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

Proceeding	92055738
Party	Plaintiff J J Holand Limited
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

J J HOLLAND LIMITED,	:	
Petitioner	:	Cancellation No. 92055738
v.	:	
	:	
POTOMAC TOBACCO COMPANY, LTD.	:	
Registrant.	:	
	:	

PETITIONER’S RESPONSE TO REGISTRANT’S MOTION TO COMPEL

Petitioner hereby objects to Registrant’s Motion to Compel responses to Respondent’s First Set of Requests for Production of Documents and Things, Respondent’s First Set of Interrogatories, and Respondent’s First Set of Requests for Admissions, marked as Exhibits A, B and C to the Declaration attached to Registrant’s Motion (hereinafter “Discovery Requests”) for the reasons set out below. Petitioner has the obligation to object to the Motion.

On October 29, 2014, Petitioner, by its Notice of Improper Discovery Requests (Exhibit D to Shultz’s Declaration) undeniably did duly notify Registrant of its objections to said Discovery Requests and that pursuant to the applicable Rules requiring Initial Disclosures be made and served prior to any discovery requests as well as pursuant to the requirements and provisions of Federal Rules of Civil Procedure 26(g)(1) and 26(g)(2) respectively, Petitioner was not obligated to and would not be responding to the Discovery Requests which were so clearly invalid and improper pursuant to the Rules. Registrant has admitted to being served with the Notice of

Improper Discovery Requests. All statements in the Motion or the Declaration to the effect that Petitioner did not respond to or timely object to the Discovery Requests are clearly false and Registrant's Motion to Compel fails on its own merits.

For the record, the Registrant has made no attempt to remedy its defective initial disclosures (the time to do so has long since expired). Nor has Registrant made any effort to remedy the lack of a proper signature under Fed. R Civ. P. 26 (g)(1) thereon despite the deficiency of a proper signature being pointed out by Petitioner. Unsurprisingly, Registrant similarly has failed to remedy the lack of a proper signature under Fed. R. Civ P. 26 (g) on each of its Discovery Requests which it now seeks the Board to Compel, although not properly signed. Petitioner properly waited for Registrant to do so after Petitioner notified Registrant of the deficiency, or at least attempt to do so, but no properly signed documents were forthcoming. Petitioner received Registrant's attorney's correspondence on October 31, 2014 ranting and attempting to "school" Petitioner on the Rules and procedures at the TTAB, however Petitioner regarded it as at best nothing but puffery trying to intimidate a pro-se opponent into waiving the clear rules applicable to these proceedings as well as the supporting case law. Petitioner, however, knowing that the Rules and clear case precedents all supported its position, took the high road and did not respond to the Registrant's petulant and clearly baseless attack, but rather waited the appropriate amount of time to see if Registrant would sign any of its requests or seek to remedy its lack of proper initial disclosures, which again, Registrant failed to do so. Registrant

then failed to timely file a motion to compel as Registrant in its October 31, 2014 letter had threatened to do if no disclosures were provided by Petitioner within Nov. 7, 2014 (Attachment E to the Shultz Declaration). Thereby giving Petitioner more reason to believe Registrant's attorney was attempting to belligerently intimidate Petitioner and/or perhaps conceal the negligence from their client, something Petitioner knows well from its prior representation by Fredrikson & Byron. Petitioner considered additionally that the failure to file a motion to compel was the result of Registrant's attorney actually reviewing the Rules and finding the Board's precedent decisions which clearly support the Petitioner and therefore they abandoned the idea and were aware their discovery was entirely defective. In any event, Registrant then sat on its claimed right to file a motion to compel for fully three months, until January 29, 2015 despite being told on October 29th that Petitioner was aware it had no obligation to respond and therefore would not respond. Registrant's motion is therefore clearly well beyond the proper and reasonable time to bring it and is in light of its legally deficient nature - coming with no valid initial declarations and unsigned Discovery Requests - merely yet another in a long line of actions taken by Registrant to frustrate and delay these proceedings which were instituted in June 2012.

