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

<b>Proceeding</b>	91154043
<b>Party</b>	Defendant Gebr. Hoffmann AG. Gebr. Hoffmann AG. Eisenbahnstrasse 71 CHX CH-3601 Thun,
<b>Correspondence Address</b>	J. STEPHEN SIMMS SIMMS SHOWERS LLP 20 S CHARLES ST, STE 702 BALTIMORE, MD 21201
<b>Submission</b>	Reply to Opposer's Response to Hoffman's Motion for Reconsideration of Board's December 5, 2003 Order
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<b>Date</b>	02/09/2004
<b>Attachments</b>	020904 - Reply brief.reconsideration.pdf ( 13 pages )

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

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Lanco Corporation	)	
	)	
Opposer,	)	
	)	Opposition No. 91/154,043
v.	)	
	)	
Hoffman Neopac AG	)	Ser. No. 75/545,553
(f/k/a) Gebr. Hoffman A.G.	)	Mark: Miscellaneous Design
	)	
Applicant.	)	
	)	

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**APPLICANT HOFFMAN NEOPAC A.G.'S  
REPLY TO OPPOSER'S RESPONSE TO  
HOFFMAN'S MOTION FOR RECONSIDERATION  
OF BOARD'S DECEMBER 5, 2003 ORDER**

Applicant Hoffman Neopac AG, by its undersigned counsel, hereby replies to Opposer Lanco Corporation's opposition to Applicant's request for reconsideration of the Board's decision dated December 5, 2003 as follows:

In its response requesting that the Board deny Applicant's reconsideration request, Opposer continues to allege that Applicant failed to respond to Opposer's discovery requests and, therefore, the Board's decision to grant the motion to compel was right.

Opposer's allegations are false. Applicant did, in fact, respond to the Opposer's discovery requests, and did so 36 days prior to the extended response deadline. Opposer, however, failed to inform the Board of its receipt of Applicant's responses as required by TTAB Rule 2.120(e). Absent any formal notice of the receipt, which would have rendered the motion to compel moot, the Board granted Opposer's motion on December 5, 2003.

In its motion for reconsideration, Applicant pointed out to the Board that, by Opposer's own August 18, 2003 request for an extension of time to respond to Applicant's discovery

requests, Opposer agreed to allow Applicant an additional 60 day period to consider whether or not it would continue with this action, and to respond to Opposer's discovery requests. Opposer did not address or dispute this issue in its opposition to Applicant's motion. Opposer raised no objection, therefore, it may be inferred that Opposer accepts and agrees with Applicant's assertion.

The new deadline created by the first extension request was October 17, 2003. Despite its apparent acceptance of, and agreement to, the extension peripherally granted to Applicant, Opposer filed a Motion to Compel Applicant's response on October 1, 2003 - sixteen days before the new response deadline. Opposer cited Applicant's failure to respond by the deadline as grounds for granting the motion to compel. The Opposer apparently has a crystal ball that can predict the future, using it to predict that the Applicant would not respond by October 17.

On October 7, 2003, the Board suspended the proceedings, pending disposition of the motion to compel, and stated that no filings were to be made that were not germane to the motion at issue. Despite the suspension, the Opposer filed a second extension request on October 17. The Board granted the request, effectively contradicting its own ruling regarding the suspension order, and granting an additional 60 days for the Applicant to respond.

It follows that, as the first extension request extended to the Applicant, so should Opposer's second request. Applicant availed itself of the additional time to consider its position on continuing with the proceeding. On November 13, 2003, Applicant served its discovery responses to both the first and second set of requests on Opposer, well within the second 60-day extension period that ended December 19, 2003.

Simultaneous with serving its discovery responses, Applicant filed its response to

Opposer's motion to compel in which Applicant confirmed both its intent to proceed forward, and its service of responses. At that point, Applicant believed the motion to compel was rendered moot and no additional response was required.

In the Opposer's November 24, 2003 reply to Applicant's response to the motion to compel, Opposer acknowledges receipt of the Applicant's discovery responses. Opposer, however, broadly classified Applicant's answers as vague and incomplete. In support of its contention, Opposer cited, as an example, the response to interrogatory no. 5 which directs Opposer to Applicant's website for a listing of Applicant's products. Opposer contends this answer is "vague and incomplete" because the text of the website "is in German not English." What the Opposer fails to acknowledge, however, is that the website provides a link to an English version, as well as French. It simply requires one click of the mouse. [Copies of the website homepage, in both German and English, are attached hereto as Exhibit A.] The website contains a wealth of information regarding Applicant's products. This is neither a vague, nor incomplete, response. Opposer provides no other examples to support its sweeping claim that Applicant's responses are vague and incomplete.

