ESTTA Tracking number: **ESTTA835199**

Filing date: **07/25/2017**

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

Proceeding	91226647
Party	Plaintiff Dude IP, LLC
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Date	07/25/2017
Attachments	REPLY to Motion to Compel.pdf(508671 bytes)

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

Opposition No. 91,226,647
In re: Serial No, 86/557,684 for
FOOD DUDES

DUDE IP, LLC	:	
Petitioner/Opposer	:	
	:	REQUEST FOR ACCEPTANCE OF
v.	:	RE-FORMATTED RESPONSE
	:	
FOOD DUDES	:	
DELIVERY, LLC	:	
Applicant	:	

Opposer, by this filing, asks the Board to accept this re-formatted Reply which is identical in text and content to its July 4, 2017 filing. Due to a formatting error when the document was converted into PDF, Opposer's original filing of July 4, 2017 was in 12 point type and 1.15 spacing with double spacing between certain paragraphs; Opposer has corrected this issue such that this filing is in 11 point type with double spacing. Opposer also notes that said filing is under 25 pages.

Respectfully submitted,
/hht/
Heidi Howard Tandy, Esq.
Attorney for Opposer/Counterclaim-Defendant Dude IP, LLC
July 25, 2017

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Request has been served on Norman Abramson, Esq. via email to Norman.Abramson@gpmlaw.com on July 25, 2017.

_____/hht/_____

Heidi Howard Tandy, Esq.
Counsel for Opposer/Counterclaim-Defendant
Dude IP, LLC

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

Opposition No. 91,226,647
In re: Serial No, 86/557,684 for
FOOD DUDES

DUDE IP, LLC Petitioner/Opposer	:	
v.	:	**RESPONSE TO APPLICANT'S MOTION TO COMPEL PRODUCTION**
FOOD DUDES DELIVERY, LLC Applicant	:	

OPPOSER RESPONSE TO MOTION TO COMPEL

Opposer Dude IP, LLC ("Opposer" or "Delivery Dudes") hereby files its response to the Motion to Compel Discovery filed by Applicant Food Dudes LLC ("Applicant"). The Motion is wholly without merit and must be denied.

I. Introduction

On May 18, 2017, the Interlocutory Attorney entered an order in the above-captioned matter stating that (a) Applicant's affirmative defense claiming that Opposer's registration at 4,101,367 had fallen abandoned could be heard by the Board, and (b) Applicant's defenses of failure to state a claim, that Opposer's claim is barred by the doctrine of waiver and estoppel, and Applicant's baseless claim that Opposer had engaged in fraud on the Trademark Office were summarily stricken. Opposer filed an answer to the Amended Counterclaim on June 2, 2017, a few days after Applicant had clarified certain discovery requests to Opposer in a May 31, 2017 letter.

Opposer corresponded with Applicant via email multiple times since May 18, 2017, including on June 5, 22 and 29, 2017, and Opposer provided documents to Applicant on multiple occasions between June 2, 2017 and July 4, 2017. Opposer made a good faith effort to provide responsive documents to Applicant, as well as amended interrogatories and documents requests that took into consideration the contents of Applicant's Amended Answer and Counterclaims as approved by the Board in the May 18, 2017 decision. Opposer also made a good faith effort to communicate its outstanding questions and objections to Applicant; Applicant made no effort to respond to Opposer's questions and objections outside the conversations between the parties on June 9, 2017 and between the parties and the Interlocutory Attorney on June 6, 2017.

Opposer believes that Applicant is on a fishing expedition, requesting documents that are not reasonably tailored to produce relevant evidence. Opposer further believes that Applicant is using motions practice to harass Opposer; given that Applicant did not even include the required statement that it made a good faith effort to resolve its issues with Opposer, perhaps Applicant is fully aware that it made no such effort.

Opposer has provided Applicant with hundreds of documents and lists of thousands of vendors and restaurants that Opposer has delivered goods from, among other documents. Applicant baselessly claims in its motion that Opposer has provided no documents in response to numerous document requests, but Opposer actually has provided documents in response to almost all of those requests; there are a few outstanding disputes as to the nature and extent of certain claims by Opposer of attorney-client privilege and with regard to trade secret in marketing plans, but Opposer truly believes that such disputes could have been worked out between the parties if Applicant had been truly willing to do so in good faith; at the very least, the issues before the Board could have been narrowed considerably.

Accordingly, Applicant's Motion must be denied. Applicant failed to include the required statements regarding good faith. Second, even if the statement had been included, Applicant failed to engage in the required good faith effort to resolve its differences with Opposer. Third, Applicant has not made a showing that its outstanding discovery requests ask for matter that is relevant to its claims or defenses, and proportional to the needs of the case. Fourth, Applicant does not overcome Opposer's legitimate objections including relevance and privilege. Opposer requests that its remaining objections be sustained as stated.

MEMORANDUM OF LAW

Discovery Parameters at the TTAB

A party seeking discovery before the Trademark Trial and Appeal Board may seek discovery of any non-privileged matter that is relevant to the party's claims or defenses and proportional to the needs of the case, Trademark Rule 2.120(a)(1); E*milio Pucci Int'l BV v. Sachdev*, 118 USPQ2d 1383, 1386 (TTAB 2016); *Domond v. 37.37, Inc*., 113 USPQ2d 1264, 1268 (TTAB 2015). As Board proceedings concern only the right to registration, discovery in a Board proceeding generally is more limited than discovery in a trademark infringement action. Accordingly, a movant has the burden of demonstrating that it is entitled to certain discovery.

Opposer agrees that parties have a duty to cooperate under the Federal Rules of Civil Procedure and the Trademark Rules, and notes that Board looks with extreme disfavor on those who do not cooperate in the discovery process. TBMP §408.01 "Each party and its attorney or other authorized representative has a duty not only to make a good faith effort to satisfy the discovery needs of its adversary, but also to make a good faith effort to seek only such discovery as is proper and relevant to the issues in the case." Id. *Also see Domond* ("Fed. R. Civ. P. 26(c)(1) requires that a party moving for a protective order include a certificate that the movant has in good faith conferred or attempted to confer with the other affected parties in an effort to resolve the dispute without Board action.")

At present, Applicant has been impatiently uncooperative in the discovery process, which resulted in Applicant filing its motion to compel one day after being told in writing by Opposer that additional documents would be provided in the coming days - and on the same day that over 100 documents were sent via Federal Express by Opposer to Applicant. Even if the Interlocutory Attorney sees merit in Applicant's premature demands, many if not all of those demands are now moot.

