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

Proceeding	91239589
Party	Plaintiff Maker's Mark Distillery, Inc.
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Date	02/28/2019
Attachments	Opp Reply ISO 56d Motion Opp 91239589.pdf(412027 bytes ) Exhibit A Supp. Assmus Dec. with Exhibit.pdf(233258 bytes )

**UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

MAKER'S MARK DISTILLERY, INC.,

Opposer,

v.

BOWMAKER'S WHISKEY COMPANY,

Applicant.

Opposition No. 91239589

Serial No. 87,383,989

Mark: BOWMAKER'S WHISKEY

**OPPOSER'S REPLY IN SUPPORT OF ITS RULE 56(D) MOTION**

Opposer Maker's Mark Distillery, Inc. ("Opposer") submits this reply in support of its Rule 56(d) motion for additional discovery (12 TTABVUE) (the "56(d) Motion"). Nearly half of Applicant Bowmaker's Whiskey Company's ("Applicant") opposition (13 TTABVUE) is devoted to rehashing Applicant's selective and self-serving account of the history of this opposition. The rest consists of conclusory statements alleging that the 56(d) Motion is deficient and that Opposer has not been diligent in pursuing discovery. To the contrary, it is the Applicant who has failed to respond to discovery relating to the very issues that are the subject of Applicant's pending summary judgment motion – or any discovery at all. Applicant's overt gamesmanship should not be rewarded. Accordingly, for the reasons set forth below and in Opposer's opening brief in support of the 56(d) Motion, Opposer respectfully requests that the Board grant Opposer the relief sought and allow Opposer the opportunity to take additional discovery.

**I. APPLICANT'S RECITATION OF THE HISTORY OF THE CASE IS SELECTIVE AND OMITTS CRITICAL FACTS SHOWING THAT APPLICANT HAS PURPOSELY EVADED ITS DISCOVERY OBLIGATIONS.**

Although Applicant devotes nearly five pages of its opposition to the 56(d) Motion to its account of the parties' conduct throughout these proceedings, Applicant's self-serving recitation of the facts conveniently omits what transpired during the critical two month period immediately preceding Applicant's filing of a motion for summary judgment in this case. Between October 16, 2018 and December 21, 2018, Applicant sat on a settlement proposal, all the while assuring Opposer that it was considering the proposal. Applicant now states that it considered the parties to be at an impasse (Opp. Br. at 7, ¶ 32). However, for weeks, Applicant let on that it was considering the October 16 settlement proposal as well as an extension of the general discovery period on consent, which Opposer suggested in view of Applicant's need for additional time to respond to the proposal. *See* Declaration of Richard Assmus in support of Opposer's 56(d) Motion ("Assmus Declaration") at ¶¶ 4-6; 11.

Applicant's contention that Opposer "has not been serious in any of its settlement discussions" (Opp. Br. at 11) is belied by the numerous concessions Opposer has made in order to settle this dispute amicably while protecting its valuable trademarks. While Applicant claims the October settlement proposal referenced in the Assmus Declaration contained provisions previously rejected by Applicant, it does not cite them with any specificity. Opposer's demands are reasonable and straightforward. Opposer requests that Applicant (i) cease using and seeking to register the term BOWMAKER'S in the possessive form by eliminating the "'S" in the "BOWMAKER'S" portion of the company name and mark, (ii) change the "A" in "BOWMAKER" to a bowman image (with an accommodation made when use of the logo would be impracticable), (iii) amend its identification of goods to recite only "distilled spirits", and (iv) refrain from future use of the amended mark in red type font or in connection with wax or wax

drippings, as Opposer's prominent use of a red wax seal is an iconic feature of the Maker's Mark trade dress. The requested changes require no significant alterations to Applicant's business plans and Opposer has even offered to pay certain specified out-of-pocket expenses in connection with Applicant making the changes, so long as they are well-documented.

Applicant's recitation of the history of the case also omits the fact that, while Opposer responded to Applicant's discovery requests, Applicant never responded to Opposer's timely served requests. As noted at pages 6-9 of Opposer's brief in support of the 56(d) Motion, Opposer's unanswered requests included at least three interrogatories, two requests for admission, and seven requests for production directed to the sole issue Applicant asks the Board to decide in connection with its motion for summary judgment, namely, the similarity between the two marks at issue.

