

TTAB

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

BENIKO, INC.,)	
)	
Opposer)	Opposition No. 91168617
)	
v.)	Serial No. 79/011,411
)	
PIRELLI & C.S p.A)	
)	
Applicant)	

**BENIKO'S MOTION TO STAY PROCEEDINGS PENDING CLARIFICATION OF
THE BOARD'S NOVEMBER 5, 2007 ORDER**

Mail Stop TTAB
Trademark Trial and Appeal Board
United States Trademark Office
P.O. Box 1451
Alexandria, Virginia 22313-1451

Dear Sir:

Pursuant to Trademark Rule 2.117(c), Opposer, Beniko, Inc., ("Opposer") in the above-referenced proceeding, respectfully moves for a stay of proceedings until the Board has clarified the language as to the scope of Opposer's production of materials in the Board's Order dated November 5, 2007 ("Order"). In particular, it is unclear as to whether the language in the Order compels production of each and every sales related document from the year 2000 forward or whether representative samples and summaries, accurately reflecting all sales from the year 2000 forward, are sufficient. Accordingly, for the purposes of this motion, Opposer respectfully requests that the Board clarify its order and stay proceedings pending the



01-07-2008

clarification of the Board's Order with respect to the scope of Opposer's document production.

Under Trademark Rule 2.117(c), proceedings in an action may be suspended upon a motion for good cause. See also TBMP §510 ("from the Board's inherent power to schedule disposition of the cases on its docket is the power to stay proceedings"). Additionally, each party has a duty not only to make a good faith effort to satisfy the discovery needs of its adversary, but also to make a good faith effort to seek only such discovery as is proper and relevant. See TBMP §402.01 and 408.01. Opposer respectfully submits that clarification of the Board's Order as to the scope of Opposer's responsive materials, particularly as the production of said materials affects the upcoming deposition of Opposer, constitutes good cause to suspend proceedings in this action.

The Board's Order, in pertinent part, reads as follows, "[i]f, in fact, it would be unduly burdensome for opposer to produce all responsive materials since 1984 (opposer's alleged date of first use in its Registration No. 1439274, an incontestable registration), opposer may produce such materials from the year 2000 forward." (Order Page 11). Opposer respectfully submits that it is unclear whether the above language directs Opposer to produce each and every responsive sales document, including all purchase orders and invoices, from the year 2000 forward, or whether Opposer may produce representative samples of order confirmation forms and yearly sales summaries that accurately reflect yearly sales from the year 2000 forward.

Opposer has repeatedly sought to clarify this issue with Applicant's counsel. (see attached email correspondence). Unfortunately, Applicant's counsel has refused to meaningfully discuss the issue and has merely responded that it is Applicant's position that

Opposer “produce all supplemental documents as ordered by the Board.” (see Applicant’s correspondence to Opposer dated December 14, 2007). Opposer notes that producing each and every sales related document from the year 2000 forward will be unduly burdensome and likely necessitate the production of an additional 200 boxes of materials. For example, the sales summary for the year 2001 alone is seven inches thick, with printing on both front and back. Opposer respectfully suggests that in lieu of producing an extremely voluminous and unwieldy amount of material, Opposer produce all necessary responsive materials by way of representative samples and summaries which accurately reflect Opposer’s sales from the year 2000 forward. Therefore, suspension of the proceedings and clarification as to the scope of responsive documents as laid out in the Board’s Order may prevent an unnecessary, unwieldy and costly undertaking.

Moreover, in light of Applicant’s upcoming deposition of Opposer, if proceedings in this action are not stayed pending the clarification of the scope of Opposer’s responsive materials, Applicant will likely conduct its deposition without all the sales-related materials. If the Board decides to expand the scope of production to include ALL materials, such a scenario would likely entail Applicant requiring a second deposition of Opposer at a later date. As discussed above, Opposer respectfully contends that the Board’s Order does not require Opposer to produce voluminous materials consisting of approximately 200 boxes of documents. If on the other hand, the Board does Order Opposer to produce such documents, Applicant’s counsel would need to review them prior to the upcoming deposition. Opposer therefore respectfully requests proceedings in the action be stayed in order for (1) the Board to rule on the scope of production, (2) Opposer to produce the necessary responsive documents

as clarified by the Board and (3) Applicant to have ample time to receive and review Opposer's appropriate responsive materials.