In short, Registrant seeks to compel answers to unsigned Discovery Requests, having never even served valid and signed Initial Disclosures but instead provided only a legally inadequate and unsigned document it named Initial Disclosures which fails to meet the requirements of the Board for valid Initial Disclosures not to mention

also fails to meet the requirements for proper signature under the Rules as adopted. Registrant was notified that Petitioner would not be providing any responses to the Discovery Requests as it had no obligation to do so as clearly supported by the Board's case law. Registrant's Motion to Compel is clearly baseless and abusive.

Registrant is not entitled to any Board order to compel pursuant to both the Rules and applicable Board decisions as Registrant has clearly failed to meet its obligations pursuant to the Rules by inter alia (1) failing to properly serve Initial Disclosures as required, (2) failing to properly sign in accordance with Fed. R. Civ. Pro. 26(g) as made applicable to these proceedings the deficient and inadequate document Registrant entitled "Initial Disclosures", (hereinafter "Defective Disclosures") upon which Registrant relies in its motion but fails to provide to the Board, the omission being both obvious and deliberate (3) failing to remedy the failure to sign the Defective Disclosures within 15 days (or ever) once Petitioner advised Registrant on October 29, 2014, of the failure to properly sign as required by the Rules, (4) serving various Discovery Requests (the subject of Registrant's Motion to Compel - hereinafter the "Discovery Requests") without first serving valid and signed Initial Disclosures as required by the Rules and (5) by serving said Discovery Requests without properly signing said discovery documents as required by Fed. R. Civ. Pro 26(g) and (6) failing to properly sign the Discovery Requests within 15 days (or ever) of October 29, 2014, the date Registrant was notified that its Discovery Requests were not properly signed as required.

I. **Objection to Motion to Compel on grounds of Failure to make required Initial Disclosures**

Pursuant to the Rules as made applicable to these proceedings, before a party may serve any Discovery, they must first properly serve upon the other side their Initial Disclosures (37 CFR Section 2.120(a)(3)). Quite simply, Registrant has not provided the required Initial Disclosures pursuant to the Rules and accordingly is not entitled to serve discovery, much less apply for a motion to Compel.

A. **Registrant Failed to serve valid Initial Disclosures**

Initial Disclosures, as mandated in these proceedings and as described in the BMP Section 401.02 must be served on the opposing party early in the proceedings, in these proceedings the Board set the deadline as April 27, 2014. Initial Disclosures are required to meet the provisions of Fed. R. Civ. P. 26(a)(1), as adopted by the Board, as the Registrant's attorney has noted and copied in her letter dated October 31, 2014 [Registrant's Motion, Shultz Declaration Exhibit F].

Fed R. Civ. P. 26 (a)(1)(A)(ii) provides "(ii) a copy - or a description by category and location ..."

Section 26 (a)(1) goes on to say "In addition, a party must either provide the location of all identified documents or, in the alternative, produce them." The Rules very clearly require that the initial disclosures must identify the documents as well as where

they are located. The Registrant's purported initial disclosures, the "Defective Disclosures", never identify any category of documents with their location or locations or produces them instead as is required, in fact Registrant does not identify any location where the document categories are, only claiming that at some unspecified point in the future, that they would be located in the office of their European solicitor, in Belgium. To accept this would be akin to a party merely saying the documents will be on planet earth, that clearly is not what any court, or the Board has expected of a party in making good faith initial disclosures. The importance of identifying not only the type but also the location of documents early on in initial disclosures cannot be underscored. Registrant itself in its motion for extension of time to respond to Petitioner's Discovery Requests cites the need to collect documents from multiple countries, clearly indicating that Registrant's attorney and Registrant made no prior effort in the nearly 6 month period between preparing the defective disclosures and submitting the request for extension of time to collect documents and forward them to the supposed eventual repository in Belgium. Registrant's Defective Disclosures do not by any stretch of the imagination fulfill the obligations set forth in the Rules and they do not satisfy the Registrant's obligations to provide initial disclosures. Registrant is left without any valid proper initial disclosures served upon Petitioner, contrary to the false assertions of Registrant and Registrant's counsel in its motion and her declaration respectively.

