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Filing date: **01/18/2007**

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

Proceeding	91170202
Party	Plaintiff Russell G. Weiner Russell G. Weiner ,
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Date	01/18/2007
Attachments	Opposition to Applicant's Motion to Compel 070118.pdf (9 pages)(428117 bytes) Appel Dec re Opposition to Applicant's Motion to Compel 070118.pdf (12 pages)(607200 bytes)

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7 **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
8 **BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**
9

10 RUSSELL G. WEINER, an individual

11 Opposer,

12 v.

13 JMBP, INC., a California corporation

14 Applicant.
15

**OPPOSER'S OPPOSITION TO
16 APPLICANT'S MOTIONS TO COMPEL
17 PRODUCTION OF DOCUMENTS AND
18 SUPPLEMENTAL RESPONSES TO
19 INTERROGATORIES**

Opposition No. 91170202

Application Serial No. 78976392

Published in the Official Gazette
on December 6, 2005

18 Applicant JMBP, Inc. ("Applicant") maintains that the interrogatory responses and production
19 of documents of Opposer Russell G. Weiner ("Opposer") are insufficient. Applicant's position has
20 no merit. Opposer gave detailed answers to all of Applicant's interrogatories that sought relevant,
21 non-privileged information. Opposer provided documents in response to all of Applicant's legitimate
22 document requests.

23 Applicant's motions to compel are ironic, given that Applicant's own responses to Opposer's
24 interrogatories consisted of nothing more than boilerplate objections.¹ Furthermore, Applicant has
25 produced no documents.

26
27 ¹ In response to *all* twelve of Opposer's interrogatories, Applicant stated simply: "Objection. This request is
28 overbroad, unduly burdensome, oppressive, and seeks information outside the scope of discovery in an
Opposition Proceeding."

1 Applicant's motion to compel production of documents is particularly unwarranted.
2 Applicant states that "Opposer has not turned over or made available to Applicant a single document
3 to support the allegations made in the Notice of Opposition." (Mot., 1:25-27). This statement is false,
4 and Applicant knows it is false. Opposer has in fact produced over 200 pages of documents
5 supporting its position.

6 It appears that Applicant has brought these motions to compel simply to burden Opposer in
7 retaliation for Opposer's own well-founded motion to compel, which was filed just days before
8 Applicant's motion.

9 OPPOSITION

10 Applicant's motion to compel production of documents is based on a false premise.
11 Applicant falsely tells the Board that Opposer has not produced any documents in response to
12 Applicant's document requests. On the contrary, Opposer has produced 227 pages of documents.

13 Opposer served timely responses to Applicant's document requests. In response to each of
14 Applicant's unobjectionable requests—as well as several of Applicant's objectionable requests—
15 Opposer stated: "Opposer will produce non-privileged documents...at a mutually agreeable time and
16 place." (See Opposer's Responses, attached to Applicant's Motion as Ex. 3). After the parties had
17 two telephone conferences concerning discovery, Opposer served supplemental responses to
18 Applicant's documents requests on December 8, 2006. Again, Opposer stated that he would produce
19 non-privileged documents at a mutually agreeable time and place. (See Opposer's Supp. Responses,
20 attached to Applicant's Motion as Ex. 5)

21 On December 19, 2006, Applicant's counsel sent Opposer's counsel an email inquiring when
22 Opposer would produce documents. *Opposer's counsel promptly replied that Opposer would send*
23 *Applicant documents by the end of the following week.* (See Appel Decl. ¶4 and Ex. A attached
24 thereto.) Applicant did not object to this timing. (See Appel. ¶5)

25 As promised, Opposer sent 227 pages of documents to Applicant on Friday, December 29.
26 That day, Applicant filed the instant motion to compel. While Applicant may not have received
27

1 Opposer's documents at the time it filed its motion, it knew that Opposer would be serving them that
2 day.

3 Applicant's claim that Opposer had not produced any documents (as of December 29) is
4 misleading. Applicant's claim that "Opposer...has not committed to producing any documents"
5 (Mot., 2:2-3) is knowingly false.

6 As discussed below, Opposer's responses to Applicant's interrogatories were more than
7 sufficient.

8 **1. Opposer's Response to Interrogatory No. 1**

9 Applicant's first interrogatory asks for the basis of Opposer's contention that there is likelihood
10 of confusion between Applicant's proposed mark and Opposer's marks. In response, Opposer noted
11 several factual bases, *e.g.*, (1) Applicant's proposed mark is identical or substantially similar to
12 Opposer's marks; (2) the goods listed in Applicant's application are substantially similar to the goods
13 and services covered by Opposer's marks, applications, and registrations; (3) Applicant is likely to
14 use trade channels in connection with the goods listed in its application that are similar or identical
15 the trade channels used by Opposer; (4) Opposer's marks are famous; and (5) Opposer uses
16 ROCKSTAR and related marks on a wide variety of goods and services. These points track several
17 of the *Du Pont* factors,² which the Board uses to determine the present or absence of likelihood of
18 confusion.

