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

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| Proceeding | 92048271 |
| Party | Defendant<br>Patriarch Partners Agency Services, LLC |
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TRADEMARK
Docket No. 110.2*1/R643

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

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| RH INO LININGS, USA, INC.<br>Petitioner,<br>v.<br>RAPID RACK INDUSTRIES, INC.<br>Respondent. | Cancellation No. 92048271<br><br>Registration No. 1,698,407<br>Date of Issue: June 30, 1992 |

**RESPONDENT'S OPPOSITION TO PETITIONER'S AMENDED MOTION TO COMPEL DISCOVERY RESPONSES, MOTION TO DEEM REQUESTS FOR ADMISSIONS ADMITTED AND MOTION FOR SANCTIONS**

**AND**

**RESPONDENT'S OPPOSITION TO PETITIONER'S MOTION TO EXTEND THE DISCOVERY DEADLINE TO ALLOW PETITIONER TO CONDUCT FOLLOW-UP DISCOVERY**

## I. INTRODUCTION

Petitioner's Rhino Linings USA, Inc.'s ("RL") myriad discovery motions amount to a last ditch effort to avoid the reality that Respondent, Rapid Rack Industries, Inc. ("RR") possesses valid rights in its United States Trademark Registration No. 1,698,407 for the RHINO RACK mark ("'407 mark"). After RR provided RL with the discovery requested, RL appears to have realized the validity of the RR's mark and now seeks to conduct a fishing expedition. RL's frustration began when the Trademark Examining Attorney denied RL's Application Serial Nos. 78/855,807; 78/832,703; 78/832,653; and 78/832,237 applications ("RL's applications") because of a likelihood of confusion with RR's prior use of the '407 mark for goods in Class 20. Faced with this defeat, RL turned to the Trademark Trial and Appeal Board ("TTAB") in an attempt to

cancel RR's long standing use of the RHINO RACK mark. When RL learned from RR's discovery responses that RR's continuous use of the '407 mark would also cause rejection of RL's applications, RL filed the current discovery motions in an attempt to salvage those applications.

Particularly telling of the desperation RL now finds itself in is the fact that its motions are completely free of any case law to support its position. Further, where RL does revert to the use of the Trademark Rules and Federal Rules of Civil Procedure, RL fails to show any facts support application of these rules to the situation at hand. This fact is but another indication that RL is unwilling to accept the legitimate discovery responses provided by RR indicating that RR has continually used the RHINO RACK mark since at least January 1991 and RL has no basis for asserting fraud based on a lack of continuous use.

Also telling is the fact that RL failed to provide any documents produced by RR showing its complete responses to RL's discovery requests. To bring the matter to full light before the TTAB, RR provides these documents to show the lengths that RR went to provide RL the requested discovery.

RL also appears to have not understood RR's responses because it failed to file its original motion under seal although RR's responses clearly indicate the responses are designated "TRADE SECRET/COMMERCIALLY SENSITIVE" and "CONFIDENTIAL" in accordance with the standard protective order governing proceedings before the TTAB. Only after RR's counsel pointed out the breach of this Board's Protective Order did RL file the current Amended Motion.

Because RR has acted in good faith and provided all the discovery requested by RL, the Board should deny RL's numerous motions.

## II. BACKGROUND

### A. Procedural Background

RL first used the RHINO RACK mark on January 8, 1991. RR alleges that RL failed to use the '407 mark "for at least a five-year period between roughly 2001 and 2007." Pet. for Cancellation at ¶ 1. RL further alleges that RR "committed fraud on the United States Patent and

Trademark Office by filing a false affidavit of use under Sections 8 and 9" in 2002. *Id.* RL has continually used the RHINO RACK mark between 2001 and 2007 thereby negating RL's basis for its cancellation proceeding and its allegation of fraud.

RR worked with RL to reach a settlement over an eight-month period. In fact, RL's counsel of record, Mr. David Harlow, a partner at Nelson Mullins Riley & Scarborough LLP, agreed to suspend the current proceedings in light of the settlement talks on January 22, 2008. Declaration of Patrick J. Ormé filed herewith ("Ormé Decl."), Ex. A. Another attorney at Mr. Harlow's firm, an associate by the name of Mr. Joe Dowdy, took exception to any discovery extension beyond a single day. Ormé Decl., Ex. B. Two minutes after Mr. Dowdy's rejection, Mr. Harlow agreed to suspend discovery beyond a single. Ormé Decl., Ex. C. The parties then filed a *joint* request to suspend the proceedings on January 25, 2008. The parties continued to work over on reaching a settlement and RL filed a motion to suspend the proceedings on March 25, 2008. Only when settlement negotiations broke down did the proceedings and discovery resume.

