

ESTTA Tracking number: **ESTTA634621**

Filing date: **10/22/2014**

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

Proceeding	91215049
Party	Plaintiff Alliance Powersports Inc.
Correspondence Address	ERIN C KUNZELMAN LEE LEE & ASSOCIATES PC 2531 JACKSON RD, STE 234 ANN ARBOR, MI 48103 UNITED STATES jj@llapc.com, erin@llapc.com
Submission	Opposition/Response to Motion
Filer's Name	Erin C. Bray
Filer's e-mail	erin@llapc.com,jj@llapc.com
Signature	/Erin C. Bray/
Date	10/22/2014
Attachments	Opposer's Response to Applicant's Motion to Compel.pdf(171903 bytes) Opposer's Exhibit 1.pdf(111104 bytes) Opposer's Exhibit 2.pdf(89907 bytes) Opposer's Exhibit 3.pdf(224037 bytes) Opposer's Exhibit 4.pdf(135063 bytes) Opposer's Exhibit 5.pdf(174067 bytes)

Opposer initiated this Opposition against Applicant, after becoming aware of Applicant's application for the mark "WOLF," for scooters, U.S. Application Serial No. 85608003.

Applicant is a Limited Liability Company organized in Florida. Applicant claims to have begun using the WOLF mark for Scooters in April 2013.

II. Facts

1. The Opposer and Applicant held their discovery conference on May 1, 2014. At the discovery conference Applicant and Opposer specifically agreed to service by U.S. Mail.
2. The discovery period in this proceeding is scheduled to close on October 30, 2014.
3. Applicant served Opposer with its first set of discovery on May 5, 2014. (Applicant's Exhibit 1)
4. Opposer timely served Applicant with Opposer's Initial Disclosures on June 2, 2014, and consented to Applicant's request for an extension to serve Applicant's Initial Disclosures on June 3, 2014. (Opposer's Exhibit 1)
5. Opposer had difficulty in securing documents in response to Applicant's requests as they were outside Opposer's possession, custody and control. To assist Opposer in obtaining additional documentation Opposer requested that Applicant agree to the Board's standard Protective Order and a 30-day extension for Opposer to respond to Applicant's discovery requests. Applicant denied Opposer's request for an extension in time to answer. (Applicant's Exhibit 3)
6. Opposer served Applicant with its initial responses to Applicant's discovery requests on June 4, 2013. (Applicant's Exhibit 4)

7. Opposer continued to diligently seek additional documentation to support and supplement its responses to Applicant's discovery request.
8. On June 20, 2014, Applicant claims to have mailed Opposer a letter noting deficiencies to Opposer's discovery responses. Opposer did not receive the letter, nor, as had been Applicant's common practice, did Applicant send Opposer an emailed courtesy copy of the letter. (Applicant's Exhibit 7)
9. Opposer was unaware of the June 20, 2014 letter until Applicant emailed Opposer on July 10, 2014 requesting a response from Opposer. (Opposer's Exhibit 2)
10. Opposer served Applicant with its First Amended Responses to Applicant's Discovery Requests on July 14, 2014.
11. On August 19, 2014, Applicant requested that Opposer provide Applicant with the availability of Mr. Gene Chang, CEO of Alliance Powersports for deposition by the 29th of August. Opposer was not aware of any scheduling conflicts.
12. On September 8, 2014, Applicant Served Opposer with its Second Set of Interrogatories and Requests for Production and its First Set of Requests for Admissions.
13. On September 8, 2014, Opposer became aware that Mr. Gene Chang was out of the country and would not be returning until late October. (Applicant's Exhibit 12)
14. On September 24, 2014, at 2:39 pm, Applicant served Opposer with a Notice of Deposition. Opposer responded at 3:55 pm that unfortunately Mr. Chang was out of the country and unavailable until the 29th of October. "To facilitate rescheduling the deposition, [Opposer] propose[d] extending the discovery deadline to November 30." (Applicant's Exhibit 12)

