

TTAB

THE UNITED STATES PATENT AND TRADEMARK OFFICE

UBS AG,	)	
	)	
Opposer,	)	
	)	Opposition No. 91154654
v.	)	
	)	Application Ser. No. 78/059,847
UNITED SECURITY BANK,	)	
	)	
Applicant.	)	

OPPOSER'S MOTION TO COMPEL DISCOVERY

Pursuant to 37 C.F.R. § 2.120(e), Opposer UBS AG ("Opposer") hereby requests that the Trademark Trial and Appeal Board issue an order compelling Applicant United Security Bank ("Applicant") to respond to Interrogatories 33 and 34 in Opposer's SECOND SET OF INTERROGATORIES TO APPLICANT UNITED SECURITY BANK. In particular, Opposer seeks identification and production of documents in accordance with 37 C.F.R. § 2.120 and Rules 26(b)(1) and 33 of the Federal Rules of Civil Procedure.

As more fully set forth in Opposer's memorandum submitted herewith, Applicant has failed to provide any discovery on the use of the dominant portion of its mark. Absent such discovery, particularly documents showing such use, Opposer will not be in a position to fully support its contentions in this case. Opposer has made numerous good faith attempts to resolve this issue, however, Applicant has not responded to these inquiries.



Respectfully submitted,

02-04-2004

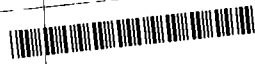
U.S. Patent & TMOtc/TM Mail Rcpt Dt. #22

February 4, 2004

By:

*Kevin T. Kramer*

Kevin T. Kramer  
PILLSBURY WINTHROP LLP  
1600 Tysons Blvd.  
McLean, VA 22102  
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Counsel for Opposer UBS AG



02-04-2004

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #22

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UNITED SECURITY BANK,	)	
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**OPPOSER’S MEMORANDUM IN SUPPORT OF MOTION TO COMPEL DISCOVERY**

**INTRODUCTION**

Opposer UBS AG (“Opposer”) has asked Applicant United Security Bank (“Applicant”) to provide Opposer with relevant information and documents regarding use of the dominant portion of Applicant’s USB E-Pay mark, which is virtually identical to Opposer’s UBS mark. Despite its obligation to comply with Opposer’s relevant discovery requests, Applicant has repeatedly failed to provide the requested information and documents. Because the requested information and documents are integral to Opposer’s ability to prove that the dominant portion of Applicant’s mark is confusingly similar to Opposer’s UBS mark, Opposer respectfully requests that the Board order Applicant to answer Opposer’s relevant interrogatories and produce the requested documents.

**FACTS**

On September 8, 2003, Opposer served a second set of interrogatories to Applicant. Ex. A: Second Set of Interrogatories. Specifically, Opposer asked Applicant to: 1) state whether Applicant uses the letters “USB” without the term “E-Pay” to advertise any of its services and, if

so, to identify all such uses and documents showing such use; and 2) identify the date on which Applicant first used the letters "USB" to advertise any of its services. *Id.*

On September 30, 2003, Applicant responded to Opposer's second set of interrogatories. Ex. B: United Security Bank's Responses. In its response, Applicant refused to state whether it uses the letters "USB" without the term "E-Pay" to advertise any of its services and, if so, to identify all such uses and documents showing such use, or to identify the date on which Applicant first used the letters "USB" to advertise any of its services. *Id.* at Response Nos. 33 and 34. Instead, Applicant simply objected to both interrogatories on grounds of relevance. *Id.*

On October 15, 2003, Opposer sent Applicant an e-mail explaining the relevancy of interrogatories 33 and 34 and asking Applicant to provide supplemental responses and representative samples of Applicant's advertisements. Ex. C: October 15, 2003, E-mail from Kramer to Woolman.

Because Applicant did not respond, Opposer sent Applicant a second e-mail on October 22, 2003, requesting supplemental interrogatory responses and documents. Ex. C: October 22, 2003, E-mail from Kramer to Woolman.

