

ESTTA Tracking number: **ESTTA567452**

Filing date: **10/28/2013**

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

Proceeding	91204122
Party	Plaintiff Empire State Building Company L.L.C.
Correspondence Address	MAYA L TARR COWAN LIEBOWITZ LATMAN PC 1133 AVENUE OF THE AMERICAS NEW YORK, NY 10036 UNITED STATES mxt@cll.com, wmb@cll.com, trademark@cll.com, fxm@cll.com, mlk@cll.com
Submission	Opposition/Response to Motion
Filer's Name	Maya L. Tarr
Filer's e-mail	mxt@cll.com, wmb@cll.com, trademark@cll.com, fxm@cll.com, mlk@cll.com, ejs@cll.com
Signature	/Maya L. Tarr/
Date	10/28/2013
Attachments	Opposition to Reopen Discovery w Declaration and Exhibits.pdf(1862367 bytes)

favor of Opposer. Opposer filed its motion for sanctions based on Applicant's consistent failure to comply with the Board's rules and order concerning discovery. Weeks prior to the time Applicant filed the instant motion to reopen the discovery period, the Board specifically suspended the proceedings and ordered that *it would not accept any papers unrelated to the previously filed motion for sanctions*. Applicant did not file a response in opposition to Opposer's motion for sanctions, and that prior motion should be granted as conceded. *See* 37 C.F.R. § 2.127(a). The Board thus should disregard the instant motion to reopen the discovery period as (1) moot in light of the conceded motion for sanctions *and* (2) improperly filed contrary to the Board's suspension order.

Second, even if the Board does consider the instant motion to reopen the discovery period, which ended *over eight months ago*, Applicant has failed to show excusable neglect. Applicant's counsel alleges that he was dealing with "extraordinary and unusual personal matters," which began on some unspecified date after June 26, 2012, the date the Board suspended the proceedings for thirty days on consent of the parties. However, Applicant's counsel has omitted from his moving papers *any details* concerning these purported "personal matters," including when they ended. Instead, Applicant's counsel claims that he has submitted such details *confidentially and ex parte to the Board* in a separate letter. Not only is this *ex parte* communication wholly improper, but it severely has prejudiced Opposer's ability to respond to the unknown arguments made therein. Thus, the Board should disregard any *ex parte* communications from Applicant's counsel and deny the instant motion based on the papers *that were served on Opposer, which do not provide any excuse for delay*.

Nonetheless, any details concerning the purported "personal matters" Applicant's counsel has disclosed secretly to the Board would be insufficient to show excusable neglect. Despite

these purported “personal matters,” which allegedly spanned a time period of a year and a half, Applicant’s counsel was able to: (1) communicate with Opposer’s counsel on several occasions concerning a request for an extension of time to respond to Opposer’s discovery requests, settlement negotiations and the waiver of initial disclosures and (2) submit lengthy responses to Opposer’s discovery requests (although untimely and deficient) after the Board issued an order compelling such responses. Yet, Applicant’s counsel did not once seek to extend or reopen the discovery period during this time. Applicant’s counsel’s own decision to focus on other matters in this opposition—and not to seek to reopen the discovery period until now—completely undermines his claim of excusable neglect.

Moreover, although Applicant has couched the instant motion as one seeking to “reopen discovery,” his moving papers claim that Opposer’s previously filed motion for sanctions, to which Applicant did not submit a timely response, “*is without any merit.*” It is clear that Applicant *improperly* is using the instant motion as *an untimely response* in opposition to Opposer’s motion for sanctions, which shows Applicant’s continued bad faith and disregard for the Board’s rules, orders and practices. For these reasons, and as set forth herein in greater detail, Applicant’s motion to reopen the discovery period should be denied.

STATEMENT OF FACTS¹

Opposer initiated this opposition proceeding by filing a Notice of Opposition on March 1, 2012, against Application Serial No. 85/213,453 filed by Applicant seeking to register on an intent-to-use basis the mark NYC BEER LAGER and Design shown below:



(“Applicant’s Mark”) for “Alcohol-free beers; Beer; Beer, ale and lager; Beer, ale and porter; Beer, ale, lager, stout and porter; Beer, ale, lager, stout, porter, shandy; Beers; Black beer; Brewed malt-based alcoholic beverage in the nature of a beer; Coffee-flavored beer; De-alcoholised beer; Extracts of hops for making beer; Flavored beers; Ginger beer; Hop extracts for manufacturing beer; Imitation beer; Malt beer; Malt extracts for making beer; Malt liquor; Non-alcoholic beer; Pale beer; Porter” in International Class 32. Borchard Decl. ¶ 2; Dkt.#1.

The Notice of Opposition alleged that registration of Applicant’s Mark was likely to result in confusion, falsely suggest a connection between Applicant and Opposer, and/or cause a likelihood of dilution by blurring of the distinctive quality of Opposer’s Empire State Building Marks, as defined in Paragraph 1 of the Notice of Opposition. Borchard Decl. ¶ 2; Dkt.#1.

¹ The facts upon which this motion is based are set forth in detail in the accompanying declaration of William M. Borchard (“Borchard Decl.”). Many of these facts already were submitted in support of Opposer’s motion for sanctions in the form of entry of judgment in favor of Opposer, *see* Dkt.#19, and are reiterated here for the Board’s convenience.

On June 26, 2012, the Board issued an order setting February 16, 2013, as the deadline for the close of the discovery period. Borchard Decl. ¶ 4 & Ex. A. Thereafter, in early September 2012, Applicant's counsel and Opposer's counsel participated in several communications via telephone and email concerning the waiver of initial disclosures and potential settlement of the opposition. *Id.* ¶ 5 & Ex. B (redacting settlement communications).

On September 19, 2012, the parties filed a consented Motion to Waive Initial Disclosures, which was noted by the Board on October 10, 2012. *Id.* ¶ 6 & Ex. C. In the Board's October 10, 2012, it reiterated the February 16, 2013, deadline for the close of the discovery period. *Id.*

At no time in September 2012 or during the discovery period, which ended February 16, 2013, did Applicant's counsel ask to suspend or extend the discovery period, or indicate in any manner that he believed he would be unable to comply with the Board's deadlines. *Id.* ¶ 7. Applicant did not serve discovery requests on Opposer, either during the discovery period or thereafter. *Id.* ¶ 8.

Prior to the close of the discovery period, Opposer served Applicant with Opposer's First Set of Interrogatories and Request for Production of Documents and Things and Opposer's First Set of Requests for Admissions by first class mail. *Id.* ¶ 9 and Ex. D. Applicant's responses to Opposer's discovery requests were due on March 26, 2013. *Id.*

On March 19, 2013, *after the close of the discovery period*, Applicant's counsel called Opposer's counsel to request a sixty extension of Applicant's deadline to respond to Opposer's discovery requests, to which Opposer consented. *Id.* ¶ 10. The parties also discussed potential settlement at that time and agreed to a ninety day extension of all other forthcoming dates in order to continue their discussions. *Id.* ¶ 11 & Ex. E (redacting settlement communications).

Contrary to Applicant's counsel's misrepresentation in his moving papers, *see* Mot. at 6; Yan Decl. ¶ 14, *Opposer did consent* to both the sixty day extension of Applicant's time to respond to Opposer's discovery requests and a ninety day extension of all other future dates. Borchard Decl. ¶ 12 & Ex. E. Indeed, Opposer's counsel confirmed the parties' agreement via email and filed the motion to extend with the Board, which was granted the same day. *Id.* ¶ 13 & Exs. E & F. At that time, Applicant's counsel did not claim either that he could not respond to Opposer's discovery requests within the extended sixty days, that he wanted to suspend the proceedings or that he wanted to reopen the discovery period. *Id.* ¶ 14.²

Applicant did not respond to Opposer's discovery requests by the extended deadline of May 25, 2013. Thus, on June 6, 2013, Opposer filed a motion to compel Applicant to respond to Opposer's interrogatories and document requests. Borchard Decl. ¶ 15; Dkt.#14. On August 6, 2013, the Board granted Opposer's motion and ordered Applicant to provide responses to Opposer's interrogatories and document requests within thirty days. Borchard Decl. ¶ 16 & Ex. G. The Board further ordered that any such responses must be made "*without objection on the merits.*" *Id.*

Applicant did not respond to Opposer's interrogatories and document requests within thirty days of the Board's order. *Id.* ¶ 17. Instead, after the deadline, Applicant's counsel sent to Opposer's counsel via first class mail purported responses to Opposer's interrogatories and document requests. *Id.* ¶ 17 & Ex. H. Despite the Board's explicit order that such responses should be served *without objection on the merits*, each and every one of Applicant's responses

² Although less than a model of clarity, Applicant's counsel's statements in his moving papers, *see* Mot. at 6; Yan Decl. ¶ 14, that Opposer's counsel refused to consent to "suspend" the proceedings in March 2013 may reveal some confusion on his part. Because the discovery deadline already had passed, a motion on consent to suspend at that time would not have reopened discovery.

objected to Opposer's discovery requests on several grounds other than privilege, including overbreadth and undue burden. *Id.* ¶ 18 & Ex. H. Applicant also failed to wholly respond to several interrogatory responses and did not sign the responses under oath. *Id.* Nor did Applicant produce one single document in response to Opposer's demands, including documents that would show Applicant's purported *bona fide* intent to use his mark. *Id.*³

Based on Applicant's consistent disregard for the Board's rules and violation of the Board's order compelling discovery, on September 11, 2013, Opposer moved the Board for an order granting sanctions against Applicant in the form of entry of judgment in favor of Opposer. *Id.* ¶ 20; Dkt.#19. On September 19, 2013, the Board suspended the proceedings pending determination of the motion for sanctions. Borchard Decl. ¶ 21 & Ex. J. In that order, the Board stated: "Any paper filed during the pendency of this motion which is not relevant thereto will be given no consideration." *Id.* (citing 37 C.F.R. § 2.127(d)).

Although Applicant's deadline to file papers in opposition to Opposer's motion for sanctions was September 23, 2013, at no time did Applicant file such papers. *Id.* ¶ 22. Instead, weeks later, on October 8, 2013, and in violation of the Board's order that no paper unrelated to Opposer's motion for sanctions should be filed with the Board, Applicant filed the instant motion seeking to reopen the discovery period, ***which closed over eight months ago***. *Id.* ¶ 23. Although Applicant filed the instant motion as one seeking to "reopen discovery," he asserts in his moving papers: "As set forth in detail herein, Applicant, *via his counsel*, submits to the Board that the

³ Applicant's counsel also served on Opposer's counsel a copy of Applicant's purported responses to the requests for admission via first class mail on September 6, 2013. *Id.* ¶ 19 & Ex. I. However, those request were deemed admitted by operation of law due to Applicant's failure to serve responses by the May 25, 2013, deadline.

Opposer’s Motion for Sanctions of Entry of Judgment and to Suspend *is without any merit* under the totality of the circumstances.” Mot. at 4 (emphasis added).

In his improperly filed motion, Applicant’s counsel alleges that, as of June 2012, he was dealing with “extraordinary and unusual personal matters,” which he claims excuses his delay. But Applicant’s counsel wholly fails to disclose in his papers filed with the Board and served on Opposer the nature of details of these purported “personal matters,” including when they allegedly ceased. *See* Mot. at p. 6; Yan Decl. ¶¶ 9, 10, 13, 16, 20. Instead, Applicant’s counsel indicates that he provided the nature and details of these purported “personal matters” in a private *ex parte* communication sent only to the Board. *See* Mot. at p. 6; Yan Decl. ¶ 10. Thus, Opposer is unaware of the nature of details of these purported “personal matters” that were disclosed to the Board *ex parte*. Borchard Decl. ¶ 26.

Nonetheless, during the time of these purported “personal matters,” Applicant’s counsel was able to communicate with Opposer’s counsel on several occasions (concerning settlement, the waiver of initial disclosures and other extensions) and submit responses to discovery requests (although untimely and deficient), yet never once asked to reopen the discovery period or indicated that he could not respond to Opposer’s discovery requests within the generously extended time period, or within the time period subsequently ordered by the Board. *Id.* ¶ 27.

ARGUMENT

THE BOARD SHOULD DENY APPLICANT’S MOTION TO REOPEN THE DISCOVERY PERIOD

A. APPLICANT’S MOTION IS MOOT AND PROCEDURALLY IMPROPER

Based on Applicant’s consistent failure to comply with his discovery obligations, including violating a direct order of the Board compelling such compliance, on September 11,

2013, Opposer moved the Board for an award of sanctions in the form of entry of judgment in favor of Opposer. On September 19, 2013, the Board issued an order *suspending the proceedings* pending disposition of that motion. In its order, the Board specifically stated: “Any paper filed during the pendency of this motion which is not relevant thereto **will be given no consideration.**” See Borchard Decl. Exh. J (citing 37 C.F.R. § 2.127(d)) (emphasis added).

Although Applicant’s deadline to file papers in opposition to Opposer’s motion for sanctions expired September 23, 2013, at no time did Applicant file such papers. Accordingly, **Opposer’s motion for sanctions should be granted as conceded.** See 37 C.F.R. § 2.127(a) (“When a party fails to file a brief in response to a motion, the Board may treat the motion as conceded”); T.B.M.P. § 502.04 (“If the nonmoving party has not given its consent to a motion, but does not file a brief in opposition thereto during the time allowed therefor, the Board, in its discretion, may grant the motion as conceded”); *Boston Chicken Inc. v. Boston Pizza International Inc.*, 53 U.S.P.Q.2d 1053, 1054 (T.T.A.B. 1999) (unopposed motion for summary judgment deemed conceded). In light of the conceded motion for sanctions, Applicant’s motion to reopen the discovery period should be denied as moot.

Moreover, contrary to the Board’s explicit order that no papers unrelated to the motion for sanctions should be filed during the suspension of the proceedings, on October 8, 2013, weeks after the deadline to oppose the motion for sanctions, Applicant filed the instant motion seeking for the first time to reopen the discovery period. As such, the instant motion was filed in violation of the Board’s order and should be denied as procedurally improper. See T.B.M.P. § 501.03(a); 37 C.F.R. § 2.127(d); *Guthy-Renker Corp. v. Boyd*, 88 U.S.P.Q.2d 1701, 1703 (T.T.A.B. 2008) (Board refused to consider cross motion to dismiss filed while proceedings were suspended pending resolution of motion for sanctions).

