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

Proceeding	91207333
Party	Plaintiff RxD Media, LLC
Correspondence Address	CECIL E KEY DIMUROGINSBERG PC 1101 KING ST, STE 610 ALEXANDRIA, VA 22314 UNITED STATES ckey@dimuro.com, ssakagami@dimuro.com
Submission	Motion to Compel Discovery
Filer's Name	Sara M. Sakagami
Filer's e-mail	ssakagami@dimuro.com
Signature	/Sara M. Sakagami/
Date	04/06/2015
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

RXD MEDIA, LLC	:	
	:	
Opposer	:	
	:	
v.	:	Opposition No. 91207333
	:	91207598
IP APPLICATION DEVELOPMENT LLC,	:	
	:	
Applicant.	:	
	:	

**OPPOSER RXD MEDIA, LLC’S MOTION TO COMPEL DISCOVERY RESPONSES
FROM APPLICANT IP APPLICATION DEVELOPMENT LLC**

Pursuant to TBMP § 523 and Fed. R. Civ. P. 37, Opposer RxD Media, LLC (“RxD”) hereby moves the Board for an order compelling Applicant IP Application Development, LLC (“IP Application”) and [REDACTED] Apple, Inc. (“Apple”) (collectively, “Applicant”)¹ to produce Douglas Vetter for deposition, and to respond to the specific written discovery requests set forth in Appendix A hereto. Specifically, RxD requests that the Board issue an order: (1) compelling Applicant to produce Douglas Vetter for deposition; (2) striking Applicant’s objections and compelling it to fully respond to the discovery requests identified in Appendix A; (3) compelling Applicant to produce a privilege log; (4) striking Applicant’s improper designations of responses as “Trade Secret/Commercially Sensitive;” and (5) extending the deadline for Applicant’s discovery for a period of time sufficient to allow completion following Applicant’s compliance with the Board’s order. The bases for RxD’s requests are set forth in full below.

Statement of Good Faith Efforts to Resolve the Issues Presented. As set forth more fully below, RxD and Applicant exchanged correspondence setting forth their respective

¹ While IP Application is technically the Applicant, it has agreed to treat Apple, IP Application’s exclusive licensee to the mark at issue, as a party for purposes of these proceedings.

positions regarding the discovery issues in dispute, and met and conferred by telephone on February 25, 2015. While progress was made on some issues, the parties are at an impasse as to the issues that are the subject of this motion, and Applicant has indicated that it will provide no further responses absent an order from the Board.

Applicant has indicated that it will supplement responses to other requests, but RxD has not yet received the supplemental responses. RxD therefore reserves its right to challenge the sufficiency of the supplemental responses if and when they are received and RxD has had a reasonable opportunity to review them.

I. BACKGROUND

A. History of Applicant's Discovery Responses

On December 18, 2014, three days after the Board resumed the current proceedings following the undersigned's entry of appearance as counsel for RxD, the undersigned wrote to Applicant's counsel regarding certain discovery issues that were to be addressed. *See* Ex. 1, C. Key Dec. 29, 2014 letter to G. Gundersen. Two such issues were the depositions of Applicant's deponents that RxD had identified, and the production of "documents or communications to or from Steve Jobs, who [REDACTED]

[REDACTED] *Id.*

On December 29, 2014, RxD served its third set of written discovery, including interrogatories and requests for production of documents. *See* Ex. 2, C. Key Dec. 29, 2014 email to G. Gundersen. On January 20, 2015, RxD issued notices of deposition to Applicant, including the individual deposition of Douglas Vetter. *See* Ex.3, Notice of Deposition of Douglas Vetter. Mr. Vetter was one of the deponents expressly identified in RxD's December 18 letter to Applicant's counsel. *See* Ex. 1 at 1.

TRADE SECRET/COMMERCIALY SENSITIVE

At 11:02 p.m. on January 28, 2015, less than an hour before the deadline to respond was to expire, Applicant served its responses to RxD's third set of discovery requests. *See* Ex. 4, D. Hope Jan. 28, 2015 email to C. Key; Ex. 5, Applicant's Responses and Objections to Opposer RxD Media, LLC's Third Set of Interrogatories to IP Application Development LLC; Ex. 6, Applicant's Responses and Objections to Opposer RxD Media, LLC's Third Set of Requests for Production of Documents and Things to IP Application Development LLC. Applicant did not produce responsive documents until February 2, 2015, and that production consisted almost entirely of publicly available documents, such as copies of Apple's website and Securities and Exchange Commission filings. *See* Appendix B, Index of Applicant's Document Production To-Date.

Six business days after receiving Applicant's written responses, and only three days after receiving Applicant's document production, RxD wrote to Applicant identifying its concerns with the deficiencies it had identified in Applicant's responses. *See* Ex. 7, C. Key Feb. 5, 2015 Letter to D. Hope. The issue of RxD's challenges to Applicant's discovery responses was raised during the telephone conference with the Board on February 6, 2015 regarding extending the proceeding deadlines, and in RxD's written submissions prior to the conference. *See* Paper 33, Order Re: Extension of Discovery and Trial Periods (Feb. 14, 2015). Two weeks later, Applicant responded to RxD's discovery issues in a letter that consisted entirely of attorney argument, but without any commitment to supplement a single response, and refusing to produce Mr. Vetter for deposition. *See* Ex. 8, D. Hope Feb. 19, 2015 Letter to C. Key & S. Sakagami.

On February 25, 2015, the parties held a meet and confer via telephone conference. During that call, the undersigned counsel expressed RxD's view and concern that Applicant had essentially failed to provide any substantive responses to RxD's requests, and that Applicant

appeared to be using questionable objections to avoid the good faith efforts at responding as required by the Board's rules. RxD sought to answer Applicant's questions regarding RxD's requests, and to provide further explanation for the information being sought. Applicant agreed to review RxD's explanation, and to provide a synopsis of the meet and confer for further discussion by the parties' respective counsel.

Instead, Applicant waited approximately two weeks to respond, and in that response stated the view that the parties are at an impasse as to certain of the outstanding requests, and expressly refused to supplement or further respond as to those requests, including maintaining the refusal to produce Mr. Vetter for deposition. *See Ex. 9, D. Hope Mar. 9, 2015 email to C. Key.* Nevertheless, RxD responded the next day with an invitation to discuss the issues further, and correcting certain of Applicant's averred understanding of RxD's positions discussed during the meet and confer. *See Ex. 10, C. Key Mar. 10, 2015 email to D. Hope.* Applicant's response was that it was standing on its positions. *See Ex.11, D. Hope Mar. 13, 2015 email to C. Key.*

B. Facts Pertinent To RxD's Requests

1. In the "20 months of discovery" Applicant has cited to (*see Ex.8 at 2*), Applicant has identified [REDACTED]

[REDACTED] *See Ex. 12, Applicant's Responses and Objections to Opposer's First Set of Interrogatories and Requests for Production of Documents and Things.* [REDACTED]

[REDACTED]

Thus, a total of four people from both Applicant and [REDACTED] Apple Inc., a very large multinational corporation with thousands of employees, have been disclosed by Applicant despite having 20 months to investigate and identify knowledgeable individuals.

2. Of the four individuals Applicant has disclosed, [REDACTED]

[REDACTED]

[REDACTED] See Ex. 12, IPADLLC_000149-152, at IPADLLC_000152. [REDACTED]

[REDACTED] *Id.*

3. [REDACTED]

[REDACTED]

[REDACTED]

4. For both applications at issue in these proceedings, 77/913,563 and 77/927,446,

Applicant represented to the U.S. Patent and Trademark Office that the “services covered by the present application are highly related to mobile digital devices.” See ‘563 App., Request for Reconsideration (Apr. 18, 2012) at 25; ‘446 App., Request for Reconsideration (Feb. 21, 2012) at 33. Notably, Applicant did not limit its statement to the precise services described; its statement extends to services *covered* by the application. Also notable is that Applicant did not limit its statements to the IPAD mark. Rather, it cited to other marks owned by Applicant and Apple. See ‘563 App., Request for Reconsideration (Apr. 18, 2012) at 25-29; ‘446 App., Request for Reconsideration (Feb. 21, 2012) at 33-36. Moreover, Applicant represented to the Office that as of 2012, “the public would immediately perceive IPAD as a distinctive mark for the services covered by” the challenged application. See ‘563 App., Request for Reconsideration

(Apr. 18, 2012) at 24; '446 App., Request for Reconsideration (Feb. 21, 2012) at 32. These statements were made for the express purpose of securing approval of the applications at issue.

5. For both applications at issue in these proceedings, Applicant, an LLC established in Delaware, claims priority to an application filed in Trinidad & Tobago on July 16, 2009. Applicant was not formed, however, until January 11, 2010, approximately six months later.

6. According to Applicant, [REDACTED]
[REDACTED] See Ex. 5, Applicant Response to RxD Interrogatory No. 9. RxD adopted and began using the IPAD mark in 2007, [REDACTED]
[REDACTED]
[REDACTED] See Ex. 14, at IPADLLC-00145. The Trinidad & Tobago application was filed a week later.

7. Applicant was clearly aware of other third parties that were using the mark IPAD at the time it filed the applications at issue. One such party was Proview Electronics, who brought suit against Apple alleging fraud and unfair competition regarding Apple's adoption and use of the IPAD mark. See Complaint, *Proview Electronics Co. Ltd., et al. v. Apple Inc., et al.*, Civil Action No. 112-CV-219219, 2012 WL 590878 (Cal. Sup. Ct. Feb 17, 2012); Ex. 5, Response to Interrogatory No. 10. Another was Fujitsu Frontech North America Inc. from whom Apple purchased Fujitsu's IPAD mark in 2010. See Opposition No. 76497338 (TTAB 2009); Ex. 14, at IPADLLC_000144-45; Ex. 15, IPADLLC_000001-08.

8. Applicant has asserted the equitable defenses of laches, acquiescence and estoppel. See Answer, Second Affirmative Defense, at 3 (Opposition No. 91207333); Answer, Second Affirmative Defense, at 3 (Opposition No. 91207598). Equitable defenses are not available to a party that itself acted inequitably. See Part II(B), ¶ 8, *infra*.

II. ARGUMENT.

Applicant's objections to the discovery requests at issue, and its refusal to produce Mr. Vetter for deposition, are based entirely on misguided views of the controlling law and the facts of this case, but Applicant's motivation does not stop there. Applicant's pattern of behavior since these proceedings were resumed has demonstrated that Applicant's responses and tactics are part of a calculated effort to frustrate RxD's ability to discover facts that might run counter to the one-sided story that Applicant wants to tell. To begin with, there is no justification for waiting two weeks to respond about discovery issues when the response includes nothing more than a restatement of objections and attorney argument. This is particularly so when Applicant has been on notice of the issues since mid-December, and knows that discovery is set to close within a few short weeks. Yet, Applicant has consistently taken weeks to respond regarding even basic information such as available dates for deposition. When it does respond, Applicant unilaterally determines what it views to be admissible evidence, and seeks to dictate to both RxD and the Board what evidence may be presented and considered. Were Applicant's views to prevail, RxD would be forced to prepare and present its case based solely on documents such as Apple's website, SEC filings, and trademark applications, and the deposition of one lone individual, an in-house lawyer for Apple, who will be put forth rehearsed testimony on behalf of two entities, IP Application and Apple. There is no justification for such inordinate limitations, and Applicant has provided none apart from its unilateral and self-serving determinations of "relevance."

Such behavior is obviously inappropriate, and should not be countenanced. RxD therefore requests that Applicant be ordered to supplement the discovery responses identified below, and produce Mr. Vetter for deposition.

A. The Issues Presented In These Proceedings.

The following issues have been expressly raised in the pleadings filed in these proceedings:

1. Priority of rights in the IPAD mark (*see* Notice of Opposition, Opp. No. 91207333, at ¶ 6; Notice of Opposition, Opp. No. 91207598, at ¶ 6);
2. Likelihood of confusion (*see* Notice of Opposition, Opp. No. 91207333, at ¶ 8; Notice of Opposition, Opp. No. 91207598, at ¶ 8);
3. Distinctiveness of the IPAD mark (*see* Answer, Opp. No. 91207333, “First Affirmative Defense;” Notice of Opposition, Opp. No. 91207598, “First Affirmative Defense”);
4. Acquisition of secondary meaning (*see id.*); and
5. Equitable bars to the relief RxD is seeking, such as laches, acquiescence and estoppel (*see* Answer, Opp. No. 91207333, “Second Affirmative Defense;” Notice of Opposition, Opp. No. 91207598, “Second Affirmative Defense”).

The facts revealed by the Applicant’s modest discovery responses to date raise the following additional issues:

6. The commercial connotation of the IPAD mark as adopted and used by IP Application and [REDACTED], Apple (Part I(B), ¶ 4, *supra*);
7. Applicant’s ownership of the application on which it bases its claim of priority (Part I(B), ¶ 5, *supra*);
8. Applicant’s bona fides and good faith in adopting the IPAD mark (Part I(B), ¶¶ 5-7, *supra*); and
9. Applicant’s knowledge of the rights of third parties and its efforts, as a junior user, to avoid conflicts with those rights (Part I(B), ¶ 7, *supra*).

B. Controlling Legal Principles

The issues outlined above are typical in trademark opposition proceedings, particularly those related to acquisition and priority of rights, and likelihood of confusion. Based on its experience with these issues across a broad range of cases, the Board has developed guidelines

outlining the type of information that a party is entitled to discover regarding these issues. *See* TBMP § 414. In trademark opposition cases, all facts must be considered and properly weighed to fully and fairly determine the issues. *See In re E.I. DuPont de Nemours*, 177 USPQ 563, 476 F.2d 1357, 1362 (CCPA 1973) (“We find no warrant, in the statute or elsewhere, for discarding *any* evidence bearing on the question of likelihood of confusion.”) (emphasis original). Thus, the Board’s guidelines reflect a liberal view of what information is discoverable. Included in the broad range of permissible discovery is that which informs other facts or witnesses about or from which further discovery is warranted, and that which might inform additional issues beyond the pleadings that might properly be considered in the proceedings. TBMP § 402.01. Just as significant here, the guidelines are designed to prevent forcing a party such as RxD and the Board to needlessly expend resources on a motion practice regarding information that has consistently been shown to be discoverable.

The expressly pled issues also raise subsidiary issues, such as an applicant’s intent and bona fides in adopting the mark at issue. 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 23:110 (4th ed. Mar. 2015) (“It is well established that an intent of the alleged infringer to gain through confusing customers or others is relevant to the issue of likelihood of confusion.”).

In light of the issues in these proceedings, of which Applicant is fully aware, the statement of controlling legal principles, such as those regarding the lack of “relevance,” on which Applicant consistently relies are plainly erroneous.

1. Information need not be admissible at trial to be discoverable. Discovery is relevant if it is likely to lead to the discovery of admissible evidence. Fed. R. Civ. P. 26(b)(1); TBMP § 402. As a standard of admissibility, relevance is to be determined by the Board, not

TRADE SECRET/COMMERCIALY SENSITIVE

unilaterally by a party trying to simply avoid providing a substantive response. Moreover, it has long been established that admissibility is to be liberally applied in trademark opposition proceedings. *In re E.I. DuPont de Nemours*, 177 USPQ 563, 476 F.2d at 1362.

2. The categories identified in TBMP § 414 are presumptively discoverable based on prior decisions. Moreover, a party and its attorneys have a duty to make a good faith attempt to determine whether the requested information is available; they cannot simply feign ignorance, and hide behind a purported lack of details as a basis not to provide responses. TBMP § 408.

3. There is no requirement that a party show that a requested deponent has “unique and superior knowledge” to any other opponent to be entitled to his deposition. As with all other discovery, the standard is whether the deponent has information that is likely to lead to the discovery of admissible evidence.

4. As these rules demonstrate, the purpose of discovery is to allow a party to test and challenge the assertions and averments of the opponent and to obtain discovery regarding potential additional claims fairly suggested by the current facts. The requesting party is not required to simply accept the unilateral and unverified statement of the opponent’s attorney in lieu of the opportunity to seek information that may contradict or negate the opponent’s assertions, nor must the requesting party be limited to the opponent’s unilateral interpretation of issues raised by the pleadings. TBMP § 401.

5. The commercial connotation of a mark in the minds of consumers based on the context of the goods and services with which the mark is used is always relevant to both the issues of likelihood of confusion and distinctiveness. *See In re E.I. DuPont de Nemours*, 177 USPQ 563, 476 F.2d at 1361 (connotation and commercial impression must be considered).

6. Discovery in opposition proceedings is *not* limited to the exact mark at issue or the goods and services described in the applicant's application. On the contrary, where, as here, likelihood of confusion is an issue in the proceedings, a critical factor is the similarity of the goods and services offered by the respective parties under other marks, especially when the marks at issue are identical. *In re Thor Tech.*, 90 USPQ2d 1634, 1635 (TTAB 2009). Thus, the TMBP expressly provides that information regarding goods and services offered by a defendant under other marks is discoverable when that information is probative of who consumers will view as the source of the plaintiff's goods and services. TBMP § 414(11) ("the information that a party sells the same goods or services as the propounding party, even if under a different mark, is relevant to the issue of likelihood of confusion for purposes of establishing the relationship between the goods or services of the parties").

