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

Proceeding	91200327
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 77/886,135

James Murta, Opposer, v. Victor Suarez, Applicant.	Opposition No. 91/200,327 Interlocutory Attorney: Elizabeth J. Winter APPLICANT’S RESPONSE TO PETITIONER’S MOTION TO COMPEL DISCOVERY RESPONSES
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Applicant Victor Suarez, by his attorneys, hereby responds to Petitioner’s Motion to Compel Discovery Responses.

I. INTRODUCTION

On October 7, 2013, Opposer filed the above-referenced Motion to Compel Discovery Responses and served a copy of same on Applicant. Opposer’s brief in support of his motion consisted of thirty-six numbered paragraphs that recite several misleading facts and arguments that are unsupported by any case law. Due to the nature of Opposer’s motion, it is somewhat difficult to ascertain the grounds upon which Opposer claims the legal right to request the information he seeks and Opposer’s motion fails to provide any legal basis for the discovery requests he wishes to obtain. For the foregoing reasons, Applicant respectfully submits that Opposer’s requests for certain discovery requests cannot be supported by relevant law and that Applicant’s previous objections to Opposer’s discovery requests were properly made in good faith and based on a correct interpretation of relevant case law. As such, Applicant respectfully requests that Opposer’s motion be denied in its entirety.

II. ARGUMENTS

A. Opposer's Motion to Compel Applicant's Discovery Requests and to Test the Sufficiency of Applicant's Previous Discovery Responses Is Untimely.

Board practice directs that a motion to compel discovery responses should be filed in a timely manner. Specifically, TBMB Section 523.03 states that a “motion should be filed within a reasonable time after the failure to respond to a request for discovery or after service of the response believed to be inadequate.” It follows that where a party that serves a request for discovery receives a response thereto which it believes to be inadequate, but fails to file a motion to challenge the sufficiency of the response, it may not thereafter be heard to complain about the sufficiency thereof. *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715 (TTAB 2008) (party that receives response it believes inadequate but fails to file a motion to test sufficiency of response, may not thereafter complain about its insufficiency); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650 (TTAB 2002) (having failed to file motion to compel, defendant will not later be heard to complain that interrogatory responses were inadequate); *Linville v. Rivard*, 41 USPQ2d 1731 (TTAB 1996) (objections that discovery requests are, for example, ambiguous or burdensome, are not of a nature which would lead propounding party to believe that the requested information does not exist, and party should have filed motion to compel), *aff'd*, 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998).

Paragraphs 6-7, 14-15, 17, 20-21, and 26 of Opposer's Motion¹ all relate to certain information and documents such as receipts, invoices, or other evidence provided by Applicant to Opposer that demonstrate Applicant's use of his DERBY of SAN FRANCISCO (“DOSF”) Mark and sales of products bearing his mark. Paragraphs 6-9 in particular relate to Applicant's

¹ Opposer does not attempt to organize the assertions in his motion either by topic or legal theory. Rather, Opposer's motion is merely a recitation of statements surrounding Opposer's contentions that he is entitled to various pieces of discovery, although Opposer does not appear to connect any case law to support his discovery requests. For space and simplicity's sake, Applicant will attempt to respond to these points on a topical basis.

discovery responses provided in January 2012, almost *two years* prior to this filing of Opposer's motion to compel, yet this is the first time Opposer has taken any formal steps to test the sufficiency of Applicant's responses.

Contrary to Opposer's assertions, Applicant has never withheld documents or information in his possession related to sales of his products under the DOSF Mark. Instead, the point with which Opposer takes issue is that some of these documents have been redacted to conceal private customer data or confidential trade secret and/or sensitive commercial information. What Opposer also fails to acknowledge is that Applicant first provided these sales- and use-related information and documents *before* being requested to do so pursuant to discovery requests made by Opposer. Instead, Applicant's original provision of this information came about during the course of settlement discussions and was formally provided to Opposer in response to his first set of discovery requests nearly two years ago. Given the lapse of time since Opposer first received this information, and the fact that Opposer failed to file a motion to compel testing the sufficiency of Applicant's responses, Opposer's right to challenge the sufficiency of Applicant's responses to his discovery requests is now untimely.

