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

AMERICAN RICE INC.)
)
Petitioner,)
)
vs.)
)
DUNMORE PROPERTIES, S.A.)
)
Registrant.)



Cancellation No. 41,652

09-02-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #22



**REGISTRANT'S BRIEF IN OPPOSITION
TO PETITIONER'S MOTION TO COMPEL**

Registrant responds to Petitioner's Motion to compel. The Motion was brought without the required good faith consultation with Registrant's counsel. Moreover, the objections which are identified in the Motion were legitimately and validly interposed by Registrant. Registrant respectfully submits that the Motion should be denied.

Background

On July 17, 2003, undersigned counsel was advised that Mr. Michael S. McCoy, Petitioner's counsel, had called Registrant's named counsel on this matter, Mr. Simor Moskowitz, regarding this proceeding. As Mr. Moskowitz was out of the office, undersigned counsel returned the call on Mr. Moskowitz's behalf on July 17, and left a voice-mail message for Mr. McCoy.

Not having heard from Mr. McCoy by July 22, undersigned counsel called again and spoke with Mr. McCoy, who claimed in general terms that Registrant's discovery responses were inadequate. Undersigned counsel advised that he was not actively working on the case, did not prepare or assist in the preparation of the responses, and so was unfamiliar with said responses. Petitioner's counsel responded by stating that he wanted Registrant's counsel to go through the discovery responses and supplement where Registrant believed Petitioner might object to the

response(s). Undersigned counsel suggested that it might be more efficient and effective for Petitioner's counsel to reduce the alleged deficiencies to writing for Registrant's counsel consideration. Petitioner's counsel said he would consider this suggestion.

On August 5, 2003, without forewarning, Petitioner's counsel called undersigned counsel to discuss the matter further. Initially, Petitioner's counsel said he decided to not write a letter outlining the alleged deficiencies in Registrant's responses, but instead wanted to *generally*¹ go through the responses on the telephone. Undersigned counsel advised that that approach was acceptable (though not preferable). However, since undersigned counsel had a prior commitment at the time that Petitioner placed the unannounced call, and since the file would have to be obtained and reviewed prior to the proposed telephone discussion (it was anticipated that Petitioner's counsel would send a letter listing the alleged discovery deficiencies), undersigned counsel suggested the telephone conference occur later.

In response, Petitioner's counsel changed course and advised that he was not inclined to go through the allegedly defective responses² since "all" of the responses were inadequate. Petitioner's counsel then advised that if Registrant did not review and supplement the responses on its own – without any indication from Petitioner which responses were allegedly inadequate or why – Petitioner would file a Motion to compel. Petitioner's counsel's position (if not expressly stated) was to "let the Board sort it out". Undersigned counsel objected to this approach and advised that, from Registrant's perspective, Petitioner had not engaged in the good faith efforts – had not even

¹ One can only assume that the level of specificity Petitioner had in mind was no greater than that found in the Motion to compel.

² Indeed, this position is borne out in Petitioner's Motion where Petitioner has still not gone through each allegedly defective response, but only discussed five (5) out of 35 responses.

identified the allegedly defective responses or their perceived deficiencies – which are a necessary precondition to the filing of any Motion to compel. At no time, during this conversation or the earlier conversation had Petitioner identified which responses it thought were deficient, or why he thought so.

Moreover, undersigned counsel does not recall Petitioner's counsel raising the document production issue, beyond the issue of protection of confidential information and documents. In this latter regard, undersigned counsel recalls advising Petitioner's counsel of the existence of the Board's standard Protective Order and its posting on the Board's website.

Registrant's counsel memorialized the August 5 conversation in a letter of the same date to Petitioner's counsel. *See* Cuccias letter to McCoy, attached hereto as Exhibit A. Despite Petitioner's threat to file a Motion to compel unless Registrant *sua sponte* supplemented its responses (without any input from Petitioner as to which responses should be supplemented and why), Registrant's letter invited consultation – whether by phone or letter. *See* Exhibit A. Specifically, Registrant's counsel stated:

As your approach seems less efficient and requires Registrant to anticipate all of Petitioner's concerns with the responses, I again repeat our earlier invitation to advise us, preferably – but not necessarily – in writing, which responses you believe are insufficient and the basis for such assertion. If you are not inclined to memorialize your comments regarding Registrant's discovery responses in writing, *I am available for a telephonic conference.*

Id. (Emphasis supplied). Petitioner's counsel chose not to respond to this letter or accept Registrant's invitation for a meet and confer conference – either in writing or by phone. Indeed, from August 5 to August 13, Petitioner took no action whatever.

