

ESTTA Tracking number: **ESTTA322086**

Filing date: **12/15/2009**

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

Proceeding	91184529
Party	Plaintiff Georgia-Pacific Consumer Products LP
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Date	12/15/2009
Attachments	2009.12.15 GP's Opposition to Motions to Ext. Discovery Period and to Compel Discovery.pdf (13 pages)(37317 bytes) 2009.12.15 Declaration of C. Marino.pdf (18 pages)(772940 bytes)

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

GEORGIA-PACIFIC CONSUMER
PRODUCTS LP,

Opposer,

v.

GLOBAL TISSUE GROUP, INC.

Applicant.

Opposition No.: 91184529

Serial No.: 77/364,616

**GEORGIA-PACIFIC'S CONSOLIDATED OPPOSITION TO
APPLICANT GLOBAL TISSUE GROUP'S MOTIONS TO EXTEND THE
DISCOVERY PERIOD AND TO COMPEL DISCOVERY**

During the entire 18 months this Opposition has been pending, Applicant Global Tissue Group (“Global Tissue”) slept on its rights, delayed and obstructed Georgia-Pacific’s efforts to take discovery, and utterly failed to pursue any of the discovery Global Tissue now seeks. Despite the fact that the close of discovery was extended twice, Global Tissue failed to notice the depositions of *any* of Georgia-Pacific’s witnesses and failed to follow up on *any* of its document requests. Now, on the eve of the close of discovery, Global Tissue asks the Board to re-open discovery for an additional two months and to compel the untimely-noticed depositions of *six* witnesses of Georgia-Pacific—witnesses Global Tissue has known about for more than a *year*.

Global Tissue’s motions are merely the latest in a continued strategy designed entirely to obstruct and delay resolution of this matter. Global Tissue’s failure to take any depositions until the last minute was a direct result of its own lack of diligence. The alleged “deficiencies” in Georgia-Pacific’s document production are nothing more than a manufactured excuse for the discovery extension. Indeed, the documents sought by Global

Tissue are irrelevant and/or privileged and thus should not have been produced by Georgia-Pacific in the first place.

Discovery has gone on long enough. Global Tissue made its bed and now should be required to lie in it. The Board should deny the motion to extend discovery as well as the motion to compel, and this case should be allowed to proceed to a swift conclusion.

RELEVANT FACTS

A. Procedural History

On June 11, 2009, Georgia-Pacific filed its Notice of Opposition. Although the original close of discovery was scheduled by the Board for February 16, 2009, since that time it has been reset twice, on May 4 and September 9. (*See* Dkt. 13 and 22.) Both extensions of the discovery period were necessitated by obstructionist and delay tactics on the part of Global Tissue.

While Georgia-Pacific substituted counsel early in this proceeding (in December 2008), it worked diligently to complete discovery within the originally set discovery period and Georgia-Pacific served timely notices for depositions of Global Tissue witnesses. In January 2009, however, Georgia-Pacific was forced to file a motion for an extension of the discovery period, because Global Tissue: (1) would not make its witnesses available for noticed depositions before the close of discovery; (2) refused to consent to Georgia-Pacific's proposed Protective Order eventually approved by the Board; and (3) refused to produce documents prior to the Board's resolution of Georgia-Pacific's Motion for Protective Order. (*See* Dkt. 8.) Global Tissue opposed the motion. (*See id.*) On May 4, 2009, the Board granted the motion and extended discovery to July 10. (*See* Dkt. 13.)

On June 4, 2009, the parties completed the exchange of documents, and Georgia-Pacific took depositions of Global Tissue's witnesses a few weeks later, on June 24. (Marino Dec. ¶ 7.) In these depositions, Global Tissue once again engaged in obstructionist tactics when its witnesses refused to answer relevant questions, requiring Georgia-Pacific to move to compel responses with the Board shortly before the close of discovery. (See Dkt. 16.) After oral argument with the interlocutory attorney, the Board granted Georgia-Pacific's Motion to Compel and reset the close of discovery to December 2, 2009, to provide sufficient time for Georgia-Pacific to re-take the deposition of Global Tissue's recalcitrant witnesses. (See Dkt. 22.) Georgia-Pacific worked cooperatively with Global Tissue to find a convenient date for the Board-ordered follow-up deposition of Global Tissue's 30(b)(6) representative, and completed it on October 23. (Marino Dec. ¶ 9.)