Accordingly, Opposer respectfully requests clarification of the language in the Board's Order, so that Opposer may then produce additional responsive documents to Applicant, if necessary. Further, Opposer respectfully requests that proceedings in this action be stayed, pending clarification as to the scope of responsive materials, in order for Opposer to produce any necessary responsive documents in light of Applicant's upcoming deposition of Opposer.

CONCLUSION

For the above stated reasons, Opposer respectfully requests that the Board stay proceedings in this action pending the Board's clarification of language in its Order as it relates to the scope of Opposer's responsive materials from the year 2000 forward, in particular whether Opposer must produce all sales related documents from the year 2000 forward or whether representative samples and summaries accurately reflecting all sales from the year 2000 forward is sufficient.

Respectfully submitted,

Dated: 12/31/07

By: 

Willmore F. Holbrow

Daniel J. Russell

BLAKELY SOKOLOFF TAYLOR & ZAFMAN

12400 Wilshire Boulevard

Los Angeles, CA 90025

(310) 207-3800

Attorneys for Beniko

CERTIFICATE OF SERVICE


I hereby certify that a true and correct copy of the foregoing document entitled:

**BENIKO'S MOTION TO STAY PROCEEDINGS PENDING CLARIFICATION OF
THE BOARD'S NOVEMBER 5, 2007 ORDER**

was served on counsel for Applicant by first class mail, postage prepaid, in a sealed
enveloped addressed as follows:

Virginia L. Carron
Finnegan Henderson Farabow Garrett & Dunner LLP
3500 SunTrust Plaza
303 Peachtree Street, NE
Atlanta, GA 30308-3263

Executed on December 31, 2007, at Los Angeles, California.



Marie Monsod

Subject: Re: Discovery

Date: Wednesday, December 5, 2007 11:38 AM

From: Bill Holbrow <Bill_Holbrow@bstz.com>

To: "Carron, Virginia" <Virginia.Carron@finnegan.com>

Conversation: Discovery

Hi Virginia,

We will be serving supplemental responses and additional documents today as well. We have decided to go ahead and copy the documents to save you the trouble of the copy service. In any event, we are producing a summary showing sales made in 2001, representative samples of Order confirmation forms showing sales from 2000-2007 and additional documentation.

It is unclear from the Board's order whether we are to produce each and every sales document going back to the 2000-01 or representative samples. Please let us know how you interpret the Order. If you believe the Board's order requires Beniko to produce more documents we will need to discuss it and either work something out or go back to the Board for clarification. Producing all sales related documents going back 6 years would likely fill 1000+ boxes. The summary for 2001 alone is approximately 7 inches thick, front and back. Once you review the documents, I trust you will find them satisfactory.

Regards,

Bill

On 12/4/07 7:30 AM, "Carron, Virginia" <Virginia.Carron@finnegan.com> wrote:

> Bill,

>

> Per the Board's Order, supplemental responses are due on December 5, 2007. In
> keeping with the Order, we will serve Pirelli's supplemental responses,
> including additional documents, on you on December 5.

>

> We expect that you will serve Beniko's responses and supplemental responses on
> us on December 5, as ordered by the Board. As to Beniko's Board-ordered
> document production, we will have a local copy service come to your office on
> December 5 to collect the documents and make a copy for us, at our expense.
> If you prefer that we use a certain copy service, please let us know by return
> email. Please be prepared to provide the copy service with appropriate
> instructions as to the numbering and designations, if any, of the documents.

