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

Proceeding	91204897
Party	Defendant Laguna Lakes Community Association, Inc.
Correspondence Address	DONNA M FLAMMANG BRENNAN MANNA & DIAMOND PL 3301 BONITA BEACH RD STE 100 BONITA SPRINGS, FL 34134-7833 UNITED STATES dmflammang@bmdpl.com, crothschild@bmdllc.com, wsharders@bmdllc.com
Submission	Opposition/Response to Motion
Filer's Name	Chad R. Rothschild
Filer's e-mail	crothschild@bmdllc.com
Signature	/s/ Chad R. Rothschild
Date	08/27/2013
Attachments	Response to Second Motion to Extend.pdf(29996 bytes) Exhibit A - Amended Notice of Deposition.pdf(25469 bytes) Exhibit B - nod4.pdf(49383 bytes) Exhibit C.pdf(43714 bytes) Exhibit D.pdf(99321 bytes) Exhibit E.pdf(67588 bytes)

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

John Gerard Marino,)	
)	Consolidated Opp. No. 91/204,897
Opposer,)	91/204,941
)	
v.)	OPPOSITION TO JOHN GERARD
)	MARINO’S SECOND MOTION TO
Laguna Lakes Community Association,)	EXTEND DISCOVERY CUTOFF IN
Inc.,)	THIS MATTER
)	
Applicant.)	

I. The Discovery Motion Should Be Summarily Denied.

On August 15, 2013, after a series of frivolous discovery motions, the Board issued an Order directing Opposer’s counsel to telephonically contact the interlocutory attorney before filing “another discovery motion.” 8/15/13 Board Order at p. 3 (emphasis added). The intent was to give the Board an opportunity to “independently ascertain whether the filing of such a motion is appropriate under Board rules and regulations.” *Id.* The Board warned that if Opposer filed a discovery motion without contacting the interlocutory attorney, “such motion will be summarily denied.” *Id.* (emphasis added).

As discovery closed, late last night Opposer’s counsel filed his most recent discovery motion captioned “JOHN GERARD MARINO’S SECOND MOTION TO EXTEND DISCOVERY CUTOFF IN THIS MATTER” (the “Discovery Motion”) without first contacting Applicant’s counsel and, on information and belief, without contacting the interlocutory attorney.

Because Opposer’s counsel filed the Discovery Motion without an advance Board determination of appropriateness, the Board should deny the Discovery Motion summarily in accordance with its 8/15/13 Order.

II. The Board May Also Deny the Discovery Motion on the Merits.

Opposer offers absolutely no support for his two slim paragraphs alleging failures by Applicant. *See, e.g.* Discovery Motion at ¶¶2-3 (advancing the entirely unsubstantiated claims that: (1) Applicant’s corporate 30(b)(6) witness “had little or no knowledge of most of the areas requested”; (2) Opposer still has not received “full discovery responses”; and (3) Applicant’s counsel “has refused ... to set up” a phone conference with the Board). All of these unsubstantiated claims are simply not true. As such, Opposer wholly fails to satisfy his burden and the Discovery Motion should be denied.

First, Applicant’s Rule 30(b)(6) witness was the President of its board of directors, a fact known to Opposer. *See* Discovery Motion at ¶ 3. The basis for the assertion that its President “had little or no knowledge of most of the areas requested” – or even which of the 13 noticed topics¹ are encompassed by “most” of the areas – is left completely to the reader’s speculation. Likewise, there is no transcript of the Rule 30(b)(6) deposition to substantiate any of the claims made by Opposer. Evidently, rather than raise legitimate concerns, Opposer’s objection appears to be a blatant attempt to breathe new life into a tactic already disapproved by the Board; that is, an attempt to compel the deposition of Applicant’s attorney. The Board should not permit such gamesmanship, if only because Opposer is not entitled to select Applicant’s Rule 30(b)(6) witness in the first instance. *See, e.g., Wyeth v. Lupin Ltd.*, 252 F.R.D. 295, 296 (D. Md. 2008) (“[The depositing party], of course, cannot dictate to [the noticed corporation] whom it should produce as its 30(b)(6) designee.”).

Second, Opposer attaches his first attempt, even though responses were served upon him some five (5) months ago, to narrow the alleged discovery deficiencies to his Discovery Motion. On its face, the Discovery Motion inexplicably fails to mention that this belated attempt to

¹ *See* Exhibit A to Re-Notice of Taking Depositions (attached hereto as Exhibit B).

narrow by Opposer was only done two (2) business days ago following the deposition of Opposer. *See* 8/22/13 E-mail from Attorney Behren (attached as Exhibit C).² Opposer also deceptively fails to mention that despite the incredibly recent vintage nature of his attempt to narrow, Applicant has already in good faith informed opposing counsel that supplements are being prepared. *See* 8/23/13 E-mail from Attorney Harders (attached as Exhibit D); 8/26/13 E-mail from Attorney Rothschild (attached as Exhibit E).

