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Filing date: **07/09/2015**

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

Proceeding	92057941
Party	Defendant Barnaby Heating & Air
Correspondence Address	JULIE CELUM GARRIGUE CELUM LAW FIRM PLLC 11700 PRESTON RD, SUITE 660 PMB 560 DALLAS, TX 75230 UNITED STATES jcelum@celumlaw.com
Submission	Opposition/Response to Motion
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Date	07/09/2015
Attachments	RESP.'S MOTION TO REOPEN & DECL .pdf(240042 bytes) EXHIBIT 1 - 6 CELUM DECL.pdf(2668056 bytes) EX. 7 - 10 CELUM DECL.pdf(1157756 bytes)

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

In the Matter of Trademark Registration No. 3,618,331

Registration Date: May 12, 2009

Mark: COMFORTCLUB

Clockwork IP, LLC)	
)	
Petitioner)	
)	
v.)	Cancellation No. 92057941
)	
BARNABY HEATING & AIR, LLC)	
)	
Respondent.)	

**RESPONDENT’S MOTION TO REOPEN OR TO WITHDRAW
OR AMEND PETITIONER’S REQUESTS FOR ADMISSION NOS. 36 – 45**

Registrant, Barnaby Heating & Air, LLC (“Barnaby”) by and through counsel, moves for relief: (1) pursuant to Fed. R. Civ. P. 6(b)(2), to reopen time to respond to Petitioner’s Requests for Admission Nos. 36 – 45, because any failure by Respondent to timely respond was caused by Petitioner, and squarely demonstrates excusable neglect, or (2) pursuant to Fed. R. Civ. P. 36(b) and Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) §525, to withdraw or amend the so-called “deemed admissions.”

The subject Requests for Admission Nos. 36 – 45 are not “admissions,” because

Petitioner failed to serve Nos. 36 – 45 when Petitioner served Nos. 1 – 35. The bulk of Petitioner’s Motion for Summary Judgment is based upon these “admissions,” and these Requests relate directly to Respondent’s affirmative defenses in this matter. The grounds for this motion are set forth in the accompanying memorandum and supporting declaration.

Filed via ESTTA: July 9, 2015

Respectfully submitted,

Barnaby Heating & Air, LLC

// Julie Celum Garrigue //

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **RESPONDENT’S MOTION TO REOPEN OR TO WITHDRAW OR AMEND PETITIONER’S REQUESTS FOR ADMISSION NOS. 36 – 45** was filed on July 9, 2015 and forwarded to counsel for Petitioner and counsel for Co-Respondent, this 9th day of July 2015, by email and by sending the same via first class mail:

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Counsel for Co-Respondent,
McAfee Heating & Air Conditioning, Inc.

// Julie Celum Garrigue //

JULIE CELUM GARRIGUE

**IN THE UNITED STATES PATENT & TRADEMARK OFFICE
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BARNABY HEATING & AIR, LLC)	
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Respondent.)	

**MEMORANDUM IN SUPPORT OF RESPONDENT’S
MOTION TO REOPEN OR TO WITHDRAW OR AMEND ADMISSIONS NOS. 36 – 45**

Respondent, Barnaby Heating & Air, LLC, asks the Board to reopen discovery and grant Respondent additional time to respond to Petitioner’s Requests for Admission Nos. 36 – 45. A true and correct copy of Respondent’s Objections and Responses to Petitioner’s Requests for Admission Nos. 36 – 45 are attached hereto as Exhibit 1. (See Exhibit 1 of Celum Decl.)

I. FACTUAL BACKGROUND

1. On May 12, 2009, Respondent, as rightful owner of the COMFORTCLUB Mark, was issued U.S. Registration No. 3,618,331 for its COMFORTCLUB Mark following the submission of its March 13, 2008 application to register the COMFORTCLUB Mark, for

“prepaid preventative maintenance service plans for heating, ventilating and air conditioning systems” in International Class 36, U.S. Application Serial No. 77/420,784, as available on the U.S. Patent and Trademark Office’s (“USPTO’s”) Trademark Status & Document Retrieval (“TSDR”) website. (Exhibits 2 and 3 to Celum Decl. at ¶¶3 and 4.)

2. On September 30, 2014, Respondent assigned all right title and interest to the COMFORTCLUB Mark to its Co-Respondent, McAfee Heating & Air Conditioning, Inc., which Assignment was recorded at the U.S. Patent & Trademark Office on October 14, 2014. (Exhibits 4 and 5 to Celum Decl. at ¶6.) On September 30, 2014, Respondent was granted an exclusive license for its continued use of the COMFORTCLUB Mark, which License provides Respondent the right to prosecute and defend this cancellation proceeding. (See Exhibit 6 to Celum Decl. at ¶¶5 and 6.)

3. On September 27, 2013, prior to the Assignment and License, Petitioner moved to cancel Respondent’s registration on the basis of likelihood of confusion and fraud. (Dkt. # 1 at pp. 1 and 6 – 9.)

4. On November 6, 2013, Respondent filed its Answer, acknowledging it is the rightful owner of the COMFORTCLUB Mark, denying Petitioner’s claims, and asserting various enumerated Affirmative Defenses to Petitioner’s claims, including the affirmative defenses of: (1) Petitioner’s Failure to State a Claim, (2) Respondent’s Priority, (3) Respondent’s Fair Use, (4) Petitioner’s claims are barred by the Statute of Limitations, (5) Petitioner’s claims are barred by the equitable doctrines of Estoppel, (6) Petitioner’s claims are barred by Laches, (7) Petitioner’s Claims are barred by Petitioner’s Acquiescence, (8) Respondent has No Liability and has not committed, and is not now committing, fraud or any other act to support the cancellation of Respondent’s Mark, or give rise to any liability to Clockwork, (9)

that Petitioner Lacks Standing, (10) that Petitioner's claims are barred by Non-Use and Abandonment, and (11) any additional affirmative defenses that Respondent may have against Petitioner's claims that were not known at the time Respondent's answer was filed. (Dkt. # 4; *see also* Celum Decl. at ¶ 11.)

5. On May 26, 2015, Petitioner moved for judgment on the pleadings, claiming Respondent's "admissions" to Nos. 36 – 45, "conclusively establish" Respondent committed fraud when procuring its registration for its COMFORTCLUB Mark and that Petitioner is entitled to judgment as a matter of law as Respondent's mark is void ab initio. (*See* Dkt. # 1 at p. 8 para. 34 and Dkt. # 22, Pet.'s Memo at p. 2 INTRODUCTION para.)

6. Discovery in this case opened on December 6, 2013 and closed on June 4, 2014. (*See* Dkt. # 2.) Though the parties hotly contest when Petitioner's discovery requests were actually served, on June 30, 2014, Respondent received Petitioner's discovery requests, which included 90 Requests for Production of Documents, 27 Interrogatories, and 35 Requests for Admission. (*See* Dkt. # 13 at p. 6, *see also* Exhibit I to Purvi Decl.; and Exhibits 9 and 10 to Celum Decl. at ¶¶ 10 - 12.)

7. Petitioner failed to serve Respondent with the effective admissions when it served discovery in this case. (*Id.*) Petitioner only served Nos. 1 – 35. (*Id.* at ¶¶ 8 - 16.)

8. Today, July 9, 2015, Respondent serves its First Objections and Responses to Petitioner's Requests for Admission Nos. 36 – 45 by copy of this Motion. (*See* Exhibit 1 to Celum Decl.)

II. LAW AND ARGUMENT

If a party on which requests for admission have been served fails to timely respond thereto, the requests will stand admitted by operation of law unless the party is able to show that

its failure to timely respond was the result of excusable neglect. Fed. R. Civ. P. 6(b)(1)(B); *see Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1307 (TTAB 2007) (counsel’s mistaken belief that opposing counsel would grant an extension for responding to admissions did not constitute excusable neglect to reopen time to respond under Fed. R. Civ. P. 6(b)). The determination of whether a party’s neglect is excusable takes into account all of the relevant circumstances, including:

- (1) the danger of prejudice to the nonmovant, (2) the length of delay, (3) the reason for the delay, including whether it was within reasonable control of the movant, and (4) whether the movant acted in good faith.

Pioneer Invest. Servs. Co. v. Brunswick Assoc. L.P., 507 U.S. 380, 395 (1993) (as discussed by the Board in *Pumpkin, Ltd. v. Seed Corps*, 43 USPQ2d 1582 (TTAB 1997).

As this Board has previously ruled, “the third Pioneer factor, namely the reason for the delay and whether it was within the reasonable control of the movant, might be the considered the most important factor in a particular case.” (Dkt. # 16 at p.7) (*citing Pumpkin*, 43 USPQ2d at 1586 n.7.) Respondent has conclusively established that Petitioner caused any delay, and not Respondent. (*See Celum Decl.* at 1-16.)

Petitioner only served 35 Requests for Admission on June 30, 2015. (*See Celum Decl.* at ¶¶ 8-16.) By correspondence dated September 10, 2014, Petitioner’s counsel represented in writing that it served Respondent with 35 requests for admission. (Exhibit 8 to *Celum Decl.* at ¶9.) On November 6, 2014, Petitioner affirmed that it served 35 requests for admission. (Dkt. # 13 and Exhibit 9 to *Celum Decl.*)

In Petitioner’s Motion to Compel, filed November 6, 2014, Petitioner again affirmed, “Petitioner’s Discovery Requests consist of 26 interrogatories, 90 requests for production, and 35 requests for admission.” (Dkt. # 13 at p. 6; *see also* Exhibit 8 to *Celum Decl.* *Purvi Decl.* at

Exhibit I.) In that same motion, Petitioner also affirmed that it served “over 150 interrogatories, requests for production and requests for admission on Respondent” (Dkt. # 13 at p. 1) and that Respondent responded to “all 151 of Petitioner’s Discovery Requests...” (*Id.* at p. 15).

On May 26, 2015, Petitioner moved for summary judgment based upon Respondent’s failure to provide responses to Petitioner’s Requests for Admission Nos. 36 – 45, and argues that, as a result, Respondent has waived its Affirmative Defenses Nos. 8 – 11 and that Respondent “admitted” it committed fraud in procuring its Registration for the COMFORTCLUB Mark. (Dkt. # 22 at pp. 13-14.)

It was not until after Respondent received Petitioner’s summary judgment motion that Respondent became aware that Petitioner believed the subject requests for admission nos. 36 – 45 were never answered, resulting in their deemed admission. (Exhibit 7 to Celum Decl. at ¶ 8.) Respondent has served multiple sets of supplemental or amended objections and responses to Petitioner’s discovery in this case. It makes little sense that Respondent would respond to 80 percent of Petitioner’s requests for admissions and intentionally disregard the rest. Given the sworn statements made by Petitioner in its Motion to Compel, and in signed correspondence between counsel, Respondent should be granted additional time to serve responses to Petitioner’s Requests for Admission Nos. 36 –45 as the result of excusable neglect. (Dkt # 13 at pp. 2, 7, and 16 and Purvi Decl. at Exhibit I.)

Alternatively, Respondent moves to withdraw or amend the admissions pursuant to Fed. R. Civ. P. 36(b) because the merits of this case will be subserved by allowing amendment or withdrawal. *See Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1307 (TTAB 2007) (finding merits of action subserved by withdrawal of admissions and replacement with later served responses and finding no prejudice to petitioner under Fed. R. Civ. P. 36(b)); *Hobie*

Designs Inc. v. Fred Hayman Beverly Hills Inc., 14 USPQ2d 2064, 2065 (TTAB 1990) (“...where failure to timely respond to a request for admission has harsh result, Rule 36(b) provides method for obtaining relief.”); *see also American Automobile Ass'n (Inc.) v. AAA Legal Clinic of Jefferson Crooke, P.C.*, 930 F.2d 1117, 19 USPQ2d 1142, 1144 (5th Cir. 1991) (court may not sua sponte withdraw or ignore admissions without a motion to withdraw or amend). The Board should permit a deemed admission to be withdrawn or amended when (1) the movant shows that the presentation of the merits of the action will be promoted and (2) the nonmovant does not show that it will be prejudiced in maintaining or defending the action on the merits. Fed. R. Civ. P. 36(b); *Kerry Steel, Inc. v. Paragon Indus., Inc.*, 106 F.3d 147, 154 (6th Cir. 1997); *Hadley v. United States*, 45 F.3d 1345, 1348 (9th Cir. 1995).

May 26, 2015, in direct contradiction previous sworn statements that it served 35 Requests for Admission, Petitioner’s “new” counsel filed a Motion for Summary Judgment and swore that Respondent was served with 45 Requests for Admission. (*See* DeFord Decl. in support of Petitioner’s Motion for Summary Judgment.) After receiving the motion Barnaby’s counsel emailed Petitioner’s counsel, Brad Newberg, and confronted Petitioner’s counsel about Nos. 36 – 45 and provided counsel with multiple, specific references, wherein Petitioner’s former counsel represented serving 35 Requests for Admission. (Exhibit 7 to Celum Decl.)

Rule 36(b) "emphasizes the importance of having the action resolved on the merits, while at the same time assuring each party that justified reliance on an admission in preparation for trial will not operate to his prejudice." FED. R. CIV. P. 36(b) note (emphasis added). Petitioner’s pretrial disclosures are not yet due and the testimony period has not yet opened. (Dkt. # 19.) *See Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064, 2065 (TTAB 1990) (motion to withdraw admissions granted when propounding party’s testimony period had not yet

opened). As this Board has stated, “[i]n making [the Rule 36(b)] determination, it is important to keep in mind that the resolution of an action on the merits whenever possible is a basic tenet underlying the Federal Rules of Civil Procedure.” *Brown & Bigelow, Inc. v. Freeflight, Inc.*, Opp. No. 102448, 1999 TTAB LEXIS 305, at *2 (T.T.A.B. July 7, 1999) (citing *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 U.S.P.Q.2d 1719, 1720 (T.T.A.B. 1989) (motion to withdraw admissions granted when case was still in pretrial stage).

Petitioner’s Requests Nos. 36 – 45 serve as the basis for its summary judgment motion, and go to core factual and legal issues of Respondent’s defenses to Petitioner’s claims. (See Celum Decl. at ¶¶ 10 - 16). To support a finding that the presentation of the merits of an action will be subverted by withdrawal or amendment of admissions, the Board consistently requires only that the "admissions" to be withdrawn go to the core factual and legal issues of the opposer's claim. *Brown & Bigelow*, 1999 TTAB LEXIS 305, at *3; *Johnston Pump*, 13 U.S.P.Q.2d at 1721. In *Brown & Bigelow*, the Board cited the importance of deciding actions on their merits, and held that “[u]nder the first part of the test, it is clear that if the admissions are allowed to stand, applicant, having admitted to essentially every factual element of opposer's Section 2(d) claim, would have no hope of succeeding on the merits of the case. Thus, the first part of the test has been satisfied.” *Id.* at *3 (emphasis added). *Johnston Pump* involved an even more extreme factual predicate for a motion to withdraw: after the opposer admitted it had not used the mark in question in plain type, one of its employees "remembered" that the opposer in fact had used the mark in plain type, so the opposer moved to withdraw the admission. 13 U.S.P.Q.2d at 1719-20.

Respondent provides objections and responses to Petitioner's requests for admissions Nos. 36 – 45 herewith, and respectfully requests the Board allow such responses, so that this

action may be decided on the merits. In this case, as in *Brown & Bigelow* and *Johnston Pump, supra*, Barnaby's alleged "admissions" go to the necessary elements of Petitioner's claims of fraud and likelihood of confusion and, indeed, form nearly the entire basis for its summary judgment motion. (See Dkt. # 22, Pet's Mot. for Summary Judgment.) (citing Barnaby's alleged admissions that, for example: that Barnaby's Eighth Affirmative Defense that it has not committed, and is not now committing fraud...is without merit and unsupported by evidence; that Barnaby's Ninth Affirmative Defense that Petitioner lacks standing is without merit and unsupported by evidence; that Respondent's COMFORCLUB Mark should be cancelled; that Petitioner's Petition to Cancel should be granted on the basis of fraud. (*See id.*))

Here, as in the above-cited cases, allowing Barnaby to fairly meet the substance of these requests for admission, which relate to Respondent's affirmative defenses and the factual elements of Petitioner's claims, would "enhance the development of the merits of the case." Barnaby stands ready to do so, by way of the attached responses. Therefore, under the TTAB's prior decisions, withdrawal or amendment of Barnaby's "admissions" would subserve the presentation of the merits in this case.

Federal Rule of Civil Procedure 36(b) and TBMP § 525 place the burden on Petitioner to demonstrate that it would be prejudiced by withdrawal. FED. R. CIV. P. 36(b); TBMP § 525 ("The Board . . . may permit withdrawal . . . of an admission when the . . . propounding party fails to satisfy the Board that withdrawal . . . will prejudice said party in maintaining its action or defense on the merits.") The concept of prejudice, in this regard, does not simply mean that the party who obtained the admissions will now have to prove the previously admitted facts, but rather refers to the special difficulty a party may face in proving its case, *e.g.*, if key witnesses or evidence has become unavailable, or if there is insufficient time before trial for that party to

obtain the necessary evidence or witnesses. Thus, although applicant cannot be excused for failing to respond within the time allowed for such response, it is clear that the interests of justice are best served by accepting applicant's late-filed responses and allowing a disposition on the merits. *Brown & Bigelow*, 1999 TTAB LEXIS 305, at *3-4; *see also Newman v. Unlimited Concepts, Inc.*, Cane. No. 24265, 1997 TTAB LEXIS 28, at *3-4 (T.T.A.B. Oct. 9, 1997).

As set forth above, since as early as September 2014, Petitioner made repeated representations that it served Respondent with 35 requests for admission. The Board may permit Respondent to withdraw or amend any "admissions" it is deemed to have made due to the passage of the time in which to respond if the "presentation of the merits of the action will be subserved" by the withdrawal or amendment, and if Petitioner fails to "satisfy the [Board] that withdrawal or amendment will prejudice [Petitioner] in maintaining the action or defense on the merits." FED. R. CIV. P. 36(b); TBMP § 525. "[C]ourts have substantial discretion in deciding whether to allow withdrawal of an admission." *Monster Cable Prods. Inc. v. Bettes*, Opp. No. 116757, 2002 TIAB LEXIS 554, at *4-5 (T.T.A.B. Aug. 29, 2002).

Here, Petitioner filed his motion for summary judgment after the discovery period closed. (See Dkt. # # 18-19.) Petitioner's pre-trial deadline was May 30, 2105 and its thirty-day testimony period was not scheduled to close until July 14, 2015, both of which deadlines will be extended given the pendency of Petitioner's summary judgment motion. (*Id.*) While Petitioner relied on Respondent's effective admissions in preparing its motion for summary judgment, such reliance does not rise to the level of prejudice as contemplated under Rule 36(b). *See Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1307 (TTAB 2007) (*citing FDIC v. Prusia*, 18 F.3d 637 (8th Cir. 1994) (holding that the preparation of the summary judgment motion does not constitute "prejudice" to preclude grant of a motion to withdraw admissions)).

Barnaby has already served its responses to Petitioner's requests for admissions Nos. 1 – 35 and serves its responses to Petitioner's requests for admission Nos. 36 – 45, which are in fact set forth in Exhibit 1 to Celum Decl., attached to this motion. In any event, in this pre-trial stage, the discovery period can easily be re-opened or extended as needed to allow Petitioner to complete any necessary additional discovery. Barely one month has elapsed since Petitioner's summary judgment motion; Petitioner can make no argument that evidence or witnesses have become unavailable in that short amount time. Moreover, Petitioner cannot argue that any delay in Barnaby's response has prejudiced Petitioner, since the delay was of Petitioner's own making.

III. CONCLUSION

In sum, because the “admissions” were the result of an error originating with Petitioner, because they go to the core facts and elements of Petitioner's claims and Respondent's defenses, and because Petitioner will be unable to show prejudice, the Board should reopen discovery or permit Barnaby to withdraw any “admissions” it is deemed to have made, or to amend those “admissions” to conform to those set forth in Exhibit 1, so that the parties may litigate this case on its merits. For these reasons, Respondent asks the court to reopen time, or permit Respondent to withdraw or amend deemed admissions.

