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

Proceeding	91205331
Party	Defendant Kerry Earnhardt, Inc.
Correspondence Address	D BLAINE SANDERS ROBINSON BRADSHAW & HINSON PA 101 N TRYON ST, SUITE 1900 CHARLOTTE, NC 28246-0106 UNITED STATES dsanders@rbh.com, mtiley@rbh.com
Submission	Motion to Compel Discovery
Filer's Name	Suzanne Warfield
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Signature	/Suzanne Warfield/
Date	02/27/2013
Attachments	Applicant's Motion to Compel Discovery with Exhibits.pdf (38 pages)(2985218 bytes)

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

TERESA H. EARNHARDT,

Opposer,

v.

KERRY EARNHARDT, INC.,

Applicant.

Opposition No.: 91205331 (parent)

Application Serial No. 85/383,910

Trademark: EARNHARDT COLLECTION
(Intl. Class 20)

TERESA H. EARNHARDT,

Opposer,

v.

KERRY EARNHARDT, INC.,

Applicant.

Opposition No.: 91205338

Application Serial No. 85/391,456

Service Mark: EARNHARDT COLLECTION
(Intl. Class 37)

APPLICANT'S MOTION TO COMPEL DISCOVERY

Applicant, Kerry Earnhardt, Inc., ("KEI") herby moves for an order requiring Opposer, Teresa H. Earnhardt, ("Ms. Earnhardt" or "Opposer"), to produce documents responsive to Applicant's First Request for Production of Documents. Because of the nature of the motion, this pleading also will serve as KEI's brief. As grounds for this motion, KEI shows as follows:

1. On November 19, 2012, KEI served Ms. Earnhardt's counsel with Applicant's First Request for Production of Documents (the "Request for Production"), attached hereto as **Exhibit A**. Ms. Earnhardt, through counsel, subsequently requested, and KEI agreed, to extend the time for Ms. Earnhardt to respond to KEI's Request for Production through January 24, 2013.

2. On January 24, 2013, Ms. Earnhardt's counsel served her Response to Applicant's First Request for Production of Documents, attached hereto as **Exhibit B**. In that response, Ms. Earnhardt's counsel purported to object to producing documents at the time and place specified

in the Request for Production. Ms. Earnhardt's counsel, however, provided no grounds for such objection and did not indicate when she would produce the requested documents.

3. On January 28, 2013, KEI's counsel contacted Ms. Earnhardt's counsel to inquire about Ms. Earnhardt's document production and the basis for her purported objection. On January 29, 2013, Ms. Earnhardt's counsel informed KEI that Ms. Earnhardt and her counsel had not yet reviewed and prepared the responsive documents for production and that they would produce responsive documents as Ms. Earnhardt and her counsel made them ready.

4. On February 6, 2013, Ms. Earnhardt's counsel made a partial, incomplete production of responsive documents. This production consisted of a few thousand pages, but this volume was attributable predominately to a single category of documents—multiple license agreements. Although the production did not include all responsive documents, Ms. Earnhardt's counsel did not disclose that the production was incomplete until February 11, 2013—*only after* KEI's counsel again inquired whether Ms. Earnhardt had provided all responsive documents in her possession. In response to that request, Ms. Earnhardt's counsel stated that Ms. Earnhardt herself possessed an unspecified number of additional responsive documents, but that she had not provided these documents to her counsel and they thus had not been produced. Despite KEI's request that they do so, Ms. Earnhardt's counsel stated that they could not provide a date by which Ms. Earnhardt would produce the remaining responsive documents in her possession.

5. KEI's counsel repeatedly has sought to secure Ms. Earnhardt's production of the remaining responsive documents in her possession, but to no avail:

a. On February 13, 2013, KEI's counsel wrote Larry C. Jones, lead counsel for Ms. Earnhardt, requesting that he provide a date by which Ms. Earnhardt would produce the remaining documents in her possession. (*See* Letter from D. Blaine Sanders to Larry C. Jones, dated February 13, 2013, attached hereto as **Exhibit C.**) On February 19, 2013, Mr. Jones responded, stating only that Ms. Earnhardt had not provided her counsel with the remaining

responsive documents. Mr. Jones, however, failed to provide any indication as to whether or when Ms. Earnhardt would produce the remaining responsive documents in her possession. (See E-mail from Larry C. Jones to D. Blaine Sanders, dated February 19, 2013, attached hereto as **Exhibit D.**)

b. On February 21, 2013, KEI's counsel again requested that Mr. Earnhardt's counsel provide a date by which Ms. Earnhardt would provide the remaining responsive documents in her possession. On February 26, 2013, Ms. Earnhardt's counsel responded only that they would "continue to serve responsive documents as we receive them from the client." (See E-mail from Larry C. Jones to D. Blaine Sanders, dated February 26, 2013, attached hereto as **Exhibit E**, at page 2.) When KEI's counsel once again requested a date by which Ms. Earnhardt would complete her document production, Mr. Jones refused to do so, insisting that, "We will let you know when our client's production is believed to be completed, when we know or understand that to be true." (See E-mail from Larry C. Jones to D. Blaine Sanders, dated February 26, 2013, attached hereto as **Exhibit E**, at page 1).

