

ESTTA Tracking number: **ESTTA694385**

Filing date: **09/08/2015**

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

Proceeding	91203192
Party	Defendant Merkury Innovations, LLC
Correspondence Address	ANTHONY F LO CICERO AMSTER ROTHSTEIN & EBENSTEIN LLP 90 PARK AVE NEW YORK, NY 10016 UNITED STATES ptodocket@arelaw.com, mjason@arelaw.com
Submission	Motion to Compel Discovery
Filer's Name	Marc J. Jason
Filer's e-mail	ptodocket@arelaw.com
Signature	/Marc J. Jason/
Date	09/08/2015
Attachments	Redacted_Defendant's_Opposition_to_Motion_to_Compel_Discovery_&_Jason_Declaration_with_Exhibits.pdf(1901479 bytes )



additional employees of Applicant is nothing more than harassment of a small company by the Opposer, a tech giant.<sup>1</sup>

## I. ARGUMENT

### A. All Relevant Information Has Been Provided

Opposer states on the opening page of its brief that Applicant's Rule 30(b)(6) witness, Mr. Chaby Orfali,

identified Messrs. Kang and Levy as **the only people with knowledge** of (1) who first proposed the mark URBAN BEATZ; (2) what other marks (if any) Merkury considered before adopting URBAN BEATZ; (3) why URBAN BEATZ was selected by Merkury; (4) why Merkury decided to file a trademark application for URBAN BEATZ; (5) whether a trademark clearance search for URBAN BEATZ was performed; and (6) if any such search was performed, who performed the search. (Emphasis added.)

(Opp. Brief at 1.) This statement is blatantly false. Mr. Orfali testified that Messrs. Kang and Levy were involved in the selection of the URBAN BEATZ mark, not that they were the only people with knowledge. Indeed, Mr. Orfali himself testified regarding all of these issues as the company's designated Rule 30(b)(6) witness. He is the most knowledgeable person in the company on all of the relevant issues and he testified about all of them. Attached to the Declaration of Marc J. Jason ("Jason Decl.") submitted herewith are more complete excerpts from Mr. Orfali's deposition transcript which demonstrate that these issues have already been explored and exhausted by Opposer.

For example, at Mr. Orfali's deposition, he testified at length about the creation of the URBAN BEATZ mark. (*See, e.g.*, Jason Decl. Ex. A at 39:25-43:5, 58:11-58:20, 170:11-175:4, 189:8-198:14.) He testified regarding the selection process, identified the personnel present during the selection process, explained the meaning and significance of the terms "Urban" and

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<sup>1</sup> Applicant is a company of about 35 employees. (Orfali Tr. at 39:8-16.) Opposer is now owned by Apple, Inc.

“Beatz,” and even the reason for using the letter “z” at the end of the word “Beatz.” (*See id.* at 58:11-20, 195:7-17.) With respect to the “ultimate decision maker” for adopting the mark, Mr. Orfali testified that it was “all of us” (including Messrs. Orfali, Levy and Kang). (*Id.* at 194:11-18.)

In connection with information about creation of the URBAN BEATZ word mark, Opposer also inquired about creation of the “Urban Beatz” logo.<sup>2</sup> (*Id.* at 170:11-174:4, 198:6-10.) The document regarding creation of the logo was produced by Applicant to Opposer. (Jason Decl. Ex. B.) and Mr. Orfali was examined on the document (referred to as Exhibit 16 during the deposition). As Mr. Orfali testified, the only document created at the meeting at which the URBAN BEATZ mark was selected was this logo design document. (Jason Decl. Ex. A at 198:6-10.) Thus, Applicant has already obtained testimony and the only documentation that exists regarding creation/selection of the URBAN BEATZ mark.

Information that Opposer did not get from Mr. Orfali includes the reason that Applicant decided to file its application to register the mark. Questions directed at this issue were objectionable since the information is protected by the attorney-client privilege, and Mr. Orfali was instructed by counsel not to answer such questions. (*Id.* at 198:11-18.) Such questions would still be objectionable at a deposition of Mr. Kang or Mr. Levy.