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On August 13, 2003 – nearly two (2) months prior to the close of discovery³ – Petitioner filed a Motion to compel. The Motion incorrectly states: “The parties conferred on the subject matter of this motion but did not reach agreement.” *See* Motion to compel, p. 5. Petitioner’s service copy of the Motion was sent under Petitioner’s cover letter of the same date, which is attached hereto as Exhibit B.

Discussion

Applicant’s Motion to compel should be denied due to Applicant’s total failure to engage in a good faith attempt(s) to resolve the asserted discovery disputes. Additionally, the alleged defects in Registrant’s discovery responses – which were set forth *for the first time* in Petitioner’s Motion – are not defects at all. Moreover, while Petitioner’s Motion only specifically addressed a handful of responses, it seeks to strip objections from all thirty-five (35) responses to document requests based on a disingenuous “sampling” of five (5) responses. Not only are Registrant’s objections properly interposed for these latter responses, it is inappropriate to try to address objections on a sweeping basis in light of their fact-specific nature.

Finally, there were no exigent circumstances which justified Petitioner’s decision to eschew Registrant’s invitations at dialogue and to file the Motion to compel. Indeed, the parties had recently agreed to file a sixty (60) day consented extension of time of all outstanding dates such that the discovery period was scheduled to close in mid-October.

³ By Order dated July 25, 2003, the discovery is set to close on October 13, 2003.

1. Applicant Failed to Engage in Good Faith Efforts Before Filing Motion to Compel

The Rules impose upon a movant who would file a Motion to compel a special requirement to engage in a good faith effort to resolve discovery dispute(s) with the opposing party. Specifically, the Rules require that:

The motion must be supported by a written statement from the moving party that such party or the attorney therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion and has been unable to reach agreement.

See C.F.R. §2.120(e)(1). Since Applicant has not satisfied this special requirement, its Motion to compel should be denied.

Registrant's position regarding Petitioner's vague, generalized and ill-defined "concerns" about Registrant's discovery responses has been to request, repeatedly, that Petitioner identify the allegedly defective response(s) and advise as to the perceived defects. Petitioner's position is that since "all of [Registrant's] responses are inadequate. Every single one," Registrant has the obligation to review the responses on its own and to supplement those to which Registrant *believes* Petitioner *may* object. Not only is Petitioner's approach contrary to the Rules and common sense, it's fallacy is actually borne out by Petitioner's own Motion. Despite advising in two different conversations with Registrant's counsel (and confirmed in its August 13 letter) that "all of [Registrant's] responses are inadequate. Every single one," Petitioner's Motion to compel does not raise a *single* concern as to any of Registrant's answers to Petitioner's *interrogatories*. Thus, Petitioner's oft-stated position is incorrect, at least as to half of the discovery responses (*i.e.*, answers to interrogatories).

In any event, Registrant respectfully submits that the activities described above do not constitute the good faith efforts required by counsel prior to the filing of a Motion to compel. As such, the Motion should be denied.

2. Registrant’s Objections Are Valid and Should Not Be Overruled

Petitioner seems to take the view that a document request is either wholly objectionable or wholly unobjectionable. However, many document requests are written in overly broad language (*i.e.*, requesting “all documents” as does Petitioner’s requests) with the expectation that the other side will object and then produce or make available documents subject to such objections. That is the case here. While Registrant could legitimately withhold documents in response to various requests, it simply chose to interpose reasonable objections to protect its legitimate interests and then, at Petitioner’s initiative, address the document production issues.

If Registrant’s objections are overruled, as requested by Petitioner, Registrant would be subjected to the undue prejudice of having to produce or make available documents responsive to requests which are fundamentally objectionable (*e.g.*, produce all documents that refer/relate to Registrant’s use of its federally registered mark; “Produce all documents related to marketing rice in Saudi Arabia”).

