

ESTTA Tracking number: **ESTTA210221**

Filing date: **05/08/2008**

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

Proceeding	92046928
Party	Plaintiff BILLION DOLLAR SMILE, LTD.
Correspondence Address	MARK A. TIDWELL JACKSON WALKER LLP 1401 McKinney, Ste. 1900 Houston, TX 77010 UNITED STATES mtidwell@jw.com, tadolph@jw.com
Submission	Opposition/Response to Motion
Filer's Name	Mark A. Tidwell
Filer's e-mail	mtidwell@jw.com, tadolph@jw.com
Signature	/Mark A. Tidwell/
Date	05/08/2008
Attachments	reply.pdf (5 pages)(233792 bytes)

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

Billion Dollar Smile, Ltd.,	§	Cancellation No.: 92046928
Petitioner,	§	
	§	Mark: MILLION DOLLAR SMILE
v.	§	
	§	Registration No. 3,084,967
William M. Dorfman,	§	
	§	Date of Issue: April 25, 2006
Registrant.	§	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

**PETITIONER’S REPLY TO REGISTRANT’S RESPONSE
TO PETITIONER’S SECOND MOTION
FOR AN ORDER TO COMPEL DISCOVERY**

1. Registrant still has produced no information or documents.

Despite the Board’s April 4, 2008 admonition that Registrant had “failed to cooperate in discovery” and that Registrant “is under an obligation to respond fully to petitioner’s discovery requests,” Registrant has failed to cooperate, and Registrant’s response to Petitioner’s second motion to compel is a continuation of Registrant’s failure to cooperate.

Registrant has not corrected the responses that this Board deemed “boilerplate.”

Registrant has not produced any of the information or documents at issue.

Registrant fails to address the case citations and rules cited in Petitioner’s motion to compel.

Registrant has not produced its advertising using the registered mark – the most basic discovery in a trademark proceeding.

Registrant’s counsel has not even been available, or prepared, or authorized to discuss the discovery dispute.

2. The discovery at issue.

Registrant pretends not to know what interrogatories and requests are at issue in the motion. To take this position, Registrant ignores Pe titioner’s list of discovery at issue that appears in the first

paragraph of the motion, – the same list that appears in the table at pages 3-6 of the motion (with case citations), – the same list that appears in the prayer at the end of the motion, – the same list (with some new deletions) that appeared in the April 4, 2008 email to Registrant’s counsel with an attached table of the discovery at issue with citations, – and the same list (with some new deletions) that appeared in the first motion to compel. As stated in the motion, the discovery at issue is: Interrogatories 1, 3-6, 8-22, and 24-31 of Petitioner’s First Set of Interrogatories to Registrant and to fully and Requests 3-4, 6-37, and 39-46 of Petitioner’s First Request for Production to Registrant.

3. Relevance

In its claim that Petitioner has not addressed the relevance of the discovery at issue, Registrant ignores the argument and case citations for Petitioner’s discovery that appear in the table on pages 3-6 of the motion and in the text preceding the table beginning at the top of page 3 of the motion. The requested information and documents are – as the Board has determined in TBMP §414 – both reasonable and relevant in a proceeding concerning descriptiveness and the other issues raised by the pleadings.

4. Distinctiveness

Registrant continues to play games with the distinctiveness issue. Through a portion of the requested discovery, Petitioner is trying to determine if Registrant is asserting that the registered mark has acquired distinctiveness and if Registrant is making that assertion, then Petitioner seeks discovery relating to that issue. As Petitioner noted in its motion, Registrant refuses discovery on distinctiveness claiming that distinctiveness is not an issue in this proceeding. As late as April 14, 2008, Registrant’s counsel denied that distinctiveness is an issue in the case. In its Response, Registrant continues to play this game. While Registrant mentions that distinctiveness *could* be an issue, Registrant still does not state whether Registrant will contest distinctiveness, and Registrant continues to refuse discovery on this issue.

5. Registrant tries to shift the burden for its objections.

Registrant tries to shift the burden of proof (from Registrant to Petitioner) with respect to proving (or disproving) objections of relevance, burdensomeness, harassment and other objections. Registrant offers no evidence to support any objection of burdensomeness or harassment. As the objecting party,

Registrant has the burden to show specifically how, despite the broad and liberal construction afforded the federal discovery rules, each request is not relevant or how each question is overly broad, burdensome or oppressive by submitting affidavits or offering evidence revealing the nature of the burden. *Culkin v. Pitney Bowes, Inc.*, 225 F.R.D. 69, 70-71 (D. Conn. 2004). “A general objection that interrogatories are onerous and burdensome and require the party to make research and compile data raises no issue. The objection must make a specific showing of reasons why the interrogatory should not be answered.” *Trabon Engineering Corp. v. Eaton Mfg. Co.*, 37 F.R.D. 51, 59 (N.D. Ohio 1964). Further, the requested information and documents are – as the Board has determined in TBMP §414, both reasonable and relevant.