15. On September 24, 2014 at 7:46, Applicant responded that it did not consent to an extension. (Applicant's Exhibit 12)
16. Over several succeeding emails Opposer attempted to reasonably negotiate with Applicant and offer what consideration, under the circumstances, it could to alleviate any harm to Applicant, due to the unavailability of Mr. Chang. (Applicant's Exhibit 12)
17. On September 25, 2014 Applicant, gave Opposer a deadline to produce a designee for Mr. Chang for the 30(b)(6) deposition. (Applicant's Exhibit 12)
18. Continuing its diligent effort to respond and deal in good-faith, Opposer produced additional responses to Applicant's discovery requests on September 26, 2014. In addition, Opposer explained that given the outlined scope of the 30(b)(6) deposition, Opposer did not have an competent designee other than Mr. Chang. (Opposer's Exhibit 3)
19. On October 2, 2014, Applicant filed the present Motion.
20. On October 13, 2014, Opposer served Applicant with its responses to Applicant's Second Set of Discovery.
21. On October 15, 2014, Opposer informed Applicant that Mr. Gene Chang had changed his travel plans and was back within the United States. Opposer further informed Applicant that Mr. Gene Chang was available to be deposed via video or phone conferencing from California, after 8:00 am PST. (Opposer's Exhibit 4)
22. On October 17, 2014, Opposer received an email copy of a letter from Applicant stating, in part, that it was Applicant's understanding that Opposer's October 15, 2014, letter was sent to "commemorate Alliance's refusal to appear at the Rule-30(b)(6) deposition as

noticed on September 22.... For a deposition to take place on October 20, 2014 at our offices in Cleveland, Ohio.” (Opposer’s Exhibit 5)

III. Argument

A. Applicant’s Notice of Deposition was deficient.

Trademark Rule 2.120(b), 37 C.F.R. § 2.120(b), and TBMP Sections 404.03 and 404.04 have detailed provisions and explanations regarding where a deposition may be taken, and it is the responsibility of the inquiring party to secure the attendance of the deponent. Trademark Rule 2.120 (b), specifically provides: “The deposition of a natural person shall be taken in the Federal judicial district where the person resides or is regularly employed or at any place on which the parties agree by stipulation.” However, it is clear from Applicant’s Notice of Deposition and October 17, 2014, letter that Applicant expected Mr. Gene Chang to appear in person at Applicant’s counsel’s offices in Cleveland, Ohio. Mr. Chang is a resident of, and regularly employed in California. 35 U.S.C. 24, provides that: “No witness shall be deemed guilty of contempt for disobeying such subpoena unless his fees and traveling expenses in going to, and returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena;...”.

Although initially, Mr. Chang was unavailable on the scheduled date for the deposition due to his absence from the United States, upon his return Opposer informed Applicant of his availability for the deposition from his domicile in California. At no time has Applicant either discussed travel arrangements, or the potential of making travel arrangements for Mr. Chang to

appear in Cleveland, Ohio. Opposer also put forth that Mr. Chang's availability for the deposition include consideration of the time difference between Ohio and California, having deemed appearance at 6:00 a.m. PDT, to be unreasonable and unduly burdensome on the deponent. (Opposer's Exhibit 4)

In addition, in general parties are limited in their right to discovery to the more convenient, least burdensome or expensive means or source. TMBP §402.02. Counsel for Applicant has offices in San Diego, California. Therefore, in addition to the options of a video or voice conferenced deposition, Applicant's counsel has a physical presence in a neighboring federal judicial district.

Rather than seek the least burdensome or expensive means, Applicant refused Opposer's attempt to ameliorate any hardship on the Applicant due to Mr. Chang's absence from the U.S., or later adjust in any way his early return. Instead Applicant asserted that Mr. Chang had no other option but to appear, at his own expense, at Applicant's Offices on the 20th of October, or face being held in contempt. (Opposer's Exhibit 5)

B. Opposer has made a good faith effort to respond to Applicant's requests for production.

Opposer has made diligent efforts to respond to the extensive and unduly burdensome discovery. Opposer has gone beyond its discovery obligation to locate documents outside its possession, custody and control. Opposer's responses, amended responses and supplemental responses to Applicant's discovery requests moot Applicant's assertion that Opposer has not acted in good faith, stonewalled, or ignored Applicant's requests. To the contrary, amid the barrage of requests, and deficiency notices from Applicant, Opposer has responded with the

information available to Opposer at the time of each response. Quite simply, Opposer cannot produce documents which do not exist. Further exacerbating Opposer's good-faith efforts in this case is the time and language differences between Alliance Powersports and its manufacturer.

