

ESTTA Tracking number: **ESTTA851983**

Filing date: **10/13/2017**

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

Proceeding	91230403
Party	Plaintiff Securrency, Inc.
Correspondence Address	KEVIN J KEENER KEENER AND ASSOCIATES PC 161 N CLARK ST STE 4700 CHICAGO, IL 60601 UNITED STATES Email: kevin.keener@keenerlegal.com, rishi.nair@keenerlegal.com
Submission	Motion to Compel Discovery or Disclosure
Filer's Name	Kevin Keener
Filer's email	kevin.keener@keenerlegal.com
Signature	/kevinkeener/
Date	10/13/2017
Attachments	Motion to Compel Initial Disclosures.pdf(334350 bytes)

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

In the matter of:

Trademark Application Serial No. 86/904,230

Filing Date: February 10, 2016

Mark: SECURENCY

)	
Securrency, Inc.)	
)	
)	
Opposer,)	
)	
v.)	Opposition No. 91230403
)	
Luigi Boschin)	
)	
Applicant.)	
)	

MOTION TO COMPEL INITIAL DISCLOSURES

NOW COMES the Opposer, Securrency, Inc., and moves the Board for an Order granting Opposer default judgment, or in the alternative, an Order compelling Applicant to provide the required initial disclosures.

The Parties agreed to serve initial disclosures on each other by August 30, 2017 as part of an agreement to extend the timeline of the proceeding. See Exhibit A. Opposer served disclosures on Applicant on August 31, 2017. See Exhibit B. Applicant to date has failed to make disclosure that was due on or before the agreed upon date. Counsel for Opposer has attempted to resolve the matter with counsel for Applicant and has emailed counsel for Applicant on separate occasions to both his professional email and personal email. See Exhibit C. To date, Applicant has not yet delivered initial disclosures to Opposer.

The new rules provide for the imposition of sanctions for such behavior in front of the TTAB. 37 CFR §2.120(g). Specifically, Trademark Rule 2.120(g)(1) provides, in pertinent part (emphasis added): If a party fails to participate in the required discovery conference, **or if a party fails to comply with an order of the Trademark Trial and Appeal Board relating to disclosure or discovery**, including a protective order, the Board may make any appropriate order, including those provided in Rule 37(b)(2) of the Federal Rules of Civil Procedure.

Trademark Rule 2.120(g)(2), which sets forth additional provisions discussing the possible imposition of sanctions for failure to make initial disclosures, states, in pertinent part (emphasis added): **If a party fails to make required initial disclosures** or expert testimony disclosure, **and such party or the party's attorney** or other authorized representative **informs the party or parties entitled to receive disclosures that required disclosures will not be made**, the Board may make any appropriate order, as specified in paragraph (g)(1) of this section.

Applicant agreed to a specific date to deliver initial disclosures with Opposer. Applicant's failure to comply with the date agreed upon by the Parties means that Applicant has willfully failed to respond. No date or further information about when to expect the disclosures is forthcoming. Therefore, it is clear that Applicant is "gaming" the system for which the appropriate sanction is dismissal with prejudice.

Opposer, faced with Applicant's bad faith and willful refusal of its disclosure obligations, is caused prejudice by needing to speculate about Applicant's evidence and witnesses, and rendering Opposer unable to formulate an adequate discovery plan. As such, at minimum the Board should order that the Applicant is compelled to provide proper initial disclosures by a

certain date and, if the Board agrees that Trademark Rule 2.120(g)(2) is triggered, issue sanctions, per its discretion, against Applicant.

WHEREFORE, Opposer prays that the Board, pursuant to 37 CFR § 120(g)(1) and Fed. R. Civ. P. 37 (b)(2)(C) compel Applicant to provide disclosures, or, in the alternative, pursuant to Trademark Rule 2.120(g)(2), grant Opposer a default judgment against Applicant for willful and continuing failure to comply with the rules governing disclosure.

