500-158

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

BENETTON GROUP, S.p.A

Opposer,

v.

NORDIC GEAR, INC.,

Applicant.

03-17-2003

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #34

Opposition No.: 106,726 (parent)
Opposition No.: 110,355
Opposition No. 150,498
Cancellation No. 40,209

OPPOSER'S STATEMENT OF GOOD FAITH EFFORTS TO RESOLVE DISCOVERY DISPUTE PURSUANT TO THE BOARD'S JANUARY 15, 2003 ORDER

Opposer, Benetton Group S.p.A. ("Opposer"), pursuant to the Board's January 15, 2003 Order, hereby provides its statement setting forth the additional good faith efforts Opposer's counsel has undertaken to resolve the discovery disputes that necessitated the filing of the motions to compel that are currently pending in the above-referenced proceedings.[1]

[1] In footnote 1 of the TTAB's January 15, 2003 Order, the Board states that Opposer has not filed a request for a change of legal representation from Oblon Spivak to Sughrue Mion PLLC, and thus correspondence will be sent to Oblon. Opposer attaches hereto a copy of the "Notice of Appearance and Substitution of Counsel," with date-stamped filing receipt, showing that such a request was filed in Consolidated Opposition Nos. 106,726 and 110,355 on November 2, 2001. See Attachment A. As reflected in the TTAB records, Sughrue Mion PLLC has always been listed as counsel of record in Opposition No. 150,498 and Cancellation No. 40,209. Therefore, Sughrue Mion PLLC is the attorney of record in this consolidated matter, and all correspondence should directed to it and not Oblon.

BACKGROUND FACTS & STATEMENT OF GOOD FAITH EFFORTS

As set forth in the motions to compel discovery, Applicant, Nordic Gear Inc. ("Applicant"), failed to respond to the Opposer's discovery requests. Prior to filing these motions, Opposer's counsel contacted Applicant's counsel by mail and/or telephone to obtain the responses. As set forth in detail in the motions to compel, Applicant's counsel failed to respond to Opposer's request for responses. Copies of the letters Opposer's counsel sent to Applicant's counsel requesting discovery responses were attached as exhibits to the motions to compel.

Several months after the filing of Opposer's motions to compel, Applicant's counsel sought to withdraw as counsel in the above-referenced proceedings. On January 15, 2003, the Board granted the request for withdrawal, and gave Applicant 30 days to appoint new counsel. That Order also required Opposer's counsel to attempt to resolve this dispute with Applicant or its new counsel, and submit a statement setting forth such efforts within 60 days of the Order.

Opposer's counsel received no communication from Applicant that it had appointed new counsel during the 30 day period prescribed in the Board's Order. To confirm that Applicant had not hired new counsel, and thus could be contacted directly, on February 21, 2003, Opposer's counsel contacted the TTAB Interlocutory Attorney and confirmed that the Applicant had not notified the TTAB of hiring new counsel.

Immediately thereafter, on February 21, 2003, Opposer's counsel called Applicant's President, Richard Sontag, the Applicant's contact person, to discuss the discovery dispute. Opposer's counsel was told that Mr. Sontag would be out of the office until March 2, 2003.

On March 10, 2003, Opposer's counsel again called Mr. Sontag to discuss the discovery dispute. Mr. Sontag was not available, and Opposer's counsel left him a very detailed voicemail message stating the reason for the call and the need to resolve the discovery dispute before the

March 17, 2003 deadline set forth in the Board's January 15, 2003 Order. Opposer's counsel requested that Mr. Sontag return the telephone call immediately.

On March 12, 2003, after receiving no response, Opposer's counsel again called Mr. Sontag to discuss the discovery dispute. Opposer's counsel was told that Mr. Sontag would be out of the office until Monday, March 17, 2003. Opposer's counsel told the person answering the telephone at Mr. Sontag's place of business that the call was about a pending trademark dispute with an upcoming deadline on March 17, and whether someone else might be able to discuss these issues. Opposer's counsel was told that only Mr. Sontag could speak on such issues, and the best course of action would be to leave a voicemail, as Mr. Sontag checks his voicemail when he is away from the office. Accordingly, Opposer's counsel left another very detailed voicemail message stating the reason for the call and the need to resolve the discovery dispute before the March 17, 2003 deadline set forth in the Board's January 15, 2003 Order.

As a follow-up to that telephone message, on March 12, 2003, Opposer's counsel faxed and mailed a letter to Mr. Sontag summarizing the need to discuss the discovery dispute by March 17, 2003, and requesting that Mr. Sontag contact Opposer's counsel immediately. See Attachment B.

