

ESTTA Tracking number: **ESTTA616843**

Filing date: **07/21/2014**

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

Proceeding	91196299
Party	Defendant Digitalmojo, Inc.
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Attachments	2014 07 21 - Reply in Motion to Compel - CONNECT.pdf(122693 bytes )

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<b>Opposition No. 91196299 (Parent)</b>	)	
	)	
CONNECT PUBLIC RELATIONS, INC.	)	
Opposer,	)	
	)	
v.	)	
	)	
DIGITALMOJO, INC., Applicant	)	<b>APPLICANT’S/PETITIONER’S</b>
	)	<b>REPLY IN SUPPORT OF ITS</b>
	)	<b>MOTION TO COMPEL</b>
	)	<b>SUPPLEMENTAL RESPONSES</b>
	)	
<b>Cancellation No. 92054395</b>	)	
<b>Cancellation No. 92054427</b>	)	<b>Fed. R. Civ. P. 56(f)</b>
	)	
DIGITALMOJO, INC.,	)	
Petitioner,	)	
	)	
v.	)	
	)	
CONNECT PUBLIC RELATIONS, INC.	)	
Respondent.	)	

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DigitalMojo, Inc., Applicant and Petitioner in these consolidated cases (“DigitalMojo”) submits this Reply and Memorandum in support of its: Motion to Compel Supplemental Responses to: 1. Petitioner’s Interrogatories, Set One and Set Two, and 2. Petitioner’s Requests for Admissions, Sets One and Two, Necessary for Response to Opposer’s Motion for Summary Judgement Fed. R. Civ. P. 56(f), and for Leave to Serve Additional Discovery (the “Motion to Compel”).

DigitalMojo addresses the points raised by Opposer and Respondent Connect Public Relations, Inc. (“Connect”) in the order in which they are raised in Connect’s Memorandum in Opposition to DigitalMojo’s Motion to Compel (Connect’s “Response”).

## **I. INTRODUCTION**

Connect has begun with an “introduction” about lack of support for DigitalMojo’s Motion to Compel alleging the Motion to Compel is not supported by an affidavit. However, since Connect continues its discussion on this point in two succeeding sections of its Response. DigitalMojo will therefore address this point below.

## **II. LEGAL REQUIREMENTS UNDER RULE 56(d) AND TBMP § 528.06**

Connect continues its Response by reference specifically to TBMP § 528.06, and by citation to various case law. DigitalMojo assumes Connect’s references and citation are correct.

## **III. DIGITAL MOJO’S MOTION TO COMPEL SHOULD BE GRANTED**

Connect concludes DigitalMojo’s Motion to Compel is insufficient for two reasons (as near as DigitalMojo can make out) for two reasons:

First, Connect states that DigitalMojo did not file a separate affidavit alleging facts. Connect goes to far as to say “DigitalMojo’s failure to provide a supporting affidavit mandates that the Board deny its Motion to Compel.” This assertion appears to put form over substance, given the appearance of counsel for DigitalMojo in these consolidated cases, and his statement, on page 2 of the Motion to Compel, under FACTS AND STATUS OF CASES:

*“THOMAS W. COOK, counsel for DigitalMojo in these consolidated matters, hereby affirms under penalty of perjury:”*

Of course, the purpose of the declaration is to provide such facts as are necessary to support the Motion to Compel. Counsel for DigitalMojo has identified himself in these consolidated cases, and has provided his affidavit with his statement regarding the facts in this case. However, should the Board determine counsel for DigitalMojo should provide a separate affidavit, he will be glad to do so.

Second, Connect states that DigitalMojo's Motion to Compel is insufficiently specific about its areas of inquiry. However, DigitalMojo has provided in its Motion to Compel copies of the discovery it has served on Connect, copies of Connect's responses to that discovery, and a copy of its formal, written, "Meet and Confer" request for supplemental responses which sets forth the deficiencies in Connect's responses (Motion to Compel Exhibit D). These documents as a group set forth with specificity the areas of inquiry needed to obtain the information necessary to enable DigitalMojo to respond to Connect's Motion to Compel. In fact, they comprise specific questions within such areas of inquiry. For example, DigitalMojo has in PETITIONER'S INTERROGATORIES, SET TWO, asked this question:

*INTERROGATORY NO. 55 - State which services Opposer has ever offered or supplied under the mark CONNECT PUBLIC RELATIONS, other than those identified in its pending application for registration of CONNECT MARKETING, serial number 85061227.*

This Interrogatory 55 is directed to the issue of abandonment of Connect's registrations. That issue is again raised by Connect in the assertion raised in Connect's Motion for Summary Judgment, at its Section IV, that "...there is no genuine dispute that it has not abandoned its CONNECT PUBLIC RELATIONS MARK..." Connect is correct that DigitalMojo has asserted in its Second Amended Petitions that Connect "switched" its Class 35 marks in favor of the mark CONNECT MARKETING, and Connect has contended in its Motion for Summary Judgment and elsewhere that "Connect's adoption of the CONNECT MARKETING mark and the corporate name change were done as part of a brand 'expansion' and not a brand 'switch.'" (Motion for Summary Judgment, top of page 11). Interrogatory 55 is intended to determine what services Connect is supplying under these two marks, to thereby determine whether such a "switch" has occurred.

