


TTAB

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

Dallas Basketball Limited §
§
Opposer, §
§
v. §
§
John Jacob Carlisle §
§
Applicant. §

Opposition No. 91156064
Serial No. 76/165,865
Mark: DEEP 3 & DESIGN

Assistant Commissioner for Trademarks
TTAB
2900 Crystal Drive
Arlington, Virginia 22202-3514


03-01-2004
U.S. Patent & TMOfr/TM Mail Rcpt Dt. #78

**OPPOSER'S MOTION FOR DISCOVERY UNDER
FEDERAL RULE 56(f)**

Dallas Basketball Limited, Opposer in the above-referenced opposition proceeding, files this Motion pursuant to Federal Rule of Civil Procedure 56(f) and pursuant to Section 528.06 of the TTAB Manual of Procedure and in support thereof would show as follows:

On February 23, 2004, Opposer's counsel was served with Applicant's Motion for Summary Judgment. Applicant's motion was supported by the Declaration of Applicant, John Jacob Carlisle. Applicant seeks summary judgment from the Board on the basis that Opposer cannot establish any facts that Applicant lacked a bona fide intent to use Applicant's mark when Applicant filed the application for the disputed mark. In order for Opposer to fully respond to the Motion for Summary Judgment, Opposer requires the deposition of John Jacob Carlisle and Dan Meckel, one of Mr. Carlisle's business partners. Applicant is in a unique position regarding Applicant's intent at the

time of the filing of the application. In support of this motion, the Declaration of Molly Buck Richard, counsel for Opposer, is attached hereto.

As noted in the attached affidavit, some of the documents in the file history and those produced by Applicant in response to requests for production of documents would indicate that a business known as Deep 3 existed prior to the filing of the subject application. These documents include the application which states Applicant's address as a P. O. Box in Fairbanks, Alaska which is the same P. O. Box used by an unincorporated entity known as Deep 3, at a time when Applicant's address was actually in San Antonio, Texas. (See Declaration of Molly Buck Richard, paragraph 2). It appears that the parties that may have had an informal partnership known as Deep 3 before the filing of the application were John Jacob Carlisle, Dan Meckel and James Hajdukovich, apparently all college friends who played basketball together. (See Carlisle Declaration, paragraph 1). While Mr. Carlisle's declaration indicates that they did not form any sort of business entity or partnership even on an informal basis (Carlisle Declaration paragraph 2), Opposer is unable to test these statements without the depositions of Mr. Carlisle and Mr. Meckel. In the letter attached as Exhibit B to the Declaration of Molly Richard, Mr. Hajdukovich, "President of Operations" for Deep 3 states that the address to which the Trademark Office was given in connection with the application never changed and that for the past two and a half years "we have been active in selling DEEP 3 gear." This letter is dated May 30, 2002. If these statements are correct, sales of the DEEP 3 clothing would have occurred well prior to the November 13, 2000 date of the subject application. At a minimum, a genuine issue of fact would be raised regarding whether Mr. Carlisle intended to use the mark in his individual capacity. If he did not, the subject application is void ab initio. See, e.g., American Forests v. Sanders 54 USPQ 2d 1860 (TTAB 2000) [application filed by an individual is

void ab initio when a partnership between the individual and her husband actually had the intent to use the mark].

Opposer has been attempting to take the deposition of Mr. Carlisle since the filing of this proceeding. (See Declaration of Molly Buck Richard, paragraph 4). Mr. Carlisle is apparently now a resident of Vancouver, Washington. Pursuant to documents produced by Applicant in this proceeding, Dan Meckel, one of the originators of the DEEP 3 mark and shareholder in Deep 3, Inc., is also a resident of the Vancouver, Washington area. (See Declaration of Molly Buck Richard, paragraph 3). Opposer intends to take both depositions in one day in Portland, Oregon, approximately nine miles from Vancouver, Washington, for sake of economy to both parties. These depositions are required in order to determine if an informal organization known as Deep 3 existed prior to the filing of the application which would establish that Mr. Carlisle did not intend to use the DEEP 3 mark in his individual capacity. Opposer submits that a sufficient basis has been shown for its need for additional discovery which is essential to this opposition. See Opryland USA Inc. v. The Great American Music Show Inc. 23 USPQ 2d 1471, 1475 (Fed. Cir. 1992) [when the discovery is reasonably directed to facts essential to justify the party's opposition, such discovery must be permitted or summary judgment refused]. The facts relating to Applicant's intent to use the mark are central to the issues in this proceeding. Opposer should be entitled to discovery thereon prior to responding to Applicant's Motion for Summary Judgment. Orion Group Inc. v. Orion Insurance Co. P.L.C. 12 USPQ 2d 1923, 1925 (TTAB 1989).

