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Filing date: **01/28/2014**

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

Proceeding	92057438
Party	Plaintiff Bacardi & Company Limited
Correspondence Address	JANICE W HOUSEY SYMBUS LAW GROUP LLC PO BOX 11085 MCLEAN, VA 22101 UNITED STATES jhousey@symbus.com, trademarks@symbus.com
Submission	Motion to Compel Discovery
Filer's Name	Janice Housey
Filer's e-mail	jhousey@symbus.com, trademarks@symbus.com
Signature	/janice housey/
Date	01/28/2014
Attachments	92057438 LUSSO Motion to Compel and for Sanctions 1-28-14.pdf(51402 bytes ) 92057438 LUSSO Discovery Motion Exh A.pdf(137015 bytes ) 92057438 LUSSO Discovery Motion Exh B.pdf(35534 bytes )

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

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Bacardi & Company Limited :  
Petitioner, :  
 :  
v. :  
 : Cancellation No. 92057438  
 :  
Giovanni Maggio :  
Registrant. : Reg. No. 3,433,372  
 : Mark: LUSSO  
 :  
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**PETITIONER’S MOTION TO COMPEL DISCOVERY AND FOR SANCTIONS  
FOR FAILURE TO SUBMIT DISCOVERY RESPONSES**

Petitioner served Interrogatories, Requests for Production of Documents and Requests for Admissions on Registrant in the above captioned case on December 6, 2013. See Exhibit A attached hereto. Responses were due January 5, 2014. Petitioner’s counsel waited several days after January 5 in case the discovery responses were mailed (despite the Parties’ agreement to service by email for most documents). As of January 13, no responses had been received. On January 13, Petitioner’s counsel followed up with Registrant’s counsel regarding the discovery responses, and Petitioner’s counsel received a read receipt indicating that the message was read on January 13. On January 15, Registrant’s counsel advised Petitioner’s counsel that the discovery requests had gone to junk mail, but offered no indication as to when she would provide responses. Petitioner agreed to an extension of time to January 24 for Registrant to respond to the discovery requests (an almost three week extension). On January 24, Petitioner’s counsel received further email communication from Registrant’s counsel, but Registrant’s counsel gave no

indication as to the whereabouts of discovery responses. See Declaration of Janice Housey, attached hereto as Exhibit B.

In light of Registrant's apparent lack of intention to respond to the outstanding discovery requests, Petitioner requests that pursuant to TBMP 527.01(b), the Board make an appropriate order. 37 CFR § 2.120(g)(2). Specifically, Petitioner requests an entry of judgment against the "disobedient party" such that Registration No. 3,433,372 is cancelled. In the alternative, Petitioner requests the sanctions put forth below.

Since the Requests for Admissions were not timely answered during the response period or by the post-deadline extension granted by Petitioner, the Requests for Admissions should be deemed admitted pursuant to Fed. R. Civ. P. 36(a), should Petitioner's request for a judgment against Registrant not be granted. Petitioner asks the Board to confirm that Petitioner's Requests for Admissions have been deemed admitted by Registrant's failure to respond to Petitioner's Requests for Admissions, pursuant to Fed. R. Civ. P. 36 and 37 CFR § 2.120(h). See *Fram Trak Industries v. WiseTracks LLC*, 77 USPQ2d 2000, 2005 (TTAB 2006) (requests for admission deemed admitted by respondent's failure to respond to petitioner's requests for admissions); *Pinnocchio's Pizza Inc. v. Sandia Inc.*, 11 USPQ2d 1227, 1228 n.5 (TTAB 1989).

Should judgment not be granted at this time, Petitioner request that Registrant be compelled to respond to the outstanding Requests for Documents and Things and the outstanding Interrogatories within 10 days of the Order of the Trademark Trial and Appeal Board in connection with this Motion. Further, Petitioner requests that sanctions be issued in the form of Registrant not being allowed to object to any of Petitioner's discovery requests. TBMP §27.01(c).

WHEREFORE, Petitioner requests that the Board issue judgment in its favor and cancel the registration, or issue the sanctions requested herein or any other sanctions the Board deems just and proper.