## **II. OPPOSER CONDUCTED DISCOVERY CONCURRENTLY WITH PURSUING SETTLEMENT AND IT IS APPLICANT WHO HAS IGNORED ITS DISCOVERY OBLIGATIONS.**

Applicant argues it should not be required to incur "the substantial expense of responding to Opposer's discovery" (Opp. Br. at 11). However, as Applicant itself points out, "it is common in any litigation to concurrently pursue discovery and consider settlement" (Opp. Br. at 11). In fact, that is what the rules require. Applicant acknowledges that Opposer responded to Applicant's discovery requests (Opp. Br. at 7). Opposer also served its own offensive discovery requests concurrently with seeking an extension of the schedule due to Applicant's delay in providing comments on a draft settlement agreement. (Assmus Declaration ¶ 6, Exhibit 1.) However, Applicant fails to address why it never (i) sought to meet and confer with Opposer on open discovery issues after Opposer served its responses to Applicant's discovery, and (ii) never responded to Opposer's discovery requests prior to service of the summary judgment motion.

As noted in Opposer's opening brief, "the parties must be afforded adequate time for

general discovery before being required to respond to a motion for summary judgment.” *Metro. Life Ins. Co. v. Bancorp Servs., LLC*, 527 F.3d 1330, 1336 (Fed. Cir. 2008). Responding to an opposing party’s discovery requests is not an onerous and burdensome task. Rather, it is a necessary mechanism by which facts relevant to the merits of a case are established. Applicant’s characterization of complying with its most basic discovery obligations as unduly burdensome rings hollow and is fundamentally at odds with the tenets of the Federal Rules and TTAB practice. *See, e.g. Panda Travel Inc. v Resort Option Enterprises, Inc.*, 94 USPQ2d 1789, 1791 (TTAB 2009) (“Each party has a duty to make a good faith effort to satisfy the reasonable and appropriate discovery needs of its adversary.”) Applicant’s argument that Opposer was not diligent in pursuing discovery before the summary judgment motion was filed should be rejected; this argument is merely an effort to mask Applicant’s bad faith in (i) misleading Opposer as to Applicant’s consideration of a settlement proposal and schedule extension, (ii) deliberately running down the clock on the discovery period in order to file a summary judgment motion prior to furnishing *any* discovery to Opposer, and (iii) ignoring Opposer’s repeated efforts to solicit Applicant’s position on the proposed settlement and proposed extension, as detailed in the Assmus Declaration.

**III. OPPOSER’S 56(D) MOTION AND SUPPORTING DECLARATION SET OUT WITH SPECIFICITY THE ESSENTIAL FACTS NECESSARY FOR OPPOSER TO EFFECTIVELY OPPOSE APPLICANT’S SUMMARY JUDGMENT MOTION.**

Applicant argues that Opposer’s 56(d) Motion is “fatally deficient” without offering concrete reasons why Opposer’s reasoning is flawed. Applicant repeatedly states that the Assmus Declaration does not provide “specific” reasons why Opposer cannot present facts “essential” to justify its opposition. However, the 56(d) Motion and Assmus Declaration are replete with specific examples of discovery on the issue of the similarity of the parties’

respective marks that is necessary in order to effectively rebut the arguments in Applicants' pending summary judgment motion.

The Assmus Declaration attaches unanswered discovery requests that include: (i) Interrogatory ("ROG") Nos. 9, 13 and 14, (ii) Requests for Admission ("RFA") Nos. 5 and 6, and (iii) Requests for Production ("RFP") Nos. 1 and 5-10. ROG 9 and RFP 9 solicit facts and documents relating to any known instances of actual or possible confusion. ROG 13 solicits facts in support of Applicant's contention that the marks at issue are not similar in sight, sound, connotation, and overall meaning. ROG 14 and RFAs 5 and 6 solicit facts and admissions relating to the parties' respective uses of the identical term "MAKER'S" and of the term "Maker" in the possessive form. RFPs 5, 6 and 10 solicit documents relating to the selection and adoption of Applicant's mark, any other marks considered by the Applicant in making that selection, and any studies conducted or documents in Applicant's possession that relate to the parties' respective marks and goods. RFPs 1, 7 and 8 solicit documents relating to the Applicant's planned use of its mark, including labels, brochures, marketing, and other promotional materials depicting Applicant's intended use of its mark. *See* Assmus Declaration Exhibits 3-5. All of the foregoing open discovery requests relate to the similarity of the marks in question, which is the subject of the summary judgment motion. Opposer will be prejudiced if not given the opportunity to cite Applicant's responses to these requests in its opposition to the summary judgment motion.<sup>1</sup>

