ESTTA Tracking number: **ESTTA588902**

Filing date: **02/24/2014**

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

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|---|---|
| Proceeding | 91209218 |
| Party | Defendant<br>Croda International Plc |
| Correspondence Address | KRISTINE M BOYLAN<br>MERCHANT & GOULD PC<br>P O BOX 2910<br>MINNEAPOLIS, MN DN14 9AA<br>UNITED STATES<br>kboylan@merchantgould.com, aries@merchantgould.com, dockmpls@merchantgould.com |
| Submission | Opposition/Response to Motion |
| Filer's Name | Kristine Boylan |
| Filer's e-mail | kboylan@merchantgould.com, aries@merchantgould.com, dockmpls@merchantgould.com |
| Signature | /Kristine Boylan/ |
| Date | 02/24/2014 |
| Attachments | 2014 02 24 Reply Response to Motion for Summary Judgment.pdf(352692 bytes ) |

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

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| EVONIK DEGUSSA GMBH | ) | |
| | ) | |
| Opposer, | ) | |
| | ) | Opposition No. : 91209218 |
| v. | ) | |
| | ) | Application No. 79/120,041 |
| CRODA INTERNATIONAL, PLC, | ) | Mark: KERAMIMIC |
| | ) | |
| Applicant. | ) | |
| | ) | |

**APPLICANT CRODA INTERNATIONAL, PLC'S REPLY IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT AND IN RESPONSE TO OPPOSER'S CROSS-MOTION FOR SUMMARY JUDGMENT (COMBINED RESPONSE/REPLY BRIEF)**

In its Response and Cross-Motion, Evonik filed a Declaration from Dr. Thomas Satzinger, along with exhibits consisting of uncorroborated advertising brochures, a picture and invoices that are insufficient to establish use of the SKINMIMICS name in the United States. The Satzinger Declaration and exhibits do not change the grounds for Applicant Croda's Motion. Nothing produced by Evonik, in discovery or its Response and Cross-Motion, establish sufficient use by Evonik in the United States to maintain this Opposition.

As more fully outlined below and as Evonik's Response and Cross-Motion states, Evonik's discovery conduct has been prejudicial to Croda's interests. Evonik served woefully inadequate Initial Disclosures in October 2013, discovery responses in December 2013, and filed a Section 8 and 5 Declaration at the eleventh hour on December 30, 2013. Significantly, these materials demonstrate serious deficiencies in Evonik's October 2013 Initial Disclosures that are prejudicial to Croda's interests in the case. Should this tribunal decide—contrary to rules of evidence and proof—that Evonik's showing survives summary judgment scrutiny, Evonik should be limited to the witness testimony of Dr. Satzinger to support its case in chief.

## LAW AND ANALYSIS

### A. An Order of Summary Judgment Disposing of Evonik's Opposition Is Proper Because The Exhibits Proffering Use Lack Evidentiary Sufficiency To Survive Summary Judgment Scrutiny.

To survive summary judgment scrutiny, Evonik must come forward with evidence demonstrating the existence of specific genuinely disputed facts. It is not enough to merely oppose the motion with refutation. Instead, Evonik must point to specific portions of the record or provide other evidence supporting the existence of genuine disputed facts. *The Joy of Cooking Trust v. Christopher McCarley*, 2012 TTAB LEXIS 373, at *5-6, 8 (TTAB 2012) (granting summary judgment where nonmoving party failed to come forward with evidence of use sufficient to create a genuine issue of fact).

While a detailed affidavit submitted by a knowledgeable affiant may be used to establish a genuine issue of material fact, the affidavit must provide enough details, facts, and/or evidence such that the statements are not conclusory and unsubstantiated. *See*, *The Clorox Company v. Hermilo Tamez Salazar*, 108 USPQ2d 1083, at *7, 12-14 (TTAB 2013) (granting summary judgment where advertising and offers for sale on English version website, and shipment of parts did not establish use); *Alliance Entertainment Corp. v. Eric Russ*, 2007 TTAB LEXIS 114, at *3, 5-6 (TTAB 2007) (granting summary judgment of nonuse because a screen shot showing the mark was insufficient to establish use of the mark in connection with the relevant good). In other words, merely providing a declaration, producing documents, and attaching exhibits is not enough where the evidence does not go toward establishing trademark use. *The Clorox Company*, 108 USPQ2d 1083, at *7, 12-14; *Alliance Entertainment Corp.*, 2007 TTAB LEXIS 114, at *3, 5-6.

