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

Proceeding	91210813
Party	Plaintiff SATA GmbH & Co. KG
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Attachments	Opposer's Reply Brief in Support of Its Motion to Compel.pdf(294406 bytes )



documents, until after Opposer filed its Motion. Secondly, Applicant elected to defer serving that “supplementation” and those documents until June 25, 2014, the day before the close of discovery. Thirdly, as discussed below, Applicant’s belated “supplementation” and document production does not resolve the issues raised in Opposer’s Motion to Compel and Applicant has never seen fit to tender any supplementation of any of its document request Responses, in spite of the nearly nine-month lapse since Opposer’s first related correspondence to Applicant.

Applicant’s repeated references to the parties’ efforts, and ultimately their ability, to resolve disputes regarding expert-related discovery are illusory, misplaced and but further examples of its unwillingness to respond to Opposer’s non expert-related discovery. Applicant (at p. 3) appears to chastise Opposer for having filed this Motion to Compel in the face of Applicant’s having acknowledged and attempted to remedy its deficiencies with respect to expert-related discovery. Those efforts are irrelevant to Opposer’s Motion to Compel in that the Motion to Compel is in no way related to any expert-related discovery. The parties, as part of their meet and confer by correspondence, were able to resolve expert-related discovery issues. The parties, through their meet and confer by correspondence, were not able to resolve the other long standing issues regarding Applicant’s discovery shortcomings. Those issues logically, and properly, form the basis for Opposer’s Motion to Compel. Applicant’s election to continue its practice of ignoring, for well over half a year, Opposer’s repeated concerns with respect to Applicant’s discovery responses in no way immunized Applicant from having those deficiencies brought to the Board’s attention through a Motion to Compel. To the contrary, Applicant’s inaction with respect to each of the items discussed in Opposer’s Motion to Compel rendered the filing of that Motion necessary, proper and timely.

Applicant's contention that it was awaiting a phone conversation to discuss these discovery issues rings hollow. On May 8, when a phone conversation was still contemplated, Applicant's counsel received, as it requested, another listing of Opposer's discovery complaints, having asserted that it was believed that many of those complaints could be addressed and resolved prior to a phone call. In fact, these long outstanding issues were again brought to Applicant's attention but, with the exception of expert discovery-related issues, were not resolved, or even addressed by Applicant, despite Opposer's repeated urgings. (See related items of correspondence submitted collectively as Ex. 3 to Vande Sande Dec. offered in support of Opposer's Motion to Compel).

With no progress having been made in connection with discovery deficiencies first raised in October 2013, with the futility of a phone conference abundantly apparent, and with the close of discovery quickly approaching, Opposer can hardly be chastised for seeing the meet and confer process as being at its end and filing its Motion to Compel on June 17th. Also telling is the fact that Applicant itself threatened to file, and ultimately in fact did file (albeit untimely), its own Motion to Compel without any longer seeking or suggesting a phone conference. Finally, Applicant's insistence that the discovery responses and document production efforts it has made to date are sufficient underscores the impasse reached by the parties and thus the timeliness and necessity of Opposer's filing its Motion to Compel.

In sum, the parties attempted to resolve outstanding disputes by correspondence. Ultimately, those efforts were not successful.

**II. APPLICANT HAS FAILED TO ADDRESS OR REMEDY ITS NUMEROUS DISCOVERY DEFICIENCIES.**

**A. Interrogatory 1 And Related Document Production Request 1 Deficiencies Have Not Been Cured.**

Applicant has yet to provide any details concerning the selection of the EURO and Design mark in dispute. Its proclamation that the “mark and design” were selected spontaneously evades the thrust of Interrogatory 1 by omitting mention of a single related detail such as when the mark and design were spontaneously selected and under what circumstances this spontaneous selection occurred. Applicant’s Supplemental Answer, merely stating that it has no related documents, does not respond to the Interrogatory.<sup>1</sup>