Registrant has deliberately attempted to mislead the Board into believing that Registrant has properly served upon Petitioner Initial Disclosures "in accordance with

the rules set out by the Board” (which would require meeting Fed. R. Civ. Pro. 26(a) et seq.) and that Registrant did so prior to serving discovery as required by Section 2.120(a)(3). Petitioner asserts it is undeniable that Registrant did neither. Registrant’s pitiful attempt to pass off a non-compliant document lacking any legitimate effort to comply with the Board’s requirements for Initial Disclosures shows clear lack of intent to meet its obligations under the discovery process for proceedings it now apparently knew it would try to escape via a Section 8 cancellation. Registrant and Registrant’s Counsel in her Declaration have not surprisingly omitted attaching any Initial Disclosures for the Board to review despite claiming that they served valid Initial Disclosures on April 24, 2014. Petitioner would posit that the omission was for the obvious reason that they do not have valid Initial Disclosures to provide the Board. Why hide the potato? Instead Registrant and Registrant’s attorney self-contradict themselves by stating on pages 1-2 of the Motion that “Petitioner made no objections to respondent’s initial disclosures” and in the next paragraph then asserting that “petitioner served respondent with a paper entitled Notice of Improper Discovery Request [Exhibit D (Shultz declaration)] ... In this paper, petitioner tried to set forth an objection to respondent’s initial disclosures”(citation inserted) and then going on to say Petitioner’s objection was not only baseless and without merit, it was also untimely. The second statement clearly disproves the first. If Registrant believed its assertions, why not provide the Board with its initial disclosures? For the Board’s reference, the Registrant’s Defective Disclosures which they refused to provide the Board are attached hereto as Exhibit 1.

The Board must maintain the integrity and purpose of the Rules and refuse to accept a party's clearly inadequate documents which lack any real effort to satisfy either the requirements of the Board or the needs of their opposing party for which the requirements of initial disclosures were adopted.

B. Registrant failed to validly sign Initial Disclosures

Petitioner on October 29, 2014, timely and properly notified Registrant that in addition to the legal inadequacy of its Defective Disclosures in terms of content, there was an additional defect in the Defective Disclosures, in that pursuant to the Board Rules, each discovery document, including the initial disclosures, are required by the Rules to be signed in accordance with Fed. R. Civ Pro. 26(g)(1), which requires that every discovery document, including the initial disclosures, "be signed by at least one attorney ... or by the party personally, if unrepresented and must state the signer's address, e-mail address, and telephone number."[underlining added]. The Registrant's Defective Disclosures omit a proper signature, which must identify the signer with their address, e-mail address and telephone, Mr. Jennison has not followed the rule as he has not provided his e-mail address as required. For the avoidance of doubt, having done so would not have validated the Defective Disclosures as they failed to meet the minimum standards of the Rules as noted above. As notified to Registrant on October 29, 2014, Fed. R. Civ. Pro. 26(g)(2) clearly provides that a party does not have any obligation to respond to an unsigned disclosure, request, response or objection until it is signed, and the court must strike it unless a signature is promptly supplied after the omission is

called to the attorney's or party's attention (which despite being brought to the Registrant's attention on October 29, 2014 was not signed within 15 days or at all up to the present, a point made clear by the Discovery Requests attached to the Motion to Compel although Registrant didn't even bother to attach the Initial Disclosures upon which existence and legal sufficiency its motion relies even though such was challenged in correspondence attached to Registrant's motion and nothing in the motion disputes or contradicts the deficiencies Petitioner has cited.

2. Registrant's failure to provide Initial Disclosures prior to serving discovery

Petitioner in its October 29, 2014 notice to Registrant specifically quoted the provisions of Section 2.120(a)(3) which requires that initial disclosures be served before any discovery requests may be served. The Board's precedential decision in *Dating DNA LLC. v. Imagini Holdings, Ltd.*, 94 USPQ2d 1889 (TTAB 2010) [precedential] has made it clear that this provision and requirement means exactly what it says. Registrant, having not served valid initial disclosures had no right to serve the Registrant's Discovery Requests it now seeks to compel, and moreover because discovery has closed, Registrant has no right to serve any discovery requests even if it were to now provide proper initial disclosures, the time for doing so also having long ago expired.

