

ESTTA Tracking number: **ESTTA702008**

Filing date: **10/13/2015**

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

Proceeding	91220096
Party	Defendant Morales Caro, Luis R.
Correspondence Address	SAMUEL F PAMIAS HOGLUND & PAMIAS PSC 256 ELEANOR ROOSEVELT STREET SAN JUAN, PR 00918 UNITED STATES samuel@hhoglund.com, aileen@hhoglund.com, nahomy@hhoglund.com, eida@hhoglund.com, adriana@hhoglund.com, vernonica@hhoglund
Submission	Opposition/Response to Motion
Filer's Name	Samuel F. Pamias
Filer's e-mail	samuel@hhoglund.com, jaime@hhoglund.com, adriana@hhoglund.com, aileen@hhoglund.com
Signature	/Samuel F. Pamias/
Date	10/13/2015
Attachments	OPPOSITION TO MOTION TO AMEND NOTICE OF OPPOSITION.pdf(189730 bytes) Exhibit 1-Opposition to Motion.pdf(631729 bytes) Exhibit 2- Opposition to Motion.pdf(1284666 bytes)

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

GlaxoSmithKline Consumer Healthcare
(UK) IP Limited

Opposer

v.

Morales Caro, Luis R.

Applicant

Opposition No. 91220096

Mark: **SANADOL**

Serial No. 86/244,742

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

P.O. Box 1451

Alexandria, VA 22313-1451

**MOTION IN OPPOSITION TO OPPOSER’S MOTION TO AMEND NOTICE OF
OPPOSITION**

COMES NOW applicant Luis R. Morales Caro (hereinafter referred to as “Applicant”), through its undersigned counsel, and respectfully states, alleges and prays:

INTRODUCTION

On September 22, 2015, Opposer GlaxoSmithKline Consumer Healthcare (UK) IP Limited filed a “Motion and Incorporated Memorandum of Law in Support of Motion to Amend Notice of Opposition” (“Motion to Amend”). In such Motion to Amend, Opposer moved to amend its notice of opposition to add as an additional ground for opposition that Applicant, at the time of the filing of the trademark application SANADOL, did not

have a bona fide intent to use the trademark Sanadol in interstate commerce. However, Applicant respectfully requests that Opposer's Motion to Amend be denied since (1) discovery proceedings in this case have not shown such alleged lack of bona fide intent; (2) the Motion to Amend is untimely and; (3) granting such Motion will cause prejudice to Applicant, whose trademark may be registered if no likelihood of confusion is found between the marks at issue, but now stands to loose protection of a potentially registrable trademark based on Opposer's unfounded new theory, if allowed by this Board.

DISCUSSION

By definition a trademark filed under the "intent to use" basis means that Applicant has not yet used the mark in commerce, but intends to use it in the future. See 15 U.S.C. §1051(b) and TMEP §1101. Further, when filing a trademark under the "intent to use" basis, Applicant must include a verified statement that it has a bona fide intention to use the mark in commerce. This means that, Applicant has more than just an idea but is less than market ready, for example creating sample products or having a business plan. See TMEP §1101, 804.02 and 1008. Accordingly, when Applicant files a trademark under the "intent to use" basis, an Examining Attorney will examine such trademark and after publishing the same, it will issue a notice of allowance ("NOA"). Applicant must then file a statement of use six months after the issuing of the NOA or may request up to 5 six-month extensions of time. Therefore, this means that Applicant has up to three years to begin using its trademark in commerce.

On the other hand, Section 507.02 of the Trademark Trial and Appeal Board Manual of Procedure ("TBMP") states that a party may amend its pleading only by written

consent of every adverse party or by leave of the Board. See Fed. R. Civ. P. 15(a). In these cases, the Board usually grants leave to amend pleadings, unless the amendment would violate settled law or is prejudicial to the rights of the adverse party. One of the factors used by the Board to determine whether it should grant the motion to amend is timing. As stated in American University v. Nico Van Niekerk, the timing of a motion for leave to amend under Fed. R. Civ. P. 15(a) is a major factor in determining whether the adverse party would be prejudiced by allowance of the proposed amendment. See *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993). See also, *Am. Univ.*, CANCELLATION 9204093, 2003 WL 22970623, at *2 (Dec. 15, 2003). According to Section 507.02(a) of the TBMP, the timing of the motion plays a large role in the Board's determination of whether a party would be prejudiced by the allowance of the proposed amendment. Therefore, a long a unexplained delay in filing the motion, **specifically when there is no question of newly discovered evidence**, may render the amendment untimely. See Section 507.02(a) of the TBMP.

