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

Proceeding	91208855
Party	Defendant The Wine Group LLC
Correspondence Address	PAUL W REIDL LAW OFFICE OF PAUL W REIDL 241 EAGLE TRACE DRIVE, SECOND FLOOR HALF MOON BAY, CA 94019 UNITED STATES paul@reidllaw.com
Submission	Motion to Compel Discovery
Filer's Name	Paul W Reidl
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Date	07/15/2013
Attachments	Motion to Compel.pdf(73912 bytes) Exhibit1.pdf(1460117 bytes) Exhibit3.pdf(5966280 bytes) Exhibit4.pdf(4734545 bytes) Exhibit5.pdf(437064 bytes)

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

3 Application Serial No. 85/736,374

4 Mark: (B)URBAN

5 Class: 33

6
7 _____)
8 **GREATER LOUISVILLE**)
9 **CONVENTION & VISITORS**)
10 **BUREAU,**)

11 Opposer/Respondent,)

12 v.)

13 **THE WINE GROUP, LLC,**)

14 Applicant/Counterclaimant.)
15 _____)

Opposition No. 91208855

**MOTION TO COMPEL RESPONSES
TO DOCUMENT REQUESTS AND TO
TEST THE SUFFICIENCY OF
RESPONSES TO REQUESTS FOR
ADMISSION**

16 Applicant, the Wine Group (“TWG”) hereby moves: (a) to compel document discovery
17 from Opposer, the Greater Louisville Convention and Visitors Bureau (“GLCVB”), and (b) to
18 test the sufficiency of three RFA responses. TWG regrets making this motion but GLCVB has
19 not participated in the meet and confer process on these issues. TWG requests a prompt decision
20 with a telephonic hearing if the Board deems it appropriate.¹

21 **MEET AND CONFER PROCESS**

22 The undersigned counsel certifies that he has made a good faith attempt to resolve these
23 issues with GLCVB as required by the Board’s Rules. He explained in writing, twice, why
24 GLCVB’s positions were not well-grounded, making essentially the same arguments made in

¹ TWG notes that a motion for reconsideration or, in the alternative, to strike the newly-pleaded affirmative defenses is currently pending.

1 this motion. With respect to each, GLCVB declined to provide any explanation or justification
2 for its position. It has simply asserted that it was right, that TWG was wrong, and that if TWG
3 disagree it should file a motion to compel. This was not acting in good faith as required by
4 TBMP § 408.01; *see Panda Travel Inc., v Resort Option Enterprises, Inc.*, 94 U.S.P.Q.2d 1789,
5 1791 (TTAB 2009); *Amazon Technologies Inc. v. Wax*, 93 U.S.P.Q.2d 1702, 1705 (TTAB
6 2009). TWG suggested that these issues be resolved in a telephone conference with the Board
7 but GLCVB insisted on a full briefing. Copies of the meet and confer correspondence between
8 the parties are attached as Exhibit 1 to this motion.

9 **DOCUMENT PRODUCTION ISSUES**

10 **• Remedy Sought**

11 Applicant seeks an Order compelling GLCVB to: (a) provide an unconditioned,
12 unequivocal response to each document request, (b) to produce all responsive documents, not a
13 “sampling” or a “list,” (c) require GLCVB to copy and produce the documents to TWG and (d)
14 require GLCVB to produce documents responsive to three specific requests. TWG requests that
15 the Order require GLCVB to do each of these within twenty (20) days.

16 **• Requests and Responses**

17 Discovery opened on May 5, 2013. TWG served its initial disclosures and its document
18 requests on May 10, 2013. GLCVB provided a written response on June 14, 2013 (Exhibit 2). It
19 did not request any extension of time to respond. GLCVB has not produced any documents.

20 **• The Need For Unconditioned, Unequivocal Responses**

21 As the Board will see from Exhibit 2, GLCVB answered most of the document requests
22 with a long string of objections concluding with the following statement: “Louisville will permit
23 inspection and copying of non-privileged documents and things responsive to this request, if any
24

1 exist.” (See, e.g., response to Requests 1–25, 26-27, 31, 33-52). It also expressly disclaimed the
2 responsibility to tell TWG whether any responsive documents actually exist. (General Objection
3 14, Exhibit 2, page 5). This is not a proper response because it does not tell TWG whether there
4 are, in fact, responsive documents. Without that information, TWG cannot assess the
5 completeness of GLCVB’s document production nor can it properly prepare for trial.

6 Rule 34 requires GLCVB to “state whether or not there are responsive documents” in
7 response to each specific request. TBMP § 406.04 (c) (citing *No Fear Inc. v. Rule*, 54 USPQ2d
8 1551, 1555 (TTAB 2000)). This is fundamental to the document discovery process, for the
9 entire point of written document discovery is to “discover” whether a party has documents on a
10 particular subject matter. Without such a requirement, a party is simply left to guess – based on
11 whatever is ultimately produced – whether responsive documents exist. On subjects such as
12 whether an applicant had a bona fide intention to use the mark as of the date of the filing of the
13 application, knowing whether responsive documents exist can be critical.

14 The Rules require a party to do a search to determine whether it has responsive
15 documents, TBMP § 409.02. GLCVB presumably did one. It would therefore be a relatively
16 simple thing for it to have given straightforward and unequivocal responses to the document
17 requests. Instead, it decided to play “hide the ball.” TWG does not know why GLCVB believes
18 its view is correct; it never attempted to justify it during the meet and confer process.

19 Accordingly, GLCVB should be ordered to state definitively whether it has responsive
20 documents to each of the aforementioned requests.

21 • **All Responsive Documents Must be Produced (General Objection 14).**

22 GLCVB has asserted an extraordinary procedure for producing its documents. In
23 General Objection 14 (Exhibit 2, page 5), it claims that it is only obligated to produce a
24

1 “representative sample” or “summary information” of its documents and, and after TWG has
2 reviewed these, TWG must enter into a “meet and confer” process with GLCVB to determine
3 what documents GLVCB will actually produce.

4 Such a procedure would be unprecedented and not is permitted by Rule 34. GLCVB
5 does not get to pick and choose which documents it will show TWG, and TWG is not required to
6 negotiate over what GLCVB will actually produce. Rule 34 requires GLCVB to produce all
7 responsive documents. TBMP § 406.04. Once again, GLCVB made no attempt to justify this
8 extraordinary view of its Rule 34 obligations during the meet and confer process.

9 Accordingly, GLCVB should be ordered to produce all responsive documents to those
10 requests where it has agreed to produce documents, not a “representative sample” or “summary
11 information.”

12 • **GLCVB Should Be Required to Copy and Send the Documents to TWG**

13 GLCVB compounds the impropriety of the previous two objections by demanding that
14 TWG’s counsel travel from San Francisco to GLCVB’s home office in Louisville, Kentucky to
15 review the self-selected “samples” or a “list” -- without knowing whether any responsive
16 documents exist at all. Similarly, GLCVB’s counsel would have to travel from Baltimore to
17 Louisville. This is unfair, unreasonable, economically irrational, and contrary to GLCVB’s
18 obligation to cooperate in good faith in discovery. There is simply no proper reason for it, and
19 GLCVB provided none during the meet and confer process. The only reason to impose such
20 barriers to producing documents is harassment of TWG by running up the cost of this opposition
21 and forcing unnecessary motions.

22 The bad faith nature of this self-declared procedure is compounded by GLCVB’s own
23 document requests on TWG, which require TWG to produce its documents at the offices of
24

1 GLCVB’s counsel in Maryland. (See Exhibit 3, page 1).² Under these circumstances, GLCVB
2 should be estopped from insisting on a production at its offices in Louisville and, instead, be
3 required to copy and send the documents to the offices of TWG’s counsel in California. TBMP
4 § 402.01; *see Amazon Technologies, supra* (a party is estopped from objecting to discovery
5 requests that are the same as those it propounded).

6 • **GLCVB Should be Ordered to Respond to Three Specific Requests**

7 **Requests 26 and 32.** The Notice of Opposition alleges in paragraph 2 that GLCVB is
8 the licensee of one of the registrations on which this opposition is based, no. 3,932,986. GLCVB
9 was the original owner of this registration, apparently assigned it to a third party and received a
10 license in return. As an Affirmative Defense, TWG alleges that these transactions were invalid
11 due, in part, to the absence of quality control. Request 26 seeks documents concerning the
12 quality control and request 32 seeks documents concerning communications with the licensor.

13 GLCVB refused to produce any documents responsive to either request. As with its other
14 objections, GLCVB offered no justification for this position during the meet and confer process.

15 These requests are reasonably calculated to lead to the discovery of admissible evidence.
16 They go to the validity of the right being asserted. They go to the right of GLCVB to assert it on
17 behalf of its owner. Because this mark is registered on the Supplemental Register, they go to the
18 ability of GLCVB to prove that the mark has acquired distinctiveness such that it can be relied
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20
21

22 ² If the Board believes that GLCVB’s procedure is appropriate, then Board should out of
23 fairness require that GLCVB’s counsel travel to TWG’s offices in Tracy, California to view its
24 documents.