**B. <u>Discovery Background</u>**

In an effort to reach a resolution to the current discovery disputes, RR's counsel sought to communicate directly with RL's counsel of record, Mr. Harlow, given Mr. Dowdy's seemingly unreasonable and contradictory actions. This included Mr. Dowdy's contradiction to Mr. Harlow's discovery extension noted above. Additional problems include Mr. Dowdy's apparent attempt to seek a Rule 30(b) deposition of RR by burying the request in his July 11, 2008 letter instead of seeking to issue a Notice of Deposition. Pet.'s Ex. 2 at 5 ("In conjunction with this demand for supplementation also, we request depositions of records custodian(s) or other Rapid Rack employee(s) with knowledge"). In telephone conversations with Mr. Dowdy and Mr. Hollander, any resolution of the discovery disputes seemed far removed. As a further example of the unreasonable nature of Mr. Dowdy's discovery requests, during the Rule 30(b)(6)

deposition of RR, Mr. Dowdy insisted that a panel of witnesses be deposed at one time although he failed to provide any support for such a request that would leave the court reporter, RL's counsel and the witnesses confused as to who should respond to what question. Given the seemly erratic approach of Mr. Dowdy, RL cannot be heard to complain that RR believed it should communicate directly with RL's attorney of record, Mr. Harlow, in seeking resolution of these discovery disputes in a reasoned manner.

Petitioner seeks an amended discovery order to allow it to take a Rule 30(b)(6) deposition of Respondent. Pet.'s Mot. at 12, ¶ 18. As Petitioner itself admits, it does not need this extension because it "set the deposition for the last day of discovery on September 22, 2008." Pet.'s Ex. 4 at 3. Upon agreement of the parties, RR produced a 30(b)(6) witness knowledgeable on 22 of the 45 topics noticed by RL. Ormé Decl., Ex. D; Ex. E (Deposition of Randy Taylor ("Taylor Depo.") at 8:8-21). RL has not indicated that they will pursue further deposition testimony and thus any extension is no longer warranted.

### C. Rapid Rack Background

The current management of RR has been in place for about three years. Lacking knowledge regarding many of the discovery requests propounded by RL, RR's management answered to extent they possessed such knowledge. As related to RL's counsel on numerous occasions, RR also suffered a flood in 2004 destroying many documents. Ormé Decl., Ex. E (Taylor Depo. at 72:15-17.) RL failed to properly notice a Rule 30(b)(6) deposition of RR to learn the extent of this flood until September 26, 2008, before filing its current motion to compel.[1] Although RL seeks a Motion to Compel 30(b)(6) such a deposition already occurred. Ormé Decl., ¶ 7.

Many of RR's records requested by RL are located in an inaccessible and possibly corrupt

[1] Although RL seeks to compel a Rule 30(b)(6) deposition, such a deposition already occurred on September 26, 2008.

database. RL demanded access to the computer containing the database even when RR's counsel stated that computer may contain attorney-client privilege and attorney work product materials. Ormé Decl., ¶ 8. RR's counsel offered to provide the computer to a third party technician at RL's cost, but counsel for RL refused. *Id.*

## III. ARGUMENT

### A. Respondent Mets Its Discovery Obligations

#### 1. Respondent Provided Proper Interrogatory Responses

RR responded as required under Federal Rule of Civil Procedure 33 and Trademark Rule 405.04(b). As required by Rule 405.05(b), Respondent properly "respond[ed] to them by stating, with respect to each interrogatory, either an answer or objection" or directing RL to appropriate documents. With respect to the answers to each interrogatory, RR noted that its responses where "based on diligent inquiry and investigation." Pet.'s Ex. 1 at 3, ¶ 10. RR's investigation supports the fact that "respondent's response[s are] sufficient. *Jet, Inc.*, 2003 WL 355736 (denying motion to compel). RR responds to each of the contested interrogatory responses below[2]:

##### a) Interrogatory No. 1

RR fully responded to this interrogatory with part numbers for storage racks bearing the RHINO RACK mark since as early as 1991. RL's objections appear to be nothing more than a rehash of it denial that RR used the RHINO RACK mark continuously since registration of the mark. Further, RR's response provides the date of use as earlier as January 1991 - a date sufficient to overcome RL's claim that RR did not continually use its mark since the time of

[2] RL failed to provide any specific reasons for its motion to compel responses to Interrogatory Nos. 28-35, but instead refers to a letter that lacks any support for a motion to compel and includes conclusory arguments such as "undoubtedly would be relevant to the present proceedings." Petitioner's Ex. 2 at 9.

