

ESTTA Tracking number: **ESTTA1045600**

Filing date: **03/29/2020**

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

Proceeding	91242236
Party	Plaintiff PBH Marketing, Inc.
Correspondence Address	KAREN B TRIPP 4265 SAN FELIPE STE 1100 HOUSTON, TX 77027 UNITED STATES tripp.karen@gmail.com, ktripp@tripplaw.com, docket@tripplaw.com 713-658-9323
Submission	Motion for Discovery Sanctions
Filer's Name	Karen B. Tripp
Filer's email	tripp.karen@gmail.com, ktripp@tripplaw.com, docket@tripplaw.com
Signature	/s/karen tripp/
Date	03/29/2020
Attachments	PBH Motion for Sanctions FINAL1.pdf(141900 bytes) EXHIBIT A to Motion for Sanctions 3-28-20.pdf(49178 bytes) Exhibit B to Mot for Sanctions 3-28-20.pdf(54974 bytes) EXHIBIT C to Motion for Sanctions 3-28-20.pdf(61300 bytes) Exhibit D PBH First Set of Doc Requests to Brown FINAL.pdf(232226 bytes) Declaration of Karen Tripp 3-29-20 final.pdf(848351 bytes)

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

In the matter of Application Serial No. 87782744

Filed on February 2, 2018

For the Mark **Paul Brown Hawaii**

Published in the *Official Gazette* on June 26, 2018

PBH Marketing, Inc.	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No. 91242236
	:	
Paul L. Brown,	:	
	:	
Applicant	:	
	:	

**OPPOSER PBH MARKETING, INC.’S MOTION FOR SANCTIONS
AGAINST APPLICANT PAUL L. BROWN**

Opposer, PBH Marketing, Inc. (“PBH” or “Opposer”), by and through its attorney, pursuant to TBMP § 527.01(b) and 37 C.F.R. § 2.120(h)(2), seeks sanctions against Applicant for failure to respond to Opposer’s first set of requests to Applicant for production of documents and things.

BACKGROUND

Applicant was previously a founder and owner of Opposer, and Applicant’s salons continued buying PAUL BROWN HAWAII hair care products from Opposer after Applicant’s sale of his interest in Opposer until about the time Applicant filed the trademark application that is the subject of this opposition proceeding. Applicant gave permission for Opposer to sell PAUL BROWN HAWAII hair care products and to register a trademark for PAUL BROWN

HAWAII hair care products about the time of Opposer's founding well over a decade ago. Opposer has used the mark in this manner ever since.

Under these circumstances, the discovery needed by Opposer in this proceeding was to understand Applicant's positions taken in his answer to the opposition.

Opposer originally sought clarity in Applicant's answer itself, and Applicant ultimately filed two amended answers following Opposer's motion to strike and sending Applicant's counsel a Rule 11 notice. Applicant also answered Opposer's amended notice of opposition.

Applicant's initial disclosures were largely "pro forma," and did not include any documents. Opposer provided an extensive first set of document requests to Applicant on September 2, 2019, largely aimed at understanding Applicant's positions in this opposition. A copy of the document requests is attached as Exhibit D.

FACTS RELATED TO THE MOTION

Opposer served these document requests on Applicant on September 2, 2019. Two days before Applicant's responses were due, that is, on September 30, 2019, Applicant served a motion for summary judgment based on a procedural matter which Applicant had alluded to in an affirmative defense in its fourth answer filed on May 16, 2019. Undersigned counsel inquired of Applicant's counsel with respect to Applicant's responses to the outstanding document requests and Applicant's counsel confirmed they would wait until the Board ruled on their motion to yield discovery. Exhibit A.

The Trademark Trial and Appeal Board denied Applicant's summary judgment motion on February 20, 2019. That same day, undersigned counsel sent Applicant's counsel a reminder about Opposer's outstanding document requests. Exhibit B. Applicant's counsel did not respond and Opposer's counsel followed up with phone calls to Tracey Ohta and to Seth Reiss,

attorneys in the same law firm who both have appeared in this opposition on behalf of Applicant, leaving voice mails each time. Neither of Applicant's counsel returned the phone calls or replied to the February 20, 2020 email, until Opposer's undersigned counsel sent a follow-up email on February 26, 2020 stating that she also wanted to schedule the deposition of Applicant, as well as receive responses to Opposer's outstanding document requests. Exhibit C, p. 2.

