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

Proceeding	91185884
Party	Plaintiff Dating DNA, LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Dating DNA, LLC,	)	
	)	Serial No. : 77/258,529
Opposer/Respondent,	)	Mark : VISUALDNA
	)	Opposition No. : 91185884
v.	)	
	)	
Imagini Holdings Ltd.,	)	
	)	
Applicant/Petitioner	)	
	)	

MOTION TO COMPEL DISCOVERY

Pursuant to Trademark Rule 2.120(e), Opposer moves to compel discovery responses from Applicant in Opposition No. 91185884. Opposer is filing concurrently a Motion to Re-open Discovery and Re-set Trial Deadlines. Should that Motion be denied, Opposer respectfully requests that the present Motion be granted. Opposer has made a good faith effort to obtain the requested discovery information from Applicant without success. Moreover, Opposer has participated in the discovery process in good faith and has provided responses to Applicant's discovery requests.

The following recitation of facts is intended to shed light upon the underlying reasons necessitating this motion.

STATEMENT OF FACTS

1. The subject opposition was filed on August 19, 2008.
2. Applicant's Answer and Counterclaim were filed on October 8, 2008.
3. Opposer filed a Stipulated Motion for Extension of Time on November 13, 2008.
4. Opposer's Answer to Counterclaim was filed on December 11, 2008.

5. Upon information and belief, Opposer and Applicant (who was at that time representing itself *pro se*) failed to participate in a discovery conference, as required.[1]

6. Applicant served discovery requests upon Opposer on May 7, 2009.

7. Opposer served documents and responses to Applicant's discovery requests on June 9, 2009. On the same date, Opposer served upon Applicant its discovery requests, as well as a letter from Kevin Carmony, C.E.O of Dating DNA, LLC to Alex Willcock, C.E.O. of Imagini Holdings Ltd. regarding settlement negotiations.

8. Kevin Carmony and Alex Willcock conducted oral settlement negotiations via telephone on July 10, 2009. A further call was scheduled for July 14, 2009, but it was later postponed by Mr. Willcock.

9. Discovery closed on July 12, 2009.

10. On July 14, 2009, Applicant sent an e-mail message to Opposer giving the first indication of Applicant's intent not to respond to Opposer's discovery requests for lack of initial disclosures having been served.

11. Mr. Carmony telephoned Mr. Willcock on July 28, 2009 to follow up on their previous discussions, but he was informed by Mr. Willcock's assistant that Mr. Willcock was on vacation and was not scheduled to return until mid-August. No further discussions between Mr. Carmony and Mr. Willcock have yet occurred.

12. Opposer served its initial disclosures upon Applicant on July 29, 2009.

13. Opposer renewed its request for Applicant's responses to discovery requests in an e-mail message on August 4, 2009

14. Counsel for Applicant was on vacation from August 3-10, 2009, as indicated by an automated response to Opposer's e-mail message.

15. On August 10, 2009, Applicant replied to Opposer's renewed request for responses to discovery requests via e-mail, attaching a copy of Trademark Rule 2.120 (regarding the timing of initial disclosure requirements). Opposer has received no further response from Applicant.

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[1] Final Rule, "*Miscellaneous Changes to Trademark Trial and Appeal Board Rules*," 72 Fed. Reg. 42,242, 42,252 (August 1, 2007).

DISCUSSION

The objective of the disclosure regime is to accelerate the exchange of basic information about the case and to eliminate the paperwork involved in requesting such information.[2] The Board expects each party to cooperate in the discovery process and to make a good faith effort to satisfy the discovery requests of its opponent.[3] That one party has failed to provide any responses to discovery, or has otherwise violated the discovery rules, does not relieve the other party of its duty to respond properly and timely to discovery requests.[4] A party upon whom discovery is served cannot impede the progress of its opponent's discovery by failing to respond in a timely manner. The Board will, upon motion, "re-open or extend discovery solely for the benefit of a party whose opponent, by wrongfully refusing to answer, or delaying its responses to, discovery, has unfairly deprived the propounding party of the right to take follow-up."[5]

Opposer admits that it failed to make required initial disclosures by the specified deadline.[6] Opposer submits, however, that this failure was not in bad faith; rather it was the result of an oversight. Opposer further submits that information set forth in the initial disclosures was routine in nature and was of the type that parties to an opposition make the subject of discovery requests as a matter of course. That is, had this same information been served prior to Applicant's discovery requests rather than after, it likely would have had no effect on the substance of Applicant's discovery requests. The result of the absent initial disclosures was therefore harmless error. Additionally, Opposer participated willingly in the discovery process by providing timely responses to Applicant's discovery requests.