With respect to any trademark clearance search conducted by or on behalf of Applicant regarding the mark URBAN BEATZ, no search report has been found despite a diligent search by Applicant and by counsel. (Jason Decl. ¶ 4.) There is no basis to depose Messrs. Kang and Levy on the topic of search reports that do not exist.

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<sup>2</sup> Applicant did not apply to register its “UB” logo. However, the logo creation document is the only document that exists that is related to the creation of the “Urban Beatz” mark. This documents was produced to Opposer and Mr. Orfali was questioned about the document at his deposition in connection with creation of the URBAN BEATZ mark. (Jason Decl. Ex. A at 170:11-174:4, 198:6-10.)

B. Opposer Also Seeks Irrelevant Information

Certain information that Opposer purports to seek from Messrs. Kang and Levy relates to “decisions about packaging for URBAN BEATZ-branded products” and the “decision about whether to offer new products under the URBAN BEATZ mark.” (Opp. Brief at p. 4.) Opposer offers no explanation as to why such information is relevant to a determination of registrability of Applicant’s URBAN BEATZ mark. Indeed, it is not relevant at all. Nevertheless, Opposer had the opportunity to question Applicant on these issues and DID already question Mr. Orfali on product issues. There is no basis to depose Messrs. Kang and Levy on irrelevant topics, and it is late in the game to begin a fishing expedition.

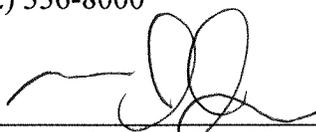
II. CONCLUSION

It is respectfully submitted that the Board should deny Opposer’s motion to compel the depositions of Messrs. Ki Kang and Steven Levy.

Respectfully submitted,

AMSTER, ROTHSTEIN & EBENSTEIN LLP  
Attorneys for Opposer  
90 Park Avenue  
New York, New York 10016  
(212) 336-8000

Dated: New York, New York  
September 8, 2015

By:   
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Anthony F. Lo Cicero  
Marc J. Jason

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing APPLICANT'S OPPOSITION TO MOTION TO COMPEL THE DEPOSITIONS OF KI KANG AND STEVEN LEVY has been served on Opposer Beats Electronics, LLC by delivering said copy via regular U.S. Mail and email to Opposer's attorney of record, as follows:

Michael G. Kelber, Esq.  
*mkelber@ngelaw.com*  
Katherine Dennis Nye, Esq.  
*knye@ngelaw.com*  
Neal Gerber & Eisenberg LLP  
Two North LaSalle Street  
Suite 1700  
Chicago, IL 60602

Dale Cendali, Esq.  
*dale.cendali@kirkland.com*  
Bonnie L. Jarrett, Esq.  
*bonnie.jarrett@kirkland.com*  
Kirkland & Ellis LLP  
601 Lexington Avenue  
New York, NY 10022

By:   
\_\_\_\_\_  
Marc J. Jason

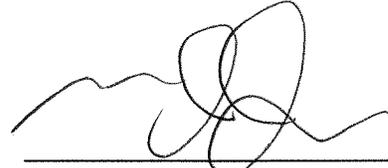
Dated: New York, New York  
September 8, 2015



4. Both the undersigned counsel and Applicant have conducted a diligent search for any trademark clearance search reports related to the URBAN BEATZ mark. No such reports have been found.

Pursuant to 28 U.S.C. § 1746, I declare under penalty of perjury that the foregoing is true and correct.