RL also attempts to circumvent the 25 page limit on motions imposed by 37 C.F.R. § 127(a) by incorporating by reference 23 pages of additional legal arguments. Pet.'s Mot. at p. 3 ¶ 4, p. 5 ¶ 7, p. 7 ¶ 8, p. 8, ¶ 9 and p. 9, ¶ 11.

registration. Particularly telling is RL's attempt to backtrack on prior arguments made to RR by blacking out portions of its July 11, 2008 letter. Pet.'s Ex. 2 at 6. The blacked out portions illustrate that RL understood that RR used the RHINO RACK mark on storage racks. The blacked out portions read:

> "Rapid Rack then proceeds to list eleven 'part numbers' for 'at least' some of the storage racks bearing the Rhino Rack Mark. It is completely unclear whether the numbers are serial numbers for racks themselves or whether they are part numbers for component parts allegedly used in Rapid Rack's storage racks. If the latter, then it is also unclear whether the parts themselves bear the RHINO RACK Mark or whether it is only the complete shelving system when sold together that bears the Mark."

Ormé Decl., Ex. I. That RL could not understand its own definition of "all products" yet RR provided answers identifying storage rack indicates RL's frivolous claim that RR failed to respond properly to this interrogatory based upon a reasonable interpretation.

RL also improperly seeks a response regarding unknown future intentions of RR to use its mark. Thus, RR's response lays to rest the entire issue of this cancellation proceeding and any further response would not only be overly burdensome, but also harassing. For these reasons, petitioner's motion to compel further responses to Interrogatory No. 1 should be denied.

**b) <u>Interrogatory No. 2</u>**

RL provides no rational basis for compelling responses beyond RR's already proper response other than claiming the "answer is incomplete." In addition to responding that its products are distributed throughout the United States, RL provided documents, including

customer lists and invoices, indicating geographic distributions and names of retailers. Ormé Decl., Ex. F (RR1-00001-RR1-00504, RR1-00508-RR1-00511). These responses provide the information sought by RL and therefore RL's motion to compel further responses to Interrogatory No. 2 should be denied.

**c) Interrogatory No. 3**

RL objects to RR's identification of three individuals possessing knowledge concerning RL's use of the RHINO RACK Mark. RL further seeks details of each individual's involvement. Details of the scope of an individual's knowledge are properly the subject of a deposition and are overly broad and unduly burdensome in the context of an interrogatory. RR met its duty to identify individuals with knowledge. RL fails to offer any sound reason or legal support rebutting RR's proper response and thus RL's motion to compel further responses to Interrogatory No. 3 should be denied.

**d) Interrogatory No. 4**

The documents identified by RL in response to this interrogatory along with RL's responses to Interrogatory No. 1 fully respond to this interrogatory. The documents identified contain the requested sale information by part numbers and name for storage rack part numbers identified in response to Interrogatory No. 1. Petitioner can add the numbers to come up with sales information for whatever time period it desires without overly burdening Respondent. Because RR completely responded and no other information is currently available, the Board should deny RL's motion to compel further responses to Interrogatory No. 4.

**e) Interrogatory No. 5**

RR fully responded to this interrogatory requesting RR "describe in detail how Registrant uses or used Registrant's Mark." RR responded that it uses the RHINO RACK mark "to identify

Rapid Rack as the source of goods bearing such mark," yet RL attempted to broaden the meaning of the word. Pet.'s Ex. 1 at 7. RL's attempt to redefine the common meaning of "use" is not overly surprising given RR identified the mark as indicating the origin of its goods - a response contrary to RL's interest in overcoming the prior rejection of RL's applications. In its letter of July 11, 2008, RL expands the meaning of "use" "such as whether the Mark is used on packaging or on the products themselves, which (if any) of the products bear the Mark apart from any packaging (and if so where the Mark appears on the products), and whether the mark [*sic*] appears on any advertising or other materials in connection with the products identified." Pet.'s Ex. 2 at 7. RR provided a complete response based upon the common meaning of the word "use." RL cannot complain to the Board regarding its own inadequate interrogatory. For these reasons, the Board should deny RL's motion to compel further responses to Interrogatory No. 5.

**f) <u>Interrogatory Nos. 6-13</u>**

RL seeks additional responses to these interrogatories although, as discussed above, when RR offered a solution to the problems with its database, RL refused the offer. RL cannot seek relief from the Board for its own failings to seek a solution to this discovery dispute.

RL also appears to lack an understanding of what constitutes channels of distribution because it believes that the retailers identified by RR as selling storage racks bearing the RHINO RACK mark do not constitute channels of trade. As this Board has stated on numerous occasions, channels of distribution include retailers. *See e.g., In re Versus Trading Co., Inc.*, 2007 WL 2415740 (TTAB 2007) ("opposer's sales of its goods are through ordinary retail channels of distribution"); *Novo Nordisk A/S v. Innoject, Inc.*, 2004 WL 1427396 (TTAB 2004) ("ordinary retail channels of distribution").

