

ESTTA Tracking number: **ESTTA175652**

Filing date: **11/19/2007**

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

Proceeding	91160327
Party	Plaintiff Republic of Colombia and National Federation of Coffee Growers of Columbia
Correspondence Address	DARRYL ADAMS DEWEY & LEBOEUF LLP 401 CONGRESS AVENUE, SUITE 3200 AUSTIN, TX 787101 UNITED STATES dadams@dl.com
Submission	Reply in Support of Motion
Filer's Name	Darryl Adams
Filer's e-mail	dadams@dl.com, lpmco@dl.com
Signature	/Darryl Adams/
Date	11/19/2007
Attachments	91-160327 - Opposers' Reply in Support of their Motion for Sanctions - 11-19-07.pdf (9 pages)(264347 bytes)

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

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REPUBLIC OF COLOMBIA and NATIONAL	:	
FEDERATION OF COFFEE GROWERS OF	:	
COLOMBIA,	:	
	:	Opposition No.
Opposers,	:	91/160,327
v.	:	
	:	Serial No.
SPLENDID TREATS LLC,	:	76/459,180
	:	
Applicant.	:	
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**OPPOSERS' REPLY IN SUPPORT OF THEIR MOTION FOR SANCTIONS, OR,
IN THE ALTERNATIVE, MOTION TO COMPEL**

The Republic of Colombia and the National Federation of Coffee Growers of Colombia (collectively "Opposers") respectfully submit this Reply Memorandum in further support of their motion for sanctions, or in the alternative, to compel, dated October 12, 2007. Consistent with the Board's rules, this reply will address only those issues that require clarification. Opposers rest on their opening brief for the remaining arguments.

ARGUMENT

A. Applicant Has Failed to Conduct a Diligent Search for Responsive Documents

Applicant's Response to Opposers' Motion for Sanctions highlights Applicant's fundamentally misguided view of its discovery obligations. (Response to Motion for Sanctions, dated Oct. 31, 2007 ("Response").)¹ Applicant asserts that it is dismissed from its obligation to

¹ Applicant spends a substantial portion of its brief discussing the merits of this case, rather than justifying its discovery shortcomings. (Response at 1-3.) Applicant's arguments on the merits are entirely irrelevant to the sanctions motion at hand. In any event, these arguments enjoy no support by law or fact. First, Applicant admits in its Response, as it did during its deposition (Ex. 27, Rule 30(b)(6) Dep. Tr. at 119:1-21), that CAFÉ DE COLOMBIA means "Colombian coffee." (Response at 2 ("Coffee of Colombia" is "the literal translation of 'Café de

conduct diligent and good faith searches unless and until the Opposer can point to specific documents that would be located in Applicant's search. This position, of course, turns Applicant's discovery obligations on its head.

Applicant concedes that it failed to search its archives and computers² for documents responsive to Opposers' discovery requests. (Opposers' Motion for Sanctions, dated Oct. 12, 2007 ("Motion for Sanctions") at 13-14.) Applicant's only response for failing to search these likely sources of responsive document in the three years since the discovery requests were propounded is that: "Failure to search archives or computers is not significant if no relevant records exist there. Opposer has no indication there are any missing records." (Response at 9.) In other words, Applicant argues that it is not required to search for responsive documents unless and until Opposers can point to specific documents that would be in the specific locations