7. It is well-established that the intent of the junior user is relevant to at least the issue of likelihood of confusion. 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 23:110 (4th ed. Mar. 2015) ("It is well established that an intent of the alleged infringer to gain through confusing customers or others is relevant to the issue of likelihood of confusion.").

8. Likewise, when a defendant raises equitable defenses, the plaintiff is entitled to explore whether the defendant is entitled to equitable relief, and that includes whether the defendant has acted in bad faith or with unclean hands as to the mark at issue. *See, e.g., Worden v. California Fig Syrup Co.*, 187 U.S. 516, 535 (1903) ("It is well settled that if a person wishes his trade-mark property to be protected by a court of equity, he must come into court with clean hands, and if it appears that the trade-mark for which he seeks protection is itself a misrepresentation to the public, and has acquired a value with the public by fraudulent misrepresentations in advertisements, all relief will be denied to him.").

9. The fact that requested information is publicly available is not a proper objection to discovery requests. Applicant has a duty to search in good faith and produce discoverable information requested by RxD that is within Applicant's possession, custody or control. TBMP §§ 402.01; 408. Indeed, Applicant's latest production consisted almost entirely of publicly available information, such as the Apple website and Apple's SEC filings. *See* Appendix B.

10. Attorney objections and publicly available information, such as description of services in a trademark application, do not constitute "Trade Secret/Commercially Sensitive" information. *Provisions for Protecting Confidentiality of Information Revealed During Board Proceeding*, Oppositions No. 91207333, 91207598, ¶ 2 (Feb. 4, 2013) (information in "publicly available writings" is "Information Not to Be Designated as Protected"). And the party asserting such protection, not the party challenging it, has the burden to establish that it is proper. *Id.*, ¶ 15.

III. Deficiencies Of Specific Responses

Applying the correct statement of the law to the pertinent facts demonstrates the following specific deficiencies in Applicant's responses.

A. Vetter Deposition.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Ex. 13, at IPADLLC_000149. [REDACTED]

[REDACTED]

[REDACTED] *Id.*, at IPADLLC_000152. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Such discovery might also lead to the discovery of admissible evidence as to Applicant's intent and good faith in adopting the mark. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Applicant is also refusing to identify another person or persons, other than Mr. La Perle, [REDACTED] Ex. 9 at 1. Mr. Vetter's deposition is even more critical under those circumstances.² Applicant has objected that Mr. Vetter's deposition will somehow be "burdensome," but it has failed to explain how a single deposition taken near Mr. Vetter's place of employment will present any burden beyond the slight inconvenience that any deponent must experience.

Applicant should therefore be order to produce Mr. Vetter for deposition within two weeks of issuance of the Board's order.

B. Interrogatories.

Interrogatory No. 21. RxD's Interrogatory No. 21 is directed to the identity of advertising and marketing agencies engaged by Applicant to promote and market services under the IPAD mark. Such information is expressly identified as discoverable under the Board's guidelines. TBMP, § 414(17). Applicant is objecting that the requested information is not

² At the meet and confer, RxD indicated that it was willing to entertain a deposition of a person other than Mr. Vetter, but that it would need to assess whether the proposed individual is indeed an appropriate substitute and requested Applicant to provide the name and his or her background information. At this time, Applicant has not provided any specific proposal as an alternate to Mr. Vetter. The obvious concern is that Mr. Vetter may have a level of knowledge and involvement that cannot be easily replicated by another witness, and Applicant's failure to identify an alternate person (other than Mr. La Perle as a 30(b)(6) designee) underscores the validity of that concern.

“relevant to any issue in these proceedings.” Ex. 9, at 2. However, as the guidelines recognize, the identity of advertising and marketing agencies may lead to the discovery of relevant information concerning circumstances surrounding selection of the mark and distinctiveness of the mark. TBMP§ 414(17), Note 25. The requested information is therefore discoverable, and must be produced. [REDACTED]

[REDACTED] Ex. 8, at 4, is nonresponsive. [REDACTED]

[REDACTED] Moreover, [REDACTED]

[REDACTED] is not a static document and Applicant cannot simply point to [REDACTED] as a sufficient response to a proper discovery request.

Applicant’s objections should therefore be stricken, and Applicant ordered to fully respond to Interrogatory No. 21.

Interrogatory No. 27. RxD’s Interrogatory 27 is directed to Applicant’s consideration and decision to reject any alternative marks before adopting the IPAD mark. “Information concerning a party’s selection and adoption of its involved mark is generally discoverable (particularly of a defendant).” TBMP § 414(4); *see also* § 414(24). Here, there is evidence that Applicant may have acted inequitably in adopting the IPAD mark, which is directly relevant to the issue of likelihood of confusion and the affirmative equitable defenses expressly pled by Applicant. *See* Part II(B), ¶ 8, *supra*. The sole objection being maintained by Applicant is the purported lack of relevance of the requested information. Ex. 9, at 2. However, as the Board’s guidelines make clear, the requested information may lead to the discovery of admissible evidence, and is therefore discoverable.

Applicant’s objections should therefore be stricken, and Applicant ordered to fully respond to Interrogatory No. 27.

Interrogatory No. 28. RxD's Interrogatory 28 is directed to the identification of the officers, members, directors, etc. of IP Application. Pursuant to the Board's guidelines, the names and addresses of a party's officers are discoverable. *Id.*, § 414(12). [REDACTED], and there is no indication that producing the requested identification would be burdensome. As noted above, only four individuals have been disclosed by Applicant since these proceedings began, and Applicant wishes to limit RxD's discovery to one in-house lawyer at Apple. *See* Part I, ¶¶ 1-2, *supra*. RxD is entitled to explore discovery from individuals involved in adopting, registering and attempting to register, and using the IPAD mark because such information is relevant to, among other issues, Applicant's intent and good faith in adopting the mark. *See* Part II(B), ¶ 8, *supra*. RxD is not required to simply accept Applicant's unilateral and self-serving determination that only a single individual has "knowledge relevant to the issues in these proceedings." Other members of IP Application are likely to have discoverable knowledge, particularly when the sole basis for Applicant's existence is the IPAD mark.

Applicant's objections should therefore be stricken, and Applicant ordered to fully respond to Interrogatory No. 28.

C. Document Requests.

Applicant has produced very little apart from publicly available documents such as copies of the apple.com website, Apple's SEC filings, one license agreement, and the results of a Google search. *See* Appendix B. Indeed, RxD, a much smaller company, has produced approximately the same volume of documents as Apple, a very large multinational corporation. Most notably, Applicant has produced only one email in response to RxD's discovery requests,

and that email contains significant redactions. . That is highly suspect, and underscores the following deficiencies in Applicant's document production.

Requests Nos. 21-23. RxD's document Requests Nos. 21-23 are directed to consumer or market studies regarding the commercial connotation of the IPAD mark, and services to be offered under the mark, and studies on which Applicant relied regarding the marketing and sale of the iPad product. Ex. 6, at 3-4. The commercial connotation of the mark at issue is relevant to both the issues of likelihood of confusion and distinctiveness. *See* Part II(B), ¶ 5, *supra*. As the Board's guidelines recognize, evidence regarding consumer views or comments about products offered under the mark at issue is discoverable where distinctiveness is an issue. TBMP § 414(23). Moreover, during prosecution and in order to secure approval of its applications, Applicant asserted that the connotation of the IPAD mark for services was inextricably intertwined with the connotation of the mark for goods, including the iPad device. *See* Part I(B), ¶ 4, *supra*. Applicant also represented that "the public would immediately perceive IPAD as a distinctive mark for the services covered by" the challenged applications. *Id.* RxD is entitled to discovery regarding Applicant's unilateral statements as to the connotation of the marks, which Applicant itself put at issue through its statements during prosecution, but very few responsive documents have been produced.

Applicant's objections should therefore be stricken, and Applicant ordered to produce all documents responsive to Requests Nos. 21-23 that are within the possession, custody or control of IP Application and Apple.

Requests Nos. 30-32. RxD's Requests Nos. 30-32 are directed to Applicant's knowledge of use of IPAD by third parties, and its assessment and valuation of the mark as used by others. Applicant had actual knowledge of use of the identical mark by third parties prior to the time it

began using the IPAD mark. *See* Part I(B), ¶¶ 6-7, *supra*. Indeed, Applicant had disputes two such parties regarding the IPAD mark. *Id.*, ¶ 7. Under these circumstances, the Board's guidelines recognize that the requested information is discoverable. TBMP §§ 414(9)-(10). Moreover, Applicant has placed the good faith nature of its actions at issue by asserting equitable defenses. *See* Part II(B), ¶ 8, *supra*. In addition, the intent of the junior user is relevant to both a determination of secondary meaning and likelihood of confusion. *Id.*, ¶ 7. Applicant cannot therefore avoid discovery calculated to obtain facts to refute Applicant's affirmative defenses. Applicant's primary objection is to the purported lack of relevance, Ex. 9, at 2, but the controlling law and the Board's guidelines make clear that the requested information is discoverable.

Applicant's objections should therefore be stricken, and Applicant ordered to produce all documents responsive to Requests Nos. 30-32 that are within the possession, custody or control of IP Application and Apple.

Request No. 35. RxD's Request No. 35 is directed to testimony given in Applicant's dispute with a third party, ProView, regarding the IPAD mark. ProView's allegations included assertions that Applicant acted fraudulently in adopting and acquiring rights in and to the IPAD mark. *See* Part I(B), ¶ 7, *supra*. Applicant has placed the good faith nature of its actions at issue by asserting equitable defenses. *See* Part II(B), ¶ 8, *supra*. In addition, the intent of the junior user is relevant to both a determination of secondary meaning and likelihood of confusion. *Id.*, ¶ 7. Applicant cannot therefore avoid discovery calculated to obtain facts to refute Applicant's affirmative defenses. Applicant has objected because [REDACTED]

[REDACTED] Ex. 9, at 2. However, the issue is not Applicant's foreign rights, but whether it acted fraudulently or inequitably in

adopting the mark. The requested information is directly related to that issue because Applicant filed an application in Trinidad & Tobago, which is not a significant market, and then relied on that filing to claim an earlier priority date, and thus potentially superior rights, in the U.S. *See* Part I(B), ¶ 5, *supra*. The facts of this case therefore present the type of circumstances where information regarding use of the mark outside the U.S. is discoverable under the Board's guidelines. TBMP § 414(13).

Applicant's objections should therefore be stricken, and Applicant ordered to produce all documents responsive to Request No. 35 that are within the possession, custody or control of IP Application and Apple.

Request No. 36. RxD's Request No. 36 is directed to documents regarding Applicant's acquisition of rights to the IPAD mark from Fujitsu. As with Requests Nos. 30-32 and 35, the requested information is probative of Applicant's knowledge and assessment of the uses of the mark by third parties and its good faith adoption of the IPAD mark, which is directly relevant to the issues of likelihood of confusion, secondary meaning, and the affirmative equitable defenses pled by Applicant. Part II(B), ¶¶ 5, 7-8, *supra*. Applicant has produced the assignment filed with the Office, but has refused to produce the substantive documents regarding the assignment based on the objection that the requested documents "would not be relevant to the services offered under the IPAD Mark." Ex. 9, at 3. However, commercial connotation is a relevant inquiry in these proceedings, and evidence probative of such connotation is discoverable. *See* Part II(B), ¶ 5, *supra*. Applicant itself represented to the Office that the commercial connotation of the IPAD mark for services is inextricably intertwined with the connotation of the mark for goods to obtain approval of the challenged applications. *See* Part I(B), ¶ 4, *supra*. It cannot now

deprive RxD of discovery based on a distinction that Applicant previously averred doesn't exist in order to obtain approval of the applications at issue.

Applicant's objections should therefore be stricken, and Applicant ordered to produce all documents responsive to Request No. 36 that are within the possession, custody or control of IP Application and Apple.

Requests Nos. 38-39. RxD's Requests Nos. 38-39 are directed to communications and emails with Steve Jobs regarding the adoption of the IPAD mark, both generally and for services.

[REDACTED]

[REDACTED] Part I(B), ¶ 2. As is well known, [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Ex. 12, at 5. Information regarding the selection and adoption of a mark by a defendant such as Applicant is generally discoverable. In this case, the information is probative of Applicant's intent and good faith in adopting the IPAD mark, which is relevant to the issues of secondary meaning, likelihood of confusion, and the affirmative equitable defenses Applicant has pled. Part II(B), ¶¶ 7-8, *supra*. [REDACTED]

[REDACTED]

[REDACTED] The requested documents are therefore particularly critical here due to the lack of witnesses Applicant has identified, [REDACTED]

[REDACTED], and the questions surrounding Applicant's adoption of the mark that have been raised by the facts uncovered to date.

Applicant's objections should therefore be stricken, and Applicant ordered to produce all documents responsive to Requests Nos. 38-39 that are within the possession, custody or control of IP Application and Apple.

Request No. 41. RxD's Request No. 41 is directed to the identification of IP Application's officers, directors, managers, etc. As noted above regarding Interrogatory No. 28, to which this request is related, the names and addresses of a party's officers are discoverable. *Id.*, § 414(12). It appears that [REDACTED] and there is no indication that producing the requested identification would be burdensome. As noted above, only four individuals have been disclosed by Applicant since these proceedings began, and Applicant wishes to limit RxD's discovery to one in-house lawyer at Apple. *See* Part I(B), ¶¶ 1-2, *supra*. RxD is entitled to explore discovery from individuals involved in adopting, registering and attempting to register, and using the IPAD mark because such information is relevant to, among other issues, Applicant's intent and good faith in adopting the mark. *See* Part II(B), ¶¶ 7-8, *supra*. RxD is not required to simply accept Applicant's unilateral and self-serving determination that only a single individual has "knowledge relevant to the issues in these proceedings." Other members of IP Application are likely to have discoverable knowledge, particularly when the sole basis for Applicant's existence is the IPAD mark.

Applicant's objections should therefore be stricken, and Applicant ordered to produce all documents responsive to Request No. 41 that are within the possession, custody or control of IP Application and Apple.

Request No. 42. RxD's Request No. 42 is directed to documents regarding assignments relating to or regarding any rights Applicant purports to have in the IPAD mark. Applicant has

claimed priority to a foreign filing dated July 2009, but Applicant was not formed until January 2010, six months later. *See* Part I(B), ¶ 5. These basic facts raise a colorable question of Applicant's ownership of the mark, its right to claim priority, and potentially material misrepresentations to the Office in order to secure registration of the mark. Such information is clearly discoverable. In its latest communication, Applicant offered no justification for its refusal to produce this basic information, simply stating that it "declines to supplement its production." Ex. 9, at 3. To the extent Applicant seeks to rely on previous objections, Applicant has not made any effort to explain how the production of such basic information would be unduly burdensome, and its original objection that the request goes beyond the services identified in the applications at issue cannot stand in light of Applicant's own reliance on the sale of IPAD branded goods to secure approval of the applications. *See* Part I(B), ¶ 4.

Applicant's objections should therefore be stricken, and Applicant ordered to produce all documents responsive to Request No. 42 that are within the possession, custody or control of IP Application and Apple.

D. Failure to Produce Privilege Log

Despite RxD's repeated requests, Applicant has failed to produce a privilege log, and indicated that it would produce a privilege log only when its production of document is completed. Ex. 10, at 1. Applicant's position is unsupported by law and particularly improper under the circumstances of this case.

Attorney-client privilege is generally not favored because it "impedes the full and free discovery of the truth," and is "in derogation of the public's right to every man's evidence." *In re Grand Jury Proceedings*, 727 F.2d 1352, 1355 (4th Cir. 1984)(quoting *Herbert v. Lando*, 441 U.S. 153, 175, 99 S. Ct. 1635)(1979)). Thus, the privilege is to be "strictly confined within the

narrowest possible limits consistent with the logic of its principle.” *Id.* For these reasons, Fed. R. Civ. P. 26(b)(5) places the onus on the party asserting the privilege to make a clear assertion of the privilege and provide information, typically in the form of a privilege log, to allow the other party to assess and, if necessary, challenge the claim of privilege.

Applicant has asserted privilege objections to numerous discovery requests by RxD, and presumably, withheld responsive documents on that basis. Applicant has also heavily redacted the lone email it has produced so far, on the basis of some privilege claim. Without the privilege log, RxD has no way of knowing how many documents Applicant has withheld, and whether Applicant’s assertion of privilege is proper. Considering the Applicant’s position that only one individual has the knowledge of the facts relevant to these proceedings and that individual is an attorney, the privilege log Applicant plans to produce at the conclusion of its document production could be overwhelmingly large. The discovery period in this matter is ending on March 31, 2015, which is less than two weeks away. At this time, Applicant has not indicated when it plans to complete the supplemental production that it has agreed to provide, and Applicant may very well not produce a privilege log until after March 31, 2015. Waiting to produce the privilege log until the end of discovery would unreasonably prejudice RxD by forcing RxD to engage in discovery practice after the conclusion of discovery period.

