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

Proceeding	91189418
Party	Defendant Phoenix 2008 LLC
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Application Serial Nos.:	77476098 77497086 77476107 77478035
Filed:	May 15, 2008 June 12, 2008 May 15, 2008 May 19, 2008
Marks:	SPEEDVISION SPEEDVISION SPEEDVISION HD SPEEDVISION (and Design)
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<p>Speed Channel, Inc.</p> <p style="text-align: center;">Opposer,</p> <p>v.</p> <p>Phoenix 2008 LLC,</p> <p style="text-align: center;">Applicant.</p>

Opposition No. 91189418

PHOENIX 2008 LLC’S RESPONSE TO SPEED CHANNEL, INC’S MOTION TO COMPEL AND TO TEST THE SUFFICIENCY OF RESPONSES TO REQUESTS FOR ADMISSIONS

Applicant Phoenix 2008 LLC (“Applicant” or “Phoenix”) submits its response to Speed Channel, Inc.’s (“Opposer”) Motion to (1) Compel Applicant’s Responses to Speed Channel’s First Set of Requests for Production of Documents and Its First Set of Interrogatories (“Motion to Compel”); (2) Test the Sufficiency of Applicant’s Responses to Speed Channel’s Requests for

Admissions (“Motion to Test Applicant’s Admissions”); and (3) Suspend (hereinafter “Opposer’s Motion”), filed with the Board on September 28, 2009.¹

Background

Since at least as early as January 3, 2004, the Board has cancelled approximately 12 marks bearing the name SPEEDVISION and derivatives thereof that previously had been registered to, and used by, Opposer or Opposer’s predecessor entity for various classes of goods and services, including Classes 016, 025, 038 and 041 (the “Abandoned Speedvision Marks”).² The marks were cancelled by the Board pursuant to Section 8 of the Trademark Act, 15 U.S.C. § 1058, due to Opposer’s failure to submit even an initial 6-year Section 8 affidavit or declaration of use for *any* of the Abandoned Speedvision Marks. Moreover, since 2004, Opposer did not ever attempt to demonstrate excusable “nonuse” of the marks. Indeed, because none of the Abandoned Speedvision Marks were in use for at least three years, and Opposer had done *nothing* to try and resume use of the marks, Opposer has abandoned the SPEEDVISION name. *See* TMEP § 1604.11.

Discovering that the Abandoned Speedvision Marks had been abandoned by Opposer, and that their registrations had been cancelled by the Board, between May 15, 2008 and June 12, 2008, Applicant filed four applications for marks bearing the name SPEEDVISION (“Applicant’s Marks”), in Classes 016, 025, 038 and 041.³ Those applications were passed for

¹ The Board already ruled on Opposer’s request to suspend the proceedings. *See* Order, Sept. 29, 2009 (suspending proceedings pending disposition of Opposer’s Motion). Applicant’s Response therefore addresses only those parts of Opposer’s Motion that seek to compel responses to Opposer’s discovery requests and test Applicant’s responses to Opposer’s requests for admissions.

² These prior-registered marks include Registration Nos. 2049276, 2067548, 2126782, 2134232, 2140153, 2152091, 2433636, 2451685, 2453681, 2453772, 2464221 and 2517630.

³ *See* Application Serial Nos. 77478035; 77476098; 77476107; and 77497086.

publication in the Official Gazette without any significant concerns, including likelihood of confusion with any other registered mark.⁴

Notwithstanding its abandonment and non-use of the Abandoned Speedvision Marks, Opposer filed a Notice of Opposition to Applicant's Marks, asserting, *inter alia*, that Applicant's Marks were confusingly similar to Opposer's various SPEED marks and infringed Opposer's alleged rights to the now-cancelled Abandoned Speedvision Marks. Applicant filed an Answer, which refuted each of Opposer's claims, and discovery commenced.

Applicant is a small start-up enterprise, owned and operated by its sole proprietor, Mr. Roger Williams, a well-respected former executive of a number of cable television networks and the producer of highly rated programs for cable networks, particularly in the genre of automotive and motor sports programming. Relying on his personal finances, Mr. Williams has invested substantial time, money and other resources into growing his business in the cable television programming industry. Most recently, he has produced cable television shows for various cable television networks for another business venture called Roger Wilco Productions.

Opposer Speed Channel, Inc., is part of the family of Fox cable entities, and ultimately News Corporation. According to recent SEC filings, News Corporation reported net income of over \$2.7 *billion*...for only the first *quarter* of 2009.⁵ While Speed Channel, its parent News Corporation and their affiliates, which have an expansive portfolio of trademarks and other intellectual property rights, certainly are entitled to enforce those rights in an appropriate manner and forum, they may not engage in harassment, delay or needlessly expensive and vexatious

⁴ The Examining Attorney was initially concerned with the ownership interest of prior-registered SPEEDVISION marks, but Applicant explained that there was no issue because the Board had cancelled those marks pursuant to Section 8 of the Trademark Act, 15 U.S.C. § 1058. *See* Exhibit A (Applicant's Responses to Office Actions regarding Applicant's Marks).

