UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

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Mailed: June 17, 2013

Opposition No. 91198552

Raising Cane's USA, L.L.C.

v.

Fifty-Six Hope Road Music Limited

Cancellation No. 92053461

Fifty-Six Hope Road Music Limited

v.

Raising Cane's USA, L.L.C.

Elizabeth A. Dunn, Attorney (571-272-4267):

This case comes up on the combined motion of Fifty-Six Hope Road Music Limited, defendant in the opposition and plaintiff in the cancellation, to compel supplemental responses to interrogatories and document requests, and to determine the sufficiency of responses to requests for admissions. The motion is contested. For clarity in this order, movant will be referred to as Fifty-Six, or defendant, and non-movant will be referred to as RCU, or plaintiff. Pursuant to Trademark Rule 2.120(e), Fifty-Six provided copies of the disputed requests and responses, and

support for its statement that it attempted to resolve this matter with RCU before the motion was filed.

In Opposition No. 9198552, RCU claims dilution of, and likelihood of confusion with, its registered mark ONE LOVE for restaurant services by Fifty-Six' mark ONE LOVE for music services in Int. Cl. 41. In Cancellation No. 92053461, Fifty-Six seeks to cancel RCU's registration on the grounds of dilution, and priority and likelihood of confusion, pleading two registrations for BOB MARLEY and BOB MARLEY AND THE WAILERS marks, three pending applications for ONE LOVE in standard characters, and rights to Bob Marley, and his song and album titles including ONE LOVE. Pursuant to the Board's July 6, 2012 order, on August 16, 2012, Fifty-Six filed an amended pleading which added a claim of false association. The Board accepts the amended petition to cancel as the operative pleading. Answers have been filed in both proceedings, which now are consolidated.

On August 1, 2011, Fifty-Six served RCU with its first interrogatories, document requests, and requests for admission. On August 19, 2011, RCU filed a motion for summary judgment which resulted in suspension of this proceeding, including RCU's obligation to respond to discovery. On July 6, 2012 the Board denied the motion for summary judgment and resumed proceedings. On August 16, 2012, RCU served its discovery responses.

On September 7, 2012, Fifty-Six served respondent with a letter detailing perceived deficiencies in the responses. On September 13, 2012, RCU responded by letter and phone call, and on September 24, 2012, RCU supplemented its responses. On October 4, RCU responded to the second set of request for admissions. On October 10, 2012, Fifty-Six sent another deficiencies letter. On October 18, 2012, RCU confirmed that it would not further supplement its responses. On October 26, 2012, the Board granted the parties' stipulation to extend discovery to close January 26, 2013. On November 29, 2012, Fifty-Six filed the combined motion to compel and to determine the sufficiency of responses.

MOTION TO TEST SUFFICIENCY OF RESPONSES TO REQUESTS FOR ADMISSION IS DENIED

Pursuant to Fed. R. Civ. P. 36(a)(6), "The requesting party may move to determine the sufficiency of an answer or objection." Fifty-Six seeks supplemental responses to (i) request for admissions Nos. 67-73 regarding Bob Marley's authorship and release of particular songs and albums, and (ii) request for admissions Nos. 73-83 regarding the ownership of trademark registrations by Fifty-Six and its affiliates.[1]

[1] Fifty-Six's initial motion to compel also sought a determination that RCU's responses to request for admission Nos. 1, 5, 6, 11-20, 41-42, and 141-142 were insufficient. In its reply brief, Fifty-Six withdrew its motion to compel with respect to those requests.

In response to the (i) requests, RCU objected on the basis of relevance, and in response to the (ii) requests, RCU stated "Applicant has insufficient information to admit or deny the allegation."

The Board finds both responses sufficient. More specifically, whether Bob Marley wrote songs other than ONE LOVE is not relevant to the claims of likelihood of confusion and false association between Fifty-Six' Bob Marley marks and applicant's ONE LOVE mark. Fifty-Six overreaches with its argument that RCU must acknowledge Fifty-Six' ownership of Fifty-Six' registrations.

MOTION TO COMPEL SUPPLEMENTAL INTERROGATORY RESPONSES IS DENIED IN PART AND GRANTED IN PART

Pursuant to Fed. R. Civ. P. 33(b)(2), "The responding party must serve its answers and any objections within 30 days after being served with the interrogatories." Fifty-Six seeks supplemental responses to interrogatory Nos. 1, 3-5, 9, and 11.

With interrogatory No. 9, Fifty-Six seeks RCU's explanation of its knowledge of marks unrelated to RCU's ONE LOVE mark or Fifty-Six' marks ONE LOVE, BOB MARLEY, and BOB MARLEY AND THE WAILERS. RCU objects to the breadth and relevance of the interrogatory and limits its response to its knowledge of BOB MARLEY and his ONE LOVE song, stating that RCU was unaware of the claim of trademark rights in the song

title. The objection is upheld, and RCU's response is sufficient.