6. Ms. Earnhardt has failed and refused to provide those documents responsive to KEI's Request for Production, despite KEI's repeated efforts to secure the production of those documents without the Board's intervention. Ms. Earnhardt's counsel is unable even to provide a date by which Ms. Earnhardt will produce her documents. Further, KEI requires and is entitled to inspect those responsive documents in Ms. Earnhardt's possession prior to conducting Ms. Earnhardt's deposition and in order to determine whether any subsequent discovery is appropriate or necessary.

7. Ms. Earnhardt lacks any substantial justification for refusing to comply fully with KEI's Request for Production. Her refusal is especially noteworthy given that she initiated this opposition proceeding.

WHEREFORE, KEI moves for entry of an order:

a) Directing Ms. Earnhardt to produce to KEI's counsel all documents in Ms. Earnhardt's possession, custody, or control that are responsive KEI's Request for Production within seven days of the order's entry; and

b) Granting KEI such further and additional relief as the Board deems just and appropriate.

This 27th day of February, 2013.



D. Blaine Sanders
Matthew F. Tilley
ROBINSON, BRADSHAW & HINSON, P.A.
101 North Tryon Street, Suite 1900
Charlotte, North Carolina 28246-1900
Telephone: (704) 377-2536
Facsimile: (704) 373-4000
E-mail: bsanders@rbh.com; mtilley@rbh.com
Attorneys for Kerry Earnhardt, Inc.

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **MOTION TO COMPEL DISCOVERY** has been served upon the party listed below by depositing same in the United States mail, postage prepaid, in an envelope(s) addressed as follows:

Larry C. Jones
Alston & Bird LLP
101 S. Tryon Street, Suite 4000
Charlotte, North Carolina 28280-4000
Telephone: (704) 444-1000
Larry.jones@alston.com

This 22nd day of February, 2013



D. Blaine Sanders

Exhibit A

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

TERESA H. EARNHARDT,

Opposer,

v.

KERRY EARNHARDT, INC.,

Applicant.

Opposition No.: 91205331 (parent)

Application Serial No. 85/383,910
Trademark: EARNHARDT COLLECTION
(Intl. Class 20)

TERESA H. EARNHARDT,

Opposer,

v.

KERRY EARNHARDT, INC.,

Applicant.

Opposition No.: 91205338 (parent)

Application Serial No. 85/391,456
Service Mark: EARNHARDT COLLECTION
(Intl. Class 37)

PLEASE TAKE NOTICE that, pursuant to Rule 34 of the Federal Rules of Civil Procedure and 37 C.F.R. Section 2.120, Applicant Kerry Earnhardt, Inc. ("Applicant"), through counsel, hereby requests that Opposer Teresa H. Earnhardt ("Opposer") produce and permit Applicant to inspect and copy any and all documents described below which Opposer possesses, has access to, has custody of, or controls, at the offices of ROBINSON, BRADSHAW & HINSON, P.A., 101 North Tryon Street, Suite 1900, Charlotte, NC 28246, within thirty-five (35) days after service of this request. Further, Applicant requests that such production and inspection proceed in accordance with the definitions and instructions set out below.

DEFINITIONS AND INSTRUCTIONS

1. "Opposer," "You" or "Your" shall mean Teresa H. Earnhardt, her agents, employees, attorneys and any person acting on her behalf or at her instruction.

2. "Document" refers to all items subject to discovery under Rule 34 of the Federal Rules of Civil Procedure, including but not limited to any written or recorded material of any kind, including the originals and all non-identical copies, whether different from the originals by reason of any notation made on such copies or otherwise; notations of any sort of conversations, telephone calls, meetings or other communications; all graphic or oral records or representations of any kind; and mechanical or electronic records or representations of any kind including tapes, cassettes, disks or records.

3. *Marking and Arrangement.* The documents produced in response to this request shall be marked and arranged in such a way as to indicate clearly the request to which each such document is responsive.

4. *Privilege or Immunity from Production.* To the extent that any documents are not produced on the basis of a claim of privilege or immunity: (a) submit a list identifying each such document; (b) identify the nature of the privilege (including work product) which is being claimed; and (c) identify each person having knowledge of the factual basis, if any, on which the claim of privilege or immunity is based. For these purposes, "identify" shall mean in the case of a document, to state the document's date, its author, its recipient or the person for whom it was prepared, the type of document (*e.g.*, letter, memorandum, chart, or other category), its present location or custodian, a summary of its contents, and any other information necessary to render the document distinguishable from all others and subject to ready location.

5. *Proprietary Matter.* If any document request is deemed to call for disclosure of confidential or proprietary data within the meaning of Rule 26(c)(1)(G) of the Federal Rules of Civil Procedure, Applicant's counsel is prepared to receive such data pursuant to an appropriate order with respect to confidentiality.

6. *Destroyed Documents.* If any documents requested herein have been lost, discarded, or destroyed, the documents so lost, discarded, or destroyed shall be identified as completely as possible, including, without limitation, the following information: date of disposal, manner of disposal, reason for disposal, person authorizing the disposal, and the person disposing of the document.

