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

Proceeding	91206212
Party	Plaintiff Carefusion 2200, Inc.
Correspondence Address	JOSEPH R DREITLER DREITLER TRUE LLC 19 E KOSSUTH STREET COLUMBUS, OH 43206 UNITED STATES mtrue@ustrademarklawyer.com, jdreitler@ustrademarklawyer.com, ttro- fino@ustrademarklawyer.com
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Signature	/Mary R. True/
Date	12/02/2014
Attachments	CFN v Entrotech - Response to Motion to Compel - final.pdf(635048 bytes)

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

**IN THE MATTER OF Trademark Application Serial Nos. 85499349; 85499345;
85499337 and 85499332**

DATE OF PUBLICATION: May 29, 2012

CareFusion 2200, Inc.,)	
)	
Opposer,)	Combined Opposition No. 91206212
)	
v.)	
)	
Entrotech, Inc.,)	
)	
Applicant.)	

**OPPOSER’S RESPONSE TO APPLICANT’S MOTION
TO COMPEL**

Applicant’s Motion to Compel is untimely, unwarranted, harassing and moot. It is untimely because the parties had been exchanging letters and discussing the issues raised in the Motion since early November, the 30(b)(6) deposition of Opposer’s designee has been scheduled since mid-October, but counsel for Applicant waited until 8:00 PM on Friday November 21, 2014 to file such motion and to seek a stay of the 30(b)(6) deposition of Opposer’s designee. Nevertheless, because Opposer has only a condensed time frame in which to respond to Applicant’s 100+ page Motion and attached exhibits, this Response will attempt to distill and clarify the issues to assist the Board in resolving this matter.

A. The Motion is unwarranted because Opposer’s bad faith is not at issue in the context of a trademark opposition, it has produced documents on the following topics, as listed in the Motion to Compel, and will not object to providing testimony within the limitations noted below.

- (1) Consumers’ perception and the industry’s perception of Opposer’s goods allegedly sold under its CHLORAPREP and CHLORASHIELD marks [Topic 13]

Opposer withdraws any objection to providing 30(b)(6) testimony on this topic and has produced a substantial number of responsive documents.

(2) Opposer's other disputes, or lack thereof, involving its CHLORAPREP and CHLORASHIELD marks [Topic 28]

Opposer has produced documents relating to this topic and does not object to providing 30(b)(6) testimony on this issue, although Opposer maintains its objection to providing information beyond the nature of the dispute, the parties, and the outcome. *J&J v. Rexall Drug*, 186 USPQ 201 (TTAB 1975) ("Thus applicant's interrogatories requesting identification of legal proceedings or written or oral agreements between oppose and third parties based on opposer's ownership[p of its pleaded mark . . . are not objectionable, except that opposer need merely identify the legal proceedings by naming the parties involved, listing the jurisdiction and proceeding number, and stating the outcome; that is, oppose need not . . . identify all documents pertaining to such litigation, such request being too broad and burdensome.).

(5) Opposer's slogan THE CHLORAPREP ADVANTAGE and its knowledge of Applicant's pending, allowed United States applications for the slogan THE CHLORHEXIDINE ADVANTAGE [Topics 20, 21, 22]

Opposer has already informed Applicant that it has no documents responsive to this request, and Applicant is aware that Opposer has no trademark applications or registrations for the phrase THE CHLORAPREP ADVANTAGE. The only purpose for this discovery would be to file a civil lawsuit for unfair competition. Indeed, Applicant has stated that the information is relevant to "Opposer's bad faith and lack of diligence in selecting its trademarks." Motion at 17. Opposer's alleged "bad faith" regarding such a descriptive phrase is of no relevance to this trademark opposition proceeding. It does not go to any claim, defense or counterclaim. Rather, accusations of bad faith on the part of Opposer are more properly considered equitable defenses which are not considered by the Board. Any other accusations regarding Opposer's "bad faith" in

using the descriptive phrase “The Chloraprep Advantage” could only be raised in a lawsuit under Section 43(a) for unfair competition, assuming that Applicant had trademark rights and assuming Opposer was using such a phrase as a trademark, neither of which is the case. The TTAB does not have jurisdiction over issues relating to unfair competition. *Paramount Pictures Corp. v. White*, 41 USPQ2d 1768, 1771 n.5 (TTAB 1994).

