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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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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

REDACTED

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**OPPOSER’S REPLY BRIEF IN SUPPORT OF ITS  
MOTION FOR SUMMARY JUDGMENT**

Opposer Georgia-Pacific (“Georgia-Pacific”) submits the following Reply Brief in Support of its Motion for Summary Judgment.

**I. INTRODUCTION**

Georgia-Pacific is entitled to summary judgment because GTG has failed to submit any objective, corroborated evidence of a *bona fide* intent to use the QUILTY mark at the time it filed its application. Indeed, GTG’s opposition readily concedes that it has no documentary evidence demonstrating a *bona fide* intent. This lack of documentary evidence constitutes objective proof that GTG lacks a *bona fide* intention to use its mark in commerce and, to avoid summary judgment, GTG must come forward with evidence that adequately explains or outweighs its failure to provide such documentary evidence.

GTG has not met this burden. Its only “evidence” consists of three self-serving declarations containing uncorroborated, subjective statements that (i) contradict prior deposition testimony or (ii) provide new information not previously disclosed in discovery. Georgia-Pacific is filing a Motion to Strike the Declarations; but even if the Board considers this improper evidence, the Declarations do not raise an issue of material fact as to GTG’s *bona fide* intent to

use the QUILTY mark at the time the application was filed. At best, the declarations merely suggest that GTG had a vague, inchoate plan regarding the QUILTY mark and that it filed a trademark application to reserve a right in the mark. Under the Board's precedent, such a plan does not evidence a *bona fide* intent to use a trademark. Because no disputed issues of fact exist, the Board should grant Georgia-Pacific's motion for summary judgment.

**II. GTG'S WITNESS DECLARATIONS CONTRADICT PRIOR SWORN STATEMENTS.**

The only evidence GTG proffers in response to Georgia-Pacific's motion for summary judgment are the declarations of Mr. Shaoul, Mr. David, and Mr. Elnekaveh. As discussed in Georgia-Pacific's Motion to Strike, the declarations are inadmissible on summary judgment because they contain new evidence that Global Tissue failed to produce in discovery. In the unlikely event the Board does not strike the declarations, however, the declarations still do not create an issue of material fact because they are inconsistent with sworn statements GTG made during discovery, [REDACTED]



[REDACTED]

[REDACTED]

[REDACTED]

**III. GTG’S CONTRADICTORY DECLARATIONS DO NOT CREATE AN ISSUE OF FACT SUFFICIENT TO DEFEAT SUMMARY JUDGMENT.**

Due to the blatant inconsistencies between the new witness declarations and previous deposition testimony, the Board should not consider the declarations as evidence in opposition to Georgia-Pacific’s summary judgment motion. The Federal Circuit held:

A party cannot create an issue of fact by supplying an affidavit contradicting his prior deposition testimony, without explaining the contradiction or attempting to resolve the disparity. . . . Where, as here, a party has been examined extensively at deposition and then seeks to create an issue of fact through a later, inconsistent declaration, he has the duty to provide a satisfactory explanation for the discrepancy at the time the declaration is filed. To allow him to preclude summary judgment simply by contradicting his own prior statements would seriously impair the utility of Federal Rule of Civil Procedure 56.

*Sinskey v. Pharmacia Ophthalmics Inc.*, 982 F.2d 494, 498 (Fed. Cir. 1992), *abrogated in part on other grounds*, *Pfaff v. Wells Elecs.*, 525 U.S. 55, 67-68 (1998) (affirming grant of summary judgment and holding that the trial court properly disregarded contradictory declaration in assessing the existence of a genuine issue of fact).

