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

Proceeding	92056362
Party	Defendant Milano Bags Inc.
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Date	02/03/2014
Attachments	Response to 2nd MTC.pdf(345397 bytes)

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

Registration No. 4,215,599
For the mark MILANO BAGS,
Registered on the Supplemental Register on September 25, 2012.

Milano Series International Products, LTD.,	:	
Petitioner,	:	
vs.	:	Cancellation No. 92056362
Milano Bags, Inc.,	:	
Registrant.	:	

REGISTRANT'S RESPONSE TO PETITIONER'S SECOND MOTION TO COMPEL DISCOVERY

COMES NOW the Registrant, Milano Bags, Inc. (hereinafter "Registrant"), by counsel, and submits its Opposition and Reply to Petitioner's (hereinafter "Petitioner") motion to compel and extend trial dates stating as follows.

Statement of Facts

1. On or about February 18, 2013 Registrant served its first answers and responses to Petitioner's interrogatories and requests for production of documents.

2. Not satisfied with the responses thereto, Petitioner filed its first motion to compel on or about April 17, 2013.

3. By Order dated July 2, 2013 the Board denied Petitioner's motion for failing to comply with the rules of court. In that Order, however, the Board did take the time to point out several instances where the parties should meet and confer concerning the Petitioner's concerns as to Registrant's responses to Petitioner's discovery.

4. On or about September 4, 2013 at approximately 10:25 a.m. Petitioner and Respondent's counsel held their first meet and confer concerning the Petitioner's concerns. The call was of a brief duration and a subsequent, more extensive call was scheduled to transpire on September 6, 2013.

5. On or about September 6, 2013 counsel for Petitioner and Registrant met again via conference call to discuss Petitioner's concerns regarding Registrant's responses to Registrant's discovery.

6. In total, counsel for Petitioner and Registrant spent over two hours September 6, 2013 discussing Petitioner's concerns in regard to Registrant's answers.

7. Some of the Petitioner's concerns were alleviated by the call wherein the parties agreed the Petitioner's concerns were without merit.

8. Other concerns were discussed wherein counsel for the Registrant agreed to supplement and/or to amend interrogatory answers and/or responses to Petitioner's discovery.

9. Said amendments were made and forwarded to counsel for Registrant within the time frame agreed to by the parties.

10. Thereafter, Petitioner's counsel began efforts to, once again, assert that certain responses were still deficient despite the parties having agreed, on September 6, 2013, as to that which would be amended and/or supplemented.

11. To facilitate a better understanding of Petitioner's continued concerns, Registrant simply requested that Petitioner's counsel annunciate the new issues with Registrant's amended discovery.

12. Initially Petitioner's counsel refused to do so. However, finally agreed to do so thus creating a record of the exact issues Petitioner's counsel then had with Registrant's supplemental responses. Exhibit 1.

13. The instant motion now follows.

Argument as to Motion to Compel

As a threshold issue, the instant motion only addresses Registrant's supplemental answers to interrogatories 2, 3, 12, 16, and 17 as well as supplemental responses to document requests 1, 9, 10, and 11.

Interrogatories 2, 3, 12, and 16

Petitioner's only issue with these answers is that "they do not appear to be accurate" because the individuals named in the responses as "Principals" reside in Peru. In this regard, Petitioner's counsel seemingly is requesting a clarification of an unambiguous response based upon what can only be surmised as disbelief that the Principal of a Florida corporation could actually reside in the country of Peru.

In this regard, Registrant asserts that it has fully and completely answered the questions set forth and that it not be compelled because Petitioner's counsel simply does not understand that a person living in Peru can be a Principal of a Florida corporation.

Interrogatory 17

Petitioner initially states its same issue set forth in connection with interrogatories 2, 3, 12, and 16 in regard to interrogatory 17, namely, that "Identifying individuals residing in Peru as "Principals" does not appear accurate ... [for] a Florida corporation." Registrant herein incorporates its response set forth above in regard to its supplemental responses to interrogatories 2, 3, 12, and 16.

