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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91195823
Party	Defendant NCA Biotech, Inc.
Correspondence Address	STANLEY T HSIAO NCA BIOTECH INC 4802 MURRIETA STREET CHINO, CA 91710 UNITED STATES stanleyth@ncabiotech.com, info@ncabiotech.com
Submission	Opposition/Response to Motion
Filer's Name	Stanley T. Hsiao
Filer's e-mail	stanleyth@cpbio.com
Signature	/Stanley T. Hsiao/
Date	06/06/2011
Attachments	Resp to mot to sususpend.pdf (15 pages)(2754008 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 77/853.842
Published in the *Official Gazette* on March 30, 2010
Mark: CHAMPIONGRO

OMS Investments, Inc.	Opposition No. 91195823
vs.	APPLICANT'S RESPONSE IN OPPOSITION OF OPPOSER'S MOTION TO SUSPEND OPPOSITION INCLUDING DISCOVERY
NCA Biotech, Inc.	Applicant.

Applicant hereby responds to oppose Opposer's motion to suspend opposition including discovery as follows:

BACKGROUND

October 21, 2009 –

Applicant filed to register the mark "ChampionGro" with the Patent and Trade Mark Office.

July 28, 2010 –

Opposer filed its Notice of Opposition.

December 3, 2010 –

Applicant consented to Opposer's request to suspend the opposition to explore the possibility of settlement. Opposer claims that a settlement had been reached while Applicant disagrees. For this response purpose only, see the correspondences in Exhibit "A". Among others, the proposed settlement agreement was never signed, and the proposed settlement agreement does not contain the payment term of \$6,000 which Opposer was willing to pay.

April 14, 2011 –

Opposer mailed out and emailed to Applicant:

1. **Opposer's First Interrogatories;**
2. **Opposer's First Request for Admissions;** and
3. **Opposer's First Requests for Production.**

April 18, 2011 –

Applicant mailed out and emailed to Opposer:

1. **Applicant's First Set of Interrogatories and Requests for Production;** and
2. **Applicant's First Set of Request for Admissions;**

April 19, 2011 –

Applicant mailed out and emailed to Opposer:

Applicant's Second Set of Interrogatories and Requests for Production.

April 21, 2011 –

Opposer filed a **Motion for Leave to File A First Amended Notice of Opposition** from the Board, not on the reason of correction, but on a disputed settlement, which occurred after the original Notice of Opposition was filed and was totally unrelated to the registrability issue of Applicant's ChampionGro mark.

May 3, 2011 -

Applicant mailed out and emailed to Opposer **Applicant's Response to Opposer's for Leave to File A First Amended Notice of Opposition.**

May 10, 2011 –

Opposer filed a **Reply Brief in Support of Its Motion for Leave to File A First Amended Notice of Opposition.**

May 13, 2011 –

Opposer filed **Motion for Summary Judgment.**

May 16, 2011 –

Applicant mailed out and email its **Answers to Opposer's First Interrogatories, First Request for Admissions, and Requests for Production.**

May 18, 2011 –

Due date for **Opposer's Answers to Applicant's First Set of Interrogatories and Requests for Production; and Applicant's First Set of Request for Admissions.**

May 19, 2011 –

Due date for **Opposer's Answers to Applicant's second Set of Interrogatories and Requests for Production.**

May 23, 2011 –

Opposer filed **Motion to Suspend Opposition including discovery.**

DISCUSSIONS

When a motion for summary judgment is filed, the non-moving party would normally agree to the request to temporarily suspend other proceedings including

discovery on the reasons as Opposer explained in its motion to suspend. However in this case, Opposer's motion was filed in violation of the Federal Rules of Civil Procedure. Applicant cannot agree to Opposer's motion.

I. Rule 56(b) of Federal Rules of Civil Procedure

Rule 56(b) of Federal Rules of Civil Procedure provides:

“(b) Time to File a Motion. Unless a different time is set by local rule or the court orders otherwise, a party may file a motion for summary judgment at any time until 30 days after the close of all discovery.”

Opposer's Motion for Summary Judgment was filed before the due date both parties are required to answer the discovery requests. Opposer actually has failed to answer Applicant's discovery requests so far even after the due dates to answer had passed. For the purpose of Applicant's responses only, see Exhibit "A" attached hereto. There is no court order otherwise in place in this case. Opposer's motion was filed in violation of Federal Rules of Civil Procedure regarding motion for summary judgment.

