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Filing date: **02/11/2020**

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

Proceeding	92071928
Party	Plaintiff Republic Technologies (NA), LLC
Correspondence Address	ANTONY J MCSHANE NEAL GERBER & EISENBERG LLP 2 NORTH LASALLE ST, SUITE 1700 CHICAGO, IL 60602 UNITED STATES amcshane@nge.com, bnathan@nge.com, temanuelson@nge.com, dcesek@nge.com, ecfdoCKET@nge.com 312-269-8000
Submission	Motion for Default Judgment
Filer's Name	ANTONY J. MCSHANE
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Signature	/Antony J. McShane/
Date	02/11/2020
Attachments	Republic Technologies Motion for Judgment -JB CIGARS.pdf(102004 bytes ) EX A - Republic Technologies Motion for Judgment -JB CIGARS.pdf(872747 bytes )

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

In the Matter of Registration No.:  
5,812,004 for JB CIGARS

REPUBLIC TECHNOLOGIES (NA), LLC,

Petitioner,

v.

TABACALERA DIAMOND CIGARS, S.A.,

Respondent.

**Cancellation No. 92071928**

**PETITIONER’S MOTION FOR JUDGMENT**

Pursuant to TBMP §§ 527.01(a) and 527.03, Fed. R. Civ. P. 37(b)(2) and 37 CFR § 2.120(h), Petitioner, Republic Technologies (NA), LLC, (“Republic”) hereby moves the Board for entry of judgment against Respondent, Tabacalera Diamond Cigars, S.A. based on Respondent’s failure to serve Initial Disclosures or its own discovery requests, and its stated intention to surrender the subject registration in this proceeding. In support of its request, Republic states as follows:

1. On August 6, 2019, Republic filed its Petition for Cancellation in this proceeding seeking cancellation of Respondent’s registration for the mark JB CIGARS (Registration No. 5,812,004). Pursuant to the Board’s original Scheduling Order of August 7, 2019, Respondent’s answer was due September 16, 2019, the deadline for the parties’ mandatory discovery conference was October 16, 2019, discovery opened on October 16, 2019, and initial disclosures were due by November 16, 2019.

2. Respondent filed a motion for additional time on September 18, 2019, and then filed its Answer and Affirmative Defenses on October 8, 2019.

3. Proceeding under the original Scheduling Order, Republic's counsel and Respondent's counsel conducted their discovery conference on October 10, 2019. Republic then served Respondent with its Initial Disclosures, First Set of Interrogatories, and First Set of Requests for the Production of Documents on October 28, 2019 (attached hereto as Exhibit A). Respondent's responses to these discovery requests were thus due November 28, 2019.

4. On November 4, 2019, the Board issued a revised Scheduling Order under which Respondent's Initial Disclosures became due on December 7, 2019.

5. On November 26, 2019, Respondent requested additional time to respond to Republic's discovery requests, and Republic granted Respondent until December 30, 2019 to respond.

6. To date, Respondent has not served its Initial Disclosures that were due on December 7, 2019, nor has Respondent served its responses to Republic's discovery requests that were due by December 30, 2019. In addition, Respondent has not served any of its own discovery requests.

7. On January 10, 2019, Respondent's counsel indicated that Respondent does not wish to continue to litigate this matter and that it intends to voluntarily surrender its registration, although it has yet to do so or otherwise respond to Republic's efforts to move this matter forward.

8. Entry of judgment is proper when a party fails to comply with an order of the Board relating to disclosure or discovery. *See* TBMP § 527.01(a); 37 C.F.R. § 2.120(h). Here, Respondent has not served its Initial Disclosures, nor responded to Republic's discovery requests. Accordingly, judgment may therefore be entered against Respondent pursuant to TBMP § 527.01(a) and 37 C.F.R. § 2.120(h).

9. In addition, entry of judgment is appropriate when a party indicates that it will not take further action in the matter. See TBMP § 527.03 (“[W]hen a party to an *inter partes* proceeding before the Board advises an adverse party that it will not take any further action in the case, the adverse party may file a motion asserting this fact and request entry of judgment in its favor.”).