B. Global Tissue's Last-Minute Deposition Notices.

During the discovery period, Georgia-Pacific asked Global Tissue's counsel on several occasions whether it intended to depose anyone from Georgia-Pacific. (*Id.* ¶ 10.). On every occasion, Global Tissue told Georgia-Pacific's counsel that it did not intend to take any depositions. (*Id.*) More than one year ago, in November 2008, Georgia-Pacific responded to Global Tissue's Interrogatories and Requests for Production of Documents, and at that time Georgia-Pacific disclosed the witnesses who may have knowledge relevant to this case. (*Id.* ¶¶ 2-3.) Thus, over the span of an *entire year*, Global Tissue never asked to depose any of these witnesses.

For the first time, on November 2, 2009, Global Tissue's new counsel contacted counsel for Georgia-Pacific, advising of the substitution of counsel and indicating that they would be noticing depositions. (*Id.* ¶ 12.) On November 4 -- only seventeen business days

before discovery was set to close -- Global Tissue served six (6) deposition notices, unilaterally setting the depositions for two weeks later. (*Id.* ¶ 13.) Most of the witnesses noticed by Global Tissue are senior executives of Georgia-Pacific (one is a former employee over whom Georgia-Pacific has no control) and, due to their schedules and the Thanksgiving holiday, were unavailable to clear their schedules in order to be deposed prior to the close of discovery on December 2. (*Id.* ¶ 14.)

Despite the fact that Global Tissue failed to provide reasonable notice of these depositions, and despite the significant inconvenience it imposed on Georgia-Pacific and its senior executives, Georgia-Pacific offered to make available two (2) witnesses—a 30(b)(6) representative and a witness of Global Tissue's choosing—after the close of discovery, on December 3. (*Id.*) Global Tissue rejected Georgia-Pacific's compromise offer and instead filed this motion. (*Id.*)

C. Global Tissue's Last-Minute Document Requests.

On November 17, 2009, Global Tissue requested that Georgia-Pacific produce a privilege log as well as search reports for marks listed in the Notice of Opposition and documents pertaining to unrelated litigation between Georgia-Pacific and Kimberly-Clark. (*Id.* ¶ 15 & Ex. A.) Georgia-Pacific promptly responded to this request -- the very next day - - by producing its privilege log and explaining that it had no responsive search reports other than a 2002 search report for the mark IT'S ALL IN THE QUILTING.¹ (*Id.* ¶ 16 & Ex. B.) Because the search report is protected by the attorney-client privilege and work product doctrine, and because its date (seven years ago) rendered it irrelevant to this proceeding, Georgia-Pacific declined to produce the search report. (*Id.*)

¹ The search report was properly listed on Georgia-Pacific's privilege log.

Georgia-Pacific also responded to Global Tissue's last-minute request for documents pertaining to the litigation between Georgia-Pacific and Kimberly-Clark. First, the litigation is irrelevant to this proceeding because it involved an objection to Kimberly-Clark's use of a diamond-shaped emboss pattern imprinted on bath tissue, not use of a word mark confusingly similar to Georgia-Pacific's QUILTED marks. (*Id.* ¶ 17 & Ex. B.) Second, Georgia-Pacific advised Global Tissue that because the pleadings in that matter were publicly available (on PACER, for example), they could be downloaded directly by Global Tissue without imposing a burden on Georgia-Pacific. Third, Georgia-Pacific *already* had produced all of the same documents in this proceeding that Georgia-Pacific produced to Kimberly-Clark in that proceeding. Fourth, all of the documents produced by Kimberly-Clark were marked "confidential" or "attorneys-eyes-only" pursuant to a Protective Order, and thus could not be disclosed by Georgia-Pacific. (*Id.*)

The only documents from the Kimberly-Clark litigation that were not publicly available, covered by a Protective Order, or already produced to Global Tissue were emails between outside litigation counsel for Georgia-Pacific and outside litigation counsel for Kimberly-Clark relating to procedural issues such as extensions of time, deposition scheduling, briefing page limits, and the like. (*Id.*) These documents have absolutely nothing to do with the issues before the Board in the present action and are neither relevant nor reasonably calculated to lead to the discovery of admissible evidence.

