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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
Correspondence Address	Leigh Ann Lindquist Sughrue Mion, PLLC 2100 Pennsylvania Ave, NW Washington, DC 20037 UNITED STATES tm@sughrue.com, klash@sughrue.com
Submission	Reply in Support of Motion
Filer's Name	Jacob R. Bishop
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Signature	/Jacob R. Bishop/
Date	01/31/2008
Attachments	AQUAJETT Opposer's Reply Brief.pdf (6 pages)(257762 bytes) AQUAJETT Exhibits A-G to Opposer's Reply Brief.pdf (39 pages)(1200835 bytes)

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

SMITHKLINE BEECHAM CORPORATION	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No. 91/178,539
	:	
OMNISOURCE DDS, LLC	:	
	:	
Applicant.	:	

**OPPOSER’S REPLY BRIEF IN SUPPORT OF ITS
MOTION TO AMEND THE NOTICE OF OPPOSITION**

Opposer moved to amend the Notice of Opposition by adding its newly-acquired registration for AQUA FLOSS as an additional basis for opposing Applicant’s AQUAJETT mark. Applicant objected to Opposer’s amendment, but Applicant’s brief fails to provide any legitimate basis for denying this request.

- ° Applicant claims that it will be prejudiced if this mark is added to the Notice of Opposition, because the discovery period is scheduled to close on February 9, 2008. However, Applicant has not provided any rationale as to why it would be prejudiced. Applicant already served Opposer with a broad set of discovery requests that call for documents and information concerning Opposer’s AQUA-formative marks, and Opposer specifically mentioned AQUA FLOSS in its responses to those requests.
- ° Applicant claims that it will be prejudiced if the discovery period is extended, because that will delay the registration of its mark. However, the parties have not asked the Board to extend the discovery deadline in connection with this motion. Moreover, the Applicant admits that its mark is not in use; as such, Applicant’s mark is not yet eligible for registration.
- ° Applicant claims that the registration for AQUA FLOSS is not relevant to the issues presented in this opposition. But in fact, Applicant put this registration at issue by citing it in its Tenth Affirmative Defense. Thus, the fact that Opposer now owns this registration is directly relevant to Applicant’s affirmative defense.
- ° Finally, Applicant claims that the AQUA FLOSS registration is immaterial, because the amended Notice of Opposition does not allege that Opposer has used this mark. This is simply a collateral attack on Opposer’s newly acquired registration, and as such, it is not a proper basis for denying the motion to amend.

BACKGROUND

The factual and legal issues presented in this motion are straightforward. Applicant has filed an intent-to-use application to register AQUAJETT for “dental instruments, namely, oral irrigators” (Serial No. 78/893,144). Opposer has opposed based on its prior registrations for AQUA, AQUAFRESH, and other AQUAFRESH-formative marks for toothpastes, toothbrushes, and related products. After filing its Notice of Opposition, Opposer acquired a registration for AQUA FLOSS for a “water jet oral hygiene device for cleaning and irrigating gums and spaces between teeth” (Registration No. 1,660,337). Opposer has sought to add this registration to the Notice of Opposition as an additional basis for opposing Applicant’s mark under § 2(d).

Leave to amend a pleading must be “freely” and “liberally” given “at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse parties or parties.” TBMP § 507.02. Leave to amend is routinely granted where – as here – the plaintiff has sought to add “a claim based on a registration issued to or acquired by plaintiff after the filing date of the original complaint.” *Id.* (citing *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 17 USPQ2d 1866, 1867 (Fed. Cir. 1991) (amendment to add recently acquired registration to take on prior owner’s use); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1217 (TTAB 1990) (notice of opposition amended during testimony period to add claim of ownership of newly issued registration)). Likewise, the Board has held that leave to amend should be granted where – as here – the proceeding is still in the midst of the discovery period or where the testimony period has not begun.

ARGUMENT

A. Applicant Will Not Suffer Any Prejudice If This Motion Is Granted

Applicant claims that it will be prejudiced if Opposer’s newly-acquired registration is

added to the Notice of Opposition, because the discovery period is scheduled to close on February 9, 2008.¹ The Board has held that amending a pleading is not prejudicial to the opposing party where – as here – the proceeding is still in the midst of the discovery period. Applicant does not address or attempt to distinguish these cases.

Applicant's claim of prejudice rings hollow, because Applicant does not allege that it has been unable to take discovery within the time allowed, or that it will be unable to complete its discovery before the deadline. The Board's scheduling order for this proceeding set the discovery period to open on August 13, 2007 and to close on February 9, 2008. During that time, Applicant had ample opportunity to explore Opposer's plans for the AQUA FLOSS mark, and did in fact serve discovery requests that encompass the AQUA FLOSS mark.

On December 7, 2007 Opposer notified Applicant that it had acquired the AQUA FLOSS registration by specifically mentioning that mark in its responses to Applicant's discovery requests. (*See* Response to Applicant's First Set of Requests for Production of Documents and Things, Request No. 7, attached as Ex. A.) On January 2, 2008, Opposer notified Applicant that it intends to rely on the AQUA FLOSS registration in this proceeding by filing its Motion to Amend the Notice of Opposition. Thus, Applicant has known for more than a month and a half that the AQUA FLOSS registration would be at issue in this proceeding.

Moreover, Applicant has already taken a great deal of discovery concerning AQUA FLOSS. On October 22, 2007 – roughly a month after Opposer acquired this mark – Applicant served Opposer with a broad set of discovery requests. In these requests, Applicant asked for documents and information concerning "Opposer's Marks," a defined term that referred to "all marks of Opposer incorporating the terms 'AQUA' or 'AQUAFRESH' and all variations thereof" (*See* Applicant's First Request for Production of Documents and Things, Definition No. 3, attached as Ex. B *and* Applicant's First Set of Interrogatories to Opposer, Definition No. 4,

¹ Applicant does not allege that the proposed amendment "would violate settled law." *Cf.* TBMP § 507.02.

attached as Ex. C.) Opposer specifically referenced this mark in its responses to those requests. (*See, e.g.*, Response to Applicant's First Set of Interrogatories to Opposer, Interrogatory No. 2, attached as Ex. D; Response to Applicant's First Set of Requests for Production of Documents and Things, Request No. 7, attached as Ex. A.) Applicant has no basis to complain if the AQUA FLOSS mark is added to the Notice of Opposition, because the complaint is simply being amended in order to conform to the evidence that has been produced during discovery.

In the alternative, Applicant claims that it will be prejudiced by any extension of the discovery period, because that will delay the registration of its mark. However, Applicant fails to mention that the parties have not asked the Board to extend the discovery deadline in connection with this motion or at any other point in this proceeding. Nor is there any need for an extension, because as discussed above, Applicant already served Opposer with discovery requests that call for documents and information concerning AQUA FLOSS.

The Applicant has admitted that its AQUAJETT mark is not in use. Nor does the Applicant have any current plans to market or even promote the "oral irrigators" that it intends to sell under this mark. (*See, e.g.*, Applicant's Objections and Responses to Opposer's First Set of Requests for Production of Documents and Things, Request Nos. 4, 5, 6, 11, attached as Ex. E.) As such, Applicant will not suffer any prejudice if the Motion to Amend is granted, because Applicant's mark would not be entitled to registration even if the Board immediately dismissed the opposition and issued a notice of allowance.

