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

Proceeding	91210643
Party	Plaintiff Tristar Products, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

TRISTAR PRODUCTS, INC.,

Opposer/Petitioner,

vs.

BLUE GENTIAN, LLC,

Applicant/Registrant.

Opposition No. 91210643

Mark: design mark

Serial No. 85/684,030

(parent case)

Cancellation No. 92057408

Mark: design mark

Registration No. 4,351,590

**OPPOSER/PETITIONER'S OPPOSITION TO
APPLICANT/REGISTRANT'S MOTION TO COMPEL DISCOVERY RESPONSES**

I. INTRODUCTION

Opposer/Petitioner, TRISTAR PRODUCTS, INC. (“Tristar”) hereby opposes Applicant/Registrant’s, BLUE GENTIAN, LLC’s (“Blue Gentian”) motion to compel discovery responses, and respectfully requests the Board deny entry of an order compelling Tristar to provide answers to certain interrogatories and production of certain documents demanded by Blue Gentian.

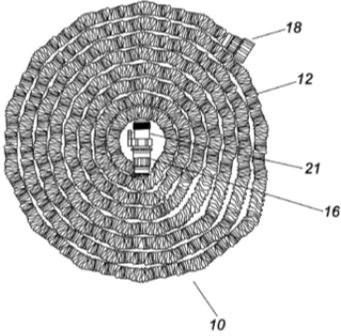
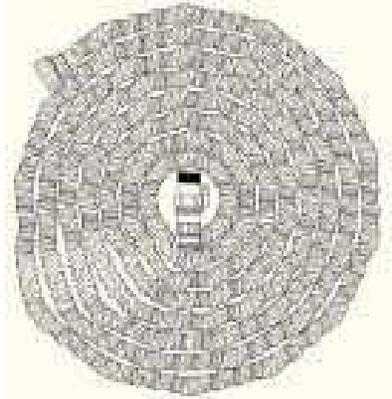
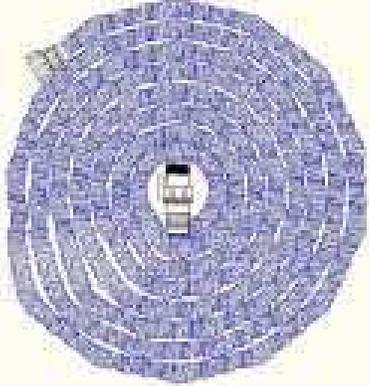
Blue Gentian’s is engaged in a far-ranging, fishing expedition for irrelevant material to support its patent infringement contentions. The information requested has no bearing on any claim or defense pertinent to these proceedings.

Tristar has alleged three bases for opposition and/or cancellation to Blue Gentian’s involved application and registration. Specifically, that the marks are generic and/or descriptive (Count I); that the involved application and registration should have been refused as functional under Section 2(e)(5) (Count II); and that the involved application and registration should have been refused under Sections 1, 2 and/or 45 for failure to function as a trademark (Count III). It is important to note that Tristar has not alleged likelihood of confusion as a basis for refusal or cancelation of Blue Gentian’s involved application and registration. Bearing this situation

in mind, it is evident that Tristar's sales information and documents supporting the same, which Blue Gentian has demanded and has filed this Motion to Compel, are irrelevant to the proceeding because they have no bearing on proving or disproving the counts alleged in this proceeding. Furthermore, the requested information has no bearing on any defense or counterclaim that Blue Gentian could raise in defense of these proceedings. Whether Tristar has, indeed, suffered damage by Blue Gentian's involved application and registration is clearly evident by the fact that Tristar is a competitor to Blue Gentian. Accordingly, Tristar has a commercial interest and thus standing to prosecute these opposition and cancellation proceedings. TBMP § 303.03.

Moreover, Tristar's belief that it will be damaged is more than buttressed by the fact the Blue Gentian has already sued Tristar for patent infringement, as so noted in the facts of the opposition and cancellation (*see, e.g., Amended Notice of Opposition*, p.2-3) and Blue Gentian's Memorandum in Support of the Motion to Compel (p.1-2). Tristar offered to settle these proceedings if Blue Gentian promised not to enforce the involved application and registration against Tristar, but Blue Gentian refused this settlement offer. Accordingly, Tristar has a reasonable belief that Blue Gentian may sue Tristar for trademark infringement and/or violation(s) of the Lanham Act over the involved application and registration.

