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

Proceeding	91220096
Party	Plaintiff GlaxoSmithKline Consumer Healthcare (UK) IP Limited
Correspondence Address	Paul C. Llewellyn Kaye Scholer LLP 250 West 55th Street New York, NY 10019-9710 UNITED STATES paul.llewellyn@kayescholer.com, tmdocketing@kayescholer.com, john.rynkiewicz@kayescholer.com
Submission	Motion to Amend Pleading/Amended Pleading
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Signature	/paul c. llewellyn/
Date	10/20/2015
Attachments	Declaration in Support of Motion (SANADOL).pdf(11434 bytes) Reply Memo in Support of Motion (SANADOL).pdf(18031 bytes) Exhibits to Declaration (SANADOL).pdf(3357267 bytes)

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

GLAXOSMITHKLINE CONSUMER
HEALTHCARE (UK) IP LIMITED,

Opposer,

v.

LUIS R. MORALES CARO,

Applicant.

Opposition No. 91220096

Mark: SANADOL

Serial No: 86244742

**DECLARATION OF PAUL C. LLEWELLYN
IN SUPPORT OF OPPOSER'S MOTION
TO AMEND NOTICE OF OPPOSITION**

I, Paul C. Llewellyn, declare as follows:

1. I am a partner at the law firm of Kaye Scholer LLP, counsel for Opposer. I submit this declaration in support of Opposer's motion to amend its notice of opposition to add as an additional ground for opposition that Applicant, at the time it filed its application, did not have a *bona fide* intent to use the mark SANADOL in interstate commerce. In particular, I submit this declaration to provide documents and respond to certain statements in Applicant's opposition to Opposer's motion.

2. Attached as **Exhibit A** is a true and correct copy of Opposer's First Set of Requests for Production of Documents and Things, dated May 19, 2015.

3. Attached as **Exhibit B** is a true and correct copy of Applicant's Answers to Opposer's First Set of Requests for Production of Documents and Things, dated June 23, 2015.

4. Attached as **Exhibit C** is a true and correct copy of an email chain between me and counsel for Applicant, including emails from me to counsel for Applicant dated July 11, 2015 and August 18, 2015.

5. The August 18 email in Exhibit C includes a summary of a telephone conference that was conducted between me and counsel for Applicant on July 30, 2015. Among other things, with respect to Opposer's Document Request No. 2, my August 18 email states, "I understand from the 7/30/2015 call that Applicant will check for search reports (e.g. third party reports such as Corsearch and Thomson; searches conducted by Applicant himself) and will check for any documents re conception of the SANADOL mark, and will produce any such documents." To date, Applicant has produced no such documents concerning the conception of the SANADOL mark.

6. Attached as **Exhibit D** is a true and correct copy of Applicant's Supplemental Answers to Opposer's First Set of Requests for Production of Documents and Things, dated September 23, 2015.

Pursuant to 28 U.S.C. § 1746, I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct.

Dated: October 20, 2015

/Paul C. Llewellyn/

CERTIFICATE OF SERVICE

This is to certify that on October 20, 2015, I caused a copy of the foregoing DECLARATION OF PAUL C. LLEWELLYN IN SUPPORT OF OPPOSER'S MOTION TO AMEND NOTICE OF OPPOSITION, including Exhibits A through D thereto, to be served by U.S. first-class mail, postage prepaid, on the attorneys of record for Applicant, namely:

Samuel F. Pamas, Esq.
Hoglund & Pamas, P.S.C.
256 Eleanor Roosevelt St.
San Juan, Puerto Rico 00918

/Jennifer Worksman/

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

GLAXOSMITHKLINE CONSUMER
HEALTHCARE (UK) IP LIMITED,

Opposer,

v.

LUIS R. MORALES CARO,

Applicant.

Opposition No. 91220096

Mark: SANADOL

Serial No: 86244742

**REPLY MEMORANDUM OF LAW IN FURTHER
SUPPORT OF MOTION TO AMEND NOTICE OF OPPOSITION**

Opposer GlaxoSmithKline Consumer Healthcare (UK) IP Limited submits this reply memorandum of law in further support of its motion to amend its notice of opposition to add as an additional ground for opposition that Applicant, at the time it filed its application, did not have a *bona fide* intent to use the mark SANADOL in interstate commerce.

In its initial motion and memorandum of law (Docket #9), Opposer demonstrated that the requested amendment should be permitted: The proposed amendment does not violate settled law and is not prejudicial to the rights of Applicant. (*See* TBMP § 507.02 (standard for granting motion to amend notice of opposition).) Applicant sets forth three arguments in its opposition to the motion, all of which fail to refute Opposer’s strong showing that amendment should be permitted.

First, Applicant incorrectly asserts that “discovery proceedings in this case have not shown such alleged lack of bona fide intent.” Putting aside that this does not address the standard for leave to amend, it is not true. To the contrary, discovery to date has suggested a lack of evidence of *bona fide* intent. Not only does Applicant concede (Docket #12 at p.4) that

so far he has not produced any documents reflecting preparations to use his mark, Applicant also has produced no documents regarding his conception, creation or selection of his mark, and no documents that identify any products in connection with which he intends to use the mark.

Thus, in its Document Request No. 2, Opposer sought “All documents and things concerning the conception, creation, selection, adoption, design, approval, or clearance of Applicant’s Mark, including any and all formal or informal trademark searches, trademark search reports, online searches, surveys, polling or other market research, alternative marks considered, investigations, analyses, opinions, and/or communications between [Applicant] and any person concerning Applicant’s Mark.” Ex. A.¹ Applicant’s initial responses, dated June 23, 2015, asserted various objections to the request and did not agree to produce any documents in response to the request. *See* Ex. B.

Counsel for Opposer then sent an email to Applicant’s counsel on July 11, 2015, concerning Applicant’s responses. Counsel for the parties had a telephone call on the issue on July 30, 2015, and on August 18, 2015, counsel for Opposer sent another email to counsel for Applicant confirming the parties’ July 30 discussion. *See* Ex. C. Among other things, with respect to Document Request No. 2, the August 18 email states “I understand from the 7/30/2015 call that Applicant will check for search reports (e.g. third party reports such as Corsearch and Thomson; searches conducted by Applicant himself) and will check for any documents re conception of the SANADOL mark, and will produce any such documents.” Ex. C (emphasis added). To date, Applicant has produced no such documents concerning the conception of the SANADOL mark. Llewellyn Decl. ¶ 5. Since then, moreover, Applicant served a supplemental

¹ “Ex.” refers to the exhibits are attached to the accompanying Declaration of Paul C. Llewellyn dated October 20, 2015 (“Llewellyn Decl.”).

response to Document Request No. 2, which asserts various objections and then states: “Subject to and without waiving any of its General and Specific Objections, and in a good-faith effort to be responsive, Applicant submits that up to this moment he has found no non-privileged documents responsive to this request for production.” Ex. D (emphasis added).

