

ESTTA Tracking number: **ESTTA548815**

Filing date: **07/16/2013**

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

Proceeding	91207983
Party	Plaintiff Emanuel Ungaro Italia S.r.l.
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Attachments	Motion to Compel Discovery Responses - Added Extras.pdf(1045572 bytes)

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

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EMANUEL UNGARO ITALIA S.R.L. :
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Opposer, : Opposition No. 91/207,983
:
v. : Application No. 85/500,670
:
ADDED EXTRAS LLC, :
:
Applicant. :
:
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**OPPOSER'S MOTION TO COMPEL DISCOVERY RESPONSES, SANCTIONS, ENTRY OF
PROTECTIVE ORDER AND STAY**

Opposer, Emanuel Ungaro S.r.l., moves pursuant to 37 C.F.R. § 2.120 and Fed. R. Civ. P. 37(a), for (i) an order compelling Applicant to respond to Opposer's First Set of Document Requests and First Set of Interrogatories (ii) discovery sanctions (iii) entry of a modified standard protective order and (iv) a stay of proceedings, including pending discovery responses.

BACKGROUND

On December 21, 2011, Applicant applied to register, under Serial No. 85/500,670, the mark DIVA COUTURE, which application covers:

"[a]dhesives for artificial nails; Adhesives for false eyelashes, hair and nails; Aromatic body care products, namely, body lotion, shower gel, cuticle cream, shampoo, conditioner, non-medicated lip balm, soap, body polish, body and foot scrub and non-medicated foot cream; Cosmetics and make-up; False nails; Nail art stickers; Nail buffing preparations; Nail care kits comprising nail polish; Nail care preparations; Nail care preparations, namely, nail softeners; Nail cream; Nail enamel; Nail enamel removers"

The application was published on May 22, 2012. Cathcart Declaration ("Cathcart Dec'1."), ¶ 3.

Opposer obtained extensions of time to oppose the DIVA COUTURE mark and filed a Notice of Opposition on November 14, 2012. Applicant filed its Answer on December 20, 2012. Cathcart Dec'l., ¶¶ 3 and 4.

On February 5, 2013, Opposer served its Initial Disclosures on Applicant. Cathcart Dec'l., ¶ 6. On May 16, 2013, Opposer served its First Set of Interrogatories and First Request for Production of Documents upon Applicant, together with a Modified Protective Order to be signed by Applicant and counsel. Cathcart Dec'l., ¶ 7, Exhs. A, B and C. Applicant's Responses were due on June 20, 2013. Applicant requested and Opposer granted a 7-day extension of time for Applicant to respond to Opposer's First Set of Interrogatories, up-to-and including June 27, 2013. On June 20, 2012, Applicant served woefully deficient responses to Opposer's First Set of Document Requests, producing not one single page of documents (privileged or otherwise) and sham objections. Cathcart Dec'l. ¶¶ 9-15, Exh. D. On June 27, 2013, Applicant served its response to Opposer's First Set of Interrogatories, again not answering a single interrogatory and asserting sham objections. Cathcart Dec'l., ¶¶ 9-15, Exhibit E.

By e-mail dated July 10, 2013, Opposer sent Applicant a letter in an attempt to resolve Applicant's blatant discovery non-compliance and to avoid motion practice (as per Board rules), by offering to accept tardy supplemental discovery responses, provided Applicant supplement its responses "on the merits" on or before July 15, 2013. Cathcart Dec'l., ¶ 16, Exh. F.

To date, Applicant has wholly failed to produce one single document (non-confidential or otherwise) in response to Opposer's discovery requests and has failed to answer one single interrogatory or to sign the Modified Protective Order. Cathcart Dec'l., ¶ 16. Accordingly, Applicant's discovery responses are woefully deficient, tardy and have effectively thwarted the discovery process.

I.

OPPOSER MUST COMPLY WITH ITS DISCOVERY OBLIGATIONS

Applicant should be compelled to comply with its discovery obligations as required by law.

37 C.F.R. § 2.120(e) provides in pertinent part:

“if a party fails to... answer... any interrogatory, or fails to produce and permit the inspection and copying of any document or thing, the party... seeking disclosure may file a motion to compel disclosure”

Fed. R. Civ. P. 37 provides in pertinent part:

“(a) Motion for Order Compelling Disclosure or Discovery.

A party, seeking discovery may move for an order compelling an answer ... [or] production”.

