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Filing date: **05/12/2010**

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

Proceeding	91189287
Party	Defendant Timothy Whitehurst
Correspondence Address	Robert L. Powley Powley & Gibson, P.C. 304 Hudson St., 2nd fl. New York, NY 10013 UNITED STATES Trademarks@powleygibson.com
Submission	Motion for Sanctions
Filer's Name	Michelle K. Riley, NY State Bar Member
Filer's e-mail	trademarks@powleygibson.com
Signature	/mkr/
Date	05/12/2010
Attachments	Applicant's motion for dismissal.pdf ( 8 pages )(378976 bytes ) Declaration.pdf ( 6 pages )(197890 bytes ) ex 1.pdf ( 22 pages )(662453 bytes ) ex 2.pdf ( 6 pages )(242057 bytes ) Ex 3.pdf ( 32 pages )(1365490 bytes ) Exhibits 4-6.pdf ( 16 pages )(475061 bytes )

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

-----X	:		
TechSmith Corporation,	:		
	:		
Opposer,	:		
	:	Opposition No:	91189287
v.	:	Serial No.:	77/505306
	:	Mark:	SNAG-IT
Timothy Whitehurst,	:	International Class:	28
	:	Published:	November 18, 2008
Applicant.	:		
-----X	:		

Box TTAB  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

**APPLICANT'S MOTION FOR DISMISSAL**

Pursuant to 37 CFR § 2.120(g)(1), TMBP § 527.01(a), and Rule 37(b)(2)(A)(vi) of the Federal Rules of Civil Procedure, Timothy Whitehurst ("Applicant"), by his attorneys, Powley & Gibson, P.C., respectfully requests that the Trademark Trial and Appeal Board ("TTAB") dismiss the above-captioned Opposition proceedings with prejudice against TechSmith Corporation ("Opposer") as per the TTAB's direction in its Order dated March 31, 2010 by entering a default judgment against Opposer.

Opposer commenced the above-captioned Opposition on March 18, 2009. Applicant served its First Set of Interrogatories, First Request for the Production of Documents and Things, and First Set of Requests for Admission on Opposer on September 4, 2009 and Opposer's responses were due on October 9, 2009. Opposer responded to the Requests for Admission but failed to respond to Applicant's Document Requests or Interrogatories and Document Requests. Rather, Opposer filed a Combined Motion and Brief for Request for Suspension and Extension

of Time to Respond to Applicant's Written Discovery Requests on October 9, 2009, alleging that the parties were partaking in settlement discussions, which was false. The TTAB granted Opposer until December 21, 2009 to respond to Applicant's Interrogatories and Document Requests and to properly respond to the Requests for Admission. On that date, Opposer provided responses to Applicant's discovery requests which were deficient in numerous respects. Applicant timely filed a Motion to Compel and to Extend Discovery on February 10, 2010 and Opposer failed to respond to Applicant's Motion. On March 31, 2010, the TTAB granted Applicant's Motion to Compel and to Extend Discovery, and ordered Opposer to serve Applicant with complete responses to the outstanding Interrogatories and Document Requests, without objection, within thirty days from the date of the Order. The TTAB directed that if Opposer failed to comply with its Order, Applicant was free to file a Motion for the entry of involuntary dismissal under Trademark Rule 2.120(g)(1). Opposer failed to provide Applicant with any responses to the outstanding Interrogatories and Document Requests, nor has Opposer contacted Applicant regarding discovery at any time since the TTAB's Order. As a result, Applicant will be prejudiced in defending the Opposition should the Opposition proceed.

#### I. PROCEDURAL BACKGROUND

Applicant served discovery requests on Opposer on September 4, 2009. (Riley Declaration ("Riley Decl.") ¶2, Exhibit 1). Opposer responded solely to Applicant's Request for Admissions. The responses to the Requests for Admissions were incomplete and unintelligible. (Riley Decl. ¶3, Exhibit 2). On October 9, 2009 Opposer filed of a Combined Motion and Brief for Request for Suspension and Extension of Time to Respond to Applicant's Written Discovery Requests, alleging that the parties were partaking in settlement discussions, which was false. (Riley Decl. ¶4). Applicant filed a Motion in Opposition on October 23, 2009 (Riley Decl. ¶5).

The TTAB granted Opposer until December 21, 2009 to respond to Applicant's Interrogatories and Document Requests and to properly respond to the Requests for Admission. (Riley Decl. ¶6). Opposer responded to Applicant's First Set of Interrogatories and Applicant's First Request for Production of Documents and Things on December 21, 2009, but many of Opposer's responses to Applicant's discovery requests were improper and/or unintelligible. (Riley Decl. ¶7, Exhibit 3). On January 15, 2010, Applicant's counsel sent a letter to Opposer, outlining Opposer's deficiencies in its discovery responses. (Riley Decl. ¶8, Exhibit 4). Applicant made numerous attempts to contact Opposer's counsel regarding Opposer's insufficient discovery responses but did not receive a response. (Riley Decl. ¶9-¶15). Having not heard from Opposer regarding the insufficient discovery responses, Applicant filed a Motion to Compel and to Extend Discovery on February 10, 2010. (Riley Decl. ¶16, Exhibit 5). Opposer failed to respond to Applicant's Motion, and on March 31, 2010, the TTAB granted Applicant's Motion to Compel and to Extend Discovery, and ordered Opposer to serve Applicant with complete responses to the outstanding Interrogatories and Document Requests, without objection, within thirty days from the date of the Order. (Riley Decl. ¶17, Exhibit 6). Opposer failed to provide Applicant with any responses to the outstanding Interrogatories and Document Requests by the deadline imposed by the TTAB, and as of the date of this filing has still failed to provide Applicant with any proper discovery responses. (Riley Decl. ¶18). Applicant has not received any communications from Opposer regarding the Opposer's discovery responses since the TTAB issued its March 31, 2010 Order. (Riley Decl. ¶18). The TTAB indicated that Applicant should file a Motion for Dismissal in these circumstances.

## II. ARGUMENT

Opposer's utter failure to comply with the TTAB's Order to produce complete responses to the outstanding Interrogatories and Document Requests, along with Opposer's pattern of dilatory conduct in the proceedings as a whole, have prejudiced Applicant's ability to properly defend Applicant's rights in this proceeding. In its Order dated March 31, 2010, the TTAB recommended "[i]f Opposer fails to comply with this order, applicant is free to file a motion for the entry of involuntary dismissal under Trademark Rule 2.120(g)(1)." 37 C.F.R. § 2.120(g)(1) states "[i]f a party fails to comply with an order of the Trademark Trial and Appeal Board relating to discovery, including a protective order, the Board may make any appropriate order, including any of the orders provided in Rule 37(b)(2) of the Federal Rules of Civil Procedure...". F.R.C.P. 37(b)(2)(A) delineates the appropriate sanctions for failure to comply with a Discovery Order. Specifically, F.R.C.P. 37(b)(2)(A)(vi) allows a court to issue orders "rendering a default judgment against the disobedient party." In appropriate situations, the TTAB may issue sanctions, including the entry of default judgment against a party. *See Ingalls Shipbuilding, Inc. v. United States*, 857 F.2d 1448, 1451 (Fed. Cir. 1988) ("the decision whether to impose discovery sanctions rests within the sound discretion of the trial court"); *see MHW, Ltd. and PepsiCo, Inc. v. Simex, Aussenhandelsgesellschaft Savelsberg KG* 2000 TTAB LEXIS 717, \*2-\*4 (TTAB 2000) (TTAB granted the applicant's motion for default judgment after opposers were two days late in serving responses to the first request for production of documents and things and three days late in serving responses to the first set of interrogatories); *and see Baron Philippe de Rothschild, S.A. and Societe Civile de Chateau Lafite-Rothschild v. Styl-Rite Optical Mfg. Co.*, 2000 TTAB LEXIS 467; 55 U.S.P.Q.2D (BNA) 1848 (TTAB 2000) (TTAB granted opposer's

Motion for Sanctions in the form of entry of judgment against the applicant after applicant failed to comply with TTAB Order relating to discovery).

Here, Opposer's complete lack of a response to the TTAB's Order of March 31, 2010 clearly demonstrates an intent to delay the proceedings, a tactic which the TTAB considers when granting a Motion for sanctions for failure to comply with a Discovery Order. *See MHW, Ltd. and PepsiCo. Inc.* 2000 TTAB LEXIS 717 at \*6. ("We agree with applicant that the responses and supplements to responses served on applicant demonstrate opposers' intent to continue to delay this proceeding by setting up obstacles to applicant's receipt of clearly relevant information."). Opposer's responses to Applicant's First Set of Interrogatories and Applicant's First Requests for the Production of Documents and Things were due on October 9, 2009. The TTAB granted Opposer's Motion for Request for Suspension and Extension of Time to Respond to Applicant's written Discovery Requests, giving Opposer until December 21, 2009 to respond. Opposer failed to produce any documents and provided utterly deficient answers to Applicant's Interrogatories. In response to Applicant's Motion to Compel, Opposer was given until April 30, 2010 to serve complete responses to the outstanding Interrogatories and Document Requests. Again, Opposer failed to comply with the TTAB's order. Over six months after its discovery responses were due, Opposer still has not provided Applicant with sufficient discovery responses or even contacted Applicant regarding the same.

In addition to causing delay, Opposer has also cost Applicant significant expense in protecting Applicant's rights in the Opposition proceedings, another factor that influences the TTAB when deciding motions for sanctions. *See Baron Philippe de Rothschild, S.A.* 2000 TTAB LEXIS 467 at \*19. (TTAB agreed with the opposer that the "history of delays and dilatory tactics have increased the costs to opposers, requiring them to respond to numerous

motions, as well as resulting in prejudice to opposers because of the increased overall delay to the proceedings.”). Here, Applicant was compelled to file a Motion in Opposition to Opposer’s Combined Motion and Brief for Request for Suspension and Extension of Time to Respond to Applicant’s Written Discovery Requests in October of 2009. In January of 2009, Applicant also incurred expenses in writing a letter to Opposer outlining the deficiencies in Opposer’s responses to Applicant’s discovery requests and the TTAB’s Order dated November 20, 2009. After Opposer failed to properly respond to the deficiency letter and Applicant’s multiple inquiries regarding the same, Applicant was again forced to file a Motion to Compel and to Extend Discovery in order to protect Applicant’s rights. Last but not least, Applicant has had to file this present Motion for Dismissal as a result of Opposer’s repeated failure to comply with Applicant’s discovery requests. In total, Opposer’s delays and lack of responsiveness have cost Applicant thousands of dollars in protecting its rights in these proceedings.

Opposer has not offered a scintilla of evidence why it cannot and has not complied with the TTAB’s Order. Opposer’s complete failure to proceed in this Opposition has further frustrated Applicant’s attempts to proceed. Finally, Opposer’s failure to comply with the TTAB’s Order dated March 31, 2010 warrants dismissal of this Opposition, with prejudice.

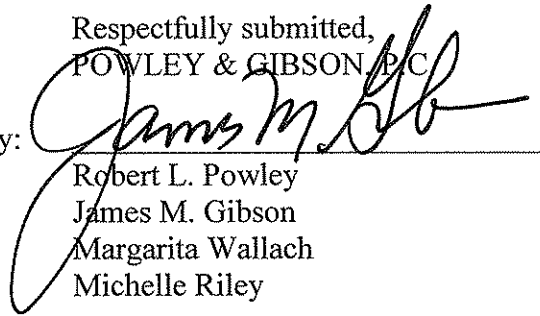
### **CONCLUSION**

Based on the foregoing, Applicant respectfully requests that that the Trademark Trial and Appeal Board (“TTAB”) dismiss the above-captioned Opposition proceedings with prejudice by rendering a default judgment against TechSmith Corporation (“Opposer”), pursuant to 37 CFR § 2.120(g)(1), TMBP § 527.01(a), and Rule 37(b)(2)(A)(vi) of the Federal Rules of Civil Procedure.

Dated: May 12, 2010  
New York, New York

Respectfully submitted,  
POWLEY & GIBSON, P.C.

By:

A large, stylized handwritten signature in black ink, appearing to read "James M. Gibson", is written over a horizontal line. The signature is written in a cursive style with a large initial "J".

Robert L. Powley  
James M. Gibson  
Margarita Wallach  
Michelle Riley

304 Hudson St., 2<sup>nd</sup> Fl.  
New York, NY 10013  
(212) 226-5054 (phone)  
(212) 226-5085 (fax)

*Attorneys for Applicant Timothy Whitehurst*



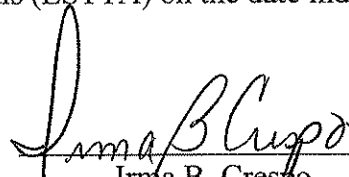
**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of Applicant's Motion for Dismissal was served by priority mail, postage prepaid, on May 12, 2010, upon the following:

James R. Duby, Jr.  
Duby & Associates, PLC  
3511 Coolidge Road, Suite 200  
East Lansing, MI 48823  
(517) 371-9835

ATTORNEY FOR OPPOSER

The undersigned also certifies that Applicant's Motion for Dismissal is being transmitted to the United States Patent and Trademark Office Trademark Trial and Appeal Board using the Electronic System for Trademark Trials and Appeals (ESTTA) on the date indicated above.

