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

Proceeding	92073804
Party	Plaintiff Petabyte Technology, Inc.
Correspondence Address	BRIAN TAMSUT SOCAL IP LAW GROUP LLP 310 N WESTLAKE BLVD , SUITE 120 WESTLAKE VILLAGE, CA 91362 UNITED STATES Primary Email: btamsut@socalip.com Secondary Email(s): sshereboff@socalip.com, nabeloe@socalip.com, uspto@socalip.com 805-230-1350
Submission	Other Motions/Papers
Filer's Name	Brian Tamsut
Filer's email	btamsut@socalip.com, sshereboff@socalip.com, nabeloe@socalip.com, uspto@socalip.com
Signature	/Brian Tamsut/
Date	09/22/2020
Attachments	Petitioner Reply in Support of Motion to Compel L20377.pdf(46582 bytes) Petitioner Dec in Support of Reply to Motion to Compel L20377.pdf(74446 bytes) Exhibit A - REDACTED.pdf(129656 bytes) Exhibit B.pdf(173350 bytes)

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

Petabyte Technology, Inc., a Delaware corporation, Petitioner, v. InterOperability Bidco, Inc., a Delaware corporation Respondent.	Cancellation No. 92073804 (parent) 92073874 Registration No. 4677029, 2910269 Mark: RHAPSODY

PETITIONER'S REPLY IN SUPPORT OF MOTION TO COMPEL DISCOVERY RESPONSES

Petitioner respectfully submits this Reply in support of its motion to compel discovery responses.

INTRODUCTION

Petitioner's motion to compel was necessitated by Registrant's evasiveness and failure to provide timely and responsive documents, despite Petitioner accommodating Registrant at every turn. In a further attempt to evade producing relevant discovery, Registrant produces documents weeks after the initial discovery deadline and not fully responsive to Petitioner's discovery requests. Registrant should not be rewarded for its gamesmanship, evasiveness, and dilatory conduct. Registrant should be ordered to fully comply with its discovery obligations.

Petitioner served discovery requests on Registrant, and when asked to provide more time for a response, graciously allowed Registrant more time to respond. After Petitioner was forced to file a motion to compel, Registrant finally produced 85 pages of documents. (Tamsut Reply

Decl. ¶ 2 and exhibit A). These 85 pages are not fully responsive to Petitioner's document requests. On September 8th, 2020, Attorneys for Petitioner sent Registrant's attorney an email outlining the deficiencies with Registrant's responses. (Tamsut Reply Decl. ¶ 3 and exhibit B). Registrant further refused to produce documents but agreed to meet and confer regarding the issue. (Tamsut Reply Decl. ¶ 3). After delaying the meet and confer meeting several times, Registrant's counsel finally agreed to meet and confer with Petitioner's attorneys, but nonetheless refused to produce any further documents. (Tamsut Reply Decl. ¶ 4-5).

Registrant's belated, thin production reflects either a lack of diligence or a lack of respect for these proceedings. Furthermore, Registrant's assertion that "Registrant has served responses to the outstanding discovery requests", (9 TTABVUE), is incorrect because there are multiple documents being withheld based on improper objections.

PETITIONER'S MOTION TO COMPEL DISCOVERY RESPONSES

Registrant's untimely and incomplete discovery responses do not meet standards required by the Federal Rules and the Board's Rules. Registrant's opposition arguments fail to cure the numerous deficiencies within Registrant's production. *See* FRCP 26, 34, 37; TBMP § 408 (Duty to cooperate, search records, and supplement); *Hewlett Packard Enterprise Development LP v. Arroware Industries, Inc*., Cancellation No. 92067494 (TTAB May 2, 2019) (precedential) (granting Petitioner's motion to compel due to Respondent's incomplete discovery responses and lack of cooperation in the discovery process).

A. Registrant's Production Contains No Information Related to Revenues and Expenditures

Attached as Exhibit A to the declaration filed with this motion are the only documents produced by Registrant. These documents contain nothing related to Petitioner's RFP 19, 20, and

21 relating to revenues from sales and expenditures on advertising. During a meet and confer regarding discovery on September 21st, 2020, Registrant's counsel continued to insist that the documents were not relevant and that such documents would not be produced.

