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

Proceeding	92055738
Party	Defendant Potomac Tobacco Company Limited
Correspondence Address	KATHRYN JENNISON SHULTZ JENNISON & SHULTZ PC 2001 JEFFERSON DAVIS HWY, SUITE 1102 ARLINGTON, VA 22202 UNITED STATES kjs@jennisonlaw.com
Submission	Opposition/Response to Motion
Filer's Name	Kathryn Jennison Shultz
Filer's e-mail	kjs@jennisonlaw.com
Signature	/Kathryn Jennison Shultz/
Date	02/22/2016
Attachments	reply to motion to compe_001.pdf(788095 bytes )

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.,	:	
	:	
Respondent.	:	

RESPONDENT'S REPLY TO PETITIONER'S MOTION TO COMPEL

Respondent Potomac Tobacco Company, Ltd., by and through its undersigned attorney, hereby responds to petitioner's undated and unsigned motion to compel.

DEFICIENCIES OF "MOTION"

Petitioner has not served respondent with a complete and accurate copy of the document filed with the Board on February 1, 2016. Attached as Exhibit A is a copy (without its exhibits) of petitioner's "motion to compel" that was received by respondent. It is noted that the motion is not signed, the accompanying declaration by Lance Andrew Straube is not executed and there is no signature on the certificate of service. Therefore, respondent points out that the motion should not be given any consideration.

NO GOOD FAITH EFFORT TO RESOLVE

In addition, a motion to compel must be supported by a written statement from the moving party that such party has made a good faith effort, by conference or correspondence, to resolve with the other party the issues presented in the motion to reach agreement. Petitioner has not done so. The unsigned declaration attached to the unsigned motion does not set out any good faith attempts by the petitioner to resolve this matter prior to its filing. No attempt has been made to arrange for the exchange of

documents or the time line for serving discovery responses. Petitioner is located in Thailand and petitioner has made no attempt to provide an alternative location for service. Petitioner has only concentrated on making excuses for its non-action.

### SUSPENSION OF ACTION

Petitioner served respondent with a voluminous amount of discovery requests. Most of which are requests for confidential business information and information not relevant to the issues in this proceeding. It is mainly a fishing expedition for a party that had prior knowledge of the respondent's extensive use of the subject trademarks on or in connection with the products listed in the registrations in numerous countries around the world.

The discovery requests were served in September 2014. Respondent was in the process of putting in place all requirements necessary to re-establish use of its trademarks in connection with the named products. This was set out in documents previously filed with the Board to support its excusable non-use. The final deadlines for filing the required Section 8 affidavits fell in October 2014. With attention required for the undertaking of these activities, respondent requested and was granted an extension of time to serve responses to the discovery requests.

Next with the knowledge that the registrations would be marked cancelled and the fact that the Board would take notice of the fact, respondent waited to see if there was any reason for this proceeding to go forward. In its opinion, the matter was moot and any further action on discovery would not be required. We awaited action by the Board to see if our assumption was correct.

Subsequently, the Board sent out orders requesting respondent to explain its excusable non-use and asking if the petitioner wanted to go forward with this proceeding. After the parties intentions were set out, respondent requested from petitioner responses to its discovery requests and, after making good faith effort to resolve this, respondent filed and was granted its motion to compel. Respondent was not sure if petitioner was going to respond to not only its discovery, but also respond to the motion to compel. After all, the first cancellation proceeding involving these same parties was decided because petitioner did not serve respondent with discovery responses, did not respond to a motion to compel and did not respond to a motion for sanctions. As a result, the Board found in favor of respondent.

Respondent is still perplexed by the need to continue this proceeding as the registrations as stated above have already been cancelled and the notice of allowance for petitioner's claimed application has been mailed.

Currently, petitioner has only made excuses and thrown insults at everyone - its past attorneys, the respondent, respondent's counsel and even the Board. At no time, have they tried to resolve any discovery disputes.

DISCOVERY RESPONSES HAVE BEEN SERVED

Petitioner has been served with respondent's discovery responses. As a result, this motion is moot.