Applicant's counsel Seth Reiss then replied on February 27, 2020 as follows:

Ms. Tripp:

Thank you for our [sic] email. Please direct your future communications about this matter to me and not to Ms. Ohta.

We do not currently have authority to respond to your requests. We will advise you once we do.

Seth M. Reiss
Of Counsel
Watanabe Ing LLP

Exhibit C, p. 1.

Another month has passed and undersigned counsel has not heard from Opposer's counsel. Discovery is now scheduled to close on March 28, 2020. Since that date falls on a Saturday, discovery is believed to officially close on March 30, 2020, the next business day.

APPLICABLE LAW

TBMP § 527.01(b) provides in pertinent part:

37 C.F.R. § 2.120 (h)(2) If a party, . . . fails to provide any response to . . . a set of requests for production of documents and things, and such party or the party's attorney or other authorized representative informs the party seeking discovery that no response will be made thereto, the Board may make any appropriate order, as specified in paragraph (h)(1) of this section.

The motion for sanctions under 37 C.F.R. § 2.120(h)(2) is available for discovery depositions, interrogatories, and requests for production of documents and things, and lies where the responding party has (1) failed to respond, and (2) has informed the party seeking discovery that no response will be made. . . .

The sanctions that may be entered by the Board include, inter alia, striking all or part of the pleadings of the disobedient party; refusing to allow the disobedient party to support or oppose designated claims or defenses; prohibiting the disobedient party from introducing designated matters in evidence; and entering judgment against the disobedient party. However, the Board will not hold any persons in contempt, or award any expenses, including attorney fees, to any party. *See* TBMP § 502.05.

ARGUMENT

Applicant filed the subject trademark application in bad faith, knowing at the time that Opposer had an ongoing business using the trademark Applicant was seeking to register, for the same goods. Applicant has resisted Opposer's efforts to obtain evidence and admissions of these facts in this proceeding, in an effort to bamboozle the Trademark Office, even though a likelihood of confusion in the marketplace as to the trademark in issue will result.

Opposer has not caused Applicant undue burden with discovery demands but has reasonably made a single request for documents to obtain an understanding of Applicant's positions and pleadings. Applicant first avoided candid answers to the notice of opposition, then Applicant failed to provide any responses whatsoever to the document requests. Applicant never denied receiving the requests, and the context of Applicant's counsel's response to Opposer's counsel's follow-up about the missing responses indicates that Applicant's counsel had received the document requests and indeed had not responded to them.

Applicant's counsel's final word to Opposer, that he did not "currently have authority to respond" to Opposer's requests and would advise when they did, with no such advice or any other explanation of any kind forthcoming even by the close of discovery, was effectively a door-slam in the face and blatant refusal to cooperate with discovery and this opposition proceeding. It was also in flagrant disregard of the rules of this Board.

Without the discovery that Opposer sought with the document requests, Opposer has essentially no more information about Applicant's claims and defenses than the minimal amount

provided in Applicant's answer to the complaint and Applicant's summary judgment motion directed to Applicant's first affirmative defense. Applicant's omissions and refusal to cooperate with discovery unfairly prejudices Opposer's ability to fully present its case for this Board's denying Applicant's trademark application. Applicant's failure to cooperate is intended to prevent Opposer from proving that it has superior rights to the trademark in issue, which Applicant's application describes as the same mark for essentially the same goods as Opposer's trademark and goods in commerce.

Given the pressure that Opposer originally had to place on Applicant--in a motion to strike his answer and under Rule 11 (presenting Applicant's counsel with an unfiled motion for Rule 11 sanctions)--that resulted in Applicant's amending his answer multiple times, there is no reason to assume that, given additional opportunities, Applicant will fulfill his obligation under the Federal and Trademark Rules and the Board's orders. Moreover, since discovery closed March 28, 2020, or at the latest will close March 30, 2020, any filing by Applicant of a late response to the document requests after receiving this motion would afford Opposer no time for follow-up questions about any deficiencies in Applicant's responses or for the deposition of Applicant that Opposer's counsel told Applicant's counsel Opposer wanted to schedule.

