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

Proceeding	91170091
Party	Plaintiff ALPINA TOVARNA OBUTVE, D.D. ZIRI
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

ALPINA, TOVARNA OBUTVE, D.D., ZIRI,

Opposer,

vs.

TSA CORPORATE SERVICES, INC.

Applicant.

Opposition No. 91170091

**OPPOSER’S BRIEF IN REPLY TO
APPLICANT’S BRIEF IN OPPOSITION TO
OPPOSER’S MOTION TO COMPEL AND TO TEST THE
SUFFICIENCY OF APPLICANT’S ANSWERS TO REQUESTS FOR ADMISSION,
TO SUSPEND THE PROCEEDINGS AND TO RESET THE TRIAL DATES**

I. Introduction

On October 15, 2008, Opposer filed a discovery motion, entitled “Opposer’s Motion to Compel and to Test the Sufficiency of Applicant’s Answers to Requests for Admission, to Suspend the Proceedings and to Reset the Trial Dates” (“Opposer’s Motion to Compel”).

On November 4, 2008, Applicant filed “Applicant’s Brief in Opposition to Opposer’s Motion to Compel and to Test the Sufficiency of Applicant’s Answers to Requests for Admission, to Suspend the Proceedings and to Reset the Trial Dates” (“Applicant’s Opposition Brief”). Supplemental discovery responses and some documents were attached to Applicant’s Opposition Brief.

Opposer files this brief in reply to Applicant’s Opposition Brief.

Applicant seeks to castigate Opposer for not bringing its discovery objections to Applicant’s attention earlier, opining that the parties then “might have readily resolved almost all of Applicant’s objections”. As an initial matter, Opposer advised Applicant as early as

September, 2007 that its refusal to produce confidential information and materials was improper in view of the Board's standard protective, made applicable to this case by way of Rule change. 37 CFR 2.116(g). *See* Motion to Compel, Exhibit C. However, Opposer did not then press this discovery issue – or raise the other discovery issues – in view of potential settlement. While Opposer was prepared to defer these issues pending settlement discussions, once discussions faltered, Applicant waited nearly three weeks before advising that it was not going to consent to an extension of the trial periods. Moreover, Applicant did not provide its first confidential materials until two days before Opposer's trial period opened – and only after a meet and confer discovery conference.

II. Argument

Applicant should be required to provide a privilege log, and supplemental information and materials.

A. Applicant Should Be Compelled to Provide a Privilege Log

Applicant asserts that “[p]rior to filing the instant motion, Alpina never once requested that TSA produce a privilege log. There was no such request in Opposer's Interrogatories. There was no such request in the Instructions to Opposer's Request for Production of Documents”. *See* Applicant's Opposition Brief, p. 2. The assertions are incorrect, on all counts. First, Opposer sought a privilege log during the meet and confer conference, which was held prior to the filing of the discovery motion. Moreover, Opposer's interrogatories *expressly* requests a privilege log. *See* Opposer's First Set of Interrogatories, Instruction AA (“With respect to each document withheld on the ground of a claim of attorney privilege, identify such document in accordance with these definitions and instructions, and state in detail the basis and nature of such claim of privilege.”),

attached to Opposer's Motion to Compel as Exhibit A. Similarly, since Opposer's document requests expressly incorporated the instructions found in Opposer's interrogatories, then the same requirement was present in Opposer's document requests. *See* Opposer's First Set of Document Requests, Instruction 1 ("The Instructions and Definitions set forth in Opposer's First Set of Interrogatories, served concurrently herewith, are incorporated herein by reference and made a part hereof, as if fully stated herein."), attached to Opposer's Motion to Compel as Exhibit A.

Finally, Applicant promised to serve a privilege log. *See* Applicant's Opposition Brief, p. 2. However, to date, Opposer has not received same. Accordingly, Opposer respectfully submits that Applicant should be compelled to provide a privilege log, in sufficient detail to allow Opposer evaluate the privilege claims.

B. Applicant Should Be Compelled to Provide Supplemental Discovery Responses

_____ Applicant's Opposition Brief attached supplemental discovery responses.¹ In those few cases where the supplemental responses obviate the discovery objection, such is noted herein. However, most of the noted responses remain deficient.