A. Petitioner’s Requests Are Objectionable As Being Vague and Indefinite

Not only has Petitioner not bothered to engage in good faith consultation with Registrant regarding its discovery concerns *prior* to filing its Motion to compel, it has not even elaborated on them for the Board to consider in connection with its Motion to compel. Petitioner engages in a disingenuous practice of choosing two responses – ostensibly the most egregious from Petitioner’s point of view – and claiming that such are “representative” of twenty or thirty different responses.

This is a flawed approach since each Request, and its response, are fact-specific and must be evaluated individually. Petitioner's counter-intuitive approach is borne out by the very first two responses⁴ to which Petitioner would seek to apply its broad brush:

Request No. 4 asks for production of "all communications between Defendant and Shanshal." Request No. 5 seeks the same documents relative to "Alesayi." These requests were objected to on grounds that they were vague and indefinite in that they "fail[ed] to adequately identify one of the parties." The "Definitions and Instructions" section of Petitioner's document requests do not identify or refer to "Shanshal" or "Alesayi." Additionally, the requests were objected to on the same grounds in that they were unlimited in time and scope.

As to Request Nos. 14 & 15, they both involve a definition ("Identified Trademarks") to which Registrant objected both in the specific responses and in the preliminary objections. Registrant's use *vel non* of marks other than its registered mark which is the subject of this proceeding is beyond legitimate inquiry⁵. Additionally, the Requests are objectionable because they are not limited in time or place. Furthermore, the Requests – like many of the Requests – seek "all documents." This is particularly problematic as to Request No. 14 which seeks production of "all documents that relate or refer to Defendant's use of any of the Identified Trademarks" Even if this request were limited to the registered mark which is the subject of this cancellation proceeding, demanding "all documents" relating to its use is patently objectionable.

⁴ Registrant will not go through and justify each and every objection to all of Petitioner's defective requests since Petitioner failed to specifically address same.

⁵ In any event, Petitioner has not carried its burden of demonstrating its legitimacy.

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B. Petitioner's Requests Are Objectionable As Being Unlimited in Time and Scope

Petitioner claims that Request Nos. 14 and 28 are limited in time and scope since they request information about Registrant's first use of its registered mark, and sales since such first use. Petitioner argues that these requests contain a "specific or practical limitation in time and scope" since Petitioner notes that Registrant filed a Statement of Use in 2000. However, the Requests seek information related to the use of two other marks which are not the subject of a Statement of Use. Petitioner cannot have it both ways – seeking information beyond the proper scope of this proceeding, on the one hand, and then defending the scope of the requests by claiming a "specific or practical limitation in time and scope" by pointing to only one portion of the Request. Additionally, these Requests are not limited to the United States.

Moreover, Petitioner's Request No. 28 seeks: "all documents setting forth or showing the dollar and unit volume of sales, since inception of products bearing any of the Identified Trademarks." Under a strict reading, every sales receipt, every invoice, every daily summary, *etc.* would fall within the ambit of this request. Such an unlimited breadth is clearly not contemplated by nor authorized under the Trademark Rules. Thus, Registrant interposed objections and intends to produce or make available documents which summarize sales of products under its registered mark in the United States, pursuant to the entry of a Standard Protective Order.

Petitioner again adopts the transparent tactic of holding up two Requests (it ostensibly believes to be the most egregious) as "representative", and then summarily and broadly painting the remaining 23 Requests with the same brush. This treatment is reduced to one sentence – "Similarly, Dunmore's unlimited in time and scope objections to Requests . . . are also without merit in that each request contains either a specific or practical limitation in time and scope." *See* Motion to compel,

p. 3. Again, the absurdity of this approach is evident by its application, for example, to the first several requests:

Request 4: Produce all communications between Defendant and Shanshal.

Request 5: Produce all communications between Defendant and Alesayi

Request 6: Produce all communications between Defendant and Producers Rice Mill, Inc.

Request 7: Produce all documents reflecting⁶ either or both the ABU BINT and ABU BINT (in Arabic) trademarks.