B. The AQUA FLOSS Registration Is Relevant To The Issues Presented In This Opposition

Applicant argues that this motion should be denied, because Opposer has not demonstrated that its ownership of the AQUA FLOSS registration would have any bearing on the issues presented in this proceeding. But in fact, the Applicant put this registration at issue by specifically mentioning it in its Tenth Affirmative Defense. (*See Answer, Tenth Affirmative Defense, attached as Ex. F.*) The fact that Opposer now owns the AQUA FLOSS registration is directly relevant to this affirmative defense, and as such, Applicant cannot argue that Opposer's

acquisition and ownership of that mark is irrelevant to this proceeding.

Applicant also claims that the AQUA FLOSS registration is immaterial, because the amended Notice of Opposition does not allege that Opposer has used this mark. By alleging that the mark has been abandoned through non-use, Applicant is making an impermissible collateral attack on the validity of Opposer's registration. This argument cannot be considered in the absence of a counterclaim for cancellation, and as such, it is not a proper basis for opposing a motion to add a new claim to the Notice of Opposition. *See Liberty & Co., Ltd. v. Liberty Trouser Co., Inc.*, 216 USPQ 65, 66 n.9 (TTAB 1982) (allegations that opposer abandoned its mark "constitute collateral attacks upon the validity of opposer's pleaded registrations and hence cannot be entertained in this proceeding in the absence of a counterclaim"); *see also Analytica Environmental Laboratories, Inc. v. Lumina Decision Systems, Inc.*, Cancellation No. 92/26,851, at 4-5 (TTAB Jan. 26, 2001) (respondent precluded from pursuing a collateral attack on petitioner's pleaded registrations in the absence of a counterclaim for cancellation) [available at <http://des.uspto.gov/Foia/ReterivePdf?system=TTABIS&flNm=92026851-01-26-2001>]; *Drexel Heritage Furnishings, Inc. v. Orbon Industries, Inc.*, 1982 TTAB LEXIS 33, at *2 n.3 (TTAB 1982) (answer alleging that opposer abandoned its rights need not be considered, as a pleading of abandonment is an impermissible collateral attack on the pleaded registrations) [attached as Ex. G]; *Squirtco v. Tomy Corporation*, 1981 TTAB LEXIS 2, at *2 n.3 (TTAB 1981) (no consideration may be given to allegations of abandonment, "which amount to a collateral attack on opposer's registrations, in the absence of a counterclaim") [attached as Ex. G].

CONCLUSION

For the foregoing reasons, Opposer respectfully requests that the Board grant the motion to amend the Notice of Opposition.

Dated: January 31, 2008

Respectfully submitted,



Glenn A. Gundersen

Erik Bertin

Jacob R. Bishop

DECHERT LLP

Cira Centre, 2929 Arch Street

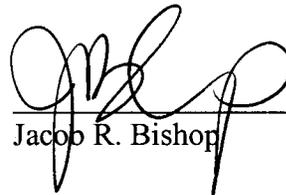
Philadelphia, PA 19104-2808

(215) 994-2183

Attorneys for Opposer
SMITHKLINE BEECHAM CORPORATION

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of Registrant's Reply Brief in Support of Its Motion to Amend the Notice of Opposition has been duly served by mailing such copy first class, postage prepaid, to Erik M. Pelton, P.O. Box 100637, Arlington, VA 22210 on January 31, 2008.



Jacob R. Bishop

EXHIBIT A

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

SmithKline Beecham Corp.,

Opposer,

v.

Omnisource DDS, LLC.,

Applicant.

Opposition No.: 91/178,539

**RESPONSE TO APPLICANT'S FIRST REQUEST FOR
PRODUCTION OF DOCUMENTS AND THINGS**

GENERAL OBJECTIONS

Opposer hereby incorporates its General Objections provided in its Responses to Applicant's First Set of Interrogatories.

REQUEST NO. 1

All documents and things referring to, relating to, comprising, or commenting on any entity associated with Opposer that relates to the use of Opposer's Marks, including, but not limited to, its incorporation, corporate name reservations, qualifications to do business, trade name registrations, and assumed name.

RESPONSE NO. 1

See General Objections. Opposer further objects to this Request on the ground that it seeks information irrelevant to these proceedings, is overly broad and unduly burdensome.

REQUEST NO. 5

All U.S. federal and state trademark and service mark applications filed by or on behalf of Opposer for Opposer's Marks, which include goods in International Class 10.

RESPONSE NO. 5

See General Objections. Without waiving same, Opposer directs the Applicant to the U.S. Patent and Trademark Office records which are available to the public. Opposer further responds that it is unaware of any state trademark or service mark filings for its AQUAFRESH Marks.

REQUEST NO. 6

All documents and things referring or relating to, or comprising any authorization, permission, licensing, or assignment given by Opposer to any third party to use a trademark or trade name similar or identical to Opposer's Marks, including, but not limited to, all franchise agreements, licenses, and other documents permitting such use.

RESPONSE NO. 6

See General Objections. Opposer further objects to this Request on the ground that it seeks information irrelevant to these proceedings, is overly broad and unduly burdensome, and is incomprehensible.

REQUEST NO. 7

All documents and things referring or relating to, or comprising any authorization, permission, licensing, or assignment received by Opposer from any third party to use a

trademark or trade name, which is similar or identical to Opposer's Marks including, but not limited to, all franchise agreements, licenses, and other documents permitting such use.

RESPONSE NO. 7

See General Objections. Opposer further objects to this Request on the ground that it seeks information irrelevant to these proceedings, is overly broad and unduly burdensome, and is incomprehensible. Without waiving these objections, Opposer will produce documents responsive to this Request with respect to the mark AQUA FLOSS.

REQUEST NO. 8

All documents and things referring to, relating to, or comprising any challenges, including, but not limited to, federal court actions, Trademark Trial and Appeal Board oppositions or cancellations, and cease and desist letters, that Opposer has ever made against any third party, and/or any challengers that a third party made against Opposer, concerning the use or registration of any phrase, service mark, trademark, or trade name that purportedly are confusingly similar to Opposer's Marks or any portion thereof.

RESPONSE NO. 8

See General Objections. Opposer further objects to this Request on the ground that it seeks information irrelevant to these proceedings, is overly broad and unduly burdensome, and is incomprehensible. Without waiving same, Opposer will produce representative documents responsive, if any, to this Request. Opposer also directs Applicant to the publicly available records maintained at the U.S. Patent and Trademark Office.

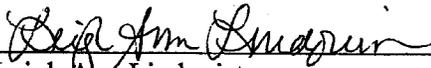
REQUEST NO. 32

All documents and things, other than those produced in response to any of the foregoing requests, upon which Opposer intends to rely in connection with this Opposition proceeding.

RESPONSE NO. 32

See General Objections. Without waiving same, Opposer has not yet identified all documents it will rely on in this proceeding.

