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

Proceeding	91184529
Party	Defendant Global Tissue Group, Inc.
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Attachments	Opp to Motion to compel.pdf ( 7 pages )(168481 bytes )

**BEFORE THE UNITED STATES  
TRADEMARK TRIAL AND APPEAL BOARD**

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GEORGIA-PACIFIC CONSUMER  
PRODUCTS LP,

Opposer,

v.

GLOBAL TISSUE GROUP, INC.,

Applicant.

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Opp. No. 91184529  
Serial No. 77/364616

**APPLICANT'S OPPOSITION TO MOTION TO COMPEL DISCOVERY**

In its Motion to Compel Discovery, Opposer asks the Board to rule on objections raised against questions Opposer asked during discovery depositions of Philip Shaoul, who appeared as Applicant's Rule 30(b)(6) representative, and Meir Elkenaveh, Applicant's CEO. For the reasons discussed in detail below, Applicant's objections regarding relevance were well-founded.

Moreover, Opposer's request that the Board compel responses to the disputed deposition questions is entirely inappropriate because it seeks the Board to rule on deposition objections mid-stream. The Board's rules and practice indicate that the Board should delay ruling on whether Applicant's objections are well placed, until the final hearing.

**ARGUMENT**

Opposer's motion improperly asserts that Applicant may not, during a discovery deposition, object to any question on the ground that it is not relevant

to the proceeding and thus not likely to lead to the discovery of admissible evidence. To the contrary, the Trademark Rules of Practice and Board precedent make clear that in opposition proceedings, such an objection may be interposed and that the Board will not consider objections to relevancy and materiality until the final hearing. See Trademark Rule 2.123, 37 CFR 2.123; Levi Strauss & Co. v. R. Josephs Sportswear Inc., 28 U.S.P.Q.2d 1464 (TTAB 1993); Health-Tex Inc. v. Okabashi (U.S.) Corp., 18 U.S.P.Q.2d 1409 (TTAB 1990).<sup>1</sup>

Trademark Rule 2.123 sets out the Board's practice that it will defer consideration of a relevancy objection until a final hearing in a case. Following that practice, the Board has ruled that "applicant is free to object and refuse to answer those questions which it believes are not relevant . . . ." Health-Tex Inc., 18 U.S.P.Q.2d at 1411. This is true even when there is a protective order in place. Red Wing Co. v. J.M. Smucker Co., 59 USPQ2d 1861 (TTAB 2001) (Applicant's objections to discovery attempting to learn business confidential information that is irrelevant to the proceeding at hand, namely manufacturing processes for Applicant's products not subject to the Opposition, were sustained even though a protective order was in place). Accordingly, Applicant was fully entitled to instruct its deposition witnesses not to answer certain questions based on its good faith belief that those questions sought information not relevant to the case.

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<sup>1</sup> The Rules and Procedures of this Board are not identical to those of federal district courts and Opposer's citation of only cases from the federal district courts to compel production fails to recognize these substantive procedural differences.

The discovery questions at issue in Opposer's motion seek specific information about how and where Applicant manufactures, markets, advertises, offers and sells other products, under other marks, as well as alternative marks under Applicant's consideration. Yet, this Opposition concerns an intent-to-use application for a mark that identifies a short and defined list of goods (namely, facial tissues, napkins, towels and bathroom tissues), readily understood by the general public. This is not a case where Applicant has listed an ambiguous or impossibly broad list of goods that need clarification. The parties are competitors in the paper products industry and understand precisely what goods are the subject of Applicant's trademark claim.<sup>2</sup> The issue in this Opposition boils down whether Opposer can show that Applicant's mark QUILTY would be seen as confusingly similar to any or all of its marks which incorporate the term QUILTED, with the wrinkle being that Opposer has consistently disclaimed the term QUILTED in its registrations and there are several third party used of the term "quilted" on similar products which support the need for disclaimer. That's the issue—everything else is, in the proverbial sense, merely "window dressing."

Rather than recognize the simplicity of the issue that this matter presents, Opposer has embarked on a fishing expedition regarding Applicant's other products, Applicant's specific business affiliations, Applicant's sources of raw materials, its quality control measures, its pricing information, and on and on.

