

ESTTA Tracking number: **ESTTA757836**

Filing date: **07/12/2016**

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

Proceeding	92062923
Party	Defendant K & N Distributors
Correspondence Address	MATTHEW H SWYERS THE TRADEMARK COMPANY PLLC 344 MAPLE AVE W, STE 151 VIENNA, VA 22180 UNITED STATES mswyers@thetrademarkcompany.com, admin@thetrademarkcompany.com
Submission	Opposition/Response to Motion
Filer's Name	Matthew H. Swyers
Filer's e-mail	Mswyers@thetrademarkcompany.com
Signature	/Matthew H. Swyers/
Date	07/12/2016
Attachments	OPPOSITION TO MOTION TO COMPEL and EXHIBIT A.pdf(266908 bytes)

THE UNITED STATES PATENT AND TRADEMARK OFFICE
The Trademark Trial and Appeal Board

U.S. Reg. No. 4,818,656;
For the mark TROPIC CLAIR PLUS;
Registered on the Principal Register on September 22, 2015.

TOPICLEAR INC.,	:	
	:	
Petitioner,	:	
	:	
vs.	:	Cancellation No. 92062923
	:	
K & N Distributors,	:	
	:	
Respondent.	:	

OPPOSITION TO MOTION TO COMPEL

COMES NOW Registrant, K & N Distributors (hereinafter “Registrant”), by and through counsel, The Trademark Company, PLLC, and files the instant Opposition to the Motion to Compel filed by Petitioner, TOPICLEAR INC. (hereinafter “Petitioner”), stating as follows:

STATEMENT OF FACTS

1. On or about December 18, 2015 Petitioner filed a Petition to Cancel Registrant’s U.S. Registration No. 4,818,656 for the mark TROPIC CLAIR PLUS (“Registrant’s Mark”) for use in connection with “Cosmetics” (“Registrant’s Goods”) in International Class 3.
2. The Petitioner’s Petition to Cancel was filed solely on the grounds of priority and likelihood of confusion pursuant to Trademark Act Section 2(d).
3. On or about January 11, 2016 Registrant timely filed its Answer to Petitioner’s Petition to Cancel.
4. On or about February 9, 2016 Counsel for Petitioner and Counsel for Registrant held the Board’s mandatory Discovery Conference in the instant case.
5. On or about February 16, 2016 Registrant’s Initial Disclosures were timely served to Counsel for Petitioner.

6. On or about March 4, 2016 Counsel for Registrant received Petitioner's Initial Disclosures from Counsel for Petitioner.

7. On or about March 8, 2016 Counsel for Registrant served the following on Counsel for Petitioner: Registrant's First Set of Requests for Interrogatories to Petitioner, Registrant's First Set of Requests for Production of Documents to Petitioner and Registrant's First Set of Requests for Admissions to Petitioner (hereinafter "Registrant's First Set of Discovery Requests to Petitioner").

8. On or about March 28, 2016 Counsel for Registrant received Petitioner's First Set of Requests for Interrogatories to Registrant, Petitioner's First Set of Requests for Production of Documents to Registrant and Petitioner's First Set of Requests for Admissions to Registrant (hereinafter "Petitioner's First Set of Discovery Requests to Registrant").

9. On or about April 25, 2016 Registrant's responses to Petitioner's First Set of Discovery Requests to Registrant were timely served to Counsel for Petitioner.

10. On or about May 10, 2016 Counsel for Registrant received Petitioner's responses to Registrant's First Set of Discovery to Petitioner.

11. On or about June 22, 2016 Counsel for Petitioner filed a Motion to Compel seeking an Order from the Board compelling Registrant to respond with objection to Petitioner's Interrogatory Request No.'s 7, 8, 12, 13, 15, 16, 17, 18 and 19.

STIPULATION OF FACT

In an effort to address some if not all of the issues in contention regarding the instant Motion to Compel Registrant provides the following stipulation in support of its objections that the information is not reasonably calculated to lead to the discovery of admissible evidence at trial:

Registrant stipulates that Petitioner began using Petitioner's Marks for Petitioner's Goods in U.S. interstate commerce prior to Registrant's first use of Registrant's Mark for Registrant's Goods in U.S. interstate commerce. As such, based on the foregoing, Registrant concedes the issue of priority of use to Petitioner.

