

October 28, 2008

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

Attn: Trademark Trial and Appeal Board

Re: Reply Brief in Support of Motion to Compel

Marks: AQUAJETT  
Applicant: Omnisource DDS, LLC  
Serial Nos.: 78/893,144  
Opposition Nos.: 91178539

To the Commissioner for Trademarks:

On behalf of SmithKline Beecham Corporation, I enclose for filing a Reply Brief in Support of Motion to Compel.

Respectfully submitted,



Kristina M. Case

KMC:jcr  
Enclosures

cc: Erik M. Pelton, Esq.



10-28-2008

U.S. Patent & TMO/™ Mail Rpt. Dt. #28

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

SMITHKLINE BEECHAM CORPORATION	:	
	:	
Opposer,	:	
	:	
v.	:	OPPOSITION NO. 91178539
	:	
OMNISOURCE DDS, LLC	:	
	:	
Applicant.	:	

**REPLY BRIEF IN SUPPORT OF MOTION TO COMPEL**

Opposer, SmithKline Beecham Corporation, demonstrated that Applicant, Omnisource DDS, LLC, failed to provide full and complete responses to Opposer’s interrogatories.

Applicant has failed to demonstrate that Opposer lacked good faith in filing this motion or that Applicant should not be required to supplement its interrogatory responses. Accordingly, the Board should grant Opposer’s motion and compel Applicant to provide full and complete responses.

**Argument**

**A. Opposer Filed Its Motion To Compel In Good Faith**

Applicant claims that Opposer’s motion should be denied, because Opposer did not submit a “separate signed statement from [Opposer’s] attorney that he has made a good faith effort to resolve the issues presented in the Motion.” (Applicant’s Brief at 1.) Section 523.02 of the TBMP states that a motion to compel must be supported by a written statement that the moving party has made a good faith effort to resolve the dispute. However, there is nothing in the rule to suggest that this statement must be made in a separate document. Opposer’s opening



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brief clearly states that “Opposer has made a good faith effort to resolve this dispute,” and Applicant does not claim that this statement is otherwise deficient in any way. (Opposer’s Brief at 2.)

As detailed in Opposer’s motion, Opposer’s counsel made a good faith effort to resolve this dispute before bringing this dispute to the Board. Opposer identified certain deficiencies in Applicant’s discovery responses, and to its credit, Applicant agreed to correct some – but not all – of those deficiencies.<sup>1</sup> However, Applicant’s counsel informed Opposer’s counsel in writing that Applicant would not provide a supplemental response to interrogatory numbers 1, 2, 4, 5, 8-13, 15, 16, and 22-26 from Opposer’s Second Set of Interrogatories. (See Exhibit C to Opposer’s Motion.) Opposer was not required to take any additional action, because Applicant made it clear that additional responses would not be provided. Thus, Opposer was entitled to bring these issues directly to the Board.

Applicant admits that Opposer’s motion was filed in a timely manner. Nevertheless, Applicant claims that the timing of the motion demonstrates a lack of good faith, because it was filed the day before the testimony period was scheduled to begin. It is well established that a motion to compel must be filed before the start of the testimony period. (TBMP § 523.01.) Under the previous schedule, Opposer’s testimony period was scheduled to begin on October 20th. In order to preserve its right to obtain discovery, Opposer had no choice but to file the motion when it did. Applicant claims that Opposer should have filed a motion to postpone the

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<sup>1</sup> Statements made in a letter from opposing counsel are not admissible at trial. Therefore, Applicant should incorporate this information into a formal interrogatory response, and should supplement its document production with the additional documents that Applicant agreed to produce.

start of the testimony period rather than filing a motion to compel. As Opposer explained in its opening brief, Applicant refused to extend the deadlines in this proceeding by agreement of the parties. The Board has cautioned that there is no guarantee that it will act upon a non-consented motion to extend or that the motion will be granted. (TBMP § 509.02) If Opposer filed a motion to extend and the motion was denied, Opposer would lose the opportunity to obtain the withheld discovery from Applicant and would lose a substantial portion of its testimony period.