A Motion to Compel Discovery Must Be Supported by a Written Statement re Good Faith

Further, a motion to compel discovery must be supported by a written statement from the moving party showing that the party has made a good faith effort, by conference or correspondence, to resolve the issues with the other party, *and* that the parties were unable to resolve their differences. *Share This v. Rahid Chopra, Tarina Chopra and Anita Chopra* at Opposition No. 91209951 (May 4, 2014), *Giant Food, Inc. v. Standard Terry Mills, Inc*., 231 USPQ 626 (TTAB 1986) (movant failed to submit documentary evidence of good faith effort and thus the motion to compel was denied). Also see Trademark Rule 2.120(e)(1), 37 CFR § 2.120(e)(1); TBMP § 523.02 (June, 2017). Applicant did not include such written statement that it had made a good faith effort to resolve its differences with Opposer, nor state in writing that the parties were unable to resolve their differences. Accordingly, Applicant's Motion to Compel fails, and should not be granted.

The absence of this necessary, required and vital statement is grounds enough for the Board to deny Applicant's Motion to Compel. Applicant has not actually made a good faith effort to resolve what issues they have with Opposer, and thus even if Applicant had claimed a good faith effort in writing in its motion, its motion would fail as "good faith" effort is not discharged where counsel has made an inquiry, but is merely dissatisfied with its adversary's response. In such circumstances the inquiring party must engage in additional effort to resolve the dispute. *Hot Tamale Mama…and More, LLC v. SF Investments, Inc.*, 110 USPQ2d 1080, 1081 (TTAB 2014) ("Trademark Rule 2.120(e)(1) calls for the moving party to show that it has made a good faith effort to resolve the issues presented in the motion, *and* that the parties were *unable to resolve their differences*... [T]he good faith efforts of the parties should be directed to understanding differences and actually investigating ways in which to resolve the dispute.") (emphasis in the original).

Where an applicant and/or its representative fails to make a good faith effort to resolve a discovery dispute, the party is also unable to include the required certification or statement in its motion. Lack of said certification or statement - on its own - has led federal courts to deny motions to compel. *Nwachukwu v. Karl*, 223 F. Supp. 2d 60, 71 n 7 (D.D.C. 2002); *Murthy v. Barberino Bros., Inc., 208 F.R.*D. 483 (D. Conn. 2001); *Burton v. R.J.*

Reynolds Tobacco Co., 203 F.R.D. 624 (D. Kan. 2001); *Doe v. Nat'l Hemophilia Found.*, 194 F.R.D. 516 (D. Md 2000). The absence of a claim in Applicant's filing that a good faith effort was made is telling.

In *MacMillan Bloedel Limited v. Arrow-M Corp*., 203 USPQ 952, 953-954 (TTAB 1979), the Board explained that even where a party has completely failed to respond to discovery, the party seeking discovery has a duty to contact the adverse party to ascertain why it has received no response and whether the matter can be resolved amicably, see id. at 954; and second, in a subsequent precedent, explained that, following such contact, if the party seeking discovery is dissatisfied with the adverse party's answer, it may file a motion to compel, supported by the statement and accompanying showing required by Trademark Rule 2.120(e)(1). See *Envirotech Corp. v. Compagnie Des Lampes*, 219 USPQ 448, 450 (TTAB 1979), *The Phillies v. Phila. Consol. Holding Corp*., 107 USPQ2d 2149, 2151 (TTAB 2013).

The Board said in *Hot Tamale Mama*:

> ...mere dissatisfaction with the adversary's answer to an initial inquiry, in itself, does not discharge the duty to undertake a good faith effort to resolve the dispute, particularly where the inquiring party has received no, minimal or incomplete substantive information in response to its initial inquiry. Rather, the point is to investigate the possibility of resolving the dispute. Although the reason why no discovery responses were served can be part possibly an important part of the discussion, it may be irrelevant to resolving the dispute in many cases. Regardless, the good faith efforts of the parties should be directed to understanding differences and actually investigating ways in which to resolve the dispute.... [E]stablishing the good faith effort that is a prerequisite for a motion to compel necessitates that the inquiring party engage in additional effort toward ascertaining and resolving the substance of the dispute. Here, that was not done.
>
> The record does not reflect an unresolvable situation – such as would have been the case if opposer were a defiant adversary who simply refused to engage in discovery or to provide applicant with any answer regarding the failure to serve discovery responses.

In this matter, likewise, Applicant engaged in no additional effort to ascertain and resolve the substance of this dispute After its receipt of Opposer's June 19, 2017 letter, or after its receipt of any of the documents sent by Opposer to Applicant since the acceptance of Applicant's Amended Answer and Counterclaim in mid-May. Despite Applicant's baseless attempts to infer and even claim that Opposer is some sort of defiant adversary, there is no evidence indicating that Opposer is such, as Opposer has produced hundreds of pages of documents to

Applicant as well as reasonable answers to interrogatories, provided a time frame for additional production in its June 19, 2017 letter, and indicated its willingness to engage with Applicant to work out a time frame for supplemental production as additional documents were discovered in both the conference call with the Interlocutory Attorney and the June 19, 2017 letter.

As the Interlocutory Attorney is aware, Applicant and Opposer engaged in a discovery conference with the Interlocutory Attorney on June 6, 2017; the parties were unable to finish all of their discussion on that date and mutually agreed to have another phone conversation posthaste. Such conversation took place on June 9, 2017. Subsequent to that conversation, even before Applicant filed its Motion to Compel, Opposer had already amended its answers to its interrogatories in light of the new counterclaim and given the stricken defences originally promulgated by Applicant in its first filing, and provided Applicant with dozens of additional documents; further documents followed the week after, pursuant to the time frame set forth by Opposer in its June 19, 2017 letter to Applicant.

Pursuant to *Hot Tamale Mama…and More, LLC v. SF Invs., Inc.*, 110 USPQ2d 1080, 1081 (TTAB 2014), a good faith effort requires more than one telephone call, letter, or email exchange. The Board expects that the parties will engage in a meaningful effort to understand their differences and investigate ways to resolve their dispute. *Id.; Sentrol, Inc. v. Sentex Sys., Inc*., 231 USPQ 666, 667 (TTAB 1986). When a significant number of discovery requests are in dispute, the Board may decline to resolve the dispute on the theory that the parties could not have made a sufficient good-faith effort to resolve it themselves. *Sentrol*, 231 USPQ at 667. However, Opposer asks that the Board not merely decline to resolve this dispute, but rather deny Applicant's motion due to their failure to claim or manifest a good faith effort to resolve the matter. Applicant is so bold-faced as to claim that Opposer's request in February, 2017 that "if [Applicant] wish[es] to have a phone conference regarding such documents, please let me know" (Littman Decl., Ex. I.) is a refusal to cooperate, when it is quite the opposite. Applicant never expressed any interest in scheduling such a phone conference regarding such documents at any time before its filing of its Motion to Compel.

