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

Proceeding	92052897
Party	Defendant Galderma Laboratories, Inc.
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Date	06/12/2014
Attachments	Registrant's Motion to Strike Petitioner's Notice of Reliance.pdf(288004 bytes)

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

Thomas Sköld Petitioner,	§ § §	Cancellation No.: 92052897
v.	§ § §	Mark: RESTORADERM
Galderma Laboratories, Inc. Registrant.	§ §	Reg. Nos.: 2,985,751 and 3,394,514

REGISTRANT'S MOTION TO STRIKE PETITIONER'S NOTICE OF RELIANCE EXHIBITS T157 AND T158

Registrant, Galderma Laboratories, Inc., hereby moves the Trademark Trial and Appeal Board to strike from the record Petitioner's "Responsive Notice of Reliance" Exhibits T157 and T158, filed on May 14, 2014, under Trademark Rule 2.120(j)(5), 37 C.F.R. § 2.120(j)(5), and Fed. R. Civ. P. 36(b).[1]

I. Introduction & Background

On May 14, 2014, Petitioner sought to introduce, as Exhibits T157 and T158 to a "Responsive Notice of Reliance," his own responses to Registrant's requests for admissions ("Request" or "Requests"). However, Exhibits T157 and T158 consist collectively of inadmissible denials and objections; superfluous admissions already made of record through Registrant's March 31, 2014 Notice of Reliance; and unauthorized, and thus inoperative, "supplemental" admissions, which Petitioner served on Registrant without Board leave and filed with the Board (as Exhibit T158) on the same day.

Aside from the fact that each and every discovery response included in Petitioner's Exhibits T157 and T158 is inadmissible for one or more of the reasons noted above, Exhibit T157 should be stricken in its entirety for yet another reason. For most of the discovery responses in Exhibit T157, Petitioner failed to adequately explain how or why they were needed, as required by Trademark Rule 2.120(j)(5). As to the remaining responses—which were attached to the Responsive Notice but not listed in the Responsive Notice itself—no attempt at an explanation was even made.

[1] In addition to the issues addressed in the present Motion, Registrant has numerous substantive objections to the admissibility of Petitioner's Responsive Notice, which Registrant intends to raise in final briefing.

II. Argument

A. The Board should strike Exhibit T157 because only *admissions* to requests for admissions are admissible as evidence.

Only *admissions* made in response to requests for admissions are admissible through a notice of reliance, not denials and objections:

> [A]n *admission to a request for admission*[ ] may be submitted and made part of the record by only the inquiring party except that, if fewer than all of the . . . admissions are offered in evidence by the inquiring party, the responding party may introduce under a notice of reliance *any other* . . . *admissions*, which should in fairness be considered so as to make not misleading what was offered by the inquiring party.

37 C.F.R. § 2.120(j)(5) (emphasis added). *See also Turdin v. Trilobite, Ltd.*, 109 U.S.P.Q.2d 1473, 1477 (TTAB 2014) (noting that the rules governing submission of discovery responses through notice of reliance do not extend to denials); *Life Zone Inc. v. Middleman Group Inc.*, 87 U.S.P.Q.2d 1953, 1957 (TTAB 2008) (noting that a denial of a request for admission is not admissible). Petitioner, therefore, may not claim reliance on denials and objections to Registrant's Requests.

Yet, the only *admissions* included in Petitioner's Exhibit T157—namely, responses to Request Nos. 109, 116, 117, 203, and 205—had already been made of record through Registrant's March 31, 2014 Notice of Reliance, at Exhibit 8. All other responses in Exhibit T157 are denials and objections. Petitioner's Responsive Notice Exhibit T157 on its face offers no new, admissible evidence, and, accordingly, it should be stricken from the record.

B. The Board should strike Exhibit T157 because Petitioner did not explain why each discovery response offered was needed.

In attempting to offer his own discovery responses, Petitioner was required to pinpoint the relevance of each discovery response he wished to introduce to the discovery responses submitted by Registrant in its Notice of Reliance:

> The notice of reliance filed by the . . . responding party must be supported by a written statement explaining why the . . . responding party needs to rely upon *each* of the additional discovery responses listed in the . . . responding party's notice . . . .

37 C.F.R. § 2.120(j)(5) (emphasis added). *See also Holiday Inns, Inc. v. Monolith Enters.*, 212 U.S.P.Q. 949, 950 (TTAB 1981) (noting that a responding party seeking to introduce discovery responses which clarify, rebut, or explain those introduced by the requesting party must pinpoint the responses it seeks to introduce and show the relationship between that additional response and the response submitted by the requesting party).

