

ESTTA Tracking number: **ESTTA488459**

Filing date: **08/10/2012**

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

Proceeding	91203865
Party	Defendant Hewlett-Packard Development Company, L.P.
Correspondence Address	JAMES F STRUTHERS RICHARD LAW GROUP 8411 PRESTON ROAD, SUITE 890 DALLAS, TX 75225 UNITED STATES jim@richardlawgroup.com,clarissa@richardlawgroup.com
Submission	Motion to Compel Discovery
Filer's Name	Elizann Carroll
Filer's e-mail	elizann@richardlawgroup.com,clarissa@richardlawgroup.com
Signature	/Elizann Carroll/
Date	08/10/2012
Attachments	HPDC Motion to Compel and to Determine Sufficiency.pdf (10 pages)(50478 bytes) Exhibits to HPDC's Motion to Compel.pdf (32 pages)(219198 bytes)

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

In re MADE FOR HP TOUCHPAD & Design Serial No. 85/315,880 et al.

Apple, Inc.	§	
	§	
Opposer	§	
	§	
v.	§	Opposition No. 91203865
	§	
Hewlett-Packard Development Company, L.P.	§	
	§	
Applicant	§	

**APPLICANT’S MOTION TO COMPEL PRODUCTION OF DOCUMENTS
AND TO DETERMINE SUFFICIENCY OF OBJECTIONS AND
ANSWERS TO REQUESTS FOR ADMISSION**

Applicant Hewlett-Packard Development Company, L.P. (“HPDC”) files this Motion to Compel Production of Documents and to Determine Sufficiency of Objections and Answers to Requests for Admission against Opposer Apple, Inc. (“Apple”) and for good cause shows the Board as follows:

INTRODUCTION

In the above-referenced opposition, Apple is asserting among other things its pending Trademark Application Nos. 85/040,770 and 85/025,647 (hereinafter, the “Applications”), each of which consists, according to its own description, of a “simplified drawing of a mobile digital electronic communication device.” Apple has referred to these drawings as “Opposer’s iPhone Mark” and “Opposer’s iPad Mark,” respectively.

The Applications are not entitled to a presumption of validity, and HPDC has placed the validity of the Applications in issue through its affirmative defenses which allege that the drawings shown in the Applications are non-distinctive and functional, lack secondary meaning,

and are substantially common designs used by many other manufacturers of mobile digital electronic communication devices.

HPDC seeks discovery relating to Apple's decisions to use the elements depicted in Apple's "simplified drawings" as features of its corresponding iPhone and iPad products, the purpose these features serve, whether Apple was the first to employ these features, and whether Apple and third-parties use similar features, and has requested documents from a pending lawsuit in which Apple is asserting trade dress rights in a combination of the same features. See Exhibit A (RFP No.'s 3-4, 14-21, 24-25, and 29-36; RFA No.'s 6-10, 25-32). Apple has objected to all of these requests on the grounds that they seek information that is not relevant or reasonably calculated to lead to the discovery of admissible evidence.

The information sought by HPDC is both relevant and reasonably calculated to lead to the discovery of admissible evidence, because whether the features shown in Apple's simplified drawings are functional, rather than ornamental, directly correlates to the strength and distinctiveness of the alleged marks, and this in turn correlates directly to the validity of the marks and whether confusion is likely, as Apple alleges. Similarly, widespread industry use of devices that strongly resemble the drawings in the Applications is clearly relevant to the distinctiveness and strength of the alleged marks, which is relevant to likelihood of confusion.

Apple has also objected to the foregoing discovery requests on the grounds of overbreadth and undue burden, but has not explained or justified these objections. Indeed, there appears to be no good faith basis for objecting on these grounds, given that the discovery involves matters that are relevant and clearly within Apple's knowledge as a leading provider of tablets and smartphones. Having chosen to assert simplified drawings of a tablet and smart phone as trademarks, Apple cannot now claim it is unduly burdensome to answer discovery questions

related to the marks' ability to distinguish Apple's smart phones and tablets from others.

Apple has also asserted registrations in this Opposition that contain the word IPAD. IP Development Company, LLC ("IPAD-LLC") owns an intent-to-use application for the mark "IPAD," and this application appears to have priority over Apple's asserted registrations. Accordingly, HPDC is seeking discovery regarding Apple's relationship, if any, with IPAD-LLC. **See Exhibit A** (RFP No.'s 26-28, and RFA No.'s 1-4). Apple has refused to answer discovery relating to its relationship with IPAD-LLC. However, use or registration of IPAD by parties other than Apple would plainly be relevant to Apple's claimed ownership of the asserted marks containing IPAD, as well as their distinctiveness and strength. Accordingly Apple's relationship or lack of relationship with IPAD-LLC is clearly relevant.

THE SCOPE OF DISCOVERY IS BROAD

Federal Rule 26 (b)(1) provides that a party is entitled to discover "any non-privileged matter that is relevant to any party's claim or defense.... Relevant information need not be admissible...if the discovery appears to be reasonably calculated to lead to the discovery of admissible evidence." The objecting party, Apple, has the burden to produce evidence supporting its objections. *S.E.C. v. Brady*, 238 F.R.D. 429, 436 (N.D. Tex. 2006).

DISCOVERY AS TO FUNCTIONALITY AND DISTINCTIVENESS

Both of the pending Applications asserted by Apple in this proceeding state that "the mark consists of a simplified drawing of a mobile digital electronic communication device." Furthermore, Apple has designated the drawings shown in the Applications as "Opposer's iPhone Mark" and "Opposer's iPad Mark," respectively, in Interrogatory Nos. 13 and 14 of Opposer's First Set of Interrogatories. **See Exhibit B**. These drawings also appear in several registrations asserted by Apple.