⁵ *See* News Corporation SEC Form 10-Q for period ended March 31, 2009 (filed May 7, 2009), available at <http://investor.newscorp.com/sec.cfm?DocType=Quarterly&Year=> (last visited October 29, 2009).

litigation tactics in an effort to deter others from securing available and appropriately registrable trademarks. *See* TBMP § 527.02 (citing Fed. R. Civ. P. 11). Yet that is the course that Opposer has pursued in this case, and that is what the instant Motion is really about.

On September 28, Opposer filed its Notice of Opposition, alleging among other things that, notwithstanding the fact that Opposer had abandoned the Abandoned Speedvision Marks, and that those marks had been cancelled by the Board, Opposer nonetheless retained rights in the SPEEDVISION name, and that Applicant's Marks were confusingly similar to Opposer's SPEED marks. The merits of Opposer's claims, while facially dubious, remain undecided, as the parties are still in the early stages of discovery. However, from the outset of this proceeding, Opposer has done everything it can to intimidate Applicant, and to burden it with oppressive expense, with the obvious goal of dissuading Applicant from continuing to prosecute its applications before the Board. Opposer's tactics have included, for example, serving Applicant with an *18-page, single-spaced* discovery letter and demanding that Applicant respond to Opposer's demands within one day; filing the instant *60-page motion*, which far exceeds the Board's allowed page limitation for briefs in support of motions; threatening Applicant and its counsel with a petition to disqualify; noticing the deposition of Applicant's counsel; and threatening to pursue a complaint against Applicant's counsel before the District of Columbia Bar Association. All of these heavy-handed tactics have been undertaken by Opposer with the intent of intimidating Applicant, burdening it with massive litigation expense, and ultimately forcing it to abandon its prosecution of Applicant's marks, thereby preventing the Board from ever reaching the merits of Applicant's applications and Opposer's opposition.

Opposer's current Motion is merely one phase of its ongoing attempt to drag out, and make unbearably costly, the proceedings in this case, with the transparent intention of forcing

Applicant to withdraw its applications. The Board should deny the Motion for all the reasons set forth in this Response, including, among other things, because Opposer's course of conduct demonstrates that it has failed to act in good faith to attempt to resolve its discovery disputes with Applicant and has made a mockery of the Board's rules.

Procedural History

On June 4, 2009, Opposer served Applicant with its First Set of Requests for Admissions ("Admissions"), First Set of Interrogatories ("Interrogatories"), and First Request for Production of Documents ("Document Requests"). Applicant's original response date of July 9, 2009 was extended by consent motion to July 13. On July 13, 2009, Applicant timely submitted responses to each of Opposer's discovery requests.

In its response to Opposer's Document Requests, Applicant indicated that, as of July 13, 2009, it had not identified any *non-privileged* documents responsive to the Document Requests, and accordingly, that it had no non-privileged, responsive documents or things to produce to Opposer at that time.

In response, Opposer e-mailed Applicant's counsel, on Thursday, September 10, 2009, at 2:57 PM, an 18-page, single-spaced letter complaining that Applicant's responses were "woefully deficient" and demanding, incredibly, that, with only *one day's* notice, Applicant agree to all of Opposer's terms set forth in Opposer's letter, or it would move to compel. *See* Opposer's Motion, Exhibit G, page 17. In addition, Opposer demanded that Applicant both produce a privilege log and supplement its responses eight days later. *See id.* On September 11, Applicant informed Opposer that it would respond to its demands in a timely manner. *See* Opposer's Motion, Exhibit H. Subsequently, Applicant began to review Opposer's exhaustive

demands and form its response. Before Applicant could respond, however, Opposer filed the instant Motion with the Board.

As this Response demonstrates, Opposer's alleged concerns with Applicant's discovery responses are unfounded and were raised prematurely. Applicant submitted responses to each and every one of Opposer's requests in a timely manner. The fact that Applicant did not identify any non-privileged, responsive documents at that time does *not* constitute a failure or refusal to produce documents. The Motion is merely Opposer's further attempt to intimidate Applicant and to inflict on Applicant needless and excessive litigation costs, tactics that will not only burden Applicant but consume the Board's resources. Accordingly, Applicant respectfully requests that the Board deny Opposer's Motion.

As a procedural matter, Opposer's Motion should be denied for grossly exceeding the Board's strict page limitations on briefs in support of motions. Alternatively, the Motion should be dismissed as moot, in light of Applicant's recent supplemental disclosures, including documents and a privilege log.

If, however, the Board proceeds to hear the merits of Opposer's Motion, it will find that it lacks any adequate basis for the Board to grant any of the relief sought, and therefore should be denied. The Motion not only contains improper interpretation of the Federal Rules of Civil Procedure ("FRCP"), the Board's rules (37 C.F.R. § 2.1 *et seq.*) and the Trademark Trial and Appeal Board's ("Board") Manual of Procedure ("TBMP"), but also is intended to mislead the Board with false accusations and inconsistent and inappropriate reasoning.

The Board should deny Opposer's Motion, lift the suspension over this proceeding, and allow the parties to move forward with their respective cases.