Opposer, throughout its parade of motions and responses, has accused the Applicant of failing to follow the Rules. Opposer, however, neglects to cite its own shortcomings in that area. Applicant served its discovery requests on Opposer on July 14, 2003. Opposer's responses were due on or before August 19, 2003. Instead of serving its responses, Opposer chose to wait until the last minute, then filed a request for a 60 day extension. In support of its extension request, Opposer cited Applicant's failure to respond, however, Opposer did not provide a valid reason for its own failure to respond.

Whether or not the Applicant responded to Opposer's requests within the allotted response period, Opposer had an obligation to respond to Applicant's requests. Pursuant to TTAB Rule 403.03:

[d]iscovery in proceedings before the Board is not governed by any concept of priority of discovery or deposition. That is, a party which is the first to serve a request for discovery does not thereby gain a right to receive a response to its request before it must respond to its adversary's subsequently served request for discovery, and this is so even if its adversary fails to respond, or respond completely, to the first party's request for discovery. Rather, a party is under an obligation to respond to an adversary's request for discovery during the time allowed therefor under the applicable rules, irrespective of the sequence of requests for discovery, or of an adversary's failure to respond to a pending request for discovery.

In *Miss America Pageant v. Petite Productions, Inc.*, 17 U.S.P.Q. 2d 1067, "... the Board [took] the position that a party is not relieved of its discovery obligations in spite of the fact that its adverse party has wrongfully failed to fulfill its own obligations."

Opposer, who was the first party to serve discovery requests, had no valid reason for its failure to respond by August 19. Opposer merely wanted to receive Applicant's responses before submitting its own. When it became obvious that that wasn't going to happen, Opposer waited until the last moment, then filed a request for extension. Opposer claimed the request to be in good faith and not for any improper purpose of delay. Applicant disagrees. Opposer's request for extension was merely a delay tactic.

Opposer, again, failed to serve its discovery responses within the first requested 60-day extension period. Opposer waited until the last minute, then filed a second request for extension,

claiming that this second request was made in good faith and not for any improper purpose of delay; Opposer failed to cite its reasons for its own failure to respond to Applicant's discovery requests. Once again, Applicant disagrees with the Opposer's good faith assertions. This was clearly another intentional delay tactic.

In para. [3] of its response to Applicant's request for reconsideration of the Board's decision, Opposer asserts that Applicant has not yet served any responses. Yet, in the Opposer's November 24, 2003 reply to Applicant's response to the motion to compel, Opposer acknowledges receipt of the Applicant's discovery responses. Which is it? Responses were served on November 13, well within the newly extended deadline. Just because they are not the answers that the Opposer wanted, it does not negate the fact that responses were served - on time- effectively putting an end to the issue of response. The Opposer was required to notify the Board, in a separate writing, of this receipt of Applicant's responses, yet failed to do so.

In its submissions to the Board, Opposer has repeatedly chastised Applicant for its failure to respond and its alleged disregard for the Rules of the Board. These assertions are absolutely false. Admittedly, although Applicant's responses were due on August 7, 2003 and August 11, 2003, they were not timely served. On August 18, 2003, Opposer accepted Applicant's apology, and its explanation of the delay as being a communication error, agreeing to a short extension until August 25. Applicant extended the same courtesy to Opposer, whose responses were due on August 19, and Opposer accepted. Further, Opposer filed a formal 60-day extension request with the Board to allow Applicant additional time to evaluate its position and respond accordingly.

By agreeing to the extensions, Opposer waived its right to claim that the Applicant was

non-responsive. Opposer granted Applicant 60 additional days to respond, therefore, Opposer had no basis to claim non-responsiveness until the new deadline of October 17 passed. On October 17, Opposer filed another 60-day extension request, moving the response deadline to December 19. This was done of the Opposer's own volition. Applicant did not request the extension. Once again, the Opposer had no basis to claim non-responsiveness until December 19.

Opposer's premature filing of its motion to compel created a situation in which there were overlapping response deadlines, thus clouding and distorting the proceeding. The Board added to the confusion by granting the second extension request prior to the deadline for Applicant's response to the motion to compel. The Board did not offer any clarification as to the applicable deadlines, therefore, the Applicant held true to the established discovery response deadlines, as it was the most consistent time line.

Opposer cannot support its claim that the Applicant was non-responsive. Applicant did not disregard the Rules. Applicant responded to Opposer's requests on November 13, well within the time frame established by the Opposer's own request.

Opposer, however, did not serve its responses until January 5, 2004, seventeen days beyond the deadline established by its own second extension request, although the Opposer's interrogatory responses were signed and dated August 18, 2003. It is a logical conclusion that the production response was complete and ready for submission on the same date. At no time does the Opposer offer any explanation for its delay in serving the responses. Rather, Opposer points the finger at the Applicant, accusing it of being unresponsive.

