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

Proceeding	91228289
Party	Defendant Mitac International Corp.
Correspondence Address	LAWRENCE E ABELMAN ABELMAN FRAYNE & SCHWAB 666 THIRD AVENUE NEW YORK, NY 10017-5621 UNITED STATES Email: docket@lawabel.com, leabelman@lawabel.com, jbseyler@lawabel.com
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Signature	/Julie B. Seyler/
Date	09/12/2017
Attachments	MiTAC Response to McFreen Motion to Compel 9.12.17.pdf(657148 bytes)

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

Padraic McFreen.

Opposer,

v.

MiTAC International Corp.

Applicant.

Opposition No. 91228289

**APPLICANT'S RESPONSE TO OPPOSER'S MOTION TO COMPEL
And
APPLICANT'S REPLY TO
OPPOSER'S RESPONSE TO APPLICANT'S MOTION TO COMPEL**

I. Applicant Response to Opposer's Motion to Compel

A. Introduction

Opposer's Motion to Compel ("Motion") should be denied on its face because Opposer does not comply with the basic requirements for bringing such a motion, namely it failed to engage in a good faith discussion to resolve disputes prior to the filing of the Motion; the Motion was filed well after the due date for Opposer's pretrial disclosures; the Motion failed to include copies of the objected to discovery and Applicant's responses thereto and Opposer never served Applicant with a copy of its submission to the Trademark Trial and Appeal Board.

Moreover, Applicant timely provided full and complete responses to Opposer's written discovery. This is not seriously disputed in Opposer's Motion¹.

¹ The issues raised by Opposer in its Motion have been corrected and Applicant has served its amended responses on Opposer.

B. Opposer's Motion to Compel Should be Denied Because Opposer Failed to Comply with 37 CFR § 2.120(f)(1) in its Entirety.

(i) Opposer's Motion is Untimely

37 CFR § 2.120(f)(1) provides that a motion to compel discovery must be filed prior to the deadline for pretrial disclosures for the first testimony period as originally set or as reset. Under the trial schedule set by the Board in its April 24, 2017 order, Opposer's Pretrial Disclosures were due on August 23, 2017. Opposer served its Motion on September 6, two weeks late; therefore, the Motion is untimely and should be denied.

(ii) Opposer's Motion Does Not Include Copies of Opposer's Discovery or Applicant's Responses

37 CFR § 2.120(f) (1) provides that a motion to compel discovery must include a copy of the interrogatory with any answer or objection that was made and a copy of the request for production and any proffer of production or objection to production in response to the request. Opposer's Motion did not include Applicant's full and complete responses to Opposer's interrogatories and document requests.

(iii) Opposer Never Made a Good Faith Effort to Resolve Discovery Disputes with Applicant

37 CFR § 2.120(f) (1) mandates that a motion to compel discovery must be supported by a written statement from the moving party that such party has made a good faith effort to resolve with the other party the outstanding discovery disputes. The Trademark Board Manual of Procedure 523.02 advises that the good faith statement "should contain a recitation of the communications conducted including dates, a summary of telephone conversations, and where applicable, copies of any correspondence exchanged such as email and letters, or notes to the file."

Opposer's Motion does not include this statement because he never did make such a good faith effort. This omission is clearly intentional and made in bad faith since Opposer made no effort to discuss its discovery differences with Applicant. Indeed, Applicant is still not sure what those differences are.

(iv) Opposer Failed to Serve Applicant

37 CFR § 2.116(b) mandates that service of submissions filed with the Board must be served on the attorney. Opposer never served a copy of OPPOSER'S MOTION IN OPPOSITION TO MOTION TO COMPEL AND OPPOSER'S MOTION TO COMPEL BETTER ANSWERS TO DISCOVERY AND REQUEST FOR BOARD INTERVENTION. Rather the sole reason that Applicant has knowledge that Opposer filed its Motion is because on September 6, 2017, the undersigned received an email from estta-server@uspto.gov advising of a filing at ESTTA of "Other Motions/Papers confirmation receipt ID: ESTTA844063".

