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

Proceeding	91201070
Party	Defendant Matthew Harnden and Roger Scommegna
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Date	01/30/2012
Attachments	Opp to Deposition Motion.pdf (9 pages)(112018 bytes) Response to Selected Interrogatories Ex A.pdf (6 pages)(89375 bytes) Email to Leavens Ex B.pdf (1 page)(1098036 bytes)

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

PROCEEDING NO. 91201070

Anderson Valley Acquisition Company, LLC

v.

Matthew Harnden and Roger Scommegna

Serial No. 85178395

Mark: BOONVILLE CIDER HOUSE BITE HARD CIDER

**APPLICANTS' OPPOSITION TO OPPOSER'S RULE 56(D) MOTION TO CONTINUE
APPLICANTS' MOTION FOR SUMMARY JUDGMENT PENDING DISCOVERY¹**

Facing an opposition based on a highly questionable theory of likelihood of confusion that appears to be little more than an effort to intimidate Applicants into abandoning their mark, Applicants moved for summary judgment to avoid the time and expense of discovery and further proceedings. As Opposer is well aware, Applicants are individuals involved in a start up venture and can ill afford the cost that Opposer seeks to inflict on them. Recognizing that it may not be able to succeed in tis efforts, Opposer now seeks to add harassment to its intimidation tactics by forcing Applicants to submit to unnecessary depositions.²

¹ Applicants note that the Opposer's motion was not served in accordance with the Board's rules. It was served via email rather than by hand or first class mail and there is no agreement in place between the parties for such service. Nevertheless, Applicants have treated this motion as served via regular mail and chosen to respond out of an abundance of caution.

² Bizarrely, in making its case for these depositions, Opposer seems to claim that it needs to take the depositions of *Applicants* to determine why its own mark is descriptive, "Based upon the allegations set forth in the Declaration of Roger Scommegna, Applicants' Motion . . . that Opposer's mark is descriptive. Opposer cannot conceivably respond to the above contentions without the opportunity to orally depose Scommegna and Harnden . . ." Opposer's Brief at 5. This same theme continues when, seeking depositions regarding the strength of the marks, Opposer notes that, "Applicants state that Opposer 'uses 'Boonville' prominently and descriptively to identify the place where it brews beer.'"

I. BACKGROUND

Before addressing the merits (or lack thereof) of Opposer's motion, it is useful to consider the marks in issue and the actual nature of Applicants' motion for summary judgment.

Opposer's registered mark is "THE LEGENDARY BOONVILLE BEER" in the logo form shown below:



Both the terms "BOONVILLE" and "BEER" are disclaimed.

Applicants' pending application is for the mark, "BOONVILLE CIDER HOUSE BITE HARD CIDER." Applicants have also disclaimed the term "BOONVILLE" as well as the term "HARD CIDER".

As can be clearly seen, the *only* common term between the two marks is the disclaimed term "BOONVILLE", the place where both parties manufacture (or in the case of Applicants, intend to manufacture) their respective products. Given the obvious disparity between the commercial impressions of the two marks, and the admitted descriptiveness of the only overlapping term, Applicants moved for summary judgment. The principal basis for Applicants' motion is that disparity. The only other evidence submitted by Applicants in support of their motion was labels of *Opposer's* products showing the term "BOONVILLE" used descriptively (submitted via the declaration of Roger Scommegna), several articles also showing descriptive uses of "BOONVILLE" in connection with Opposer's products (submitted via declaration of the undersigned counsel) and two third party uses of "BOONVILLE" (also submitted via the

declaration of Roger Scommegna). Exemplary labels of uses of a mark similar to Applicants' pending mark were also submitted via the Scommegna declaration.

When the present proceeding was stayed pending a decision on Applicants' motion for summary judgment, Opposer had outstanding discovery to which Applicant had not responded (the response date had not yet been reached). Despite no obligation to do so, Applicants responded to selected discovery requests – both document requests and interrogatories – that Opposer submitted were necessary to formulate its response to Applicants' summary judgment motion.³ In other words, Opposer has already had the benefit of discovery in this proceeding – the very same discovery it now claims to be seeking. (Opposer states in its brief at pages 2-3 that it seeks oral depositions, “[C]oncerning the subject areas addressed by the [existing] written discovery requests.”). Ignoring the lack of relevance of the information sought by Opposer, what is confirmed by the responses, and what Opposer does not seem to grasp, is that Applicants have not used the mark. In other words, virtually all of the information Opposer claims it needs to respond to Applicants' motion simply doesn't exist.