Once again, Applicant did not respond.

On October 24, 2003, Opposer sent Applicant a letter explaining the relevancy of interrogatories 33 and 34 and requesting supplemental responses and the production of the pertinent documents. Ex. D: October 24, 2003, Letter from Jennings to Woolman.

Applicant failed to respond again.

Because the parties were engaged in settlement discussions, Opposer waited until January 27, 2004, to send a follow-up letter requesting supplemental responses and the production of the pertinent documents. Ex. E: January 27, 2004, Letter from Kramer to Woolman.

Applicant completely failed to respond again.

## DISCUSSION

Generally, the scope of discovery in Board proceedings is governed by Fed. R. Civ. P. 26(b), which essentially provides that a party is entitled to discovery regarding any matter, not privileged, which is relevant to the subject matter of the proceeding, or which appears reasonably calculated to lead to the discovery of admissible evidence. *See* T.B.M.P. § 402.01; *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1761 (T.T.A.B. 1999); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (T.T.A.B. 1988); *Fischer Gesellschaft M.B.H. v. Molnar and Co., Inc.*, 203 USPQ 561, 565 (TTAB 1979). Each party in a dispute before the Board has a duty to make a good faith effort to satisfy the discovery requests of its adversary and seek only such discovery as is proper and relevant to the specific issues involved in the proceeding. Fed. R. Civ. P. 26(g); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1305 (T.T.A.B. 1987); *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (T.T.A.B. 1986); TBMP § 408.01.

In this case, Opposer is undoubtedly seeking relevant information. Whether Applicant ever uses the three-letters "USB" without the phrase "E-Pay," the manner in which it does so, and the date on which it began doing so are relevant to determining the dominant portion of Applicant's mark. Determining the dominant portion of Applicant's mark is an integral part of Opposer's case because the dominant portion of a mark is generally given greater weight in the likelihood of confusion analysis, enabling Opposer to prove that the marks are in fact similar in sound, appearance, meaning or commercial impression. *See In re National Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985); *In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214, 1217 (T.T.A.B. 2001).

Without the information and documents requested in interrogatories 33 and 34, Opposer will not have all of the relevant evidence it needs to prove that the letters "USB" are the

Without the information and documents requested in interrogatories 33 and 34, Opposer will not have all of the relevant evidence it needs to prove that the letters "USB" are the dominant portion of Applicant's mark and that, as a result, the dominant portion of Applicant's mark is virtually identical and confusingly similar to Opposer's mark. Thus, Applicant's failure to answer Opposer's interrogatories and produce the pertinent documents will limit Opposer's ability to submit all of the relevant evidence in this case.

### CONCLUSION

Because Applicant has failed to provide any discovery concerning the dominant portion of its mark, Opposer respectfully requests that the Board grant Opposer's motion to compel Applicant to provide supplemental responses to Opposer's second set of interrogatories and to produce the documents requested to be identified.

Respectfully submitted,

February 4, 2004

By:



Kevin T. Kramer  
James R. Menker  
Patrick J. Jennings  
PILLSBURY WINTHROP LLP  
1600 Tysons Blvd.  
McLean, VA 22102  
Tel: 703-905-2000  
Fax: 703-905-2500

*Counsel for Opposer UBS AG*

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing OPPOSER'S MOTION TO COMPEL DISCOVERY and OPPOSER'S MEMORANDUM IN SUPPORT OF MOTION TO COMPEL DISCOVERY was served on Applicant's attorney, William Woolman of Jory, Peterson, Watkins & Smith, with an address at P.O. Box 5394, Fresno, California 93755-5394 via first class mail, postage prepaid, today February 4, 2004.

By:

  
Patrick J. Jennings

# EXHIBIT A





Opposition No. 91154654

## INTERROGATORIES

### INTERROGATORY NO 32

State whether the three letter portion of Applicant's Mark – "USB" – is an acronym or abbreviation, and, if so, explain for what.