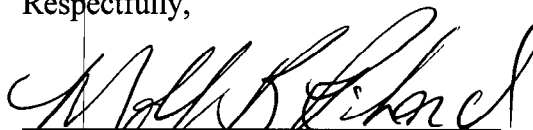
Applicant's counsel has been opposed to the taking of the deposition of Mr. Carlisle at his place of residence even though the Rules require that the deposition occur at his place of residence unless there is a stipulation of the parties to the contrary. (See Declaration of Molly Buck Richard,

paragraph 4). In order to avoid any further controversy on this issue, Opposer requests that the Board order that Opposer be permitted to take the depositions of John Jacob Carlisle and Mr. Meckel in the Vancouver, Washington area (including Portland, Oregon) prior to the filing of Opposer's Response to the Motion for Summary Judgment. Due to the fact that Mr. Meckel is not a party to this proceeding, Opposer would issue a subpoena pursuant to the Rules for Mr. Meckel's attendance.

Pursuant to Rule 56(f) of the Civil Rules of Civil Procedure and Section 528.06 of the TTAB Manual of Procedure, Opposer requests that the Board order that the depositions of John Jacob Carlisle and Dan Meckel take place in Portland, Oregon prior to any required response by Opposer. Opposer further requests that Opposer's time for responding to Applicant's Motion for Summary Judgment be extended to allow the depositions to take place as requested herein.

February 27, 2004

Respectfully,



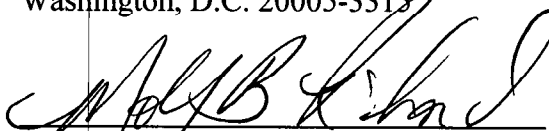
Molly Buck Richard
THOMPSON & KNIGHT, LLP
1700 Pacific Avenue, Suite 3300
Dallas, Texas 75201-4693
Telephone: (214) 969-1677
Facsimile: (214) 969-1751
ATTORNEYS FOR OPPOSER

502498 000008 DALLAS 1707913.1

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **Opposer's Motion for Discovery Under Federal Rule 56(f)** was served via first class U. S. mail to the following on February 27, 2004:

Mr. Mark Sommers
Finnegan, Henderson, Farabow,
Garrett & Dunner, L.L.P.
1300 I Street, N.W.
Washington, D.C. 20005-3315



Molly Buck Richard

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

Dallas Basketball Limited

Opposer,

v.

John Jacob Carlisle

Applicant.

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Opposition No. 91156064

Serial No. 76/165,865

Mark: DEEP 3 & DESIGN

DECLARATION OF MOLLY BUCK RICHARD

I, Molly Buck Richard, state that I am counsel for Dallas Basketball Limited in the above-referenced proceeding and I have knowledge of the statements made herein.

1. Opposer is unable without discovery to present by affidavit facts which are sufficient to show the existence of a genuine issue of material facts for trial. In particular, this opposition is based upon Applicant's lack of a bona fide intent to use the mark DEEP 3 & DESIGN in his individual capacity. Applicant, John Jacob Carlisle has filed a Declaration in Support of his Motion for Summary Judgment stating that he had an intent to use the mark in interstate commerce in his individual capacity and that he did not have any business organization prior to the filing of the application. However, certain documents have been produced which, upon further discovery, may determine that indeed a business was organized prior to the filing of the application for the purpose of marketing clothing under the DEEP 3 & DESIGN trademark.

