Trademark Trial and Appeal Board Electronic Filing System. https://estta.uspto.gov

ESTTA Tracking number: **ESTTA1126246**

Filing date: **04/12/2021**

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

Proceeding	91252583
Party	Plaintiff Estee Lauder Cosmetics Ltd.
Correspondence Address	BARBARA A SOLOMON FROSS ZELNICK LEHRMAN & ZISSU PC 151 WEST 42ND STREET, 17TH FLOOR NEW YORK, NY 10036 UNITED STATES Primary Email: bsolomon@fzlz.com Secondary Email(s): jjones@fzlz.com, ttabfiling@fzlz.com 212-813-5900
Submission	Motion to Compel Discovery or Disclosure
Filer's Name	Jason D. Jones
Filer's email	jjones@fzlz.com, bsolomon@fzlz.com, ttabfiling@fzlz.com
Signature	/Jason D. Jones/
Date	04/12/2021
Attachments	MAC Motion to Compel.PDF(539079 bytes)

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

ESTEE LAUDER COSMETICS LTD., Opposer, -against- ANA MARIA ALVES CASAS, Applicant.	Opposition No. 91252583

OPPOSER'S MOTION TO COMPEL DISCOVERY

Pursuant to Rules 2.120(f) of the Trademark Rules of Practice, Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 523, and Rule 37(a) of the Federal Rules of Civil Procedure, Opposer Estee Lauder Cosmetics Ltd. ("Opposer") hereby moves the Trademark Trial and Appeal Board for an order compelling Applicant Ana Maria Alves Casas ("Applicant") to address deficiencies in her responses to Interrogatory Nos. 8 and 9 of Opposer's First Set of Interrogatories by serving supplemental responses thereto.

CERTIFICATION OF COUNSEL

Pursuant to Trademark Rule of Practice § 2.120(f), and TBMP § 523.02, this motion is made following a good faith attempt by counsel for Opposer to resolve the issues presented in this motion with counsel for Applicant. As detailed in the Declaration of Jason D. Jones in Support of Opposer's Motion to Compel Discovery ("Jones Decl.") at ¶¶ 6-11 and Exhibits B and C thereto, Opposer has made repeated attempts to resolve this matter before seeking the Board's intervention, including exchanging detailed emails throughout February and March of 2021 with Applicant's counsel setting forth the parties' positions on the deficiencies set forth herein.

Following this detailed exchange of emails in which Applicant's counsel initially represented that responses would be supplemented, on March 24, 2021, Opposer's counsel sent an email that gave Applicant until March 31, 2021 to provide supplemental responses to Interrogatory Nos. 8 and 9. (Jones Decl. ¶ 9, Ex. C at p. 2.) Applicant did not respond to this email, did not provide any supplemental responses on March 31, 2021, and still to date has not provided any supplemental responses to these interrogatories. (*Id.* ¶ 9.)

On April 1, 2021, Opposer's counsel emailed Applicant's counsel and requested a meet and confer to be held on either April 5th or 6th, 2021 and asked Applicant's counsel to provide his availability on these dates. (Jones Decl. ¶ 10, Ex. C at p. 1.) Applicant's counsel never responded to this email. (*Id.* ¶ 10.)

Finally, on April 5, 2021, Opposer's counsel called Applicant's counsel and left a voicemail requesting Applicant's counsel return the phone call to discuss setting up a meet and confer on these issues. (*Id.* ¶ 11.) Applicant's counsel never returned this phone call. (*Id.*)

Based on the detailed communications between counsel for the parties prior to bringing this motion, Opposer's repeated attempts to resolve this matter with Applicant which have gone unanswered, and Applicant's refusal to engage in any further discussions on the issues presented herein, Opposer does not believe that further discussions with Applicant's counsel are likely to resolve the dispute, thereby necessitating the filing of this motion.

BRIEF FACTUAL BACKGROUND

Opposer is one of the world's leading manufacturers of prestige skincare and cosmetics products. For more than three decades, Opposer, through its licensee Make-up Art Cosmetics Inc., has marketed and sold cosmetics and skincare products throughout the United States under the famous trademark MAC. (*See* 6 TTABVUE 6-8 (¶¶ 1-8).)

In this opposition, Opposer has opposed Applicant's attempt to register the mark MCCOSMETICS NY (Stylized) for, *inter alia*, "Cosmetics; cosmetic creams for skin care; non-medicated cosmetic creams for body care; face and body creams; [and] skin cleansers" in International Class 3. According to the application, Applicant is a Portuguese individual residing in Porto, Portugal. (6 TTABVUE 9 at ¶ 10.) Applicant claimed in interrogatory responses to have first used the MCCOSMETICS NY mark in the United States in 2014 and to have used it continuously since then. (Jones Decl., Ex. A at Response to Interrogatory No. 5.)