HPDC's discovery seeks information relating to the utilitarian nature and functional aspects and advantages of the devices and specific product features depicted in the simplified drawings Apple is seeking to register as trademarks. Apple employs these features in its iPad tablets and iPhone smartphones, and it is clear that Apple intends the alleged marks to be representations of these products. It is HPDC's contention that the drawings in the Applications depict nothing more than purely functional features, and a common design, and thus are not entitled to trademark protection. There are only so many basic shapes that can be used for a tablet or smartphone, and one company cannot monopolize a drawing that consists of these shapes and essentially nothing else.

To begin with, a picture of a product is incapable of protection as a trademark when it is merely the graphic equivalent of a purely generic, functional or utilitarian device. The Board recognized this in *Textron, Inc. v. Pilling Chain Co., Inc.* 175 USPQ 621 (TTAB 1972), in which Textron, a zipper manufacturer, opposed a competitor's attempt to register a mark for sliders for zipper fasteners that contained an image of a zipper as a dominant feature of the mark. Textron used the similar configuration on tags attached to clothing that incorporated Textron's zippers. The Board rejected the application, stating that

“[i]t is well-established precedent that one may not claim a right to registration in the configuration or illustration of a purely functional item [A]pplicant...has failed to consider that registration on the Principal Register, without an effective disclaimer, would give it *prima facie* rights by which it could theoretically exclude opposer and other zipper manufacturers from illustrating their products on their goods or in their advertising. Opposer, as a manufacturer of zippers, has the right to use an illustration of its zippers to describe the contents of its packages....”

Almost 10 years later, the Board again addressed the issue of an application for a graphic design depicting a representation of a product in *In re Lighting Systems, Inc.*, 212 USPQ 313 (TTAB 1981). Lighting Systems, Inc. (“LSI”) sought to register a drawing of a flashlight,

claiming its particular drawing was distinctive. The Examiner rejected the application, finding that it was a non-distinctive configuration of a functional container which houses batteries and lighting elements. LSI appealed and after a review of the record, the Board found that

“there are only so many basic shapes which may be utilized for portable electric lights....In this case, applicant has used a three-dimensional rectangular container as the housing for the lights and batteries. This commonly shaped container with transparent surfaces at the sides and end permit light to be emitted from the container. It is our opinion that the design or configuration of applicant’s light ... is essentially functional or utilitarian in character and purpose and therefore not capable of distinguishing applicant’s goods from those of others.”

The Board also quoted at length from *In re Water Gremlin Co.*, 208 USPQ 89, 90-91 (TTAB 1980), in which the Board discussed the “overriding public policy” of free competition and preventing competitors from foreclosing the market through the registration of trademarks that use only “commonplace design” or “essentially functional features.”

Furthermore, it is well-settled that a mark that combines descriptive words is generally not registrable unless the composite creates a unitary mark with a unique, non-descriptive meaning or commercial impression. *See In re Tower Tech, Inc.*, 64 USPQ2d 1314 (TTAB 2002) The same is true for drawings or graphic designs, as the Board has repeatedly held that graphic marks can be challenged based on genericness and lack of distinctiveness. *See, e.g. Sunrise Jewelry Manufacturing Corp. v. Fred S.A.*, 50 USPQ2d 1532 (Fed. Cir. 1999); *see also* McCarthy, Thomas J., MCCARTHY ON TRADEMARKS, § 7:37 2011).

Under the circumstances, HPDC’s requests are plainly within the scope of allowable discovery. Apple seeks to register simplified drawings of mobile devices as trademarks, and HP has challenged the validity of these marks on the basis of functionality and lack of distinctiveness. As such, HPDC is entitled to conduct discovery as to the functional attributes of the devices and features displayed in these drawings, which includes discovery as to the

functional attributes of these features on actual devices that are similar or identical in appearance. This clearly includes the iPhone and iPad, to which Apple has expressly indicated its drawings correspond.

Beyond the question of fundamental validity, the functionality of features displayed in the Apple's simplified drawings impacts distinctiveness and strength, both of which are relevant to a determination of likelihood of confusion. A simplified drawing of a functional feature does not have the same capacity to distinguish goods as does ornamental subject matter, and consumers presented with a simplified drawing of a purely functional device are less likely to associate the drawing with source than consumers presented with a simplified drawing of an arbitrary or partially arbitrary device. Thus, functionality is squarely in issue, and HPDC is entitled to responses to its discovery requests.

In declining to respond to HPDC's discovery requests as to functionality, Apple relies on the Board's non-precedential decision on Samsung Electronics Co., Ltd's Motion to Suspend in *Acer, Inc., et al v. Apple, Inc.*, Opposition No. 91198009. **See Exhibit C.** The matter before the Board in that decision was not a discovery matter; rather, it involved Samsung's request that the Board suspend the consolidated Opposition to the Applications during the pendency of a federal lawsuit. The Board denied Samsung's motion based primarily on the fact that the applications at issue in the Opposition were not at issue in the federal lawsuit. The *dicta* cited by Apple addresses an argument by Samsung that Apple's common law trade dress claim could impact the Opposition proceedings. This is not relevant at all to the pending discovery in this opposition.

DISCOVERY AS TO THIRD-PARTY USE OF ELEMENTS OF APPLE'S ASSERTED MARKS

HPDC also propounded discovery regarding third-party prior and concurrent use of devices and features similar to those depicted in Apple's simplified drawings, including rectangular shaped screens, rounded corners, and circular buttons. Apple refused to produce documents and answer requests for admissions on these subjects.

