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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

**REPLY TO APPLICANT'S OPPOSITION TO OPPOSER GEORGIA-PACIFIC
CONSUMER PRODUCTS LP'S MOTION TO COMPEL DISCOVERY**

In its Opposition to Georgia-Pacific's ("GP") Motion to Compel, Applicant Global Tissue Goup, Inc. ("GTG") does not dispute, and thereby concedes, that the deposition questions its witnesses refused to answer are relevant to the issues in this Opposition, and that it thus had no legitimate basis for refusing to answer these questions. GTG also does not defend its confidentiality objections in its Opposition, and thereby has effectively withdrawn these objections as well.¹ That GTG did not even attempt to defend its objections and instructions not to answer deposition questions on the merits underscores that these objections are nothing more than blatant stonewalling designed to hinder and delay the discovery process and increase the cost to GP of prosecuting this matter.

As shown in GP's Motion to Compel, GP's deposition questions were relevant to the issues in this lawsuit, and the Board rules state that a motion to compel is the proper vehicle for relief where a party refuses to answer questions in a discovery deposition. *See Johnston Pump/General Valve, Inc. v. Chromalloy American Corp.*, 10 U.S.P.Q.2d 1671, 1672 (T.T.A.B.

¹ At the depositions at issue, counsel for GTG had also interposed "confidentiality" objections. *See, e.g.*, Shaoul Dep. at 13:24-14:22, 38:13-40:10, 64:4-65:2. GP noted in its motion to compel that these objections were baseless in light of the Stipulated Protective Order entered in this case. *See* GP's Motion to Compel and Brief in Support, at 4.

1988) (granting motion to compel). Therefore, the Board should grant GP's Motion to Compel and order the completion of the depositions in Atlanta, to spare GP additional expense already incurred in traveling to New York.

Rather than defending its objections on the merits, GTG erroneously relies on Rule 2.123 in contending that: (1) the Board cannot rule on its objections until the time of the final hearing; and (2) by stipulating to certain facts it can evade having to answer the deposition questions. Trademark Rule 2.123 clearly applies only to depositions taken as *trial testimony*, and thus GTG's arguments improperly confuse a *discovery* deposition with a *testimony* deposition. *See* 37 C.F.R. § 2.123.

Trademark Rule 2.123 provides that objections raised during a *testimony* deposition will not be considered by the Board until the final hearing (and not in a motion to compel), and that parties may stipulate to certain facts in writing in lieu of taking testimony. *See* 37 C.F.R. § 2.123(b) and (k). There are no such provision in Trademark Rule 2.120, which governs *discovery* depositions, and permits a party to file a motion to compel where a witness fails to answer a question propounded in a discovery deposition, and provides no basis for a party to avoid discovery by conceding certain facts. *See* 37 C.F.R. § 2.120(e).

The TTAB Manual of Procedure ("TMBP") clarifies these differences between discovery and testimony depositions:

In a discovery deposition, a party may seek information that would be inadmissible at trial, provided that the information sought appears reasonably calculated to lead to the discovery of admissible evidence. In a testimony deposition, a party may properly adduce only evidence admissible under the applicable rules of evidence; inadmissibility is a valid ground for objection.

In both types of depositions, questions objected to ordinarily should be answered subject to the objection, but a witness may properly refuse to answer a question asking for information that is...privileged or confidential.

TMBP § 404.09 (citing FED. R. CIV. P. 26(b)(5) and 30(c)). Thus, the TMBP, consistent with FED. R. CIV. P. 30(c), is clear in prohibiting a party from refusing to answer a question on the grounds of relevance in a discovery deposition. *See* FED. R. CIV. P. 30(c)(2) (providing that 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)); *see also* *Resolution Trust Corp. v. Dabney*, 73 F.3d 262, 266 (10th Cir. 1995) (same); *Hall v. Clifton Precision, a Div. of Litton Sys., Inc.*, 150 F.R.D. 525, 531 (E.D. Pa. 1993) (same).