Respectfully submitted,

Bacardi & Company Limited



Janice W. Housey  
Counsel for Petitioner

Date: January 28, 2014

Janice W. Housey  
Symbus Law Group, LLC  
PO Box 11085  
McLean, Virginia 22102  
703.957.5274 office  
540.518.9037 fax

**CERTIFICATE OF SERVICE**

On this 28th day of January 2014, a true and correct copy of the foregoing PETITIONER'S MOTION TO COMPEL DISCOVERY AND FOR SANCTIONS FOR FAILURE TO SUBMIT DISCOVERY RESPONSES is being sent via email, as agreed, addressed as follows:

[maria@denovopc.com](mailto:maria@denovopc.com)

Maria Johnson

Counsel for Registrant

[monteolimpo@monteolimpo.it](mailto:monteolimpo@monteolimpo.it)

Tomaso Maggiore

Registrant



Janice W. Housey

**EXHIBIT A**

to

**PETITIONER'S MOTION TO COMPEL DISCOVERY AND FOR SANCTIONS  
FOR FAILURE TO SUBMIT DISCOVERY RESPONSES**

**Cancellation No. 92057438**

**Bacardi & Company Limited**

**Petitioner,**

v.

**Giovanni Maggio**

**Registrant**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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Petitioner, :  
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Giovanni Maggio :  
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**PETITIONER’S FIRST SET OF REQUESTS FOR ADMISSIONS**

Pursuant to Rule 33 of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice, Registrant is hereby requested to answer under oath and within thirty (30) days of service, each and every admission hereinafter listed.

**DEFINITIONS AND INSTRUCTIONS**

- A. The definitions and instructions contained in Petitioner’s First Set of Interrogatories (the “Interrogatories”) are incorporated herein by reference.
- B. With respect to any document requested below for which a claim of privilege, work product or confidentiality is made, Registrant shall specify (in log form) the nature of the document, identify by name, address, title and business affiliation, the writer, the addressee and all recipients thereof, and set forth the general subject matter to which the document is related, and its date.

C. Registrant shall separately identify the Request by number pursuant to which each document or thing is produced.

D. A written response to this Request is required pursuant to Rule 33, Fed.R.Civ.P.

## **REQUESTS**

### Request No. 1

Admit that Registrant has not sold wine bearing Registrant's Mark to any party or person unrelated to Registrant.

### Request No. 2

Admit that Registrant has not sold wine bearing Registrant's Mark to any business that is not under the control of Registrant.

### Request No. 3

Admit that Registrant has not sold wine bearing Registrant's Mark to any business that is not under the partial control of Registrant.

### Request No. 4

Admit that Registrant has not sold wine bearing Registrant's Mark to any business in which Registrant is not an owner.

### Request No. 5

Admit that Registrant does not advertise any goods under Registrant's Mark.

### Request No. 6

Admit that Registrant has not used Registrant's Mark on wine in 2013 in the U.S.

Request No. 7

Admit that Registrant did not use Registrant's Mark on wine in 2012 in the U.S.

Request No. 8

Admit that Registrant did not use Registrant's Mark on wine in 2011 in the U.S.

Request No. 9

Admit that Registrant did not use Registrant's Mark on wine in 2010 in the U.S.

Request No. 10

Admit that Registrant did not use Registrant's Mark on wine in 2009 in the U.S.

Request No. 11

Admit that wine is not offered under Registrant's Mark in any store in the U.S.

Request No. 12

Admit that wine is not offered under Registrant's Mark in any restaurant in the U.S.

Request No. 13

Admit that wine is not offered under Registrant's Mark in any restaurant in the U.S., other than a restaurant owned by Registrant.

Request No. 14

Admit that there is no party authorized to import wine with Registrant's Mark thereon into the U.S.

Request No. 15

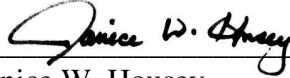
Admit that LUSSO has a particular meaning in connection with wine.

Request No. 16

Admit that LUSSO is descriptive for a type of wine.

Respectfully submitted,

Date: December 6, 2013

  
\_\_\_\_\_  
Janice W. Housey  
Counsel for Petitioner

Janice W. Housey  
Symbus Law Group, LLC  
PO Box 11085  
McLean, VA 22102

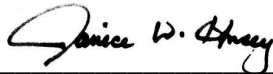
703.957.5274 office  
540.518.9037 fax

**CERTIFICATE OF SERVICE**

I hereby certify that on this 6th day of December 2013, a true and correct copy of the foregoing PETITIONER'S FIRST SET OF REQUESTS FOR ADMISSIONS TO REGISTRANT is being sent by email to:

maria@denovopc.com

Maria Johnson  
De Novo Legal PC  
2244 Faraday Avenue, Suite 103  
Carlsbad, CA 92009

  
\_\_\_\_\_  
Janice Housey

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

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Bacardi & Company Limited :  
Petitioner, :  
v. :  
Giovanni Maggio : Cancellation No. 92057438  
Registrant. : Reg. No. 3,433,372  
: Mark: LUSSO  
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**PETITIONERS’S FIRST SET OF INTERROGATORIES TO REGISTRANT**

Petitioner, Bacardi & Company Limited (“Petitioner”), serves the following interrogatories under Rule 33, Fed.R.Civ.P., to be answered separately and fully in writing under oath by an authorized representative of Registrant, Giovanni Maggio (“Registrant”). Each separately numbered or lettered sub-part of each interrogatory requires a separate answer. Furthermore, these interrogatories shall be deemed to be continuing to the fullest extent permitted by the Rules and Registrant shall provide Petitioner with any supplemental answers and additional information responsive to these interrogatories that become available to Registrant at a later date.

