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

Proceeding	92057344
Party	Defendant Racemi, Inc.
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Attachments	Racemi Response 92057344_1.PDF(331583 bytes )

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

Cloudpath Networks, Inc.,	§	
	§	Cancellation No. 92057344
Petitioner,	§	(Registration No. 4,174,640)
	§	
vs.	§	
	§	
Racemi, Inc.,	§	
	§	
Registrant.	§	
	§	

**REGISTRANT’S RESPONSE TO PETITIONER’S  
MOTION TO COMPEL DISCOVERY**

Registrant, Racemi, Inc., hereby responds to *Cloudpath’s Motion to Compel Discovery* (the “Motion”) filed December 3, 2013, by Petitioner Cloudpath Networks, Inc. In doing so, Registrant will demonstrate that:

- (1) Registrant is entitled to a reasonable period of time after October 25, 2013 to identify, collect, process and produce its documents in response to Petitioner’s requests for production served September 20, 2013;
- (2) No such reasonable period of time had expired as of Petitioner’s December 3, 2013, motion to compel, and Registrant has neither refused to produce the responsive documents nor otherwise acted in any way which supports Petitioner’s request for an order compelling discovery; and
- (3) Petitioner’s request for sanctions is not only unsupported by the facts but also is procedurally premature.

Accordingly, Petitioner’s Motion should be denied.

## I. The Status of Discovery in This Proceeding

In this proceeding, Petitioner seeks the cancellation of Registrant's Service Mark Registration No. 4,174,160 of the service mark CLOUD PATH. Pursuant to the Board's scheduling order of June 18, 2013, the deadline for Registrant's responsive pleading was Sunday, July 28, 2013. Without any delay whatsoever, and without any request for any extension of time, Registrant timely filed and served its responsive pleading on Monday, July 29, 2013.

Pursuant to that same scheduling order, the deadline for the parties' discovery conference was August 27, 2013, and that conference was conducted on August 27, 2013, such that there was no delay or extension requested by Registrant. In that conference, the parties' counsel agreed that, notwithstanding their contemporaneous agreement to accept email service of discovery-related materials, the deadline for discovery responses would remain as that deadline would be for discovery requests served via regular mail, *i.e.*, 35 days (30 days + 5 days).

Also pursuant to the Board's scheduling order, the discovery period in this proceeding opened August 27, 2013, and closes (unless extended) on February 23, 2014. On September 20, 2013, Petitioner served its first sets of interrogatories and requests for production. The deadline for Registrant's responses to those discovery requests was 35 days later, *i.e.*, October 25, 2013.<sup>1</sup> On October 25, 2013, Registrant, without needing, requesting or obtaining any extension of that deadline, served by mail its responses to all 22 interrogatories (not counting the additional subparts to those interrogatories) and all 34 requests for production. Neither in the Motion nor in any other communication has Petitioner asserted any challenge to the sufficiency of the substance of any of Registrant's 56 responses to Petitioner's interrogatories and requests for production.

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<sup>1</sup> In its Motion, Petitioner states incorrectly or, at best, in a misleading manner, that Registrant's response "was due October 20, 2013" but was "extended to October 25, 2013." (Motion, p. 1)

In the preamble of its September 20, 2013, requests for production, Petitioner purported to require unilaterally that Registrant not only respond but also fully produce documents “within thirty (30) days of service hereof,” *i.e.*, produce such documents on or before October 20, 2013 – 5 days before the October 25 deadline for Registrant’s responses. Accordingly, in Paragraph 4 of Registrant’s *General Objections* to the requests for production, Registrant timely and clearly asserted its objection to the putative October 20 deadline for production (“Racemi objects to the putative requirement that it produce fully all responsive documents within thirty (30) days of [the September 20, 2013] service of the requests for production.” *Registrant’s Responses to Petitioner’s First Set of Requests for Production*, p. 2.)

As will be reflected hereinafter, Registrant is entitled to a reasonable period of time to identify, collect, process and produce the documents which, in its October 25, 2013, response, it indicated will be produced. Ignoring that well-recognized principle, Petitioner erroneously asserted on November 11, 2013, that Registrant was obligated to complete the identification, collection, processing and production of all such documents by October 25, 2013. Why? --- Simply because it said so! (Motion, Exh. C) Registrant’s counsel promptly responded by pointing out the incorrectness of Petitioner’s contention. (Motion, Exh. C) In doing so, Registrant’s counsel indicated that, at that time (November 11, 2013) he expected to receive Registrant’s first wave of documents during the Thanksgiving week, November 25-29. (Motion, Exh. C)<sup>2</sup> Petitioner’s counsel converted that statement of Registrant’s counsel’s good faith estimate into a unilaterally imposed ultimatum that production be completed by the Friday of

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<sup>2</sup> In its Motion, Petitioner states incorrectly or, at least, in a misleading manner, that “Registrant...refused to produce any documents by the November 29 deadline that it [*i.e.*, Registrant] had indicated as a deadline for [its] production.” (Motion, p. 2) It is rather disingenuous to characterize the good faith November 11 statement voluntarily provided by Registrant’s counsel as to his expectation of when the documents would be collected and served as an agreed “deadline” for identifying, collecting, processing and serving those documents.

