

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

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Mailed: September 5, 2002

Opposition No. 115,516  
Cancellation No. 40,257

Mark Saron, d/b/a  
Skybridge

v.

Alcatel Espace, Societe  
Anonyme and Skybridge  
Limited Partnership,  
joined as a defendant

Before Cissel, Holtzman, and Bottorff, Administrative  
Trademark Judges.

By the Board:

***Opposition No. 115,516***

This opposition now comes up on the following: (a) Mark Saron's (hereinafter "opposer" or "petitioner") motion (filed May 2, 2002) to compel; (b) Alcatel Espace Societe Anonyme's (hereinafter "applicant" or "respondent") motion (filed May 16, 2002) for entry of a stipulated protective order; (c) applicant's motion (filed May 16, 2002) to amend the caption of this case; (d) opposer's motion (filed May 31, 2002 as a part of opposer's response to applicant's motion to amend) to extend opposer's discovery period, to

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close applicant's discovery period and to compel "Skybridge Limited" to respond to certain discovery requests; and (e) applicant's motion (filed June 6, 2002) to extend time to respond to the motion to compel.

We first turn to applicant's motion to amend "the caption ... to reflect the assignment of the above mark and application to Skybridge Limited Partnership," which was recorded at Reel No. 2432, Frame No. 0192. The Board, on July 2, 2002, amended the caption to join Skybridge Limited Partnership as a party defendant. Because it appears from the record in this case that the Board did so without the benefit of opposer's combined response and motion to extend the discovery period (filed May 31, 2002) and applicant's reply (filed June 17, 2002),<sup>1</sup> and because the registration which is the subject of Cancellation No. 40,257 (see discussion below regarding Cancellation No. 40,257) has also been assigned to Skybridge Limited Partnership and the Board has not yet considered the assignment in that case, we reconsider applicant's motion to amend.

The records of the United States Patent and Trademark Office for the application involved in this opposition reflect the recordation on January 16, 2002 of a change of name from Alcatel Espace Societe Anonyme to Alcatel Space

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<sup>1</sup> It appears that the response and reply had not been matched with the Board file for this proceeding at the time of the Board's decision.

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Industries, executed on July 2, 1998, at Reel No. 2432, Frame 0192; and on January 17, 2002, of an assignment from Alcatel Space Industries to Skybridge Limited Partnership, executed on July 17, 1998, at Reel No. 2431, Frame 0814.<sup>2</sup> According to opposer, Roland Plottel, applicant's attorney of record in this opposition and in Cancellation No. 40,257, filed the papers to record the assignment on December 11, 2001; that from December 11, 2001 until the filing of its motion to amend on May 16, 2002, Mr. Plottel did not advise the Board that there had been a change of ownership of the involved application and that he "responded to discovery, propounded by opposer, on behalf of Alcatel Espace and not on behalf of the true owner Skybridge Limited Partnership"; and that "the request should not be granted until such time as Alcatel Espace and/or Skybridge Limited Partnership provides a detailed explanation as to why no effort was made to correct the identity of the proprietor of said application at an earlier stage of this proceeding."

(Emphasis in the original.) Further, opposer argues that "Opposer should not be required to reissue interrogatories, document requests, and admission requests which have been propounded in the belief that Alcatel Espace was the owner of the ... application;" and that the discovery period for

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<sup>2</sup> The execution dates of the change of name and the assignment are earlier than the filing date of the notice of opposition.

opposer should be extended for six months, while closing applicant's discovery period, and that "Skybridge Limited" be ordered to immediately respond to all interrogatories, document requests and admission requests without objection and produce all relevant documents.

