

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

MBA

Mailed: February 11, 2011

Opposition No. 91185325

La Senza Corp.

v.

Olympic Mountain and Marine
Products, Inc.

Michael B. Adlin, Interlocutory Attorney:

This case now comes up for consideration of: (1) opposer's motion, filed July 14, 2010, for reconsideration of the Board's order of June 14, 2010 (the "Prior Order"), in which the Board granted applicant's motion for leave to amend its answer to add a counterclaim and defense, and denied opposer's cross-motion to amend the identification of goods in its pleaded registration; and (2) opposer's cross-motion under Fed. R. Civ. P. 56(d) (formerly 56(f)), filed August 30, 2010, seeking discovery which opposer claims is necessary to adequately respond to applicant's October 14, 2009 motion for summary judgment. Both motions are fully briefed.

Background

Applicant seeks registration of ESSENZA, in standard characters, for "Scented oils used to produce aromas when heated; essential oils for household use" and "Scent

diffusers comprised of a container and wood rods used to diffuse oil scent poured in the container.”¹ In its notice of opposition, opposer alleges prior use of LA SENZA for apparel, skin care products “and related goods and accessories,” ownership of a registration for the mark for “body lotions” (the “Registration”)² and that use of applicant’s mark is likely to cause confusion with opposer’s mark. In its original answer, applicant merely denied the salient allegations in the notice of opposition.

Applicant’s motion for summary judgment includes a motion for leave to amend applicant’s original answer to add an affirmative defense of “unclean hands” and a counterclaim for fraud. Applicant’s motion sought judgment on the proposed new counterclaim and defense, as well as opposer’s claim of priority and likelihood of confusion. However, following the Board’s order of November 5, 2009, applicant recast its motion for leave to amend, and in its second motion for leave to amend, applicant sought to add instead a

¹ Application Serial No. 77071961, filed December 27, 2006, based on an alleged intent to use the mark in commerce.

² Registration No. 1800379, issued October 26, 2003 from an application filed November 30, 1990 under Section 44(e) for use in connection with a variety of products. However, pursuant to opposer’s Combined Declaration of Use in Commerce/Application for Renewal filed October 22, 2003, the goods identified in the Registration are now limited to “body lotions.” For reasons unknown, Office records were not updated to reflect the current identification of goods prior to the filing of the notice of opposition or prior to applicant raising an issue with the Office’s records being incorrect. The Office records were recently updated and now accurately reflect that opposer’s pleaded Registration is now limited to “body lotions.”

counterclaim for "partial abandonment," rather than fraud, as well as the "unclean hands" defense. In essence, applicant alleges "partial abandonment" because Office records regarding opposer's pleaded Registration were "wrong," in that they did not reflect opposer's October 22, 2003 renewal, in which opposer indicated that it only sought to maintain the Registration for "body lotions." Applicant alleges that the Office's error "was fostered, if not caused by Opposer's failure" to "specify the goods or services being deleted from the registration," pursuant to Trademark Rule 2.161(e)(2). Applicant points out that opposer's allegation in Paragraph 3 of its notice of opposition, regarding the goods in its Registration, is incorrect and overly broad, as the Registration is now limited to "body lotions," and this error by opposer is apparently the basis for applicant's "unclean hands" defense.

Opposer filed an extensive brief in opposition to applicant's second motion for leave to amend on a variety of grounds, and cross-moved to amend the identification of goods in its pleaded Registration to be coextensive with those in its October 23, 2003 renewal, i.e. "body lotions."

In the Prior Order, as supplemented by the Board's order of July 9, 2010, the Board granted applicant's motion for leave to amend its answer to add the counterclaim for partial abandonment and affirmative defense of "unclean

hands." The Board also denied opposer's cross-motion to amend the identification of goods in its pleaded Registration, because applicant did not consent thereto and opposer failed to pay the required fee. Accordingly, applicant's amended answer and counterclaim filed December 1, 2009 is now applicant's operative pleading herein. In its answer, opposer denies the salient allegations in the counterclaim. In February 2011, the Office updated opposer's pleaded Registration to accurately reflect the identification of goods, i.e. "body lotions" only.

Motion for Reconsideration

Opposer argues that applicant's abandonment counterclaim "is not a claim to be litigated, but rather an error to be corrected," and therefore that opposer should not be required to pay a fee for amending its pleaded Registration pursuant to its cross-motion, or to obtain applicant's consent to an "amendment," because the error was the Office's, not opposer's. Opposer further argues that applicant's abandonment counterclaim is insufficiently pled and a compulsory counterclaim which should have been filed with applicant's original answer.