10. Here, Respondent indicated that it does not wish to litigate this matter and will voluntarily surrender its registration. Thus, entry of judgment against Respondent is also appropriate pursuant to TBMP § 527.03.

11. Accordingly, based on Respondent’s failure to serve its Initial Disclosures, respond to Republic’s discovery requests, and its stated intention that it does not wish to proceed with this proceeding, Republic submits that the entry of judgment against Respondent is appropriate.

WHEREFORE, Republic respectfully requests that the Board enter judgment against Respondent, sustain this Cancellation proceeding and cancel Respondent’s registration.

Date: February 11, 2020

Respectfully submitted,

By: /Antony J. McShane /  
One of the Attorneys for  
Republic Technologies (NA), LLC  
Antony J. McShane  
Bari L. Nathan  
Neal, Gerber & Eisenberg LLP  
Two North LaSalle Street – Ste. 1700  
Chicago, IL 60602-3801  
(312) 269-8000 (telephone)  
(312) 269-1747 (facsimile)

**CERTIFICATE OF SERVICE**

I, Bari L. Nathan, an attorney, state that I served a copy of the foregoing **PETITIONER'S**  
**MOTION FOR JUDGMENT** upon:

Gustavo Sardiña  
g.sardina@hnewmedia.com  
H New Media Law  
1110 Brickell Avenue, Suite 506  
Miami, Florida 33131 | 561.847.6380

by email on February 11, 2020.

/Bari L. Nathan/  
Bari L. Nathan

30286162.3

# **EXHIBIT A**

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

In the Matter of Registration No.:  
5,812,004 for JB CIGARS

REPUBLIC TECHNOLOGIES (NA), LLC,

Petitioner,

v.

TABACALERA DIAMOND CIGARS, S.A.,

Respondent.

**Cancellation No. 92071928**

**PETITIONER'S INITIAL DISCLOSURES**

In accordance with 37 C.F.R. § 2.120(a) and Rule 26(a)(1) of the Federal Rules of Civil Procedure, Petitioner, Republic Technologies (NA), LLC (“Republic”), by and through its attorneys, Neal, Gerber & Eisenberg, LLP, hereby makes the following disclosures:

**26(a)(1)(A)(i):** The name and, if known, the address and telephone number of each individual likely to have discoverable information – along with the subjects of that information – that the disclosing party may use to support its claims or defenses, unless the use would be solely for impeachment:

**ANSWER:**

Sachin Lele  
Republic Technologies (NA), LLC  
2301 Ravine Way  
Glenview, Illinois 60025

Mr. Lele is likely to have discoverable information concerning Republic’s use and promotion of the JOB marks; the products with which Republic uses the JOB marks as well as the channels of trade for those products; and Republic’s federal registrations for the JOB marks, Reg. Nos. 73,124; 1,341,384; 2,422,747; 2,420,646; 2,432,868; and 4,019,093.

Republic will supplement this disclosure in the event that it discovers additional individuals likely to have discoverable information that it may use to support its claims.

**26(a)(1)(A)(ii):** A copy – or a description by category and location – of all documents, electronically stored information, and tangible things that the disclosing party has in its possession, custody, or control and may use to support its claims and defenses, unless the use would be solely for impeachment:

**ANSWER:**

Republic may use the following categories of documents relating to the United States market to support its claims in these proceedings:

- (i) Documents constituting advertisements and promotional materials bearing the JOB marks;
- (ii) Documents setting forth marketing and promotional expenditures as well as revenues with respect to products sold in connection with the JOB marks;
- (iii) Documents reflecting the channels of trade of products bearing the JOB marks;
- (iv) Documents showing the manner of use of the JOB marks;
- (v) Documents identifying the products sold under the JOB marks; and
- (vi) Filings with the United States Patent and Trademark Office relating to Republic's federal registrations for the JOB marks.