Finally, Applicant claims that this motion is improper because Opposer filed a motion for summary judgment purportedly based on the same discovery that is being sought in this motion. However, Opposer's motion for summary judgment was based solely on the issue of Applicant's *bona fide* intent. (See docket entry 13 at pages 1-2.) The discovery Applicant has failed to produce – which is the subject of this motion – is relevant to the issue of likelihood of confusion, such as differences in the marks, third party marks, and the customers and channels of trade for the Applicant's products.

**B. Applicant Should Be Compelled To Supplement Its Interrogatory Responses**

**1. The Meaning and Impression of the Marks (Interrogatory Nos. 1, 2, and 4)**

Applicant claims that it did not respond to interrogatories regarding the meaning its mark and Opposer's mark, because the meaning "is discernable from common reference materials, including dictionaries." However, Applicant's AQUAJETT mark and Opposer's AQUAFRESH marks are coined. These are not words that could be looked up in a dictionary or any other reference material.

Applicant claims that the meaning of the marks is "clearly protected by the doctrine of attorney work product." (Applicant's Brief at pages 4-5.) However, Applicant waived any claim

of privilege in the meaning and overall impression of the marks, by raising these issues in its affirmative defenses and by providing information concerning the commercial impression and visual impression of the marks in its responses to interrogatories 1, 2, 3, and 4. (*See* Opposer's Brief, Ex. A at pages 1-3.)

**B. Third Party Marks (Interrogatory No. 5)**

Applicant claims that “[a]ny information of Applicant regarding third party uses of AQUA was derived from the work of Applicant’s attorneys and is not discoverable.” (Applicant’s Brief at page 5.) These alleged third party marks are the proper subject of discovery, because Applicant put them directly at issue by citing them in its affirmative defenses. Applicant claims that this information is work product, because it was developed by Applicant’s counsel. However, Applicant provided similar information in its response to Opposer’s document requests, and thus, has waived whatever privilege that it may claim in this information. (*See* Applicant’s Responses to Opposer’s Document Request No. 14, enclosed as Exhibit A.)

Applicant claims that it already provided this information at the deposition of Applicant’s president, Dr. William Weissman. The portion of the transcript that is attached to Applicant’s brief only mentions one third party mark – WATERPIK– a mark that does not contain the term AQUA. If, as alleged in its 7<sup>th</sup> affirmative defense, Applicant is aware of third party AQUA marks and intends to reply on them in this proceeding, those marks should be disclosed.

**C. Applicant's Products (Interrogatories 8-12)<sup>2</sup>**

Applicant claims that the information requested in Interrogatories 8-12 was provided during the deposition of Applicant's president. (Applicant's Brief at pages 5-6.) Applicant's brief contains extensive quotes from the deposition transcript, but none of these passages identify the channels of trade for Applicant's products. Likewise, the cited portions of the transcript do not identify any of the prospective users of Applicant's products – aside from the deponent's own patients. Because Applicant's classification of goods is not limited to any particular class of customers – much less the deponent's own patients – Applicant should be required to identify the classes of customers for its products in a formal interrogatory response.

**D. Competing Products (Interrogatory Nos. 15, 16, 22-26)**

Opposer asked Applicant to identify the "other similar goods" referenced in its response to Interrogatory No. 15. In response, Applicant points to the deposition testimony of its president, who mentioned toothpicks and chewing gum. If "toothpicks" and "chewing gum" are the "other similar goods," Applicant should mention those items in its interrogatory response. If there are any other goods that fall into the "other similar goods" category that were not mentioned in the deposition transcript, these goods should be disclosed as well.

