ESTTA Tracking number: **ESTTA898433**

Filing date: **05/22/2018**

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

Proceeding	91229956
Party	Defendant ATG Ceylon (Pvt) Limited
Correspondence Address	NICOLE K MCLAUGHLIN DUANE MORRIS LLP 30 S 17TH STREET PHILADELPHIA, PA 19103 UNITED STATES Email: nkmclaughlin@duanemorris.com
Submission	Opposition/Response to Motion
Filer's Name	Nicole K. McLaughlin
Filer's email	NKMcLaughlin@duanemorris.com
Signature	/Nicole K. McLaughlin/
Date	05/22/2018
Attachments	Applicants Opposition to Opposers Motion to Compel Applicants Substantive Responses to Discovery with Exhibit A.pdf(493101 bytes)

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

ANSELL LIMITED,	:	
	:	
Opposer,	:	Opposition No. 91229956
v.	:	
	:	
	:	
ATG CEYLON (PVT) LIMITED,	:	App. Ser. No. 86571248
	:	
Applicant.	:	

APPLICANT'S OPPOSITION TO OPPOSER'S MOTION TO COMPEL APPLICANT'S SUBSTANTIVE RESPONSES TO DISCOVERY

Applicant ATG Ceylon (Pvt) Limited hereby opposes Ansell Limited's Motion to Compel Applicant's Substantive Responses to Discovery ("Motion to Compel"). Opposer's Motion to Compel is deficient in several respects and should be denied. Opposer seeks to force Applicant to respond to discovery requests on issues that are based on grounds which the Board has already expressly rejected. Specifically, on January 23, 2017, the Board expressly struck Opposer's pleaded claims, in its Amended Notice of Opposition, of deceptiveness and deceptive misdescriptiveness. Accordingly, the only ground in the current opposition is Opposer's allegation of mere descriptiveness. However, in its Motion to Compel, Opposer admits that its discovery requests are directed to grounds of deceptiveness, deceptive misdescriptiveness and mere descriptiveness. Thus, the present Motion to Compel is improper and overly broad on its face and directed to discovery that is not relevant to the sole ground of mere descriptiveness.

In addition, Opposer has not engaged with Applicant in good faith in attempting to resolve the discovery dispute. This is shown by Opposer (1) unilaterally filing this untimely Motion to Compel by failing to wait for Applicant to timely respond to Opposer's Second

Deficiency Letter, (2) improperly asserting that Applicant has the burden of proof for the Motion to Compel, and (3) characterizing alleged inconsistent discovery responses as deficient responses.

I. Ansell is Using the Wrong Legal Standard to Improperly Shift the Burden of Proof to Applicant

Opposer asserts that Applicant has the burden of proof asserting that "if the non-moving party cannot show that neglect of its discovery obligations was excusable, the Board generally should order that discovery responses be provided without objection", citing *No Fear, Inc. v Rule*, 54 USPQ2d 1551,1554 (TTAB 2000). MTC p. 5. However, the standard of excusable neglect is only for cases in which no discovery responses were filed by the non-moving party, and therefore the non-moving party can be ordered to respond to the discovery responses without objection. TBMP 527.01(c). Here, Applicant ***did*** respond to Opposer's discovery requests, and raised valid objections, which have subsequently been ignored by Opposer. Because the burden of proof remains with Opposer, and Opposer is unable to meet its burden of proof, the Motion to Compel should be denied.

II. Opposer Has Not Made a Good Faith Effort to Resolve the Discovery Dispute

A motion to compel discovery must be supported by a written statement from the moving party that such party or its attorney has made a good faith effort, by conference or correspondence, to resolve with the other party or its attorney the issues presented in the motion, and has been unable to reach agreement. TBMP § 523.02. In determining whether a good faith effort to resolve the discovery dispute has been made, the Board may consider whether attempts at resolution were incomplete. *Id.*

Here, Opposer filed the Motion to Compel within the middle of a discovery dispute, and before receiving Applicant's responses to its Second Deficiency Letter, which were not due until ***8 days after*** Opposer filed its Motion to Compel.

In its Second Deficiency Letter dated April 5, 2018, (Exhibit F to the MTC[1]), Opposer requested that Applicant respond "no later than April 11, 2018". On April 6, 2018, the parties agreed to extend all deadlines by 30 days while they engaged in settlement discussions, thus making Applicant's response to the Second Deficiency Letter due on May 11, 2018. Applicant's timely response to the Second Deficiency Letter, dated May 11, 2018, is attached hereto as Applicant's **Exhibit A**. Thus, Opposer's filing of the Motion to Compel on May 3, 2018, 8 days before Applicant's deadline to respond, did not afford Applicant the opportunity to timely respond to Opposer's Second Deficiency Letter. This clearly demonstrates Opposer's lack of good faith in attempting to resolve the discovery dispute which was incomplete.