1. OPPOSER’S MOTION SHOULD BE DENIED FOR GROSSLY EXCEEDING THE BOARD’S PAGE LIMIT FOR MOTION BRIEFS

Opposer’s Motion is *60 pages long*. On its face, the Motion grossly exceeds the Board’s limit for a brief in support of a motion. Accordingly, the Board should deny Opposer’s Motion, without leave to re-submit a conforming motion.

Section 502.02(b) of the TBMP explains that a motion (including a motion to compel) must embody or be accompanied by a brief. Such brief must meet the general requirements for submissions to the Board set forth in 37 CFR § 2.216, as well as “page limitations and time requirements.” TBMP § 502.02(b). The Board’s rules expressly require that a brief in support of a motion “*shall not exceed twenty-five pages in length.*” 37 CFR § 2.217(a) (emphasis added). The Board strictly construes this page limit, and will deny a motion whose brief exceeds this limit. *See The Administration of the Estate of Tupac Shakur v. Thug Life Clothing, Co.*, 57 U.S.P.Q.2d 1095, 2000 TTAB LEXIS 710, at *2-*3 (TTAB 2000) (denying motion to compel for exceeding Board’s page limit for supporting brief). *Cf. Ron Cauldwell Jewelry, Inc. v. Clothestime Clothes, Inc.*, 63 U.S.P.Q.2d 2009, 2002 TTAB LEXIS 89, at *5 (TTAB 2002) (giving no consideration to brief that violated applicable page limit).

Moreover, the Board has indicated that a party who exceeds the page limit for motion briefs may not re-submit a conforming motion to cure the deficiency. The Board has indicated its strong disfavor of pleadings that exceed their applicable page limitations. *Cf. TBMP § 537* (noting that “it is *only* with the Board’s permission, timely sought, that a brief [on the case] exceeding the page limit be entertained.”) (emphasis added); *see also id.* (“If a party files a [brief on the case] that exceeds the page limit, but does not file a timely motion for leave to file such a brief, the brief will be stricken, without leave to file a substitute brief that meets the limit.”). The Board’s displeasure extends to motions to compel. *See Estate of Tupac Shakur*, 2000 TTAB

LEXIS 710 at *3 (questioning whether future violations of Board’s “recent” page limit rule for briefs on motions warrant any leniency to cure). In *Estate of Tupac Shakur*, the Board granted the moving party leave to re-file a revised motion to compel adhering to the 25-page limit, but *only* “because this is a case of first impression under the new rule.” 2000 TTAB LEXIS 710 at *3. Nine years later, there is no longer any basis for such leniency.

Opposer’s Motion and embedded argument are **60 pages long** (not including attached exhibits), approximately 58 pages of which consist of argument. There is no question that Opposer’s “brief” in support of its Motion grossly exceeds the Board’s strict page limitation, and no justification for Opposer’s disregard of the clear requirement of the Board’s rules.

Even if the Board were to treat Opposer’s Motion as being comprised of two motions – one to compel, and the other to test the sufficiency of Applicant’s admissions – Opposer still would have exceeded the page limit, with each “motion/brief” being allocated 30 pages. Moreover, it would be inappropriate to treat them in that fashion, as the allegations are intermingled, with much of the discussion being relevant to both issues. Further, given the Board’s strong criticism of attempts to “circumvent the page limitations” as a “clear violation of the rules”, *see Estate of Tupak Shakur*, 2000 TTAB LEXIS 710, at *2, it should not countenance Opposer’s attempt here, by comingling arguments, to blatantly exceed the explicit page limitation clearly applicable to briefs in support of motions. Nor can Opposer gain any advantage from having requested the Board to suspend proceedings, as that request took up a mere four lines of Opposer’s Motion (*see* p. 2 and p. 49, ¶ 47) and thus does not alter the fact that, no matter how Opposer might characterize its Motion, it indisputably has exceeded the Board’s strictly applied page limits.

Finally, Opposer's disregard of the page limit is rendered even more objectionable by the fact that the Board has made clear that any party asserting a need to exceed the limit must make a timely request to do so, and not wait until after the fact to address the issue. Here, if Opposer believed it necessary to submit nearly 60 pages of briefing in support of its Motion, it could and should have filed a motion for leave to do so, supported with a showing of good cause, before or at least at the time of filing its Motion. *See Estate of Tupac Shakur* at *3 n.3 (TTAB 2000) (noting that respondent failed to file a motion for leave). It did not do so, however, and even if it had done so, Opposer would likely not have been able to overcome the Board's strong disfavor for granting leave to file excessively long briefs.⁶ In this case, Opposer presumptuously did not even seek the Board's permission to exceed the page limits for briefs on motions, and instead proceeded to blatantly violate that limit more than two-fold.⁷

Applicant therefore respectfully requests that the Board deny Opposer's Motion without leave to re-file a conforming motion.⁸

2. OPPOSER'S REQUEST TO COMPEL SHOULD BE DENIED AS MOOT

Even if the Board accepted Opposer's Motion, the request to compel should be denied as moot in light of the fact that, since the filing of Opposer's Motion, Applicant has provided supplemental responses to Opposer, which included identification of supplemental documents

⁶ Cf. TBMP § 537 (indicating that motions for leave to exceed the Board's page limits on final briefs on the case are "disfavored by the Board and rarely granted").