As of the date of this Motion, Monday, March 17, 2003, Opposer's counsel has not received any communication whatsoever from Mr. Sontag or anyone else on behalf of the Applicant.

Mr. Sontag made the following representation in his October 22, 2002 letter submitted in support of its counsel's request for withdrawal:

> I have received all of the files relating to these Proceedings and have been updated by Tucker & Latifi of the status of these Proceedings to ensure that the rights of Nordic Gear are not in any way prejudiced. . . . **I am capable of and willing to appear and represent Nordic Gear in these Proceedings.**

See Attachment C (emphasis added).

Accordingly, since at least October 22, 2002, Applicant has been aware that motions to compel discovery responses are pending in the above-captioned proceedings because of Applicant's failure to provide any discovery responses, and its failure to cooperate in resolving this issue. The Board's January 15, 2003 Order, which was mailed directly to Mr. Sontag, re-iterated that motions to compel discovery are pending and that the parties should try to resolve the discovery dispute.

Applicant, however, has completely failed to make any attempt to resolve the discovery dispute. As set forth in the motions to compel, the dispute is Applicant's failure to provide **any** discovery responses whatsoever. This is not a case where the party receiving discovery requests has made some effort to respond, and the dispute is over whether the responses were sufficient. This is a case where the receiving party made no effort whatsoever, and provided absolutely no excuse for its violation of the discovery rules. Indeed, not only did Applicant's prior counsel fail to respond to Opposer's counsel's requests for the discovery responses, but Applicant did not even bother to oppose or respond to Opposer's motion to compel. Putting aside the unsuccessful good faith efforts Opposer's counsel made to obtain Applicant's responses before the filing of the motions (as documented therein), Applicant has done absolutely nothing to resolve this dispute since the filing of these motions in July 2002. It has not made any attempt to contact Opposer's counsel to discuss this matter. It has not returned any of Opposer's counsel's messages. It has not filed anything with the Board to justify its refusal to answer Opposer's timely and legally sufficient discovery requests.

In contrast, Opposer's counsel has made a number of good faith attempts to resolve this dispute, all to no avail. Opposer's counsel attempted to revolve the discovery dispute with Applicant, filed the Motions to Compel when these efforts failed, and upon the Board's request, has made additional good faith efforts to resolve this dispute with the Applicant, as discussed above and reflected in Attachment B hereto. Given Applicant's refusal since at least July 2002 to make any

attempt to contact the Opposer or the TTAB to resolve the discovery dispute, or at least make a proffer as to why it has failed to respond to proper discovery requests, it seems clear that the Applicant will not provide discovery responses without an Order from the Board.

Opposer respectfully submits pursuant to Trademark Rule 2.120(e) that it has made good faith efforts by correspondence and telephone, both before filing its motions to compel and since the Court's January 15, 2003 Order, to resolve the discovery dispute with Applicant, but has been unable to resolve the dispute. Therefore, a decision on Opposer's motions to compel is proper, and for the reasons stated therein, the motions should be granted.

Respectfully submitted,
BENETTON GROUP S.p.A.

By: _____

W. Mack Webner
Dale R. Harburg
Paul M. Higgins
Attorneys for Opposer
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037-3202
Telephone: (202) 663-7495
Facsimile: (202) 293-7860

Date: March 17, 2003

CERTIFICATE OF SERVICE

I, Paul M. Higgins, Esq., hereby certify that on March 17, 2003 a true copy of the foregoing OPPOSER'S STATEMENT OF GOOD FAITH EFFORTS TO RESOLVE DISCOVERY DISPUTE PURSUANT TO THE BOARD'S JANUARY 15, 2003 ORDER was sent via U.S. mail, postage prepaid to:

Richard L. Sontag
Nordic Gear, Inc.
C/o Turtle Fur Co.
146 Industrial Park Drive
Morrisville, VT 05661

Paul M. Higgins, Esq.

84

PLEASE DATE STAMP AND RETURN AFTER FILING

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Matter of:	)	
	)	
Benetton Sportsystem S.p.A.	)	
	)	
Opposer	)	
v.	)	Consolidated Opposition Nos.
	)	106,726 and 110,355
Nordic Gear, Inc.	)	
	)	
Applicant	)	

Paper(s) Filed: 1. Notice of Appearance and Substitution of Counsel

SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3213
Telephone: (202) 663-7495
Facsimile: (202) 293-7860

DOCKET NO.: 500159
ATTORNEY: W. Mack Webner

Date: November 6, 2001

(Please return this receipt to Annette Spriggs - 6th Floor. Thank you.)