2. In particular, attached hereto as Exhibit A is a copy of the application of John Jacob Carlisle wherein he states his address as P. O. Box 72036, Fairbanks, Alaska. As represented by Applicant's counsel, Mr. Carlisle moved from Fairbanks, Alaska to San Antonio, Texas in February

of 2000, approximately nine months prior to the filing of the trademark application. The address shown on the application is also the address on the letterhead for Deep 3 before it was an incorporated entity as shown in Exhibit B attached hereto. Exhibit B is a letter from James Hajdukovich who represents himself as President of Operations of Deep 3. In Exhibit B, Mr. Hajdukovich states that the address to which the Trademark Office has been given has never changed, indicating that the address Mr. Carlisle used in the application was the same address for the business known as Deep 3. Additionally, in Exhibit B Mr. Hajdukovich states that for the past two and a half years, "we have been active in selling DEEP 3 gear along with our Internet site." If this information is accurate, the business known as Deep 3 was selling DEEP 3 clothing long prior to the filing of the application by Mr. Carlisle in November of 2000. This statement is also reiterated in an email message from Mr. Hajdukovich to Mark Cuban attached hereto as Exhibit C. In the email message, Mr. Hajdukovich states that he coined the phrase "DEEP 3" with two team mates and they started a business in college. He again reiterates that they have been selling DEEP 3 for the last two and a half years. (See Exhibit C).

3. Opposer is unable to specifically challenge the statements made in the Declaration of John Jacob Carlisle attached to the Motion for Summary Judgment without Mr. Carlisle's deposition. Additionally, the deposition of Dan Meckel is requested since Mr. Meckel is one of the alleged partners in the business for Deep 3 and according to Applicant's documents, resides in the same general area as Mr. Carlisle. Mr. Meckel was identified as one of the persons that came up with the DEEP 3 mark while in college with Mr. Carlisle and Mr. Hajdukovich. He is also identified in various documents as one of the founders of Deep 3. His deposition will establish that there was a partnership or some other business relationship prior to November 13, 2000 for the purpose of

marketing DEEP 3 clothing. Opposer's counsel believes that both depositions can be taken in one day and it is requested that the depositions take place in Portland, Oregon which is approximately nine miles from where Applicant and Mr. Meckel reside.

4. Opposer's counsel has been attempting to obtain the deposition of Mr. Carlisle since the filing of this opposition. A Notice of Discovery Deposition was served upon counsel for Applicant on May 23, 2003. Prior to the date set forth in the deposition; however, Applicant filed a Motion for More Definite Statement and Motion to Suspend Proceedings which effectively precluded the deposition of Mr. Carlisle. On August 19, 2003 the Board issued its Order denying Applicant's Motion for More Definite Statement. Counsel has been attempting to schedule the deposition of Mr. Carlisle since but Applicant's counsel has refused to produce Mr. Carlisle for his deposition at his place of residence, instead insisting that Opposer's counsel take the deposition in Washington, D.C. where Applicant's counsel is located. Opposer is not required to take the deposition in Washington, D.C. and, indeed, pursuant to Rule 2.120(b) of the Trademark Rules of Practice, the deposition is to be taken where the deponent resides, namely in the Vancouver, Washington area. As noted previously, Vancouver is located approximately nine (9) miles from Portland, which is the nearest airport available to counsel. In this case, it is more economical for the parties to take the depositions of Mr. Carlisle and Mr. Meckel in the Portland, Oregon area since both deponents reside there.

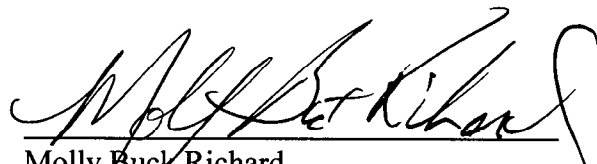
5. The depositions of Mr. Carlisle and Mr. Meckel will focus on the efforts of the two gentlemen, along with Mr. Hajdukovich, in adopting the DEEP 3 mark and marketing products prior to November 13, 2000, the date the Mr. Carlisle signed the trademark application. Additionally, information regarding the parties' formation of a business relationship prior to that date for purposes of selling products under the DEEP 3 trademark is necessary. This information is within the control

of Mr. Carlisle, the party moving for summary judgment and his associates such as Mr. Meckel.

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 USC § 1001 and that such willful false statement and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of her own knowledge are true; and all statements made on information and belief are believed to be true.

Further affiant saith not.

