

ESTTA Tracking number: **ESTTA508481**

Filing date: **11/30/2012**

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

Proceeding	91178927
Party	Plaintiff Royal Crown Company, Inc. and Dr. Pepper/Seven Up, Inc.
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Date	11/30/2012
Attachments	Royal Crown Company, Inc's Motion To Compel and To Test Sufficiency of Objection (F1128612).PDF (14 pages)(612088 bytes)

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

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ROYAL CROWN COMPANY, INC.,	:	<u>Consolidated Proceedings</u>
	:	Opposition No. 91178927
Opposer,	:	Opposition No. 91180771
	:	Opposition No. 91180772
- against -	:	Opposition No. 91183482
	:	Opposition No. 91185755
THE COCA-COLA COMPANY,	:	Opposition No. 91186579
	:	Opposition No. 91189847
Applicant.	:	Opposition No. 91190658
-----X		

—and—

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THE COCA-COLA COMPANY,	:	
	:	
Opposer,	:	
	:	
- against -	:	Opposition No. 91184434
	:	
ROYAL CROWN COMPANY, INC.,	:	
	:	
Applicant.	:	
-----X		

**ROYAL CROWN COMPANY, INC.’S
MOTION TO COMPEL AND TO TEST SUFFICIENCY OF OBJECTION**

These consolidated oppositions have been pending since 2007. Throughout the discovery phase of these proceedings, The Coca-Cola Company (“TCCC”) has engaged in a pattern of refusing to honor its discovery obligations, interjecting invalid objections to Royal Crown’s discovery requests, withholding clearly responsive documents with no basis, repeatedly promising and then failing to deliver document production, failing to update and supplement its discovery responses and, now, refusing to respond to validly served discovery requests. Royal Crown has already had to make one motion to requesting the Board to compel TCCC to fulfill its

discovery obligations. Apparently, TCCC did not learn its lesson from that experience. On the contrary, its discovery behavior has only deteriorated. At this point, Royal Crown can no longer afford to wait for TCCC to get its discovery act together. After five years, the trial period for these proceedings is finally set to open in about six weeks. Yet Royal Crown *still* does not complete discovery from TCCC.

Therefore, pursuant to Rule 37(a) of the Federal Rules of Civil Procedure and Rule 2.120(e) of the Trademark Rules of Practice, Royal Crown Company, Inc. (“Royal Crown”)¹ hereby moves the Trademark Trial and Appeal Board (the “Board”) for an order compelling TCCC to (i) produce documents in response to Royal Crown’s document requests dated January 14, 2010; (ii) produce documents in response to Royal Crown’s document requests dated February 23, 2010; (iii) respond in full and without objection, including by producing responsive documents, in response to Royal Crown’s document requests dated August 17, 2012; and (iv) supplement its written responses and document production to requests for admission Nos. 50-51, 68, 70-98, 101, 106-113, 124-125 and 132-137, document requests Nos. 7-9, 12-19, 21-22, 24-27, 30-33, 35-36 and 38, and interrogatories Nos. 8-14 by updating its responses thereto.

Pursuant to Rule 36(a)(6) of the Federal Rules of Civil Procedure and Rule 2.120(h) of the Trademark Rules of Practice, Royal Crown further moves the Board for an order determining that TCCC’s objection to Royal Crown’s requests for admission dated August 17, 2012 was insufficient and ordering TCCC to respond in full and without objection.

¹ By motion dated November 15, 2012, Royal Crown has moved to substitute its successor-in-interest, Dr Pepper/Seven Up, Inc. as the opposer and applicant in these consolidated proceedings. The Board has not yet ruled on the motion.

CERTIFICATION OF COUNSEL

Pursuant to Trademark Rule of Practice 2.120(e), this motion is made following repeated good faith attempts by counsel for Royal Crown to resolve with counsel for TCCC the issues presented in this motion. Despite such good faith efforts, TCCC has failed to provide the outstanding discovery materials. (*See, generally*, Declaration of Laura Popp-Rosenberg in Support of Royal Crown’s Motion to Compel (“Popp-Rosenberg Decl.”).) Based on the extensive communications between counsel for the parties prior to bringing this motion and the fact that those communications have not resulted in the resolution of the issues addressed herein, Royal Crown does not believe that further discussions with TCCC are likely to resolve the dispute.

