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

<b>CLOCKWORK IP, LLC</b>	)	
	)	
<b>Petitioner,</b>	)	
	)	
v.	)	<b>Cancellation No. 92057941</b>
	)	<b>Reg. No. 3,618,331</b>
<b>BARNABY HEATING &amp; AIR, and</b>	)	
<b>McAFEE HEATING AND AIR</b>	)	
<b>CONDITIONING CO., INC.</b>	)	
	)	
<b>Respondents.</b>	)	

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

Petitioner Clockwork IP, LLC (“Clockwork”), by counsel, states the following as its Opposition to Respondent’s Motion to Reopen or to Withdraw or Amend Petitioner’s Requests for Admission Nos. 36-45:<sup>1</sup>

**INTRODUCTION**

In an attempt to obtain relief to which it is not entitled, Respondent Barnaby Heating & Air (“Barnaby”) has contrived an absolutely fantastical (and sanctionable) story that it was never served with Requests for Admission (“RFAs”) Nos. 36 to 45 over a year ago. Without even bothering to think through the “facts” in support of this story long enough to make sure that it consistently represents them, that the “facts” are consistent with one another, or that the “facts” are even believable, Barnaby dumps a myriad of explanations and blame-shifting excuses at the Board’s feet, claiming that “justice” requires that it not be held to its admissions under Rule 36(a). But Barnaby’s tale falls to pieces when one digs even slightly beneath the surface since

<sup>1</sup> The title of Barnaby’s motion is confusing in that Barnaby is not seeking (**nor can it**) to withdraw or amend the RFAs themselves, but instead is seeking to reopen the time to respond to, or withdraw and amend its failure to respond to, those RFAs. To avoid changing Barnaby’s choice of words, however, Clockwork will use Barnaby’s confusing title.

the story is revealed as impossible just by looking at the RFAs themselves. Thus, as set forth below, Barnaby has failed to show that it is entitled to relief from its failure to respond to RFA Nos. 36 to 45 under either Federal Rule of Civil Procedure (“Rule”) 6(b)(2) or 36(b), and therefore the matters covered by those RFAs remain admitted and conclusively established.

## **BACKGROUND**

On June 4, 2014, Clockwork served its First Set of Requests for Production, First Set of Interrogatories, and First Set of Requests for Admission (collectively, the “discovery requests”) on Barnaby by sending those documents to Barnaby’s counsel of record via First Class mail. (See Decl. of Purvi Patel Albers (“Patel Albers Decl.”) ¶ 3.) Clockwork’s discovery requests – including but not limited to a complete set of Clockwork’s 45 RFAs – were therefore timely served on Barnaby in this case.<sup>2</sup> (See Patel Albers Decl. ¶¶ 2–4; Ex. 1 to Patel Albers Decl. (containing a true and accurate copy of Ex. C to Clockwork’s Mot. to Compel [Dkt. # 13], which is also a true copy of the as-served RFAs); [Dkt. # 22] Ex. 8 to DeFord Decl. (containing a true and accurate copy of the as-served RFAs).)

After receiving the discovery requests, Barnaby requested a brief extension of time to respond, and Clockwork consented. Barnaby then served its first responses to the discovery

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<sup>2</sup> Barnaby’s continued refusal to acknowledge that the discovery requests were timely served is baffling. (See [Dkt. # 29] Resp’t Mem. at 6 (“Though the parties hotly contest when Petitioner’s discovery requests were actually served . . . .”)) Not only did it waive any objection based on timeliness over a year ago, Barnaby has never offered any evidence in support of that argument. Although Barnaby claims that it did not receive the discovery requests until June 30, 2014, any alleged delay in receipt was not the result of late service, but rather, as Barnaby’s counsel explained via email that day, the people in charge of the mail in her building allegedly “delivered [Clockwork’s requests] to another mailbox holder in my suite . . . [t]hrough no fault of your client’s, or mine.” (Ex. 2 to Patel Albers Decl.) Moreover, in any case, service is not completed upon receipt of discovery requests; it is completed upon mailing and the Trademark Rules explicitly state that service is timely when completed on the last day of the discovery period. 37 C.F.R. § 2.119(c), 2.120(a)(3); TBMP § 403.03. Barnaby’s constant attempts to rehash this point is just another example of Barnaby refusing to let go of any excuse in this matter, regardless of whether the current excuse conflicts with its prior excuses.

requests on July 15, 2014, but it did not answer RFA Nos. 36 to 45. (*See* [Dkt. # 22] Ex. 9 to DeFord Decl.) As a result, under the Rules, as of July 15, 2014, Barnaby is deemed to have admitted RFA Nos. 36 to 45 and the matter contained in those RFAs was, and remains, conclusively established. *See* Fed. R. Civ. P. 36(a).

Now, almost exactly a year after Barnaby failed to respond to RFA Nos. 36 to 45, Barnaby seeks relief from its admission of those RFAs by claiming for the first time that there was a missing page and that Clockwork therefore never served Barnaby with RFA Nos. 36 to 45. (*See generally* [Dkt. # 29] Resp't's Mem. in Supp. of Resp't's Mot. to Reopen or Withdraw or Amend Pet'r's Requests for Admission Nos. 36 to 45 ("Resp't Mem.")) That contention is not grounded in fact and is refuted not only by Clockwork's prior attorney's sworn declaration and other evidence that it served all 45 RFAs on Barnaby on June 4, 2014, (*see* Patel Albers Decl. ¶¶ 2–4; *see also* Ex. 1 to Patel Albers Decl.; [Dkt. # 22] Ex. 8 to DeFord Decl.), but also by Barnaby's own "evidence" in support of its claim. **As explained below, RFA No. 35 starts on the bottom of one page and continues on the top of the next—the same page on which RFAs 36 to 45 are found. As Barnaby's counsel re-typed RFA No. 35 in its entirety to answer it, Barnaby's excuse is literally impossible.**

### ARGUMENT

It is undisputed that Barnaby has failed to respond to RFA Nos. 36 to 45 within the time prescribed by the Rules. (*See* [Dkt. # 29] Resp't Mem.; [Dkt. # 22] Ex. 9 to DeFord Decl.) Barnaby has therefore admitted those RFAs and the matter contained in them was, and remains, conclusively established. Fed. R. Civ. P. 36(a). Barnaby seeks relief from those admissions pursuant to Rule 6(b)(2), or alternatively, under Rule 36(b). But Barnaby has failed to establish that it is entitled to relief under either Rule.

**I. The Board should deny the Motion to Reopen under Rule 6(b)(2) because Barnaby's failure to respond to RFA Nos. 36 to 45 was not the product of excusable neglect.**

Rule 6(b)(2) provides that that Board “may, for good cause, extend the time” to act “on motion made after the time has expired if the party failed to act because of excusable neglect.” Fed. R. Civ. P. 6(b)(2). Whether excusable neglect exists is ““at bottom an equitable [determination], taking into account . . . all relevant circumstances surrounding the party’s omission.”” *Pumpkin Ltd. v. The Seed Corps*, 43 U.S.P.Q.2d (BNA) 1582, 1586 (T.T.A.B. 1997) (quoting *Pioneer Inv. Servs. Co. v. Brunswick Assocs. Ltd. P’ship*, 507 U.S. 380 (1993)). The Board generally balances the following four factors, set forth by the Supreme Court of the United States in *Pioneer Investment Services Co. v. Brunswick Associates Ltd. Partnership*, when deciding whether that standard is met and whether to reopen a time to act: “(1) the danger of prejudice to the non-moving party, (2) the length of delay and its potential impact on judicial proceedings, (3) the reason for the delay, including whether it was within the reasonable control of the moving party, and (4) whether the moving party had acted in good faith.” *DC Comics & Marvel Characters, Inc. v. Margo*, 68 U.S.P.Q.2d (BNA) 1319, 1319 (T.T.A.B. 2003); *see also Jodi Kristopher Inc. v. Int’l Seaway Trading Corp.*, 88 U.S.P.Q.2d (BNA) 1798, 1799 (T.T.A.B. 2008); *Pumpkin*, 43 U.S.P.Q.2d (BNA) at 1586. Although the Board should consider all four factors, it is almost universally accepted that the third factor is the most important one. *See Jodi Kristopher*, 88 U.S.P.Q.2d (BNA) at 1799; *DC Comics*, 68 U.S.P.Q.2d (BNA) at 1320; *see also Primavera Life GMBH v. Amorepacific Corp.*, No. 91196106, 2012 WL 9509389, at \*2 (T.T.A.B. Mar. 26, 2012); *Giersch v. Scripps Network, Inc.*, 85 U.S.P.Q.2d (BNA) 1306, 1307 (T.T.A.B. 2007); *Envirotech Corp. v. Compagnie Des Lampes*, 219 U.S.P.Q. (BNA) 448, 448 (T.T.A.B. 1979).