II. Rule 408 of Federal Rules of Evidence

The substance of Opposer's motion for summary judgment is identical to Opposer's earlier Motion for Leave to File A First Amended Notice of Opposition. Namely, Opposer tries to allege and argue that the parties had reached settlement. Applicant strongly disputes it. For the purpose of Applicant's responses only, see Exhibit "B" attached hereto. Opposer is unable to submit a signed agreement.

It has been a well-established judicial policy that compromise or offer to compromise is inadmissible. Such policy is well spelt in Rule 408 of Federal Rules of Evidence. The principle has also been extended to cover medical payment, plea discussions, liability insurance respectively in Rules 409, 410 and 411. The disputed settlement should not be admitted as evidence, and as a matter of law cannot be incorporated into its amended Notice of Opposition as proposed, nor used as a reason to Opposer's motion for summary judgment.

III. Requirements of Rule 56

Issuance of summary judgment can be based only upon the court's finding that:

1. there are no genuine issues of material fact requiring a trial for their resolution, and
2. in applying the law to the undisputed facts, one party is clearly entitled to judgment.

Opposer is unable to prove to the Board that there are no issues of material fact requiring a trial for their resolution. In addition, the Board must consider all materials in the light most favorable to the party opposing the motion for summary judgment. In order to defeat a motion for summary judgment, the non-moving party only has to show substantial evidence that a dispute of material facts exists, regardless of the strength of that evidence.

To grant Opposer's motion here the Board will right the wrong committed by Opposer. It should not be allowed on the principle of justice.

IV. TTAB's Jurisdiction

The TTAB is an administrative board that hears and decides adversary proceedings between two parties, namely, oppositions (party opposes a mark after publication in the *Official Gazette*) and cancellations (party seeks to cancel an existing registration).

The agency's expertise is about the registrability of a trade mark, not about contract. In this case, the Board is to decide whether Opposer is legally entitled to claim Gro as its family mark or element in order to preclude all applications of any mark containing Gro, including Applicant's ChampionGro mark, from registration.

The agency's expertise is not about contract, and is not charged with duty to decide the formation or validity of a contract or whether a settlement was ever formed. To allow Opposer's motion to suspend will indirectly mean that Opposer's wrongly filed motion for summary judgment is justified by the Board.

CONCLUSION

Opposer is asking the Board to approve a motion to suspend opposition including discovery on the reason of its filing of a motion for summary judgment, which was filed in violation of Federal Rules of Civil Procedure and Federal Rules of Evidence. In addition, Opposer is asking the Board to decide on contract issues, which is a subject matter outside the Board's jurisdiction. Therefore, Applicant respectfully requests that Opposer's Motion to Suspend Opposition Including Discovery be denied.

DATED this 6th day of June, 2011.

Respectfully Submitted,



Stanley T. Hsiao
NCA Biotech, Inc.
4802 Murrieta St.
Chino, CA 91710
Tel: (909) 348-5133

Certificate of Service

The undersigned hereby certifies that a copy of this foregoing paper has been served upon Opposer's attorney of record and address below by First Class Mail and by email on this date.

John Gary Maynard, III, Esq.
Hunton & Williams LLP
951 East Byrd Street
Riverfront Plaza, East Tower
Richmond, VA 23219-4074
Telephone (808) 788-8200

Dated: June 6, 2011



Linn Robinson

EXHIBIT "A"

High Light Added.

Stanley Hsiao

From: Lim, Elizabeth A. <ELim@hunton.com>
Sent: Thursday, June 02, 2011 12:09 PM
To: Stanley Hsiao
Cc: Demm, Stephen; Wortham, Early
Subject: RE: OMS Investments, Inc. v. NCA Biotech, Inc.

Mr. Hsiao,

Thank you for your e-mail. Since both parties believe that the best approach is to suspend discovery pending the Board's disposition of the summary judgment motion, we think it is unlikely that the Board will deny that motion. In the unlikely event that the Board decides not to suspend discovery while the summary judgment motion is pending, we anticipate that both parties would resume the discovery process soon afterwards. So if the Board does deny the motion to suspend, OMS will provide appropriate responses to NCA's discovery requests in due course, just as we understand that NCA will supplement the deficiencies in its responses to OMS's discovery requests in due course.

