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

Proceeding	92062400
Party	Plaintiff AvalonBay Communities, Inc.
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Date	07/08/2016
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

AvalonBay Communities, Inc.,

Petitioner,

v.

Avalon IP Holding Co., LLC,

Registrant.

Cancellation No. 92062400

**PETITIONER’S OPPOSITION TO REGISTRANT’S
MOTION FOR EXTENSION OF TIME**

In connection with the above-captioned cancellation proceeding, Petitioner AvalonBay Communities, Inc. (“Avalon”) files this Opposition to the Motion for Extension of Time (the “Motion for Extension”) filed by Avalon IP Holding Co., LLC (“Avalon IP”), and respectfully requests that the Trademark Trial and Appeal Board (the “Board”) deny the motion.

I. INTRODUCTION

By its Motion for Extension, Avalon IP requests a 60-day extension of all remaining deadlines in the cancellation action. However, Avalon IP provides no “good cause” for requesting such an extension. Instead, Avalon IP admits that the parties have exchanged written discovery and produced a significant number of documents during over five (5) months of an uninterrupted discovery period. Avalon has acted diligently in its discovery efforts throughout the discovery period, thereby obviating the need for any additional discovery or extensions. Because there is no good cause for additional discovery and an extension will only prejudice Avalon, Avalon respectfully requests that the Motion for Extension be denied.

II. FACTS

To demonstrate that there has been ample time for discovery in this cancellation action, Avalon provides the following timeline:

- October 6 & 7, 2015: Petitioner Avalon files the instant proceeding, and the discovery deadline is initially set for June 13, 2016. (1 & 2 TTABVUE).
- November 13, 2015: Registrant Avalon IP's motion for extension of time to answer (with Avalon's consent) is granted, resetting the discovery deadline to July 13, 2016. (5 & 6 TTABVUE).
- December 16, 2015: Avalon IP files its Answer. (7 TTABVUE).
- January 15, 2016: Discovery in this case opens. (6 TTABVUE 1).
- March 3, 2016: Avalon IP serves its First Set of Requests for Admission, Interrogatories, and Requests for Production of Documents and Things to Petitioner. (Raimer Decl., ¶ 2).¹
- March 28, 2016: Avalon serves its First Set of Requests for Admission, Interrogatories, and Requests for Production of Documents and Things to Registrant. (*Id.* at ¶ 3).
- April 4, 2016: Avalon timely responds to discovery requests. (*Id.* at ¶ 4).
- April 12, 2016: Avalon produces documents bates numbered AVA 000001 – AVA 004142 to Avalon IP. (*Id.* at ¶ 5).
- May 2, 2016: Avalon IP timely responds to discovery requests. (*Id.* at ¶ 6).
- May 2, 2016: Avalon IP sends Avalon a letter alleging deficiencies in Avalon's discovery responses. (*Id.* at ¶ 7; Nye Decl., ¶ 4, Exh. C).²

¹ Cites to Raimer Decl. are to the Declaration of Anna E. Raimer In Support of Registrant's Opposition to Petitioner's Motion for Extension, filed herewith.

- May 10, 2016: Avalon sends a letter advising Avalon IP of deficiencies in its discovery responses; Avalon separately produces additional documents bates numbered AVA 004143 – AVA 006229 to Avalon IP, and also serves a Second Set of Requests for Admission on Avalon IP. (Raimer Decl., ¶¶ 8-9).
- May 23, 2016: Avalon IP produces documents bates numbered AIH000001-001560 to Avalon. (*Id.* at ¶ 10).
- May 24, 2016: Avalon responds by letter to Avalon IP’s May 2, 2016 letter, advising that it maintains all objections and articulating why its responses are sufficient. (*Id.* at ¶ 11; Nye Decl., ¶ 5, Exh. D).
- June 3, 2016: Avalon IP responds by letter to Avalon’s May 10, 2016 letter regarding Avalon IP’s deficient discovery responses. (*Id.* at ¶ 12).
- June 8, 2016: Avalon produces additional documents bates numbered AVA 006230 – AVA 006385 to Avalon IP. (*Id.* at ¶ 13).
- June 13, 2016: Avalon consents to Avalon IP’s request for a two-week extension of the expert disclosure deadline; neither party serves expert disclosures by the new deadline of June 27, 2016. (*Id.* at ¶ 14).
- June 14, 2016: Avalon IP responds to Avalon’s Second Set of Requests for Admission, denying all of the requests. (*Id.* at ¶ 15).
- June 14, 2016: Call between the parties’ counsel to discuss discovery issues; counsel for Avalon notes that Avalon believes the remaining time for discovery is

(continued...)

² Cites to Nye Decl. are to the Declaration of Katherine Dennis Nye In Support of Registrant’s Motion to Compel, filed at 9 TTABVue 8.

sufficient but agrees to discuss with Avalon whether it would be amenable to Avalon IP's request for an extension. (*Id.* at ¶ 16; Nye Decl., ¶ 7).

- June 15, 2016: Avalon IP emails regarding the parties' call (Nye Decl., ¶ 8, Exh. F), and Avalon sends a letter memorializing that same call, including consenting to Avalon IP's requested 60-day extension on the condition that "no further extensions of the new deadlines will be requested or observed except by further agreement of the parties in this proceeding." (Raimer Decl., ¶ 17, Exh. 1).
- June 15, 2016: Avalon serves three deposition notices, which were scheduled for July 5-7, 2016. (Raimer Decl., ¶ 19, Exh. 2).
- June 17, 2016: Avalon IP serves its First Amended and Supplemental Answers and Objections to Petitioner's First Set of Interrogatories and to Petitioner's First Set of Requests for Admission. (*Id.* at ¶ 20).
- June 22, 2016: Avalon IP produces documents bates numbered AIH01574 – 1599 (*Id.* at ¶ 21); Avalon IP writes to Avalon noting that its deposition witnesses will not be available for the week noticed without providing alternate dates, and advises that Avalon IP "cannot agree to forego any further requests for extension, as it is not yet clear how quickly the parties will be able to complete discovery." (*Id.* at ¶ 22, Exh. 3).
- June 23, 2016: Avalon IP files its Motion for Extension and Motion to Compel, with no prior notice to Avalon. (*Id.* at ¶ 23; 8 & 9 TTABVUE).
- June 24, 2016: Avalon responds to Avalon IP's June 22, 2016 letter, requesting that Avalon IP provide proposed alternate deposition dates by July 1, 2016, and

clarifying that Avalon does not agree that any further extension of time is necessary or appropriate. (Raimer Decl., ¶ 24, Exh. 4).

- July 5, 2016: Avalon IP reiterates that its witnesses will not be available as noticed, but again does not provide alternate dates; Avalon again requests alternate dates for the depositions by letter. (*Id.* at ¶ 25, Exhs. 5 & 6).
- July 7, 2016: Avalon provides its First Amended Answers and Objections to Petitioner's First Set of Requests for Admission. (*Id.* at ¶ 26).
- July 7, 2016: Avalon IP responds to Avalon's July 5, 2016 letter by email, advising that its witnesses will be available September 13-15, 2016. (*Id.* at ¶ 27, Exh. 7).
- July 13, 2016: Discovery deadline. (5 & 6 TTABVUE).

