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

Proceeding	91218523
Party	Defendant 13th Ave Fish Market Inc. DBA Freund's Fish
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Date	12/14/2015
Attachments	2015.12.14-Applicant's Reply Brief ISO Motion to Compel.pdf(116467 bytes) Grossberg Supplemental Declaration with Exhibit A.pdf(126586 bytes)

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

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Oakhurst Industries, Inc. DBA Freund Baking Co.,

Opposer,

v.

Opposition No. 91218523

13th Ave Fish Market Inc. DBA Freund's Fish,

Applicant.
-----><

**APPLICANT 13th AVE FISH MARKET INC. DBA
FREUND'S FISH'S REPLY BRIEF IN SUPPORT OF MOTION
TO COMPEL DISCOVERY RESPONSES
AND TO RESET ALL DATES**

Applicant 13th Ave Fish Market Inc. DBA Freund's Fish ("Applicant") submits this reply brief in further support of its motion for an order compelling Opposer, Oakhurst Industries, Inc. DBA Freund Baking Co., to fully respond to Applicant's discovery requests and for a rescheduling of all dates (the "Motion").

I. INTRODUCTION

Contrary to Opposer's intimation, the supplemental discovery responses that Opposer served on November 9, 2015 and were received by Applicant's counsel on November 13, 2015, do not "moot" the Motion. (Dkt. no. 25, Opposer's Opp'n Br. ("Opp'n") at 1.) Opposer's delinquent responses, served three weeks after Opposer had originally indicated they would be served and two months after responses were due, do not address all of the issues raised in the Motion. And Opposer's opposition brief does nothing to substantively address what issues are supposedly resolved by its supplemental

responses. Notwithstanding Opposer's lack of cooperation, Applicant has identified specific discovery responses by Opposer that were raised in the Motion and remain deficient in spite of the eventual service of supplemental responses, and will address those deficient responses as well as Opposer's other inapposite arguments in turn.

II. ARGUMENT

A. The Motion Was Timely Filed and is Not Moot

The Motion was not prematurely filed. Applicant's efforts to meet and confer on Opposer's discovery deficiencies were thoroughly set forth in the Motion and the communications speak for themselves (although the parties' counsel have not actually spoken, because counsel for Opposer repeatedly refused Applicant's counsel's requests to schedule a telephone conversation).

The Trademark Rules are clear that a party seeking remedy of deficient discovery responses is obligated to file a timely motion to compel or else risk waiver of its ability to do so. See TBMP § 523.04. Applicant was not required to sit idly by after the date on which Opposer indicated it would supplement its responses came and went, and came and went again, with no indication of when supplemental responses would finally be provided. And Opposer cites no authority whatsoever for its contention that the Motion is "procedurally infirm" because Opposer intended to supplement its deficient discovery responses at some date in the future, unknown to Applicant, at the time that the Motion was filed. (Opp'n at 2.)

The situation present here is distinguishable from *Hot Tamale Mama...and More, LLC v. SF Investments, Inc.*, 110 U.S.P.Q.2d 1080 (TTAB 2014), relied on by Opposer. In *Hot Tamale*, the parties had engaged in a single short email exchange before a motion to compel was filed. Here, the parties engaged in extensive correspondence regarding

the scope and meaning of Applicant's discovery requests, with very little able to be resolved (in large part due to the formal letter-writing campaign dictated by Opposer's counsel). When counsel for Opposer advised that Opposer's supplemental discovery responses would be provided "shortly" after missing the its first self-imposed deadline and failing to set forth a firm date on which the responses would actually be provided, Applicant waited a week before filing its Motion. The Motion was finally filed after Opposer's rejection of Applicant's suggestion of a three-month extension of the discovery period indicated that Opposer was unwilling to own up to its own delaying tactics, and that communication provided no indication of when and whether the supplemental responses would finally be forthcoming.

