

ESTTA Tracking number: **ESTTA720984**

Filing date: **01/16/2016**

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

Proceeding	91210542
Party	Plaintiff Tissot SA
Correspondence Address	JESS M COLLEN COLLEN IP THE HOLYOKE-MANHATTAN BUILDING, 80 SOUTH HIGHLAND AVENUE OSSINING, NY 10562 UNITED STATES lmcanrews@collenip.com, docket@collenip.com
Submission	Motion to Compel Discovery
Filer's Name	Jess M. Collen
Filer's e-mail	lmcanrews@collenip.com, docket@collenip.com
Signature	/Jess M. Collen/
Date	01/16/2016
Attachments	N1865_Motion to Compel_160116.pdf(1446977 bytes )

**UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

TISSOT S.A.,

Opposer,

v.

TOUCHDOME, LLC,

Applicant.

Opposition No.: 91210542

Serial No. 85643792

Mark: TOUCHDOME

**OPPOSER'S MOTION TO COMPEL**

Pursuant to 37 C.F.R. § 2.120(e) and Fed. R. Civ. P. 37, Opposer Tissot S.A.(hereafter, "Opposer") hereby respectfully moves the Board for an Order compelling Applicant to respond, without objection, to Opposer's First Set of Interrogatories and First Request for Production of Documents.

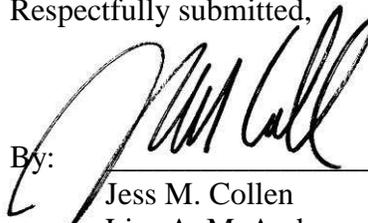
On March 4, 2014, Opposer served its first set of interrogatories and first request for production of documents on Applicant, by delivering same to Applicant's counsel via US Mail. A copy of Opposer's discovery requests and the certificate of service evidencing service are attached hereto as Exhibit 1. Applicant's original deadline to respond to these requests (due 30 days after service, plus five days for mailing) was April 8, 2014.

The Parties have been exploring settlement of this matter throughout its pendency and have periodically extended and/or suspended proceedings to continue to work out resolution. The close of discovery was on December 8, 2014. Since that date, the Parties have continued to discuss settlement, and accordingly, the proceedings have again been adjusted for these efforts to continue. Within these discussions, counsel for Opposer has regularly referenced Applicant's

outstanding discovery responses. However, as of the filing of this motion, Applicant has not responded to Opposer's discovery requests, and has made no indication that it has any intention to do so.

For the foregoing reasons, Opposer respectfully requests that the Board issue an Order compelling Applicant to respond, without objection,<sup>1</sup> to Opposer's First Set of Interrogatories and First Request for Production of Documents.

Respectfully submitted,

By: 

Jess M. Collen  
Lisa A. McAndrews  
COLLEN IP  
The Holyoke-Manhattan Building  
80 South Highland Avenue  
Ossining, New York 10562  
Tel.: (914) 941-5668  
Fax: (914) 941-6091  
jcollen@collenip.com  
lmcandrews@collenip.com  
*Attorneys for Opposer*

Dated: January 16, 2016

p:\N\N18\N1865\_Motion to CompeL\_160116.docx

---

<sup>1</sup> *DeNicola v. Frontline Asset Strategies*, 279 F.R.D. 214, 215 (E.D.N.Y. 2012) (“by its failure to timely respond, the defendant has waived all objections as to the interrogatories (see Fed. R. Civ. P. 33(b)(4)) and all objections to the document demands except those based on privilege”); *Amazon Techs., Inc. v. Wax*, 93 U.S.P.Q.2D 1702, 2009 TTAB LEXIS 712, \*6 (TTAB Nov. 4, 2009).