Similarly, in its Document Request No. 6, Opposer sought “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.” Ex. A (emphasis added).

Applicant’s response to this request asserts various objections and then states: “Nevertheless, in a good faith effort to be responsive, and waiving any of these specific objections and/or the “general objections”, Applicant avers that at this moment it has not located or identified and document that may be responsive to this request, as Applicant’s mark is not yet in use in commerce.” Ex. B (emphasis added).

Plainly, what little discovery Applicant has provided tends to show an absence of intent to use the applied-for mark. What is more, whether the limited discovery to date has confirmed a lack of *bona fide* use is beside the point: Discovery is ongoing, Applicant has not yet been deposed, and by no means can Applicant show that amendment at this stage would be futile or would violate settled law.

Second, Applicant fails to show that the proposed amendment is untimely. Applicant argues, speciously, that Opposer should have included the claim for lack of *bona fide* intent in its initial notice of opposition, before any discovery whatsoever. Applicant ignores, however, that there was no reason for Opposer to suspect at the time of the filing of the initial notice of opposition that Applicant lacked the requisite *bona fide* intent, and that it is precisely Applicant’s failure to date to produce relevant documents in discovery that has provided Opposer with a

reasonable basis to assert the claim. *See Montblanc-Simplo GmbH v. United Brands Int'l, Inc.*, No. 91185637 (T.T.A.B. 2009) (non-precedential) (granting motion to amend to add an additional ground for opposition that applicant lacked a *bona fide* intent to use the mark MONTBLANC in commerce for the described goods; motion not untimely where it was based on information gained during discovery, and was made before close of discovery). Tellingly, Applicant cites no authority holding that an opposer should assert a lack of *bona fide* intent claim at the outset of a proceeding, before obtaining any discovery at all. Nor does Applicant cite any authority holding that an amendment to assert such a claim, made during discovery, is untimely.

Third, Applicant fails to identify any prejudice that he would suffer as a result of the proposed amendment: Applicant merely argues that it would be injured if, as a result of the amendment, it is prevented from obtaining a registration. As the Board has repeatedly held, in cases that Applicant ignores, there is no prejudice to an applicant where, as here, a new ground for opposition relates solely to evidence within the control of Applicant, discovery is ongoing, and Applicant would not need to conduct additional discovery regarding the added ground. *See Montblanc-Simplo*, No. 91185637 (no prejudice where motion to amend made before close of discovery); *Metromedia Steakhouses Inc. v. Pondco II Inc.*, 28 U.S.P.Q. 2d 1205, 1207-08 (T.T.A.B. 1993) (no prejudice where non-moving party would not need to conduct additional discovery); *Diageo North Am., Inc. v. Captain Russell Corp.*, No. 91203745 (T.T.A.B. 2013) (non-precedential) (granting motion to amend to add assertion of a lack of *bona fide* intent; non-moving party was in possession of the relevant evidence).

CONCLUSION

In view of the foregoing and for the reasons set forth in its initial motion and memorandum of law, Opposer respectfully requests that the Board grant it leave to amend the

Notice of Opposition, in the form submitted with Docket #9, to allege that the subject application is void *ab initio* because Applicant did not have a *bona fide* intent to use the applied-for marks in commerce on the goods claimed in the applications as of the application's filing date.

/Paul C. Llewellyn/
Paul C. Llewellyn
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Washington, DC 20005
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Attorneys for Opposer

CERTIFICATE OF SERVICE

This is to certify that on this 20th day of October, 2015, I caused a copy of the foregoing
REPLY MEMORANDUM OF LAW IN FURTHER SUPPORT OF MOTION TO AMEND
NOTICE OF OPPOSITION to be served by first-class mail, postage prepaid, on the attorneys of
record for Applicant, namely:

Samuel F. Pamas, Esq.
Hoglund & Pamas, P.S.C.
256 Eleanor Roosevelt St.
San Juan, Puerto Rico 00918

/Jennifer Worksman/

Jennifer Worksman

EXHIBIT A

**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

business entities owned or controlled in whole or in part by You, or as a fictitious business name for any of the foregoing.

B. If You object to any part of any discovery request, state with particularity both the grounds and the reasons for Your objection and respond to all parts of the request to which Your objection does not apply.

C. If You cannot answer any of these requests in full, You shall answer to the extent possible, specifying the reasons for Your inability to answer the remainder and stating what information, knowledge, or belief You have concerning the unanswered portion.

D. If You withhold under a claim of privilege (including attorney work-product) any document or thing requested herein, You shall furnish a privilege log specifying: (i) the nature of the privilege claimed and, if the privilege is being asserted in connection with a claim or defense governed by federal or state law or any other rule, the privilege rule being invoked; (ii) the general subject matter of the document; (iii) the nature or type of document (*e.g.*, letter, email, memorandum); (iv) the date of the document; (v) the name, and position or job title, of each author; (vi) the name, and position or job title, of each addressee, recipient, and person to whom a copy or copies were furnished; and (vii) the paragraph of this request to which each such document is responsive.

E. If any document requested herein is no longer in Your possession, custody, or control because of destruction, loss, or any other reason, then, with respect to each such document, state: (i) the nature or type of document (*e.g.*, letter, email, memorandum); (ii) the date of the document; (iii) the name, and position or job title, of each author; (iv) the name, and position or job title, of each addressee, recipient, and person to whom a copy or copies were furnished; (v) in as much detail as possible, the contents of the document; (vi) each custodian of

the document and each person otherwise responsible for the document's safekeeping, storage, or filing; (vii) the date the document was lost or destroyed; (viii) the circumstances surrounding the loss of the document and, if the document was destroyed, the reason for the circumstances surrounding its destruction; and (ix) the paragraph of this request to which each such document is responsive.