Respectfully submitted,

By: 
Leigh Ann Lindquist
Attorney for Opposer
Sughrue Mion, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3213
Telephone: (202) 663-7409
Facsimile: (202) 293-7860

Date: December 7, 2007

EXHIBIT B

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

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

**APPLICANT’S FIRST REQUEST FOR
PRODUCTION OF DOCUMENTS AND THINGS**

Pursuant to Rules 26 and 34 of the Federal Rules of Civil Procedure and the Trademark Rules of Practice, Applicant, Omnisource DDS, LLC (“Omnisource” or “Applicant”), by counsel, hereby requests that Opposer, SmithKline Beecham Corporation (“SmithKline” or “Opposer”), produce the following documents and things that are in Opposer’s possession, custody, or control. These documents and things are to be produced, or made available for copying and inspection, at the offices of Erik M. Pelton & Associates, PLLC, PO Box 100637, Arlington, Virginia 22210, within thirty (30) days of service hereof.

DEFINITIONS

The following definitions apply to and are deemed incorporated into each of the requests to produce herein.

1. “SmithKline Beecham Corporation,” “SmithKline,” “you,” “your,” or “Opposer” means Opposer SmithKline Beecham Corporation, its officers, directors, employees, counsel, agents, representatives, or other persons under its control, any predecessor or successor whether incorporated or not, any division, subsidiary or affiliate thereof, and those persons in active concert or participation with it or them.

2. The term “Application” or “Applicant’s Mark” shall refer to United States trademark application Serial Number 78/893144, Applicant’s use of the AQUAJETT mark, and any variations thereof.

3. The terms “Opposer’s Marks” or “AQUAFRESH Marks” shall refer to all marks of Opposer incorporating the terms “AQUA” or “AQUAFRESH” and all variations thereof including, but not limited to “AQUAFRESH FLEX,” “AQUAFRESH SENSITIVE,” “AQUAFRESH FLEX TIP MAX-ACTIVE,” “AQUAFRESH-ALL,” “AQUAFRESH EXTREME CLEAN,” AQUAFRESH AQUABLAST,” “AQUAFRESH XTENSIVE,” “AQUAFRESH WHITE & SHINE,” “AQUAFRESH IMPACT,” and “AQUAFRESH DIRECT,” all variations in which not all of its letters are capitalized, variations in which it is combined with a superscript such as “TM,” “SM,” “Tm,” “Sm,” “tm,” “sm” or “®” or any other variation intended to convey that, collectively, the AQUAFRESH Marks are trademarks.

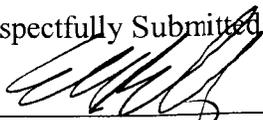
4. The words “and” and “or” are construed both conjunctively and disjunctively, and each includes the other wherever such dual construction will serve to bring within the scope of this request any documents which would otherwise not be brought within its scope. All such terms, as well as other conjunctions and prepositions, are interpreted in the manner that provides the most complete answer and information.

5. “Each” means each and every.

6. “Communication” means all discussions, conversations, interviews, negotiations, cable grams, mail grams, e-mails, telegrams, telexes, facsimile transmissions, cables, letters, confirmations, or other forms of written or verbal discourse, however transmitted, including reports, notes, electronic files and databases, memoranda, lists, agenda and other documents and records.

foregoing requests, upon which Opposer intends to rely in connection with this Opposition proceeding.

Dated: October 22, 2007

Respectfully Submitted,
By: 
Erik M. Pelton, Esq.
Attorney for Applicant

PO Box 100637
Arlington, Virginia 22210
(703) 525-8009

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the Applicant's First Request for Production of Documents and Things was deposited as First Class mail with the United States Postal Service on October ___, 2007, to the following:

Leigh Ann Lindquist
Sughrue Mion, PLLC
2100 Pennsylvania Ave
Washington, DC 20037

By: 
Erik M. Pelton, Esq.

EXHIBIT C

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

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

APPLICANT’S FIRST SET OF INTERROGATORIES TO OPPOSER

Pursuant to Rules 26 and 33 of the Federal Rules of Civil Procedure, 37 C.F.R. § 2.120, and the Trademark Rules of Practice, Applicant Omnisource DDS, LLC (“Omnisource” or “Applicant”), by counsel, hereby requests that Opposer SmithKline Beecham Corporation, (“SmithKline” or “Opposer”) answer fully under oath the following interrogatories within thirty (30) days after service thereof. These answers are to be sent to Erik M. Pelton & Associates, PLLC, PO Box 100637, Arlington, Virginia 22210.

DEFINITIONS

The following definitions apply to and are deemed incorporated into each question in this first set of interrogatories:

1. “SmithKline Beecham Corporation,” “SmithKline,” “you,” “your,” or “Opposer” means Opposer SmithKline Beecham Corporation, its officers, directors, employees, counsel, agents, representatives, or other persons under its control, any predecessor or successor whether incorporated or not, any division, subsidiary or affiliate thereof, and those persons in active concert or participation with it or them.

2. “Document” shall refer to all items within the scope of Rule 34, Federal Rules of Civil Procedure.

3. “Person” or “persons” shall refer to any individual, corporation, proprietorship, partnership, association, joint venture, business trust, receiver, estate syndicate government agency or other entity, including the parties to this suit and their officers, agents, employees and representatives.

4. The terms “Opposer’s Marks” or “AQUAFRESH Marks” shall refer to all marks of Opposer incorporating the terms “AQUA” or “AQUAFRESH” and all variations thereof including, but not limited to “AQUAFRESH FLEX,” “AQUAFRESH SENSITIVE,” “AQUAFRESH FLEX TIP MAX-ACTIVE,” “AQUAFRESH-ALL,” “AQUAFRESH EXTREME CLEAN,” AQUAFRESH AQUABLAST,” “AQUAFRESH XTENSIVE,” “AQUAFRESH WHITE & SHINE,” “AQUAFRESH IMPACT,” and “AQUAFRESH DIRECT,” all variations in which not all of its letters are capitalized, variations in which it is combined with a superscript such as “TM,” “SM,” “Tm,” “Sm,” “tm,” “sm” or “®” or any other variation intended to convey that, collectively, the AQUAFRESH Marks are trademarks.

5. The term “mark” includes any trademark, service mark, trade name, collective mark or certification mark, as defined by 15 U.S.C. § 1127, and any other phrase or symbol used as a source identifier for a particular good or service.

6. The words “and” and “or” are construed both conjunctively and disjunctively, and each includes the other wherever such dual construction will serve to bring within the scope of this request any documents which would otherwise not be brought within its scope. All such terms, as well as other conjunctions and prepositions, are interpreted in the manner that provides the most complete answer and information.

7. “Each” means each and every.

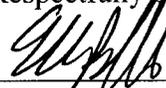
8. “Communication” means all discussions, conversations, interviews, negotiations,

Identify any person who may be used at Trial to present evidence under Rules 702, 703, or 705 of the Federal Rules of Evidence. For each such person, provide a separate written report satisfying the provisions of F.R.Civ.P. 26(a)(2)(B).

ANSWER:

Dated: October 22, 2007

Respectfully Submitted,



Erik M. Pelton, Esq.
Attorney for Applicant
PO Box 100637
Arlington, Virginia 22210
(703) 525-8009

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the Applicant's First Set of Interrogatories to Opposer was deposited as First Class mail with the United States Postal Service on October 22, 2007, to counsel for Opposer at:

Leigh Ann Lindquist
Sughrue Mion, PLLC
2100 Pennsylvania Ave
Washington, DC 20037

By:



Erik M. Pelton, Esq.