Applicant may attempt to now suddenly claim they made some sort of good faith effort to resolve the issues it claims to still see, but in fact, they sent only one letter after their amended answer and counterclaim was accepted by the Board, and made no communication outreach with regard to substantive discovery matters after they received either the June 16 or June 19 emails from Applicant, although one of their assistants did reach out to Opposer in connection with an updated email to cc when sending materials.

The parties did engage in a conference with the Interlocutory Attorney (the "June 6, Phone Conference") in which a discussion of that letter transpired; Applicant and Opposer followed that up with a phone conversation on June 9, 2017, a fact which Applicant entirely left out of their filing.

Applicant also neglected to mention that on June 16, 2017, Opposer sent two emails that included a total of four documents comprising dozens of pages; the first email Opposer sent to Applicant that day also included production schedule information. In Applicant's Motion to Compel, they curiously neglected to include a copy of said email, which is attached hereto as Exhibit A; the salient section said:

> As my paralegal has been out part of this week, our response to your letter, as well as additional documents, will follow next week. I hope to have the updated privilege log to you by the end of next week as well.

Opposer was, in fact able to respond more briskly than originally predicted, as, on June 19, 2017, Opposer notified Applicant in said June 19 letter that "additional responsive documents will follow when they have been properly marked and Bates-stamped." Approximately 26 hours later, without calling, emailing or otherwise reaching out to Opposer with regard to Opposer's extensive interrogatory response amendments or document request responses, Applicant filed its Motion to Compel. That cannot be reasonably seen as a good faith effort to resolve any differences, especially given the fact that had Applicant called or emailed Opposer, Applicant would have been informed that Opposer had already arranged for the pick-up by Federal Express of a stack of over 100 Bates-stamped documents, set for delivery on June 20, 2017.

Opposer explained in the June 6 Phone Conference that it was particularly complicated to compile complete annual sales figures from 2009 to 2012, and it would need additional time to do so; at no time in the June 6 Phone

Conference, or in any subsequent communication, did Applicant demand it be provided immediately. Such sales figures were provided as they were compiled, with the 2013 figures submitted on July 4, 2017.

Applicant's Amended Answer and Counterclaim was only accepted by the TTAB on May 18, 2017; Opposer provided its amended responses to Applicant's interrogatories only 21 working days later, and provided additional document production even sooner than that. Such production and responses must be seen as prompt and reasonable. Further, Opposer's June 2017 production of documents and provision of its amended responses to discovery requests and interrogatories make Applicant's Motion to Compel utterly moot.

"Each party has a duty to make a good faith effort to satisfy the reasonable and appropriate discovery needs of its adversary." *Panda Travel Inc., v Resort Option Enterprises, Inc.*, 94 USPQ2d 1789, 1791 (TTAB 2009). Also see *Amazon Technologies Inc. v. Wax,* 93 USPQ2d 1702, 1705 (TTAB 2009), quoting *Nevada Power Co. v. Monsanto Co.*, 151 F.R.D. 118, 120 (D. Nev. 1993) (("In order for the meet and confer process to be meaningful and serve its intended purpose, the parties must present to each other the merits of their respective positions with the same candor, specificity, and support during informal negotiations as during the briefing of discovery motions."). See also *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1654 (TTAB 2007) (parties have a duty to cooperate in resolving conflicts in the scheduling and taking of depositions).

Each party and its attorney or other authorized representative also has to make a good faith effort to seek only such discovery as is proper and relevant to the issues in the case. Fed. R. Civ. P. 26(g). See e.g., *Johnston Pump/General Valve Inc. v. Chromalloy American Corp*., 13 USPQ2d 1719, 1721 n.4 (TTAB 1989) (Board warned counsel for opposer that its conduct of discovery in the case was "uncooperative" and "improper" and that any further misconduct may result in the imposition of the estoppel sanction); *Luehrmann v. Kwik Kopy Corp*., 2 USPQ2d 1303, 1305 (TTAB 1987) (while party submitted responses late, the motion to compel was moot and party was not sanctioned); *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986) (prior to seeking Board intervention, parties must narrow amount of disputed requests to reasonable number); *Medtronic, Inc. v. Pacesetter Systems, Inc*., 222 USPQ 80, 83 (TTAB 1984) (it was clear from number and nature of opposer's discovery requests and applicant's blanket objections thereto that neither party was cooperating). See also *C. H. Stuart Inc. v. Carolina Closet, Inc.*, 213 USPQ 506, 507 (TTAB 1980) (opposer's "voluminous"

discovery requests were "oppressive and nothing short of harassment" to applicant); *C. H. Stuart Inc. v. S. S. Sarna, Inc*., 212 USPQ 386, 387 (TTAB 1980) (Board granted applicant's motion for protective order; opposer's "boiler-plate" discovery requests designed for an infringement action deemed harassment); *Varian Associates v. Fairfield-Noble Corp*., 188 USPQ 581, 584 (TTAB 1975) (applicant's motion to compel denied due to lack of good faith effort to resolve dispute).

As Ms. Sachdev was with her motion for a protective order at the end of discovery, *Emilio Pucci International BV v. Rani Sachdev*, 18 USPQ2d 1383 (TTAB 2016), Applicant is now with its Motion to Compel. Applicant made no effort to resolve whatever issues it had with Opposer before filing said motion. Just as it is improper for a party to move for a protective order to harass one's adversary by forcing the adversary to engage in motion practice, *Fort Howard Paper Co. v. G.V. Gambina Inc*., 4 USPQ2d 1552, 1553 (TTAB 1987), it is improper for a party to file a Motion to Compel to harass one's adversary by forcing the adversary to engage in motion practice. The Board reasonably looks with disfavor on upon the use of harassing tactics in discovery through any discovery device. *Carolina Closet, Inc.*, 213 USPQ 506 (TTAB 1980).

Opposer also notes that the Board makes a concerted effort to provide attorneys, as well as members of the public, with tips on practicing before the Trademark Trial and Appeal Board.[1] At present, the failure is not the responding party's response; it is the inquiring party's request. It is difficult, even now, for Opposer to be completely sure of which interrogatories and document requests Applicant is asking for more documents and/or answers in response to. For example, at page five of Applicant's Motion, Applicant incorrectly states that Opposer did not supplement its responses to Applicant's Document Requests ("Opposer continues to state that it is looking for more documents and that it has documents in its possession, custody, or control, but they have yet to be produced.") even though Applicant knows full well that Opposer submitted documents to Applicant in January, and supplemented its production in February, March and June, and has provided additional supplements in July. Exhibit B.

