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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 -- Opposer's Motion to Strike Applicant's Supplemental Notice of Reliance.pdf (11 pages)(455858 bytes)

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.	:	

OPPOSER'S MOTION TO STRIKE
APPLICANT'S SUPPLEMENTAL NOTICE OF RELIANCE

Opposer, SmithKline Beecham Corporation, moves to strike Applicant, Omnisource DDS, LLC's Supplemental Notice of Reliance. Opposer respectfully requests that the Board suspend the deadlines in this proceeding until it has ruled on this motion.

Applicant filed its initial Notice of Reliance on April 16th (Docket No. 33) and Opposer filed a motion to strike that evidence on April 30th (Docket No. 34). In its Order dated June 10th (the "Order"), the Board granted Opposer's motion to strike Exhibits 2 and 8 to Applicant's initial Notice of Reliance, but gave Applicant an opportunity to correct its Notice of Reliance and to resubmit some of the evidence cited therein (Docket No. 38). Applicant filed its Supplemental Notice of Reliance on June 30th (Docket No. 39).

Applicant has failed to comply with the Board's Order. Applicant failed to submit a copy of the specific portions of the discovery deposition transcript that it intends to rely upon in this proceeding. Applicant attempted to reintroduce four discovery responses which were deemed inadmissible in the Order. Moreover, Applicant's Supplemental Notice of Reliance failed to explain why the deposition testimony and discovery responses cited therein are needed to counter or neutralize the evidence that Opposer submitted with its Notices of Reliance. Because this motion can be resolved simply by reviewing the face of Applicant's Supplemental Notice of Reliance, Opposer respectfully requests that the Board rule on this motion before the trial period begins.

I. APPLICANT'S DISCOVERY DEPOSITION TESTIMONY IS INADMISSIBLE

A. Applicant Failed to Submit the Portions of the Discovery Deposition Transcript Cited in Its Supplemental Notice of Reliance

Applicant's Supplemental Notice of Reliance should be excluded, because Applicant failed to submit a copy of the specific portions of the discovery deposition transcript that it intends to rely upon in this proceeding.

In its initial Notice of Reliance Applicant submitted a complete copy of the discovery deposition of Applicant's president. The Board ruled that the submission of the entire deposition was improper, because Rule 2.120(j)(4) "allows only for submission of '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.'" (Order at 3-4.) Accordingly, the deposition transcript and the exhibits thereto were "stricken" from Applicant's initial Notice of Reliance. (*See* Order at 4, 7, excluding Exhibit 2.)

Although the Board threw out the entire deposition transcript, the Board gave Applicant an opportunity "to resubmit only those excerpts of the discovery deposition necessary to make not misleading the portions [opposer[1]] 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." (Order at 4.) This is consistent with Rule 2.120(j)(3)(i) which states that "a discovery deposition . . . which may be offered in evidence" – including a discovery deposition which may be offered as rebuttal evidence under Rule 2.120(j)(3)(ii) – "may be made of record in the case by filing the deposition or any part thereof . . . together with a notice of reliance."

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[1] There are five typos on pages 3 and 4 of the Order where the Board referred to "Opposer" when it clearly meant to refer to the "Applicant" (or *vice versa*). There is no need for the Board to correct these typos, because as discussed above, Applicant clearly understood that the Order directed Applicant (not Opposer) to resubmit the specific portions of the discovery deposition that it intends to rely upon in this proceeding.

Omnisource admitted that the Order "directs Applicant to resubmit the relevant portions of the deposition," but it ignored that directive (Supplemental Notice of Reliance at 1.) Applicant claims that it did not attach the relevant pages to its Supplemental Notice of Reliance, because they were included in the entire deposition transcript which was submitted with its initial Notice of Reliance. (Supplemental Notice of Reliance at 1, footnote 1.) However, the Order specifically stated that the entire deposition transcript was "stricken" from the record and would be given no further consideration. (Order at 7.)

Because Omnisource failed to resubmit the specific pages of the transcript that it intends to rely upon in this proceeding, the Board should strike the section of Applicant's Supplemental Notice of Reliance which appears under the heading "Exhibit 2." If the Board grants this request, then it need not consider Section I.B of this Motion to Strike and instead may proceed directly to Section II of Opposer's brief.

B. Applicant Failed to Provide Sufficient Justification for Allowing It to Rely on the Discovery Deposition Pages Cited in the Supplemental Notice of Reliance

Applicant's Supplemental Notice of Reliance should be given no consideration, because Applicant failed to explain why it should be allowed to rely on the portions of the deposition transcript cited therein.