III. Opposer's Discovery Requests are Overly Broad and Not Limited to the Sole Ground at Issue in the Opposition

In its Motion to Compel, Opposer states that "[t]he information that [Opposer] has sought through discovery is relevant and necessary for Opposer to prepare for trial of this dispute on the issues of **deceptiveness**, **deceptive misdescriptiveness**, and mere descriptiveness." MTC p. 3; (emphasis added). Moreover, Opposer justified the relevancy of its discovery requests as follows:

> [Opposer] has asserted in its First Amended Notice of Opposition that ATG's mark **AD-APT** is deceptive, deceptively misdescriptive, and/or merely descriptive of the goods, or a function, characteristic, or claim of the goods; namely that such goods contain **All Day Anti-Perspirant Technology**. In an effort to garner some of the evidence necessary to prove its claims, [Opposer] has propounded multiple requests for relevant information and documents on these issues.

[1] The Motion to compel will be cited as "MTC p. x."

MTC p. 6 (emphasis in original).

Opposer's justification for its discovery requests ignores the Board's Order issued on January 23, 2017. In its Order, the Board stated "Because Opposer's deceptive misdescriptiveness and deceptiveness claims are not based upon any prior determination of noncompliance with FDA regulations or *per se* statutory violation, those claims are insufficient." Order, P. 7. As a result, the Board ruled that "This case will go forward solely on the Section 2(e)(1) mere descriptiveness claim." Order, p. 8.

Thus, on its face, Applicant's Motion to Compel improperly seeks to force Applicant to respond to discovery on issues that are not grounds of the opposition. This fact by itself is dispositive that Opposer has not filed its Motion to Compel in good faith.

IV. When Opposer's Discovery Requests are Narrowed to the Sole Ground in this Opposition, Applicant Has Fully Responded

In its Motion to Compel, Opposer asserts that Applicant's discovery responses to Interrogatory Nos. 16, 18 and 20 are deficient. For each of these requests, Applicant objected to the requests as "overbroad" and seeking "information not relevant to or proportional to the needs of the case." Ex. C to MTC, pp. 16, 17 and 20.

A. Response to Interrogatory No. 16

Applicant does not understand Opposer's assertion that Applicant's response to Interrogatory No. 16 is somehow deficient. As an initial mater, Opposer did not identify Interrogatory No. 16 in its Second Deficiency Letter to Applicant and thus raising it in a Motion to Compel is evidence that Opposer did not engage with Applicant in good faith to resolve this perceived deficiency. In its Motion to Compel, Opposer notes that Applicant stated that "it would produce non-privileged documents responsive to this request; however, no such

documents were ever produced." MTC p. 6. However, two sentences later, Opposer quotes from documents produced by Applicant having Bates Nos. ATG_0001 through ATG_00019, that are responsive to Interrogatory 16. *Id.* The documents state what the documents state, and to the extent that Opposer wanted to explore further what was stated on the documents, it had the opportunity to depose Applicant, but chose not to do so. The fact that Opposer may not understand Applicant's documents does not mean Applicant's response is deficient.

B. Response To Interrogatory No. 18

Opposer's Interrogatory No. 18 is directed to identifying all independent testing and certifications for Applicant's gloves. In its response, Applicant stated,
"it has no certification for gloves bearing the AD-APT term that are relevant to this matter." Opposer in its Motion to Compel identifies three certifications issued by the Skin Health Alliance, Oeko-Tex and REACH for Applicant's gloves as the basis for asserting Applicant's response is deficient. As Applicant explained to Opposer in Applicant's May 10 response letter, Opposer is well aware that Skin Health Alliance, Oeko-Tex and REACH certifications are generally safety standards that are not dependent upon whether a product includes "all day antiperspirant technology." Ex. A.

Moreover, in its response to the First Deficiency Letter of October 12, 2017, Applicant addressed Opposer's claimed deficiencies, and specifically requested that Opposer provide the factual basis for why it believed that certifications issued by the Skin Health Alliance, Oeko-Tex, and REACH are relevant to whether Applicant's gloves have all day antiperspirant technology properties. Ex. D to MTC. To date, Opposer has been unable to explain the relevance of these certifications, as to the sole ground of the opposition, and thus Opposer's unsupported assertions do not show that Applicant's response has been deficient.

C. Interrogatory No. 20.

The issue raised by Opposer with respect to Interrogatory No. 20 conflates Applicant's use of "cooling agents" in its marketing materials with "all day antiperspirant technology." As Opposer is aware, a product which a company wants to claim and/or market as an "antiperspirant" must comply with the Over the Counter (OTC) Monograph promulgated by the US FDA. In fact, Opposer identified the FDA requirements in its original Notice of Opposition. Thus, just because a product includes "cooling agents" does not mean it is an antiperspirant, or meets the requirements for an all-day antiperspirant. Likewise, a listing of ingredients of a product, which is not marketed pursuant to the FDA monograph for an antiperspirant, is not relevant as to whether the term AD-APT is merely descriptive of Applicant's gloves. Once again, to the extent that Opposer does not understand the marketing materials of Applicant, Opposer had the opportunity to depose Applicant on these issues but chose not to do so.

