

ESTTA Tracking number: **ESTTA537161**

Filing date: **05/10/2013**

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

Proceeding	91208266
Party	Plaintiff Uncle Milton Industries, Inc.
Correspondence Address	IRENE Y LEE RUSS AUGUST & KABAT 12424 WILSHIRE BOULEVARD, TWELFTH FLOOR LOS ANGELES, CA 90025 UNITED STATES ilee@raklaw.com, azivkovic@raklaw.com, trademark@raklaw.com
Submission	Motion to Compel Discovery
Filer's Name	Irene Y. Lee
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Signature	/Irene Y. Lee/
Date	05/10/2013
Attachments	3186-US2 130509 Motion to Compel Init Disc.pdf (1 page)(103952 bytes) 3186-US2 130509 Decl Lee re Motion for Init Disc.pdf (1 page)(100358 bytes) EXH A - Initial Disclosures.pdf (1 page)(183450 bytes) EXHb - 3185-US2 130401 LT J. Egbert.pdf (1 page)(51905 bytes) EXHc Re- US- MILTON (Opposition No. 91208266) [3186-003].pdf (1 page)(97999 bytes) EXHd - 3186-US2 130402 LT J Egbert.pdf (1 page)(105504 bytes)

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

Uncle Milton Industries, Inc.,

Opposer,

v.

Team John Whitaker Limited,

Applicant.

Opposition No. 91208266

Application Serial No. 85/445,797

Mark: MILTON

**OPPOSER’S MOTION TO COMPEL APPLICANT TO
SERVE INITIAL DISCLOSURES**

Pursuant to 37 CFR § 2.120(e), Uncle Milton Industries, Inc. (“Opposer”) respectfully submits this motion for the Board to issue an order compelling Applicant Team John Whitaker Limited (“Applicant”) to serve initial disclosures. It is well established that “a motion to compel is the available remedy when an adversary has failed to make, or has made inadequate, initial disclosures” Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42256 (August 2007); see also 37 CFR §2.120(e).

Accordingly, Opposer seeks the Board’s order compelling Applicant’s initial disclosures, based upon the following facts:

- On February 4, 2013, the parties held their discovery teleconference. See Declaration of Irene Y. Lee in Support of Opposer’s Motion to Compel Applicant to Serve Initial Disclosures (hereinafter referred to as “Lee Decl.”), ¶ 2.
- Under Trademark Rule 2.120(a)(2) and the Board’s Scheduling Order, dated November 30, 2012, the parties were required to serve their respective initial disclosures by March 10, 2013. Lee Decl., ¶ 3.

- In compliance with the Rule and Board's Scheduling Order, Opposer served its initial disclosures on February 15, 2013. Lee Decl., ¶ 4; Exhibit A.
- In violation of the Rule and Board's Scheduling Order, Applicant failed to serve its initial disclosures by March 10, 2013. Lee Decl., ¶ 5.
- On April 1, 2013, Opposer sent a letter to Applicant, requesting a meet and confer to address Applicant's failure to meet its discovery obligations: failure to serve its answer and documents in response to Opposer's first set of interrogatories and first set of requests for production of documents and things and its failure to serve initial disclosures. Lee Decl., ¶ 6; Exhibit B.
- On April 2, 2013, Applicant responded by email to Opposer's April 1, 2013 letter stating that Applicant refused to meet and confer via teleconference, and would meet and confer only via correspondence. Lee Decl., ¶ 7; Exhibit C.
- On April 2, 2013, I sent a reply letter to Applicant, reiterating Opposer's good faith effort to address Applicant's failure to meet its discovery obligations and violation of the Board's Scheduling Order. Lee Decl., ¶ 8; Exhibit D.
- Despite Opposer's repeated requests, Applicant has yet to serve initial disclosures, or any discovery responses for that matter. Lee Decl., ¶ 9.

Accordingly, Opposer respectfully seeks the Board's intervention to compel Applicant to serve initial disclosures within 20 days, without further delay.

Dated: May 10, 2013

Respectfully submitted,



Irene Y. Lee
RUSS, AUGUST & KABAT
Twelfth Floor
12424 Wilshire Boulevard

Los Angeles, California 90025
Telephone: (310) 826-7474
Facsimile: (310) 826-6991
Attorneys for Opposer
Uncle Milton Industries, Inc.