Applicant also argues that Opposer need not depose Bryan Parks, an individual who was

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<sup>1</sup> To the extent there is any doubt as to whether the sworn Assmus Declaration in support of Opposer's 56(d) Motion sufficiently states the specific reasons why this additional discovery is essential in order for Opposer to respond to Applicant's summary judgment motion, the Supplemental Declaration of Richard M. Assmus attached hereto as Exhibit A (the "Supplemental Assmus Declaration") at ¶¶ 9-10 provides these reasons in another signed filing.

identified in Applicant's Initial Disclosures<sup>2</sup> as a witness with information in support of "all claims and rebuttals" on behalf of Applicant and who submitted a declaration in support of Applicant's motion for summary judgment (the "Parks Declaration"). In making this argument, Applicant claims that none of Mr. Parks' testimony is "controversial" or "goes to the issue of the dissimilarity of the trademarks BOWMAKER'S WHISKEY and the MAKER'S MARK trademarks" (Opp. Br. at 3). However, the Parks Declaration includes a discussion of the meaning and connotation ascribed to the term "bowmaker," an argument central to Applicant's summary judgment motion. It also attaches samples of labels depicting how Applicant intends to use its mark on its goods. These exhibits are relevant to Applicant's argument that the marks at issue appear different. As noted in Opposer's opening brief, Opposer requests that it be afforded the opportunity to depose Mr. Parks on the topics raised in his declaration, including the meaning of the term "BOWMAKER'S," Mr. Park's alleged intent in selecting Applicant's mark, and the sample uses of Applicant's mark shown on the labels attached to the declaration, including their font, type size, color, imagery, and other characteristics. Opposer will be disadvantaged if it is not allowed to take the deposition of Mr. Parks. Regardless whether Opposer was previously informed that Applicant claims its mark was chosen "based on Mr. Parks' hobby of being a bowmaker" (Opp. Br. at Exhibit 1) Opposer has heretofore been unable to test the statements made by Mr. Parks through discovery and Applicant relies on these statements to support its Summary Judgment Motion. *See* Supplemental Assmus Declaration at ¶¶ 5-8.

#### **IV. OPPOSER'S 56(D) MOTION DOES NOT IMPROPERLY ARGUE THE SUBSTANCE OF APPLICANT'S SUMMARY JUDGMENT MOTION.**

The parties agree that the substance of Applicant's summary judgment motion boils down to the degree of similarity between the parties' respective marks. (Opening Br. at 4; Opp. Br. at

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<sup>2</sup> Applicant's Initial Disclosures are attached hereto as Exhibit 1 to the Supplemental Assmus

11.) Opposer's 56(d) Motion requests that the Board extend the general discovery period so that the parties may develop all facts relevant to establishing likelihood of confusion, consistent with the relief sought in Opposer's pending Motion to Extend the Schedule (8 TTABVUE). In the alternative, Opposer seeks the opportunity to take specific additional discovery in order to effectively respond to the issue presented in the summary judgment motion. At no point does Opposer present arguments to rebut Applicant's contention that the parties' respective marks are purportedly dissimilar in sight, sound, and meaning. The only discussion given to the similarity of the marks at issue appears in Section II.C, where specific additional discovery essential to Opposer's opposition of the summary judgment motion is outlined in detail, as is required under Fed. R. Civ. P. 56(d). The 56(d) Motion is devoid of any substantive argument as to the relative similarity of the marks at issue and instead details the narrow facts needed in order to form a substantive response to Applicant's claim that the marks are sufficiently dissimilar to dispel any likelihood of confusion. Accordingly, Applicant's argument that Opposer does not need additional discovery to justify its opposition because the 56(d) Motion sets forth substantive argument why Applicant's summary judgment motion should be denied misses the mark.