(v) Opposer's Motion Must be Denied Because Applicant Provided Full and Complete Responses to Discovery

Applicant timely provided full and complete responses to Opposer's discovery and has served Opposer with amended responses to Opposer's interrogatories and document requests and also provided its responsive documents.

II. Applicant's Motion to Reopen Discovery Should be Granted.

Opposer asserts that Applicant has not managed its discovery judiciously, and therefore, is not entitled to benefit from a reopening of discovery. This argument is unsupported and without merit. The reason that Applicant's Motion was necessary was due to Opposer's repeated dodges and evasions in responding to discovery as detailed in the motion.

Specifically, Applicant's discovery was served on June 5 and thus Opposer's responses were due on July 5, 2017. Having not heard from Opposer by the due date, Applicant contacted

Opposer inquiring about the status of Opposer's responses. On July 11, Opposer sought an extension of time which Applicant's attorney granted until July 26. However, Opposer did not abide by this date, rather Applicant made two other good faith efforts to obtain Opposer's discovery responses (July 31 and August 2nd) and when Opposer's responses were ultimately served on August 3rd they were wholly deficient because Opposer made baseless boiler plate objections and failed to respond in any meaningful or substantive way. All of these deficiencies are in Applicant's motion and Opposer's response is devoid of any substantive dispute. Accordingly, Applicant's motion should be granted.

III. Applicant's Reply to Opposer's Response to Applicant's Motion to Compel

On August 22, 2017, after repeated good faith attempts to resolve discovery disputes with Opposer, Applicant timely filed a Motion to Compel. The Motion detailed the deficiencies in Opposer's responses to Applicant's interrogatories and document requests.

On September 6, Opposer filed its response to Applicant's Motion. This response fails to set forth any substantive reason why Applicant's Motion should be denied. In fact, Opposer's response is an example of the deliberate manner in which Opposer refuses to comply with its discovery obligations and is attempting to obstruct this opposition proceeding.

Opposer does not assert that Applicant failed to make a good faith effort to work with Opposer to overcome the discovery disputes.

Opposer does not assert it provided full and complete responses to Applicant's written discovery requests.²

² Opposer asserts it provided Applicant with confidential business documents. On August 23, 2017, Opposer's Counsel forwarded non-bate stamped documents of an indeterminate nature. The documents were not in compliance with Fed. R. Civ. P. 34(b)(2)(E)(i) which mandates that a party must organize and label documents to correspond to the categories in the document request. There was no attempt or intent on the part of Opposer to comply with the Trademark Rules or the Federal Rules of Civil Procedure.

Unbelievably, the sole ground that Opposer asserts as a basis for denying Applicant's Motion is that Opposer has been prejudiced because Applicant timely served its Motion to Compel before the date Opposer's pre-trial disclosures were due when Applicant is required to file this motion by such a date. In making this argument, Opposer ignores that it had been served discovery on June 5; sought extensions of time and still failed to abide by the new term date permitted and when it did serve responses they were virtually non-responsive in their entirety.

IV. Opposer's Misstatements of Facts

Opposer asserts that Opposer consented to Applicant's request to extend the June 21 term date for Applicant to respond to Opposer's discovery. This is a blatant misstatement of fact.

Applicant sought consent in an email dated June 20. Opposer's Counsel advised it was checking with his client. Opposer never reverted with a confirmation of consent. (Please see emails attached in Exhibit A). Applicant timely served full and complete responses to written interrogatories and document requests on June 21, 2017.

Opposer in Paragraph 6 of its filing asserts that:

on two separate dates, July 14 and July 31, 2017, Opposer pointed out to Applicant that the discovery responses of Applicant contained the names of third-party companies, "Foodtown, Inc." and "Alpha I Marketing Corp.", both are not a party to this opposition, and not that of Opposer. Applicant's counsel said that she would look into the matter, but never responded to Opposer regarding this severe deficiency nor did Applicant attempt to amend the discovery.

This is another blatant misstatement of fact.

