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

Proceeding	92059915
Party	Plaintiff GE Nutrients, Inc.
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Date	11/20/2015
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

GE NUTRIENTS, INC.,

Petitioner,

vs.

CA IP HOLDINGS, LLC,

Registrant.

Cancellation No. 92,059,915

Registration No. 4,302,581

Mark: TESTOGEN-XR

**PETITIONER’S RESPONSE IN OPPOSITION TO
REGISTRANT’S MOTION TO COMPEL COMPLETE RESPONSES TO
REGISTRANT’S FIRST REQUESTS TO PRODUCE**

In filing a motion to compel more complete responses to their first set of requests for production of documents, Registrant mischaracterizes time periods and ignores key points of communication and production by Petitioner, all in an effort to paint the Petitioner as uncooperative and dilatory. However, the evidence demonstrates that Petitioner provided Registrant with sufficient notice of delays in producing responsive documents as a result of having retained a third-party e-discovery vendor to ensure complete production of documents in this case.

Most importantly, Registrant fails to articulate just **how** Petitioner’s significant document production remains incomplete, nor have they at any point expressed such dissatisfaction with Petitioner. To be clear, Registrant’s motion makes no argument, discussion or even mention of the substance of the over 10GB of electronically produced documents provided by Petitioner. Registrant’s remaining grievances appear to be solely related to Petitioner’s General Objections and other specific objections. With the hopes of amicably resolving this discovery dispute,

Petitioner waives nearly all prior General Objections and many specific objections. For these reasons, explained more fully below, Registrant's motion to compel should be denied.

I. Petitioner's Consistent Communication and Document Production.

Registrant's motion to compel contains numerous misleading characterizations of the relevant time periods or communications between the parties. For example, while Registrant expresses indignation about the "two (2) months" (*see* Registrant's Br. at ¶ 6, emphasis in original) between their initial request and the parties' conference of September 14, 2015, it should be noted that half that time constituted the *allowable time period* under Fed. R. Civ. P. 34(b)(2)(A) and 37 C.F.R. § 2.120(a)(3) for Petitioner to respond to the requests. Another two weeks of this time is attributed to Registrant's decision to send its discovery letter on September 2, 2015. *See* Registrant's Br. at ¶¶ 3-4. The remainder of this time can be attributed to Registrant's offering until September 11 to respond to their letter. Adding these periods together, it is clear that the "two month" delay in having a telephone conference as to the discovery was completely innocuous, resulting from allowable discovery response time or the timing of Registrant's own decisions – and certainly not any "dilatatory" behavior by the Petitioner. *Id.* at ¶ 10.

Similarly, contrary to Registrant's characterizations, the record demonstrates that Petitioner provided consistent communication regarding the production of documents. On September 2, 2015, upon receiving Registrant's discovery letter, within less than two hours counsel for Petitioner let Registrant know that "our client's documents are currently being culled and processed by our e-discovery vendor. We expect to have them for review and production soon." *See* Registrant's Exhibit C at 2-3. On September 11, in keeping with Registrant's unilateral deadline, counsel for Petitioner contacted Registrant to set up the September 14 call.

Id. at 1. On September 18, Petitioner’s counsel notified Registrant that Petitioner was “still reviewing a large amount of information received from our client in response to your documents requests...there is over 10GB of information to review...We hope to produce the documents by late next week and are working as diligently as possible, but I cannot be sure that we will be finished by then.” *See* Registrant’s Exhibit D at 1.¹ On September 28, Petitioner’s counsel informed Registrant of a delay in production resulting from a technical delay on the part of the e-discovery vendor retained by Petitioner. *See* Registrant’s Exhibit F at 3.

On October 6, 2015, Petitioner’s entire production was made available. *Id.* at 2. On October 15, Petitioner submitted supplemental written responses to Registrant’s first request for production of documents. *See* Registrant’s Exhibit E (providing precise Bates-stamped page numbers to each Request for Production).

II. Registrant’s motion to compel fails to articulate precisely in what way Petitioner’s voluminous document production remains incomplete.