Here, Petitioner's Responsive Notice of Reliance stated generally that responses to Request Nos. 101-108, 110-115, 125-131, 189-193, 199-202, 204, and 206, collectively, were necessary to put Registrant's Notice of Reliance "in context." The Board has consistently held that such broad and generalized statements are unacceptable as they do not make plain how or why the responses submitted by the responding party are needed, or which responses offered by the requesting party needed clarification. *See, e.g., Hiraga v. Arena*, 90 U.S.P.Q.2d 1102, 1105-06 (TTAB 2009) (additional discovery responses not properly made of record where proponent failed to offer an explanation as to why he needed to rely upon *each* of the additional responses); *Bd. of Trustees of the Univ. of Alabama v. BAMA-Werke Curt Baumann*, 231 U.S.P.Q. 408, 409 (TTAB 1986) (finding that broad statements regarding the necessity of various responses is insufficient).

Notably, Petitioner's bare, generalized statement that the responses were needed for "context" is only made with respect to the responses actually listed in the Responsive Notice. Eighteen (18) additional responses—namely, responses to Request Nos. 52-55, 109, 116-117, 132-133, 194-198, 203, 205, and 207-208—were attached to the Responsive Notice but not identified in the Responsive Notice itself. It appears that Petitioner merely failed to redact these unlisted responses, further disregarding Board procedure: "[T]he answering party is expected to select *only the relevant answer*[s] . . . ." *Heaton Enters. of Nevada, Inc. v. Lang*, 7 U.S.P.Q.2d 1842, 1849 n.5 (TTAB 1988) (emphasis added).

Petitioner cannot expect the Board or Registrant to determine which of the admissions previously filed by Registrant needed clarification, or how each response Petitioner filed clarified those answers. *See id.* The Board and Registrant are left guessing as to what relevance Petitioner's Exhibit T157 has.

C. Exhibit T158 should be stricken because it consists solely of two inoperative admissions.

Much like many of the responses included in Petitioner's Exhibit T157, the two admissions Petitioner sought to offer as Exhibit T158 were already made of record through Registrant's March 31, 2014 Notice of Reliance, except that Exhibit T158 features newly-revised versions of those admissions, which Petitioner attempted to amend by simply serving "supplementary" admissions on Registrant without having sought, or obtained, leave to do so.

Petitioner originally responded to Registrant's Request Nos. 116 and 117 on February 7, 2013 with unqualified admissions, stating: "Petitioner confirms this assertion." *See* Registrant's March 31, 2014 Notice of Reliance, Ex. 8. Any amendment to those admissions would have required Board approval:

> Any matter admitted (either expressly, or for failure to timely respond) under Fed. R. Civ. P. 36(a) is conclusively established unless the Board, on motion, permits withdrawal or amendment of the admission or the Board permits a reopening of the time for responding to the admission requests.

TBMP § 407.04; *see also* Fed. R. Civ. P. 36(b) ("A matter admitted under this rule is conclusively established unless the court, on motion, permits the admission to be withdrawn or amended."). Petitioner did not even request, let alone obtain, the Board's permission to amend his February 7, 2013 admissions. The two admission responses offered as Petitioner's Exhibit T158, therefore, are not operative and must be stricken from the record and given no effect.

III. Conclusion

In his May 14, 2014 "Responsive Notice of Reliance" Exhibit T157, Petitioner sought to introduce his own responses to Registrant's Requests for Admissions, pursuant to Trademark Rule 2.120(j)(5), 37 C.F.R. § 2.120(j)(5). However, Rule 2.120(j)(5) only applies to *admissions* made in

response to requests for admissions. Because Exhibit T157 does not include any admissions not already made of record through Registrant's Notice of Reliance, it should be stricken.

Petitioner's Responsive Notice also failed to explain why each of the discovery responses in Exhibit T157 was needed to clarify the discovery responses filed with Registrant's March 31, 2014 Notice of Reliance, as required by the Trademark Rules.

Petitioner's Exhibit T158 sought to introduce inoperative, revised responses to Request Nos. 116 and 117. As evidenced by Registrant's March 31, 2014 Notice of Reliance, Petitioner responded to Request Nos. 116 and 117 with unqualified admissions. On the day Petitioner filed his Responsive Notice, he attempted to amend those admissions by serving "supplemental" responses to Request Nos. 116 and 117, but such amendment is ineffective because Petitioner did not obtain leave from the Board to amend his admissions.

For the foregoing reasons, Registrant moves the Board to strike Petitioner's Responsive Notice of Reliance Exhibits T157 and T158.

Respectfully submitted,

Date: June 12, 2014

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this 12th day of June 2014, the foregoing *Registrant's Motion to Strike Petitioner's Notice of Reliance Exhibits T157 and T158* was served on Petitioner's counsel of record, via email to the following:

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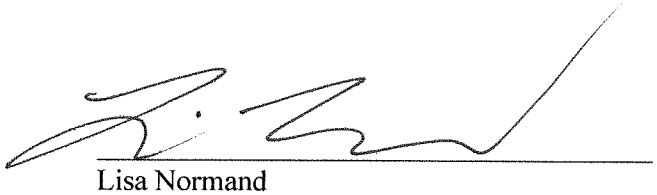

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