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

Proceeding	91219179
Party	Defendant United Yacht Transport LLC dba United Yacht Transport
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

SPLIETHOFF'S BEVRACHTINGSKANTOOR B.V.,

Opposer,

vs.

Opposition No. 91219179

Serial No. 86031633

UNITED YACHT TRANSPORT LLC,

Applicant.

_____ /

**APPLICANT'S RESPONSE IN OPPOSITION
TO SPLIETHOFF'S OPPOSED MOTION FOR RECONSIDERATION/
CLARIFICATION OF SCOPE OF JUNE 16, 2016 SUSPENSION ORDER**

Applicant, United Yacht Transport LLC ("United"), opposes Spliethoff's motion for reconsideration of the scope of the June 16, 2016 suspension order, and states:

Background

Spliethoff's Bevrachtingskantoor B.V. ("Spliethoff") commenced this proceeding, opposing United's right to register the service mark UNITED YACHT TRANSPORT. Spliethoff alleges that it acquired superior rights to the mark after purchasing the assets of Dockwise Yacht Transport LLC from Koninklijke Boskalis Westminster N.V. ("Boskalis"), which had recently acquired Dockwise Yacht Transport LLC's parent company, Dockwise, Ltd.

United contends that Dockwise Yacht Transport LLC stopped using the UNITED YACHT TRANSPORT mark in 2000, abandoned any rights to the mark, and any further use was *di minimus* and an effort to reserve rights in the mark. United is seeking discovery related to its abandonment defense, including document requests to Dockwise, Ltd. and a deposition on written questions to André Goedée, the former CEO of Dockwise, Ltd.

On June 15, 2016, United filed a Notice of Taking the Deposition on Written Questions of André Goedée (Dkt. 30). Because both Mr. Goedée and Dockwise, Ltd. are located in the Netherlands, United filed a Consent Motion to Extend Discovery Period, or in the Alternative, Opposed Motion to Suspend Proceedings (Dkt. 29), requesting that the proceedings be suspended pending (1) the orderly completion of the deposition on written questions of Mr. Goedée in the Netherlands via the Hague Convention, and (2) the return of documents from Dockwise, Ltd. pursuant to a letter of request served via the Hague Convention.

Trademark Rule § 2.124(d)(2) provides: “Upon receipt of written notice that one or more testimonial depositions are to be taken upon written questions, the Trademark Trial and Appeal Board shall suspend or reschedule other proceedings in the matter to allow for the orderly completion of the depositions upon written questions.” Thus, on June 16, 2016, an order was entered suspending the proceedings pursuant to Trademark Rule 2.124(d)(2) “to allow the parties sufficient time in which to complete the discovery deposition on written questions of André Goedée.” (Dkt. 31).

The order appears to have been entered based solely on the deposition notice (Dkt. 30), as it did not reference the pending motion (Dkt. 29) and did not address the request to suspend the proceedings pending return of the letter of request for documents from Dockwise, Ltd. (*Id.*). For the reasons stated in its Consent Motion to Extend Discovery Period, or in the Alternative, Opposed Motion to Suspend Proceedings (Dkt. 29), these proceedings should be suspended and remain suspended pending completion of the deposition on written questions of André Goedée and return of documents from Dockwise, Ltd.

Argument

In addressing discovery from non-parties located in foreign countries, the Trademark Trial and Appeal Board Manual of Procedure provides:

During the interim [from filing the initial letter of request to receipt of the discovery], proceedings in the case before the Board most likely will be suspended pending the execution and return to the Board of the letter rogatory.

TBMP § 404.03(c)(2). Notwithstanding, Spliethoff has moved for reconsideration or clarification of the suspension order, requesting that these proceedings only be suspended with respect to certain issues, specifically, its claim to priority of rights in the UNITED YACHT TRANSPORT mark. Spliethoff requests that it be permitted to take discovery and file motions directed at several other issues raised in its pleadings, namely, its claim of fraudulent misrepresentations to the USPTO, its claim that United's trademark application was void *ab initio*, and its proposed claim that United lacked an Ocean Transport Intermediary license, which is the subject of a pending motion for leave to amend.

