

ESTTA Tracking number: **ESTTA281915**

Filing date: **05/05/2009**

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

Proceeding	91178539
Party	Defendant Omnisource DDS, LLC
Correspondence Address	ERIK M. PELTON ERIK M. PELTON & ASSOCIATES, PLLC P. O. BOX 100637 ARLINGTON, VA 22210 UNITED STATES emp@tm4smallbiz.com
Submission	Opposition/Response to Motion
Filer's Name	Erik M. Pelton
Filer's e-mail	uspto@tm4smallbiz.com
Signature	/ErikMPelton/
Date	05/05/2009
Attachments	AQUAJETT - Response to Opposers Motion to Strike - FINAL.pdf ( 6 pages ) (37550 bytes )

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

SmithKline Beecham Corporation  
Opposer,

v.

Omnisource DDS, LLC,  
Applicant.

Opposition No. 91178539

Application Serial No. 78893144

Mark:

**AQUAJETT**

**RESPONSE TO OPPOSER’S MOTION TO STRIKE APPLICANT’S TESTIMONY**

Applicant hereby responds to Opposer’s Motion to Strike Applicant’s Testimony and requests the Board deny each relief requested for the following reasons:

**I. DISCOVERY DEPOSITION TESTIMONY  
(EXHIBIT 2 TO APPLICANT’S NOTICE OF RELIANCE)**

Opposer first introduced portions of the deposition transcript of William R. Weissman, President of Applicant in Opposer’s testimony. See Opposer’s Fifth Notice of Reliance. Opposer submitted “portions” of the deposition consisting of more than 40 pages. The entire deposition transcript consists of 56 pages.

Applicant submitted as testimony the entire deposition in order to provide a more clear picture of the deposition portions submitted by Opposer. “If only part of a discovery deposition is submitted and made part of the record by a party, an adverse party may introduce under a notice of reliance any other part of the deposition which should in fairness be considered so as to make not misleading what was offered by the submitting party.” Trademark Rule 2.120(4).

In addition, pursuant to Trademark Rule 2.120(j)(7), “When a discovery deposition, or a part thereof, or an answer to an interrogatory, or an admission, has been made of record by one party in accordance with the provisions of paragraph (j)(3) of this section, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.”

Portions of the deposition of William R. Weissman, President of Applicant, are particularly useful because the Board requires more than mere allegations and assertions in defending a claim that an Applicant lacked a bona fide intent to use its mark. See discussion below in Section IV. In order to provide a full and clear record of the statements made in the deposition, and the evidence referred to therein, more than the mere excerpts submitted by Opposer are necessary.

Opposer submitted portions of more than half of the deposition transcript, yet it seeks to prevent submission of the remaining portions. Taken out of context, statements can often be given distorted meaning. The entire context of the deposition is necessary to provide a fair and accurate record of the statements made therein, and is properly introduced by Applicant for that purpose under Trademark Rule 2.120

## **II. DECLARATION OF APPLICANT’S PRESIDENT (EXHIBIT 7 TO APPLICANT’S NOTICE OF RELIANCE)**

Applicant submitted a declaration from its President in Exhibit 7 to Applicant’s Notice of Reliance. The declaration was properly introduced because it is true and authentic, matters which have not been disputed by Opposer. Opposer’s motion states that “[t]he rules do not allow a party to introduce testimony in the form of written declaration.” Opposer does not cite any authority for its proposition. The declaration from Applicant’s president was properly

introduced even though it was previously part of the record filed in connection with a motion for summary judgment.

### **III. APPLICANT'S DISCOVERY RESPONSES (EXHIBIT 8 TO APPLICANT'S NOTICE OF RELIANCE)**

Opposer has moved to strike excerpts from Opposer's Interrogatories and Requests for Admission, together with Applicant's responses to the requests (Exhibit 8 to Applicant's Notice of Reliance). Applicant submitted the interrogatory and admission responses pursuant to TBMP § 704.10 and 37 CFR 2.120(j). Applicant needs to rely upon each of these so as not to make misleading the interrogatory and admission responses.

