

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Mailed: December 3, 2014

Opposition No. 91206212

Carefusion 2200, Inc.

v.

entrotech, inc.

**George C. Pologeorgis,
Interlocutory Attorney:**

This case now comes before the Board for consideration of Applicant's combined motion (filed November 21, 2014) (1) to compel responses to Applicant's second set of interrogatories, (2) to compel production of documents to certain document requests set forth in Applicant's Second Set of Document Requests, (3) to compel Opposer's designated 30(b)(6) deponent to testify on certain topics for examination, and (4) to extend the close of discovery to allow Applicant to take follow-up discovery. Opposer filed a timely response to Applicant's combined motion on December 2, 2014.

The Board, in its discretion, suggested that the issues raised in Applicant's combined motion should be resolved by telephonic conference as permitted by TBMP § 502.06 (2014). The Board contacted the parties to discuss the date and time for holding the phone conference.

Opposition No. 91206212

The parties agreed to hold a telephone conference at 3:00 p.m. Eastern Time, on Tuesday, December 2, 2014. The conference was held as scheduled among Mary True, as counsel for Opposer, Erin Hickey, as counsel for Applicant, and George C. Pologeorgis, as a Board attorney responsible for resolving Applicant's combined motion.

The Board carefully considered the arguments raised by the parties during the telephone conference, as well as the supporting correspondence and the record of this case, in coming to a determination regarding the above matters. During the telephone conference, the Board made the following findings and determinations:

Applicant's Motion To Compel

The Board first turns to Applicant's motion to compel. The Board finds that Applicant has made a good faith effort to resolve the parties' discovery dispute prior to seeking Board intervention, as required by Trademark Rule 2.120(e)(1). Additionally, the Board finds that Applicant's motion is timely. *Id.*

The Board next turns to the merits of Applicant's motion to compel. Applicant's motion to compel is **GRANTED**, in part, **DENIED**, in part, deemed **MOOT**, in part, and **DENIED without prejudice**, in part, as set forth below.

The Board notes that Opposer, on November 24, 2014, filed a voluntary surrender of its pleaded Registration No. 4495083 for the mark

Opposition No. 91206212

CHLORASHIELD for “surgical incise tape.” During the telephone conference, Opposer’s counsel stated that Opposer would not rely on any common law rights in the mark CHLORASHIELD used in connection with “surgical incise tape” to support its asserted claims. In view thereof, Applicant’s motion to compel written discovery or deposition testimony regarding this registration and/or any common law rights associated with the CHLORASHIELD mark for “surgical incise tape” is deemed **MOOT** and will be given no further consideration. Opposer is not required to respond to any written discovery or provide any oral discovery testimony regarding this registration and/or any common law rights associated with the mark and goods identified in the registration.

1. Second Set of Interrogatory Requests

In support of its motion to compel, Applicant seeks responses to its second set of interrogatories. In response, Opposer maintains that, not only do the first set of Applicant’s interrogatories exceed the 75 limit permitted by Board rules, but the second set also exceed the permitted limitation.

The Board has reviewed Applicant’s first set of interrogatories and finds that the number of interrogatories, including subparts, set forth therein exceed the 75 limit permitted under Board rules. Accordingly, Applicant’s second set of interrogatories are impermissible because they further exceed the permissible 75 limit. The Board also finds that by not making a general objection to Applicant’s first set of interrogatories on the ground that they

Opposition No. 91206212

exceed the permissible 75 limit at the time it served its responses thereto, Opposer has not waived its right to object to Applicant's second set of interrogatories on the ground that these requests in combination with Applicant's first set of interrogatories exceed the permissible limit under Board rules.

In view of the foregoing, Applicant's motion to compel responses to its second set of interrogatories is **DENIED**. Moreover, Applicant is precluded from propounding any further interrogatories in this matter.