B. APPLICANT HAS FAILED TO SHOW EXCUSABLE NEGLIGENCE

In order to reopen the discovery period, *which closed over eight months ago*, Applicant must demonstrate *excusable neglect*. See T.B.M.P. § 509.01(b)(1); Fed. R. Civ. P. 6(b)(1)(B); *Dating DNA LLC v. Imagini Holdings Ltd.*, 94 U.S.P.Q.2d 1889, 1892 (T.T.A.B. 2010). The Board examines the following four factors when determining excusable neglect: (1) the danger of prejudice to the non-moving party; (2) the length of delay and its potential impact on judicial proceedings; (3) the reason for the delay, including whether it was within the reasonable control of the moving party; and, (4) whether the moving party has acted in good faith. See *Dating DNA*, 94 U.S.P.Q.2d at 1892 (citing *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership*, 507 U.S. 380, 395 (1993)). The third factor generally is the most important factor when determining whether excusable neglect exists. See *id.* Here, all four factors weigh strongly *against* a finding of *excusable neglect*.

1. Applicant Has Not Provided Any Reason for His Delay

In his moving papers, Applicant’s counsel claims his delay was caused by “extraordinary and unusual personal matters,” which began on some unspecified date shortly after June 26, 2012. However, Applicant’s counsel *wholly has omitted* from the papers he served on Opposer *any details* concerning these purported “personal matters,” including when they ended. Instead, Applicant’s counsel claims that he has submitted such details *confidentially and ex parte to the Board*. Applicant’s counsel has not cited any authority that permits a moving party to disclose its principle arguments on a motion to the Board *ex parte*, but *not* to the opposing party. Nor is Opposer aware of any such authority. To the contrary, Applicant’s counsel’s failure to disclose to Opposer the entire basis of Applicant’s purported excusable neglect is wholly improper.

Without any details concerning Applicant’s counsel purported “personal matters,” Opposer lacks the ability to respond to Applicant’s counsel’s claims in a meaningful way.

Opposer would be severely prejudiced if the Board gave credence to Applicant's motion under these circumstances. Thus, the Board should disregard Applicant's counsel *ex parte* communication regarding these "personal matters" and deny the instant motion based on the papers served on Opposer, ***which do not show any excuse for delay***. See, e.g., *Dating DNA*, 94 U.S.P.Q.2d at 1892 (no excusable neglect where moving party failed to provide excuse for delay); *HKG Industries Inc. v. Perma-Pipe Inc.*, 49 U.S.P.Q.2d 1156, 1158 (T.T.A.B. 1998) (no excusable neglect where moving party did not provide "critical factual information" about its purported excuse).

Nonetheless, regardless of the precise nature and substance of the confidential matters Applicant's counsel has disclosed to the Board *ex parte*, they would be insufficient to show excusable neglect. It is difficult to imagine any set of circumstances that would have made Applicant's counsel wholly unable—for a period expanding nearly a year and a half—to seek to extend or reopen the discovery period. To the contrary, despite his purported "personal matters," Applicant's counsel was able to communicate with Opposer's counsel on several occasions concerning other aspects of the opposition proceedings (such as settlement, extensions of time to respond to Opposer's discovery requests and the waiver of initial disclosures) and submit lengthy responses to discovery requests (although untimely and deficient) ***during this same time period***. Yet Applicant's counsel never once asked to extend or reopen the discovery period. Applicant's counsel's own behavior fully undermines his claim of excusable neglect.

Specifically, Applicant's counsel alleges that his personal matters began shortly after June 26, 2012, when the Board granted the parties stipulated motion to suspend the opposition for thirty days due to settlement negotiations. Yet, several months later, in or about early September 2012, Applicant's counsel had several communications, including via email and

telephone, with Opposer's counsel concerning potential settlement and the waiver of initial disclosures. At no time during these conversations did Applicant's counsel request an extension of the discovery deadline or indicate his inability to adhere to the Board's schedule.

At no time during the discovery period, which ended on February 16, 2013, did Applicant serve on Opposer any discovery demands or request an extension of the discovery period. Although Applicant's counsel and Opposer's counsel had telephone conversations and email communications after February 16, 2013 concerning Applicant's failure to respond to Opposer's discovery demands and potential settlement, Applicant's counsel did not request that the parties reopen the discovery period at that time. Instead, Applicant's counsel requested that Opposer consent to a sixty day "extension" of time to respond to Opposer's discovery requests, *terms to which Opposer generously agreed*.⁴ At no time did Applicant's counsel indicate that he could not respond to Opposer's discovery requests within the extra sixty days or ask to reopen the already expired discovery period.

Even after the Board ordered Applicant to respond to Opposer's discovery requests, Applicant did not request that that the Board reopen the discovery period. Instead, on September 6, 2013, Applicant served untimely and deficient responses to Opposer's discovery requests, which necessitated that Opposer file a motion for sanctions. And Applicant did not respond to that motion for sanctions within the time allotted by the rules, and instead later and improperly filed a separate motion that, for the first time ever, seeks to reopen the discovery period.

Between June 20, 2012, and October 8, 2013, Applicant's counsel was able to (1) communicate with Opposer's counsel on several occasions regarding settlement negotiations, the

⁴ In his moving papers, Applicant's counsel claims that, on or about March 19, 2013, he asked Opposer to consent to a "suspension" of the proceedings (Mot. at 6; Yan Decl. ¶¶ 14-16). Although factually incorrect, such a suspension would not have had any effect *on the already lapsed discovery deadline*.

waiver of initial disclosures and an extension of time to respond to Opposer's discovery requests and (2) prepare lengthy responses (although deficient and untimely) to Opposer's discovery requests. Despite Applicant's counsel's clear ability to devote his attention to this opposition during the time he claims he was experiencing "personal matters," at no time therein did he ever request to extend or reopen the discovery period. Applicant's counsel's own actions thus wholly undermine any specific claims he may have made *ex parte* to the Board that his delay was excusable and outside his control. This alone warrants denial of the instant motion. *See Pumpkin Ltd. v. The Seed Corps*, 43 U.S.P.Q.2d 1582, 1586 (T.T.A.B. 1997) (no excusable neglect where moving party's delay "was caused by circumstances wholly within [its] reasonable control").

2. Applicant's Delay in Filing the Instant Motion to Reopen Eight Months after the Close of Discovery Is Significant

The discovery period closed on February 16, 2013, and Applicant only now is moving to reopen that period. This *delay of eight months* is significant and weighs heavily against a finding of excusable neglect. *See Old Nutfield Brewing Company, Ltd. v. Hudson Valley Brewing Company, Inc.*, 65 U.S.P.Q.2d 1701, 1703 (T.T.A.B. 2002) (no excusable neglect where opposer waited *four months* after close of testimony period to file motion to reopen); *PolyJohn Enterprises Corp. v. 1-800-Toilets Inc.*, 61 U.S.P.Q.2d 1860, 1860-61 (T.T.A.B. 2002) (no excusable neglect where motion to reopen was filed nearly *one month* after close of testimony period); *Dating DNA*, 94 U.S.P.Q.2d at 1892 (no excusable neglect where motion to reopen initial disclosure period was filed *six months* after deadline to serve initial disclosures); *Vital Pharmaceuticals Inc. v. Kronholm*, 99 U.S.P.Q.2d 1708, 1711 (T.T.A.B. 2011) ("a reopening of the testimony period, which closed *seven months* prior to opposer's request to reopen that period, would cause substantial delay to this opposition"). Indeed, as discussed above,

Applicant's counsel could have moved to extend or reopen the discovery period at any time, yet instead choose to focus on other aspects of the opposition.

3. Applicant Has Acted in Bad Faith

As set forth in great detail in Opposer's motion for sanctions, *see* Dkt.#19, Applicant has proceeded through this opposition with utter disregard for the rules of discovery and the Board's order compelling discovery responses. Applicant's deadline to respond to Opposer's motion for sanctions was September 23, 2013. Yet Applicant did not submit any such response by that deadline. Instead, Applicant filed the instant motion to reopen the discovery period weeks later.

Although Applicant filed the instant motion as one seeking to "reopen discovery," he asserts in his moving papers: "As set forth in detail herein, Applicant, *via his counsel*, submits to the Board that the *Opposer's Motion for Sanctions of Entry of Judgment* and to Suspend *is without any merit* under the totality of the circumstances." Mot. at 4 (emphasis added). Thus, it is clear that Applicant *improperly* is using the instant motion to reopen the discovery period as *an untimely response* in opposition to Opposer's motion for sanctions. A party cannot couch unpermitted or untimely papers in opposition to a pending motion as those ostensibly in support of a new motion. *See Guthy-Renker Corp. v. Boyd*, 88 U.S.P.Q.2d 1701, 1703 (T.T.A.B. 2008) (Board refused to consider new motion to dismiss that clearly was intended to serve as impermissible surreptitiously to pending motion for sanctions). These actions show Applicant's continued bad faith and utter disregard for the Board's rules and practices, which weighs significantly against a finding of excusable neglect.

4. Further Delay Will Prejudice Opposer

Opposer generously granted Applicant an extension of sixty days to respond to Opposer's discovery demands. When Applicant failed to serve any responses within the extended period, Opposer was forced to bear the expense and further delay of moving to compel. When Applicant

failed to comply with the Board's order compelling Applicant to respond to Opposer's discovery demands, Opposer was forced to bear the additional expense and delay of moving for sanctions. Now, Opposer has been forced to bear the expense of opposing a meritless motion to reopen the discovery period, based on facts disclosed *ex parte* only to the Board, that clearly was designed to serve as an untimely and improper response to Opposer's motion for sanctions. Opposer already has been prejudiced by Applicant's utter disregard for the Board's discovery rules and order. Reopening the discovery period only will result in further cost and delay.

CONCLUSION

For the foregoing reasons, Opposer respectfully requests that the Board issue an order denying Applicant's motion to reopen the discovery period and granting Opposer such further and other relief as the Board deems just and proper.

Dated: New York, New York
October 28, 2013

Respectfully submitted,

COWAN, LIEBOWITZ & LATMAN, P.C.
Attorneys for Opposer

By: /Maya L. Tarr/
William M. Borchard
Mary L. Kevlin
Maya L. Tarr

1133 Avenue of the Americas
New York, New York 10036
(212) 790-9200

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that, on October 28, 2013, I caused a true and correct copy of the foregoing Opposition to Applicant's Motion to Reopen the Discovery Period and supporting Declaration of William M. Borchard with exhibits to be sent via First Class Mail, postage prepaid, to Applicant's Attorney of Record, David Yan, Esq., Law Offices of David Yan, 136-20 38th Avenue, Suite 11E, Flushing, New York 11354-4232.

/Maya L. Tarr/

Maya L. Tarr



("Applicant's Mark") for "Alcohol-free beers; Beer; Beer, ale and lager; Beer, ale and porter; Beer, ale, lager, stout and porter; Beer, ale, lager, stout, porter, shandy; Beers; Black beer; Brewed malt-based alcoholic beverage in the nature of a beer; Coffee-flavored beer; De-alcoholised beer; Extracts of hops for making beer; Flavored beers; Ginger beer; Hop extracts for manufacturing beer; Imitation beer; Malt beer; Malt extracts for making beer; Malt liquor; Non-alcoholic beer; Pale beer; Porter" in International Class 32. *See* Dkt.#1.

3. The Notice of Opposition alleged that registration of Applicant's Mark was likely to result in confusion, falsely suggest a connection between Applicant and Opposer, and/or cause a likelihood of dilution by blurring of the distinctive quality of Opposer's Empire State Building Marks, as defined in Paragraph 1 of the Notice of Opposition. *See* Dkt.#1.

4. On June 26, 2012, the Board issued an order setting February 16, 2013, as the deadline for the close of the discovery period. A true and correct copy of that order is attached hereto as **Exhibit A**.

5. Thereafter, in early September 2012, Applicant's counsel and I participated in several communications via telephone and email concerning the waiver of initial disclosures and potential settlement of the opposition. True and correct copies of some of these email communications (with settlement discussions redacted) are attached hereto as **Exhibit B**.

6. On September 19, 2012, the parties filed a consented Motion to Waive Initial Disclosures, which was noted by the Board on October 10, 2012. True and correct copies of

these documents are attached hereto as **Exhibit C**. In the Board's October 10, 2012, it reiterated the February 16, 2013, deadline for the close of the discovery period. *See Ex. C* hereto.

7. At no time in September 2012 or during the discovery period, which ended February 16, 2013, did Applicant's counsel ask me or the Board to suspend or extend the discovery period, or indicate in any manner that he believed he would be unable to comply with the Board's deadlines.

8. Applicant did not serve discovery requests on Opposer, either during the discovery period or thereafter.

9. Prior to the close of the discovery period, my firm served Applicant with Opposer's First Set of Interrogatories and Request for Production of Documents and Things and Opposer's First Set of Requests for Admissions by first class mail, true and correct copies of which are attached hereto as **Exhibit D**. Applicant's responses to Opposer's discovery requests were due on March 26, 2013.

10. On March 19, 2013, *after the close of the discovery period*, Applicant's counsel called me to request a sixty extension of Applicant's deadline to respond to Opposer's discovery requests, to which I consented.

11. Applicant's counsel and I also discussed potential settlement at that time and agreed to a ninety day extension of all other forthcoming dates in order to continue these discussions. *See Exhibit E* hereto, which contains true and correct copies of email communications confirming these discussions (with confidential settlement discussions redacted).

12. *Contrary to Applicant's counsel's misrepresentation* in his moving papers (Mot. at 6; Yan Decl. ¶ 14), *I did consent* to both the sixty day extension of Applicant's time to

respond to Opposer's discovery requests and a ninety day extension of all other future dates. *See Ex. E* hereto.

13. Indeed, I confirmed the parties' agreement with Applicant's counsel via email, *see Ex. E* hereto, and filed the motion to extend with the Board, which was granted the same day. True and correct copies of the motion papers and the Board's order are attached hereto as **Exhibit F**.

14. At that time, Applicant's counsel did not inform me either that he could not respond to Opposer's discovery requests within the extended sixty days, that he wanted to suspend the proceedings or that he wanted to reopen the discovery period.

15. Applicant did not respond to Opposer's discovery requests by the extended deadline of May 25, 2013. Thus, on June 6, 2013, my firm filed a motion to compel Applicant to respond to Opposer's interrogatories and document requests. *See Dkt.#14*.

16. On August 6, 2013, the Board granted Opposer's motion and ordered Applicant to provide responses to Opposer's interrogatories and document requests within thirty days. A true and correct copy of the Board's order is attached hereto as **Exhibit G**. The Board further ordered that any such responses must be made "*without objection on the merits.*" *See Ex. G* hereto.

17. Applicant did not respond to Opposer's interrogatories and document requests within thirty days of the Board's order. Instead, after the deadline, Applicant's counsel sent to me via first class mail purported responses to Opposer's interrogatories and document requests, true and correct copies of which are attached hereto as **Exhibit H**.