The Board directed Applicant to resubmit "only those excerpts of the discovery deposition" transcript which were "necessary to make not misleading the portions [Opposer] has submitted," and to provide "a complete explanation" as to "why [it] needs to rely upon **each** additional part" of that transcript. (Order at 4, 7, emphasis in original.) The Board warned the Applicant that if it failed to comply with these directives, the Board would "not consider the additional parts" of the transcript cited in Applicant's Supplemental Notice of Reliance (*Id.* at 4.)

Applicant intends to rely upon five sections of the discovery deposition transcript of Applicant's president, William Weissman,[2] and one of the exhibits which was introduced during that deposition.[3] Applicant explains that these sections of the transcript cover the following topics:

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[2] Some of the pages cited in Applicant's Supplemental Notice of Reliance were submitted

* "Dr. Weissman's description of Applicant's product, its market, and its functions, potential consumers, along with possible brand names"

* "Dr. Weissman's description of Applicant's principle patents and possible licensing of the products, including sending letters to potential licensees"

* "Dr. Weissman's description of possible sales channels"

* "Dr. Weissman's description of trade show attendance"

* "Minutes from meetings of Applicant's partners" (Supplemental Notice of Reliance at 2-4.)

Applicant claims that it needs to rely on these sections of the transcript in order to respond to the statement that Applicant provided in its response to Opposer's Interrogatory No. 10. The Board allowed Applicant to use portions of the discovery deposition for the limited purpose of responding to testimony that Opposer submitted from the same deposition transcript. The Board did not allow Applicant to offer deposition testimony for the purpose of responding to the interrogatory responses that Opposer submitted with its Notice of Reliance. This is consistent with Rule 2.120(j)(4) which states that "[i]f only part of a

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with Opposer's Notice of Reliance. Opposer did not submit complete copies of those pages, so it appears that Applicant intends to rely on the specific portions of those pages which were *not* included in Opposer's submission. These portions include:

Page	Line(s)	Page	Line(s)
22	1-2, 24-25	38	1, 6-8, 12-14, 21-25
23	1, 7-25	39	1-6
24	1-11	41	14-25
29	1-2, 11-14, 22-25	42	(entire page)
30	1-9	45	8-14
32	2-13, 17-25	51	14-25
33	(entire page)	52	1-15, 18-25
36	15-25	58	(entire page)
37	7-25	59	(entire page)

[3] Applicant apparently intends to rely upon the "meeting minutes" which were discussed on pages 51 to 52 of the transcript. (Supplemental Notice of Reliance at 4.) Because Applicant did not mention any of the other exhibits which were introduced during this deposition, it has waived

discovery deposition is submitted . . . 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." Thus, the fact that Opposer submitted one of Applicant's Interrogatory responses into evidence provides no basis for allowing Applicant to use portions of the discovery deposition transcript as rebuttal evidence.

Applicant claims that it needs to rely upon its own deposition testimony in order to respond to portions of the deposition which were submitted with Opposer's Notice of Reliance. Specifically, Applicant claims that it needs to respond to deposition testimony "regarding Applicant's lack of sales, lack of manufacturing schematics or agreements, lack of marketing materials, and the like." (Supplemental Notice of Reliance at 2-4.) However, Applicant's Supplemental Notice of Reliance is deficient for several reasons.

Applicant failed to identify the specific portions of the deposition transcript that discuss Applicant's lack of sales, lack of manufacturing schematics, lack of manufacturing agreements, and lack of marketing materials. Likewise, the catch-all phrase "and the like" is vague and lacks reasonable specificity. Applicant has failed to explain why the testimony submitted under Opposer's notice of reliance would be misleading. Applicant has failed to explain why the testimony cited in its Supplemental Notice of Reliance would be needed to correct any alleged misimpressions "regarding Applicant's lack of sales, lack of manufacturing schematics or agreements, [and] lack of marketing materials." Applicant does not claim that it has made any sales or that it has created any manufacturing schematics, manufacturing agreements, or marketing materials for its product. Moreover, there is nothing in the Supplemental Notice of Reliance to suggest that this deposition testimony even mentions Applicant's sales, manufacturing schematics, manufacturing agreements, or marketing materials (or lack thereof).

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its right to rely upon those exhibits.

Because Applicant failed to comply with the Order, the Board should give no consideration to the section of Applicant's Supplemental Notice of Reliance which appears under the heading "Exhibit 2."

