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

Proceeding	91190298
Party	Plaintiff Cherokee Nation
Correspondence Address	Anthony J. Jorgenson Hall, Estill, Hardwick, Gable, Golden & Nelson 320 South Boston Avenue, Suite 200 Tulsa, OK 74103 UNITED STATES ajorgenson@hallestill.com
Submission	Motion to Compel Discovery
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Signature	/Anthony J. Jorgenson/
Date	10/08/2009
Attachments	DOC036[1].pdf (9 pages)(152531 bytes)

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

**CHEROKEE NATION, a federally recognized
Indian tribe,**

Opposers,

Opposition No. 91190298

v.

**LOST CHEROKEE OF ARKANSAS AND
MISSOURI, INC.,**

Applicant.

**OPPOSER'S MOTION TO COMPEL DISCOVERY AND RESET TRIAL DATES
WITH BRIEF IN SUPPORT**

Opposer, the Cherokee Nation moves the Board pursuant to Trademark Rule 2.120(e), 37 C.F.R. § 2.120(e), for an order compelling Applicant, The Lost Cherokee of Arkansas and Missouri, Inc., to participate in the mandatory discovery conference and produce initial disclosures.

The discovery period in this Opposition proceeding is currently set to close on January 25, 2010. Therefore, Opposer further moves the Board, pursuant to Trademark Rule 2.120(e), 37 C.F.R. § 2.120(e) and T.B.M.P. § 523.01, to suspend all further proceedings in this Opposition, including all discovery and testimony periods, pending the Board's ruling on this Motion and, upon resolution of the Motion, to reset the discovery, testimony and trial dates as contemplated by 37 C.F.R. § 2.120(a), T.M.B.P. § 403.04. In support hereof, Opposer respectfully submits its Brief in Support.

INTRODUCTION

1. On May 20, 2009, Opposer, Cherokee Nation filed its Notice of Opposition in this proceeding.

2. On May 20, 2009, the Board entered its Order requiring Applicant to file an Answer on or before June 29, 2009 and setting other discovery deadlines.

3. Pursuant to the Board's May 20, 2009 Order the parties were to conduct the Discovery Conference on or before July 29, 2009 and to exchange Initial Disclosures on or before August 28, 2009.

4. Applicant filed its Answer on or about June 29, 2009. In an email that same day, Applicant's counsel indicated that Applicant anticipated abandoning its trademark application in lieu of filing a new application. See Email from G. Speed to A. Jorgenson dated June 29, 2009, Ex. 1.

5. In reliance upon the representation that the application would likely be abandoned and in an effort to avoid unnecessary litigation costs, Opposer continually monitored the docket sheet for such an abandonment.

6. Because Applicant had not filed the abandonment, on August 4, 2009, August 25, 2009, and again on September 22, 2009, the undersigned counsel for Opposer attempted to determine whether Applicant would indeed abandon and, if not, to make arrangements to conduct the Discovery Conference. See Emails from A. Jorgenson to G. Speed dated August 4, 2009, August 25, 2009 and September 22, 2009, Ex. 1.

7. To date, Applicant has not abandoned its application, nor has Applicant responded to Opposer's requests to conduct the Discovery Conference. Because the Discovery

Conference has not been held, Opposer has effectively been precluded from commencing discovery.

8. Pursuant to Trademark Rule 2.120(e), 37 C.F.R. § 2.120(e), the undersigned counsel certifies that he has made a good faith effort to resolve the issues raised in this motion to compel, but has been unable to reach an agreement regarding when, or if, the requisite Discovery Conference will be conducted. As set forth above, counsel for Applicant indicated that Applicant would be abandoning the application. To avoid needless litigation expense should the application be abandoned, and in reliance upon Applicant's representation that an abandonment was forthcoming, counsel for Opposer waited for Applicant to file the abandonment. When after more than one (1) month passed without further communication from Applicant, Opposer wrote to counsel for Applicant on three (3) occasions to inquire as to the status of the abandonment or, alternatively, to schedule the Discovery Conference. Applicant has not responded to any of Opposer's attempts to communicate about those issues.

