

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

In the Matter of)	
Trademark Registration No. 2,772,766)	
For the Mark SAN DIMAS GUITARS THE)	
CALIFORNIA GUITAR COMPANY (Design))	
Registration Date: October 7, 2003)	
)	
JACKSON/CHARVEL MANUFACTURING,)	Cancellation No. 92042614
INC.,)	
Petitioner,)	
)	
v.)	
)	
PRINS, LLOYD A.,)	
Registrant-Respondent.)	

**PETITIONER'S MOTION TO SUPPLEMENT ITS MOTION TO COMPEL
AND RE-SET TRIAL DATES**

Petitioner Jackson/Charvel Manufacturing, Inc. ("Jackson/Charvel"), by its undersigned attorneys, hereby moves the Trademark Trial and Appeal Board (the "Board") (i) to supplement its Motion to Compel with the attached exhibit; (ii) to grant Jackson/Charvel's Motion to Compel in its entirety; and (iii) to re-set trial dates, such that Jackson/Charvel's first testimony period begins 30 days after the Board's ruling on Jackson/Charvel's Motion to Compel. In support of this Motion, Jackson/Charvel states as follows:

1. On December 31, 2004, Jackson/Charvel filed a Motion to Compel based on Respondent Lloyd A. Prins ("Prins") failure to answer discovery requests, produce documents, and properly answer requests for admission.
2. As part of its Motion to Compel, Jackson/Charvel certified that its counsel conferred with Prins via both correspondence and telephone in a good faith effort to resolve the discovery dispute; however, the parties were unable to reach agreement on resolving the discovery dispute prior to the start of the first testimony period. Since Jackson/Charvel filed its Motion to Compel, Prins sent additional correspondence to Jackson/Charvel's counsel expressly

stating that he would not promptly respond to Jackson/Charvel's Rule 37 letter. (*See* Letter from Lloyd A. Prins, San Dimas Guitar Company, to Salvador K. Karottki, Goldberg Kohn (Jan. 6, 2005), attached hereto as Exhibit 1.) Prins stated that his "schedule simply does not allow" him to respond and that he needed until "early February" in order to craft a response. (*Id.*) Therefore, Prins refused to respond to Jackson/Charvel until *after* Jackson/Charvel's first testimony period, based on the Board's then-current trial schedule. This means Jackson/Charvel would have been required to put on its case in chief without answers to numerous discovery requests from Prins and with only four pages of documents produced by Prins. The Board has since suspended proceedings on January 14, 2005.

3. As further evidence of Jackson/Charvel's good faith effort to resolve this dispute and Prins' failure to respond, Jackson/Charvel requests that the Board take into consideration Prins' letter, attached hereto as Exhibit 1, in connection with its Motion to Compel.

4. Jackson/Charvel served its Motion to Compel on December 31, 2004. Prins had 20 days in which to file a response brief to the Motion to Compel. Prins has not filed a response brief. "When a party fails to file a brief in response to a motion, the Board may treat the motion as conceded" 37 C.F.R. § 2.127(a); *see also* Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 502.04, at 500-14 to 15 (2d ed., 1st rev. 2004); *Boston Chicken Inc. v. Boston Pizza International Inc.*, 53 U.S.P.Q.2d 1053, 1054 (T.T.A.B. 1999) (granting summary judgment motion on respondent's counterclaims as conceded when respondent failed to file a response brief, and dismissing respondent's counterclaims with prejudice). Accordingly, the Board should grant Jackson/Charvel's Motion to Compel in its entirety, (i) compelling Prins to fully and completely answer Jackson/Charvel's Interrogatory Nos. 1, 2, 10-15, 19, 21, 23, 28, 30, and 31; (ii) striking Prins' Affirmative Defenses; (iii) compelling Prins to produce documents responsive to Jackson/Charvel's Requests for Production

Nos. 21-22, 37, and 38; and (iv) deeming admitted Jackson/Charvel's Admission Requests Nos. 11, 16, 21, 22, and 38.

