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

Proceeding	91196299
Party	Plaintiff Connect Public Relations, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Opposition No. 91196299 (Parent)
CONNECT PUBLIC RELATIONS, INC.,
Opposer,
v.
DIGITALMOJO, INC., Applicant.

Cancellation Nos. 92054395 & 92054427
DIGITALMOJO, INC., Petitioner,
v.
CONNECT PUBLIC RELATIONS, INC.,
Respondent.

**MEMORANDUM IN OPPOSITION
TO MOTION TO COMPEL**

Opposer and Respondent Connect Public Relations, Inc. ("Connect") opposes Applicant and Petitioner Digitalmojo, Inc.'s ("Digitalmojo") *Motion to Compel Supplemental Responses to 1. Petitioner's Interrogatories Set One and Set Two, and 2. Petitioner's Requests for Admissions,*

Set One and for Leave to Serve Additional Discovery (“Motion to Compel”) for the reasons stated herein.

I. INTRODUCTION

Digitalmojo’s Motion to Compel should be denied because Digitalmojo failed to comply with the basic procedural rules of the Federal Rules of Civil Procedure and the TBMP. More specifically, Digitalmojo should not be awarded additional interrogatories in excess of the 75 interrogatory limit set in 37 C.F.R. § 2.120(d)(1) and TBMP § 405.03(a) because the request is untimely, and Connect cannot be compelled to provide responses to the 2014 RFA because the Motion to Compel was not brought within a reasonable time as required by TMBP § 523.03.

(Note: In lieu of resubmitting duplicate copies of the relevant discovery requests and responses, Connect will cite to the exhibits attached to Digitalmojo’s Motion to Compel in the footnotes of this opposition.)

II. DIGITALMOJO’S MOTION TO COMPEL SHOULD BE DENIED AND DIDGITALMOJO IS NOT ENTITLED TO THE REQUESTED DISCOVERY, FOR FAILURE TO COMPLY WITH BASIC PROCEDURAL RULES SET FORTH IN THE FEDERAL RULES OF CIVIL PROCEDURE AND THE TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE

A motion for leave to serve additional interrogatories must be filed and granted prior to the service of the proposed additional interrogatories and must be accompanied by a copy of the interrogatories, if any, which have already been served by the moving party, and by a copy of the interrogatories proposed to be served. 37 C.F.R. § 2.120(d)(1). Digitalmojo complied with neither of these requirements.

Digitalmojo served additional discovery requests, beyond the limits agreed upon, on the last day of the discovery period, without filing the required motion, and without providing a copy of all interrogatories that had already been served.

More specifically, Digitalmojo requests that Connect be compelled to provide responses to (i) Petitioner's Interrogatories, Set One¹ served on March 12, 2014 and Petitioner's Interrogatories, Set Two² served on March 13, 2014 (collectively "2014 Interrogatories"); and (ii) Petitioner's Requests for Admission, Sets One and Two³ served on March 13, 2014 (collectively "2014 RFA"). For the reasons set forth below, Connect submits that Digitalmojo is procedurally barred from receiving responses to its 2014 Interrogatories and 2014 RFA.

A. Digitalmojo Should Not Be Awarded Additional Interrogatories in Excess of the 75 Interrogatory Limit Set in 37 C.F.R. § 2.120(d)(1) and TBMP § 405.03(a) Because the Request is Untimely

Digitalmojo had already exhausted its allotment of 75 interrogatories, and then served additional discovery requests untimely and on the last day of the discovery period, without filing the required motion. The discovery period closed on March 13, 2014, the same day Digitalmojo filed the last of its additional discovery requests beyond the limit it had already exhausted.

Digitalmojo does not dispute that its 2014 Interrogatories exceeded the 75 interrogatory limit agreed to by the parties in 2010 and set forth in 37 C.F.R. § 2.120(d)(1) and TBMP § 405.03(a). As justification for serving excess interrogatories, Digitalmojo contends that the 75 interrogatory limit agreed to by the parties only applied to the opposition proceeding and that there was no

¹ Motion to Compel, Exhibit C.

² Motion to Compel, Exhibit C.

³ Motion to Compel, Exhibit C.

agreement between the parties as to the number of interrogatories in the cancellation proceedings.

See Motion to Compel, p. 7.

