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

Proceeding	91219607
Party	Defendant Vubiquity, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

VIEWBIQUITY, LLC

Registrant/Opposer,

vs.

VUBIQUITY, INC.

Applicant/Respondent.

Opposition No. 91219607

Mark: VUBIQUITY

**VUBIQUITY, INC.'S AMENDED MOTION TO COMPEL RULE 26 DISCLOSURES
AND DISCOVERY RESPONSES AND MEMORANDUM OF LAW IN
SUPPORT THEREOF**

Respondent Vubiquity, Inc. (“Respondent”) moves pursuant to Federal Rules of Civil Procedure Rules 33 and 34, 37(a)(3)(A) and 37(a)(3)(B), and Trademark Trial and Appeal Board (“TTAB”) Trademark Manual of Procedure (“TBMP”) Rule 523, 37 CFR § 2.120(e), for an order: (i) compelling Viewbiquity, LLC (“Opposer”) to make required initial disclosures under Federal Rule of Civil Procedure Rule 26(a)(1)(A); (ii) compelling Opposer to produce documents in response to Respondent’s First Request for Production of Documents and Things, duly served on May 20, 2016 (the “Document Demands”); (iii) compelling Opposer to respond to Respondent’s First Set of Interrogatories (the “Interrogatories”), duly served on May 18, 2016; and (iv) granting such other and further relief as the Board deems just and proper.

Respondent submits this memorandum of law, along with the Declaration of Merit, sworn to by Amy B. Goldsmith on July 8, 2016, together with exhibits annexed thereto (the “Goldsmith Declaration”), in support of its motion.

PRELIMINARY STATEMENT

This motion is made necessary because while Opposer had no problem commencing the above-captioned Opposition, it has an apparent aversion to fulfilling its own disclosure and discovery obligations. After the Rule 26(f) conference, Respondent duly served its Rule 26(a)(1)(A) disclosures (on May 6, 2016) and its Interrogatories and Document Demands (on May 18, 2016). Respondent also prepared the Standard Protective Order and sent it to Opposer’s counsel for her review. (Goldsmith Declaration, ¶¶2, 3 and 6). Respondent never received any disclosures from Plaintiff or comments on the Protective Order despite numerous phone calls and emails to opposing counsel Alice Sum, Esq. (Goldsmith Declaration, ¶¶3, 5 and 7). After the June 22, 2016 due date for the Interrogatories and Document Demands, additional phone calls

and emails were sent and no reply was received nor was any extension requested. (Goldsmith Declaration, ¶¶11 and 12).

Accordingly, Vubiquity requests the Board to compel Opposer to make its required initial disclosures, respond to the Interrogatories, and produce documents responsive to Respondent's Document Demands.

STATEMENT OF FACTS

The Board is respectfully referred to the accompanying Goldsmith Declaration for a full recitation of the facts relevant to the instant motion. These facts support Ms. Goldsmith's good faith efforts, by multiple phone calls and email messages, to attempt to confer with Ms. Sum regarding Opposer's failure to serve Rule 26 disclosures or respond to the Interrogatories and Document Demands. (Goldsmith Declaration). Ms. Sum has utterly failed to engage with Ms. Goldsmith. These facts reflect an unresolvable situation between the parties.

ARGUMENT

I. OPPOSER MUST BE COMPELLED TO MAKE ITS REQUIRED RULE 26(a)(1)(A) DISCLOSURES

Federal Rule of Civil Procedure 26(a)(1)(A) provides that a party must provide to the other party, without waiting for a discovery request, a list of individuals having discoverable information and a copy or description of documents that the party may use to support its claims and defenses. Respondent duly served its Rule 26 disclosures on Opposer's counsel on May 6, 2016, which was within 14 days after the parties' Rule 26(f) conference. (Goldsmith Declaration, ¶3). Opposer has never served its Rule 26 disclosures on Respondent's counsel. (Goldsmith Declaration, ¶5).

In accordance with 37 CFR § 2.120(e); Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42256 (August 1, 2007), “A motion to compel is the available remedy when an adversary has failed to make, or has made inadequate, initial disclosures or disclosures of expert testimony. Both of these types of disclosures are made during discovery, and a motion to compel must precede a motion for sanctions.”

Federal Rule of Civil Procedure 37(a)(1) provides that “a party may move for an order compelling disclosure or discovery. The motion must include a certification that the movant has in good faith conferred or attempted to confer with the person or party failing to make disclosure or discovery in an effort to obtain it without court action.”