19 Applicant contends that these points are merely "conclusions." This contention is wrong. It
20 is well-established that each of the individual *Du Pont* factors presents a question of fact. *See In re*
21 *Majestic Distilling Co.*, 315 F.3d 1311, 1314 (Fed. Cir. 2003); *In re Coors Brewing Co.*, 343 F.3d
22 1340, 1343 (Fed. Cir. 2003). Other jurisdictions are in accord. *See Bristol-Myers Squibb Co. v.*
23 *McNeil-P.P.C., Inc.*, 973 F.2d 1033, 1043 (2d Cir. 1992) ("[A] district court's determination of the
24 individual Polaroid factors are subject to review as findings of fact..."); *First Franklin Fin. Corp. v.*
25

26 _____
27 ² *See In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973).

1 *Franklin First Financial, LTD*, 356 F. Supp. 2d 1048, 1050-1051 (N.D. Cal. 2005) (“Most of these
2 so-called *Sleekcraft* factors are questions of fact.”)

3 Applicant faults Opposer for not providing further details, such as why its marks are famous,
4 or the identity of Opposer’s consumers. If Applicant wishes to know this information, it must
5 propound interrogatories to that effect. Opposer’s answer is perfectly responsive to the interrogatory
6 at hand.

7 **2. Opposer’s Response to Interrogatory No. 2**

8 Applicant’s second interrogatory seeks the dates and locations of “all sales of each good or
9 service” identified in Opposer’s Notice of Opposition. This request is the epitome of overbroad and
10 unduly burdensome. Opposer and his licensees have made *hundreds of millions* of sales over the past six
11 years. Applicant’s contention that it needs to know the date and location of every single one of them is
12 preposterous.

13 Opposer stated in its supplemental responses to interrogatories, *inter alia*, that his licensees have
14 sold energy drinks under the subject marks since at least as early as January 2001, “in all fifty states at
15 approximately 50,000 – 100,000 locations in the United States, including grocery stores, convenience
16 stores, liquor stores, warehouse retailers, restaurants, bars, nightclubs, gas stations, and other retail
17 establishments, and several hundred million cans of these products have been sold.” Yet Applicant
18 claims that Opposer has not provided information sufficient to determine Opposer’s “channels of
19 trade” and the strength of his marks. These claims have no merit.

20 The cases that Applicant cites do not support its position and, in fact, illustrate the sufficiency of
21 Opposer’s answer. In *Georgia-Pacific Corporation v. Great Plains Bag Co.*, 190 USPQ 193 (TTAB
22 1976), for example, the Board required petitioner to identify every state to which it shipped its goods.
23 Here, Opposer has done precisely that.

24 **3. Opposer’s Response to Interrogatory No. 3**

25 Applicant’s third interrogatory inquires about the “geographic scope” of the marks identified in
26 Opposer’s Notice of Opposition. In response, Opposer identified the geographic scope of its marks, one-
27 by-one. Some of these marks are used in all fifty states; Opposer thus stated that they are used
28

1 “throughout the United States.” Others are used in all fifty states and foreign countries; Opposer thus
2 stated that they are used “throughout the United States and beyond.” Opposer need not identify the
3 foreign countries in which it uses the mark, as only U.S. commerce is relevant. *See Int’l Bancorp, LLC*
4 *v. Societe Des Bains De Mer Et Du Cercle Des Etrangers A Monaco*, 329 F.3d 359, 378 (4th Cir. 2003).
5 Contrary to Applicant’s contention, there is nothing “vague” or “incomplete” about this answer.

6 **4. Opposer’s Response to Interrogatory No. 4**

7 Applicant’s fourth interrogatory asks Opposer to identify “each brochure, business card, sign,
8 placard, label, or other means” by which Opposer has used its marks. Again, this interrogatory is clearly
9 overbroad and unduly burdensome. As noted above, Opposer’s licensees have sold hundreds of millions
10 of products under the subject marks. Applicant cannot reasonably expect Opposer to identify every label
11 on every can. Furthermore, Opposer and its licensees have advertised their products extensively over the
12 past six years. Applicant cannot reasonably expect Opposer to identify every sign, brochure, and similar
13 materials with any sort of precision. Opposer stated that it uses its marks on labels and in advertisements
14 in various media, such as print, billboards, and websites. Documents reasonably identifying a
15 representative sample of these promotional materials have been produced to Applicant. This information
16 is more than sufficient for Applicant to draw all reasonably useful conclusions about Opposer’s
17 marketing efforts. The cases that Applicant cites do not indicate otherwise, and it is Applicant who bears
18 the burden on this motion.

