

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

AMERICAN RICE, INC.,

Plaintiff,

v.

DUNMORE PROPERTIES S.A.,

Defendant.

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Cancellation No. 92/041652

Reg. No.: 2,532,912



09-23-2003

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

**REPLY TO DEFENDANTS RESPONSE TO PLAINTIFFS MOTION TO COMPEL
DISCOVERY FROM DEFENDANT DUNMORE PROPERTIES S.A.**

It is Dunmore's burden to demonstrate the validity of its objections. See *Shannon v. N.Y. City Transit Auth.*, 2001 U.S. Dist. LEXIS 3162 (S.D.N.Y. 2001) ("The burden is on the party resisting discovery to explain its objections and to provide support therefore.") (citations omitted). Dunmore has not explained its objections or provided support therefore. Instead, Dunmore has responded with the same general responses included in its discovery responses.

1. Background

ARI's disagrees with Dunmore's characterization of the facts. The facts are simply that ARI served Dunmore with a request for production on March 17, 2003. Dunmore twice requested and twice received extensions of time to respond to the request for production. ARI did not oppose either extension. After two extensions, Dunmore served on June 6, 2003, the response attached as Exhibit A to ARI's motion to compel.

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2. ARI Made A Good Faith Effort To Resolve The Discovery Dispute Before Filing Its Motion.

ARI made a good faith effort to resolve the discovery dispute prior to filing its motion to compel. As noted in Exhibit B to Dunmore's response, Dunmore was contacted prior to filing ARI's motion to compel. Counsel for Dunmore was either unavailable or unable to discuss the sufficiency of Dunmore's responses. As is also noted in Exhibit B to Dunmore's response, ARI was and remains available to discuss the validity of Dunmore's objections.

Dunmore's position seems to be that a good faith effort would have required ARI to summarize all the problems with Dunmore's responses - which was a failure to respond to every request - and then explain to Dunmore why the responses are improper. Neither the TTAB rules nor the Federal Rules of Civil Procedure contemplate conducting discovery in such a manner. ARI properly served its request for production, agreed to two extensions of time, and attempted to confer with Dunmore.

3. Dunmore's Objections Should Be Overruled

Dunmore's numerous unfounded objections amount to a complete failure to respond. Fed. R. Civ. P. 37(a)(3). There is nothing in the Federal Rules of Civil Procedure that contemplates or justifies failing to respond to discovery because some documents ostensibly could have been legitimately withheld. Dunmore's Response at 6. Dunmore is merely attempting to use its failure to cooperate in discovery as a tool to negotiate down to a sub-set of the requested material.

Additionally, as noted above, it is Dunmore's burden to explain and provide support for its objections. Dunmore has not carried the burden of its objections. Instead, Dunmore repeats or rewords the same general objection included in its original responses.

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A. Dunmore's Vague and Indefinite Objections Should Be Overruled

Requests 4 and 5 seek communications between Defendant and Shanshal and Alesayi. Dunmore complains that these requests are vague because they are not supported by Definitions and Instructions. ARI is not aware of any rule that requires it to include the identities of third parties in the Definitions and Instructions. All that is required is that ARI identify documents with reasonable particularity. Requests 4 and 5 do that. Both names are English translations of Arabic names. Although translations from Arabic to English are never exact, ARI believes the translations are sufficient to identify with reasonable particularity the requested documents. Dunmore is very familiar with both Shanshal and Alesayi, and it does not dare assert to the contrary.

B. Dunmore's Time and Scope Objections Should Be Overruled

Dunmore rhetorically asks about the practical limitations in time and scope in Requests 4, 5, 6, and 7. ARI believes Dunmore was recently established for the sole purpose of owning the BINT ALARAB registration. As noted in ARI's Petition For Cancellation, ARI has already proved once that the BINT AL-ARAB mark is confusingly similar to ARI's ABU BINT marks (*See American Rice, Inc. v. Arkansas Rice Growers Coop. Ass'n*, 532 F. Supp. 1376, 214 U.S.P.Q. (BNA) 936 (S.D. Tex. 1982), affirmed, *American Rice, Inc. v. Arkansas Rice Growers Coop. Ass'n*, 701 F.2d 408, 218 U.S.P.Q. (BNA) 489 (5th Cir. 1983)). ARI believes that Dunmore was established in furtherance of a second attempt by the same or related individuals to capitalize on the goodwill associated with ARI's marks. As such, the requests are practically limited by the length of time Dunmore has been in business, which is likely in the neighborhood of five years.

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Dunmore also notes that it appears that ARI improperly seeks documents and information related to activity outside the United States. Dunmore's Response at 9. As noted in Dunmore's Statement of Use, filed on May 21, 2001, in relation to Dunmore's BINT ALARAB registration

The mark was first used anywhere in connection with RICE in International Class 30 on September 14, 2000; was first used in commerce between the United States and the *Kingdom of Saudi Arabia* on September 14, 2000; and the mark is now used in such commerce.

Statement of Use filed May 5, 2001. Thus, Dunmore relied on sales to Saudi Arabia to file its Statement of Use. Requests that seek documents evidencing sales between the U.S. and Saudi Arabia are both reasonable and justified.

4 Dunmore's Irrelevance Objections Should Be Overruled

Dunmore's arguments related to relevance are, at best, strange. A cursory review of ARI's request show that they are reasonably calculated to lead to admissible evidence. See Fed. Rule Civ. P. 26(a)(1). Arguments to the contrary merely highlight Dunmore's complete failure to respond to ARI's discovery.

5. Conclusion

For the forgoing reasons and those in ARI motion to compel, Dunmore's objections to discovery should be overruled and Dunmore should be ordered to produce all responsive documents within 10 business days.

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CERTIFICATE OF SERVICE

This hereby certifies that the foregoing instrument was served by Certified Mail to the following on 23th day of September, 2003.

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September 23, 2003



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

Trademark Trial and Appeal Board
Commissioner for Trademarks
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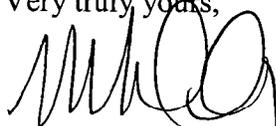
Re: Cancellation No. 92/041,652
Mark: AMERICAN RICE, INC. v. DUNMORE PROPERTIES
Our Reference: HO-C92041652/08156617

Dear Madam:

Attached hereto for filing are the following:

1. Plaintiff's American Rice, Inc.'s Reply to Defendants Response to Plaintiffs Motion to Compel Discovery From Defendant Dunmore Properties S.A.; and:
2. Return Post Card.

The Commissioner is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 06-2375, under Order No. HO-C92041652.

Very truly yours,

Michael S. McCoy

MSM/taj