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

Proceeding	91214615
Party	Plaintiff Transamerica Corporation
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Signature	/Bruce A. McDonald/
Date	08/08/2014
Attachments	Motion to Quash Subpoenas and For Protective Order & Attachments 1-8.pdf(2690114 bytes )

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

Serial No. 85889202  
OWN YOUR TOMORROW

TRANSAMERICA CORPORATION,	:	
	:	
Opposer,	:	Opposition No. 91214615
	:	
v.	:	
	:	
CHARLES SCHWAB & CO., INC.,	:	
	:	
Applicant.	:	

**MOTION TO QUASH SUBPOENAS AND FOR PROTECTIVE ORDER**

Opposer, pursuant to Sections 521 and 526 of the Trademark Trial and Appeal Board Manual of Procedure, and Rule 2.120(f) of the Trademark Rules of Practice, 37 C.F.R. § 2.120(f), moves the Board to quash, without prejudice, the two subpoenas issued by Applicant on July 24, 2014, out of the U.S. District Court for the Southern District of New York, directed to Opposer’s advertising and media agencies, copies appended hereto as Attachments 1 and 2, respectively. As grounds for this Motion, Opposer submits that any and all discoverable material designated in these subpoenas can be obtained directly from Opposer, and has been requested from Opposer in two sets of discovery requests, one of which has been answered by Opposer, the other of which is pending. If and when Applicant is unable to obtain the discoverable information and documents designated in these subpoenas directly from Opposer, then, and only then, should Applicant be allowed to go forward with subpoenas directed to Opposer’s advertising and media agencies or other third parties.

One of the subpoenas (Attachment 1) is directed to Opposer’s advertising agency, J. Walter Thompson U.S.A., LLC (“JWT”). This advertising agency was identified by Opposer in

response to Applicant's first set of discovery requests. The other subpoena (Attachment 2) is directed to an affiliate of JWT named Mindshare New York ("Mindshare").<sup>1</sup> The information and documents requested in these subpoenas is materially identical to information and documents called for in discovery requests propounded by Applicant and produced or identified by Opposer in response thereto, as illustrated in the following numbered attachments:

<b><u>Att.</u></b>	<b><u>Description</u></b>
3	Transamerica's Answers and Objections to Schwab's First Set of Interrogatories, Dated July 23, 2014
4	Transamerica's Response to Schwab's First Request for Production of Documents and Things, Dated July 25, 2014
5	Schwab's Second Set of Interrogatories, Dated July 25, 2014
6	Schwab's Second Request for Production of Documents, Dated July 25, 2014
7	Schwab's Fed.R.Civ.P. 30(b)(6) Notice of Deposition, dated July 31, 2014

The advertising and media agencies to whom Applicant's subpoenas are directed, JWT and Mindshare, were contractually engaged by Opposer in the ordinary course of their business. *See* Declaration of Jennifer Tafet Klausner, ¶ 1, appended hereto as Attachment 8. Under that contractual relationship, substantially any and all discoverable material called for by the subpoenas is either in the possession of Opposer or available to Opposer from JWT and Mindshare upon request. *Id.* Moreover, Opposer is required to indemnify JWT and Mindshare for attorneys' fees and expenses incurred in response to such subpoenas. *Id.*, ¶ 2. Applicant has no need or apparent purpose in propounding these subpoenas other than to harass Opposer and its advertising and media agencies with duplicative and unnecessary requests.

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<sup>1</sup> The actual name of the corporate entity is Mindshare USA, LLC.

### **Certificate Of Good Faith Attempt To Confer**

Pursuant to Fed.R.Civ.P. 26(c)(1) and TBMP § 412.06, undersigned counsel certifies that he has conferred with opposing counsel Laura Franco by telephone, email and written correspondence, in an effort to resolve this dispute, but that opposing counsel has declined to withdraw the subpoenas.

#### **Argument**

The scope of discovery in a Board proceeding is governed by Fed. R. Civ. P. 26(b), which provides that a party is entitled to discovery regarding any matter, not privileged, which is relevant to the subject matter of the proceeding, and which appears reasonably calculated to lead to the discovery of admissible evidence. *See* TBMP § 402. Consistent with that rule, a party is permitted to take the discovery deposition of “any person.” *See* TBMP § 404.03 *et seq.* However, the right to discovery is not unlimited. Both the Trademark Rules and the Federal Rules of Civil Procedure grant the Board discretion to manage the discovery process in order to balance the requesting party's need for information against any injury that may result from discovery abuse. *See* TBMP § 402.02; *Micro Motion Inc. v. Kane Steel Co.*, 894 F.2d 1318, 1325, 13 USPQ2d 1696, 1701 (Fed. Cir. 1990).

#### **I. The Subpoenas Are Materially Identical to Applicant’s Discovery Requests.**

Fed. R. Civ. P. 34(a) provides that a party may request documents and things “which are in the possession, custody or control of the party upon whom the request is served.” Control with respect to the production of documents is defined “not only as possession, but as the legal right to obtain the documents requested upon demand.” *Cochran Consulting, Inc. v. Uwatec USA, Inc.*, 102 F.3d 1224, 1229-1230, 41 USPQ2d 1161, 1166 (Fed. Cir. 1996) (quoting *Searock*

*v. Stripling*, 736 F.2d 650, 653 (11th Cir. 1984)).<sup>2</sup> If documents are available from a party, they should be obtained pursuant to Rule 34 rather than subpoenaing them from a nonparty witness. See *Wright & Miller*, 8A Fed. Prac. & Proc. Civ.2d § 2204 (1990); *Haworth Inc. v. Herman Miller Inc.*, 998 F. 2d 975, 978, 27 USPQ2d 1469, 1472 ( Fed. Cir. 1993) (“court could properly require [party] to seek discovery from its party opponent before burdening the nonparty”).

Parties have been found to have a legal right to obtain requested documents that have been turned over to the party's attorney, its insurer, a related company, or a former employee who receives compensation. *Wright & Miller*, 8A Fed. Prac. & Proc. Civ.2d § 2210 (1990) (citing authorities); see also *Alper v. U.S.A.*, 190 F.R.D. 281, 283 (D. Mass 2000) (“Given the fact that Dr. Becker is Defendant's expert, the documents which Plaintiff seeks from him may be considered to be within Defendant's control.”).

As JWT and Mindshare are employed by Opposer for the provision of advertising agency and media services, Opposer either has possession of any and all discoverable information and documents designated in the subpoenas, or has the “legal right to obtain” such documents and information from JWT and Mindshare “upon demand.” *Cochran Consulting, id.*; Declaration of Jennifer Tafet Klausner, ¶ 1 (Attachment 8 hereto). The subpoenas are improper on that basis alone.

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<sup>2</sup> Lack of control may be considered an objection to the discovery request and, like any such objection, it may be waived. *Wright & Miller*, 8A Fed. Prac. & Proc. Civ.2d § 2210 (1994, updated by 2005 Pocket Part); *Henderson v. Zurn Indus., Inc.*, 131 F.R.D. 560, 564 (D. Ind. 1990).

**II. A Protective Order is Necessary to Prevent Applicant from Harassing Opposer and its Advertising and Media Agencies With Cumulative and Vexatious Discovery Requests.**

Section 402.02 of the TTAB Manual of Procedure states:

The right to discovery is not unlimited. Even if the discovery sought by a party is relevant, it will be limited, or not permitted, where, *inter alia*, it is unreasonably cumulative or duplicative; or is unduly burdensome or obtainable from some other source that is more convenient, less burdensome, or less expensive; or “where harm to the person from whom discovery is sought outweighs the need of the person seeking discovery of the information.”

TBMP § 402.02 (emphasis added) (citing authorities).

Section 521 of the TTAB Manual of Procedure provides that “[a] party to an *inter partes* proceeding before the Board may file a motion, prior to the taking of a noticed discovery or testimony deposition, to quash the notice of deposition.” TBMP § 521. “Alternatively, in the case of a notice of discovery deposition and under appropriate circumstances, the party may file a motion for a protective order.” *Id.* (citing authorities). A motion to quash may be filed, for example, on the grounds that the discovery “constitutes harassment or is without proper basis[.]” *Id.*

The need for a protective order in the present case arises from Applicant’s sweeping requests to Opposer’s advertising and media agencies – non-parties - for information and documents substantially identical to the information and documents requested from Opposer in Applicant’s pending discovery requests. A protective order is required because the subpoenas constitute clear harassment, and because neither of the entities on which they have been served is a real “party in interest,” TBMP § 526 (citing authorities). *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1764 (TTAB 1999).

Courts have broad discretion in supervising discovery and striking a balance between disclosure and non-disclosure. *Richards of Rockford, Inc. v. Pacific Gas & Elec. Co.*, 71 F.R.D.

388, 389 (N.D.Cal., 1976). Whether the deponent is a party and whether the information sought is available from other sources are two relevant considerations. *Id.* at 390. “Courts do not favor unnecessarily burdening nonparties with discovery requests.” *High Tech Medical Instrumentation, Inc. v. New Image Industries, Inc.*, 161 F.R.D. 86 (N.D.Cal. 1995).

Thus, while a party may take the discovery deposition of “any person” under Fed. R. Civ. P. 30(a), the Board has the power to limit or bar a deposition if it determines that the discovery sought is obtainable from other sources that are more convenient and less burdensome or duplicative. *See* Fed. R. Civ. P. 26; *FMR Corp.*, 51 USPQ2d at 1761; *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America, Inc.*, 74 USPQ2d 1672, 1674 (TTAB 2005).

Pursuant to Fed. R. Civ. P. 26(b), the Board has the power to deny discovery if the party seeking discovery can obtain it from another source that is more convenient, less burdensome, or less expensive, and the Board may properly require a party “to seek discovery from its party opponent before burdening a nonparty.” *Haworth*, 998 F. 2d at 978 (affirming denial of motion to compel non-party to produce settlement documents because party seeking discovery from non-party could obtain the discovery from its adversary, but, despite having served document requests, had not moved to compel its adversary to produce the documents prior to moving to compel non-party to produce the documents). *See also Truswal Systems Corp. v. Hydro-Air Engineering, Inc.*, 813 F.2d 1207, 1210, 2 USPQ2d 1034, 9 Fed. R. Serv. 3d 1274 (Fed. Cir. 1987) (“In assessing the burden of complying with a subpoena, a court may consider as one factor that a deponent is not a party.”)<sup>3</sup>

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<sup>3</sup> *Accord, Buckhorn, Inc. v. Orbis, Inc.*, 10-MC-71, 2010 WL 4941726, \*1 (E.D. Wis. 2010); *In re Motion to Compel Compliance with Subpoena Direct to Dept. of Veterans Affairs*, 257 F.R.D. 12, 2009 WL 1139231, \*7–\*8 (D.D.C. 2009), *denying motion for reconsideration*, 08-525, 2009 WL 2868756 (D.D.C. Sept. 3, 2009); *Kim v. NuVasive, Inc.*, 11-cv-1370-DMS (NLS), 2011 WL 3844106, \*3–\*4 (S.D. Cal. Aug. 29, 2011); *Morrow v. Air Ride*

In *Haworth*, Herman Miller, Inc. (“Herman Miller”) appealed an order of the United States District Court for the Northern District of Illinois in an ancillary proceeding to obtain discovery from Allsteel, a non-party. Herman Miller served upon non-party Allsteel a subpoena which demanded production of certain documents, including documents pertaining to a settlement agreement reached between Haworth and Allsteel. Allsteel refused to produce the settlement agreement on the grounds that it would violate its duty of confidentiality imposed by the agreement. At some point, Herman Miller also sought the settlement agreement from Haworth. Herman Miller then moved first to compel production of the settlement agreement from non-party Allsteel. The Illinois district court denied Herman Miller's motion to compel, holding that:

If [Herman] Miller is seeking the settlement agreement, surely the same settlement agreement should be produced whether by Allsteel or Haworth. Moreover, any objections to the discoverability of such documents could then be ruled upon in the Northern District of Georgia, by the judge who is presiding over the underlying case.

998 F.2d at 977.

The district court in *Haworth* concluded that the party seeking information from a non-party witness was first required to seek that information from the opposing party, stating:

We find that the notions of judicial economy and efficiency require us to deny the motion to compel Allsteel to produce the settlement documents. Miller should first attempt to

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*Technologies, Inc.*, IP-05-113, 2006 WL 559288 (S.D. Ind. 2006); *Nidec Corp. v. Victor Co. of Japan*, C-05-086, 2007 WL 1941775 (N.D. Cal. 2007), *order amended and superseded*, 2007 WL 1994171 (N.D. Cal. 2007); *PSN Illinois, LLC v. Abbott Labs, Inc.*, 11-1588, 2011 WL 5508624, \*3–\*5 (D.N.J. 2011); *Rockwell Automation, Inc. v. Kontron Modular Computers*, 12-cv-566, 2012 WL 5197934, \*6–\*10 (S.D. Cal. 2012); *MacDermid Printing Solutions, L.L.C. v. E.I. Du Pont De Nemours and Co.*, 1:10MC37, 2012 WL 734146, \*3 (M.D. N.C. 2012); *Versata Software v. Internet Brands, Inc.*, 11-MC-50844, 2011 WL 4905665, \*2 (E.D. Mich. 2011).



obtain the desired documents from the opposing party, Haworth, in the court which is presiding over the underlying case, the Northern District of Georgia.

*Id.* The U.S. Court of Appeals for the Federal Circuit agreed, stating:

Fed.R.Civ.P. 26(b), relating to the general scope and limits of discovery, expressly acknowledges that a court may limit discovery if it determines that the discovery sought ‘is obtainable from some other source that is more convenient, less burdensome, or less expensive.’ Thus, this court has noted that the need for discovery in an ancillary proceeding ‘is diminished when the information is available elsewhere.’ [ ] Consistent with this authority, the district court could properly require Herman Miller to seek discovery from its party opponent before burdening the nonparty Allsteel with this ancillary proceeding. That is all that the district court has done here. It has not forbidden Herman Miller from obtaining the settlement documents from Allsteel; it has merely required that Herman Miller first seek them from Haworth.

*Id.* at 978 (emphasis added) (citations omitted).

As in *Haworth*, any and all discoverable information and documents sought by Applicant in its subpoenas to Opposer’s advertising and media agencies are either within the custody or control of Opposer by reason of its relationship with those agencies, or available to Opposer from those agencies upon request. Moreover, the information and documents designated in the subpoenas are materially identical to the information and documents sought in Applicant’s pending discovery requests. Applicant’s subpoenas are therefore improper or, at best, premature.

### **Conclusion**

Like the Plaintiff in *Haworth*, Opposer seeks only an order quashing the third-party subpoenas, and preventing Applicant from pursuing third-party discovery against Opposer’s advertising and media agencies, pending an opportunity for Applicant to obtain the requested information and documents directly from Opposer, not an unqualified prohibition

against Applicant from conducting third-party discovery. The justification for a limited protective order to this effect is fully apparent.

Respectfully submitted,



Dated: Aug. 8, 2014

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**Attachments**

<b><u>Att.</u></b>	<b><u>Description</u></b>
1	Subpoena to J. Walter Thompson USA, LLC.
2	Subpoena to Mindshare USA, LLC
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8	Declaration of Jennifer Tafet Klausner

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that on August 8, 2014, a copy of the foregoing OP-POSER'S MOTION TO QUASH SUBPOENAS AND FOR PROTECTIVE ORDER was served by electronic mail on the following counsel of record for Applicant at the email addresses indicated below:

Laura M Franco, Esq., [lfranco@winston.com](mailto:lfranco@winston.com)  
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Bruce A. McDonald  
Attorney  
BUCHANAN INGERSOLL & ROONEY PC

UNITED STATES DISTRICT COURT

for the

Southern District of New York

Transamerica Corporation

Plaintiff

v.

Charles Schwab & Co., Inc.

Defendant

Civil Action No. USPTO Opp. No. 91214615

(If the action is pending in another district, state where: United States Patent and Trademark Office)

SUBPOENA TO TESTIFY AT A DEPOSITION IN A CIVIL ACTION

To: J. Walter Thompson U.S.A., Inc. 466 Lexington Avenue, Suite 6R, New York, NY 10017

Testimony: YOU ARE COMMANDED to appear at the time, date, and place set forth below to testify at a deposition to be taken in this civil action. If you are an organization that is not a party in this case, you must designate one or more officers, directors, or managing agents, or designate other persons who consent to testify on your behalf about the following matters, or those set forth in an attachment:

SEE ATTACHED EXHIBIT A FOR DEPOSITION TOPICS

Table with 2 columns: Place (Winston & Strawn, LLP, 200 Park Avenue, New York, NY 10017) and Date and Time (09/09/2014 10:00 am)

The deposition will be recorded by this method: Video

Production: You, or your representatives, must also bring with you to the deposition the following documents, electronically stored information, or objects, and permit their inspection, copying, testing, or sampling of the material:

SEE ATTACHED EXHIBIT A FOR DOCUMENT REQUESTS

Please produce documents to Winston & Strawn, LLP, 101 California Street, San Francisco, CA 94111 no later than August 19, 2014.

The provisions of Fed. R. Civ. P. 45(c), relating to your protection as a person subject to a subpoena, and Rule 45 (d) and (e), relating to your duty to respond to this subpoena and the potential consequences of not doing so, are attached.