Opposer Has Provided Numerous Responsive Documents and Information

[1] https://cdn2.hubspot.net/hubfs/454850/TTAB%20Tips%202017%20Revised%20Feb.%207-1.pdf

Applicant falsely claims that it "has not received any responsive documents" in connection with Document Requests 5, 7-9, 12, 15-17, 21, 23-24, 27-29, 31-32. (Applicant Motion, Page 7.) However, inaccurate claims by Applicant are set forth below, along with information about what Opposer has actually produced, even where Opposer has objected to certain requests. Opposer hereby requests that its remaining objections be sustained.

- Applicant claims in its motion that Opposer has not produced any documents "related to any third parties' use in commerce in the United States of Opposer's Marks, or any mark containing the word DUDES in connection with delivery services" even though Opposer has produced documents relating to Opposer's lawsuit against an Australian company that briefly used the mark DELIVERY DUDES in the United States.
- Applicant claims in its motion that Opposer has not produced any "documents in any way related to delivery services sold under a tradename or mark containing the word DUDES at the time" Opposer's application was filed; apart from the fact that this is a vague and ambiguous inquiry as three registrations were listed in Opposer's Opposition, Applicant produced a screenshot from its 2014 website, as well as other documents, in response thereto.
- Applicant claims in its motion that Opposer has not produced any documents "containing, comprising or any way related to assignments, licenses or other agreements through which Opposer claims any trademark right or interest in Opposer's Marks" but has also admitted that Opposer has produced the 2012 assignment of the DELIVERY DUDES mark, goodwill and domain name to Opposer's predecessor in interest from Marc Veneziano. Opposer notes that it is confused as to why Applicant believes that Opposer - who paid Veneziano for his trademark, domain name and goodwill - should be obligated to confirm that it "collected $10" in connection with this transaction, or for some inexplicable reason admit that its valid trademark assignment which included an assignment of the mark and goodwill associated therewith is a naked assignment, when it is most certainly not. Applicant's demand for such an admission might be appropriately included in a Request for Admission but it is not a proper inquiry in an interrogatory.

- Applicant claims in its motion that Opposer has not produced any "documents containing, comprising or related to assignments, licenses or permissions you have given to third parties to use a mark containing the words DUDES and/or DELIVERY, but also admits that Opposer has produced some license and franchise agreements; when Applicant asked on May 31 for those agreements to be produced without redaction, Opposer did so, and provided a representative sample of such agreements to Applicant on June 16, 2017.
- Applicant claims in its motion that Opposer has not produced any documents "sufficient to identify the period or periods of time Opposer used each of Opposer's Marks and on which of Opposer's services, including but not limited to restaurant take-out delivery services" but Opposer has produced screenshots of websites, as well as advertisements, receipts and other documents responsive to this request.
- Applicant claims in its motion that Opposer has not produced any documents "related to any lawsuits, oppositions, cancellations or other legal actions in which [Opposer was] involved relating to any dispute regarding the use or ownership of a mark or trade dress containing the words DELIVERY and/or DUDES" but Opposer has produced documents relating to Opposer's lawsuit against an Australian company that briefly used the mark DELIVERY DUDES in the United States, and has explained that while it believed it was not obligated to produce documents that were publicly available and easily accessible online in the records of the US Patent and Trademark Office pursuant to *Domond*, as well as TBMP 414(10), it would do so; those documents have been produced as of this filing and thus the motion to compel such production is moot.
- Applicant claims in its motion that Opposer has not produced any documents "related to any settlement, consent or other agreement with a third party relating to the use of a mark containing the words DUDES or DELIVERY" but Opposer has produced the Veneziano agreement and has produced other documents responsive to this request.
- Applicant claims in its motion that Opposer has not produced any documents "reflecting or relating to any actual confusion between a third party's goods sold under a mark containing the words DELIVERY

and/or DUDES and Opposer or Opposer's Services sold under Opposer's Marks"; Opposer has produced such documents, including Opposer's internal discussion of job postings that evidence actual

- Confusion, which it had also informed Applicant about in 2015 before this matter commenced.
- Applicant claims in its motion that Opposer has not produced any documents to support Opposer's contention that its "use of DELIVERY DUDES trademarks to identify Opposer's Services and Opposer as their source has been "widespread, continuous and exclusive", but Opposer has produced numerous advertisements, receipts, promotional materials, website pages and more in response to this document request.
- Applicant claims in its motion that Opposer has not produced any documents to support Opposer's contention that registration of Applicant's mark "is likely to damage the distinctiveness, goodwill, reputation and secondary meaning created and established within the DELIVERY DUDES mark by virtue of the confusion, mistake and deception likely to occur between the respective marks in derogation of Petitioner's rights, all to the Opposer's irreparable damage", but Opposer has produced dozens of documents in response to this request.
- Applicant claims in its motion that Opposer has not produced any documents to support Opposer's date of first use of each of its marks but Opposer has produced documents that show the first use of DELIVERY DUDES by Opposer's predecessor in interest in October of 2005; Opposer is still searching for documents that feature Opposer's use of the DD DELIVERY DUDES logo mark in March of 2012 as that is the date of first use cited in Opposer's 2014 application to register that mark, but have thus only been able to find, in its diligent search of its archives, and thus, produce, documentation showing use of the mark in October 2012. Opposer also is still searching for documents that feature Opposer's first use of its DELIVERY DUDES marks, and has produced other documentation of use of the DELIVERY DUDES mark in June and July of 2009, as well as use by Opposer's predecessor in interest in various years before 2012.
- Applicant claims in its motion that Opposer has not produced any documents sufficient to "identify the restaurants from which Opposer performs take-out delivery services under any of Opposer's Marks", but

Opposer has produced lists of restaurants as well as advertising and website screenshots that list such restaurants.

- Applicant claims in its motion that Opposer has not produced any documents "containing or comprising agreements between Opposer and restaurants, grocery stores or other food retailers under which Opposer is allowed to perform take-out delivery services under any of Opposer's Marks" but Opposer has produced a selection of documents responsive to this request.
- Applicant claims in its motion that Opposer has not produced any documents in response to its query regarding quantity of services and gross revenue; Opposer notes that on June 20, 2017 it advised Applicant that "we have only been able to create a complete and accurate chart of annual sales figures for the company for 2014, 2015 and 2016; we will provide that as an Attorney Eyes Only document this week. We are still working to compile the figures for 2009-2013." Opposer produced such information on June 22, 2017 and supplemented it twice with sales figures for other years.
- Applicant claims in its motion that Opposer has not produced any documents in response to its request for publicly available documents that are freely available for download at the USPTO website; Opposer notes that there are hundreds of pages available in multiple documents, and it is still in the process of gathering and Bates-stamping all of them. Opposer has produced many documents that have been publicly filed at the USPTO including assignments and specimens.
- Applicant claimed in its motion at page 15 that "Opposer has not produced any evidence of use, particularly on restaurant delivery services5 , before 2013" but on the next page admitted that Opposer provided receipts; said receipts are dated as far back as 2009.[2]
- Applicant claimed in its motion at page 16 that Opposer had only provided redacted license and franchise agreements, but Opposer provided four unredacted license and franchise agreements on June 16, in conjunction with an email in which Opposer stated, "Attached are three attorneys'-eyes-only documents in response to your request for documents; one will follow in a subsequent email. While these are not

[2] Applicant also cites a "July 19, 2017" letter at Page 15; Opposer assumes that Applicant is referring to its June 19, 2017 letter.