The title of Registrant’s motion states that it seeks “complete responses” to its request for production of documents, yet Registrant fails to explain how Petitioner’s substantial document production falls short. Following production of these documents, Registrant’s only remaining concern appeared to be Petitioner’s general and/or specific objections stated in its answers to Registrant’s First *Interrogatories*: Registrant’s counsel no longer expresses any dissatisfaction with Petitioner’s responses to their requests for production in any aspect. *See* Registrant’s Exhibit G at 2. Yet, Registrant has filed a motion to compel regarding their First Requests for Production. This comes as a surprise to Petitioner. 37 C.F.R. § 2.120(e)(1) and Fed. R. Civ. P.

¹ Registrant’s Motion to Compel ignores the entirety of Petitioner’s counsel’s statement, who clearly indicated that she was unsure if it was possible to provide the documents by “late next week.” *See* Registrant’s Br. at ¶ 8 (misquoting Petitioner’s counsel’s statement, suggesting that her sentence ended with the phrase “late next week.”).

37(a)(1) both contemplate that the parties to resolve discovery disputes before seeking relief from the Court. On this basis alone, this motion to compel should be denied.

III. Petitioner maintains that certain requests for production remain overly broad. Nevertheless, Petitioner withdraws nearly all general and specific objections as well as its objections on the basis of confidentiality.

Petitioner submits that Registrant’s Request Nos. 2, 12, 13, 20 and 24, as written, remain overly broad. These requests, among others, appear to ask for documents that would include material that is attorney work-product protected or attorney-client privileged – especially given that Registrant’s “definition” of “documents” states that this term “shall be construed in the broadest sense possible” and does not include any limitation regarding privilege. *See* Petitioner’s Exhibit A, Registrant’s First Requests for Production of July 17, 2015 at 1-2. These requests – seeking documents related to how the term TESTOFEN was decided upon (No. 2); licensing (Nos. 12 and 13); business strategy (No. 20); and the production of the discovery request (No. 24) – are written so broadly that they most likely solicit at least in part privileged information. Therefore, Petitioner must maintain its specific objections as to these Requests. *Id.*

Because of the overly broad nature of these Requests and Registrant’s unilateral definition of “documents,” Petitioner cannot withdraw some general objections, nor can it withdraw its specific objections to Requests Nos. 2, 10-13, 20, and 24. But in the spirit of cooperation and to amicably resolve this discovery dispute, Petitioner withdraws a great majority of its general and specific objections.

A. General and Specific Objections Maintained.

Petitioner maintains General Objections “A” and “B”: to the extent that Registrant’s unilateral definitions seek to impose create greater obligations than the Federal Rules of Civil Procedure require, or to the extent that these requests solicit privileged information, Petitioner

must continue to object. Petitioner maintains General Objection “G”, a definition, to ensure that it protects privileged information to the utmost. And as mentioned above, Petitioner maintains its specific objections to Request Nos. 2, 10-13, 20 and 24. As for Registrant’s Request No. 20, Petitioner retracts its statement that it will produce documents responsive to the request, and avers that such documents have indeed been produced as part of its October 6 e-discovery production.

B. General and Specific Objections Withdrawn.

Petitioner withdraws General Objections “C”, “D”, “E”, “F”, “H”, and “I”. Petitioner withdraws its specific objections as to Requests Nos. 1, 3-11, and 14-19, and 21-23, as well its objection as to Request No. 24 being cumulative and duplicative of other requests. Regarding all of its responses, Petitioner continues to refer Registrant to the specific documents produced and identified by Bates number – which, again, Registrant has expressed no dissatisfaction with to this point.

IV. Petitioner does not oppose Registrant’s request for extension of time.

Petitioner has no objection to Registrant’s request for an extension of time as it relates to the Expert Disclosures or other subsequent deadlines.

CONCLUSION

Registrant has expressed no prior dissatisfaction with Petitioner’s considerable production responsive to their First Request for Production of Documents. Petitioner withdraws nearly all general and specific objections except those necessary to maintain privileged documents or information. This motion to compel should be denied.

