

ESTTA Tracking number: **ESTTA718286**

Filing date: **01/04/2016**

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

Proceeding	91218523
Party	Plaintiff Oakhurst Industries, Inc. DBA Freund Baking Co.
Correspondence Address	STEVEN A. FREUND Law Office of Steven A. Freund P.O. BOX 911457 LOS ANGELES, CA 90091 UNITED STATES sfreund@freundlawfirm.com
Submission	Reply in Support of Motion
Filer's Name	Steven Freund
Filer's e-mail	sfreund@freundlawfirm.com
Signature	/Steven Freund/
Date	01/04/2016
Attachments	16.1.4.Reply.Brief.In.Support.Of.Motion.To.Amend.pdf(198845 bytes) 16.1.4.Freund.Declaration.In.Support.Of.Reply.pdf(233910 bytes)

Support of Opposer's Motion is further supported by the attached Declaration of Steven A. Freund, Esq. ("Freund Decl.") and enclosed exhibits.

II. ARGUMENT.

A. Opposer's Motion Is Relevant To Applicant's Motion To Compel Discovery.

Rather than simply permitting Opposer to withdraw its dilution claim unopposed, Applicant files its response to the Motion on the procedural ground that the Motion is not relevant to the pending motions that are the subject of the Board's November 12, 2015 Suspension Order. [Applicant's Response to Motion to Amend at pg.1] At bar, Applicant filed a Motion To File Second Amended Answer and a Motion to Compel Discovery. [Dkt. entry nos. 19 and 23.]

The Board's Suspension Order states, in pertinent part, that "[a]ny paper filed during the pendency of these motions [Applicant's November 3, 2015 motion to compel discovery and Applicant's September 22, 2015 motion for leave to file a second amended answer] which is not relevant thereto will be given no consideration. See Trademark Rule 2.127(d)." [Dkt. entry no. 24.]

Trademark Rule 2.127(d) provides "[w]hen any party files a motion to dismiss, or a motion for judgment on the pleadings, or a motion for summary judgment, or any other motion which is potentially dispositive of a proceeding, the case will be suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion and no party should file any paper which is not germane to the motion except as otherwise specified in the Board's suspension order. If the case is not disposed of as a result of the motion, proceedings will be resumed pursuant to an order of the Board when the motion is decided."

While it is unclear regarding the Board's citation to Trademark Rule 2.127(d) because there is no pending motion to dismiss, motion for judgment on the pleadings, motion for summary judgment or any dispositive motion, Opposer's Motion is indeed relevant to Applicant's Motion to Compel Discovery. The Notice of Opposition frames the scope of the proceedings, including discovery. [Fed. R. Civ. P. 26(b)(1).] In Opposer's Notice of Opposition, Opposer has pleaded a claim for dilution. In light of the

fact that Applicant's Motion to Compel Discovery is based upon several Requests and Interrogatories relevant to Opposer's dilution claim, Opposer's Motion is relevant to Applicant's pending Motion To Compel Discovery and does not violate the Board's Suspension Order. In fact, any pleading that withdraws any of a litigant's claims is indisputably relevant to a pending motion to compel discovery.

In any event, Applicant's Motion to Compel Discovery at pages 6 through 9 concerns discovery directed to Opposer's dilution claim. [Applicant's Motion to Compel Discovery at pages 6 through 9.] Further, Applicant's Reply Brief in Support of its Motion to Compel Discovery ("Reply Brief") is based upon discovery directed at Opposer's dilution claim. In Applicant's Reply Brief at pages 5 and 8, Applicant specifically argues that the indicated discovery is relevant to Opposer's dilution claim. [Applicant's Reply Brief at pages 5 and 8.] It is disingenuous for Applicant to now assert in its Response to the Motion that the Motion is not relevant to Applicant's Motion to Compel Discovery. In this manner, the Motion should be granted.

B. Applicant Filed Its Response To The Motion On Procedural Grounds And Should Not Be Permitted To Later Oppose The Motion By Filing A Delinquent Pleading.