As a second example, DigitalMojo has in the same interrogatories asked this question:

*INTERROGATORY NO. 57 - State what industries Opposer refers to, when it uses the phrase "this specific market-place," as that phrase is used in the document numbered CPR 000643 produced by Opposer.*

This Interrogatory 57 is directed to the issue of likelihood of confusion between DigitalMojo's mark CONNECT and Connect's marks (CONNECT PUBLIC RELATIONS and CONNECTPR). That issue is again raised by Connect in Connect's Motion for Summary

Judgment, at its Section V, with the assertion that “...there is no genuine dispute that the Goods/Services of the Connect Marks and of the Opposed Mark are identical or legally related...” (Motion for Summary Judgment, page 17, and following pages). The resolution of this issue will be governed by the relationship between the services DigitalMojo has identified in its application, and the services Connect has identified in its registrations for CONNECT PUBLIC RELATIONS and CONNECTPR. Interrogatory 57 is intended to determine what the phrase “this specific market-place” means when Connect uses this phrase in its marketing materials, to thereby determine whether “...the Goods/Services of the Connect Marks and of the Opposed Mark are identical or legally related...”.

For further example, DigitalMojo has in PETITIONER’S REQUESTS FOR ADMISSIONS, SET TWO, asked these three questions:

*REQUEST FOR ADMISSION NO. 435 - Admit the following text appears on Opposer’s web site, at: <http://www.connectpr.com/focus.html>:*

*“Connectivity (SM) surrounds us: The CEO checking stock prices at the airport, the sales executive reading email at Starbucks and the teenager instant messaging friends at the game. Connectivity (SM) is technology that helps people interact with each other. Hardware or software, computer or telephony, Connectivity (SM) today is a trillion dollar market. “Connect Public Relations® focused on this market from the earliest days. We’ve helped more than 400 firms make their mark in the Connectivity (SM) space. We’ve met with thousands of analysts and journalists. We’ve secured more than 200,000 articles for our clients. “In short, we know the Connectivity (SM) market. We should...it’s been our only focus since 1989.”*

*REQUEST FOR ADMISSION NO. 436 - Admit Opposer’s use of the description of “connectivity” as set forth in Request No. 435 of these Requests, and on Opposer’s web site, refers to “technology that helps people interact with each other” which may be of use to Opposer’s clients when dealing with their customers.*

*REQUEST FOR ADMISSION NO. 437 - Admit Opposer's use of the description of "connectivity" as set forth in Request No. 435 of these Requests, and on Opposer's web site, does not refer to "technology that helps people interact with each other" supplied by Opposer directly to consumers.*

In these three questions, DigitalMojo has again taken up the question of the relationship between the services supplied by DigitalMojo and the services supplied by Connect. Connect must and does contend in these actions that the services of these companies are related, while DigitalMojo contends that its services are directed to consumers only, and while the services of Connect are directed to businesses only. This question is raised directly by Connect in its Motion for Summary Judgment as it asserts "Connect's Class 35 registrations both broadly recite, without restriction: 'marketing and market research and consulting services; public media relations services and sales promotion services.'" Connect assumes, without directly stating it, that the meaning of this identification of services is clear. Connect then goes on to define the word "marketing" for us (Motion for Summary Judgment, page 19), and argue that the words of DigitalMojo's identification "comparative marketing" and "marketing of high speed telephone, Internet, and wireless access," must be related to Connect's identified services because such services are "...types of marketing and overlap with, or are a subset of, ConnectPR's broadly worded and unrestricted 'marketing services.'" (Motion for Summary Judgment, page 19). Connect makes a similar argument in its Motion for Summary Judgment about DigitalMojo's "promoting the goods and services of others" when Connect asserts are "nearly legally identical" to Connect's broadly worded "sales promotion services." After all, says Connect's "expert" Christensen, these services "both use grammatical equivalents of the core term 'promote.'"