Respectfully submitted,

POTOMAC TOBACCO COMPANY LIMITED

Date: February 22, 2016

By:   
Kathryn Jennison Shultz

JENNISON & SHULTZ, P.C.  
2001 Jefferson Davis Highway - Suite 1102  
Arlington, Virginia 22202  
Telephone: (703) 415-1640  
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Email: kjs@jennisonlaw.com  
Attorneys for Respondent

CERTIFICATE OF SERVICE

I hereby certify that true and complete copies of the foregoing RESPONDENT'S REPLY TO PETITIONER'S MOTION TO COMPEL DISCOVERY was 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 February, 2016.

A handwritten signature in blue ink, reading "Kathryn Jennison Shultz", written over a horizontal line.

Kathryn Jennison Shultz

## Exhibit A

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. :  
Respondent. : FEB 03 2016

RECEIVED  
JENNISON & SHULTZ P.C.

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PETITIONER'S MOTION TO COMPEL DISCOVERY

Petitioner J J Holland Limited, by and through its Authorized Officer and Representative, hereby moves, pursuant to Rule 37(a)(2) of the Rules of Civil Procedure and Rule 2.120(e) of the Trademark Rules of Practice, for an order to compel discovery from Respondent Potomac Tobacco Company, Ltd. As set forth below, and in the Declaration of Lance Andrew Straube, filed herewith, Petitioner has made a good faith effort to resolve the issues raised by this Motion, without success.

Petitioner properly served Respondent with its Initial Disclosures in the proper and complete format in accordance with the Rules on April 28, 2014.

Respondent served Petitioner with a document entitled RESPONDENT'S INITIAL DISCLOSURES dated April 22, 2014, which were not in the proper and complete format as required by the rules. In this document, Respondent's attorney outlined, inter alia, that documents and things related to goods identified by Respondent's marks, relating to the use of the marks, relating to the registrations of the marks, relating to the advertising and promotion of the marks, sales and distribution of goods identified by the marks, relating to the reputation and recognition of the marks, relating to the channels of trade through which goods or services bearing the marks were marketed, advertised, offered for sale and/or sold will be, if available, located in the offices of Gunzburg, Cornette & Schotts, Advocates, in Antwerp, Belgium.

Petitioner properly served Respondent with its Requests for the Production of Documents and Things, Interrogatories and Admissions as follows:

September 3, 2014 : First Set of Requests for Production of Documents and Things (9). Responses were due on or before October 8, 2014. Exhibit A.

September 4, 2014 : First Set of Interrogatories (1 - 13). Responses were due on or before October 9, 2014. Exhibit B.



September 4, 2014 : Second Set of Requests for Production of Documents and Things (28). Responses were due on or before October 9, 2014. Exhibit C

September 5, 2014 : Second Set of Interrogatories (14 - 28). Responses were due on or before October 10, 2014. Exhibit D.

September 24, 2014 : First Set of Requests for Admission (102). Responses were due on October 29, 2014. Exhibit E.

September 24, 2014 : Second Set of Requests for Admission (33). Responses were due on October 29, 2014. Exhibit F.

September 24, 2014 : Third Set of Requests for Production of Documents and Things (102). Responses were due on or before October 29, 2014. Exhibit G.

Copies of the above are attached hereto as Exhibits A, B, C, D, E, F and G.

In addition to the above, Petitioner sent a document entitled CORRECTION TO DISCOVERY INSTRUCTIONS FOR INTERROGATORIES AND REQUESTS FOR PRODUCTION OF DOCUMENTS to Respondent on September 24, 2014 - attached hereto as Exhibit H.

Discovery closed in this matter on September 24, 2014.

On October 8, 2014, Respondent filed a Motion for Extension of Time to Respond to Petitioner's discovery requests. Petitioner objected but the Board granted on December 19, 2014 an extension, allowing Respondent until January 19, 2015 'to

respond to all seven sets of Petitioner's discovery requests' and commented that 'this extension of time should be more than adequate for Respondent to prepare and serve its discovery responses.' (Emphasis added.)

Respondent did not respond on the date set by the Board. When Petitioner enquired where the outstanding discovery was and challenged Respondent's failure to comply with the Board's Order, counsel for Respondent advised Petitioner in an email dated January 30, 2015 (Exhibit I Attached) that the Board granted the extension of time to respond but 'They did not order us to do so.' Petitioner has several times pointed out to the Board and Respondent that Respondent has not complied with its obligations, and that discovery is an obligation not a choice, most recently in its response to the Respondent's own Motion to Compel, but still to no avail. Despite Respondent's counsel's continual insistence that we follow the rules, Respondent's counsel feels no compunction to do so with respect to their own discovery obligations. We had hoped that pointing out again in our response to their Motion to Compel the obligatory nature of discovery would prompt Respondent's counsel to push Respondent to comply given that they had voiced no objections to the discovery whatsoever, unlike our well founded objections. Despite this additional communication served upon Respondent reminding them of their failure to comply, no responses to our Discovery requests has been forthcoming and with the stay finally lifted, we now must file this motion to compel.