Applying the *Pioneer* standard here, Barnaby has not demonstrated that its failure to respond to RFA Nos. 36 to 45 was the product of excusable neglect. In lieu of addressing each factor, it summarily argues that it is entitled to relief because “any failure by Respondent to timely respond was caused by Petitioner, and squarely demonstrates excusable neglect” because “Ppetitioner failed to serve Nos. 36 – 45 when Petitioner served Nos. 1 –35,”<sup>3</sup> ([Dkt. # 29] Resp’t’s Mot. to Reopen or Withdraw or Amend Pet’r’s Requests for Admission Nos. 36-45 (“Resp’t’s Mot.”) at 1), and that it did not intentionally fail to respond to those RFAs, ([Dkt. # 29] Resp’t Mem. at 8.) But Barnaby’s attempt to shift blame for its failure to Clockwork does not withstand scrutiny, and a finding that it did not intentionally fail to respond is not sufficient standing alone to establish excusable neglect.

Clockwork’s First Set of Requests for Admission has, at all times, included a total of 45 RFAs. (Patel Albers Decl. ¶¶ 2–4; *see also* Ex. 1 to Patel Albers Decl.; [Dkt. # 22] Ex. 8 to DeFord Decl.). On June 4, 2014, Clockwork served all 45 RFAs on Barnaby by sending the complete, 10 page document containing those RFAs via First Class mail to Barnaby’s counsel of record. (Patel Albers Decl. ¶ 3; *see also* Ex. 1 to Patel Albers Decl.; [Dkt. # 22] Ex. 8 to DeFord Decl.) The as-served RFAs – which list RFA Nos. 36 to 45 on page 8 of 10 – were attached to Clockwork’s Motion to Compel as Exhibit C, (*see* Ex. 1 to Patel Albers Decl.), and Clockwork’s Motion for Summary Judgment as Exhibit 8, (*see* [Dkt. # 22] Ex. 8 to DeFord Decl.), and they

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<sup>3</sup> Barnaby neglects to make arguments with respect to the other two factors in this case, relying principally on the third and fourth factor. But as the Board should nevertheless consider those factors, Clockwork submits that they do not weigh in favor of finding excusable neglect (or are at best neutral in light of Barnaby’s inability to show that its failure to respond was outside its reasonable control) because, as explained more fully below, Clockwork will be prejudiced by reopening the time to respond, the delay caused by Barnaby’s failure to comply with its discovery obligations has already negatively impacted the proceedings, and further excusing Barnaby’s failure under the circumstances here is highly likely to result in future delays by perpetuating Barnaby’s sense that it does not have to take care now because it can excuse itself from any negative consequences later. (*See infra* at 15–16.)

are again attached to this Opposition as Exhibit 3 to the declaration of Purvi Patel Albers, (*see* Ex. 3 to Patel Albers Decl.) Thus, the record shows that, at all times during this proceeding, Clockwork intended to – and did – serve a total of 45 requests for admission.

Barnaby’s claim to the contrary is unfounded. To start, to the extent that Barnaby intends to imply or suggest that Clockwork did not intend to include RFA Nos. 36 to 45 as part of the First Set of Requests for Admission at the time Clockwork served them on June 4, 2014, that argument is devoid of any support and is contradicted by Barnaby’s own “evidence.” Barnaby never once objected to the authenticity of the as-served RFAs that were attached as Exhibit C to the motion to compel and as Exhibit 8 to the motion for summary judgment, and it cannot go back and make those objections now.<sup>4</sup> Moreover, Barnaby attached as Exhibit 10 to its

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<sup>4</sup> Barnaby tries to claim that Clockwork’s prior counsel affirmatively represented that there were only 35 RFAs in this case. (*See, e.g.*, [Dkt. # 29] Resp’t Mem. at 7–8; [Dkt. # 29] Celum Decl. ¶¶ 9–10; [Dkt. # 29] Ex. 8–9 to Celum Decl.) But a review of the two statements in the context in which they were made reveals that Barnaby is mischaracterizing those representations and that Clockwork’s prior counsel was merely looking at and referencing Barnaby’s responses. Specifically, Barnaby first tries to claim that the statement by Clockwork’s prior counsel in the deficiency letter “that all 35 of Petitioner’s Requests for Admission have been objected to in the same manner” somehow shows that there were only 35 RFAs. (*See* [Dkt. # 29] Ex. 8 to Celum Decl.) That reasoning is faulty. The deficiency letter raised issues with the responses that Barnaby actually served, which included responses to only 35 RFAs. (*See id.*; Patel Albers Decl. ¶ 6.) As a failure to respond to an RFA is not a discovery deficiency but a deemed admission under Rule 36(a), there was no need for Clockwork to mention that failure in its letter. *See* Fed. R. Civ. P. 36(a)(3) (noting that a matter is admitted unless responded to, and that “[a] matter admitted under this rule is conclusively established unless the court, on motion, permits the admission to be withdrawn or amended”). Thus, the only inference to be drawn from Clockwork’s statement in the discovery letter is that all 35 responses that Barnaby actually bothered to provide were deficient.

For the same reason, Barnaby cannot rely on the statement of prior counsel in the motion to compel to claim there were only 35 RFAs in this case. Not only were the RFAs not at issue in the motion to compel, (*see* [Dkt. # 29] Ex. 9 to Celum Decl.), any reference in the motion to compel of 35 RFAs or 151 requests total was again meant to refer only to deficient responses that Barnaby actually provided, not as some concession that Clockwork *served* only 35 RFAs. (*See id.* at 6. 15; Patel Albers Decl. ¶ 7.) In fact, it is nonsensical to argue that Clockwork conceded that it served only 35 RFAs in its motion to compel because Clockwork attached the as-served RFAs to its motion as Exhibit C, which contained all 45 RFAs, (Patel Albers Decl. ¶ 7;

memorandum what its counsel declared to be a “true and accurate copy of the original .PDF of Petitioner’s requests for admissions, as scanned into [counsel’s] office database and as saved, and from which [counsel] created and drafted Respondent’s objections and responses to Petitioner’s discovery request.” (See [Dkt. # 29] Celum Decl. ¶ 12; [Dkt. # 29] Ex. 10 to Celum Decl.) That document is identical to the as-served RFAs that Clockwork attached to its prior motions and to this Opposition, except that Barnaby’s exhibit is missing two pages: pages 2 and 8 of the 10 page document.<sup>5</sup>

As a result, in order for Barnaby’s “lack of service” argument to hold any water, the Board must buy Barnaby’s story that Clockwork inadvertently left out page 8 (and therefore RFA Nos. 36 to 45) when it served the RFAs on Barnaby on June 4, 2014 (the “Missing Page story”). But even putting aside how unlikely it would be that Clockwork would inadvertently leave out a page from the middle of a document while including the pages before and after it, Barnaby – in its own desperation to convince the Board that such an unlikely event occurred – all but proves that the Missing Page story is fabricated.

