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

Proceeding	91212445
Party	Plaintiff Red Bull GmbH
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extension and is not guilty of negligence or bad faith, Opposer's request for an extension of the testimony periods should be granted.

This is the first extension of any TTAB scheduled dates requested by Opposer in this proceeding. There were two earlier extensions of trial dates, but both were for Applicant's benefit and due to Applicant's counsel's travel schedules³. On April 23, 2014, to allow Applicant's counsel, who would be traveling in Asia in July, extra time to confer with his client regarding Opposer's settlement proposal, Opposer filed an agreed-upon Motion for a 90-day Suspension for Settlement with Consent in Opposition No. 91-212,445.⁴ This motion was granted by the Board on the same day.⁵ Aside from this 90-day extension to allow Applicant's counsel time to confer with his client during his travels in Asia, and one other 60-day extension, also largely to accommodate Applicant's counsel, this opposition has progressed with relatively few delays or interruptions.

During the last few weeks of the discovery period, Applicant's counsel introduced two "of counsel" lawyers for what Opposer understood to be the limited purpose of assisting Applicant's counsel with discovery for this opposition.⁶ With the introduction of Amy Benjamin, and Joe Zito shortly thereafter, Applicant began taking a needlessly aggressive – and surprisingly uncoordinated - discovery approach and the parties held multiple extensive meet and confer conference calls, both during and after the close of the discovery period. During the last meet and confer prior to the opening of the first

³ There has been a complete lack of courtesy by Applicant in the recent past since two additional counsel have apparently joined Applicant's team, notwithstanding Opposer's courtesies early in this case including Opposer filing for extensions for Applicant while Applicant's counsel was traveling in Asia.

⁴ Applicant mis-characterizes the standard Motion for 90-day Suspension for Settlement, filed on April 23, 2014 (mistakenly referenced in Applicant's Opposition to Opposer's Motion for Suspension/Extension of Testimony Periods as May 23, 2014), as an "agreed upon Trial Schedule." Though the 90-day suspension was *agreed to*, the remaining dates were set in accordance with the TTAB's standard procedures/schedules, *See* Motion for Suspension for Settlement with Consent ("Motion for 90-day Suspension for Settlement"), Docket No. 7 (April 23, 2014) and Opposition to Opposer's Motion for Suspension/Extension of Testimony Periods ("Applicant's Opposition"), Docket No. 10 (January 2, 2015), p. 1.

⁵ *See* Motion to Suspend Granted ("90-day Suspension Order"), Docket No. 8 (April 23, 2014).

⁶ Amy Benjamin was first introduced to Opposer on September 30, 2014 during a short, discovery-related conference call. Joe Zito was introduced to Opposer in early November 2014, after the close of discovery, to assist Michael Stein and Amy Benjamin during a discovery-related meet and confer. Neither Amy Benjamin nor Joe Zito have served a Notice of Appearance in Opposition No. 91-212,445. Michael Stein is Applicant's only listed attorney of record.

testimony period in this case, Applicant's attorneys indicated a clear intention to file a Motion to Compel, or similar discovery motion. Such a motion would have suspended proceedings and delayed the opening of the first testimony period.

Based upon the standard dates in the 90-day Suspension Order⁷, Opposer's 30-day testimony period opened on December 17, 2014. In anticipation of Applicant's Motion to Compel, or a similar discovery motion that would result in the suspension of all dates in Opposition No. 91-212,455, Opposer diligently checked TTABVUE for a motion submitted by Applicant.⁸

Since the deadline for filing discovery motions is the opening of testimony, and in view of the aggressive approach taken and threats made by Applicant, Opposer was quite surprised when, 24 hours after the opening of testimony, TTABVUE still did not show any Motion to Compel, or similar discovery motion, filed by Applicant. That next day, Opposer immediately contacted Applicant's counsel⁹ to discuss deposition dates in view of the fact that testimony would not be rescheduled due to Applicant's failure to file a Motion to Compel and that testimony would now be scheduled to occur over the Christmas and New Year's holiday season.¹⁰ Not only does the holiday period typically pose special problems for counsel but also is often problematic for contacting witnesses, especially in Europe.

