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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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Submission	Motion to Amend/Amended Answer or Counterclaim
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Date	11/25/2009
Attachments	Motion and Brief for Leave to Amend Answer.pdf ( 90 pages )(2995015 bytes )



## **FACTUAL BACKGROUND**

Following the Board's most recent decision of September 9, 2009, an Amended Notice of Opposition was filed by Georgia-Pacific on September 9, 2009, and an Amended Answer was filed by Global Tissue on October 7, 2009. A further deposition of Global Tissue's 30(b)(6) designee was conducted on October 23, 2009 in accordance with the Board's order. Following the completion of this further deposition, Hoffmann & Baron was retained by Global Tissue, and asked to assume responsibility for the above-referenced Opposition on a going-forward basis.

On November 2, 2009, the undersigned attorney contacted Charlene Marino, counsel for Georgia-Pacific, and informed her that Hoffmann & Baron was assuming responsibility for this matter, and that Hoffmann & Baron would be filing a Notice of Appearance. Moreover, Ms. Marino was informed that Hoffmann & Baron would be serving Notices of Deposition directed to the individuals named in the discovery responses received from Georgia-Pacific. This conversation was confirmed by email dated November 2, 2009, a copy of which is attached as Exhibit B.

On November 3, 2009, Hoffmann & Baron filed a Notice of Appearance in this proceeding, a copy of which was served upon counsel for Georgia-Pacific (attached as Exhibit C). On November 4, 2009, six Notices of Deposition were served upon counsel for Georgia-Pacific (attached as Exhibit D).

Ms. Marino advised the undersigned attorney by telephone on November 5, 2009 that not one of the named individuals or a 30(b)(6) designee was available for deposition during the remaining month of the discovery period, but that Andrew Towle would be

available on December 3, 2009 in a 30(b)(6) capacity, one day after the close of discovery. Ms. Marino further advised the undersigned attorney that Georgia-Pacific believed that noticing six depositions was unreasonable, but that Georgia-Pacific would agree to produce a 30(b)(6) witness, as well as one other witness, both outside of the discovery period. Finally, Ms. Marino advised the undersigned attorney that Georgia-Pacific was not willing to extend the discovery period.

Global Tissue refused to accept Georgia-Pacific's proposal, and insisted that Global Tissue was entitled to depose all of the named individuals. After reminding Ms. Marino that the named individuals were the same persons identified in Georgia-Pacific's responses, counsel for Global Tissue requested that Ms. Marino confirm with her client whether or not they would be willing to produce all the named individuals, and to provide proposed dates for such individuals. No response was ever received to this request. Accordingly, counsel for Global Tissue telephoned Ms. Marino on November 16, 2009, and followed up by letter dated November 17, 2009, a copy of which is attached as Exhibit E. A redacted version of Ms. Marino's letter of November 18, 2009 is attached as Exhibit F.<sup>1</sup>

Counsel for Global Tissue again conferred with Ms. Marino by telephone on November 19, 2009 to confirm that Georgia-Pacific was unwilling to consent to a 60-day extension of the discovery period, that Georgia-Pacific was unwilling to produce all 6 witnesses, and that Georgia-Pacific was unwilling to consent to the filing of an amended Answer. Global Tissue's counsel was advised that Georgia-Pacific was standing by the

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<sup>1</sup> The dollar figure presented to Georgia-Pacific during settlement discussions is confidential, and should not be made part of the public record.

position set forth in its November 18<sup>th</sup> letter. This discussion was confirmed by letter dated November 20, 2009, a copy of which is attached as Exhibit G.

### ARGUMENT

Rather than filing a separate cancellation proceeding, the TTAB has held that it is “mandatory that a party assert as a counterclaim any claim...against the adverse party, provided that the counterclaim arise out of the subject matter of the transaction or occurrence which is the subject matter of the other party’s claim.” *Endo Laboratories, Inc. v. Fredericks*, 197 U.S.P.Q. (BNA) 560, 561 (T.T.A.B. 1977). The policy behind this rule is to allow for consolidation of related claims for purposes of efficiency and to avoid a “multiplicity” of suits. *Id.* Leave to amend, so as to include a counterclaim, should be freely given when justice so requires. Fed. R. Civ. P. 15(a).

As noted by the interlocutory Attorney in charge of this proceeding in her decision of September 9, 2009, 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 prejudiced to the rights of the adverse party or parties.” TBMP §507.02 (2d ed. rev. 2004). In this regard, the Board is to consider whether there is (1) any undue prejudice to Opposer; and (2) whether the amendment is legally sufficient. *Commodore Elecs. Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503, 1505 (T.T.A.B. 1993).

TBMP §507.02(b) notes that the timing of a motion for leave to amend is particularly important in the case of a motion for leave to amend to assert a counterclaim

for cancellation of one or more of the plaintiff's pleaded registrations. If grounds for the counterclaim are known to the defendant when its answer to the Complaint is filed, the counterclaim should be pleaded with or as part of the answer. If, during the proceeding, the defendant learns of grounds for a counterclaim to cancel a registration pleaded by the plaintiff, the counterclaim should be pleaded promptly after the grounds therefore are learned. TBMP § 507.02(b).

Global Tissue will discuss each of these factors in detail hereinbelow.

**A. There is No Undue Prejudice to Opposer**

An adverse party will not be prejudiced if a motion for leave to amend pleadings is granted while the discovery period is still open. "Generally speaking, if the Board proceeding is still in the pre-trial stage...leave to amend, if otherwise appropriate, will be allowed...The fact that an adverse party may be prejudiced as a result of delay to the proceedings is generally outweighed by the principle that there should be a full adjudication." Chapman, "TIPS FROM THE TTAB: AMENDING PLEADINGS: THE RIGHT STUFF," 81 T.M.R. 302, 305 (1991). *Compare to Endo Laboratories, supra* (holding that the counterclaims could not be asserted because the discovery period had closed).

Here, not only is discovery still ongoing, but Global Tissue has requested a 60-day extension of time in its concurrently-filed Motion to Extend Discovery Period. To the extent Georgia-Pacific may need time to defend these new counterclaims, the requested 60-day extension of time should be more than sufficient. However, if Georgia-Pacific believes that it needs additional time to investigate/defend these new

counterclaims, Global Tissue is willing to consent to a longer extension of the discovery period. Notwithstanding the foregoing, it should be kept in mind that any facts/evidence that Georgia-Pacific needs to defend these counterclaims are in its own possession, not in the possession of Global Tissue or any other party.

**B. The Counterclaims are Legally Sufficient**

In order to set forth a properly pleaded counterclaim, Global Tissue “need only allege in its amended pleading such facts as would, if proven, establish both its standing to challenge [Georgia-Pacific’s] right to registration and a . . . statutory ground for [cancellation of the registration]. See *Commodore Elecs. Ltd.*, 26 U.S.P.Q.2d at 1506 (citing *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 U.S.P.Q. 185, 188 (C.C.P.A. 1982)). The counterclaims set forth in the proposed Amended Answer clearly satisfy these requirements.

**C. The Counterclaims were Promptly Plead Once Sufficient Facts were Uncovered**

As mentioned hereinabove, the newly-asserted counterclaims request cancellation of sixteen of Georgia-Pacific’s registered trademarks on the grounds of mere descriptiveness and/or abandonment. Before being able to plead these counterclaims, it was necessary for Global Tissue to investigate the facts underlying such counts. More particularly, it was necessary to seek discovery from Opposer, some of which remains outstanding. It was also necessary to consider the 32,000+ pages of documents produced by Georgia-Pacific.

Moreover, Global Tissue only recently learned of additional documents/evidence contained in Georgia-Pacific's ongoing dispute with Kimberly-Clark. Opposer failed to produce documents from this dispute with Kimberly-Clark, or to even identify the existence of this dispute to Global Tissue, despite having been asked for such information in Global Tissue's discovery requests, e.g., Request Nos. 16, 17, 21 and 22 of Applicant's First Set of Requests for the Production of Documents (attached as Exhibit H). This point is discussed in counsel's letter of November 17, 2009 and November 18, 2009, attached as Exhibits E and F.<sup>2</sup> Applicant learned of this dispute through its own research, and has been reviewing the lengthy and extensive papers from both the litigation and cancellation proceeding. The documents uncovered in these proceedings support the grounds underlying Global Tissue's counterclaims.

In sum, Applicant has been required to extend substantial efforts to obtain the facts/evidence supporting its counterclaims. Having now obtained sufficient facts/evidence to support its counterclaims, Applicant has promptly filed the present motion seeking leave to amend its pleadings.

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<sup>2</sup> Although counsel for Georgia-Pacific has taken the position that these prior proceedings are not relevant and/or responsive to any discovery requests, it should be noted that the Amended Complaint filed by Georgia-Pacific on March 18, 2009 actually identifies many of the same trademark cited in this opposition proceeding (See Pages 14-16 of the Amended Complaint attached as Exhibit I), and that the Motion to Suspend filed in Cancellation Proceeding No. 92051438 includes the statement by Georgia-Pacific that "Georgia-Pacific's Amended Complaint asserts rights deriving in part from its QUILTED and QUILTED NORTHERN trademarks, which are covered by numerous trademark registrations, including..." (see Pages 2-4 of the Motion to Suspend attached as Exhibit J). It is to be noted that both the Amended Complaint and the Motion to Suspend were prepared by the very same law firm representing Georgia-Pacific in this proceeding.

## CONCLUSION

In sum, there would be no undue prejudice to Georgia-Pacific in allowing these counterclaims to be added to this proceeding, the counterclaims are legally sufficient on their face, and the counterclaims were promptly plead as soon as sufficient facts were uncovered. Accordingly, Applicant respectfully requests the Board to grant its motion for leave to amend.

Dated: November 25, 2009

Respectfully submitted,



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# **EXHIBIT A**



4. Applicant lacks sufficient information to either admit or deny the allegations in Paragraph 4 and therefore denies those allegations.

5. Applicant lacks sufficient information to either admit or deny the allegations in Paragraph 5 and therefore denies those allegations.

6. Applicant lacks sufficient information to either admit or deny the allegations in Paragraph 6 and therefore denies those allegations.

7. Applicant lacks sufficient information to either admit or deny the allegations in Paragraph 7 and therefore denies those allegations.

8. Applicant lacks sufficient information to either admit or deny the allegations in Paragraph 8 and therefore denies those allegations.