As noted in TBMP §512,<sup>3</sup> when there has been an assignment of a mark which is the subject of an inter partes proceeding before the Board, the assignee may be joined or substituted, as may be appropriate. When an assignment is recorded in the Assignment Branch, the assignee may be substituted as a party if the assignment occurred prior to the commencement of the proceeding. *Id.* In this case, even though the assignment to Skybridge Limited Partnership was executed prior to the commencement of the opposition, we grant applicant's motion to the extent that we join (rather than substitute) Skybridge Limited Partnership as a defendant in the opposition. We do so because numerous papers have been filed in this proceeding in the name of Alcatel Espace Societe Anonyme (even after the filing of the motion to amend), because Alcatel Espace Societe Anonyme has responded to opposer's discovery, and because applicant has

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<sup>3</sup> The Trademark Trial and Appeal Board Manual of Procedure (TBMP) is available (i) as a book from the U.S. Government Printing Office (202-512-1800); (ii) as a CD-ROM from the Patent and Trademark Office's Office of Electronic Information Products (703-306-2600); and (iii) on the global computer network at <http://www.uspto.gov/web/offices/dcom/ttab/tbmp>.

not specifically requested substitution of Skybridge Limited Partnership for Alcatel Espace Societe Anonyme.

As for opposer's motion to extend opposer's discovery period for six months and to close applicant's discovery period, we deny the motion as unwarranted. We also deny opposer's motion that "Skybridge Limited" be ordered to immediately respond to certain discovery requests without objection and produce all relevant documents. Now that Skybridge Limited Partnership is a party to this proceeding and the discovery period remains open (see below), opposer may propound discovery on Skybridge Limited Partnership.

Next, we turn to applicant's motion to extend the time for applicant to respond to the motion to compel. Because the Board has not received a response to applicant's motion from opposer, applicant's motion is granted as conceded by opposer under Trademark Rule 2.127(a). We have considered applicant's response to the motion to compel.

We now address the motion to compel. Because opposer, in its response (filed June 27, 2002) to the motion to compel, limits its discussion to Interrogatory Nos. 1 (parts 1 - 5, 7 and 8), 4, 5, 14, 15 and 16,<sup>4</sup> and Document Request Nos. 3, 5, 6, 9, 10, 16 - 18, 20, 21, 25, 26, 30, 31, 33,

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<sup>4</sup> Opposer states in its response that applicant's amended answer to Interrogatory Nos. 2, 3 and 10, "assuming that they are correct, would obviate any need for the Board to decide the matters" relating to these interrogatories.

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and 35, we consider opposer's motion only with respect to these discovery requests.<sup>5</sup>

As explained in the pages that follow, opposer's motion to compel is granted in part and denied in part.<sup>6</sup> For ease of consideration, the interrogatories and document requests are generally grouped together by subject matter or by applicant's objections.

*Interrogatory No. 1 (parts 1-5, 7 and 8)*

Because applicant states in its amended answer to this interrogatory that it has not yet rendered any of the services recited in the involved application in the United States, applicant only must produce the publications which it promises in its amended answer to Interrogatory No. 1.

*Interrogatory Nos. 4 and 5*

Applicant has stated in its amended answers to these interrogatories that Applicant's in-house marketing and advertising departments have responsibility for the marketing, advertisement and/or promotion of Applicant's products and/or services identified by the designation SKYBRIDGE, and that "the creation of the SKYBRIDGE Mark was a collective work of various persons." Because (a) we have

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<sup>5</sup> Applicant served amended responses to opposer's discovery requests after opposer filed its motion to compel.

<sup>6</sup> The record in this case reflects that opposer has made the requisite good faith effort to resolve with opposer the issues presented in the motion and has been unable to reach agreement. See Trademark Rule 2.120(e).

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ordered the production of documents responsive to Document Request No. 5 (see below), and, to the extent that such documents exist, opposer may obtain the names of persons who authored such documents or to whom such documents were sent; and (b) because opposer may notice a Federal Rule 30(b)(6) deposition, we deny opposer's motion to compel further answers to these two interrogatories.