* * *

“(4) Evasive or Incomplete Disclosure, Answer, or Response. For purposes of this subdivision (a), an evasive or incomplete disclosure, answer or response must be treated as a failure to disclose, answer, or respond. (*Emphasis added.*)

A motion to compel discovery is to be granted based upon a failure to provide requested discovery, interrogatories or requests for production of documents and things. *Johnson & Johnson v. Diamond Medical, Inc.*, 183 U.S.P.Q. 615 (TTAB 1974) (Board ordered production of representative samples of invoices, labels, advertising materials and figures relating to advertising expenditures incurred in promoting subject mark”); *Neville Chemical Co. v. Lubrizol Corp.*, 183 U.S.P.Q. 184 (TTAB 1974) (Board ordered production of all agreements relating to the subject trademark, advertising and promotional figures for each year and for each corresponding mark, answers to interrogatory, *etc.*)

As discussed herein and in the Cathcart Dec’l., Applicant’s discovery compliance is woefully deficient, in fact, a sham, calculated to frustrate and impede the discovery process.

Cathcart Dec'1. ¶¶ 1-23. Absent the relief requested herein, access to meaningful discovery will be substantially thwarted and Opposer's ability to lay bare its proofs at trial will be materially prejudiced.

Applicant's refusal to comply with its discovery obligations has delayed proceedings, thwarted Opposer's ability to obtain meaningful discovery, resulted in unnecessary motion practice, strains the Board's busy docket and has resulted in unnecessary legal expense for Opposer. Cathcart Dec'1., ¶ 16.

Applicant has not produced or made available a single document, nor has Applicant answered a single interrogatory or executed the previously agreed upon Modified Protective Order. Cathcart Dec'1., ¶¶ 9-23. Further, Opposer's First Set Of Interrogatories and First request For Production of Documents specifically requested that responses and production be made at the offices of Ladas & Parry. (Cathcart Dec'1., Exhs D and E.) Thus, Applicant must meaningfully and substantively reply to Opposer's discovery requests and produce responsive documents at the offices of Ladas & Parry in New York, "on the merits", without the groundless objections interposed by Applicant which will be discussed *supra*.

Where a party has failed to respond to a request for discovery during the time allowed, it may be found to have forfeited its right to object to the discovery requests on the merits. *See, e.g., No Fear Inc. v. Rule*, 54 U.S.P.Q. 2d 1551, 1554 (TTAB 2000) ("where the non-movant cannot show that its neglect of discovery obligations was excusable, the Board generally will order discovery responses to be provided without objection"); *Crane Co. v. Shimano Industrial Co.*, 184 U.S.P.Q. 691 (TTAB 1975) (inasmuch as applicant failed to respond to interrogatories because it claimed they served "no useful purpose," applicant waived its rights to object to them on their merits and "must reply to them as put").

Given Applicant's inexcusable discovery non-compliance, Applicant has waived its right to object to Opposer's First Set of Interrogatories and First Requests for Production of Documents "on the merits". Further, since Opposer's First Set of Interrogatories and First Requests for Production of Documents seek Applicant's production at the offices of Ladas & Parry and Applicant has not objected thereto, Opposer respectfully requests that the Board compel Applicant to supplement its answers and produce responsive answers and documents to Opposer's First Set of Interrogatories and First Set of Document Requests "on the merits" at Opposer's counsel's office. See, e.g., *No Fear Inc.*, 54 U.S.P.Q. 2d 1551, 1555. In *No Fear Inc.*, the court held that

"Opposer, in its requests for production, asked applicant to copy and forward responsive documents to opposer. [Since] applicant did not timely respond [applicant] was found to have waived its right to object to discovery requests on their merits. Accordingly, it was improper for applicant to have raised an objection regarding place of production". *Id.* at 1555.

See also *Crane Co. v. Shimano Industrial Co., Ltd.* 184 U.S.P.Q. 691 (TTAB 1975). "(Inasmuch as applicant failed to [timely] respond to the interrogatories . . . or to request an extension of its time to do so prior to the aforesaid date [responses were due], applicant has waived its rights to object to interrogatories on their merits and must reply to them as put"). Accordingly, Applicant should be ordered to supplement its answers to Opposer's First Set of Interrogatories and produce responsive documents to Opposer's First Set of Document Requests, "on the merits", since Applicant has wholly failed or refused to respond to Opposer's discovery requests and Fed. R. Civ. P. 37 mandates that evasive or incomplete disclosure "must" be treated as a "failure to disclose, answer or respond".

