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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
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Submission	Motion to Compel Discovery
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Date	12/06/2013
Attachments	Motion to Compel - NON-CONFIDENTIAL.pdf(30556 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

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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’ MOTION TO COMPEL
RESPONDENT’S RESPONSES TO PETITIONERS’ THIRD SET
OF REQUESTS FOR THE PRODUCTION OF DOCUMENTS AND THINGS**

Petitioners, in accordance with Rule 523 of the Trademark Trial and Appeal Board Manual of Procedure (“TBMP”), 37 CFR § 2.120(e), submit this motion for an order compelling Respondent, Ronald Beckenfeld (“Respondent” or “Ronald Beckenfeld”) to produce documents in response to Petitioners’ Third Set Of Requests for the Production of Documents and Things, which were served on February 4, 2013 (“Document Requests”), a copy of which is annexed hereto to the Declaration of Peter S. Sloane (“Sloane Dec.”) as **Exhibit A**.

I. PRELIMINARY STATEMENT

Respondent claims ownership of the registration in dispute for the trademark MONOPOLOWA for vodka based on an assignment of rights from his father, Mickey Beckenfeld, transferred through an *inter vivos* trust. Yet, despite the mark purportedly being the *only* non-cash asset subject to said transfer, Respondent has outright refused to produce any of the trust documents demonstrating a clear chain of title and documented transfer, despite being timely served with Discovery Requests specifically targeting these materials.

Counsel for Petitioners has made good faith efforts, including by e-mail and telephone, to resolve this discovery dispute with Respondent without motion practice. *See* Sloane Dec. at Ex. C. Ultimately, on November 22, 2013, Respondent, through his counsel, advised that he will not be producing documents pertaining to the trust which are in his possession, custody or control. *Id* at Ex. D. Thus, in accordance with TBMP §§ 523, CFR §2.120(e), Petitioners respectfully request that their Motion to Compel be granted in its entirety.

II. STATEMENT OF FACTS

The relevant facts are set forth in the Petition for Cancellation dated January 14, 2008.¹ However, a recitation of the pertinent facts is repeated below for the Board's convenience.

A. Background on Petitioners

Petitioners have been in the spirits business for generations. One of the brands owned by Petitioners is the mark MONOPOLOWA for vodka. MONOPOLOWA brand vodka is made according to an old family recipe and distilled from high quality special variety potatoes (vodka is now more commonly distilled from grain). Over the years, the product has won numerous awards and medals.

¹ Petitioners' motion to amend the Petition for Cancellation is pending.

B. Petitioners' Relationship with Mutual

In the 1980s, Petitioners began using a dealer in Los Angeles named Mutual Wholesale Liquor Inc. ("Mutual") to distribute their spirits in the U.S. including MONOPOLOWA brand vodka. Without authority from Petitioners, on September 16, 2002, Mutual filed application number 76/449,831 of the mark MONOPOLOWA for vodka with U.S. Patent and Trademark Office. The application issued to registration number 2,731,948 on July 1, 2003 (the "Registration").

On October 4, 2007, Mutual assigned the Registration to Ronald Beckenfeld (the "Assignment"). On January 14, 2008, Petitioners filed the instant cancellation action against Ronald Beckenfeld seeking cancellation of the Registration.

During all relevant times, Mutual was owned by Ronald Beckenfeld's father, Mickey Beckenfeld. At deposition during discovery, Mickey Beckenfeld testified that he gifted his son, Ronald Beckenfeld, with the brand MONOPOLOWA and several millions of dollars in through a trust account. Sloane Dec. at Ex. F at 53:2-4.

REDACTED

See Sloane Dec., Ex. H at 24:24-25.

The Trust appears to hold all assets of Mutual. As Respondent clarified during his testimony, "Everything [went] in the trust." *Id.*, Ex. G at 165:10-11.

REDACTED

Id., Ex. H at 45:8- 46.13; 49:19-

22.

REDACTED

REDACTED

See id.

At the deposition of Ronald Beckenfeld, the undersigned counsel for Petitioners requested that Respondent produce a copy of the trust document and stated that Petitioners would serve written discovery requests seeking same, which Petitioners later did. *See id.*, Ex. A.

C. Respondent's Refusal To Comply with the Discovery Requests

On February 4, 2013, Petitioners propounded the Document Requests upon Respondent. The Document Requests included several requests concerning the Trust. Specifically, the following Requests were served on Respondent:

REQUEST NO. 1

All trust documents referenced in the discovery deposition of Registrant taken on August 4, 2011.

REQUEST NO. 2

All amendments to the trust documents mentioned in the discovery deposition of Registrant taken on August 4, 2011.

REQUEST NO. 3

Documents sufficient to identify each and every past and present trustee of the trusts mentioned in the discovery deposition of Registrant taken on August 4, 2011.

REQUEST NO. 4

All documents referring or relating to the trust documents mentioned in the discovery deposition of Registrant taken on August 4, 2011.

REQUEST NO. 5

All documents of the trusts mentioned in the discovery deposition of Registrant taken on August 4, 2011 referring or relating to the mark MONOPOLOWA.