### INTERROGATORY NO 33

State whether the Applicant ever uses the three letter portion of Applicant's Mark – "USB" – without the term "E-Pay" in any advertising for any service offered by Applicant, and, if so, identify all such uses and all documents showing such use.

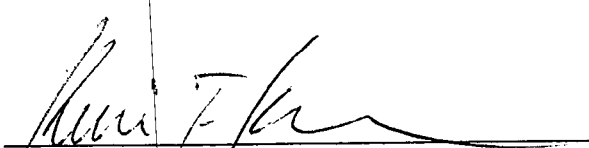
### INTERROGATORY NO 34

Identify the date on which Applicant first used the three letter portion of Applicant's Mark – "USB" – without the term "E-Pay" in any advertising for any service offered by Applicant.

Respectfully submitted,

UBS AG

Date: September 8, 2003

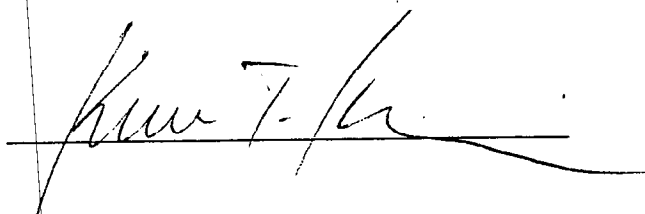


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Kevin T. Kramer  
James R. Menker  
PILLSBURY WINTHROP LLP  
1600 Tysons Boulevard  
McLean, Virginia 22102  
(703) 905-2000  
(703) 905-2500 (fax)

**CERTIFICATE OF SERVICE**

It is hereby certified that a copy of the foregoing UBS'S SECOND SET OF INTERROGATORIES TO APPLICANT UNITED SECURITY BANK has been served on William M. Woolman of Jory, Peterson, Watkins & Smith, 555 West Shaw Avenue, Suite C-1, P.O. Box 5394, Fresno, California 93755-5394 by first class mail, postage prepaid, this 8th day of September, 2003.



A handwritten signature in cursive script, appearing to read "K. T. Smith", is written over a horizontal line. The signature is positioned to the right of the main text block.

# EXHIBIT B

William M. Woolman, Esq. #145124  
JORY, PETERSON, WATKINS & SMITH  
555 West Shaw Avenue, Suite C-1  
P. O. Box 5394  
Fresno, California 93755-5394

Telephone: (559) 225-6700  
Facsimile No.: (559) 225-3416

Attorneys for: Applicant, UNITED SECURITY BANK

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

UBS AG,	)	Opposition No. 91154654
	)	
	)	Serial No. 78/059,847
vs.	)	
	)	
UNITED SECURITY BANK,	)	UNITED SECURITY BANK'S
	)	RESPONSES TO
	)	OPPOSER UBS'S
	)	SECOND SET OF
	)	<u>INTERROGATORIES</u>
	)	
	)	
	)	
	)	
	)	

United Security Bank ("USB") provides the following answer to Opposer UBS's Second Set of Interrogatories to Applicant United Security Bank:

**INTERROGATORIES**

**INTERROGATORY NO. 32**

State whether the three letter portion of Applicant's Mark – "USB" – is an acronym or abbreviation, an, if so, explain for what.

**RESPONSE TO INTERROGATORY NO. 32:**

Objection. The request is vague, ambiguous, compound, overbroad, irrelevant and not likely to lead to the discovery of admissible evidence. Without waiving these objections, USB provides the following response: USB E-Pay means "United Security Bank's Electronic Pay" system.

INTERROGATORY NO. 33

State whether Applicant ever uses the three letter portion of Applicant's Mark – "USB" – without the term "E-Pay" in any advertising for any service offered by Applicant, and, if so, identify all such uses and all documents showing such use.

RESPONSE TO INTERROGATORY NO. 33:

Objection. The request is vague, ambiguous, compound, overbroad, irrelevant and not likely to lead to the discovery of admissible evidence. Applicant's registration application only sought protection of the mark USB E-Pay. Therefore, Applicant's use of any other mark is irrelevant.

