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

Proceeding	92065930
Party	Plaintiff Root Four Imagination Inc.
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Date	12/11/2017
Attachments	Reply re Motion to Compel.pdf(18559 bytes)

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

Root Four Imagination Inc. Petitioner, v. Esurance Insurance Services, Inc. Registrant.	Cancellation. No.: 92065930 Registration No.: 5,083,816 Registered: November 15, 2016 Cancellation No.: 92065891 Registration No.: 4,512,663 Registered: April 8, 2014

ROOT FOUR'S REPLY TO PETITIONER'S MOTION TO COMPEL

Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1451
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Nothing in Esurance's Opposition changes the fact that the information sought by Root Four in Admission Nos. 1-5 and Interrogatory No. 6 is properly discoverable. In an obvious effort to avoid having to admit that it affirmatively asserted that there is a likelihood of confusion between Esurance's DRIVE SAFE mark and Root Four's SAVEDRIVER mark in Canada, Esurance relies on factually and procedurally distinguishable case law.[1]

[1] To the extent that Esurance asserts it has responded to Root Four's motion to compel as a "combined Motion to Compel/Motion to Test Sufficiency of Response," Root Four will not file a separate Motion to Test Sufficiency, unless requested by the Board. In lieu of a Motion to Test Sufficiency, and in the interest of furthering the proceeding, Root Four notes that the standards under which the Board considers both Motions to Compel and Motions to Test Sufficiency are comparable. *See generally* TBMP § 502.04.

ARGUMENT

In opposition to Root Four's motion, Esurance asserts that it does not have to adopt or admit to the contents of the initiating Statement of Opposition which Esurance filed with the Canadian Trademarks Opposition Board ("the Canadian opposition") for two reasons: (1) the documents are already in the possession of Root Four, and (2) the foreign proceedings are irrelevant. Neither argument is availing.

I. Even if the Documents are Otherwise Available, Esurance Should be Required to Respond to Root Four's Interrogatory and Admission Requests

Esurance wrongly contends that since Root Four has access to the Opposition Esurance filed in Canada, there is no need to respond to the discovery requests. This argument is unavailing for three reasons. First, that objection was not raised in Answer to the Admission or Interrogatory Request, and is therefore waived. Second, the Board and courts have long held that neither public availability nor possession by the requesting party alleviates the duty to respond and/or produce. *Omega Sa (Omega Ag) (Omega Ltd.) v. Lambda Tau Omega Sorority, Inc.*, OPPOSITION 91208881, 2016 WL 6833477, at *3 (Oct. 3, 2016) (requiring Applicant to respond to discovery requests even where the documents were publicly available); *Martino v. Kiewit New Mexico Corp.*, 600 F. App'x 908, 911 (5th Cir. 2015) (noting that "even if a document is publicly available or in the opposing party's possession, a party must still disclose it"); *Charter Practices Int'l, LLC v. Robb,* No. 3:12CV1768 RNC, 2014 WL 273855, at *2 (D. Conn. 2014) (noting that an objection based on the availability of documents online is insufficient to resist a discovery request); *St. Paul Reinsurance Co. v. Commer. Fin. Corp.,* 198 F.R.D. 508, 514 (N.D. Iowa 2000) (noting that Plaintiffs' objection that the information and documents sought are equally available to the propounding parties from their own records or

from records which are equally available to the propounding parties is a "meritless" basis for objection); *City Consumer Services v. Horne,* 100 F.R.D. 740, 747 (D. Utah 1983) (describing how it is "not usually a ground for objection that the information is equally available to the interrogator or is a matter of public record"); *Shatsky v. Syrian Arab Republic*, 312 F.R.D. 219, 224 (D.D.C. 2015) (noting that Rule 26 of the Federal Rules of Civil Procedure require a party disclose a document even where the document is publicly available or in the opposing party's possession).