Date: October 13, 2017

Respectfully Submitted,



Kevin J. Keener
Rishi Nair
KEENER & ASSOCIATES, P.C.
161 N. Clark Street, Suite 1600
Chicago, IL 60601
Telephone: (312) 523-2164
rishi.nair@keenerlegal.com
kevin.keener@keenerlegal.com
Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a copy of the forgoing Motion to Compel Initial Disclosures was served upon Applicant by email, per agreement, on October 13, 2017 at the following email addresses:

Bruno Tarabichi
Owens Tarabichi, LLC
4750 Almaden Expressway 124-359
San Jose, CA 95118
btarabichi@owenstarabichi.com

By: /Kevin J. Keener /
Kevin J. Keener
Keener and Associates, P.C.
161 N. Clark Street, #1600
Chicago, IL 60601
(312) 523-2164
Attorney for Opposer



Kevin Keener <kevin.keener@keenerlegal.com>

Securrency TTAB

9 messages

Kevin Keener <kevin.keener@keenerlegal.com>
To: Bruno Tarabichi <btarabichi@owenstarabichi.com>

Wed, Jul 12, 2017 at 10:24 AM

Hi Bruno,

After getting the Board's order it appears that we are both almost two months behind in providing our initial disclosures (due May 30th under current schedule). Would you consent to a two month extension of time so that we can put the initial disclosures due on July 30th and take the rest of the schedule from there? If you do then let me know and I can file it.

Thanks
Kevin

--
Kevin Keener
Keener and Associates, P.C.
161 North Clark Street
Suite 1600
Chicago, IL 60601
Office: [312-523-2164](tel:312-523-2164)
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Bruno Tarabichi <btarabichi@owenstarabichi.com>
To: Kevin Keener <kevin.keener@keenerlegal.com>

Tue, Jul 18, 2017 at 11:38 AM

Hi Kevin,

I am OK with an extension. But I think we should make it three months for two reasons: (1) that way the discovery conference deadline won't be in the past, and (2) I will be on vacation from 8/31 - 9/17. As a professional courtesy, I'd appreciate it if you could refrain from scheduling discovery responses or other deadlines during the period when I will be away (I can also agree to 4 months if you prefer that). Does 3 or 4 months work?

Best,

Bruno Tarabichi | Partner
owens tarabichi llp | Counselors At Law
4750 Almaden Expressway 124-359 | San Jose, CA 95118
[408.298.8204](tel:408.298.8204) (direct) | [408.521.2203](tel:408.521.2203) (fax)
www.owenstarabichi.com

[Quoted text hidden]

Kevin Keener <kevin.keener@keenerlegal.com>
To: Bruno Tarabichi <btarabichi@owenstarabichi.com>

Tue, Jul 18, 2017 at 2:29 PM

Good point. I forgot about the discovery conference. Let's do 3 months as it is a simple radial button selection for extending time. Just email back confirmation and I will file it.

I won't submit any discovery requests that would be pending during your vacation time.

Kevin

[Quoted text hidden]

Bruno Tarabichi <btarabichi@owenstarabichi.com>
To: Kevin Keener <kevin.keener@keenerlegal.com>

Tue, Jul 18, 2017 at 2:36 PM

Confirmed.

Best,

Bruno Tarabichi | Partner
owens tarabichi llp | Counselors At Law
4750 Almaden Expressway 124-359 | San Jose, CA 95118
408.298.8204 (direct) | 408.521.2203 (fax)
www.owenstarabichi.com

[Quoted text hidden]

Kevin Keener <kevin.keener@keenerlegal.com>
To: Bruno Tarabichi <btarabichi@owenstarabichi.com>

Wed, Aug 9, 2017 at 4:37 PM

Hi Bruno,

Just left you a VM. Wanted to check the discovery conference off of the list with a 5 min call. Call me back at [773-562-5902](tel:773-562-5902) or email me some times that work for you in the next couple of days.