Therefore, Applicant should not be permitted to withhold the privilege log, and ordered to produce privilege log immediately.

E. Improper Designation of Responses as “Trade Secret/Commercially Sensitive”

RxD has challenged Applicant’s designation of its most recent responses as “Trade Secret/Commercially Sensitive” pursuant to the Protective Order governing these proceedings. As can be seen from the responses, they contain no information that is on its face commercially

sensitive or confidential, and, in fact, is often based on publicly available information. *See* Ex. 5; Appendix B. Pursuant to the terms of the Protective Order, now that RxD has challenged the designation, the burden is on Applicant to justify maintaining the designation. Applicant has not even attempted to do so. It is apparent that Applicant is abusing the devices of the Protective Order to unduly shield information from RxD, as it is doing by and through the remainder of its discovery practices. This is clearly improper.

Accordingly, Applicant's designation should be stricken, and Applicant ordered to refrain from over-designation in the future.

IV. Extension of RxD's Discovery Deadlines

In light of the numerous deficiencies in Applicant's responses as outlined above, RxD will not be able to complete its discovery by the current March 31, 2015 deadline, including any follow up discovery that is warranted once RxD finally receives the discovery it has already requested. These circumstances have not been caused by RxD, who has been diligent in pursuing its requests, but by Applicant's failure to respond. The Board has previously recognized that similar circumstances warranted a general extension of the discovery schedule. *See* Order re Extension of Trial and Discovery Deadlines (Feb. 14, 2015). However, in this instance, no extension is warranted for Applicant because of its actions, including the lengthy amounts of time regularly used by Applicant to respond regarding the discovery issues.

RxD therefore requests that the deadlines for it to complete discovery be extended to a time following the receipt of Applicant's responses that is sufficient to allow RxD follow up discovery as needed.

V. Conclusion

TRADE SECRET/COMMERCIALY SENSITIVE

Applicant has refused to provide responses and to produce witnesses in response to numerous requests that seek information that has long been established as properly discoverable pursuant to the controlling law and the Board's rules, and has done so in a concerted effort to prevent RxD and the Board from considering evidence that is relevant to the adjudication of the issues in these proceedings. This behavior is improper. RxD therefore requests that the Board issue an order: (1) compelling Applicant to produce Douglas Vetter for deposition; (2) striking Applicant's objections and compelling it to fully respond to the discovery requests identified in Appendix B; (3) compelling Applicant to produce a privilege log; (4) striking Applicant's improper designations of responses as "Trade Secret/Commercially Sensitive;" and (5) extending the deadline for Applicant's discovery for a period of time sufficient to allow completion following Applicant's compliance with the Board's order.

Dated: March 20, 2015

Respectfully submitted,

RXD MEDIA, LLC
BY COUNSEL

/s/ Cecil E. Key
Cecil E. Key, Esq. (VSB #41018)
Sara M. Sakagami (VSB #77278)

Counsel for RxD Media, LLC.

DiMUROGINSBERG, PC
1101 King Street, Suite 610
Alexandria, Virginia 22314
(703) 684-4333 (telephone)
(703) 548-3181 (facsimile)
e-mail: ckey@dimuro.com
e-mail: ssakagami@dimuro.com

CERTIFICATE OF SERVICE

I hereby certify that on the 6th day of April, 2015, the foregoing redacted version of the Motion originally filed on March 20, 2015 was electronically mailed to the following:

Dale Candali
Claudia Ray
Johanna Schmitt
Allison Buchner
KIRKLAND & ELLIS LLP
601 Lexington Avenue
New York, NY 10022
dale.cendali@kirkland.com,
claudia.ray@kirkland.com,
johanna.schmitt@kirkland.com,
allison.buchner@kirkland.com

 /s/ Cecil E. Key
Cecil E. Key, Esq. (VSB #41018)

APPENDIX A

DISCOVERY REQUESTS CURRENTLY IN DISPUTE

Request Type	Request No.	Topic
Interrogatory	21	Identity of advertising or marketing agencies, including the identification the name of the employee(s) of such agencies having the most relevant knowledge, engaged by Applicant to advertise, promote, or market services offered under the IPAD Mark.
	27	Identity and explanation of any decision to reject any alternative marks considered by Applicant for use in connection with the services described in Applicant's Applications, including in the explanation the identity of the alternative marks that were considered, all persons involved in selecting and rejecting the alternative marks, and the bases for rejection of the alternative marks.
	28	Identity of all officers, directors and managing agents of IP Application Development, LLC from the time the Trinidad & Tobago Application was filed through to the present.
Request for Production	21	Consumer or market studies or surveys that evidence the connotations that the IPAD Mark produces in the minds of Apple, Inc.'s consumers.
	22	Consumer or market studies or surveys that Applicant has conducted, reviewed, or relied on regarding the selection of services to be offered under the IPAD Mark.
	23	Consumer or market studies or surveys that Applicant has ever relied on, or used, in its efforts to market and sell the iPad.
	30	Applicant's knowledge of the use of the IPAD Mark by any third party, regardless of the type of goods and/or services offered under the IPAD Mark, at the time of the filing of the Trinidad & Tobago Application.

Request Type	Request No.	Topic
Request for Production	31	Search reports or investigation reports, conducted by or on behalf of Applicant prior to the filing of Trinidad & Tobago Application regarding the use of the IPAD Mark by others.
	32	Evaluation or assessment of the IPAD Mark as owned or used by others including, but not limited to, valuation of any such IPAD Mark.
	35	Testimony by the Applicant regarding the acquisition of rights in the IPAD mark, including the testimony offered in or regarding the dispute between the Applicant and Shenzhen Provview Technology.
	36	Purchase of the IPAD Mark by the Applicant from Fujitsu, Inc.
	38	Correspondence to and/or from Steve Jobs regarding the adoption of the IPAD Mark.
	39	Correspondence to and/or from Steve Jobs regarding the use of the IPAD Mark for the services described in Applicant's Applications.
	41	Identity of all officers, directors, members, and managing agents of IP Application Development.
	42	Any assignments relating to or regarding any rights Applicant purports to have in the IPAD Mark.

APPENDIX B

APPLICANT'S DOCUMENT PRODUCTION TO-DATE

Production No.	Document Description	Designation
IPADLLC-000001-000007	Trademark/Sales Mark Application No. 76497338	
IPADLLC-000008	Trademark Principal Register Registration No. 3776575	
IPADLLC-000009-000024	Trademark/Sales Mark Application filed 1/16/10 Serial No. 77913563	
IPADLLC-000025-000031	Trademark/Sales Mark Application filed 2/03/10 Serial No. 77927446	
IPADLLC-000032-000037	Trademark/Sales Mark Application filed 2/03/10 Serial No. 77927453	
IPADLLC-000038-000085	Trademark/Sales Mark Application filed 1/16/10 Serial No. 77913563	
IPADLLC-000086-000091	Trademark/Sales Mark Application filed 4/14/10 Serial No. 85014215	
IPADLLC-000092-000097	Trademark/Sales Mark Application filed 4/14/10 Serial No. 85014225	
IPADLLC-000098-000103	Trademark/Sales Mark Application filed 4/14/10 Serial No. 85014233	
IPADLLC-000104-000110	Trademark/Sales Mark Application filed 4/28/10 Serial No. 85025637	
IPADLLC-000111-000117	Trademark/Sales Mark Application filed 5/03/10 Serial No. 85028975	
IPADLLC-000118-000124	Trademark/Sales Mark Application filed 5/03/10 Serial No. 85028997	
IPADLLC-000125-000131	Trademark/Sales Mark Application filed 5/03/10 Serial No. 85029010	
IPADLLC-000132-000139	Trademark/Sales Mark Application filed 11/15/12 Serial No. 85780375	

Production No.	Document Description	Designation
IPADLLC-000140-000148	Google Search for iPad	Attorney's Eyes Only
IPADLLC-000149-000152	IPAD Trademark License Agreement	Attorney's Eyes Only
IPADLLC-000153-000154	Apple Press Release: Apple Launches iPad 5/10/13	
IPADLLC-000155-000161	Trademark/Sales Mark Application filed 3/12/10 Serial No. 77958000	
IPADLLC-000162	4/26/11 RXD's First 30 Day Request for Extension of Time to Oppose Serial No. 85014225	
IPADLLC-000163	4/26/11 PTO's Ltr Granting 30 Day Extension of Time Serial No. 85014225	
IPADLLC-000164	4/26/11 RXD's First 30 Day Request for Extension of Time to Oppose Serial No. 85014233	
IPADLLC-000165	4/26/11 PTO's Ltr Granting 30 Day Extension of Time Serial No. 85014233	
IPADLLC-000166-000207	Printout of Apple website re: iPad, printed on 5/10/13	
IPADLLC-000208-000212	USPTO Office Action for 77913563	
IPADLLC-000213-000214	USPTO Trademark Registration	
IPADLLC-000215-000217	Print out of AT&T website advertisement for iPad devices, printed 11/1/13	
IPADLLC-000218-000219	Printout of Verizon website advertisement for iPad devices, printed 11/1/13	
IPADLLC-000220-000236	Print out of Apple Website re: iPad and iPad Air, printed 11/1/13	
IPADLLC-000237	7/08/09 Email (Redacted)	Attorney's Eyes Only
IPADLLC-000238 – 000249	MISSING	
IPADLLC-000250-000252	Statista.com webpage comparing tablet brands, printed on 2/2/15	

Production No.	Document Description	Designation
IPADLLC-000253-000257	Time.com webpage re “Six Reasons Why Apple Is So Successful”, printed on 2/2/15	
IPADLLC-000258-000272	Techcrunch.com webpage re “Ten Things The iPad Is Good For And Five It Isn’t”, printed on 2/2/15	
IPADLLC-000273-000390	Apple Inc.’s Form 10K Filed 10/27/10 for the Period Ending 09/25/10	
IPADLLC-000391-000496	Apple Inc.’s Form 10K for Fiscal Year Ending 9/24/11	
IPADLLC-000497-000584	Apple Inc.’s Form 10K for Fiscal Year Ending 9/29/12	
IPADLLC-000585-000682	Apple Inc.’s Form 10K Filed 10/30/13 for the Period Ending 09/28/13	
IPADLLC-000683-000800	Apple Inc.’s Form 10K Filed 10/27/14 for the Period Ending 09/27/14	
IPADLLC-000801-000806	Print out of Apple website from Web.archive.org, printed on 2/2/15	
IPADLLC-000807-000815	Print out of Apple Website re: iPad and iPad Air, printed 2/2/15	
IPADLLC-000816-000817	Print out of Apple website from Web.archive.org, printed on 2/2/15	
IPADLLC-000818-000834	Print out of Apple Website re: iPad, printed 2/2/15	
IPADLLC-000835-000836	Print out of Apple website from Web.archive.org, printed on 2/2/15	
IPADLLC-000837-000850	1/27/10 Macworld article re: iPad launch	
IPADLLC-000851-000898	Print out of various 3 rd party webistes such as CNN, Apple Insider, CNet.com, Techtimes re: apple brands including iPad.	
IPADLLC-000899-000911	Print out of Apple Website re: iPad, printed 2/2/15	
IPADLLC-000912-000929	Rankingthebrands.com articles	

Production No.	Document Description	Designation
	re iPad ranking	
IPADLLC-000930	“Kids Top 50 Brands 2014” by Smarty Pants LLC	
IPADLLC-000931-001050	Engadget.com article: “Live from the Apple 'latest creation' event”	
IPADLLC-001051-001056	Rankingthebrands.com article: “Moms' Most Loved Brands 2012”	
IPADLLC-001057-001062	Rankingthebrands.com article: re “Moms' Most Loved Brands 2011”	
IPADLLC-001063	“Moms’ Top 100 Most Loved Brands 2012” by Smarty Pants LLC	
IPADLLC-001064-001065	Print out of Apple Website re: iPad, printed 2/2/15	
IPADLLC-001066-001071	Rankingthebrands.com article: “The Vitruve 100 -Top Social Brands, 2010”	
IPADLLC-001072-001073	Rankingthebrands.com article :re “Top 20 most loved brands 2010”	
IPADLLC-001074-001075	Rankingthebrands.com article re “Top U.S. BrandIndex Buzz Ranking 2012”	
IPADLLC-001076-001078	NYTimes.com article: “With Its Tablet, Apple Blurs Line Between Devices”	



DIMUROGINSBERG PC
ATTORNEYS AT LAW

December 18, 2014

BERNARD J. DIMURO
NINA J. GINSBERG
MICHAEL S. LIEBERMAN
JONATHAN R. MOOK
C. THOMAS HICKS III
STEPHEN L. NEAL, JR.
ANDREA L. MOSELEY
STACEY ROSE HARRIS
KENDALL A. ALMERICO*
M. JARRAD WRIGHT
SARA M. SAKAGAMI
TAYLOR S. CHAPMAN
RACHAEL E. LUZIETTI

VIA Email
Glenn A. Gundersen, Esq.
DECHERT LLP
Cira Center
2929 Arch Street
Philadelphia, PA 19104-2808

Re: *RxD Media, LLC v. IP Application Development LLC*
Opposition Nos. 91207333 (Parent) and 91207598 (TTAB)

Dear Glenn:

As I believe you are aware, the TTAB has now resumed the proceedings in the above-captioned oppositions. As a result, we will be serving RxD Media, LLC's additional discovery requests to you shortly. We will also be providing to you a list of deficiencies we have identified in IP Application Development's discovery responses to date. Of particular note is the lack of any documents or communications

[REDACTED]

(see Response to RxD Interrogatory No. 6), regarding adoption of the IPAD mark.

We also intend to take the depositions of at least the following individuals: Thomas La Perle, Douglas Vetter and Dan Cooperman. Pursuant to the current schedule, these depositions must be completed by February 9, 2015. Accordingly, please let me know the dates that these individuals can be available for deposition in January. If it is IP Application's position that one or more of these individuals is not within IP Application's control, please provide the individual's last known address so that we may issue the proper subpoena.

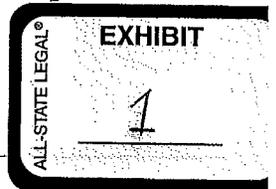
Finally, in light of the intervening holidays, we are willing to discuss a short extension of the current schedule if that is of interest to IP Application. Please let me know and we will put together a proposal.

We otherwise look forward to receiving the available dates for the deponents we have identified.

HARVEY B. COHEN
SENIOR COUNSEL

CECIL E. KEY †
OF COUNSEL
JAY P. KESAN †
OF COUNSEL
TERESA M. SUMMERS †
OF COUNSEL

† MEMBER OF KEY IP LAW GROUP, PLLC
* LICENSED ONLY IN FL



Gundersen

Page 2 of 2

December 18, 2014



DIMURO GINSBERG PC
ATTORNEYS AT LAW

Sincerely,

A handwritten signature in cursive script that reads 'Cecil E. Key'.

Cecil E. Key

Sara Sakagami

From: Cecil Key
Sent: Monday, December 29, 2014 3:11 PM
To: glenn.gundersen@dechert.com
Cc: Sara Sakagami
Subject: RxD v. IP Application Development: Opposer's Third Sets of Discovery Requests
Attachments: RxD's 3rd Interrogatories to IPAD LLC.pdf; RxD's 3rd RPD to IPAD LLC.pdf

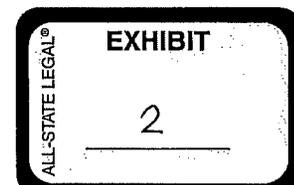
Glenn:

Enclosed please find Opposer RxD Development's Third Set of Requests for Production and Third Set of Interrogatories. to IP Application Development Please note that RxD is withdrawing its Second Set of Discovery Requests (Interrogatories 19-20 and Request for Production 20) which were served on January 21, 2014, but to which IP Application has not yet responded. RxD's withdrawal and reservation as to these requests is noted in the enclosed requests.

We are still awaiting a response to my request for potential deposition dates for the deponents identified in my December 18, 2014 letter. Please provide us with dates as soon as possible so that we can move forward with scheduling the depositions.

Thank you.

Cecil E. Key
DG**Key**Ip Group
1750 Tysons Blvd., Suite 1500
Tysons Corner, VA 22102
(703) 289-5118 (Telephone)
(703) 388-0648 (Facsimile)
(703) 472-5976 (Cell)
Email: ckey@dimuro.com



DIMUROGINSBERG, PC
1101 King Street, Suite 610
Alexandria, Virginia 22314
(703) 684-4333 (telephone)
(703) 548-3181 (facsimile)
e-mail: ckey@dimuro.com
e-mail: ssakagami@dimuro.com

CERTIFICATE OF SERVICE

I hereby certify that on January 20, 2015, a true copy of the foregoing was electronically mailed to the following:

Glenn A. Gundersen
Daniel P. Hope
DECHERT LLP
Cira Centre
2929 Arch Street
Philadelphia, PA 19104-2808
glenn.gundersen@dechert.com
Daniel.Hope@dechert.com
Attorneys for IP Application Development LLC

/s/ Cecil E. Key
Cecil E. Key

Sara Sakagami

From: Hope, Daniel <Daniel.Hope@dechert.com>
Sent: Wednesday, January 28, 2015 11:03 PM
To: Cecil Key
Cc: Sara Sakagami; Gundersen, Glenn
Subject: RxD Media, LLC v. IP Application Development LLC, Opp. Nos. 91207333 and 91207598
Attachments: 2015.01.28 - Applicant's Responses to RxD's 3rd Set of Interrogatories.pdf; 2015.01.28 - Applicant's Responses to RxD's 3rd Set of RFPs.pdf

Dear Cecil,

Please find attached Applicant's responses to Opposer's third sets of interrogatories and requests for production.