Colombia").) Thus, there can be no genuine dispute that the predominant feature of Applicant's proposed mark — CAFÉ DE COLOMBIA — and the Republic's certification mark — COLOMBIAN for coffee — are substantially similar in sound, appearance, and connotation. *See In re Wente Bros.*, Serial No. 75,493,919, 2003 WL 21678411, at *4 (TTAB July 1, 2003). Second, Applicant's argument regarding the Federation's abandonment of marks bearing the words CAFÉ DE COLOMBIA and COFFEE OF COLOMBIA and the Federation's disclaimer of the words CAFÉ DE COLOMBIA and COFFEE OF COLOMBIA in trademark applications misapprehends the law. The Republic opposes the Applied-For Mark based on its Certification Mark, and the Federation's abandonment of various marks and disclaimer of terms has no relevance to the Republic's mark. At no time has the Republic abandoned its mark COLOMBIAN for coffee, and, contrary to Applicant's argument, the Republic does claim exclusive rights to control the use of the mark COLOMBIA as applied to coffee-related goods and services. Still further, the Federation continues to maintain that the Applied-For Mark, insofar as it contains the phrase THE WORLD'S FINEST COFFEE, is confusingly similar to the Federation's mark THE RICHEST COFFEE IN THE WORLD. (Opposition ¶¶11-13, 19-23.)

² Applicant has failed to search these likely sources of responsive documents notwithstanding the fact that Applicant has a computer in the workspace specifically set aside for Applicant and that it stores in its archives files for all of the Iron Group business entities, of which Applicant is one. (Exhibit 27, Rule 30(b)(6) Dep. Tr. at 172:1-174:8; Exhibit 34, G. Castro Dep. Tr. at 22:22-26:10.; 28:12-31:17, 40:22-42:21.)

Exhibit numbers throughout this Reply refer to the exhibits attached to Opposers' Motion for Sanctions dated Oct. 12, 2007, unless otherwise noted.

Applicant failed to search. It is, of course, Applicant's obligation to conduct a diligent and good faith search for responsive documents, and it is not Opposers' duty to foresee whether relevant documents are stored in Applicant's archives or computers. *See* Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 408.02. Applicant has consistently and repeatedly shirked its obligation to conduct a diligent and good faith search.

Additionally, Applicant's argument that "Opposer has no indication there are any missing records" (Response at 9) is both irrelevant and inaccurate. Opposers are not required to identify missing records to prompt Applicant's duty to search for responsive documents. In any case, Applicant's and George Castro's deposition testimony is riddled with evidence of missing records. For example, Applicant testified that it generated trademark search reports prior to submitting its application for the Applied-For Mark and that it purchased a building for the specific purpose of establishing a Café de Colombia restaurant, but Applicant has not produced supporting documents on either topic. (Exhibit 27, Rule 30(b)(6) Dep. Tr. at 68:2-69:5 (search reports); *id.* at 27:14-30:6 (building in Elizabeth, New Jersey).)

Not only is there evidence of missing records, Applicant's suggestion that it can state with certainty that no responsive documents exist in the places Applicant failed to search is disingenuous. In fact, George Castro clearly testified at his deposition that *he did not know* whether there is any relevant information in one of the key places Applicant failed to search, namely, Applicant's computers. (Exhibit 34, G. Castro Dep. Tr. at 29:16-21.) Similarly, Applicant's Rule 30(b)(6) deposition testimony is littered with instances in which Maurice Castro testified that he did not look for responsive documents, or did not know or could not remember whether Applicant has responsive documents. (*See, e.g.*, Exhibit 27, Rule 30(b)(6) Dep. Tr. at 58:21-22, 63:1-12, 65:4-66:3, 74:15-76:19, 95:13-96:4, 106:12-15, 133:8-14.) Had

Applicant taken its discovery obligations seriously, Applicant likely would have known the answers to each of these questions and there would be no doubt about the existence, or lack thereof, of additional responsive documents. Instead of conducting the requisite searches, however, Applicant chose ignore its duties to search for responsive documents, ignore the TTAB discovery rules, and ignore *two* Orders of this Board compelling Applicant to search for responsive documents and provide clarifying responses to interrogatory requests. Unfortunately, this conduct is emblematic of Applicant's conduct in this proceeding.