Kevin

[Quoted text hidden]

Bruno Tarabichi <btarabichi@owenstarabichi.com>
To: Kevin Keener <kevin.keener@keenerlegal.com>

Wed, Aug 9, 2017 at 8:55 PM

Hi Kevin -

Any chance we could talk on Monday after 10am Pacific?

Best,

Bruno Tarabichi | Partner
owens tarabichi llp | Counselors At Law
4750 Almaden Expressway 124-359 | San Jose, CA 95118
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[Quoted text hidden]

Kevin Keener <kevin.keener@keenerlegal.com>
To: Bruno Tarabichi <btarabichi@owenstarabichi.com>

Thu, Aug 10, 2017 at 3:47 PM

That works for me. I'll give you a call then.

[Quoted text hidden]

Bruno Tarabichi <btarabichi@owenstarabichi.com>
To: Kevin Keener <kevin.keener@keenerlegal.com>

Thu, Aug 10, 2017 at 6:42 PM

10/13/2017

Keener and Associates, P.C. Mail - Securrency TTAB

Just so we are on the same page - are you saying at 10am? If not, what time works for you?

Best,

Bruno Tarabichi | Partner
owens tarabichi llp | Counselors At Law
4750 Almaden Expressway 124-359 | San Jose, CA 95118
[408.298.8204](tel:408.298.8204) (direct) | [408.521.2203](tel:408.521.2203) (fax)
www.owenstarabichi.com

[Quoted text hidden]

Kevin Keener <kevin.keener@keenerlegal.com>
To: Bruno Tarabichi <btarabichi@owenstarabichi.com>

Fri, Aug 11, 2017 at 11:06 AM

That time works for me (10am). If you need a different time I'm open.

[Quoted text hidden]



Kevin Keener <kevin.keener@keenerlegal.com>

Securrency Inc Initial Disclosures

Kevin Keener <kevin.keener@keenerlegal.com>
To: Bruno Tarabichi <btarabichi@owenstarabichi.com>

Thu, Aug 31, 2017 at 2:12 PM

Attached please find the initial disclosures of Securrency Inc.

--

Kevin Keener
Keener and Associates, P.C.
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Chicago, IL 60601
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 **Initial Disclosures Securrency.pdf**
36K



Kevin Keener <kevin.keener@keenerlegal.com>

Initial disclosures- Securrency

3 messages

Kevin Keener <kevin.keener@keenerlegal.com>
To: Bruno Tarabichi <btarabichi@owenstarabichi.com>

Mon, Sep 25, 2017 at 11:17 AM

Hi Bruno,

I hope you had a good trip overseas. I never received the initial disclosures from your end and they are now over three weeks due from the agreed upon date. Please let me know if and when I can expect the initial disclosures.

Thank you
Kevin

--
Kevin Keener
Keener and Associates, P.C.
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Suite 1600
Chicago, IL 60601
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Cell: [773-562-5902](tel:773-562-5902)
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Kevin Keener <kevin.keener@keenerlegal.com>
To: Bruno Tarabichi <btarabichi@owenstarabichi.com>

Fri, Sep 29, 2017 at 8:49 AM

Hi Bruno,

I want to check in again about receiving your initial disclosures. Please let me know if and when you will send them. Feel free to call me with any issues you may have with getting them out. Please consider this as my attempt to meet and confer. If I do not have the initial disclosures by Wed. October 4th then I will have to file a motion to compel.

Thank you
Kevin
[Quoted text hidden]

Kevin Keener <kevin.keener@keenerlegal.com>
To: Bruno Tarabichi <btarabichi@gmail.com>

Fri, Sep 29, 2017 at 8:56 AM

Hi Bruno,

I'm sending this to your other email as well. I believe that you are back from your trip to Italy? I don't want to file a motion while you are gone as we agreed. Please let me know.

Kevin
[Quoted text hidden]