

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451**

Mailed: September 9, 2009

Opposition No. 91184529

Georgia-Pacific Consumer
Products LP

v.

Global Tissue Group, Inc.

Jennifer Krisp, Interlocutory Attorney:

This proceeding is before the Board for consideration of opposer's motion (filed July 1, 2009) to compel discovery. The motion is fully briefed.¹

The Board may resolve a motion filed in an inter partes proceeding by telephone conference. See Trademark Rule 2.120(i)(1); TBMP § 502.06(a) (2d ed. rev. 2004). On September 8, 2009, the Board convened a telephone conference to resolve the issues presented in the motion. Participating were opposer's counsel R. Charles Henn, Jr., Esq., applicant's counsel Andrew B. Katz, Esq., and the assigned Interlocutory Attorney.

Opposer's motion for leave to amend

¹ The Board gives no consideration to applicant's sur-reply filed August 10, 2009. See Trademark Rule 2.127(a); TBMP § 502.02(b) (2d ed. rev. 2004).

On January 4, 2008, applicant filed application Serial No. 77364616 for registration of the mark QUILTY (standard characters) for "consumer and industrial paper products, namely, facial tissues, napkins, towels and bathroom tissues" in International Class 16. On June 11, 2008, opposer filed a notice of opposition to registration.

On June 30, 2009, opposer filed a motion for leave to amend its notice of opposition to add a claim that applicant had no bona fide intent to use the mark in commerce at the time the application was filed. This claim is set forth in paragraph 26 of the proposed amended notice of opposition. By way of its July 10, 2009 response to said motion, applicant indicated that it consents to the request for leave to amend, but disputes and denies the substantive basis for such amended notice as set forth in opposer's motion.

Amendments to pleadings in inter partes proceedings before the Board are governed by Fed. R. Civ. P. 15, made applicable to Board proceedings by operation of Trademark Rule 2.116(a). After a responsive pleading has been filed, a party may amend its pleading only by written consent of every adverse party, or by leave of the Board. Leave shall be freely given when justice so requires. See Fed. R. Civ. P. 15(a). The Board liberally grants leave to amend pleadings 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 party or parties. See TBMP § 507.01 (2d ed. rev. 2004). See also *Hurley International LLC v. Volta*, 82 USPQ2d 1339, 1341 (TTAB 2007).

Opposer's motion for leave to amend is granted. Fed. R. Civ. P. 15(a); Trademark Rule 2.107(a). The amended notice of opposition filed on June 30, 2009 is now the operative pleading in this proceeding.

Opposer is allowed fifteen (15) days from the mailing date of this order in which to file with the Board, and serve on applicant, an executed amended notice of opposition. See TBMP § 507.01 (2d ed. rev. 2004). Applicant is allowed thirty (30) days from the date of service of the amended notice of opposition in which to file its answer thereto.

Opposer's motion to compel discovery²

Opposer took the discovery depositions of applicant's Fed. R. Civ. P. 30(b)(6) designee Philip Shaoul, and of applicant's CEO Meir Elkenaveh, during which applicant's counsel interposed objections, with respect to certain questions, based on relevance and/or confidentiality, and instructed the respective witness not to respond. Opposer

² The parties should note that it is the policy of the Board that, when possible, only confidential portions of motions and papers filed with the Board shall be filed under seal. See Trademark Rule 2.27(e). All filings should be available for public review, only confidential materials such as trade secret information should be filed under seal, and redacted versions of depositions and similar papers may be filed as part of the public record, with only truly confidential content deleted therefrom. The parties are directed to Trademark Rules 2.27(d) and (e), and TBMP §§ 412.04 and 412.05, as appropriate, with respect to future motions and papers that may be filed in this proceeding.

seeks an order compelling these two persons to each appear for further discovery deposition, in Atlanta, Georgia, the location of opposer and opposer's counsels' offices, for the purpose of responding to questions posed and not responded to under objection during said depositions.

In support of its request, opposer argues, inter alia, that counsel for applicant's objections on the basis of confidentiality are spurious in view of the applicability and enforceability of the parties' Protective Order, and that the Protective Order obviates applicant's objections based on confidentiality. Opposer asserts that counsel's instructions to applicant's witnesses not to answer on the basis of relevance were improper, and that relevance is not an appropriate ground for objecting to non-privileged matter during a discovery deposition.