⁷ See discussion on *Estate of Tupac Shakur*, *supra*.

⁸ Applicant respectfully notes that the Board should likewise not consider any Reply filed by Opposer, given that such Reply would merely reiterate arguments raised in the Motion and/or attempt to explain Opposer's reasons for filing a brief in excess of the 25-page limit, for which Opposer has no excuse. See TBMP § 502.02(b) ("The filing of reply briefs is discouraged, as the Board generally finds that reply briefs have little persuasive value and are often a mere reargument of the points made in the main brief."). Indeed, Opposer neither filed a motion for leave to exceed the 25-page limit, nor did it provide any reason for doing so in its Motion. See *id.* (disapproving of reply briefs, citing *No Fear, Inc. v. Rule*, 54 U.S.P.Q.2d 1551, 1553 (TTAB 2000) and *Johnston Pump/General Valve, Inc. v. Chromalloy American Corp.*, 13 U.S.P.Q.2d 1719, 1720 n.3 (TTAB 1989) ("The presentation of one's arguments and authority should be presented thoroughly in the motion or the opposition brief thereto.")).

and things, as well as a privilege log. Opposer requires nothing further from Applicant, and Applicant has nothing further to give to Opposer.⁹

Applicant stands by its initial responses, including its general and specific objections, to each and every of Opposer's Interrogatories, Document Requests, and Admissions. Applicant submitted its discovery responses in full and in a timely manner. Each objection was made with a good faith basis, and each response was made to the best of Applicant's information, knowledge and belief at that time. Its responses were a result of a thorough search of Applicant's records. *See also* Declaration of Roger Williams, attached hereto as Exhibit B.

Following the filing of its initial responses, Applicant continued to investigate its records pursuant to its duty to supplement under FRCP 26(e) and TBMP § 408.03. As a result, Applicant identified additional documents and things that may be responsive to Opposer's initial discovery requests, and on November 2, 2009, Applicant supplemented its initial responses to Opposer's Interrogatories and Documents Requests. At the same time, Applicant produced a privilege log, in conformance with federal law, to inform Opposer of the scope of documents claimed to be covered by the attorney-client privilege, attorney work product, or other applicable claim of privilege.¹⁰ Applicant even further stated that it would provide Opposer with documents that may not be responsive to Opposer's discovery requests. Together, these materials constitute what Applicant believes to be the full scope of responsive, non-privileged items that are within in its possession or control. *See* Exhibit C (Applicant's Supplemental

⁹ Applicant recognizes that the duty to supplement will continue to apply. Opposer is, of course, bound by this same duty.

¹⁰ The parties agreed early in the discovery period, and during numerous discussions, to provide each other with privilege logs describing documents and things subject to an applicable claim of privilege. As discussed later in this Response, Opposer's claim that Applicant has "refused" to provide a privilege log is utterly false and intended only to mislead the Board in considering the Motion.

Response to Opposer's First Interrogatories and First Request for Production of Documents, and privilege log); *see also* Declaration of Roger Williams, attached as Exhibit B.

Consequently, Opposer's request to compel is moot. The fact that Applicant did not identify any responsive, non-privileged documents or things for production at the time of its initial response does not, contrary to Opposer's contention, indicate a failure or refusal to produce documents or things, or constitute a failure or refusal to supplement its responses. Nor does the fact that Opposer merely disagrees with Applicant's responses and objections constitute a refusal or failure by Applicant to comply with its discovery obligations.

Opposer's request to compel therefore should be denied, given Applicant's timely, good faith initial response and its supplemental responses and production of documents to Opposer, and because Opposer has not been prejudiced in any way. (For example, no depositions have been taken, and no motions or other pleadings that may have relied on Applicant's supplemental responses, documents or things have been filed.) *See generally* TBMP § 523.02, note 317 (citing *Luehrmann v. Kwik Kopy Corporation*, 2 U.S.P.Q.2d 1303, 1987 TTAB LEXIS 77 (TTAB 1987) (denying as moot respondent's motion to compel for failure to respond to discovery requests in light of petitioner's filing of responses that satisfy the "thrust of respondent's motion")). Here, Applicant's recent submissions to Opposer satisfy the "thrust" of the Opposer's request to compel and, therefore, Applicant requests that the Board deny the request, as moot, in order to allow the parties to move forward with discovery and to facilitate the resolution of the merits of this proceeding.

3. OPPOSER IS NOT ENTITLED TO ANY OF THE RELIEF REQUESTED

In the event that the Board addresses the merits of Opposer's Motion, each of Opposer's requests for relief (see Motion, pp. 58-59 (¶¶ 45(a)-(h))) should be denied because Opposer has failed to provide adequate support for any of them.

