EXHS TTAB

02-03-2003

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I hereby certify that on the date specified below, this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to Commissioner of Patents and Trademarks, Washington D.C. 200231.

January 31, 2003
Date

Brian G. Bodine

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

I.C.E.D. Management, Inc., Opposer, v. CDS, Incorporated, Applicant.	Trademark Opposition No. 121,374 Concurrent Use No. 1250 Docket No. 59320-4

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Asst. Commissioner of Trademarks
Clerk of the Trademark Trial and Appeal Board
Box TTAB/No Fee
2900 Crystal Drive
Arlington, VA 22202-3513

MOTION TO COMPEL DISCOVERY RESPONSES AND MEMORANDUM IN SUPPORT OF OPPOSER'S MOTION TO COMPEL

Pursuant to 37 C.F.R. § 2.120(e), Opposer I.C.E.D. Management, Inc. ("Opposer") hereby moves the Board for an order compelling Applicant CDS, Incorporated ("Applicant") to more fully respond to Opposer's requests for interrogatories and document production.

I. FACTUAL BACKGROUND

Opposer is currently opposing Applicant's concurrent use application for its mark ("THE COPY CLUB") because that mark is nearly identical to Opposer's "COPY CLUB" mark. Because the marks are nearly identical, concurrent use of the marks is likely to cause confusion.

On December 10, 2003, Opposer served on Applicant its First Set of Interrogatories, First Set of Requests for Production of Documents, and First Set of Requests for Admissions. (Declaration of Jill M. Ballo) ("Ballo Decl.") (Exhs. A-C). On the same day, Opposer sent Applicant a Proposed Stipulated Protective Order. (Ballo Decl., ¶ 8 & Exh. G). This order is the same as the one agreed upon in the previous matter between the parties when CDS opposed I.C.E.D.'s original trademark application. (*Id.*). Applicant never signed the protective order or proposed an alternative order protecting confidentiality. (*Id.*).

On January 17, 2003, Applicant served Responses to Opposer's First Sets of Interrogatories, Requests for Production of Documents and Requests for Admissions. (Ballo Decl., Exhs D-F). The responses were incomplete and contained numerous objections. On January 24, 2003, Opposer sent a letter to Applicant concerning the discovery objections and requesting clarification and supplementation of what appeared to be insufficient responses. (Ballo Decl., Exh. H).

The discovery period in this proceeding is set to close tomorrow, February 1, 2003. Because the period for original discovery is about to end, Opposer moves to compel Applicant to fully respond to Opposer's discovery requests.[1]

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[1] Subject to approval by the Board, the parties have agreed to an extension of the discovery and testimony periods as well as the trial date. A motion with consent to extend these dates is filed concurrently herewith.

II. THE BOARD SHOULD ORDER APPLICANT TO FULLY RESPOND TO INTERROGATORIES AND REQUESTS FOR DOCUMENT PRODUCTION

Applicant has failed to meet its obligations under the discovery process. Pursuant to 37 C.F.R. § 2.120(e), Opposer moves the Board to compel complete responses to interrogatories and requests for production of documents. Opposer properly served Applicant with the written discovery requests under 37 C.F.R. § 2.120 and Rules 33 and 34 of the Federal Rules of Civil Procedure. Applicant has a duty to sufficiently answer the discovery requests or demonstrate why it does not have to comply.

A. Applicant's Attempt To Provide Partial Responses Is Inappropriate and Inadequate

Applicant should be compelled to supplement its vague and inadequate partial discovery responses. A party must fully answer Interrogatories and Document Requests unless it objects with specificity. Fed. R. of Civ. P. 33(b) and 34(b). Responses to Interrogatory Nos. 9 and 11-15 contain no objections, yet Applicant fails to provide complete responses in two particulars. First, Applicant does not provide accurate dates for its alleged first use, and second, Applicant fails to describe the manner of such alleged first use. (Exh. D).

