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Filing date: **12/30/2020**

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

Proceeding	91264424
Party	Plaintiff Sitecore Corporation A/S
Correspondence Address	JULIE E HOFER DONAHUE FITZGERALD LLP 1999 HARRISON STREET 26TH FLOOR OAKLAND, CA 94612 UNITED STATES Primary Email: jhofer@donahue.com Secondary Email(s): bfriedman@donahue.com, pcheruvu@donahue.com, trademarks@donahue.com 510-451-3300
Submission	Motion to Compel Discovery or Disclosure
Filer's Name	Barbara L. Friedman
Filer's email	trademarks@donahue.com, bfriedman@donahue.com, pcheruvu@donahue.com, jhofer@donahue.com
Signature	/BLF/
Date	12/30/2020
Attachments	Sitecore Motion to Compel Initial Disclosures.pdf(162666 bytes) Cheruvu Declaration ISO Sitecores Motion to Compel Initial Disclosures.pdf(157335 bytes) Exhibits to Cheruvu Decl. ISO Motion to Compel.pdf(529764 bytes)

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

In the Matter of Application Serial No. 88/865,956
For the Mark SITECARE

SITECORE CORPORATION A/S,

Opposer,

-against-

SOUTHERN WEB, LLC,

Applicant.

Opposition No. 91,264,424

OPPOSER’S MOTION TO COMPEL

Pursuant to Rule 26 of the Federal Rules of Civil Procedure, TBMP § 411.01, and Title 37, Section 2.120 of the Code of Federal Regulations, Opposer Sitecore Corporation A/S (“Sitecore” or “Opposer”) respectfully moves the Board for an order compelling Applicant Southern Web, LLC (“Applicant”) to serve Initial Disclosures.

A motion to compel is proper when a party fails to serve initial disclosures. TBMP § 411.01. The deadline for both parties to serve initial disclosures was December 4, 2020. This motion is timely as it is filed within thirty (30) days after the deadline to serve initial disclosures. *Id.*; 37 C.F.R. § 2.120(f).

I. INTRODUCTION

A. Factual Background

On August 26, 2020, Sitecore filed its Notice of Opposition against registration of the SITECARE mark, Serial No. 88/865,956, by Applicant. (1 TTABVUE.) On August 26, 2020, the Board set the trial dates on the following schedule:

Time to Answer 10/5/2020

Deadline for Discovery Conference 11/4/2020

Discovery Opens 11/4/2020

Initial Disclosures Due 12/4/2020

Expert Disclosures Due 4/3/2021
Discovery Closes 5/3/2021
Plaintiff's Pretrial Disclosures 6/17/2021
Plaintiff's 30-day Trial Period Ends 8/1/2021
Defendant's Pretrial Disclosures 8/16/2021
Defendant's 30-day Trial Period Ends 9/30/2021
Plaintiff's Rebuttal Disclosures 10/15/2021
Plaintiff's 15-day Rebuttal Period Ends 11/14/2021
Plaintiff's Opening Brief Due 1/13/2022
Defendant's Brief Due 2/12/2022
Plaintiff's Reply Brief Due 2/27/2022
Request for Oral Hearing (optional) Due 3/9/2022

(2 TTABVUE.)

On October 5, 2020, Applicant filed its Answer to Sitecore's Notice of Opposition. (4 TTABVUE.) On October 30, 2020, the parties completed the discovery conference via telephone. (Declaration of Padmini Cheruvu in Support of Opposer's Motion to Compel ("Cheruvu Decl."), ¶ 2.) On December 4, 2020 Sitecore served its Initial Disclosures on Applicant via email. (*Id.* at ¶ 3, A.) Applicant's deadline to serve its Initial Disclosures on Sitecore was December 4, 2020. (2 TTABVUE.) To date, Sitecore has not received Applicant's Initial Disclosures or any explanation for Applicant's failure to serve Initial Disclosures. (Cheruvu Decl., ¶ 4.)