EXHIBIT
A

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

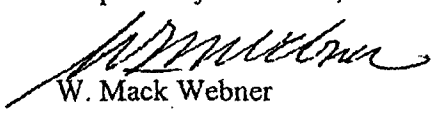
Benetton Sportsystem S.p.A.	)	
	)	
Opposer	)	
	)	CONSOLIDATED OPPOSITIONS
v.	)	Nos. 106726 and 110355
	)	
Nordic Gear, Inc.	)	
	)	
Applicant	)	

NOTICE OF APPEARANCE AND SUBSTITUTION OF COUNSEL

The undersigned W. Mack Webner herewith enters his appearance as counsel for Opposer Benetton Sportsystem S. p. A. Please substitute the undersigned as counsel of record in this consolidated opposition and send all correspondence and orders of the Board to the undersigned at the following address:

W. Mack Webner, Esq.
Sughrue Mion PLLC
2100 Pennsylvania Ave.
Washington D.C. 20037 -3213

Respectfully submitted,



W. Mack Webner

CERTIFICATE OF SERVICE

I certify that the foregoing document entitled **NOTICE OF APPEARANCE AND SUBSTITUTION OF COUNSEL** was served on Applicant on November 6, 2001, by United States First Class Mail postage prepaid at the following addresses:

Robert L. Tucker, Esquire
Afschineh Latifi, Esquire
Nordic Gear, Inc.
160 East 84th Street
New York, NY 10028
Tel: (212) 472-6262

W. MackWebner

Sughrue
SUGHRUE MION, PLLC

2100 Pennsylvania Avenue, NW
Washington, DC 20037-3213
T 202.293.7060
F 202.293.7860
www.sughrue.com

Paul M. Higgins
T (202) 663-7384
phiggins@sughrue.com

March 12, 2003

VIA FACSIMILE/FIRST CLASS MAIL
Fax No. (802) 888-3025

Richard L. Sontag
Nordic Gear, Inc.
C/o Turtle Fur Co.
146 Industrial Park Drive
Morrisville, VT 05661

Re: *Benetton Group S.P.A. v. Nordic Gear, Inc.*
Consolidated Opp'n No. 106,726
Our Ref: 500158

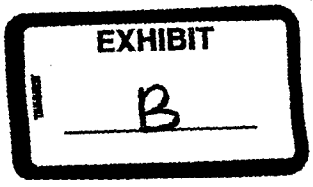
Dear Mr. Sontag:

This is a follow-up to my telephone messages to you on Monday, March 10, 2003 and today regarding the above-referenced matter.

As I explained in my telephone messages, we represent Benetton Group S.P.A. in four Opposition and Cancellation proceedings against your company Nordic Gear, Inc. that are currently pending before the Trademark Trial and Appeal Board ("TTAB"), United States Patent and Trademark Office. As you already know from the TTAB's January 15, 2003 Order, which was mailed to you directly, we have filed motions to compel discovery in these cases. These motions were filed last July after our repeated attempts to obtain discovery responses from your prior counsel were ignored.

Because your prior counsel, Tucker & Latifi, LLP, have withdrawn from the case, and you apparently have not hired replacement counsel, I am writing this letter to you directly asking that you provide the responses to our discovery requests. As you have represented to the TTAB that you are competent to take over the handling of this matter, you should be aware of the discovery responses we are seeking, and be in a position to discuss this issue.

Accordingly, please contact me at once to discuss your outstanding discovery responses. As I have had difficulty getting in touch with you, I request that you contact me. I called you initially on February 21, 2003 and was told you were out of the office until March 2, 2003. I called you on March 10, 2003 and left a very detailed message explaining the situation and the urgency of your response, as I need to file a statement with the TTAB by Monday, March 17, 2003, setting forth the additional efforts I have made to obtain your discovery responses. After receiving no return call, I called you again today, at which time I was informed that you will be



out of the office until March 17, 2003. Your receptionist told me that you will be checking your voicemail while you were out and therefore I should leave you a message. I once again left a very detailed telephone message explaining the situation.

As I need to inform the TTAB by Monday, March 17, 2003 regarding the status of your discovery responses, I respectfully ask that you call me immediately, or in any case, prior to March 17th.

Very truly yours,

Paul M. Higgins

TUCKER & LATIFI, LLP

COUNSELORS AT LAW

915 N. MANSFIELD AVENUE
LOS ANGELES, CA 90038
(323) 606-4190
(646) 349-2436 FAX

ROBERT L. TUCKER
AFSCHINEH LATIFI (NY, CA & D.C.)

