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

Proceeding	91217154
Party	Defendant Janoskians LLC
Correspondence Address	STEPHEN L BAKER BAKER AND RANNELLS PA 575 ROUTE 28 RARITAN, NJ 08869-1354 UNITED STATES officeactions@br-tmlaw.com, K.Hnasko@br-tmlaw.com, r.mcgonigle@br-tmlaw.com, s.baker@br-tmlaw.com
Submission	Opposition/Response to Motion
Filer's Name	Jason DeFrancesco
Filer's e-mail	jld@br-tmlaw.com, k.hnasko@br-tmlaw.com
Signature	/Jason DeFrancesco/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of trademark application Serial Nos. 86/085,785
For the respective mark: DIRTY PIG
Published in the Official Gazette March 4, 2014

NASTY PIG, INC,	)	
Opposer,	)	Opposition No. 91217154
vs.	)	
JANOSKIANS, LLC,	)	
Applicant.	)	

JANOSKIANS' RESPONSE IN OPPOSITION TO
OPPOSER'S MOTION TO COMPEL

Applicant, Janoskians LLC by and through the undersigned and pursuant to 37 CFR §2.120, TBMP 523 and Rule 33 of the Federal Rules of Civil Procedure, files this Response in opposition to Opposer's Motion to Compel Discovery, as the motion is premature, because Opposer has failed to make a good-faith effort.

BACKGROUND

On October 10, 2014 Opposer mailed its First Set of Interrogatories ("First Interrogatories"), which exceeded the allowable limit of seventy-five (75), counting subparts. (*See Opposer's Motion to Compel* at Exh. D[1].) On December 9, 2014 Applicant objected to the First Interrogatories, on the basis that the count is excessive in violation of 37 CFR §2.120(d). Applicant further highlighted *Kellogg Co. v. Nugget Distributors*, 16 USPQ2d 1468 (TTAB 1990) for reference. (*See id.* at Exh. A)

[1] Prior Interrogatories are attached to *Opposer's Motion to Compel*, as Exhibit D. at pp. 6–13, redlined. (The term "Exhibit" abbreviated herein as "Exh.").

(*Approximately one month later*) on January 8, 2015, counsel for Opposer and Applicant attended a telephonic conference, to meet and confer, regarding Applicant's objections to the First Interrogatories. During the call the undersigned went through Applicant's methodology of counting the First Interrogatories (the "January 8, 2015 phone call"). (*See id.* at p. 3.)

On January 12, 2015, Opposer mailed its Amended First Set of Interrogatories ("Amended Interrogatories"), which again exceeded the allowable limit of seventy-five (75), counting subparts. (*See id.* at Exh. C.) Accordingly, on February 17, 2015 Applicant objected to the Amended Interrogatories, on the basis that the count is excessive in violation of 37 CFR §2.120(d). Applicant again highlighted *Kellogg Co. v. Nugget Distributors*, 16 USPQ2d 1468 (TTAB 1990) for reference. (*See id.* at Exh. E.)

On February 23, 2015, counsel for Opposer sent an e-mail to the undersigned arguing that because Opposer alleges to have "significantly pared down the interrogatories" "there would be no question that they met the subpart limitation." (*See id.* at Exh. F.) The Opposer demanded explanation or threatened to go to the Board. (*See id.*) On February 24, 2015, the undersigned responded to Opposer's demand and provided counsel with a sample count, that interrogatory nos. 3–7 alone add up to forty-three (43)(which is conservative). (S*ee id.*) Counsel for Opposer disagreed with the sample count, and alleged that Opposer "in good faith amended the interrogatories in accordance with the specific objections [the undersigned] expressed during [the January 8, 2015 phone call]." (*See id.*)

Outside of the campaign made by Opposer's counsel (that its interrogatories were compliant because it said so), there was no further communication – including no good faith attempt by Opposer to ever explain its own counting methodology and reveal how its calculations can possibly not exceed the seventy-five (75) limit.

