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

Proceeding	91227407
Party	Plaintiff Baccarat S.A.
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Date	07/28/2017
Attachments	BACCARAT S.A. - Reply in support of Motion to Compel.pdf(37841 bytes) BACCARAT S.A. - Exhibit A.pdf(106149 bytes)

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

In the matter of:
Serial No. 86/639975
For: BACCARAT
Published in the Official Gazette on October 20, 2015

BACCARAT S.A.	:	
	:	
OPPOSER	:	
	:	
v.	:	
	:	Opposition No. 91227407
Laux, Stefan H	:	
	:	
APPLICANT.	:	

OPPOSER BACCARAT S.A.'S REPLY IN SUPPORT OF ITS MOTION TO COMPEL DISCOVERY RESPONSES PURSUANT TO SECTIONS 411.02 AND 523.01 OF THE TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE AND RULE 37(a) OF THE FEDERAL RULES OF CIVIL PROCEDURE

Pursuant to TBMP § 502.02(b), Baccarat hereby submits this reply to briefly address the continuing deficiencies in Applicant's supplemental discovery responses, just served on July 12 and 24, 2017, as well as several blatant inaccuracies in the opposition brief filed by Applicant on July 12, 2017 (Dkt. # 13) (the "Opposition").[1] Applicant's allegedly "supplemental" responses are yet another attempt by Applicant to flout its discovery obligations, and its untimely Opposition makes irrelevant arguments and blatant misrepresentations that should be not be considered by the Board.

[1] Capitalized terms not defined herein shall have the meaning ascribed to them in Baccarat's Motion (Dkt. # 11).

I. Applicant's Purportedly Supplemental Responses Remain Grossly Inadequate.

On July 12, 2017—tellingly, only ***after*** the filing of the present Motion on June 22, 2017—Applicant served a set of purportedly supplemental responses to Baccarat's Discovery Requests (attached as Exhibit 3 to Applicant's Opposition (Dkt. # 13)). On July 24, 2017, Applicant also finally made a first production of documents, consisting of 2,896 pages of online print outs of trademark registrations and prosecution histories for marks that include the word "baccarat," produced as a single PDF document. These supplemental responses remain entirely deficient and still utterly fail to fulfill Applicant's discovery obligations.

Specifically, Applicant's supplemental responses to Baccarat's Interrogatories merely reiterate nearly all of the same boilerplate objections and provide virtually no additional responsive information. Indeed, Applicant's supplemental responses to Interrogatory Nos. 3, 4, 5, 7, and 18, for example, have not even been supplemented at all. Similarly, Applicant's supplemental responses to Interrogatory Nos. 11, 12, 13, 14, 15, and 16, several of which ask Applicant to state the basis for contentions it has asserted in its Answer, now merely recursively refer Baccarat to Applicant's answer, initial disclosures, and expert witness list, without providing any of the requested responsive information, and are thus still nonresponsive.

Applicant's supplemental responses and preliminary production in response to Baccarat's Requests for Production are also still grossly deficient. Though Applicant has now, as of July 24, 2017, produced nearly three-thousand pages exclusively evidencing other trademark prosecution histories and registrations (which, at most, is arguably responsive only to Request No. 19 and much of which was previously attached to Applicant's answer (Dkt. # 4)), Applicant has still completely failed to produce any documents responsive to any of Baccarat's other Requests. For example, in response to Request Nos. 1, 2, 4, 5, 6, 8, 10, 11, 12, 13, 14, 15, 16,

17, 18, and 40, Applicant's supplemental responses now merely state that Applicant has no documents responsive to any of these Requests. Likewise, in response to Request Nos. 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, and 37, Applicant refers Baccarat to its responses to the various corresponding Interrogatories, to which Applicant also failed to adequately respond, and then asserts that Applicant has no other responsive documents to any of these Requests. However, each of these Requests seeks highly-relevant information that is almost certainly within Applicant's possession. For instance:

- Request No. 6 seeks any documents relating to Applicant's selection, adoption, and use of the Applied-for Mark;
- Request No. 10 seeks any documents relating to Applicant's business plan or intent to use the Applied-for Mark;
- Request No. 11 seeks any documents relating to preliminary designs or logos for the Applied-for Mark;
- Request No. 12 seeks any documents relating to preliminary designs, prototypes, or samples relating to the products or services Applicant intends to offer under the Applied-for Mark;
- Request No. 15 seeks any documents relating to plans, designs, or samples related to promotion, marketing, or advertising of the Applied-for Mark;
- Request No. 16 seeks any documents identifying third parties with whom Applicant has discussed the Applied-for Mark;
- Request No. 17 seeks documents identifying consumers to whom Applicant intends to market or sell the products or services under the Applied-for Mark; and
- Request No. 18 seeks documents relating to Applicant's plans or intentions for using the Applied-for Mark.

