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

Proceeding	91199529
Party	Plaintiff Hunter Boot Limited
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Attachments	OPPOSER'S REPLY IN SUPPORT OF MOTION TO COMPEL.pdf (6 pages)(267109 bytes)

Attorney Docket No. 76027-797607

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

In re Application No. 76/702,199
Filed: March 23, 2010
Published: December 21, 2010 in the Official Gazette
For: **GIRL HUNTER**

HUNTER BOOT LIMITED, Opposer, vs. GEORGIA PELLEGRINI MEDIA GROUP, LLC, Applicant.	Opposition No. 91199529

REPLY IN SUPPORT OF OPPOSER'S MOTION FOR AN ORDER TO COMPEL RESPONSES TO ITS INTERROGATORIES AND REQUESTS FOR PRODUCTION, TO COMPEL PRODUCTION OF DOCUMENTS, AND REQUEST FOR AN EXPEDITED TELEPHONIC HEARING

Opposer Hunter Boot Limited ("Opposer") hereby replies to the Opposition filed by Applicant Georgia Pellegrini Media Group, LLC ("Applicant") to Opposer's motion for an order compelling Applicant to comply with its discovery obligations. Opposer finds it necessary to submit this reply so that it may respond to new issues and serious mischaracterizations of fact raised in the Opposition.

I. THE BOARD SHOULD DECLINE TO CONSIDER APPLICANT'S OPPOSITION PAPERS AND DEEM OPPOSER'S MOTION CONCEDED

Applicant's submission in opposition to Opposer's Motion to Compel fails to meet the requirements of Trademark Rule 2.119 and should not be considered. Pursuant to Trademark Rule 2.119 and TBMP § 113.02, the Board usually will decline to consider papers that do not

include a proper certificate of service. Trademark Rule 2.119 requires that each document filed with the Board include a certificate of service indicating the date and manner of service, as well as the address to which the papers were served. 37 CFR 2.119; TBMP § 113.03. The TBMP even offers an example of a compliant Certificate of Service for participants in TTAB proceedings to use in their papers. *See* TBMP § 113.03 note 1. Yet, Applicant's "Certificate of Service" merely states that Applicant's counsel "caused the foregoing and accompanying exhibits[1] to be today served upon Attorney of Record for Opposer." (Opp. at 3). The Certificate of Service does not specifically indicate the date on which service was made, the address to which service was effectuated or the manner in which service was accomplished. Applicant's proof of service fails to meet the Trademark Rules, and the Board should therefore decline to consider Applicant's opposition papers. *See ShutEmDown Sports Inc. v. Lacy*, 102 U.S.P.Q.2d 1038, n. 4 & 5 (TTAB 2012) (noting that respondent was advised that "that strict compliance with the Trademark Rules and the Federal Rules of Civil Procedure is expected by all parties ... and specifically . . . that compliance with Rules 2.119 and Rules 2.125-2.128 [is] required. . . . [and that] the Board might decline to consider any paper that did not clearly indicate proof of service required by Rule 2.119.")

Moreover, consistent with Applicant's failure to indicate the date or manner of service of its papers, as of the date of writing (May 11, 2012), nine days after the alleged service, Opposer has yet to receive a service copy of the opposition papers, and learned of the filing of the opposition only by checking the Board's online records. *See* Declaration of Tali L. Alban in Support of Applicant's Reply, at ¶ 2. Opposer therefore has reasonable doubts about whether it was ever served at all. If failure *properly* to comply with Rule 2.119 is sufficient for the Board to refuse to consider moving papers, certainly a complete failure to effectuate service is also

[1] Opposer is not aware of any exhibits accompanying Applicant's Opposition.

grounds for declining to consider the papers and deeming the motion to compel admitted. *See ShutEmDown Sports, Inc.* 102 U.S.P.Q.2d at 1038 n. 5.

Unlike the respondent in *ShutEmDown Sports*, who – though *pro* se – was chastised and penalized by the Board for failing to comply with Rule 2.119, Applicant here is represented by counsel. There is no reason why, therefore, Applicant should be permitted to flout the Board's rules in this manner. The Board should thus refuse to consider Applicant's Opposition, deem Opposer's Motion to Compel as conceded and require Applicant to supplement its discovery responses, as specified in Opposer's Motion. *See* 37 C.F.R. § 2.127(a) ("When a party fails to file a brief in response to a motion, the Board may treat the motion as conceded.")

