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

Proceeding	91162244
Party	Defendant INDIANA BOTANIC GARDENS, INC. INDIANA BOTANIC GARDENS, INC. 3401 WEST 37TH AV. HOBART, IN 46342
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Attachments	Applicant_Memo_Responding_to_Motion.pdf (6 pages)

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

In the Matter of Application Serial No.)	
76/543,753)	
)	
VITALITY FOODSERVICE, INC.)	Opposition No. 91/162,244
Opposer,)	
)	
INDIANA BOTANIC GARDENS, INC.)	
Applicant.)	

MEMORANDUM IN RESPONSE TO OPPOSER’S MOTION TO COMPEL

NOW COMES Applicant, Indiana Botanic Gardens, Inc., by its attorneys, BARNES & THORNBURG, L.L.P. and responds to Opposer’s Motion to Compel. Opposer to chose to write logically inconsistent definitions and upon receipt of responses with objections and a letter explaining the basis for their objections, refused to even attempt to redefine in order to solve the problem.

SUMMARY

Essentially, what is at issue is whether the rule for “common sense” in interrogatory definitions applies here. *Cory v. Aztec Steel Building, Inc.*, 225 FRD 667 (D KS, 2005) where Opposer defines “VITALITY mark” to include a three-word mark with “vitality” disclaimed. Applicant may object and respond using the common sense definition of “VITALITY mark” being the one word “VITALITY” mark.

PROCEDURAL BACKGROUND

There is no issue over the authenticity of the attachments to the affidavit of counsel for Opposer. Applicant disagrees with Paragraph 12 and argumentative and conclusory statements. Paragraph 8 is accurate as far as it goes, however, it does not reflect the position of counsel for Applicant that applicant would not attempt to compromise the issue over the interrogatories and the misleading definition.

Paragraph 12 OF Opposer's Affidavit is in error because it says "Vitality has not received any responses" because, of course, it is the adequacy of the responses received that is at issue. The exaggerated "repeated requests" include only the correspondence already attached and the conference in Paragraph 8 and telephone conversations in which a refusal to negotiate was advanced by Opposer.

A proposed protective order has just been sent. No privileged document log was ever discussed, it being an expectation (without waiving any privilege) that construction of such a log might be rendered unnecessary as to the bulk of the confidential document upon agreement to the protective order.

Counsel for Applicant writes as if they are in a big hurry, yet when the basis for the objections was clearly explained, counsel refused to amend their language to overcome the objections.

It appears there is no disagreement on the Interrogatories and Document Request numbers.

THE "VITALITY MARK"

A major substantive issue in this opposition is whether Applicant can extend its "choking hand into the market not its own". *S.C. Johnson & Sons, Inc. v. Johnson*, 175 F2d 176, 180, 81

USPQ 509, 513-514 (2d Circuit 1949) In the present motion, Opposer seeks to squeeze descriptive use of “Vitality Teas” into an admission that Applicant is using a “VITALITY mark” through definition A.

The reasons for this “squeeze” may be tactical, (hoping to trick Applicant into admissions), editorial (failing to differentiate between trademark use and descriptive use) strategic (for example, to preserve interrogatory numbers because of the general rule that definitions do not “multiply” interrogatory numbers before this Board) or for some other reason. However, when a valid objection is propounded, it is not incumbent on the respondent to guess at the interrogator’s preferred solution for clarification. Opposer refuses to negotiate.

Indeed, Applicant already answered so as to not make the admission that it does not use a “VITALITY mark”. In doing this, Applicant applies its own common sense definition that “VITALITY mark” has the ordinary meaning of VITALITY used as a word mark, but not a three-word mark which disclaims “VITALITY”. If Opposer wanted to know if Applicant has used “VITALITY” separately, it could have accomplished this through simple agreed changes to the Interrogatories, Document Requests or Definitions. Opposer chose to not even try. Alternatively, Opposer could have narrowed the issues by precisely asking interrogatories about the published mark at issue, GARDEN VITALITY TEAS with “vitality teas” disclaimed, a separate interrogatory on any other marks with “vitality” in them and a separate interrogatory, if they wanted (although not covered by the definition) about descriptive use. Undoubtedly, other courses could have overcome or avoided the objections.

Counsel for Opposer has chosen to not even attempt any of these remedies. It is not incumbent upon Applicant to do so for Opposer.

DISCOVERY RULES

Common sense is a consistent theme in discovery. *Cory, supra*. Calcagno, “Tips from the TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1)” 80 TMR 285. Indeed, Attorney-Advisor Calcagno’s example in Footnote 7 shows another logical alternative that, if adopted by Opposer, would have negated Applicant’s objection: Using “VITALITY term” instead of “VITALITY mark” would have been a solution. This was, in fact, an alternative mentioned by counsel for Applicant in the telephone conversation referred to in Paragraph 8 of the Beutz Affidavit.

Applicant cannot concede on the present record that it uses anything that could accurately, or with common sense, be described as a “VITALITY mark” so a definitional change was appropriate. Counsel for Opposer chose not to redefine.

A rule of “common sense” is implied to give meaning to definitions in Interrogatories or Document Requests. There is also a second prong of the *Cory* test. Where there is an objection, as there is here, the responding party can apply its own common sense definition.

This Board need not adopt overly-broad rules in dealing with this dispute. All Applicant seeks here is affirmation that a definition, affording trademark significance to an admittedly descriptive, disclaimed term, can be validly objected to and the responding party satisfies its obligation by providing substantive answers which apply a common sense meaning to the term “mark”. That has occurred here. There has been a total refusal to redefine by Opposer.

CONCLUSION

The objection to the definitions purporting to convert the descriptive mark “vitality” with the “mark” is valid. Applicant’s answers that it does not use a “VITALITY mark” should stand. The motion should be denied.

Respectfully submitted,

INDIANA BOTANIC GARDENS, INC.

Dated: March ¹⁵__, 2005

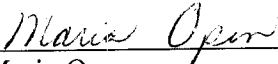


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CERTIFICATE OF SERVICE

It is hereby certified that a true and correct copy of the foregoing :

Memorandum in Response to Opposer's Motion to Compel was served via First Class mail on the attorney for Registrant and Applicant, Eunice P. de Carvalho and Molly K. Beutz, 2200 Wells Fargo Center, 90 South Seventh Street, Minneapolis, Minnesota 554023901 on this 15th Day of March, 2005.



Maria Opon