As this timeline shows, there has been over five (5) months of available discovery time in this proceeding. During this time, Avalon has timely served responses to discovery (without seeking any extensions) including substantial document productions responsive to Avalon IP's requests. As evidenced by the above timeline, as well as the parties' correspondence and additional discovery responses, Avalon IP's only remaining concerns regarding Avalon's discovery responses involve the Requests for Production subject to the Motion to Compel. All issues regarding Avalon's responses to Avalon IP's Requests for Admission and Interrogatories have been resolved. (Raimer Decl., ¶¶ 17-18, Exh. 1).

III. ARGUMENT

Good cause must be shown for the Board to grant an extension of the discovery period. *See* Fed. R. Civ. P. 6(b)(1); *Nat'l Football League, NFL Properties LLC v. DNH Management, LLC*, 85 U.S.P.Q.2d 1852, 1854 (T.T.A.B. 2008). As the party seeking to extend a discovery

deadline, Avalon IP has the burden of convincing the Board that it has been diligent in meeting its discovery obligations and that “good cause” merits an extension. *Nat’l Football League*, 85 U.S.P.Q.2d at 1854. The Board should “scrutinize carefully” a motion to extend to determine whether good cause has been shown, including “the diligence of the moving party during the discovery period.” *Luemme, Inc. v. D.B. Plus Inc.*, 53 U.S.P.Q.2d 1758, 1760 (T.T.A.B. 1999). Furthermore, an extension of time must not prejudice the non-moving party. *See Pumpkin Ltd. v. The Seed Corps*, 43 U.S.P.Q.2d 1582, 1586 (T.T.A.B. 1997).

A. There Is No Good Cause for the Requested Extension.

There is no good cause to extend all remaining deadlines in this proceeding. Avalon IP has been given over five months to complete discovery on its defenses and Avalon’s claims. The discovery already received by Avalon IP includes responses to interrogatories, requests for admission, and requests for production, as well as over 6,000 pages of documents. (Raimer Decl., ¶¶ 4, 5, 9, 13). Such responses have been served timely without any requests for extension by Avalon, thereby allowing ample time for follow-up by Avalon IP. (*Id.*).

Avalon IP does not articulate any particular need, let alone good cause, for additional discovery. A motion to extend must state with particularity the grounds upon which it is based, which Avalon IP’s Motion for Extension fails to do. *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 U.S.P.Q.2d 1719, 1720 n. 3 (T.T.A.B. 1989) (“The presentation of one’s arguments and authority should be presented thoroughly in the motion or the opposition brief thereto.”); *see also HKG Industries, Inc. v. Perma-Pipe, Inc.*, 49 U.S.P.Q.2d 1156, 1158 (T.T.A.B. 1998) (motion to reopen denied because the movant failed to provide detailed factual information in support of the requested relief). *Cf. Instruments SA Inc. v. ASI Instruments Inc.*, 53 U.S.P.Q.2d 1925, 1927 (T.T.A.B. 1999) (“Cursory or conclusory allegations that are denied

unequivocally by the non-movant, and that are not otherwise supported by the record, will not constitute a showing of good cause.”).

The only discernible reason³ given in the Motion for Extension to extend the deadlines is that “[b]oth parties have . . . raised concerns regarding the sufficiency of the other’s responses and production.” (Motion for Extension, p. 1, ¶ 3). However, as demonstrated by the parties’ correspondence and Avalon IP’s Motion to Compel filed concurrently with this Motion for Extension, Avalon IP continues to take issue with only a handful of Avalon’s responses to the Requests for Production. Any such outstanding concerns do not warrant extending the deadlines in this proceeding as the rules provide for resolving discovery disputes following the close of discovery, such that discovery issues need not be resolved during the discovery period. *See, e.g.*, 37 CFR § 2.120(e) (“A motion to compel discovery must be filed prior to the commencement of the first testimony period as originally set or as reset.”). Furthermore, Avalon IP has not alleged—nor could it—that a supplemental production to the requests at issue in the Motion to Compel would lead to relevant follow-up discovery requests. Indeed, Avalon IP has failed to elucidate *any* further discovery that it seeks to take in this case, much less describing why such discovery could not have been obtained during the discovery period.

To the extent that Avalon IP is implying in its Motion for Extension that the deposition notices served by Avalon on June 15, 2016 are a reason to extend discovery (Motion for Extension, p. 1, ¶ 5), Avalon strongly disagrees. These deposition notices were served a full month before the end of the discovery period and were noticed for dates prior to the close of discovery that gave reasonable notice to Avalon IP. (Raimer Decl., ¶ 19, Exh. 2). Therefore, there is no good cause for an extension based on such deposition notices. Notably, despite

³ As the Motion for Extension is written, Avalon is unable to determine the reason given for the requested extension. Avalon IP also fails to provide any case law in support of its Motion for Extension.

repeated requests from Avalon, Avalon IP refused to provide its witnesses' availability for these depositions (noticed for July 5-7, 2016) until July 7, 2016, at which point Avalon IP advised that its witnesses would not be available until September 13-15, 2016. (*Id.* at ¶¶ 22-25, 27, Exhs. 3-7).

In addition, to the extent that Avalon IP suggests that it has had limited time to review Avalon's discovery (Motion for Extension, p. 1, ¶ 3: "Petitioner [] produced over 6,000 documents to Registrant, some as recently as June 8, 2016"), in fact, Avalon produced the bulk of documents to Avalon IP on April 12, 2016 (AVA 000001 – AVA 004142) and May 10, 2016 (AVA 004143 – AVA 006229). (Raimer Decl., ¶¶ 5, 9). Hence, Avalon IP had over ten weeks and six weeks, respectively, to review the vast majority of Avalon's documents before filing its Motion for Extension, and Avalon IP cannot now claim that 156 pages of documents produced June 8, 2016 (with bookmarks labeling each section of documents) present a serious difficulty to completing discovery prior to the July 13, 2016 deadline. (*Id.* at ¶ 13) ("On June 8, 2016, Avalon produced . . . documents bates numbered AVA 006230 – AVA 006385.").

Avalon IP also claims that Avalon agreed to conditionally consent to a 60-day extension due to an apparent recognition of the need for additional time to complete discovery. (Motion for Extension, p. 2, ¶ 6). As noted in correspondence dated June 24, 2016, Avalon denied that any additional time is necessary. (Raimer Decl., ¶ 24, Exh. 4). Rather, Avalon timely served all discovery requests that it deemed necessary to succeed in this cancellation action prior to the close of discovery and, indeed, prior to the June 23, 2016 date by which Avalon IP served this Motion for Extension. (*Id.* at ¶¶ 3, 9). The conditional grant of an extension was made in the spirit of cooperation and to avoid burdening the Board with unnecessary motion practice; however, Avalon was unwilling to agree to an unlimited number of further extensions that would

effectively give Avalon IP a free pass to delay a decision on the merits with additional unconsented extensions going forward. (*Id.* at ¶ 17).

Finally, as noted in the Motion for Extension, Avalon agreed to a two-week extension of the expert disclosure deadline. (Motion for Extension, p. 1, ¶ 4). However, neither party served expert disclosures by the agreed-upon June 27, 2016 deadline. (Raimer Decl., ¶ 14). To the extent that Avalon IP seeks to extend this deadline by sixty days, Avalon IP has provided no good cause for such an extension, and Avalon opposes the same.

