

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

jk

Mailed: June 10, 2011

Opposition No. 91184529

Georgia-Pacific Consumer
Products LP

v.

Global Tissue Group, Inc.

Before Walters, Bergsman and Wolfson,
Administrative Trademark Judges.

By the Board:

This proceeding is before the Board for consideration of opposer's 1) motion (filed January 6, 2011) for summary judgment, and 2) motion (filed March 2, 2011) to strike. The motions have been fully briefed.¹

Applicant seeks to register the mark QUILTY (standard characters) for "consumer and industrial paper products,

¹ On all briefs on both motions, the parties filed copies under seal along with redacted (public) copies. Substantial portions of the evidence and arguments going to the core issue to be determined on summary judgment is designated as confidential. Consequently, we refer to certain evidence by general reference, as appropriate.

namely, facial tissues, napkins, towels and bathroom tissues" in International Class 16.²

Opposer opposes registration, asserting priority and likelihood of confusion, dilution, and that applicant had no bona fide intent to use the mark in commerce on the identified goods as of the filing date of the application. It asserts ownership of a family of marks comprised of or incorporating the term QUILT for bathroom tissue and facial tissue.

Opposer seeks summary judgment on its claim that applicant lacked a bona fide intent to use the mark,³ and submitted the evidence set forth below:

² Application Serial No. 77364616, filed January 4, 2008, asserting a bona fide intent to use the mark in commerce pursuant to Trademark Act Section 1(b).

³ In submitting their briefs on the case, the parties should be mindful to submit under seal only truly confidential portions thereof. See Trademark Rule 2.126(c); TBMP §§ 703.01(p) and 801.03 (3d ed. 2011).

The Board notes that, on summary judgment, neither party consistently delineated the truly confidential wording in the redacted (public) copies of their briefs, and some of the redacted matters are not confidential. For example, in its summary judgment motion, there is no apparent reason for opposer to have redacted, at page 3, statements setting forth the filing date, mark, identified goods, and certain declaration statements pertaining to non-confidential data concerning applicant's application; additionally, opposer redacted non-confidential arguments that merely summarize portions of its confidential exhibit 11 (declaration of Philip Shaoul). For its part, applicant redacted both opposer's Requests for Admission Nos. 130-133 as well as its responses thereto, after opposer had submitted the same in unredacted form. Applicant submitted under seal all three declarations on which it relies, and, at pages 5-9 of its brief, nearly the entirety of its arguments regarding and own summations thereof.

Board proceedings are designed to be publicly available and the improper designation of materials as confidential thwarts that intention. It is more difficult to make findings of fact, apply the facts to the law, and write decisions when the facts may not

- 1) Applicant's responses to Opposer's First Request for Production of Documents and Things Nos. 11, 15, 19-22, and 31 (opposer's exhibit 12), in support of opposer's argument that applicant responded that it has no responsive, unprivileged documents to produce that pertain to plans to use the mark;
- 2) Applicant's answers to Opposer's First Request for Admission Nos. 130-132 (opposer's exhibit 13), in support of opposer's argument that applicant has not advertised or manufactured products on which it intends to use the QUILTY mark; and
- 3) Portions of the discovery deposition of applicant's Fed. R. Civ. P. 30(b)(6) corporate designee, Philip Shaoul (opposer's exhibit 11, filed under seal), in support of its argument that applicant has no documents pertaining to sales or shipments, advertising, or customers.

With its opposition to the motion, applicant submitted the declarations of three of its officers. The declaration of its designee, Philip Shaoul, is offered to attest to applicant's internal procedure for identifying, reviewing and selecting

be discussed. The Board needs to be able to discuss the evidence of record, unless there is an overriding need for confidentiality, so that the parties and a reviewing court will know the basis for the Board's decisions. Accordingly, the parties are now advised that further failure to limit the designation of confidential testimony and evidence to truly confidential testimony and evidence will result in the Board disallowing the confidential designation and making all of the testimony and evidence public.

trademarks for its products, and includes descriptions of face-to-face meetings relevant to the process undertaken to select the mark in October of 2007, excerpts from Mr. Shaoul's deposition pertaining to questions regarding market testing, product research and market surveys, and attached copies of emails from 2007. The declaration of Daniel David is offered to further explain applicant's usual practice in choosing a trademark. The declaration of Freydoun Meir Elnekaveh is offered to attest to a process used "in October to November of 2007" (declaration, p. 2) to manufacture and select a name for certain identified products.

