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

Proceeding	91184529
Party	Plaintiff Georgia-Pacific Consumer Products LP
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

GEORGIA-PACIFIC CONSUMER  
PRODUCTS LP,

Opposer,

v.

GLOBAL TISSUE GROUP, INC.

Applicant.

Opposition No.: 91184529

Serial No.: 77/364,616

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**OPPOSER GEORGIA-PACIFIC CONSUMER PRODUCTS LP'S MOTION TO  
COMPEL DISCOVERY AND BRIEF IN SUPPORT**

Opposer Georgia-Pacific Consumer Products LP (“GP”) moves the Board pursuant to Fed. R. Civ. P. 37(a), 37 C.F.R. § 2.120(e) and TBMP § 523.01 for an Order compelling Applicant Global Tissue Group, Inc. (“GTG”) to (a) appear for a further deposition in Atlanta, Georgia; and (b) answer questions subject to the Protective Order notwithstanding the purportedly “confidential” nature of the answers.

GTG’s counsel impeded the deposition by improperly instructing the witness not to answer deposition questions on the basis of confidentiality and relevance. These tactics are not permitted under the law and were designed entirely to hinder and delay the discovery process and increase the cost to GP of prosecuting this matter. GP incurred significant costs associated with the deposition, which took place in New York. GTG’s counsel’s behavior should not be rewarded by imposing an unnecessary and unfair burden on GP by requiring GP’s counsel (in Atlanta) to travel back to New York again to re-take the deposition.

The undersigned counsel certifies pursuant to 37 C.F.R. § 2.120(e) that he has made a good faith effort, by conference with counsel for GTG at the depositions, to resolve the issues presented in this motion, but has been unable to reach an agreement.

## I. RELEVANT FACTS

On June 24, 2009, GP took the properly noticed deposition of GTG's 30(b)(6) representative. GP's in-house and outside counsel traveled to New York for the deposition from their offices in Atlanta. The witness appeared for the deposition, but, upon instruction by counsel, refused to answer questions relating to numerous issues including:

- (a) The identity of retailers that sell GTG products, [REDACTED]  
[REDACTED]
- (b) The manufacture of GTG's paper products, including by any outside companies, [REDACTED]
- (c) The raw materials GTG uses in making its finished paper products, including the source of those raw materials, [REDACTED]
- (d) Testing conducted on behalf of GTG comparing the quality of its products and those of national brands, including GP, [REDACTED]
- (e) Whether GTG is a licensee of any trademarks for paper products, [REDACTED]  
[REDACTED]
- (f) GTG's private label and "co-branding" business and whether GTG intends to use the QUILTY mark in connection with same, [REDACTED]
- (g) Whether and how GTG products are priced such that they compete with national brands, [REDACTED]
- (h) Whether and how GTG intends to use the QUILTY mark in connection with certain of its "ultra-premium" products, [REDACTED] and
- (i) Alternative brand names GTG considered when it decided to proceed with the QUILTY mark, [REDACTED]

GP also took the deposition of GTG's CEO, Meir Elkenaveh, who refused to answer questions upon instruction by counsel regarding the quality control measures implemented by GTG in the manufacture of its paper products. [REDACTED]

[REDACTED]

Counsel for GTG not only objected to questioning regarding each of these topics, but – in direct contravention of the Rules and the law – instructed the witness not to answer any such questions on the grounds that (1) the information was confidential business information; and (2) the information purportedly was not relevant to the Opposition. Counsel for GTG maintained her instruction not to respond even when reminded of the existence of the Protective Order and GP's willingness to maintain the confidentiality of the transcript. [REDACTED]

[REDACTED]

GTG's objections on the basis of confidentiality are clearly spurious in light of the Protective Order that has been entered in this matter protecting the public disclosure of such information. Moreover, these issues are all related to the likelihood of confusion between the intended identical and closely related goods to be sold under Applicant's QUILTY mark and GP's QUILTED NORTHERN products and therefore are relevant. In any event, the law is clear that counsel may not instruct a witness not to answer a deposition question on the basis of relevance. *Resolution Trust Corp. v. Dabney*, 73 F.3d 262, 266 (10th Cir. 1995) ("It is inappropriate to instruct a witness not to answer a question on the basis of relevance.")<sup>2</sup>