In this case, the Satzinger Declaration with attached exhibits does not establish use so as to

overcome summary judgment scrutiny. As a threshold matter, the exhibits are completely uncorroborated and lack foundation. "What a witness represents as his knowledge must be based on personal observation or authenticated business records." *Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 2006 TTAB LEXIS 9, at *16 (TTAB 2006) (ruling that an employee's testimony regarding first use of the mark in the 1960s was inadmissible hearsay when the employee was not employed with the company until 1991).

Here, there is no foundation laid to establish that Satzinger has personal knowledge to testify to anything that has happened outside his three-year tenure as the Director of Global Marketing for Evonik, yet Satzinger baldly states that Evonik has been marketing and selling the SKINMIMICS products to customers in the United States since a date that is nearly two years before the start of his work as Director of Global Marketing. Satzinger does not attest to having talked with people who would know about what happened in that period, nor did he even consult business records kept in the normal course to inform himself as to what may have transpired in that period. The Satzinger Declaration and exhibits cannot support an Order sustaining Evonik's Opposition to Croda's summary judgment motion.

Even if the Satzinger Declaration exhibits were authenticated and foundation was laid to establish their admissibility, the exhibits themselves—consisting of advertising brochures and invoices—do not establish trademark use so as to overcome summary judgment scrutiny. Where there is no evidence as to when brochures were distributed or to whom they were distributed, advertising brochures do not establish use. *Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 2006 TTAB LEXIS 9 at *11 (TTAB 2006) (sustaining objection and finding inadmissible proffered brochures where it was unclear when or if the brochures had been distributed in the United States). Likewise, invoices lacking information or substantiation as to

how customers saw a trademark on boxes or products do not establish use. *Clairol Incorporated v. Holland Hall Products, Inc.*, 1970 TTAB LEXIS 35, at *5-6 (TTAB 1970) (holding that invoices did not evidence that the trademark ever appeared on the container or package or that the mark was ever used as a trademark in connection with such goods); *Standard Brands, Inc. v. Newtown*, 1973 TTAB LEXIS 28, at *4-5 (TTAB 1973) (explaining that invoices do not constitute trademark use but finding that testimony implied such use).

In this case, neither the advertising brochures nor the invoices establish trademark use. The advertising brochures are not point-of-sale pieces. There is no evidence as to when brochures were distributed or to whom they were distributed. The invoices are fairly bare and if a product was shipped relative to the invoices, there is no way to tell if a trademark did actually appear on any packaging or product. Evonik's evidentiary showing does not survive summary judgment scrutiny.[1]

**B. Should this tribunal decide—contrary to settled rules of evidence and proof—that Evonik's showing supports an Order sustaining Evonik's Opposition to Croda's summary judgment motion, Evonik should be limited to only the witness testimony of Dr. Satzinger to support its case in chief.**

As Evonik's Response and Cross-Motion states, Evonik's discovery responses and Initial Disclosures were received, and a Section 8 and 5 Declaration was filed at the eleventh hour. Evonik's submission takes great strains to emphasize this point, by including copies of correspondence between counsel and complete copies of discovery responses served.

[1] The procedural history and backdrop of this case does not prevent this tribunal from granting Croda's request for relief. Croda need not have filed an independent cancellation action to assert its defense of nonuse (i.e., abandonment). *See, e.g., Yamaha Corp. of America v. Wrightwood Enterprises, Inc.*, 2002 TTAB LEXIS 721, at * 1-2, 32 (TTAB 2002) (Abandonment was pled as an affirmative defense in an opposition proceeding, and the Board agreed that the mark had been abandoned.).