"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" (Fed. R. Civ. P. 26(b)(1)) TBMP 402.01. Furthermore TBMP § 414 (18) expressly states that "annual sales and advertising figures" are discoverable. One main issue in this proceeding is whether the RHAPODY mark has been abandoned. Registrant's sales and advertising figures are highly relevant to whether a mark has been abandoned because if a mark has not been abandoned one would expect these figures to exist or an explanation as to why they do not exist. These figures are proportional to the needs of the case because producing these documents is not very difficult: all businesses are required to keep such records. Locating records that already exist and are relevant to the case is not an undue burden. Registrant's objections regarding RFP 19, 20, and 21 should be overruled and Registrant should be compelled to produce documents responsive to this request.

B. Registrant's Production Contains No Information Relating to Expansion

Petitioner's RFP 11 requested "Documents sufficient to establish Your plans concerning use of the RHAPSODY mark, including but not limited to, any creation or expansion of marketing lines, product lines, and/or intended consumer base for goods or services to be offered or sold in connection with the RHAPSODY mark" (6 TTABVUE). The Board has routinely endorsed such discovery requests. TBMP § 414 (8) states "[a] party's plans for expansion may be discoverable under protective order." Here, the request is relevant to the case, no evidence relating to expansion may indicate that the mark is currently abandoned as Registrant has no further plans to expand upon or use the mark.

C. Registrant's Responses Contain A Privilege Objection but No Privilege Log.

Registrant's form objections contain a reference to withholding documents based on the attorney client privilege. "Respondent objects to the Requests for Production to the extent they seek information protected from discovery by the attorney-client privilege and/or attorney work product doctrine or any other privilege." (Tamsut Decl. Exhibit A, *See* Respondent's Responses to Petitioner's First Set of Document Requests to Respondent Interoperability Bidco, Inc. General Objections item D) It is unclear from this form objection whether there are privileged documents or not. Under TBMP 406.04(c), "Fed. R. Civ. P. 26(b)(5) does not specify exactly how the party asserting privilege/protection must particularize its claim. The most common way is by using a privilege log, which identifies each document withheld, information regarding the nature of the privilege/protection claimed, the name of the person making/receiving the communication, the date and place of the communication, and the document's general subject matter." Petitioner hereby formally requests Registrant provide a privilege log in accordance with TBMP 406.04(c) and identify each document being withheld on the basis of the attorney client privilege.

Conclusion

For the reasons set forth above and in Petitioner's first Motion, Petitioner respectfully requests that the Board grant its Motion.

Respectfully submitted,

September 22, 2020 /s/ Brian Tamsut

Brian Tamsut
California Bar No. 322780
btamsut@socalip.com

Steven C. Sereboff
California Bar No. 156731
sschereboff@socalip.com
SoCal IP Law Group LLP
310 N. Westlake Blvd., Suite 120
Westlake Village, CA 91362
Phone: (805) 230-1350 Attorneys for Petitioner
Petabyte Technology, Inc.

CERTIFICATE OF SERVICE

I hereby certify that on September 22, 2020, the foregoing PETITIONER'S REPLY IN SUPPORT OF MOTION TO COMPEL DISCOVERY RESPONSES was served via email to counsel for Respondent InterOperability Bidco, Inc. at:

snweller@mintz.com, jddib@mintz.com,

acromanini@mintz.com, ipdocketingbos@mintz.com,

Mintzdocketing@cpaglobal.com

September 22, 2020 /s/ Nicole Abeloe

Nicole Abeloe

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

Petabyte Technology, Inc., a Delaware corporation, Petitioner, v. InterOperability Bidco, Inc., a Delaware corporation Respondent.	Cancellation No. 92073804 (parent) 92073874 Registration No. 4677029, 2910269 Mark: RHAPSODY

DECLARATION OF BRIAN TAMSUT IN SUPPORT OF PETITIONER'S REPLY

I, Brian Tamsut, declare as follows.

1. I am an attorney at SoCal IP Law Group LLP and attorney of record for Petitioner Petabyte Technology, Inc. in this TTAB proceeding. I make this declaration based on my own personal knowledge.
2. On August 25, 2020 Petitioner's counsel served a response to Petitioner's Request for Production along with 47 documents marked confidential and 38 pages not marked confidential for a total of 85 pages in a PDF format. These documents are subject to a protective order and are reproduced in this declaration as Exhibit A.
3. On September 8, 2020 I emailed Registrant's counsel outlining the deficiencies in the document production and requesting that Registrant meet and confer regarding supplementing the discovery production. Registrant did not agree to produce more documents. The email is reproduced in this declaration as Exhibit B.