Nevertheless, and without waiving its objections to the relevance of this line of questioning, Mr. Creidenberg can testify to the fact that CareFusion does not use the referenced phrase as a “slogan” or in a trademark sense, and that Opposer was not aware of Applicant’s application for THE CHLORHEXIDNE ADVANTAGE.

B. In addition to being unwarranted, the Motion is moot as to the issues set forth below

(3) Opposer’s development, manufacture, distribution, marketing, and sale of the goods allegedly sold under Opposer’s CHLORASHIELD marks and Opposer’s collaboration efforts with third parties with respect to same, including Avery Dennison Corporation, which, according to a press release on Opposer’s website, *see Exhibit D*, collaborated with Opposer to manufacture, commercialize, and/or co-brand the goods allegedly sold under the CHLORASHIELD marks [Topics 4, 7, 40, 76, 77, 83, and 84]

(6) Opposer’s FDA filings relating to the goods allegedly sold in connection with the CHLORASHIELD marks, Opposer’s research and testing, including pilot and/or clinical trials for the goods allegedly sold under the CHLORASHIELD marks, and any approvals from Institutional Review Boards for the goods allegedly sold under the CHLORASHIELD marks [Topics 38, 75, 90].

Applicant acknowledges in its Motion that the purpose of the requested discovery is to test the validity of Opposer’s CHLORASHIELD registrations, and is part of Applicant’s “diligent” investigation of the marks for the purpose of bringing a counterclaim for cancellation.¹

¹ Applicant has not conducted a timely and diligent investigation as to whether it should bring counterclaims against Opposer’s CHLORASHIELD registrations. Applicant’s original Answer contained no affirmative defenses or counterclaims. Applicant served Opposer with its initial set of document requests on February 13, 2013. These requests included requests for documents showing use, or planned use by Opposer of the CHLORAPREP and CHLORASHIELD marks. Opposer made an extensive document production in August of 2013. Registration No. 4488745 –CHLORASHIELD – registered February 25, 2014 for antimicrobial catheter patch dressing and Registration

However, given that Opposer has voluntarily cancelled its registration of CHLORASHIELD, Reg. No. 4495083 for “surgical incise drapes”, this registration is no longer in issue in this Opposition, and further discovery on that registration is largely moot.² Opposer maintains its objection that discovery with respect to its relationships with unrelated third parties are irrelevant to this proceeding, are burdensome and harassing and that Opposer should not be compelled to present 30(b)(6) testimony on this topic. However, as Opposer advised Applicant by letter of November 17, 2014, Mr. Creidenberg has certain personal knowledge and can testify about Opposer’s continuing efforts to commercialize an incise drape product containing chlorhexidine.³

Opposer has also produced documents showing actual use of the CHOLORASHIELD mark on catheter patch dressings, as per Reg. No. 4488745, including photographs of the actual product that is being sold, its FDA-approved packaging, marketing materials, and sales information. Opposer has already informed Applicant that Opposer’s 30(b)(6) witness, Mr. Creidenberg, has personal knowledge and can testify *generally* about the development of the Chlorashield catheter patch product which is the subject of Reg. No. 4488745, and will testify as a 30(b)(6) witness as to the marketing and sales of that product. However, Opposer’s pre-approval FDA filings for its Chlorashield catheter patch are irrelevant to whether Opposer had a *bona fide* intent to use the mark, given that the product is sold nationally. “Moreover, post-filing