Quite unexpectedly, the information Evonik served demonstrates that there are serious and prejudicial deficiencies in Evonik's October 4, 2013 Initial Disclosures. As described in the Stradley Declaration, Evonik's Initial Disclosures identify only Satzinger as a witness in the case. (Declaration of Paige S. Stradley "Stradley Decl." at Ex. A.) In the materials filed to oppose this motion, however, it is clear that there are more individuals known to Evonik (more than just Dr. Thomas Satzinger, that is) who are likely to have discoverable information in the case. At a minimum, "Dr. Rolf Franke" signed the Section 8 and 15 Declaration, "Thomas Felchner" signed the Verification to the Interrogatory Answers, and other Evonik employee names appear throughout the materials filed under seal (marked FOR COUNSEL ONLY) to oppose Croda's Motion for Summary Judgment.

None of these people, however, are identified in Evonik's October 4, 2013 Initial Disclosures and instead appear only in discovery responses received at the undersigned's office relatively late in the discovery period - less than 90 days before the close of discovery and less than 60 days before the expert witness disclosure deadline. (Stradley Decl. at Exs. B, C.) Moreover, in that same time period, Dr. Satzinger was the only 30(b)(6) deponent Evonik planned to produce for testimony on use. This discovery conduct has been prejudicial to Croda's interests.

Should this tribunal decide – contrary to settled rules of evidence and proof - that Evonik's showing survives summary judgment scrutiny, Evonik should be limited to the witness testimony of Dr. Satzinger to support its case in chief. This case cannot proceed along the same time-line as set in the original scheduling order, with the inadequacy of Evonik's disclosures. (*Id*.)

**CONCLUSION**

Summary judgment in Croda's favor should be ordered, because the evidence simply does not establish use to maintain the Opposition. To the extent this case should proceed, however, a

specific Order fashioning and limiting how discovery should proceed is warranted.

CRODA INTERNATIONAL PLC,

By its Attorneys,

Date: February 24, 2014

s/ Kristine Boylan
Kristine M. Boylan
MERCHANT & GOULD P.C.
3200 IDS Center, 80 South Eighth Street
Minneapolis, MN 55402-2215
(612) 332-5300
***Attorneys for Applicant***

## CERTIFICATE OF SERVICE

I hereby certify that on this 24th day of February, 2014, a true copy of the foregoing **APPLICANT CRODA INTERNATIONAL, PLC'S REPLY IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT AND IN RESPONSE TO OPPOSER'S CROSS-MOTION FOR SUMMARY JUDGMENT (COMBINED RESPONSE/REPLY BRIEF)** was served by first-class mail, postage prepaid, upon counsel for Opposer:

Scott D. Woldow
Elizabeth G. Borland
Smith, Gambrell & Russell, LLP
1230 Peachtree Street, N.E.
Suite 3100-Promenade
Atlanta, GA 30303

s/Abigail Ries
Abigail Ries

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

| | | |
|---|---|---|
| Evonik Goldschmidt GmbH (now merged into Evonik Degussa GmbH), | ) | Opposition No. 91209218 |
| Opposer | ) | Mark: KERAMIMIC |
| v. | ) | Serial No.: 79/120,041 |
| Croda International Plc, | ) | Filed: May 29, 2012 |
| Applicant. | ) | |

## DECLARATION OF PAIGE S. STRADLEY

I, Paige S. Stradley, do hereby state as follows:

1. I am an attorney with the firm of Merchant & Gould, P.C., counsel for Applicant, Croda International Plc ("Applicant"), in the captioned matter, and I submit this declaration in conjunction with Applicant's Reply In Support Of Its Motion For Summary Judgment And In Response To Opposer's Cross-Motion For Summary Judgment.

2. Attached hereto as **Exhibit A** is a true and correct copy of Opposer, Evonik Goldschmidt GmbH's (now merged into Evonik Degussa GmbH) ("Opposer's") Initial Disclosures, served October 4, 2013.