1 on in an opposition proceeding.³ *Otter Products LLC v. BaseOneLabs LLC*, 105 U.S.P.Q.2d
2 1252 (TTAB 2012).

3 Accordingly, GLCVB should be ordered to produce documents responsive to these
4 requests.

5 **Request 30.** The marks at issue in this case are GLCVB’s URBAN BOURBON
6 TRAIL/URBAN BOURBON/URBAN BOURBON EXPERIENCE in class 35 and TWG’s
7 B(URBAN) in Class 33. Request 30 sought documents concerning the use of the term
8 “bourbon” as part of a trademark. (Exhibit 2, pages 28-29). GLCVB asserted its boilerplate
9 objections and refused to produce any documents responsive to this request. As with its other
10 objections, GLCVB offered no justification for these objections during the meet and confer
11 process.

12 The objections are improper. Third party marks are relevant under the sixth *DuPont*
13 factor: “The number and nature of similar marks in use on similar goods.” They go to the
14 strength of the marks being asserted against TWG. Moreover, GLCVB should be estopped from
15 asserting this objection because it made a substantially similar request of TWG (Exhibit 3,
16 Request No. 66). TBMP § 402.01; *see Amazon Technologies, supra* (a party is estopped from
17 objecting to discovery requests that are the same as those it propounded).

18 Accordingly, GLCVB should be ordered to state whether it has any such documents and,
19 if so, to produce them.

20 **REQUESTS FOR ADMISSION**

21 TWG served its Requests for Admission on May 10, 2013. GLCVB served its written
22 responses on June 14, 2013 (Exhibit 4).

23 ³ TWG has asked GLCVB to dismiss the claims based on this registration but it has
24 refused because it believes it can prove acquired distinctiveness.

1 Rule 36 permits a party to test the sufficiency of a response to a request for admission by
2 filing a motion with the Board. TBMP § 524.01. The Board can order that the request be
3 admitted. As set forth above, TWG has explained to GLCVB why it believes that the requests
4 should have been admitted, but GLCVB has offered no explanation for its denials.

5 **Request 3.** This request asked GLCVB to admit that the first use date of registration no.
6 4,178,113 was October 20, 2011. This was denied by GLCVB. (Exhibit 4, page 2). The cover
7 sheet for this Notice of Opposition, the Amendment to Allege Use for the application, and the
8 official TSDR record state this as the first use date. (Exhibit 5). During the meet and confer
9 process GLCVB did not explain why this request was properly denied. It should therefore be
10 deemed as admitted.

11 **Request 36.** This request asked GLCVB to admit that the Examining Attorney for the
12 application that became Registration No. 3,932,986 claimed that there was a likelihood of
13 confusion with a similar mark in Class 33. This was denied by GLCVB. (Exhibit 4, pages 8-9).
14 The Office Action dated September 10, 2009 said precisely this, and counsel for GLCVB filed a
15 response to that Office Action on March 10, 2010. (Exhibit 6). During the meet and confer
16 process GLCVB did not explain why this request was properly denied. It should therefore be
17 deemed as admitted.

18 **Request 37.** This request was a companion request to request 36. It asked GLCVB to
19 admit that during the prosecution of the application that became Registration No. 3,932,986, it
20 argued that there was no likelihood of confusion between URBAN BOURBAN EXPERIENCE
21 in Class 35 and URBAN BOURBAN for “alcohol beverages, namely bourbon and bourbon-
22 based beverages.” This was denied by GLCVB. (Exhibit 5, page 9). The Office Action dated
23 September 10, 2009 said precisely this, and counsel for GLCVB’s response of March 10, 2010 to
24

1 the Office Action makes it very clear that it did, in fact, make such an argument. (Exhibit 6).
2 During the meet and confer process GLCVB did not explain why this request was properly
3 denied. It should therefore be deemed as admitted.

4 **CONCLUSION**

5 This is a simple motion and TWG asks the Board to act quickly on it. As indicated by the
6 foregoing objections and responses, GLCVB has not acted in good faith and has frustrated
7 TWG's ability to defend itself in this opposition by failing to cooperate during discovery. The
8 motion should be granted. This is the kind of bad faith conduct that a Federal Magistrate Judge
9 would sanction. Regrettably, the Board does not have that authority.

10 Respectfully submitted,

11 **LAW OFFICE OF PAUL W. REIDL**

12 

13 By: _____

14
15 Dated: July 15, 2013

16 Paul W. Reidl
17 Law Office of Paul W. Reidl
18 241 Eagle Trace Drive
19 Second Floor
20 Half Moon Bay, CA 94019
21 (650) 560-8530
22 paul@reidllaw.com

23 *Attorney for Applicant,*
24 *The Wine Group*

1 **CERTIFICATE OF SERVICE**

2 On July 15, 2013, I caused to be served the following document:

3 **MOTION TO COMPEL RESPONSES TO DOCUMENT REQUESTS AND TO TEST**
4 **THE SUFFICIENCY OF REQUESTS FOR ADMISSION**

5 on Opposer by placing a true copy thereof in the United States mail enclosed in an envelope,
6 postage prepaid, addressed as follows to their counsel of record at his present business address:

7 John A. Galbreath
8 Galbreath Law Offices
2516 Chestnut Woods Ct.
Reiseterstown, MD 21136-5523

9 Executed on July 15, 2013 at Half Moon Bay, California.

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EXHIBIT 1



June 26, 2013

John L. Galbreath
Galbreath Law Offices PC
2516 Chestnut Woods Ct.
Reisterstown, MD 21136-5523

VIA E-MAIL and USPS

Re: Opposition No. 9120885

Dear Mr. Galbreath:

This letter initiates the meet and confer process for your responses to my first round of discovery requests. While I have concerns regarding your blanket objections, taking the Board's time with these would be inappropriate at this time due to the many other issues with your responses. These are detailed below.

REQUESTS FOR ADMISSION

Request No. 3. This request asked you to admit that the claimed first use date of the mark in Registration No. 4,178,113 was October 20, 2011. Your denial of this request was not made in good faith. You used this date in the cover sheet for your Notice of Opposition and it is reflected in the Amendment to Allege use that you personally signed under oath. Please change your response accordingly or explain why the declaration you signed under oath was not true.

Request No. 27. This request asked you to admit that the term "BOURBON" was disclaimed in Registration No. 3,032,986. Your denial of this request was not made in good faith. The disclaimer of this term is reflected on the face of the registration certificate. Please change your response accordingly.

Request No. 36. This request asked you to admit that the Examining Attorney for the application that became Registration No. 3,932,986 claimed that there was a likelihood of confusion with a similar mark in Class 33. Your denial of this request was not made in good faith. Please refresh your recollection by reviewing the Office Action dated September 10, 2009 and your response thereto dated March 10, 2010. You and I both know that this request should have been admitted. Please change your response accordingly.

Request No. 37. This request asked you to admit that during the prosecution of the application that became Registration No. 3,932,986, you argued that there was no likelihood of confusion between URBAN BOURBAN EXPERIENCE in Class 35 and URBAN BOURBAN for "alcohol beverages, namely bourbon and bourbon-based beverages." Your denial of this request was not made in good faith.

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I call your attention to the Office Action response that you signed and filed on March 10, 2010, in which you addressed the Examining Attorney's Section 2 (d) citation to Registration No. 3,097,217. You wrote in part as follows:

Regarding Applicant's Class 35 services, there are many different services that are within the scope of promoting business and tourism, and simply because a particular business or tourist attraction is located in the bourbon-producing region of Kentucky does not mean that the business or tourist attraction is connected with bourbon. Said another way, Applicant's services are not defined as promoting the *bourbon* business and *bourbon* tourism.

Your argument persuaded the Examining Attorney to withdraw the citation. Please change your response accordingly.

INTERROGATORY RESPONSES

Your **General Objection No. 3** states that you will not produce proprietary or confidential information without a protective order. We have already agreed to abide by the Board's standard protective order. Accordingly, please withdraw your objection.

Interrogatory No. 7. This interrogatory asked whether you have licensed any of your marks to a third party and it asked you to identify that third party. Identify is a defined term (to which you did not object) that asked you to provide basic information about the licensee. You did not fully answer this interrogatory. While you confirmed that there was at least one licensee, you did not identify it. Your offer to produce documents is not a proper Rule 33 (d) response; the identity of a licensee is a simple matter the information for which can be provided by your client over the telephone. Please provide this information.

Interrogatory No. 9. This interrogatory asked you to identify the licensee you referenced in your Notice of Opposition. You did not do so. Your offer to produce documents is not a proper Rule 33 (d) response; the identity of licensees is a simple matter the information for which can be provided by your client over the telephone. Please provide this information.

