

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Mailed: June 10, 2009

Opposition No. 91178539

SmithKline Beecham Corporation

v.

Omnisource DDS, LLC

**Linda Skoro, Interlocutory Attorney**

This case comes up on cross-motions to strike portions of each party's notices of reliance. Applicant moves to strike opposer's Exhibit A to its second, third, and fourth notice of reliance as well as its ninth notice, filed March 7, 2009. Opposer's motion, filed April 30, 2009, seeks to strike applicant's Exhibits 2, 7, 8, 11, 12 and 13 to its notice of reliance. Each party has responded to the respective motions.

Applicant's Motion to Strike

Exhibit A to each of opposer's second, third and fourth notice of reliance consists of lists from three NEXIS databases.<sup>1</sup> Opposer's ninth notice of reliance is the

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<sup>1</sup> The search results are from the categories of "All News" (Notice of Reliance 2); "Major Newspapers" (Notice 3) and "US Newspapers" (Notice 4). An illustrative sample is: "Marketing

testimonial deposition of a witness involving another proceeding, unrelated to the matter before the Board.

The ground for applicant's motion to strike the lists (Exhibit A to Notices 2, 3 and 4) is that they are not complete copies of printed publications or complete electronic copies. Trademark Rule 2.122(e) allows for printed publications to be introduced into evidence through a notice of reliance. The Board accepts articles or excerpts taken from the NEXIS database as evidence as they are generally considered an electronically generated document which is the equivalent of the printed publication. See *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 940, 942 n.6 (TTAB 1985). However, printouts from databases which themselves comprise abstracts or syntheses of published documents, unlike the actual text of the documents, are hearsay as to the context of a term, and therefore inadmissible. Thus, because the objection to Exhibit A to the notices of reliance two, three and four is substantive in nature, the motion to strike these items is deferred until final hearing. Applicant should renew these objections in its brief on the case, if it wishes to maintain them.

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Week, May 25, 2006, Thursday Pg. 11; 221 words, GSK in talks over #50m Euro account...hygiene products, including Aquafresh and Sensodyne. The agency also works..." [236 items in the list as Exhibit A to the second notice of reliance.]

Opposer's ninth notice of reliance consists of a testimonial deposition from another proceeding.<sup>2</sup> Trademark Rule 2.122(f) provides that testimony from another proceeding may be used provided it is between the same parties or those in privity, relevant and material and subject to the right of any adverse party to recall the witness whose testimony is being offered. Opposer's ninth notice of reliance is testimony from a proceeding over ten years ago, not between the same parties and has not been the subject of a motion to allow introduction of such testimony. Accordingly, applicant's motion to strike opposer's ninth notice of reliance is hereby granted, and that document will be given no further consideration.

Opposer's Motion to Strike

Opposer objects to applicant's Exhibit 2, which is the complete discovery deposition of its president, Dr. William R. Weissman, taken February 27, 2008. Applicant states it has submitted the complete deposition pursuant to Trademark Rule 2.120(j)(4) in response to applicant's submission of parts of the deposition under Trademark Rule 2.120(j)(3). However, Rule 2.120(j)(4) allows only for submission of "any other part of the deposition which should in fairness be

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<sup>2</sup> The testimony is of Mr. Richard D. McWilliams, Senior Brand Equity Manager for AQUAFRESH toothpaste brand; taken on December 12, 1996 in Cancellation No. 92023622.

considered so as to make not misleading what was offered by the submitting party." Further, opposer's "notice of reliance must be supported by a written statement explaining why the adverse party needs to rely upon **each** additional part listed in the adverse party's notice, failing which the Board...may refuse to consider the additional parts."

Opposer's submission of the entire deposition is therefore outside the scope of Trademark Rule 2.120 and is hereby stricken. Opposer is allowed **thirty** days from the mailing date of this order to resubmit only those excerpts of the discovery deposition necessary to make not misleading the portions applicant has submitted, together with the required statement of its need to rely on the additional parts, failing which the Board will not consider the additional parts. See Trademark Rule 2.120(j)(4).

Applicant's Exhibit 7 is the declaration of applicant's president, dated February 13, 2008, and had previously been submitted in support of its response to opposer's motion for summary judgment last year. As grounds for its motion to strike this exhibit, opposer states that a declaration submitted in conjunction with a summary judgment is not of record unless properly introduced as testimony,<sup>3</sup> and the rules do not allow a declaration into evidence unless stipulated to by the parties.

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<sup>3</sup> See TBMP § 528.05(a) and cases cited therein.