7. Unless otherwise specified, these document requests refer to the time period from January 1, 2009 to the present.

DOCUMENTS REQUESTED

Produce the following:

1. All documents identifying and demonstrating Opposer's use of EARNHARDT (alone, *i.e.*, not with "DALE") as a trademark or service mark, including without limitation license agreements and exemplary specimens of advertisements or other promotional materials.

RESPONSE:

2. All documents identifying and demonstrating Opposer's use of EARNHARDT COLLECTABLES as a trademark or service mark, including without limitation license agreements and exemplary specimens of advertisements or other promotional materials.

RESPONSE:

3. All documents identifying and demonstrating Opposer's use of EARNHARDT (alone, *i.e.*, not with "DALE") as a trademark or service mark in International Class 20 or 37, including without limitation license agreements and exemplary specimens of advertisements or other promotional materials.

RESPONSE:

4. All documents identifying and demonstrating Opposer's use of the mark DALE EARNHARDT as a trademark or service mark in International Class 20 or 37, including without limitation license agreements and exemplary specimens of advertisements or other promotional materials.

RESPONSE:

5. All documents identifying and demonstrating Opposer's use of the mark EARNHARDT COLLECTABLES in International Class 20 or 37, including without limitation license agreements and exemplary specimens of advertisements or other promotional materials.

RESPONSE:

6. All documents constituting or reflecting any plans or programs by Opposer to use, market or promote the marks EARNHARDT (alone, *i.e.*, not with "DALE") or EARNHARDT COLLECTABLES, including without limitation any communications with any advertising agency or media outlet concerning these plans or programs.

RESPONSE:

7. All documents constituting or reflecting the annual amounts spent by Opposer to market or promote the sale of goods or services under the marks EARNHARDT (alone, *i.e.*, not with "DALE") or EARNHARDT COLLECTABLES.

RESPONSE:

8. All documents constituting or reflecting any confusion, mistake or deception arising out of Applicant's use of the EARNHARDT COLLECTION mark and having any connection to Opposer.

RESPONSE:

9. All documents constituting or reflecting any consumer survey or similar study undertaken by Opposer with respect to likelihood of confusion arising out of Applicant's use of the EARNHARDT COLLECTION mark and having any connection to Opposer.

RESPONSE:

10. All documents forming the factual basis for the following allegation in Paragraph 2 of the Notice of Opposition: "As a means of identifying themselves to other NASCAR fans as part of Dale Earnhardt's fandom, legions of fans yelled 'EARNHARDT!' loudly and proudly not only during races but also wherever and whenever NASCAR fans gathered."

RESPONSE:

11. All documents forming the factual basis for the following allegation in Paragraph 4 of the Notice of Opposition: "Following his death, the commercial rights in Dale Earnhardt's name and persona have passed to his widow, Teresa H. Earnhardt, the Opposer in the proceeding."

RESPONSE:

12. All documents related to or justifying any decision by Opposer to allocate to herself all of the commercial rights in Dale Earnhardt's name and persona rather than to allocate such rights among Mr. Earnhardt's children.

RESPONSE:

13. All documents forming the factual basis for the allegations in Paragraph 15 of the Notice of Opposition.

RESPONSE:

14. All documents forming the factual basis for the allegations in Paragraph 21 of the Notice of Opposition.

RESPONSE:

15. All documents forming the factual basis for the allegation in Paragraph 23 of the Notice of Opposition that the EARNHARDT and DALE EARNHARDT marks are “famous marks.”

RESPONSE:

16. All documents forming the factual basis for the allegation in Paragraph 24 of the Notice of Opposition that usage of the EARNHARDT COLLECTION mark “in conjunction with custom homes is likely to cause dilution by blurring of each of the famous EARNHARDT and DALE EARNHARDT marks.”

RESPONSE:

17. Documents sufficient to demonstrate the annual sales of merchandise licensed under the mark DALE EARNHARDT since January 1, 1999.

RESPONSE:

18. Documents sufficient to demonstrate the annual sales of merchandise licensed under the mark EARNHARDT (alone, *i.e.*, not with “DALE”) since January 1, 1999.

RESPONSE:

19. Documents sufficient to demonstrate the annual sales of merchandise licensed under the mark EARNHARDT COLLECTABLES since January 1, 1999.

RESPONSE:

20. All documents identified in Opposer’s Initial Disclosures.

RESPONSE:

21. All documents related to any expert witness and required to be disclosed under Rule 26(a)(2) and (b)(4) of the Federal Rules of Civil Procedure.

RESPONSE:

22. All documents Opposer intends to offer into evidence at the trial of this action.

RESPONSE:

23. All documents Opposer contends support its position in this litigation.

RESPONSE:

24. All documents that relate to Opposer's allegations in any way whatsoever, whether or not they support Opposer's position or are intended to be used as exhibits at trial.

