

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

MBA

Mailed: August 29, 2008

Cancellation No. 92046037

Bryan Corporation

v.

Novatech SA

Michael B. Adlin, Interlocutory Attorney:

This case now comes up for consideration of respondent's motion for summary judgment, filed November 30, 2007. Petitioner has not substantively responded to respondent's motion, but instead filed a cross-motion, pursuant to Fed. R. Civ. P. 56(f), for discovery which petitioner claims is necessary to respond to respondent's motion for summary judgment.¹ Respondent opposes the cross-motion, which is fully briefed and ready for decision. The delay in acting on it is regretted.

By way of background, respondent requests summary judgment on petitioner's claims of likelihood of confusion

¹ On November 30, 2007, petitioner filed a motion to compel discovery responses which, because it seeks the same discovery as requested in the cross-motion, is effectively identical to and subsumed by the cross-motion. It will therefore not be further considered.

and fraud, alleging that: (1) petitioner's allegation of standing is based solely on its alleged proprietary rights in the term STERILE TALC POWDER, and because there is no genuine issue of material fact that STERILE TALC POWDER is generic for petitioner's goods, petitioner lacks standing; (2) "it is impossible for there to be a likelihood of confusion" between the mark shown in respondent's registration² and petitioner's alleged mark, because petitioner's "mark" is generic; and (3) there is no genuine issue of material fact with respect to petitioner's fraud claim, because petitioner "can offer no evidence" that respondent procured its registration by "false means" or that respondent falsely stated that it believed it was entitled to use its mark in commerce.

In its cross-motion, which is supported by the declaration of petitioner's counsel, petitioner alleges that because respondent "refused to meaningfully respond to one of [petitioner's] proper discovery requests, [petitioner] has not been able to fully develop the factual record with respect to [petitioner's] fraud claim, on which [respondent] has moved for summary judgment." Specifically, petitioner claims that respondent's response to petitioner's Second Set

² Registration No. 3093389, issued May 16, 2006 under Section 66(a), for STERITALC, in standard characters, for use in connection with "Pharmaceutical products containing talcum powder, namely, pharmaceutical preparations containing talcum powder for the treatment of malignant pleural effusions"

of Interrogatories No. 5 is insufficient, even though the Board's order of October 3, 2007 overruled respondent's objection to this interrogatory and compelled respondent to respond to it. The interrogatory and respondent's supplemented response to it are as follows:

5. State whether your belief that you are "entitled to use the STERITALC mark in commerce, as set forth in the Declaration you signed in connection with your application Serial No. 79/008,374, means that on the date of the Declaration you believed you have the right to sell a drug that bears the name STERITALC in U.S. commerce.

ANSWER: Registrant incorporates by this reference the general objections set forth above. In addition, the interrogatory calls for information that is protected by the Attorney/Client privilege. Without waiving these objections or any others, the STERITALC mark was filed under 66(a) as an intent to use application and was based on an international registration. Registrant signed a Declaration in connection with application Serial No. 79/008,374. The Declaration meant that Registrant "believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive." Registrant relies solely on the statement as it is written in the Declaration contained within the application."

As explained in the Board's order of October 3, 2007, petitioner's fraud claim is based on the theory that because respondent did not have approval from the U.S. Food and Drug Administration ("FDA") to sell its goods under the mark

STERITALC, its declaration that it is entitled to use the mark in commerce, submitted in support of its application for registration, was fraudulent. See also, Petition for Cancellation ¶ 13 (respondent procured its registration by fraud, in "falsely alleging in a Declaration that Registrant believed it was entitled to use the mark in commerce, when Registrant did not then and still has not obtained approval from FDA to distribute its product in commerce or to use the name STERITALC."). Petitioner claims that "because information directed at [respondent's] state of mind is essential to [petitioner's] fraud claim (intent is an element of fraud) and because such information is exclusively within [respondent's] control, [petitioner] cannot meaningfully respond to [respondent's] Motion for Summary Judgment without first receiving [respondent's] adequate response to [petitioner's] contention interrogatory."

In its response to the cross-motion, respondent contends that its supplemental response to the interrogatory in question "complied with the Board's Order" of October 3, 2007. While not disputing that it did not specifically respond to the question posed in the interrogatory, respondent alleges that "[i]n the interrogatory, Petitioner has taken the term 'entitled to use,' a term of art in trademark law, and proceeds to supply an erroneous legal

definition [presumably the "right to sell"] to that term of art." In any event, respondent claims that its "supplemental answer to Petitioner's interrogatory makes it clear what [respondent's] state of mind was when filing its declaration." Finally, respondent claims that "the primary contention of its Motion for Summary Judgment is the issue of standing ... If Petitioner is found to lack standing, the Board will not be required to make a decision on the issues of likelihood of confusion or fraud."

