ESTTA Tracking number: **ESTTA816816**

Filing date: **04/25/2017**

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

| | |
|---|---|
| Proceeding | 92061508 |
| Party | Defendant<br>BioUrn Incorporated |
| Correspondence Address | STACY R HALPERN<br>KNOBBE MARTENS OLSON & BEAR LLP<br>2040 MAIN ST, 14TH FLOOR<br>IRVINE, CA 92614<br>UNITED STATES<br>efiling@Knobbe.com, stacey.halpern@Knobbe.com, Jonathan.Menkes@knobbe.com |
| Submission | Opposition/Response to Motion |
| Filer's Name | Jonathan A. Menkes |
| Filer's e-mail | efiling@knobbe.com |
| Signature | /Jonathan A. Menkes/ |
| Date | 04/25/2017 |
| Attachments | 2017-04-25 OPP to Motion to Compel - DEC ISO Opp to Motion - BURN.011N.pdf(216149 bytes ) |

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

ESTUDI MOLINE DISSENY, S.L.,
Petitioner,

v.

BIOURN INCORPORATED (by assignment from MY ETERNAL FAMILY TREE, LLC)
Respondent.

Cancellation No. 92061508

Mark:
Reg. No. 4,477,402

**RESPONDENT BIOURN INCORPORATED'S OPPOSITION TO PETITIONER'S MOTION TO COMPEL**

Respondent, BioUrn Incorporated ("Respondent"), hereby opposes the Motion to Compel filed by Petitioner Estudi Moline Disseny, S.L. ("Petitioner"). As Petitioner did not timely serve discovery requests pursuant to 37 CFR § 2.120(a), Petitioner's Motion to Compel should be denied.

Specifically, Petitioner filed its Petition to Cancel on May 18, 2015, alleging a likelihood of confusion between Petitioner's mark, BIOS and Design (U.S. Serial No. 86/180,988) and Respondent's mark, BIO URN A LOVING, LIVING TRIBUTE TO YOUR PETS AND LOVED ONES & Design (U.S. Registration No. 4,477,402). *See* Dkt. Entry No. 1. Respondent filed its answer to the Petition to Cancel on July 27, 2015, denying the allegations in the Petition to Cancel. *See* Dkt. Entry No. 6. Throughout the course of this cancellation action, the proceedings were suspended pending settlement talks, the most recent of which was filed by

Petitioner on August 25, 2016. Dkt. Entry No. 17. Settlement talks fell through **in October of 2016.** Declaration of Jonathan Menkes ("Menkes Declaration"), 2. Petitioner served its initial disclosures on October 24, 2016, but inexplicably waited until February 20, 2017 (nearly four months) to serve its discovery requests. *Id.* at 3. Under the current schedule, discovery was set to close on March 21, 2017. *Id.* at 4. As Petitioner served its discovery requests on February 20, 2017, Respondent's responses were not due until March 22, 2017, which was after the close of discovery. *Id.* at 3-4.

On March 22, 2017, Respondent served its objections to Petitioner's discovery requests on the grounds that the requests were untimely and no response was required pursuant to TBMP §§ 403.01, 403.03. *Id.* at 5; *see also* Pet. Mot. at 2, Exhibit C. Respondent submits that the applicable rules are unambiguous. *See* TBMP § 403.01 ("A party has no obligation to respond to an untimely request for discovery, nor is a party obliged to respond to discovery when initial disclosures have not been served, although a party should object on that basis.") (emphasis added); TBMP § 403.03 ("Because interrogatories, requests for production and requests for admissions must be served early enough that responses will be due by the closing date of discovery, a responding party may object to such discovery requests on the ground that responses would be due after the close of discovery") (emphasis added).

