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

Proceeding	92060599
Party	Plaintiff Turn-Key Vacation Rentals, Inc.
Correspondence Address	DAVID M ADLER ADLER LAW GROUP 300 SAUNDERS RD, SUITE 100 RIVERWOODS, IL 60015 UNITED STATES david@adler-law.com
Submission	Opposition/Response to Motion
Filer's Name	DAVID M. ADLER
Filer's e-mail	David@adler-law.com
Signature	/david m. adler/
Date	10/19/2016
Attachments	TKVR brief in opposition final.pdf(174633 bytes) DMA Affidavit w Ex 10-18-16.pdf(1080228 bytes)

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

TURN-KEY VACATION RENTALS, INC.,
a California corporation,

Petitioner,

v.

THOMAS CLARK,
an individual and resident of California,

Respondent.

Cancellation No. 92060599

Reg. No. 4340236

Mark: TURNKEY

PETITIONER'S RESPONSE
TO RESPONDENT'S MOTION TO COMPEL DISCOVERY
AND/OR MOTION FOR SANCTIONS

Petitioner Turn-Key Vacation Rentals, Inc. ("Petitioner") respectfully submits the following Brief in opposition to the motion of Respondent Thomas Clark ("Respondent") to Compel Discovery and/or Motion for Sanctions. As a preliminary matter, despite Respondent's uncertainty as to the nature of the motion, Petitioner is responding to both (1) a motion to compel Petitioner's response to discovery and (2) a motion for sanctions.

Respondent requests that Petitioner be compelled to respond to Respondent's discovery requests. Respondent has not filed a motion to re-open discovery, merely a motion to compel disclosure. Discovery closed on September 9, 2016. On September 16, 2016, Petitioner advised Respondent that Petitioner was not going to respond to the discovery requests because Respondent never served its Initial Disclosures. On September 16, 2016, Respondent attempted to serve its Initial Disclosures. On October 4, 2016, Respondent filed the present motion to compel discovery.

BACKGROUND

The following details, set out in the Affidavit of David M. Adler (“Adler Affidavit”, attached) summarize the important dates and the parties respective conduct of discovery. On March 7, 2016, counsel for Petitioner wrote to opposing counsel, Kuscha Hatami via email to set a date and time for the initial discovery conference required by Federal Rule 26. On March 9, 2016, counsel for Petitioner served opposing counsel with a letter outlining proposed answers to the items for discussion in the initial discovery conference. The proposed answers did not deviate from the default rules. (Adler Affidavit, Para. 2-3)

On March 9, 2016, opposing counsel replied via email that he would “review [the] proposed letter and send ... comments before the end of the week.” One month later, on April 7, 2016, counsel for Petitioner wrote to opposing counsel inquiring about the status of his edits, revisions or modifications to the proposed answers to the items for discussion in the initial discovery conference. On April 7, 2016, opposing counsel replied via email that he would respond that day or the next. As of the date of the Adler Affidavit, opposing counsel has not responded with any edits, revisions, modifications or objections to the answers to the items for discussion in the initial discovery conference. (Adler Affidavit, Para. 4-7)

On April 8, 2016, Petitioner served Respondent with Petitioner’s Initial Disclosures. Petitioner served its First Request to Admit on April 29, 2016, First Requests to Produce Documents on May 20, 2016, and First Set of Interrogatories on May 20, 2016. (Adler Affidavit, Para. 8-9)

On June 14, 2016, counsel for Petitioner wrote to opposing counsel advising him that Respondent’s answers to Petitioner’s discovery requests were late, that Respondent had failed to object to or deny the Requests to Admit and seeking to schedule the deposition of Respondent. Respondent did not respond to Petitioner’s discovery requests until June 24, 2016, which

response consisted entirely of objections and without providing a single responsive document. (Adler Affidavit, Para. 10-11)

Respondent served its First Request to Admit, First Requests to Produce Documents, and First Set of Interrogatories on July 29, 2016. On September 16, 2016, counsel for Petitioner wrote to opposing counsel that Petitioner is not responding to Respondent's discovery requests and explaining the reasoning behind the decision. Petitioner did not serve its initial disclosures until September 29, 2016, AFTER the close of discovery (September 8, 2016) and only AFTER counsel for Petitioner had advised opposing counsel of the failure to do so (September 16th, 2016). (Adler Affidavit, Para. 12-14)

Petitioner categorically denies and disputes Respondent's accusations that Petitioner was "gaming the system," "hiding the ball," or otherwise engaging in any misconduct as alleged in Respondent's motion and the "Declaration" of Respondent's counsel, Kuscha Hatami. Petitioner followed the rules. Respondent did not.