Date: 07/24/2014

CLERK OF COURT

OR

Handwritten signature of Laura M. Franco

Laura M. Franco Attorney's signature

Signature of Clerk or Deputy Clerk

The name, address, e-mail, and telephone number of the attorney representing (name of party) Charles Schwab & Co., Inc., who issues or requests this-subpoena, are:

Laura M. Franco Winston & Strawn, LLP 101 California Street, San Francisco, CA 94111 (415) 591-1000 lfranco@winston.com

Civil Action No. USPTO Opp. No. 91214615

**PROOF OF SERVICE**

*(This section should not be filed with the court unless required by Fed. R. Civ. P. 45.)*

This subpoena for *(name of individual and title, if any)* \_\_\_\_\_  
was received by me on *(date)* \_\_\_\_\_.

I served the subpoena by delivering a copy to the named individual as follows: \_\_\_\_\_  
\_\_\_\_\_ on *(date)* \_\_\_\_\_; or

I returned the subpoena unexecuted because: \_\_\_\_\_  
\_\_\_\_\_.

Unless the subpoena was issued on behalf of the United States, or one of its officers or agents, I have also  
tendered to the witness fees for one day's attendance, and the mileage allowed by law, in the amount of  
\$ \_\_\_\_\_.

My fees are \$ \_\_\_\_\_ for travel and \$ \_\_\_\_\_ for services, for a total of \$ 0.00.

I declare under penalty of perjury that this information is true.

Date: \_\_\_\_\_

\_\_\_\_\_  
*Server's signature*

\_\_\_\_\_  
*Printed name and title*

\_\_\_\_\_  
*Server's address*

Additional information regarding attempted service, etc:



**Federal Rule of Civil Procedure 45 (c), (d), and (e) (Effective 12/1/07)**

**(c) Protecting a Person Subject to a Subpoena.**

**(1) *Avoiding Undue Burden or Expense; Sanctions.*** A party or attorney responsible for issuing and serving a subpoena must take reasonable steps to avoid imposing undue burden or expense on a person subject to the subpoena. The issuing court must enforce this duty and impose an appropriate sanction — which may include lost earnings and reasonable attorney’s fees — on a party or attorney who fails to comply.

**(2) *Command to Produce Materials or Permit Inspection.***

**(A) *Appearance Not Required.*** A person commanded to produce documents, electronically stored information, or tangible things, or to permit the inspection of premises, need not appear in person at the place of production or inspection unless also commanded to appear for a deposition, hearing, or trial.

**(B) *Objections.*** A person commanded to produce documents or tangible things or to permit inspection may serve on the party or attorney designated in the subpoena a written objection to inspecting, copying, testing or sampling any or all of the materials or to inspecting the premises — or to producing electronically stored information in the form or forms requested. The objection must be served before the earlier of the time specified for compliance or 14 days after the subpoena is served. If an objection is made, the following rules apply:

**(i)** At any time, on notice to the commanded person, the serving party may move the issuing court for an order compelling production or inspection.

**(ii)** These acts may be required only as directed in the order, and the order must protect a person who is neither a party nor a party’s officer from significant expense resulting from compliance.

**(3) *Quashing or Modifying a Subpoena.***

**(A) *When Required.*** On timely motion, the issuing court must quash or modify a subpoena that:

**(i)** fails to allow a reasonable time to comply;

**(ii)** requires a person who is neither a party nor a party’s officer to travel more than 100 miles from where that person resides, is employed, or regularly transacts business in person — except that, subject to Rule 45(c)(3)(B)(iii), the person may be commanded to attend a trial by traveling from any such place within the state where the trial is held;

**(iii)** requires disclosure of privileged or other protected matter, if no exception or waiver applies; or

**(iv)** subjects a person to undue burden.

**(B) *When Permitted.*** To protect a person subject to or affected by a subpoena, the issuing court may, on motion, quash or modify the subpoena if it requires:

**(i)** disclosing a trade secret or other confidential research, development, or commercial information;

**(ii)** disclosing an unretained expert’s opinion or information that does not describe specific occurrences in dispute and results from the expert’s study that was not requested by a party; or

**(iii)** a person who is neither a party nor a party’s officer to incur substantial expense to travel more than 100 miles to attend trial.

**(C) *Specifying Conditions as an Alternative.*** In the circumstances described in Rule 45(c)(3)(B), the court may, instead of quashing or modifying a subpoena, order appearance or production under specified conditions if the serving party:

**(i)** shows a substantial need for the testimony or material that cannot be otherwise met without undue hardship; and

**(ii)** ensures that the subpoenaed person will be reasonably compensated.

**(d) Duties in Responding to a Subpoena.**

**(1) *Producing Documents or Electronically Stored Information.*** These procedures apply to producing documents or electronically stored information:

**(A) *Documents.*** A person responding to a subpoena to produce documents must produce them as they are kept in the ordinary course of business or must organize and label them to correspond to the categories in the demand.

**(B) *Form for Producing Electronically Stored Information Not Specified.*** If a subpoena does not specify a form for producing electronically stored information, the person responding must produce it in a form or forms in which it is ordinarily maintained or in a reasonably usable form or forms.

**(C) *Electronically Stored Information Produced in Only One Form.*** The person responding need not produce the same electronically stored information in more than one form.

**(D) *Inaccessible Electronically Stored Information.*** The person responding need not provide discovery of electronically stored information from sources that the person identifies as not reasonably accessible because of undue burden or cost. On motion to compel discovery or for a protective order, the person responding must show that the information is not reasonably accessible because of undue burden or cost. If that showing is made, the court may nonetheless order discovery from such sources if the requesting party shows good cause, considering the limitations of Rule 26(b)(2)(C). The court may specify conditions for the discovery.

**(2) *Claiming Privilege or Protection.***

**(A) *Information Withheld.*** A person withholding subpoenaed information under a claim that it is privileged or subject to protection as trial-preparation material must:

**(i)** expressly make the claim; and

**(ii)** describe the nature of the withheld documents, communications, or tangible things in a manner that, without revealing information itself privileged or protected, will enable the parties to assess the claim.

**(B) *Information Produced.*** If information produced in response to a subpoena is subject to a claim of privilege or of protection as trial-preparation material, the person making the claim may notify any party that received the information of the claim and the basis for it. After being notified, a party must promptly return, sequester, or destroy the specified information and any copies it has; must not use or disclose the information until the claim is resolved; must take reasonable steps to retrieve the information if the party disclosed it before being notified; and may promptly present the information to the court under seal for a determination of the claim. The person who produced the information must preserve the information until the claim is resolved.

**(e) *Contempt.*** The issuing court may hold in contempt a person who, having been served, fails without adequate excuse to obey the subpoena. A nonparty’s failure to obey must be excused if the subpoena purports to require the nonparty to attend or produce at a place outside the limits of Rule 45(c)(3)(A)(ii).



**ATTACHMENT A**

**SUBPOENA TO J. WALTER THOMPSON COMPANY**

For the purpose of this subpoena, the following instructions shall apply and the following terms will have the meaning indicated:

**DEFINITIONS**

1. “You,” “Your,” or “JWT” means J. Walter Thompson Company and its past or present officers, members, employees, agents, independent contractors, assigns, affiliates, predecessors, successors, divisions, departments, bureaus, offices, parents, subsidiaries and any other person acting or purporting to act for or on behalf of, or in privity with J. Walter Thompson Company, and any person controlled by or which controls J. Walter Thompson Company.

2. “Applicant” or “Schwab” means Applicant Charles Schwab & Co., Inc. and its past or present officers, members, employees, agents, independent contractors, assigns, affiliates, predecessors, successors, divisions, departments, bureaus, offices, parents, subsidiaries and any other person acting or purporting to act for or on behalf of, or in privity with Schwab, and any person controlled by or which controls Schwab.

3. “Opposer” or “Transamerica” refers to Transamerica Corporation and its past or present officers, members, employees, agents, independent contractors, assigns, affiliates, predecessors, successors, divisions, departments, bureaus, offices, parents, subsidiaries and any other person acting or purporting to act for or on behalf of, or in privity with Transamerica, and any person controlled by or which controls Transamerica, including but not limited to Transamerica Agency Network, Inc., Life Investors Financial Group, Inc. and Monumental Life Insurance Company.

4. “Opposition” means Opposition No. 91214615 filed by Transamerica in the United States Patent and Trademark Office before the Trademark Trial and Appeal Board.

5. “Application” means U.S. Trademark Application Serial No. 85/889,202 for Schwab’s Mark.

6. "Schwab's Mark" means the mark OWN YOUR TOMORROW, which is the subject of the Application.

7. "Transamerica's Mark" means the mark TRANSFORM YOUR TOMORROW, which is the subject of U.S. Trademark Registration No. 4,325,690.

8. "Services" means all of the services rendered by You or at Your direction to or for Transamerica concerning Transamerica's Mark, including but not limited to the creation and development of the mark and the creation of promotional materials for use in connection with the mark in the U.S., if any.

9. "Documents" shall have the broadest meaning ascribed to it by Federal Rule of Civil Procedure 34, and shall include within its meaning any and all papers, videotapes or video recordings, photographs, films, recordings, memoranda, books, records, accounts, letters, telegrams, correspondence, notes of meetings, notes of conversations, notes of telephone calls, inter-office memoranda or written communications of any nature, instant messages, texts, blogs, social media posts or messages, emails, recordings of conversations either in writing or by means of any mechanical, electrical or digital recording device, notes, papers, reports, analyses, invoices, canceled checks or check stubs, receipts, minutes of meetings, time sheets, diaries, desk calendars, ledgers, schedules, licenses, financial statements, telephone bills, logs and any differing versions of the foregoing whether denominated formal, informal, or otherwise, as well as copies of the foregoing which differ in any way, including handwritten notations or other written or printed matter of any nature, from the original. The foregoing specifically includes the information stored in any form, including electronic form, on a computer or in a computer database or cloud server or otherwise, including electronic mail.

10. The term "concerning" means relating to, discussing, referring to, describing, reflecting, evidencing or constituting.

11. "Communication" means and includes any meeting, conference, face-to-face conversation, telephone conversation, or conference or communication by any medium as well as any written, taped, or recorded communication of any kind whatsoever, through which there is



an expression or exchange of information, whether in speech, writing, or any other form, and shall include all facts surrounding such exchange, including but not limited to, the date of the exchange, the content of the exchange, the parties to the exchange, and any witnesses to the exchange.

12. "All" and "any" shall both mean any, all, each, and every.

13. The terms "and" and "or" shall be construed both conjunctively and disjunctively, and each shall include the other wherever such dual construction will enlarge the scope of the request.

14. The use of the singular form of any word also includes the plural and vice versa.

15. "Including" shall mean including, but not by way of limitation.

16. "Relating to" means concerning, referring to, summarizing, reflecting, constituting, comprising, stating, containing, embodying, pertaining to, identifying, involved with, mentioning, discussing, consisting of, showing, commenting upon, evidencing, supporting, responding to, dealing with, describing, analyzing, or in any way pertinent to that subject.

17. As pertains to a person or entity, "identify" means to state the person/entity's name, title, last known address, and last known telephone number.

18. As pertains to a litigation, "identify" means to state the case name, number, and jurisdiction, and to provide the names of the parties to the case.

19. As pertains to a communication, "identify" means to identify the parties involved in the communication, give the date, time, location, and medium of the communication; and provide a description of the substance of the communication.

20. As pertains to a document, "identify" means to identify the date, form, author, recipient, location; and provide a description of the substance of the document.

21. "Thing" shall mean any physical specimen or other tangible item, other than a document.

### INSTRUCTIONS

1. Unless otherwise stated in a specific request, these requests seek the production of

documents and things created, developed, acquired or otherwise obtained by You during the performance of the Services.

2. These requests are intended to include all documents or electronically stored information and things in Your possession, custody or control (including Your attorneys consultants, agents, other representatives, and other persons or entities subject to Your control), wherever located.

3. The documents or things requested shall be produced either as they are kept in the usual course of business, or organized and labeled to correspond with the requests to which they are responsive. If there are no documents or things responsive to any particular discovery request, You should so state in writing.

4. If You come into possession, custody or control of responsive documents or things between the time of production indicated in this subpoena and the time of trial herein, You shall promptly supplement its earlier production by producing such documents or things in accordance with Your obligations under FRCP 26(e).

5. Produce the original and all copies of each requested document and thing, as well as the file in which they are kept, including all copies which bear any additional file stamps, marginal notes, or other additional markings or writings that do not appear on the original.

6. Complete production is to be made on the date and at the time indicated in the attached subpoena. The inspection and copying will begin at that time and will continue from day to day thereafter until completed.

7. If You contend that any information, document, or thing otherwise requested in this subpoena is excluded from production or discovery, then for each such document or thing:

a. State whether the item shall not be produced because:

- 1) It is claimed to be privileged; or
- 2) It once existed but can no longer be located; or
- 3) It has been lost; or
- 4) It has been destroyed; and



b. If, under a claim of privilege, any document or thing is not produced, state for each such document or thing:

- 1) the type and title of the document or thing; and
- 2) the general subject matter of the content of the document or description of the thing; and
- 3) the date of its creation and/or revision; and
- 4) the identity of the document's author(s), addressee(s), and recipient(s); and
- 5) the nature of the privilege being claimed; and
- 6) in detail, all facts upon which You base Your claim of privilege.

#### **DOCUMENTS TO BE PRODUCED**

1. Documents and things sufficient to identify the specific tasks and deliverables that comprise the Services provided or to be provided by You to Transamerica.

2. All documents and things concerning Transamerica's Mark.

3. All creative briefs, design briefs, story boards, mock-ups, position statements, slide decks, presentations, proposals or other materials concerning Transamerica's Mark.

4. All documents concerning media schedules for advertisements concerning Transamerica's Mark.

5. Documents and things sufficient to identify each and every version or variation of, modification to, or alternative to Transamerica's Mark that You created, developed or encountered while performing the Services, whether or not such version, variation, modification or alternative was presented or proposed by You to Transamerica, and whether or not such version, variation, modification or alternative was or is currently in use.

6. All documents and things concerning the intended or actual uses of Transamerica's Mark.

7. All documents and things, including but not limited to marketing plans, development plans, business plans, or budgetary plans concerning Transamerica's Mark provided to You by Transamerica or on its behalf in connection with providing the Services.

8. Copies of each advertisement or marketing or promotional piece bearing Transamerica's Mark that You created or have in Your possession, including but not limited to brochures, catalogues, circulars, leaflets, direct mail pieces, newspaper and magazine advertisements, commercials (aired on television or radio, cable stations, streamed or downloadable via the Internet or other device), websites, price lists, trade association listings, annual reports, keyword search buys, transcripts of town hall-like discussions and any other material such as labels, tags, packages, containers, decals, stamps, and name plates, and including all drafts thereof.

9. All documents and things concerning the intended or actual geographic scope for advertising and promotion of Transamerica's Mark.

10. All documents and things concerning the intended or actual duration of use of Transamerica's Mark.

11. All documents and things concerning the meaning or message intended to be conveyed by Transamerica's Mark.

12. All documents and things concerning the intended or actual channels of advertising, marketing and promotion for Transamerica's Mark.

13. All documents and things concerning all payments made by Transamerica to You concerning the Services, or otherwise concerning Transamerica's Mark.

14. All documents and things concerning the types, characteristics, geographic locale, or classes of persons intended as the audience for Transamerica's Mark.

15. All documents and things concerning the intended or actual channels of trade and distribution of goods or services offered or sold under Transamerica's Mark.

16. All documents and things concerning the goods or services that were, are, or are intended to be offered or sold under Transamerica's Mark.



17. All documents and things concerning or comprising any consumer or marketing survey, test, analysis or study conducted by You or at Your direction concerning Transamerica's Mark, or any version, variation or modification of or alternative to Transamerica's Mark.

18. All communications concerning Your Services, Transamerica's Mark or the Opposition.

19. All documents and things concerning Schwab's Mark.

20. All brand guidelines concerning Transamerica's Mark.

#### **SUBJECT MATTER OF TESTIMONY**

1. The scope of the Services provided to Transamerica.

2. The process by which You developed Transamerica's Mark.

3. All versions or variations of Transamerica's Mark that You created or that were proposed to Transamerica as an alternative to Transamerica's Mark.

4. The guidance provided to You by Transamerica concerning the development of Transamerica's Mark.

5. The goods and services offered under Transamerica's Mark.

6. The geographic scope of use of Transamerica's Mark.

7. The geographic scope of the advertising, marketing and promotion of Transamerica's Mark.

8. The channels of advertising, marketing and promotion of Transamerica's Mark.

9. Your knowledge of marks, trade or business names, or other designations used or registered by third parties in the insurance, investment or financial services industries that include the terms "YOUR TOMORROW" or "TOMORROW."

10. The intended audience for Transamerica's Mark.

11. Payments by Transamerica to You concerning the Services or Transamerica's Mark.

12. Consumer or marketing surveys, tests, investigations, reports, analyses or studies You have conducted or caused to be conducted regarding Transamerica's Mark.

13. Actual confusion between Transamerica's Mark and Schwab's Mark, and the circumstances surrounding each such incident.
14. Your communications with Transamerica concerning Transamerica's Mark or Schwab's Mark.
15. Your communications with third parties concerning Transamerica's Mark or Schwab's Mark.
16. Your document retention and destruction policies.
17. The documents and things produced by You in response to this subpoena.
18. Your efforts to locate documents and things responsive to the requests contained in this subpoena.
19. All information identified, mentioned, referenced, reviewed, or relied upon by You in preparation for each of these deposition topics.

Civil Action No. USPTO Opp. No. 91214615

**PROOF OF SERVICE**

*(This section should not be filed with the court unless required by Fed. R. Civ. P. 45.)*

This subpoena for *(name of individual and title, if any)* J. Walter Thompson U.S.A., Inc.  
was received by me on *(date)* 07/24/2014 .