Furthermore, the crux of the dispute with whether Blue Gentian's marks are product configurations, functional or generic/descriptive, which further has no bearing on Tristar's sales and confidential business information. As can be seen in Fig. 1 of Blue Gentian's own US8479776 and US8757213, reproduced below, Blue Gentian's marks are a mirror image of the patent drawing, providing a strong if not overwhelming *prima facie* case that Blue Gentian's marks are, indeed, functional, do not function as trademarks, and are a product configuration. Accordingly, discovery should be limited in these proceedings to the issues that have bearing on the disputed issues.

 <p data-bbox="321 636 370 657">Fig. 1</p>		
<p data-bbox="212 684 526 747">Fig. 1 of US8479776 and US8757213</p>	<p data-bbox="724 699 911 730">The '590 Mark</p>	<p data-bbox="1187 699 1377 730">The '030 Mark</p>

Therefore, Tristar respectfully requests that the Blue Gentian Motion to Compel be dismissed.¹

II. ARGUMENT

a. Interrogatories Nos. 5-16 and Requests for Production Nos. 8-19

Blue Gentian improperly demands responses to several interrogatories and documents for sales information of Tristar's Flex-Able Hose product. Interrogatories 5 and 6 demand the amount of sales, stated in number of units, of Tristar's Flex-Able Hose before and after the filing date, respectively, of the '030 Mark; Interrogatories 7 and 8 demand the amount of sales, stated in dollars, of Tristar's Flex-Able Hose before and after the filing date, respectively, of the '030 Mark; Interrogatories 9 and 10 demand profits from sales of Tristar's Flex-Able Hose before and after the filing date, respectively, of the '030 Mark.; Interrogatories 11 and 12 demand the amount of sales, stated in number of units, of Tristar's Flex-Able Hose before and after the filing date, respectively, of the '590 Mark; Interrogatories 13 and 14 demand the amount of sales, stated in dollars, of Tristar's FLEX-ABLE HOSE before and after the filing date, respectively, of the '590 Mark; and, finally,

¹ Blue Gentian further asserts that Tristar served its discovery ten days late. (Memorandum p.2.) But by agreement, Tristar had until September 29, 2014, to serve its responses with Blue Gentian. Tristar further supplemented its response to Interrogatories, 1, 17, 20 and 21 on September 26, 2014, after discussion with Blue Gentian, still within the extended September 29, 2014, due date.

Interrogatories 15 and 16 demand profits from sales of Tristar's FLEX-ABLE HOSE before and after the filing date, respectively, of the '590 Mark.

Requests for Production Nos. 8-19 demand all documents things supporting the sales information disclosed in Interrogatories 5-16.

First, as described above in the introduction section, Tristar's sales are wholly irrelevant to these proceedings. Tristar is clearly a competitor to Blue Gentian and has standing to file petitions in these proceedings. Whether Tristar sold one or one million competing products does not change that status. Second, the number, dollar amount, or profit of Tristar's products is not likely to lead to additional discoverable evidence. The only purpose to discover Tristar's sales is to calculate damages, but the Board has no authority to award damages. It can only be assumed that Blue Gentian wants this information for use in its patent infringement lawsuit.

In support of its position, Blue Gentian argues that the Board has previously held that sales information is relevant in an opposition or cancellation proceeding, and cites *Sunkist Growers, Inc. v. The Benjamin Ansehl Co.*, 229 USPQ 147, 148 (TTAB 1985); however, *Sunkist Growers* is directed to the relevance of sales information of the *Applicant* for the issues of likelihood of confusion and abandonment. *Id.* Here, where abandonment and likelihood of confusion are not bases for cancellation/opposition, the sales of the opposer's/petitioner's goods have no evidentiary value.