3. Registrant's Discovery Documents lack Proper Signature

Petitioner on October 29, 2014, timely and properly notified Registrant of defects in the Registrant's Discovery Requests and Initial Disclosures, in that each discovery

document, including not only the requests but also the initial disclosures, are required by the Rules to be signed in accordance with Fed. R. Civ. Pro. 26(g)(1), which requires that every discovery request, like the initial disclosures, be signed by at least one attorney ... or by the party personally, if unrepresented and must state the signer's address, e-mail address, and telephone number.[underlining added]. The Registrant's Defective Disclosures as well as the Discovery Requests all omit a proper signature, which must identify the signer with their address, e-mail address and telephone, and neither Mr. Jennison with respect to the Defective Disclosures nor Ms. Shultz with respect to the various Discovery Requests have provided their e-mail address as required. As notified to Registrant on October 29, 2014, Fed. R. Civ. Pro. 26(g)(2) clearly provides that a party does not have any obligation to respond to an unsigned disclosure, request, response or objection until it is signed, and the court must strike it unless a signature is promptly supplied after the omission is called to the attorney's or party's attention (which despite being brought to the Registrant's attention on October 29, 2014 was not signed within 15 days or at all up to the present, a point made clear by the Discovery Requests attached to the Motion to Compel (Exhibit A, p. 17, Exhibit B p. 8 and Exhibit C p. 3 to Registrant's Motion Shultz Declaration).

4. Obligations and Burdens with respect to Initial Disclosures

Contrary to the claims of Registrant in its motion and Registrant's counsel both in her Declaration in support of the Motion and in her correspondence to Petitioner of October 31, 2014 (Shultz Decl. Exhibit E), Petitioner had no obligation to inform Registrant that

its counsel had failed to properly serve Initial Disclosures which meet the requirements, either before or after the deadline for disclosures to be served or before the deadline for discovery ends, nor did it have any requirement to file a motion to compel such initial disclosures (only a time limit if it wanted to do so). The Board's precedential decision in *Dating DNA LLC. v. Imagini Holdings, Ltd.*, 94 USPQ2d 1889 (TTAB 2010) [precedential] has made these points clear. Likewise the Board made it clear that a party notifying the other party of defects in their discovery which relieved it of any obligation to respond was properly done when notified on the last day to respond even if they could have notified them prior to the close of discovery. For the avoidance of doubt and in light of prior confusion, Petitioner did not and does not seek the Board's order for Initial Disclosures to be made by Registrant now, the time to do so having expired. However, this is no waiver of the Registrant's obligation to serve proper initial disclosures generally or specifically with respect to doing so before serving discovery requests, nor does it waive any rights Petitioner has with respect to the default of Registrant to properly serve Initial Disclosures.

5. Registrant's Motion is untimely

In any event, Registrant was notified on October 29, 2014 that Petitioner asserted defects in its Initial Disclosures and Discovery Documents and pursuant to Rule 2.120(a)(3) and Fed. R. Civ. Pro 26 (g)(2) it would not be responding to the Discovery Documents it now seeks to compel. Registrant then inexplicably sat on its claimed right to file a motion to compel for fully three months, until January 29, 2015 despite being

informed in writing on October 29, 2014 that Petitioner was aware it had no obligation to respond and therefore would not respond. Registrant's motion is therefore clearly well beyond the proper and reasonable time to bring it and is in light of its hopeless nature, yet another in a long line of actions taken by Registrant to frustrate and delay these proceedings. Registrant itself apparently acknowledges the hopeless and defective nature of its documents and position as it no longer makes any claim that its requests for admissions have been deemed admitted as it did in its October 31, 2014 correspondence "schooling" Petitioner, instead it having apparently realized its position merely purportedly seeks answers to the admissions.