In addition, Applicant has never proffered any supplementation of its written Responses to any of Opposer’s production Requests. Consequently, Applicant’s only written Responses to Opposer’s production Requests, including Request No. 1, state that Applicant has produced or will produce relevant non-privileged documents. (See Applicant’s response to Opposer’s Requests for Production, attached as Ex. 2 to Vande Sande Dec. in support of Opp. Motion to Compel).<sup>2</sup> Moreover, while Applicant asserts that it “selected EURO name and design spontaneously”, it is silent with respect to that portion of document Request 1 that calls for documents containing or reflecting information bearing upon its adoption of the EURO and design mark. Obviously, that portion of Opposer’s request cannot simply be ignored, and Applicant’s adoption of the mark did not occur spontaneously. There must be, for instance, documentation which flowed between

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<sup>1</sup> Applicant’s June 25, 2014 supplementation of interrogatory answers, served subsequent to the filing and service of Opposer’s Motion to Compel, may be found as Ex. B to the Declaration of Applicant’s counsel which accompanied Applicant’s Response to Opposer’s Motion to Compel.

<sup>2</sup> Applicant must be ordered to supplement each of its Responses to Opposer’s Document Requests in order to, at a minimum, remove the inconsistencies that permeate its document production Responses on the one hand and its interrogatory Answers and supplemental interrogatory Answers on the other.

Applicant and the manufacturer of its involved goods, packaging and advertising producers, websites designers, etc. relating to Applicant's adoption of the mark, yet Applicant has not even responded to this portion of Opposer's document Request.

**B. Applicant's Supplemental Answer To Interrogatory No. 5 Is Inadequate.**

In response to this interrogatory, which inquires as to the identification of the types and classes of purchasers of the goods offered by Applicant under the mark *sub judice*, Applicant's Supplemental Answer merely recites a run of documents in excess of 100 pages. Merely pointing Opposer to a stack of documents in lieu of identifying the types and classes of purchasers as requested through this interrogatory is inadequate. Opposer is entitled to receive from Applicant its characterization of the types and classes of involved purchasers. Applicant's attempt to force Opposer to make that characterization based upon Applicant's pointing Opposer to a stack of documents is simply not responsive to the inquiry posed through Interrogatory 5. In addition, Applicant has provided no supplementation of its Responses to related production Requests 13, 22 and 24. Nor has Applicant attempted to identify or correlate any documents it has produced with any of Opposer's specific document production Requests. Applicant must be required to provide a meaningful answer to Interrogatory 5, supplementations of its written Responses to production Requests 13, 22 and 24, and the specific identification of those documents, if any, which it has produced in response to each of those specific Production Requests.

**C. Applicant Has Failed To Supplement Its Inadequate Answer To Interrogatory 8.**

Applicant has offered no supplementation of its original answer to this interrogatory which requests specific details relating to "When and under what circumstances Applicant first learned of Opposer". Applicant's cursory response that "It learned of the Opposer through trade shows and

industry news” is totally lacking in any detail with respect to dates, specific trade shows, or particular organs of industry news. This information is highly relevant to several issues involved in this proceeding, including the debunking of Applicant’s contention that it and Opposer are not even competitors. (See ¶ 4 of App.’s Ans. To Opp. Not. of Opp. See also App. Ans. To Int. 16 found in Vande Sande Dec. Ex. 1 at p. 5). The arguments and attempted explanations offered through counsel in a Response brief, such as those found at p. 7 of Applicant’s Response brief, are in no way timely or adequate substitutes for the sworn interrogatory answers to which Opposer is entitled.<sup>3</sup>

**D. Applicant Has Not, Through Either Its Original Nor Supplemental Answers, Adequately Responded To Interrogatory 9 Nor Related Document Requests 11 And 17.**

In response to Opposer’s request for details relating to Applicant’s first use of the involved mark and its alleged date of first use in commerce, Applicant has supplemented its original inadequate answer with a supplemental inadequate answer which merely refers Opposer back to the alleged date of first use in Applicant’s Statement of Use. Applicant then, through its supplemental interrogatory answer, refers Opposer to a range of in excess of 100 pages of documentation without further discussion or detail. This cursory answer deprives Opposer of information clearly relevant to this proceeding. Additionally, Applicant has proffered absolutely no supplementation of its written Responses to related production Requests 11 and 17.

