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Filing date: **06/29/2016**

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

Proceeding	92062543
Party	Defendant Tropical Tobacco, Inc.
Correspondence Address	STEWART L GITLER WELSH FLAXMAN & GITLER LLC 2000 DUKE STREET , SUITE 100 ALEXANDRIA, VA 22314 UNITED STATES mail@iplawsolutions.com
Submission	Other Motions/Papers
Filer's Name	Stewart L Gitler
Filer's e-mail	mail@iplawsolutions.com, gitler@iplawsolutions.com
Signature	/Stewart L Gitler/
Date	06/29/2016
Attachments	20160629131016.pdf(591490 bytes ) 20160629131006.pdf(83848 bytes ) 20160629130943.pdf(408350 bytes )

# **EXHIBIT B**

## Stewart Gitler

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**From:** Stewart Gitler  
**Sent:** Friday, June 24, 2016 1:34 PM  
**To:** 'Peter S. Sloane'  
**Subject:** RE: Mombacho Cigars S.A. v. Tropical Tobacco, Inc., Cancellation No. 92062543

Peter:

Our client has not authorized us to approve an extension, Mr. Palmer and Ms. Vega are available for depositions July 6-8, please note that Ms. Vega's English is very limited and you will need a Spanish/English translator for the deposition.

Stewart  
Stewart L. Gitler, Esq.  
Welsh Flaxman & Gitler LLC  
2000 Duke Street  
Suite 100  
Alexandria, VA 22314

703-920-1122  
703-920-3399 (fax)  
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**From:** Peter S. Sloane [<mailto:Sloane@leasonellis.com>]  
**Sent:** Friday, June 24, 2016 12:29 PM  
**To:** Stewart Gitler  
**Cc:** Lauren B. Sabol; Cameron Reuber  
**Subject:** RE: Mombacho Cigars S.A. v. Tropical Tobacco, Inc., Cancellation No. 92062543

Stewart:

I just left you a voice mail. As discussed, since we have not heard back from you following our e-mail below, we will move forward with filing our motion to compel and motion to extend. Just in case our motion is not granted in time, we will separately be serving deposition notices, so please keep Mr. Palmer and Ms. Vega available from July 6th through 8th for depositions.

Regards,

## Stewart Gitler

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**From:** Stewart Gitler  
**Sent:** Thursday, June 23, 2016 2:37 PM  
**To:** 'Peter S. Sloane'  
**Subject:** RE: Mombacho Cigars S.A. v. Tropical Tobacco, Inc., Cancellation No. 92062543

Peter:

I am not really sure what you are arguing here? I responded to the interrogatories-and to the one's you believed they were deficient;

I attempted to resolve the all the deficiency issues and sent you the revised answers. I note you have an issue with the answer to interrogatory 18 and I will contact my client again and see if he can produce additional names of the entities that you are requesting.

Please note that I will contest any "contempt" motion you will file on the grounds that I have refused to reply to your requests.

We are attempting to comply and will comply to the best of our client's ability.

Stewart

Stewart L. Gitler, Esq.  
Welsh Flaxman & Gitler LLC  
2000 Duke Street  
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Alexandria, VA 22314

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---

**From:** Peter S. Sloane [mailto:Sloane@leasonellis.com]  
**Sent:** Thursday, June 23, 2016 2:23 PM  
**To:** Stewart Gitler  
**Cc:** Lauren B. Sabol; Howard Flaxman; John Welsh  
**Subject:** RE: Mombacho Cigars S.A. v. Tropical Tobacco, Inc., Cancellation No. 92062543

Stewart:

That you responded to our letter does not abrogate the fact that our letter would not have been necessary but for your client's failure to properly respond to our discovery requests in the first instance. A party which receives discovery requests early in the discovery period may not, by delaying its response thereto, or by responding improperly so that its adversary is forced to file a motion to compel discovery, deprive its adversary of the opportunity to take "follow-up" discovery. TBMP §403.04.

As previously discussed, we are not even sure what changes were made in Respondent's "second" response to our initial discovery requests. Among possibly other things, your client alleges promotion of its product at IPCPR. Are you suggesting that we are not entitled to obtain discovery on that promotion prior to deposition? That would seem unfair.