No. 4495083 – CHLORASHIELD – registered March 11, 2014 for surgical incise drape. On April 14, 2014, Opposer – *with Applicant’s consent* – amended its Notice of Opposition to assert these two additional registrations. On September 17, 2014, Applicant served the discovery at issue herein. Applicant did not file its answer to the Amended Notice of Opposition until October 27, 2014. The Answer to the Amended Notice contained no affirmative defenses or counterclaims. Under TBMP §313.04, counterclaims to cancel a pleaded registration are compulsory counterclaims and must be brought “as part of defendant’s answer or promptly after the grounds therefor are learned.” *Jack Rajca v. New Yorker S.H.K. Jeans GMBH & Co. KG*, Cancellation No. 92056995 (TTAB July 22, 2014), citing *Turbo Sportswear Inc. v. Marmat Mountain Ltd.*, 77 USPQ2d 1152, 1154 (TTAB 2005). Clearly, Applicant had all the facts that it needed to file a motion for cancellation at the time Opposer filed its Amended Notice of Opposition. Thus, even if the issue of the validity of the CHLORASHIELD registrations is not moot, Applicant has failed in its obligation to timely amend its pleadings to assert counterclaims for cancellation, and any such motion at this late date should be denied.

² See Notice of Voluntary Cancellation, Attached hereto as Exhibit A.

³ See November 17, 2014 letter from Mary R. True to Erin Hickey, attached hereto as Exhibit B.

documentation is admissible to corroborate the existence of a pre-filing *bona fide*". *Hard Candy Cases, LLC v. Hard Candy, LLC*, Opposition No. 91195328 (TTAB 2014). This is not a civil lawsuit under Section 43(a) based upon claims that Opposer has not complied with FDA Regulations in the marketing of its Chloraprep and Chlorashield products. The validity of Opposer's FDA filings are irrelevant to the issue of whether Opposer's trademark Reg. No. 4488745 for catheter patches is valid. "We deal here only with the issue of registrability and what may be registered in the PTO. It is not our concern or that of the PTO what Vintners must do to comply with the BATF *labelling* requirements." *Institut Nat. Des Appellations D'Origine v. Vintners*, 958 F. 2d 1574, 1583 (Fed Cir 1992).

Finally, the fact that Applicant was ordered by the Board to produce such information to Opposer does not justify Applicant's request. The Board ordered Applicant to produce this information with respect to the four (4) ITU applications challenged in this proceeding on the grounds that "the requested documents are directly relevant to the issue of whether applicant had a demonstrated capacity to produce the medical products set forth in its applications under its subject marks as of the time the involved applications were filed or has taken steps necessary to develop and market such products since the filing date of the applications." For the reasons set forth above, discovery from Opposer on these issues relative to its CHLORAPREP and CHLORASHIELD marks is not relevant to these proceedings, and compelling discovery beyond what Opposer has already produced would constitute harassment.

C. The Motion is unwarranted and harassing in its continued insistence on seeking privileged attorney-client communications.

(4) Opposer's communications with its law firm, Dreitler True, LLC, exclusively relating to the underlying facts and bases for the representations Mr. Dreitler, an attorney with Opposer's law firm, made when executing the declarations attesting to Opposer's alleged *bona fide* intent to use the CHLORASHIELD marks for the goods listed in the

applications and Opposer's alleged actual use of those products under the CHLORASHIELD marks (Topic 39)

Applicant's insistence that the filing of a statement of use signed by an attorney pursuant to the Trademark Rules 37 CFR 2.193(e)(1)(iii) constitutes a waiver of the attorney-client privilege simply confirms its harassing tactics. As an initial matter, such discovery is moot in light of Opposer's voluntary cancellation of its CHLORASHIELD Reg. No. 4495083. More importantly, however, this is not a civil suit for infringement and Applicant's failure to cite any TTAB law in support of its position merely confirms this. 37 CFR 2.193(e)(1)(ii) does in fact require that "a person" signing have "firsthand knowledge of the facts". There is no such requirement for an attorney signing in 37 CFR 2.193(e)(1)(iii), and it must be presumed that the USPTO would have included the requirement of "firsthand knowledge" for an attorney to sign such a statement under 2.193(e)(1)(iii) if that was the intent. Otherwise, it is simply surplusage to have amended the rule to include attorneys as signatories, inasmuch as up until 1999 there was only a single category of authorized signatories and attorneys were not included. The purpose of the Trademark Law Revision Treaty was to simplify procedural aspects of U.S. registration practice. There is not a single comment objecting to or questioning the change in the rules to permit attorney's to sign registration documents without firsthand knowledge of the facts therein (48900 Federal Register / Vol. 64, No. 173 /Wednesday, September 8, 1999 /Rules and Regulations). If Applicant's position were adopted, it would encourage litigants in Board proceedings to routinely argue that an attorney who had signed a document pursuant to 2.193(e)(1)(iii) had waived the attorney-client privilege. If Applicant's position is correct, then the U.S. Patent & Trademark Office should amend 2.193(e)(1)(iii) to include a stated requirement of "firsthand knowledge" like that set out in 2.193(e)(1)(ii) or, at a minimum, publicly announce a change in policy that all attorneys who sign documents that comply with