18. Despite the Board's explicit order that such responses should be served *without objection on the merits*, each and every one of Applicant's responses objected to Opposer's

discovery requests on several grounds other than privilege, including overbreadth and undue burden. *See Ex. H* hereto. Applicant also failed to wholly respond to several interrogatory responses and did not sign the responses under oath. *See id.* Nor did Applicant produce one single document in response to Opposer's demands, including documents that would show Applicant's purported *bona fide* intent to use his mark. *See id.*

19. Applicant's counsel also served on me a copy of Applicant's purported responses to the requests for admission via first class mail on September 6, 2013, a true and correct copy of which is attached hereto as **Exhibit I**. However, those request were deemed admitted by operation of law due to Applicant's failure to serve responses by the May 25, 2013, deadline.

20. Based on Applicant's consistent disregard for the Board's rules and violation of the Board's order compelling discovery, on September 11, 2013, my firm moved the Board for an order granting sanctions against Applicant in the form of entry of judgment in favor of Opposer. *See Dkt.#19*.

21. On September 19, 2013, the Board issued an order suspending the proceedings pending determination of Opposer's motion for sanctions, a true and correct copy of which is attached hereto as **Exhibit J**. In that order, the Board stated: "Any paper filed during the pendency of this motion which is not relevant thereto will be given no consideration." *See Ex. J* hereto (citing 37 C.F.R. § 2.127(d)).

22. Although Applicant's deadline to file papers in opposition to Opposer's motion for sanctions was September 23, 2013, at no time did Applicant file such papers.

23. Instead, weeks later, on October 8, 2013, and in violation of the Board's order that no paper unrelated to Opposer's motion for sanctions should be filed with the Board, Applicant

filed the instant motion seeking to reopen the discovery period, *which closed over eight months ago*. See Dkt.#21.

24. Although Applicant filed the instant motion as one seeking to “reopen discovery,” he asserts in his moving papers: “As set forth in detail herein, Applicant, *via his counsel*, submits to the Board that the *Opposer’s Motion for Sanctions of Entry of Judgment* and to Suspend *is without any merit* under the totality of the circumstances.” See Mot. at 4 (emphasis added).

25. In his improperly filed motion, Applicant’s counsel alleges that, as of June 2012, he was dealing with “extraordinary and unusual personal matters,” which he claims excuses his delay. But Applicant’s counsel wholly fails to disclose in his papers filed with the Board and served on Opposer the nature of details of these purported “personal matters,” including when they allegedly ceased. See Mot. at p. 6; Yan Decl. ¶¶ 9, 10, 13, 16, 20.

26. Instead, Applicant’s counsel indicates that he provided the nature and details of these purported “personal matters” in a private *ex parte* communication sent only to the Board. See Mot. at p. 6; Yan Decl. ¶ 10. Thus, Opposer is unaware of the nature of details of these purported “personal matters” that were disclosed to the Board *ex parte*.

27. Nonetheless, during the time of these purported “personal matters,” Applicant’s counsel was able to communicate with me on several occasions (concerning settlement, the waiver of initial disclosures and other extensions) and submit lengthy responses to discovery requests (although untimely and deficient), yet never once asked to reopen the discovery period or indicated that he could not respond to Opposer’s discovery requests within the generously

Ref. No. 22690.013

extended time period or within the time period subsequently ordered by the Board.

I DECLARE UNDER PENALTY OF PERJURY THAT THE FOREGOING IS TRUE
AND CORRECT, EXECUTED ON OCTOBER 28, 2013 AT NEW YORK, NEW YORK.

A handwritten signature in black ink that reads "William M. Borchard". The signature is written in a cursive style with a prominent initial "W".

WILLIAM M. BORCHARD

EXHIBIT A

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: June 26, 2012

Opposition No. 91204122

Empire State Building Company
L.L.C.

v.

Michael Liang

Vionette Baez, Paralegal Specialist:

Opposer's June 20, 2012 motion to suspend proceedings filed June 20, 2012 is granted.¹

Because the parties are negotiating for possible settlement of this case, proceedings herein are suspended until August 19, 2012, subject to the right of either party to request resumption at any time. See Trademark Rule 2.117(c).

In the event that there is no word from either party concerning the progress of their negotiations, upon conclusion of the suspension period, proceedings shall resume without further notice or order from the Board, upon the schedule set out below.

Proceedings resume

8/20/2012

¹ Applicant's June 11, 2012 motion to extend the time to file an answer is granted as conceded. Applicant's answer filed June 12, 2012 is noted and made of record.

Initial Disclosures Due	9/19/2012
Expert Disclosures Due	1/17/2013
Discovery Closes	2/16/2013
Plaintiff's Pretrial Disclosures	4/2/2013
Plaintiff's 30-day Trial Period Ends	5/17/2013
Defendant's Pretrial Disclosures	6/1/2013
Defendant's 30-day Trial Period Ends	7/16/2013
Plaintiff's Rebuttal Disclosures	7/31/2013
Plaintiff's 15-day Rebuttal Period Ends	8/30/2013

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

If, during the suspension period, either of the parties or their attorneys should have a change of address, the Board should be so informed.

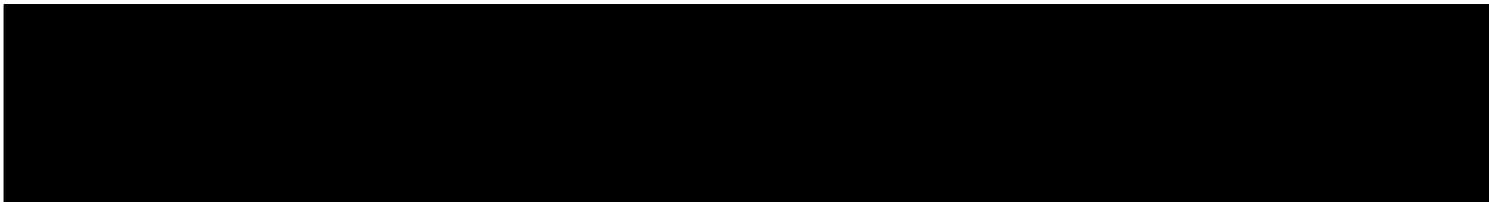
EXHIBIT B

Tarr, Maya

From: Borchard, William M.
Sent: Friday, September 07, 2012 2:10 PM
To: 'David Yan'
Subject: RE: NYC BEER Logo Opposition (CLL Ref. 22690.013)

FOR SETTLEMENT PURPOSES ONLY- FRE 408

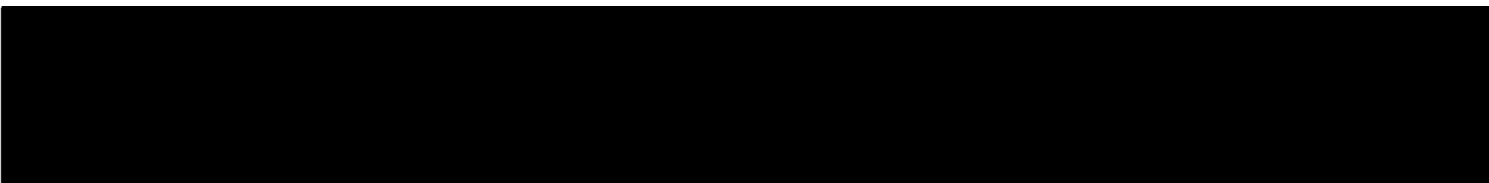
Hi David,



Bill

From: David Yan [mailto:davidyanlawfirm@yahoo.com]
Sent: Friday, September 07, 2012 2:04 PM
To: Borchard, William M.
Subject: RE: NYC BEER Logo Opposition (CLL Ref. 22690.013)

Hi, Bill,



Very truly yours,

David Yan

--- On **Thu, 9/6/12, Borchard, William M.** <WMB@cll.com> wrote:

From: Borchard, William M. <WMB@cll.com>
Subject: RE: NYC BEER Logo Opposition (CLL Ref. 22690.013)
To: "David Yan" <davidyanlawfirm@yahoo.com>
Cc: "Tarr, Maya" <mxt@cll.com>, "Kevlin, Mary" <MLK@cll.com>
Date: Thursday, September 6, 2012, 5:51 PM

David,

During our Discovery Conference, you said you get back to me about whether or not you would waive the requirement of initial disclosures. Have you decided to do so?

Bill

William M. Borchard, Esq.

Cowan, Liebowitz & Latman, P.C.

1133 Avenue of the Americas
New York, New York 10036
t: (212) 790-9290 | f: (212) 575-0671

www.cll.com | wmb@cll.com | [My Profile](#)



From: David Yan [mailto:davidyanlawfirm@yahoo.com]
Sent: Wednesday, June 20, 2012 12:13 AM
To: Borchard, William M.
Cc: Kevlin, Mary
Subject: Re: NYC BEER Logo Opposition (CLL Ref. 22690.013)

Hi, Bill,

Your transcribed minutes look right.

David Yan

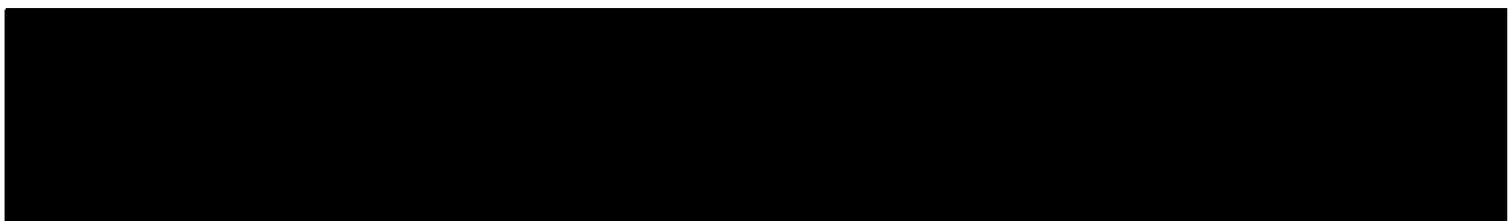
--- On Tue, 6/19/12, Borchard, William M. <WMB@cfl.com> wrote:

From: Borchard, William M. <WMB@cfl.com>
Subject: NYC BEER Logo Opposition (CLL Ref. 22690.013)
To: "David Yan" <davidyanlawfirm@yahoo.com>
Cc: "Kevlin, Mary" <MLK@cfl.com>
Date: Tuesday, June 19, 2012, 4:11 PM

FOR SETTLEMENT PURPOSES ONLY- FRE 408

Dear David,

This is to confirm our Discovery Conference today, June 19, 2012.



You also will get back to me about whether or not you will waive the requirement of initial disclosures. This would not prevent either party from seeking full discovery from the other party. It merely would avoid duplication.

You consented to suspend the opposition and all deadlines for 60 days so that settlement can be explored. We will file the motion and send you a service copy.

You agreed that Accelerated Case Resolution would not be requested at this time, subject to the further discussion at a later time of streamlining the presentation of the parties' cases.

Finally, if the matter cannot be settled, you agreed that we can provide you with a draft revised protective order allowing in-house counsel to have access to confidential information.

We look forward to hearing from you further as to settlement and initial disclosures.

Bill

William M. Borchard, Esq.

Cowan, Liebowitz & Latman, P.C.

1133 Avenue of the Americas
New York, New York 10036
t: (212) 790-9290 | f: (212) 575-0671

www.cll.com | wmb@ccl.com | [My Profile](#)



IRS CIRCULAR 230 DISCLOSURE

Under regulations issued by the U.S. Treasury, to the extent that tax advice is contained in this communication (or any attachment or enclosure hereto), you are advised that such tax advice is not intended or written to be used, and cannot be used by you, or any other party to whom this correspondence is shown, for the purpose of: (i) avoiding penalties under the Internal Revenue Code, or (ii) promoting, marketing or recommending the tax advice addressed herein to any other party.

This message is intended only for the designated recipient(s). It may contain confidential or proprietary information and may be subject to the attorney-client privilege or other confidentiality protections. If you are not a designated recipient, you may not review, copy or distribute this message. If you receive this in error, please notify the sender by reply e-mail and delete this message. Thank you.

Tarr, Maya

From: Borchard, William M.
Sent: Wednesday, September 12, 2012 12:20 PM
To: 'David Yan'
Cc: Tarr, Maya; Kevlin, Mary
Subject: NYC BEER Logo Opposition (CLL Ref. 22690.013)

FOR SETTLEMENT PURPOSES ONLY- FRE 408

Dear David,

This is to confirm that, in our telephone conversation on September 11, 2012, we agreed that both parties will waive the requirement of initial disclosures.

[REDACTED]

We look forward to your letting us know the results of that discussion.

Bill

William M. Borchard, Esq.
Cowan, Liebowitz & Latman, P.C.
1133 Avenue of the Americas
New York, New York 10036
t: (212) 790-9290 | f: (212) 575-0671
www.cll.com | wmb@cll.com | [My Profile](#)



EXHIBIT C

ESTTA Tracking number: **ESTTA495217**

Filing date: **09/19/2012**

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

Proceeding	91204122
Party	Plaintiff Empire State Building Company L.L.C.
Correspondence Address	MAYA L TARR COWAN LIEBOWITZ LATMAN PC 1133 AVENUE OF THE AMERICAS NEW YORK, NY 10036 UNITED STATES trademark@cll.com, wmb@cll.com, mxt@cll.com
Submission	Other Motions/Papers
Filer's Name	Maya L. Tarr
Filer's e-mail	mxt@cll.com, trademark@cll.com, wmb@cll.com
Signature	/Maya L. Tarr/
Date	09/19/2012
Attachments	Notice of Waiver of Initial Disclosures.pdf (2 pages)(10199 bytes)

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that, on September 19, 2012, I caused a true and correct copy of the foregoing Notice of Waiver of Initial Disclosures to be served via First Class Mail, postage prepaid, to Applicant's Attorney of Record, David Yan, Esq., Law Offices of David Yan, 136-20 38th Avenue, Suite 11E, Flushing, New York 11354-4232.

/Maya L. Tarr/
Maya L. Tarr

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

AM

Mailed: October 10, 2012

Opposition No. 91204122

Empire State Building Company
L.L.C.

v.

Michael Liang

**M. Catherine Faint,
Interlocutory Attorney:**

Opposer's notice to waive the requirement of initial disclosures, with applicant's consent, filed September 19, 2012 is noted.

Trial dates remain as set as indicated in the Board's order dated June 26, 2012 and copied below.