We are also quite clearly entitled to discovery on your verification of the interrogatory responses. An attorney who answers interrogatories on behalf of a corporation may thereafter be exposed to additional discovery and possibly even disqualification. TBMP §405.04(c).

As for continued deficiencies in your client's discovery responses, to take just one example, our Interrogatory No. 18 asked your client to identify each and every distributor and retailer in the U.S. who has ever purchased its MOMBACHO cigars. The first answer just identified Serious Cigars as a representative current retailer. We objected, whereupon Respondent's further response only added that no detailed records were kept in relation to other distributors or retailers. That is non-responsive as our Interrogatory asked for names rather than documents.

In view of the above, we ask that you reconsider your refusal to consent to the requested extension of time. If your client is truly worried about unnecessary delay, it should avoid forcing us to file a motion for contempt which may end up delaying proceedings more than the requested two months.

Regards,

Peter.

---

**From:** Stewart Gitler [<mailto:sgitler@iplawsolutions.com>]  
**Sent:** Thursday, June 23, 2016 1:54 PM  
**To:** Peter S. Sloane  
**Cc:** Lauren B. Sabol; Howard Flaxman; John Welsh  
**Subject:** RE: Mombacho Cigars S.A. v. Tropical Tobacco, Inc., Cancellation No. 92062543

Peter:

Our client does not agree to an extension of the time and we did respond to your purported "deficiency" letter. There is no requirement to respond to the second set of Ints/Doc request before the end of the discovery dates.

You have had adequate time to set time for a deposition and we will not agree to an extension, you have almost two weeks' notice and three possible dates you can choose for a deposition.

I'm not sure what motion to compel you will be filing? We did not contest your follow up letter and we tried to respond fully with your first set of interrogatories? What other deficiencies you contend exist?

We will contest any motion to extend the discovery dates as unnecessary delay.

Stewart  
Stewart L. Gitler, Esq.  
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---

**From:** Peter S. Sloane [<mailto:Sloane@leasonellis.com>]

**Sent:** Thursday, June 23, 2016 12:26 PM

**To:** Stewart Gitler

**Cc:** Lauren B. Sabol; Howard Flaxman; John Welsh

**Subject:** RE: Mombacho Cigars S.A. v. Tropical Tobacco, Inc., Cancellation No. 92062543

**Importance:** High

Stewart:

Thanks for the depositions dates. You are putting us in an unnecessarily difficult position, though, by denying our reasonable request to extend dates. Among other things, the July 4th holiday is coming up and I am in San Francisco from June 30th through July 5, we will not have received your responses to our second set of discovery requests by the time of deposition, there are still some deficiencies in your client's responses to our first set of discovery requests, and the delay in responding to our objections has adversely affected our ability to take follow up discovery. We would like to avoid filing a motion to compel and a motion to extend without consent. Accordingly, I ask that you kindly agree to consent to the requested extension of time. Given the upcoming deadline, I look forward to hearing from you by the end of today.

Regards,

Peter.

---

**From:** Stewart Gitler [<mailto:sgitler@iplawsolutions.com>]

**Sent:** Thursday, June 23, 2016 10:31 AM

**To:** Peter S. Sloane

**Cc:** Lauren B. Sabol; Howard Flaxman; John Welsh

**Subject:** RE: Mombacho Cigars S.A. v. Tropical Tobacco, Inc., Cancellation No. 92062543

Dear Peter;

Mr. Palmer and Ms. Vega are available on July 6, 7 or 8 for depositions. The location for the deposition will need to be in Miami and at the same time you can inspect the items you would like to view.

We **will not agree** to any extensions of time for the discovery period.

Let me know.

Stewart

Stewart L. Gitler, Esq.  
Welsh Flaxman & Gitler LLC  
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Suite 100  
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**From:** Peter S. Sloane [<mailto:Sloane@leasonellis.com>]  
**Sent:** Wednesday, June 22, 2016 11:19 AM  
**To:** Stewart Gitler  
**Cc:** Lauren B. Sabol; Howard Flaxman; John Welsh  
**Subject:** RE: Mombacho Cigars S.A. v. Tropical Tobacco, Inc., Cancellation No. 92062543  
**Importance:** High

Stewart:

We received your letter dated June 13, 2016 with your client's "second" response to our first interrogatories. It is unclear whether your client is correcting or supplementing its earlier response. Can you please let me know what was changed in response to my letter of May 28, 2016?