EXHIBIT D

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

SmithKline Beecham Corp.,

Opposer,

v.

Ominsource DDS, LLC.,

Applicant.

Opposition No.: 91/178,539

**RESPONSES TO APPLICANT'S FIRST
SET OF INTERROGATORIES TO OPPOSER**

GENERAL OBJECTIONS

A. Opposer objects to Applicant's definitions and requests insofar as they are overly broad, unduly burdensome, oppressive, and otherwise seek to impose a greater obligation upon Opposer than that imposed by the Federal Rules of Civil Procedure.

B. Opposer objects to Applicant's definitions, interrogatories and document requests insofar as they seek information that is irrelevant and/or unlikely to lead to the discovery of admissible evidence.

C. Opposer objects to Applicant's definitions, interrogatories and document requests insofar as they seek, or a response would disclose, information subject to the attorney-client privilege or work product doctrine or which is otherwise protected under the Federal Rules of Civil Procedure.

D. Opposer objects to Applicant's definitions, interrogatories and document requests insofar as they seek information that is not in the possession or control of Opposer.

E. Opposer objects to Applicant's interrogatories and document requests insofar as they call for information regarding Opposer's Marks and use outside the United States. A request for worldwide information is overly broad and burdensome and technically irrelevant to the issue of likelihood of confusion in the United States.

INTERROGATORIES

INTERROGATORY NO. 1

Identify, as described in Instruction No. 3, the Opposer, SmithKline Beecham Corporation.

RESPONSE NO. 1

See General Objections. Without waiving same, Opposer responds: see Notice of Opposition.

INTERROGATORY NO. 2

Identify and describe with specificity each good and service in connection with which the AQUAFRESH Marks, or any variation thereof, have been used or is currently being used by Opposer, or any authorized user of the marks.

RESPONSE NO. 2

See General Objections. Without waiving same, Opposer responds: Opposer's AQUAFRESH Marks are currently used on or in connection with toothbrushes, toothpaste, and whitening products. Opposer refers Applicant to its website at *aquafresh.com*.

Opposer's AQUAFRESH Marks have previously been used on or in connection with the above products in addition to mouthwash and a water jet oral hygiene device.

INTERROGATORY NO. 3

With respect to each of the goods and services identified in response to Interrogatory No. 2, describe all relevant facts and circumstances regarding the first use of the marks in interstate commerce in the United States.

RESPONSE NO. 3

See General Objections. Without waiving same, Opposer responds that through its predecessor in interest it has sold products under the AQUAFRESH Marks for over thirty years. Opposer will produce responsive documents, if any, but advises that the exact date of first use is probably unavailable. Opposer directs Applicant to the file histories for its AQUA formative marks available at the U.S. Patent and Trademark Office.

INTERROGATORY NO. 4

- (a) With respect to each of the goods and services identified in response to Interrogatory No. 2, state the annual sales in dollars for each year from 2000 to the present.

Responses to Interrogatories
Opposition No. 91/178,539

As to objections,

By: 
Leigh Ann Lindquist
Attorney for Opposer
SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3213

Date: December 7, 2007

EXHIBIT E

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

SMITHKLINE BEECHAM CORPORATION,)	
)	
Opposer,)	IN THE MATTER OF:
)	
vs.)	Opposition No. 91178539
)	
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

2. All documents which comprise or relate to the results of any search or investigation conducted by or on behalf of Applicant which relate to the availability or registrability of Applicant's Mark.

Response:

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

Notwithstanding and without waiving these objections, Applicant responds:

None.

3. All documents and things supporting Applicant's claim of a bona fide intent to use the mark AQUAJETT in commerce in connection with the goods described in Applicant's application.

Response:

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

Notwithstanding and without waiving these objections, Applicant responds:

None. For more information about Applicant's goods, see USPTO application Serial No. 78893114 and U.S. Patent Nos. 5,564,629; 5,511,693; and 5,556,001.

4. All documents and things relating to Applicant's proposed channels of trade, and/or actual channels of trade, to promote, offer and sell its goods under the mark AQUAJETT.

Response:

Opposition No. 91178539:

Response to Opposer's First Requests for Production of Documents and Things

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

Notwithstanding and without waiving these objections, Applicant responds:

None. Applicant has not yet begun promoting or advertising any goods under the mark AQUAJETT. For more information about Applicant's goods, see USPTO application Serial No. 78893114 and U.S. Patent Nos. 5,564,629; 5,511,693; and 5,556,001. Applicant intends to market the goods to users of oral care goods.

5. All documents and things relating to Applicant's intended classes of customers and/or actual classes of customers to which the goods under Applicant's Mark are offered and/or intended to be offered.

Response:

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

Notwithstanding and without waiving these objections, Applicant responds:

None. Applicant has not yet begun promoting or advertising any goods under the mark AQUAJETT. For more information about Applicant's goods, see USPTO application Serial No. 78893114 and U.S. Patent Nos. 5,564,629; 5,511,693; and 5,556,001. Applicant intends to market the goods to users of oral care goods.

6. All documents and things relating to Applicant's intended and/or actual advertising and promotion of its goods under its AQUAJETT mark.

Response:

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

Notwithstanding and without waiving these objections, Applicant responds:

None. Applicant has not yet begun promoting or advertising any goods under the mark AQUAJETT.

For more information about Applicant's goods, see USPTO application Serial No.

78893114 and U.S. Patent Nos. 5,564,629; 5,511,693; and 5,556,001. Applicant intends to market the goods to users of oral care goods.

7. All documents and things evidencing total sales of Applicant's goods offered under the AQUAJETT Mark.

Response:

In addition to the general objections above, Applicant objects to this Request as overly broad, burdensome, and irrelevant.

Notwithstanding and without waiving these objections, Applicant responds:

None.

8. Documents and things sufficient to identify Applicant's advertising and promotional expenditures for goods to be offered and/or offered under the AQUAJETT mark.

Response:

Opposition No. 91178539:

Response to Opposer's First Requests for Production of Documents and Things

11. All documents and things which evidence the manner in which Applicant intends to use, and/or uses, the AQUAJETT mark in relation to the goods identified in Application Serial No. 78/893,144 its goods.

Response:

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

Notwithstanding and without waiving these objections, Applicant responds:

None. Applicant has not yet begun promoting or advertising any goods under the mark AQUAJETT. For more information about Applicant's goods, see USPTO application Serial No. 78893114 and U.S. Patent Nos. 5,564,629; 5,511,693; and 5,556,001. Applicant intends to market the goods to users of oral care goods.

12. All agreements, and documents relating thereto, which relate in any way to goods sold or to be sold under Applicant's Mark, including but not limited to trademark agreements or licenses.

Response:

In addition to the general objections above, Applicant objects to this Request as irrelevant.

Notwithstanding and without waiving these objections, Applicant responds:

None.

13. All documents and things related to product development and research for goods to be offered under Applicant's Mark.

Response:

Opposition No. 91178539:
Response to Opposer's First Requests for Production of Documents and Things

16. All documents or things upon which Applicant intends to rely in this proceeding.

Response:

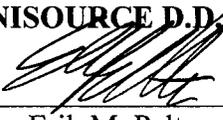
In addition to the general objections above, Applicant objects to this Request as overly broad and open ended, burdensome, irrelevant, and requesting materials which are privileged and/or attorney-work product.

