

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

Baxley

Mailed: March 27, 2012

Opposition No. 91197754

Wolf-Peter Graeser

v.

Lavatec, Inc.<sup>1</sup>

**By the Trademark Trial and Appeal Board:**

This case now comes up for consideration of applicant's motion (filed November 11, 2011) for leave of the Board to share a document that opposer produced during discovery pursuant to the Board's standard protective order as "trade secret/commercially sensitive" with an independent translator of its choice for its own translation thereof.<sup>2</sup> The motion has been fully briefed.<sup>3</sup>

Throughout opposer's brief in opposition to applicant's motion, opposer has redacted the identification of the

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<sup>1</sup> On July 25, 2011, the involved application was assigned from Lavatec, Inc. to Laundry Acquisition, Inc. ("Laundry"). A document reflecting that assignment is recorded with the USPTO's Assignment Branch at Reel 4592, Frame 0329. In July 2011, Laundry changed its name to Lavatec, Inc. A document reflecting that name change is recorded with the Assignment Branch at Reel 4595, Frame 0011.

<sup>2</sup> The document at issue was already produced during discovery. See Exhibit 1 of applicant's motion. Accordingly, applicant's captioning of its motion as one to compel is incorrect.

<sup>3</sup> In the interest of brevity, the Board declines to summarize the parties' arguments.

document at issue. The identification of a document, as opposed to its substance, is not confidential. See TBMP Section 414(1) (3d ed. 2011). Only that information which is truly confidential, such as sales and advertising figures and customer names, should be treated as confidential and redacted. See Trademark Rules 2.27(d) and (e). Moreover, opposer refers to the transaction memorialized by that document in paragraph 20 of the notice of opposition. Nonetheless, the Board will not identify the document at issue in this order.

The Board's standard protective agreement is operative herein. See Trademark Rule 2.116(g). That agreement states in relevant part as follows:

3) Access to Protected Information.

The provisions of this order regarding access to protected information are subject to modification by written agreement of the parties or their attorneys, or by motion filed with and approved by the Board.

Judges, attorneys, and other employees of the Board are bound to honor the parties' designations of information as protected but are not required to sign forms acknowledging the terms and existence of this order. Court reporters, stenographers, video technicians or others who may be employed by the parties or their attorneys to perform services incidental to this proceeding will be bound only to the extent that the parties or their attorneys make it a condition of employment or obtain agreements from such individuals, in accordance with the provisions of paragraph 4.

- Parties are defined as including individuals, officers of corporations, partners of partnerships, and management employees of any type of business organization.

- Attorneys for parties are defined as including in-house counsel and outside counsel , including support staff operating under counsel's direction, such as paralegals or legal assistants, secretaries, and any other employees or independent contractors operating under counsel's instruction.
- **Independent experts or consultants include individuals retained by a party for purposes related to prosecution or defense of the proceeding but who are not otherwise employees of either the party or its attorneys.**
- Non-party witnesses include any individuals to be deposed during discovery or trial, whether willingly or under subpoena issued by a court of competent jurisdiction over the witness.

Parties and their attorneys shall have access to information designated as confidential or highly confidential, subject to any agreed exceptions.

Outside counsel, but not in-house counsel, shall have access to information designated as trade secret/commercially sensitive.

Independent experts or consultants, non-party witnesses, and any other individual not otherwise specifically covered by the terms of this order may be afforded access to confidential or highly confidential information in accordance with the terms that follow in paragraph 4. Further, **independent experts or consultants may have access to trade secret/commercially sensitive information if such access is agreed to by the parties or ordered by the Board, in accordance with the terms that follow in paragraph 4 and 5.**

#### 4) Disclosure to Any Individual.

Prior to disclosure of protected information by any party or its attorney to any individual not already provided access to such information by the terms of this order, the individual shall be informed of the existence of this order and provided with a copy to read. The individual will then be required to certify in writing that the order has been read and understood and that the terms shall be binding on the individual.

No individual shall receive any protected information until the party or attorney proposing to disclose the information has received the signed certification from the individual. A form for such certification is attached to this order. The party or attorney receiving the completed form shall retain the original.

5) Disclosure to Independent Experts or Consultants.

In addition to meeting the requirements of paragraph 4, any party or attorney proposing to share disclosed information with an independent expert or consultant must also notify the party which designated the information as protected. Notification must be personally served or forwarded by certified mail, return receipt requested, and shall provide notice of the name, address, occupation and professional background of the expert or independent consultant.