Expert Disclosures Due	1/17/2013
Discovery Closes	2/16/2013
Plaintiff's Pretrial Disclosures	4/2/2013
Plaintiff's 30-day Trial Period Ends	5/17/2013
Defendant's Pretrial Disclosures	6/1/2013
Defendant's 30-day Trial Period Ends	7/16/2013
Plaintiff's Rebuttal Disclosures	7/31/2013
Plaintiff's 15-day Rebuttal Period Ends	8/30/2013

Opposition No. 91204122

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

EXHIBIT D

additional responsive information or documents between the time the answers are served and the time of the final hearing of this opposition proceeding.

DEFINITIONS AND INSTRUCTIONS

A. The term “Applicant” means Michael Liang, and any entities or businesses which he owns or controls, any persons, businesses or entities with which he is directly connected, and all employees, agents and/or representatives thereof.

B. The term “Opposer” means Opposer Empire State Building Company L.L.C., and all parent, subsidiary, related, predecessor and/or successor entities, divisions, employees, agents and/or representatives thereof.

C. The term “Opposer’s Empire State Building Marks” shall refer to marks used, registered and/or applied to be registered by Opposer consisting of or incorporating the words EMPIRE STATE or EMPIRE STATE BUILDING, and various marks depicting the visual equivalent of the world-renowned Empire State Building, which is located in New York City, including, but not limited to, the marks set forth in paragraphs 1 and 2 of the Notice of Opposition in this proceeding.

D. The term “Applicant’s Mark” shall refer to the mark NYC BEER LAGER and



Design as depicted here: , as applied-for in Application Serial No. 85/213,453 and any other marks used, registered and/or applied to be registered by Applicant consisting of or incorporating a building design similar to the design in Applicant’s Mark, alone or with other word, letter and/or design elements.

E. The term “commerce” means commerce subject to regulation by Congress, as defined in 15 U.S.C. §1127.

F. As used herein, the terms “entity” and “person” include natural persons, governmental entities, organizations, corporations, partnerships, associations, joint ventures and any other individual or group of individuals that has the purpose of conducting or, in fact, conducts business.

G. The term “document” shall be given the broadest possible scope under Fed. R. Civ. P. 34 and includes, but is not limited to, all writings, correspondence, memoranda, handwritten notes, drafts, invoices, contracts, purchase orders, letters, checks, receipts, books, pamphlets, flyers, advertisements, web pages, publications, stickers, posters, catalogs, labels, product packaging, product containers, displays, photographs, slides, videotapes, films, artwork, drawings, sketches, illustrative materials, layouts, tear sheets, magnetic recording tapes, microfilms, computer printouts, e-mail, work sheets, and files from any personal computer, notebook or laptop computer, file server, minicomputer, mainframe computer or any other storage means by which information is retained in retrievable form, including files that are still on any storage media, but that are identified as “erased but recoverable,” and all other materials, whether printed, typewritten, handwritten, recorded or reproduced by a mechanical or electronic process.

H. The term “identify” when used in connection with a natural person or persons requires Applicant to state the person’s full name and last known business and residential addresses, telephone number and e-mail address.

I. The term “identify” when used in connection with a document requires

Applicant to:

(i) Furnish the name or title, date and general description (e.g., letter, memorandum, etc.) of the document, the name and address of the person from whom the document originated, the name and address of the persons to whom the document was addressed or delivered, and the names and addresses of all persons to whom copies of the document were sent; and

(ii) State whether Applicant is in possession of the original of the document or a copy thereof and, if Applicant is not in possession of the original or a copy, furnish the name and address of the custodian of the original or a copy; and

(iii) Furnish a general description of the subject matter to which the document(s) pertains.

J. The term “identify” when used in connection with a company, organization or other business entity requires Applicant to state the name, address, and phone number of the company, organization or other business entity.

K. The term “concerning” means referring to, relating to, embodying, connected with, commenting on, responding to, showing, describing, analyzing or constituting.

L. The singular and plural forms are used herein interchangeably, as are the masculine and feminine forms and the present and past tenses, and such terms should be construed as necessary to bring within the scope of the interrogatory/document request all documents and information which might otherwise be construed to be outside its scope.

M. The terms “and” and “or” shall be construed either disjunctively or conjunctively as necessary to bring within the scope of the interrogatory/document request all documents and

information which might otherwise be construed to be outside its scope.

N. If any information or document called for in any interrogatory or request is withheld in whole or in part by reason of a claim of attorney-client privilege or any other claim of immunity from discovery, then, at the time the information or document is to be produced, a list is to be furnished identifying any such information or document withheld together with the following information: date and title of the document; name and job title of each author, writer or sender of the document; name and job title of each recipient, addressee or other person to whom the original or any copy of the document was sent or furnished; if Applicant contends that an author or recipient of the document is an attorney for purposes of claiming privilege or immunity from discovery, identify the State Bar of which he or she was a member at the time of the communication in question; the general subject matter of the information or document withheld; the basis for the claim of privilege or immunity from discovery; and the interrogatory or request to which the information or document is responsive.

O. In the event that any document called for by this request has been destroyed, lost, discarded or otherwise disposed of, identify any such document as completely as possible, including, without limitation, the date of disposal, manner of disposal, reason for disposal, person authorizing the disposal and person disposing of the document.

P. Documents shall be produced as they are kept in the ordinary course of business or shall be organized and labeled to correspond to the document request to which they are responsive.

Q. To the extent the information or documents are sought concerning Applicant's use or intended use of Applicant's Mark, the interrogatories and requests are referring to use or

intended use in the United States or in commerce.

INTERROGATORIES

Interrogatory No. 1

State the date when Applicant first selected any mark comprising or containing Applicant's Mark for use or intended use in connection with any goods or services.

Interrogatory No. 2

Identify all persons who or entities that participated in or were consulted in the design, selection and/or adoption of any mark comprising or containing Applicant's Mark, including a description of the nature of each person's or entity's participation or consultation.

Interrogatory No. 3

Describe in detail the reason(s) for the selection of Applicant's Mark, including, without limitation, the intended commercial impression created by the building design in Applicant's Mark.

Interrogatory No. 4

Identify any trademark searches or other searches, opinions, investigations, analyses or studies related to the selection, design, and/or adoption of Applicant's Mark, including, without limitation, the persons involved, the date(s), and the data or results of those searches, opinions, investigations, analyses or studies.

Interrogatory No. 5

State whether Applicant (or any person or entity authorized by Applicant) has made any use of any marks comprising or containing Applicant's Mark in the United States or in commerce as of the present date, and if so, identify each product or service on or in connection with which Applicant (or any person or entity authorized by Applicant) has made such use (hereinafter "Applicant's Products/Services").

Interrogatory No. 6

For each of Applicant's Products/Services identified in response to Interrogatory No. 5 above, identify:

- (a) The date of first use for each of Applicant's Products/Services;
- (b) The period of time during which each of Applicant's Products/Services was or is being distributed, offered for sale, sold or rendered;
- (c) The geographic area(s) in which each of Applicant's Products/Services was or is being distributed, offered for sale, sold or rendered;
- (d) The annual volume of sales for each year to the present, both by dollar amount and unit amount, for each of Applicant's Products/Services;
- (e) Any other revenues, including, without limitation, any licensing or sponsorship revenues that Applicant has received in connection with each of Applicant's Products/Services;
- (f) The range of retail and wholesale price for each of Applicant's Products/Services for each year to the present;
- (g) The channels of trade (e.g., types of retail stores, catalogs, mail order, on-line, promotional sales, private sales, establishments, etc.) through which each of Applicant's Products/Services was or is being distributed or sold to the ultimate purchaser, consumer or user; and
- (h) The type of customers to whom each of Applicant's Products/Services is or was marketed, distributed, offered for sale, sold or rendered.

Interrogatory No. 7

State whether any mark comprising or containing Applicant's Mark has been used or is intended to be used in connection with any indicia, designs, stylizations, terms, imagery, marks, logos, themes, or references similar to, related to, or associated or affiliated with Opposer, and if so describe the details of each such use or intended use.

Interrogatory No. 8

Identify any persons or entities that have ever, either orally or in writing, authorized, licensed, assigned, granted, conveyed or otherwise transferred to Applicant the right to use any mark comprising or containing Applicant's Mark, and for each such person or entity, identify the date of and material terms under which such authorization, license, assignment, grant, conveyance or other transfer was made, including, without limitation, the details of the grant of rights to use Applicant's Mark and the financial terms governing such transaction.

Interrogatory No. 9

Identify any persons or entities Applicant has authorized, licensed, assigned, granted, conveyed or otherwise transferred the right to use any mark comprising or containing Applicant's Mark, and for each such person or entity, identify the date of and material terms under which such authorization, license, assignment, grant, conveyance or other transfer of right to use was made, including, without limitation, the details of the grant of rights to use Applicant's Mark and the financial terms governing such transaction.

Interrogatory No. 10

Identify each website, web auction, web hosting, web listing, web posting, web page or social media page, whether owned by Applicant or third parties, including its Internet address, on or through which Applicant's Mark and/or Applicant's Products/Services have been, are

currently being or are intended to be promoted, advertised, displayed, offered for sale, sold or otherwise distributed.

Interrogatory No. 11

(a) Identify each kind of advertising, marketing and other promotional materials, including, without limitation, point-of-sale material, signs, circular, flyer, poster, sticker, sales sheet, leaflet, brochure, catalog, sign, price list, on-line or email advertisement, print advertisement, radio or television advertisement, service order list or other advertising material or promotional item that has been used or is intended to be used in connection with Applicant's Products/Services and/or Applicant's Mark.

(b) For each promotional material referred to in subparagraph (a) above, identify where the promotional material is advertised, posted, promoted, published or distributed (e.g. name the publication, the URL for the website, the retail store, etc.).

Interrogatory No. 12

(a) Describe each instance where any person has by word or deed or otherwise, including, without limitation, by misdirected mail, e-mail, telephone calls, orders or inquiries, suggested or reflected a belief that Applicant is licensed, endorsed or sponsored by or is a sponsor of Opposer, or that the products or services sold, offered for sale, or otherwise distributed or intended to be sold, offered for sale, or otherwise distributed by Applicant under Applicant's Mark are licensed, endorsed or sponsored by or associated with or related in any way to Opposer, and/or Opposer's Empire State Building Marks; and

(b) Identify all persons knowledgeable about any such instances referred to in subparagraph (a) above and describe the nature of their knowledge.

Interrogatory No. 13

State whether Applicant has marketed or intends to market Applicant's Products/Services bearing or rendered in connection with Applicant's Mark or is aware that such products will be marketed to consumers of Opposer's goods or services, or to consumers located in or around New York, New York and, if so, describe the means by which Applicant has marketed or intends to market Applicant's Products/Services or how such products will be marketed, to consumers of Opposer's goods or services, or to consumers located in or around New York, New York.

Interrogatory No. 14

State whether Applicant was aware of Opposer, Opposer's Empire State Building Marks, and/or goods or services marketed, manufactured, distributed, offered for sale, sold, licensed or rendered by Opposer or under license from Opposer in connection with Opposer's Empire State Building Marks prior to:

- a) January 8, 2011, when Applicant filed Application Serial No. 85/213,453.
- b) Any use by Applicant of Applicant's Mark in connection with any goods or services.

Interrogatory No. 15

State whether Applicant has ever sought a license or other right to use any marks, logos, designs, stylizations or slogans, including without limitation, Opposer's Empire State Building Marks, from Opposer.

Interrogatory No. 16

State whether Applicant has any documentation, including without limitation, business plans, marketing plans, memos, correspondence or draft proposals of any kind, reflecting Applicant's bona fide intention, prior to or as of January 8, 2011, to use Applicant's Mark in commerce in connection with each and every good identified in International Class 32 in Application Serial No. 85/213,453.

Interrogatory No. 17

With respect to each response to Opposer's First Set of Requests for Admissions that is anything other than an unqualified admission, state the basis for the response, including, without limitation, all facts and documents upon which the response is based.

DOCUMENT REQUESTS

Request No. 1

Specimens of each of Applicant's Products/Services bearing or displaying any mark comprising or containing Applicant's Mark, including, without limitation, each different color combination and each different product design or stylization of products in which Applicant's Mark is used or intended to be used by Applicant and/or its licensees, sponsors or related or affiliated entities.

Request No. 2

Specimens of each label, hangtag, tag, product package, package insert, sticker, hologram, package material or other device which bears any mark comprising or containing Applicant's Mark, and which has been used or is intended to be used by Applicant and/or its licensees.

Request No. 3

Specimens of each point-of-sale material, circular, flyer, poster, sticker, sales sheet, leaflet, brochure, catalog, sign, price list, on-line or email advertisement, print advertisement, radio or television advertisement, service order list or other advertising material or promotional item which bears any mark comprising or containing Applicant's Mark, and which has been used or is intended to be used by Applicant and/or its licensees.

Request No. 4

All documents concerning Applicant's design, clearance, selection, and/or adoption of Applicant's Mark.

Request No. 5

All documents concerning any trademark searches or other searches, opinions, investigations, analyses or studies conducted or reviewed by or on behalf of Applicant concerning Applicant's Mark.

Request No. 6

Documents sufficient to identify: (a) the date of first use of Applicant's Mark; (b) the date of first use of Applicant's Mark in commerce; (c) the geographic area(s) of use of Applicant's Mark; (d) any and all customers, distributors or other persons or entities to which Applicant's Products/Services offered in connection with Applicant's Mark have been sold or distributed; (e) Applicant's Products/Services bearing, offered for sale, sold or otherwise distributed under Applicant's Mark; (f) all retail, wholesale, commercial, or charitable entities through which goods or services bearing or rendered in connection with Applicant's Mark have been offered for sale, sold or otherwise distributed; (g) the channels of trade through which Applicant's Products/Services offered in connection with Applicant's Mark were or are being distributed or sold to the ultimate purchaser, consumer or user; (h) the annual volume of sales (in dollars and units) made under Applicant's Mark for each year from the date of first use to the present; and (i) the annual amount of revenue, including, without limitation, any licensing or sponsorship revenues that Applicant has received in connection with Applicant's Products/Services offered in connection with Applicant's Mark, for each year from the date of first use to the present.

Request No. 7

All documents concerning the advertising, marketing or promotion of Applicant's Products/Services offered for sale or otherwise distributed or intended to be offered for sale or otherwise distributed under Applicant's Mark, including, without limitation, any media plans, public relations materials, press kits and correspondence with advertising agencies, public relations firms, media planners, graphic designers, web site designers or any other such entities in the advertising and promotional field.

Request No. 8

Documents sufficient to identify the amount of money expended by Applicant in advertising and promoting Applicant's Mark and/or Applicant's Products/Services.

Request No. 9

All documents concerning each trade show, convention, exposition or conference at which Applicant's Products/Services bearing Applicant's Mark have been displayed, advertised, promoted, offered for sale or sold.

