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

Proceeding	92044624
Party	Defendant The Brand Experience LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD

CHRISTOPHER CARNOVALE,

Petitioner,

-against-

THE BRAND EXPERIENCE, LLC.

Registrant.

Canc. No. 92044624

THE BRAND EXPERIENCE, LLC'S OPPOSITION TO PETITIONER'S MOTION TO
COMPEL

RESERVATION OF RIGHTS

The Brand Experience reserves all objections to the admissibility of any information disclosed in response to these requests. Inadvertent disclosure of any documents shall not be a waiver of any claim of privilege, work-product protection or any other exemption from disclosure. These responses are based on information within the Brand Experience's knowledge, possession and control as of this date. The Brand Experience reserves the right to amend or supplement these responses as further information becomes available during the course of the proceeding.

GENERAL OBJECTIONS

The Brand Experience objects to the Petitioner's Requests to the extent that they:

1. Seek the disclosure of documents that are protected by the attorney-client privilege, work-product doctrine or any other applicable privilege or protection.
2. Seek to impose obligations beyond the requirements of the Rules of the Trademark and Trial Appeals Board.

3. Seek the disclosure of documents that are confidential and proprietary business information in the absence of a protective order that has been agreed upon by the parties to the above-captioned proceeding, and entered by the Board.

INTERROGATORIES

2. Identify all employees of Registrant or any other persons who have had responsibility for the marketing, advertising, or sale of any products or services under Registrant's Marks.

REGISTRANT'S PRIOR RESPONSE

Mark Schmidt is the sole person responsible for marketing Registrant's Marks.

PETITIONER'S ARGUMENT

This answer is clearly insufficient, because Registrant failed to identify the person(s) responsible for the advertising or sale of any products. The information requested is relevant to this proceeding, is discoverable and should be provided. If there has been no advertising or sale, Registrant should so indicate. Otherwise, it should be compelled to provide the information sought.

REGISTRANT'S REPLY

Mark Schmidt was/is/remains the person responsible for the sale and advertising of all SunSafe® products.

4. Describe the facts related to the acquisition or selection of Registrant's Marks, including without limitation the names of persons involved in and the date of the selection.

REGISTRANT'S PRIOR RESPONSE

Registrant conceived the marks as a “visualizing statement” of how the Registrant’s Brand of sun protective apparel, “SUNSAFE”, will benefit the consumer. This is a tried and true marketing practice employed by global Brands such as “Coke – The Real Thing”, and “IBM – Solutions for a Small Planet”. In the Registrant’s Case, “SUNSAFE – THE SUNSCREEN THAT WON’T RUB OFF”, helps explain an important benefit of sun protective apparel. Likewise, “SUNSAFE – SUNSCREEN KIDS WANT TO WEAR” offers parents a solution to convincing their kids to wear sunscreen.

PETITIONER'S ARGUMENT

TBE failed to identify any fact related to the acquisition or selection of the marks, including the identity of any person(s) involved and the date(s) of the selection or acquisition. If no rights in the mark were acquired from another party, you should so state and you should indicate who selected the mark. The information sought is relevant to this proceeding and it is discoverable.

REGISTRANT'S REPLY

TBE Stands by its statements in Interrogatory No 4. and additionally states:

- The Marks were 100% originally conceived based on the marketing principles described, namely a Brand Name, “SUNSAFE”, supported by a product claim/benefit/explanation (in this case, all the Marks in question)
- Because the Marks were 100% originally conceived based on the principles described, no “acquisition”, no “other party” was ever involved – or necessary
- It is perhaps helpful to put place a Context under which these Marks were conceived. At the time, this was a new business launch for sun protective apparel under the SUNSAFE Brand. No “marketing departments” or “sales departments” existed. From the beginning, these Marks were conceived and selected to represent the benefits of SUNSAFE® Branded products. In their origin, SUNSAFE® branded products focused exclusively on children.

6 . Describe the facts related to the date(s) and manner in which each of Registrant's Marks was first used in connection with the sale or advertising of any products or services specifying the place(s) of said first sale, the first customer (s), the manner in which Registrant's Marks were first displayed in connection with said first sale, and the nature of the products or services first sold under' Registrant's Marks.,

REGISTRANT'S PRIOR RESPONSE

The dates and actual samples of materials which used Registrant's Marks are contained in the respective Trademark Applications Registrant filed for these Marks.

PETITIONER'S ARGUMENT

The Applications referred to by Registrant contain only a claimed date of first use referring generally to the entire class, and only one specimen of use. Registrant failed to identify how each of Registrant's Marks was first used in connection with each product, the date and place of said first sale, the first customer, and the nature of the products first sold and the manner the mark was displayed in that first sale.