  
\_\_\_\_\_  
Irma B. Crespo

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

-----X	:		
TechSmith Corporation,	:		
	:		
Opposer,	:		
	:	Opposition No:	91189287
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	:	Mark:	SNAG-IT
Timothy Whitehurst,	:	International Class:	28
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Applicant.	:		
-----X	:		

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**DECLARATION OF MICHELLE K. RILEY  
IN SUPPORT OF APPLICANT'S MOTION FOR DISMISSAL**

Michelle K. Riley declares the following to be true under the penalties of perjury:

1. I am a member in good standing of the bar of the State of New York. I am authorized to act on behalf of Applicant. I have first-hand knowledge of the facts herein and submit this declaration in support of Applicant's Motion for Dismissal.
2. Applicant served his First Set of Interrogatories, First Request for Production of Documents and Things, and First Set of Requests for Admissions on Opposer on September 4, 2009. See Exhibit 1.

3. Opposer responded to Applicant's Request for Admissions on October 2, 2009. The responses were incomplete and unintelligible. See Exhibit 2.
4. Opposer filed of a Combined Motion and Brief for Request for Suspension and Extension of Time to Respond to Applicant's Written Discovery Requests on October 9, 2009, alleging that the parties were partaking in settlement discussions, which was false.
5. Applicant filed a Motion in Opposition on October 23, 2009.
6. The TTAB granted Opposer until December 21, 2009 to respond to Applicant's Interrogatories and Document Requests and to properly respond to the Requests for Admission.
7. Opposer responded to Applicant's First Set of Interrogatories and Applicant's First Request for Production of Documents and Things on December 21, 2009 but many of Opposer's responses to Applicant's discovery requests were improper and/or unintelligible. See Exhibit 3.
8. On January 15, 2010, Applicant's attorneys sent a letter to counsel for Opposer, James Duby, outlining Opposer's deficiencies in its discovery responses. See Exhibit 4.

9. On January 20, 2010, and January 21, 2010, I left voicemail messages with Mr. Duby and I sent an email to Mr. Duby requesting that the parties have a conversation to discuss document production.
10. Mr. Duby responded on January 21, 2010 that he would be contacting us shortly.
11. Having had no further response from Mr. Duby, I sent an email on January 26, 2010, regarding the exchange of discovery documents between the parties.
12. On January 28, 2010, I received an email from Mr. Duby in which he stated that he was “in the process of reviewing the contentions contained in [Applicant’s counsel’s] recent letter,” and attaching the same proposed coexistence agreement which was previously rejected by Applicant (with revisions solely to the dates referenced in the agreement) and requesting that Applicant execute the same or forward proposed revisions to the agreement. On the same date, an attorney for Applicant left a voicemail message with Mr. Duby advising that Applicant was not interested at this time in talking settlement and that he wished to discuss proper discovery responses and the production of documents.
13. Having received no reply, I sent an email to Mr. Duby on January 29, 2010, reminding him that Applicant had rejected the proposed Coexistence Agreement, and that the parties were not currently in settlement negotiations, and requesting that Opposer provide Applicant with Opposer’s discovery responses, and that Mr. Duby call to discuss any other discovery issues.

14. I emailed Mr. Duby again on February 1, 2010 and February 2, 2010 requesting that the parties discuss discovery, but received no response.
15. On February 3, 2010, I emailed Mr. Duby and requested Opposer's consent to file a Motion to Extend Discovery, and did not receive a response.
16. Having not heard from Opposer regarding the insufficient discovery responses, Applicant filed a Motion to Compel and to Extend Discovery on February 10, 2010. See Exhibit 5.
17. Opposer failed to respond to Applicant's Motion, and on March 31, 2010, the TTAB granted Applicant's Motion to Compel and to Extend Discovery, and ordered Opposer to serve Applicant with complete responses to the outstanding Interrogatories and Document Requests, without objection, within thirty days from the date of the Order. See Exhibit 6.
18. Opposer failed to provide Applicant with any responses to the outstanding Interrogatories and Document Requests by the deadline imposed by the TTAB, and as of the date of this filing has still failed to provide Applicant with any proper discovery responses.
19. I have not received any communications from Opposer regarding the Opposer's discovery responses since the TTAB issued its March 31, 2010 Order.

Dated: May 12, 2010  
New York, New York

*Michelle Riley*  
\_\_\_\_\_  
Michelle Riley

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the Declaration of Michelle K. Riley in Support of Applicant's Motion for Dismissal was served by priority mail, postage prepaid, on May 12, 2010, upon the following:

James R. Duby, Jr.  
Duby & Associates, PLC  
3511 Coolidge Road, Suite 200  
East Lansing, MI 48823  
(517) 371-9835

ATTORNEY FOR OPPOSER

The undersigned also certifies that the Declaration of Michelle K. Riley in Support of Applicant's Motion for Dismissal is being transmitted to the United States Patent and Trademark Office Trademark Trial and Appeal Board using the Electronic System for Trademark Trials and Appeals (ESTTA) on the date indicated above.

  
Irma B. Crespo

# EXHIBIT 1



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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-----X			
TechSmith Corporation,	:		
	:		
Opposer,	:		
	:		
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**APPLICANT'S FIRST SET OF INTERROGATORIES TO OPPOSER**

Pursuant to Rules 26 and 33 of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice, Applicant Timothy Whitehurst ("Applicant") hereby requests that Opposer Techsmith Corporation ("Opposer") by an officer or agent thereof, answer under oath and in writing the following interrogatories within thirty (30) days following service hereof.

### **Definitions and Instructions**

1. Applicant hereby incorporates, where appropriate, the Definitions and Instructions set forth in Applicant's First Request for Production of Documents and Things to Opposer, served contemporaneously herewith.

2. In each instance where an Interrogatory is answered on information and belief, Opposer shall set forth the entire basis for such information and belief.

3. In each instance where Opposer denies knowledge or information sufficient to answer the Interrogatory, Opposer shall set forth the name and address of each person, if any, known to have such knowledge.

### **INTERROGATORIES**

1. Identify all present and former officers, directors, and/or managers of Opposer and all other persons having responsibility for marketing, advertising, and promotion for any goods or services offered for sale or sold under Opposer's SNAGIT Trademark.

2. Describe in detail the facts relating to, and identify the persons primarily involved in, Opposer's selection, adoption, and use of Opposer's SNAGIT Trademark, including the date on which Opposer first decided to adopt the mark, and the circumstances and method by which the mark was selected, created, adopted, and first used.

3. Identify the person or persons employed by Opposer most knowledgeable about the sales, advertising and promotion of products and/or provision of services under Opposer's SNAGIT Trademark, by Opposer and/or its licensees.

4. Identify the person or persons employed by Opposer knowledgeable about any and all agreements, licenses, contracts or other arrangements between Opposer and any third-party that refer or relate to the use of the Opposer's SNAGIT Trademark.

5. State the exact date of first use by Opposer and/or Opposer's licensees of the Opposer's SNAGIT Trademark, describe in detail the circumstances surrounding first use, including the identity of each person who was a party thereto, and describe in detail the exact dates for any periods of non-use between the date of first use and Opposer's filing of this Opposition.

6. State the date and detailed circumstances under which the Opposer first became aware of Applicant.

7. State the gross revenue of the Opposer for sales of all goods utilizing the Opposer's SNAGIT Trademark and identify each document that sets forth or from which may be determined the annual income derived by Opposer from the sale of such goods.

8. Identify each and every mode of advertising whereby the Opposer's goods utilizing the Opposer's SNAGIT Trademark are advertised including, but not limited to, how said goods are advertised, the geographic area(s) within which said goods are advertised, and the medium(s) in which said goods are advertised.

9. Identify the channels of trade through which the Opposer's goods utilizing Opposer's SNAGIT Trademark travel, including but not limited to, the types of stores, catalogs or Internet sites where said goods may be ordered and/or purchased, and intended users of said goods.

10. State whether Opposer's rights in Opposer's SNAGIT Trademark were or have been acquired from another person, whether by assignment, license, operation of law, or other transfer, express or implied, stating the precise rights acquired by Opposer from each such person, the date(s) on which Opposer acquired such rights, and identifying any relevant documents relating to such acquisition of rights and the means whereby such acquisition of rights was accomplished.

11. With respect to Opposer's SNAGIT Trademark:

(a) State the earliest date(s) of the development, creation, design,

adoption, and use of the mark;

(b) Identify the person(s) primarily responsible for the development, creation, design, adoption, and use of the mark, and for each person identify and describe in detail that person's specific involvement;

(c) Identify all persons involved in or who participated in the development, creation, design, adoption and use of the mark, or who have knowledge of facts concerning the same, and for each person identify and describe in detail that person(s) specific involvement; and

(d) Identify all documents concerning, reflecting, or referring to (i) development, creation, design, and modification of the mark, and (ii) the adoption and use of the mark.

12. State the entire factual basis for, and identify the person or persons employed by Opposer most knowledgeable about the allegations in Paragraph 1 of the Notice of Opposition that "TechSmith is a world-famous developer and provider of screen capture and recording software and services for individual and professional use."

13. State the entire factual basis for, and identify the person or persons employed by Opposer most knowledgeable about the allegations in Paragraph 2 that Opposer's SNAGIT Mark is "world famous."

14. State the entire factual basis for, and identify the person or persons employed by Opposer most knowledgeable about the allegations in Paragraph 2 that "TechSmith is also the owner of several other foreign registrations of its world famous mark SNAGIT."

15. State the entire factual basis for, and identify the person or persons employed by Opposer most knowledgeable about the allegations in Paragraph 5 that "As a result of the experience, care and quality of TechSmith in providing its goods under its world famous mark

SNAGIT, TechSmith has become identified as a source of the goods and/or services to which the mark is applied and has acquired a reputation of excellence.”

16. State the entire factual basis for, and identify the person or persons employed by Opposer most knowledgeable about the allegations in Paragraph 9 that “Upon information and belief, the Applicant filed its application for the essentially identical mark SNAG-IT long after TechSmith obtained trademark rights in its world famous mark SNAGIT.”

17. State the entire factual basis for, and identify the person or persons employed by Opposer most knowledgeable about the allegations in Paragraph 10 that “the goods identified in Applicant’s essentially identical SNAG-IT mark are confusingly similar to the goods and/or services offered under TechSmith’s SNAGIT mark.”

18. State the entire factual basis for, and identify the person or persons employed by Opposer most knowledgeable about the allegations in Paragraph 15 that “Applicant’s use of the essentially identical mark SNAG-IT is likely to cause, and will cause, dilution of the distinctive value of the TechSmith mark SNAGIT under Section 439(c) of the Lanham Act of 1946, as amended, 15 USC §1125(c).”

19. Describe Opposer’s efforts in, and identify the person or persons employed by Opposer most knowledgeable about, policing of the marketplace for any third-party uses of the Opposer’s SNAGIT Trademark, and identify all documents and things referring or relating to such policing.

20. With regard to each allegation in the Notice of Opposition that Opposer will be injured or damaged by the registration and/or use of the mark shown in Application Serial Number 77/505306 by Applicant:

- (a) describe separately and in detail how the registration and/or use of the mark in Application Serial No. 77/505306 will cause such

injury or damage;

- (b) identify the person most knowledgeable about such alleged injury or damage; and
- (c) identify all documents and things referring or relating to such alleged injury or damage.

21. Identify all documents Opposer expects to introduce into evidence at the trial of this matter and the person(s) in custody, possession, or control of each such document.

22. Identify all persons whom Opposer intend to call as a witness (fact or expert) during Opposer's testimony period, and briefly describe the subject of each witness' anticipated testimony.

Dated: New York, New York  
September 4, 2009

Respectfully submitted,  
POWLEY & GIBSON, P.C.

By: 

Robert L. Powley  
James M. Gibson  
David J. Lorenz  
Jason H. Kasner

304 Hudson St., 2<sup>nd</sup> Fl.  
New York, NY 10013  
(212) 226-5054 (phone)  
(212) 226-5085 (fax)

*Attorneys for Applicant Timothy Whitehurst*

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing Applicant's First Set of Interrogatories to Opposer was served by first-class mail, postage prepaid, on September 4, 2009, upon the following:

James R. Duby, Jr.  
Duby & Associates, PLC  
3511 Coolidge Road, Suite 200  
East Lansing, MI 48823  
(517) 371-9835

ATTORNEYS FOR OPPOSER

A handwritten signature in cursive script, reading "Irma Crespo", is written over a horizontal line.

Irma Crespo

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**APPLICANT'S FIRST REQUEST FOR  
PRODUCTION OF DOCUMENTS AND THINGS**

Pursuant to Rule 34 of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice, Applicant Timothy Whitehurst ("Applicant") hereby requests that Opposer Techsmith Corporation ("Opposer") produce the documents and things requested below for inspection and copying at the offices of Powley & Gibson, P.C., 304 Hudson Street, Second Floor, New York, New York 10013, or at such other place as agreed to by the parties within thirty (30) days from the date of service. This request shall be deemed continuing to the fullest extent permitted by the Rules and requires production of any documents called for herein, of any such documents which shall come within the custody or control of Opposer, or its agents or



representatives at any time between Opposer's initial production and the further prosecution of this action.

### DEFINITIONS AND INSTRUCTIONS

A. The full text of the definitions and rules of construction set forth in paragraphs (C) and (D) is deemed incorporated by reference into all discovery requests. No

discovery request shall use broader definitions or rules of construction than those set forth in paragraphs (C) and (D). This rule shall not preclude (a) the definition of other terms specific to the particular litigation, (b) the use of abbreviations, or (c) a more narrow definition of a term defined in paragraph (C).