On December 15, 2020, Sitecore served Applicant with its first set of discovery requests via email to Applicant's counsel Russell Sandidge. (Cheruvu Decl., ¶ 5, Exh. B.) In that same email, Sitecore's counsel initiated a good faith meet and confer regarding Applicant's failure to serve its Initial Disclosures. (*Id.*) Sitecore's counsel stated the following: "[w]e have not received Southern Web, LLC's Initial Disclosures, which should have been served by December 4, 2020. Please let us know when we can expect to receive the Initial Disclosures as we would like to resolve the issue in advance of our January 4, 2021 deadline to file a Motion to Compel the Initial Disclosures." (*Id.*) As of the date of this Motion, Sitecore's counsel has not received any response from Applicant's counsel to her December 15, 2020 email. (*Id.*)

On December 21, 2020, Sitecore's counsel again emailed Applicant's counsel regarding

Applicant's failure to (1) serve its Initial Disclosures and (2) respond to the meet and confer email dated December 15, 2020. (Cheruvu Decl., ¶ 6, Exh. C.) Sitecore's counsel informed Applicant's counsel that if Sitecore did not receive Applicant's Initial Disclosures by December 28, 2020, Sitecore would be forced to file a Motion to Compel. (*Id.*) As of the date of this Motion, Sitecore's counsel has not received any response from Applicant's counsel to her December 21, 2020 meet and confer email. (*Id.*)

On December 29, 2020, after not receiving Applicant's Initial Disclosures or a response to her meet and confer emails dated December 15, 2020 and December 21, 2020 email, Sitecore's counsel called Applicant's counsel to discuss the situation. (Cheruvu Decl., ¶ 7.) Sitecore's counsel was not able to reach Mr. Sandidge and instead left a voicemail regarding Applicant's failure to (1) serve its Initial Disclosures and (2) respond to any communications from Sitecore's counsel regarding the Initial Disclosures. (*Id.*) In the voicemail, Sitecore's counsel again stated that Sitecore would be forced to file a Motion to Compel if Applicant did not serve its Initial Disclosures. (*Id.*) As of the date of this Motion, Sitecore's counsel has not received any response to her December 29, 2020 voicemail nor any explanation for Applicant's failure to serve its Initial Disclosures. (*Id.*)

II. Argument

As Applicant has failed to serve the required Initial Disclosures, which were due on December 4, 2020, Applicant should be compelled to serve its Initial Disclosures without further delay. *See* 37 C.F.R. § 2.120(f); *see also Luster Products Inc. v. Van Zandt*, 104 USPQ2d 1877, 1878-79 (TTAB 2012) (motion to compel is available remedy for failure to serve, or insufficient, initial disclosures).

Sitecore has satisfied its obligation under 37 C.F.R. § 2.120(f) to make a good faith effort, by conference or correspondence, to resolve the matter with Applicant. Sitecore has more than adequately provided Applicant with opportunities to comply with the Board's rules, first by providing Applicant with additional time to serve its Initial Disclosures after the deadline had passed, and second by attempting to meet and confer with Applicant regarding its failure to serve Initial Disclosures. All of Sitecore's attempts to meet and confer in order to resolve the issue have been ignored by Applicant. Therefore, Sitecore believes it has more than adequately satisfied its duty to resolve the issue without the Board's involvement. Sitecore now has no choice but to move for an order compelling Applicant to provide its Initial Disclosures. Given

Applicant's refusal to comply with the rules of discovery, Sitecore must enlist the Board's assistance in compelling Applicant to provide the Initial Disclosures to which Applicant is entitled.

III. Conclusion

For the foregoing reasons, Sitecore respectfully requests that the Board compel Applicant to serve its Initial Disclosures.

