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

Proceeding	92044624
Party	Defendant The Brand Experience LLC
Correspondence Address	MARK SCHMIDT THE BRAND EXPERIENCE LLC 1521 ALTON ROAD #8 MIAMI BEACH, FL 33139 UNITED STATES mark@sunsafe.com
Submission	Opposition/Response to Motion
Filer's Name	Mark Schmidt
Filer's e-mail	mark@sunsafe.com
Signature	/mark schmidt/
Date	12/01/2010
Attachments	Trademark; Rebuttal to Motion for Default Judgement; Dec 1; part 1 of 2.pdf ( 3 pages )(316300 bytes ) Trademark; Exhibit X; Rebuttal to Motion for Default Judgement; Dec 1; part 2 of 2.pdf ( 8 pages )(332183 bytes )

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

**Re: J. Christopher Carnovale (Petitioner)**

**Vs**

**The Brand Experience LLC (Registrant)**

**Canc. No. 92044624**

**REGISTRANT'S RESPONSE TO PETITIONER'S NOV 2, 2010 MOTION FOR DEFAULT JUDGEMENT AND FOR POSTPONMENT OF TESTIMONY OPENING**

**PREFACE**

Please note that Registrant has changed representation. Registrant will now be self-represented by Mark Schmidt, Managing Partner of The Brand Experience LLC. Petitioner's Counsel was notified of this fact on October 15. Registrant formally notified USPTO on Friday, Nov 19. Any delays are due to transition issues caused by this change of representation.

**REGISTRANT'S RESPONSE – SUMMARY**

- Registrant urges the Board to deny Petitioner's Motions and proceed to Testimony
  - The primary reason for this request is that, in this layman's view, Petitioner has relied almost exclusively on procedural remedy instead of Statements of Fact concerning use of the Marks.
  - Registrant, to date, has provided Petitioner unambiguous, verifiable, and continuous Proof of Use of the Marks in Commerce. This Proof includes (but is not limited to): Advertisements and Press Releases in National Publications, National Television Appearances, Participation at Trade Shows, Expenditures on Advertising, Annual Revenues, Continuous Catalog Distribution, Etc.
  - In contrast, Petitioner has provided only limited examples of alleged Use of their Claimed Mark in Commerce.
  - In addition, Petitioner has made false claims in their Allegations of Registrant's Use of the Marks to obtain procedural remedy from the USPTO.
- Based on the above, and that the Use of the Marks in Commerce is, by my understanding, the pre-imminent guideline, the Petitioner is not to be entitled to any default judgment or postponement.

## **REGISTRANT'S RESPONSE TO PETITIONER'S SPECIFIC ALLEGATIONS IN MOTION**

The Communication received by Registrant appears to be a duplicate, "cut and paste" set of pages which are no different from earlier sent questions and contain no specific sections which obviously differentiate and describe how these are different from earlier information requests. Please refer to Petitioner's second set of interrogatories attached hereto as Exhibit X.

To quote Registrant's Response to Petitioner on October 15, 2010:

"The Brand Experience LLC does not understand what additional information is being requested.

To the extent that you believe we have not answered your questions, we request that you let us know specifically what information you require. "

In response – and as further evidence of Petitioner's procedure vs. fact based tactics -- Petitioner resorted to filing a motion for default judgment instead of responding directly to Registrant who, for the first time, is the primary recipient and is reading these requests for the first time.

**Please note that Registrant did, in fact, reply within the thirty (30) day time period.** Please further note that a certificate of mailing was included in the email response, and that this was mailed on Oct 15 as evidenced by the "Certified Mail Receipt" received.

Use of the Marks – above and beyond the evidence already provided -- has remained continuous, and is evident to any interested party who requests a catalog via toll free number or via a web site, which rotates use of the various Marks deployed by Registrant. The continuous Use of the Marks can be verified independently by anybody, anytime. Registrant has consistently stated this to Counsel.

Registrant denies Petitioner's statement that "Respondent has willfully violated" any Order of the Board. If anything, it is the Petitioner's use of false claims during this process that has willfully violated Federal Trademark Rules.

## **CONCLUSION**

Registrant urges the Board to deny Petitioner's Motions and proceed to Testimony for the reasons presented above.

The valid electronic signature below certifies this formal response, in writing and under oath, by The Brand Experience LLC, represented by Mark Schmidt, to the REGISTRANT'S RESPONSE TO PETITIONER'S NOV 2, 2010 MOTION FOR DEFAULT JUDGEMENT AND FOR POSTPONMENT OF TESTIMONY (RE Canc. No. 92044624)

/mark schmidt/ , signed on Dec 1, 2010

Mark Schmidt

Managing Partner

The Brand Experience LLC

#### CERTIFICATE OF MAILING

It is hereby that the attached **REGISTRANT'S RESPONSE TO PETITIONER'S NOV 2, 2010 MOTION FOR DEFAULT JUDGEMENT AND FOR POSTPONMENT OF TESTIMONY (RE Canc. No. 92044624)** will be deposited with the US Postal on December 2, 2010, addressed to the Hon. Commissioner of Trademarks, PO Box 1451, Washington, DC 22313, marked first class mail, postage prepaid.