These documents are located at either the offices of Republic in Glenview, Illinois, or at the offices of Republic's counsel in these proceedings, Neal, Gerber & Eisenberg LLP. Any documents within the categories described above that may be in Republic's possession may contain confidential and proprietary information. Accordingly, Republic will produce any such documents subject to the Board's standing protective order governing this matter. Republic will supplement this disclosure in accordance with 37 C.F.R. § 2.120(a) and Fed. R. Civ. P. 26(e) if it discovers additional categories of documents that it may use to support its claims in these proceedings.



**26(a)(1)(A)(iii):** A computation of each category of damages claimed by the disclosing party – who must also make available for inspection and copying as under Rule 34 the documents or other evidentiary material, unless privileged or protected from disclosure, on which each computation is based, including materials bearing on the nature and extent of injuries suffered:

**ANSWER:** Not applicable.

**26(a)(1)(A)(iv):** For inspection and copying as under Rule 34, any insurance agreement under which an insurance business may be liable to satisfy all or part of a possible judgment in the action or to indemnify or reimburse for payments made to satisfy the judgment:

**ANSWER:** Not applicable.

Date: October 28, 2019

Respectfully submitted,

By: /Antony J. McShane /  
One of the Attorneys for  
Republic Technologies (NA), LLC  
Antony J. McShane  
Bari L. Nathan  
Neal, Gerber & Eisenberg LLP  
Two North LaSalle Street – Ste. 1700  
Chicago, IL 60602-3801  
(312) 269-8000 (telephone)  
(312) 269-1747 (facsimile)

**CERTIFICATE OF SERVICE**

I hereby certify that I served a copy of the foregoing **PETITIONER'S INITIAL DISCLOSURES** upon:

Gustavo Sardina  
g.sardina@hnewmedia.com  
H New Media Law  
1110 Brickell Avenue, Suite 506  
Miami, Florida 33131 | 561.847.6380

via email on the date noted below:

Date: October 28, 2019

By: /Bari L. Nathan/  
One of the Attorneys for Petitioner,  
Republic Technologies (NA), LLC

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

In the Matter of Registration No.:  
5,812,004 for JB CIGARS

REPUBLIC TECHNOLOGIES (NA), LLC,

Petitioner,

v.

TABACALERA DIAMOND CIGARS, S.A.,

Respondent.

**Cancellation No. 92071928**

**PETITIONER'S FIRST SET OF INTERROGATORIES**

Pursuant to Rule 2.120 of the Trademark Rules of Practice and Rule 33 of the Federal Rules of Civil Procedure, Petitioner, Republic Technologies (NA), LLC (“Republic”), hereby requests that Respondent, Tabacalera Diamond Cigars, S.A., serve upon Republic sworn answers to the interrogatories set forth below within thirty (30) days. These interrogatories are intended to be continuing in nature and any information that may be discovered subsequent to the service of Respondent’s initial answers should be brought to the attention of Republic through supplemental answers within thirty (30) days following such discovery pursuant to Rule 26(e) of the Federal Rules of Civil Procedure.

**INTERROGATORIES**

1. Identify by common commercial name each product marketed, sold or offered, or intended to be marketed, sold or offered by Respondent under or in connection with Respondent’s Mark in the United States, and for each product, identify, with respect to the United States:
  - a. the inclusive dates of use of Respondent’s Mark with such products (if applicable);

- b. the current or anticipated geographic scope of such use;
- c. the price at which the product is sold or intended to be sold;
- d. the annual volume of sales of the product in both dollars and units, if applicable;
- e. the unit sizes in which the product is or will be sold;
- f. each class of purchasers or expected purchasers of the product;
- g. the channels of trade by which the product reaches or will reach the ultimate consumer;
- h. all types of stores or forums in which the product is or will be offered or sold; and
- i. the persons most knowledgeable of each of the foregoing and all documents relating thereto.

