ESTTA Tracking number: **ESTTA214460**

Filing date: **05/29/2008**

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

Proceeding	91172045
Party	Defendant Lightspeed Entertainment, LLC
Correspondence Address	Tabetha D. Plummer, Esq. Plummer Law Group, PC Penthouse 14724 Ventura Boulevard Sherman Oaks, CA 91403 UNITED STATES tabetha@plummerlawgroup.com
Submission	Opposition/Response to Motion
Filer's Name	Brian P. Kinder
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Signature	/Brian P. Kinder/
Date	05/29/2008
Attachments	opposition to motion - dec - exhibits.pdf (21 pages)(882849 bytes)

I hereby certify that this paper or fee is being electronically filed with the United States Patent and Trademark Office on May 29, 2008.

Brian P. Kinder

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TRADEMARK TRIAL AND APPEAL BOARD

MONSTER CABLE PRODUCTS, INC. Opposer, v. LIGHTSPEED ENTERTAINMENT, LLC, Applicant.	)	Opposition No.: 91172045 Serial No.: 78/614,307

OPPOSITION TO MOTION TO COMPEL

THE PRODUCTION OF DISCOVERY

Applicant Lightspeed Entertainment, LLC ("Applicant") hereby opposes Petitioner Monster Cable Products, Inc.'s ("Petitioner") Motion to Compel Discovery (the "Motion") on the following three grounds: (1) Petitioner's Motion is procedurally flawed and Petitioner has intentionally ignored its obligation to the Board to meet and confer before filing the Motion – even after Applicant offered to do so upon receipt of the Motion, (2) the Motion is without merit in that Applicant has fully responded to Petitioner's discovery, and (3) the filing of the Motion contradicts Petitioner's own position in that Petitioner has – improperly – refused to respond to Applicant's discovery requests based on the allegation that it is "treating" all matters as suspended pending Petitioner's Motion to Reopen the Discovery Period. Accordingly, the Motion either should be denied on the merits in its entirety, or at a minimum, should be denied until Petitioner has satisfied its obligation to the Board to meet and confer with Applicant.

I. INTRODUCTION

The filing of the instant Motion is yet another chapter in the growing book of discovery abuses perpetrated by the Petitioner. Moreover, the filing fully supports Applicant's assertion that Petitioner is merely attempting to increase the costs of the proceeding because it cannot prove a likelihood of confusion under the circumstances (see Applicant's arguments to this end in the pending opposition to Petitioner's Motion to Reopen). The Board simply should not countenance behavior of this sort on the part of litigants because to do so would risk encouraging this type of behavior in the future. As an introduction to the preposterous nature of the instant Motion, the Board should be aware of the following:

- Petitioner has refused to respond to Applicant's first set of discovery on the basis that Petitioner is "treating all matters as suspended" pending the outcome of Petitioner's motion to reopen the discovery period.
- Despite this position, as improper as it is, Petitioner nonetheless filed the instant Motion to Compel in an act of complete contradiction.
- Worse yet, Petitioner filed the Motion without having ever met and conferred with Applicant.
- Upon receiving the Motion, Applicant immediately sent Petitioner a letter pointing out the shortcoming and requesting an opportunity to meet and confer.
- Despite Applicant's efforts, Petitioner did not even provide the courtesy of a response.
- As a result, Applicant is now forced to oppose the instant Motion both procedurally and on the merits since there is simply no basis for

the allegations of the Motion. Should the Board permit this sort of behavior, Petitioner will achieve its goal of increasing the costs of this dispute at the expense of the Board's valuable judicial resources.

