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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

Mr. Wolf-Peter Graeser,

)
)
) the "Opposer",
)
)

v.)

Lavatec, Inc.)

)
)
) the "Applicant"
)

Opposition No.: 91197754

OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO COMPEL

Opposer responds to Applicant Lavatec, Inc.'s Motion to Compel, stating the following:

1. The motion submitted by Applicant's counsel is nothing more than a continuation of Atty's Linderman's incessant campaign of personal attacks against Opposer's counsel and, therefore, a further waste of the Board's time and resources.

2. The motion submitted by Applicant's counsel is, to put it charitably, "incomplete". Indeed, the motion omits material facts, perversely manipulates Opposer's counsel's words and contains libelous statements regarding Opposer's counsel.

3. Opposer's counsel urges the Board to ignore Applicant's counsel's tiresome diatribe and to carefully consider the simple facts surrounding this dispute. We are confident that the Board will see this motion for what it is, yet another opportunity for Applicant's counsel to abuse the TTAB procedure in a questionable attempt to wear out Opposer and Opposer's counsel by misusing procedural rules and attempting to gain an unfair advantage, rather than just focusing on the merits of the case.

4. In his motion, Applicant's counsel seeks to cloud the Board's judgment from the outset by painting a picture that Opposer's entire case rests upon one single document, an [REDACTED]. This could not be further from the truth.

5. It should be noted that Opposer has raised six separate grounds in his Notice of Opposition: (i) deceptiveness, (ii) false suggestion of a connection, (iii) priority and likelihood of confusion, (iv) that the mark is deceptively misdescriptive, (v) dilution, and (vi) that Applicant is not the owner of the mark. Therefore, the issue of ownership is clearly not the lynch pin of Opposer's case and the document in question is actually of an ancillary nature.

6. Furthermore, Applicant's counsel also fails to notify the Board that Opposer is the legal and registered owner of the LAVATEC mark for the entire European Union, therefore, the issue of Opposer's ownership of the mark is not really open to dispute.

7. Moving back to the issue at hand, Opposer hereby notifies the Board that the [REDACTED] in question is of high commercial sensitivity and contains many trade secrets. If details contained in the [REDACTED] were to be disclosed, then Opposer's business interests could suffer significant damage, especially vis-à-vis its competitors. It is of paramount importance to Opposer that the confidentiality of this document be preserved. For this reason, Opposer has withheld its consent to the release of the document to any unnecessary person.

8. Bearing in mind the foregoing and the fact that Opposer was cognizant of the need to provide Applicant with a translation of the relevant sections of the [REDACTED] Opposer requested a certified translation of all sections of the [REDACTED]. Such translation was provided to Applicant in response to Applicant's first round of discovery requests.

9. Knowing Applicant's counsel pattern of conduct, Opposer diligently undertook to incur the high cost of obtaining a certified translation of all sections of the [REDACTED] from the German Honorary Consul in Denver, Colorado.

10. Opposer's counsel would like to take a moment to explain to the Board the nature of a certified translation. In Germany, for a translation to be accepted by any governmental body or admitted in any court proceeding, it must be translated or vetted by either a sworn court translator in Germany or a German consulate/embassy overseas. When vetting or performing a translation, sworn court translators and/or consular officers certify the accuracy of the translation and, therefore, its content. The purpose of such a system is two-fold: (i) to ensure that the competency of the person performing and certifying the translation to carry out such translation be verified by independent government officials, and (ii) to ensure that the person translating, vetting and certifying the content of such translation be independent and *supra partes*. Sworn court translators and consular officers are paid a fixed salary by the government and, therefore, have no financial interest in the work being performed. Furthermore, sworn court translators and consular officers have no duty to act in the interest of the person requesting the translation; au contraire, their only duty is to remain impartial as they act in their capacity as government officials. It should also be noted that consular officials have a duty to maintain the confidentiality of any information and/or documents provided to them.

11. By having the [REDACTED] translated by the German Honorary Consul in Denver, Colorado, Opposer ensured: (i) that Applicant was provided with an accurate and unbiased translation of the document in question by a translator whose impartiality is guaranteed by the nature of his/her office, and (ii) that the confidentiality of the document in question was preserved.

12. In the instant case, Opposer went above and beyond his duty to ensure that Applicant was provided with a fair, impartial and accurate translation of the [REDACTED]. As explained below, the credentials of the German Honorary Consul in Denver are impeccable and to maintain that a public German official would go as far as providing a biased translation to please Opposer, a complete stranger, borders of the edge of paranoia. As a Firm that routinely works with Consulates from several countries, including E.U. member states and the U.S., we can attest that consular officers have no interest whatsoever in jeopardizing their position by taking sides, or

even getting involved, in a litigation matter. Applicant's counsel, however, seems to be insinuating that the German Honorary Consul in Denver would be the exception to the rule.

13. Applicant's true grievance with the translation is not that the translation is biased and error strewn as stated in the motion, but rather that it does not say what Applicant's counsel would desperately like it to say.