Bates-stamped, but I am happy to do so next week..." Accordingly, Applicant's demand that Opposer be compelled to provide documents that it produced before Applicant filed its motion to compel is unfounded and moot, and a demonstration of Applicant's lack of good faith in connection with reaching any resolution of outstanding disputes with Opposer.

In its May 31, 2017 letter, Applicant further claimed that it had not received certain answers and documents, Opposer herein sets forth an accurate status update with regard to each of these issues.

- Applicant claims it has not received any information regarding use by Opposer's predecessor in interest between 2005 and 2012; however, Opposer has provided screenshots of Amazon pages and websites that show use of the mark in at least 2006, 2007, 2010 and 2011.
- Applicant claims it has not received sales figures; Opposer has informed Applicant multiple times that sales figures for 2009-2013 are complicated to assemble correctly, but they have been produced, making Applicant's complaints on this issue moot.
- Applicant correctly states that Opposer has not provided a complete list of vendors, or restaurants and stores that Opposer delivered goods to customers from between 2009 and 2013, or that Opposer's predecessor in interest delivered goods to customers from post-2005. However, Opposer has provided receipts and website printouts from those years from a number of such entities and Opposer believes that said selection is satisfactory. Opposer requests that its objections to providing additional receipts be sustained as stated.
- Applicant correctly states that Opposer has not provided any marketing plans that differ from Opposer's current marketing practices; Opposer has no such marketing plans that would be responsive to this request at present, and reserves the right to amend its answer to this Interrogatory Number 4 if such plans are created and responsive. However, Opposer has produced marketing documentation, and has objected to Applicant's demand for additional marketing documentation as such documents by their nature constitute trade secrets; Applicant requests that its objections to providing such documents be sustained as stated.
- Applicant claims that Opposer has not provided materials that include third-party names; however, Opposer has provided such documents to Applicant.

- In connection with Opposer's privilege log, Opposer believes that the log it has produced and updated is sufficiently responsive and requests that its objections to providing such documents be sustained as stated.
- In connection with the purchase of the mark and domain name from Opposer's predecessor in interest, Opposer remains baffled by Applicant's insistence that the Assignment entered into by the parties in 2012 which documents the assignment of the mark, domain name and goodwill for good and valuable consideration is somehow considered lacking by Applicant. In June, Opposer found additional documents in connection with communications between Opposer and its predecessor in interest, and produced them. Applicant's complaints on this issue now appear to be moot.
- In connection with Interrogatories 13 and 14, Opposer notes that discovery is not yet close to over, and any motion to compel production on these matters is premature.

Given that discovery is still open, and Opposer is still finding additional documents that are responsive to Applicant's document requests, Opposer continues to produce them as they are discovered. Given the fact that Opposer's pre-2014 records are not stored in the same system as its records since that time, a fact about which Opposer has informed Applicant, those earlier records have to be recovered and searched separately, which is a time consuming process that Opposer is nonetheless continuing to do, so that it can fully respond to all reasonable document requests and interrogatories.

Opposer also contends that its specific objections detailed in response to certain discovery requests and interrogatories are valid and legitimate, and requests that the Board sustain its outstanding objections, set forth in the amended responses to interrogatories and document requests that it sent to Applicant on June 19, 2017, just ten days after the parties' conference call regarding discovery. It is laughable for Applicant to contend that none of their interrogatories or document requests are burdensome, when Opposer has offered multiple times to provide a selection or sample of documents that are responsive to specific requests, and Applicant accepted said offer as sufficient in the June 6, 2017 conference with the Interlocutory Attorney.

Opposer notes that Applicant is engaging in discovery requests as if this were a federal court proceeding. However, the Board has a specific and limited jurisdiction, under which the Board "is empowered to determine only the right to register." TBMP § 102.01 (3d ed. 2011). "[T]he scope of discovery in Board proceedings is

generally narrower than in court proceedings." TBMP 402.01, quoting *Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1907 (TTAB 2011). While Opposer "has a duty" to satisfy the legitimate "discovery needs of its adversary" TBMP § 408.01 (3d ed. 2011) it has no duty to satisfy illegitimate discovery demands or disproportionate demands. See, Sedona Principles Comment 2.b ("Electronic discovery burdens should be proportional to the amount in controversy and the nature of the case. Otherwise, transaction costs due to electronic discovery will overwhelm the ability to resolve disputes fairly in litigation."). When alleging that a responding party's responses to individual discovery responses are inadequate, a propounding party should, as a threshold matter, first cite authority to establish that the information sought by each discovery request at issue is properly discoverable. See generally TBMP Section 414. In its Motion, in particular on pages 12 and 13, Applicant has not cited to any authority that the individual interrogatories at issue in its motion seek discoverable information.

This is not a litigation over whether Applicant can use the mark where it was using it before the filing date of Opposer's earliest application that vested to registration. The matter before the Board is only whether Applicant can register its FOOD DUDES mark in connection with the listed services on the principal register of the US Patent and Trademark Office. Given that, even acknowledging that discovery to overcome Applicant's unsupportable abandonment claim should be and has been produced by Opposer, the principles of proportionality with regard to discovery requests obligate the party making the requests to ensure that said requests are neither harassing nor oppressive; the party is expected to consider the scope of the requests as well as to confer in good faith about the proper scope of discovery so as to minimize the need for motions. Applicant's discovery requests were disproportional at the start, but Opposer has nonetheless provided documents responsive to each request or provided a reasonable explanation why it has not done so.

Opposer has priority of registration, even if the '367 registration is set aside. A trademark or service mark registration on the principal register is presumed valid, as, for purposes of establishing priority, Applicant may at the very least rely on the filing dates of its applications. *M.C.I. Foods, Inc. v. Bunte*, 96 USPQ2d 1544, 1550 (TTAB 2010); see also, *J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 437 (CCPA 1965).

Any registration of a mark registered on the principal register, owned by a party to an action, "shall be admissible in evidence and shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration subject to any conditions or limitations stated therein." 15 U.S. Code § 1115.

Opposer has nonetheless provided printouts of the publicly available registration and application files that Applicant could have and should have accessed in March of 2016 when this matter began[3] as well as myriad other documents in response to Applicant's vague and over-broad document requests and irrelevant interrogatories.