**CERTIFICATE OF FILING AND SERVICE**

I, Lisa A. McAndrews, hereby certify that I caused a true and correct copy of Opposer's Motion to Compel to be filed electronically with the Trademark Trial and Appeal Board, and to be served upon the Applicant and the following counsel of record, via first class mail, postage prepaid and email this 16<sup>th</sup> Day of January, 2016:

Martin B. Pavane, Esq.  
Lisa A. Ferrari, Esq.  
COZEN O'CONNOR  
277 Park Avenue  
New York, New York 10172



---

Lisa A. McAndrews

# EXHIBIT A

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

Tissot S.A.,

Opposer,

v.

Touchdome, LLC,

Applicant.

Opp. No. 91210542  
Serial No. 85643792

Mark: TOUCHDOME

**OPPOSER'S FIRST SET OF REQUESTS FOR THE PRODUCTION**  
**OF DOCUMENTS AND THINGS**

Opposer Tissot S.A. (hereafter, "Opposer") submits herewith for production by Applicant, Touchdome, LLC ("Applicant"), pursuant to Rule 34 of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice for the United States Patent and Trademark Office.

Opposer hereby requests that Applicant produce the following documents and tangible things to the attention and at the address of the Opposer's undersigned counsel's offices at Collen *IP*, THE HOLYOKE-MANHATTAN BUILDING, 80 South Highland Avenue, Ossining, New York, 10562 within thirty (30) days after service of these requests. This request shall be deemed continuing and requires production of any documents called for herein or any such documents which shall come within the custody or control of Applicant, or their agents or representatives at any time between Applicant's initial production and the further prosecution of this action.

*Please note the instructions and definitions included in the Opposer's First Set of Interrogatories, served contemporaneously herewith, which are incorporated by reference and made a part hereof, as if fully stated herein.*

**DOCUMENTS TO BE PRODUCED**

**REQUEST NO. 1:** All documents which refer to, relate to, or evidence Applicant's first use in interstate commerce of Applicant's Mark.

**REQUEST NO. 2:** All documents relating to any application ever filed in the United States for federal or state registration of Applicant's Mark.

**REQUEST NO. 3:** All documents that constitute, evidence, reflect, describe, refer to, or relate to the selection or creation of Applicant's Mark, or any reason why Applicant selected, adopted or applied to register this Mark.

**REQUEST NO. 4:** All documents evidencing, reflecting, or referring to the selection, availability, adoption, creation, design, use or proposed use of Applicant's Mark, including without limitation, any notes from any meetings or any telephone or video conferences at which such topics were discussed.

**REQUEST NO. 5:** Documents relating to the manufacturing or developing of products to be used with Applicant's Mark in the United States.

**REQUEST NO. 6:** All licenses, agreements, consents or other documents concerning third-party use of Applicant's Mark in the United States.

**REQUEST NO. 7:** All documents concerning third-party use of Applicant's Mark, whether authorized or unauthorized, in the United States.

**REQUEST NO. 8:** Representative documents evidencing each product with which the Applicant's Mark is used in the United States.

**REQUEST NO. 9:** Samples of products sold in the United States under the Applicant's Mark, with the mark clearly affixed in the ordinary manner in which the mark is affixed to goods for sale by others authorized by, or in conjunction with, Applicant, in the ordinary course of business.

**REQUEST NO. 10:** A sample of the complete packaging in which each product sold or distributed by Applicant in the United States under the Applicant's Mark is:

- a. shipped from Applicant to Applicant's customers;
- b. displayed at the point of sale to the ultimate users; and/or
- c. contained when sold or distributed to the ultimate users.

**REQUEST NO. 11:** Documents evidencing Applicant's yearly sales (in dollars) in the United States of Products bearing Applicant's Mark.

**REQUEST NO. 12:** Representative invoices evidencing the sale of each product on which Applicant's Mark is used, for each year since the date of first use of Applicant's Mark.

**REQUEST NO. 13:** Representative documents identifying the number of products bearing Applicant's Mark sold by Applicant in the United States.

**REQUEST NO. 14:** Representative documents identifying products bearing Applicant's Mark that are, or were, sold or advertised by Applicant in the United States.

**REQUEST NO. 15:** All documents identifying products Applicant plans to sell, market or develop in the United States under the Applicant's Mark in the future.