Applicant directs the Board's attention to its September 4, 2011, Order following the parties' August 30, 2011, discovery conference with Interlocutory Attorney Elizabeth Winters in which Applicant and Opposer agreed to a sixty-day suspension of this opposition in order to exchange information Applicant currently had in his possession reflecting his use of the DOSF Mark. Applicant agreed to this informal exchange of evidence with Opposer *as a courtesy*, with the hope of saving both sides the continued expense of opposition proceedings by impressing upon Opposer the fact that Applicant had, in fact, demonstrated bona fide use of his DOSF Mark and a lack of fraud with respect to use of his brand. The information Applicant provided to

Opposer through these informal settlement discussions was substantially identical to the information and documents Applicant later provided to Opposer in response to Opposer's first set of discovery requests made in December 2011. Some of the documents Applicant provided to Opposer were redacted to conceal the names and addresses of individual customers and current suppliers of Applicant's products.²

Upon receipt of this information, rather than engage in a good faith discussion of the merits, or evaluating the strength of this evidence with respect to Applicant's use of his DOSF Mark, Opposer instead immediately demanded unredacted documents to show the identity of these previously undisclosed parties, despite the fact that Opposer had no legal right to do so. Applicant reminded Opposer that these documents were being provided as a courtesy to establish that Opposer's fraud claims were meritless and that the burden remained with Opposer to prove fraud by Applicant "to the hilt." In addition, Applicant explained that the information being provided represented confidential customer and commercial data, that the information was being provided for settlement purposes only, and that Applicant was providing these documents for their persuasive value only and not in response to any particular discovery request. As such, Opposer was free to consider the documents and their persuasive value, or not; however, Opposer never had any right to request unredacted documents within the context of settlement discussions. Applicant's good faith attempts at settlement notwithstanding, Opposer rebuked Applicant's explanation and attempts at dialogue, and again demanded unredacted copies of Applicant's confidential documents, despite having no legal basis to make such a demand. Applicant again responded to Opposer's demands, in which Applicant maintained his position

² Applicant is not currently providing copies of the exchange of correspondence between Applicant and Opposer, as such correspondence was confidential and made in accordance with settlement discussions pursuant to Fed. R. Civ. P. Rule 408. Applicant's reference to this exchange of correspondence is for illustration and background only. However, upon request by the Board, Applicant will make such correspondence available provided such correspondence is filed with the Board under seal.

that the evidence of his use of his DOSF Mark obviated any question as to whether he had the requisite reasonable belief that he had used his mark in commerce, and that the burden of proving fraud in this opposition remained with Opposer.

Upon being served with Opposer's first set of interrogatories and requests for production of documents in December 2011, Applicant included copies of the same documents provided during the parties' settlement discussions, including the redacted copies of Applicant's customer and commercial supplier data. Upon receipt of Applicant's redacted documents, Opposer never lodged any formal objection to the redacted documents, nor did he make any further demands for unredacted copies. Instead, nearly two years later, Applicant is only now learning that Opposer formally objects to the redaction of these documents. Since Opposer failed to raise any objections to Applicant's redacted confidential customer and commercial data until nearly two years later, Opposer is deemed to have accepted Applicant's response to his discovery requests in the form presented and his motion to test the sufficiency of these responses is untimely.

B. Opposer's Discovery Requests Seek Documents and Information That Are Not Relevant to the Claims at Issue and Are Not Reasonably Calculated to Lead to the Discovery of Admissible Evidence.

Federal Rule 26(b)(1) states that "[p]arties may obtain discovery regarding any nonprivileged matter that is relevant to any party's claim or defense" Fed. R. Civ. P. 26(b)(1). However, each party has a duty to make a good faith effort to seek only such discovery as is proper and relevant to the specific issues involved in the proceeding. Fed. R. Civ. P. 26(g). *See Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303 (TTAB 1987) ("each party and its attorney has a duty not only to make a good faith effort to satisfy the discovery needs of its opponent but also to make a good faith effort to seek only such discovery as is proper and relevant to the specific issues involved in the case."). Moreover, the right to discovery is not unlimited. Even if

relevant, discovery is not permitted where no need is shown, or if compliance would be unduly burdensome, or where harm to the person from whom discovery is sought outweighs the need of the person seeking the discovery. Fed. R. Civ. P. 26(b)(1); *Micro Motion, Inc. v. Kane Steel Co., Inc.*, 894 F.2d 1318 (Fed. Cir. 1990).