This information is clearly relevant because if Apple's simplified drawings merely represent a design that is common in the industry, the purported marks would be unregistrable as generic, or merely descriptive with no proof of secondary meaning. At a minimum, evidence of widespread third-party use tends to show weakness of the purported marks and would reduce any potential for confusion. Likewise, prior or concurrent industry-wide use of the individual features of Apple's simplified drawings also bears on weakness of the marks, and potential for confusion.

This is plainly relevant and discoverable information in a 2(d) opposition. In *Armstrong Cork Co. v. World Carpets, Inc.*, 597 F.2d 496 (5th Cir. 1979), *cert denied* 444 US 932, the court found that 85 other companies' use of WORLD in the carpet business weighed against a strong mark. *See also General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622 (8th Cir. 1987)(evidence of third party usage of similar marks and similar goods admissible to show mark weak and worthy of only limited protection). Because the information sought is relevant or likely to lead to the discovery of admissible evidence, the discovery requested is appropriate.

DISCOVERY ON IP APPLICATION DEVELOPMENT COMPANY

HPDC propounded three requests for production (Nos. 26-28) and four requests for admission (Nos. 1-4) inquiring about issues relating to IPAD-LLC's pending intent-to-use

application that pre-dates Apple's asserted rights in various registrations that contain the word IPAD. Apple objected to this discovery on the basis of purported overbreadth, burden and relevance.

In responding to HPDC regarding the basis for its objections, Apple asserted that HPDC's request did not seek relevant information because Apple had not asserted claims based on any applications filed by IPAD-LLC. This misses the point. The issue is whether a third party owns or claims to own any marks, or dominant portions of marks, that Apple is asserting in this Opposition. The discovery rules are broadly drafted so as to allow discovery of information that is reasonably calculated to lead to the discovery of admissible evidence. Fed. R. Civ. P. 26(b)(1). In this case, if a third party has prior rights in a dominant element of the marks upon which Apple relies in this Opposition, it could weigh against Apple's claim of a likelihood of consumer confusion and could also demonstrate that the registrations upon which Apple relies are subject to challenge.

OVERBREADTH AND UNDUE BURDEN OBJECTIONS

Apple also objected to the foregoing discovery requests based on overbreadth and undue burden. However, it is well-accepted that the party resisting discovery "must show specifically how each [request] is not relevant or how each question is overly broad, burdensome or oppressive." *McLeod, Alexander, Powel & Apffel, P.C. v. Quarles*, 894 F.2d 1482, 1485 (5th Cir.1990) (holding that objections to document requests on the grounds that they were "overly broad, burdensome, oppressive, and irrelevant" were insufficient). "The burden is on the party who opposes its opponent's request for production to show specifically how each [request] is not relevant or how each [request] is overly broad, burdensome or oppressive." *S.E.C. v. Brady*, 238 F.R.D. at 436. In order to satisfy its burden, the objecting party must make a specific, detailed

showing of how the request is burdensome. *Id.* at 437.

Despite HPDC's specific request for an explanation of how its discovery was overly broad or unduly burdensome, Apple stood on its objections without providing an explanation. Apple cannot provide a plausible explanation because HPDC's discovery is relevant and narrowly drafted to address the relevant issues. Accordingly, HPDC requests that the Board overrule Apple's objections and order Apple to respond in full to HPDC's requests.

CONCLUSION

In conclusion, Apple has wholly failed to cooperate in discovery. Instead, Apple has asserted numerous, unsupported objections; has failed to produce any documents; and has failed to answer requests for admission based on wholly unexplained objections as to burden and breadth. In fact, Apple refuses to produce precisely the information HPDC requires for its defense, namely information that tends to show that the Applications feature a purely functional and commonplace design, and information that tends to show that IPAD is owned by a third party. Accordingly, HPDC requests that the Board overrule Apple's objections and order Apple to produce the requested documents and to properly answer the requests for admission.

RICHARD LAW GROUP

/s/ Elizann Carroll

James F. Struthers
Elizann Carroll
Molly Buck Richard
Richard Law Group
8411 Preston Road, Suite 890
Dallas, TX 75227
214-206-4301
214-206-4330 (fax)

ATTORNEYS FOR APPLICANT

CERTIFICATE OF CONFERENCE

This is to certify that the undersigned conferred in good faith with counsel for Apple. The parties exchanged detailed correspondence setting out their respective positions and were unable to resolve their differences. Accordingly, HPDC files this Motion to Compel.

/s/ Elizann Carroll
ELIZANN CARROLL

CERTIFICATE OF SERVICE

I certify that on August 10, 2012, a true and correct copy of this Motion to Compel Production of Documents and TO Determine the Sufficiency of Objections and Answers to Requests for Admission was served on Glenn Gundersen and Christine Hernandez, Dechert LLP, via email to glenn.gundersen@dechert.com, christine.hernandez@dechert.com and trademarks@dechert.com, by agreement of the parties.

/s/ Elizann Carroll
ELIZANN CARROLL

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

In re Applications of Hewlett-Packard Development Company, L.P.



