

UNITED STATES PATENT AND TRADEMARK  
OFFICE  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

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**MAILED: June 20, 2002**

Opposition No. 119,265

Yves Saint Laurent  
Fashion, B.V., Yves Saint  
Laurent International,  
B.V. and Yves Saint  
Laurent Couture

v.

Y&S Handbags

Before Seeherman, Hairston and Bucher, Administrative  
Trademark Judges.

By the Board:

This case now comes up on applicant's motion to compel  
(filed January 11, 2001) and applicant's motion for summary  
judgment (filed on March 15, 2001). The motions have been  
fully briefed by the parties.

The burden is on the party moving for summary judgment  
to demonstrate the absence of any genuine issue of material  
fact, and that it is entitled to summary judgment as a  
matter of law. See Fed. R. Civ. P. 56(c); and *Celotex Corp.  
v. Catrett*, 477 U.S. 317 (1986). The evidence of record and  
any inferences which may be drawn from the underlying  
undisputed facts must be viewed in the light most favorable  
to the non-moving party. See *Olde Tyme Foods, Inc. v.*

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*Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

In applicant's motion for summary judgment, applicant argues that the opposition should be dismissed because opposers cannot be further damaged by the registration of applicant's mark in view of applicant's ownership of Registration No. 1,713,676 for the same mark and goods involved in its present application, the so-called Morehouse defense. *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969). Applicant acknowledges that Registration No. 1,713,676 expired in 1998 for failure to file a Section 8 affidavit but argues that "[w]hether or not the equitable principles behind *Morehouse* apply should not depend solely on the existence of a pre-existing registration at the time of the second application for registration. The true inquiry is harm to the Opposer."

The proposition for which the *Morehouse* case stands is that, as a matter of law, an opposer cannot be damaged, within the meaning of Section 13 of the Trademark Act, by the issuance to an applicant of a second registration when applicant already has an existing, unchallenged registration of the same mark for the same goods. See also *O-M Bread, Inc. v. United States Olympic Committee*, 65 F.3d 933, 36 USPQ2d 1041 (Fed. Cir. 1995).

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Applicant's reliance on *Morehouse* is not well-taken in view of the fact that the registration on which applicant seeks to rely has expired. Therefore, applicant does not have an existing registration, as the *Morehouse* defense contemplates, upon which to rely.

Applicant also relies on the case of *Aquion Partners Limited Partnership v. Envirogard Products Limited*, 43 USPQ2d 1371 (TTAB 1997), which applicant argues is circumstantially similar to the case at hand. In *Aquion*, the applicant moved for summary judgment asserting, *inter alia*, that the opposer was barred by laches from opposing the registration of applicant's proposed mark because opposer therein failed to challenge applicant's previous registration for a similar mark and similar goods which had expired by the time of the opposition. The Board noted in *Aquion* that the burden of proof is on the party that raises the affirmative defense of laches and held that applicant failed to establish facts necessary to prove the elements of laches. *Id.* at 1372.

Upon careful consideration of the parties' arguments and submissions with respect to applicant's affirmative defense of laches, we find that genuine issues of material fact exist regarding the existence of the elements necessary to prove laches. Specifically, a genuine issue of material

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fact remains as to any material prejudice to applicant as a result of opposer's delay in asserting its rights.

We now turn to applicant's argument that it is entitled to summary judgment because "opposer[s] has failed to meet its burden as a matter of law of proving a likelihood of confusion." In opposers' opposition to applicant's motion for summary judgment, they contend that applicant "misunderstands its burden. For summary judgment to be appropriate, the burden is on the [applicant] ...to show that there are no genuine issues of material fact..." Opposers then argue that applicant has failed to meet this burden.

