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

Proceeding	92052625
Party	Plaintiff Nautica Apparel, Inc.
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Attachments	Response to motion to compel discovery 5-20-11.pdf (8 pages)(23187 bytes)

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

Nautica Apparel, Inc.,

Cancellation No.: 92052625

Petitioner,

Mark: AIRNAUTIC

v.

Reg. No. 3640791

AirNautic Watch Company,

Reg. Date: June 16, 2009

Registrant.

**PETITIONER'S RESPONSE TO REGISTRANT'S MOTION TO COMPEL
RESPONSES TO REGISTRANT'S FIRST REQUEST
FOR PRODUCTION OF DOCUMENTS**

Petitioner, Nautica Apparel, Inc. ("Petitioner" or "Nautica"), hereby objects to the Registrant's Motion to Compel dated April 29, 2011. Registrant's motion is without basis and fails to meet the requirements of 37 CFR § 2.120(e).

Background

On September 22, 2010, Registrant served upon Nautica its First Request for Production of Documents and Things (the "Requests"), which consisted of sixty-seven (67) separate Requests and its First Set of Interrogatories (the "Interrogatories"), which consisted of just fewer than seventy-five (75) delineated Interrogatories and well over seventy-five (75) Interrogatories including non-delineated compound questions or conjunctive questions.¹

¹ On March 4, 2011, Petitioner objected to the Interrogatories on the basis that the same violated 37 CFR § 2.120(d) as excessive. Registrant conceded this point on April 28, 2011 when it served upon Petitioner revised Interrogatories.

On March 4, 2011, pursuant to FRCP § 34, Nautica timely served its objections, written responses and produced 13,439 documents as they are kept by Nautica in the usual course of business, via a portable flash drive. Electronic service of documents was previously agreed to by counsel during the Initial Conference in this matter.

By letter dated April 11, 2011, counsel for Registrant contacted counsel for Nautica alleging discovery response deficiencies. A copy of said letter is attached hereto as Exhibit A. Interestingly enough, counsel's letter was not presented to the Board with Registrant's Motion to Compel.

The April 11 letter set forth four (4) issues: (1) That Nautica improperly objected to the Interrogatories on the basis that the same violated 37 CFR § 2.120(d) as excessive²; (2) That Nautica was required to produce documents pursuant to FRCP § 34; (3) That Nautica failed to provide a privilege log; and (4) That Nautica improperly objected to certain Requests on the basis that the documents sought are equally accessible to Registrant from public sources. Specifically, Registrant asserted that in connection with Request No. 29, "which seeks litigation documents related to enforcement efforts for its NAUTICA mark"... "Petitioner refer[red] Registrant to the TTAB and Pacer Websites."

By letter dated April 13, 2011, a copy of which is attached as Exhibit B, Nautica responded to the four (4) issues presented in the April 11 letter as follows: (1) Nautica properly objected to the Interrogatories pursuant to 37 CFR § 2.120(d); (2) Nautica produced responsive documents pursuant to FRCP § 34 as they are kept in the usual course of its business and Nautica offered Registrant the opportunity to review its files; (3) Nautica presented a privilege log; and (4) In response to Request No. 29, Nautica

² As indicated above, Registrant conceded this point on April 28, 2011 when it served upon Petitioner revised Interrogatories.

believed that its objections and response was proper. Nautica had already provided Registrant with unreported decisions it obtained from the TTAB. Nevertheless, Nautica supplemented its production with over one hundred additional representative documents (Bates Nos. 13440 through 13554).

Without any further response, on April 29, 2011, Registrant filed the instant motion to compel in which it alleges in pertinent part the following:

- 1) That Nautica's production was produced without organization or categorization;
- 2) That Nautica must fully respond to Request Nos. 12-14, 17-21, 23, 24, 26, 27, 33, 34, 36-41, 44, 47-49, 51, 52, 56, 59-65 and 67; and
- 3) That Registrant made a good faith effort to resolve the issues in the motion prior to making same.

Argument

Registrant's motion to compel is, at best, premature. 37 CFR §2.120(e) provides that, with regard to a motion to compel discovery,

A motion to compel initial disclosures, expert testimony disclosure, or discovery must be supported by a written statement from the moving party that such party or the attorney therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion but the parties were unable to resolve their differences.

Registrant should not use the deliberate omission of material facts in order to support a motion to compel and to support its declaration of good faith effort.