9. Applicant lacks sufficient information to either admit or deny the allegations in Paragraph 9 and therefore denies those allegations.

10. Applicant lacks sufficient information to either admit or deny the allegations in Paragraph 10 and therefore denies those allegations.

11. Applicant lacks sufficient information to either admit or deny the allegations in Paragraph 11 and therefore denies those allegations.

12. Applicant lacks sufficient information to either admit or deny the allegations in Paragraph 12 and therefore denies those allegations.

13. Applicant lacks sufficient information to either admit or deny the allegations in Paragraph 13 and therefore denies those allegations.

14. Applicant lacks sufficient information to either admit or deny the allegations in Paragraph 14 and therefore denies those allegations.

15. Denied.

16. Denied.

17. Denied.

18. Admitted.

19. Denied.

20. Applicant lacks sufficient information to either admit or deny the allegations in Paragraph 20 and therefore denies those allegations.

21. Applicant denies the allegations contained in the first sentence of Paragraph 21. Applicant lacks sufficient information to either admit or deny the allegations in the second sentence of Paragraph 21 and therefore denies those allegations. Applicant admits the remainder of the allegations contained in Paragraph 21.

22. Denied.

23. Denied.

24. Denied.

25. Denied.

26. Denied.

### **AFFIRMATIVE DEFENSES**

As its affirmative defenses to the Amended Notice of Opposition, Applicant alleges as follows:

27. Opposer fails to state a claim upon which relief can be granted.

28. Opposer is not likely to be damaged by registration of the Applicant's mark and therefore, Opposer lacks standing to oppose registration of same.

29. Opposer's opposition is barred by the doctrine of unclean hands.

30. The terms “QUILT” and “QUILTED” for the relevant goods are generic or highly descriptive and to which no party may claim exclusive rights.

31. Opposer has disclaimed rights to the terms “QUILT” and “QUILTED” in its trademark applications and registration, and cannot assert exclusivity with respect to those terms with respect to the relative goods.

32. Numerous third parties, which on information and belief are unrelated to Opposer and unlicensed by Opposer, are using the terms “QUILT,” “QUILTED,” and other quilt-formative marks in connection with the same goods as the relevant goods in this opposition. In addition, there are several other QUILTED-formative marks coexisting with Opposer’s marks both on the PTO register and in the marketplace, including Procter & Gamble’s registrations for THE STRONG QUILTED PICKER UPPER Reg. No. 3178381 and BOUNTY DOUBLE QUILTED Reg. No. 2533080, and Kruger Products’ registration for QUILTED POCKETS Reg. No. 3315444, all for paper towels. The co-existence of these QUILT-formative marks for the relevant goods in International Class 16 limit the distinctiveness of Opposer’s referenced marks and demonstrated the public’s ability to distinguish among the marks.

33. There is widespread third party use of the terms QUILT and QUILTED in the relevant industry, rendering all of such terms incapable of serving as source identifiers by themselves.

34. Opposer’s purported rights to the term QUILTED and QUILT are inferior to third parties who use those terms in the relevant industry.

35. The terms “QUILT” or “QUILTED” as used by Opposer in all of its marks are inferior parts of each mark, as evidenced by Opposer’s own disclaimers, and

Applicant does not use any of the dominant portions of such marks, making the likelihood of confusion between Applicant's mark and any of Opposer's marks highly unlikely.

36. Applicant's use of the independently coined term QUILTY has not and will not cause the public to mistakenly believe that Applicant's goods originate from the same source as Opposer's goods, nor will such use be thought by the public to be a use by Opposer or with Opposer's authorization and consent.

37. Applicant's mark QUILTY in its entirety is sufficiently distinctive and different from all of Opposer's marks to avoid confusion, deception or mistake as to the source, sponsorship or association of the Applicant's goods with Opposer.

38. Opposer's claims are barred by the doctrine of laches, estoppel, acquiescence and/or waiver in relation to the numerous third party uses of the terms "QUILT" and "QUILTED" used on or in connection with a wide variety of goods and services.

**WHEREFOR**, Applicant requests that this Opposition proceeding be dismissed and that its application for registration of its design be allowed to register.

### **COUNTERCLAIMS**

As for its counterclaims, Applicant/Petitioner Global Tissue Group, Inc. (Global Tissue) alleges as follows:

39. Global Tissue is the owner of U.S. Application Serial Number 77/364,616 for "QUILTY" covering "consumer and industrial paper products, namely, facial tissues, napkins, towels and bathroom tissues" in International Class 16.

40. Global Tissue has been and is now extensively engaged in the business of manufacturing, marketing and selling various goods in interstate commerce, including facial tissues, napkins, towels and bathroom tissues, and related goods.

41. Opposer/Registrant Georgia-Pacific Consumer Products LP (Georgia-Pacific) has been and is now engaged in the business of manufacturing, marketing and selling various goods in interstate commerce, including facial tissue, napkins, towels, bath tissue, and related goods.

42. Global Tissue and Georgia-Pacific are competitors and compete in the sale of facial tissue, napkins, towels, bathroom tissue, and related goods.

43. Georgia-Pacific has filed the present opposition proceeding against Global Tissue's intent-to-use application for "QUILTY," citing the following twelve registrations: 3,170,713; 2,867,895; 3,069,376; 2,957,128; 2,933,048; 2,968,615; 2,209,027; 2,663,438, 3,018,501; 3,293,547; 2,059,102; and 2,872,813.

44. Global Tissue believes that it is being damaged and will continue to be damaged by registration of the marks that are the subject of the following United States Trademark Registrations owned by Georgia-Pacific: 2,872,813; 2,957,128; 3,170,713; 2,933,048; 3,069,376; 2,968,615; 3,463,900; 3,463,899; 3,018,501; 3,293,547; 3,463,460; 2,980,757; 3,642,378; 3,517,622; 3,642,213; and 3,532,136. As described more fully hereinbelow, Global Tissue hereby petitions for cancellation of such registrations and/or that such registrations be modified to include an appropriate disclaimer.

**COUNT 1: US Reg. No. 2,872,813**

45. Global-Tissue repeats and alleges the allegations in Paragraphs 39 through 44 as if here set forth at length.

46. Georgia-Pacific is the owner of United States Trademark Registration No. 2,872,813 for “QUILTING” covering “bath tissue” in International Class 16. The registration was granted on August 10, 2004. As of the filing of this Answer, the registration is more than five years old.

47. Georgia-Pacific has cited Registration No. 2,872,813 against Global Tissue’s intent-to-use application “QUILTY” in the present opposition proceeding.

48. Global Tissue requests that Reg. No. 2,872,813 be cancelled on the ground that it has been abandoned. Georgia-Pacific’s mark has never been used in commerce on or in connection with its registered goods as the alleged mark on the specimen provided to the USPTO, as well as the alleged mark being used in commerce, does not match the mark in the drawing of the application.

**COUNT 2: US Reg. No. 2,957,128**

49. Global Tissue repeats and alleges the allegations in Paragraphs 39 through 44 as if here set forth at length.

50. Georgia-Pacific is the owner of United States Trademark Registration No. 2,957,128 for “QUILTED” covering “bath tissue” in International Class 16. The registration was granted on May 31, 2005. As of the filing date of this petition, the registration is less than five years old.

51. Georgia-Pacific has cited Registration No. 2,957,128 against Global Tissue's intent-to-use application "QUILTY" in the present opposition proceeding.

52. The term "Quilted" is merely descriptive and without secondary meaning as applied to the goods identified in Reg. No. 2,957,128. The word "Quilted" lacks secondary meaning and immediately describes a quality, characteristic, or feature of the goods.

53. The term "Quilted" was merely descriptive and without secondary meaning as applied to the goods as of the date the registration was issued, and on this basis Reg. No. 2,957,128 should be cancelled. Alternatively, Global Tissue alleges that the term "Quilted" is merely descriptive and without secondary meaning as applied to the goods at the time the issue is considered in the instant proceeding, and on this basis requests that Reg. No. 2,957,128 be cancelled.

54. In the alternative, Global Tissue requests that Reg. No. 2,957,128 be cancelled on the ground that it has been abandoned. Georgia-Pacific's mark has never been used in commerce on or in connection with its registered goods as the alleged mark on the specimen provided to the USPTO, as well as the alleged mark being used in commerce, does not match the mark in the drawing of the application.

**COUNT 3: US Reg. No. 3,170,713**

55. Global Tissue repeats and alleges the allegations in Paragraphs 39 through 44 as if here set forth at length.

56. Georgia-Pacific is the owner of United States Trademark Registration No. 3,170,713 for ACOLCHINADO covering "bath tissue" in International Class 16. The

term “Acolchinado” translates into English as “Quilted.” The registration was granted on November 14, 2006. As of the filing date of this Answer, the registration is less than five years old.

57. Georgia-Pacific has cited Registration No. 3,170,713 against Global Tissue’s intent-to-use application “QUILTY” in the present opposition proceeding.

58. The term “Acolchinado” translates into English as “quilted” and as such is merely descriptive and without secondary meaning as applied to the goods identified in Reg. No. 3,170,713. The word “Acolchinado” lacks secondary meaning and immediately describes a quality, characteristic, or feature of the goods.

59. The term “Acolchinado” was merely descriptive and without secondary meaning as applied to the goods as of the date the registration was issued, and on this basis Reg. No. 3,170,713 should be cancelled. Alternatively, Global Tissue alleges that “Acolchinado” is merely descriptive and without secondary meaning as applied to the goods as of the time the issue is considered in the instant proceeding, and on this basis requests that Reg. No. 3,170,713 be cancelled.

60. In the alternative, Global Tissue requests that Reg. No. 3,170,713 be cancelled on the ground that it has been abandoned. Georgia-Pacific’s mark has never been used in commerce or in connection with its registered goods as the specimen provided to the USPTO, and the alleged mark being used in commerce, does not match the application.

**COUNT 4: US Reg. No. 2,933,048**

61. Applicant repeats and alleges the allegations in Paragraphs 39 through 44 as if here set forth at length.

62. Georgia-Pacific is the owner of United States Trademark Registration No. 2,933,048 for QUILTED and design covering “bath tissue” in International Class 16. The registration was granted on March 15, 2005. As of the filing date of this Answer, the registration is less than five years old.