9. The deadline to conduct the Discovery Conference expired on July 29, 2009, and Initial Disclosures were due on August 28, 2009. Additionally, the discovery period is currently set to close on January 25, 2010. Because the parties have not yet conducted the Discovery Conference, Opposer has been precluded from conducting discovery under Trademark Rule 2.120(e), 37 C.F.R. § 2.120(e). Therefore, in the event Opposer's Motion to Compel is granted, Opposer will need additional time to conduct the Discovery Conference, exchange Initial Disclosures unless otherwise stipulated, and conduct written discovery. Alternatively, if Opposer's Motion is denied, Opposer will need additional time to seek leave from the Board to commence discovery in the absence of a Discovery Conference and prepare for the testimony period.

ARGUMENT AND AUTHORITIES

If one party fails to produce requested discovery, the other party may bring a motion to compel. See 37 C.F.R. § 2.120(e), T.B.M.P. § 523.01. The motion to compel must include a copy of the requested discovery and must contain a certification that the moving party or its attorney made a good faith effort, by conference or correspondence with the opposing party or its counsel, to resolve the issues addressed in the motion to compel. See 37 C.F.R. § 2.120(e)(1), T.B.M.P. § 523.02; see also Envirotech Corp. v. Compagnie Des Lampes, 219 U.S.P.Q. 448, 450 (TTAB 1979) (confirming that telephone call to opposing counsel sufficient to satisfy good faith requirement where adversary failed to respond to discovery).

Opposer respectfully submits that it has satisfied all of the requirements of a motion to compel. Applicant has failed to respond to Opposer's attempts to schedule the Discovery Conference and has not yet produced Initial Disclosures, and its time for doing so has expired. See 37 C.F.R. § 2.120(a); T.B.M.P. § 403.03. This Motion is brought prior to the opening of the first testimony period. In addition, Opposer's counsel certifies herein that he made a good faith effort to confer with counsel for Applicant to secure Applicant's participation in a Discovery Conference without need for a motion to compel. For these reasons, Opposer's Motion to Compel should be granted. See Jain v. Ramparts, Inc., 49 U.S.P.Q.2d 1429 (TTAB 1998) (granting motion to compel answers to interrogatories and responses to requests for documents)

Trademark Rule 2.120(e)(2) provides that in the event a motion to compel is filed, the opposition proceeding will be suspended pending resolution of the motion. See 37 C.F.R. § 2.120(e)(2), T.M.B.P. § 523.01. Because discovery in this proceeding is currently set to close on January 25, 2010, Opposer requests that the matter be suspended until such time as the Board has ruled on this Motion to Compel. Opposer further requests that upon resolution of the Motion

to Compel, the discovery, testimony and trial periods be reset to permit Opposer a reasonable amount of time following the resolution of the Motion to Compel within which to conduct discovery it has been precluded from conducting as a result of Applicant's unwillingness to participate in the Discovery Conference. See 37 C.F.R. § 2.120(a); T.M.B.P. § 403.04; see also Miss America Pageant v. Petite Prods., Inc., 17 U.S.P.Q.2d 1067, 1070 (TTAB 1990) (granting motion to compel and resetting scheduling order dates to permit follow-up discovery); Neville Chem. Co. v. Lubrizal Corp., 184 U.S.P.Q. 689, 690 (TTAB 1975) (same).

CONCLUSION

For the foregoing reasons, Opposer respectfully requests that the Board enter an order compelling Applicant to: (i) participate in a Discovery Conference with counsel for Opposer; and (ii) produce Initial Disclosures; (iii) suspending this proceeding during the pendency of the Motion to Compel; and, (iv) upon resolution of the Motion to Compel, resetting the discovery, testimony, and trial dates to permit Opposer an opportunity to conduct discovery it has been precluded from conducting to date.