6. Registrant’s fictional rule requirements

In its claim that the motion to compel does not comply with the Board’s requirements, Registrant makes up requirements for a motion to compel that do not exist (*i.e.*, to repeat word for word – as opposed to including a copy of – the discovery requests at issue). This requirement simply is not in the rules applicable to proceedings before this Board. Further, in a case such as this, where Registrant has completely failed to provide documents or proper answers and responses, repeating the requests at issue would, in itself, consume more than the space allotted for a motion. Attaching the discovery requests is the only reasonable and practical approach.

Petitioner has fully complied with the rules concerning motions to compel. Petitioner has provided copies of the requests and the responses. Petitioner has identified the discovery at issue, and Petitioner has indicated that Registrant has wholly failed to provide the requests discovery. Significantly, this is not a case of partial production. Rather, this is a case of wholesale failure to produce any of the discovery at issue.

7. Petitioner’s failure to cooperate

Being unavailable, being unprepared when reached, professing to have no authority to discuss the matter, failing to call as promised, never correcting the boilerplate answers and response, and never producing a single document cannot be described as good faith efforts to resolve the dispute. In its claim

that Registrant's counsel has been justifiably unavailable, Registrant ignores the fact that Registrant has a team of counsel who could have discussed the dispute and ignores the fact that letters and email can serve as substitutes for telephone conversations. Registrant does not justify its failure ever to address the discovery issues and its counsel's failure to call as promised.

In addition, Registrant's argument that document requests 15-19 seek the same information only serves to highlight Registrant's failure to cooperate.

First, Requests 15-19 do not require Registrant to create any documents but only require Registrant to produce what exists. Petitioner is not asking that registrant *create* documents that satisfy each request. Still, Registrant has not produced anything within these requests.

Second, a phone discussion between counsel would have immediately led to resolution of such an argument. Registrant has simply refused to have such a discussion. Petitioner wrote the requests not knowing whether Registrant maintains the information in monthly increments (Request 16), or quarterly increments (Request 17), or yearly increments (Request 18) or for some other period (Request 19), or without regard to time periods (Request 15). The requests were intended to cover these possibilities, and Registrant's counsel could have simply advised Petitioner how the information is kept and produced the existing documents.

Conclusion

Registrant has completely frustrated the purposes of discovery. A telling portion of Registrant's Response is the following:

Registrant is entitled to rely upon the presumption accorded his registration for MILLION DOLLAR SMILE in the defense of this action, and Registrant will identify any documents and witnesses it intends to rely upon for the defense of this action when they become known.

Response, p. 6. In short, Registrant intends to produce no discovery until trial. This is ambush tactics.

Petitioner has a right to discoverable documents and information. Petitioner requests the assistance of the Board to end Registrant's dilatory tactics.

Respectfully submitted,

JACKSON WALKER L.L.P.

/Mark A. Tidwell/

Mark A. Tidwell, Reg. No. 37,456
Tom Adolph, Texas Bar No. 00928900
Charles Kulkarni, Reg. No. 57,119
112 E. Pecan Street, Suite 2400
San Antonio, Texas 78205-1521
Phone: (713) 752-4578
Fax: (713) 752-4221
Attorney for Petitioner

CERTIFICATE OF SERVICE

I certify that on May 8, 2008, a copy of this document and its attachments was served on the following, via certified, first-class mail:

Kristine M. Boylan
Scott M. Oslick
MERCHANT & GOULD, P.C.
80 South Eighth Street, Ste. 3200
Minneapolis, MN 55402-2215

/Tom Adolph/

Tom Adolph

CERTIFICATE OF FILING

I certify that the foregoing Petitioner's Reply to Registrant's Response to Petitioner's Second Motion for an Order to Compel Discovery is being filed electronically with the United States Patent and Trademark Office's Electronic System for Trademark Trials and Appeals (ESTTA) on this 8th day of May, 2008.

/Tom Adolph/

Tom Adolph