A. Opposer failed to make a good faith attempt to resolve the instant dispute.

Opposer claims to have made good faith attempts to resolve the discovery disputes at issue in this proceeding. In fact, nothing could be further from the truth and Applicant therefore respectfully requests that the Board refuse to make the finding requested by Opposer in ¶ 45(a) of its Motion.

Section TBMP § 523.02 requires that Opposer's Motion "must be supported by a written statement from the moving party that such party or its attorney has made a good faith effort, by conference or correspondence, to resolve with the other party or its attorney the issues presented in the motion, and has been unable to reach agreement." The mere fact that Opposer made multiple phone calls and e-mails to Applicant's counsel – which calls and emails delivered oppressive, unreasonable demands and threats – fails to demonstrate a good faith attempt, especially in light of Opposer's unreasonableness throughout these discovery proceedings.

As noted above, Applicant responded to each of Opposer's discovery requests, in full and in a timely manner. Opposer nevertheless responded with oppressive and unreasonable demands on Applicant – *including demanding Applicant's response to, and compliance with, Opposer's 18-page, single spaced letter on one day's notice* – disregarding the fact that Opposer had Applicant's full and complete responses, *see* Opposer's Motion, Exhibit G, or that Applicant had afforded Opposer a *45-day* extension to respond to Applicant's discovery requests.¹¹ Not

¹¹ See Exhibit D (e-mail dated July 15, 2009 from B. Hurh consenting to 45-day extension request).

surprisingly, and consistent with its abusive tactics, Opposer exploited Applicant's good faith by subsequently accusing Applicant of failing to comply with its discovery obligations since responding to Opposer's requests – despite the fact that Opposer's extension request would in turn provide Applicant with additional time to respond to Opposer's requests.¹² Applicant's inability to comply with patently unreasonable demands is not a "failure" to provide the discovery requested. *Cf.* TBMP § 523.01 (“[A] motion to compel discovery procedure is available in the event of a failure to provide discovery requested by means of discovery depositions, interrogatories, and request for production of documents and things.”).

Opposer continued to obstruct resolution of these discovery disputes by diverting the parties' attention and resources, and by taking unnecessarily combative positions, such as threatening to petition the Director of the USPTO to disqualify Applicant's counsel,¹³

¹² Compare Opposer's Motion, Exhibit G, at 2 with Opposer's Consent Motion to Extend Deadline to Respond to Discovery and to Amend Scheduling Order, at 2 (filed July 17, 2009) (noting that 45-day extension would “permit Applicant additional time to produce documents and things responsive to Opposer's previously served written discovery”).

¹³ Opposer's Motion notes that, during this time, Opposer also complained of an alleged conflict of interest concerning Applicant's representation by its counsel. Opposer's Motion at page 7, note 1 (referencing, but not actually attaching, a September 2, 2009 e-mail). Although this issue is entirely irrelevant to the instant Motion (and was not referenced in any attachment to the Motion), Opposer has sought to inject it into the instant motion proceedings in a misguided, and inappropriate, attempt to taint Applicant's standing in this proceeding. Indeed, there is no conflict. Rather, it is just another instance of the scorched earth campaign of vexation and harassment on which Opposer has embarked to exhaust Applicant's resources, with the goal of forcing Applicant to withdraw its applications. At the appropriate time, Applicant will catalogue this and all other actions by Opposer and ask the Board to issue an appropriate sanction. *See* TBMP § 527.02 (procedures for filing motion for Rule 11 sanctions); *see also* Exhibit E (e-mail from D. Brusco dated Sept. 11, 2009, threatening to file Petition to Disqualify with USPTO Director).

threatening to file a Bar complaint against Applicant's counsel,¹⁴ and noticing Applicant's counsel for deposition without good cause.¹⁵

Equally fallacious is Opposer's attempt to prove its "good faith" by accusing Applicant of "refusing" to provide responsive documents, to supplement its responses, to remove its objections, or to produce a privilege log. *See, e.g.*, Opposer's Motion ¶ 21. These claims are unfounded and blatant misstatements.

Applicant has *never* refused to provide responsive, non-privileged documents or things. Contrary to Opposer's position, the fact that a party does not produce any documents in response to a discovery request does not, *ipso facto*, represent a "failure" or "refusal" to do so. Opposer overlooks a number of obvious reasons why no documents were produced at the time of Applicant's initial response to Opposer's production request: (1) unlike Opposer, which is part of

¹⁴ *See* Exhibit F (e-mail dated Oct. 23, 2009 from D. Brusco threatening to notify D.C. Bar). The Board will notice that, in its Oct. 23 e-mail, Opposer rejected Applicant's draft protective order, because Opposer – as in its counsel and in-house attorneys – insists that it have full access to Applicant's highly confidential, proprietary information. That information is essential to Applicant's business, and yet, Opposer refuses to explain or otherwise demonstrate any need to see unredacted copies of Applicant's materials – further evidence of Opposer's unreasonableness in this proceeding.

