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

Proceeding no.	92070823
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

ICware Systems, Inc. dba BatchTest Corporation, and
BatchTest Corporation,

Petitioner,

v.

Ikonix USA, LLC,

Respondent

Cancellation No. 92070823

**RESPONDENT'S OPPOSITION TO THE
MOTION TO COMPEL**

Respondent, Ikonix USA, LLC (referred to as “Ikonix” below) hereby serves upon ICware Systems, Inc. dba BatchTest Corporation, and BatchTest Corporation (referred to as “BatchTest” below) the following opposition to BatchTest’s Motion to Compel filed December 3, 2021 (TTABVUE#51) (referred to as the “Motion” below), pursuant to the Order dated May 31, 2022 (TTABVUE#65), the Federal Rules of Civil Procedure and the relevant rules of the Trademark Trial and Appeal Board (referred to as the “Board” or the “TTAB” below) of the U.S. Patent and Trademark Office (referred to as the “PTO” or the “Office” below).

The Order dated May 31, 2022 (TTABVUE#65) states “Respondent’s response to Petitioner’s motion to compel due: June 21, 2022.” The motion to compel procedure “is not applicable to requests for admission.” Trademark Trial and Appeal Board Manual of Procedure (TBMP) Section 523.01 (June, 2022). Thus, Ikonix hereby responds to the motion to compel, but not to BatchTest’s request “for an order testing the sufficiency of Registrant’s responses to requests for admission” (TTABVUE#51 at page 1).

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The discovery responses at issue are “Respondent's Reply To Petitioner’s First Set Of Interrogatories To Registrant” And “Respondent's Reply To Petitioner’s First Set Of Requests For Production To Registrant,” each served on March 12, 2021.

The only remaining count from BatchTest’s Second Amended Petition of December 11, 2019 (TTABVUE#16) is based on the allegations of priority and likelihood of confusion. The remaining counts were dismissed “with prejudice” by the Order dated March 31, 2020 (TTABVUE#20, at page 10). and are not considered in this proceeding.

BatchTest is appearing *pro se*, and *pro se* parties are “precluded from receiving information designated “Confidential – For Attorneys’ Eyes Only (trade secret/commercially sensitive)” under the Standard Protective Order” as noted in the Order dated February 10, 2021 (TTABVUE#37 at page 4). Thus, “Respondent [Ikonix] need only provide discovery regarding its use of the involved mark on the goods identified in its involved registration” *Id.* (footnote omitted).

The Motion is untimely. The Order dated February 10, 2021 (TTABVUE#37) sets “Plaintiff’s Pretrial Disclosures Due 9/22/2021.” The Motion was filed December 3, 2021. “A motion to compel discovery must be filed before the day of the deadline for pretrial disclosures for the first testimony period as originally set or as reset.” 37 C.F.R. §2.120(f) (2017). The TBMP provides that “as of the day of the

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deadline for pretrial disclosures for the first testimony period, a motion to compel filed is untimely, even if it is filed prior to the opening of the day of a rescheduled or reset deadline for pretrial disclosures for the first testimony period.” TBMP §523.03 (June 2022). As noted in the Order dated July 7, 2021 (TTABVUE#45), “Petitioner has not filed a motion to compel discovery in the time between the expiration of Respondent’s time to serve discovery responses in accordance with that order and the filing of Petitioner’s motions.” “There is no provision in the rule for Board discretion to consider an untimely motion to compel.” TBMP §523.03 (June 2022).

1. Ikonix’ Objections Are Not Boilerplate

Ikonix’ objections should be considered with respect to the discovery request, and not “overruled” as requested on page 5 of the Motion. An objection should not be disregarded based merely on the number of times it is asserted. For example, if every discovery request called for privileged attorney client communications, then a failure to make that objection with respect to a single request could be argued to waive the privilege.

1(a). Ikonix responded in accord with the rules to Request for Production Nos. 1-2, 9, 11-13, 15-16, 20-21, 23, 26, 29-31, and 33, and Interrogatories Nos. 14, 20-21, 40, 42, and 44.