This Board has authority under the circumstances here to include entry of judgment against Applicant as a sanction for Applicant's refusal to cooperate in discovery. While judgment is a harsh remedy, it is justified where no less drastic remedy would be effective, and there is a strong showing of willful evasion, as at bar. See *SFM, LLC v. Corcamore, LLC*, 2018 WL 6929684 (TTAB 2018); *Cadbury UK Ltd v. Meenaxi Enterprise, Inc.*, 115 U.S.P.Q.2d 14014, 2015 WL 4763659 (TTAB 2015).

Alternatively as sanctions, the Board may strike all or part of Applicant's pleadings, refuse to allow Applicant to support or oppose designated claims or defenses; or prohibit Applicant from introducing designated matters in evidence. When considering what sanctions to impose, the Board may consider "(1) the willfulness of the non-compliant party or the reason for noncompliance; (2) the efficacy of lesser sanctions; (3) the prejudice of the other party; (4) the duration of the period of noncompliance; and (5) whether the non-compliant party has been warned of the consequence of his non-compliance." *Medical Quant USA, Inc. v. Radiant Life Technologies*, 2019 WL 1454332 (TTAB 2019), quoting *Handweker v. AT&T Corp.*, 211 F.R.D. 203, 208 (S.D.N.Y. 2002). At bar, these factors weigh in favor of the Board granting sanctions against Applicant as requested below.

RELIEF SOUGHT

Opposer requests this Board enter judgment against Applicant, grant Opposer's opposition, and dismiss Applicant's trademark application. Alternatively, Opposer requests this Board: (1) prohibit Applicant from relying at trial on any documents or information requested by Opposer in its first set of document requests; and (2) estop Applicant from denying: (a) that he gave permission to PBH Marketing, Inc. to use and register the trademark PAUL BROWN HAWAII for hair care products; (b) that PBH Marketing, Inc. has been using the trademark PAUL BROWN HAWAII in interstate commerce for over a decade; and (c) that the PAUL BROWN HAWAII trademark was an asset of PBH Marketing, Inc., included in his sale of his interest in that company.

Date: March 29, 2020

Respectfully submitted,
/s/ Karen B. Tripp
Karen B. Tripp, *Attorney at Law*
Texas State Bar No.: 03420850
4265 San Felipe, Suite 1100
Houston, Texas 77027

(713) 658-9323 office phone
(832) 798-7576 cell phone
tripp.karen@gmail.com
ATTORNEY FOR OPPOSER,
PBH MARKETING, INC.

Certificate of Service

The undersigned counsel hereby certifies that on this March 29, 2020, a true copy of the foregoing was served to Attorney for Applicant, Seth Reiss, via email respectively at seth.reiss@lex-ip.com.

/karen tripp/
Karen B. Tripp

<EXHIBIT A>

On Sep 30, 2019, at 6:39 PM, Tracey Ohta <tohta@wik.com> wrote:

Hi Karen,

It is our understanding that the filing of a Motion for Summary Judgment suspends all matters not germane to the Motion and tolls the time to respond to outstanding discovery requests.

Thank you.

Tracey L. Ohta, Esq.

Watanabe Ing LLP
First Hawaiian Center
999 Bishop Street, Suite 1250
Honolulu, Hawaii 96813
Phone: 808-544-8300

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-----Original Message-----

From: Karen B. Tripp, Attorney [mailto:tripp.karen@gmail.com]

Sent: Monday, September 30, 2019 11:38 AM

To: Tracey Ohta

Cc: Seth M. Reiss

Subject: Re: ESTTA Filing Receipt: Proceeding or Serial or Registration No. 91242236
Motion for Summary Judgment Filing Receipt for ESTTA Tracking No: ESTTA1005540

You provide this instead of the discovery we requested a month ago?

On Sep 30, 2019, at 4:26 PM, Tracey Ohta <tohta@wik.com> wrote:

Counsel:

Please find attached Applicant's Motion for Summary Judgment filed today with ESTTA.

Thank you.

Tracey L. Ohta, Esq.

Watanabe Ing LLP
First Hawaiian Center
999 Bishop Street, Suite 1250
Honolulu, Hawaii 96813
Phone: 808-544-8300

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-----Original Message-----

From: estta@uspto.gov [mailto:estta@uspto.gov]

Sent: Monday, September 30, 2019 11:19 AM

To: Trademark; Tracey Ohta; Seth M. Reiss; Summer H. Kaiawe; Heather K. Reagan

Subject: ESTTA Filing Receipt: Proceeding or Serial or Registration No. 91242236

Motion for Summary Judgment Filing Receipt for ESTTA Tracking No: ESTTA1005540

ESTTA Filing Receipt

This ESTTA Filing Receipt confirms receipt of your filing associated with the above-identified ESTTA Tracking Number.

