

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

RANDALL A. TERRY)	
)	
Petitioner)	
)	
v.)	Cancellation No. 92047809
)	Registration No. 3179591
TROY NEWMAN)	Mark: OPERATION RESCUE
)	
Registrant)	
)	
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_____)	

**PETITIONER’S MOTION TO AMEND THE PLEADING
AND FOR A PROTECTIVE ORDER TO PRECLUDE CERTAIN DISCOVERY**

Petitioner Randall A. Terry, through undersigned counsel, brings this motion having two components: First, Petitioner moves to amend the Petition to Cancel pursuant to Rule 15(a) of the Federal Rules of Civil Procedure. **By this motion, Petitioner hereby withdraws the pending motion for the Second Amended Petition to Cancel served December 10, 2007 and received December 13, 2007 by the Board.** Second, Petitioner moves pursuant to 37 CFR § 2.120(f) for a protective order to preclude certain discovery by Registrant. Each of these components is separately discussed below.

Procedural Background

Petitioner, then acting through prior counsel, initiated this proceeding on July 10, 2007, and later amended the pleadings in response to Registrant’s motion to dismiss. The Board approved entry of the amended pleading by its Order of November 27, 2007. The parties requested that the close of discovery be extended until May 1, 2008, which the Board granted on December 14, 2007.

At that time, Petitioner also moved to amend the pleading, as discussed above in the introductory paragraph. That motion was contested by Registrant and has been briefed by the parties. As noted, that motion is withdrawn and should be deemed moot.

Petitioner's prior counsel filed a motion to withdraw as Petitioner's representative, which was received by the Board on January 16, 2008 and granted on February 1, 2008. Proceedings have remained suspended since then with Petitioner being granted an extension of time to obtain new counsel. The undersigned filed an appearance on Petitioner's behalf on April 4, 2008.

Motion to Amend

Rule 15(a) provides that "leave [to amend] shall be freely given when justice so requires." Petitioner has amended once as of right (since no responsive pleading was then of record by Registrant) and, having withdrawn the prior motion, the instant motion represents Petitioner's first request to amend the pleadings. In the second amended petition of the prior motion, the asserted grounds were essentially likelihood of confusion, fraud, dilution and descriptiveness. The proposed amended pleading, at Exhibit A, asserts none of the prior grounds and instead relies solely on Section 2(a) as Registrant's mark "falsely suggests a connection" with Petitioner. *See, e.g., Buffett v. Chi-Chi's*, 226 USPQ 428 (TTAB 1985). This amended ground was ascertained during discussions between Petitioner and the undersigned, as new counsel.

Registrant is not prejudiced by this amendment since the grounds for the proceeding are greatly simplified to one basis. Moreover, this case is still somewhat early in discovery in that no discovery depositions have been taken. At the time of suspension on February 1, the parties had agreed to extend discovery and the Board's

Order specifically provided that discovery would be re-opened. Thus, Registrant has ample time to investigate the facts supporting Petitioner's allegations. In view of this, and that the interest of justice supports proceeding to hear all relevant claims, this motion should be granted. *See Buffett*, 226 USPQ at 431.¹

Protective Order to Preclude Certain Discovery

Notwithstanding that Registrant may need additional discovery in light of the amended pleading, that discovery must proceed in light of what has already occurred and consistent with the applicable rules. More specifically, Registrant has served discovery requests that are outrageously burdensome and far outside the permissible scope of the rules. Any future discovery should be reined in, as discussed below.

On December 22, 2007, Registrant served his First Request for Admissions, attached at Exhibit B, comprising 597 such requests and 20 of those (nos. 403 to 422) each had 52 subparts directed to use of Petitioner's mark in each of the 50 States as well as the District of Columbia and Puerto Rico for the years 1988 to 2007, inclusive. Likewise, Registrant also served his Second Set of Interrogatories, at Exhibit C, in which no. 20 requested additional information if the responses were not an unqualified admission for admission requests nos. 203 through 402. That request alone for 200 interrogatories, made without leave of the Board, far exceeds the permissible number of 75 including subparts under 37 CFR § 2.120(d). To put the total number of interrogatories in perspective, attached at Exhibit D is Registrant's First Set of Interrogatories, totaling 19, not counting subparts.

¹ The undersigned spoke with Registrant's counsel regarding the proposed motion on May 12 and that day emailed him a copy of the pleading. I again spoke with him on May 20 and 21, but he did not have Registrant's consent to the motion. In these later discussions, discovery matters were also discussed, as detailed later in this memorandum.

Petitioner's prior counsel, even though he served his motion to withdraw on January 9, undertook the arduous task of responding to the admission requests and second set of interrogatories. Those responses, attached at Exhibit E, were served on January 28, just three days before the Board granted his withdraw and suspended the case. The responses were made subject to the general and specific objections that Registrant's discovery was overly burdensome.