II. OPPOSER'S MOTION SHOULD BE DENIED

Strangely, Opposer claims that it cannot “conceivably” respond to Applicants' summary judgment motion without orally deposing *both* Scommegna and Harnden (the Applicants). It claims this is necessary because it needs to “test the veracity of the declaration testimony submitted.” However, only Scommegna submitted a declaration. Thus, there is no basis for Opposer's claimed “need” of a deposition of Harnden.

³ Not only were Opposer's requests objectionable because the proceeding was stayed, they also sought irrelevant information about Applicants' intentions and activities with respect to the applied for mark – ignoring the fact that it is what is in the four corners of the application that determines the mark's registrability.

A. Commercial Impression

Opposer claims it needs discovery about “the actual and intended commercial impression of Applicants’ Mark.” However, as noted earlier, and as conveyed to Opposer, Applicants have not used the mark. Therefore there cannot be any actual commercial impression other than that derived from observation of the wording of the mark in the application.

Opposer also claims that Scommegna has offered evidence on commercial impression stating, “Relying on the Declaration of Scommegna, Applicants assert the legal conclusion that ‘it is undisputed that they [the marks] present entirely different commercial impressions’” Opposer’s Brief at 6. However, the quoted sentence does not cite to Scommegna’s declaration and Scommegna’s declaration makes no such averments. Indeed, the actual sentence makes clear that the conclusion is based on what is obvious from observing the two marks themselves rather than anyone’s testimony, “Given the tremendous differences in the sight, sound and meaning of the two marks in their entireties, it is undisputed” Applicants’ Summary Judgment Brief at 14.

As to the “intended” commercial impression of the mark, it is irrelevant. Opposer is challenging the *application* as it appears in the records of the Office. It is on that basis that mark is judged. *See, e.g., Bellbrook Dairies v. Hawthorn-Mellody Farms Dairy*, 253 F.2d 431, 433 (C.C.P.A., 1958)(The right to register a trade-mark must be determined on the basis of what is set forth in the application rather than the manner in which the mark may be actually used.”). As such, any information obtained by Opposer via discovery on this topic would be irrelevant.

In sum, there is no need or basis for a deposition of Scommegna (or Harnden) relative to the commercial impression of Applicants’ mark.

B. Scope of the Goods

Opposer also claims it needs testimony from Scommegna regarding the scope of Applicants' goods sold (or to be sold) under the mark. However, as noted above, the mark has not been used so there are no goods sold under the mark. Even if there were, it is the goods recited in the application that govern the determination of likelihood of confusion, not what Applicants are doing or might do. *Octocom Systems Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 942 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed."). Thus, there is no basis to grant Opposer the opportunity to depose either or both of Applicants as to the scope of Applicants' goods.

C. Applicants Channels of Trade

Opposer claims that it needs to know Applicants' actual or intended channels of trade under the mark, which information it asserts can only be gleaned from *both* Scommegna and Harnden. However, as noted above, the determination of the registrability of Applicants' mark is decided based on what is in the four corners of the application not what channels of trade Applicants' goods do or may travel in. *Octocom Systems* at 42. In other words, granting Opposer the opportunity to depose either Scommegna or Harnden with respect to Applicants' intended or actual sales of goods under the mark into one or more channels of trade would serve no purpose.

D. Strength of the Marks

Under the heading “Discovery is Necessary to Determine the Strength of the Marks,” Opposer claims it needs to determine “the reason or circumstances surrounding Applicants’ disclaimer of the term ‘Boonville’ in their application or how Applicants’ intentions with respect to use of the term ‘Boonville’ may have otherwise been expressed.” Yet again, Opposer fails to recognize that it is the application itself that is the measuring stick against which Opposer’s opposition evidence will be judged. Whatever the actual reason for the disclaimer entered into the record, it is irrelevant. The fact that it was made is the only thing that matters. *See Octocom Systems* at 42.

E. Scope of Use

Under a heading indicating that it seeks to determine Applicants’ claimed scope of use of their mark, Opposer indicates a desire to query Mr. Scommegna about whether there is a connection between the Boonville Hotel and Applicants. However, nowhere do Applicants claim that the Boonville Hotel has any connection to their activities or has any ownership or rights in or to the application at issue. Even if they did, it would be irrelevant to the determination of the scope of use of the mark. Once again, it is the application itself that determines the relevant scope of use for purposes of the present opposition. Whatever the Applicants’ connection may or not be with the Boonville Hotel is irrelevant for purposes of assessing the scope of use of Applicants’ mark. Thus, there is no basis for a deposition of Scommegna or Harnden with respect to the scope of Applicants’ use of the mark.