D. Conclusion

For the reasons stated above, Opposer's Motion to Compel is both procedurally and substantively deficient and should be denied.

Respectfully submitted,

Dated: May 22, 2018

/Nicole K. McLaughlin/
Nicole K. McLaughlin
DUANE MORRIS LLP
30 S. 17th Street
Philadelphia, PA 19103
(215) 979-1191

Attorneys for Applicant

CERTIFICATE OF SERVICE

I hereby state that a true and correct copy of the foregoing Applicant's Opposition To Opposer's Motion To Compel Applicant's Substantive Responses To Discovery was mailed via e-mail and first-class mail, postage prepaid to Attorneys for Opposer as follows this 22nd day of May 2018.

Charles P. Guarino
MOSER TABOADA
1030 Broad Street, Suite 203
Shrewsbury, New Jersey 07702
cguarino@mtiplaw.com

By: /Josh Staples/

EXHIBIT A

NEW YORK
LONDON
SINGAPORE
PHILADELPHIA
CHICAGO
WASHINGTON, DC
SAN FRANCISCO
SILICON VALLEY
SAN DIEGO
LOS ANGELES
TAIWAN
BOSTON
HOUSTON
AUSTIN
HANOI
HO CHI MINH CITY

DuaneMorris®

FIRM and AFFILIATE OFFICES

NICOLE K. MCLAUGHLIN
DIRECT DIAL: +1 215 979 1191
PERSONAL FAX: +1 215 689 4934
E-MAIL: NKMcLaughlin@duanemorris.com

www.duanemorris.com

SHANGHAI
ATLANTA
BALTIMORE
WILMINGTON
MIAMI
BOCA RATON
PITTSBURGH
NEWARK
LAS VEGAS
CHERRY HILL
LAKE TAHOE
MYANMAR
OMAN
A GCC REPRESENTATIVE OFFICE OF DUANE MORRIS

ALLIANCES IN MEXICO
AND SRI LANKA

May 11, 2018

VIA E-MAIL
(CGUARINO@MTIPLAW.COM)

Charles P. Guarino
Moser Taboada
1030 Broad Street, Suite 203
Shrewsbury, NJ 07702

Re: Ansell Limited v. ATG Ceylon (Pvt) Limited (TM Opp. No. 91229956)

Dear Mr. Guarino:

We are surprised to have received your Motion to Compel, especially since the motion is premature and ignores the fact that ATG has outstanding objections to be addressed. As you are aware, on April 6, 2018, we agreed to a 30 day extension "of all deadlines" in order to allow the parties to engage in settlement discussions. Therefore, our deadline to respond to your letter of April 5, 2018, wherein you requested receipt of our responses by April 11, 2018, was extended to today, May 11, 2018. Thus, your unilateral decision to prematurely file a second Motion to Compel on May 3, 2018, without waiting for our response to your April 5, 2018 letter, is improper and not in accordance with TBMP § 408.01, which requires the parties to meet and confer in good faith. Accordingly, we request that you immediately withdraw your Motion to Compel, otherwise, we will raise your improper filing with the TTAB.

With respect to your April 5, 2018 letter, it does not address the valid objections which we raised in our discovery responses, and as detailed in our letter of October 24, 2017. Specifically, we noted that your requests were broader than that allowed by Fed. R. Civ Pro. 26, as they sought information beyond Ansell's claim that AD-APT is an acronym for the descriptive phrase "All Day Anti-Perspirant Technology." For example, your client is well aware that Skin Health Alliance, Oeko-Tex and REACH certifications are generally safety standards that are not dependent upon whether a product includes 'all day antiperspirant technology'. Thus, your assertion that these certifications are "clearly relevant" to whether our client's gloves include 'all day antiperspirant technology' is factually unsupported.

The issue you raise with respect to Interrogatory No. 20 conflates our client's description of "cooling agents" with 'all day antiperspirant technology.' As your client is aware, a product which a company wants to claim and/or market as an "anti-perspirant" must comply with the Over the Counter (OTC) Monograph promulgated by the USFDA. Thus, just because a product includes "cooling agents" does not mean it is an antiperspirant. Likewise, a listing of ingredients of a product which is not marketed pursuant to the FDA monograph as an antiperspirant is not relevant.

We are supplementing our discovery to include U.S. Patent No. 9,890,497, which recently issued to our client. Here is a link to the patent.
http://www.freepatentsonline.com/9890497.pdf

In view of the fact that your Motion to Compel is improper, we will not consent to an extension of time. We look forward to receiving your disclosures on Monday.

Sincerely,

Nicole K. McLaughlin

Nicole K. McLaughlin