Opposer blatantly disregarded TTAB Rule 403.03, which states, in part:

“. . . a party is under an obligation to respond to an adversary’s request for discovery during the time allowed therefor under the applicable rules, irrespective of the sequence of requests for discovery, or of an adversary’s failure to respond to a pending request for discovery.”

Despite this, Opposer repeatedly claims to be acting in good faith and not for any improper purpose of delay.

In its discovery responses, Opposer blanketly objected to each and every interrogatory and/or request for production propounded on the grounds that the information requested is “overly broad, vague, burdensome, and not reasonably calculated to lead to the discovery of admissible evidence.” While that response may be within Opposer’s rights, Applicant is a little dismayed by those assertions, given that the Applicant’s requests directly mirror the Opposer’s requests in almost every instance. Opposer certainly expects the Applicant to respond in full detail and vehemently argues in its motion to compel that the Applicant should not be granted the opportunity to raise the same objections.

In a number of its responses, Opposer declines to answer or to produce documents without a Protective Order, agreed to and signed by the Applicant, citing the proprietary and confidential nature of the information requested. Opposer, however, has not filed a motion to request the order, nor did Opposer contact Applicant with regard to such order. Applicant, however, did file a Motion for Protective Order Regarding Discovery Material, and Opposer responded by requesting the motion be denied. The confidential information requested by both

parties is virtually the same. How does the Opposer justify its belief that it should be protected by such an order, but the Applicant should not?

Applicant respectfully renews its request for the Board to reconsider its December 5 decision and to dismiss the motion to compel as moot. Opposer's greatest complaint is that the Applicant has not responded to its discovery requests, violating the TTAB Rules. That assertion is absolutely false. Applicant responded, in good faith, well within the deadline set by the Opposer's own request.

Opposer continually describes its actions as being done in good faith. Black's Law Dictionary, Abridged Sixth Edition defines good faith as ". . . an honest belief, the absence of malice and the *absence of design* to defraud or *to seek an unconscionable advantage*." (emphasis added) Applicant submits that the Opposer's actions have been anything but done in good faith. Rather, Applicant submits that the Opposer's actions have been calculated to gain an unconscionable advantage.

Opposer repeatedly violated TTAB Rule 403.03 by failing to respond to Applicant's requests, without valid reason: (1) when it failed to respond by the August 19 deadline, (2) when it failed to respond by the October 17 deadline, and (3) when it failed to respond by the December 19 deadline. This fact was consistently omitted from Opposer's submissions.

Further, Opposer failed to inform the Board of its receipt of Applicant's responses, thus violating TTAB Rule 2.120(e). By doing so, the Opposer manipulated the Board into granting its motion to compel the Applicant to respond without objection. Applicant contends that Opposer's actions were deliberate and calculated to allow it to effect an end-run around the discovery rules. Opposer is simply looking for a way to force the Applicant to reveal trade

secrets and other privileged information, while Opposer hides behind its objections.

Opposer has not acted in good faith through this process. Opposer has repeatedly filled its submissions with half-truths and skewed time lines, while omitting all references to its own short-comings, in an attempt to manipulate the Board's rulings in its favor.

Given the Applicant's compliance with the response deadlines established by the Opposer's own extension requests, and the Opposer's blatant violations of the TTAB Rules, the Board must reconsider its December 5, 2003 ruling in a light favorable to the non-movant Applicant, and render the Opposer's motion to compel moot.

Dated: February 9, 2004

Respectfully submitted,

/s/

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Counsel for Applicant

**CERTIFICATE OF SERVICE**

I hereby certify that on February 9, 2004, I caused a true and correct copy of the Applicant Hoffman Neopac A.G.'s Reply to Opposer's Response to Hoffman's Motion for Reconsideration of Board's December 5, 2003 Order to be served by First Class, United States Mail on counsel for Opposer as follows:

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\_\_\_\_\_/s/  
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# **EXHIBIT A**

HOFFMANN NEOPAC

HOFFMANN

NEOPAC

E-MAIL

SUCHEN

HOFFMANN NEOPAC  
PACKAGING SOLUTIONS



- INFORMATIONEN
- STANDORTE
- KONTAKT
- JOBS

HOFFMANN...

Weissblech-Verpackungen

Kunststoff- und Laminattuben

[for-english@hoffmannneopac.ch](mailto:for-english@hoffmannneopac.ch)

<http://www.hoffmannneopac.ch/hof-neo/d/default.htm>

On St@g

<http://www.hoffmannneopac.ch/hof-neo/d/>

1/30/2004

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