RR also provided the information necessary to establish its continuous use of the RAPID

RACK mark from 2000 through 2008, an answer that likely has led to RL's current unfounded complaint regarding deficient discovery responses. An interrogatory requestor's displeasure with responses it receives to those interrogatories does not justify a motion to compel.

For the foregoing reasons, the Board should deny RL's motion to compel further responses to RL's Interrogatory Nos. 6 to 13.

**g) Interrogatory Nos. 15-22**

RR provided answers consistent with the extent of knowledge of its new management and information available and not destroyed in a flood in 2005.[3] Contrary to RL's assertion, RR provide answers to these interrogatories. Because RR's investigation was ongoing, RR provided documents responsive to this request as they became available such as a mock up of advertising and invoices. Ormé Decl., Exs. F (RR1-00511), H (RR00515). That RL failed to analyze the documents produced by RR should come as now surprised given RL did not review them enough to understand the documents should have been filed under seal. RR met its ongoing discovery obligations and further response beyond the scope of the current interrogatories required RL to conduct further discovery. Instead, RL improperly chose to bring a motion to compel information not sought by these interrogatories. For these reasons, the Board should deny RL's motion to compel further responses to Interrogatories Nos. 15-22.

**h) Interrogatory No. 25**

RL seeks responses from RR regarding RL's *own* Petition for Cancellation and persons having knowledge and what that knowledge comprises. This interrogatory's broad scope seeks information beyond the possession, custody and control of RR because such information is

[3] RR inadvertently responded to Interrogatory No. 21 that some of the information may be been destroyed in a flood. Instead of seeking to clarify the extent of flood damage with further discovery on this issue, RL has filed this current motion.

possessed by RL itself or other third parties.

To the extent this interrogatory seeks information possessed by RR, RL should understand that such persons and knowledge involve attorney-client privilege and attorney work product. "The privilege protects communications made in confidence by clients to their lawyers for the purpose of obtaining legal advice." *The Pep Boys Manny, Moe & Jack of Cal. v. Teera Hanharutaivan and Krieng Wongtangjai*, 2002 WL 2007893 (TTAB 2002) (citing *Upjohn Co. v. United States*, 449 U.S. 383, 395 (1981), *Fisher v. United States*, 425 U.S. 391, 403 (1976) and *In re Walsh*, 623 F.2d 489, 492 (7th Cir. 1980)) (upholding attorney-client privilege)[4]. That RR's counsel has "knowledge or information regarding the issues raised in Petitioner's Petition for Cancellation" should come as no surprise to RL. Pet.'s Ex. 1 at 24. Similarly, RR's counsel possesses knowledge regarding its Answer to the Petition.

RL asserts it is seeking the identification of "persons with knowledge of the claims or defenses in the present cancellation proceeding and a summary of each such person's knowledge." Pet.'s Ex. 2 at 8. The claims and defenses and knowledge regarding them are possessed by certain individuals at RR's as RR's counsel related this information to them. This portion of the interrogatory is but another attempt to invade the province of the attorney client relationship protected by privilege.

For these reasons, the Board should deny RL's motion to compel a further response to Interrogatory No. 25.

**i) <u>Interrogatory No. 27</u>**

The response to this interrogatory by RR that evidence of use may be found in documents

[4] RR realizes this case and others may not be citable as precedent of the TTAB, but presents these cases for their informative purposes.

pursuant to Federal Rule of Civil Procedure is proper. RR provided documents evidencing continuous use of the RHINO RACK mark between January 1, 2000 and the present by providing invoices from this period. Ormé Decl., ¶ F. As with RL's unfounded complaint regarding the dealers identified by RR, RL's motion to compel further responses appears to be based upon RL's displeasure in learning that RR intended to and did continuously used the mark during the period in question. *See* 15 U.S.C. § 1127 (defining presumption of "abandonment" from "[n]onuse for 3 consecutive years"). Because RR provided a responsive answer, the Board should deny RL's motion to compel a further response to Interrogatory No. 27.

**j) <u>Interrogatory Nos. 28-35</u>**

RL continues its pattern of seeking a motion to compel without any legitimate basis by failing to provide any argument in support of further responses to these interrogatories. *See supra*, n.2. Failure to provide any support in its motion to compel requires denial of this motion. Further, "[a]ny such deficiencies in [respondent's] discovery responses should have been addressed by the timely filing of a properly-supported motion to compel discovery." *Chianti Ruffino Esportazione Vinicola Toscana S.p.A. v. Colli Spolenti Spoletoducale SCRL*, 59 USPQ 2d 1383, 1383 (TTAB 2001). Here, RL failed to address these issues and like the motion to compel in *Chianti*, RL's motion should be denied.