F. If any document requested herein has been lost or destroyed, such document is to be identified by stating the following: (i) the type of document (*e.g.*, letter or memorandum); (ii) the general subject matter of the document; (iii) the date of the document; (iv) the identity of each author and recipient (including actual and designated recipients of copies) of the document; (v) each custodian of the document and each person otherwise responsible for the document's safekeeping, storage, or filing; (vi) the date the document was lost or destroyed; and (vii) the circumstances surrounding the loss of the document and, if the document was destroyed, the reason for the circumstances surrounding its destruction.

G. If the answer to any request is unknown to You, so state and identify the name and address of each person that might have such information.

H. In responding to each request, You are to review and search all relevant files within its possession, custody, or control, including all relevant files of appropriate entities and persons within Your control.

I. Produce all electronically stored information in full, including all metadata, either (i) in single-page TIFF format accompanied with extracted metadata and full-text, or (ii) in native format.

J. As required by Federal Rule of Civil Procedure 34(b), You must produce all documents requested for inspection or copying either as they are kept in the usual course of business or shall organize and label them to correspond with the requests below.

K. Each document produced shall be identified in such production by the paragraph number(s) of the request(s) with respect to which it is produced.

L. Pursuant to Federal Rule of Civil Procedure 26(e), You are under a continuing duty to furnish additional and supplemental documents where such further documents become known or available between the time of the initial response thereunder and the time of hearing or trial in this proceeding.

REQUESTS FOR PRODUCTION

1. All documents and things identified in response to, requested to be identified in, or referred to in preparing answers to Opposer's First Set of Interrogatories.

2. All documents and things concerning the conception, creation, selection, adoption, design, approval, or clearance of Applicant's Mark, including any and all formal or informal trademark searches, trademark search reports, online searches, surveys, polling or other market research, alternative marks considered, investigations, analyses, opinions, and/or communications between You and any person concerning Applicant's Mark.

3. All documents and things setting forth or concerning any change or modification of the Applicant's Mark since the time of conception of Applicant's Mark.

4. All documents and things comprising or describing any communications between You and the U.S. Patent and Trademark Office or the Trademark Trial and Appeal Board concerning Applicant's Mark or Opposer's Mark.

5. Documents sufficient to identify and describe Your first use, if any, of Applicant's Mark in the United States.

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.

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.

13. All documents and things concerning or referring to Opposer or Opposer's Mark.

14. All documents and things concerning or reflecting your knowledge or awareness at any time of Opposer's Mark.

15. All documents and things concerning any inquiries or communications from any person concerning or referring to Opposer's products or services or Opposer's Mark.

16. All documents and things concerning any actual, alleged, potential, or possible instances of confusion, mistake, or deception between Opposer, Opposer's products or services, or Opposer's Mark, on the one part, and You, Your products or services, or Applicant's Mark, on the other part.

17. All documents concerning any inquiries or communications from any person concerning, referring to, or evidencing any actual, potential, or possible relationship between You or any product or service in connection with which You have used or intend to use the Applicant's Mark, on the one hand, and Opposer, Opposer's products or services, or Opposer's Mark, on the other hand.

18. All documents and things comprising or describing any communications between You and any third party concerning this proceeding.

19. All documents and things supporting each of Your defenses and affirmative defenses asserted in Your Answer.

20. All documents and things concerning the factual basis, if any, for Your information and belief alleged in Your tenth affirmative defense asserted in Your Answer to the

effect that Opposer purportedly obtained its interest in Opposer's Mark "by way of an invalid transfer."

21. All documents and things concerning the factual basis, if any, for Your eighteenth affirmative defense asserted in Your Answer (alleging that "Opposer is not entitled to maintain its Opposition by reason of estoppel").

22. All documents and things concerning the factual basis, if any, for Your nineteenth affirmative defense asserted in Your Answer (alleging that "The Opposition is barred by the equitable doctrine of waiver").

23. All documents and things concerning the factual basis, if any, for Your twenty-first affirmative defense asserted in Your Answer (alleging that "Opposer maliciously filed the instant action in an attempt to monopolize or restrain trade and in order to harass a legitimate competitor").

24. All documents provided to, reviewed by, or prepared for or by any person whom You expect or intend to call as an expert witness at any stage in these proceedings, or on whose testimony (written or oral) You intend to rely on at any stage in this litigation, including, without limitation, all documents such person plans to use, refer to, or rely upon.

Dated: May 19, 2015
New York, New York



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*Attorneys for Opposer SmithKline Beecham
Limited*

CERTIFICATE OF SERVICE

I hereby certify that on this 19th day of May, 2015, I caused a true and correct copy of the foregoing document to be served by first class mail upon the following attorney of record:

SAMUEL F PAMIAS
HOGLUND & PAMIAS PSC
256 ELEANOR ROOSEVELT STREET
SAN JUAN, PR 00918

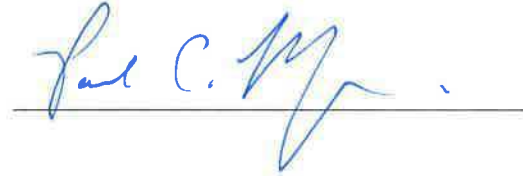
A handwritten signature in blue ink, appearing to read "Samuel F. Pamas", is written over a horizontal line.

EXHIBIT B

**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,

custody, or control of Applicant or information regarding issues that are proper subjects for experts, which have not yet been designated and Applicant objects to the Requests to the extent that they seek an expert opinion.

4. Applicant objects to any Request for the Production of Documents that is overly broad, irrelevant, vague and unduly burdensome; that goes beyond the allegations of any claim or defense asserted herein; that is not appropriately limited to subjects, times and areas relevant to this proceeding; that requires legal conclusions; or that is not calculated to lead to the discovery of admissible evidence.
5. Applicant reserves the right to provide supplemental responses as additional information becomes available or is made known to Applicant.
6. Applicant objects to the request for the Production of Documents to the extent they seek information of matters of public record or information that is equally available to Opposer.
7. Applicant objects generally and individually to the request for the Production of Documents on the grounds and to the extent that they assume facts not in evidence or otherwise are erroneous.
8. Applicant objects to the request for the Production of Documents to the extent they attempt to shift to Applicant the burden of reviewing documents to determine whether any responsive information exists and compiling responsive information if located.
9. Applicant objects to the request for the Production of Documents to the extent they are not reasonably limited in time.
10. Applicant does not represent that there exist any documents responsive to any particular request, and Applicant's statement that documents responsive to a particular request will be produced does not mean that any such documents in fact exist or that Applicant has possession, custody or control over said document(s). In addition, Applicant reserves the right to produce only the responsive portions of a document when that document also contains non-responsive, confidential, privileged, proprietary or personal information, or other information not relevant to the subject matter of this action.
11. Applicant incorporates by reference the foregoing Objections in response to each

Request whether or not set forth at length below.