CFR 2.193 are waiving attorney-client privilege.

D. Opposer should not be compelled to respond to Applicant's Second Set of Interrogatories

Applicant's rationale for seeking to compel Opposer to respond to Applicant's Second Set of Interrogatories, which are numbered 41-60, but are actually comprised of at least 147 separate requests, is that Opposer has waived its rights to object to additional interrogatories because it didn't object to Applicant's first set of *excessive* interrogatories. This is just another example of Applicant attempting to turn Opposer's professional courtesy and efforts to cooperate in discovery against Opposer. Applicant cites no law to support its position. However, case law is clear that once a subpart of an interrogatory introduces a line of inquiry that is separate and distinct from the inquiry made by the portion of the interrogatory that precedes it, the subpart must be considered a separate interrogatory no matter how it is designated. *Willingham v. Ashcroft*, 226 F.R.D. 57, 59 (D.D.C. 2005). Thus, an interrogatory asking Opposer to describe in detail any entity (including companies, organizations or people) with whom Opposer communicated (including "solicited, encouraged or engaged in any discussions or negotiations) regarding "researching, testing, developing, manufacturing, producing, distributing, marketing, advertising, and/or selling" the products identified in Opposer's two CHLORASHIELD registrations clearly is comprised (charitably) of at least eighteen separate inquiries (nine topics times two registrations). The Second Set of Interrogatories continues in this vein, comprising at least 147 separate requests.

However, the "counting" issue is not the only, or even the most important, factor to consider. Having to respond to such interrogatories is burdensome and harassing, particularly because the information sought in the interrogatories is already included in the 30(b)(6)

deposition topics and the Second Set of Document Requests (and are substantively objectionable on the same bases). Applicant will be questioning Opposer's 30(b)(6) witness on whatever topics the Board allows. There is no purpose, other than attempting to manufacture inconsistencies in the record, to having Opposer draft responses to interrogatories that its 30(b)(6) witness will have already testified on. Moreover, Applicant should not be permitted to seek written responses *in lieu* of deposition testimony, when it is clear that live testimony is the most efficient way to elicit the requested discovery.

E. The Motion is untimely and another example of Applicant's attempt to delay resolution of these proceedings

Finally, the Motion is just one more attempt by Applicant to drag its feet on conducting substantive discovery of Opposer. Applicant's first set of written discovery was served in February 2013 and Opposer provided more than 25,000 pages of responsive documents in August 2013. Applicant's second set of discovery, which is at issue in the Motion, was not served until September 16, 2014 – seventeen (17) months later, and literally on the eve of the discovery cut off. The second set of discovery requests sought discovery on a wide variety of new topics, although all of the topics were based on information in documents that had been produced by Opposer more than one (1) year ago. Applicant's apparent lack of diligence in reviewing Opposer's document production should not be rewarded by allowing Applicant to further delay resolution of these proceedings.