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<sup>2</sup> Moreover, because Applicant has not yet used the mark at issue and determined to defer its undertaking use of the mark while Opposer's allegations cast a cloud over Applicant's right to do so, Applicant does not have reams of paper to produce in discovery. Such an absence of documents has been deemed understandable and reasonable by the Board and its commentators. See, e.g., *Blair Corp. v. Fassinger*, Opp. No. 91166414 (TTAB October 17, 2008) and *Proving your Bona Fides – Establishing Bona Fide Intent to Use Under the U.S. Trademark (Lanham) Act*, 99 TMR 763, 778—783 (2009).

This information has no relevance to the case at hand. Opposer's effort to gain the most sensitive and confidential business secrets regarding Applicant's other products and business practices stretches the idea of relevant and focused discovery beyond reasonable limits. Opposer attempts to couch its need for this information as key to proving likelihood of confusion. In no uncertain terms, this information (a) has nothing to do with the marks themselves; and (b) is not needed to establish similarity of the goods in issue, common channels of trade, or common classes of purchasers. Both parties understand that they are, and will continue to be, direct competitors in the paper goods market. As is evident from the facts within the four corners of Applicant's intent-to-use application and the facts within the four corners of Opposer's registrations listed in Paragraph 3 of the Notice of Opposition, Applicant's proposed mark identifies goods that will compete directly with, and travel in the same channels of trade as, the goods identified in Opposer's claimed registrations. Given that Applicant concedes the similarity of goods, what possible relevance does the information sought by Opposer have to this proceeding? The answer is none.

By stating what should be patently obvious to all, i.e., that Applicant's paper products will compete with Opposer's (and in the same trade channels and to the same customers), Applicant effectively accepts any adverse inference the Board would draw at a final hearing were the Board to rule that Applicant's objections were not well placed. Health-Tex Inc., 18 U.S.P.Q.2d at 1411 (finding that if a party refuses to answer a question based on an objection later found to be not well taken, "the Board will presume that the answer to the question would

have been adverse to the position of the party whose witness refused to answer.”). To be sure, the only basis that Opposer offers to support the relevancy of the disputed deposition questions is that the information sought may tend to prove one or more facets of likelihood of confusion between the two marks.<sup>3</sup> Applicant’s stipulation that its mark will be used on directly competing goods marketed to the same class of purchasers in similar channels of trade effectively and irrefutably ends any justifiable need for the discovery Opposer is moving to compel<sup>4</sup>—particularly, in the context of a mark that has not yet been used in commerce, information about Applicant’s other products could only be applied to this Opposition in a speculative manner. In contrast, Applicant’s stipulation is absolute. To compel further discovery on these issues would impose undue cost and delay, for no legitimate purpose.

### **CONCLUSION**

Opposer’s requested relief should not be granted in view of the Board’s practice of delaying ruling on deposition objections until final hearing, particularly where, as here, Applicant has effectively conceded the points that the Board would draw as adverse inferences were it to find that Applicant’s objections were not well placed. If the Board nevertheless permits Opposer to take a further deposition, long-standing discovery practice requires that depositions take place

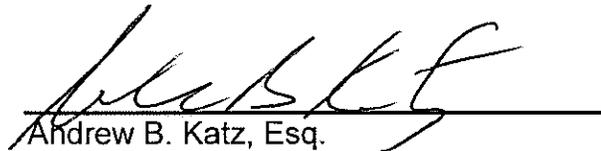
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<sup>3</sup> Likelihood of confusion boils down to two inquiries: a comparison of the marks and a comparison of the described goods and services. Again, since none of the sought information relates to the comparison of marks, Opposer is basically arguing that it needs the information to show that the goods would be deemed similar, the channels of trade would be deemed similar and the class of purchasers would be deemed similar.

<sup>4</sup> This includes all of Opposer’s attenuated sub-inquiries, such as “what if Applicant’s goods were somewhat inferior to Opposer’s goods” and “what if Applicant’s goods were less expensive than Opposer’s good” etc. No matter how one looks at it, every one of them hinges on the same similarity of goods (and channels of trade) inquiry which is conceded as “similar.”

where the witness resides or is regularly employed. 37 C.F.R. § 2.120(b).  
Applicant interposed its objections in good faith, based on clear Board procedure and precedent. Thus, there is no basis to deviate from the general rule that a deposition of a corporate entity be taken near the corporation's place of business.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "A. Katz", is written over a solid horizontal line.

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Dated: July 13, 2009

**CERTIFICATE OF SERVICE**

I hereby certify that on this 13th day of July, 2009, a true and correct copy of the foregoing Applicant's Opposition to Motion to Compel Discovery was sent by first class mail, postage pre-paid to the following:

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