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

Proceeding	91207983
Party	Defendant Added Extras LLC
Correspondence Address	CLAUDIA CANTARELLA SALANS LLP ROCKEFELLER CENTER , 620 FIFTH AVENUE NEW YORK, NY 10020-2457 UNITED STATES ACarlson@salans.com,Thicks@salans.com
Submission	Opposition/Response to Motion
Filer's Name	Lora A. Moffatt
Filer's e-mail	lora.moffatt@dentons.com, tanya.hicks@dentons.com, wanda.heller@dentons.com, alison.carlson@dentons.com
Signature	/lora a. moffatt/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

EMANUEL UNGARO ITALIA S.R.L.,

Opposer

Opposition No. 91/207,983

vs.

Serial No. 85/500,670

ADDED EXTRAS LLC,

Applicant.

**APPLICANT’S OPPOSITION TO OPPOSER’S MOTION TO COMPEL DISCOVERY  
RESPONSES, SANCTIONS, ENTRY OF PROTECTIVE ORDER AND STAY**

Applicant Added Extras LLC (“Applicant” or “AE”), by its undersigned attorneys, hereby opposes Opposer’s Motion to Compel Discovery Responses, Sanctions, Entry of Protective Order and Stay (“Motion”).

**I. INTRODUCTION**

Rather than trying to resolve the parties’ alleged discovery dispute in good faith, Opposer Emanuel Ungaro Italia S.R.L.’s (“Opposer” or “Ungaro”) Motion is a blatant attempt to evade its own discovery obligations. Opposer initiated this action in November 2012 and, like Applicant, had thirty (30) days to object and respond to Applicant’s discovery requests, which were served in June. Instead of seeking an extension from Applicant, which Applicant would have granted. Opposer now claims due to an “extended leave for vacation or ‘holiday’” it will be unable to provide substantive responses or documents.<sup>1</sup> Opposer should not be able to use this Motion as an excuse not to provide responses unless, of course, the proceeding is stayed.

Ungaro’s Motion is also premature because it fails to comply with Chapter 523.02 of the Trademark Board Manual of Procedure (“TBMP”). Nowhere in either the Motion or the

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<sup>1</sup> Italians vacation in August, not July.

Declaration of Ralph H. Cathcart, Esq. (“Cathcart Declaration” or “Cathcart Dec.”) does Opposer or counsel certify that a “good faith effort” was made to resolve the parties’ discovery dispute. In fact, Opposer’s letter, demanding discovery, was unreasonable. Opposer’s letter demanded that Applicant produce documents within five days, two of which fell over the weekend. When Applicant failed to capitulate to this unreasonable demand, Opposer filed the instant Motion the following day: on July 16, 2013. Clearly, Opposer had no intention of resolving the parties’ dispute amicably and, more importantly, failed to wait a reasonable amount of time after the deadline to produce documents had passed to file this Motion as required by the TBMP.<sup>2</sup>

With respect to the Protective Order, Opposer distorts the parties’ explicit agreement during the discovery conference, which was to abide by the TTAB’s standard protective order (“TTAB’s Order”). The TTAB’s Order does not require both the parties and their attorneys to become signatories. Instead of sending Applicant the TTAB’s Order, Opposer sent a modified version, which deviated from the TTAB’s standard terms in several respects. Applicant’s draft rejected those provisions that did not track the TTAB’s Order and attempted restore the TTAB’s standard language. Again, rather than trying to resolve the purported dispute in good faith (with a telephone call or some other written communication), Opposer filed this Motion.

Finally, Opposer’s request for discovery sanctions is wholly without merit. It is well established that sanctions are only available to a party (1) where the allegedly non-compliant party has failed to comply with an order related to discovery or an order compelling discovery; or (2) if the disclosing party has failed to make such disclosures and has informed the other party that no response will be made. Because no such orders exist here and because Applicant has not

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<sup>2</sup> Applicant notes that it erred in its objections to Opposer’s interrogatories with respect to the number permitted under the TTAB’s rules and will revise those objections.

indicated that it will not make the requested disclosures, Opposer's request for sanctions must be denied.