During the course of discovery, Opposer asked Applicant on many occasions which of Opposer's fact witnesses it wished to depose, so that its witnesses would have a reasonable time to clear their calendars to prepare and give testimony. Applicant ignored this basic courtesy, and did not request the depositions of any of Opposer's identified fact witnesses until it served

its 30(b)(6) Notice on September 16, 2014. Opposer's 30(b)(6) designee, Jan Creidenberg, is a Vice President and Marketing Manager for CareFusion, and has many other responsibilities within the company, particularly in light of the recently-announced acquisition of CareFusion by Beckton, Dickenson and Company. Nevertheless, in October, Mr. Creidenberg committed to setting aside December 4th and 5th to prepare for and sit for deposition. Applicant's cavalier assumption that Mr. Creidenberg can rearrange his schedule (at counsel's convenience) so that he can be deposed the week of December 15, or at some other unspecified date in the future, is discourteous and disrespectful – particularly because the compressed time frame for scheduling his deposition is entirely of Applicant's making.

For all the foregoing reasons, Opposer respectfully requests that the Board limit the topics for examination for Mr. Creidenberg's deposition and the documents to be produced as set forth above, order that neither Mr. Dreitler nor any other of Opposer's in-house or outside legal counsel be compelled to testify, and that Opposer's Second Set of Interrogatories be withdrawn and no further interrogatories be propounded.

Dated: December 2, 2014

Respectfully submitted,

/s/ Mary R. True

Mary R. True

Joseph R. Dreitler

DREITLER TRUE LLC

19 East Kossuth Street

Columbus, Ohio 43206

Telephone: (614) 449-6677

Email:

jdreitler@ustrademarklawyer.com

mtrue@ustrademarklawyer.com

Attorneys for Opposer CareFusion 2200, Inc.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing has been served by electronic mail upon Applicant's attorney of record in this proceeding on this 2nd December, 2014, at the following email address:

Erin M. Hickey hickey@fr.com
Fish & Richardson PC
12390 El Camino Real
San Diego, CA 92130

/s/ Mary R. True
Mary R. True

Exhibit A

Surrender of registration for cancellation

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85051477
REGISTRATION NUMBER	4495083
FORM TEXT	
Registration No. 4495083, CHLORASHIELD, is being surrendered in its entirety. Please see the attached signed petition.	
Contact information for the correspondent is as follows:	
Joseph R. Dreitler Dreitler True, LLC 19 E. Kossuth St. Columbus, OH 43206 jdreitler@ustrademarklawyer.com 614-449-6677	
ATTACHMENT(S)	
ORIGINAL PDF FILE	Chlorashield_Class_10_Voluntary_Cancellation_2014102431854830.pdf
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT16\IMAGEOUT16\850\514\85051477\xml16\S7S0002.jpg
SIGNATURE SECTION	
SUBMISSION SIGNATURE	/Joseph R. Dreitler/
SIGNATORY'S NAME	Joseph R. Dreitler
SIGNATORY'S POSITION	Attorney of record, Ohio bar member
DATE SIGNED	11/24/2014
AUTHORIZED SIGNATORY	YES
FILING INFORMATION SECTION	
USPTO/S7S-104.10.45.218-2 0141124152358399857-44950	

TEAS STAMP

83-20141124151806096297-N
/A-N/A-201411241518060962
97

Global Format; No Form Number (Rev 8/2009)
OMB No. 0651-0055 (Exp. 12/31/2011)

**Surrender of registration for cancellation
To the Commissioner for Trademarks:**

The following is submitted for registration number. **4495083** :

FORM INFORMATION

Registration No. 4495083, CHLORASHIELD, is being surrendered in its entirety. Please see the attached signed petition.

Contact information for the correspondent is as follows:

Joseph R. Dreitler
Dreitler True, LLC
19 E. Kossuth St.
Columbus, OH 43206
jdreitler@ustrademarklawyer.com
614-449-6677

FORM FILE NAME(S)

Original PDF file:

[Chlorashield Class 10 Voluntary Cancellation 2014102431854830.pdf](#)

Converted PDF file(s) (1 page)

[Attachments-1](#)

SIGNATURE(S)

Submission Signature

Signature: /Joseph R. Dreitler/ Date: 11/24/2014
Signatory's Name: Joseph R. Dreitler
Signatory's Position: Attorney of record, Ohio bar member
Signatory's Phone Number: 614-449-6677

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possession; and is currently the trademark owner's attorney or an associate thereof.