At page 7 of the Motion, BatchTest points out the Ikonix responded to discovery requests by objecting that producing or responding to “all” is not proportional to the needs of the case. This is in

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accord with Fed. R. Civ. R 26(b)(1), which governs the discovery process in this cancellation proceeding, “Unless otherwise limited by court order, the scope of discovery is as follows: Parties may obtain discovery regarding any nonprivileged matter that is relevant to any party’s claim or defense and proportional to the needs of the case, considering the importance of the issues at stake in the action, the amount in controversy, the parties’ relative access to relevant information, the parties’ resources, the importance of the discovery in resolving the issues, and whether the burden or expense of the proposed discovery outweighs its likely benefit.”

Production Request No. 1 is “All documents relied upon in answering Petitioner’s Interrogatories to Registrant, or which otherwise support Registrant’s answers thereto.” All documents supporting Ikonix’ answers would be almost every document containing “BatchTest.” This would not be proportional to the needs of the case. Ikonix produced product literature, press releases and other documents, including an image from the Wayback Machine showing Ikonix’ website as captured on January 27, 2013, listing “BatchTEST” as one of the “Features” of Ikonix’ autoware2 “Instrument Control Software” for Ikonix’ products. The scope of Request Nos. 2 and 9, is also not proportional to the needs of the case.

Production Request No. 11 recites “Samples of all tags, labels, packaging, brochures, mailings, advertisements, or other written materials that show use of ‘BATCHTEST.’” Ikonix has produced not “all” such documents but representative documents, as stated in Mr. Lee’s email to Mr. Patel dated May 31, 2021 (see Exhibit F to the Motion):

3. While it is our understanding that the produced documents were clear on their face and described in our Response to Request for Production, but nevertheless, we respond as follows:

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- a. 2013-01-27 BatchTEST on autoware2 page from Wayback Machine - Request Nos. 9/10/11/12/13/22/26/33
- b. AR Catalog – Low Res - Request Nos. 9/10/11/12/13/15/16/20/22/26/33
- c. Autoware II - Request Nos. 9/10/11/12/13/22/26/33
- d. Autoware Press Release 2019 – Request Nos. 15/16/20/22/26
- e. Autoware_II_low – Request Nos. 15/16/20
- f. AW2_PR_JK_V2 - Request Nos. 9/10/11/12/13/15/16/20/22/26/33
- g. AW3 New Improved Features V1.00 - Request Nos. 9/10/11/12/13/22/26/33

The AR Catalog comprises 34 pages of text and images, and was produced in pdf format. A list of the relevant products of Ikonix on pages 4-5. A search for “BatchTest” finds this feature for the SC6540 multiplexer on page 18 with a photographic image of the device, and for the autoware3 software on page 28 with an image of the trademark BatchTest as it appears on the display screen during operation. The AW3 New Improved Features lists “BatchTEST Serial Numbers” as a feature.

The produced information and documents are proportional to the needs of the case, given that the issues are priority of use and likelihood of confusion, where Ikonix is entitled to the constructive use of the registered mark since at least as early as November 21, 2012, which is the filing date of the intent to use application upon which the subject Registration No. 4499170 was granted.

- 1(b). Ikonix responded in accord with the rules to Request for Production Nos. 1-4, 21, 29, and 31-33, and to Interrogatory Nos. 40, 42, 44, 47, and 48**

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At page 7 of the Motion, BatchTest points out the Ikonix responded to discovery requests by asserting that they cover privileged material. The Board has ruled that Ikonix “need only provide discovery regarding its use of the involved mark on the goods identified in its involved registration” as stated in the Order dated February 10, 2021 (TTABVUE#37 at page 4). Correspondence between Ikonix and its attorneys is unlikely to provide relevant information. As stated in Ikonix reply to BatchTest’s Production Request No. 5:

“Respondent did not have another party conduct a trademark search, investigation or study on the trademark BATCHTEST, other than the search conducted by the Examining Attorney of the U.S. Patent and Trademark Office during examination of the application that resulted in Respondent’s U.S. Registration No. 4499170 on the mark BATCHTEST. Respondent will produce an email string dated November 19, 2012, which reflects selection of the trademark BATCHTEST.”

Ikonix produced that “email string dated November 19, 2012,” which does not include or refer to any past communications with any attorney, but only an intention by a “Manager” to contact Ikonix’ attorney (“I’d like to get our attorney started on this.”).