RESPONSE:

25. All documents requested above differing from the original by virtue of additions, deletions and marginal notations.

RESPONSE:

26. All drafts of all documents requested above.

RESPONSE:

27. All documents used or consulted by Opposer in preparation of the Notice of Opposition.

RESPONSE:

28. All tape recordings concerning the subject matter of this action.

RESPONSE:

Pursuant to Rule 26(e) of the Federal Rules of Civil Procedure, this request is continuing and requires further and supplemental production by Opposer in the event she obtains or discovers additional documents between the time of initial production and the time of hearing or trial.

This 19th day of November, 2012.



D. Blaine Sanders
N.C. Bar No. 12541
Matthew F. Tilley
N.C. Bar No. 40125

ROBINSON, BRADSHAW & HINSON, P.A.
101 North Tryon Street, Suite 1900
Charlotte, NC 28246
(704) 377-2536

Attorneys for Applicant

CERTIFICATE OF SERVICE

I hereby certify that the foregoing **FIRST REQUEST FOR PRODUCTION OF DOCUMENTS** has been served upon each of the parties to this action by depositing same in the United States mail, postage prepaid, in an envelope(s) addressed as follows:

Larry C. Jones
Alston & Bird LLP
Bank of America Plaza
101 S. Tryon Street, Suite 4000
Charlotte, NC 28280-4000

This 19th day of November, 2012.



D. Blaine Sanders

Exhibit B

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

Teresa H. Earnhardt,	§	Consolidated Opposition Nos.
	§	91205331 (parent) and 91205338
Opposer,	§	
	§	In the matter of:
vs.	§	
	§	Application Serial No. 85/383,910
Kerry Earnhardt, Inc.,	§	Mark; EARNHARDT COLLECTION
	§	(Intl. Class 20)
Applicant.	§	
	§	Application Serial No. 85/391,456
	§	Mark; EARNHARDT COLLECTION
		(Intl. Class 37)

**OPPOSER'S RESPONSES TO APPLICANT'S
FIRST SET OF REQUESTS FOR PRODUCTION**

Pursuant to 37 C.F.R. § 2.120 and Rules 26 and 34 of the Federal Rules of Civil Procedure, Opposer, Teresa H. Earnhardt, hereby provides the following responses to Applicant's first requests for production of documents.

GENERAL OBJECTIONS

1. Opposer objects to each and every request for production to the extent that it seeks information protected from discovery by the attorney-client communications privilege or the attorney work product immunity doctrine.
2. Opposer objects to each and every definition, instruction, and request for production to the extent that it purports to require Opposer to search for information not within Opposer's possession, custody or control. To do so would place an undue added burden upon Opposer.
3. Opposer objects to each and every definition, instruction, and request for production to the extent it purports to require Opposer to provide discovery or

information and materials not otherwise required under 37 C.F.R. § 2.120 and the applicable Federal Rules of Civil Procedure.

4. Opposer objects to the date and place of production designated by Applicant in its request for production.

5. Opposer objects to any requirement that she identify or provide a list of any documents withheld from discovery pursuant to either the attorney-client communications privilege and/or the attorney work product immunity doctrine and which documents were created on or after May 16, 2012, the date on which each Notice of Opposition was filed in this proceeding. Such a requirement would be unduly burdensome and would interfere with this proceeding by deterring the creation of such documents.

6. These responses are made without waiver of and with preservation of:

(a) all questions as to competency, relevancy, materiality, privilege and admissibility of the responses and the subject matter thereof as evidence for any purpose and in any further proceeding in this action and in any other action;

(b) the right to object to the use of any such responses or the subject matter thereof, on any ground in any further proceeding in this action and any other action;

(c) the right to object on any ground at any time to a demand or request for further response to these or any other requests for production or other discovery requests involved or related to the subject matter of the discovery to which these responses are provided; and

(d) the right at any time to review, correct, add to, supplement or clarify any of the responses contained herein.

7. The following responses are based upon information and documents presently available to and located by Opposer and her attorneys. Opposer has not completed her investigation of the facts relating to this proceeding, has not completed her discovery in this proceeding, and has not completed her preparation of her testimony. The responses given herein to the discovery requests are without prejudice to Opposer's right to produce evidence of any additional facts or materials.

These general objections apply to all of Applicant's discovery requests. To the extent that the specific General Objections are cited herein in response to specific discovery requests, those specific citations are provided because they are believed to be particularly applicable to the requests and are not to be construed a waiver of any other General Objections applicable to information or materials falling within the scope of the requests.

RESPONSE TO REQUESTS FOR PRODUCTION NOS. 1-28

Request for Production No. 1:

All documents identifying and demonstrating Opposer's use of EARNHARDT (alone, *i.e.*, not with "DALE") as a trademark or service mark, including without limitation license agreements and exemplary specimens of advertisements or other promotional materials.

Response to Request for Production No. 1:

Opposer incorporates by reference all of the foregoing objections.

Opposer will produce the non-privileged documents and things, if any such documents and things exist in her possession, custody or control.

Request for Production No. 2:

All documents identifying and demonstrating Opposer's use of EARNHARDT COLLECTABLES as a trademark or service mark, including without limitation license agreements and exemplary specimens of advertisements or other promotional materials.