Thank you for your clarification on this point,

Elizabeth

From: Stanley Hsiao [mailto:stanleyth@cpbio.com]
Sent: Thursday, June 02, 2011 2:35 PM
To: Lim, Elizabeth A.
Cc: Demm, Stephen; Wortham, Early
Subject: RE: OMS Investments, Inc. v. NCA Biotech, Inc.

Dear Sirs and Madam:

I want to point out that your email doesn't really reflect the essence of our conference, because if Opposer's Motion to Suspend Opposition including Discovery is not granted, Opposer should provide its answers to Applicant immediately. Thus, the discovery is on hold pending disposition of Opposer's Motion to Suspend Opposition Including Discovery, not of Opposer's Motion for Summary Judgment.

Thanks for your attention.

Stanley

From: Lim, Elizabeth A. [mailto:ELim@hunton.com]
Sent: Friday, May 27, 2011 9:40 AM
To: stanleyth@cpbio.com
Cc: Demm, Stephen; Wortham, Early
Subject: OMS Investments, Inc. v. NCA Biotech, Inc.

Stanley,

Thank you for taking the time to discuss the discovery process in the CHAMPIONGRO Opposition.

As we understand it, both parties have agreed to put discovery on hold pending disposition of the motion for summary judgment that OMS filed on May 13, 2011. The parties agree that they will not seek responses to discovery requests or correction of deficiencies in discovery responses unless and until the proceeding resumes, provided that should the proceeding resume, both parties have sufficient time to review discovery responses and prepare for the testimony period.

Thank you again for your time,

Elizabeth

Elizabeth Lim
Associate
ELim@hunton.com

Hunton & Williams LLP
Riverfront Plaza, East Tower
951 East Byrd Street
Richmond, VA 23219
Phone: (804) 788-7365
Fax: (804) 343-4924
www.hunton.com

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EXHIBIT "B"

High Light Added.

Stanley Hsiao

From: Maynard, John Gary <jgmaynard@hunton.com>
Sent: Tuesday, April 05, 2011 6:39 AM
To: Stanley Hsiao
Cc: Demm, Stephen; Lim, Elizabeth A.
Subject: RE: Scotts/NCA Biotech

Mr. Hsiao

The email below was rejected by your filter because of the size of the attachments. I am resending without the attachments as you already have the attachments in your possession.

From: Maynard, John Gary
Sent: Tuesday, April 05, 2011 9:31 AM
To: 'Stanley Hsiao'
Cc: Demm, Stephen; Lim, Elizabeth A.
Subject: RE: Scotts/NCA Biotech

Mr. Hsiao

I am beginning to think you are playing games with me.

The facts could not be more clear. As set forth in my March 16 and January 14 emails, copies of which are attached for your convenience, Scotts made a settlement offer to you via an email dated November 18, which attached a draft settlement agreement. This November 18 email is attached to my January 14 email above. You responded on December 15 with a very clear counter-offer. NCA Biotech would accept all of the terms of the settlement agreement, but for two specific provisions: either (i) Scotts agrees to pay you \$6,000, or (ii) Scotts withdraws the language of the Agreement requiring NCA Biotech to recognize Scotts' rights in the GRO mark. Most notably, you proposed no other terms. Scotts accepted NCA Biotech's offer by electing the second option, and on January 14, 2011, I forwarded you a revised agreement that reflected the parties' agreement on all material terms.

Since then, you have sought to renegotiate the terms, most recently via the agreement attached to your March 29 email. This approach is not productive. A deal has already been reached and is reflected in the agreement attached to my January 14 email. I hope that NCA Biotech will sign that attached agreement, and we look forward to hearing from you by the end of the week. Should this matter not be resolved by the end of the week, Scotts will have no choice but to prosecute this matter.

From: Stanley Hsiao [mailto:stanleyth@cpbio.com]
Sent: Friday, April 01, 2011 6:47 PM
To: Maynard, John Gary
Subject: RE: Scotts/NCA Biotech

John,
I asked you on 3/16/2011:

So is it correct that your position is that you will not pay NCA Biotech any amount if you are to sign an agreement similar to what I revised?