On July 14, 2017, Opposer sent an email stating "I don't know if you want to change it but your discovery requests reference companies not party to the opposition (I think it is in the general objections section)."

On July 17, Applicant requested clarification specifically inquiring whether he was referring to General Objection No. 4:

Did you mean in Applicant's Responses to Opposer's Interrogatories wherein it referenced Tequila rather than MiTAC and inquired whether there was another reference because it could not be located.

(Emails attached as part of Exhibit B).

Opposer never responded to the July 17 email.

On July 31, 2017 Opposer wrote again and inquired whether Applicant intended to amend its discovery responses.

Applicant requested that Opposer telephone and when no phone call was forthcoming sent a follow up email stating:

I am not clear as what you are referring to when you are asking if we intend to amend our discovery responses. In a prior email you stated "I don't know if you want to change it but your discovery requests reference companies not party to the opposition (I think it is in the general objections section). Do you mean in the General Objections to our responses to your client's interrogatories?"

(Emails included in Exhibit B).

Opposer never responded.

Thus to assert in Paragraph 7 of Opposer's filing that "Applicant's Counsel said she would look in the matter, but never responded to Opposer regarding this severe deficiency nor did Applicant attempt to amend discovery" is false.


In Paragraph 9 Opposer makes another baseless assertion that Applicant has not responded to Opposer's discovery and has only responded with boiler plate responses. Had Opposer followed the rules of procedure and attached Applicant's responses to discovery this issue would be moot.

Alternatively, if Opposer had followed the rules requiring that it undertake a good faith effort to resolve any alleged deficiency it claimed existed in Applicant's responses, this issue would be moot. However, it appears that Opposer prefers to go on record with unsupported assertions.

For the foregoing reasons, Applicant requests that Applicant's Motion to Compel and to Reopen Discovery for Applicant be granted and that Opposer's Motion to Compel be denied.

Respectfully submitted,

Date: September 12, 2017
New York, New York

By 
JULIE B. SEYLER
NED W. BRANTHOVER

Abelman, Frayne & Schwab
666 Third Avenue
New York, New York 10017
(212) 949-9022

Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing was served via email, this 12th day of September, 2017, upon the following:

ms@TheMiamiLaw.com

Michael D. Stewart, Esq.
Law Offices of Michael D. Stewart
150 SE 2nd Ave., Suite 1000, 10th Floor
Miami, Florida 33131

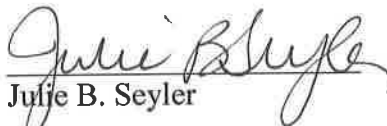

Julie B. Seyler

Exhibit A

SEYLER, J.

From: SEYLER, J.
Sent: Tuesday, June 20, 2017 10:56 AM
To: 'ms@miamilaw.com'
Cc: midstewart@gmail.com; HALSTEAD, E.
Subject: RE: MIVUE Trademark Opposition 91228289

Dear Michael:

Please advise if you will consent to a 30-day extension for Mitac to respond to the outstanding discovery requests such that they will now be due on July 20. Mitac will extend the courtesy to your client as well, thereby extending the due date from July 4 to August 4.

Further, to the extent that consent is provided, we shall file a 30-day extension of all dates with the Board such that Discovery will close on August 8 rather than July 9.

Your courtesy is appreciated.

I look forward to hearing from you.

Regards,
Julie

Julie B. Seyler
ABELMAN FRAYNE & SCHWAB
666 Third Avenue
New York, New York 10017
212-949-9022

From: midstewart@gmail.com [<mailto:midstewart@gmail.com>] **On Behalf Of** Michael Stewart
Sent: Monday, May 22, 2017 12:10 PM
To: Docket; ABELMAN, L.; SEYLER, J.
Subject: MIVUE Trademark Opposition 91228289

Julie:

Further to our telephone conversation a moment ago, attached is our first set of discovery documents. We look forward to hearing from you.

Very truly yours,

/Michael D. Stewart/
MICHAEL D. STEWART, ESQ.
Law Offices of Michael D. Stewart
Please note new address
150 SE 2nd Ave., Suite 1000, 10th Floor
Miami, Florida 33131

SEYLER, J.