The Board should not accept the position of Respondent's counsel that an extension of time being granted merely allows a party to decide if they might want to

comply with Discovery Requests, as if the Federal Rules of Civil Procedure make such items discretionary or at the whim of counsel or a party. The foregoing begs the question of why Respondent requested the extension if they were simply seeking 60 days so that they might contemplate whether they would want to answer, assuredly neither the Board nor Petitioner understood Respondent's Request for an Extension of time as merely seeking such period of contemplation. In so seeking the extension, Respondent's counsel undertook to the Board that it sought such extension in good faith and would answer the discovery, then after an extremely generous period granted by the Board, that same counsel acts as if discovery is not obligatory and cannot even be bothered to make up any excuses.

This interpretation shows that the Respondent and its counsel had bad faith intentions when applying to the Board for the extension in the first place. The Board should not allow such abuse to go unpunished. The Petitioner has had to wait during months and months of suspensions and now has no choice but to bring this motion to try to obtain the discovery Registrant should have turned over well over a year ago.

Therefore, it is clear that the Respondent is taking all steps to avoid serving Petitioner with any substantive responses to any of Petitioner's discovery requests, perhaps because as Respondent's counsel implied, it hasn't any.

Respondent, by its abusive behavior, is not meeting its responsibilities in accordance with the Board's rules, on which Respondent has constantly lectured Petitioner during these proceedings. Respondent has a duty to satisfy the legitimate needs of its adversary. TBMP §408.01 (3<sup>rd</sup> ed. 2011). This duty has not been met and, as a

result, Respondent is creating a barrier that prevents Petitioner from going forward with the preparation of its case.

#### REMARKS

According to 37 CFR §2.120(e), a motion to compel must be supported by a written statement from the moving party that such party or the attorney therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion to reach agreement.

In the subject proceeding, Respondent has completely ignored Petitioner's (and the Board's) good faith efforts to amicably resolve the discovery issues and its attorney has put forward fatuous arguments to support its non-compliance with the Rules and the Board's Order.

In Petitioner's Objection to Respondent's Motion to Compel dated September 15, 2015, Registrant wrote :

'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. '

As the Respondent's deadline to respond to the Board's Order has passed and Respondent has not responded in any meaningful manner other than to say it hasn't violated an order to comply but only failed to utilize the extra time it sought from the Board to submit a reply to the Discovery requests, if it had any. Petitioner requests that this motion be granted in its entirety, and the Board issue an Order (1) compelling Respondent to serve on Petitioner complete verified answers to all discovery requests and interrogatories within 10 days of such Order and to produce documents and things called for by the Requests for Production of Documents and Things included in the Petitioner's discovery requests within 10 days of such order, (2) issuing appropriate sanctions against Respondent and its attorney for their abuse of the Court's Order dated January 19, 2015 and (3) finding that Respondent forfeited its rights to object to Petitioner's discovery requests on the merits. See TBMP §527.03.

Respectfully submitted,

J J HOLLAND LIMITED

Date : February 1, 2016

By: \_\_\_\_\_  
Mr. Lance Andrew Straube  
Authorized Officer & Representative  
J J Holland Limited  
437/20 Suanphlu Soi 8  
Bangkok 10120  
Thailand  
Telephone: +66-81-1737434

E-mail: lstraube@gmail.com

Certificate of Service

I hereby certify that a true and complete copy of the foregoing PETITIONER'S MOTION TO COMPEL DISCOVERY and the Declaration of Lance Andrew Straube has been served upon POTOMAC TOBACCO COMPANY, LTD., by mailing said copy on February 1, 2016, 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.