63. Georgia-Pacific has cited Registration No. 2,933,048 against Global Tissue’s intent-to-use application “QUILTY” in the present opposition proceeding.

64. The term “quilted” is merely descriptive and without secondary meaning as applied to the goods identified in Reg. No. 2,933,048. The word “Quilted” lacks secondary meaning and immediately describes a quality, characteristic, or feature of the goods.

65. The term “Quilted” was merely descriptive and without secondary meaning as applied to the goods as of the date of the registration issued, and on this basis Reg. No. 2,933,048 should be cancelled. Alternatively, Global Tissue alleges that the term “Quilted” is merely descriptive and without secondary meaning as applied to the goods as of the time the issue is considered in the present proceeding, and on this basis requests that Reg. No. 2,933,048 be cancelled.

66. In the alternative, Global Tissue requests that “Quilted” be required to be disclaimed in Reg. No. 2,933,048, and that the registration should be cancelled unless such a disclaimer is entered. The term “Quilted” was merely descriptive and without secondary meaning as applied to the goods as of the date the registration was issued or,

alternatively, the term “Quilted” is merely descriptive and without secondary meaning as applied to the goods as of the time the issue is considered in the present proceeding. As such, the term “Quilted” should be disclaimed in the registration. However, in the subject registration, the term “Quilted” is not disclaimed. On this basis, Global Tissue requests that “Quilted” be required to be disclaimed in the registration, and that the registration be cancelled unless such a disclaimer is entered.

67. Georgia-Pacific has disclaimed the term “QUILTED” in its following registrations: 2,059,102; 2,209,027; 1,877,561; and 2,407,296.

68. In the alternative, Global Tissue requests that Reg. No. 2,933,848 be cancelled on the ground that it has been abandoned. Georgia-Pacific’s mark has never been used in commerce on or in connection with its registered goods as the alleged mark on the specimen provided to the USPTO, as well as the alleged mark being used in commerce, does not match the mark in the drawings of the application.

**COUNT 5: US Reg. No. 3,069,376**

69. Global Tissue repeats and alleges the allegations in Paragraphs 39 through 44 as if here set forth at length.

70. Georgia-Pacific is the owner of United States Trademark Registration No. 3,069,376 for “PLUSH QUILTS” covering “bath tissue” in International Class 16. The registration was granted on March 14, 2006. As of the filing date of this Answer, the registration is less than five years old.

71. Georgia-Pacific has cited Registration No. 3,069,376 against Global Tissue’s intent-to-use application “QUILTY” in the present opposition proceeding.

72. The term “Plush Quilts” is merely descriptive and without secondary meaning as applied to the goods identified in Reg. No. 3,069,376. The terms “Plush Quilts” lacks secondary meaning and immediately describes a quality, characteristic, or feature of the goods.

73. The term “Plush Quilts” was merely descriptive and without secondary meaning as applied to the goods as of the date the registration was issued, and on this basis Reg. No. 3,069,376 should be cancelled. Alternatively, Global Tissue alleges that the term “Plush Quilts” is merely descriptive and without secondary meaning as applied to the goods at the time the issue is considered in the instant proceeding, and on this basis requests that Reg. No. 3,069,376 be cancelled.

74. In the alternative, Global Tissue requests that “Quilts” be required to be disclaimed in Reg. No. 3,069,376, and that the registration should be cancelled unless such a disclaimer is entered. The term “Quilts” was merely descriptive and without secondary meaning as applied to the goods as of the date the registration was issued or, alternatively, the term “Quilts” is merely descriptive and without secondary meaning as applied to the goods as of the time the issue is considered in the present proceeding. As such, the term “Quilts” should be disclaimed in the registration. However, in the subject registration, the term “Quilts” is not disclaimed. On this basis, Global Tissue requests that “Quilts” be required to be disclaimed in the registration, and that the registration be cancelled unless such a disclaimer is entered.

75. Opposer has disclaimed the term “QUILTED” in its following registrations: 2,059,102; 2,209,027; 1,877,561; and 2,407,296.

76. In the alternative, Global Tissue requests that Reg. No. 3,069,376 be cancelled on the ground that it has been abandoned. Georgia-Pacific's mark has never been used in commerce or in connection with its registered goods as the alleged mark on the specimen provided to the USPTO, as well as the alleged mark being used in commerce, does not match the mark in the drawing of the application.

**COUNT 6: U.S. REGISTRATION NO. 2,968,615**

77. Global Tissue repeats and realleges the allegations in Paragraphs 39 through 44 above as if here set forth at length.

78. Georgia-Pacific is the owner of United States Trademark Registration No. 2,968,615 for QUILTED NORTHERN for "facial tissue" in International Class 16. The registration was granted on July 12, 2005. The registration does not include a disclaimer of the term "Quilted." As of the filing date of this petition, the registration is less than five years old.

79. Georgia-Pacific has cited Registration No. 2,968,615 against Global Tissue's intent-to-use application "QUILTY" in the present opposition proceeding.

80. Global Tissue requests that "Quilted" be required to be disclaimed in Registration No. 2,968,615, and that the registration be cancelled unless such a disclaimer is entered. The term "Quilted" was merely descriptive and without secondary meaning as applied to the goods as of the date the registration issued or, alternatively, the term "Quilted" is merely descriptive and without secondary meaning as applied to the goods as of the time the issue is considered in the present proceeding. As such, the term "Quilted" should be disclaimed in the registration.

However, in the subject registration, the term “Quilted” is not disclaimed. On this basis, Petitioner requests that “Quilted” be required to be disclaimed in the registration, and that the registration be cancelled unless such a disclaimer is entered.

81. Georgia-Pacific has disclaimed the term “QUILTED” in its following registrations: 2,059,102; 2,209,027; 1,877,561; and 2,407,296. .

**COUNT 7: U.S. REGISTRATION NO. 3,463,900**

82. Global Tissue repeats and realleges the allegations in Paragraphs 39 through 44 above as if here set forth at length.

83. Georgia-Pacific is the owner of United States Trademark Registration No. 3,463,900 for Q ULTRA QUILTED NORTHERN covering “bathroom tissue” in International Class 16. The registration was granted on July 8, 2008. The registration does not include a disclaimer of the term “Quilted.” As of the filing date of this petition, the registration is less than five years old.

84. Petitioner requests that “Quilted” be required to be disclaimed in Registration No. 3,463,900, and that the registration be cancelled unless such a disclaimer is entered. The term “Quilted” was merely descriptive and without secondary meaning as applied to the goods as of the date the registration issued or, alternatively, the term “Quilted” is merely descriptive and without secondary meaning as applied to the goods as of the time the issue is considered in the present proceeding. As such, the term “Quilted” should be disclaimed in the registration. However, in the subject registration, the term “Quilted” is not disclaimed. On this

basis, Petitioner requests that “Quilted” be required to be disclaimed in the registration, and that the registration be cancelled unless such a disclaimer is entered.

85. Georgia-Pacific has disclaimed the term “QUILTED” in its following registrations: 2,059,102; 2,209,027; 1,877,561; and 2,407,296.

**COUNT 8: U.S. REGISTRATION NO. 3,463,899**

86. Global Tissue repeats and realleges the allegations in Paragraphs 39 through 44 above as if here set forth at length.

87. Georgia-Pacific is the owner of United States Trademark Registration No. 3,463,899 for Q QUILTED NORTHERN covering “bathroom tissue” in International Class 16. The registration was granted on July 8, 2008. The registration does not include a disclaimer of the term “Quilted.” As of the filing date of this petition, the registration is less than five years old.

88. Global Tissue requests that “Quilted” be required to be disclaimed in Registration No. 3,463,899, and that the registration be cancelled unless such a disclaimer is entered. The term “Quilted” was merely descriptive and without secondary meaning as applied to the goods as of the date the registration issued or, alternatively, the term “Quilted” is merely descriptive and without secondary meaning as applied to the goods as of the time the issue is considered in the present proceeding. As such, the term “Quilted” should be disclaimed in the registration. However, in the subject registration, the term “Quilted” is not disclaimed. On this basis, Petitioner requests that “Quilted” be required to be disclaimed in the registration, and that the registration be cancelled unless such a disclaimer is entered.

89. Georgia-Pacific has disclaimed the term “QUILTED” in its following registrations: 2,059,102; 2,209,027; 1,877,561; and 2,407,296.

**COUNT 9: U.S. REGISTRATION NO. 3,018,501**

90. Global Tissue repeats and realleges the allegations in Paragraphs 39 through 44 above as if here set forth at length.

91. 29. Georgia-Pacific is the owner of record of United States Trademark Registration No. 3,018,501 for QUILTED NORTHERN PS covering “bath tissue” in International Class 16. The registration was granted on November 22, 2005. The registration does not include a disclaimer of the term “Quilted.” As of the filing date of this petition, the registration is less than five years old.

92. Georgia-Pacific has cited Registration No. 3,018,501 against Global Tissue’s intent-to-use application “QUILTY” in the present opposition proceeding.

93. Petitioner requests that “Quilted” be required to be disclaimed in Registration No. 3,018,501, and that the registration be cancelled unless such a disclaimer is entered. The term “Quilted” was merely descriptive and without secondary meaning as applied to the goods as of the date the registration issued or, alternatively, the term “Quilted” is merely descriptive and without secondary meaning as applied to the goods as of the time the issue is considered in the present proceeding. As such, the term “Quilted” should be disclaimed in the registration. However, in the subject registration, the term “Quilted” is not disclaimed. On this basis, Petitioner requests that “Quilted” be required to be disclaimed in the registration, and that the registration be cancelled unless such a disclaimer is entered.

94. Georgia-Pacific has disclaimed the term “QUILTED” in its following registrations: 2,059,102; 2,209,027; 1,877,561; and 2,407,296.

**COUNT 10: U.S. REGISTRATION NO. 3,293,547**

95. Global Tissue repeats and realleges the allegations in Paragraphs 1 through 3 above as if here set forth at length.

96. Georgia-Pacific is the owner of United States Trademark Registration No. 3,293,547 for QUILTED NORTHERN PS covering “facial tissue” in International Class 16. The registration was granted on September 18, 2007. The registration does not include a disclaimer of the term “Quilted.” As of the filing date of this petition, the registration is less than five years old.

97. Georgia-Pacific has cited Registration No. 3,293,547 against Global Tissue’s intent-to-use application “QUILTY” in the present opposition proceeding.

