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

Proceeding	92044624
Party	Plaintiff J. Christopher Carnovale
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

J. CHRISTOPHER CARNOVALE :
Petitioner :
v. : Canc. No. 92044624
THE BRAND EXPERIENCE LLC :
Registrant :

**REPLY MEMORANDUM IN SUPPORT OF PETITIONER'S
MOTION TO COMPEL DISCOVERY OR FOR SANCTIONS**

I. INTRODUCTION

It is clear from the opposition brief submitted by Registrant The Brand Experience LLC (“Registrant”) that Registrant does not intend to comply with the rules governing proceedings before this Board. While purporting to provide some of the information it has heretofore withheld (without justification) and to amplify a few of its deficient discovery objections and responses, Registrant has in fact only magnified its overwhelming noncompliance. By contrast, Petitioner J. Christopher Carnovale (“Petitioner”) complied timely and fully with the discovery requests that Registrant served on him and is suffering prejudice as a result of Registrant’s stonewalling. Petitioner’s motion should be granted so that these already protracted proceedings can proceed to a decision on the merits.

Petitioner initiated this proceeding on June 14, 2005 seeking cancellation (on grounds of abandonment and under Section 2(d) of the Trademark Act) of Registrant’s registrations for the marks THE 50+ SUNSCREEN THAT WON’T RUB OFF (Reg. No. 2,384,600); THE SUNSCREEN THAT WON’T RUB OFF (Reg. No. 2,477,694); and SUNSCREEN KIDS

WANT TO WEAR (Reg. No. 2,593,603). Registrant failed to respond to the petition to cancel and the Board granted default judgment against it.

After persuading the Board to vacate the default judgment by claiming that it had not received the petition to cancel, Petitioner has elected not to comply with obligations imposed by the applicable discovery rules. The discovery requests at issue were served on April 18, 2008, and Registrant's responses were due by May 23, 2008. Registrant served interrogatory responses that were replete with unwarranted objections and has never served written objections or responses to Petitioner's requests for production. Notwithstanding its claim that the marks shown in the registrations at issue "have been in 'high profile, continuous use since prior to 2000, Registrant has produced a mere 25 pages of largely unresponsive documents thus far and has ignored several communications from Petitioner's counsel seeking further information and documents.

Petitioner was thus forced to move for an order compelling discovery. In response, Registrant has submitted a pleading entitled "The Brand Experience, LLC's Opposition to Petitioner's Motion to Compel." However, this "opposition" contains no facts that explain or excuse Registrant's discovery noncompliance, nor any meaningful argument as to why Petitioner's requests are objectionable. Instead, it simply recites the requests and then either restates its unfounded, boilerplate objections and inadequate responses (in the case of the interrogatories) – in some instances purporting to provide additional information – or (in the case of the requests for production) responds *for the first time* with similar objections and statements about whether and to what extent it has responsive documents.

Far from rehabilitating its prior noncompliance, Registrant has only demonstrated its unwillingness to provide discoverable information. Moreover, it alleges that it need not disclose

information or produce documents claimed to be “trade secrets” unless and until the parties enter into a confidentiality agreement or protective order in addition to the one currently (and automatically) in place here under the governing rules. Registrant further claims to be “still looking for” responsive documents in some cases, but any such documents (and all of the other discovery responses) are now late by almost four months.

The Board should not permit further delay and should either impose appropriate sanctions precluding Registrant from denying that its marks are not abandoned or it should compel Registrant to produce all responsive documents *without any further delay*.

II. ARGUMENT

A. Registrant’s Opposition Brief is Not the Appropriate Place to Respond to Discovery Requests

Registrant’s 28-page “opposition brief” is in fact little more than a belated attempt to comply with discovery obligations that it has shirked for months. Indeed, the “brief” begins not with a summary of Registrant’s factual or legal arguments about why its noncompliance is justified or excused, but rather with a boilerplate “Reservation of Rights” and “General Objections,” such as those typically found in discovery responses.

An opposition brief is not a proper place to make discovery responses, and Registrant’s responses here do not comply with the applicable rules. For example, Fed. R. Civ. P. 33(b)(3) requires that the responses be made “under oath,” and Registrant’s brief does not satisfy that requirement. Equally improper is Registrant’s use of its opposition brief as a means for asserting untimely objections and evasive responses to Petitioner’s requests for production. No additional documents were provided with the response and this in itself provides justification for entry of sanctions precluding Respondent from relying on any such documents in this proceeding.

