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Filing date: **01/05/2021**

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

Proceeding	91254428
Party	Defendant Mother's Milk, Inc.; Min Byung Wook dba Uzinmedicare
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Signature	/Tarae L. Howell/
Date	01/05/2021
Attachments	91254428 Applicants Motion to Extend Case Deadlines.pdf(438564 bytes)

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

In the Matter of Application Serial No. 88/329,455



Published: December 24, 2019

Motif Medical, LLC,

Opposer,

v.

Mother's Milk, Inc. DBA Spectra Baby USA;

and Min Byung Wook DBA Uzinmedicare,

Applicants.

Opposition No. 91254428

**MOTHER'S MILK, INC.'S MOTION TO EXTEND CONFERENCE, DISCOVERY,
DISCLOSURE AND TRIAL SCHEDULE DEADLINES**

Pursuant to TBMP § 509.01(a), Applicant Mother's Milk, Inc. DBA Spectra Baby USA ("Spectra" or "Applicant") respectfully moves for an Order extending the remaining deadlines under the *Conference, Discovery, Disclosure and Trial Schedule* ("Case Schedule") by sixty (60) days. In Support of this Motion, Spectra states:

1. On March 3, 2020, Opposer Motif Medical, LLC ("Motif" or "Opposer") filed its Notice of Opposition to the application bearing Serial No. 88/329,455. As grounds for the opposition Motif alleges (i) fraud, (ii) genericness, (iii) descriptiveness, (iv) failure to function, and (v) aesthetic functionality. Spectra filed its Answer and Defenses on April 22, 2020. The

parties have been engaged in discovery since the summer of 2020 and the current deadline to complete discovery is January 17, 2021.

2. On December 10, 2020, Motif issued notices of deposition for a Fed. R. Civ. P. 30(b)(6) deposition of Spectra and a separate deposition of Spectra's CEO, Heidi Humphries. The notices of deposition are the subject of a separate *Motion to (1) Vacate and Quash Notices of Deposition and (2) For Protective Order* ("Deposition Motion") filed with this Motion. To the extent that the Board determines that Motif is entitled to the depositions noticed, the deponents will need sufficient time to prepare for the depositions. The Board should consider the substance of that motion in considering the relief requested in this Motion.

3. As noted, Spectra files this Motion contemporaneously with its Deposition Motion, seeking to vacate, preclude, limit and/or delay the 33-topic Rule 30(b)(6) notice of deposition, along with the notice of deposition of its CEO, Ms. Heidi Humphries, noticed for January 12-13, and served only on December 10 without consultation between the parties. In fact, Spectra has now dedicated so much time to dealing with the vastly overbroad and disproportionate deposition notices served by Motif that it has compromised Spectra's ability to consider serving deposition notices for Motif witnesses.

4. The parties telephonically conferred regarding discovery on November 30, there was follow-up correspondences, and the deposition notices were served on December 10. *See Exhibit B*, Correspondence chain. The parties further corresponded after and held a further telephonic conference on January 4, 2021. During that conference, counsel for Motif agreed to withdraw one topic and modify two others. Given the pending deadline for discovery, and Motif's refusal to consent to any extension, there is not sufficient time for further discussions

among the parties due to the quickly approaching deadline to complete discovery by January 17, 2021.

5. There has been only one previous extension of the Case Schedule which was for sixty (60) days.

6. Spectra has at all times worked diligently to complete its discovery obligations including, for example: (i) issuing written discovery to Motif; (ii) reviewing documents produced by Motif; (iii) reviewing Spectra's documents and information to respond to Motif's written discovery, including forty (40) interrogatories and thirty-one (31) document requests; and (iv) searching Spectra's records to identify and produce responsive documents and information.

7. Under any circumstances, the approximately 32 days between the service of the 30(b)(6) notice in this action (and an identical notice with regard to the companion Opposition No. 91254427) and the noticed dates for deposition is simply not enough time either to complete the objection process with regard to the notices, nor prepare witnesses regarding the same. Additionally, the December holiday season coupled with the public health regulations associated with the Covid-19 pandemic, however, have imposed additional challenges on Spectra's ability to object and then adequately prepare witnesses in response to the overbroad notices of deposition served on December 10 or prepare witnesses by the dates noticed or the discovery closure deadline.

6. Spectra has conferred in good faith with Motif's counsel regarding the relief requested in this Motion, but Motif has declined to consent to any extension of the subject deadline.

