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

Proceeding	91197754
Party	Plaintiff Wolf-Peter Graeser
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**THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of trademark application Serial No.: 76701998

For the mark: LAVATEC

Published in the Official Gazette on November 2, 2010

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Mr. Wolf-Peter Graeser, )  
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 the "Opposer", )  
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 v. ) Opposition No.: 91197754  
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 Lavatec, Inc. )  
 )  
 the "Applicant" )  
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**OPPOSER'S REPLY TO APPLICANT'S OBJECTIONS TO OPPOSER'S MOTION TO  
COMPEL AND FOR PROTECTIVE ORDER**

Opposer replies to Applicant Lavatec, Inc.'s Objection to Opposer's Motion To Compel and Request for Protective Order, stating the following:

1. Despite the allegations by Applicant that Opposer has employed techniques to avoid discovery and the revelation of documents, Opposer notifies the Board that since Opposer's Motion for a Protective Order has not yet been granted, Opposer has nonetheless duly complied with its obligation to respond to Applicant's First Set of Interrogatories, First Set of Requests for Admission, First Set of Document Requests and Second Set of Interrogatories by the due date of August 19, 2011.

2. On August 19, 2011, Opposer's counsel served Applicant's counsel with the responses to the discovery requests, consisting of well over 1,000 pages of documents dating back to 1987.

3. In order to provide Applicant with the requested discovery, Opposer was

required to open and review archives created by his predecessor in interest dating back to 1986, review all records, scan all documents and send them to Opposer's counsel. Opposer's counsel had to send an attorney from their German office to Opposer's place of business to assist Opposer in identifying the documents requested by Applicant (had Opposer's counsel not had an office in Germany, it would have taken substantially longer). Opposer's counsel then had to review all documents provided, most of which were in German, prior to responding to Applicant.

4. Opposer informed Applicant prior to Applicant's filing the Motion To Compel that Opposer was proceeding to provide discovery in accordance with the August 19, 2011, deadline, and restated the same position in Opposer's opposition to Applicant's Motion To Compel. Despite Opposer's counsel's clear confirmation that responses to Applicant's discovery requests were being duly addressed, Applicant's counsel went ahead and filed an unnecessary Motion to Compel. We believe this Motion to Compel to be a waste of the Board's time and resources.

5. Opposer has timely complied with its discovery obligations in good faith and has acted reasonably under the circumstances. Given that the material was located overseas, voluminous, drafted in German and stored in an unfamiliar archive, we believe that Opposer complied with its obligations in a short period of time (i.e., 60 days).

6. Applicant's Initial Disclosures fail to comply with F.R.Civ.P.26(a)(1). Opposer notified Applicant of the deficiency on two separate occasions explaining to Applicant's counsel that the reason for such deficiency was due to the failure of the Initial Disclosures to provide sufficiently detailed information as required by F.R.Civ.P.26(a)(1). Reference to F.R.Civ.P.26(a)(1) is a clear indication of what the deficiencies were.

7. Applicant's Objection to Opposer's motion admits that Applicant's Initial Disclosures fail to identify the location of the documents and things listed in Paragraph 2, that Applicant's disclosures list only broad categories of documents without any reference to Applicant's claim to the mark. Opposer should not be expected to second-guess what Applicant's counsel meant when drafting its shoddy Initial Disclosures.

8. Applicant's Objection to Opposer's motion states that Opposer did not object to Applicant's Initial Disclosures until Applicant denied a 30-day extension

request. It should be noted that Opposer has until the close of discovery to file a motion to compel Applicant to serve its Initial Disclosures.

9. Applicant further claims that Opposer delayed filing its motion as part of a scheme to avoid producing documents in discovery, which should cast a doubt upon the credibility of Opposer's motion. This allegation is simply false and malicious. Opposer informed Applicant that it was working on responding to its discovery requests and indeed served its response to Applicant's discovery requests by the agreed deadline of August 19, 2011.

10. Applicant claims that Opposer failed to confer regarding Opposer's objections to Applicant's Initial Disclosures. Opposer's counsel attempted to confer with Applicant's counsel regarding discovery issues, however, Applicant's counsel categorically slammed the door shut on any possibility of a discussion of the issues by filing a Motion To Compel without any attempt to resolve the pending issues. Applicant cannot in good faith claim that Opposer failed to confer, when Opposer made at least the same effort to confer with Applicant as Applicant did prior to filing its own Motion To Compel.

11. Opposer's request for a Protective Order is neither untimely nor unwarranted. The due date for Opposer's response to Applicant's discovery requests was August 19, 2011, and Opposer filed its request prior to such date. Notwithstanding the foregoing, during the period in question, Opposer's counsel had indicated their position that discovery issues could be resolved between the parties and could not imagine that a reasonable attorney would take the pending issues to the Board without any further attempts to resolve same. Opposer deemed that its deadline to respond to Applicant's discovery requests was August 19, 2011, therefore, it used the period prior to August 2, 2011, to continue preparing its responses to Applicant's discovery requests and to serve Applicant with its own discovery requests. Opposer fails to understand how Applicant can claim that Opposer's diligent prosecution of this Opposition can be objectionable and grounds for denial of Opposer's Motion To Compel.

### **RELIEF REQUESTED**

For the reasons contained herein, Opposer respectfully requests that the Board grant Opposer's Motion To Compel and For Protective Order and deny Applicant's Motion to Compel and Order for Admissions.

Dated: New York, New York

August 23, 2011

Respectfully submitted.

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## CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Reply to Applicant's Objection to Opposer's Motion to Compel Initial Disclosure and for Protective Order was served on Applicant at the correspondence address of record by email addressed to:

lind@ip-lawyers.com

On August 23, 2011

By: /s/ Kai Livramento