## **V. CONCLUSION**

In its summary judgment motion, Applicant asks the Board to determine as a matter of law that there is no likelihood of confusion between the parties' respective marks because of their purported dissimilarity. As noted above and in Opposer's opening brief in support of the 56(d) Motion, Applicant misled Opposer into believing that it was considering a settlement proposal and extension of the discovery schedule, all the while failing to provide any discovery on the topic of its forthcoming summary judgment motion or any other issue. This is true despite Opposer's timely service of numerous requests relevant to establishing the similarity between the

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Declaration.



marks at issue. In addition, Applicant relies on the sworn declaration of a witness who Opposer has not yet had an opportunity to depose in support of its motion. Opposer respectfully maintains its request that Applicant's summary judgment motion be denied and general discovery be extended for a period of ninety days, consistent with Opposer's pending motion for an extension of the schedule (8 TTABVUE). Opposer also maintains its alternative request that the Board enter an order requiring Applicant to (i) fully respond to Opposer's Interrogatory Nos. 9, 13 and 14, Requests for Admission Nos. 5 and 6, and Requests for Production Nos. 1 and 5-10 (including producing all responsive documents), and (ii) make Mr. Bryan Parks available for a deposition. Opposer submits that this specific discovery is necessary in order for Opposer to respond to the summary judgment motion and requests the relief sought in accordance with Fed. R. Civ. P. 56(d).

Respectfully submitted,

MAKER'S MARK DISTILLERY, INC.

Dated: February 28, 2019

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*Attorneys for Opposer*

**CERTIFICATE OF SERVICE**

I certify that, on February 28, 2019, I caused a copy of the foregoing **REPLY IN SUPPORT OF RULE 56(D) MOTION** to be served upon Bowmaker's Whiskey Company by e-mail at the following addresses:

[tbreiner@bbpatlaw.com](mailto:tbreiner@bbpatlaw.com), [elisedelatorre@bbpatlaw.com](mailto:elisedelatorre@bbpatlaw.com), [docketclerk@bbpatlaw.com](mailto:docketclerk@bbpatlaw.com)

With courtesy copies sent by USPS Express mail to Bowmaker's Whiskey Company at the following address:

Theodore A. Breiner  
Breiner & Breiner LLC  
115 North Henry Street  
Alexandria, VA 22314

Dated: February 28, 2019

/s/ Richard M. Assmus  
Richard Assmus  
Attorney for Opposer  
Maker's Mark Distillery, Inc.

# **EXHIBIT A**

**UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

MAKER'S MARK DISTILLERY, INC.,

Opposer,

v.

BOWMAKER'S WHISKEY COMPANY,

Applicant.

Opposition No. 91239589

Serial No. 87,383,989

Mark: BOWMAKER'S WHISKEY

**SUPPLEMENTAL DECLARATION OF RICHARD M. ASSMUS**

I, Richard M. Assmus, hereby declare as follows:

1. I am a partner at the law firm Mayer Brown LLP, which represents Opposer Maker's Mark Distillery Inc. ("Opposer") in the above-captioned proceeding.

2. I submit this Supplemental Declaration in support of Opposer's Rule 56(d) Motion for Additional Discovery in Response to Applicant's Motion for Summary Judgment of No Confusion.

3. The facts set forth in this Declaration are personally known to me. If called as a witness, I could and would competently testify to the facts stated herein.

4. Attached hereto as Exhibit 1 is a true and accurate copy of Applicant's Initial Disclosures dated July 30, 2018.

5. In its Initial Disclosures at Exhibit 1, Applicant names Bryan Parks as a witness with information in support of “all claims and rebuttals” on behalf of Applicant in this proceeding.

6. In support of its pending summary judgment motion, Applicant submits a declaration from Bryan Parks, the same individual referenced in paragraph 5 above (the “Parks Declaration”). However, Opposer has not had an opportunity to test the statements made in the Parks Declaration through discovery.

7. Opposer will be disadvantaged if it is not allowed to take the deposition of Mr. Parks prior to responding to the pending summary judgment motion, as Applicant relies on statements made in the Parks Declaration to support its summary judgment motion.