The apparent explanation that no responsive documents exist because "Applicant tends to commit plans and thoughts to memory rather than to paper," Opposition, at 7, is not only implausible but inconsistent with Applicant's own prior statements. Specifically, Applicant's ***own*** Rule 26(a)(1) initial disclosures expressly identify "[d]ocuments concerning ***Applicant's selection, adoption and/or use of the Applicant's trademark 'BACCARAT'***," within the

description of documents and things "in the possession, control or custody of [Applicant] that [Applicant] may use to support his claims or defenses." *See* Applicant's Rule 26(a)(1) Initial Disclosures, attached hereto as Exhibit A, at 3. Thus, it is unbelievable that Applicant, which submitted a trademark application on May 23, 2015, does not have a single document responsive to ***any*** of these Requests, all of which are fundamental in nature and scope to this proceeding, when Applicant has itself said it intends to rely on such documents.

Applicant's other supplemental responses, including Supplemental Response Nos. 3, 19, and 20, once again state only that Applicant is willing to "meet and confer" regarding these Requests, despite their clear relevance to this action and unobjectionable nature, as well as Applicant's repeated refusals to do just that.

Thus, Applicant's purported supplemental responses and production, only served since the filing of the Motion, remain entirely deficient and reflect Applicant's continued attempts to stall and prevent Baccarat from obtaining relevant discovery. As such, the Motion should still be granted.

II. Applicant's Opposition Should Be Disregarded as Untimely.

On top of Applicant's still-deficient supplemental responses, Applicant's Opposition is untimely and should be disregarded. *See, e.g., Smith v. Donahoe*, 917 F. Supp. 2d 562, 568 (E.D. Va. 2013) (granting motion to strike untimely opposition); *Davidson v. Keenan*, 740 F.2d 129, 131 (2d Cir. 1984) (finding no abuse of discretion in refusing to consider papers filed late and without adequate excuse). Pursuant to TBMP § 502.02(b), Applicant had fifteen days to respond to Baccarat's Motion, which was filed via ESSTA and served via both electronic mail

and U.S. Mail on June 22, 2017, as identified in the Certificate of Service (Dkt. # 11).[2] As such, any response was due within fifteen days by July 7, 2017. However, Applicant did not file any response until 11:29 PM on July 12, 2017 (which was served only by electronic mail) and failed to provide any explanation for this undue delay. For this reason alone, Applicant's Opposition should be disregarded in its entirety and Baccarat's Motion granted.

III. Baccarat's Attempts to Resolve This Dispute Were Adequate And Further Efforts Would Have Been Futile.

Applicant also makes much of what it deems to be Baccarat's failure to fulfill its "meet and confer" requirement. However, in view of Applicant's repeated pattern of ignoring communications from Baccarat and stalling on its discovery obligations over the past six months, Baccarat's efforts to resolve the outstanding disputes with Applicant prior to filing the present Motion, including by its June 5, 2017 letter outlining Applicant's discovery deficiencies and setting a final deadline for supplemental responses (*see* Dkt. # 11, at Ex. 8),[3] are reasonable and sufficient to meet its obligation under the Federal Rules of Civil Procedure and the rules of this

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[2] To the extent Applicant is heard to argue that the parties did not agree in writing that service may be effectuated via electronic transmission such that Applicant is entitled to five additional days for its response, Baccarat notes that Applicant served its Opposition, as well as all other pleadings in this action, ***solely*** by electronic mail, as evidenced by its Certificate of Service (Dkt. # 13), which would be insufficient service in the absence of such an agreement. To that extent, Baccarat notes that the Opposition should then be disregarded for Applicant's failure to effectuate service (of the Opposition as well as all other pleadings to date) as required by Trademark Rule 2.119(a), 37 CFR §2.119(a).

[3] Grasping at straws, Applicant also boldly claims that counsel never received ***any*** of Baccarat's correspondence, which was delivered via both U.S. Mail and electronic mail, contending that it was "misaddressed" for omitting the name of Applicant's counsel's law firm. Opposition, at 3. However, Applicant does not and cannot contend that the mailing address was incorrect or contest that all of Baccarat's correspondence was also delivered to Applicant's counsel via e-mail to the correct e-mail address. Applicant therefore has no excuse for his consistent and repeated failure to respond to or acknowledge Baccarat's correspondence.

