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

Proceeding	91218001
Party	Plaintiff Tod's S.p.A.
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Date	02/02/2016
Attachments	REDACTED - Reply Memorandum of Law - Motion to Amend.pdf(459857 bytes) REDACTED - Reply Decl. of R. Mandel.pdf(2223001 bytes)

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

In re Application Serial No. 86/004,044
Filed: July 8, 2013
For Mark: TOMS
Published in the Official Gazette: April 29, 2014

In re Registration Nos. 4,097,948; 4,192,925; 4,313,981; 4,410,344
Registered: February 14, 2012; August 21, 2012; April 2, 2013; October 1, 2013
For Mark: TOMS

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TOD'S S.P.A.,	:	
	:	
Opposer,	:	
v.	:	Opposition No. 91218001
MYCOSKIE, LLC,	:	
	:	
Applicant.	:	

TOD'S S.P.A.,	:	
	:	
Petitioner,	:	
v.	:	
MYCOSKIE, LLC,	:	Cancellation No. 92061234
	:	
Respondent.	:	

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PUBLIC - REDACTED

**REPLY MEMORANDUM IN FURTHER SUPPORT
OF OPPOSER/PETITIONER'S MOTION TO AMEND**

PRELIMINARY STATEMENT

Mycoskie's papers seek to conflate two separate, unrelated issues by combining its opposition to Tod's motion to amend with a "cross-motion" seeking an oral deposition in New York of Tod's Co-CEO, Stefano Sincini, a resident of Italy. Mr. Sincini has no knowledge regarding the new claim that is the subject of Tod's proposed amendment, as it relates solely to Mycoskie's bona fide intention and is thus based on facts exclusively within Mycoskie's own knowledge. Accordingly, the issues concerning Mycoskie's requested deposition have no bearing on the pending motion to amend and are separately addressed in Tod's opposition to Mycoskie's cross-motion to compel.

With respect to the amendment, Mycoskie has not come forward with any prejudice that would override the Federal Rules' liberal policy favoring amendments. While Mycoskie claims that Tod's should have made its motion sooner, it was not until Tod's completed its 30(b)(6) deposition of the designated witness on Mycoskie's bona fide intention that Tod's was able to verify that it had a valid additional claim for opposition. Tod's received the transcript from that deposition on December 7, 2015 and sought Mycoskie's consent to the amendment within three days on December 10, 2015. After communications between counsel over the next week failed to resolve the amendment issue, Tod's promptly filed its motion to amend on December 17, 2015. Mycoskie's contention that Tod's failed to act quickly enough is not even colorable.

Nor can Mycoskie reasonably argue that it has somehow been prejudiced because Tod's amended pleading drops its previously asserted dilution claim. The notion that a party can be prejudiced by having one less claim against which to defend defies logic. While Mycoskie suggests that it commissioned its survey based on the allegations supporting Tod's dilution claim, the survey at issue was directed solely at likelihood of confusion, which of course remains a disputed issue in the case. Significantly, Mycoskie never asserts that its survey is no longer admissible on the likelihood of confusion issue and it will presumably argue that such survey supports its defense whether or not the TOD'S mark is deemed famous. In any event, the relevance and weight of both parties' likelihood of confusion surveys are appropriately addressed in the context of deciding the merits of this case, and

certainly provide no reason to prevent Tod's from withdrawing the dilution claim that it no longer intends to pursue.

ARGUMENT

I. Tod's Timely Asserted the New Claim for Lack of Bona Fide Intent Following the 30(b)(6) Deposition of Mycoskie's Designated Witness on Such Topic

The Board "generally will grant" motions to amend where, as here, "the proceedings are still in the pre-trial stage" and no testimony has yet been taken. PRL USA Holdings, Inc. v. Young, Opp. No. 91206846 (Docket No. 18)¹ (T.T.A.B. Oct. 16, 2013) at 4; see also United States Olympic Committee v. O-M Bread Inc., 26 U.S.P.Q.2d 1221, 1222 (T.T.A.B. 1993) (applicant not prejudiced where proceeding still in pre-trial phase); Focus 21 Int'l Inc. v. Pola Kasei Kogyo Kabushiki Kaisha, 22 U.S.P.Q.2d 1316, 1318 (T.T.A.B. 1992) (motion to amend filed prior to opening of testimony periods granted); Caron Corp. v. Helena Rubinstein, Inc., 193 U.S.P.Q. 113 (T.T.A.B. 1976) (amendment allowed where neither party had yet taken testimony); Mack Trucks, Inc. v. Monroe Auto Equip. Co., 182 U.S.P.Q. 511, 512 (T.T.A.B. 1974) (no prejudice where no testimony yet taken). Such a result is particularly appropriate where the basis for the new claim is uncovered as a result of information developed through discovery. See, e.g., PRL Holdings, Opp. No. 91206846 (Docket No. 18) at 4 (granting motion to add lack of bona fide intent claim based on information learned during discovery); Jimlar Corp. v. Montrexpert S.p.A., Cancellation No. 92032471 (Docket No. 28) at 6 (T.T.A.B. June 4, 2004)² (granting motion where grounds for claim only revealed through discovery responses); Cashflow Techs., Inc. v. NetDecide, Cancellation No. 92030363, 2002 TTAB LEXIS 147, at *6 (T.T.A.B. Feb. 7, 2002) (copy included in Appendix) (permitting amendment where additional grounds learned after conducting discovery depositions and reviewing discovery responses).

While Mycoskie claims that Tod's could have brought the bona fide intent claim sooner based solely on the documents Mycoskie produced (or failed to produce) in discovery, the record shows that

¹<http://ttabvue.uspto.gov/ttabvue/v?pno=91206846&pty=OPP&eno=18>

²<http://ttabvue.uspto.gov/ttabvue/v?pno=92032471&pty=CAN&eno=28>

Tod's proceeded in a reasonable fashion by only seeking to amend after it had taken depositions to confirm the claim's validity. Mycoskie produced more than 11,000 pages in response to Tod's discovery requests in February 2015. Mandel Reply Decl. ¶ 3. It was apparent from such production and subsequent communications between counsel that Mycoskie did not have documentation reflecting its intention with respect to every one of the numerous Class 18 goods listed in its application. Id. However, it was not clear from this production precisely which of the goods Mycoskie considered to be encompassed by the documents it produced without further explanatory testimony. Id. ¶ 4 & Ex. 1. More important, given that Mycoskie had produced documentation relating to at least some of the Class 18 goods, it was not clear whether Mycoskie would be able to offer countervailing evidence of some other kind supporting its intention with respect to those goods for which no documentation existed. Id. ¶ 5. See, e.g., Commodore Elecs. Ltd. v. CBM Kabushiki Kaisha, 26 U.S.P.Q.2d 1503, 1507 (T.T.A.B. 1993) (“[W]e hold that absent other facts which adequately explain or outweigh the failure of an applicant to have any documents supportive of or bearing upon its claimed intent to use its mark in commerce, the absence of any documentary evidence on the part of an applicant regarding such intent is sufficient to prove that applicant lacks a bona fide intention to use its mark ...”) (emphasis added). Accordingly, rather than rushing to assert a claim that might ultimately prove unsupported after further discovery, Tod's made the responsible and reasonable decision to pursue deposition testimony in order to further explore the facts concerning Mycoskie's bona fide intention. Mandel Reply Decl. ¶ 5.

Depositions of both sides did not proceed until the Fall of 2015 because the parties agreed to wait for the consolidation of Tod's cancellation proceeding with its pending opposition in order to avoid the need for duplicative depositions.³ Id. ¶ 6. Tod's' October 1, 2015 30(b)(6) notice contained three topics specifically addressed to the bona fide intent issue:

³Mycoskie's opposition papers disingenuously assert that “discovery had nearly concluded in the Opposition Proceeding” as of April 2015 when Tod's indicated its intention to bring a cancellation petition with respect to certain of Mycoskie's registrations. Mycoskie Opp. at 5. However, discovery was going to have to be extended in that proceeding regardless of the cancellation petition in order to permit sufficient time for depositions to be completed before the May 2, 2015 deadline. Mandel Reply

13. Any business plans, marketing plans, memos, correspondence or draft proposals of any kind reflecting Mycoskie's bona fide intent prior to or as of July 8, 2013 to use Mycoskie's TOMS Mark in the United States in connection with each of the goods identified in the Application.

14. All steps taken by Mycoskie prior to July 8, 2013 in connection with the intended use of Mycoskie's TOMS Mark in the United States in connection with each of the goods identified in the Application.

15. All steps taken by Mycoskie on or after July 8, 2013 in connection with the intended use of Mycoskie's TOMS Mark in the United States in connection with each of the goods specified in the Application.

Mandel Reply Decl. ¶ 7; see also Mandel Moving Decl. Ex. C. Although Mycoskie served objections to certain of the topics in the notice, it did not assert any objection with respect to the bona fide intent topics

13-15. Mandel Reply Decl. ¶ 8 & Ex. 2. On October 20, 2015, Mycoskie's counsel sent an email identifying Brigid Stevens as the only designee with respect to those topics. Id. ¶ 9 & Ex. 3.