REGISTRANT'S REPLY

- Acceptable specimens are tags, labels, instruction manuals, containers, photographs, etc that show the Marks on the goods or packaging. For the record, multiple specimens were submitted with each filing
- Further, mock-ups, specimens, marketing materials displaying the Marks were developed and in-use prior to any filing date or registration
- Samples of use on the product are care labels (sewn into EACH product) and hang tags (affixed to EACH garment).
- Samples of marketing/PR/Sales materials are magazine pieces, catalogs, direct mail pieces, etc.

- Sample of Each of these categories are being supplied as part of readily available documentation

7. State whether the use of any of Registrant's Marks has ever been discontinued for a period of one year with respect to any of the products listed in Registrant's Registrations.

REGISTRANT'S PRIOR RESPONSE

The registrant has not actively used Registration No 2,384,600 for the past few years in actual marketing and sales materials.

8. If Registrant ever discontinued use of Registrant's Marks with respect to any of the products listed in its registrations, identify the period of time, if any, during which Registrant discontinued and resumed the sale of any such products under Registrant's Marks.

REGISTRANT'S PRIOR RESPONSE

The registrant has had high profile, continuous use of Registrations No's 2,477,694; and 2,593,603 since their first use in the USA.

PETITIONER'S ARGUMENT

These answers are not responsive since they refer to use of registrations and the interrogatories inquire as to use of marks. Registrant was asked to identify any period of time in which use of a mark was discontinued.

REGISTRANT'S REPLY

The following Marks have been in "high profile, continuous" use since before their Trademark Filings and Registrations: THE SUNSCREEN THAT WON'T RUB OFF®, and SUNSCREEN KIDS WANT TO WEAR®.

Equally so the Mark, "THE 50+ SUNSCREEN THAT WON'T RUB OFF", with one exception: it's active use had been suspended on/about 2005 when a complete review of

marketing materials was conducted in preparation for a nation-wide mailing of approximately 130,000 catalogs and associated marketing initiatives.

None of the Marks have ever been abandoned.

9. Identify all persons who designed or made any materials or other items on which Registrant's Marks have ever been displayed, including without limitation any labels, hangtags, packages, containers, bags, clothing, signs, advertisements, brochures, sales literature, catalogs, artwork, Websites, or other materials.

REGISTRANT'S PRIOR RESPONSE

The information requested is a trade secret or otherwise confidential. Petitioner objects to the disclosure of the above information in the absence of a confidentiality agreement between the parties.

Petitioner further objects to this interrogatory as requesting information which is not relevant to the issues in this proceeding and not reasonably calculated to lead to the discovery of admissible evidence.

PETITIONER'S ARGUMENT

Petitioner pointed out to Registrant that this objection is groundless and unacceptable because a standardized protective agreement is in place in this proceeding, under the TTAB Rules. However, Registrant still refused to provide the information. Registrant also objected on the ground that that this Interrogatory allegedly requests information that is not relevant and not reasonably calculated to lead to the discovery of admissible evidence. This objection is clearly also groundless. Individuals who prepared materials on which the marks have been displayed, may have relevant information concerning how, where and when the marks have been used.

REGISTRANT'S REPLY

The information requested represents a "supplier directory", which has taken years to build up and which, does not wish to disclose on the basis that it is confidential, proprietary information.

This is all the more important given the inquiring party is/represents a competitor clearly wishing to access the US Market.

The Petitioner points out that TTAB Manual of Procedure states:

412.03 Signature of Protective Order

Stipulated protective orders may be signed either by the parties thereto, or by their attorneys, or by both. However, once a proceeding before the Board has been finally determined, the Board has no further jurisdiction over the parties thereto. Thus, it may be advisable for both the parties and their attorneys to sign a stipulated protective order, so that it is clear that they are all bound thereby; that they have created a contract which will survive the proceeding; and that there may be a remedy at court for any breach of that contract which occurs after the conclusion of the Board proceeding.

The Registrant is unaware of any protective agreement that will remain binding following the termination of this proceeding.

Registrant further maintains that that this information is not relevant to this proceeding. The continuous market presence of physical product and advertising/PR exhibiting the Marks is evidence that, indeed, these Marks were and remain in use in commerce.

Finally, while many present day suppliers remain active in the production of materials with these Marks, several early suppliers have gone out of business, were independent contractors who have since moved and/or even gone on to something else in their careers, etc. In short, not all parties would be contactable, nor are there whereabouts/current situations known to the registrant.

