

AMAZON.T.008M

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

AMAZON TECHNOLOGIES, INC.,

Opposer,

v.

JEFFREY S. WAX & STEVEN M. FREELAND,

Applicants.

Opposition No.: 91187118

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I hereby certify that this correspondence and all listed attachments are addressed to Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451, and are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service on

July 20, 2009

(Date)



Susan M. Natland

AMAZON TECHNOLOGIES, INC.'SRESPONSE TO APPLICANTS' MOTION TO COMPEL

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451



07-22-2009

Dear Sir or Madam:

U.S. Patent & Trademark Mail Rept. D. #30

Amazon Technologies, Inc. ("Amazon") hereby responds to Applicants' Motion to Compel. In Jeffrey S. Wax and Steven M. Freeland's ("Applicants") Motion to Compel, Applicants move, pursuant to Rule 523.01 of the U.S. Trademark Trial and Appeal Board and 37 CFR § 2.120(e), for an order compelling Amazon's substantive responses to Interrogatories Nos. 1-29, Requests for Admissions Nos. 1-91, and Requests for Production of Documents and Things Nos. 1-51.¹

¹ Moreover, on July 17, 2009 (two days before the deadline for Amazon to respond to Applicants' Motion to Compel), Applicant filed a document entitled "Exhibits I And J To Be Considered With Applicant's Motion To Compel Opposer's Substantive Responses To Discovery" (the "Supplemental Motion"). The Supplemental Motion attached Amazon's First Set of Interrogatories, Nos. 1-37 and Amazon's First set of Requests for Production of Documents and Things, Nos. 1-76 and set forth some additional arguments. As a preliminary matter, Amazon notes that the Supplemental Motion is irrelevant and untimely. As such, it should be stricken. If the Board considers Applicants' Supplemental Motion, Amazon notes that, as mentioned below, Applicants have refused to properly respond to many of Amazon's Discovery Requests. Further, while Applicants allege that they requested electronic copies of these discovery requests from Amazon, the email making such a request was sent at **6:05 p.m. on July 16, 2009**. Thus, Amazon did not even have time to respond to this email before Applicants filed their Supplemental Motion. In any event, the request to Amazon for electronic copies of these discovery requests was made seventeen (17) days after Applicants filed Applicants' Motion to Compel. Further, whether Amazon provided Applicants with electronic copies of the discovery requests or Applicants made their own electronic copies, the

Specifically, in Applicants' Motion to Compel, Applicants allege that "[o]n May 12, 2009, Applicant served upon Opposer Interrogatories Nos. 1-29, Requests for Admissions Nos. 1-91, and Requests for Production of Documents and Things Nos. 1-51" (collectively, "Applicants' Discovery Requests") and that Amazon failed to substantively respond to Applicants' Discovery Requests. While Applicants are correct that on May 12, 2009, Applicants mailed Applicants' Discovery Requests to counsel for Amazon, pursuant to 37 CFR § 2.120(a)(3), "[a] party must make its initial disclosures **prior to seeking discovery**, absent modification of this requirement by a stipulation of the parties approved by the Board, or a motion granted by the Board, or by order of the Board." (Emphasis added).²

However, to date, Applicants have not served their Initial Disclosures. Due to Applicants' failure to serve their Initial Disclosures, Applicants have not complied with 37 CFR § 2.120(a)(3). Accordingly, Applicants were not (and are not) entitled to serve any discovery requests.³ Amazon notes that in its objections to Applicants' Discovery Requests, Amazon stated that it was exempt from responding (at this time), due to Applicants' failure to comply with the applicable rules.⁴

As Applicants were not entitled to serve any discovery requests, Amazon respectfully requests that the Trademark Trial and Appeal Board (the "Board") issue an order denying Applicants' Motion to Compel in its entirety, including, an order denying Applicants' (1) request that they be given additional time to conduct follow-up discovery, (2) request that Amazon be ordered to provide substantive responses and production to Applicants' Discovery Requests; (3) request for an order extending discovery solely for the benefit of Applicants; and (4) motion for sanctions.

Amazon notes that, in making this request, Applicants have failed to show that good cause exists for providing Applicants with any additional time to send additional or follow-up discovery requests or take any discovery depositions. See T.M.B.P. 509.01. In fact, Amazon notes that Applicants' Motion to Compel was filed only one (1) day before the discovery period closed.⁵ Thus, Applicants' failure to have

² As is the standard practice of the Board, the January 31, 2009 deadline for the parties to serve Initial Disclosures was set forth in the October 23, 2008 Trial Order.

³ Amazon notes that the parties did not agree to waive Initial Disclosures and that Amazon's Initial Disclosures were properly served on January 30, 2009. Moreover, Applicants did not motion the Board for an order waiving Initial Disclosures. Amazon further notes that Applicant, Jeffrey Wax, a licensed member of the California Bar, indicates on his website that his legal practice areas include representation in trademark oppositions (See Exhibit A). As such, Mr. Wax was obviously well aware of 37 CFR § 2.120(a)(3), which applies to all opposition proceedings commenced on or after November 1, 2007.

⁴ As is discussed in Applicants' Motion to Compel, in Amazon's June 25, 2009 letter, Amazon once again advised Applicants that Amazon was not obligated to provide substantive responses to Applicants' Discovery Requests.

⁵ In Applicants' Motion to Compel, Applicants argue that they are entitled to additional time to propound "follow-up"

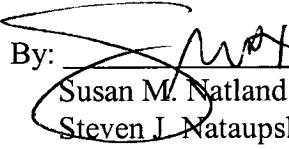
sufficient time to take "follow-up discovery" (or even any discovery, since, to date, Applicants have not properly served any discovery), is due to Applicants' own lack of diligence. See Luehrmann v. Kwik Kopy Corp., 2 USPQ2d 1303 (T.T.A.B. 1987) (desire to conduct follow-up discovery is not good cause for extension of discovery period where party seeking extension did not serve initial discovery requests until late in discovery period).

In light of the foregoing, Amazon respectfully requests that the Board deny Applicants' Motion and reset the Scheduling Order to provide Applicants with the same period of time it had under the prior order, namely, one (1) day remaining in the discovery period.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: July 20, 2009

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have, however, failed to mention that they failed to properly respond to many of Amazon's Discovery Requests. Amazon is

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **AMAZON TECHNOLOGIES, INC.'S RESPONSE TO APPLICANTS' MOTION TO COMPEL** upon Applicants' correspondent of record by depositing one copy thereof in the United States Mail, first class postage prepaid and by depositing one copy thereof in the United States Mail, Certified Mail on July 20, 2009, upon counsel for Steven M. Freeland, upon Jeffrey S. Wax, as well as Applicants' correspondence of record as follows:

Jeffrey S. Wax
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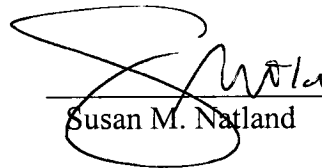

Susan M. Natland

EXHIBIT A

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