B. Opposer's Supplemental Discovery Responses Remain Deficient

1. Responses to Document Requests

. Opposer's supplemental responses to Applicant's document requests maintain baseless objections and do not provide responses to the following requests:

- No. 11 (price lists from 1981 to the present);
- No. 14 (all documents related to advertising, promotional and marketing expenditures from first use to present);
- No. 25 (all documents reflecting Opposer or Marked Goods being mentioned in the press);
- No. 32 (documents concerning the extent of recognition by the general public of each of Opposer's marks);
- No. 42 (documents sufficient to identify every baked good sold since 1981);
- No. 47 (documents sufficient to identify all members, officers, shareholders since 2005);
- No. 49 (documents concerning, reflecting, or related to communications by Opposer with others about Applicant and/or Applicant's Marks);
- No. 52 (documents relating to use of marks in connection with private label bakery services since 1981);

- No. 53 (documents sufficient to identify three customers annually since 1981 for whom opposer has rendered private label bakery services since 1981).

Opposer's complaint that "it is difficult to figure out exactly what Applicant is moving to compel" (Opp'n at 3) merely attempts to divert attention from the fact that Opposer's original discovery responses were so deficient that, as the Motion clearly states, Opposer had merely objected to fifty out of fifty-seven Requests for Production, without stating whether responsive documents existed or indicating whether any responsive documents would be produced or a search undertaken, and Applicant's Motion sought meaningful responses to all of its Requests. (See Motion at 9.)

Opposer's refusal to provide responsive representative documents about Opposer's purported use of its mark in connection with private label bakery services in response to Requests 52 and 53 has no basis, and is improper in light of Opposer's assertion of a registration that subsists specifically in connection with use for private label bakery services (i.e., U.S. Reg. No. 4,500,792). And Applicant is amenable to specifying that it is only seeking production of documents actually within Opposer's possession regarding Request Nos. 25 and 32, both of which seek the type of information that a trademark holder typically maintains in its files.

Rather than produce price lists in response to Request No. 11, Opposer has provided in its supplemental document production a "price range" list for the years 2011-2015 indicating the price range of "all products" (and designated it TRADE SECRET/COMMERCIALY SENSITIVE). This document does not address the question of what products Opposer offers for sale under its marks (a topic also covered by Request No. 42, which Opposer has also refused to respond to), or what the price of each product is – information that is plainly discoverable in a trademark dispute. Similarly, Opposer has not provided any documents in response to Request No. 14, which seeks documents

related to advertising, promotional, and marketing expenditures from first use to present. Opposer has instead produced a two-line summary document, designated TRADE SECRET/COMMERCIALY SENSITIVE, titled "Advertising Expense 2011-2015." In addition, Opposer provided a supplemental response to Request No. 7 (documents concerning, reflecting or related to sales figures on an annualized basis, reflecting Opposer's dollar value, unit volume, and geographic extent of Marked Goods or Services sold in connection with Opposer's marks) that cites the "Advertising Expense 2011-2015" document. This is unresponsive, but perhaps Opposer meant to cite the document that summarizes its "Annual Sales 2011-2015" for "All Products" (designated TRADE SECRET/COMMERCIALY SENSITIVE), which merely provides a "not less than" figure where the figure is the same for all five years. The documents sought by Request No. 7 go not only to the statutory factors for fame, which Opposer has pleaded, but also are necessary to evaluate the *DuPont* factors, including: similarity or dissimilarity of established, likely-to continue trade channels (*DuPont* factor 3); the conditions under which and buyers to whom sales are made (*DuPont* factor 4); the fame of the prior mark (sales, advertising, length of use) (*DuPont* factor 5); and the length of time during and the conditions under which there has been concurrent use without evidence of actual confusion (*DuPont* factor 8).