Notwithstanding and without waiving these objections, Applicant responds:

Publicly available records of the USPTO; documents identified herein; correspondence from Opposer regarding AQUAPIK (in possession of Opposer); December 9, 1997, opinion of TTAB in Cancellation No. 23,622 (publicly available). Applicant's investigation of this matter is continuing and this response will be supplemented if necessary.

Dated: November 8, 2007

OMNISOURCE D.D.S., LLC

By: 
Erik M. Pelton, Esq.

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

EXHIBIT F

1 IN THE UNITED STATES PATENT AND TRADEMARK

2 BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

3
4 In the matter of the Trademark and Service Mark Application Serial No. 78/893,144
5 for "AQUAJETT" published in the Official Gazette on July 10, 2007

6 SmithKline Beecham Corporation,) Opposition No.: 91178539
7)
8 Opposer,) ANSWER TO NOTICE OF OPPOSITION
9)
10 vs.)
11)
12 Omnisource DDS, LLC)
13)
14 Applicant.)
15)

13 Commissioner for Trademarks
14 Trademark Trial and Appeal Board
15 P.O. Box 1451
16 Alexandria, VA 22313-1451

17
18 **ANSWER TO NOTICE OF OPPOSITION**

19 COMES NOW the Applicant, Omnisource DDS, LLC, a California limited
20 liability company (hereafter "Applicant"), by and through its attorney and pursuant to
21 Rule 2.114 of the Trademark Rules of Practice and Rule 8(b) of the Fed. R. Civ. P., and
22 for its Answer to the Notice for Opposition (hereafter the "Opposition"), filed by
23 SmithKline Beecham Corporation (hereafter "Opposer") seeking to oppose the issuance
24 of United States Trademark Application Serial No. 78/893,144 for "AQUAJETT", and
25 answers the Opposition as follows:
26
27
28

ROZSA LAW GROUP LC
ATTORNEYS AT LAW
18757 BURBANK BOULEVARD, SUITE 220
TARZANA, CALIFORNIA 91336-3346
TELEPHONE (818) 783-0990



08-20-2007

U.S. Patent & TM Office Mail Room DL #30

1 when the Opposer's marks and Applicant's mark are compared in their entirety, the
2 Applicant's mark for "AQUAJETT" and the Opposer's marks which include
3 "AQUAFRESH" are not confusingly similar in overall sight, sound and meaning. The
4 overall impression created by Applicant's mark is totally different from the overall
5 impression created by Opposer's mark.

6
7 **SEVENTH AFFIRMATIVE DEFENSE**

8 14. As a seventh, separate and distinct affirmative defense, Applicant alleges
9 that there are numerous other uses of "AQUA" in International Class 10 which is the
10 same class in which Applicant's mark has been applied for and numerous other uses of
11 the term "AQUA" in dental products. Therefore, there is no distinctiveness to "AQUA"
12 and the fact that Applicant's mark and Opposer' mark both have the term "AQUA" in
13 them would not automatically lead to any confusion between the mark "AQUAJETT"
14 and "AQUAFRESH".

15
16 **EIGHTH AFFIRMATIVE DEFENSE**

17 15. As an eighth, separate and distinct affirmative defense, Applicant alleges
18 that the Opposition and each and every paragraph stated therein fails to state a cause of
19 action against the Applicant.
20

21 **NINTH AFFIRMATIVE DEFENSE**

22 16. As a ninth, separate and distinct affirmative defense, Applicant alleges
23 that the Opposer has sustained no damage, injury or prejudice as a result of the
24 Applicant's trademark application for "AQUAJETT".
25

26 **TENTH AFFIRMATIVE DEFENSE**

27 17. As a tenth, separate and distinct affirmative defense, Applicant attaches as
28 Exhibit 1 hereto a copy of a ruling by the Trademark Trial and Appeal Board wherein

1 the Opposer sought to cancel the registration for the mark "AQUA FLOSS" based on its
2 "AQUAFRESH" trademarks and lost the Cancellation. Accordingly, the Opposer is
3 engaged in a wanton and wrongful act as they have already lost in their attempt to cancel
4 registrations that contain "AQUA" with other marks based upon their "AQUAFRESH"
5 mark and therefore, this Opposition is groundless and baseless.

6
7 **ELEVENTH AFFIRMATIVE DEFENSE**

8 18. As an eleventh, separate and distinct affirmative defense, attached hereto
9 as **Exhibit 2** is a true and correct copy of a letter received by Attorney Leigh Ann
10 Lindquist from the law firm of Lord Bissell Brook LLP on August 11, 2005, clearly
11 showing why there is no confusing similarity between the Applicant's marks
12 "AQUAPIK" and "AQUAJET" and the Opposer's mark "AQUAFRESH". In spite of
13 this, Opposer has brought this groundless, meritless Opposition.
14

15
16 WHEREFORE, Applicant requests that the Opposition to Trademark Application
17 Serial No. 78/893,144 be denied and that Opposer take nothing by way of its Opposition.

18
19 Applicant further requests Rule 11 sanctions against Opposer and that Applicant
20 be awarded its costs and attorneys' fees in defending the meritless Opposition filed by
21 Opposer.

22
23 If there is any charge required for the filing of this Answer to Notice of
24 Opposition, the Commissioner of Patents and Trademarks is hereby authorized to charge
25 my Deposit Account No. 18-2222 for the appropriate fee.
26
27
28

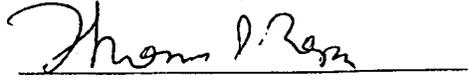
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Please send all correspondence concerning this Opposition to Thomas I. Rozsa, at
the address listed below.

Respectfully submitted,

Date: August 14, 2007



Thomas I. Rozsa
Registration No. 29,210
Attorney for Applicant
Omnisource DDS, LLC
18757 Burbank Boulevard, Suite 220
Tarzana, California 91356-3346
Telephone: (818) 783-0990
Telecopier: (818) 783-0992

EXHIBIT G

LEXSEE 1982 TTAB LEXIS 33

Drexel Heritage Furnishings, Inc. v. Orbon Industries, Inc.

Opposition No. 63,458, to application Serial No. 155,948, filed January 20, 1978.

NOTE: This opinion will not be published in full in a printed volume because it does not add significantly to the body of trademark law and is not considered to be of widespread legal interest. Thus, while the decision is a public record, it is not citable as precedent. A brief digest notation of the decision may appear in printed case reporter volumes.

Trademark Trial and Appeal Board

1982 TTAB LEXIS 33

May 18, 1982, Hearing

November 15, 1982, Decided

DISPOSITION:

[*1]

Decision: The opposition is dismissed.

COUNSEL:

Bell, Seltzer, Park & Gibson for Drexel Heritage Furnishings, Inc.

Lane, Aitken, Ziems, Kice and Kananen for Orbon Industries, Inc.

JUDGES: Before Rice, Simms and Sams, Members.

