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

Proceeding	91154092
Party	Defendant ShaReem, Inc. ShaReem, Inc. 965 Lambrecht Road Frankfort, IL 60423
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

National Academy of Recording Arts & Sciences, Inc.)	
)	
)	
Opposer,)	
)	
v.)	Opposition No. 154,092
)	
ShaReem, Inc.,)	Opposition No. 145,417
)	
Applicant.)	

REPLY IN SUPPORT OF APPLICANT’S MOTION TO DETERMINE THE
SUFFICIENCY OF OPPOSER’S RESPONSES TO REQUESTS FOR
ADMISSION AND TO COMPEL AN ANSWER TO INTERROGATORY 17

Applicant Shareem, Inc. submits this reply in support of its motion for an order to determine the sufficiency of opposer’s responses to Applicant’s First Requests For Admission and to compel an answer to Interrogatory 17.

I. Opposer Fails To Offer Any Explanation For Its Untimely Responses

Opposer cannot and does not dispute that its responses were served late, the day after they were due. A failure to provide a timely response generally results in objections being waived and requests to admit being admitted absent a showing of excusable neglect or a successful motion to withdraw the admissions.

Here, opposer offers no explanation for its late responses. Opposer cites *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership*, 507 U.S. 380 (1993) in support of its statement that its requests should not be deemed admitted or its objections deemed waived. In so doing, however, opposer simply ignores the requirement in *Pioneer*, adopted in *Pumpkin Ltd. v. Seed Corps*, 43 USPQ 1582 (TTAB 1997), of providing “the reason

for the delay, including whether it was in the reasonable control of the [party].” *Pioneer*, 507 U.S. at 395; *Pumpkin*, 43 USPQ 2d at 1586. This factor has been found to be the most important of the factors to be considered. *See, e.g., Atlanta–Fulton County Zoo Inc. v. DePalma* 45 USPQ 2d 1858, 1859 (TTAB 1998). Failure to provide such an explanation is grounds for finding no excusable neglect. *HKG Industries Inc. v. Perma–Pipe Inc.*, 49 USPQ 2d 1156, 1158 (TTAB 1998) (No excusable neglect where petitioner failed to provide reason for its delay, even though there was no measurable prejudice to respondent, the length of the delay was insignificant and there was no evidence of bad faith). Opposer’s failure to provide any explanation similarly precludes a finding of excusable neglect here.

Rather than address the lateness of its responses, opposer attempts to attack applicant and the timing of applicant’s motion.¹ Opposer contends that the motion was not filed in compliance with TBMP Rules 523.03 and 524.03. The Rules, however, require that any discovery motion be filed prior to the opening of opposer’s testimony period, which is exactly what applicant did, after first writing opposer in an attempt to work out a resolution and giving opposer time to respond.² *See Societe Per Azioni Chianti Ruffino v. Colli Spolenti Spoletoducale*, 59 USPQ 2d 1383, 1383 (TTAB 2001) (Motions directed to deficiencies of discovery responses are to be filed prior to opening of opposer’s testimony period.)

¹ Opposer also notes that following applicant’s filing of this motion opposer sent a letter in which it was stated it was willing to work with applicant. The remainder of the letter, however, made clear opposer’s position that its responses were proper and showed that opposer was unwilling to make any change to its responses – a position reiterated by opposer in its opposition to the motion.

² Opposer also quotes the statement made by the Board in a prior motion faulting applicant for not being able to more quickly identify all of the deficiencies of the production opposer made in response to the Board’s Order granting applicant’s prior motion to compel when opposer failed to provide basic discovery. While applicant respectfully disagrees with that conclusion given the facts that opposer produced over 1,500 pages that it previously had wrongfully withheld and it took time to identify all of the deficiencies (deficiencies opposer did not deny existed with respect to the initial production it made on the date set by the Board’s Order and that it did not cure until much later), it has no bearing on the present motion.

II. Opposer's Responses Are Deficient

Even if the Board were to excuse opposer's failure to provide timely responses, its responses are substantively deficient.

A. Requests To Admit

As noted in applicant's motions, opposer responded to Request 42, 45, 48, 51, 54, 57, 60, 63, 66, 72, and 75 by denying the requests and then providing narrative responses that confirm that the requests should have been admitted. For example, as set forth at page 2 of applicant's motion, opposer responded to Request 42 as follows:

Request No. 42: Opposer has made no objection to the registration or use of the mark COMPUTERS FOR GRAMMYS.

Response to Request No. 42: Denied. Opposer states that it has no objection to the mark COMPUTERS FOR GRAMMYS as it is currently being used. Opposer continues to monitor COMPUTERS FOR GRAMMYS to ensure that no instances of actual confusion arise between Opposer's goods and services and those goods and services offered by COMPUTERS FOR GRAMMYS. Opposer also continues to monitor COMPUTERS FOR GRAMMYS to ensure that it has not expanded its use into music or music related goods and services.