The Goldsmith Declaration sets forth the numerous efforts made by Ms. Goldsmith to attempt to confer with Ms. Sum. These efforts did not work as Ms. Sum has not responded at all, either by phone or email. The Board expects the parties’ counsel to cooperate with one another. The Board’s discussion in *Cadbury UK Limited v. Meenaxi Enterprise, Inc.*, 115 U.S.P.Q.2d 1404 (TTAB 2015) is applicable here.

It also must be stressed that Petitioner's conduct has not demonstrated the good faith and cooperation that is expected of litigants during discovery. Such conduct has delayed this proceeding, unnecessarily increased the litigation costs of the parties, wasted valuable Board resources, and interfered with Respondent's ability and, indeed, its right, to take discovery. If Respondent perceives Petitioner as not having complied with the terms of this order, or can establish any further abusive, uncooperative, or harassing behavior from Petitioner, then Respondent's remedy will lie in a motion for entry of sanctions. Sanctions the Board can order, if warranted, may include judgment against Petitioner. See TBMP § 527.01 (Motion for Discovery Sanctions) and cases cited therein; cf. *Johnston Pump/Gen. Valve Inc. v. Chromalloy Am. Corp.*, 13 USPQ2d 1719, 1721 n.4 (TTAB 1989) and cases cited therein.

**OPPOSER MUST BE COMPELLED TO
PRODUCE RESPONSIVE DOCUMENTS FORTHWITH**

Federal Rule of Civil Procedure 37(a)(3)(B) provides that “[a] party seeking discovery may move for an order compelling an answer, designation, production, or inspection. This motion may be made if: (iii) a party fails to answer an interrogatory submitted under Rule 33; or (iv) a party fails to respond that inspection will be permitted—or fails to permit inspection—as requested under Rule 34.” As set forth more fully in the Goldsmith Declaration, Respondent duly served Opposer with its Interrogatories and Document Demands on May 18, 2016. Without seeking an extension and without notifying Respondent that it would not be responding to the interrogatories or producing any documents, the Opposer defaulted on its obligation to respond to interrogatories and produce responsive documents.

In good faith, Respondent waited over two weeks to see if Opposer’s responses to the interrogatories and document requests would arrive in the mail. (Goldsmith Declaration, ¶¶12-13). They did not. As set forth in the Goldsmith Declaration, Ms. Goldsmith called and left multiple messages for and sent multiple emails to Alice Sum, counsel for Opposer, regarding her lack of responsiveness, to no avail. (Goldsmith Declaration, ¶¶12-13).

This failure to prosecute its own Opposition action is unconscionable and prejudicial to Respondent, who is acting in good faith. The facts are not in dispute. In good faith, Ms. Goldsmith attempted to confer with Ms. Sum regarding Opposer’s failure to serve the required Rule 26 disclosures and failure to respond to the Interrogatories and Document Demands. Opposer is delaying its own Opposition, causing increased costs to Respondent, and is interfering with Respondent’s right to take discovery. These actions are disfavored by the Board. See *Cadbury UK Limited v. Meenaxi Enterprise, Inc.*, 115 U.S.P.Q.2d 1404.

CONCLUSION

Based on the foregoing, Respondent respectfully moves the Board for an Order: (i) compelling Opposer to make required initial disclosures under Federal Rule of Civil Procedure Rule 26(a)(1)(A); (ii) compelling Opposer to produce documents in response to the Document Demands; (iii) compelling Opposer to respond to the Interrogatories; and (iv) granting such other and further relief as the Board deems just and proper, all within fifteen (15) days from the date of the Order.

WHEREFORE, Respondent respectfully requests that the Trademark Trial and Appeal Board grant its Motion to Compel and grant all other appropriate relief.

Dated: New York, New York
July 11, 2016

Respectfully submitted,

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By: _____


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Certificate of Service

I hereby certify that on July 11, 2016, a true and complete copy of the foregoing **VUBIQUITY, INC.'S AMENDED MOTION TO COMPEL RULE 26 DISCLOSURES AND DISCOVERY RESPONSES AND MEMORANDUM OF LAW IN SUPPORT THEREOF** and **DECLARATION OF MERIT OF AMY B. GOLDSMITH, ESQ.** have been served on Viewbiquity, LLC via electronic mail and First Class Mail addressed to counsel of record:

Alice Sum
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Amy B. Goldsmith, Attorney for
Applicant/ Respondent Vubiquity, Inc.