BACKGROUND

As one would imagine in the case of proceedings going on for more than five years, the procedural and discovery history of these consolidated oppositions is complicated. Royal Crown limits its background explication to the facts most pertinent to the instant motion.

A. Procedural History

The first of these consolidated proceedings was instituted more than five years ago, on August 14, 2007. Since that time, these proceedings have gone through many twists and turns. For the most part, the consolidated oppositions proceeded apace, with short stops and sputterings for various issues, until Royal Crown served its first Motion to Compel on August 21, 2009. (Dkt. No. 44.) After the Board decided that motion on November 13, 2009 (Dkt. No. 50), the proceedings have repeatedly been extended and suspended. On February 23, 2010, which was the date discovery was set to close under the Board’s then-operative November 13, 2009 Order, the parties jointly moved for a 60-day extension of remaining dates so that they could complete

discovery (Dkt. No. 51), which motion the Board granted (Dkt. No. 52). On May 14, 2010, the parties jointly requested a further 30-day extension of remaining dates, again to permit the parties to conclude discovery (Dkt. No. 53), which motion the Board granted (Dkt. No. 54.) On July 9, 2010, the parties jointly requested a further 45-day extension of the remaining dates, again to permit the parties to conclude discovery (Dkt. No. 55), which motion the Board granted (Dkt. No. 57). On August 13, 2010, the parties once again requested an extension of the remaining dates – for 60 days – again based on the parties’ need to complete discovery (Dkt. No. 58), which the Board again granted (Dkt. No. 59).

Following these successive requests to extend the dates for discovery purposes, the parties engaged on a course of settlement discussions, resulting in suspension of the proceedings. (See Dkt. Nos. 60, 62, 64 & 66.) Settlement discussions ultimately did not prove fruitful. But by that time, a third-party opposition involving some of the same TCCC marks involved in this proceeding (Opposition No. 91178953) had progressed to the trial stage, so the parties and the Board agreed that it made sense to suspend these proceedings pending decision in the other opposition. (See Dkt. No. 68 & 69.) After a decision issued in the third-party opposition, the Board issued an order resuming these proceedings on July 19, 2012. Among other things, the Board’s July 19, 2012 Order set August 17, 2012 as the discovery close date. (Dkt. No. 71.) The Board issued a slightly revised, corrected order on July 23, 2012, which maintained the August 17, 2012 discovery close date. (Dkt. No. 72.)

The parties later filed a stipulated motion to extend the trial dates in these proceedings so that discovery could be completed and updated (Dkt. No. 73), which motion to Board granted on October 4, 2012. (Dkt. No. 74.) Under the current schedule, Royal Crown’s first set of pretrial

disclosures are due December 23, 2012, and its first testimony period opens January 7, 2013.

(*See id.*)

B. Discovery History

In connection with these proceedings, Royal Crown has served on TCCC five sets of requests for documents, four sets of requests for admission and two sets of interrogatories.

(Popp-Rosenberg Decl. ¶¶ 2-4.)

1. TCCC's Failure to Produce Documents in Response to Royal Crown's Third and Fourth Document Requests

Royal Crown served on TCCC Royal Crown's Third Set of Requests for the Production of Documents and Things to Applicant ("Third Document Requests") on January 14, 2010 and Royal Crown's Fourth Set of Requests for the Production of Documents and Things to The Coca-Cola Company ("Fourth Document Requests") on February 23, 2010. (Popp-Rosenberg Decl. ¶¶ 2(c)-(d) & Exs. 5, 7). TCCC served written responses to the discovery requests by the due dates. (*Id.* at ¶¶ 5, 8 & Exs. 2, 5.) However, TCCC has never produced documents in response to either the Third or the Fourth Document Requests. In response to Royal Crown's repeated requests for production, TCCC simply makes promises of future production but then never makes good on its word. (*See, generally*, Popp-Rosenberg Decl. ¶¶ 5-22, 32-35, 42-45.) TCCC said it would make production on March 31, 2010, but did not. (*Id.* at ¶¶ 6-7.) TCCC then said it would make production by June 3, 2010, but did not. (*Id.* at ¶¶ 9-13 & Exs. 24-27.) TCCC next gave September 8, 2010 as the production date, but again produced no documents by that date. (*Id.* at ¶¶ 14-21 & Exs. 32-33.) TCCC next offered September 20, 2010 as the date for production, but again failed to deliver. (*Id.* at ¶¶ 21-22 & Exs. 34-35.) Following the long suspension of these proceedings, and again after repeated demands from Royal Crown that it make production in response to the 2010 document requests, TCCC next proposed October 19,

2012 as its production date. (*Id.* at ¶¶ 26, 28, 30, 32-35 & Exs. 36-40.) Not surprisingly, TCCC once again failed to deliver its long-overdue and long-promised production by the deadline TCCC had set for itself.

