ESTTA Tracking number: **ESTTA392735**
Filing date: **02/10/2011**

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

Proceeding	91184529
Party	Defendant Global Tissue Group, Inc.
Correspondence Address	R. GLENN SCHROEDER HOFFMAN & BARON, LLP 6900 JERICHO TURNPIKE SYOSSET, NY 11791 UNITED STATES gschroeder@hoffmannbaron.com
Submission	Opposition/Response to Motion
Filer's Name	R. Glenn Schroeder
Filer's e-mail	rgsdocket@hoffmannbaron.com
Signature	/r. glenn schroeder/
Date	02/10/2011
Attachments	Redacted Opposition to Opposer's Motion for Summary Judgment.pdf (15 pages)(1499128 bytes)

REDACTED

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

GEORGIA-PACIFIC CONSUMER PRODUCTS LP,	)	
Opposer,	)	Opposition No.: 91184529
v.	)	
GLOBAL TISSUE GROUP, INC.	)	
Applicant.	)	

APPLICANT'S OPPOSITION TO OPPOSER'S MOTION FOR SUMMARY JUDGEMENT

Applicant Global Tissue Group ("Global Tissue") hereby submits this Opposition paper in response to Georgia-Pacific Consumer Products LP's ("Georgia-Pacific") Motion for Summary Judgment.

I. INTRODUCTION

A. Background

Global Tissue is a family-owned business which was founded in 1999, and which manufactures finished paper products. More particularly, Global Tissue is the business of converting paper from parent rolls to finished goods, namely bathroom tissue, facial tissue, paper towel and napkins. [redacted] The finished paper products manufactured by Global Tissue are sold 1) under Global Tissue's own marks; and/or 2) to retailers as a privately-labeled brand. (Shaoul Decl., ¶¶ 2, 3).

On January 4, 2008, Global Tissue filed an intent-to-use trademark application for the mark QUILTY covering certain goods in Class 16, namely "consumer and industrial paper products, namely facial tissues, napkins, towels and bathroom tissues." In other words, it filed an application for a new mark covering the exact type of products it has and continues to manufacture. Georgia-Pacific notified Global Tissue by letter dated April 17, 2008 that it was objecting to Global Tissue's request to register the mark QUILTY, and would oppose such application if not withdrawn. (Shaoul Decl., ¶ 12) Following publication of the mark on May 20, 2008, Georgia-Pacific filed the present opposition.

Prior to the testimony period, and thus prior to the opportunity for Applicant to present its evidence regarding intent-to-use, Georgia-Pacific brought the present Motion for Summary Judgment alleging that Applicant lacked a *bona fide* intent-to-use the mark QUILTY at the time it filed its application.

B. Material Facts in Dispute

In its moving paper, Georgia-Pacific states that "GTG's 30(b)(6) witness made it absolutely clear that GTG has taken **no** steps to use the QUILTY mark in the United States." Georgia-Pacific then proceeds to quote a selected portion of Mr. Shaoul's deposition transcript in support of its statement. Georgia-Pacific concludes by stating that "[t]his testimony has never been contradicted, rescinded or otherwise called into question." Global Tissue disagrees.

First, as discussed throughout this paper, numerous portions of that same deposition transcript indicate that Global Tissue did take certain steps prior to the filing of the QUILTY application. These steps may not have been the exact steps described in the questions posed in the quoted transcript, but clearly steps were taken by Global Tissue prior to the filing of its application. Georgia-Pacific's statement that this testimony has never been contradicted, rescinded or otherwise called into question simply ignores the other portions of Mr. Shaoul's testimony which contradict this argument. Moreover, the Declarations attached hereto clearly provide evidence of the actual steps taken by Global Tissue prior to the filing of its application, and which demonstrate its bona fide intent to use this mark.

Georgia-Pacific also refers to Global Tissue's answers to certain Requests for Admission as somehow demonstrating a lack of bona fide intent. More particularly, Georgia-Pacific points to Request Nos. 130-132 which reads as follows:

[redacted]

Thus, it appears that Georgia-Pacific is arguing that the because Global Tissue does not have a warehouse full of product "waiting" to be labeled with the QUILTY mark, that somehow it does not have an intent to use that mark on those same products or similar products in the future. As discussed herein, Global Tissue identified certain products on which it intended to use the QUILTY mark. (Shaoul Decl., ¶ 8) Global Tissue's responses to Admission Request Nos. 130 to 133 simply mean that it is not currently manufacturing and warehousing products to be later labeled with the QUILTY mark. The responses do not mean that Global Tissue has not identified product or products on which the mark will be

used. Accordingly, the issue of whether Global Tissue is manufacturing the product, or type of products on which the QUILTY mark is intended to be used, is clearly in dispute.

