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

Proceeding	91224422
Party	Plaintiff CareerBuilder, LLC
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Attachments	PUBLIC VERSION - REPLY IN SUPPORT OF OPPOSERS MOTION TO COMPEL DISCOVERY.pdf(46203 bytes) PUBLIC VERSION - EXHIBITS A - C.pdf(7206 bytes)

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

In the Matter of Application Serial No.:
86/134,485 for TALENTBUILDER

CAREERBUILDER, LLC,

Opposer,

v.

LEE HECHT HARRISON, LLC,

Applicant.

OPPOSITION NO. 91224422

REPLY IN SUPPORT OF OPPOSER'S MOTION TO COMPEL DISCOVERY
PUBLIC VERSION

Applicant's response to CareerBuilder's Motion to Compel merely underscores the reasons CareerBuilder was forced to file its Motion in the first place. In its response, Applicant repeatedly refers to additional documents it produced on the day that CareerBuilder filed its Motion. Applicant also relies on its representation that it would supplement its responses to several of CareerBuilder's discovery requests within fifteen days, corresponding with the due date for this Reply. Both the timing of Applicant's productions and the paucity of documents produced show that Applicant continues not to take its discovery obligations seriously.

Discovery opened in this matter on December 28, 2015. As set forth in CareerBuilder's Motion, Applicant belatedly responded to CareerBuilder's discovery requests, first producing documents in April 2016. After reviewing Applicant's responses and documents, CareerBuilder repeatedly notified Applicant of various deficiencies. CareerBuilder notified Applicant on April 28, 2016 of its intention to file a motion to compel if Applicant did not produce additional documents and supplement its responses. Nonetheless, CareerBuilder agreed to two extensions of the discovery deadlines in the hopes that Applicant would cooperate in the discovery process.

After nearly six months of unresponsiveness from Applicant,¹ CareerBuilder filed the instant Motion on September 8, 2016.

That same day, Applicant finally supplemented its April 2016 production. However, Applicant produced only three additional documents: (i) heavily redacted versions of the Asset Purchase Agreement referenced in CareerBuilder's Motion and schedules thereto, (ii) the publicly available trademark assignment filed with the USPTO, and (iii) a redacted document potentially showing 2015 sales of certain of Applicant's products. The supplemental production promised in Applicant's response, delivered on October 12, 2016, was similarly meager, as discussed in greater detail below. Moreover, all of these documents are responsive to CareerBuilder's original Requests for Production sent nearly eight months ago. Applicant has still not provided a single supplemental response to CareerBuilder's Interrogatories and Requests for Production. CareerBuilder should not be forced to file a Motion to Compel to secure even the most basic compliance with Applicant's discovery obligations months after the fact. Because Applicant's belated production fails to address all of the deficiencies highlighted in CareerBuilder's Motion to Compel, the Motion should be granted and the Board should compel a complete response as outlined in CareerBuilder's opening brief.

Applicant's Designations and Newly Produced Documents

Applicant's removal of the "Highly Confidential – Attorney's Eyes Only" designation from the title page of its responses to CareerBuilder's Interrogatories does not resolve the issue of Applicant's general over-designation of its documents and discovery responses. Applicant designated every document in its initial production as confidential or highly confidential,

¹ In some instances Applicant provided more information in its Response to CareerBuilder's Motion than it did in six months of discovery. For example, in response to CareerBuilder's Interrogatory No. 17 regarding abandonment of the application at issue, Applicant stated that it had no responsive knowledge. However, in response to CareerBuilder's Motion, Applicant explained that it was not notified of impending deadlines by its predecessor's counsel.

including documents such as printouts of publicly available web pages and even press releases, and de-designated only a fraction of the documents after CareerBuilder filed its Motion. Indeed, Applicant continues to over-designate even in connection with its response to CareerBuilder’s Motion by filing what appear to be customer-facing marketing materials under seal as “Highly Confidential – Attorney’s Eyes Only.” *See Applicant’s Resp., Exhs. A, C-D.*

Moreover, Applicant has produced key documents in heavily redacted form despite the Protective Order in place in this proceeding. Both the Asset Purchase Agreement and its schedules, attached hereto as Exhibit A, are designated “Highly Confidential – Attorney’s Eyes Only.” There is absolutely no need for Applicant to redact anything from these documents in light of the fact that the Protective Order prevents anyone other than CareerBuilder’s outside counsel from seeing documents so designated.

Nonetheless, these documents contain material redactions, in some instances to the extent that CareerBuilder’s counsel cannot even determine the subject matter of the redacted material with any specificity. [REDACTED]

² Redactions in this Reply are made to avoid further dispute with Applicant and should not be construed to reflect CareerBuilder’s agreement with Applicant that such material was properly redacted, designated or filed under seal to begin with.

[REDACTED]

[REDACTED] If none of the redacted material is relevant to these proceedings, Applicant should so stipulate in writing. Otherwise, Applicant should be ordered to produce all these documents in unredacted form and to refrain from over-designation and improper redaction in the future.

Interrogatory No. 4

Applicant contends that its September 9, 2016 production included “annual sales numbers for products sold under the TALENTBUILDER mark” and accordingly considers this issue resolved. This is inaccurate. [REDACTED]

[REDACTED]

[REDACTED] Applicant’s belated production included only a three-page document responsive to Interrogatory No. 4 (Exhibit B hereto), one page of which is redacted in its entirety. [REDACTED]

[REDACTED]

[REDACTED] See Exhibit C

hereto. Applicant has claimed priority to 2005 and continuous use ever since that time. Applicant must either produce evidence of sales revenue since 2005 to support this claim or admit that it has no documents evidencing sales prior to 2015. Applicant should be ordered to provide sales data for all years, and all products, for which Applicant claims use of the TALENTBUILDER mark.