INTERROGATORY NO. 34

State the date on which Applicant first used the three letter portion of Applicant's Mark – "USB" – without the term "E-Pay" in any advertising for any service offered by Applicant.

RESPONSE TO INTERROGATORY NO. 34:

Objection. The request is vague, ambiguous, compound, overbroad, irrelevant and not likely to lead to the discovery of admissible evidence. Applicant's registration application only sought protection of the mark USB E-Pay. Therefore, the date Applicant first used any other mark is irrelevant.

DATED: September 30, 2003.

JORY, PETERSON, WATKINS & SMITH

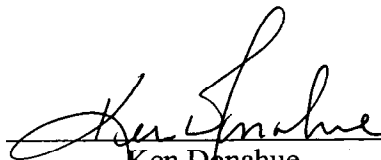
By 

Attorneys for Applicant  
UNITED SECURITY BANK

**CORPORATE VERIFICATION**

I am the Senior Vice President and Chief Financial Officer of Applicant in the above-entitled action; I have read the foregoing RESPONSES TO OPPOSER UBS'S SECOND SET OF INTERROGATORIES and know the contents thereof; I certify that the same is true of my own knowledge, except as to those matters which are therein stated upon my information or belief, and as to those matters, I believe them to be true.

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct, and that this verification was executed this 10<sup>th</sup> day of October 2003, at Fresno, California.

  
\_\_\_\_\_  
Ken Donahue

**PROOF OF SERVICE BY U.S. MAIL**

My business address is 555 West Shaw Avenue, Post Office Box 5394, Fresno, California 93755. I am employed in Fresno County, California. I am over the age of 18 years and am not a party to this case.

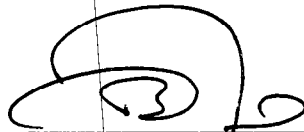
I am readily familiar with the business' practice for collection and processing of correspondence for mailing with the United States Postal Service. The business' correspondence is deposited with the United States Postal Service that same day in the ordinary course of business.

On October 10, 2003, I served UNITED SECURITY BANK'S RESPONSES TO OPPOSER UBS'S SECOND SET OF INTERROGATORIES on all interested parties in this action by placing a true copy thereof enclosed in sealed envelopes addressed as follows:

Kevin T. Kramer, Esq.  
PILLSBURY WINTHROP, LLP  
1600 Tysons Boulevard  
McLean, Virginia 22102

I caused such envelopes to be deposited in the United States mail, with postage thereon fully prepaid, at my business address as set forth above following ordinary business' practices.

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct and that this proof of service was executed on October 10, 2003, at Fresno, California.



Beth Noel

# EXHIBIT C



**Jennings, Patrick J.**

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**From:** Kramer, Kevin T.  
**Sent:** Wednesday, October 22, 2003 11:38 AM  
**To:** 'William Woolman'  
**Cc:** Menker, James R.; Jennings, Patrick J.  
**Subject:** RE: Re-scheduling Deposition 3741-75

Bill,

Could you let me know where your client stands on UBS's request for supplemental interrogatory responses and documents? I'd like to know whether we will be forced to move to compel responses and documents if your client decides to go forward with the case.

Thanks.

Kevin

-----Original Message-----

**From:** William Woolman [mailto:Wmw@jpws.com]  
**Sent:** Wednesday, October 15, 2003 3:10 PM  
**To:** Kramer, Kevin T.  
**Subject:** Re: Re-scheduling Deposition 3741-75

Thank you for your timely response to my inquiry. As to depositions, I agree to the terms you assert and am told that a decision will be rendered by the end of the month. As to available dates for United Security Bank's representative, November 3, 5, 13 and 14 are available dates. As to UBS' representative, as time permits, please provide me with possible dates and a location.

I will respond to your objections to United Security Bank's interrogatory responses shortly.