Your filing may be viewed on TTABVUE at <http://ttabvue.uspto.gov/ttabvue/> . If you don't see your filing on TTABVUE a week after you file, or if you received an error message or experienced a technical issue while submitting your filing on ESTTA, please send an email to esta@uspto.gov and provide the ESTTA Tracking Number and the Serial, Registration or Proceeding Number identified above, and a brief description of the error message or technical issue you encountered.

For non-technical status or information inquiries, please contact the TTAB Assistance Center at ttabinfo@uspto.gov or 571-272-8500 Monday through Friday from 8:30 a.m. to 5:00 p.m. Eastern Time (ET).

Tracking No.: ESTTA1005540
Filing date: 09/30/2019

Proceeding No.: 91242236
Filing Party: Defendant
Paul L. Brown

Filing Party's Correspondence Address: SETH M REISS
WATANABE ING LLP
999 BISHOP ST STE 1250
HONOLULU, HI 96813
UNITED STATES
trademark@wik.com, tohta@wik.com, sreiss@wik.com, skaiawe@wik.com,
hreagan@wik.com
808-544-8300

Submission: Motion for Summary Judgment

Filer's Name: Seth M. Reiss
Filer's email: sreiss@wik.com, trademark@wik.com, tohta@wik.com
Signature: /seth m. reiss/
Date: 09/30/2019

Attachments: PBH_PB_MSJ.pdf

<PBH_PB_MSJ.pdf>

<EXHIBIT B>

From: "Karen B. Tripp, Attorney" <tripp.karen@gmail.com>
Subject: Re: ESTTA Filing Receipt: Proceeding or Serial or Registration No. 91242236 Motion for Summary Judgment Filing Receipt for ESTTA Tracking No: ESTTA1005540
Date: February 20, 2020 at 11:26:31 AM CST
To: Tracey Ohta <tohta@wik.com>

Hi Tracey,

In light of the TTAB ruling on your motion. Please provide your responses to our discovery requests outstanding since September today.

Regards,
Karen B. Tripp
Attorney at Law
4265 San Felipe, Suite 1100
Houston, TX 77027
(713) 658-9323 office phone
(832) 798-7576 cell phone
tripp.karen@gmail.com

On Sep 30, 2019, at 6:39 PM, Tracey Ohta <tohta@wik.com> wrote:

Hi Karen,

It is our understanding that the filing of a Motion for Summary Judgment suspends all matters not germane to the Motion and tolls the time to respond to outstanding discovery requests.

Thank you.

Tracey L. Ohta, Esq.

Watanabe Ing LLP
First Hawaiian Center
999 Bishop Street, Suite 1250
Honolulu, Hawaii 96813
Phone: 808-544-8300

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<EXHIBIT C>

From: "Seth M. Reiss" <seth.reiss@lex-ip.com>
Subject: RE: Discovery in Paul Brown Hawaii Trademark Opposition
Date: February 27, 2020 at 12:12:00 PM CST
To: "'Karen B. Tripp, Attorney'" <tripp.karen@gmail.com>
Cc: "'Tracey Ohta'" <tohta@wik.com>
Reply-To: <seth.reiss@lex-ip.com>

Ms. Tripp

Thank you for our email. Please direct your future communications about this matter to me and not to Ms. Ohta.

We do not currently have authority to respond to your requests. We will advise you once we do.

Regards,

Seth M. Reiss
Of Counsel
Watanabe Ing LLP
First Hawaiian Center | 999 Bishop Street, Suite 1250 | Honolulu, HI 96813
F:808.544.8321 | 7: 808.544.8399 | : seth.reiss@lex-ip.com
lwebsite: www.wik.com and lex-ip.com

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-----Original Message-----

From: Karen B. Tripp, Attorney <tripp.karen@gmail.com>
Sent: Wednesday, February 26, 2020 7:54 PM
To: Tracey Ohta <tohta@wik.com>
Cc: Seth M Reiss <seth.reiss@lex-ip.com>
Subject: Discovery in Paul Brown Hawaii Trademark Opposition

Tracey,

Have you received my voice mails and email about your failure to respond to our Sept 2, 2019 discovery requests? Please advise if I should be contacting you in a different way. It appears that you are just trying to cause further delays, which is not acting in good faith. If that is not the case, then please respond and explain.