2. Explain the reason(s) for Respondent's selection of Respondent's Mark and decision to seek a trademark registration in the United States for each product identified in response to Interrogatory No. 1 as well as the procedure followed by Respondent for selecting the mark for such products.

3. Identify all marks other than Respondent's Mark considered for use in connection with each product identified in response to Interrogatory No. 1, and explain whether such mark was ever used with any of the products.

4. Describe in detail each opinion, survey or research effort initiated by, for or on behalf of Respondent relating in any way to Respondent's Mark, including the decision to use and apply to register the mark in the United States.

5. Identify all persons and entities involved or to be involved on behalf of Respondent in marketing, distribution and sale of products under or in connection with Respondent's Mark in the United States, and for each such person or entity, describe in detail the services that have been, are being or will be performed and the inclusive dates of such services.

6. With respect to each product identified in response to Interrogatory No. 1, identify all means by which the product will be or has been advertised or promoted in the United States.

7. Identify every trade show in the United States at which each product identified in response to Interrogatory No. 1 has been or will be advertised, promoted, or marketed.

8. Identify each press release concerning any product promoted in association with Respondent's Mark issued, or intended to be issued and, for each such release, identify all publications or other media in or through which the press release was disseminated.

9. State whether Respondent has ever received any communications that in any manner were intended for Republic or that in any way indicated a connection between Republic and Respondent or their products, and if so, with respect to each identify:

- a. each such communicator;
- b. the date and place of occurrence;
- c. the substance of each such communication; and
- d. the person receiving the communication.

10. Describe in detail Respondent's awareness and knowledge of Republic, Republic's business activities, and Republic's Marks prior to Respondent's selection and adoption of Respondent's Mark and the filing of its application for registration in the United States of Applicant's Mark.

11. State whether Respondent has ever received any objection to its use or registration of Respondent's Mark other than the instant proceeding, and with respect to each such objection, identify: (a) the nature and basis of the objection, (b) when the objection was made, and (c) the disposition of the objection.

12. Identify all agreements to which Respondent has been or is a party that refer or relate in any way to Respondent's Mark, including all amendments and modifications thereto.

13. Identify all facts that support Respondent's contentions in its application for the Subject Registration that (a) it has a *bona fide* intent to use in commerce in the United States, and (b) it is entitled to use the mark in commerce in the United States.

14. Identify, on an interrogatory-by-interrogatory basis, each person furnishing information upon which any part of any answer to these interrogatories is based, indicating the parts based on information so furnished by each such person, and whether such information is within the personal knowledge of such person, and if not within such person's knowledge, identify the source of the information so furnished.

### **DEFINITIONS**

As used herein, the words and phrases set out below shall have the following meaning or meanings prescribed for them:

A. "Republic" means Republic Technologies (NA), LLC, as well as its respective officers, directors, subsidiaries, divisions, representatives, employees, agents and assignees.

B. "Respondent" means Tabacalera Diamond Cigars, S.A., a Nicaragua corporation, as well as its predecessors, agents, employees, respective officers, directors, subsidiaries, divisions, representatives and other persons acting on its behalf or on behalf of its predecessors.

C. "Subject Registration" means U.S. Trademark Registration Number 5,812,004.

D. "Republic's Marks" means Republic's JOB marks, including U.S. Reg. Nos. 73,124; 1,341,384; 2,422,747; 2,420,646; 2,432,868; and 4,019,093.

E. "Respondent's Mark" means the JB CIGARS mark as set forth in the Subject Registration, and for use in connection with the goods designated therein.

F. "Person" means any individual, firm, partnership, corporation, proprietorship, association, or other organization or entity.