Now, nearly three years after the Third and Fourth Document Requests were served, and despite being advised that this motion was forthcoming (*see* Popp-Rosenberg Decl. ¶¶ 42, 45), TCCC *still* has not produced documents in response to Royal Crown's Third and Fourth Document Requests. (*Id.* at ¶ 45.)

2. TCCC's Refusal to Respond to Royal Crown's Fifth Document Requests and Fourth RFAs

When the Board resumed these proceedings in mid-July of this year after the long suspension, the Board set a discovery close date of August 17, 2012, first in its order issued July 19, 2012, then again in its corrected order issued July 23, 2012. (Dkt. Nos. 71-72; *see also* Popp-Rosenberg Decl. ¶¶ 27, 29.) While TCCC of course had every reason to look closely at the Board's July 19 and July 23 Orders to understand what dates had been set for the resumed proceedings, it had even more reason than usual to give the July 19 and July 23 Orders special scrutiny. First, Royal Crown had advised TCCC of a mistake in the Board's July 19 Order (which mistake was corrected through the July 23 Order). (Popp-Rosenberg Decl. ¶ 28 & Ex. 37.) Moreover, the parties had multiple telephone and email communications debating an appropriate extension of the deadlines set forth in the July 23 Order. (*Id.* at ¶¶ 28, 30.) Despite having extra reason to closely review the Board's July 19 and July 23 Orders, TCCC did not raise any objection to the Orders or the dates set forth therein, including the August 17, 2012 discovery close date.

Consistent with the July 23 Order, Royal Crown on August 17, 2012 served TCCC with Royal Crown's Fifth Set of Requests for the Production of Documents and Things to The Coca-

Cola Company (“Fifth Document Requests”) and Royal Crown’s Fourth Set of Requests for Admission (“Fourth RFAs,” and, together with the Fifth Document Requests, the “August 17 Discovery Requests”). (Popp-Rosenberg Decl. ¶¶ 2(e), 3(d), 31 & Ex. 9, 17) Thereafter, TCCC requested, and Royal Crown granted, two extensions of TCCC’s time to respond to the August 17 Discovery Requests, so that TCCC’s responses ultimately became due October 12, 2012. (*Id.* at ¶¶ 34-37 & Exs. 39-40.) From the August 17, 2012 service date of the Fifth Document Requests and Fourth RFAs, the parties engaged in fairly regular email correspondence and at least two separate telephone conferences to discuss TCCC’s need to complete discovery and both parties’ needs to update discovery. (*Id.* at ¶¶ 32-37 & Exs. 38-40.) At no point did TCCC ever question Royal Crown’s right to serve the August 17 Discovery Requests. In fact, in response to a specific inquiry from Royal Crown on September 18, 2012 as to when TCCC would produce documents in response to the Fifth Document Requests, TCCC responded that it would make production by October 19, 2012. (*Id.* at ¶ 35 & Ex. 40.)

As it turned out, TCCC’s actions and statements during this period of frequent communications between the parties were merely subterfuge, intended to convince Royal Crown that TCCC would (finally) live up to its discovery obligations when in fact TCCC had nothing of the sort in mind. On October 12, 2012, when TCCC finally provided its written responses to the August 17 Discovery Requests, TCCC revealed that it had no intention of responding to Royal Crown’s duly served August 17 Discovery Requests. Instead, TCCC merely objected to the requests on the newly-minted and baseless theory that they were untimely served because discovery allegedly had closed long ago and the August 17, 2012 discovery close date set forth in the Board’s July 19 and July 23 Orders was an error. (Popp-Rosenberg Decl. ¶ 38 & Exs. 10, 18.) Although the parties have engaged in telephone and email communications to address

TCCC's untimeliness objection to the August 17 Discovery Requests, TCCC continues to refuse to withdraw its baseless objection or to provide proper and complete responses. (*Id.* at ¶¶ 39-45 & Exs. 41-45.)