Also, since you have not been able to timely respond to discovery requests made on Sept. 2, it seems that one way to get some needed information and documents before the close of the discovery period would be a deposition with subpoena duces tecum of Paul Brown. Please advise when he can be available for deposition and the city location—I assume Honolulu—between March 5 and March 17.

Regards,
Karen B. Tripp
Attorney at Law
4265 San Felipe, Suite 1100
Houston, TX 77027
(713) 658-9323 office phone
(832) 798-7576 cell phone
tripp.karen@gmail.com=

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

In the matter of Application Serial No. 87782744

Filed on February 2, 2018

For the Mark **Paul Brown Hawaii**

Published in the *Official Gazette* on June 26, 2018

PBH Marketing, Inc.	:	
Opposer,	:	
v.	:	Opposition No. 91242236
Paul L. Brown,	:	
Applicant	:	

EXHIBIT D

To

OPPOSER PBH MARKETING, INC.'S MOTION FOR SANCTIONS

AGAINST APPLICANT PAUL L. BROWN

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

In the matter of Application Serial No. 87782744

Filed on February 2, 2018

For the Mark **Paul Brown Hawaii**

Published in the *Official Gazette* on June 26, 2018

PBH Marketing, Inc.	:	
Opposer,	:	
v.	:	Opposition No. 91242236
Paul L. Brown,	:	
Applicant	:	

**OPPOSER PBH MARKETING, INC.’S FIRST SET OF REQUESTS
TO APPLICANT FOR PRODUCTION OF DOCUMENTS AND THINGS**

Opposer, PBH Marketing, Inc. (“PBH” or “Opposer”), by and through its attorney, pursuant to TBMP § 406 and Federal Rule of Civil Procedure 34, requests that Applicant, Paul L. Brown (“Applicant Brown” or “Applicant”) produce for inspection and copying the following documents and other tangible things within the possession, custody, or control of Applicant. Opposer requests that Applicant send copies or samples of the requested items to Opposer’s counsel, Karen B. Tripp, Attorney at Law, 4265 San Felipe, Suite 1100, Houston, TX 77027, accompanying service of Applicant’s responses to these requests within thirty (30) days after the date of service of these Requests for Production.

DIRECTIONS AND INSTRUCTIONS

I. DEFINITIONS

1. "Agreement" means a contract, arrangement, or understanding, formal or informal, oral or written, between two or more persons.

2. "Any" means one or more.

3. "Communication" means any disclosure, transfer, or exchange of information or opinion, however made.

4. "Distributor" means any person that distributes any products of any other person or purchases or acquires any such product for resale to any other person.

5. "Document" means any written, recorded, or graphic material of any kind, whether prepared by you or by any other person, that is in your possession, custody, or control. The term includes agreements; contracts; letters; telegrams; inter-office communications; memoranda; reports; records; instructions; specifications; notes; notebooks; laboratory notebooks; scrapbooks; diaries; journals; plans; drawings; sketches; blueprints; diagrams; photographs; photocopies; charts; graphs; descriptions; drafts, whether or not they resulted in a final document; minutes of meetings, conferences; and telephone or other conversations or communications; text messages; invoices; purchase orders; bills of lading; recordings; published or unpublished speeches or articles; publications; transcripts of telephone conversations; cellular phone text messages; phone mail; electronic-mail; ledgers; financial statements; microfilm; microfiche; tape or disc recordings; and computer print-outs.

The term "document" also includes electronically stored data from which information can be obtained either directly or by translation through detection devices or readers; any such document is to be produced in a reasonably legible and usable form. The term "document" includes all drafts of a document and all copies that differ in any respect from the original, including any notation, underlining, marking, or information not on the original. The term also includes information stored in, or accessible through, computer or other information retrieval systems (including any computer archives or back-up systems), together with instructions and all other materials necessary to use or interpret such data compilations.

A comment or a notation appearing on any Document, and not a part of the original text, is to be considered a separate "document." Each copy of any document that contains any marking not appearing on the original or which is an alteration of the original in any way or which is discovered at a different location or in the possession or custody of a different person than the original is a separate document for the purposes of these requests.

