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

Proceeding	91181380
Party	Defendant MIMULANI AG
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Attachments	2008-02-09 Reply to Opposition to Motion to Compel.pdf (5 pages)(70316 bytes) 2009-02-09 Declaration of ML for Reply to Opp. to M. to Compel.pdf (2 pages)(56862 bytes) EX. A.pdf (2 pages)(45563 bytes) EX. B.pdf (2 pages)(17556 bytes) EX. C.pdf (4 pages)(64192 bytes)

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

E. & J. GALLO WINERY,

Opposer,

v.

MIMULANI AG,

Applicant.

Opposition No. 91181380 (consolidated)

Opposition No. 91181381

Opposition No. 91181384

Opposition No. 91181385

Opposition No. 91181386

Opposition No. 91181388

**APPLICANT MIMULANI AG'S REPLY TO
OPPOSITION TO APPLICANT'S MOTION TO COMPEL**

Counsel for Mimulani AG ("Mimulani") made more than sufficient effort to raise and resolve Mimulani's discovery dispute with counsel for Opposer E. & J. Gallo Winery ("E. & J.") and fully discharged Mimulani's duty to meet and confer regarding this dispute.

Opposer's brief in opposition mischaracterizes the parties' communications and confuses Mimulani's meet and confer duty regarding its discovery dispute with a separate and later arising discovery dispute originating from Opposer.

Mimulani's meet and confer began with its counsel sending to Opposer's counsel an email on December 16, 2008 identifying in detail each of Opposer's discovery responses that Mimulani believed deficient. The email included the manner and nature of the alleged deficiency. This email was attached to Mimulani's motion as Exhibit A and is incorporated into this Reply by reference. The email is sufficiently specific to ripen the issues upon response by Opposer and does not require further clarification to particularize Mimulani's position. Mimulani's position regarding Opposer's discovery responses was clearly and

completely set out in the email and any narrowing of the issues was the responsibility of Opposer to make substantive responses thereto. In response to the email, if Opposer conceded that some or all of its responses were deficient then the issues could have been narrowed. Absent such concession, the parties' dispute was crystallized and ripe for determination from the Board.

Opposer made an immediate, preliminary email response to the December 16 email, which was also included in Exhibit A to Mimulani's motion. The response (1) indicated that Opposer disagreed that it owed Mimulani additional discovery responses, (2) requested authority from Mimulani supporting its position, and (3) indicated that a more substantive response would be forthcoming in the following week. Mimulani's counsel followed up by emailing Opposer's counsel on the same day that "we look forward to hearing back from you upon your return from New York", thus confirming Opposer's counsel's indication that substantive responses would be forthcoming the following week. (See declaration of Mark Lebow and Exhibit A)

Applicant is not required to provide authority supporting its position that Opposer's discovery responses were deficient. Nevertheless, on December 19, 2008, in the spirit of resolving the dispute without requiring the Board's intervention, counsel for Mimulani emailed Opposer's counsel several case law citations supporting its position as has been requested. (See declaration of Mark Lebow and Exhibit B) Despite this second follow up communication, Opposer made no response, substantive or otherwise, regarding Mimulani's detailed December 16 email in the week following the email.

Parallel to this meet and confer process, alleged counsel for Opposer began to raise a separate, unrelated discovery issue regarding Opposer's alleged failure to receive Mimulani's discovery responses timely served on October 6, 2008. On the afternoon of December 29 Mimulani's counsel received voice mail messages from an attorney named Peter Harvey claiming to represent Opposer. However, Mr. Harvey was not counsel of record and had made no appearance in this proceeding and has yet to make an appearance in this proceeding as of this filing. Counsel for Mimulani also received an email/letter from Mr. Harvey on the morning of December 30, 2008 (sent after business hours, EST, on the 29th and received on the 30th).

The transcribed voicemail reads:

Hi Mr. Lebow this is Peter Harvey calling. I'm with Harvey-Siskin in San Francisco. I'm calling you in connection with the E.& J. Gallo winery case versus Mimulani, the GALLISS opposition or cancellation proceeding. I wanted to check in with you on the discovery that's recently come to light. Could you give me a call at your convenience, 515-354-0100, thanks.

(See Declaration of Mark Lebow). Mr. Harvey's letter/email is attached hereto as Exhibit C.

As is apparent, neither the voicemail nor the letter mentions Mimulani's discovery issues raised in its detailed email of December 16. Rather, each is dedicated solely to Opposer's separate discovery dispute which arose after Mimulani's December 16 email. Neither communication attempts to more substantively respond to Mimulani's email or even acknowledges that such a substantive response is overdue.

Opposer's brief at page 2, and Peter Harvey's declaration at paragraph 2, describes Mr. Harvey's voice mail and email/letter as requesting correspondence on "pending

discovery issues". While this is technically true, it is not the whole truth. The "pending discovery issues" with which the communications were directed were Opposer's discovery dispute not Mimulani's discovery dispute. It is clear that Mr. Harvey (who was not Opposer's counsel and whose voicemail message did not claim to be) was interested only in discussing its issues with Mimulani's discovery and had no intention of making a response to Mimulani's email of December 16 that would narrow the issue. The fact that Opposer had no intention of narrowing the issues with a substantive response to the December 16 email is confirmed by Opposer's opposition in its brief to each and every issue raised by Mimulani's motion to compel.

Opposer's concentration in its brief in opposition on Mr. Harvey's two communications is a red herring and an obvious attempt to mischaracterize Mimulani's efforts to meet and confer. Opposer's decision to emphasize these communications in its brief is at odds with the incomplete description of them in Harvey's declarations and the strategic failure to include them as exhibits to Opposer's brief. To have done so would have revealed the mischaracterization and red herring and would have been fatal to Opposer's allegation that Mimulani ignored any request for additional meet and confer regarding Opposer's discovery deficiencies.

And, as noted, Mr. Harvey is not a counsel in this proceeding. His authority to act for Opposer in any capacity has not been confirmed, and it would have been improper for Mimulani's counsel to confer substantially with him given his lack of appearance or authority. The dispute regarding Opposer's discovery deficiencies was ripe at the time of

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