposer served its first sets of document requests, interrogatories, and requests for admission in this proceeding on Applicant Mimulani AG ("Applicant") by mail on August 18, 2008. Applicant's responses were due on September 22. On September 19, Applicant's counsel, Mark Lebow, sent me an email requesting two additional weeks to respond. I granted this request, making Applicant's responses due on October 6.

3. Opposer did not receive any discovery responses from Applicant on October 6, or in the two months that followed.

4. As a result of Applicant's failure to respond to Opposer's first set of discovery requests, we did not conduct additional discovery. We could not conduct follow up discovery, in the nature of depositions or otherwise, since there were no responses to follow up on. More importantly, we concluded that additional discovery and the retention of experts was unnecessary because Opposer could establish its claims based on Applicant's failure to respond to Opposer's requests for admission, which had the effect of all requests being deemed admitted. FRCP 36.

5. On December 9, 2008, Opposer served a second set of requests for admission. I included a cover letter with these requests, in which I referenced Applicant's failure to serve any responses to Opposer's first set of discovery requests. The cover letter explained that the requests for admission were directed toward obtaining admissions that Applicant did not have any documents to produce in response to the document requests previously served. This would be a way of establishing those facts and protecting Opposer from a last-minute disclosure at trial without having to involve the Board in a motion to compel.

6. Ten days later, on December 19, 2008, I received an email from Applicant's counsel, Jeffrey Goehring, claming that Applicant had in fact served responses to Opposer's first set of discovery requests. Mr. Goehring's email included as attachments written responses that he claimed were served on October 6. Opposer had not previously received these written responses, nor had it received the documents referenced therein that Applicant had promised to produce. Mr. Goehring acknowledged that the responses had been served on the wrong address, but he asserted that this should not have mattered to the postal service. A true and correct copy of Mr. Goehring's December 19 email (without attachments) is attached hereto as Exhibit A.

7. I was shocked by Mr. Goehring's December 19 email, and by his claim that Applicant had timely served discovery responses. This claim was particularly suspect since the responses attached to Mr. Goehring's email stated that Applicant would produce documents in response to many of Opposer's document requests, yet Applicant has never produced any documents, nor has it contacted Opposer about arrangements for an inspection.

I declare under penalty of perjury under the laws of the State of California and the United States of America that the foregoing is true and correct and that this declaration was executed this 31st day of December, 2008, in Modesto, California.

/s/

Paul W. Reidl

Exhibit A

to Declaration of Paul W. Reidl
in Support of Opposer's Motion
to Reopen Discovery Period

E. & J. Gallo Winery v. Mimulani AG

Opposition No. 91181380
(Consolidated)

From: Jeff Goehring [mailto:JGoehring@young-thompson.com]
Sent: Friday, December 19, 2008 11:46 AM
To: Reidl, Paul
Cc: Mark Lebow
Subject: Opp. No. 91181380 (Trademark GALLISS)

Dear Paul,

We received your letter dated December 9, 2008 regarding discovery. In it you state that we did not respond to your discover requests. This is not correct. Responses to each of your requests were served on October 6, 2008 and were timely. Scans of the originals are attached. As you can see, they were sent to the P.O. Box that appears on your letterhead. Have you received the responses since your December 9 letter? Delivery may be delayed due to our error in using the 95353 zip code rather than the 95354 zip code, for which we apologize for any inconvenience this may have caused. However, both zip codes appear to be in Modesto and it is likely delivery will be or has been made despite this error. The package has not been sent back to us by the post office, though we will watch for it. Please let us know if/when you received it.

Further to your request earlier this week to Mark Lebow for authority, please see below some citations to case law regarding a responding parities' duty in responding to admissions.

U.S. ex rel. Englund v. Los Angeles County, 235 F.R.D. 675, 684 (E.D. Cal. 2006)

Bouchard v. U.S., 241 F.R.D. 72, 76 (D.Me. 2007)

Herrera v. Scully, 143 F.R.D. 545, 548-49 (S.D.N.Y 1992)

Sincerely,

Jeff Goehring

Jeffrey M. Goehring
Young & Thompson
209 Madison St.
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Alexandria, VA 22314
(703) 521-6590 (direct)
Fax: (703) 685-0573
jgoehring@young-thompson.com

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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E. & J. GALLO WINERY, Opposer, v. MIMULANI AG Applicant.	**Opposition No. 91181380** Opposition No. 91181381 Opposition No. 91181383 Opposition No. 91181384 Opposition No. 91181385 Opposition No. 91181386 Opposition No. 91181388 (Consolidated)

DECLARATION OF D. PETER HARVEY
IN SUPPORT OF OPPOSER'S MOTION TO REOPEN DISCOVERY PERIOD

I, D. Peter Harvey, declare as follows:

1. I am a member of Harvey Siskind LLP, counsel for Opposer E. & J. Gallo Winery ("Opposer"). I make this declaration freely and of my own personal knowledge. If I were called as a witness, I could and would competently testify to the matters set forth.