OPINION BY: SAMS

OPINION:

Opinion by Sams, Member:

Orbon Industries, Inc. has filed an application to register the mark "ORBON HERITAGE" for "gas and electric cooking ranges" and has claimed use of the mark since February 1977. n1 Drexel Heritage Furnishings, Inc. has opposed registration on the ground that applicant's mark "ORBON HERITAGE" so resembles the mark "HERITAGE", previously used and registered by opposer for various goods and services, including, inter alia, furniture products and services for the establishment and operation of furniture stores, n2 as to be likely, when applied to applicant's goods, to cause confusion or to cause mistake or to deceive.

n1 Ser. No. 155,948, filed January 20, 1978.

n2 Reg. No. 1,055,898, issued January 11, 1977.

Office records show that a combined affidavit under Section 8 and 15 has been filed for each of the following registrations: Reg. No. 1,047,833, issued Sept. 7, 1976; Reg. No. 1,046,525, issued Aug. 17, 1976; Reg. No. 1,034,046, issued Feb. 17, 1976; Reg. No. 1,032,565, issued Feb. 3, 1976; Reg. No. 1,027,181, issued Dec. 16, 1975; Reg. No. 1,005,825, issued March 4, 1975; Reg. No. 1,005,340, issued Feb. 25, 1975; Reg. No. 993,747, issued Sept. 24, 1974; Reg. No. 951,221, issued Jan. 23, 1973; Reg. No. 599,977, issued Dec. 28, 1954; and Reg. No. 444,792, issued Oct. 20, 1953.

Office records show that the following pleaded registrations have been cancelled pursuant to Section 8: Reg. Nos. 1,040,147; 1,031,366; 1,028,695; 1,015,777; and 944,680. Because these registrations are no longer in effect, we do not consider them as evidence of any currently existing rights in our determination of the issues before us.

[*2]

In its answer to the notice of opposition, applicant admitted that it seeks to register the mark "ORBON HERITAGE" for gas and electric cooking ranges with a date of first use of February, 1977, but denied the other allegations upon which opposer's claim of damage is based, and stated affirmatively that there are substantial differences both in the marks and in the goods to which the marks are applied. n3

n3 Applicant's answer also stated affirmatively that opposer has abandoned rights in the mark "HERITAGE" as a result of nonuse of the mark with respect to certain goods and services set forth in the pleaded registrations and that opposer's prior litigation history constitutes unclean hands. The record contains no testimony or other evidence on these issues and applicant failed to argue these matters in its brief. Hence we need not consider them. In any event, a pleading of abandonment is, in this case, an impermissible collateral attack on the pleaded registrations.

The record consists of the pleadings, the file of applicant's application, copies of opposer's pleaded registrations showing status and title, applicant's responses to eight of opposer's interrogatories, opposer's responses [*3] to five of applicant's interrogatories, copies of the records of several cases in the United States District Courts and the records of certain cases before the Trademark Trial and Appeal Board (introduced into the record by opposer pursuant to Trademark Rule 2.122(c)), copies of records of certain additional cases before the Trademark Trial and Appeal Board (introduced into the record by applicant pursuant to Trademark Rule 2.122(c)), copies of several third-party U.S. trademark registrations (introduced into the record by applicant pursuant to Trademark Rule 2.122(c)), printed publications (introduced into the record by applicant pursuant to Trademark Rule 2.122(c)), a copy of one of opposer's pleaded registrations showing status and title (introduced into the record by applicant pursuant to Trademark Rule 2.122(c)), opposer's response to one of applicant's requests for admission, and testimony (and exhibits) in behalf of both parties. Both parties filed briefs on the case and were represented at oral hearing.

Opposer's priority is established by its registrations. Thus, the only issue to be determined is that of likelihood of confusion, that is, whether the contemporaneous use [*4] of the marks at issue, as applied to the respective goods and services of the parties, would be likely to cause confusion, mistake or deception.

Turning first to the goods in connection with which the marks are used, we find that opposer's furniture, home furnishing items and furniture store services and applicant's cooking ranges are significantly dissimilar. While there is testimony to the effect that the goods are sometimes sold in the same retail stores, that is, home furnishing stores, we view this to be the exception rather than the rule. Testimony adduced by both sides reveals that, commonly, opposer's furniture is sold through furniture stores and applicant's ranges through appliance stores. However, even when the goods are sold in the same store, furniture and cooking ranges are sold in separate areas. Opposer's assertion that a cooking range falls within the scope of home furnishings is not well founded. n4 The two products are unrelated and noncompeting and, moreover, they significantly differ in utility.

n4 In its reply brief, opposer raises, for the first time, the theory of natural expansion of trade. No proof on this issue was adduced by opposer. In view thereof, opposer's argument is not persuasive.

[*5]

Turning next to the marks of the parties, opposer urges the Board to apply the rule that the addition of a trade name or house mark to one of two otherwise confusingly similar marks will not generally serve to avoid a likelihood of confusion. In support thereof, opposer cites *In re Hathaway Co.*, 190 U.S.P.Q. 343 (TTAB 1976) and *In re Hill-Behan Lumber Co.*, 201 U.S.P.Q. 246 (TTAB 1978). However, where, as here, the goods of the parties are substantially different, we find the cases relied on by opposer to be of little precedential value.

Opposer relies also on the records of prior cases before the U. S. District Court and this Board, involving its "HERIAGE" mark, in which opposer was successful in enjoining the use of or opposing registration of certain marks. It argues, on the basis of its successive cases, that "HERITAGE" is a strong mark. While prior decisions in cases involving different marks may be pertinent to the extent that they may set standards to be applied generally in proceedings before the Board, they are not controlling in our determination of the issue of likelihood of confusion presented in this proceeding. Each case must be decided [*6] on its own particular facts. See *In re Cosvetic Laboratories, Inc.*, *supra* and cases cited therein. As noted by the Court of Customs and Patent Appeals in *Jacquet-Girard, S.A. v. Girard Perregaux & Cie., S.A.*, 165 U.S.P.Q. 265 (CCPA 1970), "[p]rior decisions on different marks used under different circumstances are of little value in deciding a specific issue of likelihood of confusion." Thus, the determination in a civil action between opposer and a third party that, as against that third party, opposer's mark is entitled to protection against infringement, has no bearing on opposer's rights vis-a-vis applicant or on the question of likelihood of confusion herein.

In a similar way, applicant's argument concerning third-party registrations is not persuasive of the weakness or suggestiveness of opposer's mark. The question before us remains whether the marks at issue, when viewed as a whole, create a likelihood of confusion when applied to the parties' goods. Third-party registrations have very little weight on this issue. Likelihood of confusion is always resolved by a comparison of the marks in their entireties and a comparison of the products [*7] in connection with which the marks are used. See, e.g., *Beacon-Morris Corp. v. Int'l. Tel. & Tel. Corp.*, 175 U.S.P.Q. 16 (CCPA 1972); *Glenwood Laboratories, Inc. v. American Home Products Corp.*, 173 U.S.P.Q. 19 (CCPA 1972); *In re Belgrade Shoe Co.*, 162 U.S.P.Q. 227 (CCPA 1969); *Independent Grocers' Alliance Distributing Co. v. Potter McCune Co.*, 160 U.S.P.Q. 46 (CCPA 1968); *In re Yawata Iron & Steel Co.*, 159 U.S.P.Q. 721 (CCPA 1968); and *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 153 U.S.P.Q. 406 (CCPA 1967).

Taking into account the differences in the marks and the differences in the goods and services to which those marks are applied, we do not believe that the applicant's mark so resembles the opposer's mark as to be likely, when applied to applicant's goods, to cause confusion or mistake or to deceive.

Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark Law
Likelihood of Confusion
General Overview
Trademark Law
Protection of Rights
General Overview
Trademark Law
U.S. Trademark Trial & Appeal Board Proceedings
Oppositions
General Overview

LEXSEE 1981 TTAB LEXIS 2

Squirtco v. Tomy Corporation

Opposition No. 62,392 to application Serial No. 179,259, filed July 24, 1978.

Trademark Trial and Appeal Board

1981 TTAB LEXIS 2

December 9, 1980, Hearing

October 23, 1981, Decided

DISPOSITION:

[*1]

Decision: The opposition is dismissed.

COUNSEL:

Price, Heneveld, Huizenga & Cooper for Squirtco.

Edward D. O'Brian and F. David LaRiviere for Tomy Corporation.

JUDGES: Before Lefkowitz *, Rice and Fruge', Members.

* Mr. Lefkowitz retired from government service prior to the writing of this opinion and therefore did not participate therein.

OPINION BY: FRUGE', Member:

OPINION:

Opinion by Fruge', Member:

An application was filed by Tomy Corporation to register the mark "SQUIRT SQUAD" for floating water toys. Use since February 2, 1978 was alleged. n1

n1 Application Serial No. 179,259, filed July 24, 1978.

Registration was opposed by Squirtco on the ground that applicant's mark so resembles the mark "SQUIRT" (alone or with designs or written matter) previously used and registered by opposer for soft drinks and bases, syrups, concentrates and extracts for making same, fresh citrus fruits and canned fruit juices, glass salt and pepper shakers, toy balloons, and periodical publications n2 as to be likely, when applied to the goods of the applicant, to cause confusion, mistake or deception of purchasers.

n2 Reg. No. 367,659, issued May 23, 1939, Republished, Renewed, Section 8 affidavit accepted, Section 15 affidavit filed.

Reg. No. 388,791, issued July 8, 1941, Republished, Twice Renewed, Section 8 affidavit accepted, Section 15 affidavit filed.

Reg. No. 388,791, issued July 8, 1941, Republished, Twice Renewed, Section 8 affidavit accepted, Section 15 affidavit filed.

Reg. No. 390,686, issued September 30, 1941, Republished, Renewed, Section 8 affidavit accepted, Section 15 affidavit filed.

Reg. No. 396,177, issued June 20, 1942, Republished, Renewed, Section 8 affidavit accepted, Section 15 affidavit filed.

Reg. No. 410,117, issued November 7, 1944, Republished, Renewed, Section 8 affidavit accepted, Section 15 affidavit filed.

Reg. No. 528,806, issued August 8, 1950, Renewed, Section 8 affidavit accepted, Section 15 affidavit filed.

Reg. No. 689,587, issued December 8, 1959, Renewed, Section 8 affidavit accepted, Section 15 affidavit filed.

Reg. No. 702,924, issued August 16, 1960, Section 8 affidavit accepted, Section 15 affidavit filed.

Reg. No. 710,198, issued January 24, 1961, Section 8 affidavit accepted, Section 15 affidavit filed.

Reg. No. 748,123, issued April 16, 1963, Section 8 affidavit accepted, Section 15 affidavit filed.

Reg. No. 771,971, issued June 23, 1964, Section 8 affidavit accepted, Section 15 affidavit filed.

Reg. No. 820,330, issued December 13, 1966, Section 8 affidavit accepted, Section 15 affidavit filed.

Reg. No. 1,094,454, issued June 27, 1978.

[*2]

Applicant denied the allegations upon which opposer bases its opposition and as an affirmative defense pleaded that the word "SQUIRT", per se, is a descriptive term and, in effect, contended that marks using that word tend to be weak marks. n3 The record consists of the pleadings, applicant's application file, opposer's registrations introduced during the testimony of its witness, n4 certain of applicant's responses to opposer's discovery requests and exhibits connected therewith introduced by opposer under Rule 2.120(b) n5, certain dictionary definitions introduced by applicant under Rule 2.122(c) n6 and testimony on behalf of both parties. n7 Both parties filed briefs but only applicant was represented at the oral hearing held in this matter, opposer having waived its appearance.

n3 Applicant also pleaded that opposer had abandoned its marks by failure to exercise adequate control of their use and to comply with applicable statutes. Applicant is advised that no consideration may be given to these allegations, which amount to a collateral attack on opposer's registrations, in the absence of a counterclaim for their cancellation. See: *Gould Inc. v. Sanyo Electric Co., Ltd.*, 1979 U.S.P.Q. 313 (TTAB, 1973).

n4 In its brief on the case, applicant moved to strike the testimony given by Mr. Heath relative to the use of opposer's mark on the ground that Mr. Heath has been employed by opposer only since December 1979 and that his testimony as to any use predating his employment is hearsay and should not be considered. While there is merit in applicant's contention, it is noted that counsel for applicant never once objected on that ground during the taking of the testimony and, in fact, cross-examined the witness extensively, thereby waiving his objection. Nonetheless, we do note a deficiency in the introduction of opposer's registrations into evidence during the

testimony of opposer's witness insofar as the current status of the registrations was not established by the witness. See: *Peters Sportswear Co., Inc. v. Peter's Bag Corporation*, 187 U.S.P.Q. 648 (TTAB, 1975). However, applicant failed to object on that ground as well and did, in fact, treat them in its main brief as part of opposer's record as if they were properly made of evidence. We consider this an admission by applicant that the registrations exist, that they are owned by opposer and that they are therefore entitled to the presumptions of Section 7(b). See: *West Point-Pepperell, Inc. v. Borlan Industries, Inc.*, 191 U.S.P.Q. 53 (TTAB, 1976).

n5 The parties are advised that the rules pertaining to discovery require that each interrogatory, except those to which an objection is made, must be answered fully and separately. That is, it is not sufficient to answer by referring to answers to previous interrogatories. See: *United States v. Watchmakers of Switzerland Information Center, Inc.*, 2 FR Serv 2d 543 (DC SDNY, 1959) and *Trabon Engineering Corp. v. Eaton Mfg. Co.*, 9 FR Serv 2d 33.319 Case 2; 37 FRD 51 (DCND Ohio, 1964). To illustrate, one of the answers relied upon by opposer states in part "In response to the (a), (b), (d), (e), and (f) portions of this interrogatory 41 the applicant incorporates herein by reference the responses to interrogatories 5, 38 and 39. ... Reference is made to the request to produce documents and things number 7 which response is herein incorporated by reference. The response to interrogatory 42 is also incorporated herein by reference. The applicant objects to the (g) part of this interrogatory 41 and therefore declines to answer the same on grounds as set forth in the response to interrogatory number 38, which response is incorporated herein by reference ..." Consequently, to the extent that the discovery responses relied upon by opposer merely refer to other answers, requiring the Board to undertake a laborious and time consuming search for information, they have not been considered herein. Any prejudice to opposer as a result could have been avoided if opposer had sought correction of this deficiency during the interlocutory stages of the proceeding. It is further noted that opposer's discovery included a set of interrogatories throughout which requests for admissions and requests for production were intermingled with no apparent rhyme or reason for their particular placement therein. While the rules do not specify that such requests be in separate documents, it would seem apparent that in the interest of clarity and simplification for all concerned separate sets of requests would be the better practice. There is no doubt it would facilitate consideration of relied upon discovery.

