

ESTTA Tracking number: **ESTTA598353**

Filing date: **04/14/2014**

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

Proceeding	92048732
Party	Plaintiff Altwater Gessler - J.A. Baczewski International (USA) Inc. and Altwater Gessler - J.A. Baczewski GmbH
Correspondence Address	PETER S SLOANE LEASON ELLIS LLP ONE BARKER AVE, FIFTH FL WHITE PLAINS, NY 10601 UNITED STATES sloane@leasonellis.com, reuber@leasonellis.com, tmdocket@leasonellis.com
Submission	Opposition/Response to Motion
Filer's Name	Peter S. Sloane
Filer's e-mail	sloane@leasonellis.com, reuber@leasonellis.com, tmdocket@leasonellis.com
Signature	/peter sloane/
Date	04/14/2014
Attachments	2014-04-14 Petitioner's Opposition to Motion to Re-open Discovery.pdf(131552 bytes)

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

In the Matter of Registration No. 2,731,948

-----X	:	
ALTVATER GESSLER – J.A. BACZEWSKI	:	
INTERNATIONAL (USA) INC. and ALTVATER	:	
GESSLER – J.A. BACZEWSKI LIKÖRERZEUGUNG	:	
GESELLSCHAFT M.B.H. d/b/a	:	
ALTVATER GESSLER – J.A. BACZEWSKI GMBH,	:	
	:	
Petitioners,	:	Cancellation No. 92048732
	:	
v.	:	
	:	
RONALD BECKENFELD,	:	
	:	
Respondent.	:	
-----X	:	

**PETITIONERS’ OPPOSITION TO RESPONDENT’S
MOTION TO RE-OPEN DISCOVERY**

Petitioners, by their undersigned attorneys, hereby oppose Respondent’s last minute motion to re-open the discovery period to take discovery on Petitioner’s Second Amended Petition for Cancellation (“Respondent’s Motion”). No further discovery is needed as Respondent already has the information sought. Furthermore, Respondent already has had a full and fair opportunity to take discovery as the amended claims fell within the scope of the original claims and the individuals likely to have discoverable information were properly identified at the outset of the case. Further delay of trial risks prejudicing Petitioners as witnesses grow older and memories fade.

STATEMENT OF FACTS

Petitioners filed the Petition for Cancellation on January 14, 2008. After various extensions of time, Respondent filed his answer on March 27, 2008. The parties subsequently engaged in discovery and intermittent settlement talks over the next several years.

The discovery period closed on or about February 3, 2013. Thereafter, on March 18, 2013, Respondent moved for summary judgment. Petitioners opposed same and, on May 31, 2013, Petitioners moved to amend the Petition for Cancellation to amplify and clarify the original claims, and to include additional claims conforming with the discovery obtained in the proceeding.

The Board denied Respondent's summary judgment motion by decision dated September 27, 2013. In denying summary judgment, the Board stated that it did not consider the motion to amend and that Petitioners were free to refile it.

On January 9, 2014, Petitioners filed a second motion to amend the Petition for Cancellation. Respondent opposed the motion. By decision dated December 20, 2013 (the "December 20th Decision"), the Board granted the motion to amend, except for the claim of abandonment due to naked licensing, on the ground that it was improperly pled. The Board provided Petitioners with twenty days to file an amended petition which properly asserted a claim of naked licensing.

Petitioners filed a Second Amended Petition for Cancellation on January 9, 2014 (the "Second Amended Petition"). Respondent answered on February 10, 2014.

On December 6, 2013, Petitioners filed a motion to compel Respondent to produce documents in response to Petitioners' third set of document requests. Respondent opposed the motion, which motion the Board denied by decision dated February 24, 2014. In denying the motion to compel, the Board provided Petitioners with the opportunity to modify their requests for production.