Mark:

Serial No.: 85/316,016

Published in the Official Gazette of October 18, 2011



Mark:

Serial No.: 85/315,978

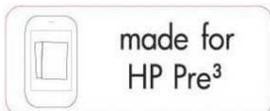
Published in the Official Gazette of October 18, 2011



Mark:

Serial No.: 85/315,880

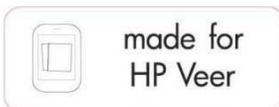
Published in the Official Gazette of October 25, 2011



Mark:

Serial No.: 85/315,996

Published in the Official Gazette of October 25, 2011



Mark:

Serial No.: 85/315,959

Published in the Official Gazette of October 25, 2011





Mark:
 Serial No.: 85/315,933
 Published in the Official Gazette of October 25, 2011

APPLE INC.	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No. 91203865
	:	
HEWLETT-PACKARD DEVELOPMENT	:	
COMPANY, L.P.	:	
	:	
Applicant.	:	

OPPOSER’S RESPONSES AND OBJECTIONS TO APPLICANT’S FIRST REQUESTS FOR PRODUCTION

Pursuant to Rule 2.120 of the Trademark Rules of Practice and Rule 34 of the Federal Rules of Civil Procedure, Opposer Apple Inc., by its attorneys, hereby submits these first amended responses and objections to Applicant’s First Requests for Production. The responses are limited to information available to Opposer at the present time and are provided without prejudice to its right to present additional or alternative information later in this proceeding.

GENERAL OBJECTIONS

Opposer objects to Applicant’s Instructions and Definitions and to each of these Requests to the extent they exceed the requirements of the Trademark Rules of Practice and the Federal Rules of Civil Procedure, and to the extent that they seek information protected by the attorney-client privilege, the work product doctrine, or other legally recognized privileges and obligations.

In providing these responses to Applicant's Requests for Production, Opposer does not waive or intend to waive:

- * objections as to competency, relevance, materiality or admissibility;
- * rights to object on any ground to the use of any of the responses contained herein in this or any subsequent proceeding;
- * objections as to vagueness or ambiguity; or
- * rights to object on the same or other grounds to these or any further discovery requests in this proceeding.

Opposer further objects to Applicant's Definition No. 1 as vague, ambiguous, overly broad, unduly burdensome, and exceeding the requirements of the Trademark Rules of Practice and the Federal Rules of Civil Procedure, insofar as it requires Opposer to identify entities "purporting to act on behalf of Apple Inc."

The foregoing General Objections are hereby incorporated into Opposer's responses to each of the Requests set forth below and are not waived by any of Opposer's individual responses.

RESPONSES

REQUEST FOR PRODUCTION NO. 3: Documents sufficient to show when Opposer's first iPhone-branded product was created and who participated in its external design.

RESPONSE:

Opposer objects to this Request on the grounds that it is overly broad, unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence.

REQUEST FOR PRODUCTION NO. 4: Documents sufficient to show when Opposer's first iPad-branded product was created and who participated in its external design.

RESPONSE:

Opposer objects to this Request on the grounds that it is overly broad, unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence.

REQUEST FOR PRODUCTION NO. 14: All unlicensed third-party packaging and advertisements that employ a rounded rectangle as a trademark, graphic element, or portion of a trademark or graphic element, for Opposer's Identified Goods.

RESPONSE:

Opposer objects to this Request on the grounds that it is vague and ambiguous, overly broad, unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence.

REQUEST FOR PRODUCTION NO. 15: Specimens or photographs of all Opposer's products that have curved external corners.

RESPONSE:

Opposer objects to this Request on the grounds that it is overly broad, unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence.

REQUEST FOR PRODUCTION NO. 16: Specimens or photographs of all Opposer's products that have a round button.

RESPONSE:

Opposer objects to this Request on the grounds that it is overly broad, unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence.

REQUEST FOR PRODUCTION NO. 17: Specimens or photographs of all Opposer's products that have a rectangular screen.

RESPONSE:

Opposer objects to this Request on the grounds that it is overly broad, unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence.

REQUEST FOR PRODUCTION NO. 18: All documents that refer or relate to any purpose, advantage or user preference for curved (as opposed to other shapes) external corners on Opposer's Identified Goods.

RESPONSE:

Opposer objects to this Request on the grounds that it is vague and ambiguous, overly broad, unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence.

REQUEST FOR PRODUCTION NO. 19: All documents that refer or relate to any purpose, advantage or user preference for round (as opposed to other shapes) buttons on Opposer's Identified Goods.

RESPONSE:

Opposer objects to this Request on the grounds that it is vague and ambiguous, overly broad, unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence.

REQUEST FOR PRODUCTION NO. 20: All documents that refer or relate to any purpose, advantage or user preference for rectangular (as opposed to other shapes) screens on Opposer's Identified Goods.

RESPONSE:

Opposer objects to this Request on the grounds that it is vague and ambiguous, overly broad, unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence.

REQUEST FOR PRODUCTION NO. 21: All documents that refer or relate to use by Opposer, or others, of screens that are not substantially rectangular, in conjunction with Opposer's Identified Goods.

RESPONSE:

Opposer objects to this Request on the grounds that it is vague and ambiguous, overly broad, unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence.

REQUEST FOR PRODUCTION NO. 24: All documents evidencing third party use of design features that Opposer contends infringe its purported trade dress for the Apple iPhone.

RESPONSE:

Opposer objects to this Request on the grounds that it is overly broad, unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence.

REQUEST FOR PRODUCTION NO. 25: All documents evidencing third party use of design features that Opposer contends infringe its purported trade dress for the Apple iPad.

RESPONSE:

Opposer objects to this Request on the grounds that it is overly broad, unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence.

REQUEST FOR PRODUCTION NO. 26: Documents sufficient to establish the nature of Opposer's relationship with IP Application Development LLC, owner of U.S. Application No. 77/913,563 for the mark IPAD.

RESPONSE:

Opposer objects to this Request on the grounds that it is overly broad, unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the

discovery of admissible evidence.

