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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

07-09-2003

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

In re Application of:)
)
Go Daddy Software, Inc.)
Opposition)
No.: 91156061)
Serial No.: 78/137180)
Mark: STEALTHRAY)
Filing Date: 06/19/02)
Published: 12/17/02)
Legal Asst.: Pauline Stewart)
)

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APPLICANT'S RESPONSE TO OPPOSER'S MOTION TO TEST THE SUFFICIENCY OF RESPONSE TO ADMISSIONS

Applicant hereby responds to Opposer's Motion to Test the Sufficiency of Applicant's Response to Opposer's Request for Admissions. This Response is supported by the following Memorandum.

MEMORANDUM

Opposer's Motion to Test the Sufficiency of Applicant's Responses to Opposer's Admissions should be denied for several reasons.[1] First, Opposer falsely asserts that he made a good faith effort to resolve the issues presented by the instant Motion. The

[1] Pending before the Board is Applicant's Motion for an extension of the response deadline to Opposer's discovery. Applicant proceeded with response to Opposer's Requests for Admissions in an abundance of caution to avoid a claim by Opposer that the Requests should be deemed admitted. Applicant is awaiting the Board's ruling on its Motion before responding to Opposer's remaining discovery.

assertion is itself insufficient. During a brief conversation between Opposer and undersigned counsel, Opposer terminated the conversation shortly after it began, refusing to discuss the objections of Applicant and hanging up on counsel.

Second, Opposer's arguments in support of the Motion are baseless. The only analysis presented by Opposer in his Motion relates to requested admissions 1.1, 1.2 and 5. As to admission request 1.1, Opposer requested Applicant to admit that "it is well known to the Applicant that Opposer holds rights to the attached list of Applications/Registrations." Applicant was more than entitled to deny the requested admission. The referenced attached list of "Applications/Registrations" constitutes rank hearsay. Applicant believes that Opposer in fact does not hold legitimate or bona fide rights to the various marks referenced in the applications or registrations. The scope or extent of Opposer's purported rights in numerous asserted trademarks is certainly not "well known" to Applicant. Applicant believes Opposer is "warehousing" trademarks in an effort to hold other legitimate trademark owners hostage to licensing demands. The matter is sharply in dispute in this case. Applicant is more than entitled to deny Opposer's asserted rights to the trademarks at issue.

As to admission request 1.2, it is equally not "obvious that Opposer is the senior user of the mark at issue," as asserted by Opposer. Applicant believes, based on Opposer's numerous frivolous actions in past Board and court proceedings, that Opposer does not truly use trademarks in the fashion he asserts, and Applicant disputes Opposer's use of the registered mark in the same fields or channels of commerce as that of Applicant's "STEALTHRAY" mark. Certainly the Examining Attorney seems to

support this notion by allowing Applicant to proceed notwithstanding Opposer's registration. Opposer's use of the "STEALTH" mark is sharply in dispute in this case and will be the subject of Applicant's discovery requests. Applicant is certainly not in a position to admit Opposer's requested admission at this stage in the Opposition, if at all.

As to admission request 5, Opposer is simply wrong in suggesting that its "STEALTHRAY" mark is any way "identical" to Applicant's "STEALTH" mark. In any event, Applicant properly denied the requested admission because Opposer did not precisely request any basis of comparison, whether by sight, sound, meaning, consumer impression, channels of commerce or trade or other comparisons. Applicant intends to forcefully rebut any claim by Opposer that the marks are confusingly similar. Opposer is not entitled to an admission from Applicant that the marks are "identical." Applicant's position is hardly "disingenuous and disceitful (sic)" as suggested by Opposer in his Motion.

