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

Proceeding	91178927
Party	Defendant The Coca-Cola Company
Correspondence Address	BRUCE W BABER KING SPALDING LLP 1180 PEACHTREE STREET ATLANTA, GA 30309 UNITED STATES bbaber@kslaw.com, ebrown@kslaw.com
Submission	Opposition/Response to Motion
Filer's Name	Bruce W. Baber
Filer's e-mail	bbaber@kslaw.com
Signature	/Bruce W. Baber/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

ROYAL CROWN COMPANY, INC.,	)	
	)	Consolidated Proceedings:
	)	
Opposer,	)	OPPOSITION NO. 91178927
	)	OPPOSITION NO. 91180771
v.	)	OPPOSITION NO. 91180772
	)	OPPOSITION NO. 91183482
	)	OPPOSITION NO. 91185755
THE COCA-COLA COMPANY,	)	OPPOSITION NO. 91186579
	)	OPPOSITION NO. 91189847
	)	OPPOSITION NO. 91190658
Applicant.	)	

-- and --

THE COCA-COLA COMPANY,	)	
	)	
Opposer,	)	
	)	
v.	)	OPPOSITION NO. 91184434
	)	
ROYAL CROWN COMPANY, INC.,	)	
	)	
Applicant.	)	

RESPONSE OF THE COCA-COLA COMPANY
TO ROYAL CROWN'S MOTION TO COMPEL
AND TO TEST SUFFICIENCY OF OBJECTION

The Coca-Cola Company ("TCCC"), by and through its undersigned counsel and in accordance with Rule 2.127 of the Trademark Rules of Practice, files this response to "Royal Crown Company's Motion To Compel And To Test Sufficiency Of Objection"

("RC's Motion to Compel"), filed by Royal Crown Company, Inc. ("RC") on November 30, 2012.

INTRODUCTION

Well prior to the most recent suspension of proceedings herein on June 20, 2011, the discovery period – after having been extended several times by consent of the parties – had closed on April 24, 2010. That close of discovery in April of 2010 was purposeful. The parties had engaged in extensive discovery in the two years prior to that time, and the parties recognized that it was time for these proceedings to move into the testimony phase once certain remaining outstanding discovery issues were addressed. The June 2011 suspension, which was based on other pending proceedings before the Board that have since been resolved (the "Ambev cases"), was itself only the latest in a series of suspensions, the earlier ones of which were based on settlement discussions that were then ongoing between the parties but ultimately proved unsuccessful.

At the time the proceedings were suspended in June 2011, the parties did not request that the discovery period be reopened when the suspension ended. And when the proceedings were resumed in July of this year following the conclusion of the Ambev cases, neither party requested a reopening of discovery. Nor did counsel for either party, during the several conferences between counsel prior to August 17, suggest to the other that the service of any new, additional discovery requests was needed or contemplated.

Although RC's Motion to Compel appears to raise a number of issues, there is only one issue with respect to which the parties need a decision by the Board, namely whether RC's service of additional new discovery requests in August of this year was proper. Once the Board resolves that issue, the parties will be able to complete the remaining discovery that is still outstanding and proceed with these cases. The parties have agreed that both parties will supplement certain of their prior discovery responses and produce any remaining documents that need to be produced. TCCC believes strongly, however, that these final discovery issues should be addressed all at once, and once and for all – and that neither continuing piecemeal discovery nor additional new discovery is warranted.

ARGUMENT AND CITATION OF AUTHORITIES

RC's Motion to Compel raises two separate issues. The first issue is whether TCCC should be ordered to respond to nearly one hundred new written discovery requests (19 document requests and 75 requests for admissions) served by RC, without any prior notice to or discussion with TCCC, on August 17, 2012 – the last day of what RC contends was a "reopened" discovery period. The second is RC's request that TCCC be ordered to produce documents and supplement certain prior responses as TCCC has already agreed to do.