14. Applicant's counsel claims that a second translation of the [REDACTED] [REDACTED] is necessary to point out the bias, deficiencies and errors in the partial translation provided by Opposer, yet Applicant's counsel fails to point out what such bias, deficiency and/or errors would be.

15. Applicant's counsel then launches into what can only be described as a false, twisting and turning tall tale of smoke and mirrors omitting the true facts of the matter and painting Opposer's counsel as being deliberately deceitful.

16. As explained above, Opposer went to the expense of having a certified translation of those sections of the [REDACTED] [REDACTED] prepared for Applicant.

17. Applicant then accused Opposer of withholding a more complete translation. Opposer had not had any other translations prepared, however, Opposer's counsel recalled that there had been [REDACTED] [REDACTED] and Opposer, before the opposing proceedings had been commenced, regarding the interpretation of the language reproduced in paragraph 10 of Applicant's motion. Opposer notified Applicant that such language does not relate to [REDACTED] nevertheless, Opposer immediately offered to have a certified translation of the language in question prepared. What Applicant blatantly fails to inform the Board is that Opposer had already delivered a certified translation of the language in question to Applicant's counsel prior to Applicant's counsel filing this motion. Therefore, paragraphs 10 and 11 of Applicant's motion are moot and serve no purpose other than to inaccurately place Opposer's counsel in a negative light.

18. Applicant then continues to accuse Opposer of translating only those

sections of the [REDACTED] that had allegedly been cherry picked by Opposer. What Applicant's counsel once again deliberately omits to inform the Board is that Opposer's counsel made two separate offers to allay Applicant's concerns that relevant sections of the document had not been translated. Per Applicant's Exhibit 4, Opposer's Counsel offered to have the German Honorary Consul certify that all sections relevant to intellectual property had in fact been translated, however, this was unacceptable to Applicant's counsel. Opposer's counsel then offered to allow Applicant's counsel have the remainder of the [REDACTED] translated by the German Honorary Consul (See Exhibit 1), who - as a public official - would have ensured the preservation of the document's confidentiality. This latter offer would have allowed Applicant to have a full translation of the document by a qualified independent translator.

19. Applicant's counsel did not even have the courtesy to respond to this communication and proceeded to file yet another retaliatory motion to compel without first making a good faith attempt to arrive at any negotiated arrangement for obtaining a full translation that would protect the rights of both parties. Applicant's argument that they are unable to obtain a complete translation of the [REDACTED] is, therefore, entirely without merit and a manipulation of the facts.

20. Applicant's attorney further claims an additional translation is needed to point out bias, yet he fails to explain how and on what grounds the German Honorary Consul, who represents the German government (not Opposer) and who stamped the translation on behalf of the Federal Republic of Germany, is biased.

21. Applicant's attorney claims that the translation contains errors and inaccuracies but fails to point out what such errors and inaccuracies are.

22. The German Honorary Consul is admitted to the Colorado Bar (Exhibit 2) and is also admitted to practice in Germany (Exhibit 3); his knowledge of both U.S. and German legalese is, therefore, unquestionable and we fail to see how Applicant's attorney, who is not a German attorney and thus far less qualified, can claim his translation to be inaccurate.

23. Applicant's attorney claims to speak German (Exhibit 4) and it appears

that either he or someone in his office has a high level of German since they are able to spot the unspecified errors. This means that there is nothing to prevent them from translating the document themselves without violating the Board's Protective Order.

24. Applicant's attorney claims that the translation is incomplete, yet has been given the opportunity to obtain a full translation and declined.

25. Applicant's attorney falsely accuses Opposer's counsel of being deceitful and deceptively misleading. We invite the Board to read Exhibits 2, 4 and 5 to Applicant's motion. All of these documents confirm that the translation in question was certified as to the accuracy of its contents by the German Honorary Consul. Exhibit 5 to Applicant's motion goes further and describes the specific process by which the certified translation was obtained. A draft translation is provided to the German Honorary Consul who then has an obligation to carefully review and edit such translation until he is satisfied that it is accurate, at which point he will certify the translation in his official capacity as Honorary Consul and a public official. Please note that, as Opposer's counsel has been trying to explain to Applicant's counsel, the German Honorary Counsel is certifying that each word of the translation in question is correct, not merely rubber stamping a document handed to him by Opposer's counsel. Applicant's counsel's allegations to the contrary are simply scandalous and are akin to accusing a court clerk of acting on behalf of a litigant for presenting a document for filing.

26. Nowhere in Exhibits 2-5 to Applicant's motion are there any inconsistent, deceitful or misleading statements made by Opposer's counsel and we respectfully request that Applicant's counsel be sanctioned for bringing such a frivolous and unprofessional personal attack.

27. Applicant's counsel claims that they did not select the translator. As explained above, Opposer did not select the translator either, the government of the Federal Republic of Germany did. The precise reason that a certified translation was requested was to ensure confidentiality, integrity and independence of the translation, which appears to be something Applicant's counsel bizarrely finds to be unacceptable.