However, in an attempt to satisfy Applicant's requests, as in Applicant's request for documentation of the relationship between Sanyang Industry and Alliance Powersports, (after previously having produced the agreement between the two, marked commercially sensitive, and having it deemed deficient by Applicant), Opposer requested additional documentation from Sanyang. As Applicant notes in its Memorandum in Support of the subject Motion, the resulting document from Sanyang Industries was written on September 4, 2014. (Applicant's Exhibit 13). Based on Applicant's Memorandum, this document too is insufficient.

Although Applicant asserts that Opposer is not providing full responses to its requests, the simple reality is that regardless Opposer's efforts to produce documents, including documents that previously did not exist; Applicant finds Opposer's responses deficient. To date Opposer has produced 40 Exhibits in response to Applicant's document requests. Opposer has worked diligently to cooperate and act in good-faith during the pendency of this proceeding.

IV. Conclusion

Opposer therefore, requests that the Board deny Applicant's Motion for Order Compelling Deposition and Document Production and that the trial dates remain as set.

Respectfully Submitted,
Alliance Powersports, Inc.

By: /Erin C. Bray/
Erin C. Bray, Esq.
JungJin Lee, Esq.
Attorneys for Applicant

Lee, Lee & Associates, P.C.
2531 Jackson Road, Suite 234
Ann Arbor, MI 48103
Tel: 866-400-2507
Fax: 800-689-7978
Email: jj@llapc.com, erin@llapc.com

CERTIFICATE OF SERVICE

I hereby certify that on October 22, 2014, a true and correct copy of Opposer's Response to Applicant's Motion for Order Compelling Deposition and Document Production:

SHANNON MCCUE
HAHN LOESER & PARKS LLP
200 PUBLIC SQUARE, SUITE 2800
CLEVELAND, OH 44114
UNITED STATES

trademarks@hahnlaw.com, bareese@hahnlaw.com, smccue@hahnlaw.com, bclark@hahnlaw.com,
mcsoulsby@hahnlaw.com, rbabbitt@babbitt-lawfirm.com

By Electronic and Priority Mail.

I further certify that the foregoing paper is being filed electronically via the Electronic System for Trademark Trials and Appeals (ESTTA).

Date: October 22, 2014

/JungJin Lee/
JungJin Lee

Erin K.

From: Erin K.
Sent: Monday, June 02, 2014 9:42 PM
To: trademarks@hahnlaw.com; bareese@hahnlaw.com; smccue@hahnlaw.com; 'bclark@hahnlaw.com'
Cc: J.J. Lee
Subject: Opposer's Initial Disclosures
Attachments: Opposer's Initial Disclosure - WOLF.pdf

Shannon McCue,

Attached please find Opposer's Initial Disclosures.

Thank you,

Erin

Erin Kunzelman, Esq.
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Phone: 800-529-2218
Fax: 800-689-7978

Erin K.

From: Erin K.
Sent: Tuesday, June 03, 2014 9:06 AM
To: 'Shannon V. McCue'
Subject: RE: Alliance v. Hammer Brand Opposition - Applicant's Initial Disclosures

Shannon,

Thank you for sending these over, and we consent to the one day extension.

Thank you,

Erin

From: Shannon V. McCue [<mailto:smccue@hahnlaw.com>]
Sent: Tuesday, June 03, 2014 8:31 AM
To: Erin K.; J.J. Lee
Cc: Brendan E. Clark; Becky Reese
Subject: Alliance v. Hammer Brand Opposition - Applicant's Initial Disclosures

Erin,
Per my voicemail, here are Applicant's initial disclosures.
-Shannon

[Shannon V. McCue](#)
Hahn Loeser & Parks LLP
200 Public Square, Suite 2800
Cleveland, OH 44114-2316
216.274.2282 - phone
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HAHN  LOESER

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Erin K.

From: Erin K.
Sent: Friday, July 11, 2014 10:16 AM
To: 'Shannon V. McCue'
Subject: RE: Alliance v. Hammer Brand opposition

Hi Shannon,

Are you available for a call today? I have meetings at 1pm and 5:30pm eastern.