The petition for cancellation of Respondent's "TURN KEY" mark is based on Petitioner's prior use and priority of rights in the "TURN KEY VACATION RENTALS" mark. Due to Respondent's counsel's gross negligence, Respondent failed to follow the discovery rules and procedures, failed to produce any evidence in response to Petitioner's requests and is now in the embarrassing position of having zero evidence to counter or refute Petitioner's claim of priority. Presuming that Respondent had any shred of evidence that refuted or countered Petitioner's claim of priority, Respondent could have produced such evidence in response to Petitioner's requests. Respondent produced nothing, only objections. Respondent's present motions are without legal merit and brought out of sheer desperation.

ARGUMENT

Despite the fact that Respondent brings this motion after the close of discovery, Respondent has not moved to reopen discovery. In order to reopen a now-expired discovery period, Registrant must establish “excusable neglect.” Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co., 55 USPQ2d 1848, 1852 (TTAB 2000) (“Pursuant to Fed. R. Civ. P. 6(b)(2), the requisite showing for reopening an expired period is that of excusable neglect.”). Respondent argues that its failure to follow discovery rules and deadlines was “excusable neglect” due to a “calendar error” which Respondent attempts to blame on Petitioner by arguing that Petitioner failed to proctor Respondent’s compliance with the discovery schedule set forth in the TTAB Order dated December 31, 2105. This argument is both outrageous and based on a false premise.

The crux of Respondent’s argument is that its calendar error resulted from Petitioner’s failure to tell Respondent that it’s initial disclosures were due prior to issuing discovery requests. Respondent states:

“In sum, petitioner did not at any time refer to, or bring to Registrant’s attention, Petitioner’s non-receipt of Registrant’s initial disclosures document and waited until after the close of discovery, Notwithstanding communications registered prior to the closing discovery regarding petitioners failure respond to registrants requests, and a blatant act of gamesmanship.”

In addition to being an entirely frivolous argument, it is built upon faulty logic. First, it assumes Respondent *actually served initial disclosures in a timely manner*. By its own admission Registration did not serve initial disclosures until after the close of discovery. Second, it assumes that Petitioner has an obligation to “babysit” Respondent and make sure that Respondent followed the rules. No such obligation exists and is contrary to the advocacy system. Respondent

outrageously characterizes Respondent's own gross negligence in failing to follow the rules as Petitioner's "gamesmanship." Lastly, it is important to note that all of Respondent's arguments that Petitioner failed to timely respond to discovery requests are based the false premise that the requests had been properly served upon Petitioner.

The requirement that parties to make reciprocal initial disclosures was introduced into Board inter partes proceedings by the Notice of Final Rulemaking, Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242 (Aug. 1, 2007) ("Final Rule"). Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC, 88 USPQ2d 1541 (2008). "[T]he obligation of parties to make initial disclosures is integral to the efficient conduct of Board proceedings and not an obligation to be taken lightly by the parties." Id.

In opposition, Petitioner argues that Respondent is responsible for following the rules and meeting applicable deadlines. Petitioner claims that it acted in good faith and was under no obligation to inform Respondent of its intentions prior to its deadline for doing so. Petitioner also points out that: (1) after serving its untimely initial disclosures, Respondent has not re-served its discovery requests; (2) Respondent has not requested that the Board reopen the deadline for serving initial disclosures; and (3) Respondent did not seek Petitioner's consent to extending the discovery period before it closed.

1. Respondent's failure to follow discovery rules and procedures is due to gross negligence, not "excusable neglect" and Respondent's motion to compel must be denied.

