

TTAB

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



08-16-2002

U.S. Patent & TMOs/TM Mail Rcpt Dt. #58

Goldshield Group plc,  
Petitioner,

v.

David M. Mayer,  
Registrant.

Cancellation No. 32,627

Reg. Nos. 1,962,216 and  
1,962,217

02 AUG 2002  
TRADEMARK TRIAL AND  
APPEAL BOARD  
ART: 58

**PETITIONER'S BRIEF IN OPPOSITION TO MOTION TO COMPEL DISCOVERY**

Goldshield Group plc ("Petitioner"), the party in the position of plaintiff in Cancellation No. 32,627, requests that the Motion to Compel Discovery filed by Registrant be denied for the reasons set forth below.

1. Registrant's Second Set of Interrogatories and Request for Production of Documents and Things to Petitioner did not include a proper Certificate of Service as required by Fed.R.Civ.P. 5(d).
2. The issue is moot since Petitioner is serving herewith its responses to the second set of interrogatories and document requests.

Registrant cites 37 CFR § 2.119 as requiring a certificate of service only for papers filed in the Patent and Trademark Office. 37 CFR § 2.119(a) requires service on the other party of every paper filed in the Patent and Trademark Office in inter parties cases with specific exceptions, but does not mention papers not being filed. 37 CFR § 2.120(a) applies the Federal Rules of Civil Procedure to cancellation proceedings. Fed.R.Civ.P. 5(d) requires a certificate of service for all papers after the complaint.

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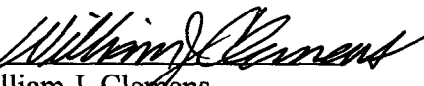
As can be seen on page 4 of Exhibit A attached to Registrant's Brief, the certificate of service incorrectly identifies the paper being served and includes the wrong date of service. Registrant easily could have corrected the defective certificate of service in response to the prompt facsimile (Exhibit B, Registrant's Brief) message on June 3 from Petitioner's attorney, but instead waited six weeks before threatening to file a Motion to Compel based upon the undefined requirement "if you do not to these discovery requests within the next 3 business days".

The Declaration and exhibits attached to Registrant's Brief show that Registrant's attorney did not make a good faith effort to resolve the issue presented in the Motion as required by 37 CFR § 2.120(e)(1). Consequently, Registrant's Motion should be denied.

Based upon service in connection with Registrant's Motion, Petitioner is serving concurrently responses and objections to Registrant's Second Set of Interrogatories and Request for Production of Documents and Things to Petitioner. Consequently, the issue raised by Registrant's Motion is moot and the Motion should be denied.

RESPECTFULLY SUBMITTED,


MacMillan, Sobanski & Todd, LLC

By   
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Date: August 13, 2002

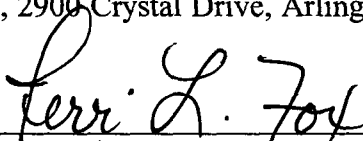
*CERTIFICATE OF SERVICE*

I hereby certify that a true copy of the foregoing  
PETITIONER'S BRIEF IN OPPOSITION TO MOTION TO COMPEL DISCOVERY  
was served upon counsel for Registrant by mailing the same, first-class mail, to Tal S. Benschar,  
Esq., Kalow & Springut, LLP, 488 Madison Avenue, New York, NY 10022, this 14<sup>th</sup> day of  
August, 2002.

  
William J. Clemens  
Attorney for Petitioner

*CERTIFICATE OF MAILING*

I hereby certify that this document is being deposited with the United States Postal  
Service as first class mail in an envelope addressed to: BOX TTAB NO FEE, Assistant  
Commissioner For Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513 on the date  
set forth below.

  
\_\_\_\_\_  
Terri L. Fox

Date of signature and deposit – August 14, 2002

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