**DEFINITIONS AND INSTRUCTIONS**

Petitioner’s interrogatories and requests are subject to the definitions set forth below:

- A. As used herein, "Registrant" and "you" shall be construed to include Giovanni Maggio, his partners, affiliates, employees, agents, representatives, attorneys, and all other persons acting or purported to act in behalf of Registrant, and all

predecessors of Registrant and also any partly or wholly owned or controlled division, subsidiary, or parent company, and any officer, director, employee, agent, or attorney thereof.

- B. As used herein, "documents" shall mean "any designated documents" provided for under Fed. R. Civ. P. 34(a), including all original writings of any nature whatsoever and all drafts and non-identical copies thereof in the possession, custody or control of Registrant regardless of where located, and including, but not limited to, accounting material (including books of account, ledgers, orders, invoices, statements, bills, checks and vouchers), memoranda, stenographic or handwritten notes, contracts, agreements, records, mechanical/electrical/electronic or magnetic recordings, correspondence, communications, reports, studies, summaries, surveys, statistical compilations, computer printouts, minutes, charts, photographs, manuals, brochures, schedules, price lists, telegrams, teletypes, facsimiles, technical drawings, specifications, web sites (or excerpts thereof) and each and every copy of such writings or records where the original is not in the possession, custody or control of Registrant, and every copy of every such writing or record where such copy contains any commentary or notation whatsoever that does not appear on the original, said writings and copies being designated by the date, author, sender, recipient, type of writing or record or some other means of identification, and any other document as defined in Rule 34 of the Federal Rules of Civil Procedure. In all cases where originals and/or non-identical copies are not available, "documents" shall also mean identical copies of original documents and copies of non-identical copies.

- C. If Registrant refuses to identify or produce any document(s) based upon a claim of privilege, or work product immunity, Registrant shall state the same with specificity including providing a log of such documents that show sufficient information to assess the claim.
- D. As used herein, the term “Registrant’s Mark(s)” shall refer to Registrant’s LUSSO trademark as put forth in Registration No. 3,433,372 and identified in Petitioner’s Petition for Cancellation filed on June 27, 2013. (the “Cancellation.”)
- E. As used herein, the phrase “Registrant’s Goods” shall refer to those goods offered, promoted, advertised and/or sold bearing Registrant’s LUSSO mark.
- F. As used herein, the term “Petitioner’s Mark” shall refer to the GRAN LUSSO mark in which Petitioner has rights and which was identified in Petitioner’s Petition for Cancellation filed on June 27, 2013.
- G. As used herein, the phrase “Petitioner’s Goods” shall refer to those goods offered, advertised and/or sold bearing Petitioner’s Mark including “Alcoholic beverages, except beer.”
- H. As used herein, the term “regarding” means relating or referring to, incorporating, comprising, touching upon, indicating, evidencing, affirming, denying, concerned with, relevant to, or likely to lead to admissible evidence concerning.
- I. As used herein, the terms “use in commerce” or “in commerce” shall have the same meaning as these terms are used in Section 45 of the Trademark Act.
- J. As used herein, "person" shall mean a natural person, firm, partnership, corporation, proprietorship, association, or any other organization or entity.

K. As used herein, "date" shall mean the exact day, month and year if so ascertainable or, if not, the best approximation (including any relationship to other events).

L. "And" as well as "or" shall be construed disjunctively or conjunctively as necessary to bring within the scope of the interrogatory all information which might otherwise be construed to be outside its scope.

M. The singular shall include the plural and the present tense shall include the past tense and vice versa in order to bring within the scope of the interrogatory all information which might otherwise be construed to be outside its scope.

### **INTERROGATORIES**

1. State the general nature of the business of Registrant as it relates to Registrant's Mark and Registrant's Goods.

2. State with specificity the goods offered by Registrant under Registrant's Mark or any mark that includes the term LUSSO.

3. Identify all prior owners of Registrant's Mark and describe the relationship between Registrant and each of these predecessors.