Third, Opposer provides absolutely no support for the baseless proposition that Applicant has refused anything, notwithstanding that Applicant would be justified in declining to unilaterally “set up” Board conferences at the Opposer’s demand. Indeed, in this case, the Board has gone to the lengths of specifically providing the interlocutory attorney’s name and phone in its Order with instruction that “opposer’s counsel must first telephonically contact the assigned interlocutory attorney” before filing discovery motions, something which – with time running out in the discovery period – opposing counsel wholly failed to do here. To the contrary, the evidence demonstrates the good faith willingness of Applicant and its counsel to work with Opposer (notwithstanding Opposer’s last minute rush to complete discovery caused by his own failure to initiate discovery earlier).

Quite simply, Opposer fails to make even “the minimum showing necessary to establish good cause to support an extension of the discovery period for any length of time” for the same reasons as previously determined – namely that Opposer’s own lack of diligence in failing to commence discovery earlier is no one’s fault but his own. *See* 8/15/13 Board Order at pp. 6-7; *see also Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147 (TTAB 1985) (which, in accordance with, Opposer must demonstrate that the requested extension is not necessitated by Opposer’s own lack of diligence or unreasonable delay, and under which

² *See also* Amended Notice of Deposition (attached hereto as Exhibit A).

Opposer, as the moving party, retains the burden of persuading the Board that it was diligent in meeting its responsibilities). Opposer wholly fails to satisfy this burden. Indeed, it is not Applicant's fault that Opposer did not initiate discovery earlier. Nor is it Applicant's fault that Opposer waited until the eve of the discovery cutoff to identify purported discovery issues – something he could have done months ago to obviate the need for yet another discovery motion.

Accordingly, the Board should deny the Discovery Motion.

III. Conclusion.

For each and every one of the foregoing reasons, Applicant respectfully requests that the Board issue an Order denying the Discovery Motion. First, the Discovery Motion should be summarily denied for failure of Opposer to comply with the Board's 8/15/13 Order. Second, the Board may also deny the Discovery Motion on the merits for lack of good cause and the failure of Opposer to satisfy his burden as the moving party.

Respectfully submitted,

/s/ Chad R. Rothschild

W. Scott Harders (Ohio Bar No. 0070598)
Donna M. Flammang (Florida Bar No. 0015230)
Chad R. Rothschild (Ohio Bar No. 0088122)

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Attorneys for Applicant

Dated: August 27, 2013

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

John Gerard Marino,)	
)	
Opposer,)	Consolidated Opp. No. 91/204,897
)	91/204,941
)	
v.)	<u>AMENDED NOTICE OF</u>
)	<u>DEPOSITION OF OPPOSER, JOHN</u>
Laguna Lakes Community Association,)	<u>GERARD MARINO</u>
Inc.,)	
)	
Applicant.)	

Applicant, Laguna Lakes Community Association, Inc., by and through counsel, hereby provides notice that it will take the deposition of Opposer, John Gerard Marino, on Thursday, August 22, 2013, beginning at 10:00 am at the offices of Von Ahn Associates, Inc, 13241 University Drive, Suite 104, Ft. Myers, FL 33907. The deposition will be conducted by stenography before an officer authorized to administer oaths, and in accordance with the TTAB rules.

On behalf of Applicant, attorneys W. Scott Harders and Chad R. Rothschild will be participating by telephone; attorney Richard S. Annunziata will be participating in person. Said deposition is intended for both discovery and evidence at trial, and may be used for all purposes permitted by law. All parties are hereby notified and invited to attend and participate.

Respectfully submitted,

/s/ Chad R. Rothschild

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Donna M. Flammang (Florida Bar No. 0015230)
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UNITED STATES PATENT AND TRADEMARK
OFFICE-Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Opposition No: 91204897
Opposition No: 91204941

JOHN G. MARINO

vs.

LAGUNA LAKES COMMUNITY
ASSOCIATION, INC.

_____ /

RE-NOTICE OF TAKING DEPOSITIONS

PLEASE TAKE NOTICE that the undersigned will take the deposition of:

<u>Name</u>	<u>Date</u>	<u>Time</u>
Corporate Rep of Laguna Lakes Community Association, Inc. With the Most Knowledge of all Complaints Answers, and Affirmative Defenses and all issues on the Attached Exhibit "A"	August 23, 2013	10:00 a.m.
Patrick Tardiff		1:00 p.m.
Jeff Kelly		2:00 p.m.
Mary Ann Cowart		3:00 p.m.
Bob Hajcek		4:00 p.m.

Exhibit B

upon oral examination before an officer qualified to administer oaths at the offices of Von Ahn Associates Court Reporting, 13241 University Drive, Suite 104, Ft. Myers, FL 33907 for the above-styled cause. The deposition shall be conducted pursuant to local rules and shall continue day to day, weekends and holidays excepted, until completed.