Without limitation on the term "control" as used in the preceding paragraph, a document is deemed to be in your control if you have the right to secure the document or a copy thereof from another person.

6. "Identify" or "identity" means to state or a statement of:

a. in the case of a person other than a natural person, its name, the address of its principal place of business (including zipcode), its telephone number, and the name of its chief executive officer, as well as, if it has a person other than a natural person that ultimately controls it, that other person's name, the address of that person's principal place of business (including

zipcode), that other person's telephone number, and the name of that other person's chief executive officer;

b. in the case of a natural person, his or her name, business address and telephone number, employer, and title or position;

c. in the case of a communication, its date, type (*e.g.*, telephone conversation or discussion), the place where it occurred, the identity of the person who made the communication, the identity of the person who received the communication, the identity of each other person when it was made, and the subject matter discussed;

d. in the case of a document, the title of the document, the author, the title or position of the author, the addressee, each recipient, the type of document, the subject matter, the date of preparation, and its number of pages; and

e. in the case of an agreement, its date, the place where it occurred, the identity of all persons who were parties to the agreement, the identity of each person who has knowledge of the agreement and all other persons present when it was made, and the subject matter of the agreement.

7. "Including" means including, but not limited to.

8. "Person" means any natural person, corporation, company, partnership, joint venture, firm, association, proprietorship, agency, board, authority, commission, office or other business or legal entity, whether private or governmental.

9. "Relating to" means containing, constituting, considering, comprising, concerning, discussing, regarding, describing, reflecting, studying, commenting or reporting on, mentioning, analyzing, or referring, alluding, or pertaining to, in whole or in part.
10. "Relevant time period" means the time period stated in paragraph 1 of the Instructions.
11. **"You," "your" or "your company" means Applicant Brown, as defined below.**
12. **"Applicant Brown" means Applicant, Paul L. Brown, each of his predecessors, successors, companies, company divisions, company subsidiaries, salons, licensees, licensors, and affiliates, located in the United States and/or in any other country, each other person directly or indirectly, wholly or in part, owned or controlled or licensed or otherwise authorized by him or affiliated with him, and each joint venture to which any of them is a party, and all present and former partners, associates, representatives, employees, agents, consultants, affiliates, licensors, licensees, or other persons acting for or on behalf of any of them.**
13. "Third party" means any person other than Applicant or Opposer.
14. "Year" means calendar year or the twelve-month period on which your business records are based; if the latter is used in responding to a document request, specify the twelve month period used.
15. "Your amended answer" means the Applicant's Answer filed in this Opposition dated May 16, 2019.

16. The singular form of a noun or pronoun shall be considered to include within its meaning the plural form of the noun or pronoun, and vice versa; and the past tense shall include the present tense where the clear meaning is not distorted. The term "or" shall mean "and" and vice-versa, as necessary to bring within the scope of the following document requests all information or documents that would be excluded absent this definition.

II. INSTRUCTIONS

1. Unless otherwise specified, the documents called for by these document requests are documents in your possession, custody or control that were applicable, effective, prepared, written, generated, sent, dated, or received at any time since January 1, 2004.

2. Pursuant to Fed. R. Civ. P. 26(e), you are under a duty seasonably to supplement any response to this request for production for which you learn that the response is in some material respect incomplete or incorrect and if the additional or corrective information has not otherwise been made known to Applicant Brown during the discovery process or in writing.

3. All documents that respond, in whole or in part, to any part or clause of any paragraph of these document requests shall be produced in their entirety, including all attachments and enclosures. Only one copy need be produced of documents that are responsive to more than one paragraph or are identical except for the person to whom it is addressed if you indicate the persons or group of persons to whom such documents were distributed. Documents that in their original condition were stapled, clipped, or otherwise fastened together shall be produced in such form. Please place the documents called for by each paragraph in a separate file folder or other enclosure marked with Applicant Brown's name and the paragraph to which such documents

respond, and if any document is responsive to more than one request, indicate each request to which it responds.

5. In producing documents consisting of electronically stored data in machine-readable form in response to any document request, provide such data in a form that does not require specialized or proprietary hardware or software. For each data file provided, the following information should be included: a record layout, a short narrative description of the contents of the file, translation of any coded fields, the number of records in the file, and a printout of the first 100 records in report format. A record layout must contain the following pieces of information: name of the field, starting and ending position in the record, length of the field, and characteristics of the field).