In reviewing these requests, one struggles to uncover the “specific or practical limitations in time and scope.” Others are just as overly broad. *See* Request Nos. 9 (“Produce all documents that reference Producers Rice Mills, Inc.”); 11 (“Produce all documents related to marketing rice in Saudi Arabia”). Moreover, it appears that Petitioner seeks documents and information related to activity outside the United States. Such an improperly broad scope further complicates the responses.

C. Petitioner’s Requests Are Irrelevant

About half of Petitioner’s document requests involve “Identified Trademarks.” To the extent that these “Identified Trademarks” include trademarks which are not the registration sought to be cancelled, they are irrelevant to this proceeding. Indeed, the irrelevancy of the subject Requests is shown in Petitioner’s “sweeping statement” – “each request is calculated to provide relevant information on Dunmore’s use and decision to register the BINT ALARAB *and similar trademarks.*” *See* Motion to compel, p. 4 (emphasis supplied). However, Registrant’s use and decision to register “similar trademarks” – meaning, not the trademark sought to be cancelled – is simply not relevant

⁶It is somewhat unclear how a document “reflects” a trademark.

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to this proceeding. At a minimum, Petitioner has not shown or even alleged such in its discovery Motion.

Similarly, “Request 23 seeks rice packaging featuring a single woman.” To the extent that this seeks information or documents beyond Registrant’s use of the registered mark, it is simply not relevant. In this *inter partes* proceeding, which is statutorily limited to the registrability of Registrant’s registered mark, the relevant inquiry concerning a likelihood of confusion is between Petitioner’s pleaded mark(s) and Registrant’s registered mark – not “rice packaging featuring a single woman.”

D. Petitioner’s Requests Call for Confidential Documents

As noted above, in a conversation with Mr. McCoy, undersigned counsel noted the existence of the Protective Order and its location on the Board’s website. Registrant respectfully requests the Board to impose its standard Protective Order on the parties to this proceeding.

E. Registrant Did Not Waive Objections to Any Request

Petitioner asserts that Dunmore has waived objections to Request Nos. 1, 3 and 24. *See* Motion to compel, p. 4. This is wrong. Registrant’s responses interposed a number of objections to Petitioner’s Requests for Production of Documents, as well as the definitions and instructions. *See* Exhibit 2 to Petitioner’s Motion to compel, pp. 2-3. Registrant then “incorporate[d] each of the foregoing Objections into each of the Answers set forth below.” *Id.*, p. 3.

F. Registrant's Documents

Petitioner complains that "Dunmore has not produced or made available a single document." See Motion to compel, p.1. As Petitioner may or may not know, the Trademark Rules do not require the recipient of document requests to produce documents to the propounding party at the situs of its counsel or by mail. Rather, responsive documents need only be made available at a place where the documents are usually kept. Specifically, the Rule states:

The production of documents and things under the provision of Rule 34 of the Federal Rules of Civil Procedure will be made at the place where the documents and things are usually kept, or where the parties agree, or where and in the manner which the Trademark Trial and Appeal Board, upon motion, orders.

See 37 C.F.R. § 2.120(d)(2). As the Board has recently stated: "[w]e will not sanction defendant for failing to forward copies of documents to plaintiff. A party is not *required* to copy responsive documents and forward them to its adversary in response to document requests. Parties often do this as a reciprocal courtesy, but it is sufficient for a responding party to make documents available, at the place they are normally kept, for inspection and copying by the inquiring party." *Electronic Industries Assoc. v. Potega*, 50 U.S.P.Q.2d 1775, 1777 (TTAB 1999) (emphasis in original). Petitioner has not inquired as to any arrangements to review the documents. In this regard, Registrant notes that it is located in Panama. Registrant would consider offering to exchange documents by mail, but this is precisely the type of issue – like all of the above issues – which should

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be addressed, at least in the first instance, by and between the parties.

Respectfully submitted,

DUNMORE PROPERTIES, S.A.