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true and correct copy of the foregoing was e-mailed this 16 day of August 2013 to: Chad Rothschild, Esq. and Donna Flammig, Esq., Brennan, Manna & Diamond, LLC, 75 East Market St. | Akron, OH 44308.

Behren Law Firm
2893 Executive Park Drive, Suite 110
Weston, FL 33331
(954) 636-3802
(772) 252-3365 - fax
scott@behrenlaw.com

By: / Scott M. Behren/
Scott M. Behren
Fla. Bar No. 987786

Exhibit "A"

1. The first use of the marks applied for with the USPTO.
2. The information contained on the application to the USPTO.
3. The use of the sought trademark in interstate commerce.
4. The reason for seeking the marks.
5. Marino's use of the marks or name Laguna Lakes or Mr. Laguna Lakes.
6. Whether any transfer of the marks was ever made by Transeastern Homes or any TOUSA entity.
7. Any likelihood of confusion between the marks of Laguna and Marino.
8. Whether the sought marks is geographically descriptive.
9. The use of the sought marks by other entities in the U.S.
10. Any profits earned by Laguna by the use of the sought marks.
11. Person with the most knowledge of documents responsive to the Request for Production.
12. Person with most knowledge of the answers to interrogatories.
13. Person with the most knowledge of responses to Request for Admissions.

Chad Rothschild

From: Scott behren <scott.behren@gmail.com>
Sent: Thursday, August 22, 2013 12:27 PM
To: Chad Rothschild
Cc: W. Scott Harders; Donna Flammang; Work Work Behren; Schedule
Subject: Marino and Laguna Lakes
Attachments: Marino Discovery Document.docx

Chad:

Attached please find my summary of my efforts to resolve discovery disputes between us as to your responses to our written discovery. I have narrowed down the requests and attempted to resolve each request with you.

Tomorrow at the deposition, we can confer further and if unable to reach agreement on each of these issues, we can then call the Board Attorney as recently ordered by him.

Feel free to e-mail me later today or tonight if you wish to discuss further.

--

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Twitter: Flaemploylaw

Chad Rothschild

From: W. Scott Harders
Sent: Friday, August 23, 2013 7:11 PM
To: Scott Behren
Cc: Donna Flammang; Work Work Behren; Richard S. Annunziata; Chad Rothschild
Subject: Depo follow-up Marino - Laguna Lakes

Mr. Behren - I write to follow up on just a few points in addressed as we were winding up the depositions this afternoon.

First, as to the good faith effort to resolve discovery issues that you finally sent to us yesterday afternoon in the midst of these depositions, we will supplement the narrowed issues you have identified but will not be able to complete over the weekend. Indeed we may need to review the approved deposition transcript of Mr. Tardiff who you deposed extensively on the subject to ensure consistency. To the extent we can provide other materials sooner, we will do so.

Second, we have identified two of the four depositions, namely those of Msrs. Tardiff and Hajicek as subject to the board's standard AND automatic protective order under the middle classification - Highly Confidential - shielded from public access or disclosure as they contain sensitive, non-public information regarding the applicant Board's operations.

Third, on Monday we will try to arrange a call with the interlocutory attorney for next week. As I reflect on it, I'm not sure there is any disagreement at this point except perhaps on your renewed interest in taking the deposition of applicant's attorney Flammang. And that sole issue will be hotly contested and is not amenable to resolution on a call with the attorney. We should discuss next week.

Scott

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Chad Rothschild

From: Chad Rothschild
Sent: Monday, August 26, 2013 7:05 PM
To: scott.behren@gmail.com; scott@behrenlaw.com
Cc: Donna Flammang; W. Scott Harders
Subject: RE: Marino v. Laguna Lakes
Attachments: Laguna Lakes 2nd set of Rogs, RFP and RFA to Marino 8.26.12.pdf; 8.26.13 service letter to Behren.pdf; Laguna Lakes 2nd set of Rogs, RFP and RFA to Marino 8.26.12.pdf

Scott,

Please find attached a few discovery requests to follow-up on last week's depositions.

In addition, we have reviewed Mr. Marino's Responses to Applicant's First Set of Discovery and noticed some deficiencies. One deficiency we hope you can immediately supplement is Request for Production No. 6: "Please produce, for the period Opposer seeks to rely upon in support of his Opposition, to date, all documents showing, concerning, evidencing, relating or referring to the organization or implementation of Opposer's Advertising program, including without limitation, documents identifying: (a) the date, (b) the place, (c) the monetary amount expended, (d) the class of customers to whom the Advertising or promotional materials were or are directed, (e) the number of copies of such materials, and (f) the names and addresses of each Person, advertising agency, public relations firm, or any other business entity hired or retained in connection with such Advertisements."

Mr. Marino responded that "responsive documents will be produced." However, we have not received any such information. Please provide us with copies of these responsive documents as soon as possible.

As a final note, now that the depositions from last week have concluded and the weekend is over, the Laguna Lakes Community Association is diligently working to help resolve the narrowed discovery issues you have identified.

Thanks,
Chad