Despite Respondent's admitted negligence, Respondent now seeks to avoid the consequences of its misconduct under a manufactured theory of "excusable neglect." Respondent's "calendar error" does not establish that Respondent's failure to timely serve initial disclosures was the result of excusable neglect. Petitioner argues that Registrant's motion

to compel should be denied because Registrant violated Trademark Rule 2.120(a)(3) by not serving initial disclosures before serving its discovery requests.

A. Opposition to Respondent’s Excusable Neglect Claim

Registrant claims its failure to serve its initial disclosures due to a “calendaring error” was the result of excusable neglect. There are four factors to look at in determining excusable neglect: (1) the danger of prejudice to the non-moving party, (2) the length of the 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 acted in good faith. Pioneer Investment Services Company v. Brunswick Associates Limited Partnership, 507 U.S. 380, 395 (1993).

Courts have held that the third factor may be considered the most important factor in a particular case. Pioneer at 386. Therefore, Petitioner begins the analysis here. In Dating DNA, LLC v. Imagini Holdings, LTD., a trademark opposition proceeding, the Trademark Trial and Appeal Board (TTAB) denied motions to compel discovery against the opposer, the party that failed to serve its initial disclosures. Dating DNA, Opposition Nos. 91185884 and 91191912, (TTAB 2010). There, the respondent failed to send initial disclosures until well after the deadline due to an alleged “clerical oversight.” Id. The Dating DNA case is nearly identical to the present situation and provides clear precedent and reasoning for denying Respondent’s motion.

In Dating DNA, The TTAB found the second and third factors of excusable neglect to be the most important and weighed them against the opposer. Id. The TTAB considered the third factor first: “opposer’s entirely unexplained “oversight” in not timely serving initial disclosures, and its failure to seek an extension of the discovery period before it closed” and determined these were “entirely within opposer’s reasonable control.” Id. The TTAB stressed that, “after opposer

received applicant's initial disclosures, [o]pposer should have realized it might have a parallel obligation to send its own Initial Disclosures” Id.

Additionally, the TTAB faulted opposer's failure to “explain the nature of the “oversight,” how it occurred or how it prevented opposer from taking action.” Id. The TTAB concluded “opposer has therefore not established that its failure to serve initial disclosures was outside of its reasonable control.” *HKG Industries Inc. v. Perma-Pipe Inc.*, 49 USPQ2d 1156, 1158 (TTAB 1998) (finding that petitioner failed to establish excusable neglect because it did not provide “critical factual information” about its attorney's death, or explain why other attorneys with petitioner's law firm could not have taken action).

In addition to the afore-mentioned errors, the TTAB stated that opposer's failure to seek an extension of discovery was another critical mistake:

“most importantly, opposer's “oversight” or “clerical error” in failing to timely serve initial disclosures does not in any way excuse its failure to seek an extension of the discovery period before that period closed. In fact, “opposer neither contends that it was unaware of the discovery and trial deadlines nor that it was in any way prevented from taking action.” *Atlanta- Fulton County Zoo Inc. v. DePalma*, 45 USPQ2d 1858, 1859 (TTAB 1998). Therefore, this factor weighs heavily against a finding of excusable neglect.”

Applying the Dating DNA opinion's reasoning on the third factor to the present case demonstrates that - on this factor alone - Respondent's motion must be denied. Like the opposer in Dating DNA, Respondent fails to explain how it's “calendar error” prevented it from taking action. Also, just like the opposer in Dating DNA, Respondent should have realized upon receiving Petitioner's Initial Disclosures it might have a parallel obligation to send its own. like

the opposer in Dating DNA, Respondent could have and should have filed a motion to compel discovery prior to the close of the discovery period, but failed to do so. Respondent has simply not established that its failure to serve initial disclosures was outside of its reasonable control.