3. Attached hereto as **Exhibit B** is a true and correct copy of the scheduling order as it appears in Croda's Motion for Suspension for Settlement with Consent filed May 13, 2013. The Motion for Suspension for Settlement with Consent provides the Trademark Trial and Appeal Board with a proposed schedule.

4. Attached hereto as **Exhibit C** is a true and correct copy of the Trademark Trial and Appeal Board's Order granting Croda's Motion for Suspension for Settlement with Consent

and agreeing to the schedule set forth in Croda's Motion for Suspension for Settlement with Consent, entered May 13, 2013.

Date: February 24, 2014

s/ Paige S. Stradley____
Paige S. Stradley

## CERTIFICATE OF SERVICE

I hereby certify that on this 24th day of February, 2014, a true copy of the foregoing **Declaration of Paige S. Stradley** was served by first-class mail, postage prepaid, upon counsel for Opposer:

Scott D. Woldow
Elizabeth G. Borland
Smith, Gambrell & Russell, LLP
1230 Peachtree Street, N.E.
Suite 3100-Promenade
Atlanta, GA 30303

_s/Abigail Ries_____
Abigail Ries

# EXHIBIT A

KMB

Attorney Docket No.
034536.007Opp

TRADEMARK

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

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| Evonik Goldschmidt GmbH | ) | |
| | ) | |
| | ) | |
| Opposer, | ) | |
| | ) | |
| v. | ) | Opposition No. 91209218 |
| | ) | |
| Croda International Plc | ) | |
| | ) | |
| Applicant. | ) | |

Commissioner for Trademarks
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

## EVONIK GOLDSCHMIDT GMBH'S INITIAL DISCLOSURES

Pursuant to Rule 2.120 of the Trademark Rules of Practice and Rule 26 of the Federal Rules of Civil Procedure, Evonik Goldschmidt GmbH ("Evonik") hereby provides its Initial Disclosures to Croda International Plc:

**A. The name and, if known, the address and telephone number of each individual likely to have discoverable information that the disclosing party may use to support its claims or defenses, unless solely for impeachment, identifying the subjects of the information:**

| Name | Company | Address | Phone | Connection with Case |
|---|---|---|---|---|
| Dr. Thomas Satzinger | Evonik Industries AG | Rellinghauser Strasse 1-11, 45128 Essen, Germany | Dr. Satzinger can be reached through counsel of record | Consumer Specialties, Care Specialties, and Personal Care Divisions |

Dr. Satzinger works in the Consumer Specialties, Care Specialties and Personal Care Divisions of Evonik Industries AG. Dr. Satzinger is familiar with the relevant products, use of the mark, use of the goods, length of use and dates of use. Dr. Satzinger is familiar with Evonik's ownership and use of the SKINMIMICS mark. Dr. Satzinger is knowledgeable regarding technical information relevant to the goods.

Evonik Degussa GmbH reserves the right to supplement the above list with persons who are identified during the course of discovery.

**B. A copy of, or a description by category and location of, all documents, electronically stored information, and tangible things that are in the possession, custody, or control of the party and that the disclosing party may use to support its claims or defenses, unless solely for impeachment:**

Evonik Goldschmidt GmbH has copies of the following types of documents at its principal place of business:

(1) the application for the SKINMIMICS mark and the file wrapper for same;

(2) documents relating to use of SKINMIMICS mark, including but not limited to, advertising and sales documentation

Evonik Goldschmidt GmbH reserves the right to supplement this list with additional documents that are identified during the course of discovery.

**C. A computation of any category of damages claimed by Opposer, making available for inspection and copying, as under Fed.R.Civ.P. 34, the documents or other evidentiary material, not privileged or protected from disclosure, on which such computation is based, including materials bearing on the nature and extent of injuries suffered:**

Not applicable.

**D. The existence and extent of coverage of any insurance agreement under which any insurer may be liable to satisfy part or all of a judgment which may be entered against Opposer in the action or to indemnify or reimburse it for payments made to satisfy the judgment:**

Not applicable.