Filed via ESTTA: July 9, 2015

Respectfully submitted,

Barnaby Heating & Air, LLC

// Julie Celum Garrigue //

JULIE CELUM GARRIGUE

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Counsel for Respondent,
Barnaby Heating & Air, LLC

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **RESPONDENT'S MEMORANDUM IN SUPPORT OF ITS MOTION TO REOPEN OR TO WITHDRAW OR AMEND PETITIONER'S REQUESTS FOR ADMISSION NOS. 36 – 45** was filed on July 9, 2015 and forwarded to counsel for Petitioner and counsel for Co-Respondent, this 9th day of July 2015, by email and by sending the same via first class mail:

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Counsel for Co-Respondent,
McAfee Heating & Air Conditioning, Inc.

// Julie Celum Garrigue //

JULIE CELUM GARRIGUE

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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BARNABY HEATING & AIR, LLC)	
)	
Respondent.)	

DECLARATION OF JULIE CELUM GARRIGUE

“I Julie Celum Garrigue declare under penalty of perjury that the foregoing is true and correct.

1. I am legal counsel for Respondent, Barnaby Heating & Air, LLC.
2. Attached hereto as Exhibit 1 is a true and accurate copy of Respondent’s First Objections and Responses to Petitioner’s First Requests for Admission Nos. 36 – 45, served today, July 9, 2015 by copy of this Motion and Memorandum in support.
3. On March 13, 2008, Respondent filed the application to register the COMFORTCLUB Mark, for “prepaid preventative maintenance service plans for heating, ventilating and air conditioning systems” in International Class 36, U.S.

Application Serial No. 77/420,784, as available on the U.S. Patent and Trademark Office's ("USPTO's") Trademark Status & Document Retrieval ("TSDR") website. A true and accurate copy of the application to register the COMFORTCLUB Mark, U.S. Application Serial No. 77/420,784, dated March 13, 2008, as available on the USPTO's TSDR website, is attached hereto as Exhibit 2.

4. On May 12, 2009, Respondent, Barnaby Heating & Air, LLC, was issued U.S. Registration No. 3,618,331 for the COMFORTCLUB Mark in International Class 36. A true and accurate copy of U.S. Registration No. 3,618,331 for the COMFORTCLUB Mark, as available on the USPTO's TSDR website, is attached hereto as Exhibit 3.

5. On September 30, 2014, Mr. Charles Barnaby entered into a Trademark Assignment, on behalf of Barnaby Heating & Air, LLC, with McAfee Heating & Air Conditioning Co., Inc., assigning the entire interest and the goodwill in the COMFORTCLUB Mark to McAfee Heating & Air Conditioning Co, Inc. A true and accurate copy of the Assignment of Trademark Registration for the COMFORTCLUB Mark, dated September 30, 2014, is attached hereto as Exhibit 4.

6. On October 14, 2014, the Assignment was recorded at the USPTO, No. 900304052, at Reel: 005380, Frame: 0159, and the Trademark Assignment Cover Sheet for the COMFORTCLUB Mark, dated October 14, 2014, ETAS ID: TM319944, as available on the USPTO's TSDR website, and is attached hereto as Exhibit 5.

7. On September 22, 2014, Respondent, Barnaby Heating & Air, LLC entered into an Exclusive License with McAfee Heating & Air Conditioning Co., Inc. for the continued of the COMFORTCLUB Mark, which License includes the right to prosecute and defend this action. A true and accurate copy of the Licensing Agreement, dated

September 22, 2014, is attached hereto as Exhibit 6.

8. Beginning on June 15, 2015 – June 19, 2015, I corresponded via email with Mr. Brad R. Newberg, counsel for Petitioner and advised that Petitioner's Motion for Summary Judgment misrepresented the numbers of Requests for Admission Petitioner served on Respondent. A true and accurate copy of the emails exchanged between counsel for Petitioner and Respondent, beginning June 15, 2015 through June 19, 2015, are attached hereto as Exhibit 7.

9. On September 10, 2014, I received the attached true and accurate copy of correspondence from Petitioner's former counsel of record, Ms. Purvi Patel, wherein she specifically asserted she served Respondent with 35 Requests for Admission, which is attached hereto as Exhibit 8.

10. On November 6, 2014, Petitioner filed a motion to compel in this case, wherein Petitioner asserted in multiple places throughout its motion, that Petitioner served 35 requests for admission in this case. A true and accurate copy of the relevant portions of Petitioner's Motion to compel, with Ms. Patel's affidavit, is attached hereto as Exhibit 9.

11. On June 30, 2014, I received Petitioner's first discovery requests and the originals were scanned into my database, as is customary, that very same day. The metadata from the scanned .PDF shows a file creation date of June 30, 2014.

12. Attached hereto is a true and accurate copy of Petitioner's original Requests for Admission at Exhibit 10. This document is a true and accurate copy of the original .PDF of Petitioner's requests for admissions, as scanned into my office database and as saved, and from which I created and drafted Respondent's objections and responses to Petitioner's discovery requests.

13. Respondent asserted 11 Affirmative Defenses in defense of Petitioner's petition to cancel. Requests Nos. 36 – 45 go directly to Petitioner's claims and would essentially nullify Respondent's Affirmative Defenses, Nos. 8 – 11, and Petitioner's fraud claim, and likelihood of confusion claim, and would lead to a judgment on the pleadings.

14. I did not intend to not respond to Petitioner's Requests Nos. 36 – 45, but was never properly served with the Requests, and any failure to respond was the result of excusable neglect.

15. I did see that a portion of Petitioner's Request No. 35 was missing, but assumed that Petitioner's counsel made a typographical error. I did not notice that a numerical page was missing from Petitioner's requests.

16. Petitioner's counsel never mentioned that I failed to serve Requests Nos. 36 – 45 until I received Petitioner's motion for summary judgment.

I declare under penalty of perjury the foregoing is true and correct.

EXECUTED on JULY 9, 2015.



JULIE CELUM GARRIGUE

EXHIBIT 1

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

In the Matter of Trademark Registration No. 3,618,331

Registration Date: May 12, 2009

Mark: COMFORTCLUB

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BARNABY HEATING & AIR, LLC)	
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**RESPONDENT’S FIRST OBJECTIONS AND RESPONSES
TO PETITIONER’S REQUESTS FOR ADMISSIONS NOS. 36-45**

TO: PETITIONER CLOCKWORK II, LLC AND ITS COUNSEL OF RECORD:

Pursuant to Rules 26, 33, 36(d) of the Federal Rules of Civil Procedure and TBMP § 403, et seq., Respondent Barnaby Heating & Air, LLC (“Barnaby”) serves its First Objections and Responses to Petitioner’s Requests for Admission Nos. 36 - 45.

GENERAL OBJECTIONS

Respondent objects to the Petitioner’s Requests for Admission Nos. 36 – 45 in their entirety given the date of service. Through no fault of Respondent’s, Respondent was not served with Petitioner’s first discovery requests during the discovery period in this case. The discovery

devices are available for use only during the discovery period. *See Smith International, Inc. v. Olin Corp.*, 201 USPQ 250 (TTAB 1978), and *Rhone- Poulenc Industries v. Gulf Oil Corp.*, 198 UPSQ 372 (TTAB 1978). Respondent has no obligation to respond to an untimely request for discovery. TBMP § 403.01.

With respect to Requests for Admission Nos. 36 – 45, these requests for admission were not served with Petitioner’s original requests for production, interrogatories and requests for admission nos. 1 – 35. By correspondence dated September 10, 2014, Petitioner’s counsel affirmatively represented in writing that it served Respondent with 35 requests for admission. In Petitioner’s sworn motion to compel, filed November 6, 2014, Petitioner affirmed that it served, “over 150 interrogatories, requests for production and requests for admission on Respondent” (Dkt. # 13 at p. 1) that “Petitioner’s Discovery Requests consist of 26 interrogatories, 90 requests for production, and 35 requests for admission” (*Id.* at p. 6) that Respondent responded to “all 151 of Petitioner’s Discovery Requests” (*Id.* at p. 15). Given the delay in service, and given sworn statements made by Petitioner in its Motion to Compel, and in signed correspondence between counsel, Respondent objects to Petitioner’s Requests for Admission Nos. 36 – 45 given their service outside the discovery period.

Respondent objects to the definitions and instructions preceding Petitioner’s Requests for Admission to the extent they attempt to re-define commonly used words. Respondent, in answering these requests for admission will afford the words contained therein their common, ordinary meaning, except as the Federal Rules of Civil Procedure may specifically define them.

Respondent further objects to the definitions and instructions preceding the Petitioner’s Requests for Admission Nos. 36 – 45 to the extent that the requests seek to impose additional or different obligations upon Respondent other than those obligations that are placed on Respondent by the Federal Rules of Civil Procedure, the TBMP and the Trademark Trial and Appeal Board rules of practice and procedure. Respondent will answer these admissions in accordance with the applicable rules.

Respondent also objects to the extent these requests are propounded on behalf of entities that are

not parties to this litigation, such as “SGI”, “AirTime”, “AirTime 500”, “Success Day”, “Success Academy”, “CONGRESS”, “SGI EXPO”, “BRAND DOMINANCE”, and “Senior Tech.” The pleadings in this matter do not indicate how these entities are related to this litigation and without more Respondent is unable to adequately respond to Petitioner’s requests relating to these various entities. Respondent objects to any requests relating to these various entities because these requests cause Respondent to speculate. Respondent also objects to each of the discovery requests made by, or on behalf of the entities named above, based upon their ambiguity and vagueness, given Respondent unfamiliarity with these entities.

Respondent hereby objects to each request contained in the Request for Admissions to the extent that it seeks information that is: (i) protected from discovery by the attorney-client privilege, work-product doctrine, or any other privilege, doctrine or immunity; (ii) not reasonably calculated to lead to the discovery of admissible evidence; (iii) from a time prior to or after the events or circumstances relevant to the matters pertaining to the captioned proceeding; (iv) pertaining to transactions other than those that are the subject matter of this litigation; (v) being sought pursuant to requests that are vague, ambiguous and subject to multiple interpretations; (vi) being sought pursuant to requests that are overbroad, burdensome and/or harassing; (vii) being sought pursuant to requests that require a legal conclusion or call for speculation; (viii) beyond the scope of the obligations or requirements contained in the FRCP and the TBMP; and (ix) to the extent that a request assumes that Petitioner has a mark, which Respondent denies.

REQUEST FOR ADMISSION NO. 36:

Respondent's Eighth Affirmative Defense in paragraph 48 of its Answer to Petitioner's Petition to Cancel is without merit and unsupported by evidence.

ANSWER: Respondent objects to this Request, because it is being sought pursuant to requests that require a legal conclusion and calls for speculation, Respondent also objects to the extent this Request is beyond the scope of the obligations or requirements contained in the FRCP and the TBMP. Respondent also objects to the extent this Request assumes that Petitioner has a

mark, which Respondent denies. Subject to the foregoing objections and without waiving same, denied.

REQUEST FOR ADMISSION NO. 37:

Respondent's Ninth Affirmative Defense in paragraph 49 of its Answer to Petitioner's Petition to Cancel is without merit and unsupported by evidence.

ANSWER: Respondent objects to this Request, because it is being sought pursuant to requests that require a legal conclusion and calls for speculation, Respondent also objects to the extent this Request is beyond the scope of the obligations or requirements contained in the FRCP and the TBMP. Respondent also objects to the extent this Request assumes that Petitioner has a mark, which Respondent denies. Subject to the foregoing objections and without waiving same, denied.

REQUEST FOR ADMISSION NO. 38:

Respondent's Tenth Affirmative Defense in paragraph 50 of its Answer to Petitioner's Petition to Cancel is without merit and unsupported by evidence.

ANSWER: Respondent objects to this Request, because it is being sought pursuant to requests that require a legal conclusion and calls for speculation, Respondent also objects to the extent this Request is beyond the scope of the obligations or requirements contained in the FRCP and the TBMP. Respondent also objects to the extent this Request assumes that Petitioner has a mark, which Respondent denies. Subject to the foregoing objections and without waiving same, denied.

REQUEST FOR ADMISSION NO. 39:

Respondent's Eleventh Affirmative Defense in paragraph 51 of its Answer to Petitioner's Petition to Cancel is without merit and unsupported by evidence.

ANSWER: Respondent objects to this Request, because it is being sought pursuant to requests that require a legal conclusion and calls for speculation, Respondent also objects to the extent this Request is beyond the scope of the obligations or requirements contained in the FRCP and the TBMP. Respondent also objects to the extent this Request assumes that Petitioner has a mark, which Respondent denies. Subject to the foregoing objections and without waiving same, denied.

REQUEST FOR ADMISSION NO. 40:

Petitioner's Mark is distinctive.

ANSWER: Respondent objects to the extent this Request assumes that Petitioner has a mark, which Respondent denies. Respondent also objects to this Request, because it is being sought pursuant to requests that require a legal conclusion or calls for speculation, Respondent also objects to the extent this Request is beyond the scope of the obligations or requirements contained in the FRCP and the TBMP. Subject to the foregoing objections and without waiving same, denied.

REQUEST FOR ADMISSION NO. 41:

COMFORTCLUB is distinctive as applied to Respondent's services.

ANSWER: Respondent objects to this Request to the extent this Request is beyond the scope of the obligations or requirements contained in the FRCP and the TBMP. Respondent also objects to this Request, because it requires a legal conclusion and it calls for speculation. Subject to the

foregoing objections and without waiving same, admitted.

REQUEST FOR ADMISSION NO. 42:

The COMFORTCLUB mark is distinctive as applied to Petitioner's services.

ANSWER: Respondent objects to the extent this Request assumes that Petitioner has a mark, which Respondent denies. Respondent objects to this Request to the extent this Request is beyond the scope of the obligations or requirements contained in the FRCP and the TBMP. Respondent also objects to this Request, because it requires a legal conclusion and it calls for speculation. Subject to the foregoing objections and without waiving same, denied.

REQUEST FOR ADMISSION NO. 43:

Respondent adopted Respondent's Mark after learning of Petitioner's use of Petitioner's Mark.

ANSWER: Respondent objects to the extent this Request assumes that Petitioner has a mark, which Respondent denies. Respondent objects to this Request to the extent this Request is beyond the scope of the obligations or requirements contained in the FRCP and the TBMP. Respondent also objects to this Request, because it requires a legal conclusion and it calls for speculation. Subject to the foregoing objections and without waiving same, denied.

REQUEST FOR ADMISSION NO. 44:

Respondent's Mark should be cancelled.

ANSWER: Respondent objects to the extent this Request assumes that Petitioner has a mark, which Respondent denies. Respondent objects to this Request to the extent this Request is

beyond the scope of the obligations or requirements contained in the FRCP and the TBMP. Respondent also objects to this Request, because it requires a legal conclusion. Subject to the foregoing objections and without waiving same, denied.

REQUEST FOR ADMISSION NO. 45:

This Petition to Cancel should be granted on the basis of a likelihood of confusion and fraud on the Trademark Office.

ANSWER: Respondent objects to the extent this Request assumes that Petitioner has a mark, which Respondent denies. Respondent objects to this Request to the extent this Request is beyond the scope of the obligations or requirements contained in the FRCP and the TBMP. Respondent also objects to this Request, because it requires a legal conclusion. Subject to the foregoing objections and without waiving same, denied.

Dated: July 9, 2015

Barnaby Heating & Air, LLC

// Julie Celum Garrigue //

JULIE CELUM GARRIGUE

Celum Law Firm, PLLC

11700 Preston Rd.

Suite 660, PMB 560

Dallas, Texas 75230

P: 214.334.6065

F: 214.504.2289

E: Jcelum@celumlaw.com

Attorney for Respondent

Barnaby Heating & Air, LLC

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **RESPONDENT'S FIRST OBJECTIONS AND RESPONSES TO PETITIONER'S REQUEST FOR ADMISSIONS NOS. 36 - 45** was served on counsel for Petitioner and counsel for Co-Respondent, this 9th day of July 2015, by sending the same via email and via first class mail:

Brad R. Newberg
McGuireWoods, LLP
1750 Tysons Boulevard
Suite 1800
Tysons Corner, VA 22102-4215
T: 703.712.5061 (Direct Line)
F: 703.712.5187
Email: bnewberg@mcguirewoods.com

Counsel for Petitioner,
Clockwork IP, LLC

Melissa Replogle, Esq.
Replogle Law Office, LLC
2312 Far Hills Ave., #145
Dayton, OH 45419
T: 937.369.0177
F: 937.999.3924
Email: melissa@reploglelawoffice.com

Counsel for Co-Respondent,
McAfee Heating & Air Conditioning, Inc.

// Julie Celum Garrigue //

JULIE CELUM GARRIGUE

EXHIBIT 2

Trademark/Service Mark Application, Principal Register

Serial Number: 77420784

Filing Date: 03/13/2008

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77420784
MARK INFORMATION	
*MARK	ComfortClub
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	ComfortClub
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font, style, size, or color.
REGISTER	Principal
APPLICANT INFORMATION	
*OWNER OF MARK	Barnaby Heating & Air
*STREET	4620 Industrial ST, STE C
*CITY	Rowlett
*STATE (Required for U.S. applicants)	Texas
*COUNTRY	United States
*ZIP/POSTAL CODE (Required for U.S. applicants only)	75088
PHONE	972-412-0150
FAX	972-475-6815
EMAIL ADDRESS	info@barnabyheatingandair.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
LEGAL ENTITY INFORMATION	
TYPE	limited liability company

STATE/COUNTRY WHERE LEGALLY ORGANIZED	Texas
GOODS AND/OR SERVICES AND BASIS INFORMATION	
INTERNATIONAL CLASS	036
FIRST USE ANYWHERE DATE	At least as early as 01/22/2008
FIRST USE IN COMMERCE DATE	At least as early as 01/22/2008
*IDENTIFICATION	Prepaid preventive maintenance service plans for heating, ventilating and air conditioning systems
FILING BASIS	SECTION 1(a)
FIRST USE ANYWHERE DATE	At least as early as 01/22/2008
FIRST USE IN COMMERCE DATE	At least as early as 01/22/2008
CORRESPONDENCE INFORMATION	
NAME	Barnaby Heating & Air
FIRM NAME	Barnaby Heating & Air
STREET	4620 Industrial ST, STE C
CITY	Rowlett
STATE	Texas
COUNTRY	United States
ZIP/POSTAL CODE	75088
PHONE	972-412-0150
FAX	972-475-6815
EMAIL ADDRESS	info@barnabyheatingandair.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
FEE INFORMATION	
NUMBER OF CLASSES	1
FEE PER CLASS	325
*TOTAL FEE DUE	325
*TOTAL FEE PAID	325
SIGNATURE INFORMATION	
SIGNATURE	/Charles Barnaby/

SIGNATORY'S NAME	Charles Barnaby
SIGNATORY'S POSITION	Principal Partner
DATE SIGNED	03/13/2008

Trademark/Service Mark Application, Principal Register

Serial Number: 77420784

Filing Date: 03/13/2008

To the Commissioner for Trademarks:

MARK: ComfortClub (Standard Characters, see [mark](#))

The literal element of the mark consists of ComfortClub.

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, Barnaby Heating & Air, a limited liability company legally organized under the laws of Texas, having an address of

4620 Industrial ST, STE C

Rowlett, Texas 75088

United States

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended.

For specific filing basis information for each item, you must view the display within the Input Table.

International Class 036: Prepaid preventive maintenance service plans for heating, ventilating and air conditioning systems

Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, or the applicant's predecessor in interest used the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended.

In International Class 036, the mark was first used at least as early as 01/22/2008, and first used in commerce at least as early as 01/22/2008, and is now in use in such commerce. The applicant is submitting one specimen(s) showing the mark as used in commerce on or in connection with any item in the class of listed goods and/or services, consisting of a(n) direct mail piece.

[Specimen File 1](#)

Correspondence Information: Barnaby Heating & Air

4620 Industrial ST, STE C

Rowlett, Texas 75088

972-412-0150(phone)

972-475-6815(fax)

info@barnabyheatingandair.com (authorized)

A fee payment in the amount of \$325 has been submitted with the application, representing payment for 1 class(es).

Declaration

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: /Charles Barnaby/ Date Signed: 03/13/2008

Signatory's Name: Charles Barnaby

Signatory's Position: Principal Partner

RAM Sale Number: 9157

RAM Accounting Date: 03/13/2008

Serial Number: 77420784

Internet Transmission Date: Thu Mar 13 11:34:48 EDT 2008

TEAS Stamp: USPTO/BAS-71.96.1.66-2008031311344828293

3-77420784-40030574bb9cde1113f4fe217ddac

a3212f-CC-9157-20080313113219201855

ComfortClub

No Image Attached

EXHIBIT 3

Int. Cl.: 36

Prior U.S. Cls.: 100, 101 and 102

Reg. No. 3,618,331

United States Patent and Trademark Office

Registered May 12, 2009

**SERVICE MARK
PRINCIPAL REGISTER**

ComfortClub

BARNABY HEATING & AIR (TEXAS LIMITED
LIABILITY COMPANY)
4620 INDUSTRIAL ST, STE C
ROWLETT, TX 75088

THE MARK CONSISTS OF STANDARD CHAR-
ACTERS WITHOUT CLAIM TO ANY PARTICULAR
FONT, STYLE, SIZE, OR COLOR.