ALI R. LATIFI

160 EAST 84TH STREET
NEW YORK, NEW YORK 10028
(212) 472-6262
(212) 744-6509 FAX

100 JERICHO QUADRANGLE
SUITE 236
JERICHO, NY 11753
(516) 942-5300
(516) 932-6050 FAX

October 25, 2002

BY EXPRESS MAIL
Box TTAB
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513
Attn: Karyn K. Ryan, Esq.

Re: Benetton Group v. Nordic Gear, Inc. – Various Cancellation & Opposition Proceedings

Dear Ms. Ryan:

In accordance with your *Order* dated October 2, 2002, attached is a letter signed by the president of Nordic Gear, Inc., the Applicant/Respondent, in Opposition Nos. 106726 and 110,355 and Cancellation Proceeding Nos. 150498 and 40,209 (the "Proceedings") confirming (i) receipt of all files relating to these Proceedings; (ii) that Applicant/Respondent's rights are not in any way prejudiced by counsel's withdrawal from the Proceedings; and, (iii) that counsel is not in possession of any unearned fees relating to the Proceedings.

Finally, Applicant/Respondent has now requested that all correspondence relating to these Proceedings be mailed to Nordic Gear, Inc. c/o Turtle Fur Company, 146 Industrial Park Drive, Morrisville, Vermont 05661.

Based on the attached letter, request is respectfully made that counsel's motion of September 3, 2002 for withdrawal be granted.

Sincerely,

AFSCHINEH LATIFI

cc: W. Mack Webner, Esq.
Dale R. Harburg, Esq.
David Mermelstein, Esq. (By Regular Mail)

EXHIBIT
C

NORDIC GEAR, INC.
PO Box 1010
Morrisville, VT 05661

October 22, 2002

BY EXPRESS MAIL
Karyn K. Ryan, Esq.
Box TTAB
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Re: Benetton Group v. Nordic Gear, Inc.

Dear Ms. Ryan:

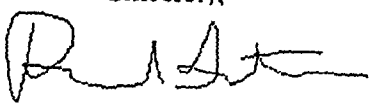
I am the president of Nordic Gear, Inc. ("Nordic Gear") and as such am fully familiar with all of the facts and circumstance surrounding the pending opposition and cancellation proceedings. A Notice of Withdrawal was filed at my express request by the law firm of Tucker & Latifi, LLP in September 2002 withdrawing as counsel to Nordic Gear in Opposition Proceeding Nos. 106726, 110355 and 150498 and Cancellation Proceeding No. 40,209 (the "Proceedings").

I have received all of the files relating to these Proceedings and have been updated by Tucker & Latifi of the status of these Proceedings to ensure that the rights of Nordic Gear are not in any way prejudiced. Further, Tucker & Latifi is not in possession of any unearned fees. I am capable of and willing to appear and represent Nordic Gear in these Proceedings.

Thus, in accordance with your Order dated October 2, 2002, please allow this letter to serve as my express request to allow the law firm of Tucker & Latifi, LLP to withdraw as my counsel in these Proceedings.

Please feel free to contact me if you have any questions regarding this matter.

Sincerely,



Richard L. Sontag

CERTIFICATE OF SERVICE

I hereby certify that true and correct copies of the foregoing letters from Afschineh Latifi, Esq. and Applicant/Respondent Nordic Gear, Inc. were served by Express Mail on this 25th day of October 2002 upon Opposer/Petitioner's attorneys:

W. Mack Webner, Esq.
Dale R. Harburg, Esq.
SUGHRUE MION PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3213

Dated: October 25, 2002

Afschineh Latifi

Sughrue
SUGHRUE MION, PLLC

2100 Pennsylvania Avenue, NW
Washington, DC 20037-3213
T 202.293.7060
F 202.293.7860

www.sughrue.com

Paul M.Higgins
T (202) 663-7384
phiggins@sughrue.com

March 17, 2003

VIA HAND DELIVERY

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Re: *Benetton Group S.P.A. v. Nordic Gear, Inc.*
Consolidated Opp'n No. 106,726
Our Ref: 500158

Sir:

The following documents are enclosed for appropriate action by the Trademark Trial and Appeal Board of the U.S. Patent and Trademark Office:

1. Opposer's Statement of Good Faith Efforts to Resolve Discovery Dispute Pursuant to the Board's January 15, 2003 Order; and

2. One (1) Return Receipt.

It is respectfully requested that the receipt be stamped with the date of filing of these documents and that it be returned to our courier.

It is believed that no fee is due for the Opposer's Statement of Good Faith Efforts to Resolve Discovery Dispute Pursuant to the Board's January 15, 2003 Order. However, if a fee is due, the Commissioner is hereby authorized to charge such fee to our Deposit Account No. 19-4880.

Very truly yours,

Paul M. Higgins

PMH/ejh

Enclosures