Applicant should not get two bites at the apple. Applicant was able to oppose the Motion on any grounds it so chose and based its opposition to the Motion solely on the procedural ground that the Motion was not relevant to the pending motions that precipitated the Board's Suspension Order. Applicant further seeks an opportunity to "respond substantively" should the Board view the instant Motion as relevant to the pending motions covered by the Board's Suspension Order. As shown above, the instant Motion is relevant to Applicant's Motion to Compel Discovery and is thus not violative of the Board's Suspension Order. Applicant's sole ground to oppose the Motion was based upon the procedural ground that the Motion was not relevant to either of Applicant's pending motions. The Motion is relevant to Applicant's Motion to Compel Discovery and should be granted.

There are no legitimate grounds to deny the Motion. Applicant has not and cannot assert any such grounds. In this manner, the Motion should be granted and

Applicant should not be permitted to hedge its bet by opposing the Motion on procedural grounds while at the same time requesting an opportunity to substantively respond at a later date. There is no authority for such piecemeal motion practice and it would be inappropriate to begin such precedent in this situation.

Moreover, on November 19, 2015 Opposer wrote to Applicant seeking its consent to withdraw its dilution claim. [Freund Decl., ¶12, Exhibit A, November 19, 2015 email from Opposer's counsel to Applicant's counsel with accompanying letter.] Applicant coyly responded that its "consent is not necessary for Opposer to withdraw its dilution claim." [Freund Decl., ¶13, Exhibit B, November 19, 2015 email from Applicant's counsel to Opposer's counsel.] Opposer followed-up its request on November 20, 2015 specifically acknowledging that Applicant's consent is not necessary, however, Opposer was reiterating its request that Applicant inform Opposer whether or not it would consent to Opposer's withdrawal of its dilution claim. [Freund Decl., ¶14, Exhibit C, November 19, 2015 email from Opposer's counsel to Applicant's counsel.] Applicant never responded to Opposer's November 20, 2015 e-mail and proceeded to oppose the instant Motion on procedural grounds. [Freund Decl., ¶15.]

Applicant knows very well that Opposer was seeking Applicant's consent for Opposer's withdrawal of the dilution claim because its consent would only be required for the claim to be dropped *without prejudice*. [Trademark Rule 2.106(c).] There would thus be no reason to request consent for the claim to be dropped *with prejudice*. Since Applicant did not substantively respond to Opposer's requests for consent, Opposer filed the Motion to withdraw its dilution claim *with prejudice*. As such, Applicant's claim that Opposer's request for consent was "not proposed as a withdrawal *with prejudice*..." is nonsense.

Applicant in its Motion to Compel Discovery and Reply Brief in support thereof expends a lot of effort attempting to portray Opposer's counsel in a negative manner,

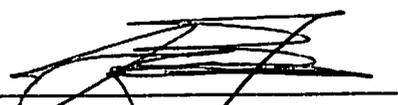
including Opposer's filing of the instant Motion. Not surprisingly, Applicant neglects to mention in its Response to the Motion its gamesmanship as shown above.²

III. CONCLUSION

For all the foregoing reasons, the Motion should be granted.

Respectfully Submitted,

Dated: January 4, 2016

By: 
Steven A. Freund, Esq.
Attorney for Opposer
Law Office of Steven A. Freund
A Professional Corporation
P.O. Box 911457
Los Angeles, CA 90091
Phone: 310-284-7929

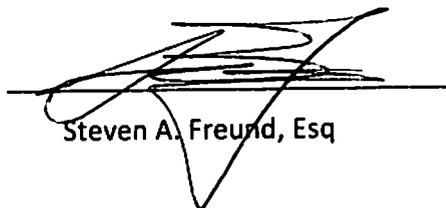
² Moreover, Applicant's Reply Brief In Support of Its Motion to Compel Discovery intentionally omits that Applicant refused to withdraw any part of its motion after Opposer requested it do so after service of its supplemental responses forcing Opposer to file a needless opposition. Instead and in contravention of Trademark Rule 2.120(e), Applicant requested Opposer provide a list of those discovery items it believed were rendered moot by its supplemental responses. [Freund Decl., ¶6, Exhibit D, November 17 e-mail from Applicant's counsel to Opposer's counsel.] Then in its Reply brief (and in contravention of Rule 2.120(e), Applicant attempts to portray Opposer as uncooperative in this regard. [Applicant's Reply Brief In Support of Motion To Compel Discovery at pgs.1 and 2.]