F. Actual Confusion

Opposer asserts that it needs to depose Scommegna and Harnden about any instances of actual confusion between Applicants’ mark and Opposer’s marks. However, before this motion

was made and in the discovery responses provided to Opposer, Applicants made clear that not only was there no use of the mark – precluding any actual confusion – but, there was not any actual confusion between the other similar marks Applicants had used. *See* Response to Interrogatory No. 13, attached hereto as Exhibit A and the email from Adam Brookman to Thomas Leavens dated January 19, 2012 attached hereto as Exhibit B. Thus, a deposition on this topic cannot yield any more information than what was already provided to Opposer.

G. Third Party Uses of the Term “Boonville”

Opposer claims to be unaware of the third party use of “Boonville” by Jim Ball Vineyards in Boonville, California. Putting aside the questionable nature of that claim, such lack of knowledge does not justify a deposition of Mr. Scommegna. The entirety of Mr. Scommegna’s testimony on this subject is set forth below:

5. I am also aware that Jim Ball Vineyards, located in Boonville, California, has been using the word/name “Boonville,” as shown below, to identify one of its wine products since at least 2007.



As can be clearly seen, while such testimony does establish third party use of the term “Boonville” to identify the source of alcoholic goods, there is no testimony about quantities of product sold, distribution, channels of trade, etc. In other words, there is little or nothing to be gleaned from a deposition of Mr. Scommegna (or Mr. Harnden) with respect to this fact; certainly nothing that would warrant the expenditure and cost associated with a deposition.

III. CONCLUSION

Opposer’s motion asks the Board to ignore “legions” of cases that make clear that it is what is in the application itself that is the basis for determining the mark’s registrability. In other words, Opposer seeks discovery that is not likely to lead to the discovery of admissible evidence. Moreover, the information sought by Opposer is cumulative of information already provided as a result of Applicants’ voluntary discovery responses. Thus, any depositions will be a waste of the time and limited resources of Applicants.

Nevertheless, should the Board determine that some additional discovery is warranted; Applicants’ respectfully request that it be limited to targeted written requests. If that is deemed insufficient, narrowly tailored deposition topics would at least serve to minimize the waste of Applicants’ limited resources.

Respectfully Submitted,

Dated: January 30, 2012

By: /Adam L. Brookman/
Adam L. Brookman
BOYLE FREDRICKSON, S.C.
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Milwaukee, WI 53203
Telephone: (414) 225-9755
abrookman@boylefred.com

Attorneys for Respondents/Applicants
Roger Scommegna and Mathew Harnden.

CERTIFICATE OF SERVICE

This is to certify that a true and accurate copy of the foregoing **APPLICANTS' OPPOSITION TO OPPOSER'S RULE 56(D) MOTION TO CONTINUE APPLICANTS' MOTION FOR SUMMARY JUDGMENT PENDING DISCOVERY** was served in the manner indicated to the person indicated on the date indicated:

VIA FIRST CLASS U.S. MAIL

Thomas R. Leavens
Leavens, Strand, Glover & Adler, LLC
203 N. LaSalle Street
Suite 203 Floor
Chicago, Illinois 60601

On January 30, 2012.

/Adam L. Brookman/
Adam L. Brookman

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

PROCEEDING NO. 91201070

Anderson Valley Acquisition Company, LLC

v.

Matthew Harnden and Roger Scommegna

Serial No. 85178395

Mark: BOONVILLE CIDER HOUSE BITE HARD CIDER

**APPLICANT'S RESPONSES TO OPPOSER'S
FIRST SET OF INTERROGATORIES NOS. 3, 5, 6, 8, 10, 12, 13, 14, 15, and 17**

GENERAL OBJECTIONS

1. Applicants object to each and every definition, instruction and interrogatory that seeks to impose obligations upon Applicants that are greater than imposed by the Federal Rules of Civil Procedure. Applicants will respond in accordance with Fed. R. Civ. Pro. 33.
2. Applicants object to each and every definition, instruction and interrogatory that requests information which is privileged, protected from discovery as work product, or otherwise not discoverable under Fed. R. Civ. Pro. 26(b)(3).
3. Applicants reserve the right to object to the use of any of these answers or to the subject matter thereof and/or any documents produced in any other proceeding, and the right to object on any ground at any time to a demand for further response to these or any other requests.
4. Applicants object to the above-enumerated interrogatories, inasmuch as Opposer is seeking discovery during a time when the proceeding is stayed. Applicants' responses at this time are being provided voluntarily and thus, cannot be considered untimely or challenged as unresponsive or incomplete unless and until discovery is re-opened.