ARGUMENT AND CITATION OF AUTHORITY

A. **Global Tissue’s Unreasonable Delay in Conducting Discovery is not Good Cause for an Extension of the Discovery Period.**

A party moving for an extension of the discovery period must show “good cause” for the requested extension. TBMP § 509.01. Moreover, “a party moving to extend time must demonstrate that the requested extension of time is not necessitated by **the party’s own lack of diligence or unreasonable delay** in taking the required action during the time previously allotted therefore.” TBMP § 509.01(a) (emphasis added). Global Tissue’s failure to act diligently in conducting discovery is not “good cause” for an extension of the discovery period. As the Board explained:

A party may not wait until the waning days of the discovery period to serve his discovery requests or notices of deposition and then be heard to complain that he needs an extension of the discovery period in order to take additional discovery. Mere delay in initiating discovery does not constitute good cause of an extension of the discovery period. If a party believes that issues in a case are complex and may involve lengthy discovery, it is his responsibility to begin taking discovery early in the discovery period. To allow an extension for all purposes herein would be to reward [applicant] for its delay in initiating discovery, a result which is to be discouraged.

Luehrmann v. Kwik Kopy Corp., 2 U.S.P.Q.2d 1303, 1305 (T.T.A.B. 1987).

Global Tissue’s claim that it has acted diligently throughout discovery is belied by the fact that, since serving Georgia-Pacific with interrogatories and document requests in October 2008, it has done *nothing* to pursue discovery. It willingly chose to sleep on its rights throughout this proceeding, including several extensions of the discovery period, and cannot now 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.”)

Although Global Tissue notes that the witnesses it seeks to depose are those identified by Georgia-Pacific in interrogatory responses, Global Tissue conveniently fails to mention that Georgia-Pacific identified two of these witnesses in its Initial Disclosures served on September 19, 2008, and the remaining witnesses in its interrogatory responses on November 4, 2008. Thus, Global Tissue has known of these witnesses for *over a year*, and never once noticed their depositions or even requested available dates for their depositions.

Global Tissue’s claim that an extension is necessary because Georgia-Pacific’s document production is “deficient” is a further red herring. Global Tissue received Georgia-Pacific’s document production in June and never once raised any issues regarding perceived deficiencies. As shown below, Georgia-Pacific has produced all responsive documents in its possession in a timely manner. Any “deficiencies” alleged by Global Tissue are a contrivance intended to cover up its own lack of diligence.

Global Tissue has had ample time to complete discovery in this matter. *See Luehrmann*, 2 U.S.P.Q.2d at 1305 (denying in part request for additional discovery where moving party “did nothing” during the discovery period). Its recent decision to substitute counsel and to pursue a more aggressive discovery strategy at the last minute does not constitute “good cause” for an extension. This proceeding has already languished long enough due to Global Tissue’s dilatory tactics, and resolution of Georgia-Pacific’s claims on the merits should not be further delayed.

B. Global Tissue’s Unreasonable Delay Mandates Denial of its Motion to Compel.

1. The Requested Depositions Were Not Timely Noticed.

Because Global Tissue slept on its rights for an entire year and failed to diligently pursue discovery depositions, its motion to compel depositions should be denied. A deposing party must give “reasonable notice” in writing to the other party of a discovery deposition. *See* FED. R. CIV. P. 30(b)(1). Global Tissue served six deposition notices on November 4 for depositions unilaterally scheduled for 10 business days later (the week before Thanksgiving), which is not reasonable notice for the five senior executives and one former employee of Georgia-Pacific sought to be deposed.² Therefore, its motion to compel the depositions should be denied. *See In re Sulfuric Acid Antitrust Litig.*, 231 F.R.D. 320, 327 (N.D. Ill. 2005) (denying plaintiffs’ motion to compel two depositions, noticed ten days prior to the deposition dates and slightly more than two weeks before the close of discovery); *see also Al-Kidd v. Gonzales*, No. CV: 05-093-S-EJL-MHW, 2008 WL 2788418, *4-5 (D. Idaho July 17, 2008) (denying plaintiff’s motion to compel, finding the deposition notice five days before the deposition was to occur, which was two days before the cutoff period for discovery, and where the claims against the defendants had “existed for quite some time”); *Erbe Elektromedizin GmbH v. Candy*, Civ. A. No. 05-1674, 2006 WL 2287176, *1 (W.D. Pa. Nov. 21, 2006) (denying plaintiffs’ motion to compel the deposition of nine deponents noticed on the last day of discovery, noting that plaintiffs did not propound any discovery for seven months, but instead waited until the last day).