Executed at New York, New York  
September 8, 2015



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Marc J. Jason

# **EXHIBIT A**

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CHABY ORFALI

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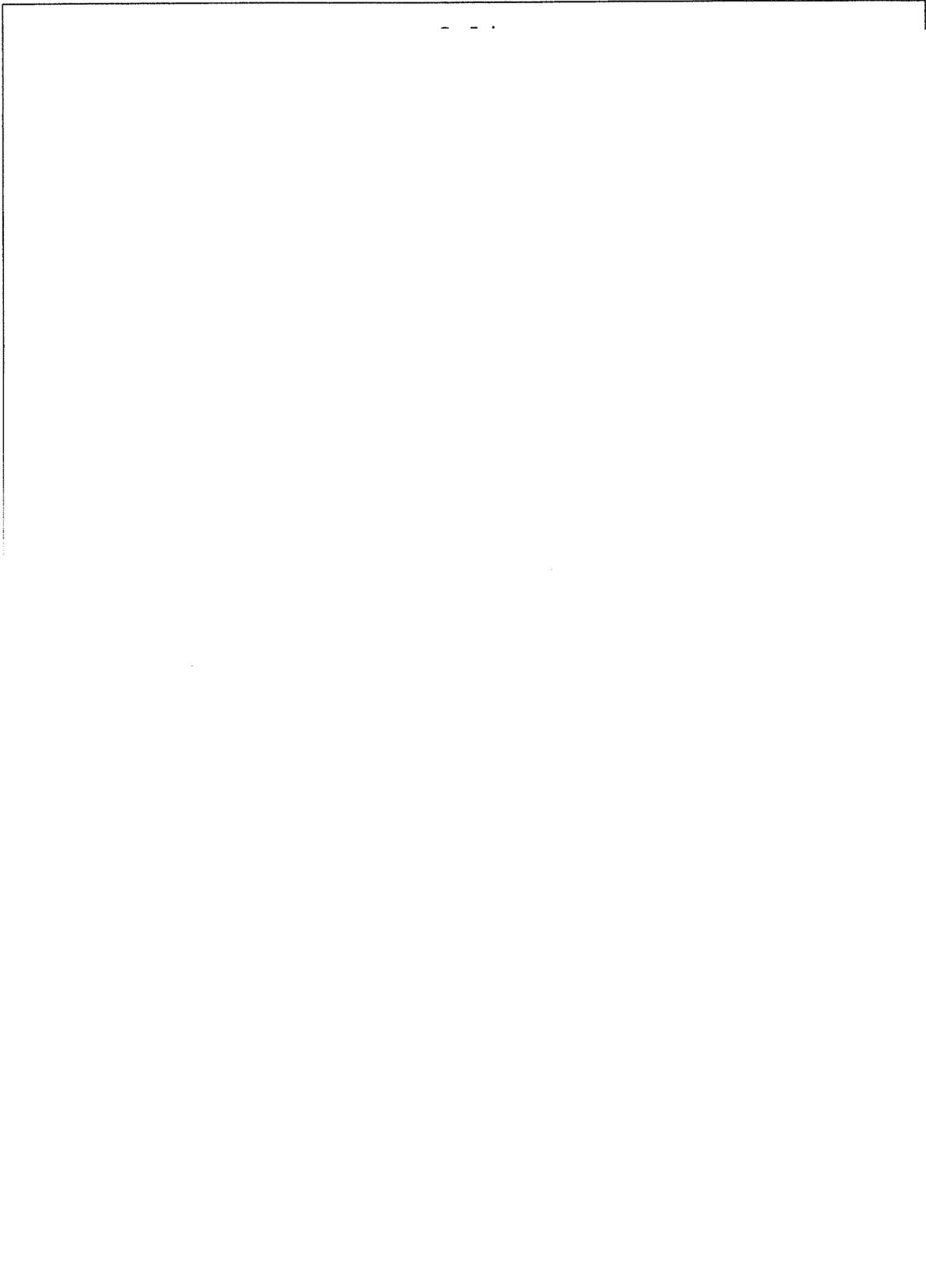
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Chaby Orfali



