

ESTTA Tracking number: **ESTTA723690**

Filing date: **01/29/2016**

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

Proceeding	91220166
Party	Defendant The Wine Group, LLC
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Attachments	Reply on Motion to Compel.pdf(54721 bytes)

1 **BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE**
2 **TRADEMARK TRIAL AND APPEAL BOARD**

3 Application Serial No. 86/348,425

4 Mark: FLORET

5 Class: 33

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7 _____)
8 **FLOWERS VINEYARD AND WINERY,**)
9 **LLC,**)

9 Opposer,)

10 v.)

11 **THE WINE GROUP LLC.,**)

12 Applicant.)
13 _____)

Opposition No: 91220166

**APPLICANT’S REPLY MEMORANDUM
ON ITS MOTION TO COMPEL**

14 Applicant hereby submits this brief reply to Opposer’s Opposition Memorandum.

15 **Meet and Confer.** Courts and the Board require the parties to meet and confer before
16 bringing discovery motions because it increases the likelihood that a dispute can be resolved
17 informally and it potentially reduces the number of issues. Both parties have an obligation to act
18 in good faith. The adequacy of a meet and confer should not be measured by the number of e-
19 mails or letters or phone calls. Instead, it should be measured by whether the parties attempted
20 to resolve the dispute.

21 Here the Applicant followed the basic procedure that is followed in most courts in the
22 country. On July 21 it sent a five page, single-spaced letter to Opposer detailing the issues with
23 the responses and citing authorities supporting its position. (Applicant’s Mem., Ex. A). As
24 detailed in Exhibit A to Applicant’s Memorandum, Opposer did not respond in a timely way.

1 After a reminder from Applicant, Opposer promised a response but then did not provide one, and
2 on October 6 Applicant sent another written reminder. Opposer responded on October 7 -- 2/12
3 months after the initial letter. Therein it disagreed with each and every one of Applicant's issues.
4 (Id., Ex. B). It did not cite a single case to contradict any of the authority set forth in the initial
5 letter. In many cases it provided no explanation for why it believed its response or objections
6 were proper.

7 At that point, it was very clear that Opposer was not going to produce any additional
8 documents or supplement its interrogatory responses. Any further communications would have
9 been futile. Applicant should not, as suggested by Opposer, have been required to write yet
10 another letter in a futile attempt to make Opposer change its mind or to see if Opposer was really
11 serious. In the face of obvious intransigence, that would only drive up the cost of the
12 proceeding.

13 If any party did not act in good faith it was Opposer who dragged its heels in responding
14 to the letter, was uncompromising, and left Applicant no choice but to take the issues to the
15 Board. But even then Applicant reassessed its position, considered the responses, and raised
16 **only four** of the many issues with the Board. To that extent the meet and confer process was
17 successful because it narrowed the issues to be resolved by the Board. Applicant's efforts should
18 not be deemed inadequate simply because it did not continue trying to negotiate with a party that
19 was unwilling to compromise on anything. As experienced lawyers, Opposer's counsel surely
20 understood that refusing to negotiate a single point of Applicant's letter would ultimately result
21 in the present motion. The motion was a predictable outcome of Opposer's intransigence and
22 should not be denied because Applicant did not take the extra step of begging Opposer to change
23 its mind.

1 **Sales and Promotional Information.** Opposer never disputes the relevance of the
2 requested information. It never demonstrated that producing it was **unduly** burdensome. Its
3 Memorandum argues, however, that what it has produced is sufficient to prove what it needs to
4 prove in order to win. (Opp. Mem. at 5:1-19). That is not the standard for determining relevance
5 in discovery. Stated somewhat differently, a party does not have a right to withhold discovery
6 unilaterally simply because it believes that the discovery it has produced is good enough for it to
7 win.

8 Opposer’s position puts Applicant in a box. The Board has consistently taken the
9 position that it will not preclude evidence at trial that was requested but not produced in
10 discovery unless a party brings a motion to compel, that motion is granted, and the non-moving
11 party never produces the information. *See Midwestern Pet Foods v. Societe des Produits de*
12 *Nestle*, 685 F. 3d 1046, 1051-52 (Fed. Cir. 2012). In order to prevent being sandbagged at trial if
13 Opposer decided to use the requested information, Applicant had to bring the instant motion.

14 **Specifying Documents/Unqualified Responses.** Opposer’s memorandum misses the
15 point of the motion. Multiple responses did not affirmatively state that the documents existed or
16 did not exist; rather, they stated that the documents would be produced “to the extent they exist.”
17 Opposer’s view that the burden is on Applicant to cull through the responses and **guess** whether:
18 (a) responsive documents were produced, and (b) for which requests, cannot be reconciled with
19 Federal Rule of Civil Procedure 34 (b)(2)(B) and the Board’s decisions. The days of trial by
20 ambush long ago gave way to requiring a party to disclose and to be clear in its disclosures.
21 Applicant should not be required to waste deposition time establishing the basic information
22 about a document production. Opposer should have provided it voluntarily.

1 **Witness Statements.** Opposer is represented by a large, global law firm and its attorneys
2 know exactly what Applicant meant by a “witness statement.” Their ignorance objection was
3 not made in good faith. But Applicant explained the obvious and Opposer responded by
4 asserting attorney work product immunity.

5 By definition, work product immunity applies only to the mental impressions of a lawyer.
6 By definition, a witness statement is the statement **of a witness**, not a lawyer. For example, if a
7 lawyer obtains a written statement from the witness to an accident, that is inherently factual and
8 is fully discoverable even though the lawyer may have had it typed for the witness.

9 In any event, this dispute illustrates why unqualified answers to discovery requests are
10 required. If Opposer had responded by saying that it had no witness statements then the motion
11 would be moot.

12 **Behmke Declaration.** The validity of the assignment and the continuing validity of the
13 registration are important issues in this case. Opposer thought it was so important that it filed an
14 eight paragraph Declaration from its former attorney.

15 Opposer’s claim that the client did not knowingly waive the privilege concerning the
16 subject matter the Declaration should not be rejected; the client’s lawyers filed the declaration
17 with the PTO and it is a matter of public record. Perhaps neither the lawyers nor the client were
18 consciously thinking about the waiver implications of the Declaration, but the public filing was a
19 waiver nonetheless because it was a public statement by a lawyer about what he did and why he
20 did it. There is no other way to construe it. Opposer should not be permitted to put the horse
21 back into the barn – especially since the Declaration has been a matter of public record for a year
22 and the PTO relied on it in allowing the entity change.

1 **PROOF OF SERVICE**

2 On January 29, 2016 I caused to be served the following document:

3 **APPLICANT’S REPLY MEMORANDUM ON ITS MOTION TO COMPEL**

4 on Opposer by placing a true copy thereof in the United States mail enclosed in an envelope,
5 postage prepaid, addressed as follows to their counsel of record at his present business address:

6 Jennifer Lee Taylor
7 Morrison & Forester LLP
8 425 Market Street
9 San Francisco, CA 94105-2482

10 Executed on January 29, 2016 at Half Moon Bay, California.

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