Sincerely,
Dan

Daniel P. Hope

Dechert LLP

1095 Avenue of the Americas
New York, New York 10036
Daniel.Hope@dechert.com
Direct: +1 212 698-3657

This e-mail is from Dechert LLP, a law firm, and may contain information that is confidential or privileged. If you are not the intended recipient, do not read, copy or distribute the e-mail or any attachments. Instead, please notify the sender and delete the e-mail and any attachments. Thank you.

Total Control Panel

[Login](#)

To: ssakagami@dimuro.com
From: daniel.hope@dechert.com

Message Score: 1
My Spam Blocking Level: High

High (60): Pass
Medium (75): Pass
Low (90): Pass

[Block](#) this sender
[Block](#) dechert.com

This message was delivered because the content filter score did not exceed your filter level.

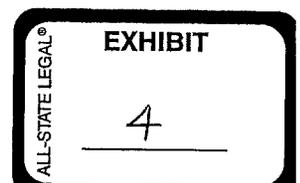


Exhibit 5-6
Marked
Trade Secret/Commercially Sensitive
in Its Entirety



DIMURO GINSBERG PC
ATTORNEYS AT LAW

February 5, 2015

BERNARD J. DIMURO
NINA J. GINSBERG
MICHAEL S. LIEBERMAN
JONATHAN R. MOOK
C. THOMAS HICKS III
STEPHEN L. NEAL, JR.
ANDREA L. MOSELEY
STACEY ROSE HARRIS
KENDALL A. ALMERICCO*
M. JARRAD WRIGHT
SARA M. SAKAGAMI
RACHAEL E. LUZIETTI

VIA Email
Daniel Hope
DECHERT LLP
Cira Center
2929 Arch Street
Philadelphia, PA 19104-2808
Daniel.Hope@dechert.com

Re: *RxD Media, LLC v. IP Application Development LLC*
Opposition Nos. 91207333 (Parent) and 91207598 (TTAB)

HARVEY B. COHEN
SENIOR COUNSEL

Dan:

CEGIL E. KEY †
OF COUNSEL
JAY P. KESAN †
OF COUNSEL
TERESA M. SUMMERS †
OF COUNSEL

Further to my January 29, 2015 email, outlined below are the deficiencies we have identified in *Applicant's Responses and Objections to Opposer RxD Media, LLC's Third Set of Interrogatories to IP Application Development LLC* ("Applicant's 3d Interrogatory Responses") and *Applicant's Responses and Objections to Opposer RxD Media, LLC's Third Set of Requests for Production of Documents and Things to IP Application Development* ("Applicant's 3d Document Responses"). Once you have reviewed our positions, please let us know if you would like to schedule a call to discuss further.

Applicant's Unfounded Boilerplate Objections.

At the outset, there are certain unfounded objections that Applicant has made to virtually every request in both Applicant's 3d Interrogatory Responses and Applicant's 3d Document Responses. For example:

1. Applicant consistently objects to Opposer's requests as "overly broad, unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence" if the requests seek information that is not limited to "the services identified in" the applications being challenged in these proceedings. *See, e.g., Applicant's 3d Interrogatory Responses, at Interrogatories Nos. 21, and 25-26; Applicant's 3d Document Responses, at Responses Nos. 21-23, 25, 30-33, 35-38, 40, and 42.* The scope of services that a defending party offers is directly relevant to issues such as establishing the relationship between the goods or services of the

† MEMBER OF KEY IP LAW GROUP, PLLC
* LICENSED ONLY IN FL





parties, and is thus discoverable. *See* TBMP § 414. Thus, Applicant cannot properly withhold information based on this objection, and it must be withdrawn.

2. Applicant also consistently objects to Opposer's requests as not reasonably calculated to lead to the discovery of admissible evidence because the challenged applications "were filed under Trademark Act Section 1(b) on an intent-to-use basis." *See, e.g.*, Applicant's 3d Interrogatory Responses, at Interrogatories Nos. 21-24; Applicant's 3d Document Responses, at Responses Nos. 23-29, 33, 37, 39-40. Information probative of the relationship of the goods or services of the parties, even if it involves marks not at issue or goods and services not described in the challenged application, is discoverable. *See* TBMP § 414. Thus, Applicant cannot properly withhold information simply because the applications at issue are filed on an intent-to-use basis, and that objection must be withdrawn.

3. Applicant frequently objects to requests as unduly burdensome if they request documents that, according to Applicant, are "publicly available and equally accessible by Opposer." *See, e.g.*, Applicant's 3d Document Responses, at Responses Nos. 25, 27-28. This objection is improper; the fact that information, even publicly available information, is in the possession, custody or control of a party may be probative of the party's knowledge of a fact or issue in the proceedings, and is discoverable. Thus, Applicant cannot properly withhold information based on this objection, but has seemingly used the objection as an excuse to avoid producing responsive, non-public documents.

Applicant's Deficient Interrogatory Responses.

Interrogatory No. 21:

Interrogatory 21 is directed to the identification of advertising and marketing agencies engaged by Applicant or its licensee regarding advertising and promotion of services under the mark at issue. Such information is discoverable. *See* TBMP § 414. In addition to the unfounded boilerplate objections noted above, Applicant's objection that the request is "without regard to whether such information is relevant to any of the issues in these proceedings," is evasive and contrary to the Board's established rules. Moreover, Applicant's answer is incomplete and nonresponsive. [REDACTED]



The unfounded objections must therefore be withdrawn and a complete answer provided.

Interrogatory No. 22:

Interrogatory 22 is directed to the identification of trade channels and avenues through which Applicant offers or intends to offer the services described in the challenged applications. Such information is discoverable. *See* TBMP § 414; *see also In re E.I du Pont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973). Applicant has nevertheless imposed numerous objections, including the unfounded boilerplate objections noted above.

The unfounded objections must therefore be withdrawn and a complete answer provided.

Interrogatory No. 23:

Interrogatory 23 is directed to the identification of other marks under which Applicant offers the services described in the challenged applications. This information is discoverable. *See* TBMP § 414. Based on the unfounded boilerplate objections noted above, Applicant has provided an evasive and nonresponsive answer. The interrogatory is not limited to the services described in the challenged applications, and Applicant cannot unilaterally impose such a limitation. This is particularly so because Applicant relied on other marks under which the same services as those described in the challenged applications were purportedly offered to overcome the examiner's rejections during prosecution of the challenged applications.

The unfounded objections must therefore be withdrawn and a complete answer provided.

Interrogatory No. 24:

Interrogatory is directed to the class or classes of consumers to whom Applicant offers or intends to offer the services described in the challenged applications. In addition to the unfounded boilerplate objections noted above, Applicant has objected that the term "class(es) of consumers" is vague and ambiguous. The term "class of consumers" is a well-understood term of art, and the class of consumers to whom an applicant sells is clearly discoverable. *See* TBMP § 414; *see also R.J. Ants, Inc. v. Marinelli Enterprises, LLC*, 771 F.Supp.2d 475 (E.D.Pa., 2011).



The unfounded objections must therefore be withdrawn and a complete answer provided.

Interrogatory No. 25:

Interrogatory 25 is directed to uses of the mark at issue by others that Applicant was aware of when it filed the application on which it has based its claim of priority in the United States. Information regarding others' uses of the same mark of which the Applicant was aware at the time of its application is clearly discoverable, as is information regarding foreign uses when such foreign uses relate to a claim of priority in the United States. *See* TBMP § 414. In addition to the unfounded boilerplate objections noted above, Applicant objected that the request was made "without regard to whether such information is relevant to any of the issues in these proceedings," as seeking information covered by work product immunity or attorney-client privilege, and as not being geographically limited to the United States. These objections are baseless for the reasons stated above, and because Applicant has not presented sufficient information to allow Opposer to determine the basis for any claim of privilege.

The unfounded objections must therefore be withdrawn and a complete answer provided.

Interrogatory No. 26:

Interrogatory 26 is directed to Applicant's plans for expansion of use of the mark at issue. Such information is clearly discoverable. *See* TBMP § 414. In addition to the unfounded boilerplate objections noted above, Applicant has objected that the request was made "without regard to whether such information is relevant to any of the issues in these proceedings," and further objected based on an assertion of work product and attorney-client privilege. These objections are baseless for the reasons stated above, and because Applicant has not presented sufficient information to allow Opposer to determine the basis for any claim of privilege. Based on these improper objections, [REDACTED]

[REDACTED] This answer is nonresponsive and evasive.

The unfounded objections must therefore be withdrawn and a complete answer provided.



Interrogatory No. 27:

Interrogatory 27 is directed to alternative marks considered and rejected by Applicant. This information is clearly discoverable. *See* TBMP § 414. Applicant has nevertheless objected that the request is “wholly irrelevant to the issues in these proceedings,” alleged that the request is duplicative of Interrogatories Nos. 5 and 6, and objected based on the assertion of work product and attorney-client privilege. The first objection is baseless for the reasons stated above, the second is based on a complete misreading of Interrogatories 5 and 6, which are directed to the entirely separate question of Applicant’s explanation of why it chose the mark at issue. As to the assertion of work product and attorney-client privilege, Applicant has not presented sufficient information to allow Opposer to determine the basis for any claim of privilege. Based on these improper objections, Applicant has provided no answer to Opposer’s interrogatory.

The unfounded objections must therefore be withdrawn and a complete answer provided.

Interrogatory No. 28:

Interrogatory 28 is directed to the identification of Applicant’s officers, directors and managing agents. This information is clearly discoverable. *See* TBMP § 414. Applicant nevertheless objects that the request has been made “without regard to whether such information is relevant to any of the issues in these proceedings.” Based on these improper objections, [REDACTED] since the time that the application on which Applicant bases its claim of priority was filed.

The unfounded objections must therefore be withdrawn and a complete answer provided.

Applicant’s Deficient Document Responses.

In general, it does not appear that Applicant has undertaken good faith efforts to search for and identify responsive documents. For example, for several of Applicant’s responses, Applicant objects to the request even though its response suggests that as of the date of the response, it had not yet begun to identify documents. *See, e.g.*, Applicant’s 3d Document Responses, at Response 21 (“Applicant states that



it will search for and produce non-privileged documents ...”). Applicant’s document production bears out this concern. To date, Applicant has produced little more than copies of the Apple website, and public filings such as trademark applications and SEC submissions. Among the most notable missing documents are internal communications between and among the relevant participants regarding adoption and use of the mark at issue, documents evidencing what other uses of the mark Applicant was aware of at the time it adopted the mark, and documents regarding any efforts to enforce the mark or resolve conflicts concerning the mark. All are directly relevant to the issues in these proceedings (likelihood of confusion, priority, secondary meaning, good faith adoption, etc.), and are thus discoverable. When taken together with the sparse production, Applicant’s responses are evasive, as further demonstrated by our further specific concerns identified below.

Request No. 21

Request 21 is directed to consumer or market studies that evidence the connotation the mark at issue has in the minds of consumers. This information is clearly discoverable. *See* TBMP § 414. Applicant has nevertheless objected based on the unfounded boilerplate objections noted above, and produced virtually no responsive documents, despite asserting that the mark was allegedly considered for adoption years before the challenged applications were filed.

Applicant should therefore confirm that no documents are being withheld based on the improper objections, and that documents that are in the possession, custody, or control of Applicant and that are responsive to the full scope of the request will be produced following a good faith search.

Request No. 22

Request 22 is directed to consumer or market studies conducted by Applicant regarding the services with which the mark at issue is to be used. This information is clearly discoverable. *See* TBMP § 414. Applicant has nevertheless objected based on the unfounded boilerplate objections noted above, and produced virtually no responsive documents, despite asserting that the mark was allegedly considered for adoption years before the challenged applications were filed. Moreover, Applicant’s response that “it is not aware of any non-privileged documents” responsive to the request is nonresponsive because it is unclear whether any responsive documents were located, neither confirms nor denies that a good faith search consistent with the full scope of the request has been or will be conducted, and does not provide sufficient



information for Applicant to assess the claim of privilege.

Applicant should therefore confirm that no documents are being withheld based on the improper objections, and that documents that are in the possession, custody, or control of Applicant and that are responsive to the full scope of the request will be produced following a good faith search.

Request No. 23

Request 23 is directed to consumer or market studies that Applicant or its licensee has relied on in efforts to market the iPad device, the sales and marketing of which Applicant relied on to overcome the examiner's rejections during prosecution of the challenged applications. This information is clearly discoverable. *See* TBMP § 414. Applicant has nevertheless objected based on the unfounded boilerplate objections noted above, and produced virtually no responsive documents as requested,

Moreover, Applicant's response that "it is not aware of any non-privileged documents" responsive to the request is nonresponsive because it is unclear whether any responsive documents were located, neither confirms nor denies that a good faith search consistent with the full scope of the request has been or will be conducted, and does not provide sufficient information for Applicant to assess the claim of privilege.

Applicant should therefore confirm that no documents are being withheld based on the improper objections, and that documents that are in the possession, custody, or control of Applicant and that are responsive to the full scope of the request will be produced following a good faith search.

Request No. 24

Request 24 is directed to the identification of the classes of consumers to whom Applicant offers or intends to offer the services described in the challenged applications. This information is clearly discoverable. *See* TBMP § 414. Applicant has nevertheless objected based on the unfounded boilerplate objections noted above, and produced virtually no responsive documents,

Applicant has also provided a response that is nonresponsive because Applicant's statement that it will limit its search to documents "it reasonably believes to be responsive" neither confirms nor denies that a good faith search consistent with the



full scope of the request has been or will be conducted.

Applicant should therefore confirm that no documents are being withheld based on the improper objections, and that documents that are in the possession, custody, or control of Applicant and that are responsive to the full scope of the request will be produced following a good faith search.

Request No. 25

Request 25 is directed to documents regarding the marketing of any services offered by Applicant's licensee in connection with the iPad device, the sales and marketing of which Applicant relied on to overcome the examiner's rejections during prosecution of the challenged applications. This information is clearly discoverable. *See* TBMP § 414. Applicant has nevertheless objected based on the unfounded boilerplate objections noted above, and produced virtually no responsive documents. Applicant has also objected that the request seeks "documents concerning 'the use of the IPAD Mark by any third party,'" even though that is not the subject of the request, and provided a response that is nonresponsive because [REDACTED], and because Applicant's statement that it will limit its search to documents "it reasonably believes to be responsive" neither confirms nor denies that a good faith search consistent with the full scope of the request has been or will be conducted.

Applicant should therefore confirm that no documents are being withheld based on the improper objections, and that documents that are in the possession, custody, or control of Applicant and that are responsive to the full scope of the request will be produced following a good faith search.

Request No. 26

Request 26 is directed to the channels of distribution for the services described in the challenged applications. This information is clearly discoverable. *See* TBMP § 414. Applicant has nevertheless objected based on the unfounded boilerplate objections noted above, and produced virtually no responsive documents. Applicant has provided a response that is nonresponsive because Applicant's statement that it is "not aware" of documents "it reasonably believes to be responsive" neither confirms nor denies that a good faith search consistent with the full scope of the request has been or will be conducted.



Applicant should therefore confirm that no documents are being withheld based on the improper objections, and that documents that are in the possession, custody, or control of Applicant and that are responsive to the full scope of the request will be produced following a good faith search.

Request No. 27

Request 27 is directed to consumer views or comments regarding any services offered under the mark at issue or in connection with the iPad device, the sales and marketing of which Applicant relied on to overcome the examiner's rejections during prosecution of the challenged applications. This information is clearly discoverable. *See* TBMP § 414. Applicant has nevertheless objected based on the unfounded boilerplate objections noted above, and produced virtually no responsive documents. Applicant has also provided a response that is nonresponsive because Applicant's statement that it will limit its search to documents "it reasonably believes to be responsive" neither confirms nor denies that a good faith search consistent with the full scope of the request has been or will be conducted.

Applicant should therefore confirm that no documents are being withheld based on the improper objections, and that documents that are in the possession, custody, or control of Applicant and that are responsive to the full scope of the request will be produced following a good faith search.

Request No. 28

Request 28 is directed to the sales and profits of the iPad device, the sales and marketing of which Applicant relied on in overcoming the examiner's rejections during prosecution of the challenged applications. This information is clearly discoverable. *See* TBMP § 414. Applicant has produced some publicly available documents, but has also objected based on the unfounded boilerplate objections noted above.

Applicant should therefore confirm that no documents are being withheld based on the improper objections, and that documents that are in the possession, custody, or control of Applicant and that are responsive to the full scope of the request will be produced following a good faith search.