Interrogatories

Interrogatory No. 2

Applicant seeks to continue to rely on Rule 33(d) of the Federal Rules of Civil Procedure in response to this interrogatory. However, the business records sought to be relied upon are vague in description to the "outsider", and overly burdensome to interpret (*e.g.*, calculate total annual sales and annual sales per product line). Accordingly, Opposer respectfully requests that

¹ To the extent that Applicant seeks to impose, by way of its supplemental discovery responses, additional objections to Opposer's written discovery, such are barred as untimely. *See e.g.*, supplemental response to Interrogatory nos. 17.

the Board compel Applicant to provide a full and written response to Interrogatory No. 2(a)² and 2(c).

Finally, the interrogatory seeks information dating back to the first use of the mark – and Applicant has claimed it will seek to rely on such use at trial – yet Applicant has only provided sales for the last few years. Applicant should either provide the requested information or be limited at trial to the date ranges it provides in discovery.

Interrogatory No. 6

This issue has been resolved.

Interrogatory Nos. 12 and 15 (and related RPD Nos. 53 and 54)

Continued reliance on Rule 33(d) of the Federal Rules of Civil Procedure in response to interrogatory nos. 12 (which sought an identification of relevant trademark registrations) and 15 (which sought an identification of the present use of a trademark comprising “alpine” or “alpina”) is not available to Applicant for several reasons. The referenced documents are trademark search reports, which (as Applicant admits) are not Applicant’s business records kept in the ordinary course of its business. Accordingly, Applicant may not rely on Fed. R. Civ. Pro. 33(d) in referring to said documents in lieu of providing a written response.

Moreover, since the documents include information which clearly are not relevant (*e.g.*, foreign trademark registrations), Applicant is “simply dumping large quantities of unrequested

² It would appear that Applicant is claiming use of the mark on goods other than expressly recited in the supplemental answer.

materials onto the discovery party along with items actually sought”. *See No Fear v. Rule, supra*. For this reason, Applicant’s response to document request no. 54 is similarly deficient. Moreover, the documents don’t provide the requested information since the interrogatories seek information concerning trademarks and registrations which Applicant believes is relevant to this proceeding; and it is highly doubtful that Applicant believes that each and every citation in the report(s) is relevant to this proceeding.

Furthermore, the documents do not provide the information requested in interrogatory no. 15, namely, dates of usage, identity of persons having knowledge of such use and whether that knowledge is based on personal knowledge or information and belief.³ If Applicant does not possess this information, it should so state.

Accordingly, Opposer respectfully submits that the Board require Applicant to provide a written response to these interrogatories.

As noted, trademark search reports do not evince use of a third party mark. Accordingly, Opposer respectfully submits that Applicant should either be compelled to produce documents responsive to document requests no. 53, or be precluded from introducing any documents at trial which would be responsive to this request.

Interrogatory Nos. 17 and 18 (and related RPD Nos. 15-17 and 18-21)

These interrogatories seek each fact which evidences Applicant’s denials to the Notice of Opposition (no. 17) and evidenced Applicant’s Affirmative Defenses (no. 18). Applicant’s supplemental responses identify *some* facts, though much of the responses are fashioned in terms

³ It is axiomatic that third party registrations do not evince use of the registered mark.

of legal conclusions. Similarly, Applicant's responses to the related document requests, nos. 15-17 and 18-21, are also deficient. Accordingly, Opposer respectfully requests that the Board compel Applicant to either identify responsive facts and produce responsive documents, or be precluded from relying or referring to same at trial of this matter.

Since Applicant refused to identify any persons who could testify as to the facts (other than Opposer's employees in response to interrogatory no. 18), Opposer respectfully submits that Applicant should not be allowed to rely at trial on any witnesses not identified therein.

Interrogatory Nos. 23 and 24 (and related Admission responses to nos. 2 and 3)

These issue have been resolved.

Identification of Persons

While Applicant has provided additional information concerning the persons identified in its interrogatories, further information is required. For example, for natural persons, Applicant should provide the person's occupation and business position held; as well as last known employer or business affiliation. *See* Opposer's First Set of Interrogatories, Instruction H(4) – H(5).

