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

Proceeding	91254594
Party	Defendant David Critzman
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Date	05/17/2021
Attachments	Response to Motion to Compel 5-17-2021.pdf(213033 bytes) Exhibit 1.PDF(65835 bytes)

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

In the Matter of Serial No. 88/314,397

Mark: 

Filing Date: February 25, 2019
Publication Date: November 12, 2019

adidas AG, adidas America, Inc., and adidasInternational Marketing BV, Opposers,	)	
v.	)	Opposition No. 91254594
David Critzman, Applicant.	)	

APPLICANT'S RESPONSE TO OPPOSERS' MOTION TO COMPEL DISCOVERY RESPONSES

Applicant submits this Response to Opposers' Motion to Compel Discovery Responses, filed and served on the last day of the discovery period. Opposers' Motion is neither supported by the facts nor legally or equitably justified and it should, therefore, be denied in its entirety.

In truth, both parties have struggled with their discovery obligations because of the coronavirus pandemic. Opposers themselves have failed to satisfy their discovery obligations, e.g., they have not produced a single document and they have not answered interrogatories providing information which is expressly called for by the Rules. Thus, in bringing the instant Motion, Opposers come before the Board with unclean hands.

The Board should simply grant a six (6) month extension of the discovery period for the benefit of both parties. Applicant's counsel proposed that the parties agree to an extension of the discovery period, but Opposers' counsel did not respond. Rather, Opposer's counsel waited until the last day of the discovery period and filed and served the instant Motion, self-evidently hoping to gain an unfair advantage via such Motion practice. Such tactic should not be countenanced by

the Board, particularly in light of Opposers' own discovery failings and unclean hands.[1]

(1) NEITHER PARTY HAS PRODUCED A SINGLE DOCUMENT

It is incredulous that Opposers seek an order compelling Applicant to produce documents responsive to Opposers' First Requests for Production of Documents and Things to Applicant on the grounds that Applicant has not "produced a single document responsive to [their] requests" (page 3-4 of the Motion). Why "incredulous?" Because - - the Board will surely be surprised to learn - - Opposers themselves have also not produced a single document responsive to Applicant's requests.

How is that possible? It is simply the result of the general practice of adversary counsel in proceedings such as these. Specifically, both Opposers' counsel and Applicant's counsel expressed a willingness to exchange documents at a mutually convenient day and time. Opposers' counsel and Applicant's counsel simply have not come to an agreement upon a day and time for such an exchange.

Frankly, that Opposers' counsel would file their Motion seeking an order to compel Applicant to unilaterally produce documents when Opposers have themselves not produced any documents is the first indication of the disingenuous nature of Opposer's Motion.

(2) APPLICANT HAS ANSWERED – BUT OPPOSERS DON'T LIKE THE ANSWERS

Opposers seek an order compelling Applicant to supplement his answers to Opposers' First Set of Interrogatories to Applicant. The Board will naturally take cognizance of the explicit acknowledgement in Opposers' Motion that Applicant did – in fact - answer Opposers'

[1] Opposers' counsel tries to impugn Applicant's counsel's conduct by referring to the various follow up emails which they have sent. Applicant's counsel has similarly had to send various follow up emails to Opposers' counsel regarding Opposers' discovery failings – to no avail. If the Board believes it is needed, Applicant's counsel would be happy to provide the Board with exhibits reflecting the same. But, for now, Applicant's counsel opts not to burden the record with such exhibits - particularly since Applicant believes that the proper course of action for the Board is to deny Opposers' Motion in its entirety and grant the proposed six (6) month extension of the discovery period for the benefit of both parties.

interrogatories. Indeed, Applicant's answers are attached as Exhibit G to Opposers' Motion. The Board will take further cognizance of the fact that Opposers' Motion recites only eight (8) of the forty-one (41) interrogatories as not having been answered, i.e., interrogatories 4-9 and 11-12. What becomes clear from a review of the eight interrogatories, of Applicant's answers and finally of Opposers' arguments in the Motion is that Applicant did, in fact, answer even these eight interrogatories. Opposers just did not "like" Applicant's answers.