Thanksgiving week, November 29. (Motion, Exh. E) Thus, on Tuesday, December 3, the second business day following the Thanksgiving holidays, Petitioner filed its Motion.

**II. Rule 34 Does Not Set a Deadline for Document Production –  
Registrant Is Entitled to a Reasonable Period of Time  
After October 25 to Produce Responsive Documents**

Petitioner’s motion is grounded on the assertion that Registrant was *obligated* to produce all responsive documents by either October 20, 2013 (30 days after service of the requests) or October 25, 2013 (the date asserted as the deadline in Petitioner’s counsel’s email of November 11, 2013). (Motion, Exh. C) Although the Motion does not refer to Rule 34, F.R.Civ.P., or otherwise state the legal basis for that assertion, it must be assumed that the Motion is grounded on Rule 34.<sup>3</sup>

However, Rule 34 is essentially silent as to the deadline on which a party must produce responsive documents, particularly when that party has timely objected to the deadline for production set unilaterally by the party serving the requests for production. Instead, Rule 34(b)(2)(A) requires only that the responding party must “respond in writing” within 30 days of service,<sup>4</sup> and Rule 34(b)(2)(B) requires that each separate response must either include appropriate objections and/or state that inspection “will be permitted” at some time in the future.<sup>5</sup> The phrase “will be permitted” in Rule 34(b)(2)(B) obviously contemplates production subsequent to the deadline for such responses. Moreover, not only is it extremely common for a

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<sup>3</sup> Rule 34(b), F.R.Civ.P., provides, in relevant part:

(2) **Responses and Objections.**

- (A) *Time to Respond.* The party to whom the request is directed must respond in writing within 30 days after being served. A shorter or longer time may be stipulated to under Rule 29 or be ordered by the court.
- (B) *Responding to Each Item.* For each item or category, the response must either state that inspection and related activities will be permitted as requested or state an objection to the request, including the reasons.

<sup>4</sup> See n. 3 *infra*.

<sup>5</sup> See n. 3 *infra*.

party's document production to occur subsequent to the service of its discovery responses, that is the normal, traditional practice.

Of course, a party does not have an infinite period of time after serving its written responses in which to identify, collect, process and produce its responsive documents. Instead, the courts, the Board, and most parties apply a rule of reasonableness in setting such a "deadline." As such, in determining the reasonableness of the period of time after serving written responses, the courts, the Board, and (in most instances) the parties take into consideration such factors as the scope of the requested document production, the resources available at that time to the responding party, and the stage of the proceeding and remaining length of time in which to complete discovery. Such a practice and application of Rule 34 has been recognized often. *See, e.g., Keith v. Mayes*, 2010 WL 3339041 (S.D. Ga. 2010), in which a plaintiff's motion to compel was denied after the defendants timely responded to the requests for production and the plaintiff failed to afford the defendants "a **reasonable amount of time** to gather and mail the requested documents" before the plaintiff filed his motion to compel because the requested documents were not produced within 30 days of the discovery requests, a "deadline" which had been set unilaterally by the plaintiff. *See also, L.H. v. Schwarzenegger*, 2008 WL 2073958, p. 5 (E.D. Cal. 2008):

Rule 34 requires a written *response* [emphasis in original] within 30 days after being served, but provides nothing express about the time at which actual production shall take place. The rule merely implies that the response will address the production time set forth in the response.

\* \* \*

Since plaintiffs did not provide a time for actual production, a **reasonable time** [emphasis added] is presumed, and defendants' production of the majority of documents by April 18, 2008 is considered a **reasonable time** [emphasis added] frame.

\* \* \*

Since defendants responded [in writing] timely under Rule 34, and made actual production within a **reasonable time** thereafter, their actions were substantially justified.

Accordingly, Registrant is entitled to a reasonable period of time after October 25 to produce its responsive documents.