By:

---

Mr. Lance Andrew Straube  
J J Holand Limited  
437/20 Suanphlu Soi 8  
Bangkok 10120  
Thailand  
Telephone: +66-81-1737434  
E-mail: lstraube@gmail.com

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.	:
Respondent.	:
	:

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DECLARATION OF LANCE ANDREW STRAUBE

Lance Andrew Straube, the Authorized Officer and Representative of Petitioner, declares under penalty of perjury that the following is true and correct:

1. I am a director and officer of J J Holland Limited, a company of good standing, registered in the British Virgin Islands (No. 86244), with the authority of the company's board of directors to litigate this Petition to Cancel.
2. I make this declaration in connection with Petitioner's Motion to Compel Discovery dated February 2, 2016, filed herewith.
3. On April 28, 2014, Respondent was properly served with Petitioner's initial disclosures in accordance with the rules set out by the Trademark Trial and Appeal Board.
4. Attached to the Motion as Exhibit A is a true and correct copy of the Petitioner's September 3, 2014 : First Set of Requests for Production of Documents and Things (9).

5. Attached to the Motion as Exhibit B is a true and correct copy of the Petitioner's September 4, 2014 : First Set of Interrogatories (1 - 13).
6. Attached to the Motion as Exhibit C is a true and correct copy of the Petitioner's September 4, 2014 : Second Set of Requests for Production of Documents and Things (28).
7. Attached to the Motion as Exhibit D is a true and correct copy of the Petitioner's September 5, 2014 : Second Set of Interrogatories (14 - 28).
8. Attached to the Motion as Exhibit E is a true and correct copy of the Petitioner's September 24, 2014 : First Set of Requests for Admission (102).
9. Attached to the Motion as Exhibit F is a true and correct copy of the Petitioner's September 24, 2014 : Second Set of Requests for Admission (33).
10. Attached to the Motion as Exhibit G is a true and correct copy of the Petitioner's September 24, 2014 : Third Set of Requests for Production of Documents and Things (102).
11. Copies of the above are attached hereto as Exhibits A, B, C, D, E, F and G.
12. Also attached is Petitioner's document entitled CORRECTION TO DISCOVERY INSTRUCTIONS FOR INTERROGATORIES AND REQUESTS FOR PRODUCTION OF DOCUMENTS which was sent to Respondent on September 24, 2014 - Exhibit H.
13. Respondent requested without consent and was granted by board order an extension of time to respond to Petitioner's aforementioned Discovery Requests.



14. Respondent did not at the time of requesting said extension of time make any substantive objections to Petitioner's Initial Disclosures or Discovery Requests.
15. Prior to the expiry of the granted extension of time to respond, Respondent made no objections to Petitioner's Initial Disclosures or Discovery Requests, nor did Respondent make any response to the Discovery Requests or any explanation for not responding.
16. I emailed Respondent's counsel to follow up on the failure to respond to the Discovery Requests as per the Board's Order.
17. Attached to the Motion as Exhibit I is a true and correct copy of an email received from Respondent's counsel on January 30, 2015
18. Despite numerous documents from Respondent's counsel lecturing Petitioner on the rules applicable to this case, Petitioner has attempted to conduct its activities according to the applicable rules with proper conduct and respect.
19. In its defective Initial Disclosures, Respondent advised that records covering all the relevant activities conducted with respect to its two registered trademarks (Yes and YES International) in the United States of America will be available at their lawyers' offices in Antwerp, Belgium. None of these records have been made available to Petitioner.
20. Pursuant to the Rules applicable to these proceedings, it is not permissible to require the Petitioner to travel to Antwerp, Belgium to inspect the documents even if they were ever made available there.

21. Although these proceedings have been suspended pending various motions and board orders since January 2015, we have taken those opportunities where we responded to such matters to remind the Respondent of its Discovery Obligations and failure to comply, hoping to get Respondent's attorneys' response, however no response has been received. We now believe that we have exhausted any means to elicit a response or action from Respondent or its attorneys and have acted in good faith to try to inform Respondent of its obligations and persuade Respondent's attorneys to respond and thus are required to submit this Motion to enforce our discovery rights so as not to be prejudiced in these proceedings.

22. Petitioner has made good faith efforts through written correspondence to resolve the issues in this motion. Unfortunately, no agreement has been reached. Respondent's counsel's email shown in Exhibit I is evidence of the lengths to which Respondent will go to obfuscate and abuse the process and forms the rationale behind Petitioner's request that the Board sanctions both Petitioner and its counsel.

Executed this 1<sup>st</sup> day of February 2016 in Bangkok, Thailand.

By: \_\_\_\_\_  
Mr. Lance Andrew Straube