

ESTTA Tracking number: **ESTTA287085**

Filing date: **06/01/2009**

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

Proceeding	91177921
Party	Defendant Fashion World Limited
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Date	06/01/2009
Attachments	91177921_Public_Reply_Brief.pdf (47 pages)(1598447 bytes)

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

Valentino S.p.A.	Opposer,	Opposition Number: 91177921 (consolidated case) 91182713
v.		Serial Number: 78/497,040 77/006,996
Fashion World Limited	Applicant.	Trademark: F BY FORTUNAVALENTINO (Stylized) in Classes 18 and 25

**APPLICANT’S REPLY BRIEF IN SUPPORT OF ITS
MOTION TO COMPEL DISCOVERY FROM OPPOSER**

Applicant, Fashion World Limited, offers this Brief in Reply to Opposer’s Opposition to Applicant’s Motion to Compel Discovery from Opposer. Applicant recognizes that the Board may exercise discretion as to whether it considers a reply brief. Applicant, therefore, desires to highlight key deficiencies in Opposer’s Opposition to Applicant’s Motion to Compel Discovery (“Opposer’s Opp.”).

I. Opposer does not dispute that documents from Opposer’s former counsel’s files are missing.

Opposer’s factual allegations in its Opposition Brief do not refute Applicant’s charges and, in any event, are wholly unsupported by competent evidence.

Opposer has prosecuted an enforcement campaign for several decades. The TTABVUE database indicates that since 1985, Opposer and its related entities have instituted proceedings against at least fifty-five applications or registrations for marks containing the name Valentino and similar names, such as Valentina and Valentine. Ex. 1 to Declaration of Benjamin T. Hickman, accompanying Applicant’s Motion to Compel (“Applicant’s Mot.”). Opposer’s current counsel did not begin representing Opposer until June 2002. Opposer’s Opp. at 1. Search results from TTABVUE and the Federal Courts’ PACER database indicate that at least

five law firms other than Opposer's current counsel have represented Opposer or its related entities before the Board and United States District Courts since 1985. Exs. 1-3 to Second Declaration of Benjamin T. Hickman ("Second Hickman Decl."), accompanying this Reply Brief.

When Opposer responded to Applicant's discovery requests about third-party enforcement, Opposer had a duty to search for materials in the possession of its former counsel. "Under Fed. R. Civ. P. 34, which governs the production of documents during discovery, the clear rule is that documents in the possession of a party's *current or former* counsel are deemed to be within that party's 'possession, custody and control.'" *MTB Bank v. Federal Armored Express*, 1998 U.S. Dist. LEXIS 922, at *12 (S.D.N.Y. 1998) (emphasis in original). *See also Variable-Parameter Fixture Dev. Corp. v. Morpheus Lights, Inc.*, 1994 U.S. Dist. LEXIS 11185, at *17 n.15 (S.D.N.Y. 1994) (rejecting a party's claim that documents were not in its possession, custody, or control because the documents were in the possession of former counsel).

Notwithstanding Opposer's duty to conduct a full search for documents, Opposer produced little evidence of third-party enforcement. Out of more than 3,000 pages of documents, Opposer produced one settlement agreement with a third party; one consent judgment; and zero coexistence agreements, letters of consent, cease and desist letters, and trademark watches. Second Hickman Decl. ¶ 8.

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Id. ¶ 9. Opposer cannot plausibly claim that it can produce no more evidence of third-party enforcement—including evidence from its former counsels' files—when Opposer commenced an enforcement campaign more than a decade before current counsel began representing Opposer.

Opposer had an opportunity to explain this implausibility in its Opposition Brief. Not only did Opposer decline to explain why it produced so little evidence of third-party enforcement, Opposer wholly failed to refute Applicant's claim that documents are missing. Opposer, instead, claimed that its current counsel is ignorant as to what kinds of documents might have been found in Opposer's former counsel's files:

The undersigned explained [in her telephone call with Applicant's counsel] that Valentino has produced everything in the files, but admitted that we cannot know about every document in every attorney's files over the years. The undersigned never admitted that she knew that documents relating to third-parties were in fact missing.

Opposer's Opp. at 2 (emphasis in original). Opposer did not refute Applicant's claim that documents are missing. Opposer attempted to wash its hands of the problem by claiming that it does not know the identity of documents that it allowed to go missing. *Id.* In the face of Applicant's allegations, Opposer conceded the core fact that gave rise to the Motion to Compel.

In any event, the Board should afford no weight to the facts Opposer alleged in its Opposition Brief. Opposer failed to append a declaration or affidavit in support its factual allegations to its Opposition Brief. Factual allegations in a discovery motion or a response to a discovery motion must be supported by competent evidence. *See, e.g., Kiobel v. Royal Dutch Petroleum Corp.*, 2005 U.S. Dist. LEXIS 16514, at *16 (S.D.N.Y. 2005) (court refused to recognize a party's claim of attorney-client privilege where affidavits provided no factual information to support the claim of privilege). Here, the Opposition Brief references a declaration made by Opposer's counsel. Opposer's Opp. at 1-3. TTABVUE, however, indicates that no declaration was appended to the Brief. The service copy that Applicant's counsel received from Opposer's counsel contains no declaration. Second Hickman Decl. ¶ 10. The Opposition Brief is wholly unsupported by competent evidence.

II. Opposer's duty to preserve evidence began no later than the date when Opposer sent the April 6, 1998 cease and desist letter.

Opposer claims that the April 6, 1998 cease and desist letter did not trigger a duty to preserve evidence. *See* Opposer's Opp. at 3-4. Opposer is urging the Board to apply a rule that does not trigger the duty to preserve evidence until a dispute arises that involves the same parties and marks that become the subjects of litigation. *Id.* Even then, according to Opposer, a party would not be required to preserve evidence relevant to "use" of a mark if the dispute only concerns "registerability." *Id.* Opposer's rule directly conflicts with those set forth by the Courts, as demonstrated by the cases Applicant cited in its Motion to Compel. Applicant's Mot. at 7-8. Opposer made no attempt to refute or distinguish those cases. Opposer's Opp. at 3-4.

General knowledge that some type of litigation will ensue is sufficient to trigger the duty to preserve. *Rambus, Inc. v. Infineon Technologies AG*, 220 F.R.D. 264, 287 n.30 (E.D. Va. Mar. 17, 2004). In *Rambus*, the plaintiff brought patent infringement actions against an assortment of defendants, seeking to extract royalties based on patents it held for random access memory (RAM) technology. Defendant charged that plaintiff destroyed relevant documents in its possession at a time when plaintiff was planning a general litigation strategy against a number of potential defendants, but before plaintiff filed suit against defendant in the subject case. Plaintiff attempted to argue that the court could not find spoliation occurred unless the court found that plaintiff reasonably anticipated litigation with the particular defendant claiming spoliation in the subject case. *Id.* at 287. The court rejected plaintiff's argument. "[Plaintiff] clearly anticipated some type of litigation at the point it destroyed documents. . . . [I]t just stands as a matter of logic that if a company is on notice that litigation is likely to ensue, that the company will realize, at least on a broad level, who the anticipated litigation will involve." *Id.*

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