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<sup>3</sup> Applicant has yet to provide Opposer with Applicant’s original interrogatory Answers as executed by Applicant. Instead, those Answers were executed by Applicant’s counsel. (See Vande Sande Dec. Ex. 1). Opposer’s subsequent related correspondence to Applicant’s current counsel (Vande Sande Dec. Ex. 3) requesting interrogatory answers as signed by Applicant resulted in Opposer being provided with only an additional copy of Applicant’s execution of its original (and only) Responses to Opposer’s production requests. Opposer asks that the Board remind Applicant of its obligation to provide interrogatory answers as executed by the party and not its counsel.

**E. Applicant Has Offered No Supplementation Of Its Inadequate Answer To Interrogatory No. 19.**

The inadequacy of Applicant's answer to Interrogatory 19 was discussed in Opposer's opening brief. Applicant's recent and belated supplementation of interrogatory answers offers no supplementation of its earlier inadequate answer. In addition, Applicant has, through its Response brief, and its interrogatory answer, completely ignored part (a) of this interrogatory.

**F. Having Made No Attempt to Supplement Its Responses To Opposer's Production Requests, Applicant's Responses To Document Requests 2, 9, 12, 19 and 21 Remain Deficient.**

As Applicant has provided no supplementation of its Responses to Production Requests 2, 9, 12, 19 or 21, (or for that matter, any other Response) its Responses remain deficient under Rule 34, as discussed in Opposer's opening brief.<sup>4</sup> Moreover, to the extent that Applicant contends that any documentation that it produced in the course of this proceeding is responsive to these (or any other of) Opposer's production Requests, Applicant must be ordered to specify in the course of supplementing its written Responses to Opposer's production Requests, which documents are allegedly responsive to which particular Requests.

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<sup>4</sup> Applicant's contention, set forth for the first time in its Response brief, that information concerning its advertising (sought through Document Request 19) is not relevant because Opposer has noted that its own advertising is not relevant to the issues involved in this dispute, is misplaced. The fundamental issue to be decided is the geographical misdescriptiveness of Applicant's mark as such is used in connection with Applicant's goods. Applicant's contention that "a primary significance of its EURO mark and design is its identification of Applicant's products that are identified by that mark" (App. Supp. Resp. to Int. 19, App. Ex. B) is representative of the position advanced by Applicant which renders details concerning the nature and extent of its advertising relevant, as such sheds light on the extent to which potential purchasers may (or may not) be conditioned to see EURO as referring to Applicant's goods. On the other hand, no such argument can be asserted with respect to Opposer's advertising, as Opposer's mark is not in issue. Moreover, Applicant has already acknowledged Opposer's status as a recognized industry leader in the U.S. (App. Supp. Resp. to Expert Int. 7, submitted by App. as part of Ex. I of the Dec. of its counsel.)

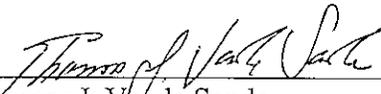
**III. CONCLUSION**

For the reasons set forth herein and more fully discussed in Opposer's opening brief, Opposer's Motion to Compel should be granted in its entirety.

Respectfully submitted,

HALL & VANDE SANDE, LLC

Date: 7/16/14

  
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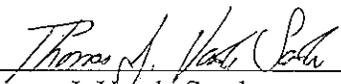
CERTIFICATE OF SERVICE

The undersigned, Thomas J. Vande Sande, attorney for Opposer, hereby certifies that one (1) copy of the foregoing "OPPOSER'S REPLY BRIEF IN SUPPORT OF ITS MOTION TO COMPEL" was this day served on Applicant by mailing same, first class mail, to:

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HALL & VANDE SANDE, LLC

Date: 7/16/14

  
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