D. TCCC's Failure to Supplement Its Discovery Responses

After the Board resumed these proceedings following a more than 20-month suspension, the parties agreed that each would need to supplement its discovery responses to bring them up to date. (*See* Popp-Rosenberg Decl. ¶¶ 30, 32-36 & Exs. 38-40.) Rather than asking TCCC to update its responses to all 16 interrogatories, 71 document requests, and 224 requests for admission that had been served before the suspension, Royal Crown identified for TCCC a limited number of discovery requests for updating, namely:

- Requests for Admission Nos. 50-51, 68, 70-98, 101, 106-113, 124-125 and 132-137;
- Document Requests Nos. 7-9, 12-19, 21-22, 24-27, 30-33, 35-36 and 38; and
- Interrogatories Nos. 8-14.

(*Id.* at ¶ 33 & Ex. 38.)

Notwithstanding having recognized that discovery supplementation was appropriate and necessary, and notwithstanding Royal Crown's requests for TCCC to make good on its promise to supplement, TCCC has failed to provide the requested and promised supplementation. (Popp-Rosenberg Decl. at ¶ 45.)

ARGUMENT

A. **TCCC Must Produce Documents in Response to the Third and Fourth Document Requests**

It is coming up on the third anniversary of Royal Crown's Third and Fourth Document Requests. Despite the long passage of time, TCCC has not served a single responsive document. Not one. Worse, when faced with Royal Crown's repeated requests that TCCC produce the

long-overdue documents, TCCC has misled Royal Crown, continually promising production then continually failing to live up to those promises.

There is simply no excuse for TCCC's nearly three-year delay in responding to Royal Crown's Third and Fourth Document Requests. Nor is there any justification for TCCC intentionally misleading Royal Crown with its repeated promises to produce, and then failure to do so. Therefore, Royal Crown respectfully requests that the Board issue an order compelling TCCC to produce documents in response to Royal Crown's Third and Fourth Document Requests within thirty days of the Board's decision on this Motion to Compel.²

B. TCCC Must Respond to the August 17, 2012 Discovery Requests

There is no reason that TCCC should not be required to respond in full to Royal Crown's August 17 Discovery Requests, consisting of the Fifth Document Request and the Fourth RFAs. TCCC does not dispute that Royal Crown's August 17 Discovery Requests were served within the discovery period set by the Board in the then-operative July 23, 2012 Order. Rather, TCCC theorizes that the Board made a mistake in its July 23 Order – and its earlier July 19 Order – by setting a discovery close date at all. There is absolutely no basis for TCCC's theory.

The Board's July 23 and July 19 Orders were issued after these proceedings had been suspended – first for settlement negotiations and then pending conclusion of a third-party opposition – for more than twenty months. Following such a long suspension, it made sense for the Board to give the parties an opportunity to conduct, complete and update any necessary discovery before the trial period opened. This is particularly true in this case, where, even before the proceedings had entered the lengthy suspension period, the parties had requested and

² Royal Crown reserves all rights in relation to TCCC's objections to the Third and Fourth Document Requests until Royal Crown has had an opportunity to review TCCC's production.

received four successive extensions of dates in the proceeding – totaling 195 days – on the parties’ representations that they had been unable to complete discovery in the time period originally provided. Against this background, the Board’s decision to give the parties additional time for discovery makes perfect sense.

If TCCC honestly believed that the Board’s setting of the August 17, 2012 discovery close date was an error, it had ample time and opportunity to raise the issue, either with the Board or with Royal Crown, well before it served its unfounded objections to the August 17 Discovery Requests on October 12, 2012. TCCC could have raised the issue when the Board first issued the July 19 Order, but it did not. TCCC could have raised the issue when Royal Crown notified TCCC of a real error in the July 19 Order, but it did not. TCCC could have raised the issue when the Board issued the corrective July 23 Order, but it did not. TCCC could have raised the issue during the parties’ August 10, 2012 teleconference to discuss discovery and scheduling issues, but it did not. TCCC could have raised the issue when it received the August 17 Discovery Requests, but it did not. TCCC could have raised the issue during the parties’ August 27, 2012 teleconference to discuss discovery and scheduling issues, but it did not. TCCC could have raised the issue on September 18, 2012, when it requested an extension of its deadline to respond to the August 17 Discovery Requests, but it did not. TCCC could have raised the issue on September 18, 2012 when Royal Crown specifically asked TCCC when it planned to produce documents in response to the August 17 Discovery Requests, but it did not. TCCC could have raised the issue on October 4, 2012 when it requested a second extension of its deadline for responding to the August 17 Discovery Requests, but it did not. Despite these myriad opportunities to voice its alleged concern that the Board had made a mistake in its July 19 and July 23 Orders when it set an August 17, 2012 discovery close date, TCCC remained

