

TTAB

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

COMEDY HALL OF FAME, INC.  
a Florida corporation,  
Opposer

v.

JEFFREY PANCER  
an individual,  
Applicant

In the matter of  
Application Serial No. 76621097  
For the mark: COMEDY HALL OF FAME

Published in the Official Gazette  
On December 1, 2009

Opposition No. 91194358

RESPONSE TO MOTION TO COMPEL

**OPPOSER'S RESPONSE TO APPLICANT'S MOTION TO COMPEL**

Opposer hereby responds to Applicant's Motion to Compel and requests that it be denied. Opposer contends that its objections were proper, that the documents were produced in accordance with applicable rules, and that true copies of documents have already been produced.

**CERTIFICATE OF MAILING**

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11-09-2010

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**I. Applicant's Interrogatories were Improper Inquiries into Opposer's Trial Evidence.**

In Interrogatories 7 and 8, Applicant requested that Opposer identify all documents that support Opposer's contentions in Paragraph 18 and 20 of its Notice of Opposition, to which request Opposer objected.

It is well-settled that a party need not, in advance of trial, identify its trial evidence or witnesses. *See, e.g., British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197 (TTAB 1993), *aff'd, Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); *Charrette Corp. v. Bowater Communication Papers Inc.*, 13 USPQ2d 2040 (TTAB 1989); TBMP 414 (7);

The Board has previously ruled that a request for an identification of all documents in support of allegations in a pleading is essentially equivalent to an improper request for trial evidence prior to trial. *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1656 (TTAB 2002). ("We find applicant's interrogatory requests that opposer 'identify each and every fact, document and witness in support of its pleaded allegations' to be equivalent to a request for identification of fact witnesses and trial evidence prior to trial, and therefore improper.")

The Board's interpretation in *Time Warner* was a necessity to give any meaning to the limitation. The set of documents which a party will submit as evidence to support an allegation in a pleading is necessarily a subset of *all* documents in support of that allegation. A party cannot ask for "All documents which support Allegation X in your pleading, which you intend to

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use at trial". To allow a party to omit the last seven words and ask for "All documents which support Allegation X in your pleading" would eviscerate that limitation.

Opposer therefore contends that this objection was proper, and requests that the Board uphold this objection.

## **II. Opposer Produced Documents As They Are Kept in the Usual Course of Business**

Many of Applicant's discovery requests were quite broad, seeking a wide (and vaguely defined) category of documents. In particular, Requests for Production Nos. 16, 17 and 18 were substantially broad, seeking:

- All documents and things referring or relating to, or showing or documenting that the term NATIONAL COMEDY HALL OF FAME is distinctive and famous
- All documents and things referring or relating to, or showing or documenting that the term COMEDY HALL OF FAME points uniquely and unmistakably to Opposer.
- All documents and things referring or relating to, or showing or documenting that members of the media and persons inside the field of comedy unmistakably associate the term COMEDY HALL OF FAME with Opposer.

These overly broad requests required Opposer to review years of files, and to determine which documents were representative examples of documents responsive to Applicant's requests. Many documents could be responsive to more than one request, and Opposer does not intend to limit the future applicability of any of its documents. Many of the documents referred to by Applicant in its motion fall under the general category of referring, relating, showing or documenting one (or all) of these requests.

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Opposer's files span the many years in which it has been providing services, and are organized according to categories: for example, Comedians (bio, research information, photos, etc.), Honors & Letters, Media & Museum, Comedy Research & Support, Politicians, Friar's Club, etc. Material is filed in the category the filer subjectively felt at the time best suited a document, as some material could arguably fall into more than one category.

When seeking documents responsive to these requests, Opposer reviewed its files, removed suitable materials and had them duplicated, keeping materials organized as they were kept in its files in the ordinary course of business.

Pursuant to TBMP 406.04(b), a party must produce documents as they are kept in the usual course of business, or must organize and label them to correspond with the categories in the request. Opposer chose to do the former.

As the Board has noted, a responding party is not required to organize documents to correspond to particular document requests, though it may if it so chooses. *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1556 (TTAB 2000).

Applicant has cited *Amazon Technologies, Inc. v. Wax*, 95 USPQ2d 1865 (TTAB 2010) for the principle that documents must be properly indexed. However, even Applicant notes that this was a case involving 17,000 documents, and a review of the decision reveals that the producing party in that case admitted that the documents were not being produced as they were kept in the usual course of business, which makes that case inapplicable to this situation.

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As noted by the Board in *No Fear*, it is not normally required that a party in a TTAB proceeding index its discovery responses. Decisions requiring such an index generally deal with vast quantities of documents, usually in the thousands or tens of thousands of pages. *See, e.g., Amazon Technologies, supra*, and the cases cited therein, including *Wagner v. Dryvit Systems, Inc.*, 208 F.R.D. 606, 610 (D. Neb. 2001), *Stiller v. Arnold*, 167 F.R.D. 68, 71 (N.D. Ind. 1996).

The production at issue is less than 300 pages. It comfortably fit within a single envelope when sent to Applicant. It would be difficult to characterize this production as being a voluminous mass of documents in the same nature as the production responses in the cases referenced by Applicant.

Opposer does not possess an index for the documents it has produced, and the burden it would bear in preparing such an index and organizing the documents as Applicant requests is no lighter than it would be for Applicant itself to index or organize the documents.

To say that even such a modest amount of documents as produced here must be indexed and organized by the responding party according to the propounding party's requests would remove the default provision stated in *No Fear*, and set as a general principle that indexing is required if a party chooses to extend the courtesy of photocopying and mailing its produced documents.

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**III. Dates Were Not Improperly Redacted from the Produced Documents**

Opposer's production contains some documents which had dates redacted by Opposer's marketing director several years ago, long prior to this proceeding, as she felt the dates distracted from the contents and did not serve a useful purpose.

Any redactions of dates appear also on the originals in Opposer's possession, and these alterations took place many years prior to this proceeding. No dates were altered or redacted only on the copies produced to Applicant, nor have any dates been redacted during or in contemplation of this proceeding.

**IV. Opposer Objects to a Party-Specific Extension of Time**

Opposer has argued that its discovery responses were proper and this motion to compel is therefore unreasonable. As such, it objects to any extension of the discovery period limited to one party.

Pursuant to 37 CFR §2.120(e)(2), a motion to compel generally results in a suspension of the proceeding with respect to all other matters. As such, Opposer would not object to an extension of the discovery period for both parties, inasmuch as both parties have been unable to file or serve any other papers unrelated to this discovery dispute while this motion was pending.

However, Opposer contends that Applicant has failed to show the type of extreme conduct required for the Board to extend the discovery period solely for the benefit of one party, and therefore argues against any such one-sided extension.

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**CONCLUSION**

Opposer contends that its discovery responses were proper, and that its objections should be upheld. While it objects to any unilateral extension, Opposer would support the trial calendar being reset in such a manner as to allow for fair discovery by both parties.

Respectfully submitted,



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Attorney for Opposer

11/03/2010  
Date

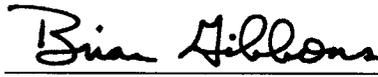
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CERTIFICATE OF SERVICE

I hereby certify that a true and accurate copy of the foregoing document is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to Andrew B. Katz, Chernow Katz LLC, 721 Dresher Road, Suite 1100, Horsham, PA 19044 this 3<sup>rd</sup> day of November, 2010.



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