The claims at issue in this proceeding are very specific. They include a) fraud for non-use and geographically deceptively misdescriptiveness, and b) non-use. Despite the specificity of these claims, however, the majority of Opposer's interrogatories and requests for production of documents either a) do not relate to any of Opposer's claims at issue, or b) are overly vague and seek information and/or documents which Opposer is not entitled to receive.

Moreover, most of Opposer's discovery requests to which Applicant has objected are objectionable *on their face*. Under such circumstances, Opposer bears the burden of demonstrating the relevancy of these requests. To date, Opposer has failed to make any connection between his discovery requests and any cognizable legal theory, despite Applicant's repeated objections and requests for such legal support. Therefore, unless and until Opposer can demonstrate a valid legal basis for making such various discovery requests, Applicant was within his rights to object to the presentation of these improper requests.

- 1. Confidential information regarding the identity of Applicant's product manufacturer(s) is not relevant to Opposer's claim of fraud for non-use because it is not necessary to establish applicant's basis for his good faith belief that he had used his DOSF Mark in commerce at the time of filing his application.**

A claim of fraud for non-use requires a showing that Applicant lacked a reasonable basis for a good faith belief that he had used his DOSF Mark in commerce. *Sinclair Oil Corp. v. Kendrick*, 85 USPQ2d 1032 (TTAB 2007); *Maids to Order of Ohio, Inc. v. Maid-to-Order, Inc.*, 78 USPQ2d 1899 (TTAB 2006). Applicant has observed that throughout this motion, Opposer

seems to muddle the bases relating to fraud for non-use and non-use, as it to suggest that the standard for support either theory is the same. However, these claims involve different standards of proof, and the evidence required to support these two claims is distinct.

Paragraphs 6-7, 14-15, 17, 20-21, and 26 of Opposer's Motion all relate to Applicant's production of certain information and documents such as receipts, invoices, and other evidence provided by Applicant to Opposer to demonstrate Applicant's use of his DOSF Mark and sales of products bearing his mark. Applicant maintains his position that the names of his customers and his production sources are not necessary to establish the fundamental point at issue in Opposer's fraud claim for non-use: that Applicant had a good faith basis for his belief that he made sales of his products to customers at the time of filing his application. The names of customers who purchased those products, and the names of the parties who produced those items, are irrelevant to the discussion of whether Applicant had a reasonable basis for his belief that sales in connection with the DOSF Mark at the time of filing had occurred. Rather, the information contained in these documents—even without specific names and street addresses — is more than sufficient to demonstrate evidence of Applicant's good faith belief that he had used the mark in commerce at the time of filing. Opposer's demand that Applicant reveal the identity of these individuals is without a basis in law and cannot be sustained.

2. The identity of Applicant's product manufacturer(s) is not relevant to whether Applicant had a good faith belief that his products originated in San Francisco.

Similarly, the information related to confidential customer and supplier data that Opposer requests in Paragraphs 6-7, 14-15, 17, 20-21, and 26 of his Motion is not relevant to a discussion of whether Applicant committed fraud when Applicant stated that his goods were produced in the San Francisco area. First, at least one of the documents Applicant provided reflected a

location based in Oakland, California—a neighboring city located within the San Francisco metropolitan region. Even though the name of this entity was redacted for purposes of confidentiality, the invoice still shows sufficient information to indicate the manufacturer’s location within the San Francisco metro region.

In Paragraph 30, Opposer asserts that “Plaintiff has asserted a claim of fraud against the Defendant in part for representing to the Examiner that his goods were/are manufactured in San Francisco” and that “[i]nformation concerning the locale in which the goods are manufactured is relevant to providing [sic] whether Defendant’s representation under oath to the Trademark Office was truthful.” In Paragraph 32, Opposer again asserts that unredacted documents are pertinent to a claim of fraud related to geography.

Again, Opposer’s assertion is based upon a misinterpretation of the fraud standard. What is at issue is not the truthfulness of Applicant’s statement that his goods were produced in the San Francisco area, per se. Rather, what is at issue—and what Opposer seemingly fails to understand—is Applicant’s *reasonable basis for his belief* that the goods were produced in the San Francisco area. The documents Applicant provided are more than sufficient to demonstrate evidence of the basis for Applicant’s belief.