¹⁵ Indeed, Opposer's lack of good faith is especially reflected in Opposer's continued insistence on taking the deposition of Applicant's counsel, when there clearly is no legal basis or practical need for doing so. *See* Opposer's Motions at 41-42 ¶¶ 35-36. Applicant's counsel did not sign Applicant's responses to Opposer's Interrogatories as the "agent" of Applicant, nor did Applicant authorize counsel as its "agent" for purposes of "answering" Opposer's Interrogatories. In fact, Applicant provided Opposer (and Opposer accepted) the verified signature of Mr. Roger Williams – the authorized representative of Phoenix – (with counsel's signature as to objections) to clarify any misunderstanding. The provision cited by Opposer is intended to ensure that an attorney acting as the authorized "agent" for the corporate party is aware of his or her obligations – and vulnerabilities – in signing as the "agent." *See Allstate Insurance Co. v. Healthy America, Inc.*, 9 U.S.P.Q.2d 1663, 1988 TTAB LEXIS 51, *7 (TTAB 1988) (holding that "interrogatory answers that have been *verified* by its attorney are permissible"). It was not intended to allow one party to drag opposing counsel into the discovery fray when there is no compelling reason to do so. Courts strongly disfavor allowing depositions of opposing counsel, and the party that seeks to depose an opposing counsel bears a heavy burden to justify the deposition. *See, e.g., Guantanamo Cigar Co. v. Corporacion Hananos S.A.*, Civ. Action No. 08-0721 (RCL), 2009 WL 2514082, at *6 (D.D.C. Aug. 18, 2009) (during appeal of trademark opposition proceeding, citing cases in numerous jurisdictions for proposition that "[d]epositions of opposing counsel are generally disfavored in federal courts," and that "when seeking to depose opposing counsel, the cards are stacked against the requesting party from the outset and they must prove the deposition's necessity"). In any event, as Applicant's attorney is *not* a party to this proceeding, the Board does not have jurisdiction over his deposition. *See* TBMP § 404.03(a)(2). Despite all of these factors, and further manifesting Opposer's bad faith, as of the filing date of this Response, Opposer continues to insist on deposing Applicant's counsel, a strategy clearly intended merely to harass, and impose additional cost on, Applicant.

a multi-billion dollar media conglomerate, Applicant is a small start-up, sole proprietor business that has few business records and, therefore, would not have volumes of materials to produce in response to Opposer's document request; (2) certain records that are responsive, but that are privileged, were not required to be produced, and are identified in Applicant's privilege log; and (3) other documents of Applicant that were not within the scope of Opposer's request did not need to be produced. Clearly, the fact that Applicant initially had no responsive, non-privileged documents to produce in response to Opposer's requests does not translate into the conclusion that Opposer seeks to draw – that Applicant intentionally or knowingly withheld any non-privileged responsive document, or that Applicant “refused” to provide responsive, non-privileged documents or things in its possession or control. Indeed, Opposer's position is belied by the fact that Applicant has voluntarily provided to Opposer various documents and things that it recently identified pursuant to its duty to supplement. The issue is thus moot.

Nor has Applicant ever “refused” to “supplement” its responses. Not only is the claim false, but it is a distortion of the duty to supplement as contemplated by the Federal Rules of Civil Procedure and the Board's rules. The duty to supplement is a continuing duty that arises after a party submits its initial responses,¹⁶ and simply because a party has not yet supplemented its responses at any given moment does not constitute a “refusal” to do so. To hold otherwise would mean that any party subject to discovery would *always* be in violation of federal law *until*

¹⁶ See Fed. R. Civ. P. 26(e)(1); TBMP § 408.03. Note that Section 408.03 of the currently provided version of the TBMP (revised March 2004) continues to cite to a former version of Fed. R. Civ. P. 26(e)(2), which was amended and renumbered in 2007 to Rule 26(e)(1). Nevertheless, the current text of Rule 26(e)(2) is substantially the same – the amendments were intended only to clarify the intent of the rules. Rule 26(e)(1) as it now reads requires parties to supplement their responses “in a timely manner *if* the party learns that in some material respect the disclosure or response is incomplete or incorrect, and if the additional or corrective information has not otherwise been made known to the other parties during the discovery process or in writing.” (Emphasis added.)

it provided supplemental responses.¹⁷ In any event, the issue is moot, as Applicant has provided supplemental responses to Opposer.

Opposer's claim that Applicant has "refused" to provide a privilege log is even more bogus, since as early as the parties' discovery conference, counsel for both parties had already discussed, and agreed to, the production of a privilege log. That agreement was confirmed in subsequent conversations between the parties' counsel. In any event, Applicant has provided Opposer with its privilege log, and thus, the issue is moot.¹⁸

In light of the positions maintained, and the actions taken, by Opposer, its formal certification to the Board that Applicant has "refused" to do any of the things that Opposer demands in fact further reflects Opposer's lack of good faith in this proceeding. Indeed, even after Applicant informed Opposer that it was preparing to produce recently identified materials (including even some that arguably were not within the scope of Opposer's discovery requests), that it would provide supplemental responses to Opposer, and that it was preparing its privilege log, Opposer continued to allege that Applicant was refusing to comply with its demands, and moreover, refused to withdraw, amend or even suspend its Motion – thus requiring Applicant to prepare its supplemental materials *and* respond to a motion that would soon be mooted, thus burdening not only Applicant but also the Board by forcing it to consider a motion that is now moot.¹⁹ Clearly, Opposer lacks the requisite good faith necessary to support the Motion.