19 **5. Opposer’s Response to Interrogatory No. 5**

20 Applicant’s fifth interrogatory seeks “a detailed accounting” of the amounts Opposer has spent
21 on marketing. Such information is proprietary to Opposer, and Opposer therefore refuses to provide
22 such information without a protective order.

23 Applicant does not deny that a protective order is proper. But Applicant suggests that Opposer
24 has somehow waived its right to a protective order. Applicant cites no authority in support of this
25 curious position. On the contrary, Applicant cites TMBP §414(18) which provides: “Annual sales and
26 advertising figures, stated in round numbers, for a party’s involved goods or services sold under its
27

1 involved mark are proper matters for discovery; if a responding party considers such information to
2 be confidential, disclosure may be made under protective order.”

3 In fact, Applicant expressly states that it “does not object to the entry of such a protective
4 order for confidential information.” (Mot., 15:26-27) But it maintains that Opposer “should have
5 sought it earlier.” (Mot., 15:27-16:1) Opposer is perplexed by this statement. Opposer raised the
6 issue of a protective order at the earliest practical time: in his responses to Applicant’s discovery
7 requests. Applicant apparently believes that Opposer should have sought a protective order before
8 discovery began, which would have been illogical, since Opposer did not know that Applicant would
9 seek confidential information until it saw Applicant’s discovery requests.

10 **6. Opposer’s Response to Interrogatory No. 7**

11 Applicant’s seventh interrogatory asks Opposer to identify “all persons who have ever been an
12 owner, assignee, or licensee of the marks, registrations, and applications set forth” in Opposer’s Notice
13 of Opposition, and to describe “how and when such proprietary interest was acquired or transferred.”
14 Opposer candidly responded that he is the only person who has ever owned the marks, applications, and
15 registrations. Furthermore, Opposer agreed to provide information concerning his licensees and
16 licensing agreements upon entry of a protective order. Again, Applicant does not deny that a protective
17 order is proper.

18 **7. Opposer’s Response to Interrogatory No. 8**

19 Applicant’s eighth interrogatory inquires about third party challenges to Opposer’s marks,
20 applications, and registrations. Opposer replied that he is unaware of any such challenges. Opposer has
21 no idea why Applicant finds this answer problematic.

22 **8. Opposer’s Response to Interrogatory No. 10**

23 Applicant’s tenth interrogatory states: “*If you contend* that any of the marks identified in your
24 Notice of Opposition have acquired secondary meaning, please set forth all facts upon which you base
25 that contention.” (emphasis added) In response, Opposer pointed out that its marks are inherently
26 distinctive, and Opposer therefore does not rely on his marks’ secondary meaning in this proceeding. In
27 other words, at this point in time, Opposer is not “contending” secondary meaning.

1 **9. Opposer's Response to Interrogatory No. 11**

2 Applicant's eleventh interrogatory is a catch-all. It asks for "all facts upon which you base your
3 contention that Applicant's mark should not be registered." This enormously broad interrogatory is
4 improper. If this sort of interrogatory were appropriate, there would be no need for Applicant (or *any*
5 applicant) to serve additional interrogatories. After all, all information relevant to this opposition
6 proceeding (or *any* opposition proceeding) concerns whether or not the subject mark should be
7 registered.

8 Not surprisingly, Applicant cites only "TMBP § 414" in support of its eleventh interrogatory.
9 That is, Applicant cites the *entire* section of the TMBP concerning discovery guidelines.

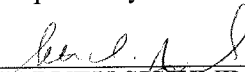
10 At any rate, Opposer candidly responded that Applicant's mark should not be registered because
11 it will create a likelihood of confusion with Opposer's actual and proposed marks, which will harm both
12 consumers and Opposer.

13 **CONCLUSION**

14 These motions to compel demonstrate bad faith on the part of Applicant. At best, Applicant's
15 motion to compel production of documents is moot, and Applicant's motion to compel supplemental
16 responses to interrogatories is overreaching. These motions were simply filed as a knee jerk response
17 to Opposer's own motion to compel. The Board should soundly deny Applicant's motions.

