ESTTA Tracking number: **ESTTA783755**

Filing date: **11/17/2016**

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

Proceeding	91226605
Party	Plaintiff Duke University
Correspondence Address	SUSAN FREYA OLIVE OLIVE & OLIVE PA PO BOX 2049 DURHAM, NC 27702 UNITED STATES emailboxTTAB@oliveandolive.com, solive@oliveandolive.com, shernandez@oliveandolive.com
Submission	Opposition/Response to Motion
Filer's Name	David Loar Mckenzie
Filer's e-mail	dmckenzie@oliveandolive.com, david@mckenzielaw.net
Signature	/David McKenzie/
Date	11/17/2016
Attachments	AA Duke.pdf(3065735 bytes)

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board

Duke University, Plaintiff-Opposer vs Duke's Brewhouse, Inc., Defendant-Applicant	OPPOSITION NO. 91226605 DUKE'S BREWHOUSE Sr. No. 86/590,454 DUKE'S BREWHOUSE WINGS SPORTS SPIRITS Ser. No. 86/590,453

DUKE UNIVERSITY'S RESPONSE TO APPLICANT'S MOTION TO COMPEL

I. PROCEDURAL POSTURE

The marks at issue in this proceeding were published for opposition on September 1 and 8, 2015. After early attempts at resolution failed, Duke University ("Duke") initiated this opposition proceeding on February 29, 2016. The parties then undertook more efforts to reach a resolution and this matter was then suspended on April 5, 2016. After these further efforts failed, Applicant Duke's Brewhouse ("Applicant") filed its answer on June 8, 2016, and then instituted its Motion to Compel on November 2, 2016. Duke now timely responds to Applicant's motion.

II. BACKGROUND

Duke University is known to the public at large by its famous mark DUKE. Under this mark, Duke offers highly respected undergraduate, graduate, and professional degree programs; world-class hospitals; and a nationally known athletic program, which includes its famous men's basketball team. Duke University has been in the business of restaurant services since its inception in 1927 and bar services at least as early as 1972. In connection with its famous DUKE mark, Duke

University presently provides bar and/or restaurant services at its athletic venues, academic campuses, hospitals and medical facilities. It also sells a number of alcohol and restaurant goods under the DUKE mark. Additionally, Duke has valid and subsisting registrations for its DUKE mark and variants of the same.

As one would anticipate with an entity that is one of the largest private employers in the State of North Carolina [Ex. 1], Duke University receives applications from over 10,000 persons seeking jobs every month. Ex.1. Duke University educates over 14,000 full-time students annually,, treats over 1 million medical patients/yea, and has an operating budget of $2.3 billion annually, and further has been in existence since 1924 under the Duke name Duke has accumulated millions if not billions of documents. Its libraries alone have over 6.9 million volumes [Ex. 1 at 17]. Its archives and other files are even larger. The undersigned, in connection with a lawsuit of some considerable magnitude, was required to evaluate millions of documents arising from but a single unit within the university. Thus, requests seeking production of "any and all" documents on broad topics in the context of such an enterprise are frequently virtually impossible to accomplish and seldom justified.

As one would anticipate with an entity that is one of the largest private employers in the State of North Carolina and has been in existence since 1927, Duke has accumulated millions if not billions of documents. **Ex. 1**. Its libraries alone have millions of volumes; its archives and other files are even larger.

On July 29, 2016, Applicant served Duke with its written discovery. Duke contends that this written discovery is ill-defined in certain respects, oppressive and, most importantly, not proportional to the needs of this proceeding given the relatively small issues before this tribunal.

III. DISCUSSION

A. Duke University should not be compelled to offer additional responses to form discovery that is neither tailored nor proportional to the case.

Last year, the United States Supreme Court amended Rule 26(b)(1) to require that discovery be "proportional" to the needs of a case. Congress declined to intervene on this rule change, and proportionality consequently became the norm on December 1, 2015. Applicant, instead, served Duke with what appears to be form discovery that is not tailored or proportional at all. Mot to Compel, Exs. 1-2. The issues in this case will be fame and likelihood of confusion, and to this end priority. Applicant has not offered written discovery that is proportional to these issues. Here, courts around the country are interpreting the amended rule to require exactly this.

Courts are requiring issue proportionality. In *Moore v. Lowe's Home Ctrs*., 2016 WL 687111 (W.D. Wash. Feb. 19, 2016), a plaintiff brought an action for unlawful employment practices, including discrimination, harassment, and termination related to her gender. The plaintiff made a broad requests and sought to compel the production of "personnel records" not only for those "who allegedly harassed, discriminated, and retaliated against" her, but also for "store managers, HR representatives, and investigators" and for comparable employees without protected status like hers. The court allowed the motion to compel as to the personnel file for the specific person named in the complaint but denied it for all other employees, stating that the "relevance [of the discovery sought] is tangential and not proportional to the Plaintiff's claims." In this same case, the plaintiff wanted additional email searches but failed to state why it needed the searches with proportionality (i.e., tailored or specific to the issues). The court found the plaintiff's request for additional searches "overly broad and not proportional to the case," stating that, although the searches might yield some relevant emails, the plaintiff had not provided specifics for what she expected to find and had not shown that the information "could not be found through other means,"

such as through questioning at depositions. Having found the request not proportional, the court denied plaintiff's motion as the discovery was not proportional to the legal issues. *Id* at *2.

In *Wilmington Trust v. AEP Generating*, 2016 WL 860693 (March 7, 2016), there was one legal issue at stake: breach of contract. The plaintiff requested emails during the relevant time period during which the breach occurred, which was proportional, but later requested emails during the time after the breach. That second request required a search of "many as a million" pages and could have yielded over 200,000 pages. The court denied the plaintiff's motion to compel because the documents would not go to the relevant issue – i.e., was there a breach – and declared that the additional search outside the relevant time period would "violate the rule of proportionality." *Id* at *2.

In *Robertson v. People Magazine*, a federal district court concluded that the amended rule "serves to exhort judges to exercise their preexisting control over discovery more exactingly." *Robertson v. People Magazine*, 2015 WL 9077111 (S.D.N.Y. Dec. 16, 2015). The court then considered the legal issues at stake – employment discrimination – verses the discovery in dispute – documents concerning editorial decisions on what to publish. The court found that the requests "extend far beyond the scope of Plaintiffs' claims and would significantly burden Defendants" and denied the plaintiff's motion to compel. *Id* at *3.

Here, a similar result should follow given the issues of fame and likelihood of confusion, and to this end priority. The same is alleged with particularity in the Opposition to Registration. Requests should be proportional to these issues. Applicant repeatedly uses "any and all" and "all documents," and Applicant additionally also offers broad written discovery that appear to be derived from forms. Furthermore, Applicant fails to define key terms, leaving Duke to divine for

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.