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

Proceeding	92068467
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

U.G.A. NUTRACEUTICALS, SRL,

Petitioner,

v.

MAPLE MOUNTAIN GROUP, INC.,
f/k/a NEWAYS, INC.

Registrant.

Proceeding No.: 92068467

Mark: CARDIOL

Registration No.: 2,693,218

PETITIONER'S RESPONSE TO REGISTRANT'S MOTION TO COMPEL

U.G.A. Nutraceuticals, SRL ("Petitioner") hereby submits the following in response to Registrant's Motion to Compel.

This cancellation proceeding involves a single claim of abandonment based upon Registrant's abandonment of the "CARDIOL" mark in U.S. commerce. Accordingly, the central question in this proceeding is whether Registrant has ceased use of the mark in question and therefore abandoned its rights. The information relevant to this inquiry is necessarily within Registrant's possession, *i.e.*, if Registrant, in fact, used the mark (or had an intention to resume use), Registrant would have documents. To date, Registrant has produced no documents establishing use.

Instead, to shift focus from its own evidentiary problems (and ignoring the delays caused by its own deflections in discovery; namely, its delay in producing any documents, refusal to identify which documents are responsive to which specific requests, and to certify whether its production is complete and whether any documents are being withheld), Registrant files this motion as a pretext to extend the discovery timeline and to request case determinative sanctions for purported discovery failures that (1) were never subject to a meet and confer and (2) are not central to the single issue in

this case—evidence that Registrant, in fact, has used or has a bona fide intent to resume use of the CARDIOL mark.

I. Factual Background

On April 5, 2019, Registrant served its First Set of Interrogatories and First Set of Requests for the Production of Documents and Things. Registrant's First Set of Interrogatories consisted of 32 questions and Registrant's First Set of Requests for the Production of Documents and Things consisted of requests for 29 separate categories of documents. Registrant's discovery requests are attached to the declaration in support of its motion as Exhibits B and C. Petitioner fully responded to these requests on October 16, 2019. Petitioner answered each and every Interrogatory without objection and for each category of documents requested, Petitioner stated, again without objection, whether it would produce documents or that none existed. Petitioner's responses to Registrant's discovery requests are attached to the declaration in support as Exhibits D and E.

Petitioner's responses to written discovery on October 16, 2019 occurred while a motion to compel filed by Petitioner was pending and prior to the Board's entry of an order for it to do so on February 3, 2020. Indeed, Registrant admits this in its current motion. Nearly six months after Petitioner responded to Registrant's discovery requests, on April 3, 2020, Registrant emailed Petitioner a letter objecting to Petitioner's responses to seven of Registrant's 51 discovery requests—specifically Interrogatory Nos. 20-25 and 27. Registrant's April 3, 2020 letter is attached to its declaration as Exhibit F.

On April 30, 2020, six and a half months after Petitioner served its discovery responses to Registrant, the parties conferred orally to discuss Registrant's concerns regarding the answers. Counsel for Registrant only discussed responses to interrogatories on this call, and confirmed that Registrant had not yet raised deficiencies with respect to document responses. Attorneys for both

parties discussed Registrant's stated dissatisfaction with Petitioner's interrogatory responses.¹ Registrant's challenge involved three interrogatories seeking information regarding Petitioner's investigation into use of the mark prior to filing the petition. Petitioner explained, as stated in the Interrogatory responses, that the investigation involved searching the web to try to locate use of the mark, which Petitioner did not find. Petitioner contended that this response was complete and the specificity Registrant requested—*i.e.*, identifying every search and every webpage Petitioner viewed (even if it could)—was more than what was necessary to provide a full response. The other set of interrogatories all focused on the allegations that Registrant abandoned the mark and had no intent to resume use. Again, Petitioner explained that it could not find any evidence of use and emphasized that to the extent Registrant is using the mark, documents showing use would be exclusively in Registrant's possession.²

At all times, Petitioner has maintained that its answers to Interrogatories are complete and that it sufficiently respond to the request. The parties concluded the conference by taking both concerns (Registrant's challenge to Interrogatory answers and Petitioner's objection that Registrant had produced no documents) under advisement with their respective clients. The outcome of this conference is documented in Registrant's April 30, 2020 summary email attached to its declaration as Exhibit G. In light of Petitioner's position that its answers were sufficient, Registrant specifically asked if Petitioner would provide supplemental answers.

Registrant sent an email approximately two weeks later on May 12, 2020 to explain why Registrant had still not produced any documents. At the end of the note, Registrant asked if

¹ The parties further discussed Registrant's complete failure to produce documents responsive to Petitioner's requests. Registrant's counsel stated that he would "try" to produce documents within a week.

