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

Proceeding	91208855
Party	Defendant The Wine Group LLC
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BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE

TRADEMARK TRIAL AND APPEAL BOARD

Application Serial No. 85/736,374

Mark: (B)URBAN

Class: 33

GREATER LOUISVILLE CONVENTION & VISITORS BUREAU, Opposer/Respondent, v. **THE WINE GROUP, LLC,** Applicant/Counterclaimant.	Opposition No. 91208855 **APPLICANT'S REPLY ON MOTION TO COMPEL**

The Wine Group ("TWG") hereby replies to GLCVB's Opposition memorandum.

The correspondence in Exhibit 1 to TWG's motion clearly shows that Opposer did not participate in the meet and confer process in good faith. It provided no explanations for its objections and declined to discuss them with opposing counsel. Opposer has now done what it should have done during the meet and confer process, namely, explained its objections. This kind of bad faith, sharp practice would likely be sanctioned in Federal Court. Regrettably, the Board does not have that authority.

DOCUMENT PRODUCTION ISSUES

- **Equivocal Responses**

Each of GLCVB's written responses was equivocal as to the existence of responsive documents and TWG requested that the Board order unequivocal responses (TWG Mem. at 2:21-

3:20). GLCVB's response simply changed the subject and accused TWG of doing the same thing, which is not true (GLCVB Mem. at 10-11).[1] The authorities cited in TWG's memorandum are unambiguous that a party must state whether it has responsible documents. Otherwise, what is the point of doing responses to each specific document requests? GLCVB should be ordered to provide an unequivocal response to each request as to whether there are responsive documents.

- **All Responsive Documents Must Be Produced**

TWG objected to GLCVB's extraordinary and unprecedented procedure for producing its documents to TWG (TWG Mem. at 3:21-4:11). GLCVB's response does not defend its novel procedure. Instead, it now offers to "permit inspection and copying of all of the non-privileged [responsive] documents … except for the few objected-to requests." (GLCVB Mem. at 11). This is meaningless: (a) because GLCVB has objected to all of the requests so, on its face, GLCVB is agreeing to produce nothing and (b) because GLCVB still maintains that it is not obligated to tell TWG the requests to which it has responsive documents.

- **Copying vs. Inspection**

TWG requested that GLCVB be ordered to copy and send the responsive documents to TWG (TWG Mem. at 4:12-5:5). GLCVB argues in response that this is not required by Rule 34. (GLCVB Mem. at 7-8). This misses the point: both parties requested that documents be copied and sent to the other in their instructions, and under the *Amazon Technologies* case GLCVB should be estopped from insisting on a procedure different from the one it requested of TWG.

GLCVB asserts two additional justifications for its position. First, it argues that its burden to produce documents is greater than TWG's because its marks are in use and TWG's are

[1] As shown in GLCVB Exhibit 20, TWG provided unequivocal responses to GLCVB's request.

not (GLCVB Mem. at 9). There is nothing in the Rules of Civil Procedure that requires parties to shoulder equal burdens in discovery and GLCVB cites no authority that point. In fact, GLCVB's argument could be made every time the owner of a registered trademark (which by definition is in use) opposes an ITU application. The reality is that GLCVB is the Opposer, it has the burden of proof and if its marks are as well-known as claimed it will have a lot of responsive documents. TWG is entitled to those documents so that it can defend the case.

To bolster its "burden" argument GLCVB submits three identical declarations stating that it will be a burden to search for, copy and produce the documents. The declarations give no order of magnitude of this challenge and no specifics (are we talking about 1,000,000 or 100 documents?) .– which is quite curious since the documents should have been identified at the time the written response was filed (otherwise, counsel would have been unable to prepare a response to the requests). And to the extent that GLCVB does not want to spend the time copying documents, it should have thought of that before it filed the opposition. In any event, this is a red herring because GLCVB is going to have to copy the documents anyway so that they can be produced to TWG. Thus, the only thing gained by GLCVB's refusal to copy and mail the documents now is the satisfaction of making TWG pay to fly its counsel from San Francisco to Louisville for a 15 minute look at the documents and a verbal instruction to copy all of them so that they can be reviewed in counsel's office in California. Since GLCVB will also have to pay for its counsel to fly from Baltimore to Louisville, this is so economically irrational that it cannot have been made in good faith.

Second, GLCVB claims that TWG insisted on the same procedure and that its counsel is agreeable to it. (GLCVB Mem. at 9-10). This is Russian History. TWG is more than happy to

comply with GLCVB's instructions that the documents be copied and sent to its counsel: that is

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the smart and sensible thing to do. But it was obviously disinclined to do so once GLCVB insisted that TWG's counsel fly to Louisville simply to give an instruction to copy everything.[2]

SPECIFIC DOCUMENT REQUESTS

- **Request 26**

GLCVB is a licensee of one of the marks on which it has based this opposition. TWG requested documents concerning the quality control exercised by the licensor over the mark. (TWG Mem. at 5:7-14). GLCVB now explains that the request is ambiguous because it did not mention quality control in the Notice of Opposition. (GLCVB Mem. at 3-4).