Board. Unsurprisingly, rather than respond to or even request additional time to respond to this letter, Applicant chose to once again disregard its obligations and ignore this letter. As previously set forth, Baccarat has now made several good faith efforts to obtain relevant discovery in preparation for trial in this proceeding, all of which Applicant has elected to disregard. Moreover, given Applicant's longstanding failure to provide adequate discovery, the record is clear that any further attempt to resolve this matter without Board intervention would be futile. Courts will excuse parties from the requirement of conferring where it appears that such an effort would be futile. *See, e.g., United States v. Acquest Transit LLC*, 319 F.R.D. 83, 89 (W.D.N.Y. 2017) (stating that parties are excused from the requirement of an effort to confer under Federal Rule of Civil Procedure 37(a)(1) "where the record shows an attempt to confer would be futile"). Thus, even if Baccarat's numerous good faith efforts to resolve this dispute were insufficient, which they were not, the Motion should still be granted because any further efforts to resolve this dispute with Applicant would be futile. *See id.*

Applicant's contention that a telephonic conference is required before filing a motion to compel is also incorrect. Applicant relies on *Westlake Polymers LLC v. Westlake Plastics Co.*, 2015 WL 9906631 (TTAB 2015), but *Westlake Polymers* is not a precedent of the TTAB. In fact, a good faith effort to resolve a discovery dispute without involving the Board may be made either by "conference ***or correspondence***." *See* 37 CFR § 2.120(f)(1) (emphasis added). Thus, Baccarat's attempt to resolve the pending disputes via correspondence to Applicant is more than sufficient under the applicable rules.[4]

[4] Applicant also misreads the holding of *Miss Am. Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067, 1068 (TTAB 1990), in which the Board only considered the adequacy of efforts to confer in the context of a motion for a protective order, and where in any event the Board ultimately concluded that "respondent's argument that petitioner's motion should be

Finally, even if Baccarat had not attempted in good faith to resolve this dispute, which it now has multiple times, the Board still retains discretion to grant the Motion, which it should exercise here. *See Sentrol, Inc. v. Sentex Systems, Inc.*, 231 U.S.P.Q. 666, (T.T.A.B. 1986) (granting motions to compel even though parties had failed to adequately attempt to resolve discovery dispute among themselves). Given the urgent need for Baccarat to obtain discovery relevant to prosecuting its claims in this proceeding, and Applicant's repeated failures to cooperate to date, the Motion should be granted.

IV. Applicant's Other Arguments Are Also Meritless.

Even if the Board were to consider Applicant's untimely Opposition, Applicant's arguments therein are meritless. In addition to failing to provide any substantive defense of its deficient discovery responses, Applicant repeatedly argues that Baccarat's discovery responses are purportedly deficient, apparently suggesting that this has any relevance to Applicant's discovery obligations. It does not. *See, e.g., In re Napster, Inc. Copyright Litigation*, 462 F. Supp. 2d 1060, 1074 (N.D. Cal. 2006) (deficiencies in one party's discovery responses are irrelevant to adjudicating the deficiencies of another party's responses); *Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067, 1070 (TTAB 1990) ("a party is not relieved of its discovery obligations in spite of the fact that its adverse party has wrongfully failed to fulfill its own obligations").[5]

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denied as premature in view of the failure of the petitioner to attempt to work out this issue, is without merit." *Id.*

[5] Though plainly not relevant to this Motion, Baccarat states for the record that it provided timely and complete responses to both Applicant's First Set of Requests for Production and First Set of Interrogatories on September 14, 2016 and produced over 1,500 pages of responsive documents to Applicant on February 23, 2017 and an additional 1,100 pages of responsive documents on March 17, 2017. Following Applicant's subsequent discovery deficiency letter to Baccarat on December 9, 2016, Baccarat timely provided a response letter

Applicant's argument that Baccarat has not in fact been prejudiced by Applicant's disregard for its discovery obligations is likewise meritless. Baccarat's discovery requests were served seven months ago on December 28, 2016, but Applicant's failure to timely and adequately respond has necessitated this Motion and severely prejudiced Baccarat's ability to conduct supplemental discovery and prepare for trial, justifying an extension of the close of discovery as to Baccarat only. *See Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067, 1070 (TTAB 1990) ("the Board will, upon motion, reopen or extend discovery ***solely for the benefit of a party whose opponent, by wrongfully refusing to answer, or delaying its responses to, discovery, has unfairly deprived the propounding party of the right to take follow-up***") (emphasis added). Applicant apparently cites *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303 (TTAB 1987) for the proposition that Baccarat has not been prejudiced. However, *Luehrmann* is inapposite, as it involved a party that had delayed serving discovery until the very last day of the discovery period and did not involve a party flouting its discovery obligations as Applicant has done. Unlike the parties in *Luerhmann*, Baccarat diligently and appropriately served its discovery requests on Applicant seven months ago, well within the Board's discovery schedule, but Applicant has consistently failed and refused to comply with its obligations. Thus, the Board should extend the close of discovery as to Baccarat only.