From: SEYLER, J.
Sent: Tuesday, June 20, 2017 12:23 PM
To: 'Michael Stewart'
Subject: RE: FW: MIVUE Trademark Opposition 91228289

Ok.

Thanks for update.

Julie B. Seyler
ABELMAN FRAYNE & SCHWAB
666 Third Avenue
New York, New York 10017
212-949-9022

From: midstewart@gmail.com [mailto:midstewart@gmail.com] **On Behalf Of** Michael Stewart
Sent: Tuesday, June 20, 2017 12:12 PM
To: SEYLER, J.
Subject: Re: FW: MIVUE Trademark Opposition 91228289

Julie:

I am waiting to hear from my client. I will get back to you shortly.

Very truly yours,

/Michael D. Stewart/
MICHAEL D. STEWART, ESQ.
Law Offices of Michael D. Stewart
Please note new address
150 SE 2nd Ave., Suite 1000, 10th Floor
Miami, Florida 33131
email: ms@TheMiamiLaw.com
1-305-590-8909 Telephone
1-866-438-6574
1-305-415-9920 Facsimile
Website: <http://www.TheMiamiLaw.com>
<http://www.gotpersonalinjury.com>
Twitter: <https://twitter.com/TheMiamiLaw>
Facebook: <http://www.facebook.com/themiamilawyer>
LinkedIn: <https://www.linkedin.com/in/miamilawyer>
Google: <https://plus.google.com/+Themiamilaw/posts>

Admitted to practice in New York and Florida, State and Federal Courts

This communication is intended solely for the use of the intended individual or entity and may

Exhibit B

SEYLER, J.

From: SEYLER, J.
Sent: Monday, July 31, 2017 4:34 PM
To: 'Michael Stewart'
Cc: HALSTEAD, E.
Subject: RE: MIVUE Trademark Opposition

Dear Michael,

I asked you to telephone because we never received your client's responses to discovery. Please resend them and confirm that you are doing so. Upon receipt we shall confirm that we have them.

I am not clear as what you are referring to when you are asking if we intend to amend our discovery responses. In a prior email you stated "I don't know if you want to change it but your discovery requests reference companies not party to the opposition (I think it is in the general objections section). Do you mean in the General Objections to our responses to your client's interrogatories?"

In an email dated July 17, I contacted you for clarification and specifically inquired whether you meant in Applicant's Responses to Opposer's Interrogatories in General Objection No. 4 wherein it is stated that "Mitac objects to Opposer's Definitions and "Instructions" to the extent that they seek to impose any obligation or burden on **Tequila** not specifically required by the Trademark and Appeal Board rules of the Federal Rules of Civil Procedure" and that rather than Tequila it should state Mitac? We would want to change this to state Mitac. If there is another reference, please advise as we searched the documents and could not locate it.

We shall forward your client's proposal to our client.

Regards,
Julie

Julie B. Seyler
ABELMAN FRAYNE & SCHWAB
666 Third Avenue
New York, New York 10017
212-949-9022

From: midstewart@gmail.com [mailto:midstewart@gmail.com] **On Behalf Of** Michael Stewart
Sent: Monday, July 31, 2017 3:20 PM
To: SEYLER, J.
Subject: MIVUE Trademark Opposition

Julie:

Have you had a chance to review my client's discovery? Do you intend to amend your discovery responses?

In my preparation for trial in this matter I note that it seems clear that your client is infringing upon my clients trademark rights. It also appears from the internet that your client is making uses of the mark which were not covered by the initial application, which we believe also clearly infringe upon my clients rights.

SEYLER, J.

From: SEYLER, J.
Sent: Monday, July 31, 2017 4:18 PM
To: 'Michael Stewart'
Cc: HALSTEAD, E.
Subject: RE: MIVUE Trademark Opposition

Please telephone.

