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

Proceeding	91211530
Party	Defendant William T. Odonnell DBA Odonnell Entertainment
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Attachments	OPPOSITION TO MOTION TO COMPEL .pdf(175414 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
The Trademark Trial and Appeal Board**

Serial No. 85/785,996
For the mark ADVENTURES OF SHADOW,

Registration No. 3,991,181
For the mark ADVENTURES OF SHADOW,

J-Lynn Entertainment, LLC,	:	
	:	
Opposer,	:	
	:	
vs.	:	Opposition No. 91211530 (Parent)
	:	Cancellation No. 92056491 (Child)
William T. Odonnell, d/b/aOdonnell Entertainment,	:	
	:	
Applicant.	:	

**OPPOSITION TO MOTION TO COMPEL AND
MOTION TO EXTEND OR RE-OPEN OPPOSER’S DISCOVERY PERIOD**

COMES NOW the Applicant, William T. Odonnell, d/b/a Odonnell Entertainment, (hereinafter “Applicant”), by and through counsel, The Trademark Company, PLLC, and files the instant Opposition to the Motion to Compel and Motion to Extend or Re-Open Opposer’s Discovery Period, as filed by Opposer stating as follows:

STATEMENT OF THE CASE

1. On or about July 12, 2013 Opposer filed a Notice of Opposition against Applicant’s Federal Trademark Application Serial No. 85/785,996 for the mark ADVENTURES OF SHADOW.

2. On or about July 23, 2013 Applicant filed its Answer and Ground of Defense to Opposer’s Notice of Opposition in addition to a Motion to Consolidate Opposition Proceeding No. 91211530 and Cancellation Proceeding 92056491.

3. On or about June 18, 2013 Opposer served its First Set of Written Document Requests upon Applicant in Cancellation Proceeding No. 92056491.

4. On or about July 23, 2013 Applicant served its Responses to Opposer’s First Set of Written Discovery Requests on Opposer.

5. On or about July 30, 2013 Opposer served its Second Set of Written Discovery Requests on Applicant.
6. On or about August 1, 2013 the parties began engaging in settlement negotiations of which continued through January 28, 2014.
7. On or about September 10, 2013 Opposer consented to a 30-day extension of Applicant's deadline to serve its responses to Opposer's Second Set of Written Discovery Requests.
8. On or about September 26, 2013 the Board granted Applicant's Motion to Consolidate and consolidated the aforementioned proceedings under Opposition No. 91211530.
9. On or about April 18, 2014 Applicant served its First Set of Discovery Requests, namely: Requests for Production of Documents, Requests for Admissions and Requests for Interrogatories to Opposer.
10. On or about April 18, 2014 the Discovery Period closed in the instant proceeding.
11. On or about May 8, 2014 Opposer filed a Motion to Strike Applicant's Requests for Admissions.
12. On or about May 12, 2014 Opposer served its Responses to Applicant's Requests for Production of Documents, Requests for Admissions and Requests for Interrogatories to Applicant.
13. On or about May 12, 2014 Opposer filed its Responses to Applicant's Requests for Admissions with the Board.
14. On or about May 13, 2014 Opposer filed a copy of Applicant's Requests for Admissions with the Board.
15. Opposer filed the instant Motion to Compel Discovery and Motion to Extend Opposer's Discovery Period on May 12, 2014, prior to making any good faith efforts to cure this discovery issue with Counsel for Applicant.
16. On or about May 27, 2014 Applicant filed an Opposition to Opposer's Motion to Strike Applicant's Requests for Admissions.

17. Applicant now timely files the instant opposition to Opposer's Motion to Compel and Motion to Extend Opposer's Discovery Period.

**ARGUMENT IN SUPPORT OF APPLICANT'S OPPOSITION TO OPPOSER'S
MOTION TO EXTEND OPPOSER'S DISCOVERY PERIOD**

It is well established that proceedings may be suspended or extended for good cause as defined in Trademark Rule 2.11(c). In response to Opposer's Motion to Extend its Discovery Period by fifteen (15) days, Applicant notes that Discovery closed in this matter on April 18, 2014. As such, Opposer's Motion to Extend was filed untimely on May 12, 2014 and as such, it must be treated as a motion to reopen since it was filed after the close of the discovery period. See Fed. R. Civ. P. 6(b).