G. "Identify" means:

- a. in connection with natural persons, state their full names, titles and job descriptions, if applicable, and their present or last known business and home addresses;
- b. in connection with firms, partnerships, corporations, proprietorships, associations or other entities, state their name, and each of their present or last known addresses;
- c. in connection with documents, describe the documents, setting forth their dates, titles, authors, addresses, parties thereto and the substance thereof, with such reasonable particularity as would be sufficient to permit them to be sought by subpoenas *duces tecum* or under the provisions of Rule 34 of the Federal Rules of Civil Procedure. Documents to be identified shall include both documents in your possession, custody and control and all other documents of which you have knowledge; and
- d. in connection with oral statements and communications, (i) state when and where they were made; (ii) identify each of the makers and recipients thereof as well as all others present at the time such statement or communication was made; (iii) indicate the medium of communication; and (iv) state their substance.

H. “Document” or “documents” means all writings of any nature whatsoever or other means by which information is retained in retrievable form, as well as drafts and all non-identical copies thereof, including but not limited to memoranda, reports, opinions, stenographic or handwritten notes, contracts, agreements, records, audio and video recordings, correspondence, communications, studies, summaries, surveys, statistical compilations, minutes, charts, manuals, brochures, schedules, price lists, telegrams, teletypes, facsimiles, photographs of any nature, E-mail, electronically stored documents regardless of location or media upon which the data is stored, signage, drawings, sketches, blueprints, certificates of registration, labels, specimens, writings, and any other documents as defined in Rule 34 of the Federal Rules of Civil Procedure.

I. “Advertisement” means any printed or promotional materials including, but not limited to, flyers, brochures, story boards, newspaper items, scripts and audiotapes of radio advertising, scripts and videotapes of television advertising, email or other internet promotions and solicitations, and other materials printed, distributed or aired to the public or trade.

## INSTRUCTIONS

If you cannot answer any interrogatory fully, completely, and in detail, after exercising due diligence to make inquiry and secure the information necessary, so state, and (1) answer such interrogatory to the extent possible; (2) specify the portion of such interrogatory that you are unable to answer fully, completely, and in detail; and (3) state the reason why such portion cannot be so answered. If your response is qualified in any particular respect, set forth the details of such qualification.

If any information is withheld under a claim of privilege, state the nature of the privilege claimed and provide sufficient information to permit a full determination of whether the claim is valid.

Date: October 23, 2019

Respectfully submitted,

By: /Antony J. McShane /  
One of the Attorneys for  
Republic Technologies (NA), LLC  
Antony J. McShane  
Bari L. Nathan  
Neal, Gerber & Eisenberg LLP  
Two North LaSalle Street – Ste. 1700  
Chicago, IL 60602-3801  
(312) 269-8000 (telephone)  
(312) 269-1747 (facsimile)



**CERTIFICATE OF SERVICE**

I hereby certify that I served a copy of the foregoing **PETITIONER'S FIRST SET OF INTERROGATORIES** upon:

Gustavo Sardina  
g.sardina@hnewmedia.com  
H New Media Law  
1110 Brickell Avenue, Suite 506  
Miami, Florida 33131 | 561.847.6380

via email on the date noted below:

Date: October 28, 2019

By: /Bari L. Nathan/  
One of the Attorneys for Petitioner,  
Republic Technologies (NA), LLC

29930344.2

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

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TABACALERA DIAMOND CIGARS, S.A.,

Respondent.

**Cancellation No. 92071928**

**PETITIONER'S FIRST SET OF REQUESTS**  
**FOR THE PRODUCTION OF DOCUMENTS**

Pursuant to Rule 2.120 of the Trademark Rules of Practice and Rule 34 of the Federal Rules of Civil Procedure, Petitioner, Republic Technologies (NA), LLC (“Republic”), hereby requests that Respondent, Tabacalera Diamond Cigars, S.A., produce the documents and things described below at the offices of Neal, Gerber & Eisenberg, LLP, Two North LaSalle Street, Suite 1700, Chicago, Illinois 60602, or at such other place mutually agreed upon by the parties, within thirty (30) days. These requests are intended to be continuing in nature, and supplemental responses should be provided if Respondent learns that a response is incomplete or incorrect in any respect, pursuant to Rule 26(e) of the Federal Rules of Civil Procedure.