CERTIFICATE OF SERVICE

I hereby certify that on May 10, 2013, one (1) true and correct copy of the foregoing document has been served on Applicant by mailing the same via First Class Mail and electronic mail to:

John S. Egbert, Esq.
Kevin S. Wilson, Esq.
EGBERT LAW OFFICES, PLLC
21st Floor
1314 Texas
Houston, Texas 77002
Telephone: 713-224-8080 x 204
Facsimile: 713-223-4873
Email: mail@egbertlawoffices.com

/s/ Anne Zivkovic
Anne Zivkovic

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

Uncle Milton Industries, Inc.,

Opposer,

v.

Team John Whitaker Limited,

Applicant.

Opposition No. 91208266

Application Serial No. 85/445,797

Mark: MILTON

**DECLARATION OF IRENE Y. LEE IN SUPPORT OF OPPOSER'S MOTION TO
COMPEL APPLICANT TO SERVE INITIAL DISCLOSURES**

I, Irene Y. Lee, declare and state as follows:

1. I am a member of the State Bar of California and a partner in the firm of Russ, August & Kabat, counsel of record for Opposer Uncle Milton Industries, Inc. in the above-captioned opposition proceeding. I have personal knowledge of the facts set forth herein, and if called upon to testify, could and would testify competently thereto.

2. Pursuant to the Board's Scheduling Order, dated November 30, 2012, on February 4, 2013, I conducted discovery teleconference with Applicant's counsel.

3. Under Trademark Rule 2.120(a)(2) and the Board's Scheduling Order, the parties were required to serve their respective initial disclosures by March 10, 2013.

4. In compliance with the Rule and Board's Scheduling Order, Opposer served its initial disclosures on February 15, 2013. A true and correct copy of Opposer's initial disclosures is attached hereto as **Exhibit A**.

5. Applicant violated the Board's Scheduling Order by failure to serve its initial disclosures by March 10, 2013.

6. On April 1, 2013, on behalf of Opposer, I sent a letter to Applicant's counsel, requesting a meet and confer to address Applicant's failure to meet its discovery obligations: failure to serve its answer and documents in response to Opposer's first set of interrogatories and first set of requests for production of documents and things and its failure to serve initial disclosures. A true and correct copy of my April 1, 2013, letter is attached hereto as **EXHIBIT B**.

7. On April 2, 2013, Applicant's counsel responded by email to my letter, stating that Applicant refused to meet and confer via teleconference, and would meet and confer only via correspondence. A true and correct copy of his email is attached hereto as **EXHIBIT C**.

8. On April 2, 2013, I sent a reply letter to Applicant's counsel, reiterating Opposer's good faith effort to address Applicant's failure to meet its discovery obligations and violation of the Board's Scheduling Order. A true and correct copy of my letter of April 2, 2013, is attached hereto as **EXHIBIT D**.

9. Despite Opposer's repeated requests, Applicant has yet to serve initial disclosures, or any discovery responses for that matter.

I declare under penalty of perjury pursuant to the laws of the United States that the foregoing is true and correct.

Executed this 10th day of May, 2013 in Los Angeles, California.



Irene Y. Lee

CERTIFICATE OF SERVICE

I hereby certify that on May 10, 2013, one (1) true and correct copy of the foregoing document has been served on Applicant by mailing the same via First Class Mail and electronic mail to:

John S. Egbert, Esq.
Kevin S. Wilson, Esq.
EGBERT LAW OFFICES, PLLC
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1314 Texas
Houston, Texas 77002
Telephone: 713-224-8080 x 204
Facsimile: 713-223-4873
Email: mail@egbertlawoffices.com

/s/ Anne Zivkovic
Anne Zivkovic

EXHIBIT A

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

Uncle Milton Industries, Inc.,

Opposer,

v.

Team John Whitaker Limited,

Applicant.

Opposition No. 91208266

Serial No. 85/445,797

Mark: MILTON

OPPOSER UNCLE MILTON INDUSTRIES, INC.’S INITIAL DISCLOSURES

Pursuant to Rule 26(a)(1)(A) of the Federal Rules of Civil Procedure, Opposer Uncle Milton Industries, Inc. (“Uncle Milton”) hereby makes the following initial disclosures. These disclosures are based on Uncle Milton’s reasonable inquiries to date, and Uncle Milton reserves the right to amend, supplement, or otherwise modify these disclosures. Uncle Milton’s initial disclosures represent a good faith effort to identify information and documents it may use to support claims and defenses.