B. An Extension of the Discovery Period Would Prejudice Avalon.

An extension of the discovery period in this case would only serve to benefit Avalon IP, to the detriment of Avalon. Avalon IP has had sufficient time to take discovery over an uninterrupted five month period of time. Indeed, Avalon stands ready to move forward with this cancellation action based on the discovery timely served during the discovery period (which includes the depositions of Avalon IP witnesses).

Unlike Avalon IP, Avalon has diligently sought and served discovery, and would be prejudiced by an extension of the discovery period, including the imposition of added costs, time, and delays, to respond to any additional discovery requests by Avalon IP. *See Gaylord Entm't Co. v. Calvin Gilmore Prods., Inc.*, 59 U.S.P.Q.2d 1369, 1370-71, 1373 (T.T.A.B. 2000) (finding that applicant “may well have been prejudiced” where applicant incurred additional costs and attorneys’ fees as a result of opposer’s delay). Tactically, Avalon IP has pursued the broadest, most burdensome and meritless discovery throughout this case. Avalon IP has further failed to engage in any meaningful substantive dialogue as to any form of ACR (Raimer Decl., ¶ 28), which would streamline the case and alleviate the burden on the Board and the parties. Rather, Avalon IP’s tactic is to impose delay and substantial discovery costs, taking advantage of Avalon’s near 3,000-person organization spread out throughout communities across the U.S.,

while only providing information from two individuals from its IP holding company. Avalon IP fails to articulate what additional discovery it needs in its Motion for Extension. But there is no doubt given its past position that additional written discovery or depositions would be burdensome and costly. In any event, Avalon IP fails to meet its burden as it provides no suggestion in the Motion for Extension of any particular evidence that Avalon IP has an expectation of finding with such added discovery that it could not have timely pursued earlier, or that would warrant further delay and expense on Avalon and necessitate enlarging the discovery time to complete.

Importantly, Avalon IP has had over five months to request depositions, and should not now be granted additional time to take them. *Nat'l Football League*, 85 U.S.P.Q.2d at 1854 (“When, as in this case, a party . . . did not attempt to depose its adversary during the prescribed discovery period, a motion to extend discovery will ordinarily be denied.”); *Luemme, Inc.*, 53 U.S.P.Q.2d at 1760-61 (denying motion to extend in part because petitioner “never made any effort to depose respondent during the initial discovery period”). This point is particularly pertinent as Avalon IP, on the parties June 14, 2016 call, stated that it anticipated “significant” deposition practice, yet failed to notice a single deposition. (Raimer Decl., ¶ 16).

This prejudice to Avalon is not outweighed by any “good cause” demonstrated by Avalon IP. As discussed above, it is Avalon IP’s failure to diligently pursue discovery during the discovery period that has created its alleged predicament. It had the chance to seek depositions and other discovery over the more than five-month discovery period but chose to file this Motion for Extension a few weeks before the close of discovery in an attempt to further drag out these proceedings and cause undue burden to Avalon. Avalon should not be prejudiced because Avalon IP did not seek the additional discovery it now supposedly wants (but fails to describe in

its motion) during the discovery period, particularly when Avalon has met all deadlines in this proceeding. The Motion for Extension itself has already tactically derailed the proceedings for no just reason.

IV. CONCLUSION

Avalon IP has not demonstrated good cause for its Motion for Extension, nor has Avalon IP met its burden to show diligence in meeting its discovery obligations. Avalon has established that it would be prejudiced by an extension of the discovery period. For all of the foregoing reasons, Avalon respectfully requests that the Board deny Avalon IP's Motion for Extension.

Respectfully submitted,

Dated: July 8, 2016

By: 

Anna E. Raimer
JONES DAY
717 Texas Avenue, Suite 3300
Houston, TX 77002
(832) 239-3786
aeraimer@jonesday.com

*Attorneys for Petitioner
AvalonBay Communities, Inc.*

CERTIFICATE OF SERVICE

It is hereby certified that a copy of the documents entitled Petitioner's Opposition to Registrant's Motion for Extension of Time and the Declaration of Anna E. Raimer in Support of the Opposition have been served upon Avalon IP this 8th day of July, 2016, via Federal Express, to Registrant's counsel:

LEE J. EULGEN

NEAL, GERBER & EISENBERG LLP

2 N. LASALLE ST., SUITE 1700

CHICAGO, IL 60602

A courtesy copy was also served via e-mail at knye@ngelaw.com, leulgen@ngelaw.com, and temanuelson@ngelaw.com.

Dated: July 8, 2016

Respectfully submitted,

By: Meredith Williams

Meredith L. Williams

JONES DAY

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Attorneys for AvalonBay Communities, Inc.

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

AvalonBay Communities, Inc.,

Petitioner,

v.

Avalon IP Holding Co., LLC,

Registrant.

Cancellation No. 92062400

**DECLARATION OF ANNA E. RAIMER IN SUPPORT OF PETITIONER'S
OPPOSITION TO REGISTRANT'S MOTION FOR EXTENSION OF TIME**

I, Anna E. Raimer, hereby declare and state as follows:

1. I am a Partner at the law firm of Jones Day, counsel to Petitioner AvalonBay Communities, Inc. ("Avalon") in the above-captioned action, and I have personal knowledge of the facts stated in this declaration.

2. On March 3, 2016, Avalon IP Holding Co., LLC ("Avalon IP") served its First Set of Requests for Admission, Interrogatories, and Requests for Production of Documents and Things to Petitioner Avalon.

3. On March 28, 2016, Avalon served its First Set of Requests for Admission, Interrogatories, and Requests for Production of Documents and Things to Registrant Avalon IP.

4. On April 4, 2016, Avalon timely responded to Avalon IP's discovery requests.

5. On April 12, 2016, Avalon produced documents bates numbered AVA 000001 – AVA 004142 to Avalon IP.

6. On May 2, 2016, Avalon IP timely responded to Avalon's discovery requests.

7. Also on May 2, 2016, Avalon IP sent Avalon a letter alleging deficiencies in Avalon's discovery responses.

8. On May 10, 2016, Avalon sent a letter advising Avalon IP of deficiencies in its discovery responses.

9. Also on May 10, 2016, Avalon produced additional documents bates numbered AVA 004143 – AVA 006229 to Avalon IP, and also served a Second Set of Requests for Admission on Avalon IP.

10. On May 23, 2016, Avalon IP produced documents bates numbered AIH000001-001560 to Avalon.

11. On May 24, 2016, Avalon responded by letter to Avalon IP's May 2, 2016 letter, advising that it maintains all objections and articulating why its responses are sufficient.

12. On June 3, 2016, Avalon IP responded by letter to Avalon's May 10, 2016 letter regarding Avalon IP's deficient discovery responses.

13. On June 8, 2016, Avalon produced additional documents bates numbered AVA 006230 – AVA 006385 to Avalon IP.

14. On June 13, 2016, Avalon consented to Avalon IP's request for a two-week extension of the expert disclosure deadline; neither party served expert disclosures by the new deadline of June 27, 2016.