B. Registrant's Refusal to Disclose Information and Documents Until a Confidentiality Agreement is in Place is Meritless: The Board's Standard Protective Order is in Place and Provides Ample Protection

Registrant persists in refusing to disclose responsive information and documents on the ground that what is sought constitutes confidential information or trade secrets that need not be turned over until the parties execute a negotiated confidentiality agreement. This untimely objection has been asserted with regard to Interrogatories Nos. 15, 16, 20, 21, 25, 28, and 30, and Request for Production Nos. 1, 11, 12, 13, 14, 15, 16, 18, 28, 29, 30, 31, and 32 on that ground.

The objection is invalid because the "Board's standard protective order is applicable during disclosure, discovery and at trial *in all* opposition, *cancellation*, interference and concurrent use registration *proceedings, unless the parties, by stipulation approved by the Board, agree to an alternative order, or a motion by a party to use an alternative order is granted by the Board.*" See 37 C.F.R. § 2.116(g). The comments and explanation accompanying the final rulemaking process through which this requirement was adopted are absolutely clear:

In the disclosure regime established by this final rule, the Board's standard protective order is applicable in all cases. . . . The applicability of this standard protective order does not make all submissions confidential. Parties must utilize its provisions to protect confidential information. Neither does the applicability of the standard order preclude a party, when appropriate, from moving for a protective order under applicable trademark or federal rules, when the standard order does not cover the extant circumstances or is viewed by the moving party as providing insufficient protection. As under current practice, parties are free to agree to modify the standard protective order. . . . Absent a stipulation to vary the terms of the standard protective order, approved by the Board, or an order by the Board granting a party's motion to use an alternative order, the parties must abide by the standard order.

United States Patent and Trademark Office OG Notices: 28 August 2007 (emphases added)
(available at <http://www.uspto.gov/go/og/2007/week35/patchtm.htm>.)

The Board's order of August 21, 2008 suspending proceedings *in this case* (pending resolution of this motion) eliminated any doubt on this issue. The final paragraph of the order

states (in relevant part) that “By one rule change effective August 31, 2007, the Board’s standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date.” Having received this order, Registrant’s reiteration of its plainly meritless objection reveals an utter disregard for the Board’s rules.

Registrant claims to want “protections” above and beyond those in the Board’s standard protective order, but it has never approached Petitioner about revising, augmenting, or replacing that order to accommodate any unique needs or concerns about purported “trade secrets”. Were any such needs or concerns genuine, Registrant could have proposed terms to add to the standard order, presented Petitioner with a separate confidentiality agreement to consider, or moved for a protective order.

Accordingly, the Board should compel Registrant to comply immediately with its obligations in response to any discovery requests at which it has heretofore balked on grounds that added “confidentiality” protections are needed.

C. Registrant Has Not Provided Complete Responses to Petitioner’s Interrogatories

Notwithstanding its perfunctory attempt to fill holes in its interrogatory responses by including discovery facts in its “opposition brief,” Registrant’s responses remain largely superficial. Petitioner’s initial brief in support of its motion to compel details the full range of Registrant’s improper objections and deficient responses. The opposition brief only highlights these flaws, examples of which include the following:

- *Response to Interrogatory No. 6* – Registrant refers to a range of materials on which it claims to have placed its marks at issue and states that “[s]ample of Each [sic] of these categories are being supplied as part of readily available documentation,” but it has provided no such “samples,” and it is unclear where the relevant documentation is

“readily available.” Of the 25 pages Registrant has produced thus far, none are Bates labeled and many are only partially decipherable. Some include on their face handwritten references to “Exhibit ___” and other notations with no further explanation. Moreover, Registrant continues to ignore Petitioner’s request for the first use dates (and a description of the relevant first products, first sale, first customers, etc.) for each of those marks. Its response – a reference to information included in its trademark applications – is insufficient, especially given that *priority of use* is a central issue in this case.

