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May 26, 2009

**VIA U.S. EXPRESS MAIL**

United States Patent and Trademark Office
Attention: Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Re: Opposition No. 91/178,539
*SmithKline Beecham Corporation v. Omnisource DDS, LLC*

Dear Sir or Madame,

Enclosed for filing in this matter is Opposer's Reply Brief in Support of Its Motion to Strike Applicant's Testimony.

Sincerely,

Erik Bertin

Erik Bertin

Enclosure

cc: Erik M. Pelton
Erik M. Pelton & Associates
P.O. Box 100637
Arlington, VA 22210

Counsel for Applicant Omnisource DDS, LLC

07-12-2012

U.S. Patent & TMOfc/TM Mail Rcpt Dt #11



EB303226369US

**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 REPLY BRIEF IN SUPPORT OF ITS**
**MOTION TO STRIKE APPLICANT'S TESTIMONY**

Opposer, SmithKline Beecham Corporation, moved to strike Exhibits 2, 7, 8, 11, 12, and 13 to Applicant, Omnisource DDS, LLC's Notice of Reliance, because the proffered materials may not be admitted into evidence with a notice of reliance. Applicant's brief fails to provide any legitimate basis for denying this request.

## I. APPLICANT'S DISCOVERY DEPOSITION TESTIMONY IS INADMISSIBLE (EXHIBIT 2 TO APPLICANT'S NOTICE OF RELIANCE)

The Board has developed clear procedures for introducing direct testimony in an opposition proceeding. A party may introduce direct testimony from its own witness by taking a deposition during its testimony period and filing that transcript with the Board. (*See* Rule 2.123(a)(1)). Applicant did not take any testimony depositions in this proceeding. Instead, Applicant is attempting to make an end-run around the rules by submitting the entire transcript and all of the exhibits from its own discovery deposition.

Rule 2.120(j)(4) states that if an inquiring party submits "only part of a discovery deposition" into the record, the responding 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 [inquiring] party" (emphasis added). While this rule allows a responding party to submit a "part" of its

own discovery deposition, it does not give the responding party *carte blanche* to dump the entire deposition transcript into the record along with all of the exhibits thereto. Thus, Exhibit 2 to Applicant's Notice of Reliance should be excluded on that basis alone.

Rule 2.120(j)(4) also requires the responding party to identify the specific portions of the opposing party's submission which could be misleading. Applicant claims that Opposer submitted "mere excerpts" from the discovery deposition of Applicant's president, and that these "statements can often be given distorted meaning" when "[t]aken out of context." (Applicant's Brief ("App. Br.") at 2.) However, Applicant failed to identify any specific statements which have been taken out of context, or any specific statements which were misleading in any way.

Finally, Rule 2.120(j)(4) states that the notice of reliance "filed by [the responding] party must be supported by a written statement explaining why the responding party needs to rely upon ***each*** additional part listed in the [responding] party's notice, failing which the Board, in its discretion, may refuse to consider the additional parts" Rule 2.120(j)(4) (emphasis added). Applicant has submitted the entire deposition transcript, but has failed to explain why it needs to rely on any specific part of that transcript.

## II. APPLICANT'S DECLARATION IS INADMISSIBLE (EXHIBIT 7 TO APPLICANT'S NOTICE OF RELIANCE)

Applicant submitted a declaration from its president, which was previously filed in response to Opposer's motion for summary judgment. Rules 2.120(j)(3) and 2.122 specify the types of materials which may be admitted into evidence under a notice of reliance. Applicant has not cited any rule or offered any rationale which would allow the Board to consider a declaration from the summary judgment record.

If Applicant wanted to introduce direct testimony from its own president, it should have deposed that witness during its own testimony period and filed the transcript with the Board. Allowing Applicant

to submit a written declaration in lieu of a testimonial deposition would be unfairly prejudicial, because witness has never been cross-examined about the statements made in this declaration. The declaration was signed on May 13, 2008 – long after the discovery period closed on February 5, 2008 and long after Opposer deposed the Applicant's president on February 27, 2008.

## III. APPLICANT'S DENIALS ARE INADMISSIBLE (EXHIBIT 8 TO APPLICANT'S NOTICE OF RELIANCE)

Applicant claims that its responses to Opposer's Requests for Admission are admissible under Rule 2.120(j)(5). This rule states:

> 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 (emphasis added).

In other words, a responding party may submit its response to a request for admission under a notice of reliance, but only if that request was "admitted." A responding party may not submit its own discovery response if that request was "denied."

Four of the five responses that Applicant submitted with its notice of reliance were "denials" rather than "admissions." (*See* Applicant's Notice of Reliance, Exhibit 8, Opposer's Request for Admission Nos. 110, 112, 114, 116 and Opposer's Responses thereto.) As such, these responses may not be admitted into evidence under Rule 2.120(j)(5).

