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

Proceeding	91178539
Party	Plaintiff SmithKline Beecham Corporation
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Attachments	AQUAJETT Reply Brief in Support of Motion to Amend the Notice of Opposition.pdf (5 pages)(402550 bytes)

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

SMITHKLINE BEECHAM CORPORATION	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No. 91/178,539
	:	
OMNISOURCE DDS, LLC	:	
	:	
Applicant.	:	

**OPPOSER’S REPLY BRIEF IN SUPPORT OF ITS
SECOND MOTION TO AMEND THE NOTICE OF OPPOSITION**

On April 8th Opposer, SmithKline Beecham Corporation, filed a motion to amend the notice of opposition. Opposer served a copy of that motion on Applicant, Omnisource DDS, LLC, on the same date.

Applicant’s filed a response to that motion, but filed it late, and as a result Applicant’s response should not be considered. However, even if Applicant’s response is considered, it does not provide any rationale to deny Opposer’s amendment of the notice of opposition. Applicant objects to the amendment on the premise that Applicant was denied an opportunity to conduct discovery on its own *bona fide* intent to use the mark. Needless to say, this argument makes no sense, because the purpose of discovery is to allow a party to learn about the other party. Applicant had no need to conduct discovery of itself, and has not demonstrated how it would otherwise be prejudiced by the proposed amendment.

ARGUMENT

Opposer sent its motion to amend to Applicant’s counsel by first class mail on April 8th. Thus, the deadline for responding to this motion was April 28th – twenty days after the motion was served on Applicant’s counsel. Applicant did not file a response to this motion until May 13th – thirty-five days after the motion was served. The rules specifically state that “a brief in response to a motion shall be filed within fifteen days from the date of service of the motion” or within twenty days from the date of service when the motion has been served by first class mail.

37 C.F.R. §§ 2.119(c) and 2.127(a). Because Applicant failed to respond to the motion to amend within the time allowed, Applicant's response should not be considered by the Board.

Even if the Board decides to consider Applicant's tardy response, Applicant has failed to provide any factual or legal basis for denying Opposer's motion to amend. Opposer has demonstrated that the lack of a *bona fide* intent to use a mark in commerce is a legitimate basis for opposing registration. Opposer has demonstrated that its Second Amended Notice of Opposition and its motion for summary judgment provide Applicant with fair notice of the factual and legal basis for this claim. Opposer has demonstrated that Applicant will not suffer any prejudice if this claim is added to the Notice of Opposition, because Opposer has not asked to take additional discovery of Applicant on this issue. (*See* Opposer's Second Motion to Amend at 4.) Applicant does not take issue with any of this.

Opposer also demonstrated that Applicant will not suffer any prejudice if this claim is added to the Notice of Opposition, because the new claim is based on Applicant's own action (or inactions), and based on documents and information that should be within Applicant's custody and control. (*See id.*) Applicant responds to this by claiming that its *bona fide* intent has never been a legitimate topic for discovery, because Opposer failed to mention this issue in its initial Notice of Opposition. Therefore, Applicant claims that it did not have "any burden or responsibility" to produce evidence concerning its plans for using the AQUAJETT mark. Now that the discovery period has closed, Applicant claims that it cannot defend itself against this new claim, because it has no means for introducing evidence of its intent into the record. (*See* Applicant's Response to Opposer's Motion to Amend ("App. Br.") at p. 2.)

That is simply not true. Opposer served Applicant with discovery requests explicitly directed at Applicant's *bona fide* intent to use its mark in commerce, and asked deposition questions about that *bona fide* intent. If Applicant did not fully respond to those discovery requests or did not honestly respond to those questions, that is Applicant's fault. Applicant cannot now object on the premise that it would have been more forthcoming if it had known that

those questions would matter. It was Applicant's responsibility to provide complete and honest answers to Opposer's discovery requests.