6. Registrant's Bad Faith Position on Discovery

Petitioner would be remiss not to inform the Board that Registrant, despite having on October 9, 2014 requested an extension of time of 60 days to respond to Petitioner's Discovery Requests and having actually been granted on December 19, 2014 until January 19, 2015 (nearly 100 days extension, or 135 days from the date of service of the Petitioner's first Discovery Requests), has not served a single document or provided a single answer to interrogatories and has allowed the requests for admissions to all be deemed admitted. Petitioner considers that, and can only assume that the Board takes the same position, that such a request for extension and particularly one for such a long duration (60 days is an extension twice as long as the standard response time and effectively gives 90 days or three times the time normally allowed) implies that the requester actually intends to respond.

The Registrant in its current motion at page 2 quotes the Interlocutory Attorney's statement (in the Dec. 19, 2014 order) that the granted extension of time granted to the Registrant "should be more than adequate for Respondent to prepare and service its discovery responses (by January 19, 2015)." Registrant then goes on to claim that the statement with respect to adequate time should also apply to the Petitioner. The assertion is clearly without merit as Petitioner had no knowledge of or expectation that it had any valid discovery obligations during that period, it having already addressed with the Registrant the deficiencies of Registrant's discovery documents collectively as noted above. Registrant also omits from informing the Board that Registrant hasn't actually fulfilled its discovery obligations pursuant to the Discovery Requests the time limit for which were extended in that very order. Petitioner and Registrant are of different minds as to whether the Discovery Requests, the Request for Extension of time and the Board's Order actually meant they should serve the responses, or as Registrant's attorney has claimed in subsequent correspondence, merely the opportunity that they could respond to the Petitioner's Discovery Requests by the deadline set by the Board of January 19, 2015, which in any case they have not availed themselves of. In light of the current events where Registrant's marks have been cancelled under Section 8, it seems clear that the Registrant and Registrant's attorney acted in bad faith and deliberately refused to properly participate in these proceedings and further refused to provide proper initial disclosures in compliance with the Rules, prepared invalid discovery requests in violation of

the Rules and acted to delay its own discovery responses so as to delay their obligations until after the deadline for late submission of the Section 8 renewal so that the marks would be cancelled, without the Registrant ever having to respond to the Discovery Requests and then submitted the current motion to compel knowingly distorting the facts and omitting material information from the Board which makes it clear that the motion fails on its face.

Petitioner requests that the Board deny Registrant's Motion, strike the Registrant's clearly invalid and impermissible Discovery Requests and issue proper admonitions, including referring Registrant's attorneys for disciplinary action.

Dated: September 1, 2015



Mr. Lance Andrew Straube

JJ Holand Limited

Authorized Officer and Representative

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Certificate of Service

I hereby certify that a true and complete copy of the foregoing PETITIONER'S RESPONSE TO REGISTRANT'S MOTION TO COMPEL dated September 1, 2015 has been served upon POTOMAC TOBACCO COMPANY, LTD., by mailing said copy on September 1, 2015, via First Class Mail, postage prepaid, to its representative of record in this matter at the correspondence address of record: KATHRYN JENNISON SHULTZ, JENNISON & SHULTZ, P.C., 2001 JEFFERSON DAVIS HWY, SUITE 1102, ARLINGTON, VA 22202, USA.

September 1, 2015

BY:



Lance Andrew Straube -
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Exhibit 1

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

J J HOLLAND LIMITED,	:	
	:	
Petitioner,	:	Cancellation No. 92/055,738
	:	Reg. Nos. 3409520 and
v.	:	3418779
	:	
POTOMAC TOBACCO COMPANY, LTD.,	:	
	:	
<u>Respondent.</u>	:	

RESPONDENT'S INITIAL DISCLOSURES

Respondent Potomac Tobacco Company, Ltd. (“Respondent”) makes its initial disclosures under Federal Rule of Civil Procedure 26 (a)(1) based on the information reasonably available to Respondent at this time. Respondent reserves the right to supplement these disclosures. Respondent makes these disclosures without waiver of any applicable privilege or work product protection. Respondent expressly reserves all rights to object to the production of any of the information below on those grounds.

Respondent also reserves its right to object to the admissibility of any of the information below. Subject to these objections, Respondent provides the following information.