The party or its attorney receiving the notice shall have ten (10) business days to object to disclosure to the expert or independent consultant. If objection is made, then the parties must negotiate the issue before raising the issue before the Board. If the parties are unable to settle their dispute, then it shall be the obligation of the party or attorney proposing disclosure to bring the matter before the Board with an explanation of the need for disclosure and a report on the efforts the parties have made to settle their dispute. The party objecting to disclosure will be expected to respond with its arguments against disclosure or its objections will be deemed waived.

(emphasis added).

In view of the incomplete certified translation of the document at issue that opposer has provided and the alleged importance of that document to applicant's defense herein, the Board, in the interest of allaying applicant's concerns about the accuracy and incompleteness of that translation, will allow applicant to obtain its own complete translation of that document from an independent translator who is not

otherwise affiliated with applicant.<sup>4</sup> However, in view of opposer's concerns regarding preserving the confidentiality of that document, any translator must comply with paragraph 4 of the standard protective agreement. That is, the translator must be informed of the existence of the standard protective agreement and provided with a copy to read. Prior to being disclosed the document at issue, the translator must certify in writing that: (1) he has read and understood the standard protective agreement; and (2) the terms shall be binding on him. The Board's form acknowledgment of the standard form agreement protecting confidentiality of information revealed during Board proceeding is online at:  
<http://www.uspto.gov/trademarks/process/appeal/guidelines/ackagrmt.jsp>.

In view thereof, applicant motion for leave to share a document that opposer produced during discovery pursuant to the Board's standard protective order as "trade secret/commercially sensitive" with an independent translator of its choosing for its own translation thereof is granted. Applicant may have the document at issue

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<sup>4</sup> In so allowing, the Board makes no determination regarding the qualifications of opposer's translator. Any differences between the parties' translations of the document at issue are matters to be addressed when this case is decided on the merits.

translated by a independent translator of its choosing, subject to the foregoing conditions.

To the extent that each party has requested that its adversary be sanctioned for its conduct in connection with applicant's motion, those requests are inappropriate and will therefore receive no consideration. See Trademark Rule 2.120(g); TBMP Section 527.

In preparing this order, the Board reviewed the pleadings herein. In the electronic cover sheet of the notice of opposition, opposer sets forth as grounds for opposition: (1) deceptiveness and (2) false suggestion under Trademark Act Section 2(a), 15 U.S.C. Section 1052(a); (3) priority/likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d); (4) deceptive misdescriptiveness under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1); (5) dilution under Trademark Act Section 43(c), 15 U.S.C. Section 1125(c), and (6) nonownership.<sup>5</sup> Applicant, in its answer, denied the salient allegations of the notice of opposition.

In the text of the notice of opposition, however, opposer has adequately pleaded only its nonownership and Section 2(d) claims. See Trademark Act Sections 1(a) and 2(d), 15 U.S.C. Sections 1051(a) and 1052(d); *King Candy Co.*

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<sup>5</sup> Although not stated in the electronic cover sheet, a nonownership claim is pursuant to Trademark Act Section 1(a), 15 U.S.C. Section 1051(a).

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*v. Eunice King's Kitchen, Inc.*, 182 USPQ 108 (CCPA 1974).

Merely referring to a ground for opposition in the electronic cover sheet of a complaint does not constitute notice pleading of that ground. See TBMP Section 506.01 (pleadings should provide fair notice of the basis for claims and defenses).

Regarding the intended Section 2(a) grounds, a plaintiff alleging deceptiveness must allege

facts that, if proved, would establish that purchasers would be deceived in a way that would affect materially their decision to purchase applicant's goods. . . . A proper pleading of 'deceptiveness' under [S]ection 2(a) requires the plaintiff to do more than parrot the language of Section 2(d). The latter provision of the Trademark Act prohibits registration of marks which are likely to deceive a consumer as to the source or origin of goods or services. By contrast, Section 2(a) of the Act prohibits registration of marks which lead a consumer to draw a false conclusion about the nature or quality of goods or services under circumstances where such a conclusion will be material to the consumer's deliberations regarding purchase of the goods or services.

*Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711, 1713 (TTAB 1993). "When a plaintiff's allegation is that consumers are 'deceived into' buying defendant's goods under the mistaken belief that they originate from the same source as plaintiff's, or vice versa, the sort of deception at issue is the basis for a Section 2(d), not a Section 2(a), claim." *Id.* Opposer's allegations of deceptiveness in the notice of opposition are in the nature of a Section 2(d)

claim and do not set forth a separate claim of deceptiveness under Section 2(a).

Likewise, a claim of false suggestion under Section 2(a) requires a pleading of

facts from which it may be inferred that the applicant's mark points uniquely to opposer, as an entity -- i.e., that applicant's mark is opposer's identity or "persona" -- and that purchasers would assume that goods bearing applicant's mark are connected with opposer. ... Also, a properly pleaded claim of false suggestion of a connection clearly must assert *either* opposer's prior use of applicant's mark, or the equivalent thereof, as a designation of its identity or 'persona', or an association of the same with the plaintiff prior in time to the defendant's use.

*Id.* at 1712 (citations omitted). Such a claim is rooted in the rights of personal privacy and publicity, in the absence of likelihood of confusion. See *Bridgestone/Firestone Research Inc. v. Automobile Club de l'Ouest de la France*, 245 F.3d 1359, 58 USPQ2d 1460, 1463-64 (Fed. Cir. 2001). In the text of the notice of opposition, opposer has alleged ownership of the involved mark, but has not alleged that the involved mark is his identity or persona. Moreover, opposer has not expressly alleged in such text that applicant's mark falsely suggests a connection with opposer.

Regarding the intended deceptive misdescriptiveness claim under Section 2(e)(1), a mark is deceptively misdescriptive where it conveys a false, but plausible, idea about an ingredient, quality, characteristic, function, or feature of the goods or services with which it is used is

merely descriptive. See TMEP Section 1209.04 (8<sup>th</sup> ed. 2011). Opposer has pleaded no allegedly false idea about the nature of the involved goods that is conveyed by the involved mark and thus has failed to provide fair notice of the basis for a Section 2(e)(1) deceptive misdescriptiveness claim.

Regarding the intended dilution claim, such a claim requires allegations that the pleaded mark is famous and distinctive, that the pleaded mark became famous prior to a defendant's actual or constructive use of the involved mark and that registration of the involved mark will dilute the distinctive character of the pleaded mark. See *Polaris Industries Inc. v. DC Comics*, 59 USPQ2d 1798 (TTAB 2000). Although opposer alleged that his mark became famous prior to the filing date of the applicant's application, opposer did not properly plead the fame of his mark prior to the earliest date on which applicant can rely for purposes of priority, i.e., prior to applicant's first use of the involved mark. See *UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1871 fn. 3 (TTAB 2011). If opposer wishes to pursue its insufficiently pleaded claims, it must seek to leave of the Board to file an amended notice of opposition.<sup>6</sup> See Fed. R. Civ. P. 15(a); TBMP Section 507.02.

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<sup>6</sup> Opposer is reminded that, under Trademark Rule 11.18(b), [b]y presenting to the Office ... any paper, the party presenting such paper ... is certifying that ... [t]o the

The hostile and accusatory tone of the parties' submissions herein, however, has not gone unnoticed. The parties are reminded to conduct themselves with courtesy and decorum herein. See Trademark Rule 2.192.

Proceedings herein are resumed. Remaining dates are reset as follows.

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|-----------------------------------------|---------|
| Discovery Closes <sup>7</sup>           | 4/21/12 |
| Plaintiff's Pretrial Disclosures Due    | 6/5/12  |
| Plaintiff's 30-day Trial Period Ends    | 7/20/12 |
| Defendant's Pretrial Disclosures Due    | 8/4/12  |
| Defendant's 30-day Trial Period Ends    | 9/18/12 |
| Plaintiff's Rebuttal Disclosures Due    | 10/3/12 |
| Plaintiff's 15-day Rebuttal Period Ends | 11/2/12 |

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

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best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, ... [t]he paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office; ... [and t]he allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery.

See also Fed. R. Civ. P. 11(b); TBMP Section 527.02. Accordingly, unless opposer knows of facts that support each claim he intends to raise herein or has a good faith belief that evidence showing the factual basis for those claims is likely to be obtained after a reasonable opportunity for discovery or investigation, he should not seek to add those claims.

<sup>7</sup> Pursuant to the Board's September 26, 2011 order, the parties' expert disclosures were due on November 2, 2011, prior to the filing of applicant's motion.

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Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.