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

Proceeding	92048480
Party	Plaintiff Sinbad Grand Cafe, LLC
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Attachments	Petitioner's Reply to Respondent's Opposition.pdf (8 pages)(502414 bytes)

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

*In the matter of Registration No. 2782619
Issued on November 11, 2003*

SINBAD GRAND CAFÉ, LLC.

Petitioner,

v.

AL-FAKHER FOR TABACCO
TRADING & AGENCIES CO. LTD.

Respondent.

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) **Cancellation No. 92048480**

)
) **Assigned for All Purposes to the United**
) **States Patent and Trademark Office**
) **Trademark Trial and Appeal Board**

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) **PETITIONER SINBAD GRAND**
) **CAFÉ'S REPLY TO RESPONDENT'S**
) **OPPOSITION TO PETITIONER'S**
) **MOTION TO COMPEL**

) **Petition Filed:** November 21, 2007
) **Discovery Period Closes:** October 28, 2008
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INTRODUCTION

Registrant Al-Fakher For Tobacco Trading & Agencies, Co., LTD., (“Registrant” or “Al-Fakher for Tobacco”) has filed an inadequate Opposition (“Opposition”) to Petitioner’s Motion to Compel Responses (“Motion” or “Motion to Compel”) to Petitioner’s First Set of Requests for Production of Documents and Things (“RFD”). Although Registrant has made an effort to respond by filing its Supplemental Responses and producing some documents, Registrant continues to frustrate the discovery process by requesting further extensions without specifying a time for production to produce remaining documents that have been the subject of discovery from last few months. Additionally, several of Registrant’s Supplemental Responses fail to respond to Petitioner’s RFD and are still deficient.

It is interesting to note that after five months of meet and confer efforts and the Motion to Compel RFD, Registrant has barely produced 400 documents. In light of the fact that the stipulated date for the closing of discovery is October 28, 2008, Registrant's behavior continues to prevent Petitioner from conducting depositions and using the limited discovery period in a productive manner.

Therefore, Petitioner's Motion to Compel should be granted and the Trademark Trial and Appeals Board ("TTAB" or "Board") should set a specific deadline for production of responsive documents.

ARGUMENT

I. REGISTRANT'S ARGUMENT THAT PETITIONER'S MOTION HAS NO MERIT BECAUSE RESPONDENT HAS WITHDRAWN ITS OBJECTIONS AND PROVIDED SUPPLEMENTAL RESPONSES IS INVALID.

Registrant conveniently withdraws its objections after Petitioner has expended significant efforts and resources in order to compel Registrant's supplemental responses. Registrant argues that Petitioner's Motion is moot, yet fails to acknowledge that it is Petitioner's Motion that forced Registrant to alter its behavior and comply with the TTAB's procedures. Since Registrant only made an effort to comply with discovery requests after Petitioner filed its Motion, it is evident that Petitioner is unable to resolve these discovery issues without the TTAB's intervention. Now since the Motion is with the Board for disposition, Petitioner respectfully requests the Board to address all the issues raised in the Motion and in this Reply and set some clear guidelines by which Registrant is forced to comply. Registrant's argument that the Motion is moot has no merit.

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II. ALTHOUGH REGISTRANT WITHDRAWS HIS OBJECTIONS AND REQUESTS ADDITIONAL TIME TO RESPOND TO THE RFD, THE TTAB MUST SET DEADLINES BY WHICH REGISTRANT SHALL PRODUCE THE REQUESTED DOCUMENTS IN ORDER TO ALLOW REGISTRANT TO COMPLETE THE DISCOVERY PROCESS.

Registrant assures Petitioner that it has provided supplemental documents, as requested, and has abandoned its objections to those requests. Petitioner acknowledges that the withdrawal of objections by the Registrant is a good start and is in the right direction. However, even though Registrant has made an effort to comply with Petitioner's request, Registrant continues to seek vague extensions and avoid deadlines in the hope to delay the discovery and increase the cost of litigation. This must not be tolerated.

Registrant, in its responses to Petitioner's RFD Nos. 24, 25, 27, 29, 30, 31, 41, 43, 45, 46, 47, 49 and 50, asserts that it "is in the process of securing documents in the UAE, and due to the extremely laborious task of gathering these documents, requests additional time to provide these documents." These requests have been pending for the last several months. Registrant has had more than sufficient time to obtain these documents but has failed to do so. Although Registrant requests additional time, Registrant fails to state how much additional time it needs to complete its task. There cannot be unlimited extension in view of the upcoming discovery deadline. The amount of time Registrant has already spent in performing this "extremely laborious task" of securing documents, and its continuous delays are prejudicing Petitioner.

For example, RFD No. 29 requests documents relating to the sale of Registrant's products bearing the Trademark within the United States from 2001 to the present, "including purchase orders, wire transfers, invoices, receipts, contracts, agreements and/or sales summaries." Since the Tobacco business is highly regulated and those involved in the business must keep sufficient business records for tax and other regulatory purposes, the records requested

by RFD No. 29, such as wire transfers and invoices, must be readily available and should not be extremely difficult to obtain.