A. APPLICANT'S RESPONSES TO OPPOSER'S DOCUMENT REQUESTS ARE A SHAM

To put matters in the proper context, Opposer's First Request for Production of Documents contained 70 requests for production of documents. Cathcart Dec'1., ¶ 13, Exh. E. Notwithstanding, Applicant has not produced responsive documents to even one single document request. Rather, Applicant either refuses to produce documents altogether, states in rote-like fashion that dozens of Document Requests are "overly broad, unduly burdensome, not calculated to lead to the discovery of admissible evidence, ambiguous, or claims that unspecified documents are confidential or privileged.

Perhaps the easiest way to address the plethora of groundless objections, is to group all of Applicant's responses together that impermissibly state "subject to and without waiver of the foregoing, [Applicant] will produce non-privileged responsive documents, if any, that are located as a result of a reasonable search". (Emphasis added) Here, Applicant states that responsive documents, "if any", will be produced in response to the following document requests: Document Requests Nos. 1, 7, 8, 11, 15, 16, 17, 18, 22, 23, 30, 31, 38, 41, 42, 43, 44, 45, 46, 48, 49, 51, 59, 61, 62, 66, 67, 68, 69 and 70. As the Board knows, such responses are impermissible. *See, e.g., No Fear, Inc. v. Ruede D. Rule*, 54 U.S.P.Q.2d 1551 (TTAB 2000).

In *No Fear, Inc.*, the Board instructively stated that the Applicant's response in that case, to wit,

"responsive documents, if any, will be produced" was improper for two reasons. First, "applicant was obligated to respond to each request; and a proper response requires either stating that there are responsive documents and that they will be produced or withheld on a claim of privilege or stating that [applicant] has no responsive documents [citation omitted] Second, applicant's response suggests that applicant has not actually searched for responsive documents and, therefore, has no idea whether there are documents responsive to particular requests for production". (Emphasis added.)

Id. at 1555-56.

In *No Fear, Inc.*, as in this case, Applicant had not objected to Opposer's request that documents be produced at Opposer's counsel's office. Similarly, Applicant in *No Fear*, like Applicant in the present case, produced no substantive response to the 62 requests for production, other than "responsive documents, if any, will be produced in accordance with the Federal Rules and will be produced at the offices of Applicant or Applicant's counsel at a time and place to be agreed upon between counsel". Here, Applicant's response, as in *No Fear*, suggests that "Applicant has not even searched for responsive documents and has no idea whether there are documents responsive to particular requests for production. *Id.* Applicant's discovery conduct falls far short of the duty to cooperate imposed by TBMP § 408.

Accordingly, these responses are deficient and Applicant has defaulted on its discovery obligations. Accordingly, Opposer respectfully requests that the Board issue an Order compelling Applicant to produce all documents responsive to the aforementioned document requests "on the merits" as "an incomplete disclosure, answer or response must be treated as a failure to disclose, answer or respond". Fed. R. Civ. P. 37.

As stated in *No Fear*, "objections going to the merits of a discovery request include those which challenge a request as overly broad, unduly vague and ambiguous, burdensome and oppressive, as seeking non-discoverable information on expert witnesses, or as not calculated to lead to the discovery of admissible evidence". *Id.* at 1554.

Here, Applicant refuses to answer Document Request Nos. 2-6; 10, 12, 13, 14, 19-21, 24, 25-29, 32-37, 39, 40, 47, 50, 53 – 58, 60, 63, 64, "on the merits", alleging that those Document Requests are either ambiguous, or burdensome or not likely to lead to the disclosure of discoverable evidence. Under the circumstances, Opposer respectfully requests that the Board

compel Applicant to answer the Document requests “on the merits” as put, given Applicant’s sham responses.

Applicant repeatedly also vaguely asserts an attorney client privilege or a confidentiality claim in response to numerous interrogatories and document requests. Applicant must support such claims since

“[a]ny claim that otherwise responsive documents are privileged requires a particularized explanation of the privilege relied on, and a description of the documents which, without revealing the privileged information, is sufficient to allow the inquiring party to access the applicability of the privilege. *No Fear*, 59 U.S.P.Q.2d at 1556.