Response to Request for Production No. 2:

Opposer incorporates by reference all of the foregoing objections.

Opposer will produce the non-privileged documents and things, if any such documents and things exist in her possession, custody or control.

Request for Production No. 3:

All documents identifying and demonstrating Opposer's use of EARNHARDT (alone, *i.e.*, not with "DALE") as a trademark or service mark in International Class 20 or 37, including without limitation license agreements and exemplary specimens of advertisements or other promotional materials.

Response to Request for Production No. 3:

Opposer incorporates by reference all of the foregoing objections.

Opposer will produce the non-privileged documents and things, if any such documents and things exist in her possession, custody or control.

Request for Production No. 4:

All documents identifying and demonstrating Opposer's use of the mark DALE EARNHARDT as a trademark or service mark in International Class 20 or 37, including without limitation license agreements and exemplary specimens of advertisements or other promotional materials.

Response to Request for Production No. 4:

Opposer incorporates by reference all of the foregoing objections.

Opposer will produce the non-privileged documents and things, if any such documents and things exist in her possession, custody or control.

Request for Production No. 5:

All documents identifying and demonstrating Opposer's use of the mark EARNHARDT COLLECTABLES in International Class 20 or 37, including without limitation license agreements and exemplary specimens of advertisements or other promotional materials.

Response to Request for Production No. 5:

Opposer incorporates by reference all of the foregoing objections.

Opposer will produce the non-privileged documents and things, if any such documents and things exist in her possession, custody or control.

Request for Production No. 6:

All documents constituting or reflecting any plans or programs by Opposer to use, market or promote the mark EARNHARDT (alone, *i.e.*, not with “DALE”) or EARNHARDT COLLECTABLES, including without limitation any communications with any advertising agency or media outlet concerning these plans or programs.

Response to Request for Production No. 6:

Opposer incorporates by reference all of the foregoing objections.

Opposer will produce the non-privileged documents and things, if any such documents and things exist in her possession, custody or control.

Request for Production No. 7:

All documents constituting or reflecting the annual amounts spent by Opposer to market or promote the sale of goods or services under the marks EARNHARDT (alone, *i.e.*, not with “DALE”) or EARNHARDT COLLECTABLES.

Response to Request for Production No. 7:

Opposer incorporates by reference all of the foregoing objections.

Opposer will produce the non-privileged documents and things, if any such documents and things exist in her possession, custody or control.

Request for Production No. 8:

All documents constituting or reflecting any confusion, mistake or deception arising out of Applicant’s use of the EARNHARDT COLLECTION mark and having any connection to Opposer.

Response to Request for Production No. 8:

Opposer incorporates by reference all of the foregoing objections.

Opposer will produce the non-privileged documents and things, if any such documents and things exist in her possession, custody or control.

Request for Production No. 9:

All documents constituting or reflecting any consumer survey or similar study undertaken by Opposer with respect to likelihood of confusion arising out of Applicant's use of the EARNHARDT COLLECTION mark and having any connection to Opposer.

Response to Request for Production No. 9:

Opposer incorporates by reference all of the foregoing objections.

Opposer will produce the non-privileged documents and things, if any such documents and things exist in her possession, custody or control.

Request for Production No. 10:

All documents forming the factual basis for the following allegation in Paragraph 2 of the Notice of Opposition: "As a means of identifying themselves to other NASCAR fans as part of Dale Earnhardt's fandom, legions of fans yelled 'EARNHARDT!' loudly and proudly not only during races but also wherever and whenever NASCAR fans gathered."

Response to Request for Production No. 10:

Opposer incorporates by reference all of the foregoing objections.

Opposer will produce the non-privileged documents and things, if any such documents and things exist in her possession, custody or control.

Request for Production No. 11:

All documents forming the factual basis for the following allegation in Paragraph 4 of the Notice of Opposition: "Following his death, the commercial rights in Dale Earnhardt's name and persona have passed to his widow, Teresa H. Earnhardt, the Opposer in the proceeding."

Response to Request for Production No. 11:

Opposer incorporates by reference all of the foregoing objections.

Opposer will produce copies of the will of Dale Earnhardt (appropriately redacted to delete sensitive information not relevant to establishing Opposer's interest in the commercial

rights in Dale Earnhardt's name and persona) and the relevant assignments of trademarks and service marks to Opposer.

Otherwise, Opposer also objects to this request on the grounds that: (i) it seeks materials neither relevant to any issue to be determined in this proceeding nor likely to lead to the discovery of admissible evidence relevant to any issue to be determined in this proceeding; and (ii) it exceeds the bounds of discovery permitted under the controlling precedents and rules of the TTAB.

Request for Production No. 12:

All documents related to or justifying any decision by Opposer to allocate to herself all of the commercial rights in Dale Earnhardt's name and persona rather than to allocate such rights among Mr. Earnhardt's children.

Response to Request for Production No. 12:

Opposer incorporates by reference all of the foregoing objections.

Otherwise, Opposer also objects to this request on the grounds that: (i) it seeks materials neither relevant to any issue to be determined in this proceeding nor likely to lead to the discovery of admissible evidence relevant to any issue to be determined in this proceeding; and (ii) it exceeds the bounds of discovery permitted under the controlling precedents and rules of the TTAB.