In regard to the identification of Juan Ferriera, Mr. Ferriera was identified to the best of counsel's ability in the response.

Finally, if Opposing counsel wishes for the undersigned to identify himself as assisting in the preparation of these responses, counsel will do so.

Request for Production of Documents 1 and 9

Counsel for the Petitioner has compelled Registrant to produce a written contract between it and a Peruvian company Studio Moda SAC. Petitioner has blinded asserted that Registrant must be compelled to produce the contract assuming that a written contract exists. Nothing in Registrant's cited answers indicates that a writing exists in that regard. As such, Petitioner is moving for an order compelling Registrant to produce a document that may or may not exist. In turn, Registrant has unambiguously stated that it retains no such documents. As such, the instant motion should be denied in regard to these requests.

Request for Production of Documents 10 and 11

The motion concerning documents identified in connection with requests 10 and 11 are due to the alleged inadequate nature of the reproduction of the documents to Petitioner's counsel and Petitioner's request to see the "reverse side" of labels assuming such had printed material thereon.

In regard to the first issue, Registrant will agree to attempt to reproduce better copies to the Petitioner. Those attached to Petitioner's motion are of less quality than those which were forwarded to Petitioner. But Registrant will so agree in the interest of moving this case along and moving past this discovery dispute.

In regard to the "reverse side" of labels, Registrant has produced documents relevant to the instant responses. If the reverse sides were blank they would not be responsive. As such, it is requested that the Board deny this request.

Verification of Interrogatories

Upon examination of the file Petitioner is correct that neither Registrant's answers to Petitioner's interrogatories or supplemental answers to Petitioner's interrogatories were verified. The same will be done in the coming days.

Response to Motion to Extend

Registrant consents to the Petitioner's request to re-set and extend the remaining periods as set forth in Petitioner's motion.

Respectfully submitted this 3rd day of February, 2014.

THE TRADEMARK COMPANY, PLLC
/Matthew H. Swyers/
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Counsel for Registrant

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

Registration No. 4,215,599,
For the mark MILANO BAGS,

Milano Series International Products, Inc.,	:	
Petitioner,	:	
vs.	:	Cancellation No. 92056362
Milano Bags, Inc.,	:	
Registrant.	:	

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that I caused a copy of the foregoing this 3rd day of February 2014, to be served, via first class mail, postage prepaid, upon:

Roberta S. Bren, Esq.
Oblon, Spivak, McClelland,
Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, Virginia 22314

/Matthew H. Swyers/
Matthew H. Swyers

Matthew H. Swyers

From: Robin Bren <RBren@oblon.com>
Sent: Monday, November 04, 2013 6:00 PM
To: mswyers@thetrademarkcompany.com
Cc: Beth A. Chapman; Nicole M. Dyson; 406676US _ MILANO BAGS E_Mails
Subject: Milano Series International Products, Ltd. v. Milano Bags Inc. (MILANO BAGS) [IWOV-iManageDB.FID3578531]

Importance: High

Our Ref: 406676US-10398-35

Dear Matt:

This is further to my October 20, 2013 email again requesting you advise me when you would be available to discuss Milano Bags' Supplemental Responses to Milano Series' First Set of Interrogatories and First Request for Production of Documents. I received no response. We do not believe that your approach is consistent with the directive from the Board.

Initially, we note the following remaining deficiencies.

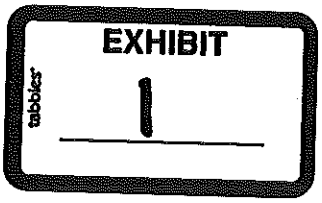
Milano Series' First Set of Interrogatories- to be answered under oath
Both Milano Bags' original Responses and its Supplemental Responses must be signed under oath by an officer of Respondent corporation. You stated in our September 6, 2013 telephone conference that would be done. It was not.

Supplemental Response to Interrogatory No. 2 identifies two persons in Peru by name and as "Principal" being those most knowledgeable about Respondent's marketing, advertising, distribution and sale of its products under its mark. This title is unclear in terms of Respondent, Milano Bags Inc., a corporation of Florida. If the individuals identified are officers of Milano Bags, Inc., please provide their titles. If the individuals are principals of a different entity/company, please identify the entity/company.