These interrogatories request *accurate dates* for first use of THE COPY CLUB mark and a *description* of the manner of such use in Connecticut, Missouri, New Jersey, New York, Pennsylvania and Utah respectively. (Exh. A). These are the states in which Applicant contends that it is entitled to a concurrent use registration of THE COPY CLUB mark based on alleged use before July 7, 1994 (the date on which Opposer filed its application for the COPY CLUB mark). Applicant does not provide a single accurate date. (Exh. D). The responses to Nos. 9 and 11 list "the first quarter of 1993." (*Id.*). Responses to Nos. 14 and 15 are even more vague, identifying first use in "the first half of 1993" and "during 1994." (*Id.*). Responses to Nos. 12

and 13 do not even confirm the year of first use, merely estimating that use began "approximately" in 1993. (*Id.*). These incomplete responses are unacceptable.

Answers to Interrogatory Nos. 9-15 lack adequate descriptions of manner of use. (Exh. D). Each answer refers back to the same boilerplate response offered in Interrogatory No. 2 which gives a comprehensive list of uses named in Applicant's concurrent use application. (Exh. D). Applicant must be more forthcoming. Specifically, Applicant should describe how THE COPY CLUB mark has been used in each state with regard to each good or service claimed in the trademark application (International Classes 035, 040, 041, 042 and U.S. Classes 100, 101, 102, 103, 106 and 107). Applicant cannot simply rely on a blanket statement that may or may not cover the manner of use in each state claimed.

B. Applicant Must Produce Documents Showing Prior Use In Claimed States

Applicant must produce documents showing prior use in the states claimed in its concurrent use application. Applicant has asserted use of its mark prior to Opposer's filing date in the states of Kansas, Missouri, Connecticut, New Jersey, New York, Pennsylvania and Utah, yet it produces no documents showing any use other than in the Kansas City area. (Ballo Decl. ¶ 10). Request Nos. 4-10 seek documents relating to any use by Applicant of THE COPY CLUB mark in the claimed states. (*Id.*, Exh. B). Applicant should be compelled to produce documents showing use in each geographic area or confirm that no such documents exist.[2]

C. Applicant Cannot Limit Responses to Information Only Pertaining to Geographic Areas Claimed In Its Concurrent Use Application

Applicant cannot limit is discovery responses to information related solely to geographic territory claimed in its concurrent use application. For Interrogatory Nos. 6, 7, 8, and 16,

[2] If Applicant cannot provide responsive documents, Opposer is prepared to file a motion for summary judgment for those claims that are without factual support.

Applicant offers responses pertaining only to the seven states listed in its application: Connecticut, Kansas, Missouri, New Jersey, New York, Pennsylvania and Utah. (Exh. D). Applicant refuses to answer with respect to all other states on the grounds that the Interrogatories are over broad, irrelevant, not calculated to lead to discovery of admissible evidence and/or unduly burdensome. (*Id.*).

In a concurrent use proceeding, the applicant has the burden of proving an absence of likelihood of confusion between its mark and a similar mark. 37 C.F.R. § 2.99, TTMP 1107. Thus, confusion between Applicant's proposed mark ("THE COPY CLUB") and Opposer's mark ("COPY CLUB") is highly relevant to this proceeding.

The analysis of confusion should not be limited to the geographic area claimed in a concurrent use application. *Gray v. Daffy Dan's Bargaintown,* 3 U.S.P.Q.2d 1306 (Fed. Cir. 1987). In *Gray,* the Court held that the issue of likelihood of confusion was properly resolved by looking at the actual territorial use of the applicant's mark, not merely the area claimed in his application. *Id* at 1309. In fact, Applicant argued in its Response to Opposer's Motion for Summary Judgment that *Gray* indeed requires analysis of actual territorial use, making it inconceivable that Applicant now refuses to answer discovery with respect to any territory not named in its application. (Ballo Decl., Exh. I).