98. Petitioner requests that “Quilted” be required to be disclaimed in Registration No. 3,293,547, and that the registration be cancelled unless such a disclaimer is entered. The term “Quilted” was merely descriptive and without secondary meaning as applied to the goods as of the date the registration issued or, alternatively, the term “Quilted” is merely descriptive and without secondary meaning as applied to the goods as of the time the issue is considered in the present proceeding. As such, the term “Quilted” should be disclaimed in the registration. However, in the subject registration, the term “Quilted” is not disclaimed. On this basis, Petitioner requests that “Quilted” be required to be disclaimed in the registration, and that the registration be cancelled unless such a disclaimer is entered.

99. Georgia-Pacific has disclaimed the term “QUILTED” in its following registrations: 2,059,102; 2,209,027; 1,877,561; and 2,407,296.

**COUNT 11: U.S. REGISTRATION NO. 3,463,460**

100. Global Tissue repeats and realleges the allegations in Paragraphs 39 through 44 above as if here set forth at length.

101. Georgia-Pacific is the owner of United States Trademark Registration No. 3,463,460 for Q QUILTED NORTHERN covering “bathroom tissue” in International Class 16. The registration was granted on July 8, 2008. The registration does not include a disclaimer of the term “Quilted.” As of the filing date of this petition, the registration is less than five years old.

102. Global Tissue requests that “Quilted” be required to be disclaimed in Registration No. 3,463,460, and that the registration be cancelled unless such a disclaimer is entered. The term “Quilted” was merely descriptive and without secondary meaning as applied to the goods as of the date the registration issued or, alternatively, the term “Quilted” is merely descriptive and without secondary meaning as applied to the goods as of the time the issue is considered in the present proceeding. As such, the term “Quilted” should be disclaimed in the registration. However, in the subject registration, the term “Quilted” is not disclaimed. On this basis, Petitioner requests that “Quilted” be required to be disclaimed in the registration, and that the registration be cancelled unless such a disclaimer is entered.

103. Georgia-Pacific has disclaimed the term “QUILTED” in its following registrations: 2,059,102; 2,209,027; 1,877,561; and 2,407,296.

**COUNT 12: U.S. REGISTRATION NO. 2,980,757**

104. Global Tissue repeats and realleges the allegations in Paragraphs 39 through 44 above as if here set forth at length.

105. Georgia-Pacific is the owner of record of United States Trademark Registration No. 2,980,757 for THE ULTIMATE QUILTED CLEAN covering “bath tissue” in International Class 16. The registration was granted on August 2, 2005. The registration does not include a disclaimer of the term “Quilted.” As of the filing date of this petition, the registration is less than five years old.

106. Petitioner requests that “Quilted” be required to be disclaimed in Registration No. 2,980,757, and that the registration be cancelled unless such a disclaimer is entered. The term “Quilted” was merely descriptive and without secondary meaning as applied to the goods as of the date the registration issued or, alternatively, the term “Quilted” is merely descriptive and without secondary meaning as applied to the goods as of the time the issue is considered in the present proceeding. As such, the term “Quilted” should be disclaimed in the registration. However, in the subject registration, the term “Quilted” is not disclaimed. On this basis, Petitioner requests that “Quilted” be required to be disclaimed in the registration, and that the registration be cancelled unless such a disclaimer is entered.

107. Georgia-Pacific has disclaimed the term “QUILTED” in its following registrations: 2,059,102; 2,209,027; 1,877,561; and 2,407,296.

**COUNT 13: U.S. REGISTRATION NO. 3,642,378**

108. Global Tissue repeats and realleges the allegations in Paragraphs 39 through 44 above as if here set forth at length.

109. Georgia-Pacific is the owner of record of United States Trademark Registration No. 3,642,378 for QUILTED NORTHERN SOFT & STRONG covering “bathroom tissue” in International Class 16. The registration was granted on June 23, 2009. The registration does not include a disclaimer of the term “Quilted.” As of the filing date of this petition, the registration is less than five years old.

110. Petitioner requests that “Quilted” be required to be disclaimed in Registration No. 3,642,378, and that the registration be cancelled unless such a disclaimer is entered. The term “Quilted” was merely descriptive and without secondary meaning as applied to the goods as of the date the registration issued or, alternatively, the term “Quilted” is merely descriptive and without secondary meaning as applied to the goods as of the time the issue is considered in the present proceeding. As such, the term “Quilted” should be disclaimed in the registration. However, in the subject registration, the term “Quilted” is not disclaimed. On this basis, Petitioner requests that “Quilted” be required to be disclaimed in the registration, and that the registration be cancelled unless such a disclaimer is entered.

111. Georgia-Pacific has disclaimed the term “QUILTED” in its following registrations: 2,059,102; 2,209,027; 1,877,561; and 2,407,296.

**COUNT 14: U.S. REGISTRATION NO. 3,517,622**

112. Global Tissue repeats and realleges the allegations in Paragraphs 39 through 44 above as if here set forth at length.

113. Georgia-Pacific is the owner of record of United States Trademark Registration No. 3,517,622 for QUILTED NORTHERN ULTRA PLUSH covering “bathroom tissue” in International Class 16. The registration was granted on October 14, 2008. The registration does not include a disclaimer of the term “Quilted.” As of the filing date of this petition, the registration is less than five years old.

114. Global Tissue requests that “Quilted” be required to be disclaimed in Registration No. 3,517,622, and that the registration be cancelled unless such a disclaimer is entered. The term “Quilted” was merely descriptive and without secondary meaning as applied to the goods as of the date the registration issued or, alternatively, the term “Quilted” is merely descriptive and without secondary meaning as applied to the goods as of the time the issue is considered in the present proceeding. As such, the term “Quilted” should be disclaimed in the registration. However, in the subject registration, the term “Quilted” is not disclaimed. On this basis, Petitioner requests that “Quilted” be required to be disclaimed in the registration, and that the registration be cancelled unless such a disclaimer is entered.

115. Georgia-Pacific has disclaimed the word “QUILTED” in its following registrations: 2,059,102; 2,209,027; 1,877,561; and 2,407,296.

**COUNT 15: U.S. REGISTRATION NO. 3,642,213**

116. Global Tissue repeats and realleges the allegations in Paragraphs 39 through 44 above as if here set forth at length.

117. Georgia-Pacific is the owner of record of United States Trademark Registration No. 3,642,213 for Q QUILTED NORTHERN SOFT & STRONG covering “bathroom tissue” in International Class 16. The registration was granted on June 23, 2009. The registration does not include a disclaimer of the term “Quilted.” As of the filing date of this petition, the registration is less than five years old.

118. Global Tissue requests that “Quilted” be required to be disclaimed in Registration No. 3,642,213, and that the registration be cancelled unless such a disclaimer is entered. The term “Quilted” was merely descriptive and without secondary meaning as applied to the goods as of the date the registration issued or, alternatively, the term “Quilted” is merely descriptive and without secondary meaning as applied to the goods as of the time the issue is considered in the present proceeding. As such, the term “Quilted” should be disclaimed in the registration. However, in the subject registration, the term “Quilted” is not disclaimed. On this basis, Petitioner requests that “Quilted” be required to be disclaimed in the registration, and that the registration be cancelled unless such a disclaimer is entered.

119. Georgia-Pacific has disclaimed the term “QUILTED” in its following registrations: 2,059,102; 2,209,027; 1,877,561; and 2,407,296.

**COUNT 16: U.S. REGISTRATION NO. 3,532,136**

120. Global Tissue repeats and realleges the allegations in Paragraphs 39 through 44 above as if here set forth at length.

121. Georgia-Pacific is the owner of record of United States Trademark Registration No. 3,532,136 for Q ULTRA QUILTED NORTHERN OUR SOFTEST EVER covering “bathroom tissue” in International Class 16. The registration was granted on November 11, 2008. The registration does not include a disclaimer of the term “Quilted.” As of the filing date of this petition, the registration is less than five years old.

122. Global Tissue requests that “Quilted” be required to be disclaimed in Registration No. 3,532,136, and that the registration be cancelled unless such a disclaimer is entered. The term “Quilted” was merely descriptive and without secondary meaning as applied to the goods as of the date the registration issued or, alternatively, the term “Quilted” is merely descriptive and without secondary meaning as applied to the goods as of the time the issue is considered in the present proceeding. As such, the term “Quilted” should be disclaimed in the registration. However, in the subject registration, the term “Quilted” is not disclaimed. On this basis, Petitioner requests that “Quilted” be required to be disclaimed in the registration, and that the registration be cancelled unless such a disclaimer is entered.

123. Georgia-Pacific has disclaimed the term “QUILTED” in its following registrations: 2,059,102; 2,209,027; 1,877,561; and 2,407,296.

**WHEREFOR**, Global Tissue believes that it is being damaged by the challenged registrations.

Global Tissue does not claim trademark rights in the term “Quilted,” “Quilting,” or “Quilts,” but rather seeks to protect its right, and the right of others, to use the term in a generic or descriptive manner in connection with the goods at issue. The above-listed registrations are inconsistent with Global Tissue’s free use of such terms and therefore damage Global Tissue.

Global Tissue requests that United States Trademark Registration Nos. 2,872,813; 2,957,128; 3,170,713; 2,933,048; and 3,069,376 be cancelled as set forth above under Section 14(3) of the Lanham Act, 15 U.S.C. §1064(3). Global Tissue further requests that United States Trademark Registration Nos. 2,957,128; 3,170,713; 2,933,048; and 3,069,376 be cancelled as set forth above under Section 2(e)(1) of the Lanham Act, 15 U.S.C. § 1052(e)(1). Finally, Petitioner requests that United States Trademark Registration Nos. 2,933,048; 3,069,376; 2,968,615; 3,463,900; 3,463,899; 3,018,501; 3,293,547; 3,463,460; 2,980,757; 3,642,378; 3,517,622; 3,642,213; and 3,532,136 be modified to include a disclaimer of “Quilted” or “Quilts” as set forth above, and that such registrations be cancelled unless such a disclaimer is entered. Lanham Act Sections 2(e)(1) and 6(a), 15 U.S.C. §§ 1052(e)(1) and 1056(a).

The filing fee for this cancellation, in the amount of \$4,800.00, is enclosed.

The Commissioner is hereby authorized to charge any additional fees to Deposit

Account No. \_\_\_\_\_.