First, Barnaby cannot contest that it answered RFA No. 35 in all of its prior discovery responses, and that it included a word-for-word transcription, re-typed or copied and pasted by Barnaby’s counsel, of RFA No. 35 with its answer each time. (See [Dkt. # 22] Ex. 5, 9–10 to DeFord Decl.) Barnaby also admits that RFA No. 35 is split between pages 7 and 8 of the 10 page document, such that part of RFA No. 35 appears on the same page as RFA Nos. 36 to 45.

([Dkt. # 29] Celum Decl. ¶ 15.) Yet, although Barnaby now asks the Board to believe that it

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Ex. 1 to Patel Albers Decl.), a point which Barnaby conveniently fails to mention in its opening brief.

<sup>5</sup> The fact that Barnaby’s exhibit showing the supposedly served RFAs is also missing page 2 is telling as Barnaby does not claim that page 2 was not served. And although it may be the case that Barnaby continues to misplace pages related to the RFAs, that is not Barnaby’s claim, nor would that be excusable neglect a year later.

never received page 8, Barnaby offers no explanation in its memorandum or declaration how it nevertheless knew every word of RFA No. 35, (*see generally id.*; [Dkt. # 29] Resp't Mem.), and the Board would be justified in treating any after-the-fact explanation proffered in Barnaby's reply with extreme skepticism.<sup>6</sup>

Second, Barnaby relies on Exhibit 10 as “evidence” that the service copy of the RFAs was missing page 8 (and therefore RFA Nos. 36 to 45), stating that the document attached as Exhibit 10 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*, from which I created and drafted Respondent’s objections and responses to Petitioner’s discovery requests.” ([Dkt. # 29] Celum Decl. 12 (emphasis added); [Dkt. # 29] Ex. 10 to Celum Decl.) Also attached with Exhibit 10 is a print out of “[t]he metadata from the scanned .PDF show[ing] a file create date of June 30, 2014.” ([Dkt. # 29] Celum Decl. ¶ 11; [Dkt. # 29] Ex. 10 to Celum Decl.) But viewing those documents together demonstrates that Barnaby’s story does not add up. The “true and accurate copy” of the RFAs, “*as scanned into my office database and saved*,” that is attached in Exhibit 10 is missing both page 2 and page 8 of the 10 page document and is therefore 8 pages long. (*See* [Dkt. # 29] Ex. 10 to Celum Decl.) But the metadata for the file “Clockwork RFAs.pdf” that Barnaby contends corresponds to that “true and accurate copy” of the RFAs it received is only 7 pages long. (*See id.*) No matter how that discrepancy in page count occurred, the documents suggest that Barnaby – not Clockwork – is misplacing (and then finding) pages of its

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<sup>6</sup> Although it is not entirely impossible that Barnaby’s counsel would have guessed, word-for-word, what the remainder of RFA No. 35 said, it is telling that Barnaby did not think to mention that explanation in its opening brief, given that Clockwork’s counsel raised that issue with Barnaby’s story before Barnaby filed its opening brief, (*see* [Dkt. # 29] Ex. 7 to Celum Decl.), and in light of the fact that Barnaby took the time to try and explain, albeit insufficiently, why it did not reach out to Clockwork’s counsel regarding the missing portion of RFP No. 35 and to claim that it **somehow** did not notice the missing page even though it noticed that part of the RFP was missing, (*see* [Dkt. # 29] Celum Decl. ¶ 15.)

documents. In actuality, all that is clear is that Barnaby is not very good at hiding the tracks of its fabrication.

Third, as Barnaby admits, it first raised its “lack of service” claim with Clockwork on June 15, 2015 – three weeks after Clockwork filed its motion for summary judgment, which rests in part on Barnaby’s admissions in RFA Nos. 36 to 45 – in an email sent to Clockwork’s counsel. ([Dkt. # 29] Resp’t Mem. at 9; [Dkt. # 29] Celum Decl. ¶ 8; [Dkt. # 29] Ex. 7 to Celum Decl.) In that email Barnaby’s counsel stated: “Barnaby was never served with 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.” ([Dkt. # 29] Ex. 7 to Celum Decl. (emphasis added).) But a quick reference to the “true and accurate copy” of the “original document” that Barnaby submitted (as well as the as-served RFAs attached to this motion), shows that page 9 is a signature page; the allegedly missing RFAs are found on page 8. (*See* [Dkt. # 29] Ex. 10 to Celum Decl.) It was not until after Clockwork’s counsel pointed this out to Barnaby that Barnaby all of a sudden began claiming that it never received page 8. (*See* [Dkt. # 29] Ex. 7 to Celum Decl.)

And fourth, Barnaby itself does not even appear to believe its claim that Clockwork failed to serve RFA Nos. 36 to 45. Not only does it let its doubt show through later in its memorandum, (*see* [Dkt. # 29] Resp’t Mem. at 12 (“[A]lthough applicant cannot be excused for failing to respond within the time allowed for such response . . . .”), but Barnaby chose to file a motion to reopen or to withdraw and amend, not a motion to strike untimely filed RFAs. Combining all of these points together, Barnaby has not only failed to show excusable neglect, but actually provides affirmative evidence that, to the extent Barnaby’s Missing Page story is not

a complete fabrication,<sup>7</sup> any failure to see and respond to RFA Nos. 36 to 45 was Barnaby's fault.

But even if the Board believes that RFA Nos. 36 to 45 were missing from the document Clockwork served on Barnaby, the third *Pioneer* factor would still weigh against a finding of excusable neglect. That factor takes into account whether the failure to respond was *reasonably* within the control of the moving party, not *wholly* in its control. Here, accepting *arguendo* that Clockwork inadvertently left out page 8 from the service copy of the RFAs, Barnaby was the only party in a position to know that such error occurred prior to the time its deadline to respond elapsed. In fact, Barnaby's counsel admits that she "did see that a portion of Petitioner's Request No. 35 was missing" but claims that she did not notice that one of the clearly numbered pages was missing. ([Dkt. # 29] Celum Decl. ¶ 15.) Barnaby's counsel goes on to explain that she did not reach out to Clockwork's counsel regarding the missing half of RFP No. 35 – or even presumably look down at the bottom of the page to check the page numbers *for a year* – because she just "assumed that Petitioner's counsel made a typographical error." (*Id.*) Thus, even accepting *arguendo* that Barnaby's Missing Page story holds any weight – which it does not – Barnaby cannot claim that its failure to respond was not reasonably within its control when it noticed an issue with the RFAs, and instead of protecting itself by reaching out to Clockwork's

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<sup>7</sup> Clockwork's counsel would normally not be so bold as to allege that something is an outright fabrication, but in light of the history of this case, Barnaby's remarkable ability to come up with after-the-fact, blame-shift excuses for why its failure to meet deadlines was beyond its control, that Barnaby's most recent Missing Page story simply does not add up, and Barnaby's blatant dishonest misrepresentation of the allegations in the Petition in support of its pleading deficiency argument, (*see* [Dkt.# 30 and 32]), Clockwork has clear reason for making such statements.

counsel for, at a minimum, clarification of what RFA No. 35 said, it decided to assume that it knew what happened.<sup>8</sup>