Request for Production No. 13:

All documents forming the factual basis for the allegations in Paragraph 15 of the Notice of Opposition.

Response to Request for Production No. 13:

Opposer incorporates by reference all of the foregoing objections.

Opposer will produce the non-privileged documents and things, if any such documents and things exist in her possession, custody or control.

Request for Production No. 14:

All documents forming the factual basis for the allegations in Paragraph 21 of the Notice of Opposition.

Response to Request for Production No. 14:

Opposer incorporates by reference all of the foregoing objections.

Opposer will produce the non-privileged documents and things, if any such documents and things exist in her possession, custody or control.

Request for Production No. 15:

All documents forming the factual basis for the allegation in Paragraph 23 of the Notice of Opposition that the EARNHARDT and DALE EARNHARDT marks are "famous marks."

Response to Request for Production No. 15:

Opposer incorporates by reference all of the foregoing objections.

Opposer will produce the non-privileged documents and things, if any such documents and things exist in her possession, custody or control.

Request for Production No. 16:

All documents forming the factual basis for the allegation in Paragraph 24 of the Notice of Opposition that usage of the EARNHARDT COLLECTION mark "in conjunction with custom homes is likely to cause dilution by blurring of each of the famous EARNHARDT and DALE EARNHARDT marks."

Response to Request for Production No. 16:

Opposer incorporates by reference all of the foregoing objections.

Opposer will produce the non-privileged documents and things, if any such documents and things exist in her possession, custody or control.

Request for Production No. 17:

Documents sufficient to demonstrate the annual sales of merchandise licensed under the mark DALE EARNHARDT since January 1, 1999.

Response to Request for Production No. 17:

Opposer incorporates by reference all of the foregoing objections.

Opposer will produce the non-privileged documents and things, if any such documents and things exist in her possession, custody or control.

Request for Production No. 18:

Documents sufficient to demonstrate the annual sales of merchandise licensed under the mark EARNHARDT (alone, *i.e.*, not with "DALE") since January 1, 1999.

Response to Request for Production No. 18:

Opposer incorporates by reference all of the foregoing objections.

Opposer will produce the non-privileged documents and things, if any such documents and things exist in her possession, custody or control.

Request for Production No. 19:

Documents sufficient to demonstrate the annual sales of merchandise licensed under the mark EARNHARDT COLLECTABLES since January 1, 1999.

Response to Request for Production No. 19:

Opposer incorporates by reference all of the foregoing objections.

Opposer will produce the non-privileged documents and things, if any such documents and things exist in her possession, custody or control.

Request for Production No. 20:

All documents identified in Opposer's Initial Disclosures.

Response to Request for Production No. 20:

Opposer incorporates by reference all of the foregoing objections.

Opposer will produce the non-privileged documents and things, if any such documents and things exist in her possession, custody or control.

Request for Production No. 21:

All documents related to any expert witness and required to be disclosed under Rule 26(a)(2) and (b)(4) of the Federal Rules of Civil Procedure.

Response to Request for Production No. 21:

Opposer incorporates by reference all of the foregoing objections.

Opposer will produce the expert witness report for each expert witness, if any, whom Opposer decides to call as a witness, when and having the content required under the controlling rules of practice of the TTAB. To the extent this request would require any other response, Opposer objects to this request.

Request for Production No. 22:

All documents Opposer intends to offer into evidence at the trial of this action.

Response to Request for Production No. 22:

Opposer incorporates by reference all of the foregoing objections.

Opposer also objects to this request on the grounds that it exceeds the scope of discovery permitted under the controlling precedents and rules of the TTAB.

Request for Production No. 23:

All documents Opposer contends support its position in this litigation.

Response to Request for Production No. 23:

Opposer incorporates by reference all of the foregoing objections.

Opposer also objects to this request on the grounds that it exceeds the scope of discovery permitted under the controlling precedents and rules of the TTAB.

Request for Production No. 24:

All documents that relate to Opposer's allegations in any way whatsoever, whether or not they support Opposer's position or are intended to be used as exhibits at trial.

Response to Request for Production No. 24:

Opposer incorporates by reference all of the foregoing objections.

Opposer also objects to this request on the grounds that it exceeds the scope of discovery permitted under the controlling precedents and rules of the TTAB.

Request for Production No. 25:

All documents requested above differing from the original by virtue of additions, deletions and marginal notations.

Response to Request for Production No. 25:

Opposer incorporates by reference all of the foregoing objections.

Opposer also objects to this request on the grounds that, in view of Paragraph 2 of Applicant's "Definitions and Instructions," this request is duplicitous of all other requests for production.

Request for Production No. 26:

All drafts of all documents requested above.

Response to Request for Production No. 26:

Opposer incorporates by reference all of the foregoing objections.

Opposer also objects to this request on the grounds that, in view of Paragraph 2 of Applicant's "Definitions and Instructions," this request is duplicitous of all other requests for production.

Request for Production No. 27:

All documents used or consulted by Opposer in preparation of the Notice of Opposition.