FOR: PREPAID PREVENTIVE MAINTENANCE
SERVICE PLANS FOR HEATING, VENTILATING
AND AIR CONDITIONING SYSTEMS, IN CLASS 36
(U.S. CLS. 100, 101 AND 102).

SER. NO. 77-420,784, FILED 3-13-2008.

FIRST USE 1-22-2008; IN COMMERCE 1-22-2008.

DANNEAN HETZEL, EXAMINING ATTORNEY

EXHIBIT 4

ASSIGNMENT OF TRADEMARK REGISTRATION

Mark: COMFORTCLUB
Registration No.: 3618331
Registration Date: May 12, 2009

Assignor: Barnaby Heating & Air LLC
Address: 4620 Industrial St., Ste. C, Rowlett, Texas 75088

Assignee: McAfee Heating and Air Conditioning Co., Inc.
Address: 4770 Hempstead Station Dr., Kettering, Ohio 45429

This Trademark Assignment is made and effective as of the 22nd date of September, 2014, by and between Barnaby Heating & Air LLC ("Assignor") and McAfee Heating and Air Conditioning Co., Inc. ("Assignee").

WHEREAS, Assignor obtained a federal trademark registration on May 12, 2009;

WHEREAS, Assignor and Assignee entered into a certain Trademark License Agreement effective the 2nd day of September, 2014 (the "License Agreement") which, among other provisions, grants certain licenses to Assignor to use the Mark;

WHEREAS Assignee desires to acquire all of Assignor's right, title and interest, in and to the Mark together with all the goodwill symbolized thereby, and Assignor desires to assign all such right, title and interest in and to the Mark to Assignee, upon the terms and conditions set forth herein.

NOW, THEREFORE, for good and valuable consideration the receipt and sufficiency of which is hereby acknowledged by Assignor, the parties agree as follows:

1. Assignor hereby conveys and assigns to Assignee, and Assignee hereby accepts from Assignor, all of Assignor's right, title and interest in and to the Mark, together with the goodwill of the business symbolized by the Mark.

2. Assignor represents and warrants that:

- (i) Assignor owns the entire right, title and interest in and to the Mark;
- (ii) the registration for the Mark is currently valid and subsisting and in full force and effect;
- (iii) Assignor has not licensed the Mark to any other person or entity or granted, either expressly or impliedly, any trademark right with respect to the Mark to any other person or entity;
- (iv) there are no liens or security interests against the Mark; and

(v) Assignor has all authority necessary to enter into this Agreement and the execution and delivery of this Agreement has been duly and validly authorized.

3. Assignor shall execute and deliver to Assignee on or before the Effective Date the Trademark Assignment in the form shown in Exhibit B. Assignor further agrees to assist Assignee and to provide such reasonable cooperation and assistance to Assignee, at Assignee's expense, as Assignee may reasonably deem necessary and desirable in exercising and enforcing Assignee's rights in the Mark.

4. After the Effective Date, Assignor agrees to use the Mark only as expressly authorized by Assignee in accordance with the License Agreement, and so long as it is in accordance with the License Agreement, Assignor agrees to not challenge Assignee's use or ownership, or the validity, of the Mark.

5. This Agreement shall be binding on and shall inure to the benefit of the parties to this Agreement and their successors and assigns, if any.

6. Miscellaneous.

(a) This Agreement, Exhibit A, and the Trademark Assignment whose form is shown in Exhibit B constitute the entire agreement of the parties with regard to the subject matter hereof. No modifications of or additions to this Agreement shall have effect unless in writing and properly executed by both parties, making specific reference to this Agreement by date, parties, and subject matter.

(b) This Agreement and the rights and obligations of the parties hereunder shall be governed by and construed in accordance with the laws of Texas or Ohio, without regard to its conflict of laws principles, and shall be enforceable against the parties in the courts of Texas or Ohio. For such purpose, each party hereby irrevocably submits to the jurisdiction of such courts, and agrees that all claims in respect of this Agreement may be heard and determined in any of such courts.

(c) This Agreement may be signed by each party separately, in which case attachment of all of the parties' signature pages to this Agreement shall constitute a fully-executed agreement.

(d) This Agreement may be amended only by a written agreement signed by both parties which explicitly adjoins itself to this agreement.

(e) Any provision of this Agreement that is invalid, illegal or unenforceable in any jurisdiction shall, as to that jurisdiction, be ineffective to the extent of such invalidity, illegality or unenforceability, without affecting in any way the remaining provisions of this Agreement in such jurisdiction or rendering that or any other provision of this Agreement invalid, illegal or unenforceable in any other jurisdiction.

(f) Assignor and Assignee agree to perform any further acts and execute and deliver any documents that may be reasonably necessary to carry out the provisions of this Agreement.

IN WITNESS WHEREOF, the parties hereto have caused this Agreement to be executed by their respective duly authorized representatives as of the day and year above written.

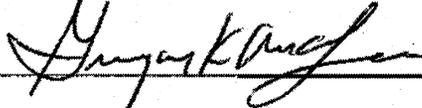
ASSIGNOR:

ASSIGNEE:

Barnaby Heating & Air, LLC

McAfee Heating and Air Conditioning, Inc.

By: 

By: 

Name: Charlie Barnaby

Name: Greg McAfee

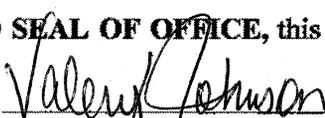
Title: President

Title: Pro

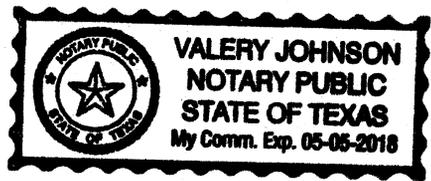
STATE OF TEXAS §
 §
COUNTY OF DALLAS §

BEFORE ME, the undersigned, a Notary Public in and for said County and State, on this day personally appeared Charlie Barnaby, known to me to be the person whose name is subscribed to the foregoing instrument and acknowledged to me that he executed this document and that he executed the same for the purposes and consideration therein expressed.

GIVEN UNDER MY HAND AND SEAL OF OFFICE, this 30 day of September, 2014.


Notary Public, State of Texas

Barnaby Heating & Air, LLC

STATE OF OHIO

COUNTY OF Montgomery

§
§
§

BEFORE ME, the undersigned, a Notary Public in and for said County and State, on this day personally appeared Greg McAfee, known to me to be the person whose name is subscribed to the foregoing instrument and acknowledged to me that he executed this document and that he executed the same for the purposes and consideration therein expressed.

GIVEN UNDER MY HAND AND SEAL OF OFFICE, this 22 day of September, 2014.

Angela Petersimes
Angela Petersimes
Notary Public, State of Ohio

McAfee Heating and Air Conditioning, Inc.

Greg McAfee

ANGELA PETERSIMES
NOTARY PUBLIC • STATE OF OHIO
Recorded in Montgomery County
My commission expires Dec. 23, 2018

EXHIBIT 5

TRADEMARK ASSIGNMENT COVER SHEET

Electronic Version v1.1
Stylesheet Version v1.2

ETAS ID: TM319944

SUBMISSION TYPE:	NEW ASSIGNMENT		
NATURE OF CONVEYANCE:	ASSIGNMENT OF THE ENTIRE INTEREST AND THE GOODWILL		
CONVEYING PARTY DATA			
Name	Formerly	Execution Date	Entity Type
Barnaby Heating & Air LLC		09/30/2014	LIMITED LIABILITY COMPANY: TEXAS
RECEIVING PARTY DATA			
Name:	McAfee Heating and Air Conditioning Co., Inc.		
Street Address:	4770 Hempstead Station Dr.		
City:	Kettering		
State/Country:	OHIO		
Postal Code:	45429		
Entity Type:	CORPORATION: OHIO		
PROPERTY NUMBERS Total: 1			
Property Type	Number	Word Mark	
Registration Number:	3618331	COMFORTCLUB	
CORRESPONDENCE DATA			
Fax Number:	9379993924		
<i>Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent using a fax number, if provided; if that is unsuccessful, it will be sent via US Mail.</i>			
Phone:	937-369-0177		
Email:	melissa@reploglelawoffice.com		
Correspondent Name:	Melissa Replogle		
Address Line 1:	2312 Far Hills Ave.		
Address Line 2:	PMB 145		
Address Line 4:	Dayton, OHIO 45419		
NAME OF SUBMITTER:	Melissa Replogle, Ohio Bar Member		
SIGNATURE:	/Melissa Replogle/		
DATE SIGNED:	10/14/2014		
Total Attachments: 4			
source=Executed Trademark Assignment#page1.tif			
source=Executed Trademark Assignment#page2.tif			
source=Executed Trademark Assignment#page3.tif			
source=Executed Trademark Assignment#page4.tif			

OP \$40.00 3618331

ASSIGNMENT OF TRADEMARK REGISTRATION

Mark: COMFORTCLUB
Registration No.: 3618331
Registration Date: May 12, 2009

Assignor: Barnaby Heating & Air LLC
Address: 4620 Industrial St., Ste. C, Rowlett, Texas 75088

Assignee: McAfee Heating and Air Conditioning Co., Inc.
Address: 4770 Hempstead Station Dr., Kettering, Ohio 45429

This Trademark Assignment is made and effective as of the 22nd date of September, 2014, by and between Barnaby Heating & Air LLC ("Assignor") and McAfee Heating and Air Conditioning Co., Inc. ("Assignee").

WHEREAS, Assignor obtained a federal trademark registration on May 12, 2009;

WHEREAS, Assignor and Assignee entered into a certain Trademark License Agreement effective the 22nd day of September, 2014 (the "License Agreement") which, among other provisions, grants certain licenses to Assignor to use the Mark;

WHEREAS Assignee desires to acquire all of Assignor's right, title and interest, in and to the Mark together with all the goodwill symbolized thereby, and Assignor desires to assign all such right, title and interest in and to the Mark to Assignee, upon the terms and conditions set forth herein.

NOW, THEREFORE, for good and valuable consideration the receipt and sufficiency of which is hereby acknowledged by Assignor, the parties agree as follows:

1. Assignor hereby conveys and assigns to Assignee, and Assignee hereby accepts from Assignor, all of Assignor's right, title and interest in and to the Mark, together with the goodwill of the business symbolized by the Mark.

2. Assignor represents and warrants that:

- (i) Assignor owns the entire right, title and interest in and to the Mark;
- (ii) the registration for the Mark is currently valid and subsisting and in full force and effect;
- (iii) Assignor has not licensed the Mark to any other person or entity or granted, either expressly or impliedly, any trademark right with respect to the Mark to any other person or entity;
- (iv) there are no liens or security interests against the Mark; and

(v) Assignor has all authority necessary to enter into this Agreement and the execution and delivery of this Agreement has been duly and validly authorized.

3. Assignor shall execute and deliver to Assignee on or before the Effective Date the Trademark Assignment in the form shown in Exhibit B. Assignor further agrees to assist Assignee and to provide such reasonable cooperation and assistance to Assignee, at Assignee's expense, as Assignee may reasonably deem necessary and desirable in exercising and enforcing Assignee's rights in the Mark.

4. After the Effective Date, Assignor agrees to use the Mark only as expressly authorized by Assignee in accordance with the License Agreement, and so long as it is in accordance with the License Agreement, Assignor agrees to not challenge Assignee's use or ownership, or the validity, of the Mark.

5. This Agreement shall be binding on and shall inure to the benefit of the parties to this Agreement and their successors and assigns, if any.

6. Miscellaneous.

(a) This Agreement, Exhibit A, and the Trademark Assignment whose form is shown in Exhibit B constitute the entire agreement of the parties with regard to the subject matter hereof. No modifications of or additions to this Agreement shall have effect unless in writing and properly executed by both parties, making specific reference to this Agreement by date, parties, and subject matter.

(b) This Agreement and the rights and obligations of the parties hereunder shall be governed by and construed in accordance with the laws of Texas or Ohio, without regard to its conflict of laws principles, and shall be enforceable against the parties in the courts of Texas or Ohio. For such purpose, each party hereby irrevocably submits to the jurisdiction of such courts, and agrees that all claims in respect of this Agreement may be heard and determined in any of such courts.

(c) This Agreement may be signed by each party separately, in which case attachment of all of the parties' signature pages to this Agreement shall constitute a fully-executed agreement.

(d) This Agreement may be amended only by a written agreement signed by both parties which explicitly adjoins itself to this agreement.

(e) Any provision of this Agreement that is invalid, illegal or unenforceable in any jurisdiction shall, as to that jurisdiction, be ineffective to the extent of such invalidity, illegality or unenforceability, without affecting in any way the remaining provisions of this Agreement in such jurisdiction or rendering that or any other provision of this Agreement invalid, illegal or unenforceable in any other jurisdiction.

(f) Assignor and Assignee agree to perform any further acts and execute and deliver any documents that may be reasonably necessary to carry out the provisions of this Agreement.

IN WITNESS WHEREOF, the parties hereto have caused this Agreement to be executed by their respective duly authorized representatives as of the day and year above written.

ASSIGNOR:

ASSIGNEE:

Barnaby Heating & Air, LLC

McAfee Heating and Air Conditioning, Inc.

By: *[Signature]*

By: *[Signature]*

Name: Charlie Barnaby

Name: Greg McAfee

Title: President

Title: Pro.

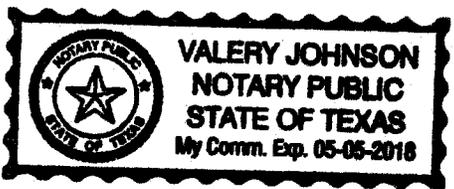
STATE OF TEXAS §
 §
COUNTY OF DALLAS §

BEFORE ME, the undersigned, a Notary Public in and for said County and State, on this day personally appeared Charlie Barnaby, known to me to be the person whose name is subscribed to the foregoing instrument and acknowledged to me that he executed this document and that he executed the same for the purposes and consideration therein expressed.

GIVEN UNDER MY HAND AND SEAL OF OFFICE, this 30 day of September, 2014.

[Signature]
Notary Public, State of Texas

Barnaby Heating & Air, LLC
[Signature]



STATE OF OHIO

§
§
§

COUNTY OF Montgomery

BEFORE ME, the undersigned, a Notary Public in and for said County and State, on this day personally appeared Greg McAfee, known to me to be the person whose name is subscribed to the foregoing instrument and acknowledged to me that he executed this document and that he executed the same for the purposes and consideration therein expressed.

GIVEN UNDER MY HAND AND SEAL OF OFFICE, this 22 day of September, 2014.

Angela Petersimes
Angela Petersimes
Notary Public, State of Ohio

McAfee Heating and Air Conditioning, Inc.

Greg McAfee

ANGELA PETERSIMES
NOTARY PUBLIC - STATE OF OHIO
Recorded in Montgomery County
My commission expires Dec. 23, 2018

EXHIBIT 6

TRADEMARK LICENSE AGREEMENT

THIS AGREEMENT is effective this 22nd day of September, 2014 by and between Barnaby Heating & Air LLC, a Texas Limited Liability Company, having its principal place of business at 4620 Industrial Street, Suite C, Rowlett, TX 75088 (hereinafter "Barnaby") and McAfee Heating & Air Conditioning Co., Inc., an Ohio corporation, having its principal place of business at 4770 Hempstead Station Drive, Kettering, OH 45429 (hereinafter "McAfee").

WHEREAS, Barnaby was the owner of the federal trademark COMFORTCLUB, U.S. Registration No. 3,618,331, (hereinafter referred to as COMFORTCLUB or the Mark) thereof for prepaid preventive maintenance service plans for heating, ventilating and air conditioning systems as set forth in Exhibit A);

WHEREAS, since at least as early as 1999, McAfee has used and is using COMFORT CLUB in connection with prepaid preventive maintenance service plans for heating, ventilating and air conditioning systems;

WHEREAS, Barnaby has assigned to McAfee the COMFORTCLUB trademark, including U.S. Registration No. 3,618,331, for good and valuable consideration, and McAfee is willing to grant to Barnaby a license to use the COMFORTCLUB trademark in connection with prepaid preventive maintenance service plans for heating, ventilating and air conditioning systems (the "Licensed Services"), on the following terms and conditions;

NOW THEREFORE, in consideration of the foregoing and the mutual covenants contained herein, the parties agree to follows:

1. Assignment.

By assignment, Barnaby hereby has transferred and assigned to McAfee all right, title and interest it possesses in the COMFORTCLUB trademark, including U.S. Registration No. 3,618,331, together with the goodwill in connection with which the mark has been used as set forth in Exhibit B. Barnaby further transfers and assigns to McAfee all causes of action, rights and remedies arising under the COMFORTCLUB trademark after the effective date of this Agreement, with the exception of the Clockwork action currently before the Trademark Trial and Appeal Board, such action McAfee intends to be joined with Barnaby upon the grant of an agreed

Motion to Join.

2. Grant.

McAfee hereby grants to Barnaby, subject to the following terms and conditions, an exclusive, royalty-free right to use the COMFORTCLUB trademark in connection with the Licensed Services within and limited to 90 miles from Dallas, Texas, including all of Collin, Dallas, Rockwall and Tarrant Counties, Texas. Barnaby shall have no right to license or sublicense the Mark.

Notwithstanding the exclusive character of the license granted in this Agreement, Barnaby shall take such license subject to the rights in one (1) third party, located in Waco, Texas, established by a licensing agreement entered into by McAfee prior to the date of this Agreement. In this connection, McAfee represents that no rights have been granted to others in the State of Texas to the Mark and the Licensed Services that are the subject matter of this Agreement and that no licenses have been granted affecting the subject matter of such Mark and Licensed Services that would in its judgment significantly diminish the value of the rights herein conveyed.

McAfee has noted and Barnaby recognizes and accepts the possible existence, in reference to the particular Mark and Licensed Services, of the prior licenses granted by McAfee to third parties that may be inconsistent in some respects with the commitments of this Agreement, but McAfee represents and warrants that it has accepted no commitments or restrictions that will materially affect the value of the license and rights granted by it in this Agreement.

3. Use of the Mark.

Barnaby shall continue to use the COMFORTCLUB trademark in the manner in which it is using the trademark as of the effective date of this Agreement.

Barnaby shall include in and/on all advertising and promotional material, and other printed material, and on its Web site or in other electronic media, the following legend or such other legend as McAfee may from time to time require:

COMFORTCLUB ® is a trademark of McAfee Heating & Air Conditioning Co., Inc., used under license.

Barnaby agrees that it shall use the COMFORTCLUB trademark only in such form and

manner as may be approved by McAfee. All advertising, promotion and other use of the COMFORTCLUB trademark will be in good taste and in such manner as will maintain and enhance the value of the COMFORTCLUB trademark and McAfee's reputation for high quality.

McAfee acknowledges that the manner in which Barnaby uses the COMFORTCLUB trademark in its advertising as of the date of this Agreement is acceptable to McAfee.

Before releasing any labeling, advertising, promotional or other material which departs materially from the manner in which Barnaby currently uses the COMFORTCLUB trademark, Barnaby shall submit to McAfee for its approval, a sample of each such new intended use of the COMFORTCLUB trademark, sufficiently far in advance to permit McAfee to review the form and manner in which the COMFORTCLUB trademark is displayed. However, McAfee shall not unreasonably withhold its approval, and any sample or example of art work submitted to McAfee hereunder which has not been disapproved within fifteen (15) days after receipt thereof shall be deemed to have been approved.

4. Quality Control.

McAfee has inspected the services that Barnaby is currently providing in connection with the COMFORTCLUB trademark and acknowledges that these services are of high quality and are appropriate for sale under the COMFORTCLUB trademark. Barnaby agrees to maintain the standard of quality of the services it provides in connection with the COMFORTCLUB trademark. If, in the future, Barnaby wishes to change or modify any of the Licensed Services it advertises, offers for sale, sells or distributes in connection with the COMFORTCLUB trademark, Barnaby, without charge and prior to any such advertisement, offer for sale, sale, or distribution, shall submit to McAfee for inspection such modified or changed services. McAfee shall have thirty (30) working days following its receipt of the submission within which to object in writing to Barnaby's proposed changes. If McAfee fails to object to the changed or modified service within thirty (30) working days, McAfee shall be deemed to have consented to Barnaby's modification. McAfee's consent to any changes or modifications to any of the Licensed Services shall not be unreasonably withheld. Barnaby may not offer for sale, sell or distribute any Licensed Services to which McAfee has objected in writing pursuant to this paragraph.