WHEREFORE, for good cause shown, Spectra respectfully requests that the Board extend all remaining case deadlines by at least sixty (60) days, but no shorter than forty-five (45) days after its Order in the contemporaneously filed Motion to Vacate, in accordance with the

Proposed Order attached as **Exhibit A**. This one additional extension should be sufficient for the parties to complete their discovery and continue advancing the matter forward and to resolution. In the event that this Motion is not granted, Applicant respectfully requests permission to complete its discovery within twenty-one (21) days of entry of the Board's order on this Motion, or by such other deadline that the Board deems just.

Respectfully submitted,

NIXON PEABODY LLP

Dated: January 5, 2021

/Tarae L. Howell/
Jeffrey L. Costellia
Robert A. Weikert
Deanna R. Kunze
Lauren J. Arnold
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*Attorneys for Mother's Milk, Inc. DBA
Spectra Baby USA*

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Applicant's Motion to Extend Conference, Discovery, Disclosure and Trial Schedule Deadlines was served on Opposer's counsel this 5th Day of January 2021, via email to ANGELA P. DOUGHTY, ESQ., WARD AND SMITH, P.A. via email at trademarks@wardandsmith.com; APD@wardandsmith.com; and EBRogers@wardandsmith.com.

/Tarae L. Howell/

EXHIBIT A

Plaintiff's 30-day Trial Period Ends	June 16, 2021
Defendants' Pretrial Disclosures Due	July 1, 2021
Defendant's 30-day Trial Period Ends	August 15, 2021
Plaintiff's Rebuttal Disclosures Due	August 30, 2021
Plaintiff's 15-day Rebuttal Period Ends	September 29, 2021
Plaintiff's Opening Brief Due	November 28, 2021
Defendant's Brief Due	December 28, 2021
Plaintiff's Reply Brief Due	January 12, 2022
Request for Oral Hearing (optional) Due	January 22, 2022

ENTERED this _____ day of _____, 2020.

By: _____

EXHIBIT B

Howell, Tarae

From: Erica B. E. Rogers <EBRogers@wardandsmith.com>
Sent: Wednesday, December 30, 2020 8:36 PM
To: Kunze, Deanna; NP Trademark Docketing
Cc: Angela P. Doughty; trademarks@wardandsmith.com; Costellia, Jeffrey; Weikert, Robert; Arnold, Lauren; Washington Trademark; Joseph A. Schouten; Grilli, Alexis; Howell, Tarae
Subject: RE: Discovery of Opposition Nos. 91254427 and 91254428 filed by Motif Medical LLC; Our Refs. 080327-2, -66, and -74 (WS: 161593-00026; 00027)

Follow Up Flag: Follow up
Flag Status: Flagged

Dear Ms. Kunze,

We have received and reviewed the email below. There are a number of mischaracterizations about the facts, the scope of the opposition proceedings, and the law. It is impossible to address all of them in this email. However, we have several points in response:

First, Opposer served Notices of Deposition for Heidi Humphries, individually, in addition to the Rule 30(b)(6) Notices of Deposition. Applicants' email below fails to provide any justification for delaying Heidi Humphries' individual deposition or any reason to support Ms. Humphries not appearing for the deposition the week of January 11, 2021.

Second, Applicants' suggestion that the Rule 30(b)(6) Notices are "moot" or "ineffective" because there has not yet been a meet and confer is without merit for at least the following reasons:

- i. Nothing in the recent amendment to Rule 30(b)(6) suggests that Opposer's 30(b)(6) Notices would become "moot" or "ineffective."
- ii. Nothing in the recent amendment to Rule 30(b)(6) suggests that a meet and confer is required prior to the deposition notices being sent out. To the contrary, the revised Rule 30(b)(6) **specifically provides that a meet and confer can occur after the 30(b)(6) notice is served.**
- iii. Opposer has been available to meet and confer on the topics in the deposition notices since the date the deposition notices were served on **December 10**. As a matter of fact, our correspondence serving the notices specifically sought further communication from Applicants.
- iv. Despite this, **Applicants failed to provide any response regarding the Notices for 19 days.** Applicants did not raise any issues with the dates, topics, scope, or anything else at all. Again, Applicants were completely silent for 19 days.
- v. It appears the only reason we received any communication at all from Applicants on the 30(b)(6) Notices—**after 19 days of silence**—was that **we asked Applicants** about the 30(b)(6) witnesses.
- vi. Applicants cannot sit back for 19 days after the notices are sent, refuse to respond to a specific question that accompanied the 30(b)(6) notices, remain silent about any of the topics, withhold any objection to the notices, and then complain about a failure to meet and confer.
- vii. Again, **we have been available to meet and confer for the last 19 days, but we have received absolutely no communication from Applicants.**
- viii. Therefore, to the extent that there has been any delay regarding a meet and confer, the delay is a direct result of Applicants' conduct, not Opposer's conduct.
- ix. Moreover, we are still able and willing to meet and confer regarding the topics of the 30(b)(6) deposition notices. In fact, Applicants agreed to a meet and confer in the below email.
- x. We will meet and confer early next week to discuss the 30(b)(6) notices, thereby satisfying the requirement.

