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

Proceeding	91195327
Party	Plaintiff Hard Candy Cases, LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application Serial No.	:	77/700,559
For the Mark	:	Hard Candy
Filed	:	March 27, 2009
Published in the Trademark Official Gazette on	:	February 16, 2010

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HardCandy Cases, LLC	:	
Opposer,	:	Opposition No.: 91195327 (Parent) Opposition No.: 91195328
v.	:	
Hard Candy, LLC	:	Reply to Applicant's Response in Opposition to Motion for Order to Compel Discovery
Applicant.	:	

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Commissioner for Trademarks
P.O. Box 1451
Arlington, VA 22313-1451

REPLY TO APPLICANT'S RESPONSE IN OPPOSITION TO MOTION FOR ORDER TO COMPEL DISCOVERY

HardCandy Cases, LLC ("Opposer"), by and through its undersigned counsel hereby replies to the Response in Opposition to Motion for Order to Compel Discovery filed by Applicant Hard Candy, LLC ("Applicant") on January 18, 2012 in Opposition No.: 91195328. Pursuant to Trademark Trial and Appeal Board Manual of Procedure (TBMP) Rule § 539, Opposer hereby moves to strike Applicant's response on the grounds that the answering brief was not timely filed.

I. APPLICANT'S RESPONSE WAS NOT TIMELY FILED

Opposer filed a Motion for Order to Compel Discovery on December 28, 2011. As noted on the Certificate of Service, Opposer sent copies of all filed documents to Applicant's counsel, Gabriel Groisman, on December 28, 2011 by First Class Mail and electronic mail.

Pursuant to TBMP Rule § 502.02(b), Applicant had an extended period of 20 days (15 days plus a five day extension period due to service being made by First Class Mail) following the date of service to file a brief in response to the Motion for Order to Compel Discovery. Under 37 CFR § 2.119(c), the date of service was the date of mailing, December 28, 2011. The latest date Applicant could have filed its reply brief was therefore January 17, 2012, 20 days after December 28, 2011. Applicant missed the January 17, 2012 deadline by filing its reply on January 18, 2012. Opposer notes that in addition to the reply brief not being timely filed, Applicant filed its response in Opposition No. 91195328, a case that has been consolidated with the present "parent" case.

II. APPLICANT'S HISTORY OF DELAYS

Applicant has displayed a pattern of delaying its responses and communications until the last possible moment or beyond. For example, Applicant had until December 9, 2011 to respond to Opposer's First Set of Interrogatories and Opposer's First Request for Production of Documents. However it was not until December 8, 2011, just before the deadline, that Applicant first notified Opposer that it did not intend to respond to the discovery requests. Applicant mistakenly believed that Opposer had not served

Applicant with its Initial Disclosures by the September 8, 2011 deadline, and called the discovery requests "a nullity" because of this supposed failure to serve Initial Disclosures. Despite Applicant's belief that the Initial Disclosures were three months past due, Applicant did not inform Opposer that there were any problems until December 8, just before the discovery responses were due. Applicant's beliefs about the Initial Disclosures were in error, and Opposer provided proof that it had served Applicant with the Initial Disclosures on September 8 by mailing them via first class mail on that date. After receiving the proof of service, Applicant requested that it be given until December 23 to respond to the discovery requests. Opposer granted an extension until December 13 under the condition that all discovery would be responded to or a signed consent agreement was in place. Applicant apparently declined the offer of an extension, and served Opposer with its responses and objections to the discovery requests the next morning, on December 9.

In summary, Applicant was refusing to respond to Opposer's discovery requests as of the afternoon of December 8, but then, despite first indicating that it needed a two week extension in order to properly respond, Applicant was able to provide 61 pages of responses and objections by the next morning in order to meet the deadline. Due to the repetitive and non-responsive nature of the objections, it is likely that Applicant copied and pasted stock objections to each of the 175 Requests for Production and five Interrogatories without fully evaluating the merits of each discovery request, simply to respond to the requests quickly in order to meet the December 9 deadline and avoid meeting the conditions for an extension of the deadline. While Applicant technically served responses to the discovery requests on time, its quick turnaround from a stated

intention to not respond at all to providing 61 pages of duplicative objections the next morning shows that Applicant's "responses" were in actuality evasive or incomplete responses, which must be treated as a failure to respond under Rule 37(a)(4) of the Federal Rules of Civil Procedure. Applicant should be deemed to have waived its objections by not properly responding on time and be compelled to provide full responses to the discovery requests.

Applicant's practice of responding late continued with the filing of its Response in Opposition to Motion for Order to Compel Discovery on January 18, 2012, one day after the January 17, 2012 deadline.