*Interrogatory No. 14*

Applicant must supplement its response with a privilege log in accordance with Federal Rule 26(b)(5), identifying all privileged communications which are responsive to this interrogatory. The parties are reminded that the identification of opinions, as opposed to the substance or contents of the opinions, is not privileged or confidential. See *Goodyear Tire & Rubber Co. v. Tyrco Industries*, 186 USPQ 207 (TTAB 1975); and *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167 (TTAB 1975).

*Interrogatory No. 15*

Opposer's complaint regarding Exhibit A to applicant's response (filed June 10, 2002) to the motion to compel is well taken. Applicant therefore must supplement its response to this interrogatory to reference Exhibit A, and any other evidence that is responsive to this interrogatory, or explain why it has not included Exhibit A in its response to this interrogatory.

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Additionally, applicant is reminded that it is under a continuing obligation to supplement its discovery responses in accordance with Federal Rule 26(e)(2), which provides as follows:

(2) A party is under a duty seasonably to amend a prior response to an interrogatory, request for production, or request for admission if the party learns that the response is in some material respect incomplete or incorrect and if the additional or corrective information has not otherwise been made known to the other parties during the discovery process or in writing.

Thus, as applicant learns of further facts and documents which support its affirmative defenses, it must supplement its response to this interrogatory.

*Interrogatory No. 16*

Applicant's objections to this interrogatory are not well taken. Applicant therefore must supplement its answer to this interrogatory to identify all the persons who participated and/or were consulted and/or supplied information in connection with the preparation of answers and responses to opposer's first set of interrogatories and opposer's first set of document requests.

*Document Request Nos. 3, 5, 6 and 33*

Applicant has objected to these document requests on the basis that they are overly broad, vague and indefinite, and that they seek privileged documents or documents protected by the work product doctrine. We agree that Request Nos. 3 and 33 are overly broad and deny the motion

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to compel with respect to Request Nos. 3 and 33. With respect to Request Nos. 6, we find that it can be suitably responded to if restricted in scope. Thus, applicant must produce all documents constituting, relating or referring to any application for registration of SKYBRIDGE in the United States (including any state applications for registration) and to the prosecution of such applications, with the exception of documents for which it claims privilege and/or for which it claims are subject to the work product doctrine. As for Request No. 5, applicant must provide all responsive documents without objection, except for objections based on the attorney-client privilege and/or work product doctrine.

*Document Request Nos. 10, 17, 18 and 21*

Applicant has objected to these document requests on the basis that they are overly broad, vague and indefinite. Most of these objections are well taken.

Turning first to Request No. 10, applicant's objections are well taken and the motion to compel regarding Request No. 10 is denied.

As for Request No. 17, the document request would not be objectionable if it were restricted in scope. Thus, applicant need only to produce all license agreements, and any amendments and/or modifications of any such license

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agreements, regarding use of the designation SKYBRIDGE *in the United States* in response to Request No. 17.

Next, with respect to Request No. 18, we consider each element of the request. First, applicant must produce all documents concerning the origin and selection of the mark. Second, in view of applicant's response to amended Interrogatory No. 1, applicant need not produce documents regarding the development and adoption *outside of the United States* of the designation SKYBRIDGE. However, if applicant begins to use the mark *in the United States* during the course of this proceeding, it must produce those documents regarding the development and adoption *in the United States* of the designation SKYBRIDGE. Third, in view of applicant's response to amended Interrogatory No. 1, applicant need not further respond or produce documents regarding first use of the designation SKYBRIDGE, unless it begins to use SKYBRIDGE *in the United States* during the course of this proceeding. Then, it need only produce documents regarding first use *in the United States* of the designation SKYBRIDGE. Fourth, applicant must produce those documents which relate or refer to the meaning and significance of the designation SKYBRIDGE.

Turning to Request No. 21, applicant must only produce the documents regarding applicant's marketing strategy involving the designation SKYBRIDGE as used on the services

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which are the subject of the involved application, and only with respect to applicant's marketing strategy in the United States.