II. STANDARD OF REVIEW

"If a party fails ... to answer any question propounded in a discovery deposition, or any interrogatory, or fails to produce and permit the inspection and copying of any document or thing, the party seeking discovery may file a motion before the Trademark Trial and Appeal Board for an order to compel...." *TBMP § 523.01; see also 37 CFR § 2.120(e).* Further, "The motion must be supported by a written statement from the moving party that such party or its attorney has made a good faith effort, by conference or correspondence, to resolve with the other party or its attorney the issues presented in the motion, and has been unable to reach agreement." *TBMP § 523.02; see also 37 C.F.R. § 2.120(e).* [Emphasis added.] Moreover, the "motion to compel procedure is not applicable to requests for admission" since "the procedure to be followed in the case of requests for admission is as set forth in 37 CFR § 2.120(h) and Fed. R. Civ. P. 36(a)." *TBMP 523.01.*

III. ARGUMENT

A. Petitioner's Motion Suffers From Two Serious Procedural Defects.

Apart from the fact that Petitioner's Motion is substantively without merit, the Motion also suffers such serious procedural defects as to be rendered void. More precisely, and as set forth in detail below, Petitioner's Motion to Compel improperly includes a request to compel responses to requests for admission and, more seriously, Petitioner has also entirely, and intentionally, failed to fulfill its

meet and confer obligations to the Board.

(i) **A Motion to Compel is Inappropriate As to Responses to Requests for Admission.**

In Petitioner's Motion to Compel, Petitioner "moves the Board to compel Applicant to respond to Opposer's interrogatories, admissions and requests for production of documents." See Petitioner's Motion to Compel, pg. 1. As set out above, however, the motion to compel procedure is not applicable to requests for admission. The appropriate procedure with regard to requests for admission is a "motion to test the sufficiency of response to admission request." *TBMP § 524.*

(ii) **Petitioner Has Intentionally Ignored The Obligation to the Board to Meet And Confer With Applicant Before Filing the Instant Motion.**

As indicated above, before filing a motion to compel, the moving party must make a good faith effort, by conference or correspondence, to resolve the issues presented in the motion. As set forth in greater detail below, Petitioner not only failed to fulfill the meet and confer obligation, but Petitioner's actions were clearly intentional in view of the fact that Petitioner outright ignored Applicant's good faith offer and request to meet and confer.

Prior to Petitioner filing the Motion to Compel, Applicant presented a letter to Petitioner setting out the terms of a settlement proposal. *See Kinder Decl, ¶ 2, Ex. A.* Counsel for Applicant also called counsel for Petitioner on two (2) separate occasions over the course of the two (2) week period following transmission of the letter. *Id. at ¶ 3.* It wasn't until two (2) weeks and three (3) days later when counsel for Petitioner returned counsel for Applicant's phone calls. *Id. at ¶ 4.* During the conversation, the only discussion between the respective counsel was in relation to Applicant's settlement proposal. *Id.* Also, Petitioner requested and

Applicant granted a ten (10) day extension of time for Petitioner to respond to Applicant's first set of discovery. *Id.* Counsel for Petitioner sent counsel for Applicant an email dated April 17, 2008 that confirmed the discussion of these issues. *Id. at ¶ 5, Ex. B.* There was no discussion about the issues now raised in Petitioner's Motion to Compel and the issue is not raised in counsel for Petitioner's confirming email. *See Id. at ¶ 4, see also id. at ¶ 5, Ex. B.*

Apart from the foregoing, the only communication from counsel for Petitioner that could even be construed as relating to the issues in the Motion to Compel is a letter dated more than two (2) months prior to the filing date of the instant Motion to Compel. *Id. at ¶ 6, Ex. C.* (March 12, 2008 letter from counsel for Petitioner). The letter simply stated that Petitioner viewed Applicant's document production as being "unacceptable" and proposed that the parties stipulate to a ninety (90) day extension of the discovery period. *Id.* Such actions by no means satisfy Petitioner's obligations to the Board to attempt to resolve discovery issues.