Furthermore, Applicant interposes numerous spurious objections as a pretext not to comply with its discovery obligations. For *e.g.*, applicant objects to Document Request No. 5, which seeks production of “all documents concerning the named Applicant’s predecessors in interest, if any, to the DIVA COUTURE mark”. It is difficult to imagine how Applicant can object to such an interrogatory as it may specifically bear on specific witnesses, chain of title, knowledge of Opposer, *etc.*,

Likewise, Applicant objects to Opposer’s Document Request No. 6, which seeks production of all documents concerning the named Applicant’s successors in interest, if any, to the DIVA COUTURE mark. Again, it is difficult to imagine how Applicant could object to this request in good faith, particularly since a trademark assignment, assigning the entire interest of Added Extras LLC to KVZ International Limited was recorded on April 5, 2012 with the USPTO. Opposer should be able to flesh out information concerning who actually owns the intellectual property rights at issue in this case and whether Applicant even has standing.

As to Document Request No. 9, Opposer sought production of documents “relating to any legal opinions concerning the DIVA COUTURE mark or Applicant’s goods and services”.

While an attorney/client privilege may certainly apply, this certainly does not forestall Applicant's obligation to identify said documents. *See, e.g., Fisons Limited v. Capability Brown Limited*, 209 U.S.P.Q. 167, 170 (TTAB 1980); *Goodyear Tire and Rubber Co. v. Tireco Industries*, 186 U.S.P.Q. 207, 208 (TTAB 1975) (The fact that an opinion concerning trademark validity or possible conflicts regarding Applicant's adoption and use of mark was given to Applicant as "not privileged"). Compare *Miles Laboratory, Inc. v. Instrumentation Laboratory, Inc.*, 185 U.S.P.Q.2d 432, 434 (TTAB 1975) (Attorney comments on search report or prosecution of Application are privileged).

Likewise, Applicant refuses to answer Document Request No. 10 which seeks documents pertaining "to evidence, whether in tangible form or electronic data, concerning Applicant's intent to use DIVA COUTURE in the United States". Plainly such evidence is admissible and proper.

Incredibly, Applicant refuses to respond to Opposer's Document Request Nos. 24 through 29 seeking two specimen samples of Applicant's advertising, promotional products, sales or information kits or samples of each document or tangible thing on which the symbol "TM", "SM", "®" or other symbol or phrase of similar meaning is used in connection with the DIVA COUTURE mark. Plainly Applicant must supplement its responses and answer these document requests on the merits.

As to Document Request No. 58, Opposer seeks documents related to "third party uses, applications or registrations (or application or Applicant's knowledge thereof) of the names or marks DIVA, DIVA COUTURE, any name or mark including the term DIVA or any name or mark which is similar to the foregoing on or in connection with products or services identical similar or related to Applicant's goods and services". Plainly, such document request is proper

so long as Opposer is not seeking that Applicant undertake a search to ascertain such information. Rather, Opposer is merely asking if Applicant is aware of such third party use. *See, e.g., Sports Authority Michigan, Inc. v. PC Authority, Inc.*, 63 U.S.P.Q.2d 1782, 1788 (TTAB 2001) (No obligation to search for third party uses). *Domino Pizza, Inc. v. Little Caesar Enterprises, Inc.*, 7 U.S.P.Q.2d 1359, 1363 Note 9 (TTAB 1988) (relevant to show purchase or perception of the mark.)

Accordingly, for the reasons above cited, Opposer requests that the Board issue an Order compelling Applicant to supplement its sham responses and to provide responsive documents to Opposer First Request for Documents on the merits.

B. APPLICANT'S INTERROGATORY RESPONSES ARE A SHAM

Applicant's General Objections and Responses are inappropriate. Applicant impermissibly seeks to narrow the definition of Applicant, Applicant's Goods and Services and the definition of the DIVA COUTURE Mark. Further, Applicant objects to Opposer's First Set of Interrogatories to the extent they are not limited "in time and will limit its responses to information from January 1, 2007 to the present". Applicant, however, served Interrogatories on Opposer on or about June 27, 2013 that requests information going back three decades, as per Applicant's "Instructions" at page 5 thereto, to wit – "unless otherwise specified, these interrogatories relate to the period from the date of first use of Opposer's mark to the date of Opposer's reply to these Interrogatories". Cathcart Dec'l., Exh. F. Further, General Objection No. 12 states "[Applicant] objects to each and every interrogatory to the extent they seek ". . . information readily accessible to opposer from public sources". Plainly such objection is not permitted. Cathcart Dec'l., Exh. D.