By: 

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Matthew J. Cuccias
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(202) 638-6666
Attorneys for Registrant

September 2, 2003
Atty. Dkt. 11495/I-4869

CERTIFICATE OF SERVICE

I hereby certify that on this 2nd day of September, 2003, a copy of the foregoing REGISTRANT'S BRIEF IN OPPOSITION TO PETITIONER'S MOTION TO COMPEL, in connection with Cancellation No. 41,652 – American Rice Inc. vs. Dunmore Properties, S.A., was served, via U.S. first class mail, postage prepaid, to the following:

Michael S. McCoy, Esquire
Fulbright & Jaworski, L.L.P.
1301 McKinney, Suite 5100
Houston, Texas 77010-3095



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Bright & J...
1301 McKinney,
Houston, Texas 770...

Our Ref...

Mr. McCoy:

This will refer to our telephone conversations of July...
above-referenced matter.

Re: Can...
America...
Registratio...
Mark: BINI
Our Reference

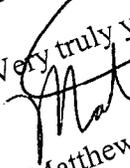
Dear Mr. McCoy:

This will refer to our telephone c...
above-referenced matter.

We spoke on July 22, 2003 regardi...
Registrant's responses to Petitioner's written d...
responses but suggested that we revisit the respon...
I requested that you advise us, preferably in writing, which responses yo...

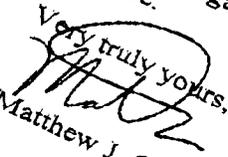
You called today and advised that you were not inclined to go t...
responses and advise us which responses you believed to be insuff...
Registrant to go through and supplement any response we believe...

As your approach seems less efficient and requires Registrant to...
concerns with the responses, I again repeat our earlier invitatio...
necessarily - in writing, which responses you believe are insuff...
If you are not inclined to memorialize your comments regard...
in writing, I am available for a telephonic conference.

Very truly yours,

Matthew

We spoke on July 22, 2003 regardi...
Registrant's responses to Petitioner's written d...
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le for a telephonic conference.

Harvey B. Jaco

Very truly yours,

Matthew J. Cuccias

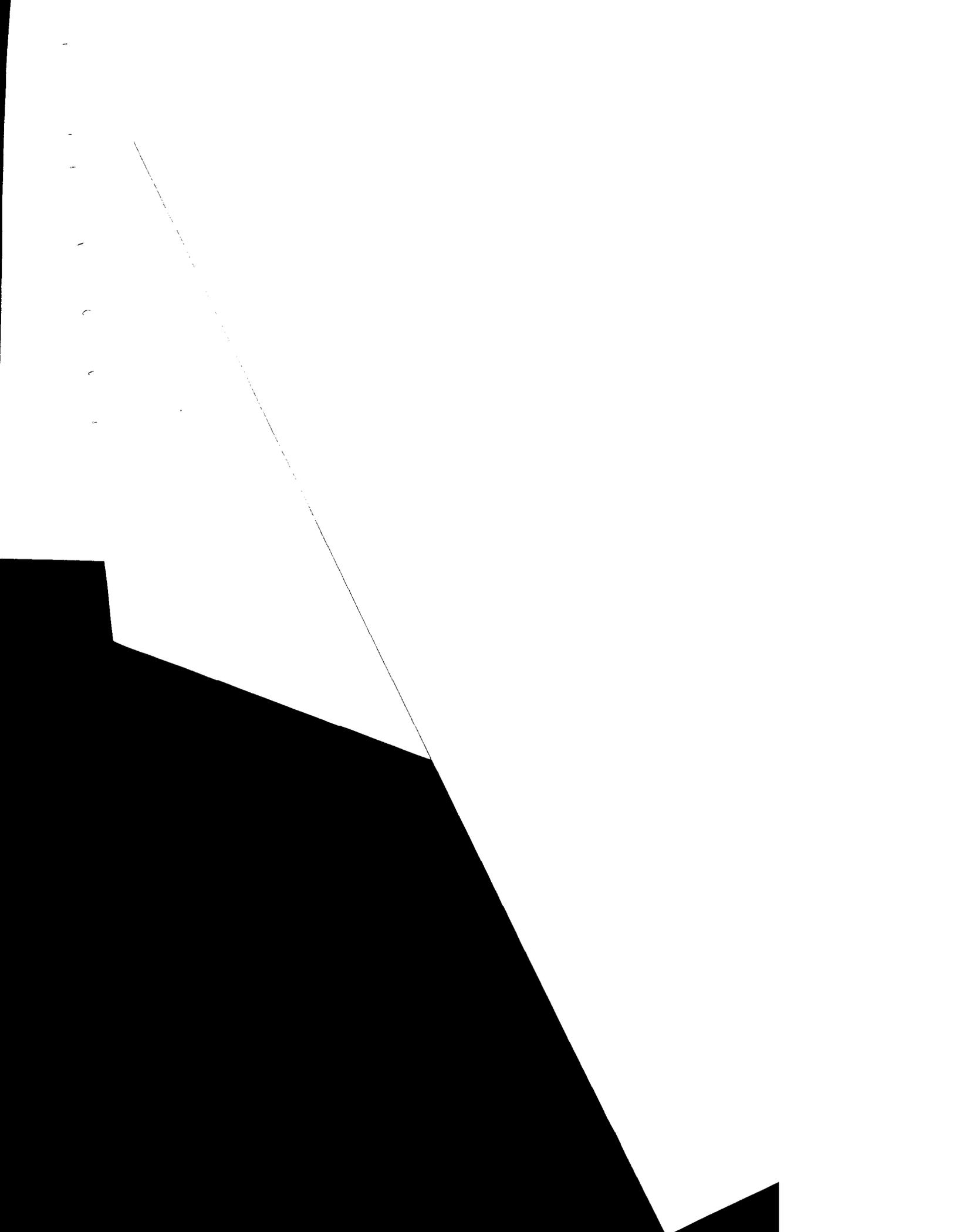
Harvey B. Jacobson, Jr. John Clarke Holman Simor L. Moskowitz Allen
Linda J. Shapiro Irwin M. Aisenberg George W. Lewis Will
Leesa N. Weiss Suzin C. Bailey* M
Of Counsel: Marvin R. St