4. After multiple delays (not the fault of Petitioner's counsel), counsel for Petitioner and Registrant met and conferred by telephone on September 21, 2020.
5. During the September 21, 2020 call registrant's counsel did not agree to produce any more documents.

I declare under penalty of perjury that the forgoing is true and correct to the best of my knowledge.

September 22, 2020

/s/ Brian Tamsut
Brian Tamsut

Exhibit A

Exhibit B

Brian Tamsut

To: Weller, Susan
Subject: FW: Petabyte v. InterOperability Bidco TTAB Cancellation Proceedings - Confidential Discovery Docs P272.L20377

From: Weller, Susan <SWeller@mintz.com>
Sent: Tuesday, September 8, 2020 6:42 PM
To: Brian Tamsut <btamsut@socalip.com>
Cc: Steve Sereboff <SSereboff@socalip.com>; Romanini, Allysa <ACRomanini@mintz.com>; Dib, Jacobo <JDDib@mintz.com>; Gause, Shelly <SYGause@mintz.com>
Subject: Re: Petabyte v. InterOperability Bidco TTAB Cancellation Proceedings - Confidential Discovery Docs P272.L20377

Brian:

We will get back to you on our availability for a call. The times you proposed will not work for us.

Generally, much of what you have requested is not relevant to the issue of whether our client abandoned its mark. For example, advertising and revenue information is not relevant to the issue of abandonment, and future plans for use of the mark are not also not relevant to whether the mark was abandoned. We produced documents demonstrating unequivocally that the mark has been in use for many years and has never been abandoned. Such documents will not be produced for the grounds stated.

Regards,

Susan

> On Sep 8, 2020, at 5:48 PM, Brian Tamsut <btamsut@socalip.com> wrote:
>
> Dear Susan,
>
> We write regarding numerous deficiencies in Respondent's Responses to Petitioner's First Set of Document Requests to Respondent Interoperability Bidco, Inc. We request your availability to meet and confer this week. Steve and I are available for a phone call 9/9/2020 from 1:00pm – 2:00pm PST. Alternatively, we can be available Thursday 9/10/2020 from 2:00pm -3:00pm PST.
>
> In advance of our meeting, we address several of Respondent's deficient discovery responses. Notwithstanding the below, Petitioner reserves the right to follow up concerning additional matters as may be necessary. Petitioner also reserves the right to supplement this deficiency letter and further object to any insufficient responses once Petitioner has had the opportunity to review Respondent's document production.
>
> Objections based on privilege and request for privilege log

Respondent listed in part D of "General Objections" that "Respondent objects to the Requests for Production to the extent they seek information protected from discovery by the attorney-client privilege and/or attorney work product doctrine or any other privilege." Not only does the Board look towards general objections with disfavor see T.B.M.P § 405.04(b) but if Respondent is going to object based on attorney client privilege, Petitioner formally requests respondent create a privilege log for all documents withheld on the basis of privilege.

Objections to requests for revenues and expenditures

Petitioner has objected to RFPs 19, 20, and 21 relating to requests for Respondent's advertising expenditures and revenues. This objection and refusal to produce documents is improper, TBMP § 414 (18) expressly states that "annual sales and advertising figures" are discoverable. Respondent must produce responsive documents and complete interrogatory responses without further delay.

Objections to Requests regarding expansion

Respondent has objected and refused to produce documents responsive to RFP 11 which requests,

"Documents sufficient to establish Your plans concerning use of the RHAPSODY mark, including but not limited to, any creation or expansion of marketing lines, product lines, and/or intended consumer base for goods or services to be offered or sold in connection with the RHAPSODY mark."

This objection and refusal to produce documents is improper. A protective order is already in place for this case, and Respondent's plans regarding use of a mark that is allegedly not abandoned is highly relevant. Furthermore TBMP § 414 (8) states "[a] party's plans for expansion may be discoverable under protective order."

We look forward to conferring with you on these matters and to receiving Respondent's complete responses.

Best,

/Brian Tamsut/
Attorney
<image001.jpg>
Skype ID: btam22
310 N. Westlake Blvd., Suite 120, Westlake Village, CA 91362
1332 Anacapa St., Suite 201 Santa Barbara, CA 93101
P +1 (805) 267-2265
www.socalip.com
btamsut@socalip.com