I served the subpoena by delivering a copy to the named individual as follows: Jean Griffins - Authorized  
to Accept. 466 Lexington Avenue, Suite 6R, New York, NY 10017

on *(date)* 07/28/2014 ; or

I returned the subpoena unexecuted because: \_\_\_\_\_

Unless the subpoena was issued on behalf of the United States, or one of its officers or agents, I have also  
tendered to the witness fees for one day's attendance, and the mileage allowed by law, in the amount of  
\$ \_\_\_\_\_ .

My fees are \$ \_\_\_\_\_ for travel and \$ \_\_\_\_\_ for services, for a total of \$ 0.00 .

I declare under penalty of perjury that this information is true.

Date: 07/29/2014

  
\_\_\_\_\_  
*Server's signature*

Steven Torres, Process Server, Lic. #1372099, New York

*Printed name and title*

Nationwide Legal, LLC  
859 Harrison Street, Suite A  
San Francisco, CA 94107  
(415) 351-0400

*Server's address*

Additional information regarding attempted service, etc:  
(Ref. 3254963)



**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing SUBPOENA TO TESTIFY AT A DEPOSITION IN A CIVIL ACTION to J. Walter Thompson U.S.A.,Inc. and PROOF OF SERVICE has been served on Opposer's counsel of record by emailing said copy on July 31, 2014 to:

Bruce A. McDonald, Esq.  
Buchanan Ingersoll & Rooney PC  
1700 K Street, N.W., Suite 300  
Washington, D.C. 20006  
[bruce.mcdonald@bipc.com](mailto:bruce.mcdonald@bipc.com)

and

Holly B. Lance, Esq.  
Buchanan Ingersoll & Rooney PC  
1737 King Street, Suite 500  
Alexandria, VA 22314  
[holly.lance@bipc.com](mailto:holly.lance@bipc.com)



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David Rosenthal



UNITED STATES DISTRICT COURT

for the

Southern District of New York

Transamerica Corporation

Plaintiff

v.

Charles Schwab & Co., Inc.

Defendant

Civil Action No. USPTO Opp. No. 91214615

(If the action is pending in another district, state where:  
United States Patent and Trademark Office)

SUBPOENA TO TESTIFY AT A DEPOSITION IN A CIVIL ACTION

To: Mindshare New York  
498 7th Avenue, New York, NY 10018

**Testimony:** YOU ARE COMMANDED to appear at the time, date, and place set forth below to testify at a deposition to be taken in this civil action. If you are an organization that is not a party in this case, you must designate one or more officers, directors, or managing agents, or designate other persons who consent to testify on your behalf about the following matters, or those set forth in an attachment:

SEE ATTACHED EXHIBIT A FOR DEPOSITION TOPICS

Place: Winston & Strawn, LLP 200 Park Avenue New York, NY 10017	Date and Time: 09/10/2014 10:00 am
---	---------------------------------------

The deposition will be recorded by this method: Video

**Production:** You, or your representatives, must also bring with you to the deposition the following documents, electronically stored information, or objects, and permit their inspection, copying, testing, or sampling of the material:

SEE ATTACHED EXHIBIT A FOR DOCUMENT REQUESTS

Please produce documents to Winston & Strawn, LLP, 101 California Street, San Francisco, CA 94111 no later than August 19, 2014.

The provisions of Fed. R. Civ. P. 45(c), relating to your protection as a person subject to a subpoena, and Rule 45 (d) and (e), relating to your duty to respond to this subpoena and the potential consequences of not doing so, are attached.

Date: 07/24/2014

CLERK OF COURT

OR

Signature of Clerk or Deputy Clerk

Laura M. Franco

Attorney's signature

The name, address, e-mail, and telephone number of the attorney representing (name of party) Charles Schwab & Co., Inc., who issues or requests this-subpoena, are:

Laura M. Franco  
Winston & Strawn, LLP 101 California Street, San Francisco, CA 94111 (415) 591-1000 lfranco@winston.com

Civil Action No. USPTO Opp. No. 91214615

**PROOF OF SERVICE**

*(This section should not be filed with the court unless required by Fed. R. Civ. P. 45.)*

This subpoena for *(name of individual and title, if any)* \_\_\_\_\_  
was received by me on *(date)* \_\_\_\_\_ .

I served the subpoena by delivering a copy to the named individual as follows: \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_ on *(date)* \_\_\_\_\_ ; or

I returned the subpoena unexecuted because: \_\_\_\_\_  
\_\_\_\_\_ .

Unless the subpoena was issued on behalf of the United States, or one of its officers or agents, I have also  
tendered to the witness fees for one day's attendance, and the mileage allowed by law, in the amount of  
\$ \_\_\_\_\_ .

My fees are \$ \_\_\_\_\_ for travel and \$ \_\_\_\_\_ for services, for a total of \$ \_\_\_\_\_ 0.00 \_\_\_\_\_ .

I declare under penalty of perjury that this information is true.

Date: \_\_\_\_\_  
\_\_\_\_\_  
*Server's signature*

\_\_\_\_\_  
*Printed name and title*

\_\_\_\_\_  
*Server's address*

Additional information regarding attempted service, etc:

## Federal Rule of Civil Procedure 45 (c), (d), and (e) (Effective 12/1/07)

### (c) Protecting a Person Subject to a Subpoena.

(1) *Avoiding Undue Burden or Expense; Sanctions.* A party or attorney responsible for issuing and serving a subpoena must take reasonable steps to avoid imposing undue burden or expense on a person subject to the subpoena. The issuing court must enforce this duty and impose an appropriate sanction — which may include lost earnings and reasonable attorney’s fees — on a party or attorney who fails to comply.

#### (2) *Command to Produce Materials or Permit Inspection.*

(A) *Appearance Not Required.* A person commanded to produce documents, electronically stored information, or tangible things, or to permit the inspection of premises, need not appear in person at the place of production or inspection unless also commanded to appear for a deposition, hearing, or trial.

(B) *Objections.* A person commanded to produce documents or tangible things or to permit inspection may serve on the party or attorney designated in the subpoena a written objection to inspecting, copying, testing or sampling any or all of the materials or to inspecting the premises — or to producing electronically stored information in the form or forms requested. The objection must be served before the earlier of the time specified for compliance or 14 days after the subpoena is served. If an objection is made, the following rules apply:

(i) At any time, on notice to the commanded person, the serving party may move the issuing court for an order compelling production or inspection.

(ii) These acts may be required only as directed in the order, and the order must protect a person who is neither a party nor a party’s officer from significant expense resulting from compliance.

#### (3) *Quashing or Modifying a Subpoena.*

(A) *When Required.* On timely motion, the issuing court must quash or modify a subpoena that:

(i) fails to allow a reasonable time to comply;

(ii) requires a person who is neither a party nor a party’s officer to travel more than 100 miles from where that person resides, is employed, or regularly transacts business in person — except that, subject to Rule 45(c)(3)(B)(iii), the person may be commanded to attend a trial by traveling from any such place within the state where the trial is held;

(iii) requires disclosure of privileged or other protected matter, if no exception or waiver applies; or

(iv) subjects a person to undue burden.

(B) *When Permitted.* To protect a person subject to or affected by a subpoena, the issuing court may, on motion, quash or modify the subpoena if it requires:

(i) disclosing a trade secret or other confidential research, development, or commercial information;

(ii) disclosing an unretained expert’s opinion or information that does not describe specific occurrences in dispute and results from the expert’s study that was not requested by a party; or

(iii) a person who is neither a party nor a party’s officer to incur substantial expense to travel more than 100 miles to attend trial.

(C) *Specifying Conditions as an Alternative.* In the circumstances described in Rule 45(c)(3)(B), the court may, instead of quashing or modifying a subpoena, order appearance or production under specified conditions if the serving party:

(i) shows a substantial need for the testimony or material that cannot be otherwise met without undue hardship; and

(ii) ensures that the subpoenaed person will be reasonably compensated.

### (d) Duties in Responding to a Subpoena.

(1) *Producing Documents or Electronically Stored Information.* These procedures apply to producing documents or electronically stored information:

(A) *Documents.* A person responding to a subpoena to produce documents must produce them as they are kept in the ordinary course of business or must organize and label them to correspond to the categories in the demand.

(B) *Form for Producing Electronically Stored Information Not Specified.* If a subpoena does not specify a form for producing electronically stored information, the person responding must produce it in a form or forms in which it is ordinarily maintained or in a reasonably usable form or forms.

(C) *Electronically Stored Information Produced in Only One Form.* The person responding need not produce the same electronically stored information in more than one form.

(D) *Inaccessible Electronically Stored Information.* The person responding need not provide discovery of electronically stored information from sources that the person identifies as not reasonably accessible because of undue burden or cost. On motion to compel discovery or for a protective order, the person responding must show that the information is not reasonably accessible because of undue burden or cost. If that showing is made, the court may nonetheless order discovery from such sources if the requesting party shows good cause, considering the limitations of Rule 26(b)(2)(C). The court may specify conditions for the discovery.

#### (2) *Claiming Privilege or Protection.*

(A) *Information Withheld.* A person withholding subpoenaed information under a claim that it is privileged or subject to protection as trial-preparation material must:

(i) expressly make the claim; and

(ii) describe the nature of the withheld documents, communications, or tangible things in a manner that, without revealing information itself privileged or protected, will enable the parties to assess the claim.

(B) *Information Produced.* If information produced in response to a subpoena is subject to a claim of privilege or of protection as trial-preparation material, the person making the claim may notify any party that received the information of the claim and the basis for it. After being notified, a party must promptly return, sequester, or destroy the specified information and any copies it has; must not use or disclose the information until the claim is resolved; must take reasonable steps to retrieve the information if the party disclosed it before being notified; and may promptly present the information to the court under seal for a determination of the claim. The person who produced the information must preserve the information until the claim is resolved.

(e) *Contempt.* The issuing court may hold in contempt a person who, having been served, fails without adequate excuse to obey the subpoena. A nonparty’s failure to obey must be excused if the subpoena purports to require the nonparty to attend or produce at a place outside the limits of Rule 45(c)(3)(A)(ii).

Civil Action No. USPTO Opp. No. 91214615

**PROOF OF SERVICE**

*(This section should not be filed with the court unless required by Fed. R. Civ. P. 45.)*

This subpoena for *(name of individual and title, if any)* Mindshare New York  
was received by me on *(date)* 07/24/2014.

I served the subpoena by delivering a copy to the named individual as follows: Julissa Villalona  
498 7th Avenue, New York, NY 10018  
\_\_\_\_\_ on *(date)* 07/25/2014 ; or

I returned the subpoena unexecuted because: \_\_\_\_\_

Unless the subpoena was issued on behalf of the United States, or one of its officers or agents, I have also  
tendered to the witness fees for one day's attendance, and the mileage allowed by law, in the amount of  
\$ \_\_\_\_\_.

My fees are \$ \_\_\_\_\_ for travel and \$ \_\_\_\_\_ for services, for a total of \$ 0.00.

I declare under penalty of perjury that this information is true.

Date: 07/25/2014

  
\_\_\_\_\_  
*Server's signature*

Steven Torres, Process Server, Lic. #1372099, New York

*Printed name and title*

Nationwide Legal, LLC  
859 Harrison Street, Suite A  
San Francisco, CA 94107  
(415) 351-0400

*Server's address*

Additional information regarding attempted service, etc:  
(Ref. 3254962)

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing SUBPOENA TO TESTIFY AT A DEPOSITION IN A CIVIL ACTION to Mindshare New York and PROOF OF SERVICE has been served on Opposer's counsel of record by emailing said copy on July 25, 2014 to:

Bruce A. McDonald, Esq.  
Buchanan Ingersoll & Rooney PC  
1700 K Street, N.W., Suite 300  
Washington, D.C. 20006  
[bruce.mcdonald@bipc.com](mailto:bruce.mcdonald@bipc.com)

and

Holly B. Lance, Esq.  
Buchanan Ingersoll & Rooney PC  
1737 King Street, Suite 500  
Alexandria, VA 22314  
[holly.lance@bipc.com](mailto:holly.lance@bipc.com)



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David Rosenthal



**ATTACHMENT A**

**SUBPOENA TO MINDSHARE UNITED STATES**

For the purpose of this subpoena for production of documents and things, the following instructions shall apply and the following terms will have the meaning indicated:

**DEFINITIONS**

1. “You,” “Your,” or “Mindshare” means Mindshare United States and its past or present officers, members, employees, agents, independent contractors, assigns, affiliates, predecessors, successors, divisions, departments, bureaus, offices, parents, subsidiaries and any other person acting or purporting to act for or on behalf of, or in privity with Mindshare, and any person controlled by or which controls Mindshare.

2. “Applicant” or “Schwab” means Applicant Charles Schwab & Co., Inc. and its past or present officers, members, employees, agents, independent contractors, assigns, affiliates, predecessors, successors, divisions, departments, bureaus, offices, parents, subsidiaries and any other person acting or purporting to act for or on behalf of, or in privity with Schwab, and any person controlled by or which controls Schwab.

3. “Opposer” or “Transamerica” refers to Transamerica Corporation and its past or present officers, members, employees, agents, independent contractors, assigns, affiliates, predecessors, successors, divisions, departments, bureaus, offices, parents, subsidiaries and any other person acting or purporting to act for or on behalf of, or in privity with Transamerica, and any person controlled by or which controls Transamerica, including but not limited to Transamerica Agency Network, Inc., Life Investors Financial Group, Inc. and Monumental Life Insurance Company.

4. “Opposition” means Opposition No. 91214615 filed by Transamerica in the United States Patent and Trademark Office before the Trademark Trial and Appeal Board.

5. “Application” means U.S. Trademark Application Serial No. 85/889,202 for Schwab’s Mark.

6. “Schwab’s Mark” means the mark OWN YOUR TOMORROW, which is the subject of the Application.

7. “Transamerica’s Mark” means the mark TRANSFORM YOUR TOMORROW, which is the subject of U.S. Trademark Registration No. 4,325,690.

8. “Services” means all of the services rendered by You or at Your direction to or for Transamerica concerning the promotion of Transamerica’s Mark and goods and services offered under Transamerica’s Mark in the U.S., including but not limited to media planning and strategies, media buys and placement, and analytics from the foregoing.

9. “Documents” shall have the broadest meaning ascribed to it by Federal Rule of Civil Procedure 34, and shall include within its meaning any and all papers, videotapes or video recordings, photographs, films, recordings, memoranda, books, records, accounts, letters, telegrams, correspondence, notes of meetings, notes of conversations, notes of telephone calls, inter-office memoranda or written communications of any nature, instant messages, texts, blogs, social media posts or messages, emails, recordings of conversations either in writing or by means of any mechanical, electrical or digital recording device, notes, papers, reports, analyses, invoices, canceled checks or check stubs, receipts, minutes of meetings, time sheets, diaries, desk calendars, ledgers, schedules, licenses, financial statements, telephone bills, logs and any differing versions of the foregoing whether denominated formal, informal, or otherwise, as well as copies of the foregoing which differ in any way, including handwritten notations or other written or printed matter of any nature, from the original. The foregoing specifically includes the information stored in any form, including electronic form, on a computer or in a computer database or cloud server or otherwise, including electronic mail.

10. The term “concerning” means relating to, discussing, referring to, describing, reflecting, evidencing or constituting.

11. “Communication” means and includes any meeting, conference, face-to-face conversation, telephone conversation, or conference or communication by any medium as well as any written, taped, or recorded communication of any kind whatsoever, through which there is

an expression or exchange of information, whether in speech, writing, or any other form, and shall include all facts surrounding such exchange, including but not limited to, the date of the exchange, the content of the exchange, the parties to the exchange, and any witnesses to the exchange.

12. “All” and “any” shall both mean any, all, each, and every.

13. The terms “and” and “or” shall be construed both conjunctively and disjunctively, and each shall include the other wherever such dual construction will enlarge the scope of the request.

14. The use of the singular form of any word also includes the plural and vice versa.

15. “Including” shall mean including, but not by way of limitation.

16. “Relating to” means concerning, referring to, summarizing, reflecting, constituting, comprising, stating, containing, embodying, pertaining to, identifying, involved with, mentioning, discussing, consisting of, showing, commenting upon, evidencing, supporting, responding to, dealing with, describing, analyzing, or in any way pertinent to that subject.

17. As pertains to a person or entity, “identify” means to state the person/entity’s name, title, last known address, and last known telephone number.

18. As pertains to a litigation, “identify” means to state the case name, number, and jurisdiction, and to provide the names of the parties to the case.

19. As pertains to a communication, “identify” means to identify the parties involved in the communication, give the date, time, location, and medium of the communication; and provide a description of the substance of the communication.

20. As pertains to a document, “identify” means to identify the date, form, author, recipient, location; and provide a description of the substance of the document.

21. “Thing” shall mean any physical specimen or other tangible item, other than a document.

### **INSTRUCTIONS**

1. Unless otherwise stated in a specific request, these requests seek the production of



documents and things created, developed, acquired or otherwise obtained by You during the performance of the Services.

2. These requests are intended to include all documents or electronically stored information and things in Your possession, custody or control (including Your attorneys consultants, agents, other representatives, and other persons or entities subject to Your control), wherever located.

3. The documents or things requested shall be produced either as they are kept in the usual course of business, or organized and labeled to correspond with the requests to which they are responsive. If there are no documents or things responsive to any particular discovery request, You should so state in writing.

4. If You come into possession, custody or control of responsive documents or things between the time of production indicated in this subpoena and the time of trial herein, You shall promptly supplement its earlier production by producing such documents or things in accordance with Your obligations under FRCP 26(e).