OPPOSITION TO MOTION

Registrant has served Registrant's Supplemental Responses to Petitioner's enumerated Interrogatory Request No.'s 7, 8, 12, 13, 15, 16, 17, 18 and 19 (subject of the Petitioner's instant Motion to Compel) to Counsel for Petitioner today, July 12, 2016. Moreover, a copy of Registrant's supplemental responses to Petitioner's Interrogatory Request No's 7, 8, 12, 13, 15, 16, 17, 18 and 19 is attached hereto as Exhibit A.

With respect to the objections which remain regard the interrogatories that are not reasonably calculated to lead to the discovery of admissible evidence at trial, such questions solely seek information which would merely be relevant to Registrant's use and/or first use date in Interstate Commerce. As use itself is not an issue as no fraud has been claimed the only remaining possible relevance would be for priority of use. As priority of use has now been conceded, the questions have been rendered moot and are now not reasonably calculated to lead to the discovery of admissible evidence of trial.

Given the supplemental responses in conjunction with the stipulation provided it is submitted that Registrant has now sufficiently answered Petitioner's interrogatories. Counsel for Registrant will provide a verification page for Registrant's initial and supplemental responses to Petitioner's First Set of Interrogatory Requests to Registrant with Registrant's notarized signature to opposing counsel in due course.

CONCLUSION

WHEREFORE for good cause considered, Registrant, by counsel, respectfully requests that the Board reject the Petitioner's Motion to Compel Discovery in the instant case.

DATED this 12th day of July, 2016.

THE TRADEMARK COMPANY, PLLC

/Matthew H. Swyers/

Matthew H. Swyers, Esquire

344 Maple Avenue West, Suite 151

Vienna, VA 22180

Telephone (800) 906-8626 x 100

Facsimile (270) 477-4574

mswyers@TheTrademarkCompany.com

Attorney for Registrant

THE UNITED STATES PATENT AND TRADEMARK OFFICE
The Trademark Trial and Appeal Board

U.S. Reg. No. 4,818,656;
For the mark TROPIC CLAIR PLUS;
Registered on the Principal Register on September 22, 2015.

TOPICLEAR INC.,	:	
	:	
Petitioner,	:	
	:	
vs.	:	Cancellation No. 92062923
	:	
K & N Distributors,	:	
	:	
Respondent.	:	

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that I caused a copy of the foregoing this 12th day of July, 2016 to be served, via first class mail, postage prepaid, upon:

Donald Dennison
Ladas & Parry LLP
1727 King Street, Ste. 105
Alexandria, Virginia 22314

/Matthew H. Swyers/
Matthew H. Swyers

EXHIBIT A

THE UNITED STATES PATENT AND TRADEMARK OFFICE
The Trademark Trial and Appeal Board

U.S. Reg. No. 4,818,656;
For the mark TROPIC CLAIR PLUS;
Registered on the Principal Register on September 22, 2015.

TOPICLEAR INC.,	:	
	:	
Petitioner,	:	
	:	
vs.	:	Cancellation No. 92062923
	:	
K & N Distributors,	:	
	:	
Respondent.	:	

**REGISTRANT’S SUPPLEMENTAL RESPONSES TO
PETITIONER’S FIRST SET OF INTERROGATORIES**

Pursuant to the applicable rules of the Federal Rules of Civil Procedure and TBMP, Registrant, K & N Distributors (hereinafter “Registrant”), hereby provides the following supplemental responses to Petitioner’s Interrogatory Request No.’s 7, 8, 12, 13, 15, 16, 17, 18 and 19 as set out in Petitioner’s First Set of Interrogatories to Registrant

INTERROGATORIES

7. With regard to the alleged first date of use of Registrant's trademark, "TROPIC CLAIR PLUS, as set forth in its registration, indicate:
- a. the date of the first shipment of goods in the United States bearing the mark;
 - b. the nature of any documentation which relates to such shipment and/or sale;
 - c. the name and address of the customer for the first shipment of such goods.
 - d. the date when Registrant's "TROPIC CLAIR PLUS goods were first imported-into the United States if they were manufactured abroad.