The Board has rejected declarations like those offered by GTG here, finding that inconsistencies with prior testimony do not create issues of fact sufficient to avoid summary judgment. For example, the applicant in *Kabbalah Centre International, Inc. v. Kabbalah Diet, LLC*, Opp. No. 91171862, 2009 WL 1017286 (T.T.A.B. Mar. 25, 2009), failed to produce any documentary evidence in discovery showing an objective *bona fide* intent to use the mark, and

the applicant's president conceded during his deposition that no specific planning or action was taken to use or develop the subject mark. *Id.*, at \*1. When the president later submitted a declaration in response to a summary judgment motion claiming that he conducted research to develop concepts for the product, the Board rejected the declaration testimony and granted summary judgment. *Id.*, at \*4. *See also Montblanc-Simplo GmbH v. United Brands Int'l, Inc.*, Opp. No. 91185637, 2009 WL 4086591, at \*7 (T.T.A.B. Sept. 29, 2009) (rejecting declaration of applicant that he had taken steps to use the mark when he testified in his discovery deposition that he had "nothing in writing" showing any intended use); *Universal City Studios, LLP v. Valen Brost*, Opp. No. 91153683, 2004 WL 1957207, at \*2 (T.T.A.B. Aug. 18, 2004) (disregarding declaration claiming that the applicant shipped goods bearing the mark at issue where the declaration directly contradicted the witness's prior testimony).

Likewise, GTG cannot manufacture issues of fact in an attempt to defeat summary judgment by offering witness declarations that are contradicted by prior testimony. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Due to their numerous inconsistencies, the declarations are not credible evidence and cannot create issues of fact precluding summary judgment.

**IV. GTG’S PROFERRED EVIDENCE FAILS TO SHOW THAT IT HAD THE REQUISITE *BONA FIDE* INTENT TO USE THE QUILTY MARK IN COMMERCE.**

Even if the Board does consider GTG’s declarations, this evidence is insufficient to raise an issue of material fact regarding GTG’s *bona fide* intent to use the QUILTY mark. The record contains no documentary evidence regarding GTG’s purported intention to use the QUILTY mark, “which establishes, prima facie, that [GTG] lacked the requisite bona fide intent when [it] filed [its] application.” *Padres, LP v. Munoz*, Opp. No. 91187852, 2010 WL 1720596, at \*3 (T.T.A.B. Apr. 15, 2010). The evidence demonstrating the absence of any documentary evidence regarding GTG’s *bona fide* intention to use the QUILTY mark is set forth in detail in Georgia-Pacific’s opening brief. (See Dkt. 50, at 3-5.) GTG does not dispute any of this evidence in its response.

To raise a genuine issue of material fact to counter Georgia-Pacific’s prima facie showing, GTG must “point to specific evidence in the summary judgment record that [it] might present at trial to explain or outweigh [its] lack of documentary evidence of bona fide intent, or which would otherwise establish that [it] had the requisite bona fide intent to use the mark when [it] filed the application.” *Id.*<sup>1</sup> Evidence demonstrating intent must be objectively corroborated; “mere statements of subjective intent do not suffice to establish bona fide intent.” *Id.*

Evidence bearing on bona fide intent is “objective” in the sense that it is evidence in the form of real life facts and by the actions of the applicant, not by the applicant’s testimony as to its subjective state of mind. That is, Congress did not

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<sup>1</sup> GTG’s contention that “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” is simply wrong. GTG still bears the burden on summary judgment of pointing to evidence **in the record** that creates a genuine issue of fact regarding its *bona fide* intent to use at the time it filed its application. See *Padres*, 2010 WL 1720596, at \*3. [REDACTED]

intend the issue to be resolved simply by an officer of applicant later testifying, “Yes, indeed, at the time we filed that application, I did truly intend to use the mark at some time in the future.”

*Research In Motion Ltd. v. NBOR Corp.*, 92 U.S.P.Q.2d 1926, 1931 (T.T.A.B. 2009) (internal citation omitted).

GTG has clearly not met this burden. Even assuming the witness declarations are credible and admissible evidence, they only establish that [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] But, these are steps that **every** trademark applicant follows when applying for registration of a mark, and thus are not adequate to establish that GTG objectively had a *bona fide* intent to use the mark. *See SmithKline Beecham Corp. v. Omnisource DDS, LLC*, 97 U.S.P.Q.2d 1300, 1304 (T.T.A.B. 2010) (“If the filing and prosecution of a trademark application constituted a bona fide intent to use a mark, then in effect, lack of a bona fide intent to use would never be a ground for opposition or cancellation.”).

