

ESTTA Tracking number: **ESTTA637258**

Filing date: **11/05/2014**

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

Proceeding	92053501
Party	Plaintiff Christian M. Ziebarth
Correspondence Address	KELLY K PFEIFFER AMEZCUA-MOLL ASSOCIATES PC LINCOLN PROFESSIONAL CENTER, 1122 E LINCOLN AVE SUITE 203 ORANGE, CA 92865 UNITED STATES kelly@amalaw.net
Submission	Opposition/Response to Motion
Filer's Name	Kelly K. Pfeiffer
Filer's e-mail	kelly@amalaw.net
Signature	/Kelly K. Pfeiffer/
Date	11/05/2014
Attachments	Opp to Del Taco's Mtn to Strike 11-5-14.pdf(75907 bytes)

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

In the Matter of Registration No. 1043729
Date of Registration: July 13, 1976

CHRISTIAN M. ZIEBARTH
Petitioner,

Cancellation No.: 92053501

v.

DEL TACO, LLC
Registrant.

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

**PETITIONER’S OPPOSITION TO DEL TACO’S MOTION TO STRIKE
OR, IN THE ALTERNATIVE, DISMISS**

Petitioner Christian M. Ziebarth ("Petitioner") opposes Registrant Del Taco, LLC’s (“Del Taco”) motion to strike or, in the alternative, to dismiss (“Del Taco’s Motion”) as follows:

Del Taco’s Motion is fatally flawed because it is based upon the untrue assertion that Petitioner is attempting to use the evidence in question to support his case. The six pages of emails in question between Petitioner and Jeff Naugle and Petitioner and Barbara Caruso **were never introduced by Petitioner to make his case nor relied upon in his Trial Brief.** Instead, the emails were referenced *for the first time by Del Taco* in its own Trial Brief. In response, Petitioner properly addressed the emails in his Reply Brief.

By submitting the full set of facts surrounding the emails, and the declaration of Kelly Pfeiffer (“Pfeiffer Declaration”) and exhibit to illustrate the truth of those facts, Petitioner seeks only to set the record straight. The facts are as they are, and Petitioner’s assertion of those facts is not gamesmanship. Del Taco’s accusations to the contrary are unfounded.

Del Taco’s Trial Brief discussed the existence of these emails and falsely stated that they were not produced. Petitioner rebutted that assertion via the Pfeiffer Declaration by detailing how the emails were discovered and illustrating that Petitioner did, in fact, produce the emails a year ago, but thereafter, in the interest of fairness, chose not to use them to support his case. The Pfeiffer Declaration and attached exhibit has not been presented to support Petitioner’s substantive case in this proceeding. Instead, they are presented for the limited purposes of 1) rebutting Del Taco’s inaccurate statement in its Trial Brief that the emails were not produced and the allegation that Petitioner and his counsel have not acted in good-faith, and 2) giving the Board the opportunity to review the emails so it can verify for itself that these emails were not offered into evidence by Petitioner, nor were their contents referenced in his Trial Brief. As such, Petitioner has not violated any Order of the Board, nor is dismissal of this case in Del Taco’s favor warranted under Section 527.03 of the TBMP. This Motion is groundless and should be denied in its entirety.

I. FACTUAL BACKGROUND

In its own Trial Brief, Del Taco referenced the existence of six pages of emails between Petitioner and Jeff Naugle and Petitioner and Barbara Caruso. Del Taco’s Trial Brief (Doc. 91). Del Taco’s Trial Brief alleges that Petitioner withheld these emails, then relied upon them to support his case. Petitioner, knowing that Del Taco’s accusations are unfounded, included a

rebuttal in his Reply Brief, attaching the Pfeiffer Declaration and exhibit as evidentiary proof of the inaccuracy of Del Taco's assertions.