**REQUESTS FOR PRODUCTION OF DOCUMENTS**

1. Documents sufficient to identify:
  - a. all products offered or intended to be offered by Respondent under Respondent’s Mark in the United States;
  - b. the manner in which Respondent uses or intends to use Respondent’s Mark in the United States; and

- c. the geographic scope of Respondent's efforts or intended efforts to market, sell, or otherwise provide products under Respondent's Mark in the United States.
2. For each product offered by or intended to be offered under Respondent's Mark, all documents evidencing, referring, or relating to when Respondent first used Respondent's Mark in the United States.
3. Documents sufficient to identify the channels of trade through which Respondent distributes or intends to distribute products, or offers or intends to offer products, under Respondent's Mark in the United States, including, without limitation, documents sufficient to identify the customers, sales agents, dealerships, distributors or other outlets through which its products are sold or are intended to be sold under Respondent's Mark.
4. For each product offered by or intended to be offered under Respondent's Mark in the United States, documents sufficient to identify:
  - a. the prices Respondent charges or intends to charge for each such product; and
  - b. Respondent's annual sales (in units and dollars) and projected sales of each such product, by country and state.
5. All documents evidencing, referring, or relating to any sales or marketing plans for products sold or intended to be sold under Respondent's Mark in the United States.
6. All documents evidencing, referring, or relating to:
  - a. the manner by which Respondent advertises or promotes, has advertised or promoted, or intends to advertise or promote products under Respondent's Mark in the United States;
  - b. any publications in which Respondent has placed or intends to place print advertisements, articles or other information concerning products Respondent offers or intends to offer under Respondent's Mark in the United States; and
  - c. any Internet website referring or relating to Respondent's Mark, including but not limited to printouts of all such website pages.

7. Documents sufficient to identify the total annual expenditures incurred by Respondent to date, by year, if applicable, for all advertising and marketing using or relating to Respondent's Mark in the United States.

8. All documents constituting, describing or relating to any forecast for expenditures anticipated or planned to be incurred by Respondent for advertising and marketing products using or relating to Respondent's Mark in the United States.

9. All documents that disclose, describe, or otherwise relate to:

- a. the characteristics or profiles of the type of person or entity that purchases or otherwise receives products provided by Respondent under Respondent's Mark in the United States or the type of person or entity to whom Respondent intends to market and sell products under Respondent's Mark in the United States;
- b. any incident(s) wherein any persons or entities have indicated that they understood or believed that Republic's business or products, and Respondent's business or products, were in any way affiliated, associated or connected with one another; and
- c. with regard to any such incident(s), produce all documents that disclose, describe or are related to:
  - i. the place of such incident;
  - ii. the date of such incident;
  - iii. the identity of all persons or entities involved in or having knowledge of such incident, and the nature of their involvement or knowledge;
  - iv. the products involved in such incident;
  - v. the nature of the incident;
  - vi. how the incident came to the attention of Respondent; and
  - vii. efforts to ascertain or monitor such incidents.

10. All documents constituting or relating to:

- a. misdirected correspondence (including electronic mail) or telephone calls received by Respondent that appear to be intended for Republic; and

b. Republic or Republic's products.

11. All documents evidencing, referring, or relating to the selection or adoption of Respondent's Mark in the United States or otherwise.

12. All documents constituting, describing or concerning any and all trademark searches, investigations, polls, studies, evaluations, analysis, tests, ratings or surveys relating to Respondent's Mark.

13. All documents constituting, describing or concerning any and all trademark searches, investigations, polls, studies, evaluations, analysis, tests, ratings or surveys relating to Republic and its trademarks, including any and all legal opinions relating to Republic or Republic's Marks.

14. Documents sufficient to identify any person employed by or associated with Respondent who was involved in or responsible for the selection or adoption of Respondent's Mark, and with respect to each person so identified, the nature and scope of his or her involvement.