Barnaby cannot excuse its failure to respond to RFA Nos. 36 to 45 by claiming that it did not intentionally fail to respond or that it did not know it had failed to respond until Clockwork filed its motion for summary judgment. ([Dkt. # 29] Resp't Mem. at 8; [Dkt. # 29] Celum Decl. ¶ 14.) As the facts described *supra* establish, bad faith is clear in this case and has been exacerbated by Barnaby's implausible story regarding the supposed missing pages. However, even if the Board were to credit both Barnaby's statements regarding its lack of intent – which the Board would be justified in declining to do given Barnaby's conduct throughout this proceeding, not to mention in connection with this motion, (*see, e.g.*, Ex. 2, 4 to Patel Albers Decl. (evidencing Barnaby's fluctuating and inconsistent positions with respect to service of the discovery requests); [Dkt. # 21] Pet.'s Sanction Mot. at 1–6 (providing an overview of Barnaby's refusal to abide by its discovery obligations and demonstrating how several of the responses provided are clearly false or intentionally evasive); [Dkt. # 27] Pet.'s Sanction Reply at 7–8 (describing Barnaby's bad faith conduct); [Dkt. # 32] Pet.'s SJ Reply at 4–5 (discussing Barnaby's blatantly dishonest pleading deficiency argument)) – “good faith” is just one prong in the four factor test and is not enough to warrant a finding of excusable neglect where, as here, the reason for the failure to respond was within the reasonable control of Barnaby. *See, e.g.*,

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<sup>8</sup> In its brief, Barnaby asserts that: “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.” ([Dkt. # 29] Resp't Mem. at 8.) But no part of Barnaby's story makes sense. For example, it makes no sense that Barnaby would answer RFA No. 35 without confirming first what it said or that it would not reach out to Clockwork's counsel when it noticed half the RFA was missing to cover its bases, but Barnaby admittedly did so in this case. ([Dkt. # 29] Celum Decl. ¶ 15.)

*Giersch*, 85 U.S.P.Q.2d (BNA) at 1307 (finding no excusable neglect even though there was no evidence of bad faith by the moving party).<sup>9</sup>

Essentially, no matter how the Board looks at it, Barnaby has failed to establish excusable neglect. Its sole explanation – that it never received RFA Nos. 36 to 45 – is clearly false and made in desperation. Viewed as a whole, Barnaby’s explanation and “evidence” in support of that explanation not only fails to support its lack of service and Missing Page stories, but actually swings so far in the other direction that, when combined with Clockwork’s evidence of service, it is clear that Clockwork served all 45 RFAs on Barnaby on June 4, 2014. At best, Barnaby’s failure to respond was the result of its own misplacement of page 8. At worst, Barnaby realized its error too late and made the whole story up.<sup>10</sup> Either way, Barnaby has not established that its failure to respond to RFA Nos. 36 to 45 was the product of excusable neglect, and the Board should deny the motion to reopen pursuant to Rule 6(b)(2).

**II. The Board should deny the Motion to Withdraw and Amend Barnaby’s admissions of RFA Nos. 36 to 45.**

The Board should not permit Barnaby to escape the consequences of its failure to act under Rule 36(b). Rule 36(b) provides that “the [Board] *may* permit withdrawal or amendment

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<sup>9</sup> Similarly, Barnaby cannot patch the holes in its story by complaining that, on “September 10, 2014, Petitioner’s counsel represented in writing that it served Respondent with 35 requests for admission,” ([Dkt. # 29] Resp’t Mem. at 7), or that, “[o]n November 6, 2014, Petitioner affirmed that it served 35 requests for admission,” (*id.*; *see also id.* at 8, 12; [Dkt. # 29] Celum Decl. ¶¶ 9–10; [Dkt. # 29] Ex. 8–9 to Celum Decl.) Even if Barnaby was accurately representing the nature of those statements by prior counsel – which it is not, *see supra* n.4 – those statements were made *after* Barnaby’s deadline to respond to the RFAs lapsed. Barnaby therefore cannot justify its failure to respond to RFA Nos. 36 to 45 based on those statements because the unanswered RFAs had already been admitted and conclusively established under the Rules by the time they were made. Fed. R. Civ. P. 36(a).

<sup>10</sup> Curiously, despite proffering evidence in support of this motion to “show” that Barnaby did not receive the discovery requests until June 30, 2014, (*see* [Dkt. # 29] Ex. 10 to Celum Decl.), Barnaby nevertheless complained in all of its prior discovery responses that it did not receive those requests until July 2, 2015, (*see* [Dkt. # 22] Ex. 5, 9–10 to DeFord Decl.)

[of admitted RFAs] if it would promote the presentation of the merits of the action and if the court is not persuaded that it would prejudice the requesting party in maintaining or defending the action on the merits.” Fed. R. Civ. P. 36(b) (emphasis added). Although both prongs of the test must be met in order for the Board to permit withdrawal and amendment of deemed admissions, once those prongs are met, Rule 36(b) gives the Board “substantial discretion in deciding whether to allow [that] withdrawal.” See *Sarl Corexco v. Webid Consulting Ltd.*, 110 U.S.P.Q.2d (BNA) 1587, 1589 (T.T.AB. 2014); *Giersch*, 85 U.S.P.Q.2d (BNA) at 1308 (noting that, “[c]onsistent with the language contained in [Rule 36(b),] ‘withdrawal is at the discretion of the court.’” (citation omitted)).

At least four circuits have held that the Board may decline to exercise that discretion even if the two prongs are met, where other factors – including but not limited to “whether the moving party can show good cause for the delay” or “whether the moving party appears to have a strong case on the merits,” *Conlon v. United States*, 474 F.3d 616, 625 (9th Cir. 2007) – indicate that withdrawal or amendment should not be allowed, see *Williams v. Wells Fargo Bank, N.A.*, 560 F. App’x 233, 244 (5th Cir. Mar. 19, 2014); *Gwynn v. City of Philadelphia*, 719 F.3d 295, 298 (3d Cir. 2013); *SEC v. Global Express Capital Real Estate Investment Fund, I, LLC*, 289 F. App’x 183, 191 (9th Cir. Aug. 7, 2008); *Donovan v. Carls Drug Co.*, 703 F.2d 650, 651–52 (2d Cir. 1983), *rejected on other grounds by McLaughlin v. Richland Shoe Co.*, 486 U.S. 128 (1988).<sup>11</sup>

Here, Barnaby again puts forth minimal effort in an attempt to establish that it is entitled to relief under Rule 36(b). With respect to the first of the two mandatory prongs, Barnaby makes a blanket statement that *all* of the deemed admissions “go to the necessary elements of

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<sup>11</sup> Because a motion under Rule 36(b) amounts to an admission that moving party failed to timely respond to the RFAs, a party that obtains relief under this Rule must submit amended responses without objections on the merits. *Envirotech Corp.*, 219 U.S.P.Q. (BNA) at 449; see also *Conopco, Inc. v. Huff*, 2004 WL 1799922, at \*7 (T.T.A.B. Aug. 10, 2004).

Petitioner’s claims of fraud and likelihood of confusion.” ([Dkt. # 29] Resp’t Mem. at 11.) But at least RFA Nos. 37, 38, 40, 41, and 42, (admitting that Clockwork has standing in this cancellation proceeding, that Clockwork used and is continuing to use COMFORTCLUB, that Clockwork’s COMFORTCLUB Mark is distinctive and is distinctive as applied to Clockwork’s services, and that the COMFORTCLUB Mark is distinctive as applied to Barnaby’s services), do not admit core facts related to Clockwork’s fraud or likelihood of confusion claims, or they admit something that Barnaby could not otherwise properly deny.<sup>12</sup> Permitting withdrawal and amendment of Barnaby’s admission of these RFAs would therefore not serve the merits, and the Board must deny Barnaby’s Rule 36(b) motion with respect to those RFAs for that reason alone. *See* Fed. R. Civ. P. 36(b); *see also Williams*, 560 F. App’x at 244; *Global Express*, 289 F. App’x at 191.

