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

Proceeding	92065178
Party	Defendant The General Conference Corporation of Seventh-day Adventists
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Philanthropist.com, Inc.

Petitioner,

vs.

General Conference Corporation
of Seventh-day Adventists

Registrant.

Cancellation No. 92065178 (Parent)
Cancellation No. 92065255

**REGISTRANT’S REPLY BRIEF IN SUPPORT OF ITS
MOTION TO REOPEN DISCOVERY AND SUSPEND PROCEEDINGS**

I. INTRODUCTION

Registrant General Conference Corporation of Seventh-day Adventists ("Registrant") hereby submits this reply brief in support of its Motion to Reopen Discovery and Suspend Proceedings ("Registrant’s Motion").

Petitioner Philanthropist.com, Inc. ("Petitioner") has failed to show any reason that the Motion should be denied. Petitioner has misrepresented the nature of the relief Registrant is seeking, as well as the extent of the responsive documents that it has been withholding and still continues to withhold. Petitioner has also not provided any justification for its failure to comply with its discovery obligations, and continues to assert that it is entitled to withhold responsive documents on the baseless grounds that the documents are “publicly available,” that the parties have “equal access” to the documents, or that the documents can be introduced via Notice of Reliance without being produced during discovery. Finally, Petitioner has failed to establish that

any other remedy would be sufficient to resolve the issues surrounding Petitioner's document production.

Therefore, the Board should grant Registrant's Motion and issue an order reopening discovery for 60 days.

II. PETITIONER HAS MISREPRESENTED REGISTRANT'S ARGUMENTS AND THE FACTS AT ISSUE

In an effort to avoid having to re-enter discovery and produce responsive documents, Petitioner has grossly misrepresented the nature of the relief that Registrant is seeking, as well as the extent of Petitioner's failure to comply with its discovery obligations. Petitioner falsely states that Registrant is seeking to take "sixteen additional depositions from eleven new witnesses, and to request countless new categories of information from Petitioner." Petitioner's Brief, at 10. In fact, Registrant has not indicated that it intends to take any further discovery depositions, and Registrant does not currently anticipate taking any further depositions during the reopened discovery period.¹ Petitioner also falsely claims that Registrant is seeking to reopen the expert disclosures period, when in fact Registrant is only seeking to re-open fact discovery.²

Petitioner has also misrepresented the extent of its failure to comply with its discovery obligations, arguing that the unproduced documents consist of "only" four publications. However, as noted in Registrant's Motion, Petitioner served notice in its Pretrial Disclosures that

¹ Registrant did, prior to filing the Motion to Reopen, serve amended Initial Disclosures identifying several additional witnesses that Registrant may use to support its claims. However, Registrant has every right to amend its Initial Disclosures prior to serving its Pretrial Disclosures, and is in fact required to amend its Initial Disclosures under Rule 26(e). The amended Initial Disclosures have nothing to do with the subject matter of Registrant's Motion to Reopen Discovery, despite Petitioner's effort to confuse the issues.

² Registrant currently expects that it will only need to take written fact discovery during the reopened discovery period. However, Registrant reserves the right to seek additional discovery depositions, or to move to re-open expert discovery if necessary, based upon any new documents produced by Petitioner.

it intends to rely at trial upon other additional documents that have not yet been produced.

Petitioner's Pretrial Disclosures listed the following documents:

- Publicly available media, news, and opinion articles concerning Respondent and Respondent's mark;
- Evidence of third-party use, advertisement, and promotion of the word "Adventist";
- ...
- Publicly available dictionary, encyclopedia, and reference book excerpts relating to the history, etymology, meaning, and use of the word "Adventist";
- Publicly available scholarly journals and publications relating to the word "Adventist" and the Adventist religion;
- ...
- Publicly available documents reflecting consumer views or comments about the word "Adventist";
- Other documents, as yet unascertained, showing the genericness of Respondent's mark in connection with Respondent's goods and services.

Registrant's Motion, Ex. 5.

With the exception of a few dictionary and encyclopedia excerpts and online blog posts, Petitioner has not produced any of these documents. Petitioner has not produced any "evidence of third party use, advertisement, and promotion of the word 'Adventist'"; any "media, news, and opinion articles concerning Respondent and Respondent's mark" (other than the blog posts); or any "documents reflecting consumer views or comments about the word 'Adventist.'" All of these documents would have been directly responsive to several of Registrant's document requests. It must be assumed that Petitioner has also been withholding these documents on the grounds that they are "publicly available."

Finally, Petitioner falsely suggests that Registrant somehow delayed in seeking discovery from Petitioner, or that Registrant is merely seeking to reopen discovery because the Board

denied Registrant's Motion for Summary Judgment. Both of these allegations are false. Registrant was diligent in seeking written discovery during the original discovery period; as Petitioner admits, Registrant served 39 interrogatories and 29 requests for production, in two separate sets. Petitioner's Brief, at 4. Petitioner served several hundred pages of documents in response to these requests and never indicated that it objected to any of the requests or that it was withholding any responsive documents.