We set aside for the moment that the word "grammar" refers, in linguistics, to the set of structural rules governing the composition of clauses, phrases, and words in natural languages, and not just a simple correlation between the root word "promote," and words with prefixes and suffixes which may be based on that root word, as Christensen implies. Instead, we note that any focus on a single word within an identification consisting of many words cannot lead us to a reasoned conclusion about whether services are legally related. The legal inquiry must be on questions such as "to whom is this marketing and promotion directed" (our target market), and "how do we reach those within our target market." DigitalMojo's requests for admissions 435 through 437 are calculated precisely to answer those questions, as those questions make a

distinction between services supplied to “consumers” (those who use DigitalMojo’s identified services), and non-consumer businesses (those who use Connect’s identified services). DigitalMojo wishes to make the reasonable and legally significant distinction between, on the one hand, its “marketing” and “promoting” of the services of businesses to consumers under its mark CONNECT and, on the other hand, Connect’s services which allow its clients to more effectively “market” and “promote” their services under their own marks. DigitalMojo’s “marketing and promotion” services put its mark CONNECT in front of consumers, while Connect’s “marketing and promotion” services result in presentation of the marks of Connect’s clients to consumers. With such a separation in the markets of DigitalMojo and Connect, no prospective user of the services of either company can be confused. The substantive answers to DigitalMojo’s requests for admissions 435 through 437 (and DigitalMojo’s other requests) should make this market separation much clearer, and such answers (along with answers to DigitalMojo’s other requests) are necessary to respond to Connect’s Motion for Summary Judgment.

#### **IV. CONNECT SHOULD BE COMPELLED TO SUBSTANTIVELY RESPOND TO DIGITALMOJO’S REQUESTED DISCOVERY, EITHER ON THIS MOTION TO COMPEL, OR ON LEAVE TO SERVE SUCH DISCOVERY**

Connect correctly points out that DigitalMojo is requesting additional discovery in this Motion to Compel because of the unusually numerous or complex issues involved in these cases. DigitalMojo has pointed out in its moving paper the timing of the early discovery served in, and the joinder of, these cases. The joinder of DigitalMojo’s Petitions to Cancel two of Connect’s registrations has raised issues which, according to Connect, could not be previously raised. As but one example, we may note a representative question taken from PETITIONER’S REQUESTS FOR ADMISSIONS, SET ONE:

*REQUEST FOR ADMISSION NO. 127 - Admit the documents numbered CPR 000375 - CPR 000376 refer to the registration of the mark CONNECT PUBLIC RELATIONS, registered under number 2373504, and that all goods and/or services “listed in the existing registration” comprise: “Marketing and market research and consulting services; public and media relations services and sales promotion services.”*

To this question, Connect has objected, in part, with the following statement: “Opposer objects to this request as being irrelevant as Opposer’s use of its marks is not at issue.” Exhibit B to the Motion to Compel. Of course, Connect’s use of its marks is very much at issue after the joinder of DigitalMojo’s petition to cancel, and Connect should not now be heard to say DigitalMojo is not entitled to ask questions about Connect’s use of its marks when Connect would not answer those same questions earlier claiming its registrations were “not at issue.”

As to whether DigitalMojo should have filed a motion for leave to propound additional discovery, DigitalMojo has in its moving paper requested precisely such leave. DigitalMojo could not know until it received Connect’s responses that such responses would be insufficient and evasive, nor did it know Connect would object to DigitalMojo discovery; DigitalMojo assumed Connect would in good faith attempt to answer DigitalMojo’s discovery with reasonable, substantive, responses. Given Connect’s evasions in its responses received after close of discovery, and the additional questions presented in its Petitions, and the need for responses to questions such as those set forth above and in its discovery necessary to decide these cases on the merits, DigitalMojo thinks such leave should be granted.

As to whether DigitalMojo’s Motion to Compel was brought within a reasonable time, DigitalMojo should note again here that, as to DigitalMojo’s Requests for Admissions, Connect did not merely fail to respond to DigitalMojo’s original set of Requests (served prior to the joinder of DigitalMojo’s Petitions), Connect objected to many of those Requests saying “Opposer objects to this request as being irrelevant as Opposer’s use of its marks is not at issue.” We might argue about whether those of DigitalMojo’s Requests answered in this way were irrelevant, but as a technical matter Connect was correct that its registrations were “not at issue” at the time, and it may have been futile for DigitalMojo to argue about Connect’s objections of this character.