5. Produce the original and all copies of each requested document and thing, as well as the file in which they are kept, including all copies which bear any additional file stamps, marginal notes, or other additional markings or writings that do not appear on the original.

6. Complete production is to be made on the date and at the time indicated in the attached subpoena. The inspection and copying will begin at that time and will continue from day to day thereafter until completed.

7. If You contend that any information, document, or thing otherwise requested in this subpoena is excluded from production or discovery, then for each such document or thing:

- a. State whether the item shall not be produced because:
  - 1) It is claimed to be privileged; or
  - 2) It once existed but can no longer be located; or
  - 3) It has been lost; or
  - 4) It has been destroyed; and

b. If, under a claim of privilege, any document or thing is not produced, state for each such document or thing:

- 1) the type and title of the document or thing; and
- 2) the general subject matter of the content of the document or description of the thing; and
- 3) the date of its creation and/or revision; and
- 4) the identity of the document's author(s), addressee(s), and recipient(s); and
- 5) the nature of the privilege being claimed; and
- 6) in detail, all facts upon which You base Your claim of privilege.

#### **DOCUMENTS TO BE PRODUCED**

1. Documents and things sufficient to identify the specific tasks and deliverables that comprise the Services provided or to be provided by You to Transamerica.
2. All documents and things concerning Transamerica's Mark.
3. All creative briefs, position statements, strategy papers, slide decks, presentations, proposals or other materials concerning Transamerica's Mark.
4. All documents and things concerning media schedules for advertisements and promotions concerning Transamerica's Mark.
5. All documents and things concerning media buys for advertisements and promotions concerning Transamerica's Mark, including but not limited to invoices therefor.
6. All documents and things concerning each and every version or variation of, modification to, or alternative to Transamerica's Mark that You are aware of or encountered while performing the Services, whether or not you made any media purchases in connection with such version, variation, modification or alternative was or is currently in use.
7. All documents and things concerning the intended or actual uses of Transamerica's Mark.

8. All documents and things, including but not limited to creative briefs, marketing plans, development plans, business plans, or budgetary plans concerning Transamerica's Mark provided to You by Transamerica or on its behalf in connection with providing the Services.

9. Copies of each advertisement or marketing or promotional piece bearing Transamerica's Mark that You have in Your possession, including but not limited to circulars, leaflets, direct mail pieces, newspaper and magazine advertisements, commercials (aired on television or radio, cable stations, streamed or downloadable via the Internet or other device), websites, trade association listings, keyword search buys and any other materials used in connection with advertising or promoting Transamerica's Mark.

10. All documents and things provided to You by the J Walter Thompson Company concerning Transamerica's Mark.

11. All documents and things concerning the intended or actual geographic scope for advertising and promotion of Transamerica's Mark.

12. All documents and things concerning the intended or actual duration of use of Transamerica's Mark.

13. All documents and things concerning the meaning or message intended to be conveyed by Transamerica's Mark.

14. All documents and things concerning the intended or actual channels of advertising, marketing and promotion for Transamerica's Mark.

15. All documents and things concerning all payments made by Transamerica to You concerning the Services, or otherwise concerning Transamerica's Mark.

16. All documents and things concerning the types, characteristics, geographic locale, or classes of persons intended as the audience for Transamerica's Mark.

17. All documents and things concerning the intended or actual channels of trade and distribution of goods or services offered or sold under Transamerica's Mark.

18. All documents and things concerning the goods or services that were, are, or are intended to be offered or sold under Transamerica's Mark.

19. All documents and things concerning or comprising any consumer or marketing survey, test, report, analysis or study conducted by You or at Your direction concerning Transamerica's Mark, or any version, variation or modification of or alternative to Transamerica's Mark.

20. All documents and things concerning the success, return on investment, benchmark or other measures of performance of all media placed by You concerning Transamerica's Mark.

21. All communications concerning Your Services, Transamerica's Mark or the Opposition.

22. All documents and things concerning Schwab's Mark.

#### **SUBJECT MATTER OF TESTIMONY**

1. The scope of the Services provided to Transamerica.
2. The guidance provided to You by or on behalf of Transamerica concerning the advertising, marketing and promotion of Transamerica's Mark.
3. The scope of use of Transamerica's Mark.
4. The goods and services offered under Transamerica's Mark.
5. The geographic scope of the advertising, marketing and promotion of Transamerica's Mark or goods or services offered under Transamerica's Mark.
6. The channels of advertising, marketing and promotion of Transamerica's Mark.
7. All media purchases and placements to advertise, market and promote Transamerica's Mark.
8. Your knowledge of marks, trade or business names, or other designations used or registered by third parties in the insurance, investment or financial services industries that include the terms "YOUR TOMORROW" or "TOMORROW."
9. The intended audience for Transamerica's Mark.
10. Payments by Transamerica to You concerning the Services or Transamerica's Mark.

11. Consumer or marketing surveys, tests, investigations, reports, analyses or studies You have conducted or caused to be conducted regarding Transamerica's Mark.
12. Actual confusion between Transamerica's Mark and Schwab's Mark, and the circumstances surrounding each such incident.
13. Your communications with Transamerica concerning Transamerica's Mark or Schwab's Mark.
14. Your communications with third parties concerning Transamerica's Mark or Schwab's Mark.
15. Your document retention and destruction policies.
16. The documents and things produced by You in response to this subpoena.
17. Your efforts to locate documents and things responsive to the requests contained in this subpoena.
18. All information identified, mentioned, referenced, reviewed, or relied upon by You in preparation for each of these deposition topics.

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

Serial No. 85889202  
OWN YOUR TOMORROW

TRANSAMERICA CORPORATION,	:	
	:	
Opposer,	:	Opposition No. 91214615
	:	
v.	:	
	:	
CHARLES SCHWAB & CO., INC.	:	
	:	
Applicant.	:	

**TRANSAMERICA’S ANSWERS AND OBJECTIONS  
TO SCHWAB’S FIRST SET OF INTERROGATORIES**

Pursuant to Rule 33 of the Federal Rules of Civil Procedure, 37 C.F.R. § 2.120, and TBMP § 405, Opposer responds as follows to Applicant’s First Set of Interrogatories.

**General Objections**

1. Opposer’s answers to these interrogatories and corresponding document production requests is without prejudice to any claim or defense, and the production of information and documents in response to Opposer’s interrogatories and document production requests shall not be construed as an admission that any such information or document is relevant to any claim or defense.

2. These responses are made solely for the purpose of this case, and Opposer has not completed its investigation into the facts. These responses are based solely on the documents that are presently available and specifically known to Opposer. Opposer reserves its right to supplement these responses.

3. Opposer objects to Applicant’s First Set of Interrogatories on the grounds that they are overly broad, unduly burdensome, oppressive and vague.

4. Opposer objects to each Interrogatory to the extent it seeks information not reasonably related to the claims or defenses in this matter or reasonably calculated to lead to the discovery of admissible evidence.

5. Opposer objects to each Interrogatory to the extent it calls for the disclosure of trade secrets or other confidential information.

6. Opposer objects to each Interrogatory to the extent that it calls for information already in the possession, custody or control of Applicant, that is in the possession of third parties, or otherwise outside of Opposer's possession, custody or control.

7. Opposer objects to each Interrogatory, definition, and instruction to the extent it purports to impose any requirement or discovery obligation on Opposer other than those set forth in the Federal Rules of Civil Procedure and the applicable rules of the Board.

8. Opposer objects to each Interrogatory to the extent that it seeks information protected by the attorney-client privilege, the work product privilege and/or any other applicable privilege. Any inadvertent disclosure of such information shall not be deemed a waiver of the attorney-client privilege, the attorney-work product doctrine, or any other applicable privilege or immunity.

**INTERROGATORY NO. 1**

Describe the process by which Opposer's Mark was created, selected, or developed.

**Response**

Opposer objects to this Interrogatory on the grounds of relevance inasmuch as the registrability of Opposer's mark is not in issue. Without waiving this objection, Opposer states that the opposed mark was created, selected and adopted to complement a family of marks containing the word TOMORROW as depicted in the following U.S. service mark registrations,

filed by Opposer on June 2, 2011, and first used in September 2011, covering “financial services, namely, underwriting and distribution of life and health insurance and annuity products; investment management and advisory services; mutual fund management, brokerage, and distribution services; retail stock brokerage services; financial retirement planning; administration of retirement and pension plans; and insurance agency and brokerage services,” in International Class 36:

<b>Mark</b>	<b>App./Reg.</b>	<b>Status</b>
<b>TRANSFORM TOMORROW</b>	85336965 4169168	Registered 7/3/2012
<b>TRANSAMERICA TRANSFORM TOMORROW</b>	85336972 4169169	Registered 7/3/2012
<b>TOMORROW MAKERS</b>	85336977 4226784	Registered 10/16/2012
<b>WE ARE THE TOMORROW MAKERS</b>	85336983 4169170	Registered 7/3/2012
<b>TOMORROW MAKERS &amp; Pyramid Design</b> 	8534778 34262095	Registered 12/18/2012
<b>WE ARE THE TOMORROW MAKERS &amp; Pyramid Design</b> 	85338740 4169179	Registered 7/3/2012



**INTERROGATORY NO. 2**

Identify the process by which you cleared Opposer's Mark for use and registration, including the identification of all persons involved.

**Response**

Opposer objects to his Interrogatory on the grounds of relevance inasmuch as the registrability of Opposer's mark is not in issue. Opposer further objects to this interrogatory to the extent that it requires the disclosure of attorney-client communications. Without waiving these objections, Opposer states that a prior application filed by Opposer, for registration of TRANSFORM TOMORROW, U.S. Service Mark Application Serial No. 85336965, was allowed by the PTO on March 20, 2012. See also the following search reports, produced herewith, obtained by Michael MacDermott of the law firm Christie Parker & Hale LLP:

- Thomson Compumark Trademark Search Report, March 30, 2011, TRANSFORM TOMORROW, Bates Nos. 1 -200
- Thomson Compumark Trademark Search Report, TOMORROW MAKERS, April 4, 2011, Bates Nos. 201-429

**INTERROGATORY NO. 3**

Identify all searches, reports, investigations or other research conducted by you or on your behalf that identify marks that include the term "TOMORROW."

**Response**

Opposer objects to this Interrogatory on the grounds that it is overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence. Opposer further objects to this Interrogatory to the extent it calls for the disclosure of searches, reports, investigations and other research conducted by counsel, on the grounds that such materials are protected from disclosure under the work product doctrine. Without waiving these

objections, Opposer refers Applicant to the documents identified in response to Interrogatory No. 2 above.

**INTERROGATORY NO. 4**

Identify the three individuals most knowledgeable about the creation, selection, adoption, and use of Opposer's mark.

**Response**

(1) William H. Tate, Senior Vice President of Marketing, Transamerica Corporation, 1150 S. Olive St., Los Angeles, CA.

(2) Frank A. Camp, Associate General Counsel, Intellectual Property, Transamerica Corporation, 4333 Edgewood Rd. NE, Cedar Rapids, IA 52499.

(3) Kimberly Vaughn, Senior Project Manager, Brand Development, Transamerica Life Insurance Company, 4333 Edgewood Rd. NE, Cedar Rapids, IA 52499.

**INTERROGATORY NO. 5**

Identify all variations of Opposer's Mark, whether previously or currently used by Opposer, including the identification [of] all goods and/or services on or in connection with which such variant was or is used.

**Response**

Opposer objects to this Interrogatory on the grounds of vagueness in that it calls for an interpretation of what is meant by a "variation" of Opposer's Mark. Without waiving this objection, Opposer states that the word TOMORROW is depicted in the U.S. service mark registrations identified in in response to Interrogatory 1 above, covering "financial services, namely, underwriting and distribution of life and health insurance and annuity products; investment management and advisory services; mutual fund management, brokerage, and distribution services; retail stock brokerage services; financial retirement planning; administration of retirement and pension plans; and insurance agency and brokerage services," in

International Class 36. Opposer states further that Opposer uses multiple variations of the term YOUR TOMORROW as illustrated in the advertising and promotional materials produced herewith in response to Document Production Request Nos. 1, 5 and 7.

**INTERROGATORY NO. 6**

Identify each and every good and service which Opposer previously, currently or intends to be advertised or offered for sale under Opposer's Mark, and for each such good or service, provide the date of first use in commerce in the United States as defined by 15 U.S.C. § 1127 or a statement that no such use has occurred, the channel(s) of trade through which the good or service is or is intended to be distributed, the class or intended class of purchaser, and user or target market of the good or services, the time period(s) during which the good or service has been or is intended to be sold, and the retail and/or wholesale price.

**Response**

**Goods and Services.** Opposer has been using its Mark in commerce for the following financial services since January 14, 2013: underwriting and distribution of life and health insurance and annuity products; investment management and advisory services; mutual fund management, brokerage, and distribution services; retail stock brokerage services; financial retirement planning; administration of retirement and pension plans; and insurance agency and brokerage services. Opposer has been using variations of its Mark since September 12, 2011.

**Channels of Trade.** Opposer markets its services through a network of subsidiaries, operating divisions, authorized agents and representatives, in addition to a number of websites including but not limited to [www.transamerica.com](http://www.transamerica.com), [www.transamericaagencynetwork.com](http://www.transamericaagencynetwork.com), and [www.ta-retirement.com](http://www.ta-retirement.com). Transamerica's organization includes a number of wholly owned subsidiaries, including the following suppliers of financial products and services engaged in the marketing and sale of financial products and services to a domestic and international clientele:

- Transamerica Life Insurance Company, Transamerica Advisors Life Insurance Company, Transamerica Advisors Life Insurance Company of New York, and Transamerica Financial Life Insurance Company, providers of life and

supplemental health insurance products and annuities with more than \$1.3 trillion in aggregate total assets as of December 31, 2013;

- Transamerica Capital, Inc., a wholesale marketing and sales group that assists financial professionals in providing retirement services, mutual funds, life insurance and annuities;
- Transamerica Financial Advisors, Inc., a full service broker/dealer and financial services provider;
- Transamerica Asset Management, Inc., a provider of investment management services;
- Transamerica Retirement Solutions Corporation, a third-party administrator for employer-sponsored retirement plans;
- Transamerica Employee Benefits (formerly known as Transamerica Worksite Marketing), a business unit of the Transamerica Companies, that provides voluntary supplemental insurance products including term life, universal life, cancer, accident, and vision insurance;
- Transamerica International Re (Bermuda) Ltd. and Transamerica International Re Escritório de Representação no Brasil Ltd., providers of reinsurance services; and
- Transamerica Life (Bermuda) Ltd., an international provider of life insurance products.

**Class of Purchaser.** Opposer markets its services to the general public.

**Price.** Opposer objects to the request for pricing information on the grounds of vagueness. Without waiving this objection, Opposer states that, as to life insurance, the price of premiums is calculated on a case-by-case basis in consideration of the customer's health and other factors. Mutual funds and other investment vehicles are priced on the basis of stock prices and other market factors.



**INTERROGATORY NO. 7**

Identify by product or service, for each year since the date of the first use of Opposer's Mark, the total sales for each of the goods and services advertised or offered for sale under Opposer's mark in both dollar amounts and number of units.

**Response**

Opposer objects to this Interrogatory on the grounds that it is vague, overly broad and unduly burdensome in calling for a quantification of sales in terms of "units" inasmuch as such quantification is not ordinary or customary in the trade. Opposer further objects to this Interrogatory on grounds of relevance and burden to the extent it requires any additional information than what is provided in this response. Without waiving these objections, Opposer states that its combined revenues from services in the financial and insurance fields offered by the Transamerica companies averaged over \$16 billion annually between 2011 and 2013. Opposer additionally refers Applicant to the Dun & Bradstreet reports produced herewith under Bates Nos. 1878-1925.

**INTERROGATOR NO. 8**

Identify the geographic location(s) in which you have, currently do, or intend to promote, advertise or offer for sale goods or services under Opposer's Mark.

**Response**

National.

**INTERROGATORY NO. 9**

Identify each person employed by you and each outside agency or contractor retained by you or on your behalf that has been or is now responsible for marketing, advertising and promotional activities relating to Opposer's Mark.

**Response**

Opposer objects to this Interrogatory on the grounds that it is vague, overly broad and unduly burdensome in calling for the identification of "each" person employed by Opposer that

has been or is now “responsible” for marketing, advertising and promotional activities relating to Opposer’s Mark. Without waiving this objection, Opposer states as follows.

(1) The individual in Opposer’s organization with principal responsibility for marketing, advertising and promotional activities, including but not limited to activities relating to Opposer’s Mark, is William H. Tate, Senior Vice President of Marketing, Transamerica Corporation, in Los Angeles, CA. Opposer objects on grounds of relevance and burden to the extent that this Interrogatory purports to require the disclosure of persons reporting to Mr. Tate. In addition to individuals within Opposer’s organizations who report to Mr. Tate, there are marketing units within each division of the corporation that are involved in advertising, marketing and promotional activity.

(2) Opposer employs the services of an outside agency, J. Walter Thompson U.S.A., Inc. ("JWT"), 466 Lexington Ave., Suite 6R, New York, NY 10017, for marketing, advertising and promotional activities, including but not limited to activities relating to Opposer’s Mark.

**INTERROGATORY NO. 10**

Identify all forms of advertising used by you or with your authorization to advertise, market and promote Opposer’s Mark, including but not limited to broadcast, print, digital, out of home, domain names, websites, or other media, including the name or title of the publication in which each such advertisement appears, and the date thereof.

