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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

**REPLY IN SUPPORT OF  
OPPOSER'S MOTION TO STRIKE**

Pursuant to 37 C.F.R. 2.127(a) and T.B.M.P § 502.02(b), Opposer Georgia-Pacific submits this Reply Brief in Support of its Motion to Strike Witness Declarations.

**I. INTRODUCTION**

Global Tissue Group (“GTG”) deliberately withheld evidence from Georgia-Pacific during discovery, even going so far as willfully ignoring a Board Order requiring disclosure of that evidence. GTG should not be permitted to rely on the previously-withheld evidence to avoid summary judgment. The Board should not reward GTG’s abuse of the litigation process and should exclude from consideration all evidence not properly disclosed during discovery.

**II. ARGUMENT**

**A. GTG’s Witness Declarations Are Inadmissible.**

The record is clear that Georgia-Pacific requested that GTG disclose information concerning its adoption of the QUILTY mark and consideration of any alternative trademarks. In response to Georgia-Pacific’s document requests and deposition questions, GTG repeatedly and consciously refused to provide this information. Even after the Board granted Georgia-

Pacific's motion to compel, and Georgia-Pacific was forced to depose GTG's corporate designee a second time, GTG deliberately concealed this information.

GTG's contention that Georgia-Pacific has not been harmed because the testimony period is not yet open is misplaced. All fact discovery closed in this proceeding in May 2010, nearly six months before Georgia-Pacific filed its motion for summary judgment. The fact that the Board has agreed to reopen expert discovery if summary judgment is not entered (Dkt. 51, at 3) does not cure GTG's failure to disclose fact information during the fact discovery period. GTG's *mea culpa* explanations and its suggestion that the Board should simply reopen all discovery is improper under the Board's Rules, its precedent, and the fair and equitable administration of justice in Board proceedings. In short, GTG should not be permitted to benefit from violating Board orders and withholding information.

**1. GTG Previously Withheld Evidence Concerning Consideration of Alternatives to the QUILTY Mark.**

The factual record does not support GTG's outrageous claim that it understood Georgia-Pacific's discovery requests as "asking whether [it] had more than one mark in mind for testing purposes" *after* it had already selected the QUILTY mark (Dkt. 59, at 4, 7). None of Georgia-Pacific's discovery requests sought information about marks for "testing purposes." Its interrogatories clearly asked for "all words considered as possible alternatives for the QUILTY mark." (Marino Dec. Ex. C, at 2-3).<sup>1</sup> GTG did not object to the interrogatory as vague or unclear, and it unequivocally responded that "no other words were considered as possible alternatives for the QUILTY mark." (*Id.*)

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<sup>1</sup> The Marino Declaration is attached to Georgia-Pacific's opening brief. (Dkt. 57.)



[REDACTED]

[REDACTED]

[REDACTED]

(Marino Dec. Ex. E, at 272-73.)

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

(*Id.* at 275-81.)

[REDACTED]

[REDACTED]



(T.T.A.B. Sept. 14, 1988) (granting motion to strike affidavit). GTG clearly was in possession of emails with its counsel regarding other marks that the company considered in addition to the QUILTY marks. (Shaoul Dec. ¶ 13 & Exs. 7-10.) Because GTG failed to disclose this information, and decided not to produce these documents on the basis of privilege, it should not be permitted to “sandbag” Georgia-Pacific at summary judgment with this new evidence that it had a duty to disclose it during discovery.

### 3. GTG Previously Denied Any Involvement By Elnekaveh & David.

The declarations of Mr. Elnekaveh and Mr. David are inadmissible because they contain previously undisclosed information regarding GTG’s selection and adoption of the QUILTY mark.<sup>2</sup> Specifically, GTG never disclosed that Mr. Shaoul discussed potential marks with Mr. Elnekaveh or Mr. David or that they made a joint decision to adopt the QUILTY mark. (*See* Shaoul Dec. ¶¶ 9-11; David Dec. ¶¶ 3-6; Elnekaveh Dec. ¶¶ 3-6.) Throughout discovery, GTG represented that Mr. Shaoul was the only individual involved with the selection of the QUILTY mark. (*See* Marino Dec. Ex C, at 2-3, 6; Ex. D, at 72-73.) Moreover, Mr. Elnekaveh’s testimony that he reviewed a “list” of proposed marks (Elnekaveh Dec. ¶ 5) is [REDACTED] (Marino Dec. Ex. E at 278-79.) As the Board previously warned GTG: “[I]n the event that a party withholds proper discoverable matter in the course of the discovery depositions, the party will be precluded, during trial, from adducing or relying on any such information that it withheld but should have produced.” (Dkt. 22, at 11.)

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<sup>2</sup> As noted in Georgia-Pacific’s opening brief, Mr. David’s declaration should be excluded for the additional reason that GTG failed to disclose him during discovery. GTG has been aware that Georgia-Pacific intended to assert that GTG lacked a *bona fide* intent to use the QUILTY mark since Georgia-Pacific filed its amended notice of opposition on September 9, 2009. (Dkt. 23.) At that time, GTG had a duty to supplement its Rule 26 disclosures by identifying all witnesses that it may use to support its defenses to this claim. Fed. R. Civ. P. 26(e)(1).