## II. FACTS

On January 17, 2013, the parties held the mandatory discovery conference and agreed, *inter alia*, that the TTAB's Order would, with slight modifications, govern this proceeding. Declaration of Tanya D. Hicks ("Hicks Declaration" or "Hicks Dec.") at ¶ 2. During the discovery conference, Opposer's counsel never mentioned that both counsel and the parties would be required to sign the protective order. *Id.* at ¶ 3. Rather, the parties discussed that the disclosures made between the parties would be limited to the current proceeding and any appeal thereof and that, if necessary, the parties would agree to discuss any further issues concerning the protective order as they arose. *Id.*

On May 16, 2013, Opposer sent Applicant a draft of Opposer's proposed protective order ("Opposer's Order"). Hicks Dec. at ¶ 4.<sup>3</sup> On June 25, 2013, Applicant's counsel informed Opposer's counsel that Applicant had changes to Opposer's Order. Hicks Dec. ¶ 6, Ex. 2. Opposer responded on June 26, 2013, indicating that Applicant's changes would have to be vetted with Opposer. *Id.* at ¶ 7. On July 12, 2013, Applicant sent Opposer Applicant's proposed changes to Opposer's Order ("Applicant's Order") via email.<sup>4</sup> *Id.* at ¶ 11. Opposer never responded to Applicant's proposed changes, which more closely mimicked the TTAB's Order. *Id.* at ¶ 7.

On July 2, 2013, Opposer sent Applicant a letter, requesting a ninety-day extension of discovery. Hicks Dec. at ¶ 8, Ex. 4. Applicant consented to the request and, on July 10, 2013,

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<sup>3</sup>A redlined version of Opposer's Order, showing the changes from the TTAB's Order is attached as Exhibit 1 to the Hicks Declaration.

<sup>4</sup>A true and accurate copy of Applicant's Order, showing Applicant's proposed changes to Opposer's Order is attached to the Cathcart Declaration as Exhibit I.

the TTAB granted the ninety-day extension. *Id.* at ¶ 9. Discovery is currently set to close on October 20, 2013. *Id.* Notwithstanding this three-month extension, Opposer demanded that Applicant produce documents within five (5) days of its July 10, 2013 letter and, when Applicant failed to produce documents, served Applicant with a copy of the instant Motion by hand on July 16, 2013.<sup>5</sup> *Id.* at ¶ 12.

### III. ARGUMENT

#### A. **Opposer Neither Attempted To Resolve The Alleged Discovery Dispute In Good Faith Nor Waited A Reasonable Amount of Time To File the Motion**

Chapter 523.02 of the TBMP requires that parties make a “good faith effort” to resolve discovery issues. *See* TBMP 523.02. A “motion to compel disclosures or discovery must be supported by a written statement from the moving party that such party or its attorney has made a *good faith effort* . . . to resolve with the other party or its attorney the issues presented in the motion, and has been unable to reach agreement.” *See also* 37 CFR § 2.120(e). As set forth below, Opposer failed to comply with the literal requirements of the TTAB rules and did not attempt to resolve the parties’ issues in good faith.

Opposer’s July 10, 2013 letter does not qualify as a good faith effort to resolve the parties’ discovery dispute under the TTAB’s rules. In *Giant Food, Inc. v. Standard Terry Mills, Inc.*, the TTAB denied a motion to compel where the moving party’s efforts to resolve discovery issues fell short of the good faith requirement. *See Giant*, 1986 WL 84982 at \*10-11, 229 U.S.P.Q. 955 (TTAB May 7, 1986). In that case, the “sole effort” made by the applicant’s attorney to resolve the discovery disputes prior to filing the motion “was simply to send a letter to opposer’s counsel,” characterizing opposer’s responses to certain interrogatories as “non-

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<sup>5</sup> Opposer has never indicated to Applicant that it will not comply with the discovery requests to which it has not objected. Hicks Dec. ¶ 14.

responsive” or “evasive.” *Id.* at \*10. Opposer’s July 10, 2013 letter makes similar conclusory statements about Applicant’s objections and responses and should not be taken as a good faith effort to resolve the discovery dispute. *See* Cathcart Dec. at ¶ 16, Ex. H. Further, Opposer’s demand that Applicant produce documents responsive to seventy (70) document requests in less than three (3) business days was also unreasonable.