Dated: November \_\_\_\_, 2009

Respectfully submitted,

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Attorneys for Applicant  
Global Tissue Group, Inc.

## **EXHIBIT B**

## Schroeder, R. Glenn

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**From:** Schroeder, R. Glenn  
**Sent:** Monday, November 02, 2009 6:45 PM  
**To:** 'cmarino@kilpatrickstockton.com'  
**Subject:** Georgia-Pacific v. Global Tissue Group - Opposition No. 91184529

Charlene:

Thank you for taking the time to speak with me. As I mentioned, our firm has now been retained by GTG to handle the above-referenced opposition on a going forward basis. We will be filing a Notice of Appearance shortly. It is our understanding that discovery is set to close on December 2, 2009. We intend to Notice several depositions, including a 30(b)(6) as well as those individuals identified in your discovery responses, namely Andrew Towle, David Sayyed, Thomas Best and Patrick Davis. I wanted to advise you as soon as possible so that you can check with your client as to the availability of these individuals during the week of November 16. We of course will make every effort to accommodate your client, but it may make sense to attempt to schedule several days back to back. Our initial thought is to schedule 3 days, with the idea that we can finish up sooner. Would November 18, 19 and 20 be convenient? As I also mentioned, we are in the process of reviewing the 32,000 + pages of documents produced by G-P. I will let you know as soon as possible if we have any questions regarding this production.

Thank you in advance for your cooperation.

Regards,

Glenn

*R. Glenn Schroeder*  
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6900 Jericho Turnpike  
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## **EXHIBIT C**





## **EXHIBIT D**

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SCIENTIFIC ADVISOR  
DANIEL A. SCOLA, SR., Ph.D.

\* NOT ADMITTED IN NY  
† SENIOR ATTORNEY

November 4, 2009

Charlene R. Marino, Esq.  
Kilpatrick Stockton, LLP  
1100 Peachtree Street, Suite 2800  
Atlanta, Georgia 30309

Re: Georgia-Pacific Consumer Products, LP v. Global Tissue Group, Inc.

Dear Charlene:

Please find enclosed the following documents:

1. Notice of Rule 30(b)(6) Deposition;
2. Notice of Deposition of Patrick Davis;
3. Notice of Deposition of Thomas Best;
4. Notice of Deposition of David Sayyed;
5. Notice of Deposition of Andrew Towle; and
6. Notice of Deposition of Emily K. Boss.

Thank you in advance for your cooperation in this matter.

Very truly yours,



R. Glenn Schroeder

RGS:mak  
Enclosures

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3. Sales of products sold under Opposer's Marks.
4. Searches, investigations, reports and/or opinions directed and/or referring to any of Opposer's Marks.
5. Searches, investigations, reports and opinions disclosing and/or referencing usage by third parties of any name, mark or designation that consists of or includes the term "QUILT" or variations thereof.
6. Third party usage or registration of any name, mark or designation that consists of or includes the term "QUILT" or variations thereof in connection with bathroom tissue, facial tissue and/or other paper products.
7. Brand awareness and competitive brands.
8. Confusion in the marketplace between any of Opposer's Marks and the name, mark or designation of any third party which includes the term "QUILT" or variations thereof.
9. Objections made by Opposer against any third party's use and/or registration of any name, mark or designation which includes the term "QUILT" or variations thereof.
10. Any agreements entered into between Opposer and any third party based upon either of such party's usage of a name, mark or designation including the term "QUILT" or variations thereof.
11. Customer feedback regarding the quality of products sold under Opposer's Marks.
12. Consumer recognition of names, marks and/or designations including the term "QUILT" or variations thereof.
13. The alleged fame of any name, mark or designation including the term "QUILT" or variations thereof.

Opposer is requested to provide Applicant's counsel with written notice, at least five (5) business days in advance of the deposition, of the name and employment position of each designee who consents to testify on behalf of Applicant, and the subject matter categories as to which each designee has agreed to testify.

Dated: November 4, 2009

Respectfully submitted,



---

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Attorneys for Applicant  
Global Tissue Group, Inc.























# **EXHIBIT E**

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November 17, 2009

**VIA FACSIMILE & E-MAIL**

Charlene R. Marino, Esq.  
Kilpatrick Stockton, LLP  
1100 Peachtree Street, Suite 2800  
Atlanta, Georgia 30309

Re: Georgia-Pacific Consumer Products, LP v. Global Tissue Group, Inc.  
Opposition No. 91184529

Dear Charlene:

This letter is to confirm our conversation of November 16, 2009 and to set forth in writing several outstanding issues relating to the ongoing discovery in the above-referenced opposition proceeding. We have also asked for your consent to a sixty (60) day extension of the discovery period.

## I. Substitution of Counsel and Noticed Depositions

As we advised you by telephone on November 2, 2009, and in our subsequent email that same day, Hoffmann & Baron was retained by Global Tissue Group (GTG) at the beginning of this month to represent them in this opposition as it proceeds forward. At that time, I indicated that we would be filing a Notice of Appearance and noticing several depositions. The Notice of Appearance was subsequently filed on November 3, 2009, and six Notices of Deposition were served on you on November 4, 2009.

You advised us by telephone on November 5, 2009 that none of the named individuals were available during the month of November, but that you would be willing to produce Andrew Towle as your 30(b)(6) witness on December 3, 2009, as well as one additional witness – also to be produced outside the discovery cut-off date. We indicated at that time that we could not agree to such a proposal, and that we would insist upon scheduling depositions for all of the named individuals. We asked you to confirm with your client whether or not they would be willing to produce all of the named individuals. We also asked for proposed dates for these individuals. No response was received from

you subsequent to that telephone conversation, nor did you return our phone call of November 12, 2009. When we spoke yesterday, you still did not have a definitive answer as to whether your client would produce all of the named witnesses, nor did you have any proposed dates available.

As we explained to you during our conversation of November 5, 2009, the individuals identified in the Notices of Deposition are the very same persons which you identified to us as relevant individuals in both your initial disclosures and interrogatory responses. For you to now suggest that we should not be allowed the opportunity to depose these individuals, particularly in view of the 32,000 plus page documents which you have produced to us, is clearly unreasonable and contrary to the TTAB rules. Accordingly, please provide us with dates for all the Noticed individuals, or confirm for us that your client is unwilling to produce such individuals.

## II. GP Document Production

We have now had the opportunity to initially review the 32,000+ documents which were produced by GP. As we discussed with you yesterday, there are several significant deficiencies with your production.

### 1. The Lack of the Privilege Log

We have been unable to identify a privilege log in the documents produced to us. When we asked you yesterday whether a privilege log had been produced, you were unable to tell us whether such a log had been produced, and if not, why not. Is it GP's position in this proceeding that not one single privilege document exists within the files of GP? If that is in fact your position, please confirm that fact for us in writing. If not, we expect to promptly receive the necessary privilege log required by Rule 26.

### 2. The Failure to Produce Documents as they are Kept in the Usual Course of Business

As you know, GP produced the bulk of its documents in electronic format. It appears, however, that many of the multi-page documents were scanned as individual pages – which makes its difficult/impossible to determine how these documents were actually kept in the usual course of business. The electronic index you provided to us does not help in this regard since it merely provides large groupings of documents with general titles, or no titles at all.

We have also reviewed the chart which you prepared for Mr. Katz in response to his earlier objection. Although this chart makes an attempt to identify which documents

are responsive to which requests, we must also object to the general nature of this document in that it simply identifies thousands of documents (by Bates Numbers only) as responsive to many of the requests. In addition, your response to GTG Document Request No. 1 is not understood since it does not identify any documents, while your response to GTG Document Request No. 19 and 20 suggests that you in fact do have privileged documents which you have not produced or identified on a privilege log.

### 3. Missing Documents

Our initial review has revealed that the GP document production is clearly deficient.

First, no search reports directed to the marks identified in the Notice of Opposition have been produced. As you know, such search reports are not considered to be privileged by the TTAB. Although you stated yesterday that you do not believe that such search reports exist, we find it difficult to believe that GP has never conducted a search with respect to any of the twelve marks identified in the Notice of Opposition. If this in fact the case, please confirm that fact for us in writing.

Second, the produced documents do not appear to include any documents relating to the current Kimberly-Clark litigation/cancellation proceedings. When I asked you about this yesterday, you indicated that such documents were probably not produced because the cancellation was only recently filed, when in fact it was filed over two months ago. It was actually filed the day after you received the most recent decision from the TTAB regarding this opposition proceeding. Under the Federal Rules, GP has a continuing duty to update its prior discovery responses. It is unclear to us why you have not produced such documents.

You also indicated during our telephone conversation yesterday that you may not have produced these documents because the original litigation matter was not responsive to our discovery requests. Again, this explanation is clearly inadequate in that several of GTG's requests (e.g., Request No. 16) specifically refer to the production of such documents. In fact, we note that the Complaint filed in the Kimberly-Clark litigation was not only prepared by your firm, but actually signed by your colleague Charles Henn, who is also appearing in this proceeding. Your response to me yesterday that this prior proceeding did not involve the marks in question would not appear to be accurate in view of the contents of this Complaint, which, for example, list GP's Northern Quilted marks on pages 15-16 of such document.

4. Competitive Marks

We have been unable to locate even a single document among the 32,000+ pages which contains any reference to a competitive use of the term “quilt”, “quilted”, or a variation thereof (other than the litigation/adversarial documents provided to us.) We find it difficult to believe that GP is not in possession of a single document showing any of its competitors using one of these terms. For example, Bounty has been using the mark “Bounty Double Quilted” since at least as early as September 2001. Is it GP’s position that not one document exists within the confines of GP that reference this mark, or other such uses of these terms by your competitors?

III. Request to Extend Discovery

In view of the points discussed hereinabove, we have asked you to consent to a sixty (60) day extension of the discovery period. In this regard, we remind you that when Kilpatrick took over representation of this matter for GP, you made a similar request to extend the discovery period. It would be quite unreasonable for GP to now oppose GTG’s request for the same relief that GP sought at the time Kilpatrick entered this proceeding.