RL states that its Exhibit 2 contains further details regarding the deficiencies, but as noted earlier this Exhibit is filled with conclusory statements such as "Rapid Rack has refused to provide any response at all." Pet.'s Ex. 2 at 9. Without any support or argument, RL merely states in its motion that RR failed to provide answers and no basis exists for its objections. Pet.'s Mot. at 5 ¶ (i). Such conclusory statements fail to provide either this Board or RR with the basis for RL's motion and prevent RR from providing any meaningful responses.

For these reasons, the Board should deny RL's motion to compel further responses to Interrogatory Nos. 28-35.

**2. Respondent Provided Requested Documents and Things**

RR provided over 571 pages of documents responsive to RL's requests for production. This production by RR shows RR's continuous use of the RHINO RACK mark from the period that RL states the RR did not use the mark.

RL makes much of the fact that a RR database became damaged in a flood that occurred at RR's facilities. In response to RL's demand that RR produce and allow inspection of the computer holding the database, RR properly responded that it would allow a third party of RL's choosing and operating under a protective order, to inspect the database at RL's costs. *See* Fed. R. Civ. Proc. 26(b)(2)(B) ("A party need not provide discovery of electronically stored information from sources that the party identifies as not reasonably accessible because of undue burden or costs.") On numerous occasions, RR's counsel communicated to RL's counsel the undue burden and costs associated with any attempt to determine if any information stored in the database could be recovered. Further, as RR's counsel indicated to RL's counsel, the computer holding the database may also contain attorney client privilege and attorney work product materials. Thus, RR's response is proper.

"A party cannot be compelled to produce a document that it does not have." *Re/Max Int'l, Inv. v. Gurley*, 2001 WL 422988 (TTAB 2001). RR provided documents to the extent such documents exist that are responsive to RL's requests. "The party that brings the motion to compel has the burden of establishing that the non-movant has control of the requested documents." *Id.* RL has not met its burden of showing that the documents it seeks are in the control of RR. Indeed, RR produced all documents RR reasonably believed are responsive to

RL's requests. If RL believes other documents exist, it must provided a basis for such a belief and not just move for additional discovery on an unfounded argument.

Because RL's motion fails to follow any particular order with respect to the Requests for Production, RR responds in the same order as presented by RL to ease the burden on the Board.

**a) Requests for Production Nos. 1-17 and 25-38**

RL's motion to compel contains a blanket argument regarding Requests for Production Nos. 1-17 and 25-38. RL contends that RR improperly responded when it stated that documents "will be produced." Given RL responded to these requests on June 24, 2008 and provided documents under separate cover on June 24, 2008 and August 14, 2008, the responses reflects RL's actions apart from providing written responses to RL's request for production. Further, RL properly objected to these requests to the extent the requests sought non-relevant and privileged documents. Contrary to RL's assertion, RR can independently assert an objection based upon relevance as non-relevant documents and documents not likely to lead to the discovery of admissible evidence are beyond the scope of permissible discovery under Federal Rule of Civil Procedure 26(b). Petitioner's fails to indicate how any relevancy objection by Respondent is improper. For these reasons, the Board should deny RL's motion to compel further responses to Requests for Production Nos. 1-17 and 25-38 based upon this unsupported argument.

**b) Requests for Production Nos. 17-24**

RR properly responded to these requests on several bases. First, each request seeks "[a]ny specimens" without limit and thus moves beyond the allowable scope of discovery under Federal Rule of Civil Procedure 26(b). Second, the request also moves beyond the limits of Rule 26(b) by seeking specimens used "in commerce" without any limitation as to what extent or how the requested specimen is used "in commerce." Finally, the request calls for an unknown legal

conclusion regarding "self-authenticating" with respect to a specimen. Federal Rule of Evidence 902 provides the basis for what constitutes self-authenticating *documents*, but contains no guidance regarding what constitutes a self-authenticating *specimen* as requested by RL. For these reasons, the Board should deny RL's motion to compel further responses to Requests for Production Nos. 17-24 based on RL's unsupported arguments.

**c) Requests for Production Nos. 25-32**

RL's counsel admitted in its July 11, 2008 letter to RR's counsel "that Rapid Rack has produced . . . documents for the requested time period." Pet.'s Ex. 2 at 10. RL's complaint appears to be the number of documents produced by RR. In response to these requests, RR indicated the 2004 flood could have destroyed some other potentially responsive material. That RR could not identify the specific material is not great mystery given a change in RR's management since the time of the flood. If RL seeks to determine the extent of current management's knowledge, nothing prevented it from deposing individuals identified by RR in its interrogatory responses. RL cannot now complain that RR did not provide documents or information regarding the flood damage when RL failed to seek that information earlier. For these reasons, the Board should deny RL's motion to compel further responses to Requests for Production Nos. 25-32.