Opposer's motion to strike

Opposer moves to strike the three declarations submitted by applicant. Regarding the Shaoul declaration, opposer contends that applicant should have produced, in response to opposer's document requests, copies of emails attached to the declaration, asserting that they are responsive to its Document Requests 2, 4 and 5, which sought documents pertaining to the creation, selection, approval and/or modification of the QUILTY mark, but in response to which applicant asserted privilege and confidentiality, stated that it would produce non-privileged responsive documents, but did not produce during discovery. Opposer also asserts that the declaration is inconsistent with applicant's response to an interrogatory and with its

deposition, wherein applicant responded that no other marks were considered.

Opposer seeks to strike Mr. Elnekaveh's declaration on the basis that applicant identified only Mr. Shaoul in its initial disclosures, and not Mr. Elnekaveh, as an individual with knowledge relevant to the selection and adoption of the mark, and that Mr. Elnekaveh testified during his deposition that he was not involved in the selection of the mark. Finally, opposer seeks to strike Mr. David's declaration on the basis that applicant never identified him as a potential witness.

For its part, applicant argues, *inter alia*, that the Shaoul declaration is not inconsistent with statements he made in his deposition because there was "confusion" in opposer's line of questioning regarding applicant's consideration of alternative marks, and because applicant accurately identified Mr. Shaoul as the person responsible for selecting the mark. Regarding the emails attached to the declaration, applicant asserts that it had already identified some of the privileged emails in its privilege log, and that the other emails were only recently discovered in preparing the summary judgment response.

Applicant argues that Mr. Elnekaveh's declaration is not inconsistent with the testimony he gave opposer because his testimony "that he was not involved in the selection of the QUILTY mark" (applicant's brief, p. 8) is and remains true

inasmuch as Mr. Elnekaveh, himself, was not involved in said selection decision. Finally, applicant argues that it had no obligation to disclose Mr. David because it only needed to disclose those who it may use to support its claims to defenses, and that "at the time (applicant) prepared its initial disclosures, it was unaware that (opposer) would be filing the present Summary Judgment Motion" (applicant's brief, p. 9).

The Board has previously considered the application of the preclusion sanction of Fed. R. Civ. P. 37(c)(1). In an earlier decision, the Board denied summary judgment, finding that a genuine issue of material fact as to bona fide intent to use had been raised by an applicant's declaration asserting facts and documents that it had not furnished during discovery. *See Vignette Corp. v. Marino*, 77 USPQ2d 1408, 1410-1411 (TTAB 2005). In that case, the Board found it unduly harsh to impose the preclusion sanction of Fed. R. Civ. P. 37(c)(1), given that the applicant had not absolutely refused to provide the information, and given that discovery responses may be supplemented at any time, including during trial or after receipt of a summary judgment motion. *Id.* The Board distinguished the facts in *Presto Products, Inc. v. Nice Pak Products, Inc.*, 9 USPQ2d 1895, 1896 n.5 (TTAB 1988), wherein the applicant had unequivocally refused to provide the information sought and

stated that it would not be provided, from the facts in *Vignette Corp.*, where because the applicant had not refused to provide the information sought, the Board held that it would be "unfair to foreclose applicant from the opportunity to amplify the assertions made in his previous discovery responses in order to defend against opposer's motion for summary judgment." *Vignette Corp. v. Marino*, 77 USPQ2d at 1411.

Here, although applicant could have been more forthcoming during discovery with the type of detailed information and documents that it produced in response to the summary judgment motion regarding selection of the QUILTY mark and other internal company matters, and could have earlier sought clarification of written requests or lines of questioning that it found to be confusing, applicant did not unequivocally refuse to provide the information. Thus, as in *Vignette Corp.*, we find that it would be unduly harsh to bar declarations that applicant has provided in an effort to demonstrate that a genuine dispute exists with respect to the core factual issue of whether it had, on the filing date, an intent to use the QUILTY mark.

With respect to opposer's motion to strike the Elnekaveh and David declarations (filed under seal) based on applicant's initial disclosures, which identify only Mr. Shaoul and state that applicant "is not currently aware of

other individuals who have discoverable non-expert information" (Marino Declaration, Exh. G, p. 2), for the purpose of summary judgment, we consider the declarations. To the extent that the three declarations attest to communications that took place among the three declarants, the Elnekaveh and David declarations are redundant of the Shaoul declaration, which we have considered. Moreover, although applicant's initial disclosures did not identify Mr. Elnekaveh, he was, nevertheless, deposed by opposer during discovery, and opposer's characterization, at page 6 of its motion to strike, of a portion of Mr. Elnekaveh's deposition testimony with respect to his involvement in the selection of the mark is inconsistent when compared to the transcript.