Petitioner's own case in chief and Trial Brief never brought up the existence of these emails nor relied upon them in any way. Del Taco's own Trial Brief was the first time these emails were brought to light in this proceeding. For the limited purpose of rebutting Del Taco's unsupported statements, Petitioner offered the full set of facts surrounding the emails, sworn to under penalty of perjury by his counsel, which are summarized as follows:

During the live cross-examination of Petitioner on October 28, 2013, Petitioner's counsel, Kelly Pfeiffer, learned for the first time while Petitioner was testifying that he still might possess additional emails from Jeff Naugle. Pfeiffer Decl., ¶ 4. Because Ms. Pfeiffer is the third counsel to represent Petitioner during this 4-year proceeding, she did not assist Petitioner through the discovery phase because her appearance came five months after discovery closed. After Petitioner's cross-examination, Ms. Pfeiffer instructed Petitioner to make a thorough examination of his records to determine whether additional responsive documents were within his possession. Pfeiffer Decl., ¶ 6. On November 5, 2013, Petitioner sent to Ms. Pfeiffer six pages of emails, four being emails between Barbara Caruso and Petitioner attempting to set up a meeting between Petitioner and Noah Chillingworth, and two being emails between Jeff Naugle and Petitioner, a few dated February 9, 2010, wherein Mr. Naugle confirmed that he has original Naugles recipes, that Del Taco knew he was using said recipes in his own restaurant but did nothing about it, and wherein Petitioner wrote, "Getting ready to come up on Saturday," corroborating Petitioner's testimony and documentation that he had a meeting with Jeff Naugle on February 10, 2010. Pfeiffer Decl., ¶ 7; see also Ziebarth Aff., ¶ 9, Ex. F. Ms. Pfeiffer had

never seen nor been told about the existence of these emails prior to this time. Pfeiffer Decl., ¶ 7.

The very next day on November 6, 2013, Ms. Pfeiffer called Del Taco's counsel and explained the situation honestly and bluntly. Ms. Pfeiffer promised to turn over the emails within 24 hours. Pfeiffer Decl., ¶ 8. Ms. Pfeiffer told them that she understood that they would need time to evaluate these six pages to determine whether they thought anything else needed to be addressed and, after review, to the extent Del Taco took issue with the documents, she invited a conversation on any issues its counsel may have. Pfeiffer Decl., ¶ 8. Ms. Pfeiffer went out of her way to stress that she was open-minded to communication between the parties as a method of working this out, and she wanted to address any concerns of theirs that may exist. Ms. Pfeiffer's goal was to remedy the situation as quickly and easily possible. Pfeiffer Decl., ¶ 8.

On November 7, 2013, Ms. Pfeiffer sent a follow-up letter to Del Taco's counsel, recounting their conversation from the day prior and included the six pages of emails she had promised to produce. Pfeiffer Decl., ¶ 9, Ex. A. Ms. Pfeiffer's November 7th letter specifically requested, "[W]e respectfully request that you confirm with us one way or another if you take issue with the enclosed, additional documents so we can respond accordingly." Pfeiffer Decl., ¶ 10, Ex. A, p. 2. Thereafter, Del Taco's counsel never conveyed to Ms. Pfeiffer that they took issue with those six pages of emails. Pfeiffer Decl., ¶ 11.

Ms. Pfeiffer and her firm made the professional and ethical decision in the interest of fairness not to introduce these six pages of emails into evidence in this proceeding. Pfeiffer Decl., ¶ 12. Petitioner has not used these emails nor referenced them or their contents in any way. Pfeiffer Decl., ¶ 12. The first time these emails have been referenced in this proceeding was by Del Taco in its Brief and Objections. Pfeiffer Decl., ¶ 12. After waiving its opportunity

to address any issues it had with these emails by failing to engage Ms. Pfeiffer in discussion which she openly invited an entire year ago, Del Taco is now using these emails to create controversy where none exists.

Because the existence of the emails was raised in Del Taco's Trial Brief, Petitioner properly addressed them in his Reply Brief. Petitioner offered the Pfeiffer Declaration and attached exhibit for the limited purpose of lending support to and proving the veracity of his rebuttal to Del Taco's allegations. The Pfeiffer Declaration also gives the Board the complete set of facts in the hopes that the Board's ultimate ruling in this proceeding is not clouded by Del Taco's inappropriate accusations.

II. PROCEDURAL HISTORY

Over the course of this proceeding, Del Taco has at least twice asked the Board for terminating sanctions against Petitioner based upon unfounded allegations of bad faith. The Board has never found that Petitioner has acted in bad faith.

On August 22, 2012, Del Taco moved the board for sanctions against Petitioner. On December 12, 2012, the Board ruled that Petitioner had not deliberately attempted to evade discovery answers and, as such, neither terminating nor evidentiary sanctions were warranted. Doc. 33.

