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

Proceeding	92058411
Party	Plaintiff Luxco, Inc.
Correspondence Address	MICHAEL R ANNIS HUSCH BLACKWELL LLP 190 CARONDELET PLAZA, STE 600 ST LOUIS, MO 63105 UNITED STATES mike.annis@huschblackwell.com, andy.gilfoil@huschblackwell.com, alan.nemes@huschblackwell.com
Submission	Motion to Compel Discovery
Filer's Name	Andrew R. Gilfoil
Filer's e-mail	andy.gilfoil@huschblackwell.com, mike.annis@huschblackwell.com, alan.nemes@huschblackwell.com
Signature	/s/ Andrew R. Gilfoil
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

LUXCO, INC.,)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92058411
)	
OPICI IP HOLDINGS, LLC)	
)	
Registrant.)	

MOTION TO COMPEL

Petitioner Luxco, Inc. (“Luxco” or “Opposer”), by and through its undersigned counsel and pursuant to 37 C.F.R. § 2.120 and TBMP § 523.01, hereby moves the Board to issue an Order compelling Registrant Opici IP Holdings, LLC (“Registrant” or “Opici”) to: (1) produce all documents responsive to Luxco’s enumerated Requests for Production of Documents, and (2) fully and completely respond without objection to Luxco’s Interrogatories.¹ In support of this Motion, Luxco states as follows:

INTRODUCTION

Luxco seeks, and Opici has repeatedly refused to provide, information and documents that are plainly relevant to this cancellation proceeding. As detailed more fully below, Opici has failed to abide by its discovery obligations, has offered improper and unsupportable objections, and has

¹ As discussed more fully below, in a good-faith effort to resolve Opici’s untimely concerns regarding Luxco’s interrogatories without needing to belabor the Board with this issue Luxco previously offered to provide Opici with a revised set of interrogatories, as specifically recommended in TBMP §405.03(e). After multiple requests asking whether Opici would voluntarily agree to same or would continue to suggest that any revised interrogatories purportedly violate the Board’s 75 interrogatory limit, (*see* Exs. K, p. 1, Ex. L, p. 1, Ex. O, p. 1 and Ex. P, p. 1) Opici has now finally confirmed that it will refuse to substantively respond. (*See* Ex. P, at p. 1.) Luxco perceives that at the very least this issue could be easily resolved expeditiously by way of telephonic conference with the interlocutory attorney pursuant to 37 C.F.R. §2.120(i)(1).

attempted at every juncture to obfuscate Luxco's efforts to obtain discovery relating to factual assertions that Opici itself has alleged in this proceeding.

In response, Opici stands on its claim that it can hide responsive facts and documents behind an alleged "privilege," and that it somehow need not respond to requests to identify facts and produce documents that it relied on to support its prior counterclaims simply because the Board later found them factually deficient. Opici's request is tantamount to a request that the Board endorse a party's efforts to file factually deficient counterclaims, refuse to respond to discovery propounded as to the very same allegations, and then cut-off all further efforts to obtain discoverable information regarding the same issues. Opici's assertions must fail, however, because it is axiomatic that a litigant cannot use alleged "privileged" material as both a sword and a shield. The Board should refuse Opici's improvident request.

FACTUAL BACKGROUND

1. Luxco filed its Petition to Cancel in this matter over eight months ago, on December 10, 2013, asserting a likelihood of consumer confusion between Luxco's REBEL Marks and Opici's registered mark REBELLION when used on legally identical goods. (*See* Petition [Dkt. 1].)

2. In response, Opici answered and filed three denominated counterclaims, alleging therein that Luxco's REBEL Marks should be cancelled because of purported "naked licensing" and Luxco's "failure to police" its REBEL Marks. (*See* Counterclaims [Dkt. 4], p. 4.)

3. Discovery first opened over five months ago, on February 28, 2014. *See* Order [Dkt. 2], at p. 2. When Opici filed its counterclaims that discovery date was reset to April 27. *See* Order [Dkt. 5], at p.1.

4. On April 29, 2014, Luxco served Opici with Interrogatories and Requests for Production of Documents. (*See* Exs. A and B attached hereto.) Therein, Luxco asked Opici, among

other things, to state all facts that it relied on to support its various counterclaim contentions (Ex. A, at Interrogatory Nos. 23-28) and to produce any documents that Opici relied on to support its various conclusory abandonment/“naked licensing” contentions (*See* Ex. B, at Request Nos. 32-38.)