During the term of this Agreement, Barnaby shall, in all advertisements, marketing, and all other materials bearing the Mark, use the registered trademark symbol indicating that it is a

registered trademark.

During the term of this Agreement and thereafter Barnaby shall not use the Mark (i) as a portion of or in combination with any other trademarks, or (ii) as all or part of a corporate name, trade name or any other designation used by Barnaby to identify its products, services, or business. Both during and after the term of this Agreement, neither Barnaby nor any parent, subsidiary, affiliated, or related company, nor any person or entity owned or controlled by Barnaby or under common ownership or control as Barnaby, shall use any name, trademark, service mark, trade name, trade dress, or logo, which, in McAfee's sole opinion, is confusingly similar or identical to the Mark.

5. Ownership of the Mark.

Barnaby acknowledges that McAfee is the exclusive owner of the entire right, title and interest in and to the COMFORTCLUB trademark, U.S. Registration No. 3,618,331, in the United States together with the goodwill therein. Barnaby further acknowledges that its future use of the COMFORTCLUB trademark creates in Barnaby no rights in that Mark, and that all use of the COMFORTCLUB trademark by Barnaby shall inure to the benefit of McAfee. Barnaby shall not challenge or, directly or indirectly, assert any right, title or interest in or to the COMFORTCLUB trademark or any variation thereof, or any registration thereof or application for registration thereof.

At the request of McAfee and at McAfee's expense, Barnaby shall execute and deliver all documents which McAfee deems necessary or appropriate to transfer, obtain or maintain any federal trademark registration of the COMFORTCLUB trademark.

6. Infringement.

Barnaby shall promptly inform McAfee in writing of: (1) any infringement or instance of unfair competition involving the COMFORTCLUB trademark of which Barnaby becomes aware, (2) any challenge to Barnaby's use of the COMFORTCLUB trademark, and (3) any claim by any person of any rights in the COMFORTCLUB trademark (collectively, an Infringing Act).

McAfee shall have the right, but not the obligation, in its sole discretion, to take such action in response to an Infringing Act as it deems appropriate. Barnaby shall assist and cooperate with McAfee by furnishing documentary evidence and oral testimony relating to Barnaby's use of the COMFORTCLUB trademark, not only pursuant to this Agreement, but also

as a predecessor in title to the COMFORTCLUB trademark for the Licensed Services. At McAfee's request and expense, Barnaby agrees to be joined as a party in any action instituted by McAfee concerning the protection of the COMFORTCLUB trademark. Barnaby shall have no authority to enforce the rights of McAfee, nor shall Barnaby have any right to demand or control any action taken or proposed to be taken by McAfee to enforce such rights.

If third parties without a license to the Mark and the Licensed Services shall commit an Infringing Act and provide services under the Mark coming within the definition of Licensed Services, and if:

- (1) Barnaby shall give McAfee written notice of such infringement; and
- (2) Barnaby shall request in writing that suit be brought against such third party for the Mark so infringed; and
- (3) Barnaby supplies McAfee with an opinion from the Celum Law Firm, PLLC that such third party is infringing the Mark; and
- (4) McAfee fails to bring such suit or obtain discontinuance of such infringement within ninety (90) days after receipt of Barnaby's written notice of such infringement,

then, in such case, Barnaby, after obtaining McAfee's written authorization to do so, shall have the right to file suit against an infringer, in the name of McAfee and at Barnaby's expense and for Barnaby's benefit. McAfee consents to be a party and to cooperate with Barnaby in any such suit brought by Barnaby pursuant to this paragraph.

7. Indemnification.

(A) To the fullest extent permitted by applicable law, McAfee expressly agrees to defend (at McAfee's expense), indemnify, and save and hold harmless Barnaby and all of its officers, directors, shareholders, employees, agents, successors, and assigns, from and against any and all claims, suits, losses, causes of action, damages, liabilities, and expenses of any kind whatsoever, including without limitation, all expenses of litigation and arbitration, court costs and attorney's fees, arising during or on account of or in connection with alleged infringement of the COMFORTCLUB trademark or alleged wrongful use of the COMFORTCLUB trademark as contemplated by this Agreement.

(B) The obligations of McAfee as stated in paragraph (A), above, apply only if

Barnaby shall (1) notify McAfee in writing of such claims within 10 business days of learning of such claim, (2) McAfee is given exclusive control of the defense of such claims and all negotiations relating to any settlement, and (3) Barnaby assists McAfee in all necessary respects in conduct of the suit.

(C) McAfee shall not indemnify Barnaby for expenses incurred as part of the ongoing dispute with Clockwork IP, LLC. The parties expressly agree that they will assist one another in all necessary respects in conduct of the suit and will be responsible for their own attorney's fees.

(D) McAfee shall defend any and all future intellectual property suits, and indemnify Barnaby for any resulting loss and hold Barnaby harmless from any liability, including costs and expenses, and reasonable attorney's fees, for the infringement of any intellectual property arising on account of or in connection with this Agreement, including any claims for royalties or profits of Barnaby, whether or not said claims be asserted by the owner of the intellectual property, parties or third-parties.

(E) Barnaby shall indemnify and hold McAfee harmless from and against any claim, suit, loss, damage, or expense (including without limitation reasonable attorneys' fees) arising out of or relating to any breach of Barnaby's representations and warranties, or arising out of or relating to the manufacture, marketing, distribution, advertising, promotion or sale of any product or service bearing the Mark, including without limitation, products liability claims, or any other breach of this Agreement, or arising out of the gross negligence of Barnaby or its officers, directors, shareholders, employees, agents, successors, and assigns. In the event of Barnaby's misuse of the Mark, Barnaby shall be responsible for the fees and expenses associated with any legal action or challenge.

8. Termination.

McAfee may terminate this Agreement by providing Barnaby written notice of termination upon the occurrence of the following:

- (1) Barnaby's failure to cure any breach or default under this Agreement within thirty (30) days after receiving written notice thereof from McAfee;
- (2) Barnaby's assignment of its assets or business for the benefit of creditors, or the appointment of a trustee or receiver to administer Barnaby's business or affairs, or the filing of a voluntary or involuntary bankruptcy petition against Barnaby; or

- (3) Barnaby's failure to make regular commercial use of the COMFORTCLUB trademark in connection with the Licensed Services for a period of at least three (3) consecutive years.

Upon the termination of this Agreement, Barnaby shall discontinue all use of the COMFORTCLUB trademark in connection with the advertising, offering for sale, sale or distribution of the Licensed Services. Notwithstanding the foregoing, in the event that this Agreement is terminated pursuant to this paragraph 8(b), Barnaby may phase out the use of the COMFORTCLUB trademark in connection with the Licensed Services over a period not to exceed three (3) months following the date of termination.

9. Assignment.

Barnaby may not assign or transfer this Agreement except as part of the sale or transfer of its entire business. Barnaby shall provide McAfee with written notice of any such sale or transfer of the Agreement at least sixty (60) days prior to the effective date of the sale or transfer. Prior to the effective date of the sale or transfer, McAfee may object to any sale or transfer of the Agreement to a provider of heating, air conditioning, and ventilation equipment and services provider. If McAfee raises such an objection, Barnaby shall exclude this Agreement from the business assets being sold or transferred or, if Barnaby refuses or fails to do so, McAfee may immediately terminate this Agreement.

10. Relationship of the Parties.

The relationship created by this Agreement is that of licensor and licensee. This Agreement does not create an agency relationship between Barnaby and McAfee. Barnaby, its agents and employees shall, under no circumstances, be deemed employees, agents or representatives of McAfee. Neither Barnaby nor McAfee shall have any right to enter into any contract or commitment in the name of, or on behalf of the other, or to bind the other in any respect whatsoever.

11. No Waiver.

Any failure by McAfee or Barnaby to enforce any provision of this Agreement shall not constitute a waiver of McAfee's or Barnaby's rights herein.

12. Governing Law.

This Agreement and the rights and obligations of the parties hereunder shall be governed by

and construed in accordance with the laws of Texas or Ohio, without regard to its conflict of laws principles, and shall be enforceable against the parties in the courts of Texas or Ohio. For such purpose, each party hereby irrevocably submits to the jurisdiction of such courts, and agrees that all claims in respect of this Agreement may be heard and determined in any of such courts.

13. Notices.

Any notice, communication, approval or disapproval and request therefor required or permitted to be sent under this Agreement shall be duly made and shall be valid and effective only if in writing and sent by telefax, with a confirmation copy by First Class mail, or by Registered or Certified Mail, Return Receipt Requested, postage prepaid, to the addresses set forth above.

14. Arbitration.

Any dispute between McAfee and Barnaby arising out of or in connection with this Agreement shall be finally settled by mandatory binding arbitration in either Dallas, Texas or Dayton, Ohio, conducted in accordance with the rules and procedures of the American Arbitration Association. Such arbitration shall be conducted before a single arbitrator, except in matters involving a dispute greater than five hundred thousand dollars, which shall be conducted before a three arbitrator panel with each side selecting one arbitrator and the two arbitrators selected by the parties choosing the third arbitrator. The arbitrator(s) shall be knowledgeable in the subject matter of the dispute. Judgment on a binding arbitration award may be entered in any court of competent jurisdiction. Arbitration has the potential to provide a more timely, more economic and more confidential resolution of any dispute between the parties. There will likely be less discovery and a determination by an agreed upon arbitrator or arbitrators rather than a judge or jury. *The parties mutually acknowledge that, by this agreement to arbitrate, each party irrevocably waives its rights to court or jury trial.*

15. Injunctive Relief.

Barnaby acknowledges and admits that its failure to advertise, promote, and use the Mark in accordance with this Agreement or to otherwise fulfill its obligations under this Agreement or to cease its activities as required upon expiration or termination of this Agreement will result in immediate and irreparable damage to McAfee, and that McAfee will have no adequate remedy at law for the injuries described in this Section. Barnaby agrees that, in the event of such failure,

McAfee shall be entitled to equitable relief by way of temporary, preliminary, and permanent injunctions, and such other and further relief as any court with jurisdiction may deem just, in addition to and without prejudice to any other relief to which McAfee may be entitled.

16. Confidentiality.

Except as required by order of a court or government agency of competent jurisdiction, or by applicable laws, this Agreement and its provisions shall be kept confidential by and among the parties, unless otherwise agreed in writing.

17. Headings in this Agreement.

The headings in this Agreement are for convenience only, confirm no rights or obligations in either party, and do not alter any terms of this Agreement.

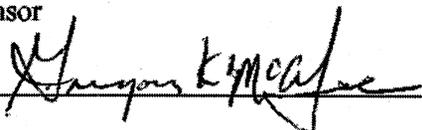
18. Severability.

If any term of this Agreement is held by a court of competent jurisdiction to be invalid or unenforceable, then this Agreement, including all of the remaining terms, will remain in full force and effect as if such invalid or unenforceable term had never been included.

19. Binding Effect.

This Agreement shall be binding upon the parties and their respective successors and assigns. This Agreement may not be amended or modified except by a written instrument, signed by both parties.

McAfee Heating & Air Conditioning Co., Inc.
Licensor

By: 

Name: Gregory K. McAfee

Title: President

Barnaby Heating & Air LLC
Licensee

By: 

Name: Charles Barnum

Title: President

EXHIBIT 7

From: Julie Celum Garrigue jcelum@celumlaw.com

Subject: Clockwork IP's MSJ

Date: June 15, 2015 at 6:17 PM

To: Brad R. Newberg BNewberg@mcguirewoods.com, Amanda L. DeFord ADeFord@mcguirewoods.com



Brad & Amanda,

I am writing to request that you withdraw your recently filed MSJ, as written, and amend to motion to correct misrepresentations made therein, namely, that Barnaby failed to respond to RFA Nos. 36 -45.

Barnaby was never served RFA Nos. 36-45. I have a copy of the original document, as it was received by my office on June 30th and page 9 of 10 is missing, which coincides with a total of 35 RFAs. Additionally, in correspondence dated September 10, 2014 from Ms. Patel to me she affirmatively represented that Clockwork served Barnaby with 35 RFAs. Also, in Petitioner's Motion to Compel, that same affirmative statement, that 35 RFAs were served upon Barnaby, appears on P. 6 of Pet.'s Mot. to Compel.

If you choose not to withdraw your motion, I will advise the panel that you were made aware of the misrepresentation as of today's date, and that you chose to proceed and to advocate your motion in violation of R. 11 of FRCP.

Please let me know by 12:00 tomorrow whether you intend on withdrawing your motion or proceeding with the motion as drafted.

Thanks.

Julie Celum Garrigue

Celum Law Firm, PLLC
11700 Preston Rd., Suite 660, PMB 560
Dallas, TX 75230

P: 214-334-6065

F: 214-504-2289

E: jcelum@celumlaw.com

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From: Newberg, Brad R. BNewberg@mcguirewoods.com
Subject: RE: Clockwork IP's MSJ
Date: June 15, 2015 at 6:38 PM
To: Julie Celum Garrigue jcelum@celumlaw.com, DeFord, Amanda L. ADeFord@mcguirewoods.com

BN

Julie, for you to take three weeks after we file a motion and then, at 7:17 pm say that we have until noon the next day to withdraw a motion or face Rule 11 is neither civil nor conscionable.

First off, our motion is not only based on the RFAs, so regardless of the RFA issue, you will have to respond to the summary judgment motion.

Second, we have the as served 45 RFAs and filed our motion based on our copy of the served RFAs. We didn't create these ten RFAs ourselves. However, we will certainly investigate your claim over the next couple of days to see whether that portion of the motion needs to be withdrawn. Please provide me with the September 10, 2014 correspondence wherein Ms. Patel purportedly affirmatively stated that there were 35 RFAs. I assume that what you will be sending isn't some e-mail where she simply had a typo (or was just looking at your responses) and mentioned 35 as opposed to 45, but rather an actual discussion related to the number of the RFAs wherein she affirmatively stated that it was 35, and NOT 45.

From: Julie Celum Garrigue [jcelum@celumlaw.com]
Sent: Monday, June 15, 2015 7:17 PM
To: Newberg, Brad R.; DeFord, Amanda L.
Subject: Clockwork IP's MSJ

Brad & Amanda,

I am writing to request that you withdraw your recently filed MSJ, as written, and amend to motion to correct misrepresentations made therein, namely, that Barnaby failed to respond to RFA Nos. 36 -45.

Barnaby was never served RFA Nos. 36-45. I have a copy of the original document, as it was received by my office on June 30th and page 9 of 10 is missing, which coincides with a total of 35 RFAs. Additionally, in correspondence dated September 10, 2014 from Ms. Patel to me she affirmatively represented that Clockwork served Barnaby with 35 RFAs. Also, in Petitioner's Motion to Compel, that same affirmative statement, that 35 RFAs were served upon Barnaby, appears on P. 6 of Pet.'s Mot. to Compel.

If you choose not to withdraw your motion, I will advise the panel that you were made aware of the misrepresentation as of today's date, and that you chose to proceed and to advocate your motion in violation of R. 11 of FRCP.

Please let me know by 12:00 tomorrow whether you intend on withdrawing your motion or proceeding with the motion as drafted.

Thanks.

Julie Celum Garrigue

Celum Law Firm, PLLC
11700 Preston Rd., Suite 660, PMB 560
Dallas, TX 75230

P: 214-334-6065
F: 214-504-2289
E: jcelum@celumlaw.com

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From: Julie Celum Garrigue jcelum@celumlaw.com 
Subject: Re: Clockwork IP's MSJ
Date: June 15, 2015 at 7:14 PM
To: Brad R. Newberg BNewberg@mcguirewoods.com
Cc: DeFord, Amanda L. ADeFord@mcguirewoods.com



Brad,

Thanks for the quick response. Below is a copy of Ms. Patel's September 10, 2014 correspondence on HaynesBoone letterhead. Is that official enough for your liking? I would also point out that following Ms. Patel's September 10, 2014 letter, the parties held a conference on the outstanding discovery and there was zero discussion of the RFAs on which you now assert entitled you, in part, to judgment on the pleadings.

As for your rant about civility, and when I notified you, it is civil for me to have notified you at all. I'll assert Rule 11, whether I have your blessing, or not. I was kind enough to provide you an opportunity to correct what is obviously a misrepresentation to the Board, and is counter to representations made not only in written correspondence, and in a telephonic discovery conference, but also in sworn pleadings filed with the Board on your client's behalf.

You did not serve 45 RFAs. You served 35 RFAs. Your previous counsel knew it and adopted that position in representations made to me in writing and in a sworn motion to the Board. You all may have been able to skate on the late-served discovery in this case, but not on this.

Also, my request below was sent at 6:17 my time and I did not ask that you withdraw your motion by noon tomorrow, only that you advise me of your intent now that you know you made material misrepresentations in sworn pleadings.

I am happy to discuss any of that set forth above. Have a great evening.



9.10.2014 - Barnaby
LTOC re Di...iciencies.pdf

Julie Celum Garrigue

Celum Law Firm, PLLC
11700 Preston Rd., Suite 660, PMB 560
Dallas, TX 75230

P: 214-334-6065
F: 214-504-2289
E: jcelum@celumlaw.com

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From: Newberg, Brad R. BNewberg@mcguirewoods.com
Subject: RE: Clockwork IP's MSJ
Date: June 16, 2015 at 11:02 AM
To: jcelum@celumlaw.com
Cc: DeFord, Amanda L. ADeFord@mcguirewoods.com

BN

Julie,

Despite sending an e-mail last night, three weeks after our motion was filed, you asked me to respond regarding our intent by noon today, so I am following through on that request.

We have copies of the as served 45 RFAs. We do not believe there was any misrepresentation in our filings at all. There is no evidence that any RFAs other than the ones we filed with the Board were the RFAs served on you.

We will investigate your allegation regarding the 45 RFAs, but as of right now, we do not believe they hold water. Ms. Patel's letter does not reference any questions regarding the RFAs. It seems absolutely clear that (if not a typo) she was just referencing your objections and answers while typing her letter—you responded to 35 and she wrote that you made a boilerplate objection to 35. The same seems clear in her blanket one-line statement in the motion you mention. That being said, we will make sure that Ms. Patel confirms that those are the facts. I note that you do not say that there was any sort of dispute or clarification regarding whether there were 35 RFAs or 45.

More importantly, your claim does not hold water because your claim appears to rest on some idea that in the RFAs you received "page 9 of 10 is missing" which you say corresponds with 35 RFAs. That is simply not the case. Not only would page 9 of 10 not correspond with any "missing" RFAs, but you re-typed and answered RFA 35 just fine, and that RFA crossed over to the top of the page where RFAs 36-45 resided. You could not have answered that RFA without seeing the others. We also note that you do not point to any correspondence you had with Ms. Patel, where you asked Ms. Patel about the missing page. Please provide that correspondence if it exists. Certainly, I cannot imagine that you will try to tell the Board that you received a set of RFAs with a missing page and simply chose to risk any missing RFAs being deemed admitted and not to inquire.

We will be in contact with Ms. Patel to complete our investigation this week to let you know whether anything I have said above needs to be corrected. It is clear that the *only* issue regarding your allegation is whether Ms. Patel somehow sent you something different than the as served 45 RFAs we had in our files and attached to our motion. If that is not the case, there is nothing to correct or withdraw.

In the meantime, these communications should not be deemed to suspend anything regarding our summary judgment motion, and we assume you will proceed as you see fit.

I will make one note about Rule 11, and that is you should assert it at your peril and only in following the proper rules. Your statement of "it is civil for me to have notified you at all. I'll assert Rule 11, whether I have your blessing, or not." suggests that you are not planning on following the federal and TTAB rules at all, especially the ones regarding notice and timing of motions asserted under Rule 11.

And, in reference to Rule 11, Clockwork does not waive any rights based on its statements above and does not mean the statements above to be interpreted as a way to side-step the specific timing

requirements of Rule 11. Should you draft a Rule 11 motion, we would expect that you follow through with all of the notice and timing requirements, including the 11(c) and TBMP 527.02 safe harbor.