RESPONSE

The undersigned, on behalf of the Applicant discussed with Opposer's counsel its method of calculating the number of First Interrogatories in view of Trademark Rule 2.120(d)(1) and *Kellogg Co. v. Nugget Distributors*, 16 USPQ2d 1468 (TTAB 1990). Just because "Opposer strongly disagreed with Applicant's count[2]" and argues to have "carefully pared down the amended interrogatories[3]" this does not mean the Amended Interrogatories must now automatically conform to 37 CFR §2.120(d), and it does not mean that the Applicant has agreed to waive the Trademark Rules or its right to object (which it does not). Furthermore, the Applicant denies Opposer's careful paring is even appropriate, as it went from at least about over four hundred (400) First Interrogatories to at least about over two hundred (200) Amended Interrogatories. Accordingly, Applicant is acting entirely within the provisions of Trademark Rule 2.120(d)(1) when it elects to object to the number of interrogatories rather than relenting to answer them. And, *Opposer has never provided Applicant or the Board with its method of calculating interrogatories.*

The parties met in good faith with regards to Opposer's First Interrogatories, <u>and resolved</u> the issue.[4] The parties however have not met in good faith to resolve issues with regards to Opposer's Amended Interrogatories. A good faith requirement has not been met as there was never any understanding of differences actually invested by Opposer. Thus, Opposer's motion to compel is premature.

MEMORANDUM OF LAW

According to TBMP 405.03(e), "[i]f a general objection on the ground of excessive number is asserted, and the propounding party, in turn, believes that the objection is not well

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[2] *See Opposer's Motion to Compel* at p. 6.
[3] See *id.* at <u>Exh. F</u>, email from "Ceresia, Scott P." to "Jason L. DeFrancesco," dated February 23, 2015.
[4] Applicant agreed to serve amended interrogatories in compliance with Rule 2.120 (*see* <u>Exh. E</u>).

taken, and wishes to obtain an adjudication from the Board as to the sufficiency thereof, the propounding party must file a motion to compel discovery." TBMP 405.03(e) requires that the motion be accompanied by a copy of the set of interrogatories said to exceed the limitation, and,

> (1) which must otherwise comply with the requirements of 37 CFR § 2.120(e), whereby the Board recommends the moving party set out its counting method showing that the number of interrogatories does not exceed seventy-five (75); and,
>
> (2) must be supported by a written statement from the moving party "that such party or its attorney has made a good faith effort, by conference or correspondence, to resolve with the other party or its attorney the issues presented in the motion and has been unable to reach agreement." *Id.*

Opposer failed to make a good faith effort prior to filing its Motion to Compel Discovery based on Applicant's objection to same based on 2.120(d)(1)

A motion to compel discovery must be supported by a showing that the moving party has made a good faith effort, by conference or correspondence, to resolve the issues with the other party, but that the parties were unable to resolve their differences. See Trademark Rule 2.120(e)(1), 37 CFR § 2.120(e)(1); TBMP § 523.02 (2013). Cf. *The Phillies v. Phila. Consol. Holding Corp*., 107 USPQ2d 2149, 2151 (TTAB 2013). One purpose of this rule is to relieve the Board of the burden of ruling on motions to compel in proceedings where the parties can resolve their discovery disputes if they make a good faith effort to do so. *See MacMillan Bloedel Limited v. Arrow-M Corp*., 203 USPQ 952, 953-954 (TTAB 1979).

While Opposer communicated its "great surprise" that Applicant objects to Opposer's interrogatories "without elaboration," Opposer's dissatisfaction does not discharge it of the duty

to undertake a good faith effort to resolve the dispute. *Hot Tamale Mama...& More, LLC v. SF Inv., Inc*., 2014 TTAB LEXIS 93, 4 (TTAB 2014)("particularly where the inquiring party has received minimal information in response to its initial inquiry").