A. The name and, if known, the address and telephone number of each individual likely to have discoverable information – along with the subjects of that information – that the disclosing party may use to support its claim or defenses, unless solely for impeachment.

Based on the information currently available, Registrant identifies the following individuals likely to have relevant information which it may use to support its defenses or to rebut any claims raised by Petitioner, but reserves the right to supplement this list following further investigation and discovery:

Mr. Paul Nkwaya, Marketing Manager for Potomac Tobacco Company, Ltd. Mr. Nkwaya may have information relating to the following matters: (i) general information

concerning the business and operation of Respondent; (ii) Respondent's current and prior use of the YES and YES INTERNATIONAL marks; (iii) information concerning the goods marketed and sold by Respondent in connection its YES and YES INTERNATIONAL marks; (iv) information concerning advertising, marketing, promotion and sales of the goods offered or identified by its YES and YES INTERNATIONAL marks; and (v) information concerning Respondent's marks and trademark applications/registrations therefore. Mr. Nkwaya's address is 2 Alhadji Bakare Street, Sango ota, Lagos, Nigeria. He may be contacted through the offices of Respondent's counsel, Jennison & Shultz, P.C., at 2001 Jefferson Davis Highway, Suite 1102, Arlington, Virginia 22202, telephone (703) 415-1640.

B. A copy – or a description by category and location – of all documents, data compilations and tangible things that the disclosing party has in its possession, custody, or control and may use to support its claims or defenses, unless the use would be solely for impeachment.

Based on information currently available, Respondent provides the following description of documents and things which it may use to support its defenses or rebut any claims raised by Petitioner:

1. Documents and things relating to the goods identified by Respondent's marks;
2. Documents and things relating to Respondent's use of Respondent's YES and YES INTERNATIONAL marks;
3. Documents and things relating to Respondent's trademark registrations for its YES and YES INTERNATIONAL marks;

4. Documents and things relating to advertising and promotional activities and/or expenditures for goods marketed, offered for sale and/or sold under or in connection with its YES and YES INTERNATIONAL marks;

5. Documents and things relating to Respondent's sales and/or distribution of the goods identified by its YES and YES INTERNATIONAL marks;

6. Documents and things relating to the reputation and recognition of the YES and YES INTERNATIONAL marks;

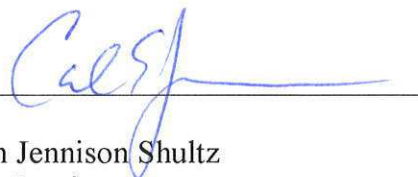
7. Documents and things relating to the channels of trade through which goods or services bearing the YES and YES INTERNATIONAL marks are marketed, advertised, promoted, offered for sale and/or sold.

Copies of the above-noted documents and things, if available, will be located in the offices of Gunzburg, Cornette & Schots, Advocates, President Building, Franklin Rooseveltplaats 12 bus 3, 2060 Antwerp, Belgium. Respondent will not produce confidential or proprietary documents, or business information except as provided under the Board's standard protective order. Further, Respondent reserves its right to amend its Initial Disclosures to identify additional documents and things.

Respectfully submitted,

Date: April 22, 2014

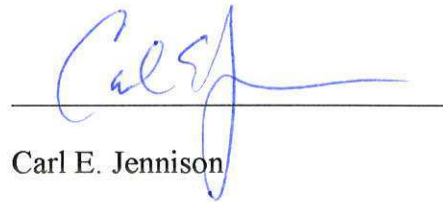
By: _____



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Telephone: (703) 415-1640
Attorneys for Registrant

CERTIFICATE OF SERVICE

I hereby certify that true and complete copy of the foregoing RESPONDENT'S INITIAL DISCLOSURES were served upon Petitioner J J HOLLAND LIMITED, by forwarding same via First Class Mail, postage prepaid, to Keith Murray McCulloch, J J Holland Limited, 87/171 Wireless Road, Pathumvan, Bangkok 10330, Thailand, this 22nd day of April, 2014.



Carl E. Jennison