Significantly, Jessica Murray, who now offers a declaration about the facts concerning Mycoskie's alleged bona fide intent and whom Mycoskie claims should have been questioned further on this topic,⁴ was not designated for any of the three topics concerning Mycoskie's bona fide intent. Id. Moreover, the designations contained in the October 20, 2015 email of Mycoskie's counsel were confirmed at the start of both Ms. Murray's and Ms. Stevens' deposition, without any indication of a change with respect to topics 13-15. Id. & Ex. 4.

Ms. Stevens' deposition testimony provided a clear basis for the new claim Tod's seeks to assert based on Mycoskie's lack of bona fide intent with respect to certain products. [REDACTED]

[REDACTED]

[REDACTED] See Mandel Moving Decl. Ex. D. Mycoskie's argument that Tod's should have asked about Mycoskie's intentions as

Decl. ¶ 6. Both sides agreed to the consolidation and to conduct depositions following that consolidation so that the depositions could be taken once without the need for repetitive depositions of the same witnesses. Id.

⁴Although Mycoskie actually indicates that Ms. Murray would have testified that "Tod's had every intention of using its TOMS mark" (Mycoskie Opp. at 10 n. 3), it presumably meant that Toms had such an intention and simply confused the names given their close similarity.

of the filing date of the application rather than its present plans misses the point. Tod's already had sufficient evidence of the absence of an intention as of the filing date based on the lack of any contemporaneous documentation supporting such an intention – [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED].⁵ Mandel Reply Decl. ¶ 10.

Moreover, Mycoskie's current lack of intent is itself sufficient to support a claimed lack of bona fide intent. Thus, for example, in Swiss Army Brand Ltd. v. Dempsey, Opp. No. 91175614 (Docket No. 13)⁶ (T.T.A.B. April 17, 2008), the Board granted summary judgment on applicant's lack of bona fide intent based on his unequivocal admission in discovery that "he does not intend to use the IRISH ARMY KNIFE mark for folding knives." Id. at 4-5. The Board found as a matter of law based on such admission "that applicant did not have at the time the application was filed (nor does he continue to have), the required bona fide intent to use the mark in commerce" Id. at 7. Tod's has certainly developed sufficient evidence here to justify assertion of the claim that Mycoskie lacked a bona fide intent to use as of the filing date of the application, and that Myscoskie does not continue to have such an intention now,⁷ with respect to the specified Class 18 products.

Mycoskie can point to no prejudice in permitting the amendment.⁸ The mere addition of a new issue does not constitute the type of prejudice necessary to overcome Rule 15's liberal policy favoring

⁵The cases cited by Mycoskie are readily distinguishable in that none of them involved a situation where the new claim was based on facts learned through the discovery process. Moreover, the delay was generally far more substantial, such as in Media Online Inc. v. El Clasificado, Inc., 88 U.S.P.Q.2d 1285 (T.T.A.B. 2008) and Kellogg Co. v. Shakespeare Co., 2005 TTAB LEXIS 284 (T.T.A.B. June 30, 2005), in which the amendment was only sought after the defendant's filing of a dispositive motion.

⁶<http://ttabvue.uspto.gov/ttabvue/v?pno=91175614&pty=OPP&eno=13>

⁷An intent-to-use applicant must maintain such an intention throughout the application process. Cf. 15 U.S.C. § 1051(d)(2) (requiring verified statement of applicant's continuing bona fide intention to use mark in order to obtain extension of time to file statement of use).

⁸While Mycoskie's claim of undue delay is unfounded based on the discovery timeline addressed above, delay alone does not justify denial of a motion to amend in the absence of prejudice. See, e.g.,

amendment. See, e.g., Montblanc-Simplo GmbH v. United Brands Int'l., Inc., Opp. No. 91185637 (Docket No. 10)⁹ at 4-5 (T.T.A.B. Sept. 29, 2009) (permitting motion to amend to add lack of bona fide intent based primarily on information learned during deposition of applicant's representative; liberal policy favoring amendments applies "even when a plaintiff seeks to amend its complaint to plead a claim other than those stated in the original complaint"). In addition, no additional discovery is required inasmuch as the claim turns on facts solely within Mycoskie's own knowledge.¹⁰ See Jimlar, Cancellation No. 92032471 (Docket No. 28) at 6-7 (no need to reopen discovery where respondent possesses all of the information concerning the filing of its combined section 8 and 15 declaration). Accordingly, the amendment should be permitted.

II. There is No Basis for Preventing Tod's From Dropping its Dilution Claim

As discovery was drawing to a close and Tod's began the process of preparing for trial, it determined that it would not pursue a claim for dilution. Mandel Reply Decl. ¶ 11. The net effect of such decision is that Mycoskie need not defend against this claim at trial. Apparently not content with such a benefit, Mycoskie takes the position that Tod's is somehow required to maintain the dilution claim and allegations because Mycoskie believes they assist certain of its arguments in defending against the remaining likelihood of confusion claim.

Bell v. Allstate Life Ins. Co., 160 F.3d 452, 454 (8th Cir. 1998) (delay alone insufficient to deny motion to amend; prejudice must be shown); Cashflow Techs., 2002 TTAB LEXIS 147, at *5 (delay in seeking leave to amend is not in and of itself reason to deny motion to amend); Marshall Field & Co. v. Mrs. Field's Cookies, 11 U.S.P.Q.2d 1355, 1359 (T.T.A.B. 1989) ("the concept of 'undue delay' is inextricably linked with the concept of prejudice to the non-moving party").

⁹<http://ttabvue.uspto.gov/ttabvue/v?pno=91185637&pty=OPP&eno=10>

¹⁰ Ironically, it appears that Mycoskie is the party that wishes to reopen discovery if the bona fide intent claim is allowed in order to supplement its production with additional documents not produced and identify new witnesses with knowledge that its designated 30(b)(6) witness lacked. See Mycoskie Opp. at 18 n. 12. However, a party that fails to produce a knowledgeable 30(b)(6) witness will be estopped from introducing information not provided during a 30(b)(6) discovery deposition. See Toni & Guy (USA) Ltd. v. Nelson, Cancellation No. 92040118 (Docket No. 21) (T.T.A.B. Mar. 30, 2004), at 23, <http://ttabvue.uspto.gov/ttabvue/v?pno=92040118&pty=CAN&eno=21> (citing TBMP § 527.01(e)). Having failed to produce documentation relating to the products at issue, and having required Tod's to travel to California for a deposition of a 30(b)(6) witness who plainly had no knowledge regarding Mycoskie's bona fide intent, Mycoskie should be limited in its defense of the bona fide intent claim to the evidence previously provided.

There is no basis for denying Tod's' amendment under these circumstances. Indeed, where an amendment includes the dropping of a claim, the Board has not even bothered to analyze that portion of the amendment under the governing standards. See, e.g., Amazon.com, Inc. v. Kalaydjian, Opp. No. 91122000 (Docket No. 37)¹¹ (T.T.A.B. June 2, 2006) (granting amendment to add allegations and withdraw dilution claim five years after original pleading without even analyzing withdrawal portion of amendment); Rodale, Inc. v. Healthy Heart Review, Inc., Opp. No. 91151405 (Docket No. 26)¹² at 3 n. 1 & 5-7 (T.T.A.B. Feb. 23, 2004) (treating claims expressly dropped in motion to amend as withdrawn despite denial of amendment seeking to add new claims). Such an approach is not surprising, as a party may always choose to streamline its case by not pursuing certain claims at trial. While Tod's thus did not even require an amendment to forego its dilution claim, it withdrew such claim as part of its proposed amendment so that the operative pleading would reflect the actual claims to be tried. Mandel Reply Decl. ¶ 11.

Mycoskie nevertheless insists that the withdrawal of the dilution claim (and its corresponding allegation of fame) prejudices it because of the purported impact on the likelihood of confusion surveys conducted by the parties' experts. However, Mycoskie does not claim that it is no longer able to offer its survey as a result of Tod's' amendment. To the contrary, Mycoskie's expert, Dr. Deborah Jay, will presumably continue to claim, as she did in her report, that the Eveready format is "the most utilized and accepted survey format for assessing likelihood-of-confusion in Board proceedings." See Ederer Decl. Ex. 24 at 2 n.3. And she will presumably continue to criticize Tod's' use of a Squirt format based on her contention – contrary to Mycoskie's own pleading¹³ – that the parties' goods are frequently not sold in the same retail locations. Id.

¹¹<http://ttabvue.uspto.gov/ttabvue/v?pno=91122000&pty=OPP&eno=37>

¹²<http://ttabvue.uspto.gov/ttabvue/v?pno=91151405&pty=OPP&eno=26>

¹³See Ederer Decl. Ex. 7 at p.5, Facts Common to all Affirmative Defenses ¶ 5 ("Since at least as early as May 2006, identical and/or related products and services bearing the TOMS Marks and Opposer's TOD'S mark have coexisted in the United States – frequently being sold in the very same retail

Likewise, Mycoskie’s suggestion that “if Tod’s proposed amendment is not allowed, then its rebuttal goes out the window” (Mycoskie Opp. at 18) is wishful thinking. Tod’s’ rebuttal expert, Sarah Butler, opines that the Squirt format is best suited to measuring confusion in the circumstances of this case for a number of reasons. Among other things, she explains that contrary to Dr. Jay’s unsupported contention, the parties’ products are frequently sold in the same retail locations, according to Mycoskie’s own pleadings and her independent research. See Ederer Decl. Ex. 30 ¶¶ 26-29 at pp. 17-18. She further explains how the data from Dr. Jay’s survey suggests that consumers were merely reading the TOMS name above the long list of goods provided and defaulting to that name in their responses. Id. ¶¶ 21-23 at pp. 11-16. Finally, with respect to the allegation of fame on which Mycoskie focuses, Ms. Butler opines that “[w] hile TOD’S is likely a well-known brand name within a luxury or high end market, it is unlikely to be a ‘household name’” of the type required for dilution purposes. Id. ¶ 20 at p. 10. Although she incidentally references Tod’s’ proposed amendment in a footnote, her conclusion is not based on the amendment, but on her own assessment of the marketplace realities – a conclusion with which Mycoskie itself undoubtedly agrees. Thus, regardless of whether the amendment is permitted, Tod’s will offer the rebuttal testimony and survey of Ms. Butler, and Mycoskie can argue that it should be ignored even though Mycoskie accepts the key factual premises underlying Ms. Butler’s opinion, namely, the level of fame the TOD’S mark enjoys and the competitive proximity of the parties’ products in the marketplace.