As explained by *Hot Tamale Mama,* the good faith effort should be directed to "understanding differences *and actually investigating* ways in which to resolve the dispute." *Id.* at 5 (*emphasis added*). Opposer, however, is unable to show its efforts were directed in good faith to resolve the dispute as,

> **Opposer refused to actually investigate / provide its counting methodology to attempt to understand differences in view of Applicants 2.120(d)(1) second objection.**

The Board recommends the moving party set out its counting method showing that the number of interrogatories does not exceed seventy-five (75) when an excessive objection is lodged. See TBMP 405.03(e). Opposer has never provided Applicant with its counting method, but rather demanded the onerous of Applicant's count (which was well in excess of 75). Instead of trying to resolve the dispute, and provide its methodology in return, Opposer merely disagreed with Applicants count[5] and suggests here that its "carefully pared down"[6] amended interrogatories should not be objectionable based on the prior January 8, 2015 phone call. The problem with Opposer's argument is that the January 8, 2015 phone call concerned a prior set of interrogatories. Any discussions regarding a prior set of interrogatories, does not mean that any subsequent or amended set will automatically conform to 37 CFR §2.120(d), and it does not mean that the Applicant has agreed to waive the Trademark Rules or its right to object (which it does not).

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[5] *See Opposer's Motion to Compel*, Exh. F: email from "Ceresia, Scott P." to "Jason L. DeFrancesco," dated February 24, 2015.
[6] *See id*.: email from "Ceresia, Scott P." to "Jason L. DeFrancesco," dated February 23, 2015.

Applicant was acting entirely within the provisions of Trademark Rule 2.120(d)(1) when it elected to object to the number of interrogatories rather than answering them. *See Admin. v. Thug Life Clothing, Co*., 2001 TTAB LEXIS 158 (TTAB 2001). Opposer's subsequent refusal to provide any reasoning as to how its current count of interrogatories conforms with 2.120(d)(1) is rather concerning and quite telling — much as Opposer's allegation that its prior set was in compliance (without any written proof of a count or methodology).[7,8]

CONCLUSION

It is well settled that motions to compel must comply with the special requirements of Trademark Rule 2.120(e) to receive favorable treatment by the Board. See TBMP § 523.02. It is the policy of the Board to intervene in disputes concerning discovery, by determining motions to compel, only where it is clear that (i) the parties have in fact followed the aforesaid process and (ii) have narrowed the amount of disputed requests for discovery. *Sentrol, Inc. v. Sentex Sys*., 1986 TTAB LEXIS 94, 5-6 (TTAB 1986). Opposer is not able to establish good faith because it failed to engage effort toward resolving the dispute. *Hot Tamale Mama...& More, LLC v. SF Inv., Inc*., 2014 TTAB LEXIS 93, 4 (TTAB 2014). The motion to compel should be denied.

IN THE ALTERNATE

Should the Board not find Opposer failed to make a good faith effort to resolve the discover dispute prior to filing the motion to compel, Applicant requests that the Board allow the Applicant the opportunity to respond substantively to the motion.

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[7] *See id.* at p. 6, "Opposer strongly disagreed with Applicant's count of Opposer's [First] Interrogatories."
[8] Prior Interrogatories are attached to *id.*, as Exh. D, and are redlined. See pp. 6–13.

Respectfully, on behalf of Applicant,

Dated: April 13, 2015

BAKER AND RANNELLS, P.A.

By:/Jason DeFrancesco/
Jason DeFrancesco
575 Rte. 28, Ste. 102
Raritan, NJ 08869
(908) 722-5640

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the Applicant's Response in opposition to Opposer's Motion to Compel has been served on Opposer c/o its counsel, by first class mail on this 13th day of April 2015, to,

Joel Karni Schmidt
COWAN LIEBOWITZ & LATMAN PC
1133 Avenue of The Americas
New York, NY 10036

/Jason DeFrancesco/
Jason DeFrancesco