Request No. 10

All documents concerning any authorization, license, assignment, grant, conveyance or other transfer of the right to use (or proposed authorization, license, assignment, grant, conveyance or other transfer of the right to use) Applicant's Mark from any third party to Applicant, or to sell Applicant's Products/Services bearing Applicant's Mark.

Request No. 11

All documents concerning any authorization, license, assignment, grant, conveyance or other transfer of the right to use (or proposed authorization, license, assignment, grant,

conveyance or other transfer of the right to use) any of Opposer's Empire State Building Marks from Opposer to Applicant.

Request No. 12

All documents concerning Applicant's authorization, license, assignment, grant, conveyance or other transfer of rights (or proposed authorization, license, assignment, grant, conveyance or other transfer of rights) in Applicant's Mark from or on behalf of Applicant to any third party, including, but not limited to, all license agreements.

Request No. 13

Documents sufficient to identify each website, web auction, web hosting, web listing, web posting, web page or social media page (whether owned by Applicant or third parties), including its Internet address, on or through which Applicant's Mark and/or Applicant's Products/Services has been, is currently being or is intended to be promoted, advertised, displayed, offered for sale, sold or otherwise distributed.

Request No. 14

All documents concerning the use or intended use of Applicant's Mark in connection with any indicia, designs, stylizations, terms, imagery, marks, logos, themes, or references similar to, related to, or associated or affiliated with Opposer, or its trademarks, logos, designs, or stylizations, including without limitation, Opposer's Empire State Building Marks.

Request No. 15

Apart from the current opposition, all documents concerning any objections, claims, demands or actions lodged or filed against the use or proposed use or registration of Applicant's Mark, including, without limitation, cease and desist letters, complaints and/or Notices of Opposition.

Request No. 16

All documents concerning Opposer, Opposer's Empire State Building Marks, or any goods or services marketed, manufactured, distributed, offered for sale, sold, licensed or rendered by Opposer.

Request No. 17

All documents concerning Applicant's knowledge of Opposer, Opposer's Empire State Building Marks, and/or any goods or services marketed, manufactured, distributed, offered for sale, sold, licensed or rendered by Opposer or under license from Opposer in connection with Opposer's Empire State Building Marks prior to:

- a) January 8, 2011, when Applicant filed Application Serial No. 85/213,453.
- b) Any use by Applicant of Applicant's Mark in connection with any goods or services.

Request No. 18

All documents concerning any market research, focus groups, surveys or other investigation made or commissioned by or on behalf of Applicant concerning Applicant's Mark, Applicant's Products/Services, Opposer's Empire State Building Marks or any goods or services advertised, promoted, offered for sale, sold, licensed or rendered by Opposer.

Request No. 19

All documents reflecting or indicating any confusion on the part of any member of the public between Opposer and Applicant and/or their respective marks and/or goods or services, including, without limitation, documents referring to or evidencing misdirected mail, e-mails, telephone calls, orders or inquiries suggesting or reflecting a belief by any person that Applicant is licensed, endorsed or sponsored by, or is a sponsor of Opposer, or that the products or services sold, offered for sale or otherwise distributed, or intended to be sold, offered for sale or

Ref. No. 22690.013

otherwise distributed, by Applicant under Applicant's Mark are licensed, endorsed or sponsored by or associated or related in any way with or to Opposer, and/or Opposer's goods and services.

Request No. 20

All documents concerning the actual or intended channels of trade for goods or services sold or rendered or intended to be sold or rendered in connection with Applicant's Mark.

Request No. 21

All documents concerning any designs, logos, renditions, stylizations, (including, without limitation, font styles) or formats of or for Applicant's Mark, including without limitation any drafts or proposed versions of same.

Request No. 22

All documents, including without limitation, business plans, marketing plans, memos, correspondence or draft proposals of any kind, concerning Applicant's bona fide intent to use Applicant's Mark. in connection with each and every good identified in International Class 32 in Application Serial No. 85/213,453 prior to or as of January 8, 2011.

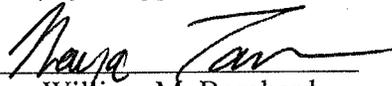
Request No. 23

All documents identified or otherwise referred to by Applicant in answering Opposer's First Set of Interrogatories above and Opposer's First Set of Requests for Admission.

Dated: New York, New York
February 19, 2013

Respectfully submitted,

COWAN, LIEBOWITZ & LATMAN, P.C.
Attorneys for Opposer

By: 
William M. Borchard
Mary L. Kevlin
Maya L. Tarr

1133 Avenue of the Americas
New York, New York 10036
212-790-9200

CERTIFICATE OF SERVICE

I hereby certify that, on February 19, 2013, I caused a true and complete copy of the foregoing *Opposer's First Set of Interrogatories and Request for Production of Documents and Things to Applicant* to be served by First Class Mail to Applicant's Attorney and Correspondent of Record, David Yan, Law Offices of David Yan, 136-20 38th Avenue, Suite 11E, Flushing, New York 11354 4232, United States.

Dated: New York, New York
February 19, 2013



Maya L. Tarr

REQUESTS FOR ADMISSIONS

Request No. 1

Admit that Opposer's Empire State Building Marks are famous.

Request No. 2

Admit that Opposer's Empire State Building Marks were famous prior to:

- (a) January 8, 2011, when Applicant filed Application Serial No. 85/213,453.
- (b) Any use by Applicant of Applicant's Mark in connection with any goods or services.

Request No. 3

Admit that Opposer's Empire State Building Marks are closely identified and associated with Opposer's goods and services.

Request No. 4

Admit that Applicant was aware of Opposer's Empire State Building Marks prior to:

- (a) January 8, 2011, when Applicant filed Application Serial No. 85/213,453.
- (b) Any use by Applicant of Applicant's Mark in connection with any goods or services.

Request No. 5

Admit that Applicant was aware of goods or services marketed, manufactured, distributed, offered for sale, sold, licensed or rendered by Opposer or under license from Opposer in connection with Opposer's Empire State Building Marks prior to:

- (c) January 8, 2011, when Applicant filed Application Serial No. 85/213,453.
- (d) Any use by Applicant of Applicant's Mark in connection with any goods or services.

Request No. 6

Admit that Applicant's services covered by Application No. 85/213,453 are marketed or intended to be marketed to consumers of Opposer's goods and/or services.

Request No. 7

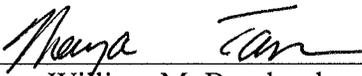
Admit that Applicant has no connection with Opposer and has no authorization from Opposer to use the building design in Applicant's Mark.

Request No. 8

Admit that Applicant intended the building design in Applicant's Mark to resemble the Empire State Building.

Dated: New York, New York
February 19, 2013

COWAN, LIEBOWITZ & LATMAN, P.C.
Attorneys for Opposer

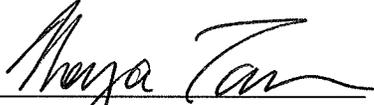
By: 
William M. Borchard
Mary L. Kevlin
Maya L. Tarr

1133 Avenue of the Americas
New York, New York 10036
212-790-9200

CERTIFICATE OF SERVICE

I hereby certify that, on February 19, 2013, I caused a true and complete copy of the foregoing *Opposer's First Set of Requests for Admissions* to be served by First Class Mail to Applicant's Attorney and Correspondent of Record, David Yan, Law Offices of David Yan, 136-20 38th Avenue, Suite 11E, Flushing, New York 11354 4232, United States.

Dated: New York, New York
February 19, 2013



Maya L. Tarr

EXHIBIT E

Tarr, Maya

From: Borchard, William M.
Sent: Thursday, March 21, 2013 12:45 PM
To: 'David Yan'
Cc: Kevlin, Mary; Tarr, Maya
Subject: NYC BEER Logo Opposition No. 91204122 (CLL Ref. 22890.013)

FOR SETTLEMENT PURPOSES ONLY -- FRE 408

Dear David,

You telephoned me on March 19, 2013 to request an extension of the Applicant's deadline to respond to Opposer's First Set of discovery requests.

We had a very brief phone conversation about fifteen minutes later, but you had to go so we did not finish our conversation. I called you again yesterday, but you were not available.

1. Extension Request

Regarding your extension request, Opposer will consent to a 60 day extension of Applicant's deadline to respond to Opposer's First Set of discovery requests on condition that all other dates are extended for 90 days. This will give us an opportunity to continue to explore settlement and will avoid putting Applicant and Opposer under undo time pressure should settlement not be possible.

Please let me know whether or not this is acceptable. If so, we will prepare and submit the Motion on Consent to the TTAB.

2. Settlement

I look forward to hearing from you.

Bill

William M. Borchard, Esq.

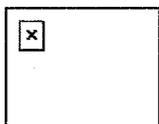
Cowan, Liebowitz & Latman, P.C.

1133 Avenue of the Americas

New York, New York 10036

t: (212) 790-9290 | f: (212) 575-0671

www.cll.com | wmb@ccl.com | [My Profile](#)



Tarr, Maya

From: Borchard, William M.
Sent: Tuesday, March 26, 2013 3:38 PM
To: 'David Yan'
Cc: Kevlin, Mary; Tarr, Maya
Subject: NYC BEER Logo Opposition No. 91204122 (CLL Ref. 22890.013)

Dear David,

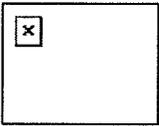
Since I have not heard from you in reply to my email of March 21, 2013, I believe that you have accepted our client's consent to a 60 day extension of Applicant's deadline to respond to Opposer's First Set of discovery requests on condition that all other dates are extended for 90 days.

We will prepare and submit the Motion on Consent tomorrow if we do not hear otherwise from you.

We also look forward to hearing from you about the settlement proposal we made in that email.

Bill

William M. Borchard, Esq.
Cowan, Liebowitz & Latman, P.C.
1133 Avenue of the Americas
New York, New York 10036
t: (212) 790-9290 | f: (212) 575-0671
www.cll.com | wmb@cll.com | [My Profile](#)



From: Borchard, William M.
Sent: Thursday, March 21, 2013 12:45 PM
To: 'David Yan'
Cc: Kevlin, Mary; Tarr, Maya
Subject: NYC BEER Logo Opposition No. 91204122 (CLL Ref. 22890.013)

FOR SETTLEMENT PURPOSES ONLY -- FRE 408

Dear David,

You telephoned me on March 19, 2013 to request an extension of the Applicant's deadline to respond to Opposer's First Set of discovery requests.

We had a very brief phone conversation about fifteen minutes later, but you had to go so we did not finish our conversation. I called you again yesterday, but you were not available.

1. Extension Request

Regarding your extension request, Opposer will consent to a 60 day extension of Applicant's deadline to respond to Opposer's First Set of discovery requests on condition that all other dates are extended for 90 days.

This will give us an opportunity to continue to explore settlement and will avoid putting Applicant and Opposer under undo time pressure should settlement not be possible.

Please let me know whether or not this is acceptable. If so, we will prepare and submit the Motion on Consent to the TTAB.

2. Settlement

I look forward to hearing from you.

Bill

William M. Borchard, Esq.
Cowan, Liebowitz & Latman, P.C.
1133 Avenue of the Americas
New York, New York 10036
t: (212) 790-9290 | f: (212) 575-0671
www.cll.com | wmb@cll.com | [My Profile](#)

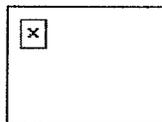


EXHIBIT F

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

Proceeding.	91204122
Applicant	Plaintiff Empire State Building Company L.L.C.
Other Party	Defendant Michael Liang

Motion for an Extension of Answer or Discovery or Trial Periods With Consent

The Close of Plaintiff's Trial Period is currently set to close on 05/17/2013. Empire State Building Company L.L.C. requests that such date be extended for 90 days, or until 08/15/2013, and that all subsequent dates be reset accordingly.

Time to Answer :	CLOSED
Deadline for Discovery Conference :	CLOSED
Discovery Opens :	CLOSED
Initial Disclosures Due :	CLOSED
Expert Disclosure Due :	CLOSED
Discovery Closes :	CLOSED
Plaintiff's Pretrial Disclosures :	07/01/2013
Plaintiff's 30-day Trial Period Ends :	08/15/2013
Defendant's Pretrial Disclosures :	08/30/2013
Defendant's 30-day Trial Period Ends :	10/14/2013
Plaintiff's Rebuttal Disclosures :	10/29/2013
Plaintiff's 15-day Rebuttal Period Ends :	11/28/2013

The grounds for this request are as follows:

- *Parties are engaged in settlement discussions*
- *Opposer has consented to a 60 day extension of Applicant's deadline to respond to Opposer's First Set of discovery requests, until May 25, 2013. Opposer also requests, upon consent from Applicant, that all other dates be extended for an additional 90 days.*

Empire State Building Company L.L.C. has secured the express consent of all other parties to this proceeding for the extension and resetting of dates requested herein.

Empire State Building Company L.L.C. has provided an e-mail address herewith for itself and for the opposing party so that any order on this motion may be issued electronically by the Board.

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Respectfully submitted,

/Maya L. Tarr/

Maya L. Tarr

mxt@cil.com, wmb@cil.com, trademark@cil.com, fxm@cil.com, mlk@cil.com
davidyanlawfirm@yahoo.com

03/27/2013

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

March 27, 2013

PROCEEDING NO. 91204122
Empire State Building Company
L.L.C.

v.

Michael Liang

MOTION TO EXTEND GRANTED

By the Board:

Empire State Building Company L.L.C.'s consent motion to extend, filed Mar 27, 2013, is granted. Dates are reset as set out in the motion.

.oOo.

EXHIBIT G

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: August 6, 2013

Opposition No. 91204122

Empire State Building Company
L.L.C.

v.

Michael Liang

M. Catherine Faint,
Interlocutory Attorney:

This case now comes up on opposer's motion, filed June 6, 2013, to compel applicant to answer opposer's first set of interrogatories and first set of document requests, served February 19, 2013. Applicant has failed to file a brief in response to opposer's motion. See Trademark Rule 2.127(a).¹

In view of the circumstances set forth in opposer's motion to compel, and because applicant has not responded to the motion, opposer's motion to compel discovery responses is granted. See Trademark Rule 2.120(e).

Applicant is allowed until **THIRTY DAYS** from the mailing date of this order in which to respond to opposer's first set of interrogatories and first set of document requests, without objection on the merits, failing which a motion for sanctions

will be entertained by the Board.² See Trademark Rule 2.120(g)(1).

Proceedings are resumed, and dates are reset below.