15. On June 14, 2016, Avalon IP responded to Avalon's Second Set of Requests for Admission, denying all of the requests.

16. Also on June 14, 2016, I had a call with Avalon IP's counsel, Katherine Nye, regarding, discovery issues. Ms. Nye requested a 60-day extension of all remaining deadlines, in part, because Avalon IP expects "significant" deposition practice. I advised that Avalon believed the remaining time for discovery was sufficient but agreed to discuss with Avalon whether it would be amenable to Avalon IP's request for an extension.

17. On June 15, 2016, we received Avalon IP's email regarding the parties' call. The same day, I also sent a letter memorializing the call. In that letter, Avalon consents to Avalon IP's requested 60-day extension on the condition that "no further extensions of the new deadlines will be requested or observed except by further agreement of the parties in this proceeding." A true and correct copy of my letter (and the cover email to that letter) is attached as Exhibit 1.

18. In my June 15, 2016 letter, I also noted an understanding that Avalon's responses to Interrogatory No. 4(b), which Avalon IP never raised again, and to the Requests for Production described in the letter (Nos. 8, 17 through 23, and 25) were "the only responses to which that Avalon IP had issues." No response was received from Avalon IP to refute this point.

19. Also on June 15, 2016, Avalon served three deposition notices, which were scheduled for July 5-7, 2016. True and correct copies of those deposition notices (and the cover email to the courtesy copies) are attached as Exhibit 2.

20. On June 17, 2016, Avalon IP served its First Amended and Supplemental Answers and Objections to Petitioner's First Set of Interrogatories and to Petitioner's First Set of Requests for Admission.

21. On June 22, 2016, Avalon IP produced documents bates numbered AIH01574 – 1599 to Avalon.

22. Also on June 22, 2016, Avalon IP wrote to Avalon noting that its deposition witnesses will not be available for the week noticed without advising of alternate dates, and advising that Avalon IP "cannot agree to forego any further requests for extension, as it is not yet clear how quickly the parties will be able to complete discovery." A true and correct copy of that letter is attached as Exhibit 3.

23. On June 23, 2016, Avalon IP filed its Motion for Extension and Motion to Compel, with no prior notice to Avalon.

24. On June 24, 2016, Avalon responded to Avalon IP's June 22, 2016 letter, requesting that Avalon IP provide proposed alternate deposition dates by July 1, 2016, and clarifying that Avalon does not agree that any further extension of time is necessary or appropriate. A true and correct copy of that letter (and the cover email to that letter) is attached as Exhibit 4.

25. On July 5, 2016, Avalon IP reiterated by letter that its witnesses will not be available as noticed, but again did not provide alternate dates. Avalon responded the same day by letter, requesting that alternate dates be provided for the depositions. True and correct copies of those letters are attached as Exhibit 5 and Exhibit 6, respectively.

26. On July 7, 2016, Avalon provided its First Amended Answers and Objections to Petitioner's First Set of Requests for Admission.

27. Also on July 7, 2016, Avalon IP responded to Avalon's July 5, 2016 letter by email, advising that its witnesses will be available September 13-15, 2016. A true and correct copy of that email is attached as Exhibit 7.

28. Avalon raised the possibility of Accelerated Case Resolution ("ACR") at the parties' initial discovery conference and again raised this option during the parties' call on June 14, 2016. Avalon also requested a response from Avalon IP on this issue in its June 24, 2016 letter. Avalon IP has not substantively responded to this issue.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. Executed this 8th day of June, 2016 in Houston, Texas.



Anna E. Raimer

EXHIBIT 1



AvalonBay Communities, Inc. v. Avalon IP Holding Co., LLC; Cancellation No. 92062400

Anna E Raimer to: Nye, Katherine Dennis
33786

06/15/2016 04:25 PM

Cc: Brent D Sokol, "Eulgen, Lee J."

Bcc: Meredith L Williams

History: This message has been forwarded.

Kate,

Please see the attached letter.

Kind regards,
Anna

Anna E. Raimer ([bio](#))

Partner

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June 15, 2016

VIA EMAIL (KNYE@NGELAW.COM)

Katherine Dennis Nye
Neal, Gerber & Eisenberg LLP
2 N. LaSalle St., Suite 1700
Chicago, IL 60602

Re: *AvalonBay Communities, Inc. v. Avalon IP Holding Co., LLC*,
Cancellation No. 92062400

Dear Ms. Nye:

We received your letter dated June 3, 2016, responding to our May 10, 2016 letter regarding the deficiencies in Avalon IP Holding Co., LLC's ("Avalon IP's") responses and objections to the First Set of Interrogatories, First Set of Requests for Admission, and First Set of Requests for Production of Documents served by AvalonBay Communities, Inc. ("AvalonBay"). We are also in receipt of Avalon IP's responses and objections to AvalonBay's Second Set of Requests for Admission. This letter addresses the foregoing discovery responses, as well as memorializing the representations from our telephone call yesterday.

I. Response to June 3, 2016 Letter

We appreciate your assurance that Avalon IP's "reasonable inquiry" included an inquiry into the knowledge of its predecessor in interest, Avalon Hotels, L.L.C. Given your statement that "there is information to which [Avalon IP] does not have access as a result of its status as a later purchaser of the AVALON mark and related goodwill," we understand that you will not later produce or rely on documents or information from Avalon Hotels, L.L.C. that you have not produced to date. Please confirm this understanding, or else identify any additional documents or information not yet produced in discovery by no later than June 22, 2016.

A. Interrogatories

AvalonBay's Interrogatory No. 7, requesting "the annual dollar and unit volume of Registrant's sales in the United States of services under the Avalon Mark from the first sale of each type of service to the present" (and related Document Request Nos. 22 and 23), seek sales information, which is appropriate discovery per the Trademark Trial and Appeal Board. *Sunkist Growers, Inc.*, 229 U.S.P.Q. 147 (T.T.A.B. 1985) (internal citations omitted):

The Board has held that annual sales and advertising figures of recent years given in round numbers for specific goods bearing the involved mark(s) are proper matters for discovery since the information may well have a bearing upon the issues in an opposition or cancellation proceeding.

Based on this case law, please advise whether an amended response will be provided.

We appreciate your willingness to provide supplemental responses to Interrogatory Nos. 13, 14, 20, and 21. Please also advise whether Avalon IP will amend its response to Interrogatory No. 24, providing facts to support its denial that Avalon IP's services are closely related to those offered by AvalonBay.

B. Requests for Admission

We also appreciate your agreement to provide supplemental responses to Request for Admission Nos. 1 and 3 through 16 (asking Avalon IP to admit that AvalonBay owns the relevant U.S. Trademarks alleged in the Petition), as well as for clarifying Avalon IP's responses to Request for Admission No. 18 and Interrogatory No. 23. Please provide the date by which we may expect to receive the supplemental responses.

C. Requests for Production of Documents

As to AvalonBay's Request for Production No. 7, AvalonBay is willing to narrow its request as you suggest to seek only "the price Registrant paid to acquire the Avalon Mark." Accordingly, please review with your client as you indicated and supplement this response.

