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

Proceeding	91168617
Party	Defendant PIRELLI & C. S.P.A. PIRELLI & C. S.P.A. Via Gaetano Negri, 10 I-20123 MILANO (MI) ITX ,
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Date	05/18/2007
Attachments	Pirelli's Reply to Opposition to Motion to Compel Discovery P ZEROTEMPO.pdf (14 pages)(291400 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Beniko, Inc.,)	
)	
Opposer,)	Mark: P ZEROTEMPO
)	
v.)	Opposition No. 91168617
)	
Pirelli & C. S.p.A.,)	Serial No. 79/011,411
)	
Applicant.)	
)	

APPLICANT'S REPLY TO OPPOSER'S OPPOSITION
TO APPLICANT'S MOTION TO COMPEL DISCOVERY

Opposer sets forth two bases for its opposition to Applicant's Motion to Compel Discovery: (1) Opposer claims that Applicant failed to make a good faith effort to resolve the issues raised in its motion; and (2) Opposer claims that Applicant's motion is moot. Neither position is supported by the facts nor warrants denial of Applicant's motion to compel.

As established in Applicant Pirelli's motion at pages 1 through 4, Pirelli made numerous attempts to resolve the issues subject to its Motion to Compel. Despite Pirelli's good faith efforts, the parties were unable to reach an agreement.

Opposer's claim that Pirelli's Motion to Compel is moot, is unfounded. While Pirelli concedes that Opposer has recently (after the motion was filed, and indeed, one day before filing its Opposition to the Motion) produced some additional documents, Opposer has still failed to respond to Pirelli's outstanding interrogatories and written

document requests as well as provide numerous documents requested by Pirelli that are clearly relevant to the matters in this opposition. In addition, although Opposer has finally provided a date for its noticed depositions, that date is outside the discovery period, and thus, unacceptable.

As briefly outlined below, Pirelli maintains its Motion to Compel and respectfully requests that the Board grant its Motion and compel Opposer to properly and completely respond to Pirelli's outstanding discovery request.

I. Pirelli's Good Faith Effort to Resolve the Discovery Issues

As explained in its Motion, Pirelli sent several letters to Opposer explaining in detail the deficiencies in Opposer's discovery responses and specifically requesting certain documents and responses, and attempting to resolve the scheduling of Opposer's depositions. Pirelli's letters requested some type of response by dates certain in mid-April so that the parties could complete discovery prior to the discovery deadline. Opposer did not even give Pirelli the courtesy of a response, much less agree to provide the missing responses, documents or dates. Instead, Opposer merely disregarded and/or ignored Pirelli's letters and requests to communicate in an effort to resolve the discovery disputes. To date, Opposer has still failed to provide any responses to the Interrogatories that it previously refused to answer or only partially answered, has failed to produce many relevant, requested documents, and has refused to provide dates within the discovery period for its depositions.

Opposer does not deny that it failed to respond to the discovery requests that are the subject of Pirelli's motion. Interestingly, Opposer did not respond to Pirelli's detailed illustration of Opposer's failure to properly respond to Pirelli's discovery requests. Nor

does Opposer deny that it failed to respond to Pirelli's letters setting forth Opposer's deficiencies and requesting responses. Instead Opposer attempts to suggest that the parties agreed to extend the discovery period "in order to resolve the outstanding discovery issues" thereby implying that the parties had agreed to attempt further resolution of the matters raised in Pirelli's motion. (Opposer's Opposition, page 2.) Opposer's suggestion is untrue. The issue of Opposer's failure to provide proper responses to Pirelli's discovery requests did not have anything to do with Opposer's request, or Pirelli's agreement, to consent to the extension. As clearly shown in Opposer's email suggesting the extension, the only basis for the request and consent to extend the discovery period was the scheduling of the depositions. (Opp. Ex. A).

Despite Pirelli's repeated requests for complete responses to its Interrogatories and Documents Requests, and for dates certain within the discovery period for the noticed depositions, Opposer has failed to provide them. Opposer would like to benefit from its silence and refusal to answer Pirelli's letters and requests by claiming that Pirelli has failed to establish that it made a good faith attempt to resolve these issues. But Opposer's refusal to respond and address these issues does not make Pirelli's attempts somehow deficient or not in good faith; instead, they demonstrate that Opposer forced Pirelli to file this motion after its repeated requests that Opposer address these issues were met with silence.