Discovery Closes	CLOSED
Plaintiff's Pretrial Disclosures Due	9/20/2013
Plaintiff's 30-day Trial Period Ends	11/4/2013
Defendant's Pretrial Disclosures Due	11/19/2013
Defendant's 30-day Trial Period Ends	1/3/2014
Plaintiff's Rebuttal Disclosures Due	1/18/2014
Plaintiff's 15-day Rebuttal Period Ends	2/17/2014

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

¹ Trademark Rule 2.127(a) reads, in relevant part, as follows: "When a party fails to file a brief in response to a motion, the Board may treat the motion as conceded."

² Objections going to the merits of a discovery request include those which challenge the request as overly broad, unduly vague and ambiguous, burdensome and oppressive, as seeking non-discoverable information on expert witnesses, or as not calculated to lead to the discovery of admissible evidence. In contrast, claims that information sought by a discovery request is trade secret, business-sensitive or otherwise confidential, is subject to attorney-client or a like privilege, or comprises attorney work product, goes not to the merits of the request but to a characteristic or attribute of the responsive information. The Board generally is not inclined to hold a party to have waived the right to make these claims, although such claims must be made expressly. *No Fear v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000).

EXHIBIT H

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

In re Application Serial No. 85/213,453
Filed: January 8, 2011
For Mark: NYC BEER LAGER and Design
Published in the Official Gazette: December 6, 2011

----- X
: EMPIRE STATE BUILDING COMPANY L.L.C., :
: :
: Opposer, :
: :
: v. : Opposition No.: 91204122
: :
: MICHAEL LIANG, :
: :
: Applicant. :
: :
----- X

Commissioner for Trademarks
Attn: Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

**APPLICANT’S RESPONSE
TO OPPOSER’S FIRST SET OF INTERROGATORIES
AND REQUEST FOR PRODUCTION OF DOCUMENTS AND THINGS**

Pursuant to Rule 33 and 34 of the Federal Rules of Civil Procedure and 37 C.F.R. § 2.120, Applicant, MICHAEL LIANG (“Applicant”), by and through his undersigned attorney, hereby submit responses and objections to Opposer Empire State Building Company L.L.C. (“Opposer”)’s First Set of Interrogatories and Request for Production of Documents and Things:

GENERAL OBJECTIONS

The following General Objections are incorporated into each Specific Objection and Response below as if set forth in full responses to each individually numbered response. The

failure to specifically incorporate a General Objection shall not be construed as a waiver of the same.

1. Applicant objects to each and every Interrogatory herein to the extent that it seeks information or documents protected by any privilege or protection from discovery, including but not limited to the attorney-client privilege and the work-product doctrine. The inadvertent production of any material protected by the attorney-client privilege, the work-product doctrine or any other applicable privilege, immunity or protection from disclosure is not intended and should not be construed to constitute a waiver. Applicant reserves the right to assert all applicable privileges and protections from production.
2. Applicant objects to each and every Interrogatory to the extent that it seeks to impose requirements that are inconsistent with, or beyond those contemplated by, the Federal Rules of Civil Procedure and/or the Code of Federal Regulations.
3. Applicant objects to each and every Interrogatory to the extent that the definitions, instructions, or specific requests are vague, ambiguous, overly broad, and/or unduly burdensome.
4. Applicant objects to each and every Interrogatory to the extent that it seeks information that is a matter of public record or equally available to Opposer.
5. Applicant objects to each and every Interrogatory to the extent that it calls for an expert opinion on the ground that it violates the work-product doctrine.
6. Applicant objects to each and every Interrogatory to the extent that it seeks Applicant confidential and proprietary information, the disclosure of which will or may cause harm to Applicant.

7. Applicant objects to each and every Interrogatory as overly broad, unduly burdensome, and oppressive, insofar as it seeks information which is in the custody, possession, or control of Opposer or its agents, or is equally available to the public.
8. Applicant objects to each and every Interrogatory to the extent that it is overly broad, unduly burdensome, and oppressive, where the Interrogatory requests the identification of “all” documents when all relevant facts can be obtained from fewer than “all documents.”
9. Applicant objects to each and every Interrogatory to the extent that it is overly broad and unduly burdensome by requesting documents that are neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.
10. Applicant objects to each and every Interrogatory to the extent that it is vague or ambiguous.
11. Applicant objects to each and every Interrogatory to the extent that it is overly broad, unduly burdensome, or oppressive.
12. Applicant objects to each and every Interrogatory to the extent that it requires Plaintiff to produce documents not within Applicant’s possession, custody, or control. Unless otherwise specified, Applicant will not produce any documents in the possession, custody, and control of any third party, including any agent or outside attorney of Applicant.
13. Applicant objects to each and every Interrogatory to the extent that it seeks information without any limitation to the time period relevant to this action.

14. In making these objections, Applicant does not in any way waive, or intend to waive, but rather intend to preserve and are preserving:
15. All objections as to competency, relevancy, materiality, and admissibility of any information that may be provided in response to the Interrogatory, or the subject matter thereof;
16. All rights to object on any ground to the use of any information that may be provided in response to the Interrogatory, or the subject matter thereof, in any subsequent proceedings, including the trial of this or any other matter; and
17. All rights to object on any ground to any request for further responses to the Interrogatory or any other document request.
18. Applicant's objections herein and the production of any documents by Applicant pursuant to any Interrogatory are not intended to waive or prejudice any objections or privileges Applicant may later assert, without limitation.
19. Applicant reserves the right to supplement, amend, correct, or clarify the responses and objections to the Interrogatory.

In addition to the General Objections set forth above, Applicant sets forth below Specific Objections to individual requests where appropriate, including objections that are not generally applicable to all of the requests. By setting forth such Specific Objections, Applicant does not intend to limit the General Objections set forth above. To the extent that Applicant responds to requests to which they object, such objections are not waived by a response.

The information provided herein is based upon, and is therefore limited by, the records and information in existence, presently collected and thus far discovered in the course of the preparation of these responses.

SPECIFIC OBJECTIONS AND RESPONSES

Interrogatory No. 1:

State the date when Applicant first selected any mark comprising or containing Applicant's Mark for use or intended use in connection with any goods or services.

Response No. 1:

Applicant objects to this Interrogatory on the ground that it is overly broad and unduly burdensome.

Subject to and without waiving any General Objection or Specific Objection, Applicant answers as follows: Applicant has not used any mark comprising or containing Applicant's Mark in connection with any goods or services. Once the Applicant's application for registration (Serial No. 85/213,453) is approved by the U.S. Patent and Trademark Office, Applicant intends to use a mark comprising or containing the Applicant's Mark in goods or services of Alcohol-free beers; Beer; Beer, ale and lager; Beer, ale and porter; Beer, ale, lager, stout and porter; Beer, ale, lager, stout, porter, shandy; Beers; Black beer; Brewed maltbased alcoholic beverage in the nature of a beer; Coffee-flavored beer; De-alcoholised beer; Extracts of hops for making beer; Flavored beers; Ginger beer; Hop extracts for manufacturing beer; Imitation beer; Malt beer; Malt extracts for making beer; Malt liquor; Non-alcoholic beer; Pale beer.

Interrogatory No. 2:

Identify all persons who or entities that participated in or were consulted in the design selection and/or adoption of any mark comprising or containing Applicant's Mark, including a description of the nature of each person's or entity's participation or consultation.

Response No. 2:

Applicant objects to this Interrogatory on the ground that it is overly broad and unduly burdensome.

Subject to and without waiving any General Objection or Specific Objection, Applicant answers as follows: Applicant does not remember with specificity every individual responsive to this request. Applicant has only retained a design firm, Sky Blue Web Design Studio, 15 7th Avenue South, New York, NY 10014, Attn.: Raymond Yu, Tel.: (917) 916-8802, to design the Applicant's Mark.

Interrogatory No. 3:

Describe in detail the reason(s) for the selection of Applicant's Mark, including, without limitation, the intended commercial impression created by the building design in Applicant's Mark.

Response No. 3:

Applicant objects to this Interrogatory on the ground that it is overly broad and unduly burdensome.

Subject to and without waiving any General Objection or Specific Objection, Applicant answers as follows: the building design in the Applicant's Mark represents the skyscrapers in New York City that would create the commercial impression of metropolitan life style.

Interrogatory No. 4:

Identify any trademark searches or other searches, opinions, investigations, analyses or studies related to the selection, design, and/or adoption of Applicant's Mark, including, without limitation, the persons involved, the date(s), and the data or results of those searches, opinions, investigations, analyses or studies.

Response No. 4:

Applicant objects to this Interrogatory on the ground that it is overly broad and unduly burdensome.

Subject to and without waiving any General Objection or Specific Objection, Applicant answers as follows:

(a) The design firm, Sky Blue Web Design Studio, will not disclose its work-product related confidential information and its work has no connection with the Applicant's intention to use this Applicant's Mark.

(b) Applicant searched the website of the U.S. Patent and Trademark Office shortly before Applicant submitted the application for registration on January 8, 2011.

Interrogatory No. 5:

State whether Applicant (or any person or entity authorized by Applicant) has made any use of any marks comprising or containing Applicant's Mark in the United States or in commerce as of the present date, and if so, identify each product or service on or in connection with which Applicant (or any person or entity authorized by Applicant) has made such use (hereinafter "Applicant's Products/Services").

Response No. 5:

Applicant objects to this Interrogatory on the ground that it is overly broad and unduly burdensome.

Subject to and without waiving any General Objection or Specific Objection, Applicant answers as follows: Applicant has not made use any mark comprising or containing Applicant's Mark in the United States or in commerce.

Interrogatory No. 6

For each of Applicant's Products/Services identified in response to Interrogatory No. 5 above, identify:

(a) The date of first use for each of Applicant's Products/Services;

- (b) The period of time during which each of Applicant's Products/Services was or is being distributed, offered for sale, sold or rendered;
- (c) The geographic area(s) in which each of Applicant's Products/Services was or is being distributed, offered for sale sold or rendered;
- (d) The annual volume of sales for each year to the present, both by dollar amount and unit amount, for each of Applicant's Products/Serives;
- (e) Any other revenues, including, without limitation, any licensing or sponsorship revenues that Applicant has received in connection with each of Applicant's Products/Services;
- (f) The range of retail and wholesale price for each of Applicant's Products/Services for each year to the present;
- (g) The channels of trade (e.g., types of retail stores, catalogs, mail order, on-line, promotional sales, private sales, establishments, etc.) through which each of Applicant's Products/Services was or is being distributed or sold to the ultimate purchaser, consumer or user; and
- (h) The type of customers to whom each of Applicant's Products/Services is or was marketed, distributed, offered for sale, sold or rendered.

Response No. 6:

Applicant objects to this Interrogatory on the ground that it is overly broad and unduly burdensome.

Subject to and without waiving any General Objection or Specific Objection, Applicant answers as follows:

- (a) Applicant has not used its products or services yet;

- (b) Not applicable;
- (c) Not applicable;
- (d) Not applicable;
- (e) Not applicable;
- (f) Not applicable;
- (g) Not applicable;
- (h) Not applicable.

Interrogatory No. 7:

State whether any mark comprising or containing Applicant's Mark has been used or is intended to be used in connection with any indicia, designs, stylizations, terms, imagery, marks, logos, themes, or references similar to, related to, or associated or affiliated with Opposer, and if so describe the details of each such use or intended use.

Response No. 7:

Applicant objects to this Interrogatory on the ground that it is overly broad and unduly burdensome.

Subject to and without waiving any General Objection or Specific Objection, Applicant answers as follows: Applicant lacks knowledge or information sufficient to form a belief as to the fact whether any mark comprises or contains Applicant's Mark.

Interrogatory No. 8:

Identify any persons or entities that have ever, either orally or in writing, authorized, licensed, assigned, granted, conveyed or otherwise transferred to Applicant the right to use any mark comprising or containing Applicant's Mark, and for each such person or entity, identify the date of and material terms under which such authorization, license, assignment, grant,

conveyance or other transfer was made, including, without limitation, the details of the grant of rights to use Applicant's Mark and the financial terms governing such transaction.

Response No. 8:

Applicant objects to this Interrogatory on the ground that it is overly broad and unduly burdensome.

Subject to and without waiving any General Objection or Specific Objection, Applicant answers as follows: No.

Interrogatory No. 9:

Identify any persons or entities Applicant has authorized, licensed, assigned, granted, conveyed or otherwise transferred the right to use any mark comprising or containing Applicant's Mark, and for each such person or entity, identify the date of and material terms under which such authorization, license, assignment, grant, conveyance or other transfer of right to use was made, including, without limitation, the details of the grant of rights to use Applicant's Mark and the financial terms governing such transaction.

Response No. 9:

Applicant objects to this Interrogatory on the ground that it is overly broad and unduly burdensome.

Subject to and without waiving any General Objection or Specific Objection, Applicant answers as follows: No. Applicant lacks knowledge or information sufficient to form a belief as to the fact whether any mark comprises or contains Applicant's Mark.

Interrogatory No. 10:

Identify each website, web auction, web hosting, web listing, web posting, web page or social media page, whether owned by Applicant or third parties, including its Internet address, on

or through which Applicant's Mark and/or Applicant's Products/Services have been, are currently being or are intended to be promoted, advertised, displayed, offered for sale, sold or otherwise distributed.

Response No. 10:

Applicant objects to this Interrogatory on the ground that it is overly broad and unduly burdensome.

Subject to and without waiving any General Objection or Specific Objection, Applicant answers as follows: Applicant lacks knowledge or information sufficient to form a belief as to the fact whether such website, web auction, web hosting, web listing, web posting, web page or social media page alleged by Opposer in the Interrogatory ever exists.

Interrogatory No. 11:

(a) Identify each kind of advertising, marketing and other promotional materials, including, without limitation, point-of-sale material, signs, circular, flyer, poster, sticker, sales sheet, leaflet, brochure, catalog, sign, price list, on-line or email advertisement, print advertisement, radio or television advertisement, service order list or other advertising material or promotional item that has been used or is intended to be used in connection with Applicant's Products/Services and/or Applicant's Mark.

(b) For each promotional material referred to in subparagraph (a) above, identify where the promotional material is advertised, posted, promoted, published or distributed (e.g. name the publication, the URL for the website, the retail store, etc.);

Response No. 11:

Applicant objects to this Interrogatory on the ground that it is overly broad and unduly burdensome.

(a) Subject to and without waiving any General Objection or Specific Objection, Applicant answers as follows: Applicant lacks knowledge or information sufficient to form a belief as to the fact whether any kind of advertising, marketing and other promotional materials, including, without limitation, point-of-sale material, signs, circular, flyer, poster, sticker, sales sheet, leaflet, brochure, catalog, sign, price list, on-line or email advertisement, print advertisement, radio or television advertisement, service order list or other advertising material or promotional item that has been used or is intended to be used in connection with Applicant's Products/Services and/or Applicant's Mark.