Brad R. Newberg
McGuireWoods LLP
1750 Tysons Boulevard
Suite 1800
Tysons Corner, VA 22102-4215
703.712.5061 (Direct Line)
703.712.5187 (Fax)
bnewberg@mcguirewoods.com
<http://www.mcguirewoods.com>
[Brad R. Newberg Profile](#)

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From: Julie Celum Garrigue jcelum@celumlaw.com
Subject: Re: Clockwork IP's MSJ
Date: June 19, 2015 at 2:55 PM
To: Brad R. Newberg BNewberg@mcguirewoods.com
Cc: DeFord, Amanda L. ADeFord@mcguirewoods.com

Brad,

Thanks for your response.

In light of having to respond to your sanctions motion and the myriad of issues raised by your summary judgment motion, I would ask for a stipulation of time to respond to your summary judgment until Thursday, July 2nd. Please let me know whether you can agree and I will file the appropriate stipulation/motion.

Julie Celum Garrigue

Celum Law Firm, PLLC
11700 Preston Rd., Suite 660, PMB 560
Dallas, TX 75230

P: 214-334-6065
F: 214-504-2289
E: jcelum@celumlaw.com

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On Jun 19, 2015, at 1:19 PM, Newberg, Brad R. <BNewberg@mcguirewoods.com> wrote:

Julie,

I mentioned that I would "be in contact with Ms. Patel to complete our investigation this week to let you know whether anything I have said above needs to be corrected." We have done that and Ms. Patel has confirmed that what we filed with the Board with the 45 RFAs is the same document she served on you.

Brad R. Newberg
McGuireWoods LLP
1750 Tysons Boulevard
Suite 1800
Tysons Corner, VA 22102-4215
703.712.5061 (Direct Line)
703.712.5187 (Fax)
bnewberg@mcguirewoods.com
<http://www.mcguirewoods.com>
[Brad R. Newberg Profile](#)

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EXHIBIT 8



September 10, 2014

Via Email to jcelum@celumlaw.com

Julie Celum Garrigue, Esq.
Celum Law Firm, PLLC
11700 Preston Road
Suite 660, PBM 560
Dallas, Texas 75230

Re: *Clockwork IP, LLC v. Barnaby Heating & Air, LLC*
Cancellation No. 92057941 (Our Ref.: 46889.81)

Dear Julie:

Further to my email earlier this week requesting a telephone conference, this represents our good faith effort to resolve Respondent Barnaby Heating & Air, LLC's deficient responses provided to Petitioner's First Set of Interrogatories, Petitioner's First Set of Requests for Production of Documents, and Petitioner's First Requests for Admission. Please provide times for a telephone conference on **Friday, September 12, 2014**, to discuss how we can resolve these deficiencies. Moreover, in a further showing of good faith, and since we have yet to receive any responsive documents, we suggest an additional 30 day extension of deadlines in the above referenced cancellation proceeding. Absent further discussions and the extension of deadlines, we will have no choice but to consider a Motion to Compel and/or Sanctions – or escalation to federal litigation.

As set forth below, the responses suffer from numerous deficiencies and, in almost all instances, fail to set forth basic information called for by Clockwork IP, LLC and required by the Federal Rules of Civil Procedure, the Code of Federal Regulations, and the Trademark Trial and Appeal Board Manual of Procedure. Clockwork submitted 27 Interrogatory Requests to Barnaby, and in response, we received over 110 objections from you with very few substantive responses. For the 90 Requests for Production Clockwork submitted to Barnaby, we received 270 objections and not a single responsive document. Barnaby cannot wholesale ignore its discovery obligations.

Respondent has asserted several improper and meritless objections to the requests for discovery. One of the most inappropriate objections that you lodged for each and every one of Petitioner's requests was that Respondent allegedly has no obligation to respond to Petitioner's requests for discovery because they were served outside of the discovery period. While this objection

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occasionally takes a slightly different form in wording, the substance remains the same – in any form, it is completely without merit. Petitioner mailed its requests for discovery to Respondent on June 4, 2014, via First-Class Mail. When service is made via First-Class Mail, the date of mailing is considered the date of service. 37 C.F.R. § 2.119(c). Petitioner's requests were therefore timely served on Respondent during the discovery period, namely on June 4, 2014. Interrogatories, Requests for Production, and Requests for Admission may be served on an opposing party up through the closing date of discovery, and a responding party may not object to such requests on the basis that responses would be due after the close of the discovery period. TBMP § 403.03; *see also* 37 C.F.R. § 2.120(a)(3).

Respondent contends that it did not receive Petitioner's discovery requests until July 2, 2014. In a show of good faith and in an effort to obtain evidence so that the Board may decide this proceeding on its merits, Petitioner agreed to allow Respondent an extension of time until July 15, 2014, respond to Petitioner's discovery requests. Respondent accepted Petitioner's offer of extension, only to reply with the above-described objection applied to each and every one of Petitioner's discovery requests. Such action conveys a lack of intention to cooperate and conduct discovery in good faith.

In addition to its untenable objection regarding timeliness, Respondent's answers to Petitioner's discovery requests are inadequate for a host of additional reasons. To be clear, Respondent failed to produce (or make available) a single document or thing to Clockwork. Respondent has raised other meritless objections and has failed to answer any request for discovery in a way that indicates a good faith attempt to comply with the rules governing this proceeding.

As you are well aware, the grounds for cancellation concern ownership of the COMFORTCLUB mark, likelihood of confusion, the seniority/priority of Clockwork's rights in the COMFORTCLUB, and relatedly, Barnaby's procurement of Registration No. 3,618,331 based on fraudulent statements made to the U.S. Trademark Office. In the interest of efficiency for both parties, Clockwork submitted very targeted discovery requests seeking specific information related to these particular issues raised in the cancellation – and yet, we received inapplicable objections from Barnaby claiming “undue burden,” “irrelevant,” speculative, and for information only Barnaby would know, “opportunity to discovery on your own.” The strangest of them all was your objection that numerous Interrogatories were “premature until additional discovery is conducted,” – to be clear, the discovery period was already closed when you submitted your objections, so this position was and is nonsensical.

Having said all this, in an effort to resolve this issue, we have illustrated some of the deficient answers below. Also, for talking points, we have also enclosed a chart that outlines our

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discovery request as well as your main meritless objections thereto. We are hopeful that by bringing these issues to light and allowing Registrant an opportunity to respond properly, we can conduct discovery appropriately with respect to Petitioner's request as a whole.

Interrogatories

Respondent's Answers and Objections to Petitioner's First Set of Interrogatories suffer from a myriad of deficiencies. Interrogatories must be answered by the party to whom they are directed. Fed. R. Civ. P. 33(b)(1); TBMP § 405.04(c). To the extent that it is not objected to, each interrogatory must be answered "separately and fully in writing under oath." Fed. R. Civ. P. 33(b)(3). Where Respondent has in fact provided an answer, it has not endeavored to answer in a manner that is responsive to the question asked – rather, it seems to be a boilerplate and generally irrelevant statement regarding Respondent's stated date of first use. Respondent appears to have provided such an unresponsive answer just so it can allege that it "responded" to at least a small percentage of the discovery requests submitted by Clockwork.

Beyond these general insufficiencies, each response provided is inadequate for other reasons, including the assertion of meritless objections. In an effort to resolve this inadequacy, we have detailed some of the issues below and can discuss all of the concerns based on the enclosed grid during our conference. To be clear, the following examples are illustrative in nature and are not meant to be considered a comprehensive explanation of the deficiencies of Respondent's discovery responses.

Response to Interrogatory No. 9:

This interrogatory asked the Respondent to "[d]escribe and identify all documents and things relating to and showing Respondent's use of Respondent's Mark in commerce before and after Mr. Charles Barnaby's execution of the Success Academy 'Acknowledgement of Non-Solicitation Policy' dated March 17, 2008." Respondent provided, subject to its objections, the following non-responsive answer: "Respondent has used the COMFORTCLUB mark continuously and consistently since, at least as early as January 22, 2008."

Respondent's answer is not only inadequate; it fails to relate to the question asked. Petitioner requested that Respondent *describe* and *identify* all *documents and things* relating to and showing Respondent's use of its mark in commerce at specified points in time. Respondent's answer is merely an assertion that Respondent has used its mark, something that is not in dispute and about which Petitioner has not inquired in this interrogatory. Since this request is specifically directed to the issues of priority, first use, ownership, and fraud on the Trademark Office, it is quite relevant and we would expect Respondent to provide an answer to this interrogatory that is responsive to the question asked.

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Respondent has also raised several objections to this Interrogatory, none of which has merit. As explained above, the objection as to the timeliness of the Interrogatories and Respondent's duty to answer them is baseless.

The objection on the ground that "this request asks for information that the requesting party has had ample opportunity to discover on its own" is also flawed and seemingly stems from a misunderstanding of the Fed. R. Civ. P. 26(b)(2)(C)(ii), which Respondent cites in support of its objection. The actual text of that rule instructs a court to limit the frequency or extent of discovery where "the party seeking discovery has had ample opportunity to obtain the information *by discovery in the action.*" Clockwork's request for this information was via its first and only discovery requests in the action. As explained previously, the applicable rules provide that discovery requests may be served through the end of the discovery period. Petitioner's request was therefore within its "opportunity for discovery" period, and Respondent's objection is moot.

Respondent further objected on the ground that the interrogatory calls for speculation with respect to the document described in the interrogatory. This document, however, was described with detail and specificity, eliminating any possibility that Respondent would need to speculate as to the nature or identity of the document. Petitioner requests that Respondent provide a response to this and all other interrogatories that is complete and responsive.

Response to Interrogatory No. 25:

This interrogatory sought an identification of the persons having knowledge of allegations and facts asserted in Respondent's interrogatory responses, as well as the substance of those persons' knowledge. In answer, Respondent raised several objections and then "refer[red] Petitioner to Respondent's Rule 26(a)(1) disclosures for a list of those individuals Respondent believes have the most knowledge about the facts of this case." This improper answer is not responsive to the question asked. Petitioner did not inquire as to the persons who have knowledge about the case, but rather into those persons who provided the information contained in Respondent's interrogatory responses. This is especially relevant to Petitioner as there is no indication in Respondent's responses that anyone besides Respondent's counsel even saw the discovery requests.

As to the objections raised by Respondent, none is well-taken as all are without merit. As explained above, the objection as to the timeliness of the interrogatories and Respondent's duty to answer them is baseless. Respondent further objected on the ground that this interrogatory asks for opinions and contentions, but an interrogatory is not objectionable merely because it

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calls for an opinion. Fed. R. Civ. P. 33(a)(2); TBMP § 405.02. Respondent's additional objection that the interrogatory is premature until additional discovery is conducted is completely baseless, as the discovery period is now closed.

Respondent's decision to "decline[] to provide a narrative answer . . . because the interrogatory asks for information that is available from its business and electronically stored records" is improper in the context of a proceeding before the Trademark Trial and Appeal Board. We would remind you that, while the Federal Rules of Civil Procedure do apply to these proceedings, they are also modified by the Trademark Trial and Appeal Board Manual of Procedure. Where the answer to an interrogatory may be derived from the business records of the responding party, and the burden of deriving such information is substantially the same for either party, the responding party may answer "by specifying the records from which the information may be derived or ascertained, and affording the propounding party reasonable opportunity to examine, audit, or inspect the records and to make copies, compilations, abstracts or summaries." TBMP § 405.04(b). In this case, the burden to Respondent of identifying the persons who have knowledge of the facts alleged in its interrogatory responses is far less than the burden to Petitioner of deriving this information from Respondent's business records, so the objection is not proper. Even assuming otherwise, however, Respondent still has not sufficiently complied with the rule as Respondent has failed to specify the records in sufficient detail to "permit the propounding party to locate and identify, as readily as can the responding party, the records from which the answer may be ascertained." TBMP § 405.04(b). In fact, Respondent has made no relevant records available to Petitioner at this time.

Respondent's objection that this request is "over broad and unduly burdensome" is absurd on its face. Petitioner has asked for a list of the persons having knowledge of the facts alleged in its interrogatory responses, and the substance of those persons' knowledge. It is beyond the bounds of reason to assert that making such a list and providing such information is "over broad" or "unduly burdensome," as it simply requires a clerical action be performed alongside the information gathering that is a necessary prerequisite to providing responses to discovery requests.

Similarly, the objection that such a request "calls for speculation by Respondent as to each and every individual who may have knowledge about Respondent's prior use of the COMFORTCLUB mark" is without merit. First, such an objection is not relevant to the question as Petitioner has not asked for persons with knowledge about use, but persons with knowledge of facts alleged in interrogatory responses. Second, it requires no speculation to provide the name and information regarding the knowledge of a person who provided information contained in a

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discovery request. Petitioner requests that Respondent provide a response to this and all other interrogatories that is complete and responsive.

Requests for Production

Respondent's Answers and Objections to Petitioner's First Set of Requests for Production of Documents are likewise deficient. An answer must be provided for each item, stating that inspection and related activities will be permitted as requested or stating an objection. Fed. R. Civ. P. 34(b)(2)(A); TBMP § 406.04. Alternatively, a responding party may simply produce the documents.

All 90 of Petitioner's Requests for Production have been objected to and "answered" in exactly the same way, all of which are inadequate. The most outrageous objection set forth by Respondent is as follows: "If the parties can agree to a reciprocal extension of the discovery deadlines in this case, Respondent will provide assistance to Petitioner in retrieving electronically stored records." This clearly demonstrates Respondent's lack of intention to make a good faith effort to respond to Petitioner's discovery requests – despite being obligated to do so. Barnaby failed to serve discovery requests on Clockwork during the discovery period and its misstep has no bearing on Barnaby's obligation to timely and comprehensively responds to discovery requests timely served upon Respondent.

Response to Request for Production No. 6

This was a request for documents concerning the first use and use in commerce of Respondent's mark by or on behalf of Respondent. In answer, Respondent raised several objections and then, subject to those objections, stated that "Respondent will rely on any and all documents that tend to support its defenses in this case, including, but not limited to, its business records, those documents that Petitioner and Respondent will include on their exhibit lists, any and all documents identified by Petitioner and Respondent in their Rule 26(A)(1) Disclosures and in Petitioner's most recent June 4, 2014 Supplemental Disclosures, any and all documents on file with the U.S. Patent & Trademark Office, and the Trademark Trial and Appeal Board."

This answer is inadequate. Respondent may not make a blanket statement as to the documents on which it intends to rely, some of which—like "exhibit lists"—may not exist in a proceeding before the Trademark Trial and Appeal Board. Moreover, Respondent has not even indicated that it will make these insufficiently described documents available to Petitioner, let alone that it will produce the documents by copying and forwarding them to us, which is the Board's preferred method of production. TBMP § 406.04(b); Fed. R. Civ. P. 34(b)(2)(E).

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As to the objections raised by Respondent, none is well-taken as all are without merit. As explained above, the objection as to the timeliness of the requests and Respondent's duty to answer them is baseless.

Respondent's objection that this request is "over broad and unduly burdensome" is absurd on its face. Petitioner has asked for documents that relate to Respondent's first use of its mark. These are documents which Respondent itself will require in order submit evidence relating to priority, one of the issues in dispute in this action.

Respondent's objection that this request is "not narrowly tailored to a specific fact or issue in this matter" is likewise beyond the bounds of a reasonable objection. This request is narrowly tailored to the specific issue of priority. Petitioner requests that Respondent provide a response to this and all other requests that is complete and responsive.

Requests for Admission

In responding to a Request for Admission, a party must specifically deny the request or state in detail why he cannot truthfully admit or deny it. Fed. R. Civ. P. 36(a)(4). A denial must fairly respond to the substance of the matter. Fed. R. Civ. P. 36(a)(4); TBMP § 407.03(b). We note that all 35 of Petitioner's Requests for Admission have been objected to in the same manner and have all been denied, with the exception of Request for Admission No. 16, which Respondent was "unable to admit or deny." Such boilerplate objections and denials, some of which suggest that objections and answers were lodged without even reading the request, undermine the "fair response" and "good faith" contemplated by the applicable rules. In light of this, the accuracy and veracity certain denials are certainly in question – making Respondent's responses to the other discovery requests even more important.

As indicated, Petitioner wishes to resolve these outstanding discovery issues quickly and without further Board intervention. "The Board expects parties (and their attorneys or other authorized representatives) to cooperate with one another in the discovery process, and looks with extreme disfavor on those who do not." TBMP § 408.01. It is our hope that, by explaining the deficiencies of Respondent's discovery answers, Respondent will now provide answers that are complete, responsive, and made in good faith. However, if Respondent does not respond to our request for conference this week, Petitioner will seek TTAB intervention and/or escalation to federal litigation.

haynesboone

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I look forward to hearing from you at your earliest convenience.

Sincerely,

/Purvi Patel Albers/

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Enclosures

D-2303047_1

EXHIBIT 9

ESTTA Tracking number: **ESTTA637502**

Filing date: **11/06/2014**

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

Proceeding	92057941
Party	Plaintiff Clockwork IP, LLC
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Submission	Motion to Compel Discovery
Filer's Name	Purvi J. Patel
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Signature	/Purvi J. Patel/
Date	11/06/2014
Attachments	Motion to Compel & Dec NO Exhibits.pdf(2174459 bytes) Motion to Compel Exhibits A-J.pdf(4757477 bytes) Motion to Compel Exhibit K.pdf(1545742 bytes)

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

Clockwork IP, LLC	§	Mark: COMFORT CLUB
	§	
<i>Petitioner,</i>	§	
	§	
v.	§	Cancellation No. 92057941
	§	In re Registration No. 3618331
Barnaby Heating & Air	§	
	§	
	§	
<i>Respondent.</i>	§	

PETITIONER’S MOTION TO COMPEL DISCOVERY RESPONSES

Pursuant to 37 C.F.R. §2.120(e), and T.B.M.P. § 523, Petitioner Clockwork IP, LLC hereby moves the Trademark Trial and Appeal Board (the “Board”) to compel discovery responses from Respondent Barnaby Heating & Air. Respondent’s objections and responses to Petitioner’s discovery requests suffer from numerous deficiencies and, in almost all instances, fail to set forth basic information called for by Petitioner and required by the Federal Rules of Civil Procedure, the Code of Federal Regulations, and the Trademark Trial and Appeal Board Manual of Procedure. Therefore, the Board should order Respondent to amend its responses to the discovery requests further detailed below and produce the documents requested.

I. INTRODUCTION

During the discovery period in this proceeding, Petitioner served over 150 interrogatories, requests for production, and requests for admission on Respondent. Respondent served none.

As this case approaches the parties’ respective trial periods, Respondent has attempted to cure its failure to diligently pursue discovery in this case. Its two primary attempts to reopen discovery include (1) arguing that Petitioner’s discovery requests – served well within the discovery period – were untimely and therefore only a reciprocal reopening of discovery can compel Respondent to properly respond, and (2) assigning Registration No. 3,618,331 to a non-party –arguably in bad faith – in an effort to create new issues requiring the re-opening of discovery.

Respondent should not be allowed to obstruct this proceeding or Petitioner's ability to obtain discovery by asserting blanket nonsensical objections and failing to timely disclose assignments even though such assignments were sought *in Petitioner's discovery requests*. The Board should order Respondent to properly respond to Petitioner's discovery and to not permit reciprocal discovery to occur.

II. BACKGROUND OF PROCEEDINGS

A. Petitioner's Discovery Requests

On September 27, 2013, Petitioner filed this Cancellation No. 92057941 against Respondent's registration of the mark COMFORTCLUB ("Respondent's Mark") shown in U.S. Registration No. 3,618,331 (the "Registration"). A Scheduling Order was issued by the Board that same day, wherein discovery was set to open on December 6, 2013 and close on June 4, 2014.

Petitioner timely served its First Set of Interrogatories, First Set of Requests for the Production of Documents and Things, and First Set of Requests for Admissions to Respondent via First Class Mail on June 4, 2014. Declaration of Purvi J. Patel ("Patel Decl.") ¶¶ 2-4, **Exhibits A, B, and C (collectively, Petitioner's Discovery Requests)**". At no point did Respondent serve any discovery requests on Petitioner. Patel Decl. ¶ 5. However, in the context of settlement negotiations, Petitioner has supplied Respondent with documentation and evidence supporting its claims. A representative sample of that documentation is attached to the Patel Decl. as **Exhibit D**.