The Board should not order Ikonix to prepare a privilege log where the previously produced information and documents are proportional to the needs of the case, given that the issues are priority of use and likelihood of confusion.

2. The affirmative defense of laches is no longer at issue

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At page 9 of the Motion, BatchTest points out the Ikonix has designated documents “which evidence goodwill in the designation BATCHTEST are AEO [Attorney Eyes Only under the Board’s Protective Order] designated.” Internal financial documents are appropriately designated AEO. Moreover, there would have no bearing on the present issues of priority of use and likelihood of confusion. BatchTest asserts that Ikonix “has alleged this matter as a part of its affirmative defenses” Motion at page 9. The Order dated September 7, 2019 (TTABVUE#10), includes at page 4, “Petitioner’s motion to strike Respondent’s affirmative defenses is granted and paragraphs 44 and 45 are hereby stricken.” Thus, discovery related to affirmative defenses is not proportional to the needs of the case.

3. Ikonix responded in accord with the rules to the Interrogatories

At page 10 of the Motion, BatchTest erroneously states that Ikonix’ “responses to a large number of [BatchTest’s] interrogatory requests are wholly evasive, inadequate, and/or improper.” The responses are proportional to the needs of the case, given that the issues are priority of use and likelihood of confusion.

Interrogatory No. 2

Identify by common commercial product name, each product that is currently sold, was previously sold, ... under Registrant’s BATCHTEST Mark

REPLY:

Respondent ... states that it uses the mark BATCHTEST for its Simultaneous DUT testing with its Autoware platform.

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These two items are further described in the produced AR Catalog. Page 28 of the catalog includes “Combined with a multiplexer, our BatchTEST® feature performs AC/DC Hipot, Continuity and Insulation Resistance tests on a batch of DUT’S in a convenient 1-step test.” Page 18 describes “PRODUCTIVITY ENHANCING FEATURES BatchTEST.” This catalog is exactly what customers and potential customers see. This is not “wholly evasive, inadequate, and/or improper.”

Interrogatory No. 3

Identify the Integrated Development Environment or IDE, which was used by you for development of each software product or software driver that is currently sold, distributed, was previously sold, or that Registrant intends to sell or distribute in the United States under Registrant’s BATCHTEST Mark.

REPLY:

LabVIEW.

This response is the opposite of “wholly evasive, inadequate, and/or improper.” This response is directly to the point. Ikonix used LabVIEW as the IDE. BatchTest needs no further explanation, because BatchTest also used LabVIEW.

In regard to **Interrogatory Nos. 4-11** on page 11 of the Motion, BatchTest complains that these responses refer only to one product. There is one product, software. As stated in response to Interrogatory No. 4, “software because the trademark BATCHTEST is used with the trademark Autoware 2 and the trademark Autoware 3, and the Autoware 2 and Autoware 3 software are written to interact exclusively

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with Registrant's electrical measuring instruments." This response is the opposite of "wholly evasive, inadequate, and/or improper."

Interrogatory No. 5 requests "For each product and service identified in response to INTERROGATORY NO. 4, state the period of time during which Registrant has used Registrant's BATCHTEST Mark in connection with such product and/or service." Ikonix replied "that it has used the BATCHTEST mark for its Simultaneous DUT testing with its Autoware software to interact exclusively with Respondent's electrical measuring instruments since as early as July 8, 2013." This response is the opposite of "wholly evasive, inadequate, and/or improper." The date is consistent with the date of first use in the challenged registration.

Interrogatory No. 7 requests "for each product and service identified in response to INTERROGATORY NO. 4, describe with particularity the types of promotional materials bearing the mark employed by Registrant in connection with the product or service." Ikonix replied "that it promotes the software having the mark "BATCHTEST" on its website and technical brochures." Ikonix website is on the Internet for all to see. Ikonix produced a representative brochure, the AR catalog, as well as the Autoware 2 product sheet, and the Autoware 3 list of improved features.

Interrogatory No. 8 requests "for each product and service identified in response to INTERROGATORY NO. 4, describe the channels of trade through which the product or service has been distributed." Ikonix replied "that it sells the BATCHTEST software through its online portal or over the phone." The term online portal is regularly used, and appears in the Trademark ID Manual. The term "over the phone" is clear and concise.