5. As noted above, on January 14, 2005, the Board suspended proceedings pending disposition of the parties' discovery motions. After the Board rules on the discovery motions, Jackson/Charvel requests that it re-set trial dates, starting Jackson/Charvel's first testimony period 30 days after the Board's ruling on Jackson/Charvel's Motion to Compel.

WHEREFORE, Jackson/Charvel respectfully requests that the Board grant its Motion in its entirety and:

- (1) supplement Jackson/Charvel's Motion to Compel with Exhibit 1 hereto;
- (2) grant Jackson/Charvel's Motion to Compel as conceded, (i) compelling Prins to fully and completely answer Jackson/Charvel's Interrogatory Nos. 1, 2, 10-15, 19, 21, 23, 28, 30, and 31; (ii) striking Prins' Affirmative Defenses; (iii) compelling Prins to produce documents responsive to Jackson/Charvel's Requests for Production Nos. 21-22, 37, and 38; and (iv) deeming admitted Jackson/Charvel's Admission Requests Nos. 11, 16, 21, 22, and 38; and
- (3) re-set trial dates in this proceeding, starting Jackson/Charvel's first testimony period 30 days after the Board's ruling on Jackson/Charvel's Motion to Compel.

DATED: January 21, 2005

Respectfully Submitted,

JACKSON/CHARVEL MANUFACTURING,
INC.

By 
One of Its Attorneys

Oscar L. Alcantara
Salvador K. Karottki
GOLDBERG, KOHN, BELL, BLACK,
ROSENBLUM & MORITZ, LTD.
55 East Monroe Street, Suite 3700
Chicago, Illinois 60603
(312) 201-4000

EXHIBIT 1

Lloyd A. Prins
San Dimas Guitar Company
2323 Via Saldivar
Glendale, CA 91208

January 6, 2005

Mr. Salvador K. Karottki
Goldberg, Kohn
55 East Monroe Street, Suite 3700
Chicago, IL 60603

Re: Cancellation No. 92042614

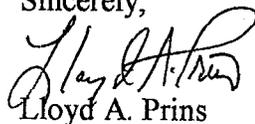
Dear Mr. Karottki,

This letter confirms my receipt of your December 29, 2004 Rule 37 letter. In it you ask that I respond to you immediately with additional information to your discovery requests. I am happy to reply, however the timing of your request coincides with my absolute busiest time of year as I work to prepare for the Winter NAMM Show scheduled for January 20-24, 2004.

I appreciate you taking the time to delineate the concerns you have with my responses to your first discovery requests. Your careful work warrants an equally careful and deliberate reply. Unfortunately my schedule simply does not allow me to do so. Considering this, if it is acceptable to you, please allow me until early February to craft my response.

Thank you for your time and consideration.

Sincerely,



Lloyd A. Prins
San Dimas Guitar Company

CERTIFICATE OF SERVICE

The undersigned, an attorney, certifies that on January 21, 2005, he caused a copy of Petitioner's **Motion to Supplement Its Motion to Compel and Re-Set Trial Dates** to be served by U.S. Express Mail delivery upon the following:

Lloyd A. Prins
San Dimas Guitar Company
2323 Via Saldivar
Glendale, CA 91208



Salvador K. Karotki

TTAB

GOLDBERG KOHN

GOLDBERG KOHN BELL BLACK ROSENBLUM & MORITZ, LTD

January 21, 2005

sal.karottki@goldbergkohn.com
direct phone: 312.201.3861
direct fax: 312.863.7861

VIA EXPRESS MAIL NO. EL873830062US

BOX TTAB/NO FEE
UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

**Re: JACKSON/CHARVEL MANUFACTURING, INC. v. PRINS, LLOYD A. -
CANCELLATION NO. 92042614**

Dear Sir or Madam:

Please find enclosed Petitioner's Motion to Supplement Its Motion to Compel and Re-Set Trial Dates in connection with the above-referenced matter (Cancellation No. 92042614).

Please contact me if you have any questions or comments in this regard.

Very truly yours,



Salvador K. Karottki

SKK.ck

Enclosure

cc: Lloyd A. Prins
Oscar L. Alcantara



01-24-2005
U.S. Patent & TMO/c/TM Mail Rcpt Dt. #64