Request Nos. 47 and 49 will be discussed below with respect to topically related Interrogatories. The fundamental issue raised in the Motion – that Applicant has simply refused to provide a substantive response or provide an answer beyond boilerplate objections – has not changed by virtue of the supplemental responses with respect to the foregoing document requests. Opposer's claim that it should not have to produce information (much less actual documents) going back further than five years flies in the face of the likelihood of confusion factors regarding duration and nature of use.

2. Responses to Interrogatories

Opposer's supplemental interrogatory responses generally provide several of the substantive responses sought in the Motion. The only two Interrogatories that still have not been substantively responded to are Nos. 14 and 15. Two of Opposer's supplemental responses remain deficient.

The supplemental response to Interrogatory No. 17, regarding an alleged instance of apparent actual confusion, is extremely vague and lacks any kind of meaningful identifying information as to the identity of the individual who contacted Opposer on September 19, 2015, and the nature or content of that communication. (See Opposer's Opp'n, Freund Decl., Exhibit 5.) Counsel for Applicant specifically asked counsel for Opposer whether Opposer would be willing to further supplement that response to provide the identity of the individual and the nature and content of the communication. (Freund Decl., Ex. 7, Nov. 17, 2015 Email from L. Grossberg to S. Freund.) Counsel for Opposer has not responded to that request, and Opposer has not provided a supplemental response (or substantive response at all) to Request No. 49, which would call for any documentation related to this alleged incident (documents concerning, reflecting or related to communications by Opposer with others about Applicant and/or Applicant's Marks"). Insofar as Opposer has made its supplemental Interrogatory responses of record in relation to the Motion, this matter is ripe for determination by the Board.

The supplemental response to Interrogatory No. 4, which seeks a corporate chart or identification of executives, officers, directors, and managerial employees of Opposer, is labeled "TRADE SECRET/COMMERCIALY SENSITIVE" and provides a list of officers since 2010. (Freund Decl., Ex. 5 (redacted).) The supplemental "response" does not provide any responsive information about managerial employees, notwithstanding that

Applicant clarified that “managerial employees” could be limited to those persons having trademark-related responsibilities. (Grossberg Decl. Ex. L.) Opposer should be compelled to provide a response to the interrogatory that addresses managerial employees having trademark-related responsibilities, as well as a further response to Request to Produce No. 47 (“Documents sufficient to identify all members, officers, and/or shareholders of Opposer, since 2005”), to which Opposer has maintained its objections and not provided responsive documents. (Freund Decl., Ex. 4.)

As to Interrogatory Nos. 14 and 15, Opposer had never indicated in correspondence what it deemed to be substantively “blatantly impermissible” about these interrogatories before filing its opposition brief. (Opp’n at 11; Grossberg Decl., Ex. H, at p. 2.) Now that Opposer has clarified that it objects to the word “may” in light of TBMP § 414(7) stating that names of expert witnesses that a party *intends* to call on to testify are discoverable, Applicant states that it is amenable to the Board addressing Opposer’s semantic concerns by compelling Opposer to provide a supplemental response to Interrogatory No. 14 that assumes it had been worded to ask about expert witnesses that Opposer “intends” to call rather than “will” call, and further compelling Opposer to provide a response to Interrogatory No. 15 based on its response to No. 14.

C. Opposer’s Reliance on Amendments to the Federal Rules of Civil Procedure are Misplaced

Applicant does not contest the fact that amendments to the Federal Rules of Civil Procedure governing discovery took effect on December 1, 2015; that those rules are intended to have immediate effect, even as to pending cases; or that those rules are generally applicable in proceedings before the Trademark Trial and Appeal Board. Applicant does take issue, however, with Opposer’s characterization of the effect of those rules on the discovery requests at issue in the Motion.