**Response**

Opposer objects to this Interrogatory on the grounds that it is overly broad and unduly burdensome in requiring the identification of “all” forms of advertising used by Opposer or with Opposer’s authorization to advertise, market and promote Opposer’s mark. Without waiving this objection, Opposer refers Applicant to the documents produced herewith in response to Document Production Request Nos. 1, 5 and 7.

**INTERROGATORY NO. 11**

Identify by year and type, the total expenses incurred by Opposer in promoting goods or services under Opposer's Mark, or in promoting Opposer's Mark generally.

**Response**

Opposer objects to this Interrogatory on the grounds that it is unduly burdensome to the extent it requires Opposer to separate out expenses associated with Opposer's Mark inasmuch as Opposer's records are not structured to allow for an accounting of expenses attributable specifically to that Mark. Without waiving this objection, Opposer states that company expenditures for advertising exceeded \$50 million between 2011 and 2013.

**INTERROGATORY NO. 12**

Identify by title, date, and location all conferences, seminars, trade shows, or similar public or semi-public gatherings at which you promoted Opposer's Mark or advertised or offered for sale goods or services under Opposer's Mark, and state, if known, whether Applicant was a participant in any such conferences, seminars, trade shows, or similar public or semi-public gatherings.

**Response**

Opposer objects to this Interrogatory on the grounds that it is overly broad and unduly burdensome in requiring the identification of "all" conferences, seminars, trade shows, or similar public or semi-public gatherings at which Opposer promoted its Mark or advertised or offered for sale goods or services under Opposer's Mark. Without waiving this objection, Opposer's mark has been displayed at the following such gatherings in the recent past, documents relating to which are produced herewith under the identified Bates Numbers:

- National Association of Plan Advisors (NAPA), NAPA 401(k) Summit 2015, March 22-24, 2015, San Diego, CA, Bates Nos. 2175-2188
- National Association of Plan Advisors (NAPA), NAPA 401(k) Summit 2014, March 23-25, 2014, New Orleans, LA, Bates Nos. 2189-2206
- Plan Sponsor Council of America, 65<sup>th</sup> Annual National Conference, September 11-14, 2012, New Orleans, LA, Bates Nos. 2207-2217

- Plan Sponsor Council of America, 64<sup>th</sup> Annual National Conference, September 19-22, 2011, Las Vegas, NV. Bates Nos. 2218-2230
- SouthWest Benefits Association, 39<sup>th</sup> Annual Conference, May 7-9, 2014, Austin, TX, Bates Nos. 2231-2237
- Retirement Industry Conference, April 9-11, 2014, Chicago, IL, Bates Nos. 2238-2249 and 2250-2260
- Financial Planning Association of Long Island, 14<sup>th</sup> Annual Symposium & Exhibition, November 1, 2013, Bates Nos. 2261-2278
- Bank Innovators Council, FinovateSpring, April 29-30, 2014, Bates Nos. 2279-2315
- Women Advisors Forum 2013 Series, Bates Nos. 2316-2321
- Investment Company Institute, 2014 General Membership Meeting, May 20-22, 2014, Washington, D.C., Bates Nos. 2322-2338
- PiMA, 21014 Midyear Meeting & Tradeshow, July 17-20, 2014, Napa, CA, Bates Nos. 2339-2340

### **INTERROGATORY NO. 13**

Identify all websites owned, controlled or operated by Opposer, on which Opposer's Mark is or has been displayed and for each such website, identify the specific webpage(s) on which Opposer's Mark appears or has appeared, and whether it continues to appear at the time you respond to these interrogatories.

### **Response**

Opposer objects to this Interrogatory on the grounds that it is overly broad and unduly burdensome in calling for the identification of "all" websites owned, controlled or operated by Opposer, on which Opposer's Mark is or has been displayed, and also on grounds of relevance to the extent the Interrogatory requires Opposer to investigate cached web pages. Without waiving these objections, Opposer states that its Mark is currently displayed on various web pages including those at [www.transamerica.com](http://www.transamerica.com), [www.ta-retirement.com](http://www.ta-retirement.com), and [www.transamericaagencynetwork.com](http://www.transamericaagencynetwork.com), illustrated in Opposer's Response to Applicant's Documents Production Request Nos. 5 and 7.

**INTERROGATORY NO. 14**

Identify all press releases or public statements issued by you or on your behalf referring or relating to Opposer’s Mark.

**Response**


Opposer is unaware of any such documents.

**INTERROGATORY NO. 15**

Identify all third-party uses, applications and registrations for any trademark, service mark, trade name, business name, or other designation in the insurance or financial services industries that include the term “YOUR TOMORROW” of which you are aware.

**Response**

Opposer objects to this Interrogatory on the grounds of relevance to the extent it calls for the identification of registrations or applications issued or filed after the priority date of Opposer’s Mark. Without waiving that objection, Applicant states that the following prior third-party registrations containing the words YOUR TOMORROW or YOUR TOMORROWS in International Class 36 were identified by Opposer in the clearance of Opposer’s mark:

Mark	Services	Owner
<b>ANNUITIES TO SECURE YOUR TOMORROWS</b> , U.S. Reg. 1940102, registered 12/5/1995	Underwriting services for life insurance and annuities services (first use 1995)	American International Group, Inc., New York, NY
<b>THE PATY GROUP IMPROVING YOUR TOMORROW &amp; Design</b> , U.S. Reg. 3362132, registered 1/1/2008 	Debt counseling services; Consumer credit consultation; Credit and financial consultation; Credit consultation; Credit inquiry and consultation; Debt management consultation; Financial analysis and consultation (first use 2006)	The PATY Group, Inc., Clearwater, FL
<b>PLANNING TODAY FOR YOUR TOMORROWS</b> , U.S. Reg. 3682128, registered 9/15/2009	Financial planning; insurance brokerage; investment brokerage (first use 1993)	Muraski, John, Newbury Park, CA



**INTERROGATORY NO. 16**

Identify all third-party uses, applications and registrations for any trademark, service mark, trade name, business name, or other designation in the insurance or financial services industries that include the term “TOMORROW” of which you are aware.

**Response**

Opposer objects to this Interrogatory on the grounds that it is overly broad and unduly burdensome, and not likely to lead to the discovery of admissible evidence. Without waiving this objection, Opposer refers Applicant to the following documents produced herewith:

- Thomson Compumark Trademark Search Report, March 30, 2011, TRANSFORM TOMORROW, Bates Nos. 1-200
- Thomson Compumark Trademark Search Report, TOMORROW MAKERS, April 4, 2011, Bates Nos. 201-429
- Documents Illustrating Third-Party Use of TOMORROW Marks Disclosed in 2011 Investigation, Bates Nos. 504-854

**INTERROGATORY NO. 17**

Identify Opposer’s principal competitors for each category of goods or services offered under Opposer’s Mark.

**Response**

Opposer objects to this interrogatory on the grounds that it is overly broad and unduly burdensome in calling for identification of Opposer’s principal competitors in each of the listed classes. In respect to life and health insurance, and annuities, Opposer refers Applicant to the Industry Rankings produced herewith under Bates Stamp Nos. 2506-2512 (CONFIDENTIAL). Opposer and Applicant are principal competitors in respect to investment management and advisory services; mutual fund management, brokerage and distribution services; financial retirement planning; and administration of retirement and pension funds. Principal competitors of Opposer in the markets where the parties compete are identified in the Bids Won / Bids Lost Questionnaires identified by Bates Nos. 2384-2505 (CONFIDENTIAL).

## **ROGATORY NO. 18**

Describe the circumstances under which you first became aware of Applicant's Mark, including the dates, all persons involved in such circumstances, and the nature of each person's involvement.

### **Response**

In July 2013, Applicant's use of its mark on the following Facebook page came to the attention of Opposer's employees, including Sherry Rothenberg, Wendy Daniels, David Shute, Pat Advaney, Dennis Westerhuis, Anthony Ginn, and Mitzi Takeuchi, whereupon the matter was brought to the attention of William Tate and subsequently assigned to in-house and outside counsel for follow-up:



## **INTERROGATORY NO. 19**

Describe each instance of which you are aware of a person being confused between Applicant, Applicant's Mark or any good or service offered by Applicant under Applicant's Mark on the one hand, and Opposer, Opposer's Mark or any good or service offered by Opposer under Opposer's Mark on the other hand, and for each such instance, identify the persons

involved, the date of such instance of confusion, how such instance of confusion came to your attention, and the steps taken in response to learning of such instance of confusion.

**Response**

Opposer is unaware of any such instances.

**INTERROGATORY NO. 20**

Describe each inquiry received by you, or of which you are aware, in which anyone suggests, implies or infers a relationship, connection or association between Applicant, Applicant's mark or any good or service offered by Applicant under Applicant's mark on the one hand, and Opposer, Opposer's Mark, or any good or service offered by Opposer under Opposer's mark on the other hand, and for each such inquiry, identify the persons involved, the date of such inquiry, how such inquiry was received, and the steps taken in response to such inquiry.

**Response**

Opposer is unaware of any such inquiry.

**INTERROGATORY NO. 21**

Identify all challenges, threats, lawsuits or United States Patent and Trademark Office ("USPTO") proceedings relating to or involving Opposer's Mark, other than this proceeding. If the answer is anything but a categorical, unqualified none, describe such challenge, threat, lawsuit or proceeding, including the names of the parties, the date, the issues involved and the result or current status.

**Response**

None.

**INTERROGATORY NO. 22**

Identify all agreements relating to or involving Opposer's Mark, including, without limitation, assignments, licenses or consents. If the answer is anything but a categorical, unqualified none, identify each such agreement, including the names of the parties involved, the date of such agreement and identify all documents addressing such agreement.

**Response**

None.

**INTERROGATORY NO. 23**

Identify all communications between Applicant and Opposer, including the dates, participants, documents relating to each communication, and the substance of each communication.

**Response**

No such communications are known to exist.

**INTERROGATORY NO. 24**

Identify all communications with third parties relating to Opposer's Mark, including the dates, participants, documents relating to each communication, and the substance of each communication.

**Response**

No such communications are known to exist.

**INTERROGATORY NO. 25**

Identify all public filings relating to goods or services offered under Opposer's mark.

**Response**

Opposer objects to this Interrogatory on the grounds of relevance. Opposer's mark is used "enterprise-wide" as a slogan for advertising and promoting Opposer's services generally rather than the identification of a particular financial product. The mark would therefore not pertain to any particular public filing.

**INTERROGATORY NO. 26**

Describe the organizational structure of Opposer to the extent that it relates to the use and ownership of Opposer's Mark.

**Response**

Not applicable.

**INTERROGATORY NO. 27**

Describe each circumstance in which you or any person acting on your behalf has consulted with or retained the services of any expert with respect to any of the issues involved in this proceeding, including the identity of such the [sic] expert, all documents considered by or provided to such expert, including those documents upon which such expert has based or will base an opinion, the dates of such consultation or retention, and a description of the subject matter for which the expert was consulted [sic] or retained.

**Response**

Not applicable.

**INTERROGATORY NO. 28**

Describe each circumstance in which you or any person acting on your behalf has obtained any statement or opinion regarding an of the issues in this proceeding, including the identity of the person(s) who rendered the statement or opinion, the person(s) who obtained or received such statement or opinion, whether such statement or opinion was in writing or oral, all documents containing such statement or opinion, and the date for such statement or opinion.

**Response**

Opposer objects to this Interrogatory on the grounds that it is vague, overly broad, unduly burdensome, and not likely to lead to the discovery of admissible evidence. Applicant further objects to this Interrogatory on the grounds that it calls for the disclosure of privileged attorney-client communications. If the Interrogatory is intended to inquire whether a formal statement or opinion of any kind has been obtained by a third party, the answer is no.



**INTERROGATORY NO. 29**

Describe any expert testimony upon which you intend or expect to rely upon during the trial period of this proceeding, including identification of the expert providing such testimony, describing in detail the subject area of the expert's testimony, and identify all documents upon which the expert will rely.

**Response**

Opposer objects to this Interrogatory on the grounds that it is unduly burdensome in calling for the identification of expert witnesses in advance of the deadline for such disclosure set forth in the current trial calendar.

**INTERROGATORY NO. 30**

Describe the testimony of each person you intend or expect to call as a witness during the testimony period of this proceeding, including the identification of each such witness and a detailed description of the substance of each such person's testimony.

**Response**

Opposer objects to this Interrogatory on the grounds that it is unduly burdensome in calling for the designation of witnesses that is not required until such time as Opposer files its Notice of Reliance.

**INTERROGATORY NO. 31**

Identify all documents you intend to rely on in this proceeding.

**Response**

Opposer objects to this Interrogatory on the grounds that it is unduly burdensome in calling for the identification of exhibits that is not required until such time as Opposer files its Notice of Reliance.

**INTERROGATORY NO. 32**

Identify each person who participated or provided information used in answering the interrogatories and identify specifically the interrogatory for which each person provided information.

**Response**

These interrogatory responses were prepared jointly by Frank Camp and undersigned counsel.

**INTERROGATORY NO. 33**

Identify all documents used to answer the Interrogatories.

**Response**

Opposer objects to this Interrogatory on the grounds that it is overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence. Without waiving this objection, all responsive documents have been identified or produced as required.

**VERIFICATION**

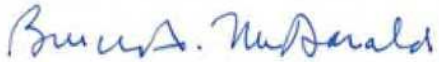
The undersigned affirms, under penalty of perjury pursuant to the laws of the United States of America, that the foregoing answers are true and accurate to the best of his knowledge, information and belief.



Frank A. Camp  
Associate General Counsel  
Intellectual Property  
Transamerica Corporate Law  
4333 Edgewood Road NE  
Cedar Rapids, IA, 52499-0001

July 23, 2014

FOR OBJECTIONS:



Bruce A. McDonald  
**BUCHANAN INGERSOLL & ROONEY PC**  
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Washington, D.C. 20006  
Tel. (202) 452-6052  
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Email: bruce.mcdonald@bipc.com

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that on July 23, 2014, a copy of the foregoing Transamerica's Answers and Objections to Schwab's First Set of Interrogatories was sent by U.S. mail, first class postage prepaid, to counsel of record for Applicant at the following address:

Laura M. Franco, Esq.  
Winston & Strawn LLP  
101 California Street, Suite 3900  
San Francisco, California 94111-5894



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Bruce A. McDonald  
Attorney  
BUCHANAN INGERSOLL & ROONEY PC

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

Serial No. 85889202

OWN YOUR TOMORROW

TRANSAMERICA CORPORATION, :

Opposer, :

Opposition No. 91214615

v. :

CHARLES SCHWAB & CO., INC. :

Applicant. :

**TRANSAMERICA’S RESPONSE TO SCHWAB’S FIRST  
REQUEST FOR PRODUCTION OF DOCUMENTS AND THINGS**

Transamerica Corporation (“Transamerica” or “Opposer”), in accordance with Rule 34 of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice, responds as follows to Schwab’s First Request for Production of Documents and Things.

**General Objections**

Opposer objects to Applicant’s requests to the extent they call for identification of attorney-client communications and attorney work product, on the grounds that the identification of such communications, under the circumstances of this case, would be unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence. In support of this objection, Opposer states that the substantial entirety of Opposer’s files relating to this mark consist of emails among and between in-house and outside counsel. Opposer requests that Applicant examine the documents produced by Opposer in response to Applicant’s Requests and identify specific issues or responses, if any, in respect to which Applicant believes there is a basis for requiring a privilege log or other detailed description of communications withheld from identification and production on the ground of privilege or work product immunity.



In addition to the above, Opposer incorporates the General Objections set forth in its Answers and Objections to Applicant's First Set of Interrogatories.

**REQUEST FOR PRODUCTION NO. 1**

All documents and things relating to the creation, development, and adoption of Opposer's Mark, including search reports, investigative reports, design concepts and communications with and memoranda between Opposer and any consultant, design firm, website design firm, advertising agency, advertising media, suppliers, or printers.

**Response**

Opposer objects to this Request on the grounds that it is overly broad and unduly burdensome in calling for the production of "all" documents and things in the designated class.

Without waiving this objection, produced herewith are the following documents:

- Thomson Compumark Trademark Search Report, March 30, 2011, TRANSFORM TOMORROW, Bates Nos. 1 -200
- Thomson Compumark Trademark Search Report, TOMORROW MAKERS, April 4, 2011, Bates Nos. 201-429
- Master Brand Style Guide, October 2013, Bates Nos. 431-480 (CONFIDENTIAL)
- Web page, TRANSFORM YOUR TOMORROW, Bates No. 481
- Transamerica Agency Network, Banner Advertisement, TRANSFORM YOUR TOMORROW, Bates No. 482
- Transamerica Agency Network, Advertising Exemplars, TRANSFORM YOUR TOMORROW, Bates Nos. 483-491
- "Launch Week Digital Highlights," Bates Nos. 492-503 (CONFIDENTIAL)
- Documents Illustrating Third-Party Use of TOMORROW Marks Disclosed in 2011 Investigation, Bates Nos. 504-854

## **REQUEST FOR PRODUCTION NO. 2**

All documents and things relating to any search or investigation reports prepared by or for Opposer relating to Schwab's Mark.