Applicant repeatedly states that its application only names Kansas, Missouri, Connecticut, New Jersey, New York, Pennsylvania and Utah and fails to provide information about any other areas. (Exh. D). As the Court in *Gray* reasoned, however, "the mere statement by an applicant that a registration is not sought for a particular state of geographic area cannot be equated with a representation that the applicant does not and will not use its mark in the area." *Gray*, 3 U.S.P.Q.2d at 1309. It must be considered relevant, and cannot be considered over

broad, to request nationwide information on the use of Applicant's mark when Opposer has already obtained an unrestricted U.S. trademark registration for a very similar mark. Therefore, Opposer asks the Board to compel the following responses from Applicant:

1. Interrogatory No. 6 Requires a More Complete Response

Interrogatory No. 6 seeks geographic areas where Applicant's customers are or will be located and where Applicant has used or intends to use its mark. (Exh. A). Information pertaining to *all states,* even those not listed in the concurrent use application, must be named due to the possibility of overlapping use of Applicant's and Opposer's marks and the likelihood of confusion of the public. In fact, Applicant has already admitted to advertising its goods and serves through a website that presumably has nationwide reach. (Exh. F). The Internet marketing has the potential to reach customers in all areas of the country, including those areas in which Opposer's current and potential customers are located. More information about Opposer's widespread use of THE COPY CLUB mark must be known to properly analyze the concurrent use application. The Board should compel Applicant to fully address use of its mark in geographic areas anywhere in the United States.

Furthermore, Applicant's response for the geographic areas listed in its application is inadequate. Interrogatory No. 6 requests areas "by state and city" (Exh. A). Applicant does not name a single city in Kansas or Missouri. (Exh. D). Applicant's descriptions of "southern Connecticut," "northeast Pennsylvania.," and the "greater New York City metropolitan area" are entirely too vague. (*Id.*). It is also unacceptable to list entire counties in New Jersey and New York without specifying any cities at all. (*Id.*). The Board should order Applicant to supplement its deficient responses and identify use of THE COPY CLUB mark in all relevant cities.

2. Interrogatory Nos. 7 and 8 Requires a More Complete Response

Interrogatory Nos. 7 and 8 request a list of states where Applicant has used its mark, shipped goods under the mark, or serviced clients under the mark and a corresponding list of clients. (Exh. A). As the *Gray* case holds, analysis of likelihood of confusion should focus on actual use, not merely use in the states listed in an application. *Gray*, 3 U.S.P.Q.2d at 1309. Moreover, Applicant's prior use of THE COPY CLUB mark in territories outside of those for which Applicant seeks a concurrent use registration is relevant to the likelihood of confusion analysis. To allow for proper analysis, Applicant must be compelled to provide information about geographic areas and clients served under THE COPY CLUB mark.

3. Interrogatory No. 16 Requires a More Complete Response

Interrogatory No. 16 seeks information regarding the location of any discontinuance of Applicant's mark since initial use. (Exh. A). Once again, Applicant only provides information related to the states listed in its concurrent use application. (Exh. D). Discontinuance is relevant to this matter because if Applicant has in the past used THE COPY CLUB mark in territories outside of the areas in which Applicant now seeks a concurrent use registration, such use could lead to confusion now or in the future. The Board should compel Applicant to address discontinuance of its mark anywhere in the United States.

D. Applicant Cannot Avoid Disclosing Relevant Facts By Claiming That The Facts Are "Legal Conclusions"

The Board should compel Applicant to provide relevant facts requested in Opposer's discovery requests. Interrogatory Nos. 22 and 27 and Document Request No. 23 seek the factual basis for contentions on which ***Applicant*** bears the burden of proof. Specifically, Interrogatory No. 22 seeks the factual basis for Applicant's contention that there is no likelihood of confusion when THE COPY CLUB and COPY CLUB marks are used to promote identical services. (Ballo Decl., Exh. A). Interrogatory No. 27 seeks the factual basis for Applicant's affirmative defenses.

(*Id*). Both interrogatories also request the names of persons knowledgeable of the facts. (*Id.*). Production Request No. 23 seeks documents related to Applicant's contention that there is no likelihood of confusion. (*Id.*, Exh. B).

Applicant objects to these discovery requests on the grounds that they call for "legal conclusions." Applicant's objections are not well-taken for at least two reasons. First, Applicant bears the burden of proof of demonstrating that a concurrent use would not create a likelihood of confusion and of demonstrating that it should prevail on its affirmative defenses. Second, the requests by their clear language seek only the "***factual basis***" for Applicant's contentions. (Exhs. D, E).