Supplemental Response: Insomuch as Registrant concedes the issue of priority of use to Petitioner, Registrant objects to the instant interrogatory request on the grounds that the responsive information that Petitioner is seeking is not relevant to this action and is not reasonably calculated to lead to the discovery of admissible evidence.

8. Have any of Registrant's "TROPIC CLAIR PLUS" goods ever been sold and shipped to stores in the United States, and if the answer is affirmative, provide the names and addresses of at least five such stores.

Supplemental Response: Registrant's Goods are sold or shipped to whole sellers, not retail stores.

12. List 5 representative current retail store customers who have purchased "TROPIC CLAIR PLUS" goods manufactured, sold or distributed by Registrant within the past 6 months.

Supplemental Response: Registrant's Goods are sold or shipped to whole sellers, not retail stores.

13. Did the Registrant know either Symcha Horowitz or John Graterol prior to the filing of its application resulting in the registration here in issue?

Supplemental Response: Registrant objects to the instant interrogatory request on the grounds that the responsive information that Petitioner is seeking is not relevant to this action and is not reasonably calculated to lead to the discovery of admissible evidence.

15. Who is the manufacturer of Registrant's "TROPIC CLAIR Plus goods and where are they located?

Supplemental Response: Registrant objects to the instant interrogatory request on the grounds that the responsive information that Petitioner is seeking is not relevant to this action and is not reasonably calculated to lead to the discovery of admissible evidence.

16. If the goods noted in Interrogatory No, 15 are manufactured abroad, is there any notification of the country of manufacture on the product or its packaging?

Supplemental Response: Registrant objects to the instant interrogatory request on the grounds that the responsive information that Petitioner is seeking is not relevant to this action and is not reasonably calculated to lead to the discovery of admissible evidence.

17. Have Registrant's "TROPIC CLAIR PLUS" products ever been advertised in any periodicals or other media, and if affirmative, identify each such periodical, or other media form?

Supplemental Response: Registrant has not used any periodicals or other media to advertise Registrant's Goods.

18. Are you aware of a company called Nature Cosmetics LLC?

(a) if the answer is affirmative state the address of that company and indicate what, if any, relationship you had or presently have with that company.

Supplemental Response: Registrant objects to the instant interrogatory request on the grounds that the responsive information that Petitioner is seeking is not relevant to this action and is not reasonably calculated to lead to the discovery of admissible evidence.

19. Are you aware of a company called R&B Cosmetics Ltd?

(a) if the answer is affirmative state the address of that company and indicate what, if any, relationship you had or presently have with that company.

Supplemental Response: Registrant objects to the instant interrogatory request on the grounds that the responsive information that Petitioner is seeking is not relevant to this action and is not reasonably calculated to lead to the discovery of admissible evidence.

DATED this 12th day of July, 2016.

THE TRADEMARK COMPANY, PLLC

/Matthew H. Swyers/

Matthew H. Swyers, Esquire

344 Maple Avenue West, Suite 151

Vienna, VA 22180

Telephone (800) 906-8626 x 100

Facsimile (270) 477-4574

mswyers@TheTrademarkCompany.com

Attorney for Registrant

THE UNITED STATES PATENT AND TRADEMARK OFFICE
The Trademark Trial and Appeal Board

U.S. Reg. No. 4,818,656;
For the mark TROPIC CLAIR PLUS;
Registered on the Principal Register on September 22, 2015.

TOPICLEAR INC.,	:	
	:	
Petitioner,	:	
	:	
vs.	:	Cancellation No. 92062923
	:	
K & N Distributors,	:	
	:	
Respondent.	:	

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that I caused a copy of the foregoing this 12th day of July, 2016 to be served, via first class mail, postage prepaid, upon:

Donald Dennison
Ladas & Parry LLP
1727 King Street, Ste. 105
Alexandria, Virginia 22314

/Matthew H. Swyers/
Matthew H. Swyers