To the extent that any document, including but not limited to electronic files, produced in response to this request for production requires the use of software to view, manipulate and otherwise extract information, you shall produce a copy of that software.

6. For any document withheld under a claim of privilege, submit a sworn or certified statement from your counsel or one of your employees in which you identify the document by author, addressee, date, number of pages, and subject matter; specify the nature and basis of the claimed privilege and the paragraph of this demand for documents to which the document is responsive; and identify each person to whom the document or its contents, or any part thereof, has been disclosed.

7. For any document responsive to these document requests which is known to have been destroyed or lost, or is otherwise unavailable, identify each such document by author, addressee, date, number of pages, and subject matter; and explain in detail the events leading to the

destruction or loss, or the reason for the unavailability of such document, including the location of such document when last in your possession, custody, or control, and the date and manner of its disposition.

8. In responding to any document request that calls for documents relating to "any person," or "each person," include information or documents relating to you, Applicant Bown, if applicable.

9. Each document that is written in whole or in part in any language other than English or that contains any marginal notations in such a language must be accompanied by a certified verbatim English language translation, and all existing English language versions, of all such writings and notations.

10. If any document responsive to any request was at one time but is no more in your custody, control, or possession, or is otherwise known to you but never in your custody, control or possession, then identify that document sufficient to describe it for a subpoena *duces tecum* and identify the person last known to have been in possession or control of the document.

DOCUMENTS REQUESTED

1. Documents identifying the company you referenced as "Applicant's company," in paragraph 3 of your amended answer, including the company's certificate of formation and by-laws and documents showing all ownership interests at any time in said company, documents showing any and all attempted, partial or complete sales of a part or all of said company, and documents showing any dissolution and/or name-change of said company.

2. Documents showing use and/or ownership of the mark PAUL BROWN HAWAII by you, including without limitation documents showing your first or early use and documents showing your use in each and every year of use, if any, thereafter, to the present day, if applicable.
3. Documents that support or relate to your allegation in paragraph 10 of your amended answer that you deny “that the negotiations contemplated the sale of all Applicant’s rights in the trademark PAUL BROWN HAWAII.”
4. Documents showing reasons or support for or that relate to your denial stated in paragraph 12 of your amended answer.
5. Documents showing your orders of products, directly or indirectly, from PBH Marketing, Inc.
6. Documents showing your sales of products obtained, directly or indirectly, from PBH Marketing, Inc.
7. Documents showing your withdrawal of any orders of products, directly or indirectly, from PBH Marketing, Inc.
8. Documents showing your return of any products, directly or indirectly, to PBH Marketing, Inc.
9. Documents showing goods you intend to associate and/or already do associate with the mark or sell under the mark PAUL BROWN HAWAII.
10. Documents sufficient to show the channels of trade through which you sell or provide, have sold or provided, or have plans to sell or provide, products and/or services under the PAUL BROWN HAWAII mark.

11. All documents relating to any communications between you and PBH Marketing, Inc., or any of its employees, agents, representatives, associates, affiliates, officers, directors, managers, owners, contractors, or consultants, since January 1, 2015.
12. All of your minutes, recordings, summaries, or reports of meetings, whether formal or informal, that refer to the mark PAUL BROWN HAWAII.
13. All of your minutes, recordings, summaries, or reports of meetings, whether formal or informal, that refer to PBH Marketing, Inc., since January 1, 2015.
14. All documents relating to your efforts or intended or planned efforts to market, advertise, and promote the mark PAUL BROWN HAWAII, for hair care and/or hair styling products.
15. All documents relating to any currently or previously contemplated plan or strategy by you to license or otherwise participate in or sell PAUL BROWN HAWAII products, including whether or not the plan or strategy was implemented and the reasons why it was or was not.
16. All documents relating to any currently or previously contemplated plan or strategy by you to license the mark PAUL BROWN HAWAII.
17. All documents supporting or related to your first Affirmative Defense in your amended answer.
18. All documents supporting or related to your second Affirmative Defense in your amended answer.
19. All documents supporting or related to your third Affirmative Defense in your amended answer.
20. All documents supporting or related to your fourth Affirmative Defense in your amended answer.