We also acknowledge Avalon IP's confirmation that it is not withholding any responsive documents based on its objections to Request for Production Nos. 2, 3, 18, and 38 through 40. With respect to Request for Production Nos. 2 and 3, relating to the date of first use of Avalon IP's mark, we understand your response to mean that Avalon IP does not have and will not seek out or rely on any documents outside of those "that are in the public domain or public record," i.e., outside of the registration documents already produced. If this understanding is incorrect, please immediately identify what additional documents you intend to procure (from third party discovery or otherwise) responsive to these requests, and produce those documents by no later than June 22, 2016.

As to Request for Production Nos. 18 and 38 through 40, Avalon IP again averred that it "is not withholding any documents on the basis of its objections" but also that "its investigation is ongoing" (unlike its responses to Request Nos. 2 and 3). These requests seek any documents "upon which you rely for any defense," "that support and/or rebut an allegation contained in the

Petition,” and that support or controvert “statements contained in” and “affirmative defenses pled in Registrant’s Answer.” If Avalon IP intends to supplement its current production, please clarify what additional documents you intend to procure responsive to these requests, and produce those documents. Given the upcoming deadline of the close of discovery, Avalon IP’s investigation should similarly be coming to a close.

Finally, Avalon IP’s responses to Request for Production Nos. 12 and 33 agree to produce documents based on different descriptions than those sought by the requests. That is, Request No. 12 seeks: “All documents on which you will rely to support any claim that Registrant’s use of the Avalon Mark is sufficiently distinct from AvalonBay’s use of the AvalonBay Marks so as to obviate any likelihood of confusion,” but Avalon IP agreed to produce “representative documents showing the manner of its use of the Avalon Mark.” Please clarify whether Avalon IP is currently withholding documents responsive to the balance of this request, and if not, whether Avalon anticipates obtaining, producing, and/or relying on additional documents. Likewise, Request No. 33 seeks: “Documents sufficient to identify all licenses, assignments, consents, or agreements taken or given by Registrant” relating to the Avalon Mark, but Avalon IP only stated it will produce “the agreement by which it obtained rights in the Avalon Mark.” Please immediately clarify whether Avalon IP is currently withholding other licenses, assignments, consents, or agreements relating to the Avalon Mark.

II. Response to June 3, 2016 Letter

In response to AvalonBay’s Second Set of Requests for Admission (Nos. 35 through 55), Avalon IP denied each and every request. That is, Avalon IP denied that it lacks knowledge or information (outside of the relevant registration, application, and publicly available documents filed therewith) relating to early uses of the mark Avalon prior to its acquisition by Avalon IP.

These denials are puzzling in light of Avalon IP’s production to date—which does not provide evidence of early use—and its response to AvalonBay’s Interrogatory No. 13, asking it to “Identify and describe the facts relating to the date and manner in which the Avalon Mark was first used . . . ,” as Avalon IP stated that “after reasonable inquiry, [Registrant] is without knowledge or information sufficient to respond to this Interrogatory.” We trust that in amending this response and similar responses as agreed, Avalon IP will provide whatever information supports Avalon IP’s belief that the first use of the Avalon Mark in connection with each of the services identified was prior to its March 2015 acquisition.

Relatedly, Avalon IP objected to AvalonBay’s Request for Production Nos. 2 and 3—requesting documents “sufficient to show the dates of first use” and “sufficient to support the dates of first use in interstate commerce of the Avalon Mark” for each service—by objecting “on the grounds that it seeks documents *in the public domain or public record*, already in the possession, custody or control of Petitioner, or equally available to Petitioner.” (emphasis

added). Given your recent statement that Registrant is not withholding any responsive documents on the basis of this objection—i.e., Avalon IP is not withholding any documents available in the public domain—please clarify what non-publicly available documents, if any, Avalon IP has and produce those documents immediately.

Avalon IP's sweeping denials of AvalonBay's Second Set of Requests for Admission are deeply concerning, as Avalon IP's responses, taken together, indicate that responsive material has been withheld as to first use. We hope that Avalon IP will clarify and revise its responses promptly, and by no later than June 22, 2016. If not, AvalonBay will need to pursue motion practice to obtain sufficient answers to understand Avalon IP's basis for such denials, or notice your deposition with respect to these responses as you are the signatory of the same.

III. June 14, 2016 Meet and Confer Call

With respect to our call yesterday regarding Avalon IP's alleged issues with AvalonBay's discovery responses, we made agreements and representations on a number of issues.

First, Avalon IP requested a 60-day extension of all remaining deadlines. After conferring with AvalonBay regarding the same, our client is willing to agree to the proposed 60-day extension. However, such consent is dependent on Avalon IP's agreement that no further extensions of the new deadlines will be requested or observed except by further agreement of the parties in this proceeding. Please confirm your agreement to these terms.

Second, it was requested that AvalonBay formally supplement its responses to Request for Admission Nos. 1 and 2 in line with the proposal in our previous letter. We have done so, and we will serve the responses once the verification is signed.

Third, in terms of Avalon IP's request related to the geographic scope of the use of AvalonBay's services (Interrogatory No. 4(b)), you indicated that it would resolve Avalon IP's issue with this response if AvalonBay produced a complete list of its communities. After reviewing the production, we confirm that AvalonBay has produced such lists in various documents, including the following: the community list webpages available at <http://www.avaloncommunities.com/community-list>, (AVA 000061 and 000068-95); apartments for rent in each state and in the District of Columbia (AVA 000096-342); AvalonBay's most recent 10-K, including the total numbers of communities (AVA 000473) and listing out the various kinds of communities (AVA 000475-487; 00572-582); and the list of all AvalonBay's subsidiaries/affiliates in the Bloomberg Company report (AVA 000604-618). Please confirm that the foregoing satisfies any outstanding issue with respect to this discovery request.

Fourth, we discussed Avalon IP's request for documents relating to any litigation or complaints (Request for Production No. 8). We advised that there is no central repository for the

Katherine Dennis Nye
June 15, 2016
Page 5

latter and reemphasized our earlier objection that the former are publicly available. Further, AvalonBay continues to dispute the relevance of these documents. You indicated that Avalon IP would consider this request further, and we look forward to hearing back from you regarding the same.

Fifth, we discussed Avalon IP's Requests for Production Nos. 17 through 23, dealing with third party use. Although we continued to dispute the relevancy of this request, especially in connection with Avalon IP's affirmative defenses, I advised that we would discuss with our client supplementing these requests, if possible. We will revert to you shortly on the same.

Sixth, in connection with Request for Production No. 25 regarding AvalonBay's intent to offer "vacation rentals or other short-term leasing arrangements," we will produce any additional responsive documents that we can locate after a reasonable investigation.

Following our discussion of the foregoing discovery requests, which we understand to be the only responses to which that Avalon IP had issues, you indicated that Avalon IP will produce supplemental discovery responses by the end of the week or early next week. We look forward to receiving these responses.

I also presented the possibility of engaging in Accelerated Case Resolution under the Board's procedure, such as a stipulation that summary judgment motions be treated as the final briefs in the case. You advised that you would take this proposal to your client to see if there was any interest in doing so.

Thank you for your cooperation in this meet and confer process, and we look forward to amicably resolving any outstanding issues with you going forward.

Very Truly Yours,



Anna E. Raimer

EXHIBIT 2



AvalonBay Communities, Inc. v. Avalon IP Holding Co., LLC; Cancellation No. 92062400

Meredith L Williams to: Eulgen, Lee J., Nye, Katherine Dennis, temanuelson, dcesek, ECFDocket

06/15/2016 05:17 PM

37529

Cc: Brent D Sokol, Anna E Raimer

Bcc: Dulce Hansen

Counsel,

Please see attached courtesy copies of the deposition notices mailed today.