B. This rule is not intended to broaden or narrow the scope of discovery permitted by the Federal Rules of Civil Procedure.

C. The following definitions apply to all discovery requests:

- (1) **Communication.** The term "communication" means the transmittal of information (in the form of facts, ideas, inquiries or otherwise).
- (2) **Document.** The term "document" is defined to be synonymous in meaning and equal in scope to the usage of this term in Federal Rule of Civil Procedure 34(a), including, without limitation, electronic or computerized data compilations, all originals, copies and drafts of any written, typewritten, recorded, transcribed, printed, taped, photographic, or graphic matter, however produced or reproduced, whether sent or

received, including, but not limited to, all books, pamphlets, articles, newspapers, press releases, magazines, booklets, circulars, handbooks, manuals, periodicals, letters, memoranda, files, envelopes, notices, instructions, reports, financial reports, records, studies, transcripts, diaries, formal, informal, audited and unaudited financial statements, working papers, notes, notations, charts, lists, comparisons, telegrams, cables, telex messages, email, electronically stored data, communications (including reports, notes, notations, and memoranda of, or relating to, telephone conversations and conferences, minutes, transcriptions, correspondence), offering circulars, graphs, tabulations, analyses, evaluations, projections, statements, summaries, desk calendars, appointment books, telephone logs, questionnaires, surveys, indices, tapes, computer inputs or outputs, microfilms, magnetic tapes and disks and photographs within the possession, custody of, or under the control of Defendant. Different versions of the same documents, handwritten notes or notations in any form, drafts of documents and documents with handwritten notations or marks not found in the original or on other copies are different documents. A draft or non-identical copy is a separate document within the meaning of this term.

- (3) **Identify (with respect to persons).** When referring to a person, “to identify” means to give, to the extent known, the person’s full name, present or last known address, and when referring to a natural person, additionally, the present or last known place of employment. Once a

person has been identified in accordance with this subparagraph, only the name of that person need be listed in response to subsequent discovery requesting the identification of that person.

- (4) **Identify (with respect to documents).** When referring to documents, “to identify” means to give, to the extent known, the (i) type of document; (ii) general subject matter; (iii) date of the document; and (iv) author(s), addressee(s) and recipients(s).
- (5) **Person.** The term “person” is defined as any natural person or any business, legal or governmental entity or association.
- (6) **Concerning.** The term “concerning” means relating to, referring to, describing, evidencing or constituting.

D. The following rules of construction apply to all discovery requests:

- (1) **All/Each.** The terms “all” and “each” shall be construed as all and each.
- (2) **And/Or.** The connectives “and” and “or” shall be construed either disjunctively or conjunctively as necessary to bring within the scope of the discovery request all responses that might otherwise be construed to be outside of its scope.
- (3) **Number.** The use of the singular form of any word includes the plural and vice versa.

E. In responding to the following requests, Opposer is to produce any electronically stored information in native format, with an accompanying load file compatible with Summation, which shall facilitate the use of the produced images.

### **REQUESTS FOR DOCUMENTS AND THINGS**

#### **REQUEST NO. 1:**

All documents and tangible things identified by Opposer in response to Applicant's First Set of Interrogatories to Opposer or otherwise used, relied upon or referred to by Opposer in answering Applicant's First Set of Interrogatories to Opposer.

#### **REQUEST NO. 2:**

A representative sample of each product, label, package, container, product insert or other specimen bearing Opposer's SNAGIT Mark for each type of product in connection with which Opposer's SNAGIT Mark is used.

#### **REQUEST NO. 3:**

Documents sufficient to show Opposer's first use of Opposer's SNAGIT Mark for each good or service in connection with which Opposer's SNAGIT Mark has been used.

#### **REQUEST NO. 4:**

Documents sufficient to show Opposer's continuous use of Opposer's SNAGIT Mark from Opposer's claimed date of first use to the present in connection with board games.

#### **REQUEST NO. 5:**

All documents concerning the class or type of purchasers of products sold under Opposer's SNAGIT Mark.

**REQUEST NO. 6:**

All documents concerning the channels of trade for products sold under Opposer's SNAGIT Mark.

**REQUEST NO. 7:**

All documents concerning the marketing, sale, distribution, advertising or promotion by Opposer of Opposer's SNAGIT Mark.

**REQUEST NO. 8:**

All documents that record, summarize or otherwise refer to advertising or promotional expenditures, including actual, projected and budgeted expenditures, by or for Opposer for Opposer's SNAGIT Mark.

**REQUEST NO. 9:**

Copies of all publicity and/or media coverage, whether solicited or unsolicited, concerning products sold under Opposer's SNAGIT Mark, including press releases and articles of any kind.

**REQUEST NO. 10:**

All documents concerning any market research, survey, analysis or investigation, including but not limited to individual questionnaires, pilot studies and focus groups, that disclose or indicate in any way recognition or awareness of Opposer's SNAGIT Mark by purchasers, customers and/or the trade.

**REQUEST NO. 11:**

All documents concerning the creation, design, selection, approval, adoption, display or use of Opposer's SNAGIT Mark.

**REQUEST NO. 12:**

All documents concerning any investigation and/or trademark searches and legal opinion(s) made by or for Opposer relating to Opposer's SNAGIT Mark.

**REQUEST NO. 13:**

A copy of the file history of the trademark application that resulted in Opposer's SNAGIT Registration.

**REQUEST NO. 14:**

All documents concerning any protest or complaint made by Opposer concerning the registration and/or use by any third party of any SNAGIT mark or any variation thereof.

**REQUEST NO. 15:**

All documents concerning any pending or concluded arbitration, litigation or adversary proceedings concerning Opposer's SNAGIT Mark, with the exception of this opposition proceeding.

**REQUEST NO. 16:**

All documents concerning or comprising agreements concerning the use of Opposer's SNAGIT Mark, including without limitation licenses, assignments, permissions or consents.

**REQUEST NO. 17:**

All documents concerning any survey or other test or opinion concerning the likelihood of confusion between Opposer's SNAGIT Mark and Applicant's Mark.

**REQUEST NO. 18:**

All trademark searches, reports or investigations concerning Applicant's Mark.

**REQUEST NO. 19:**

All documents concerning Opposer's policies, procedures, guidelines, handbooks, practices, and recommendations regarding the usage, maintenance, protection, policing and enforcement of trademarks

**REQUEST NO. 20:**

All documents concerning Applicant or its intended use of the SNAG-IT Mark on board games, other than communications from Opposer or its counsel to the Patent and Trademark Office concerning this opposition proceeding.

**REQUEST NO. 21:**

All documents Opposer intends to use or rely upon in support of any position at any hearing or in any dispositive motion in this opposition.

**REQUEST NO. 22:**

All documents on which Opposer will or may rely to prove the allegations in Paragraph 1 that "TechSmith is a world-famous developer and provider of screen capture and recording software and services for individual and professional use."

**REQUEST NO. 23:**

All documents on which Opposer will or may rely to prove the allegations in Paragraph 2 that Opposer's SNAGIT Mark is "world famous."

**REQUEST NO. 24:**

All documents on which Opposer will or may rely to prove the allegations in Paragraph 2 that "TechSmith is also the owner of several other foreign registrations of its world famous mark SNAGIT."

**REQUEST NO. 25:**

All documents on which Opposer will or may rely to prove the allegations in Paragraph 5 that “As a result of the experience, care and quality of TechSmith in providing its goods under its world famous mark SNAGIT, TechSmith has become identified as a source of the goods and/or services to which the mark is applied and has acquired a reputation of excellence.”

**REQUEST NO. 26:**

All documents on which Opposer will or may rely to prove the allegations in Paragraph 9 that “Upon information and belief, the Applicant filed its application for the essentially identical mark SNAG-IT long after TechSmith obtained trademark rights in its world famous mark SNAGIT.”

**REQUEST NO. 27:**

All documents on which Opposer will or may rely to prove the allegations in Paragraph 10 that “the goods identified in Applicant’s essentially identical SNAG-IT mark are confusingly similar to the goods and/or services offered under TechSmith’s SNAGIT mark.”

**REQUEST NO. 28:**

All documents on which Opposer will or may rely to prove the allegations in Paragraph 15 that “Applicant’s use of the essentially identical mark SNAG-IT is likely to cause, and will cause, dilution of the distinctive value of the TechSmith mark SNAGIT under Section 439(c) of the Lanham Act of 1946, as amended, 15 USC §1125(c).”

**REQUEST NO. 29:**

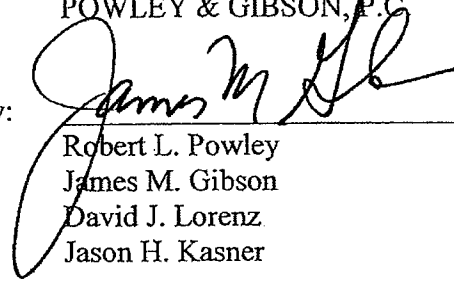
All documents concerning Opposer’s document retention policies.



Dated: New York, New York  
September 4, 2009

Respectfully submitted,  
POWLEY & GIBSON, P.C.

By:



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Robert L. Powley  
James M. Gibson  
David J. Lorenz  
Jason H. Kasner

304 Hudson St., 2<sup>nd</sup> Fl.  
New York, NY 10013  
(212) 226-5054 (phone)  
(212) 226-5085 (fax)

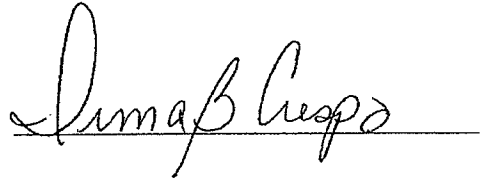
*Attorneys for Applicant Timothy Whitehurst*

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the foregoing Applicant's First Request for Production of Documents and Things was served by first-class mail, postage prepaid, on September 4, 2009, upon the following:

James R. Duby, Jr.  
Duby & Associates, PLC  
3511 Coolidge Road, Suite 200  
East Lansing, MI 48823  
(517) 371-9835

ATTORNEYS FOR OPPOSER

A handwritten signature in cursive script, appearing to read "Irma Crespo", is written over a horizontal line.

Irma Crespo

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

-----X			
TechSmith Corporation,	:		
	:		
Opposer,	:		
	:	Opposition No:	91189287
v.	:	Serial No.:	77/505306
	:	Mark:	SNAG-IT
Timothy Whitehurst,	:	International Class:	28
	:	Published:	November 18, 2008
Applicant.	:		
-----X			

Box TTAB  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

**APPLICANT'S FIRST SET OF REQUESTS FOR ADMISSIONS**

Pursuant to Rules 26 and 36 of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice, Applicant Timothy Whitehurst ("Applicant") hereby requests that Opposer Techsmith Corporation ("Opposer") by an officer or agent thereof, answer under oath and in writing the following requests within thirty (30) days following service hereof.

REQUEST NO.1: Admit that Opposer owns no exclusive rights to the terms "SNAG" and "IT."

REQUEST NO. 2: Admit that the goods of Applicant's application, namely, "board games," are different and distinct from the goods offered under the Opposer's SNAGIT mark, namely "computer software, namely, a screen capture utility software."

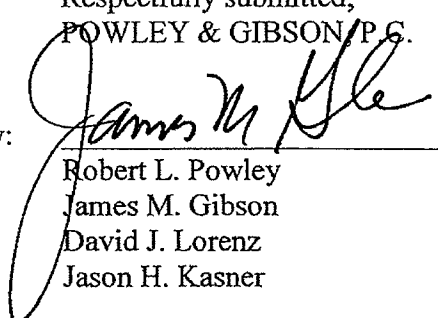
REQUEST NO. 3: Admit that the goods to be offered under Applicant's mark, namely, "board games," will be sold through different channels of trade than the goods offered under the Opposer's mark, namely "computer software, namely, a screen capture utility software."

REQUEST NO. 4: Admit that the goods to be offered under Applicant's mark, namely, board games, will be targeted towards different consumers than the goods offered under the Opposer's mark, namely, computer software, namely, a screen capture utility software.

Dated: New York, New York  
September 4, 2009

Respectfully submitted,  
POWLEY & GIBSON, P.C.

By:



---

Robert L. Powley  
James M. Gibson  
David J. Lorenz  
Jason H. Kasner

304 Hudson St., 2<sup>nd</sup> Fl.  
New York, NY 10013  
(212) 226-5054 (phone)  
(212) 226-5085 (fax)

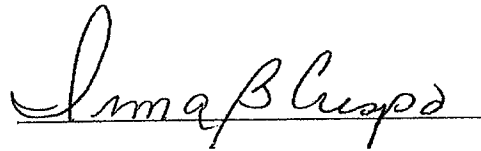
*Attorneys for Applicant Timothy Whitehurst*

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the foregoing Applicant's First Set of Requests for Admissions was served by first-class mail, postage prepaid, on September 4, 2009, upon the following:

James R. Duby, Jr.  
Duby & Associates, PLC  
3511 Coolidge Road, Suite 200  
East Lansing, MI 48823  
(517) 371-9835

ATTORNEYS FOR OPPOSER

A handwritten signature in cursive script, reading "Irma Crespo", is written over a horizontal line.

Irma Crespo

# EXHIBIT 2

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

---

TECHSMITH CORPORATION

Opposer

v.

TIMOTHY WHITEHURST,

Applicant.