Because neither of GTG's objections have merit, and instructions to the witness not to answer the question were improper, GTG's witnesses should be compelled to attend a further

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<sup>1</sup> Pursuant to 37 C.F.R. § 2.120(e), GP is attaching to its motion the relevant portions of the discovery depositions of Mr. Shaoul and Mr. Elkenaveh that contain the propounded questions at issue and the objections of GTG's counsel.

<sup>2</sup> The only proper bases upon which counsel may instruct a deposition witness not to answer a question are to preserve a privilege, to enforce a court-ordered limitation, or to present a motion under Rule 30(d)(3). FED. R. CIV. P. 30(c)(2); *see also Resolution Trust Corp.*, 73 F.3d at 266 (same); *Hall v. Clifton Precision, a Div. of Litton Sys., Inc.*, 150 F.R.D. 525, 531 (E.D. Pa. 1993) (same).

deposition to answer questions relating to these highly relevant topics. GP further requests that it be spared additional expense (that could have been avoided by proper behavior from GTG's counsel) and that the witnesses be compelled to appear at the office of GP's counsel in Atlanta, Georgia, to complete the depositions.

## **II. ARGUMENT**

### **A. The Protective Order Obviates GTG's Confidentiality Objection.**

In its Order of May 4, 2009, the Board entered the Protective Order, which prohibits the public disclosure of sensitive and proprietary business information designated by either party as "Confidential" or "Attorney's Eyes Only." *See* Docket No. 13. The very purpose of the Protective Order is to allow parties to discover relevant information that is sensitive and proprietary in nature while still protecting the confidentiality of this material.

Amazingly, after refusing to let witnesses answer questions on grounds of confidentiality, counsel for GTG then elected at the end of the depositions to designate both transcripts "Confidential." [REDACTED] Therefore, GTG's objection to each question at issue in this motion on the basis of "confidentiality" should be overruled.

### **B. GTG's Objections on the Ground of Relevance are Also Baseless.**

At the outset, it is black-letter law that counsel at a deposition may not instruct a witness not to answer a question on the ground that it seeks irrelevant information. *See Buckley Towers Condo., Inc. v. QBE Ins. Corp.*, No. 07-22988-CIV, 2008 WL 2645680, at \*7 (S.D. Fla. June 26, 2008) ("this Court has for many years enforced the principle that pure relevance objections cannot be the bases for instructions not to answer during a deposition."); *Luc Vets Diamant v. Akush*, No. 05 Civ. 2934 WHP, 2006 WL 258293, at \*1 (S.D.N.Y. Feb. 3, 2006) ("Lack of relevancy is not a proper ground for instructing a witness not to answer deposition questions.");

*Furniture World, Inc. v. D.A.V. Thrift Stores, Inc.*, 168 F.R.D. 61, 63 (D.N.M. 1996) (“case law as well as Rule 30(d)(1) clearly state that propounding an irrelevant question is not an appropriate ground for instructing a witness not to answer a question.”) (internal quotation omitted). Thus, while counsel may later seek to exclude certain testimony *at trial* on the ground that it is not relevant, during a *discovery* deposition, the witness is required to provide *all* non-privileged information sought. *See Vita-Mix Corp. v. Basic Holdings, Inc.*, No. 1:06 CV 2622, 2007 WL 2344750, at \*3 (N.D. Ohio Aug. 15, 2007) (“defendant is entitled to depose [plaintiff] on all relevant, non-privileged information that he may possess.”).

Moreover, the issues sought to be discovered by GP during the depositions are relevant to the issue of likelihood of confusion. In proceedings before the Board, the scope of discovery is governed by FED. R. CIV. P. 26, which provides:

Parties may obtain discovery regarding any nonprivileged matter that is relevant to any party's claim or defense--including the existence, description, nature, custody, condition, and location of any documents or other tangible things and the identity and location of persons who know of any discoverable matter.... Relevant information need not be admissible at the trial if the discovery appears reasonably calculated to lead to the discovery of admissible evidence.