II. THERE IS NO HARASSMENT IN REQUIRING APPLICANT TO COMPLY WITH ITS DISCOVERY OBLIGATIONS

Applicant offers no real defense to the Motion to Compel. By unfairly attacking and mischaracterizing Opposer's actions, Applicant's brief is clearly designed to divert the Board's attention from the merits of this Motion, which Applicant simply-- and notably-- does not address. In fact, the gist of the opposition appears to be that Opposer is requiring that Applicant comply with its discovery obligations because it is "intent on harassing applicant concerning further production." (Opp. at 2.) If requiring a litigant to meet its discovery obligations were considered "harassment," all litigants (and judicial bodies) would be guilty.

First, as detailed in Opposer's moving papers, Opposer properly propounded its reasonable discovery requests, gave Applicant multiple extensions and an opportunity to cure the deficiencies in its responses, and generally sought to resolve this discovery dispute and obviate the need for a Motion to Compel. These efforts were frustrated by Applicant, who promised to

cure the deficiencies[2] and yet persisted in its failure to provide adequate responses (or even respond at all), and to provide only a few responsive documents.[3]

Second, not only has Applicant provided insufficient responses to Opposer's discovery requests, Applicant has failed *completely* to respond to Opposer's requests for documents. Thus, Applicant's statements in its Opposition that "Applicant is unable to . . . produce documents that do not exist..." (Opp. at 2.), are not well taken, since Opposer has never been informed that no additional documents exist. Applicant should be compelled to provide complete responses to Opposer's document requests, and if no additional documents exist beyond what has already been produced, Applicant needs to so say in its responses.

Finally, in its motion papers, Opposer provided a list of interrogatories to which Applicant's responses were legally and factually insufficient. Applicant failed to respond to entire categories of requests for information – categories such as date of first use, and channels of trade and distribution – all of which are relevant and discoverable. Applicant has completely failed to show otherwise.

Applicant may not simply pick and choose the discovery obligations with which it wishes to comply. Opposer sympathizes with Applicant that responding to discovery can be burdensome, but these are the natural consequences of adopting and attempting to federally register an infringing mark and refusing to engage in reasonable settlement negotiations at the outset, before any proceedings were filed.

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[2] As shown in Opposer's opening brief, this promise was apparently intended to gain Applicant time to propound its own discovery before Opposer filed a Motion to Compel.

[3] Applicant's statement that it has produced "hundreds of pages" of documents is a gross exaggeration. In total, Applicant has **produced less than a hundred pages,** most of which are various items of press, many of marginal or questionable relevance to the issues in this proceeding. It has at no time indicated that this was the totality of the responsive documents.

III. RENEWED REQUEST FOR EXPEDITED HEARING

Due to the impending close of discovery and the approach of the trial period, Opposer renews its request for an expedited hearing concerning this matter so that it may obtain its needed and overdue discovery in time for preparing any necessary follow-up discovery and notice depositions as needed.

IV. CONCLUSION

For the foregoing reasons, Opposer respectfully requests that the Board decline to consider Applicant's moving papers and deem Opposer's Motion to Compel conceded, and/or grant its Motion to Compel in full and order that Applicant promptly provide full and complete responses to the outstanding discovery. To the extent a hearing is required, Opposer further requests an expedited hearing through telephone conference to resolve the Motion, pursuant to TBMP § 413.

Respectfully submitted,

KILPATRICK TOWNSEND AND STOCKTON LLP

Dated: May 11, 2012

By: _____

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CERTIFICATE OF SERVICE

On May 11, 2012, I served the foregoing **REPLY IN SUPPORT OF OPPOSER'S MOTION FOR AN ORDER TO COMPEL RESPONSES TO ITS INTERROGATORIES AND REQUESTS FOR PRODUCTION, TO COMPEL PRODUCTION OF DOCUMENTS, AND REQUEST FOR AN EXPEDITED TELEPHONIC HEARING** on the party in said action by depositing a true copy thereof with the United States Postal Service as first class mail, postage prepaid, at San Francisco, California, enclosed in a sealed envelope addressed as follows:

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Audrey Schlette