Turning to the second factor, the length of delay and its potential impact, this too weighs against the Respondent. The TTAB in Dating DNA found that a delay of serving Initial Disclosures of seventeen days after the closing of discovery to be significant, and weighed the second factor against the opposer. Id. Here, the Initial Disclosures were not served until September 28, 2016, over five months late, five months and three days after Petitioner served its Initial Disclosures, and twenty one days after the close of discovery, which is a significant delay. Moreover, it appears unlikely that Respondent would ever have served Initial Disclosures had Petitioner not provided notice of their absence. The delay here, longer than the significant delay in Dating DNA, means this factor weighs against a finding of excusable neglect.

Lastly, turning to the remaining factors of the “excusable neglect” analysis, the first factor, prejudice to the non-moving party, weighs against the Respondent, while the fourth factor, good faith, is at best neutral. If discovery is now reopened and Petitioner is ordered to recommence discovery, Petitioner will incur costs and delays that could easily have been avoided. In fact, Petitioner is incurring costs by responding to this motion and responding to a frivolous motion for sanctions. As the Dating DNA Board stated “opposer’s delay in serving initial disclosures was significant, and opposer did not serve its initial disclosures until after it was informed by applicant.” The same is true here. Petitioner does not claim that Respondent acted in bad faith. However, Respondent was grossly negligent with respect to following the rules.

Weighing all the factors together, the Respondent has not established that its delay was outside of its reasonable control, and the length of the delay was meaningful. Accordingly, opposer has not established excusable neglect, and its motion must be denied. Similarly, Trademark Rule 2.120(a)(3) provides that “[a] party must make its initial disclosures prior to seeking discovery.” Respondent failed to comply with this Rule, and accordingly its motion to compel must be denied.

B. No Obligation to Inform

Respondent claims that Petitioner was obligated to inform Respondent that the Initial Disclosures had not been served and that Petitioner didn’t intend to respond to the discovery requests. However, Petitioner is under no obligation to do this, nor is Petitioner under any obligation to respond to Respondent’s discovery requests until the Initial Disclosures are served.

Trademark Rule 2.120(a)(3) provides that “[a] party must make its Initial Disclosures prior to seeking discovery...” According to the TTAB, that Petitioner did not inform Registrant of its position until after discovery closed is not necessarily a function of Petitioner attempting to game the system, but is instead a function of Registrant’s failure to follow the Trademark Rules for discovery procedures. *Id.* Petitioner acted in good faith and is under no obligation to inform the Registrant before discovery is closed that it would not be responding to the discovery requests. Since Petitioner was under no obligation to inform Respondent that the Initial Disclosures had not been served, the motion to compel discovery must be denied.

2. Respondent’s failure to follow discovery rules and procedures is not grounds for Sanctions and Respondent’s Motion for Sanctions must be denied.

As noted above, Respondent failed to follow the discovery rules and procedures, failed to produce any evidence in response to Petitioner’s requests and is now in a fatal position, having no evidence to counter or refute Petitioner’s claim of priority. Such desperation has caused

Responded to blame it woes on Petitioner and to seek sanctions in the nature of dismissal of the Petition and a litany of lesser sanctions that would effectively bar Petitioner from prosecuting its case.

Under Trademark Rule 2.120(a)(2), initial disclosures must be made no later than thirty days after the opening date of discovery, and under Trademark Rule 2.120(a)(3) a party cannot seek discovery until it has made its initial disclosures, absent modification of this requirement by stipulation of the parties approved by the Board, on motion granted by the Board, or by order of the Board. Kairos Institute of Sound Healing LLC, 88 USPQ2d 1541 (2008).

Pursuant to the Board's December 31, 2015 Order resetting the trial dates, the parties' reciprocal Initial Disclosures were due April 11, 2016. Petitioner served its Initial Disclosures on April 8, 2016, but opposer did not serve its Initial Disclosures until September 29, 2016, over five months late, five months and three days after Petitioner served its Initial Disclosures, and twenty one days after the close of discovery.