PROOF OF SERVICE

I hereby certify that a true and complete copy of the foregoing **OPPOSER OAKHURST INDUSTRIES, INC. DBA FREUND BAKING CO.'S REPLY IN SUPPORT OF ITS MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION** has been served on Applicant's counsel via First Class U.S. Mail on January 4, 2016, postage prepaid to:

Robert B.G. Horowitz
Baker & Hostetler LLP
45 Rockefeller Plaza, 14th Floor
New York, New York 10111-0100

Lesley McCall Grossberg
Baker & Hostetler LLP
2929 Arch Street
Cira Centre, 12th Floor
Philadelphia, PA 19104-2891



Steven A. Freund, Esq

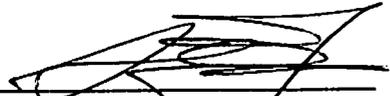
4. I followed-up Opposer's request on November 20, 2015 specifically acknowledging that Applicant's consent is not necessary, however, Opposer was reiterating its request that Applicant inform Opposer whether or not it would consent to Opposer's withdrawal of its dilution claim. A true and correct copy of my November 20, 2015 e-mail to Ms. Grossberg is attached hereto as "Exhibit C" and is incorporated by reference throughout.

5. Applicant's counsel never responded to my November 20, 2015 e-mail and proceeded to oppose the instant Motion on procedural grounds.

6. Instead and in contravention of Trademark Rule 2.120(e), Applicant requested Opposer provide a list of those discovery items it believed were rendered moot by its supplemental responses. A true and correct copy of Ms. Grossberg's November 17, 2015 e-mail is attached hereto as "Exhibit D" and is incorporated by reference throughout.

I declare under the penalty of perjury under the laws of the State of California that the foregoing is true and correct and that this declaration was executed on the 4th day of January, 2016, at Los Angeles, California.

Dated: January 4, 2016

By: 

Steven A. Freund, Esq.
Attorney for Opposer
Law Office of Steven A. Freund
A Professional Corporation
P.O. Box 911457
Los Angeles, CA 90091
Phone: 310-284-7929

Exhibit A

From: Steven Freund [mailto:sfreund@freundlawfirm.com]
Sent: Thursday, November 19, 2015 3:27 PM
To: 'Grossberg, Lesley'
Cc: 'Horowitz, Robert B. G.'
Subject: RE: FREUND'S FAMOUS opposition proceeding No. 91218523

Dear Ms. Grossberg,

Please see my attached letter of today's date.

Thank you for your time and attention to this matter.

Steven A. Freund, Esq.
Law Office of Steven A. Freund
P.O. Box 911457
Los Angeles, CA 90091
[310-284-7929](tel:310-284-7929)
[310-284-8341](tel:310-284-8341) (fax)
sfreund@freundlawfirm.com
www.freundlawfirm.com

This message is a confidential communication from a law firm. Interception of this message is a violation of the Electronic Communications Privacy Act, 18 U.S.C. 2510-2521 and 2707-2709. This message may be protected by the attorney-client privilege and/or the attorney work-product doctrine. If you are not the intended recipient of this message, any disclosure, copying, distribution or use of the information contained in or attached to this message is prohibited. If you have received this message in error, please immediately delete the message and any attachments, and notify me at [\(310\)284-7929](tel:3102847929). Thank you.

