

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

DUNN

Mailed: September 22, 2009

Cancellation No. 920044697

ACM Enterprises, Inc.

v.

Jeannette Martello

Elizabeth A. Dunn, Attorney (571-272-4267):

This case comes up on petitioner's combined motion to compel supplemental responses to interrogatories and to test the sufficiency of respondent's responses to requests for admission. The motion is contested, and in view of the long pendency of the motion, the Board held a phone conference on September 21, 2009. The participants were David Hong, attorney for petitioner, Jeannette Martello, respondent, acting pro se, and Elizabeth Dunn, attorney for the Board.¹

BACKGROUND

Jeannette Martello has registered the mark "SKIN DEEP" for "medical services; healthspa services, namely cosmetic

¹ Contrary to the information conveyed during the conference, Elizabeth Dunn now is assigned to this case and will address future interlocutory matters.

body care services; cosmetician services; physician services" (Registration No. 2932593), the subject of the instant petition to cancel, and also owns registrations for the mark SKIN DEEP for radio show services (Registration No. 2777522), a magazine (Registration No. 3094594), and retail stores service (Registration No. 3387207), all in the fields of medicine, surgery, health, health care, beauty, skin care, cosmetic surgery and plastic surgery.²

ACM Enterprises, Inc. owns a pending application for SKIN DEEP LASER MEDSPA for services providing cosmetic treatments (Application Serial No. 78569772), against which Registration No. 2932593 was cited as a bar to registration and which is now suspended pending the outcome of this proceeding.³ ACM Enterprises, Inc.'s petition to cancel Registration No. 2932593 alleges claims of grounds of priority and likelihood of confusion, nonuse, and fraud.

On February 22, 2006, petitioner served respondent with its second set of interrogatories, document requests, and requests for admission. After two extensions of time were

² Respondent also owns pending applications for SKIN DEEP for dermatological pharmaceutical products (Application Serial No. 78763028), and MORE THAN SKIN DEEP for non-medicated skin care preparations and dermatological pharmaceutical products (Application Serial No. 78787667).

³ Petitioner also owns pending Application Serial No. 78569898 for SKIN DEEP LASER MEDSPA for cosmetics. On September 2, 2009, the examining attorney assigned to both of respondent's applications noted the recent issuance of respondent's Registration No. 3387207 and cited it as a bar to registration in both applications.

granted, respondent served responses on April 19, 2006. Proceedings then were largely suspended pending petitioner's motion to compel (filed April 21, 2006) and petitioner's motion to amend the petition to cancel and for summary judgment (filed August 3, 2007), both of which were denied, and pending settlement discussions between the parties. Discovery was extended by Board order to January 5, 2007, and on that date petitioner filed a third set of requests for admissions. Respondent served responses on February 20, 2007. Opposer sent letters stating the reasons it found the responses to both the interrogatories and the requests for admissions to be deficient on February 28, 2007 and March 21, 2007. Respondent never responded to the letters and on September 11, 2008, petitioner again requested supplemental responses.

The Board notes that petitioner has provided the requisite copies of the disputed discovery requests and responses, and the combined motion is supported by evidence of petitioner's good faith effort to resolve the disputed before bringing the motion before the Board. Trademark Rule 2.120(e).

PETITIONER'S MOTION TO COMPEL SUPPLEMENTAL RESPONSES TO INTERROGATORIES NOS. 20-22 IS GRANTED

Interrogatories Nos. 20-22 request different information regarding use of the mark with the goods listed

in the registration by Sara Herrick, respondent's predecessor. In response respondent objected that each interrogatory is "vague, ambiguous, and overbroad", which is plainly not the case. In response to petitioner's motion to compel, respondent contends that the information sought is irrelevant and moot, and would be more readily obtained directly from Ms. Herrick.