The Board finds that applicant has failed to carry its burden of establishing that no genuine issues of material fact exist and that it is entitled to judgment as a matter of law on opposers' claims of likelihood of confusion. At a minimum, genuine issues of material fact exist as to: (1) the similarity of the applicant's mark and opposers' marks; (2) the nature and extent of any actual confusion; and (3) the similarity or dissimilarity of trade channels.<sup>1</sup>

In view of the foregoing, and in accordance with Fed. R. Civ. P. 56(c), applicant's motion for summary judgment is denied. As stated above, applicant is not entitled to rely

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<sup>1</sup> The fact that we have identified and discussed only a few genuine issues of material fact as sufficient bases for denying the motion for summary judgment should not be construed as a finding that these issues are necessarily the only issues which remain for trial.

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on a *Morehouse* defense herein and there exists genuine issues of material fact on the issues of laches and likelihood of confusion.

We now turn to applicant's motion to compel discovery wherein applicant essentially seeks to compel more complete responses from opposers to its first request for the production of documents and first set of interrogatories. In the motion to compel, applicant asserts that it made a good faith effort, by telephone and correspondence with opposers' counsel, to resolve the discovery issues in the motion. In support of its motion to compel and stated efforts to resolve the discovery requests dispute, applicant submitted copies of two letters from applicant's counsel to opposers' counsel regarding the discovery disputes.

Opposers have opposed the motion to compel by arguing that applicant has "done nothing to address the meritorious objections made by opposer to applicant's discovery requests." Opposers point out that the parties were able to overcome some of opposers' earlier objections by entering into a stipulated protective agreement. Opposers also contend that they "remained willing to accommodate reasonable, appropriate requests, but the applicant has declined to address the problem of its ill considered language." In support of their argument that they have

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attempted to resolve the discovery disputes, opposers attached copies of two letters from opposers' counsel to applicant's counsel.

Upon review of the parties' arguments and attached copies of correspondence, the Board concludes that the parties have not made the required good faith effort to resolve the matters raised in the motion as contemplated by Trademark Rule 2.120(e). Accordingly, applicant's motion to compel is denied without prejudice. Applicant's counsel and opposers' counsel are both reminded that it is their obligation to cooperate in discovery in good faith, and to exchange appropriate discovery materials. If applicant's counsel and opposers' counsel are ultimately unable to resolve their discovery disputes, a second motion to compel pursuant to Trademark Rule 2.120(e) may be filed. However, the Board trusts and expects that the parties will comply with their discovery obligations, and that such a motion will not be necessary.

As some general discovery advice to both sides, the Board offers the following:

- (1) Fed. R. Civ. P. 33(a) requires that interrogatories be answered by the party under oath. Answers to interrogatories must be signed by the person making them, and objections to interrogatories must be signed by the attorney making them. See FRCP

33(b)(2). In applicant's motion to compel, applicant states that opposers' have failed to sign discovery responses. **To the extent that opposers have responded with unsigned discovery responses, opposers are hereby ordered to provide applicant with a signed copy thereof within twenty (20) days from the date of this order.**

- (2) It is standard Board practice to allow reasonable representative samples of documents in response to requests to produce "all" documents if responding to said request would otherwise be so voluminous as to be burdensome. See *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 149 (TTAB 1985). Therefore, if a party identifies all the documents, but produces reasonable representative samples because to produce all such documents would be unreasonable, then that party will have sufficiently responded to the other's discovery requests.
- (3) The parties are advised that if proper discoverable matter is withheld from the requesting party, the responding party will be precluded from relying on such information and from adducing testimony with regard thereto during its testimony period. See *Shoe Factory Supplies Co. v. Thermal Engineering Company*, 207 USPQ 517 (TTAB 1980); and *Presto*

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*Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d  
1895 (TTAB 1988).

Proceedings herein are hereby resumed and the discovery  
deadline and testimony periods are reset as follows.

THE PERIOD FOR DISCOVERY TO CLOSE:	August 27, 2002
Testimony period for party in position of plaintiff to close: (opening thirty days prior thereto)	November 25, 2002
Testimony period for party in position of defendant to close: (opening thirty days prior thereto)	January 24, 2003
Rebuttal testimony period to close (opening fifteen days prior thereto)	March 10, 2003

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

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