**B. Georgia-Pacific is Entitled to Summary Judgment Even if the Board does not Strike GTG’s Witness Declarations.<sup>3</sup>**

To survive summary judgment, GTG bears the burden of producing evidence *admissible at trial* showing the existence of a genuine issue of material fact as to its *bona fide* intent to use the QUILTY mark. *Montblanc-Simplo GmbH v. United Brands Int’l, Inc.*, Opp. No. 91185637, 2009 WL 4086591, at \*5 (T.T.A.B. Sept. 29, 2009) (non-movant “must designate specific portions of the record or produce additional evidence showing the existence of a genuine issue of material fact for trial”). Just as GTG cannot present the previously-withheld evidence at trial, the Board cannot consider it at the summary-judgment stage. *See Presto Prods.*, 1988 WL 252340, at \*4 n. 5 (refusing to consider evidence in response to summary judgment motion that was not produced during discovery).

Georgia-Pacific moved to exclude GTG’s witness declarations because they are both inconsistent with prior sworn statements and contain new information not disclosed in discovery, and not because they raise genuine issues of material fact sufficient to avoid summary judgment. Even if the Board considers GTG’s inadmissible declarations, it should still find as a matter of law that GTG lacked a *bona fide* intent to use the QUILTY mark at the time it filed the application.

That GTG selected a mark out of a number of alternatives and applied to register the mark is not enough to avoid summary judgment. Indeed, there are numerous cases in which the

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<sup>3</sup> The Board Rules are clear that surreply briefs are not permitted. 37 C.F.R. § 2.127(a); *Karsten Mfg. Corp. v. Editoy AG*, 79 U.S.P.Q.2d 1783, 1785 n. 3 (T.T.A.B. 2006) (refusing to consider arguments in applicant’s brief “because they [were] essentially in the nature of a surreply to opposer’s motion for summary judgment”). Nevertheless, approximately half of GTG’s Opposition to the Motion to Strike is nothing more than a surreply on the pending Motion for Summary Judgment. (Dkt. 59, 2-6.) Section B of GTG’s Opposition (“Genuine Issues of Material Fact Exist”) is improper and should be ignored. Georgia-Pacific includes the following arguments in the event the Board does not ignore that section of GTG’s Opposition.

Board has found that the applicant failed to demonstrate a *bona fide* intent despite evidence similar to that offered by GTG. *See, e.g., SmithKline Beecham Corp. v. Omnisource DDS, LLC*, 97 U.S.P.Q.2d 1300, 1302-03 (T.T.A.B. 2010) (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); *Padres L.P. v. Munoz*, No. 91187852, 2010 WL 1720596, at \*2 (T.T.A.B. Apr. 15, 2010) (applicant’s vague assertions that he “made plans on how [he] would proceed if granted the mark” without documentary support not sufficient to find genuine issue of fact as to applicant’s *bona fide* intent to use); *D.C. Comics and Marvel Characters, Inc. v. Silver*, No. 91176744, 2009 WL 4085622, at \*6 (T.T.A.B. Aug. 21, 2009) (granting summary judgment where “applicant’s evidence indicates, at most, that applicant has considered use of the involved mark for the identified goods and has confidence in his ability to bring such goods to market at some point in the future”).

Under the Board’s precedent, an applicant cannot simply say, “we intend to use this mark on this kind of product,” and survive summary judgment. This is particularly the case when—as here—the applicant’s evidence conflicts with disclosures during discovery. *See, e.g., Montblanc-Simplo*, 2009 WL 4086591 at \*5, 7 (granting summary judgment where applicant submitted a declaration averring that it “has taken steps and continues to take steps...pending resolution of this proceeding” where he testified in his discovery deposition that he had “nothing in writing” showing any intended use of the mark); *Kabbalah Centre Int’l, Inc. v. Kabbalah Diet, LLC*, Opp. No. 91171862, 2009 WL 1017286, at \*4 (T.T.A.B. Mar. 25, 2009) (rejecting the declaration of applicant’s president stating that he conducted research for the product at issue where he conceded in his deposition that no specific planning or action was taken to use or develop the subject mark).

Even with GTG's witness declarations, the record is completely devoid of evidence the Board considers probative of a *bona fide* intent to use, "such as product design efforts, manufacturing efforts, graphic design efforts, test marketing, correspondence with prospective licenses, preparation of marketing plans or business plans, creation of labels, marketing or promotional materials, and the like." *Research In Motion Ltd. v. NBOR Corp.*, 92 U.S.P.Q.2d 1926, 1931 (T.T.A.B. 2009); *accord SmithKline*, 97 U.S.P.Q.2d at 1304. Thus, the evidence in the record shows as a matter of law that GTG lacked the requisite *bona fide* intent to use the QUILTY mark at the time it filed the application, the Board should grant summary judgment.

### **III. CONCLUSION**

Because GTG failed to disclose the information contained in GTG's witness declarations during discovery, the Board should grant Georgia-Pacific's Motion to Strike and preclude GTG from relying on this evidence in opposition to the pending Motion for Summary Judgment. Even if the Board considers the declarations, however, summary judgment is still warranted, and the Opposition should be sustained.

Dated: March 31, 2011

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that on this date, March 31, 2011, a copy of this Reply Brief in Support of Opposer's Motion to Strike Witness Declarations 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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