II. ARGUMENT

A. Summary Judgment is Not Appropriate for the Issue at Hand

Summary judgment is only appropriate where there are no genuine issues of material fact in dispute, thus allowing the case to be resolved as a matter of law. *Fed. R. Civ. P. 56(c)*. The party seeking summary judgment bears the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to a judgment under the applicable law. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 323, 106 S. Ct. 2548, 91 L. Ed. 2d 265 (1986); *Sweats Fashions, Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1796 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

The evidence on summary judgment must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. *Lloyd's Food Products, Inc. v. Eli's Inc., 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); Opryland USA, 23 USPQ2d at 1472.* The Board may not resolve issues of material fact; it may only ascertain whether issues of material fact exist. See *Lloyd's Food Products, 25 USPQ2d at 2029; Olde Tyme Foods, 22 USPQ2d at 1542.*

In view of the evidence set forth in the three Declarations hereto, together with the arguments set forth herein, there can be no doubt but that Applicant had a *bona fide* intent to use the mark QUILTY at the time the application was filed. Inasmuch as the TTAB must view all evidence in the light most favorable to Applicant, and must draw all inferences in favor of Applicant, summary judgment is simply not appropriate for the issue at hand.

B. <u>Global Tissue had a *Bona Fide* Intent to Use the Mark QUILTY at the Time it Filed its Application</u>

[redacted]

[redacted]

[redacted]

[redacted]

[redacted]

[redacted]

[redacted]

[redacted]

Georgia-Pacific cites several decisions of the TTAB in which the Board found that the Applicant lacked an intent to use the mark in question. However, each of those decisions can be distinguished from the case at hand. To begin, Georgia-Pacific relies upon the TTAB's decision in *Research in Motion Ltd. v. NBOR Corp.*, 92 USPQ2D 1926 (TTAB 2009) in support of its argument. However, Georgia-Pacific never discusses the actual facts of such case.

To start, the *RIM* case notes that "a *bona fide* intention to use a mark in commerce is an objective determination based on all the circumstances." *Id.* 1930. In *RIM*, it is crucial to note that the Applicant "did not offer any testimony or evidence regarding its intent." The Opposer specifically argued that there was an absence of evidence, either documentary or otherwise, to support a *bona fide* intent to use at the time of filing. In other words, the Applicant in *RIM* presented no evidence, whatsoever, regarding its intent. Here, because Georgia-Pacific's motion has been brought prior to the testimony period, Applicant did not have an opportunity to present its evidence regarding its intent to use. Thus, it has been forced to present its evidence by way of Declaration in response to Opposer's motion.

Moreover, the Applicant in the *RIM* case had repeatedly filed for the same mark, such applications lapsing for failure to timely file a Statement of Use. In other words, there is evidence that the *RIM* Applicant was pursuing the very type of unwanted conduct which was discussed in the legislative history of the Trademark Law Revision Act. Finally, the Applicant in the *RIM* case had no plans relating to use of the mark, no plans relating to trade channels of prior customers, and no plans for expansion and growth of its product line to be sold under the mark. The evidence set forth in the Declarations attached to Applicant's opposition papers, as well as Mr. Shaoul's testimony during his prior deposition, clearly establish that Applicant had identified a product or products to be used in connection with the QUILTY mark, In sum, the present facts are distinct from the facts in the *RIM* decision.

Next, Georgia-Pacific relies upon the TTAB's decision in *Honda Motor Company v. Winkelman*, 90 USPQ2d 1660 (TTAB 2009) in support of its argument. Georgia-Pacific cites the *Honda* decision for the proposition that "the absence of any documentary evidence regarding an applicant's *bona fide* intention to use a mark in commerce is sufficient to prove that an applicant lacks such intention as required by §1(b) of the Trademark Act." What Georgia-Pacific does not mention in its paper, nor indicate by proper punctuation, is that it conveniently left out the last clause of that quotation – namely – "unless other facts are presented which adequately explain or outweigh way Applicant's failure to provide such documentary evidence." *Id.* at 1662.

As discussed throughout this paper, Applicant has clearly presented other facts which adequately explain and/or outweigh its failure to provide documentary evidence in this proceeding. The facts of the *Honda* decision are also distinct from the facts in the present proceeding. Most importantly, the Applicant in the *Honda* case submitted declarations prepared by its counsel – rather than by Applicant himself. Moreover, the declarations lacked any objective facts in support of applicant's intent. Finally, there was no other testimony to support Applicant's argument regarding its *bona fide* intent to use the mark.

Georgia-Pacific further relies upon the TTAB's decision in *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581 (TTAB 2008) to support of its argument. This decision does note that the "burden shifts to Applicant to come forward with evidence which would adequately explain or outweigh his failure to provide such documentary evidence," *Id.* at 1587, something which Global Tissue has clearly done in this response. As with the other cases, the facts in the *Red Sox* case are distinct from the facts in the present proceeding.

Most importantly, the Board notes that the Applicant "submitted no evidence, documentary or otherwise, to support or having a bearing on his claimed *bona fide* intention to use the mark when the application was filed." In other words, in addition to lacking documentary evidence, the Applicant in the *Red Sox* decision failed to submit any other type of evidence, e.g., testimony evidence. Further, the Opposer in the *Red Sox* decision argued that the applicant lacked the "capacity to conduct a genuine commercial enterprise involving the manufacture and distribution of clothing." The Board clearly considered this lack of

manufacturing capacity to be a relevant factor in its decision. As discussed herein, Global Tissue is in the business of manufacturing the very same products identified in the opposed application. In sum, the facts in the *Red Sox* case are distinct from the facts in the present proceeding.

