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

Proceeding	92054095
Party	Defendant Drifire, LLC
Correspondence Address	DENISE I MROZ WOODCOCK WASHBURN LLP CIRA CENTRE 12TH FLOOR, 2929 ARCH ST PHILADELPHIA, PA 19104 UNITED STATES clyu@woodcock.com, dmroz@woodcock.com, trademarks@woodcock.com
Submission	Opposition/Response to Motion
Filer's Name	Charlie C. Lyu
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Signature	/Charlie C. Lyu/
Date	05/17/2012
Attachments	Opposition.pdf (6 pages)(109139 bytes) Lyu Declaration.pdf (2 pages)(106447 bytes) Exhibit A.pdf (3 pages)(191205 bytes) Exhibit B.pdf (4 pages)(73340 bytes) Exhibit C.pdf (3 pages)(68557 bytes)

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

SOUTHERN MILLS, INC.
DBA TENCATE PROTECTIVE FABRICS
USA

Petitioner,

v.

DRIFIRE, LLC

Respondent

Cancellation No. 92054095

U.S. Trademark Registration No. 3,915,295

Trademark: COMFORTABLE FR WEAR

Registration Date: February 1, 2011

**DRIFIRE’S OPPOSITION TO SOUTHERN MILL’S MOTION TO COMPEL
DESIGNATION OF FRCP 30(B)(6) WITNESS(ES) AND PROVIDE ALTERNATIVE
DATE(S), TIME, AND/OR PLACE FOR HOLDING DISCOVERY DEPOSITION**

Registrant, DRIFIRE, LLC (“DRIFIRE”), herewith responds to Southern Mills, Inc.’s (“Southern Mills”) Motion to Compel, and request to extend the discovery dates in this matter. Southern Mills’ motion should be denied in its entirety.

This cancellation proceeding was brought by Southern Mills to cancel DRIFIRE’s mark, COMFORTABLE FR WEAR, which is registered on the Supplemental Register, on grounds of genericism. The parties have engaged in discovery and have extended the discovery period twice. Additionally, Southern Mills has promulgated extensive third party discovery in this matter. Southern Mills now seeks to extend further the discovery in this matter, without any explanation as to why an extension is necessary. As a tactic to seek an extension of discovery (which Southern Mills had not discussed with DRIFIRE before filing its motion), Southern Mills moves to compel the designation of a 30(b)(6) witness that DRIFIRE had already agreed to produce.

Southern Mills has filed its motion without any notice, much less a meet and confer, on

the eve of the close of discovery when it had over two months since the last discovery extension to discuss a new deposition date. It brings to the Board a matter that had not been in dispute, and only appears to be in dispute, as a tactic to obtain an additional period for discovery.

DRIFIRE had certainly agreed to produce a witness; the parties simply had not had further discussions concerning a new date. Southern Mills' motion is its latest attempt to simply over-litigate a cancellation proceeding. It is respectfully requested that the Board deny both the motion to compel and Southern Mills' request to extend discovery.

Under the Trademark Rules of Practice 523.01, a motion to compel "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." *See also*, 37 C.F.R. §2.120(e). Indeed, Southern Mills cannot make these representations. Southern Mills had not contacted DRIFIRE on any issue raised in its motion since March. Instead, communications between the parties since March have been relating to negotiations of potential settlement, and on a possible (as of yet unfiled) motion to compel in district court on a related third party. Since Southern Mills cannot make the required good faith statement of a meet and confer, its present motion should be denied on all grounds.

Moreover, there are no good grounds for Southern Mills' motion. Southern Mills' papers misrepresent the nature and timing of any discussions about the 30(b)(6) witness deposition. The initial scheduled deposition date was not a suitable date and there was no discussion of a new date other than DRIFIRE's willingness to extend discovery sixty (60) days to accommodate a to-be-agreed upon new date. Ex. A and B. However, in April, before counsel had any further discussions about remaining discovery and a new 30(b)(6) deposition date, Southern Mills'

corporate representatives and DRIFIRE's corporate representatives reopened settlement discussions. Thereafter, counsel for DRIFIRE sent Southern Mills a letter memorializing initial settlement discussions among the two companies and requested that the parties suspend the proceedings pending settlement discussions. Lyu Decl. at 5. Southern Mills refused to consent to suspension of the proceedings, stating instead that they "were not interested in prolonging the situation any further and will not agree to suspend the TTAB proceeding." *See* Lyu Decl. at 6 and Ex. C.