Neither JJ or I received your June 20th letter requesting a call the week of the 23rd, sorry for any miscommunication on that account.

Let me know when you might be available. I can be reached at 800-529-2218 ext. 806.

Erin C. Bray, Esq. (*formerly Erin Kunzelman*)
Attorney & Counselor at Law
Lee, Lee & Associates, P.C.
www.llapc.com
erin@llapc.com
Phone: 800-529-2218
Fax: 800-689-7978

From: Shannon V. McCue [<mailto:smccue@hahnlaw.com>]
Sent: Thursday, July 10, 2014 9:36 AM
To: Erin K.
Cc: J.J. Lee; Brendan E. Clark
Subject: Alliance v. Hammer Brand opposition

Erin,
I am following up on my correspondence from June 13 and 20th. Briefly, we had requested the documents withheld by Alliance pending entry of the protective order and noted other deficiencies in our follow correspondence. In the June 20th letter, I had requested that you call during the week of June 23rd to resolve these issues over the phone.

It has been over two weeks since this correspondence and I have not received a call. Hammer Brands has made every effort to resolve these issues in good faith and obtain Alliance's cooperation during discovery. Ironically although Hammer Brand served its discovery requests more than a month before Alliance's requests, Hammer has provided a full response and production of documents while Alliance continues to withhold documents and information critical to Hammer Brand's case.

Hammer Brand is frustrated with the utter lack of cooperation from Alliance during discovery and views the unreasonable delay in responding fully to its discovery requests as an attempt to unnecessarily increase the costs of this opposition by forcing it to seek relief from the Board.

If the documents withheld pending entry of the protective order and other deficiencies noted in our June 20th correspondence are not resolved by providing a complete production of documents and requested information by July 14, Hammer Brand will file a motion to compel.

Sincerely,
Shannon McCue

[Shannon V. McCue](#)

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Jason R. Lee, Esq.
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September 26, 2014

Shannon V. McCue
Hahn Loeser & Parks, LLP
200 Public Square, Suite 2800
Cleveland, OH 44114-2316

RE: FRE 408 Settlement Communication
Alliance Powersports, Inc. v. Hammer Brand, LLC
Mark: WOLF

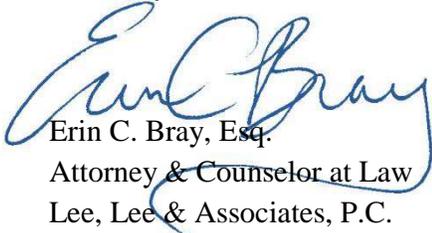
Dear Mr. McCue:

Under FRE 408

Finally, Alliance's CEO, Gene Chang is presently overseas on business. We were made aware of his absence on the 8th of September. We made you aware of our client's inability to be present at the deposition scheduled for the 20th of October, in good faith, within 53 minutes after receipt of the Notice of Deposition by email on September 24, 2014, and offered to consent to a

30 day extension to the discovery deadline in this case. Our offer was initially refused out of hand, however, in an effort to bring this matter to a resolution we are open to discussing a potential extension in order to facilitate scheduling a deposition. Due to the areas of deposition, there is no other who can be designated to appear in Mr. Chang's place.

Sincerely,

A handwritten signature in blue ink that reads "Erin C. Bray". The signature is fluid and cursive, with the first name "Erin" and last name "Bray" clearly legible.

Erin C. Bray, Esq.

Attorney & Counselor at Law

Lee, Lee & Associates, P.C.

erin@llapc.com

Phone: 866-400-2507

Fax: 800-689-7978

October 15, 2014

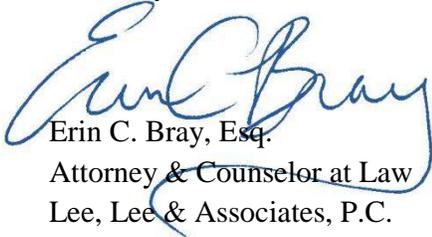
Shannon V. McCue
Hahn Loeser & Parks, LLP
200 Public Square, Suite 2800
Cleveland, OH 44114-2316

RE: Discovery Deposition

Dear Mr. McCue:

Following up from our September 26, 2014 correspondence, Alliance Powersports CEO, Gene Chang, has informed us that his travel plans were changed. Mr. Chang is available to attend a discovery deposition remotely from California, either via videoconferencing, or conference telephone call after 8:00 AM PDT.