**d) Request for Production No. 34**

RL complains for the first time regarding RR's response to this request. Contrary to RL's statement in its motion that "the foregoing requests for production are set forth in more detail in pages 10-11 of the July 11, 2008 letter," nothing in that letter refers to RL's new found objection to RR's response to this request. RL failed to conduct a good faith effort to resolve this dispute as required by Trademark Rule 2.120(e). Nevertheless, RR responds that it responded properly

by noting that some documents may have been destroyed in the 2004 flood. Given the change in management since the flood, RR could not provided a definitive answer without any knowledge of whether documents had or had not been destroyed. RL's inaction with respect to determining who in the prior management might have knowledge regarding documents destroyed in the flood does not provide a proper basis for requesting further responses for the first time in a motion to compel. For these reasons, the Board should deny RL's motion to compel further responses to Request for Production No. 34.

**e) Request for Production No. 36**

RL's complaint regarding RR's response appears to indicate that again, RL did not review the documents produced by RR. These documents include invoices showing the "geographic extent to which Registrant used its mark." Pet.'s Ex. 2 at 24. RR provided hundreds of pages of invoices that state the location of the customer receiving goods bearing the RHINO RACK mark. Ormé Decl., Ex. F, (RR1-00071-489, RR1-00508-11). RL statement that "it appears that no responsive documents have been produced" combined with the large number of responsive document produced indicates that RL did not have a good faith basis for filing a motion to compel a response to this particular request. For these reasons, the Board should deny RL's motion to compel further responses to Request for Production No. 36.

**f) Request for Production No. 37**

This particular RL request seeks production of documents relating to "items under any other mark than" the RHINO RACK mark. RR properly objected under Federal Rule of Civil Procedure 26(b) on that the request lacked relevancy because the documents requested are not relevant and not likely to lead to admissible evidence regarding to RR's use of the RHINO RACK mark on the goods contained in the '407 Registration. The current cancellation

proceeding is limited to the RHINO RACK mark shown in RR's '407 Registration and RL's request seeks documents that are in no way related to this mark or cancellation proceeding. "While the expression 'fishing expedition' has been generally denigrated as a reason for objecting to discovery, in some situations, such as the one at hand, it remains apt. *Hancock Indus. v. Schaeffer*, 619 F.Supp. 322, 331 (E.D. Pa. 1985); *see also, Milazzo v. Sentry Ins.*, 856 F.2d 321, 322 (1st Cir. 1988); *Paul Kadair, Inc. v. Sony Corp.*, 694 F.2d 1017, 1032 (5th Cir. 1983)." *Micro Motion, Inc. v. Kane Steel Co., Inc.*, 894 F.2d 1318, 1327 (Fed. Cir. 1990) (denying third party discovery regarding the same technology, but not relevant to the current case). As in *Micro Motion*, RL is seeking discovery not relevant to RR's use of the RHINO RACK mark, *i.e.*, the very basis of RL's Petition for Cancellation. RL "may not engage in merely speculative inquiries in the guise of relevant discovery" under Federal Rule of Civil Procedure 26. *Id.* at 1328. For these reasons, the Board should deny RL's motion to compel further responses to Request for Production No. 37.

**g) <u>Request for Production No. 38</u>**

RL's makes much of the fact that no documents have been produced regarding an alleged discontinuance of an alleged mark "RINO RACK." The document referencing "RINO RACK" appears to be nothing more than an abbreviation in a limited electronic field of a financial statement, but the financial documents contains information about part numbers identified by RR in its response to Interrogatory No. 1 that use the RHINO RACK mark. RR searched and did not find any documents responsive to this request and thus could not provide any responsive documents because as noted earlier, RR never discontinued the use of the RHINO RACK mark. For these reasons, the Board should deny RL's motion to compel further responses to Request for Production No. 38.

**h) Request for Production No. 39**

Given RR's new management, this request for all documents associated with a filing occurring before the new management arrived is both unduly burdensome and harassing. Requiring RR to search through decades of records for any documents responsive to this request is unduly burdensome because RR already provided evidence of continuous use of the RHINO RACK mark with invoices from the relevant time period as noted earlier. Further, a brief review of the publicly available "Combined Declaration of Use in Commerce & Application for Renewal of Trademark Registration," file April 2, 2002, clearly indicates at that time a person by the name of Ray Lawson held the titled of President of RR and the counsel for RR at that time as Han Yu. RL could avoid the undue burden and harassment of RR by seeking discovery from these third parties. For these reasons, the Board should deny RL's motion to compel further responses to Request for Production No. 39.