Further, in paragraph 13 of Applicant's General Objections and Responses, Applicant states that it "will not produce any such confidential document until the parties have executed and the [sic] TTAB Standard Protective Order". Applicant makes this objection despite knowing full well it had agreed to a modified version of the Standard Protective Order, but now declines to sign same. Cathcart Decl. ¶¶ 5, 17-18. Further, consistent with Applicant's stalling tactics, Applicant sent Opposer a marked up version of the modified Protective Order specifically deleting the very revisions the parties had agreed upon. Cathcart Decl., Exhibit H.

A cursory review of Applicant's Responses to Opposer's First Set of Interrogatories demonstrates that Applicant's responses are designed to thwart the discovery process. Indeed, e.g., Applicant's Response to Interrogatory No. 1 objects to same, despite the fact that Applicant asked essentially the identical questions in its Interrogatory No. 2 propounded upon Opposer. Cathcart Decl., Exhibit D. It is well established that one cannot object to a particular discovery request if one has served the same discovery request on one's adversary. *See, e.g., Sentrol, Inc. v. Sentex Systems, Inc.*, 231 U.S.P.Q. 666, 667 (TTAB 1986). *See also, Metronic, Inc. v. Pacesetters Systems, Inc.*, 222 U.S.P.Q. 80, 83 (TTAB 1984) (same proposition).

Further, Applicant objects to Opposer's Interrogatories seeking the identity of the person having primary responsibility for "manufacture or rendering of Applicant's goods and services. *See, e.g., J.B. Williams Co. v. Pepsodent GmbH*, 188 U.S.P.Q. 577, 580 (TTAB 1975) (may identify a reasonable number of those most knowledgeable of adoption, selection or day-to-day use of mark).

Likewise, Applicant has failed to Answer (Interrogatory No. 3) concerning its first use or adoption of the DIVA COUTURE mark, despite such interrogatory plainly being appropriate. *See, e.g., Varian Associates v. Fairfield-Noble Corp.*, 188 U.S.P.Q. 581, 583 (TTAB 1975).

Applicant has also refused to supply any information concerning Applicant's knowledge (including first knowledge) of Opposer and its use of the trademarks DIVA and DIVA UNGARO, despite being an appropriate interrogatory. *See, e.g., Volkswagon Aktiengesellschaft v. MTD Products, Inc.*, 181 U.S.P.Q. 471, 473 (TTAB 1974) (Applicant's knowledge of use by Opposer or by the public or the trade, is relevant). Likewise, Applicant refuses to answer Interrogatory No. 8 which seeks the identification of advertising agencies, public relations firms, *etc.*, that Applicant has retained in connection with advertising and the promotion of Applicant's goods and services. Plainly, such information is proper and admissible. *See, e.g., J.B. Williams Co. v. Pepsodent G.m.b.H.* 188 U.S.P.Q. 577, 580 (TTAB 1975).

Applicant objected to each of Opposer's First Set of Interrogatories Nos. 1 through 11 on the merits (*i.e.*, that the interrogatory is burdensome, not calculated to lead to the discovery of admissible evidence, ambiguous, *etc.*, and refused to respond. Cathcart Decl. ¶ 10, Exh. D.

Similarly, Applicant has totally failed to respond to Opposer's Interrogatory Nos. 12 – 22, except to incredibly state “that Opposer has exceeded the allowable number of interrogatories permitted under the Federal Rules”. Cathcart Decl. ¶ 12, Exh. D. Plainly, 37 CFR § 2.120(d)(1) provides for 75 interrogatories, and states in relevant part: “the total number of written interrogatories which a party may serve upon another party pursuant to Rule 33 of the Federal Rules of Civil Procedure, in a proceeding shall not exceed 75 counting subparts, except that the Trademark Trial and Appeal Board may allow additional interrogatories.”

Since Rule 37(a) of the Fed. R. Civ. P. provides that “for purposes of this subdivision (a) an evasive or incomplete disclosure, answer or response is to be treated as a failure to disclose, answer or respond”, Applicant should be compelled to answer the Interrogatories as

put, without objections, on the merit. *See, e.g., No Fear Inc. v. Rule*, 54 U.S.P.Q. 2d 1551 (TTAB 2000); *Crane Co. v. Shimano Industrial Co., Ltd.* 184 U.S.P.Q. 691 (TTAB 1975)

II.