Request No. 29

Request 29 is directed to the description of the category to which the services offered under the mark at issue belong. This information is clearly discoverable. *See* TBMP § 414. Applicant has nevertheless objected based on the unfounded boilerplate objections noted above, and produced no responsive documents. Applicant has also objected that the term “any method of describing” is vague and ambiguous, even though that term appears in the Board’s rules expressly delineating information that is discoverable. *See id.*, at 400-132. Applicant then provided a response that is nonresponsive because

[REDACTED]

Applicant should therefore confirm that no documents are being withheld based on the improper objections, and that documents that are in the possession, custody, or control of Applicant and that are responsive to the full scope of the request will be produced following a good faith search.

Request No. 30

Request 30 is directed to Applicant’s knowledge of use of the mark at issue by any third party. This information is clearly discoverable. *See* TBMP § 414. Applicant has nevertheless objected based on the unfounded boilerplate objections noted above, and produced no responsive documents. Applicant then provided a response that is nonresponsive because the statement that Applicant is “not aware of any non-privileged documents” that “it reasonably believes to be responsive” neither confirms nor denies that a good faith search consistent with the full scope of the request has been or will be conducted. To the contrary, Applicant’s response to Request No. 31 suggests that

[REDACTED]

Applicant should therefore confirm that no documents are being withheld based on the improper objections, and that documents that are in the possession, custody, or control of Applicant and that are responsive to the full scope of the request will be produced following a good faith search.



Request No. 31

Request 31 is directed to search reports regarding the availability of the mark at issue that were conducted by Applicant prior to the time the application on which Applicant bases its priority claims was filed. This information is clearly discoverable. *See* TBMP § 414. Applicant has nevertheless objected based on the unfounded boilerplate objections noted above, and produced virtually no responsive documents. In its response, Applicant neither confirms nor denies that a good faith search consistent with the full scope of the request has been or will be conducted, despite alleging in other discovery responses [REDACTED]

Applicant should therefore confirm that no documents are being withheld based on the improper objections, and that documents that are in the possession, custody, or control of Applicant and that are responsive to the full scope of the request will be produced following a good faith search.

Request No. 32

Request 32 is directed to Applicant's evaluation or assessment of rights others might have in the mark at issue, including information probative of that assessment, such as valuation. This information is clearly discoverable. *See* TBMP § 414. Applicant has nevertheless objected based on the unfounded boilerplate objections noted above, and produced no responsive documents. Applicant has further objected that the request for valuation of such third party marks is "wholly irrelevant to the issues in these proceedings," despite the fact that valuation is probative of Applicant's basis for selecting and adopting the mark at issue, which is discoverable, especially from a party such as Applicant in the defendant's position. *See id.*

Applicant should therefore confirm that no documents are being withheld based on the improper objections, and that documents that are in the possession, custody, or control of Applicant and that are responsive to the full scope of the request will be produced following a good faith search.

Request No. 33

Request 33 is directed to the identification of all goods and services with which Applicant or its licensees have used the mark at issue. This information is clearly discoverable. *See* TBMP § 414. Applicant has nevertheless objected based on the unfounded boilerplate objections noted above, and produced virtually no responsive



documents. Applicant's response [REDACTED] and thus will not reliably identify all goods and services with which the mark has been used over the relevant time period, and the response neither confirms nor denies that a good faith search consistent with the full scope of the request has been or will be conducted.

Applicant should therefore confirm that no documents are being withheld based on the improper objections, and that documents that are in the possession, custody, or control of Applicant and that are responsive to the full scope of the request will be produced following a good faith search.

Request No. 34

Request 34 is directed to documents regarding the application on which Applicant based its claim of priority, including those establishing Applicant's ownership of the application. This information is clearly discoverable. *See* TBMP § 414. Applicant's objection that the request relates to "matters that are not geographically limited to the United States" is unfounded because Applicant put the subject of the foreign application at issue when it relied on it as a basis for establishing priority of rights in the United States. In addition Applicant's response is nonresponsive because the statement that Applicant will search for documents "it reasonably believes are responsive" neither confirms nor denies that a good faith search consistent with the full scope of the request has been or will be conducted.

Applicant should therefore confirm that no documents are being withheld based on the improper objection, and that documents that are in the possession, custody, or control of Applicant and that are responsive to the full scope of the request will be produced following a good faith search.

Request No. 35

Request 35 is directed to documents relating to the circumstances by which Applicant obtained rights to the mark at issue from a prior owner. This information is clearly discoverable. *See* TBMP § 414. Applicant has nevertheless objected based on the unfounded boilerplate objections noted above, and other objections that are equally baseless. Applicant has objected that the subject of the request is "wholly irrelevant to the issues in these proceedings," and that it seeks documents relating to "matters that are not geographically limited to the United States." Applicant, however, made the



subject matter of the request relevant by relying on other marks and uses as a basis for overcoming the examiner's rejections during prosecution of the challenged applications, and by relying on rights outside the United States to establish priority of rights inside the United States. Opposer is entitled to explore these issues in discovery, *see id.*, but Applicant has produced no responsive documents. Moreover, Applicant neither confirms nor denies that a good faith search consistent with the full scope of the request has been or will be conducted.

Applicant should therefore confirm that no documents are being withheld based on the improper objections, and that documents that are in the possession, custody, or control of Applicant and that are responsive to the full scope of the request will be produced following a good faith search.

Request No. 36

Request 36, like Request 35, is directed to Application's acquisition of rights in the mark as issue from another third party. This information is clearly discoverable. *See* TBMP § 414. Applicant has nevertheless objected based on the unfounded boilerplate objections noted above, and other objections that are equally baseless. For example, Applicant has objected that the subject of the request is "wholly irrelevant to the issues in these proceedings." Applicant, however, made the subject matter of the request relevant by relying on other marks and uses as a basis for overcoming the examiner's rejections during prosecution of the challenged applications. Opposer is entitled to explore this issue in discovery, *see id.*, but Applicant has produced no responsive documents. Moreover, Applicant has provided a response that is nonresponsive because [REDACTED] and neither confirms nor denies that a good faith search consistent with the full scope of the request has been or will be conducted.

Applicant should therefore confirm that no documents are being withheld based on the improper objections, and that documents that are in the possession, custody, or control of Applicant and that are responsive to the full scope of the request will be produced following a good faith search.

Request No. 37

Request 37 is directed to promotional materials and statements issued by Applicant's licensee upon the introduction of the iPad device, the sales and marketing of which Applicant relied on in overcoming the examiner's rejections during



prosecution of the challenged applications. This information is clearly discoverable. *See* TBMP § 414. Applicant has nevertheless objected based on the unfounded boilerplate objections noted above, and produced virtually no responsive documents. Applicant has also provided a response that is nonresponsive because the statement that Applicant will search for documents that “it reasonably believes are responsive” neither confirms nor denies that a good faith search consistent with the full scope of the request has been or will be conducted.

Applicant should therefore confirm that no documents are being withheld based on the improper objections, and that documents that are in the possession, custody, or control of Applicant and that are responsive to the full scope of the request will be produced following a good faith search.

Request No. 38

Request 38 is directed to correspondence to and from the late Steve Jobs, who Applicant has identified as the person primarily responsible for the decision to adopt the mark at issue, regarding adoption of the mark. This information is clearly discoverable. *See* TBMP § 414. Applicant has nevertheless objected based on the unfounded boilerplate objections noted above, and other objections that are equally baseless. For example, Applicant objected that the subject of the request is “plainly irrelevant” based on unilateral averments, such as when the mark at issue was allegedly adopted, in Applicant’s other discovery responses. Opposer is entitled to discovery that is probative of these averments, and [REDACTED]

[REDACTED] Based on these objections, Applicant has provided a response that is nonresponsive because the statement that Applicant “is not aware” of documents that “it believes to be responsive” neither confirms nor denies that a good faith search consistent with the full scope of the request has been or will be conducted.

Applicant should therefore confirm that no documents are being withheld based on the improper objections, and that documents that are in the possession, custody, or control of Applicant and that are responsive to the full scope of the request will be produced following a good faith search.

Request No. 39

Request 39 is directed to correspondence to and from the late Steve Jobs, who Applicant has identified as the person primarily responsible for the decision to adopt



the mark at issue, regarding the services with which the mark is or was to be used. This information is clearly discoverable. *See* TBMP § 414. Applicant has nevertheless objected based on the unfounded boilerplate objections noted above, and produced no responsive documents. Based on these objections, Applicant has provided a response that is nonresponsive because the statement that Applicant “is not aware” of documents that “it believes to be responsive” neither confirms nor denies that a good faith search consistent with the full scope of the request has been or will be conducted.

Applicant should therefore confirm that no documents are being withheld based on the improper objections, and that documents that are in the possession, custody, or control of Applicant and that are responsive to the full scope of the request will be produced following a good faith search.

Request No. 40

Request 40 is directed to any goods or services offered by Applicant or its licensees. This information is clearly discoverable. *See* TBMP § 414. Applicant has nevertheless objected based on the unfounded boilerplate objections noted above, and other objections that are equally baseless. For example, Applicant objected to the request as duplicative of Opposer’s Request No. 33, which is limited to the goods and services with which Applicant or its licensees used the mark at issue, and then further objected that the subject of the request is overly broad, unduly burdensome and not reasonably calculated to the discovery of admissible evidence because it is not limited to use of the mark at issue. Applicant placed goods and services offered under other marks at issue when it relied on those other uses in overcoming the examiner’s rejections during prosecution of the challenged applications. Opposer is entitled to discovery on those issues. *See id.* Applicant’s response whereby it merely refers Opposer to the response to Request No. 33, which is itself deficient for the reasons outlined above, is therefore nonresponsive. The response is also nonresponsive because it neither confirms nor denies that a good faith search consistent with the full scope of the request has been or will be conducted.

Applicant should therefore confirm that no documents are being withheld based on the improper objections, and that documents that are in the possession, custody, or control of Applicant and that are responsive to the full scope of the request will be produced following a good faith search.



Request No. 41

Request 41 is directed to documents sufficient to identify all officers, directors, members and managing agents of Applicant. This information is clearly discoverable. *See* TBMP § 414. Despite the Board's clear rules on the discoverability of the subject matter to this request, Applicant has nevertheless objected that the request is made "without regard to whether such documents are relevant to any of the issues in these proceedings." Applicant's response is also nonresponsive because [REDACTED] and neither confirms nor denies that a good faith search consistent with the full scope of the request has been or will be conducted.

Applicant should therefore confirm that no documents are being withheld based on the improper objections, and that documents that are in the possession, custody, or control of Applicant and that are responsive to the full scope of the request will be produced following a good faith search.

Request No. 42

Request 42 is directed to any assignments that evidence rights, including ownership rights, Applicant purports to have in the mark at issue. This information is clearly discoverable. *See* TBMP § 414. Applicant has nevertheless objected based on the unfounded boilerplate objections noted above, and produced no additional documents. Applicant's response is also nonresponsive because [REDACTED] and neither confirms nor denies that a good faith search consistent with the full scope of the request has been or will be conducted.

Applicant should therefore confirm that no documents are being withheld based on the improper objections, and that documents that are in the possession, custody, or control of Applicant and that are responsive to the full scope of the request will be produced following a good faith search.

Other Issues.

Applicant has designated both Applicant's 3d Interrogatory Responses and Applicant's 3d Document Responses as "Trade Secret/Commercially Sensitive." The



DiMURO GINSBERG PC
ATTORNEYS AT LAW

Daniel Hope
February 5, 2015
Page 17

Responses do not warrant such designation. As noted above, the Responses are generally nonresponsive and evasive, and contain no information that is commercially sensitive or will provide a competitive advantage. Moreover, the references to the documents previously designated as "Trade Secret/Commercially Sensitive," without revealing their content, do not justify such designation. We therefore request that the "Trade Secret/Commercially Sensitive" designation of the Requests be withdrawn. *See* TBMP § 412.

Lastly, your position regarding the privilege log we have requested, namely that we have to explain our request for the privilege log, is unfounded and flatly contrary to the rules. Pursuant to Fed. R. Civ. P. 26(b)(5), it is the duty of the party asserting the privilege to make a clear assertion of the privilege and provide information, typically in the form of a privilege log, to allow the other party to assess and, if necessary, challenge the claim of privilege. Considering that you have asserted numerous objections to our discovery requests based on work product and attorney-client privilege, as well as having redacted at least one document, presumably on the basis of some privilege claim, it is your duty to provide us with the privilege log. Having failed to do so, it is well within the Rules for us to move for the Board's ruling that privilege has been waived and lost.

We look forward to getting these issues resolved promptly, and in advance of the depositions we have noticed. We therefore remain available for telephone conference to further discuss the issues we have identified. Failing resolution of the issues, we will have no choice but to take the matter before the Board.

We look forward to receiving your response.

Sincerely,

A handwritten signature in cursive script, appearing to read 'Cecil E. Key', written over a printed name.

Cecil E. Key

cc: Glenn Gundersen

DANIEL P. HOPE

daniel.hope@dechert.com
+1 212 698 3657 Direct
+1 212 698 3599 Fax

February 19, 2015

BY EMAIL

Cecil E. Key & Sara Sakagami
DiMuroGinsberg PC
1101 King Street, Suite 610
Alexandria, VA 22314

Re: *RxD Media, LLC v. IP Application Development LLC*, Opposition Nos. 91207333 and 91207598

Dear Cecil and Sara:

We write regarding outstanding discovery issues, including the depositions noticed by both parties in these proceedings and your lengthy February 5, 2015 letter alleging deficiencies in Applicant's responses to Opposer's third sets of interrogatories and requests for production.

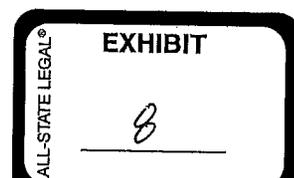
Depositions

As you know, Mr. La Perle's previously scheduled deposition had to be postponed as a result of his unexpectedly having to undergo surgery. Please note that Mr. La Perle is available to be deposed in his individual and 30(b)(6) capacities March 16-20, 2015. Please confirm the date so that we may make the necessary arrangements.

Applicant will not produce Doug Vetter for deposition. There are no discovery issues cited in your February 5th deficiency allegations about which Mr. Vetter would have unique and superior knowledge, and you have cited no reasons that would warrant the parties' expending resources on his deposition. As you know, Mr. Vetter and Mr. La Perle are both employees of Apple Inc. and, to the extent that RxD has any question about Mr. Vetter's role, it can be fully explored and satisfied during the 30(b)(6) deposition. If RxD believes it is necessary to otherwise document Mr. Vetter's lack of personal knowledge that is relevant to this dispute, it should do so through less wasteful and intrusive written discovery.

As to Applicant's notices to depose RxD's 30(b)(6) witness and Keith Clements, we are available to conduct the depositions the week of March 2-6, 2015, as suggested in your February 2, 2015 email. We are also available the week of March 9-13, 2015. Please let us know which date

US Austin Boston Charlotte Hartford Los Angeles New York Orange County Philadelphia Princeton San Francisco Silicon Valley
Washington DC EUROPE Brussels Dublin Frankfurt London Luxembourg Moscow Munich Paris ASIA Beijing Hong Kong



works best for you and identify the individual who will serve as RxD's 30(b)(6) designee so that we may make the necessary arrangements.

RxD's February 5, 2015 Deficiency Allegations

RxD's 17-page letter alleging discovery deficiencies comes after 20 months of discovery in these proceedings. During that time, Applicant provided substantive answers to RxD's interrogatories, and counsel for the parties exchanged numerous communications relating to a wide range of discovery issues, which resulted in Applicant's supplementation of its discovery responses and document production. Now, you have alleged non-specific deficiencies with virtually every outstanding interrogatory. This is a transparent attempt to manufacture a discovery dispute, and not a good faith effort to resolve issues that are relevant to these proceedings.

Each of the allegations set forth in your February 5th letter is based primarily, if not solely, on whether or not certain broad categories of materials are "discoverable," pursuant to TBMP §414. However, your letter repeatedly misrepresents the substance of TBMP § 414. That section does not support your statements that the following categories of information, among others, are discoverable:

- "the scope of services that a defending party offers," irrespective of whether such services are identified in the application at issue (RxD's Feb. 5, 2015 letter at 1-2);
- information relating to the relationship of parties' goods or services, "even if it involves marks not at issue or goods and services not described in the challenged application" (*Id.* at 2); and
- information regarding "foreign uses when such foreign uses relate to a claim of priority in the United States" (*Id.* at 4).

Needless to say, the fact that information may be generally considered discoverable does not automatically mean that it is relevant to these proceedings. TBMP §414 expressly provides that "[a] party need not provide discovery with respect to those of its marks and goods and/or services that are not involved in the proceeding and have no relevance thereto." TBMP § 414(11). Here, RxD's discovery requests are not restricted in any meaningful manner to the IPAD Mark, the services identified in the opposed applications that allegedly conflict with the services identified in RxD's IPAD application, trademark use in the United States, or a relevant time period. Accordingly, Applicant declines to withdraw its objections on relevance grounds.