**REQUEST NO. 16:** Any tags or labels used by Applicant in connection with the sale of products under the Applicant's Mark in the United States.

**REQUEST NO. 17:** Samples of promotional and advertising materials used or sold by Applicant in the United States, on which Applicant's Mark (alone or in connection with other elements) is printed, embossed, stamped, or otherwise affixed, whether or not such materials have been published or used in commerce.

**REQUEST NO. 18:** A representative sample of documents relating to the advertising in the United States of any products sold by Applicant under Applicant's Mark, including invoices for advertising services, for each year Applicant's Mark has been used.

**REQUEST NO. 19:** A representative sample of documents relating to the promotion and marketing, including, but not limited to, point of sale and point of purchase materials, of any products sold by Applicant in the United States under Applicant's Mark, for each year the mark has been used.

**REQUEST NO. 20:** All documents identifying the channels of trade through which Products bearing Applicant's Mark are sold in the United States.

**REQUEST NO. 21:** All documents relating or referring to the targeted consumers for any Products bearing the Applicant's Mark.

**REQUEST NO. 22:** A listing of Applicant's distributors in the United States for Products sold under Applicant's Mark.

**REQUEST NO. 23:** A listing of all third parties licensed by Applicant to use Applicant's Mark in connection with the sale or marketing of Products in the United States.

**REQUEST NO. 24:** Samples of all marketing and promotional materials, including, without limitation, labels, tags, packaging, brochures, advertisements, pamphlets, manuals, product information sheets, and any other promotional merchandise or literature, on which Applicant's Marks have been printed, embossed, stamped, or otherwise affixed, whether or not such materials have been published or used in commerce.

**REQUEST NO. 25:** All documents in Applicant's possession or control that refer or relate to Opposer or to Opposer's Mark.

**REQUEST NO. 26:** All trademark searches, surveys, polls, consumer perception studies, focus group studies, market research studies, or other investigations, searches, studies, or reports that Applicant conducted, caused to be conducted, or obtained in connection with the selection of the Applicant's Mark.

**REQUEST NO. 27:** All trademark searches, surveys, polls, consumer perception studies, focus group studies, market research studies, or other investigations, searches, studies, or reports that include any reference to Opposer, Opposer's Mark, Applicant, or Applicant's Mark,

and all documents that refer or relate to any such search, survey, poll, study, investigation or report.

**REQUEST NO. 28:** All trademark searches, surveys, polls, consumer perception studies, focus group studies, market research studies, or other investigations, searches, studies, or reports that include any reference to Opposer's Mark, and all documents that refer or relate to any such search, survey, poll, study, investigation or report.

**REQUEST NO. 29:** All trademark searches, surveys, polls, consumer perception studies, focus group studies, market research studies, or other investigations, searches, studies, or reports that include any reference to Applicant, and all documents that refer or relate to any such search, survey, poll, study, investigation or report.

**REQUEST NO. 30:** All trademark searches, surveys, polls, consumer perception studies, focus group studies, market research studies, or other investigations, searches, studies, or reports that include any reference to Applicant's Mark, and all documents that refer or relate to any such search, survey, poll, study, investigation or report.

**REQUEST NO. 31:** All communications with any person other than Opposer concerning a dispute or potential dispute between Applicant and Opposer regarding trademark or trade dress ownership rights in the United States.

**REQUEST NO. 32:** All documents that constitute, evidence, reflect, describe, refer to, or relate to any investigation, trademark search, inquiry, survey, poll, consumer perception study, focus group study, market research study, or other search, survey, poll, study, or investigation that relates to any mark that includes or consists of the term TOUCHDOME.

**REQUEST NO. 33:** All documents that constitute, evidence, reflect, describe, refer to, or relate to any confusion expressed or experienced by any person between Applicant's Mark and Opposer's Mark, or between any product offered for sale under Applicant's Mark and any product offered for sale under Opposer's Mark.

