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

Proceeding	91180471
Party	Plaintiff Marc Vianello
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Submission	Motion to Compel Discovery
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Attachments	Motion and Brief to Compel Discovery.pdf (7 pages)(22519 bytes) Exhibit A_motion to Compel.pdf (26 pages)(1161249 bytes) Exhibit B_motion to Compel.pdf (3 pages)(716997 bytes) Exhibit C_motion to Compel.pdf (1 page)(312364 bytes) Exhibit D_motion to Compel.pdf (4 pages)(1475582 bytes) Exhibit E_motion to Compel.pdf (3 pages)(1008946 bytes) Exhibit F_motion to Compel.pdf (3 pages)(323415 bytes)

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

Marc Vianello)
)
 Opposer,)
)
 v.) Opposition No.:91180471
)
 Sandra Nudelman)
)
 Applicant.)

OPPOSER’S COMBINED MOTION TO COMPEL
AND MOTION TO EXTEND DISCOVERY AND TRIAL DATES

Pursuant to Rules 26 and 37 of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice, Opposer Marc Vianello (“Opposer”) respectfully moves the Board for an order compelling Applicant Sandra Nudelman (“Applicant”) to make herself available to Opposer’s Deposition Request without objections.

In addition, Opposer requests an extension of the discovery period for the limited purpose of allowing Opposer (and not Applicant) time to consider Applicant’s deposition testimony as ordered by the Board, and to pursue follow-up discovery if necessary.

Such an order is appropriate because Applicant failed entirely to respond to Opposer’s Interrogatories and Document Requests prior to the Discovery cut-off date and Applicant failed to make herself available for the scheduled Deposition and has since stated that she will not comply with Opposer’s deposition request. Counsel for Opposer has made good faith efforts to resolve the issues with Applicant but, to date, such efforts have been unsuccessful.

I. BACKGROUND

On October 31, 2007, Opposer filed a Notice of Opposition against Application Serial No. 77/110,266 for Ms. Nudelman's mark for "background investigation and research services" and "legal services." Opposer asserts, among other things, that it owns the distinctive marks shown in Serial Nos. 77/031,981, 77/212,172, ("the Vianello Marks") for various electronic and print publication needs¹. Opposer also asserts that he has extensively used and promoted the Vianello marks in the United States since at least as early as September 1, 2007 (Not. of Opp. ¶¶ 2-5), well prior to the date of Applicant's use of Applicant's mark which was filed as an Intent to Use and no Statement of Use has been entered. As grounds for the opposition, Opposer alleges priority of use and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C § 1052(d) and dilution under Section 43(c) of the Trademark Act 15 U.S.C. § 1125(c). (Not. of Opp. ¶¶ 6-8).

¹ THE JUDICIAL VIEW, U.S. Application Serial No. 77/031,981, filed October 30, 2006, in international class 041 for "publication of an online legal newspaper," and THE JUDICIAL VIEW, U.S. Application Serial No, 77/212,172, filed June 21, 2007, in international class 038 for "providing e-mail notification alerts of recent court decisions to others" and in international class 041 for "providing on-line publications in the nature of newspapers, newsletters, magazines, and articles in the field of law, classified advertising, display and text advertising, law review, legal case summaries, feature articles, current events, civil rights, finance and banking, communications, immigration, education, politics, administrative law, agriculture, intellectual property, antitrust, bankruptcy, civil procedure, civil remedies, commercial contracts, computer and technology, conflicts at law, constitutional law, criminal justice, corporate and shareholder law, employment law, energy and utilities, environmental law, expert witness, family law, health, immigration, international law, lost profits, maritime and marine, military, products liability, professional malpractice, real and personal property, securities law, federal, state and local taxation, torts and personal injury, veterans, wills, trusts and estates, sports, entertainment, art, government, insurance, transportation, business valuation, alternative dispute resolution and legal matters; on-line journals, namely, blogs featuring information on recent court decisions, current events, civil rights, finance and banking, communications, immigration, education, politics, administrative law, agriculture, intellectual property, antitrust, bankruptcy, civil procedure, civil remedies, commercial contracts, computer and technology, conflicts at law, constitutional law, criminal justice, corporate and shareholder law, employment law, energy and utilities, environmental law, expert witness, family law, health, immigration, international law, lost profits, maritime and marine, military, products liability, professional malpractice, real and personal property, securities law, federal, state and local taxation, torts and personal injury, veterans, wills, trusts and estates, sports, entertainment, art, government, insurance, transportation, business valuation, alternative dispute resolution and legal matters."

On October 31, 2007, the Board instituted this proceeding and set discovery to open on November 20, 2007, and to close on May 18, 2008. Applicant's Answer to the Notice of Opposition was due December 10, 2007.

On December 10, 2007, Applicant filed an answer denying the essential allegations in the Notice of Opposition. On April 14, 2008, Opposer served the Applicant with Opposer's First Request for the Production of Documents and Opposer's First Set of Interrogatories to Applicant. (Copies of these Requests are attached as Exhibit A.) Responses to Opposer's discovery requests were due May 14, 2008. On April 19, 2008 Opposer served Applicant with Opposer's Request for Deposition (copy of which is attached as Exhibit B). This deposition was scheduled to be conducted in Brooklyn, NY on May 15, 2008 near Applicant's address in the city of Applicant's residence as listed with the TTAB.

Opposer's requests were all served on Applicant within the time permitted by 37 CFR § 2.120(a) and were in compliance with all applicable discovery rules. The deposition was noticed in compliance with Fed. R. Civ. P. 30(b) and 37 CFR § 2.120(a). The deposition was scheduled to be completed at an appropriate venue in accordance with 37 CFR § 2.120(b) based on Applicant's residential address contained in the record.

On May 7, 2008, after a phone call by Opposer on May 6 confirming receipt of said notices, Applicant sent Opposer notice via fax (attached as Exhibit C) indicating that Applicant needed to reschedule the deposition because she was unavailable. In addition, she notified Applicant that it would be more convenient if Opposer would send future communications to Applicant's home address, which was different from that listed with the TTAB.

More than ten days after a response was due, On May 27, 2008, Applicant sent Opposer's attorney a letter refusing to provide discovery (attached as Exhibit D). In the letter, Applicant stated that Opposer's discovery demands were premature and improper because "Opposer never attempted, in good faith, to hold required Discovery Plan Conference or work out a Discovery schedule with the Applicant...prior to initiating Discovery demands..." In addition, Applicant stated that because leave of court was not obtained prior to Opposer's "unilateral discovery demands" and because Opposer made no attempt to schedule or hold a Discovery Plan Conference, Opposer had waived any right to further Discovery.

Opposer then responded via First Class Mail on May 27, 2008 (attached as Exhibit E) to Applicant's May 27, 2008 letter demanding compliance with Opposer's Discovery Requests, referring Applicant to the relevant rules and suggesting she obtain counsel. Specifically, Opposer requested compliance by (1) producing documents responsive to Opposer's request for production, (2) providing written responses to Opposer's interrogatories, and (3) rescheduling her deposition.

On June 2, 2008, via facsimile, Applicant provided written responses to Opposer's First Set of Document Requests and Interrogatories. However, Applicant has still refused to comply with Opposer's Deposition request as stated in her June 2, 2008 transmittal letter (attached as Exhibit F).

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