10. Describe the facts related to any investigation conducted with respect to Registrant's Marks, including any trademark search to determine whether other persons had used or registered a mark similar to Registrant's Marks and the records examined in any such search,

11. Identify all persons who ever engaged in any communication including the communication of any opinion relating to any investigation or trademark search relating to Registrant's Marks.

REGISTRANT'S PRIOR RESPONSE

Trademark Search Specialists of FRC, Lawyers of USPTO, and Mark Schmidt.

PETITIONER'S ARGUMENT

In its answer Registrant failed to identify these individuals, except for Mark Schmidt.

REGISTRANT'S REPLY

Federal Research Corporation (FRC), based in Washington DC, Trademark Search Specialists of FRC, Lawyers of USPTO, and Mark Schmidt. The trademark search results have or will be provided to Registrant, which represents all of the information in the Registrant's possession.

13. Identify the purchasers or classes of purchasers to whom Registrant has sold any products or services under' Registrant's Marks.

REGISTRANT'S PRIOR RESPONSE

Trade Customers (who purchase SUNSAFE products for sale to their customers), and Direct Retail Customers who purchase SUNSAFE products directly from a SUNSAFE catalog, web site, or promotional event.

PETITIONER'S ARGUMENT

This answer is clearly insufficient because it fails to properly identify the classes of purchasers. The terms "Trade Customers" is vague because it could encompass any type of retailers, including clothing wholesalers, high end department stores, clothing retailers, online stores, outlets, discount department stores. Registrant should identify which type of retailers purchased its products. The term "direct retail customers" does not identify a class of purchasers, but merely anyone who ever purchased SUNSAFE products not for resale.

REGISTRANT'S REPLY

"Trade Customers" include many types of retailers, including clothing wholesalers, department stores, clothing retailers, online stores, outlets, specialty stores, hotels, resorts, etc

"Direct retail customers" are those end users who purchased products directly from the SUNSAFE® web site, catalog, or "public event" (any event, such as a Baby Fair or Melanoma Foundation gathering at which products were directly being sold to the public)

15. Identify on an annual basis for each year since Registrant's Marks was first used, the amount of revenue generated by the sale of products or services under Registrant's Marks.

REGISTRANT'S PRIOR RESPONSE

The information requested is a trade secret or otherwise confidential. Petitioner objects to the disclosure of the above information in the absence of a confidentiality agreement between the parties.

16. Identify on an annual basis for each year since Registrant's Marks first appeared in advertisements the dollar amount spent on advertising products or services offered under Registrant's Marks.

REGISTRANT'S PRIOR RESPONSE

The information requested is a trade secret or otherwise confidential. Petitioner objects to the disclosure of the above information in the absence of a confidentiality agreement between the parties.

PETITIONER'S ARGUMENT

As already discussed above, under TTAB Rules a standardized confidentiality agreement is automatically in place in any cancellation proceeding, including this one. Accordingly, Registrant objection is unwarranted and should be withdrawn.

REGISTRANT'S REPLY

The information requested is a trade secret or otherwise confidential. Petitioner objects to the disclosure of the above information in the absence of a confidentiality agreement between the parties. This is all the more important when the inquiring party is/represents a competitor clearly wishing to access the US Market. "A standardized confidentiality agreement" is insufficient security.

20. Describe the facts relating to any market research, including any focus group study or survey relating to Registrant's Marks or the goods or services sold under the marks.

REGISTRANT'S PRIOR RESPONSE

The information requested is a trade secret or otherwise confidential. Petitioner objects to the disclosure of the above information in the absence of a confidentiality agreement between the parties.

PETITIONER'S ARGUMENT

As already discussed above, under TTAB Rules a standardized confidentiality agreement is automatically in place in any cancellation proceeding, including this one.

REGISTRANT'S REPLY

The information requested is a trade secret or otherwise confidential. Petitioner objects to the disclosure of the above information in the absence of a confidentiality agreement between the parties. This is all the more important when the inquiring party is/represents a competitor clearly wishing to access the US Market. "A standardized confidentiality agreement" is insufficient security.

21. Identify all oral or written agreements relating to Registrant's Marks, including without limitation all licenses, assignments, co-existence agreements, partnership agreements, or joint venture agreements. (Petitioner identifies this as Interrogatory 22.)

REGISTRANT'S PRIOR RESPONSE

The information requested is a trade secret or otherwise confidential. Petitioner objects to the disclosure of the above information in the absence of a confidentiality agreement between the parties.

PETITIONER'S ARGUMENT

As already discussed above, under TTAB Rules a standardized confidentiality agreement is automatically in place in any cancellation proceeding, including this one.