As the above discussion makes clear, issues regarding the parties’ surveys will remain for trial regardless of the disposition of this motion. These complex questions are best addressed and decided during the merits phase of the case rather than as part of a motion to amend a pleading. While Mycoskie repeatedly argues that Tod’s’ motion to amend should be denied on the basis of Tod’s’ alleged bad faith, there is no basis for such a conclusion.¹⁴ Even crediting Mycoskie’s argument that Tod’s’ amendment

locations, including, without limitation, the Nordstrom and Neiman Marcus department store chains ...”); Ederer Decl. Ex. 25 at p. 7, Facts Common to all Affirmative Defenses ¶ 5 (same).

¹⁴The cases on which Mycoskie relies do not support denial of Tod’s’ amendment. Indeed, in Larios v. Nike Retail Servs., 2013 U.S. Dist. LEXIS 112761 (S.D. Cal. Aug. 9, 2013), the Court actually granted the motion to amend despite the fact that it was the plaintiff’s third amendment. In Rusyniak v.

was motivated in part by a desire to support the Butler rebuttal evidence, “[a] change in litigation strategy is a legitimate reason for seeking to amend a pleading under the liberal standard of Rule 15(a).” Duling v. Gristede’s Operating Corp., 265 F.R.D. 91, 98 (S.D.N.Y. 2010). See also Town of New Windsor v. Tesa Tuck, Inc., 919 F. Supp. 662, 676 (S.D.N.Y. 1996) (“[N]either long delay nor the fact that a proposed amendment is motivated by an afterthought of counsel as to the best theory upon which to proceed, by themselves, suffice as reasons for denying leave to amend”). The Federal Rules are not designed to lock counsel into a litigation strategy, but to facilitate a proper decision on the merits. Id. at 677. Because Tod’s’ amendment serves the purpose of fostering a correct decision based on the actual facts developed in discovery, the amendment should be allowed.

CONCLUSION

For all these reasons and those stated in Tod’s’ moving papers, the motion to amend should be granted.

Dated: New York, New York
February 2, 2016

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Gensini, 629 F. Supp. 2d 203 (N.D.N.Y. 2009), the Court denied the motion in part, but only on grounds of futility. Lee v. Regal Cruises, 916 F. Supp. 300 (S.D.N.Y. 1996) involved a complete change of theory following the defendant’s filing of a summary judgment motion and 10 months after the court-ordered cutoff date for amendments. And as noted above, the Kellogg and Media Online cases also involved attempts to amend to assert new claims after the filing of dispositive motions. See n. 5 supra.

APPENDIX

2002 TTAB LEXIS 147

Trademark Trial and Appeal Board

February 07, 2002, Decided

Cancellation No. 30,363; Cancellation No. 30,364

Reporter

2002 TTAB LEXIS 147

CashFlow Technologies, Inc. v. NetDecide

Core Terms

discovery, summary judgment motion, abandonment, cancel, motion to amend, reopen, amended pleading, cash flow, summary judgment, deposition, partial, mail, genuine issue of material fact, amendment of a pleading, additional ground, amended petition, motion in limine, suspend, moot

Panel: Before Hohein, Walters and Rogers, Administrative Trademark Judges.

Opinion

By the Board:

NetDecide Corporation owns Reg. No. 2,209,531, issued on December 8, 1998 for the mark CASHFLOW for "computer software for individual financial modeling, management, planning, and online financial data transactions," and Reg. No. 2,298,545, issued on December 7, 1999 for the mark CASHFLOW and design, as reproduced below,



for "computer software for individual financial modeling, management, planning and online financial data transactions." On March 27, 2000, Cashflow Technologies filed separate petitions to cancel the registrations on the ground that respondent had abandoned its marks.

On October 6, 2000, the Board consolidated proceedings, with Cancellation No. 30,363 identified as the parent case.

On May 10, 2001, the Board reset discovery and trial dates, setting the close of discovery for June 10, 2001, and the trial period to commence on August 10, 2001.

This case now comes before the Board on the following motions: ¹

¹ While petitioner, on July 15, 2001, filed a motion to suspend and reschedule trial dates, proceedings were suspended on July 31, 2001 pending disposition of petitioner's motion to amend. Additionally, on August 16, 2001, the Board amended the suspension order to also suspend proceedings pending disposition of the parties' motions for summary judgment. Accordingly, petitioner's motion to suspend is moot.

- 1) petitioner's motion to extend discovery, filed June 11, 2001;²
- 2) petitioner's motion to amend the petition to [*2] cancel, filed July 15, 2001;
- 3) respondent's motion for summary judgment, filed August 2, 2001 (and served via certificate of mailing on August 2, 2001);
- 4) petitioner's motion in limine or alternative motion to reopen, filed August 6, 2001;
- 5) petitioner's motion for summary judgment, filed August 7, 2001;
- 6) petitioner's request for clarification of the Board's order of August 16, 2001, filed September 4, 2001; and
- 7) petitioner's request for 56(f) discovery, filed September 6, 2001.

The motions are fully briefed.

Petitioner's Motion to Amend

We turn first to petitioner's motion to amend. Petitioner [*3] requests leave to amend the petitions to cancel to add the additional grounds of descriptiveness and "partial cancellation" based on abandonment or nonuse.³

In support of its motion, petitioner argues that amendment of the petitions to cancel is appropriate because evidence produced during discovery has given rise to the new grounds for cancellation as set forth in the amended pleadings; that the amended pleadings conform to the evidence furnished by the respondent during discovery; that the amendment is not prejudicial to respondent; and that justice requires the amendment.

In response, respondent argues that amendment of the pleadings was not proposed within a reasonable time and that petitioner's motion to amend "at this [*4] late stage of these proceedings" prejudices respondent; that respondent will face undue prejudice if amendment of the pleadings is allowed, because respondent was not apprised of the additional grounds during discovery; and that petitioner's "suggested solution [to the problem of prejudice from amendment of the pleadings i.e.,] reopening discovery" also prejudices respondent by delaying adjudication of this case.

In reply, petitioner argues that filing its motion to amend 35 days after discovery closed does not constitute undue delay;⁴ that its motion to amend was filed three and a half weeks prior to the opening of the first testimony period; and that respondent has not explained why any prejudice would not be cured by reopening the discovery period, to which petitioner indicates it would consent.

The Board liberally grants leave to amend pleadings at any stage of a proceeding when justice [*5] so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties. See Fed. R. Civ. P. 15(a) and TBMP Section 507.02. See also *American Optical Corp. v. American Olean Tile Co.*, 168 USPQ 471 (TTAB 1971).

In deciding whether to grant leave to amend, a tribunal may consider undue delay, prejudice to the opposing party, bad faith or dilatory motive, futility of the amendment, and whether the party has previously amended its pleadings. See *Foman v. Davis*, 371 U.S. 178, 182, (1962).

² June 10, 2001 was a Sunday. Pursuant to Patent Rule 1.7, made applicable by Trademark Rule 2.1, petitioner's motion to extend was timely.

³ Rather than partial cancellation, it appears that petitioner is requesting a restriction to respondent's registrations by limiting the description of goods in each registration. The proposed restriction to the identification of goods for both registrations is "custom-configured enterprise server software for individual financial modeling, management, planning and online financial data transactions; the software marketed to financial professionals."

⁴ Petitioner indicates that it received the deposition transcript of third party Legg Mason on June 20, 2001 and the errata sheet for the deposition of NetDecide officer Evan Burfield on July 5, 2001, and states that the motion to amend was filed ten days thereafter, on July 15, 2001.

Generally, delay in seeking leave to amend a pleading is not in and of itself a reason to deny a motion to amend. However, the Board may deny a motion to amend when the movant knew or should have known of the facts upon which the amendment is based when the original pleading was filed, and the movant offers no excuse for the delay. See *Capital Speakers Inc. v. Capital Speakers Club of Washington D.C. Inc.*, 41 USPQ2d 1030 (TTAB 1996).

In this case, discovery closed on June 10, 2001, and petitioner filed its motion to amend on July 15, 2001. In [*6] its motion to amend, petitioner asserts that it only became aware of the additional grounds for cancellation after conducting discovery depositions and after reviewing respondent's discovery responses. While petitioner has admitted that there was a delay between the time it became aware of the additional grounds and the time of filing its motion, we do not consider the delay to be unreasonable.