By making these disclosures, Uncle Milton does not represent that it is identifying every document, tangible thing or witness possibly relevant to this proceeding. Uncle Milton’s initial disclosures are made without in any way waiving: (1) the right to object to the use of any of the disclosed information, for any purpose, in whole or in part, in any subsequent proceeding in this action or any other action; and (2) the right to object on any and all grounds, at any time, to any discovery request or proceeding involving or relating to the subject matter of these disclosures.

Fed. R. Civ. Proc. 26(a)(1)(A)(i) Witnesses:

The name and, if known, the address and telephone number of each individual likely to have discoverable information—along with the subjects of that information—that the disclosing party may use to support its claims or defenses, unless the use would be solely for impeachment.

Pursuant to Fed. R. Civ. P. 26(a)(1)(A)(i), Uncle Milton identifies the following individuals. Uncle Milton expressly reserves the right to identify and/or call as witnesses additional and/or different individuals if, during the course of discovery and investigation relating to this case, Uncle Milton learns that such additional and/or different individuals have relevant knowledge.

1. Frank Adler (*)
Uncle Milton.com, Inc.

Subjects: Uncle Milton's adoption, ownership, application for service mark registrations, actual use and planned use of its UNCLE MILTON trademarks; Uncle Milton's advertising, promotional, and marketing activities and publications featuring its UNCLE MILTON trademarks and its products.

2. Person Most Knowledgeable
c/o John S. Egbert, Esq.
EGBERT LAW OFFICES, PLLC

Subjects:

- Applicant Team John Whitaker Limited ("Applicant")'s purported adoption, ownership, application for registration, protection, actual use and planned use of its trademarks at issue;
- Applicant's actual and planned advertising, marketing, distribution and sales of products offered and provided under its trademarks at issue;
- The channels of distribution and/or trade of products Applicant offers in connection with its trademarks at issue;
- Applicant's customers for products offered under its trademarks at issue;
- History of Applicant;
- Business of Applicant;
- Applicant's identification and awareness of Uncle Milton and its registration(s) and use of the UNCLE MILTON marks;
- Applicant's advertising, promotional and marketing activities for products offered under its trademarks at issue and associated costs and expenditures;

- Factual bases for denying the allegation that “Applicant’s MILTON mark is confusingly similar to Uncle Milton’s UNCLE MILTON marks in sound, appearance and commercial impression.”;
- Factual bases for denying the allegation that “[Applicant’s MILTON mark] so resembles Uncle Milton’s marks as to be likely, when applied to the goods, to cause confusion, or to cause mistake, or to deceive”;
- Factual bases for the affirmative defense that “Opposer’s Notice of Opposition fails to state a claim upon which relief can be granted.”;
- Factual bases for the affirmative defense that “Applicant’s mark and the alleged trademarks listed in Opposer’s Notice of Opposition are different in sound, appearance, meaning and commercial impression, [sic] that the goods of the parties are unrelated and marketed through different channels of trade.”;
- Factual bases for the affirmative defense that “the term ‘MILTON’ contained in the alleged common law trademarks and trademark registrations listed in Opposer’s Notice of Opposition have been used by various third parties for various goods and services and, as such, are ‘weak’ marks that are entitled to limited protection.”;
- Applicant’s sales of goods offered under its trademark mark at issue and revenues generated, and income derived, from such sales; and
- Pre-filing investigation, filing and prosecuting application, Serial No. 85/445,797.

3. John S. Egbert, Esq.
Kevin S. Wilson, Esq.
EGBERT LAW OFFICES, PLLC
1314 Texas, 21st Floor
Houston, Texas 77002

- Pre-filing investigation, filing and prosecuting application, Serial No. 85/445,797; and
- Applicant’s actual and planned use of its trademark at issue; and
- Identification and awareness of Uncle Milton and its registrations and use of the UNCLE MILTON marks.

No current or former Uncle Milton officer, employee or consultant may be contacted without the prior consent of Uncle Milton’s counsel. People listed above with asterisks (*) by

their name are represented by Uncle Milton's counsel for the purpose of this opposition proceeding, and can be contacted only through Uncle Milton's counsel.