Opposer claims that Applicant's discovery requests are disproportionate to the needs of the case by being "overbroad in time and scope." (Opposer's Opp'n at 4.) The opposition brief's reliance on "proportionality," however, constitutes a mere repackaging of now-outdated relevance objections to garden-variety discovery requests in a trademark dispute that are aimed at acquiring the information necessary for the parties and the Board to conduct meaningful *DuPont* analysis. Moreover, the claim that "Applicant seeks all documents from 1856" is false. Applicant merely pointed out to Opposer in an email communication dated October 15, 2015 (Grossberg Decl., Ex. L) that in light of Opposer having pleaded that its marks are "famous" within the meaning of 15 U.S.C. § 1125(c), the "duration, extent, and geographic reach of advertising and publicity of the mark" was statutorily at issue and a proper subject for discovery. As for the claim that the Requests "improperly" seek documents and information dating back to 1981, Opposer does not in any way counter the well-established authority that a trademark owner's alleged first use of a mark (1981 being the first use date in Opposer's trademark registrations) is a proper subject of discovery. See TBMP § 414(5) ("Information concerning a party's first use of its involved mark is discoverable.").

Opposer has not actually made any argument that its records are inaccessible, that the universe of responsive documents is so large that it would be unduly time-consuming or expensive for Opposer to review and produce them, or any other potentially valid claim to "disproportionality." Opposer simply does not want to produce responsive information, which necessitated the instant Motion.

D. Attorney-Client Privilege and Work Product Doctrine Objections

Opposer's original discovery responses invoked the attorney-client privilege and work product doctrine without providing a privilege log of responsive but privileged or otherwise protected documents as to a large number of requests, *i.e.*, Opposer's

Responses to RFP Nos. 1, 3, 5, 29, 39, 40, 46, 48, 49, 50, 51, 57; and Response to Interrogatory No. 16. Opposer now states in its opposition to the Motion that it “fully answered Interrogatory No. 16” and that its supplemental responses to document requests “clarify[y] that it did not withhold any information or documents when it had asserted these objections and it will thus not have to produce a privilege log.” (Opp’n at 11.) Given Opposer’s reference to the changes to the Federal Rules, it is surprising that it would maintain its “attorney-client privilege” objections in its *supplemental* discovery responses if it is now also claiming that it is not in fact asserting or relying on the attorney-client privilege as to any discovery request. (Freund Decl., Exs. 4-5.)

As explained in Applicant’s Motion and set forth in Applicant’s counsel’s email of October 15, 2015 (Grossberg Decl., Ex. L), Applicant had suggested that the parties agree that any privileged documents created after the filing of the date of the Notice of Opposition need not be logged by either party. Opposer has refused to respond to that proposal. (See Supp’l Grossberg Decl., Ex. A, attached hereto.) Opposer makes much of Applicant’s assertion of an attorney-client privilege objection without producing a privilege log but without acknowledging the proposed agreement or its failure to respond thereto. This dispute remains ripe as to both Applicant’s proposal that the parties agree that post-Notice of Opposition privileged documents need not be logged, and as to Opposer’s apparent continued reliance without production of a privilege log or responsive documents in connection with Request No. 49, which seeks documents concerning, reflecting, or related to communications by Opposer with others about Applicant and/or Applicant’s Marks. (See Opposer Opp’n at 11 (acknowledging that Opposer has not supplemented its response to Request No. 49 but making no statement as to whether it is withholding responsive documents).)

E. Improper Motion to Amend/Withdraw

After Opposer's opposition to the instant Motion was filed, Opposer sought to withdraw its dilution claim and filed a Motion to Amend seeking leave to do so. (Dkt. no. 26.) Applicant believes the Motion to Amend is improper at least insofar as it directly contravenes the Interlocutory Attorney's Suspension Order of November 12, 2015, which states that "Any paper filed during the pendency of" Applicant's Motion to Compel and Applicant's Motion for Leave to File a Second Amended Answer "which is not relevant thereto will be given no consideration." (Dkt. no. 24, 11-12-15 Suspension Order.) To the extent Opposer's Motion to Amend to withdraw the dilution claim with prejudice is intended to allow Opposer to escape its obligation to respond substantively to discovery requests relevant to the alleged fame of Opposer's mark, Applicant notes that such an argument would be unavailing in the face of the fifth *DuPont* factor: "the fame of the prior mark (sales, advertising, length of use)".