III. APPLICANT'S RESPONSE WAS INSUFFICIENT

Due to Applicant's late response on January 18, 2012, Opposer moves to strike Applicant's Response in Opposition to Motion for Order to Compel Discovery. In the event that the motion to strike is not granted, Opposer notes that Applicant's response did not adequately address the merits of the Motion for Order to Compel Discovery.

Applicant's response simply repeats its earlier objections that Opposer's discovery requests were unduly burdensome, overbroad, irrelevant, unrelated to the Opposition, not likely to lead to the discovery of admissible evidence, were intended to harass Applicant, sought confidential information about a competitor, and were impermissible fishing expeditions. None of these allegations are accurate. While Opposer's discovery requests were admittedly voluminous, they were not submitted for any improper purpose, and were directly related to allegations contained in Opposer's Notice of Opposition.

Opposer alleged in its Notice of Opposition that Applicant had filed more than 100 federal trademark applications since 1996 that have been abandoned either expressly or for a failure to file a statement of use. Opposer also alleged that Applicant had exhibited a pattern and practice of filing multiple intent-to-use trademark applications across multiple classes of goods and subsequently abandoning the underlying applications for failure to file statements of use. These actions supported a further allegation that Applicant did not have a bona fide intent to use the applied-for marks. In compliance with Rule 26(b)(1) of the Federal Rules of Civil Procedure, Opposer's discovery requests ask for relevant information related Opposer's claims that is reasonably calculated to lead to admissible evidence.

The discovery requests seek evidence admissible to prove the allegations of Applicant's habit of a lack of bona fide intent to use applied-for marks. Evidence of a habit and/or routine practice is admissible under Rule 406 of the Federal Rules of Evidence. Should Applicant not be able to provide any such evidence, Applicant's lack of documentary evidence showing a bona fide intent to use can also be admissible evidence. See Spirits Int'l B.V. v. S.S. Taris Zeytin Ve Zeytinyagi Tarim Satis Kooperatifleri Birligi, 99 USPQ2d 1545 (TTAB 2011)); Boston Red Sox Baseball Club LP v. Sherman, 88 USPQ2d 1581, 1587 (TTAB 2008); and Commodore Electronics Ltd. v. CBM Kabushiki Kaisha Opposition, 26 USPQ2d 1503, 1507 (TTAB 1993). The discovery requests are necessary, as Opposer has no other way of gaining this evidence.

Further, Opposer's discovery requests did not ask for documents "related to every other trademark application Applicant has ever filed," contrary to Applicant's claim. The discovery requests instead only asked for information related to applications filed for

similar "HARD CANDY" or "HC" marks, a subset of the over 100 trademark applications filed and then abandoned by Applicant since 1996.

Applicant appears to have made its repetitive and non-responsive objections simply in order to respond to the discovery requests on time, without properly reviewing the requests for production and interrogatories, and its Response in Opposition to Motion for Order to Compel Discovery provides no further rationale for its failure to properly respond to the discovery requests. For example, Applicant has not yet provided an adequate explanation as to why it has not provided discovery documents related to Trademark Application No. 77700557, the trademark filing specifically at issue in this case. Documents and information related to Application No. 77700557 were requested in at least Requests for Production 91, 92, and 93 and all five Interrogatories. These requests are calculated to lead to admissible evidence regarding Applicant's bona fide intent to use the applied-for mark at issue, and as such cannot be overbroad, irrelevant, or unrelated as Applicant claims. Even if Applicant had objections to the other discovery requests, Applicant should have objected to those while providing adequate responses to the requests regarding Application No. 77700557.

IV. MEET AND CONFER DELAYS

Opposer attempted to confer with Applicant regarding the insufficient discovery responses, but Applicant's counsel had left the country without notifying Opposer. Applicant's counsel furthermore indicated that no one else in his office could discuss the matter with Opposer, and discussions would need to wait until he returned to the United States. These actions fit with Applicant's habit of delaying communications until the last

possible moment or beyond. Applicant's insufficient responses and travel delays would have pushed discovery closer to the deadline and could have precluded scheduling depositions, therefore Opposer had no choice but to file the Motion for Order to Compel Discovery.

V. CONCLUSION

Because Applicant's response to Opposer's Motion for Order to Compel Discovery was filed after the 20 day window provided by TBMP Rule § 502.02(b), Applicant's response should be struck and Opposer's motion granted. If Applicant's response is not struck, Opposer's motion should nevertheless be granted because Applicant's response did not adequately address the issues it presented.

Respectfully Submitted,

/s/ Stuart J. West

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Certificate of Service

IT IS HEREBY CERTIFIED that a true and correct copy of the foregoing was served on this 7th day of February, 2012 by First Class Mail and email to:

Gabriel Groisman
ggroisman@coffeyburlington.com
Coffey Burlington
Office in the Grove, Penthouse
2699 South Bayshore Drive
Miami, FL 33133

By: _____ Dated: 2/7/2012
Shaun Sluman