I appreciate your client providing dates for the inspection of product, but we are not available this week. I will revert to you with proposed dates shortly.

Attached are courtesy copies of our second set of discovery requests. The service copies follow by first-class mail.

Discovery is set to close on July 8, 2016. Please confirm that you are amenable to a two-month extension of time.

If you are not agreeable to extending the discovery and trial dates, please let me know when Paul Palmer and Josefa Vega are available for deposition between now and the current deadline. We should also discuss a mutually convenient place for us to take their depositions.

Regards,

Peter.

# **EXHIBIT A**

## Stewart Gitler

---

**From:** Stewart Gitler  
**Sent:** Sunday, May 29, 2016 11:38 AM  
**To:** Peter S. Sloane  
**Cc:** Lauren B. Sabol  
**Subject:** RE: Mombacho Cigars S.A. v. Tropical Tobacco, Inc., Cancellation No. 92062543

Peter:

Safely received-Applicant will review the letter and discuss same with client then will provide answers timely-the client will not be available next week but will provide answers to the further clarifications by the middle of the month of June.

Stewart

---

**From:** Peter S. Sloane [Sloane@leasonellis.com]  
**Sent:** Saturday, May 28, 2016 3:30 PM  
**To:** Stewart Gitler  
**Cc:** Lauren B. Sabol  
**Subject:** Mombacho Cigars S.A. v. Tropical Tobacco, Inc., Cancellation No. 92062543

Stewart:

Please see the attached correspondence.

Regards,

Peter S. Sloane  
LEASON ELLIS.  
One Barker Avenue, Fifth Floor  
White Plains, New York 10601  
[Sloane@LeasonEllis.com](mailto:Sloane@LeasonEllis.com)  
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C. 914.419.6159  
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Registration No.: 4,183,397  
Mark: MOMBACHO  
Registered: July 31, 2012

_____	)	
MOMBACHO CIGARS S.A.	)	
	)	
Petitioner,	)	
	)	
v.	)	Cancellation No. 92062543
	)	
TROPICAL TOBACCO, INC.,	)	
	)	
Respondent.	)	
_____	)	

**RESPONDENT’S RESPONSE TO MOTION TO COMPEL RESPONDENT’S  
RESPONSES TO PETITIONERS DISCOVERY REQUEST AND RESPONSE TO  
MOTION FOR EXTENSION OF THE DISCOVERY AND TRIAL PERIODS**

Respondent, TROPICAL TOBACCO, INC. (hereinafter, “Tropical”), hereby requests that Petitioner’s motion to compel respondent’s responses to petitioners discovery request and motion for extension of the discovery and trial periods be denied on the grounds that Petitioner had adequate time to conduct discovery and further, Respondent has timely responded to Petitioner’s interrogatories and follow up letter to purportedly correct deficiencies in the response to the first set of Interrogatories that followed the timely response.

Discovery opened on January 10, 2016 and Petitioner did not serve their first set of interrogatories and request for documents until March 29, 2016. (Almost three months later) Respondent’s Counsel, after receiving input from Respondent, timely responded to the interrogatories on April 27, 2016. There was no delay in providing the response. A good faith effort was undertaken in

the response and each and every interrogatory was answered and each document production request was provided. There was no delay in providing the response. On May 28, 2016, thirty days later, Respondent received a letter via email and in the mail with some purported deficiencies in the responses. In an effort to work with Opposing Counsel and “not delay”, Respondent’s Counsel contacted Respondent and timely addressed each purported deficiency with more detailed responses.

The answers to the interrogatories and responses to the production requests provided in the first set and amended first set of responses were made with good faith and were complete based upon the information provided by Respondent. Just because petitioner is unhappy with the content of the responses does not make them vague or deficient. Any alleged inconsistencies in the responses can be addressed during the already scheduled depositions of Respondent.

It is unfair of a party to drag out discovery and request an extension of discovery after waiting three months to begin discovery when all interrogatories have been fully and timely answered. Just because the party is unhappy with some of the content of the responses is not justification for extending discovery and imposing unnecessary costs on the other party.