(b) Subject to and without waiving any General Objection or Specific Objection, Applicant answers as follows: Applicant lacks knowledge or information sufficient to form a belief as to the fact whether and where, for each promotional material referred to in Interrogatory No. 11 subparagraph (a) above, the promotional material is advertised, posted, promoted, published or distributed.

Interrogatory No. 12:

(a) Describe each instance where any person has by word or deed or otherwise, including, without limitation, by misdirected mail, e-mail, telephone calls, orders or inquiries, suggested or reflected a belief that Applicant is licensed, endorsed or sponsored by or is a sponsor of Opposer, or that the products or services sold, offered for sale, or otherwise distributed or intended to be sold, offered for sale, or otherwise distributed by Applicant under Applicant's Mark are licensed, endorsed or sponsored by or associated with or related in any way to Opposer, and/or Opposer's Empire State Building Marks; and

(b) Identify all persons knowledgeable about any such instances referred to in subparagraph (a) above and describe the nature of their knowledge.

Response No. 12:

Applicant objects to this Interrogatory on the ground that it is overly broad and unduly burdensome.

(a) Subject to and without waiving any General Objection or Specific Objection, Applicant answers as follows: Applicant lacks knowledge or information sufficient to form a belief as to the fact whether any person has by word or deed or otherwise, including, without limitation, by misdirected mail, e-mail, telephone calls, orders or inquiries, suggested or reflected a belief that Applicant is licensed, endorsed or sponsored by or is a sponsor of Opposer, or that the products or services sold, offered for sale, or otherwise distributed or intended to be sold, offered for sale, or otherwise distributed by Applicant under Applicant's Mark are licensed, endorsed or sponsored by or associated with or related in any way to Opposer, and/or Opposer's Empire State Building Marks.

(b) Subject to and without waiving any General Objection or Specific Objection, Applicant answers as follows: Applicant lacks knowledge or information sufficient to form a belief as to the fact whether any person is knowledgeable about any such instances referred to in Interrogatory No. 12 subparagraph (a) above and what is the nature of their knowledge.

Interrogatory No. 13:

State whether Applicant has marketed or intends to market Applicant's Products/Services bearing or rendered in connection with Applicant's Mark or is aware that such products will be marketed to consumers of Opposer's goods or services, or to consumers located in or around New York, New York and, if so, describe the means by which Applicant has marketed or intends to market Applicant's Products/Services or how such products will be marketed, to consumers of Opposer's goods or services, or to consumers located in or around New York, New York.

Response No. 13:

Applicant objects to this Interrogatory on the ground that it is overly broad and unduly burdensome.

Subject to and without waiving any General Objection or Specific Objection, Applicant answers as follows: Applicant has not marketed the Applicant's Products/Services bearing or rendered in connection with Applicant's Mark anywhere in the world. Applicant, however, intends to market the Applicant's Products/Services bearing or rendered in connection with Applicant's Mark to consumers located in or around China and the United States *once the registration of the Applicant's Mark is approved by the United States Trade and Patent Office*. Applicant does not know at this time how the Applicant's Products/Services bearing or rendered in connection with Applicant's Mark will be marketed, to consumers of Opposer's goods or services, or to consumers located in or around New York, New York after the registration of the Applicant's Mark is approved by the United States Trade and Patent Office.

Interrogatory No. 14:

State whether Applicant was aware of Opposer, Opposer's Empire State Building Marks, and/or goods or services marketed, manufactured, distributed, offered for sale, sold, licensed or rendered by Opposer or under license from Opposer in connection with Opposer's Empire State Building Marks prior to:

- (a) January 8, 2011, when Applicant filed Application Serial No. 85/213,453.
- (b) Any use by Applicant of Applicant's Mark in connection with any goods or services.

Response No. 14:

Applicant objects to this Interrogatory on the ground that it is overly broad and unduly burdensome.

(a) Subject to and without waiving any General Objection or Specific Objection, Applicant answers as follows: Applicant was not aware of Opposer, Opposer's Empire State Building Marks, and/or goods or services marketed, manufactured, distributed, offered for sale, sold, licensed or rendered by Opposer or under license from Opposer in connection with Opposer's Empire State Building Marks with respect to beverage, liquor, or food industries prior to January 8, 2011, when Applicant filed Application Serial No. 85/213,453. Applicant lacks knowledge or information sufficient to form a belief as to the existence of Opposer, Opposer's Empire State Building Marks, and/or goods or services marketed, manufactured, distributed, offered for sale, sold, licensed or rendered by Opposer or under license from Opposer in connection with Opposer's Empire State Building Marks outside the industries of beverage, liquor, or food industries prior to January 8, 2011, when Applicant filed Application Serial No. 85/213,453 that is intended to be used in the beverage, liquor or food industries.

(b) Not applicable.

Interrogatory No. 15:

State whether Applicant has ever sought a license or other right to use any marks, logos, designs, stylizations or slogans, including without limitation, Opposer's Empire State Building Marks, from Opposer.

Response No. 15:

Applicant objects to this Interrogatory on the ground that it is overly broad and unduly burdensome.

Subject to and without waiving any General Objection or Specific Objection, Applicant answers as follows: No.

Interrogatory No. 16:

State whether Applicant has any documentation, including without limitation, business plans, marketing plans, memos, correspondence or draft proposals of any kind, reflecting Applicant's bona fide intention, prior to or as of January 8, 2011, to use Applicant's Mark in commerce in connection with each and every good identified in International Class 32 in Application Serial No. 85/213,453.

Response No. 10:

Applicant objects to this Interrogatory on the ground that it is overly broad and unduly burdensome.

Applicant does not understand what "each and every good" in the above interrogatory means.

Interrogatory No. 17:

With respect to each response to Opposer's First Set of Requests for Admissions that is anything other than an unqualified admission, state the basis for the response, including, without limitation, all facts and documents upon which the response is based.

Response No. 17:

Applicant objects to this Interrogatory on the ground that it is overly broad and unduly burdensome.

DOCUMENT REQUESTS

SPECIFIC OJECTIONS AND RESPONSES

Request No. 1:

Specimens of each of Applicant's Products/Services bearing or displaying any mark comprising or containing Applicant's Mark including, without limitation, each different color combination and each different product design or stylization of products in which Applicant's Mark is used or intended to be used by Applicant and/or its licensees, sponsors or related or affiliated entities.

Response No. 1:

Applicant objects to this Request on the grounds that it is overly broad, unduly burdensome, seeks documents not in the Applicant's possession, seeks documents already in the Opposer's possession, and seeks information not reasonably calculated to lead to the discovery of admissible evidence.

Subject to and without waiving any General Objection or Specific Objection, Applicant will produce responsive documents, if any, in their possession: None at this time.

Request No. 2:

Specimens of each label, hangtag, tag, product package, package insert, sticker, hologram, package material or other device which bears any mark comprising or containing Applicant's Mark, and which has been used or is intended to be used by Applicant and/or its licensees.

Response No. 2:

Applicant objects to this Request on the grounds that it is overly broad, unduly burdensome, seeks documents not in the Applicant's possession, seeks documents already in the Opposer's possession, and seeks information not reasonably calculated to lead to the discovery of admissible evidence.

Subject to and without waiving any General Objection or Specific Objection, Applicant will produce responsive documents, if any, in their possession: None at this time.

Request No. 3:

Specimens of each point-of-sale material, circular, flyer, poster, sticker, sales sheet, leaflet, brochure, catalog, sign, price list, on-line or email advertisement, print advertisement, radio or television advertisement, service order list or other advertising material or promotional item which bears any mark comprising or containing Applicant's Mark, and which has been used or is intended to be used by Applicant and/or its licensees.

Response No. 3:

Applicant objects to this Request on the grounds that it is overly broad, unduly burdensome, seeks documents not in the Applicant's possession, seeks documents already in the Opposer's possession, and seeks information not reasonably calculated to lead to the discovery of admissible evidence.

Subject to and without waiving any General Objection or Specific Objection, Applicant will produce responsive documents, if any, in their possession: None at this time.

Response No. 4:

All documents concerning Applicant's design, clearance, selection, and/or adoption of Applicant's Mark.

Response No. 4:

Applicant objects to this Request on the grounds that it is overly broad, unduly burdensome, seeks documents not in the Applicant's possession, seeks documents already in the Opposer's possession, and seeks information not reasonably calculated to lead to the discovery of admissible evidence.

Subject to and without waiving any General Objection or Specific Objection, Applicant will produce responsive documents, if any, in their possession: None at this time.

Request No. 5:

Specimens of each point-of-sale material, circular, flyer, poster, sticker, sales sheet, leaflet, brochure, catalog, sign, price list, on-line or email advertisement, print advertisement, radio or television advertisement, service order list or other advertising material or promotional item which bears any mark comprising or containing Applicant's Mark, and which has been used or is intended to be used by Applicant and/or its licensees.

Response No. 5:

Applicant objects to this Request on the grounds that it is overly broad, unduly burdensome, seeks documents not in the Applicant's possession, seeks documents already in the Opposer's possession, and seeks information not reasonably calculated to lead to the discovery of admissible evidence.

Subject to and without waiving any General Objection or Specific Objection, Applicant will produce responsive documents, if any, in their possession: None at this time.

Request No. 6:

Documents sufficient to identify: (a) the date of first use of Applicant's Mark; (b) the date of first use of Applicant's Mark in commerce; (c) the geographic area(s) of use of Applicant's Mark; (d) any and all customers, distributors or other persons or entities to which Applicant's Products/Services offered in connection with Applicant's Mark have been sold or distributed; (e) Applicant's Products/Services bearing, offered for sale, sold or otherwise distributed under Applicant's Mark; (f) all retail, wholesale, commercial, or charitable entities through which goods or services bearing or rendered in connection with Applicant's Mark have

been offered for sale, sold or otherwise distributed; (g) the channels of trade through which Applicant's Products/Services offered in connection with Applicant's Mark were or are being distributed or sold to the ultimate purchaser, consumer or user; (h) the annual volume of sales (in dollars and units) made under Applicant's Mark for each year from the date of first use to the present; and (i) the annual amount of revenue, including, without limitation, any licensing or sponsorship revenues that Applicant has received in connection with Applicant's Products/Services offered in connection with Applicant's Mark, for each year from the date of first use to the present.

Response No. 6:

Applicant objects to this Request on the grounds that it is overly broad, unduly burdensome, seeks documents not in the Applicant's possession, seeks documents already in the Opposer's possession, and seeks information not reasonably calculated to lead to the discovery of admissible evidence.

Subject to and without waiving any General Objection or Specific Objection, Applicant will produce responsive documents, if any, in their possession: Not applicable.

Requests No. 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, and 23:

Responses No. 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, and 23:

Applicant objects to this Request on the grounds that it is overly broad, unduly burdensome, seeks documents not in the Applicant's possession, seeks documents already in the Opposer's possession, seeks information already responded, and seeks information not reasonably calculated to lead to the discovery of admissible evidence.

Subject to and without waiving any General Objection or Specific Objection, Applicant will produce responsive documents, if any, in their possession: Not applicable and none.

There is not any confusion on the part of any member of the public between Opposer and Applicant and/or their respective marks and/or goods or services. For instance, U.S. Registration No. 1247058 with the work mark “NY” and the designed drawing that shows a “fanciful design of the **Empire State Building**” does not confuse any part of the member of the public where the owner of the U.S. Registration No. 1247058 Mark uses the Mark in the industries or areas in Skylines; Gravestones; Leaning Tower of Pisa; Space needle; Tombstones; Totem poles; Envelopes; Rectangles as carriers or rectangles as single or multiple lien borders and where Opposer uses its Empire State Building Marks in their registered areas of providing observation decks in a skyscraper for purposes of sightseeing and managing and leasing the real estate.

Dated: Flushing, New York
September 5, 2013

Law Offices of David Yan
Attorney for Applicant

by: /David Yan/
David Yan

136-20 38th Avenue, Suite 11E
Flushing, NY 11354
Tel.: (718) 888-7788

REQUESTS FOR ADMISSIONS

Request No. 1

Admit that Opposer's Empire State Building Marks are famous.

Request No. 2

Admit that Opposer's Empire State Building Marks were famous prior to:

- (a) January 8, 2011, when Applicant filed Application Serial No. 85/213,453.
- (b) Any use by Applicant of Applicant's Mark in connection with any goods or services.

Request No. 3

Admit that Opposer's Empire State Building Marks are closely identified and associated with Opposer's goods and services.

Request No. 4

Admit that Applicant was aware of Opposer's Empire State Building Marks prior to:

- (a) January 8, 2011, when Applicant filed Application Serial No. 85/213,453.
- (b) Any use by Applicant of Applicant's Mark in connection with any goods or services.

Request No. 5

Admit that Applicant was aware of goods or services marketed, manufactured, distributed, offered for sale, sold, licensed or rendered by Opposer or under license from Opposer in connection with Opposer's Empire State Building Marks prior to:

- (c) January 8, 2011, when Applicant filed Application Serial No. 85/213,453.
- (d) Any use by Applicant of Applicant's Mark in connection with any goods or services.

Request No. 6

Admit that Applicant's services covered by Application No. 85/213,453 are marketed or intended to be marketed to consumers of Opposer's goods and/or services.

Request No. 7

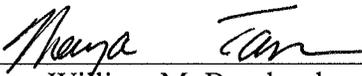
Admit that Applicant has no connection with Opposer and has no authorization from Opposer to use the building design in Applicant's Mark.

Request No. 8

Admit that Applicant intended the building design in Applicant's Mark to resemble the Empire State Building.

Dated: New York, New York
February 19, 2013

COWAN, LIEBOWITZ & LATMAN, P.C.
Attorneys for Opposer

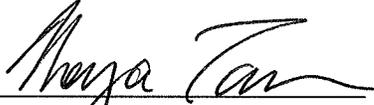
By: 
William M. Borchard
Mary L. Kevlin
Maya L. Tarr

1133 Avenue of the Americas
New York, New York 10036
212-790-9200

CERTIFICATE OF SERVICE

I hereby certify that, on February 19, 2013, I caused a true and complete copy of the foregoing *Opposer's First Set of Requests for Admissions* to be served by First Class Mail to Applicant's Attorney and Correspondent of Record, David Yan, Law Offices of David Yan, 136-20 38th Avenue, Suite 11E, Flushing, New York 11354 4232, United States.

Dated: New York, New York
February 19, 2013



Maya L. Tarr

AFFIRMATION OF SERVICE

I hereby certify that, on September 6, 2013, I caused a true and complete copy of the foregoing Applicant's Response to the Opposer's First Set of Interrogatories and Request for Production of Documents and Things to be served by electronic mail in PDF Format to Opposer's counsel of record, William M. Borchard, Esquire of Cowan Liebowitz, & Latman, P.C., at his email address of at WMB@cll.com.