A. Opposer's First Set of Interrogatories to Applicant

Opposer filed its First Amended Notice of Opposition on February 26, 2020 and Applicant filed its Answer on May 6, 2020. (*See* 6-11 TTABVUE.) On September 9, 2020, Opposer served its First Set of Interrogatories on Applicant. (Jones Decl. ¶ 3.) On October 8, 2020, the parties agreed to a thirty-day extension of Applicant's deadline to respond to Opposer's First Set of Interrogatories. (*Id.* ¶ 4.) On November 10, 2020, Applicant served its responses to Opposer's First Set of Interrogatories. (Jones Decl. ¶ 5, Exhibit A.)

B. Applicant's Deficient Responses to Interrogatory Nos. 8 and 9 and the Parties' Correspondence and Meet and Confer

Applicant's responses to Interrogatory Nos. 8 and 9 of Opposer's First Set of Interrogatories were deficient on their face, as detailed *infra.*

Accordingly, on January 28, 2021, counsel for Opposer and counsel for Applicant held a telephonic meet and confer at which time Opposer's counsel outlined in detail the deficiencies in Applicant's responses to these two interrogatories. (Jones Decl. ¶ 6.) On the call, Applicant's counsel agreed to provide supplemental responses to Interrogatory Nos. 8 and 9. (Jones Decl. ¶¶ 6-7, Ex. B.) Notwithstanding this original agreement, Applicant has never provided any

supplemental responses and has now refused to do so even though Opposer's counsel has repeatedly explained in detail why Applicant's responses are deficient. (Jones Decl. ¶¶ 7-9, Ex. C.)

ARGUMENT

A. Applicant Should Be Compelled to Supplement Its Responses to Interrogatory Nos. 8 and 9

Interrogatory No. 8

Interrogatory No. 8 asked Applicant to "[s]tate the amount of money Applicant has spent on an annual basis (or part thereof) to publicize goods or services under Applicant's Mark in the United States" from the claimed date of first use (2014) to the present. Applicant has never objected to the relevancy of this interrogatory or suggested that Opposer is not entitled to the information requested. Rather, in her November 2020 response, Applicant stated that she was "still gathering the information that will allow [her] to provide an accurate answer" and that she would "provide a supplemental answer to this interrogatory with the requested information." (Jones Decl., Ex. A at Response to Interrogatory No. 8.)

On February 17, 2021, following counsel's January 28, 2021 meet and confer, Applicant's counsel sent an email stating:

> "As to Interrogatory 8, Applicant's advertising in the U.S. consists of its website only. We are still trying to obtain a dollar amount associated with the use of the website in the United States. We will supplement our answer to Interrogatory 8 when we receive that information."

(Jones Decl., Ex. C at p. 5.)

Such supplementation never came. Instead, on March 23, 2021, Applicant's counsel sent an email repeating the same fact he had already told Opposer, stating specifically: "For Interrogatory No. 8, we understand that the client does not have any marketing in the U.S. other than its global webpage and that the costs for the webpage are attributed to the U.S." (Jones

Decl., Ex. C at p. 3.) Applicant's counsel did not, however, provide such costs even though he previously had agreed to do so. In an apparent attempt to avoid its obligation to provide a response, Applicant's counsel points for the first time to a document Applicant produced in discovery (which bears bates stamp AMAC230 and is marked "Confidential"), but admits that he does not know "whether or not [the information on the document] is related to marketing activity" in the United States and clearly did not seek clarification from his client on this issue. (Jones Decl., Ex. C at p. 3.) Applicant's counsel flippantly concluded his email by stating: "At this point, I suggest that you take our client's deposition and learn more directly from them." (*Id.*)

This response is insufficient. Opposer served a valid and proper interrogatory seeking information that is clearly discoverable and that is exclusively within Applicant's possession and control. *See* TRADEMARK BOARD MANUAL OF PROCEDURE § 414(18) ("Annual sales and advertising figures, stated in round numbers, for a party's involved goods or services sold under its involved mark are proper matters for discovery"). Applicant never objected to providing the information and in fact stated in her response to the interrogatory that she would do so. Applicant's failure to provide basic information within her exclusive control is unquestionably a failure to meet her discovery obligations. Nor can Applicant rely on her counsel's reference in an email to the document marked AMAC230 to fulfill her obligations, since this reference is improper under Federal Rule of Civil Procedure 33(d) which allows for documents to be provided in lieu of an interrogatory response *only* where the response to the interrogatory can be readily obtained by examining the document. That is clearly not the case here. Indeed, Applicant's counsel admits that he does not know whether the information contained in AMAC230 refers to any marketing activity at all.

There is no basis for Applicant's ongoing refusal to provide in response to Opposer's Interrogatory No. 8 the total amount of money Applicant has spent to advertise and promote her goods offered under the MCCOSMETICS NY mark in the United States since the date of first use to the present. Applicant cannot put the obligation on Opposer to ascertain Applicant's expenditures.