- *Response to Interrogatory No. 9* – Registrant maintains several unfounded objections to enable it to avoid identifying the persons who designed or made materials on which the relevant marks allegedly have been displayed. It is unclear why information about “suppliers,” as Registrant refers to it, is “confidential”; but, even if Registrant could demonstrate the sensitivity of such information, the operative protective order requires its disclosure, if relevant and responsive. *See supra*. Contrary to Registrant’s position, its “suppliers” may have discoverable information concerning how, where, and when (if at all) Registrant has used the marks, and the suppliers’ identities are plainly discoverable under the applicable standards. *See Fed. R. Civ. P. 26(b)* (information is discoverable as long as it “appears reasonably calculated to lead to the discovery of admissible evidence”). Finally, Registrant cannot avoid turning over this information based on its stated assumption that “not all [“suppliers”] would be contactable, nor are there [sic] whereabouts/current situations known to” it. *Opposition Brief at 7*. Its obligation is to disclose the information it has; Petitioner can follow up as circumstances permit.

- *Responses to Interrogatories Nos. 10 & 11* – Registrant has identified “Trademark Search Specialists of FRC [Federal Research Corporation]” as persons who communicated concerning any investigation / trademark search related to its marks at issue, and it states that “[t]he trademark search results have [sic] or will be provided to Registrant[.] [sic]” Registrant has produced no such materials to date. In fact, only one document it has turned over bears any apparent connection to “FRC,” and it is nothing more than a filing receipt related to the application for one of the registrations at issue.

The foregoing are merely examples of the evasive approach Registrant has adopted in responding to Petitioner’s discovery requests. The Board should order Registrant to provide complete information responsive to these interrogatories and all the others identified in Petitioner’s original motion brief.

D. Registrant Has Waived Its Opportunity to Object to Petitioner’s Requests for Production and Should Produce the Responsive Documents Without Further Delay

The Board should also find that the extremely belated objections to Petitioner’s requests for production that Registrant has raised (for the first time) in his “opposition brief” are invalid. “It is well established that a failure to object to discovery requests within the time required constitutes a waiver of any objection.” *Richmark Corp. v. Timber Falling Consultants*, 959 F.2d 1468, 1473 (9th Cir. 1992) (citation omitted). Any objections Registrant intended to raise to Petitioner’s requests for production were due nearly four months ago. More than that, Registrant has not even *tried* to justify its failure to raise its objections sooner. There is thus no basis to excuse its discovery noncompliance, and the objections warrant no attention.

The Board should therefore order Registrant to produce all documents responsive to the requests for production right away.

The same result is appropriate even if the Board considers the objections, because they are meritless. As discussed above, Registrant has objected to producing documents responsive to thirteen requested categories based on the incorrect position that the parties must first execute a negotiated confidentiality agreement. Other objections and responses in the “opposition brief” further prove that Registrant will not voluntarily comply with its discovery duties. The following are a few examples:

- Registrant repeatedly represents that it is searching for or will produce, responsive documents to Petitioner, *see Opposition Brief* at 20, 21, and 24, but Petitioner has received no further documents since the “opposition brief” was filed.
- Registrant contends that Petitioner’s requests for documents concerning (i) the selection, creation, and decision to register its marks at issue, (ii) whether it has made proper, lawful use of those marks, and (iii) the prospective customers and sales channels for goods sold under those marks are “not relevant” to this proceeding. *See id.* at 19-20, 23, and 25

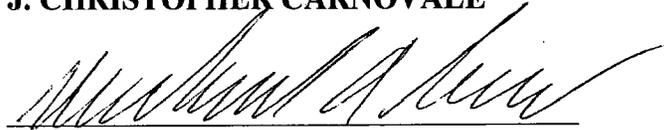
These positions reflect a cramped and obstructionist understanding of, and attitude toward, discovery. Only a Board order and/or sanctions will allow Petitioner access to information and documents it is entitled to. The Board should issue such an order now.

III. CONCLUSION

For all the foregoing reasons, Petitioner respectfully requests that the Board grant its Motion to Compel Discovery or for Sanctions and order any and all relief it deems necessary and appropriate to facilitate the fair and speedy resolution of this case on its merits.

J. CHRISTOPHER CARNOVALE

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CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing Motion is being served upon Registrant's counsel Wayne Harper of Greenberg Traurig PA at Suite 650, 450 S. Orange Avenue, Orlando Florida 32801 by first class mail, postage prepaid this 18th day of September 2008.