Respectfully submitted,

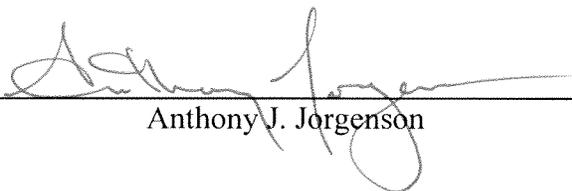


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**ATTORNEYS FOR OPPOSER,
CHEROKEE NATION**

CERTIFICATE OF FILING

I, Anthony J. Jorgenson, hereby certify that a copy of the foregoing **OPPOSER’S MOTION TO COMPEL DISCOVERY AND RESET TRIAL DATES WITH BRIEF IN SUPPORT** is being filed with the Electronic System for Trademark Trial and Appeals (“ETTS”) of the U.S. Patent and Trademark Office on this 8th day of October, 2009.



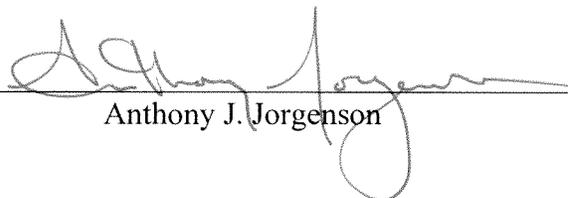
Anthony J. Jorgenson

CERTIFICATE OF SERVICE

I, the undersigned, do hereby certify that on this 8th day of October, 2009, a true and correct copy of the above and foregoing **OPPOSER’S MOTION TO COMPEL DISCOVERY AND RESET TRIAL DATES WITH BRIEF IN SUPPORT** was served upon Applicant at the following address:

Gary N. Speed
Speed Law Firm
111 Center Street, Suite 1200
Little Rock, AR 72201

by first class mail, proper postage prepaid, on this 8th day of October, 2009.



Anthony J. Jorgenson

1035633.1:231629:02060

Exhibit 1

Anthony Jorgenson

From: Anthony Jorgenson
Sent: Tuesday, September 22, 2009 5:11 PM
To: 'Gary Speed'
Subject: RE: Lost Cherokee of Arkansas and Missouri, Inc. / Trademark Opposition Nos. 9119089 and 91190299

Mr. Speed --

I just checked TTABVUE and noticed that your client has not yet abandoned its application. Please let me know when I can call you to conduct the discovery conference.

Thanks,

Tony Jorgenson

From: Anthony Jorgenson
Sent: Tuesday, August 25, 2009 11:26 AM
To: 'Gary Speed'
Subject: RE: Lost Cherokee of Arkansas and Missouri, Inc. / Trademark Opposition Nos. 9119089 and 91190299

Mr. Speed --

I am following up regarding the above-referenced matters. Please let me know if your client still intends to abandon its application. If not, please let me know when I should contact you to conduct the discovery conference.

Thanks,

Tony Jorgenson

From: Anthony Jorgenson
Sent: Tuesday, August 04, 2009 4:19 PM
To: 'Gary Speed'
Subject: RE: Lost Cherokee of Arkansas and Missouri, Inc. / Trademark Opposition Nos. 9119089 and 91190299

Mr. Speed --

I checked on the status of these matters today, and it appears that your client has not yet abandoned its application. Do you believe your client will do so in the near future? If not, we should probably set some time aside to conduct the discovery conference and discuss the exchange of initial disclosures.

Thanks,

Tony Jorgenson

From: Gary Speed [mailto:speedlaw@speedlaw.com]
Sent: Monday, June 29, 2009 4:44 PM
To: Anthony Jorgenson

10/7/2009

Subject: Lost Cherokee of Arkansas and Missouri, Inc. / Trademark Opposition Nos. 9119089 and 91190299

Mr. Jorgenson--

Attached are copies of answers filed today in the two above-referenced opposition matters. I anticipate that my client will be refiling its trademark application, and that it will be willing to abandoned the current application as filed. I will let you know when we have filed the new application. Thanks.

Gary N. Speed
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10/7/2009