Fed. R. Civ. Proc. 26(a)(1)(A)(ii) Documents:

A copy — or a description by category and location — of all documents, electronically stored information, and tangible things that the disclosing party has in its possession, custody, or control and may use to support its claims or defenses, unless the use would be solely for impeachment.

Pursuant to Fed. R. Civ. P. 26(a)(1)(A)(ii), and based upon presently available information, Uncle Milton may use relevant documents from the following categories to support its claims. Uncle Milton expressly reserves the right to identify and use documents from additional categories if, during the course of discovery and investigation relating to this case, Uncle Milton learns that such additional categories contain relevant documents. Uncle Milton also reserves the right to respond to and/or rebut the contentions and allegations Applicant may make.

1. Documents showing Uncle Milton's valid, enforceable rights in UNCLE MILTON marks.
2. Documents showing fame in UNCLE MILTON marks.
3. Investigation, analysis, studies or opinion of counsel concerning the strength, ownership, validity and/or enforceability of Applicant's trademark at issue.
4. Documents concerning Applicant's pre-filing investigation, filing and prosecuting applications, Serial No. 85/445,797.
5. Applicant's goods offered for sale and/or sold under the trademark at issue.
6. Applicant's marketing and promotional materials and associated expenditures.
7. Sales of Applicant's goods offered under its trademark at issue.

Numerous documents in the categories identified above are already in Applicant's possession, custody or control. These items which Uncle Milton may use to supports its claims will be made available for inspection at the offices of counsel for Uncle Milton, at a mutually

agreeable and convenient time for the parties and their respective counsel, subject to a protective order acceptable to all parties.

Further discovery and investigation may reveal additional tangible items or documents, which may be relevant and discoverable. Uncle Milton may produce other relevant and non-privileged documents in its own possession, custody or control, to the extent reasonably available, in response to the appropriate document requests, subject to its objections.

Dated: February 15, 2013

Respectfully submitted,



Irene Y. Lee
RUSS, AUGUST & KABAT
Twelfth Floor
12424 Wilshire Boulevard
Los Angeles, California 90025
Telephone: (310) 826-7474
Facsimile: (310) 826-6991

*Attorneys for Opposer
Uncle Milton Industries, Inc.*

CERTIFICATE OF SERVICE

I certify that a true and correct copy of the foregoing **Opposer Uncle Milton Industries, Inc.'s Initial Disclosures** was served by first class mail, postage prepaid, and electronic mail on February 15, 2013 upon counsel of Applicant:

John S. Egbert, Esq.
Kevin S. Wilson, Esq.
EGBERT LAW OFFICES, PLLC
21st Floor
1314 Texas
Houston, Texas 77002
Telephone: 713-224-8080 x 204
Facsimile: 713-223-4873
Email: mail@egbertlawoffices.com

/s/ Anne Zivkovic

Anne Zivkovic

EXHIBIT B



Irene Y. Lee
ilee@raklaw.com

April 1, 2013

12424
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90025

Tel 310.826.7474
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VIA FIRST CLASS MAIL
VIA ELECTRONIC MAIL - mail@egbertlawoffices.com

John S. Egbert, Esq.
Egbert Law Offices PLLC
21st Floor
1314 Texas Avenue
Houston, Texas 77002

Re: *Uncle Milton Industries, Inc. v. Team John Whitaker Limited*
Opposition No. 91208266
Application No. 85/445,797
Mark: MILTON

Dear Mr. Egbert,

I am writing to initiate the meet-and-confer process to address Applicant Team John Whitaker Limited's failure to serve its answers and documents in response to Opposer Uncle Milton Industries, Inc.'s first set of interrogatories and first set of requests for production of documents and things, both of which were served on February 15, 2013, along with Uncle Milton Industries, Inc.'s initial disclosures.

We are available on April 2, 3, 4 and 5 to meet and confer between 9:00 a.m. and noon (Pacific Time). Please let me know if you are available on any of the proposed dates. If you are not available, please suggest a few alternative dates and times.

Very truly yours,

Russ, August & Kabat

Irene Y. Lee

EXHIBIT C

From: Kevin Wilson <kwilson@egbertlawoffices.com>
Subject: **Re: US: MILTON (Opposition No. 91208266) [3186-003]**
Date: April 2, 2013 1:47:42 PM PDT
To: Irene Lee <ilee@raklaw.com>
Cc: Anne Zivkovic <azivkovic@raklaw.com>, Nathan Meyer <nmeyer@raklaw.com>, Mike Swartz <mswartz@egbertlawoffices.com>, Egbert Law Offices <mail@egbertlawoffices.com>

Dear Irene:

Perhaps you are unfamiliar with practice in the TTAB. I would suggest you read TBMP Section 523.02. The rules of this administrative court clearly includes the phrase "by conference or correspondence." All we have explained is that we are not going to have a conference call with you. We are certainly open to any correspondence you may have for us.