/mark schmidt/

**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 :

**PETITIONER'S SECOND SET OF INTERROGATORIES**

Petitioner, J. Christopher Carnovale (“Petitioner”) propounds the following interrogatories to be answered by Registrant, The Brand Experience LLC (“Registrant”), in writing under oath, within thirty (30) days pursuant to Rule 33 of the Federal Rule of Civil Procedure.

**DEFINITIONS**

The following definitions apply to these interrogatories and other discovery requests.

1. “Document” shall have the full meaning ascribed to it in Rule 34 of the Federal Rules of Civil Procedure, and shall include all tangible sources of information, including but not limited to: (a) the original and any non-identical copy (whether different from the original because of handwritten notes or underlining made thereon, attachments affixed thereto, or otherwise) or drafts thereof, of any handwritten, typewritten, printed, recorded, electronically stored or graphic matter, however produced or reproduced, including but not limited to charts, plans, drawings, art work, transparencies, sketches, blueprints, files, electronic mail, computer data and/or tapes, reports, travel reports, expense reports, memoranda, notes, minutes, letters and other correspondence, testimony, summaries, abstracts, studies, surveys, graphs, statistics, tables, forms, work papers, logs, indexes, drafts, advertisements, and scripts; and (b) any mechanical,

magnetic or electronic or other recordings of any voice, sound, image or data including but not limited to photographs, microfilms, video and audio tapes, film, sound recordings, CDs, record albums, and any other data compilation in Registrant's possession, custody or control wherever located.

2. "Tangible things" shall mean any physical object not included within the definition of "document" above including, but not limited to, models, mock-ups, prototypes and samples.

3. The pronouns "you" and "your" and/or the term "Registrant" shall mean the Registrant The Brand Experience LLC, and all of its parents, predecessors, subsidiaries, affiliates, divisions and groups, and each of their directors, officers, employees, shareholders, agents, representatives and consultants.

4. The term "Petitioner" shall mean the Petitioner J. Christopher Carnovale in the above-captioned action, and all of his predecessors in business, employees, agents, representatives, attorneys and consultants.

5. The singular includes the plural number, and vice versa. The masculine includes the feminine and neuter genders. The past tense includes the present tense where the clear meaning is not distorted by change of tense.

6. "And" and "or" shall be construed conjunctively or disjunctively as necessary to make these document requests inclusive rather than exclusive.

7. "Each", "any" and "all" mean each and every.

8. "Person" means any individual or entity, including but not limited to partnerships, corporations or any other form of business or any legal, governmental, or business entity.

9. “Entity” means any legal or business entity of any kind and includes, without limitation, corporations, partnerships, trusts, associations and organizations.

10. The term “communication” means any exchange or transmission of words or ideas to another person or an entity, including without limitation conversations, discussions, e-mails, facsimiles, letters, memoranda, meetings, notes, speeches, or other transfer of information, whether written, oral, or by any other means, whether direct or indirect, formal or informal, and includes any document which abstracts, digests, transcribes or records any such communication.

11. The term “Petitioner’s Mark” refers to the mark THE SUNSCREEN THAT NEVER WEARS OFF, and any other marks owned by Petitioner containing the phrase SUNSCREEN THAT NEVER WEARS OFF, described in the petition to cancel.

12. The term “Registrant’s Marks” refers to the alleged marks identified in Registration Nos. 2384600, THE 50+ SUNSCREEN THAT WON’T RUB OFF; 2477694, THE SUNSCREEN THAT WON’T RUB OFF; and 2593603, SUNSCREEN KIDS WANT TO WEAR, and the phrase SUNSCREEN THAT WON’T RUB OFF, alone or in combination with other words.

13. The term “mark” includes trademarks, service marks, collective marks, certification marks, and trade names as defined in 15 U.S.C. § 1127, regardless of whether any such mark is federally registered.

14. The term “referring or relating to” means comprising, relating to, or in any way relevant within the meaning of Rule 26(b) (1) of the Federal Rules of Civil Procedure.

15. As used herein, the term “identify” means:

- (1) In the case of a person, to state:
  - a. name;

- b. last known residence;
- c. employer or business affiliation; and
- d. occupation and title or position held.

(2) In the case of a company, to state:

- a. the name;
- b. if incorporated, the place of incorporation;
- c. the principal place of business; and
- d. the name and address of the person or persons having knowledge of the matter with respect to which the company is named.