In response, applicant states, inter alia, that the objections it posed regarding relevance were well-founded, that applicant may object and refuse to answer questions on the basis of relevance, even when there is a protective order in place, that the questions at issue seek information about "other products under other marks," and that the application is based on intent to use the involved mark, rather than actual use. Citing Trademark Rule 2.123, applicant further asserts that the Board should defer consideration of and ruling on the merits of applicant's objections until the case is decided at final hearing.

The Board finds that opposer made a good faith effort, through communications with applicant's counsel, as well as attempted telephone contact with the assigned Interlocutory Attorney, to resolve the discovery dispute presented in its motion to compel, as required by Trademark Rule 2.120(e)(1).³ Furthermore, opposer, as movant, includes in its motion counsel's statement that he made a good faith effort, by conference with opposing counsel, to resolve the issues presented in opposer's motion. The motion is further in compliance with Trademark Rule 2.120(e)(1) inasmuch as it is accompanied by a copy of the matter at issue, namely, relevant questions propounded and objections made during portions of the two discovery depositions at issue.

In its June 11, 2008 order instituting this proceeding, the Board indicated that the Standard Protective Order was applicable and enforceable in this proceeding since the date of its commencement. See Trademark Rule 2.116(g). Pursuant to the Board's May 4, 2009 order, the parties' modified Protective Order has been applicable as of May 4, 2009.

The scope of discovery in Board proceedings is governed by Fed. R. Civ. P. 26(b)(1). See TBMP § 402.01 (2d ed. rev. 2004). A motion to compel is the proper vehicle for relief where a party refuses to respond to questions posed in a discovery deposition. See Trademark Rule 2.120(e); TBMP § 411.03 (2d ed. rev. 2004). See also *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 189 (TTAB 1974).

³ The interlocutory attorney was unavailable at the time of said

If a party believes that a question propounded at a discovery deposition is improper, it may state its objection thereto. Questions objected to ordinarily should be answered subject to the objection, but a witness may properly refuse to answer a question asking for information which is, for example, privileged or confidential. See TBMP § 404.08(c) (2d ed. rev. 2004).

Turning to the discovery dispute, it is initially noted that applicant's reliance on Trademark Rule 2.123 is misplaced inasmuch as the Rule governs the noticing and taking of trial testimony in inter partes cases. With respect to the analysis that the Board undertakes in an inter partes case to resolve an issue of likelihood of confusion under Trademark Act Section 2(d), all or any appropriate combination of the thirteen factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), may be relevant to or potentially relevant to the issue. Applicant's argument that likelihood of confusion "boils down to" a comparison of the marks and a comparison of the identified goods and/or services sets forth an unduly truncated analysis. Moreover, while the Board notes applicant's willingness to stipulate "that its mark will be used on directly competing goods marketed to the same class of purchasers in similar channels of trade," and notes that applicant again offered to enter into this

telephone call, and opposer's counsel left a voicemail message.

stipulation during the conference, opposer has not agreed to so stipulate.

In its motion, opposer seeks an order addressing each of several topics to which applicant's counsel objected on the grounds of relevance and/or confidentiality, and directed its Fed. R. Civ. P. 30(b)(6) witness not to respond. Opposer also seeks an order addressing a topic on which applicant's counsel objected and directed applicant's CEO not to respond.

With respect to the identity of retailers that sell applicant's products, opposer's motion is denied insofar as opposer seeks the names of such individual retailers. Applicant's objections are overruled, and opposer's motion is granted, only to the extent that opposer may seek the class or type of retailers (e.g. department stores, retail pharmacies, etc.) that sell applicant's goods on which applicant uses the involved mark. See TBMP § 414(16) (2d ed. rev. 2004).

As regards identification of the manufacturers of applicant's paper products, including manufacture by any outside companies, opposer has failed to establish the relevance of questions directed to this information, and its motion is denied. With respect to questions seeking locations of places of business where applicant manufactures facial tissues, napkins, towels and bathroom tissues under the involved mark, opposer's motion is granted. See TBMP § 414(15) (2d ed. rev. 2004).