If you have any other questions or concerns, please feel free to contact our office at any time.

Sincerely,
Kevin Wilson

Egbert Law Offices, PLLC
Great Southwest Building
1314 Texas, 21st Floor
Houston, TX 77002
Tel: (713) 224-8080 Ext. 206
Fax: (713) 223-4873

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On 4/2/2013 3:32 PM, Irene Lee wrote:

Dear Kevin,

As a moving party, we are required to conduct a meet and confer before filing a motion to compel discovery responses. Please advise if you refuse to participate in the meet and confer process so we can properly advise the Board.

Regards,

--
Irene Y. Lee
RUSS AUGUST & KABAT
12th Floor
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Los Angeles, California 90025
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Direct: 001.310.979.8224

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On Apr 2, 2013, at 12:21 PM, Kevin Wilson <kwilson@egbertlawoffices.com> wrote:

Dear Irene:

At this point, we believe a conference is unnecessary, therefore, we do not plan on setting up a time for a conference. We are, of course, open to any correspondence regarding any issues you may have. We, therefore, ask at this time that you proceed with your case as you deem fit.

If you have any other questions or concerns, please feel free to contact our office at any time.

Sincerely,
Kevin Wilson

Egbert Law Offices, PLLC
Great Southwest Building

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Houston, TX 77002
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--- On **Mon, 4/1/13**, **Anne Zivkovic** <azivkovic@raklaw.com> wrote:

From: Anne Zivkovic <azivkovic@raklaw.com>
Subject: US: MILTON (Opposition No. 91208266) [3186-003]
To: mail@egbertlawoffices.com
Cc: "Irene Lee" <ilee@raklaw.com>, "Nathan Meyer" <nmeyer@raklaw.com>
Date: Monday, April 1, 2013, 5:43 PM

Dear Mr. Egbert,

Please find attached a letter from Ms. Irene Lee regarding the referenced trademark opposition. Thank you.

Sincerely,

Anne Zivkovic
Intellectual Property Paralegal
Russ August & Kabat
12424 Wilshire Blvd., Suite 1200
Los Angeles, CA 90025
(310) 826-7474

EXHIBIT D



Irene Y. Lee
ilee@raklaw.com

April 2, 2013

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VIA FIRST CLASS MAIL
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John S. Egbert, Esq.
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21st Floor
1314 Texas Avenue
Houston, Texas 77002

Re: *Uncle Milton Industries, Inc. v. Team John Whitaker Limited*
Opposition No. 91208266
Application No. 85/445,797
Mark: MILTON

Dear Messrs. Egbert and Wilson,

Thank you for your email of even date herewith, where you pointed out the "by conference or correspondence" language in Section 523.02. Pursuant to that very language, we made a good faith effort by sending a letter to you yesterday. In the letter, we requested that the parties meet and confer to address Applicant's failure to serve any answer or document in response to Opposer's first set of interrogatories and first set of requests for documents and things, both of which were served on February 15, 2013, along with Opposer's initial disclosures. Applicant has yet to serve its initial disclosures, which were due March 10, 2013.

While we are puzzled by your refusal to participate in a conference call to address Applicant's failure to serve discovery responses and resolve its violation of the Board's scheduling order of November 30, 2012, we remain open and willing to resolve the matter in good faith through correspondence.

As we endeavor to prosecute this matter in compliance with the Board's scheduling order, we ask that Applicant's initial disclosures be served by April 12, 2013, along with full and complete responses and documents in response to Opposer's first set of interrogatories and first set of requests for documents and things. Otherwise, we will have to seek the Board's intervention.



John S. Egbert, Esq.
Kevin Wilson, Esq.
Egbert Law Offices PLLC
April 2, 2013
Page 2 of 2

Please confirm that Applicant's will serve all outstanding discovery responses, documents and initial disclosures by April 12, 2013.

Very truly yours,

Russ, August & Kabat

Irene Y. Lee

IYL/az