With respect to RFA Nos. 36, 39, 43, 44, and 45, Clockwork is certainly prejudiced by a withdrawal and amendment of those RFAs almost 15 months after they were admitted, after Clockwork relied on them in support of its motion for summary judgment, and on the eve of the start of Clockwork’s pretrial period. However, the Board should decline to exercise its discretion

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<sup>12</sup> Barnaby’s claim that Clockwork lacks standing to bring this action is baseless. The public record establishes that Clockwork filed Application Ser. No. 85/880,911 for the mark COMFORTCLUB on March 20, 2013, for use in connection with, among other things, “prepaid services for heating, ventilating and air conditioning systems,” and that its application was refused based on Barnaby’s registration for that mark. (*See* [Dkt. # 22] Ex. 1, 3–4 to DeFord Decl.) Clockwork therefore has standing to bring this cancellation action. *See Farah v. Pramil S.R.L.*, 300 F. App’x 915, 917–18 (Fed. Cir. 2008); *Nutriline Int’l, Inc. v. Andrew Bert Foti*, No. 92056801, 2014 WL 2174327, at \*3 (T.T.A.B. May 14, 2014) (“Standing can be established if a petitioner proves that it filed an application and that a rejection was made because of a respondent’s registration.”); *Great Seats, Ltd. v. Great Seats, Inc.*, 84 U.S.P.Q.2d (BNA) 1235, (T.T.A.B. 2007) (same). Similarly, although Barnaby may contest when Clockwork’s use of COMFORTCLUB first began, it cannot deny that Clockwork has used, and currently is using, the COMFORTCLUB Mark, for several reasons, including but not limited to the fact that Barnaby previously sent Clockwork a cease and desist letter, demanding that Clockwork stop use of COMFORTCLUB. ([Dkt. # 32] Ex. 1 to Newberg Decl.)

under Rule 36(b) regardless of whether that prejudice is deemed substantial or not given the surrounding circumstances of this case.

As described above, many courts have previously declined to exercise their discretion and refused to allow a party to withdraw and amend admitted RFAs under Rule 36(b) where the failure to respond was the product of gamesmanship, where the moving party did not appear to have a strong case on the merits, or where the explanation for the failure to respond, even if not evidence of gamesmanship, nevertheless indicated that relief under Rule 36(b) was not warranted. *Global Express*, 289 F. App'x at 191; *Conlon*, 474 F.3d at 616; *SEC v. Dynasty Fund, Ltd.*, 121 F. App'x 410, 411–12 (2d Cir. 2005); *Donovan*, 722 F.2d at 652. All three of those situations are present here.

As demonstrated in Clockwork's motion for sanctions and accompanying briefs, the record in this case is wrought with evidence that, since Clockwork served its discovery on June 4, 2014, Barnaby has stonewalled and used every tactic to avoid satisfying its discovery obligations in this case. (*See generally* [Dkt. # 21] Pet.'s Sanction Mot.; [Dkt. # 27] Pet.'s Sanction Reply; *see also* [Dkt. # 32] Pet's SJ Reply at 4–5 (discussing Barnaby's blatantly dishonest pleading deficiency argument).) Now, faced for the first time with meaningful consequences for its continued refusal to take this matter seriously, Barnaby tries to sell the Board a flimsy story that its failure to respond to RFA Nos. 36 to 45 was Clockwork's fault because Barnaby never received the page containing those RFAs. But as demonstrated above, that story falls apart when one digs even slightly beneath the surface, and, at the very least, Barnaby cannot dispute that it deliberately chose to not raise an issue that its counsel noticed in the RFAs over 15 months ago. ([Dkt. # 29] Celum Decl. ¶ 15.)

In light of the circumstances surrounding Barnaby's failure to respond to RFA Nos. 36 to 45, permitting Barnaby to withdraw and amend its RFAs under these circumstances is not in the "clear . . . interest[] of justice" as Barnaby claims. ([Dkt. # 29] Resp't Mem. at 12.) Instead, it would reward Barnaby's cavalier attitude and "miss deadlines, and generate excuses later" approach to this proceeding, thus signaling to Barnaby that it need not take even a basic level of care. Moreover, permitting withdrawal and amendment would prejudice Clockwork by putting it in the untenable position of never knowing whether it can rely on any representation or action taken by Barnaby because Clockwork will always have to wonder whether, when faced with consequences for its representations or actions, Barnaby will miraculously come up with another fanciful reason for why it should not be held accountable. (*See, e.g.*, [Dkt. # 24] Resp't's Opp'n to Pet.'s Sanction Mot. at 2, 4, 6–7 (blaming its failure to comply with the Board ordered discovery deadline on a calendar snafu and on Clockwork); [Dkt. # 27] Pet.'s Sanction Reply at 5 (identifying the parade of calamities Barnaby claims to have been a victim of in order to excuse its failure to meet deadlines, such as the calendar snafu and the mailbox mix-up).) The Board would therefore be justified in declining to exercise its discretion to grant the permissive, equitable relief provided for in Rule 36(b). *See Dynasty Fund, Ltd.*, 121 F. App'x at 411–12 (affirming the district court's refusal to excuse admissions under Rule 36(b) after finding that, contrary to the moving party's claim, the moving party was in fact served with the RFAs); *see also Global Express*, 289 F. App'x at 191 (noting that, even if the moving party "had satisfied both prongs of the 36(b) test, [the court] would affirm the district court's denial of her motion to withdraw" because, in part, the district court found "that her delay was part of her manipulative approach to the litigation").

The Board would also be justified in declining to exercise its discretion because Barnaby has conceded that it does not have a strong case on the merits. *See Donovan*, 703 F.2d at 652. As demonstrated more fully in Clockwork's memoranda filed in support of its motion for sanctions and motion for summary judgment, Barnaby's discovery responses in this case are deficient, evasive, and demonstrate that Barnaby not only will be unable to refute Clockwork's affirmative evidence in support of its claims, but that the minimal documents Barnaby has produced actually support Clockwork's claims. (*See* [Dkt. # 21] Pet.'s Sanction Mem.; [Dkt. # 22] Pet.'s SJ Mem. at 11–14; [Dkt. # 27] Pet.'s Sanction Reply; [Dkt. # 32] Pet.'s SJ Reply.) At a minimum, Barnaby has conceded prior to the trial phase in this matter that it possesses *no* physical evidence and cannot provide *any* details in support its unsubstantiated claim that it created the COMFORTCLUB Mark out of wholecloth despite being surrounded by at least 7 OHAC franchisees (and competitors of Barnaby's) that were using Clockwork's COMFORTCLUB Mark. (*See, e.g.*, [Dkt. # 22] Yohn Decl. ¶ 9; [Dkt. # 22] Ex. 2 to Yohn Decl.; [Dkt. # 32] Pet.'s SJ Reply at 7–8.) It is also apparent that Barnaby will be unable to offer anything other than self-serving statements to show that it could honestly believe its sworn declarations to the Board in March 2008 and/or August 2008 that Barnaby owned the COMFORTCLUB Mark and/or believed that no other person, firm, entity, or association with rights to use an identical or confusingly similar mark despite the fact that Barnaby was not only surrounded by Clockwork's franchisees that were using the mark, but also by March 2008 had a non-exclusive license to Clockwork's intellectual property – including the COMFORTCLUB Mark – based on Barnaby's AirTime500 membership and had expressly acknowledged that Barnaby received no ownership rights in Clockwork's intellectual property by signing the Nighthawk AirTime Membership Agreement. (*See, e.g.*, [Dkt. # 22] Pet.'s SJ Mem. at 12–13;

[Dkt. # 22] Ex. 2 to DeFord Decl.; [Dkt. # 22] Ex. 2 to Yohn Decl.; [Dkt. # 32] Pet.'s SJ Reply at 7–8.) And Clockwork has demonstrated in its opposition to Barnaby's cross-motion for summary judgment that at least 7 of Barnaby's affirmative defenses are inapplicable to the claims in this case or are without merit. (*See* [Dkt. # 34] Pet.'s Opp. to Cross-Mot.)