Discovery requests may properly inquire into a party's contentions in a case and the factual basis therefore. *See Continental Illinois Nat'l Bank v. Caton,* 136 F.D.R. 682, 685 (D. Kan. 1991); *Cable & Computer Technology, Inc. v. Lockheed Saunders, Inc.,* 175 F.R.D. 646, 651-652 (C.D. Cal. 1997). Facts and names are accepted avenues for discovery. In addition, Applicant has already admitted at least one instance of actual confusion in its Answer to Opposer's Notice of Opposition. (Ballo Decl., Exh. J at 4). Applicant should not be allowed to hide behind an improper objection and claim that likelihood of confusion is now solely an issue of law. The Board should compel disclosure of the relevant and discoverable facts and documents.

E. Applicant's Claims Of Attorney-Client Privilege And Confidentiality Are Insufficient

A party may claim attorney-client privilege if a confidential communication is made with the purpose of seeking or giving legal advice. *Upjohn Co.* v. *United States,* 449 U.S. 383, 389 (1981); *Better Gov't Bureau Inc. v. McGraw,* 106 F.3d 582 (4th Cir. 1997). A party claiming privilege must describe the nature of the documents withheld sufficiently enough to enable the

opponent to determine applicability of the privilege. Fed. R. of Civ. P. 26(b)(5).

Applicant objects to responding to Document Request Nos. 17, 18, 19, 20 and 29 on the basis of attorney-client privilege and refuses to produce relevant documents or claims that no documents exist. (Ballo Decl., Exh. E). Applicant does not produce a privilege log or meet the standard cited above. Applicant's responses show a complete failure to describe the nature of documents with any specificity to allow either the Board or Opposer to determine whether they were created in the context of giving legal advice. (*Id.*). The Board should compel Applicant to state the nature of its allegedly privileged documents so the privilege claim can be legitimately determined.

Applicant also contends that Requests Nos. 17 and 18 seek "confidential" information and Interrogatory No. 8 calls for "confidential or proprietary" information. (Ballo Decl., Exh. D, E). It is unclear exactly what kind of confidentiality is contemplated. To the extent that Applicant believes Opposer is seeking confidential business information, there is no absolute privilege that allows a party to withhold the information. *Federal Open Market Committee v. Merril,* 443 U.S. 340, 362 (1979). Under Rule 26(c)(7) of the Federal Rules of Civil Procedure, parties may seek a protective order governing disclosure of relevant confidential business information. TBMP Rule 416.02 allows parties to stipulate to a protective order of their design.

Opposer proposed a stipulated protective order more than seven weeks ago. (Ballo Decl., ¶ 8 & Exh. G). The order is identical to the one agreed upon by both parties in their prior proceeding (Opposition No. 102,651). (*Id.*). However, Opposer has not signed or even responded to the current proposed protective order. (*Id.*). The Board should not allow Applicant to withhold allegedly confidential business information because Applicant has failed for nearly two months to complete a protective order.

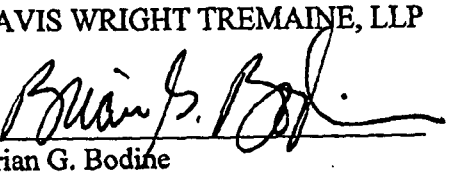
III. CONCLUSION

For the foregoing reasons, Opposer respectfully requests that Applicant be compelled to fully respond to Opposer's outstanding discovery requests.

DATED this 31st day of January, 2003.

Respectfully submitted,

DAVIS WRIGHT TREMAINE, LLP



Brian G. Bodine
Jill M. Ballo
2600 Century Square
1501 Fourth Avenue
Seattle, WA 98101-1688
(206) 622-3150
FAX: (206) 628-7699

Attorney for Opposer
I.C.E.D. Management, Inc.

cc: Stephen M. Gracey
Michael Golden
George C. Rondeau, Esq.
Jill M. Ballo, Esq.