Dated: December 30, 2020

Respectfully submitted,

DONAHUE FITZGERALD LLP

By: /Padmini Cheruvu/

Julie E. Hofer, CA Bar No. 152185
Barbara L. Friedman, CA Bar No. 208735
Padmini Cheruvu, CA Bar No. 301292
1999 Harrison Street, 26th Floor
Oakland, California 94612

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Telephone: (510) 451-3300

Facsimile: (510) 451-1527

Attorneys for Opposer

SITECORE CORPORATION A/S

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and complete copy of the foregoing Sitecore's Motion to Compel has been served by electronic mail on December 30, 2020, upon the following:

Russell Sandidge
Russell L. Sandidge Intellectual Property Law
2310 Peachford Road
Atlanta, GA 30338
rlsandidge@att.net

By: /Padmini Cheruvu/

Julie E. Hofer, CA Bar No. 152185
Barbara L. Friedman, CA Bar No. 208735
Padmini Cheruvu, CA Bar No. 301292
1999 Harrison Street, 26th Floor
Oakland, California 94612
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Telephone: (510) 451-3300
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For the Mark SITECARE

SITECORE CORPORATION A/S,

Opposer,

-against-

SOUTHERN WEB, LLC,

Applicant.

Opposition No. 91,264,424

**DECLARATION OF PADMINI CHERUVU IN SUPPORT OF
OPPOSER'S MOTION TO COMPEL**

I, Padmini Cheruvu, declare as follows:

1. I am an attorney at law duly admitted to practice before all the courts of the State of California. I am an attorney with the law firm of Donahue Fitzgerald LLP, counsel of record herein for Opposer Sitecore Corporation A/S ("Sitecore"). I have personal knowledge of the matters set forth herein and if called as a witness could and would competently testify thereto.

2. On October 30, 2020, counsel for Applicant Southern Webb, LLC ("Applicant") and I completed the required discovery conference via telephone.

3. On December 4, 2020, I served Sitecore's Initial Disclosures on Applicant via email. A true and correct copy of the email is attached hereto as **Exhibit A**.

4. To date, neither Sitecore nor I have received Applicant's Initial Disclosures nor any explanation for Applicant's failure to serve Initial Disclosures.

5. On December 15, 2020, I served Applicant with Sitecore's first set of discovery requests via email to Applicant's counsel Russell Sandidge. In that same email, I initiated a good faith meet and confer regarding Applicant's failure to serve its Initial Disclosures. As of the date of this declaration, I have not received any response from Applicant's counsel to my December 15, 2020 email. A true and correct copy of the December 15, 2020 email is attached hereto as

Exhibit B.

6. On December 21, 2020, I again emailed Applicant's counsel regarding Applicant's failure to (1) serve its Initial Disclosures and (2) respond to the meet and confer email dated December 15, 2020. As of the date of this declaration, I have not received any response from Applicant's counsel to my December 21, 2020 email. A true and correct copy of the December 21, 2020 email is attached hereto as **Exhibit C**.

7. On December 29, 2020, after not receiving Applicant's Initial Disclosures or a response to my meet and confer emails dated December 15, 2020 and December 21, 2020 email, I called Applicant's counsel to discuss the situation. I was not able to reach Mr. Sandidge and instead left a voicemail regarding Applicant's failure to (1) serve its Initial Disclosures and (2) respond to any communications from Sitecore's counsel regarding the Initial Disclosures. (*Id.*) In the voicemail, I again stated that Sitecore would be forced to file a Motion to Compel if Applicant did not serve its Initial Disclosures. (*Id.*) As of the date of this declaration, I have not received any response to my December 29, 2020 voicemail or any explanation for Applicant's failure to serve its Initial Disclosures.

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct. Executed at San Francisco, California on December 30, 2020.



Padmini Cheruvu

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and complete copy of the foregoing Declaration of Padmini Cheruvu in Support of Sitecore's Motion to Compel has been served by electronic mail on December 30, 2020, upon the following:

Russell Sandidge
Russell L. Sandidge Intellectual Property Law
2310 Peachford Road
Atlanta, GA 30338
rlsandidge@att.net

By: /Padmini Cheruvu/

Julie E. Hofer, CA Bar No. 152185
Barbara L. Friedman, CA Bar No. 208735
Padmini Cheruvu, CA Bar No. 301292
1999 Harrison Street, 26th Floor
Oakland, California 94612
Email: jhofer@donahue.com
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Telephone: (510) 451-3300
Facsimile: (510) 451-1527

EXHIBIT A

From: [Padmini Cheruvu](#)
To: [Russell Sandidge](#)
Cc: [Barbara L. Friedman](#); [Julie E. Hofer](#)
Subject: RE: Sitecore Corporation A/S v. Southern Web, LLC (TTAB Opposition No. 91264424)
Date: Friday, December 04, 2020 10:26:49 AM
Attachments: [Sitecore's Initial Disclosures.pdf](#)

Russell,

Your email below essentially admits that there may be some initial customer confusion but that your client does not see that as an issue and therefore is not willing to make any changes to the SITECARE mark. If that is the position that your client is taking, we do not see room for compromise.