Blue Gentian further argues that this information is relevant to determine the performance of Tristar's product in the marketplace. This argument is specious. There is no requirement that Tristar prove that it has lost sales since Blue Gentian obtained its registration or filed for its application. The mere existence of the involved application and registration is sufficient to provide Tristar, a competitor in the marketplace, standing to file an opposition and/or cancellation. *See Books on Tape Inc. v. Booktape Corp.*, 836 F.2d 519, 5 USPQ2d 1301, 1302 (Fed. Cir. 1987) ("Petitioner, a competitor of respondent, clearly has an interest in the outcome beyond that of the public in general and has standing"); *International Order of Job's Daughters v. Lindeburg and Co.*, 727

F.2d 1087, 220 USPQ 1017, 1020 (Fed. Cir. 1984) (finding sufficient the petitioner's production and sale of merchandise bearing the registered mark.) Blue Gentian wants Tristar's number of units sold, total dollars amounts and profits for use in Blue Gentian's patent infringement lawsuit. Blue Gentian wants to be able to calculate patent damages. The proper place for Blue Gentian to seek damages discovery is in its lawsuit in federal court, not at the Board.

Accordingly, the motion to compel answer and production for Interrogatories Nos. 5-16 and Requests for Production Nos. 8-19 should be denied.

b. Requests for Production Nos. 22 and 25

Blue Gentian improperly demands confidential information on Tristar's Flex-Able Hose product, including, (RP No. 22) all documents and things pertaining to the market for the Flex-Able Hose, including, but not limited to, price points, market segments, customer base, competition, and anticipated and actual market share, and (RP No. 25) all annual reports, financial statements, prospectuses, business plans, and strategic plans related to the Flex-Able Hose in the United States.

These proceedings are about whether Blue Gentian's marks are generic/descriptive, functional, fail to function as trademarks, and/or are, in fact, product configurations. Likelihood of confusion has not been alleged by Tristar. Accordingly, Blue Gentian's demands for Tristar's confidential business information for the Flex-Able Hose exceed the scope of these proceedings. Blue Gentian is demanding this information to harass Tristar and for use in its patent infringement lawsuit.

Accordingly, the motion to compel production of documents and things demanded in Requests for Production Nos. 22 and 25 should be denied.

c. Interrogatory No. 20

Blue Gentian complains that Tristar has not provided a description of the particular subject matter set forth in the allegation of the petitions in these proceedings each named witness has knowledge. The response is that both Keith Mirchandani and Adam Levy are familiar with all the allegations set forth in Tristar's petition

and opposition in these proceedings.

d. Request for Production No. 1

In Blue Gentian’s Request for Production No. 1, Blue Gentian demands Tristar provide copies of documents identified in its initial disclosures. In particular, Blue Gentian complains that Tristar has not provided documents identified in items 12-15, namely, (12) documents reflecting Applicant/Registrant’s goods;² (13) documents reflecting the genericness, mere descriptiveness, or descriptiveness of Applicant/Registrant’s Marks; (14) documents reflecting that Applicant/Registrant’s mark comprises matter, as a whole, is functional; and (15) documents reflecting that Applicant/Registrant’s Marks failure to function as a trademark.

Blue Gentian argues that these documents are producible by Tristar. The answer is Tristar produced all the documents in its possession that are not already public documents. Tristar is not obligated to produce copies of documents already in Blue Gentian’s possession or are otherwise public documents that Blue Gentian can retrieve itself. Tristar is not withholding otherwise producible documents for items 12-15.

Accordingly, the motion to compel production of documents and things demanded in Requests for Production No. 1 should be denied.

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² Blue Gentian appears to misread this statement and incorrectly asserts that “they purportedly reflect: Tristar’s goods – i.e., the Flex-Able Hose.” Tristar is referring to documents about Blue Gentian’s goods.

III. CONCLUSION

In light of the above arguments, Tristar respectfully requests that Blue Gentian's Motion to Compel be denied in its entirety. Blue Gentian is using discovery in this forum as a vehicle to obtain information for its patent infringement lawsuit. The Board should deny this abuse of process.

Date: October 27, 2014

Respectfully submitted,

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that the foregoing **OPPOSER/PETITIONER'S OPPOSITION TO APPLICANT/REGISTRANT'S MOTION TO COMPEL DISCOVERY RESPONSES** was served to counsel via e-mail and U.S. First Class Mail on October 27, 2014. Counsel includes:

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