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

Proceeding	92062182
Party	Plaintiff AFAB Industrial Services, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

AFAB INDUSTRIAL SERVICES, INC.

Petitioner,

v.

PAC-WEST DISTRIBUTING NV LLC,

Registrant.

Cancellation No. 92062182

Registration No. 4,187,497

Mark: PWD

Registration No. 1,112,095

Registration No. 4,541,507

Mark: RUSH

Registration No. 2,538,037

Mark: POWER PAK PELLETT

**REPLY OF PETITIONER AFAB INDUSTRIAL SERVICES, INC.
IN SUPPORT OF MOTION FOR FED. R. CIV. P. 56(d) DISCOVERY**

Registrant, Pac-West Distributing NV LLC's ("Registrant" or "PWD") Response in Opposition ("Response") to the pending Motion for Fed. R. Civ. P. 56(d) ("Discovery Motion") only demonstrates Registrant's efforts to mask the true nature of the products being marketed and sold under the challenged Marks. Registrant does not want discovery to proceed because it knows it will be required to disclose evidence that will support Petitioner's claims and reveal the illegal nature of Registrant's products.

I. ARGUMENT

Registrant makes two arguments why discovery is not needed. First, Registrant suggests that Petitioner failed to investigate its claims in advance of initiating these proceedings. Second, Registrant attempts to argue that Petitioner conflated the instant Discovery Motion with another ongoing Opposition between the Parties. Neither argument is sufficient to deny Petitioner the opportunity to uncover factual evidence necessary to respond substantively to Registrant's Summary Judgment Motion.

A. Petitioner's Claims and Discovery Motion Are Well Supported¹

Registrant first argues Petitioner's Discovery Motion should be denied because Petitioner allegedly filed its Petition to Cancel without evidence to support its claims. This argument is belied by the pleadings and by the evidence submitted in support of the Petition to Cancel and Petitioner's Discovery Motion.

With respect to the pleadings, Registrant had the opportunity to, but declined to file a Motion to Dismiss the Petition to Cancel on the grounds that it failed to state a claim on which relief could be granted. Instead, Registrant tacitly acknowledged the pleadings were sufficient on their face by submitting its Answer, which denied the salient allegations. While Registrant may deny the allegations, it cannot in good faith argue the claims were factually insufficient.

Notwithstanding, Petitioner has come forth with ample evidence to demonstrate it took care to investigate its claims and is entitled to take discovery on the same. The Petition to Cancel itself provides evidence of products bearing the challenged Marks that contain the banned hazardous chemical. Petitioner's Discovery Motion bolstered those claims with evidence of Registrant's past and current use of its Marks in connection with Isobutyl Nitrite (in direct contradiction to the self-serving declaration Registrant submitted in support of its Summary Judgment Motion).

¹ Registrant also suggests Petitioner filed the instant action only to harass Registrant and "clog up the Board's already crowded docket." Yet, it has been Registrant that has burdened the parties and the Board with frivolous motions that only loosely comport with the Rules governing these proceedings.

Petitioner's Petition to Cancel and Discovery Motion call into question Registrant's claim and demonstrate Petitioner's need for discovery on evidence that lies solely with Registrant and perhaps, its licensees.

B. Registrant's Reference to Opposition Nos. 91224268 and 91224272 Actually Supports Granting Petitioner's Motion for Discovery

Registrant argues Petitioner has attempted to "conflate...two separate Opposition proceedings (Opposition Nos. 91224268 and 91224272)" to support this pending Motion. Registrant's argument is mistaken and, ironically, wholly supportive of Petitioner's pending Discovery Motion.

First, Registrant's argument is mistaken because Petitioner's Discovery Motion makes no mention of the other pending Oppositions cited by Registrant. Rather, Petitioner cited evidence of other pending trademark applications filed by Registrant for the PWD and RUSH marks that have been refused registration by the USPTO on the grounds that Registrant's use of the applied for marks is unlawful. *See* DKT No. 11, pp. 6-7. As Petitioner previously stated, Registrant's other pending applications challenge the veracity of Registrant's claims regarding its alleged non-use of a banned hazardous chemical and demonstrate Petitioner's need for discovery. Registrant has not challenged these claims.

Second, while Petitioner did not mention the Oppositions to which Registrant referred, those consolidated proceedings actually support granting Petitioner its requested discovery in this proceeding. Therein, Registrant (Applicant) filed similar and separate motions for summary judgment before the opening of discovery. *See generally*, Opp. No. 91224268, DKT No. 9 and Opp. No. 91224272, DKT No. 8. After the proceedings were consolidated,

Petitioner (Opposer) submitted a Motion for Discovery under Rule 56(d). *See generally*, Opp. No. 91224268, DKT No. 11 (“Petitioner’s Other Discovery Motion”).

On May 4, 2016, the Board denied both of Registrant’s (Applicant’s) Summary Judgment Motions outright, rendering Petitioner’s Other Discovery Motion moot. *See id.*, DKT No. 14 (<http://ttabvue.uspto.gov/ttabvue/v?pno=91224268&pty=OPP&eno=14>). In that Order, the Board noted Registrant (Applicant) provided no evidence that its goods complied with the “commercial purpose” requirement of 15 U.S.C. §§ 2057a and 2057b. *See id.*, p. 5. The Board concluded there were genuine disputes as to “the precise nature and purpose of [Registrant’s] goods; whether the goods may be lawfully sold in commerce; and whether [Registrant] knowingly made material misrepresentations regarding the identified goods in the involved applications.” *Id.*, pp. 5-6.

Here, the Board faces a similar request for discovery. Registrant relies on superficial denials of the claims and provides no substantive evidence to demonstrate the true nature of its use of the challenged Marks and whether such use lawfully comports with the limitations of 15 U.S.C. §§ 2057a and 2057b. As noted above, Registrant’s self-serving denials are contradicted by the claims made in the Petition to Cancel and in support of Petitioner’s Discovery Motion.

The fact is questions remain unanswered regarding the legality of Registrant’s use of the challenged Marks. Answers to those questions are in Registrant’s possession and Petitioner’s proposed discovery is directed to answering those questions. Those answers would permit Petitioner to respond substantively to Registrant’s Summary Judgment Motion and the Board to make a reasoned decision.

II. CONCLUSION

Registrant claims its use of the challenged Marks is lawful. Registrant's Summary Judgment Motion goes directly to the heart of that claim. Petitioner cannot respond substantively to that claim without being afforded discovery on the nature and extent of Registrant's use of the challenged Marks. Nor should the Board decide such a dispositive motion on mere allegations. Thus, Petitioner's Discovery Motion is well founded and should be granted.

Respectfully submitted,

Date: May 11, 2016

/Sean P. McConnell/

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CERTIFICATE OF SERVICE

I, Sean P. McConnell, hereby certify that on May 11, 2016, a true and correct copy of the foregoing Reply of Petitioner AFAB Industrial Services, Inc. in Support of Motion for Fed. R. Civ. P. 56(d) Discovery has been served via Email and U.S. First Class Mail, postage prepaid, to:

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