II. Pirelli's Motion is Not Moot

Opposer claims that Pirelli's motion had been mooted by its supplemental document production and its offer to provide witnesses for the noticed depositions on June 21, 2007. But Opposer wholly fails to mention the Interrogatories it has refused to

answer and the fact that its proposed deposition date is outside the discovery period, and has been rejected by Pirelli as such. In addition, Opposer's supplemental document production does not contain many of the documents that are the subject of Pirelli's motion.

A. Interrogatories

Opposer has not supplemented its responses to Pirelli's interrogatories, nor does Opposer deny (or even address) its failure to answer, or provide complete answers to many of the interrogatories. As explained in detail in Pirelli's Motion, Opposer wholly failed to respond to Interrogatories 1, 8, 14 and 15, instead merely lodging improper objections. As to Interrogatories 2, 3, 4, 5, 6, 7, 9, 10, 11 and 12, Opposer provided only incomplete responses. (See Pirelli's detailed explanation as to the relevancy of these interrogatories and Opposer's incomplete responses in its Motion on pages 10 through 16.) Thus, Pirelli moved for an order compelling proper, complete substantive responses to its interrogatories. Given that Opposer still has failed to supplement its interrogatory responses, Pirelli's Motion as to the interrogatories is not moot and Pirelli requests that the Motion be granted and Opposer ordered to immediately provide complete and proper responses to the interrogatories set forth above and in its Motion.

B. Document Requests

After Pirelli filed its Motion to Compel, Opposer finally produced some of the documents subject to the Motion, but has still failed to respond to many of Pirelli's document requests. Although Opposer agreed to produce documents responsive to Document Request Nos. 3 (related to Opposer's selection and adoption of each asserted mark), 5 (evidencing Opposer's first use of each of Opposer's Marks for each

product), 7 (samples of packing for all products), 10 (related to any instances of confusion), 11 (related to inquiries regarding affiliation or relation of Opposer or Opposer's products and Pirelli), 12 (related to inquiries regarding affiliation or relation between Pirelli or Pirelli's products and Opposer), 13 (related to any instance where Opposer received misdirected correspondence intended for Pirelli), 14 (related to any investigation or study relating to Opposer's Marks and other ZERO-formative marks, including Pirelli's), 15 (related to reports or studies concerning perception awareness or understanding of Opposer's Marks), 16 (related to trademark searches for Opposer's Marks), 17 (related to objections Opposer has made to any third parties' use and/or registration of marks because of Opposer's asserted marks), 19 (agreements between Opposer and others regarding use and/or registration of any ZERO-formative mark) and 25 (supporting Opposer's allegation of likelihood of confusion), Opposer has failed to provide any responsive documents, and has also refused to state for which of these requests (if any) there are no responsive documents. Pirelli's Motion as to these document requests is not moot. Pirelli requests that Opposer be compelled to produce its responsive documents within ten days from the mailing date of the Board's ruling on the Motion or provide additional responses indicating for which document requests it has no responsive documents.

In addition, in response to Request for Production of Documents Nos. 8, 21, 22 and 24, Opposer failed to provide any response, only lodging improper objections. Each of these requests are proper and seek the production of relevant documents. Opposer has failed to properly respond to these requests and has failed to produce any documents responsive to these requests. As such, Pirelli's Motion as to these requests

is not moot, and Pirelli requests that Opposer be compelled to provide proper written responses and produce responsive documents or state that none exist.

As explained in Pirelli's Motion, Opposer also provided improper, incomplete responses to Request No. 4 (documents sufficient to identify each product with which Opposer's Marks have been used), Request No. 9 (documents relating to Opposer's development, marketing, promotion, advertising, and offering of products under Opposer's Marks, including, but not limited to, marketing plans, advertising plans, strategic business plans, and market research) and Request Nos. 20 and 23 (seeking documents evidencing sales and advertising expenditures for Opposer's Products sold under Opposer's asserted marks). Although Opposer recently provided some documents that appear to reflect some advertising expenditures and some documents that appear to reflect Opposer's purchase and resale of some goods, the documents fail to identify the marks under which the products were sold, and are for only a very limited time window. For example, the "Customer Net Shipment Report" produced by Opposer does not identify the goods, the marks, or the location (be it within or outside the US) of the alleged sales or the dates on which the shipments allegedly occurred. In sum, the few documents that Opposer did recently produce do not evidence all sales and advertising expenditures for goods sold in association with each of Opposer's asserted marks as requested in Pirelli's document requests. In addition, Opposer has still not provided documents sufficient to identify each product with which Opposer's Marks have been used in response to Document Request No. 4, nor documents responsive to Request No. 9. Pirelli's Motion to Compel has not been mooted as to these document requests.