Third, Applicants characterization of the 30(b)(6) notice topics as "egregiously overbroad and disproportionate" is based upon on Applicants' apparent failure to read the operative pleadings in either Opposition. Applicants' objections are based on the incorrect statement that, "the only basis asserted is the alleged functionality of the claimed features." If Applicants would have taken five minutes to review the operative pleadings in both oppositions, they would have understood, or should have understood, that there are more grounds at issue in these opposition proceedings than "functionality." For example, all of the following grounds are explicitly and expressly pleaded in the Notice of Opposition for Opposition No. 91254427: (1) fraud; (2) functionality; and (3) nondistinctive product design; and for Opposition No. 91254428: (1) fraud; (2) genericness; (3) mere descriptiveness; (4) failure to function; and (5) aesthetic functionality. Therefore, Applicants' belated objections fail to demonstrate a basic understanding of the grounds in each case.

In addition, Applicants' passing complaint about the "THIRTY-THREE topics" is not indicative of the burden of the 30(b)(6) notice. A deposition notice with one very broad category could be more burdensome than a deposition notice (like ours) with thirty-three narrowly-tailored and specific categories. Therefore, the complaint about "THIRTY-THREE" topics is not well founded either.

Fourth, Applicants' statement that we "agreed to a 30-day extension then reneged on that and declined an extension" is false. We never agreed to an extension on the phone. We said that we would discuss a 30-day extension with our client because there was no way our client would agree to a 60-day extension. We expressly told Applicants that we did not have authority to commit to any extension. Furthermore, we told Applicants that we were disappointed that Applicants did no work whatsoever during the prior 60-day extension to which we agreed. Because Applicants have made baseless threats of trademark infringement in the past, our client is concerned about delaying the proceedings. We are anxious to establish that Applicants have no protectable trademarks here, neither for the breast pump design or the wave design, and that is why we are committed to moving the proceedings forward as quickly as possible. We are reiterating, here, what we already discussed with Applicants. Plus, it is clear from our December 6 email that we never agreed to an additional extension, and if Applicants needed to discuss an extension with us, we are confused why we received no communication from Applicants on the subject for almost a month.

Fifth, using the "holiday season" and "middle of the Covid-19 crisis" as an excuse is unacceptable. The longer these proceedings persist, the more potential for prejudice to our client. Further, Opposer and Applicants already agreed to extend the dates as currently set forth in the schedules. If the "holiday season" was going to be an issue, Applicants should not have agreed to discovery ending during the holidays in the first place. We all knew what these dates would be when we entered into the last 60-day extension. The "holiday season" and Covid-19 were known at the time of entering into earlier extensions. As a matter of fact, Covid-19 makes scheduling depositions even easier than in-person depositions. In numerous other matters, we have been able to complete discovery, conduct depositions, participate in hearings, hold mediations, and complete any number of other necessary tasks without multiple extensions. Therefore, this excuse simply does not support another extension.

Finally, during our prior meet and confer, Applicants informed us if we did not agree to an extension, Applicants were going to seek one unilaterally. We note Applicants have not done that. Applicants' delay in actively participating in these proceedings is particularly puzzling when Applicants have six attorneys on this matter.

We will not withdraw the deposition notices for the week of January 11, 2021. It is our intention that we will complete the depositions at the noticed time. However, we reserve the right to file a motion to compel these witnesses to attend the depositions after the close of discovery if they do not appear for the depositions prior to the close of discovery.

We look forward to meeting and conferring with you regarding the topics of the notices and whether any topics can be clarified, narrowed, or eliminated. However, before we do so, we ask that you read the operative proceedings so that you have an accurate understating of all issues raised. We expect that once you do, you will understand that all of the thirty-three topics seek information that pertain directly to a ground that we have alleged in the Notices of Opposition.

We are available Monday or Tuesday of next week to meet and confer to discuss these topics. Please let us know your availability.

Thanks very much.