OPPOSER REQUESTS THAT ALL PENDING DISCOVERY BE STAYED

In the instant case, it is apparent that Applicant is not acting in good faith with respect to its discovery obligations and that absent an order compelling its compliance, Applicant will continue to attempt to frustrate and impede the discovery process to Opposer's detriment. Towards this end, Opposer respectfully requests that the Board stays all pending discovery requests including Applicant's Interrogatory and Document Requests served on Opposer on June 27, 2013. A stay is particularly appropriate here, given the need for an Order imposing the Modified Protective Order discussed *infra*. This will negate a significant portion of Applicant's feigned "excuse" not to produce confidential documents and shall allow Opposer to do the same with the understanding that both parties and their counsel are signatories to the Protective Order. Further too, in many instances, Applicant propounds the identical or substantially similar discovery requests that Opposer has served on Applicant and to which Applicant has objected. It is well settled that one cannot object to discovery requests that one has likewise propounded. *See, e.g., Sentrol, Inc. v. Sentex Systems, Inc.*, 231 U.S.P.Q. 666, 667 (TTAB 1986).

Furthermore, it bears noting that Opposer takes instruction from an Italian law firm and Opposer is located in Italy. Cathcart Dec'l. ¶¶ 21 and 22. It will be exceedingly difficult to obtain meaningful information and a good faith reasonable search of Opposer's records in late July or August given that key individuals are or will be away from their offices for extended periods of time given much more liberal vacations or "holiday" customary in Europe. Cathcart Dec'l. ¶¶ 21 and 22.

III.

OPPOSER MOVES FOR ENTRY OF MODIFIED PROTECTIVE ORDER

Opposer respectfully moves the Board to order the entry of the Modified Protective Order at Exhibit C to the Cathcart Dec'l. and that all parties and their respective counsel be required to sign same before entry.

On or about January 17, 2013 when Opposer's counsel and Applicant's counsel engaged in the mandatory discovery/settlement conference, the parties had seemingly agreed to a modified standard Protective Order. Cathcart Dec'l., ¶ 5.

At no time did Applicant ever subsequently object thereto, even after Opposer sent the Modified Protective Order along with its discovery requests to Applicant. Applicant for the first time conveniently raised the issue of revising the Modified Protective Order after serving its sham discovery responses and prior to serving its discovery requests upon Opposer. It is obvious that Applicant will attempt to impede and frustrate every facet of the discovery process and therefore, rather than engage in protracted negotiations with Applicant for an acceptable Protective Order, Opposer respectfully moves the Board to Order that the parties sign the attached Modified Standard Protective Order and thereafter enter it before the Board.

As stated in the TBMP §412.03, "it is unclear whether the Board can order parties to enter into a contract that will govern the protection of information after the Board proceeding is concluded [citation omitted]. Thus, it may be advisable for both parties and their attorneys to sign a stipulated protective order so it is clear that they are all bound thereby" . . . (Emphasis Added.)

Here, it is particularly important to have the Modified Protective Order in place as it is unclear whether Applicant or its assignee is the owner of Applicant's applied-for DIVA COUTURE mark.

IV.

OPPOSER IS ENTITLED TO SANCTIONS

Given Applicant's willful and/or non-excusable discovery non-compliance, and refusal to execute the agreed upon Standard Protective Order, the Board should impose sanctions on Applicant. Applicant's bad faith is underscored by (i) its sham objections To Opposer's First Set of Interrogatories and Document Requests, (ii) its utter failure to produce a single document (iii) Applicant's refusal to respond to a single interrogatory and (iv) Applicant's refusal to sign the Modified Standard Protective Order.¹ Cathcart Decl.

TBMP §527.01(c) entitled "Untimely Response to Discovery Requests" provides, in relevant part:

"A party which fails to respond to a request for discovery... during the time allowed therefor... may be found, upon motion to compel filed by the propounding party, to have forfeited its right to object to the discovery requests on its merits. Objections going to the merits of a discovery request include claims that the... request is irrelevant, overly broad, unduly vague and ambiguous, burdensome and oppressive.(Emphasis added)

Applicant's conduct during discovery can only be characterized as an abuse of the discovery process.