Applicant argues that a mere correction is insufficient, and that instead it is entitled to judgment on the counterclaim. Applicant further argues that it is entitled to plead and attempt to prove the "unclean hands"

defense based on opposer's alleged violation of Trademark Rule 2.161(e)(2) and misstatement about its Registration in its notice of opposition, but that if opposer's motion for reconsideration is granted, the defense would be "wiped away."

A motion for reconsideration "may not properly be used to introduce additional evidence, nor should it be devoted simply to a reargument of the points presented in a brief on the original motion." TBMP § 518 (2d ed. rev. 2004). Instead, a motion for reconsideration "should be limited to a demonstration that based on the facts before it and the applicable law, the Board's ruling is in error and requires appropriate change." Id.

Opposer's motion for reconsideration focuses primarily on the denial of opposer's cross-motion to amend its pleaded Registration. Both opposer's motion for reconsideration on this point and its underlying cross-motion to amend are hereby **DENIED AS MOOT**. Indeed, the Office has now corrected its records, which accurately reflect opposer's October 22, 2003 renewal. Because the renewal was filed before this proceeding and the Office did not timely act on it, neither applicant's consent to an "amendment," nor an additional fee, is required.

Opposer also seeks reconsideration of the Prior Order allowing applicant leave to amend its answer. While it

appears that applicant's proposed counterclaim may now be moot because Office records concerning opposer's involved Registration are now accurate, applicant argues that it should be entitled to: (1) pursue a judgment on its counterclaim for partial abandonment;³ and (2) argue that opposer's misstatement in Paragraph 3 of its notice of opposition constitutes "unclean hands." Consideration of these remaining questions is hereby **DEFERRED**, and these issues will be addressed by the panel which ultimately takes up applicant's motion for summary judgment.

Cross-Motion for Discovery Under Rule 56(f)

Applicant seeks summary judgment on opposer's claim under Section 2(d) of the Act, arguing that there is no likelihood of confusion between the parties' marks. Specifically, applicant argues that the parties' marks create different overall commercial impressions, that the parties' goods are "not at all similar" and that despite

³ Applicant should be aware that even if it is permitted to pursue its counterclaim for partial abandonment, opposer relies not only on its pleaded Registration, but also on prior use of its mark for "ladies (sic) wearing apparel, lingerie, loungewear, skin care products, and related goods and accessories, including, but not limited to, body oils, bath oils and massage oils." Notice of Opposition ¶ 2. Therefore, if opposer proves its alleged prior use of its mark on these products and that there is a likelihood of confusion, any "partial cancellation" of opposer's pleaded Registration, and perhaps even any finding of unclean hands with respect to the pleaded Registration, may not change the result of opposer's claim of priority and likelihood of confusion.

concurrent use of the parties' marks for several years, "there is no evidence of actual confusion."

In its cross-motion, opposer, which has already served fairly extensive written discovery, claims that it requires answers to proposed supplemental, and relatively limited, written discovery requests to adequately respond to applicant's motion for summary judgment. Specifically, opposer argues that it requires information concerning "the amount and geographic scope of Applicant's sale of products under the ESSENZA mark in the United States" in order to counter applicant's argument that the lack of evidence of actual confusion is relevant. Opposer points out that applicant's responses to opposer's original written discovery requests are difficult to parse, in that applicant provides information about its U.S. sales and foreign sales together, and the information about applicant's U.S. sales is not easily understandable or separable from the information about applicant's foreign sales. Opposer's proposed supplemental discovery requests are comprised of 11 interrogatories (including subparts) and nine requests for production.