The Kairos case is particular enlightening here. In Kairos, an opposer failed to make the required initial disclosures within the prescribed time period. Applicant made timely disclosures and later moved for sanctions against opposer, arguing that dismissal of the Opposition would be an appropriate sanction under Trademark Rule 2.120(g)(1). Id. The Board denied the motion for sanctions because the opposer in the case "could not be said to have ignored an Order of the TTAB." Id. The Board stated "Sanctions are appropriate under Rule 2.120(g)(1) of the Trademark Rules of Practice in situations where a party fails to comply with an Order of the Trademark Trial and Appeal Board or under Rule 2.120(g)(2) where a party fails to make initial disclosures or expert testimony disclosures and informs the party entitled to receive such disclosures that no such information will be forthcoming." Because the applicant had not filed a

motion to compel and because there was no order from the Board, the TTAB held that the motion for sanctions was in the nature of dismissal, was premature, and therefore denied.

What becomes strikingly apparent is the fact that Respondent is in violation of an Order by the Board, not Petitioner. In this case, Petitioner complied with its discovery obligations. Respondent did not. Respondent waited until AFTER the close of discovery to serve its Initial Disclosures and bring a motion to compel. Respondent's motion for sanctions is not based on any violation of a Board order by Petitioner.

Given respondent's conduct, the observations of the Kairos Board are particularly insightful:

“[A]pplicant's motion for sanctions in the nature of dismissal is premature and is denied. If applicant here had first filed, and the Board had granted, a motion to compel the disclosures, and opposer had thereafter failed to timely provide them, or provided inadequate disclosures, applicant would then have been able to move for sanctions. Under such circumstances, the question of what sanction, if any, would be appropriate, would be committed to the discretion of the Board. “The Board must retain the discretion to tailor sanctions to the particular circumstances of each case.” Final Rule 72 F.R. at 42256.6

While applicant's motion for sanctions has been denied, we add that opposer is now warned that it must adhere to the provisions of applicable rules and that its lax approach to its initial disclosure obligation may be considered as an aggravating factor if applicant has occasion to file a later motion for sanctions under Trademark Rule 2.120(g).” (footnotes omitted)

Since Petitioner is not in violation of any Board order, Respondent's motion is premature (and meritless) and, therefore, must be denied.

CONCLUSION

Respondent's motions must be denied. Respondent failed to serve Initial Disclosures prior to seeking discovery, in accordance with Trademark Rule 2.120(a)(3). Respondent failed to file a motion to reopen discovery after discovery closed. Even presuming that respondent had followed the rules, and that its motion to compel disclosure is timely and permitted, Respondent has failed to establish "excusable neglect," and the Petitioner was under no obligation to inform Respondent that Respondent had failed to serve Initial Disclosures. Therefore Respondent's motion to compel must be denied. Similarly Respondent's motion for sanctions must be denied since Petitioner is not in violation of any Board order as required by Trademark Rules 2.120(g)(1) and 2.120(g)(2).

Respectfully submitted,

[signed] /david m. adler/

David M. Adler, Esq.
Adler Law Group
300 Saunders Road, Suite 100
Riverwoods, Illinois 60015
Phone: (866) 734-2568
ISBA #6242403

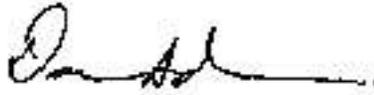
Dated: October 19, 2016

CERTIFICATE OF SERVICE

David M. Adler, an attorney, certifies that pursuant to 28 U.S.C. 1746, under penalties of perjury, he caused a copy of the **PETITIONER'S BRIEF IN OPPOSITION TO RESPONDENT'S MOTION TO COMPEL DISCOVERY AND/OR MOTION FOR SANCTIONS** to be served upon:

Counsel for Registrant
KUSCHA HATAMI
HP LAW GROUP
1300 MONTECITO AVENUE, UNIT NO 20
MOUNTAIN VIEW, CA 94043

via by placing the same in a United States Post Office Box located at 300 Saunders Road, Riverwoods, Illinois, postage prepaid with courtesy copies via electronic mail, this October 19, 2016.



By:

David M. Adler, Esq.

David M. Adler, Esq.
Adler Law Group
300 Saunders Road, Suite 100
Riverwoods, Illinois 60015
Phone: (866) 734-2568
ISBA #6242403

IN THE UNITED STATES PATENT & TRADEMARK OFFICE
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TURN-KEY VACATION RENTALS, INC.,
a California corporation,

Petitioner,

v.