Encl.: Postcard
Certificate of Service

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **MOTION TO COMPEL DISCOVERY RESPONSES AND MEMORANDUM IN SUPPORT OF OPPOSER'S MOTION TO COMPEL** was served on counsel for Applicant this 31st day of January, 2003, by first-class mail, U.S postage prepaid, in an envelope addressed to:

Dianne M. Smith-Misemer
SPENCER FANE BRITT & BROWNE
1000 Walnut Street, Suite 1400
Kansas City, MO 64106-2140

Jill Ballo

Jill M. Ballo

Exhibit A

I hereby certify that on the date specified below, this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to Commissioner of Patents and Trademarks, Washington D.C. 200231.

JANUARY 31, 2003
Date

Jill Ballo
Jill M. Ballo

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

I.C.E.D. Management, Inc., Opposer, v. CDS, Incorporated, Applicant.	Trademark Opposition No. 121,374 Concurrent Use No. 1250 Docket No. 59320-4

Asst. Commissioner of Trademarks
Clerk of the Trademark Trial and Appeal Board
Box TTAB/No Fee
2900 Crystal Drive
Arlington, VA 22202-3513

DECLARATION OF JILL M. BALLO
IN SUPPORT OF
OPPOSER'S MOTION TO COMPEL DISCOVERY RESPONSES

I, Jill M. Ballo, hereby declare and state that:

1. I am an attorney with Davis Wright Tremaine, LLP, which represents Opposer I.C.E.D. Management, Inc. ("Opposer") in this matter. I submit this declaration in support of Opposer's Motion to Compel Discovery Responses. I have personal knowledge of the following facts except where the context indicates otherwise:

2. Attached hereto as Exhibit A is a true and correct copy of Opposer's First Set of Interrogatories served on Applicant on or about December 10, 2002.

3. Attached hereto as Exhibit B is a true and correct copy of Opposer's First Set of Requests for Production of Documents served on Applicant on or about December 10, 2002.

4. Attached hereto as Exhibit C is a true and correct copy of Opposer's First Set of Requests for Admission to CDS, Incorporated served on Applicant December 10, 2002.

5. Attached hereto as Exhibit D is a true and correct copy of Applicant's Responses to Opposer's First Set of Interrogatories served on Opposer on or about January 17, 2003.

6. Attached hereto as Exhibit E is a true and correct copy of Applicant's Responses to Opposer's First Set of Requests for Production of Documents served on Opposer on or about January 17, 2003.

7. Attached hereto as Exhibit F is a true and correct copy of Applicant's Responses to Opposer's First Set of Requests for Admission served on Opposer on or about January 17, 2003.

8. Attached hereto as Exhibit G is a true and correct copy of a letter and Proposed Stipulated Protective Order I sent to Applicant on or about December 10, 2002. This proposed order is the same as the order agreed upon in the previous matter between the parties, where CDS opposed I.C.E.D.'s original trademark application (Opposition No. 102,651). Opposer has never received the proposed order back from Applicant. Nor has Applicant suggested an alternative protective order.

9. Attached hereto as Exhibit H is a true and correct copy of a letter I faxed to Applicant's counsel on January 24, 2003 addressing concerns about Applicant's discovery responses and asking for supplementation of incomplete responses.

10. I have reviewed the documents produced by Applicant relating to alleged first use of its mark in the states claimed in the concurrent use application. There does not appear to be any documentary evidence showing use in any area other than the Kansas City region.

11. Attached hereto as Exhibit I is a true and correct copy of Applicant's Response to Opposer's Motion for Summary Judgment served on Opposer on or about April 23, 2001.

12. Attached hereto as Exhibit J is a true and correct copy of Applicant's Answer to Notice of Opposition served on Opposer on or about January 24, 2001.

I declare under penalty of perjury under the laws of the State of Washington that the foregoing is true and correct.

DATED this 31st day of January, 2003, at Seattle, Washington.

Jill Ballo

Jill M. Ballo

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Declaration of Jill M. Ballo in Support of Opposer's Motion to Compel Discovery Responses was served on counsel for Applicant this 31st day of January, 2003, by first-class mail, U.S postage prepaid, in an envelope addressed to:

Dianne M. Smith-Misemer
SPENCER FANE BRITT & BROWNE
1000 Walnut Street, Suite 1400
Kansas City, MO 64106-2140

Jill Ballo
Jill M. Ballo