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

Proceeding	91189629
Party	Plaintiff Borghese Trademarks Inc.
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Attachments	Opposr's Reply in Support of Its Motion to Compel.pdf ( 5 pages )(238096 bytes )

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

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Borghese Trademarks, Inc.

Opposition No.: 91189629

Opposer,

Mark: PRINCE LORENZO BORGHESE'S  
LA DOLCE VITA

v.

Appl. Serial No.: 77/435,171

Multi Media Exposure, Inc.

Applicant.

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**OPPOSER'S REPLY IN SUPPORT OF ITS MOTION TO COMPEL DISCOVERY**

Opposer, Borghese Trademarks, Inc. ("Opposer"), respectfully moves the Board for leave to file a reply brief in support of its Motion to Compel discovery pursuant to Fed. R. Civ. P. 37.

**Applicant has not responded adequately to Opposer's requests for discovery**

Applicant claims in its response that Opposer's Motion to Compel is "moot" because "Applicant has responded to all outstanding discovery responses." However, the responses to discovery that Applicant sent to Opposer along with its motion response are incomplete, evasive, misnumbered, and non-responsive. Fed. R. Civ. P. §37(a)(4) provides, "An evasive or incomplete disclosure, answer, or response must be treated as a failure to disclose, answer or respond." Applicant has utterly failed in its duty to answer Opposer's discovery requests and should be compelled to respond.

Applicant's responses to Opposer's Requests for the Production of Documents Nos. 1, 2, 4, 7 and 8 essentially all state that "responsive documents will be provided at a mutually convenient time and place." However, Applicant has ignored the fact that during the initial

discovery conference, the parties agreed to the mailing of discovery documents. Therefore, the “responsive documents” referred to by Applicant should have been mailed along with their specific responses. Applicant is yet again attempting to evade their duty to respond adequately and obstruct Opposer’s efforts to obtain discovery on matters relevant to the present case as the Requests for Production of documents remain outstanding.

Applicant’s Responses to Opposer’s Requests for Admission are also non-responsive. Specifically, Applicant did not respond to Admission Request No. 9, and Admission request Nos. 11 through 17 appear to be misnumbered making it unclear which admission requests are being responded to. Therefore, these admission requests were not responded to in a timely manner and as such are deemed admitted.

Finally, there are also deficiencies in Applicant’s Responses to Opposer’s First Set of Interrogatories. As with the Admission Request responses, the responses are misnumbered so it is not clear to which requests Applicant is responding. The interrogatory labeled as “No. 4” (which Opposer believes to be its Interrogatory No. 6) asked Applicant to “Identify all labels and packaging ever used and/or which are intended to be used in the United States by or on behalf of Applicant bearing Applicant’s Mark.” In response Applicant states “Applicant refers Opposer to documents responsive to Opposer’s document requests.” Obviously, this is not an adequate answer as Applicant cannot refer Applicant to documents it refuses to produce. Applicant’s response to the interrogatory labeled as “No. 5” (which Opposer believes to be its Interrogatory No. 7), wherein it was requested to identify all expert witnesses, claims “attorney-client privilege” which is not an adequate or proper response to a request to identify expert witnesses. Applicant’s response to the interrogatory labeled as “No. 7” (which Opposer believes to be its interrogatory No. 12), wherein it was asked to set forth the basis for its denial of any of the

Request for Admissions, claims that the request “constitutes improper subject matter for an interrogatory.” Applicant’s answer to the interrogatory labeled as “No. 8” (which Opposer believes to be its Interrogatory No. 13) wherein it was asked to “identify the person(s) who provided information for each answer to respond to the Interrogatories” actually objected on the basis of relevance! As anyone who litigates knows, these types of interrogatory requests are common, permissible and relevant. Applicant has not responded to Opposer’s Interrogatories and they remain outstanding.

Fed. R. Civ. P. 26 (b) defines the scope and limits of discovery as “parties may obtain discovery regarding any nonprivileged matter that is relevant to any party’s claim or defense—including the existence, description, nature, custody, condition, and location of any documents or other tangible things and the identity and location of persons who know of any discoverable matter.” As shown above, Applicant has made objections in clear contradiction to this rule. The sloppiness, misapplication of rote answers and lack of candor or cooperation in answering Opposer’s discovery requests amounts to a set of completely non-responsive documents. As such, Applicant’s responses to Opposer’s discovery requests may still be considered to be outstanding.

**Applicant’s responses were provided well past the time such responses were due.**

Applicant claims it had a good faith belief that its responses were not due until July 16, 2010, because “the Board usually sets a deadline of thirty days after the resumption of a previously suspended proceeding for the service of any outstanding discovery.” However, the Board Orders on which Applicant relies to support this faulty argument were issued pursuant to completely distinguishable circumstances in the other cases. Each of the cited Board Orders were issued in response to consented Motions for Suspension for Settlement with Consent. In

those cases, the parties were actively engaged in settlement discussions so there was no need for discovery during that period. In the present case, however, Applicant's supposed "conciliatory efforts to resolve this matter amicably" were actually put forth to stall their having to produce information and documents in response to the outstanding discovery requests. Opposer has never agreed to, nor requested, settlement discussions. Therefore, Applicant's citation of Orders providing 30-days to respond to outstanding discovery are irrelevant to the proceedings at hand.

Applicant filed its Motion for Summary Judgment eight days prior to the deadline for responding to Opposer's discovery responses. TBMP §528.03 provides:

When a party files a timely motion for summary judgment, the Board will suspend proceedings in the case with respect to all matters not germane to the motion. The filing of a summary judgment motion does not, in and of itself, automatically suspend proceedings in a case, rather, proceedings are suspended when the Board issues an order to that effect...on a case-by-case basis, the Board may find the filing...provides a party with good cause for not complying with an otherwise outstanding obligation, for example, responding to discovery requests.

In the present case, the Board's October 28, 2009 Order stated, "Proceedings herein are suspended pending the disposition of applicant's unserved motion for summary judgment, with the suspension retroactive to the date of filing of the motion." At that point the Board included a footnote that cited the above rule and read "On a case-by-case basis, the Board may find the filing...provides a party with good cause for not complying with an otherwise outstanding obligation, for example, responding to discovery requests." Opposer understood this to mean Applicant's discovery responses would not be due until after the Board's Order deciding the summary judgment motion. The Board issued that Order on June 16, 2010 which meant that Applicant's responses to discovery were due eight days later on June 24, 2010. Applicant did not meet that deadline, and has still failed to provide responses to Opposer's discovery requests.

**CONCLUSION**

In light of the foregoing, Opposer respectfully request that its Motion to Compel be granted and Applicant be required to provide immediate responses without objection to the outstanding discovery requests of Opposer.

Respectfully submitted,

BAKER AND RANNELLS, P.A.

Date: July 22, 2010

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**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing **OPPOSER'S REPLY IN SUPPORT OF ITS MOTION TO COMPEL** in re Borghese Trademarks, Inc. v. Multi Media Exposure, Inc., Opposition No. 91189629 was served on counsel for Applicant, this 22nd day of July, 2010, by sending same via First Class Mail, postage prepaid, to:

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