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

Baxley

Mailed: August 30, 2012

Opposition No. **91197754**

Wolf-Peter Graeser

v.

Lavatec, Inc.

By the Trademark Trial and Appeal Board:

This case now comes up for consideration of: (1) opposer's motion (filed April 11, 2012) for leave to file an amended notice of opposition; and (2) applicant's combined motion (filed April 18, 2012) to compel and to test the sufficiency of responses to requests for admission. The motions have been fully briefed.

Turning first to the motion for leave to file an amended notice of opposition, an answer to the original notice of opposition is of record herein. Accordingly, opposer may amend the notice of opposition only by written consent of applicant or by leave of the Board; leave is to be freely granted when justice so requires. See Fed. R. Civ. P. 15(a)(1)(A); TBMP Section 507.02(a) (3d ed. rev. 2012). The Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled

law, be prejudicial to the rights of the adverse party or parties, or be futile. See *id.*

Opposer filed its motion two weeks after the issuance of, and in apparent response to, the Board's March 27, 2012 order. In that order, the Board reviewed the notice of opposition and noted insufficiencies in the pleading of opposer's claims herein. In addition, opposer contends that it seeks to amend the notice of opposition (1) to clarify factual allegations based on information obtained in discovery, (2) to reflect the assignment the involved application, and (3) withdraw its claims under Trademark Act Sections 2(a) and 2(e)(1), 15 U.S.C. Section 1052(a) and 1052(e)(1).

Opposer filed his motion prior to the close of the discovery period, as last reset, and any potential prejudice can remedied by extending the discovery period. See *Microsoft Corp. v. Qantel Business Systems Inc.*, 16 USPQ2d 1732 (TTAB 1990). Further, a review of the amended notice of opposition indicates that opposer has provided notice pleading of nonownership, likelihood of confusion, and dilution claims. Applicant's argument that the proposed amendments are futile because opposer's pleaded claims "will fail" prematurely addresses the merits of those arguments, which is a matter for resolution at trial. See *Flatley v. Trump*, 11 USPQ2d 1284 (TTAB 1989).

Based on the foregoing, the motion for leave to file an amended notice of opposition is granted. Opposer's amended notice of opposition is the operative complaint herein. Applicant is allowed until **thirty days** from the mailing date of this order to file an answer thereto.

In the motion for leave to file an amended notice of opposition, opposer affirmatively states that he is withdrawing his Section 2(a) deceptiveness and false suggestion claims and Section 2(e)(1) deceptive misdescriptiveness claims. Because applicant's written consent to such withdrawal is not of record, those claims are dismissed with prejudice. See Trademark Rule 2.106(c).

Although opposer alleges in the last sentence of paragraph 38 of the amended notice of opposition that applicant's mark is not entitled to registration under Trademark Act Sections 2(f) and 13, 15 U.S.C. Sections 1052(f) and 1063, neither section set forth a claim upon which relief can be granted. Section 2(f) provides for registration on the Principal Register of certain marks that are not inherently distinctive upon a showing of distinctiveness, and Section 13 provides the statutory framework for opposition proceedings.

Opposer has not pleaded any claim that applicant's mark is not inherently distinctive, e.g., a claim of mere descriptiveness under Trademark Act Section 2(e)(1), 15

U.S.C. Section 1052(e)(1), that would require to a showing of distinctiveness under Section 2(f). Instead, opposer has pleaded that his pleaded LAVATEC mark, which is identical to applicant's involved LAVATEC mark, is inherently distinctive and, through his motion for leave to file an amended notice of opposition, has expressly withdrawn a claim that applicant's mark is not inherently distinctive, i.e., that applicant's mark is deceptively misdescriptive under Section 2(e)(1). Based on the foregoing, the Board *sua sponte* strikes the last sentence of paragraph 38.[1] See Fed. R. Civ. P. 12(f); TBMP Section 506.01.

Turning to applicant's combined motion to compel and motion to test the sufficiency of responses without objection to requests for admission, applicant seeks further substantive responses to its request for admission nos. 20-22 and interrogatory no. 10. In response, opposer contends

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[1] In paragraph 16 of the amended notice of opposition, opposer alleges fraud based on an allegedly false date of first use. Dates of use, even if false, are not considered material and therefore cannot form the basis of a fraud claim, so long as the mark at issue was in use as of the filing date of an involved use-based application. See *Hiraga v. Arena*, 90 USPQ2d 1102 (TTAB 2009). Dates of use set forth in an application are not evidence of use; rather, dates of use must be established by competent evidence. See Trademark Rule 2.122(b)(2).

For information regarding elements of fraud claims, see *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed.Cir. 2009) (fraud claim requires allegations of specific false statements of material fact made with the intent of obtaining or maintaining a registration to which defendant is not entitled), and *Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d 1478 (TTAB 2009) (allegations of fraud made on information and belief, without a recitation of specific facts upon which the belief is reasonably based are insufficient). However, the Board will consider the

that he served supplemental responses to request for admission no. 20 and interrogatory no. 10 concurrently with his brief in response to applicant's motion, and that applicant's motion is therefore moot.[2] Applicant, in its reply brief, contends that those responses remain insufficient and asks that requests for admission at issue be deemed admitted with opposer precluded from offering contrary evidence in the future.