/David Yan/

David Yan

AFFIRMATION OF SERVICE

I hereby certify that, on September 6, 2013, I caused a true and complete copy of the foregoing Applicant's Response to the Opposer's First Set of Requests for Admissions and Applicant's Response to the Opposer's First Set of Interrogatories and Request for Production of Documents and Things to be sent by the U.S. Post First Class Mail, postage prepared, to the Opposer's Counsel of Record, William M. Borchard, Esquire, Cowan Liebowitz, & Latman, P.C., located at 1133 Avenue of the Americas, New York, NY 10278

/David Yan/

David Yan

EXHIBIT I

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

In re Application Serial No. 85/213,453
Filed: January 8, 2011
For Mark: NYC BEER LAGER and Design
Published in the Official Gazette: December 6, 2011

----- X
: EMPIRE STATE BUILDING COMPANY L.L.C., :
: :
: Opposer, :
: :
: v. : Opposition No.: 91204122
: :
: MICHAEL LIANG, :
: :
: Applicant. :
: :
----- X

Commissioner for Trademarks
Attn: Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

**APPLICANT’S RESPONSE
TO OPPOSER’S FIRST SET OF REQUESTS FOR ADMISSIONS**

Pursuant to Rule 36 of the Federal Rules of Civil Procedure and 37 C.F.R. § 2.120,
Applicant, MICHAEL LIANG (“Applicant”), by and through his undersigned attorney, hereby
submit responses and objections to Opposer Empire State Building Company L.L.C.
 (“Opposer”)’s First Set of Requests for Admissions:

GENERAL OBJECTIONS

The following General Objections are incorporated into each Specific Objection and
Response below as if set forth in full responses to each individually numbered response. The

failure to specifically incorporate a General Objection shall not be construed as a waiver of the same.

1. Applicant objects to each and every Request for Admissions herein to the extent that it seeks information or documents protected by any privilege or protection from discovery, including but not limited to the attorney-client privilege and the work-product doctrine. The inadvertent production of any material protected by the attorney-client privilege, the work-product doctrine or any other applicable privilege, immunity or protection from disclosure is not intended and should not be construed to constitute a waiver. Applicant reserves the right to assert all applicable privileges and protections from production.
2. Applicant objects to each and every Request for Admissions to the extent that it seeks to impose requirements that are inconsistent with, or beyond those contemplated by, the Federal Rules of Civil Procedure and/or the Code of Federal Regulations.
3. Applicant objects to each and every Request for Admissions to the extent that the definitions, instructions, or specific requests are vague, ambiguous, overly broad, and/or unduly burdensome.
4. Applicant objects to each and every Request for Admissions to the extent that it seeks information that is a matter of public record or equally available to Opposer.
5. Applicant objects to each and every Request for Admissions to the extent that it calls for an expert opinion on the ground that it violates the work-product doctrine.

6. Applicant objects to each and every Request for Admissions to the extent that it seeks Applicant confidential and proprietary information, the disclosure of which will or may cause harm to Applicant.
7. Applicant objects to each and every Request for Admissions as overly broad, unduly burdensome, and oppressive, insofar as it seeks information which is in the custody, possession, or control of Opposer or its agents, or is equally available to the public.
8. Applicant objects to each and every Request for Admissions to the extent that it is overly broad, unduly burdensome, and oppressive, where the Request for Admissions requests the identification of “all” documents when all relevant facts can be obtained from fewer than “all documents.”
9. Applicant objects to each and every Request for Admissions to the extent that it is overly broad and unduly burdensome by requesting documents that are neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.
10. Applicant objects to each and every Request for Admissions to the extent that it is vague or ambiguous.
11. Applicant objects to each and every Request for Admissions to the extent that it is overly broad, unduly burdensome, or oppressive.
12. Applicant objects to each and every Request for Admissions to the extent that it requires Plaintiff to produce documents not within Applicant’s possession, custody, or control. Unless otherwise specified, Applicant will not produce any

documents in the possession, custody, and control of any third party, including any agent or outside attorney of Applicant.

13. Applicant objects to each and every Request for Admissions to the extent that it seeks information without any limitation to the time period relevant to this action.
14. In making these objections, Applicant does not in any way waive, or intend to waive, but rather intend to preserve and are preserving.
15. All objections as to competency, relevancy, materiality, and admissibility of any information that may be provided in response to the Request for Admissions, or the subject matter thereof.
16. All rights to object on any ground to the use of any information that may be provided in response to the Request for Admissions, or the subject matter thereof, in any subsequent proceedings, including the trial of this or any other matter.
17. All rights to object on any ground to any request for further responses to the Request for Admissions or any other document request.
18. Applicant's objections herein and the production of any documents by Applicant pursuant to any Request for Admissions are not intended to waive or prejudice any objections or privileges Applicant may later assert, without limitation.
19. Applicant reserves the right to supplement, amend, correct, or clarify the responses and objections to the Request for Admissions.

In addition to the General Objections set forth above, Applicant sets forth below Specific Objections to individual requests where appropriate, including objections that are not generally applicable to all of the requests. By setting forth such Specific Objections, Applicant does not

intend to limit the General Objections set forth above. To the extent that Applicant responds to requests to which they object, such objections are not waived by a response.

The information provided herein is based upon, and is therefore limited by, the records and information in existence, presently collected and thus far discovered in the course of the preparation of these responses.

**SPECIFIC OBJECTIONS AND RESPONSES
TO DEFENDANTS' REQUESTS FOR ADMISSION**

Request No. 1:

Admit that Opposer's Empire State Building Marks are famous.

Response No. 1:

Applicant objects to this Request for Admissions on the ground that it is overly broad and unduly burdensome.

Subject to and without waiving any General Objection or Specific Objection, Applicant answers as follows:

- (a) Deny that Opposer's Empire State Building Marks are famous in general.
- (b) Noticed from the Opposer's "Notice of Opposition", Applicant admits that the word mark and design mark of "Empire State Building" is the registered mark on December 12, 2000 with the U.S. Patent and Trademark Office under the U.S. Registration No. 2411972 for the goods/services of "Class 041 . . . entertainment services, namely providing observation decks in a skyscraper for purposes of sightseeing."
- (c) Noticed from the Opposer's "Notice of Opposition", Applicant admits that the word mark and design mark of "Empire State Building" is the registered mark on December 19, 2000 with the U.S. Patent and Trademark Office under the U.S. Registration No. 2413667 for the

goods/services of “Class 036 . . . Real estate services, namely the management and leasing of real estate.”

(d) Noticed from the Opposer’s “Notice of Opposition”, Applicant admits that the design mark containing a logo of skyscraper of a building so unique to its own drawing and without any reference to any words or typed drawing of “Empire State Building” is the registered mark on February 20, 2001 with the U.S. Patent and Trademark Office under the U.S. Registration No. 2429297 for the goods/services of “Class 036 . . . Real estate services, namely the management and leasing of real estate.”

(e) Noticed from the Opposer’s “Notice of Opposition”, Applicant admits that the design mark containing a logo of skyscraper of a building so unique to its own drawing and without any reference to any words or typed drawing of “Empire State Building” is the registered mark on February 27, 2001 with the U.S. Patent and Trademark Office under the U.S. Registration No. 2430828 for the goods/services of “Class 041 . . . entertainment services, namely providing observation decks in a skyscraper for purposes of sightseeing.”

(f) Deny that the Opposer’s Empire State Building Marks are famous for the goods/services of Alcohol-free beers; Beer; Beer, ale and lager; Beer, ale and porter; Beer, ale, lager, stout and porter; Beer, ale, lager, stout, porter, shandy; Beers; Black beer; Brewed maltbased alcoholic beverage in the nature of a beer; Coffee-flavored beer; De-alcoholised beer; Extracts of hops for making beer; Flavored beers; Ginger beer; Hop extracts for manufacturing beer; Imitation beer; Malt beer; Malt extracts for making beer; Malt liquor; Non-alcoholic beer; Pale beer; Porter
Intent to Use: The applicant has a bona fide intention to use or use through the applicant’s related company or licensee the mark in commerce on or in connection with the identified goods and/or services.

(g) Deny that Opposer's Empire State Building Marks are famous at least in the area of skylines, gravestones, leaning tower of pisa, space needle, tombstones, totem poles, envelopes, rectangles as carriers or rectangles as single or multiple line borders where New York Envelope Corp. is the Registrant of the word mark, "NY" with the designed drawing of a logo that shows a fanciful design of the **Empire State Building** surrounded by smaller buildings and envelopes and the letters "N" and "Y" in a rectangle, which has a U.S. Registration No. 1247058.

Request No. 2:

Admit that Opposer's Empire State Building Marks were famous prior to:

- (a) January 8, 2011, when Applicant filed Application Serial No. 85/213,453.
- (b) Any use by Applicant of Applicant's Mark in connection with any goods or services.

Response No. 2:

Applicant objects to this Request for Admissions on the ground that it is overly broad and unduly burdensome.

Subject to and without waiving any General Objection or Specific Objection, Applicant answers as follows:

- (a) Deny in general and same qualified response as Response No. 1.
- (b) Not applicable and same qualified response as Response No. 1.

Request No. 3:

Admit that Opposer's Empire State Building Marks are closely identified and associated with Opposer's goods and services.

Response No. 3:

Applicant objects to this Request for Admissions on the ground that it is overly broad and unduly burdensome.

Subject to and without waiving any General Objection or Specific Objection, Applicant answers as follows:

- (a) Applicant does not understand the Opposer's Request for Admissions because the term "Opposer's goods and services" is vague and not defined anywhere by Opposer.
- (b) Applicant admits to the extent that Opposer's Empire State Building Marks are identified and associated with goods and services in the Opposer's self-serving statements in the U.S. Registration No. 2411972, 2413667, 2429297, and 2430828.

Request No. 4:

Admit that Applicant was aware of Opposer's Empire State Building Marks prior to:

- (a) January 8, 2011, when Applicant filed Application Serial No. 85/212,453.
- (b) Any use by Applicant of Applicant's Mark in connection with any goods or services.

Response No. 4:

Applicant objects to this Request for Admissions on the ground that it is overly broad and unduly burdensome.

Subject to and without waiving any General Objection or Specific Objection, Applicant answers as follows:

- (a) Admit.

- (b) This Request is not applicable because Applicant has not used the Applicant's Mark pending the final approval and registration of the Applicant's Mark.

Request No. 5:

Admit that Applicant was aware of goods or services marketed, manufactured, distributed, offered for sale, sold, licensed or rendered by Opposer or under license from Opposer in connection with Opposer's Empire State Building Marks prior to:

- (c) January 8, 2011, when Applicant filed Application Serial No. 85/212,453.
- (d) Any use by Applicant of Applicant's Mark in connection with any goods or services.

Response No. 5:

Applicant objects to this Request for Admissions on the ground that it is overly broad and unduly burdensome.

Subject to and without waiving any General Objection or Specific Objection, Applicant answers as follows:

- (c) Deny, except for admitting that Applicant is aware of the sightseeing services in the observation decks in the Empire State Building.
- (d) This Request is not applicable because Applicant has not used the Applicant's Mark pending the final approval and registration of the Applicant's Mark.

Request No. 6:

Admit that Applicant's services covered by Application No. 85/213,453 are marketed or intended to be marketed to consumers of Opposer's goods and/or services.

Response No. 6:

Applicant objects to this Request for Admissions on the ground that it is overly broad and unduly burdensome.

Subject to and without waiving any General Objection or Specific Objection, Applicant answers as follows:

Applicant does not understand the Opposer's Request for Admissions because the term "Opposer's goods and services" is vague and not defined anywhere by Opposer. Applicant does not understand the Opposer's Request for Admissions because Applicant does not know who are consumers of Opposer's goods and services.

Request No. 7:

Admit that Applicant has no connection with Opposer and has no authorization from Opposer to use the building design in Applicant's Mark.

Response No. 7:

Applicant objects to this Request for Admissions on the ground that it is overly broad and unduly burdensome.

Subject to and without waiving any General Objection or Specific Objection, Applicant answers as follows:

- (a) Admit that Applicant has no connection with Opposer.
- (b) Admit that Applicant has no authorization from Opposer to use its building design registered in the U.S. Patent and Trademark Office. Applicant, however, has not used the Opposer's the building design registered in the U.S. Patent and Trademark Office in the Applicant's Mark.

Request No. 8:

Admit that Applicant intended the building design in Applicant's Mark to resemble the Empire State Building.

Response No. 8:

Applicant objects to this Request for Admissions on the ground that it is overly broad and unduly burdensome.

Subject to and without waiving any General Objection or Specific Objection, Applicant answers as follows:

- (a) Admit.
- (b) The building design in Applicant's Mark is not the Empire State Building.

Dated: Flushing, New York
September 5, 2013

Law Offices of David Yan
Attorney for Applicant

by: /David Yan/
David Yan

136-20 38th Avenue, Suite 11E
Flushing, NY 11354
Tel.: (718) 888-7788

AFFIRMATION OF SERVICE

I hereby certify that, on September 5, 2013, I caused a true and complete copy of the foregoing Applicant's Response to the Opposer's First Set of Requests for Admissions to be served by electronic mail in PDF Format to Opposer's counsel of record, William M. Borchard, Esquire of Cowan Liebowitz, & Latman, P.C., at his email address of at WMB@c11.com.

/David Yan/

David Yan

EXHIBIT J

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: September 19, 2013

Opposition No. 91204122

Empire State Building
Company L.L.C.

v.

Michael Liang

Karl Kochersperger, Paralegal Specialist:

Proceedings herein are *suspended* pending disposition of opposer's motion for sanctions (filed September 11, 2013). Any paper filed during the pendency of this motion which is not relevant thereto will be given no consideration. See Trademark Rule 2.127(d).

On September 6, 2013, applicant filed its responses to opposer's first set of requests for admissions and opposer's first set of interrogatories and request for production of documents and things that were apparently served on counsel for opposer, with the Board.

Applicant is advised that

[r]equests for discovery, responses thereto, and materials or depositions obtained through the discovery process should not be filed with the board except when submitted with a motion relating to discovery, or in support of or response to a motion for summary judgment, or under a notice of reliance during a party's testimony period. Papers or materials filed in violation of this paragraph may be returned by the Board.

Trademark Rule 2.120(j)(8).

Accordingly, applicant's discovery responses will be disregarded by the Board, and shall not be considered of record by the parties for any purpose, unless hereafter properly submitted.¹

¹ To avoid the additional burden to the Board, we will not return applicant's papers in this case.