5. Thereafter, Opici’s counsel requested a thirty (30) day extension until July 2, 2014 to respond to Luxco’s discovery requests, which Luxco provided. (*See* May 29-30 e-mail correspondence between S. Baker and A. Gilfoil, attached hereto as Ex. C—“we look forward to receipt of Opici’s substantive responses and document production on or before July 2, 2014.”)

6. When Opici provided its responses on July 2, it instead lodged various objections and claimed that any information or documents relied on to support Opici’s counterclaim contentions were purportedly “subject to the attorney-client privilege and/or the attorney work product privilege.” *See* Registrant’s response to Luxco’s Interrogatories, Ex. D attached hereto, at pp. 11-13. Importantly, in response to Luxco’s interrogatories Opici raised no claim or objection asserting that Luxco’s interrogatories purportedly violated the Board’s 75 interrogatory limit. *See* Ex. D and 37 C.F.R. §2.120(d)(1)(stating that to preserve claim party “shall, within the time for (and instead of) serving answers and specific objections . . . serve a general objection on the ground of their excessive number”).

7. Opici similarly refused to produce any documents that it relied on to support its various counterclaim contentions, asserting that “[a]ny such documents would be subject to the attorney-client privilege and/or attorney-work product privilege.” *See* Registrant’s Responses to Luxco’s First Production Requests, Ex. E attached hereto, at pp. 14-16.

8. Opici in fact failed to produce a single document, stating instead that relevant “representative, non-duplicative, non-privileged documents will be made available for inspection and copying where the documents are kept or as otherwise mutually agreed by the parties, and at a mutually agreed date and time.” *See* Ex. E.

9. On July 8, 2014, Luxco served Opici's counsel with correspondence highlighting various deficiencies in Opici's discovery responses and asking that counsel provide availability to meet and confer regarding these issues. (See July 8, 2014 golden-rule correspondence to S. Baker, attached hereto as Ex. F.)

10. On July 14 Luxco also confirmed that it was agreeable to mutual exchange of documents. (See Ex. G, p. 1-2.)

11. In follow-up correspondence Opici indicated that it would be available to meet and confer after counsel had prepared a written response, and that Opici was "more than prepared" to meet its discovery obligations. (See July 15, 2014, e-mail from S. Baker, attached hereto as Ex. G.)

12. Opici provided its subsequent response on July 23, 2014, stating therein that Opici would produce copies of responsive documents directly "if Petitioner will agree and stipulate to producing Petitioner's documents directly to our office." (See July 23, 2014, letter from J. Rannells, attached as Ex. H, at p. 10.) By e-mail correspondence the same day Luxco again confirmed that it was agreeable to producing responsive documents directly to counsel. (See July 23, 2014, e-mail correspondence from A. Gilfoil to J. Rannells, attached as Ex. I.)

13. On July 29, 2014, the Board entered its order granting Luxco's motion, dismissing Opici's counterclaims without prejudice and striking Opici's fourth affirmative defense. (See Order [Dkt. 12], p. 7-8.) The Board went on to allow Opici thirty (30) days leave to submit amended counterclaims "if possible, justified and appropriate." (See Order [Dkt. 12], p. 7-8.)

14. On July 31, 2014, counsel for Luxco and Opici spoke telephonically in an effort to meet and confer regarding these issues. For the first time Opici claimed that Luxco's First set of twenty-eight (28) enumerated Interrogatories contained an alleged 100 interrogatory sub-parts and that, as a result, Opici refused to provide a response to any revised interrogatories. (See July 31-Aug. 1 e-mail correspondence between A. Gilfoil and J. Rannells, Ex. J, at p. 9-10.) Opici further

stated that documents would be produced within the next week and that a privilege log would be forthcoming. (*Id.*)

15. Luxco sent follow-up email correspondence on August 12, noting Opici's failure to produce any responsive documents or a privilege log, and requesting that Opici provide a date certain when Luxco could expect same. (*Id.* at p. 3.)

16. In subsequent correspondence Opici stated that it expected to serve responsive documents "shortly." (*Id.* at p. 6.)

17. Subsequent thereto, the parties undertook lengthy correspondence regarding Opici's contention that Luxco had already served in excess of 75 interrogatories and Luxco's contention that Opici had waived the issue by first raising it during the parties meet and confer call. (*Id.* at pp. 4-5.) Luxco sent correspondence on August 13 and 18 requesting that the parties arrange for a telephonic conference with the interlocutory attorney in order to address this issue. (*Id.* at p. 4.) In response, Opici stated that it did "not believe that the correct procedure to resolve the interrogatory count issue is via telephonic conference with the interlocutory attorney." (*Id.* at p. 4.) Finally, in that August 18 e-mail Luxco again noted that Opici had still not provided any documents, and again requested that Opici provide a date when it would do so. (*Id.*)

18. Luxco again sent follow-up correspondence on August 21 and 26 asking that Opici confirm that it was not withholding information and that it would be providing responsive documents and a privilege log on or before August 28. (*Id.* at p. 1-2.)