¹⁷ *See id.*

¹⁸ While Opposer has focused on Applicant's supposed failure to produce a privilege log (*see* Opposer's Motion, Exhibit G) – which is untrue and now moot – it has ignored the fact that it has failed to provide Applicant with a privilege log covering the documents that it withheld from its June 4, 2009 response, with objections, to Applicant's Document Requests, and still apparently refuses to do so.

¹⁹ *See* Exhibit G (letter from B. Hurh dated Oct. 7, 2009 offering supplemental responses; e-mail from D. Bruso dated Oct. 12, 2009 with letter attached rejecting Applicant's offer to supplement).

Accordingly, Applicant respectfully requests that the Board deny this request. *See* Opposer's Motions ¶ 45(a).

B. There is no basis for the Board to grant the Motion on its terms.

Opposer requests that the Board “[a]llow the instant Motion on its terms.” *See* Opposer's Motion, ¶ 45(b). The request should be denied for all the reasons set forth in this Response, including that the Motion is void for exceeding the Board's page limits, that the Motion is moot in light of Applicant's recent supplemental disclosures, and that Opposer has failed to demonstrate any good faith in attempting to resolve these discovery disputes.

C. Applicant has not interposed frivolous objections.

Opposer's individual objections and its expressed concerns about Applicant's specific responses are hyper-technical and without merit. As explained above, Applicant's initial responses and objections, and its supplemental responses, were fully consistent with its discovery obligations. Moreover, there is no need for the Board to be burdened with the task of considering Opposer's individual objections to substantially all of Applicant's responses, as Opposer's Motion exceeds the Board's 25-page limit, and was, in any case, substantially mooted with Applicant's recent supplemental disclosures.

Indeed, Opposer's concerns are unfounded and conclusory; its sheer volume intended only to intimidate and harass. Opposer complains about substantially all of Applicant's responses to its Document Requests, but does not support its accusations. For example, as to Applicant's Response to Document Request No. 2, Opposer charges that Applicant's actions in adopting Applicant's Marks are “inconceivable,” yet cannot explain why that may be. *See* Opposer's Motion at 13. Opposer's disbelief is not adequate grounds to granting the Motion.

Opposer further misconstrues Applicant's privilege claims, as it seems to believe that *all* responsive documents must be either privileged or not privileged, ignoring the possibility that certain requested information may be publicly available while *other* information potentially responsive to the request may be privileged. *See, e.g.*, Opposer's Motion at 20. The USPTO's trademark database contains publicly available information, and is accessible to Opposer. However, counsel's research of that database constitutes protectable information, whether under the attorney-client privilege or protected by the work-product doctrine. Opposer cannot realistically argue that an attorney's own research of publicly available information is itself discoverable.

Opposer further misconstrues Applicant's objections in an attempt to impermissibly obtain privileged documents and other information from opposing counsel. Applicant's response to Document Request No. 6, for example, is not "nonsensical" as Opposer seems to believe. *See* Opposer's Motion at 18. Applicant is clearly permitted to rely on information provided by the USPTO, as the USPTO maintains registrations containing assertions by registrants of the potential goods and services that may be offered under those registrations. If Opposer contends that this information may not be relied on by third-parties, and thus the goods and services declared in its registrations are unreliable, then Opposer has committed fraud on the Board.

Opposer's complaints about Applicant's Interrogatory responses are equally baseless. For example, Opposer demands that Applicant should supplement its response to Interrogatory No. 5, but offers no explanation as to why Applicant's response – which is clearly responsive – was in any way inadequate. Opposer has simply taken this opportunity to assert complaints against Applicant for the sake of intimidating and harassing Applicant.

Applicant therefore respectfully requests that the Board deny this request. *See* Opposer's Motion ¶ 45(c).

D. Opposer's demands for Applicant to supplement its responses without objection is inappropriate, and is otherwise moot.

The duty to supplement is a continuing duty that arises after a party submits its initial discovery responses. Opposer's demands that Applicant do so are inapposite, as Applicant has never refused to comply with its duty to supplement under federal law, and in fact, has provided supplemental responses and documents pursuant to that duty. Opposer's request is thus moot.

Further, there is nothing under the FRCP or the Board's rules that holds that a supplementing party may not assert appropriate objections when providing supplemental information or materials. *Cf.* TBMP § 408.02 (responding party may not rely on information not included in responses "unless the response is supplemented in a timely fashion pursuant to Fed. R. Civ. P. 26(e)"). As Applicant noted above, Applicant only recently identified certain documents and things that arguably may be responsive to Opposer's initial discovery requests, and accordingly, timely supplemented its responses pursuant to FRCP 26(e) and 408.02 of the TBMP. Applicant therefore respectfully requests that the Board deny this request. *See* Opposer's Motion ¶ 45(d).

