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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.
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Date	11/13/2014
Attachments	Opp. to MTS.PDF(410584 bytes)

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

LUXCO, INC.,)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92/058,411
)	
OPICI IP HOLDINGS, LLC)	
)	
Registrant.)	

LUXCO’S OPPOSITION TO OPICI’S MOTION TO STRIKE

Opposer Luxco, Inc. (“Luxco”), by and through its undersigned attorneys and pursuant to 37 C.F.R. §2.127(a) and TBMP §506, submits the following brief in opposition to Opici’s Motion to Strike, filed October 24, 2014 [Dkt. 22]:

INTRODUCTION

In a thinly-veiled effort to needlessly increase the cost of this litigation, Opici now files a “Motion to Strike” wherein it claims that certain portions of Luxco’s Reply Brief in support of its Motion to Compel should be struck for containing alleged “new” issues and “inaccurate and misleading assertions” of fact. (*See* Motion to Strike [Dkt. 22].) Opici cites no authority supporting the relief it requests and, in fact, fails to even articulate the applicable legal standard governing its motion. The Board treats motions to strike with disfavor, and they are accordingly denied unless the matter sought to be struck has no bearing on the issues in the case or is found to be “redundant, immaterial, impertinent, or scandalous.” Fed. R. Civ. P. 12(f).

Opici’s moving papers fail to satisfy this burden. Luxco’s Reply Brief did nothing more than correct factual inaccuracies regarding this ongoing discovery dispute asserted by Opici in its opposition brief, and provide further response to Opici’s newly-claimed position that it will

refuse to respond to discovery based on so-titled “advice of counsel” reliance. As more fully set forth below, it would have been impossible for Luxco to raise this issue in its principal motion—because Opici did not even make the claim until two weeks thereafter. Regardless, whether the issue is characterized as one of “advice of counsel” or instead simply as relating to Opici’s refusal to respond to discovery based on claimed “privilege” or “work product”—which Opici does not dispute—the end result must necessarily be the same. The Board should order that Opici either fully respond or be precluded from using any withheld documents or information contained therein as evidence in this matter. In short, Opici’s Motion to Strike is unfounded and should be denied. The Board should rule on Luxco’s Motion to Compel.

ARGUMENT AND AUTHORITIES

I. LEGAL STANDARD

Motions to strike are not favored, and the Board will refuse to strike matter “unless it clearly has no bearing” on the issues in the case. *Harsco Corp. v. Electrical Sciences, Inc.*, 9 U.S.P.Q.2d 1570, 1571 (T.T.A.B. 1988); *Leon Shaffer Golnick Advertising, Inc. v. William G. Pendill Marketing Co.*, 177 U.S.P.Q. 401, 402 (T.T.A.B. 1973). That is, pursuant to Federal Rule 12(f), matter should not be struck unless it is “redundant, immaterial, impertinent, or scandalous.” Fed. R. Civ. P. 12(f). The Board thus regularly declines to grant motions to strike where matter sought to be struck simply provides fuller notice of the basis of a claim or defense. *Ohio State Univ. v. Ohio Univ.*, 51 U.S.P.Q.2d 1289, 1292 (T.T.A.B. 1999); *Leon Shaffer Golnick Advertising, Inc. v. William G. Pendill Marketing Comp., Inc.*, 177 U.S.P.Q. 401, 402 (T.T.A.B. 1973); *Harsco Corp. v. Electrical Sciences Inc.*, 9 U.S.P.Q.2d 1570, 571 (T.T.A.B. 1988) (rejecting motion to strike where allegations simply amplified claim). A motion to strike is equally inappropriate and properly denied where a reply brief simply clarifies matters raised in

a principal brief. *See D'Angelo v. Boston Red Sox Baseball Club L.P.*, 43 U.S.P.Q.2d 1635, 1636 n. 2 (T.T.A.B. 1997).