Since we are proceeding with the Opposition, attached please find Sitecore's Initial Disclosures.

Best,
Padmini

Padmini Cheruvu, Esq.
Donahue Fitzgerald LLP



Representing Innovators for Over 135 Years

1999 Harrison Street, 26th Floor, Oakland, CA 94612 | pcheruvu@donahue.com | [510.451.3300](tel:510.451.3300)

Important: This email may contain confidential or privileged information. If it is not meant for you, please do not retain, read, copy, or disseminate any part of it, and please immediately notify us. Thank you.

EXHIBIT B

From: [Padmini Cheruvu](#)
To: [Russell Sandidge](#)
Cc: [Barbara L. Friedman](#); [Julie E. Hofer](#)
Subject: RE: Sitecore Corporation A/S v. Southern Web, LLC (TTAB Opposition No. 91264424)
Date: Tuesday, December 15, 2020 11:20:05 AM
Attachments: [Sitecore's Interrogatories, Set One.pdf](#)
[Sitecore's RFAs, Set One.pdf](#)
[Sitecore's RFPs, Set One.pdf](#)

Russell,

Attached please find Sitecore's first set of discovery requests.

Additionally, we have not received Southern Web, LLC's Initial Disclosures, which should have been served by December 4, 2020. Please let us know when we can expect to receive the Initial Disclosures as we would like to resolve the issue in advance of our January 4, 2021 deadline to file a Motion to Compel the Initial Disclosures.

Best,
Padmini

Padmini Cheruvu, Esq.
Donahue Fitzgerald LLP



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Important: This email may contain confidential or privileged information. If it is not meant for you, please do not retain, read, copy, or disseminate any part of it, and please immediately notify us. Thank you.

EXHIBIT C

From: [Padmini Cheruvu](#)
To: [Russell Sandidge](#)
Cc: [Barbara L. Friedman](#); [Julie E. Hofer](#)
Subject: RE: Sitecore Corporation A/S v. Southern Web, LLC (TTAB Opposition No. 91264424)
Date: Monday, December 21, 2020 10:46:40 AM

Russell,

I'm following up on my email below regarding Southern Webb LLC's Initial Disclosures, to which I have not received a response. If we do not receive Southern Webb's Initial Disclosures by December 28, 2020, we will be forced to file a Motion to Compel.

Best,

Padmini

Padmini Cheruvu, Esq.

Donahue Fitzgerald LLP



Representing Innovators for Over 135 Years

1999 Harrison Street, 26th Floor, Oakland, CA 94612 | pcheruvu@donahue.com | [510.451.3300](tel:510.451.3300)

Important: This email may contain confidential or privileged information. If it is not meant for you, please do not retain, read, copy, or disseminate any part of it, and please immediately notify us. Thank you.

From: Padmini Cheruvu
Sent: Tuesday, December 15, 2020 11:20 AM
To: Russell Sandidge
Cc: Barbara L. Friedman; Julie E. Hofer
Subject: RE: Sitecore Corporation A/S v. Southern Web, LLC (TTAB Opposition No. 91264424)

Russell,

Attached please find Sitecore's first set of discovery requests.

Additionally, we have not received Southern Web, LLC's Initial Disclosures, which should have been served by December 4, 2020. Please let us know when we can expect to receive the Initial Disclosures as we would like to resolve the issue in advance of our January 4, 2021 deadline to file a Motion to Compel the Initial Disclosures.

Best,

Padmini

Padmini Cheruvu, Esq.

Donahue Fitzgerald LLP