ESTTA Tracking number: **ESTTA677193**

Filing date: **06/09/2015**

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

Proceeding	92058280
Party	Defendant Tenggis Co., Ltd.
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Signature	/Peter D. Gordon/
Date	06/09/2015
Attachments	final JC REPLY TO OPPOSITION TTAB.pdf(263964 bytes)

Petition to Cancel
Reg. No. 3,949,134
Mark: CHINGGIS KHAAN KHAAN OF BEERS
Registrant: Tenggis Co., Ltd.
Petitioner: APU XK

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

APU XK, Petitioner	Cancellation No. 92058280
TENGGIS CO., LTD. Registrant	Registration No. 3949134

RESPONSE TO OPPOSITION
WITH SUPPLEMENTARY GORDON DECLARATION

TO THE TRADEMARK TRIAL AND APPEAL BOARD, PARTIES HEREIN AND TO THEIR RESPECTIVE ATTORNEYS OF RECORD:

Registrant Triggis Co., Ltd./E. Shagdarguntev ("Registrant") hereby files the following Response to the 168-page Opposition to the Motion to Withdraw Admissions relating to the First Set of Request for Admissions, served by the Petitioner on November 7, 2014, and re-served on November 14, 2014.

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I. RELEVANT FACTUAL SUMMARY

A. 10-Day Delay with Admission of Error by Tenggis'

Counsel Lebow relies in his Opposition on the fact that Responses were due on December 12, 2014 (Opposition at §15, p.3), predicated on service of the Requests on November 7, 2014 and admits that Responses were in fact served only 10-days later by Registrant on December 22, 2014, (Opposition at §15, p. 5). This short delay is insufficient to support the forfeiture Petitioner seeks.

B. Actually, Only 3-Day Delay in Serving Responses to Corrected and Re-served Requests for Admissions:

Please note the Proof of Service on Petitioner's First Set of Requests for Admission:

"7th day of **July November** 2014 via U.S. mail, …"

See last page of Exhibit "C," attached to the Opposition. Attorney Lebow suppresses this service error and fails to disclose that his Requests were re-served on **November 14, 2014**. See the reference to the re-served date in attorney Gordon's ***mea culpa*** introductory statement set out in the Responses to the First Set of Requests for Admission, attached as Exhibit "7" to the Motion to Withdraw (erroneously referred to as "July 14, 2014"). See Supplementary Declaration of Peter D. Gordon, attached hereto. Consequently, adding the 5-day mailing rule,

the Responses in issue were due, based on the November 14, 2014, corrected service date, not until December 19, 2014. Given that the Responses were served on December 22, 2014, they were only 3-days late ! See Proof of Service on Exhibit "7."

C. Registrant Timely Served an Objection to Belatedly Served Discovery:

Please also note that Registrant served an Objection to Belatedly Served Discovery on December 8, 2014, while mistakenly believing that discovery responses were time-barred. See Exhibit "3" to the Motion to Withdraw. There was also pending the December 3, 2014, Registrant's Opposition to Petitioner's Request to Correct or Extend Discovery, which is Exhibit "2" to the Motion to Set Aside.

D. Harsh, Vindictive and Unjustified Posturing:

Despite the immediate curative step by counsel for Registrant of serving Responses to the First Request for Admission, Petitioner argues for the Draconian position that Counsel Gordon's admitted unfamiliarity with the TTAB rule--holding that discovery response are due even after the discovery cut-off date under 37 CFR Section 2.120(a)(3) --renders this short delay in serving Responses inexcusable. It is utter gamesmanship, elevating form-above-substance, to subvert

Registrant's right to the Mark for a mere 3 to 10-day delay in serving responses in this fact setting. Given attorney Gordon's express reliance in the Motion to Withdraw on counsel's own error under Rule 36(b), the Motion provides ample justification to order Withdrawal of the Admissions. See §1 of Attorney Peter Gordon's Declaration in support of the Motion to Withdraw Admissions.

E. Bad Faith "Lying in the Bushes:"

Petitioner argues in its Opposition for a forfeiture terminating Registrant's rights in the mark, without a hearing on the merits, by means of ***ad hominem*** attack and mistakenly presenting more than 150-pages of discovery maneuverings. This is but a small part of the 3-waves of discovery by Petitioner! Given the effort now being made to foist the Admissions on Petitioner, **it appears that counsel Lebow's successive rounds of (a) Second set of Requests for Admission, Interrogatories and Document Productions, and (b) his Third set of Requests for Admissions, Interrogatories and Document Productions, as well as his (c) repeated Meet and Confer demands for Supplementary Responses were all a distraction. He sought to have Registrant lulled into the belief that Petitioner's successive waves of discovery were putting the case-at-issue**.

