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

Proceeding	91219179
Party	Plaintiff Spliethoff's Bevrachtungskantoor B.V.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Opposition No. 91219179

Serial No. 86031633

SPLIETHOFF'S BEVRACHTINGSKANTOOR B.V.,

Opposer,

v.

UNITED YACHT TRANSPORT LLC.,

Applicant.

**OPPOSER'S REPLY IN SUPPORT OF MOTION
FOR RECONSIDERATION/CLARIFICATION OF SCOPE
OF JUNE 16, 2016 SUSPENSION ORDER**

Opposer SPLIETHOFF'S BEVRACHTINGSKANTOOR B.V. ("Spliethoff"), by and through its undersigned counsel, hereby files this reply in support of its Motion for Reconsideration/Clarification of Scope of June 16, 2016 Suspension Order ("Motion"). (DE 37).

On June 15, 2016, Applicant filed a Notice of Taking Deposition Upon Written Questions of foreign non-party Andre Goedee. (DE 30). The next day, on June 16, 2016, an Order was entered herein pursuant to Trademark Rule 2.214(d)(2) which suspended proceedings "in order to allow the parties sufficient time in which to complete the discovery deposition on written questions of Andre Goedee." (DE 31). On July 14, 2016, Spliethoff filed the instant Motion. (DE 37).

**Suspension of This Proceeding In Its Entirety Is
Unnecessary and Highly Prejudicial to Spliethoff**

As of this date, two months and two days from the entry of the Suspension Order (DE 31), Applicant's proposed international discovery of foreign non-parties Goedee (deposition upon written

questions) and Dockwise (document requests) under the Hague Convention have not yet been served. In fact, Applicant's Motion for the Board to Issue a Letter of Request for International Judicial Assistance regarding the proposed deposition on written questions to Goedee has not yet been filed.¹

Therefore, the "unintended consequence" of the Suspension Order is that Applicant has received the benefit of a two-month suspension of this proceeding even though Applicant's proposed discovery deposition upon written questions to foreign non-party Goedee – the stated reason for the entry of the Suspension Order under Trademark Rule 2.124(d)(2) – are still in the drafting stage.

The Suspension Order has created an immensely one-sided and unfair situation for Spliethoff. By filing a Notice of Taking Deposition on Written Questions on June 15, 2016, Applicant has brought this proceeding to a complete halt. Spliethoff asks the Board to remedy this untenable situation forthwith by entering an Order which vacates DE 31 and/or narrows scope of the Suspension Order so that, without leave of the Board, Spliethoff may file motions (discovery and dispositive) relating to its opposition grounds which have no relationship to the subject of Applicant's proposed discovery of foreign non-parties Goedee and Dockwise.

¹ This delay reflects the generally cumbersome process of depositions on written questions and foreshadows the much longer delay expected before Applicant's proposed international discovery of Goedee and Dockwise is completed. (*see* TBMP § 404.03(c)(2) and DE 37 at n. 1). A motion filed by Applicant on June 23, 2016 states that Applicant proposes to file its Motion for Issuance of Letters of Request concerning its deposition on written questions to Goedee after "all cross-examination and redirect deposition questions have been served by the parties." (DE 34 at 2). On July 15, 2016 and August 1, 2016, Spliethoff filed objections to certain of Applicant's written questions and amended written questions for deponent Goedee. (DE 38 and 41).

**Applicant's Speculative Opposition Arguments Do Not Justify
The Suspension Of All Activity In This Proceeding Until
Applicant's Discovery Deposition On Written Questions Or
Document Requests to Foreign Non-Parties Are Completed**

Applicant's three arguments in opposition to Spliethoff's Motion fail to offer any persuasive reason for this proceeding to be suspended in its entirety until Applicant's proposed international discovery is completed.

Applicant's first argument that total suspension of the case is required because there is an "overlap of issues" between its abandonment defense (to which its proposed discovery relates) and one of Spliethoff's fraud claims is facially unconvincing. This argument is the epitome of the "tail wagging the dog." As the Board recognized in its March 1, 2016 Order (DE 22 at 1 - 2), Spliethoff's Second Amended Notice of Opposition pleads two separate fraud claims: its "first" fraud claim (Applicant filed and continued to prosecute its Application with knowledge of Dockwise's prior rights in the Mark) and its "second" fraud claim (Applicant made false representations to the USPTO regarding its use of the Mark in commerce). Applicant's "overlap" argument is confined to Spliethoff's "first" fraud claim. (DE 43 at 3).² Therefore, even assuming *arguendo* that there is an overlap of issues as Applicant claims, that is not a basis upon which to preclude Spliethoff from filing discovery or dispositive motions relating to its "second" fraud claim, non-use claim or proposed "unlawful use" claim.

Moreover, Applicant's "overlap" argument is premature and ignores established procedure under Fed. R. Civ. P. 56(d). Applicant asserts that total suspension is necessary because no

² Applicant argues: "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," citing ¶ 35 of Spliethoff's Notice of Opposition. (DE 43 at 4).

dispositive ruling can be made on either its abandonment defense or Spliethoff's [first] fraud claim "prior to the completion of discovery related to abandonment by Spliethoff's predecessor." (DE 43 at 3). However, if Spliethoff were to file a motion for summary judgment based on its "first" fraud claim before Applicant's deposition on written questions of Goedee is completed, Applicant at that time could ask the Board to defer ruling on the motion or seek other relief under Rule 56(d) on the ground that Applicant was awaiting evidence from its international discovery.