8. If granted the opportunity to depose Mr. Parks, Opposer would seek, inter-alia, his testimony on the following topics: the meaning of the term “BOWMAKER’S,” Mr. Park’s alleged intent in selecting the contested BOWMAKER’S WHISKEY mark, and the sample uses of the contested mark shown on the labels attached to the Parks Declaration, including their font, type size, color, imagery, and other characteristics.


9. Opposer will similarly be disadvantaged if it does not have the benefit of Applicant’s responses to unanswered Interrogatory Nos. 9, 13 and 14, Requests for Admission Nos. 5 and 6 at Exhibit 4 hereto, and Requests for Production Nos. 1 and 5-10, which were served on November 26, 2018, prior to responding to the pending summary judgment motion.

10. The interrogatories and requests enumerated in paragraph 9 above all relate or potentially relate to one or more of the following factors that inform the degree of similarity between the parties’ marks: the appearance of the marks at issue, the letters and components the marks share

in common, the commercial impression created or intended to be created by the marks, and any actual or perceived similarities between the marks known to Applicant. These factors are at the heart of Applicant's Summary Judgment Motion.

I declare under penalty of perjury that the foregoing is true and correct.

Dated: February 28, 2019

  
Richard M. Assmus

# **EXHIBIT 1**

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

MAKER'S MARK DISTILLERY, INC.,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. 91239589
	)	
	)	
	)	Serial No. 87/383,989
BOWMAKER'S WHISKEY COMPANY,	)	Mark: BOWMAKER'S WHISKEY
	)	
Applicant.	)	

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APPLICANT'S RULE 26(a) INITIAL DISCLOSURES

Pursuant to Rule 26(a) of the Federal Rules Of Civil Procedure as adopted by 37 CFR § 2.120, applicant Bowmaker's Whiskey Company hereby makes the following initial disclosures:

I. INDIVIDUALS LIKELY TO HAVE DISCOVERABLE INFORMATION THAT APPLICANT MAY USE TO SUPPORT APPLICANT'S CLAIMS OR DEFENSES

The following individuals are likely to have discoverable information that applicant may use in support of applicant's defenses to opposer's notice of opposition.

1. As to all claims and rebuttals -

Bryan Parks  
BOWMAKER'S WHISKEY COMPANY  
10390 South 2nd Street  
Schoolcraft, Michigan 49087



Applicant cannot further fully identify those individuals who may have discoverable information that applicant may use to support applicant's claims or defenses until such time as the factual basis of opposer's allegations in the opposition are more precisely defined.

II. DOCUMENTS IN THE POSSESSION OF APPLICANT THAT APPLICANT MAY USE TO SUPPORT APPLICANT'S CLAIMS AND DEFENSES

The documents in applicant's possession that applicant may use to support applicant's defenses to the opposition include:

(1) Documents and things showing applicant's intended use of the BOWMAKER'S WHISKEY trademark;

(2) Documents and things that pertain to applicant's position that there is no likelihood of confusion between applicant's BOWMAKER'S WHISKEY trademark and the trademarks pleaded by opposer;

(3) Documents and things that pertain to applicant's position that applicant is entitled to registration of the BOWMAKER'S WHISKEY trademark in the United States; and

(4) Documents and things relating to third party use of trademarks using the wording "Makers," "Maker" or "Mark" or similar names evidencing the proper scope of protection to be accorded opposer's pleaded trademarks.

These documents are located at applicant's offices in Michigan or at the offices of applicant's counsel.

Applicant cannot further fully identify those documents that applicant may use to support applicant's defenses to the notice of opposition until such time as the factual basis of opposer's allegations in the opposition are more precisely defined.

III. A COMPUTATION OF DAMAGES CLAIMED BY APPLICANT

Not applicable.

IV. INSURANCE POLICIES

Not applicable.

Respectfully submitted,

BOWMAKER'S WHISKEY COMPANY

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July 30, 2018

Attorneys for Applicant

CERTIFICATE OF SERVICE

It is hereby certified that on this 30th day of July,  
2018, a true copy of the foregoing paper entitled-

APPLICANT's RULE 26(a) INITIAL DISCLOSURES

was served by email on -

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/s/Theodore A. Breiner  
THEODORE A. BREINER