

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

Mailed: October 6, 2010

Opposition No. 91184529

Georgia-Pacific Consumer  
Products LP

v.

Global Tissue Group, Inc.

Jennifer Krisp, Interlocutory Attorney:

This proceeding is before the Board for consideration of applicant's motion (filed May 27, 2010) to compel discovery. The motion has been fully briefed.

The Board may, upon its initiative, resolve a motion filed in an inter partes proceeding by telephone conference. See Trademark Rule 2.120(i)(1); TBMP § 502.06(a) (2d ed. rev. 2004). On October 5, 2010, the Board convened a telephone conference to resolve the issue(s) presented in the motion. Participating were applicant's counsel R. Glenn Schroeder, Esq., opposer's counsel Charlene R. Marino, Esq., and the assigned interlocutory attorney.

Applicant seeks an order compelling opposer to 1) produce additional witnesses to complete the deposition under Fed. R. Civ. P. 30(b)(6) with respect to topics 2, 4, 5, 6, 7, 9, 12 and 13 identified in its November 4, 2009 notice of deposition (Exhibit A to applicant's motion to

compel); and 2) a revised privilege log pursuant to Fed. R. Civ. P. 26(b)(5).<sup>1</sup>

Through an exchange of written communications between counsels detailing applicant's position with respect to its assertions of insufficiencies in testimony provided by opposer's Fed. R. Civ. P. 30(b)(6) designee, Mr. Andrew Towle, during his discovery deposition, and assertions of insufficiencies in the privilege log which is at issue, applicant satisfied its obligation to make a good faith effort to resolve the issues presented in its motion prior to seeking the Board's intervention. See Trademark Rule 2.120(e)(1).

#### Deposition

With respect to topic 2 ("Advertising and marketing of products sold under Opposer's Marks"), the questions posed by applicant are within the scope of this topic, and request information which applicant is entitled to pursue. Opposer's argument that Mr. Towle answered a "majority" of the questions posed is unpersuasive. Opposer has claimed a date of priority of use as early as January, 1993, and as early as August, 2004 for the mark QUILTED NORTHERN. Mr. Towle's employment with opposer did not commence until late 2007, he serves as General Manager for a portion of opposer's business (the consumer bath tissue business), and it is apparent from the transcript of his deposition that he

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<sup>1</sup> Applicant designated its motion as confidential, and filed two copies (one redacted copy) under Trademark Rule 2.126(c). Thus, in this order, the Board refers to certain matters in general.

has a limited ability to answer questions regarding opposer's marks and/or products that predate his period of employment. In view thereof, applicant's motion is granted.

With respect to topic 4 ("Searches, investigations, reports and/or opinions directed and/or referring to any of Opposer's Marks"), while comments or opinions of attorneys relating to search reports are privileged and not discoverable, the circumstances surrounding and information regarding the adoption, selection and uses of a mark or marks are discoverable. See, e.g., *J.B. Williams Co. Inc. v. Pepsodent G.m.b.H.*, 188 USPQ 577 (TTAB 1975). See also TBMP § 414(4) and 414(6) (2d ed. rev. 2004). Moreover, in certain instances, while Mr. Towle responded that he did not have information, he was able to name individuals within the company who would likely have such knowledge; thus, opposer's contention that no one else has the information sought is unpersuasive. In view thereof, applicant's motion is granted.

With respect to topic 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"), and topic 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"), applicant's questions were within the scope of these topics.

Furthermore, information regarding a party's awareness of third-party use and/or registration of the same or similar marks for the same or related goods is discoverable to the extent that the responding party has actual knowledge thereof. See TBMP § 414(9) (2d ed. rev. 2004). At a minimum, given that applicant has asserted a counterclaim alleging descriptiveness under Trademark Act Section 2(e)(1), this information is reasonably calculated to lead to the discovery of admissible evidence. Moreover, applicant questioned the designee regarding such usage for certain of opposer's products, whereupon Mr. Towle indicated a lack of knowledge, and named a counterpart who is knowledgeable about that part or portion of opposer's business. In view thereof, applicant's motion is granted.

With respect to topic 7 ("Brand awareness and competitive brands"), applicant's questions regarding opposer's awareness and/or review of "competitive ads" are within the scope of this topic. Moreover, Mr. Towle identified individuals within the company who may have information relevant to these questions, and opposer's counsel indicated during the conference a willingness to produce the custodian of certain documentation about which applicant has questioned opposer's designee. In view thereof, applicant's motion is granted.