2. Topics For Oral Examination Of Opposer's Designated 30(b)(6) Witness

Examination Topic No. 4

Motion is **GRANTED** to the extent that Opposer's designated 30(b)(6)(6) witness must be able to testify competently regarding Opposer's relationship, collaboration and/or partnership with Avery Dennison Corporation, including, but not limited to its business under the trade name Vancive Medical Technologies, with respect antimicrobial catheter patch dressings offered and/or sold under Opposer's CHLORASHIELD mark.

Examination Topic No. 7

Motion is **GRANTED** to the extent that Opposer's designated 30(b)(6)(6) witness must be able to testify competently regarding the development, manufacture, production, distribution, marketing and/or sale of goods offered under Opposer's CHLORAPREP mark, as well as antimicrobial catheter patch dressings offered and/or sold under Opposer's CHLORASHIELD mark.

Opposition No. 91206212

Examination Topic No. 13

Motion is **GRANTED** to the extent that Opposer's designated 30(b)(6)(6) witness must be able to testify competently regarding the satisfaction, dissatisfaction, and/or complaints from consumers or the trade with respect to the goods offered and/or sold under Opposer's CHLORAPREP mark, as well as antimicrobial catheter patch dressings offered and/or sold under Opposer's CHLORASHIELD mark.

Examination Topic No. 28

Motion is **GRANTED** to the extent that Opposer's designated 30(b)(6)(6) witness must be able to testify competently regarding Opposer's general trademark enforcement policies, including the issuance of cease and desist letters, as well as any prior or current disputes that relate to Opposer's pleaded CHLORAPREP marks and Opposer's CHLORASHIELD mark used in association with antimicrobial catheter patch dressings. To the extent any of the disputes resulted in an actual litigation, Opposer's designated 30(b)(6)(6) witness need only provide testimony regarding the identification of the legal proceeding(s) by naming the parties involved, the jurisdiction where the case was litigated or is being litigated, the proceeding number, and stating the outcome of the litigation. Opposer's designated 30(b)(6) witness is not required to provide testimony regarding any particular filings made during any actual litigation.

Opposition No. 91206212

Examination Topic No. 38

Motion is **GRANTED** to the extent that Opposer's designated 30(b)(6)(6) witness must be able to testify competently regarding Opposer's filings with the Food and Drug Administration (the "FDA") which have been produced to Applicant which concern to the goods offered and/or sold under Opposer's CHLORAPREP mark, as well as antimicrobial catheter patch dressings offered and/or sold under Opposer's CHLORASHIELD mark.

Examination Topic No. 39

Motion is **GRANTED** to the extent that Opposer's designated 30(b)(6)(6) witness must be able to testify competently regarding Opposer's trademark filings which concern to the goods offered and/or sold under Opposer's CHLORAPREP mark, as well as antimicrobial catheter patch dressings offered and/or sold under Opposer's CHLORASHIELD mark.

Examination Topic No. 40

Motion is **GRANTED** to the extent that Opposer's designated 30(b)(6)(6) witness must be able to testify competently regarding companies, organizations, entities with whom Opposer ultimately engaged regarding the development, manufacture, production, distribution, marketing, advertising, and/or selling of antimicrobial catheter patch dressings offered and/or sold under Opposer's CHLORASHIELD mark. Opposer's designated 30(b)(6)(6) witness, however, is **NOT required** to testify as to companies, organizations, entities, or persons with whom Opposer may have preliminarily contacted

Opposition No. 91206212

but eventually did not collaborate and/or employ regarding the development, manufacture, production, distribution, marketing, advertising, and/or selling of antimicrobial catheter patch dressings offered and/or sold under Opposer's CHLORASHIELD mark.

Examination Topic Nos. 20-22

Motion is **DENIED** with regard to the above-identified examination topics. However, the Board notes that Opposer, in response to Applicant's combined motion, has stated that its designated 30(b)(6)(6) witness can testify to the fact that Opposer does not use the phrase "THE CHLORAPREP ADVANTAGE" as a slogan or in a trademark sense, and that Opposer was not aware of Applicant's trademark application for the mark THE CHLORHEXIDINE ADVANTAGE. Accordingly, Opposer's designated 30(b)(6)(6) witness should be prepared to testify competently as to these aforementioned matters.