Julie

Julie B. Seyler
ABELMAN FRAYNE & SCHWAB
666 Third Avenue
New York, New York 10017
212-949-9022

From: midstewart@gmail.com [<mailto:midstewart@gmail.com>] **On Behalf Of** Michael Stewart
Sent: Monday, July 31, 2017 3:20 PM
To: SEYLER, J.
Subject: MIVUE Trademark Opposition

Julie:

Have you had a chance to review my client's discovery? Do you intend to amend your discovery responses?

In my preparation for trial in this matter I note that it seems clear that your client is infringing upon my clients trademark rights. It also appears from the internet that your client is making uses of the mark which were not covered by the initial application, which we believe also clearly infringe upon my clients rights.

I understand that you previously had settlement negotiations with my client and that those negotiations broke down. After consultation with my client, he is willing to resolve this matter and to provide your client with a release from liability for a one time payment of \$500,000.00. Please let me know if your client is interested.

Very truly yours,

/Michael D. Stewart/
MICHAEL D. STEWART, ESQ.
Law Offices of Michael D. Stewart
Please note new address
150 SE 2nd Ave., Suite 1000, 10th Floor
Miami, Florida 33131
email: ms@TheMiamiLaw.com
1-305-590-8909 Telephone

SEYLER, J.

From: SEYLER, J.
Sent: Monday, July 17, 2017 10:49 AM
To: 'midstewart@gmail.com'
Cc: HALSTEAD, E.
Subject: RE: MIVUE Trademark Opposition 91228289

Dear Michael:

In your email below you mention that our "discovery requests" reference companies not party to the opposition and note that this appears in the general objections section. Did you mean in Applicant's Responses to Opposer's Interrogatories in General Objection No. 4 wherein it is stated that "Mitac objects to Opposer's Definitions and "Instructions" to the extent that they seek to impose any obligation or burden on **Tequila** not specifically required by the Trademark and Appeal Board rules of the Federal Rules of Civil Procedure" and that rather than Tequila it should state Mitac? We would want to change this to state Mitac. If there is another reference, please advise as we searched the documents and could not locate it.

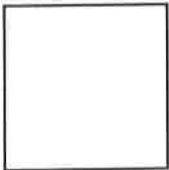
Regards,
Julie

Julie B. Seyler
ABELMAN FRAYNE & SCHWAB
666 Third Avenue
New York, New York 10017
212-949-9022

From: Michael Stewart [mailto:midstewart@gmail.com]
Sent: Friday, July 14, 2017 1:22 PM
To: SEYLER, J.
Subject: Re: MIVUE Trademark Opposition 91228289

Julie:

Thank you. Please not and I don't know if you want to change it but your discovery requests reference companies not party to the opposition (I think it is in the general objections section).



Very truly yours,

/Michael D. Stewart/

SEYLER, J.

From: Michael Stewart <midstewart@gmail.com>
Sent: Friday, July 14, 2017 1:22 PM
To: SEYLER, J.
Subject: Re: MIVUE Trademark Opposition 91228289

Julie:

Thank you. Please not and I don't know if you want to change it but your discovery requests reference companies not party to the opposition (I think it is in the general objections section).



Very truly yours,

/Michael D. Stewart/
MICHAEL D. STEWART, ESQ.
Law Offices of Michael D. Stewart
Please note new address
150 SE 2nd Ave., Suite 1000, 10th Floor
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1-305-590-8909 Telephone
1-866-438-6574
1-305-415-9920 Facsimile
Website: <http://www.TheMiamiLaw.com>
<http://www.gotpersonalinjury.com>
Twitter: <https://twitter.com/TheMiamiLaw>
Facebook: <http://www.facebook.com/themiamilawyer>
LinkedIn: <https://www.linkedin.com/in/miamilawyer>
Google: <https://plus.google.com/+Themiamilaw/posts>

Admitted to practice in New York and Florida, State and Federal Courts

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On Fri, Jul 14, 2017 at 7:17 AM, SEYLER, J. <JBSeyler@lawabel.com> wrote:
Dear Michael,

I have been advised our client has no objection to the extension.

Julie