19. When no documents or privilege log were received by August 28, Luxco sent further correspondence stating that Luxco needed to receive Opici's responsive documents and privilege log by September 1 in light of the schedule entered by the Board. (*See* August 29, 2014, e-mail correspondence from A. Gilfoil to J. Rannells, Ex. K, at pp. 1-2.) In addition, Luxco proposed in the interest of compromise that Opici voluntarily agree to a revised set of interrogatories instead of

wasting the Board's attention resolving this dispute, as specifically recommended by TBMP §405.03(e). (*Id.* at p. 2.)

20. On September 3, Opici finally served Luxco with its privilege log and documents in response to Luxco's prior April 29 production requests. (*See* Sept. 3 e-mail from J. Rannells to A. Gilfoil, Ex. J attached hereto.) Opici provided no response to Luxco's request regarding revised Interrogatories. (*Id.*)

21. Having received no response, Luxco sent follow-up correspondence to Opici's counsel on September 5 again asking that Opici advise regarding Luxco's interrogatory proposal and further addressing additional issues regarding the insufficiency of Opici's privilege log and document production. (*See* Sept. 5, 2014 e-mail from A. Gilfoil to J. Rannells, attached hereto as Ex. K., at p. 1).

22. On September 8 Opici provided e-mail correspondence that largely restates prior e-mail correspondence, still fails to provide a privilege log that could enable Luxco to assess Opici's claims of "privilege", and further failed to provide a simple answer regarding whether Opici would or would not agree the service of revised interrogatories. (*See* Sept. 8 e-mail correspondence from J. Rannells, attached hereto as Ex. M.) Luxco again requested confirmation from Opici regarding this proposal. (*See* Sept. 15 e-mail from A. Gilfoil to J. Rannells, attached hereto as Ex. O).

23. In response, Opici has now finally confirmed that it would not agree to the proposed compromise but would instead make a blanket objection to any further interrogatories "on the basis of the 75 limit rule." (*See* Sept. 15, 2014 e-mail correspondence attached hereto as Ex. P.)

ARGUMENT AND AUTHORITIES

I. LUXCO'S MOTION TO COMPEL SHOULD BE GRANTED

A motion to compel is available and appropriate where a party to an inter partes proceeding

fails to provide interrogatory responses or document production. 37 C.F.R. §2.120(e); TBMP §523.01. Such a motion is timely if filed prior to the commencement of the first testimony period. 37 C.F.R. §2.120(e)(1); TBMP §523.03. Luxco has timely filed this Motion well in advance of the opening of the testimony periods, and indeed months prior to when discovery is set to close. (*See* Order [Dkt. 14], at p. 4.) Luxco has made multiple good-faith attempts to meet and confer with Opici pursuant to 37 C.F.R. §2.120(e)(1) regarding these issues.

To that end, Luxco has previously agreed to provide Opici with revised interrogatories to resolve Opici's untimely super-numerosity concerns. However, it appears that Opici has no other goal than to delay and to frustrate Luxco's efforts to obtain discoverable information or to have adequate time to undertake any necessary follow-up discovery. *Johnston Pump/Gen. Valve Inc. v. Chromalloy American Corp.*, 13 U.S.P.Q.2d 1719, 1721 n. 4 (TTAB 1989)(Board does not tolerate "game playing" or evasiveness in discovery and uncooperative conduct by counsel). In order to preserve its right to receive proper discovery in this cancellation proceeding Luxco has no choice but to move to compel Opici to provide supplemental responses and production after informal attempts to resolve these discovery issues between the parties have in large part failed.

A. Opici Has Failed to Answer Many of Luxco's Interrogatories Without Lodging Improper Objections

As noted above, when Opici previously served its responses to Luxco's Interrogatories on July 2 Opici raised no claim that the same purportedly violated Rule 2.120(d)(1). (*See* Ex. D.) Indeed, Opici also made no such assertion even in its later July 23 response to Luxco's golden rule letter. (*See* Ex. H.) Instead, during the parties' subsequent attempt to meet and confer telephonically regarding these issues Opici, for the first time, claimed that Luxco's twenty eight (28) enumerated interrogatories were allegedly "100 interrogatories" and that as a result Opici would not provide substantive responses to any revised interrogatories. (*See* Ex. J, at p. 9.)