Finally, there are other ways that Opposer may test the sufficiency of Applicant’s reasonable belief. For example, Opposer could have simply served Applicant with a single interrogatory such as “state all facts upon which you form the basis for your belief that the goods originate in San Francisco.” Had Opposer ever offered such a request, Applicant could have provided additional information that would support his good faith belief in the truth of his statement.

For instance, Applicant had at least one telephone conversation with the Examining Attorney, Maureen Dall Lott, during the course of prosecution of this application in which Applicant and Ms. Lott discussed her request for additional information related to the origination of Applicant's products. Applicant explained that at least some of the goods included in his application were manufactured in the San Francisco Bay Area at the time Applicant made the statement, such as t-shirts he had personally manufactured as far back as 1997. In addition, Applicant confirmed that he lived in the San Francisco metropolitan region and that he advertised and promoted his goods from that location. Based on their conversation, the Examining Attorney determined that no further action was necessary on this issue. As such, the information Opposer seeks to prove fraud for geographically deceptively misdescriptiveness is unnecessary and misplaced because there were other factors that went into the Examining Attorney's decision whether to refuse registration on these grounds.

As Applicant previously asserted in his December 23, 2011, Combined Motion to Dismiss, Motion to Strike, Motion for More Definite Statement ("Applicant's December 2011 Motion"), the criteria for determining whether a product is geographically deceptively misdescriptive involves an inquiry into whether consumers would believe, inter alia, that goods "originate" from a particular geographic location. Applicant further pointed to Board authority that states that it is not necessary that goods be produced in a particular region in order to support the finding that the goods originate from that location. *In re Nantucket Allserve Inc.*, 28 USPQ2d 1144 (TTAB 1993). Instead, a product may be deemed to "originate" from a location if it is *manufactured, produced, or sold* there. See *Fred Hayman Beverly Hills Inc. v. Jacques Bernier Inc.*, 38 USPQ2d 1691 (TTAB 1996).

In addition, another document evidences a manufacturing company based in China (with name and street address redacted), one of several suppliers with whom Applicant conducted business to obtain his products. Opposer asserts in Paragraph 26 of his motion that he requires the identity of these entities because “[e]vidence of the manufacture and supply of the goods from outside of San Francisco would be evidence that the representation made to the Examiner was fraudulent.” Opposer’s assertions are incorrect and not supported by relevant law. By Opposer’s own admission, this is a fraud claim - not a geographically descriptive or deceptively misdescriptiveness claim. Therefore, the fundamental element that is at issue here is whether Applicant had a reasonable basis for his good faith belief that the statement made to the Examining Attorney during prosecution of this application was true.

Simply put, Opposer’s discovery requests do not address the primary issue of whether Applicant had a good faith belief that his goods either were produced or originated in the San Francisco area. Moreover, Opposer is once again reminded that the claim at issue in this proceeding is fraud—*not* geographically deceptively misdescriptiveness. As such, Opposer cannot sustain his argument that unredacted documents are essential to evidencing the claim at issue here.

3. The identity of Applicant’s product manufacturer(s) is not relevant to whether Applicant used the DOSF mark in commerce at the time of filing his application.

Finally, Opposer has not asserted in his Motion to Compel any facts or legal basis to support his claim that the identity of confidential suppliers and trade channels is relevant to support a claim of non-use. What *is* relevant is that these invoices and manufacturing receipts reflect sufficient information to indicate that Applicant maintained an inventory of relevant products bearing the DOSF Mark, that those products were sold by Applicant (therefore

supporting his assertion that the sales were made on or before the filing date of his application), and that those sales were made to customers outside of California. (The documents produced by Applicant retained the city and state of the customer's address in order to illustrate that the purchase was made by an out-of-state customer.)