Subject to these "General Objections" and the limitations which are outlined with regard to each specifically numbered Response, Applicant responds to Opposer's First Request without waiver of, and with the preservation of the following:

1. The right to object on the grounds of competency, privilege, relevance, materiality or any other proper ground, to the use of any material produced herein, in whole or in part, for any purpose, in any subsequent proceeding in this action or in any other action;
2. The right to object on any and all proper grounds, at any time, to other requests, or other discovery procedures involving or relating to the subject matter of the requests responded to herein; and
- 3. The right, at any time, to revise, correct, modify, supplement or clarify any of the answers provided herein.**

All of Applicant's responses are made subject to the foregoing objections, comments and qualifications.

RESPONSES AND SPECIAL OBJECTIONS TO REQUESTS FOR PRODUCTION OF DOCUMENTS

Subject to and without waiving the foregoing General Objections, Applicant hereby responds to and/or specifically objects to the following requests for production of documents:

1. All documents and things identified in response to, requested to be identified in, or referred to in preparing answers to Opposer's First Set of Interrogatories.
 - a. Applicant objects this request for being overly broad and unduly burdensome as to "all documents and things".
 - b. Nevertheless, subject to and without waiving any of its General and Specific Objections, and in a good-faith effort to be responsive, Applicant submits that it has found no relevant documents responsive to this request for production. Applicant reserves the right to provide supplemental responses to this request as discovery progresses and/or additional information becomes available or is made known to Applicant.
2. All documents and things concerning the conception, creation, selection adoption, design, approval, or clearance of Applicant's Mark, including any and

all formal or informal trademark searches, trademark search reports, online searches, surveys, polling or other market research, alternative marks considered, investigations, analyses, opinions, and/or communications between You and any person concerning Applicant's Mark.

- a. Applicant objects this request for being overly broad and unduly burdensome, particularly in regard to the use and scope of the phrase "all documents and things concerning".
 - b. Applicant also objects this request for being a compound request.
 - c. Applicant objects this request to the extent that it seeks to obtain confidential and trade secret information belonging to Applicant, 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.
 - d. Applicant further objects this request to the extent that, as drafted, it may be requesting documents protected under the attorney-client privilege. Please **reformulate**.
3. All documents and things setting forth or concerning any change or modification of the Applicant's Mark since the time of conception of Applicant's Mark.
- a. Applicant objects this request for being overly broad and unduly burdensome, particularly in regard to the use and scope of the phrase "all documents and things setting forth or concerning".
 - b. Nevertheless, subject to and without waiving any of its General and Specific Objections, and in a good-faith effort to be responsive, Applicant submits that it has found no relevant documents responsive to this request for production. Applicant reserves the right to provide supplemental responses to this request as discovery progresses and/or additional information becomes available or is made known to Applicant.
4. All documents and things comprising or describing any communications between You and the U.S. Patent and Trademark Office or the Trademark Trial and Appeal Board concerning Applicant's Mark or Opposer's Mark.
- a. Applicant objects this request for being overly broad and unduly burdensome, particularly in regard to the use and scope of the phrase "all

documents and things comprising or describing".

- b. Applicant also objects this request for being a compound request.
 - c. Applicant further objects to this request because it attempts to shift to Applicant the burden of conducting research and compiling evidence to support Opposer's Opposition. This request is unduly burdensome as the information requested, to the extent it involves communications with the U.S. Patent and Trademark Office (USPTO) or the Trademark Trial and Appeal Board (TTAB), relates to **public records that are readily available to Opposer** at the electronic databases of the USPTO and TTAB. Accordingly, we refer Opposer to those public records, where it may seek and obtain any documents it may want, without imposing any burden or expense to Applicant.
5. Documents sufficient to identify and describe Your first use, if any, of Applicant's Mark in the United States.
- a. At this moment Applicant has not located or identified any document 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.
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.
- a. Applicant objects this request for being a compound request. Applicant further objects to this request to the extent it requests evidence regarding services rendered in connection to Applicant's mark; the applied-for mark at issue is for goods.
 - 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.
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.
- a. Applicant objects to this request as it is vague, ambiguous, confusing

and/or imprecise in relation to the meaning given to the term "medium." Furthermore, Applicant objects this request since it is a compound request.

- b. Applicant also objects this request to the extent that it seeks to obtain confidential, 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.
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.
- a. Applicant objects this request for being a compound request.
 - b. Applicant also objects this request to the extent that it seeks to obtain confidential, 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.

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 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.
13. All documents and things concerning or referring to Opposer or Opposer's Mark.
 - a. Applicant objects this request for being overly broad and unduly burdensome, particularly in regard to the use and scope of the phrase "all

documents and things concerning or referring to".

- b. Applicant also objects to this request for being overly broad and unduly burdensome, and because it attempts to shift to Applicant the burden of conducting research and compiling evidence to determine whether any information exist in the World, to support Opposer's Opposition, and because it purports to impose upon Applicant obligations greater than those set forth in the Federal Rules of Civil Procedure and the TBMP.
 - c. Applicant further objects to this request as it is vague, ambiguous, confusing and/or imprecise, particularly as it does not make reference to a specific person, source, time frame and scope of evidence requested. Therefore, it is impossible to make a response. For these same reasons, this request is objected to the extent it seeks to obtain information that is irrelevant to the cause of action and controversies in this case, and that is not reasonably calculated to lead to the discovery of admissible evidence.
Please reformulate your request.
14. All documents and things concerning or reflecting your knowledge or awareness at any time of Opposer's Mark.
- a. Applicant objects this request for being overly broad and unduly burdensome, particularly in regard to the use and scope of the phrase "all documents and things concerning or reflecting".
 - b. Applicant also objects to this request for production to the extent it seeks to obtain information that is irrelevant to the cause of action and controversies in this case, and that is not reasonably calculated to lead to the discovery of admissible evidence, particularly when this is not a case of trademark infringement, but rather a case of alleged likelihood of confusion and Applicant's right to register the marks at issue. TBMP § 102.01 (3d ed. 2011). **As a result, the scope of discovery in Board proceedings is generally narrower than in court proceedings, especially court proceedings involving allegations of infringement".** Frito-Lay North America, Inc. v. Princeton Vanguard, LLC, 100 U.S.P.Q.2d 1904 (2011). (Our emphasis.). The knowledge or awareness that Applicant may have had about any use (constructive or actual) or registration of Opposer's Marks bears no impact on the issue of likelihood of confusion between two marks, in a inter-partes proceeding like the one at hand, where the analysis must be concentrated on whether any likelihood of confusion exists. Such analysis must be conducted taking into consideration by analyzing any similarities between the parties' marks and their respective products. Moreover, the Board has stated that the two key