Specifically, Applicant's interrogatory and admission responses address Opposer's claim that Applicant lacked a bona fide intent to use its mark. Applicant's submission of responses is necessary to provide a more complete picture regarding the actions and intention of Applicant to demonstrate that it indeed had a bona fide intent to use its mark.

Opposer further argues that the admission responses submitted by Applicant consist of denials that are not admissible. However, Applicant did not submit the responses to requests for admission under Rule 2.120 (j)(3)(i), Applicant needs to rely upon each response in its Exhibit 8 to Applicant's Notice of Reliance so as not to make misleading the interrogatory and admission responses offered by Opposer in its Seventh Notice of Reliance regarding Applicant's bona fide intent to use its mark. Applicant submitted the responses under Rule 2.120 (j)(5), which provides that

“An answer to an interrogatory, or an admission to a request for admission, may be submitted and made part of the record by only the inquiring party except that, if fewer than all of the answers to interrogatories, or fewer than all of the admissions, are offered in evidence by the inquiring party, the responding party may introduce under a notice of reliance any other answers to interrogatories, or

any other admissions, which should in fairness be considered so as to make not misleading what was offered by the inquiring party.”

Because Opposer introduced portions of Applicant’s interrogatory and admission responses which related to Applicant’s intent to use its mark, the submission of other responses by Applicant – including admissions or denials – in Applicant’s testimony was proper.

#### **IV. EXHIBITS 11, 12, AND 13 TO APPLICANT’S NOTICE OF RELIANCE**

Applicant has submitted the documents in Exhibits 11, 12, and 13 to Applicant’s Notice of Reliance pursuant to Rule 2.120(j) in order make not misleading what was offered by Opposer. These documents are particularly useful because the Board requires documentary evidence in defending a claim that an Applicant lacked a bona fide intent to use its mark. *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993) (“absent other facts which adequately explain or outweigh the failure of an applicant to have any documents supportive of or bearing upon its claimed intent to use its mark in commerce, the absence of documentary evidence on the part of an applicant regarding such intent is sufficient to prove that the applicant lacks a bona fide intention to use the mark in commerce as required by Section 1(b).”). Regarding an intention to use the mark “[A]pplicant's showing should be 'objective' in the sense that it is evidence in the form of real life facts measured by the actions of the applicant, not by the applicant's later arguments about his subjective state of mind." *Intel Corp. v. Emeny*, Opposition No. 91123312 (May 15, 2007) [not precedential].

The production of Applicant’s documents in Exhibit 12 after the close of discovery has in no way prejudiced Opposer. Rather, Opposer’s allegation of a lack of a bona fide intent to use Applicant’s mark has caused Applicant to search and re-search its records on multiple occasions

to produce as much documentation as possible regarding its “intent” and the events captured on paper which document it.

Because the documents in Exhibits 11, 12, and 13 to Applicant’s Notice of Reliance are so valuable in order to not make misleading the testimony responses submitted by Opposer, they should not be stricken.

WHEREFORE, Applicant respectfully requests the Board deny Opposer’s Motion to Strike Applicant’s Testimony in its entirety.

Dated this 5th day of May, 2009.



---

Erik M. Pelton  
ERIK M. PELTON & ASSOCIATES, PLLC  
PO Box 100637  
Arlington, Virginia 22210  
TEL: (703) 525-8009  
FAX: (703) 525-8089

Attorney for Applicant

**CERTIFICATE OF SERVICE**

I hereby certify that a true and accurate copy of RESPONSE TO OPPOSER'S MOTION TO STRIKE APPLICANT'S TESTIMONY has been served on the following by delivering said copy on May 5, 2009, via First Class Mail, postage prepaid, to counsel for Opposer at the following address:

Glenn A. Gundersen  
Dechert LLP  
Cira Centre, 2929 Arch Street  
Philadelphia, PA 19103-2808

By:  \_\_\_\_\_  
Erik M. Pelton, Esq.