### **Response**

Opposer objects to this Request on the grounds that it is vague, overly broad and unduly burdensome in requesting “all” documents and things “relating to” any search or investigation reports prepared by or for Opposer relating to Schwab’s Mark. Without waiving this objection, produced herewith are the following:

- 7/29/2013 TESS Printout, OWN YOUR TOMORROW, Bates Nos. 855-856
- 7/29/2013 Internet printout, “Charles Schwab Launches New Campaign Celebrating the Spirit of Engagement, Press Release dated June 12, 2013, Bates Nos. 857-858
- Information and Procedures - Schwab Personal Choice Retirement Account (PCRA, Bates No. 859-865
- 7/30/2013 print-out, 2012 Retirement Plan Adviser Survey, Bates Nos. 866
- Westlaw Search Results, Bates Nos. 867-905
- Schwab Brochure, “Schwab PCRA - Frequently Asked Questions,” Bates Nos. 906-908
- Transamerica Funds, Statement of Additional Information, April 30, 2013, Bates Nos. 909-1189

## **REQUEST FOR PRODUCTION NO. 3**

The complete file history for Opposer's Registration, including all communications to and from the United States Patent and Trademark Office ("USPTO") relating thereto.

### **Response**

Opposer is unaware of any communications to or from the PTO regarding Opposer’s Registration other than those that appear in the PTO file which is available to Opposer and the public on the PTO website. Opposer objects to this Request on the grounds that it is unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence, to the

extent that it calls for the production of records available to Applicant and the public at the PTO website. Without waiving that objection, produced herewith are communications received by Opposer's counsel throughout the prosecution of Opposer's Registration identified by Bates Nos. 1190-1200.

**REQUEST FOR PRODUCTION NO. 4**

All documents reflecting communications with the USPTO relating to Opposer's Mark or Schwab's Mark.

**Response**

Opposer is unaware of any communications to or from the PTO regarding Opposer's Mark or Schwab's Mark other than those that appear in the PTO file which is available to Opposer and the public on the PTO website. Opposer objects to this Request on the grounds that it is overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence, to the extent that it calls for the production of records available to Applicant and the public at the PTO website.

**REQUEST FOR PRODUCTION NO. 5**

Documents and things sufficient to identify each and every version or variation of, or modification to, Opposer's Mark, whether or not such version, variation, or modification is currently in use.

**Response**

Variations of Opposer's Mark, including but not limited to TRANSFORM TOMORROW, are illustrated in documents produced herewith identified by Bates Nos. 1201-1373.

**REQUEST FOR PRODUCTION NO. 6**

Documents and things sufficient to identify each and every version, variant or modification of Opposer's Mark previously used, currently in use, or intended to be used by Opposer on any good or service.

**Response**

See response to Request No. 5 above.

**REQUEST FOR PRODUCTION NO. 7**

Documents and things sufficient to identify all intended or actual uses of Opposer's Mark.

**Response**

In addition to documents produced in response to the foregoing requests, see the following documents produced herewith:

- “Life & Protection at a Glance,” Power Point Presentation, Bates Nos. 1374-1379 (CONFIDENTIAL)
- Transamerica Retirement Solutions, Conversion News, TRANSFORM YOUR TOMORROW, Bates Nos. 1380-1383
- “Transamerica wants to help Transform Your Tomorrow,” Facebook, May 23, 2012, Bates No. 1834
- “Choose to Save and transform your tomorrow,” Facebook, May 29, 2014, Bates No. 1835
- “Choose to save and transform your tomorrow,” Twitter, May 29, 2014, Bates No. 1836
- Enrollment Book, “Transform Your Tomorrow,” Bates Nos. 1837-1872 (CONFIDENTIAL)
- Advertising Exemplars, “Transform Your Tomorrow,” Bates Nos. 1873-1876

**REQUEST FOR PRODUCTION NO. 8**

Representative examples of each type of good or service offered or sold under Opposer's Mark.

**Response**

Opposer objects to this Request on the grounds of vagueness inasmuch as Opposer is engaged in insurance, investment and retirement services, and cannot provide a representative example of a service in the form of these responses. Opposer interprets the Request to call for the production of documents illustrating each type of service offered and sold under Opposer's Mark and objects to the Request on the grounds that it is overly broad and unduly burdensome to the extent it calls for the production of additional documents. Without waiving this objection, Opposer refers Applicant to the documents produced in response to Request Nos. 5 and 7 above.

**REQUEST FOR PRODUCTION NO. 9**

All documents and things relating to any plan Opposer has to expand the types of goods and services it offers for sale under Opposer's Mark.

**Response**

Opposer is currently unaware of any responsive documents or things.

**REQUEST FOR PRODUCTION NO. 10**

Documents and things sufficient to identify the first or earliest use of every good or service offered or sold under Opposer's Mark.

**Response**

See specimen filed by Opposer at PTO on February 14, 2013, Bates No. 1877.



**REQUEST FOR PRODUCTION NO. 11**

Documents and things sufficient to show, by month and by product or service, all sales (whether direct or indirect) of goods or services offered or sold under Opposer's Mark by dollar amount and number of units sold, for each year since Opposer's first use of Opposer's Mark.

**Response**

Opposer objects to this Request on the grounds that it is overly broad and unduly burdensome in calling for the identification of “all” sales, whether “direct or indirect,” categorized “by month and by product or service” and by “number of units.” Without waiving this objection, Opposer refers Applicant to the confidential Power Point presentation entitled “Life and Protection at a Glance,” Bates Nos. 1374-1379, in addition to the Dun & Bradstreet reports produced herewith under Bates Nos. 1878-1925.

**REQUEST FOR PRODUCTION NO. 12**

All documents and things relating to any analyses, studies, or reports of the sales or prospective sales of Opposer's goods or services under Opposer Mark, including but not limited to business plans, marketing plans, development plans, financial plans, and budgetary plans.

**Response**

Opposer objects to this Request on the grounds that it is overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence, to the extent that it calls for the production of documents in addition to those produced in response to Request No. 11. In support of this objection Opposer states that, because Opposer's Mark is a slogan used by Opposer on an “enterprise wide” basis, the Request is tantamount to a request for all analyses, studies, and reports of all sales and prospective sales of all Opposer's services, including but “not limited to” business plans, marketing plans, development plans, financial plans, and budgetary plans. Without waiving this objection, produced herewith is a confidential

Power Point presentation entitled “Life and Protection at a Glance,” Bates Nos. 1374-1379, in addition to the following:

- Cerulli Associates, The Cerulli Report, Retirement Markets 2013, Data & Dynamics of Employer-Sponsored Plans, Bates Nos. 1926-2141 (CONFIDENTIAL)
- Excel Spreadsheet, “Open-Ended Mutual Fund Firms,” Bates Nos. 2142-2154 (CONFIDENTIAL)
- Plansponsor.com, “The Forest and the Trees,” Bates Nos. 2155-2170
- 2012 Plansponsor, “DC Survey Best in Class,” Bates Nos. 2171-2174

### **REQUEST FOR PRODUCTION NO. 13**

Copies of all advertisements or marketing or promotional pieces bearing Opposer's Mark, including, but not limited to, brochures, catalogues, circulars, leaflets, direct mail pieces, newspaper and magazine advertisements, commercials (aired on television or radio, cable stations, streamed or downloadable via the Internet or other device), websites, price lists, trade association listings, annual reports, and any other material such as labels, tags, packages, containers, decals, stamps, and name plates used by Opposer, its distributors, or other providers of its products or services.

#### **Response**

Opposer objects to this Request on the grounds that it is overly broad, unduly burdensome and not likely to lead to the discovery of admissible evidence, to the extent that it requires the production of “all” documents in the designated class. Without waiving this objection, Opposer states that its advertisements, marketing and promotional pieces bearing Opposer’s mark are fairly and representatively depicted in the website excerpts and other examples produced in response to Request Nos. 1, 5 and 7 above.

### **REQUEST FOR PRODUCTION NO. 14**

All press releases and written statements issued by or on behalf of Opposer relating to Opposer's Mark.

#### **Response**

Opposer is presently unaware of any responsive documents or things.

**REQUEST FOR PRODUCTION NO. 15**

All unsolicited press relating to Opposer's Mark.

**Response**

Opposer is presently unaware of any responsive documents or things.

**REQUEST FOR PRODUCTION NO. 16**

For each website owned or operated by Opposer, all documents illustrating, relating or referring to any and all appearance of Opposer's Mark that appears [sic] previously at such website, but no longer appears as of the date of Opposer's responses to these discovery requests.

**Response**

Opposer objects to this Request on the grounds that it is overly broad, unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence. Without waiving this objection, Opposer states that it is currently unaware of any instance in which a depiction of its Mark has been removed from any website other than in the course of routine marketing, and that Opposer is further unaware of any previous web page differing in form or substance from the excerpts of Opposer's websites produced in response to the foregoing Requests.

**REQUEST FOR PRODUCTION NO. 17**

Documents and things sufficient to show all trade shows or industry events at which Opposer has promoted goods or services under Opposer's Mark or at which Opposer intends to promote goods or services thereunder.

**Response**

Opposer objects to this Request on the grounds that it is overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence, in calling for the identification of "all" trade shows and industry events at which Opposer has promoted services under Opposer's Mark or at which Opposer intends to promote services

thereunder. Without waiving this objection, the following documents illustrate trade shows and industry events that were jointly sponsored and/or attended by Opposer and Applicant:

- National Association of Plan Advisors (NAPA), NAPA 401(k) Summit 2015, March 22-24, 2015, San Diego, CA, Bates Nos. 2175-2188
- National Association of Plan Advisors (NAPA), NAPA 401(k) Summit 2014, March 23-25, 2014, New Orleans, LA, Bates Nos. 2189-2206
- Plan Sponsor Council of America, 65<sup>th</sup> Annual National Conference, September 11-14, 2012, New Orleans, LA, Bates Nos. 2207-2217
- Plan Sponsor Council of America, 64<sup>th</sup> Annual National Conference, September 19-22, 2011, Las Vegas, NV, Bates Nos. 2218-2230
- SouthWest Benefits Association, 39<sup>th</sup> Annual Conference, May 7-9, 2014, Austin, TX, Bates Nos. 2231-2237
- Retirement Industry Conference, April 9-11, 2014, Chicago, IL, Bates Nos. 2238-2249 and 2250-2260
- Financial Planning Association of Long Island, 14<sup>th</sup> Annual Symposium & Exhibition, November 1, 2013. Bates Nos. 2261-2278
- Bank Innovators Council, FinovateSpring, April 29-30, 2014, Bates Nos. 2279-2315
- Women Advisors Forum 2013 Series, Bates Nos. 2316-2321
- Investment Company Institute, 2014 General Membership Meeting, May 20-22, 2014, Washington, D.C., Bates Nos. 2322-2338
- PiMA, 2014 Midyear Meeting & Tradeshow, July 17-20, 2014, Napa, CA, Bates Nos. 2339-2340

### **REQUEST FOR PRODUCTION NO. 18**

Examples of all non-traditional advertising and promotions (e.g., product placements, location naming rights, etc.) featuring Opposer's Mark.

### **Response**

Opposer is currently unaware of any responsive documents or things.

**REQUEST FOR PRODUCTION NO. 19**

Documents and things sufficient to identify all publications and broadcast media in which Opposer has advertised, is advertising, or is planning to advertise any goods or services offered or sold under Opposer's Mark.

**Response**

Opposer objects to this Request to the extent that it requires the identification of “all” publications and broadcast media in which Opposer has advertised, is advertising, or is planning to advertise any goods or services offered or sold under Opposer’s Mark. Without waiving this objection, Opposer refers Applicant to the documents produced in response to Request Nos. 1, 5 and 7.

**REQUEST FOR PRODUCTION NO. 20**

All documents and things relating to Opposer's expenditures on advertising and marketing activities in connection with Opposer's Mark or any variation thereof.

**Response**

Opposer objects to this Request on the grounds that it is overly broad and unduly burdensome in calling for the production of “all” documents and things in the designated class. The Request is also unduly burdensome inasmuch as Opposer’s accounting for advertising and marketing activities does not indicate specifically what expenses are attributable to Opposer’s Mark. Without waiving this objection, Opposer refers Applicant to the Declaration of Craig D. Vermie produced herewith under Bates Nos. 2341-2376.

**REQUEST FOR PRODUCTION NO. 21**

Documents sufficient to show, by month, all expenditures in connection with the marketing, advertising and promotion of Opposer's Mark, by category of expense for each year since Opposer's first use of Opposer's Mark.

**Response**

Opposer objects to this Request on the grounds that it is overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence, inasmuch as Opposer's accounting for marketing, advertising and promotion does not indicate specifically what expenses are attributable to Opposer's Mark. The Request is also unduly burdensome in calling for a breakdown of the designated expenses by month. Without waiving this objection, Opposer refers Applicant to the Declaration of Craig D. Vermie, produced herewith under Bates Stamp Nos. 2341-2376, at Paragraphs 30-31.

**REQUEST FOR PRODUCTION NO. 22**

Documents and things sufficient to identify the geographic scope of the advertising, distribution and sale of goods or services offered or sold under Opposer's Mark.

**Response**

Opposer objects to this request on the grounds that it is overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence. Opposer's services under the pleaded mark are offered throughout the United States and internationally. Without waiving this objection, Opposer refers Applicant to the documents produced in response to Request Nos. 5 and 17 above.



**REQUEST FOR PRODUCTION NO. 23**

All documents and things sufficient to identify the types, characteristics, geographic locale, or classes of persons or end-users who purchase or use goods or services offered or sold under Opposer's Mark.

**Response**

Opposer objects to this Request on the grounds that it is overly broad and unduly burdensome in calling for the production of “all” documents and things in the designated class. Without waiving this objection, Opposer refers Applicant to the documents produced in response to Request Nos. 5 and 17 above, in addition to the confidential Power Point presentation entitled “Life and Protection at a Glance,” Bates Nos. 1374-1379.

**REQUEST FOR PRODUCTION NO. 24**

All document and things which identify or analyze the market or class of customer or end-user to which Opposer sells, or intends to sell, goods or services offered or sold under Opposer's Mark.

**Response**

Opposer objects to this Request on the grounds that it is overly broad and unduly burdensome in calling for production of “all” documents and things in the designated class. Without waiving this objection, Opposer refers Applicant to the documents produced in response to Request Nos. 5 and 17 above, in addition to the confidential Power Point presentation entitled “Life and Protection at a Glance,” Bates Nos. 1374-1379; the Bids Won / Bids Lost Questionnaires identified by Bates Nos. 2384-2505 (CONFIDENTIAL); and the Ranking Summary, Bates Nos. 2506-2512 (CONFIDENTIAL).

**REQUEST FOR PRODUCTION NO. 25**

Documents and things sufficient to identify all actual or intended channels of trade and distribution of goods or services offered or sold under Opposer's Mark.

**Response**

See response to Request Nos. 5 and 17 above, in addition to the confidential Power Point presentation entitled "Life and Protection at a Glance," Bates Nos. 1374-1379.

**REQUEST FOR PRODUCTION NO. 26**

Documents and things sufficient to identify the distribution outlets for each of the goods and services offered or sold under Opposer's Mark.

**Response**

See response to Request Nos. 5 and 17 above, in addition to the confidential Power Point presentation entitled "Life and Protection at a Glance," Bates Nos. 1374-1379.

**REQUEST FOR PRODUCTION NO. 27**

All documents and things relating to or comprising any consumer or marketing survey, test or study Opposer has conducted or caused to be conducted regarding the public's or the trade's recognition of or reaction to Opposer's Mark or to Schwab's Mark.

**Response**

Opposer is currently unaware of any responsive documents or things.

**REQUEST FOR PRODUCTION NO. 28**

All documents and things relating to or comprising any consumer or marketing survey, test or study Opposer has conducted or caused to be conducted regarding any confusion among the public or the trade resulting from Schwab's use of Schwab's Mark.

**Response**

Opposer is currently unaware of any responsive documents or things.

**REQUEST FOR PRODUCTION NO. 29**

All documents and things, including but not limited to any survey or other compilation of information, relating to actual confusion, mistake or deception, or likelihood of confusion or lack thereof, between Opposer and Schwab or between Opposer's Mark and Schwab's Mark.

**Response**

Opposer is currently unaware of any responsive documents or things.

**REQUEST FOR PRODUCTION NO. 30**

All documents and things relating to inquiries from third parties to Opposer regarding the relationship of, or distinction between, Opposer and Schwab or between Opposer's Mark and Schwab's Mark.

**Response**

Opposer is currently unaware of any responsive documents or things.

**REQUEST FOR PRODUCTION NO. 31**

All documents and things relating to any actual or likely confusion or mistake as to an association between Opposer or goods and services offered or sold under Opposer's Mark, and Schwab or goods or services offered or sold under Schwab's Mark, including misdirected communications.

**Response**

Opposer is currently unaware of any responsive documents or things.

**REQUEST FOR PRODUCTION NO. 32**

All documents and things relating to any survey, test, investigation or study Opposer has conducted or has caused to be conducted regarding any confusion among the public, retailers, or the trade resulting from the use of Opposer's Mark.

**Response**

Opposer is currently unaware of any responsive documents or things.

**REQUEST FOR PRODUCTION NO. 33**

All documents illustrating any third party uses, applications and registrations for any trademark, service mark, trade name, business name, or other designation that includes the term "YOUR TOMORROW" in the insurance or financial services industries.

**Response**

See the following documents produced herewith:

- Thomson Compumark Trademark Search Report, March 30, 2011, TRANSFORM TOMORROW, Bates Nos. 1-200
- Thomson Compumark Trademark Search Report, TOMORROW MAKERS, April 4, 2011, Bates Nos. 201-429

**REQUEST FOR PRODUCTION NO. 34**

All documents illustrating any third party uses, applications and registrations for any trademark, service mark, trade name, business name, or other designation that includes the term "TOMORROW" in the insurance or financial services industries.

**Response**

See response to Request No. 33 above.