Digitalmojo's contention, however, is in direct contradiction to TBMP § 405.03(c) which unequivocally states:

37 CFR § 2.120(d)(1) does not provide for extra interrogatories in cases where more than one mark is pleaded and/or attacked by the plaintiff (whether in a single proceeding, or in consolidated proceedings), because in such cases, the propounding party may simply request that each interrogatory be answered with respect to each involved mark of the responding party, and the interrogatories will be counted the same as if they pertained to only one mark. Similarly, the rule does not provide for extra interrogatories in cases where there is a counterclaim, because in a proceeding before the Board, the discovery information needed by a party for purposes of litigating the plaintiff's claim usually encompasses the information needed by that party for purposes of litigating a counterclaim. That is, the mere fact that a proceeding involves multiple marks (whether in a single proceeding, or in consolidated proceedings) and/or a counterclaim does not mean that a party is entitled to serve 75 interrogatories, counting subparts, for each mark, or for each proceeding that has been consolidated, or for both the main claim and the counterclaim.

(Underlining added). Thus, the mere fact that this case involves multiple consolidated proceedings did not automatically entitle Digitalmojo to more than 75 interrogatories. In fact, the 75 interrogatory limit seems intended for cases just like this one, where there is only one application being opposed, and two registrations being challenged, and any interrogatory from Digitalmojo against the latter could be asserted to with respect to both registrations as a single interrogatory, as pointed out in the regulation cited above.

Digitalmojo further asserts that it is entitled to serve the additional interrogatories because this proceeding involves "unusually numerous or complex issues" as set forth in TBMP § 405.03(c). Connect submits that Digitalmojo may have misread § 405.03(c). First, a party is not automatically entitled to serve excess interrogatories just because it believes that a proceeding involves "unusually numerous or complex issues." Instead, 37 C.F.R. § 2.120(d)(1) states that,

absent a stipulation, a party must file a motion with the Board demonstrating good cause for the additional discovery. TBMP § 405.03(c) clearly indicates that “unusually numerous or complex issues” in a proceeding “will be considered in determining a motion for leave to serve additional interrogatories.” Thus, absent a motion granted by the Board, Digitalmojo is not entitled to additional interrogatories, but Digitalmojo’s motion clearly cannot be granted given its untimeliness and given the defects and omissions noted above.

To the extent that Digitalmojo moves for leave to serve additional interrogatories, Connect submits that this request must be denied as both untimely and noncompliant with the TBMP. In regard to untimeliness, the discovery period for this proceeding closed on March 13, 2014. Digitalmojo should have and could have filed a motion requesting additional interrogatories well prior to the close of discovery. Connect submits at this late stage, additional discovery should not be granted as it would only serve to further delay this proceeding which as been pending since April of 2010, almost six years ago.

In regard to further procedural non-compliance by Digitalmojo, 37 C.F.R. § 2.120(d)(1) specifically requires that

[a] motion for leave to serve additional interrogatories must be filed and granted prior to the service of the proposed additional interrogatories and must be accompanied by a copy of the interrogatories, if any, which have already been served by the moving party, and by a copy of the interrogatories proposed to be served.

(Underlining added). Digitalmojo has clearly violated § 2.120(d)(1) because it has already served the additional interrogatories that it is requesting, namely, its 2014 Interrogatories, prior to the filing of the Motion to Compel. Digitalmojo further violated § 2.120(d)(1) because it did not provide a copy to the Board of all of the interrogatories which have previously been served with

its Motion to Compel as it failed to provide a copy of its Applicant's Interrogatories, Set Two, which had been served on February 24, 2011.

In short, Connect should not be compelled to respond to the 2014 Interrogatories because (I) Digitalmojo had already served the 75 interrogatory limit agreed to by the parties in this proceeding; (ii) the discovery period is closed; and (iii) Digitalmojo already served the additional interrogatories and failed to provide a copy of all of its previous interrogatories, all in direct violation of 37 C.F.R. § 2.120(d)(1).

B. Connect Cannot Be Compelled to Provide Responses to the 2014 RFA Because the Motion to Compel was not Brought Within a Reasonable Time as Required by TMBP § 523.03

Digitalmojo first filed its Motion to Compel on May 22, 2014, more than two months after the close of the discovery period on March 13, 2014. It is therefore, difficult to understand how the timing of Digitalmojo's Motion to Compel can be considered timely.

Further, Connect objected to Digitalmojo's 2014 RFA numbers 1 to 403 on the basis that they were "previously asked and answered." In this regard, Digitalmojo does not dispute that the disputed 403 requests served in 2014 are word-for-word identical to requests numbered 1-403 propounded in Digitalmojo's Requests for Admission, Set Two⁴ served on September 4, 2011. As a basis for re-serving the 403 requests for admission in 2014, counsel for Digitalmojo asserted in a letter⁵ dated May 3, 2014 that Digitalmojo was dissatisfied with Connect's previous responses to the same 403 requests, which were originally served by Connect on December 5, 2011.