More on the subject of opposer's relied upon discovery, applicant is advised that in response to a request for admissions a party must either admit, deny or object to a specific request. A statement that the party declines to admit or deny is totally improper and, in fact, since failure to deny is taken to be an admission such equivocation could be very damaging. On the other hand, requests for admission are not to be used to discover facts but to establish facts of a peripheral nature which are not in dispute. To the extent that opposer's relied upon answers to requests to admit were directed to disputed matters, they have not been considered.

n6 Applicant also included in its notice of reliance a number of decisions of the Trademark Trial and Appeal Board. Except for one unpublished decision, a copy of which was attached, the decisions need not be noticed under Rule 2.122(c) in order to be considered in a proceeding before the Board.

n7 Applicant's objections to opposer's exhibits introduced during the testimony deposition of Mr. Heath have been fully considered in determining the probative value to be accorded to said exhibits and the testimony related thereto.

[*3]

The record n8 establishes that opposer sells "SQUIRT" soft drink bases and/or concentrates having a grapefruit flavor to its franchisees who may bottle or can the soft drink product which is then sold in regular or diet form to the public. In addition to sales in bottles or cans, some franchisees prepare a vending machine mix of the soft drink. Opposer has approximately 250 franchisees in the United States whose agreement with opposer includes extensive quality control provisions. Other than the soft drink and some fruit and fruit juices, the mark is used on a number of promotional items which are sold by opposer to individual bottlers who may give them away or sell them. Some such products are jogging suits, T-shirts, ashtrays, wrist watches, alarm clocks, dart boards, practice tennis balls, tennis bags,

toy balloons, lighters, cuff links, key charms, tie clasps, pen knives, salt and pepper shakers and cocktail napkins. n9 Opposer advertises in newspapers, periodicals, national magazines, radio, and television, and conducts point of purchase promotional advertising and promotional campaigns. Opposer maintains direct control of all advertising and any advertising by individual franchisees [*4] is done cooperatively with opposer.

n8 Although opposer offered a compilation of sales and advertising figures during the testimony of its witness, no consideration can be afforded those figures because, not only were the compilations prepared by others than the witness who were thus unavailable for cross-examination, but also because Mr. Heath had only been associated with opposer for a year and a half prior to the taking of his testimony and could not have had personal knowledge such as would enable him to testify to matters occurring more than thirty years prior thereto. See: *Viking Boat Company, Inc., Division of Coachmen Industries, Inc. v. Viking Camper Supply, Inc.*, 191 U.S.P.Q. 297 (TTAB, 1976) and *Ferro Corporation v. Nicofibers, Inc.*, 196 U.S.P.Q. 41 (TTAB, 1978).

n9 There was some testimony relative to water pistols as well. However, there is no evidence of such use and Mr. Heath's testimony is inconclusive on that point.

Applicant is a toy manufacturer having a varied line of toys including preschool toys, dolls, wind-up toys and games. Applicant's witness testified that the first shipment of a toy under the subject mark occurred in [*5] February 1978 and that the product has been continuously sold since that time. The toys in question here, one an elephant, the other a whale, are designed to be used in water. That is, each has a wind-up feature permitting it to be propelled through water and at the same time each emits a stream of water, the whale through a hole in its top and the elephant through its trunk. Applicant advertises through its catalogs and participation in the annual Toy Fair held in February. Sales figures were not given.

Opposer's discovery additionally reveals that applicant sells through sales representatives or jobbers to free-standing, n10 retail, discount, toy specialty and national chain stores.

n10 Free standing is defined by applicant as a trade term for independent retail stores.

In view of applicant's acknowledgment of opposer's registrations and since the question of priority does not arise against a registered trademark in an opposition proceeding, the issue of priority is resolved in favor of opposer. See: *Borg-Warner Corporation v. Pneumatic Hydraulic Development Co., Inc.*, 185 U.S.P.Q. 181 (TTAB, 1975).

The question which remains to be determined is whether [*6] the parties' marks, when used to identify their respective goods, are so similar as to be likely to cause confusion, mistake or deception within the purview of Section 2(d) of the Trademark Act.

The question of likelihood of confusion between the parties' marks must be determined in light of the goods on which those marks are used, since it is in connection with those goods that the marks will be encountered by prospective purchasers. With regard thereto, it is noted that there is no requirement that goods be similar or competitive in character to support a holding of likelihood of confusion. It is sufficient for that purpose that the goods are related in some manner or that conditions surrounding their marketing are such that they could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to a mistaken belief that they originate with or are in some way associated with the same producer. See: *Paulist Productions, Inc. v. Anna Broadcasting Co., Inc.*, 199 U.S.P.Q. 740 (TTAB, 1978). Establishing such a relationship is the burden of opposer.

Opposer's and applicant's goods are significantly different in [*7] physical characteristics as well as in use. Recognizing those differences, opposer has attempted to show that there is nevertheless a likelihood of confusion resulting from the marketing of the goods. Specifically, opposer contends that applicant's goods are sold in many of the same outlets as its own are and to the same purchasers; and that, moreover, its use of the mark on a number of different

promotional items, particularly toy balloons, increases the likelihood that purchasers would be confused.

The fact that opposer's and applicant's goods may be found in some of the same stores is not controlling on this question. It is well recognized that there are a number of commercial establishments where one can find a myriad of different items. *Royce Laboratories, Inc. v. The Coca-Cola Company*, 175 U.S.P.Q. 719 (TTAB, 1972) and *Faultless Starch Company v. Sales Producers Associates, inc.*, 185 U.S.P.Q. 824 (TTAB, 1975). But, no modern shopper would assume that the mere fact that goods are sold in the same stores dictates that they must have a common origin. As to opposer's promotional items, these are distributed, either by sale or as a gift, by purveyors [*8] of opposer's soft drinks. Under these conditions, there is no question that the recipient is made aware of their source. Their promotional value would be lost otherwise. To that end, these items, for the most part, bear messages or other indicia of their promotional intent. Some of the toy balloons, for example, carry the quote, "I drink SQUIRT".

As to the marks, the word common to both marks is "SQUIRT", defined variously as follows: "to eject liquid in a thin spurt" or as "an especially young, small upstart or impudent person given to meddling beyond his competence or concern." (Webster's Third New International Dictionary). As used by applicant "SQUIRT" has the descriptive connotation of emitting a spurt of liquid, as applicant's goods do, while opposer's use is suggestive of a characteristic of the grapefruit from which it takes its flavor which may also on occasion eject a spurt of liquid or it may suggest the small boy referred to in opposer's literature (Exhibit 36) as Squirt's character "Little Squirt" whose representation is used on several of opposer's promotional items, including balloons, as well as on its packaging. It is clear that the word has a suggestive meaning [*9] as used by the parties on their respective goods. The addition of other matter to that word by applicant removes its mark even farther from opposer's and, we believe, creates an entirely different commercial impression.

Considering the cumulative differences in the goods and in the marks, it is our opinion that "SQUIRT SQUAD" as used by applicant on floating water toys is not likely to be confused with "SQUIRT" as used on soft drinks, toy balloons, or any of the other products listed in opposer's registrations.

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