Interrogatory No. 10. This interrogatory asked whether the Kentucky Derby Museum was licensed to use one of the marks. It also asked you to identify the licensee agreement. Again, you have only answered half the question: you affirmed that it was a licensee. Your offer to produce the license agreement is not a proper Rule 33 (d) response; the basic information about the agreement can be provided by your client over the telephone. Please provide this information.

Interrogatory No. 15. This interrogatory requested you to identify each document reflecting your bona fide intention to use the mark. Your offer to produce the documents is not a proper Rule 33 (d) response; I am entitled to this basic information so that I know which documents purport to show the bona fide intention to use. Please provide this information.

DOCUMENT RESPONSES

Generally. You have not responded in good faith to the document requests. The requests instructed you to produce the requested documents to me. You were required to provide a written

response stating whether you had such documents. You did neither. Instead, you provided the same response to nearly all of my requests: “Louisville will permit inspection and copying of non-privileged documents and things responsive to this request, if any exist.” That is not a proper response. As of today, I know no more about your client’s documents than I knew at the time I wrote the requests: they may exist, they may not exist, and you (apparently) are in no position to tell me because (as you acknowledged in response to interrogatory no. 8) your clients have not provided you with any documents.

I can understand why your client does not want to take the time to search for responsive documents, but this opposition was initiated by them, not my client. They have the burden of proof, not TWG. If there are no responsive documents, then so be it but I am entitled to a clear and unambiguous answer to each request. Accordingly, please produce your documents promptly or give me an unambiguous answer to each request that no such documents exist.

Objection 14. Your assertion that you are only obligated to produce a “representative sample” of documents and that you will consider producing more after a “meet and confer” is improper. Rule 34 requires you to produce **all** the documents to me **at my offices**. You have no right to cherry pick representative documents, force me to fly to Louisville to look at them and then require me to go through a “meet and confer” process to get the rest. Accordingly, please produce all of the documents as instructed.

Request No. 26. This requested documents concerning the quality control exercised by you over the licensee mentioned in the Notice of Opposition. You responded by objecting and refusing to produce any documents in response to this request. Your objections are improper. My client has alleged that your client has engaged in naked licensing of its registered mark in that it has failed to exercise quality control. I am, therefore, entitled to documents concerning the quality control exercised by your client. Please amend your response and produce the requested documents or give me an unambiguous answer to each request that no such documents exist.

Request No. 30. This requested documents concerning trademarks that contain the term “bourbon.” You have refused to produce documents responsive to this request on relevance grounds. This objection is improper. You made the same request of my client (Request No. 66 and interrogatory 30). Third party marks are relevant under the sixth *DuPont* factor: “The number and nature of similar marks in use on similar goods.” Accordingly, please withdraw your objection, amend your response and produce the documents or give me an unambiguous answer to each request that no such documents exist.

Request No. 32. This requested communications between you and the owner of registration no. 3,932,986. You have refused to do so on relevance and burden grounds. These objections are improper. You have asserted that you have the right to bring this opposition even though you do not own the registered mark. That mark also was assigned by you, and based on the recorded assignment it is reasonably likely that the assignment was naked and therefore invalid. Accordingly, the request is reasonably likely to lead to the discovery of admissible evidence. As for burden, you have not provided any facts on which the Board could determine whether there was a burdensome quantity of documents. I rather doubt it. Accordingly, please withdraw your objection, amend your response, and produce the documents or give me an unambiguous answer to each request that no such documents exist.

I need your affirmative responses to these requests, and your documents, by July 3, 2013. If you prefer to stand on your objections and responses please let me know promptly and I will arrange for a conference call with the Interlocutory Attorney to resolve the dispute.

Yours sincerely,

A handwritten signature in black ink that reads "Paul W. Reidl". The signature is written in a cursive, flowing style.



GALBREATH LAW OFFICES, P.C.

2516 Chestnut Woods Ct. Reisterstown, MD 21136-5523 U.S.A.
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Web: www.galbreath-law.com

July 3, 2013

BY EMAIL

PAUL W. REIDL
LAW OFFICE OF PAUL W. REIDL
241 EAGLE TRACE DR., 2nd FLR.
HALF MOON BAY, CA 94019

Re: Louisville Convention & Visitors Bureau v. Wine Group – Opposition 9120885

Dear Paul,

Thank you for your letter of June 26, 2013. We strongly disagree with your characterization of our discovery responses, and specifics follow:

Requests for Admission 3, 27, 36, and 37

We believe we have given true and correct responses to your admission requests, and we do not plan to change our responses.

Interrogatories 7, 9, 10, and 15

We believe that our answers are proper under the rules. Regarding interrogatory 7, if you have any doubt about what record may be used to derive the answer, let me be clear that the license agreement for the URBAN BOURBON mark is that record. We have already stated, in our responses to your production requests, that we will afford you the opportunity to

inspect and copy all license agreements concerning Opposer's Marks, which of course includes the URBAN BOURBON mark.

Regarding interrogatory 9, if you have any doubt about what record may be used to derive the answer, let me be clear that the license agreement for the URBAN BOURBON TRAIL mark is that record. We have already stated, in our responses to your production requests, that we will afford you the opportunity to inspect and copy all license agreements involving Opposer's Marks, which of course includes the URBAN BOURBON TRAIL mark.

Regarding interrogatory 10, if you have any doubt about what record may be used to derive the answer, let me be clear that the license agreement for the URBAN BOURBON mark is that record. We have already stated, in our responses to your production requests, that we will afford you the opportunity to inspect and copy all license agreements for Opposer's Marks, which of course includes the URBAN BOURBON mark.

Regarding interrogatory 15, if you have any doubt about what records may be used to derive the answer, let me be clear that Louisville's marketing and business plans concerning the URBAN BOURBON mark prior to its filing are those records. We have already stated, in our responses to your production requests, that we will afford you the opportunity to inspect and copy all documents concerning the marketing and business plans for Opposer's Marks, which of course includes the URBAN BOURBON mark.

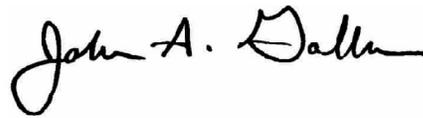
Requests for Production 26, 30, and 32

We believe that our responses are proper under the rules. Specifically, we stand by our objection concerning request for production 26. We also stand by our objection to request for production 30. Finally, we stand by our objection regarding request for production 32.

Given the extensive nature of your objections to our responses and the vitriolic tenor of your letter, it does not make sense to attempt to resolve all these issues informally via a telephone conference. Rather, we wish to have a formal written record of your objections and associated arguments; our arguments against your objections; and the Board's decision. If you wish to pursue these matters further, you may of course file a motion to

compel under 37 C.F.R. § 2.120(e) and Fed. R. Civ. P. 37(a).

Best regards,

A handwritten signature in black ink that reads "John A. Galbreath". The signature is written in a cursive style with a large initial "J" and a distinct "G".

John Galbreath

JG784:ks



July 8, 2013

John L. Galbreath
Galbreath Law Offices PC
2516 Chestnut Woods Ct.
Reisterstown, MD 21136-5523

VIA E-MAIL and USPS

Re: Opposition No. 9120885

Dear Mr. Galbreath:

This letter responds to your letter of July 3, 2013, in which you responded to my meet and confer letter of June 26, 2013.

The Board requires you to meet and confer in good faith. TBMP § 408.01; *see Panda Travel Inc., v Resort Option Enterprises, Inc.*, 94 U.S.P.Q.2d 1789, 1791 (TTAB 2009) (“Each party has a duty to make a good faith effort to satisfy the reasonable and appropriate discovery needs of its adversary.”) As the Board stated in *Amazon Technologies Inc. v. Wax*, 93 U.S.P.Q.2d 1702, 1705 (TTAB 2009)(quoting *Nevada Power Co. v. Monsanto Co.*, 151 F.R.D. 118, 120 (D. Nev. 1993)):

In order for the meet and confer process to be meaningful and serve its intended purpose, the parties must present to each other the merits of their respective positions with the same candor, specificity, and support during informal negotiations as during the briefing of discovery motions.

You have not done so.

1. **Requests for Admission 3, 27, 36 and 37.** I pointed to objective documents in the USPTO docket – including your own sworn declaration – to support my contention that these should have been admitted. Your flippant statement that you stand by your denials was not made in good faith. At a minimum, you are required to explain why you are correct – and especially in light of the documentation provided in my letter which plainly shows that these should have been admitted. In other words, if a motion can be avoided because I am misreading the documents, then under *Amazon Technologies* you have an obligation to tell me why you

think I am wrong so that we might avoid involving the Board in the matter. The meet and confer requirements do not permit you to “hide the ball” until after I file a motion to compel.