Document Production and Responses

Applicant effected its document production by mailing a stack of documents to Opposer, without identifying which documents are responsive to which document requests. Applicant's Opposition Brief seeks to remedy this by offering an after-the-fact generalized categorization into which the documents purportedly fit. *See* Applicant's Opposition Brief, Exhibit F. However, this categorization does not correspond with categories in the document requests, as required by the Rules.⁴ Accordingly, Opposer respectfully submits that the Board compel Applicant to identify the documents (by bates range) that are responsive to each document request. *Cf. No Fear v. Rule*, 54 USPQ2d 1551 (TTAB 2000).

RPD No. 5

In view of the vague product descriptions found in Applicant's documents, Opposer respectfully submits that Applicant should provide documents which list, show, explain or describe the products (to be) sold and/or services (to be) offered by Applicant under Applicant's Mark(s).

RPD No. 35

This issue has been resolved.

⁴ For illustrative purposes only, Opposer notes that the following document requests do not fall within Applicant's categorization, and leaves Opposer guessing as to which documents are responsive to the requests: nos. 1– 4, 12, 15-20, 36-37, 40, 42-48, 50, 53, 54, and 58 – 62 (while Applicant cited bates ranges in response to some of these requests, such references are not exhaustive). Other requests may fall into this area as well.

RPD No. 48

Applicant claimed it would produce marketing plans; however, it has not done so. The only document produced is a one page, undated “logo usage sheet”. It is difficult to believe that Applicant does not possess marketing plans or related documents that refer to Applicant’s Mark. Conceivably, Applicant’s response arises from an improperly narrow interpretation of the document request. In short, Opposer respectfully submits that Applicant should be compelled to produce marketing plans and all other documents responsive to this request.

RPD Nos. 51/52 and related Admission Request Nos. 48-50, 52

Applicant argues that Opposer’s discovery requests are defective because they seek Applicant’s (*i.e.*, “its”) website and that Applicant does not own the www.sportsauthority.com website. However, Opposer’s discovery is not so narrowly tailored. Some of Opposer’s discovery requests simply ask for a copy of a website linked to a domain name registered to Applicant. Other of Opposer’s discovery defines “Applicant’s Website” as a “website which links to the *sportsauthority.com* domain name, found at www.sportsauthority.com (“Applicant’s Website”).” Accordingly, Applicant’s explanation for refusing to provide the responsive documents is insufficient. Moreover, to the extent that Applicant claims to be a licensor of Applicant’s Website, it presumably exercises control over the licensee – including the ability to obtain copies of its website.

Applicant’s argument is especially infirm in view of its inexplicable refusal to admit to portions of Applicant’s Website that Opposer attached to its discovery (*see*, RFA Nos. 48-50, 52). In view of the above and the fact that Applicant’s Website is an admitted trade channel for

products bearing (or to bear) Applicant's Mark, Opposer respectfully requests that Applicant be compelled to either produce documents from the licensee or have RFA Nos. 48-50,52 be deemed admitted.

RPD Nos. 58-60

These requests seek documents showing first and continuous use of Applicant's Mark. However, despite seeking to rely on its use of the mark since 1969, *see* Motion to Compel, Exhibit B, Applicant's Answer to Interrogatory No. 1, Applicant has only produced several years worth of sales figures and assignment agreements (which do not evince use of the mark). If Applicant seeks to rely on such use, then Applicant should provide responsive documents. Conversely, if Applicant only provides documents since 2004, then its claim or rights should be similarly limited.

III. Conclusion

For all the foregoing reasons and those contained in its Motion to compel, Opposer respectfully requests that the Board GRANT Opposer's Motion to Compel and Test Sufficiency; and issue an Order to: 1) compel Applicant to immediately serve amended and/or supplemental answers to Opposer's interrogatories and document requests; 2) deem certain admission requests admitted (or require supplementation), 3) produce responsive documents by mail; and 4) reset the trial dates upon lifting the suspension.

Respectfully Submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 24th day of November, 2008, a true copy of the foregoing Opposer's Brief in Reply to Applicant's Brief in Opposition to Opposer's Motion to Compel and Motion to Test the Sufficiency of Applicant's Answers to Requests for Admission, to Suspend the Proceedings and to Reset the Trial Dates was served by first-class mail, postage prepaid, upon counsel for Applicant:

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