February 27, 2004



Molly Buck Richard

502498 000008 DALLAS 1708499.1

TRADEMARK/SERVICE MARK APPLICATION, PRINCIPAL REGISTER, WITH DECLARATION	MARK (Word(s) and/or Design) <u>Deep 3</u>	CLASS NO. (If known) <u>25</u>
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TO THE ASSISTANT COMMISSIONER FOR TRADEMARKS

APPLICANT'S NAME: John Jacob Carlisle

APPLICANT'S MAILING ADDRESS: P.O. Box 72036
Fairbanks, Alaska 99707

(Display address exactly as it should appear on registration)

APPLICANT'S ENTITY TYPE (Check one and supply requested information)

Individual - Citizen of (Country): John Jacob Carlisle, citizen of the USA.

Partnership - State where organized (Country, if appropriate): _____
 Names and Citizenship (Country) of General Partners: _____

Corporation - State (Country, if appropriate) of Incorporation: _____

Other (Specify Nature of Entity and Domicile): _____

GOODS AND/OR SERVICES

Applicant requests registration of the trademark/service mark shown in the accompanying drawing in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. 1051 et. seq., as amended) for the following goods/services (SPECIFIC GOODS AND/OR SERVICES MUST BE INSERTED HERE):

Basketball sportswear, shirts, baseball style caps, shorts, pants, socks, sweat shirts, jackets, sweat suits, sweat pants, bandanas, shoes, wrist and head bands, winter hats, watches, visors, towels, gloves, and basketballs.

BASIS FOR APPLICATION (Check boxes which apply, but never both the first AND second boxes, and supply requested information related to each box checked.)

Applicant is using the mark in commerce on or in connection with the above identified goods/services. (15 U.S.C. 1051(a), as amended.) Three specimens showing the mark as used in commerce are submitted with this application.

Applicant is using the mark in commerce in connection with the goods/services which the U.S. Congress may regulate (for example, interstate or

DECLARATION

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or if the application is being filed under 15 U.S.C. 1051(b), he/she believes the applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the above identified mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.

November 13, 2000
DATE

John J. Carlisle
SIGNATURE

(210) 637-6473
TELEPHONE NUMBER

John J. Carlisle
PRINT OR TYPE NAME AND POSITION

INSTRUCTIONS AND INFORMATION FOR APPLICANT

TO RECEIVE A FILING DATE, THE APPLICATION MUST BE COMPLETED AND SIGNED BY THE APPLICANT AND SUBMITTED ALONG WITH:

- \$ 325.00
1. The prescribed FEE (~~\$245.00~~) for each class of goods/services listed in the application;
 2. A DRAWING PAGE displaying the mark in conformance with 37 CFR 2.52;
 3. If the application is based on use of the mark in commerce, THREE (3) SPECIMENS (evidence) of the mark as used in commerce for each class of goods/services listed in the application. All three specimens include: (a) labels showing the mark which

APPLICANT'S NAME: John Jacob Carlisle

APPLICANTS ADDRESS: PO Box 72036, Fairbanks, Alaska 99707

GOODS AND SERVICES: Basketball sportswear, branding on shirts, baseball style caps, shorts, pants, socks, sweat suits, jackets, sweatshirts, sweatpants, bandanas, shoes, wrist & head bands, winter sock hats, watches, visors, blankets, towels, gloves, scarves, and basketballs.

DATE OF FIRST USE: Intent-to-Use Application

DATE OF FIRST USE IN COMMERCE: Intent-to-Use Application

DESIGN: The number 3 with a basketball in the center.