REGISTRANT'S REPLY

The information requested is a trade secret or otherwise confidential. Petitioner objects to the disclosure of the above information in the absence of a confidentiality agreement between the parties. This is all the more important when the inquiring party is/represents a competitor clearly wishing to access the US Market. "A standardized confidentiality agreement" is insufficient security.

25. Describe all trade channels through which products or services have been sold under Registrant's Marks, including any retail stores, wholesale outlets, Internet websites, direct mail operations or other trade channels.,

REGISTRANT'S PRIOR RESPONSE

The information requested is a trade secret or otherwise confidential. Petitioner objects to the disclosure of the above information in the absence of a confidentiality agreement between the parties.

PETITIONER'S ARGUMENT

As already discussed above, under TTAB Rules a standardized confidentiality agreement is automatically in place in any cancellation proceeding, including this one.

REGISTRANT'S REPLY

The information requested is a trade secret or otherwise confidential. Petitioner objects to the disclosure of the above information in the absence of a confidentiality agreement between the parties. This is all the more important when the inquiring party is/represents a competitor clearly wishing to access the US Market. "A standardized confidentiality agreement" is insufficient security.

27. Identify each state or other geographic area where products bearing each of Registrant's Marks are currently being sold.

RESPONSE

Registrant continues to sell and/or advertise products under Registrant's Marks in all 50 United States, most US Territories and Internationally (including Canada)

PETITIONER'S ARGUMENT

This answer is insufficient and unacceptable, and seems to contradict at least one previous answer given by Registrant. In its answer to Interrogatory No. 7, Registrant admitted that it "has not actively used" the mark identified in Reg. No. 2,384,600 "for the past few years". Petitioner pointed out to Registrant that its answer to this interrogatory was deficient and that it contradicted other answers, but Registrant failed to answer to Petitioner's remarks and to amend or supplement its answer to this interrogatory. Because the information sought is relevant and discoverable, Registrant should be compelled to answer to this interrogatory with a clear indication, for each of the Registrant's Marks, of the states and geographic areas where products under said mark are currently sold.

REGISTRANT'S REPLY

The following Marks have been in "high profile, continuous" use since before their Trademark Filings and Registrations: THE SUNSCREEN THAT WON'T RUB OFF®, and SUNSCREEN KIDS WANT TO WEAR®.

Equally so the Mark, "THE 50+ SUNSCREEN THAT WON'T RUB OFF", with one exception: it's active use had been suspended on/about 2005 when a complete review of marketing materials was conducted in preparation for a nation-wide mailing of approximately 130,000 catalogs and associated marketing initiatives.

None of the Marks have ever been abandoned.

28. Identify representative retail outlets or other locations in each state identified in the preceding interrogatory where products bearing Registrant's Marks are currently being sold.

REGISTRANT'S PRIOR RESPONSE

The information requested is a trade secret or otherwise confidential. Petitioner objects to the disclosure of the above information in the absence of a confidentiality agreement between the parties.

PETITIONER'S ARGUMENT

As already discussed above, under TTAB Rules a standardized confidentiality agreement is automatically in place in any cancellation proceeding, including this one.

REGISTRANT'S REPLY

The information requested is a trade secret or otherwise confidential. Petitioner objects to the disclosure of the above information in the absence of a confidentiality agreement between the parties. This is all the more important when the inquiring party is/represents a competitor clearly

wishing to access the US Market. “A standardized confidentiality agreement” is insufficient security.

30. Identify each manufacturer that made each type of product currently being sold under each of Registrant's Marks.

REGISTRANT’S PRIOR RESPONSE

The information requested is a trade secret or otherwise confidential. Petitioner objects to the disclosure of the above information in the absence of a confidentiality agreement between the parties.

Petitioner further objects to this interrogatory as requesting information which is not relevant to the issues in this proceeding and not reasonably calculated to lead to the discovery of admissible evidence.

PETITIONER’S ARGUMENT

As already discussed above, Registrant's objection is unjustified and should be withdrawn, since under TTAB Rules a standardized confidentiality agreement is automatically in place in any cancellation proceeding, including this one. Registrant also objected alleging that the information sought is not relevant to the issues in this proceeding. This objection is invalid and should be withdrawn. The information sought is relevant to this proceeding because it may lead because it may lead to discoverable information relating to the use of Registrant's Marks, the nature of the products sold under Registrant's Marks and the extent of use.

REGISTRANT’S REPLY

The information requested is a trade secret or otherwise confidential. Petitioner objects to the disclosure of the above information in the absence of a confidentiality agreement between the parties. This is all the more important when the inquiring party is/represents a competitor clearly wishing to access the US Market. “A standardized confidentiality agreement” is insufficient security.