Response to Request for Production No. 27:

Opposer incorporates by reference all of the foregoing objections.

Opposer also objects to this request on the grounds that it exceeds the scope of discovery permitted under the controlling precedents and rules of the TTAB.

Opposer further objects to this request on the grounds that it seeks information and/or materials which are immune from discovery pursuant to the attorney work product doctrine.

Request for Production No. 28:

All tape recordings concerning the subject matter of this action.

Response to Request for Production No. 28:

Opposer incorporates by reference all of the foregoing objections.

Opposer also objects to this request on the grounds that it is vague and ambiguous and, to the extent understood, beyond the scope of discovery permitted under the controlling precedents and rules of the TTAB.

Dated: January 24, 2013

Respectfully submitted,



Larry C. Jones
Carla H. Clements
Alston & Bird, LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, North Carolina 28280-4000
Telephone: (704) 444-1000

Attorneys for Opposer,
Teresa H. Earnhardt

CERTIFICATE OF SERVICE

I hereby certify that the foregoing "Opposer's Responses to Applicant's First Set of Requests for Production" was duly served on Applicant by depositing a copy of same in the United States mail, first-class postage prepaid, on the 24th day of January, 2013 addressed to Applicant's attorneys of record as follows:

D. Blaine Sanders
Matthew F. Tilley
Robinson Bradshaw & Hinson, P.A.
101 N. Tryon Street, Suite 1900
Charlotte, NC 28246-0106



Carla H. Clements

Exhibit C

Robinson Bradshaw

D. Blaine Sanders
Charlotte Office
704.377.8344 Direct Phone
704.373.3944 Direct Fax
bsanders@rbh.com
rbh.com

February 13, 2013

VIA E-MAIL AND FIRST CLASS MAIL

Larry C. Jones
Alston & Bird, LLP
Bank of America Plaza
101 S. Tryon Street, Suite 4000
Charlotte, NC 28280-4000

Rc: Teresa H. Earnhardt v. Kerry Earnhardt, Inc.

Dear Larry:

I am writing you about discovery. Concerning documents, Matthew and Carla have been going back and forth now for more than two weeks about Teresa's incomplete document production. Our most recent understanding is that your firm has requested the documents from Teresa, but she has not responded. This, of course, is not surprising to our client, but we must insist that Teresa comply with her discovery obligations, especially given that she initiated this proceeding. If we do not have a firm date by which the remaining documents will be produced within one week of this letter, we will have no choice but to file a motion to compel.

Regarding deposition scheduling, when I recently asked you for dates for the taking of Teresa's deposition, you stated that you wanted to take Rene's deposition. Rene is available with some flexibility the mornings of February 26, 27 or 28. Please let me know of Teresa's availability.

As you know, the March 5 discovery cutoff is approaching, so we need to make some progress.

Sincerely,

ROBINSON BRADSHAW & HINSON, P.A.



D. Blaine Sanders

3165486v1

Larry Jones
February 13, 2013
Page 2

DBS/ksl

cc: Kerry Earnhardt, Inc. (via email)
Matthew F. Tilley (via email)
Carla H. Clements (via email)

Exhibit D

Tilley, Matthew

From: Jones, Larry <Larry.Jones@alston.com>
Sent: Tuesday, February 19, 2013 10:34 AM
To: Sanders, Blaine
Cc: Tilley, Matthew
Subject: Teresa H. Earnhardt v. Kerry Earnhardt, Inc.; TTAB Opposition Nos. 91205331 and 91205338
Attachments: Notice Rene Earnhardt Deposition_1.PDF

Blaine:

Attached is a courtesy copy of the "Opposer's Notice of Deposition of Rene Earnhardt." The service copy is being formally served via mail today. Inasmuch as your letter of February 13 indicated that Rene Earnhardt would be available for a deposition on either of February 26, 27 or 28, the deposition notice specifies February 28 as the date of that deposition.

In your letter of February 13, you noted that Opposer Teresa Earnhardt's document production is not yet complete, and you also inquired as to the dates on which Teresa Earnhardt could be made available for her deposition. As you may know, my associate, Carla Clements, is out of the office for two weeks on her honeymoon, and I understand that, prior to Carla leaving for her honeymoon, Teresa Earnhardt did not complete her document production or identify dates on which she would be available for a deposition

Accordingly, and inasmuch as the discovery period is currently set to close March 5, I suggest that we jointly stipulate to an extension of 60 days of the discovery period and all subsequent periods and deadlines. Further, if you are willing to stipulate to that extension, I would be willing to reschedule the deposition of Rene Earnhardt for a date subsequent to March 5.

Please let me know whether you prefer to proceed with Rene Earnhardt's deposition on February 28, as noticed. Please also let me know whether you consent to my filing of a stipulated extension of the discovery period for 60 days.