In its response to the cross-motion, applicant complains of opposer's "tsunami" of original discovery requests, points out that they were served on the last day of discovery and argues that opposer undertook the risk

"that if Applicant's discovery responses suggested the need for additional discovery, the discovery period would be closed, and such additional discovery would be unavailable." Applicant contends that its responses to opposer's original discovery requests were "thorough," and that the information opposer seeks is "already available" in the original discovery responses, if opposer is "willing to devote the time." That is, applicant does not dispute that its original responses combined irrelevant foreign sales with relevant U.S. sales in a way which makes it difficult for opposer to use and understand the information provided, but contends that opposer could nevertheless, with significant effort, ascertain the information it requires from the original responses. Applicant also complains that opposer waited until its response to the motion for summary judgment was due to file its cross-motion. Finally, applicant contends that opposer's proposed supplemental discovery requests would be "highly burdensome," and that the additional information requested "cannot make a material difference to the outcome of this action."⁴

In order to establish that it is entitled to discovery under Fed. R. Civ. P. 56(d), opposer must show through affidavit or declaration (in this case the affidavit of its

⁴ Opposer filed a reply brief in which it essentially restates its original arguments.

counsel) "reasons why discovery is needed in order to support its opposition" to applicant's motion for summary judgment. Opryland USA Inc. v. The Great American Music Show Inc., 970 F.2d 847, 852, 23 USPQ2d 1471, 1474 (Fed Cir. 1992) (citing Keebler Co. v. Murray Bakery Products, 866 F.2d 1386, 1389, 9 USPQ2d 1736, 1739 (Fed. Cir. 1989)). Opposer must do more than set forth a "speculative hope of finding some evidence" that would support its arguments, however. Sweats Fashions, Inc. v. Pannill Knitting Co. Inc., 833 F.2d 1560, 1566-67, 4 USPQ2d 1793, 1799 (Fed. Cir. 1987); Pure Gold, Inc. v. Syntex (U.S.A.), Inc., 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984). Instead, opposer "should set forth with specificity the areas of inquiry needed" to respond to applicant's motion for summary judgment. TBMP § 528.06 (2d ed. rev. 2004). "Unfocused requests" for discovery which lack specificity are not sufficient under Fed. R. Civ. P. 56(f). Keebler, 866 F.2d at 1390, 9 USPQ2d at 1739.

Here, applicant specifically relies on the absence of evidence of actual confusion in support of its motion for summary judgment. However, its original discovery responses regarding its U.S. sales are difficult to understand, especially with respect to which products applicant has sold in the U.S., where in the U.S. it has sold these products, and approximately how many products identified in its

involved application have been sold in the U.S. It is self-evident, as well as clear from applicant's response to opposer's cross-motion, that the burden to applicant of providing the requested information in understandable form is significantly less than the burden to opposer of dissecting applicant's original responses to discern the information it needs, especially because opposer is unfamiliar with the raw information or underlying facts.⁵

Furthermore, opposer's proposed supplemental requests are specific, focused, limited in number and directly related to applicant's argument that the lack of evidence of actual confusion is relevant. In fact, without responses to its proposed supplemental requests, opposer would not be able to effectively counter applicant's argument about the lack of evidence of actual confusion, because opposer would not know how much opportunity there has been for actual confusion to occur in the United States.

Accordingly, opposer's cross-motion is hereby **GRANTED** and applicant is allowed until **THIRTY FIVE DAYS** from the mailing date of this order to respond to opposer's

⁵ Applicant's argument that opposer "assumed the risk" that follow-up or additional discovery could be "unavailable" is not well-taken. In fact, Board rules allow motions to compel to be filed anytime prior to the opening of trial, and extensions of the discovery period are routinely granted where discovery responses are inadequate. While it certainly would have been preferable for opposer to confer with applicant prior to filing its cross-motion, neither Rule 56(d) nor Board rules required opposer to do so, and opposer had a limited amount of time in which to file its cross-motion.

supplemental discovery requests attached to opposer's cross-motion as Exhibits J and K, except that: (1) applicant need only respond to opposer's supplemental discovery requests with respect to the goods identified in applicant's involved application; and (2) applicant need not respond to supplemental Interrogatory No. 3 or supplemental Document Request Nos. 6 or 8, because these address non-U.S. sales, are therefore irrelevant and opposer cannot have it both ways. TBMP § 414(13) (2d ed. rev. 2004).

Conclusion

Opposer's motion for reconsideration is denied as moot with respect to opposer's cross-motion to amend its pleaded Registration. Further consideration of opposer's motion for reconsideration with respect to applicant's motion for leave to amend its answer is deferred. Opposer's cross-motion for discovery under Fed. R. Civ. P. 56(d) is granted, to the extent set forth herein. Opposer is allowed until **SIXTY FIVE DAYS** from the mailing date of this order to file its substantive response to applicant's motion for summary judgment. Proceedings herein remain otherwise suspended pending disposition of applicant's motion for summary judgment.