Each of these eight interrogatories asked for details regarding Applicant's business. However, Applicant's business was destroyed by the receipt of Opposer's February 18, 2020 letter asserting infringement of Opposers' Three-Stripe Mark by Applicant's Two-Stripe Mark. Such destruction occurred prior to the time when the interrogatories were served, let alone, prior to the time when answers to the interrogatories were due. The answers thus simply (and correctly) reflected the fact of such destruction of Applicant's business. Opposers' counsel expressly recognized the impact of the letter on Applicant's business in an email sent to Applicant's counsel on February 24, 2021[2] In sum, Opposers have, since at least as early February 24, 2021, had firsthand knowledge of the propriety of Applicant's answers. And yet, inexplicably, Opposers have still pursued the instant Motion and have asked the Board to compel answers - as if the destruction of Applicant's business which their conduct has wrought has not occurred.

Opposers seek to advance a makeweight argument in the Motion that information pertaining to certain "facts" has not been provided. Such argument is untrue, as can readily be gleaned from the information which Applicant's answers have provided as regards those "facts" (which information is set forth in italics below after each such "fact"):

> Fact #1 - Applicant's intended use for Applicant's Mark – *Applicant's intended use was in connection with the products covered by the application*.

[2] Attorney Nichole David Chollet wrote an email on February 24, 2021 indicating that Opposers knew that Applicant had stopped sales under the Mark – a copy of such email is attached hereto as Exhibit #1.

Fact #2 - the identification of products Applicant has sold or intends to sale[sic] – *the products which Applicant had sold and intended to sell were those covered by the application*.

Fact #3 - the dates on which Applicant has sold his products – *Applicant sold his products from the date of first use alleged in the application until the time when Applicant's business was destroyed by the receipt of Opposers' infringement letter*.

Fact #4 - Applicant's target consumers – *Applicant sold his products to the general populace until the time when Applicant's business was destroyed by the receipt of Opposers' infringement letter.*

Fact #5 - the identification of each person responsible for the creation of Applicant's Mark – *this allegation is irrefutable evidence of the disingenuous nature of Opposers' entire Motion, i.e., here is Applicant's response to Opposer's first interrogatory (which defined "adoption" to include "creation"):*

> RESPONSE: Applicant was responsible for the adoption [i.e., the "creation"] of Applicant's Mark.

Fact #6 - the identification of each person or advertising agency Applicant hired or intends to hire – *None*.

Fact #7 - the channels of trade through which Applicant intends to advertise, distribute, offer for sale, or sell products bearing Applicant's Mark – *the Internet, that is, until the time when Applicant's business was destroyed by the receipt of Opposers' infringement letter*.

Fact #8 - the ways on which Applicant's products have been advertised, promoted, or marketed – *the Internet, that is, until the time when Applicant's business was destroyed by the receipt of Opposers' infringement letter*.

That Opposers' counsel would file their Motion seeking an order to compel Applicant to "supplement" Applicant's answers to the eight (8) interrogatories under the circumstances noted above is the second indication of the disingenuous nature of Opposer's Motion.

(3) <u>APPLICANT'S DELAY IN SERVING OBJECTIONS RESULTED FROM EXCUSABLE ERROR</u>

Opposers ask the Board to find that Applicant's twenty-three (23) day delay (from October 17th to November 9th) in serving objections should result in a waiver of such objections. Such draconian relief is neither appropriate nor reasonable. The delay resulted from excusable error,

namely, from:

a. remote interaction between Applicant's counsel and docketing staff due to coronavirus pandemic working conditions; and

b. a miscommunication regarding the impact of the belated receipt of Opposers' discovery documents in Word format (as discussed in Opposers' Motion).

The best evidence that the delay was the result of excusable error is the fact that, as Opposers' Motion notes: "Applicant made no effort to communicate the tardiness of the responses, nor did Applicant reach out to adidas's counsel for an extension of the deadline." The reason there was no communication was precisely because, at the time when the responses were served, Applicant's counsel reasonably believed that the responses were timely served.

