ESTTA Tracking number: **ESTTA635087**
Filing date: **10/24/2014**

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

Proceeding	92058411
Party	Defendant Opici IP Holdings, LLC
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Submission	Motion to Strike
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Signature	/John Rannells/
Date	10/24/2014
Attachments	Motion to Strike Reply Brief.pdf(114738 bytes)

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

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

REGISTRANT'S MOTION TO STRIKE PETITIONER'S REPLY BRIEF OR ALTERNATIVELY PERMIT REGISTRANT TO RESPOND TO ISSUES RAISED FOR THE FIRST TIME IN PETITIONER'S REPLY BRIEF AND TO CERTAIN INNACURATE AND MISLEADING ASSERTIONS MADE THEREIN

Registrant, Opici IP Holdings, LLC (hereinafter "Opici") hereby moves to strike Petitioner's Reply Brief on the grounds that:

1) It raises a new issue and request for relief not raised in Petitioner's motion to compel (i.e., Petitioner's frivolous assertion that Opici has raised an "advice of counsel defense" and thereby waived the attorney-client privilege);

2) Petitioner's assertions concerning its Interrogatory No. 19 are raised for the first time in its Response Brief; and

3) Petitioner's Assertions at Page 2 of its Response Brief are so misleading they should be stricken.

Alternatively, in fairness, Opici should be permitted to respond to each of the above issues.

A. Petitioner Has Raised a Frivolous Argument Not Briefed in its Motion to Compel – Justice Demands That the Argument be Stricken Or that Opici be Permitted to Respond

Almost the entirely of Petitioner's argument in its Reply Brief is dedicated to its new assertion that Opici has somehow raised an "advice of counsel defense" and has thereby waived the attorney-client privilege.[1] The argument is raised by Petitioner for the first time in its reply brief. Given that the rules do not provide for a sur-response by Opici, Opici is placed at an unfair advantage, especially given the frivolous nature of Petitioner's assertion. Accordingly, it is only fair that the argument be stricken or that Opici be permitted to respond. In the event Petitioner's argument is given any consideration by the Board, Opici responds as follows.

The only use of the phrase "advice of counsel" in any of Opici's discovery responses appears in Opici's identical Amended responses to Petitioner's Interrogatory Nos. 23, 24 and 28,[2] which interrogatories concern Opici's now stricken counterclaims and which request Opici to "[s]tate all facts that [Opici] relied on to support [its] contention in paragraph" 26 and 27 "of [Opici's] Counterclaims" (re: naked licensing and failure to police), and to "[s]tate all facts that you relied on to support your contention that Luxco's Petition for Cancellation is barred by reason of Luxco's failure to challenge the use of Rebel and/or Rebellion marks on related goods and services by unrelated third parties, as stated in Registrant's fourth affirmative defense."

In each instance, Opici responded:

AMENDED ANSWER:

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[1] The argument is raised by Petitioner on pp. 1, 3, 4, 5, 6, 8, and 9 of its 9 page response brief.

[2] On page 4 of its reply brief, Petitioner states: "Opici similarly testifies that it received a search report from counsel on July 20, 2010 yet refuses to produce the report and opinion despite asserting reliance on the advice of counsel in this matter." *Citing to it motion*, Ex. D p 7 and to Opici's response, Ex. 9. The statement is untrue. Opici has never used the phrase "advice of counsel" in association with said search report and Opici has never asserted an "advice of counsel defense" as regards the search report or as regards any other matter. The assertion made by Petitioner is made up out of thin air for the apparent sole purpose of clothing its frivolous argument with some element of substance.

> Registrant relied upon the advice of counsel. Counsel conducted an informal search of USPTO database records, TTB database records, and a general Google Internet search all of which revealed numerous third party uses, registrations, applications and label approvals for alcoholic beverages under the term REBEL and variations thereof. The results were not downloaded or saved in any way. Counsel also conducted a search of TTAB database records concerning Petitioner and Petitioner's litigation efforts (or non-efforts as the case may be) before the TTAB. The results were not downloaded or saved in any way.

Opici's response was a factual response to the three questions posed.