Ben S. Meiser Michael R. Slobasky Marsha G. Gentner Jonathan L. Scherer
Sam E. Player Yoon S. Harn Phillip L. O'Neill
Matthew J. Cuccias Daniel K. Dorsey Suzannah K. Sundby
Nathanial A. Humphries

* bar other than D.C.

NAME: JACOBSON HOLMAN PLLC
TEL: 202 393 5350
DATE: 08/05/03 20:00
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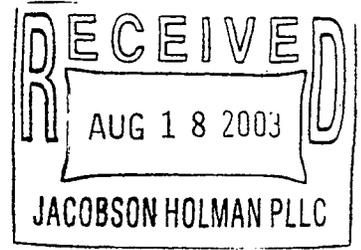
TRANSMIT MESSAGE CONFIRMA



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August 13, 2003

Mr. Matthew J. Cuccias
Law Offices
Jacobson Holman
Professional Limited Liability Company
400 Seventh Street, N.W.
Washington, D.C. 20004-22158

Re: Cancellation No.: 41,652
Mark: AMERICAN RICE, INC. v. DUNMORE PROPERTIES
Our Reference: HO-C92041652/08156617

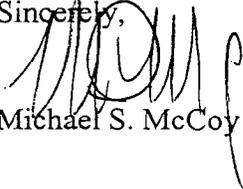
Dear Mr. Cuccias:

I am in receipt of your August 5, 2003, letter regarding discovery in the above-referenced matter. I understand your position is that you need me to explain why your discovery responses are inadequate. I also understand your position is that it is more efficient if I summarize for you the reasons why your responses are inadequate.

As I noted in our conversations, all of your responses are inadequate. Every single one. Both times we spoke on the adequacy of your responses you informed me that you were not familiar with your answers because you had not had an opportunity to look at them. Further, I offered during our last conversation to go through the problems with each response. You declined.

Please see the attached motion we recently filed with the Trademark Trial and Appeal Board regarding the adequacy of your responses. If after the reviewing the motion you have an opportunity to review your responses and wish to talk about them, please give me a call.

Sincerely,


Michael S. McCoy

MSM/taj
Enclosure

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