[signature on following page]

November 20, 2015

Respectfully submitted,

/s/ Ryan M. Kaiser

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Attorneys for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that on November 20, 2015, a true and correct copy of the foregoing was served by via electronic mail on all counsel or parties of record on the Service List below:

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/s/ Ryan M. Kaiser

EXHIBIT “A”

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

GE Nutrients, Inc.,
Petitioner

v.

CA IP Holdings, LLC,
Registrant

Cancellation No. 92059915

Registration No. 4,302,581

Mark: TESTOGEN-XR

**REGISTRANT'S FIRST REQUEST FOR PRODUCTION OF
DOCUMENTS AND THINGS TO PETITIONER, GE NUTRIENTS, INC.**

Registrant, CA IP HOLDINGS, LLC, by and through the undersigned counsel, and pursuant to Federal Rule of Civil Procedure 34, hereby requests that Petitioner, GE NUTRIENTS, INC., produce the documents requested herein, and serve them upon Registrant within thirty (35) days of the date noted on the certificate of service page to the undersigned counsel.

DEFINITIONS

The following definitions shall apply:

A. As used in this request, the terms "document" or "documentary materials" shall be construed in the broadest sense possible to include all recorded information within the scope of Rule 34, regardless of the medium of recording. The terms shall cover, without limitation, any writing and any other object or tangible thing in your custody, possession or control, or that of your representative(s) and/or attorney(s), whether printed, recorded, reproduced by any process, photocopied, or written or produced by hand, including, but not limited to, records, notes, papers, books, letters, reports, facsimiles, log books, sign in sheets, agreements, contracts, subcontracts, purchase orders, communications, including correspondence, telegrams, e-mails, memoranda, summaries, analyses or estimates or records of personal conversations, diaries, calendars, forecasts, photographs, tape recordings, models, statistical statements, graphs, laboratory and engineering reports and notebooks, charts, plans, drawings, estimates of cost,

budgets, books of account, minutes or records of conferences, expressions or statements of policy, lists of persons attending meetings or conferences, lists of persons having access to trade secrets or confidential information, reports and/or summaries, analyses or estimates of interviews, reports, and/or summaries, analyses or estimates of investigations, opinions or reports of consultants, appraisals, records, reports or summaries, analyses or estimates of negotiations, brochures, pamphlets, circulars, drafts of any document, revisions of drafts of any document, canceled checks, bank statements, billings, deposit agreements, invoices, delivery tickets, sales journals, financial records, receipts and any other original or photocopied document on paper. Any comment or notation appearing on any document, and not a part of the original text, is to be considered a separate "document." Any draft or preliminary form of any document is also to be considered a separate "document." Specific reference to any other type of document in the ensuing requests shall not be construed as in any respect limiting the generality of the foregoing.

B. The terms "individual" and "person" refers to a natural or artificial person as defined by State and Federal law, as well as a corporation, partnership or other business association or entity, government or governmental body, commission, board, office or agency.

C. The term "communication" means any knowledge, thoughts or feelings, imparted, exchanged or transmitted between or among persons through any medium of communication, including but not limited to telephone, correspondence, personal meetings or any type of wire transmission, as well as any and all preserved forms of communication. It shall also mean any transfer or exchange between two or more persons of any information, whether by written or oral means, including, but not limited to personal conversation, correspondence, telephone calls, and telegrams. This definition includes all communications for which you claim a privilege.

D. The words "agreement" and "contract" shall include any agreement or contract executed or in effect at any time during an indicated period. The terms "agreement" and "contract" shall also be deemed to include any agreement which has allegedly been superseded, amended, modified, revoked or rescinded. Identification of a draft and of any copy of the agreement or draft.

E. The term "address" shall mean present or last known address.

F. The term "business entity" shall mean a corporation, partnership, joint venture, business trust, professional association or sole proprietorship organized for commercial purposes.

G. The term "and" shall include the term "or," and the term "or" shall include "and."

H. "Pertain", "Pertaining", "Relate", "Relating", "Reflect", "Reflecting", "Regard" or "Regarding" shall mean evidencing, memorializing, referring to, constituting, containing, discussing, describing, embodying, reflecting, identifying, mentioning, stating, or otherwise relating to or regarding in any way, directly or indirectly, in whole or in part, the subject matter referred to in the request.