considerations are the similarities between the marks and the similarities between the goods or services. In *Re SL&E Training Stable Inc. U.S.P.Q. 2d 1216*. Therefore, Applicant's knowledge, if any, of Opposer's Marks is completely irrelevant as to whether the marks and the products have any similarities.

15. All documents and things concerning any inquiries or communications from any person concerning or referring to Opposer's products or services or Opposer's Mark.

- a. Applicant objects this request for being overly broad and unduly burdensome, particularly in regard to the use and scope of the phrase "all documents and things concerning".
- b. Applicant also objects to this request for being overly broad and unduly burdensome, and because it attempts to shift to Applicant the burden of conducting research and compiling evidence to determine whether any information exist in the World, to support Opposer's Opposition, and because it purports to impose upon Applicant obligations greater than those set forth in the Federal Rules of Civil Procedure and the TBMP.
- c. Applicant further objects to this request as it is vague, ambiguous, confusing and/or imprecise, particularly as it does not make reference to a specific person, source, time frame and scope of evidence requested. Therefore, it is impossible to make a response. For these same reasons, this request is objected to the extent it seeks to obtain information that is irrelevant to the cause of action and controversies in this case, and that is not reasonably calculated to lead to the discovery of admissible evidence.

Please reformulate your request.

16. All documents and things concerning any actual, alleged, potential, or possible instances of confusion, mistake, or deception between Opposer, Opposer's products or services, or Opposer's Mark, on the one part, and You, Your products or services, or Applicant's Mark, on the other part.

- a. Applicant objects this request for being overly broad and unduly burdensome, particularly in regard to the use and scope of the phrase "all documents and things concerning".
- b. Applicant objects to this request as it is vague, ambiguous, confusing and/or imprecise, and for being a compound request.
- c. Applicant objects this request to the extent it calls for speculation.

- d. Applicant also objects to this Request because it attempts to shift to Applicant the burden of conducting research and compiling evidence to determine whether any information exist in the World, to support Opposer's Opposition, and because it purports to impose upon Applicant obligations greater than those set forth in the Federal Rules of Civil Procedure and the TBMP.
 - e. 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.
17. All documents concerning any inquiries or communications from any person concerning, referring to, or evidencing any actual, potential, or possible relationship between You or any product or service **in connection with which You have used or intend to** use the Applicant's Mark, on the one hand, and Opposer, Opposer's products **or services, or Opposer's** Mark, on the other hand.
- a. Applicant objects this request for being overly broad and unduly burdensome, particularly in regard to the use and scope of the phrase "all documents concerning".
 - b. Applicant objects to this request as it is **extremely** vague, ambiguous, confusing and/or imprecise. Furthermore, Applicant objects this request since it is a compound request.
 - 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 document that may be responsive to this request. Applicant reserves the right to supplement the answer to this request at a later date, as discovery progresses.
18. All documents and things comprising or describing any communications between You and any third party concerning this proceeding.
- a. Applicant objects this request for being overly broad and unduly burdensome, particularly in regard to the use and scope of the phrase "all documents and things comprising or describing", and the term "concerning". Likewise, this request is vague, confusing and imprecise regarding the use and scope of the term "concerning" and, as such, it is objected to the extent it may seek evidence irrelevant to this cause of

action and controversies of this case.

b. Applicant objects this request to the extent that, as drafted, it may be requesting documents protected under the attorney-client privilege.
Please reformulate your request.

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 relevant, non-privileged document that may be responsive to this request. Applicant reserves the right to supplement the answer to this request at a later date, as discovery progresses.

19. All documents and things supporting each of Your defenses and affirmative defenses asserted in Your Answer.

a. Applicant objects this request for being overly broad and unduly burdensome, particularly in regard to the use and scope of the phrase "all documents and things supporting".

b. Nevertheless, in a good faith effort to be responsive, and without waiving any of these specific objections and/or the "general objections", see documents produced herewith, marked as Exhibit 1. Applicant reserves the right to supplement the answer to this request at a later date, as discovery progresses.

20. All documents and things concerning the factual basis, if any, for Your information and belief alleged in Your tenth affirmative defense asserted in Your Answer to the effect that Opposer purportedly obtained its interest in Opposer's Mark "by way of an invalid transfer."

a. Applicant objects this request for being overly broad and unduly burdensome, particularly in regard to the use and scope of the phrase "all documents and things concerning".

b. Applicant objects this request as it refers to a legal conclusion.

21. All documents and things concerning the factual basis, if any, for Your eighteenth affirmative defense asserted in Your Answer (alleging that "Opposer is not entitled to maintain its Opposition by reason of estoppel")

a. Applicant objects this request for being overly broad and unduly burdensome, particularly in regard to the use and scope of the phrase "all documents and things concerning".