Moreover, even if the letter could somehow be construed as attempting to resolve a discovery issue, the letter mentions nothing about Applicant's responses to interrogatories or requests for admission. In fact, the letter addresses only the issue of document production and does not even attempt to meet and confer as to any other issue. As explained in detail below, the reason behind the exclusion of these other issues in the letter is because Petitioner's Motion to Compel is entirely without merit as Applicant has in fact fully responded to all discovery propounded by Petitioner. On this procedural basis alone, the Motion should be denied, and as set forth in more detail below, the Motion should also be denied on substantive grounds.

B. Petitioner's Motion is Entirely Without Merit Since Applicant Has Fully Responded to All Propounded Discovery.

Nowhere in the Motion to Compel does Petitioner explain how or why Applicant's responses are improper. Indeed, Petitioner is unable to articulate any shortcomings in the responses because there are none to be found. For the same reason, Petitioner has refused to meet and confer with Applicant because Petitioner simply has no basis to allege that the responses are deficient in any way.

Not only are the responses entirely appropriate, but Applicant even went out of its way to offer cooperation with regard to those interrogatories propounded by Petitioner that were so inartfully crafted by Petitioner as to be rendered incomprehensible. By way of example, the Board will note the following exchange in response to Petitioner's Interrogatory No. 9:

> "INTERROGATORY NO. 9: Please describe fully any proposed or intended use of the intended mark use in connection with the promotion, distribution, sale, license, performance, electronic transmittal or reproduction of electronic goods.
>
> RESPONSE TO INTERROGATORY NO 9: Applicant objects to this request on the ground that it is vague, ambiguous and unintelligible in that it **appears to be an incomplete sentence** with either unintended words included or intended words excluded. Without waiving said objections, **Applicant will respond to this interrogatory upon clarification** from Opposer." [Emphasis added.]

At no time has Petitioner either offered such clarification or met and conferred with Applicant on this point or any other for that matter. While Applicant could have simply objected on the grounds that the inarftful drafting rendered the interrogatory unintelligible and refused to answer on such grounds, Applicant acted in good faith and agreed to cooperate upon clarification. Thus, it is clear that the only gamesmanship and discovery abuses being perpetrated are

those of Petitioner in the filing of the instant Motion (together with Petitioner's refusal to respond to Applicant's discovery based upon the allegation that they are "treating all matters as suspended" pending a decision on their motion to reopen discovery.). Accordingly, the Motion is without merit and should be denied in its entirety.

C. The Filing of The Instant Motion is Yet Another Chapter In A Growing Book of Discovery Abuses by Petitioner.

On April 17, 2008, Petitioner requested and Applicant granted a ten (10) day extension of time to respond to Applicant's first set of discovery, including, interrogatories, requests for admission, and requests for production of documents. The same day, Petitioner filed a Motion to Reopen the Discovery Period, which motion remains pending before the Board. Eleven (11) days later, on March 28, 2008, Petitioner sent a letter to Applicant stating, "Pursuant to our Motion [to Reopen the Discovery Period] in the TTAB, we are treating all matters as suspended including your discovery to our client." *See Kinder Decl.*, ¶ *7, Ex. D.*

Notwithstanding the impropriety of that position, the filing of the instant Motion to Compel flies directly in the face thereof and confirms Applicant's allegation that Petitioner is not acting in good faith and is engaging in egregious discovery abuses for the sole purpose of increasing the cost of defending this proceeding. As stated at the outset of this opposition, the Board simply should not countenance such behavior because to do so would risk encouraging this type of behavior in the future.

2. CONCLUSION

In view of the procedural and substantive defects in Petitioner's Motion, the request for an order to compel should be denied entirely. Moreover, Applicant

believes strongly that Petitioner's actions and discovery abuses merit the filing of a **motion for terminating sanctions**, but does not wish to burden the Board's judicial resources if the Board feels otherwise. If the Board would entertain such a motion, **Applicant respectfully requests that the Board invite such a motion** from Applicant.

Dated: May 29, 2008

HART, KING & COLDREN

By: _____

Brian P. Kinder
David Christopher Baker
Attorneys for Applicant
Lightspeed Entertainment, Inc.