Registrant maintains his objection to this interrogatory as requesting information which is not relevant to the issues in this proceeding and not reasonably calculated to lead to the discovery of admissible evidence.

31. Describe all facts on which Registrant bases each defense that Registrant intends to assert in the pending cancellation petition.

REGISTRANT'S RESPONSE

The registrant has had high profile, continuous use of Registrations No's 2,384,600; 2,477,694; and 2,593,603 since their first use in the USA. These Marks have been promoted nationally in the USA through major national publications, television programs, a joint education program with a National Medical Association, and Trade Shows to name just a few venues in which the Registrant has invested. Any active competitor in the "sun protective apparel market space" would have noticed and been aware of Registrant's active use of these Marks prior to June 17, 2004, which is the date that petitioner filed a trademark application with the USPTO.

Prior to formally filing the Mark "THE SUNSCREEN THAT WON'T RUB OFF", Registrant engaged a third party research firm, Federal Research Corporation (FRC), based in Washington DC, to research whether this Mark was used in commerce in the USA. This research was conducted across 3 levels: The Federal Trademark Register, State Trademark Registers, and what FRC titles a "Common Law" Search, which included researching national yellow pages, newspapers and the internet. Their Research turned up NO conflicting Marks. They also filed the Mark on behalf of Registrant on April 6, 2000 (Exhibit D).

This result was further reinforced through USPTO's own trademark process, in which no external objections were raised at any time during the publication process prior to the Mark being issued on Aug 14, 2001.

A search for SUNSCREEN THAT NEVER WEARS OFF revealed many web retailers using this Mark (exhibit F). Significantly, none of these retailers are based in the US. Several are based in Canada.

No evidence of a "substantial investment in advertising and promoting its goods" was uncovered by third party research conducted in 2001. The evidence in 2006 suggests only Canadian exposure

The evidence in the Market clearly demonstrates Registrant's use of the Mark in the USA.

Registrant had NO KNOWLEDGE of the Petitioner's prior use of their alleged mark. Third Party Research conducted prior to filing of the Registrant's Mark turned up NO use of THE SUNSCREEN THAT NEVER WEARS OFF! (Exhibit D).

Registrant Challenges Petitioner to prove "interstate commerce" and dollar volume of interstate commerce.

Registrant further highlights the web site registration dates of both companies. This is significant because the internet is a major driver/contributor to "interstate commerce", especially for "small businesses" which registrant believes characterizes both parties in this case.

www.sunveil.com was created in the ICANN Register on Sept 24, 1998.

www.sunsafe.com was created in the ICANN Register on May 28, 1998

Registrant's web site pre-dates the registration of www.sunveil.com by almost 4 months, demonstrating Registrant's priority through this channel in interstate commerce.

Petitioner and Registrant are not affiliated or connected in any way. Petitioner has had zero contact with Registrant (and vice versa) other than through proceedings with the USPTO. As such, and based on no credible market evidence of priority or investment in advertising and goodwill, Petitioner is in no position to "approve" or "grant permission" for anything.

Petitioner states that "upon information and belief", Registrant adopted "the registered marks" ... "to cause confusion among purchasers..." Registrant states, for the record, that Petitioner's Mark was never a "registered mark" at any time in Registrant's adoption and use of Registrant's Marks. Registrant had NO KNOWLEDGE of the Petitioner's prior use of their alleged mark.

Registrant further maintains its priority and use of these marks in the USA. Third Party Research demonstrated NO use of “THE SUNSCREEN THAT NEVER WEARS OFF!” in the marketplace in

PETITIONER’S ARGUMENT

Registrant alleges that it "has had a high profile, continuous use of Registrations Nos. 2,384,600; 2,477,694; and 2,593,603 since their first use in the USA". However, in other answers (see answer to Interrogatory No. 7), Registrant admits that the mark identified in Reg. No. 2,384,600 has not been used for years. These answers are contradictory and must be revised. Moreover, Registrant alleges that "no evidence of a substantial investment in advertising and promoting its goods was uncovered by third party research conducted in 2001". However, Registrant never identified any third-party research conducted in 2001. Petitioner pointed out these inconsistencies to Registrant and asked Registrant to revise its answers to previous interrogatories concerning searches by providing information identifying the search referred to above, including without limitation the identity of the person(s) who conducted the search, the nature of the search, the date, and any document relating or referring to the search.

REGISTRANT’S REPLY

Please refer to additional statements in regard to to interrogatories 7&8 and 11 above. Additionally, a search conducted by FRC in 1997 did not reveal the presence of SunVeil in the American Market.

DOCUMENT REQUESTS

PETITIONER'S ARGUMENT

Request No. 1 sought all documents that Registrant was required to identify in its responses to Petitioner's first set of interrogatories, or from which it derived information used in preparing those responses.