Discovery Must Be Proportional to the Issues

A mere "belief that documents must exist simply is not enough to grant a motion to compel that would require [a party] to go back to square one and begin its document collection efforts anew." *Ford Motor Co.*, 257 F.R.D. at 428; see also *Covad Communications Co. v. Revonet, Inc.*, 258 F.R.D. 5, 13-14 (D.D.C. 2009). Further, Applicant has not supported its allegation that responsive documents must exist, or that Opposer has failed to produce such documents. "Parties are advised to be precise in their requests and to have as their first consideration how to significantly limit the expense of such production." *Frito Lay.*

Opposer looks to the Board ruling in *Frito Lay* for guidance on what discovery is proportional and reasonable. Applicant has not explained, whether in this pleading or in communication with Opposer, how or why "the burden or expense of the proposed discovery outweighs its likely benefit, considering the needs of the case, the amount in controversy, the parties' resources, the importance of the issues at stake in the action, and the importance of the discovery in resolving the issues." See e.g. Fed. R. Civ. P. 26(b)(2)(C)(iii).

[3] Opposer notes that Applicant claims that Opposer has 'concealed' the cancellation proceeding it filed over five years ago against Marc Veneziano; it is not actually possible to conceal something that is publicly available, especially when it is listed on the Summary page that appears when one types "DELIVERY DUDES" into http://ttabvue.uspto.gov/ttabvue/, and has been accessible to Applicant since before it filed its answer in this matter. Opposer also explicitly stated in its December response to Applicant's request for production of documents that Applicant's "request seeks documents that are publicly available from the US Patent and Trademark Office". Opposer informed Applicant of where they could access said documents easily, for free, and in an electronic, searchable form. "TTABVUE [is] the Board's publically available docket history system... Board proceedings are open to the public." *ProMark Brands Inc. and H.J. Heinz Company v. GFA Brands, Inc.*, 114 USPQ2d 1232 (TTAB 2015)

In its motion, Applicant implies that Opposer has to prove the date of first use of its word marks and logo marks; however, given the limited jurisdiction of the TTAB and the fact that the only issue before the board is the registerability of Applicant's FOOD DUDE mark in connection with the services stated in its application, in view of Opposer's ownership of valid and subsisting registrations for the goods identified therein, Opposer's priority is not in issue. *King Candy, Inc. v. Eunice King's Kitchen, Inc*., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). *Also see Sigma-Tau Industrie Farmaceutiche Riunite S.p.A. v. SigmaPharm Laboratories, LLC* at Opposition Nos. 91196802 and 91196807 (TTAB 2015) ("Because Opposer has properly made of record its pleaded registrations, Section 2(d) priority is not an issue in the opposition as to the mark and the goods covered by the pleaded registrations.").[4]

Even if Applicant is able to show abandonment of Opposer's DELIVERY DUDES registration at 4,101,367, that has no impact on the relevance and impact of Opposer's valid and subsisting registrations at 4,702,834 and 4,702,835, and Applicant is not now permitted under the rules of the TTAB to engage in a collateral attack on such registrations. The TBMP explicitly states that "priority is not in issue in an opposition where opposer pleads (and later proves) that it owns a registration for its pleaded mark, provided that there is no counterclaim or separate petition to cancel the pleaded registration." There is no such counterclaim or separate petition to cancel two of Opposer's pleaded registrations and thus, priority is not in issue. *L.C. Licensing Inc. v. Berman,* 86 USPQ2d 1883, 1887 (TTAB 2008) (pleaded registrations show current ownership and that each is valid and subsisting; priority is not an issue). *Fort James Operating Co. v. Royal Paper Converting Inc*., 83 USPQ2d 1624, 1626 (TTAB 2007) (having submitted status and title copies of its pleaded registrations, opposer not required to prove acquired distinctiveness of marks).

If the merits of Applicant's motion are reviewed despite the fact that Applicant's motion is devoid of a statement that they have made a good faith effort to resolve their differences with opposer, and a statement that the parties have been unable to resolve said differences, as is required by the Board, the Board should conclude that many of Applicant's requests are vague, irrelevant, overbroad and not designed to result in the discovery of relevant

[4] This decision is available in the online records of the TTAB at http://ttabvue.uspto.gov/ttabvue/v?pno=91196802&pty=OPP&eno=92 and a copy of the decision is submitted alongside this Response.

evidence - and that nonetheless, Opposer has produced documents that respond to those vague, irrelevant, overbroad and inappropriately drafted requests and Opposer's remaining objections should be sustained, especially as, even if they are, Opposer will still be obligated to supplement its production with additional responsive documents, and update its interrogatory answers if any change.

In addition, Opposer has produced a privilege log of documents protected by attorney-client privilege. Information protected by the attorney-client privilege is not discoverable unless the privilege has been waived; and documents and things prepared in anticipation of litigation or for trial by or for another party, or by or for that other party's representative, are discoverable only upon a showing that the party seeking discovery has substantial need of the materials in the preparation of its case and that it is unable, without undue hardship, to obtain the substantial equivalent of the materials by other means. See, for example FRCP 26(b)(3); *Goodyear Tire & Rubber Co. v. Tyrco Industries*, 186 USPQ 207 (TTAB 1975); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167 (TTAB 1975); *Miles Laboratories, Inc. v. Instrumentation Laboratory, Inc.*, 185 USPQ 432 (TTAB 1975); *Amerace Corp. v. USM Corp.*, 183 USPQ 506 (TTAB 1974); and *Goodyear Tire & Rubber Co. v. Uniroyal, Inc.*, 183 USPQ 372 (TTAB 1974). While Applicant claims that documents created by Opposer and its attorneys in the lead-up to, and during, the 2012 cancellation proceeding, were not created in connection with litigation, such argument must fail. The Board's "About" page at https://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board explicitly describes a proceeding before the Board as a litigation, stating that the "TBMP provides practitioners with basic information generally useful for litigating cases before the TTAB." Further, Opposer raised reasonable relevancy and proportionality objections in connection with various of Applicant's requests. Opposer's claims of privilege and attorney-client work product must be upheld, and Opposer requests that its objections including its objections to being forced to void privilege, be sustained as stated.

Many Requested Documents Are Publicly Available

The TTAB has held that materials that are publicly available on the internet and acquired by a party in anticipation of trial are generally not required to be produced in discovery. *Capital City, LLC v. Select Brands, LLC*, 2013 WL 5402086 at *3 (TTAB Aug. 26, 2013) (denying motion to strike internet material from notice of

reliance because "many of the documents introduced under [the notice of reliance] are not of the type whereby we can conclude they were solely within the possession of petitioner prior to trial") (citing *Rocket Trademarks Pty. Ltd. v. Phard. S.p.A.*, 98 USPQ2d 1066, 1071-72 (TTAB 2011)).