>

> Virginia

>

> Virginia L. Carron | Finnegan, Henderson, Farabow, Garrett & Dunner, LLP | 3500
> SunTrust Plaza, 303 Peachtree Street NE Atlanta, Georgia 30308-3263
> | 404.653.6452 | fax 404.653.6444 | virginia.carron@finnegan.com

>

>

> -----Original Message-----

> From: Bill Holbrow [mailto:Bill_Holbrow@bstz.com]

> Sent: Monday, December 03, 2007 8:19 PM

> To: Carron, Virginia

> Subject: Discovery

>

> Virginia,

>
> We will be producing supplemental responses to the discovery requests and
> additional documents this week. In light of the Board's order, it appears
> that some of the responsive documents are quite voluminous. Accordingly,
> we will make some documents available for inspection at a mutually
> convenient date and time.
>
> Please let me know if you have any questions.
>
> Bill Holbrow
>
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>
> This e-mail message is intended only for individual(s) to whom it is addressed
> and may contain information that is privileged, confidential, proprietary, or
> otherwise exempt from disclosure under applicable law. If you believe you have
> received this message in error, please advise the sender by return e-mail and
> delete it from your mailbox. Thank you.

Subject: Discovery

Date: Wednesday, December 12, 2007 5:27 PM

From: Bill Holbrow <Bill_Holbrow@bstz.com>

To: "Carron, Virginia" <Virginia.Carron@finnegan.com>

Conversation: Discovery

Hi Virginia,

I haven't heard back from you in response to my previous email regarding the scope of the Board's Order. We also haven't received Pirelli's supplemental responses and additional documents.

Just to let you know, it appears that additional records fill approximately 200 boxes, including without limitation POs and invoices. We will continue to forward any additional documents, as appropriate.

We received your deposition notice and unfortunately our client is unavailable on the dates noticed. Please let me know what other dates work for you.

Regards,

Bill



FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

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VIRGINIA L. CARRON
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December 14, 2007

Bill Holbrow, Esq.
Blakely Sokoloff Taylor & Zafman
12400 Wilshire Boulevard
Seventh Floor
Los Angeles, California 90025-1030

Via Facsimile

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

Dear Bill:

We acknowledge receipt of your December 12, 2007, email correspondence regarding supplemental document production and the deposition of Beniko and Mr. Khodari

In that correspondence for the first time you indicate that your clients are not available on the dates noticed for the depositions, January 9 and 10. As you are well aware, prior to serving the Notices of Deposition, we requested twice that you provide us with two consecutive dates for the depositions of your clients some time during the month of January. Having not heard from you in response to our requests, we re-noticed the depositions for January 9 and 10. Along with our Notices, we provided a letter (copy attached hereto for your reference) requesting that if the witnesses were not available as noticed, that you immediately provide alternative consecutive dates for the depositions in January.

You have now informed us that your clients are not available on January 9 and 10 and request that we suggest alternative dates. We will not again attempt to suggest dates as it is you, not us, who knows the schedules of your witnesses. We have requested, at least three times that you provide us with consecutive dates during the month of January upon which the witnesses are available. If you fail to provide those dates and we fail to reach an agreement regarding alternative dates prior to the noticed dates of January 9 and 10, we will proceed with the depositions as noticed, unless you obtain a protective order from the Board. Again, we request, for the fourth time, that you immediately provide us with two consecutive dates during the month of January upon which your clients are available for deposition.

Bill Holbrow, Esq.
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GARRETT &
DUNNER LLP

As to your statement regarding Pirelli's supplemental document production, Pirelli's supplemental document production was mailed to you on December 5, 2007, in compliance with the Board's Order. As a courtesy we enclose herewith the supplemental document production. It is Pirelli's belief that this completes its supplemental document production. However, should additional information or documents come to our attention we will immediately provide them to you in keeping with the Federal Rules and the Board's Order.

Finally, as to your statement that you have additional documents responsive to Pirelli's discovery request, we again request that you immediately comply with the Board's Order and produce all supplemental documents as ordered by the Board. As you are well aware, those documents were required to be produced on December 5, well over a week ago. Unless Beniko immediately complies with the Court's Order and produces its supplemental documents, Pirelli will be forced to seek court intervention.

We await your prompt response regarding the deposition dates and Beniko's complete supplemental production.

Cordially yours,


Virginia L. Carron

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