As discussed herein, Registrant's April 11th letter (i.e. its alleged "good faith effort"), contained only four (4) allegations. Of the four (4) allegations, three (3) were apparently resolved. The remaining issue presented by Registrant is that Nautica's production was produced without organization or categorization. Nautica strenuously objects to this mischaracterization to the Board. Registrant served at least sixty-seven (67) Requests calling for production of numerous documents from and throughout Nautica's near thirty (30) years of existence. Representative documents Bates stamped 1-13,554 were produced by category or topic as they are kept in the usual course of Nautica's business. Registrant's motion now alleges that the production was insufficient and that additional documents should be produced. Nautica went to great expense to electronically scan representative documents responsive to Registrant's numerous Requests. Nautica's production was in no way the paper "dump" being alleged by Registrant. There was no intent to bury any documents in this production and Nautica intends to use the produced documents at trial. Nautica is under no obligation to create an index for its production or to label its production since they were produced as they are kept in the usual course of business. Nevertheless, in an effort to resolve the matter Nautica offered Registrant the opportunity to review the same documents where they are kept in New York or New Jersey. Registrant never responded to this offer. Although not required, Nautica also offers the following broad categorization of the documents produced.

1. Corporate and Financial Reports (Bates Nos. 0000001- 0001058)
2. Product Documentation (Bates Nos. 0001059 – 0002819)
3. Marketing and Sales Data (Bates Nos. 0002820- 0002834)

4. Product Documentation Bates Nos. (0002835 – 0003599)
5. Product Documentation and Advertising (Bates Nos. 0003600 – 0004146)
6. Product Documentation (Bates Nos. 0004147 – 0004163)
7. Articles Referring to Nautica (Bates Nos. 0004164- 0009959)
8. Product Documentation (Bates Nos. 0009960- 0011748)
9. Sponsorships (Bates Nos. 0011749- 0012161)
10. Store Imagery (Bates Nos. 0012162- 0012185)
11. Product Documentation (Bates Nos. 0012186- 0012284)
12. Internet Materials (Bates Nos. 0012285-0012333)
13. Product Documentation and Promotion (Bates Nos. 0012334- 0012686)
14. Advertising, marketing, promotion, presence and sales information (Bates Nos. 0012687- 0013267)
15. Trademark Certificates (Bates Nos. 0013268- 0013353)
16. Enforcement Matters (Bates Nos. 0013354-0013554)

The April 11th letter from Registrant alone simply does not constitute sufficient “good faith effort” to resolve matters. As discussed above, the April 11 letter contained four allegations. Three have been resolved. The last concerning Nautica’s organization or categorization of its production has been thoroughly responded to despite the fact that there was only one letter issued by Registrant to resolve the issue. Now however, Registrant’s motion raises new allegations concerning Request Nos. 12-14, 17-21, 23, 24, 26, 27, 33, 34, 36-41, 44, 47-49, 51, 52, 56, 59-65 and 67 which were never the subject of any prior communication or Registrant’s April 11th letter. *See, Giant Food, Inc. v. Standard Terry Mills, Inc., 231 USPQ 626, 632 (TTAB 1986) (Absent additional*

documentation or other information indicating that a good faith effort was in fact made, one letter is not sufficient). *See also*, Envirotech Corporation v. Compagnie Des Lampes, 219 USPQ 448, 450 (TTAB 1979) (Where there has been a response to discovery which is unsatisfactory to the party seeking discovery, the moving party has a duty to confer with the opposing party to try to settle their disputes as to the propriety of the discovery requests and/or responses thereto). *See also* MacMillan Bloedel Ltd. v. Arrow-M Corp., 203 USPQ 952 (TTAB 1979); Ford Motor Co. v. Shelby International, Inc., 193 USPQ 236 (TTAB 1976); Daimler-Benz Aktiengesellschaft v. Hibner Products Mfg., Inc., 189 USPQ 479 (TTAB 1976); Varian Associates v. Fairfield-Noble Corp., 188 USPQ 581 (TTAB 1975); J. B. Williams Co. v. Pepsodent G.m.b.H., 188 USPQ 577 (TTAB 1975); Penthouse International Ltd. v. Dyn Electronics, Inc., 184 USPQ 117 (TTAB 1974); and Angelica Corp. v. Collins & Aikman Corp., 183 USPQ 378 (TTAB 1974).

Nautica is fully prepared to discuss and attempt to resolve all discovery disputes. As stated above, Registrant never communicated any objection to Nautica's response to Request Nos. 12-14, 17-21, 23, 24, 26, 27, 33, 34, 36-41, 44, 47-49, 51, 52, 56, 59-65 and 67. Any motion to compel concerning Request Nos. 12-14, 17-21, 23, 24, 26, 27, 33, 34, 36-41, 44, 47-49, 51, 52, 56, 59-65 and 67 is at best premature and simply cannot form the basis of a motion to compel. In the event that the Board determines that Registrant's Motion to Compel complies with 37 CFR § 2.120(e), Nautica respectfully reserves its right to substantively respond to these new allegations until such time that the Board rules on Registrant's perceived "good faith efforts."

For the foregoing reasons, Registrant's motion to compel should be denied as being improper.

BAKER & RANNELLS PA

Dated: May 20, 2011

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing was forwarded by First Class Mail on this 20th day of May, 2011 to the attorneys for the Registrant at the following address:

Jennifer Parkins Rabin, Esq.
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/Neil B. Friedman/
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