## IV. APPLICANT'S ADMISSION AND INTERROGATORY RESPONSES ARE INADMISSIBLE (EXHIBIT 8 TO APPLICANT'S NOTICE OF RELIANCE)

Rule 2.120(j)(5) states that a responding party may submit its own discovery responses "so as to make not misleading what was offered by the inquiring party." However, "[t]he notice of reliance filed by the responding party must be supported by a written statement explaining why the responding party needs to rely upon ***each*** of the additional discovery responses listed in the responding party's notice,

failing which the Board, in its discretion, may refuse to consider the additional responses" (emphasis added).

Applicant has not explained why the admissions and interrogatory responses submitted with Opposer's notice of reliance would be misleading. Nor did Applicant explain why it needs to rely on the specific discovery responses which were submitted with its own notice of reliance. Instead, Applicant claims that its discovery responses are generally needed "to provide a more complete picture" regarding its intent to use its mark. (App. Br. at 3.) In fact, most of these responses have nothing to do with the issue of *bona fide* intent. Four of the interrogatories discuss the meaning and impression of the Applicant's mark as compared to the Opposer's mark, as well as the confusing similarity between these marks. Another interrogatory inquired as to whether Applicant conducted a trademark search before it filed its application. These topics may be relevant to the issue of confusion, but they have nothing to do with the issue of Applicant's intent. (*See* Applicant's Notice of Reliance, Exhibit 8, Applicant's Response to Opposer's First Set of Interrogatories (Interrogatory 7) and Applicant's Response to Opposer's Second Set of Interrogatories (Interrogatories 1, 2, 4, and 6).)

Applicant also submitted its response to Request for Admission No. 174, which asked the Applicant to authenticate the documents which were referenced in that Request. Opposer did not introduce these documents into evidence during its testimony period. Nor did Opposer introduce any deposition testimony, interrogatory responses, or admissions concerning these documents. Since these documents were not offered into evidence during Opposer's testimony period, there is no basis for allowing Applicant to offer evidence concerning the authenticity of those documents under Rule 2.120(j)(5).

If Applicant wanted to introduce direct testimony from its own witnesses, it should have deposed those witnesses during the testimony period. Likewise, if Applicant wanted to introduce its own 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. But as discussed above, Applicant did not take any testimony depositions in this proceeding. Instead, Applicant is attempting to use a request for admission concerning the authenticity of its internal documents in order to get the actual documents into evidence. Likewise, Applicant is attempting to use its own interrogatory responses in order to make an end-run around the rules for introducing direct testimony.

## V. APPLICANT'S INTERNAL DOCUMENTS ARE INADMISSIBLE (EXHIBITS 11, 12, AND 13 TO APPLICANT'S NOTICE OF RELIANCE)

Opposer demonstrated that Applicant's internal documents may not be introduced into evidence with a notice of reliance, because they do not qualify as official records or printed publications under Rule 2.122(e). Applicant's internal documents are also inadmissible, because they are not self-authenticating, and because Applicant failed to provide deposition testimony to authenticate any of these documents. (*See* Opp. Br. at 3.) Applicant did not respond to these arguments in its brief.

Applicant claims that its internal documents should be allowed into evidence under Rule 2.120(j), because they are needed to rebut evidence that Opposer submitted with its notices of reliance. (App. Br. at 4.) As discussed above, Rule 2.120(j) states that a responding party may submit its own interrogatory responses, its own admissions, and portions of its own deposition testimony under limited circumstances. However, this rule does not allow a responding party to introduce its own internal documents with a notice of reliance – let alone documents which not been authenticated.

Applicant claims that Opposer will not be prejudiced if these internal documents are allowed into evidence. (App. Br. at 4-5.) However, Applicant did not produce these documents until February 5, 2009, which was nearly a year after the close of the discovery period and exactly 25 days after the start of the testimony period. Opposer did not receive these documents until February 10, 2009, which was the last day of its testimony period.

Because Applicant failed to produce these documents in a timely manner, Opposer did not have an opportunity to take any follow-up discovery concerning these materials. Opposer did not have an opportunity to question Applicant's witness about these documents during the discovery deposition which was held on February 27, 2008. Nor did Opposer have an opportunity to recall Applicant's witness to testify during Opposer's testimony period. Applicant did not challenge any of this in its brief, nor did it offer any explanation as to why these documents were not produced until after the testimony period began.

**Conclusion**

For the foregoing reasons, Opposer respectfully requests that the Board grant Opposer's motion and exclude Exhibits 2, 7, 8, 11, 12, and 13 to Applicant's Notice of Reliance.

Dated: May 26, 2009

Respectfully submitted,

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Certificate of Mailing by Express Mail

I hereby certify that Opposer's Reply Brief in Support of Its Motion to Strike Applicant's Testimony is being deposited with the United States Postal Service as Express Mail, Post Office to Addressee in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451, on May 26, 2008.

Erik Bertin
Person Signing Certificate

Erik Bertin
Signature

May 26, 2008
Date of Signature

EB 303226369 US
Express Mail Number

Certificate of Service

I hereby certify that a true and correct copy of Opposer's Reply Brief in Support of Its Motion to Strike Applicant's Testimony 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 May 26, 2009.

Erik Bertin
Erik Bertin