ESTTA Tracking number: **ESTTA79895**
Filing date: **05/08/2006**

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

Proceeding	92044697
Party	Defendant Martello, Jeannette Martello, Jeannette 501 Floral Park Terrace South Pasadena, CA 91030
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Date	05/08/2006
Attachments	Opposition to Motion to Compel.pdf (8 pages)(23346 bytes)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

ACM ENTERPRISES, INC., Petitioner, vs. JEANNETTE MARTELLO, M.D., Respondent.	Cancellation No. 92044697 Reg. No. 2932593 OPPOSITION TO MOTION TO COMPEL; DECLARATION OF BRANDON M. TESSER

1. INTRODUCTION.

Petitioner's Motion to Compel "further responses" to its Request for Production of Documents (Set No. 2) and Special Interrogatories (Set No. 2) (the "Motion")[1] should be denied because it was prematurely filed before counsel for the parties had an opportunity to "meet and confer" in good faith to attempt to resolve these discovery issues. Petitioner's sole attempt to resolve this dispute consisted of a last-minute telephone call on April 20, 2006, the day before its deadline to file discovery motions. And the sole issue discussed was Respondent's failure to produce documents – the other purported discovery issues were not mentioned.

Because there was no discovery "dispute" – Respondent merely needed more time to

[1]/ Petitioner also filed a motion to test the sufficiency of answers to requests for admissions (TBMP 524). But the issues presented by this motion were subsequently resolved, and the TTAB was so notified by Petitioner on May 5, 2006.

locate and produce the requested documents, some of which were in the possession of third-party Sara Herrick – Respondent offered to stipulate to extend the relevant time periods to allow more time to resolve these issues, and give Petitioner more time to file a motion to compel, if necessary. But Petitioner refused to agree to extend the time periods, claiming that it would be prejudiced by the delay. Ironically, however, because the proceedings have been suspended as a result of Petitioner's Motion, the testimony and trial periods will be extended in any event.

Had Petitioner agreed to a brief continuance, the parties could have had more time to resolve these discovery issues, and perhaps obviate the necessity of having a motion to compel heard by the TTAB. The main issue presented by the Motion is Respondent's failure to produce documents. Respondent is working diligently to produce the requested documents, which will in all likelihood be produced prior to the date the TTAB rules on the Motion.

2. PETITIONER'S MOTION MUST BE DENIED BECAUSE IT WAS PREMATURELY FILED WITHOUT FIRST MAKING A GOOD FAITH EFFORT TO RESOLVE THE ISSUES PRESENTED BY THE MOTION.

Before filing a motion to compel, the moving party must make a good faith effort to resolve the discovery dispute. 37 CFR 2.120(e)(2). This is more than a *pro forma* requirement. In the instant case, Petitioner's counsel called Respondent's counsel to discuss these discovery issues for the first time on April 20, 2006; just one day prior Petitioner's to file its motion to compel. A brief telephone discussion was had regarding Respondent's failure to produce documents and the fact that Respondent's deadline to file a motion to compel expired the next day. No other substantive issues were discussed.

Respondent's counsel indicated that additional time was necessary to search for and produce the requested documents, some of which were in the possession of third-party witness Sara Herrick. Accordingly, Respondent offered to stipulate to further extend the discovery period and testimony periods so that there would be sufficient time for the discovery issues to be worked out, or not, while alleviating the necessity for Petitioner to have to file a motion the next day. Petitioner refused to accept the offered extension notwithstanding the fact that no conceivable prejudice would have resulted from a brief extension. Indeed, the mandatory

suspension caused by Petitioner's Motion filing will cause the time periods to be further delayed.

There was no discussion during the April 20 "meet and confer" telephone call regarding the other discovery issues presented by the motion. In particular, Petitioner's counsel did not mention that there were deficiencies with Respondent's responses to Petitioner's Requests for Admissions or its Special Interrogatories. These issues were communicated for the first time in counsel's self-serving letter of April 20, 2006 which Respondent's counsel did not receive until the next day, April 21st – the same day Respondent filed its motion.