(3) In the case of a document, to state:

- a. the identity of the person or persons who prepared it, the sender and recipient, if any;
- b. the title or a description of the general nature of its subject matter;
- c. the date of preparation;
- d. the date and manner of distribution and publication, if any;
- e. the location of each copy and the identity of the present custodian;
- f. the identity of the person or persons who can identify it;
- g. the contents of the document verbatim; and
- h. if privilege is claimed, the specific basis for the claim.

In lieu of the foregoing, a copy may be supplied.

(4) In the case of an act or event, to state:

- a. a description of the act or event;
- b. when it occurred;

- c. where it occurred;
- d. the names and addresses of the person or persons involved in or who performed said act (or, in the case of an omission, the person or persons failing to perform);
- e. the identity of all persons who have knowledge, information or belief about the act;
- f. when the act, event or omission first became known; and
- g. the circumstances and manner in which such knowledge was first obtained.

16. The terms “state,” “describe,” or “explain” mean, when used with respect to a fact, event, action, defense, or allegation, to provide a complete description of all details concerning such fact, event, action, defense, or allegation, including the date, place, factual basis, pertinent facts, and names and addresses of all persons with knowledge relating to each such fact, event, action, defense, or allegation.

### **INSTRUCTIONS**

The following instructions apply in answering these interrogatories and other discovery requests:

1. The interrogatories and document requests are continuing in nature and, pursuant to Rule 26 of the Federal Rules of Civil Procedure, Registrant has a duty to supplement its answers promptly upon obtaining or learning of further responsive information.

2. The answer to each interrogatory or document request shall include such knowledge or information as is within Registrant’s possession, custody, or control including, but not limited to, knowledge, information and documents in the possession, custody, or control of

Registrant's officers, directors, accountants, consultants, attorneys, or other agents or representatives.

3. The answers to interrogatories must be furnished separately and fully in writing under oath or verification by Registrant declaring, under penalty of perjury, that the answers are true and accurate to the best of its current knowledge, information, and belief. If an answer depends upon the knowledge of a person other than the person signing the answers, each such person should be identified in the answer.

4. The answers shall include the knowledge of Registrant's representatives and agents including, but not limited to, its consultants, accountants and your attorneys.

5. If an objection is raised to all or any part of an interrogatory or document request, state the grounds of the objection with sufficient specificity to permit determination of the basis for and propriety of such objection, including citations where legal authority is relied upon, and answer to the extent the interrogatory or document request is not objectionable. All objections shall be signed by the attorney making them.

6. All answers and objections to interrogatories or document requests shall be made within thirty (30) days of the service of these interrogatories in writing.

7. Registrant shall not refer to documents generally in lieu of answering; if the burden upon you of deriving an answer from documents is the same as it is upon Petitioner, you may elect to refer to documents which are specifically identified from which the response may be readily obtained. Such a response constitutes a representation under oath by you and your counsel that, after reasonable investigation, those conditions have been met.

8. The full text of the interrogatory (or part thereof) to which any answer is intended to respond is to be restated immediately preceding such answer.

9. If at any time you obtain knowledge that the answer given in response to any interrogatory or document request was not correct when given or is no longer correct, a statement in writing under penalty of perjury consisting of the correct answer to such interrogatory shall be promptly provided.

10. If you contend that any item of information requested by the interrogatories or document requests is privileged, in whole or in part, as a ground for its non-production or non-disclosure, for each alleged privileged item or document, provide all information required by Rule 26 of the Federal Rules of Civil Procedure, the Local Rules and relevant case law.

### **INTERROGATORIES**

34. Identify and describe all facts on which Registrant bases the allegation that it has continuously used the marks THE SUNSCREEN THAT WON'T WEAR OFF and the THE SUNSCREEN THAT KIDS WANT TO WEAR.

35. Supplement all of Registrant's responses to Petitioner's First Set of Interrogatories with information that is current and complete as of the date of this Second Set of Interrogatories.

If the response to any interrogatory is believed by Registrant to contain confidential information or trade secrets, it should be so designated in accordance with the protective order in effect in this proceeding..

J. CHRISTOPHER CARNOVALE

By   
Michael A. Grow  
Alec Rosenberg  
Arent Fox LLP  
1050 Connecticut Avenue, NW  
Washington, DC 20036  
202-857-6389

Attorney for Petitioner

**CERTIFICATE OF SERVICE**

It is hereby certified that the foregoing Petitioner's second set of interrogatories is being served upon Registrant's counsel Wayne Harper of Greenberg Traurig, PA at Suite 650, 450 South Orange Avenue, Orlando, Florida 32801 by first class mail, postage prepaid, on May 7, 2010.

  
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