2. Requests for Production, Generally, and Objection 14. You **never** responded to my claim that your responses, generally, and your unilateral procedures for providing me with the documents were improper and not made in good faith. Thus, as I sit here today, I do not know whether you have documents responsive to any request and I do not have any documents. I also do not know why you believe such extraordinary procedures are permitted by the Rules. Please provide proper responses and produce your documents immediately, or explain why your procedures are permitted by the Rules.

3. Requests 26, 30, 32. As with your responses on the RFA’s, your statement that you stand by your responses is not made in good faith. *Amazon Technologies* requires more.

* * * * *

Accordingly, please provide full and complete responses, or a detailed explanation as to why your initial responses were correct, by July 12, 2013, or I will make a motion to compel.

Yours sincerely,



Paul W. Reidl



GALBREATH LAW OFFICES, P.C.

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July 12, 2013

BY EMAIL

PAUL W. REIDL
LAW OFFICE OF PAUL W. REIDL
241 EAGLE TRACE DR., 2nd FLR.
HALF MOON BAY, CA 94019

Re: Louisville Convention & Visitors Bureau v. Wine Group – Opposition 9120885

Dear Paul,

Thank you for your letter of July 8, 2013. Please see our July 3, 2013 letter, which responded to the alleged deficiencies in admission request responses, interrogatory answers, and production request responses enumerated in your June 26, 2013 letter.

Our position on your alleged issues has not changed, and we believe they are without merit. We wish to additionally make clear that we will permit inspection and copying of documents consistent with the Standard Protective Order. Said another way, confidentiality will not impede our production of documents for inspection and copying. Just let us know which dates would be convenient for you to come inspect Louisville's documents, and we will check with our client and get back to you. I am sure that we can arrive at mutually-agreeable dates.

Best regards,

John Galbreath



July 14, 2013

John L. Galbreath
Galbreath Law Offices PC
2516 Chestnut Woods Ct.
Reisterstown, MD 21136-5523

VIA E-MAIL

Re: Opposition No. 9120885

Dear Mr. Galbreath:

This letter responds to your letter of July 12, 2013, in which you responded to my second meet and confer letter dated July 8, 2013.

The Board requires you to meet and confer in good faith. You are not acting in good faith by again asserting, without elaboration, that you are right and I am wrong. Those kinds of schoolyard responses have no place in Board proceedings. While I doubt that you have a sound legal basis for your positions, the TBMP, the *Amazon Technologies* case and others are unequivocal: it is improper for you to decline to justify your positions. You are required to communicate your arguments to me **before** my client invests in a motion. That is the whole point of the meet and confer process.

As for the production of documents, your demand that I must come to Louisville to look at a “list” or a “sample” of documents has no basis in Rule 34, is economically irrational and not made in good faith. Since you have presumably already complied with the Board’s rules and gathered the responsive documents, it is a simple matter for you to number, copy and produce them. Your refusal to do so is improper. When coupled with your refusal even to tell me whether your client has any documents responsive to any request, and your insistence that even after I view the list or sample you will still insist on a further meet and confer over what you will produce, it would be unreasonable for me to come to Louisville to do exactly what? Look at a list? Look at a “sample” document? That is not the way Rule 34 works and I think the Board will agree.

Your own instructions for producing documents in response to your document requests require me to produce them at your offices. Based on the holding in *Amazon Technologies* you are estopped from requiring me to do something different than what you have asked of me. In the event I am wrong, however, I am holding on to TWG’s documents until the Board decides the motion. If I must come to Louisville, then you must come to Northern California.

Your refusal to participate in good faith in the meet and confer process leaves me no choice but to file the enclosed motion to compel.

Yours sincerely,

A handwritten signature in black ink that reads "Paul W. Reidl". The signature is written in a cursive, flowing style.

Paul W. Reidl

Attorney for The Wine Group

EXHIBIT 3

**Greater Louisville Convention
and Visitors Bureau**

Opposer

v.

The Wine Group LLC

Applicant

) **IN THE UNITED STATES**
) **PATENT AND TRADEMARK OFFICE**
)
) **TRADEMARK TRIAL AND APPEAL BOAR**
)
) **APPL. NO. 85/736,374**
) **OPPOSITION NO. 91208855**
)

**OPPOSER'S FIRST SET OF REQUESTS FOR
PRODUCTION OF DOCUMENTS AND THINGS, NOS. 1 - 66**

Pursuant to Rule 2.120(d) of the U.S. Patent and Trademark Office's ("PTO") Trademark Rules of Practice, 37 C.F.R. § 2.120(d), and Rule 34 of the Federal Rules of Civil Procedure ("FRCP"), Greater Louisville Convention and Visitors Bureau (hereinafter referred to as "Louisville", "Opposer", or "Plaintiff") hereby requests that The Wine Group LLC (hereinafter referred to as "Wine Group", "Applicant", or "Defendant"), produce the following documents and things at Galbreath Law Offices, P.C., 2516 Chestnut Woods Ct., Reisterstown, MD 21136 within thirty (30) days of service hereof in accordance with Rule 2.120(a) of the PTO's Trademark Rules of Practice and FRCP 34. Applicant is requested to supplement its responses from time to time as appropriate in accordance with FRCP 26(e).

DEFINITIONS

A. The terms "Wine Group", "Applicant", or "Defendant" shall refer to The Wine Group LLC, and any present or former owner, officer, director, employee, servant, agent, attorney or other representative acting on its behalf, and shall include any parent corporation, or wholly-owned or partially-owned subsidiary, predecessor, successor, or

affiliate either within the United States or a foreign country.

B. The term "Louisville", "Opposer", or "Plaintiff" shall refer to Greater Louisville Convention and Visitors Bureau, and any present or former owner, officer, director, employee, servant, agent, attorney or other representative acting on its behalf, and shall include any parent corporation, or wholly-owned or partially-owned subsidiary, predecessor, successor, or affiliate either within the United States or a foreign country.

C. The term "you" shall mean the party or person to whom the Production Request is propounded, all agents, employees, servants, attorneys, and all other representatives, and persons over whom the person or party to whom the Production Request is propounded has the right to or does control or direct any activities.

D. The term "document" shall mean any tangible thing upon which information is or has been stored, recorded, or communicated, and any written, printed, typed and visually or aurally reproduced material of any kind, whether or not privileged, such as (by way of example and not by way of limitation) correspondence including email and other electronic correspondence, letters, notes, memoranda, diaries, invoices, purchase orders, records, minutes, interoffice communications, bills, contracts, agreements, orders, receipts, price lists, studies, drawings or sketches, tapes or discs capable of being mechanically read, films, pictures, catalogs, photographs, electronic mail, advertising or promotional literature, operating manuals or instructional materials, voice recording, cables or telegrams, maps, charts, surveys, test data, HTML code, website pages and reports; every copy of every such writing or record where the original is not in the possession, custody or control of Applicant, and every copy of every such writing or record where such copy is not identical copy of the original or where such copy contains any commentary that does not appear on the original.

E. The term "thing" shall mean all tangible objects of any type, composition, construction or nature.

F. The term "communication(s)" includes the disclosure, transfer or exchange of information by any means, written, verbal, electronic or otherwise.

G. The term "person" shall include both natural persons and corporate or other business entities, whether or not in the employ of Applicant, and the acts and knowledge of a person are defined to include the acts and knowledge of that person's directors, officers, members, employees, representatives, agents and attorneys.

H. The term "trademark" or "mark" includes trademarks, service marks, collective marks, certification marks and trade names as defined in 15 U.S.C. §1127.

I. The term "concerning" means relating to, referring to, describing, evidencing or constituting.

J. A document or thing "relating or referring" or which "relates" to any given subject means any document or thing that comprises, constitutes, contains, embodies, reflects, identifies, states, refers to, deals with, or is in any way pertinent to that subject, including, without limitation, documents concerning the preparation of other documents.

K. The term "all" or "each" shall be construed to include all and each.

L. The term "and" shall be construed to include "or" and *vice versa*, and shall be the logical equivalent of "and/or," as necessary in order to bring within the scope of the request all responses which might otherwise be construed to be outside its scope.

M. The use of the singular form of any word also includes the plural and *vice versa*.

N. The phrases "use in commerce," "use in United States commerce," "used in

commerce" and "used in United States commerce", or similar phrases, shall mean and refer to the definition provided under 15 U.S.C. §1127.

O. The term "Applicant's Mark" shall mean the mark depicted in Application No. 85/736,374.

P. The term "Opposer's Mark" or "Opposer's Marks" shall mean the marks as alleged by Opposer in this opposition.

GENERAL INSTRUCTIONS

1. If you claim that any document requested is privileged, please provide all information falling within the scope of the Request for Production which is not privileged, and identify with sufficient particularity for purposes of a Motion to Compel each item, document or thing, separately, with respect to which you claim a privilege, and state:

- a. the basis on which the privilege is claimed;
- b. the author of the document, if applicable;
- c. each individual or other person to whom the document or copy thereof was sent or otherwise disclosed;
- d. the date of the document;
- e. the type of document (e.g., letter, memorandum, etc.); and;
- f. the general subject matter of the document.