In response to Request No. 6 (representative samples of all advertising and promotional materials in each media utilized evidencing Opposer's use of each of Opposer's Marks), Opposer has only provided advertisements which purport to show use of only the mark POINT ZERO in association with men's t-shirts and/or jackets, and boys t-shirts. And in those advertisements it is unclear, and in fact appears, that the mark POINT ZERO is not used on the goods themselves, but instead each good is identified in the ads as being "by Point Zero." In addition, most of the advertisements do not establish a date or indicate an area of distribution, and some of the advertisements appear to be for circulation outside of the United States. To the extent that Opposer alleges that it uses any of the other marks it has asserted in these oppositions and/or uses the POINT ZERO mark for any goods other than men's t-shirts and jackets, and boys t-shirts, Pirelli requests that Opposer be compelled to immediately produce representative samples of advertising evidencing the same or that Opposer confirm that no advertisements for the asserted marks other than POINT ZERO have occurred and that the mark POINT ZERO has only been used and advertised for men's T-shirts and/or jackets and boy's T-shirts. If Opposer refuses to produce evidence of its use of each of the marks, in association with each of the goods it has asserted in this opposition, Pirelli moves that the Board enter an Order precluding use of such evidence in this opposition.

Pirelli requests that the Board issue an order compelling Opposer to produce all documents responsive to Pirelli's document requests listed above and in its Motion, and to specifically identify each request, if any, for which Opposer does not have any responsive documents.

C. Depositions

In its opposition, Opposer claims that the issue of Opposer's deposition dates has been resolved by Opposer's May 8 letter to Pirelli offering to make its witnesses available for deposition on June 21, 2007. Opposer's offer does not resolve the issue and Opposer knew the issue was not resolved prior to filing its opposition, yet misrepresented that it was despite its knowledge to the contrary. Opposer fails to explain to the Board that on May 9, 2007, Opposer received Pirelli's letter of that date rejecting Opposer's offered date of June 21, 2007 because it is outside of the discovery period. (Exhibit A hereto). Opposer's claim that its witnesses have been unavailable for deposition due to "unanticipated travel plans" from the noticed date of April 12 until June 21 is simply not credible and is not supported by a declaration. This issue is clearly not resolved as no date within the discovery period has been offered or agreed upon. Thus, Pirelli requests that Opposer be compelled to immediately provide dates certain prior to the close of discovery for the noticed depositions.

III. Conclusion

The undersigned attorney for Pirelli made a good faith effort to resolve the discovery issues raised in this Motion with counsel for Opposer, but the parties have been unable to reach agreement with regard to these issues. Opposer's recent document production has not mooted Pirelli's Motion. For the reasons set forth in its Motion and above, Applicant Pirelli respectfully requests that the Board issue an order compelling Opposer to produce documents, provide complete and substantive responses to Applicant's Document Requests and Interrogatories, and to produce witnesses within the discovery period for deposition pursuant to Applicant's Notices.

Dated: May 18, 2007

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of APPLICANT'S REPLY TO OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO COMPEL DISCOVERY was served on May 18, 2007 by first class postage paid mail to Attorneys for Opposer at the address listed below:

Dax Alvarez
Blakely Sokoloff Taylor & Zafman LLP
12400 Wilshire Boulevard, Seventh Floor
Los Angeles, CA 90025-1030

/Virginia L. Carron/

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Exhibit A



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May 9, 2007

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Via Facsimile

Re: Beniko v. Pirelli
Opposition Nos. 91168614 and 91168617

Dear Bill:

We write in response to your e-mail correspondence received late yesterday evening regarding discovery in the above-referenced oppositions.

First, as to your offer to provide your client for the Rule 30(b)(6) and personal depositions on June 21st, we must respectfully decline. As you are well aware, the Rule 30(b)(6) Notice of Deposition was served on March 28, 2007, and the deposition notice of Mr. Albert Khodari was served on April 3, 2007. Those depositions were respectively noticed for April 12 and 13, 2007. On the eve of those depositions you informed us that Beniko would not make witnesses available as noticed. Instead however, you promised to make witnesses available for deposition "in mid to late May". Despite our repeated requests for a date certain for both the Rule 30(b)(6) and personal deposition of Mr. Khodari, it was not until yesterday May 8th, that you informed us that "in light of some unanticipated travel plans, the earliest date [upon which your client] is available to be deposed is June 21st."