Finally, the Board would be justified in declining to exercise its discretion under Rule 36(b) because Barnaby cannot show good cause for its failure to respond to RFA Nos. 36 to 45 or for the subsequent 15 month delay between that failure to respond and Barnaby's motion to withdraw and amend the RFAs. *See Global Express*, 289 F. App'x at 191 (noting that, even if the moving party "had satisfied both prongs of the 36(b) test, [the court] would affirm the district court's denial of her motion to withdraw" because, in part, the district court found the moving party "did not have good cause for delay"); *Conlon*, 474 F.3d at 624–25. As explained above, even if the Board were to accept Barnaby's flawed story that the service copy of Clockwork's RFAs was missing page 8 (and therefore RFA Nos. 36 to 45), Barnaby's failure to reach out to Clockwork's counsel when it admittedly noticed that part of RFA No. 35 was missing is inexcusable. Barnaby was the only party in a position to know, prior to when its deadline to respond elapsed, that it supposedly did not receive a complete copy of Clockwork's RFAs. But in lieu of picking up the phone or sending a simple email to Clockwork's counsel just to be safe, Barnaby decided instead to "assume" the incomplete RFA was "a typographical error." ([Dkt. # 29] Celum Decl. ¶ 15.) Perhaps even more telling, Barnaby apparently did not even bother to glance down at the page numbers to verify its "typographical error" assumption. (*Id.*) As a result, Barnaby cannot show good cause for its failure to respond to RFA Nos. 36 to 45 within the prescribed deadline or justify the 15 month delay in filing this motion by claiming that it did

not learn of this failure until after Clockwork filed its motion for summary judgment in reliance on those admissions.<sup>13</sup>

Simply put, by viewing the case in its entirety as well as the specific facts linked to Barnaby's Rule 36(b) motion, the inescapable conclusion is that relief under Rule 36(b) is inappropriate. Thus, Clockwork respectfully requests that the Board decline to exercise its discretion under Rule 36(b) and deny Barnaby's motion. Alternatively, to the extent that the Board finds relief appropriate under Rule 36(b), Clockwork requests that the Board not accept Barnaby's proposed objections and responses to RFA Nos. 36 to 45, ([Dkt. # 29] Ex. 1 to Resp't Mem.), and instead set a specific time by which Barnaby must serve on Clockwork's counsel of record its amended responses to RFA Nos. 36 to 45 without objections on the merits, *see Envirotech Corp.*, 219 U.S.P.Q. (BNA) at 449; *see also Conopco, Inc.*, 2004 WL 1799922, at \*7.

### CONCLUSION

For the reasons stated above, Petitioner Clockwork IP, LLC respectfully requests that the Board deny Respondent's Motion to Reopen or to Withdraw or Amend Petitioner's Requests for Admission Nos. 36-45, and enter an Order that Requests for Admission Nos. 36 to 45 are admitted and conclusively established.

Respectfully submitted,

CLOCKWORK IP, LLC

Filed via ESTTA: July 24, 2015

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<sup>13</sup> Again, for the reasons set forth in footnote 4, Barnaby cannot rely on its tortured interpretation of prior statements by Clockwork's former counsel. *See supra* n.4.

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*Attorneys for Petitioner Clockwork IP, LLC*

**CERTIFICATE OF SERVICE**

On July 24, 2015, this document was sent by first class mail to the following counsel of record:

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

*Counsel for Respondent Barnaby  
Heating & Air*

Melissa Replogle  
Replogle Law Office LLC  
2661 Commons Blvd.  
Suite 142  
Beavercreek, OH 45431

*Counsel for Assignee McAfee Heating  
& Air Conditioning Co., Inc.*

/Amanda L. DeFord/  
Amanda L. DeFord

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

<b>CLOCKWORK IP, LLC</b>	)	
	)	
<b>Petitioner,</b>	)	
	)	
<b>v.</b>	)	<b>Cancellation No. 92057941</b>
	)	<b>Reg. No. 3,618,331</b>
<b>BARNABY HEATING &amp; AIR, and</b>	)	
<b>McAFEE HEATING AND AIR</b>	)	
<b>CONDITIONING CO., INC.</b>	)	
	)	
<b>Respondents.</b>	)	

**DECLARATION OF PURVI PATEL ALBERS**

I, Purvi Patel Albers, declare and state as follows:

1. I am a partner at the law firm Haynes and Boone, LLP, former counsel for Petitioner Clockwork IP, LLC (“Clockwork”). I make this declaration in support of Clockwork’s Opposition to Respondent’s Motion to Reopen or Withdraw or Amend Petitioner’s Requests for Admission Nos. 36 to 45. The following facts are within my knowledge and, if called and sworn as a witness, I could and would testify competently thereto. The matters referred to in this declaration are based upon my personal knowledge, and/or when referencing documents, such documents were reviewed by me and where applicable, were obtained and compiled at my instruction by other attorneys employed by Haynes and Boone, LLP, and if called as a witness I could testify and would testify competently thereto.

2. When I served as counsel for Clockwork in this matter, I drafted, or had drafted at my direction, a total of forty-five (45) Requests for Admissions for this case to be, and which were, served as one set of requests.

3. On June 4, 2014, along with Clockwork’s First Sets of Interrogatories and Requests for Production, I served Clockwork’s First Set of Requests for Admission – which consisted of a total of forty-five (45) Requests for Admission – on Barnaby by sending a copy of the First Set of Requests for Admission to Barnaby’s counsel of record, Julie Celum Garrigue, via First Class mail.

4. At all times, I intended to serve – and did serve – forty-five (45) Requests for Admission on Barnaby in the above-captioned matter. At no time did I ever concede to Barnaby or Ms. Garrigue that Clockwork served only thirty-five (35) Requests for Admission in this case.

5. Ms. Garrigue never contacted me regarding a purported missing page or pages in the service copy of the First Set of Requests for Admission. Ms. Garrigue also never claimed that half of Request for Admission No. 35 was allegedly missing from the service copy she received.

6. Ms. Garrigue's characterizations of the statements made in the deficiency letter I sent to Ms. Garrigue on September 10, 2014, are inaccurate. Any reference to thirty-five (35) Requests for Admission was not a concession that Clockwork served only thirty-five (35) Requests for Admission, but instead was the product of me referencing, and referring only to, the Requests for Admission that Barnaby actually answered.

7. Ms. Garrigue's characterizations of the statements made in the motion to compel are also inaccurate. I have reviewed that motion and state that any reference to thirty-five (35) Requests for Admission or a total of 151 discovery requests was similarly not a concession that Clockwork served only thirty-five (35) Requests for Admission, but instead was again the product of me referencing, or referring only to, the Requests for Admission that Barnaby actually answered when preparing that motion. In fact, I attached, *as Exhibit C to the Motion to Compel*, a true and accurate copy of the as-served First Set of Requests for Admission, which demonstrate that they contained a total of forty-five (45) Requests for Admission. Attached hereto as **Exhibit 1** is a true and accurate copy of Exhibit C to the Motion to Compel.

8. Attached hereto as **Exhibit 2** is a true and accurate copy of an email I received from Julie Celum Garrigue, Esquire, counsel of record for Respondent Barnaby Heating & Air, on June 30, 2014. In that email, Ms. Garrigue claimed that she had just received Clockwork's discovery requests because, through no fault of Clockwork or Barnaby, the requests had been delivered to the wrong mailbox in her office suite. Ms. Garrigue did not, however, state that the discovery was served late or that any pages were missing.