Serial Number: 85051477

Internet Transmission Date:

TEAS Stamp: USPTO/S7S-104.10.45.218-2014112415235839

9857-4495083-20141124151806096297-N/A-N/

A-20141124151806096297

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
To the Assistant Commissioner of Patents and Trademarks:**

Trademark: CHLORASHIELD

Registration Number: 4495083

International Class No.: 10

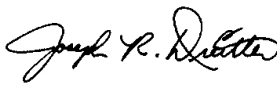
Registrant: CareFusion 2200, Inc.

Petition for Voluntary Cancellation
Under Section 7(e)

Box POST REG – NO FEE
Assistant Commissioner for Trademarks
Alexandria, VA

The above-identified Registrant, pursuant to Section 7(e) of the Lanham Act (15 U.S.C. 1057), through its attorney, hereby requests that the honorable Assistant Commissioner for Trademarks cancel Registration No. 4495083 for the mark CHLORASHIELD issued March 11, 2014.

Respectfully submitted,

By: 

Joseph R. Dreitler
Attorney for Registrant CareFusion 2200,
Inc.

Exhibit B



LLC

19 E. Kossuth Street
Columbus, Ohio 43206
November 17, 2014

Mary R. True
Telephone: (614)(449-6643

mtrue@ustrademarklawyer.com

via email: hickey@fr.com

Erin Hickey, Esq.
Fish & Richardson
12390 El Camino Real
San Diego, CA 92130

Re: *CareFusion 2200, Inc. v. Entrotech, Inc., Opposition No. 91206212*

Dear Erin:

While reserving all rights to appropriate objections, Mr. Creidenberg will be responding on behalf of Opposer on the following topics: 1-6¹, 8-12, 14-19, 23-25, and 27-37. The deposition transcript will be designated “Trade Secret Highly Confidential” and he will only be instructed not to answer questions that seek attorney-client privileged information.

As an initial matter, it bears noting that Opposer has agreed to provide testimony and has already produced documents relating to the vast majority of Applicant’s recent discovery requests – including documents relating to Opposer’s bases for alleging its bona fide intent to use the Chlorashield mark in commerce (Requests for Production Nos. 78, 79, 80).² Indeed, in response to Applicant’s Second Set of Requests for Production – which comprised 35 separate requests, Opposer refused to provide documents only as to 8 of them, Nos. 75, 76, 77, 82, 83, 84, 90, and 98, for the reasons set forth above. The assertion of

¹ With respect to Topic Nos. 1 and 2, Mr. Creidenberg’s knowledge to speak on behalf of Opposer is limited to the portions of the company that are currently responsible for the Chloraprep line of products, and predecessors in interest thereto. No other discovery of Opposer’s corporate structure is relevant, including discovery regarding Becton Dickinson Co.’s “intent” or “plans” for products currently sold under the Chloraprep and Chlorashield marks. Such discovery is irrelevant and constitutes harassment, and the disclosure of such information likely violates SEC rules.

² Mr. Creidenberg will also be prepared to discuss these issues. The mere fact that Mr. Dreitler signed application documents as “an attorney as defined in §11.1 of this chapter who has an actual written or verbal power of attorney or an implied power of attorney form the owner” (37 CFR §§2.193(e)(1)–2.193(e)(1)(iii)) does not make him subject to deposition or waive any applicable privilege (see *infra*).



what you refer to as “boilerplate” objections is intended to preserve those objections, as you would no doubt be quick to claim that Opposer had waived them otherwise. Opposer has produced over 25,000 pages of documents since August of 2013, and it has updated its production as additional relevant documents became available (for example, documents relating to the use, marketing and sales of the Chlorashield products). Opposer has unquestionably complied with its discovery obligations throughout these proceedings.