28. Applicant's counsel appears to allege that the German Honorary Consul for Denver may not have certified the translation and/or may not have been acting in his

official capacity. Applicant's counsel offers no proof for this allegation other than a statement that the consul did not reply to his somewhat odd communications. Although Opposer's counsel cannot respond for the official in question, we are not surprised that such a communication went ignored, since it was obviously inappropriate.

29. Since the translation provided to Applicant's counsel was signed and stamped by the Consul on behalf of the Federal Republic of Germany, we fail to see how Applicant's counsel can question by whom it was certified and in what capacity. The certification from the translation is attached hereto as Exhibit 5.

30. On the basis of the foregoing, Applicant has not provided any credible explanation for the need for disclosure. Applicant's counsel has a translation certified by a qualified and independent public official with impeccable credentials difficult to be found in the U.S., and has been invited to have the remainder of the [REDACTED] translated by the same official.

31. Applicant's counsel rejected and/or ignored Opposer's counsel's attempts to resolve this matter before unnecessarily bringing the issue before the Board.

32. Applicant's counsel falsely accuses Opposer's counsel of being deceitful and misleading without providing a scrap of proof. Indeed, the evidence that he proffers, clearly contradicts his allegations.

33. Furthermore, by submitting the current motion to the Board, Applicant's counsel has submitted a pleading which reproduces, paraphrases and/or discusses protected information without filing the document under Seal. This is a flagrant violation of Paragraph 12 of the Standard Protective Order. Applicant's counsel should be sanctioned pursuant to 37 C.F.R. 2.120(g)(1).

RELIEF REQUESTED

For the reasons contained herein, Opposer respectfully requests that the Board deny Applicant's Motion to Compel in its entirety and that Applicant's counsel be sanctioned for filing an unnecessary and unwarranted Motion to Compel and violating the Board's Standard Protective Order.

Dated: New York, New York

November 22, 2011

Respectfully submitted.

/s/ Andrea Fiocchi
Andrea Fiocchi, Esq.
Sarah E. Tallent, Esq.
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(212) 710-0970

Attorneys for Opposer,
Wolf-Peter Graeser

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Opposition to Motion to Compel was served on Applicant at the correspondence address of record by email addressed to:

lind@ip-lawyers.com

On November 22, 2011

By: /s/ Sarah E. Tallent

Exhibit 1

Sarah E. Tallent

From: Sarah E. Tallent [stallent@reinhardt-law.com]
Sent: Friday, October 28, 2011 5:02 PM
To: 'John Linderman'
Cc: 'Andrea Fiocchi'; 'Kai N. Livramento'
Subject: RE: Graeser v. Lavatec, Inc.

Mr. Linderman:

As regards the [REDACTED], our client's position has been clearly stated in our previous communications and has not changed. The [REDACTED] was certified by Bernhardt Jurgen Bleise, Honorary Consul of the Federal Republic of Germany. Mr. Bleise is an attorney admitted to practice in both Germany and Colorado and he certified the accuracy of the content of the [REDACTED] as compared to the [REDACTED]

Mr. Bleise's credentials make him one of the most qualified individuals in either the U.S. or Germany when it comes to [REDACTED] from German into English. Additionally, Mr. Bleise is an independent public official representing the Federal Republic of Germany, rather than a party to the action. You have no grounds to challenge his impartiality or ability to perform the translation.

Having said that, in an attempt to accommodate your incessant requests, our client is willing to allow you to have the remainder of the document translated by Mr. Bleise, at your client's sole cost and expense, it being understood that the [REDACTED]

We remind you that we are yet to receive your response to our communication dated October 14, 2011 (below). We expect to receive your response early next week.

Very truly yours,

Sarah E. Tallent
Attorney at Law

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Exhibit 2

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Exhibit 4

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John C. Linderman Partner

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Education

- BS, Massachusetts Institute of Technology
- JD, University of Connecticut School of Law

Associations

- American Bar Association
- American Intellectual Property Law Association
- MIT Enterprise Forum of Connecticut
- Connecticut Bar Association
- Connecticut Intellectual Property Law Association
- Hartford County Bar Association



PAST OFFICES

- Chairman, Intellectual Property Section of the Connecticut Bar Association
- President, Connecticut Intellectual Property Law Association
- Chairman, MIT Enterprise Forum of Connecticut
- Has served as a Trustee of the Stanley Museum

John C. Linderman maintains a broad intellectual practice and regularly litigates patent, trademark and copyright matters in the state and federal courts. He also prosecutes applications for patents, trademarks and copyrights, and handles contracts and licensing pertaining to technology transfer and the sale or exchange of intellectual property.

He has a speaking and reading knowledge of German.

In addition, Mr. Linderman has written several papers on patent infringement and validity, and conducted a Continuing Legal Education Seminar on trademarks for the general practitioner. He also serves as a guest lecturer on intellectual property topics at The University of Connecticut School of Law and Trinity College.

AUTHOR

How to Fashion a Protective Order in Patent Litigation
The Licensing Journal, Vol. 11, No. 5

The Ascending Role of Secondary Considerations
Third Annual Joint Seminar Program of Patent Law Associations

Staking your Claims - A Patent May Cover More Than It Says
Mechanical Engineering, Vol. 125, No. 1 January 2003

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