4. If Registrant has any legal or business relationship or affiliation of any kind with any other party with rights to Registrant's Mark or a mark similar to Registrant's Mark, please identify the party and the mark and explain and describe the nature and duration of that relationship.

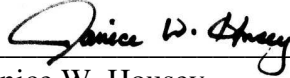
5. Identify each person having information regarding Registrant's first use of Registrant's Mark in the U.S.

6. State whether Registrant has made continuous use of Registrant's Mark on wine in the U.S. and indicate the date(s) the same was offered in the U.S.

7. Identify all assignments or licenses relating to Registrant's Mark.
8. Identify the annual sales, in volume and dollars, of the wine offered under Registrant's Mark in the United States for the first five years of use and each of the last five years.
9. State the wholesale and retail prices of each of the goods offered under Registrant's Mark, for each of the last five years in the U.S.
10. Identify all customers of Registrant's Goods.
11. Identify any distribution agreement for distribution of Registrant's Goods.

Respectfully submitted,

Date: December 6, 2013

  
\_\_\_\_\_  
Janice W. Housey  
Counsel for Petitioner

Janice W. Housey  
Symbus Law Group, LLC  
PO Box 11085  
McLean, VA 22102

703.957.5274 office  
540.518.9037 fax

**CERTIFICATE OF SERVICE**

I hereby certify that on this 6th day of December 2013, a true and correct copy of the foregoing PETITIONER'S FIRST SET OF INTERROGATORIES TO REGISTRANT is being sent by email to:

maria@denovopc.com

Maria Johnson  
De Novo Legal PC  
2244 Faraday Avenue, Suite 103  
Carlsbad, CA 92009



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Janice Housey

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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: Cancellation No. 92057438  
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Giovanni Maggio : Reg. No. 3,433,372  
Registrant. : Mark: LUSSO  
: :  
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**PETITIONERS’S FIRST SET OF REQUESTS FOR PRODUCTION  
OF DOCUMENTS AND THINGS TO REGISTRANT**

Petitioner, Bacardi & Company Limited, hereby requests, pursuant to Rule 34, Fed.R.Civ.P., that Registrant, Giovanni Maggio, produce the documents and things listed below for inspection and copying, and that said production be made accompanying Registrant’s service of its responses to these requests upon Petitioner at the offices of Symbus Law Group, LLC.

**DEFINITIONS AND INSTRUCTIONS**

- A. The definitions and instructions contained in Petitioner’s First Set of Interrogatories (the “Interrogatories”) are incorporated herein by reference.
- B. With respect to any document requested below for which a claim of privilege, work product or confidentiality is made, Registrant shall specify (in log form) the nature of the document, identify by name, address, title and business affiliation,

the writer, the addressee and all recipients thereof, and set forth the general subject matter to which the document is related, and its date.

- C. Registrant shall separately identify the Request by number pursuant to which each document or thing is produced.
- D. A written response to this Request is required pursuant to Rule 34, Fed.R.Civ.P.

### **REQUESTS**

1. A representative sample of documents reflecting the general nature of the business of Registrant.
2. A representative sample of documents showing the actual and/or proposed business line under Registrant's Mark.
3. A representative sample of brochures, flyers, promotional literature or other materials distributed, or intended to be distributed, by or on behalf of Registrant to U.S. customers or clients or prospective U.S. customers or clients of Registrant.
4. All documents relating to first use of Registrant's Mark as a commercial designation, as a trademark, or as a trade name by any entity or person, including Registrant, in the United States.
5. All documents referring to, relating to, or reflecting Registrant's first use of Registrant's Mark on which it intends to rely in the subject Cancellation, including use as a trademark in the United States, as well as all other uses for each and every good for which Registrant believes it is entitled to use Registrant's Mark.
6. All documents referring to, relating to, reflecting, supporting, or corroborating the date of first use on which Registrant will rely in the present proceeding for Registrant's Goods.

7. All documents relating to the customers of Registrant for the first five transactions in which Registrant's Mark has been used by Registrant for Registrant's Goods.

8. All documents relating to the customers of Registrant for the most recent five transactions in which Registrant's Mark has been used by Registrant for Registrant's Goods.

9. All other documents, specifications, sales records, promotional literature, advertising or any other tangible things not covered by any of the preceding document categories purporting to show the earliest date of use of Registrant's Mark as a mark or as a trade name for Registrant's Goods.

10. All documents, including but not limited to license agreements, assignment documents, letters of consent relating to any authorization of or by any third parties or persons to use Registrant's Mark in connection with a sale or offering of any goods or services.