15. All documents evidencing, referring, or relating to the decision by Respondent to apply for registration of Respondent's Mark in the United States, including, but not limited to, all documents related to any discussions concerning such decision(s).

16. All documents relating or referring to any draft or actual filings with either the United States Patent and Trademark Office or any state's trademark office concerning any attempted registration by Respondent of Respondent's Mark, including the Subject Registration.

17. All documents that disclose, describe, constitute or otherwise relate to:

- a. statements or reports concerning the quality or perceived standards of quality of products offered, or to be offered, under Respondent's Mark or otherwise;
- b. any potential, threatened or actual civil action or *inter partes* proceeding relating to Respondent's Mark or involving products offered or to be offered by Respondent under Respondent's Mark or otherwise; and

- c. any complaints concerning any products distributed, marketed or sold at any time by Respondent, whether under Respondent's Mark or otherwise.

18. All documents evidencing, referring, or relating to use by any third-party of any mark comprising Respondent's Mark or any other term that is visually or phonetically similar thereto.

19. Representative specimens of all packaging, hang tags, wrapping, promotional material, press or publicity releases, brochures, pamphlets, advertisements, point of sale displays, signs, trade show displays, labels, or other material that depicts or describes any products marketed, distributed, sold, or offered under Respondent's Mark in the United States, or intended to be marketed, distributed, sold, or offered under Respondent's Mark in the United States, including all drafts, mock-ups and prototypes thereof.

20. All documents evidencing, referring, or relating to the development, production, or placement of all advertisements, either actual or considered, depicting or describing any products marketed, distributed, sold, or offered under Respondent's Mark in the United States, or intended to be marketed, distributed, sold or offered by Respondent under Respondent's Mark in the United States.

21. All documents evidencing, referring, or relating to test marketing conducted by Respondent, or on its behalf, of any products offered or intended to be offered under Respondent's Mark in the United States, including but not limited to any market surveys, analyses, or studies concerning the promotion, use, potential sale, or sale of such product.

22. All agreements that relate in any way to Respondent's Mark, including all amendments and modifications thereto.

23. All documents consulted in the preparation of, or that are requested to be identified in, Respondent's responses to Petitioner's First Set of Interrogatories.

24. All documents relating to any document retention policy of Respondent or the destruction of documents by Respondent at any time.

### **DEFINITIONS**

As used herein, the words and phrases set out below shall have the following meaning or meanings prescribed for them:

A. “Republic” means Republic Technologies (NA), LLC, as well as its respective officers, directors, subsidiaries, divisions, representatives, employees, agents and assignees.

B. “Respondent” means Tabacalera Diamond Cigars, S.A., a Nicaragua corporation, as well as its predecessors, agents, employees, respective officers, directors, subsidiaries, divisions, representatives and other persons acting on its behalf or on behalf of its predecessors.

C. “Subject Registration” means U.S. Trademark Registration Number 5,812,004.

D. “Republic’s Marks” means Republic’s JOB marks, including U.S. Reg. Nos. 73,124; 1,341,384; 2,422,747; 2,420,646; 2,432,868; and 4,019,093.

E. “Respondent’s Mark” means the JB CIGARS mark as set forth in the Subject Registration, and for use in connection with the goods designated therein.

F. “Person” means any individual, firm, partnership, corporation, proprietorship, association, or other organization or entity.

G. “Identify” means:

- i. in connection with natural persons, state their full names, titles and job descriptions, if applicable, and their present or last known business and home addresses;
- ii. in connection with firms, partnerships, corporations, proprietorships, associations or other entities, state their name, and each of their present or last known addresses;
- iii. in connection with documents, describe the documents, setting forth their dates, titles, authors, addresses, parties thereto and the substance thereof, with such reasonable particularity as would be sufficient to permit them to

be sought by subpoenas *duces tecum* or under the provisions of Rule 34 of the Federal Rules of Civil Procedure. Documents to be identified shall include both documents in your possession, custody and control and all other documents of which you have knowledge; and

- iv. in connection with oral statements and communications, (i) state when and where they were made; (ii) identify each of the makers and recipients thereof as well as all others present at the time such statement or communication was made; (iii) indicate the medium of communication; and (iv) state their substance.