Erica

From: Kunze, Deanna <dkunze@nixonpeabody.com>

Sent: Tuesday, December 29, 2020 4:39 PM

To: Erica B. E. Rogers <EBRogers@wardandsmith.com>; NP Trademark Docketing <NPTM@nixonpeabody.com>

Cc: Angela P. Doughty <APD@wardandsmith.com>; trademarks@wardandsmith.com; Costellia, Jeffrey <JCostellia@nixonpeabody.com>; Weikert, Robert <rweikert@nixonpeabody.com>; Arnold, Lauren <larnold@nixonpeabody.com>; Washington Trademark <WTM@nixonpeabody.com>; Joseph A. Schouten <JAS@wardandsmith.com>; Grilli, Alexis <agrilli@nixonpeabody.com>; Howell, Tarae <THOWELL@nixonpeabody.com>

Subject: RE: Discovery of Opposition Nos. 91254427 and 91254428 filed by Motif Medical LLC; Our Refs. 080327-2, -66, and -74 (WS: 161593-00026; 00027)

Dear Ms. Rogers,

We are in receipt of your correspondence from yesterday, and we have conferred with our client regarding the same.

First, we provided the bates numbers yesterday, so that issue should be closed.

Second, Spectra will not be proceeding with the depositions noticed for the week of January 11th. The deposition notices are deficient in a number of ways, but most importantly, Motif failed to confer with Spectra on the Rule 30(b)(6) notices as required by the most recent updates to Rule 30(b)(6), rendering those notices moot.

We are disappointed in this situation. Spectra sought a meet-and-confer in November to discuss the status of discovery, including depositions, and we identified that trying to squeeze depositions in by January 18 would prove problematic, given the holidays and Covid-19 crisis. We believed a 60-day extension was most reasonable, given the Board's preference for either a 30-day or 60-day request, but Motif refused any extension in the *Sunday* December 6 correspondence sent by Mr. Schouten. Additionally, your reference to Motif's request for dates for the depositions in your correspondence below instead was just this statement, buried at least 4 paragraphs into Mr. Schouten's same email: "Please let us know when Ms. Humphries will be available during the week of January 11. We have been taking depositions remotely during Covid, so this should actually make scheduling easier."

Four days later, on December 10, you served notices, not just for Ms. Humphries's deposition, but also for an egregiously overbroad and disproportionate set of Rule 30(b)(6) depositions of the corporation, with **THIRTY-THREE** topics each.

We previously asked your team to agree to a short extension to relieve pressure during the holiday season and allow for preparing for depositions under those circumstances, which we believed would benefit both parties and the individuals involved in the matters. Your team first agreed to a 30-day extension then reneged on that and declined an extension altogether; therefore, we began making preparations with Ms. Humphries—the CEO of Spectra—to arrange her schedule for a deposition the week of January 10. Then, despite the prior meet-and-confer and our correspondence regarding scheduling, Motif served these highly inappropriate—and ineffective—Rule 30(b)(6) notices for depositions 30 days later, punctuated by the holiday season and in the middle of the Covid-19 crisis.

This matter is an opposition to two trademark registration applications. The only basis asserted is the alleged functionality of the claimed features. The discovery requests from Motif have gone far, far beyond this issue.

We would like to set a time to confer about a reasonable schedule going forward to finalize depositions, which will provide both parties opportunities to comply with Rule 30(b)(6) and avoid unnecessary expense. Please let us know your availability early next week. In the interim, for clarity, no Spectra witnesses will be appearing pursuant to these deficient deposition notices. Spectra reserves the right to further challenge the notices, but we object to them in their entirety for violations of TBMP 404.06, as well as failure to specify a valid time and place pursuant to Federal Rule of Civ. P. 30(b). For those notices issued pursuant to Fed. R. Civ. P. Rule 30(b)(6), we also object to Motif's failure to meet its requirements for reasonable particularity and conference. Additionally, the Rule 30(b)(6) notices are harassing, and we object generally that the noticed topics are not proportional to the issues in this matter (i.e. functionality) and vague, particularly with the use of the phrase "The facts and circumstances concerning." The following specific topics also are overbroad, not relevant, and, therefore, also not proportional: 1-12, 15-33. Several of the topics also specifically target legal conclusions and attorney-client privileged information, as well as call for speculation.

Again, we would like to set a meet-and-confer to discuss a reasonable process and timeframe to complete oral discovery in this matter—please let us know your availability early next week.

Best Regards,
Deanna Kunze



Deanna R. Kunze
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From: Erica B. E. Rogers <EBRogers@wardandsmith.com>
Sent: Monday, December 28, 2020 11:43 AM
To: NP Trademark Docketing <NPTM@nixonpeabody.com>
Cc: Angela P. Doughty <APD@wardandsmith.com>; trademarks@wardandsmith.com; Costellia, Jeffrey <JCostellia@nixonpeabody.com>; Weikert, Robert <rweikert@nixonpeabody.com>; Arnold, Lauren <larnold@nixonpeabody.com>; Washington Trademark <WTM@nixonpeabody.com>; Joseph A. Schouten <JAS@wardandsmith.com>; Grilli, Alexis <agrilli@nixonpeabody.com>; Kunze, Deanna <dkunze@nixonpeabody.com>; Howell, Tarae <THOWELL@nixonpeabody.com>
Subject: RE: Discovery of Opposition Nos. 91254427 and 91254428 filed by Motif Medical LLC; Our Refs. 080327-2, -66, and -74 (WS: 161593-00026; 00027)

Counsel,

It has been quite some time since we have heard from you. In light of that, we are following up on two items.