² Despite the fact that Global Tissue failed to notice these depositions in a timely fashion, Georgia-Pacific offered to make available two witnesses—a 30(b)(6) representative and a witness of Global Tissue’s choosing—available after the close of discovery on December 3, the first possible date they were available. Global Tissue rejected this compromise offer. (Marino Dec. ¶¶ 6-7.)

2. Georgia-Pacific's 7-Year-Old Search Report Is Privileged and Irrelevant.

Georgia-Pacific is not in possession, custody, or control of trademark search reports covering the marks at issue in this matter. The only exception is a 2002 search obtained by Georgia-Pacific's in-house legal department in connection with the mark IT'S ALL IN THE QUILTING. This search report, however, is privileged and confidential work product, and is thus not discoverable. *See Flagstar Bank, FSB v. Freestar Bank, N.A.*, No. 09 C 1941, 2009 WL 2706965, *4 (Aug. 25, 2009) (rejecting a "bright-line rule that would render all documents that demonstrate the execution of a trademark search and all trademark search reports, non-privilege[.]" and finding plaintiff's search report to be protected from discovery under the attorney-client privilege).

In addition to the privilege concerns, the outdated search report has no relevance to the issues in this proceeding. The search report was conducted seven years ago, and thus it has no bearing on the current market perception of Georgia-Pacific's family of QUILTED® trademarks. *See Univ. of Ga. Athletic Ass'n v. Laite*, 756 F.2d 1535, 1545 n.27 (11th Cir. 1985) (third party use of mark only relevant where it can be shown that the marks are recognized by the public); *McGraw-Edison Co. v. Walt Disney Prods.*, 787 F.2d 1163, 1171 (7th Cir. 1986) (existence of other registrations only relevant where it can be shown that the marks are actually currently being used by third parties to the extent that they are recognized by consumers).

3. Irrelevant Documents From Third-Party Litigation Should Not Be Compelled.

The documents pertaining to the federal litigation between Georgia-Pacific and Kimberly-Clark are also not discoverable. As a preliminary matter, such documents are not

responsive to Global Tissue's Document Requests (*see* Nos. 16, 17, 21, & 22, cited by Global Tissue in its Motion), because the litigation between Georgia-Pacific and Kimberly-Clark does not involve Kimberly-Clark's use of the term "QUILT." Rather, the litigation relates to Kimberly-Clark's diamond-shaped *emboss pattern* imprinted on sheets of bath tissue. (Marino Dec. ¶ 17 & Ex. B.)

Even if the documents were responsive to a properly-served Document Request, Georgia-Pacific should not be compelled to produce them. First, the substantive pleadings pertaining to the Kimberly-Clark litigation (as well as the corresponding TTAB cancellation action) are available to Global Tissue on the Internet through the PACER and TTABVUE systems. *See Tequila Centinela, S.A. de C.V. v. Bacardi & Co. Ltd.*, 242 F.R.D. 1, 11-12 (D.D.C. 2007) ("Typically, courts do not order discovery of public records which are equally accessible to all parties.") (citations omitted); *Fresenius Med. Care Holding Inc. v. Baxter Int'l, Inc.*, 224 F.R.D. 664, 656 (N.D. Cal. 2004) (denying plaintiff's motion to compel as to publicly available documents); *Dushkin Publ'g Group, Inc. v. Kinko's Serv. Corp.*, 136 F.R.D. 334, 335 (D.D.C. 1991) ("To the extent [plaintiff] seeks documents that have been filed with the court in the Southern District and that are a matter of public record, the plaintiff's motion to compel is denied."); *Sec. and Exch. Comm'n v. Samuel H. Sloan & Co.*, 369 F. Supp. 994 (S.D.N.Y. 1973) ("It is well established that discovery need not be required of documents of public record which are equally accessible to all parties.").

Second, the documents produced in discovery by Georgia-Pacific to Kimberly-Clark already were included among the materials Georgia-Pacific produced to Global Tissue in this matter. (Marino Dec. ¶ 17 & Ex. B.) The documents produced in discovery by Kimberly-Clark cannot be produced by Georgia-Pacific in this action because they were produced on a

“confidential” or “attorneys-eyes-only” basis pursuant to a Protective Order in that case.

(Id.)

The only materials (i) not already produced, (ii) protected by a Protective Order, or (iii) publicly available for Global Tissue to download, are the emails between outside litigation counsel for both Georgia-Pacific and Kimberly-Clark relating to mundane procedural issues such as extensions of time, deposition scheduling, briefing page limits, and the like. *(Id.)* These are neither relevant nor reasonably calculated to lead to the discovery of admissible evidence in this Board proceeding. Thus, the Board should deny Global Tissue’s motion to compel these materials.