In this case, since the earlier stages of the proceedings, meaning, even before Opposer filed its "Notice of Opposition" ("Opposition"), Opposer knew that Applicant was not using its SANADOL trademark in commerce, as allowed by 15 U.S.C. §1051(b). However, Opposer failed to include in its Opposition the allegation that Applicant did not have a bona fide intent to use the applied-for mark in the United States commerce but waited over almost one year to file its Motion to Amend after assuming that Applicant has no "documents reflecting preparations to use the applied-for mark". This is not only

speculative, but also misguided since the discovery proceedings in this case do not support said speculation.

It must be brought to the Board's attention that in Opposer's Requests for Production of Documents, Opposer requested several documents regarding Applicant's plans to use the mark, such as, market research, prospective future packaging, advertisements, labels, and other promotional or sales material containing Applicant's Mark. See Exhibit 1. However, Applicant objected such requests to the extent that they sought to obtain confidential-trade secret information. See Exhibit 2. Different from what Opposer attempts to conclude out of these objections, **in no way did Applicant respond or made any statement that may have led Opposer to conclude that Applicant did not have a bona fide intent at the time it requested the applied-for trademark.** *Id.*

This is further reinforced by the fact that, on September 30, 2015, Opposer filed before the Board "Opposer's Motion to Compel Discovery and Brief in Support of Motion" ("Motion to Compel"). In such Motion to Compel, Opposer requested the Board to issue an order compelling Applicant to produce all documents responsive to the request number 10, which requested "representative samples of... prospective future packaging, advertisements, labels, and other promotional, marketing, or sales materials containing Applicant's Mark, intended for use or potentially for use in the United States". Therefore, by its own pleadings and requests, Opposer concedes that it has not received a definite, final response from Applicant that may lead Opposer to conclude that Applicant holds no evidence of bona fide use of its trademark.

As such, since Applicant objected Opposer's requests for considering the documents to be trade-secret information, Opposer cannot reasonably imply that newly

discovered evidence in this case warrants its request to amend its Notice of Opposition, which is why its Motion to Amend should be considered untimely. Moreover, such Motion to Amend should be held in abeyance until the Board reaches a determination regarding Opposer's Motion to Compel. This, given that the Board has not yet evaluated whether Applicant is to produce such documents, Opposer's Motion to Amend is premature and no newly discovered evidence exists to support Opposer's untimely Motion to Amend.

Furthermore, Applicant asserts that granting Opposer's Motion to Amend upon its speculation of documents that show lack of bona fide intent from Applicant will be prejudicial to Applicant's rights. First, to grant an untimely and unfounded Motion to Amend, at this stage of the proceedings, would be a way for Opposer to prevent registration of a trademark which would otherwise be entitled to registration, since no likelihood of confusion exists between Applicant's and Opposer's marks. Further, Opposer now wants to include a new ground to its Opposition, in order to further prevent Applicant from registering its trademark, even though Opposer had knowledge since the beginning of these proceedings that Applicant was not using its trademark in commerce and that it could evidence such use at a later time. Therefore, almost one year after filing, Opposer seeks to amend its Opposition by mere speculation and when the discovery has not proven such new allegation.

As it is evident, Opposer's Motion to Amend is untimely, since there is no newly discovered evidence and it was filed almost one year after the Opposition, and granting it would cause prejudice to Applicant's rights. Therefore, Applicant respectfully requests this Board to deny the same.

WHEREFORE, Applicant hereby respectfully requests this Board to take notice of the foregoing for all practical purposes and that, as a result, an order be entered denying Opposer's Motion to Amend.