**REQUEST NO. 34:** All documents identifying any domain names or websites owned or operated by Applicant that include Applicant's Mark, alone or in combination with other elements.

**REQUEST NO. 35:** All documents identifying any domain names or websites owned or operated by third parties through which products bearing Applicant's Mark are sold or marketed.

**REQUEST NO. 36:** All documents on which Applicant intends to rely on in this proceeding, including all documents that Applicant intends to offer in evidence in this proceeding.

**REQUEST NO. 37:** All documents identifying, referring to or relating to any person whom Applicant intends to call as a fact or expert witness in this proceeding.

**REQUEST NO. 38:** All documents Applicant has provided or shown to any person whom Applicant intends to call as a fact or expert witness in this proceeding.

**REQUEST NO. 39:** All documents relied upon, either in whole or in part, as a basis for any opinion rendered or to be rendered by an expert witness whom Applicant may call to testify in this proceeding.

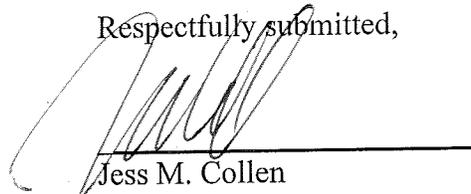
**REQUEST NO. 40:** All statements, affidavits, declarations, reports and communications Applicant has received from any person who is expected to give expert testimony as an expert witness on behalf of Applicant in this proceeding.

**REQUEST NO. 41:** All documents identified by Applicant in response to Opposer's First Set of Interrogatories served contemporaneously herewith.

**REQUEST NO. 42:** All documents that Applicant was required to identify, or from which Applicant obtained information, in responding to Opposer's First Set of Interrogatories, served simultaneously with this Request, and which documents have not been otherwise produced in response to these Requests.

**REQUEST NO. 43:** All documents that Applicant contends are relevant to this proceeding.

Respectfully submitted,



---

Jess M. Collen  
Lisa A. McAndrews  
Collen IP Intellectual Property Law  
The Holyoke-Manhattan Building  
80 South Highland Avenue  
Ossining, New York 10562  
(914) 941-5668 Tel.  
(914) 941-6091 Fax  
[jcollen@collenip.com](mailto:jcollen@collenip.com)  
[lmcaudrews@collenip.com](mailto:lmcaudrews@collenip.com)  
*Attorneys for Opposer*

Dated: March 4, 2014

**CERTIFICATE OF SERVICE**

I hereby certify that on March 4, 2014 the foregoing Opposer's First Set of Requests for the Production of Documents and Things are being served on Applicant via First Class Mail and Email at the following address:

Martin B. Pavane  
Lisa A. Ferrari  
COZEN O'CONNOR  
277 Park Avenue  
New York, New York 10172

*Attorneys for Applicant Touchdome LLC*



---

Lisa A. McAndrews

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

Tissot S.A.,

Opposer,

v.

Touchdome, LLC,

Applicant.

Opp. No. 91210542  
Serial No. 85643792

Mark: TOUCHDOME

**OPPOSER'S FIRST SET OF INTERROGATORIES**

Pursuant to Rule 33 of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice for the United States Patent and Trademark Office, Opposer Tissot S.A. (hereafter, "Opposer") hereby requests that Applicant Touchdome, LLC ("Applicant") respond under oath or by affirmation to the following Interrogatories. The Interrogatories shall be deemed continuing and Applicant is requested to serve upon Opposer, in the form of supplementary Answers, any additional information requested herein that may be known to Applicant after the date of its Answers to these Interrogatories.

**INSTRUCTIONS AND DEFINITIONS**

The following definitions and instructions are applicable to Opposer's First Set of Interrogatories and Opposer's First Request for the Production of Documents and Things:

A. "Opposer" means Tissot S.A., captioned above including its divisions, departments, subsidiaries, parents, partners, joint venture partners, officers, directors, owners, agents, employees, accountants, attorneys, any predecessor—or successor-in-interest thereof, and all other persons acting on behalf of or for the benefit of Tissot S.A..