Finally, Applicant claims that it is unduly burdensome to identify the "other products" that are likely to compete with its oral irrigators. Applicant could easily respond to this request by identifying the general types of products that are expected to compete with its oral irrigators, and a representative sampling of brand names for those products. Applicant cited a number of

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<sup>2</sup> Applicant correctly notes that it clarified its response to Interrogatory No. 8 in a letter from opposing counsel. (Applicant's Brief at page 6.) Opposer has not moved to compel a response to this interrogatory. Opposer's motion is directed at Applicant's responses to Opposer's Second Set of Interrogatories, which are deficient.

examples in its brief – namely, oral irrigators, dental floss, interdental brushes, interdental pics – which confirms that this request is not unduly burdensome. However, statements in a legal brief are not admissible at trial, so Applicant should be required to incorporate this information into a formal interrogatory response.

**Conclusion**

For the foregoing reasons, Opposer respectfully requests that the Board issue an order compelling Applicant to supplement its responses to Opposer’s Second Set of Interrogatories Nos. 1, 2, 4, 5, 8, 9, 10, 11, 12, 13, 15, 16, 22, 23, 24, 25, and 26.

Respectfully submitted,



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Dated October 28, 2008

Attorneys for Opposer  
SMITHKLINE BEECHAM  
CORPORATION

Certificate of Mailing by Express Mail

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Post Office to Addressee, in an envelope addressed to: Commissioner for Trademarks, Attention: Trademark Trial and Appeal Board, P.O. Box 1451, Arlington, Virginia 22313-1451 on October 28, 2008.

Kristina Case  
Person Signing Certificate

October 28, 2008  
Date of Signature

  
Signature

EV 855678195 US  
Express Mail Number

Certificate of Service

I hereby certify that a true and correct copy of Reply Brief in Support of Motion to Compel has been duly served by mailing such copy first class, postage prepaid, to Erik M. Pelton, Erik M. Pelton & Associates, PLLC, P.O. Box 100637, Arlington, Virginia 22210, on October 28, 2008

  
Kristina M. Case

**EXHIBIT A**

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

SMITHKLINE BEECHAM CORPORATION,	)	
	)	
Opposer,	)	IN THE MATTER OF:
	)	
vs.	)	<b>Opposition No. 91178539</b>
	)	
OMNISOURCE DDS, LLC,	)	
	)	
Applicant.	)	

**APPLICANT'S OBJECTIONS AND RESPONSES TO OPPOSER'S FIRST  
REQUESTS FOR PRODUCTION OF DOCUMENTS AND THINGS**

**I. PRELIMINARY STATEMENT**

Applicant is presently pursuing its investigation and analysis of the facts and law relating to this case and has not yet completed preparation for the Opposition proceedings. The responses set forth herein are given without prejudice to Applicant's right to develop any theory or produce or use any subsequently discovered or previously unknown facts, documents or evidence, or to add to, modify or otherwise change or amend the responses herein. These responses are based upon writings and information currently available to Applicant. The information set forth is true and correct to the best knowledge of Applicant as of this date, and is subject to correction for inadvertent errors, mistakes or omissions.

**II. GENERAL OBJECTIONS**

Applicant objects to each Request on the following grounds:

1. Applicant objects each and every Request, including the definitions and instructions, to the extent the requests (a) contain requests that exceed the scope and requirements of the applicable federal and local rules and (b) purport to require discovery not

14. All documents and things which relate to the use of any third party marks which comprise or include the term AQUA or any variation thereof in connection with oral care goods and/or Applicant's awareness thereof.

**Response:**

In addition to the general objections above, Applicant objects to this Request as overly broad and open ended, burdensome, irrelevant, and requesting materials which are privileged and/or attorney-work product.

Notwithstanding and without waiving these objections, Applicant responds:

See USPTO records regarding Serial Numbers 78312007, 78722367, 78617811, 76575470, 76449343, 76275969, 76069024, 73257455, 73161110, 76594979 and 74025271.

Dated: November 8, 2007

OMNISOURCE D.D.S., LLC

By:   
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