DECLARATION OF BRIAN P. KINDER

I, Brian P. Kinder, declare:

1. I am a duly licensed attorney and an associate with the law firm of Hart, King & Coldren, attorney of record for Applicant Lightspeed Entertainment, Inc. ("Applicant"). The facts set forth herein are true of my own personal knowledge and if called as a witness, I could and would competently testify thereto.

2. Attached as Exhibit A is a true and correct copy of a letter from me to counsel for Petitioner dated April 4, 2008 which sets out the terms of a settlement proposal.

3. Between March 12, 2008 and April 16, 2008, I personally placed at least two (2) phone calls to counsel for Applicant to inquire about, among other things, the settlement offer set forth in the letter in Exhibit A hereto.

4. On April 17, 2008, I received a telephone call from counsel for Petitioner and the only issues that we discussed related to Applicant's settlement proposal and Petitioner's request for a ten (10) day extension of time for Petitioner to respond to Applicant's first set of discovery – which I granted. At no time during the conversation did Petitioner raise any issue that is now set out in Petitioner's Motion to Compel.

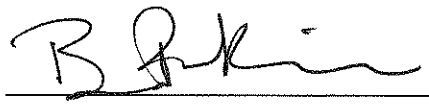
5. On the same day, April 17, 2008, I received an email from counsel for Petitioner confirming our earlier conversation. A true and correct print out of the email is attached hereto as Exhibit B.

6. Attached hereto as Exhibit C is a true and correct copy of a letter from counsel for Petitioner to me dated March 12, 2008.

7. Attached hereto as Exhibit D is a true and correct copy of a letter from counsel for Petitioner to me dated April 28, 2008.

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

Executed May 29, 2008, in Santa Ana, California



Brian P. Kinder

PROOF OF SERVICE
Monster Cable Products, Inc. v. Lightspeed Entertainment, Inc.
Opposition No.: 91172045

STATE OF CALIFORNIA, COUNTY OF ORANGE

I am employed in the County of Orange, State of California. I am over the age of 18 years and am not a party to the within action. My business address is 200 Sandpointe, Fourth Floor, Santa Ana, California 92707-0507. On May 29, 2008, I caused the foregoing document(s) described as **1) OPPOSITION TO MOTION TO COMPEL DISCOVERY,** to be served on the interested parties in this action as follows:

Nicole Smith, Esq.
LaRiviere, Grubman & Payne, LLP
19 Upper Ragsdale Drive, Suite 200
P. O. Box 3140
Monterey, CA 93942

☒ **BY MAIL:** I am "readily familiar" with the firm's practice of collection and processing correspondence for mailing. Under that practice it would be deposited with the U.S. Postal Service on that same day with postage thereon fully prepaid Santa Ana, California in the ordinary course of business. I am aware that on motion of the party served, service is presumed invalid if the postal cancellation date or postage meter date is more than one day after date of deposit for mailing in the affidavit.

☐ **BY OVERNIGHT COURIER:** I caused such envelope to be placed for collection and delivery on this date in accordance with standard OVERNITE EXPRESS delivery procedures.

☐ **BY PERSONAL SERVICE:** I caused such envelope to be delivered by hand to the above-referenced person(s).

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

Executed on May 29, 2008, at Santa Ana, California.

Jill McIntee

EXHIBIT A

HK&C
HART, KING & COLDREN

Brian P. Kinder
bkinder@hkclaw.com

April 4, 2008

Our File Number: 38079.001/4849-0718-6434v.1

CONFIDENTIAL COMMUNICATION
FOR SETTLEMENT PURPOSES ONLY
Fed. R. Evid. 408; Cal. Evid. Code § 1152

SENT VIA EMAIL (nsmith@lgpatlaw.com)
AND FIRST CLASS MAIL

Nicole Smith, Esq.
LaRiviere, Grubman & Payne, LLP
19 Upper Ragsdale Drive, Suite 200
Monterey, California 93942

Re: Monster Cable Products, Inc. v. Lightspeed Entertainment, Inc.
Mark: MONSTER CONTROL
Opposition No. 91172045

Dear Ms. Smith:

You have no doubt now had an opportunity to review our client's use and proposed use of the "MONSTER CONTROL" mark. In that regard, we are hopeful that your client is now more receptive to our argument that no likelihood of confusion will result from the simultaneous use of the marks in question. More precisely, we anticipate that your client will acknowledge that it will not be harmed by my client's use of the term MONSTER in connection with products that have a "creature-like" or "monster-like" theme as a prominent characteristic or feature.