II. APPLICANT'S DENIALS HAVE BEEN EXCLUDED FROM EVIDENCE ALREADY

In its initial Notice of Reliance Applicant submitted excerpts from Opposer's Requests for Admission, together with Applicant's responses to those requests. Applicant responded to all but one of those requests by stating "Denied." The Board ruled that "applicant's responses to opposer's requests for admissions numbered 110, 112, 114, and 116 will be given no consideration," because the rules only allow "admissions" to be entered into evidence. (Order at 5-6, footnote 5; Order at 7.)

Applicant has attempted to make an end-run around the Board's Order by reintroducing its responses to Opposer's Requests for Admission Nos. 110, 112, 114, and 116 – despite the fact that the Board already excluded those responses from evidence. (Supplemental Notice of Reliance at 7.) As a sanction for ignoring the Board's prior ruling, Opposer respectfully submits that Applicant's should not be allowed to rely upon its response to Opposer's Request for Admission No. 174, which is the only "admission" that Applicant cited in its Supplemental Notice of Reliance. If the Board decides to impose this sanction, then it need not consider Section III.A of this Motion to Strike and instead may proceed directly to Section III.B of Opposer's brief.

III. APPLICANT'S ADMISSION AND INTERROGATORY RESPONSES ARE INADMISSIBLE

Applicant's Supplemental Notice of Reliance should be given no consideration, because Applicant failed to explain why it should be allowed to rely on its response to Opposer's Request for Admission No. 174 or its response to Interrogatory Nos. 6, 7, 8, 9, and 10. The Board ordered Applicant to "explain why its needs to rely upon **each** of the additional discovery responses" which were submitted under Exhibit 8 to Applicant's initial Notice of Reliance. (Order at 6.) Specifically, the Board directed Applicant to "provide

the reason as to why the additional response counters, is inconsistent with or neutralizes the response submitted by Opposer." (*Id.*) Applicant failed to comply with these directives.

A. Applicant's Admission

Request for Admission No. 174 asked the Applicant to authenticate certain documents that Applicant produced during discovery. Opposer did not introduce these documents into evidence during its testimony period. Nor did Opposer introduce any interrogatory responses or admissions concerning these documents. Since Opposer did not offer any evidence concerning these documents, there is no basis for allowing Applicant to offer evidence concerning the authenticity of those documents as rebuttal evidence.

The documents attached to Request for Admission No. 174 are Applicant's internal documents. If Applicant wanted to introduce these internal documents into evidence, it should have scheduled a testimony deposition, asked the witness to authenticate those documents, and then filed the documents with the Board together with the deposition transcript. However, Applicant did not take any testimony depositions in this proceeding. Instead, Applicant is attempting to use a request for admission concerning the authenticity of these documents in order to make an end-run around the rules for introducing its own internal documents.

Applicant claims that it needs to rely on this admission in order to respond to the statement that Applicant provided in its response to Opposer's Interrogatory No. 10. This interrogatory asked Applicant to "state all facts and identify all documents supporting Applicant's assertion . . . that it had . . . a bona fide intent to use Applicant's Mark in commerce in connection with the goods identified in the application." Applicant responded to this request by stating that "Applicant's bona fide intent to use the AQUAJETT mark in commerce is evidence in Applicant's patent filings and other documents indicating an intention to manufacture dental instruments." (*See* Opposer's Sixth Notice of Reliance.)

Applicant's Supplemental Notice of Reliance is deficient, because Applicant failed to explain why this interrogatory response would be misleading in any way. Likewise, Applicant has failed to explain why its admission concerning the *authenticity* of the documents attached to Request for Admission No. 174

"counters, is inconsistent with or neutralizes" the statements made in Applicant's in that interrogatory response. Moreover, even if the documents attached to Request for Admission No. 174 indicate that Applicant has "an intention to manufacture dental instruments," those documents would not "counter" or "neutralize" the statements made in Applicant's response to Interrogatory No. 10. At best, they would simply bolster statements that are already in the record, and as such, the documents themselves are not the proper subject for rebuttal evidence.