Additionally, we are not persuaded by respondent's claim of prejudice regarding its inability to conduct discovery or present testimony on matters raised in petitioner's amended pleadings inasmuch as that prejudice can be overcome by reopening discovery on those issues. See, e.g. *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990); *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985); see also Beth A. Chapman, TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff, 81 *Trademark Rep.* 302, 305 (1991). Moreover, since petitioner's proposed restriction claim speaks to activity or inactivity of respondent, respondent should not need much, if any, discovery. Accordingly, we find that allowance of the proposed amendment would not be prejudicial [*7] to respondent.

In view thereof, petitioner's motion to amend is granted insofar as we allow the additional claims of descriptiveness and partial restriction to be added to the petitions to cancel.⁵ In the event proceedings are not disposed of by the motions for summary judgment, limited discovery will be reopened for a brief period for both parties.

Petitioner's Motion for 56(f) Discovery

Turning next to petitioner's motion for 56(f) discovery in connection with respondent's motion for summary judgment, petitioner seeks to take the deposition of non-party EER (as well as non-parties Bank of America Investments and Robert W. Baird) so as to determine the nature of EER's use and the manner in which the CASHFLOW term was used and thus enable petitioner to obtain evidence to challenge respondent's "new allegation of commercial use by ordinary consumers," and to "clear up inconsistencies between respondent's testimony and statements made in the summary judgment motion." Petitioner's declaration under [*8] Trademark Rule 2.20 states that the deposition of EER "may establish nonuse or a prima facie case of abandonment. "

In response, respondent argues that petitioner has not demonstrated why it cannot, based on the record and any affidavits it could proffer, oppose respondent's motion for summary judgment, but rather, has only indicated in a conclusory manner that it needs additional discovery to respond to the motion for summary judgment.

Fed. R. Civ. P. 56(f) provides, in pertinent part, that a party which believes that it cannot effectively oppose a motion for summary judgment without first taking discovery may file a request with the Board to take the needed discovery. The request must be supported by an affidavit showing that the nonmoving party cannot, for reasons stated, present by affidavit facts essential to justify its opposition to the motion. See also *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); and *Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989).

In this case, nothing in petitioner's declaration indicates [*9] the specific issues to which it cannot respond or why it cannot oppose respondent's motion for summary judgment without the discovery deposition of non-party EER. In fact, petitioner

⁵ As discussed later in this opinion, plaintiff will have to amend its abandonment claim. Thus we have not set a time for respondent to answer the amended petitions here.

has already fully responded to respondent's motion for summary judgment. Thus, petitioner's request for 56(f) discovery is without merit.⁶

A party cannot engage in a "fishing expedition" in hopes of gathering some evidence to help its case. See T. Jeffrey Quinn, *TIPS FROM THE TTAB: Discovery Safeguards in Motions for Summary Judgment: No Fishing Allowed*, 80 *Trademark Rep.* 413 (1990); and *Keebler Co.*, *supra*, 866 F.2d 1389, 9 USPQ2d at 1738-1739. Inasmuch as petitioner has fully responded to respondent's motion for summary judgment, petitioner's request for 56(f) discovery is denied.

The Summary Judgment Motions

We now turn to the parties' motions for summary judgment, each on different grounds.

Summary judgment is an appropriate method of disposing of cases [*10] in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). The party moving for summary judgment has the initial burden of demonstrating the absence of any genuine issue of material fact. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986), and *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable finder of fact could resolve the matter in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992), and *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). The evidence must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993), and *Opryland USA*, *supra*.

*Petitioner's Motion for [*11] Summary Judgment*

We consider petitioner's motion for summary judgment first.⁷ Petitioner moves for summary judgment on the ground that there is no genuine issue that respondent's CASHFLOW marks are merely descriptive.

In response, respondent has only argued that petitioner's motion for summary judgment is based on an unpleaded issue and should be denied.

Inasmuch as respondent has not had an opportunity to respond to petitioner's motion for summary judgment, and in view of our granting petitioner's motion to amend to add the ground of descriptiveness earlier in this order, a decision on petitioner's motion for summary judgment would be premature without briefing by respondent. Accordingly, a decision on petitioner's motion for summary judgment on the ground of descriptiveness is hereby deferred pending the filing by respondent of a response on the merits.

Petitioner's Motion for Clarification

Petitioner's motion for [*12] clarification, filed September 4, 2001 (in conjunction with petitioner's reply in support of its motion for summary judgment), requesting that the Board clarify whether respondent needs to file a response on the merits to petitioner's motion for summary judgment is moot.

Respondent is allowed until SIXTY DAYS from the mailing date of this order to file its response to petitioner's motion for summary judgment on the ground of descriptiveness, and petitioner is allowed until SEVENTY-FIVE DAYS from the mailing date of this order to file a reply.⁸

Respondent's Motion for Summary Judgment

⁶ We note that most of the discovery petitioner has requested in its motion relates to general discovery and does not go to specific issues raised in respondent's motion for summary judgment.

⁷ We construe petitioner's motion as a motion for partial summary judgment in that petitioner has alleged three different grounds for cancellation under the amended petitions to cancel but has only moved for summary judgment on one of those grounds.

⁸ These deadlines account for deadlines set, *infra*, in regard to amendment of the pleadings.

We now consider respondent's motion for summary judgment on the ground that there is no genuine issue that it has abandoned its CASHFLOW trademarks, which are the subjects of Reg. Nos. 2,209,531 and 2,298,545. We have carefully considered the parties' arguments and evidence in the record before us.

Initially, we find that petitioner has not pleaded a valid claim of abandonment under either the original petitions to cancel or the amended petitions to cancel, so as to provide fair notice to respondent [*13] of the theory of abandonment. It is well settled that in order to set forth a claim on the ground of abandonment, a petitioner must allege ultimate facts pertaining to the alleged abandonment. See *Clubman's Club Corporation v. Martin*, 188 USPO 455, 456 (TTAB 1975). In this case, petitioner has provided no facts to support its conclusory allegation of abandonment in paragraph no. 4 of the original petitions to cancel (or paragraph 5 of the first amended petitions to cancel). Accordingly, petitioner's pleading of abandonment is legally insufficient, and a further amended pleading properly setting forth a claim of abandonment is required.

Nevertheless, the matter before us is, in any event, whether respondent has established the absence of any genuine issue of material fact regarding petitioner's claim of abandonment. If not, the motion may be denied now, without regard to any potential amended claim of abandonment.

We conclude that genuine issues of material fact exist, at a minimum, regarding whether respondent's use of the CASHFLOW marks constitutes commercial trademark use of the type common to the particular industry to which respondent belongs; and whether for [*14] purposes of maintaining or establishing trademark use, respondent's use would be considered deliberate and continuous use, or at least constitute an active and public attempt to establish such a trade in the goods.⁹

Accordingly, respondent's motion for summary judgment is denied.

Amendment of Pleadings

In view of the insufficiency of petitioner's pleading of abandonment of its original and amended pleadings, as discussed above, petitioner is allowed until THIRTY DAYS from the mailing date of this order to file amended petitions to cancel which sufficiently set forth a claim of abandonment, whether through pleading of a prima facie case under the statute or by pleading specific facts supporting petitioner's theory of abandonment, failing which, the Board will consider the abandonment claim to have been withdrawn, and proceedings will go forward on the claims of descriptiveness and partial restriction as set [*15] forth in the first amended pleadings. Respondent is allowed until SIXTY DAYS from the mailing date of this order to file an answer to petitioner's prospective amended pleadings, if filed. In the event that no further amended pleadings are filed by petitioner, respondent is allowed until SIXTY DAYS from the mailing date of this order to file amended answers to the first amended pleadings. Respondent's time to file amended answers will not be extended, and failure to respond within the time set forth in this order will place respondent in default.

Motion in Limine

Turning next to petitioner's motion in limine, petitioner asks the Board to prospectively exclude any evidence regarding commercial use by respondent which might be presented by respondent at trial, to the extent that such evidence is inconsistent with respondent's discovery responses, or consists of material respondent failed to produce in discovery.

Petitioner's motion in limine is denied. It is not the Board's practice to make prospective or hypothetical evidentiary rulings such as those requested by petitioner. See *Greenhouse Systems Inc. v. Carson*, 37 USPO2d 1748, 1750 (TTAB 1995).

[*16] Motion to Extend/Reopen Discovery

We now turn to petitioner's motion to extend, filed June 11, 2001, and petitioner's alternative motion to reopen, filed August 6, 2001. In view of the Board's decision granting petitioner's motion to amend the petitions, and the determination

⁹ The fact that we have identified and discussed only a few genuine issues of material fact as reasons for denying respondent's motion for summary judgment should not be construed as a finding that these are necessarily the only issues which remain for trial.

that, should proceedings resume, a brief reopening of the discovery period would be warranted, petitioner's motion to extend discovery and alternative motion to reopen discovery are moot.

Summary

In summary, petitioner's motion to amend is granted to the extent that petitioner may plead the additional grounds of descriptiveness and partial cancellation; petitioner's pleading of abandonment in both the original and amended pleadings is insufficient and must be amended as discussed herein; petitioner's motion for clarification is moot; petitioner's motion to extend and alternative motion to reopen are moot; petitioner's motion in limine is denied; petitioner's motion for 56(f) discovery is denied; respondent's motion for summary judgment is denied; and petitioner's motion for summary judgment on the ground of descriptiveness is deferred pending submission of a brief on the merits by respondent, and, [*17] should proceedings resume, limited discovery will be reopened for a brief period for the parties.