⁴ Motion to Compel, Exhibit B.

⁵ Motion to Compel, Exhibit D

As a first point of contention, Connect respectfully asserts that Digitalmojo acted outside of Fed. R. Civ. P. 37 (“Rule 37) by re-serving the exact same 403 requests in 2014 as were served in 2011 instead of timely pursuing the relief allowed under this rule. In particular, Rule 37 requires a propounding party that is dissatisfied with discovery responses to request a meet and confer conference with the responding party. Fed. R. Civ. P. 37(a). If dissatisfied with the outcome of the meet and confer conference, the propounding party must then file a motion to compel to obtain relief. *Id.* Instead of following proper procedure (by proceeding under the auspices of Rule 37 to resolve the allegedly unsatisfactory responses to the 403 requests served in 2011), Digitalmojo inappropriately re-served the exact same 403 requests in 2014, over two and one-half years later.⁶ Importantly, Digitalmojo has cited no authority that would allow it to re-serve discovery requests where it is dissatisfied with the initial response to the same requests.

Secondly, Digitalmojo is precluded from seeking relief on this issue through its Motion to Compel because Digitalmojo did not act within a reasonable time after service of Connect’s original responses to the 403 requests in December of 2011. In particular, TMBP § 523.03 is clear that a propounding party must file a motion to compel “within a reasonable time . . . after service of the response believed to be inadequate and must, in any event, be filed before the first testimony period opens.” In the present case, it is undisputed that two and one-half years passed since Connect served its original responses to the 403 requests and Digitalmojo’s perviosuly filed Motion to Compel. In all of that time, Digitalmojo never sought a meet and confer conference to discuss the allegedly unsatisfactory responses. Only then, two and one half years later and after discovery has closed and then only after Connect filed a motion for summary

⁶ For this reason, Connect objected to the requests numbered 1-403 in the 2014 RFA as already having been asked and answered.

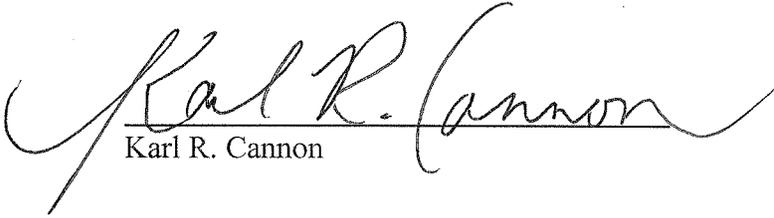
judgment, did Digitalmojo contend by letter that Connect's responses to the 403 requests served in December of 2011 were inadequate. Connect respectfully submits that re-serving the same 403 requests, and on the last day of the discovery period, two and one half years later, does not restart the clock for determining a "reasonable time."

For the reasons set forth above, the Board should deny the current Motion to Compel on this issue outright on the basis that (I) Digitalmojo acted improperly by re-serving the 403 requests in 2014 instead of seeking relief under Rule 37; and (ii) Digitalmojo's two and one-half year delay in bringing its previous Motion to Compel and then the current Motion to Compel is not "within a reasonable time" as required by TMBP § 523.03.

III. CONCLUSION

Connect respectfully submits that when all of the foregoing is considered, the Board will deny Digitalmojo's Motion to Compel. Further, because Digitalmojo's Motion to Compel to comply with the basic procedural rules of the Federal Rules of Civil Procedure and the TBMP, namely, that Digitalmojo should not be awarded additional interrogatories in excess of the 75 interrogatory limit set in 37 C.F.R. § 2.120(d)(1) and TBMP § 405.03(a) because the request is untimely and that connect cannot be compelled to provide responses to the 2014 RFA because the Motion to Compel was not brought within a reasonable time as required by TMBP § 523.03, Connect respectfully asks the Board to strongly consider granting Connect's Motion for Summary Judgment forthwith.

Respectfully submitted this 11 day of February, 2016.


Karl R. Cannon

CLAYTON, HOWARTH & CANNON, P.C.
Attorneys for Opposer
Connect Public Relations, Inc.

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CERTIFICATE OF SERVICE

I hereby certify that I caused a true and correct copy of the foregoing **MEMORANDUM**
IN OPPOSITION TO MOTION TO COMPEL to be served, via first class mail, postage
prepaid, on this 11 day of February, 2016 to:

Thomas W. Cook, Esq.
Thomas Cook Intellectual Property Attorneys
3030 Bridgeway, Suite 425-430
Sausalito, California 94965-2810

A handwritten signature in cursive script, reading "Karl R. Cannon", is written over a horizontal line.