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

Proceeding	92055426
Party	Defendant Leander Lodi
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Submission	Motion to Strike
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of:

Run It Consulting, LLC,

Petitioner,

vs.

Leander Lodi, by Assignment from  
Augusto Lodi dba American Muscle,

Registrant.

Cancellation No. 92055426

U.S. Trademark Registration No. 1,962,898

Mark: AMERICAN MUSCLE

Registered on Principal Register: 3/19/1996

Trademark Trial and Appeal Board  
Commissioner for Trademarks  
Via E-File

**MOTION TO STRIKE IN PART PETITIONER'S  
FIRST NOTICE OF RELIANCE - CONFIDENTIAL INFORMATION**

COMES NOW the Registrant, LEANDER LODI, successor-in-interest to AUGUSTO LODI (hereinafter "Registrant"), by counsel, and pursuant to 37 CFR §2.120(j)(3)(ii) objects to PETITIONER'S FIRST NOTICE OF RELIANCE - CONFIDENTIAL INFORMATION (hereinafter "FNOR-CI"), to the extent it purports to introduce "documents produced by Registrant" designated as Petitioner's Exhibit B. Registrant further moves this Board for an order striking, in part, Petitioner's FNOR-CI, specifically, Petitioner's Exhibit B representing the documents produced by Registrant. In support of the objection and instant Motion, Registrant states as follows:

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**1. STATEMENT OF FACTS.**

On or about July 31, 2012, Petitioner served written discovery requests on Registrant, including a First Set of Interrogatories ("Rogs") and a First Set of Requests for Production of Documents ("RFPs"). On or about September 24, 2012, Registrant served written responses to Petitioner's RFPs and Rogs. Subsequently, on or about October 5, 2012, Registrant produced documents responsive to the RFPs, including those documents bearing Bates Nos. LODI-0001 through LODI-0234. At the same time, Registrant served supplemental responses to the Rogs.

Two days before Petitioner's testimony period was set to close, a first Notice of Reliance was served submitting a single answer to a Request for Admission by Registrant. On the same day, Petitioner filed the FNOR-CI that is the subject of the instant Motion. As part of the FNOR-CI, Petitioner purports to introduce documents produced by Registrant in response to Petitioner's RFPs, designated by Petitioner as Exhibit B and bearing Bates Nos. LODI-0001 through LODI-0234. Petitioner's FNOR-CI relies upon 37 CFR §§ 2.120(j)(3)(i) and 2.120(j)(5) as the basis for the relevance of these documents designated as Exhibit B.

Registrant submits that the Notice of Reliance is not a proper method for introducing the type of evidence presented by Petitioner as Exhibit B and submits that the Notice of Reliance should be stricken as it relates to Exhibit B and the documents contained in Exhibit B not be given any evidentiary weight.

**2. ARGUMENT.**

**A. Notice of Reliance Upon Document Production is Improper.**

The sections of 37 CFR relied upon by Petitioner to establish the relevance of Exhibit B specifically exclude documents produced under Fed.R.Civ.Proc. 34 from the categories of documents that may be submitted by notice of reliance in this manner. 37 CFR §2.120(j)(3)(ii). Where a written response to a request for production of documents, as in a response indicating that no documents exist, may be relied upon in this manner, a disclosed document itself may not. TBMP §704.11 (Documents

produced in response to a request for production of documents may not be made of record by way of a notice of reliance); Hiraga v. Arena, 90 USPQ2d 1102, 1104 (TTAB, 2009); M. Tek, Inc. v. CVP Systems, Inc., 17 USPQ2d 1070, 1073 (TTAB, 1990); Miles Labs, Inc. v. Naturally Vitamin Supplements, Inc., 1 USPQ2d 1445, 1447, N.9 (TTAB 1987). This is further confirmed by 37 CFR §2.120(j)(3)(ii), which states that "a party that has obtained documents from another party through disclosure or under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance alone".<sup>1</sup>

**B. Contents of Exhibit B Were a Document Production - NOT an Interrogatory Response.**

Without specifying the specific basis for the Notice of Reliance, Petitioner appears to be relying upon a limited exception to this Rule which permits a notice of reliance upon documents produced by an adversary in lieu of responding to an interrogatory or attached to an interrogatory response. In Exhibit A to Petitioner's FNOR-CI, Petitioner includes Interrogatory No. 23 requesting Registrant to identify and describe all documents that he expects to "use, introduce or rely upon at the time of trial in this matter." Registrant objected to this Interrogatory as premature as the proceeding was only in the early stages and the time for Registrant to make his pretrial disclosures had not yet arrived. Subject to the objections, Registrant responded that he cannot presently identify the documents that he expects to use, introduce or rely upon at the time of trial. In the final sentence to this response, Registrant referred Petitioner "to the document (sic) produced in connection with Registrant's Response to Petitioner's First Request for Production of Documents." It is clear from this Interrogatory response that the documents produced by Registrant were in response to the Request for Production of Documents propounded by Petitioner and were not being provided in lieu of a response to this or any other Interrogatory. The documents did not form a part of

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<sup>1</sup>While there are some exceptions to this rule, none are applicable here. The documents contained in Exhibit B do not comprise printed publications or official records as permitted under 37 CFR §2.122(e).

Registrant's answers to the Interrogatories in any form.