 **15.11.19.to.pdf**
25K

LAW OFFICE OF
STEVEN A. FREUND
A PROFESSIONAL CORPORATION
P.O. BOX 911457
LOS ANGELES, CA 90091
TELEPHONE (310) 284-7929
FACSIMILE (310) 284-8341
www.freundlawfirm.com

November 19, 2015

**VIA FIRST CLASS MAIL AND
ELECTRONIC MAIL (LGrossberg@bakerlaw.com)**

Lesley M. Grossberg, Esq.
Baker & Hostetler LLP
2929 Arch Street
Cira Center, 12th Floor
Philadelphia, PA 19104-2891

Re: **Oakhurst Industries, Inc. dba Freund Baking Co. v. 13th Ave Fish Market
Inc. dba Freund's Fish**
Opposition No.: **91218523**

Dear Ms. Grossberg:

I am writing in regard to Opposer's dilution claim. Please advise the undersigned if you will be willing to consent to Opposer's dismissal of its dilution claim.

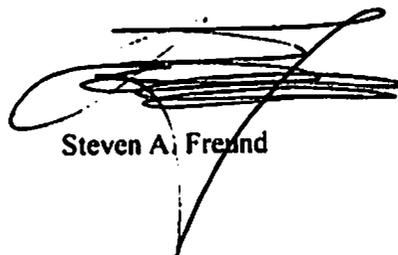
I look forward to your prompt reply.

Thank you for your time and attention to this matter.

Lastly, everything contained in this letter is written pursuant to Federal Rules of Evidence Rule 408 in that we intend it to further settlement.

Respectfully yours,

Law Office of Steven A. Freund


Steven A. Freund

SAF:rd
cc: (R. Horowitz, Esq. via e-mail)

Exhibit B

From: Grossberg, Lesley [mailto:LGrossberg@bakerlaw.com]
Sent: Thursday, November 19, 2015 3:58 PM
To: Steven Freund
Cc: Horowitz, Robert B. G.; Mahoney, Cynthia; BH IP Docket
Subject: RE: FREUND'S FAMOUS opposition proceeding No. 91218523

Dear Mr. Freund,

Applicant's consent is not necessary for Opposer to withdraw its dilution claim.

Best,

Lesley

Lesley McCall Grossberg | BakerHostetler
2929 Arch Street | Cira Centre, 12th Floor | Philadelphia, PA 19104-2891
T [215.564.3007](tel:215.564.3007) | F [215.566.3439](tel:215.566.3439)
lgrossberg@bakerlaw.com

Exhibit C

From: Steven Freund [mailto:sfreund@freundlawfirm.com]
Sent: Friday, November 20, 2015 11:47 AM
To: 'Grossberg, Lesley'
Cc: 'Horowitz, Robert B. G.'; 'Mahoney, Cynthia'; 'BH IP Docket'
Subject: RE: FREUND'S FAMOUS opposition proceeding No. 91218523

Dear Ms. Grossberg,

Technically you are correct. However, Opposer is entitled to seek your consent to withdraw its dilution claim. So please let me know if you will consent for Opposer to withdraw its dilution claim. If not, then also please let me know.

Thank you for your time and attention to this matter.

Everything contained in this e-mail is written pursuant to Federal Rules of Evidence Rule 408 in that we intend it to further settlement.

Steven A. Freund, Esq.
Law Office of Steven A. Freund
P.O. Box 911457
Los Angeles, CA 90091
[310-284-7929](tel:310-284-7929)
[310-284-8341](tel:310-284-8341) (fax)
sfreund@freundlawfirm.com
www.freundlawfirm.com

This message is a confidential communication from a law firm. Interception of this message is a violation of the Electronic Communications Privacy Act, 18 U.S.C. 2510-2521 and 2707-2709. This message may be protected by the attorney-client privilege and/or the attorney work-product doctrine. If you are not the intended recipient of this message, any disclosure, copying, distribution or use of the information contained in or attached to this message is prohibited. If you have received this message in error, please immediately delete the message and any attachments, and notify me at [\(310\)284-7929](tel:3102847929). Thank you.