Thank you,
Meredith



2016-06-15 AvalonBay - 30(b)(6) Deposition Notice - Avalon IP.pdf



2016-06-15 AvalonBay - Deposition Notice - Brad Korzen.pdf



2016-06-15 AvalonBay - Deposition Notice - Brian De Lowe.pdf

Meredith L. Williams
Associate

[JONES DAY® - One Firm WorldwideSM](#)

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=====

This e-mail (including any attachments) may contain information that is private, confidential, or protected by attorney-client or other privilege. If you received this e-mail in error, please delete it from your system without copying it and notify sender by reply e-mail, so that our records can be corrected.

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

AvalonBay Communities, Inc.,

Petitioner,

v.

Avalon IP Holding Co., LLC,

Registrant.

Cancellation No. 92062400

NOTICE OF DEPOSITION PURSUANT TO RULE 30(b)(6)

PLEASE TAKE NOTICE THAT, pursuant to Federal Rule of Civil Procedure 30(b)(6), AvalonBay Communities, Inc. (“AvalonBay” or “Petitioner”), by and through its attorneys, will take the oral deposition of Avalon IP Holding Co., LLC (“Avalon IP” or “Registrant”) through one or more of its designated officers, directors, managing agents, or other persons who consent to testify on its behalf concerning the following matters:

- (a) The conception, consideration, and development of the mark at issue in this proceeding, namely the mark that is the subject of U.S. Trademark Registration No. 4043653 (the “Avalon Mark”) and any related service mark or trade name;
- (b) The registration of the Avalon Mark;
- (c) The use, including first use, of the Avalon Mark and any related service mark or trade name;
- (d) Development of goods or services identified or otherwise promoted by the Avalon Mark;
- (e) Sales of all goods or services identified or otherwise promoted by the Avalon Mark;
- (f) The geographic scope of Registrant’s use of the Avalon Mark in connection with the sale of any goods or services, including the states in which Registrant has advertised, promoted and/or sold their goods or services under the Avalon Mark (or in which Registrant intends to advertise, promote and/or sell its goods and services), and the extent of use of the Avalon Mark in each state;

- (g) Any license, agreement or other form of permission to use the Avalon Mark in connection with promotion, marketing, distribution and/or sale of any goods or services;
- (h) Any application to register the Avalon Mark, or any portion thereof, with any state or federal agency or any party authorized to maintain a trademark, service mark or trade name registration;
- (i) Any consideration by Registrant as to whether or not its use of the Avalon Mark may or may not infringe upon any rights held by any other party or person;
- (j) Any efforts on behalf of Registrant to police or otherwise monitor use of the Avalon Mark by any other person or party;
- (k) Any instance in which any individual expressed, conveyed or exhibited a belief that Registrant, or the goods or services sold by Registrant, were in any manner endorsed by, sponsored by, or affiliated with Petitioner or Petitioner's use of the marks set forth in the Petition for Cancellation, namely, the marks that are the subject of U.S. Trademark Registration Nos. 1871559, 2618414, 2799153, 2887466, 2931998, 2950374, 2950378, 2950379, 3101896, 3154668, 3174681, 3419667, 3423982, and 3523079 (the "AvalonBay Marks");
- (l) The trade channels and classes of purchasers for Registrant's services, including the types of people to whom goods and/or services identified by the Avalon Mark are sold;
- (m) The marketing channels for goods and services offered under the Avalon Mark, including the intended people to whom goods or services identified by the Avalon Mark are promoted;
- (n) Any other person offering goods or services in connection with any trademark, service mark or trade name containing the word "AVALON" in any industry in which Registrant uses the Avalon Mark;
- (o) All data, studies or analyses performed by Registrant relating to Petitioner, the AvalonBay Marks, and the use thereof;
- (p) Any efforts by Registrant to measure the strength or recognition of the Avalon Mark, including the results of any poll, study or survey designed in whole or in part to measure the strength or recognition of the Avalon Mark or any other trademark, service mark or trade name containing the word "AVALON";
- (q) The results of any poll, study or survey designed in whole or in part to measure confusion between any of the Registrant's marks and any other trademark, service mark or trade name containing the word "AVALON";
- (r) Advertising and marketing of products or services using the Avalon Mark, including revenues expended to advertise or otherwise promote the Avalon Mark;
- (s) The maintenance, enforcement, licensing or protection of the Avalon Mark;

- (t) Any instance(s) involving Registrant or its predecessor in owning the Avalon Mark (Avalon Hotels, L.L.C.) in which the use of the Avalon Mark was objected to in any way, including, but not limited to, trademark dispute(s), litigation, opposition proceedings, cancellation proceedings, and/or cease and desist requests;
- (u) Any search and/or investigation with respect to any trademark, service mark or trade name for or containing the word "AVALON";
- (v) Any business plans, strategies, or intentions of management regarding the expansion of the product or service offerings, advertising scope or geographic territory of Registrant or any of its affiliates using the Avalon Mark;
- (w) The allegations in Registrant's Answer;
- (x) The scope of any searches for documents and information responsive to AvalonBay's discovery requests conducted by or on behalf of Registrant, including who conducted the search(es), who that individual or those individuals spoke with, where that individual or those individuals searched, and what sources of information were searched;
- (y) The bases for all Registrant's answers to written discovery in this case;
- (z) The authenticity of all documents produced in this matter by Registrant; and
- (aa) The ownership and organizational structure of Registrant and its licensees.

The deposition will be taken before a notary public or other qualified court reporter beginning at 9:30 a.m. on July 5, 2016, at the offices of Jones Day, 555 South Flower Street, 50th Floor, Los Angeles, California 90071, or any other location the parties may agree to or that the TTAB may order, may be videotaped and will continue from day to day until completed. The testimony so obtained will be used for all purposes permitted under the Federal Rules of Evidence and the Federal Rules of Civil Procedure.

Dated this 15th day of June, 2016.

By: Meredith Williams
Meredith L. Williams
JONES DAY
3161 Michelson Drive, Suite 800
Irvine, California 92612
Telephone: (949) 553-7529
Facsimile: (949) 553-7539

Email: mwilliams@jonesday.com

Brent D. Sokol
JONES DAY
555 South Flower Street, 50th Floor
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Telephone: (213) 489-3939
Facsimile: (213) 243-2539

Anna E. Raimer
JONES DAY
717 Texas Avenue, Suite 3300
Houston, Texas 77002
Telephone: (832) 239-3786

*Attorneys for Petitioner
AvalonBay Communities, Inc.*

CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing document entitled Notice of Deposition Pursuant to Rule 30(b)(6) has been served upon Registrant by mailing said copy this 15th day of June, 2016, via First Class Mail, postage prepaid to Registrant's counsel:

LEE J. EULGEN

NEAL, GERBER & EISENBERG LLP

2 N. LASALLE ST., SUITE 1700

CHICAGO, IL 60602

A courtesy copy was also served via e-mail at knye@ngelaw.com, leulgen@ngelaw.com, and temanuelson@ngelaw.com.