H. “Document” or “documents” means all writings of any nature whatsoever or other means by which information is retained in retrievable form, as well as drafts and all non-identical copies thereof, including but not limited to memoranda, reports, opinions, stenographic or handwritten notes, contracts, agreements, records, audio and video recordings, correspondence, communications, studies, summaries, surveys, statistical compilations, minutes, charts, manuals, brochures, schedules, price lists, telegrams, teletypes, facsimiles, photographs of any nature, E-mail, electronically stored documents regardless of location or media upon which the data is stored, signage, drawings, sketches, blueprints, certificates of registration, labels, specimens, writings, and any other documents as defined in Rule 34 of the Federal Rules of Civil Procedure.

I. “Relate to,” “related to,” or “relating to” means directly or indirectly mentioning or describing, pertaining to, connected with, or reflecting upon a state subject matter.

J. “Advertisement” means any printed or promotional materials including, but not limited to, flyers, brochures, story boards, newspaper items, scripts and audiotapes of radio advertising, scripts and videotapes of television advertising, email or other internet promotions and solicitations, and other materials printed, distributed or aired to the public or trade.



## INSTRUCTIONS

- A. The singular includes the plural and the plural includes the singular.
- B. The terms “and” and “or” shall be construed disjunctively or conjunctively as necessary in order to bring within the scope of the document request all responses which might otherwise be construed to be outside its scope.
- C. In responding to these requests, Respondent must make a diligent search of its records and of other papers and materials in its possession or available to it or its representatives, in accordance with the requirements of Rule 34 of the Federal Rules of Civil Procedure.
- D. In answering these requests, Respondent is required to furnish all documents that are available to it, including documents and things in the possession, custody or control of any of Respondent’s representatives, including, without limitation, Respondent’s attorneys, accountants, advisers, agents, and other persons, directly or indirectly, employed by, or connected with Respondent or anyone else otherwise subject to Respondent’s control.
- E. Each request calls for production of each document and thing in its entirety, without abbreviation, redaction, expurgation or modification. In addition, each request requires production of any addenda, attachments, drafts, and non-identical copies as found or located either in Respondent’s business or personal files, together with a copy of the descriptive file folders or database category in its entirety.
- F. If any request cannot be complied with in full, it shall be complied with, to the extent possible, with a written explanation as to why full compliance is not possible. If there are no documents or things responsive to a particular request, Respondent must state so in writing.
- G. All objections to document requests in which Respondent fails or refuses to fully respond on the ground of any claim of privilege of any kind whatever shall:

- i. state the nature of the claim of privilege;
- ii. state all facts relied upon in support of the claim of privilege or related thereto;
- iii. identify all documents related to the claim of privilege;
- iv. identify all persons having knowledge of any facts related to the claim of privilege; and
- v. identify all events, transactions or occurrences related to the claim of privilege.

H. Discovery requests are continuous in nature and, pursuant to Rule 26(e) of the Federal Rules of Civil Procedure, you are under a duty to seasonably supplement any prior response to a Request for Production if you learn that the response is in some material respect incomplete or incorrect, or if you are so ordered by the Court.

Date: October 28, 2019

Respectfully submitted,

By: /Antony J. McShane /  
One of the Attorneys for  
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**CERTIFICATE OF SERVICE**

I hereby certify that I served a copy of the foregoing **PETITIONER'S FIRST SET OF REQUESTS FOR THE PRODUCTION OF DOCUMENTS** upon:

Gustavo Sardina  
g.sardina@hnewmedia.com  
H New Media Law  
1110 Brickell Avenue, Suite 506  
Miami, Florida 33131 | 561.847.6380

via email on the date noted below:

Date: October 28, 2019

By: /Bari L. Nathan/  
One of the Attorneys for Petitioner,  
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