You are not requested to provide privileged information or information for which you claim privilege, but only to identify such information, document or thing.

2. If any document which you would have produced in response to any Request was, but is no longer, in your present possession or subject to your control or is no longer

in existence, please state whether any such document is:

- a. missing or lost;
 - b. destroyed;
 - c. transferred to others; and
 - d. otherwise disposed of, and in such instance, set forth the surrounding circumstances and any authorization of such disposition and state the approximate date of any such disposition, and the present location and custodian of such document.
3. Applicant's responses to the following Requests for Production are to be promptly supplemented to include subsequently acquired information in accordance with the requirements of Rule 26(e) of the Federal Rules of Civil Procedure.

REQUEST FOR PRODUCTION NO. 1:

All documents and things identified in response to Opposer's Interrogatories.

REQUEST FOR PRODUCTION NO. 2:

All documents and things consulted in preparing responses to Opposer's Interrogatories.

REQUEST FOR PRODUCTION NO. 3:

All documents and things referring or relating to Applicant's selection, adoption, development, or creation of Applicant's Mark, including, but not limited to, invoices,

advertisements in any media, promotional materials in any media, brochures, catalogs, labels, tags, packaging, containers, point-of-sale displays, or websites, produced by or on behalf of Applicant.

REQUEST FOR PRODUCTION NO. 4:

All documents and things referring or relating to any variations of Applicant's Mark and/or the goods and/or services with which such variations were used or with which Applicant plans to use Applicant's Mark, including, but not limited to, invoices, advertisements in any media, promotional materials including email advertisements and promotions, catalogs, brochures, tags, labels, packaging, containers, point of sale displays, or websites, produced by or on behalf of Applicant.

REQUEST FOR PRODUCTION NO. 5:

All documents and things referring or relating to Applicant's current use in United States commerce of Applicant's Mark, including, but not limited to, invoices, advertisements in any media, promotional materials including email advertisements and promotions, catalogs, brochures, tags, labels, packaging, containers, point of sale displays, or websites, produced by or on behalf of Applicant.

REQUEST FOR PRODUCTION NO. 6:

All documents and things sufficient to identify each person who participated in the adoption, development, creation, or selection of Applicant's Mark, or any variation

thereof.

REQUEST FOR PRODUCTION NO. 7:

All documents and things sufficient to identify each mark considered by Applicant to be a variation of Applicant's Mark.

REQUEST FOR PRODUCTION NO. 8:

All documents and things referring or relating to Applicant's past use, current use, or plans for future use of Applicant's Mark in connection with all goods and/or services with which Applicant's Mark is used.

REQUEST FOR PRODUCTION NO. 9:

All documents and things concerning any search, business, legal or other opinions regarding any mark containing the design shown in Applicant's mark, or any variation thereof.

REQUEST FOR PRODUCTION NO. 10:

All documents and things concerning any inquiry or investigation made by or on behalf of Applicant with respect to any mark cited by any trademark search related to Applicant's Mark.

REQUEST FOR PRODUCTION NO. 11:

All documents and things concerning any opinion regarding Applicant's right to use Applicant's Mark.

REQUEST FOR PRODUCTION NO. 12:

All documents and things sufficient to identify all goods and/or services Applicant offers or intends to offer under Applicant's Mark, or any variation thereof, including:

- a) The nature and intended use of the products and/or services;
- b) The projected date and nature of the first use of Applicant's Mark, or any variation thereof, for each of the products and/or services;
- c) The projected date and nature of the first use of Applicant's Mark, or any variation thereof, in U.S. commerce;
- d) The present stage of development of each product and/or service;
- e) The steps that have been taken toward the exploitation of Applicant's Mark, or any variation thereof, in connection with each product and/or service; and
- f) Applicant's intent to use Applicant's Mark, or any variation thereof, in connection with each product and/or service.

REQUEST FOR PRODUCTION NO. 13:

All documents and things sufficient to identify the period or periods of use of Applicant's Mark, or any variation thereof, since the date of first use of Applicant's Mark.

REQUEST FOR PRODUCTION NO. 14:

Representative samples of invoices, purchase orders, sales reports, shipping orders, inventory reports, and other records concerning any sales or offerings of goods and/or services to any person or entity under Applicant's Mark, or any variation thereof.

REQUEST FOR PRODUCTION NO. 15:

All documents and things, including financial, accounting and corporate records concerning:

a) your total income from the sale or license of goods and/or services sold under Applicant's Mark annually by good or service per calendar year, from first use of Applicant's Mark for each such good or service to the present; and

b) your projected income from the sale or license of goods and/or services sold under Applicant's Mark annually by good or service per calendar year.

REQUEST FOR PRODUCTION NO. 16:

All documents and things, including financial, accounting and corporate records concerning:

a) the total amount spent on promoting and advertising Applicant's Mark; and

b) the projected total amount that will be spent on promoting and advertising Applicant's Mark.

REQUEST FOR PRODUCTION NO. 17:

All documents and things sufficient to establish the date of first use in commerce of Applicant's Mark, or any variation thereof, in connection with each good and/or service rendered under Applicant's Mark, or any variation thereof.

REQUEST FOR PRODUCTION NO. 18:

All documents and thing sufficient to show how Applicant uses or intends to use Applicant 's Mark, or any variation thereof, including, but not limited to, advertising and advertising mockups and proposals, promotional materials including emails and websites, catalogs, forms, letterhead, membership materials, purchase orders, press and/or media kits, point-of-purchase displays, and promotional goods.

REQUEST FOR PRODUCTION NO. 19:

All documents and things sufficient to identify each channel of trade or distribution through which Applicant markets or intends to market its goods and/or services under Applicant's Mark, or any variation thereof.

REQUEST FOR PRODUCTION NO. 20:

All documents and things sufficient to identify each type of media or publication through which Applicant advertises and promotes or intends to advertise and promote goods and/or services under Applicant's Mark, or any variation thereof.

REQUEST FOR PRODUCTION NO. 21:

All documents and things sufficient to identify each type of sponsorship through which Applicant advertises and promotes or intends to advertise and promote goods and/or services under Applicant's Mark, or any variation thereof.

REQUEST FOR PRODUCTION NO. 22:

All documents and things relating or referring to, or tending to show, the amount of money spent by any authorized user of Applicant's Mark for promotional activities or advertisements for Applicant's Mark.

REQUEST FOR PRODUCTION NO. 23:

All documents and things relating to, referring to or showing market research conducted by Applicant in connection with Applicant's Mark, including, but not limited to, surveys or statistics showing Applicant's target audience of consumers.

REQUEST FOR PRODUCTION NO. 24:

All documents and things concerning, relating or referring to Opposer or Opposer's Marks.

REQUEST FOR PRODUCTION NO. 25:

All documents and things concerning business plans, including, but not limited to, marketing plans, advertising plans and business forecasts, for Applicant's goods and/or services used in connection with Applicant's Mark.

REQUEST FOR PRODUCTION NO. 26:

All documents and things concerning any efforts to enforce the rights in Applicant's Mark against any third person(s) or third party(ies).

REQUEST FOR PRODUCTION NO. 27:

All documents and things relating or referring to or showing ownership of any claimed predecessor-in-title to Applicant's Mark.

REQUEST FOR PRODUCTION NO. 28:

All documents and things referring or relating to any attempts by Applicant to register Applicant's Mark, or any variation thereof, under the laws of any state or before the U.S. Patent and Trademark Office.

REQUEST FOR PRODUCTION NO. 29:

All documents and things that refer or relate to any plans by Applicant to expand use of Applicant's Mark, or any variation thereof, or sales or distribution of the goods and/or services, including, but not limited to, expansion of marketing lines, channels of

distribution, the number of products or services in connection with which Applicant's Mark is used, the customer base or geographical areas served.

REQUEST FOR PRODUCTION NO. 30:

All documents and things relating or referring to, or showing how Applicant's Mark has been and is being advertised or promoted since the date of its initial adoption to the present, including but not limited to, internal memorandums, brochures, flyers, newspaper articles, advertisements (both print and electronic versions), websites, billboards, pamphlets, magazine or trade journal articles, and radio or television advertisements.

REQUEST FOR PRODUCTION NO. 31:

All documents and things referring or relating to, or tending to show, any current or anticipated advertisements or promotions of goods and/or services in connection with Applicant's Mark, including but not limited to, internal memorandums, brochures, flyers, newspaper articles, advertisements (both print and electronic versions), websites, billboards, pamphlets, magazine or trade journal articles, and radio or television advertisements.

REQUEST FOR PRODUCTION NO. 32:

A sample of each product and/or service provided under Applicant's Mark since its initial adoption.

