

ESTTA Tracking number: **ESTTA265497**

Filing date: **02/09/2009**

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

Proceeding	91181380
Party	Defendant MIMULANI AG
Correspondence Address	MARK LEBOW YOUNG & THOMPSON 209 MADISON STREET, SUITE 500 ALEXANDRIA, VA 22314 UNITED STATES embon@young-thompson.com
Submission	Reply in Support of Motion
Filer's Name	Mark Lebow
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Signature	/ml/
Date	02/09/2009
Attachments	2008-02-09 Reply to Opposition to Motion to Compel.pdf (5 pages)(70316 bytes) 2009-02-09 Declaration of ML for Reply to Opp. to M. to Compel.pdf (2 pages)(56862 bytes) EX. A.pdf (2 pages)(45563 bytes) EX. B.pdf (2 pages)(17556 bytes) EX. C.pdf (4 pages)(64192 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 (consolidated)

Opposition No. 91181381

Opposition No. 91181384

Opposition No. 91181385

Opposition No. 91181386

Opposition No. 91181388

**APPLICANT MIMULANI AG'S REPLY TO
OPPOSITION TO APPLICANT'S MOTION TO COMPEL**

Counsel for Mimulani AG ("Mimulani") made more than sufficient effort to raise and resolve Mimulani's discovery dispute with counsel for Opposer E. & J. Gallo Winery ("E. & J.") and fully discharged Mimulani's duty to meet and confer regarding this dispute.

Opposer's brief in opposition mischaracterizes the parties' communications and confuses Mimulani's meet and confer duty regarding its discovery dispute with a separate and later arising discovery dispute originating from Opposer.

Mimulani's meet and confer began with its counsel sending to Opposer's counsel an email on December 16, 2008 identifying in detail each of Opposer's discovery responses that Mimulani believed deficient. The email included the manner and nature of the alleged deficiency. This email was attached to Mimulani's motion as Exhibit A and is incorporated into this Reply by reference. The email is sufficiently specific to ripen the issues upon response by Opposer and does not require further clarification to particularize Mimulani's position. Mimulani's position regarding Opposer's discovery responses was clearly and

completely set out in the email and any narrowing of the issues was the responsibility of Opposer to make substantive responses thereto. In response to the email, if Opposer conceded that some or all of its responses were deficient then the issues could have been narrowed. Absent such concession, the parties' dispute was crystallized and ripe for determination from the Board.

Opposer made an immediate, preliminary email response to the December 16 email, which was also included in Exhibit A to Mimulani's motion. The response (1) indicated that Opposer disagreed that it owed Mimulani additional discovery responses, (2) requested authority from Mimulani supporting its position, and (3) indicated that a more substantive response would be forthcoming in the following week. Mimulani's counsel followed up by emailing Opposer's counsel on the same day that "we look forward to hearing back from you upon your return from New York", thus confirming Opposer's counsel's indication that substantive responses would be forthcoming the following week. (See declaration of Mark Lebow and Exhibit A)

Applicant is not required to provide authority supporting its position that Opposer's discovery responses were deficient. Nevertheless, on December 19, 2008, in the spirit of resolving the dispute without requiring the Board's intervention, counsel for Mimulani emailed Opposer's counsel several case law citations supporting its position as has been requested. (See declaration of Mark Lebow and Exhibit B) Despite this second follow up communication, Opposer made no response, substantive or otherwise, regarding Mimulani's detailed December 16 email in the week following the email.

Parallel to this meet and confer process, alleged counsel for Opposer began to raise a separate, unrelated discovery issue regarding Opposer's alleged failure to receive Mimulani's discovery responses timely served on October 6, 2008. On the afternoon of December 29 Mimulani's counsel received voice mail messages from an attorney named Peter Harvey claiming to represent Opposer. However, Mr. Harvey was not counsel of record and had made no appearance in this proceeding and has yet to make an appearance in this proceeding as of this filing. Counsel for Mimulani also received an email/letter from Mr. Harvey on the morning of December 30, 2008 (sent after business hours, EST, on the 29th and received on the 30th).