RESPONSE TO INTERROGATORIES

INTERROGATORY NO. 3: Identify each person who participated in, provided information concerning, or was consulted with respect to the decision by Applicant to adopt the Mark for use in connection with hard cider.

RESPONSE:

Applicants object to this interrogatory as not likely to lead to the discovery of admissible evidence. Without waiving their objections, Applicants state that the following persons participated in, provided information concerning, or were consulted with respect to the decision by Applicant to adopt the Mark: Matt Harnden, Roger Scommegna, Nicole Scommegna, Kristen Scommegna, John Schmitt, Brooks Schmitt, and Willie Schmitt.

INTERROGATORY NO. 5: Identify each advertising agency, graphic designer, artist, consultant and any other person or entity that participated in, provided information concerning or was consulted with respect to the selection of the Mark for Applicant's hard cider product or any label, packaging, or advertising or promotional material therefor.

RESPONSE:

Applicants object to this interrogatory as not likely to lead to the discovery of admissible evidence, as seeking attorney client privilege and /or work product information. Without waiving their objections, Applicants state that, LegalZoom.com, Inc. provided information concerning or was consulted with respect to the selection of the Mark for Applicant's hard cider product or any label, packaging, or advertising or promotional material therefor.

INTERROGATORY NO. 6: Identify all methods of advertising or promotion of Applicant's hard cider product bearing the Mark and identify the territory of dissemination of such advertising or promotion.

RESPONSE:

Applicants object to this interrogatory as not likely to lead to the discovery of admissible evidence and as vague and ambiguous. Without waiving their objections, Applicants states that there are no methods of advertising or promotion of Applicants' hard cider product bearing the Mark.

INTERROGATORY NO. 8: State whether Applicant has ever conducted, or had conducted, any trademark searches, market research, surveys, investigations, tests, or studies relating to the mark, or any term or mark similar thereto, and if so, identify all such searches, market research, surveys, investigations, tests, or studies and produce all documents relating thereto.

RESPONSE:

Applicants object to this interrogatory as not likely to lead to the discovery of admissible evidence, as seeking attorney client privilege and /or work product information and as improperly seeking the production of documents. Without waiving their objections, Applicants state that, LegalZoom.com, Inc. provided Applicants with trademark search results.

INTERROGATORY NO. 10: Identify each channel of trade through which Applicant has sold its hard cider product under or in association with the Mark.

RESPONSE:

Applicants object to this interrogatory as not likely to lead to the discovery of admissible evidence and as vague and ambiguous. Without waiving their objections, Applicants state that they have not sold their hard cider product under or in association with the Mark through any identifiable channel of trade.

INTERROGATORY NO. 12. Identify the date and the method by which Applicant first had knowledge of any association, or perceived association, between Opposer or Opposer's products or services and BOONVILLE.

RESPONSE:

Applicants object to this interrogatory as not likely to lead to the discovery of admissible evidence and as vague and ambiguous. Without waiving their objects Applicants state that Applicant Roger Scommegna became generally aware of Opposer and Opposer's location in Boonville, CA approximately twelve (12) years ago.

INTERROGATORY NO. 13: Identify each instance of actual confusion, mistake, or deception, or any instance which may indicate a likelihood of confusion, mistake, or deception regarding the source, sponsorship, approval, connection or endorsement of the products advertised, promoted or sold by Applicant under or in association with the Mark and the goods or services advertised, promoted or sold by Applicant.

RESPONSE:

Applicants object to this interrogatory as not likely to lead to the discovery of admissible evidence and as vague and ambiguous. Without waiving their objections, Applicants state that there are no instances of actual confusion, mistake, or deception, or any instance which may indicate a likelihood of confusion, mistake, or deception regarding the source, sponsorship, approval, connection or endorsement of the products advertised, promoted or sold by Applicants under or in association with the Mark

INTERROGATORY NO. 14: For each instance identified in your response to Interrogatory No. 13, identify the person or persons having knowledge of the instance and the date and place of the instance.