A request for admission is essentially one to stipulate to certain facts as a means of narrowing issues in a case. See *National Semiconductor Corp. v. Ramtron Int'l Corp.*, 265 F.Supp.2d 71, 74 (D.D.C. 2003). Fed. R. Civ. P. 36(a) requires that the answering party admit or deny the matter set forth in the requests for admission, or detail the reasons why the party can do neither. An admission in response to a request for admission "conclusively establishe[s]" the matter that is subject of that request. Fed. R. Civ. P. 36(b). However, a denial in response to a request for admission is merely a refusal to stipulate to certain matter. See *Sinclair Oil Corp. v. Kendrick,* 85 USPQ2d 1032, 1036 fn.8 (TTAB 2007).

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allegations in paragraph 16 as part of opposer's other pleaded claims herein.

[2] Regarding opposer's contention that applicant's responses to discovery requests are deficient, see TBMP Sections 523.04 and 524.04.

A motion to test the sufficiency of responses to admission requests is solely a test of the legal sufficiency of those responses. See Fed R. Civ. P. 36(a); Trademark Rule 2.120(h). Disagreements regarding the veracity of such responses are matters to be determined at trial and are not properly the subject of a motion to test their sufficiency. See *National Semiconductor Corp. v. Ramtron Int'l Corp., supra.*

The Board finds initially that applicant made a good faith effort to resolve the parties' dispute prior to seeking Board intervention. See Trademark Rules 2.120(e)(1) and 2.120(h)(1).

In interrogatory no. 10, applicant asks opposer to explain any denials to its requests for admission.[3] In request for admission no. 20, applicant asks opposer to admit that Lavatec GmbH, his predecessor-in-interest, had not delivered any commercial laundry equipment for United States customers prior to the formation of Lavatec, Inc. in February 1987. In an October 28, 2011 response, opposer stated that he "does not [so] admit." In a May 1, 2012 supplemental response, opposer refers to Exhibit 30, a copy

[3] The Board notes, however, that a party is generally not required to stipulate to any fact. See *National Semiconductor Corp. v. Ramtron Int'l Corp., supra.* However, a request for admission may be deemed admitted as a sanction for failure to comply with a Board order compelling a further response to a request for admission. See Trademark Rule 2.120(g)(1); TBMP Section 527.03.

of a February 2, 1987 letter from Lavatec GmbH to Consulex Corporation of Spartanburg, South Carolina. Taken together, the Board will treat the responses as denying request for admission no. 20, based on Exhibit 30.[4] These responses are acceptable.[5]

In request for admission nos. 21-22, applicant asks opposer to admit that he has no documents from Lavatec GmbH prohibiting applicant from using and registering the involved LAVATEC mark in the United States. Information regarding whether or not opposer has such documents, as opposed to the content of those documents, is relevant, nonprivileged, and discoverable. See Fed. R. Civ. P. 26(b)(1); TBMP Sections 414(1) and (21). Accordingly, opposer's objections to these requests for admission are overruled.

Applicant's combined motion to compel and to test the sufficiency of responses to requests for admission is denied with regard to request for admission no. 20 and interrogatory no. 10, as it relates to that request, and

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[4] Invoices that opposer provided with its supplemental responses are in German. Board proceedings are conducted in English; documents in a language other than English are inadmissible at trial. See *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921 (TTAB 2011).

[5] Whether or not the aforementioned letter is evidence of delivery of commercial laundry equipment for United States customers prior to the formation of Lavatec, Inc. is a matter for resolution at trial. See *National Semiconductor Corp. v. Ramtron Int'l Corp., supra.*

granted with regard to request for admission nos. 21-22 and interrogatory no. 10, as it relates to those requests. Opposer is allowed until thirty days from the mailing date set forth in this order to serve supplemental responses to request for admission nos. 21-22 and interrogatory no. 10, if necessary.[6]

The caption of applicant's motion states that such motion is applicant's fourth motion to compel in this proceeding. In addition, a review of the Board file in this proceeding indicates that opposer has filed two motions to compel in this case. The Board, in exercising its inherent authority to control the conduct of its proceedings, will not entertain any further motions to compel or motions to test the sufficiency of responses to requests for admission unless the movant first obtains leave of the Board to so file in a telephone conference between the parties' attorneys and the Board attorney assigned to this case. The Board expects parties to cooperate in the discovery process and looks with disfavor upon those who do not. See TBMP Section 408.01.

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[6] If opposer does not comply with this order, applicant's remedy is to file a motion for sanctions under Trademark Rule 2.120(g)(1).

Applicant asks that opposer be precluded from introducing documents to support an assertion that applicant cannot use or register the involved mark. However, the Board does not preclude the introduction of documents preemptively. Applicant's remedy is to object at trial to the introduction of such documents pursuant to Fed. R. Civ. P. 37(c)(1).

The Board deems the filing of opposer's motion for leave to amend to have tolled the running of dates herein. Proceedings herein are resumed. Remaining dates are reset as follows.

Expert Disclosures Due	**10/2/2012**
Discovery Closes	**11/1/2012**
Plaintiff's Pretrial Disclosures	**12/16/2012**
Plaintiff's 30-day Trial Period Ends	**1/30/2013**
Defendant's Pretrial Disclosures	**2/14/2013**
Defendant's 30-day Trial Period Ends	**3/31/2013**
Plaintiff's Rebuttal Disclosures	**4/15/2013**
Plaintiff's 15-day Rebuttal Period Ends	**5/15/2013**

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.l25.

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.l29.

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