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Interrogatory No. 9 requests “for each product and service identified in response to INTERROGATORY NO. 4, describe the end use of the product or service.” Ikonix replied “the end use of the product is provided as a software feature on its Autoware platform for testing multiple DUT’s simultaneously.” This reply is not “deliberately vague” as alleged by BatchTest.

Interrogatory No. 10 requests “for each product and service identified in response to INTERROGATORY NO. 4, describe the purchasers of the product or service.” Ikonix replied “that the purchasers of the product are those needing electrical safety compliance.” The fact that this reply is broader than the reply to Interrogatory 9 does not render it “wholly evasive, inadequate, and/or improper” as asserted by BatchTest.

Interrogatory No. 14 requests “Identify all material prejudice to Registrant due to any alleged delay by Petitioner in initiating the current Cancellation proceeding.” The Order dated September 7, 2019 (TTABVUE#10), includes at page 4, “Petitioner’s motion to strike Respondent’s affirmative defenses is granted and paragraphs 44 and 45 are hereby stricken.” Thus, discovery related to affirmative defenses is not proportional to the needs of the case.

Interrogatory No. 15 requests “Identify all information for each year since 2013 on Registrant’s investment and development of Registrant's Products in the United States under Registrant's BATCHTEST Mark; if any such product is or was a part of another product not identified under Registrant’s BATCHTEST Mark, only provide the requested information on the portion such product

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which was under Registrant's BATCHTEST Mark." Ikonix replied that "it objects to Petitioner's request for information relating to the investment and development of its products as being "Confidential – For Attorneys' Eyes only (trade secret/commercially sensitive)." The information on "investment and development" of products is normally highly confidential. Moreover, it is not relevant to the issues of priority of use and likelihood of confusion.

Interrogatory No. 16 requests "State whether Registrant currently uses, has used in the past, or intends to use in the United States in connection with any of Registrant's Products, the mark BATCHTEST in a manner that is different from the mark depicted in Registrant's BATCHTEST Application." Construing "Application" to mean "Registration" and carving our future plans as AEO, Ikonix replied "that it does not and has not used the mark BATCHTEST in a manner different from the" goods listed in the registration. The Office approved the identification of goods when the registration was granted. This reply is not "deliberately vague" as alleged by BatchTest.

Interrogatory Nos. 18-19 request the types of media and the publications where Ikonix promotes BATCHTEST. Ikonix replied "through its website, press releases, product catalog, and customer database, as well as YouTube and LinkedIn." This reply is proportional to the needs of the case and the issue of likelihood of confusion.

Interrogatory No. 28 requests "Identify each publication, whether print or otherwise, which has mentioned Registrant's Products sold or to be sold in the United States under Registrant's BATCHTEST Mark." This is unduly burdensome and not proportional to the needs of the case, where it ask for "each" publication that has "mentioned" Ikonix BATCHTEST product. Ikonix replied that its products "appear in

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Respondent's product catalog and used to be advertised in Evaluation Engineering. This is proportional to the needs of the case where the issue is likelihood of confusion.

Interrogatory Nos. 42, 44-45 and 47 have been replied to in a manner consistent with the rules.

4. Ikonix responded in accord with the rules to the Requests for Production

At page 13 of the Motion, BatchTest admits that some of its requests for production are directed to Ikonix "affirmative defenses." However, the Order dated September 7, 2019 (TTABVUE#10), includes at page 4, "Petitioner's motion to strike Respondent's affirmative defenses is granted and paragraphs 44 and 45 are hereby stricken." Thus, discovery related to affirmative defenses is not proportional to the needs of the case.

Request for Production No. 6 asks for "All documents and things that concern, reflect, refer to, relate to, or evidence any and all surveys, studies, reports or research activity Registrant has conducted or prepared, or that was conducted or prepared on behalf of Registrant, relating to BATCHTEST or any mark, phrase or designation concerning the term BATCHTEST including, but not limited to, each report or summary of the results thereof, whether written or oral, and each document relating to, reflecting, supporting or generated in the consideration, planning, conduct or reporting of any such survey or the results or substances thereof." Ikonix replied that it "did not have another party conduct a trademark search, investigation or study on the trademark BATCHTEST, other than the search conducted by the Examining Attorney of the U.S. Patent and Trademark Office during examination of the application that resulted in Respondent's U.S. Registration No. 4499170 on the mark BATCHTEST. Respondent will

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produce an email string dated November 19, 2012, which reflects selection of the trademark.” Ikonix produced the email string. This production is proportional to the needs of the case, given that the issues are priority of use and likelihood of confusion.

