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

Proceeding	92062400
Party	Defendant Avalon IP Holding Co.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

AvalonBay Communities, Inc.,)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92062400
)	
Avalon IP Holding Co., LLC,)	
)	
Registrant.)	

PETITIONER’S REPLY IN SUPPORT OF MOTION TO COMPEL

Unable to defend its deficient discovery responses, Petitioner’s Opposition to Registrant’s Motion to Compel instead unsuccessfully attempts to attack Registrant’s good faith efforts to resolve this matter without intervention of the Board. As detailed in Registrant’s Motion and below, these efforts have been more than sufficient for the Board to order Petitioner to provide full and complete responses.

I. Registrant Made a Significant (and Good Faith) Effort to Resolve These Issues

Unable to defend its positions on the merits, most of Petitioner’s opposition to this brief focuses instead on the requirement to make a good-faith effort to resolve issues. (*See* Resp. Br.¹, pp. 1-7.) However, Petitioner does not deny that there was a substantive exchange of correspondence regarding the Requests at issue. (Resp. Br., p. 3.) The parties then had an extended conversation regarding outstanding issues, and then further exchanged correspondence. (*Id.*) Despite these efforts, Petitioner continues to make the disingenuous claim that Registrant’s efforts were insufficient.

Even the cases cited by Registrant cannot support this argument. For example, in *Hot Tamale Mama...and More, LLC v. SF Invs., Inc.*, the Applicant sent discovery requests, received

¹ References to Response Brief are to Petitioner’s Opposition to Motion to Compel, 12 TTABVUE.

no response, then sent a single email asking when it could expect responses. 110 U.S.P.Q.2d 1080, 1081-82 (TTAB 2014). Opposer responded that it would check and get back to Applicant with a timeframe. *Id.* Applicant then filed the motion. *Id.* The Board held that this single exchange did not constitute a good faith effort to resolve the matter. *Id.*

Here, by contrast, Registrant's repeated efforts to resolve these issues without intervention of the Board have unquestionably been in good faith, and are sufficient to satisfy the requirements of Trademark Rule 2.120(e). Petitioner's response brief acknowledges the extended correspondence and discussions the parties had regarding its deficient responses. (Resp. Br. p. 3; *see also* Nye Decl.², ¶¶ 2-8; Raimer Decl.³, ¶¶ 6-7.) Petitioner then argues that Registrant filed its Motion "without any warning." (Resp. Br. p. 2.) This is simply false, and belied by the correspondence Petitioner acknowledges.

"The purpose of the conference requirement is to promote a frank exchange between counsel to resolve issues by agreement or to at least narrow and focus the matters in controversy before judicial resolution is sought." *Amazon Technologies Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009) (granting motion to compel, and holding that, while the initial good faith burden to confer is the movant's, counter-movant also has an equal obligation to participate in good faith). Here, the parties had such a frank exchange, and narrowed the issues before this Board. (*Cf.* Nye Decl., Ex. C.) Registrant is not required to wait indefinitely for further communication from Petitioner. *Hot Tamale Mama*, 110 U.S.P.Q.2d at 1081.

Similarly, Petitioner claims that it was considering supplementing its responses to Requests Nos. 17-23, and producing additional documents. (*Id.* at p. 3-4; Raimer Decl. ¶¶ 6-7.)

² References to the Nye Decl. are to the Declaration of Katherine Dennis Nye in Support of Registrant's Motion to Compel, 9 TTABVUE.

³ References to the Raimer Decl. are to the Declaration of Anna E. Raimer in Support of Petitioner's Opposition to Registrant's Motion to Compel, 12 TTABVUE.

While Petitioner has in the meantime served previously-promised Supplemental Responses to Requests for Admission, it has, at the time of filing, not served any supplemental written responses to Petitioner's Requests for Production, nor produced any additional documents at issue in this Motion. If Petitioner had done so in the interim, it would have mooted this concern, and Registrant would have withdrawn this portion of its motion. Its continued refusal to do so, however, shows that it intends to stonewall Registrant on these critical issues until the very end of the discovery period. Petitioner cannot simply drag out the meet and confer process indefinitely, forcing Registrant to continue to wait for adequate responses, and run out the clock on discovery.

II. Petitioner's Responses Remain Deficient

Petitioner alleges without support that the information sought by Petitioner is not proportional to the needs of the case because it seeks documents "from approximately 3,000 employees in over 250 communities throughout the U.S., concerning more than a 20-year period." (Reply Br. p. 8.) The breadth of this case, however, is a direct result of the broad-reaching claims in Petitioner's Notice of Opposition, which claims rights in over 10 marks, in at least six classes. Petitioner cannot be permitted to claim broad rights, and produce documents from its properties when it suits Petitioner's needs in the case, and then deny Registrant discovery on this basis.

Additionally, despite Petitioner's attempts to hide evidence of third party uses, this information is directly relevant to Registrant's affirmative defenses, and, moreover, is directly relevant to the likelihood of confusion analysis required as part of Petitioner's case-in-chief. *In re E.I. du Pont de Nemours & Co.*, 177 USPQ 563, 567 (CCPA 1973); *see also* TBMP § 414 ("Information concerning a party's awareness of third-party use and/or registration of the same or similar marks for the same or closely related goods or services as an involved mark, is

discoverable...”); *American Society of Oral Surgeons v. American College of Oral & Maxillofacial Surgeons*, 201 USPQ 531, 533 (TTAB 1979) (third party uses relevant to show mark is weak); *See also Domino’s Pizza Inc. v. Little Caesar Enterprises Inc.*, 7 USPQ2d 1359, 1363 n.9 (TTAB 1988) (third party uses relevant to show purchaser perception of the marks). Indeed, one of the *du Pont* factors specifically directs this Board to consider “[t]he number and nature of similar marks in use on similar goods.” *du Pont*, 177 USPQ at 567. Accordingly, Petitioner’s suggestion that this information is irrelevant cannot stand.

Furthermore, Petitioner’s attack on Registrant’s estoppel affirmative defense is not well-taken in this context. The only footnote from the only case that Petitioner cites on this point states in dicta that estoppel is a personal defense, and holds merely that estoppel is not available in an *ex parte* appeal. The case does not, as Petitioner improperly tries to argue, stand for the proposition that an estoppel defense is unavailable to Registrant here. *See In re Wilson*, 57 USPQ2d 1863, n. 13 (TTAB 2001).⁴ Indeed, an estoppel defense on the grounds of widespread third party use has been recognized by the Board. *See CBS Inc. v. Morrow*, 217 USPQ 272, 272-273 (holding there was no likelihood of confusion, noting affirmative defense of estoppel based on acquiescence to third party uses of same mark on more similar goods). Petitioner cannot now, months in to the discovery process, withhold documents relevant to Registrant’s validly asserted affirmative defenses on relevance grounds.

⁴ Moreover, even if Petitioner believed that Registrant’s affirmative defenses were inapplicable, the time to raise that would be on a Motion to Strike.

WHEREFORE, for the foregoing reasons, Registrant again respectfully requests that the Board enter an Order compelling Petitioner to respond in full to Registrant's discovery requests within 10 days of the entry of such Order, and granting such other relief as the Board deems appropriate.

Dated: July 28, 2016

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