Bill

>>> "Kramer, Kevin T." <kkramer@pillsburywinthrop.com> 10/15/03 11:50AM

>>> >>>

After considering your request, we agree to postpone the parties' respective depositions if: (1) you will agree to an extension of the deadlines in the case for a one month period; (2) let me know by the end of the month whether your client decides to withdraw the application; and (3) provide me with an acceptable date in November for your client's deposition should the case proceed.

Let me know whether this is acceptable.

Despite agreeing to postpone the depositions, we do not agree that the entire discovery process should be stayed pending your client's decision to pursue this application. In this regard, I have just received your client's responses to interrogatories 32-34. United Security Bank's use of the USB acronym is relevant to determining the dominant portion of its USB E-Pay mark. Accordingly, it is relevant to the claims made by UBS in this case, and I request that United Security Bank provide supplemental interrogatory responses and representative samples of its advertisements.

Please let me know whether United Security Bank will supplement its responses and when we can expect to

receive those responses.

I look forward to hearing from you.

Kevin T. Kramer  
Pillsbury Winthrop LLP  
1600 Tysons Blvd  
McLean, Virginia 22102  
Tel: 703-905-2119  
(Not Admitted in Virginia)

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# EXHIBIT D



**PILLSBURY WINTHROP LLP**

1600 TYSONS BOULEVARD MCLEAN, VA 22102 703.905.2000 F: 703.905.2500

October 24, 2003

Patrick J. Jennings  
Phone: 703.905.2018  
pjennings@pillsburywinthrop.com

**VIA FACSIMILE**

William M. Woolman  
Jory, Peterson, Watkins & Smith  
P. O. Box 5394  
Fresno, CA 93755-5394

Re: U.S. Trademark Opposition  
Opp. No. 91154654

Dear Mr. Woolman:

We continue to request supplemental interrogatory responses to interrogatories 32-34, which we originally requested in an October 15, 2003 e-mail. As we mentioned in our e-mail, United Security Bank's use of the acronym USB is particularly relevant to determining the dominant portion of United Security Bank's USB E-Pay mark. With this in mind, please let us know whether United Security Bank intends to comply with our request to provide supplemental responses and produce the necessary documents. If so, please forward the responses and documents as soon as possible. If not, please inform your client that we will be forced to file a motion to compel production of the relevant documents.

We look forward to hearing from you with respect to the above-mentioned matter.

Very truly yours,

  
Patrick J. Jennings

cc: Kevin T. Kramer  
James R. Menker

**EXHIBIT E**



**PILLSBURY WINTHROP<sup>LLP</sup>**

1600 TYSONS BOULEVARD MCLEAN, VA 22102 703.905.2000 F: 703.905.2500

January 27, 2004

Kevin T. Kramer  
Phone: 703.905.2119  
kkramer@pillsburywinthrop.com

**VIA E-MAIL**

William M. Woolman, Esq.  
Jory, Peterson, Watkins & Smith  
P. O. Box 5394  
Fresno, CA 93755-5394

Re: U.S. Trademark Opposition  
Opp. No. 91154654

Dear Mr. Woolman:

My colleague, Pat Jennings, has been attempting to contact you regarding settlement, but we have not received a reply to any of his phone calls. Please note that absent your indication that your client accepts the conditions for settlement set forth in our December 5, 2003 letter, we have no choice but to rigorously pursue this matter.

In that regard, we are awaiting your client's supplemental responses to UBS's Interrogatories 32-34 that we requested several months ago. As noted in our previous letter on this subject, United Security Bank's use of the acronym "USB" is particularly relevant to determining the dominant portion of United Security Bank's USB E-Pay mark. If United Security Bank intends to comply with our request to provide supplemental responses and produce the necessary documents, please let me know by the close of business Friday, January 30, 2004 when we can expect to receive the supplemental responses and documents. If we do not hear from you, we will be forced to file a motion to compel.

We look forward to hearing from you with respect to the above-mentioned matter.

Very truly yours,

Kevin T. Kramer