Opposer also fails to point out that not all of the documents provided by Applicant were redacted. For instance, two of the invoices provided by Applicant reflected sales in 2008 made to a commercial re-seller named Sunset Surf Shop, a now-defunct brick-and-mortar store featuring sporting equipment and fashion clothing and accessories. Sunset Surf Shop frequently sold products to local patrons, as well as out-of-town tourists, both in its retail location in San Francisco and via the internet. In addition, the owner of the Sunset Surf Shop has been identified in Applicant's Initial Disclosures as Brian Kramer. Mr. Kramer is, and has always been, available to provide discovery deposition testimony to Opposer as to facts and information he possesses related to claims at issue in this proceeding.

However, Opposer has never sought any information from Mr. Kramer, nor has he ever attempted to notice Mr. Kramer's discovery deposition. Instead, Opposer focuses his demands solely on the redacted documents that evidence the identity of *current* suppliers and distributors. Frankly, Applicant is puzzled as to why Opposer would persist so vehemently in pursuing this information when Mr. Kramer's testimony as to Applicant's sales activities and use of the DOSF Mark *at the time of filing* would be very relevant to the claims at issue in this proceeding. In view of the fact that Opposer has always had full access to such relevant sources of discovery, his assertions that he has somehow been thwarted in his discovery efforts fall flat. For these reasons, Opposer has failed to demonstrate any compelling reason why unredacted copies of

Applicant's confidential customer and commercial data are necessary to support his claims of non-use by Applicant.

4. Opposer's Requests for Information related to use of the DOSF Mark for the four years preceding the filing of this application are not relevant to any claim at issue in this opposition,

In Paragraph 26, Opposer identifies Interrogatory No. 1 in his August 1, 2013, set of interrogatories, and Applicant's objection to the same, on the grounds that the information requested therein was not relevant to any claims asserted by Opposer and not reasonably calculated to lead to the discovery of admissible evidence. Opposer then asserts that he is entitled to information concerning the identity of Applicant's customers and suppliers because "the manufacture of the listed goods or lack thereof is relevant to demonstrating the Mark was not in use continuously and regularly in the years *prior to the filing of the application*" (emphasis added). Opposer makes similar arguments in Paragraphs 27, 28, 30, 31, and 32 regarding Opposer's August 1, 2013, Interrogatory Nos. 2, 3, 6, and 7, and August 1, 2013, Request for Production of Documents No. 6.

What Opposer so strategically omits from his motion is the fact that each of these discovery requests seeks information related to Applicant's sales activities and use of the DOSF Mark from the years 2005 to 2009—in other words, for a period of *four years* prior to the date of filing. Opposer fails to provide any basis for requesting information that pre-dates the filing date of this application by so many years. Because these requests were plainly objectionable on their face, Applicant properly objected to these requests in his September 5, 2013, responses to these interrogatories and document production requests. To date, Opposer still has not demonstrated any valid legal theory that would support his request for this information, or would otherwise explain his reasons for requesting this irrelevant information.

Rather, Opposer's Motion to Compel simply reflects conclusory statements (not supported by any relevant case law) that the "request for manufactures and suppliers prior to the filing of the application goes directly to both the non-use claim and the claim that the applicant fraudulently filed an In Use application." Opposer's position is simply unsupportable. There is no claim at issue in this opposition (e.g., abandonment) that would necessitate or even justify a request for sales or use information from four years prior to the date of filing.

Moreover, Opposer has already been instructed by the Board in its September 4, 2011 Order that dates of first use and claims regarding use of the DOSF Mark prior to the time of filing cannot form a proper basis of a fraud claim so long as there is use of the applied-form mark as of the date of filing date of the application. (The Board's September 4, 2011 Order struck Opposer's allegations related to the dates of first use of Applicant's mark for failure to form a basis for a valid claim.) Given that Opposer has offered no legal basis for requesting this pre-filing information, Applicant respectfully submits that these requests are improper and irrelevant.

5. Opposer's Requests for Information related to Applicant's decision to submit his original specimen of use are not relevant to any claim at issue in this opposition.

In Paragraph 29, Opposer states that he is entitled to information concerning Applicant's decision to submit a specimen that consists of a photograph of a jacket with a tag bearing the moniker "Capt. Spalding." Opposer's request is unwarranted and irrelevant for two reasons.