II. OPICI OFFERS NO AUTHORITY OR SUPPORT FOR ITS CLAIM THAT ANY PORTION OF LUXCO'S REPLY BRIEF SHOULD BE STRUCK

In the present motion Opici now contends that certain portions of Luxco's Reply Brief should be struck for containing alleged "new" issues and "inaccurate and misleading assertions." (*See* Motion to Strike [Dkt. 22].) Opici offers no rule or court endorsing the relief it requests. Luxco's Reply Brief in support of its Motion to Compel did nothing more than seek to correct factual inaccuracies alleged by Opici in its opposition brief, and further respond to Opici's newly-raised affirmation that it was refusing production based on "advice of counsel" reliance. Opici's Motion to Strike is without support and should be denied.

A. Luxco Could Not Have Addressed Opici's Reliance on Claimed "Advice of Counsel" in its Motion to Compel

Opici maintains in the present motion that Luxco's reference to Opici's reliance on "advice of counsel" in reply is purportedly "frivolous," but nevertheless untimely, and should accordingly be struck. (*See* Motion to Strike [Dkt. 22], p. 2-3.) However, as is plain even from a cursory review of Opici's exhibits filed in this matter, Opici did not serve Luxco with its amended interrogatory responses identifying "advice of counsel" until October 1, 2014—two weeks after Luxco's filing. (*See* Opici's Opp. to Luxco's Motion to Compel [Dkt. 20], at Ex. 9.) Thus, it would have been impossible for Luxco to raise this issue in its Motion to Compel. Having intentionally chosen to interject this claim now in its response to Luxco's Motion to Compel, Opici cannot be heard to assert that it was somehow improper for Luxco to respond. In truth, Opici's assertions of "unfair advantage" ring hollow.

Opici vigorous suggestion that this issue is “frivolous” here is equally without legal support. To that end, Opici submits that *Teal Bay* supports its claim that “advice of counsel” is “simply inapplicable” unless there is an allegation of “willful infringement,” a fraud claim, or a claim for enhanced money damages. (*See* Motion to Strike [Dkt. 22], p. 3.)¹ In fact, the *Teal Bay* court contradicts Opici’s claim:

Advice-of-counsel evidence is **most relevant** to the [likelihood of confusion] factor concerning the defendant’s intent. Some courts have referred to this as the “good faith” factor. Good faith can be found where a defendant has relied on the advice of counsel and cannot be said to have adopted its mark with the intention of capitalizing on another markholder’s reputation and goodwill by confusing consumers. Advice of counsel **can also** impact the ability of a prevailing party to recover attorney’s fees, which are reserved for “exceptional cases.” A party’s reasonable reliance on the advice of counsel may serve as evidence that the party did not engage in the willful conduct that has served as a basis for other courts to award attorney’s fees in “exceptional cases.”

See Teal Bay Alliances, Inc. v. Southbound One, Inc., 2014 WL 1630211, *3 (D. Md.

Apr. 21, 2014)(emphasis added)(holding that waiver applied to any communications and documents relating to “good faith adoption, registration, and use” of its trademark)(internal citations omitted). As Opici’s intent is plainly an issue here relative to the Board’s analysis of all relevant *du Pont* factors, Opici’s suggestion that this issue is “simply inapplicable” lacks any factual or legal support.

In short, Opici fails to provide any support for its claim that Luxco’s Reply Brief addressing “advice of counsel” was improper or “frivolous.” The Board should accordingly deny Opici’s Motion to Strike. Regardless, whether considered as an issue relating to claimed “advice of counsel” or simply one of Opici’s continued refusal to substantively respond to

¹ Tellingly, Opici’s Motion provides no pin-point citation from *Teal Bay* purportedly endorsing its assertion. The reason for this failure is plain; one does not exist.

interrogatories² and production requests based on claimed “privilege,” case-law makes abundantly clear that Opici cannot use “privilege” as both a sword and a shield. (See Motion to Compel [Dkt. 15], and cases cited therein.) As such, the Board must either overrule Opici’s objections or order that Opici be precluded from using any withheld documents or information obtained from such documents as evidence in this matter. Fed. R. Civ. P. 37(c); *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 U.S.P.Q.2d 1895, 1897 n. 5 (T.T.A.B. 1988).