18
19 Dated: January 18, 2007

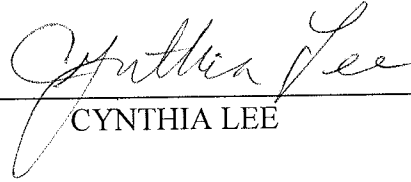
Respectfully submitted,

20 
21 HARVEY SISKIND LLP
22 IAN K. BOYD
23 SETH I. APPEL

24 Attorneys for Opposer
25 Russell G. Weiner
26
27
28

CERTIFICATE OF MAILING

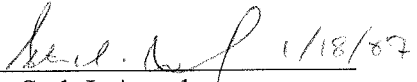
I hereby certify that a true and correct copy of the attached **OPPOSER'S OPPOSITION TO APPLICANT'S MOTIONS TO COMPEL PRODUCTION OF DOCUMENTS AND SUPPLEMENTAL RESPONSES TO INTERROGATORIES**, dated January 18, 2007 (Opposition No. 91170202), was served on Applicant by mailing a copy thereof via first-class mail, postage prepaid, addressed to James Slominski, Esq., The Hecker Law Group, 1925 Century Park East, Suite 2300, Los Angeles, California, 90067 on January 18, 2007.



CYNTHIA LEE

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being electronically transmitted to the Trademark Trial and Appeal Board on January 18, 2007.



Seth I. Appel

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2 IAN K. BOYD (SBN 191434)
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8 Attorneys for Opposer,
9 Russell G. Weiner

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

12 RUSSELL G. WEINER, an individual
13 Opposer,
14 v.
15 JMBP, INC., a California corporation
16 Applicant.

17 **DECLARATION OF SETH I. APPEL**
18 **IN SUPPORT OF OPPOSER'S**
19 **OPPOSITION TO APPLICANT'S**
20 **MOTIONS TO COMPEL PRODUCTION**
21 **OF DOCUMENTS AND**
22 **SUPPLEMENTAL RESPONSES TO**
23 **INTERROGATORIES**

24 Opposition No. 91170202

25 Application Serial No. 78976392

26 Published in the Official Gazette
27 on December 6, 2005

28 I, Seth I. Appel, declare:

1. I am an attorney at the law firm of Harvey Siskind LLP, counsel of record for Opposer Russell G. Weiner.

2. I have personal knowledge of the matters stated herein, and, if called as a witness, I could and would testify competently thereto.

3. I have communicated with James Slominski, counsel for Applicant JMBP, Inc. via email throughout this proceeding.

4. On December 19, 2006, Mr. Slominski sent me an email inquiring when Opposer would produce documents in response to Applicant's document requests. On December 21, I sent Mr. Slominski an email stating that Opposer would send him responsive documents by the end of the

1 following week, or December 29. A true and correct copy of this email is attached hereto as Exhibit
2 A.

3 5. Applicant did not object to Opposer's offer to send responsive documents to Applicant
4 by December 29.

5 6. On December 29, 2006, I sent Mr. Slominski 227 pages of responsive documents. A
6 true and correct copy of my cover letter and the first and last pages of these documents is attached
7 hereto as Exhibit B. A true and correct copy of the bill for copying and Bates stamping these
8 documents is attached hereto as Exhibit C.

9 I declare under penalty of perjury under the laws of the State of California that the foregoing
10 is true and correct.

11 Executed in San Francisco, California on January 18, 2007.

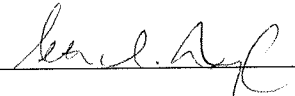
12
13 
14 _____
15 Seth I. Appel

Exhibit A

**to Declaration of Seth I. Appel in Support of
Opposer's Opposition to Applicant's Motions
to Compel Production of Documents and
Supplemental Responses to Interrogatories**

Offered by Opposer Russell G. Weiner

Russell G. Weiner v. JMBP, Inc.

Opposition No. 91170202

Application Serial No. 78976392

Seth I. Appel

From: Seth I. Appel
Sent: Thursday, December 21, 2006 4:29 PM
To: 'jimslominski'
Cc: Ian K. Boyd
Subject: RE: Rock Star Opposition

Jim, in light of the holidays, it will be impossible to get you the documents by the end of the week. But we'll send them to you by the end of next week.

Thanks,
Seth

From: jimslominski [mailto:jslominski@hh.com]
Sent: Tuesday, December 19, 2006 10:02 AM
To: Seth I. Appel
Subject: Rock Star Opposition

Seth, when are you going to produce the documents? Please have them here by the end of the week or we will file the appropriate motion.