⁷ See Motion for 90-day Suspension for Settlement and 90-day Suspension Order.

⁸ Opposer had initially provided electronic courtesy copies of all mail served documents to Applicant in this proceeding. When Applicant resisted this reciprocal exchange, Opposer stopped unilaterally providing electronic courtesy copies. Given the inherent delay in receiving physical mail, Opposer diligently checked TTABVUE to make itself aware of any submission made by Applicant, as uploaded filings generally become available on TTABVUE within approximately 24 hours after filing.

⁹ Applicant's Opposition incorrectly states that "although Applicant is represented by three counsel, (Mr. Stein, Ms. Benjamin and Mr. Zito), and despite the fact that all three have been cc'd on previous e-mails, Opposer's counsel contacted only Mr. Stein on Friday, December 19 and made no effort to cc: or reach out to any other co-counsel." See Applicant's Opposition, p. 2. In that Ms. Benjamin and Mr. Zito were held out as only assisting Applicant's attorney of record with discovery issues, and that neither Ms. Benjamin nor Mr. Zito has ever entered an appearance in Opposition No. 91-212,445, Mr. Stein was the proper and appropriate person to call regarding trial testimony. Mr. Stein, who Opposer later learned was traveling for the holidays, received Opposer's voicemail and email, and promptly forwarded this email to Ms. Benjamin, who then forwarded it to Mr. Zito that same day.

¹⁰ Applicant's Opposition falsely states that "half-way through its own testimony period ... Opposer's counsel seeks extra time." Opposer's testimony period opened December 17, 2014 and Opposer contacted Applicant's attorney of record to discuss Applicant's counsel's availability and deposition dates on December 19, 2014. One and a half days is clearly not "half-way" through the 30-day testimony period.

II. LEGAL ANALYSIS

Opposer's Motion was filed early in the testimony period. Indeed, Opposer contacted Applicant immediately after the opening of its testimony period and within hours after confirming that Applicant's threatened Motion to Compel had not been filed. Opposer need only establish "good cause" for the requested extension.¹¹ Generally, "the Board is liberal in granting extensions of time before the period to act has elapsed, so long as the moving party has not been guilty of negligence or bad faith and the privilege of extensions is not abused."¹²

A. Opposer's Motion was Filed Early in the Testimony Period and Without Delay

Opposer's motion was filed early in the testimony period, immediately after Applicant's counsel and two of Applicant's counsel's "of counsel" lawyers – three partner-level attorneys – indicated their unavailability for the first half of Opposer's testimony period. Further, Opposer was extremely diligent in monitoring TTABVUE for the expected Motion to Compel, or similar discovery motion; Opposer was diligent in immediately contacting Applicant's attorney of record to discuss¹³ deposition dates when it confirmed that no such motion had been filed. Opposer's 30-day testimony period opened on December 17, 2014 and any motion by Applicant to compel discovery responses from Opposer certainly should have been on TTABVUE by December 18, 2014. Opposer contacted Applicant's attorney of record to discuss deposition dates on December 19, 2014.

Opposer reached out to Mr. Stein by phone on December 19, 2014, immediately followed by an email to Mr. Stein. In Ms. Benjamin's response on December 19, 2014, she informed Opposer for the first time that she and Mr. Zito would be handling testimony depositions on behalf of Bullstone and, further, indicated her need to discuss dates with Mr. Zito before proceeding with scheduling, making it clear that

¹¹ See FRCP Rule 6(b)(1)(A).

¹² See *American Vitamin Products Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992). Not only was Opposer's motion filed timely and very promptly in the testimony period, but it was filed well before the deadline for noticing depositions on written questions.

¹³ Applicant's Opposition suggests that Opposer should have taken a discourteous *shoot first, ask questions later* approach. Not only is it common courtesy to agree on testimony dates and then issue appropriate legal documents but, when dealing with a tight schedule and special circumstances during the Christmas/New Year's holiday season, such a process would have been extremely inefficient.