- b. Applicant objects this request as it refers to a legal conclusion.
22. All documents and things concerning the factual basis, if any, for Your nineteenth affirmative defense asserted in Your Answer (alleging that "The Opposition is barred by the equitable doctrine of waiver").
- a. Applicant objects this request for being overly broad and unduly burdensome, particularly in regard to the use and scope of the phrase "all documents and things concerning".
 - b. Applicant objects this request as it refers to a legal conclusion.
23. All documents and things concerning the factual basis, if any, for Your twenty-first affirmative defense asserted in Your Answer (alleging that "Opposer maliciously filed the instant action in an attempt to monopolize or restrain trade and in order to harass a legitimate competitor").
- a. Applicant objects this request for being overly broad and unduly burdensome, particularly in regard to the use and scope of the phrase "all documents and things concerning".
 - b. Applicant objects this request as it refers to a legal conclusion.
24. All documents provided to, reviewed by, or prepared for or by any person whom You expect or intend to call as an expert witness at any stage in these proceedings, or on whose testimony (written or oral) You intend to rely on at any stage in this litigation, including, without limitation, all documents such person plans to use, refer to, or rely upon.
- a. Applicant objects this request for being overly broad and unduly burdensome, particularly in regard to the use and scope of the phrase "all documents".
 - b. Applicant objects this request for being a compound request.
 - 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 contacted any experts. Applicant reserves the right to supplement the answer to this request at a later date, as discovery progresses.

Respectfully submitted,

June 23, 2015

As to the objections,

Hoglund & Pamas, P.S.C.

256 Eleanor Roosevelt Street
San Juan, Puerto Rico 00918
Telephone: 787-772-9200 / 787-772-9834
Fax: 787-772-9533

s/Aileen E. Vazquez Jimenez/
Aileen E. Vazquez Jimenez
E-mail: aileenahodlund.com

Samuel F. Pamas Portalatin
E-mail: samelahodlund.com

Attorneys for Applicant

CERTIFICATE OF SERVICE

It is hereby certified that a true copy of APPLICANT'S ANSWER TO OPPOSER'S FIRST SET OF REQUESTS FOR DOCUMENTS AND THINGS was served upon the Opposer via electronic mail to the mails:
paul.11ewellvnakavescholer.com,tmocketindakavescholercom ,io hn xvnkiewiczakave
scholer.com.

s/Aileen E. Vazquez Jimenez/
Aileen E. Vazquez Jimenez
E-mail: aileen@hhoglund.com
Hoglund & Pamas, P.S.C.
256 Eleanor Roosevelt Street
San Juan, Puerto Rico 00918
Telephone: 787-772-9234
Fax: 787-772-9533

DECLARATION UNDER PENALTY OF PERJURY

I, Luis Roberto Morales Caro declare under penalty of perjury that to the best of my know1edge the foregoing information is true and correct Furthermore, I state that I have read the foregoing answers and know the contents thereof; that the answers set forth therein, subject to inadvertent or undiscovered errors are based on and therefore necessarily limited by the records and information still in existence. presently recollected, and thus far discovered in the course for the preparation of these answers, that I reserve the right to make any changes in the answers if it appears at any time that omissions or errors have been made therein or that more accurate information is available; and that subject to these limitation the information is true to the best of my knowledge, information and belief

Executed in Mayaguez , Puerto Rico , on June 23. 2015.

EXHIBIT C

Llewellyn, Paul

From: Llewellyn, Paul
Sent: Tuesday, August 18, 2015 11:08 AM
To: 'Samuel F Pamiás'; Aileen Vazquez; Adriana Amadeo; 'jaime@hhoglund.com'
Cc: Gooch, Kyle; Worksman, Jennifer
Subject: SmithKline Beecham Limited v. Luis Morales Caro Opposition No. 91220096

Follow Up Flag: Follow up
Flag Status: Flagged

Dear Samuel -

Following up on our 7/30/2015 call regarding Applicant's discovery responses, below I have annotated (**in bold**), in my July 11 email, my understand of the current status of the issues we discussed on our call. Can you let me know when Applicant will supplement his responses as we discussed?

With respect to issues #1 and #7 below, we still think that the requests seek discoverable information, and Opposer reserves its right to move to compel if Applicant does not agree to produce the requested documents and information.

Thank you and best regards,

Paul

Paul C. Llewellyn
Kaye Scholer LLP
250 West 55th Street | New York, New York 10019-9710
T: (212) 836-7828 | F: (212) 836-6463
Paul.Llewellyn@kayescholer.com | www.kayescholer.com

From: Llewellyn, Paul
Sent: Saturday, July 11, 2015 8:58 AM
To: 'Samuel Pamiás'
Cc: 'Aileen Vazquez'; 'Adriana Amadeo '; 'Jaime López'; Docketing, Trademark
Subject: RE: ANSWERS- SmithKline Beecham Limited v. Luis Morales Caro Opposition No. 91220096

Dear Samuel –

I write with respect to Applicant's responses to Opposer's document requests and interrogatories. The purpose of this email is to briefly set forth our main concerns with a number of Applicant's responses. I suggest that after you have had a chance to consider these issues, we have a call to discuss them in greater detail in the hope that we can resolve them.

1. In response to Interrogatory 4, Applicant refuses to say whether he was aware of the PANADOL mark when he selected his proposed mark. Intent is, of course, relevant to likelihood of confusion, so we do not see the basis for this refusal and request that you provide a full response to this interrogatory.
 - a. Similarly, Document Request 14 seeks documents concerning Applicant's awareness of the PANADOL mark; such documents are highly relevant and must be produced.

PL8/17/2015: I understand from the 7/30/2015 call that Applicant disagrees with Opposer's position and will not provide the requested info/docs. Opposer reserves its right to seek production of this material.

2. In Document Request 13, we request documents applicant has in its possession or control that refer to PANADOL; Applicant responds as if we requested them to research PANADOL throughout the world. Any documents in Applicant's possession or control that refer to PANADOL would bear on Applicant's knowledge of the PANADOL mark, his intent in selecting his mark, and possibly potential confusion, and should be produced.

PL8/17/2015: I understand from the 7/30/2015 call that Applicant will check for any documents After some discussion whether the request is too broad, they agreed to see if the applicant has any documents in Applicant's possession or control that refer to PANADOL or GSK

3. In response to Interrogatory 11, Applicant refuses to say whether he is aware of instances of actual confusion between his mark and Opposer's marks. Given the clear relevance of such evidence to the likelihood of confusion analysis, we see no basis for this refusal and request that you provide a full response to this interrogatory.

PL8/17/2015: I understand from the 7/30/2015 call that Applicant will provide a substantive response to Interrogatory 11.