With respect to topic 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"), applicant's motion centers on questions directed to opposer's designee regarding objections to uses by a third party of the term "QUILT." Opposer's counsel represented during the conference that opposer provided information responsive to these particular questions in answers to interrogatories, a copy of which opposer provided with its brief on the motion to compel, that any information in addition to that which has been provided would be privileged, and that the referenced litigation does not center on the third party's use of the term "QUILT." Furthermore, it is noted that information included within the record of litigation between opposer and a third party may be obtainable from other sources, and applicant previously requested information by way of a subpoena. *Cf. Pioneer Kabushiki Kaisha v. Hitachi High Technologies America Inc.*, 74 USPQ2d 1672, 1674 (TTAB 2005) (Board can limit or bar a deposition if it determines that the discovery sought is obtainable from other sources that are more convenient and less burdensome or duplicative). In view thereof, applicant's motion is denied.

With respect to topic 12 ("Consumer recognition of names, marks and/or designations including the term 'QUILT' or variations thereof"), and topic 13 ("The alleged fame of any name, mark or designation including the term 'QUILT' or variations thereof"), opposer's brief in opposition to the motion does not address these issues. It is apparent from the transcript that Mr. Towle responded that he did not know

the information requested, which centered on a particular document produced by opposer during discovery. Moreover, in conference, counsel for opposer identified an individual within the company who can testify as to this matter. In view thereof, applicant's motion is granted.

Accordingly, applicant's motion to compel is granted to the extent noted herein, that is, with respect to topics 2, 4, 5, 6, 7, 12 and 13. Opposer is directed to make available, for deposition on the identified topics, a second Fed. R. Civ. P. 30(b)(6) designee. In the event that one individual is not able to testify as to matters within his or her knowledge, as well as matters known or reasonably available to opposer, regarding *each* of these topics, opposer must make available one or more additional designees, as appropriate, to testify as to the remaining topics. Fed. R. Civ. P. 30(b)(6) and 31(a)(3). Opposer is allowed until forty-five (45) days from the mailing date of this order in which to produce one or more deponents, as directed.

As a general note, in the event that opposer's designee or designees do not provide responses to inquiries that seek discoverable information, opposer may be precluded from introducing or relying on such information at trial. *Cf. Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1677 (TTAB 1988); *Vignette Corp. v. Marino*, 77 USPQ2d 1408, 1411 fn. 4 (TTAB 2005).

Privilege log

A review of what opposer has provided indicates that opposer chose to identify each communication or document listed on its privilege log, identified as Exhibit 4 to the Towle deposition, using a finite set of descriptors which it included under the "Reviewer Comments" column of said log. As noted during the conference, applicant's motion is granted to the extent that opposer is directed to provide a written, detailed descriptive definition for each type of entry it elected to include in the "Reviewer Comments" column of its privilege log. Fed. R. Civ. P. 26(b)(5).

For example, opposer shall provide a descriptive definition for each of the following types of entries: "testing of product;" legal advice/review;" and "testing."

Schedule

Proceedings are resumed. The close of discovery is extended for the purpose of allowing the completion of the discovery deposition(s) as directed herein. Accordingly, discovery, pre-trial disclosure and trial dates are reset as follows:

Discovery Closes	November 24, 2010
Plaintiff's Pretrial Disclosures	January 8, 2011
30-day testimony period for plaintiff's testimony to close	February 22, 2011
Defendant/Counterclaim Plaintiff's Pretrial Disclosures	March 9, 2011
30-day testimony period for defendant and plaintiff in the counterclaim to close	April 23, 2011
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	May 8, 2011

30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	June 22, 2011
Counterclaim Plaintiff's Rebuttal Disclosures Due	July 7, 2011
15-day rebuttal period for plaintiff in the counterclaim to close	August 6, 2011
<b>BRIEFS SHALL BE DUE AS FOLLOWS:</b>	
Brief for plaintiff due	October 5, 2011
Brief for defendant and plaintiff in the counterclaim due	November 4, 2011
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	December 4, 2011
Reply brief, if any, for plaintiff in the counterclaim due	December 19, 2011

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

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