It was only after Petitioner filed its summary judgment brief citing several previously unproduced documents that Registrant became aware that Petitioner had not complied with its discovery obligations. However, at that time the case was suspended and the parties were prohibited from filing any papers not germane to the summary judgment motion. *See* 26 TTABVUE. Registrant acted promptly to reopen discovery once the Board ruled on summary judgment, and cannot be penalized for not addressing the problems with Petitioner's document production while the case was suspended. *Cf. Jive Software, Inc. v. Jive Communications, Inc.*, 125 U.S.P.Q.2d 1175, 1181 (TTAB 2017). ("We decline to penalize a party for taking no action while proceedings were suspended by the Board.").

III. PETITIONER'S EXCUSES FOR FAILING TO COMPLY WITH ITS DISCOVERY OBLIGATIONS ARE BASELESS

Petitioner's Brief also fails to set forth any reasonable justification for its failure to produce responsive documents during discovery. Petitioner's original excuse for not producing the documents at issue is that they were "publicly available." However, as Registrant pointed out in its Motion, courts have consistently rejected the argument that a party is not required to produce responsive documents because they are "publicly available." 31 TTABVUE at 6-7.

Petitioner has now largely abandoned its "publicly available" argument, and shifted to a new argument that it was not required to produce the responsive publications because the

Board's rules allow printed publications to be introduced at trial via Notice of Reliance. Petitioner's Brief, at 7-8. However, whether or not documents can be introduced via Notice of Reliance has no bearing on whether they must be produced during discovery. It is a basic tenet of trial procedure, whether in court or before the Board, that a party may not rely on evidence at trial that it failed to produce during discovery. TBMP 527.01(e) states that "[a] party that fails to provide information, or provides an untimely supplement, may be precluded from using that information or witness at trial unless the failure to disclose was substantially justified or is harmless." *See also* Fed R. Civ. P. 37(c) (stating that a party that fails to supplement its discovery responses "is not allowed to use that information...to supply evidence on a motion, at a hearing, or at a trial, unless the failure was substantially justified or is harmless").

There have been many cases in which the Board has struck evidence submitted through a Notice of Reliance or through a trial witness's testimony where that evidence had not been produced during discovery. For example, in *Panda Travel, Inc. v. Resort Option Enterprises, Inc.*, 94 U.S.P.Q.2d 1789 (TTAB 2009), the Opposer filed a Notice of Reliance that included several examples of advertising and promotional materials that the Opposer had never produced during discovery, despite the fact that the applicant had served a discovery request for all such materials. The Board granted the applicant's motion to strike these materials, stating:

Each party has a duty to make a good faith effort to satisfy the reasonable and appropriate discovery needs of its adversary. A party served with a request for discovery has a duty to thoroughly search its records for all information property sought in the request, and to provide such information to the requesting party...A responding party which...provides an incomplete response to a discovery request may not thereafter rely at trial on information from its records which was properly sought in the discovery request but was not included in the response thereto unless the response is supplemented in a timely fashion pursuant to Fed. R. Civ. P. 26(e).

Id. at 1791-1792 (citations omitted); *see also StrongVolt, Inc. v. Ghomeshi*, Cancellation No. 92061629, at 15-16 (TTAB Nov. 23, 2018) (“Because Respondent did not produce the nineteen relevant documents that make up Exhibit F, with the exception of three receipts, in response to Petitioner’s discovery request[s]...we sustain Petitioner’s objection to the documents contained in Exhibit F.”); *GMA Accessories, Inc. v. Charlotte Olympia Holdings Limited*, Opp. No. 91211164, at 14 (TTAB June 15, 2017) (“Opposer’s failure to timely supplement its responses to Applicant’s discovery requests precludes it from introducing responsive materials at trial.”); *East West Bank Co. v. The Plubell Firm LLC*, Cancellation No. 92053712, at 60 (TTAB Sep. 8, 2016) (applying estoppel sanction to documents that “were requested but not produced during discovery”); *Daniele & Sons, Inc. v. 33 Subs, Inc.*, Opp. No. 91219007, at 8-9 (TTAB June 28, 2016) (applying estoppel sanction where “[u]nder the circumstances, there is no excuse for Applicant’s failure to produce in discovery the few documents which it now seeks to introduce in response to Opposer’s summary judgment motion”); *Hard Candy Cases, LLC v. Hard Candy, LLC*, Opp. No. 91195328, at 5-6 (TTAB Nov. 13, 2014) (“Because Opposer requested the document in discovery and Applicant failed to produce it during discovery or following Opposer’s motion to compel, the objection is sustained and the motion to strike is granted.”).

Petitioner also argues that the specific documents cited in its summary judgment brief “were not in Petitioner’s possession, custody, or control during the discovery period.” Petitioner’s Brief, at 2. However, even if this is true, Petitioner had an obligation under Fed. R. Civ. P. 26(e) and TBMP 408.03 to supplement its discovery responses in a timely manner once it became aware of these documents, even after the end of the discovery period. Petitioner alleges that it obtained these documents on October 15, 2018; however, to date, Petitioner has still not

supplemented its discovery responses and produced the documents, over six months after they were obtained by Petitioner.