CONCLUSION

Global Tissue’s last-minute change in counsel at the close of discovery is not sufficient “good cause” to overcome its prior negligence in failing to diligently pursue discovery during the discovery period. It would be highly prejudicial to Georgia-Pacific, which acted diligently throughout discovery, to delay the resolution of this matter any further, and require it to incur the significant expense of another two months of discovery and six witness depositions. The documents sought by Global Tissue are privileged, publicly available, or are irrelevant and not reasonably calculated to lead to the discovery of admissible evidence. For all of these reasons, Global Tissue’s motion to compel and extend discovery should be denied.

This 15th day of December, 2009.

/s/ Charlene R. Marino

R. Charles Henn Jr.

Charlene R. Marino

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this date, December 15, 2009, a copy of this paper has been served upon Applicant, by email and by U.S. mail, to Applicant's current identified counsel, as set forth below:

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

/s/ Charlene R. Marino

Charlene R. Marino

Attorney for Opposer Georgia-Pacific
Consumer Products LP

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DECLARATION OF CHARLENE R. MARINO

I, Charlene R. Marino, pursuant to 28 U.S.C. § 1746, declare under penalty of perjury under the laws of the United States of America that the following is true and correct:

1. My name is Charlene R. Marino. I am an attorney at Kilpatrick Stockton, counsel for Opposer Georgia-Pacific Consumer Products, LP (“Georgia-Pacific”) in the above-styled Opposition proceeding. I have personal knowledge of the facts stated in this declaration, which are true and correct to the best of my knowledge.

2. In October 2008, Applicant Global Tissue Group served on prior counsel for Georgia-Pacific written Interrogatories and Requests for Production of Documents. In November 2008, Georgia-Pacific served responses to this written discovery.

3. In its interrogatory responses, Georgia-Pacific disclosed the witnesses who may have knowledge relevant to the case, including Andrew Towle, David Sayyed, Patrick Davis, Thomas Best, and Emily Boss. In its Initial Disclosures served in September 2008, Georgia-Pacific had previously disclosed Mr. Towle and Mr. Sayyed as witnesses with knowledge.

4. On December 12, 2008, Georgia-Pacific substituted Kilpatrick Stockton as its counsel. As soon as the notice of substitution of counsel was filed, Georgia-Pacific worked

diligently to complete discovery within the originally set discovery period. Georgia-Pacific produced all non-confidential documents in its possession in January and served notices for the depositions of Global Tissues witnesses in January 2008, within the original discovery period.

5. Upon receipt of Georgia-Pacific's deposition notices, Global Tissue advised that its witnesses were not available to be deposed until after the close of discovery. Because of this, and because Global Tissue refused to produce any documents until the Board resolved a dispute between the parties over Georgia-Pacific's proposed Protective Order, Georgia-Pacific to file a motion with the Board for an extension of discovery on January 21, 2009. Global Tissue's counsel declined to consent to this motion.

6. On May 4, 2009, the Board granted Georgia-Pacific's motion for Protective Order, extended discovery to July 10, and ordered the parties to complete the exchange of all documents.

7. In June 2009, Georgia-Pacific produced its remaining responsive documents and conducted discovery depositions of Global Tissues' witnesses.

8. However, in their depositions, Global Tissue's witnesses refused to answer certain questions, requiring Georgia-Pacific to move to compel responses with the Board shortly before the close of discovery in early July 2009.

9. On September 9, 2009, the Board granted Georgia-Pacific's Motion to Compel, ordered Global Tissue to offer a 30(b)(6) representative for a follow-up deposition, and reset the close of discovery to December 2, 2009. Georgia-Pacific worked cooperatively with Global Tissue to find a convenient date for the Board-ordered follow-up deposition of Global Tissue's 30(b)(6) representative, and completed this deposition on October 23, 2009.

10. On several occasions during discovery, including at the deposition on October 23, I asked Global Tissue's former counsel, Andrew Katz, whether his client intended to depose anyone from Georgia-Pacific, so that I could look into available dates for those witnesses. On all of these occasions, he replied that Global Tissue did not intend to take any discovery depositions.

11. Other than its first set of interrogatories and document requests served in October 2008, until November 2009, Global Tissue took no depositions, served no additional interrogatories, requested no additional documents, and never advised counsel Georgia-Pacific that there were any deficiencies in Georgia-Pacific's discovery responses.