As Registrant is well aware, discovery closes on October 28, 2008 and the parties only have about four months to complete the discovery process.¹ Therefore, Petitioner respectfully requests that the Board set deadlines by which Registrant is required to produce all documents which are responsive to Petitioner's RFD.

III. ALTHOUGH REGISTRANT HAS PRODUCED SOME RESPONSIVE DOCUMENTS, ITS RESPONSE IS STILL DEFICIENT BECAUSE REGISTRANT HAS FAILED TO PRODUCE ALL RELEVANT DOCUMENTS.

A. Registrant has failed to produce all Documents which depict Registrant's use of the Trademark in connection with any products offered for sale or sold in the United States by Registrant.

Petitioner's RFD No. 4 asks Registrant to produce all documents relating to Registrant's use of the Trademark in connection with any products offered for sale or sold in the United States by Registrant. In response to RFD No. 4, Registrant produces invoices and purchase orders between Sierra Network and various distributors for the years 2006, 2007 and 2008. Although these documents cover the period of ownership for Al-Fakher for Tobacco, the definition of "Registrant," as provided in Petitioner's RFD, defines "Registrant" to mean "Al-Fakher for Tobacco Trading & Agencies Co. Ltd. and its . . . predecessors or successors-in-interest." Therefore, Registrant must produce documents relating to the use of the Trademark in connection with products sold in the United States by its predecessors, even though Al-Fakher for Tobacco acquired ownership of the Trademark in 2006. If Registrant has no responsive documents for the remaining period, Registrant must state so. In addition, since Petitioner seeks

¹ Due to the significant delays in discovery, Petitioner may be forced to seek an extension of the discovery closing date from the TTAB in order to complete discovery.

to cancel Registrant's Trademark on various grounds, including abandonment through non-use, Petitioner is entitled to these documents in order to support its allegation that Registrant abandoned its rights in the Trademark between 2004 and 2005 or even sooner than that.

Furthermore, in Registrant's own supplemental responses to SI Nos. 5 and 6,² it admits, under oath, that "Registrant's business relevant to the Trademark commenced January 10, 1995 in the Middle East and in the United States." Therefore, by Registrant's own admission, Registrant must produce documents which depict its use of the Trademark in connection with any products offered for sale or sold in the United States dating as far back as 1995.

If the TTAB concludes that 1995 is not the relevant date for which documents may be sought, since Registrant claimed January 15, 2001 as the date when the Trademark was first used in commerce in the United States, Petitioner is entitled to invoices and purchase orders relating to the Trademark in connection with any products offered for sale or sold in the United States by Registrant at least as of January 15, 2001.

For example, Registrant states that it has produced all non-privileged, non-work product documents responsive to RFD No. 4 that are within its possession, control and/or custody but has failed to state that Registrant is not in possession, custody or control of responsive documents for the years prior to 2006. At the same time, Registrant has not indicated that it will produce further responsive documents for the years prior to 2006. Therefore, Registrant's response as well as production of documents is deficient. Registrant must be compelled to supplement its responses and document production further.

² A simultaneous Motion to Compel SI has been filed and is currently under review by the TTAB. Petitioner respectfully directs the TTAB's attention to Petitioner's Motion to Compel SI which clearly demonstrates Registrant's blatant disregard for TTAB rules and procedures.

B. Registrant has failed to produce Documents which identify each product which is used or is intended to be used by Registrants in which the Trademark appears or will appears.

RFD Nos. 8-12, 16 and 17 generally request documents which depict or illustrate any marking by Registrant of the Trademark in connection with any advertising or promotion, and intended advertising or promotion of any products. In response to RFD Nos 8-12, 16 and 17, Registrant produces a CD containing photographs of advertising and promotional materials containing and depicting the Trademark and a promotional brochure for Al-Fakher Molasses Tobacco which depicts the marking by Registrant of the Trademark “in connection with any advertising, intended advertising, promotion or intended promotion of any product,” depicting at most thirty products (See Respondent’s Supplemental Responses). Nonetheless, in SI No. 7, Registrant lists at least 80 goods and/or services on or in connection with which Registrant currently uses, intends to use or has used the Trademark with or without any design element or in a stylized format of any sort.” (See Petitioner’s Special Interrogatories). It appears that Registrant is being untruthful in the response and is simply withholding hundreds of documents that are in its possession that are responsive to this request.

Thus, Registrant’s response and production are deficient and Registrant must be compelled to supplement its responses and document production.

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IV. CONCLUSION

Based on the foregoing, Petitioner respectfully requests the Board to grant its Motion, set a specific deadline to produce responsive documents and issue appropriate sanctions that the Board deems it proper.

Dated: June 27, 2008

Respectfully Submitted,
THE PATEL LAW FIRM, P.C.

By: 

Natu J. Patel
Attorney for Petitioner
Sinbad Grand Cafe, LLC

CERTIFICATE OF SERVICE

It is hereby certified that a true and correct copy of the foregoing PETITIONER SINBAD GRAND CAFÉ'S REPLY TO REGISTRANT'S OPPOSITION TO PETITIONER'S MOTION TO COMPEL was served by First-Class mail and electronic mail, upon attorneys for Respondent, this 27th day of June, 2008 as follows:

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