GTG cites no authority for the proposition that its self-serving, uncorroborated declaration testimony is sufficient to demonstrate a *bona fide* intent. Rather, the Board’s precedent is clear that GTG’s evidence is insufficient. In *L.C. Licensing, Inc. v. Berman*, the Board considered an opposition to an application to register the ENYCE mark for use in connection with several custom automotive accessories. 86 U.S.P.Q.2d 1883, 1885 (T.T.A.B. 2008). The opposer moved for summary judgment based in part on an assertion that applicant lacked a *bona fide* intent to use the mark, pointing out that applicant had not identified any documents supporting such an intent. *Id.* at 1891-92. In response, applicant submitted

uncorroborated testimony stating that he intended to use the mark on shift knobs, but the Board found the testimony insufficient to provide credible evidence of a *bona fide* intent to use the mark and sustained the opposition. *Id.* See also *Padres*, 2010 WL 1720596 at \*2 (applicant’s declaration stating that he had not “published any of his thoughts on how he would proceed with marketing and selling the products covered by his application” and that he “made plans on how [he] would proceed if granted the mark, but have not put those thoughts down on paper” was not sufficient to avoid summary judgment); *SmithKline*, 97 U.S.P.Q.2d at 1302-1303 (applicant’s testimony that he considered the type of goods for the mark and potential customers was not sufficient to overcome lack of corroborating documentary evidence).

[REDACTED]

GTG’s assertion that it has no corroborating evidence because it wanted to see what happened in this Board proceeding does not suffice. Actions taken after the opposition was filed are irrelevant to the inquiry of whether GTG had a *bona fide* intent to use the mark **at the time it filed the application**. In *L.C. Licensing*, the applicant responded to the opposer’s assertion that applicant lacked a *bona fide* intent to use the mark by relying on testimony stating that applicant decided to forgo planning for the use of the mark until after the opposition was resolved. 86 U.S.P.Q.2d at 1891-92. The Board rejected this evidence, finding it insufficient to outweigh the lack of documentary evidence supporting applicant’s *bona fide* intent to use the mark, and noting

that the testimony did “not explain his failure to have any documents whatsoever at the time the application was filed that showed an intent to use the mark.” *See also Saul Zaentz Co. v. Bumb*, 95 U.S.P.Q.2d 1723, 1729 (T.T.A.B. 2010) (applicant’s receipt of a cease and desist letter after filing date of application “does not help to establish that applicant had a bona fide intent to use the mark when he filed the application”); *Padres*, 2010 WL 1720596, at \*3 (“[A]pplicant’s statement that he lacks documentary evidence because he wanted to avoid a possible infringement action does not establish that he had a bona fide intent to use the mark when he filed the application.”).

Likewise, no genuine issues of fact exist regarding GTG’s lack of a *bona fide* intent. GTG’s uncorroborated declarations—even if accepted by the Board—“establish[] that [it] had nothing more than a vague plan for, or conception of, how [it] would actually use [the QUILTY] mark in commerce,” and that it filed a trademark application “merely to reserve a right in the mark.” *See Saul Zaentz Co.*, 95 U.S.P.Q.2d at 1729. Consistent with the Board’s clear precedent requiring “objective” evidence, and GTG’s failure to submit any such evidence in the record, the Board should find as a matter of law that GTG did not have a *bona fide* intent to use the mark at the time it filed the application.

## V. CONCLUSION

Based on the foregoing, Georgia-Pacific respectfully requests that the Board grant its motion for summary judgment and sustain the Opposition.

Dated: March 2, 2011.

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that on this date, March 2, 2011, a copy of this Reply Brief in Support of Georgia-Pacific's Motion for Summary Judgment has been served upon Applicant, by email and by U.S. mail, to Applicant's current identified counsel, as set forth below:

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