First, on December 2, you indicated that you would provide bates numbers for the documents responsive to Interrogatories 15, 17, 20, 21, and 23. Please provide us with that information by the end of this week, which would be a month since you promised to provide it.

Second, we have not heard anything from you in response to our December 6 request for available deposition dates. In addition, we have not received any objection or notice of conflict to the dates that we provide in our December 10 Notices of Deposition. Therefore, we have been preparing as if we will go forward with depositions on January 12 and 13. In light of this, please provide us with the names of your 30(b)(6) designees.

Finally, please find attached Opposer's Supplemental Initial Disclosures for Opposition Nos. 91254427 and 91254428.

We look forward to hearing from you.

Thank you,
Erica

From: Erica B. E. Rogers
Sent: Thursday, December 10, 2020 6:17 PM
To: NP Trademark Docketing <NPTM@nixonpeabody.com>
Cc: Angela P. Doughty <APD@wardandsmith.com>; trademarks@wardandsmith.com; Costellia, Jeffrey <JCostellia@nixonpeabody.com>; Weikert, Robert <rweikert@nixonpeabody.com>; Arnold, Lauren <larnold@nixonpeabody.com>; Washington Trademark <WTM@nixonpeabody.com>; Joseph A. Schouten <JAS@wardandsmith.com>; Grilli, Alexis <agrilli@nixonpeabody.com>; Kunze, Deanna <dkunze@nixonpeabody.com>; 'Howell, Tarae' <THOWELL@nixonpeabody.com>
Subject: RE: Discovery of Opposition Nos. 91254427 and 91254428 filed by Motif Medical LLC; Our Refs. 080327-2, -66, and -74 (WS: 161593-00026; 00027)

Counsel,

Please find attached Opposer's Notices of Deposition for Heidi Humphries and Mother's Milk, Inc. (pursuant to FRCP 30(b)(6)).

We inserted dates and times since we did not receive a response from you on availability. We will work with you on other dates to the extent the selected dates and times do not work. Please let us know.

Erica

From: Howell, Tarae <THOWELL@nixonpeabody.com>
Sent: Monday, December 7, 2020 7:45 PM
To: Erica B. E. Rogers <EBRogers@wardandsmith.com>
Cc: Angela P. Doughty <APD@wardandsmith.com>; trademarks@wardandsmith.com; Costellia, Jeffrey <JCostellia@nixonpeabody.com>; Weikert, Robert <rweikert@nixonpeabody.com>; Arnold, Lauren <larnold@nixonpeabody.com>; Washington Trademark <WTM@nixonpeabody.com>; Joseph A. Schouten <JAS@wardandsmith.com>; Grilli, Alexis <agrilli@nixonpeabody.com>; Kunze, Deanna <dkunze@nixonpeabody.com>
Subject: RE: Discovery of Opposition Nos. 91254427 and 91254428 filed by Motif Medical LLC; Our Refs. 080327-2, -66, and -74 (WS: 161593-00026; 00027)

Erica,

Thank you. Our second document production can be accessed using the link below. A password will be sent to you by separate email shortly.

Link: <https://spaces.hightail.com/receive/i9hAQyNRd8>

Expiration Date: Monday December 14, 2020

-Tarae



Tarae L. Howell

Associate

thowell@nixonpeabody.com

T 617-345-1249 | C 607-280-2442 | F 866-999-0837

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From: Erica B. E. Rogers <EBRogers@wardandsmith.com>

Sent: Monday, December 7, 2020 12:04 PM

To: Howell, Tarae <THOWELL@nixonpeabody.com>

Cc: Angela P. Doughty <APD@wardandsmith.com>; trademarks@wardandsmith.com; Costellia, Jeffrey

<JCostellia@nixonpeabody.com>; Weikert, Robert <rweikert@nixonpeabody.com>; Arnold, Lauren

<larnold@nixonpeabody.com>; Washington Trademark <WTM@nixonpeabody.com>; Joseph A. Schouten

<JAS@wardandsmith.com>; Grilli, Alexis <agrilli@nixonpeabody.com>; Kunze, Deanna <dkunze@nixonpeabody.com>

Subject: RE: Discovery of Opposition Nos. 91254427 and 91254428 filed by Motif Medical LLC; Our Refs. 080327-2, -66, and -74 (WS: 161593-00026; 00027)

Tarae,

Opposer's second and third document productions (MOTIF_0000356 – MOTIF_0003135) are available for download via the following link: <https://wardandsmith.box.com/s/bp4h708z84b13g69lvxs67jt1q8vekin>. The link will expire on December 18, 2020, and the password will be sent by separate email.