B. Luxco’s Motion to Compel Addresses Opici’s Improper Refusal to Respond to Any Revised Interrogatories

Luxco’s Motion to Compel addressed two distinct deficiencies in Opici’s responses to Luxco’s Interrogatories, namely: (1) Opici’s refusal to respond to revised interrogatories, and (2) Opici’s further refusal to provide any substantive responses to various other interrogatories based on claimed “privilege” or “work product” protection. (See Motion to Compel [Dkt. 15], pp. 7-9 and Exhibits cited therein). In its response, Opici stated to the Board that there was no dispute on this issue because, despite Opici’s claimed “effort to see if something could be worked out” that it requested information regarding “what revisions” were intended and that, purportedly, Luxco failed to disclose or identify any. (See Opp. to Motion to Compel [Dkt. 20], p. 5.) Luxco’s Reply Brief did nothing more than correct this factual distortion.

² In its Reply Brief Opici will likely claim that Luxco is “arguing the same” in its privilege and work-product objections lodged in response to Opici’s Requests for Admission, which were served on Opici on or about October 31, 2014. Opici’s claims in this regard are a *non sequitur* because Opici has not served Luxco with Interrogatories or Production Requests. Further, Luxco previously provided Opici with extensive case-law holding that Rule 36 does not authorize a party to request an admission that would require the respondent to divulge attorney-client communications or work product materials. (See Nov. 7, 2014 e-mail attached hereto as Ex. A.)

C. There is Nothing “Misleading” in Luxco’s Reply Brief

Finally, Opici’s claim that page 2 of Luxco’s Reply Brief is “misleading” requiring that it be struck similarly lacks any support. To the contrary, therein Luxco cites authority showing how Opici’s adamant refusal to produce any documents relating to alleged third-party uses based on so-called “work-product” privilege is wholly improper. (*See* Reply Br. [Dkt. 21], p. 2.) The COLAs which Opici references in its Requests for Admission should have been produced in response to multiple of Luxco’s prior discovery requests, including those directed to Opici’s now-dismissed counterclaim allegations (i.e., RFPD 32-35 and 38) as well as Luxco’s request that Opici produce any documents and other materials referenced or referred to in its initial disclosures. (RFPD No. 31.) Opici now seems to suggest in its Motion to Strike that it need not produce these documents simply because they were generated after the counterclaim was filed. (Motion to Strike [Dkt 22], p. 6.) To be sure, Opici’s initial disclosures plainly identify “TTB Cola Label approvals concerning labels bearing the term REBEL or variations thereof,” as well as other documents related to “uses by third parties of products bearing the term REBEL and variations thereof.” (*See* Motion to Compel [Dkt. 15], Ex. N, p. 3.) Thus, Opici’s claims in this regard are at odds with, and contrary to, Opici’s ongoing duty to supplement its prior discovery responses in a timely manner. *See* Fed. R. Civ. P. 26(e)(1)(A).

Simply stated, Opici fails in the present motion to identify any “redundant, immaterial, impertinent, or scandalous” matter warranting exclusion under Rule 12(f). Having failed to satisfy its burden, the present motion should be denied and the Board should rule on Luxco’s Motion to Compel. To the extent Opici remains adamantly unwilling to provide responsive information and documents the Board should order that it be precluded from using any such withheld documents or information obtained therefrom as evidence in this matter. Fed. R. Civ. P.

37(c); *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 U.S.P.Q.2d 1895, 1897 n. 5 (T.T.A.B. 1988).

CONCLUSION

For the reasons set forth above, the Board should deny Opici's Motion to Strike.

DATED: November 13, 2014.

Respectfully Submitted,

By: *Andrew R. Gilfoil*
Michael R. Annis
Andrew R. Gilfoil
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Attorneys for Luxco, Inc.