§  
§  
§  
§  
§  
§  
§  
§  
§  
§

Opposition No: 91189287  
Serial No.: 77/505,306  
Mark: SNAG-IT  
International Class: 28  
Published: Nov. 18, 2008

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Box TTAB  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

**OPPOSER'S RESPONSES TO APPLICANT'S  
FIRST SET OF REQUESTS FOR ADMISSIONS**

Pursuant to Rule 36 of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice, Opposer, TECHSMITH CORPORATION ("TECHSMITH"), responds to Applicant's First Responses to Applicant's First Set of Requests for Admissions, and in support thereof, states as follows:

**ADMISSIONS**

**REQUEST NO.1:** Admit that Opposer owns no exclusive rights to the terms "SNAG" and "IT."

**ANSWER:** Denied. Opposer is the owner of world famous incontestable mark SNAGIT, U.S. Registration Number 2,104,800, and several other foreign registrations of the world famous mark SNAGIT in which incorporates and/or uses the terms "SNAG" and "IT." Opposer expressly reserves any and all other applicable denials to this request.

REQUEST NO.2: Admit that the goods of Applicant's application, namely, "board games," are different and distinct from the goods offered under the Opposer's SNAGIT mark, namely "computer software, namely, a screen capture utility software."

1. **ANSWER:** Denied. Applicant's intent-to-use trademark application for SNAG-IT for "board games" is not different and distinct from the goods offered under Opposer's world famous incontestable mark SNAGIT, U.S. Registration Number 2,104,800, in connection with "computer software, namely, a screen capture utility software" as Applicant's intent-to-use trademark, SNAG-IT for "board games", if and when used, is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association with famous Opposer or is likely to cause confusion, mistake, or deception as to the origin, sponsorship, or approval of Applicant's goods with famous Opposer. Moreover, Applicant's intended use of the essentially identical mark SNAG-IT is likely to cause, and will cause, dilution of the distinctive value of the Opposer's mark SNAGIT. Opposer expressly reserves any and all other applicable denials to this request.

REQUEST NO.3: Admit that the goods to be offered under Applicant's mark, namely, "board games," will be sold through different channels of trade than the goods offered under the Opposer's mark, namely "computer software, namely, a screen capture utility software."

**ANSWER:** Objection, as this request relates to future events of Applicant which have not yet occurred or may never occur and facts which will be unknown until the occurrence of said future event, the truth of the statement or opinion of fact requested is therefore beyond the scope of discovery pursuant to Rules 36 and 26(b)(1). Opposer expressly reserves any and all other applicable objections or denials to this request.



REQUEST NO.4: Admit that the goods to be offered under Applicant's mark, namely, board games, will be targeted towards different consumers than the goods offered under the Opposer's mark, namely, computer software, namely, a screen capture utility software.

**ANSWER:** Objection, as this request relates to future events of Applicant which have not yet occurred or may never occur and facts which will be unknown until the occurrence of said future event, the truth of the statement or opinion of fact requested is therefore beyond the scope of discovery pursuant to Rules 36 and 26(b)(1). Opposer expressly reserves any and all other applicable objections or denials to this request.

Respectfully submitted,

Dated: October 2, 2009

By: 

James R. Duby, Jr.  
DUBY & ASSOCIATES, PLC  
3511 Coolidge Road, Suite 200  
East Lansing, MI 48823  
Phone: (517) 371-9835  
Fax : (517) 371-9840

ATTORNEY FOR OPPOSER, TECHSMITH  
CORPORATION



**CERTIFICATE OF SERVICE**

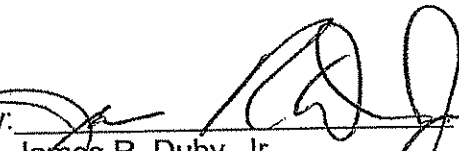
I hereby certify that on October 2, 2009, I caused to be served **OPPOSER'S RESPONSES TO APPLICANT'S FIRST SET OF REQUESTS FOR ADMISSIONS** on the following parties at the following addresses:

Robert L. Powley  
James M. Gibson  
POWLEY & GIBSON P.C.  
304 Hudson Street, 2<sup>nd</sup> Floor  
New York, NY 10013  
Telephone: (212) 226-5054  
Facsimile: (212) 226-5085

By:

- U.S. Postal Service, ordinary first class mail
- U.S. Postal Service, certified or registered mail,
- Return receipt requested
- Hand delivery
- Facsimile
- Electronic service via the Court's CM/ECF system
- Other (specify) E-mail

By:

  
James R. DUBY, Jr.  
DUBY & ASSOCIATES, PLC  
3511 Coolidge Road, Suite 200  
East Lansing, MI 48823

# EXHIBIT 3

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

---

TECHSMITH CORPORATION	§		
	§		
Opposer	§	Opposition No:	91189287
	§	Serial No.:	77/505,306
v.	§	Mark:	SNAG-IT
	§	International Class:	28
TIMOTHY WHITEHURST,	§	Published:	Nov. 18, 2008
	§		
Applicant.	§		

---

Box TTAB  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

**OPPOSER'S RESPONSES TO APPLICANT'S  
FIRST SET OF INTERROGATORIES**

Pursuant to Rule 33 of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice, Opposer, TECHSMITH CORPORATION ("TechSmith" and/or "Opposer"), responds to Applicant's First Set of Interrogatories, and in support thereof, states as follows:

Opposer asserts that all documents produced in response to or in accordance with Applicant's First Set of Interrogatories are governed by and subject to the Trademark Trial and Appeal Board's ("TTAB's) Standard Protective Order governing discovery.

**BY RESPONDING TO THESE REQUESTS, TECHSMITH  
DOES NOT ADOPT ANY INSTRUCTIONS, DEFINITION  
OR CHARACTERIZATION OF ANY TERM USED BY THE APPLICANT.**

## GENERAL OBJECTIONS

(a) Opposer's investigation and discovery in this matter are ongoing. These responses are based on information gathered as of the time of these Responses. Opposer reserves the right to amend or supplement these answers and Responses if and when additional information is obtained, and expressly refuses to be bound by the timeliness for response set out in Applicant's Requests, if any.

(b) Any Response to any Interrogatory is not intended to be, and shall not be deemed a concession or admission by Opposer of the appropriateness, accuracy, relevance or admissibility into evidence of such Response or information produced by the Opposer or the truth or accuracy of any characterization of any information or document contained herein. Opposer reserves the right to object to further discovery regarding the same subject matter as to any Request and to object to the introduction into evidence of information provided in response to these Interrogatories.

(c) Opposer objects to the Applicant's Requests to the extent that they seek to impose obligations on the Opposer beyond those imposed by the Trademark Rules of Practice and the Federal Rules of Civil Procedure.

(d) Opposer objects to Applicant's Requests and instructions to the extent they seek to limit Opposer's responses pursuant to the Trademark Rules of Practice and the Federal Rules of Civil Procedure.

(e) Opposer objects to each interrogatory or document request to the extent that it refers to any documents prepared in anticipation of litigation or for trial or which are otherwise covered by attorney work product immunity or subject to or falls within the scope of the attorney client/privilege and will not produce documents protected

from the discovery by virtue of any such immunity or privilege. Any information and/or document withheld from discovery by virtue on the basis of any privilege or immunity will be identified on a privileged document log.

(f) Opposer objects to each interrogatory or document request to the extent that it pertains to, or is inclusive of, entities other than Opposer, including present or former affiliates or agents which are not parties to this litigation. The answers set forth herein are those of Opposer alone.

(g) Opposer objects to each interrogatory or document request to the extent that production of "all documents", "referring to", "relating to", or "concerning" the subject matter beyond the scope of the suit is requested. Such requests are overly broad, indefinite and consequently unduly burdensome or oppressive since they cover a vast number of documents and/or information, many of which are confidential, irrelevant or not reasonably calculated to lead to the discovery of admissible evidence. In response to such requests, Opposer will produce information and/or documents otherwise producible or which are relevant to the subject matter of this action or reasonably calculated to lead to the discovery of admissible evidence.

(h) Opposer objects to each interrogatory or document request to the extent that it may be interpreted to be unlimited or not properly limited in time. Opposer's answers to these requests will be limited to information or documents created over a period prior to the filing date of the Notice of Opposition herein.

(i) Opposer objects to each interrogatory or document request to the extent that it seeks information and/or documents not under its control.

(j) Opposer objects to the definition of the term "document" in the Interrogatory Requests on the grounds that it is overly broad and, therefore, not reasonably calculated to lead to the discovery of admissible evidence.

(k) Opposer objects to each interrogatory request to the extent that it states or seeks a legal conclusion.

(l) Each of the foregoing objections is incorporated by reference into the following specific objections.

(m) Opposer reserves the right to modify, amend, or supplement its objections and move for further amended protective orders as necessary.

(n) Opposer incorporates herein all the objections listed in Opposer's Response to Applicant's First Request for Documents and Things.

Opposer reserves all objections to the admissibility of any information or documents or materials produced in to these interrogatories or documents requests. Inadvertent disclosure of any information or documents shall not be a waiver of any claim of privilege, work product protection or any other exemption.

### **INTERROGATORIES**

1. Identify all present and former officers, directors, and/or managers of Opposer and all other persons having responsibility for marketing, advertising, and promotion for any goods or services offered for sale or sold under Opposer's SNAGIT Trademark.

**RESPONSE: Opposer objects to this Interrogatory on the basis that it is vague, overly broad, unduly burdensome, and indefinite. Subject to and without waiving the objection, Opposer identifies the following persons:**

Donald J. Nourse, VP, Finance & Administration



2. Describe in detail the facts relating to, and identify the persons primarily involved in, Opposer's selection, adoption, and use of Opposer's SNAGIT Trademark, including the date on which Opposer first decided to adopt the mark, and the circumstances and method by which the mark was selected, created, adopted, and first used.

**RESPONSE:** Opposer objects to this Interrogatory on the basis that it is vague, overly broad, unduly burdensome, and indefinite. Subject to and without waiving the objection, Opposer will identify such persons after a reasonable investigation is completed to determine the same.

3. Identify the person or persons employed by Opposer most knowledgeable about the sales, advertising and promotion of products and/or provision of services under Opposer's SNAGIT Trademark, by Opposer and/or its licensees.

**RESPONSE:** Opposer objects to this Interrogatory on the basis that it is vague, overly broad, unduly burdensome, and indefinite. Subject to and without waiving the objection, Opposer refers to the individuals identified in response to Interrogatory No. 1.

4. Identify the person or persons employed by Opposer knowledgeable about any and all agreements, licenses, contracts or other arrangements between Opposer and any third party that refer or relate to the use of the Opposer's SNAGIT Trademark.

**RESPONSE:** Opposer objects to this Interrogatory on the basis that it is vague, overly broad, unduly burdensome, and indefinite. Subject to and without waiving the objection, Opposer refers to the individuals identified in response to Interrogatory No. 1.

5. State the exact date of first use by Opposer and/or Opposer's licensees of the Opposer's SNAGIT Trademark, describe in detail the circumstances surrounding first use, including the identity of each person who was a party thereto, and describe in detail

the exact dates for any periods of non-use between the date of first use and Opposer's filing of this Opposition.

**RESPONSE:** Opposer objects to this Interrogatory on the basis that it is vague, overly broad, unduly burdensome, and indefinite. Subject to and without waiving the objection, Opposer's date of first use of the Opposer's Mark is February 19, 1991.

6. State the date and detailed circumstances under which the Opposer first became aware of Applicant.

**RESPONSE:** Opposer objects to this Interrogatory on the basis that it is vague, overly broad, unduly burdensome, and indefinite. Subject to and without waiving the objection, Opposer first became aware of the Applicant upon receipt of a Watch Service report on or about the U.S. Patent and Trademark Office's publication date for the mark SNAG-IT.

7. State the gross revenue of the Opposer for sales of all goods utilizing the Opposer's SNAGIT Trademark and identify each document that sets forth or from which may be determined the annual income derived by Opposer from the sale of such goods.

**RESPONSE:** Opposer objects to this Interrogatory on the basis that it is overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence.

8. Identify each and every mode of advertising whereby the Opposer's goods utilizing the Opposer's SNAGIT Trademark are advertised including, but not limited to, how said goods are advertised, the geographic area(s) within which said goods are advertised, and the medium(s) in which said goods are advertised.

**RESPONSE:** Opposer objects to this Interrogatory on the basis that it is vague, overly broad, unduly burdensome, and indefinite. Subject to and without waiving the objection, Opposer refers Applicant to Opposer's TECHSMITH.COM and SNAGIT.COM Web Sites in connection with this interrogatory.

9. Identify the channels of trade through which the Opposer's goods utilizing Opposer's SNAGIT Trademark travel, including but not limited to, the types of stores, catalogs or Internet sites where said goods may be ordered and/or purchased, and intended users of said goods.

**RESPONSE:** Opposer objects to this Interrogatory on the basis that it is vague, overly broad, unduly burdensome, and indefinite. Subject to and without waiving the objection, Opposer refers Applicant to Opposer's TECHSMITH.COM and SNAGIT.COM Web Sites in connection with this interrogatory.

10. State whether Opposer's rights in Opposer's SNAGIT Trademark were or have been acquired from another person, whether by assignment, license, operation of law, or other transfer, express or implied, stating the precise rights acquired by Opposer from each such person, the date(s) on which Opposer acquired such rights, and identifying any relevant documents relating to such acquisition of rights and the means whereby such acquisition of rights was accomplished.