Supplemental Response to Interrogatory No. 3 identifies two persons in Peru by name and as "Principal" being those who conceived of Respondent's mark. This title is unclear in terms of Respondent, Milano Bags Inc., a corporation of Florida. If the individuals identified are officers of Milano Bags, Inc., please provide their titles. If the individuals are principals of a different entity/company, please identify the entity/company.

Supplemental Response to Interrogatory No. 12 identifies two persons in Peru by name and as "Principal" being those most knowledgeable about any market research conducted by or on behalf of Respondent. This title is unclear in terms of Respondent, Milano Bags Inc., a corporation of Florida. If the individuals identified are officers of Milano Bags, Inc., please provide their titles. If the individuals are principals of a different entity/company, please identify the entity/company.

Supplemental Response to Interrogatory No. 16 identifies two persons in Peru by name and as "Principal" being those who participated in creating or distributing advertisements or promotions for Respondent's products under its mark. This title is unclear in terms of Respondent, Milano Bags Inc., a corporation of Florida. If the individuals identified are officers of Milano Bags, Inc., please provide their titles. If the individuals are principals of a different entity/company, please identify the entity/company. Further, the Interrogatory requests the period of time during which each person participated in such activities, to which there is no response.



Supplemental Response to Interrogatory No. 17 identifies two persons in Peru by name and as "Principal" being those who supplied documents or information or participated in responding to Milano Series' First Set of Interrogatories and First Request for Production. This title is unclear in terms of Respondent, Milano Bags Inc., a corporation of Florida. If the individuals identified are officers of Milano Bags, Inc., please provide their titles. If the individuals are principals of a different entity/company, please identify the entity/company.
Also, the Supplemental Response identifies a third person, but no title or position was provided for him.
Further, the "counsel" referred to in Respondent's original response to Interrogatory No. 17 are not identified.

Supplemental Response to Request for Production No. 1 requesting each document, thing, or electronically stored information (hereinafter "document") identified in response to Petitioner's First Set of Interrogatories states "None" when Respondent's original and supplemental response to Interrogatory No. 1 both refer to a contract between Studio Moda SAC and Respondent, Milano Bags Inc.

Supplemental Response to Request for Production No. 9 requesting each document referring to any assignment, etc. granted to Respondent to use the mark MILANO BAGS. Respondent states "None" when Respondent's original and Supplemental Response to Interrogatory No. 1 both refer to a contract between Studio Moda SAC and Respondent, Milano Bags Inc., regarding use of the mark in the United States.

Supplemental Response to Request for Production No. 10 requesting representative sample labels, tags, packaging, etc. for Respondent's products that bear Respondent's mark. Respondent states: "000008-000037, 000045-000072." Each of Respondent's documents numbered 000023, 000050, 000054 - 000060, 000064 and 000072 are illegible. Legible copies are requested. For all documents which are labels, tags, etc. , the reverse side of each such label, tag, etc. should be provided. (For example, documents numbered 000021, 000061, 000067, and 000069 – 000072.)

Supplemental Response to Request for Production No. 11 requesting representative specimens of current and/or proposed advertising or promotional documents and electronic media that bear Respondent's mark. Respondent states: "000008-000016, 000020 – 000034, 000054 – 000067, 000072." As above, Respondent's documents numbered 000023, 000050, 000054 - 000060, 000064 and 000072 are illegible. Legible copies are requested. For all documents which are labels, tags, etc. , the reverse side of each such label, tag, etc. should be provided. (For example, documents numbered 000021, 000061, 000067, and 000069 – 000072.)

We look forward to receiving your substantive response to the above by November 15, 2013. If you are not able to provide the requested information and documents by then, please let us know by return email when you expect to do so. In the meantime, kindly also confirm receipt of this email by return email.

Regards, Robin

Robin Bren
Oblon Spivak
703-412-6413