Counsel for Petitioners attempted to work with counsel for Respondent to obtain the documents sought without the need to serve modified document requests. Declaration of Peter S. Sloane (the "Sloane Dec.") at ¶¶ 2-3. With no progress made, Petitioners served modified document requests on March 14, 2014 (the "Modified Document Requests"). *Id.* at ¶ 4, Ex. A. Respondent has not yet served his responses. *Id.*

The decision of the Board on the motion to compel also resumed proceedings and reset the dates. Under the reset dates, Petitioners had until March 23, 2014 to serve their pretrial disclosures. The close of Petitioners' thirty-day trial period was also set for May 7, 2014 (opening on April 7, 2014). Petitioners timely served their pretrial disclosures on March 24, 2014 (March 23rd was a Sunday). Sloane Dec. at ¶ 4.

On April 4, 2014, Petitioners filed a motion to extend trial dates with the consent of Respondent. The motion stated that good cause exists for the requested extension of time as it would be prejudicial for trial to commence before all discovery disputes have been resolved. The motion to extend remains pending.

ARGUMENT

Respondent asks the Board to re-open discovery for a period of not less than 90 days so as to permit him to take unfettered discovery on the "allegations, claims and legal theories" asserted in the Second Amended Petition. Respondent's Motion at pp. 1 and 7. The request is wholly unwarranted.

The Board has already ruled that "petitioner's additional allegations of fraud, abandonment by naked licensing, and the additional allegations in its already-asserted claims regarding ownership involve information in respondent's control." December 20th Decision at p. 5 (emphasis added). Consequently, Respondent already has the information sought and there is no need to re-open discovery. Indeed, apart from the information in Respondent's control, the Board found that the additional claims of fraud and allegations regarding ownership were included in the original filing, "as noted by Respondent" himself. December 20th Decision at p. 6. In other words, Respondent has long known about the allegations at issue.

Respondent claims that "Petitioners have now made it known that they intend to introduce into evidence during their trial testimony period the testimony of Leonie Gessler." Respondent's Motion

at p. 4. However, Petitioners identified Leonie Gessler in their Initial Disclosures way back in 2008. Sloane Dec. at ¶ 5, Ex. B. Respondent failed to take any discovery of Mrs. Gessler during the discovery period. He cannot now complain that he did not have the opportunity to depose her when he was informed that she was someone with knowledge of Petitioners' ownership of the mark in dispute as far back as six years ago. *Luster Products, Inc. v. John M. Van Zandt d/b/a Vanza USA*, 104 USPQ2d 1877 (TTAB 2012)(denying motion to reopen discovery and finding no excusable neglect where applicant made a calculated decision not to take discovery).

Indeed, despite Respondent's conclusory allegation to the contrary, further delay risks prejudicing Petitioners. See T.B.M.P. §509.01(b)(1)(stating prejudice may result where movant's delay results in a loss or unavailability of evidence or witnesses which otherwise would have been available to non-movant). Mrs. Gessler is now 82 years old and other witnesses are reaching advanced age as well. Sloane Dec. at ¶ 7. No good reason exists to further protract these proceedings.

CONCLUSION

For the above reasons, Petitioners respectfully request that the Board deny Respondent's motion to re-open discovery and reset the trial dates from at least 30 days after Respondent serves his responses to the Modified Document Requests and produces all responsive documents and things.

Date: April 14, 2014
White Plains, New York

Respectfully submitted,



Peter S. Sloane
Cameron S. Reuber

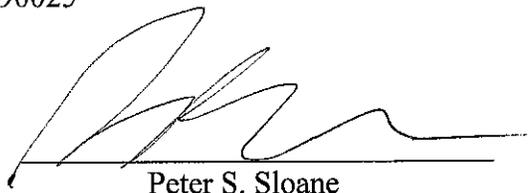
LEASON ELLIS LLP
One Barker Avenue, Fifth Floor
White Plains, New York 10601
Tel.: (914) 288-0022

Attorneys for Petitioners

CERTIFICATE OF SERVICE

It is hereby certified that a true and correct copy of the foregoing **PETITIONERS' OPPOSITION TO RESPONDENT'S MOTION TO RE-OPEN DISCOVERY** was served by First-Class mail, postage prepaid, upon the attorney for Respondent, this 14th day of April, 2014, addressed as follows:

Michael L. Lovitz, Esq.
Bowen Hayes & Kreisberg
10350 Santa Monica Blvd., Ste. 350
Los Angeles, California 90025



Peter S. Sloane