**REQUEST FOR PRODUCTION NO. 35**

Documents and things sufficient to demonstrate those goods or services offered or sold under Schwab's Mark which Opposer considers to be competitive with goods or services offered or sold under Opposer's Mark.

**Response**

See documents produced in response to Request Nos. 2 and 17 above in addition to the following:

- "Heated Competition For Branded Retirement Apps," Bates Nos. 2377-2379
- Bids Won / Bids Lost Questionnaires, identified by Bates Nos. 2384-2505 (CONFIDENTIAL)

**REQUEST FOR PRODUCTION NO. 36**

All documents and things evidencing any assignment of rights in or to Opposer's Mark.

**Response**

Opposer is currently unaware of any responsive documents or things.

**REQUEST FOR PRODUCTION NO. 37**

All documents and things relating to any permission given by Opposer to any third party to use or to register a trademark, service mark, or trade name which Opposer considered or considers to be similar or identical to Opposer's Mark, including but not limited to franchise, license and consent agreements.

**Response**

Opposer is currently unaware of any responsive documents or things.

**REQUEST FOR PRODUCTION NO. 38**

All documents and things relating to any challenges Opposer has ever made against any third party, and any third party has made against Opposer, concerning Opposer's Mark or any variant thereof.

**Response**

Opposer is currently unaware of any responsive documents or things.

**REQUEST FOR PRODUCTION NO. 39**

All documents and things relating to any U.S. federal or state court, USPTO, or other administrative proceeding, filed by Opposer or filed against Opposer relating to Opposer's Mark.

**Response**

Opposer is currently unaware of any responsive documents or things.

**REQUEST FOR PRODUCTION NO. 40**

All documents and things relating to Opposer's first notice of Schwab's use of Schwab's Mark and of Schwab's Application.

**Response**

See response to Request No. 2 above.

**REQUEST FOR PRODUCTION NO. 41**

All communications between Opposer and Schwab, or representatives of each, relating to any of the issues involved in this proceeding.

**Response**

Opposer is currently unaware of any responsive documents.

**REQUEST FOR PRODUCTION NO. 42**

All documents and things relating to or comprising any inquiry, investigation or survey conducted by or on behalf of Opposer regarding any issues involved in this proceeding.

**Response**

Opposer objects to this Request on the grounds of vagueness to the extent it calls for the production of documents or things in addition to those which have been produced in response to the foregoing Requests.

**REQUEST FOR PRODUCTION NO. 43**

All documents and things prepared by or relied upon by an expert engaged by Opposer, or any person acting on Opposer's behalf, relating to any of the issues in this proceeding, including statements or opinions.

**Response**

Opposer is currently unaware of any responsive documents or things.

**REQUEST FOR PRODUCTION NO. 44**

All statements of opinion of any expert engaged by Opposer, or any person acting on Opposer's behalf, relating to any issues involved in this proceeding.

**Response**

Opposer is currently unaware of any responsive documents or things.



**REQUEST FOR PRODUCTION NO. 45**

All documents and things, other than those produced in response to any of the foregoing requests, upon which Opposer intends to rely in this proceeding.

**Response**

Opposer objects to this Request on the grounds that it is unduly burdensome in requiring the designation of such documents prior to the Notice of Reliance. Without waiving this objection, Opposer states that it is not aware of any additional responsive documents at this time.

**REQUEST FOR PRODUCTION NO. 46**

All documents and things, other than those produced in response to any of the foregoing requests, identified by Opposer in its responses to Schwab's First Set of Interrogatories.

**Response**

Opposer is currently unaware of any additional responsive documents or things.

**REQUEST FOR PRODUCTION NO. 47**

All documents and things relating to Opposer's policies regarding retention, storage, filing and destruction of documents and things.

**Response**

Opposer objects to this Request on the grounds that it is unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence. Without waiving this objection, Opposer states that it has retained, stored and/or filed all known documents and things responsive to this Request, and has not knowingly lost or destroyed any responsive documents or things.

**REQUEST FOR PRODUCTION NO. 48**

Documents and things sufficient to describe Opposer's business structure or organization.

**Response**

Opposer objects to this Request on the grounds that it is vague, overly broad, unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence. Without waiving this objection, Opposer refers Applicant to the Dun & Bradstreet reports produced herewith under Bates Nos. 1878-1925.

**REQUEST FOR PRODUCTION NO. 49**

Documents and things sufficient to identify Opposer's officers since the date Opposer's Mark was developed or created.

**Response**

Opposer objects to this Request on the grounds that it is vague, overly broad, unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence. Without waiving this objection, Opposer refers Applicant to the Dun & Bradstreet reports produced herewith under Bates Nos. 1878-1925.

**REQUEST FOR PRODUCTION NO. 50**

A current resume or curriculum vitae for each of the persons identified in response to Interrogatory No. 4.

**Response**

See documents produced herewith under Bates Nos. 2380-2383.

**REQUEST FOR PRODUCTION NO. 51**

All documents referring or relating to Schwab.

**Response**

Opposer objects to this Request on the grounds that it is overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence. Without waiving this objection, Opposer refers Applicant to the documents and things produced herewith in response to Request Nos. 2, 17 and 35 above.

**REQUEST FOR PRODUCTION NO. 52**

All documents referring or relating to Schwab's Mark.

**Response**

Opposer objects to this Request on the grounds that it is overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence. Without waiving this objection, Opposer refers Applicant to the documents and things produced herewith in response to Request Nos. 2, 17 and 35 above.

**REQUEST FOR PRODUCTION NO. 53**

All documents referring or relating to Schwab's Application.

**Response**

Opposer objects to this Request on the grounds that it calls for the production of communications protected from disclosure by the attorney client privilege and work product doctrine. Without waiving this objection, the only non-privileged documents in Opposer's files responsive to this Request are those available to Applicant and the public on the PTO website.

**REQUEST FOR PRODUCTION NO. 54**

All brand guides relating to Opposer's Mark.

**Response**

See Master Brand Style Guide, October 2013, Bates Nos. 431-480 (CONFIDENTIAL).

**REQUEST FOR PRODUCTION NO. 55**

All documents identified in response to an interrogatory.

**Response**

With the exception of routine cover memos among and between in-house and outside counsel, which are protected from disclosure by the attorney client privilege and attorney work product doctrine, all documents identified in response to Applicant's Interrogatories have been produced. Opposer reserves the right to produce additional responsive documents if and when identified.

**REQUEST FOR PRODUCTION NO. 56**

All documents identified in response to a request for admission.

**Response**

With the exception of cover memos among and between in-house and outside counsel which are protected from disclosure by the attorney client privilege and attorney work product doctrine, all documents identified in response to Applicant's discovery requests have been

produced. Opposer reserves the right to produce additional responsive documents if and when identified.

Respectfully submitted,

**TRANSAMERICA CORPORATION**

A handwritten signature in blue ink that reads "Bruce A. McDonald".

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

Bruce A. McDonald

**BUCHANAN INGERSOLL & ROONEY PC**

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Washington, D.C. 20006

Tel. (202) 452-052

Email: [bruce.mcdonald@bipc.com](mailto:bruce.mcdonald@bipc.com)

Date: July 23, 2014

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that on July 23, 2014, a copy of the foregoing TRANSAMERICA'S RESPONSE TO SCHWAB'S FIRST REQUEST FOR PRODUCTION OF DOCUMENTS AND THINGS, was served by U.S. mail, first class postage prepaid, as well as email, on Applicant's counsel of record at the following address:

Laura M. Franco, Esq.  
**WINSTON & STRAWN LLP**  
101 California Street  
San Francisco, CA 94111-5894  
[trademarksf@winston.com](mailto:trademarksf@winston.com)



---

Bruce A. McDonald  
Attorney  
BUCHANAN INGERSOLL & ROONEY PC





**INTERROGATORY NO. 35:** Describe the nature of the commercial activities engaged in by Transamerica Agency Network, Inc. including all goods and services offered by it.

**INTERROGATORY NO. 36:** Describe all uses of Opposer's Mark made by Transamerica Agency Network, Inc.

**INTERROGATORY NO. 37:** Describe the nature of the commercial activities engaged in by Monumental Life Insurance Company including all goods and services offered by it.

**INTERROGATORY NO. 38:** Describe all uses of Opposer's Mark made by Monumental Life Insurance Company.

**INTERROGATORY NO. 39:** Describe the nature of the commercial activities engaged in by Transamerica Life Insurance Group including all goods and services offered by it.

**INTERROGATORY NO. 40:** Describe all uses of Opposer's Mark made by Transamerica Life Insurance Group.

**INTERROGATORY NO. 41:** Identify all keyword search buys made by You or on Your behalf concerning Opposer's Mark.

**INTERROGATORY NO. 42:** Identify any time periods when the use of Opposer's Mark was discontinued on any of the goods or services identified in Registration No. 4,325,690 and the reasons for such discontinuance.

**INTERROGATORY NO. 43:** Identify the employees of J Walter Thompson U.S.A., Inc. with the most knowledge of the advertising, marketing and promotion of Opposer's Mark.

**INTERROGATORY NO. 44:** Identify all factual bases that support your denial of Request for Admission No. 13.

Dated: July 25, 2014

WINSTON & STRAWN LLP

By:

  
\_\_\_\_\_  
Laura M. Franco

Laura M. Franco  
101 California Street  
San Francisco, California 94111-5894  
Telephone: (415) 591-1000  
Facsimile: (415) 591-1400  
trademarksf@winston.com

Attorneys for Applicant  
Charles Schwab & Co., Inc.



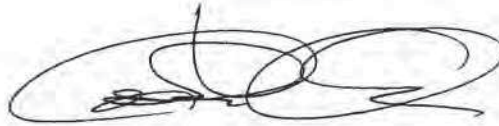
**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing APPLICANT'S SECOND SET OF INTERROGATORIES has been served on Opposer's counsel of record by emailing said copy on July 25, 2014 to:

Bruce A. McDonald, Esq.  
Buchanan Ingersoll & Rooney PC  
1700 K Street, N.W., Suite 300  
Washington, D.C. 20006  
[bruce.mcdonald@bipc.com](mailto:bruce.mcdonald@bipc.com)

and

Holly B. Lance, Esq.  
Buchanan Ingersoll & Rooney PC  
1737 King Street, Suite 500  
Alexandria, VA 22314  
[holly.lance@bipc.com](mailto:holly.lance@bipc.com)



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Carleen Chea

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

Trademark Ser. No.: 85/889,202  
Mark: OWN YOUR TOMORROW  
Filed: March 28, 2013

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TRANSAMERICA CORPORATION

Opposer,

v.

CHARLES SCHWAB & CO., INC.,

Applicant.

---

Opposition No. 91214615

**SCHWAB'S SECOND SET OF REQUESTS FOR  
PRODUCTION OF DOCUMENTS AND THINGS**

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Pursuant to Trademark Rule of Practice 2.120 and Federal Rules of Civil Procedure 26 and 34, Applicant Charles Schwab & Co., Inc., requests that Opposer Transamerica Corporation respond in writing to Schwab's Second Set of Requests for the Production of Documents and Things, and produce and permit the inspection and copying of responsive materials at the office of Winston & Strawn, LLP, 101 California Street, Suite 3900, San Francisco, CA 94111, within thirty (30) days of the date of service of these requests.

Schwab hereby incorporated by reference herein each of the Definitions and Instructions contained in Schwab's First Set of Requests for Production of Documents and Things to Opposer.

**REQUESTS**

**REQUEST FOR PRODUCTION NO. 57:** All documents and things concerning any town hall-like discussions relating to financial planning that have taken place on college campuses or in any other venue in which Opposer's Mark was used.

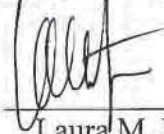
**REQUEST FOR PRODUCTION NO. 58:** All documents and things concerning any period of time during which use of Opposer's Mark was discontinued in connection with any of the goods or services covered in Registration No. 4,325,690.

**REQUEST FOR PRODUCTION NO. 59:** All documents relating to any keyword search buys made by Opposer or on Opposer's behalf concerning Opposer's Mark.

**REQUEST FOR PRODUCTION NO. 60:**

Dated: July 25, 2014

WINSTON & STRAWN LLP

By:   
\_\_\_\_\_  
Laura M. Franco

Laura M. Franco  
101 California Street  
San Francisco, California 94111-5894  
Telephone: (415) 591-1000  
Facsimile: (415) 591-1400  
trademarksf@winston.com

Attorneys for Applicant  
Charles Schwab & Co., Inc.



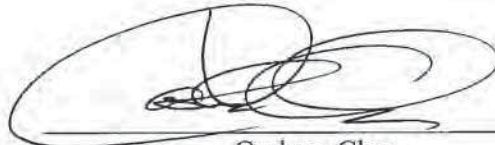
**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing APPLICANT'S SECOND SET OF REQUESTS FOR THE PRODUCTION OF DOCUMENTS AND THINGS has been served on Opposer's counsel of record by emailing said copy on July 25, 2014 to:

Bruce A. McDonald, Esq.  
Buchanan Ingersoll & Rooney PC  
1700 K Street, N.W., Suite 300  
Washington, D.C. 20006  
[bruce.mcdonald@bipc.com](mailto:bruce.mcdonald@bipc.com)

and

Holly B. Lance, Esq.  
Buchanan Ingersoll & Rooney PC  
1737 King Street, Suite 500  
Alexandria, VA 22314  
[holly.lance@bipc.com](mailto:holly.lance@bipc.com)



Carleen Chea

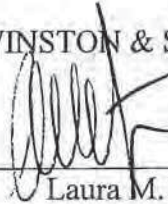


Pursuant to Rule 30(b)(6) of the Federal Rules of Civil Procedure, Transamerica is required to designate one or more officers, directors, employees or other persons who will testify on its behalf regarding the subject matters and topics listed in Attachment A. Transamerica is requested to provide Schwab's counsel, as soon as reasonably possible, a written designation of the name(s) and position(s) of the person(s) who will testify on behalf of Transamerica, and, for each person designated, the matters set forth in Attachment A as to which he or she will testify.

Dated: July 31, 2014

Respectfully submitted,

WINSTON & STRAWN LLP



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Laura M. Franco

101 California Street  
San Francisco, California 94111-5894  
Telephone: (415) 591-1000  
Facsimile: (415) 591-1400  
David Bloch, [dbloch@winston.com](mailto:dbloch@winston.com)  
Jennifer Golinveaux, [jgolinveaux@winston.com](mailto:jgolinveaux@winston.com)  
Laura Franco, [lfranco@winston.com](mailto:lfranco@winston.com)

Attorneys for Applicant  
CHARLES SCHWAB & CO., INC.



**ATTACHMENT A**

**DEFINITIONS**

1. "You," "Your," or "Opposer" or "Transamerica" means Opposer Transamerica Corporation and its past or present officers, members, employees, agents, independent contractors, assigns, affiliates, predecessors, successors, divisions, departments, bureaus, offices, parents, subsidiaries and any other person acting or purporting to act for or on behalf of, or in privity with Opposer, and any person controlled by or which controls Opposer, including but not limited to Transamerica Agency Network, Inc., Life Investors Financial Group, Inc. and Monumental Life Insurance Company.

2. "Applicant" or "Schwab" means Applicant Charles Schwab & Co., Inc. and its past or present officers, members, employees, agents, independent contractors, assigns, affiliates, predecessors, successors, divisions, departments, bureaus, offices, subsidiaries and any other person acting or purporting to act for or on behalf of, or in privity with Schwab, and any person controlled by or which controls Schwab.

3. "Opposition" means Opposition No. 91214615 filed by Transamerica in the United States Patent and Trademark Office before the Trademark Trial and Appeal Board.

4. "Application" means U.S. Trademark Application Serial No. 85/889,202 for Schwab's Mark.

5. "Schwab's Mark" means the mark OWN YOUR TOMORROW, which is the subject of the Application.

6. "Opposer's Mark" or "Your Mark" means the mark TRANSFORM YOUR TOMORROW, which is the subject of U.S. Trademark Registration No. 4,325,690.

7. "Documents" shall have the broadest meaning ascribed to it by Federal Rule of Civil Procedure 34, and shall include within its meaning any and all papers, videotapes or video recordings, photographs, films, recordings, memoranda, books, records, accounts, letters, telegrams, correspondence, notes of meetings, notes of conversations, notes of telephone calls, inter-office memoranda or written communications of any nature, instant messages, texts, blogs,



social media posts or messages, emails, recordings of conversations either in writing or by means of any mechanical, electrical or digital recording device, notes, papers, reports, analyses, invoices, canceled checks or check stubs, receipts, minutes of meetings, time sheets, diaries, desk calendars, ledgers, schedules, licenses, financial statements, telephone bills, logs and any differing versions of the foregoing whether denominated formal, informal, or otherwise, as well as copies of the foregoing which differ in any way, including handwritten notations or other written or printed matter of any nature, from the original. The foregoing specifically includes the information stored in any form, including electronic form, on a computer or in a computer database or cloud server or otherwise, including electronic mail.

8. The term “concerning” means relating to, discussing, referring to, describing, reflecting, evidencing or constituting.

9. “Communication” means and includes any meeting, conference, face-to-face conversation, telephone conversation, or conference or communication by any medium as well as any written, taped, or recorded communication of any kind whatsoever, through which there is an expression or exchange of information, whether in speech, writing, or any other form, and shall include all facts surrounding such exchange, including but not limited to, the date of the exchange, the content of the exchange, the parties to the exchange, and any witnesses to the exchange.

10. The terms “all” and “each” shall be construed to include all and each.

11. The term “and” shall be construed to include “or” and *vice versa* and shall be the logical equivalent of “and/or.”

12. The use of the singular form of any word also includes the plural and vice versa.

13. “Including” shall mean including, but not by way of limitation.