Dated: June 15, 2016

Respectfully submitted,

By: Meredith Williams

Meredith L. Williams
JONES DAY

Telephone: (949) 553-7529
Facsimile: (949) 553-7539
Email: mwilliams@jonesday.com

Attorneys for AvalonBay Communities, Inc.

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

AvalonBay Communities, Inc.,

Petitioner,

v.

Avalon IP Holding Co., LLC,

Registrant.

Cancellation No. 92062400

NOTICE OF DEPOSITION OF BRAD KORZEN

PLEASE TAKE NOTICE THAT, pursuant to Federal Rule of Civil Procedure 30, AvalonBay Communities, Inc. (“AvalonBay” or “Petitioner”), by and through its attorneys, will take the oral deposition of Brad Korzen. The deposition will be taken before a notary public or other qualified court reporter beginning at 9:30 a.m. on July 6, 2016, at the offices of Jones Day, 555 South Flower Street, 50th Floor, Los Angeles, California 90071, or any other location the parties may agree to or that the TTAB may order, may be videotaped and will continue from day to day until completed. The testimony so obtained will be used for all purposes permitted under the Federal Rules of Evidence and the Federal Rules of Civil Procedure.

Dated this 15th day of June, 2016.

By: Meredith Williams
Meredith L. Williams
JONES DAY
3161 Michelson Drive, Suite 800
Irvine, California 92612
Telephone: (949) 553-7529
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Anna E. Raimer
JONES DAY
717 Texas Avenue, Suite 3300
Houston, Texas 77002
Telephone: (832) 239-3786
Attorneys for Petitioner
AvalonBay Communities, Inc.

CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing document entitled Notice of Deposition of Brad Korzen has been served upon Registrant by mailing said copy this 15th day of June, 2016, via First Class Mail, postage prepaid to Registrant's counsel:

LEE J. EULGEN

NEAL, GERBER & EISENBERG LLP

2 N. LASALLE ST., SUITE 1700

CHICAGO, IL 60602

A courtesy copy was also served via e-mail at knye@ngelaw.com, leulgen@ngelaw.com, and temanuelson@ngelaw.com.

Dated: June 15, 2016

Respectfully submitted,

By: Meredith Williams

Meredith L. Williams
JONES DAY

Telephone: (949) 553-7529
Facsimile: (949) 553-7539
Email: mwilliams@jonesday.com

Attorneys for AvalonBay Communities, Inc.

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

AvalonBay Communities, Inc.,

Petitioner,

v.

Avalon IP Holding Co., LLC,

Registrant.

Cancellation No. 92062400

NOTICE OF DEPOSITION OF BRIAN DE LOWE

PLEASE TAKE NOTICE THAT, pursuant to Federal Rule of Civil Procedure 30, AvalonBay Communities, Inc. (“AvalonBay” or “Petitioner”), by and through its attorneys, will take the oral deposition of Brian De Lowe. The deposition will be taken before a notary public or other qualified court reporter beginning at 9:30 a.m. on July 7, 2016, at the offices of Jones Day, 555 South Flower Street, 50th Floor, Los Angeles, California 90071, or any other location the parties may agree to or that the TTAB may order, may be videotaped and will continue from day to day until completed. The testimony so obtained will be used for all purposes permitted under the Federal Rules of Evidence and the Federal Rules of Civil Procedure.

Dated this 15th day of June, 2016.

By: Meredith Williams
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Anna E. Raimer
JONES DAY
717 Texas Avenue, Suite 3300
Houston, Texas 77002
Telephone: (832) 239-3786
Attorneys for Petitioner
AvalonBay Communities, Inc.

CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing document entitled Notice of Deposition of Brian De Lowe has been served upon Registrant by mailing said copy this 15th day of June, 2016, via First Class Mail, postage prepaid to Registrant's counsel:

LEE J. EULGEN

NEAL, GERBER & EISENBERG LLP

2 N. LASALLE ST., SUITE 1700

CHICAGO, IL 60602

A courtesy copy was also served via e-mail at knye@ngelaw.com, leulgen@ngelaw.com, and temanuelson@ngelaw.com.

Dated: June 15, 2016

Respectfully submitted,

By: Meredith Williams

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Telephone: (949) 553-7529
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Email: mwilliams@jonesday.com

Attorneys for AvalonBay Communities, Inc.

EXHIBIT 3

June 22, 2016

VIA EMAIL AND U.S. MAIL

Anna Raimer
JONES DAY
717 Texas, Suite 3300
Houston, TX 77002

Re: AvalonBay Communities, Inc. v. Avalon IP Holding Co., LLC

Dear Anna:

We received the notices of deposition for Registrant's 30(b)(6) witness and Messrs. Korzen and De Lowe. The witnesses will not be available on the dates noticed, July 5-7, the week of the Independence Day holiday. We will get back to you regarding calendaring their depositions. In the meantime, we write to respond to your letter dated June 15, 2016.

Your letter asks for us to confirm that we will not later produce or rely upon documents or information from Avalon Hotels, L.L.C. that we have not produced to date, and later, to confirm whether our client is continuing to seek out documents in the public domain or public record. Of course, discovery is still ongoing, and our client's investigation is likewise ongoing, and we therefore cannot confirm that there will not be later-discovered documents. However, our client has conducted a diligent search and produced all non-privileged responsive documents in its possession, custody, and control. We anticipate that provides you with any assurances you require.

With regard to Interrogatory No. 7, after reviewing the authority you provided, Registrant will provide a supplemental response. Additionally, it will provide a supplemental response regarding Interrogatory No. 24.

With regard to Request for Production No. 7, as limited by your letter, Registrant will likewise provide a supplemental response. As to Request for Production No. 12, regarding the differences in the parties' services, of course, the best source of information regarding your client's services will be in its own possession, and correspondingly, the information that is in our client's possession, custody, or control shows the manner of its own use of AVALON. Registrant is not withholding documents on this point. Finally, on Request for Production No. 33, our client will be making a supplemental production and will provide a supplemental response.

With regard to Registrant's responses to Petitioner's Second Set of Requests for Admission, and the inconsistencies you allege with its responses to Interrogatory No. 13 and Requests for Production Nos. 2 and 3, Registrant is providing herewith further documents

Anna Raimer
June 22, 2016
Page 2

supporting its belief regarding the first use date, and its investigation continues. Registrant does not intend to withhold documents on this point, and will additionally provide supplemental written responses to Requests for Production Nos. 2 and 3.

Finally, we note your client's apparent understanding that a further extension of time is necessary and appropriate at this point. However, our client cannot agree to forego any further requests for extension, as it is not yet clear how quickly the parties will be able to complete discovery. We believe it is likely more time will be needed.

We trust that the foregoing, in conjunction with Registrant's forthcoming supplementations as outlined above, will address your concerns.

Sincerely,

A handwritten signature in black ink that reads "Katherine Dennis Nye". The signature is written in a cursive, flowing style.

Katherine Dennis Nye

cc: Lee Eulgen
Brent Sokol

Enclosures

24948285.2

EXHIBIT 4



AvalonBay Communities, Inc. v. Avalon IP Holding Co., LLC; Cancellation No. 92062400

Nye, Katherine Dennis, Eulgen, Lee J.
Meredith L Williams to: <LEulgen@ngelaw.com>, dcesek,
ECFDocket

06/24/2016 04:50 PM

37529

Cc: Brent D Sokol, Anna E Raimer
Bcc: Dulce Hansen

Counsel,

Please see attached correspondence.