2. On December 29, 2008, I left voicemail messages for, and then sent an email to, Mark Lebow and Jeffrey Goehring, counsel for Applicant Mimulani AG ("Applicant"). In my voicemail message to Mr. Goehring, I noted that Opposer had not received Applicant's discovery responses – which Mr. Goehring claimed had been misaddressed – prior to receiving an email from Mr. Goehring on December 19. In light of these facts I requested that Applicant stipulate to extending the existing discovery and trial periods so that Opposer could complete its discovery. As of today, neither Mr. Lebow nor Mr. Goehring has responded to my voicemails or email. My December 29 email is attached hereto as Exhibit A.

I declare under penalty of perjury under the laws of the State of California and the United States of America that the foregoing is true and correct and that this declaration was executed this 31st day of December, 2008, in San Francisco, California.

/s/

D. Peter Harvey

Exhibit A

to Declaration of D. Peter Harvey
in Support of Opposer's Motion
to Reopen Discovery Period

E. & J. Gallo Winery v. Mimulani AG

Opposition No. 91181380
(Consolidated)

Seth I. Appel

From: Peter Harvey
Sent: Monday, December 29, 2008 4:08 PM
To: 'mlebow@young-thompson.com'; 'jgoehring@young-thompson.com'
Cc: Reidl, Paul; Seth I. Appel
Subject: E & J Gallo Winery v. Mimulani - TTAB Cancellation Action
Attachments: Lebow and Goehring.081229.pdf

Dear Messrs. Lebow and Goehring:

Please see the attached letter and call me as soon as possible.

Thank you.

Sincerely,

Peter Harvey
Harvey Siskind LLP
4 Embarcadero Center, Suite 3950
San Francisco, CA 94111

Tel: 415.354.0100
Fax: 415.391.7124
email: pharvey@harveysiskind.com

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HARVEY ▪ SISKIND LLP

December 29, 2008

D. Peter Harvey

VIA ELECTRONIC MAIL

Mark Lebow, Esq.
Jeff Goehring, Esq.
Young & Thompson
209 Madison Street
Suite 500
Alexandria, Virginia 22314

Re: TTAB Cancellation No. 91181160
E&JGallo Winery v. Mimulani AG

Dear Messrs. Lebow and Goehring:

This confirms my telephone voice mail messages to you both this morning. Paul Reidl at E&J Gallo Winery has asked us to associate in as counsel in the above matter, in light of his existing obligations with respect to a very active federal court litigation.

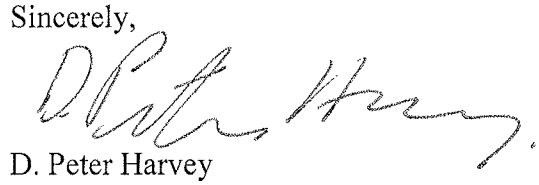
Mr. Goehring's email of December 19 forwards discovery responses dated October 6, 2008. He states that service was effected to an incorrect address. Gallo in fact did not receive these responses until Mr. Goehring's email transmitted them.

I trust you will agree that this development – and the fact that Gallo has not yet received any of the documents which Mimulani's response to Gallo's first request for production indicates will be produced – necessitates extending the existing discovery and trial deadlines in the case. At a minimum, we feel that a sixty-day extension of all dates is required. Please let us know right away if you agree, and we will prepare a stipulation and proposed order to that effect.

FOUR EMBARCADERO CENTER 39TH FLOOR SAN FRANCISCO CALIFORNIA 94111
TELEPHONE 415.354.0100 FACSIMILE 415.391.7124 WWW.HARVEYSISKIND.COM

If you wish to discuss the matter, feel free to contact either my associate, Seth Appel, or me. In light of the pending discovery cutoff, we would appreciate hearing from you as soon as possible.

Sincerely,



D. Peter Harvey

DPH:tlb

cc: Paul R. Reidl, Esq.
Seth I. Appel, Esq.

CERTIFICATE OF TRANSMISSION

I hereby certify that true and correct copies of the following documents in Opposition No. 91181380 (Consolidated) are being electronically transmitted to the Trademark Trial and Appeal Board on December 31, 2008:

- Opposer's Motion to Reopen Discovery Period
- Declaration of Paul W. Reidl in Support of Opposer's Motion to Reopen Discovery Period
- Declaration of D. Peter Harvey in Support of Opposer's Motion to Reopen Discovery Period

/s/
Seth I. Appel

Date: December 31, 2008

CERTIFICATE OF MAILING

I hereby certify that true and correct copies of the following documents in Opposition No. 91181380 (Consolidated) were served on Applicant via first-class mail, postage prepaid, addressed to Mark Lebow, Esq. and Jeff Goehring, Esq., Young & Thompson, 209 Madison Street, Suite 500, Alexandria, VA 22314, on December 31, 2008:

- Opposer's Motion to Reopen Discovery Period
- Declaration of Paul W. Reidl in Support of Opposer's Motion to Reopen Discovery Period
- Declaration of D. Peter Harvey in Support of Opposer's Motion to Reopen Discovery Period

/s/
Seth I. Appel

Date: December 31, 2008