ESTTA Tracking number: **ESTTA905860**

Filing date: **06/27/2018**

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, nwbranthover@lawabel.com
Submission	Other Motions/Papers
Filer's Name	Julie B. Seyler
Filer's email	jbseyler@lawabel.com, nwbranthover@lawabel.com
Signature	/Julie B. Seyler/
Date	06/27/2018
Attachments	MIVU Applicant Reply 6.27.18.pdf(177747 bytes)

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

In re Application No. 86/786555
Published May 24, 2016

Padraic C. McFreen

Opposer,

v.

MiTAC International Corp.,

Applicant.

Opposition No. 91228289

APPLICANT'S REPLY IN SUPPORT OF APPLICANT'S MOTION FOR SANCTIONS AND MOTION TO EXTEND APPLICANT'S DISCOVERY

Applicant MiTAC International Corp. files this reply in opposition to Opposer's response filed on June 15, 2018 and in support of Applicant's Motion for Sanctions and to Extend Applicant's discovery. While Opposer's response sets forth many meritless arguments, Opposer admits it redacted the information from the produced alleged invoices (Document # 269-293) and takes the position that it is entitled to do so. Applicant has good cause to believe these alleged invoices produced at this late date may not be genuine, and Applicant needs the redacted information to authenticate these documents.

While the TTAB rules generally provide that customer names need not be disclosed there are exceptions, and this situation is that exception. Specifically, the Trademark Manual of Board Procedure Section 414 interprets Rule 37 CFR 2.120(a)(3) as permitting discovery as to the name of the first customer for a party's involved goods or services sold under its involved mark, and, if there is a question of abandonment, the names of a minimal number of customers for a period in question, may be discoverable under a protective order.

Here, as Applicant made a point on pages 1 and 2 in its prior motion for sanctions dated January 19, 2018, Applicant made abandonment an issue in this opposition. Rule 37 CFR 2.120(a)(3) does not require that abandonment be pleaded as an affirmative defense or that a counterclaim be asserted in order to bring abandonment into question in this case. From the outset of this opposition, Applicant has attempted through discovery to obtain evidence concerning Opposer's first use of its alleged MiVu trademark as well as its bona fide use in commerce before making a motion to amend the pleadings to allege abandonment as a counterclaim. Indeed, the Board acknowledged same in its Order dated June 1, 2018 on page 5 concerning Opposer's discovery responses concerning its first use of its mark as being insufficient and deficient and that Opposer's bona fide use of the mark in commerce was an issue put forth in this opposition as acknowledged by the Board in footnote 8 on page 7 of the Order.

Since Opposer has now produced invoices which appear to show a bona fide use of its mark in commerce, Applicant is entitled to obtain a minimal number of customers to determine whether these invoices are genuine in order to authenticate these documents. Given Opposer's history of sanctioned conduct in this opposition, Applicant believes it is entitled to this discovery, and Applicant attempted to resolve this issue with Opposer prior to filing this motion without success. Therefore, Applicant has proceeded in good faith while Opposer has refused to cooperate which required this motion.

Applicant, in part, bases its belief that Opposer has abandoned its mark on the facts that Opposer has not produced any products that bear Opposer's mark, nor has Opposer produced any documents showing the creation or production of Opposer's MiVu products. This factual record calls into question whether Opposer has ever made a bona fide use of the MiVu mark in commerce.

In addition, Opposer makes the following meritless arguments in its response which can be summarily disregarded:

1. The Board has already sanctioned Opposer so it cannot again, and that Applicant is proposing a "Double-Sanction Theory".
2. Applicant can authenticate Opposer's alleged produced invoices by using a Request for Admissions to authenticate.
3. Applicant is bringing this motion to avoid trial.
4. The Board is biased in Applicant's favor.
5. Applicant's motion is without merit because Applicant produced its invoices in redacted form.
6. The Board never scheduled a time for Opposer to supplement its answers so if Applicant has an issue with Opposer supplementing is discovery responses at this time then Applicant should have discussed this with Opposer and the parties could have agreed to an extension of discovery.
7. Applicant is not being prejudiced by this supplemental response.
8. Opposer argues there has never been an issue that Opposer has used its mark in commerce and indeed had sales. (Opposer's response page 5).
9. Opposer previously provided customer names and customers' identity is readily available to the general public. (Opposer's response page 9).

All of these above arguments are without merit on their face. Clearly, Applicant under these circumstances, in which it is seeking evidence of first use of Opposer's mark and evidence that Opposer has made a bona fide use in commerce of its mark, is entitled to Opposer's produced invoices (Document #269-293) without redaction and pursuant to a protective order.

Thus, it is again respectfully requested that either the extension be granted or sanctions in the form of dismissal be issued.

Respectfully submitted,

Date: June 18, 2018

JULIE B. SEYLER
NED BRANTHOVER

ABELMAN FRAYNE & SCHWAB
666 Third Avenue
New York, New York 10017
212-949-9022

Attorneys for Applicant

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing was served by email this 27th day of June, 2018 on Padraic Cyril Mc Freen at the following:

padraic.mcfreen@gmail.com
pmcfreen@gmail.com

Julie Seyler