However, after the joinder of these Petitions into this opposition, the most reasonable and economical method of dealing with questions to which this kind of objection was asserted is to serve the Requests containing those questions again. And while Connect points out DigitalMojo has cited no authority that would allow it to re-serve discovery requests, Connect has cited no authority which suggests DigitalMojo cannot re-serve discovery requests. Connect has simply opined DigitalMojo has inappropriately re-served its Requests for Admission “Instead of following proper procedure...”

As to whether DigitalMojo served its discovery “within a reasonable time...after the service of the response believed to be inadequate...,” Connect does not contend that DigitalMojo failed to file this Motion to Compel within a reasonable time after it received Connect’s responses served on April 21, 2014 (for discovery served by DigitalMojo prior to the close of discovery). Connect contends that DigitalMojo “...is precluded from seeking relief on this issue through its Motion to Compel after Connect served its original responses in December of 2011. However, Connect does not tell us what a reasonable period of time is, only that DigitalMojo could not have served its responses within that reasonable period of time. We might recall in this regard that much has occurred in these cases since the December 2011 date which Connect says governs our “reasonable time,” and much of the time has ticked off while the parties (but more often Connect) have filed motions and those motions were pending. These motions include pendency of Connect’s Motion for Summary Judgment, filed October 28, 2011 (as amended). By February 23, 2012 Order of the Board, Proceedings herein were suspended retroactive to August 26, 2011, pending disposition of Connect's corrected motion for partial summary judgment in Opposition No. 91196299 and Connect’s motions to dismiss and the second motions for leave to file amended petitions to cancel in Cancellation Nos. 92054395 and 92054427. Connect’s October 28, 2011, Motion for Summary Judgment was not decided until March 21, 2013. In the meantime, Connect opposed DigitalMojo’s Amended Petitions to Cancel (March 9, 2012), and those Petitions were amended (October 1, 2012). After the Board’s decision on Connects October 28, 2011, Motion for Summary Judgment, the Board decided Connect’s April 18, 2013, motions for partial reconsideration of the Board’s March 21 Order, and resumed these cases once again (August 14, 2013). Thus, much of the “two and one half years” period Connect contends is more than a “reasonable time,” we were occupied with Connect’s motions, and these cases have been suspended.

DigitalMojo submits that the circumstances of any single case could, in fact, “restart the clock for determining a “reasonable time,” contrary to Connect’s suggestion, and this is just such as case. DigitalMojo also submits that, under the circumstances of this case, its re-serving of its Requests for Admissions may be taken as an objection to Connect’s responses as originally served. In either case, this Motion to Compel should be granted because of its special circumstances, or DigitalMojo should be granted leave to re-serve its discovery (or serve additional discovery, in the case of its interrogatories).

## V. CONCLUSION

DigitalMojo submits that, when all of the forgoing is considered, the Board will grant DigitalMojo's Motion to Compel (or grant it leave to serve additional discovery), or grant DigitalMojo's Motion to Compel in part as appropriate. We note in this regard that DigitalMojo has requested supplemental responses to its discovery requests as served on Connect on March 12 and March 13, 2014, i.e.,:

- a. PETITIONER'S INTERROGATORIES, SET ONE.
- b. PETITIONER'S INTERROGATORIES, SET TWO.
- c. PETITIONER'S REQUESTS FOR ADMISSIONS, SET ONE.
- d. PETITIONER'S REQUESTS FOR ADMISSIONS, SET TWO.

Connect's responses to these discovery requests are needed to enable DigitalMojo, as nonmoving party, to respond to the Motion for Summary Judgment filed by Connect on April 29, 2014. Fed. R. Civ. P. 56(f).

DigitalMojo further requests the Board reset the discovery and trial schedule in these consolidated proceedings as necessary to allow service of these discovery requests (if necessary) by DigitalMojo, and responses to these requests by Connect, and DigitalMojo requests the Board allow DigitalMojo one month to respond to the Motion for Summary Judgment filed by Connect on April 29, 2014 after the Board decides the discovery issues presented in this Motion to Compel. While DigitalMojo thinks the Board will not act on Connect's request that the Board "strongly consider granting Connect's Motion for Summary Judgment" now, DigitalMojo here also requests the Board decline to follow Connect's suggested course as to its Motion for Summary Judgment.

Date: July 21, 2014



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CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this document is today being submitted via electronic filing utilizing the ESTTA system on:

Date: July 21, 2014



Thomas W. Cook

CERTIFICATE OF SERVICE

This is to certify that on this date, a true copy of the foregoing

**APPLICANT'S/PETITIONER'S REPLY IN SUPPORT OF  
ITS MOTION TO COMPEL SUPPLEMENTAL RESPONSES**

is being served, by U.S. mail, postage prepaid, addressed to the following:

Karl R. Cannon  
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