**RESPONSE:** Opposer states "No."

11. With respect to Opposer's SNAGIT Trademark:

- (a) State the earliest date(s) of the development, creation, design, adoption, and use of the mark;
- (b) Identify the person(s) primarily responsible for the development, creation, design, adoption, and use of the mark, and for each person identify and describe in detail that person's specific involvement;
- (c) Identify all persons involved in or who participated in the development, creation, design, adoption and use of the mark, or

who have knowledge of facts concerning the same, and for each person identify and describe in detail that person(s) specific involvement; and

- (d) Identify all documents concerning, reflecting, or referring to (i) development, creation, design, and modification of the mark, and
- (ii) the adoption and use of the mark.

**RESPONSE:** Opposer objects to this Interrogatory on the basis that it is overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence. Subject to and without waiving the objection, Opposer will identify such persons after a reasonable investigation is completed to determine the same.

12. State the entire factual basis for, and identify the person or persons employed by Opposer most knowledgeable about the allegations in Paragraph 1 of the Notice of Opposition that "TechSmith is a world-famous developer and provider of screen capture and recording software and services for individual and professional use."

**RESPONSE:** Opposer objects to this Interrogatory on the basis that it is vague, overly broad, unduly burdensome, indefinite, and to the extent that it calls for a legal conclusion, seeks information that may be protected by attorney-client privilege, constitutes work product and is otherwise immune from discovery. Opposer also objects to this Interrogatory on the ground that it is premature and calls for the entire theory of its case at this early stage of discovery.

13. State the entire factual basis for, and identify the person or persons employed by Opposer most knowledgeable about the allegations in Paragraph 2 that Opposer's SNAGIT Mark is "world famous."

**RESPONSE:** Opposer objects to this Interrogatory on the basis that it is vague, overly broad, unduly burdensome, indefinite, and to the extent that it calls for a legal conclusion, seeks information that may be protected by attorney-client privilege, constitutes work product and is otherwise immune from discovery. Opposer also objects to this

**Interrogatory on the ground that its is premature and calls for the entire theory of its case at this early stage of discovery.**

14. State the entire factual basis for, and identify the person or persons employed by Opposer most knowledgeable about the allegations in Paragraph 2 that "TechSmith is also the owner of several other foreign registrations of its world famous mark SNAGIT."

**RESPONSE: Opposer objects to this Interrogatory on the basis that it is vague, overly broad, unduly burdensome, indefinite, and to the extent that it calls for a legal conclusion, seeks information that may be protected by attorney-client privilege, constitutes work product and is otherwise immune from discovery. Opposer also objects to this Interrogatory on the ground that its is premature and calls for the entire theory of its case at this early stage of discovery.**

15. State the entire factual basis for, and identify the person or persons employed by Opposer most knowledgeable about the allegations in Paragraph 5 that "As a result of the experience, care and quality of Tech Smith in providing its goods under its world famous mark SNAGIT, TechSmith has become identified as a source of the goods and/or services to which the mark is applied and has acquired a reputation of excellence."

**RESPONSE: Opposer objects to this Interrogatory on the basis that it is vague, overly broad, unduly burdensome, indefinite, and to the extent that it calls for a legal conclusion, seeks information that may be protected by attorney-client privilege, constitutes work product and is otherwise immune from discovery. Opposer also objects to this Interrogatory on the ground that its is premature and calls for the entire theory of its case at this early stage of discovery.**

16. State the entire factual basis for, and identify the person or persons employed by Opposer most knowledgeable about the allegations in Paragraph 9 that "Upon information and belief, the Applicant filed its application for the essentially identical mark SNAG-IT long after TechSmith obtained trademark rights in its world famous mark SNAGIT."

**RESPONSE:** Opposer objects to this Interrogatory on the basis that it is vague, overly broad, unduly burdensome, indefinite, and to the extent that it calls for a legal conclusion, seeks information that may be protected by attorney-client privilege, constitutes work product and is otherwise immune from discovery. Opposer also objects to this Interrogatory on the ground that its is premature and calls for the entire theory of its case at this early stage of discovery.

17. State the entire factual basis for, and identify the person or persons employed by Opposer most knowledgeable about the allegations in Paragraph 10 that "the goods identified in Applicant's essentially identical SNAG-IT mark are confusingly similar to the goods and/or services offered under TechSmith's SNAGIT mark."

**RESPONSE:** Opposer objects to this Interrogatory on the basis that it is vague, overly broad, unduly burdensome, indefinite, and to the extent that it calls for a legal conclusion, seeks information that may be protected by attorney-client privilege, constitutes work product and is otherwise immune from discovery. Opposer also objects to this Interrogatory on the ground that its is premature and calls for the entire theory of its case at this early stage of discovery.

18. State the entire factual basis for, and identify the person or persons employed by Opposer most knowledgeable about the allegations in Paragraph 15 that "Applicant's use of the essentially identical mark SNAG-IT is likely to cause, and will cause, dilution of the distinctive value of the TechSmith mark SNAGIT under Section 439(c) of the Lanham Act of 1946 as amended, 15 USC §1125(c)."

**RESPONSE:** Opposer objects to this Interrogatory on the basis that it is vague, overly broad, unduly burdensome, indefinite, and to the extent that it calls for a legal conclusion, seeks information that may be protected by attorney-client privilege, constitutes work product and is otherwise immune from discovery. Opposer also objects to this Interrogatory on the ground that its is premature and calls for the entire theory of its case at this early stage of discovery.

19. Describe Opposer's efforts in, and identify the person or persons employed by Opposer most knowledgeable about, policing of the marketplace for any third-party

uses of the Opposer's SNAGIT Trademark, and identify all documents and things referring or relating to such policing.

**RESPONSE:** Opposer objects to this Interrogatory on the basis that it is vague, overly broad, unduly burdensome, and indefinite. Subject to and without waiving the objection, Opposer refers to the individuals identified in response to Interrogatory No. 1.

20. With regard to each allegation in the Notice of Opposition that Opposer will be injured or damaged by the registration and/or use of the mark shown in Application Serial Number 77/505306 by Applicant:

- (a) describe separately and in detail how the registration and/or use of the mark in Application Serial No. 77/505306 will cause such injury or damage;
- (b) identify the person most knowledgeable about such alleged injury or damage; and
- (c) identify all documents and things referring or relating to such alleged injury or damage.

**RESPONSE:** Opposer objects to this Interrogatory on the basis that it is vague, overly broad, unduly burdensome, indefinite, and to the extent that it calls for a legal conclusion, seeks information that may be protected by attorney-client privilege, constitutes work product and is otherwise immune from discovery. Opposer also objects to this Interrogatory on the ground that its is premature and calls for the entire theory of its case at this early stage of discovery.

21. Identify all documents Opposer expects to introduce into evidence at the trial of this matter and the person(s) in custody, possession, or control of each such document.

**RESPONSE:** Opposer has not yet identified all documents it expects to introduce into evidence at the trial of this matter. Opposer expressly reserves the right to supplement this Response. Opposer further responds that all the documents Opposer identified or produced in response to Applicant's First Set of Interrogatories and Applicant's First Request For Production of Documents and Things are all current potential documents.

22. Identify all persons whom Opposer intend to call as a witness (fact or expert) during Opposer's testimony period, and briefly describe the subject of each witness' anticipated testimony.

**RESPONSE:** Opposer has not yet determined who it will call to testify as a witness (fact or expert) during Opposer's testimony period. Opposer expressly reserves the right to supplement this Response. Opposer further answers that the individuals identified in answer to Interrogatory No. 1 are current potential witnesses.

Respectfully submitted,

By: 

Dated: December 21, 2009

James R. Duby, Jr.  
DUBY & ASSOCIATES, PLC  
3511 Coolidge Road, Suite 200  
East Lansing, MI 48823  
Phone: (517) 371-9835  
Fax : (517) 371-9840

ATTORNEY FOR OPPOSER, TECHSMITH  
CORPORATION



**CERTIFICATE OF SERVICE**

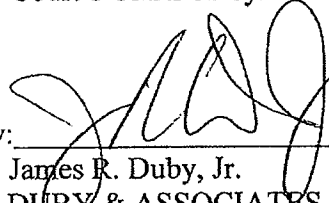
I hereby certify that on December 21, 2009, I caused to be served **OPPOSER'S RESPONSES TO APPLICANT'S FIRST SET OF INTERROGATORIES** on the following parties at the following addresses:

Robert L. Powley  
James M. Gibson  
POWLEY & GIBSON P.C.  
304 Hudson Street, 2<sup>nd</sup> Floor  
New York, NY 10013  
Telephone: (212) 226-5054  
Facsimile: (212) 226-5085

By:

- U.S. Postal Service, ordinary first class mail
- U.S. Postal Service, certified or registered mail,
- Return receipt requested
- Hand delivery
- Facsimile
- Electronic service via the Court's CM/ECF system
- Other (specify) E-mail

By: \_\_\_\_\_

  
James R. Duby, Jr.  
DUBY & ASSOCIATES, PLC  
3511 Coolidge Road, Suite 200  
East Lansing, MI 48823

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

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TECHSMITH CORPORATION	§		
	§		
Opposer	§	Opposition No:	91189287
	§	Serial No.:	77/505,306
v.	§	Mark:	SNAG-IT
	§	International Class:	28
TIMOTHY WHITEHURST,	§	Published:	Nov. 18, 2008
	§		
Applicant.	§		

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Box TTAB  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

**OPPOSER'S RESPONSES TO APPLICANT'S FIRST REQUEST FOR  
PRODUCTION OF DOCUMENTS AND THINGS**

Pursuant to Rule 34 of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice, Opposer, TECHSMITH CORPORATION ("TechSmith" and/or "Opposer"), and responds to Applicant's First Request for Production and Things, and in support thereof, states as follows:

Opposer asserts that all documents produced in response to or in accordance with Applicant's First Request for Production and Things are governed by and subject to the Trademark Trial and Appeal Board's (TTAB's) Standard Protective Order governing discovery.

**PRELIMINARY STATEMENT**

In responding to these requests, either written response or by production of the

documents, TechSmith does not waive its right to challenge the relevance, materiality, and admissibility of the information or documents provided, or to object to the uses of the information or documents in any subsequent proceeding or trial.

TechSmith's search for documents is ongoing, and its responses to these requests are based on information presently available. The fact that TechSmith may state in response to some requests that it will produce non-privileged and otherwise discoverable documents does not mean that it has yet determined that such documents exists or that it has located such documents. TechSmith reserves its right to supplement these responses and/or to produce additional documents prior to trial as provided by applicable law and rules. Pursuant to Trademark Rules of Practice and the Federal Rules of Civil Procedure, TechSmith expressly reserves the right to supplement these responses and its production of documents if it learns of additional, responsive information or documents not previously provided to the Applicant.

**BY RESPONDING TO THESE REQUESTS, TECHSMITH DOES NOT ADOPT ANY INSTRUCTIONS, DEFINITION OR CHARACTERIZATION OF ANY TERM USED BY THE APPLICANT.**

#### **GENERAL OBJECTIONS**

(a) Opposer objects to each document request to the extent that it refers to any documents prepared in anticipation of litigation or for trial or which are otherwise covered by attorney work product immunity or subject to or falls within the scope of the attorney client/privilege and will not produce documents protected from the discovery by virtue of any such immunity or privilege. Any information and/or document withheld from discovery by virtue on the basis of any privilege or immunity will be identified on a privileged document log.

(b) Opposer objects to each document request to the extent that it pertains to, or is inclusive of, entities other than Opposer, including present or former affiliates or agents which are not parties to this proceeding. The answers set forth herein are those of Opposer alone.

(c) Opposer objects to each document request to the extent that production of “all documents”, “referring to”, “relating to”, or “concerning” the subject matter beyond the scope of the proceeding is requested. Such requests are overly broad, indefinite and consequently unduly burdensome or oppressive since they cover a vast number of documents and/or information, many of which are confidential, irrelevant or not reasonably calculated to lead to the discovery of admissible evidence. In response to such requests, Opposer will produce information and/or documents otherwise producible or which are relevant to the subject matter of this action or reasonably calculated to lead to the discovery of admissible evidence.

(d) Opposer objects to each document request to the extent that it may be interpreted to be unlimited or not properly limited in time. Opposer's answers to these requests will be limited to information or documents created over a period prior to the filing date of the Notice of Opposition herein.

(e) Opposer objects to each document request to the extent that it seeks information and/or documents not under its control.

(f) Opposer objects to the definition of the term "document" in the Requests on the grounds that it is overly broad and, therefore, not reasonably calculated to lead to the discovery of admissible evidence.

(g) Opposer objects to each request to the extent that it states or seeks a legal conclusion.

(h) TechSmith's investigation and discovery in this case is ongoing. These responses are based on information gathered as of the time of these responses. TechSmith reserves the right to amend or supplement these responses if and when additional information is obtained.

(i) By responding to any request, TechSmith does not concede that there are any documents in its possession, custody or control that are responsive to such request.

(j) Any response to any request, or production of documents, is not intended to be and shall not be deemed a concession or admission by TechSmith of the relevance or admissibility into evidence of such response, or of any documents or information produced by TechSmith. TechSmith reserves the right to object to further discovery regarding the same subject matter as to any request and to object to the introduction into evidence of information and/or documents provided in response to Applicant's Requests for Production.

(k) TechSmith objects to the Applicant's Request for Production to the extent that they seek to impose obligations on TechSmith beyond those imposed by Trademark Rules of Practice and the Federal Rules of Civil Procedure.