2016-06-24 Letter to K. Nye regarding depositions and ACR.pdf

Best regards,
Meredith

Meredith L. Williams
Associate
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This e-mail (including any attachments) may contain information that is private, confidential, or protected by attorney-client or other privilege. If you received this e-mail in error, please delete it from your system without copying it and notify sender by reply e-mail, so that our records can be corrected.

=====

JONES DAY

717 TEXAS • SUITE 3300 • HOUSTON, TEXAS 77002.2712
TELEPHONE: +1.832.239.3939 • FACSIMILE: +1.832.239.3600

DIRECT NUMBER: (832) 239-3786
AERAIMER@JONESDAY.COM

June 24, 2016

VIA EMAIL (KNYE@NGELAW.COM)

Katherine Dennis Nye
Neal, Gerber & Eisenberg LLP
2 N. LaSalle St., Suite 1700
Chicago, IL 60602

Re: *AvalonBay Communities, Inc. v. Avalon IP Holding Co., LLC*,
Cancellation No. 92062400

Dear Ms. Nye:

This letter addresses scheduling of the pending depositions, requests a response on our Accelerated Case Resolution (“ACR”) proposal, and clarifies our position as to Avalon IP’s unilaterally requested extension.

First, in your June 22, 2016 letter, you advise that Avalon IP’s 30(b)(6) witness, Mr. Korzen, and Mr. De Lowe will not be available July 5-7, without providing any explanation. Although we are amenable to an agreement that would reschedule the noticed depositions to a date certain in the near term, per TBMP § 523.01, the filing of a motion to compel does not excuse appearance at depositions duly noticed prior to the filing. Accordingly, please get back to me early next week with your proposed alternate dates for each deposition.

Second, as noted in my June 15, 2106 letter, you advised on our June 14, 2016 call that you would take the possibility of engaging in ACR to your client to see if there was any interest in doing so. Please let us know your client’s response.

Finally, your June 22nd letter states that our client has an “apparent understanding that a further extension of time is necessary and appropriate at this point.” We have no such understanding and have certainly not expressed any such understanding in our meet and confer, and we will address the same in our opposition brief.

I am available to discuss any questions or concerns as to matters addressed in this letter or any of our correspondence to date.

Very Truly Yours,



Anna E. Raimer

EXHIBIT 5

July 5, 2016

VIA EMAIL AND U.S. MAIL

Anna Raimer
JONES DAY
717 Texas Avenue, Suite 3300
Houston, TX 77002

Re: AvalonBay Communities, Inc. v. Avalon IP Holding Co., LLC

Dear Anna:

We write to respond to the concern regarding deposition scheduling noted in your letter sent after the close of business on Friday, June 24, 2016. As we previously informed you, the witnesses noticed are not available during the upcoming holiday week, and we intend to work with you to find appropriate dates.

That said, we will only be producing these witnesses for depositions once, and we anticipate that the individuals you have noticed for deposition, Messrs. Korzen and De Lowe, are likely to be Avalon IP's corporate designees on many of the topics listed in the 30(b)(6) notice. To that end, we believe it would be most efficient for the parties, the witnesses, and the Board for their depositions to occur after further third-party discovery can take place, and, in particular, after we have obtained the third-party information we are seeking from your client both via discovery requests and our pending motion to compel. That information bears directly on the testimony to be provided by the witnesses, especially in their capacity as corporate designees. Please confirm that you are comfortable with this approach, and, if there is any issue, we would be happy to set a time to discuss the matter with you.

Sincerely,


Katherine Dennis Nye

cc: Brent Sokol
Lee Eulgen

EXHIBIT 6



AvalonBay Communities, Inc. v. Avalon IP Holding Co., LLC; Cancellation No. 92062400

Nye, Katherine Dennis, Eulgen, Lee J.
Meredith L Williams to: <LEulgen@ngelaw.com>, dcesek,
ECFDocket

07/05/2016 05:07 PM

37529

Cc: Brent D Sokol, Anna E Raimer
Bcc: Dulce Hansen

Counsel,

Please see attached correspondence.



2016-07-05 Letter to K. Nye regarding Deposition Scheduling.pdf

Best regards,
Meredith

Meredith L. Williams
Associate
[JONES DAY® - One Firm WorldwideSM](#)
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mwilliams@jonesday.com

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JONES DAY

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July 5, 2016

VIA EMAIL (KNYE@NGELAW.COM)

Katherine Dennis Nye
Neal, Gerber & Eisenberg LLP
2 N. LaSalle St., Suite 1700
Chicago, IL 60602

Re: *AvalonBay Communities, Inc. v. Avalon IP Holding Co., LLC*,
Cancellation No. 92062400

Dear Ms. Nye:

This letter responds to your letter of today regarding deposition scheduling. Our letter sent June 24, 2016, requested that you respond the following week with proposed alternate dates for the depositions noticed for July 5, 6, and 7, 2016. Instead, your response today provides no proposed deposition dates and merely indicates an intention to work with us “to find appropriate dates.”

We disagree with your contention that it would be more “efficient” to schedule the depositions at a later date. We duly noticed the depositions and are entitled to take the same. We also disagree with your notion that any “further third-party discovery” is relevant to these depositions, or that you may unilaterally postpone the depositions on such a basis.

Please provide us with proposed deposition dates by no later than July 8, 2016. Otherwise, we will arrange a telephone conference with the interlocutory attorney to discuss Avalon IP’s refusal to comply with the deposition notices.

Very Truly Yours,



Anna E. Raimer

EXHIBIT 7



RE: AvalonBay Communities, Inc. v. Avalon IP Holding Co., LLC; Cancellation No. 92062400

Nye, Katherine Dennis

to:

Anna E Raimer

07/07/2016 03:34 PM

Cc:

"Eulgen, Lee J.", Brent D Sokol, "mwilliams@jonesday.com"

Hide Details

From: "Nye, Katherine Dennis" <knye@ngelaw.com>

To: Anna E Raimer <AERaimer@jonesday.com>

Cc: "Eulgen, Lee J." <LEulgen@ngelaw.com>, Brent D Sokol <bd Sokol@JonesDay.com>, "mwilliams@jonesday.com" <mwilliams@jonesday.com>

Anna:

The witnesses will be available September 13-15. Please let us know if those dates will work for you.

Best regards,

Kate



Katherine Dennis Nye

Associate

Neal, Gerber & Eisenberg LLP

p: 312.827.1455 | f: 312.980.0811 | e: knye@ngelaw.com

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From: Meredith L Williams [<mailto:mwilliams@jonesday.com>]

Sent: Tuesday, July 05, 2016 7:08 PM

To: Nye, Katherine Dennis; LEulgen@ngelaw.com;manuelson; Cesek, Desiree; ECF docket

Cc: Brent D Sokol; Anna E Raimer

Subject: AvalonBay Communities, Inc. v. Avalon IP Holding Co., LLC; Cancellation No. 92062400

Counsel,

Please see attached correspondence.

Best regards,

Meredith

Meredith L. Williams

Associate

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