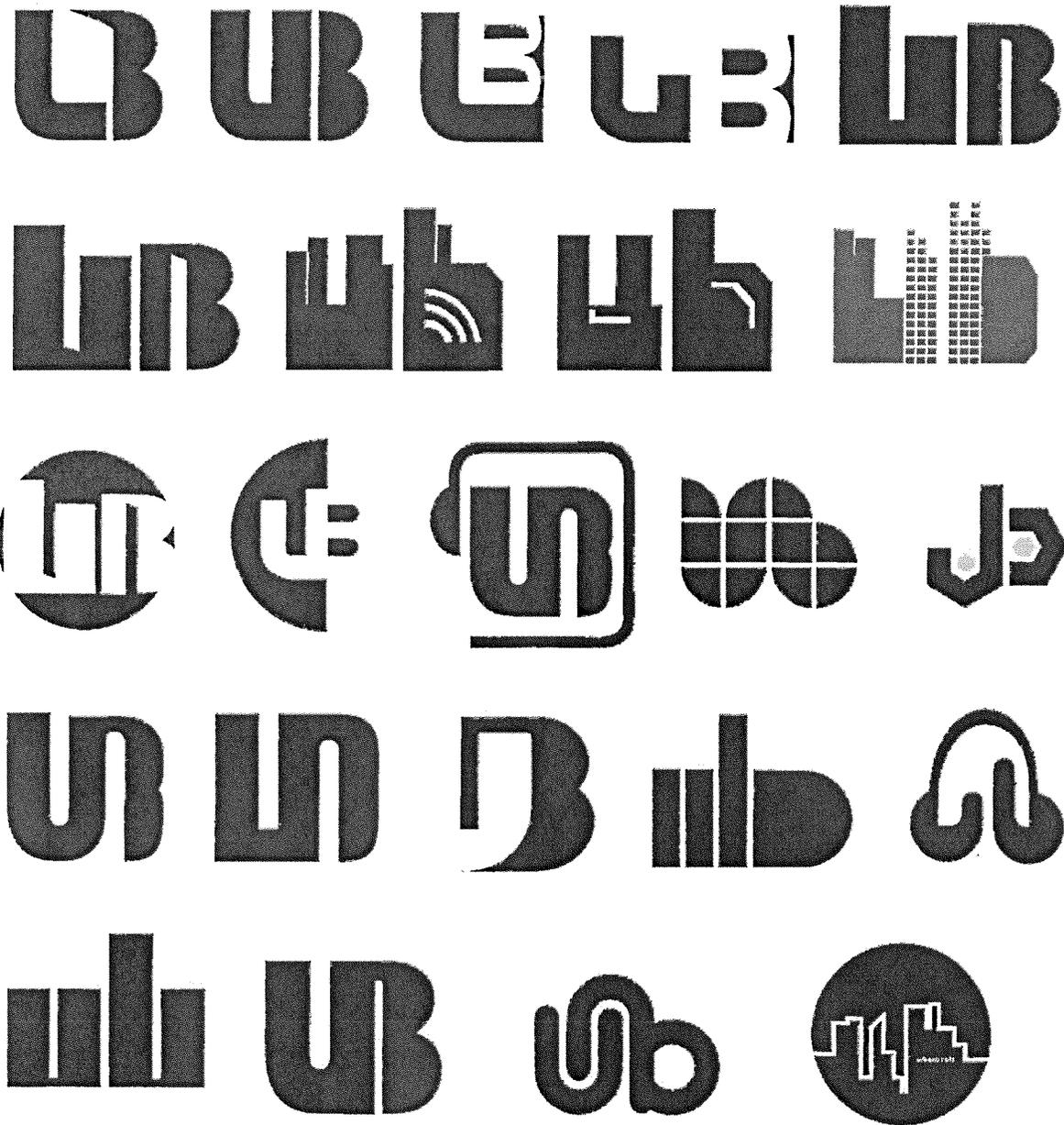
# **EXHIBIT B**

# UB Logo Development

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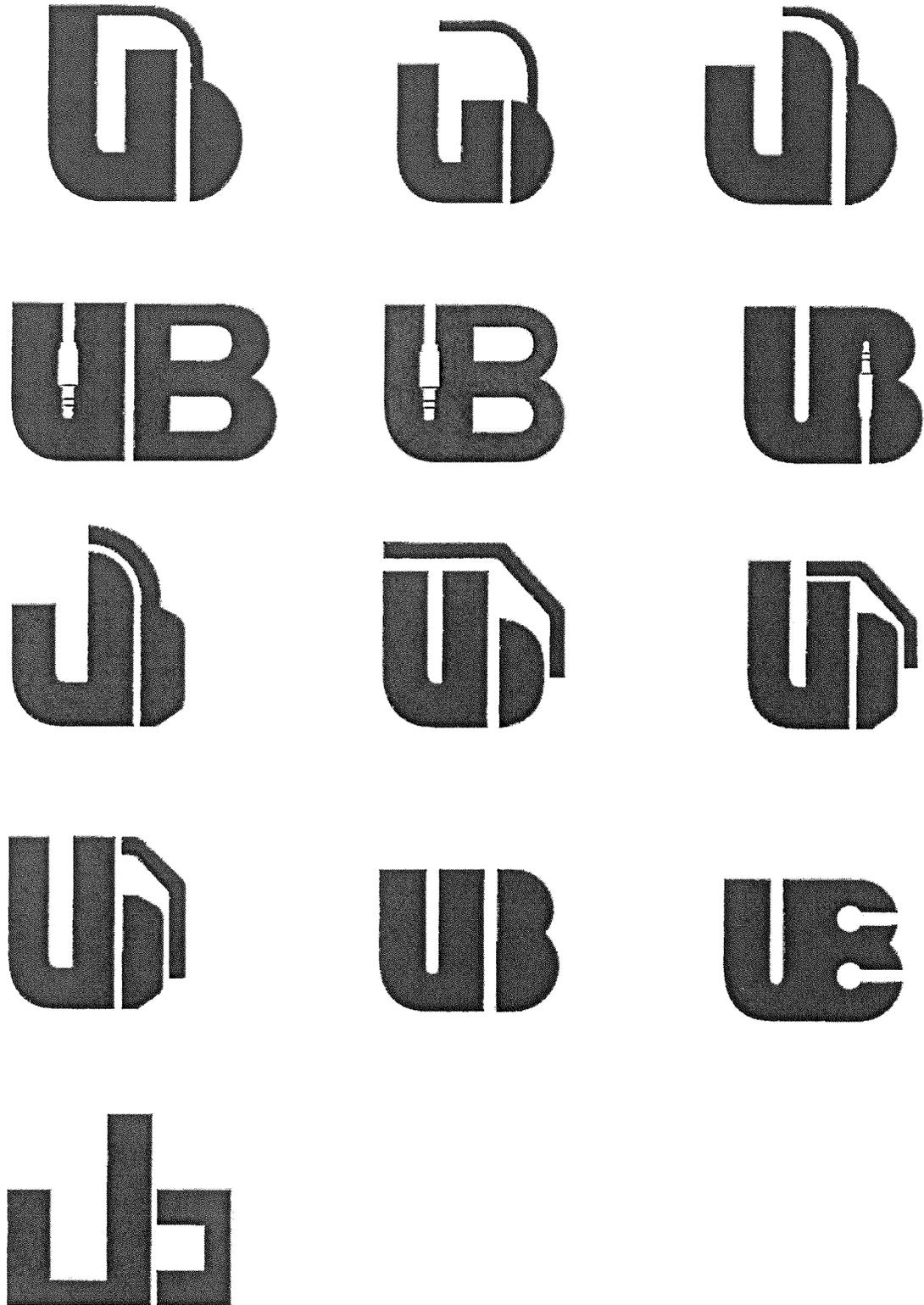


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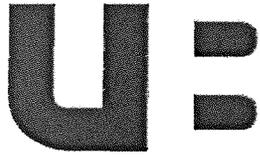
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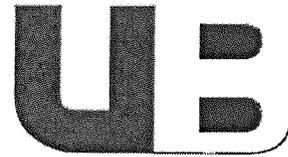


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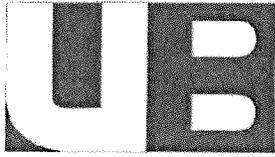
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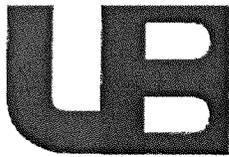
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YOUR MUSIC. YOUR STYLE.



URBAN BEATZ  
YOUR MUSIC. YOUR STYLE.



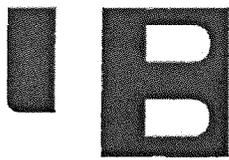
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YOUR MUSIC. YOUR STYLE.