REQUEST FOR PRODUCTION NO. 33:

All documents and things sufficient to identify each trade and/or professional association through which Applicant promotes or intends to promote its goods and/or services under Applicant's Mark, or any variation thereof.

REQUEST FOR PRODUCTION NO. 34:

All documents and things referring or relating to any trade shows attended by, or proposed to be attended by, Applicant where goods and/or services provided under Applicant's Mark, or any variation thereof, were sold, advertised or promoted or are intended to be sold, advertised or promoted.

REQUEST FOR PRODUCTION NO. 35:

All documents and things sufficient to identify each class of persons, including, but not limited to, gender, age, ethnicity, and socioeconomic status, who purchase Applicant's goods and/or services under Applicant's Mark.

REQUEST FOR PRODUCTION NO. 36:

All documents sufficient to identify each public relations firm, advertising agency, and marketing firm that has been engaged to advertise or promote Applicant's Mark, or any variation thereof.

REQUEST FOR PRODUCTION NO. 37:

All communications between Applicant and any public relations firm, advertising agency, and marketing firm that has been engaged to advertise or promote Applicant's goods and/or services under Applicant's Mark.

REQUEST FOR PRODUCTION NO. 38:

Each press release issued by or on behalf of Applicant which refers to Applicant's Mark, or any variation thereof.

REQUEST FOR PRODUCTION NO. 39:

Each unsolicited press mention, article, release or other story relating to Applicant's Mark, or any variation thereof.

REQUEST FOR PRODUCTION NO. 40:

All advertisements in any magazine, newspaper or other printed publication, relating to Applicant's Mark, or any variation thereof.

REQUEST FOR PRODUCTION NO. 41:

All documents and things sufficient to identify each retail store or other channel by which Applicant 's goods and/or services under Applicant's Mark are provided.

REQUEST FOR PRODUCTION NO. 42:

All documents and things sufficient to identify the specific geographic area(s) within which Applicant has provided goods and/or services under Applicant's Mark, or any variation thereof, over the time period in which Applicant's Mark has been used.

REQUEST FOR PRODUCTION NO. 43:

All documents and things sufficient to identify the specific geographic areas within which Applicant has promoted goods and/or services under Applicant's Mark, or any variation thereof, over the time period in which Applicant's Mark have been used.

REQUEST FOR PRODUCTION NO. 44:

All documents and things concerning the marketing, advertisement, promotion and/or sale of Applicant's goods and/or services under Applicant's Mark, including, but not limited to, subscription lists, or other materials identifying actual or prospective clients and customers in the United States.

REQUEST FOR PRODUCTION NO. 45:

All documents sufficient to identify the approximate annual sales in both units and dollars of all goods and/or services offered in connection with Applicant's Mark, or any variation thereof, annually by calendar year, from Applicant's first use of Applicant's Mark until

present.

REQUEST FOR PRODUCTION NO. 46:

All documents and things relating or referring to any discontinuation of use of Applicant's Mark, or any variation thereof.

REQUEST FOR PRODUCTION NO. 47:

All documents and things concerning, referring, or relating to Applicant's first awareness of Opposer's Marks.

REQUEST FOR PRODUCTION NO. 48:

All documents and things which refer or relate to Opposer, Opposer's Marks, or to any good and/or service of Opposer, including but not limited to, Opposer's Goods and Opposer's Services.

REQUEST FOR PRODUCTION NO. 49:

All documents and things evidencing, referring or relating to third party use of Applicant's Mark, or any variation thereof, including, but not limited to, authorizations, assignments, licenses agreements, including but not limited to, manufacturing agreements, whether in draft form or executed.

REQUEST FOR PRODUCTION NO. 50:

All documents and things evidencing, referring or relating to the sale of each and every good and/or service in connection with Applicant's Mark by Applicant, or a related company or licensee.

REQUEST FOR PRODUCTION NO. 51:

Documents and things sufficient to identify the approximate dollar amount expended annually by calendar year in the United States by Applicant in advertising the goods and/or services provided under Applicant's Mark since initial adoption of Applicant's Mark to the present.

REQUEST FOR PRODUCTION NO. 52:

A copy of each market survey and other research documents, including, but not limited to surveys, polls, tests, focus group studies Applicant has conducted, has commissioned, or plans to conduct concerning:

- a) Applicant 's goods and/or services rendered under Applicant's Mark, or any variation thereof;
- b) Applicant's Mark, or any variation thereof, as perceived by purchasers and potential purchasers;
- c) confusion between Applicant's Mark, or any variation thereof, and the mark or name of any other entity; or

d) possible use in this opposition proceeding.

REQUEST FOR PRODUCTION NO. 53:

All unsolicited communications to Applicant that refer to Opposer's Marks, or any variation thereof.

REQUEST FOR PRODUCTION NO. 54:

All documents and things concerning any inquiry or investigation made by, or on behalf of, Applicant with respect to Opposer's Marks.

REQUEST FOR PRODUCTION NO. 55:

All documents and things which evidence, refer, or relate to any confusion, or the likelihood or possibility of confusion, between Applicant and Opposer, or between the goods and services offered, sold, or distributed by Opposer or Applicant, including, but not limited to consumer statements, misdirected mail and inquiries as to affiliation.

REQUEST FOR PRODUCTION NO. 56:

All documents and things concerning any complaint or statement by any person about the quality of Applicant's goods and/or services offered under Applicant's Mark.

REQUEST FOR PRODUCTION NO. 57:

All communications intended for Opposer that were received by Applicant.

REQUEST FOR PRODUCTION NO. 58:

All documents and things referring to, relating to, or tending to show a disclaimer made by Applicant as to an association with Opposer.

REQUEST FOR PRODUCTION NO. 59

All documents and things referring or relating to any adversarial proceeding, excluding the present proceeding, involving Applicant's Mark, or any variation thereof, before the Trademark Trial and Appeal Board in the United States Patent and Trademark Office, the United States Bureau of Customs, the United States Federal Trade Commission, or any other court or government agency in the United States.

REQUEST FOR PRODUCTION NO. 60:

All documents and things referring or relating to any objection raised, other than by Opposer, to Applicant 's use or registration of Applicant's Mark, or any variation thereof, by any third party.

REQUEST FOR PRODUCTION NO. 61:

All documents and things referring or relating to any objections made by Applicant to the use by another of mark(s) believed by Applicant to be confusingly similar to Applicant's

Mark, or any variation thereof.

REQUEST FOR PRODUCTION NO. 62:

All documents and things which support or tend to support Applicant's contentions and allegations in its Answer, Affirmative Defenses & Petition for Cancellation filed in this opposition, including but not limited to, all documents and things that support or tend to support each Affirmative Defense therein and each contention in any Counterclaim therein.

REQUEST FOR PRODUCTION NO. 63:

For each expert whose opinion Applicant may rely upon in this proceeding, each document concerning:

- a) any opinions that may be presented in the opposition;
- b) the reason for such opinions;
- c) any data or information considered by the witness in forming the opinions;
- d) any exhibits used in support of or summarizing the opinions; and
- e) the compensation being paid to the witness.

REQUEST FOR PRODUCTION NO. 64:

All documents and things bearing Applicant's Mark, or any variation thereof.

REQUEST FOR PRODUCTION NO. 65:

All documents and things referring or relating to Applicant's first knowledge of Opposer or Opposer's Marks.

REQUEST FOR PRODUCTION NO. 66:

All documents and things referring or relating to Applicant 's knowledge of any third party use of trade names, trademarks or service marks for or containing the design shown in Applicant's mark, or any variation thereof.



John A. Galbreath

Galbreath Law Offices, P.C.
2516 Chestnut Woods Ct.
Reisterstown, MD 21136-5523
TEL: 410-628-7770
FAX: 410-666-7274
EMAIL: jgalbreath@galbreath-law.com

Attorneys for Plaintiff/Opposer

EXHIBIT 4

EXHIBIT 4

**Greater Louisville Convention
and Visitors Bureau**

Opposer

v.