Respectfully submitted,

Dated: December 14, 2015

/s/ Lesley M. Grossberg
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13th Ave Fish Market Inc., DBA Freund's
Fish

CERTIFICATE OF SERVICE

I hereby certify that the foregoing APPLICANT'S REPLY BRIEF IN SUPPORT OF MOTION TO COMPEL DISCOVERY RESPONSES AND RESET ALL DATES were served on Opposer's counsel this 14th day of December, 2015, by first class mail, postage prepaid, in an envelope addressed as follows:

Steven A. Freund, Esq.
Law Offices of Steven A. Freund
P.O. Box 911457
Los Angeles, CA 90091

/s/ Lesley M. Grossberg
Lesley M. Grossberg

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

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Oakhurst Industries, Inc. DBA Freund Baking Co.,

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v.

Opposition No. 91218523

13th Ave Fish Market Inc. DBA Freund's Fish,

Applicant.
-----><

**SUPPLEMENTAL DECLARATION OF LESLEY M.
GROSSBERG IN SUPPORT OF APPLICANT 13th AVE FISH
MARKET INC. DBA FREUND'S FISH'S MOTION TO COMPEL
DISCOVERY RESPONSES AND TO RESET ALL DATES**

I, Lesley M. Grossberg, declare as follows:

1. I am an associate at the law firm of Baker & Hostetler LLP, counsel for Applicant 13th Ave Fish Market Inc. DBA Freund's Fish. I submit this Supplemental Declaration in conjunction with Applicant's Reply Brief in Further Support of Motion to Compel Discovery Responses and Reset All Dates.

2. Attached as Exhibit A hereto is a true and correct copy of an email from Opposer's counsel dated December 7, 2015, that responded to my email dated December 3, 2015, regarding my proposal that the parties reach agreement that attorney-client communications or attorney work product that post-dates the filing of the Notice of Opposition in this case need not be included on any privilege log if responsive

to a discovery request. As noted in my December 3, 2015 email to Opposer's counsel, I had made that suggestion in letters dated October 15 and December 23, 2015.

I declare under penalty of perjury that the foregoing is true and correct. Executed on this 3rd day of November 2015.

Dated: December 14, 2015

/s/ Lesley M. Grossberg
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*Attorneys for Applicant
13th Ave Fish Market Inc., DBA Freund's
Fish*

CERTIFICATE OF SERVICE

I hereby certify that the foregoing Supplemental Declaration and accompanying exhibit were served on Opposer's counsel this 14th day of December 2015, by first class mail, postage prepaid, in an envelope addressed as follows:

Steven A. Freund, Esq.
Law Offices of Steven A. Freund
P.O. Box 911457
Los Angeles, CA 90091

/s/ Lesley M. Grossberg
Lesley M. Grossberg

EXHIBIT A

From: [Steven Freund](#)
To: [Grossberg, Lesley](#)
Cc: [Horowitz, Robert B. G.](#)
Subject: RE: FREUND'S FAMOUS opposition proceeding
Date: Monday, December 7, 2015 7:08:07 PM

Dear Ms. Grossberg:

I have made my position on this issue clear.

Thank you for your time and attention to this matter.

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From: Grossberg, Lesley [mailto:LGrossberg@bakerlaw.com]
Sent: Thursday, December 03, 2015 7:07 AM
To: sfreund@freundlawfirm.com
Cc: Horowitz, Robert B. G.; Michael Korsinsky (mk@kklawfirm.com)
Subject: FREUND'S FAMOUS opposition proceeding

Dear Mr. Freund,

Please let me know if the parties agree that attorney-client communications or work product that post-dates the filing of the Notice of Opposition need not be included on any privilege log, as proposed in my email of October 15 and my letter of November 23, 2015.

Regards,
Lesley

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