This is schoolyard childish. The meaning of this request was explained in the meet and confer letter of June 26, 2013 (TWG Exhibit 1) and as experienced trademark counsel GLCVB's counsel knows exactly what the request means and why it was asked, yet his response to TWG's explanation during the meet and confer process was "we stand by our objection." (TWG Exhibit 1, July 3, 2013 letter). TWG never should have had to file a motion to compel on this.

- **Request 32**

This request concerns communications between GLCVB and the licensor, which is obviously reasonably calculated to lead to the discovery of admissible evidence. GLCVB simply refused to produce any responsive documents and it provided no justification for this refusal during the meet and confer process. (TWG Mem. at 5:7- 6:4).

[2] GLCVB's counsel selected the dates for the document production and deposition in California without consulting TWG's counsel. Immediately on receipt of the deposition notice TWG's counsel informed GLCVB's counsel that he was unavailable that week.

GLCVB now asserts that the request is overbroad. It does not specify how or why, but refers simply to the three generalized declarations submitted with this opposition. (GLCVB Mem. at 6). This is not nearly enough information to assess the validity of the objection. More importantly, however, this registration is on the Supplemental Register and GLCVB has stated its intention to prove that the mark has acquired distinctiveness. (TWG. Mem. at 5:17-18-6:1-2). Proof of acquired distinctiveness is very difficult and requires a substantial amount of information concerning use of the mark. *See, e.g., In re Franklin County Historical Society*, 104 U.S.P.Q.2d 1085 (TTAB 2012). It is disingenuous for GLCVB to claim on the one hand that it has the kind of voluminous evidence of use necessary to prove acquired distinctiveness and then, on the other, claim it is too burdensome to produce in discovery.

- **Request 30**

This request sought documents concerning third party uses of BOURBON in trademarks. This is plainly relevant on the sixth *DuPont* factor. GLCVB said it would not produce any documents responsive to this requests and did not attempt to explain why during the meet and confer process. (TWG Mem. at 6:5-13).

GLCVB now asserts that the request is not relevant and overbroad because GLCVB has other marks containing the term BOURBON. (GLCVB Mem. at 4). The marks relied on by GLCVB in this opposition contain the term "Bourbon." Other marks that contain the term "Bourbon" are plainly relevant under the sixth *DuPont* factor. Again, the burden argument rings hollow in light of the facts that GLCVB did not raise it during the meet and confer process and GLCVB is the opposer.

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REQUESTS FOR ADMISSION

GLCVB's response to each of the disputed Requests for Admission is, again, a children's playground semantic game that easily could have been negotiated during the meet and confer process if GLCVB had participated in it.

- **Request for Admission 3**

TWG Exhibit 5 which was signed by the GLCVB's current counsel under oath plainly and unequivocally claims the first use date as October 20, 2011. To deny this request is indefensible, and (as alleged in GLCVB's response at p.1) does not in any way prohibit GLCVB from attempting to prove an earlier date. This denial was not made in good faith and it should have been admitted.

- **Request For Admission 36 and 37**

This is a good example of how the failure to participate in the meet and confer process caused TWG's counsel and the Board to waste their time on a motion that was avoidable. If GLCVB's counsel had answered the request properly by admitting that portion of it that could be admitted and denying that the mark was URBAN BOURBON EXPERIENCE, or engaging in a good faith meet and confer process, this never would have been brought to the Board. Since this is the only objection to these requests, obviously, GLCVB will admit them if URBAN BOURBON EXPERIENCE in the requests is changed to URBAN BOURBON TRAIL.

CONCLUSION

For the foregoing reasons TWG requests that the motion be granted and, if necessary, the Board hold a prompt telephonic hearing so that discovery can proceed in the case.

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Respectfully submitted,

LAW OFFICE OF PAUL W. REIDL

By: /s/ Paul W. Reidl

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Dated: August 13, 2013

PROOF OF SERVICE

On August 13, 2013, I caused to be served the following document:

APPLICANT'S REPLY ON MOTION TO COMPEL

on Opposer by placing a true copy thereof in the United States mail enclosed in an envelope, postage prepaid, addressed as follows to their counsel of record at his present business address:

John A. Galbreath
Galbreath Law Offices
2516 Chestnut Woods Ct.
Reiseterstown, MD 21136-5523

Executed on August 13, 2013 at Half Moon Bay, California.