**III. The Mere Fact That Registrant's Responsive Documents Were Not  
Produced Within 39 Days of Its Responses Does Not  
Warrant an Order Compelling Production**

Considering the foregoing, the only facts on which Petitioner can purport to rely, in support of a contention that its December 3 motion should be granted, would be that, in light of the scope of its discovery requests and the stage of this proceeding, 39 calendar days is an unreasonably lengthy period of time for Registrant to identify, collect, process and produce all of the documents which it indicated, in its October 25 responses, that it will produce. The Board need only peruse the scope of those requests and the description of documents to be produced, as set forth in Exhibit D to the Motion, to appreciate the relative burdensomeness of the requests and required production. The fact that the identification, collection, processing and production of all such documents was not completed in 5 weeks (October 25 to November 29) should not be surprising or perplexing. Further, the fact that such production was not completed in the 39 days extending from the October 25 responses to the December 3 Motion does not threaten any delay in this proceeding, especially with the initial unextended discovery period not ending until February 23, 2014. Accordingly, although it is Petitioner's burden to demonstrate that, on December 3, it was then entitled to an order compelling discovery, Petitioner does not demonstrate in its Motion or its supporting papers that, as of December 3, Registrant's production had been delayed unreasonably. Thus, the December 3 Motion should be denied.<sup>6</sup>

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<sup>6</sup> If the Board accepted Petitioner's invitation to enter orders compelling discovery under circumstances similar to those present in this case, the Board would be inviting parties to proceedings before it to routinely purport to impose

**IV. Petitioner’s Request for Various “Sanctions” Is Not Only  
Unsupported By the Facts of This Case But  
Also Is Procedurally Improper**

In addition to prematurely seeking an order compelling discovery, Petitioner asks the Board to enter various sanctions against Registrant for not having produced all responsive documents within 39 days after serving its responses. More particularly, Petitioner requests that the Board “order that Registrant has forfeited its right to object to discovery on the merits.” (Motion, pp. 2-3) In support of this request, Petitioner asserts the absurd, *i.e.*, that Registrant has “refused to produce any documents in [sic, response to] the ‘First Request for Production of Documents.’” (Motion, p. 2) As can be seen from the materials submitted by Petitioner with its Motion, there has been no such refusal at any time. In support of its request, Petitioner also asserts that Registrant’s timely October 25 responses, without being accompanied by a contemporaneous production of documents, “constitutes failure to respond to a discovery document request during the time allowed.” (Motion, p. 3) As reflected in the cases cited hereinabove, there is no factual or legal support for Petitioner’s position.

Further, Petitioner also asserts that the so-called “preclusion sanction” should be applied, so that Registrant is “precluded from relying on such documents or information and from offering testimony with regard thereto during its testimony period.” (Motion, p. 3) Not only does the case cited by Petitioner<sup>7</sup> not support a request for sanctions in this case, but also Petitioner ignores the well-recognized principle that, unless a party indicates that it will not respond to discovery, no sanctions of any kind are available for an alleged failure to provide discovery without the movant first obtaining an order compelling that discovery. *See, e.g.*,

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and enforce document production deadlines on, or unreasonably soon after, the response deadlines, with the obvious result that such unilateral deadlines would not be satisfied, and numerous similar premature motions to compel likely would have to be handled more frequently by the Board.

<sup>7</sup> *Weiner King, Inc. v. The Weiner King Corp.*, 615 F.2d 512, 204 USPQ 820 (CCPA 1980).

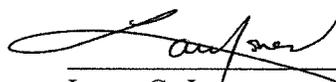
*Nobelle.com LLC v. Quest Communications International Inc.*, 66 USPQ2d 1300, 1303 (request to preclude party from submitting trial evidence as a sanction for its alleged failure to comply with discovery obligations was procedurally baseless where no discovery order was violated or even issued). *See also Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC*, 88 USPQ2d 1541, 1543 (TTAB 2008) (sanction premature without preceding order compelling discovery). Thus, Petitioner's request for sanctions is both factually and procedurally baseless.

### V. Conclusion

Registrant is entitled to a reasonable period of time after October 25, 2013 in which to produce its documents, and Petitioner has failed to satisfy its burden of demonstrating that, by December 3, 2013, that reasonable period had expired. Thus, Petitioner has not demonstrated its entitlement, as of December 3, to an order compelling production. Moreover, Petitioner's requests for various sanctions are both factually ill-founded and procedurally baseless. Accordingly, Petitioner's motion should be denied.

Dated: December 20, 2013

Respectfully submitted,



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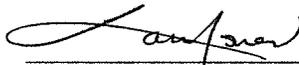
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CERTIFICATE OF SERVICE

I hereby certify that the foregoing "Registrant's Response to Petitioner's Motion to Compel Discovery" was duly served on Petitioner via email as shown below on December 20, 2013, pursuant to an agreement between the parties to serve all discovery-related documents electronically:

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