Thanks
Jim

Exhibit B

**to Declaration of Seth I. Appel in Support of
Opposer's Opposition to Applicant's Motions
to Compel Production of Documents and
Supplemental Responses to Interrogatories**

Offered by Opposer Russell G. Weiner

Russell G. Weiner v. JMBP, Inc.

Opposition No. 91170202

Application Serial No. 78976392

HARVEY ■ SISKIND LLP

December 29, 2006

Seth I. Appel

James M. Slominski, Esq.
The Hecker Law Group
1925 Century Park East, Suite 2300
Los Angeles, CA 90067

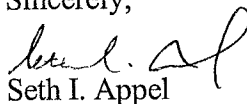
Re: *Weiner v. JMBP, Inc.*
TTAB Opposition No. 91170202

Dear Jim:

Enclosed please find documents responsive to your client's document requests. We will continue to search for responsive documents, and we will supplement this production accordingly. We will also supplement this production upon entry of an appropriate protective order.

Best wishes for the new year.

Sincerely,



Seth I. Appel

Int. Cl.: 32

Prior U.S. Cls.: 45, 46, and 48

Reg. No. 2,613,067

United States Patent and Trademark Office

Registered Aug. 27, 2002

**TRADEMARK
PRINCIPAL REGISTER**

ROCKSTAR ENERGY DRINK

WEINER, RUSSELL G. (UNITED STATES INDIVIDUAL)
8 ROSS ROAD
SAUSALITO, CA 94965

FOR: SPORTS DRINKS, NAMELY, ENERGY DRINKS, IN CLASS 32 (U.S. CLS. 45, 46 AND 48).

FIRST USE 8-19-1999; IN COMMERCE 1-16-2001.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "ENERGY DRINK", APART FROM THE MARK AS SHOWN.

SN 75-760,313, FILED 8-19-1999.

DANIELLE MATTESSICH, EXAMINING ATTORNEY

diet
ROCKSTAR
ENERGY DRINK

Party like a

ROCKSTAR!

ROCKSTAR
ENERGY DRINK

BIGGEST FASTEST STRONGEST

RW 0227

Exhibit C

**to Declaration of Seth I. Appel in Support of
Opposer's Opposition to Applicant's Motions
to Compel Production of Documents and
Supplemental Responses to Interrogatories**

Offered by Opposer Russell G. Weiner

Russell G. Weiner v. JMBP, Inc.

Opposition No. 91170202

Application Serial No. 78976392



Legal Solutions

120 Pine Street
San Francisco, CA 94111

Phone: 415-986-0111
Fax: 415-986-0633
Tax I.D. # 94-3173178

Invoice

Invoice Number
SF06-120418

Invoice Date
Dec 29, 2006

Bill To: Harvey Siskind LLP
4 Embarcadero Center
Suite 3950
San Francisco, CA 94111

Attn: Cindi Lee

Client Matter	Project Description	Payment Terms	
767.001	L/C x 1	Net 30 Days	
Sales Rep ID	Contact	Order Date	Due Date
House	Cindi Lee	12/29/06	12/29/06

Quantity	Description	Unit Price	Amount
227	bates label (RW 0001 ~ 0227)	0.0500	11.35
222	1 set of light litigation copies	0.1000	22.20
5	color copies, letter size	1.0000	5.00

	Subtotal	38.55
	Sales Tax	3.28
Received By: _____	Total Invoice Amount	41.83
Check/Credit Memo No:	Payment/Credit Applied	
	TOTAL	41.83

1.5% per month Finance Charge on Past Due Invoices.

CERTIFICATE OF MAILING

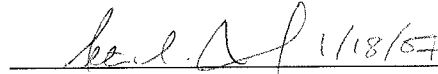
I hereby certify that a true and correct copy of the attached **DECLARATION OF SETH I. APPEL IN SUPPORT OF OPPOSER'S OPPOSITION TO APPLICANT'S MOTIONS TO COMPEL PRODUCTION OF DOCUMENTS AND SUPPLEMENTAL RESPONSES TO INTERROGATORIES**, dated January 18, 2007 (Opposition No. 91170202), was served on Applicant by mailing a copy thereof via first-class mail, postage prepaid, addressed to James Slominski, Esq., The Hecker Law Group, 1925 Century Park East, Suite 2300, Los Angeles, California, 90067 on January 18, 2007.



CYNTHIA LEE

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being electronically transmitted to the Trademark Trial and Appeal Board on January 18, 2007.


Seth I. Appel