Erica

From: Joseph A. Schouten <JAS@wardandsmith.com>

Sent: Sunday, December 6, 2020 11:09 PM

To: Kunze, Deanna <dkunze@nixonpeabody.com>; Erica B. E. Rogers <EBRogers@wardandsmith.com>; Grilli, Alexis

<agrilli@nixonpeabody.com>

Cc: Angela P. Doughty <APD@wardandsmith.com>; trademarks@wardandsmith.com; Howell, Tarae

<THOWELL@nixonpeabody.com>; Costellia, Jeffrey <JCostellia@nixonpeabody.com>; Weikert, Robert

<rweikert@nixonpeabody.com>; Arnold, Lauren <larnold@nixonpeabody.com>; Washington Trademark

<WTM@nixonpeabody.com>

Subject: RE: Discovery of Opposition Nos. 91254427 and 91254428 filed by Motif Medical LLC; Our Refs. 080327-2, -66, and -74 (WS: 161593-00026; 00027)

Deanna,

Thank you for your time on the call and for your efforts to follow up on the issues we discussed. However, we do take issue with two items you have raised: (1) Applicants' apparent belief that they can withhold information now—under a baseless objection—that was requested months ago and then unilaterally change their mind at some later date and remove that objection; and (2) Applicants' belief that a second 60-day extension is appropriate.

First, we gave your client multiple extensions of time to respond to our written discovery. In addition, we agreed to a 60-day extension of the Schedule to accommodate these extensions. Your team represented that the extensions were necessary to get information from your client. We were happy to do that as a professional courtesy and to make sure you could provide complete and accurate responses.

However, Applicants' responses contained virtually no information that would have been needed from the client. Indeed, they contained virtually no information at all. They objected to interrogatories completely, simply parroted information already before the TTAB, and/or failed to provide the substance requested. After the first 4 interrogatories, there was not a single interrogatory that was answered sufficiently. Again, there were many interrogatories Applicants did not answer at all. Others gave incomplete, non-responsive, and evasive answers.

Your email suggests that parties may freely amend their answers and withdraw their objections at any time. What you are referring to is a duty to supplement answers. However, the duty to supplement discovery does not excuse a lack of good faith in responding to interrogatories in the first instance. In other words, Applicants cannot use its obligation to supplement interrogatories with new information that comes to light in order to delay providing responsive answers now.

It appears that Applicants' position is that they does not have to provide any information now. Rather, Applicants seem to be claiming that they can just decide to that provide information later, if and when they deem it convenient for them. That is not the way it works. Parties cannot object for the purpose of strategically withholding information and later determine that they want to provide it. If Applicants have decided that its objections are baseless (and they are), Applicants must remove them now and answer now. If Applicants have decided that its answers to other interrogatories are incomplete (and they are), Applicants must amend their answers now. Applicants do not get to sandbag us, see which way the wind the blows, and then simply change their mind as to how to respond to interrogatories.

We are entitled to be able to rely on the answers (and non-answers) to interrogatories. And, while Applicants may update them if new information comes to light, Applicants do not get to refuse to provide complete answers with readily available information now. Furthermore, it is not our job to point out deficiencies in Applicants' answers. We are entitled to let Applicants have deficient answers and use that against Applicants if we want.

We understand Applicants may disagree with this statement as to how discovery works. But we wish to be clear that this is how we believe that discovery is conducted in good faith. Parties simply do not make baseless objections to delay providing discoverable information. Parties further do not get to unilaterally withdraw their baseless objections once they have decided it is convenient for them to disclose the previously withheld information. Please take this as notice that we consider basically every Interrogatory after Interrogatory No. 4 to be deficient. We have told you which Nos. we insist be corrected. For any others, we will object to and move to exclude any "updates" that are not timely provided.

Second, regarding the supplementation of Interrogatory Nos. 5, 6, and 7, we noted and refuted your relevance objections. We further note the irony in your complaints about the relevance of those interrogatories in light of the "issues" raised you with respect to our discovery. Virtually all of those Requests you referenced appeared to be cut-and-paste from a different matter where likelihood of confusion was an issue. How are the geographic areas in which Opposer sells its products remotely relevant to any issue in this Opposition? Of course, they are not.