12. On November 2, 2009, I was contacted by Glen Schroeder via telephone, who advised that his law firm had recently been retained as new counsel for Global Tissue and indicated that he would be sending out notices for the deposition of Georgia-Pacific witnesses.

13. On November 4, 2009, I received from Mr. Schroeder's office six (6) deposition notices, including notices for a 30(b)(6) representative and five individual witnesses, which were unilaterally scheduled by Global Tissue for November 18-19, 2009. In response to the receipt of these notices, I advised Mr. Schroeder that I would check on the availability of the witnesses and respond to him with their availability as soon as possible.

14. Most of the witnesses noticed by Global Tissue are senior executives of Georgia-Pacific (other than Mr. Sayyed, who is a former employee over whom Georgia-Pacific has no control) and, due to their schedules and the Thanksgiving holiday, were unavailable to clear their schedules in order to be deposed prior to the close of discovery on December 2, 2009. However, Georgia-Pacific offered to make available two witnesses (a 30(b)(6) representative

and a witness of Global Tissue's choosing) on December 3. Global Tissue rejected this compromise offer.

15. On November 17, 2009, I received a letter from Mr. Schroeder on behalf of Global Tissue requesting (1) a two-month extension of the discovery period; (2) available dates for the six noticed witness depositions; and (3) that Georgia-Pacific produce a number of documents, including a privilege log, trademark search reports, and documents pertaining to separate litigation between Georgia-Pacific and Kimberly-Clark. A true and correct copy of this letter is attached as Exhibit A.

16. Georgia-Pacific responded in writing to this request the next day (November 18, 2009) by producing its privilege log and explaining that it had no responsive search reports other than a 2002 search report for the mark IT'S ALL IN THE QUILTING, which Georgia-Pacific listed on its privilege log. A true and correct copy of this response letter is attached as Exhibit B.

17. In this letter, Georgia-Pacific also responded to Global Tissue's request for documents pertaining to the litigation between Georgia-Pacific and Kimberly-Clark, explaining that (1) the litigation is irrelevant to this proceeding because it involved an objection to Kimberly-Clarks use of a diamond-shaped emboss pattern imprinted on bath tissue, not use of a word mark confusingly similar to Georgia-Pacific's QUILTED marks; (2) the pleadings in that matter were publicly available; (3) Georgia-Pacific had already produced all of the same documents in this proceeding that Georgia-Pacific produced to Kimberly-Clark in that proceeding; (4) all of the documents produced by Kimberly-Clark were marked "confidential" or "attorneys-eyes-only" pursuant to a Protective Order, and thus could not be disclosed by Georgia-Pacific; and (5) the only documents pertaining to that

litigation were emails between outside litigation counsel for Georgia-Pacific and outside litigation counsel for Kimberly-Clark relating to procedural issues such as extensions of time, deposition scheduling, briefing page limits, and the like. (*See Ex. B.*)

18. In the same letter of November 17, 2009, Mr. Schroeder asked if Georgia-Pacific would consent to a motion by Global Tissue to amend its Answer to assert counterclaims. (*See Ex. A.*)

19. In Georgia-Pacific's responsive letter of November 18, 2009, I asked Mr. Schroeder to identify the nature of the counterclaims so Georgia-Pacific could determine whether they were based upon any newly-acquired information. (*See Ex. B.*)

20. Mr. Schroeder responded in a telephone conversation that Global Tissue intended to move to amend its Answer to add counterclaims to cancel a number of Georgia-Pacific registrations, similar to the Cancellation proceeding filed against Georgia-Pacific by Kimberly-Clark in September, 2009. However, he did not identify any newly-acquired facts or evidence giving rise to these new counterclaims.

This 15th day of December, 2009.



Charlene R. Marino

EXHIBIT A

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November 17, 2009

VIA FACSIMILE & E-MAIL

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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 it 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.

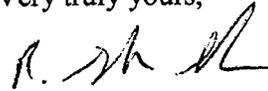
8. Please confer with your client and determine whether they are in possession of any documents showing use of the terms "quilt", "quilted" or variations thereof by their competitors, other than the litigation/adversarial documents provided to us. If no such documents exist, please confirm that for us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

Charlene R. Marino, Esq.
November 17, 2009
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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 B

November 18, 2009

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

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

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

R. Glenn Schroeder
November 18, 2009
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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 \$500,000.00 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 half a million 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
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CRM/
Enclosures

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