Applicant's dilatory tactics are underscored by Applicant's refusal to sign the agreed upon Modified Protective Order. Despite agreeing to the Modified Protective Order more than 5

¹ Applicant cannot argue that its false claim that Opposer exceeded the number of allowable interrogatories was occasioned by counsel's ignorance that the applicable Board rules provide for 75 interrogatories in *inter partes* Board proceedings, as law office action failure or incompetence does not constitute grounds for excusable neglect. TMBP § 509 states "Under our system of representative litigation, a party must be held accountable for the acts or omissions of its chosen counsel".

months ago (Cathcart Dec'l., ¶¶ 5-8), Applicant has refused to execute same, presumably as a pretext to justify not producing confidential documents or answering confidential interrogatories. Applicant's transparent attempt to abuse the discovery process is manifest given the facts. Opposer sent Applicant the Modified Standard Protective Order on May 16, 2013, along with Opposer's First set Of Interrogatories and First Request For Production of Documents. (Cathcart Decl., ¶ 7) At no time has Applicant ever objected to the Modified Standard Protective Order prior to serving its "sham" discovery responses. Only after the service of its "sham" responses did Applicant for the first time propose changes thereto. (Cathcart Dec'l. ¶ 8, Exh. G.) The folly in this charade is, even assuming, *arguendo*, that Applicant now has a valid basis not to produce confidential information, the absence of the Modified Protective Order cannot justify Applicant's refusal to answer non-confidential interrogatories or to produce non-confidential documents. Further too, the Board's Standard Protective Order is automatically invoked upon commencement of an opposition action. Unless, as Opposer now seeks herein, a party seeks entry of a modified protective order, there is no excuse for Applicant's discovery non-compliance. This is yet another of Applicant's ploys to impede discovery. As the Board is aware, absent the party's (as opposed to counsel's) "execution" of the standard Protective Order, which is automatically invoked in this proceeding, one or more of the parties could conceivably disclose confidential information when these proceedings terminate or in another proceeding, as they are not signatories to the Protective Order which would also be an enforceable bilateral agreement.

Sanctions are appropriate here where Applicant has violated and/or disregarded Board Rules, The Federal Rules of Civil Procedure, discovery deadlines and its discovery obligations. Taking all of the foregoing into consideration, the Board should levy sanctions against Applicant

in the form of ordering Applicant to supplement and produce responsive documents and answers to interrogatories “without objection,” at Applicant’s expense, at the offices of Ladas & Parry. *See No Fear Inc.*, 54 U.S.P.Q. 2d 1551, 1556. (“[A]s a sanction, applicant is directed to copy responsive documents and forward them to opposer, at applicant’s expense”).

CONCLUSION

For the reasons set forth above, Opposer’s Motion to Compel Discovery should be granted in all respects, as follows:

1. The Board should issue an Order compelling Applicant to produce responsive documents, “on the merits” without the aforementioned groundless objections, at Opposer’s attorney’s office, at Applicant’s expense.

2. The Board should issue an Order compelling Applicant to supplement and answer fully, “on the merits” , Opposer’s First Set of Interrogatories, without the aforementioned groundless objections.

3. The Board should issue an Order compelling Applicant to sign the Modified Standard Protective Order immediately, for entry with the Board.

4. The Board should stay proceedings and all outstanding discovery, pending the determination of this motion to compel and re-set discovery and trial deadlines at such time.

Respectfully submitted,

LADAS & PARRY LLP

Attorneys for Opposer
EMANUEL UNGARO ITALIA S.R.L.

Dated: July 16, 2013

By: _____

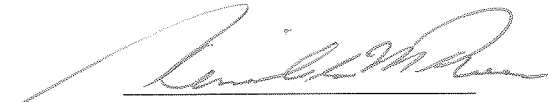


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CERTIFICATE OF TRANSMISSION

I, Reinaldo M. Roa, hereby certify that a copy of the foregoing **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 on the date indicated:

Dated: July 16, 2013



Reinaldo M. Roa

CERTIFICATE OF SERVICE

I, Elvis Vidal, hereby certify that a copy of the foregoing **OPPOSER'S MOTION TO COMPEL DISCOVERY RESPONSES, SANCTIONS, ENTRY OF PROTECTIVE ORDER AND STAY** was served on the person(s) listed below by hand, on the date indicated:

Alison Naidech Carlson, Esq.
SALANS LLP
Rockefeller Center
620 Fifth Avenue
New York, NY 10020

Dated: July 16, 2013



Elvis Vidal