The Wine Group LLC

Applicant

) **IN THE UNITED STATES**
) **PATENT AND TRADEMARK OFFICE**
)
)
) **TRADEMARK TRIAL AND APPEAL BOARD**
)
)
) **APPL. NO. 85/736,374**
)
) **OPPOSITION NO. 91208855**
)

RESPONSES TO REQUESTS FOR ADMISSION

Greater Louisville Convention and Visitors Bureau (hereinafter referred to as "Louisville", "Opposer", or "Plaintiff"), by and through its attorneys identified below, hereby responds to The Wine Group LLC's ("Wine Group", "Applicant", or "Defendant") requests for admission, and states for each numbered paragraph in the requests:

1. Registration No. 3,932,986 is on the Supplemental Register.

Response: Admitted

2. The Amendment to Allege Use of the mark in Registration No. 4,178,113 was filed, on October 20, 2011.

Response: Admitted

3. The claimed date of first use of the mark in Registration No. 4,178,113 was October 20, 2011.

Response: Denied

4. Opposer is not licensed by the Alcohol and Tobacco Tax and Trade Bureau to make bourbon.

Response: Admitted

5. Opposer is not licensed by the Alcohol and Tobacco Tax and Trade Bureau to make any alcohol beverage.

Response: Admitted

6. Opposer is not licensed by the State of Kentucky to operate as a wholesaler of bourbon.

Response: Admitted

7. Opposer is not licensed by the State of Kentucky to operate as a wholesaler of any alcohol beverage.

Response: Admitted

8. Opposer is not licensed by the State of Kentucky to sell bourbon to consumers at retail.

Response: Admitted

9. Opposer is not licensed by the State of Kentucky to sell any alcohol beverages to consumers at retail.

Response: Admitted

10. Opposer has never licensed the mark in Registration No. 4,178,113 for use as a trademark for bourbon.

Response: Admitted

11. Opposer has never licensed the mark in Registration No. 3,932,986 for use as a trademark for bourbon.

Response: Admitted

12. Opposer has never licensed the mark in Application No. 85/406,324 for use as a trademark for bourbon.

Response: Admitted

13. Opposer is unaware of any Chamber of Commerce that makes bourbon.

Response: Denied

14. Opposer is unaware of any Chamber of Commerce that makes alcohol beverages.

Response: Denied

15. Opposer is unaware of any Chamber of Commerce that sells bourbon at wholesale.

Response: Admitted

16. Opposer is unaware of any Chamber of Commerce that sells alcohol beverages at wholesale.

Response: Admitted

17. Opposer is unaware of any Chamber of Commerce that sells bourbon to consumers at retail.

Response: Admitted

18. Opposer is unaware of any Chamber of Commerce that sells alcohol beverages to consumers at retail.

Response: Admitted

19. Registration No. 4,178,113 is not a certification mark.

Response: Admitted

20. Registration No. 3,932,986 is not a certification mark.

Response: Admitted

21. Application No. 85/406,324 is not for a certification mark.

Response: Admitted

22. Opposer has not used the mark B(URBAN).

Response: Admitted

23. The mark reflected in Registration No. 4,178,113 consists of two words.

Response: Admitted

24. The mark reflected in Registration No. 3,932,986 consists of three words.

Response: Admitted

25. The mark reflected in Application No. 85/406,324 consists of three words.

Response: Admitted

26. The term "BOURBON" is disclaimed in Registration No. 4,178,113.

Response: Admitted

27. The term "BOURBON" is disclaimed in Registration No. 3,932,986.

Response: Denied

28. The term "BOURBON" is disclaimed in Application No. 85/406,314.

Response: Denied

29. Opposer is not claiming that it has the exclusive right to use the term BOURBON in connection with Chamber of Commerce services in Class 35.

Response: Denied

30. Opposer is not claiming that it has the exclusive right to use the term BOURBON in connection with alcohol beverages in Class 33.

Response: Admitted

31. Opposer filed its Notice of Opposition on January 15, 2013.

Response: Admitted

32. Bourbon is made in geographic locations other than Kentucky.

Response: Admitted

33. There is no legal requirement that bourbon must originate in Kentucky.

Response: Admitted

34. As reflected in the Specimen filed in support of the application that became Registration No. 4,178,113, "Urban Bourbon" was the name of an exhibit at the Kentucky Derby Museum that was to run from March 4, 2012 - December 31, 2012.

Response: Admitted

35. Opposer was the applicant for the application that became Registration No. 3,932,986.

Response: Admitted

36. The Examining Attorney for the application that became Registration No. 3,932,986 claimed that there was a likelihood of confusion between the applied for mark

(URBAN BOURBAN EXPERIENCE) in Class 35 and a registration of URBAN BOURBAN for "alcoholic beverages, namely bourbons and bourbon-based beverages" in Class 33.

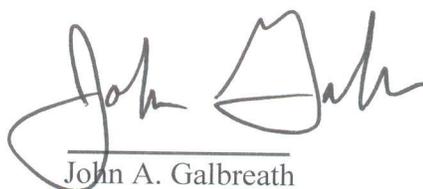
Response: Denied

37. During the prosecution of the application that became Registration No. 3,932,986, Opposer argued that there was no likelihood of confusion between the applied for mark (URBAN BOURBAN EXPERIENCE) in Class 35 and a registration of URBAN BOURBAN for "alcoholic beverages, namely bourbons and bourbon-based beverages" in Class 33.

Response: Denied

38. The attached document is a true and correct copy of the assignment of Registration No. 3,932,986 from Opposer to the Kentucky Distiller's Association.

Response: Admitted



John A. Galbreath

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Reisterstown, MD 21136-5523
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FAX: 410-666-7274
EMAIL: jgalbreath@galbreath-law.com

Attorneys for Plaintiff/Opposer

Certificate of Service: I certify that on the date below, these Responses to Requests for Admission and referenced attachments, if any, were deposited with the U.S. Postal Service as first class mail in an envelope addressed to:

PAUL W. REIDL
LAW OFFICE OF PAUL W. REIDL
241 EAGLE TRACE DRIVE, SECOND FLOOR
HALF MOON BAY, CA 94019

14 June 2013


John A. Galbreath

Greater Louisville Convention
and Visitors Bureau

Opposer

v.

The Wine Group LLC

Applicant

) IN THE UNITED STATES
) PATENT AND TRADEMARK OFFICE

)
) TRADEMARK TRIAL AND APPEAL BOARD

)
) APPL. NO. 85/736,374

)
) OPPOSITION NO. 91208855

VERIFICATION

The undersigned declares that:

I am an employee of Greater Louisville Convention and Visitors Bureau, and am authorized to make this verification on its behalf. I have read the foregoing Responses to Requests for Admission, and know the contents thereof. Under penalty of perjury, I declare that all statements made therein of my own knowledge are true and that all statements made on information and belief are believed to be true.

Greater Louisville Convention and Visitors Bureau

By:

James T Wood
Signature

6-13-13
Date

JAMES T WOOD
Printed Name

President of CED
Title

EXHIBIT 5

ESTTA Tracking number: **ESTTA516052**

Filing date: **01/15/2013**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Greater Louisville Convention & Visitors Bureau		
Entity	Independent commission	Citizenship	Kentucky
Address	401 W. Main St. Suite 2300 Louisville, KY 40202 UNITED STATES		

Attorney information	John A. Galbreath Galbreath Law Offices, P.C. 2516 Chestnut Woods Ct. Reisterstown, MD 21136 UNITED STATES jgalbreath@galbreath-law.com Phone:410-628-7770		
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Applicant Information

Application No	85736374	Publication date	12/25/2012
Opposition Filing Date	01/15/2013	Opposition Period Ends	01/24/2013
Applicant	THE WINE GROUP LLC 4596 S. TRACY BLVD. TRACY, CA 95377 UNITED STATES		

Goods/Services Affected by Opposition

Class 033. All goods and services in the class are opposed, namely: Bourbon

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	4178113	Application Date	07/07/2011
Registration Date	07/24/2012	Foreign Priority Date	NONE
Word Mark	URBAN BOURBON		

Design Mark	<h1>URBAN BOURBON</h1>		
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2011/10/20 First Use In Commerce: 2011/10/20 Chamber of commerce services, namely, promoting business and tourism in the Kentucky bourbon-producing area		

U.S. Application No.	85406324	Application Date	08/24/2011
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	URBAN BOURBON EXPERIENCE		
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Design Mark	<h1>Urban Bourbon Experience</h1>		
Description of Mark	NONE		
Goods/Services	Class 035. First use: Chamber of commerce services, namely, promoting business and tourism in the Kentucky bourbon-producing area		

U.S. Registration No.	3932986	Application Date	05/29/2009
Registration Date	03/15/2011	Foreign Priority Date	NONE

Word Mark	URBAN BOURBON TRAIL		
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Design Mark	URBAN BOURBON TRAIL
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 2008/05/30 First Use In Commerce: 2008/05/30 Chamber of commerce services, namely, promoting business and tourism in the bourbon-producing region of Kentucky

Attachments	85364988#TMSN.jpeg (1 page)(bytes) 85406324#TMSN.jpeg (1 page)(bytes) 77981154#TMSN.jpeg (1 page)(bytes) Louisville-Wine Group-(B)URBAN mark-Notice of Opposition.pdf (3 pages)(122691 bytes)
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Certificate of Service

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

Signature	/John A. Galbreath/
Name	John A. Galbreath
Date	01/15/2013

**Greater Louisville Convention
and Visitor's Bureau**

Plaintiff/Opposer

v.