Given that Petitioner: i) failed to discuss with Respondent all of the purported discovery issues prior to filing its Motion; ii) contacted counsel just the day before it's filing deadline; and iii) failed to accommodate Respondent's request for a brief extension of time to assemble the requested documents or otherwise resolve the pending discovery issues, it is evident that no good faith effort was made by Petitioner before it filed its motion to compel. See, e.g., *Tri-Star Pictures, Inc. v. Unger* (SD NY 1997) 171 FRD 94, 99 (movant must detail efforts to confer and explain why they proved useless); *Hoelzel v. First Select Corp.* (D CO 2003) 214 FRD 634, 636 (single e-mail message not a meaningful meet and confer).

3. REQUESTS FOR PRODUCTION OF DOCUMENTS.

Respondent has agreed to, and will shortly, produce all responsive documents within her possession custody or control. With the exception of Request No. 27, all documents will be produced.

Respondent concedes that it has taken longer than expected to produce these documents. But any delay is mitigated by the fact that Respondent: i) will incur the cost of photocopying the documents and arrange to have the documents delivered directly to Petitioner, instead of requiring Petitioner to travel to Respondent's counsel's office to review the documents and have them copied at its sole expense, as contemplated by 37 CFR §2.120(d)(2); ii) has agreed to produce documents within the possession of third-party Sara Herrick, although not required to do so; iii) Petitioner has not been prejudiced by the time it has taken for Respondent to produce the requested documents.

Respondent, however, stands on its objections to Request No. 27 and will not produce

any documents. As reflected below, this request improperly seeks all documents Respondent intends to rely upon at trial regarding third-party Herrick's use of a related mark.

Request No. 27:

All documents and material which Respondent intends to introduce as evidence in this Proceeding regarding SARA HERRICK's INTERSTATE COMMERCE use of the mark "SKIN DEEP SKIN CARE."

Response:

Objection, the request is vague, ambiguous, overbroad, incomprehensible, burdensome and oppressive, not relevant and not reasonably calculated to lead to the discovery of admissible evidence, and violates the work product privilege. Without waiving, and subject to the foregoing objections, Petitioner will produce all responsive documents within her possession, custody or control, if any there are.

Per TMBP §414(7) "[a] party need not, in advance of trial, specify in detail the evidence it intends to present . . . ." *See also British Seagull Ltd. v. Brunswick Corp.* (TTAB 1993) 28 USPQ2d 1197, 1201 (need not disclose entirety of proposed evidence) *aff'd, Brunswick Corp. v. British Seagull Ltd.,* (Fed. Cir. 1994) 35 F.3d 1527; *Polaroid Corp. v. Opto Specs, Ltd.,* (TTAB 1974) 181 USPQ 542, 543 (opposer need not describe evidence it will rely on to support allegations in opposition).

4. RESPONSES TO SPECIAL INTERROGATORIES.

With respect to Special Interrogatories Nos. 20, 21, and 22, Respondent will agree to provide the requested information which is in the possession of third-party Sara Herrick.

As to Special Interrogatory No. 23, Respondent has agreed to provide responsive documents (per FRCP 33(d)), and will do so.

Respondent stands on its objection to Special Interrogatory No. 24. The Interrogatory is vague and ambiguous as to whose invoices are being requested. Does the interrogatory seek information regarding Respondent's own invoices? Or information regarding invoices Respondent may have received in connection with services she rendered to her patients (e.g., invoices anesthesiology services, breast implants, hospital charges, etc.).

Dated: May 8, 2006

TESSER & RUTTENBERG

By: _____

Brandon M. Tesser
Attorneys for Respondent
Jeannette Martello, M.D.

DECLARATION OF BRANDON M. TESSER

I, BRANDON M. TESSER, Declare as follows:

1. I am an attorney at law, duly licensed and qualified to practice before all courts of the State of California. I am a partner of Tesser & Ruttenberg, counsel of record for Respondent Jeannette Martello, M.D. in the above-captioned action. I make this Declaration in support of Respondent's Opposition to Petitioner's Motion to Compel ("Motion"). I have personal knowledge of each of the following facts, and would and could competently testify thereto if called upon to do so as a witness.