RxD continues to demand information regarding Applicant's current use of the IPAD Mark, despite the fact that the opposed applications were filed on an intent-to-use basis. Applicant

declines to withdraw its objections to these discovery requests and to RxD's discovery requests for publicly available information. Such requests are improper insofar as and to the extent that they purport to require Applicant to search for and obtain information that is equally accessible to RxD or to manufacture responsive documents and information for the sole purpose of these proceedings.

Applicant will not withdraw its Trade Secret/Commercially Sensitive confidentiality designation of its discovery responses. We disagree with your conclusion that Applicant's responses are not commercially sensitive. Applicant reasonably believes that its responses to RxD's requests for information regarding the manner in which Applicant intends use its IPAD Mark contain substantive and competitive information that is confidential or trade secret in nature. *See* TBMP § 412.02. Furthermore, you have not explained how Applicant's confidentiality designation would prejudice Opposer in these proceedings. Applicant hereby expressly reserves all rights and remedies to redress any violation by RxD of the operative protective order in these proceedings.

RxD's Third Set of Interrogatories ("Interrogatory" or "Interrogatories")

Your February 5th letter fails to raise any specific concerns with the substantive responses that Applicant has already provided to RxD's Interrogatories, which prevents Applicant from understanding what sort of information is missing from its responses. Instead, your deficiency allegations generally comprise unsupported demands for the withdrawal of some or all of Applicant's objections and a "complete response" – which Applicant has already provided to most, if not all of these Interrogatories. To the extent that RxD has genuine concerns over Applicant's responses, it must identify the specific issue to which each Interrogatory relates and explain how it is relevant to the IPAD Mark and the specific services identified in the parties' respective trademark applications that may conflict. Absent such information, Applicant can only speculate about the basis of your disagreement with its objections and responses.

Interrogatory No. 21 refers to "services offered under the IPAD Mark" and Interrogatory Nos. 22, 23, and 24 refer to "the services described in Applicant's Applications." However, as you are aware, Applicant's applications describe services in International Classes 35, 38, 39, and 42, while RxD's application covers only a single service in Class 42. Interrogatory Nos. 22, 23, and 24 do not specify which of the services in Applicant's applications are relevant to RxD's claim of priority and likelihood of confusion, and Interrogatory No. 21 is not even limited to the services described in Applicant's applications. Thus, all of these interrogatories are overbroad and seek irrelevant information."

- **Interrogatory No. 21** – As indicated above, this interrogatory requests information about services beyond those described in Applicant's applications. In any event, Applicant has

already completely responded to RxD's facially overbroad request for information regarding "any and all" advertising and marketing agencies by stating that [REDACTED]

[REDACTED] This response provides a representative sampling of the information sought, as provided under TBMP §414(2). RxD fails to explain how the identity of advertising and marketing agencies engaged by Applicant, if any, would be relevant to the issues in this proceeding. Applicant hereby maintains and restates its objections and states that it is not withholding information based on its objections.

- **Interrogatory No. 22** – As discussed above, this interrogatory requests information about all services described in Applicant's applications, without specifying which services are relevant to RxD's claims. In any event, Applicant has already completely responded to RxD's facially overbroad request for information regarding "all trade channels or avenues" by stating that [REDACTED]

RxD does not attempt to explain the basis of its disagreement with Applicant's objections or how Applicant's offering of similar or even identical services under other marks would be relevant to the issues in these proceedings. Applicant hereby maintains and restates its objections and states that it is not withholding information based on its objections.

- **Interrogatory No. 23** – This Interrogatory asks Applicant to "[i]dentify by registration or application number, the mark(s) under which you offer the services described in Applicant's Applications." Because these proceedings are limited in scope to the IPAD Mark and the services identified in the applications at issue that could possibly conflict with the services identified in RxD's application to register IPAD, Applicant has already completely responded [REDACTED] Applicant hereby maintains and restates its objections.

- **Interrogatory No. 24** – Applicant has already completely responded to RxD's request for information regarding "class(es) of consumers" by stating that [REDACTED]

[REDACTED] RxD fails to explain how information concerning the classes of consumers to whom Applicant offers services under other marks would be relevant to the issues in this proceeding. Applicant hereby maintains and restates its objections and states that it is not withholding information based on its objections.

- **Interrogatory No. 25** – Applicant hereby maintains and restates its objections. In making new demands, RxD improperly disregards previous agreements between counsel, which resulted in an appropriate restriction of the scope of this discovery issue. As you know, Applicant has already completely responded to RxD’s request for information regarding “all goods and services offered by any third party under the IPAD Mark of which you were aware” by specifically directing RxD to document(s) that were produced in these proceedings.
- **Interrogatory No. 26** – Applicant has already completely responded to RxD’s facially overbroad request for information regarding “all plans you have for expansion of the use of the IPAD Mark” by stating that [REDACTED] RxD does not explain how Applicant’s plans to expand its use of the IPAD Mark would be relevant to the issues in these proceedings. Applicant hereby maintains and restates its objections and states that it is not withholding information based on its privilege objections.
- **Interrogatory No. 27** – RxD offers no explanation as to how information concerning decisions to reject other marks could possibly be relevant to the issues in these proceedings. Accordingly, Applicant maintains and restates its objections and declines to supplement or amend its response.
- **Interrogatory No. 28** – Applicant has already completely responded to RxD’s facially overbroad request for information regarding “all officers, directors and managing agents” of Applicant by [REDACTED] Applicant otherwise maintains and restates its objections to this irrelevant and overly broad Interrogatory because, *inter alia*, Applicant is an LLC that does not have “officers, directors and managing agents” and RxD fails to explain how the identification of such personnel (if they existed) would be relevant to the issues in these proceedings.

RxD’s Third Set of Requests for Production of Documents (“Request” or “Requests”)

Your February 5th letter asserts that “all” of RxD’s Requests are “directly relevant to the issues in these proceedings.” However, you fail to define “the issues in these proceedings” except to say “likelihood of confusion, priority, secondary meaning, good faith adoption, etc.” RxD’s use of “etc.” in this list demonstrates a lack of seriousness and reasonable precision in its most recent

sets of discovery requests. It also prevents Applicant from being able to evaluate the merits of RxD's deficiency allegations. Rather than rely on a non-exhaustive and non-specific list of general issues that may arise in any trademark opposition proceeding, RxD must identify the specific issue to which each Request relates and explain how the Request is relevant to the IPAD Mark and the specific services identified in the parties' respective trademark applications that may conflict.

Your list of the "issues in these proceedings" includes "secondary meaning" or "good faith adoption", but RxD's Notices of Opposition do not contain any allegations as to the secondary meaning or good faith adoption of Applicant's mark. Those issues are indeed relevant here, but they relate exclusively to Opposer's mark. In any event, RxD already possesses information sufficient to address the "secondary meaning" of Applicant's mark, in that the Trademark Office records of the applications at issue include extensive evidence of secondary meaning, which the Trademark Office accepted. Applicant's response to RxD's Interrogatory No. 7 makes clear that there is no issue regarding "good faith adoption" [REDACTED]

Your allegations regarding Applicant's responses to RxD's Requests fall into three categories: (1) requests for confirmation that Applicant is not aware of any responsive documents in existence; (2) requests for confirmation that Applicant is not withholding documents based on its objections; and (3) document requests that are unintelligible and/or irrelevant to the issues in these proceedings ("Category" or "Categories"). In response to these allegations, we respond as follows:

- **Category No. 1 – Request Nos. 22-23, 26, 30 & 32.** Applicant maintains each of its objections to these Requests, which are not appropriately tailored to the issues in these proceedings. Applicant's responses already make clear that [REDACTED] Applicant has expressly reserved the right to supplement or amend its discovery responses and/or produce additional documents later in these proceedings and will do so if Applicant later identifies relevant and responsive materials. *See* TBMP §414. Applicant hereby states that it is not currently withholding any documents pursuant to its objections.
- **Category No. 2 – Request Nos. 21, 24-25, 27-28, 31, 33-34, 36-37 & 40-42.** Applicant maintains each of its objections to these Requests, which are not appropriately tailored to the issues in these proceedings. As you know, Applicant's responses to of these Requests specified that [REDACTED] As a result of that search, Applicant made a substantial production on February 2nd, which, together with Applicant's earlier document productions in these proceedings, includes documents

responsive to each of these Requests. Applicant has expressly reserved the right to supplement or amend its responses and/or produce additional responsive documents later in these proceedings and will do so if Applicant later identifies relevant materials that are responsive to these Requests. *See* TBMP § 414. Applicant hereby states that it is not currently withholding any documents pursuant to its objections.

- **Category No. 3—Request Nos. 29, 35 & 38.** Applicant maintains each of its objections to these overly broad and unduly burdensome Requests because, *inter alia*, they are not appropriately tailored to the issues in these proceedings.
 - *Request 29* – RxD fails to explain what information it lacks concerning the “category to which services offered under the IPAD Mark belong.” Indeed, the applications at issue clearly identify the classes/categories to which the services identified therein belong. Accordingly, Applicant has already completely responded to this Request, to the extent that it is capable of being understood.
 - *Request No. 35* – This Request seeks information about legal proceedings that in no way concern Applicant’s use and registration of the IPAD Mark in the United States for the services identified in the applications at issue. You have offered no authority to support the contention that Applicant’s filing bases and responses to the Trademark Office’s descriptiveness refusals somehow entitles RxD to “explore” unrelated testimony from a distinct legal proceeding concerning matters outside the United States. Indeed, you have not even attempted to explain how this Request could possibly lead to the discovery of admissible evidence in these proceedings. Applicant hereby restates and maintains each of its objections to this Request.
 - *Request No. 38* – Applicant hereby restates and maintains each of its objections to this Request for Steve Jobs’ correspondence, which is irrelevant to these proceedings. Applicant’s responses to RxD’s previous discovery requests make clear that

Applicant will produce a privilege log when its document production in these proceedings is complete.

To the extent that the foregoing does not sufficiently address the allegations set forth in your February 5th letter, please either provide more specific information that will enable Applicant to

properly evaluate your allegations or let us know if/when you would like to meet and confer by telephone to discuss these issues. We look forward to receiving your response.

Sincerely,



Daniel P. Hope

CC: Jason Cody
Glenn Gundersen

Sara Sakagami

From: Hope, Daniel <Daniel.Hope@dechert.com>
Sent: Monday, March 09, 2015 4:57 PM
To: Cecil Key
Cc: Sara Sakagami; Gundersen, Glenn
Subject: RE: RxD v. IP Application Discovery Issues

Cecil,

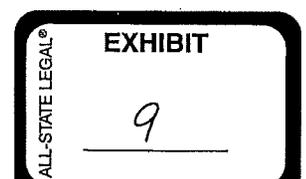
We write in response to your below email and to memorialize the issues raised and agreements reached during our February 25th meet and confer. As you know, we covered a lot of ground during our call and, as promised, Applicant has given further consideration to Opposer's deficiency allegations that were not resolved during the call. To the extent that your understanding differs or if you have anything to add to the below, please let me know.

DEPOSITIONS

- **RxD's Noticed Depositions:**
 - **30(b)(6)/Thomas La Perle** – Applicant has offered to make Mr. La Perle available the week of March 16-20, 2015. However, we understand that Opposer would like Applicant to provide potential dates for Mr. La Perle's deposition that fall after Applicant has supplemented its responses and document production. As set forth below, Applicant is diligently working to prepare supplemental interrogatory responses and produce additional documents to address some of the issues discussed during our meet and confer.
 - **Douglas Vetter** – The parties are at an impasse. Opposer seeks Mr. Vetter's deposition on the ground that he executed the license agreement between Applicant and its licensee, Apple Inc. However, notwithstanding his execution of the license agreement, Mr. Vetter has no unique or superior knowledge relating to any of the issues in these proceedings. As we have previously stated, Opposer can obtain whatever discovery it needs regarding Mr. Vetter through less wasteful and intrusive means, such as written discovery and/or the testimony of Applicant's 30(b)(6) designee
- **IP Application Development's Noticed Depositions:**
 - **30(b)(6)/Brian Clements and Keith Clements** – Thank you for offering to make RxD's witnesses available on March 30 and 31, 2015. Given that the discovery period is scheduled to close on March 31st, we would appreciate your continuing to search for alternative dates that will ensure that Applicant has time to consider and conduct any necessary follow up discovery. If that is impossible, we will accept March 30-31. Furthermore, we understand that RxD's witnesses reside in the Philadelphia area and would appreciate your making the witnesses available there, rather than requiring the witnesses and Applicant's counsel to travel to Virginia. As stated in Applicant's deposition notices, we are prepared to host these depositions in Dechert's Philadelphia offices.

APPLICANT'S DISCOVERY RESPONSES AND DOCUMENT PRODUCTION

The parties have reached an impasse with respect to several requests and Applicant has maintained its objections to Opposer's discovery requests on relevance grounds to the extent that Opposer has not specified the issues to which each request relates and/or identified the services in Applicant's applications that purportedly conflict with Opposer's services. Nevertheless, without waiver or withdrawal of its objections, Applicant has agreed to supplement its responses and/or document production to address many of Opposer's concerns.



- **Interrogatory No. 21** seeks the identification of advertising and marketing agencies engaged to promote the services offered under the IPAD Mark. [REDACTED] and RxD has not explained how the identity of any advertising and marketing agencies engaged to promote the iPad device could be relevant to any issue in these proceedings. Accordingly, Applicant will not supplement its response.
- **Interrogatory No. 23** – Opposer has requested the verification of Applicant’s responses to this and Applicant’s other Interrogatory responses. Applicant will provide the requested verification.
- **Interrogatory No. 25/RFP Nos. 30-31** seek non-privileged search reports generated in connection with trademark searches. [REDACTED]
- **Interrogatory No. 26** seeks a description of Applicant’s plans for expansion of its use of the IPAD Mark. Applicant’s response states that [REDACTED]. Opposer has requested a more concrete statement of Applicant’s plans. Applicant will supplement its interrogatory response.
- **Interrogatory No. 27** seeks an explanation of Applicant’s decisions to reject alternative marks. Applicant maintains its objections on relevance grounds and will not supplement its response.
- **Interrogatory No. 28/RFP No. 41** seek the identification of all officers, directors and managing agents of IP Application Development LLC. [REDACTED] Applicant will not supplement its responses.
- **RFP Nos. 21-23** seek consumer or market studies relating to Applicant’s IPAD Mark. Applicant has produced documents responsive to Request No. 21, but fails to see how consumer or market studies could be admissible or relevant to the issues in these proceedings. Applicant will not supplement its responses or production.
- **RFP No. 25** seeks documents relating to the marketing of services offered in connection with the iPad. Applicant has already produced documents responsive to this request, but Opposer has specifically requested the production of archival materials. Applicant will supplement its document production.
- **RFP No. 32** seeks documents relating to Applicant’s valuation of third parties’ rights in the IPAD Mark. Applicant’s response states that it is not aware of any responsive documents and Applicant will not supplement its response or production.
- **RFP No. 33** seeks documents sufficient to identify all goods and services with which Applicant uses the IPAD Mark. Applicant has already produced documents responsive to this request, but Opposer has specifically requested the production of archival materials. Applicant will supplement its document production.
- **RFP No. 34** seeks documents relating to Applicant’s application for the IPAD Mark in Trinidad & Tobago, which was the basis of Application Serial No. 77913563. Applicant will supplement its document production.
- **RFP No. 35** seeks testimony relating to the Shenzhen Proview Technology litigation. Applicant has objected and refused to produce documents on grounds that the request seeks confidential information [REDACTED]. Applicant maintains its objections and will not supplement its response or document production.

- **RFP No. 36** seeks documents relating to the acquisition of the IPAD Mark from Fujitsu. Applicant has already produced responsive documents, but Opposer has specifically requested a copy of a purchase agreement between Fujitsu and Apple Inc. Applicant has refused to supplement its production on grounds that the requested agreement would not be relevant to the services offered under the IPAD Mark that purportedly conflict with Opposer's services or any of the issues in these proceedings. Applicant maintains its objections and will not supplement its response or document production.
- **RFP No. 37** seeks iPad promotional materials, videos and product announcements. Applicant has already produced responsive documents, but Opposer has specifically requested the production of archival materials. Applicant will supplement its document production.
- **RFP Nos. 38-39** seek Steve Jobs' correspondence, which Applicant has refused to produce because such correspondence could not be relevant to any issue in these proceedings. Applicant will not supplement its responses or document production.
- **RFP No. 40** seeks documents identifying all marks owned by IP Application Development LLC. Applicant has already produced responsive documents, and will supplement its document production.
- **RFP No. 42** seeks assignments relating to Applicant's rights in the IPAD Mark. Applicant has already produced responsive documents and declines to supplement its production.

Thanks,
Dan

Daniel P. Hope

Dechert LLP

1095 Avenue of the Americas
New York, New York 10036
Daniel.Hope@dechert.com
Direct: +1 212 698-3657

From: Cecil Key [mailto:CKey@dimuro.com]
Sent: Tuesday, March 03, 2015 11:06 AM
To: Hope, Daniel
Cc: Sara Sakagami; Gundersen, Glenn
Subject: RE: RxD v. IP Application Discovery Issues

Dan:

Following on our exchange last week, the best date I have confirmed thus far for consecutive depositions of Keith Clements and RxD's 30(b)(6) designee(s) is Monday, March 30, 2015. We can make the deponents available at our offices in Alexandria, Virginia. Please let me know if you wish to move forward on that date. In the meanwhile, we will endeavor to hold the date open.