Mr. Zito’s schedule would dictate Opposer's deposition schedule. The following day, Mr. Zito wrote to Opposer, stating that it would “not be possible to schedule any depositions prior to January 2nd, after the holiday.” Opposer, also, made multiple attempts to contact Mr. Zito by phone on December 22, 2014¹⁴ and was eventually able to reach him. Applicant disingenuously attempts to characterize Mr. Zito’s unequivocal statement of unavailability as a “misunderstanding,”¹⁵ but there was, in fact, no *misunderstanding* – Mr. Zito clearly stated, with no further information or qualification, that depositions could not be held prior to January 2, 2015.¹⁶ After diligently contacting Applicant’s attorney of record immediately after the opening of Opposer’s testimony period, after receiving Mr. Zito’s email indicating the unequivocal impossibility of scheduling any depositions prior to January 2, 2015, and after Mr. Zito’s refusal to work courteously with Opposer to come to an agreement regarding an extension of Opposer’s testimony period to account for Applicant’s unavailability during the first half of Opposer’s testimony period¹⁷, Opposer promptly filed the instant motion. As has been clearly shown, Opposer was diligent in both contacting Applicant and in filing its Motion for Extension of Testimony Periods.

¹⁴ In Applicant’s Opposition, Applicant falsely asserts that Opposer did not make multiple, unsuccessful attempts to contact Applicant’s counsel. *See* Applicant’s Opposition, p. 6. Indeed, Opposer's counsel's phone switch log (excerpted below) shows three attempts to reach Mr. Zito. Mr. Zito likely knows of these attempts and never provided an affidavit or documents that he didn't receive the calls but instead misleadingly asserts that Opposer's statement is false.

O	10011	12/22/2014	00:00:09	E113	12024663500	104
O	10012	12/22/2014	00:00:55	E113	12024663500	104
O	10013	12/22/2014	00:01:23	E113	12024663500	104

These phone log excerpts show three "O" (outgoing) calls to Attorney Zito's phone number -- 202-466-3500 -- made from Extension 113 of counsel's phone switch and that such calls went out on the phone line attached to port 104. The calls were a duration of 9 seconds, 55 seconds and 1 minute, 23 seconds. Applicant's bald assertion that Opposer lied is simply another desperate attempt to throw mud rather than cooperate to reach the merits of the opposition proceeding.

¹⁵ *See* Applicant’s Opposition, p. 3.

¹⁶ As noted in Opposer’s Motion, Mr. Zito’s suggestion, in his email of December 22, 2014, that he might *retract* his unequivocal unavailability over the holidays is too little, too late. The first week of Opposer’s testimony period is important to Opposer to coordinate with its witnesses, particularly its European witnesses, due to the deadlines for noticing testimony on written questions. After receiving Mr. Zito’s email of unavailability, a *partial* retraction of his unavailability on the eve of Christmas (European time) prejudicially deprives Opposer from meaningful contact with its witnesses during this critical time.

¹⁷ Applicant’s Opposition mischaracterizes Mr. Zito’s email of December 22, 2014, “The relevant portion of Mr. Zito’s December 22nd email, agreeing to a one week extension ... ” *See* Applicant’s Opposition, p. 4. As Mr. Zito indicated earlier in this same email, Mr. Zito knew Opposer’s counsel would be traveling out of North America during this *proposed* one-week extension and, as such, Mr. Zito’s offer of an extension of one week was a hollow offer in an attempt to appear courteous. Further, it is worth noting that Mr. Zito’s email of December 22, 2014 purposefully mis-represents that Opposer’s counsel indicated that “someone else from [his] office would need to

B. Opposer Has Established Good Cause for an Extension and Applicant Has Provided No Indication that Such an Extension Will Be Prejudicial to Applicant

Opposer has established good cause where Applicant's unavailability cut Opposer's 30-day testimony period in half and where Applicant has not provided any arguments or evidence showing it will be prejudiced by this extension. It is difficult enough to schedule depositions, and meet with witnesses¹⁸ over the Christmas/New Year's holiday period due not only to limited witness availability but also attorney's schedules. Moreover, when Applicant failed to follow through on its expressly stated intent to file a Motion to Compel, that unreasonably left only a couple of business days around Christmas for Opposer to attempt to make the necessary contact with its European witnesses to finalize its deposition questions. Applicant's refusal to cooperate on scheduling other witnesses made it clear that the testimony period needed to be extended and reset.