In light of the above, we propose the following as a means of resolving this matter to the mutual satisfaction of the parties:

1) Our client will amend (subject to approval by the Board and/or the Examining Attorney) the description of goods in the application to read as follows: "Motion picture films ***featuring animated characters in the action adventure genre***; pre-recorded video tapes and discs ***featuring animated characters in the action adventure genre***; and computer programs, games and software ***featuring animated characters in the action adventure genre***.";

2) We anticipate that when our client submits specimens of use, the Examining Attorney will require our client to disclaim the term "MONSTER" apart from the mark as shown. Accordingly, in advance of any such requirement, and in addition to the significant limitations set out above, our client immediately enter a **voluntary disclaimer of MONSTER**; and

3) Our client will agree to always use the mark in connection with **stylization and/or a logo** as prominent as that with which it is presently used. Any future modifications to the stylization or logo will continue to portray a "creature-like" or "monster-like" theme along the lines of that which is currently used.

We believe the foregoing modifications will serve your client's goals in that it likely has no interest in preventing the use of marks where the word MONSTER is voluntarily disclaimed. In that regard, it would seem to be a rather significant waste of capital resources for your client to proceed with this dispute. This is particularly true given the fact that your client did not object to our client's registration of the identical MONSTER CONTROL mark for its line of comic books and related paper products. See U.S. Reg. No. 3,336,162.

While we understand that your client is certainly in a position to afford the costs of taking this matter through to completion, we also believe that the cost-benefit to your client just simply does not warrant such a course of action. As you are no doubt aware, your client's responses to our first set of discovery are coming due on **April 18, 2008**. In that regard, we estimate that the costs to respond to the discovery will not be insignificant, particularly since your client has elected to assert numerous (and questionably relevant) registrations against my client and will need to provide multi-faceted responses corresponding to each registration[1].

In addition to the foregoing, we note that your client has conducted little in the way of discovery and is facing a testimony period within the coming month. At this point in time, your client could certainly undergo the costs of appealing to the Board to re-open discovery, but with the substantial risk of being denied the relief requested. Even if your client were ultimately successful, there will no doubt be substantial additional costs involved in preparing subsequent rounds of discovery. If your client will not agree to stipulate to the proposed modification to the description of goods set out above, no doubt the Board will eventually permit it. Should your client elect to challenge the request, however, this will present additional costs.

When your client couples all of the substantial costs laid out above with the questionable impact that a registration of a mark with the term MONSTER disclaimed would have on their rights, we anticipate they will see the benefit of resolving this matter amicably. Particularly given the more than reasonable offer that our client has presented above.

I will endeavor to contact you within the next few days to discuss this matter in detail. If there is a good time for me to call, please send me an email and provide me with that information. Alternatively, if you should have any questions or concerns, please do not hesitate to contact me at your earliest convenience.

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[1] See TBMP § 405.03(c) (The rules "do not provide for extra interrogatories in cases where more than one mark is pleaded and/or attacked by the plaintiff because in such cases, the propounding party may simply request that each interrogatory be answered with respect to **each involved mark of the responding party**, and the interrogatories will be counted the same as if they pertained to only one mark.").

I look forward to speaking to you about this matter soon.

Thank you.