4. In response to Interrogatory 12, Applicant refuses to say whether there have been communications with third parties regarding the PANADOL mark, because they say it might include privileged communications. We see no basis for the assertion that communications between Applicant and third parties would be privileged; moreover, such communications may relate to actual confusion, intent in selecting Applicant's mark, and other highly relevant issues. We request that you provide a full response to this interrogatory; you are free to exclude communications between Applicant and his counsel.
 - a. Similarly, Document Request 15 seeks documents concerning communications with third parties regarding the PANADOL mark; such documents are highly relevant and must be produced.

PL8/17/2015: I understand from the 7/30/2015 call that Applicant will provide a substantive response to Interrogatory 12 and documents in response to Document Request 15, in both instances excluding communications between Applicant and Applicant's counsel.

5. In response to Interrogatories 13-16, Applicant refuses to provide any factual basis for the referenced affirmative defenses, on the ground that the interrogatories – which expressly request the “factual basis” for the cited affirmative defenses – “require[] a legal conclusion.” Similarly, Document Requests 20-23 seek documents concerning the factual basis for those affirmative defenses, but Applicant refuses to produce such documents on the ground that the requests call for a legal conclusion. Plainly, the requests seek the “factual basis” for the affirmative defenses, which is relevant and discoverable information. Opposer requests that Applicant fully respond to these requests and interrogatories.

PL8/17/2015: I understand from the 7/30/2015 call that Applicant will look at these interrogatories and provide substantive responses.

6. In response to Document Request 2, Applicant refuses to produce documents regarding his the conception of the SANADOL mark, and refuse to produce trademark search reports relating to the selection and clearance of the mark. Both of these categories of documents are relevant, and neither is privileged. Opposer requests that Applicant fully respond to these requests.

PL8/17/2015: I understand from the 7/30/2015 call that Applicant will check for search reports (e.g. third party reports such as Corsearch and Thomson; searches conducted by Applicant himself) and will check for any documents re conception of the SANADOLmark, and will produce any such documents.

7. In response to Document Request 10, Applicant asserts that copies of proposed packaging are trade secrets and refuses to produce them. Given that all TTAB proceedings are governed by the Board's standard protective order, and given that your client's proposed manner of use of the SANADOLmark is potentially relevant to confusion issues, there is no basis to refuse to produce the requested documents, and Opposer requests that Applicant do so.

PL8/17/2015: I understand from the 7/30/2015 call that Applicant disagrees with Opposer's position and will not provide the requested docs. Opposer reserves its right to seek production of this material.

8. In response to Document Requests 11-12, Applicant responds that the SANADOLmark is not used "in commerce"; it is not clear whether this refers to United States commerce, use in the United States and its territories possessions, or something else. To permit us to understand these responses, can you please clarify whether Applicant has any SANADOLproduct packaging or advertising in use outside of the US and its territories possessions?

PL8/17/2015: I understand from the 7/30/2015 call that the SANADOLmark is not in use anywhere in the world, and therefore Applicant has no responsive documents to produce in response to Document Requests 11 and 12.

I look forward to speaking with you in greater depth about these issues in the near future. I suggest we schedule a call for a few weeks' time, during the week of July 27, when we can discuss.

Thank you and best regards,

Paul

Paul C. Llewellyn
Kaye Scholer LLP
250 West 55th Street | New York, New York 10019-9710
T: (212) 836-7828 | F: (212) 836-6463
Paul.Llewellyn@kayescholer.com | www.kayescholer.com

From: Adriana Amadeo [<mailto:adriana@hhoglund.com>]
Sent: Wednesday, June 24, 2015 9:32 AM
To: Llewellyn, Paul
Cc: 'Aileen Vazquez'; samuel@hhoglund.com; 'Jaime López'; Docketing, Trademark; Rynkiewicz, John
Subject: ANSWERS- SmithKline Beecham Limited v. Luis Morales Caro Opposition No. 91220096

Dear Mr. Llewellyn,

Attached hereto please find a copy of "Applicant's Answers to Opposer's First Set of Interrogatories to Applicant" and "Applicant's Answers to Opposer's First Set of Requests for Production of Documents and Things". As agreed during our conversation, should you require hard copy of the documents, we will then send them by mail.

Should you have any questions, please do not hesitate to contact us.

Regards,



Adriana T. Amadeo-Vissepó
Attorney at Law
Hoglund & Parias, P.S.C.
256 Eleanor Roosevelt
San Juan, Puerto Rico 00918
Tel: (787) 772-9200 / 9834 Fax: (787) 772-9533
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EXHIBIT D

**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 Supplemental 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

Applicant incorporates by reference the General Objections set forth in Applicant's Answers to Opposer's First Set of Requests for Production of Documents and Things, dated June 23, 2015, as if set forth here at length.

Subject to these "General Objections", Applicant supplements the Answers to Opposer's First Set of Requests for Production of Documents and Things without waiver of, and with the preservation of the following:

1. The right to object on the grounds of competency, privilege, relevance, materiality or any other proper ground, to the use of any material produced herein, in whole or in part, for any purpose, in any subsequent proceeding in this action or in any other action;
2. The right to object on any and all proper grounds, at any time, to other requests, or other discovery procedures involving or relating to the subject matter of the requests responded to herein; and

3. The right, at any time, to revise, correct, modify, supplement or clarify any of the answers provided herein.

All of Applicant's responses are made subject to the foregoing objections, comments and qualifications.

SUPPLEMENTAL RESPONSES AND SPECIAL OBJECTIONS TO REQUESTS FOR PRODUCTION OF DOCUMENTS

2. All documents and things concerning the conception, creation, selection adoption, design, approval, or clearance of Applicant's Mark, including any and all formal or informal trademark searches, trademark search reports, online searches, surveys, polling or other market research, alternative marks considered, investigations, analyses, opinions, and/or communications between You and any person concerning Applicant's Mark.
 - a. Applicant objects this request for being overly broad and unduly burdensome, particularly in regard to the use and scope of the phrase "all documents and things concerning".
 - b. Applicant also objects this request for being a compound request.
 - c. Applicant objects this request to the extent that it seeks to obtain confidential and trade secret information belonging to Applicant, 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.
 - d. Applicant further objects this request to the extent that, as drafted, it may be requesting documents protected under the attorney-client privilege.
 - e. Nevertheless, subject to and without waiving any of its General and Specific Objections, and in a good-faith effort to be responsive, Applicant submits that up to this moment he has found no relevant non-privileged documents responsive to this request for production. Applicant reserves the right to provide supplemental responses to this request as discovery progresses and/or additional information becomes available or is made known to Applicant.
13. All documents and things concerning or referring to Opposer or Opposer's Mark.