This 4th day of October, 2013.

**SMITH, GAMBRELL & RUSSELL, LLP**

Scott D. Woldow
1055 Thomas Jefferson St., N.W.
Suite 400
Washington, D.C. 20007
(202) 263-4300
Facsimile: (202) 263-4329
Email: sdwoldow@sgrlaw.com

Attorney for Evonik Goldschmidt GmbH

Attorney Docket No.
034536.007Opp

TRADEMARK

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

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| Evonik Goldschmidt GmbH | ) | |
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| Opposer, | ) | |
| | ) | |
| v. | ) | Opposition No. 91209218 |
| | ) | |
| Croda International Plc | ) | |
| | ) | |
| Applicant. | ) | |

Madam:

**CERTIFICATE OF SERVICE**

I, Scott D. Woldow, counsel for Evonik Degussa GmbH, hereby certify that Evonik Goldschmidt GmbH's Initial Disclosures was served upon applicant by placing a copy of same in the U.S. mail, postage prepaid, addressed as follows:

KRISTINE M BOYLAN
MERCHANT & GOULD PC
P O BOX 2910
MINNEAPOLIS, MINNESOTA DN14 9AA
UNITED STATES

This 4th day of October, 2013

Scott D. Woldow

# EXHIBIT B

ESTTA Tracking number: **ESTTA537430**

Filing date: **05/13/2013**

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

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| Proceeding. | 91209218 |
| Applicant | Defendant<br>Croda International Plc |
| Other Party | Plaintiff<br>Evonik Goldschmidt GmbH |
| Have the parties held their discovery conference as required under Trademark Rules 2.120(a)(1) and (a)(2)? | No |

## Motion for Suspension for Settlement With Consent

The parties are actively engaged in negotiations for the settlement of this matter. Croda International Plc requests that this proceeding be suspended for 90 days to allow the parties to continue their settlement efforts.

| | |
|---|---|
| Time to Answer : | 08/16/2013 |
| Deadline for Discovery Conference : | 09/15/2013 |
| Discovery Opens : | 09/15/2013 |
| Initial Disclosures Due : | 10/15/2013 |
| Expert Disclosure Due : | 02/12/2014 |
| Discovery Closes : | 03/14/2014 |
| Plaintiff's Pretrial Disclosures : | 04/28/2014 |
| Plaintiff's 30-day Trial Period Ends : | 06/12/2014 |
| Defendant's Pretrial Disclosures : | 06/27/2014 |
| Defendant's 30-day Trial Period Ends : | 08/11/2014 |
| Plaintiff's Rebuttal Disclosures : | 08/26/2014 |
| Plaintiff's 15-day Rebuttal Period Ends : | 09/25/2014 |

Croda International Plc has secured the express consent of all other parties to this proceeding for the suspension and resetting of dates requested herein.

Croda International Plc has provided an e-mail address herewith for itself and for the opposing party so that any order on this motion may be issued electronically by the Board.

## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Respectfully submitted,
/Kristine Boylan/
Kristine Boylan
kboylan@merchantgould.com, aries@merchantgould.com, dockmpls@merchantgould.com
SWOLDOW@sgrlaw.com
05/13/2013

# EXHIBIT C

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

**May 13, 2013**

PROCEEDING NO. **91209218**
**Evonik Goldschmidt GmbH**

v.

**Croda International Plc**

MOTION TO SUSPEND GRANTED

**Croda International Plc's** motion filed, **May 13, 2013**, to suspend this proceeding is granted. Accordingly, proceedings herein are suspended through **Aug 11, 2013**, subject to the right of either party to request resumption at any time. During the suspension period, the parties shall notify the Board of any change of address for either the parties or their counsel.

Unless the parties sooner request resumption, upon conclusion of the suspension period, proceedings shall resume without further notice or order from the Board, upon the schedule set out in the motion. If an answer has not been filed, the defendant is allowed the time set forth in the motion in which to file an answer. The parties are allowed THIRTY DAYS from resumption in which to serve responses to any outstanding discovery requests.