14. “Relating to” means concerning, referring to, summarizing, reflecting, constituting, comprising, stating, containing, embodying, pertaining to, identifying, involved with, mentioning, discussing, consisting of, showing, commenting upon, evidencing, supporting, responding to, dealing with, describing, analyzing, or in any way pertinent to that subject.



15. As pertains to a person or entity, “identify” means to state the person/entity’s name, title, last known address, and last known telephone number.

16. As pertains to a litigation, “identify” means to state the case name, number, and jurisdiction, and to provide the names of the parties to the case.

17. As pertains to a communication, “identify” means to identify the parties involved in the communication, give the date, time, location, and medium of the communication; and provide a description of the substance of the communication.

18. As pertains to a document, “identify” means to identify the date, form, author, recipient, location; and provide a description of the substance of the document.

#### **SUBJECT MATTER OF TESTIMONY**

1. The facts and circumstances concerning the creation, selection, development and promotion of Your Mark.

2. Your business relationship with any outside agency, including but not limited to J. Walter Thompson Company, and the extent of such agency’s involvement in the creation, selection, development and promotion of Your Mark.

3. The process by which You cleared Your Mark for use and registration.

4. Your efforts to secure registration of Your Mark, including the prosecution of Your Mark with the USPTO.

5. Alternative marks that You considered or that were proposed to You during the creation, selection and development of Your Mark.

6. All versions and variations of Your Mark, previously, currently or intended to be used by You, including “TRANSFORM TOMORROW,” and the goods and services on or with which such version or variation was, is or is intended to be used.

7. All searches, reports, investigations, or other research conducted by You or on Your behalf concerning marks that contain the word “TOMORROW.”

8. The scope of use of Your Mark.



9. The goods and services previously, currently or intended to be offered under Your Mark.
10. Sales of the goods and services offered under Your Mark, including revenues earned therefrom.
11. All advertising, marketing and promotion for Your Mark or goods and services offered under Your Mark, and all costs and expenses incurred by You relating thereto.
12. The geographic scope of the advertising, marketing and promotion of Your Mark or goods or services offered under Your Mark.
13. All websites owned, controlled, or operated by You on which Your Mark has been displayed.
14. Your knowledge of marks, trade or business names, or other designations used or registered by third parties in the insurance, investment or financial services industries that include the terms "YOUR TOMORROW" or "TOMORROW."
15. The intended audience for Your Mark and the intended consumers or end-users of the goods and services offered under Your Mark.
16. The channels of trade and distribution of goods and services offered under Your Mark.
17. The circumstances under which you first became aware of Schwab's Mark and Schwab's Application.
18. Your investigation of Schwab's Mark and Schwab's use of Schwab's Mark.
19. Your enforcement practices concerning Your Mark as against all third parties.
20. The facts giving rise to this Opposition and Your decision to pursue it.
21. Any consumer or marketing survey, test, investigation or study You have conducted or caused to be conducted regarding the public's or the trade's recognition of or reaction to Your Mark or to Schwab's Mark.

22. Any consumer or marketing survey, test, investigation, or study You have conducted or has caused to be conducted regarding any confusion among the public or the trade resulting from the Schwab Mark or Schwab's use of the Schwab Mark.

23. All instances of actual confusion between Schwab's Mark and Your Mark, and the circumstances surrounding each such incident, the people involved and the date of each such incident.

24. All challenges, threats, lawsuits or administrative proceedings concerning Your Mark, other than this Opposition.

25. All assignments, licenses, rights or permissions granted by or to You concerning Your Mark.

26. All entities other than You that use Your Mark and the scope of their use.

27. All communications with Applicant concerning Your Mark or Schwab's Mark.

28. All communications with third parties concerning Your Mark (as it relates to the issues in this Opposition) or concerning Schwab's Mark.

29. All communications with the USPTO relating to Your Mark or Schwab's Mark.

30. Your organizational structure to the extent it relates to the use or ownership of Your Mark.

31. Your document retention and destruction policies.

32. All documents, information and things referred to in or relied upon by You in preparing Your responses to Schwab's Discovery Requests.

33. All documents and things produced by You in response to Schwab's Discovery Requests.

34. Your efforts to locate documents and things responsive to Schwab's Discovery Requests.

35. All information identified, mentioned, referenced, reviewed, or relied upon by You in preparation for each of these deposition topics.

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing SCHWAB'S FED. R. CIV. P. 30(B)(6) DEPOSITION NOTICE TO TRANSAMERICA has been served on Opposer's counsel of record identified below via email with a confirming courtesy copy via U.S. Mail on July 31, 2014:

Bruce A. McDonald, Esq.  
Holly B. Lance, Esq.  
Buchanan Ingersoll & Rooney PC  
1700 K Street, N.W., Suite 300  
Washington, D.C. 20006  
[bruce.mcdonald@bipc.com](mailto:bruce.mcdonald@bipc.com)  
[holly.lance@bipc.com](mailto:holly.lance@bipc.com)



---

Ciara Garlitos



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

Serial No. 85889202  
OWN YOUR TOMORROW

TRANSAMERICA CORPORATION,	:	
	:	
Opposer,	:	Opposition No. 91214615
	:	
v.	:	
	:	
CHARLES SCHWAB & CO., INC.,	:	
	:	
Applicant.	:	

**DECLARATION OF JENNIFER TAFET KLAUSNER**

My name is Jennifer Tafet Klausner. I am a partner in the Litigation Practice Group of Davis & Gilbert LLP, a law firm located at 1740 Broadway, New York, NY 10019. This firm represents J. Walter Thompson U.S.A., LLC. (“JWT”), and its affiliate, Mindshare USA, LLC (“Mindshare”). These companies are named in subpoenas issued by Applicant on July 24, 2014, in the present case, copies appended as Attachments 1 and 2 to Transamerica’s Motion to Quash and For Protective Order, filed herewith. I am submitting this Declaration in support of Transamerica’s Motion, and the statements appearing below are within my personal knowledge and/or based on information available to me in the ordinary course of business.

1. JWT and Mindshare are advertising and media agencies engaged by Transamerica Corporation. As such, it appears from my examination of the subpoenas that any and all discoverable information and documents designated in the two subpoenas are either in the custody or control of Transamerica Corporation, or are available to Transamerica from JWT and Mindshare upon request. JWT and Mindshare therefore intend to timely object to the subpoenas on numerous grounds, including that they are overreaching, cumulative, and oppressive.

2. As counsel for JWT and Mindshare, I have knowledge about the contractual relationship between Transamerica Corporation and these entities. I have discussed the contracts at issue with counsel for Transamerica Corporation, who has confirmed that Transamerica Corporation is contractually obligated to indemnify my clients for costs and expenses, including attorneys' fees, incurred by them in responding to any subpoenas or other court action arising by reason of events and occurrences involving Transamerica Corporation and/or that relationship, including costs and expenses incurred by them in responding to the subpoenas appended as Attachments 1 and 2 to Transamerica's Motion to Quash Subpoenas and For Protective Order.

3. The JWT subpoena (Attachment 1 to Transamerica's Motion to Quash Subpoenas and For Protective Order) designates the following categories of testimony and documents:

**Subject of JWT Testimony**

- (1) The scope of the Services provided to Transamerica.
- (2) The process by which You developed Transamerica's Mark.
- (3) All versions or variations of Transamerica's Mark that You created or that were proposed to Transamerica as an alternative to Transamerica's Mark.
- (4) The guidance provided to You by Transamerica concerning the development of Transamerica's Mark.
- (5) The goods and services offered under Transamerica's Mark.
- (6) The geographic scope of use of Transamerica's Mark.
- (7) The geographic scope of the advertising, marketing and promotion of Transamerica's Mark.
- (8) The channels of advertising, marketing and promotion of Transamerica's Mark.
- (9) Your knowledge of marks, trade or business names, or other designations used or registered by third parties in the insurance, investment or financial services industries that include the terms "YOUR TOMORROW" or "TOMORROW."
- (10) The intended audience for Transamerica's Mark.



- (11) Payments by Transamerica to You concerning the Services or Transamerica's Mark.
- (12) Consumer or marketing surveys, tests, investigations, reports, analyses or studies You have conducted or caused to be conducted regarding Transamerica's Mark.
- (13) Actual confusion between Transamerica's Mark and Schwab's Mark, and the circumstances surrounding each such incident.
- (14) Your communications with Transamerica concerning Transamerica's Mark or Schwab's Mark.
- (15) Your communications with third parties concerning Transamerica's Mark or Schwab's Mark.
- (16) Your document retention and destruction policies.
- (17) The documents and things produced by You in response to this subpoena.
- (18) Your efforts to locate documents and things responsive to the requests contained in this subpoena.
- (19) All information identified, mentioned, referenced, reviewed, or relied upon by You in preparation for each of these deposition topics.

**Documents to be Produced by JWT**

- (1) Documents and things sufficient to identify the specific tasks and deliverables that comprise the Services provided or to be provided by You to Transamerica.
- (2) All documents and things concerning Transamerica's Mark.
- (3) All creative briefs, design briefs, story boards, mock-ups, position statements, slide decks, presentations, proposals or other materials concerning Transamerica's mark.
- (4) All documents concerning media schedules for advertisements concerning Transamerica's mark.
- (5) Documents and things sufficient to identify each and every version or variation of, modification to, or alternative to Transamerica's Mark that You created, developed or encountered while performing the Services, whether or not such version, variation, modification or alternative was presented or proposed by You to Transamerica, and whether or not such version, variation, modification or alternative was or is currently in use.
- (6) All documents and things concerning the intended or actual uses of Transamerica's Mark.



- (7) All documents and things, including but not limited to marketing plans, development plans, business plans, or budgetary plans concerning Transamerica's Mark provided to You by Transamerica or on its behalf in connection with providing the Services.
- (8) Copies of each advertisement or marketing or promotional piece bearing Transamerica's Mark that You created or have in Your possession, including but not limited to brochures, catalogues, circulars, leaflets, direct mail pieces, newspaper and magazine advertisements, commercials (aired on television or radio, cable stations, streamed or downloadable via the Internet or other device), websites, price lists, trade association listings, annual reports, keyword search buys, transcripts of town hall-like discussions and any other material such as labels, tags, packages, containers, decals, stamps, and name plates, and including all drafts thereof.
- (9) All documents and things concerning the intended or actual geographic scope for advertising and promotion of Transamerica's Mark.
- (10) All documents and things concerning the intended or actual duration of use of Transamerica's Mark.
- (11) All documents and things concerning the meaning or message intended to be conveyed by Transamerica's Mark.
- (12) All documents and things concerning the intended or actual channels of advertising, marketing and promotion for Transamerica's Mark.
- (13) All documents and things concerning all payments made by Transamerica to You concerning the Services, or otherwise concerning Transamerica's Mark.
- (14) All documents and things concerning the types, characteristics, geographic locale, or classes of persons intended as the audience for Transamerica's Mark.
- (15) All documents and things concerning the intended or actual channels of trade and distribution of goods or services offered or sold under Transamerica's Mark.
- (16) All documents and things concerning the goods or services that were, are, or are intended to be offered or sold under Transamerica's Mark.
- (17) All documents and things concerning or comprising any consumer or marketing survey, test, analysis or study conducted by You or at Your direction concerning Transamerica's Mark, or any version, variation or modification of or alternative to Transamerica's Mark.
- (18) All communications concerning Your Services, Transamerica's Mark or the Opposition.
- (19) All documents and things concerning Schwab's Mark.

(20) All brand guidelines concerning Transamerica's Mark.

4. The categories of information and documents designated in the Mindshare subpoena (Attachment 2 to Transamerica's Motion to Quash and For Protective Order), differ from the categories of information and documents designated in the JWT Subpoena (*id.*, Attachment 1). The Mindshare subpoena reads as follows:

**Subject of Mindshare Testimony**

- (1) The scope of the Services provided to Transamerica.
- (2) The guidance provided to You by or on behalf of Transamerica concerning the advertising, marketing and promotion of Transamerica's Mark.
- (3) The scope of use of Transamerica's Mark.
- (4) The goods and services offered under Transamerica's Mark.
- (5) The geographic scope of the advertising, marketing and promotion of Transamerica's Mark or goods or services offered under Transamerica's Mark.
- (6) The channels of advertising, marketing and promotion of Transamerica's Mark.
- (7) All media purchases and placements to advertise, market and promote Transamerica's Mark.
- (8) Your knowledge of marks, trade or business names, or other designations used or registered by third parties in the insurance, investment or financial services industries that include the terms "YOUR TOMORROW" or "TOMORROW."
- (9) The intended audience for Transamerica's Mark.
- (10) Payments by Transamerica to You concerning the Services or Transamerica's Mark.
- (11) Consumer or marketing surveys, tests, investigations, reports, analyses or studies You have conducted or caused to be conducted regarding Transamerica's Mark.
- (12) Actual confusion between Transamerica's Mark and Schwab's Mark, and the circumstances surrounding each such incident.
- (13) Your communications with Transamerica concerning Transamerica's Mark or Schwab's Mark.



- (14) Your communications with third parties concerning Transamerica's Mark or Schwab's Mark.
- (15) Your document retention and destruction policies.
- (16) The documents and things produced by You in response to this subpoena.
- (17) Your efforts to locate documents and things responsive to the requests contained in this subpoena.
- (18) All information identified, mentioned, referenced, reviewed, or relied upon by You in preparation for each of these deposition topics.

**Documents to be Produced by Mindshare**

- (1) Documents and things sufficient to identify the specific tasks and deliverables that comprise the Services provided or to be provided by You to Transamerica.
- (2) All documents and things concerning Transamerica's Mark.
- (3) All creative briefs, position statements, strategy papers, slide decks, presentations, proposals or other materials concerning Transamerica's Mark.
- (4) All documents and things concerning media schedules for advertisements and promotions concerning Transamerica's Mark.
- (5) All documents and things concerning media buys for advertisements and promotions concerning Transamerica's Mark, including but not limited to invoices therefor.
- (6) All documents and things concerning each and every version or variation of, modification to, or alternative to Transamerica's Mark that You are aware of or encountered while performing the Services, whether or not you made any media purchases in connection with such version, variation, modification or alternative was or is currently in use.
- (7) All documents and things concerning the intended or actual uses of Transamerica's Mark.
- (8) All documents and things, including but not limited to creative briefs, marketing plans, development plans, business plans, or budgetary plans concerning Transamerica's Mark provided to You by Transamerica or on its behalf in connection with providing the Services.
- (9) Copies of each advertisement or marketing or promotional piece bearing Transamerica's Mark that You have in Your possession, including but not limited to circulars, leaflets, direct mail pieces, newspaper and magazine advertisements, commercials (aired on television or radio, cable stations, streamed or

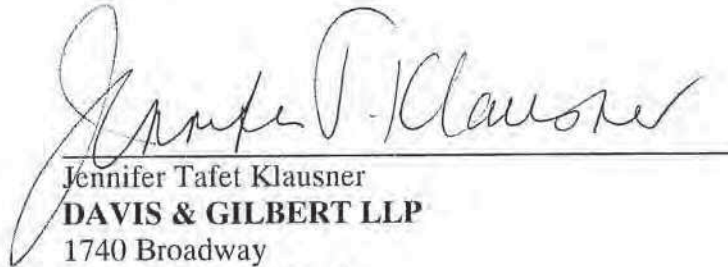


downloadable via the Internet or other device), websites, trade association listings, keyword search buys and any other materials used in connection with advertising or promoting Transamerica's Mark.

- (10) All documents and things provided to You by the J Walter Thompson Company concerning Transamerica's Mark.
- (11) All documents and things concerning the intended or actual geographic scope for advertising and promotion of Transamerica's Mark.
- (12) All documents and things concerning the intended or actual duration of use of Transamerica's Mark.
- (13) All documents and things concerning the meaning or message intended to be conveyed by Transamerica's Mark.
- (14) All documents and things concerning the intended or actual channels of advertising, marketing and promotion for Transamerica's Mark.
- (15) All documents and things concerning all payments made by Transamerica to You concerning the Services, or otherwise concerning Transamerica's Mark.
- (16) All documents and things concerning the types, characteristics, geographic locale, or classes of persons intended as the audience for Transamerica's Mark.
- (17) All documents and things concerning the intended or actual channels of trade and distribution of goods or services offered or sold under Transamerica's Mark.
- (18) All documents and things concerning the goods or services that were, are, or are intended to be offered or sold under Transamerica's Mark.
- (19) All documents and things concerning or comprising any consumer or marketing survey, test, report, analysis or study conducted by You or at Your direction concerning Transamerica's Mark, or any version, variation or modification of or alternative to Transamerica's Mark.
- (20) All documents and things concerning the success, return on investment, benchmark or other measures of performance of all media placed by You concerning Transamerica's Mark.
- (21) All communications concerning Your Services, Transamerica's Mark or the Opposition.
- (22) All documents and things concerning Schwab's Mark.

The undersigned, being warned that willful false statements are punishable as perjury under the laws of the United States, including Section 1001 of Title 18 of the United States

Code, declares that she is properly authorized to execute this declaration; that, to the best of her knowledge, information and belief, the facts set forth in the above declaration are true; that all statements made of her own knowledge are true; and that all statements made on information and belief are believed to be true.



Jennifer Tafet Klausner

**DAVIS & GILBERT LLP**

1740 Broadway

New York, NY 10019

Tel.: (212) 468-4827

Fax: (212) 468-4888

Email: [jklausner@dglaw.com](mailto:jklausner@dglaw.com)

August 7, 2014