In view of the circumstances, opposer's motion to strike is denied.

Notwithstanding, the evidentiary advisories that the Board provided in *Vignette Corp. v. Marino* apply equally here. That is, applicant has an affirmative and continuing duty to supplement its discovery responses under Fed. R. Civ. P. 26(e)(1), and, at trial, will be precluded from relying on information or documents that were requested in discovery but not provided by way of supplementation, including information or documents provided in the declarations on which it relies on summary judgment. In

appropriate cases, the Board imposes the preclusion sanction allowed under Fed. R. Civ. P. 37(c).

Furthermore, the Board may impose a duty to supplement discovery responses or disclosures. See TBMP § 408.03 (3d ed. 2011). The information and documents attached to the three declarations on which applicant relies are not evidence of record in this proceeding. Consequently, applicant is directed to promptly supplement its prior-served responses to opposer's written discovery requests, as well as its initial disclosures, relevant to and consistent with the information and documents that applicant has disclosed in connection with defending the summary judgment motion. See Fed. R. Civ. P. 26(e); TBMP § 408.03 (3d ed. 2011).

Opposer's motion for summary judgment

Summary judgment is appropriate where the movant shows that there is no genuine dispute as to any material fact and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). A party asserting that a fact cannot be or is genuinely disputed must support its assertion by either 1) citing to particular parts of materials in the record, or 2) showing that the materials cited do not establish the absence or presence of a genuine dispute, or that an adverse party cannot produce admissible evidence to support the fact. Fed. R. Civ. P. 56(c). As the movant, opposer

carries the burden of proof. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 323-24 (1986). In deciding the motion, the function of the Board is not to try issues of fact, but to determine if there are any genuine disputes of material fact to be tried. See TBMP § 528.01 (3d ed. 2011), and cases cited therein.

To prevail on summary judgment, opposer must prove that there is no genuine dispute that 1) it has standing, and 2) applicant had no bona fide intent to use QUILTY on the identified goods as of the filing date of the application.

After reviewing the parties' arguments and evidence, and viewing the evidence in the light most favorable to applicant as the non-movant, the Board finds that disposition of opposer's lack of bona fide intent to use claim on summary judgment is not well taken. At a minimum, applicant's responses to opposer's written discovery requests, viewed in the context of summary judgment, raise an issue as to bona fide intent. For example, in explaining its responses to Requests for Admission Nos. 130-133,⁴ applicant asserts that its responses "simply mean that (applicant) is not currently manufacturing and warehousing products to be later labeled with the QUILTY mark. The responses do not mean that (applicant)

⁴ In summary, the requests seek admissions that applicant "has not manufactured any" bath tissue, facial tissue, paper towels or paper napkins "on which the QUILTY Mark is intended to be used." Applicant responded, "Subject to the general objections, Global Tissue admits this Request."

has not identified product or products on which the mark will be used" (applicant's brief, p. 3-4). In this regard, we note that as a general rule, the factual issue of intent is particularly unsuited to disposition on summary judgment. See *Copelands Enterprises, Inc. v. CNV, Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1299 (Fed. Cir. 1991).

Inasmuch as opposer has not met its burden to show that there is no genuine dispute of material fact that applicant lacks evidence of a bona fide intent to use the mark at the time of filing the application, the motion for summary judgment is denied.⁵

Schedule

In accordance with the Board's January 12, 2011 order, proceedings are resuspended, and applicant is allowed until thirty (30) days from the mailing date of this order in which to disclose, and notify the Board, of its intention, if any, to employ a rebuttal expert. See Trademark Rule 2.120(a)(2).

The parties are allowed until sixty (60) days from the mailing date of this order in which to conduct discovery of the expert witness(es).

⁵ The evidence submitted in connection with the motion for summary judgment is of record only for consideration of that motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. See, e.g., *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1438 n. 14 (TTAB 2007); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993). Also, the fact that we have identified certain issues in dispute should not be construed as a finding that these are necessarily the only issues which remain for trial.

The parties are directed to notify the Board upon the completion of expert discovery and the service of information that is required under Fed. R. Civ. P. 26(a), as appropriate.

Finally, applicant is allowed until twenty (20) days from the mailing date of this order to supplement its prior-served responses to opposer's written discovery requests, as well as its initial disclosures, relevant to and consistent with the information and documents that applicant has disclosed in connection with defending the summary judgment motion.