REQUEST FOR PRODUCTION NO. 27: All documents that relate to IP Application Development Company LLC's intent to use the IPAD mark in the United States at the time U.S. Application No. 77/913,563 was filed.

RESPONSE:

Opposer objects to this Request on the grounds that it is overly broad, unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence.

REQUEST FOR PRODUCTION NO. 28: All trademark assignments and licenses between Opposer and IP Application Development Company LLC.

RESPONSE:

Opposer objects to this Request on the grounds that it is overly broad, unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence.

REQUEST FOR PRODUCTION NO. 29: All documents relating to Opposer's choice of curved external corners for the Apple iPhone over alternate designs.

RESPONSE:

Opposer objects to this Request on the grounds that it is overly broad, unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence.

REQUEST FOR PRODUCTION NO. 30: All documents relating to Opposer's choice of a rectangular screen for the Apple iPhone over alternate designs.

RESPONSE:

Opposer objects to this Request on the grounds that it is overly broad, unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the

discovery of admissible evidence.

REQUEST FOR PRODUCTION NO. 31: All documents relating to Opposer's choice of a round button for the Apple iPhone over alternate designs.

RESPONSE:

Opposer objects to this Request on the grounds that it is overly broad, unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence.

REQUEST FOR PRODUCTION NO. 32: All documents relating to Opposer's choice of curved external corners for the Apple iPad over alternate designs.

RESPONSE:

Opposer objects to this Request on the grounds that it is overly broad, unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence.

REQUEST FOR PRODUCTION NO. 33: All documents relating to Opposer's choice of a rectangular screen for the Apple iPad over alternate designs.

RESPONSE:

Opposer objects to this Request on the grounds that it is overly broad, unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence.

REQUEST FOR PRODUCTION NO. 34: All documents relating to Opposer's choice of a round button for the Apple iPad over alternate designs.

RESPONSE:

Opposer objects to this Request on the grounds that it is overly broad, unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence.

REQUEST FOR PRODUCTION NO. 35: All documents evidencing studies or research done by or for Opposer on external design for the Apple iPhone, including but not limited to documents reflecting customer preferences or customer complaints about handheld device designs.

RESPONSE:

Opposer objects to this Request on the grounds that it is vague and ambiguous, overly broad, unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence.

REQUEST FOR PRODUCTION NO. 36: All documents evidencing studies or research done by or for Opposer on external design for the Apple iPad, including but not limited to documents reflecting customer preferences or customer complaints about handheld device designs.

RESPONSE:

Opposer objects to this Request on the grounds that it is vague and ambiguous, overly broad, unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence.

Date: June 29, 2012

By: /Christine M. Hernandez/
Glenn A. Gundersen
Christine M. Hernandez
Dechert LLP
Cira Centre, 2929 Arch Street
Philadelphia, PA 19104-2808
Telephone: 215-994-2183

Attorneys for Opposer
APPLE INC.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of Opposer's Responses and Objections to Applicant's First Requests for Production is being sent by e-mail to James F. Struthers at jim@richardlawgroup.com, as agreed by the parties, on June 29, 2012.

/Christine M. Hernandez/
Christine M. Hernandez

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

In re Applications of Hewlett-Packard Development Company, L.P.



Mark:

Serial No.: 85/316,016

Published in the Official Gazette of October 18, 2011



Mark:

Serial No.: 85/315,978

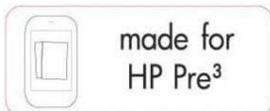
Published in the Official Gazette of October 18, 2011



Mark:

Serial No.: 85/315,880

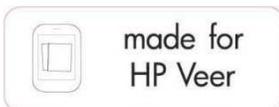
Published in the Official Gazette of October 25, 2011



Mark:

Serial No.: 85/315,996

Published in the Official Gazette of October 25, 2011



Mark:

Serial No.: 85/315,959

Published in the Official Gazette of October 25, 2011



Mark:
 Serial No.: 85/315,933
 Published in the Official Gazette of October 25, 2011

APPLE INC.	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No. 91203865
	:	
HEWLETT-PACKARD DEVELOPMENT	:	
COMPANY, L.P.	:	
	:	
Applicant.	:	

OPPOSER’S RESPONSES AND OBJECTIONS TO APPLICANT’S FIRST REQUESTS FOR ADMISSION

Pursuant to Rule 2.120 of the Trademark Rules of Practice and Rule 36 of the Federal Rules of Civil Procedure, Opposer Apple Inc., by its attorneys, hereby submits these responses and objections to Applicant’s First Requests for Admission. The responses are limited to information available to Opposer at the present time and are provided without prejudice to its right to present additional or alternative information later in this proceeding.

GENERAL OBJECTIONS

Opposer hereby incorporates its Objections to the Definitions set forth in Applicant’s First Requests for Production, served herewith, as if fully set forth herein. Opposer objects to Applicant’s Instructions and Definitions and to each of these Requests to the extent they exceed the requirements of the Trademark Rules of Practice and the Federal Rules of Civil Procedure,

and to the extent that they seek information protected by the attorney-client privilege, the work product doctrine, or other legally recognized privileges and obligations.

In providing these responses to Applicant's First Requests for Admissions, Opposer does not waive or intend to waive:

- * objections as to competency, relevance, materiality or admissibility;
- * rights to object on any ground to the use of any of the responses contained herein in this or any subsequent proceeding;
- * objections as to vagueness or ambiguity; or
- * rights to object on the same or other grounds to these or any further discovery requests in this proceeding.