*Document Requests Nos. 9 and 31*

According to applicant, opposer is "an individual who with his wife operates a computer repair business from his house." Thus, with respect to Request No. 9, applicant must produce all documents relating to or referring to use of SKYBRIDGE by or on behalf of opposer to the extent any such documents exist. With respect to Request No. 31, applicant must produce all responsive documents.

*Document Request Nos. 16, 20, 26 and 30*

Opposer's motion to compel regarding Request Nos. 16, 20, 26 and 30 is hereby denied in view of applicant's amended answer to Interrogatory No. 1. In the event applicant begins to use the mark which is the subject of this proceeding in the United States during the course of this proceeding, applicant must supplement its responses to Document Request Nos. 16, 20, 26 and 30 and produce all responsive documents.

*Document Request No. 25*

In view of applicant's objections and the substance of Document Request No. 24, opposer's motion to compel regarding Request No. 25 is denied.

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*Document Request No. 35*

We note that applicant has stated that it "has not, as yet, determined which documents support each and every affirmative defense in Applicant's Response to the Notice of Opposition." However, because applicant is under a continuing duty to supplement its discovery responses (see above), applicant, when it has determined which documents support the affirmative defenses in its answer, must supplement its response to this document request and provide responsive documents.

Because we have granted opposer's motion to compel in part, we order applicant to serve within **forty days** from the date of this order supplemental responses to opposer's first set of interrogatories and first set of document requests, and to produce all responsive documents, which are contemplated by this order. If documents responsive to a particular document request do not exist, applicant must so inform opposer. Also, applicant is ordered to serve within **forty days** from the mailing date of this order a privilege log on opposer in accordance with this order and with Federal Rule 26(b)(5). If applicant has not yet served a verified copy of its interrogatory answers on opposer,

applicant is ordered to do so within **forty days** from the mailing date of this order. See Federal Rule 33(b)(2).<sup>7</sup>

The parties and their attorneys are expected to cooperate with one another in the discovery process. Each party has a duty not only to make a good faith effort to satisfy the discovery needs of its adversary, but also to seek only such discovery as is proper and relevant to the issues in the case. See *Medtronic, Inc., v. Pacemaker Systems, Inc.*, 222 USPQ 80 (TTAB 1984).

Finally, we note the filing of the stipulated protective agreement. The parties are referred, as appropriate, to TBMP §§ 416.05 (Signature of Protective Order), 416.06 (Filing Confidential Materials With Board) and 416.07 (Handling of Confidential Materials by Board).

The parties are advised that only confidential or trade secret information should be filed pursuant to a stipulated protective agreement. Such an agreement may not be used as a means of circumventing paragraphs (d) and (e) of 37 CFR § 2.27, which provide, in essence, that the file of a published application or issued registration, and all proceedings relating thereto, should otherwise be available for public inspection.

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<sup>7</sup> Opposer's motion to compel answers under oath (filed as a part of its motion to compel) is granted.

**Cancellation No. 40,257**

This case now comes up on the following two motions:

(a) respondent's motion for judgment on the pleadings (filed May 3, 2002); and (b) respondent's motion to suspend (filed June 24, 2002 via facsimile, at the request of the Board).<sup>8</sup>

We first turn to respondent's motion to suspend.

Because respondent's motion for judgment on the pleadings is a potentially dispositive motion, and because Trademark Rule 2.127(d) requires that proceedings be suspended after the filing of a potentially dispositive motion, respondent's motion to suspend is hereby granted as well taken.

Proceedings are considered to have been suspended as of the filing of the motion for judgment on the pleadings.

Next, we turn to applicant's motion for judgment on the pleadings, based on the defense that the petition for cancellation fails to state a claim upon which relief can be granted. Because respondent only contests petitioner's allegation of priority, we only examine petitioner's allegation of priority.

We focus on paragraph 2 of the petition to cancel, which alleges that "Petitioner's Skybridge trade name and its SKYBRIDGE service mark has [sic] been extensively and

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<sup>8</sup> The Board did not receive the original motion to suspend. Also, the facsimile copy of the motion to suspend does not show proof of receipt by the U.S. Patent and Trademark Office, and does not bear a certificate of mailing.