With regard to Applicant's purchasers and channels of trade, CareerBuilder notes that Applicant provided slightly more detail in its response to CareerBuilder's Motion. However, Applicant cannot supplement its Interrogatory answer in this manner. *See* Fed. R. Civ. P. 33(b)(1) and (2) (requiring answers to be under oath and signed by the person making them); *see also, e.g., Magarl, LLC v. Crane Co.*, 2004 U.S. Dist. LEXIS 24283 at *14 (S.D. Ind. Sept. 29, 2004) ("A statement in a brief is not a proper answer to an interrogatory."). Applicant should provide a proper, verified supplementary response to CareerBuilder's Interrogatory setting forth this additional information.

Interrogatory 17

Through its responsive pleading, Applicant provided previously undisclosed information with regard to the abandonment of the instant application. The Board should order Applicant to properly supplement its Answer to CareerBuilder's Interrogatory to include such information.

Interrogatory 21

Applicant contends that its statement that it "does not know the exact date" it began using TALENTBUILDER as a single word is sufficient to answer this Interrogatory and that the earliest date that Applicant has documentary evidence of such use is not within the scope of the Interrogatory. Applicant is playing word games to hide the fact that it cannot support continuous use since 2005. Applicant's first documented use is plainly responsive to the Interrogatory as

originally propounded, and CareerBuilder requested that Applicant be compelled to provide such a date, at a minimum, to avoid requiring Applicant to speculate as to earlier use. Instead of properly supplementing its Answers, Applicant now seeks to force CareerBuilder to propound a new Interrogatory. Such tactics would only needlessly delay these proceedings, especially in light of Applicant's pattern of belated responses. Applicant should be compelled to provide a meaningful response to the Interrogatory, as modified through the parties' correspondence, setting forth the first date for which Applicant has evidence of use.

Request for Production 2

Applicant claims that it "does not have access to documents identifying the first purchaser or earliest date that goods and services were offered under the TALENTBUILDER mark" because it acquired the rights in the mark from its predecessor in interest. However,

[REDACTED]

In response to CareerBuilder's Motion, Applicant produced a single page, filed under seal, that shows use of TALENT BUILDER as two words and contains a copyright notice of 2001. If this is an internal document, as would be expected based on its "Highly Confidential – Attorney's Eyes Only" designation, it cannot show use of the mark in commerce. If it does

indeed show use in commerce, it is yet another example of over-designation. Moreover, it does not show, nor does Applicant identify, whether a client purchased the relevant product. Applicant should be compelled to produce documents, including documents identifying its first customers, or to affirmatively state that no such documents exist, rather than merely that Applicant does not have access to them.

Request for Production 4

As discussed with respect to Interrogatory 4, [REDACTED]

[REDACTED] CareerBuilder's Request seeks documents showing annual sales for each product under the TALENTBUILDER mark since the date of Applicant's first sale of such products. Applicant should be compelled to produce such documents or to affirmatively state that it does not have any documents showing sales prior to 2015.

Request for Production 5

Applicant states that it "does not track advertising expenditures on a per product basis and cannot break out its aggregate advertising costs by product." However, CareerBuilder's Request seeks Applicant's total advertising expenditures for products sold under the TALENTBUILDER mark, not such expenditures broken down by product. If such documents do not exist, Applicant should so state.

Request for Production 6

CareerBuilder withdraws its Motion with respect to this Request.

Request for Production 9

Applicant's October 12, 2016 production includes documents responsive to this Request. If no additional responsive documents exist, Applicant should so state.

Request for Production 10

As discussed above, Applicant should be compelled to provide unredacted versions of the Asset Purchase Agreement and schedules thereto.

Request for Production 14

CareerBuilder withdraws its Motion with respect to this Request.

Request for Production 18

The Request for Production seeks documents showing use of the TALENTBUILDER mark since 2005 specifically for the Class 42 services identified in the instant application. Here again, Applicant asserts that it does not have access to documents from its predecessor. However, documents showing continuous use of the mark in Class 42 [REDACTED]

[REDACTED] Moreover, the documents Applicant attached to its Response to CareerBuilder’s Motion do not show use of the mark in connection with the Class 42 services identified in the application. Applicant claims that Exhibit A to its Response constitutes “evidence of use going as far back as 2001.” However, this document does not show use of TALENTBUILDER in Class 42. Applicant’s Exhibit A shows use of TALENT BUILDER as two words and was filed under seal, suggesting that it is merely an internal document and was not used in commerce. The document appears to be [REDACTED]

[REDACTED] It does not show the provision of an interactive website at all, let alone one that “allows users to enter, access, track, monitor and generate career development information and reports for individuals, managers and organizations.” The fact that the [REDACTED] does not even indicate that Applicant had a website as of that date. Applicant’s other Exhibits likewise do not show use in connection with the identified Class 42 services.

Applicant's documents are therefore unresponsive to this Request. If Applicant does not have any responsive documents, Applicant should be compelled to supplement its responses to affirmatively state that it does not have any such documents within its possession, custody or control.

Request for Production 22

CareerBuilder withdraws its Motion with respect to this Request.

CONCLUSION

In light of Applicant's pattern of unresponsiveness and belated, insufficient supplemental production, CareerBuilder maintains its request – except as withdrawn above – that the Board issue an Order compelling Applicant to comply with its discovery obligations by properly supplementing its written discovery responses and producing responsive documents as requested or affirmatively stating that no such documents exist.

Respectfully submitted,

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EXHIBIT A
FILED UNDER SEAL

EXHIBIT B
FILED UNDER SEAL

EXHIBIT C
FILED UNDER SEAL