9. Attached hereto as **Exhibit 3** is a true and accurate copy of the First Set of Requests for Admission that I served on Ms. Garrigue via First Class mail on June 4, 2014. As one can see, Request No. 35 starts on the bottom of page 7 and continues on page 8 where Request Nos. 36-45 can be found. It would therefore be impossible for a recipient of the Requests for Admission to re-type in full and answer Request No. 35 without also seeing Request Nos. 36-45.

10. Attached hereto as **Exhibit 4** is a true and accurate copy of an email I received from Ms. Garrigue on September 10, 2014.

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are true.

Executed this 23<sup>rd</sup> day of July 2015 at 4:15pm.

  
Purvi Patel Albers, Esq  
Haynes and Boone, LLP

**EXHIBIT 1 TO PATEL  
ALBERS DECLARATION**

# EXHIBIT C

**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

DOMINANCE events, and Senior Tech events refer to periodic events, training seminars, and workshops sponsored and/or held by Petitioner or its affiliates.

D. “Person” is defined as any natural person or any business, legal, or governmental entity or association.

E. “Commerce” signifies commerce that the U.S. Congress may lawfully regulate. The phrase “use in commerce” is defined in Section 45 of the Trademark Act, 15 U.S.C. § 1127, to mean that a mark shall be deemed to be in use in commerce “(1) on goods when – (A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and (B) the goods are sold or transported in commerce, and (2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.”

F. “Date of first use” refers to the date of first use in the United States unless otherwise stated.

G. The term “goods” and the term “services,” in the singular or plural form, mean both “goods and services.”

H. “Respondent’s Mark” means the alleged mark COMFORTCLUB as shown in Respondent’s U.S. Registration No. 3,618,331, unless otherwise stated. “Respondent’s services” means the services identified in Respondent’s U.S. Registration No. 3,618,331, unless otherwise stated.

I. “Petitioner’s Mark” means the COMFORTCLUB mark, used by Petitioner at least as early as 2006, in connection with electrical services, plumbing, and heating and air conditioning services, and later covered by U.S. Application Serial No. 85/880,911. Unless otherwise stated. “Petitioner’s services” means the services identified in Respondent’s U.S. Application Serial No. 85/880,911.

J. The terms “all” and “each” shall be constructed as all and each.

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

Cancel is without merit and unsupported by evidence.

**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.

**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.

**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.

**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.

**REQUEST FOR ADMISSION NO. 40:**

Petitioner's Mark is distinctive.

**REQUEST FOR ADMISSION NO. 41:**

COMFORTCLUB is distinctive as applied to Respondent's services.

**REQUEST FOR ADMISSION NO. 42:**

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

**REQUEST FOR ADMISSION NO. 43:**

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

**REQUEST FOR ADMISSION NO. 44:**

Respondent's Mark should be cancelled.

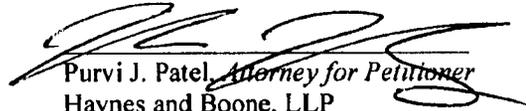
**REQUEST FOR ADMISSION NO. 45:**

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

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

*Petitioner,*

v.

Barnaby Heating & Air

*Respondent.*

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Mark: COMFORT CLUB

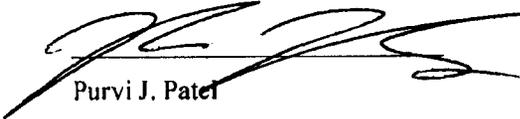
Cancellation No. 92057941

In re Registration No. 3618331

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that on this 4<sup>th</sup> 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

**EXHIBIT 2 TO PATEL  
ALBERS DECLARATION**

---

**From:** Julie Celum Garrigue [mailto:[jcelum@celumlaw.com](mailto:jcelum@celumlaw.com)]  
**Sent:** Monday, June 30, 2014 10:28 AM  
**To:** Julie Celum Garrigue  
**Cc:** Patel, Purvi J.  
**Subject:** Re: Clockwork IP, LLC v. Barnaby Heating & Air, LLC

Purvi,

Also, just to add to that set forth below. I am leaving today for vacation and will be returning, Monday, July 7, 2014. The best way to reach me during this period is via email, as I will be traveling out of the country.

If you are unwilling or unable to grant the requested continuance, I intend on moving for a continuance by operation of accident or mistake not on the part of my client.

Kind regards,

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](mailto:jcelum@celumlaw.com)

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On Jun 30, 2014, at 9:07 AM, Julie Celum Garrigue <[jcelum@celumlaw.com](mailto:jcelum@celumlaw.com)> wrote:

Purvi,

This morning I was handed an envelope containing your June 4, 2014 discovery requests. Through no fault of your client's, or mine, the envelope was delivered to another mailbox holder in my suite.

I will work on providing objections and responses as expeditiously as possible, but I am writing to ask for a July 30th deadline to serve responses?

Please let me know whether your client will agree.

Kind regards,

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](mailto:jcelum@celumlaw.com)

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**EXHIBIT 3 TO PATEL  
ALBERS DECLARATION**

**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

DOMINANCE events, and Senior Tech events refer to periodic events, training seminars, and workshops sponsored and/or held by Petitioner or its affiliates.

D. "Person" is defined as any natural person or any business, legal, or governmental entity or association.

E. "Commerce" signifies commerce that the U.S. Congress may lawfully regulate. The phrase "use in commerce" is defined in Section 45 of the Trademark Act, 15 U.S.C. § 1127, to mean that a mark shall be deemed to be in use in commerce "(1) on goods when – (A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and (B) the goods are sold or transported in commerce, and (2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services."

F. "Date of first use" refers to the date of first use in the United States unless otherwise stated.

G. The term "goods" and the term "services," in the singular or plural form, mean both "goods and services."

H. "Respondent's Mark" means the alleged mark COMFORTCLUB as shown in Respondent's U.S. Registration No. 3,618,331, unless otherwise stated. "Respondent's services" means the services identified in Respondent's U.S. Registration No. 3,618,331, unless otherwise stated.

I. "Petitioner's Mark" means the COMFORTCLUB mark, used by Petitioner at least as early as 2006, in connection with electrical services, plumbing, and heating and air conditioning services, and later covered by U.S. Application Serial No. 85/880,911. Unless otherwise stated. "Petitioner's services" means the services identified in Respondent's U.S. Application Serial No. 85/880,911.

J. The terms "all" and "each" shall be constructed as all and each.

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

Cancel is without merit and unsupported by evidence.

**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.

**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.

**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.

**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.

**REQUEST FOR ADMISSION NO. 40:**

Petitioner's Mark is distinctive.

**REQUEST FOR ADMISSION NO. 41:**

COMFORTCLUB is distinctive as applied to Respondent's services.

**REQUEST FOR ADMISSION NO. 42:**

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

**REQUEST FOR ADMISSION NO. 43:**

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

**REQUEST FOR ADMISSION NO. 44:**

Respondent's Mark should be cancelled.

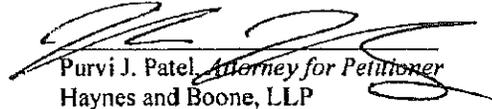
**REQUEST FOR ADMISSION NO. 45:**

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

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*



**EXHIBIT 4 TO PATEL  
ALBERS DECLARATION**

-----Original Message-----

From: jcelum@celumlaw.com [<mailto:jcelum@celumlaw.com>]

Sent: Wednesday, September 10, 2014 11:42 PM

To: Patel, Purvi J.

Subject: Re: ESTTA. Stipulated/Consent Motion. confirmation receipt ID: ESTTA616417

Purvi,

And with all of this, do you pretend not to have received my correspondence relating to our discussions regarding service via email and an extension of the discovery deadline in this case? I have not received a response from you, or your office, regarding my written request, dated August 13, 2014.

Also, your client sent a cease & desist to a third-party on August 8, 2014, requesting they cease use of the COMFORTCLUB mark. Thus, you have kept this information secret for over 1 month, and failed to disclose your client's knowledge about this concurrent use to either my firm, or the Board.