Request for Production No. 7 asks for “All documents concerning any trademark, service mark, trade name, directory, or other search reports relating to BATCHTEST or any mark, phrase or designation containing the term BATCHTEST.” Ikonix replied that it “did not have another party conduct a trademark search, investigation or study on the trademark BATCHTEST, other than the search conducted by the Examining Attorney of the U.S. Patent and Trademark Office during examination of the application that resulted in Respondent’s U.S. Registration No. 4499170 on the mark BATCHTEST. Respondent will produce an email string dated November 19, 2012, which reflects selection of the trademark.” Ikonix produced the email string. This production is proportional to the needs of the case, given that the issues are priority of use and likelihood of confusion.

Request for Production No. 9 asks for “A specimen of each product or service used in connection with the designation BATCHTEST.” Ikonix replied that it “uses the trademark BATCHTEST with the trademarks Autoware 2 and Autoware 3 for software that is written in LabVIEW to interact exclusively with Respondent’s electrical measuring instruments, and will not produce such software and instruments because this is not proportional to the needs of the case, as the product literature and other information being produced by Respondent are sufficient to adjudicate the case.” This production is proportional to the needs of the case, given that the issues are priority of use and likelihood of confusion.

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Request for Production No. 10 asks for “Representative documents sufficient to show Registrant’s first use and first use in commerce of the designation “BATCATEST” in connection with each and every product and/or service listed in the BATCATEST Application, and all documents evidencing Registrant’s continuous use of the designation “BATCATEST” in connection with such goods, including representative samples of each and every such use.” Ikonix replied that it “Respondent will produce representative documents,” and has done so. This production is proportional to the needs of the case, given that the issues are priority of use and likelihood of confusion. BatchTest appears to assert in the Motion that none of the production shows the mark affixed to the goods. This is incorrect. Page 28 of the AR Catalog, at the upper right, shows the BatchTEST On/Off toggle switch on a display screen generated by the software.

Request for Production No. 13 asks to “Produce all documents relating to the nature of all products and services for which Registrant has used the term “BATCATEST,” or any derivation of that term, by itself or in combination with any other word or phrase.” Ikonix replied that it “will produce representative documents.” These documents have been produced. There is one product, software. As stated in response to Interrogatory No. 4, “software because the trademark BATCATEST is used with the trademark Autoware 2 and the trademark Autoware 3, and the Autoware 2 and Autoware 3 software are written to interact exclusively with Registrant’s electrical measuring instruments.”

Request for Production No. 15 asks for “All documents relating to the class of customers or consumers of Registrant’s products and/or services sold, offered for sale or marketed under BATCATEST.” Ikonix replied that it “will produce representative documents.” These documents have

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been produced. The catalog and product sheets reflect the class of customers, because they advertise the features that are attractive to these customers.

Request for Production No. 16 asks for “All documents relating to any identification or profile of the target customers for each of Registrant’s products and/or services bearing the term “BATCATEST” or any derivation of that term, by itself or in combination with any other word or phrase, since the date of first use in connection with each such product and service.” Ikonix replied that it “will produce representative documents.” These documents have been produced. The catalog and product sheets reflect the class of customers, because they advertise the features that are attractive to these customers.

Request for Production No. 20 asks for “All documents showing or relating to the channels of trade through which Registrant’s products and/or services are sold, offered for sale or marketed under BATCATEST.” Ikonix replied that it “will produce representative documents.” These documents have been produced. The catalog and product sheets reflect the channels of trade because they include the postal address, email address, web address and telephone number of Ikonix, which shows the trade channels through which the BATCATEST product is sold, offered for sale and marketed.