I. "Refer" or "Referring" shall mean anything relevant, in any way, to the subject matter specified in the request, including, but not limited to, constituting, comprising, recording,

reflecting, exhibiting, indicating, discussing, analyzing, evidencing, representing, illustrating, mentioning, concerning, evaluating, or commenting upon in any way, directly or indirectly, in whole or in part, the subject matter referred to in the request.

J. The term “identify” refers to stating the identity.

K. The term “identify” or “identity” or “identification” (of an individual) shall mean to state his or her full name, present or last known address and telephone number, and present or last-known employer and job title or classification.

L. The term “identify” or “identity” or “identification” (of an entity) shall mean to state its full name, the address of its principal place of business, its main telephone number, and the names of its principals.

M. The term “identify” or “identity” or “identification” (of a document) shall mean to state its title, date, any identifying numbers and all other identifying designations, and the number of pages. Additionally, said terms shall also mean to state the date, author, sender, recipient, type and present location of each document for which identification is requested, as well as the identity of each person having custody thereof.

N. “Sufficient to Identify” shall mean the production of documents that, when reviewed and read by a person not affiliated with the responding party and not familiar with the responding party’s recording procedures, will enable the undersigned to readily ascertain, understand, and gather the information sought in each respective request.

O. The terms “Petitioner”, “you” or “your” shall mean GE NUTRIENTS, INC., and any person acting for or on your behalf, including your principals, officers, agents, representatives, attorneys, counsel, employees, investigators, consultants, predecessors, successors, parents, subsidiaries, affiliated entities and assigns. Where applicable, use of these terms shall not be read to solicit any information protected by the attorney/client doctrine; but, where applicable, a privilege log should be provided for any such information appropriately withheld.

P. The terms “Registrant” shall mean CA IP HOLDINGS, LLC, and any person acting for or on its behalf.

Q. The term “Pleadings” shall mean each and every pleading filed in this case up through the date that you respond to these discovery requests, and shall include, without limitation, the operative Complaint, and all Answers, Affirmative Defenses and Counterclaims filed in response thereto.

INSTRUCTIONS

In connection with this Request for Production, you are to act in accordance with the following instructions:

A. You are to produce the responsive documents within thirty (30) days after service of this Request upon you, responding to each of the Requests set forth below. If you object, a specific objection must be raised with respect to each Request.

B. You are to produce all responsive documents as said documents are kept in the ordinary course of your business. To the extent electronic mail (E-Mail) communications are produced in response to any request herein, such documents are requested to be produced in electronic “.pst” file format.

C. The documents requested for production include those in your possession, custody, or control, and/or that of your agents, representatives, employees, and attorneys.

D. If you object to the production of any document on the grounds that it is protected by any privilege (work product, attorney-client, etc.), you are to provide the following specific information with respect to each document or item to which a privilege is asserted:

- (i). The type of document or item being withheld (memo, letter, etc.);
- (ii). The specific privilege being asserted (attorney-client, work product, etc.);
- (iii). The date upon which that document was prepared;
- (iv). The identity of the individual who authored or prepared that document;
- (v). The identity of the person to whom that document was submitted (for example, its addressee, its recipient);
- (vi). The identification of all parties who either received a copy of that memo or who, since the creation of that document, have seen or read the document or item; and
- (vii). Identify the name of the person who has custody of it.

E. If a document is no longer in your possession, custody or control, your response should identify the document by name, number, form of description, and by date made, and should state when the document was most recently in your possession, custody or control, the disposition made of the document, and the identity of the person or persons now in possession, custody, or control of such document. If the document has been destroyed, the response should state the reason for its destruction, the date of the destruction and the name of the person(s) who directed that the document be destroyed.

F. The documents produced pursuant to these requests shall be separately produced for each paragraph of the request; however, a document which serves as a response to more than one request may, if the relevant portion is so marked or indexed, be produced and referred to in a

later response as complying with the particular paragraph or paragraphs to which they are responsive.

G. Copies, if authenticated, of the original documents may be supplied in response, unless otherwise provided.

H. Each request refers to all documents that are either known by you to exist or that can be located or discovered by reasonably diligent effort by you.