And it bears repeating that this is not a complex case, notwithstanding the fact that your discovery requests have so far resulted on our client producing 25,000 pages of documents. Priority is not an issue, as our client has an incontestable registration and has been selling an FDA approved antimicrobial chlorhexidine product for use in surgery under the trademark Chloraprep® since 1994. Additionally, our client filed two applications for Chlorashield, on June 1, 2010 for related surgical goods, which were registered in February and March 2014, respectively. Thus, the only issue in this case is whether any or all of your client’s four (4) Intent to Use trademark applications for “Chlorashield” for antimicrobial surgical goods containing chlorhexidine filed in December 2011 are likely to cause confusion with our client’s prior registrations and common law use under the thirteen *Du Pont* factors.

The only additional factors in this case are that your client and ours were working together between 2008 and 2011 to possibly develop a surgical antimicrobial drape product. That relationship ended in 2011, and your client filed the four (4) opposed trademark applications in December 2011. To our knowledge, your client has never sold any such products or even received FDA approval to sell a product, which is relevant to the extent that your client may not legally have the ability to sell such products, which brings into play Entrotech’s bona fide intent.

It is difficult not to conclude that much of your latest discovery is not simply irrelevant, but is meant to be burdensome and harassing, requiring Opposer to produce and prepare a witness to testify on documents that have nothing to do with defending a Section 2(d) Opposition. For example, you spend the better part of a page in your letter claiming that my law partner, Joseph Dreitler, has waived the attorney-client privilege and that Entrotech reserves the right to subpoena him for deposition before the discovery cutoff. This alleged waiver resulted from the fact that this law firm filed a statement of use on behalf of Opposer. Such allegations and tactics are simply harassing. You and your firm certainly know the law and that the Trademark Rule of Procedure § 2.193 clearly sets out the three types of persons who may sign documents with a verification of facts. The rule clearly distinguishes between an attorney who has an implied power of attorney from the owner and person with first-hand knowledge of facts. Mr. Dreitler is not a fact witness and your treat to subpoena him can only be construed as harassment.

With respect to your specific objections, you take issue with our objections to certain topics in the 30(b)(6) notice and to certain document requests that are based on relevance. You repeatedly cite TBMP §402.01 – “A party may take discovery not only as to matters specifically raised in the pleadings, but also as to any matter which might serve as the basis



for an additional claim, defense, or counterclaim.” – and you state the requested discovery is relevant to *inter alia*, “the validity of Opposer’s Chlorashield registrations.” See, e.g., Topics 7, 40, 38, and Requests for Production Nos. 76, 77, 82, 83, 84, 90.

Under TBMP §313.04, counterclaims to cancel a pleaded registration are compulsory counterclaims and must be brought “as part of defendant’s answer or promptly after the grounds therefor are learned.” *Jack Rajca v. New Yorker S.H.K. Jeans GMBH & Co. KG*, Cancellation No. 92056995 (TTAB July 22, 2014), citing *Turbo Sportswear Inc. v. Marmat Mountain Ltd.*, 77 USPQ2d 1152, 1154 (TTAB 2005). In this case, Registration No. 4488745 –CHLORASHIELD – registered February 25, 2014 for antimicrobial catheter patch dressing and Registration No. 4495083 – CHLORASHIELD – registered March 11, 2014 for surgical incise drape. You consented to our amending our Notice of Opposition to assert these two additional registrations, and Opposer’s Amended Notice of Opposition was filed on April 14, 2014. Applicant did not file its answer to the Amended Notice of Opposition until October 27, 2014. The Answer to the Amended Notice contained no affirmative defenses or counterclaims, even though you had served the discovery at issue herein on September 17, 2014.

Indeed, Applicant’s failure to assert any affirmative defenses or counterclaims, or conduct any discovery on the validity of the Chlorashield marks, goes back to the beginning of the case. The applications for CHLORASHIELD, Serial Nos. 85051474 and 85051477 were published for opposition on October 26, 2010. Your client did not oppose them. The applications were relied upon by Opposer in its original Notice of Opposition, filed on July 24, 2102. Applicant did not assert any affirmative defenses or counterclaims in its Answer of September 4, 2012. Statements of Use were submitted to the PTO on December 11, 2013 for Serial No. 85051474 and on December 12, 2013 for Serial No. 85051477. The specimens submitted with the SOUs were available along with the complete file histories for these applications. Clearly, Applicant had all the facts that it needed to file a motion for cancellation at the time Opposer filed its Amended Notice of Opposition. Your belated, and extensive, discovery on this issue is unquestionably prejudicial to Opposer and Opposer maintains its objections to providing the requested discovery.