Significantly, Opposers have not even attempted to argue that they suffered any harm or prejudice as a result of such twenty-three day delay – nor could they. The delay should not prejudice Applicant's right to raise objections.

That Opposers' counsel would file their Motion seeking an order denying Applicant his right to raise objections because of an inconsequential twenty-three day delay is the third indication of the disingenuous nature of Opposer's Motion.

(4) <u>OPPOSERS ARE THE ONES WHO REFUSED TO ANSWER INTERROGATORIES</u>

A big stumbling block which the parties have encountered in connection with discovery is coming to an agreement regarding the manner of conducting depositions. To date, none have been conducted.

Applicant's counsel has sought to notice in-person depositions of Opposers' witnesses. Accordingly, Applicant's counsel has proffered interrogatories seeking information as to the addresses of specified witnesses pursuant to TBMP § 404.03(a) and 37 C.F.R. § 2.120(b), which require that "the deposition of a natural person shall be taken in the Federal judicial district where

the person resides or is regularly employed or at any place on which the parties agree by stipulation." Opposers' failure to provide this information is an impediment to Applicant's efforts to conduct these depositions.

Opposers' counsel has refused to comply with the obligation to provide such address information. Instead, Opposers' counsel has unilaterally declared that, because of the coronavirus pandemic, the depositions should be conducted via video conference.

With the recent positive developments regarding the coronavirus pandemic, it is clear that in-person depositions will once again soon be possible. Applicant thus asks that the Board to remind Opposers' counsel of their obligation to provide the information expressly called for by TBMP § 404.03(a) and 37 C.F.R. § 2.120(b) so that in-person discovery depositions can be orderly conducted during the proposed extension of the discovery period.

That Opposers' counsel would file their Motion while themselves refusing to answer interrogatories and provide the information expressly called for by TBMP § 404.03(a) and 37 C.F.R. § 2.120(b) is the fourth indication of the disingenuous nature of Opposer's Motion.

(5) <u>OPPOSERS COME TO THE BOARD WITH UNCLEAN HANDS</u>

Opposers come to the Board with unclean hands – not only because they:

(i) seek an order compelling production of documents when they, themselves, have not yet produced a single document; and

(ii) seek "supplementation" of Applicant's interrogatory answers when they, themselves, have not yet provided answers in accordance with the Rules, e.g., regarding the addresses of witnesses;

but, also, because they:

(iii) seek an extension of the discovery period solely for their benefit.

The Board should sua sponte take cognizance of the struggles which all parties appearing

before it over the last year have experienced because of the coronavirus pandemic and grant a six (6) month extension of the discovery period for both parties.

(6) CONCLUSION

For the reasons and based upon the grounds set forth above, Applicant respectfully submits that:

(i) Opposers' Motion to Compel should be denied in its entirety; and

(ii) the Board should extend the discovery period for the benefit of both parties for six (6) months.

Dated: May 17, 2021

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Applicant's Response to Opposers' Motion to Compel Discovery Responses was served on the Opposer on the date indicated below by forwarding said copy via email to Opposer's counsel of record:

Nichole Davis Chollet, Esq.
Kilpatrick Townsend & Stockton LLP
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Dated: May 17, 2021

/Russell D. Dize/
Russell D. Dize

EXHIBIT 1

From:	Chollet, Nicki
To:	Charles W. Grimes; Russell D. Dize
Cc:	Truelove, Jessica; Jones, Beth; Teilhaber, Kris; Stacie Kessler
Subject:	RE: adidas AG, et. al. v Critzman: Opp. No. 91254594
Date:	Wednesday, February 24, 2021 3:29:15 PM

For Settlement Purposes Only - Pursuant to Federal Rule 408

redacted

Hi Chuck,

[redacted] however, it appears that Mr. Critzman has moved to a new mark and applied to register the new mark. [redacted]

Best,
Nicki

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