11. All documents relating to Registrant's advertising expenditures for Registrant's Mark, and/or proposed advertising expenditures, for the last five years and the next two years.

12. All articles or stories in magazines, newspapers or trade publications, or any form of publicity other than advertising, in which Registrant's Mark, as used by Registrant, has been made known to the public.

13. Documents sufficient to show how quality control standards are assured for Registrant's Goods under Registrant's Mark.

14. Documents sufficient to show the volume of sales in dollars of Registrant's Goods under Registrant's Mark in the United States.

15. All documents referring to or relating to third parties who produce products under Registrant's Mark for or on behalf of Registrant.

16. Representative documents reflecting the actual and/or intended classes of purchasers and channels of trade or distribution for the goods offered or sold under Registrant's Mark.

17. Documents sufficient to show any past, current or future marketing plans to expand the range of goods offered under Registrant's Mark.

18. A copy of each different type of print advertisement, radio promotion, television promotion or billboard usage that has been run by or on behalf of Registrant featuring Registrant's Mark.

19. All documents, including but not limited to photographs or other reproductions, depicting or reflecting the nature of any display of Registrant featuring Registrant's Mark at any trade show or exhibition or other public or private venue.

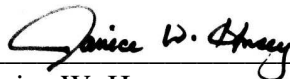
20. Documents or things, such as, but not limited to photographs or other reproductions, indicating the nature of any advertising signs or displays by or on behalf of Registrant featuring Registrant's Mark.

21. All documents that support Registrant's statements in its Answer.

22. All documents relating to any plans for Registrant to expand use of Registrant's Mark in the U.S.

Respectfully submitted,

Date: December 6, 2013

  
\_\_\_\_\_  
Janice W. Housey  
Counsel for Petitioner

Janice W. Housey  
Symbus Law Group, LLC  
PO Box 11085  
McLean, VA 22102

703.957.5274 office  
540.518.9037 fax

### **CERTIFICATE OF SERVICE**

I hereby certify that on this 6th day of December 2013, a true and correct copy of the foregoing PETITIONER'S FIRST SET OF REQUESTS FOR PRODUCTION OF DOCUMENTS AND THINGS TO REGISTRANT is being sent by email to:

maria@denovopc.com

Maria Johnson  
De Novo Legal PC  
2244 Faraday Avenue, Suite 103  
Carlsbad, CA 92009



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Janice Housey

**EXHIBIT B**

to

**PETITIONER'S MOTION TO COMPEL DISCOVERY AND FOR SANCTIONS  
FOR FAILURE TO SUBMIT DISCOVERY RESPONSES**

**Cancellation No. 92057438**

**Bacardi & Company Limited**

**Petitioner,**

v.

**Giovanni Maggio**

**Registrant**

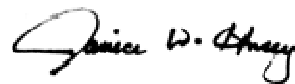


5. On December 6, 2013, my legal assistant sent an email to Maria Johnson at the email address [maria@denovopc.com](mailto:maria@denovopc.com), copying me, with the following attachments:
  - PETITIONER'S FIRST SET OF INTERROGATORIES TO REGISTRANT
  - PETITIONER'S FIRST SET OF REQUESTS FOR PRODUCTION OF DOCUMENTS AND THINGS TO REGISTRANT
  - PETITIONER'S FIRST SET OF REQUESTS FOR ADMISSIONS TO REGISTRANT.
6. The responses were due January 5, 2014.
7. As of January 13, 2014, we had received no responses to the discovery requests sent to Ms. Johnson by email on December 6, 2013.
8. On January 13, 2014, I sent an email to Ms. Johnson, requesting a "read receipt," noting that we had received no responses to our discovery requests and advising Ms. Johnson that we would need to ask the Board to intervene if we did not receive complete responses by the end of the week.
9. On January 13, 2014 I received a "read receipt" indicating that my email sent to Ms. Johnson on January 13 regarding our discovery requests had been read.
10. I received no response from Ms. Johnson until January 15, 2014.
11. On January 15, 2014, I received a voice mail message and an email from Ms. Johnson, stating that the discovery requests had been in her "junk mail" files and she had not seen them.

12. On January 15, 2014, I responded by email to Ms. Johnson, offering an extension of time until January 24, 2014 to respond to the discovery requests.
13. On January 24, 2014 I exchanged further emails with Ms. Johnson and again indicated that we needed discovery responses immediately, but received no response and no indication that any discovery responses would be forthcoming.
14. As of January 28, 2014, we have received no responses to our discovery requests which were served by email on December 6, 2013 and no indication that the same will be forthcoming.

DECLARATION: The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

Date: January 28, 2014



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Name: Janice Housey