As the basis for filing its Motion to Re-Open its Discovery Period, Opposer argues it needs additional time to serve requests for production of documents on Applicant and more time to authenticate the documents Applicant produced to Opposer on or about July 23, 2013. Pursuant to Fed. R. Civ. P. 6(b), a motion for enlargement of time filed after the expiration of the previously specified time period requires a showing by the moving party that its failure to act during the time allowed therefor was the result of excusable neglect. In considering a Motion to Re-Open Discovery, the Board has relied upon the factors of excusable neglect established by the Supreme Court in the Pioneer Investment Services Co., 507 U.S. 308, 395 (1993) case, namely:

“At the bottom and equitable one, taking account of all relevant circumstances surrounding the party's omission. These include... [1] the danger of prejudice to the [non-moving party], [2] the length of the delay and its potential impact on judicial proceedings, [3] the reason for the delay, including whether it was within the reasonable control of the movant, and [4] whether the movant acted in good faith.”

In undertaking the Pioneer analysis, several courts have stated that the third Pioneer factor, namely, the reason for the delay and whether it was within the reasonable control of the movant, might be considered the most important of the Pioneer factors in a particular case. With respect to the third Pioneer

Factor, Opposer does not specify in its Motion any factors outside its control that would explain why opposer failed to serve any supplemental requests for production of documents during the discovery period. Moreover, Opposer does not specify in its Motion any factors outside its control that would explain why Opposer did not authenticate the documents produced by Applicant on July 23, 2014 in response to Opposer's First Set of Written Discovery Requests during the discovery period. Opposer has not established excusable neglect which would support the reopening of discovery. See Fed. R. Civ. P. 6(b); Pumpkin Ltd. v. The Seed Corps, 43 USPQ2d 1582 (TTAB 1997).

Moreover, Opposer's Motion to Re-Open its Discovery Period should be deemed moot as Applicant provided its full and complete responses to Opposer's First Set of Written Discovery Requests on July 23, 2013 and has provided its full and complete responses to Opposer's Second Set of Written Discovery Requests below.

**ARGUMENT IN SUPPORT OF APPLICANT'S OPPOSITION TO OPPOSER'S
MOTION TO COMPEL AND RESPONSES AND OBJECTIONS TO OPPOSER'S SECOND SET
OF WRITTEN DISCOVERY REQUESTS**

In response to Opposer's Motion to Compel Discovery, Applicant notes that Opposer failed to satisfy its obligation to make good faith efforts to resolve the discovery issues in this proceeding subject of its motion pursuant to 37 CFR § 2.120(e) with Counsel for Applicant prior to filing its Motion to Compel on May 12, 2014. See Amazon Technologies, Inc. v. Jeffrey S. Wax, 93 USPQ2d 1702, 1705 (TTAB 2009). Moreover, Opposer failed to provide evidence of its good faith efforts in its filed Motion to Compel.

Furthermore, Applicant provided its full and complete Responses and Objections to Opposer's First Set of Written Discovery on or about July 23, 2013 and now provides its full and complete Responses and Objections to Opposer's Second Set of Written Discovery herein below. In light of the foregoing, it is respectfully submitted that the Opposer's Motion to Compel is moot as to the assertions therein.

RESPONSES AND OBJECTIONS

In response to the specifically enumerated second set of written discovery requests subject of the Opposer's instant Motion to Compel, Applicant States as follows:

Request 1: Requests of the actual original physical water bottles that have the original physical "Limited Edition 2008" label on them. Not an exported jpeg image that could have been modified at anytime or new bottles produced after the cancellation proceeding has been filed or when the first request for a Written Discovery was sent.

Response: Applicant has produced all responsive documents and information in its control at this time in response to this request.