This is in keeping with Fed. R. Civ. P. 26(b)(2) which explicitly allows for limitations on discovery where such discovery is "unreasonably cumulative or duplicative, or can be obtained from another source that is more convenient, less burdensome, or less expensive." *Domond v. 37.37, Inc*., 113 USPQ2d 1264, 1268 (TTAB 2015). Opposer did not actually have copies of the entire trademark files in December, and obtained downloads from the USPTO only during discovery after the June 6, 2017 phone call with the Interlocutory Attorney due to the the Interlocutory Attorney's statement that it would be considerate to do so. Opposer still reasonably believes that per *Rocket Trademarks*, *Domond* and *Capital City*, it is not obligated to produce such documents, and maintains its objection to the production of publicly available documents, especially those that Applicant has already admitted to accessing and reviewing.

Additional Issues

Applicant's criticism of the clarity of eight year old receipts, as well as its criticisms of the Veneziano agreement, appear to be an attack on the probative value of Opposer's evidence. The Board will not entertain any motion challenging or otherwise relating to the probative value or sufficiency of a party's trial evidence, *Hunter Industries Inc. v. Toro Co.*, 110 USPQ2d 1651, 1656 n.11 (TTAB 2014), and thus these attacks should be given no consideration in the Board's decision regarding Applicant's Motion.

Applicant incomprehensibly and baselessly claims that Opposer's 2012 Petition for Cancellation is evidence that Opposer did not use its DELIVERY DUDES mark in interstate commerce before 2012; this entire claim appears to be based on a misreading of a line in said Petition. Applicant parses and twists Opposer's words in a self-serving misreading of Opposer's statement that it had "been actively rendering services in commerce in South Florida since 2009. Petitioner desires to obtain a registration in the Mark in order expand his current business and engage in interstate commerce with the Mark..." "Engage in" cannot be read as "commence" or "begin", and it is odd for Applicant to attempt to do so. In addition, the Board's longstanding policy states that intrastate sales may be found to have such an effect on interstate commerce that the activities constitute acceptable use in commerce

for purposes of trademark registration, there must be a showing that the activities have such an effect. See *In re Gastown*, 326 F.2d 780, 140 USPQ 216, 218 (CCPA 1964).

CONCLUSION

The matters complained of by Applicant in its premature Motion to Compel fall into three categories:

- They appear to refuse to accept any of Opposer's objections.
- They deny that they have received answers and documents that are responsive to each of their inquiries and requests.
- Their impatience and refusal to wait the additional days that Opposer stated that it would need, on June 19 2017, to produce additional documents that became responsive only after Applicant's Amended Answer was accepted on May 18, 2017, means that any items in its Motion to Compel that might have been considered legitimate were already in the process of being copied and bates-stamped by Opposer, and thus said matters were moot by June 20, 2017 or in the days thereafter.

In its Motion, Applicant makes no claim that it engaged in a good faith effort to resolve its differences with Opposer, or that such differences were insurmountable; Applicant's impatience to file its Motion to Compel one day after being told that Opposer would provide additional documents within the next few days, may be seen to imply that Applicant filed its Motion to Compel to force Opposer to engage in irrelevant motions practice and to harass Opposer, both of which are frowned upon by the Board.

Accordingly, Opposer requests (a) that their objections to specific document requests and interrogatories be accepted and sustained as stated, (b) that their privilege log be deemed acceptable as provided, and (c) Applicant's Motion to Compel be denied.

Respectfully submitted,
/hht/
Heidi Howard Tandy, Esq.
Attorney for Opposer/Counterclaim-Defendant Dude IP, LLC
July 4, 2017

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Response to Applicant's Motion to Compel has been served on Norman Abramson, Esq. via email to Norman.Abramson@gpmlaw.com on July 4, 2017.

_____/hht/_____

Heidi Howard Tandy, Esq.

Counsel for Opposer/Counterclaim-Defendant
Dude IP, LLC

Exhibit A

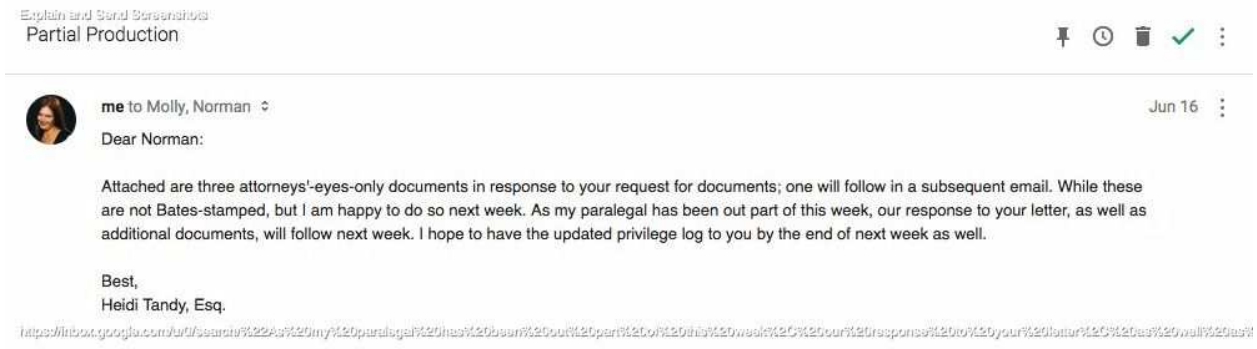
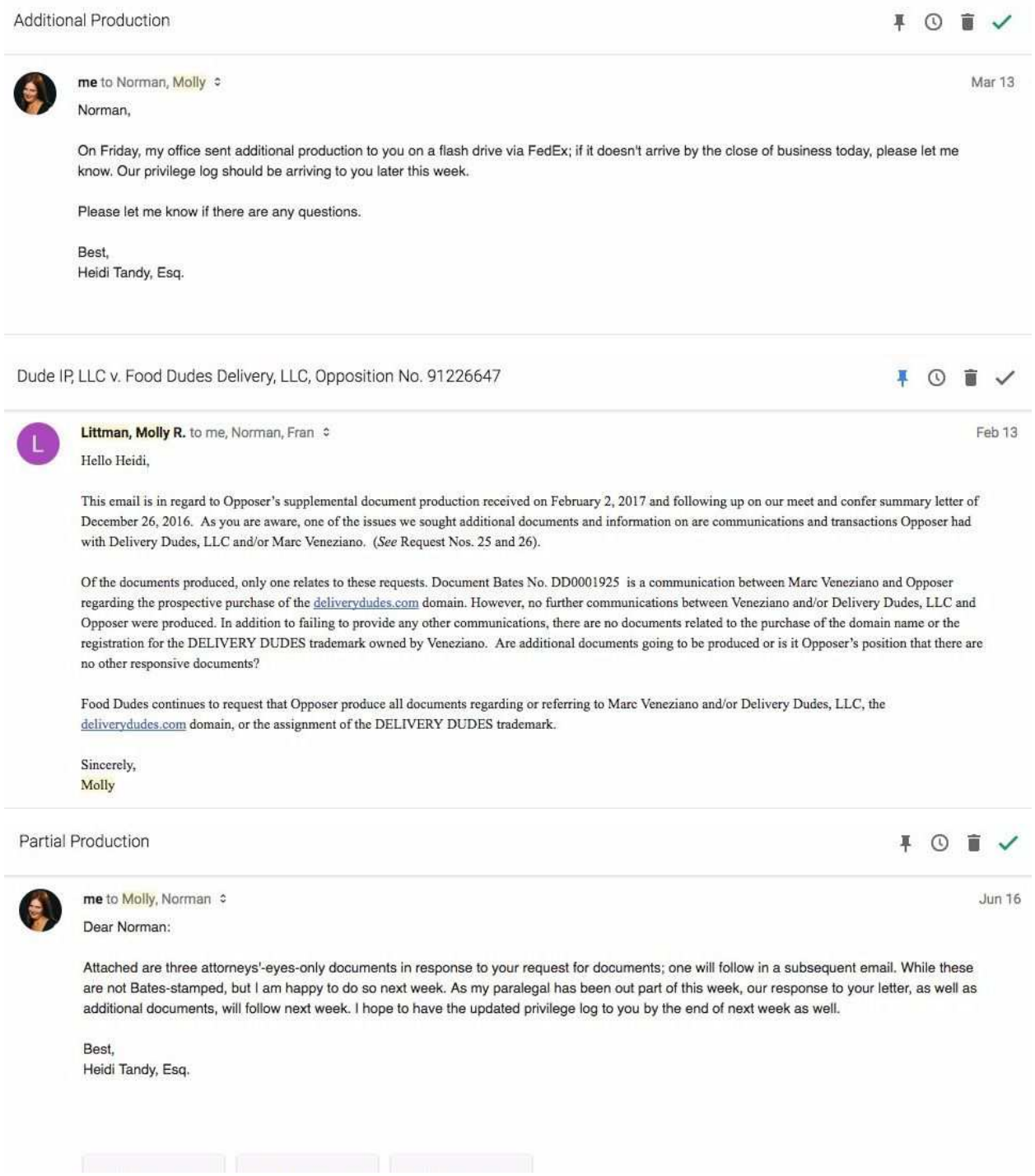