REGISTRANT'S RESPONSE

To the extent this request demands production of information Registrant has identified as a trade secret or otherwise confidential, Petitioner objects to the disclosure of the above information in the absence of a confidentiality agreement between the parties. This is all the more important when the inquiring party is/represents a competitor clearly wishing to access the US Market. "A standardized confidentiality agreement" is insufficient security.

Additionally, at least some of the documents the Registrant has produced to Petitioner are responsive to this request.

PETITIONER'S ARGUMENT

Requests No. 2 sought documents referring or relating to the organizational structure of Registrant, including without limitation any articles of incorporation, by-laws, and lists of Registrant's current or former officers, directors and managerial employees and/or descriptions of their duties and responsibilities.

REGISTRANT'S RESPONSE

Registrant objects to this request for documents as requesting information which is not relevant to the issues in this proceeding and not reasonably calculated to lead to the discovery of admissible evidence.

PETITIONER'S ARGUMENT

Request No. 3 sought all documents referring or relating to the date(s) and manner in which Registrant or any of its current or former agents first learned of the use or intended use of Petitioner's Mark.

REGISTRANT'S RESPONSE

The Registrant first learned of Petitioner's Mark when it was discovered Registrant's marks were cancelled. All documents relating to such cancellation are readily available through USPTO TDR and TTAB View.

PETITIONER'S ARGUMENT

Request No. 4 sought all documents referring or relating to any partnership agreements or joint venture agreements referring or relating to Registrant's Marks that was entered into between Registrant and any other person or entity.

REGISTRANT'S RESPONSE

Registrant objects to this request for documents as requesting information which is not relevant to the issues in this proceeding and not reasonably calculated to lead to the discovery of admissible evidence.

PETITIONER'S ARGUMENT

Request No. 5 sought all documents referring or relating to any of Registrant's current or former employees, managers and agents and/or descriptions of their duties and responsibilities.

REGISTRANT'S RESPONSE

Mark Schmidt is the sole officer of Registrant.

PETITIONER'S ARGUMENT

Request No. 6 and 7 sought all documents relating to the selection, creation, design, decision to register, or registration of Registrant's Marks including, any minutes or notes from any meetings or any e-mails in which such topics were discussed, and all documents referring or relating to any trademark search or evaluation of any records conducted by or on behalf of Registrant to determine whether other persons had used or

sought registration of Registrant's Marks, or any word or phrase similar to Registrant's Marks, or whether Registrant's use of Registrant's Marks would conflict with the rights of any person or entity.

REGISTRANT'S RESPONSE

Registrant objects to this request for documents as requesting information which is not relevant to the issues in this proceeding and not reasonably calculated to lead to the discovery of admissible evidence.

Additionally, at least some of the documents the Registrant has produced to Petitioner are responsive to this request.

Notwithstanding Registrant's objection, Registrant is currently attempting to obtain further documentation relating to searches performed on behalf of Registrant and will provide such documentation, if any such exist,

PETITIONER'S ARGUMENT

Request No. 8 and 9 sought representative samples of all documents or other materials on which Registrant's Marks have been displayed, and any correspondence, purchase orders, records of payment or invoices sent to or received from any printer or other person involved in the creation, of such materials. Registrant merely produced a handful of what appear to be newspaper advertisements, and a photocopy of a label. The documents do not refer to all of the marks and Registrant failed to produce any other document responsive to Request Nos. 8 and 9.

REGISTRANT'S RESPONSE

Registrant objects to this request for documents as overly broad and burdensome. Notwithstanding its objection, in the interest of expediting litigation, Registrant will provide further samples to the Petitioner.

Additionally, at least some of the documents the Registrant has produced to Petitioner are responsive to this request.

PETITIONER'S ARGUMENT

Request No. 10 sought representative samples of all documents or other materials that identify explain or describe any products or services sold or intended for sale by Registrant under Registrant's Marks. Registrant produced a few of photocopies of advertisements and what appear to be copies of pages of a brochure. These do not refer to all of the products allegedly sold by Registrant under each of Registrant's Marks. Thus, Registrant should be compelled to produce all documents responsive to this request. If no additional documents responsive to this request exist, Registrant should so state.

REGISTRANT'S RESPONSE

Registrant objects to this request for documents as overly broad and burdensome. Notwithstanding its objection, in the interest of expediting litigation, Registrant will provide further samples to the Petitioner.

Additionally, at least some of the documents the Registrant has produced to Petitioner are responsive to this request.