Quite telling of Applicant's improper and harassing motives is that Applicant's opposition does not provide any evidence indicating that Applicant will, in any way, be prejudiced by Opposer's first ever requested extension in this proceeding. Moreover, Applicant does not even make any attempt to argue that it will be prejudiced by this extension.

C. Opposer Is Not Guilty of Negligence or Bad Faith and the Privilege of Extensions Has Not Even Been Previously Used Let Alone Abused

Not only has Opposer been extremely diligent, it certainly has not been guilty of negligence or bad faith. In addition, the privilege of extensions has not been abused in that the only two extensions – earlier in this case – were for settlement discussions and were due to Applicant's counsel's travel unavailability.

cover," where this issue was never discussed. *See* Exhibit A.

¹⁸ Applicant wrongfully suggests that there is no need for Opposer's counsel to consult with European witnesses *before* their testimony. Applicant's experienced counsel full well knows that counsel must discuss testimony with a witness in advance. Otherwise, the witness may not understand a particular question -- which cannot be reworded in a deposition on written questions. Moreover, counsel needs to know the topics on which the witness can best testify and what documents the witness can properly identify.

What is surprising in this case is not merely the refusal of Applicant to reciprocate any courtesies - whether that be to send email courtesy copies of documents or to agree to Opposer's first request to extend dates - but also Applicant's false and misleading statements in briefs and emails. While Opposer believes these issues are red-herrings raised by Applicant, Opposer does not want Applicant to suggest, or the TTAB to believe, that Applicant's statements are somehow true as being unopposed. Opposer provides some examples below so the TTAB can understand that nature of Applicant's actions in this proceeding.

Applicant wrongfully tried to impugn Opposer by making the false statement that Opposition No. 91-212,445 has progressed “without Opposer producing documentary evidence to support its opposition nor satisfy its burden as Opposer.”¹⁹ This statement is completely false and misleading. The time for submitting documentary evidence is during trial; but this motion was brought immediately after the opening of testimony and prior to any evidence being submitted. As such, Applicant's statement is merely a *nasty* statement of the *process*, not of Opposer; yet, Applicant's Opposition suggests Opposer did something sinister. To the extent Applicant is trying to be a 500 pound *discovery* gorilla pounding his chest, Applicant's effort fails on several fronts. Opposer provided its timely and appropriate responses to Applicant's discovery requests, in full compliance with the rules. Applicant insisted that Opposer participate in several discovery *meet and confer* sessions which it did, and Applicant *brought in* special counsel to address its perceived discovery issues. On two occasions, Applicant objected to Opposer's count of Applicant's Interrogatory Requests, only to later withdraw these objections. Yet, after the meet and confer sessions, Applicant was either satisfied or otherwise elected not to bring any motions to compel. Applicant allowed the deadline for bringing motions to compel to pass, but sought to harass Opposer even more by scheduling a further meet and confer session after the opening of Opposer's testimony period. In that meet and confer, Opposer asked Applicant's well experienced counsel the basis

¹⁹ See Applicant's Opposition, p. 2.

of his client's standing to bring an untimely motion to compel. No explanation was provided during the meet and confer or thereafter.

Opposer had made voluminous documents available for inspection by Applicant, including many documents at its headquarters in Europe. Yet, Applicant elected not to inspect these documents, even though Mr. Zito stated he was recently in Europe, and specifically available in Austria, where some of these documents had been held for Applicant's inspection. Obviously, Applicant's request for the documents was not in good faith, and was solely for harassment, since it elected not to inspect the requested documents.