The Board comes to a different result with interrogatory Nos. 1, 3-5, and 11, which seek information regarding the description (No. 1), channels of trade (No. 3), demographic market (No. 4), location of the mark (No. 5), and advertising (No. 11) for the goods and services with which RCU uses its ONE LOVE mark. RCU objects to the breadth and relevance of the interrogatory, contending that only information regarding use of the ONE LOVE mark with restaurant services must be produced. The objection is overruled. How applicant uses its ONE LOVE mark is integral to the pleaded issues in this proceeding.

MOTION TO COMPEL SUPPLEMENTAL DOCUMENT PRODUCTION IS GRANTED

Pursuant to Fed. R. Civ. P. 34(b)(2)(B) "For each item or category [subject to a request for production], the response must either state that inspection and related activities will be permitted as requested or state an objection to the request, including the reasons." Fifty-Six seeks supplemental responses to document request Nos. 1, 3, 6, 11-16, 19-20, 27-29, 40-42, 45, and 58.[2]

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[2] The Board agrees with RCU that request for documents Nos. 19 and 63 are duplicative, so the motion to compel with respect to No. 63 will be given no further consideration. With its reply brief Fifty-Six noted receipt of supplemental responses from RCU

Fifty-Six seeks documents and things related to each good and service offered or bearing RCU's ONE LOVE mark (No. 1), and also for the date of first sale (No. 3), photographs (No. 6), samples of periodicals promoting RCU's ONE LOVE mark (No. 11), actual and intended distribution channels (No. 12), retail outlets (No. 13), contact information for retail outlets (No. 14), type of purchasers (No. 15), prospective consumers (No. 16), actual and intended artwork and stylizations used on RCU's ONE LOVE goods and services (No. 19), photographs of interior and exterior spaces where ONE LOVE goods and services are offered or provided (No. 20), marketing and promotion of RCU's ONE LOVE goods and services (No. 27), method of marketing (No. 28), samples of marketing (No. 29), business plans (No. 40), franchise contracts (No. 41), contests and coupons (No. 42), communications to Fifty-Six (No. 45), and website traffic for the mark and services (No. 58). RCU responded by objecting to the relevance of the request "to the extent it seeks discovery beyond the services listed in [RCU's] Registration", but stating that it would produce documents to the extent that they exist.

With respect to the present motion, RCU simultaneously argues that the no order compelling production should issue because "the information sought concerns marks, goods and services not at issue in this case", and because RCU has

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and withdrew the motion to compel with respect to document

already provided all responsive information. RCU contends that the multiple discovery disputes set forth in Fifty-Six combined motion essentially address whether RCU has control over certain documents and third parties; whether Bob Marley's song titles and albums other than the ONE LOVE song are relevant; and whether RCU's use of ONE LOVE on collateral goods is relevant. The Board does not disagree with this summary but disagrees with RCU's conclusion that its use of ONE LOVE on anything but restaurant services is not relevant to this proceeding. To the contrary, how RCU uses its mark is central to several of the factors considered to determine the issue of likelihood of confusion. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973).[3]

It is not clear on this record that RCU has produced all responsive documents and things regarding all uses of its ONE LOVE mark. The Board agrees with Fifty-Six that this information is relevant and that Fifty-Six is entitled to unequivocal responses which indicate whether all responsive information has been produced. The motion to compel is

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request Nos. 59 and 60.

[3] How RCU uses its mark may affect the following Dupont factors: the similarity or dissimilarity of established, likely-to-continue trade channels; the conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing; the fame of the prior mark (sales, advertising, length of use); the number and nature of similar marks in use on similar goods; the variety of goods on which a mark is or is not used (house mark, "family" mark, product mark); and the market interface between applicant and the owner of a prior mark.

granted with respect to document request Nos. 1, 3, 6, 11-16, 19-20, 27-29, 40-42, 45, and 58.

SUMMARY

Fifty-Six' combined motion is DENIED with respect to the requests for admission; DENIED as to interrogatory No. 9; GRANTED as to interrogatory Nos. 1, 3-5, and 11; and GRANTED as to document request No. 1, 3, 6, 11-16, 19-20, 27-29, 40-42, 45, and 58.

RCU is allowed until THIRTY DAYS from the mailing date of this order to produce the responses and documents compelled by this order, failing which the Board will entertain a motion for sanctions. RCU is barred from filing a motion for summary judgment or a motion to compel before it has complied with this order.

Proceedings herein are resumed, and dates are reset

Discovery Closes	**8/20/2013**
Plaintiff's Pretrial Disclosures Due	**10/4/2013**
Plaintiff's 30-day Trial Period Ends	**11/18/2013**
Defendant's Pretrial Disclosures Due	**12/3/2013**
Defendant's 30-day Trial Period Ends	**1/17/2014**
Plaintiff's Rebuttal Disclosures Due	**2/1/2014**
Plaintiff's 15-day Rebuttal Period Ends	**3/3/2014**

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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