I. RC's August 2012 Discovery Requests

Proceedings in these cases were resumed by the Board in its order dated July 19, 2012 (Dkt. No. 71), the day after the Ambev cases were terminated. That July

19 order contained, as the first entry in the reset schedule going forward, the notation "Discovery Closes" and the date August 17, 2012 – even though the discovery period had closed on April 24, 2010, over a year prior to the June 2011 suspension of these proceedings.[1] *See, e.g.*, Stipulation And Motion To Correct And Extend Schedule, filed May 14, 2010, Dkt. No. 53 (showing that discovery period "Closed on April 24, 2010").

Although there have been numerous extensions of the testimony periods and other scheduling dates in these proceedings that have been granted since April 2010, those extensions have been sought and granted on the premise that the parties would use the additional time to complete outstanding discovery, not initiate new discovery. *See, e.g.,* Joint Motion To Extend Schedule, Dkt. No. 58, filed August 13, 2010 (stating that additional time was needed "to conclude open discovery items"). Although the Board's July 19, 2012 and July 23, 2012 orders resuming proceedings and correcting the schedule herein included a "discovery closes" date of August 17, 2012, neither party had requested a reopening of the discovery period or requested leave to initiate additional discovery. The Board has also not entered any orders that explicitly allow for any such new or additional discovery or that reflect a deliberate decision to reopen the discovery period for any reason.

Perhaps most relevant to the issues presented by RC is the fact that in the motion that gave rise to the suspension, filed in June of 2011, the parties did not ask for any additional period for discovery following resolution of the Ambev cases. To the contrary, the parties asked only that they be afforded "some additional time" following the decision in the Ambev cases so that they could "discuss the implications of the

[1] RC's lengthy discussion of the procedural history of these cases conspicuously omits the fact that the discovery period closed on April 24, 2010.

Board's decision" and "resolve some open discovery and administrative issues that the parties have placed on hold during the time these proceedings have been suspended." Consented Motion For Suspension, filed June 8, 2011, Dkt. No. 68, at 3.

The Board Manual addresses the issue of resumption of proceedings following a suspension. Section 510.03(b), entitled "Resumption," states as follows:

> When resuming proceedings, if the consented motion or stipulation to suspend does not specify otherwise, the Board will generally issue a new trial order beginning with whatever period was running when the consented motion or stipulation to suspend was filed.

Trademark Trial and Appeal Board Manual of Procedure (TBMP), § 510.03(b). While this language appears in a sub-paragraph with the heading "Settlement negotiations," the Manual does not suggest that any different rule applies with respect to a resumption of proceedings following suspension for other reasons.

These cases, moreover, were in fact suspended several times for settlement discussions, beginning in November of 2010. *See* Order dated November 17, 2010, Dkt. No. 63; Order dated January 20, 2011, Dkt. No. 65; Order dated March 30, 2011; Dkt. No. 67. In each case, the order suspending proceedings stated that upon conclusion of the suspension period proceedings would resume "based on the schedule set forth by the parties" in their motion for suspension. And each of the three motions for suspension included schedules that did not include any further period for discovery; all three schedules began with RC's pretrial disclosures in the oppositions in which RC is the party in the position of the plaintiff. *See* Motions for Suspension filed on October 29, 2010 (Dkt. No. 62); January 4, 2011 (Dkt. No. 64); and March 10, 2011 (Dkt. No. 66). Thus, the period that "was running" when these cases were suspended beginning in late 2010 was the period ***after*** the close of discovery and prior to the opening of the

first testimony period, during which the plaintiff is required to serve its pretrial disclosures.

The Board has confirmed the procedure contemplated in section 510.03(b) in a precedential decision that does not limit its applicability to proceedings suspended for settlement:

> If a suspension period granted or approved by the Board expires, the Board, absent a specific request in the consented motion or stipulation to suspend, will resume the proceeding and issue a new trial order, *commencing with whatever period was open when the consented motion or stipulation was filed*.

