

ESTTA Tracking number: **ESTTA372770**

Filing date: **10/12/2010**

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

Proceeding	92052150
Party	Defendant Patrick Gilles
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Date	10/12/2010
Attachments	Reply to Opposition to Rule 56_f_ Motion for Discovery.pdf (5 pages)(22004 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
The Trademark Trial and Appeal Board

In the matter of Trademark Registration No. 3691948
For the mark WONDERBREAD 5,

Wonderbread 5,	:	
	:	
Petitioner,	:	
	:	
vs.	:	Cancellation No. 92052150
	:	
Patrick Gilles,	:	
	:	
Registrant.	:	

REGISTRANT’S BRIEF IN REPLY

COMES NOW the Registrant, Patrick Gilles (hereinafter “Registrant”), by and through counsel, The Trademark Company, PLLC, and submits the instant brief in reply to Petitioner Wonderbread 5’s (hereinafter “Petitioner”) opposition to Registrant’s Rule 56(f) Motion for Discovery in lieu of an Opposition to Petitioner’s Motion for Summary on the Pleadings, or in the Alternative, For Summary Judgment (hereinafter “Motion for Summary Judgment”). For the reasons and on the grounds more fully set forth below Registrant reiterates its request that the Board grant Petitioner’s Rule 56(f) Motion for Discovery and issue an Order directing Petitioner to respond to specific discovery requests submitted by Registrant to Petitioner prior to the filing of Petitioner’s Motion for Summary Judgment.

REPLY

Petitioner’s opposition to Registrant’s motion may be distilled down into two objections poignantly set forth on page 5 of the Petitioner’s brief: (1) Petitioner’s discovery requests seek information Registrant already possesses; and (2) the evidence sought through the Rule 56(f) motion “cannot possibly create a genuine dispute of material fact. *See* Petitioner’s Opposition to Registrant’s Rule 56(f) Motion for Discovery at p. 5. It is respectfully submitted to the Board that neither of these arguments should be deemed persuasive in the instant matter.

In regard to the first contention, Petitioner is in error when it states that the information requested in Registrant’s discovery is already in the possession of the Registrant. Registrant does not retain any of

the corporate, partnership, or other formation and maintenance documents of the alleged Petitioner which are instrumental in establishing, or as the case may be refuting, Petitioner's alleged competing rights against those of the Registrant. In fact, Registrant does not retain any of the information sought in the specific discovery outlined in Registrant's Rule 56(f) motion.

However, rather than to simply answer questions and produce such documents the Petitioner is attempting to frustrate the Registrant's legitimate efforts at discovery at the expense of this Board's efforts. Why? To support obstructionist tactics founded upon mere conclusory allegations that Registrant retains this evidence when Registrant, in fact, does not?

Once again undaunted by a lack of factual support Petitioner next argues that even if their initial premise, that Registrant retains the requested information sought in discovery, fails to persuade the Board to deny Registrant's motion discovery should still not be permitted because the evidence sought cannot possibly create a genuine issue of material fact sufficient to overcome the motion for summary judgment. On this point Petitioner, in an attempt to criticize Registrant's understanding of the issues at hand, provides a wonderfully concise recitation of the exact issues it contends are involved in the Motion for Summary Judgment to which discovery, if produced, would be relevant. Specifically, Petitioner provides:

[T]he issue raised by the Petition and the motion for judgment are whether the Registration must be cancelled because all of Registrant's use of the mark prior to his departure from the Band was as a *member* of the Band, whether the Band owned rights to the mark through prior use, and whether the Band abandoned the mark.

See Petitioner's Opposition to Registrant's Rule 56(f) Motion for Discovery at p. 2.

In sum, the Petitioner admits that the relevant inquires at hand in its motion for summary judgment and the counter-request for discovery on these points in Registrant's Rule 56(f) Motion are as follows:

1. Registrant's use of the mark at issue, as alleged by Registrant, was solely as a member of the band;
2. The band owns rights in the mark prior to any rights acquired by the Registrant; and
3. Whether the band abandoned rights in the mark.

Assuming Petitioner's points of relevance as admitted to above, each and every bit of the requested discovery goes to these very issues.

Information concerning the Band's formation, membership, and generally how the Band is structured goes to the heart of the Band's ability to own or otherwise possess the mark at issue. The Petitioner continuously assumes that "the Band" has rights in the mark. However, it objects to producing how these rights were acquired or who was a member of the Band and therefore may have acquired those rights in the first place.

For instance, if the Band was formed as an LLC or Partnership specifically specifying rights upon dissolution of the Band and, in particular, what happens to the intellectual property rights of the Band when the same occurs such is highly relevant to the ownership of the mark at issue. This is especially true whereas here there is no dispute as to whether Registrant was the founder of the Band but there is a dispute as to how and why he is no longer with the Band and what affect that has on the ownership of the mark at issue. This is equally as true for information concerning the selection of the mark, ownership thereof, as well as use of the same.

The Petitioner would like for us to merely assume that all facts in this regard inure to their benefit and not produce any discovery on these issues. They are wrong and these issues, and the specific discovery, go to the heart of Petitioner's Motion for Summary Judgment and in the absence of discovery thereon Registrant cannot effectively respond to the Petitioner's motion as filed no matter how often Petitioner merely states we should assume that the answers will always favor their position.

Concerning the prior adversarial proceeding, once again the Petitioner claims to retain prior rights to the mark than does the Petitioner. When asked what this is based upon, however, they never can respond with actual evidence. Registrant is entitled to evidence produced by the Petitioner that refutes their simple assumptions of ownership. The Petitioner consistently mentions the prior litigation in this matter when they feel that it serves their best interests however obstruct any and all discovery as to the relevance of that litigation to the instant claims (e.g., If they claim prior rights in the mark Registrant is entitled to discovery how they acquired these rights including any acquisition of rights via settlement, purchase, or otherwise).

In the absence of this discovery, Registrant cannot effectively oppose the instant motion as the most significant evidence refuting Petitioner's own claims is retained by Petitioner and not being produced under the rules of discovery.

WHEREFORE Registrant again respectfully requests that the Board admonish these obstructionist and time-consuming wasteful practices by granting the Registrant's Rule 56(f) Motion and ordering the Petitioner to provide full and complete responses to interrogatories 2-3, 6, 8, 10-20 as well as requests for production of documents 1-2, 6-7, and 12-14 prior to Registrant being required to respond to the *Motion for Summary Judgment*.

Respectfully submitted this 12th day of October, 2010.

THE TRADEMARK COMPANY, PLLC

/Matthew H. Swyers/

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Patrick Gilles,	:	
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Registrant.	:	

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that I caused a copy of the foregoing motion this 12th day of October, 2010,
to be served, via first class mail, postage prepaid, upon:

Meagan McKinley Ball
Phillips, Erlewine & Given LLP
50 California Street, 35th Floor
San Francisco, CA 94111

Matthew H. Swyers
Matthew H. Swyers