The transcribed voicemail reads:

Hi Mr. Lebow this is Peter Harvey calling. I'm with Harvey-Siskin in San Francisco. I'm calling you in connection with the E.& J. Gallo winery case versus Mimulani, the GALLISS opposition or cancellation proceeding. I wanted to check in with you on the discovery that's recently come to light. Could you give me a call at your convenience, 515-354-0100, thanks.

(See Declaration of Mark Lebow). Mr. Harvey's letter/email is attached hereto as Exhibit C.

As is apparent, neither the voicemail nor the letter mentions Mimulani's discovery issues raised in its detailed email of December 16. Rather, each is dedicated solely to Opposer's separate discovery dispute which arose after Mimulani's December 16 email. Neither communication attempts to more substantively respond to Mimulani's email or even acknowledges that such a substantive response is overdue.

Opposer's brief at page 2, and Peter Harvey's declaration at paragraph 2, describes Mr. Harvey's voice mail and email/letter as requesting correspondence on "pending

discovery issues". While this is technically true, it is not the whole truth. The "pending discovery issues" with which the communications were directed were Opposer's discovery dispute not Mimulani's discovery dispute. It is clear that Mr. Harvey (who was not Opposer's counsel and whose voicemail message did not claim to be) was interested only in discussing its issues with Mimulani's discovery and had no intention of making a response to Mimulani's email of December 16 that would narrow the issue. The fact that Opposer had no intention of narrowing the issues with a substantive response to the December 16 email is confirmed by Opposer's opposition in its brief to each and every issue raised by Mimulani's motion to compel.

Opposer's concentration in its brief in opposition on Mr. Harvey's two communications is a red herring and an obvious attempt to mischaracterize Mimulani's efforts to meet and confer. Opposer's decision to emphasize these communications in its brief is at odds with the incomplete description of them in Harvey's declarations and the strategic failure to include them as exhibits to Opposer's brief. To have done so would have revealed the mischaracterization and red herring and would have been fatal to Opposer's allegation that Mimulani ignored any request for additional meet and confer regarding Opposer's discovery deficiencies.

And, as noted, Mr. Harvey is not a counsel in this proceeding. His authority to act for Opposer in any capacity has not been confirmed, and it would have been improper for Mimulani's counsel to confer substantially with him given his lack of appearance or authority. The dispute regarding Opposer's discovery deficiencies was ripe at the time of

Mimulani's filing and Harvey's communications at the end of December were directed toward Opposer's harried interest in reopening discovery and in meeting and conferring regarding a separate discovery issue. This fact is confirmed by Opposer's filing of its Motion to Reopen Discovery even after the Board suspended the proceeding, in disregard of the Board's instructions.

In consideration of the above, Mimulani requests that the Board disregard Opposer's allegations regarding the meet and confer and address the substantive issues raised in Mimulani's Motion.

Respectfully submitted,

/Mark Lebow/
Mark Lebow
Attorney for Applicant
Young & Thompson
209 Madison Street, # 500
Alexandria, Virginia 22314
Tel: (703) 521-2297

February 9, 2009

CERTIFICATE OF SERVICE

I hereby certify the foregoing **APPLICANT MIMULANI AG'S REPLY TO OPPOSITION TO APPLICANT'S MOTION TO COMPEL** was deposited as first class U.S. Mail to Paul W. Reidl, Attorney for Opposer, E. & J. Gallo Winery, 600 Yosemite Boulevard, Modesto, CA 95354 this 9th day of February 2009.

/Jeff Goehring/
Jeff Goehring

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

E. & J. GALLO WINERY,

Opposer,

v.

MIMULANI AG,

Applicant.