**i) Request for Production No. 40**

RR's request is unduly burdensome and harassing to the extent it seeks production of the computer containing the database discussed *supra*. Further, as discussed earlier, this computer may contain material protected by the attorney client and attorney work product privileges.

**3. Respondent Properly Replied to Requests for Admissions**

Although RL would have the Board believe otherwise, RR properly responded to RL's requests for admissions based upon a reasonable understanding and its motion to deem such requests for admissions admitted is without merit. "A matter is admitted unless . . . the party to whom the request is directed serves on the requesting party a written answer ***or*** objection addressed to the matter." Fed. R. Civ. P. 36(a)(3) (emphasis added). Similarly, the Board allows the responding party to provide "an answer or objection to each matter of which an admission is

requested." Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 407.03(b). Further, "[i]f objection is made; the reasons therefore shall be stated," and "[t]he answer shall specifically deny the matter or set forth in detail the reasons why the answering party cannot truthfully admit or deny the matter." Thus, a respondent complies "with Federal Rule 36(a) by objecting to the requests on the ground of ambiguity and setting forth a denial." *Jet, Inc. v. Sewage Aeration Sys.*, 2003 WL 355736 (TTAB 2003).

RL's requests for admission are also unduly burdensome and harassing. RL served nearly one hundred requests for admissions on RR. "[R]equests to admit may be so voluminous and so framed that the answering party finds the task of identifying what is in dispute and what is not truly burdensome." Fed. R. Civ. P. 36 Advis. Comm. Notes 1970. Such is the case here.

RR denied many of RL's requests for admissions based upon ambiguity and therefore such denials are proper. The Board "will not substitute our judgment for respondent's judgment regarding the meaning of the terms." *Jet, Inc.*, 2003 WL 35736. That RL chose not to clarify those terms does not allow it to now seek admission of those requests. If the Board deems the requests admitted, such admission will "cause unfair surprise" to RR. Fed. R. Civ. P. 36 Advis. Comm. Notes 1970.

Here, where RL's has inundated RR with nearly one hundred vague and ambiguous request for admission, the Board should "permit withdrawal or amendment of the admissions if the presentation of the merits of the proceeding will be subserved thereby, and the propounding party fails to satisfy the Board that withdrawal or amendment will prejudice said party in maintaining its action or defense on the merits." *CBI Distributing Corp. v. R. Neal Ferguson and L. Jean Ferguson*, 2006 WL 1580936 (TTAB 2006). RL failed to indicate why it would be prejudiced by allowing RL to withdraw or amend its admissions. Given the parties are now

involved in a civil action before the United States District Court for the Central District of California regarding RR's '407 Registration, RL will suffer no prejudice. Thus, the Board should require RL to provide unambiguous requests that would allow RR to provide an amended answer or strike RL's requests entirely.

**a) Requests for Admissions 4, 9, 14, 19, 24, 29 and 34**

As contemplated by the Federal Rules and the TBMP, "[a]n answering party may not give lack information or knowledge as a reason for failure to admit or deny ***unless*** the party states that the party made a reasonable inquiry and that the information known or readily obtainable by the party is insufficient to enable the party to admit or deny." TBMP § 407.03(b) (quoting Fed. R. Civ. P. 36(a)). Rule 36 "requires only that the answering party make a reasonable inquiry and secure such knowledge and information as are readily obtainable by him." Fed. R. Civ. P. 36 Advis. Comm. Notes (1970). Further, "Rule 36 requires only that the party state that he has taken such steps." *Id.* RR's responses meet these requirements and therefore RR properly denied these requests.

**b) Requests for Admissions 5, 10, 15, 20, 25, 30, 35, and 40**

Both the Federal Rule and the TBMP provide "[i]f the responding party objects to a request for admission, the reasons for objection must be stated." TBMP § 407.03(b) (citing Fed. R. Civ. P. 36(a)). RR provided RL with its objections and the reasons therefore, but RL chose not to overcome those objections with persuasive arguments or case law to overcome RR's objections. Thus, RR properly denied each request for admissions.

**c) Requests for Admissions 36-72, 74-80, 82-84 and 88-89**

RL's motion telling fails to discuss in any detail the numerous ambiguities contained in these requests for admissions and to which RR objected. Especially troubling is RL's claim that

"Rhino Linings' requests for admission explained that the definitions in its interrogatories also applied to its requests for admissions." Pet.'s Mot. at 8. In fact, RL's requests for admissions contain no such language. Ormé Decl., Ex. G. RL's own requests for admissions do not indicate any definitions apply to RL's vague and ambiguous language. Therefore, RR properly denied these requests based upon the vague and ambiguous terms RL decided to use.