T.B.M.P. § 402.01. At the discovery stage, relevance is construed liberally and discovery should be generously allowed unless it is clear, beyond any doubt, that the information sought can have no possible bearing upon the issues involved in the particular proceeding. *See Tequila Centinela, S.A. de C.V. v. Bacardi & Co. Ltd.*, 242 F.R.D. 1, 6 (D.D.C. 2007) (“The scope of discovery itself is broad, allowing for discovery regarding any matter, not privileged, relevant to a claim or defense. . . . The term relevance at the discovery stage is a broadly construed term and is given very liberal treatment.”); *Ralston Purina Co. v. McFarland*, 550 F.2d 967, 973 (4th Cir. 1977) (“We agree . . . that the deposition-discovery rules are to be accorded a broad and liberal

treatment. No longer can the time-honored cry of ‘fishing expedition’ serve to preclude a party from inquiring into the facts underlying his opponent’s case.’’) (internal quotation omitted).

At issue in this Opposition is whether GTG’s sale of paper products, including bath tissue, facial tissue, paper towels, and napkins, under the QUILTY mark is likely to cause consumer confusion with GP’s QUILTED NORTHERN bath tissue. Therefore, all questions regarding the types of products to be sold under the QUILTY mark, the manufacture and quality of these products, the intended retail outlets, and trade channels of these products are relevant to the likelihood of confusion analysis under the applicable *DuPont* factors.<sup>3</sup>

**1. The Identity of the Retailers that Sell GTG Products.**

[REDACTED]

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<sup>3</sup> These factors include (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression; (2) the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use; (3) the similarity or dissimilarity of established, likely-to-continue trade channels; (4) the conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing; (5) the fame of the prior mark (sales, advertising, length of use); (6) the number and nature of similar marks in use on similar goods; (7) the nature and extent of any actual confusion; (8) the length of time during and conditions under which there has been concurrent use without evidence of actual confusion; (9) the variety of goods on which a mark is or is not; (10) the market interface between applicant and the owner of a prior mark; (11) the extent to which applicant has a right to exclude others from use of its mark on its goods; (12) the extent of potential confusion, i. e., whether *de minimis* or substantial; (13) any other established fact probative of the effect of use. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973).

[Redacted text block]

**2. The Manufacture and Quality of GTG's Paper Products.**

[Redacted text block]

- [Redacted list item]
- [Redacted list item]
- [Redacted list item]

[Redacted text block]

[REDACTED]

[REDACTED]

**3. GTG's Trademark Licensing**

[REDACTED]

**4. GTG's Private Label and Contract Manufacturing Business**

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

**5. Pricing of GTG Products**

[REDACTED]

**6. Alternative Brand Names Considered by GTG**

[Redacted text block]

[Redacted text block]

**7. Use of the QUILTY Mark on Certain GTG Products**

[Redacted text block]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

### III. CONCLUSION

GTG's objections and instructions not to answer deposition questions on the basis of confidentiality and relevance are nothing more than blatant stonewalling designed to hinder and delay the discovery process and increase the cost to GP of prosecuting this matter. GP incurred considerable expense traveling from Atlanta, Georgia to Garden City, New York for these depositions, and having to travel back to New York again imposes an unfair burden on GP and rewards GTG's clearly improper behavior.

For the reasons discussed above, GP's motion should be granted, and the Board should issue an order compelling GTG to appear in Atlanta to continue the depositions and to provide the relevant and responsive information requested in this motion.

This 1st day of July, 2009.

Respectfully submitted,

/s/ R. Charles Henn Jr.

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that on this date, July 1, 2009, a copy of this paper has been served upon Applicant, by email and by U.S. mail, to Applicant's current identified counsel, as set forth below:

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**DEPOSITION OF MEIR ELKENAVEH**

**REDACTED**

**DEPOSITION OF PHILIP SHAOUL**

**REDACTED**