Finally, according to the TTAB rules, “[a] moving party should also wait a reasonable time after the responses are due to file a motion to compel, to allow time for receipt of responses.” *See* TBMP 523.03 and 37 CFR § 2.120(e). The reason is clear, timely-served discovery responses might not arrive until after the deadline. Accordingly, the receiving party should wait a reasonable time beyond the service date before making a motion alleging failure to serve. *See e.g., MySpace, Inc. v. Donnell Mitchell*, 91 U.S.P.Q.2d 1060, 1061 n.2 (TTAB 2009). Here, Opposer failed to wait a reasonable amount of time after the July 15, 2013 deadline had passed to file the Motion.

On July 2, 2013, Opposer sent Applicant a letter, not only requesting Applicant’s consent to extend the discovery deadline by ninety (90) days, but also acknowledging that “we will have to resolve discovery issues.” Hicks Dec. ¶ 8, Ex. 4. Even though Applicant agreed to the extension and discovery is not set to close until October 20, 2013, Opposer sent Applicant a letter a week later, demanding that documents be produced within five days, on or before July 15, 2013. Cathcart Dec. ¶ 16, Ex. H. When Applicant failed to produce documents on the fifteenth, Opposer filed this Motion on the sixteenth. Hicks Dec. ¶ 12. Filing a motion to compel one day after the deadline passed is not a reasonable amount of time to permit compliance with Opposer’s requests. As such Opposer’s motion compelling responses should be denied.

**B. Opposer's Motion For Entry of Opposer's Order Must Be Denied**

Simply put, the parties never agreed that both the parties and their counsel would be signatories to the protective order. Hicks Dec. at ¶ 3. That requirement does not exist in the TTAB's Order and is unnecessary. See Exhibit C to Cathcart Declaration. As can be seen in the redlined version between Applicant's Order and the TTAB's Order, Applicant's version not only incorporates many of Opposer's changes, but is more similar to the TTAB's Order than Opposer's Order. Compare Hicks Ex. 1 with Ex. 6. Opposer's failure to contact Applicant to discuss Applicant's changes before filing this Motion is inexcusable.

Because the parties agreed to be bound by the TTAB's Order, that order should govern this proceeding. Alternatively, Applicant respectfully requests that Applicant's Order be entered.

**C. Opposer's Motion For Sanctions is Improper**

A motion for sanctions under 37 CFR § 2.120(g)(2) is only available to compel responses to interrogatories and requests for production of documents and things where the responding party has: (1) failed to respond; and (2) informed the party seeking discovery that no response will be made. TBMP 527.01(b). Neither the Motion nor the Cathcart Declaration indicates that Applicant has informed Opposer that it will not respond to Opposer's discovery requests because it has not. Hicks Dec. ¶ 14. Further, there is no order in this proceeding related to discovery or compelling discovery with which Applicant has failed to comply. TBMB 527.01(a).

Accordingly, the Motion as it relates to sanctions does not comport with Chapter 527 of the TBMP and must be denied.


**IV. CONCLUSION**

For the reasons set forth above, Applicant respectfully requests that Opposer's Motion be denied and that either Applicant's Order or the TTAB's Order be entered in this proceeding.

Respectfully submitted,

Dated: New York, New York  
July 31, 2013

SALANS FMC SNR DENTON EUROPE LLP

By:   
\_\_\_\_\_  
Lora A. Moffatt, Esq.  
Tanya D. Hicks, Esq.  
620 Fifth Avenue  
New York, NY 10020  
Tel.: (212) 632-5500  
Fax: (212) 632-5555

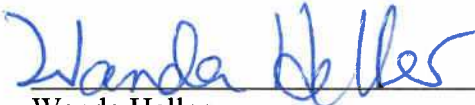
**Attorneys for Applicant Added Extras  
LLC**



**CERTIFICATE OF TRANSMISSION AND SERVICE**

I hereby certify that a true and correct copy of the foregoing APPLICANT'S OPPOSITION TO OPPOSER'S MOTION TO COMPEL DISCOVERY RESPONSES, SANCTIONS, ENTRY OF PROTECTIVE ORDER AND STAY is being electronically transmitted to the United States Patent and Trademark Office's Trademark Trial and Appeal Board on this 31st day of July 2013 and sent via First Class Mail, postage prepaid, to the following counsel for Opposer:

LADAS & PARRY LLP  
Ralph H. Cathcart  
1040 Avenue of the Americas  
New York, NY 10018-3738

  
Wanda Heller