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detailing the sufficiency of its responses on December 23, 2016. On April 13, 2017, counsel for the parties held a meet and confer regarding alleged deficiencies in Baccarat's discovery responses to which the parties could not reach a resolution. Over three months later, Applicant has still not revised or narrowed any of its discovery requests or moved to compel.

CONCLUSION

For all of the foregoing reasons, Baccarat respectfully requests that the Board grant its Motion in its entirety.

Date: July 28, 2017

Respectfully submitted,

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Attorney for Opposer, Baccarat S.A.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing document was served this 28th day of July, 2017, by sending a copy thereof via first class mail and e-mail, addressed to counsel for the Applicant:

Christian W. Liedtke
cw.liedke@acuminis.biz
acuminis pc
3420 Bristol St., 6th Floor
Costa Mesa, CA 92626

/s/ *Mark S. Leonardo*
Mark S. Leonardo

EXHIBIT A

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

BACCARAT S.A., Opposer, v. STEFAN H. LAUX, Applicant.	Opposition No. 91227407 **Application Serial No. 86/639,975** Mark: BACCARAT

APPLICANT'S RULE 26(a)(1) INITIAL DISCLOSURES

Pursuant to Trademark Rule 2.120(a)(3) and Federal Rule of Civil Procedure 26(a)(1) Stefan H. Laux ("Stefan Laux" or "Applicant") makes the following initial disclosures to the Opposer in the above referenced proceeding. These disclosures are based on information presently known and reasonably available to Stefan Laux and which Stefan Laux reasonably believes he may use in support of his claims and defenses. Continuing investigation and discovery may cause Stefan Laux to amend these initial disclosures including by identifying other potential witnesses, documents and by disclosing other pertinent information. Stefan Laux therefore reserves the right to supplement or modify these initial disclosures.

By providing these initial disclosures, Stefan Laux does not represent that he is identifying every document, tangible thing or witness possibly relevant to this action. Additionally, these disclosures are made without Stefan Laux in any way waiving (i) any claim of privilege or work product; (ii) his right to object to any discovery request or proceeding involving or relating to the subject matter of these disclosures on any

grounds, including but not limited to competency, privilege, relevancy and materiality, hearsay, undue burden, confidentiality, or any other appropriate grounds. Moreover, these disclosures are not an admission by Stefan Laux regarding any matter. Furthermore, by providing these disclosures, Stefan Laux is not conceding that he bears the burden of proof or persuasion on any of them.

Furthermore, these disclosures do not identify or otherwise include information concerning experts, as this subject is not covered by Fed. R. Civ. P. 26(a)(1). Applicant will provide his expert disclosures pursuant to the deadlines set forth in the Board's Institution and Scheduling Order.

Each and every disclosure set forth below is subject to the above qualifications and limitations.

1. <u>Individuals Likely to Have Discoverable Information</u>

In accordance with Rule 26(a)(1)(A) the following is a list of individuals likely to have discoverable factual information that Stefan Laux may use to support his claims or defenses:

Name/Title	**Address**	**Subject Matter**
Stefan Laux	via Counsel acuminis pc 3420 Bristol Street, 6th Fl. Costa Mesa, CA 92626	Selection, adoption, development of and investment in Applicant's mark "BACCARAT", marketing, including target markets, target demographics, advertising, sales, promotional activities

2. Description of Documents and Things

In accordance with Rule 26(a)(1)(B), the following enumerates documents, data compilations, and other tangible things in the possession, control or custody of Stefan Laux that Stefan Laux may use to support his claims or defenses.

Description of Documents	**Location**
Documents concerning Applicant's selection, adoption and/or use of Applicant's trademark "BACCARAT"	Applicant
USPTO file history for the Applicant's trademark "BACCARAT" U.S. Application No. 86/639,975	Office of Counsel for Applicant/ United States Patent and Trademark Office
Documents and USPTO file histories for existing U.S. trademark registrations co-existing with Opposer's alleged marks	Office of Counsel for Applicant/ United States Patent and Trademark Office
Documents concerning Stefan Laux's affirmative defenses in the instant proceeding including but not limited to third party use	Office of Counsel for Applicant

Dated: July 28th, 2016

acuminis pc

/s/ Christian W. Liedtke
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Certificate of Service

I hereby certify that on July 28, 2016, pursuant to Trademark Rule 2.119(b)(6), I served a copy of the foregoing **APPLICANT'S RULE 26(a)(1) INITIAL DISCLOSURES** via electronic mail on counsel for Opposer:

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/s/ Nicole A. Liedtke
Nicole A. Liedtke