(l) TechSmith objects to the Applicant's Requests for Production to the extent they seek information or documents containing trade secret information, confidential business information or other proprietary information regarding any of TechSmith's operations or confidential information regarding customers. TechSmith's failure to make response to any Request for Production subject to the TTAB's Standard Protective Order shall not be deemed a waiver of TechSmith's ability to designate such production as confidential material pursuant to the TTAB's Standard Protective Order

(m) TechSmith objects to any request for production that seeks to disclosure of its confidential, proprietary, trade secret and/or sensitive financial data for the purposes to annoy, harass, or improperly compete with TechSmith.

(n) TechSmith will make available documents for inspection and copying at a time and place mutually agreeable to the parties.

(o) Each of the foregoing objections is incorporated by reference into the following specific objections.

(p) Opposer incorporates herein the all the objections listed in Opposer's Response to Applicant's First Set of Interrogatories to Opposer.

(q) Opposer reserves the right to modify, amend, or supplement its objections and move for further amended protective orders as necessary.

(r) Opposer reserves all objections to the admissibility of any information or documents or materials produced in repose to these documents requests. Inadvertent disclosure of any information or documents shall not be a waiver of any claim of privilege, work product protection or any other exemption.

**REQUEST NO.1:**

All documents and tangible things identified by Opposer in response to Applicant's First Set of Interrogatories to Opposer or otherwise used, relied upon or referred to by Opposer in answering Applicant's First Set of Interrogatories to Opposer.

**RESPONSE:** Opposer incorporates its general objections and further objects to this request on the basis that it is vague, overly broad, unduly burdensome, indefinite, contentious and not reasonably calculated to lead to the discovery of admissible evidence. Opposer further objects that this Request on the ground that it seeks to invade the work product and/or attorney-client privileges.

**REQUEST NO.2:**

A representative sample of each product, label, package, container, product insert or other specimen bearing Opposer's SNAGIT Mark for each type of product in connection with which Opposer's SNAGIT Mark is used.

**RESPONSE:** Opposer incorporates its general objections and further objects to this request on the basis that it is vague, overly broad, unduly burdensome, indefinite, contentious and not reasonably calculated to lead to the discovery of admissible evidence. Notwithstanding these objections, Opposer refers Applicant to Opposer's TECHSMITH.COM and SNAGIT.COM Web Sites and in addition Opposer will make available for inspection and copying on a mutually agreeable date and time those non-privileged documents that are

located after reasonable search, to be within its possession, custody and control that it deems responsive to this Request, if any.

**REQUEST NO.3:**

Documents sufficient to show Opposer's first use of Opposer's SNAGIT Mark for each good or service in connection with which Opposer's SNAGIT Mark has been used.

**RESPONSE:** Opposer incorporates its general objections and further objects to this request on the basis that it is vague, overly broad, unduly burdensome, indefinite, contentious and not reasonably calculated to lead to the discovery of admissible evidence. Notwithstanding these objections, Opposer will make available for inspection and copying on a mutually agreeable date and time those non-privileged documents that are located after reasonable search, to be within its possession, custody and control that it deems responsive to this Request, if any.

**REQUEST NO.4:**

Documents sufficient to show Opposer's continuous use of Opposer's SNAGIT Mark from Opposer's claimed date of first use to the present in connection with board games.

**RESPONSE:** Opposer incorporates its general objections and further objects to this request on the basis that it is vague, overly broad, unduly burdensome, indefinite, contentious and not reasonably calculated to lead to the discovery of admissible evidence. Notwithstanding these objections, Opposer will make available for inspection and copying on a mutually agreeable date and time those non-privileged documents that are located after reasonable search, to be within its possession, custody and control that it deems responsive to this Request, if any.

**REQUEST NO.5:**

All documents concerning the class or type of purchasers of products sold under Opposer's SNAGIT Mark.

**RESPONSE:** Opposer incorporates its general objections and further objects to this request on the basis that it is vague, overly broad, unduly burdensome, indefinite, contentious and not reasonably calculated to lead to the discovery of admissible evidence. Notwithstanding these objections, Opposer will make available for inspection and copying on a mutually agreeable date and time those non-privileged documents that are located after reasonable search, to be within its possession, custody and control that it deems responsive to this Request, if any.

**REQUEST NO.6:**

All documents concerning the channels of trade for products sold under Opposer's SNAGIT Mark.

**RESPONSE:** Opposer incorporates its general objections and further objects to this request on the basis that it is vague, overly broad, unduly burdensome, indefinite, contentious and not reasonably calculated to lead to the discovery of admissible evidence. Notwithstanding these objections, Opposer refers Applicant to Opposer's TECHSMITH.COM and SNAGIT.COM Web Sites and in addition Opposer will make available for inspection and copying on a mutually agreeable date and time those non-privileged documents that are located after reasonable search, to be within its possession, custody and control that it deems responsive to this Request, if any.

**REQUEST NO.7:**

All documents concerning the marketing, sale, distribution, advertising or promotion by Opposer of Opposer's SNAGIT Mark.

**RESPONSE:** Opposer incorporates its general objections and further objects to this request on the basis that it is vague, overly broad, unduly burdensome, indefinite, contentious and not reasonably calculated to lead to the discovery of admissible evidence. Notwithstanding



these objections, Opposer refers Applicant to Opposer's TECHSMITH.COM and SNAGIT.COM Web Sites and in addition Opposer will make available for inspection and copying on a mutually agreeable date and time those non-privileged documents that are located after reasonable search, to be within its possession, custody and control that it deems responsive to this Request, if any.

**REQUEST NO.8:**

All documents that record summarize or otherwise refer to advertising or promotional expenditures, including actual, projected and budgeted expenditures, by or for Opposer for Opposer's SNAGIT Mark.

**RESPONSE:** Opposer incorporates its general objections and further objects to this request on the basis that it is vague, overly broad, unduly burdensome, indefinite, contentious and not reasonably calculated to lead to the discovery of admissible evidence.

**REQUEST NO.9:**

Copies of all publicity and/or media coverage, whether solicited or unsolicited, concerning products sold under Opposer's SNAGIT Mark, including press releases and articles of any kind.

**RESPONSE:** Opposer incorporates its general objections and further objects to this request on the basis that it is vague, overly broad, unduly burdensome, indefinite, contentious and not reasonably calculated to lead to the discovery of admissible evidence. Notwithstanding these objections, Opposer refers Applicant to Opposer's TECHSMITH.COM and SNAGIT.COM Web Sites and in addition Opposer will make available for inspection and copying on a mutually agreeable date and time those non-privileged documents that are located after reasonable search, to be within its possession, custody and control that it deems responsive to this Request, if any.

**REQUEST NO. 10:**

All documents concerning any market research, survey, analysis or investigation, including but not limited to individual questionnaires, pilot studies and focus groups, that disclose or indicate in any way recognition or awareness of Opposer's SNAGIT Mark by purchasers, customers and/or the trade.

**RESPONSE:** Opposer incorporates its general objections and further objects to this request on the basis that it is vague, overly broad, unduly burdensome, indefinite, contentious and not reasonably calculated to lead to the discovery of admissible evidence. Notwithstanding these objections, Opposer will make available for inspection and copying on a mutually agreeable date and time those non-privileged documents that are located after reasonable search, to be within its possession, custody and control that it deems responsive to this Request, if any.

**REQUEST NO. 11:**

All documents concerning the creation, design, selection, approval, adoption, display or use of Opposer's SNAGIT Mark.

**RESPONSE:** Opposer incorporates its general objections and further objects to this request on the basis that it is vague, overly broad, unduly burdensome, indefinite, contentious and not reasonably calculated to lead to the discovery of admissible evidence. Notwithstanding these objections, Opposer will make available for inspection and copying on a mutually agreeable date and time those non-privileged documents that are located after reasonable search, to be within its possession, custody and control that it deems responsive to this Request, if any.

**REQUEST NO. 12:**

All documents concerning any investigation and/or trademark searches and legal opinion(s) made by or for Opposer relating to Opposer's SNAGIT Mark.

**RESPONSE:** Opposer incorporates its general objections and further objects to this request on the basis that it is vague, overly broad, unduly burdensome, indefinite, contentious and not reasonably calculated to lead to the discovery of admissible evidence. Notwithstanding these objections, Opposer will make available for inspection and copying on a mutually agreeable date and time those non-privileged documents that are located after reasonable search, to be within its possession, custody and control that it deems responsive to this Request, if any.

**REQUEST NO. 13:**

A copy of the file history of the trademark application that resulted in Opposer's SNAGIT Registration.

**RESPONSE:** Opposer objects to this request on the ground that it seeks information that is equally publicly available to the Applicant and thus, Opposer refers Applicant to the document retrieval section of the USPTO.GOV Web Site. Otherwise, Opposer will make available for inspection and copying on a mutually agreeable date and time those non-privileged documents that are located after reasonable search, to be within its possession, custody and control that it deems responsive to this Request, if any.

**REQUEST NO. 14:**

All documents concerning any protest or complaint made by Opposer concerning the registration and/or use by any third party of any SNAGIT mark or any variation thereof.

**RESPONSE:** Opposer incorporates its general objections and further objects to this request on the basis that it is vague, overly broad, unduly burdensome, indefinite, contentious and not reasonably calculated to lead to the discovery of admissible evidence. Notwithstanding

these objections, Opposer will make available for inspection and copying on a mutually agreeable date and time those non-privileged documents that are located after reasonable search, to be within its possession, custody and control that it deems responsive to this Request, if any.

**REQUEST NO. 15:**

All documents concerning any pending or concluded arbitration, litigation or adversary proceedings concerning Opposer's SNAGIT Mark, with the exception of this opposition proceeding.

**RESPONSE:** Opposer incorporates its general objections and further objects to this request on the basis that it is vague, overly broad, unduly burdensome, indefinite, contentious and not reasonably calculated to lead to the discovery of admissible evidence. Notwithstanding these objections, Opposer will make available for inspection and copying on a mutually agreeable date and time those non-privileged documents that are located after reasonable search, to be within its possession, custody and control that it deems responsive to this Request, if any.

**REQUEST NO. 16:**

All documents concerning or comprising agreements concerning the use of Opposer's SNAGIT Mark, including without limitation licenses, assignments, permissions or consents.

**RESPONSE:** Opposer incorporates its general objections and further objects to this request on the basis that it is vague, overly broad, unduly burdensome, indefinite, contentious and not reasonably calculated to lead to the discovery of admissible evidence. Notwithstanding these objections, Opposer will make available for inspection and copying on a mutually agreeable date and time those non-privileged documents that are located after reasonable search, to be within its possession, custody and control that it deems responsive to this Request, if any.

**REQUEST NO. 17:**

All documents concerning any surveyor other test or opinion concerning the likelihood of confusion between Opposer's SNAGIT Mark and Applicant's Mark.

**RESPONSE:** Opposer incorporates its general objections and further objects to this request on the basis that it is vague, overly broad, unduly burdensome, indefinite, contentious and not reasonably calculated to lead to the discovery of admissible evidence. Notwithstanding these objections, Opposer will make available for inspection and copying on a mutually agreeable date and time those non-privileged documents that are located after reasonable search, to be within its possession, custody and control that it deems responsive to this Request, if any.

**REQUEST NO. 18:**

All trademark searches, reports or investigations concerning Applicant's Mark.

**RESPONSE:** Opposer incorporates its general objections and further objects to this request on the basis that it is vague, overly broad, unduly burdensome, indefinite, contentious and not reasonably calculated to lead to the discovery of admissible evidence. Opposer further objects that this Request on the ground that it seeks to invade the work product and/or attorney-client privileges.

**REQUEST NO. 19:**

All documents concerning Opposer's policies, procedures, guidelines, handbooks, practices, and recommendations regarding the usage, maintenance, protection, policing and enforcement of trademarks.

**RESPONSE:** Opposer incorporates its general objections and further objects to this request on the basis that it is vague, overly broad, unduly burdensome, indefinite, contentious and not reasonably calculated to lead to the discovery of admissible evidence. Opposer further objects that this Request on the ground that it seeks to invade the work product and/or attorney-client

privileges. Notwithstanding these objections, Opposer will make available for inspection and copying on a mutually agreeable date and time those non-privileged documents that are located after reasonable search, to be within its possession, custody and control that it deems responsive to this Request, if any.

**REQUEST NO. 20:**

All documents concerning Applicant or its intended use of the SNAG-IT Mark on board games, other than communications from Opposer or its counsel to the Patent and Trademark Office concerning this opposition proceeding.

**RESPONSE:** Opposer incorporates its general objections and further objects to this request on the basis that it is vague, overly broad, unduly burdensome, indefinite, contentious and not reasonably calculated to lead to the discovery of admissible evidence. Notwithstanding these objections, Opposer will make available for inspection and copying on a mutually agreeable date and time those non-privileged documents that are located after reasonable search, to be within its possession, custody and control that it deems responsive to this Request, if any.

**REQUEST NO. 21:**

All documents Opposer intends to use or rely upon in support of any position at any hearing or in any dispositive motion in this opposition.

**RESPONSE:** Opposer incorporates its general objections and further objects to this request on the basis that it is vague, overly broad, unduly burdensome, indefinite, contentious and not reasonably calculated to lead to the discovery of admissible evidence and unintelligible. Notwithstanding these objections, Opposer will make available for inspection and copying on a mutually agreeable date and time those non-privileged documents that are located after reasonable search, to be within its possession, custody and control that it deems responsive to this Request, if any.