First, Opposer's request for information related to Applicant's originally-filed specimen is not relevant to any claim at issue in this proceeding because it does not relate to any material false statement upon which the Examining Attorney relied in permitting the application to proceed to registration. Applicant has already explained in his December 2011 Motion that his

originally-filed specimen was simply submitted in error. Specifically, after Applicant's application was filed, but before the present opposition was instituted, Applicant learned that his previous attorney had uploaded the wrong photographs to the TEAS online filing system when filing this application. Applicant had originally provided his previous attorney with several photographs depicting products that Applicant had sold under his DOSF Mark. The photographs submitted with the application were of a used jacket that Applicant had purchased in order to re-create the vintage look of one of his product lines. These photographs were saved on Applicant's computer in the same folder as several other product photographs and were inadvertently included in the photographs sent to Applicant's previous counsel who then selected the photos for submission with Applicant's application. Later, upon learning of this error and conferring with Applicant's current attorney, Applicant submitted a verified substitute specimen which was accepted by the Examining Attorney.

As Applicant has already asserted in his December 2011 Motion, an applicant is permitted to file a substitute specimen if the proposed substitute specimen was in use in commerce as of the date of filing, and the applicant includes a declaration verifying these facts. 37 C.F.R. § 2.59; T.M.E.P. § 904.05. An applicant may submit a substitute specimen for many reasons (e.g., the original specimen is unacceptable to the Examining Attorney or does not show use of the mark with the relevant goods or services). However, as long as the requirements of 37 C.F.R. § 2.59 are met, the Applicant will be permitted to file the substitute specimen and the Examining Attorney may accept the new specimen into the record. Therefore, because the Applicant's originally-filed specimen did not constitute a material false statement upon which the PTO was prepared to grant registration, it cannot form the basis for a sustainable fraud claim and Opposer's requests for documents and information related to Applicant's originally-filed specimen are not relevant to any claim at issue in this proceeding.

Second, the Board's September 4, 2011, Order of Suspension specifically Opposer that allegations directed to ex parte examination issues fail to state a proper ground for an inter partes proceeding. Moreover, the Board specifically advised Opposer that allegations related to Applicant's originally-filed specimen *cannot* form the basis for a claim in this proceeding:

“[T]o the extent that opposer may have sought to allege that there was examiner error with respect to the consideration of applicant's specimens of use (during both the initial examination and post-registration [sic]³), it is well-settled that allegations directed to *ex parte* examination issues fail to state a proper ground for an *inter partes* proceeding.” See *Demon Int.'l LC v. William Lynch*, 86 UPQ2d 1058 (TTAB 2008), citing *Century 21 Real Estate v. Century Life of America*, 10 USPQ2d 2034, 2035 (TTAB 1989) (the issue of the adequacy of the specimens is solely a matter of ex parte examination).

In this case, Examining Attorney, Maureen Dall Lott, accepted Applicant's proposed substitute specimen and entered it into the record. Further, the Examining Attorney was made aware of Applicant's reasons for offering his substitute specimen and still accepted his specimen. Therefore, to the extent that Opposer is indirectly challenging the sufficiency of the Examining Attorney's decision to accept the substitute specimen, Board precedent directs that such a challenge cannot constitute a ground upon which relief may be granted. As such, Opposer's request for information related to Applicant's decision to submit his originally-filed specimen is irrelevant to any claim in this proceeding and cannot be entertained under any plausible legal theory.

C. Board Practice Discourages Parties From Disclosing Confidential Customer Information.

Applicant respectfully submits that the Board expressly discourages parties from submitting materials that contain personal identifying information and directs parties that such information should be redacted:

³ Applicant believes the Board's Order meant to indicate “post-publication”, rather than “post-registration.”

The parties are strongly discouraged from submitting materials which contain the personally identifiable information of an individual (e.g., account numbers, social security number, home addresses, and home phone numbers) (emphasis added)...If such information is embedded in the materials being submitted, such privacy information is to be redacted (emphasis added). TMBP Section 120.02.

Disclosure of an individual's personally identifiable information (e.g., social security number, financial account numbers, or home address) is not necessary. Such information should always be redacted from any submission. TBMB Section 502.02(c)

The Board's directive concerning the release of such confidential customer information is clear and Applicant cannot deviate from the Board's directive on this matter without a compelling reason to do so.