Third, having access to these documents does provide sufficient authentication and does adequately respond to Root Four's requests which require Esurance to admit or deny, for example, that in the Canadian opposition Esurance took a position directly contrary to the position taken herein, and explain all facts Esurance had at the time it filed the Canadian opposition to support its contention of likelihood of confusion. *See* Admission Request Nos. 4 and 5, and Interrogatory No. 6.

II. Esurance's Proffered Case Law is Inapposite

Still further, in arguing that it need not respond to Root Four's requests, Esurance relies on case law that is factually and procedurally distinct. To begin, *Double J. of Broward Inc. v. Skalony Sportswear GmbH*, 21 U.S.P.Q.2d 1609 (TTAB 1991), *Oland's Breweries [1971] Ltd. V. Miller Brewing Co.*, 189 U.S.P.Q. 481, 483 n.2 (TTAB 1975); *Johnson & Johnson v. Salve S.A.,* 183 U.S.P.Q. 375, 376 (TTAB 1974), and *Fuji Photo Film Co. v. Shinohara Shoji Kabushiki Kaisha*, 754 F.2d 591, 599 (5th Cir. 1985) all relate to the underlying issue of whether foreign use of a mark creates priority in the United States. As the Lanham is clear that only use in United States commerce creates trademark rights in the United States, it makes sense that

foreign use is not relevant to a U.S. opposition or cancellation. But that is not the issue before the Board in this case.

The *Faberge, Inc. v. Dr. Babor GmbH & Co.*, 219 U.S.P.Q. 848 (TTAB 1983) case is procedurally distinct in that the decision does not involve a discovery dispute, but a decision on the merits in which the Board noted that "[i]t has long been settled that decisions of foreign tribunals are not *controlling* on a determination of an applicant's right to register in the United States or an opposer's claim of damage in the event such a registration is issued." *Id.* at 850. Notably, however, the Board in *Faberge* also described as a "pertinent fact" the applicant's stipulation that it filed oppositions in foreign countries and had taken a position opposite to the one taken in the pending opposition, *Id.*, thereby implicitly recognizing that the type of information and admissions Root Four seeks herein are at a minimum discoverable.

This is consistent with later TTAB rulings, including *Combe Inc. v. Dr. Augus Wolff GmbH & Co, Kg. Arzneimittel,* 91209708, 2017 WL 3034058, at *14 (June 19, 2017) which distinguished between (a) information relating to an entity's foreign use/registration which is irrelevant to a U.S. opposition/cancellation proceeding (citing, as Esurance does here, *Double J, Oland's Breweries, and Johnson & Johnson*), and (b) information relating to an applicant's conduct in foreign opposition/cancellation proceedings which "may be construed as an admission against interest" and which the Board described as "merely illuminative of shade and tone in the total picture confronting the decision maker." The *Combe* decision likewise supports that the information requested by Root Four herein is discoverable.

In the end, the scope of discovery under the Federal Rules is very broad, allowing for discovery into any matters "which may aid a party in preparation or presentation of [its] case." Fed. R. Civ. P. § 26, *Notes of Advisory Committee on Rules—1946 Amendment, Subdivision (b)*

(2016). Root Four's requests are directed to information that is, at a minimum, "illuminative of shade and tone in the total picture confronting the [TTAB]," and thus properly discoverable.

CONCLUSION

For all these reasons, Root Four's requests are relevant or likely to lead to the discovery of relevant information. Wherefore, Root Four respectfully request that TTAB order Esurance to immediately and fully answer Admission Request Nos. 1-5 and Interrogatory No. 6.

Respectfully submitted,

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ATTORNEYS FOR PETITIONER
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CERTIFICATE OF FILING

I hereby declare that the foregoing document has been filed via the Electronic System for Trademark Trials and Appeals (ESTTA) this 11th day of December, 2017.

/s/ Christine Lebrón-Dykeman

CERTIFICATE OF SERVICE

I hereby declare that the foregoing instrument was served upon the following this 11th day of December, 2017, via email:

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