I. Please note that you are under a continuing duty to seasonally supplement the production with documents obtained subsequent to the preparation and filing of the response to each request.

REQUESTS TO PRODUCE

1. Produce all documents supporting your contention that “Petitioner for many years and since long prior to any date of first use upon which Registrant can rely, has adopted and continuously used the term ‘TESTOFEN’ as a trademark for use in connection its dietary supplement product.”
2. Produce all documents referencing, regarding or concerning how you decided to adopt the term TESTOFEN for use in connection with dietary supplement products.
3. Produce all documents referencing, regarding or concerning each and every instance of actual consumer confusion caused by Registrant’s use of the term ‘TESTOGEN-XR’ and your use of ‘TESTOFEN’.
4. Produce a representative label for each dietary supplement product sold by you under the term ‘TESTOFEN’ since you first began using said term, through the present.
5. Produce all documents that you reference in your Initial Disclosures as “Marketing and promotional materials concerning Petitioner’s TESTOFEN products.”
6. Produce all documents that you reference in your Initial Disclosures as “Sales information concerning Petitioner’s TESTOFEN products and documentation of Petitioner’s first use of the TESTOFEN mark in the U.S.”
7. Produce all documents that you reference in your Initial Disclosures as “Documents concerning Petitioner’s application to register the TESTOFEN trademark and resulting registration.”
8. Produce all documents relating to studies and/or surveys in connection with the use of the term TESTOFEN.
9. Produce all documents relating to your selection, adoption and registration of any Internet domain names incorporating the term TESTOFEN.
10. Produce all documents sufficient to identify every product in connection with how you have used or are using the term TESTOFEN.
11. Produce all documents relating to your past and present efforts to promote or expand public awareness of the term TESTOFEN.
12. Produce all documents relating to any licensing agreements or agreements providing your consent to others to use the term TESTOFEN.

13. Produce all documents relating to your plans for future use of, or plans to license to others the use of, the term TESTOFEN.
14. Produce all documents relating to your use of the term TESTOFEN on any product that you have sold or are offering for sale.
15. Produce all documents sufficient to show your annual expenditures on domestic advertising and marketing of products bearing the term TESTOFEN since your first use of the marks in the United States.
16. Produce all documents sufficient to show the geographic scope of your business and promotional activities associated with the use of the term TESTOFEN.
17. Produce one copy each of all advertising, marketing, and promotional material showing use of the term TESTOFEN on any goods, including, but not limited to, web pages, catalogs, circulars, leaflets, direct mail pieces, brochures, point of sale pieces, press releases, web-based advertisements (including, but not limited to, banner ads), newspaper and magazine advertisements and articles, transcripts and audio tapes for radio advertisements, and transcripts and video tapes of television advertisements.
18. Produce all documents relating to your policies regarding retention, storage, filing and destruction of electronic mail, documents, and things.
19. Produce all documents sufficient to identify trade shows or conferences that you have attended where you have offered for sale, sold, or demonstrated products bearing the term TESTOFEN.
20. Produce all documents sufficient to identify the persons involved in design, sales, marketing, communications, business strategy, or business planning for your use of the term TESTOFEN.
21. Produce all documents related to e-mail communications directed to, addressed to, intended for, or received by you (excluding those from your counsel) concerning the use of the term TESTOFEN.
22. Produce all documents related to the meaning of the term TESTOFEN in relation to the goods claimed to be sold in intrastate and/or interstate commerce.
23. Produce all documents sufficient to show the dates of first use anywhere and in interstate commerce of the term TESTOFEN in relation to the goods claimed to be sold in intrastate and/or interstate commerce.

24. Produce all documents reviewed in connection with responding to the contemporaneously served Interrogatories.

Dated: July 14, 2015

The Concept Law Group, P.A.

By: /Scott D. Smiley/
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Attorney for Registrant,
CA IP Holdings, LLC

Certificate of Mailing and Service

I certify that on July 14, 2015, the foregoing REQUEST FOR PRODUCTION OF DOCUMENTS AND THINGS is being served by mailing a copy thereof by U.S. mail to:

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