Third, Opposer himself admitted repeatedly in his comments to counsel that an admission or denial of the specific requests would have "no outcome on the case," and he was therefore astonished that Applicant would not simply accede to Opposer' requests. Opposer repeatedly stated "what difference does it make to the outcome – the requested admissions do not negatively affect your client's case so why not just admit them?" *See* Exhibit "A," Affidavit of undersigned counsel. When undersigned counsel tried to explain the objections and basis for Applicant's denials, Opposer shouted back that Applicant's responses were "disingenuous" and that all Applicant had to do was look into Opposer's numerous past litigation matters to verify that he was successful in enforcing

trademark rights in the fashion sought here. *See* Exhibit "A." When undersigned counsel remarked that Applicant's investigation led it to believe that Opposer in fact was not successful in previous actions, was sanctioned by one or more judicial bodies and seemed to extract nuisance value settlements rather than legitimately terminating use of another's trademark, Opposer's Mr. Stoller became angry and hung up on undersigned counsel. Given these remarks, Opposer has no good faith basis for the requests for admissions in the first place. Opposer should prove his trademark rights and establish legitimate trademark use, which Applicant believes cannot be done. Applicant was entitled to deny the subject requested admissions propounded by Opposer.

Opposer has provided no legitimate basis to request that the stated admissions be deemed admitted. His Motion should therefore be denied. As the Motion is baseless, on its face, Applicant respectfully requests its attorney's fees incurred in this action.

RESPECTFULLY SUBMITTED this 8th day of July 2003.

GO DADDY SOFTWARE, INC.

By: ______________________

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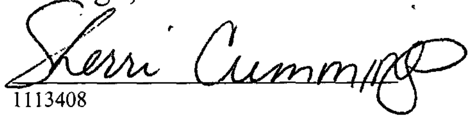
CERTIFICATE OF SERVICE

I hereby certify that Applicant's Response to Opposer's Motion to Test the Sufficiency of Response to Admissions is being Express Mailed to Mr. Stoller on July 8, 2003 as follows:

Leo Stoller
CENTRAL MFG., Opposer
Trademark & Licensing Dept.
P.O. Box 35189
Chicago, Illinois 60707-0189



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A

1 **AFFIDAVIT OF BRIAN W. LaCORTE**

2 STATE OF ARIZONA)
) ss.
3 County of Maricopa)

4 Brian W. LaCorte, being first duly sworn upon his oath, deposes and says:

5 1. I am an attorney at the law firm of Gallagher & Kennedy and the attorney of
6 record for Applicant Go Daddy Software, Inc..

7 2. This Affidavit accompanies Applicant's Response to Opposer's Motion to
8 Test Sufficiency of Response to Admissions.

9 3. On June 24, 2003, Mr. Stoller telephoned and requested that we "revise" our
10 admission responses to the following admission requests: 1, 1.2, 4, 5, 7, 12.2, 12.3, 12.4
11 and 14. Mr. Stoller stated that whether we admitted or denied some or all of the specific
12 requests referenced, "it would have no outcome on the case." He repeatedly said, "What
13 difference does it make to the outcome?" And, "It doesn't negatively affect your client's
14 case so why not just admit it?" Mr. Stoller also said that the requested admissions were
15 obvious and shouted that our objections were "disingenuous."

16 4. When I asked Mr. Stoller to provide specifics on why our objections or
17 responses were without merit, he only stated that with regard to the objection to 12.3, the
18 list of purported cancellation actions were, admittedly, "not in evidence yet," but that the
19 objection was still without merit because we were free to verify Leo Stoller's "successful"
20 oppositions.

21 5. I then indicated to Mr. Stoller that we did not believe he was successful in
22 many of the oppositions and that in fact many applicants paid nuisance value settlements

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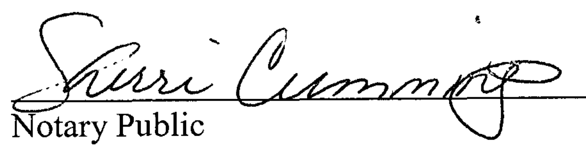
just to end the opposition, without interrupting their use of the mark. I also suggested that Applicant believes from its investigation that Mr. Stoller's operation does not involve a legitimate policing effort of bona fide trademarks in use, but rather an outwardly apparent effort to exact settlements for "warehoused" or "stored registrations" obtained from the Patent and Trademark Office without any legitimate use. At that point, Mr. Stoller became angry, said that based on our conversation he would file a Motion to Compel and hung up on me.

Brian W. LaCorte

SUBSCRIBED AND SWORN to before me this 8th day of July, 2003 by Brian W. LaCorte.



Notary Public

My Commission Expires