Each of the other requests identified above similarly ask opposer to admit it "has made no objection" to a particular use. In response to each request, opposer states that it has no objection to the use and that it "continues to monitor the use," showing that the proper response would have been to admit the requests. On their face, opposer's responses to these requests call into question opposer's compliance with Rules 11 and 36 FRCP. *See, e.g., Dulansky v. Iowa-Illinois Gas & Electric Co.*, 92. F.Supp. 118, 124 (S.D.Ia. 1950) (Rule 36 "requires absolute good faith and truthfulness in a response and any response which seeks to evade or avoid . . . will not be countenanced"). Opposer's brief repeats the same statements found in its answer to Request 42 and thereby emphasizes that opposer has made no objection to the identified uses and good faith

compliance with Rule 36 required that the requests be admitted. Requests 42, 45, 48, 51, 54, 57, 60, 63, 66, 72, and 75 should be deemed admitted.

It is well settled that a party's admissions or denials of a request to admit "must be forthright, specific, and unqualified" and that "[a] denial coupled with a general exception of doubtful import will be considered admitted." *Southern Ry. Co. v. Crosby*, 201 F. 2d 878 (4th Cir. 1953). Opposer tries to justify its failure to comply with the rule by contending that it is qualifying its denial as provided for by Rule 36. The provision in Rule 36 requiring a party to qualify its answer or deny only a portion of a request rather than deny a request in its entirety when good faith so requires does not give opposer the option to deny a request without any factual basis simply because it would prefer not to admit to the fact.

Opposer also fails to respond directly to Requests Nos. 3, 12, 23, 29, 41, 47, 50, 53, 56, 62, 65, 68, 71 and 74, instead adding argumentative and extraneous information. For example, Request 29 requests opposer to admit that opposer was informed by Jeanette Barnes "that 'Grammy' had been used in her family for over sixty years, as a name grandchildren had for their grandmother." Opposer responded as follows:

Response to Request No. 30: Admitted. Opposer also states that Jeanette Barnes uses the name Grammy Barnes Emporium in connection with selling crafts, vintage clothing and accessories and "to impart some of her knowledge and enjoyment of the Victorian Era."

The second statement in opposer's response following the word "Admitted" is in no way responsive to the Request and is not the type of qualification called for by Rule 36 in those instances where a Request can not be deemed admitted or denied in its entirety. Instead, in contradiction of Rule 36, opposer merely is adding a point it wants to make because it would prefer not to admit the fact set forth in the Request. The same is true of opposer's responses to

Requests 3, 23, 29, 41, 47, 50, 53, 56, 62, 65, 68, 71 and 74. The extraneous material should be stricken and the requests deemed admitted.

With respect to Requests 34 and 35, opposer attempts to excuse its failure to provide direct responses by stating that it objected to the requests. In fact, the responses opposer served contain no such objection. See Exhibit C to applicant's Motion, p. 7. Nor would such an objection be valid. More importantly, as shown by the discussion in opposer's opposition, opposer failed to provide a direct response to Request 34 or 35 and admit or deny that Heineken was given the right to call itself the "Official Beer Of The Grammys" and instead stated its admission of a related, but different, fact. Since opposer has not denied the requests, they should be deemed admitted.

Opposer also failed to directly address Request 79, stating that the document speaks for itself. As discussed above, Rule 36 requires opposer to give a direct response. Opposer cannot avoid the obligation by stating the document speaks for itself. In its opposition, opposer states that the document provides suggestions and a marketing strategy. If in fact opposer believes that the document does not contain market research conclusions as set forth in the Request, the proper response would be to deny the request and provide a narrative response to Interrogatory 17 explaining the denial. The proper response otherwise is an admission of the request.

B. Interrogatory No. 17

Interrogatory 17 requests opposer to state the basis for its denial of each request to admit denied by opposer and to identify any documents supporting its denial. Opposer provided no statement of the basis for its denial of Requests 4, 5, 6, or 7. In response, opposer notes that its answer stated that its denials were supported by the documents it attached to its Interrogatory Answer. While such a statement provides a response to the portion of the interrogatory

requesting opposer to identify documents, it is not a substitute for a narrative response to the request that it identify the basis for its denials. See, e.g., *Jain v. Ramparts Inc.*, 49 USPQ 2d 1429, 1433-34 (TTAB 1998) (Party can provide documents in lieu of narrative only if party can show it is burdensome to provide an interrogatory answer. Further, even if requirements regarding burdensomeness are met, the only documents a party can rely on in lieu of a response are its business records). Opposer should be required to provide a narrative response.

III. Conclusion

For the foregoing reasons, applicant requests that the requests to admit be deemed admitted or opposer be required to provide proper responses to Requests 3, 12, 23, 29, 34, 35, 41, 42, 44, 45, 47, 48, 50, 51, 53, 54, 56, 57, 60, 62, 65, 66, 68, 69, 71, 72, 74, 75, and 79. Applicant further requests that opposer be required to provide a response to Interrogatory 17 identifying the basis for its denial of Requests 4, 5, 6, and 7.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I, Patricia S. Smart, an attorney for applicant, hereby certify that a copy of the foregoing Reply In Support Of Applicant's Motion To Determine The Sufficiency Of Opposer's Responses To Requests For Admission And To Compel An Answer To Interrogatory 17 is being served upon counsel for opposer, James J. Wolfson, Greenberg Traurig, LLP, The Forum, 3290 Northside Parkway, Suite 400, Atlanta, GA 30327, this 26th day of August, 2006, by first class mail, postage prepaid.

/P S Smart/