In the recent discussions between counsel (mentioned in footnote 1), Registrant took the position that newly retained counsel should undertake to supplement the prior responses since Registrant had contemplated, and discussed with prior counsel, Registrant's potential motion to test the sufficiency of the responses to the admission requests. However, as the undersigned explained to Registrant's counsel, the great bulk of those prior responses are now irrelevant in view of the amended pleading. In particular, many of the admission requests are premised on, or directly assessing, the notion that Petitioner was asserting his mark under Section 2(d). That notion is now superseded and thus irrelevant. Under Section 2(a) as now asserted, Petitioner's "interest does not depend for its existence on the adoption and use of a technical trademark." *Buffett*, 226 USPQ at 429. "Thus, an opposer in a proceeding of this character may prevail even if the name claimed to be appropriated has never been commercially exploited by opposer in a trademark or trademark analogous manner." *Id.*

The duty to supplement prior discovery responses under Rule 26(e) must be interpreted under Rule 26(b) that sets forth that "the scope of discovery" is limited to "matter that is relevant to any party's claim or defense." Here, neither party should be able to offer or rely upon evidence that is directed to any mark previously alleged by

Petitioner since that basis for objection has been removed from the case and any such evidence is thus irrelevant.

This motion is brought in good faith so that this proceeding can be un-suspended and go forth without immediately being ensnared in future discovery disputes that again suspend the case.² For example, if the opening of discovery prompts Registrant to serve additional admission requests or even interrogatories, those would exceed any permissible limits and Petitioner would object, thus causing further motions and suspension. Absent guidance from the Board in response to this motion, this case will sail forth with an amended pleading, but quickly have to return to port for repairs.

In view of Registrant's extensive and burdensome written discovery, Petitioner respectfully requests the following relief to limit discovery by Registrant pursuant to Rule 26(b)(2)(C):

That Registrant is precluded from any further requests for admission;

That Registrant is precluded from any further interrogatories in favor of a deposition of Petitioner (Registrant's counsel proposed to take this deposition in the telephone conference with me) as this method is less costly and burdensome, and more likely to be effective in discovering relevant information;

Alternatively, if interrogatories are not precluded, that Registrant be limited to no more than five (5) interrogatories in view of the single claim in the amended petition; and

² Registrant's counsel was of the position that Petitioner should supplement the prior discovery prior to this motion. However, in view of the pending motion to amend by prior counsel, Petitioner believed that judicial economy was served by filing expeditiously so that the Board did not waste resources by ruling on the prior motion when Petitioner no longer intended to rely upon that theory of the case.

That Petitioner has no obligation to supplement discovery responses in which the request was directed to any previously asserted basis for the petition.

In view of the foregoing, Petitioner respectfully requests that this motion be granted by permitting leave for the pleading as amended and by ordering a protective order as proposed above.

Respectfully submitted,

Date: May 27, 2008

By: Michael Culver

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Attorneys for Petitioner

Certificate of Service

This is to certify that a copy of the foregoing, with Exhibits, was served this 27th day of May 2008 by first-class mail, postage prepaid, on the following:

Brian R. Gibbons, Esq.
Suite 300
3936 South Semoran Blvd.
Orlando, Florida 32822-4015

By: Michael Culver
Attorney for Petitioner

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Exhibit A

Petitioner's Third Amended Petition to Cancel

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PETITIONER’S THIRD AMENDED PETITION TO CANCEL

Petitioner, Randall A. Terry, believes that he will be damaged by the continued registration of the mark OPERATION RESCUE of Registration No. 3179591, and hereby petitions to cancel same on the following grounds:

1. In 1987, Petitioner began using the words “Operation Rescue” to identify his activities in the field of pro-life issues. This use was prior to any use by Registrant of the mark OPERATION RESCUE.
2. Using the identifier Operation Rescue, Petitioner led one the most widespread and well known protest movements in recent American history. Petitioner’s fame or reputation in the pro-life movement was well established in the late 1980s and early 1990s. Since then, this legacy has continued with Petitioner in his pro-life activities and other endeavors.
3. The words Operation Rescue point uniquely and unmistakably to Petitioner, as recognized by the media and persons both within and outside of the pro-life field.

4. Notwithstanding Petitioner's identification with Operation Rescue as known to Registrant, Registrant has registered the alleged mark OPERATION RESCUE for "educational services, namely, providing classes, workshops, seminars and personal instruction in the field of pro-life issues and social activism."


5. Petitioner is not connected in any way with the services identified by Registrant's use of the mark OPERATION RESCUE.

6. Due to the similarities in wording between Registrant's mark and Petitioner's identification as Operation Rescue, members of the public have falsely assumed a connection between Petitioner and Registrant. Some members have mistakenly made financial contributions to Registrant that were intended to be made to Petitioner.

7. Because Registrant's registration of OPERATION RESCUE falsely suggests a connection with Petitioner, this registration is precluded by Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), and therefore should be cancelled.

Respectfully submitted,

Date: May 27, 2008

By: 
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Attorneys for Petitioner

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Exhibit B

Registrant's First Request for Admissions

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Exhibit D

Registrant's First Set of Interrogatories to Petitioner

