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

Proceeding	91217154
Party	Plaintiff Nasty Pig, Inc.
Correspondence Address	JOEL KARNI SCHMIDT COWAN LIEBOWITZ & LATMAN PC 1133 AVENUE OF THE AMERICAS NEW YORK, NY 10036 UNITED STATES spc@cll.com, jks@cll.com, ejs@cll.com, mx@cll.com, trademark@cll.com
Submission	Reply in Support of Motion
Filer's Name	Joel K. Schmidt
Filer's e-mail	jks@cll.com, spc@cll.com, mx@cll.com
Signature	/Joel K. Schmidt/
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Attachments	DIRTY PIG - Reply in Support of Motion for Order re Manner of Production.pdf(24768 bytes)

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

In the Matter of Application Serial No. 86/085,785
Filed: October 8, 2013
For Mark: DIRTY PIG
Published in the Official Gazette of March 4, 2014

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NASTY PIG, INC.,		:	
	Opposer,	:	Opposition No. 91217154
		:	
v.		:	
JANOSKIANS LLC,		:	
	Applicant.	:	
-----		X	

**OPPOSER’S REPLY IN FURTHER SUPPORT OF MOTION FOR ORDER
REGARDING MANNER OF APPLICANT’S DOCUMENT PRODUCTION**

Applicant Janoskians LLC’s (“Applicant”) opposition papers fail to rebut Opposer Nasty Pig, Inc.’s (“Opposer”) showing that the Board should enter an order under Trademark Rule 2.120(d)(2) directing Applicant to copy and mail Applicant’s documents responsive to Opposer’s requests for production to Opposer’s counsel’s offices located in New York, New York. Pursuant to TBMP § 502.03, Opposer respectfully submits this reply memorandum to respond to new issues raised in Janoskians’ opposition papers.

As set forth more fully below, Applicant is unable to avoid the fact that it has waived its demand that Opposer’s New York-based counsel must travel approximately 2,500 miles to Vernon, California in order to receive Applicant’s responsive documents by virtue of its earlier identical demand that Opposer produce its responsive documents at the offices of Applicant’s counsel in New Jersey—a demand with which Opposer fully and timely complied. Moreover, even if Applicant had not waived this demand, the Board is fully empowered under Trademark Rule 2.120(d)(2) to issue an order directing that Applicant mail its responsive documents to

Opposer's counsel in New York in order to prevent the substantial and unnecessary burden and expense that Opposer would be forced to incur.

Because Applicant is unable to justify its refusal to reciprocally mail Applicant's responsive documents to Opposer's counsel in New York, it can only muster the meritless claim that Opposer failed to make a good-faith effort to resolve this dispute. Such a claim is refuted by the record showing that Opposer's counsel conducted no less than three telephone conferences with Applicant's counsel on this matter. Moreover, Applicant makes the wholly illogical argument that in order to have demonstrated "good faith" before bringing this motion, Opposer's counsel was required to have first traveled to Vernon, California to inspect Applicant's documents in accordance with Applicant's demand—which would have caused Opposer to incur the unnecessary burden and expense that this motion specifically seeks to prevent.

Similarly unavailing is Applicant's repeated self-serving references to Opposer's counsel as a "well-traveled firm." Not only does this seek to disguise the fact that Opposer's counsel operates a single office based in New York, but it purposely ignores the relevant inquiry—namely, that the burden and expense that would be incurred by **Opposer** in being forced to have its counsel travel to California would be both tremendous and unwarranted. The Board should act to prevent such undue burden and prejudice being foisted upon only one of the parties.

For the foregoing reasons, Opposer's motion should be granted.

ARGUMENT

There can be no debate that, by its express terms, Trademark Rule 2.120(d)(2) authorizes the Board to issue an order directing the manner of a party's document production as it deems appropriate. See 37 C.F.R. § 2.120(d)(2) ("The production of documents and things under the provisions of Rule 34 of the Federal Rules of Civil Procedure will be made at the place . . . where and in the manner which the Trademark Trial and Appeal Board, upon motion, orders").

None of the arguments raised by Applicant in its opposition brief are able to refute that, (1) Applicant has waived any right to object to the shipment of its documents to Opposer's counsel in New York, and (2) Applicant's demand that Opposer must inspect and copy Applicant's documents by traveling across the country to Vernon, California would force Opposer to incur significant unnecessary cost and expense. Accordingly, the Board should exercise its discretion under Trademark Rule 2.120(d)(2) and grant Opposer's motion.