On June 30, counsel for Respondent contacted counsel for Petitioner via email and stated that she had just received, for the first time, Petitioner's Discovery Requests. Patel Decl. ¶ 7, **Exhibit E**, p. 1. Counsel for Respondent stated that "through no fault of your client's [Petitioner] or mine [Respondent]" the envelope containing the requests was delivered to another mailbox holder in counsel's suite. *Id.* Respondent requested additional time to respond to Petitioner's Discovery Requests due to the delay. *Id.* The parties eventually agreed that Respondent's deadline to respond would be extended until July 15, 2014. *Id.* at p. 2. No agreement to reopen discovery was discussed at that time, and counsel for Respondent made no assertion that Petitioner's Discovery Requests were untimely. Patel Decl. ¶ 7.

B. Respondent's Objections and Responses

On July 15, Respondent served its Objections and Responses to Petitioner's First Set of Interrogatories, First Requests for Production, and First Requests for Admission ("Respondent's Objections and Responses"). Patel Decl. ¶ 8, **Exhibit F**. Respondent's Objections and Responses contained very few substantive responses, and contained *over 350 objections*. Notably, Respondent objected to each and every one of Petitioner's Discovery Requests with an objection of untimeliness, arguing that Respondent did not receive Petitioner's Discovery Requests until July 2, 2014, a direct contradiction to Respondent's previous correspondence with Petitioner. *See, e.g., Exhibit F* at p. 3. Respondent further noted that it "is willing to enter into a reciprocal extension of the discovery deadline in this case," intimating that it would be cooperative only if Petitioner were to agree to reopen discovery. *Id.* at p. 5.

On July 16 – prior to receipt of Respondent's Objections and Responses – Petitioner proposed a 30 day extension of the outstanding dates in this proceeding, as Petitioner's Pretrial Disclosures were due in three days and additional time would be needed to review Respondent's incoming discovery responses. Patel Decl. ¶ 9, **Exhibit G**, p. 2. In her response dated July 17, 2014, counsel for Respondent again falsely suggested that Petitioner's Discovery Requests were served outside the discovery period and that "documents responsive to Petitioner's Discovery Requests] may be obtained only upon a reciprocal extension of the discovery deadline." *Id.* at p. 1. The parties continued to conference on the above issues and agreed to a 60-day extension of all future deadlines. Patel Decl. ¶ 9. During the parties' conferencing, counsel for Respondent represented that once the extension was filed, Respondent would move forward with supplementing its discovery responses and would produce documents. *Id.* The Board granted the parties' stipulated motion to extend the outstanding case deadlines. However, Respondent initially failed to supplement its discovery responses or produce responsive documents as it had previously represented. *Id.*

C. Petitioner's Attempts to Conference on Respondent's Deficient Discovery Response

On September 9, counsel for Petitioner emailed counsel for Respondent requesting a discovery conference via telephone to resolve the deficiencies in Respondent's Objections and Responses. Patel Decl. ¶ 10, **Exhibit H**. Petitioner also proposed an additional 30-day extension of the outstanding case deadlines as an option to assist in the resolution of the discovery issues. *Id.* Petitioner followed up with Respondent the next day with a more detailed outline of its issues with Respondent's Objections and Responses. Patel Decl. ¶ 11, **Exhibit I**. Petitioner's counsel followed up later that day with a phone call to Respondent's counsel. Patel Decl. ¶ 11. Respondent's counsel indicated that she would be reviewing Petitioner's letter but there were alleged "new facts" that would impact the case. Respondent's counsel agreed to a discovery conference to take place on September 12, 2014. *Id.*

Later that evening, counsel for Respondent sent additional emails alleging that (1) Petitioner had not responded to Respondent's demand to re-open discovery, (2) Petitioner had failed to disclose a cease & desist letter allegedly sent to a third-party in August 2014 (despite there being no outstanding discovery requests requiring Petitioner to make such a disclosure), (3) represented that Respondent had documents responsive to Petitioner's Discovery Requests that were never produced, including documents related to Petitioner's first use of the COMFORTCLUB mark. **Exhibit I**, p. 11. Petitioner attempted to address Respondent's concerns and again inquired as to whether Respondent would conference on its discovery deficiencies or would be amenable to a 30-day extension of the outstanding case deadlines. *Id.* at pp. 9-10. The parties subsequently conferenced on the outstanding issues on September 12, at which Respondent agreed to supplement its discovery responses and make responsive documents available by no later than September 24. Patel Decl., ¶ 12, **Exhibit J**, p. 2. The parties also agreed to a 45 day extension of all open deadlines, but expressly did not agree to open any past/closed deadlines, including the discovery period. *Id.*

On September 16, 2014, Respondent's counsel indicated that Respondent intended on "filing a joinder" (without providing any information regarding the parties that sought to join) and a "motion to

reopen discovery/reset the current deadlines” and requested consent from Petitioner for same. **Exhibit J**, p. 1. Petitioner’s counsel denied consent. *Id.*

D. Respondent’s Amended Discovery Responses

On September 25, Respondent served its First Amended Responses to Petitioner’s First Interrogatories, Request for Production and Request for Admission (the “Amended Response”). Patel Decl., ¶ 13, **Exhibit K**. While Respondent updated its interrogatory responses, some of which are now substantially responsive, the majority of the Amended Response consisted of the same objections and non-responses as contained in Respondent’s original response. Furthermore, while counsel for Respondent represented that the production in response to Petitioner’s Discovery Requests was “voluminous,” the production consisted of only 237 pages, approximately 200 of which Petitioner already had access to (as publicly available documents from the PTO or because they were correspondence between Petitioner and Respondent). Patel Decl., ¶ 13.

The last document produced was an unsigned assignment of Respondent’s mark to a company named McAfee Heating & Air Conditioning, Inc. (“McAfee”), with a license back to Barnaby. Patel Decl., ¶ 14, **Exhibit L**. Respondent’s Amended Response also represented – for the first time – that Respondent had allegedly assigned Respondent’s Mark to McAfee. **Exhibit K**, p. 19. However, no executed documents regarding the assignment were included with the Amended Responses. Petitioner anticipated that Respondent would supplement its production with executed documents, especially in light of Respondent’s recently requested joinder, though no supplementation ever arrived. Patel Decl., ¶ 14.

E. Respondent attempts to re-open discovery through joinder

On October 17, nearly a month after serving the Amended Response, Respondent filed a Motion to Join and Motion to Reopen and Extend the Trial Setting. Respondent’s motion alleges that Respondent assigned Respondent’s Mark to McAfee on September 30 (despite assertions in the Amended Response that the assignment was earlier) – well after the close of discovery in this case. Respondent’s motion argues that McAfee would be prejudiced if it is joined in this proceeding and it is not allowed to participate in the now-closed discovery. Respondent also makes a strange assertion on behalf of McAfee

that McAfee “agrees to be joined in this proceeding, only if discovery is reopened and [McAfee] is allowed to participate in discovery,” implying that McAfee may be contesting its appearance in this case. These assertions by Respondent once again show that it is attempting to remedy its failure to conduct discovery by roping in another party to this proceeding.

III. RESPONDENT’S DEFICIENT DISCOVERY RESPONSES

Interrogatories must be answered by the party to whom they are directed. Fed. R. Civ. P. 33(b)(1); T.B.M.P. §405.04(c). To the extent that an interrogatory is not objected to, each one must be answered “separately and fully in writing under oath.” Fed. R. Civ. P. 33(b)(3). In addition, if a party fails to respond to a request for production, a party may move for an order compelling that production. Fed. R. Civ. P. 37(a)(3)(B)(iv).

Petitioner’s Discovery Requests consist of 26 interrogatories, 90 requests for production, and 35 requests for admission. Respondent answered Petitioner’s Discovery Requests by asserting one of a variety of global objections to each request. Subject to those objections, Respondent produced a meager 237 pages of documents. If one excludes publicly available documents (such as documents from the TSDR system) and correspondence between the parties in this matter, only around 25 pages of these documents consist of Respondent’s records that Petitioner did not otherwise have access to. After reviewing these documents and the Amended Response, nine interrogatory responses and 76 Request for Production responses are deficient.

Because Respondent’s objections to Petitioner’s Discovery Requests are similar, and to assist the Board with the resolution of Petitioner’s numerous issues with Respondent’s Amended Response, Petitioner categorizes below the discovery requests to which Respondent has not sufficiently responded to according to their relevance to the issues before the Board. Petitioner will then address Respondent’s objections in Section IV.

A. Requests related to Respondent's alleged conception/first use of the COMFORTCLUB mark.

The crux of this case centers around Petitioner's three main claims - that Respondent committed fraud when it applied for registration of the COMFORTCLUB mark pursuant to Section 14 of the Trademark Act ("**Fraud Claim**"), and relatedly that Respondent was not the rightful owner of Respondent's Mark at the time it filed the application, nor was it the rightful owner of Respondent's Mark at the time of the filing of this cancellation, and thus the registration is void *ab initio* pursuant to Section 1 of the Trademark Act ("**Incorrect/Wrongful Applicant Claim**"), as well as likelihood of confusion under Section 2(d) of the Trademark Act ("**2(d) Claim**"). Therefore, Petitioner's requests related to Respondent's alleged conception and first use of the COMFORTCLUB mark are highly relevant. However, Respondent has not sufficiently responded to the following requests related to Respondent's first use:

- **Interrogatory No. 2** (the reasons for Respondent's selection of COMFORTCLUB and the filing of U.S. Registration No. 3,618,331);
- **Interrogatory No. 8** (all goods and services with which Respondent's Mark has been, is intended to be, or is currently used);
- **Request for Production No. 3** (all documents related to Respondent's creation, selection, and adoption of Respondent's Mark);
- **Request for Production No. 6** (all documents relating to the first use anywhere and in commerce of Respondent's Mark by or on behalf of Respondent);
- **Request for Production No. 11** (all documents supporting or negating Respondent's priority and ownership of COMFORTCLUB);
- **Request for Production No. 35** (all documents relating to Respondent's selection of Respondent's Mark and the decision to file a U.S. Trademark application for COMFORTCLUB);
- **Request for Production No. 77** (all documents relied upon by Respondent to support the allegation in its trademark application that Respondent was the rightful "owner of the trademark/service mark sought to be registered");
- **Request for Production No. 79** (all documents relating to Respondent's reasons for selecting the mark "COMFORTCLUB" as a compounded or unitary mark).

Petitioner notes that Respondent has not only been unresponsive with respect to these requests, but simultaneously, has failed to provide supplemental responsive information or documentation with respect to the first use, priority, or alleged ownership of the COMFORTCLUB mark by McAfee Heating & Air. Petitioner notes that joinder is irrelevant for these purposes as requests like those made in Request for Production Nos. 6 and 11 apply to McAfee as well.

B. Requests related to Petitioner's allegation that Respondent appropriated COMFORTCLUB mark from Petitioner.

One of the bases for Petitioner's Fraud Claim as well as its Incorrect/Wrongful Applicant Claim against Respondent is that Respondent had knowledge of Petitioner's ownership and prior use of the COMFORTCLUB mark due to Respondent's attendance at seminars and presentations held or run by Petitioner. Therefore, requests related to Respondent's knowledge of and/or attendance at these seminars, and any prior relationship between Respondent and Petitioner, is highly relevant to Petitioner's claims and therefore discoverable. Respondent has not sufficiently responded to the following requests related to this issue:

- **Interrogatory No. 9** (describe all facts relating to Respondent's use of Respondent's Mark in commerce before and after Mr. Charles Barnaby's execution of the Success Academy "Acknowledgment of Non-Solicitation Policy" dated March 17, 2008);
- **Interrogatory No. 21** (identify all interactions Respondent had with Petitioner or Petitioner's legal representatives prior to the filing of its application for U.S. Registration No. 3,618,331);
- **Request for Production No. 12** (all agreements and policies between Petitioner and Respondent, Respondent and SGI, and Respondent and AirTime 500);
- **Request for Production No. 13** (all written communications between Petitioner and Respondent; Respondent and SGI; and Respondent and AirTime 500);
- **Request for Production No. 14** (all documents relating to Respondent's attendance of any Success Day or Success Academy events, CONGRESS franchise events, SGI EXPO events, BRAND DOMINANCE events, and Senior Tech events);
- **Request for Production No. 33** (all documents showing or relating to Respondent's awareness of, and first dates of awareness of Petitioner's Mark);

- **Request for Production No. 78** (all documents relating to any and all interactions Respondent had with Petitioner or Petitioner's legal representatives prior to the filing of its application for U.S. Registration No. 3,618,331);
- **Request for Production No. 81** (all documents referring or relating to the priority and seniority of Petitioner's COMFORTCLUB mark);

C. Requests related to the likelihood of confusion between Respondent's Mark and Petitioner's Mark

Due to Petitioner's 2(d) Claim, any requests that are related to a factor that would show priority and a likelihood of or actual confusion is therefore highly relevant and will lead to the discovery of admissible evidence. However, Respondent has failed to sufficiently respond to the following requests:

- **Interrogatory No. 14** (describe all facts relating to any alleged association between Petitioner and Respondent);
- **Interrogatory No. 16** (identify each person that was a potential customer of Respondent who would have received any advertising or marketing material displaying Respondent's Mark);
- **Request for Production No. 5** (all documents relating to communications issued or received by Respondent relating to Petitioner's Marks);
- **Request for Production No. 10** (all documents and things relating to the types of customers to whom Respondent has provided or is providing products or services under Respondent's Mark);
- **Request for Production No. 16** (all documents relating to distribution of and trade channels for the services identified by Respondent's Mark);
- **Request for Production No. 18** (all documents relating to communications between Respondent and any third party concerning Respondent's Mark or Petitioner's Mark);
- **Request for Production No. 21** (all documents and things relating to Petitioner's Marks, including all documents and things relating to any search, inquiry, investigation, or marketing survey that has been or will be conducted relating to Petitioner's Mark);
- **Request for Production No. 22** (all documents and things relating to any possibility of confusion as to the source of original or sponsorship of any product or service arising out of use of Respondent's Mark);
- **Request for Production No. 23** (all documents relating to any likelihood of confusion between Respondent's Mark and Petitioner's Marks);
- **Request for Production No. 24** (all documents relating to any instances of actual confusion between Respondent's Mark and Petitioner's Marks);

- **Request for Production No. 25** (all documents relating to any instances of actual confusion regarding a connection between Petitioner or Petitioner's services and Respondent);
- **Request for Production No. 29** (all documents and things relating to the strength or distinctiveness of Respondent's Mark or Petitioner's Mark);
- **Request for Production No. 30** (all documents and things relating to any application submitted by Respondent to register Respondent's Mark on any trademark register worldwide);
- **Request for Production No. 56** (all documents and things sufficient to identify the particular market or market segment in which Respondent's services compete, and all competitors);
- **Request for Production No. 63** (all documents relating to searches, investigations, surveys, etc. conducted by Respondent relating to Respondent's Mark);
- **Request for Production No. 64** (all documents referring or relating to any objections Respondent has received concerning his use and/or registration of Respondent's Mark);
- **Request for Production No. 69** (all documents relating to judicial or administrative proceedings referring or relating to Respondent's Mark or Goods);
- **Request for Production No. 73** (all documents sufficient to identify the meaning of Respondent's Mark and the messages that it intends to convey to consumers);
- **Request for Production No. 74** (all documents and things sufficient to identify the ways in which the type of consumer to whom Respondent has been marketing its goods and services under Respondent's Mark is different from the type of consumer to whom Respondent believes Petitioner is marketing its goods and services);
- **Request for Production No. 75** (all documents and things relating to all known third-party uses of terms comprised of or containing "Comfort" and "Club" in connection with HVAC);
- **Request for Production No. 80** (all documents referring or relating to the similarity of Respondent's COMFORTCLUB mark and Petitioner's COMFORTCLUB mark);
- **Request for Production No. 82** (all documents referring or relating to the similarity in the services listed in the Respondent's Mark and the services marketed or sold by Petitioner under Petitioner's Mark);

Again, in view of the recent assignment of Respondent's registration, these Requests, particularly Requests for Production Nos. 63, 73, 74, 75, 80, and 82 would certainly apply to its communications regarding the sale and license of the COMFORTCLUB mark, and any information Respondent relatedly

received from its assignee, McAfee Heating & Air – yet, in contravention of its obligations to dutifully respond to these requests, Respondent has produced no such information with Petitioner.

D. Requests related to Respondent’s allegations and assertions

Respondent, in its Answer, Initial Disclosures, and Responses to Petitioner’s Discovery Requests, makes numerous allegations and assertions. Petitioner is entitled to discover the facts that form the basis of Respondent’s assertions as well as any documents relied upon or supporting those assertions.

However, Respondent has failed to properly respond to the following requests:

- **Interrogatory No. 19** (state all facts on which Respondent relies in support of its allegation that “no other person...has the right to use [Respondent’s] mark in commerce...”);
- **Interrogatory No. 20** (state all facts on which Respondent relies in support of its allegation that it was the rightful “owner of the trademark/service mark sought to be registered);
- **Interrogatory No. 23** (describe all facts upon which Respondent bases its Affirmative Defenses);
- **Request for Production No. 1** (all documents identified in response to Interrogatories);
- **Request for Production No. 2** (all documents relied upon in preparing answers to Interrogatories);
- **Request for Production No. 31** (all documents and things identified in Respondent’s Initial Disclosures);
- **Request for Production No. 32** (all documents which were reviewed or relied upon in preparing Respondent’s Initial Disclosures);
- **Request for Production No. 37** (all documents upon which Respondent bases its denial of Petitioner’s allegation in paragraph 8 of Petitioner’s Petition to Cancel);
- **Request for Production No. 38** (all documents upon which Respondent bases its denial of Petitioner’s allegation in paragraph 22 of Petitioner’s Petition to Cancel);
- **Request for Production No. 39** (all documents upon which Respondent bases its denial of Petitioner’s allegation in paragraph 23 of Petitioner’s Petition to Cancel that “Petitioner has priority based upon its prior use...”);
- **Request for Production No. 40** (all documents upon which Respondent bases its denial of Petitioner’s allegation in paragraph 23 of Petitioner’s Petition to Cancel that Respondent’s COMFORTCLUB mark is virtually identical to Petitioner’s COMFORTCLUB mark);

- **Request for Production No. 41** (all documents upon which Respondent bases its denial of Petitioner's allegation in paragraph 36 and 37 of Petitioner's Petition to Cancel);
- **Request for Production No. 42** (all documents upon which Respondent bases its other denials and admissions in Respondent's Answer to the Petition to Cancel);
- **Request for Production No. 43** (all documents upon which Respondent bases its First Affirmative Defense);
- **Request for Production No. 44** (all documents upon which Respondent bases its Second Affirmative Defense);
- **Request for Production No. 45** (all documents upon which Respondent bases its Third Affirmative Defense);
- **Request for Production No. 46** (all documents upon which Respondent bases its Fourth Affirmative Defense);
- **Request for Production No. 47** (all documents upon which Respondent bases its Fifth Affirmative Defense);
- **Request for Production No. 48** (all documents upon which Respondent bases its Sixth Affirmative Defense);
- **Request for Production No. 49** (all documents upon which Respondent bases its Seventh Affirmative Defense);
- **Request for Production No. 50** (all documents upon which Respondent bases its Eighth Affirmative Defense);
- **Request for Production No. 51** (all documents upon which Respondent bases its Ninth Affirmative Defense);
- **Request for Production No. 52** (all documents upon which Respondent bases its Tenth Affirmative Defense);
- **Request for Production No. 53** (all documents upon which Respondent bases its Eleventh Affirmative Defense);
- **Request for Production No. 54** (all documents identified in Respondent's Answer);
- **Request for Production No. 76** (all documents relied upon by Respondent to support the allegation that "no other person, firm, corporation or association has the right to use [Respondent's] mark in commerce");
- **Request for Production No. 84** (all documents Respondent intends to introduce into evidence in this proceeding);

- **Request for Production No. 85** (all documents upon which Respondent intends to rely on during the testimony period);
- **Request for Production No. 86** (documents related to each fact witness who Respondent intends to call);
- **Request for Production No. 87** (documents supporting cancellation of Respondent's Mark because Respondent perpetrated fraud on the USPTO);
- **Request for Production No. 88** (documents supporting Respondent's position that it did not perpetrate fraud on the USPTO);
- **Request for Production No. 89** (documents relating to each expert witness Respondent has engaged);
- **Request for Production No. 90** (any report prepared by any expert witness).

Again, since these proceedings are targeted at the COMFORTCLUB registration itself, Respondent is not only obligated to provide its historical information, but any additional information gained from McAfee Heating & Air, if any, that it intends to rely upon for its assertions and alleged defenses.