Proceedings presently remain otherwise suspended pending further briefing of and a decision on petitioner's motion for summary judgment. Any paper filed during the pendency of petitioner's motion for summary judgment which is not relevant thereto will be given no consideration.

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

In re Application Serial No. 86/004,044
Filed: July 8, 2013
For Mark: TOMS
Published in the Official Gazette: April 29, 2014

In re Registration Nos. 4,097,948; 4,192,925; 4,313,981; 4,410,344
Registered: February 14, 2012; August 21, 2012; April 2, 2013; October 1, 2013
For Mark: TOMS

-----	X	
TOD'S S.P.A.,	:	
	:	
Opposer,	:	
v.	:	Opposition No. 91218001
MYCOSKIE, LLC,	:	
	:	
Applicant.	:	

TOD'S S.P.A.,	:	
	:	
Petitioner,	:	
v.	:	
MYCOSKIE, LLC,	:	Cancellation No. 92061234
	:	
Respondent.	:	
-----	X	

PUBLIC -- REDACTED

**REPLY DECLARATION OF RICHARD S. MANDEL IN FURTHER
SUPPORT OF OPPOSER/PETITIONER'S MOTION TO AMEND**

RICHARD S. MANDEL, pursuant to 28 U.S.C. §1746, declares:

1. I am a shareholder of Cowan, Liebowitz & Latman, P.C., attorneys for Opposer/Petitioner Tod's S.p.A ("Tod's"). I submit this reply declaration in further support of Opposer/Petitioner's motion to amend in order to bring certain additional facts and documents to

the Court's attention addressing the contention by Applicant/Respondent Mycoskie LLC ("Mycoskie") that Tod's unduly delayed in seeking the proposed amendment.

2. Mycoskie contends that Tod's should have sought to add the new claim based on lack of bona fide intent sooner. However, a review of the relevant history shows that Tod's proceeded in a reasonable fashion by first fully exploring all relevant facts through a 30(b)(6) deposition of Mycoskie's designated witness on bona fide intent before determining that it had a viable claim. Tod's promptly moved for leave to amend following a review of that deposition.

3. The document productions made in this case by both sides were voluminous. In the case of Mycoskie, it produced more than 11,000 pages of documents in February 2015 covering a vast range of topics going far beyond Mycoskie's bona fide intent. Because it was not apparent whether any documents concerning the Class 18 goods at issue in the opposition predated the July 8, 2013 filing date of the application, the parties had further communications regarding that subject in March 2015, as reflected in Exhibits 12 and 13 to the Declaration of Louis Ederer submitted in opposition to Tod's' motion.

4. In his March 20, 2015 letter (Ex. 13 to the Ederer Declaration), Mycoskie's counsel identified certain documents purportedly relating to its bona fide intent prior to July 8, 2013. Copies of the identified documents are attached hereto as Exhibit 1. It was apparent from the identified documents that Mycoskie did not have documentation reflecting its intention with respect to every one of the numerous Class 18 goods listed in the opposed application. However, as a review of Exhibit 1 shows, it was not clear precisely which of the numerous applied-for goods Mycoskie deemed to be covered by its production without further explanatory testimony. For example, at her deposition, Mycoskie's 30(b)(6) witness explained that it had introduced small bags that are of the same size as cosmetics bags, even though it had not branded the

products or spoken of them as cosmetics bags. See p. 115 of Brigid Stevens deposition attached as Exhibit D to my moving declaration.¹

5. More important, the document production could not answer whether Mycoskie would be able to offer other countervailing evidence of some kind that might adequately explain or outweigh its failure to have any documents supporting its bona fide intent for certain products. Given that Mycoskie had produced documentation relating to at least some of the Class 18 goods covered by its application, Tod's believed it was more prudent to pursue additional discovery in the form of deposition testimony rather than rushing to assert a claim that might ultimately prove unsupported. Such a decision to further explore the facts concerning Mycoskie's bona fide intent in order to confirm that a valid claim existed and what products it covered was a reasonable and responsible one, and Tod's should not be penalized for avoiding the sue first, ask questions later approach that Mycoskie apparently believes it should have adopted.

6. Depositions of both sides did not proceed until the Fall of 2015, with Mycoskie taking depositions of Tod's' witnesses in October and Tod's deposing Mycoskie's witnesses in November. The parties had agreed to conduct such depositions after the consolidation of Tod's' cancellation proceeding, which was instituted on April 8, 2015, with its pending opposition. Although Mycoskie's papers try to create the illusion that the filing of the cancellation caused undue delay, the reality is that an extension would have been necessary to complete discovery in the opposition regardless of the institution of the cancellation proceeding. As of April 2015, no depositions of either side had been taken or even noticed, and such depositions would not have

¹This page was originally filed under seal because Mycoskie had not yet completed its review of the transcript for confidentiality designations under the protective order. As page 115 has no longer been designated as either TRADE SECRET or CONFIDENTIAL, the reference in this declaration to that page of testimony has been publicly filed. For the Board's information, pages 117-119 of the Stevens transcript, which were also included in Exhibit D to my moving declaration, continue to be designated by Mycoskie as CONFIDENTIAL.

been completed by the May 2, 2015 deadline then in effect in the opposition. Mr. Ederer and I agreed that it made sense to conduct depositions of all witnesses only once for purposes of both proceedings rather than having separate depositions in each proceeding. Accordingly, the parties agreed to postpone all depositions until after the consolidation of the two proceedings, which was ordered on consent on May 28, 2015, and such depositions were ultimately scheduled for October and November.

7. The 30(b)(6) deposition notice of Mycoskie served on October 1, 2015 (Exhibit C to my moving declaration) contained three topics specifically addressed to the issue of Mycoskie's bona fide intent:

13. Any business plans, marketing plans, memos, correspondence or draft proposals of any kind reflecting Mycoskie's bona fide intent prior to or as of July 8, 2013 to use Mycoskie's TOMS Mark in the United States in connection with each of the goods identified in the Application.

14. All steps taken by Mycoskie prior to July 8, 2013 in connection with the intended use of Mycoskie's TOMS Mark in the United States in connection with each of the goods identified in the Application.

15. All steps taken by Mycoskie on or after July 8, 2013 in connection with the intended use of Mycoskie's TOMS Mark in the United States in connection with each of the goods specified in the Application.

8. Although Mycoskie served objections with respect to certain topics in Tod's' 30(b)(6) deposition notice, as reflected in the written objections attached hereto as Exhibit 2, it did not assert any objections with respect to the three topics (13-15) concerning bona fide intent detailed in paragraph 7 above.

9. On October 20, 2015, Mycoskie's counsel sent me an email containing Mycoskie's designations of witnesses with respect to the topics contained in Tod's' 30(b)(6) notice. A copy of the October 20, 2015 email is attached hereto as Exhibit 3. The sole witness identified with respect to topics 13-15 concerning bona fide intent was Brigid Stevens. While

Mycoskie now claims that Tod's should have questioned another witness, Jessica Murray, further about the bona fide intent issues, and even offers a declaration from Ms. Murray attesting to various facts concerning Mycoskie's bona fide intent, Ms. Murray was designated for seven other topics and not for any of the three bona fide intent topics listed in items 13-15 of the notice. The designations contained in the October 20, 2015 email were confirmed at the start of both Ms. Murray's and Ms. Stevens' deposition, without any indication of a change with respect to topics 13-15, as reflected in the deposition testimony attached hereto as Exhibit 4.

10. I took Ms. Stevens' deposition on November 20, 2015. Based on review of the transcript of her deposition, which I received on December 7, 2015, Tod's concluded that it had a valid additional ground of opposition. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

11. Around this same time, as discovery was drawing to a close and Tod's began the process of preparing for trial, it determined that it would not pursue its claim for dilution. Accordingly, as part of its proposed amendment adding the lack of bona fide intent claim, Tod's also withdrew the previously asserted dilution claim so that the operative pleading would reflect the actual claims to be tried.

I DECLARE UNDER PENALTY OF PERJURY THAT THE FOREGOING IS TRUE AND CORRECT. EXECUTED ON FEBRUARY 1, 2016 AT NEW YORK, NEW YORK.