A. The Record Demonstrates that Opposer Made a Good-Faith Effort to Resolve the Instant Discovery Dispute In Accordance with 37 C.F.R. § 2.120(e)(1)

As a threshold matter, Applicant makes the baseless claim that Opposer somehow did not make a good-faith effort to resolve the instant dispute in accordance with 37 C.F.R. § 2.120(e)(1). On the contrary, the record demonstrates that Opposer's counsel contacted Applicant's counsel in December 2014 shortly after receiving Applicant's written discovery responses, and that Opposer's counsel scheduled no less than three telephone calls during the month of January 2015 in which he in good-faith sought, unsuccessfully, to resolve this dispute without the need for Board intervention—which included conveying Opposer's generous offer, subsequently rejected by Applicant, to pay for all costs associated with copying and shipping the documents to New York. See Ceresia Decl. ¶¶ 10-19. Under any reasonable read of 37 C.F.R. § 2.120(e)(1), Opposer exhibited a good-faith effort to resolve the instant discovery dispute.

In response, Applicant merely argues that Opposer “never sent Janoskians any deficiency letter.” Opp. Br. at p. 4. However, good faith under 37 C.F.R. § 2.120(e)(1) does not require written correspondence but explicitly may be satisfied by telephone conferences as was done in this case. See 37 C.F.R. § 2.120(e)(1) (“A motion to compel . . . discovery must be supported by a written statement from the moving party that such party or the attorney therefor has made a good faith effort, *by conference or correspondence*, to resolve with the other party or the

attorney therefor the issues presented in the motion but the parties were unable to resolve their differences”) (emphasis added).

Equally frivolous is Applicant’s argument that Opposer did not exhibit the requisite good faith on the ground that Opposer did not “even attempt[] to go to The Putnam Group [in Vernon, California] to inspect the documents.” Opp. Br. at p. 4. It is apparently Applicant’s contention that a party who moves to compel discovery in an attempt to avoid unnecessary and significant burden and expense is first required to incur that very burden and expense before bringing the motion—thereby obviating any subsequent need for the motion. Such a rule would be entirely counter-productive and would undermine the purpose of Trademark Rule 2.120(d)(2) permitting the Board to direct the most equitable and reasonable manner of production based upon the circumstances of the case.

Here, self-evidently, Opposer’s New York-based counsel was not required to incur the significant costs of traveling to Vernon, California to inspect and copy Applicant’s documents as a prerequisite to bringing a motion protesting this needlessly burdensome method of production and seeking the Board’s entry of an order ensuring a fairer method of production.¹

¹ We note that Applicant’s complaint that “Opposer has refused to attempt to provide Janoskians any notice or suggestion of a time to inspect documents at the Putnam Group” (Opp. Br. at p. 5), mischaracterizes the record. Without acceding to Applicant’s unreasonable demand, Opposer’s counsel stated during the parties’ telephone conferences that Applicant had not even provided the logistical information necessary for Opposer to carry out such inspection and copying in Vernon, California, which would include (1) the specific address where the documents are located; (2) who would oversee Opposer’s inspection and copying at Applicant’s offices; and (3) how the documents to be inspected and copied are organized or otherwise maintained. See Ceresia Decl. ¶ 17. This logistical information is what Applicant’s counsel flippantly refers to as “a slurry of nonsensical questions about the Putnam Group that regarded things like the security of the building, if there was a code to get in, and so on.” DeFrancesco Decl. ¶ 12. To date, Applicant’s counsel has failed to provide Opposer with such logistical information within its possession.

B. Applicant Waived Its Right to Object to Mailing Responsive Documents to Opposer’s Counsel Based Upon Its Prior Identical Demand That Opposer Mail Its Responsive Documents to Applicant’s Counsel

Applicant is unable to refute the claim that it waived its right to object to the shipment of its documents to Opposer’s counsel in New York by virtue of its prior identical demand that Opposer produce its documents at the offices of Applicant’s counsel in New Jersey. Notably, Applicant does not contest the hypocrisy and inequity inherent in the unreasonable position it has adopted. Nor is Applicant able to dispute the case law cited by Opposer holding that a party who has taken a specific position in connection with propounding discovery requests is precluded from asserting an objection when that same position is taken by the other side in propounding their discovery requests. See Sentrol, Inc. v. Sentex Sys., 231 U.S.P.Q. 666, 668 (T.T.A.B. 1986); Tektronix, Inc. v. Tek Assocs., 183 U.S.P.Q. 623, 623-24 (T.T.A.B. 1974).²