Further, in an attempt to falsely insinuate bad faith or negligence by Opposer, Applicant makes an irrelevant and false statement regarding a fabricated submission never made by Opposer – “Opposer’s Pre-Trial Statement, timely served on December 1, 2014, is also devoid of any reference to any specific documentary evidence and it remains unclear if Opposer intends to present any documentation in support of its Opposition.”²⁰ Notably, pre-trial *statements* are not required, or even welcomed, in TTAB proceedings. On December 1, 2014, Opposer did, however, timely serve its pre-trial *disclosures*, in accordance with the rules. Further, as stated in TTAB Manual of Procedure (“TBMP”) Section 702.01, “the Board does not require pretrial disclosure of each document or other exhibit that a party plans to introduce at trial as provided by Fed. R. Civ. P. 26(a)(3)(A)(iii).”²¹ Opposer’s pre-trial disclosures were timely served in full compliance with the rules, listing

general identifying information about the witness, such as relationship to any party, including job title if employed by a party, or, if neither a party nor related to a party, occupation and job title, a general summary or list of subjects on which the witness is expected to testify, and a general summary or list of the types of documents and things which may be introduced as exhibits during the testimony of the witness.²²

²⁰ *Id.*

²¹ *See* TBMP Section 702.01.

²² *Id.*

In accordance with these rules, Opposer listed all potential witnesses and all required identifying information²³, along with a general summary/list of the types of documents and things to which each witness may testify. Indeed, Opposer, in the spirit of cooperation and to address the merits of the proceeding, went beyond the requirements and, without prejudice to necessary amendment, informed Applicant of the anticipated subjects of Applicant's party and related witnesses.

Opposer's pre-trial disclosures clearly stated that two of Opposer's potential witnesses are located in Austria. "A testimonial deposition taken in a foreign country **shall** be taken by deposition upon written questions."²⁴ Applicant makes the non-sensical statement that Opposer "[did not] indicate it if intended to serve any written deposition questions,"²⁵ The only way to take depositions in Europe is through depositions upon written questions and the TTAB has specific procedures for such depositions. Had Applicant cooperated with Opposer in setting deposition dates, discussion about the depositions on written questions of foreign witnesses could have been raised by Applicant if it preferred oral depositions.

Later in Applicant's Opposition, Applicant makes the strange and further non-sensical statement that, "[i]f it was Opposer's intent to conduct the [f]oreign depositions ... by written questions", as set forth in the rules, then what was the need to coordinate with opposing counsel or with European witnesses."²⁶ Not only would proceeding with a deposition without first coordinating with a party witness be, or border on, malpractice, but coordinating with a witness is especially important where a deposition will be taken upon written questions in that questions, once written, cannot be restated or otherwise reworded, and where these questions will not be in the witness' native language.

Finally, Applicant exaggerates the attorneys for Opposer who are available for depositions. Ms. Halpert is not involved in this opposition except on a tangential basis and has not actively participated in any of the motions or proceedings. Ms. Riordan is a junior associate who is not experienced in deposition

²³ While it is true that two of the potential witnesses listed in Opposer's pre-trial disclosures are located in the United States, Applicant has mis-characterized these individuals as "Opposer's employees."

²⁴ TBMP Section 703.02(a) (emphasis added).

²⁵ See Applicant's Opposition, p. 3.

²⁶ See Applicant's Opposition, p. 6.

practice. Moreover, Mr. Zito was informed that Mr. Greenstein was unavailable traveling outside of North American during the latter half of January. Mr. Zito's email statement that Mr. Greenstein would have to find another attorney to cover depositions during his absence was a knowing fabrication in Zito's email to support his attempt to deprive Opposer of its choice of counsel to conduct critical trial testimony.

Despite every attempt Applicant has made to misrepresent the facts to make Opposer's request appear unnecessary and to make it appear as if Opposer is somehow acting in bad faith in filing its Motion to Extend, it is clear from the foregoing that Opposer has acted diligently and has established good cause for this extension.

III. CONCLUSION

In view of the foregoing, Opposer submits that its testimony period should be rescheduled to recommence a minimum of 30 days following the TTAB's order lifting the current suspension.

Moreover, any rescheduling has the potential for conflicts with other cases, the INTA Annual Meeting, and witness availability. Opposer will certainly work with Applicant to make reasonable accommodations for Applicant's schedule and witnesses and Opposer expects the same from Applicant.

Dated: January 22, 2015

Respectfully submitted,

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CERTIFICATE OF SERVICE

I certify that a true and correct copy of the foregoing **OPPOSER'S REPLY IN SUPPORT OF EXTENSION OF TESTIMONY PERIODS** is being served on January 22, 2015, by deposit of same in the United States Mail, first class postage prepaid, in an envelope addressed to counsel for Applicant at:

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