Applicant's motion to compel is **DENIED** to the extent that Applicant seeks testimony from Opposer's designated 30(b)(6) witness regarding any communication, either oral or written, between Opposer and its counsel regarding the underlying facts and bases for the representations Opposer's counsel made when executing the declarations of Opposer's underlying applications and/or statements of use for its CHLORAPREP marks, as well as for its CHLORASHIELD mark used in association with antimicrobial catheter patch dressings. Additionally, Applicant's motion to compel is

Opposition No. 91206212

DENIED to the extent that Applicant seeks testimony from Opposer's designated 30(b)(6) witness as to the reasons why Applicant allowed its counsel to file the underlying applications and/or statements of use for its CHLORAPREP marks, as well as for its CHLORASHIELD mark used in association with antimicrobial catheter patch dressings.

3. Second Set of Document Requests

Document Request Nos. 76

Motion is **GRANTED** to the extent that Opposer must produce and/or provide supplemental responsive non-privileged documents referencing or concerning Opposer's collaboration with Avery Denninson Corporation, including but not limited to, its business under the trade name Vancive Medical Technologies, with respect to the product identified in Opposer's United States Registration No. 4488745 for Opposer's CHLORASHIELD mark from 2007 to the present, including, but not limited to all agreements and communications from 2007 to the present.

Document Request No. 77

Motion is **GRANTED** to the extent that Opposer must produce and/or provide supplemental responsive non-privileged documents referencing or concerning any company, organization, entity or person, with whom Opposer ultimately engaged in the development, manufacture, production, distribution, marketing, advertising, and/or selling the product identified in Opposer's United States Registration No. 4488745 for Opposer's

Opposition No. 91206212

CHLORASHIELD mark. To be clear, Opposer is **not** required to produce any documents to the above document request which concern any company, organization, entity or person with whom may have consulted with but eventually did not engage and/or employ and/or associate with regarding the development, manufacture, production, distribution, marketing, advertising, and/or selling the product identified in Opposer's United States Registration No. 4488745 for Opposer's CHLORASHIELD mark.

Document Request No. 78

Motion is **GRANTED** to the extent that Opposer must produce and/or provide supplemental responsive non-privileged documents that support Opposer's alleged *bona fide* intention to use the CHLORASHIELD mark in United States commerce with respect to goods identified in United States Registration No. 4488745 at the time Opposer applied to register the mark on June 1, 2010.

Document Request No. 79

Motion is **GRANTED** to the extent that Opposer must produce and/or provide supplemental responsive non-privileged documents that support Opposer's basis for filing its Statement of Use for the CHLORASHIELD mark in the United States commerce with respect to goods identified in United States Registration No. 4488745 on December 13, 2013. Motion is otherwise **DENIED** to the extent Applicant seeks documents regarding the basis of

Opposition No. 91206212

Opposer's counsel of record had for signing the declaration in support of the Statement of Use.

If there are no responsive, non-privileged documents in Opposer's possession, custody or control which are responsive to the above-identified document requests, Opposer must so state in its response to the document request.

To the extent Opposer has already produced all documents responsive to the above-identified requests, Opposer must so state in its response to the particular document request.

Document Request Nos. 83 and 90

Motion is **DENIED** with regard to each of the above-identified document requests.

Document Request No. 75

Motion is deemed **MOOT** with regard to the above identified request because Oppose stated during the telephone conference that it has already produced documents responsive to this request regarding the products identified in Opposer's pleaded Registration No. 4488745. Additionally, the motion is **MOOT** to the extent it seeks documents regarding Opposer's pleaded Registration No. 4495083. Motion is otherwise **DENIED** to the extent it seeks documents regarding any other entity's FDA filings concerning the products identified in Opposer's pleaded Registration No. 4488745.