IV. Settlement Discussions

With respect to the issue of settlement, you asked during our conversation of November 5, 2009 whether we had had any settlement discussions with our client. At that time, I advised you that we had not, but that I would discuss this matter with my client. Accordingly, I spoke with my client regarding settlement, and advised you of their offer during our discussion yesterday. Your suggestion on the telephone that our proposal was not even worth passing along to your client was both improper and not understood. You asked us to provide you with a settlement proposal, which we did. Your client is free to accept it or reject it, but the offer was made in good faith pursuant to your suggestion. For you to suggest otherwise does not advance the nature of such discussions.

V. Amended Answer

Although not discussed yesterday, and upon further review of this case, we intend to file a Motion for Leave to File an Amended Answer. Our Amended Answer will include counterclaims for cancellation of many of the marks identified in your Notice of Opposition. You will recall that your firm recently requested permission to file an amended Notice of Opposition in which you added additional grounds for opposing our

application. We did not oppose such motion. Likewise, we would expect your firm to allow us the courtesy to file an Amended Answer without opposition.

VI. Requested Action

1. Please advise us by 5:00 p.m. EST tomorrow whether your client will agree to the requested sixty (60) day extension of the discovery period. If we do not receive a response by that time, we will proceed with the understanding that your client is not willing to consent to this extension request.

2. Please advise us by 5:00 p.m. EST tomorrow whether your client will agree to produce all of the noticed individuals for depositions. If we do not receive a response by that time, we will proceed with the understanding that your client is refusing to produce all of these named individuals.

3. Please advise us by 5:00 p.m. EST tomorrow whether your client will oppose the filing of an Amended Answer.

4. Please provide us with the necessary privilege log, or confirm that no such privilege documents exists.

5. Please provide us with updated electronic copies of the GP documents indexed in a manner which corresponds to the way such documents were kept in the usual course of business, or an updated index which clearly identifies the documents contained on the disks produced in response to GTG's document requests.

6. Please provide us with copies of any search reports directed to the marks identified in the Notice of Opposition, or confirm for us that no such search reports exist.

7. Please provide us with copies of all responsive documents relating to the Kimberly-Clark litigation/cancellation proceedings, including all correspondence between the parties.

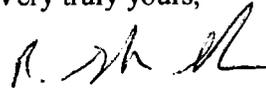
8. Please confer with your client and determine whether they are in possession of any documents showing use of the terms "quilt", "quilted" or variations thereof by their competitors, other than the litigation/adversarial documents provided to us. If no such documents exist, please confirm that for us in writing.

Charlene R. Marino, Esq.  
November 17, 2009  
Page 6

9. Please identify the person who signed the interrogatory verification. The signature is not legible, and you neglected to type the name of the signatory.

We look forward to your response.

Very truly yours,

A handwritten signature in black ink, appearing to read "R. Glenn Schroeder". The signature is stylized and somewhat cursive.

R. Glenn Schroeder

RGS:mak

325059\_1.DOC

## **EXHIBIT F**

Suite 2800 1100 Peachtree St.  
Atlanta GA 30309-4528  
t 404 815 6500 f 404 815 6555  
www.KilpatrickStockton.com

direct dial 404 815 6386  
direct fax 4045414736  
cmarino@kilpatrickstockton.com

November 18, 2009

**Via Email & U.S. Mail**

R. Glenn Schroeder  
Hoffmann & Baron, LLP  
6900 Jericho Turnpike  
Syosset, New York 11791-4407

Re: *Georgia-Pacific Consumer Products, LP v. Global Tissue Group, Inc.*  
Opposition No. 91184529

Dear Glenn:

This is in response to your November 17 letter.

**I. Global Tissue's Untimely Noticed Depositions and Request for Discovery Extension**

Georgia-Pacific does not consent to a 60-day extension of the discovery period.

Without any notice, on November 4 your client sent six (6) deposition notices, unilaterally setting the depositions for November 18 and 19. As you know, deposing party must give "reasonable notice" in writing to the other party of a discovery deposition. *See* FED. R. CIV. P. 30(b)(1). Particularly with the upcoming Thanksgiving holiday, Global Tissue's notices were not reasonable advance notice.

While we believe that Global Tissue failed to notice depositions in a timely fashion, despite over sixteen (16) months during the discovery period in which such depositions could have been scheduled, we offered to make available two witnesses—a 30(b)(6) representative and a witness of Global Tissue's choosing—even though they would not be available until *after* the close of discovery. Your client decided not to accept this compromise offer.

This matter has been ongoing since June 2008, and discovery has been reset twice-- on May 4, 2009, and on September 9, 2009--both delays due to obstreperousness on the part of Global Tissue. Indeed, the reason Georgia-Pacific previously requested a 60-day

R. Glenn Schroeder  
November 18, 2009  
Page 2

extension of the discovery period early in this matter (which was *opposed* by Global Tissue) was in part due to the change of counsel, but primarily because Global Tissue (1) refused to consent to Georgia-Pacific's proposed Protective Order eventually approved by the Board; (2) refused to produce documents prior to the Board's resolution of Georgia-Pacific's Motion for Protective Order; and (3) would not make its witnesses available for deposition during the original discovery period. The second reset of the discovery period was necessitated by the refusal of Global Tissue's witnesses to answer relevant questions during their depositions, requiring Georgia-Pacific to move to compel responses with the Board.

We previously asked Global Tissue's counsel on several occasions whether it intended to depose anyone from Georgia-Pacific, and on every occasion, we were informed that Global Tissue did not intend to take any depositions. Global Tissue has had ample time to complete discovery in this matter, notwithstanding the change in counsel. It willingly chose to sleep on its rights, and cannot reasonably seek to extend discovery at the eleventh hour. *See Springs Window Fashions, LP v. Novo Industries, LP*, 323 F.3d 989 (Fed. Cir. 2003) ("When a party fails to secure discoverable evidence due to his own lack of diligence, it is not an abuse of discretion for the trial court to refuse to grant a continuance.")

Georgia-Pacific maintains its offer: Global Tissue may depose Andrew Towle individually and as a 30(b)(6) representative of the company on December 3 in Atlanta. Georgia-Pacific objects to the other untimely noticed depositions.

## **II. Georgia-Pacific's Document Production**

### **1. Privilege Log**

We have not yet received a privilege log from Global Tissue; please produce one immediately. Per your request, enclosed is a copy of Georgia-Pacific's privilege log.

### **2. Production of Documents as Kept in the Normal Course of Business**

We disagree with your claim that Georgia-Pacific failed to produce documents as they are kept in the normal course of business. On the contrary, we produced both hard-copy documents and imaged electronic files as they were originally kept by various Georgia-Pacific employees. Both the electronic index and hard-copy index that we provided to Global Tissue's counsel months ago is more than sufficient to meet Georgia-Pacific's discovery obligations. Please inform us of any legal authority standing for the proposition that Georgia-Pacific's production has been improper.

As an additional accommodation, we are willing to provide load files for the electronically-stored information that identifies the Bates number ranges for each document, if you believe that this information would assist you in your review.

**3. Other Requested Documents**

**a. Search Reports**

Georgia-Pacific has conducted a diligent search and is not in possession, custody, or control of any trademark search reports concerning the marks at issue in this matter. The only exception is a 2002 search obtained in connection with the mark IT'S ALL IN THE QUILTING. This search report, however is not discoverable. Not only is the in-house legal department's clearance search privileged, but it is not relevant, as it was conducted seven years ago and any marks cited in the report would have no bearing on the current market perception of the QUILTED® marks at issue.

**b. Documents Pertaining to Kimberly-Clark Litigation**

Documents pertaining to the litigation between Georgia-Pacific and Kimberly-Clark ("KC"), are not responsive to Request No. 16, which seeks: "All documents and things referring or relating to, or showing or documenting, objections Opposer has made to or relating to any third party's use and/or registration of any name, Mark, or designations, based on the use of the term 'QUILT' or a variation of that term." The litigation between Georgia-Pacific and KC does involve an objection to KC's use of the term "QUILT." Rather, it relates to KC's diamond-shaped *emboss pattern* imprinted on sheets of bath tissue.

To the extent your client would like to review documents from that proceeding, the pleadings are publicly available on the Internet through the PACER and TTABVUE systems. The documents produced to KC by Georgia-Pacific in that litigation are among the materials produced to Global Tissue in this matter, so you already have those. To the extent you would be seeking documents produced *by KC*, Georgia-Pacific cannot produce them in this action because KC produced them on a "confidential" basis pursuant to a Protective Order. Correspondence between litigation counsel for Georgia-Pacific and KC relating to things such as extensions, scheduling, page limits, and the like have absolutely no relevance to the present action.

**c. Documents Regarding Third Party Use of "Quilt"**

Georgia-Pacific has produced the responsive documents in its possession pertaining to third party use of "Quilt," including all documents pertaining to its enforcement actions. To

the extent Global Tissue desires documents from third parties, it should have subpoenaed them during the discovery period.

### **III. Amended Answer**

You ask Georgia-Pacific to consent to a motion to amend Global Tissue's Answer to assert counterclaims to cancel certain of Georgia-Pacific's registrations. Please provide the basis for these counterclaims, so we can consider whether an amendment at this late stage is appropriate.

Georgia-Pacific's Motion to Amend its Notice of Opposition was based upon *newly discovered information* in Global Tissue's discovery responses and deposition testimony; namely, that Global Tissue did not have any documents or other information sufficient to show that it had a bona fide intent to use the QUILTY mark at the time the application was filed. If the counterclaims Global Tissue seeks leave to add are based upon information that is not newly uncovered, Georgia-Pacific is not inclined to consent to such a motion.

### **IV. Settlement**

Global Tissue demanded that Georgia-Pacific pay it [REDACTED] to withdraw the QUILTY application. Your demand is absurd and amounts to nothing more than extortion. We welcome a reasonable explanation as to why Georgia-Pacific should pay [REDACTED] dollars to prevent Global Tissue from registering a mark that (a) clearly infringes Georgia-Pacific's rights; and (b) has never been used by Global Tissue.

Rest assured, we passed your "offer" along to Georgia-Pacific within minutes after our phone call yesterday, and it is hereby rejected. Georgia-Pacific does not pay infringers to stop infringing.

### **V. Interrogatories**

The individual who signed the interrogatory verification is Andrew Towle.

Sincerely,



Charlene R. Marino

R. Glenn Schroeder  
November 18, 2009  
Page 5

CRM/  
Enclosures

cc: Christine M. Cason  
R. Charles Henn Jr.