Cancellation No. 91181380 et al.
(Consolidated)

**DECLARATION OF MARK LEBOW IN
SUPPORT OF REPLY TO OPPOSITION TO APPLICANT'S MOTION TO COMPEL**

I, Mark Lebow, declare as follows:

1. I am a partner of Young & Thompson, counsel for Applicant Mimulani AG. I make this declaration based on my own personal knowledge.
2. Attached hereto as Exhibit A is a true and correct copy and email representing Mimulani's first follow up communication (email) with Opposer's counsel after having received Opposer's counsel's preliminary response to my December 16 email to Opposer's counsel.
3. Attached hereto as Exhibit B is Mimulani's second follow up communication (email) with Opposer's counsel after having received Opposer's counsel's preliminary response to my December 16 email to Opposer's counsel.
4. I received a voicemail from Peter Harvey of Harvey Siskind LLP in the afternoon of December 29, 2008. The true and correct text of that voicemail as transcribed is as follows:

Hi Mr. Lebow this is Peter Harvey calling. I'm with Harvey-Siskin in San Francisco. I'm calling you in connection with the E.& J. Gallo winery case versus Mimulani, the GALLISS opposition or cancellation proceeding. I wanted to check in with you on the discovery that's recently come to light. Could you give me a call at your convenience, 515-354-0100. Thanks.

5. Attached hereto as Exhibit C is a true and correct copy of an email and attached letter I received from Peter Harvey on the morning of December 30, 2008.

/ Mark Lebow/
Mark Lebow

EXHIBIT A

From: Mark Lebow
Sent: Tuesday, December 16, 2008 6:49 PM
To: 'Reidl, Paul'
Subject: RE: Galliss Oppositions - TTAB Consolidated Opposition No. 91181380 - Our Ref. 0540-1048-1

Hi Paul,

Any enforcement of the GALLO mark that resulted in a settlement is relevant because settlements, particularly any settlements that include coexistence agreements, can be relevant to the scope of protection properly afforded to Gallo's marks and, more particularly, to the factors that scope would depend on such as the area of commerce in which the marks are used or in which Gallo considers them to be used, the likelihood that Gallo will "bridge the gap," and any other issue related to the commercial use of the GALLO mark. This relevance is not necessarily restricted by national boundaries.

Additionally, Gallo denies that it has not challenged several third party marks, and not based on lack of knowledge of the third party marks. Is it Gallo's position that there are no documents relating to the non-TTAB challenges to these third party marks? No letters, no agreements, nothing?

Further, Gallo is obligated to investigate the facts it is being asked to admit and Applicant has made some such investigations straightforward by explicitly providing the sources that support the facts Applicant asks Gallo to admit. None of the denials are base on lack of knowledge, so we assume you have reasons for denying the alleged facts and such reasons/knowledge is clearly discoverable through separate discovery requests. Our production requests already include this type of request and interrogatories would not be inappropriate. We believe many of these issues are resolvable by Gallo admitting that the identified third party marks are used in commerce as we believe is clear from sources available to anyone.

In any event, we look forward to hearing back from you upon your return from New York.

Very truly yours,

Mark Lebow | Young & Thompson

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Alexandria, VA 22314

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Skype: gaucho000

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From: Reidl, Paul [mailto:Paul.Reidl@ejgallo.com]
Sent: Tuesday, December 16, 2008 5:10 PM
To: Mark Lebow
Subject: RE: Galliss Oppositions - TTAB Consolidated Opposition No. 91181380 - Our Ref. 0540-1048-1

Dear Mr. Lebow:

EXHIBIT B

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 parties' 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.
Suite 500
Alexandria, VA 22314
(703) 521-6590 (direct)
Fax: (703) 685-0573
jgoehring@young-thompson.com

EXHIBIT C

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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Thank you for your cooperation.

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.

Mark Lebow, Esq.
Jeff Goehring, Esq.
December 29, 2008
Page 2

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,

A handwritten signature in black ink, appearing to read "D. Peter Harvey". The signature is fluid and cursive, with a large initial "D" and a long, sweeping tail.

D. Peter Harvey

DPH:tlb

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