Exhibit D

From: "Grossberg, Lesley" <LGrossberg@bakerlaw.com>
To: "Steven Freund" <sfreund@freundlawfirm.com>
Cc: "Horowitz, Robert B. G." <rhorowitz@bakerlaw.com>, "Mahoney, Cynthia" <cmahoney@bakerlaw.com>
Subject: FREUND/SFAMOUS opposition proceeding No. 91218523
Date: Tue, Nov 17, 2015 9:10 AM

Mr. Freund,

I received Opposer's supplemental document production on Friday evening and have now had a chance to review it. I disagree that all of the issues presented in the pending motion are resolved by the supplemental discovery responses. If you'd like to let me know which issues you think have been addressed by the supplemental discovery responses, I'd be happy to discuss and try to resolve them without Board intervention.

As for your intimation that the motion was filed without having engaged in good faith in the meet and confer process, the parties' meet and confer efforts are fully set forth in the motion and speak for themselves.

With respect to Opposer's supplemental response to Interrogatory No. 17, is Opposer willing to further supplement this response by identifying the individual who contacted Opposer on September 19, 2015, and the nature or content of that communication?

Regards,

Lesley

Lesley McCall Grossberg | BakerHostetler
2929 Arch Street | Cira Centre, 12th Floor | Philadelphia, PA 19104-2891
T [215.564.3007](tel:215.564.3007) | F [215.568.3439](tel:215.568.3439)
lgrossberg@bakerlaw.com

From: Steven Freund [mailto:sfreund@freundlawfirm.com]
Sent: Friday, November 13, 2015 6:46 PM
To: Grossberg, Lesley
Cc: Horowitz, Robert B. G.
Subject: FREUND'S FAMOUS opposition proceeding No. 91218523

Dear Ms. Grossberg,

Please find attached my letter of today's date.

Thank you for your time and attention to this matter.

Steven A. Freund, Esq.

Law Office of Steven A. Freund

P.O. Box 911457

Los Angeles, CA 90091

310-284-7929

310-284-8341 (fax)

sfreund@freundlawfirm.com

www.freundlawfirm.com

This message is a confidential communication from a law firm. Interception of this message is a violation of the Electronic Communications Privacy Act, 18 U.S.C. 2510-2521 and 2707-2709. This message may be protected by the attorney-client privilege and/or the attorney work-product doctrine. If you are not the intended recipient of this message, any disclosure, copying, distribution or use of the information contained in or attached to this message is prohibited. If you have received this message in error, please immediately delete the message and any attachments, and notify me at (310)284-7929. Thank you.

addressed and may contain information that is privileged, confidential, or protected by law. If you are not the intended recipient you are hereby notified that any dissemination, copying or distribution of this email or its contents is strictly prohibited. If you have received this message in error, please notify us immediately by replying to the message and deleting it from your computer.

Any tax advice in this email is for information purposes only. The content of this email is limited to the matters specifically addressed herein and may not contain a full description of all relevant facts or a complete analysis of all relevant issues or authorities.

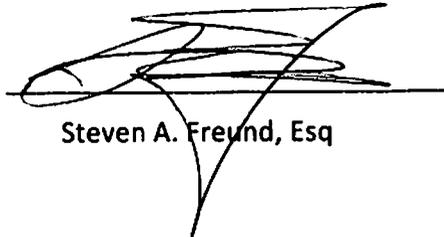
Internet communications are not assured to be secure or clear of inaccuracies as information could be intercepted, corrupted, lost, destroyed, arrive late or incomplete, or contain viruses. Therefore, we do not accept responsibility for any errors or omissions that are present in this email, or any attachment, that have arisen as a result of e-mail transmission.

PROOF OF SERVICE

I hereby certify that a true and complete copy of the foregoing **DECLARATION OF STEVEN FREUND IN SUPPORT OF OPPOSER OAKHURST INDUSTRIES, INC. DBA FREUND BAKING CO.'S REPLY IN SUPPORT OF ITS MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION** and accompanying exhibits have been served on Applicant's counsel via First Class U.S. Mail on January 4, 2016, postage prepaid to:

Robert B.G. Horowitz
Baker & Hostetler LLP
45 Rockefeller Plaza, 14th Floor
New York, New York 10111-0100

Lesley McCall Grossberg
Baker & Hostetler LLP
2929 Arch Street
Cira Centre, 12th Floor
Philadelphia, PA 19104-2891



Steven A. Freund, Esq