In order to establish that it is entitled to discovery under Fed. R. Civ. P. 56(f), petitioner must show through affidavit (in this case the declaration of its counsel) that it "cannot for reasons stated present by affidavit facts essential to justify" its opposition to respondent's motion. See, Keebler Co. v. Murray Bakery Products, 866 F.2d 1386, 1389, 9 USPQ2d 1736, 1739 (Fed. Cir. 1989). Petitioner must do more than set forth a "speculative hope of finding some evidence" that would support its arguments, however. Sweats Fashions, Inc. v. Pannill Knitting Co. Inc., 833 F.2d 1560, 1566-67, 4 USPQ2d 1793, 1799 (Fed. Cir. 1987); Pure Gold, Inc. v. Syntex (U.S.A.), Inc., 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984). Rather, petitioner "should set forth with specificity the areas of inquiry needed to obtain the information necessary to enable" it to respond to the motion for summary judgment. TBMP § 528.06 (2d ed. rev. 2004).

"Unfocused requests" for discovery which lack specificity are not sufficient under Fed. R. Civ. P. 56(f). Keebler, 866 F.2d at 1390, 9 USPQ2d at 1739.

As a preliminary matter, we note that the Board's order of October 3, 2007 required respondent to respond to the interrogatory in question. While respondent provided a "response," in the sense that it did not merely object to the interrogatory, and instead provided a purported answer, it was not proper for respondent to essentially interpret the interrogatory as invalid and on that basis refuse to provide a real response to the question posed, after being ordered to serve a response. Indeed, if the interrogatory was found to be invalid when the Board reviewed it the first time, respondent would not have been compelled to respond to it.

In any event, petitioner has established that it is entitled to an actual response to the question actually posed in the interrogatory. First, and most importantly, while respondent's motion for summary judgment is primarily based on respondent's allegation that petitioner lacks standing, it is also based on respondent's claim that petitioner cannot come forward with evidence to support its fraud claim. As petitioner points out, the information responsive to the interrogatory in question directly relates to the fraud claim, and is uniquely within respondent's

control. Second, petitioner's request for discovery under Rule 56(f) is nothing if not specific and focused.

Petitioner seeks a single response to a single interrogatory. Respondent has already been ordered to respond to the interrogatory, and failed to do so. For these reasons, petitioner's cross-motion is **GRANTED**, and respondent is allowed until **FIFTEEN DAYS** from the mailing date of this order to respond to petitioner's Second Set of Interrogatories No. 5. Petitioner is allowed until **FORTY FIVE DAYS** from the mailing date of this order to file its response to respondent's motion for summary judgment.

To avoid any confusion or further delay, respondent must answer the question posed, and petitioner must respond to respondent's motion for summary judgment, within the time provided herein. Any failure by either party to do this will be at its own peril. To answer the question posed in the interrogatory, respondent must indicate whether it believed, on the date it signed the declaration in question, that it had "the right to sell a drug that bears the name STERITALC in U.S. commerce." It must provide this answer without citing, referring to or quoting its declaration, except that respondent may cite the date on which the declaration was filed. If, as last time, respondent believes the interrogatory is "erroneous," improper, confusing or unclear in any way, it may not so state in its

supplemental response, but must instead initiate a telephone conference with petitioner and the Board to discuss any issues it has with the interrogatory, well prior to the deadline for responding to it. Serving a supplemental response which, like the last one, questions the basis or substance of the interrogatory or refuses to answer the question posed is not permitted and will be grounds upon which petitioner may file a motion for sanctions. By the same token, once respondent complies with this order, petitioner may not seek to further delay responding to the motion for summary judgment, and any attempt to do so will be at its peril. In the event petitioner intends to do anything other than respond to the motion for summary judgment within the time provided, it must initiate a telephone conference with respondent and the Board to discuss its intention, well prior to the deadline for responding to respondent's motion for summary judgment.

Proceedings herein remain otherwise suspended pending disposition of respondent's motion for summary judgment.

News from the TTAB

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

Cancellation No. 92046037

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>

http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>
