

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

Mailed: March 5, 2010

Opposition No. **91184978**

McNeill-PPC, Inc.

v.

Walgreen Co.

Ann Linnehan, Interlocutory Attorney

This case now comes up for consideration of: (1) applicant's motion (filed August 19, 2009) for leave to amend its answer; and (2) applicant's motion (filed October 5, 2009) to compel opposer to produce all documents responsive to Document Request No. 32 of applicant's second request for production of documents and things.

The Board first turns to applicant's motion for leave to amend its answer. Applicant seeks to add the affirmative defense that opposer lacks standing to bring this opposition. A copy of the amended answer was filed in conjunction with applicant's motion.

Leave to amend pleadings must be freely given when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party. See Fed. R. Civ. P. 15(a); TBMP Section 507.02 (2d ed. rev. 2004) and cases cited therein. Where

the moving party seeks to add a new claim or defense, and the proposed pleading thereof is legally insufficient, or would serve no useful purpose, the Board normally will deny the motion for leave to amend. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990).

After reviewing the parties' arguments and the amended answer, the Board denies applicant's motion for leave because the affirmative defense of a lack of standing would serve no useful purpose. See TBMP Section 507.02 and cases cited therein.

Standing must be proved by opposer as part of its *prima facie* case. Applicant's proposed affirmative defense based on opposer's alleged lack of standing is futile inasmuch as it serves no useful purpose. In order to establish standing, opposer need only prove that it has a real interest in the outcome of this proceeding. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 213 USPQ 185, 188 (CCPA 1982). Opposer's allegation that it is the exclusive U.S. licensee of the pleaded mark and that it is a competitor of applicant suffice, if proven, to establish opposer's standing. See *Books on Tape, Inc. v. Booktape Corp.*, 5 USPQ2d 1301, 1302 (Fed. Cir. 1987); *Revlon, Inc. v. La Maur, Inc.*, 157 USPQ 602, 604 (TTAB 1968); *William &*

Scott Co. v. Earl's Rests. Ltd., 30 USPq2d 1870, 1873 n. 2 (TTAB 1994).

The Board now turns to applicant's motion to compel. As a preliminary matter, the Board finds that applicant has shown that it made a good faith effort, pursuant to Trademark Rule 2.120(e)(1), to resolve with opposer the issues presented in its motion to compel prior to seeking the Board's intervention.

Document Request No. 32 seeks all communications between persons employed by UCB Pharma, S.A., UCB S.A. and McNeil-PPC, Inc., McNeil Consumer Healthcare, Johnson & Johnson, or any of its divisions or related companies in opposer's possession, custody, or control concerning applicant's use or registration of applicant's mark or this opposition proceeding.

Fed. R. Civ. P. 26(b) governs the scope of discovery served by either party and provides that the parties may obtain discovery regarding any matter, not privileged, which is relevant to the subject matter involved in the pending action. The requirement of relevancy is generally construed liberally and discovery generously allowed unless it is clear that the information which is sought can have no possible bearing on the issues involved in the particular proceedings. See Fed. R. Civ. P. 26(b)(1). See also *Johnston Pump/Valve Inc. v. Chromalloy American Corp.*, 10

USPQ2d 1671 (TTAB 1988); and TBMP § 402.01 (2d ed. rev. 2004).

Opposer's objection concerning the relevancy the information sought in Document Request No. 32 is sustained. While information concerning a defendant's knowledge of plaintiff's use of plaintiff's involved mark is generally discoverable,¹ the Board fails to see how, in this instance, opposer's knowledge of applicant's marks is of any import to the claims and defenses of this proceeding. Moreover, any discoverable documents sought concerning this opposition should, more than likely, be part of the electronic record for this proceeding.

Applicant states that the responsive documents "are relevant, because they include communications by UCB and J&J and their related divisions and companies. UCB is the owner of the ZYRTEC marks, and J&J is the former owner of the licensed rights to use the ZYRTEC mark. It would be highly relevant if the actual owner of the mark ZYRTEC believed confusion and/or dilution by WAL-ZYR was not likely." The Board disagrees. UCB's belief or opinion is not relevant to any issue in this proceeding. UCB's opinion as to whether the WAL-ZYR mark is confusingly similar to or dilutive of the ZYRTEC mark has no bearing on whether the WAL-ZYR mark in fact is confusingly similar or dilutive of the ZYRTEC mark.

¹ See TMBP Section 414(19) (2d ed. rev. 2004).

Inasmuch as applicant's Document Request No. 32 seeks documents that are not relevant to any issue in this proceeding, the Board finds that opposer need not respond to the request.

In view thereof, applicant's motion to compel is denied.

On July 20, 2009, applicant notified the Board of its timely disclosure to opposer of plans to use expert testimony. Accordingly, proceedings herein remain suspended pending the parties' compliance with Fed. R. Civ. P. 26(a)(2) and the exchange of discovery limited to planned expert testimony, including that of any rebuttal expert. Trademark Rule 2.120(a)(2).²

To the extent that the use of experts did not form part of the parties' discovery conference discussions, the parties shall promptly confer on the arrangements for the completion of disclosures relating to planned expert testimony, including any testimony by a rebuttal expert, and for exchanging and responding to discovery requests, if any, related to the identified experts. Such discussions should also encompass stipulations regarding the introduction into

² Trademark Rule 2.120(a)(2) states, in part:

Upon disclosure by any party of plans to use expert testimony, whether before or after the deadline for disclosing expert testimony, the Board may issue an order regarding expert discovery and/or set a deadline for any other party to disclose plans to use a rebuttal expert.

evidence of the testimony of expert witnesses, for example, whether in lieu of testimony, the parties introduce the expert report(s), whether the expert testimony may be provided by affidavit or declaration³, or whether the witnesses will present testimony and discuss exhibits in testimony depositions.

Federal Rule 26(a)(2) provides that a party planning to use an expert solely to contradict or rebut an adverse party's expert must disclose such plans within thirty days of the adverse party's prior disclosure. However, Trademark Rule 2.120(a)(2) also provides that the Board may set a deadline for disclosing plans to use a rebuttal expert. Accordingly, if opposer has not already complied with the requirements of the federal rule, it is allowed until 20 days from the date of this order to disclose any planned rebuttal expert testimony. Federal Rule 26(a)(2) also details what information and materials must be provided for a party to satisfy its disclosure obligation with respect to experts. See "Miscellaneous Changes to Trademark Trial and Appeal Board Rules," 72 Fed. Reg. 42242, 42246 (Aug. 1, 2007).

Upon the completion of expert discovery and the service of information required by Federal Rule 26(a)(2), the

³ Parties that stipulate that the testimony of a witness may be introduced by affidavit or declaration may also reserve the right to conduct in-person cross-examination, if necessary.

parties must inform the Board so that proceedings may be resumed.