Petitioner's other arguments also exhibit a gross misunderstanding of the discovery process. The suggestion that Registrant had "equal access" to the documents is not an acceptable excuse to fail to produce responsive documents; this is merely another version of Petitioner's "publicly available" argument, and has likewise been consistently rejected by courts. "Courts have unambiguously stated that this exact objection—that the records are equally available to the propounding party—is insufficient to resist a discovery request." *United States v. Hopkins*, No. CIV 11-0416, 2012 U.S. Dist. LEXIS 184391, at *19 (D.N.M. Dec. 22, 2012) (citations omitted). Likewise, Petitioner cannot justify its failure to produce requested documents by arguing that Registrant had "notice of their content" or blithely stating that Petitioner "could have easily purchased the books from Amazon." Petitioner's Brief, at 2.

Petitioner also tries to excuse its failure to produce the publications by arguing that two of the publications were published by subsidiaries of Registrant. Registrant and its subsidiaries have published tens of thousands of books, magazine articles, and other publications. As explained in the cases cited in Petitioner's Motion, litigation is not a "blind man's bluff" and it is not fair to expect Registrant to scour every book and magazine ever published by a subsidiary or affiliate of Registrant to determine if they contain anything that Petitioner might use to support its case. *See* Registrant's Brief, at 6-7 and cases cited therein. Furthermore, this argument only applies to two of the four publications cited in Petitioner's summary judgment brief, and presumably does not apply to the other documents that Petitioner has been withholding.

It is thus clear that there is no excuse for Petitioner's continuing failure to produce the documents cited in its summary judgment brief, or its continued withholding of other "publicly

available” documents supporting its case. “The purpose of discovery is to advance the case by requiring parties to share certain relevant information upon request, so that the issues for trial may be focused and the case may proceed in an orderly manner within reasonable time constraints.” *Phillies v. Phila. Consol. Holding Corp.*, 107 U.S.P.Q.2d 2149, 2152 (TTAB 2013) (emphasis added). By failing to produce responsive documents in its possession, custody, or control, Petitioner has significantly prejudiced Registrant’s ability to prepare for trial, and the only appropriate remedy is a limited reopening of the discovery period.

IV. THE REOPENING OF DISCOVERY IS THE PROPER REMEDY TO ADDRESS PETITIONER’S FAILURE TO COMPLY WITH ITS DISCOVERY OBLIGATIONS

Finally, Petitioner argues that the reopening of discovery is not the proper remedy to address Registrant’s complaints, and that any reopening of discovery should be “proportionally limited” to the four unproduced publications cited in Petitioner’s summary judgment brief. As set forth in Registrant’s Motion, Registrant has requested, the event that the Board does not find grounds for re-opening discovery, that the Board instead treat Registrant’s Motion in the alternative as a Motion to Compel, and issue an order requiring Petitioner to produce any and all responsive documents that it has been withholding. However, Registrant continues to believe that a reopening of the discovery period is the most appropriate remedy to deal with Petitioner’s discovery failures, for several reasons.

First, as discussed above, Petitioner has still not produced the four publications cited in its summary judgment brief, and is maintaining its position that it is not required to produce any books, newspaper articles, magazine articles, or Internet printouts, on the grounds that these documents are “publicly available” and can be introduced via Notice of Reliance. Petitioner has also signaled, through its Pretrial Disclosures, that it intends to rely upon numerous additional

“publicly available” documents that it has not yet produced and does not intend to produce. An order compelling Petitioner to produce the four publications cited in its summary judgment brief would therefore not address the larger issue of Petitioner’s continued withholding of other printed publications, Internet documents, and other “publicly available” documents that are directly responsive to Registrant’s document requests.

Furthermore, depending upon the contents of the unproduced documents, Registrant may need to take follow-up discovery, whether from Petitioner or from third parties. Petitioner claims that these documents show that consumers and the general public use and understand the term “Adventist” to refer to a class or category of religious denominations that share common beliefs, rather than solely to refer to members of Registrant’s church. If this is true, then Registrant deserves the opportunity to conduct any necessary follow-up discovery regarding the contents of these documents.

Therefore, Registrant again requests that the Board re-open the fact discovery period for 60 days. In the alternative, Registrant requests that the Board issue an order compelling Petitioner produce any and all documents that Petitioner has been withholding on the grounds that they are “publicly available” or that they can be produced via Notice of Reliance.

V. CONCLUSION

For the reasons set forth above, Registrant requests that the Board issue an order reopening the discovery period for 60 days.

Respectfully submitted,

GENERAL CONFERENCE CORPORATION
OF SEVENTH-DAY ADVENTISTS

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Date: May 27, 2019

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing REGISTRANT'S REPLY BRIEF IN SUPPORT OF ITS MOTION TO REOPEN DISCOVERY AND SUSPEND PROCEEDINGS was served this 27th day of May, 2019, by e-mail only, upon:

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