At no point during or after this April correspondence did Southern Mills seek a new deposition date. Indeed, the suspension of the proceedings would be the simplest means of protecting the remaining discovery period that would close a month later, without lengthening the period. However, it was Southern Mills' position that there was no need to suspend – much less prolong – the matter. Ironically, now, at the close of discovery, Southern Mills requests without a meet and confer to prolong these proceedings and open up discovery for an additional 60 day period. Southern Mills has presented no grounds for this extension.¹

Moreover, Southern Mills repeatedly asserts that DRIFIRE is required to identify the identity of its 30(b)(6) witness. However, Southern Mills cites no support that the name of a 30(b)(6) witness designation needs to be designated in advance, or that there is a date certain for this identification. In fact, the Federal Rules of Civil Procedure do not require that a party provide the identity of its 30(b)(6) witness.

Although the parties, both through counsel and through corporate officers, continued discussions on settlement negotiations and other matters, the issue of the deposition date of the

¹ Southern Mills implies that DRIFIRE has objected to discovery; however, this is not a motion to compel written discovery, and there is no statement that the parties have not resolved any earlier written discovery disputes.

DRIFIRE's 30(b)(6) designee did not come up. Lyu Decl. at 8. It is telling from the Robinson Declaration that Southern Mills submits to support its motion that there is a complete omission that the parties had any other discussions on any discovery issues between the parties after March 2012.

As Southern Mills has stated, discovery in the proceeding has already been extended twice. While Southern Mills claims that it was extended because it was "lenient in allowing extensions," it actually requested those extensions, and then sat by. Southern Mills waited to notice DRIFIRE's deposition until two weeks before the close of the first extended discovery period. Since the date so noticed was a time in which both parties would be occupied with trade shows, the parties mutually agreed on a second extension to facilitate exchange of discovery. DRIFIRE attempted to preserve the remaining discovery period during settlement discussions, an offer that was rejected by Southern Mills. Yet, while rejecting this offer in April, Southern Mills still did not seek a rescheduled deposition date and waited to file this motion on May 2, 2012 – two weeks before the agreed upon close of the extended discovery date.

Not only is an extension of the discovery period unnecessary, but it would prejudice DRIFIRE. It is DRIFIRE's belief that an extension will unnecessarily raise costs without achieving the purported goals of the discovery process, should this case proceed through trial. There is no information of any need for further discovery, or any "prejudice" to Southern Mills, that was not caused by Southern Mills. To the extent a breathing period is needed during settlement negotiations, the parties should agree to suspend the proceedings, and if negotiations are not successful, move forward on this action.

For the foregoing reasons, it is respectfully requested that Petitioners' motion to compel a 30(b)(6) witness and for a sixty (60) day extension of the discovery period be denied.

Dated: May 17, 2012

Respectfully submitted,

WOODCOCK WASHBURN LLP



Denise I. Mroz
Jacqueline Lesser
Charlie C. Lyu
Cira Centre, 12th Floor
2929 Arch Street
Philadelphia, PA 19104
Telephone: (215) 568-3100
Facsimile: (215) 568-3439

Counsel for Registrant

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

SOUTHERN MILLS, INC.
DBA TENCATE PROTECTIVE FABRICS
USA

Petitioner,

v.

DRIFIRE, LLC

Respondent.

Cancellation No. 92054095

U.S. Trademark Registration No. 3,915,295

Trademark: COMFORTABLE FR WEAR

Registration Date: February 1, 2011

CERTIFICATE OF SERVICE

I, Charlie C. Lyu, hereby certify that on May 17, 2012, I caused a true and correct copy of the within DRIFIRE'S RESPONSE TO SOUTHERN MILL'S MOTION TO COMPEL DESIGNATION OF FRCP 30(B)(6) WITNESS(ES) AND PROVIDE ALTERNATIVE DATE(S), TIME, AND/OR PLACE FOR HOLDING DISCOVERY DEPOSITION be served by means of electronic mail on the following counsel:

Michael E. Robinson, Esq.
Ludeka, Neely & Graham, P.C.
P.O. Box 1871
Knoxville, TN 37901
RRobinson@LNG-Patent.com



Dated: May 17, 2012

By: _____

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

SOUTHERN MILLS, INC.
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Trademark: COMFORTABLE FR WEAR

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**DECLARATION OF CHARLIE C. LYU IN SUPPORT OF RESPONDENT'S
OPPOSITION TO MOTION TO COMPEL**

I, Charlie C. Lyu, declare under penalty of perjury as follows:

1. I represent Respondent, DRIFIRE, LLC ("DRIFIRE"), in the cancellation proceeding *Southern Mills, Inc. v. DRIFIRE, LLC*, Cancellation No. 92054095, currently pending before the Trademark Trial and Appeal Board ("TTAB").
2. I have personal knowledge of the facts set forth in this declaration.
3. Exhibit A attached hereto is a true and correct copy of Respondent's cover email to Petitioner dated March 2, 2012.
4. Exhibit B attached hereto is a true and correct copy of Respondent's March 2, 2012, response letter to Petitioner's February 17, 2012, letter which was sent as an attachment to Exhibit A.
5. On April 13, 2012, I sent Southern Mills, Inc.'s ("Southern Mills") corporate counsel a letter memorializing initial settlement discussions between Southern Mills and DRIFIRE. In this letter, DRIFIRE requested that the parties suspend

the cancelation proceedings while the parties discussed settlement. A copy of this correspondence was forwarded to counsel for Petitioner on April 17, 2012.