To the extent Applicant suggests that its discovery shortcomings are immaterial or harmless, Opposers note that Applicant's counsel admitted in his letter of October 1, 2007, that his client has not yet responded fully to his requests for information responsive to Opposers' discovery requests, and, significantly, that he himself has lingering questions regarding, among other things, the ownership of the Applicant — Splendid Treats. (Exhibit 33, Letter from R. Harris to D. Adams, October 1, 2007.) Moreover, each of Applicant's interrogatory and document request responses must be questioned because the sources that Applicant has failed to search — computers and archives — are almost certain to have responsive documents.

In sum, Applicant has not fulfilled its obligation to search its records for responsive information. TBMP §408.02. In light of the Board's Orders of December 28, 2005, and June 15, 2007, and the excessive amount of time Applicant has had to respond to Opposers' discovery requests, this conduct alone warrants entry of judgment in Opposers' favor. Yet, there is more.

B. Applicant's Feigned Uncertainty Concerning the Forged Document is Belied by the Facts

As set forth in detail in Opposers' Motion for Sanctions, Applicant knowingly produced a forged document in this matter. (Motion for Sanctions at 8-9, 15-16; Ex. 26.) Applicant's response to the evidence of Applicant's forgery is two-fold. According to Applicant, the Board

should ignore this conduct because (1) Opposers did not confront Applicant with the forgery until recently, and (2) Opposers have not established who created the document or that person's fraudulent intent. Both arguments are wrong.

First, Opposers' first opportunity to confront Applicant with the forgery was the Rule 30(b)(6) deposition. Opposers unsuccessfully tried to schedule depositions of Applicant's witnesses starting in November 2004. It was not until an Order of this Board that Applicant finally made the witnesses available. Furthermore, it was not until the Rule 30(b)(6) deposition that Applicant inadvertently produced the document that confirmed Opposers' suspicion that the document was forged. At the deposition, Applicant produced for the first time the document with the TESS header bearing the date April 28, 2005 and footer bearing the contradictory date of September 5, 2002, which confirmed that the printing date of September 5, 2002 was forged. (Ex. 29; Ex. 27, Rule 30(b)(6) Dep. Tr. at 162:1-169:24.) In short, but for the Applicant's delay in making its witnesses available and its failure to timely produce all relevant documents, the matter could have been addressed much earlier.

Second, Applicant does not dispute that the date on the document was a falsification, nor could it.³ Instead, Applicant argues that the deposition testimony does not establish who created the document or that person's intent. Both points are wrong. At the Rule 30(b)(6) deposition, Maurice Castro unequivocally testified that he created the forged document. Mr. Castro testified that he personally conducted the search of the trademark database evidenced in the forged document, that he personally printed the forged document, that he personally stored and maintained the forged document, that he located the forged document in his office in response to

³ Applicant argues that the communication with the USPTO is somehow invalid. Applicant's argument is unfounded. In any event, as the e-mail in question relates to a fact within the knowledge of this tribunal (the date the USPTO changed servers), this Board can take judicial notice of the February 13, 2003 date.

the discovery requests, and that the forged document had been in his possession since 2002. Mr. Castro also testified, under oath, that he was “one thousand percent” certain that the forged document was printed in 2002. (Exhibit 27, Rule 30(b)(6) Dep. Tr. at 162:1-164:9.)

Likewise the record leaves no doubt that Applicant possessed nefarious intent in producing the false document. Indeed, there was no purpose for producing this particular document unless Applicant intended to rely on the date. A print-out from the TESS server for the same trademark application (serial number 75032080), but with an accurate date, was already produced by Applicant in response to Document Request Number 25. (Ex. 4 to the Adams Decl. in Support of the Republic of Colombia’s Motion for Summary Judgment.) In other words, the only information that is unique about the forged document is the date. Moreover, when Applicant first produced the forged document in May 2005, Applicant specifically identified this document as responsive to Document Requests Numbers 14 and 26, and it did not identify any other document as responsive to Document Request Number 14.⁴ (Exhibit 26, Response to First Request for Production of Documents and Things Nos. 14 and 26.) Still further, the forged document is the only document that supports Applicant’s dubious allegation that it was aware of the information in the TESS report prior to filing the application for the Applied-For Mark. Applicant concedes that such prior knowledge is necessary to prove its only pled defense, estoppel.⁵ (Response at 8; Answer at 4, Exhibit 3 to the Adams Decl. in Support of the Republic

⁴ Document Request No. 14 requests, “[e]ach and every document that refers or relates to, discusses or reflects any trademark searches, reports or other investigations concerning the use or registration of the Applied-For Trademark or any other mark containing the word ‘Colombian’ or ‘Colombia’ or the phrase ‘The World’s Finest Coffee’.”