B. "Applicant" or "you" shall mean the named Applicant, Touchdome, LLC, including its divisions, departments, subsidiaries, parents, partners, joint venture partners, officers, directors, owners, agents, employees, members, accountants, attorneys, any predecessor or successor in interest thereof, and all other persons acting on behalf of or for the benefit of Touchdome, LLC.

C. The term "Opposer's Mark" means U.S. Trademark Registration No. 3,653,565

D. The term "Applicant's Mark" means the trademark identified in United States Trademark Application No. 85/643,792.

E. The terms "Good," "Goods", "Products", and "Services" means the items marketed and distributed or intended to be marketed and distributed by Applicant and/or the Services provided.

F. The terms "data", "document" and "documents" means any writing of any kind, in any form or format, including all originals, copies, non-identical copies of all correspondence, papers, books, messages, publications, recordings, literature, letters, email communications, photographs, price lists, brochures, memoranda, notes, reports, drawings, diaries, graphic, aural, mechanical or electronic records, or any information that is stored electronically or otherwise and is capable of being retrieved, and any other writings whether in final or draft form and whether or not such draft was actually used or completed, or any "document" as otherwise described in Federal Rule of Civil Procedure 34 which is in your actual or constructive possession, custody or control.

G. "Person" means any individual, firm, corporation, partnership, proprietorship, cooperative, association, joint venture, organization, governmental body, group of natural persons, or any other entity.

H. The term "identify" or "specify" and "state the identity of" shall mean a complete identification to the full extent known or ascertainable by Applicant, whether or not in possession of Applicant, and whether or not alleged to be privileged, including the following information:

- 1) The present depository or depositories and the name and address of the person or persons having custody of any item to be identified unless the item is a patent, public document or person;
- 2) If the item to be identified is a person, his or her full name, address, job title, and present employers;
- 3) If the item to be identified is a document or paper, its character, title, date, addressee or recipient and author, signatory, or sender;
- 4) If the item to be identified is printed material, its title, author, publication date, volume and relevant page numbers;
- 5) If the identity sought is information about a situation or set of circumstances, all of the facts relating to or relevant to such a situation including the identity of persons with knowledge of such situation and the identity of all documents relating to, referring to, or otherwise pertinent to such a situation.
- 6) If the person to be identified is a corporation, or other legal entity, the laws under which it is organized, and the date of organization.

I. The term “mark(s)” means and includes trademarks, service marks, trade names, corporation names, and any other symbol or device used to identify the source, affiliation, or identity of any product, service or person.

J. The term “advertisement” means and includes all communications to third parties fixed in a tangible medium of expression and intended to promote or encourage the purchase or sale of goods or services in the United States.

K. The term “advertising” means and includes all advertisement and all other communications to third parties intended to promote or encourage the purchase or sale of goods or services in the United States.

L. The term “media outlet” is defined as any individual printed publication such as a newspaper or magazine; broadcast television or radio station; cable channel; or Internet website.

M. If in response to the following Interrogatories, Request for Production of Documents and Things and/or Requests for Admission, privilege is alleged as to information or materials, or if an Interrogatory, Document Request or Request for Admission is otherwise not answered in full, state the specific grounds for not answering in full, and answer said Interrogatory, Document Request or Request for Admission to the extent to which it is not objected, including the identification of all information or material for which privilege may be claimed.

N. All questions are to be read so as to give the question the broadest possible meaning, so that, for example, when either of the terms “and” or “or” is used, it is to be construed as “and/or”. Similarly use of the singular also includes the plural, use of any female pronouns also includes the male, and so forth.

O. Unless otherwise noted, the terms “sell,” “license,” “advertise,” “market,” and “promote” are to be interpreted as encompassing both the present act and the future intended act (e.g., “sell” shall also mean “intend to sell”).