Instruments SA, Inc. v. ASI Instruments, Inc., 1999 TTAB LEXIS 77, *5 n.6, 53 U.S.P.Q.2d (BNA) 1925 (T.T.A.B. 1999) (emphasis added).

During 2008 through 2010, the parties initiated and took extensive discovery, including interrogatories, document requests, requests for admissions and discovery depositions. During that period, TCCC responded to ***over three hundred*** separate written discovery requests served by RC – 16 interrogatories, 71 document requests, and 224 requests for admissions – and produced thousands of pages of documents, in multiple productions. While a limited number of items remained outstanding when these proceedings were first suspended in November of 2010, substantial discovery had been initiated and completed.

Given the amount and extent of discovery that was taken during the 2008 through 2010 period when discovery was open, there was – and is – no need for further additional discovery now that the proceedings have been resumed. TCCC agrees that the parties should complete the outstanding discovery that they had “placed on hold” since 2010 and that they should both supplement their prior discovery responses as

required, consistent with Rule 26(e) of the Federal Rules; there is no disagreement regarding those issues. But enough is enough in terms of yet additional new discovery requests.

In its motion, RC argues that TCCC should have "raised an objection" to the inclusion of the August 17, 2012 "Discovery Closes" date when the July 19 and July 23 orders were entered, and notes several different occasions on which TCCC could have objected or raised the issue. Although TCCC was aware that the date appeared in the orders, TCCC saw neither a reason nor a need to "raise an objection" or otherwise clarify the issue prior to August 17. Upon receipt of the Board's July orders, the parties commenced and continued discussions in July and August regarding the outstanding discovery issues that needed to be attended to – but at no time during those discussions did RC's counsel suggest or advise TCCC's counsel that RC intended to commence any new or additional discovery. Instead, RC simply waited until the last day and, on Friday, August 17, served on TCCC by mail its 94 new discovery requests. Once RC served the requests without notice, it made clear that it did not share TCCC's view and instead had decided to proceed with its last-minute ambush.[2]

Consistent with the above, TCCC therefore objected to RC's new discovery requests and served its formal written objections under Rules 34 and 36 on October 12, 2012. *See* Exhibit A and B attached hereto. In those responses, TCCC objected to the requests as untimely, but stated that it was willing to "discuss in good faith with RC's counsel whether TCCC is willing to provide to RC certain additional documents and/or information relating to the matters that are the subject of RC's [new requests], to the

[2] As RC notes, TCCC has offered to produce some documents that would be responsive to RC's August document requests as part of a compromise resolution of these issues – but RC has rejected TCCC's compromise and has insisted on full, formal responses to all 94 of the new requests.

extent those matters raise issues that are new, are material and were not covered by prior discovery requests."

Although the parties conferred further and TCCC proposed a compromise to RC that would have enabled the parties to resolve the issue without a Board ruling, RC refused and insisted that TCCC should be required to respond to yet another one hundred discovery requests, at least some of which could have been served in 2010 or earlier. Indeed, RC did not respond to TCCC's proposal, made on October 24, 2012, for nearly a month – at which time RC indicated that it intended to proceed by way of a motion rather than continue the parties' attempts to resolve the outstanding issues by agreement.[3] The parties' attempts to continue their discussions prior to RC filing its motion were unsuccessful, at least in part due to the unavailability of RC's counsel. Prior to that time, however, the parties were engaged in productive discussions that would have included resolving all open issues and arranging for final document production and supplementation of responses by both parties.

For the foregoing reasons, TCCC believes that any "reopening" of the discovery period in these cases (if intended) was improper and inconsistent with the Board's Manual and precedent, and that RC's eleventh-and-a-half hour Friday night mail service of eight dozen additional discovery requests was untimely. TCCC therefore requests that the Board sustain TCCC's objections to RC's Fifth Set of Document Requests and

[3] TCCC understands that a portion of the delay in RC responding was due to effects from Hurricane Sandy, which occurred several days after TCCC made its proposal – and TCCC does not contest or question any delay caused by that disruption.