⁵ Applicant has once again made a disingenuous offer of self-punishment, suggesting an Order precluding use of the forged document. (Response at 9 n.5) (Applicant’s Opposition to Opposers’ Motion for Sanctions, dated Sept. 1, 2006, at 5 (suggesting foregoing a tardy deposition notice in lieu of dismissal).) Of course, it would be a curious thing indeed if Applicant argued that it should be allowed to rely on a document that was forged.

of Colombia's Motion for Summary Judgment.) Accordingly, the record is abundantly clear that the document was forged by Maurice Castro and that it was done for the purpose of supporting Applicant's only pled defense of estoppel. Applicant's bad faith in attempting to deceive the Board with a forged document is mirrored by its bad faith in selecting the Applied-For Mark: Applicant deliberately designed its mark so that it is confusingly similar to the Republic's Certification Mark. (Motion for Summary Judgment at 18.) Simply put, Applicant is abusing the trademark system.

CONCLUSION

All of the foregoing, including the matters detailed in Opposers' initial brief, demonstrate that default judgment is appropriate in this case. Applicant's continued failure to satisfy its discovery obligations in view of *two* previous Board Orders compelling Applicant to provide clear interrogatory responses and supplemental production of documents indicates that a lesser sanction would be ineffective. Opposers have been unreasonably burdened, in terms of cost and time, by Applicant's disregard for its obligations and Applicant's disregard for the authority of this Board. Opposers have borne this burden despite the fact that it is clear that the Applied-For Mark is, as a matter of law, confusingly similar to the Republic's mark COLOMBIAN for coffee. Nevertheless, if the Board disagrees that entry of judgment in Opposers' favor is warranted, Opposers respectfully request that the Board once again issue an order compelling Applicant to comply with its discovery obligations.

Respectfully submitted,

DEWEY & LEBOEUF LLP

Dated: Austin, TX
November 19, 2007

By: s/ Darryl Adams

Darryl Adams

401 Congress Avenue, Suite 3200

Austin, Texas 78701-3788

Tel.: (512) 226-0300

Fax: (512) 226-0333

Attorneys for Opposers

Republic of Colombia

National Federation of

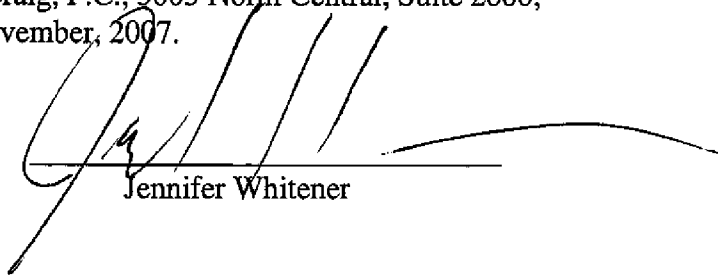
Coffee Growers of Colombia

Of counsel:

Stanton J. Lovenworth

CERTIFICATE OF SERVICE

I hereby certify that I caused a true and complete copy of OPPOSERS' REPLY IN SUPPORT OF THEIR MOTION FOR SANCTIONS, OR, IN THE ALTERNATIVE, MOTION TO COMPEL, dated November 19, 2007, to be served upon Applicant by United States Postal Service, to Ray Harris, Fennemore Craig, P.C., 3003 North Central, Suite 2600, Phoenix, Arizona 85012-2913, this 19th day of November, 2007.



Jennifer Whitener