Notwithstanding the fact that Applicant’s document requests explicitly demanded that Opposer produce its document “at the offices of Baker and Rannells, PA [Applicant’s counsel]” (Ceresia Decl., Ex. D), Applicant claims that the offhand, vague reference to “some other location mutually agreed upon” means that Applicant never demanded that Opposer mail its documents to Applicant’s counsel in New Jersey. See Opp. Br. at p. 5. This argument is too cute by half. Applicant’s document requests expressed a clearly stated preference that Opposer produce its documents at the offices of Applicant’s counsel, as is most frequently done by parties in litigation today. Contrary to Applicant’s self-serving claim, it would have been far more

² Applicant argues that the Board’s decision in Sentrol, which held the parties had waived their right to object to the other party’s requests where they had served identical discovery requests, is inapposite on the basis that the parties’ respective discovery requests in this case “are hardly identical copies.” Opp. Br. at p. 6. Applicant misses the point. The Board held that waiver was appropriate in Sentrol because the parties’ own behavior precluded them from later asserting an objection. Similarly here, Applicant is precluded from asserting an objection to Opposer’s request based upon its own behavior, namely, its prior identical demand that Opposer produce its documents at the offices of Applicant’s counsel.

“convenient” for Opposer to simply make its documents available for inspection and copying at its offices in New York. Instead, Opposer undertook significant effort and expense to comply with Applicant’s demand by reviewing, Bates-stamping and mailing over 2,300 pages of responsive documents to Applicant’s counsel in New Jersey.

Applicant cannot escape that it is refusing to comply with a reciprocal demand by Opposer that it mail its documents to Opposer’s counsel. Under relevant Board case law (to say nothing of principles of equity), Applicant has waived this claim based on its prior identical demand concerning the method of Opposer’s document production.

C. Applicant’s Demand for Inspection and Copying of Applicant’s Documents In Vernon, California Would Cause Opposer to Incur Needless and Significant Burden and Expense

Finally, Applicant’s claim that its unyielding demand that Opposer may only inspect and copy Applicant’s documents by traveling 2,500 miles to Vernon, California would somehow not be unduly burdensome and prejudicial to Opposer, must be rejected out of hand as incredulous.

Applicant opines that there is allegedly no such burden or expense to Opposer on the ground that “California is within reach of [Opposer’s counsel’s] well-traveled firm.” Opp. Br. at p. 8. Such an argument seeks to disguise that Opposer’s counsel operates a single office based in New York and thus would be required to travel across the country. More fundamentally, what matters not is the reputation and experience of Opposer’s counsel, but the burden and expense that would be incurred by its client, Opposer, a New York-based company, if it were forced to pay for its counsel to travel across the country to Vernon, California to inspect and copy Applicant’s responsive documents. The burden and expense imposed on Opposer would be tremendous and wholly unwarranted. Applicant simply cannot avoid that the method of production it is insisting upon will inflict undue hardship upon Opposer for hardship’s sake.

The Order requested by Opposer under Trademark Rule 2.120(d)(2) represents an eminently fair resolution of this dispute, as it would protect Opposer from the very undue hardship and expense that Applicant purposely avoided on its own behalf.

CONCLUSION

For the foregoing reasons and those previously set forth in Opposer's moving papers, Opposer respectfully requests that the Board issue an Order pursuant to Trademark Rule 2.120(d)(2) directing Applicant to copy and mail Applicant's documents responsive to Opposer's requests for production to Opposer's counsel's offices located in New York, New York. Opposer further requests that the Board resolve the instant motion by way of a telephone conference pursuant to Trademark Rule 2.120(i)(1).

Dated: New York, New York
February 24, 2015

Respectfully submitted,

COWAN, LIEBOWITZ & LATMAN, P.C.
Attorneys for Opposer

By: /Joel Karni Schmit/
Joel Karni Schmidt
Eric J. Shimanoff
Scott P. Ceresia
1133 Avenue of the Americas
New York, New York 10036
(212) 790-9200

CERTIFICATE OF SERVICE

I hereby certify that I caused a copy of the foregoing OPPOSER'S REPLY IN FURTHER SUPPORT OF MOTION FOR ORDER REGARDING MANNER OF APPLICANT'S DOCUMENT PRODUCTION to be sent via first class, postage paid mail to Applicant Janoskians LLC's Attorney and Correspondent of Record, Stephen L. Baker, Esq., Baker and Rannells, P.A., 575 Route 28, Raritan, New Jersey 08869-1354.

Dated: New York, New York
February 24, 2015

/Scott P. Ceresia/
Scott P. Ceresia