**REQUEST NO. 22:**

All documents on which Opposer will or may rely to prove the allegations in Paragraph 1 that "Tech Smith is a world-famous developer and provider of screen capture and recording software and services for individual and professional use."

**RESPONSE:** Opposer incorporates its general objections and further objects to this request on the basis that it is vague, overly broad, unduly burdensome, indefinite, contentious and not reasonably calculated to lead to the discovery of admissible evidence and premature.

Notwithstanding these objections, Opposer will make available for inspection and copying on a mutually agreeable date and time those non-privileged documents that are located after reasonable search, to be within its possession, custody and control that it deems responsive to this Request, if any.

**REQUEST NO. 23:**

All documents on which Opposer will or may rely to prove the allegations in Paragraph 2 that Opposer's SNAGIT Mark is "world famous."

**RESPONSE:** Opposer incorporates its general objections and further objects to this request on the basis that it is vague, overly broad, unduly burdensome, indefinite, contentious and not reasonably calculated to lead to the discovery of admissible evidence and premature.

Notwithstanding these objections, Opposer will make available for inspection and copying on a mutually agreeable date and time those non-privileged documents that are located after reasonable search, to be within its possession, custody and control that it deems responsive to this Request, if any.

**REQUEST NO. 24:**

All documents on which Opposer will or may rely to prove the allegations in Paragraph 2 that "TechSmith is also the owner of several other foreign registrations of its world famous mark SNAGIT."

**RESPONSE:** Opposer incorporates its general objections and further objects to this request on the basis that it is vague, overly broad, unduly burdensome, indefinite, contentious and not reasonably calculated to lead to the discovery of admissible evidence and premature. Notwithstanding these objections, Opposer will make available for inspection and copying on a mutually agreeable date and time those non-privileged documents that are located after reasonable search, to be within its possession, custody and control that it deems responsive to this Request, if any.

**REQUEST NO. 25:**

All documents on which Opposer will or may rely to prove the allegations in Paragraph 5 that "As a result of the experience, care and quality of TechSmith in providing its goods under its world famous mark SNAG IT, TechSmith has become identified as a source of the goods and/or services to which the mark is applied and has acquired a reputation of excellence."

**RESPONSE:** Opposer incorporates its general objections and further objects to this request on the basis that it is vague, overly broad, unduly burdensome, indefinite, contentious and not reasonably calculated to lead to the discovery of admissible evidence and premature. Notwithstanding these objections, Opposer will make available for inspection and copying on a mutually agreeable date and time those non-privileged documents that are located after reasonable search, to be within its possession, custody and control that it deems responsive to this Request, if any.

**REQUEST NO. 26:**

All documents on which Opposer will or may rely to prove the allegations in Paragraph 9 that "Upon information and belief, the Applicant filed its application for the essentially identical mark SNAG-IT long after TechSmith obtained trademark rights in its world famous mark SNAGIT."



**RESPONSE:** Opposer incorporates its general objections and further objects to this request on the basis that it is vague, overly broad, unduly burdensome, indefinite, contentious and not reasonably calculated to lead to the discovery of admissible evidence and premature. Notwithstanding these objections, Opposer will make available for inspection and copying on a mutually agreeable date and time those non-privileged documents that are located after reasonable search, to be within its possession, custody and control that it deems responsive to this Request, if any.

**REQUEST NO. 27:**

All documents on which Opposer will or may rely to prove the allegations in Paragraph 10 that "the goods identified in Applicant's essentially identical SNAG-IT mark are confusingly similar to the goods and/or services offered under TechSmith's SNAGIT mark."

**RESPONSE:** Opposer incorporates its general objections and further objects to this request on the basis that it is vague, overly broad, unduly burdensome, indefinite, contentious and not reasonably calculated to lead to the discovery of admissible evidence and premature. Notwithstanding these objections, Opposer will make available for inspection and copying on a mutually agreeable date and time those non-privileged documents that are located after reasonable search, to be within its possession, custody and control that it deems responsive to this Request, if any.

**REQUEST NO. 28:**

All documents on which Opposer will or may rely to prove the allegations in Paragraph 15 that "Applicant's use of the essentially identical mark SNAG-IT is likely to cause, and will cause, dilution of the distinctive value of the TechSmith mark SNAGIT under Section 439(c) of the Lanham Act of 1946, as amended, 15 USC §1125(c)."

**RESPONSE:** Opposer incorporates its general objections and further objects to this request on the basis that it is vague, overly broad, unduly burdensome, indefinite, contentious and

not reasonably calculated to lead to the discovery of admissible evidence and premature. Notwithstanding these objections, Opposer will make available for inspection and copying on a mutually agreeable date and time those non-privileged documents that are located after reasonable search, to be within its possession, custody and control that it deems responsive to this Request, if any.

**REQUEST NO. 29:**

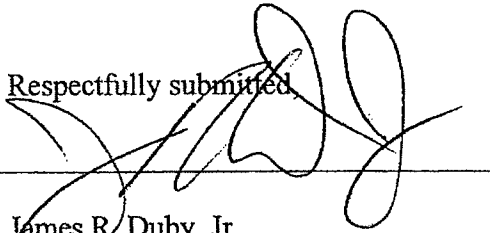
All documents concerning Opposer's document retention policies.

**RESPONSE:** Opposer incorporates its general objections and further objects to this request on the basis that it is vague, overly broad, unduly burdensome, indefinite, contentious and not reasonably calculated to lead to the discovery of admissible evidence and premature. Notwithstanding these objections, Opposer will make available for inspection and copying on a mutually agreeable date and time those non-privileged documents that are located after reasonable search, to be within its possession, custody and control that it deems responsive to this Request, if any.

Dated: December 21, 2009

By: \_\_\_\_\_

Respectfully submitted,



James R. Duby, Jr.  
DUBY & ASSOCIATES, PLC  
3511 Coolidge Road, Suite 200  
East Lansing, MI 48823  
Phone: (517) 371-9835  
Fax : (517) 371-9840  
E-mail Jim@Dubylaw.com

ATTORNEY FOR OPPOSER, TECHSMITH  
CORPORATION

**CERTIFICATE OF SERVICE**

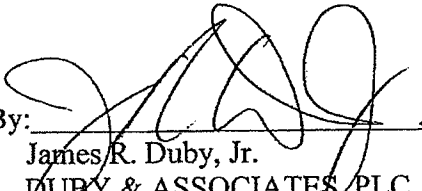
I hereby certify that on December 21, 2009, I caused to be served **OPPOSER'S RESPONSES TO APPLICANT'S FIRST REQUEST FOR REPRODUCTION OF DOCUMENTS AND THINGS** on the following parties at the following addresses:

Robert L. Powley  
James M. Gibson  
POWLEY & GIBSON P.C.  
304 Hudson Street, 2<sup>nd</sup> Floor  
New York, NY 10013  
Telephone: (212) 226-5054  
Facsimile: (212) 226-5085

By:

- U.S. Postal Service, ordinary first class mail
- U.S. Postal Service, certified or registered mail,
- Return receipt requested
- Hand delivery
- Facsimile
- Electronic service via the Court's CM/ECF system
- Other (specify) E-mail

By: \_\_\_\_\_

  
James R. Doby, Jr.  
DUBY & ASSOCIATES, PLC  
3511 Coolidge Road, Suite 200  
East Lansing, MI 48823

# EXHIBIT 4

POWLEY|GIBSON

VIA ELECTRONIC MAIL

January 15, 2010

James R. Duby, Jr.  
Duby & Associates, PLC  
3511 Coolidge Road, Suite 200  
East Lansing, MI 48823

Re: Opposition by TechSmith Corporation to  
Application No. 77/505,306 for SNAG-IT  
Our Ref. No.: 394.1

Dear Mr. Duby:

We reviewed Opposer's Responses to Applicant's First Set of Interrogatories and First Request for Production of Documents and Things and we write to request that Opposer provide proper written responses to both. Many of Opposer's responses to Applicant's discovery requests are wholly non-responsive and are not well-founded in law.

With regard to Opposer's Responses to Applicant's First Set of Interrogatories, we note the following deficiencies:

1. With respect to Interrogatory No. 1, Opposer was asked to identify all present and former officers, directors, and/or managers of Opposer and those responsible for marketing, advertising and promoting the SNAGIT product. Opposer objected to this Interrogatory on the grounds that it is "vague, overly broad, unduly burdensome, and indefinite." Clearly, Opposer's objection is not well taken as there are a limited number of officers and directors of Opposer. Again, Applicant requests the name of all current officers and directors. In addition, Opposer has only identified a single individual responsible for the marketing, advertising and promotion of products or services using the mark SNAGIT. That individual is a VP of Finance and Administration and we note is not the individual who appears responsible for the SNAGIT product at TechSmith – such as Jody Burgess, James Hidlay or Thomas McCallion. Unless Mr. Nourse will be Opposer's 30(b)(6) witness regarding the topics of marketing, advertising and promotion of the SNAGIT product, Applicant requests all names of those responsible for these functions.

Powley & Gibson, p.c.  
304 Hudson Street  
2nd Floor  
New York, NY 10013  
212.226.5054  
F 212.226.5085  
powleygibson.com

POWLEY|GIBSON

James R. Duby, Jr.  
Duby & Associates, PLC  
January 15, 2010  
Page 2

2. In response to Applicant's Interrogatory No. 2 regarding Opposer's adoption and use of Opposer's Trademark SNAGIT, Opposer states that "Opposer will identify such persons after a reasonable investigation is completed to determine the same." Opposer has already been granted an extension of time by the Trademark Trial and Appeal Board to identify such persons and documents, and has had over 90 days to do so. It is inconceivable that Opposer still has not gathered the relevant information. Applicant requests that Opposer provide a full response to this Interrogatory, immediately.
3. With regard to Opposer's response to Interrogatory No. 3, Applicant requests that Opposer provide a supplementary response to this interrogatory by responding to the same issues as raised with respect to Interrogatory No. 1.
4. With regard to Opposer's response to Interrogatory no. 4, Applicant requests that Opposer provide a supplementary response to this interrogatory by responding to the same issues as raised with respect to Interrogatory No. 1.
5. With respect to Interrogatory No. 5, in which Applicant requested that Opposer "State the exact date of first use by Opposer and/or Opposer's licensees of the Opposer's SNAGIT Trademark, describe in detail the circumstances surrounding first use, including the identity of each person who was a party thereto, and describe in detail the exact dates for any periods of non-use between the date of first use and Opposer's filing of this Opposition," Opposer provides the date of first use of Opposer's Mark, but does not describe the circumstances surrounding such first use, the party or parties who first used the mark, nor the exact dates for any periods of non-use between the date of first use and Opposer's filing of this Opposition. This information is clearly relevant and Applicant is entitled to a proper and full response. Applicant requests that Opposer provide a full response to this Interrogatory, immediately.
6. Opposer's response to Interrogatory No. 7 is unacceptable and lacks any legal basis. See *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147, 149 (TTAB 1985). Applicant requests that Opposer supplement this response, immediately.
7. With regard to Interrogatory No. 8, Opposer has referred Applicant to Opposer's websites as the sources for determining the mode and medium of advertising for Opposer's mark SNAGIT. If Opposer advertises its mark SNAGIT in any other medium then on these two websites, Applicant requests the Opposer provide this information.
8. With regard to Interrogatory No. 9, Opposer's response is not proper. See *Miller & Fink Corp. v. Servicemaster Hospital Corp.*, 184 USPQ 455,495 (TTAB 1975). Applicant requests that Opposer supplement its response to this interrogatory, immediately.

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James R. Duby, Jr.  
Duby & Associates, PLC  
January 15, 2010  
Page 3

9. With regard to Interrogatory No. 10, Applicant requested dates of earliest development, creation, design, adoption and use of the mark SNAGIT by Opposers; person primarily responsible for the development, creation, design, adoption and use; and the identification of all documents referring to these activities. These requests are proper and Applicant again request Opposer to provide this information.

10. With regard to Interrogatories Nos. 12 through 18, Opposer's objections to these requests are not legally sufficient. See FRCP 33(c) and 36(a); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671 (TTAB 1988). Applicant requests that Opposer supplement its responses to these requests, immediately.

Finally, FRCP 33 requires the person (or an agent) to sign the response to interrogatories. Since Opposer's interrogatories are signed by James R. Duby, Jr., please confirm that he signed responses on behalf of the Opposer.

With regard to Opposer's Responses to Applicant's First Request for the production of documents and things, we note the following deficiencies:

1. With respect to Document Request No. 1, Opposer refuses to provide "all documents and tangible things identified by Opposer in response to Applicant's First Set of Interrogatories to Opposer or otherwise used, relied upon or referred to by Opposer in answering Applicant's First Set of Interrogatories to Opposer." Opposer objects to this request on the grounds that it is "vague, overly broad, unduly burdensome, indefinite, contentious and not reasonably calculated to lead to the discovery of admissible evidence." Opposer's response is improper. It asks for specific, easily identifiable documents that are related to the opposition proceedings. Applicant requests that Opposer produce documents in response to this request.

2. Document Request No. 8 calls for "all documents that record, summarize or otherwise refer to advertising or promotional expenditures, including actual, projected and budgeted expenditures, by or for Opposer for Opposer's SNAGIT Mark." Opposer objects to this request on the grounds that it is "vague, overly broad, unduly burdensome, indefinite, contentious and not reasonably calculated to lead to the discovery of admissible evidence." Opposer's response is improper. Applicant is simply requesting specific information regarding Opposer's advertising and promotional costs related to Opposer's SNAGIT mark. This information is relevant to the issue of whether Opposer's mark is "famous," as Opposer's asserts in its Notice of Opposition. Applicant requests that Opposer produce documents in response to this request.