You also assert that the information sought with respect to Topic Nos. 4, 7, 40, 20, 21, 22, 39, and 38 and Requests for Production Nos. 76, 77, 83, 84, 87, 98, 82, 75, and 90, is relevant because it goes to evidence of Opposer’s purported “bad faith.” Opposer’s “bad faith” is of no relevance to this trademark opposition proceeding. It does not go to any claim, defense or counterclaim. Rather, accusations of bad faith on the part of Opposer are more properly considered equitable defenses which are not considered by the Board. Any other accusations regarding Opposer’s bad faith could only be raised in a lawsuit under Section 43(a) for unfair competition. The TTAB does not have jurisdiction over issues relating to unfair competition. *Paramount Pictures Corp. v. White*, 41 USPQ2d 1768, 1771 n,5 (TTAB 1994). Discovery regarding Opposer’s purported bad faith in adopting the Chlorashield mark is especially frivolous, inasmuch as bad faith is simply not an affirmative defense that can be raised by the junior user of a mark. Opposer maintains its objections to providing the requested discovery.



Your request that Opposer provide discovery as to its use of the slogan The Chloraprep Advantage (Request for Production Nos. 87 and 98) is clearly improper. Opposer has not sought to register this slogan. The only possible use for this information would be to file a civil lawsuit for unfair competition. As noted above, such claims are not within the jurisdiction of the Board. Opposer maintains its objections to providing the requested discovery.

With respect to Applicant's discovery requests regarding Opposer's FDA filings for its Chlorashield products and documentation of IRB approvals (Requests for Production Nos. 75 and 90), we are producing herewith the 510(k) Premarket Notifications for K103106 and K133764. That is the only information that is relevant to this proceeding. The Chlorashield product has been approved for sale by the FDA. The requested information regarding the substance of such filings could only go to a collateral attack on the processes of the involved agencies – certainly not an area over which the Board has jurisdiction. Furthermore, while the Board did indeed compel Applicant to produce this information to Opposer, on the grounds that “the requested documents are directly relevant to the issue of whether applicant had a demonstrated capacity to produce the medical products set forth in its applications under its subject marks as of the time the involved applications were filed or has taken steps necessary to develop and market such products since the filing date of the applications,” these are not issues that are equally applicable to Opposer. With the exception of producing the attached 510(k) Premarket Notifications, Opposer maintains its objections to providing any addition discovery on this topic.

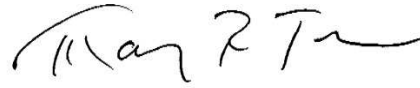
Likewise, discovery relating to Opposer's collaborations with third parties regarding the development of the Chlorashield products (Request for Production Nos. 87, 77, 83, and 84) and for information on patent filings for Chloraprep and Chlorashield products (Request for Production No. 82), or for information on internal CareFusion projects with which Applicant is no longer involved (Request for Production No. 1) are completely irrelevant to any issue properly before this Board. Such information would only be relevant to an action for unfair competition, or a patent related claim. These are not issues within the Board's jurisdiction and Opposer maintains its objections to providing the requested discovery.

Finally, as Opposer's 30(b)(6) designee, Mr. Creidenberg has the responsibility of testifying on behalf of the company. As you note, it is appropriate for him to testify to matters as to which he does not have personal knowledge, so long as he has the ability to bind the company. Accordingly, your continued insistence that Opposer confirm that Mr. Creidenberg is the “individual most knowledgeable about this topic” is improper and is not the role of a 30(b)(6) designee.



I look forward to discussing these issues with you on Monday.

Sincerely,

A handwritten signature in black ink, appearing to read "Mary R. True". The signature is fluid and cursive, with the first name "Mary" being the most prominent.

Mary R. True