Based upon your promise to provide the witnesses for deposition in mid to late May, Pirelli agreed to an extension of the discovery period until May 29. The date you now offer is outside that extended discovery period and, as such, is unacceptable. We also find it hard to believe that your client was and is unavailable for deposition due to "unanticipated travel plans" from April 12th through June 21st. We again request that you provide a date prior to the close of discovery for both the Rule 30(b)(6) deposition and the deposition of Mr. Khodari.

As to the deposition of Pirelli, we informed you on April 20, 2007, that Pirelli would make a witness available for deposition in Milan on May 24, 2007. This date was provided specifically to be within the current extended discovery period that closes on

May 29, 2007. Last night in your May 8 e-mail, you informed us that you have a “pre-existing commitment” that precludes you from traveling to Milan on May 24. Instead you suggest an alternative date of June 22, one month later. Pirelli will not agree to make a witness available for deposition outside of the current discovery period. Pirelli reconfirms its willingness to present a witness in Milan for deposition on May 24. Should Beniko fail to exercise its option to take the deposition on that date, Pirelli will insist that any deposition of Pirelli, as a non-US resident party, be conducted pursuant to the TTAB rules and be taken upon written questions.

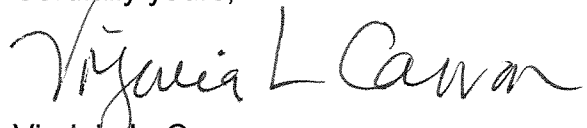
Finally, we acknowledge Beniko’s supplemental document production, Bates labeled 39 through 84. We note that all but six of these additional forty-five pages are nothing more than additional advertisements featuring men’s and boys’ shirts and jackets advertised in association with the mark POINT ZERO. We note, however, that in each of the advertisements it is unclear, and in fact appears, that the mark POINT ZERO is not used on the goods themselves, but instead each good is identified in the ad as being “by POINT ZERO”. In addition, most of the advertisements do not establish a date or indicate an area of distribution, and some of the advertisements appear to be for circulation outside of the United States.

As for the remaining six pages, three of those pages, Bates Nos. 39, 42 and 43, are photographs of watches which appear to bear the POINT ZERO mark. However, there is no evidence to establish use or sales of these watches in the United States. Two pages of the supplemental production, Bates Nos. 40 and 41, are photographs of a backpack and briefcase bag bearing the mark POINT ZERO. However, no evidence was provided to show that these products entered the United States or were offered for sale, advertised or sold in the US, much less to establish a date of alleged first use in the US or the scope and degree of any alleged use. The final page of the document production, Bates No. 84, appears to be a photograph of a shopping bag bearing the mark POINT ZERO and featuring a photograph of a woman. However, there is no evidence that the mark POINT ZERO is being used in association with any goods, nor is there any evidence that the bag in the photograph has been used in the United States, or any indication of the alleged date of use of such bag.

In short, the supplemental document production does very little to cure Beniko’s failure to provide documents and evidence responsive to Pirelli’s Document Requests and Interrogatories. For example, Beniko has still wholly failed, despite its agreement to do so, to provide documents related to: (1) sales in the US of products bearing the marks asserted in these oppositions, (2) the type or class of purchaser of Beniko’s marks, (3) the channels of trade of Beniko’s goods bearing the asserted marks, (4) the dates of first use for each of Beniko’s asserted marks for each alleged good, (5) the scope of distribution of Beniko’s goods bearing the asserted marks, or (6) the advertisement expenditures in the United States. Nor has Beniko provided documents previously withheld on the basis of confidentiality despite the Stipulated Protective Order and repeated requests from Pirelli to do so. Pirelli once again requests that

Beniko produce all of these and the other documents requested and previously identified by Pirelli, and now subject to Pirelli's Motion to Compel discovery from Beniko.

Cordially yours,

A handwritten signature in black ink that reads "Virginia L. Carron". The signature is written in a cursive style with a large, prominent "V" at the beginning.

Virginia L. Carron

cc: Dax Alvarez, Esq.
Laurence R. Hefter, Esq.