Spliethoff's motion for reconsideration should be denied, as its proposal is unworkable, would necessarily result in ineffective and inefficient management of this case, and would unfairly burden the parties and witnesses. Spliethoff effectively requests an order bifurcating the issues in this proceeding, both for discovery and resolution, apparently seeking separate deadlines for the various issues, some of which would be reopened while others remain suspended. But the issue in this case cannot be bifurcated as Spliethoff has proposed.

United's primary defense in this action is that Spliethoff's predecessor abandoned all rights to the UNITED YACHT TRANSPORT mark, and that any use after such time was *de minimus* and simply an attempt to reserve rights in the mark. Spliethoff incorrectly contends that priority of use is the sole subject at issue in the deposition of Goedée and the document requests

to Dockwise, Ltd. But United’s defense is critical not only to the question of priority but also to Spliethoff’s claim of fraud. Specifically, in its notice of opposition, Spliethoff alleges that United falsely represented to the USPTO that it believed itself to be the owner of the mark sought to be registered, and that no other person or entity had the right to use the mark in commerce. (Second Am. Notice of Opp. ¶ 35). But there was nothing “false” about this representation because Spliethoff’s predecessor had already abandoned the mark. Accordingly, discovery from Goedée and Dockwise, Ltd. related to abandonment of the mark is relevant not only to the claim of priority but also to the claim of fraud. Thus, a dispositive ruling cannot be made on either issue prior to the completion of discovery related to abandonment by Spliethoff’s predecessor. Spliethoff’s fraud claim simply cannot proceed during the suspension of this proceeding pending the discovery to Goedée and Dockwise, Ltd. pursuant to the Hague Convention.

Separate from the complete overlap of issues that Spliethoff proposes to reopen and the issues that would remain suspended, allowing discovery to proceed on certain limited issues would inevitably require witnesses to be deposed twice, including United’s corporate representatives and the officers and employees of Spliethoff’s predecessor—once for any issues that are allowed to proceed, and again after the Hague Convention discovery is complete for any issues that had been subject to suspension. Further, United has requested emails and other documents from Dockwise, Ltd., which will be critical for the depositions of the officers and employees of Spliethoff’s predecessor.¹ If United was required to move forward with discovery of certain issues, notwithstanding the suspension, prior to receiving such documents from Dockwise, Ltd., United would have to depose these witnesses again after the documents were provided.

¹ United previously requested similar documents from Spliethoff. Spliethoff represented that it had acquired some, but not all, records of Dockwise Yacht Transport LLC, and that it did not have certain documents requested by United. United thus has requested similar documents from Dockwise, Ltd.

In addition, Spliethoff is requesting that it be permitted to file dispositive motions directed at certain claim(s) that are not at issue in the international discovery under the Hague Convention (and others that are). This would inevitably lead to multiple rounds of dispositive motions requiring rulings by the Board both before and after the completion of the international discovery and the lifting of the suspension.

Conclusion

In sum, Spliethoff has proposed a bifurcation of the proceedings that would lead to inefficient and ineffective case management, would require multiple witnesses to be deposed twice, and would require rulings from the Board on multiple rounds of dispositive motions. This proceeding should remain suspended throughout the pending international discovery and reopen for the completion of discovery on all issues once the international discovery under the Hague Convention is complete.

Respectfully submitted,

Dated: August 5, 2016

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true and correct copy of the foregoing has been served upon J. Michael Pennekamp, Esq. (jpennekamp@fowler-white.com) and to Sandra I. Tart, Esq. (start@fowler-white.com), by electronic mail and U.S. Mail, J. Michael Pennekamp, Esq., Sandra I. Tart, Esq., FOWER WHITE BURNETT, P.A., Espirito Santo Plaza, Fourteenth Floor, 1395 Brickell Avenue, Miami, FL 33131.

Signature: /s/ Bryan D. Hull
Date: August 5, 2016