² To date, Registrant has not produced a single document showing recent use of the CARDIOL mark, yet Registrant refuses to certify that its document production is complete or identify which documents purportedly show continuous use of the mark or an intent to resume use.

counsel had discussed supplementation with Petitioner. A copy of this email is attached to Registrant's declaration as Exhibit H. About two and a half months after the May 12, 2020 exchange, Registrant followed up to its email demanding supplementation of the six answers it continued to challenge.³ Counsel for both parties held a second meet and confer conference on July 31, 2020. Again, the only two issues discussed during this conference were Registrant's challenge to answers to Interrogatories No. 21-25 and 27, as well as Petitioner's objections to Registrant's woefully incomplete production of documents.⁴ The parties discussed working on a potential settlement and again concluded the conference by taking both concerns under advisement with their respective clients, but Petitioner did not stipulate that supplementation of its answers was necessary.

Registrant sat idle for another three months until October 26, 2020—more than a year after Petitioner provided full responses to Registrant's discovery requests—when it emailed Petitioner demanding immediate supplementation of the six Interrogatories within 48 hours. Petitioner responded on October 29, 2020, but undeterred, Registrant filed the instant motion on October 30, 2020.

II. Argument

A. Registrant's Arguments Associated With Responses To Document Requests Should Be Stricken.

Parties are under an obligation to meet and confer in good faith and present the merits of their position in the meet and confer with similar candor, specificity, and support as in a subsequent

³ After the April 30, 2020 meet and confer, Registrant withdrew its challenge to the answer to Interrogatory No. 20.

⁴ Registrant produced a total of 183 pages of documents, consisting almost exclusively of publicly available documents related to the prosecution and assignment of the trademark. Petitioner received Registrant's document production on July 31, 2020. A paralegal in Registrant's counsel's office had sent an email attaching Registrant's document production on May 16, 2020; however, due to the unknown status of the paralegal's email address, that email was quarantined and never reached Petitioner's counsel. Upon further inquiry between counsel, the error was realized and the documents were resent and received on July 31, 2020.

discovery motion. *See Amazon Technologies Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009); *see also Nevada Power Co. v. Monsanto Co.*, 151 F.R.D. 118, 120 (D. Nev. 1993); Trademark Rule 2.120(f)(1), 37 C.F.R. § 2.120(f)(1). In the Board's Order following the discovery conference in this case, the Board emphasized:

The parties were put on notice that a motion to compel would not be entertained and good faith would not be found where the parties have failed to previously conduct at least one telephone conference to resolve the issue.

(Board Order of 10/23/2018) (bolded in original).

In its motion to compel, Registrant requests supplemental responses to Registrant's Document Request Nos. 1-3, 7, 9-14, 20-26, and 28. Registrant does not object to Petitioner's actual document production. Instead, Registrant now asserts that Petitioner's use of the phrase "to the extent such documents exist" in Petitioner's written responses is improper.

Petitioner provided full responses to Registrant's document requests on October 16, 2019. Since that time, alleged deficiencies with these responses has not been raised by the Registrant. Tellingly, none of these requests are mentioned in any of Registrant's discovery correspondence: not in its April 3, 2020 letter, not in the April 30, 2020 summary of the parties' meet and confer, not in its May 12, 2020 follow up email, and not in either of its July 29, 2020 or October 26, 2020 emails. These requests (or any claimed deficiencies) were not discussed, much less discussed with specificity, during any meet and confer in the over a year since Petitioner's discovery responses were served.

As stated above, Petitioner complied with the Board's Order of February 3, 2020 by providing full answers to Registrant's discovery requests without objections. Moreover, Petitioner produced its production of documents to Registrant on March 6, 2020. To the extent Registrant was further dissatisfied with the responses or the substance of Petitioner's document production,

Petitioner respectfully submits that Registrant should have raised the issue with Petitioner. Accordingly, Registrant respectfully requests that any argument based on responses to document requests be disregarded. Alternatively, because Registrant has raised for the first time in its motion to compel an objection to Petitioner's use of the phrase "to the extent such documents exist," if necessary, Petitioner requests an opportunity to address this language.

B. Petitioner Provided Sufficient Responses To Interrogatory Nos. 21-25 and 27.

The Interrogatory answers challenged by Registrant fall into two buckets: Registrant's abandonment of the CARDIOL mark and Petitioner's investigation. First, Registrant challenges answers to requests regarding Registrant's own abandonment of the CARDIOL mark and lack of an intent to resume use. See Interrogatory Nos. 27 (abandonment) and 24 and 25 (no intent to resume). In its answer to these questions, Petitioner accurately states it is not aware of any product marketed and sold by Registrant under the CARDIOL mark in the United States as its investigation revealed no evidence of use. As discussed with Registrant, to the extent Registrant, in fact, is using or has used the CARDIOL mark, information and documents regarding any such use are exclusively in Registrant's possession and Petitioner cannot provide information regarding the absence of information. Yet, Registrant has produced zero evidence of continuous or current use of the CARDIOL mark.