Instead, Lebow has been "lying in the bushes" to use the few days' late Responses to Admissions as a coup d'gras to be put before the Board at the

penultimate moment in order to terminate the case, without allowing Registrant a hearing on the merits. It is now clear, attorney Lebow's hidden agenda was to exploit the ***de minimis*** error by Registrant's counsel in serving Responses a few days late. See Supplementary Declaration of Peter D. Gordon, ¶s 3-6, attached hereto.

F. <u>Lack of Prejudice – Willingness to Extend Discovery</u>:

Given that Petitioner obtained additional extensions in time previously for discovery and has served two supplementary Requests for Admission, Interrogatories and Document Production Requests-- 2nd and 3rd sets --thus it would seem that there could be no prejudice to it by reason of the short 3-10 day delay in serving Registrant's Responses to the First Set of Requests for Admission. Nevertheless, in order to avert a forfeiture, especially when Counsel Gordon's error, mistake or excusable neglect should not be attributable to the Registrant-- who is without fault-- Registrant would rather stipulate to a yet further extension of discovery rather than be denied this withdrawal motion.

Consequently, if the Board determines that there is any justification for Petitioner's claim of prejudice, that can be cured, assuredly, by means of a yet further discovery extension.

II. <u>RELEVANT AUTHORITIES</u>

A. <u>The Board is Authorized to Permit the Withdrawal of Respondent's Admissions</u>:

A party may withdraw or amend an admission made in response to a Request for Admission on leave of court granted after notice to all parties pursuant to TBMP §525, Fed. R. Civ. P. 36(b), et seq. The governing statutes permit withdrawal or amendment of an admission if it determined that (a) the admission was the result of mistake, inadvertence, or excusable neglect, and (b) that the party who obtained the admission will not be substantially prejudiced in maintaining that party's action or defense on the merits. In addition *Giersch v. Scripps Networks, Inc.*, 85 USPQ2d 1306 (TTAB 2007) See also, 90 USPQ21 1020 (TTAB2009) holds that only 2 prongs need be satisfied: (1) will the deeming of the admissions as admitted undermine the discovery process; and (2) there is no substantial prejudice to the propounding party. Here, Responses were promptly sent to APU XK within 3 or 10-days of the due date.

The mass of subsequent discovery obtained by Petitioner shows lack of any substantial prejudice.

B. <u>Authorities Cited In Petitioner's Opposition Favor Registrant's Motion to Withdraw Admissions</u>:

In the Opposition, Petitioner fails to support any fact or argument by the required declaration or affidavit. The emails and letter exchanges, discovery items and supplementary demands do not support denial of the instant motion. Furthermore, Petitioner cites the case of *Giersch v. Scripps Networks, Inc.*, 85 USPQ2d 1306 (TTAB 2007), in which case the Board's ruling undermines its own argument. In *Scripps*,the parties had agreed to two extensions of time to respond to Petitioners' requests for admissions. Scripps then mistakenly assumed that Petitioners would agree to a third extension, but was then refused. The admissions were thus deemed admitted.

Scripps moved to re-open its time for response or alternatively to withdraw its admissions and submit amended responses. However, Petitioners pressed the advantage and predicated on the Admissions moved for summary judgment and for leave to add a claim of fraud.

C. *Giersch* Ruling Supports Ordering Withdrawal of Admissions:

On the Rule 36(b) motion, the Board held that it could permit withdrawal or amendment of admissions when "**the presentation of the merits of the action will be subserved thereby and the party who obtained the admission fails to satisfy the court that withdrawal or amendment will prejudice that party in maintaining the action or defense on the merits."** Id. The Board found that

without withdrawal of the admissions, "respondent would be held to have admitted critical elements of petitioner's asserted claims." Id. Respondent's proposed responses include denials of many of the previously-admitted facts, "thereby demonstrating that the supposedly admitted materials are actually disputed." Id. **This is similar to the situation here in the belatedly served responses denying the requested admissions and putting matters in issue, not admitting away Registrant's case**.

D. Standard of Proof to Show Prejudice to Petitioner:

The Board noted that the Petitioners in Giersch pointed to "no particular prejudice in the form of special difficulties it could potentially face caused by the need to obtain evidence." The Board found that Petitioner's reliance on the admissions in preparing their motions for summary judgment "does not rise to the level of 'prejudice' as contemplated under Rule 36(b)." Id**. Here, Petitioner cannot show prejudice-- given two rounds of subsequent discovery, including 2nd and 3rd Sets of Request for Admissions, Interrogatories and Document Production Requests.**

Turning now to APU's argument for prejudice, it fails to meet the higher standard required: "'[P]rejudice relates to the special difficulties a party may face caused by the sudden need to obtain evidence upon withdrawal or amendment of

admission." Citing *Kerry Steel, Inc. v. Paragon Industries, Inc., 106 F.3d 147* (6th Cir. 1997). This authority, cited by Petitioner, is applicable here and yet again undermines APU XK's argument:

> *I*f no formal motion was necessary here, it does not seem to us that the district abused its discretion in deeming the admission withdrawn. A "district court has considerable discretion over whether to permit withdrawal or amendment of admissions." *American Auto*., 930 F.2d at 1119. The court's discretion must be exercised in light of Rule 36(b), which permits withdrawal (1) "when the presentation of the merits of the action will be subserved thereby," and (2) "when the party who obtained the admission fails to satisfy the court that withdrawal or amendment will prejudice that party in maintaining the action or defense on the merits." Here there can be no doubt that the presentation of the merits of the jurisdictional issue was served by allowing the withdrawal of the admission. In regard to prejudice, " [t]he prejudice contemplated by [Rule 36(b)] is not simply that the party who initially obtained the admission will now have to convince the fact finder of its truth." *Brook Village North Assoc. v. General Elec. Co*., 686 F.2d 66, 70 (1st Cir. 1982). Prejudice under Rule 36(b), rather, "relates to special difficulties a party may face caused by a sudden need to obtain evidence upon withdrawal or amendment of an admission." *American Auto*., 930 F.2d at 1120. Kerry Steel has not shown prejudice of the sort required by the rule.

Id. at p.154. Petitioner fails to show the required level of "special difficulties" resulting from withdrawal of the admissions. This authority supports Registrant's prayer for an Order from the Board authorizing withdrawal of said admissions.

E. <u>Determining This Case on the Merits Will Not Be Served By Allowing the Matters to Be Deemed Admitted</u>:

Despite the general rule that allows for matters to be deemed admitted for a party's failure to timely respond to a request for admission, a strong policy favors determination on the merits. See *Kerry Steel, Inc. v. Paragon Industries, Inc., 106 F.3d 147* (6th Cir. 1997) When a matter is deemed admitted, no contradictory evidence may be introduced. The strong public policy in favor of determining issues on their merits will not be served by admitting the Requests here. Responses were served on Petitioner, and Petitioner will not be substantially prejudiced by the Board's granting of this motion for relief. See Exhibit "7" to the Motion to Withdraw.

The discovery disclosures by Registrant, on the whole, have been meaningful. The purported discovery difficulties claimed in the Opposition all part and parcel of the discovery process, especially when attorney Lebow pursues his massively voluminous discovery: Document Production Requests and Interrogatories have covered the same topics over and over again, in slightly varied form or rephrased, but covering the same substantive material numerous times. Please See Exhibits "7", "8" and "9" to initial Motion; See Exhibits C, D, E, H and J of the Opposition. Make no mistake, discovery has been repeatedly provided to

Petitioner by Registrant consisting of substantial and detailed responses, DVD, documents, photos, all of which have been tendered to Petitioner to fully prepare its position in this litigation. See Factual Background to initial Motion pgs. 5, 6, and 7. Further corroborating these points, see ¶s 1, 3, 7, 10, 12-14 of Declaration of Peter D. Gordon.

F. <u>In the Alternative, Stipulation to Extend Discovery</u>:

While the massive Exhibits to the Opposition clearly demonstrate the extent of discovery that has been pursued by Petitioner's counsel, and that responses and supplementary responses have been repeatedly provided to the best ability of the Registrant, nevertheless, in order to avert the catastrophic denial of the right to a meaningful trial and presentation of issues, Respondent is willing to stipulate to a yet further extension of discovery requested by Petitioner. This stipulation is submitted, *<u>arguendo</u>*, only if the Board determines that there is a substantial quantum of prejudice to Petitioner by granting the prayer for withdrawal of subject admissions.

While Registrant has pointed out that discovery by Petitioner has repeatedly covered the same areas as to which the admissions related in the First Request for Admissions, and that more than ample time has been made available for discovery on those issues, Registrant would prefer granting the leave sought for

additional time to conduct yet more discovery, rather than suffer the forfeiture resulting from the Requests being deemed admitted.

III. CONCLUSION

Accordingly, the Board should grant Registrant's Motion to Withdraw. An order should be issued by the Board authorizing withdrawal of any admissions resulting from the short delay in serving Registrant's Responses to Petitioner's First Request for Admissions so as to allow for a determination of this dispute on the merits.

Dated: June 9, 2015

Respectfully submitted,

PETER D. GORDON, ESQ.
/Peter D. Gordon/

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CERTIFICATE OF MAILING

I hereby certify that a true and accurate copy of the within Motion to Withdraw Admissions is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to Petitioner's counsel at:

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On: June 9, 2015

/Peter D. Gordon/
PETER D. GORDON, ESQ.