In addition, total suspension of this proceeding unfairly allows Applicant to pursue discovery while precluding Spliethoff from moving to compel answers to its previously-served discovery. For example, Applicant objected to Spliethoff's document requests and interrogatories focused on facts relevant to Spliethoff's "first" fraud claim.³ Allowing Spliethoff to file a motion to compel regarding this discovery and other discovery disputes arising from Spliethoff's previously-served written discovery (*see* DE 37 at 6) would not interfere with Applicant's proposed discovery of Goedee or Dockwise.

Applicant's second argument that without a total suspension of this case witnesses "inevitably" would be required "to be deposed twice" (DE 43 at 4) misapprehends the relief Spliethoff is seeking. To be clear and, with apologies if the Motion was not so, Spliethoff is not seeking a modification of the Suspension Order to allow it to take depositions before Applicant's proposed international discovery is completed.

³ With regard to its "first" fraud claim, Spliethoff served document requests and interrogatories seeking information as to the reasons why Applicant adopted the Mark for its business and Applicant's own knowledge and beliefs regarding Dockwise's rights in the Mark and Applicant objected to same. *See* Spliethoff's Second Set of Interrogatories ## 21, 22, 28 – 31 and Spliethoff's Second Request for Production of Documents ## 13- 19, 24, 25, 27 – 29, 31, 39 -43. (Exh. 2 and 7 to DE 37).

Applicant's final argument that permitting Spliethoff to file dispositive motions on issues or claims unrelated to the proposed international discovery would "inevitably" lead to "multiple rounds of dispositive motions" (DE 43 at 5) is not a reason for this proceeding to be suspended in its entirety. Pursuant to TBMP § 528.02, a party has the right to move for summary judgment at any time after making its initial disclosures. Where, as here, a proceeding involves independent, potentially dispositive opposition claims and defenses, parties may move for summary judgment on different issues at different times and multiple summary judgment motions may be filed. This would be routine procedure. In the instant case, Spliethoff's "second" fraud claim, its non-use claim and its proposed unlawful use claim bear no factual or legal relationship to Applicant's abandonment defense. Therefore, Applicant's decision to notice a foreign deponent for a deposition on written questions, and to pursue other "international discovery" relative to this defense, should have no bearing on Spliethoff's ability to move for summary judgment on its opposition grounds which are wholly unrelated to the topics of Applicant's proposed discovery. (As previously noted, Applicant itself has only claimed that there is an "overlap" between its discovery issues and Spliethoff's "first" fraud claim).

Irrespective of any evidence that Applicant may ultimately obtain from non-parties Goedee and Dockwise, and without waiting for this discovery to be completed, the Board could properly grant a motion for summary judgment which refuses registration of the Mark based upon Spliethoff's "second" fraud claim, its claim that the subject Application is *void ab initio*, and/or, if amendment is allowed, its proposed claim of unlawful use based on Applicant's use of the Mark in violation of the Shipping Act of 1984. Merely because Applicant proposes to pursue discovery on one of its

defenses, Spliethoff should not have its "hands tied" from moving for summary judgment on any of its independent, unrelated opposition grounds.

Conclusion

To summarize, Spliethoff requests that the Board forthwith issue an Order which vacates or reconsiders the June 16, 2016 Suspension Order (DE 31) and that the terms of any future case management order entered based on Trademark Rule 2.214(d)(2) would allow motion practice regarding any discovery or substantive issues which have no connection to Applicant's proposed international discovery to Goedee and Dockwise.

In addition, Spliethoff requests that the Trademark Board rule on its pending Motion for Leave to File Third Amended Notice of Opposition to add the opposition ground of "unlawful use." The Motion was filed on June 7, 2016 and has been fully briefed. (DE 26, 32 and 36).

The case management approach proposed by Spliethoff is based on common sense and would "make good use" of the lengthy time period anticipated for Applicant's international discovery under the Hague Convention to be completed. It would allow Spliethoff to file motions to compel concerning present discovery disputes arising from Spliethoff's previously-served written discovery to Applicant and to obtain rulings from the Board on the merits its opposition claims which are unrelated to Applicant's proposed discovery to Goedee and Dockwise. The Board has the inherent authority and the discretion under TBMP § 404.07(b) to grant the relief regarding case management sought by Spliethoff.

Opposition No. 91219179
Opposer's Reply in Support of Motion for
Reconsideration/Clarification of Scope of
June 16, 2016 Suspension Order

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Opposer's Reply in Support of Motion for Reconsideration/Clarification of Scope of June 16, 2016 Suspension Order has been e-filed via ESTTA and served upon Bryan D. Hull, Esquire, counsel for Applicant United Yacht Transport, LLC, by email to bhull@bushross.com, this 17th day of August, 2016.

/s/ Sandra I. Tart

Sandra I. Tart