silent, only expressing its theory that the Board's July 19 and July 23 Orders were in error for the first time when its time to respond to the August 17 Discovery Requests had finally run out and Royal Crown's trial period was closing in.

There is no question that TCCC withheld its theory that the Board's July 19 and July 23 Orders contained an error until the last possible moment in its continuing effort to avoid its discovery obligations and prejudice Royal Crown's trial preparation. TCCC's deceptive and evasive conduct should neither be tolerated nor condoned. Therefore, Royal Crown respectfully requests that the Board issue an order compelling TCCC to respond in full to Royal Crown's Fifth Document Requests and Fourth RFAs, including by producing all responsive documents, within thirty days of the Board's decision on this Motion to Compel. Further, Royal Crown respectfully requests that the Board order that by failing to respond in substance by the deadline for doing so, TCCC has waived all objections to Fifth Document Requests and Fourth RFAs.

C. TCCC Must Supplement its Discovery Responses

In its order granting Royal Crown's first motion to compel, the Board has already advised TCCC in no uncertain terms that it has a duty to supplement its discovery responses. (Order dated November 13, 2009 at 8-9.) Although TCCC seems now to acknowledge the fact that it has a duty to supplement its discovery responses, particularly in light of the long suspension of these proceedings, it has undertaken no efforts to do so, despite repeated requests from Royal Crown and despite repeated promises from TCCC.

Royal Crown has not requested that TCCC update its response to each and every discovery request served in the course of these proceedings, but instead has identified specific discovery requests for updating, as follows:

- Requests for Admission Nos. 50-51, 68, 70-98, 101, 106-113, 124-125 and 132-137;

- Document Requests Nos. 7-9, 12-19, 21-22, 24-27, 30-33, 35-36 and 38; and
- Interrogatories Nos. 8-14.

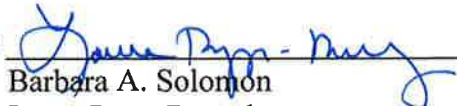
As there can be no debate as to whether TCCC is required to update its responses to the identified discovery requests, and no debate that TCCC has not done so despite being under a duty to do so and despite Royal Crown's request that it do so, Royal Crown respectfully requests that the Board issue an order compelling TCCC to supplement its responses to the above-identified discovery requests within thirty days of the Board's decision on this Motion to Compel.

CONCLUSION

For the reasons stated herein, Royal Crown respectfully requests that the Board enter an order compelling TCCC within thirty days of the Board's decision on this motion to (i) produce documents in response to Royal Crown's Third Document Requests dated January 14, 2010; (ii) produce documents in response to Royal Crown's Fourth Document Requests dated February 23, 2010; (iii) respond in full and without objection, including by producing responsive documents, in response to Royal Crown's Fifth Document Requests dated August 17, 2012; (iv) respond in full and without objection to Royal Crown's Fourth Requests for Admission dated August 17, 2012; and (v) supplement its written responses and document production to Requests for Admission Nos. 50-51, 68, 70-98, 101, 106-113, 124-125 and 132-137, Document Requests Nos. 7-9, 12-19, 21-22, 24-27, 30-33, 35-36 and 38, and Interrogatories Nos. 8-14 by updating its responses thereto.

Dated: New York, New York
November 30, 2012

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

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CERTIFICATE OF SERVICE

I hereby certify that I have caused a true and correct copy of the foregoing Royal Crown Company, Inc.'s Motion to Compel and to Test Sufficiency of Objection to be deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to counsel for Applicant, Bruce Baber, Esq., King & Spalding LLP, 1185 Avenue of the Americas, New York, NY 10036-4003, this 30th day of November, 2012.


Laura Popp-Rosenberg