REQUEST NO. 6

All documents evidencing that the trusts mentioned in the discovery deposition of Registrant taken on August 4, 2011 had the legal authority to transfer the mark MONOPOLOWA from Mutual to Registrant.

REQUEST NO. 7

All legal bills paid by the trusts mentioned in the discovery deposition of Registrant taken on August 4, 2011.

By agreement between the parties, Respondent's responses to the Document Requests were due by March 18, 2013. On the day the responses were due, Respondent moved for summary judgment. The Board denied summary judgment on September 27, 2013.

Respondent did not serve responses to the Document Requests until November 7, 2013. A copy of Respondent's Responses to Petitioners' Third Set of Requests for Production of Documents and Things (the "Responses") are attached to the Sloane Dec. at Ex. B. Respondent objected to the requests concerning the Trusts on the ground of relevancy.

On November 22, 2013, the undersigned attorney for Petitioners held a telephone conference with counsel for Respondent regarding deficiencies in the Responses. During the telephone conversation, counsel for Respondent stated that Respondent would not produce any of the requested documents regarding the Trust. An email confirming the substance of the conference as well as the Respondent's refusal to produce the requested information is attached to the Sloane Dec. at Ex. D.

On November 27, 2013, Respondent produced 73 pages worth of documents in response to the Document Requests. None of the documents related to the Trust.

III. ARGUMENT

Fed. R. Civ. P. 34 and TBMP 408.01 allow a party to serve requests for the production of documents and things upon any other party during the discovery period in an inter partes proceeding before the Board. On February 4, 2013, prior to the close of the discovery period in this matter, Petitioner served discovery requests (Sloane Dec., Ex. A) on Respondent concerning the trust, specifically as it pertained to, *inter alia*, the transfer of the MONOLOLOWA brand at issue. Pursuant to Rules 2.119(c) and 2.120(a) of the Trademark Rules of Practice, as amended by the stipulated consent of the parties, Respondent's responses to those requests were due on March 18, 2013. On the day the responses were due, Respondent moved for summary judgment, which the Board denied on September 27, 2013. Assuming that the commencement of summary judgment proceedings tolled Respondent's time to respond to Petitioner's Third of Set of Requests for Documents and Things, Respondent has since failed to timely respond.

A motion to compel is appropriate where, as here, a party fails to produce information requested pursuant to a timely-served request to produce documents. *See* Fed. R. Civ. P. 37; Rule 2.120(e). Respondent's objections (*i.e.*, relevance) are neither valid, nor proper, nor meritorious.

REDACTED

REDACTED

Obviously, Respondent should not be permitted to withhold this critical, admissible information from discovery on relevance grounds. Indeed, as Petitioner has alleged from the commencement of this action (and Respondent conceded during his deposition), the transfer of the mark between father and son was a sham transaction. *Id.*, Sloane Dec., Ex. H at 45:8- 46.13; 49:19-22.

As the Board has previously stated, “[d]uring discovery, a party may seek not only testimony and exhibits which would be admissible evidence but also information that would be inadmissible at trial if the information appears reasonably calculated to lead to the discovery of admissible evidence.” *Fischer Gesellschaft M.B.H. v. Molnar and Co., Inc.*, 203 USPQ 561, 565 (TTAB 1979) citing Fed.R.Civ.P. 26. Obviously, Petitioner is entitled to discovery as to whether Respondent actually possesses good title to the registration at issue. *See, e.g.*, 37 C.F.R. § 3.73 (Trademark Rule § 3.73(b)); *Tony B. Gelbart, v. ESCOM AG and Tulip Computers International BV*, 2001 WL 1480568 (TTAB 2001). The Trust documents sought by Petitioner are not subject

to any valid objections as they undisputedly concern Respondent's good title to the mark at issue. Accordingly, the Board should compel production of same to Petitioner.

IV. STATEMENT OF COMPLIANCE WITH TBMP 523.02 AND RULE 2.120(E)

Pursuant to TBMP 523.02 and Rule 2.120(e), Petitioner made a good faith effort to resolve with Respondent the issues presented in this motion to compel by correspondence and conversations with Respondent's counsel. Copies of correspondence evidencing Petitioner's efforts are attached to the Declaration of Peter Sloane as Exhibits C and D.

V. CONCLUSION

For the reasons set forth above, Petitioners respectfully request that the Board grant the instant motion in all respects and order Respondent to produce documents responsive to those Discovery Requests concerning the Trust. Petitioners further respectfully request that the Board suspend this proceeding pending resolution of this motion pursuant to TBMP 523.01; 37 C.F.R. § 2.120(e)(2).

Date: December 6, 2013
White Plains, New York

Respectfully submitted,



Peter S. Sloane
Cameron S. Reuber

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Attorneys for Petitioners

CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing **PETITIONERS' MOTION TO COMPEL RESPONDENT'S RESPONSES TO PETITIONERS' THIRD SET OF REQUESTS FOR THE PRODUCTION OF DOCUMENTS AND THINGS** was served upon counsel for Respondent, this 6th day of December, 2013, by First-Class mail, postage prepaid, addressed as follows:

Michael L. Lovitz, Esq.
BOWEN HAYES & KREISBERG
10350 Santa Monica Blvd., Ste. 350
Los Angeles, California 90025



Cameron S. Reuber