Also, we need to further discuss the depositions of Applicant's deponents that we have noticed. As I understand where we are, Mr. La Perle can be available the week of March 16-20, 2015 in California, but we are still awaiting a response from Applicant as to whether - and if so when - RxD will be receiving any of the additional documents we discussed during our February 25 meet-and-confer. We believe those documents could be meaningful to Mr. La Perle's testimony, both in his individual capacity and as a 30(b)(6) designee. Thus, production after the deposition might necessitate further testimony from Mr. La Perle or other of Applicant's witnesses. In addition, based on the positions discussed during the meet and confer, Applicant remains unwilling to make Mr. Vetter available for deposition absent an order from the Board. A motion to compel may therefore be necessary to secure Mr. Vetter's deposition.

If my understanding regarding the status of the depositions we've noticed is incorrect in any way, please let me know. Otherwise, we need to know which of these issues we need to bring to the Board's attention so that we can get them queued up soon. Accordingly, please provide us with an update on these issues as soon as possible.

In the meantime, we will await confirmation regarding the proposed date for the depositions of RxD's deponents.

Cecil E. Key
DG**Key**Ip Group
1750 Tysons Blvd., Suite 1500
Tysons Corner, VA 22102
(703) 289-5118 (Telephone)
(703) 388-0648 (Facsimile)
(703) 472-5976 (Cell)
Email: ckey@dimuro.com

From: Hope, Daniel [Daniel.Hope@dechert.com]
Sent: Friday, February 27, 2015 4:51 PM
To: Cecil Key
Cc: Sara Sakagami; Gundersen, Glenn
Subject: RE: RxD v. IP Application Discovery Issues

Cecil,

Thanks for your email. I confirm that we will not go forward with Keith Clements' deposition next week. We would appreciate your proposing dates when Keith will be available on or consecutive to the day of the 30(b)(6) deposition.

I'm working to get you the summary of our meet and confer.

Thanks,
Dan

Daniel P. Hope

Dechert LLP
1095 Avenue of the Americas
New York, New York 10036
Daniel.Hope@dechert.com
Direct: +1 212 698-3657

From: Cecil Key [<mailto:CKey@dimuro.com>]
Sent: Friday, February 27, 2015 10:54 AM
To: Hope, Daniel
Cc: Sara Sakagami; Gundersen, Glenn
Subject: RxD v. IP Application Discovery Issues

Dan:

As you are putting together the synopsis of our meet and confer as discussed during the call on Wednesday, I wanted to follow up regarding the deposition schedule for RxD's deponents. I have been unable to secure a time next week when both Keith Clements and RxD's 30(b)(6) designee(s) will be available on the same day. I understand that you would prefer not to take Keith Clements' deposition separately on March 4 at our offices in Virginia as offered. I am looking for alternatives for him that will align with the 30(b)(6) deposition, but we are currently holding March 4 pending confirmation that we can release that date. Accordingly, please let us know by the close of business today whether you

anticipate Mr. Clements' deposition will go forward on March 4 as proposed, or if you would prefer to reschedule to a time when all deponents can be put forth consecutively.

Cecil E. Key
DG**Key**Ip Group
1750 Tysons Blvd., Suite 1500
Tysons Corner, VA 22102
(703) 289-5118 (Telephone)
(703) 388-0648 (Facsimile)
(703) 472-5976 (Cell)
Email: ckey@dimuro.com

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To: ssakagami@dimuro.com

[Remove this sender from my allow list](#)

From: daniel.hope@dechert.com

You received this message because the sender is on your allow list.

Sara Sakagami

From: Cecil Key
Sent: Tuesday, March 10, 2015 11:18 AM
To: Hope, Daniel
Cc: Sara Sakagami; Gundersen, Glenn
Subject: RE: RxD v. IP Application Discovery Issues

Dan:

We're still reviewing your response, but I wanted to respond regarding a couple of the big picture points so we can both consider our next steps.

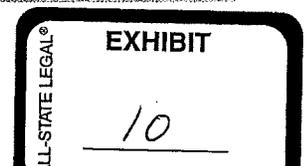
- **Doug Vetter.** One clarification should be made to your synopsis of our meet and confer discussion regarding the deposition of Doug Vetter. We are seeking Mr. Vetter's deposition because, [REDACTED]
[REDACTED] We offered to consider someone other than Mr. Vetter, to the extent there is someone who can have his level of knowledge or greater, and ask that Applicant give us a proposal. Mr. La Perle is not an acceptable substitute because we are not willing, nor are we required to rely on a single witness, who also happens to be a lawyer.
- **RxD Deponents.** I have passed along your comments and requests regarding scheduling and location of the RxD depositions. At this point, however, the best available date for both depositions is March 30 at our offices in Virginia. I will let you know as soon as I can if that changes, but it appears highly unlikely.
- **Interrogatory 25/RFP Nos. 30-31.** Regarding the search reports that are the subject of these requests, we appreciate Applicant's agreement to supplement its production. However, if Applicant intends to assert a privilege objection as your email suggests, it is Applicant's burden to establish that the privilege applies, and Applicant must produce information sufficient to allow Respondent to challenge the privilege. In addition, Applicant cannot selectively produce search results. Accordingly, at a minimum, if Applicant is going to maintain a privilege or work product objection, an appropriate privilege log must be provided with the production.

Regarding the remainder of the items for which Applicant is refusing to supplement its production, please let me know if you believe that further discussion will be fruitful. While I am willing to have such discussions, we have already explained our positions during the meet and confer almost two weeks ago and it's not clear what additional information Applicant believes will make a difference to its positions. It therefore seems to me that the prudent course is to bring the matters for which we cannot expect further supplementation to the Board, particularly in light of the upcoming discovery deadline. If you agree, please let me know when you can be available for a call with the Board later this week or early next week.

We will try to get back to you shortly with further responses.

Cecil E. Key
DGKeyIp Group
1750 Tysons Blvd., Suite 1500
Tysons Corner, VA 22102
(703) 289-5118 (Telephone)
(703) 388-0648 (Facsimile)
(703) 472-5976 (Cell)
Email: ckey@dimuro.com

From: Hope, Daniel [Daniel.Hope@dechert.com]
Sent: Monday, March 09, 2015 4:57 PM



To: Cecil Key
Cc: Sara Sakagami; Gundersen, Glenn
Subject: RE: RxD v. IP Application Discovery Issues

Cecil,

We write in response to your below email and to memorialize the issues raised and agreements reached during our February 25th meet and confer. As you know, we covered a lot of ground during our call and, as promised, Applicant has given further consideration to Opposer's deficiency allegations that were not resolved during the call. To the extent that your understanding differs or if you have anything to add to the below, please let me know.

DEPOSITIONS

- **RxD's Noticed Depositions:**
 - **30(b)(6)/Thomas La Perle** – Applicant has offered to make Mr. La Perle available the week of March 16-20, 2015. However, we understand that Opposer would like Applicant to provide potential dates for Mr. La Perle's deposition that fall after Applicant has supplemented its responses and document production. As set forth below, Applicant is diligently working to prepare supplemental interrogatory responses and produce additional documents to address some of the issues discussed during our meet and confer.
 - **Douglas Vetter** – The parties are at an impasse. Opposer seeks Mr. Vetter's deposition on the ground that he executed the license agreement between Applicant and its licensee, Apple Inc. However, notwithstanding his execution of the license agreement, Mr. Vetter has no unique or superior knowledge relating to any of the issues in these proceedings. As we have previously stated, Opposer can obtain whatever discovery it needs regarding Mr. Vetter through less wasteful and intrusive means, such as written discovery and/or the testimony of Applicant's 30(b)(6) designee
- **IP Application Development's Noticed Depositions:**
 - **30(b)(6)/Brian Clements and Keith Clements** – Thank you for offering to make RxD's witnesses available on March 30 and 31, 2015. Given that the discovery period is scheduled to close on March 31st, we would appreciate your continuing to search for alternative dates that will ensure that Applicant has time to consider and conduct any necessary follow up discovery. If that is impossible, we will accept March 30-31. Furthermore, we understand that RxD's witnesses reside in the Philadelphia area and would appreciate your making the witnesses available there, rather than requiring the witnesses and Applicant's counsel to travel to Virginia. As stated in Applicant's deposition notices, we are prepared to host these depositions in Dechert's Philadelphia offices.

APPLICANT'S DISCOVERY RESPONSES AND DOCUMENT PRODUCTION

The parties have reached an impasse with respect to several requests and Applicant has maintained its objections to Opposer's discovery requests on relevance grounds to the extent that Opposer has not specified the issues to which each request relates and/or identified the services in Applicant's applications that purportedly conflict with Opposer's services. Nevertheless, without waiver or withdrawal of its objections, Applicant has agreed to supplement its responses and/or document production to address many of Opposer's concerns.

- **Interrogatory No. 21** seeks the identification of advertising and marketing agencies engaged to promote the services offered under the IPAD Mark [REDACTED] and RxD has not explained how the identity of any advertising and marketing agencies engaged to promote the iPad device could be relevant to any issue in these proceedings. Accordingly, Applicant will not supplement its response.

- **Interrogatory No. 23** – Opposer has requested the verification of Applicant’s responses to this and Applicant’s other Interrogatory responses. Applicant will provide the requested verification.
- **Interrogatory No. 25/RFP Nos. 30-31** seek non-privileged search reports generated in connection with trademark searches. [REDACTED]
- **Interrogatory No. 26** seeks a description of Applicant’s plans for expansion of its use of the IPAD Mark. Applicant’s response states that [REDACTED]. Opposer has requested a more concrete statement of Applicant’s plans. Applicant will supplement its interrogatory response.
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- **RFP Nos. 21-23** seek consumer or market studies relating to Applicant’s IPAD Mark. Applicant has produced documents responsive to Request No. 21, but fails to see how consumer or market studies could be admissible or relevant to the issues in these proceedings. Applicant will not supplement its responses or production.
- **RFP No. 25** seeks documents relating to the marketing of services offered in connection with the iPad. Applicant has already produced documents responsive to this request, but Opposer has specifically requested the production of archival materials. Applicant will supplement its document production.
- **RFP No. 32** seeks documents relating to Applicant’s valuation of third parties’ rights in the IPAD Mark. Applicant’s response states that it is not aware of any responsive documents and Applicant will not supplement its response or production.
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- **RFP No. 36** seeks documents relating to the acquisition of the IPAD Mark from Fujitsu. Applicant has already produced responsive documents, but Opposer has specifically requested a copy of a purchase agreement between Fujitsu and Apple Inc. Applicant has refused to supplement its production on grounds that the requested agreement would not be relevant to the services offered under the IPAD Mark that purportedly conflict with Opposer’s services or any of the issues in these proceedings. Applicant maintains its objections and will not supplement its response or document production.

- **RFP No. 37** seeks iPad promotional materials, videos and product announcements. Applicant has already produced responsive documents, but Opposer has specifically requested the production of archival materials. Applicant will supplement its document production.
- **RFP Nos. 38-39** seek Steve Jobs' correspondence, which Applicant has refused to produce because such correspondence could not be relevant to any issue in these proceedings. Applicant will not supplement its responses or document production.
- **RFP No. 40** seeks documents identifying all marks owned by IP Application Development LLC. Applicant has already produced responsive documents, and will supplement its document production.
- **RFP No. 42** seeks assignments relating to Applicant's rights in the IPAD Mark. Applicant has already produced responsive documents and declines to supplement its production.

Thanks,
Dan

Daniel P. Hope

Dechert LLP

1095 Avenue of the Americas
New York, New York 10036
Daniel.Hope@dechert.com
Direct: +1 212 698-3657

From: Cecil Key [mailto:CKey@dimuro.com]
Sent: Tuesday, March 03, 2015 11:06 AM
To: Hope, Daniel
Cc: Sara Sakagami; Gundersen, Glenn
Subject: RE: RxD v. IP Application Discovery Issues

Dan:

Following on our exchange last week, the best date I have confirmed thus far for consecutive depositions of Keith Clements and RxD's 30(b)(6) designee(s) is Monday, March 30, 2015. We can make the deponents available at our offices in Alexandria, Virginia. Please let me know if you wish to move forward on that date. In the meanwhile, we will endeavor to hold the date open.

Also, we need to further discuss the depositions of Applicant's deponents that we have noticed. As I understand where we are, Mr. La Perle can be available the week of March 16-20, 2015 in California, but we are still awaiting a response from Applicant as to whether - and if so when - RxD will be receiving any of the additional documents we discussed during our February 25 meet-and-confer. We believe those documents could be meaningful to Mr. La Perle's testimony, both in his individual capacity and as a 30(b)(6) designee. Thus, production after the deposition might necessitate further testimony from Mr. La Perle or other of Applicant's witnesses. In addition, based on the positions discussed during the meet and confer, Applicant remains unwilling to make Mr. Vetter available for deposition absent an order from the Board. A motion to compel may therefore be necessary to secure Mr. Vetter's deposition.

If my understanding regarding the status of the depositions we've noticed is incorrect in any way, please let me know. Otherwise, we need to know which of these issues we need to bring to the Board's attention so that we can get them queued up soon. Accordingly, please provide us with an update on these issues as soon as possible.

In the meantime, we will await confirmation regarding the proposed date for the depositions of RxD's deponents.

Cecil E. Key
DGKeyIp Group

1750 Tysons Blvd., Suite 1500
Tysons Corner, VA 22102
(703) 289-5118 (Telephone)
(703) 388-0648 (Facsimile)
(703) 472-5976 (Cell)
Email: ckey@dimuro.com

From: Hope, Daniel [Daniel.Hope@dechert.com]
Sent: Friday, February 27, 2015 4:51 PM
To: Cecil Key
Cc: Sara Sakagami; Gundersen, Glenn
Subject: RE: RxD v. IP Application Discovery Issues

Cecil,

Thanks for your email. I confirm that we will not go forward with Keith Clements' deposition next week. We would appreciate your proposing dates when Keith will be available on or consecutive to the day of the 30(b)(6) deposition.

I'm working to get you the summary of our meet and confer.

Thanks,
Dan

Daniel P. Hope

Dechert LLP
1095 Avenue of the Americas
New York, New York 10036
Daniel.Hope@dechert.com
Direct: +1 212 698-3657

From: Cecil Key [<mailto:CKey@dimuro.com>]
Sent: Friday, February 27, 2015 10:54 AM
To: Hope, Daniel
Cc: Sara Sakagami; Gundersen, Glenn
Subject: RxD v. IP Application Discovery Issues

Dan:

As you are putting together the synopsis of our meet and confer as discussed during the call on Wednesday, I wanted to follow up regarding the deposition schedule for RxD's deponents. I have been unable to secure a time next week when both Keith Clements and RxD's 30(b)(6) designee(s) will be available on the same day. I understand that you would prefer not to take Keith Clements' deposition separately on March 4 at our offices in Virginia as offered. I am looking for alternatives for him that will align with the 30(b)(6) deposition, but we are currently holding March 4 pending confirmation that we can release that date. Accordingly, please let us know by the close of business today whether you anticipate Mr. Clements' deposition will go forward on March 4 as proposed, or if you would prefer to reschedule to a time when all deponents can be put forth consecutively.

Cecil E. Key
DGKey Ip Group
1750 Tysons Blvd., Suite 1500
Tysons Corner, VA 22102
(703) 289-5118 (Telephone)
(703) 388-0648 (Facsimile)

(703) 472-5976 (Cell)
Email: ckey@dimuro.com

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From: daniel.hope@dechert.com

You received this message because the sender is on your allow list.

Sara Sakagami

From: Hope, Daniel <Daniel.Hope@dechert.com>
Sent: Friday, March 13, 2015 11:00 AM
To: Cecil Key
Cc: Sara Sakagami; Gundersen, Glenn
Subject: RE: RxD v. IP Application Discovery Issues

Cecil,

We remain open to further discussion, but it seems clear that the parties have reached an impasse on a number of issues. As you know, RxD alleged deficiencies in nearly every one of Applicant's responses, and we have repeatedly asked you to identify the specific issue to which each of RxD's requests relates and explain how that issue is relevant to the services identified in Applicant's applications that allegedly conflict with Opposer's services. To date, we have received a non-exhaustive list of issues that generally could arise in any opposition proceeding and you have stated that RxD's requests relate to "all" of Applicant's identified services. Without more meaningful and specific information, Applicant has no reason to further supplement its responses.

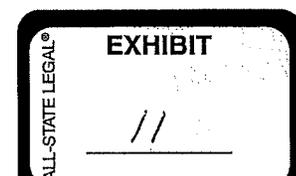
Needless to say, Applicant will oppose any motion to compel additional discovery. However, in view of the number of discovery deficiencies you have alleged and the history of these proceedings, we will not consent to seeking a resolution of the parties' discovery disputes during an expedited telephone conference with the Board. When RxD serves its motion to compel, Applicant will prepare its opposition brief in accordance with the timing provisions of TBMP Section 502.02(b), as we are entitled to do. It would be inappropriate and inefficient to demand a hasty decision based on a lengthy teleconference from the interlocutory attorney.

