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

Proceeding	91217666
Party	Defendant Summit Entertainment, LLC
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Date	12/01/2015
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Docket No. 22HF-202718

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

In re Matter of Application Nos. 86/071,240, 86/071,241, 86/071,242, 86/071,243, 86/071,244, 86/071,245, 86/071,246, 86/071,247, 86/071,248, 86/071, 249 for the trademarks  in Classes 9, 14,16, 18, 20, 21, 24, 25, 26 & 28 TBL Licensing LLC, Opposer, vs. Summit Entertainment, LLC, Applicant.	Opposition Nos. 91-217666, 91-217706 **APPLICANT SUMMIT ENTERTAINMENT, LLC'S REPLY BRIEF IN SUPPORT OF ITS MOTIONS TO COMPEL OPPOSER TBL LICENSING, LLC'S SUPPLEMENTATION OF CERTAIN OF ITS DISCOVERY RESPONSES AND TO TEST THE SUFFICIENCY OF CERTAIN OF ITS RESPONSES TO REQUESTS FOR ADMISSION**

I. INTRODUCTION

In two consolidated proceedings, Opposer TBL Licensing LLC ("Opposer") has opposed **ten** of Applicant Summit Entertainment, LLC's ("Applicant") applications – each in a different International Class – to register its design mark at issue. Likewise, Opposer has asserted **nine** trademark registrations in various classes in support of its consolidated notices of opposition. It is therefore Opposer who has set the scope of this consolidated proceeding – which by definition is quite broad as a result. Applicant's discovery requests are clearly proportional to the number of marks Opposer has made of issue in this consolidated proceeding. Yet, Opposer acts, and premises its failure to fulfill its discovery obligations, as if it is doing Applicant a favor by participating in discovery in this proceeding. The Board should not buy into Opposer's faulty premise and hyperbole, and, instead, should grant Applicant's motion to compel in its entirety.

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II. INTERROGATORY NO. 10 – RETAIL PRICES

Applicant's interrogatory plainly requests that Opposer "[s]tate the retail price of each of" Opposer's goods bearing or sold under its tree mark. Opposer's continued contention that this straightforward interrogatory is overbroad and burdensome is facially unsupported. Opposer cannot allege nine registrations, across a panoply of goods, in support of its two consolidated notices of opposition to ten applications, but then refuse to provide basic information regarding the goods it has made of issue in this proceeding.

Applicant did not request that Opposer provide it with all retail prices for the relevant goods from January 1, 2006 to the present. Opposer's contention that this is the scope of Interrogatory No. 10 derives from the following prefatory instruction to Applicant's First Set of Interrogatories: "Unless otherwise stated, the relevant time period for the requests below is January 1, 2006 to the present." Interrogatory No. 10, however, does not have a temporal component, and it would be nonsensical to read that limitation into it. The interrogatories is clearly stated in the present Opposer's suggestion that Interrogatory No. 10 does is merely a convenient way for it to dismiss its obligation to provide this relevant information. Even if Opposer is of the genuine belief that Interrogatory No. 10 is requesting that Opposer state each retail price for each of its relevant goods from January 1, 2006 to the present, a reasonable compromise would have been for Opposer to provide its current retail prices for its relevant goods or provide documents – e.g., price lists of suggested retailer prices – reflecting such prices. Instead, Opposer simply does not want to provide this relevant information for reasons unknown to Applicant.

Applicant's suggestion that Opposer provide it with a range of retail prices for its products does not constitute, as Opposer argues, a "new and untimely interrogatory." (Opp., p. 4, n. 3.) This is, instead, a compromise proposed by Applicant in good faith in order to come to an amicable resolution of this discovery impasse. Applicant's proposed compromise is tantamount to parties agreeing that, in lieu of producing *all* documents to a document request, the discovery respondent will produce *representative* samples of documents to the request. In short,

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Applicant is merely attempting to work towards amicably resolving the discovery impasse, not propounding new or untimely discovery requests.