The Board's rules explicitly require that to preserve an objection regarding the number of

alleged interrogatory sub-parts a party “**shall**, within the time for (**and instead of**) serving answers and specific objections to the interrogatories, serve a general objection on the ground of their excessive number.” 37 C.F.R. §2.120(d)(1)(emphasis added). Opici plainly did not do so here and has failed to preserve its claim. Opici’s suggestion that this rule “applies to any further interrogatories, revised or otherwise” is unfounded and untimely, and Opici’s adamant refusal to provide any response to revised interrogatories other than with a “general objection” is improper. (Ex. J, at p. 2-3.)

In a good-faith attempt to resolve this issue voluntarily between the parties without burdening the Board Luxco has repeatedly asked that Opici agree to the service of a revised set of interrogatories—as the Board’s rules strongly recommend the parties do. *See* TBMP §405.03(e) and Ex. K at p. 1, Ex. L, at p. 1, Ex. O, at p. 1. After multiple requests asking whether Opici will agree to same, (*see* Exs. K, p. 1, Ex. L, p. 1, Ex. O, p. 1 and Ex. P, p. 1.) Opici has now finally confirmed that it will refuse to substantively respond. (*See* Ex. P, at p. 1.) Luxco perceives that this issue could be easily addressed expeditiously by way of telephonic conference with the interlocutory attorney and asks that such telephonic conference be arranged at a time that is mutually agreeable for Opici and the interlocutory attorney. *See* 37 C.F.R. §2.120(i)(1).

Substantively, Opici has refused to provide adequate responses to a number of Luxco’s interrogatories directly related to the parties’ claims and defenses in this proceeding. Opici’s improper objections to these interrogatories provide no justifiable basis for withholding discoverable information responsive to these interrogatories. As summarized in detail below, Opici’s objections are improper and should be overruled.

- **Interrogatory Nos. 23-28:** Opici’s continued refusal to provide any information whatsoever in response to the referenced interrogatories is wholly inappropriate. In this regard, Opici continues to maintain that it need not provide any response because any “facts” are purportedly subject to the attorney-client privilege and/or the attorney work product

privilege. It is well settled, however, that the law does not permit a party to use the work product doctrine to hide the facts themselves, which is particularly germane here where many of the requests simply ask Opici to “state all facts” that it relied on to support its various abandonment, failure to police and “naked licensing” contentions in this matter. *See In re Rock & Republic Enterprises, Inc.*, 2010 WL 413572, *3 (Bank. S.D.N.Y. 2010)(“the attorney-client privilege cannot be used to shield from discovery facts, as opposed to communications”); *Ortiz v. H.L.H. Products Co.*, 39 F.R.D. 41, 44-45 (D.Del. 1965)(court should refuse to permit attorney “to use such privilege as a curtain behind which he can hide factual data which should in all fairness be available to both parties”). To hold otherwise “would inappropriately immunize the parties and permit them to hide relevant non-privileged facts” which is a “concept contrary to the vitality of the adversary system.” *In re HealthSouth Corp. v. Securities Litig.*, 250 F.R.D. 8, 12 (D. D.C. 2008).

- **Interrogatory Nos. 23, 24 and 28.** In addition to lodging improper privilege objections, Opici also objects to the referenced interrogatories on the grounds that they are purportedly “overly broad and unduly burdensome.” (*See Ex. D*, at pp. 11-13.) Opici offers no factual basis to support its broad unsubstantiated boiler plate objections and thus fails to satisfy its burden here of explaining how each request is purportedly unduly burdensome. The Board should order that Opici withdraw its improper objections and provide full and complete responses to these requests for basic discoverable information.

In sum, identification of the basic factual information requested in these interrogatories does not invade any privilege. Equity and Opici’s Rule 11 obligations cannot provide Opici with the power to allege claims and assertions, refuse to answer discovery directed to those very assertions, then refuse to provide the very information and documents relied on merely because the Board later held that Opici’s counterclaims were factually deficient. As “privilege” cannot be used as a sword and a shield the Board should overrule Opici’s improper objections, order that Opici provide complete responses to these interrogatories without objection, or alternatively that it be precluded from relying on any information withheld. *See Fed. R. Civ. P. 37(c)*.

B. Opici’s Has Failed to Produce Documents Responsive to Luxco’s Production Requests

As above, Opici has equally failed to fully respond to a series of Luxco’s Production Requests without objection where the documents requested are directly relevant to this proceeding—particularly Opici’s claim that Luxco is barred because of alleged failure to challenge the use of other “Rebel” or “Rebellion” marks. Luxco summarizes Opici’s deficient responses

below.