RESPECTFULLY SUBMITTED

This 13th of October, 2015

IT IS HEREBY CERTIFIED that on this date, a true and correct copy of Applicant's "Opposition to Motion to Amend Notice of Opposition" was served upon the Opposer via electronic mail to these emails: paul.llewellyn@kayescholer.com, tmcketing@kayescholer.com, john.rynkiewicz@kayescholer.com.

.On this 13th of October, 2015.



Samuel F. Pamiás-Portalatín
E-mail: samuel@hhoglund.com
Hoglund & Pamiás, P.S.C.
256 Eleanor Roosevelt Street
San Juan, Puerto Rico 00918
Telephone: 787-772-9200
Facsimile: 787-772-9533

Attorney for Applicant

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

SMITHKLINE BEECHAM LIMITED,

Opposer,

v.

LUIS R. MORALES CARO,

Applicant.

Opposition No. 91220096

Serial No. 86244742

Mark: SANADOL

**OPPOSER SMITHKLINE BEECHAM LIMITED'S FIRST SET OF
REQUESTS FOR PRODUCTION OF DOCUMENTS AND THINGS**

Pursuant to Rules 26 and 34 of the Federal Rules of Civil Procedure and Trademark Rules 2.116 and 2.210, Opposer SmithKline Beecham Limited requests that, within thirty days of service, Applicant Luis R. Morales Caro respond to these requests and produce each of the documents and things indicated below.

DEFINITIONS

Opposer incorporates by reference the Definitions set forth in Opposer's First Set of Interrogatories.

GENERAL INSTRUCTIONS

A. Each paragraph of this request calls for the production of each responsive document that is in Your possession, custody, or control, including, without limitation, each document in the possession, custody, or control of Your employees, agents, representatives, present or former consultants, attorneys, accountants, independent contractors, or investigators, and any other persons acting under Your control or on Your behalf, any corporations or other

6. Documents and things sufficient to identify each product and service in connection with which You have used, are using, or intend use Applicant's Mark in the United States.

7. Documents and things sufficient to identify each advertising and marketing channel or medium in which You have used, are using, or intend to use Applicant's Mark in the United States.

8. Documents and things sufficient to identify each distribution and retail channel in which You have used, are using or intend to use Applicant's Mark in the United States.

9. Documents and things sufficient to identify the categories or types of purchases of the products and services in connection with which You have used or intend to use Applicant's Mark in the United States.

10. Representative samples of each past, current, or prospective future packaging, advertisements, labels, and other promotional, marketing, or sales materials containing Applicant's Mark, intended for use or potentially for use in the United States, including, without limitation, all print advertisements, websites, online or digital advertising, social media presence (e.g., Facebook page, Twitter account, YouTube videos, online gaming, blogs), catalogs, labels, packages, brochures, pamphlets, marketing materials or documents, informational literature, press releases, price lists, stationery, business cards, radio advertisements and scripts therefor, television commercials and scripts and storyboards therefor, and online video or audio materials and scripts therefor.

11. Representative samples of any advertising and packaging used outside the United States for products bearing Applicant's Mark that are goods of the type covered by Your U.S. trademark application Serial No. 86244742.

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

SmithKline Beecham Limited

Opposer

v.

Morales Caro, Luis R.

Applicant

Opposition No. 91220096

Mark: **SANADOL**

Serial No. 86/244,742

Applicant’s Answers to “Opposer’s First Set of Requests for Production of Documents and Things”

Pursuant to Rule 34 of the Federal Rules of Civil Procedure and TMBP §§ 405 and 406, the Applicant, *Luis R. Morales Caro* (hereinafter “Applicant”), hereby responds and objects to Opposer’s First Set of Requests for Production of Documents and Things (“Opposer’s First Request” or “Request”) as follows:

GENERAL OBJECTIONS

1. Applicant’s answers and objections are made to the best of its present knowledge, information and belief. Said answers and objections are at all times subject to such additional or different information that discovery or further investigation may disclose.
2. Applicant objects to any request which seeks information and/or identification of documents and/or production of documents that embody material that is private, business confidential, proprietary, trade secret, attorney-client privileged, or attorney work product, on the grounds that such information and documents are privileged or confidential, and the disclosure of such confidential commercial information would be damaging to Applicant.
3. Applicant objects to any Request for the Production of Documents to the extent they seek to require Applicant to respond on behalf of any entity other than Applicant or to the extent Opposer seeks information not within the possession,

- c. Nevertheless, in a good faith effort to be responsive, and without waiving any of these specific objections and/or the “general objections”, Applicant avers that at this moment it has not located or identified any non-trade secret document that may be responsive to this request, as Applicant’s mark is not yet in use in commerce. Applicant reserves the right to supplement the answer to this request at a later date, as discovery progresses.
9. Documents and things sufficient to identify the categories or types of purchases of the products and services in connection with which You have used or intend to use Applicant’s Mark in the United States.
 - a. Applicant objects this request for being a compound request.
 - b. Applicant also objects to this request to the extent that it seeks to obtain confidential and trade secret information belonging to Applicant regarding future business plans, from which Applicant derives strategic, economic, commercial and/or competitive advantages, the disclosure of which to Opposer would cause irreparable harm to Applicant. Applicant further submits that Opposer has not established the relevance and the “need” for the disclosure of such confidential and trade secret information, according to the specific circumstances and controversies of the instant case.
 - c. Nevertheless, in a good faith effort to be responsive, and without waiving any of these specific objections and/or the “general objections”, Applicant avers that at this moment it has not located or identified any non-trade secret document that may be responsive to this request, as Applicant’s mark is not yet in use in commerce. Applicant reserves the right to supplement the answer to this request at a later date, as discovery progresses.
10. Representative samples of each past, current, or prospective future packaging, advertisements, labels, and other promotional, marketing, or sales materials containing Applicant’s Mark, intended for use or potentially for use in the United States, including, without limitation, all print advertisements, websites, online or digital advertising, social media presence (*e.g.*, Facebook page, Twitter account, YouTube videos, online gaming, blogs), catalogs, labels, packages, brochures, pamphlets, marketing materials or documents, informational literature, press releases, price lists, stationery, business cards, radio advertisements and scripts therefor, television commercials and scripts and storyboards therefor, and online video or audio materials and scripts therefor.

- a. Applicant objects this request for being a compound request. Applicant also objects this request for being overly broad and unduly burdensome.
 - b. Applicant objects to this request to the extent that it seeks to obtain confidential and trade secret information belonging to Applicant regarding future business plans, from which Applicant derives strategic, economic, commercial and/or competitive advantages, the disclosure of which to Opposer would cause irreparable harm to Applicant. Applicant further submits that Opposer has not established the relevance and the “need” for the disclosure of such confidential and trade secret information, according to the specific circumstances and controversies of the instant case.
 - c. Nevertheless, in a good faith effort to be responsive, and without waiving any of these specific objections and/or the “general objections”, Applicant avers that at this moment it has not located or identified any non-trade secret document that may be responsive to this request, as Applicant’s mark is not yet in use in commerce. Applicant reserves the right to supplement the answer to this request at a later date, as discovery progresses.
11. Representative samples of any advertising and packaging used outside the United States for products bearing Applicant's Mark that are goods of the type covered by Your U.S. trademark application Serial No. 86244742.
- a. Applicant objects this request for being a compound request.
 - b. Nevertheless, in a good faith effort to be responsive, and without waiving any of these specific objections and/or the “general objections”, Applicant avers that at this moment it has not located or identified any document that may be responsive to this request, as Applicant’s mark is not yet in use in commerce. Applicant reserves the right to supplement the answer to this request at a later date, as discovery progresses.
12. Representative samples of any television and radio advertising used anywhere in the world during the prior five years promoting any products using Applicant's Mark.
- a. Applicant objects this request for being a compound request.
 - b. Nevertheless, in a good faith effort to be responsive, and without waiving any of these specific objections and/or the “general objections”, Applicant avers that at this moment it has not located or identified any document