In addition to these valid privacy concerns, it would be an imprudent business decision for Applicant to disclose the names of individual customers who made good faith purchases of his products, only to have their names released without their consent and appropriate regard for their privacy rights in the midst of a contentious opposition proceeding. Board precedent supports this policy of protecting customer privacy. *See Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147 (TTAB 1985) (need for customer names does not outweigh possible harm, such as harassment of customers); *J.B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577 (TTAB 1975) (must identify class of customers who purchase products under mark, but not names of customers). Therefore, Opposer's reliance on the terms of the Board's protective order to compel production of this private customer data is erroneous and Applicant cannot be compelled to produce the identity of third-party private customers as such disclosure would be in violation of Board policy and practice.

D. The Names of Applicant's Suppliers Constitute Highly-Sensitive Trade Secret Information and the Potential Harm to Applicant Outweighs Opposer's Need for This Information.

Opposer further asserts that he is entitled to unredacted versions of documents evidencing the names and addresses of certain of Applicant's manufacturing invoices reflecting the identity of Applicant's manufacturers and suppliers. In his original discovery responses, Applicant redacted the names and street addresses of his product suppliers and retail store customers because this information constitutes confidential Trade Secret/Commercially Sensitive material. Applicant's confidential trade secret and third party privacy concerns for the production of unredacted documents bearing full names and addresses are well founded based upon Applicant's prior business dealings with Opposer.

Specifically, Opposer acted in bad faith, both before and during these proceedings, when he fraudulently filed a trademark application for a competing variation of the DOSF Mark, even though Opposer knew full well from his prior business dealings with Applicant that Applicant was already using his DOSF Mark and had already filed an application to register his mark with the PTO. Opposer then contacted Applicant to announce his own trademark filing and his plans essentially to extort money from Applicant by "licensing" Applicant's own mark back to him. (Interestingly, Applicant notes that Opposer never indicated to Applicant in any prior communications that he in any way contested the validity of Applicant's application—that is, until the PTO suspended Opposer's own application and his plans to "license" the DOSF Mark to Applicant were seemingly thwarted.)

Unfortunately, from that time on, Opposer continued his attempts to disrupt Applicant's business by inappropriately contacting Applicant's retail customers and threatening them with specious claims of infringement, despite the fact that Opposer had absolutely no basis to make

these claims. Specifically, in February or March 2010, Opposer contacted The Hard Wear Store and several other clothing retailers in the Haight Ashbury district of San Francisco at a time when Applicant was distributing sample merchandise. These inappropriate contacts were made for the purpose of intimidating these businesses and discouraging them from transacting with Applicant by asserted trademark rights that Opposer does not possess. Opposer has also interrupted Applicant's online commerce by filing an infringement claim against Applicant's original Facebook page which resulted in Applicant losing over 3,000 page followers. Since that time, Applicant has been forced to recreate his Facebook page and "fan base" from scratch.

Opposer's previous actions have caused harm to Applicant with respect to his commercial and customer information. In addition, Applicant has made a reasonable showing that the information requested is either irrelevant or unnecessary for Opposer to support his claims. In view of these facts, the balance of hardships weighs in Applicant's favor and Opposer's requests for confidential commercial and customer information must be denied as improper and unfounded.

E. Opposer's Discovery Request Is a Poorly-Crafted Attempt to Deprive Applicant of Documents Upon Which He May Need to Rely On to Defend Himself in This Proceeding.

Finally, Opposer's request for information that he knows Applicant cannot in good conscience disclose is nothing more than a ploy to "box in" Applicant and to try to get him to forfeit his reliance on any documents he might use to defend himself in this action. In particular, Opposer stated in his "Notice of Insufficient Initial Disclosures" that Applicant may enter a "statement by his counsel that he does not intend to rely on *any* [emphasis added] of his suppliers, manufacturers and customers" to support his defenses in this proceeding. In other words, Opposer is attempting to use Applicant's reasonably-founded reluctance to disclose

CERTIFICATE OF SERVICE

I certify that on October 22, 2013, a true copy of the foregoing

**APPLICANT'S RESPONSE TO PETITIONER'S MOTION
TO COMPEL DISCOVERY RESPONSES**

were served on Kurt Leyendecker via electronic mail to kurt@coloradoiplaw.com

/Marina A. Lewis/

Marina A. Lewis