Our position has not changed since you served discovery requests - !!14+ days outside the discovery period!! - and you have not agreed to a reciprocal extension of the discovery deadline.

Do not threaten my client with sanctions, when your client conceals relevant facts and necessary a parties, and my written communications to you and your firm go unanswered. It is you who has procrastinated, failed to disclose relevant evidence and information, and caused further delay.

Your client has misrepresented its date of first use in its initial trademark application and its petition for cancellation. We also have evidence that suggests that the documents you produced to my office last month indicating a date of first use are not authentic.

Furthermore, there is very newly discovered evidence that your client has sent a written communication to a third-party licensee of the COMFORTCLUB mark. Given these new developments and your lack of communication to my written correspondence, we are moving for a continuance of all of the deadlines, and will be filing a motion to join a necessary third-party immediately upon the recording of the assignment.

Julie Celum Garrigue  
214-334-6065

> On Sep 10, 2014, at 6:38 PM, "Patel, Purvi J." <Purvi.Patel@haynesboone.com> wrote:

>

> Correct - the extension I filed and that we agreed to was an extension of all deadlines with the TTAB (chain attached). Discovery had already closed when we had our discussion, but Clockwork's discovery requests were served within the period (as explained previously in our various communications, as well as in detail in my formal correspondence to you earlier today). Your client's obligation to respond to discovery served within the discovery period continued (the close of the discovery period does not obviate that requirement. Moreover, Clockwork consented to a July 15, 2014 extension to Barnaby for purposes of submitting responses and responsive documents. Your July 15th communication/objections were not responsive -- and rather, Barnaby's discovery responses were woefully deficient and your objections were without merit. In your July 18, 2014 email (attached), you indicated that you would

move forward with providing more substantive discovery responses, but we have not received any additional information to date. Now, once again, we are coming upon the pretrial disclosure deadline and we still do not have a single responsive document or response from you. In light of this, absent an additional 30 day extension during which you properly reply to our discovery requests/make documents and things available for our review, Clockwork is left with no choice but to proceed with a Motion to Compel and for Sanctions. As you well know, the TTAB does not view a failure to respond to discovery kindly, and would likely grant sanctions in this case. Since this proceeding does not seem to be moving forward, and Clockwork has tried to amicably resolve this dispute while receiving wholesale refusals from Barnaby, my client is seriously considering whether TTAB intervention or federal court involvement makes more sense at this point.

>

> We will expect to hear from you regarding the extension of deadlines by early Friday AM. We will get started on our Motion in the meantime. I look forward to our Friday afternoon call at 4:30 -- I will call you.

>

> -----Original Message-----

> From: jcelum@celumlaw.com [<mailto:jcelum@celumlaw.com>]

> Sent: Wednesday, September 10, 2014 6:07 PM

> To: Patel, Purvi J.

> Subject: Re: ESTTA. Stipulated/Consent Motion. confirmation receipt

> ID: ESTTA616417

>

> Purvi,

>

> The stipulation you filed only extended pretrial disclosures. It did not extend discovery.

>

> Also, the letter your client sent was dated August 8th. I want to be clear that I did not receive the letter until some time after. Wasn't sure if I made that clear when we spoke moments ago.

>

> Julie Celum Garrigue

> 214-334-6065

>

>

>

>> On Jul 18, 2014, at 11:17 AM, "Patel, Purvi J." <Purvi.Patel@haynesboone.com> wrote:

>>

>> Julie - Here is the 60 Day Stipulated Extension Request as filed with the PTO. I will be sending your service copy by mail, per our agreement in the Discovery Conference. If you prefer to have email service be an option, let me know. I am out of pocket for the rest of the day too, but look forward to discussing next steps next week. Thanks.

>>

>> -----Original Message-----

>> From: estta-server@uspto.gov [<mailto:estta-server@uspto.gov>]

>> Sent: Friday, July 18, 2014 11:15 AM

>> To: Patel, Purvi J.; IPDocketing; jcelum@celumlaw.com

>> Subject: ESTTA. Stipulated/Consent Motion. confirmation receipt ID:

>> ESTTA616417

>>

>> Stipulated/Consent Motion.

>>

>> Tracking No: ESTTA616417

>>

>>

>>

>> ELECTRONIC SYSTEM FOR TRADEMARK TRIALS AND APPEALS Filing Receipt

>>

>> We have received your Stipulated/Consent Motion. submitted through the Trademark Trial and Appeal Board's ESTTA electronic filing system. This is the only receipt which will be sent for this paper. If the Board later determines that your submission is inappropriate and should not have been accepted through ESTTA, you will receive notification and appropriate action will be taken.

>>  
>> Please note:  
>>  
>> Unless your submission fails to meet the minimum legal requirements for filing, the Board will not cancel the filing or refund any fee paid.  
>>  
>> If you have a technical question, comment or concern about your ESTTA submission, call 571-272-8500 during business hours or e-mail at [estta@uspto.gov](mailto:estta@uspto.gov).  
>>  
>> The status of any Board proceeding may be checked using TTABVUE which is available at <http://ttabvue.uspto.gov>. Complete information on Board proceedings is not available through the TESS or TARR databases. Please allow a minimum of 2 business days for TTABVUE to be updated with information on your submission.  
>>  
>> The Board will consider and take appropriate action on your filing in due course.  
>>  
>> Printable version of your request is attached to this e-mail  
>>  
>>  
>> -----  
>> ESTTA server at <http://estta.uspto.gov>  
>>  
>>  
>> ESTTA Tracking number: ESTTA616417  
>> Filing date: 07/18/2014  
>>  
>> IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK  
>> TRIAL AND APPEAL BOARD  
>>  
>> Proceeding : 92057941  
>> Applicant : Clockwork IP, LLC  
>> Other Party:Defendant  
>> Barnaby Heating & Air  
>>  
>>  
>> Motion for an Extension of Answer or Discovery or Trial Periods With  
>> Consent  
>>  
>> The Close of Plaintiff's Trial Period is currently set to close on 09/02/2014. Clockwork IP, LLC requests that such date be extended for 60 days, or until 11/01/2014, and that all subsequent dates be reset accordingly.  
>> Time to Answer :CLOSED  
>> Deadline for Discovery Conference :CLOSED Discovery Opens :CLOSED  
>> Initial Disclosures Due :CLOSED Expert Disclosure Due :CLOSED  
>> Discovery Closes :CLOSED Plaintiff's Pretrial Disclosures :09/17/2014  
>> Plaintiff's 30-day Trial Period Ends :11/01/2014 Defendant's Pretrial  
>> Disclosures :11/16/2014 Defendant's 30-day Trial Period Ends  
>> :12/31/2014 Plaintiff's Rebuttal Disclosures :01/15/2015 Plaintiff's  
>> 15-day Rebuttal Period Ends :02/14/2015  
>>  
>>  
>> The grounds for this request are as follows:  
>> Parties are unable to complete discovery/testimony during assigned  
>> period Parties are engaged in settlement discussions  
>>  
>> Clockwork IP, LLC has secured the express consent of all parties to this proceeding for the extension and resetting of dates requested herein.  
>> Clockwork IP, LLC has provided an e-mail address herewith for itself and for the opposing party so that any order on this motion may be issued electronically by the Board.  
>>

>> Certificate of Service

>>

>> The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address of record by First Class Mail on this date.

>>

>> Respectfully submitted,

>> /Purvi J. Patel/

>> Purvi J. Patel

>> patelp@haynesboone.com, ipdocketing@haynesboone.com

>> jcelum@celumlaw.com

>> 07/18/2014

>>

>>

>>

>>

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>> confidential, may be privileged and should be read or retained only  
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>> error, please immediately notify the sender and delete it from your system.

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> <mime-attachment>

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