Regardless, the "advice of counsel defense" in patent and trademark cases is a defense in federal court to a claim of "willful infringement" or "bad faith" and the attendant enhanced damages and/or attorney fees that may be awarded in a federal trademark infringement action. *See*, the very decision cited by Petitioner (and cases cited therein), *Teal Bay Alliances, Inc. v. Southbound One, Inc.*, 2014 U.S. Dist. LEXIS 55378 (D. Md. Apr. 21, 2014). The defense is simply inapplicable to the present proceeding and was never raised by Opici.

This is a TTAB proceeding, not a federal district court action for trademark infringement. The TTAB has no authority to award enhanced damages or attorney fees. The Petitioner has not alleged willful infringement or bad faith on the part of Opici in the Petition for Cancellation, and Opici has not raised an "advice of counsel defense," there being no claim of willful infringement or bad faith to defend. The Petitioner either does not understand the defense and its applicability or has inserted its argument frivolously. The same should be stricken.

B. Petitioner's Assertions Regarding its Interrogatory No. 19 Are Raised for the First Time in its Response Brief and Should be Stricken, or Opici should be Permitted to Respond

In its Response brief, Petitioner argues that "there is plainly a concrete dispute between the parties relative to [Petitioner's] efforts to obtain a substantive response from Opici to Interrogatory No. 19."

Yet, there is not a single reference to interrogatory No. 19 in Petitioner's motion to compel. It simply was not raised as a deficiency in Petitioner's motion. Given that the rules do not provide for a sur-response by Opici, Opici is placed at an unfair advantage. Accordingly, it is only fair that the references (see pp. 7-8 Petitioner's Response brief) be stricken or that Opici be permitted to respond. In the event Petitioner's argument is given any consideration by the Board, Opici responds as follows.

Interrogatory 19 asks Opici to state whether it is "aware of any unauthorized third-party use of Petitioner's Marks, or any other trademark containing the term "REBEL" . . ." Opici objected to the interrogatory on the basis that it is vague and ambiguous regarding the meaning of "unauthorized third-party use" and advised that a meaningful response cannot be framed unless Petitioner first informs Opici of the identity of its "authorized" uses as such knowledge is solely within Petitioner's knowledge.

On July 31st, the attorneys had a telephonic meet and confer on discovery issues. It was agreed that Opici would endeavor to respond to interrogatory 19 upon receipt from Petitioner of a list of entities who are authorized by Petitioner to use the REBEL mark. In fact, Petitioner's attorney affirmed the same via email the same day (*see* email from Gilfoil to Baker et al 7-31-14 12:03 pm – Ex. J to Motion to compel, pp. 9-10 of the exhibit). On August 13, 2014, Petitioner inquired as to whether Opici would be agreeable to Petitioner providing a revised version of Interrogatory 19 which was declined and Petitioner was reminded of the agreement regarding Petitioner's list of authorized entities. *See also* email from Rannells to Gilfoil 8-14-14 at Ex. J to Motion to compel, pp. 4-5 of the exhibit (reminder to Petitioner regarding the list). On August 18th, Opici's attorney again reminded Petitioner that Opici had not yet received the agreed-to

list. Then on August 21, 2014, rather than send the agreed-to list, Petitioner wrote via email "My proposed revision to Interrogatory No. 19 is set forth below."

The undersigned must apologize. There did not seem to be any "proposed revision." There is nothing in the body of Petitioner's email and no attachment. What the undersigned has now figured out is that Petitioner's attorney went in and changed the language to the interrogatory that was quoted in the body of Opici's prior email. Opici's email, as changed by Petitioner, appears as part of the email chain comprising Petitioner's Ex. J to its motion for summary judgment. Opici's actual email to Petitioner is attached hereto as Ex. 1.[3] The undersigned simply did not realize that its own email had been changed by Petitioner in the email chain between the parties. In any event, as per the parties' prior agreement, Opici has always been willing to respond to the interrogatory upon receipt of the list of authorized entities from Petitioner. Further, on two occasions,[4] Opici advised Petitioner's attorney that Opici was aware of "the Rebel Spirits Group LLC," which is responsive to the interrogatory.

C. *Petitioner's Assertions at Page 2 of its Response Brief Are so Misleading that Opici should be Permitted to Address the Same*

On page 2 of its Response brief, Petitioner refers to its Requests to Produce Nos. 32-35 and 38 as being general requests concerning third party uses of REBEL and rebel variation trademarks and uses this misleading impression to state that the numerous third-party label approvals and trademark registrations for REBEL and variations that were attached to Opici's Requests for Admissions to Petitioner should have been produced in response to Requests to Produce Nos. 32-35 and 38.