6. On April 19, 2012, counsel for Petitioner responded stating that Southern Mills was not interested in prolonging the case and would not agree to suspend the TTAB proceeding.
7. Exhibit C attached hereto is a true and correct redacted copy of Petitioner's April 19, 2012, response to Respondent's settlement offer.¹
8. From April 13, 2012, until May 17, 2012, the parties have continued to discuss settlement without the issue of a deposition date for the DRIFIRE 30(b)(6) designee being raised.

This 17th Day of May, 2012



Charlie C. Lyu

¹ DRIFIRE will file a true and correct unredacted copy of Ex. C, Petitioner's April 19, 2012, response to Respondent's settlement offer, under seal at the request of the Board.

EXHIBIT A

From: Lyu, Charlie C. (Woodcock Washburn)
Sent: Friday, March 02, 2012 5:00 PM
To: 'Roby E. Robinson'; Lesser, Jackie (Woodcock Washburn); Mroz, Denise Incorvaia (Woodcock Washburn)
Cc: Michael J. Bradford; Matt Googe; 'ldunham@lng-patent.com'
Subject: RE: Notice of Deposition (LNG File No. 67071.99)
Attachments: 2012-03-02 Privilege Log (2).PDF; Letter to Counsel (2).PDF

Roby,

As we discussed during our telephone conference on February 9, 2012, March 6 will not work for the deposition. That was the basis for extending discovery another 60 days. We are working with our client to determine a range of acceptable dates and hope to have the proposed new dates to you next week.

Attached please find our response to your letter dated February 17, 2012.

Regards,
Charlie

Charlie C. Lyu

Attorney

Woodcock Washburn LLP

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From: Roby E. Robinson [<mailto:rrobinson@lng-patent.com>]
Sent: Friday, March 02, 2012 11:14 AM
To: Lyu, Charlie C. (Woodcock Washburn); Lesser, Jackie (Woodcock Washburn); Mroz, Denise Incorvaia (Woodcock Washburn)
Cc: Michael J. Bradford; Matt Googe
Subject: Notice of Deposition (LNG File No. 67071.99)

Dear Charlie, Jackie and Denise,

Please let us know at your earliest convenience when and where you plan to have the deposition regarding the Notice of Deposition we served last month on DrFire. I believe the date on the Notice was March 6, 2012 or so, but I assume that date will not be the date the deposition is held considering you previously mentioned moving it back some.

Very truly yours,

Michael E. "Roby" Robinson
Registered Patent Attorney
Luedeka Neely Group, P.C.

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EXHIBIT B



INTELLECTUAL PROPERTY LAW
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March 2, 2012

JACQUELINE LESSER
215.564.2155
jlesser@woodcock.com

Mr. Michael E. Robinson
Luedeka Neely Group, P.C.
1871 Riverview Tower
900 S. Gay Street
Knoxville, TN 37902

Re: Southern Mills v. DriFire LLC; Cancellation No. 92054095

Dear Roby:

This follows our discussion on February 9th, and your letter of February 17, 2012.

Enclosed with the courtesy copy of this letter, you will find Respondent's privilege log.

You have asked about a new date for the noticed 30 (b) 6 deposition. We are working with our client to determine a range of acceptable dates. The original deposition date of March 16th was not acceptable, as we indicated to you. As your own client knows, March is a busy trade and marketing month in the industry. I hope to have proposed new dates to you in the next week.

The following addresses the points raised in your letter of February 17th, and our telephone call of February 9, 2012.

As discussed during our telephone conference of February 9, 2012, Respondent has agreed to revise its responses to the following Interrogatories.

Interrogatory Response No. 7 to: "Subject to, and without waiver of the objections contained in Respondent's original responses, Respondent has been and is currently the only owner of the mark that is the subject of the registration contested herein."

Interrogatory Response No. 10 is revised to: "Subject to, and without waiver of the objections contained in Respondent's original responses, with the exception of the foregoing dispute with Petitioner, Respondent is not currently, and has not been involved in any disputes relating to Respondent's mark."