With respect to the raw materials applicant uses in making its finished paper products, including the source of those raw materials, as they specifically relate to facial tissues, napkins, towels and bathroom tissues, and with respect to testing conducted on behalf of applicant comparing the quality of its products and those of national brands, as such testing specifically relates to facial tissues, napkins, towels and bathroom tissues, these topics are relevant to the similarity of, nature of, and trade channels of the goods. Accordingly, opposer's motion is granted insofar as opposer seeks information regarding applicant's facial tissues, napkins, towels and bathroom tissues.

With respect to whether applicant is a licensee of any trademarks for paper products, information that a party sells the same goods as the propounding party is relevant to likelihood of confusion, even if such goods are sold under a different mark. Accordingly, applicant's objections are overruled and opposer's motion is granted to the extent that opposer seeks information about license agreements involving goods that are the same as opposer's goods. See TBMP §§ 414(10) and 414(11) (2d ed. rev. 2004).

Regarding applicant's private label and co-branding business, and whether applicant intends to use the QUILTY mark in connection with applicant's private label and co-branding business, questions that specifically relate to applicant's use of or intent to use its involved mark on

either its own identified goods, or on goods that are the same as those sold by opposer, are proper and are relevant to the issues of the similarity of the goods and commercial impression of the marks. Accordingly, to the extent that opposer's questions relate to applicant's involved mark, opposer's motion is granted. See TBMP § 414(11) (2d ed. rev. 2004).

With respect to whether and how applicant's paper products are priced such that they compete with national brands, opposer has established that such questions related to applicant's facial tissues, napkins, towels and bathroom tissues are relevant to the issues of the similarity of the parties' goods and buying conditions. Accordingly, opposer's motion is granted with respect to questions regarding applicant's facial tissues, napkins, towels and bathroom tissues.

Regarding whether and how applicant intends to use the QUILTY mark in connection with certain of its "ultra-premium" products, inasmuch as applicant has alleged that it has a bona fide intent to use the involved mark, applicant's intended use of the involved mark is relevant, at a minimum, to the similarity of the goods. Accordingly, opposer's motion is granted.

With respect to alternative brand names applicant considered when deciding to proceed with the QUILTY mark, opposer's motion is granted in regard to questions seeking information concerning applicant's selection and adoption of

its QUILTY mark. The motion is denied to the extent that any questions seek information regarding what third parties' marks applicant considered in the course of selecting its mark. See TBMP § 414(4) (2d ed. rev. 2004).

Inasmuch as opposer's motion has been granted with respect to opposer's request to further depose applicant's Fed. R. Civ. P. 30(b)(6) designee on the topic of testing comparing the quality of applicant's products and those of national brands, opposer's motion seeking further deposition of applicant's CEO, Meir Elkenaveh, on the topic of implemented quality control measures, is denied.

In summary, opposer's motion to compel discovery is hereby denied in part and granted in part, as indicated herein.

Applicant is directed, within forty-five (45) days of the mailing date of this order, to make its Fed. R. Civ. P. 30(b)(6) designee Philip Shaoul available for continued deposition, and to respond to questions posed in accord with the Board's findings herein, subject to the parties' Protective Order. Such deposition is to be taken, pursuant to Trademark Rule 2.120(b), in the Federal judicial district where the designee resides or is regularly employed, or at a place on which the parties agree by stipulation.⁴

⁴ Opposer's request that the Board compel applicant's witness or witnesses to appear for deposition in Atlanta, Georgia, the place of employment of opposer and opposer's counsel, is denied. Opposer has set forth no basis on which to deviate from the general rule that a deposition of a corporate entity be taken near the corporate place of business.

Applicant should note that, in the event that a party withholds proper discoverable matter in the course of the discovery depositions, the party will be precluded, during trial, from adducing or relying on any such information that it withheld but should have produced. See, e.g., *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1677 (TTAB 1988).

Schedule

Proceedings are hereby resumed. The expert disclosure deadline, the close of discovery, and trial dates are reset as follows:

Expert Disclosures Due	11/2/2009
Discovery Closes	12/2/2009
Plaintiff's Pretrial Disclosures	1/16/2010
Plaintiff's 30-day Trial Period Ends	3/2/2010
Defendant's Pretrial Disclosures	3/17/2010
Defendant's 30-day Trial Period Ends	5/1/2010
Plaintiff's Rebuttal Disclosures	5/16/2010
Plaintiff's 15-day Rebuttal Period Ends	6/15/2010

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.