Opposer is correct. Trademark Rule 2.123(b) specifically provides that the testimony of any witness may be submitted in affidavit (or declaration) form, but only pursuant to a written agreement of the parties. Applicant has presented no evidence of any such written agreement and opposer's objections make it obvious there was no such agreement. Accordingly, opposer's objections are sustained and the declaration, applicant's Exhibit 7, is hereby stricken.

Applicant's Exhibit 8 consists of selected responses<sup>4</sup> of applicant to opposer's written discovery requests. Trademark Rule 2.120(j)(5) allows for the introduction of discovery responses by only the inquiring party, unless fewer than all were submitted by the inquiring party, then the responding party may introduce any other answers it wishes considered in fairness so as to make not misleading what was offered by opposer. In opposer's notice of reliance numbers six and seven, it has introduced applicant's selected responses to discovery, thereby allowing for applicant to provide additional answers to allow for a fair reading of the evidence.<sup>5</sup> However, while

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<sup>4</sup> Opposer's first set of interrogatories, no. 7; opposer's second set of interrogatories, numbers 1, 2, 4, 6-10; opposer's request for admissions numbered 110, 112, 114, 116 and 174.

<sup>5</sup> As for the requests for admissions, Trademark Rule 2.120(j)(3) and (5) allow for only "admissions" to requests for admissions to be entered into evidence and applicant's additional responses are

these responses filed by applicant are appropriate, the notice of reliance they were filed under does not fully explain why it needs to rely upon **each** of the additional discovery responses. Accordingly, applicant is allowed **thirty** days from the mailing date of this order to supplement its notice of reliance to explain the necessity of the additional responses beyond "fairness and misleading".<sup>6</sup>

Finally, opposer moves to strike Exhibits 11 through 13,<sup>7</sup> contending they are untimely, in that they were the proper subject of discovery requests and not produced until after opposer's testimony period had closed.<sup>8</sup> Further, Trademark Rule 2.122(j)(3) does not provide for the

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denials. In that denials are not allowed under the rule, applicant's responses to opposer's requests for admissions numbered 110, 112, 114, and 116 will be given no consideration. In that the response to request for admission number 174 is an admission, that response will remain of record.

<sup>6</sup> Applicant should provide the reason as to why the additional response counters, is inconsistent with or neutralizes the response submitted by opposer.

<sup>7</sup> Applicant's notice of reliance on its own production of documents has identified the documents as OMNISOURCE 000017-18; 000033-43 and 000027-32.

<sup>8</sup> Fed. R. Civ. P. 26(e) provides that a party has a continuing duty to supplement its discovery responses. However, a party responding to discovery, due to an incomplete search of its records, provides an incomplete response to a discovery request, may not thereafter rely at trial on information from its records which was properly sought in the discovery request but was not included in the response thereto. Opposer has objected to this evidence. The documents submitted contain dates from 2004 - 2008, but were not produced until February 10, 2009. Thus, because applicant's supplemented production was not done in a

introduction of documents, other than official records and printed publications, through a notice of reliance alone, but must be provided in conjunction with obtaining responsive documents from another party through discovery. Another method of introduction would be as an exhibit to a testimonial deposition, but introducing its own documents through a notice of reliance is not provided for under the rules. Accordingly, applicant's Exhibits 11, 12 and 13 are hereby stricken.

In sum, applicant's motion to strike is granted as to opposer's Ninth Notice of Reliance, and the decision to strike Exhibit A to Notices 2, 3 and 4 as hearsay is deferred until final hearing. Opposer's motion to strike is granted as to Exhibits 7, 11-13; Exhibit 2 is stricken, however, applicant is allowed thirty days from the mailing date of this order to resubmit the relevant portions of Exhibit 2 with a complete explanation of the need for these portions and thirty days to supplement the notice of reliance provided with Exhibit 8; and applicant's denials to requests for admissions 110, 112, 114, and 116 in Exhibit 8 are stricken.

Proceedings herein are resumed and the remaining trial date, opposer's rebuttal period, is hereby reset as indicated below. Briefs shall be filed in accordance with

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timely fashion, even if it had been properly introduced, it

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Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

DISCOVERY PERIOD TO CLOSE: **CLOSED**

30-day testimony period for party in position of plaintiff to close: **CLOSED**

30-day testimony period for party in position of defendant to close: **CLOSED**

15-day rebuttal testimony period for plaintiff to close: **August 15, 2009**

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.

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cannot be relied upon by applicant.