On March 8, 2013, Del Taco moved the board for sanctions against Petitioner. On August 12, 2013, the Board ruled that Del Taco's "renewal" of its August 22, 2012 motion for sanctions in the form of dismissal was denied; the Board also denied all of Del Taco's demand for estoppel sanctions, with the exception of testimony from William ODell, which, in compliance, Petitioner never sought. Doc. 49.

The instant motion constitutes Del Taco's third and final attempt to accuse Petitioner of acting in bad faith, one which Petitioner hopes the Board will see, as was seen before, is meritless.

III. ARGUMENT

A. Rebuttal To Del Taco's Trial Brief Accusations Is Proper Subject Matter For Petitioner's Reply Brief.

TBMP § 801.03 states,

If a plaintiff files a reply brief, the brief must be confined to rebutting the defendant's main brief. In other words, the reply brief should be limited to the key points in defendant's brief which plaintiff believes require clarification or response.

Del Taco's allegations in its Trial Brief that Petitioner did not produce certain emails and that his counsel and he have not acted in good faith required "clarification or response," per TBMP § 801.03. As such, Petitioner properly rebutted these accusations in his Reply Brief and submitted the Pfeiffer Declaration and attached exhibit for the limited purpose of illustrating their impropriety. By reviewing the letter and emails, the Board can independently verify that they have not been introduced by Petitioner to make his case nor have their contents been referenced. The only logical way for Petitioner to conclusively prove that he has not used the emails referenced in Del Taco's Trial Brief is to show them to the Board so it can verify that they, in fact, cannot be found anywhere else in the record.

Given the foregoing, Petitioner's Reply Brief was the proper place for Petitioner to rebut Del Taco's unsupported statements of fact contained in its Trial Brief, and the Pfeiffer Declaration and attached exhibit lend authenticity to Petitioner's rebuttal.

B. Petitioner Does Not Rely Upon The Evidence At Issue To Make His Case.

Del Taco's Motion is based upon the inaccurate assertion that Petitioner offered the Pfeiffer Declaration and attached exhibit to support his case. Nowhere in Petitioner's direct testimony, in the testimony of his witnesses nor in his Trial Brief does Petitioner reference these emails. These emails only became an issue because Del Taco made them so in its own Trial Brief and now as the subject of this Motion.

Tellingly, **nowhere in Del Taco's Motion does it point to a place in Petitioner's direct testimony, a document submitted during Petitioner's trial period or a place in Petitioner's Trial Brief wherein he introduced the emails in question or referenced their content in any way.** Del Taco cannot point to the offending evidence because it is not, in fact, anywhere in the record.

The Trademark Rules and case law cited by Del Taco do not apply because the instant situation is inapposite. The rules and cases cited by Del Taco concern a party's attempt to introduce evidence attached to a brief *to support its case*. In contrast, Petitioner offered the Pfeiffer Declaration and attached exhibit for the limited purpose of disproving unsupported statements made by Del Taco in its Trial Brief regarding evidence and issues raised by Del Taco.

Because Del Taco's Motion is based upon the inaccurate assertion that Petitioner offered the Pfeiffer Declaration and attached exhibit to support his case, it is meritless and should be denied.

C. The Pfeiffer Declaration And Exhibit Are Offered For The Limited Purpose Of Rebutting Statements Made By Del Taco In Its Trial Brief.

Del Taco is incorrect when it contends that 1) Ms. Pfeiffer is “testifying” in her declaration to support Petitioner’s case, and 2) the exhibit to the Pfeiffer Declaration is offered to support Petitioner’s case. Instead, these documents are offered for the limited purpose of rebutting inaccurate statements and allegations contained in Del Taco’s Trial Brief. The Pfeiffer Declaration explains the circumstances surrounding the discovery of the emails and how Petitioner did, in fact, produce them to Del Taco a year ago. Petitioner did not introduce these emails in his case in chief nor referenced them in his Trial Brief. However, because Del Taco put them in issue in its own Trial Brief, it was logical for Petitioner to show the emails to the Board to prove that they do not constitute any of the emails that he has introduced to support his case, nor were their contents previously referenced.