The TMBP also states that a motion to compel is the proper vehicle for relief when a deponent refuses to answer a question in a discovery deposition. *See* TMBP § 404.09 (“In the case of a discovery deposition, there is also available to the propounding party the simpler and more convenient alternative of completing the deposition and then filing a motion with the Board to compel the witness to answer the unanswered question.”). It further distinguishes a testimony deposition, where a motion to compel is not available, “nor is there any other mechanism for obtaining from the Board, prior to a final hearing, a ruling on the propriety of an objection to a question propounded during a testimony deposition.” *Id.* It is only for testimony that, if the Board finds that the relevance objection was not well taken, it may presume that the answer would have been unfavorable to the position of the party whose witness refused to answer. *Id.* The option of accepting such a presumption is not available to GTG at the *discovery* deposition stage.

The cases cited by GTG also do not support its proposition. In *Health-Tex, Inc. v. Okabashi Corp.*, 18 U.S.P.Q.2d 1409 (T.T.A.B. 1990), the Board declined under Trademark Rule 2.123 to rule on relevancy objections interposed at a *testimony* deposition, not a discovery

deposition, and deferred ruling on such objections until the time of the hearing. *Id.* at 1410-11; *see also Levi Strauss & Co. v. R. Josephs Sportswear, Inc.*, 28 U.S.P.Q.2d 1464, 1467-68 (T.T.A.B. 1993) (finding that party's objections and refusal to answer questions in testimony deposition were not well-taken and applying inference that the answers would have been adverse to party's position).

The Board has held that a motion to compel is the proper vehicle for relief where a party refuses to answer questions in a discovery deposition. *See Johnston Pump/General Valve, Inc. v. Chromalloy American Corp.*, 10 U.S.P.Q.2d 1671, 1672 (T.T.A.B. 1988). In *Johnston Pump*, the Board found that the deposed party had improperly refused to answer questions regarding the types of products on which the mark at issue was used, the manufacture, distribution, and sales of the products, and any licensing arrangements entered into by the party, and granted the moving party's motion to compel responses to these questions. *Id.* at 1673-74.

Not only is GTG's position unsupported by the law, as a practical matter it is ludicrous for GTG to suggest that the Board cannot consider GP's motion to compel, and that GP must wait to rule on GTG's baseless objections until the time of the hearing. Such a rule would effectively foreclose GP from being able to take any discovery. GTG could freely continue to stonewall and refuse to answer relevant questions, and GP would not have any available relief until after discovery had already closed. Such a result is fundamentally inconsistent with the concept of discovery and the Rules governing it.

GTG next argues that it is not required to answer deposition questions because it is willing to concede that the goods in issue, the channels of trade, and classes of purchasers are identical. GTG does not cite any Board rule or other authority to support its position that such a concession permits a party to evade its discovery obligations. While GP is certainly willing to

accept a stipulation to these facts at the time of the final hearing pursuant to Trademark Rule 2.123,² it is not a ground upon which GTG can refuse to answer legitimate questions when GP is undertaking to discover facts during the discovery period. *See J.F. Edwards Construction Co. v. Anderson Safeway Guard Rail Corp.*, 542 F.2d 1318, 1324 (7th Cir. 1976) (holding that the court is not required to accept stipulation of facts offered by a party where it has refused to answer deposition questions during discovery). GP is still entitled to seek discovery on these issues.

Moreover, the questions that GTG's witnesses were instructed not to answer pertained to more than just the three likelihood of confusion factors of similarity of goods, trade channels, and purchasers. GTG's witnesses also refused to answer questions pertaining to its intent in adopting the mark (Shaoul Dep. at 158:7-159:12), the quality of its goods and quality control measures (Shaoul Dep. at 11:11-15:2; Elkenaveh Dep. at 25:20-27:6), and whether GTG is a licensee for trademarks for paper products (Shaoul Dep. at 99:7-101:7). As discussed in GP's Brief in Support, all of these issues—in addition to the similarity of goods, trade channels, and purchasers—are relevant to the likelihood of confusion analysis under the applicable *DuPont* factors, and are thus discoverable. *See In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973).

For these reasons, and those already set forth in GP's Motion to Compel and Brief in Support, 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 the motion.

² Trademark Rule 2.123(b) provides that “the facts in the case of any party may be stipulated in writing” in lieu of trial testimony. 37 C.F.R. § 2.123(b).

This 3rd day of August, 2009.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this date, August 3rd, 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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