Fourth Set of Requests for Admissions, and deny RC's motion to the extent it seeks to compel responses to those requests.[4]

II. The Parties' Supplementation And Other Outstanding Discovery Issues

Notwithstanding RC's unnecessary rhetoric regarding alleged "subterfuge," and "deceptive and evasive conduct," the fact is that the parties have productively discussed and agreed to supplementation – by both sides – of certain prior discovery responses, consistent with both the provisions of Rule 26(e) and the need for updating due to the passage of time. TCCC has not yet produced to RC portions of the supplementation and other outstanding documentation that has been agreed to for one reason, which TCCC has made clear to RC. TCCC wishes to complete all of the remaining discovery (including any needed searching for and production of additional documents) once, rather than drag the process out piecemeal.

RC's complaints about documents that have not been produced are therefore unfounded. While TCCC has not yet produced documents in response to some of RC's document requests that were served in 2010, proceedings in these matters were suspended for a very long time – from late 2010 until July of this year – and RC has acknowledged that those requests were "placed on hold" by the parties during that extended time. TCCC has confirmed to RC that TCCC will include any documents

[4] The Board should also deny RC's request that, if TCCC is required to respond to RC's newest discovery requests, TCCC should be precluded from making any objections thereto. Such a request is improper. TCCC has the right to test whether the requests were timely before addressing the individual requests one by one, and a number of the individual requests relate to irrelevant matters, such as marks that are not at issue in these cases. *See* TBMP §§ 414(9), 414(11).

responsive to those requests in TCCC's final document production when it is made.[5] TCCC has also made clear to RC, however, that, before it does so, TCCC has a right to know the precise scope of the documents it needs to complete searching for and produce, including whether it will be required to respond to RC's new, August 2012 requests.

TCCC believes that it would also be improper for the Board, through an order, to require TCCC to provide any supplementation beyond that required by Rule 26(e). Both TCCC and RC have voluntarily agreed to supplement their prior responses in some respects that are not required by Rule 26(e), although the parties have not finally agreed on all of the details of the supplementation to be made by each party. The parties are, however, close to resolution of those issues and TCCC expects that they will be resolved by agreement. And, like TCCC, RC has not yet provided the supplementation that it agreed it would provide.

TCCC therefore requests that the Board, consistent with its November 13, 2009 order in these proceedings, provide that each party must supplement its prior discovery responses to the extent required by Rule 26(e) within thirty days of the Board's order ruling on RC's Motion to Compel. Such a result is consistent with the Rules and would apply equally to both parties.

[5] TCCC has also identified to RC certain of the document requests to which TCCC has determined that it has no responsive documents.

CONCLUSION

For the foregoing reasons, TCCC respectfully prays that RC's Motion to Compel be denied, and that both parties be required to produce any remaining documents and supplement their prior discovery responses, as required by Rule 26(e), within thirty days of the Board's order.

Respectfully submitted, this 20th day of December, 2012.

KING & SPALDING LLP

/Bruce W. Baber/
Bruce W. Baber

1180 Peachtree Street
Atlanta, Georgia 30309
Telephone: 404-572-4600
Facsimile: 404-572-5134

Attorneys for Applicant and Opposer
THE COCA-COLA COMPANY

EXHIBIT A

EXHIBIT B

CERTIFICATE OF SERVICE

This is to certify that I have this day served the foregoing Response Of The Coca-Cola Company To Royal Crown's Motion To Compel And To Test Sufficiency Of Objection in the above-captioned matter upon Royal Crown Company, Inc., by causing a true and correct copy thereof to be deposited in the United States Mail, postage prepaid, addressed to counsel of record for Royal Crown Company, Inc. as follows:

Ms. Barbara A. Solomon
Ms. Laura Popp-Rosenberg
Fross Zelnick Lehrman & Zissu, P.C.
866 United Nations Plaza
New York, New York 10017

This 20th day of December, 2012.

/Bruce W. Baber/
Bruce W. Baber