That being said, we still agreed to make sure we provided the requested information. That shows the difference between Opposer's approach to discovery versus Applicants.

Finally, we do not agree to any kind of extension and we are prepared to move forward on the current Schedule. We will be serving deposition notices for Ms. Humphries and a 30(b)(6) shortly. Please let us know when Ms. Humphries will be available during the week of January 11. We have been taking depositions remotely during Covid, so this should actually make scheduling easier.

Given Applicants' delay and failure to provide us with any information during the last 60-day extension, we find it hard to believe Applicants' would be "somewhat surprised" that we are unwilling to agree to another extension. We do wish to work with you cooperatively to see this matter through to its conclusion. But we simply cannot consent to another 60-day extension when Applicants already have wasted one 60-day extension.

Thanks very much.

Joe

From: Kunze, Deanna <dkunze@nixonpeabody.com>

Sent: Wednesday, December 2, 2020 3:51 PM

To: Erica B. E. Rogers <EBRogers@wardandsmith.com>; Grilli, Alexis <agrilli@nixonpeabody.com>

Cc: Angela P. Doughty <APD@wardandsmith.com>; Joseph A. Schouten <JAS@wardandsmith.com>; trademarks@wardandsmith.com; Howell, Tarae <THOWELL@nixonpeabody.com>; Costellia, Jeffrey <JCostellia@nixonpeabody.com>; Weikert, Robert <rweikert@nixonpeabody.com>; Arnold, Lauren <larnold@nixonpeabody.com>; Washington Trademark <WTM@nixonpeabody.com>

Subject: RE: Discovery of Opposition Nos. 91254427 and 91254428 filed by Motif Medical LLC; Our Refs. 080327-2, -66, and -74 (WS: 161593-00026; 00027)

Counsel,

Thank you for your follow-up correspondence and for your time on the call as well. As we discussed on the call, it is helpful to have the issues that you raised in writing, so we can discuss them with our client more productively.

As to your individual points on interrogatories below, we will provide document identifications to Rogs 15, 17, 20, 21, and 23. We also plan to make a supplemental production shortly. As to the remainder of the interrogatories, we will follow up with our client and see if we can provide a supplement.

As to your statement below regarding "a number of other interrogatories where we find the Responses deficient," we believe there is a little confusion. As an initial matter, although we understood the scheduled call was to be a discussion generally on both parties' discovery responses, we were nonetheless surprised by the level of hostility exhibited by Opposer's counsel during the call on Monday. Second, for clarity's sake, we are happy to address any alleged deficiencies that you wish to raise, but of course, we cannot address them if you do not raise them. Finally, with regard to your reference to being "prepared to let Applicants stand on their objections," with all due respect, this is not your decision. As is common in most adversarial processes, there will be discovery requests which you and your client deem necessary to follow-up on, and those that you do not. That decision is within your discretion. We are obligated to, and will, of course, meet and confer with you regarding any alleged deficiency, but ultimately, we may opt to supplement our response in spite of our objection, or we may choose to stand on our objection. Your client likewise has the same options for the deficiencies we raised. Very frankly, we're a long way from "standing on objections," as we just initially met and conferred this week.

Relatedly, we are somewhat surprised at your position on the extension; you wish to reserve the right to amend/supplement the list of issues with regard to discovery, you raised no discovery issues until Monday, but you are unwilling to agree to a 60-day extension of the schedule...this position seems inconsistent and somewhat illogical. We understand that your client wishes to resolve this matter quickly, but adversarial processes take time, and it seems as though your client is attempting to leverage the schedule to simply make this more difficult on the parties and counsel

over the holidays and during the Covid-19 crisis. We are not asking for a long extension—just 60 days—which is consistent with our only other requested extension in these proceedings.

We do not intend to make this process more difficult for anyone, and as we discussed on the phone, we thought a 45-day extension likely would be sufficient, but given that the Board's preferred practice is to generally grant extensions in 30-day increments, we believe the 60-day request is more prudent. The discovery process has moved slightly more slowly, due in large part to restrictions on travel that make client meetings more difficult, as well as restrictions on resources due to the Covid-19 crisis as many of us work from home due to state regulations and advisories. Further, as you know, one of the Applicants is based in Asia, which raises even greater logistical and communication challenges. With the concurrent rising severity of the Covid-19 crisis, coupled with the approaching holidays, we believe a 60-day extension is both warranted and prudent to avoid further requests for extensions. If your client will agree only to a 30-day extension, we will have to determine whether to file a motion for the additional time, so please let us know your decision no later than Monday, 12/7/2020.

Again, we will provide the document identifications and a supplemental document production in the next few days. If there are any issues that arise going forward, please reach out, and we'll be happy to set a time to discuss. We hope you're enjoying the beginning of the holiday season.