Very truly yours,

HART, KING & COLDREN

Brian P. Kinder

cc: Client

EXHIBIT B

Brian P. Kinder

From: Tabatha Morgan [tmorgan@lgpatlaw.com]
Sent: Thursday, April 17, 2008 2:55 PM
To: Brian P. Kinder
Cc: Nicole Smith
Subject: Monster Control, Opposition No. 91172045
Attachments: Motion to Reopen Discovery 4-17-08.pdf; Decl. Motion to Reopen 4-17-08.pdf

Dear Mr. Kinder:

In regard to the above-referenced matter, please find a copy of the Motion to Reopen Discovery that was filed with the TTAB today.

If you have any questions, or have trouble opening the attachments, please feel free to contact this office.

<<Motion to Reopen Discovery 4-17-08.pdf>> <<Decl. Motion to Reopen 4-17-08.pdf>>

Best regards,

Tabatha Morgan
Paralegal
LaRiviere, Grubman & Payne, LLP
19 Upper Ragsdale Drive, Suite 200
Monterey, CA 93942
831-649-7523 Direct Line
831-649-8835 Fax
tmorgan@lgpatlaw.com

EXHIBIT C

LaRiviere, Grubman & Payne, LLP

LaRiviere Grubman & Payne

Ronald E. Grubman, Ph.D., J.D.
Of Counsel

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San Jose Office
1400 N. 4th Street

March 12, 2008

VIA EMAIL (bkinder@hkclaw.com) & U.S. MAIL

Mr. Brian P. Kinder
Hart King & Coldren
200 Sandpointe 4th Floor
Santa Ana, CA 92707

Re: *Monster Cable Products, Inc. v. Lightspeed Entertainment, LLC*
Mark: "MONSTER CONTROL"
Opposition No.: 91172045

Dear Mr. Kinder:

We have received and reviewed the responses you sent to our discovery. We are disappointed to see that after granting over a year's worth of extensions, the vast majority of what was produced came from the PTO's website and was not responsive to our requests. Indeed, of the 640 documents produced, the first 100 are missing and about 450 are internet printouts from the PTO's database.

When we granted the most recent extension for your production of discovery we clarified that it had been a year since we sent discovery and we would only grant an additional extension if we would receive meaningful responses to our discovery. Internet print-outs from the Patent and Trademark Office are not meaningful responses to what we requested in our discovery.

Clearly the discovery production is unacceptable and we will need responsive information from your client. In light of these factors and for any potential settlement, we would like to push back the discovery period for 90 days.

Please let us know if you stipulate to extending the discovery period 90 days to resolve these matters. We look forward to hearing from you no later than Friday, March 14, 2008.

Sincerely,

LARIVIERE, GRUBMAN & PAYNE, LLP

Nicole A. Smith

Nicole A. Smith

NAS/trm

EXHIBIT D

April 28, 2008

VIA EMAIL (bkinder@hkclaw.com) & U.S. MAIL

Mr. Brian P. Kinder
Hart King & Coldren
200 Sandpointe 4th Floor
Santa Ana, CA 92707

Re: *Monster Cable Products, Inc. v. Lightspeed Entertainment, LLC*
Mark: "MONSTER CONTROL"
Opposition No.: 91172045

Dear Mr. Kinder:

Pursuant to our Motion in the TTAB, we are treating all matters as suspended including your discovery to our client.

Nonetheless, for the purposes of advancing this case we are collecting responsive materials and having them Bates stamped.

However, a large portion of your discovery requests were directed to extraneous cases to which your client is neither a party nor has any ownership interest. Please note that we will not be responding to the irrelevant and voluminous discovery requests directed to these cases. According to our files 105 of the 135 total document requests and 79 of your 91 admissions were directed to either marks your client has no interest in or cases in which you are not counsel of record.

Thank you in advance for your cooperation in this matter.

Sincerely,

LARIVIERE, GRUBMAN & PAYNE, LLP

Nicole A. Smith

NAS/trm

LaRiviere, Grubman & Payne LLP

L LaRiviere
G Grubman
P & Payne

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