"The purpose of discovery is to provide information which may aid a party in the preparation of its own case or in the cross-examination of its adversary's witnesses. It is unfair for a party to withhold documents requested or refuse to answer interrogatories posed by its adversary or, as appears to be the case here, fail to make a complete investigation to locate the information." *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1719 (TTAB 1987). Inasmuch as petitioner has brought claims of priority and likelihood of confusion and fraud relating to respondent's priority and use, the nature and extent of the first use of the mark is plainly relevant. Moreover, it is not for respondent to decide that Ms. Herrick would be a better witness. As discussed, the necessary investigation to respond to the interrogatories pertains to respondent's own records. There is no obligation for respondent to interview Ms. Herrick. Rather, to the extent that respondent has records reflecting the requested information, respondent is

expected to consult those records when preparing her response.

Petitioner's motion to compel is granted, and respondent is allowed until thirty days from the mailing date of this order to serve its supplemental responses to Interrogatories No. 20-22.

As discussed, absent extraordinary circumstances, the supplemental responses to interrogatories will not support a motion to reopen discovery.

PETITIONER'S MOTION TO TEST THE SUFFICIENCY OF RESPONDENT'S RESPONSES TO REQUESTS FOR ADMISSION IS DENIED

Fed. R. Civ. P. 36(a) requests for admission are particularly useful for determining, prior to trial, which facts are not in dispute, thereby narrowing the matters that must be tried, and as a means of facilitating the introduction into evidence of documents produced by an adversary in response to a request for production of documents. *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2D 1393, 1394 (TTAB 2007) ("The facts set out below are not in dispute ... [but] have been admitted by applicant in response to opposer's requests for admissions"); *Proquest Information and Learning Company v. Jacques R. Island*, 83 USPQ2d 1351 at fn 6 (TTAB 2007) ("In its response to opposer's Request for Admission ..., applicant admitted that all documents it produced in response to opposer's discovery requests were

authentic for purposes of admission into evidence during the testimony period in this opposition proceeding."). However, requests for admission are not an appropriate tool for settling factual disputes. "Strictly speaking Rule 36 is not a discovery procedure at all, since it presupposes that the party proceeding under it knows the facts or has the document and merely wishes its opponent to concede their genuineness. ... A party who desires to discover what the facts are should resort to other discovery rules rather than Rule 36." 8A Fed. Prac. & Proc. Civ.2d §2253 (citations omitted).

The disputed requests for admission addressing similar issues will be discussed together.

21. Admit that healthspa services include microdermabrasion.
22. Admit that healthspa services include treatment for acne.
23. Admit that healthspa services include cleansing and exfoliation of the skin.

Inasmuch as health spa services may vary, respondent's objection that the request for admission is overbroad is sustained.

50. Admit that the "SKIN DEEP" radio program is a type of entertainment service.
51. Admit that Respondent Jeanette Martello as a licensed California physician must perform a good faith in-person examination of a patient or of the patient's records before providing medical or physician services to the patient.
52. Admit during Respondent Jeanette Martello's "SKIN DEEP" radio program, the Respondent cannot confirm whether a caller to her program is

reporting accurate or truthful information during her radio show.

53. Admit that a good faith in-person examination of a patient enhances the opportunity for a physician to confirm if a patient needs a certain medication or treatment.

54. Admit that a good faith in-person examination of a patient enhances the opportunity for a physician to confirm the suspected medical conditions.

55. Admit that a good faith in-person examination of a patient enhances the opportunity for a physician to advise the patient of alternative treatment options and to determine if the patient is aware of potential side effects.

56. Admit that a good faith in-person examination of a patient enhances the opportunity for a physician to rule out other medical conditions.

Inasmuch as the requests do not bear on facts which need to be proven as part of petitioner's case, respondent's objection that the request for admission is overbroad, vague, and ambiguous is sustained.

71. Admit the listeners of the radio show "SKIN DEEP" look for Dr. Jeannette Martello, M.D. in So. Pasadena, CA.

72. Admit that looking up the term SKIN DEEP on the Yahoo.com Yellow Pages for the Pasadena, CA location, the search results list "Skin Deep Lazor [id] Med Spa," 425 South Fair Oaks Avenue, Pasadena, CA 91105. [See Exhibit]."

Inasmuch as the requests do not bear on facts which need to be proven as part of petitioner's case, respondent's objection that the request for admission is overbroad is sustained.

Because respondent's responses are deemed sufficient, petitioner's motion to test the sufficiency of respondent's responses to request for admission is denied.