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continuously used, advertised, and promoted in connection with its services since at least as early as December, 1996." Respondent contends that while petitioner has pleaded a likelihood of confusion and superior rights, "the Petition to Cancel nowhere makes any mention of Respondent's priority date based on its Section 44 registration"; that "the mere fact that Petitioner may have used the term SKYBRIDGE as a trade name and a mark since a date prior to the filing date of Respondent's registration does not establish Petitioner's priority with respect to the SKYBRIDGE mark"; and that paragraph 2 "does not allege any date of first use in commerce." Petitioner, in response, maintains that "[t]he fact that the Petition for Cancellation nowhere makes any mention of Respondent's priority date is not of any substance"; that the petition to cancel alleges that petitioner "has used the trade name SKYBRIDGE, on the same or closely related services as those listed in Respondent's Registration, since at least December, 1996 (more than six months prior to Respondent's filing date and priority date)"; and that the petition to cancel also alleges a likelihood of confusion. (Emphasis in the original.)

Registration No. 2,294,972, i.e., the registration sought to be cancelled in this proceeding, claims a Section 44(d) priority date of July 3, 1997 based on the filing of a

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French application. This date is later in time than the priority date claimed by petitioner in paragraph 2 of the petition to cancel, i.e., December, 1996. Thus, petitioner has properly alleged its priority of use in paragraph 2. That petitioner did not specifically state that this use was in interstate commerce is of no consequence; prior use of a designation in intrastate commerce is sufficient to sustain a petition for cancellation based on likelihood of confusion. See *Hess's of Allentown, Inc. v. National Bellas Hess, Inc.*, 169 USPQ 673 (TTAB 1971). Also, that petitioner did not specifically mention in its complaint that respondent's priority date is based on Section 44 is immaterial. Respondent's motion therefore is denied.

Additionally, the records of the U.S. Patent and Trademark Office reflect the recordation of an assignment of the registration involved in this proceeding, i.e., Registration No. 2,294,972, to Skybridge Limited Partnership. See Reel No. 2431 Frame No. 0814. In view thereof, and because Skybridge Limited Partnership has been joined as a party defendant in Opposition No. 115,516, we sua sponte join Skybridge Limited Partnership as a party defendant. See TBMP Section 512.01.<sup>9</sup>

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<sup>9</sup> Petitioner's motion (filed May 20, 2002) that respondent's motion to suspend be "dismissed" because "Alcatel Espace is not the proprietor of" the involved registration, is denied.

***Consolidation***

The Board has reviewed Opposition No. 115,516 and Cancellation No. 40,257. Because the parties are the same and the proceedings involve common questions of law or fact, in the interest of judicial economy, Opposition No. 115,516 and Cancellation No. 40,257 are hereby consolidated, and may be presented on the same record and briefs.<sup>10</sup> See Fed. R. Civ. P. 42(a).

If the parties to this proceeding are or become parties to other Board proceedings involving related marks during the pendency of Opposition No. 115,516 and Cancellation No. 40,257, they are hereby ordered, on a continuing basis, to inform the Board of any such proceeding so that the Board can consider consolidation of proceedings.

***Discovery and Trial Deadlines***

Proceedings in the opposition and cancellation proceedings are resumed and trial dates, including the close of discovery, for this consolidated proceeding are reset as follows:

THE PERIOD FOR DISCOVERY TO CLOSE:	November 30, 2002
30-day testimony period for party in position of plaintiff to close:	February 28, 2003
30-day testimony period for party in position of defendant to close:	April 29, 2003

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<sup>10</sup> The Board file will be maintained in Opposition No. 115,516 as the "parent" case, but all papers filed herein must include the proceeding numbers of both consolidated cases, in ascending order.

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15-day rebuttal testimony period for  
plaintiff to close:

June 13, 2003

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b), and an oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.