Finally, Georgia-Pacific relies upon the TTAB's decision in *Padres L.P. v. Munoz*, Opp. No. 91187852, 2010 WL 1720596 (TTAB April 15, 2010) in support of its argument. The *Munoz* case notes that to raise a genuine issue of material fact, "applicant must point to specific evidence in the summary judgment record that he might present at trial to explain or outweighs his lack of documentary evidence of bona *fide* intent, or which would otherwise establish that he the requisite bona fide intent to use the mark when he filed the application." The three Declarations attached to Global Tissue's opposition papers, as well as the prior deposition testimony of Mr. Shaoul, clearly provide an explanation for the lack of documentary evidence, as well as establishing the requisite *bona fide* intent to the use mark when the application was filed.

Turning to the facts of the *Munoz* decision, the Board relied heavily upon the fact that "applicant has not shown that he is in the business of or capable of marketing the clothing identified in his application, a fact which weighs against a finding a bona fide intent." *Id.* (citing *Honda Motors v. Winkelman*, 90 USPQ 1660 (TTAB 2009) and *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1587 (TTAB 2008) (no *bona fide* intent found because there was no relevant business established)). See also *Wet Seal Inc. v. FD Management Inc.*, USPQ2d 1629, 1643 (TTAB 2007) (finding capacity to market and/or manufacture shampoo and color products, and having produced them in the past under different marks, would tend to affirmatively rebut any claim by opposer regarding applicant's intent). Here, there can be no doubt but that Global Tissue is in the business of manufacturing the specific products specified in its pending application, namely facial tissues, napkins, towels and bathroom tissues. In sum, the facts of the *Munoz* case are distinct from the facts at hand.

Mr. Shaoul's deposition transcript is 228 pages long. Georgia-Pacific has selectively quoted portions of that lengthy transcript throughout its moving paper. It conveniently fails

to cite those portions of the transcript which demonstrate applicant's clear intent to use its QUILTY mark. Moreover, Georgia-Pacific's paper focuses almost exclusively on the lack of documentation provided by Global Tissue. [redacted] Accordingly, the types of documents which may be present in other companies are simply not part of Global Tissue's day to day business practices.

It is clear from the case law that a lack of documents is not dispositive. More particularly, the lack of documentary evidence can be overcome by oral testimony explaining the lack of such documents and/or establishing a *bona fide* intent to use. The Declarations and attorney emails attached hereto set forth such substantial and corroborating evidence, and establish that applicant had a *bona fide* intent to use at the time the QUILTY mark was filed.

C. <u>The Senate Judiciary Report Supports a Finding of a bona fide Intent to Use</u>

The Senate Judiciary Committee report discussing the issue of bona fide intent to use gives an illustrative list of circumstances that "may cast doubt on the bona fide nature of the intent or even disprove it entirely":[1]

1. *One Mark-Many Products:* The filing of numerous ITU applications for the same mark for many more new products than are seriously intended;
2. *One Product-Many Marks:* Numerous ITU applications for a variety of marks to be used on one new product;
3. *Reserving Many Descriptive Terms*: Numerous ITU applications for marks consisting of or including descriptive terms describing some important characteristic of a new product;
4. *Many Re-filings:* Numerous ITU applications to replace applications which have lapsed because no timely statement of use was filed;
5. *Many Marks-Many Products:* An "excessive number" of ITU applications in relation to the number of products the applicant is

[1] Senate Judiciary Committee Report on S. 1883, S. Rep. No. 100-515, pp. 23-24 (Sept. 15, 1988).

likely to introduce during the statutory period under the applied for marks;

6. *Vague Description of Goods or Services:* Applications unreasonably lacking in specificity in describing the proposed goods.

None of the mentioned factors apply to the case at hand. In other words, Global Tissue's business practices are consistent with the business practices envisioned by the Senate Judiciary Committee discussing the issue of bona fide intent to use.

III. CONCLUSION

In view of the evidence set forth in the Declarations attached hereto, as well as the prior deposition testimony of Philip Shaoul, Applicant has certainly demonstrated that it had the requisite *bona fide* intent to use the mark QUILTY at the time it filed its application. Accordingly, Georgia-Pacific's Motion for Summary Judgment should be denied.

Dated: February 10, 2011

Respectfully submitted,

Charles R. Hoffmann
R. Glenn Schroeder

Hoffmann & Baron, LLP
6900 Jericho Turnpike
Syosset, New York 11791
Telephone: (516) 822-3550
Facsimile: (516) 822-3582
choffmann@hoffmannbaron.com
gschroeder@hoffmannbaron.com
Attorneys for Applicant
Global Tissue Group, Inc

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this date, February 10, 2011, a copy of the foregoing APPLICANT'S OPPOSITION TO OPPOSER'S MOTION FOR SUMMARY JUDGEMENT was served upon the Opposer, by email and by U.S. mail, to Opposer's current identified counsel, as set forth below:

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

R. Glenn Schroeder