Petitioner set an artificial deadline of June 6 to “supplement” the interrogatories. Applicant timely acknowledged receipt of the letter (May 29, 2016) and informed Petitioner that a response would be coming by mid-June. (See attached email-Exhibit A) The revised responses were a good faith attempt to work with Petitioner and were timely sent to Petitioner on June 13, 2016.

The Motion to extend filed by petitioner only seeks to burden Respondent and increase costs for the proceeding. Petitioner sat on their hands for almost three months before initiating discovery and now seeks to delay even more and extend the period to the detriment of Respondent.

Petitioner has set depositions for July 6-8, 2016, within the discovery period, and no delay or change in the date or time has been requested by the deponents.

This motion amounts to continued harassment in the same light as petitioner's notice to attempt to depose opposing counsel and should be denied on the grounds that Respondent has been fully cooperative and amenable to all of Petitioner's requests to respond to the interrogatories and production requests. All responses have been timely provided. Even the response to the "deficiency letter" was responded to within the tacitly agreed to time period. Respondent immediately indicated in an email that a response would be forthcoming in the middle of June and a response was sent on June 13, 2016.

The appropriate standard for allowing an extension of a prescribed period prior to the expiration of the term is "good cause." See Fed. R. Civ. P. 6(b) and Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 509 (2d ed. rev. 2004) and cases cited therein. Generally, the Board is liberal in granting extensions of time before the period to act has elapsed so long as the moving party has not been guilty of negligence or bad faith and the privilege of extensions is not abused. The moving party, however, retains the burden of persuading the Board that it was diligent in meeting its responsibilities and should therefore be awarded additional time. See *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147 (TTAB 1985).

In this case, Petitioner did not serve their first written discovery requests until the three months had elapsed in the discovery period. Applicant timely responded. Thirty days later, Petitioner sent a letter noting purported deficiencies in the responses. Respondent's attorney responded in good faith and without delay.

Further, Petitioner is deposing two of the Respondent's employees and one customer during the present discovery period and is in no way prejudiced by a denial of the Motion to extend the discovery period.

Even though this is Petitioners' first request to extend the deadline in the proceeding there is no evidence of bad faith on the part of Respondent. Considering the entire record, Petitioner has not made the minimum showing necessary to establish good cause to support an extension of the discovery period for any length of time. Petitioners' principal argument in support of their motion to extend the discovery period is that Respondent has been uncooperative and caused delay. None of these allegations have any merit or truth.

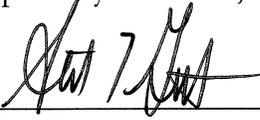
Respondent has made every effort to properly and timely respond to all questions and will continue to be timely and cooperative. (See Exhibit B)

Respondent has been cooperative throughout this proceeding and has opposed the extension to avoid unnecessary delay and cost that such an extension would cause Respondent. In addition, if Petitioner believes that one or two interrogatory questions need further clarification, Respondent is willing to work with Petitioner to their satisfaction without the need for more discovery time.

### **CONCLUSION**

Petitioner has failed to show any imminent need for the extension and in view of such the Motion for an Extension of the Discovery Period and a Motion to Compel responses to the first set of interrogatories should be denied.

Respectfully submitted,

By:  \_\_\_\_\_

Stewart L. Gitler

Howard N. Flaxman John L. Welsh

WELSH FLAXMAN & GITLER LLC

2000 Duke Street, Suite 100

(703)920-1122, mail@iplawsolutions.com

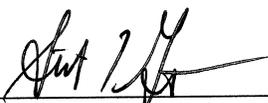
ATTORNEYS FOR RESPONDENT

Date: 6/29/16

**CERTIFICATE OF SERVICE**

The undersigned certifies that a true and correct copy of the foregoing **RESPONDENT'S RESPONSE TO MOTION TO COMPEL RESPONDENT'S RESPONSES TO PETITIONERS DISCOVERY REQUEST AND RESPONSE TO MOTION FOR EXTENSION OF THE DISCOVERY AND TRIAL PERIODS**, was served on Counsel for Petitioner, by U.S. first-class mail and email, postage prepaid, June 29, 2016, to:

Peter S. Sloane  
LEASON ELLIS LLP  
One Barker Avenue, Fifth Floor  
White Plains, New York 10601

By:  \_\_\_\_\_  
Stewart L. Gitler