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

Proceeding	91171266
Party	Defendant David Joseph
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Date: May 28, 2009

By: \_\_\_\_\_

Lori A. Ciccio

Attorney Docket No: 63254.200OPP

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

**The Deak Group, Inc.**  
**A Florida Corporation**

**Opposer**

**v.**

**David Joseph**  
**An individual**

**Applicant**

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**Opposition No. 91,171,266**

**Cancellation No. 92,047,147**

**Cancellation No. 92,047,166**

**APPLICANT'S MOTION TO COMPEL DISCOVERY  
RESPONSES FROM OPPOSER**

Pursuant to Trademark Rule of Procedure 2.120(e)(2) and Fed. R. Civ. P. 37(a)(2)(B), Applicant David Joseph respectfully requests the Trademark Trial and Appeal Board to issue an Order compelling Opposer, The Deak Group, Inc. to fully respond to Applicant's First Set Of Interrogatories, and further, to respond to, and produce discovery in response Applicant's First Set for Production of Documents to Opposer ("Document Requests"), as detailed herein.

**INTRODUCTION**

Notwithstanding any confusion in the pleadings, or the TTAB's apprehension of same, Applicant has cooperated completely with all discovery propounded to it, timely responding to each discovery request and producing in excess of 700 documents to Opposer's counsel's office on October 25, 2006. However, as the facts clearly demonstrate, Opposer has failed to make even a token attempt to abide by its discovery

obligations. Accordingly, Applicant has no other option than to proceed with its instant Motion to Compel.

### **Applicant's Compliance with its Discovery Obligations**

On August 24, 2006, Opposer served Applicant with a First Set of Interrogatories and a First Set of Document Production Requests. A Second Set of Interrogatories was served on Applicant on August 25, 2006. The parties stipulated that Applicant's response date would be October 23, 2006. No further communications have ever been received regarding the responses provided by Applicant to Opposer.

### **Opposer's Disregard of its Discovery Obligations**

On October 24, 2006, Applicant served on Opposer a First Request for Admissions, a First Set of Interrogatories and a First Set of Request for Document Production. The parties stipulated that responses were due December 26, 2006. On December 28, 2006, at Opposer's request, Applicant granted an additional one-day extension for Applicant to provide its already over-due responses. True and correct copies of the Interrogatories and Document Requests are attached herewith as Exhibit A and B to Applicant's Good Faith Statement ("Applicant's Statement").

On December 29, 2006, Applicant's counsel received Opposer's responses to Interrogatories and a written response to Opposer's Document Requests. True and correct copies of the Opposer's Responses to Interrogatories and Document Requests are attached herewith as Exhibit C and D to Applicant's Statement. Opposer's responses to Interrogatories contained a number of deficiencies, omissions and ill-taken objections. Opposer's written response to the Document Requests was similarly defective. Moreover, Opposer failed to produce any documents, indicating instead that it would make documents available for inspection and/or that copies would be submitted for Applicant's inspection. Despite repeated requests, Opposer failed to either make the documents available or to provide copies.

On February 15, 2007, Applicant's counsel sent a letter to counsel for Opposer, advising him of the deficiencies of Opposer's discovery responses and requesting that Applicant supplement his responses. A true and correct copy of the February 15, 2007, letter sent to Opposer's counsel is attached hereto as Exhibit E to Applicant's Statement filed concurrently herewith. The letter invited Opposer's counsel to contact Applicant's counsel if further clarifications were required, and further requested a protective order be forwarded to facilitate the production of responses claiming privilege. No requests for further clarification were made.

On February 27, 2007, Opposer's counsel responded to the February 15, 2007, letter stating that they "were preparing the supplement as well as compiling all the documents and should have that to you shortly." Attached hereto as Exhibit F to Applicant's Statement. As of March 21, 2007, neither responses nor documents had been received by Applicant's counsel. However, on March 21, 2007, Opposer's counsel reaffirmed that he would "get them to [us] as soon as possible." Exhibit F to Applicant's Statement, attached hereto. He also advised that "I have the documents here and I need to go through them." Exhibit F to Applicant's Statement, attached hereto. Apparently, notwithstanding the original assurances that Opposer was reviewing the documents, no review had occurred.

On April 29, 2009, Applicant's counsel again transmitted the February 15, 2007, letter to Opposer's counsel demanding production of documents and responses. Exhibit G to Applicant's Statement, attached hereto. On May 21, 2009, Opposer's counsel yet again stated that "we will be reviewing [the discovery letter] ... and supplementing discovery." Exhibit F to Applicant's Statement, attached hereto. This is the same letter transmitted two (2) years ago! Finally, on May 21, 2009, Applicant's counsel reiterated its demand for the discovery responses and set a deadline of May 25<sup>th</sup> for the receipt of the responses and documents. Exhibit F to Applicant's Statement, attached hereto. To date, no response has been received regarding the deadline demand of May 25, 2009, and not a single document or supplemental production has been produced.

### **Discussion**

Pursuant to Fed. R. Civ. P. 37(a)(3), an “evasive or incomplete disclosure, answer, or response is to be treated as a failure to disclose, answer or respond.” Trademark Rule of Procedure 2.120(3) and Fed. R. Civ. P. 37 (a)(2)(B) authorizes a motion to compel if a party fails to answer an interrogatory submitted pursuant to Fed. R. Civ. P. 33, or fails to permit inspection pursuant to a request submitted pursuant to Fed. R. Civ. P. 34.

#### **A. Applicant Has Failed To Respond To Opposer’s Interrogatories**

Interrogatory Request No. 3: Opposer states in paragraph 3 of the Notice of Opposition that “Opposer owns the domain name <redlightvideo.com>.” Please identify the date on which Opposer received ownership or title of the domain name redlightvideo.com.

Opposer’s Response to Interrogatory Request No. 3: Opposer, via its prior owner, obtained rights to the domain name <redlightvideo.com> on or about October 20, 1997.

Discussion: In response to Interrogatory No. 2, Opposer states that domain name was registered on October 20, 1997. However, Opposer is not the original owner of the domain name. The interrogatory states “identify the date on which Opposer received ownership or title of the domain name.” Accordingly, this answer cannot be correct as logic dictates that Opposer could not retroactively have obtained rights in the domain name, a contract right, at the time of registration, unless it registered the domain name. Its rights clearly vested some time after the original registration date. Opposer’s response is therefore evasive and incomplete.

Interrogatory Request 16: Please state all facts supporting Opposer’s claim that Opposer’s trademark has been “used and advertised nationally in the United

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