B. Applicant's Responses to Interrogatories 6, 7, 8, 9, and 10

Applicant also claims that it needs to rely on its response to Interrogatory No. 6 to contradict the statements that Applicant provided in its response to Interrogatory No. 7 from Opposer's second set of interrogatories. Applicant has failed to explain why the response to Interrogatory No. 7 is misleading, or why Applicant needs to rely on the response to Interrogatory No. 6 in order to correct that misstatement. Interrogatory No. 7 asked Applicant "to identify each product Applicant intends to offer, sell, or distribute . . . using Applicant's AQUAJETT mark" and Applicant responded to that request by stating "oral irrigators." By contrast, Interrogatory No. 6 asked Applicant to identify the differences between Opposer's goods and Applicant's goods, and Applicant responded to this request by claiming that oral irrigators are not related to toothpaste or toothbrushes. Even if the Board accepts the Applicant's claim that oral irrigators are not related to other oral care products, that statement does not "counter" or "neutralize" Applicant's statement that it intends to use the AQUAJETT mark for "oral irrigators." Simply put, one interrogatory response has nothing to do with the other.

Applicant also claims that it needs to rely on its response to Interrogatory No. 7 from Opposer's second set of interrogatories to contradict the statements that it provided in its response to Interrogatory Nos. 8, 9, and 10 from the same set of requests. As discussed above, Interrogatory No. 7 asked Applicant "to identify each product Applicant intends to offer, sell, or distribute . . . using Applicant's AQUAJETT mark" and Applicant responded to that request by stating "oral irrigators." By contrast, Interrogatory Nos.

8, 9, and 10 asked Applicant to identify each product that it intends to offer under three other marks, namely, OMNIJET, OMNIPIK, and AQUAPIK. Once again, Applicant responded to each of these interrogatories by stating, "oral irrigators." Applicant has failed to explain why its response to Interrogatory No. 7 is misleading, or why its needs to rely on the response to Interrogatory Nos. 8, 9, and 10 in order to "counter" or "neutralize" that statement. Interrogatory No. 7 indicates that Applicant intends to use its AQUAJETT mark on the same type of product that it intends to use with its OMNIJET, OMNIPIK, and AQUAPIK marks. Since the response to each of these requests is the same ("oral irritgators") and since each interrogatory response is consistent with the others, it follows that Applicant's response to Interrogatory No. 7 cannot be used to "counter" or "neutralize" its responses to the other requests.

Applicant claims that it needs to rely upon its response to Opposer's Interrogatory No. 7 from Opposer's first set of interrogatories in order to respond to the statements that Applicant provided in its response to Opposer's Interrogatory No. 8. (Supplemental Notice of Reliance at 4-5.) In Interrogatory No. 7 Opposer asked Applicant if it conducted a trademark search before filing its application. Applicant responded to this request by stating that it conducted a basic trademark search. Interrogatory No. 8 asked Applicant to explain how it first became aware of Opposer's use of its mark. Applicant responded to this request by admitting that it "has been aware of a toothpaste called AQUAFRESH for many years." Applicant claims that Interrogatory No. 7 is "necessary to provide additional background" regarding the statements made in Interrogatory No. 8. (*Id.* at 4.) However, Applicant failed to explain why the response to Interrogatory No. 8 is misleading, or why Applicant needs to rely on the response to Interrogatory No. 7 in order to "counter" or "neutralize" that statement. Simply put, Interrogatory No. 7 is perfectly consistent with the statement made in Interrogatory No. 8, and as such, it is not the proper subject for rebuttal evidence.

Finally, Applicant claims that it needs to rely on these interrogatory responses in order to respond to the deposition testimony that Opposer has submitted. The Board allowed Applicant to use its own interrogatory responses for the limited purpose of responding to the interrogatory responses that Opposer has submitted. The Board did not allow Applicant to offer interrogatory responses for the purpose of responding to the deposition testimony that Opposer has submitted. This is consistent with Rule 2.120(j)(5) which states that "[i]f 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." Thus, the fact that Opposer submitted portions of Applicant's deposition testimony provides no basis for allowing Applicant to use its own interrogatory responses as rebuttal evidence.

Conclusion

For the foregoing reasons, Opposer respectfully requests that the Board grant Opposer's motion and exclude the admissions, denials, and discovery deposition testimony cited in Applicant's Supplemental Notice of Reliance, as well as Applicant's response to interrogatory numbers 6, 7, 8, 9, and 10.

Dated: July 29, 2009

Respectfully submitted,

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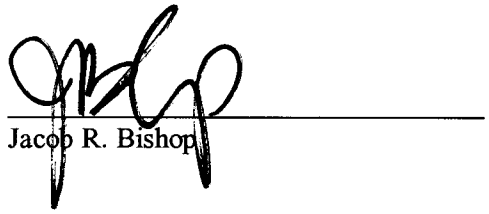
Certificate of Service

I hereby certify that a true and correct copy of Opposer's Motion to Strike Applicant's

Supplemental Notice of Reliance 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 July 29, 2009.



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