Petitioner had more than sufficient time to serve discovery requests given that it served initial disclosures on October 24, 2016, and discovery did not close until March 21, 2017. Menkes Decl., 3-4. Further, the changes in the Trademark Rules were in effect as of January 14, 2017, over a month prior to Petitioner serving its discovery requests on February 20, 2017. Moreover, the USPTO published a Notice of Final Rulemaking in the Federal Register on October 7, 2016, which was nearly two weeks prior to Petitioner servings its initial disclosures

on October 24, 2016. In addition, the Board has been emailing the parties and their counsel to remind them of the rule changes. Thus, Petitioner knew or should have known the deadline to serve discovery requests, or at the very least could have served its discovery requests at any point from October 24, 2016 to February 17, 2017.

In short, any prejudice suffered by Petitioner as a result of serving the discovery requests after the deadline was entirely within Petitioner's control. Accordingly, Respondent hereby requests that the Board deny Petitioner's Motion to Compel as Petitioner failed to timely serve its discovery requests under the applicable rules. *See* 37 § CFR 2.120(a) (stating that discovery requests "must be served early enough in the discovery period, as originally set or as may been reset by the Board, so that responses will be due no later than the close of discovery." (emphasis added); TBMP § 403.01 ("A party has no obligation to respond to an untimely request for discovery, nor is a party obliged to respond to discovery when initial disclosures have not been served, although a party should object on that basis.") (emphasis added).

Respectfully submitted,
KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: April 25, 2017

By: /Jonathan A. Menkes/

Stacey R. Halpern
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Attorneys for Respondent,
BIOURN INCORPORATED

## CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **RESPONDENT BIOURN INCORPORATED'S OPPOSITION TO PETITIONER'S MOTION TO COMPEL** upon Petitioner's counsel on April 25, 2017, addressed to:

Julie B. Seyler, Esq.
ABELMAN FRAYNE & SCHWAB
ehalstead@lawabel.com,docket@lawabel.com,jbseyler@lawabel.com

Megan Sheetz

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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|---|---|
| ESTUDI MOLINE DISSENY, S.L.,<br><br>Petitioner,<br><br>v.<br><br>BIOURN INCORPORATED (by assignment from MY ETERNAL FAMILY TREE, LLC),<br><br>Respondent. | Cancellation No.: 92061508<br><br>Mark: <br><br>Reg. No.: 4,477,402 |

**DECLARATION OF JONATHAN A. MENKES IN SUPPORT OF RESPONDENT'S OPPOSITION TO PETITIONER'S MOTION TO COMPEL**

1. I am an attorney licensed to practice in the State of California. I am an associate with the law firm of Knobbe, Martens, Olson & Bear LLP, counsel for Respondent, BioUrn Incorporated ("Respondent") in the above-identified Cancellation proceeding. I have personal knowledge of the facts set forth below. If called upon and sworn as a witness, I could and would competently testify as set forth below.

2. The proceedings had previously been suspended pending settlement talks. However, in October of 2016, settlement talks ceased as the parties were unable to reach a mutually satisfactory agreement.

3. Petitioner served its initial disclosures on October 24, 2016 and did not serve its discovery requests until February 20, 2017.

4. Fact discovery closed on March 21, 2017 and Respondent's responses to the requests were not due until March 22, 2017.

5. On March 22, 2017, Respondent served its objections to Petitioner's discovery requests.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

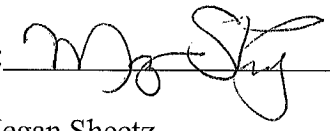
Dated: April 25, 2017

By: /Jonathan A. Menkes/
Jonathan A. Menkes

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **DECLARATION OF JONATHAN A. MENKES IN SUPPORT OF RESPONDENT'S OPPOSITION OF PETITIONER'S MOTION TO COMPEL** has been served on Petitioner's counsel on April 25, 2017 via electronic mail to:

Julie B. Seyler, Esq.
ABELMAN FRAYNE & SCHWAB
ehalstead@lawabel.com,docket@lawabel.com,jbseyler@lawabel.com

Signature: 

Name: Megan Sheetz

Date: April 25, 2017

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