PETITIONER'S ARGUMENT

Request No. 11 and 12 sought all documents referring or relating to the date and manner in which Registrant first used Registrant's Marks in connection with the sale of any product or service, and in connection with the advertising of each product or service ever offered under Registrant's Marks.

REGISTRANT'S RESPONSE

The information requested is a trade secret or otherwise confidential. Petitioner objects to the disclosure of the above information in the absence of a confidentiality agreement between the parties. This is all the more important when the inquiring party is/represents a competitor clearly wishing to access the US Market. "A standardized confidentiality agreement" is insufficient security.

Registrant, furthermore, objects to this request for documents as overly broad and burdensome.

PETITIONER'S ARGUMENT

Request No. 13 and No. 14 sought documents relating to the annual amount of revenue derived from the sale of products or services sold under Registrant's Marks from the date of first use of Registrant's Marks to the present, and documents relating to the nature and annual amount of all advertising, promotional or product development expenditures incurred in connection with each product or service offered under Registrant's Marks from the date of first use to the present.

REGISTRANT'S RESPONSE

The information requested is a trade secret or otherwise confidential. Petitioner objects to the disclosure of the above information in the absence of a confidentiality agreement between the parties. This is all the more important when the inquiring party is/represents a competitor clearly wishing to access the US Market. "A standardized confidentiality agreement" is insufficient security.

PETITIONER'S ARGUMENT

Requests No. 15 and 16 sought all documents referring or relating to Registrant's Marks that were ever sent to or received from any advertising agency, public relations firm, or design firm, and all marketing plans, media plans, business plans or other strategic planning documents referring or relating to Registrant's Marks or products or services offered or intended for sale under said Mark.

Request No. 18 sought all documents referring or relating to Registrant's Marks that Registrant has filed with or received from any federal, state or local governmental office or regulatory agency, including without limitation all documents filed or received in connection with any application to register Registrant's Marks,

REGISTRANT'S RESPONSE

The information requested is a trade secret or otherwise confidential. Petitioner objects to the disclosure of the above information in the absence of a confidentiality agreement between the parties. This is all the more important when the inquiring party is/represents a competitor clearly wishing to access the US Market. "A standardized confidentiality agreement" is insufficient security.

PETITIONER'S ARGUMENT

Request No. 19 sought all documents relating to any third party use, registration or application to register any mark containing the phrase THE SUNSCREEN THAT WON'T RUB OFF or any similar words or phrases.

REGISTRANT'S RESPONSE

Registrant is unaware of any third party use, registration or application to register any mark containing the phrase THE SUNSCREEN THAT WON'T RUB OFF or any similar words or phrases.

PETITIONER'S ARGUMENT

Requests No. 20 and 21 sought all documents referring or relating to any objections made by Registrant concerning the use or registration of any mark containing the phrase THE SUNSCREEN THAT WON'T RUB OFF or any similar words or phrases, and documents relating to any civil or administrative action or proceeding involving Registrant's Marks.

REGISTRANT'S RESPONSE

No such documents exist.

PETITIONER'S ARGUMENT

Requests No. 22 and No. 23 sought all, documents referring or relating to the compliance or non-compliance by Registrant with federal, state and local laws and regulations in connection with products sold under Registrant's Marks and packaging labels and advertisements used in connection with such products, and all documents referring or relating to any complaints received from customers or others concerning any products or services sold under Registrant's Marks.

REGISTRANT'S RESPONSE

Registrant objects to this request for documents as requesting information which is not relevant to the issues in this proceeding and not reasonably calculated to lead to the discovery of admissible evidence.

PETITIONER'S ARGUMENT

Request No. 24 sought all documents referring or relating to any press release, newspaper article or other publication that has ever mentioned Registrant or any products or services sold or offered under Registrant's Marks. Registrant produced a few documents that may be responsive.

However, Registrant should state whether the documents produced are all responsive documents available, or if they are just a sample. And Registrant should be compelled to produce all documents responsive to this request, or to state that no additional responsive documents exist.

REGISTRANT'S RESPONSE

Registrant objects to this request for documents as overly broad and burdensome. Notwithstanding its objection, in the interest of expediting litigation, Registrant will provide further samples to the Petitioner.

Additionally, at least some of the documents the Registrant has produced to Petitioner are responsive to this request.

PETITIONER'S ARGUMENT

Requests No. 25 and 26 sought all documents relating to any instances of actual confusion that may have resulted from the similarity between Registrant's Marks and Petitioner's Mark, including misdirected mail, telephone calls or other communications received by Registrant that were intended for Petitioner, or other instances wherein any person or business entity has been confused, mistaken or deceived as a result of the use of Registrant's Marks or the similarity between the parties' marks, and all documents referring or relating to any action taken, or planned to be taken, by Registrant to identify or prevent any instances of actual confusion arising from the use of Registrant's Marks.