The foregoing General Objections are hereby incorporated into Opposer's responses to each of the Requests set forth below and are not waived by any of Opposer's individual responses.

RESPONSES

REQUEST FOR ADMISSION NO. 1: Admit that Opposer is not a licensee of IP Application Development Company LLC.

RESPONSE:

Opposer objects to this Request on the grounds that it is overly broad and unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. Based on the foregoing objections, Opposer is unable to admit or deny the Request, and on that basis denies it.

REQUEST FOR ADMISSION NO. 2: Admit that on May 30, 2012, there was no written trademark license agreement between IP Application Development Company LLC and Opposer.

RESPONSE:

Opposer objects to this Request on the grounds that it is overly broad and unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. Based on the foregoing objections, Opposer is unable to admit or deny the Request, and on that basis denies it.

REQUEST FOR ADMISSION NO. 3: Admit that on January 16, 2010, there was no written trademark license agreement between IP Application Development Company LLC and Opposer.

RESPONSE:

Opposer objects to this Request on the grounds that it is overly broad and unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. Based on the foregoing objections, Opposer is unable to admit or deny the Request, and on that basis denies it.

REQUEST FOR ADMISSION NO. 4: Admit that Opposer was not a licensee of IP Application Development Company LLC on January 16, 2010.

RESPONSE:

Opposer objects to this Request on the grounds that it is overly broad and unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. Based on the foregoing objections, Opposer is unable to admit or deny the Request, and on that basis denies it.

REQUEST FOR ADMISSION NO. 6: Admit that Opposer did not conduct a trademark clearance on the first iPad's product configuration prior to introduction.

RESPONSE:

Opposer objects to this Request on the grounds that it is overly broad and unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. Based on the foregoing objections, Opposer is unable to admit or deny the Request, and on that basis denies it.

REQUEST FOR ADMISSION NO. 7: Admit that Opposer was not the first company to produce handheld electronic devices that have round buttons.

RESPONSE:

Opposer objects to this Request on the grounds that it is overly broad and unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. Based on the foregoing objections, Opposer is unable to admit or deny the Request, and on that basis denies it.

REQUEST FOR ADMISSION NO. 8: Admit that Opposer was not the first company to produce handheld electronic devices that have rectangular screens.

RESPONSE:

Opposer objects to this Request on the grounds that it is overly broad and unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. Based on the foregoing objections, Opposer is unable to admit or deny the Request, and on that basis denies it.

REQUEST FOR ADMISSION NO. 9: Admit that Opposer was not the first company to produce handheld electronic devices that have curved external corners.

RESPONSE:

Opposer objects to this Request on the grounds that it is overly broad and unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. Based on the foregoing objections, Opposer is unable to admit or deny the Request, and on that basis denies it.

REQUEST FOR ADMISSION NO. 10: Admit that Opposer was not the first company to produce handheld electronic devices that have round buttons, rectangular screens and curved external corners.

RESPONSE:

Opposer objects to this Request on the grounds that it is overly broad and unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. Based on the foregoing objections, Opposer is unable to admit or deny the Request, and on that basis denies it.

REQUEST FOR ADMISSION NO. 25: Admit that Opposer was not the first company to produce mobile phones that have round buttons.

RESPONSE:

Opposer objects to this Request on the grounds that it is overly broad and unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. Based on the foregoing objections, Opposer is unable to admit or deny the Request, and on that basis denies it.

REQUEST FOR ADMISSION NO. 26: Admit that Opposer was not the first company to produce mobile phones that have rectangular screens.

RESPONSE:

Opposer objects to this Request on the grounds that it is overly broad and unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. Based on the foregoing objections, Opposer is unable to admit or deny the Request, and on that basis denies it.

REQUEST FOR ADMISSION NO. 27: Admit that Opposer was not the first company to produce mobile phones that have curved external corners.

RESPONSE:

Opposer objects to this Request on the grounds that it is overly broad and unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. Based on the foregoing objections, Opposer is unable to admit or deny the Request, and on that basis denies it.

REQUEST FOR ADMISSION NO. 28: Admit that Opposer was not the first company to produce handheld cellular telephones that have round buttons, rectangular screens and curved external corners.

RESPONSE:

Opposer objects to this Request on the grounds that it is overly broad and unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the

discovery of admissible evidence. Based on the foregoing objections, Opposer is unable to admit or deny the Request, and on that basis denies it.

REQUEST FOR ADMISSION NO. 29: Admit that Opposer was not the first company to produce tablet computers that have round buttons.

RESPONSE:

Opposer objects to this Request on the grounds that it is overly broad and unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. Based on the foregoing objections, Opposer is unable to admit or deny the Request, and on that basis denies it.

REQUEST FOR ADMISSION NO. 30: Admit that Opposer was not the first company to produce tablet computers that have rectangular screens.

RESPONSE:

Opposer objects to this Request on the grounds that it is overly broad and unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. Based on the foregoing objections, Opposer is unable to admit or deny the Request, and on that basis denies it.

REQUEST FOR ADMISSION NO. 31: Admit that Opposer was not the first company to produce tablet computers that have curved external corners.

RESPONSE:

Opposer objects to this Request on the grounds that it is overly broad and unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. Based on the foregoing objections, Opposer is unable to admit or deny the Request, and on that basis denies it.

REQUEST FOR ADMISSION NO. 32: Admit that Opposer was not the first company to produce tablet computers that have round buttons, rectangular screens and curved external corners.

RESPONSE:

Opposer objects to this Request on the grounds that it is overly broad and unduly burdensome and seeks information neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. Based on the foregoing objections, Opposer is unable to admit or deny the Request, and on that basis denies it.