- **First Request for Production Nos. 6, 32, 33-35 and 38:** As done in response to related interrogatories Opici again objects to producing documents based on its contention that the documents are protected by the “attorney-client privilege” or “attorney-work product privilege.” (*See* Ex. E.) However, Opici’s privilege log fails to identify even a single document that it characterizes as so-called “attorney work product.” (*See* Ex. M, at pp. 12-17.) The Board should order that Opici produce all responsive non-privileged documents to these requests, and further provide a supplemental privilege log that adequately describes the nature of any documents, communications or tangible things which Opici contends to be “privileged” in a manner that actually allows Luxco to assess the veracity of Opici’s claims. *See* Fed. R. Civ. P. 26(e)(5).
- **First Request for Production Nos. 7, 10, 12-13 and 31:** For a variety of Luxco’s other document requests, Opici’s production is wholly insufficient and incomplete. For instance, Opici fails to produce any product sample or examples of tags and labels used in conjunction with the sale of REBELLION-branded products (Nos. 12-13). Opici also fails to produce any documents relating to many of the categories of documents identified in its initial disclosures (Request No. 31), including documents relating to alleged:
 - Internet materials concerning third party uses of the term REBEL and variations thereof;
 - USPTO records of third party applications and registrations that include the term REBEL or variations thereof;
 - TTB Cola Label approvals concerning labels bearing the term REBEL or variations thereof;
 - Materials concerning the Whiskey Rebellion; and
 - Dictionary definitions of and other reference materials concerning the meaning and/or commercial impression of the terms REBEL and REBELLION.

(*See* Opici’s Initial Disclosures, a copy of which is attached hereto as Ex. N, at p. 3.)

It is perplexing why Opici fails to any produce any responsive documents for the above categories when it states in initial disclosures that the same are within Opici’s “possession, custody or control.” (Ex. N, at p. 3; Ex. E, at p. 14.) Finally, in response to Luxco’s request for those documents relating to the development/adoption of the REBELLION Mark (Request No. 7), Opici has selectively produced only a single e-mail and a one page depiction of a REBELLION bourbon

bottle. (*See* Ex. Q².) The Board should order that Opici produce all responsive documents to these discoverable inquiries without improper objection.

Simply stated, Opici has provided no factual basis for its invocation of “privilege” or for its insufficient document production. As “privilege” cannot be used as a sword and a shield the Board should overrule Opici’s improper objections, order that Opici provide complete supplemental production fully complying with Opici’s discovery obligations, or alternatively hold that Opici will be precluded from relying on any information or documents that it has withheld. *See* Fed. R. Civ. P. 37(c).

C. Opici Fails to Provide a Privilege Log That Complies With FRCP 26

Finally, Opici refuses to provide a privilege log that satisfies Opici’s duty under the Federal Rules of Civil Procedure. (*See* Ex. K, at pp. 3-6 and Ex. M, at pp. 12-17.) In this regard, Opici’s log does not provide information that would enable Luxco to determine whether the communications at issue actually involved a request for legal advice or, instead, were the mere transmission of publicly-available documents or other non-privileged communications involving, inter alia, business advice. *See A&R Body Specialty and Collision Works, Inc. v. Progressive Cas. Ins. Co.*, 2014 WL 657688, *2 (D.Conn. 2014)(ordering production where party did not meet its burden of establishing the privilege); *Integrated Global Concepts, Inc. v. j2 Global, Inc.*, 2014 WL 232211, *1 (N.D. Cal. 2014)(identifying how party claiming privilege bears burden of demonstrating that the communication “sought legal advice”). The Board should order that Opici provide a complete privilege log required under Federal Rule 26 describing the nature of the documents, communications or tangible things that contends to be privileged in a manner that allows Luxco to assess whether the communication at issue is indeed privileged. *See* Fed. R. Civ. P. 26(b)(5); *Red Wing Co. v. J.M. Smucker Co.*, 59 U.S.P.Q.2d 1861, 1864 n. 5 (TTAB 2001); *see also* *Murphy v.*

² The redacted pages of Opici’s production, which are marked as CONFIDENTIAL, have been filed concurrently herewith under seal pursuant to 37 C.F.R. §2.126(d).

CERTIFICATE OF SERVICE

The undersigned counsel hereby certifies that a copy of the foregoing was served via e-mail and First Class Mail, postage prepaid, as well as electronic mail on this 17th day of September, 2014 upon:

Stephen L. Baker
Baker & Rannells P.A.
575 Route 28, Suite 102
Raritan, NJ 08869
baker@tmlaw.com

/s/ Andrew R. Gilfoil