Second, Registrant challenges Petitioner's answers to requests regarding Petitioner's investigation into Registrant's use. See Interrogatory Nos. 19, 21, 22. In its answer to these questions, Petitioner, again, has explained that it performed Internet searches to determine whether Registrant was using the CARDIOL mark and found no evidence of use. Petitioner respectfully submits that this answer adequately informs Registrant of Petitioner's efforts and Registrant's requests for specificity (e.g., identification of every web page Petitioner reviewed) goes beyond

what is necessary to respond to the request. Simply put, Petitioner researched the web to find any evidence of use and found none. Petitioner does not have documents showing the absence of use or any listing of the webpages reviewed. Petitioner has further maintained and maintains that it is not necessary to provide the name of the attorney who did the Internet searches. Petitioner has already identified the individuals with the most knowledge regarding the availability and selection of the mark, Gentian Selimi and Giovanni Zenoni. See Interrogatory No. 9. However, Registrant has done nothing to schedule depositions or otherwise explore the information Petitioner has provided.

Petitioner further notes that while Petitioner provided full answers to these Interrogatories without objection on the merits, the requests regarding Petitioner's investigation are, at best, tangential to the primary issue in this case—Registrant's total failure to provide any evidence of continued use of the CARDIOL mark. Even if Registrant would contend that Petitioner's investigation was not thorough enough, such "fact" would not make Registrant's continued use of the mark more or less likely.

C. Registrant's Request For Sanctions Should Be Denied.

Registrant's characterization of Petitioner as ignoring its discovery obligations cannot be squared with actual events. While Petitioner's initial responses to discovery were late, Petitioner fully responded to the discovery requests without objection on the merits and produced documents. Registrant does not contest Petitioner's actual production of documents and its challenge to Petitioner's answers to Interrogatories is limited to two issues and six interrogatories. While Registrant states it spent "much of 2020" trying to obtain discovery, Petitioner respectfully submits that Registrant's isolated communications do not support this contention. To the contrary, Registrant has failed to meaningfully engage in discovery and its isolated communications

regarding the six Interrogatory answers at issue made 6, 9, and 12 months after Petitioner provided full discovery responses in October 2019 do not show diligence in pursuing Registrant's defense.⁵

In the face of the close of the discovery period, Registrant's motion is a last ditch effort to try to get a case determinative ruling before Petitioner is able to present Registrant's complete failure to produce any evidence of continued use of the CARDIOL mark to the Board. As such, Petitioner respectfully submits that even if the Board determines some supplementation of Petitioner's Interrogatory answers is necessary, Registrant's request for case determinative sanctions is inappropriate and should be denied.

In its motion, Registrant seeks a sanction against Petitioner in the form of refusal to allow Petitioner to submit evidence. (Registrant's Mot. to Compel at 13-15). This effectively amounts to a request to prohibit Petitioner from prosecuting its case, which is tantamount to a judgment in Petitioner's favor. Such an extreme sanction is completely unwarranted in this case.

As an initial matter, sanctions under Fed. R. Civ. P. 37(b)(2) must be weighed under a four-part test: (1) whether the noncomplying party acted in bad faith; (2) the amount of prejudice his noncompliance caused his adversary, which necessarily includes an inquiry into the materiality of the evidence he failed to produce; (3) the need for deterrence of the particular sort of noncompliance; and (4) the effectiveness of less drastic sanctions. *See Mut. Fed. Sav. & Loan Ass'n v. Richards & Assocs.*, 872 F.2d 88, 92 (4th Cir. 1989). To warrant a dismissal, a plaintiff must demonstrate a "pattern of indifference and disrespect to the authority of the court." *Cooper v. Spartanburg Sch. Dist.* 7, No. 7:15-cv-03072-JMC, 2017 U.S. Dist. LEXIS 148020, at *13 (D.S.C. Sep. 12, 2017) (citing *Mut. Fed. Sav. & Loan Ass'n*, 872 F.2d at 93). Here,

⁵ Unfortunately, while Petitioner was willing to allow the discovery period to end with Registrant producing no evidence of use of the CARDIOL mark or intent to resume use, to balance the record, Petitioner will now have to bring a motion to compel Registrant to comply with its discovery obligations.