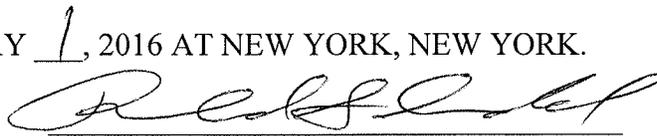

RICHARD S. MANDEL

EXHIBIT 1



MYCOSKIE001360



MYCOSKIE001361



MYCOSKIE001362



TOMS ONLINE
APPAREL COLLECTION
FALL 2012

Women's



Cobalt Small Stamp V-Neck



Cream Peru Botanical Print Scoop Neck



c/o Heather Grey Stamp Tee



Heather Cranberry Crew Neck
(no pockets)



Oatmeal Zip Up Sweatshirt



c/o Heather Grey Classic Hoodie

Men's



White Llama Graphic Crew Neck



c/o Heather Grey Stamp Tee



Black Crew Neck Sweatshirt
w/ Ash Elbow Patches



Oatmeal Zip Up Sweatshirt



c/o Heather Grey Classic Hoodie



TOMS ONLINE
APPAREL COLLECTION
FALL 2012

Accessories



Classic Black Cap



Classic TOMS Beanie - Oatmeal



Classic TOMS Beanie - Rust



Passport Cover - Saddle Brown



TOMS Travel Journal - Black



One for One Brass Bracelet



TOMS Scout Kit:
Olive Bandana + 5 Patches



iPhone Case

HOLIDAY 2012

HOLIDAY 2012
APPAREL/ACCESSORIES



TOMS Holiday 12 Women's Fleece



Women's Crew Neck Sweatshirt
w/ TOMS Logo Embroidery



Women's Crew Neck Sweatshirt
w/ TOMS stamp print



Women's Zip Up Sweatshirt
w/ knitted fabric detail

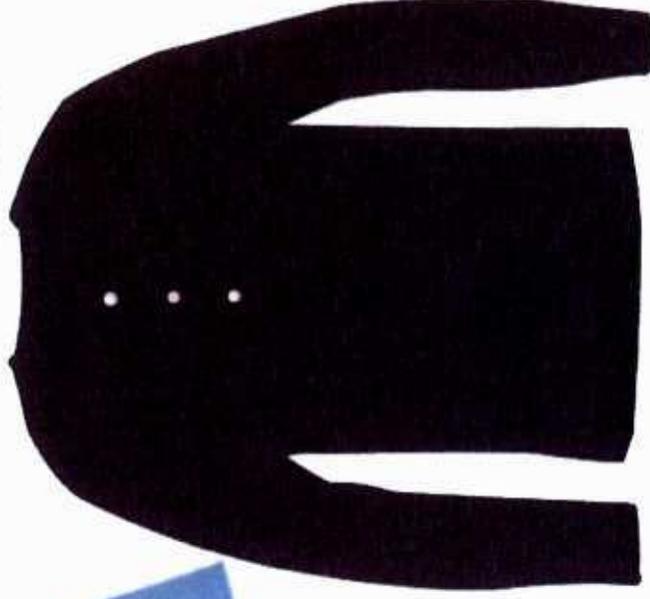
T-SHIRTS



Dark Blue TOMS Stars Crew

Grey TOMS Stars Crew

LONG SLEEVE HENLEY



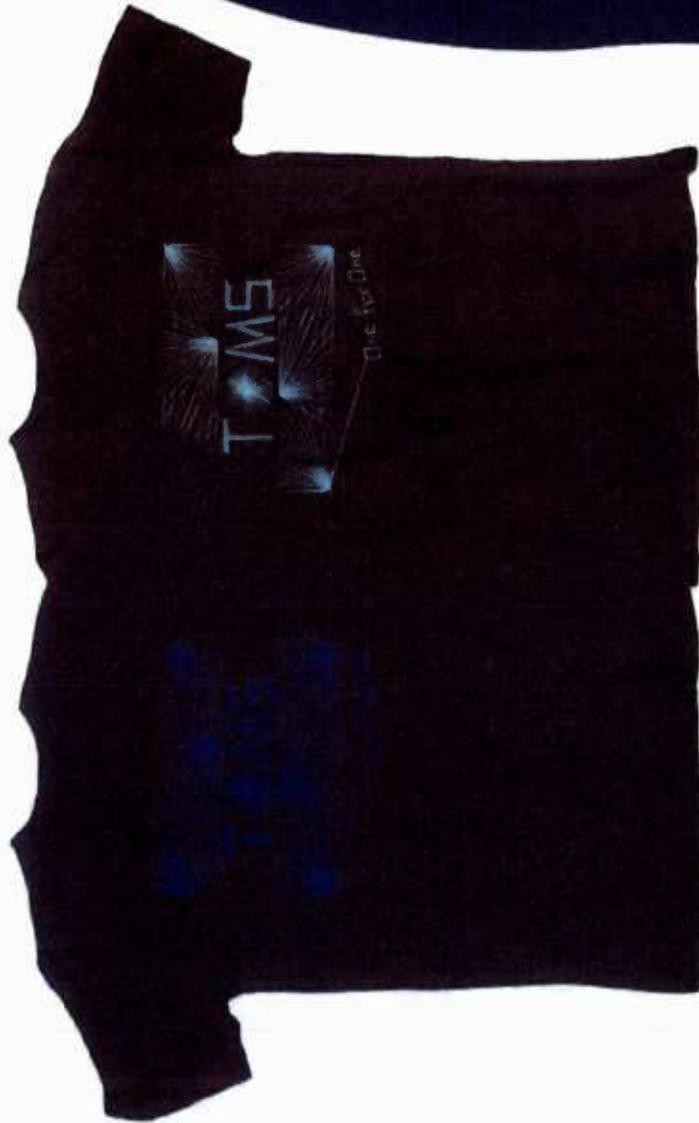
Burgundy Henley w/ TOMS logo print



Mint Green Pine Cone V-Neck

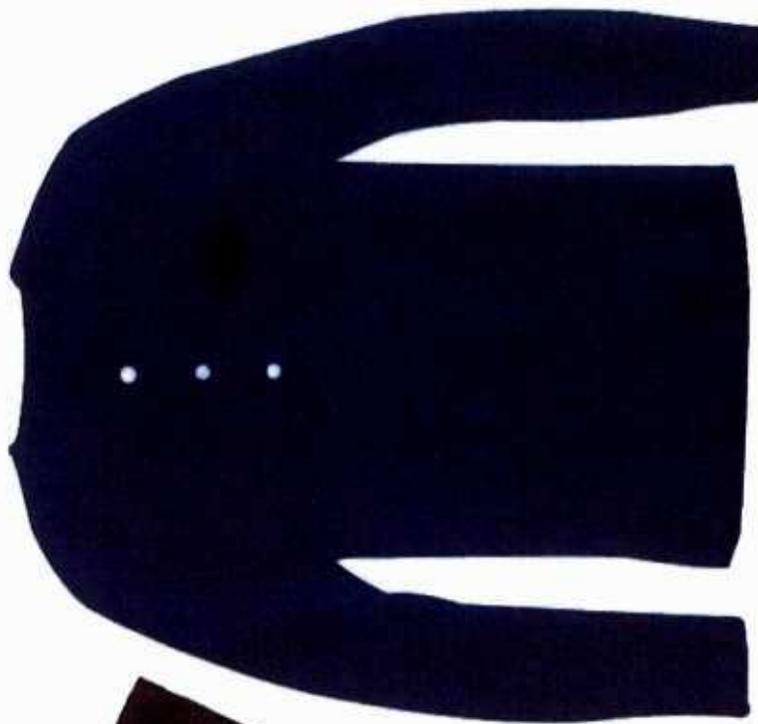
TOMS

Holiday 12 Men's Tees



Men's String Art - Olive Green

Men's String Art - Light Brown



Men's Navy Full Sleeve Henley

TOMS

Holiday 12 Men's Tees



Men's Zip Up Sweatshirt
w/ knitted fabric detail



Men's Crew Neck Sweatshirt
w/ TOMS Logo Embroidery

TOMS

Holiday 12 Accessories



Leather Money Clip
(TOMS blue stitch detail on clip)



Antique Brass Carpe Diem Necklace



Single Fold Card Holder
(strap/pin closure)



Cable Knit Slouch Beanie
w/ suede TOMS logo (logo not pictured)