III. REQUESTS FOR PRODUCTION ("RFP") NOS. 1-3, 6-11, 15-17, 39, 41, 45, AND 48 – AGREEMENT TO PRODUCE

In its opposition brief, Opposer argues that simply because its boilerplate responses to these RFPs contain the words "will produce," it has satisfied its obligations under Fed.R.Civ.P. 34(b)(2)(B).[1] This would be true if Opposer actually stated that it "will produce" the specific documents requested by Applicant in each of these RFPs. It has not done this. Instead, each of Opposer's responses states the exact same thing, namely, that:

> It will produce representative samples of labels, hang tags, advertisements, promotional materials, web pages and other materials reflecting its use of the [tree mark] in the United States on and in conjunction with the types of goods listed in response to Interrogatory No. 1, which goods are offered and sold to members of the general public in this country through numerous third-party retailers, [Opposer's] own retail stores, and the websites of [Opposer] and its retailer customers.

As noted by Applicant in its motion, each of these RFPs seeks different documents, and Opposer's boilerplate responses are, at best, non-responsive and, at worst, evasive. Accordingly, Opposer's contention in its opposition brief that it "crafted its responses to [Applicant's] requests production" (Opp., p. 7) is belied by its actual responses.

IV. RFP NO. 18 – CO-BRANDING AGREEMENTS

Opposer's agreements related to its pleaded marks are presumptively discoverable under TBMP § 414(10): "Information concerning litigation and controversies including settlement and other contractual agreements between a responding party and third parties based on the responding party's involved mark is discoverable." (Emphasis added.) Opposer's interpretation of TBMP § 414(10) is incorrect. Opposer argues that this "provision permits some discovery of only '[i]nformation concerning litigation and controversies.'" (Opp., p. 10, n. 4.) In other

[1] Applicant's problem with Opposer's responses is not that Opposer used the term "will produce" instead of "will be permitted," the language used in Fed.R.Civ.P. 34(b)(2)(B). Instead, it is Opposer's failure to agree to produce documents "as requested." Fed.R.Civ.P. 34(b)(2)(B).

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words, Opposer argues that the phrase "other contractual agreements" is limited by the previous phrase "[i]nformation concerning litigation and controversies." Opposer's argument is flatly rejected by the relevant case law as reflected in the TBMP's footnotes to TBMP § 414(10), i.e.; *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (licensing agreements and arrangements between opposer and third parties and amount of sales thereto are relevant); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 172 (TTAB 1975) (contacts with third parties, such as through litigation or agreements, based on pleaded mark for involved goods, are relevant.)

Instead of producing its agreements, Opposer asks Applicant to take it at its word that the agreements do not contain information relevant to this proceeding. It is well established, however, that "information concerning communications or controversies between a party to a proceeding before the Board and third parties based upon the party's involved mark may be relevant for such purposes as to show admissions against interest, limitations on the party's rights in such mark, a course of conduct amounting to what could be considered an abandonment of rights in the mark, that the mark has been carefully policed and protected, etc." *American Society of Oral Surgeons v. American College of Oral and Maxillofacial Surgeons*, 201 U.S.P.Q. 531, 533 (TTAB 1979). Pursuant to TBMP § 414(10), Applicant is entitled to these agreements to determine the implications of each agreement on Opposer's alleged rights in its tree mark.

V. INTERROGATORY NO. 27 AND RFP NO. 49 – TEMPORAL LIMITATION

In support of its unilateral imposition of a temporal limitation on these discovery requests, Opposer cites to a personal injury case, *Rowland v. Paris Las Vegas*, 2015 WL 4742502 (S.D. Cal. Aug. 11, 2015). In that case, the plaintiff, who slipped on defendant's floor, served defendant with an interrogatory requesting it "[i]dentify each person who complained, reported, or otherwise informed you that the tile floor in the hotel rooms at Paris Las Vegas Hotel & Casino was slippery, at any time from day one through present." *Id*. at *2. The court ruled that the interrogatory sought relevant information, but was overbroad as to time, and therefore limited its temporal scope to the last five years. *Id*. at *3.

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