Opposer specifically asked Applicant to produce evidence demonstrating that it has a *bona fide* intent to use its mark in commerce. For example, Opposer asked Applicant to produce “[a]ll documents and things supporting Applicant’s claim of a bona fide intent to use AQUAJETT in commerce in connection with the goods described Applicant’s application” and “[a]ll documents and things which evidence the manner in which Applicant intends to use” this mark.¹ Opposer asked Applicant to produce specific types of documents that might tend to show that Applicant intends to use its mark in commerce, such as business plans, media plans, advertising, marketing, and promotional materials, and the like.² Opposer asked for similar information when it deposed the president of Omnisource, Dr. William R. Weissman.³ Opposer repeatedly asked about Applicant’s oral irrigator product and its plans for using its AQUAJETT mark, and even asked the witness to identify all of the documents in Applicant’s possession “that would relate in any way to [its] intention to use the mark AQUAJETT.”⁴

Applicant provided a substantive response to each of these requests. In fact, Applicant openly admits that “a claim of a lack of a bona fide intent was contained in Applicant’s pleadings [served] in the proceeding.” (Applicant’s Response to Opposer’s Motion for Summary Judgment at 2.) Therefore, Applicant cannot claim unfair surprise now that Opposer has sought to add a claim to the Notice of Opposition that is based on the evidence (or lack thereof) that was produced in discovery. If Applicant sincerely believed that it had “no obligation to produce such

¹ See Declaration of Erik Bertin, Ex. C, Req. 3, 6; Ex. D, Int. 10; Ex. E, Req. 11 (filed April 8, 2008 and submitted in support of Opposer’s Motion for Summary Judgment).

² See, e.g., Bertin Decl., Ex. F, Int. 17; Ex. G, Req. 2-5, 7, 9, 10; Exs. H & I, Req. 71-76, 87, 97.

³ See, e.g., Bertin Decl., Ex. A, Weissman Dep. at 34, 39-41, 43-49.

⁴ See, e.g., Bertin Decl., Ex. A, Weissman Dep. at 47.

documentation” (App. Br. at 2), it should have objected to Opposer’s discovery requests, and if necessary, it should have asked the Board to issue an order stating that Applicant’s *bona fide* intent is off-limits in this proceeding. Applicant waived its right to raise these objections, by refusing to assert them when the requests were served and by providing a substantive response to each and every one of these requests.

Finally, Applicant argues that the Board should reopen the discovery period in order to give “Applicant additional time to introduce evidence supporting its *bona fide* intent to use its mark in commerce.” (App. Br. at 3.) This request makes no sense. Applicant is asking the Board to reopen discovery to allow Applicant to take discovery of its own *bona fide* intent. There is no basis for this request. Opposer’s new claim is based on Applicant’s own actions (or inactions), and based on documents and information that should be within the Applicant’s custody and control – documents and information that Applicant should already have furnished to Opposer in discovery.

In any event, Applicant does not claim to have any new evidence that would be relevant to the issue of its *bona fide* intent. It has cited certain patents that belong to Dr. Weissman and others, certain trade shows that Dr. Weissman has attended, and the fact that Dr. Weissman has been a practicing dentist for many years. (See App. Br. at 1.) However, all of this evidence was produced during discovery and has been entered into the record in connection with Opposer’s motion for summary judgment.⁵

⁵ See Bertin Decl., Ex. A, Weissman Dep. at 18-19, 41-42 & Weissman Dep. Exs. 2, 3, 4; see also Bertin Decl. Ex. B, Int. 2, 3; Ex. G, Req. 6.

CONCLUSION

For the foregoing reasons, Opposer respectfully requests that the Board grant the motion to amend and enter the Second Amended Notice of Opposition into the record.

Dated: June 2, 2008

Respectfully submitted,

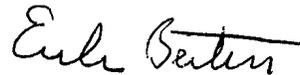


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Certificate of Service

I hereby certify that a true and correct copy of Opposer's Reply Brief in Support of its Second Motion to Amend the Notice of Opposition has been duly served by mailing such copy first class, postage prepaid, to Erik M. Pelton, P.O. Box 100637, Arlington, VA 22210 on June 2, 2008.



Erik Bertin