Classic Watch Cap - Foliage



Women's Tees & Henley



TOMS Stars Tee
Heather Dark Blue



Pine Cone Art Tee
Mint Green



TOMS Diamond Henley
Wine

Women's Crews & Hoodie



TOMS Diamond Crew
Heather Grey



TOMS Classic Crew
Heather Dark Blue



Knitted Fabric Zip-Up
Heather Grey

TOMS

One for One

TOMS ONLINE
APPAREL & ACCESSORIES COLLECTION
HOLIDAY 2012

Men's Tee & Henley



TOMS String Art Tee
Olive Green



TOMS Diamond Henley
Navy Blue

Men's Crew & Hoodie



Knitted Fabric Zip-Up
Heather Grey



TOMS Classic Crew
Heather Dark Blue



Accessories



(top left)
Brown Leather Money Clip
TOMS Blue Stitching Detail

(bottom left)
Brown Leather Single Fold Card Holder
Native Print Exterior



(right)
Antique Brass "Carpe Diem" Necklace

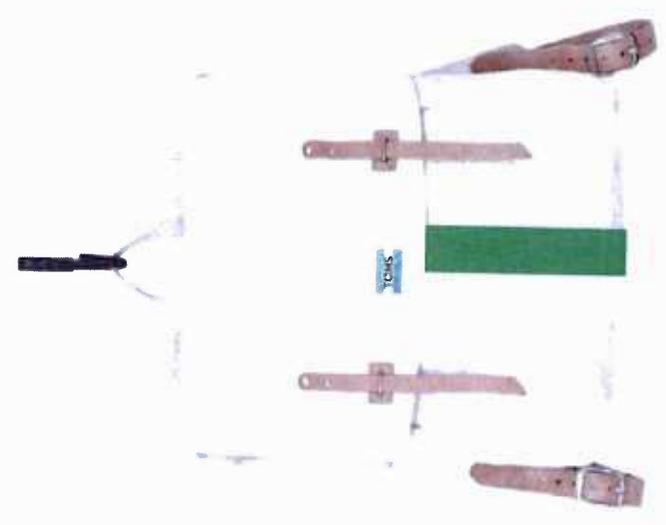


PROJECT: EDUCATION

THE STORY OF THE GIVING STRIPE

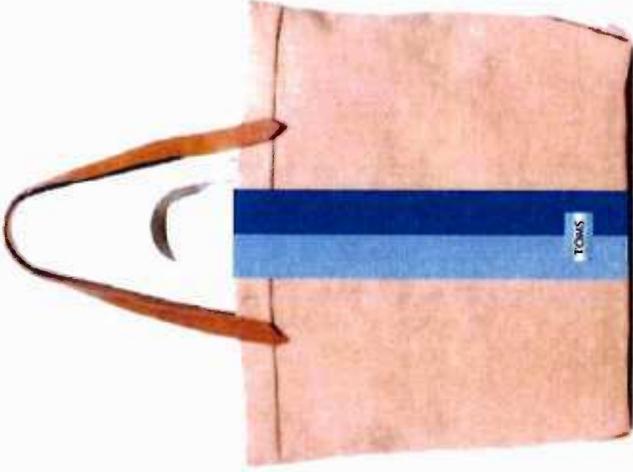
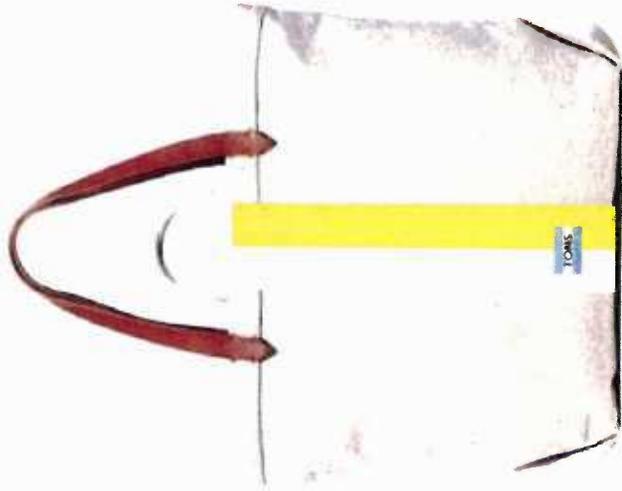


MYCOSKIE010356



THE DAILY PACK

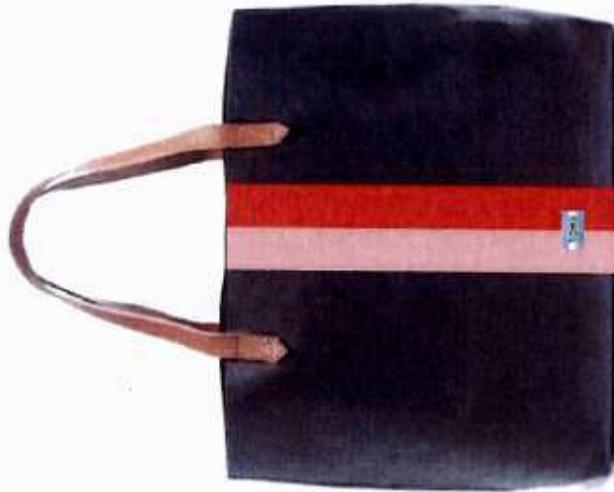
CANVAS



THE TOMS TOTE

CANVAS/LINEN

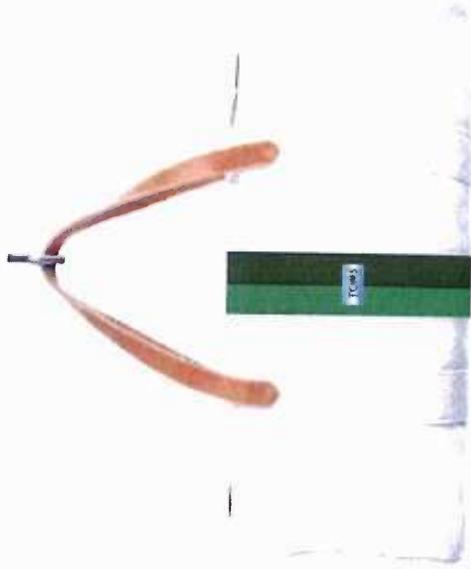
MYCOSKIE010358



THE TOMS TOTE

LEATHER

MYCOSKIE010359



THE DESTINATION DUFFEL

CANVAS

MYCOSKIE010360



PRINTS & TEXTURES

EXHIBIT 2

**UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

In re Application Serial No. 86/004,044
Published in the *Official Gazette*: April 29, 2014
For the Mark: TOMS

In the Matter of Registration Nos. 4,097,948; 4,192,925; 4,313,981; 4,410,344
Registered: February 14, 2012; August 21, 2012; April 2, 2013; October 1, 2013
For the Mark: TOMS

TOD'S S.P.A.,)	
)	Opposition No.: 91218001 (parent)
<i>Opposer/Petitioner,</i>)	Cancellation No.: 92061234
)	
-against-)	APPLICANT/RESPONDENT'S
)	OBJECTIONS TO
)	OPPOSER/PETITIONER'S 30(b)(6)
MYCOSKIE, LLC,)	NOTICE OF DEPOSITION OF
)	MYCOSKIE, LLC
<i>Applicant/Respondent.</i>)	
)	
)	

Applicant/Respondent Mycoskie, LLC ("Mycoskie"), by and through its undersigned counsel, hereby asserts the following objections to Opposer/Petitioner Tod's S.p.A. ("Tod's") 30(b)(6) Notice of Deposition of Mycoskie, LLC, and the Testimonial Topics contained therein (the "Topics"), as follows:

OBJECTIONS

TESTIMONIAL TOPIC NO. 9

Mycoskie's knowledge of Opposer/Petitioner's TOD'S Marks.

OBJECTIONS TO TESTIMONIAL TOPIC NO. 9

Mycoskie objects to this Topic as overbroad and unduly burdensome in scope. Mycoskie further objects to this Topic on the grounds that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks testimony relating to issues that are not relevant to the subject matter of these proceedings, namely, the registrability of Mycoskie's standard

character TOMS word mark in International Classes 9, 18, 25, and 35.

TESTIMONIAL TOPIC NO. 21

Any expansion plans with respect to the use of Mycoskie's TOMS Mark and/or Mycoskie's TOMS Design Mark.

OBJECTIONS TO TESTIMONIAL TOPIC NO. 21

Mycoskie objects to this Topic as overbroad and unduly burdensome in scope. Mycoskie further objects to this Topic on the grounds that the phrase "expansion plans" is vague and ambiguous as used therein. Mycoskie further objects to this Topic on the grounds that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks testimony relating to issues that are not relevant to the subject matter of these proceedings, namely, the registrability of Mycoskie's standard character TOMS word mark in International Classes 9, 18, 25, and 35, and further calls for information that is highly confidential and of the most sensitive nature.

TESTIMONIAL TOPIC NO. 22

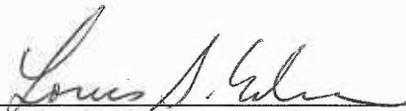
All communications between Opposer/Petitioner and Mycoskie concerning the present dispute.

OBJECTIONS TO TESTIMONIAL TOPIC NO. 22

Mycoskie objects to this Topic as overbroad and unduly burdensome in scope. Mycoskie further objects to this Topic on the grounds that it is not reasonably calculated to lead to the discovery of admissible evidence in that it seeks testimony relating to issues that are not relevant to the subject matter of these proceedings, namely, the registrability of Mycoskie's standard character TOMS word mark in International Classes 9, 18, 25, and 35. Mycoskie further objects to this Topic to the extent it seek testimony concerning inadmissible settlement discussions between Mycoskie and Tod's that are subject to Federal Rule of Evidence 408.

Dated: November 11, 2015

ARNOLD & PORTER LLP

By: 

Louis S. Ederer
399 Park Avenue
New York, New York 10022
Tel: 212.715.1000
Fax: 212.715.1399

*Attorneys for Applicant/Respondent
Mycoskie, LLC*

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing
**APPLICANT/RESPONDENT'S OBJECTIONS TO OPPOSER/PETITIONER'S 30(b)(6)
NOTICE OF DEPOSITION OF MYCOSKIE, LLC** was served upon the following attorneys
of record for Opposer/Petitioner Tod's S.p.A. by U.S. Mail, this 11th day of November, 2015:

Richard S. Mandel, Esq.
COWAN, LIEBOWITZ & LATMAN, P.C.
1133 Avenue of the Americas
New York, New York 10036-6799

Attorneys for Opposer/Petitioner Tod's S.p.A.


Benjamin C. Wolverton

EXHIBIT 3

Mandel, Richard

From: Ederer, Louis S. <Louis.Ederer@APORTER.COM>
Sent: Tuesday, October 20, 2015 7:02 PM
To: Mandel, Richard
Cc: Emert, Aryn M.; Salzmann, Matthew T.; Wolverton, Benjamin
Subject: RE: Tod's v. Toms

Richard:

I confirm that the four individually noticed witnesses will also be serving as Mycoskie's designees for the topics set forth in your Rule 30(b)(6) notice. Subject to our objections as to any of the topics, we identify the witness(es) who will be designated for each topic in your notice as follows:

Doppelt -- 1, 2, 4, 6, 7, 9, 12, 18, 19

Stern -- 3, 5, 17, 21

Stevens -- 2, 4, 6, 7, 10, 12-16, 18, 19, 21

Murray -- 8,11, 20, 22-25

Please note that in some instances more than one witness has been designated for a single topic.