E. Opposer's demand that Applicant's supplemental responses include a detailed description of Applicant's investigations exceed the Board's requirements, and is otherwise moot.

A party to a Board proceeding has a duty to "thoroughly search its records for all information properly sought in the request." TBMP § 408.02. Applicant has affirmed that it thoroughly searched its records in responding to Opposer's initial discovery requests, and fully satisfied its complementary duty to supplement by providing Opposer with supplemental

materials. *See* Declaration of Roger Williams, Exhibit B. Applicant therefore respectfully requests that the Board deny this request. *See* Opposer's Motion ¶ 45(e).

F. Opposer's demand that Applicant produce all responsive documents without objection is inappropriate, and is otherwise moot.

Applicant never refused to provide non-privileged, responsive documents or things in its initial responses; it simply did not locate or identify any such responsive, non-privileged items. That does not constitute a refusal or failure of a party's discovery obligations. Consequently, there is no basis for precluding Applicant from asserting proper objections in regard to any of the supplemental materials that it has produced. In any event, Applicant supplemented its responses with documents that it recently identified after filing its initial responses, and even included some materials that arguably are beyond the scope of the documents sought by Opposer in its document requests.

In short, Applicant has produced *all* responsive, non-privileged documents in its possession, Opposer's request is thus moot, and the Board therefore should deny this request. *See* Opposer's Motion ¶ 45(f).

G. Opposer's demand that Applicant produce a privilege log is moot.

As noted above, Applicant has already produced a privilege log that conforms to the requirements of the FRCP (even though Opposer has yet to produce such a log). Opposer's request is thus moot, and Applicant therefore respectfully requests that the Board deny this request. *See* Opposer's Motion ¶ 45(g).

H. The Board should deny Opposer's request to test Applicant's admissions because Opposer merely seeks more than it is entitled to.

As explained in Applicant's response to Opposer's request to test Applicant's Admissions, *see infra*, Applicant's responses to Opposer's Admissions were adequate and in full

compliance with the Board's requirements. Opposer merely seeks to extract more information from Applicant than it is entitled to. Applicant therefore respectfully requests that the Board deny this request. *See* Opposer's Motion ¶ 45(h).

4. OPPOSER'S REQUEST TO TEST THE SUFFICIENCY OF APPLICANT'S ADMISSIONS SEEKS MORE THAN OPPOSER IS ENTITLED TO.

Section 407.03(b) of the TBMP states that responses to requests for admissions "should include an answer or objection to each matter of which an admission is requested." In doing so, the answer must:

1. admit the matter;
2. deny the matter; or
3. state in detail the reasons why the responding party cannot truthfully admit or deny the matter.

Id.

Applicant's responses to Opposer's Requests for Admissions fully complied with these requirements.

As to objections, Opposer complains that Applicant "fail[ed] to identify the bases for its objections." *See* Opposer's Motion at 54-55. In fact, Applicant's responses properly stated objections, as well as the bases for such objections. For example, in response to Opposer's Request Nos. 5-7, Applicant objected on the grounds that the requests were "vague and ambiguous." Applicant did not simply "object" to the requests without explanation; rather, it explained that the objection was being asserted "on the ground that it [i.e., each request] is vague and ambiguous." Applicant followed the same approach throughout its admission responses, clearly identifying the bases for its objections. The Board does not require more.

As to admissions or denials, Applicant admitted or denied each request where appropriate pursuant to the Board's requirements. For example, in response to Opposer's Request for

Admission No. 9, Applicant responded that it “denies Request No. 9.” Opposer believes that it is entitled to more, *see* Opposer’s Motion at 56, but TBMP § 407.03(b) does not require more.

Furthermore, Applicant expressly noted its objection to any request for admission “to the extent that such Admissions, including their definitions and instructions, seek to impose any obligation on Applicant beyond that required by the Federal Rules of Civil Procedure or the United States Patent and Trademark Office.” *See* Opposer’s Motion, Exhibit F, at 2. Thus, Applicant preserved its objection to Opposer’s attempt to seek more that it is entitled to.

For the foregoing reasons, Applicant respectfully requests that the Board deny Opposer’s Motion to Test Applicant’s Admissions.²⁰

WHEREFORE, Applicant Phoenix 2008 LLC respectfully requests that the Board,

1. Deny the Motion on the ground that such Motion exceeds the Board’s page limit for briefs on motions;
2. Deny the Motion’s request to compel as moot;
3. Deny the Motion for failing to present an adequate basis on which the Board could grant Opposer any relief; and
4. Grant Applicant any other relief that the Board deems just and appropriate.

²⁰ The Board should deny Opposer’s request to test Applicant’s admissions on the additional ground that Opposer’s Motion exceeds the Board’s page limits for briefs in support of motions.

Respectfully submitted,

By: 

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November 2, 2009

CERTIFICATE OF SERVICE

I do hereby certify that a copy of the foregoing “Response to Speed Channel, Inc.’s Motion to Compel and to Test the Sufficiency of Responses to Requests for Admissions” was sent on via e-mail November 2, 2009 to:

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