REGISTRANT'S RESPONSE

No such documents exist.

PETITIONER'S ARGUMENT

Request No. 27 sought all documents referring or relating to any surveys or other research that Registrant has commissioned, performed or considered performing, including research to determine whether there is any likelihood of confusion has Registrant's Marks and marks used or owned by Petitioner or any third party.

REGISTRANT'S RESPONSE

No such documents exist.

PETITIONER'S ARGUMENT

Requests No. 28 and 29 sought all documents referring or relating to the prospective customers for goods offered under Registrant's Marks, and all documents referring or relating to the sales methods or sales channels through which products or services have been sold or offered under Registrant's Marks.

REGISTRANT'S RESPONSE

The information requested is a trade secret or otherwise confidential. Petitioner objects to the disclosure of the above information in the absence of a confidentiality agreement between the parties. This is all the more important when the inquiring party is/represents a competitor clearly wishing to access the US Market. "A standardized confidentiality agreement" is insufficient security.

Registrant further objects to this request for documents as requesting information which is not relevant to the issues in this proceeding and not reasonably calculated to lead to the discovery of admissible evidence.

PETITIONER'S ARGUMENT

Request No. 30 sought all documents referring or relating to communications between Registrant and any or its employees, agents or representatives regarding the use or registration of Registrant's Marks.

PETITIONER'S ARGUMENT

Request No. 31 sought all documents referring or relating to any licenses, assignments or other agreements referring or relating to Registrant's Marks.

REGISTRANT'S RESPONSE

The information requested is a trade secret or otherwise confidential. Petitioner objects to the disclosure of the above information in the absence of a confidentiality agreement between the parties. This is all the more important when the inquiring party is/represents a competitor clearly wishing to access the US Market. "A standardized confidentiality agreement" is insufficient security.

PETITIONER'S ARGUMENT

Request No. 32 asked for representative samples of all mailing lists or other documents that identify Registrant's prospective customers.

REGISTRANT'S RESPONSE

The information requested is a trade secret or otherwise confidential. Petitioner objects to the disclosure of the above information in the absence of a confidentiality agreement between the parties. This is all the more important when the inquiring party is/represents a competitor clearly wishing to access the US Market. "A standardized confidentiality agreement" is insufficient security.

Registrant further objects to this request for documents as requesting information which is not relevant to the issues in this proceeding and not reasonably calculated to lead to the discovery of admissible evidence.

PETITIONER'S ARGUMENT

Request No. 33 and 37 asked for all documents referring or relating to any domain names ever owned by Registrant containing the phrase the SUNSCREEN THAT WON'T RUB OFF or similar words or phrases, and for all documents referring or relating to any websites displaying Registrant's Marks.

PETITIONER'S ARGUMENT

Requests No. 34 and 35 asked for all documents referring to any persons with knowledge of the facts of this proceeding, and for all documents referring or relating to any witnesses or expert witnesses that Registrant may call to testify in this proceeding or on which any such expert intends to rely.

REGISTRANT'S RESPONSE

Registrant objects to this request for documents as overly broad and burdensome.

Registrant does not intend to call expert witnesses for this proceeding, and Mark Schmidt shall be the sole person offering testimony.

PETITIONER'S ARGUMENT

Request No. 36 sought all documents that Registrant intends to use during the testimony period or in any trial of this matter.

REGISTRANT'S RESPONSE

Registrant will rely on documents that have been, or will be, produced in response to document requests 1-36

For the foregoing reasons, Registrant respectfully requests that Petitioner's request for an order compelling Registrant (1) to provide complete answers to Petitioner's Interrogatory Nos. 2, 4, 6, 7, 8, 9, 11, 13, 15, 16, 20, 22, 25, 27, 28, 30, 31; and (2) to provide answers to Petitioner's Requests for Production Nos. 1-37 without objections, and to produce all documents responsive to these requests be DENIED.

Dated: August 29, 2008

The Brand Experience, LLC

By its Attorneys,

/s/ Wayne Harper
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD

CHRISTOPHER CARNOVALE,

Petitioner,

-against-

THE BRAND EXPERIENCE, LLC.

Registrant.

Canc. No. 92044624

CERTIFICATE OF SERVICE

I, Wayne Harper, hereby certify that on August 29, 2008 I served a true and correct copy
of

THE BRAND EXPERIENCE, LLC'S OPPOSITION TO PETITIONER'S MOTION TO
COMPEL

by priority mail and by email upon:

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/s/ Wayne Harper

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