Opposition No. 91206212

Document Request No. 80

Motion is deemed **MOOT** with regard to the above identified document request inasmuch as its seeks documents concerning Opposer's Registration No. 4495083 which is no longer subject to this case in light of the Opposer's voluntary surrender of the same.

Document Request No. 84

During the telephone conference, Applicant's counsel was not able to confirm whether Opposer's supplemental document production included documents that were responsive to the above-identified document request concerning any research, studies, pilot studies, clinical trial or testing conducted **by Opposer** to develop the goods identified in United States Registration No. 4488745. In view thereof, Applicant's motion to compel documents to the above request, as limited herein, is **DENIED without prejudice**. The motion is otherwise **DENIED** to the extent it seeks information regarding research, studies, pilot studies, clinical trial or testing conducted by any other entity.

During the telephone conference, Opposer's counsel stated that Opposer will make a good faith effort to produce documents to Applicant's Document Request Nos. 76-79, to the extent indicated herein, by close of business Wednesday, December 3, 2014 (Eastern time) in order to allow Applicant's counsel sufficient time to review the documents prior to Opposer's 30(b)(6)

Opposition No. 91206212

deposition to be held on Friday, December 5, 2014.¹ The Board hopes that Opposer will be able to do so. Notwithstanding, Opposer is hereby ordered to make such production no later than **close of business, Thursday, December 4, 2014 (Eastern time)**. To the extent Opposer has no responsive, non-privileged documents in Opposer's possession, custody or control which are responsive to the above-identified document requests or Opposer has already produced all documents responsive to the above-identified requests, Opposer must so advise Applicant no later than **close of business, Thursday, December 4, 2014 (Eastern time)** pursuant to the guidelines set forth herein.

Additionally, Opposer is required to provide Applicant a privilege log (or supplemental privilege log) to the extent that Opposer claims privilege to **any of Applicant's discovery requests**, if it has not already done so, by **close of business Thursday, December 4, 2014**. Opposer is advised that it should not include anything on the privilege log that does not fall under the attorney-client and/or work product privilege.

In the event Opposer fails to provide Applicant with full and complete responses to the outstanding discovery, as required by this order, Opposer will be barred from relying upon or later producing documents or facts at trial withheld from such discovery. *See* Fed. R. Civ. P. 37(c)(1).²

¹ Applicant's request to postpone Opposer's 30(b)(6) deposition is **DENIED**. The deposition will proceed as scheduled.

² If Opposer fails to comply with this order, Applicant's remedy lies in a motion for sanctions, pursuant to Trademark Rule 2.120(g)(1). Furthermore, the parties are

Opposition No. 91206212

Applicant's Motion To Extend The Close Of Discovery To Permit Follow-Up Discovery

As previously noted by the Board, discovery in this matter has been ongoing for two years. The Board finds that it has provided the parties ample time to pursue their respective discovery needs, including follow-up discovery. Accordingly, Applicant's motion to extend the close of discovery to conduct follow-up discovery is **DENIED**.

Trial Schedule

By order dated November 10, 2014, discovery in this matter was extended until December 22, 2014 for the sole purpose of allowing the orderly completion of the discovery depositions of Mr. Halsey and Mr. McGuire. Discovery otherwise close for all other purposes on **December 8, 2014**.

Remaining trial dates remain as reset by Board order dated November 10, 2014 and are restated below for the parties' convenience and reference:

Plaintiff's Pretrial Disclosures Due	2/5/2015
Plaintiff's 30-day Trial Period Ends	3/22/2015
Defendant's Pretrial Disclosures Due	4/6/2015
Defendant's 30-day Trial Period Ends	5/21/2015
Plaintiff's Rebuttal Disclosures Due	6/5/2015
Plaintiff's 15-day Rebuttal Period Ends	7/5/2015

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.

reminded that a party that has responded to a discovery request has a duty to supplement or correct that response. *See* Fed. R. Civ. P. 26(e).

Opposition No. 91206212

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