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

Proceeding	91196923
Party	Defendant Truck-Lite Co., LLC
Correspondence Address	CARL A HJORT III THE BILICKI LAW FIRM PC 1285 N MAIN ST JAMESTOWN, NY 14701-2157 UNITED STATES docadm@bilickilaw.com, cahjort@bilickilaw.com
Submission	Opposition/Response to Motion
Filer's Name	Carl A. Hjort, III
Filer's e-mail	cahjort@bilickilaw.com, babilicki@bilickilaw.com, mkpeterson@bilickilaw.com
Signature	/CAH/
Date	10/31/2013
Attachments	Reply to discovery motion clean.pdf(50981 bytes)

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

In the Matter of Miscellaneous Design (arrangement of LED's)

Application No.: 77/618,319

Published for Opposition: June 8, 2010

_____)	
Grote Industries, Inc.,)	
)	
Opposer,)	
)	Opposition No.: 91196923
v.)	
)	
Truck-Lite Co., LLC,)	
f/k/a Truck-Lite Co., Inc.)	
)	
Applicant.)	
_____)	

In the Matter of: Miscellaneous Design (stop-turn-tail lamp)

U.S. Trademark Registration No.: 3,483,147

Registered: August 12, 2008

_____)	
Grote Industries, Inc.)	
)	
Petitioner,)	
)	
v.)	Cancellation No.: 92053498
)	
Truck-Lite Co., LLC)	
f/k/a Truck-Lite Co., Inc.)	
)	
Registrant.)	
_____)	

**APPLICANT/REGISTRANT TRUCK-LITE CO., LLC'S RESPONSE TO THE
OPPOSER/PETITIONER'S RULE 56(d) MOTION FOR DISCOVERY**

Applicant/Registrant Truck-Lite Co., LLC ("Truck-Lite"), through its undersigned attorneys,
hereby submits the following response to Opposer/Petitioner Grote Industries, Inc.'s ("Grote") Rule 56(d)
Motion for Discovery.

I. Grote's Motion Is Deficient Because It Does Not Meet the Requirements of 37 C.F.R § 2.127(a)

As an initial matter, Truck-Lite submits that Grote's motion is fatally defective, because it fails to comply with the requirements of 37 C.F.R. § 2.127(a). Grote's motion fails to present even a single citation to any relevant law in support of the positions advanced therein. Because Grote's motion provides no legal support for any of the positions taken therein, the motion is defective and should be denied.

The contents of motions submitted to the Board are governed by 37 C.F.R. §2.127(a), which requires: “[e]very motion must be submitted in written form and must meet the requirements prescribed in § 2.126. It shall contain a full statement of the grounds, and shall embody or be accompanied by a brief.” 37 C.F.R. § 2.127(a)(emphasis added); *See also Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1720 n.3 (TTAB 1989) (“The presentation of one's arguments and authority should be presented thoroughly in the motion or the opposition brief thereto”).

Grote's three (3) page motion utterly fails to present any authority for any of the positions advanced in the motion. Not a single case is cited in the motion. In view of this complete lack of legal support for any of positions advanced in the motion, it is clear that the motion does not provide a “full statement of the grounds” for the relief it requests; and, therefore it does not meet the requirements of 37 C.F.R. § 2.127(a). On this procedural ground alone, Grote's Rule 56(d) motion should be denied. On substantive grounds, it is clear that Grote is not entitled to the discovery sought, because Truck-Lite has not waived the attorney-client privilege in this case.

II. Truck-Lite Has Not Waived the Attorney-Client Privilege, Therefore Any Discovery Relative to Attorney-Client Privileged Communications is Inappropriate.

Contrary to Grote's unsupported arguments, Truck-Lite has not waived the attorney-client privilege in this case. All that Truck-Lite has done in filing the instant Motion for Summary Judgment is allege that certain statements were made "with the advice of counsel." Critically, Truck-Lite has not disclosed the contents of any of the advice of counsel that it received. It has long been recognized that revealing a general topic of discussion between attorney and client does not waive attorney-client privilege, unless that revelation also reveals the substance of a protected communication. Truck-Lite has not revealed the substance of any protected communication, and consequently has not waived the attorney-client privilege in this case.

In *New Jersey v. Sprint Corp.*, 258 F.R.D. 421 (D.Kan. 2009), the court held that a director's deposition testimony did not waive attorney-client privilege with respect to advice received from counsel concerning tax shelter issues, even though the director testified to some of the advice received and stated that legal counsel gave advice. The court came to this conclusion because the director's statement in his deposition that the board of directors received legal advice did not waive attorney-client privilege to that legal advice, because the director did not reveal substance of the protected communications. *Id.*

Similarly, in *Quiksilver, Inc. v. Kymsta Corp.*, 247 F.R.D. 579 (C.D.Cal. 2007), a manufacturer's chief executive officer did not waive the company's attorney-client privilege during his deposition by disclosing the manufacturer's strategy in using and registering a composite trademark first and separately from another mark by itself. Again, the court held that since the deposition answer did not reveal the substance of any attorney-client communications, but simply noted that CEO *received legal advice* regarding the brand as part of broader

discussion of commercial strategy, there was no waiver of the attorney-client privilege. *Id.* This conclusion was reinforced by the fact that the competitor seeking to pierce the attorney-client privilege cited no pertinent authority to support the proposition that manufacturer waived the privilege. *Id.* In *Quiksilver*, the court noted that the focal point of attorney-client privilege waiver analysis should be the holder's disclosure of privileged communications to someone outside the attorney-client relationship, not the holder's intent to waive the privilege. *Quiksilver, Inc. v. Kymsta Corp.*, 247 F.R.D. 579 (C.D.Cal. 2007).

In *Allstate Ins. Co. v. Levesque*, 263 F.R.D. 663 (M.D.Fla. 2010) the court held that a defendant in a personal injury suit did not waive the attorney-client privilege regarding his communications with his personal attorney, when the defendant did not disclose any specific details of the substance of his communications with his personal attorney. The mere fact that the defendant testified, in subsequent declaratory judgment action, about the facts concerning his consultation with his personal attorney, did not constitute a waiver of the privilege under the sword and shield doctrine. *Id.* Because the details of the substance of the communication between the defendant and his personal attorney were not disclosed, there was no waiver of the attorney-client privilege. *Allstate Ins. Co. v. Levesque*, 263 F.R.D. 663 (M.D.Fla. 2010).

The case of *Safeco Ins. Co. of America v. Vecsey*, 259 F.R.D. 23 (D.Conn. 2009) also demonstrates that Truck-Lite has not waived the attorney-client privilege in this case; and, that Grote is not entitled to discover any of Truck-Lite's attorney-client privileged communications. The *Safeco* Court held that merely because the attorney-client privileged communications are relevant does not place them "at issue," so as to implicitly waive attorney-client privilege. The *Safeco* Court further held that when privileged communications are not at issue, the opposing party cannot destroy the privilege by merely claiming a need for the documents. *Id.* Many other

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