THOMAS CLARK,
an individual and resident of California,

Respondent.

Cancellation No. 92060599

Reg. No. 4340236

Mark: TURNKEY

Affidavit of David M. Adler

I, the undersigned, *do solemnly swear under penalty of perjury that*, based on my personal knowledge and experience, that the following statements are true:

1. I am the attorney for Petitioner.
2. On March 7, 2016, I wrote to opposing counsel, Kuscha Hatami via email to set a date and time for the initial discovery conference required by Federal Rule 26.
3. On March 9, 2016, I served opposing counsel with a letter outlining proposed answers to the items for discussion in the initial discovery conference. The proposed answers did not deviate from the default rules. A copy of the March 9, 2016 letter was sent via U.S. Mail and a courtesy copy via email. A true and correct copy of the March 9, 2016 letter is attached hereto as Exhibit A.
4. On March 9, 2016, opposing counsel replied via email that he would “review [the] proposed letter and send [me] ... comments before the end of the week.” A true and correct copy of opposing counsel’s March 9, 2016 email is attached hereto as Exhibit B.
5. On April 7, 2016, I wrote to opposing counsel inquiring about the status of his edits, revisions or modifications to the proposed answers to the items for discussion in the initial discovery conference.

6. On April 7, 2016, opposing counsel replied via email that he would respond that day or the next.
7. As of the date of this Affidavit, opposing counsel has not responded with any edits, revisions, modifications or objections to the answers to the items for discussion in the initial discovery conference.
8. On April 8, 2016, Petitioner served Respondent with Petitioner's Initial Disclosures.
9. Petitioner served its First Request to Admit on April 29, 2016, First Requests to Produce Documents on May 20, 2016, and First Set of Interrogatories on May 20, 2016.
10. On June 14, 2016, I wrote to opposing counsel advising him that Respondent's answers to Petitioner's discovery requests were late, that Respondent had failed to object to or deny the Requests to Admit and seeking to schedule the deposition of Respondent. A true and correct copy of the June 14, 2016 letter is attached hereto as Exhibit C.
11. Respondent did not respond to Petitioner's discovery requests until June 24, 2016, which response consisted entirely of objections and without providing a single responsive document.
12. Respondent served its First Request to Admit, First Requests to Produce Documents, and First Set of Interrogatories on July 29, 2016.
13. On September 16, 2016, I wrote to opposing counsel that Petitioner is not responding to Respondent's discovery requests and explaining the reasoning behind the decision. A true and correct copy of the September 16, 2016 letter is attached hereto as Exhibit D.
14. Petitioner did not serve its initial disclosures until September 29, 2016, AFTER the close of discovery (September 8, 2016) and only AFTER I had advised opposing counsel of the failure to do so (September 16th, 2016).

FURTHER AFFLIANT SAYETH NAUGHT.



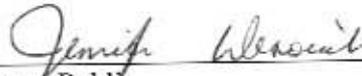
David M. Adler

Dated: October 17, 2016

STATE OF ILLINOIS)
)
COUNTY OF COOK)

This Affidavit of David M. Adler was subscribed and sworn to before me on this October 17, 2016.

AS WITNESS my hand and Notarial Seal.


Notary Public



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Riverwoods, Illinois 60015
Toll Free (866) 734-2568
www.adler-law.com

March 9, 2016

FRE 408
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VIA US MAIL AND EMAIL TO: hatami@legaledge.com

Mr. Kuscha Hatami, Esq.
PO BOX 644
CUPERTINO, CA 95015

Re: Cancellation No. 92060599 Turn-Key Vacation Rentals, Inc. v. Thomas Clark

Dear Kuscha,

I am writing as a follow-up to my email yesterday regarding our need to confer for purposes of the Discovery Conference /Federal Rule 26. I am leaving for Canada today due to a death in the family. I will have limited access to telephone and email until Monday March 14, 2016. This letter is my first draft of proposed answers to the items for discussion in the Discovery Conference:

1. Possibility for Settlement.

I have discussed with my client the requirements of Federal Rule 26(f), and whether there exists a possibility for a prompt settlement or resolution of the case. As you know Plaintiff sent a demand letter on February 22, 2016, to which Defendant served a reply on February 26, 2016. Given the gulf between the parties positions, my client doesn't see any likelihood of settlement in any reasonable amount of time.