On the other hand, Opposer submits that Applicant used the absence of Opposer's initial disclosures as a tool to avoid participating in discovery. If Applicant harbored a genuine concerned about not having received Opposer's initial disclosures, Applicant should

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[2] Fed.R.Civ.P.26, Advisory Committee Note (1993 Amendments, Subdivision (a)).
[3] *See* Fed.R.Civ.P. 26(g); *Johnson Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d1719 (TTAB 1989); *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1720 (TTAB 1987); *Sentrol, Inc.. v. Sentex Systems, Inc.*, 231 USPQ 666 (TTAB 1986).
[4] *Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067, 1070, (TTAB 1990); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 966, n.21 (TTAB 1986), *adhered to on reconsideration,* 231 USPQ 626 (TTAB 1986); Fed.R.Civ.P. 26(d).
[5] *Miss America Pageant v. Petite Productions Inc.*, 17 USPQ2d 1067, 1070 (TTAB 1990). *See also Neville Chemical Co. v. The Lubrizol Corp.*, 184 USPQ 689, 690 (TTAB 1975).
[6] Trademark Rule 2.120(a)(2), 37 CFR §2.120(a)(2).

have filed a motion to compel such disclosures prior to the close of discovery.[7] Such a motion to compel must include a statement that the moving party made a good faith effort to obtain such disclosures. Clearly, Applicant made no such good faith effort.

Instead, Applicant was in receipt of Opposer's discovery requests in excess of thirty days prior to notifying Opposer that it did not intend to respond. Interestingly, such notification was forthcoming a mere two days after the discovery period closed. By refusing to respond to discovery requests, or to provide any indication of such intention until after the close of the discovery period, Applicant used Opposer's failure to provide initial disclosures to "game the system" in a manner inconsistent with the spirit of the discovery process. Had Applicant responded in a timely manner that responses would not be provided until initial disclosures were served, Opponent would have had the opportunity to take remedial action while the discovery period remained open.

Applicant has now been in possession of Opposer's discovery requests in excess of two months, and has been in possession of Opposer's initial disclosures for over three weeks. Opposer submits that reopening of the discovery period presents no prejudice to Applicant, as Applicant would have to do no more than would have been required had the discovery process operated as intended. Moreover, the amount of time granted should be equal to that which would have been remaining in the discovery period had the responses been timely made.[8] This is a relatively short period of time that would have little impact on the overall calendar of judicial proceedings.

Opposer further submits that although it erred by not providing timely initial disclosures, that it was in fact Applicant that was in reasonable control of the events necessitating this motion. Applicant was in receipt of Opposer's discovery requests, and allowed Opposer to await responses even though it did not intend to provide them. Applicant should have properly provided an indication to Opposer of this intention and/or that Opposer was not in compliance with the disclosure rules, so that it could have taken appropriate action to remedy the same while the discovery period remained open. While Opposer acted in good faith by responding to Applicant's discovery requests, Applicant did not reciprocate such good faith.

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[7] Trademark Rule 2.120(e)(1), 37 CFR §2.120(e)(1).

[8] *See "Miscellaneous Changes to Trademark Trial and Appeal Board Rules,"* 1214 TMOG 145, 149-50 (September 29, 1998).

Thus, Opposer submits that it has made a good faith effort to obtain responses to its discovery requests. As soon as it became aware of its non-compliance with the disclosure rules, it provided an immediate remedy and a renewed request for production of responses. To date, Applicant has not responded to Opposer's discovery requests. Therefore, Opposer respectfully requests that the Board issue an order compelling such discovery.

No fees are believed due. Please apply any charges or credits to Deposit Account No. 50-3137.

Respectfully submitted,

Date: 25 AUG 2009

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