Request 2: Request for names, contact information, and addresses of all the organizations or individuals that own property where the flyers from page 176 from the first Written Discovery were posted or advertised, and indication relationship to the registrant, for example; indication if these individuals are relatives or family friends of the registrant.

Response: Applicant objects to the instant request on the grounds that it is overly broad and burdensome as to time and scope. Subject to said objection, Applicant does not retain specific records indicating where this flyer was posted or distributed. Applicant has produced all responsive documents and information in its control at this time.

Request 3: Request for names, addresses, and contact information on the manufacturer and merchant for the shirt the registrant is wearing in the picture of him in front of the light house. This is the top picture on page 234 of the first Written Discovery.

Response: Applicant has produced all responsive documents and information in its control at this time.

Request 4: Request for names, addresses, and contact information on the manufacturer and merchant for the black shirt with a generic dog picture and the worlds “Shadow” the registrant is wearing in the pictures posted on his “Adventures of Shadow” Facebook page that were posted on July 24th 2013.

Response: Applicant has produced all responsive documents and information in its control at this time.

Request 5: Request for names, addresses, and contact information on the manufacturer and merchant for the white shirt with generic dog picture the registrant is wearing in the pictures posted on his “Adventures of Shadow” Facebook page that were posted on July 30th 2013.

Response: Applicant has produced all responsive documents and information in its control at this time.

Request 6: Request for a list of all the names and contact information of individuals, websites, publishers, and companies that the registrant contacted or harassed claiming they were stealing his trademark and/or gave legal threats to. This request also includes copies of all the email communication to these entities and posts on their sites to these entities. This request also includes the dates of any phone calls or voice mails left to these entities. This request also includes a list of the grounds and products of the registrant that he claimed they were damaging. The registrant included some email's in the initial discovery material, but on the email he to sent me on 10/3/2012 or page 177 seemed to indicate there was more people. One particular individual was a Christian author the registrant claimed was using the reverse of his trademark called "Shadow Adventure Series" which the registrant scared them into changing the name and reprinting all their covers and pages. It is not clear if Mavis Duke Hinton on page 35 is the author the registrant is referring to in the email.

Response: Applicant objects to this request on the ground that it is compound. Applicant further objects on the ground that the information sought is not relevant to this action and is not reasonably calculated to lead to the discovery of admissible evidence.

Request 7: Documentation and evidence that supports why the registrant believes he has exclusive rights and a monopoly for the word “Shadow” even though other trademarks and copyrights over the last eight decades have used the word “Shadow” in respect to animals, people, and products.

Response: Applicant objects to this request on the ground that it is compound. Applicant further objects on the ground that the information sought is not relevant to this action and is not reasonably calculated to lead to the discovery of admissible evidence.

Request 8: Documentation and evidence that supports why the registrant believes he has exclusive rights and a monopoly for the word “Adventures” even though other trademarks and copyrights over the last eight decades have used the word “Adventures” in respect to animals, people, and products.

Response: Applicant objects to this request on the ground that it is compound. Applicant further objects on the ground that the information sought is not relevant to this action and is not reasonably calculated to lead to the discovery of admissible evidence.

Request 9: Request for information purposely omitted from the first discovery and has not been created after the cancellation proceeding was filed for his registration in water bottles; IC 032. US 045 046 048. G & S: Purified bottled drinking water. For Films; IC 009. US 021 023 026 036 038. G & S: Motion picture films. C 016. US 002 005 022 023 029 037 038 050. G & S: Series of fiction books and paper based products. This also includes other related product types in these categories that Mr. Odonnell claims to have been selling since 8-29-2007.

Response: Applicant objects to the instant requests on the grounds that it is overly broad and burdensome. Applicant further objects to the instant request and its insinuation of fraud. Subject to said objections, Applicant has produced all responsive documents and information in its control at this time.

CONCLUSION

WHEREFORE for good cause considered, the Applicant, by counsel, respectfully requests that the Board reject the Opposer's Motion to Compel Discovery and Motion to Extend or Re-Open Opposer's Discovery Period in the instant case.

Respectfully submitted this 6th day of June, 2014.

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