Date: June 29, 2012

By: /Christine M. Hernandez/
Glenn A. Gundersen
Christine M. Hernandez
Dechert LLP
Cira Centre, 2929 Arch Street
Philadelphia, PA 19104-2808
Telephone: 215-994-2183

Attorneys for Opposer
APPLE INC.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of Opposer's Responses and Objections to Applicant's First Requests for Admission is being sent by e-mail to James F. Struthers at jim@richardlawgroup.com, as agreed by the parties, on June 29, 2012.

/Christine M. Hernandez/
Christine M. Hernandez

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

In re Applications of Hewlett-Packard Development Company, L.P.



Mark:

Serial No.: 85/316,016

Published in the Official Gazette of October 18, 2011



Mark:

Serial No.: 85/315,978

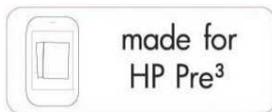
Published in the Official Gazette of October 18, 2011



Mark:

Serial No.: 85/315,880

Published in the Official Gazette of October 25, 2011



Mark:

Serial No.: 85/315,996

Published in the Official Gazette of October 25, 2011



Mark:

Serial No.: 85/315,959

Published in the Official Gazette of October 25, 2011



claim of privilege, attorney work product, or otherwise, Applicant is instructed to identify (1) the nature of the document (e.g., letter, fax, email, etc.) and the subject matter discussed therein; (2) the name of each author, maker or sender of the document; (3) the name of each addressee or recipient of the document and, if the document is an agreement, the names of the parties to the agreement; (4) the date that appears on the document, or if undated, the date the document was prepared; (5) the number of pages comprising the document; (6) the present location of the document; (7) the name, job title, employer and address of the custodian of the document; and (8) the basis for any claim of privilege that the document is withheld.

These Interrogatories are continuing. If Applicant discovers or locates any information that was not or could not be produced for the reasons discussed above, or for any other reason, or, if Applicant discovers any additional information that is covered by any of these Interrogatories, Applicant should immediately notify Opposer's counsel and supplement its responses to these Interrogatories.

DEFINITIONS

The following definitions are applicable to terms employed in these Interrogatories, in the Instructions accompanying these Interrogatories and in these Definitions.

A. The term "person" refers to natural persons, organizations, associations, partnerships, joint ventures, corporations and other legal entities, and the actions taken by a person include the actions of his or her or its partners, employees, agents, representatives, consultants, independent contractors, attorneys, or accountants acting on the person's behalf.

B. The words "and" and "or" shall be construed in both the conjunctive and disjunctive.

C. Any word that is used in the singular shall be construed to include the plural and vice versa.

D. The word “all” means “any and all,” the word “any” means “any and all.”

E. The terms “refer” and “relate” and “reference” mean directly or indirectly mentioning, discussing, describing, pertaining to or connected with, a stated subject matter.

F. The term “document” is used in its customary broad sense and encompasses, without limitation, all handwritten, typed, printed or otherwise visually or aurally reproduced materials, whether copies, drafts or originals, and irrespective of whether they are privileged against discovery on any ground, or within the possession, custody or control of Applicant, or its employees, agents, representatives, consultants, independent contractors, attorneys, or accountants, including but not limited to: letters, correspondence, cables, wires, facsimiles, telegrams, notes, memoranda, diaries, e-mails and other electronic messages, notes or records of telephone conversations, notes or records of personal conversations or interviews, interoffice and intraoffice communications of all types, drawings, plans, sketches, charts, notebooks, data, photographs, movies and recordings, books, catalogs, labels, packaging, containers, tags, advertisements, promotional materials, storyboards, press releases, reports, studies, questionnaires, assignments, agreements and other official papers and legal instruments, management reports, project reports, and minutes and reports of meetings, lists of persons attending meetings, bills, invoices, orders, books, records, files, published material of any kind, and microfilms of documents that may have been destroyed.

Any copy of a document containing or having attached to it any alterations, notes, comments or other material not included in the original document shall be deemed a separate

document.

G. “Identify,” as used with respect to a date means to provide the relevant month, day, and year.

H. “Identify,” as used with respect to products, means to describe the products briefly and to describe their intended use.

I. The term “Applicant” refers to Hewlett-Packard Development Company, L.P. as well as its directors, officers, employees, agents, attorneys, consultants, independent contractors and representatives. It also refers to all Affiliated Companies as well as the directors, officers, employees, agents, attorneys, consultants and representatives of such Affiliated Companies. Where use of a Mark is concerned, “Applicant” also means all of Applicant’s past and present licensees and all others who use, have used, or intend to use such Mark with Applicant’s consent or under Applicant’s control or authority.

J. The term “Affiliated Companies” means all companies, organizations, partnerships, and other legal entities that are wholly or partly owned or controlled by Hewlett-Packard Development Company, L.P. either directly or indirectly.

K. The term “Mark” means all forms of trademarks and trade names, including without limitation service marks, fictitious names, corporate and business names, logos, designs, trade dress and devices.

L. The term “Applicant’s Marks” refers to the marks identified in Application Serial Nos. 85/316,016, 85/315,978, 85/315,880, 85/315,996, 85/315,959, and 85/315,933.

M. The term “Opposer’s Marks” refers to the marks identified in Registration Nos. 3,341,286 and 3,818,792 and Application Serial Nos. 85/025,627, 85/025,637, 85/028,983,

85/028,975, 85/028,997, 85/029,010, 85/040,770, and 85/025,647.

N. The term “use” means the definition for “use in commerce” given in Section 45 of the Trademark Act of 1946 (15 U.S.C. § 1127).