Interrogatory Response No. 15 is revised to: "Subject to, and without waiver of the objections contained in Respondent's original responses, Respondent states that it is the only user



Mr. Michael E. Robinson
March 2, 2012
Page 2

of the slogan that it uses as a mark, "COMFORTABLE FR WEAR," Respondent uses its mark, COMFORTABLE FR WEAR on and in connection with the sale and promotion of its products; Respondent identifies the documents it has produced, and continues to produce utilizing its COMFORTABLE FR WEAR mark."

Interrogatory No. 16 has been revised by Petitioner to request the relationship between Optimer, Inc. and DriFire, LLC. Based on the revised, and tailored request (made during the parties' earlier telephone conference), Respondent's response is revised to: "Subject to, and without waiver of the objections contained in Respondent's original responses, DriFire, LLC and Optimer, Inc. are related companies through one or more wholly owned subsidiaries of Sterling Optimer Holdings, LLC. DriFire and Optimer, Inc. jointly license technology."

With respect to the three remaining interrogatories in dispute, Petitioner continues to seek licensing and customer information (see Interrogatory Nos. 3 and 6. The cases cited by Petitioner do not support Petitioner's argument that in an action seeking to cancel a mark on grounds of genericness, the petitioner is entitled to confidential customer and licensee information. Moreover, it seems likely that any list will simply be used for a less than legitimate purpose, calculated to provide Petitioner with confidential customer names to serve document subpoenas on customers (as Petitioner has done with competitors, and retailers, despite the fact that 35 USC 24, does not provide the right to seek document subpoenas in a board proceeding. See also, TBMP 406.01).

Interrogatory No. 5 does not make any sense substantively. Respondent has not claimed a monopoly on the individual words or terms "COMFORTABLE"; "FR" or "WEAR". Indeed, the mark in question is COMFORTABLE FR WEAR. Respondent has provided documents in support of its use of the mark COMFORTABLE FR WEAR and is continuing to produce documents in support of such use.

During our telephone call on February 9, 2012, the parties also discussed particular document requests. Respondent attempted to seek additional clarification on particular document requests.

Petitioner has withdrawn its two document requests which seek confidential sales information. (Requests Nos. 14 and 15). As a point of clarification, Petitioner's counsel mentioned during the telephone call his desire for marketing information – Respondent confirms that none of the existing requests seek marketing figures, and that if Petitioner seeks such information by way of discovery, it will need to make an independent request.



Mr. Michael E. Robinson
March 2, 2012
Page 3

Document Request No. 23 seeks confidential customer lists on the theory that a response will “provide direct evidence of the identity of the customers that purchase Respondent’s goods,” Respondent has already identified the class of customers who purchase its goods. A confidential customer list is not relevant to the proceeding. Moreover, it seems likely that any list will simply be used for a less than legitimate purpose, calculated to provide Petitioner with confidential customer names to serve document subpoenas on customers (as Petitioner has done with competitors, and retailers, despite the fact that 35 USC 24, does not provide the right to seek document subpoenas in a board proceeding. See also, TBMP 406.01).

Please clarify the changes to Document Request No. 26. The request as initially served on Respondent sought “All documents concerning the concept of comfort vis-à-vis FR wear and the role comfort plays in buyer and user preferences for selecting or wearing particular wear garments.” Has Petitioner replaced this request with a request that reads: “All documents concerning customers, or potential customers understanding of the meaning of the term “comfort.”? Please confirm or clarify. Additionally, your letter states that “this request is re-asserted one final time.” This is the first time that Petitioner has made this request – or substantially changed its earlier request (to our understanding).

Yours sincerely,

A handwritten signature in cursive script that reads "Jacqueline Lesser".

Jacqueline Lesser

jml

EXHIBIT C

ANDREW S. NEELY
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GEOFFREY D. KRESSIN
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April 18, 2012
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Via U. S. Mail followed by E-mail

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RE: Petition to Cancel COMFORTABLE FR WEAR,
Reg. No. 3,915,295
Cancellation No. 92054095
LNG File No. 67071.99 / C-6664.0

Dear Charlie,

Thank you for forwarding me the letter sent to Mr. Logan last Friday, April 13. This letter represents Southern Mills' response.

Southern Mills is not interested in prolonging this situation any further and will not agree to suspend the TTAB proceeding.

[REDACTED]

Cancellation No. 92054095

April 19, 2012

Page 2

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Best Regards,

LUEDEKA NEELY GROUP, P.C.

By: 

Michael E. "Roby" Robinson

MER:nsw

cc: Michael J. Bradford, Esq. *(via Email)*
Matthew M. Googe, Esq. *(via Email)*
Lori K. Dunham, Paralegal *(via Email)*
Denise Mroz, Esq. *(via Email)*
Jacqueline Lesser, Esq. *(via Email)*