Registrant fails to even weigh these factors or otherwise demonstrate that the extreme sanction of the prohibition of prosecution is appropriate. Indeed, it is not.

Registrant's reliance on *MHW, Ltd. v. Simex, Aussenhandelsgesellschaft Savelsberg KG*, 59 U.S.P.Q.2D (BNA) 1477, 1478 (T.T.A.B. 2000) is without merit. In *MHW, Ltd.*, the Board entered sanctions in the form of judgment against the opposers due to their failure to submit discovery responses after 6 years from when the discovery requests were first issued. *Id.* The opposers were first served discovery on June 3, 1994, and failed to provide responses for a full year. *Id.* On June 15, 1995, the Board first ordered the opposers to provide responses within thirty days. *Id.* The applicant then allowed a three-week extension until July 20, 1995 on the condition that no further extensions would be agreed to, yet nearly two years passed with still no responses submitted. On February 2, 1997, the Board issued a final order for responses within thirty days. *Id.* The opposers provided woefully deficient responses a month beyond this deadline. *Id.* Three and a half years later, the Board decided enough was enough. The sanction of entered judgment against the opposers was appropriate in *MHW, Ltd.* given the extreme passage of time, the failure to comply with more than one order, and the insufficient, dilatory responses that arrived nearly three years late. *Id.* at 1479.

Registrant's reliance on *Baron Philippe de Rothschild, S.A. v. Styl-Rite Optical Mfg. Co.*, 55 U.S.P.Q.2D (BNA) 1848 (T.T.A.B. June 23, 2000) (non-precedential) is similarly unavailing. In *Baron Philippe*, the Board entered judgment against the applicant after an "overall pattern of delay" of nearly two years, including "inundating the Board with an unusually high number of motions, responses to motions, and replies." *Id.* at 1852. The Board determined that these acts "caused extreme prejudice to opposers and delay in this proceeding[.]" *Id.*

Registrant's cases supporting lesser sanctions, likewise, do not compare to the facts at hand. In *M.C.I. Foods, Inc. v. Bunte*, 86 U.S.P.Q.2D (BNA) 1044, 1046 (T.T.A.B. 2008), the offending party (M.C.I.) failed to comply with *two* pre-consolidation orders from the Board to produce documents, and even after, its initial responses improperly contained a mere promise to produce unspecified documents at a later point, which the Board determined to be insufficient. Additionally, M.C.I.'s responses improperly maintained objections in violation of a prior order. *Id.* at 1047. And, unlike the aggrieved applicant in *Highbeam Mktg., LLC v. Highbeam Research, LLC*, 85 U.S.P.Q.2D (BNA) 1902, 1904 (T.T.A.B. 2008), who "promptly and repeatedly raised concerns regarding the sufficiency" of the opposer's insufficient responses, here, Registrant can make no such claim.

In this case, Petitioner has provided written discovery responses and produced documents, and Registrant has not shown diligence. Petitioner brings this motion over a year after Petitioner provided discovery responses and on the eve of the discovery close. Registrant has not once submitted concerns regarding Petitioner's responses to Registrant's Requests for Production of Documents, despite stating that they intended do so. Registrant's own dilatory actions and failure to produce any supporting evidence of use of the CARDIOL cannot support a finding of sanctions in this case.

Here, a sanction of judgment against Petitioner or a similar sanction effectively prohibiting the prosecution of its case would be "draconian." *ClearValue, Inc. v. Pearl River Polymers, Inc.*, 560 F.3d 1291, 1307-08 (Fed. Cir. 2009) (citing *Batson v. Neal Spelce Associates, Inc.*, 765 F.2d 511, 515 (5th Cir. 1985)). This case does not suffer from extreme delay. Petitioner served its discovery responses on October 16, 2019, before the Board issued its February 3, 2020 Order, and the responses complied with the Order as Petitioner responded fully and without imposing

objections on the merits. And, given that Registrant has failed to produce a single document evidencing its own use of the CARDIOL mark, Registrant cannot plausibly argue that it has suffered any prejudice as a result of Petitioner similarly being unable to produce any information or documents showing use. The evidence in this case (or lack thereof) speaks for itself. For these reasons, The Board should not order any sanctions against Petitioner.

III. Conclusion

For the foregoing reasons, Petitioner respectfully requests that Registrant's Motion be denied, in full.

November 19, 2020

Respectfully submitted,

/s/ Daniel S. Tyler

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CERTIFICATE OF SERVICE

I hereby certify that on November 19, 2020, a true and correct copy of the foregoing was served by via electronic mail on all counsel or parties of record on the Service List below:

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