Because the Pfeiffer Declaration and attached exhibit have been offered only for the limited purpose of rebutting inaccurate statements made in Del Taco’s Trial Brief, Del Taco’s motion is meritless and therefore should be denied.

D. Petitioner Has Not Violated Any Orders By The Board.

As illustrated above, Petitioner’s case in chief did not exceed the scope of what was disclosed in discovery. The Board Order cited by Del Taco prohibit “argument at trial [which] exceed[s] the information provided during discovery.” As such, Petitioner is not in violation of any Order by the Board. In reality, Del Taco is the party whose trial argument has exceeded the information provided during discovery by raising the issue of these emails for the first time in its own Trial Brief.

Del Taco's Trial Brief made unsupported allegations that Petitioner did not turn over emails between Petitioner and Jeff Naugle which were discovered to exist for the first time during Petitioner's cross-examination testimony. In reality, Petitioner did turn over those emails a year ago, a fact that could only be proved by Ms. Pfeiffer's declaration which both recounts how she called Del Taco's counsel and engaged in a good-faith discussion to deal with the new emails and authenticates the attached follow-up letter to Del Taco's counsel wherein Ms. Pfeiffer invited further discussion so that any concerns Del Taco had regarding the new emails could be handled to its satisfaction. This evidence establishes that the emails were, in fact, produced a year ago because they were enclosed with the letter.

In sum, the Pfeiffer Declaration and exhibit illustrate that Petitioner and his counsel have acted in good-faith and that Del Taco's allegations to the contrary are unsupported. It is ironic that, in order to prove his good-faith to the Board, Petitioner was forced to reveal the very documents he had purposely excluded from his case because they had concededly not been discovered or disclosed prior to the close of discovery.

Given the foregoing, Petitioner is not in violation of any Order by the Board, and his counsel and he have conducted this proceeding with honesty and professionalism throughout. For Del Taco to attempt to frame the situation otherwise is misleading. Del Taco's entire discourse in its Brief and in this instant Motion, alleging board order violations and accusing Petitioner of acting in bad-faith, is a ploy to draw focus away from the merits of this case.

E. No Grounds Exist For Dismissal Under TBMP § 527.03.

Finally, because Petitioner has not violated any Order by the Board, Del Taco's request for dismissal of this proceeding in its favor under TBMP § 527.03 is meritless and should be denied.

IV. CONCLUSION

In essence, Del Taco wants the Board to allow it to make unsupported statements and assertions of fact in its Trial Brief, yet prohibit Petitioner from responding to those statements by proving with evidence that they are untrue. Del Taco wants to be permitted to accuse Petitioner of failing to turn over evidence then relying on that evidence to make his case, but now asks the Board to prevent Petitioner from conclusively demonstrating that he actually did turn these documents over, but did not rely upon them to make his case. Del Taco cannot have it both ways.

As illustrated above, Petitioner has not violated any Order of the Board and, as such, dismissal with prejudice under § 527.03 or any other Rule is not proper.

For the foregoing reasons, Petitioner respectfully asks the Board to deny Del Taco's Motion in its entirety.

Respectfully submitted,

By /Kelly K. Pfeiffer./
Kelly K. Pfeiffer
AMEZCUA-MOLL & ASSOCIATES, P.C.
Lincoln Professional Center
1122 E. Lincoln Ave., Suite 203
Orange, CA 92865

Attorney for Petitioner CHRISTIAN M. ZIEBARTH

CERTIFICATE OF SERVICE

I certify that a copy of the foregoing **PETITIONER'S OPPOSITION TO DEL TACO'S MOTION TO STRIKE OR, IN THE ALTERNATIVE, DISMISS** was served upon April L. Besl, DINSMORE & SHOHL, LLP, attorney of record for the Registrant in this action by depositing one copy thereof in the United States mail, first-class postage prepaid on November 5, 2014 and addressed as follows:

April L. Besl, Esq.
DINSMORE & SHOHL, LLP
255 East Fifth Street, Suite 1900
Cincinnati, OH 45202

/Kelly K. Pfeiffer/
Kelly K. Pfeiffer
AMEZCUA-MOLL & ASSOCIATES, P.C.
Lincoln Professional Center
1122 E. Lincoln Ave., Suite 203
Orange, CA 92865

Attorney for Petitioner CHRISTIAN M. ZIEBARTH