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[3] Petitioner changed the wording of the interrogatory from "aware of any unauthorized third-party use of Petitioner's Mark, or any other trademark containing the term REBEL" to "aware of any third-party use of any trademark containing the term REBEL."

[4] i.e., in Opici's Amended Response to RFA No. 22 (on 8-1-14) and via email on 9-8-14.

The Requests to Produce ask for documents that Opici relied on to support its counterclaims (i.e., abandonment (Req. 32), naked licensing (Req. 33), failure to police (Req. 34 and 35), and failure to challenge third-party uses (Req. 38)). In response to the parallel interrogatories (i.e., Rogs 23, 24 and 28), Opici advised Petitioner that:

> Counsel conducted an informal search of USPTO database records, TTB database records, and a general Google Internet search all of which revealed numerous third party uses, registrations, applications and label approvals for alcoholic beverages under the term REBEL and variations thereof. The results were not downloaded or saved in any way. Counsel also conducted a search of TTAB database records concerning Petitioner and Petitioner's litigation efforts (or non-efforts as the case may be) before the TTAB. The results were not downloaded or saved in any way.

Accordingly, there are no label approval or trademark registration documents responsive to the Document requests as posed by Petitioner. The documents attached to Opici's requests for admissions were generated long after the counterclaim was filed.

Petitioner should not be allowed to simply make up facts and clothe the same with argument.

CONCLUSION

For the foregoing reasons, Petitioner's Reply Brief should be stricken. In the alternative and in the event the Board gives Petitioner's arguments any consideration, Opici should be permitted to respond as set forth above.

Respectfully submitted

Baker and Rannells PA

John M. Rannells
BAKER AND RANNELLS PA
Attorneys for Registrant,
Opici IP Holdings, LLC

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing MOTION TO STRIKE PETITIONER'S REPLY BRIEF OR ALTERNATIVELY PERMIT REGISTRANT TO RESPOND TO ISSUES RAISED FOR THE FIRST TIME IN PETITIONER'S REPLY BRIEF AND TO CERTAIN INNACURATE AND MISLEADING ASSERTIONS MADE THEREIN has been served on Petitioner by first class mail this 24TH day of October 2014:

Andrew R. Gilfoil, Esq.
HUSCH BLACKWELL LLP
190 Carondelet Plaza, Suite 600
St. Louis, MO 63108

John M. Rannells

EXHIBIT 1

J. Rannells

From: J. Rannells
Sent: Monday, August 18, 2014 7:01 PM
To: 'Gilfoil, Andy'; Steve Baker
Cc: K. Hnasko; Annis, Michael; Nemes, Alan; Smith, Celeste
Subject: RE: Luxco v Opici 92058411

Andy:

I think there is a misunderstanding or two. This seems like much ado about nothing.

1. The cases you cite are no longer precedent and no longer practice and/or procedure in Board cases.

2. Yes, in the spirit of cooperation, we responded to your first set of interrogatories notwithstanding their excessive amount. The only present issue regarding the 75 Rule applies to any further interrogatories, revised or otherwise. It is to put you on notice now that if you serve us with additional interrogatories or alleged revised interrogatories, we will make a general objection based upon the 75 Rule limit. We have no obligation to seek a protective order.

3. I simply do not understand what you are saying regarding Interrogatory #19. It was agreed to that we would endeavor to provide a response to the interrogatory upon receipt from you of a list of entities who are authorized by Luxco. I am not even sure why or how you want to revise the interrogatory. It states:

> 19. State whether you are aware of any unauthorized third-party use of Petitioner's Marks, or any other trademark containing the term "REBEL," in conjunction with the offer or sale of any distilled spirits If so, identify:
> a) All identifying information about the party or parties using such mark;
> b) The dates of such use; and
> c) The geographic area(s) of such use; and
> d) All persons with knowledge and all documents relating to or relating to any such use.

Please state what it is you wish to revise.

4. Finally, I never said that I objected to a telephonic conference. I said that it was not the proper procedure to deal with a 75 interrogatory rule matter. It also seems premature to me, as we have not been served with additional interrogatories.

Best regards,

John "Jack" M. Rannells

Baker and Rannells, PA

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