CERTIFICATE OF SERVICE

The undersigned counsel hereby certifies that a copy of the foregoing was served by First Class Mail, postage prepaid on this 13 day of November, 2014, upon:

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

/Andrew Gilfoil/

Gilfoil, Andy

From: J. Rannells <JMR@br-tmlaw.com>
Sent: Friday, November 07, 2014 1:21 PM
To: Gilfoil, Andy
Cc: Steve Baker; Annis, Michael; Nemes, Alan
Subject: RE: Luxco v Opici Discovery deficiencies

I disagree with your conclusions and your characterizations of the requests. Unless I hear from you to the contrary I will assume that your position is as stated and will file a motion.

Regards,

John "Jack" Rannells

From: Gilfoil, Andy [<mailto:Andy.Gilfoil@huschblackwell.com>]
Sent: Friday, November 07, 2014 1:06 PM
To: J. Rannells
Cc: Steve Baker; Annis, Michael; Nemes, Alan; Gilfoil, Andy
Subject: RE: Luxco v Opici Discovery deficiencies

Jack;

I am in receipt of your letter. At the outset I note that other than referencing the text of Rule 36 you cite no authority to support your claims that the referenced objections are improper.

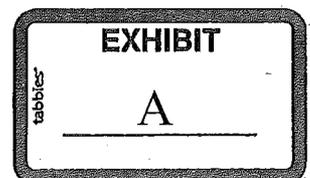
As to the privilege/work product objections, courts have repeatedly held that it is improper to request admissions that would require a party to divulge information and communications protected by the attorney client and work product privileges. See, e.g., *Cohen v. McDonnell Douglas*, 1993 WL 835279, *3 (E.D.Mo. 1993); *Chopra*, 2008 WL 5101571, *7 (D.Colo. 2008)(granting motion for protective order); *Holston v. DeBanca*, 2012 WL 843917, *13 (E.D.Cal. 2012); *Mattel*, 2010 WL 3705907, *5 (C.D.Cal. 2010)(collecting cases).

As to the "seeks a legal conclusion" objection, courts likewise have held that the "application of law to fact" language in Rule 36 does not authorize a party to request an admission regarding a legal conclusion or the truth of legal conclusions. See *Openmethods, LLC v. Mediu, LLC*, 2012 WL 2736471, *2-3 (W.D.Mo. 2012)("pure legal conclusions, or the truth of a legal conclusion, are out of bounds"); *Lane No. 1 v. Lane Masters Bowling Inc.*, 2011 WL 1097861, *11 (N.D.N.Y. 2011)("bald legal conclusion" that certain patent claims are "invalid" runs counter to Rule 36(a)); *Parkway Corp. v. Fyrnetics, Inc.*, 1992 WL 12564602 (N.D.Ill. 1992)(improper to seek admission that certain art is "prior art"); *Naxon Telesign Corp. v. GTE Inform. Sys., Inc.*, 1980 WL 57937, *1 (N.D. Ill. 1980)(improper to seek admission of an "ultimate legal conclusion in the case rather than admissions of fact or the application of law to fact").

Once you have had the opportunity to review please feel free to give me a call if you would like to discuss further. Of course, if you have case-law to the contrary please provide it and I would be happy to review.

Finally, as to your claim that Luxco has "argued the same" in its Motion to Compel, the only discovery responses at issue in that motion are Opici's responses to Luxco's Interrogatories and RFPDs. Opici has chosen not to serve Luxco with interrogatories or production requests to-date.

Best,



Andy

Andrew R. Gilfoil
Attorney
Direct: 314.480.1812
Andy.Gilfoil@huschblackwell.com

From: J. Rannells [<mailto:JMR@br-tmlaw.com>]
Sent: Wednesday, November 05, 2014 1:14 PM
To: Gilfoil, Andy
Cc: Steve Baker
Subject: Luxco v Opici Discovery deficiencies

Andy:

Attached is a courtesy copy of Opici's deficiency letter regarding Luxco's responses and objections to Opici's first and second requests for admissions. Hard copy to follow by mail.

Kind regards,

John "Jack" M. Rannells

Baker and Rannells, PA

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