**d) Requests for Admission Nos. 90-91**

RL attempts to seek admissions regarding information solely within RL's own control and of which RR lacks any knowledge. Requesting RR to admit to RL's statements when RR lacks any knowledge regarding RL's use of its undefined marks and possible damage suffered by RL goes beyond the pale. Further, RR objected based upon vague and ambiguous language contained in both of these requests. For these reasons, RR properly denied each of these requests according to Federal Rule of Civil Procedure 36(a).

**4. Rapid Rack Never Claimed Privilege**

RL's complains that RR failed to answer discovery requests based upon information protected by the attorney-client or attorney work product privileges and also refused to produce a privilege log. RL misreads RR responses, however, because RR never claimed such information or documents existed, but objected to the discovery requests to the extent such requests sought such information.

**B. Sanctions Are Not Warranted Where Respondent Properly Responded**

Sanctions will not stand where the moving party fails to provide any basis for such sanctions.

Petitioner's request for sanctions in the form of striking respondent's Answer and entry of default are not warranted. Petitioner's alternative request is nothing more than the first request cloaked in different terms because the conclusion would be the same - default judgment for the petitioner. "[D]efault judgment is a harsh remedy which would be justified where no less drastic

remedy would be effective and where there is a strong showing of willful evasion." *Agritalia S.R.L. v. Tosca, Ltd.*, 2001 WL 1002158 (TTAB 2001). Such is not the case here. As detailed above, respondent provided good faith responses and objections and met and conferred with petitioner. Petitioner's request for terminating sanctions are nothing more than an attempt to avoid the only conclusion possible that Respondent continuously used the RHINO RACK mark thereby preventing Petitioner from reviving its rejected applications.

As noted earlier, Respondent's counsel met its obligations under Trademark Rule 2.120(e) by conferring in good faith on multiple occasions with Petitioner's counsel. That Petitioner disagreed with Respondent does not mean a failure to meet and confer. Thus, Petitioner provides no basis for sanctions.

### C. Petitioner Lacks a Basis for Additional Discovery

Petitioner seeks an extension of discovery ostensibly to "be fully prepared to take the Rule 30(b)(6) deposition of Rapid Rack." What petitioner fails to mention, however, is that the Rule 30(b)(6) deposition will occur on Friday September 26. Thus, no extension of discovery is warranted.

## IV. CONCLUSION

Given the Respondent's complete answers and good faith in responding to Petitioner's vague and overreaching discovery requests along with Petitioner's inappropriate seeking to take an additional Rule 30(b)(6) deposition, Petitioner's motion to compel additional discovery responses should be denied. Similarly, Petitioner's motion to deem requests for admissions admitted should be denied based upon the vagueness of the nearly one hundred requests presented. Respondent's good faith efforts to resolve these disputes in light of counsel for Petitioner's erratic, unreasonable and contradictory actions sanctions are not warranted. Sanctions may be appropriate, however, against Petitioner for its failure to notify the Board that it noticed a Rule 30(b)(6) deposition before filing its current motions. Because Petitioner

attempted to mislead the Board regarding the Rule 30(b)(6) deposition and Respondent already offered up a witness to comply with that deposition, discovery should not be extended.

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

Date 10-6-08

By _____

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## CERTIFICATE OF TRANSMISSION AND SERVICE

I certify that on October 7, 2008, the foregoing **RESPONDENT'S OPPOSITION TO PETITIONER'S AMENDED MOTION TO COMPEL DISCOVERY RESPONSES, MOTION TO DEEM REQUESTS FOR ADMISSIONS ADMITTED AND MOTION FOR SANCTIONS; AND RESPONDENT'S OPPOSITION TO PETITIONER'S MOTION TO EXTEND THE DISCOVERY DEADLINE TO ALLOW PETITIONER TO CONDUCT FOLLOW-UP DISCOVERY** is being electronically filed with:

Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

It is further certified that on October 7, 2008, the foregoing **RESPONDENT'S OPPOSITION TO PETITIONER'S AMENDED MOTION TO COMPEL DISCOVERY RESPONSES, MOTION TO DEEM REQUESTS FOR ADMISSIONS ADMITTED AND MOTION FOR SANCTIONS; AND RESPONDENT'S OPPOSITION TO PETITIONER'S MOTION TO EXTEND THE DISCOVERY DEADLINE TO ALLOW PETITIONER TO CONDUCT FOLLOW-UP DISCOVERY** is being served by mailing a copy thereof by first-class mail addressed to:

David A. Harlow
Nelson, Mullins Riley & Scarborough LLP
4140 Parklake Avenue
GlenLake One, Suite 200
Raleigh, NC 27612

By: Joyce Reese
Joyce Reese

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