- a. Applicant objects this request for being overly broad and unduly burdensome, particularly in regard to the use and scope of the phrase “all documents and things concerning or referring to”.
 - b. Applicant also objects to this request for being overly broad and unduly burdensome, and because it attempts to shift to Applicant the burden of conducting research and compiling evidence to determine whether any information exist in the World, to support Opposer’s Opposition, and because it purports to impose upon Applicant obligations greater than those set forth in the Federal Rules of Civil Procedure and the TBMP.
 - c. Applicant further objects to this request as it is vague, ambiguous, confusing and/or imprecise, particularly as it does not make reference to a specific person, source, time frame and scope of evidence requested.
 - d. Nevertheless, subject to and without waiving any of its General and Specific Objections, and in a good-faith effort to be responsive, Applicant submits that up to this moment he has found no non-privileged documents responsive to this request for production. Applicant reserves the right to provide supplemental responses to this request as discovery progresses and/or additional information becomes available or is made known to Applicant.
15. All documents and things concerning any inquiries or communications from any person concerning or referring to Opposer’s products or services or Opposer’s Mark.
- a. Applicant objects this request for being overly broad and unduly burdensome, particularly in regard to the use and scope of the phrase “all documents and things concerning”.
 - b. Applicant also objects to this request for being overly broad and unduly burdensome, and because it attempts to shift to Applicant the burden of conducting research and compiling evidence to determine whether any information exist in the World, to support Opposer’s Opposition, and because it purports to impose upon Applicant obligations greater than those set forth in the Federal Rules of Civil Procedure and the TBMP.
 - c. Applicant further objects to this request as it is vague, ambiguous, confusing and/or imprecise, particularly as it does not make reference to a specific person, source, time frame and scope of evidence requested. Therefore, it is impossible to make a response. For these same reasons, this request is objected to the extent it seeks to obtain information that is

irrelevant to the cause of action and controversies in this case, and that is not reasonably calculated to lead to the discovery of admissible evidence.

- d. Nevertheless, subject to and without waiving any of its General and Specific Objections, and in a good-faith effort to be responsive, Applicant submits that up to this moment he has found no communications, other than those protected under the attorney-client privilege, with third parties, concerning or referring to Opposer's products or services or Opposer's Mark.
 - e. Applicant reserves the right to provide supplemental responses to this request as discovery progresses and/or additional information becomes available or is made known to Applicant.
20. All documents and things concerning the factual basis, if any, for Your information and belief alleged in Your tenth affirmative defense asserted in Your Answer to the effect that Opposer purportedly obtained its interest in Opposer's Mark "by way of an invalid transfer."
- a. Applicant objects this request for being overly broad and unduly burdensome, particularly in regard to the use and scope of the phrase "all documents and things concerning".
 - b. Applicant objects this request as it refers to a legal conclusion.
 - 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 up to this moment he has found no relevant documents responsive to this request for production.
 - d. Given that discovery in this proceeding has not yet closed, and since discovery is ongoing, Applicant reserves the right to supplement the answer to this request at a later date, as discovery progresses.
21. All documents and things concerning the factual basis, if any, for Your eighteenth affirmative defense asserted in Your Answer (alleging that " Opposer is not entitled to maintain its Opposition by reason of estoppel")
- a. Applicant objects this request for being overly broad and unduly burdensome, particularly in regard to the use and scope of the phrase "all documents and things concerning".
 - b. Applicant objects this request as it refers to a legal conclusion.

- 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 up to this moment he has found no relevant documents responsive to this request for production.
 - d. Given that discovery in this proceeding has not yet closed, and since discovery is ongoing, Applicant reserves the right to supplement the answer to this request at a later date, as discovery progresses.
22. All documents and things concerning the factual basis, if any, for Your nineteenth affirmative defense asserted in Your Answer (alleging that “The Opposition is barred by the equitable doctrine of waiver”).
- a. Applicant objects this request for being overly broad and unduly burdensome, particularly in regard to the use and scope of the phrase “all documents and things concerning”.
 - b. Applicant objects this request as it refers to a legal conclusion.
 - 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 up to this moment he has found no relevant documents responsive to this request for production.
 - d. Given that discovery in this proceeding has not yet closed, and since discovery is ongoing, Applicant reserves the right to supplement the answer to this request at a later date, as discovery progresses.
23. All documents and things concerning the factual basis, if any, for Your twenty-first affirmative defense asserted in Your Answer (alleging that “Opposer maliciously filed the instant action in an attempt to monopolize or restrain trade and in order to harass a legitimate competitor”).
- a. Applicant objects this request for being overly broad and unduly burdensome, particularly in regard to the use and scope of the phrase “all documents and things concerning”.
 - b. Applicant objects this request as it refers to a legal conclusion.
 - 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 up to this moment he has found no relevant documents responsive to this request for production.

- d. Given that discovery in this proceeding has not yet closed, and since discovery is ongoing, Applicant reserves the right to supplement the answer to this request at a later date, as discovery progresses.

Respectfully submitted,

September 23, 2015

As to the objections,

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Attorneys for Applicant

CERTIFICATE OF SERVICE

It is hereby certified that a true copy of APPLICANT'S SUPPLEMENTAL ANSWER TO OPPOSER'S FIRST SET OF REQUESTS FOR DOCUMENTS AND THINGS was served upon the Opposer via electronic mail to the emails:

paul.llewellyn@kayescholer.com, tmdocketing@kayescholer.com, john.rynkiewicz@kayescholer.com.

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DECLARATION UNDER PENALTY OF PERJURY

I, Luis R. Morales Caro, declare under penalty of perjury that to the best of my knowledge the foregoing information is true and correct. Furthermore, I state that I have read the foregoing supplemental answers and know the contents thereof; that the answers set forth therein, subject to inadvertent or undiscovered errors, are based on and therefore necessarily limited by the records and information still in existence, presently recollected, and thus far discovered in the course for the preparation of these supplemental answers; that I reserve the right to make any changes in the supplemental answers if it appears at any time that omissions or errors have been made therein or that more accurate information is available; and that subject to these limitation the information is true to the best of my knowledge, information and belief.

Executed in San Juan, Puerto Rico, on September 23, 2015.


Luis R. Morales Caro