Sincerely,



Erin C. Bray, Esq.

Attorney & Counselor at Law

Lee, Lee & Associates, P.C.

erin@llapc.com

Phone: 866-400-2507

Fax: 800-689-7978

October 17, 2014

Via E-Mail and Regular U.S. Mail

Erin C. Kunzelman, Esq.
Lee, Lee & Associates, P.C.
2531 Jackson Road, Suite 234
Ann Arbor, MI 48103
erin@llapc.com

Re: Alliance Power Sports, Inc., Opposer v. Hammer Brand, LLC, Applicant
Opposition Number 91215049
Application Serial Number 86037963
Mark: WOLF

Dear Erin:

On Thursday October 16, I received your October 15 letter sent at 10:48 pm. I understand this letter to commemorate Alliance's refusal to appear at the Rule-30(b)(6) deposition as noticed on September 22. The deposition was properly noticed on September 22, 2014, for a deposition to take place on October 20, 2014 at our offices in Cleveland, Ohio, for an in-person deposition of Alliance's corporate witness. While your letter does not indicate the date that Mr. Chang would be available by videoconference, it is abundantly clear from the letter that Mr. Chang is refusing to appear in person on October 20, 2014, as noticed. That position flouts the Order issued by the Board on October 10, 2014, which instructed that the pendency of my client's motion to compel does not, "excuse a party's appearance at any discovery deposition which had been duly noticed prior to the filing of the motion to compel."

As you know, we asked for deposition dates four months ago. We received no response with dates of availability and no indication that Mr. Chang would be traveling out of the country at that time. In August, I followed up, and again asked for confirmation of Mr. Chang's availability. Again there was no reply, which per the language of our letter, was taken as confirmation that Mr. Chang would be available through the end of the discovery period. Only after Hammer noticed a 30(b)(6) deposition on September 22, 2014, scheduling Alliance's corporate deposition for October 20, 2014, did you uncharacteristically respond promptly and advised, for the first time, that Alliance's CEO Gene Change was out of the country until October 29 and was therefore effectively unavailable for deposition before the close of discovery in this matter. When I reminded you that Alliance could produce a witness other than Mr. Chang, you asserted that only Mr. Chang could testify on behalf of Alliance. I advised that unless Alliance designated a corporate witness by September 26, we would take necessary action. Again, you chose not to respond. Having no other recourse, Hammer prepared and filed the pending motion to compel.

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You have now responded only after Hammer was forced to take action due to your intransigence. In your October 15 letter –received 2 business days before the noticed deposition, you claim Alliance’s CEO Gene Chang is actually back in the United States and available on an undisclosed date, but only via videoconferencing. You represent that his availability is the result of a change in his travel plans which followed your September 26, 2014, letter.

As discussed, this course of action does not comport with the rules of civil procedure nor with the Board’s Order nor with the relief requested in my client’s pending motion to compel attendance at the noticed deposition. Indeed the sudden reappearance of Mr. Chang makes Hammer believe that Mr. Chang’s unavailability was all a ruse to force Hammer to expend resources in filing a motion to compel. The Board’s October 10 order prevents us from seeking further relief at this time, but in the interest of resolving this issue in good faith without further expenditure of my client’s resources, Hammer asks for the following:

- proof of Mr. Chang’s travel itinerary i.e. when he left the U.S. and when he returned,
- and Alliance or its counsel’s agreement to pay Hammer’s attorney fees and costs related to the preparation of the motion to compel and this letter, approximately \$3000.

We ask for a substantive response no later than October 22, 2014, after which I will move forward with the expectation that no such response will be forthcoming. If that is the direction your client wishes discovery to take at this time, be advised that as soon as we are able, we will promptly file a motion requesting that the Board order you and your client to show cause why you and your client are not in contempt of the October 10, 2014, Order, among any other relief my client sees fit to seek at that time.

Sincerely,



Shannon V. McCue

cc: JJ Lee, Esq.