# **EXHIBIT G**

# HOFFMANN & BARON, LLP

ATTORNEYS AT LAW

6900 JERICHO TURNPIKE  
SYOSSET, NEW YORK 11791-4407

(516) 822-3550

FACSIMILE (516) 822-3582

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R. GLENN SCHROEDER  
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JAMES F. HARRINGTON†

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SENIOR COUNSEL  
ROBERT NEUNER

SCIENTIFIC ADVISOR  
DANIEL A. SCOLA, SR., Ph.D.

\* NOT ADMITTED IN NY  
† SENIOR ATTORNEY

November 20, 2009  
**VIA FIRST CLASS MAIL**  
**AND E-MAIL**

Charlene R. Marino, Esq.  
Kilpatrick Stockton, LLP  
1100 Peachtree Street, Suite 2800  
Atlanta, Georgia 30309

Re: Georgia-Pacific Consumer Products, LP v. Global Tissue Group, Inc.  
Opposition No. 91184529

Dear Charlene:

This letter is to confirm our discussion yesterday. In particular, we reviewed the topics raised in our letter of November 17, 2009, and your response of November 18, 2009. It is our understanding that Georgia-Pacific intends to stand by the positions set forth in your letter. If this understanding is incorrect, please advise us accordingly. Otherwise, as we advised you yesterday, we are proceeding with the filing of the motions mentioned in our November 17th letter.

Although not discussed during our conversation yesterday, we feel we must respond to the comments set forth in your November 18th letter regarding our settlement discussions. You state that Global Tissue “demanded that Georgia-Pacific pay it \$500,000 to withdraw the QUILTY application.” This depiction of our settlement discussions is both misleading, and typical of G-P’s bullying tactics. You asked us to discuss settlement with our client – we did so – and thereafter presented an offer to you in good faith. You may not have liked our offer, but to describe it as (1) a demand, (2) absurd, and (3) extortion is a clear mischaracterization of our discussions.

First, we did not demand anything. We presented an offer to you at your request. Second, what you may find to be “absurd”, others would find to be reasonable. The offer we presented to you was made with a sound business basis. Third, your statement that our offer is “extortion” ignores the fact that (i) you asked us for such an offer, (ii) that

Charlene R. Marino, Esq.  
Kilpatrick Stockton, LLP  
November 20, 2009  
Page 2

there is no evidence that our client has acted in anything but good faith, and (iii) that the Trademark Office considered our application in view all of G-P's marks, and thereafter approved the application for publication.

Next, your comment that this mark "clearly infringes Georgia-Pacific's rights" is a misstatement of any trademark law of which I am familiar. A mark must first be used before infringement can be found.

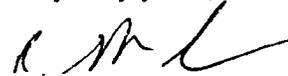
You then suggest that Global Tissue's mark has no value because it has not yet been used. This statement is not understood. As you know, U.S. Trademark Law allows for the filing of an intent-to-use application for a mark which has not yet been used. That is the whole purpose underlying that section of the law. Thus, use of a mark is clearly not dispositive of whether such mark has value.

Finally, your statement that "Georgia-Pacific does not pay infringers to stop infringing" is to use your own language "absurd", does nothing to advance the settlement discussions in this case and, as mentioned above, is a misstatement of the law.

We confirm your voicemail message of November 19, 2009 that should these proceedings be suspended upon the filing of our motions, that your client is not inclined to offer Andrew Towle for deposition on December 3, 2009.

We intend to have our motions filed by early next week and will advise you accordingly. We will also provide you with our privilege log at that time.

Very truly yours,



R. Glenn Schroeder

RGS:mak

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# **EXHIBIT H**

BEFORE THE UNITED STATES  
TRADEMARK TRIAL AND APPEAL BOARD

---

Georgia-Pacific Consumer Products LP,  
Opposer,

:  
: Opposition No. 91184529

Global Tissue Group, Inc.,  
Applicant.

---

**APPLICANT'S FIRST SET OF REQUESTS FOR THE  
PRODUCTION OF DOCUMENTS AND THINGS TO OPPOSER**

Pursuant to Rule 34 of the Federal Rules of Civil Procedure and Rule 2.120, Applicant Global Tissue Group, Inc. ("Applicant") hereby serves this First Set of Requests for the Production of Documents and Things on Opposer Georgia-Pacific Consumer Products LP ("Opposer"), and requests that Opposer respond by producing the requested documents at the offices of Applicant's counsel, Chernow Katz, LLC, 721 Dresher Rd., Ste. 1100, Horsham, PA 19044.

**DEFINITIONS AND INSTRUCTIONS**

Applicant incorporates by reference the definitions and instructions set forth in its First Set of Interrogatories to Opposer, served simultaneously herewith.

**REQUESTS**

**Request No. 1**

All documents and things referring or relating to Opposer's selection, adoption, and clearance of Opposer's Marks, including but not limited to searches, investigations, reports, and opinions.

Request No. 2

Documents and things sufficient to show and identify each product or thing on which Opposer's Marks have been used or affixed, are now used or affixed, and are intended to be used or affixed, from Opposer's alleged first use of Opposer's Marks to the present.

Request No. 3

Documents and things sufficient to show Opposer's alleged first use in the United States of each of Opposer's Marks on or in connection with each product identified in the certificates of registration for those marks.

Request No. 4

Documents and things sufficient to show Opposer's sale in units and dollars of all goods offered in connection with each of Opposer's Marks.

Request No. 5

Documents and things sufficient to show each channel of trade through which Opposer has marketed, distributed, offered, and/or sold; currently markets, distributes, offers, and/or sells; and intends to market, distribute, offer, and/or sell any products bearing Opposer's Marks.

Request No. 6

Documents and things sufficient to show the wholesale and retail prices at which Opposer currently sells goods in connection with Opposer's Marks.

Request No. 7

All documents and things referring or relating to, or showing, the nature, identity, or characteristics of each class or type of purchaser to whom Opposer has marketed, offered, and sold; currently markets, offers, and sells; and intends to market, offer, and sell any products bearing Opposer's Marks or associated with Opposer's Marks.

Request No. 8

Representative documents and things showing advertising and promotional materials prepared and/or released by or on behalf of Opposer in each advertising and/or promotional medium (e.g., brochures and other printed materials; print, television, radio, and Internet advertisements; websites; billboards, posters, and signage) featuring, displaying, depicting, or containing Opposer's Marks, and/or any of Opposer's products bearing Opposer's Marks or associated with Opposer's Marks, from the Opposer's first alleged use of Opposer's Marks to the present.

Request No. 9

Documents and things sufficient to show all forms and all manners of appearance in which Opposer allegedly has depicted, displayed, or used Opposer's Marks, including but not limited to all designs and stylizations, from Opposer's alleged first use of Opposer's Marks to the present.

Request No. 10

Documents and things sufficient to show Opposer's annual advertising and promotional expenditures for any products services bearing Opposer's Marks or associated with Opposer's Marks, from Opposer's alleged first use of Opposer's Marks to the present.

Request No. 11

All business plans, strategic plans, budgets, forecasts, projections, performance or other reports, analyses, or research referring or relating to Opposer's business and/or any of Opposer's products or services bearing Opposer's Marks or associated with Opposer's Marks.

Request No. 12

All documents and things evidencing, reflecting, supporting, or refuting each allegation of Opposer's Complaint.

Request No. 13

All documents and things referring or relating to, or showing or documenting, any instance of alleged confusion, mistake, or deception in the United States involving the Opposer and/or Opposer's Marks on the one hand, and Applicant, Applicant's products, or Applicant's Mark on the other hand.

Request No. 14

All documents and things referring or relating to any inquiries received by or known to Opposer about whether Opposer, any of Opposer's products or services, and/or Opposer's Marks, are or were affiliated or associated with, connected to, sponsored by, or otherwise related in any way to Applicant, Applicant's products, or Applicant's Mark, and/or vice versa.

Request No. 15

All documents and things in Opposer's possession or control referring or relating to any third-party use or registration of any name, Mark, or designation that consists of or includes the term "QUILT" or variations thereof, in connection with goods or services in connection with bathroom tissue, facial tissue and/or products related to the goods identified in the registrations for Opposer's Marks.

Request No. 16

All documents and things referring or relating to, or showing or documenting, objections Opposer has made to or relating to any third party's use and/or registration of any name, Mark, or designations, based on the use of the term "QUILT" or a variation of that term.

Request No. 17

All documents and things referring or relating to, or showing or documenting, objections Opposer has received from anyone relating to Opposer's use and/or registration of any name, Mark, or designation, based on the use of the term "QUILT" or a variation of that term.

Request No. 18

All documents and things referring or relating to, or constituting, agreements Opposer has reached with third parties concerning the use and/or registration of any name, Mark, or designation, based on the use of the term "QUILT" or a variation of that term.

Request No. 19

All documents and things referring or relating to, or constituting, trademark searches, reports, investigations, and/or opinions obtained by or on behalf of Opposer or its counsel relating to any name, Mark, or designation comprised of or containing the term "QUILT" or variations thereof.

Request No. 20

All documents and things referring or relating to, or constituting, any research, reports, surveys, investigations, and/or studies conducted by or on behalf of Opposer concerning, reflecting, or referring to the presence or absence of consumer confusion or the likelihood of confusion between, on the one hand, Opposer, Opposer's Marks as allegedly used by Opposer, or Opposer's products or services bearing Opposer's Marks or associated with Opposer's Marks, and, on the other hand, any Marks, names, or designations comprised of or containing the term "QUILT" or variations thereof, as used by any other person, including but not limited to Applicant.

Request No. 21

All documents and things referring or relating to, or identifying, the use, application to register, or registration of any Marks, names, or designations believed by Opposer to infringe, dilute, or otherwise violate Opposer's alleged rights in Opposer's Marks.

Request No. 22

All documents and things referring or relating to any judicial, administrative, or other proceedings in any forum (not including this action), in which Opposer was or is a party or was or is involved in any way, the subject of which was or is related to the name, Mark, or term "QUILT" or variations thereof.

Request No. 23

All documents and things referring or relating to, or constituting, any research, reports, surveys, investigations, and/or studies conducted by or on behalf of Opposer concerning, reflecting, or referring to consumer recognition of the term "QUILT" or variations thereof.