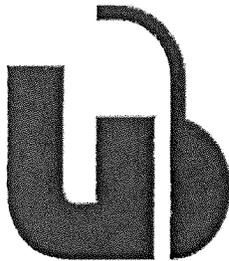
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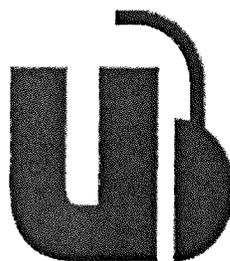
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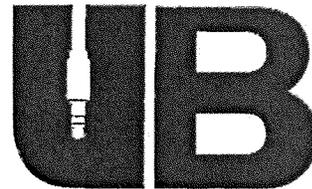
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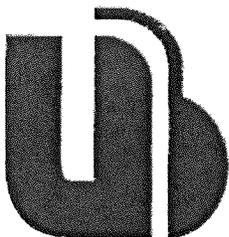
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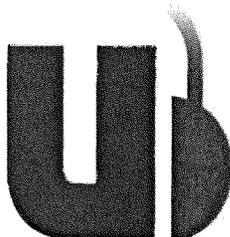
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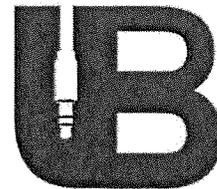
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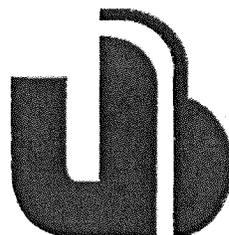
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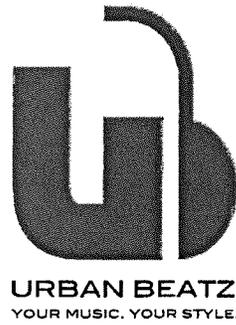


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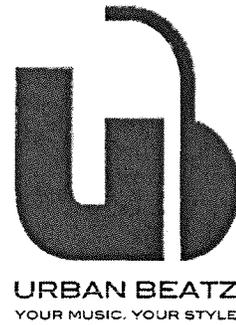
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# UB Logo Development

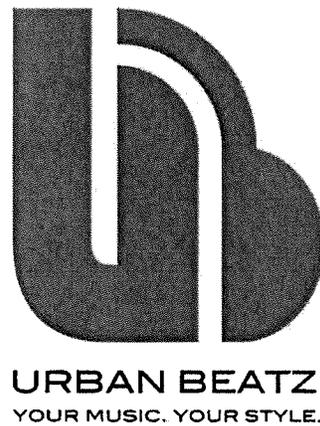
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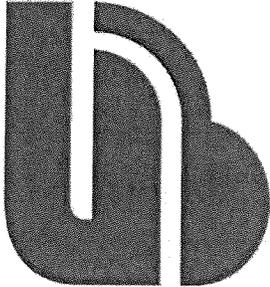


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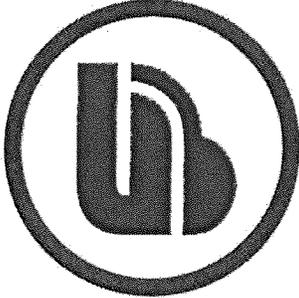


# UB Logo Development

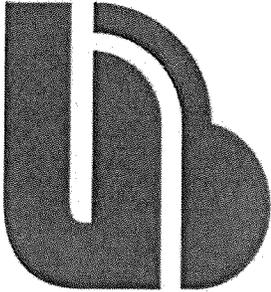
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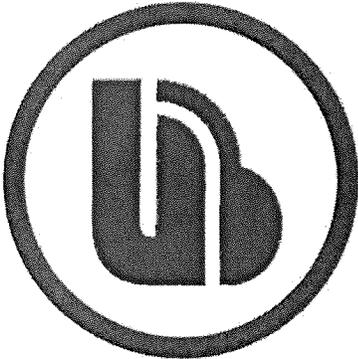
**URBAN BEATZ**  
YOUR MUSIC. YOUR STYLE.



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**URBAN BEATZ**

Your music. Your style.