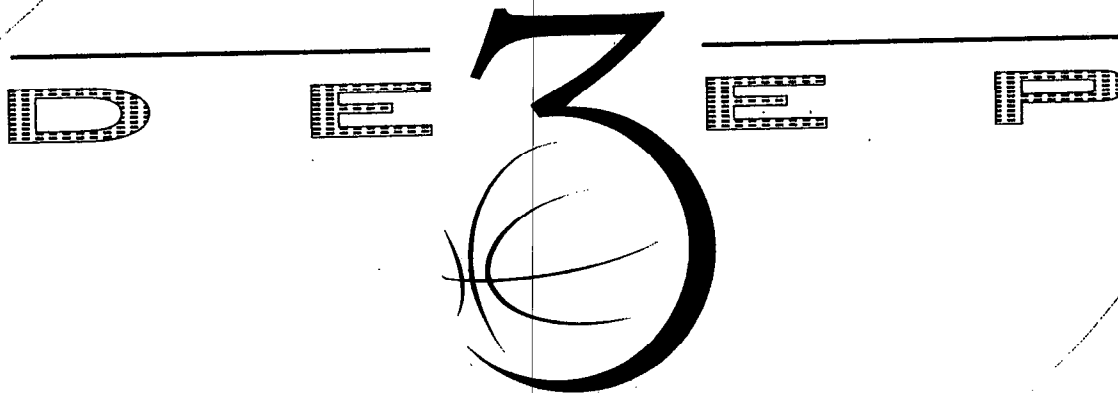
LINING: The mark is lined for the color grey.

*DO NOT
PRINT*



11-16-2000

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #70

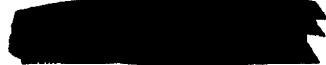


Carlisle

ABANDONED

NOV - 2001

TRADEMARK



76165865



May 30, 2002

Commission for Trademark
2900 Crystal Dr.
Arlington, VA 22202-3513



05-30-2002

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #70

Dear Sir or Madam:

I am requesting to reinstate trademark serial number 76165865. The trademark has been abandoned without our knowledge. The company has never received a letter of abandonment from the lawyer handling the trademark. The address to which the trademark notice has been given has never changed.

Since the abandonment the trademark has been registered by the Dallas Mavericks. In the past year and half years we have been active in selling Deep 3 gear along with our Internet



Sincerely,

James P Hajdukovich

President of Operations
(907) 455-7959

ASST. COMR. FOR
TRADEMARKS
2002 JUN -7 P 3:46
U.S. PATENT
AND
TRADEMARK OFFICE

06/06/2002 KGIBBONS 00000071 76165865

01 FC:375

100.00,DP

www.deep3.net

Subject: Re: Ask Mark Cuban Deep3

Date: Fri, 31 May 2002 22:39:27 -0500

From: "mark cuban" <mark.cuban@dallasnavs.com>

To: "jimmy" <jim@frontierflying.com>

References: 1

i haveno interest in investing in your company....None.

Nothing personal, but we are doing what we planned on doing and are not looking for partners or to work with anyone else.

we feel we have gotten the names through the correct procedures. But this isnot about the name. We will continue to do business regardless of the name

good luck with your company and your lawyers

thanks !

m

MFPL = Mavs Fan For Life

For the most exciting tv experience ever, check out HDNet on ch199 on directv or www.hd.net

and of course www.mavgear.com

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

From: "jimmy" <jim@frontierflying.com>

To: <mark.cuban@dallasnavs.com>

Sent: Friday, May 31, 2002 9:48 PM

Subject: Ask Mark Cuban Deep3

> Mark,

> I am a huge fan of the Mavericks and also part owner of Deep3. The
> Dallas Basketball Limited Radical Mavericks Management, LLC has an
> application for a trademark on deep3. I played college basketball at
> Fresno state and University of Alaska Anchorage and coined the phrase
> with two teammates and we started the business. One is the artist, the
> other the salesman and I am the shooter behind the three. Over two
> hundred made in college. They were the guys setting the screens, I have
> tapes to prove how deep I shot the three pointer. The artist took care
> of the trademark and confusion with the office of commission has allowed
> you to apply for the deep3 trademark.
> I just wanted you to know that we are contesting abandonment and
> seeking to suspend your application. Please stop all investments
> concering deep3 as we are confident that we will have our trademark.
> This is a dream for three hoopers that will hopefully continue on. You
> seem like a hell of a guy and would like to have your input on the
> matter. Hopefully you can become part owner with investment once all
> this settled. Check us out at deep3.net.

> I guess you could tell me to kiss my ass and good luck with your lawyers
> but you love basketball and we have dedicated our life to hoops and the
> last 2 1/2 years selling deep3. So I am hoping it will count for
> something.

> Thanks for your time.

>

>

> Jim Hajdukovich

> (907)455-7959

> Director of Deep3 Operations