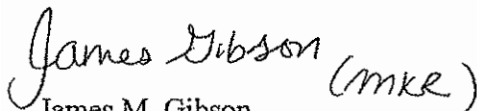
James R. Duby, Jr.  
Duby & Associates, PLC  
January 15, 2010  
Page 4

3. Opposer refuses to provide documents in response to Document Request No. 18, which requests "trademark searches, reports or investigations concerning Applicant's Mark." Opposer objects to this request on the basis that it is "vague, overly broad, unduly burdensome, indefinite, contentious and not reasonably calculated to lead to the discovery of admissible evidence." Opposer's response is improper. See *Fisons Ltd. v. Capability Brown Ltd.*, 209 USPQ 167 (TTAB 1980). This request asks specifically for the results of any investigations by Opposer into Applicant's mark, information which should be readily available to Opposer. The request is calculated to lead to the discovery of evidence connected to Opposer's assertions in the Notice of Opposition that use of Applicant's mark is likely to cause consumer confusion, will lead to the dilution of Opposer's mark, and other similar assertions. Applicant requests that Opposer produce documents in response to this request.

Finally, Opposer asserts that all documents produced in response to or in accordance with Applicant's First Set of Interrogatories and Applicant's First Request for Production of Documents and Things "are governed by and subject to the Trademark Trial and Appeal Board's ("TTAB's) Standard Protective Order governing discovery." However, at this point in time, no such Protective Order has been signed by Applicant, nor has Opposer requested that Applicant enter into a Protective Order. Applicant requests that Opposer forward a proposed Protective Order for review by Applicant. Applicant further requests that both parties exchange documents on Friday, January 22, 2010, to be treated as "For Attorney's Eyes Only" until such time as the parties agree to a Protective Order and it has been entered by the Board.

If you have any questions, please call.

Sincerely,

  
James M. Gibson (mkr)



# EXHIBIT 5

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

-----X			
TechSmith Corporation,	:		
	:		
Opposer,	:		
	:	Opposition No:	91189287
v.	:	Serial No.:	77/505306
	:	Mark:	SNAG-IT
Timothy Whitehurst,	:	International Class:	28
	:	Published:	November 18, 2008
Applicant.	:		
-----X			

Box TTAB  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

**APPLICANT'S MOTION TO COMPEL AND TO EXTEND DISCOVERY**

Pursuant to Rule 6(b) of the Federal Rules of Civil Procedure, 37 CFR § 2.120(a), TMBP § 509.01(a), Rule 37(a) of the Federal Rules of Civil Procedure, 37 CFR § 2.120(e), and TMBP § 523.01, Timothy Whitehurst ("Applicant"), by his attorneys, Powley & Gibson, P.C., respectfully requests that the Trademark Trial and Appeal Board ("TTAB") extend the February 21, 2010 deadline for the closure of discovery in the above-captioned Opposition by ninety (90) days and compel Opposer to respond to Applicant's discovery requests. Applicant also respectfully requests that the remainder of the deadlines as currently set in the trial schedule issued on November 20, 2009 be reset accordingly.

Opposer commenced the above-captioned Opposition on March 18, 2009. Applicant served discovery requests on Opposer on September 4, 2009 and Opposer's responses were due on October 9, 2009. Opposer did not respond to Applicant's written discovery requests. Rather, after responding only to Applicant's First Requests for Admissions on October 2, 2009, Opposer

filed a Combined Motion and Brief for Request for Suspension and Extension of Time to Respond to Applicant's Written Discovery Requests on October 9, 2009. The TTAB granted Opposer until December 21, 2009 to respond to Applicant's discovery requests. On that date, Opposer provided responses to Applicant's discovery requests which were deficient in numerous respects. Opposer has yet to provide any documents or substantive interrogatory responses to Applicant. Opposer appears to be refusing to discuss its discovery deficiencies with Applicant as required by TMBP § 408.01, despite Applicant's numerous attempts to engage in such discussions. As a result, Applicant will be prejudiced in defending the opposition if discovery were to close on February 21, 2010, as scheduled, without meaningful discovery from Opposer.

#### I. PROCEDURAL BACKGROUND

Applicant served discovery requests on Opposer on September 4, 2009. Copies of Applicant's Discovery Requests are attached hereto to the Declaration of Michelle Riley ("Riley Decl." ¶2, Exhibit 1). Opposer responded solely to Applicant's Request for Admissions on October 2, 2009 (Riley Decl. ¶3, Exhibit 2). On October 9, 2009, the deadline for Opposer to serve written responses to Applicant's interrogatories and requests for documents and to produce documents, Opposer filed of a Combined Motion and Brief for Request for Suspension and Extension of Time to Respond to Applicant's Written Discovery Requests. The TTAB granted Opposer until December 21, 2009 to respond to Applicant's discovery requests. (Riley Decl. ¶4, Exhibit 3). Opposer responded to Applicant's First Set of Interrogatories and Applicant's First Request for Production of Documents and Things on December 21, 2009. (Riley Decl. ¶5, Exhibit 4). Many of Opposer's responses to Applicant's discovery requests are improper and/or unintelligible. On January 15, 2010, Applicant's counsel sent a letter to Opposer, outlining Opposer's deficiencies in its discovery responses. (Riley Decl. ¶6, Exhibit 5). On January 20,

2010, and January 21, 2010, Applicant's counsel left voicemail messages with Opposer requesting that counsel contact Applicant's counsel to discuss deficiencies in Opposer's discovery response. On January 21, 2010 Applicant also sent an email to Opposer requesting that the parties have a conversation to discuss document production (Riley Decl. ¶7, Exhibit 6). Opposer advised that it would be contacting Applicant's counsel shortly. (Riley Decl. ¶8, Exhibit 7). Having had no further response from Opposer, Applicant's counsel sent an email on January 26, 2010, again requesting that counsel contact counsel for Applicant to discuss Opposer's deficient responses. (Riley Decl. ¶9, Exhibit 8).

On January 28, 2010, Applicant's counsel received an email from Opposer in which Opposer stated that it was "in the process of reviewing the contentions contained in [Applicant's] recent letter," and attaching the same proposed coexistence agreement which was previously rejected by Applicant (with revisions solely to the dates referenced in the agreement) and requesting that Applicant execute the same or forward proposed revisions to the agreement. (Riley Decl. ¶10, Exhibit 9). On the same date, counsel left a voicemail message with counsel for requesting that the parties discuss Opposer proper discovery responses and the production of documents. Having received no reply, counsel for Applicant sent an email to counsel for Opposer on January 29, 2010, reminding counsel that Applicant had rejected the proposed Coexistence Agreement, and that the parties were not currently in settlement negotiations, and requesting that Opposer provide Applicant with Opposer's discovery responses, and call to discuss any other discovery issues. (Riley Decl. ¶11, Exhibit 10). Applicant's counsel emailed counsel for Opposer again on February 1, 2010 and February 2, 2010 requesting that the parties discuss discovery, but received no response. (Riley Decl. ¶12, Exhibit 11). On February 3,

2010, Applicant's counsel emailed counsel for Opposer and requested Opposer's consent to file a Motion to Extend Discovery, to date, Opposer has not responded. (Riley Decl. ¶13, Exhibit 12).

## II. ARGUMENT

### A. **Opposer's Failure To Provide Full and Complete Responses to Applicant's Discovery Requests and to Produce Documents Has Prejudiced Applicant**

Opposer's refusal to produce any documents or meaningful written responses to Applicant's discovery requests and to engage in any discussion regarding discovery has prejudiced Applicant's ability to properly defend his rights in this proceeding. Despite having received Applicant's discovery requests on September 4, 2009, over four months later, Opposer has yet to produce a single document or provide substantive responses to Applicant's interrogatories. Applicant has attempted to cooperate with Opposer in the discovery process as required by TBMP § 408.01, but Opposer has not reciprocated. Opposer has failed to provide proper discovery responses and has repeatedly ignored Applicant's multiple requests to discuss Opposer's discovery deficiencies.

TBMP § 403.04 states:

a party which receives discovery requests early in the discovery period may not, by delaying its response thereto, or by responding improperly so that its adversary is forced to file a motion to compel discovery, rob its adversary of the opportunity to take "follow-up" discovery. Such a delay or improper response constitutes good cause for an extension of the discovery period.

Citing *Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067 (TTAB 1990) and *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689 (TTAB 1975). Here, Opposer's delay in producing documents and deficient responses to Applicant's discovery requests has robbed Applicant of its opportunity to receive any meaningful discovery and/or any follow-up discovery, including the taking of depositions of Opposer's witnesses, requesting additional

documents, and serving further interrogatories or Request to Admit. Discovery closes in approximately two weeks, and Applicant has yet to receive a single document from Opposer. Applicant will need these documents, as well as substantive written discovery responses, in order to adequately prepare for trial. Opposer's refusal to cooperate with discovery will severely prejudice Applicant if the Motion to Compel is not granted, and if the discovery deadline is not extended by ninety (90) days.

**B. Applicant has complied with Rule 37(a) of the Federal Rules of Civil Procedure and 37 CFR § 2.120(e)**

Applicant's counsel has complied with Rule 37(a) of the Federal Rules of Civil Procedure and 37 CFR § 2.120(e) by making good faith efforts to resolve with Opposer's counsel the deficiencies in Opposer's discovery responses, but has been unable to reach Opposer's counsel to discuss these issues. (Riley Decl. ¶14). Since Opposer responded to Applicant's First Set of Interrogatories and First Request for Production of Documents and Things on December 21, 2009, Applicant's counsel contacted Opposer's counsel on January 15, 2010, January 20, 2010, January 21, 2010, January 26, 2010, January 28, 2010, January 29, 2010, February 1, 2010, February 2, 2010, and February 3, 2010. (Riley Decl. ¶6, 7, 9, 11, 12, 13). Despite these attempts, the parties have not been able to discuss the deficient discovery responses. (Riley Decl. ¶13).

**CONCLUSION**

Based on the foregoing, Applicant respectfully requests that the TTAB compel Opposer to produce supplemental discovery responses to Applicant's discovery requests and enter an order extending the February 21, 2010 deadline for the closure of discovery by ninety (90) days.

Applicant also respectfully requests that the remainder of the deadlines as currently set in the trial schedule issued on November 20, 2009 be reset accordingly.

Dated: February 10, 2010  
New York, New York

Respectfully submitted,  
POWLEY & GIBSON, P.C.

By: James Gibson  
Robert L. Powley *mce*  
James M. Gibson  
Margarita Wallach  
Michelle Riley

304 Hudson St., 2<sup>nd</sup> Fl.  
New York, NY 10013  
(212) 226-5054 (phone)  
(212) 226-5085 (fax)

*Attorneys for Applicant Timothy Whitehurst*

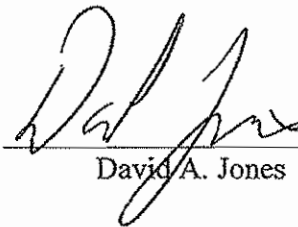
**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of Applicant's Motion to Compel and to Extend Discovery was served by priority mail, postage prepaid, on February 10, 2010, upon the following:

James R. Duby, Jr.  
Duby & Associates, PLC  
3511 Coolidge Road, Suite 200  
East Lansing, MI 48823  
(517) 371-9835

ATTORNEY FOR OPPOSER

The undersigned also certifies that Applicant's Motion to Compel and to Extend Discovery is being transmitted to the United States Patent and Trademark Office Trademark Trial and Appeal Board using the Electronic System for Trademark Trials and Appeals (ESTTA) on the date indicated above.

  
\_\_\_\_\_  
David A. Jones



# EXHIBIT 6

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Mailed: March 31, 2010

Opposition No. 91189287

TechSmith Corporation

v.

Timothy Whitehurst

**Linda Skoro, Interlocutory Attorney**

Applicant, on February 10, 2010, filed a motion to compel opposer to supplement its outstanding discovery requests. Applicant states that, despite its good faith efforts and numerous attempts to solve this matter, no supplemental responses whatsoever have been filed.

Opposer has failed to respond to the motion.

Accordingly, applicant's motion to compel is granted as uncontested. Trademark Rule 2.127(a). Opposer is allowed until thirty days from the date hereof to serve applicant with complete responses to the outstanding interrogatories and document requests, without objection, as identified in applicant's January 25, 2010, letter to applicant's counsel. If opposer fails to comply with this order, applicant is free to file a motion for the entry of involuntary dismissal under Trademark Rule 2.120(g)(1).

Applicant also requested an extension of the discovery period and a resetting of all remaining dates. That request is granted as uncontested and dates are reset as indicated below.

Discovery Closes	June 28, 2010
Plaintiff's Pretrial Disclosures	August 12, 2010
Plaintiff's 30-day Trial Period Ends	September 26, 2010
Defendant's Pretrial Disclosures	October 11, 2010
Defendant's 30-day Trial Period Ends	November 25, 2010
Plaintiff's Rebuttal Disclosures	December 10, 2010
Plaintiff's 15-day Rebuttal Period Ends	January 9, 2011

**IN EACH INSTANCE**, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party **WITHIN THIRTY DAYS** after completion of the taking of testimony. Rule 2.125.

Briefs shall be filed in accordance with Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Rule 2.129.