RESPONSE:

Applicants object to this interrogatory as not likely to lead to the discovery of admissible evidence and as vague and ambiguous. Without waiving their objections, see the Response to Interrogatory No. 13.

INTERROGATORY NO. 15: Identify any meetings (by date, location, and persons present) where any discussion was held relative to whether the Mark should be modified, discontinued or expanded by Applicant.

RESPONSE:

Applicants objects to this interrogatory as not likely to lead to the discovery of admissible evidence, as seeking work product and/or attorney client privilege information and as vague and ambiguous. Without waiving their objections, Applicants state that there have been no such meetings.

INTERROGATORY NO. 17: Has Applicant acquired through assignment, license, or any I other transfer from a third party, or granted to any third party, any rights in the Mark? If so, from or to whom was the transfer, what was the date of the transfer, and what documents relate thereto?

RESPONSE:

Applicants object to this interrogatory as not likely to lead to the discovery of admissible evidence, as seeking work product and/or attorney client privilege information and as vague and ambiguous. Without waiving their objections, Applicants state that there have been no such transfers.

Dated: January 30, 2012



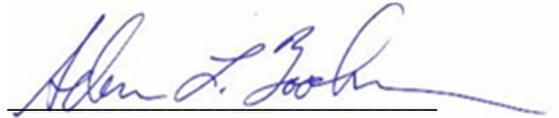
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CERTIFICATE OF SERVICE

I hereby certify that the foregoing document entitled **APPLICANT'S RESPONSES TO OPPOSER'S FIRST SET OF INTERROGATORIES NOS. 3, 5, 6, 8, 10, 12, 13, 14, 15, and 17** is being served by email on the following attorneys for Applicant on January 11, 2012 and by regular mail on January 12, 2012

Thomas R Leavens
Leavens Strand Glover & Adler Llc
203 North LaSalle Street, Suite 2550
Chicago, IL 60601
tleavens@lsglegal.com

A handwritten signature in blue ink, appearing to read "Adam L. Zook", is written over a horizontal line.

Adam Brookman

From: Adam Brookman
Sent: Monday, January 09, 2012 1:53 PM
To: 'Thomas R. Leavens'
Subject: RE: Opposition No. 91201070

Tom,

We will not agree to any depositions at this point. The case is suspended and frankly, you're not even entitled to the discovery responses we've agreed to provide. Still further, as I've said a number of times, we have an intent to use application that you've opposed. The burden is on your client to come forward with evidence to prove it has prior rights that demonstrate a likelihood of confusion. What my clients may or may not have done in selecting their mark is irrelevant to your client's burden and the issue of likelihood of confusion. I can tell you, without the bother of a deposition, neither Matt nor Roger, nor anyone else associated with the Boonville Cider House project thought that Boonville was anything more than the name of the town. They certainly did not associate Boonville with your client and its mark. I'll get you that as a sworn statement if you want. Moreover, as I also mentioned previously, the mark has not been used. Therefore, there is nothing to be gleaned about actual use or confusion. Finally, to the extent there has been use of marks in connection with the sale of hard cider as set forth in our summary judgment brief, there have been absolutely no instances of actual confusion – something I am also happy to provide in a sworn statement.

The bottom line is that we consider this opposition borderline frivolous, and depositions at this stage of the game to be nothing more than an attempt to harass my clients and force them to incur needless expenses and lost time. If you want to take depositions, you will have to make a motion to the Board; a motion we will vigorously oppose.

Adam

From: Thomas R. Leavens [<mailto:tleavens@lsglegal.com>]
Sent: Monday, January 09, 2012 1:31 PM
To: Adam Brookman
Subject: RE: Opposition No. 91201070

Thank you Adam. Can you confirm that we will be able to depose the applicants with respect to the subject areas of the document requests and interrogatories after we receive the applicant's response?

From: Adam Brookman [<mailto:alb@boylefred.com>]
Sent: Monday, January 09, 2012 1:28 PM
To: Thomas R. Leavens
Subject: RE: Opposition No. 91201070

Tom,

I apologize for not responding to you sooner. While I believe your discovery requests are neither warranted nor relevant, solely in the interest of cooperation, we will respond to the subset of requests you identified. You should have those responses electronically later today or tomorrow. If you don't receive them, please let me know.

Adam

From: Thomas R. Leavens [<mailto:tleavens@lsglegal.com>]
Sent: Thursday, January 05, 2012 11:25 AM