Best Regards,

Deanna Kunze



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From: Erica B. E. Rogers <EBRogers@wardandsmith.com>

Sent: Tuesday, December 1, 2020 4:43 PM

To: Grilli, Alexis <agrilli@nixonpeabody.com>

Cc: Angela P. Doughty <APD@wardandsmith.com>; Joseph A. Schouten <JAS@wardandsmith.com>; trademarks@wardandsmith.com; Howell, Tarae <THOWELL@nixonpeabody.com>; Costellia, Jeffrey <JCostellia@nixonpeabody.com>; Weikert, Robert <rweikert@nixonpeabody.com>; Arnold, Lauren <larnold@nixonpeabody.com>; Washington Trademark <WTM@nixonpeabody.com>; Kunze, Deanna <dkunze@nixonpeabody.com>

Subject: RE: Discovery of Opposition Nos. 91254427 and 91254428 filed by Motif Medical LLC; Our Refs. 080327-2, -66, and -74 (WS: 161593-00026; 00027)

Counsel,

We appreciate your time discussing discovery yesterday afternoon, which we summarize below.

First, we look forward to you addressing the deficiencies in Applicants' Responses and Objections to Opposer's Interrogatories and Requests for the Production of Documents ("RFP"). Please find the list of Interrogatories we discussed in bullet point below. We refer to the Interrogatories by the numbers in Opposition Proceeding No. 9125447, though the same deficiencies apply to Opposition Proceeding No. 91254428.

- [Interrogatory No. 5](#). Please provide a full and complete answer to the question. To paraphrase the explanation from our call, what designs, if any, did Applicant consider in creating/developing the challenged mark? Again, this Interrogatory is relevant, at least, to functionality and Applicants' acquired distinctiveness claims.
- [Interrogatory No. 6](#). Please provide a full and complete answer to the question, which ties to the answer to Interrogatory No. 5 both in subject matter and relevancy.
- [Interrogatory No. 7](#). Please provide a full and complete answer to the question, which ties to the answer to Interrogatory No. 5 both in subject matter and relevancy.
- [Interrogatory No. 15](#). Please provide the bates numbers for the specific documents that are responsive to Interrogatory No. 15 pursuant to Rule 33(d) of the FRCP.
- [Interrogatory No. 17](#). Please provide the bates numbers for the specific documents that are responsive to Interrogatory No. 17 pursuant to Rule 33(d) of the FRCP.
- [Interrogatory No. 19](#). Please provide a full and complete answer. The Interrogatory is not limited in scope to the United States.
- [Interrogatory No. 20](#). Please provide the bates numbers for the specific documents that are responsive to Interrogatory No. 20 pursuant to Rule 33(d) of the FRCP.
- [Interrogatory No. 21](#). Please provide the bates numbers for the specific documents that are responsive to Interrogatory No. 21 pursuant to Rule 33(d) of the FRCP.
- [Interrogatory No. 23](#). Please provide the bates numbers for the specific documents that are responsive to Interrogatory No. 23 pursuant to Rule 33(d) of the FRCP.

Please note the above is not a complete list of Interrogatory Responses for which Applicants' failed to respond and/or assert a proper objection. There were a number of other Interrogatories where we find the Responses deficient, but at this time, we are prepared to let Applicants stand on their objections. We respectfully reserve the right to amend/supplement this list.

Second, we look forward to receiving additional documents in response to Opposer's RFPs, and we intend to continue to seek those documents. To date, we have received thirty-eight documents.

Third, we acknowledge the issues raised on the phone regarding Opposer's Responses to Applicants' RFPs. We are working with our client to produce the remaining documents, and we intend to send a link to those documents within a week. We suspect these additional documents will resolve the issues raised on the phone, but we will discuss any gaps, to the extent gaps exist, after that point.

Finally, we acknowledge the request for an extension of discovery deadlines. Our client is not interested in a 60-day extension at this time, but we are open to considering an extension of a lesser amount of time. We will discuss this with our client and be in touch.

Erica

From: Erica B. E. Rogers

Sent: Tuesday, November 24, 2020 3:37 PM

To: 'Grilli, Alexis' <agrilli@nixonpeabody.com>

Cc: Angela P. Doughty <APD@wardandsmith.com>; Joseph A. Schouten <JAS@wardandsmith.com>; trademarks@wardandsmith.com; Howell, Tarae <THOWELL@nixonpeabody.com>; Costellia, Jeffrey <JCostellia@nixonpeabody.com>; Weikert, Robert <rweikert@nixonpeabody.com>; Arnold, Lauren