2. Modifications to the discovery/trial calendar.

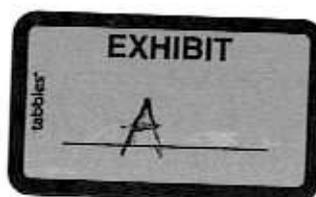
My client currently sees no need for modifications to the discovery/trial calendar but reserves the right to seek modification in relation to the existence of any discoverable information that may have a bearing on this matter.

3. Testimony.

Plaintiff is willing to stipulate to declaration testimony in lieu of deposition testimony.

4. Expert testimony and scheduling.

Expert testimony may be necessary on the issue of damages. Plaintiff does not have an expert at this time. Plaintiff shall disclose the existence of any expert and expert testimony upon which it may rely.



5. Preservation Duties.

I have advised my client on the duties with respect to preservation of discoverable information and presume you have done the same.

6. Discovery Plan.

I welcome your thoughts on the development of a discovery plan.

7. Electronically Stored Information

I do not foresee any issues about electronically stored information including the form of document production that may be required. I welcome your thoughts on the issue.

8. TTAB's Standard Protective Order.

I do not have any proposed changes to the TTAB's Standard Protective Order. I welcome your thoughts on any proposed changes.

With some advance notice, I can be available for a call on Friday, March 11, 2016, between 8am and 5pm EST.

I look forward to your prompt feedback.

Sincerely,



David M. Adler, Esq.

DMA/jb

Subject: Re: Cancellation No. 92060599 Turn-Key Vacation Rentals, Inc. v. Thomas Clark

From: Kuschka Hatami - To: david@adler-law.com - Date: March 9, 2016 at 2:47 PM, Attachments: 9FAEBFFF-794C-4BAE-B1C7-86A45CFCE9FF

Dear David,

I am very sorry to hear about your loss. I lost two very special people in my life last year, and you have my deepest condolences. I will review your proposed letter and send you my comments before the end of the week.

Kuschka

Best regards,

Kuschka Hatami

HP Law Group
Partner
Intellectual Property

Call me: 858.342.9621
Follow me: [Kuschka's Twitter](#)
Ask me: [Kuschka's Quora](#)

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On Wed, Mar 9, 2016 at 8:31 AM, David Adler <david@adler-law.com> wrote:

Hi Kuschka,

Please see attached correspondence.

Sincerely,

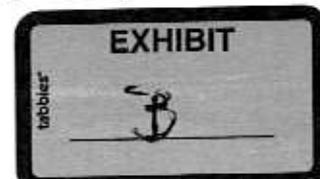
David M. Adler | Adler Law Group
Safeguarding Ideas, Relationships & Talent @
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[2016 Illinois Super Lawyer](#)

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The information in this electronic mail is intended for the named recipients only. It may contain privileged and confidential matter. If you have received this electronic mail in error, please notify the sender immediately by replying to this electronic e-mail or by collect call to [\(866\) 734-2568"> \(866\) 734-2568](tel). Do not disclose the contents to anyone. Thank you.

On February 26, 2016 at 4:16:06 PM, Kuschka Hatami (hatami@legaledgelaw.com) wrote:

FRE 408 Settlement Communication Only



June 14, 2016

VIA US MAIL AND EMAIL TO: hatami@legaledgelaw.com

Mr. Kuscha Hatami, Esq.
HP Law Group
Montecito Ave., No. 20
Mountain View CA 94043

Re: Cancellation No. 92060599 Turn-Key Vacation Rentals, Inc. v. Thomas Clark

Dear Kuscha,

I am writing to acknowledge receipt of the notice of change of address of your office and to follow up on some discovery matters.