Accordingly, Applicant should be compelled to provide a supplemental answer to Interrogatory No. 8 that clearly states (1) that Applicant's only marketing in the U.S. under the MCCOSMETICS NY marks is her webpage (and, if applicable, any other expenditures listed in AMAC230) and (2) Applicant's best estimate (in U.S. dollars) for the amount associated with these marketing efforts from 2014 to the present in the United States under the mark.

Interrogatory No. 9

Interrogatory No. 9 asked Applicant to "[s]tate Applicant's total actual sales to date (in terms of both dollars and units sold), if any, on an annual basis or part thereof" for goods and services offered under Applicant's Mark in the United States from the claimed date of first use (2014) to the present. In response, and after objecting that the interrogatory was supposedly "harassing and unduly burdensome," Applicant stated that "the total annual sales for 2019 . . . is $600,000" and the "total number of units comprising this amount is 54,722." (Jones Decl., Ex. A at Response to Interrogatory No. 9.)

In a February 18, 2021 email, and following counsels' January 28, 2021 meet and confer, Opposer's counsel explained in depth why Applicant's response to Interrogatory No. 9 was insufficient, namely because (1) Opposer is entitled to sales figures for each year from 2014 to the present (not just for 2019) and (2) Applicant's response even for 2019 does not state whether these figures are limited to the United States (which are the only sales relevant in this opposition

proceeding). (Jones Decl., Ex. C at p. 5); *see Double J of Broward, Inc. v. Skalony Sportswear GmbH*, 21 U.S.P.Q.2d 1609, 1612-13 (T.T.A.B. 1991) (information concerning applicant's foreign activities is not relevant to an opposition proceeding).

In a March 23, 2021 email response, Applicant's counsel first appeared to drop Applicant's baseless objections that Interrogatory No. 9 was "unduly burdensome" and "harassing"—and rightly so, since such information is clearly discoverable. *See* TBMP § 414(18). Second, Applicant's counsel appeared to concede that Applicant was required to supplement its response to Interrogatory No. 9 to provide at least some additional information, stating:

> "As to Interrogatory No. 9, the answer lists sales figures for 2019. However, we have asked the client if this figure is a total for all years ending in 2019. We are still waiting for a reply."

(Jones Decl., Ex. C at p. 3.)

Given that Applicant has had six months to gather this information, on March 24, 2021, Opposer's counsel sent an email giving Applicant until March 31, 2021 to provide a supplemental response that provides sales figures in the United States for the years 2014 through 2018 (or that states that the figures already provided for 2019 also cover these years). (Jones Decl., Ex. C at p. 2.) Applicant did not provide any such supplementation for Interrogatory No. 9 and has refused to respond to Opposer's counsel repeated follow-ups on this issue and has refused to respond to Opposer's requests for a meet and confer. (Jones Decl. ¶¶ 9-11.)

Accordingly, Applicant should be compelled to provide an amended answer to Interrogatory No. 9 and provide a full and complete answer.

B. This Proceeding Should Be Suspended During the Pendency of the Instant Motion

Opposer further requests that the Board suspend this proceeding with respect to all matters not germane to this motion pursuant to Trademark Rule of Practice § 2.120(f)(2).

CONCLUSION

Applicant has sought the benefits of a U.S. trademark registration. Having sought to register her mark with the U.S. Patent and Trademark Office ("USPTO"), Applicant must comply with all of the rules of the USPTO, including the rules governing discovery in opposition proceedings before the Board. Applicant without any justification has refused to cooperate by failing to provide basic information as to her sales and marketing activities in the U.S. under the opposed mark.

For the reasons stated above, Opposer respectfully requests that its motion be granted in its entirety and that the Board enter an order compelling Applicant within ten days of the Board's decision of this motion to address the deficiencies in her responses to Interrogatory Nos. 8 and 9 of Opposer's First Set of Interrogatories by serving amended and complete responses thereto and that the Board otherwise impose appropriate sanctions on Applicant for her failure to comply with her discovery obligations.

Dated: New York, New York
April 12, 2021

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By: _____

Barbara A. Solomon (*bsolomon@fzlz.com*)
Jason D. Jones (*jjones@fzlz.com*)
Daniel M. Nuzzaci (*dnuzzaci@fzlz.com*)
151 West 42nd Street, 17th Floor
New York, New York 10036
Phone: (212) 813-5900

Attorneys for Estee Lauder Cosmetics Ltd.

CERTIFICATE OF SERVICE

I hereby certify that on April 12, 2021, a copy of the foregoing **OPPOSER'S MOTION TO COMPEL DISCOVERY** was sent by email to Applicant's counsel at the email addresses: *nwells@legendslaw.com* and *docket@legendslaw.com*.

Jason D. Jones