We will get back to you soon about whether the witnesses can proceed in the order in which they have been noticed, and whether we intend to further pursue our own 30b6 deposition.

Sincerely,

Louis S. Ederer
Arnold & Porter LLP
399 Park Avenue
New York, NY 10022-4690

Telephone: +1 212.715.1102
Fax: +1 212.715.1399
louis.ederer@aporter.com
www.arnoldporter.com

From: Mandel, Richard [<mailto:RSM@cfl.com>]
Sent: Wednesday, October 14, 2015 12:00 PM
To: Ederer, Louis S.
Cc: Emert, Aryn M.; Salzmann, Matthew T.; Wolverton, Benjamin
Subject: RE: Tod's v. Toms

We can proceed with the depositions on November 19 and 20 at the same location indicated in the notice (Mitchell Silberberg's offices in LA). Please confirm that your 30(b)(6) designees will be comprised only of these four witnesses and there are no additional witnesses that need to be scheduled in connection with the 30(b)(6) deposition. Also, please let us know as soon as possible which witnesses will be designated for which topics, and if the witnesses are available to proceed in the order reflected in our notices or have any scheduling issues that require taking any of them on one of the two particular dates reserved.

EXHIBIT 4

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

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TOD'S S.P.A.,)
)
Opposer,)
)
vs.) Opposition No. 91218001
)
MYCOSKIE, LLC,)
)
Applicant.)

-----X
TOD'S S.P.A.,)
)
Petitioner,)
)
vs.) Cancellation No. 92061234
)
MYCOSKIE, LLC,)
)
Respondent.)

-----X

INDIVIDUAL AND CORPORATE DEPOSITION
OF JESSICA MURRAY
Los Angeles, California
Thursday November 19, 2015

Reported By:
SUSAN A. SULLIVAN, CSR #3522, RPR, CRR
Job No. 100102

1 November 19, 2015

2 12:13 p.m.

3
4 DEPOSITION OF JESSICA MURRAY, taken by
5 Opposer/Petitioner, at the offices of
6 Mitchell Silberberg & Knupp, 11377 West
7 Olympic Boulevard, Los Angeles, California,
8 before Susan A. Sullivan, CSR, RPR, CRR,
9 State of California.

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A P P E A R A N C E S:

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COWAN, LIEBOWITZ & LATMAN

Attorneys for the Opposer/Petitioner

1133 Avenue of the Americas

New York, New York 10036

BY: RICHARD MANDEL, ESQ.

ARNOLD & PORTER

Attorneys for the Applicant/Respondent

399 Park Avenue

New York, New York 10022

BY: LOUIS EDERER, ESQ.

1 JESSICA MURRAY,
2 called as a witness, having been duly sworn by
3 the court reporter, was examined and testified
4 as follows:

5

6 EXAMINATION

7 BY MR. MANDEL:

8 Q Please state your name for the record.

9 A My name is Jessica Murray Curtis is my
10 married, my legal name.

11 Q And you are employed by Toms?

12 A Yes.

13 Q And you are the director of intellectual
14 property and brand enforcement; is that right?

15 A That's correct.

16 Q How long have you worked for Toms?

17 A I began working for Toms in May of 2013.

18 Q And just for the record, you understand that
19 you are testifying here today both in your
20 individual capacity and as a corporate
21 representative, correct?

22 A I do.

23 Q And just so the record is clear, the topics
24 in the deposition notice which has briefly been
25 marked as Opposer's Exhibit 1 for which you have

1 been designated are Topics 8, 11, 20, 22, 23, 24 and
2 25; is that correct?

3 MR. EDERER: Do you want to look at it?

4 THE WITNESS: Yes.

5 Q BY MR. MANDEL: Did you do anything to
6 prepare for testifying as a 30(b)(6) corporate
7 representative today?

8 A I did.

9 Q What did you do?

10 A I met with counsel.

11 Q And you are referring to Mr. Ederer?

12 A I am.

13 Q And other than meeting with Mr. Ederer, did
14 you do anything else to prepare for your testimony
15 today?

16 A I spoke to my legal department.

17 Q And when you say your legal department, can
18 you describe what that comprises?

19 A It is our Chief Legal Officer, Cheryl
20 Solomon.

21 Q Cheryl Solomon?

22 A Uh-huh.

23 Q Is she the general counsel of the company?

24 A She is the chief legal officer.

25 Q Are there any other employees in the legal

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

-----x

TOD'S S.P.A.,)

)

Opposer,)

)

vs.) Opposition No. 91218001

)

MYCOSKIE, LLC,)

)

Applicant.)

)

TOD'S S.P.A.,)

)

Petitioner,)

)

vs.) Cancellation No. 92061234

)

MYCOSKIE, LLC,)

)

Respondent.)

-----x

INDIVIDUAL AND CORPORATE DEPOSITION
OF BRIGID STEVENS
Los Angeles, California
Friday November 20, 2015

Reported By:

SUSAN A. SULLIVAN, CSR #3522, RPR, CRR

Job No. 100103

1 November 20, 2015

2 11:11 a.m.

3
4 DEPOSITION OF BRIGID STEVENS, taken by
5 Opposer/Petitioner, at the offices of
6 Mitchell, Silberberg & Knupp, 11377 West
7 Olympic Boulevard, Los Angeles, California,
8 before Susan A. Sullivan, CSR, RPR, CRR,
9 State of California.

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A P P E A R A N C E S:

1
2
3 COWAN, LIEBOWITZ & LATMAN

4 Attorneys for the Opposer/Petitioner

5 1133 Avenue of the Americas

6 New York, New York 10036

7 BY: RICHARD MANDEL, ESQ.

8
9 ARNOLD & PORTER

10 Attorneys for the Applicant/Respondent

11 399 Park Avenue

12 New York, New York 10022

13 BY: LOUIS EDERER, ESQ.

14
15 ALSO PRESENT:

16 JESSICA MURRAY
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25

1 BRIGID STEVENS,

2 called as a witness, having been duly sworn by
3 the court reporter, was examined and testified
4 as follows:

5

6 EXAMINATION

7 BY MR. MANDEL:

8 Q Please state your name for the record.

9 A Brigid Stevens.

10 Q And you reside here in Los Angeles?

11 A I do.

12 Q And you understand that you are appearing
13 here today in your individual capacity as well as a
14 corporate representative on behalf of Mycoskie, LLC?

15 A Correct.

16 Q I'm going to ask you to look at what's
17 previously been marked as Exhibit 1.

18 A Okay.

19 Q Opposer's Exhibit 1, and I just want to
20 confirm for the record that you are designated to
21 testify on behalf of Mycoskie with respect to the
22 following topics. I'll just go through them and you
23 can confirm each of them.

24 A Okay.

25 Q Topic 2.

1 MR. EDERER: I would just like to state for the
2 record as I did yesterday when Ms. Doppelt was being
3 deposed that yes, we have designated Ms. Stevens
4 with respect to Topic 2 and other topics for which
5 Ms. Doppelt was also designated and that Ms. Stevens
6 focuses more on the later period of time,
7 approximately 2011 to the present.

8 Q BY MR. MANDEL: Okay. With that
9 qualification, you are designated for Topic 2,
10 correct?

11 A Correct.

12 Q And Topic 4?

13 MR. EDERER: Yes. With the same caveat.

14 Q BY MR. MANDEL: And Topic 6?

15 MR. EDERER: Once again, with the same caveat.

16 THE WITNESS: Yes.

17 Q BY MR. MANDEL: Topic 7?

18 MR. EDERER: Yes. The same caveat.

19 THE WITNESS: Yes.

20 Q BY MR. MANDEL: Topic 10?

21 A Yes, with the same caveat. I don't think we
22 have anything prior to then but --

23 MR. MANDEL: Okay. I think on -- I don't think
24 Ms. Doppelt was actually designated.

25 MR. EDERER: Right. Because there was nothing

1 prior to then.

2 MR. MANDEL: Okay.

3 MR. EDERER: As the witness just said.

4 MR. MANDEL: Okay. That's fine.

5 Q Topic 12.

6 MR. EDERER: Yes, with the same caveat.

7 Q BY MR. MANDEL: Topic 13.

8 A Yes.

9 Q Topic 14.

10 A Only speaking to 2011 and beyond.

11 MR. EDERER: Right. But this is the -- this is
12 what we have been calling the handbag trademark
13 application.

14 THE WITNESS: Oh, correct, yes. Thank you.

15 Q BY MR. MANDEL: Topic 15.

16 MR. EDERER: Same thing.

17 THE WITNESS: Yes.

18 MR. EDERER: It relates to the handbag.

19 Q BY MR. MANDEL: Topic 16.

20 A Yes.

21 Q Topic 18.

22 MR. EDERER: And that one is a -- is a
23 co-designation so that would be with the same
24 designation.

25 Q BY MR. MANDEL: Okay. Topic 19.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the attached Reply Memorandum in Further Support of Opposer/Petitioner's Motion to Amend and Reply Declaration of Richard S. Mandel, along with the supporting exhibits, was served upon Applicant/Respondent's counsel of record on February 2, 2016 by first class mail, postage prepaid addressed to:

Louis S. Ederer, Esq.
Arnold & Porter LLP
399 Park Avenue
New York, New York 10022

/Bridget A. Crawford/
Bridget A. Crawford