Producing documents in lieu of responding to an interrogatory requires that a party invoking Fed.R.Civ.Proc. 33(d) must comply with three specific conditions. No Fear, Inc. v. Rule, 54 USPQ2d 1551 (TTAB 2000); Jain v. Ramparts, Inc., 49 USPQ2D 1429 (TTAB 1998). First, a party must identify documents known to contain the responsive information and not merely records which may contain the responsive information. No Fear, 54 USPQ2d at 1555. Second, a party must establish that providing written responses would impose a significant burden. Id. Third, assuming the first two requirements are met, the inquiring party must not be left with any greater burden than the responding party would have in reviewing and inspecting the produced business records. Id. None of these conditions have been met.

These documents were produced solely in response to Petitioner's First Request for Production of Documents under Fed.R.Civ.Proc. 34. Registrant did not invoke Fed.R.Civ.Proc. 33(d) - explicitly or otherwise - to produce these documents in lieu of providing a written response to Interrogatory No. 23. Registrant did not propose that the answer to Interrogatory No. 23 may be determined by examining, auditing, compiling, abstracting, or summarizing Registrant's business records, whether the documents at issue in Exhibit B or another category of documents. Registrant did not assert that the burden of deriving or ascertaining the answer to Interrogatory No. 23 would be substantially the same for either party, pursuant to Fed.R.Civ.Proc. 33(d).

It is clear from the language of Registrant's response to Interrogatory No. 23 that Registrant did not identify documents known to contain the responsive information, but only referred Petitioner to documents that may contain the responsive information. Furthermore, Respondent did not even attempt to establish that responding to Interrogatory No. 23 would impose a significant burden on Respondent. Finally, it is clear from the face of the Interrogatory that Petitioner would be left with a significantly greater burden than Registrant if forced to review the documents produced by Registrant in order to identify those documents Registrant expects to use, introduce or rely upon at trial. See, e.g., No Fear, 54 USPQ2d at 1555 (responding party will

generally have a lesser burden than inquiring party because of responding party's inherent familiarity with its own records).

Registrant submits that it is not even possible to determine from a review of these documents which documents Registrant expects to "use, introduce or rely upon at the time of trial in this matter". A response to Interrogatory No. 23 involves a legal and strategic determination rather than a factual determination, such as is expected to be determined from a review of business records produced in lieu of responding to an interrogatory. The circumstances in this instance do not trigger Fed.R.Civ.Proc. 33(d) providing for the production of documents in lieu of responding to an interrogatory.

**C. Petitioner Has Not Satisfied the Requirements for a Notice of Reliance Introducing Documents Under 37 CFR 2.120(j)(3)(i).**

Even assuming that the documents submitted by Petitioner as Exhibit B were produced in lieu of responding to an interrogatory, Petitioner has not met its burden to establish such a basis for a notice of reliance. Petitioner has initiated this procedure by specifying in the Notice of Reliance that the documents are being introduced pursuant to Trademark Rule 2.120(j)(3)(i). In addition to specifying the particular interrogatory to which each document was provided in lieu of an interrogatory response, the Petitioner must indicate generally the relevance of the material being offered, and must identify, with some degree of specificity, the nature of each of these documents. M. Tek, Inc., 17 USPQ2d at 1073. Petitioner has not met any of these requirements.

**D. Contents of Exhibit B Are Inherently Inadmissible.**

Furthermore, the documents contained in Exhibit B are inadmissible under the Federal Rules of Evidence. These documents were not authenticated or given proper foundation through the testimony of a competent witness. As explained above, these documents were produced solely in response to requests for production of documents and not as part of any verified statement such as an interrogatory or deposition testimony. These documents are also not public records or reports or otherwise self-authenticating.

**E. Determination Is Proper at this Time.**

Registrant submits that these objections and the basis for a Motion to Strike are not substantive but procedural in nature. As such, it is not necessary to consider the substance of the evidence offered as Exhibit B in Petitioner's FNOR-CI. The only concern here is whether such documents may properly be submitted under a Notice of Reliance and the Board need look no further than the Notice of Reliance itself. Registrant respectfully submits that this procedural issue is appropriate for determination at this time and need to wait for the final hearing.

**3. CONCLUSION.**

Based upon the foregoing, Registrant requests that the Board strike, in part, Petitioner's First Notice of Reliance - Confidential Information, specifically, Petitioner's Exhibit B thereto. Pending the outcome of this Motion to Strike, Registrant requests that any remaining disclosure or testimony periods in this matter be suspended or continued until such time as a decision on this Motion is issued and the dates reset accordingly in such Order.

Dated: March 14, 2013

Respectfully submitted,

KELLY & KELLEY, LLP

*/Michael A. DiNardo/*

MICHAEL A. DiNARDO  
Attorneys for Registrant

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**CERTIFICATE OF ELECTRONIC FILING**

I hereby certify that the above **PARTIAL MOTION TO STRIKE PETITIONER'S FIRST NOTICE OF RELIANCE - CONFIDENTIAL INFORMATION** is being electronically filed with the Trademark Trial and Appeal Board through the Electronic System for Trademark Trials and Appeals ("ESTTA") on March 14, 2013.

*/Michael A. DiNardo/*

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Michael A. DiNardo  
for KELLY & KELLEY, LLP

**CERTIFICATE OF SERVICE**

I hereby certify that I caused a true and correct copy of the attached **PARTIAL MOTION TO STRIKE PETITIONER'S FIRST NOTICE OF RELIANCE - CONFIDENTIAL INFORMATION** to be served on this date via U.S. first-class mail, postage prepaid, upon counsel for Petitioner, as follows:

Matthew H. Swyers, Esq.  
344 Maple Avenue West, Suite 151  
Vienna, VA 22180

*/Nancy Hoover/*

Dated: March 14, 2013

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Nancy Hoover

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