The Wine Group LLC

Defendant/Applicant

) **IN THE UNITED STATES**
) **PATENT AND TRADEMARK OFFICE**
)
)
) **TRADEMARK TRIAL AND APPEAL BOARD**
)
)
) **APPL. NO. 85/736,374**
)
) **OPPOSITION NO. _____**
)

NOTICE OF OPPOSITION

Greater Louisville Convention and Visitor's Bureau ("Louisville" or "Opposer"), by and through its below-identified attorneys, hereby opposes The Wine Group LLC's ("Wine Group" or "Applicant") trademark application serial number 85/736,374, and states as follows:

1. On September 24, 2012, Applicant filed an application in the United States Trademark Office ("Office") to register the (B)URBAN mark for use in connection with bourbon.
2. Opposer owns United States Registration No. 4,178,113 for URBAN BOURBON and United States Application No. 85/406,324 for URBAN BOURBON EXPERIENCE, and is the exclusive, perpetual licensee of United States Registration No. 3,932,986 for URBAN BOURBON TRAIL (collectively, "Opposer's Marks"). The filing dates for Opposer's Marks all predate Applicant's September 24, 2012 filing date.
3. Opposer has used its marks in commerce since at least as early as May 30, 2008, in connection with at least the services identified in the above-referenced applications and registration: Chamber of commerce services, namely, promoting business and tourism in the bourbon-producing region of Kentucky.

4. Applicant's mark was filed on an intent-to-use basis, and presumably was not in use as of the September 24, 2012 filing date. Thus, Opposer's priority in its marks predates any priority which may be claimed by Applicant.

5. Applicant's mark is confusingly similar to Opposer's Marks and is likely, when used on or in connection with the goods identified in the Opposed Application, to cause confusion, to cause mistake, or to deceive, and Applicant's mark is thus unregistrable under § 2(d) of the United States Trademark Act, 15 U.S.C. § 1052(d).

6. The Office has assigned the pseudo mark (BOURBON)URBAN to the opposed application no. 85/736,374.

7. Applicant's goods are closely related to the services in Opposer's Marks. Indeed, Opposer's use of its registered and applied-for marks intimately involves bourbon, which are the goods shown in the Opposed Application. In addition, Opposer may offer for sale and sell bourbon goods under its URBAN BOURBON mark in the future.

8. Opposer will be damaged by Applicant's registration of the mark shown in the Opposed Application because registration would give Applicant *prima facie* evidence of its ownership of an exclusive right to use a mark that is confusingly similar to Opposer's Marks, which rights would interfere with Opposer's continued use of its marks.

WHEREFORE, Opposer requests that the Office deny Applicant's application for registration of the mark shown in Application No. 85/736,374, and grant such other and further relief and damages to Opposer that the Office deems proper.

Respectfully submitted,

/John A. Galbreath/

John A. Galbreath
Galbreath Law Offices
2516 Chestnut Woods Ct.
Reisterstown, MD 21136-5523
TEL: 410-628-7770
FAX: 410-666-7274
EMAIL: jgalbreath@galbreath-law.com

Attorneys for Opposer

Certificate of Service: I certify that on the date below, the foregoing Notice of Opposition and referenced attachments, if any, were sent by first-class mail to:

THE WINE GROUP LLC
4596 S. TRACY BLVD.
TRACY, CALIFORNIA 95377

15 January 2015

/John A. Galbreath/
John A. Galbreath

The USPTO will perform a database maintenance activity impacting the availability of Trademark Status and Document Retrieval (TSDR) system. TSDR will not be available during the database maintenance period beginning at 12:00 a.m. and ending at 1 a.m. on Sunday, July 14th.

STATUS

DOCUMENTS

[Back to Search](#)

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Mark: URBAN BOURBON

URBAN BOURBON

US Serial Number: 85364988

Application Filing Date: Jul. 07, 20

US Registration Number: 4178113

Registration Date: Jul. 24, 20

Filed as TEAS Plus: Yes

Currently TEAS Plus: Yes

Register: Principal

Mark Type: Service Mark

Status: Registered. The registration date is used to determine when post-registration maintenance docu

Status Date: Jul. 24, 2012

Publication Date: Jan. 31, 2012

Mark Information

Mark Literal Elements: URBAN BOURBON

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Disclaimer: "BOURBON"

Related Properties Information

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Chamber of commerce services, namely, promoting business and tourism in the Kentucky bour

International Class(es): 035 - Primary Class

U.S Class(es): 100, 101,

Class Status: ACTIVE

Basis: 1(a)

First Use: Oct. 20, 2011

Use in Commerce: Oct. 20, 2011

Basis Information (Case Level)

Current Owner(s) Information

Attorney/Correspondence Information

Prosecution History

TM Staff and Location Information

Assignment Abstract Of Title Information - Click to Load

Proceedings - Click to Load

PTO Form 1553 (Rev 9/2005)

OMB No. 0651-0054 (Exp. 09/30/2011)

Trademark/Service Mark Amendment to Allege Use (15 U.S.C. Section 1051(c))

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85364988
EXTENSION OF USE	NO
MARK SECTION	
MARK	URBAN BOURBON
OWNER SECTION	
NAME	Greater Louisville Convention & Visitors Bureau
STREET	401 W. Main St. Suite 2300
CITY	Louisville
STATE	Kentucky
ZIP/POSTAL CODE	40202
COUNTRY	United States
GOODS AND/OR SERVICES SECTION	
INTERNATIONAL CLASS	035
CURRENT IDENTIFICATION	Chamber of commerce services, namely, promoting business and tourism in the Kentucky bourbon-producing area
GOODS OR SERVICES	KEEP ALL LISTED
FIRST USE ANYWHERE DATE	10/20/2011
FIRST USE IN COMMERCE DATE	10/20/2011
SPECIMEN FILE NAME(S)	
ORIGINAL PDF FILE	SPN0-728113039-162432103_Louisville-Urban_Bourbon_Specimen.pdf
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT11\IMAGEOUT11\853\649\85364988\xml2\AAU0002.JPG
SPECIMEN DESCRIPTION	

	advertisement
REQUEST TO DIVIDE	NO
PAYMENT SECTION	
NUMBER OF CLASSES IN USE	1
SUBTOTAL AMOUNT [ALLEGATION OF USE FEE]	100
TOTAL AMOUNT	100
SIGNATURE SECTION	
DECLARATION SIGNATURE	/John A. Galbreath/
SIGNATORY'S NAME	John A. Galbreath
SIGNATORY'S POSITION	Attorney of record, MD bar member
DATE SIGNED	10/20/2011
FILING INFORMATION	
SUBMIT DATE	Thu Oct 20 16:29:17 EDT 2011
TEAS STAMP	USPTO/AAU-72.81.130.39-20 111020162917150404-853649 88-48076307241f8bf4257cbd 50ec91a758-CC-2941-201110 20162432103100

PTO Form 1553 (Rev 9/2005)

OMB No. 0651-0054 (Exp. 09/30/2011)

**Trademark/Service Mark Amendment to Allege Use
(15 U.S.C. Section 1051(c))**

To the Commissioner for Trademarks:

MARK: URBAN BOURBON
SERIAL NUMBER: 85364988

The applicant, Greater Louisville Convention & Visitors Bureau, having an address of
401 W. Main St. Suite 2300
Louisville, Kentucky 40202
United States

is submitting the following allegation of use information:

For International Class 035:

Current identification: Chamber of commerce services, namely, promoting business and tourism in the Kentucky bourbon-producing area

The mark is in use in commerce on or in connection with all goods or services listed in the application or Notice of Allowance or as subsequently modified for this specific class

The mark was first used by the applicant, or the applicant's related company, licensee, or predecessor in interest at least as early as 10/20/2011, and first used in commerce at least as early as 10/20/2011, and is now in use in such commerce. The applicant is submitting one specimen for the class showing the mark as used in commerce on or in connection with any item in the class, consisting of a(n) advertisement.

Original PDF file:

[SPN0-728113039-162432103 . Louisville-Urban Bourbon Specimen.pdf](#)

Converted PDF file(s) (1 page)

[Specimen File1](#)

The applicant is not filing a Request to Divide with this Allegation of Use form.

A fee payment in the amount of \$100 will be submitted with the form, representing payment for the allegation of use for 1 class.

Declaration

Applicant requests registration of the above-identified trademark/service 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. Section 1051 et seq., as amended). Applicant is the owner of the mark sought to be registered, and is using the mark in commerce on or in connection with the goods/services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce.

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. Section 1001, and that such willful false statements may jeopardize the validity of the form or any resulting registration, declares that he/she is properly authorized to execute this form on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered; 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.

Signature: /John A. Galbreath/ Date Signed: 10/20/2011

Signatory's Name: John A. Galbreath

Signatory's Position: Attorney of record, MD bar member

RAM Sale Number: 2941

RAM Accounting Date: 10/21/2011

Serial Number: 85364988

Internet Transmission Date: Thu Oct 20 16:29:17 EDT 2011

TEAS Stamp: USPTO/AAU-72.81.130.39-20111020162917150

404-85364988-48076307241f8bf4257cbd50ec9

1a758-CC-2941-20111020162432103100