Request No. 24

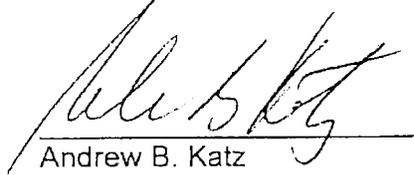
All documents and things referring or relating to, or constituting, any research, reports, surveys, investigations, and/or studies conducted by or on behalf of Opposer concerning, reflecting, or referring to the alleged fame of the term "QUILT" or variations thereof.

Request No. 25

All documents and things on which Opposer will rely to support its claim that registration of Applicant's mark will dilute Opposer's Marks under Section 43(c) of the Trademark Act.

DATED: September 30, 2008      Respectfully submitted,

CHERNOW KATZ LLC



Andrew B. Katz  
U.S.P.T.O. Reg. No. 34,200

721 Dresher Road, Suite 1100  
Horsham, Pennsylvania 19044  
phone: (215) 659-3600  
fax: (215) 659-3222  
email: [akatz@chernowkatz.com](mailto:akatz@chernowkatz.com)

COUNSEL TO GLOBAL TISSUE GROUP, INC.

# **EXHIBIT I**

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF GEORGIA  
ATLANTA DIVISION

GEORGIA-PACIFIC CONSUMER  
PRODUCTS LP,

Plaintiff,

v.

KIMBERLY-CLARK CORPORATION,  
KIMBERLY-CLARK GLOBAL SALES,  
INC., and  
KIMBERLY-CLARK WORLDWIDE,  
INC.

Defendants.

Civil Action No. 1:09-cv-371-BMM

**FIRST AMENDED COMPLAINT**

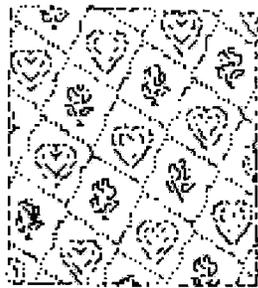
For its Complaint, Plaintiff Georgia-Pacific Consumer Products LP states the following:

**NATURE OF THE ACTION**

1. This is an action for unfair competition and trademark infringement under the Trademark Act of 1946, as amended, 15 U.S.C. § 1051 *et seq.* ("Lanham Act"), for trademark dilution under the antidilution laws of several states, including the Georgia antidilution act, O.C.G.A. § 10-1-451, for deceptive trade practices under the laws of several states, including Georgia, O.C.G.A. § 10-1-370 *et. seq.*, for unfair competition under the laws of Georgia, O.C.G.A. § 23-2-55, and

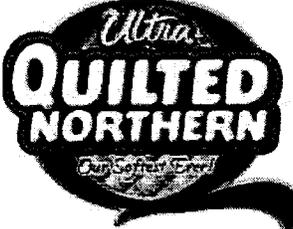
Affidavits have been filed pursuant to Sections 8 and 15 of the Lanham Act, 15 U.S.C. §§ 1058 and 1065, and this registration is incontestable. A copy of the Certificate of Registration for this mark is attached as **Exhibit 5**.

27. Georgia-Pacific is the owner of a federal trademark registration, Reg. No. 1,979,345, issued by the United States Patent and Trademark Office on June 11, 1996, for the Quilted Diamond Design, as depicted below in combination with a floral and heart motif, for "bathroom tissue."



Affidavits have been filed pursuant to Sections 8 and 15 of the Lanham Act, 15 U.S.C. §§ 1058 and 1065, and this registration is incontestable. A copy of the Certificate of Registration for this mark is attached as **Exhibit 6**.

28. In addition to registrations of the Quilted Diamond Design, Georgia-Pacific owns numerous trademark registrations incorporating the QUILTED and QUILTED NORTHERN word marks for bath tissue, including the following:

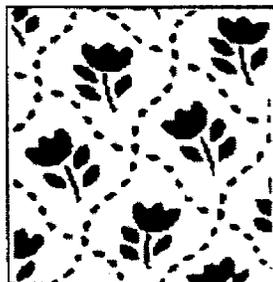
MARK	Reg. No.
QUILTED	2,957,128
	2,933,048
	3,463,900
QUILTED NORTHERN	2,968,615
QUILTED NORTHERN	2,209,027
QUILTED NORTHERN	2,657,013
QUILTED NORTHERN	2,663,438
	3,463,899
	1,877,561
QUILTED NORTHERN PS	3,018,501
QUILTED NORTHERN PS	3,293,547
QUILTED NORTHERN ULTRA	2,059,102
	3,463,460

MARK	Reg. No.
THE ULTIMATE QUILTED CLEAN	2,980,757
ACOLCHINADO (Quilted in Spanish)	3,170,713
FOR AN EVEN FRESHER QUILTED CLEAN	2,789,538

Copies of the Certificates of Registration for these marks are attached collectively as **Exhibit 7**.

**PRIOR ENFORCEMENT OF GEORGIA-PACIFIC’S RIGHTS**

29. Georgia-Pacific diligently and consistently has taken action to stop the sale of bath tissue bearing designs that are confusingly similar to the Quilted Diamond Design. Indeed, in 1998, Georgia-Pacific filed an action against Kimberly-Clark regarding bath tissue bearing the design depicted below:



The case was resolved in 2000 pursuant to a confidential settlement agreement.

30. More recently, on October 16, 2008, Georgia-Pacific filed an action against Procter & Gamble regarding a design on Charmin bath tissue that was

**JURY TRIAL DEMAND**

Plaintiffs respectfully demand a trial by jury on all claims and issues so triable.

Dated: March 18th, 2009.

Respectfully submitted,

/s/R. Charles Henn Jr.

William H. Brewster

Georgia Bar No. 080422

R. Charles Henn Jr.

Georgia Bar No. 347098

Kilpatrick Stockton LLP

1100 Peachtree Street, Suite 2800

Atlanta, Georgia 30309-4530

Tel. 404-815-6500

Fax 404-815-6555

Email: [BBrewster@KilpatrickStockton.com](mailto:BBrewster@KilpatrickStockton.com)

[CHenn@KilpatrickStockton.com](mailto:CHenn@KilpatrickStockton.com)

# **EXHIBIT J**

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

KIMBERLY-CLARK CORPORATION,	)	
	)	
Petitioner,	)	
	)	
v.	)	Cancellation No. 92051438
	)	
GEORGIA-PACIFIC CONSUMER	)	
PRODUCTS LP,	)	
	)	
Registrant.	)	
_____	)	

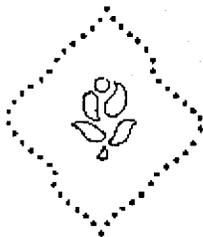
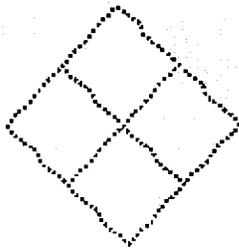
**REGISTRANT’S BRIEF IN SUPPORT OF MOTION TO SUSPEND  
PROCEEDINGS PURSUANT TO 37 C.F.R. § 2.117(a)**

Registrant, Georgia-Pacific Consumer Products LP (“Georgia-Pacific”), respectfully requests that the Board suspend this proceeding pursuant to 37 C.F.R. § 2.117(a) on the grounds that both parties to this proceeding are engaged in a civil action in federal court that will have a bearing on this proceeding.

**I. BACKGROUND**

In February 2009, Georgia-Pacific filed a civil action against Petitioner in the United States District Court in the Northern District of Georgia. The case was transferred to United States District Court for the Northern District of Illinois as Case No. 09-CV-2263, captioned *Georgia-Pacific Consumer Products LP v. Kimberly-Clark Corporation, Kimberly-Clark Global Sales, Inc., and Kimberly-Clark Worldwide, Inc.* A copy of the Amended Complaint is attached as **Exhibit A**. Petitioner’s Answer is attached as **Exhibit B**. Georgia-Pacific seeks judgment from the District Court against Petitioner for trademark infringement, trademark dilution, unfair

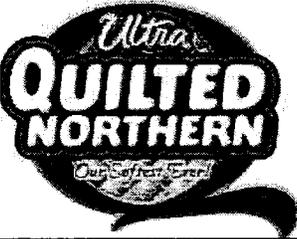
competition, and unlawful trade practices based on Georgia-Pacific's rights in its Quilted Diamond Design depicted below.

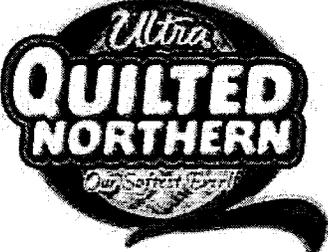


Kimberly-Clark's petition for cancellation is a strategic ploy, and an ill-fated effort to deflect from the same issues being decided in Georgia-Pacific's lawsuit.

Reflecting the obvious overlap between the proceedings, Georgia-Pacific's amended complaint asserts rights deriving in part from its QUILTED and QUILTED NORTHERN trademarks, which are covered by numerous trademark registrations, including:

MARK	Reg. No.
QUILTED	2,957,128
<b>QUILTED</b>	2,933,048

MARK	Reg. No.
	3,463,900
QUILTED NORTHERN	2,968,615
QUILTED NORTHERN	2,209,027
QUILTED NORTHERN	2,657,013
QUILTED NORTHERN	2,663,438
	3,463,899
	1,877,561
QUILTED NORTHERN PS	3,018,501
QUILTED NORTHERN PS	3,293,547
QUILTED NORTHERN ULTRA	2,059,102
	3,463,460
THE ULTIMATE QUILTED CLEAN	2,980,757
ACOLCHINADO (Quilted in Spanish)	3,170,713
FOR AN EVEN FRESHER QUILTED	2,789,538

MARK	Reg. No.
CLEAN	
QUILTED NORTHERN SOFT & STRONG	3,642,378
QUILTED NORTHERN ULTRA PLUSH	3,517,622
	3,642,213
	3,532,136

## II. ARGUMENT

The Board has the power to suspend proceedings in favor of a pending civil action pursuant to 37 C.F.R. § 2.117(a), which provides:

Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.

The Board regularly has exercised this power in the interests of promoting judicial economy and conserving resources. *See Vining Indus., Inc. v. Libman Co.*, No. 23,546, 1996 TTAB LEXIS 455, at \*6 (T.T.A.B. July 16, 1996) (suspending Board proceedings “in the interest of judicial economy and consistent with [the Board’s] inherent authority to regulate [its] proceedings to avoid duplicating the effort of the court and the possibility of reaching an

Respectfully submitted,

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