Request for Production No. 22 asks for “Representative documents sufficient to show Registrant’s marketing and promotional activity for goods and/or services offered under BATCATEST.” Ikonix replied “Respondent will produce these documents.” These documents have been produced. Ikonix markets the BATCATEST product primarily through its website, and catalog. This production is proportional to the needs of the case, given that the issue is likelihood of confusion.

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Request for Production No. 24 asks for “Representative documents sufficient to show, by year, any actual advertising or promotional expenditures in the United States by or on behalf of Registrant relating to the promotion of goods and/or services, or planned promotion of and/or services, under the designation BATCHTEST.” Ikonix replied that it “objects to this request since the information being sought is “Confidential – For Attorneys’ Eyes Only,” pursuant to the Standard Protective Order as modified by the Board’s February 10, 2021 order. The information on “actual advertising or promotional expenditures” of products is normally highly confidential. There are no affirmative defenses at issue.

Request for Production No. 26 asks for “To the extent not produced in response to an earlier request, a representative example of each different promotional material historically and presently distributed in the United States by or for Registrant, by or for Registrant’s customers, or planned to be distributed by or for Registrant or planned to be distributed by or for Registrant’s customers that mentions, identifies or describes any products and/or services offered by Registrant under the designation BATCHTEST.” Ikonix replied that it “objects to this request insofar as it covers future planned document since the information being sought is ‘Confidential – For Attorneys’ Eyes Only,’ pursuant to the Standard Protective Order as modified by the Board’s February 10, 2021 order. Respondent objects to this request as not proportional to the extent that ‘each’ document is requested. Respondent will produce representative documents.” These documents have been produced. Ikonix markets the BATCHTEST product primarily through its website, and catalog. This production is proportional to the needs of the case, given that the issue is likelihood of confusion.

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Request for Production No. 29 asks for “All documents that refer or relate to any efforts Registrant has made to enforce Registrant’s rights in “BATCHTEST” including, but not limited to, correspondence with third parties, administrative or civil litigation and/or agreements.” Ikonix replied “that it is not in possession of any such document.” This complies with the rules.

Request for Production No. 30 asks for “All documents that you contend evidence goodwill in the designation BATCHTEST.” Ikonix replied that it “objects to this request since the information being sought is ‘Confidential – For Attorneys’ Eyes Only,’ pursuant to the Standard Protective Order as modified by the Board’s February 10, 2021 order. Respondent objects to this request as not proportional to the extent that information on ‘all’ documents are requested.” The documents which evidence goodwill are internal documents and are normally highly confidential. This production is proportional to the needs of the case, given that the issue is likelihood of confusion.

Request for Production No. 33 asks to “Produce all documents in Registrant’s possession, custody, or control relating to Petitioner’s use and/or registration of its BATCHTEST Mark in the United States.” Ikonix replied “Respondent understands that this Request excludes documents generated by Petitioner, or filed by Petitioner at the U.S. Patent and Trademark Office. Respondent objects to this request since the information being sought is ‘Confidential – For Attorneys’ Eyes Only,’ pursuant to the Standard Protective Order as modified by the Board’s February 10, 2021 order. Respondent objects to this request as covering documents protected by the attorney client privilege, and the attorney work product doctrine. Respondent objects to this request as not proportional to the extent that information on “all” documents are requested. To the extent that this Request covers documents filed at the U.S. Patent and Trademark Office (USPTO), Respondent objects to the Request as not proportional because the best

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evidence of the documents is available from the records of the USPTO. Respondent now further objects that documents in the scope of this request are not proportional to the needs of the case which is now limited to the issues of priority of use and likelihood of confusion.

Request for Production No. 37 asks to “Produce all documents that Registrant intends to introduce as exhibits during this cancellation proceeding, whether during discovery or in the trial period of this cancellation proceeding.” Ikonix replied that it “has not yet determined what documents to use as trial exhibits.” Ikonix does presently plan to introduce any documents during discovery, but reserves the right to do so.

CONCLUSION

Ikonix respectfully submits that the Motion to Compel should be denied.

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Respectfully submitted,

/Thomas J. Moore/

Thomas J. Moore
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this document is being served on Petitioner by emailing it on the undersigned date addressed to the correspondence address of record in the TTABVUE database at the website of the U.S. Patent and Trademark Office as follows:

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Date: June 21, 2022

/Thomas J. Moore/
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