E. Requests related to Respondent's continued use of Respondent's Mark

In order to maintain ownership of Respondent's Mark, Respondent use of the mark in commerce must have been continuous. Requests related to the nature, extent, and geographic scope of the use of the COMFORTCLUB mark is therefore relevant and discoverable. Respondent should therefore be compelled to sufficiently respond to the following requests:

- **Request for Production No. 4** (all documents and things relating to communications issued or received by Respondent relating to Respondent's Mark);
- **Request for Production No. 8** (representative examples showing each and every variation in the form of Respondent's Mark which Respondent has used, uses or plans to use);
- **Request for Production No. 15** (documents relating to Respondent's past, present and future marketing plans and methods for products and services identified by Respondent's Mark);
- **Request for Production No. 17** (documents and things relating to communications between Respondent and third parties concerning the advertisement of Respondent's Mark);

- **Request for Production No. 26** (documents and things relating to Respondent's communications with third parties regarding this proceeding);
- **Request for Production No. 34** (documents showing the use of the term COMFORTCLUB in commerce by Respondent in connection with the sale of any product or service);
- **Request for Production No. 55** (documents referring or relating to Respondent's use of any term comprised of or containing "COMFORT" and/or "CLUB");
- **Request for Production No. 57** (representative examples of advertising and promotional materials featuring, displaying, or containing Respondent's Mark);
- **Request for Production No. 61** (all press releases, articles, and clippings relating to or commenting upon Respondent's Mark or Respondent's services);
- **Request for Production No. 62** (documents sufficient to show all forms in which Respondent has depicted, displayed, or used Respondent's Mark, including but not limited to all designs, stylizations, and/or logos).

F. Requests related to any assignment of Respondent's Mark;

Respondent's recently filed Motion to Join Assignee and Motion to Reopen Discovery and Extend the Trial Setting alleges that Barnaby assigned its Registration No. 3,618,331 on September 30, 2014 to McAfee. However, Respondent has yet to produce any executed documents related to this assignment or any other attempted assignments of Respondent's Mark or communications related thereto. Therefore, especially in light of the recent change in facts, Respondent should be compelled to sufficiently respond to the following requests:

- **Request for Production No. 27** (documents relating to any communications between Respondent and Petitioner concerning Respondent's Mark);
- **Request for Production No. 28** (documents relating to any communications between Respondent and any other party who has used or owns any names or marks which are comprised of or include the words COMFORT or CLUB);
- **Request for Production No. 71** (documents referring or relating to agreements Respondent has entered into relating to Respondent's Mark);
- **Request for Production No. 72** (documents sufficient to identify all uses of Respondent's Mark by Respondent or Respondent's licensees).

IV. RESPONSE TO RESPONDENT'S OBJECTIONS

A. Petitioner's Discovery Requests were timely served.

In response to all 151 of Petitioner's Discovery Requests, Respondent provides some variation on a blanket objection that Petitioner's Discovery Requests were not timely served within the discovery period. Sometimes Respondent merely alleges that it did not receive Petitioner's Discovery Requests until "nearly 30 days following the close of discovery in this case." *See, e.g., Exhibit K*, p.3. Other times, Respondent indicates that it would only be willing to comply if the parties "enter into a reciprocal extension of the discovery deadline in this case...." *Id.* at p. 32.

The Board's guidelines regarding when discovery can be served are straight-forward and simple. Interrogatories and Requests for Production may be served on an opposition party up through the closing date of discovery, and a responding party may not object to such requests on the basis that responses would be due after the close of the discovery period. TBMP §4.03.03; *see also* 37 C.F.R. § 2.120(a)(3). When service of discovery requests is made via first-class mail, the date of mailing is considered the date of service. TBMP §403.03. The Board ordinarily accepts, as prima facie proof of the date of mailing, the statement signed by the party or by its attorney as to the date and manner of service. T.B.M.P. §113.04. In this case, the discovery period ran through June 4, 2014. Petitioner's Discovery Requests were served via first-class mail on June 4. **Exhibit A**, p. 11, **Exhibit B**, p. 18, **Exhibit C**, p. 10. Therefore, Petitioner's Discovery Requests were served within the discovery period, and Respondent is obligated to respond.

Respondent's objections – and subsequent correspondence – also emphasizes that the late receipt of Petitioner's Discovery Requests was not the fault of Petitioner's. While Respondent's story regarding its receipt of Petitioner's Discovery Requests has been inconsistent – Respondent first stated that it received the requests on June 30, 2014, and that the late receipt was not the fault of either party, **Exhibit E**, p. 1, then stated in its Objections and Responses that it received the requests on July 2 and made no assertion that Petitioner was not at fault, **Exhibit F**, p.3 – Petitioner acknowledges that Respondent is likely not to blame for the late receipt. That is why Petitioner granted Respondent additional time to respond to the requests and has made subsequent good faith efforts to conference with Respondent on its objections. However, Respondent's above-described objections and its continued insistence on a

“reciprocal” re-opening of discovery (despite never seeking discovery during the actual discovery period or responding to the discovery served upon it) conveys a lack of intention to cooperate and conduct discovery in good faith. Because Petitioner’s Discovery Requests were timely served, the Board should order Respondent to Properly Respond to them.

B. Any concerns regarding confidentiality are cured by the Board’s standard protective order.

Respondent objects to many of Petitioner’s Discovery Requests because it would require the production of confidential information. Respondent’s objection is insufficient under the Rules of Procedure. For all inter partes proceedings commenced on or after August 31, 2007, the Board’s standard protective order is in place to allow parties to fully respond to proper and relevant discovery requests. T.B.M.P. §412.01. To the extent Respondent must disclose what it believes to be confidential information in order to respond to Petitioner’s requests, it may designate such information as confidential under the standard protective order. If Respondent is refusing to produce any documents due to their confidentiality, the Board should compel the documents to be produced under the standard protective order.

C. Petitioner’s Discovery Requests are Neither Over Broad or Unduly Burdensome.

Respondent asserts an objection that many of Petitioner’s Discovery Requests are over broad and unduly burdensome. Respondent’s objection – especially when it is broadly asserted – is absurd on its face. For example, Request for Production 58 requests “representative samples” of all websites, advertisements, and online promotional materials that have ever been used by Respondent. The request for “samples” immediately narrows the scope of the request. Petitioner cannot argue that a request is unduly burdensome when the request specifically does not seek all existing documents.

Petitioner narrowly tailored its Discovery so that they reasonably will lead to the discovery of admissible evidence. Requests seeking any expenses relating to advertisement of Respondent’s Mark (RFP No. 19), any documents relating to potential confusion arising from use of Respondent’s Mark (RFP No. 22), or documents supporting Respondent’s alleged priority and ownership of COMFORTCLUB

(Interrogatory No. 4), are on their face not over broad. Therefore, Respondent's objection should be overruled.

D. Respondent's Objection that Petitioner had "ample opportunity to discover" is nonsensical

Respondent repeatedly asserts that it should not have to respond to Petitioner's Discovery Requests because "the requesting party has had ample opportunity to discover on its own." In support of its objection, Respondent cites an Eleventh Circuit case regarding a civil RICO claim. The Eleventh Circuit case, in addition to having no binding authority over the Board, is completely distinguishable. In that case, the Eleventh Circuit found that a district court properly rejected a request for further discovery because a significant amount of discovery has been obtained and "further discovery would not be helpful in resolving the issues." 932 F.2d 1572, 1580 (11th Cir. 1991). In this case, Respondent has produced *less than 300 pages* of discovery in response to Petitioner's timely served discovery requests – despite the fact that Petitioner's Discovery Requests were served more than four months ago. Petitioner has repeatedly given Respondent the benefit of the doubt that it would fully comply with the Discovery Requests (hence why Petitioner only now seeks an order compelling production), but Respondent's repeated attempts to block production unless discovery is re-opened has worn away Petitioner's patience. Respondent cannot argue that ample time for discovery has passed when it has obstructed Petitioner's attempts to get said discovery for months. Therefore, Respondent's objection should be overruled.

E. Petitioner's requests do not call for speculation.

Respondent refuses to properly respond to many of Petitioner's requests because they allegedly call for speculation. However, as seen by the categories above, all of Petitioner's Discovery Requests simply ask for Respondent to produce records related to its use of Respondent's Mark, how it created the mark, whether it has assigned the mark, and the basis of Respondent's *actual* allegations in this case. None of these topics should require any speculation on Respondent's part. The requests that come closest to a call for speculation are ones that request Respondent's "future plans" for Respondent's mark.

However, if Respondent actually has future plans for the mark, those plans should not be “speculative” and can be disclosed.

Admittedly, it appears that Respondent is confusing “speculative” with “lack of knowledge.” Petitioner’s requests do not demand that Respondent testify as to facts or matters that it has no knowledge of. They simply ask for Respondent to provide documents or testimony that it is presently aware of. To that extent, Respondent’s objection should be overruled.

F. Petitioner’s objections to “vagueness” are meritless

Respondent objects to Interrogatories Nos. 19-21 because they are allegedly vague, ambiguous, and confusing. Respondent’s objection is nonsensical. Interrogatories Nos. 19 and 20 both request Respondent to state all facts on which Respondent relied upon when it executed its application for U.S. Registration No. 3,618,331. The request could not be any clearer. Similarly, Interrogatory No. 21 asks for all interactions Respondent had with Petitioner or Petitioner’s legal representatives prior to the filing of said application. Again, there is nothing vague about this request. Respondent should be compelled to properly respond to these interrogatories.

G. Respondent’s refusal to provide a narrative answer requires production of documents.

Respondent fails to provide an answer to a couple of interrogatories (Nos. 4 and 23) because the interrogatory asks for information that “is available from its business and electronically stored records.” However, Respondent has failed to produce documents that are sufficiently responsive to either interrogatory. The Board should therefore order Respondent to provide the narrative answer it so wishes to avoid or to produce the business and electronically stored records it has identified.

H. Petitioner’s requests are relevant.

Respondent frequently objects to Petitioner’s Discovery Requests as irrelevant. However, as detailed in Section III above, all of Petitioner’s requests are likely to lead to the discovery of admissible evidence. Therefore, Respondent’s objections should be overruled.

V. CONCLUSION

WHEREFORE, Petitioner respectfully requests that the Board:

- a. GRANT Petitioner's Motion to Compel Discovery Responses;
- b. Enter an Order requiring Petitioner to amend its responses to the Interrogatories listed above and to produce documents responsive to the Request for Production listed above; and
- c. award Petitioner all such other and further relief as the Board deems just and appropriate.

Respectfully submitted,

CLOCKWORK IP, LLC

Date: November 6, 2014



Purvi J. Patel, *Attorney for Petitioner*
Haynes and Boone, LLP
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Phone: 214-651-5917
Facsimile: 214-200-0812
patelp@haynesboone.com

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

Clockwork IP, LLC

Petitioner,

v.

Barnaby Heating & Air

Respondent.

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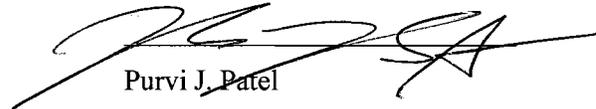
Mark: COMFORT CLUB

Cancellation No. 92057941
In re Registration No. 3618331

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this 6th day of November, 2014, a copy of the foregoing *Petitioner's Objection and Brief in Opposition to Respondent's Motion to Join Assignee and Reopen Discovery* was served via email to the following party at jcelum@celumlaw.com:

Julie Celum Garrigue, Esq.
Celum Law Firm, PLLC


Purvi J. Patel

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

Clockwork IP, LLC	§	Mark: COMFORT CLUB
	§	
<i>Petitioner,</i>	§	
	§	
v.	§	Cancellation No. 92057941
	§	In re Registration No. 3618331
Barnaby Heating & Air	§	
	§	
	§	
<i>Respondent.</i>	§	

**DECLARATION OF PURVI J. PATEL IN SUPPORT OF
PETITIONER'S MOTION TO COMPEL DISCOVERY RESPONSES**

I, Purvi Patel, declare as follows:

1. I am an attorney, duly licensed to practice law in the courts of Texas. I have been practicing law since 1998. I have personal knowledge of the facts stated herein and, if called to do so, would testify to them under oath.
2. Attached as **Exhibit A** is a true and correct copy of Petitioner's First Set of Interrogatories, served on Respondent in this case on June 4, 2014.
3. Attached as **Exhibit B** is a true and correct copy of Petitioner's First Set of Requests for the Production of Documents and Things, served on Respondent in this case on June 4, 2014.
4. Attached as **Exhibit C** is a true and correct copy of Petitioner's First Set of Requests for Admissions, served on Respondent in this case on June 4, 2014.
5. At no point did Respondent serve any discovery requests on Petitioner.
6. Attached as **Exhibit D** is a true and correct representative sample of documentation supplied by Petitioner to Respondent in July 2014.
7. Attached as **Exhibit E** is a true and correct copy of correspondence between counsel for Respondent and me dated June 30 through July 7, 2014. At no point did Petitioner agree to reopen discovery at this time. In addition, Respondent's correspondence makes no assertion that Petitioner's discovery requests were untimely served.

8. Attached as **Exhibit F** are true and correct excerpts from Respondent's Objections and Responses to Petitioner's First Set of Interrogatories, served on Petitioner in this case on July 15, 2014. Respondent produced no documents in conjunction with these Objections and Responses.

9. Attached as **Exhibit G** is a true and correct copy of correspondence between counsel for Respondent and me from July 16 through July 17, 2014. The eventual result of this correspondence was an agreement to request from the Board a 60-day extension on all future deadlines. Petitioner agreed to such an extension in part due to Respondent's assertion that it would supplement its discovery responses and produce documents responsive to those requests. However, no supplement to Respondent's discovery responses arrived in either July or August.

10. Attached as **Exhibit H** is a true and correct copy of correspondence from me to counsel for Respondent dated September 9, 2014.

11. Attached as **Exhibit I** is a true and correct copy of a letter from me to counsel for Respondent dated September 10, 2014 and subsequent email correspondence dated September 11 and 12, 2014. I followed up the September 10 correspondence with a phone call to Respondent's counsel. Respondent's counsel indicated that she would be reviewing my correspondence but there were alleged "new facts" that would soon impact the case. We then agreed to a discovery conference to take place on September 12.

12. Attached as **Exhibit J** is a true and correct copy of correspondence between me and counsel for Respondent dated September 12 through September 17, 2014.

13. Attached as **Exhibit K** is a true and correct copy of Respondent's First Amended Responses to Petitioner's First Interrogatories, Request for Production and Request for Admission. Respondent produced 237 pages of documents in conjunction with these amended responses.

14. Attached as **Exhibit L** are true and correct excerpts from Respondent's document production, including an unsigned assignment of Respondent's mark to McAfee Heating & Air Conditioning, Inc. and an unsigned license back to Barnaby. No supplementation including any executed versions of these agreements has ever been produced.

I declare under penalty of perjury that the foregoing is true and correct.

Executed on November 6, 2014.


Purvi Patel

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

Clockwork IP, LLC

Petitioner,

v.

Barnaby Heating & Air

Respondent.

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Mark: COMFORT CLUB

Cancellation No. 92057941
In re Registration No. 3618331

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this 6th day of November, 2014, a copy of the foregoing *Declaration of Purvi Patel in Support of Petitioner's Motion to Compel Discovery Responses* via email to the following party at jcelum@celumlaw.com:

Julie Celum Garrigue, Esq.
Celum Law Firm, PLLC


Purvi Patel

EXHIBIT I

haynesboone

September 10, 2014

Via Email to jcelum@celumlaw.com

Julie Celum Garrigue, Esq.
Celum Law Firm, PLLC
11700 Preston Road
Suite 660, PBM 560
Dallas, Texas 75230

Re: *Clockwork IP, LLC v. Barnaby Heating & Air, LLC*
Cancellation No. 92057941 (Our Ref.: 46889.81)

Dear Julie:

Further to my email earlier this week requesting a telephone conference, this represents our good faith effort to resolve Respondent Barnaby Heating & Air, LLC's deficient responses provided to Petitioner's First Set of Interrogatories, Petitioner's First Set of Requests for Production of Documents, and Petitioner's First Requests for Admission. Please provide times for a telephone conference on **Friday, September 12, 2014**, to discuss how we can resolve these deficiencies. Moreover, in a further showing of good faith, and since we have yet to receive any responsive documents, we suggest an additional 30 day extension of deadlines in the above referenced cancellation proceeding. Absent further discussions and the extension of deadlines, we will have no choice but to consider a Motion to Compel and/or Sanctions – or escalation to federal litigation.

As set forth below, the responses suffer from numerous deficiencies and, in almost all instances, fail to set forth basic information called for by Clockwork IP, LLC and required by the Federal Rules of Civil Procedure, the Code of Federal Regulations, and the Trademark Trial and Appeal Board Manual of Procedure. Clockwork submitted 27 Interrogatory Requests to Barnaby, and in response, we received over 110 objections from you with very few substantive responses. For the 90 Requests for Production Clockwork submitted to Barnaby, we received 270 objections and not a single responsive document. Barnaby cannot wholesale ignore its discovery obligations.

Respondent has asserted several improper and meritless objections to the requests for discovery. One of the most inappropriate objections that you lodged for each and every one of Petitioner's requests was that Respondent allegedly has no obligation to respond to Petitioner's requests for discovery because they were served outside of the discovery period. While this objection

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Julie Celum Garrigue, Esq.

September 10, 2014

Page 2

occasionally takes a slightly different form in wording, the substance remains the same – in any form, it is completely without merit. Petitioner mailed its requests for discovery to Respondent on June 4, 2014, via First-Class Mail. When service is made via First-Class Mail, the date of mailing is considered the date of service. 37 C.F.R. § 2.119(c). Petitioner's requests were therefore timely served on Respondent during the discovery period, namely on June 4, 2014. Interrogatories, Requests for Production, and Requests for Admission may be served on an opposing party up through the closing date of discovery, and a responding party may not object to such requests on the basis that responses would be due after the close of the discovery period. TBMP § 403.03; *see also* 37 C.F.R. § 2.120(a)(3).

Respondent contends that it did not receive Petitioner's discovery requests until July 2, 2014. In a show of good faith and in an effort to obtain evidence so that the Board may decide this proceeding on its merits, Petitioner agreed to allow Respondent an extension of time until July 15, 2014, respond to Petitioner's discovery requests. Respondent accepted Petitioner's offer of extension, only to reply with the above-described objection applied to each and every one of Petitioner's discovery requests. Such action conveys a lack of intention to cooperate and conduct discovery in good faith.

In addition to its untenable objection regarding timeliness, Respondent's answers to Petitioner's discovery requests are inadequate for a host of additional reasons. To be clear, Respondent failed to produce (or make available) a single document or thing to Clockwork. Respondent has raised other meritless objections and has failed to answer any request for discovery in a way that indicates a good faith attempt to comply with the rules governing this proceeding.

As you are well aware, the grounds for cancellation concern ownership of the COMFORTCLUB mark, likelihood of confusion, the seniority/priority of Clockwork's rights in the COMFORTCLUB, and relatedly, Barnaby's procurement of Registration No. 3,618,331 based on fraudulent statements made to the U.S. Trademark Office. In the interest of efficiency for both parties, Clockwork submitted very targeted discovery requests seeking specific information related to these particular issues raised in the cancellation – and yet, we received inapplicable objections from Barnaby claiming “undue burden,” “irrelevant,” speculative, and for information only Barnaby would know, “opportunity to discovery on your own.” The strangest of them all was your objection that numerous Interrogatories were “premature until additional discovery is conducted,” – to be clear, the discovery period was already closed when you submitted your objections, so this position was and is nonsensical.

Having said all this, in an effort to resolve this issue, we have illustrated some of the deficient answers below. Also, for talking points, we have also enclosed a chart that outlines our

Julie Celum Garrigue, Esq.
September 10, 2014
Page 3

discovery request as well as your main meritless objections thereto. We are hopeful that by bringing these issues to light and allowing Registrant an opportunity to respond properly, we can conduct discovery appropriately with respect to Petitioner's request as a whole.

Interrogatories

Respondent's Answers and Objections to Petitioner's First Set of Interrogatories suffer from a myriad of deficiencies. Interrogatories must be answered by the party to whom they are directed. Fed. R. Civ. P. 33(b)(1); TBMP § 405.04(c). To the extent that it is not objected to, each interrogatory must be answered "separately and fully in writing under oath." Fed. R. Civ. P. 33(b)(3). Where Respondent has in fact provided an answer, it has not endeavored to answer in a manner that is responsive to the question asked – rather, it seems to be a boilerplate and generally irrelevant statement regarding Respondent's stated date of first use. Respondent appears to have provided such an unresponsive answer just so it can allege that it "responded" to at least a small percentage of the discovery requests submitted by Clockwork.