DEFICIENT PLEADING OF FRAUD

On review the Board notes that the petition to cancel does not state a legally sufficient claim of fraud. The petition alleges (¶11-12):

11. On information and belief, Petitioner alleges respondent's registration for "SKIN DEEP" was obtained fraudulently in that the respondent failed to use the mark in commerce as applied in the following applications. Said statement was made by an authorized agent of respondent (Jeannette Martello) with the knowledge and belief that said statement was false.
12. Said false statement was made with the intent to induce authorized agents of the U.S. Patent and Trademark Office to grant said registration, and, reasonably relying upon the truth of said false statements, the U.S. Patent and Trademark Office did, in fact, grant said registration to respondent.

Fraud in procuring a trademark registration occurs when an applicant knowingly makes false, material representations of fact in connection with his application. *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 48 (Fed. Cir. 1986). There is no fraud if a false misrepresentation is occasioned by an honest misunderstanding or inadvertence without a willful intent to deceive. *Smith Int'l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981). The standard for finding intent to deceive requires more than proof that the trademark applicant should have known of the falsity of its material representations of fact. *See In re Bose Corp.*, ___ F.3d ___, ___ USPQ2d ___ (Fed. Cir., August 31, 2009).

Fed. R. Civ. P. 9(b) requires that the pleadings contain explicit rather than implied expression of the circumstances constituting fraud. *King Auto., Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 212 USPQ 801, 803 (CCPA 1981). The Board will not approve pleadings of fraud which rest solely on allegations that the trademark applicant made material representations of fact in its declaration which it "knew or should have known" to be false or misleading. *In re Bose Corp.*, ___ F.3d ___, ___ USPQ2d ___ (Fed. Cir., August 31, 2009). Pleadings of fraud made "on information and belief" where there is no separate indication that the pleader has actual knowledge of the facts supporting a claim of fraud also are insufficient. *Id.* Here, petitioner fails to plead its actual knowledge of the facts surrounding its fraud claim and fails to plead specific circumstances which if proven would establish respondent's willful intent to deceive.

Petitioner is allowed until thirty days from the mailing date of this order to file an amended petition to cancel with a legally sufficient pleading of fraud, failing which the proceeding will go forward only as to the issues of priority and likelihood of confusion, and nonuse.

If an amended petition to cancel is filed, respondent has thirty days to file its answer.

As discussed, the requirement for an amended fraud claim is not an opportunity for either party to expand the pleaded claims and defenses. Such amendment would require a separate Fed. R. Civ. P. 15 motion supported by convincing evidence that the delay in bringing the new claim was due to exceptional circumstances.

TESTIMONY DEPOSITIONS

Unless privileged or confidential, when an objection is made to a question propounded during a testimony deposition, the question ordinarily should be answered subject to the objection. In those cases where the witness in a testimony deposition refuses to answer a particular question, and the Board finds at final hearing that the objection was not well taken, the Board may presume that the answer would have been unfavorable to the position of the party whose witness refused to answer, or may find that the refusal to answer reduces the probative value of the witness's testimony.

Health-Tex Inc. v. Okabashi (U.S.) Corp., 18 USPQ2d 1409, 1411 (TTAB 1990).

As discussed, to avoid delay and expense during a deposition, the parties are urged to serve notices of deposition as far in advance of the deposition as possible, to include with the notices of deposition a detailed list of the subjects of the deposition, and to confer by phone about

questions on the relevance of the subjects listed on the notice of deposition, and potential objections or refusals to answer which could arise during either examination or cross-examination. Before the deposition takes place and before filing any papers, disputes regarding the scheduled deposition should be brought to the Board's attention by calling the assigned Board attorney at the number listed above. The Board attorney will determine if briefing is necessary.

DATES ARE RESET BELOW:

DISCOVERY PERIOD:	CLOSED
Thirty-day testimony period for party in position of plaintiff to close:	January 5, 2010
Thirty-day testimony period for party in position of defendant to close:	March 6, 2010
Fifteen-day rebuttal testimony period to close:	April 20, 2010

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.

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.