2. Respondent has been working diligently to obtain all of the information and documents sought in connection with Petitioner's discovery. Unfortunately, however, it has taken longer than expected to produce the requested documents due to Respondent's busy schedule and the fact that many of the documents are not in her possession, custody or control. They are in the possession of third-party Sara Herrick. Due to the fact that it has taken longer than expected to produce these documents, on April 14, 2006 I requested that my associate, Michelle DeCasas, contact Petitioner's counsel, David Hong, to request a brief extension of time to respond to all outstanding discovery.

3. I received a voice-mail message from David Hong n April 20, 2006 while I was out of the office attending a mediation in another case. When I called Mr. Hong back he explained to me that he had "recently received" Respondent's discovery responses and that no documents were produced. I told him that we would be producing the documents shortly, and that one of the reasons it was taking longer than expected was the illness of Sara Herrick (who had cervical cancer). He stated that, unless he had all of the documents by "tomorrow" (i.e. April 21st), he would have no choice other than to file a motion to compel because the filing deadline was the very next day. I explained to him that he did not need to file a motion to compel by tomorrow because Respondent would stipulate to extend the discovery period and testimony periods for a brief period. This would allow the parties more than 24 hours to produce the documents and resolve this discovery dispute. Respondent refused to agree to a stipulated extension and thereafter filed its Motion the very next day. At no time during this conversation did Mr. Hong mention that there were any outstanding

discovery issues other than Respondent's failure to produce the requested documents.

4. It was not until the morning of April 21, 2006 that I received a copy of Mr. Hong's April 20th self-serving confirmatory letter wherein he advised, for the first time, that there were additional issues with Respondent's discovery responses. I received later that day a copy of Respondent's Motion.

5. In connection with Respondent's production of documents I have agreed to photocopy all of the documents and have them delivered to counsel for Petitioner. Instead of requiring that counsel come to my office, or my client's office, to review and copy the requested documents, as contemplated by 37 CFR §2.120(d)(2). Respondent has also agreed to produce documents within the possession, custody and control of third-party Sara Herrick, even though we are not otherwise obligated to do so.

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct, and that this Declaration was executed on May 8, 2006, at Los Angeles, California.

_____

BRANDON M. TESSER

PROOF OF SERVICE

STATE OF CALIFORNIA, COUNTY OF LOS ANGELES

I am employed in the COUNTY of LOS ANGELES, STATE of CALIFORNIA. I am over the age of 18 and not a party to the within action; my business address is 12100 Wilshire Boulevard, Suite 220, Los Angeles, California 90025.

On May 8, 2006, I served the foregoing document(s) described as RESPONDENT'S OPPOSITION TO PETITIONER'S MOTION TO COMPEL in this action by placing a true copy thereof enclosed in a sealed envelope addressed as follows:

David Hong, Esq.
Law Office of David Hong
P.O. Box 2111
Santa Clarita, California 91386-2111
Tel/Fax: (866) 824-8680
Attorney for Petitioner ACM Enterprises, Inc.

[x] BY MAIL: I am readily familiar with my firm's practice for the collection and processing of correspondence for mailing with the United States Postal Service. In the ordinary course of business, correspondence would be deposited with the United States Postal Service that same day. I placed true copies of the above-entitled document in envelopes addressed as shown above and sealed and placed them for collection and mailing on the date stated above, following ordinary business practices.

[ ] BY PERSONAL SERVICE: I caused such envelope to be delivered by hand to the offices of the addressee(s) as marked with an ***.

[ ] BY FEDERAL EXPRESS: I caused said envelope(s) to be sent by Federal Express to the addressee(s) on the attached service list.

[x] BY TELECOPIER: In addition to the above service by mail, hand delivery, or Federal Express, I caused said document(s) to be transmitted by telecopier on May 8, 2006 at approximately 2:30 p.m. to the addressee(s) above.

[x] (Federal) I declare that I am employed in the office of a member of the bar of this court at whose direction the service was made.

Executed on May 8, 2006, at Los Angeles, California.

_____
Wendy Southart