With respect to the three points that you've raised below:

- **Doug Vetter** – You have stated that RxD seeks Mr. Vetter's deposition because "he presumably has knowledge related to the uses and intended uses of the mark at issue." The best person to address that topic is Mr. La Perle, who, as head trademark counsel, is responsible for supervising all submissions of Amendments to Allege Use and Statements of Use for U.S. trademark applications – yet you continue to refuse to accept Mr. La Perle as an acceptable substitute. Furthermore, despite your stating that RxD is willing to consider other deponents, you suggested during our meet and confer that there could be no acceptable surrogate for Mr. Vetter. Thus, the parties remain at an impasse.
- **RxD Deponents** – Subject to your providing alternative dates, we accept March 30th and 31st as the dates for the 30(b)(6) deposition of RxD/Brian Clements and the deposition of Keith Clements, respectively. As you know, the rules provide that witnesses shall be deposed in the Federal judicial district where they reside (TBMP 404.03). Here, that would require conducting the depositions in the Philadelphia area, and we have offered to host the depositions in our Philadelphia offices at no cost to Opposer. If you will only produce the witnesses in Virginia, please explain your reasons for insisting on that location.
- **Interrogatory No. 25 and RFP Nos. 30-31** – As we have previously stated, Applicant will produce a privilege log when its document production is complete.

We await your further responses, if any, to our March 9th summary of the meet and confer.

Regards,
Dan



Daniel P. Hope

Dechert LLP

1095 Avenue of the Americas
New York, New York 10036
Daniel.Hope@dechert.com
Direct: +1 212 698-3657

From: Cecil Key [mailto:CKey@dimuro.com]
Sent: Tuesday, March 10, 2015 11:18 AM
To: Hope, Daniel
Cc: Sara Sakagami; Gundersen, Glenn
Subject: RE: RxD v. IP Application Discovery Issues

Dan:

We're still reviewing your response, but I wanted to respond regarding a couple of the big picture points so we can both consider our next steps.

- **Doug Vetter.** One clarification should be made to your synopsis of our meet and confer discussion regarding the deposition of Doug Vetter. We are seeking Mr. Vetter's deposition because, [REDACTED]
[REDACTED] We offered to consider someone other than Mr. Vetter, to the extent there is someone who can have his level of knowledge or greater, and ask that Applicant give us a proposal. Mr. La Perle is not an acceptable substitute because we are not willing, nor are we required to rely on a single witness, who also happens to be a lawyer.
- **RxD Deponents.** I have passed along your comments and requests regarding scheduling and location of the RxD depositions. At this point, however, the best available date for both depositions is March 30 at our offices in Virginia. I will let you know as soon as I can if that changes, but it appears highly unlikely.
- **Interrogatory 25/RFP Nos. 30-31.** Regarding the search reports that are the subject of these requests, we appreciate Applicant's agreement to supplement its production. However, if Applicant intends to assert a privilege objection as your email suggests, it is Applicant's burden to establish that the privilege applies, and Applicant must produce information sufficient to allow Respondent to challenge the privilege. In addition, Applicant cannot selectively produce search results. Accordingly, at a minimum, if Applicant is going to maintain a privilege or work product objection, an appropriate privilege log must be provided with the production.

Regarding the remainder of the items for which Applicant is refusing to supplement its production, please let me know if you believe that further discussion will be fruitful. While I am willing to have such discussions, we have already explained our positions during the meet and confer almost two weeks ago and it's not clear what additional information Applicant believes will make a difference to its positions. It therefore seems to me that the prudent course is to bring the matters for which we cannot expect further supplementation to the Board, particularly in light of the upcoming discovery deadline. If you agree, please let me know when you can be available for a call with the Board later this week or early next week.

We will try to get back to you shortly with further responses.

Cecil E. Key

DGKeyIp Group
1750 Tysons Blvd., Suite 1500
Tysons Corner, VA 22102
(703) 289-5118 (Telephone)
(703) 388-0648 (Facsimile)
(703) 472-5976 (Cell)
Email: ckey@dimuro.com

From: Hope, Daniel [Daniel.Hope@dechert.com]
Sent: Monday, March 09, 2015 4:57 PM
To: Cecil Key
Cc: Sara Sakagami; Gundersen, Glenn
Subject: RE: RxD v. IP Application Discovery Issues

Cecil,

We write in response to your below email and to memorialize the issues raised and agreements reached during our February 25th meet and confer. As you know, we covered a lot of ground during our call and, as promised, Applicant has given further consideration to Opposer's deficiency allegations that were not resolved during the call. To the extent that your understanding differs or if you have anything to add to the below, please let me know.

DEPOSITIONS

- **RxD's Noticed Depositions:**
 - **30(b)(6)/Thomas La Perle** – Applicant has offered to make Mr. La Perle available the week of March 16-20, 2015. However, we understand that Opposer would like Applicant to provide potential dates for Mr. La Perle's deposition that fall after Applicant has supplemented its responses and document production. As set forth below, Applicant is diligently working to prepare supplemental interrogatory responses and produce additional documents to address some of the issues discussed during our meet and confer.
 - **Douglas Vetter** – The parties are at an impasse. Opposer seeks Mr. Vetter's deposition on the ground that he executed the license agreement between Applicant and its licensee, Apple Inc. However, notwithstanding his execution of the license agreement, Mr. Vetter has no unique or superior knowledge relating to any of the issues in these proceedings. As we have previously stated, Opposer can obtain whatever discovery it needs regarding Mr. Vetter through less wasteful and intrusive means, such as written discovery and/or the testimony of Applicant's 30(b)(6) designee
- **IP Application Development's Noticed Depositions:**
 - **30(b)(6)/Brian Clements and Keith Clements** – Thank you for offering to make RxD's witnesses available on March 30 and 31, 2015. Given that the discovery period is scheduled to close on March 31st, we would appreciate your continuing to search for alternative dates that will ensure that Applicant has time to consider and conduct any necessary follow up discovery. If that is impossible, we will accept March 30-31. Furthermore, we understand that RxD's witnesses reside in the Philadelphia area and would appreciate your making the witnesses available there, rather than requiring the witnesses and Applicant's counsel to travel to Virginia. As stated in Applicant's deposition notices, we are prepared to host these depositions in Dechert's Philadelphia offices.

APPLICANT'S DISCOVERY RESPONSES AND DOCUMENT PRODUCTION

The parties have reached an impasse with respect to several requests and Applicant has maintained its objections to Opposer's discovery requests on relevance grounds to the extent that Opposer has not specified the issues to which each request relates and/or identified the services in Applicant's applications that purportedly conflict with Opposer's services. Nevertheless, without waiver or withdrawal of its objections, Applicant has agreed to supplement its responses and/or document production to address many of Opposer's concerns.

- **Interrogatory No. 21** seeks the identification of advertising and marketing agencies engaged to promote the services offered under the IPAD Mark. [REDACTED] and RxD has not explained how the identity of any advertising and

marketing agencies engaged to promote the iPad device could be relevant to any issue in these proceedings. Accordingly, Applicant will not supplement its response.

- **Interrogatory No. 23** – Opposer has requested the verification of Applicant’s responses to this and Applicant’s other Interrogatory responses. Applicant will provide the requested verification.
- **Interrogatory No. 25/RFP Nos. 30-31** seek non-privileged search reports generated in connection with trademark searches. [REDACTED]
- **Interrogatory No. 26** seeks a description of Applicant’s plans for expansion of its use of the IPAD Mark. Applicant’s response states that [REDACTED] Opposer has requested a more concrete statement of Applicant’s plans. Applicant will supplement its interrogatory response.
- **Interrogatory No. 27** seeks an explanation of Applicant’s decisions to reject alternative marks. Applicant maintains its objections on relevance grounds and will not supplement its response.
- **Interrogatory No. 28/RFP No. 41** seek the identification of all officers, directors and managing agents of IP Application Development LLC. Applicant’s responses already [REDACTED] Applicant will not supplement its responses.
- **RFP Nos. 21-23** seek consumer or market studies relating to Applicant’s IPAD Mark. Applicant has produced documents responsive to Request No. 21, but fails to see how consumer or market studies could be admissible or relevant to the issues in these proceedings. Applicant will not supplement its responses or production.
- **RFP No. 25** seeks documents relating to the marketing of services offered in connection with the iPad. Applicant has already produced documents responsive to this request, but Opposer has specifically requested the production of archival materials. Applicant will supplement its document production.
- **RFP No. 32** seeks documents relating to Applicant’s valuation of third parties’ rights in the IPAD Mark. Applicant’s response states that it is not aware of any responsive documents and Applicant will not supplement its response or production.
- **RFP No. 33** seeks documents sufficient to identify all goods and services with which Applicant uses the IPAD Mark. Applicant has already produced documents responsive to this request, but Opposer has specifically requested the production of archival materials. Applicant will supplement its document production.
- **RFP No. 34** seeks documents relating to Applicant’s application for the IPAD Mark in Trinidad & Tobago, which was the basis of Application Serial No. 77913563. Applicant will supplement its document production.
- **RFP No. 35** seeks testimony relating to the Shenzhen Proview Technology litigation. Applicant has objected and refused to produce documents on grounds that the request seeks confidential information [REDACTED]. Applicant maintains its objections and will not supplement its response or document production.
- **RFP No. 36** seeks documents relating to the acquisition of the IPAD Mark from Fujitsu. Applicant has already produced responsive documents, but Opposer has specifically requested a copy of a purchase agreement between Fujitsu and Apple Inc. Applicant has refused to supplement its production on grounds that the requested agreement would not be relevant to the services offered under the IPAD Mark that purportedly conflict with Opposer’s services

or any of the issues in these proceedings. Applicant maintains its objections and will not supplement its response or document production.

- **RFP No. 37** seeks iPad promotional materials, videos and product announcements. Applicant has already produced responsive documents, but Opposer has specifically requested the production of archival materials. Applicant will supplement its document production.
- **RFP Nos. 38-39** seek Steve Jobs' correspondence, which Applicant has refused to produce because such correspondence could not be relevant to any issue in these proceedings. Applicant will not supplement its responses or document production.
- **RFP No. 40** seeks documents identifying all marks owned by IP Application Development LLC. Applicant has already produced responsive documents, and will supplement its document production.
- **RFP No. 42** seeks assignments relating to Applicant's rights in the IPAD Mark. Applicant has already produced responsive documents and declines to supplement its production.

Thanks,
Dan

Daniel P. Hope

Dechert LLP

1095 Avenue of the Americas
New York, New York 10036
Daniel.Hope@dechert.com
Direct: +1 212 698-3657

From: Cecil Key [<mailto:CKey@dimuro.com>]
Sent: Tuesday, March 03, 2015 11:06 AM
To: Hope, Daniel
Cc: Sara Sakagami; Gundersen, Glenn
Subject: RE: RxD v. IP Application Discovery Issues

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(703) 472-5976 (Cell)
Email: ckey@dimuro.com

From: Hope, Daniel [Daniel.Hope@dechert.com]
Sent: Friday, February 27, 2015 4:51 PM
To: Cecil Key
Cc: Sara Sakagami; Gundersen, Glenn
Subject: RE: RxD v. IP Application Discovery Issues

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Direct: +1 212 698-3657

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Sent: Friday, February 27, 2015 10:54 AM
To: Hope, Daniel
Cc: Sara Sakagami; Gundersen, Glenn
Subject: RxD v. IP Application Discovery Issues

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You received this message because the sender is on your allow list.

Exhibit 12-14
Marked
Trade Secret/Commercially Sensitive
in Its Entirety

MARK: IPAD

CLASS: 9

APPLICANT: Fujitsu Transaction Solutions Inc.
5429 LBJ Freeway
Dallas, Texas 75240

First use on about January 8, 2002

First use in interstate commerce on about January 13, 2002

Goods: Hand-held computing device for wireless networking in a retail environment.

IPAD



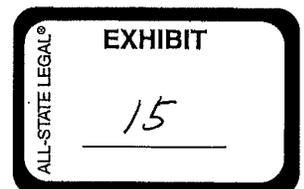
03-07-2003

U.S. Patent & TMO/™ TM Mail Rpt Dt. #51

U.S. Patent & TM Ofo/TM



76497338



76497338

TRADEMARK APPLICATION SERIAL NO. _____

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE
FEE RECORD SHEET

03/19/2003 BWILSON1 00000082 76497338

01 FC:6001

335.00 DP

BARNES & THORNBURG

William M. Lee, Jr.
(312) 368-6620
Email: wlee@btlaw.com

Suite 410
209 South LaSalle Street
Chicago, Illinois 60604-1202 U.S.A.
(312) 368-1300
Fax (312) 368-0034

www.btlaw.com

March 6, 2003

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Re: United States Trademark Application
Our File No. 920790-907579

Dear Sir:

We enclose herewith the following trademark or service mark application:

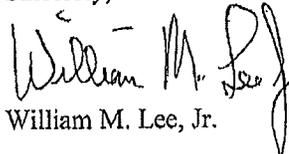
Applicant: Fujitsu Transaction Solutions, Inc.

Mark: iPad

1 (one) specimen – 1 for each class

Filing Fee of \$335.00

Sincerely,



William M. Lee, Jr.

WMLJR:jjr
Enclosures

Indianapolis

Fort Wayne

South Bend

Elkhart

Chicago

Washington, D.C.

Docket No. 920790-907579

TRADEMARK/SERVICE MARK APPLICATION
Use in Commerce (15 U.S.C. §1051(a))

MARK: IPAD

INTERNATIONAL CLASS NO.: 9

TO THE COMMISSIONER FOR TRADEMARKS

STATEMENT AND POWER OF ATTORNEY

Applicant, Fujitsu Transaction Solutions Inc., a corporation duly organized and existing under the laws of the State of Delaware, having an office and principal place of business at 5429 LBJ Freeway, Dallas, Texas 75240, has adopted and is using the mark shown in the accompanying drawing in commerce on or in connection with the below-identified goods and/or services (15 U.S.C. §1051(a)):

HAND-HELD COMPUTING DEVICE FOR WIRELESS
NETWORKING IN A RETAIL ENVIRONMENT

in International Class 9.

Applicant presents herewith one specimen for each class of goods and/or services showing the mark as it is actually used in commerce on or in connection with such goods and/or services, and requests registration of the above-identified mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. §1051 et seq.) for the above-identified goods and/or services.

The mark was first used anywhere on or in connection with the goods on about January 8, 2002 and was first used in interstate commerce on or in connection with the goods on about January 13, 2002; and is now in use in such commerce.

Applicant hereby appoints Thomas E. Smith, Dennis M. McWilliams, James R. Sweeney,

William M. Lee, Jr., Glenn W. Ohlson, David C. Brezina, Jeffrey R. Gray, Gerald S. Geren, Robert F. I. Conte, Timothy J. Engling, James B. Conte, Howard B. Rockman, Peter J. Shakula, Mark J. Nahnsen, John W. Hayes, Bradley A. Ullrick and Mark A. Hagedorn, all of Barnes & Thornburg, PO Box 2786, Chicago, Illinois 60690-2786, and all of whom are members of the Bar of the State of Illinois, its attorneys, with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to transact all business in the Patent and Trademark Office in connection therewith, and to receive the Certificate of Registration.

All correspondence concerning this application should be addressed to:

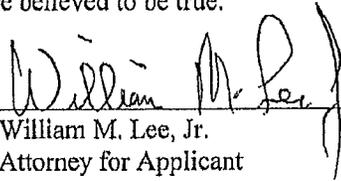
William M. Lee, Jr.
Barnes & Thornburg
P.O. Box 2786
Chicago IL 60690-2786
Telephone: (312) 368-1300
Facsimile: (312) 368-0034

DECLARATION

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. §1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used

connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.

Date: March 6, 2003



William M. Lee, Jr.
Attorney for Applicant

Express Mail" mailing label number

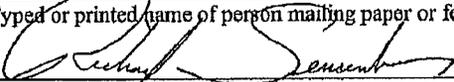
EY 227 988 075 US

Date of deposit: March 6, 2003

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513

Richard Sensenbrenner

(Typed or printed name of person mailing paper or fee)



(Signature of person mailing paper or fee)

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36 and 38

Reg. No. 3,776,575

United States Patent and Trademark Office

Registered Apr. 20, 2010

Corrected

OG Date July 20, 2010

**TRADEMARK
PRINCIPAL REGISTER**

IPAD

APPLE INC. (CALIFORNIA CORPORATION)
1 INFINITE LOOP
CUPERTINO, CA 95014

FOR: HAND-HELD COMPUTING DEVICE FOR WIRELESS NETWORKING IN A RETAIL ENVIRONMENT, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).
FIRST USE 1-8-2002; IN COMMERCE 1-13-2002.
SER. NO. 76-497,338, FILED 3-7-2003.

*In testimony whereof I have hereunto set my hand
and caused the seal of The Patent and Trademark
Office to be affixed on July 20, 2010.*