21. All documents that list, report, describe, summarize, analyze, discuss, or comment on any PAUL BROWN HAWAII customers or potential customers that you have identified.
22. All documents that relate to any investigation by you, or a third party on your behalf, of PBH Marketing, Inc.'s use of the mark PAUL BROWN HAWAII prior to your filing the trademark application that is the subject of this Opposition.
23. All documents that relate to any searches by you, or a third party on your behalf, for use of the mark PAUL BROWN HAWAII by anyone on the internet or otherwise in the marketplace prior to your filing the trademark application that is the subject of this Opposition.
24. All documents relating to communications to or from third parties regarding PBH Marketing, Inc., its products, its catalogs, its website, or its use of the PAUL BROWN HAWAII trademark.
25. All documents that you intend to offer as exhibits in this Opposition.
26. All opinions of counsel or experts relating to your alleged ownership of the PAUL BROWN HAWAII trademark on which you intend to rely during this proceeding.
27. All documents relating to or supporting your allegation that PBH Marketing, Inc. does not own or does not entirely own the mark PAUL BROWN HAWAII.
28. All documents relating to or supporting your allegation that PBH Marketing, Inc. does not have prior right to use the PAUL BROWN HAWAII mark in commerce for hair care products in identical form to the mark you seek to register.
29. All licenses or assignments of the PAUL BROWN HAWAII trademark.
30. All revocations of any licenses of the PAUL BROWN HAWAII trademark.
31. All documents that you contend support or related to any allegation in your amended answer.

Date: Sept. 2, 2019

Respectfully submitted,
/s/ Karen B. Tripp
Karen B. Tripp, *Attorney at Law*
Texas State Bar No.: 03420850
4265 San Felipe, Suite 1100
Houston, Texas 77027
(713) 658-9323 office phone
(832) 798-7576 cell phone
tripp.karen@gmail.com
ATTORNEY FOR OPPOSER,
PBH MARKETING, INC.

Certificate of Service

The undersigned counsel hereby certifies that on this 2nd day of September, 2019, a true copy of the foregoing was served to Attorneys for Applicant, Tracey Ohta and Seth Reiss, via email respectively at tohta@wik.com and seth.reiss@lex-ip.com.

/karen tripp/
Karen B. Tripp

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

In the matter of Application Serial No. 87782744

Filed on February 2, 2018

For the Mark **Paul Brown Hawaii**

Published in the *Official Gazette* on June 26, 2018

PBH Marketing, Inc.

Opposer,

v.

Paul L. Brown,

Applicant

Opposition No. 91242236

**DECLARATION OF KAREN B. TRIPP IN SUPPORT OF
OPPOSER PBH MARKETING, INC.'S MOTION FOR SANCTIONS
AGAINST APPLICANT PAUL L. BROWN**

I, Karen B. Tripp, declare:

1. I am the attorney representing Opposer, PBH Marketing, Inc. with respect to the referenced proceeding. I have personal knowledge of the matters set forth below. I make this declaration to provide the Board with email communications cited in Opposer's motion for sanctions against Applicant.

2. Attached as **Exhibit A** to Opposer's motion is a true and correct copy of: an email to me from Opposer's then counsel Tracey Ohta on September 30, 2019; my reply by email to her that same day; and her response to me; again on the same day.

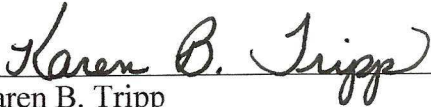
3. Attached as **Exhibit B** to Opposer's motion is a true and correct copy of a follow-up email from me to Applicant's counsel dated February 20, 2020.

4. Attached as **Exhibit C** to Opposer's motion is a true and correct copy of: an email from Applicant's counsel Seth M. Reiss on February 27, 2020, on the first page of that exhibit, replying to my email to Tracey Ohta and copied to Seth M. Reiss, dated February 26, 2020, on the second page of that exhibit.

5. Attached as **Exhibit D** to Opposer's motion is a true and correct copy of Opposer PBH Marketing, Inc.'s First Set of Requests to Applicant for Production of Documents and Things as served on Applicant's counsel on September 2, 2019.

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of her own knowledge are true, and all statements made on information and belief are believed to be true.

Executed in Houston, Texas on this 29th day of March, 2020.



Karen B. Tripp