Your clear answer on the same day was:

Yes, you understand correctly. Scotts accepted your offer on terms that required no payment of money.

It means that you would accept my version or my terms but not paying \$6,000.00.

I don't know what you are talking about now.

Stanley

From: Maynard, John Gary [mailto:jgmaynard@hunton.com]
Sent: Friday, April 01, 2011 8:20 AM
To: Stanley Hsiao
Cc: Maynard, John Gary
Subject: RE: Scotts/NCA Biotech

Mr. Hsiao

This is not what the parties agreed to.

From: Stanley Hsiao [mailto:stanleyth@cpbio.com]
Sent: Tuesday, March 29, 2011 4:55 PM
To: Maynard, John Gary
Subject: RE: Scotts/NCA Biotech

John,

It is interesting that our technology could be used by Scott Miracle-Gro in its upgraded products. It is too early to say anything yet. It is really a small world.

Our CEO is ready to accept your insistence as long as our existing marks are protected. See attached.

Stanley

From: Maynard, John Gary [mailto:jgmaynard@hunton.com]
Sent: Tuesday, March 22, 2011 2:26 PM
To: Stanley Hsiao
Subject: RE: Scotts/NCA Biotech

From our perspective, an agreement has already been reached and there is nothing more to decide. Nonetheless, the main reason I have pushed this matter is because the TTAB suspension ended on March 3 and, as such, there are several deadlines fast approaching. It is clearly in no one's interest to incur the time and expense of litigation when a settlement has been reached.

Given the approaching deadlines, if we do not hear back from you promptly, we will take appropriate actions.

From: Stanley Hsiao [mailto:stanleyth@cpbio.com]
Sent: Tuesday, March 22, 2011 5:08 PM
To: Maynard, John Gary
Subject: RE: Scotts/NCA Biotech

The insistence of your position gives our CEO a very hard time to decide. It is an issue of principle. Money is not an import issue to us. Give us more time.

From: Maynard, John Gary [mailto:jgmaynard@hunton.com]
Sent: Tuesday, March 22, 2011 11:54 AM
To: Stanley Hsiao
Subject: RE: Scotts/NCA Biotech

Just following up on this.

From: Maynard, John Gary
Sent: Wednesday, March 16, 2011 1:49 PM
To: 'Stanley Hsiao'
Cc: Maynard, John Gary
Subject: RE: Scotts/NCA Biotech

Mr. Hsiao:

Yes, you understand correctly. Scotts accepted your offer on terms that required no payment of money. We have an agreement on all material terms, as memorialized by the draft agreement I sent you on January 14. Scotts is not willing to discard that agreement and renegotiate a new one.

From: Stanley Hsiao [mailto:stanleyth@cpbio.com]
Sent: Wednesday, March 16, 2011 12:57 PM
To: Maynard, John Gary
Subject: RE: Scotts/NCA Biotech

John,

Let me know if I understand you correctly. The email you indicated contains such language as follows:

As that email indicates, you were willing to enter into the Settlement Agreement provided Scotts paid you \$6,000, or it withdrew the language of the Agreement requiring NCA to recognize Scotts' rights in the GRO mark. The Scotts has elected the latter.

So is it correct that your position is that you will not pay NCA Biotech any amount if you are to sign an agreement similar to what I revised?

Stanley

From: Maynard, John Gary [mailto:jgmaynard@hunton.com]
Sent: Wednesday, March 16, 2011 8:36 AM
To: stanleyth@cpbio.com
Cc: Maynard, John Gary
Subject: Scotts/NCA Biotech

Mr. Hsiao

Thanks for the email and revised document. Unfortunately, you have misunderstood Scotts' position. As I outlined in my email of January 14, 2011, attached above for your convenience, NCA Biotech offered to settle this matter in one of two different ways: (i) Scotts agrees to pay you \$6,000, or (ii) Scotts withdraws the language of the Agreement requiring NCA Biotech to recognize Scotts' rights in the GRO mark. Scotts accepted NCA Biotech's offer by electing the second option, and on January 14, 2011, I forwarded you a revised agreement that reflected the parties' agreement on all material terms.