P. Unless otherwise noted, the geographic scope of these discovery requests is limited to the United States.

### **INTERROGATORIES**

**INTERROGATORY 1.** Indicate the name and business address of each place of business which Applicant presently maintains in connection with trademark usage or trademark licensing in the United States, and describe the type of business activities in each place of business.

**INTERROGATORY 2.** Identify and describe each Product sold under the Applicant’s Mark.

**INTERROGATORY 3.** Identify the date that Applicant first used Applicant’s Mark in commerce in the United States.

**INTERROGATORY 4.** Identify three individuals most knowledgeable about the nature of the Applicant’s business including the advertising, marketing, manufacturing, sales and/or licensing of Products bearing Applicant’s Mark.

**INTERROGATORY 5.** For each Product identified by Applicant in response to Interrogatory No. 2 as being sold under Applicant’s Mark, set forth the amount of sales in dollars in the United States since the date of first use, broken down on a yearly basis.

**INTERROGATORY 6.** Identify the total amount of marketing and/or advertising expenditures for Products bearing Applicant’s Mark in the United States incurred by Applicant.

**INTERROGATORY 7.** Describe in detail the reasons for the selection, adoption or creation of Applicant's Mark, including any connotations or meanings underlying or intended to be conveyed by Applicant's Mark.

**INTERROGATORY 8.** Describe in detail the channels of trade through which Applicant's Products under the Applicant's Mark are sold.

**INTERROGATORY 9.** Identify all third party uses, through license agreements or otherwise, of Applicant's Mark in the United States of which Applicant is aware, including but not limited to uses of Applicant's Mark in the singular, plural, or uses in combination with other words, phrases or designs.

**INTERROGATORY 10.** Identify any assignment, license, royalty or other permitted use agreements with respect to any Products bearing Applicant's Mark.

**INTERROGATORY 11.** Identify the target market and target consumers to whom products bearing Applicant's Mark are sold.

**INTERROGATORY 12.** Indicate the price range for each product Applicant sells under Applicant's Mark.

**INTERROGATORY 13.** Identify the specific media outlets through which Applicant advertises products bearing Applicant's Mark in the United States.

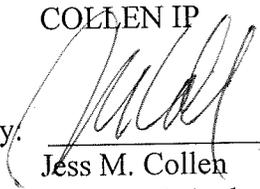
**INTERROGATORY 14.** Identify any websites through which Applicant currently advertises or sells products bearing Applicant's Mark.

**INTERROGATORY 15.** Identify any and all other trademarks - other than Applicant's Mark - under which Applicant sells or has offered for sale the products identified in the application which is the subject of this Opposition proceeding.

**INTERROGATORY 16.** Identify and describe each product that is used for promotional purposes under the Applicant's Mark.

**INTERROGATORY 17.** Identify, as precisely as you can, the date on which Applicant first became aware of Opposer's Mark, and describe how Applicant first became aware of it.

**INTERROGATORY 18.** Identify all persons who have participated in any way in the preparation of the answer or responses to these Interrogatories. If more than one individual is identified, state specifically, with reference to Interrogatory numbers, the areas of participation of each such person.

COLLEN IP  
By:   
\_\_\_\_\_  
Jess M. Colleen  
Lisa A. McAndrews  
COLLEN IP  
The Holyoke-Manhattan Building  
80 South Highland Avenue  
Town of Ossining, Westchester County  
NEW YORK 10562  
(914) 941- 5668  
*Attorneys for Opposer*

Dated: March 4, 2014

**CERTIFICATE OF SERVICE**

I, Lisa A. McAndrews, hereby certify that I caused a true and correct copy of Opposer's First Set of Interrogatories to be served upon:

Martin B. Pavane  
Lisa A. Ferrari  
COZEN O'CONNOR  
277 Park Avenue  
New York, New York 10172

*Attorneys for Applicant Touchdome LLC*

via first class mail, postage prepaid and email.

Said service having taken place this 4<sup>th</sup> day of March, 2014

A handwritten signature in black ink, appearing to read "Lisa A. McAndrews", is written over a horizontal line.