Beyond these general insufficiencies, each response provided is inadequate for other reasons, including the assertion of meritless objections. In an effort to resolve this inadequacy, we have detailed some of the issues below and can discuss all of the concerns based on the enclosed grid during our conference. To be clear, the following examples are illustrative in nature and are not meant to be considered a comprehensive explanation of the deficiencies of Respondent's discovery responses.

Response to Interrogatory No. 9:

This interrogatory asked the Respondent to "[d]escribe and identify all documents and things relating to and showing Respondent's use of Respondent's Mark in commerce before and after Mr. Charles Barnaby's execution of the Success Academy 'Acknowledgement of Non-Solicitation Policy' dated March 17, 2008." Respondent provided, subject to its objections, the following non-responsive answer: "Respondent has used the COMFORTCLUB mark continuously and consistently since, at least as early as January 22, 2008."

Respondent's answer is not only inadequate; it fails to relate to the question asked. Petitioner requested that Respondent *describe* and *identify* all *documents and things* relating to and showing Respondent's use of its mark in commerce at specified points in time. Respondent's answer is merely an assertion that Respondent has used its mark, something that is not in dispute and about which Petitioner has not inquired in this interrogatory. Since this request is specifically directed to the issues of priority, first use, ownership, and fraud on the Trademark Office, it is quite relevant and we would expect Respondent to provide an answer to this interrogatory that is responsive to the question asked.

Respondent has also raised several objections to this Interrogatory, none of which has merit. As explained above, the objection as to the timeliness of the Interrogatories and Respondent's duty to answer them is baseless.

The objection on the ground that "this request asks for information that the requesting party has had ample opportunity to discover on its own" is also flawed and seemingly stems from a misunderstanding of the Fed. R. Civ. P. 26(b)(2)(C)(ii), which Respondent cites in support of its objection. The actual text of that rule instructs a court to limit the frequency or extent of discovery where "the party seeking discovery has had ample opportunity to obtain the information *by discovery in the action.*" Clockwork's request for this information was via its first and only discovery requests in the action. As explained previously, the applicable rules provide that discovery requests may be served through the end of the discovery period. Petitioner's request was therefore within its "opportunity for discovery" period, and Respondent's objection is moot.

Respondent further objected on the ground that the interrogatory calls for speculation with respect to the document described in the interrogatory. This document, however, was described with detail and specificity, eliminating any possibility that Respondent would need to speculate as to the nature or identity of the document. Petitioner requests that Respondent provide a response to this and all other interrogatories that is complete and responsive.

Response to Interrogatory No. 25:

This interrogatory sought an identification of the persons having knowledge of allegations and facts asserted in Respondent's interrogatory responses, as well as the substance of those persons' knowledge. In answer, Respondent raised several objections and then "refer[red] Petitioner to Respondent's Rule 26(a)(1) disclosures for a list of those individuals Respondent believes have the most knowledge about the facts of this case." This improper answer is not responsive to the question asked. Petitioner did not inquire as to the persons who have knowledge about the case, but rather into those persons who provided the information contained in Respondent's interrogatory responses. This is especially relevant to Petitioner as there is no indication in Respondent's responses that anyone besides Respondent's counsel even saw the discovery requests.

As to the objections raised by Respondent, none is well-taken as all are without merit. As explained above, the objection as to the timeliness of the interrogatories and Respondent's duty to answer them is baseless. Respondent further objected on the ground that this interrogatory asks for opinions and contentions, but an interrogatory is not objectionable merely because it

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calls for an opinion. Fed. R. Civ. P. 33(a)(2); TBMP § 405.02. Respondent's additional objection that the interrogatory is premature until additional discovery is conducted is completely baseless, as the discovery period is now closed.

Respondent's decision to "decline[] to provide a narrative answer . . . because the interrogatory asks for information that is available from its business and electronically stored records" is improper in the context of a proceeding before the Trademark Trial and Appeal Board. We would remind you that, while the Federal Rules of Civil Procedure do apply to these proceedings, they are also modified by the Trademark Trial and Appeal Board Manual of Procedure. Where the answer to an interrogatory may be derived from the business records of the responding party, and the burden of deriving such information is substantially the same for either party, the responding party may answer "by specifying the records from which the information may be derived or ascertained, and affording the propounding party reasonable opportunity to examine, audit, or inspect the records and to make copies, compilations, abstracts or summaries." TBMP § 405.04(b). In this case, the burden to Respondent of identifying the persons who have knowledge of the facts alleged in its interrogatory responses is far less than the burden to Petitioner of deriving this information from Respondent's business records, so the objection is not proper. Even assuming otherwise, however, Respondent still has not sufficiently complied with the rule as Respondent has failed to specify the records in sufficient detail to "permit the propounding party to locate and identify, as readily as can the responding party, the records from which the answer may be ascertained." TBMP § 405.04(b). In fact, Respondent has made no relevant records available to Petitioner at this time.

Respondent's objection that this request is "over broad and unduly burdensome" is absurd on its face. Petitioner has asked for a list of the persons having knowledge of the facts alleged in its interrogatory responses, and the substance of those persons' knowledge. It is beyond the bounds of reason to assert that making such a list and providing such information is "over broad" or "unduly burdensome," as it simply requires a clerical action be performed alongside the information gathering that is a necessary prerequisite to providing responses to discovery requests.

Similarly, the objection that such a request "calls for speculation by Respondent as to each and every individual who may have knowledge about Respondent's prior use of the COMFORTCLUB mark" is without merit. First, such an objection is not relevant to the question as Petitioner has not asked for persons with knowledge about use, but persons with knowledge of facts alleged in interrogatory responses. Second, it requires no speculation to provide the name and information regarding the knowledge of a person who provided information contained in a

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discovery request. Petitioner requests that Respondent provide a response to this and all other interrogatories that is complete and responsive.

Requests for Production

Respondent's Answers and Objections to Petitioner's First Set of Requests for Production of Documents are likewise deficient. An answer must be provided for each item, stating that inspection and related activities will be permitted as requested or stating an objection. Fed. R. Civ. P. 34(b)(2)(A); TBMP § 406.04. Alternatively, a responding party may simply produce the documents.

All 90 of Petitioner's Requests for Production have been objected to and "answered" in exactly the same way, all of which are inadequate. The most outrageous objection set forth by Respondent is as follows: "If the parties can agree to a reciprocal extension of the discovery deadlines in this case, Respondent will provide assistance to Petitioner in retrieving electronically stored records." This clearly demonstrates Respondent's lack of intention to make a good faith effort to respond to Petitioner's discovery requests – despite being obligated to do so. Barnaby failed to serve discovery requests on Clockwork during the discovery period and its misstep has no bearing on Barnaby's obligation to timely and comprehensively respond to discovery requests timely served upon Respondent.

Response to Request for Production No. 6

This was a request for documents concerning the first use and use in commerce of Respondent's mark by or on behalf of Respondent. In answer, Respondent raised several objections and then, subject to those objections, stated that "Respondent will rely on any and all documents that tend to support its defenses in this case, including, but not limited to, its business records, those documents that Petitioner and Respondent will include on their exhibit lists, any and all documents identified by Petitioner and Respondent in their Rule 26(A)(1) Disclosures and in Petitioner's most recent June 4, 2014 Supplemental Disclosures, any and all documents on file with the U.S. Patent & Trademark Office, and the Trademark Trial and Appeal Board."

This answer is inadequate. Respondent may not make a blanket statement as to the documents on which it intends to rely, some of which—like "exhibit lists"—may not exist in a proceeding before the Trademark Trial and Appeal Board. Moreover, Respondent has not even indicated that it will make these insufficiently described documents available to Petitioner, let alone that it will produce the documents by copying and forwarding them to us, which is the Board's preferred method of production. TBMP § 406.04(b); Fed. R. Civ. P. 34(b)(2)(E).

As to the objections raised by Respondent, none is well-taken as all are without merit. As explained above, the objection as to the timeliness of the requests and Respondent's duty to answer them is baseless.

Respondent's objection that this request is "over broad and unduly burdensome" is absurd on its face. Petitioner has asked for documents that relate to Respondent's first use of its mark. These are documents which Respondent itself will require in order submit evidence relating to priority, one of the issues in dispute in this action.

Respondent's objection that this request is "not narrowly tailored to a specific fact or issue in this matter" is likewise beyond the bounds of a reasonable objection. This request is narrowly tailored to the specific issue of priority. Petitioner requests that Respondent provide a response to this and all other requests that is complete and responsive.

Requests for Admission

In responding to a Request for Admission, a party must specifically deny the request or state in detail why he cannot truthfully admit or deny it. Fed. R. Civ. P. 36(a)(4). A denial must fairly respond to the substance of the matter. Fed. R. Civ. P. 36(a)(4); TBMP § 407.03(b). We note that all 35 of Petitioner's Requests for Admission have been objected to in the same manner and have all been denied, with the exception of Request for Admission No. 16, which Respondent was "unable to admit or deny." Such boilerplate objections and denials, some of which suggest that objections and answers were lodged without even reading the request, undermine the "fair response" and "good faith" contemplated by the applicable rules. In light of this, the accuracy and veracity certain denials are certainly in question – making Respondent's responses to the other discovery requests even more important.

As indicated, Petitioner wishes to resolve these outstanding discovery issues quickly and without further Board intervention. "The Board expects parties (and their attorneys or other authorized representatives) to cooperate with one another in the discovery process, and looks with extreme disfavor on those who do not." TBMP § 408.01. It is our hope that, by explaining the deficiencies of Respondent's discovery answers, Respondent will now provide answers that are complete, responsive, and made in good faith. However, if Respondent does not respond to our request for conference this week, Petitioner will seek TTAB intervention and/or escalation to federal litigation.

haynesboone

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September 10, 2014
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I look forward to hearing from you at your earliest convenience.

Sincerely,

/Purvi Patel Albers/

Purvi Patel Albers
Telephone: 214-651-5917
Facsimile: 214-200-0853
purvi.patel@haynesboone.com

Enclosures

D-2303047_1

EXHIBIT 10

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

Clockwork IP, LLC

Petitioner,

v.

Barnaby Heating & Air

Respondent.

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Mark: COMFORT CLUB

Cancellation No. 92057941

In re Registration No. 3618331

PETITIONER'S FIRST SET OF REQUESTS FOR ADMISSIONS TO RESPONDENT

Pursuant to Rule 36 of the Federal Rules of Civil Procedure and Rules 2.116 and 2.120 of the Trademark Rules of Practice, Petitioner Clockwork IP, LLC requests that Respondent Barnaby Heating & Air serve sworn answers to Petitioner's First Set of Requests for Admissions at the offices of Petitioner's counsel, Purvi J. Patel, Haynes and Boone, L.L.P., 2323 Victory Avenue, Suite 700, Dallas, Texas 75219, within thirty-five (35) days after service.

DEFINITIONS

The following definitions apply to, and are deemed to be incorporated into, each of the Requests for Admissions herein.

A. "SGI" refers to Success Group International, an entity that was related to Petitioner but was recently sold. SGI includes a family of organizations including AirTime 500, Plumbers' Success International, Electricians' Success International, and Roofers' Success International.

B. "AirTime 500" or "AirTime" refers to an SGI entity that is dedicated to helping independent HVAC contractors succeed by providing a comprehensive set of operational and knowledge tools, including pricing systems, rebates, incentive systems, and training and networking opportunities.

C. "Success Day" and "Success Academy" refers to a periodic events, training seminars, and workshops for AirTime 500 Contractors. CONGRESS franchise events, SGI EXPO events, BRAND

K. The connectives “and” and “or” shall be construed either disjunctively or conjunctively as necessary to bring within the scope of the discovery request all responses that might otherwise be construed to be outside its scope.

L. The use of the singular form of any word shall include within its meaning the plural form of the word, and vice versa.

M. The use of the masculine form of a pronoun shall include also within its meaning the feminine form of the pronoun so used, and vice versa.

N. The use of any tense of any verb shall include also within its meaning all other tenses of the verb so used.

INSTRUCTIONS

Applicant is hereby advised that a failure to specifically deny any request will be taken as an admission of the truth requested.

REQUESTS FOR ADMISSIONS

REQUEST FOR ADMISSION NO. 1:

Respondent has no valid rights in the mark COMFORTCLUB or any variation thereof. At no time was Respondent the owner of COMFORTCLUB.

REQUEST FOR ADMISSION NO. 2:

Petitioner is the rightful owner of the COMFORTCLUB Mark as used for Petitioner’s services and Respondent’s services in the U.S.

REQUEST FOR ADMISSION NO. 3:

At no time was Respondent the owner of COMFORTCLUB.

REQUEST FOR ADMISSION NO. 4:

Petitioner’s Mark has been in use in interstate commerce by Petitioner and/or licensees of Petitioner since at least as early as 2006.

REQUEST FOR ADMISSION NO. 5:

Respondent has been an AirTime 500 member and licensee of Petitioner since August 21, 2007. In

signing the AirTime Member Agreement, Respondent agreed that “AirTime wholly owns and/or has protectable legal rights in and to the AirTime Resources whether ... (b) the AirTime Resources are subject to copyright, trademark, tradename, and/or patent rights of AirTime ...” In the Member Agreement, Respondent agreed “[n]ot to use any or all of the AirTime Resources for any purpose other than your valid participation in the AirTime Program... [and N]othing in this Agreement shall be construed as conveying to you ... (ii) any license to use, sell, exploit, copy or further develop any such AirTime Resources.” Petitioner’s Mark falls under the umbrella of the term “AirTime Resources” as described in said Member Agreement.

REQUEST FOR ADMISSION NO. 6:

Respondent attended an SGI “Senior Tech” course in March, 2008. Petitioner’s COMFORTCLUB Mark and Petitioner’s services were discussed and promoted to Airtime members and licensees at the SGI “Senior Tech” course in March, 2008.

REQUEST FOR ADMISSION NO. 7:

Respondent, without the authorization of Petitioner, filed Application No. 77/420,784 for COMFORTCLUB after attending an SGI course covering Petitioner’s services rendered under Petitioner’s Mark.

REQUEST FOR ADMISSION NO. 8:

At all relevant times, Respondent’s use of COMFORTCLUB was only as a licensee of Petitioner pursuant to Respondent’s AirTime Member Agreement. Respondent was never an owner of the COMFORTCLUB mark.

REQUEST FOR ADMISSION NO. 9:

Respondent’s Application No. 77/420,784 for Respondent’s Mark was filed fraudulently. Respondent’s Mark is thus void.

REQUEST FOR ADMISSION NO. 10:

Petitioner used the mark COMFORTCLUB in U.S. commerce before any use of the mark COMFORTCLUB in U.S. commerce by Respondent commenced.

REQUEST FOR ADMISSION NO. 11:

Prior to March 13, 2008, the filing of Application No. 77/420,784, Respondent was aware of Petitioner's senior and prior right in Petitioner's Mark for both Petitioner's services and Respondent's services.

REQUEST FOR ADMISSION NO. 12:

Respondent's Mark is identical to Petitioner's Mark.

REQUEST FOR ADMISSION NO. 13:

Respondent's Mark is confusingly similar to Petitioner's Mark.

REQUEST FOR ADMISSION NO. 14:

Respondent's services are the same as Petitioner's services.

REQUEST FOR ADMISSION NO. 15:

Respondent's services are sold through the same channels of trade as Petitioner's services and directed to the same consumers.

REQUEST FOR ADMISSION NO. 16:

Respondent is no longer an AirTime Member and is using the COMFORTCLUB mark without authorization from Petitioner.

REQUEST FOR ADMISSION NO. 17:

Respondent's Mark so closely resembles Petitioner's Mark such as to cause confusion, mistake, or deception, and/or to cause the consuming public to believe that Respondent's services marketed or sold in connection with Respondent's Mark originate with or are sponsored, endorsed, licensed, authorized and/or affiliated or connected with Petitioner and/or Petitioner's services in violation of Section 2(d) of the Lanham Act.

REQUEST FOR ADMISSION NO. 18:

Petitioner is and will be damaged by registration of Respondent's Mark.

REQUEST FOR ADMISSION NO. 19:

Petitioner's rights in Petitioner's Mark predate any use by Respondent of Respondent's Mark in U.S. commerce.

REQUEST FOR ADMISSION NO. 20:

All use of the COMFORTCLUB mark by Respondent inured to the benefit of Petitioner, the rightful owner of the COMFORTCLUB mark in the U.S.

REQUEST FOR ADMISSION NO. 21:

On March 13, 2008, Respondent's Owner and Principle Partner, Mr. Charles Barnaby, was aware of Petitioner's senior rights in COMFORTCLUB but signed a fraudulent declaration in support of Respondent's Application No. 77/420,784, with an intent to deceive the U.S. Trademark Office into granting registration of Respondent's Mark.

REQUEST FOR ADMISSION NO. 22:

On March 13, 2008, Respondent's Owner and Principle Partner, Mr. Charles Barnaby, was aware of that it was not the rightful owner of the COMFORTCLUB Mark and Application No. 77/420,784, but signed a fraudulent declaration in support of Respondent's application for registration of Respondent's Mark, with an intent to deceive the U.S. Trademark Office into granting registration of Respondent's Mark.

REQUEST FOR ADMISSION NO. 23:

Respondent's Declaration in Application No. 77/420,784 stating that "to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive...." is false.

REQUEST FOR ADMISSION NO. 24:

Petitioner established rights in the United States in its COMFORTCLUB Mark prior to 2008.

REQUEST FOR ADMISSION No. 25:

Since as early as 2006, Petitioner has established extensive, common-law rights in COMFORTCLUB Mark.

REQUEST FOR ADMISSION NO. 26:

Petitioner's rights in COMFORTCLUB date from prior to the filing date of Respondent's Mark or

Respondent's alleged use in United States commerce of Respondent's Mark.

REQUEST FOR ADMISSION NO. 27:

Respondent's Mark is not entitled to continued registration pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1125(d) because it is likely to cause confusion with the Petitioner's Mark.

REQUEST FOR ADMISSION NO. 28:

Applicant committed fraud on the U.S. Patent and Trademark Office.

REQUEST FOR ADMISSION NO. 29:

Respondent's First Affirmative Defense in paragraph 41 of its Answer to Petitioner's Petition to Cancel is without merit and unsupported by evidence.

REQUEST FOR ADMISSION NO. 30:

Respondent's Second Affirmative Defense in paragraph 42 of its Answer to Petitioner's Petition to Cancel is without merit and unsupported by evidence.

REQUEST FOR ADMISSION NO. 31:

Respondent's Third Affirmative Defense in paragraph 43 of its Answer to Petitioner's Petition to Cancel is without merit and unsupported by evidence.

REQUEST FOR ADMISSION NO. 32:

Respondent's Fourth Affirmative Defense in paragraph 44 of its Answer to Petitioner's Petition to Cancel is without merit and unsupported by evidence.

REQUEST FOR ADMISSION NO. 33:

Respondent's Fifth Affirmative Defense in paragraph 45 of its Answer to Petitioner's Petition to Cancel is without merit and unsupported by evidence.

REQUEST FOR ADMISSION NO. 34:

Respondent's Sixth Affirmative Defense in paragraph 46 of its Answer to Petitioner's Petition to Cancel is without merit and unsupported by evidence.

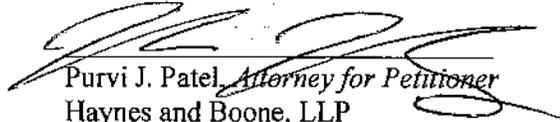
REQUEST FOR ADMISSION NO. 35:

Respondent's Seventh Affirmative Defense in paragraph 47 of its Answer to Petitioner's Petition to

Respectfully submitted,

CLOCKWORK IP, LLC

Date: June 4, 2014



Purvi J. Patel, *Attorney for Petitioner*

Haynes and Boone, LLP

2323 Victory Avenue, Suite 700

Dallas, TX 75219

Phone: 214-651-5917

Facsimile: 214-200-0812

patelp@haynesboone.com

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

Clockwork IP, LLC

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v.

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Respondent.

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Mark: COMFORT CLUB

Cancellation No. 92057941

In re Registration No. 3618331

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this 4th day of June, 2014, a copy of the foregoing *Petitioner's Requests for Admissions to Respondent* was served via first class mail, postage prepaid, on the following:

Julie Celum Garrigue, Esq.
Celum Law Firm, PLLC
11700 Preston Rd.,
Suite 660, PMB 560
Dallas, TX 75230


Purvi J. Patel

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