Explain and Send Screenshots
Partial Production
me to Molly, Norman
Jun 16
Dear Norman:
Attached are three attorneys'-eyes-only documents in response to your request for documents; one will follow in a subsequent email. While these are not Bates-stamped, but I am happy to do so next week. As my paralegal has been out part of this week, our response to your letter, as well as additional documents, will follow next week. I hope to have the updated privilege log to you by the end of next week as well.
Best,
Heidi Tandy, Esq.

Exhibit B



Additional Production

me to Norman, Molly — Mar 13

Norman,

On Friday, my office sent additional production to you on a flash drive via FedEx; if it doesn't arrive by the close of business today, please let me know. Our privilege log should be arriving to you later this week.

Please let me know if there are any questions.

Best,
Heidi Tandy, Esq.

Dude IP, LLC v. Food Dudes Delivery, LLC, Opposition No. 91226647

Littman, Molly R. to me, Norman, Fran — Feb 13

Hello Heidi,

This email is in regard to Opposer's supplemental document production received on February 2, 2017 and following up on our meet and confer summary letter of December 26, 2016. As you are aware, one of the issues we sought additional documents and information on are communications and transactions Opposer had with Delivery Dudes, LLC and/or Marc Veneziano. (*See* Request Nos. 25 and 26).

Of the documents produced, only one relates to these requests. Document Bates No. DD0001925 is a communication between Marc Veneziano and Opposer regarding the prospective purchase of the deliverydudes.com domain. However, no further communications between Veneziano and/or Delivery Dudes, LLC and Opposer were produced. In addition to failing to provide any other communications, there are no documents related to the purchase of the domain name or the registration for the DELIVERY DUDES trademark owned by Veneziano. Are additional documents going to be produced or is it Opposer's position that there are no other responsive documents?

Food Dudes continues to request that Opposer produce all documents regarding or referring to Marc Veneziano and/or Delivery Dudes, LLC, the deliverydudes.com domain, or the assignment of the DELIVERY DUDES trademark.

Sincerely,
Molly

Partial Production

me to Molly, Norman — Jun 16

Dear Norman:

Attached are three attorneys'-eyes-only documents in response to your request for documents; one will follow in a subsequent email. While these are not Bates-stamped, but I am happy to do so next week. As my paralegal has been out part of this week, our response to your letter, as well as additional documents, will follow next week. I hope to have the updated privilege log to you by the end of next week as well.

Best,
Heidi Tandy, Esq.

DELIVERY DUDES REVENUE 2014-2016 CONFIDENTIAL ATTORNEY EYES ONLY

me to me, Norman.Abramson, Molly.Littman, Katie.Schadewald, Jennifer.Veldhuizen Jul 3

Pursuant to the terms of the Protective Order entered into earlier this year between the parties, the attached document updates our June 22, 2017 response, and is produced on an Attorneys' Eyes Only basis; it has been marked accordingly.

Best,
Heidi Tandy, Esq.

Supplemental Privilelge Log - Delivery Dudes Production

L

Leanne Posch to Norman.Abramson@gpmlaw.com, me Mar 23

(On behalf of Heidi Tandy, Esq.)

Mr. Abramson,

Please see the attached document to be produced in discovery re the Delivery Dudes v Food Dudes matter. Please confirm receipt.

Sincerely,

Leann Posch, Legal Assistant
Fuller Lawyers, P.A.
1691 Michigan Avenue
Suite 360
Miami Beach, FL 33139
Phone: 305-445-7150
Fax: 305-447-4674

Delivery Dudes Production - Privilege Log

L

Leanne Posch to Norman.Abramson@gpmlaw.com, me Mar 16

(On behalf of Heidi Tandy, Esq.)

Mr. Abramson,

Please see the attached document to be produced in discovery re the Delivery Dudes v Food Dudes matter. Please confirm receipt.

Sincerely,

Leann Posch, Legal Assistant
Fuller Lawyers, P.A.
1691 Michigan Avenue
Suite 360
Miami Beach, FL 33139
Phone: 305-445-7150
Fax: 305-447-4674
E-mail: lposch@fullerlawyers.com