In regard to the Petitioner's First Set of Interrogatories, these were served on you via US Mail with courtesy copies sent via email, on April 22, 2016. The deadline for response was May 22, 2016. On May 27, 2016, you asked for and received my consent to serve Responses on May 31, 2016.

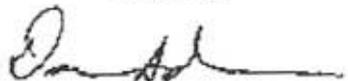
In regard to the Petitioner's First Set of Requests to Admit, these were served on you via US Mail with courtesy copies sent via email, on April 29, 2016. The deadline for response was May 29, 2016. The envelope was returned to sender as undeliverable at your registered address on May 26, 2016. As a courtesy, I have attached additional printed copies of the Requests to Admit.

In regard to the Petitioner's First Set of Requests to Produce Documents, these were served on you via US Mail with courtesy copies sent via email, on May 20, 2016.

In order to increase efficiency of scheduling Mr. Clark's deposition, can you please provide 3 days and times when Mr. Clark is available during the next 3-4 weeks?

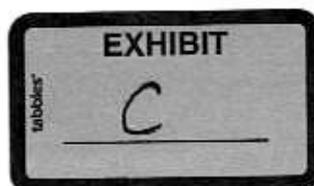
Please call me with any questions, comment or concerns. I welcome your suggestions on a path to a prompt resolution of this matter.

Sincerely,



David M. Adler, Esq.

DMA/jb
Encl. (1)





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September 16, 2016

PRE 408
Settlement Purposes Only

VIA CERTIFIED MAIL & EMAIL TO: hatami@legaledgelaw.com

Mr. Kuscha Hatami, Esq.
1300 Montecito Ave., No. 20
Mountain View CA 94043

Re: Cancellation No. 92060599
Turn-Key Vacation Rentals, Inc. v. Thomas Clark

Dear Mr. Hatami,

Thank you for your email correspondence dated September 12, 2016. My client declines the settlement offer contained in that email.

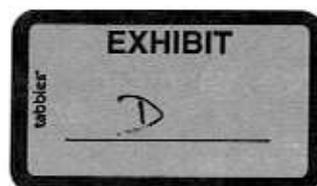
It appears that there may be some confusion about discovery in this matter. While I appreciate your continuing efforts to get your client to assent to stipulated testimony instead of deposition testimony, at this date it is a moot point since discovery closed on September 8, 2016.

You are correct that Petitioner has not responded to the Respondent's purported discovery requests. As you know, you never served Respondent's Initial Disclosures which are required by Trademark Rule 2.120(a)(3).

Unless and until Initial Disclosures are made, an opposing party has no obligation to respond to discovery requests. Since discovery is now closed, Respondent cannot seek any discovery, has not disclosed any evidence and has nothing on which it might rely that would refute or impeach any of the Petitioner's evidence. If you have any doubt about this conclusion, I suggest you review *Dating DNA, LLC v. Imagini Holdings, Ltd.*, 94 USPQ2d 1889 (TTAB 2010).

In contrast, Petitioner did make its initial disclosures and has ample evidence to support a finding of priority in this Cancellation matter. Therefore, I believe that cancellation of the Respondent's trademark registration is now a foregone conclusion.

You may also be familiar with *B2B Hardware, Inc. v. Hargis Industries, Inc.*, 134 S. Ct. 2899 (US 2014). Petitioner has already suffered numerous and documented instances of consumer confusion between the Respondent's "Turnkey" mark and Petitioner's use of the Turn-Key Vacation Rentals mark. Once the Cancellation is finalized, Petitioner shall seek damages for this trademark infringement as

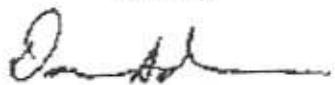


K. Hatami
September 16, 2016
Page 2

well as injunctive relief preventing your client's use of any mark that is confusingly similar to Turn-Key Vacation Rentals, including "Turnkey."

Please feel free to contact me with any questions or comments you may have.

Sincerely,



David M. Adler, Esq.

DMA/jb

Certificate of Mailing

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.



By:

David M. Adler, Esq.
Attorney for Petitioner
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