

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA
CASE NO.: 1:16-CV-21296 –SCOLA/OTAZO**

SETAI HOTEL ACQUISITION,

Plaintiff,

v.

MIAMI BEACH LUXURY RENTALS, INC.

and ALLEN TULLER,

Defendants.

**DEFENDANTS' MOTION TO COMPEL
COMPLIANCE WITH THIS COURT'S ORDER AND FOR SANCTIONS**

Defendants ("MBLR" and Tuller), through undersigned counsel, move this Court for an order compelling compliance with this Court's Order [DE 237] requiring Plaintiff to supplement its production with any forms showing use of the 974 Mark by others and for sanctions and state:

Under the clear law of the Eleventh Circuit, the number of businesses incorporated with the Division of Corporations of the Secretary of State can be used to determine the strength – or weakness – of a plaintiff's mark. The more businesses incorporated with the Division of Corporations of the Secretary of State of Florida, the weaker Plaintiff's mark. *Sun Banks of Fla. v. Sun Federal Saving*, 651 F.2d 311, 316 (5th Cir. June 20, 1981) (citing a composite print out from the Florida Secretary of State that revealed a number of businesses employing the word "Sun" in finding no likelihood of confusion between "Sun Banks" and "Sun Federal Savings & Loan" due to extensive third party use) and *Bonner v. City of Prichard*, 661 F.2d 1206, 1209 (11th Cir. 1981) (en banc) (holding all cases prior to September 30, 1981 are binding precedent in the Eleventh Circuit). Based on this law, Defendants' have asked the Court to take judicial notice of the composite printout of the Secretary of State website.

However, Defendants *also* intend to show Plaintiff knew other people were using the 974 Mark, thereby failing to police the 974 Mark. Failure to police the mark is a factor in deciding whether the Mark is weak and deserving of less protection. Thus, Defendant served discovery back in December 2016. Plaintiff responded as follows to Defendant's First Request for Production:

All documents reflecting Your knowledge of the use of the Setai name by anyone other than You, including unit owners who have the Setai name incorporated into the name of the entity holding legal title to the unit.

RESPONSE: SHA objects to this request as it is overly broad, unduly burdensome, vague, ambiguous, and not reasonably specific. SHA objects to this request because it seeks the production of documents that are neither relevant nor likely to lead to the discovery of admissible evidence. SHA further objects to this request to the extent it calls for the production of documents subject to attorney-client privilege, attorney work-product doctrine, and for documents not within SHA's possession, custody, or control.

All documents reflecting the use of the Setai name by anyone renting or attempting to rent a privately owned residential unit at the Setai Residences or Condominium.

RESPONSE: SHA objects to this request as it is overly broad, unduly burdensome, vague, ambiguous, and not reasonably specific. SHA further objects to this request because it seeks the production of documents that are neither relevant nor likely to lead to the discovery of admissible evidence.

Because Plaintiff previously just responded by stating that it produced the documents, Defendant was required to file a Motion to Compel and ask the Magistrate Judge to require Plaintiff to specifically identify the documents responsive to this request. Pursuant to the Magistrate's Order [DE 120 p. 2], Plaintiff was required to provide a list identify the bate label for all documents *responsive* to each request. Plaintiff only identified demand letters for this request.

As it turned out, Plaintiff's production was not complete. Plaintiff was still trying to preserve an objection saying that other people's use of the Setai name was "irrelevant." This is not only contrary to law, it is patently frivolous. The use of the name by others goes to the weakness

of the Mark in identifying a particular good or service, as well as Plaintiff's failure to police the Mark.

Thus, Defendants previously filed another Motion to Compel with this Court asking the Court to require Plaintiff to supplement its production with all documents showing use of the Setai name by others. [DE 232]. Although the Court deferred until trial Defendants' request for judicial notice of the composite printout of the Secretary of State's listings containing the 974 Mark, the Court granted Defendants' Motion to Compel and again required Plaintiff to supplement its discovery responses with documents showing use of the 974 Mark by others. [DE 237].

Plaintiff then produced almost 2500 pages of documents on Wednesday August 23, 2017. It is important to note that Plaintiff has been engaged in motion practice since this case failed to settle at the settlement conference and trial is set to begin Monday August 28, 2017. Plaintiff has indicated that there may be one document showing the use of the Setai name in the stack of 2500 pages. Defendant sifted through the stack of 2500 pages and could not locate the document. Defendant asked Plaintiff to stop playing games, warned Plaintiff that the Magistrate Judge had already ordered Plaintiff to specifically identify responsive documents, and asked Plaintiff to specifically identify the actual responsive document by bates label. Plaintiff has refused.¹ If there are no responsive documents, Plaintiff's response should say "none." If there are responsive documents showing use of the Setai name by others, Plaintiff should produce just the responsive documents, since Defendants did not ask for tenant registration forms. Instead, Defendants

¹ Not only did Plaintiff not produce just responsive documents, Plaintiff says that it produced the documents "as they are maintained." However, in order to determine if the file contained any responsive documents, Plaintiff would need to look through the file. Rather than pull out the responsive documents, Plaintiff believes it can produce all documents. That is not the law. Under Plaintiff's logic, it could have produced every document in its position by semi-truck and said there may be some responsive documents in the truck. Plaintiff's games need to end and this is especially problematic as trial begins Monday. This is also why Plaintiff has been engaged in its game of motion practice, to distract the undersigned counsel from preparing for trial.

requested documents showing use of the 974 Mark by others. It further seems Plaintiff, by stating that there is a responsive document within the stack of 2500 pages, is admitting it failed to disclose all responsive documents in its prior production. Plaintiff should also be sanctioned for again wasting the Court's precious time, forcing Defendants to sift through thousands of pages of documents, and forcing the filing of the current Motion.

WHEREFORE, Defendants requests that this Court enter an order requiring Plaintiff to show cause and/or compelling Plaintiff to immediately supplement its discovery responses to include documents showing use of the Setai name by others and (ii) sanctioning Plaintiff in the form of attorney's fees related to the motions and the review of 2500 pages of documents, and (iii) for such other relief as this Court deems just and proper.

Respectfully submitted,

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By: /s/ Tony Stabenow
Tony L. Stabenow, Esq.
Florida Bar No.: 0033328

CERTIFICATE OF GOOD FAITH CONFERENCE

I HEREBY CERTIFY that before filing this Motion the undersigned communicated and conferred with SHA's counsel regarding the relief requested herein before filing this Motion with the Court and Plaintiff opposes the relief requested herein.

By: /s/ Tony Stabenow
Tony L. Stabenow, Esq.
Florida Bar No.: 0033328

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that, PURSUANT TO Rule 5(b) of the Federal Rules of Civil Procedure and Rule 5.2 of the Local Rules for the United States District Court for the Southern District of Florida, I served the foregoing upon Daniel Barsky, Esq. and Daniel Benavides, Esq. at: 525 Okeechobee Blvd., Suite 1100, West Palm Beach, FL 34401 and DBarsky@shutts.com and DBenavides@shutts.com counsel for Plaintiff, this 25th day of August 2017.

By: /s/ Tony Lee Stabenow, Esq.
Tony L. Stabenow, Esq.
Florida Bar No.: 0033328