Larry C. Jones

Alston & Bird LLP
101 S. Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Direct Phone: (704) 444-1019
Direct Fax: (704) 444-1759
Email: Larry.Jones@Alston.com

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Exhibit E

Tilley, Matthew

From: Jones, Larry <Larry.Jones@alston.com>
Sent: Tuesday, February 26, 2013 3:07 PM
To: Sanders, Blaine
Cc: Tilley, Matthew
Subject: Teresa H. Earnhardt v. Kerry Earnhardt, Inc.; TTAB Opposition Nos. 91205331 and 91205338

Blaine:

My responses and comments are below in **red**.

From: Sanders, Blaine [mailto:BSanders@rbh.com]
Sent: Tuesday, February 26, 2013 2:40 PM
To: Jones, Larry
Cc: Tilley, Matthew
Subject: RE: Teresa H. Earnhardt v. Kerry Earnhardt, Inc.; TTAB Opposition Nos. 91205331 and 91205338

Larry,

I have now read your email a few times. It seems to simply be another request for consent to an extension, but it does not address the real issue--Teresa's lack of cooperation in the discovery process. I will try to advance the ball:

1. Concerning the two depositions, our side will agree to put off Teresa's deposition to a mutually convenient time provided that you do the same concerning Rene's deposition. Is that agreeable? **LCJ: Agreed** When we do schedule the depositions, Teresa's deposition should be first because we asked for hers first. **LCJ: Not agreed---We each informed the other of our intent during the same telephone conference.**
2. Regarding the document production, unless you can provide us a date certain by which Teresa will produce the remaining documents, we will have to file a motion to compel. After we gave your side an extension to respond to our discovery, your firm provided responses on January 24 and a partial document production a week or so later. There is no dispute, however, that the production is incomplete.

You are saying that your client has produced documents, but our sense based on your prior communications is that your firm has provided the responses and the partial production out of client information it already had on hand, without any discovery-specific input or cooperation from Teresa. **LCJ: I don't know how or when you came to that conclusion, but it is not accurate.** In other words, the production is incomplete because of Teresa. We believe that is why you cannot give us a date certain for producing the documents that Teresa has and why Teresa has not verified the interrogatory responses. Please let me know if that is incorrect.

If it is correct, it has now been more than a month since the due date and we still do not know when your client "might begin complying." Please let me know by tomorrow midday if you can give us a date certain. **LCJ: We will let you know when our client's production is believed to have been completed, when we know or understand that to be true.** Otherwise, I do not see that we have any choice but to move to compel.
3. As for extending the discovery period, we are agreeable to an extension for the limited purposes of taking the two depositions described above and for our side to obtain the discovery to which we are entitled under the requests we have already made. Is that agreeable? **LCJ: With the proviso that we must insist on being permitted to depose either or both of your client's licensees, the Schumacher entities, or their employees or designees, if we choose to do so**

after they complete their document production. As I am confident you know, their attorney has requested additional time to complete their production in response to the document subpoenas we served, and we are accommodating that request. Moreover, their document production to date seems quite incomplete with respect to the categories for which they have provided documents. In any event, we may choose to take one or more such Schumacher-related depositions after we receive their documents and take the deposition of Rene Earnhardt to which you have agreed.

Regards. Blaine

From: Jones, Larry [<mailto:Larry.Jones@alston.com>]
Sent: Tuesday, February 26, 2013 9:48 AM
To: Sanders, Blaine
Cc: Tilley, Matthew
Subject: Teresa H. Earnhardt v. Kerry Earnhardt, Inc.; TTAB Opposition Nos. 91205331 and 91205338

Blaine:

In your February 21, email, you indicated that you noticed the March 4 deposition of Opposer Teresa Earnhardt “to protect [your client’s] rights” inasmuch as the March 5 discovery period deadline is rapidly approaching. Similarly, to protect my client’s right to depose Rene Earnhardt, President of your client, I noticed her deposition to be taken this Thursday, February 28. In your February 21 email, you requested that I withdraw that notice on or before February 25, and you indicated that, in the absence of such a withdrawal, you “will move for a protective order.” As such, it is my understanding that Ms. Earnhardt will not appear for the deposition on February 28. If that understanding is incorrect, please let me know right away.

In your February 21 email, you also threatened to file a motion to compel. In my opinion, there is no constructive purpose to be served by filing such a motion. Of course, if Rene Earnhardt does not appear for a deposition on February 28, I likewise would need to file a motion to compel. The inevitable result of either or both of our motions is that the Board will extend the discovery period. Thus, I reiterate my prior suggestion that we jointly stipulate to the extension of the discovery period for 60 days. Please let me know whether you concur with that suggestion or whether you will insist on filing a motion to compel.

In your February 21 email, you also complained of our client’s document production. That document production is a continuing process, and we will continue to serve responsive documents as we receive them from our client. Relatedly, you stated that you “do not have any idea if or when [Opposer] might begin complying” with her discovery obligations. I am puzzled by that statement inasmuch as you have received not only our client’s written discovery responses, but also I understand that our client has produced nearly 3,000 pages of documents thus far, and that production is not yet finished. Hence, I do not understand why you inquire when our client “might begin complying.”

Larry C. Jones

Alston & Bird LLP
101 S. Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Direct Phone: (704) 444-1019
Direct Fax: (704) 444-1759
Email: Larry.Jones@Alston.com

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