INTERROGATORY NO. 13

Describe in detail all products that you contend share a “common design” with the mark shown in Application Serial No. 85/040,770 (“Opposer’s iPhone Mark”), as stated in paragraph 3 of the Affirmative Defenses of Applicant’s Answer, and for each such product, identify with particularity those elements of the product that you contend to be in “common” with Opposer’s iPhone Mark.

INTERROGATORY NO. 14

Describe in detail all products that you contend share a “common design” with the mark shown in Application Serial No. 85/025,647 (“Opposer’s iPad Mark”), as stated in paragraph 6 of the Affirmative Defenses of Applicant’s Answer, and for each such product, identify with particularity those elements of the product that you contend to be in “common” with Opposer’s iPad Mark.

Date: June 8, 2012

By:

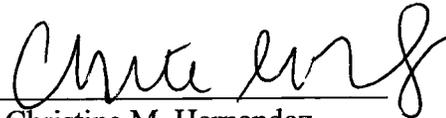


Glenn A. Gundersen
Christine M. Hernandez
Dechert LLP
Cira Centre, 2929 Arch Street
Philadelphia, PA 19104-2808
Telephone: 215-994-2183

Attorneys for Opposer
APPLE INC.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of Opposer's First Set of Interrogatories is being sent by e-mail to James F. Struthers at jim@richardlawgroup.com, as agreed by the parties, on June 8, 2012.



Christine M. Hernandez

CHRISTINE M. HERNANDEZ

christine.hernandez@dechert.com
+1 212 698 3627 Direct
+1 212 698 3599 Fax

July 30, 2012

VIA E-MAIL

Elizann Carroll
Richard Law Group
8411 Preston Road
Suite 890
Dallas Texas, 75225

Re: *Apple Inc. v. Hewlett-Packard Development Company, L.P.*, Opp. No. 91203865

Dear Elizann:

I write in response to your July 11 letter concerning Apple's discovery responses.

The vast majority of Applicant's requests seek discovery on the product configuration of Apple's iPhone and iPad devices and various design elements of mobile phones, tablet computers and handheld electronic devices. The marks that Apple has asserted in its Notice of Opposition in this proceeding are two-dimensional logotypes, not product configurations, and the Notice of Opposition does not assert that Applicant's marks cause confusion with the trade dress of any Apple products.

The Board has already noted the distinction between Apple's two-dimensional logotypes and its three-dimensional product configurations. In *Acer Inc. et al v. Apple Inc.*, Opposition No. 91198009, Opposer Samsung Electronics Co., Ltd. ("Samsung") sought to suspend the proceeding pending the resolution of the federal court litigation between Samsung and Apple. As you surely know, that litigation concerns whether the design of Samsung's devices infringes Apple's trademark, trade dress and design patent rights. In denying Samsung's motion, the Board recognized that Apple's marks shown in Serial Nos. 85/040, 770 and 85/025,647 are "two-dimensional simplified drawings and/or logos of [Apple's] smart phone and computer tablet products . . . used or intended to be used in association with accessories for applicant's smart phones and computer tablets and not for the electronic devices themselves." Dkt. No. 22 at 7. The Board further found that whether a product configuration is functional, nondistinctive or generic is irrelevant to whether a two-dimensional logo is protectable:



[E]ven assuming *arguendo*, that the district court finds that applicant's pleaded marks are functional, nondistinctive trade dress and/or generic configurations of applicant's smart phones and/or computer tablets, such a finding would not be determinative or have a bearing on whether applicant's marks involved herein, which are used or intended to be used in association with accessories for applicant's smart phone and/or computer tablets and not for the electronic devices themselves, are functional, nondistinctive configurations of one or more of applicant's goods or merely descriptive of the goods identified in applicant's subject applications.

Id. at 11. Thus, there is no basis for your contention that "information on the configuration and features of Apple's iPhone and iPad mobile digital electronic communication devices are directly related to the marks that are simplified drawings of those devices." Accordingly, Apple maintains its objections to Requests for Admission 5-10 and 25-32 and Requests for Production 15-25 and 29-36.

Requests for Admission 1-4 and Requests for Production 26-28 seek discovery concerning certain applications filed by IP Application Development LLC, which have not been asserted by Apple in this proceeding. Thus, Apple maintains its objections to the relevance of such requests. With respect to Request for Production 14, Apple maintains its objection that "packaging and advertisements that employ a rounded rectangle as a trademark" is vague and overbroad, as is the term "graphic element", but Apple agrees to conduct a reasonable search and produce non-privileged documents in its possession, custody or control, to the extent that any such documents exist, with respect to trademarks that employ a rounded rectangle. Finally, with respect to Applicant's complaints regarding Opposer's General Objections, we note that Applicant too asserted similar objections. *See, e.g.*, Applicant's statement that "HPDC will respond to these Interrogatories as required by the Federal Rules of Civil Procedure and objects to any attempts by Opposer to broaden or expand HPDC's obligations." Nevertheless, pursuant to your request, we clarify that in accordance with Apple's objection to Applicant's Definition No. 1, in each response Apple has not construed the terms "Opposer", "you" or "your" to include entities "purporting to act on behalf of Apple," but has not otherwise relied on any general objections in its responses to specific requests.

We are in the process of preparing the first installment of Apple's production, on DVDs in PDF format, and will send to you shortly. Please contact me if you wish to discuss any of the foregoing.

Sincerely,

A handwritten signature in black ink, appearing to read "Christine M. Hernandez". The signature is fluid and cursive, with a large loop at the end.

Christine M. Hernandez