

ESTTA Tracking number: **ESTTA964475**

Filing date: **04/03/2019**

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

Proceeding	91240240
Party	Defendant Salud Natural Mexicana S.A. DE C.V.
Correspondence Address	JEFFREY M FURR FURR LAW FIRM 2622 DEBOLT ROAD UTICA, OH 43080 UNITED STATES JeffMFurr@FurrLawFirm.com 740-817-2381
Submission	Other Motions/Papers
Filer's Name	Jeffrey M. Furr, Esq.
Filer's email	jeffmfurr@furrlawfirm.com
Signature	/jmf/
Date	04/03/2019
Attachments	eucmotion56d.pdf(394511 bytes)

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

In the Matter of
US Serial Number 87638836

ARSA DISTRIBUTING, INC.

Opposer,

v.

Opposition No. 91240240

SALUD NATURAL MEXICANA SA de CV

Applicant.

UNITED STATES PATENT AND
TRADEMARK TRIAL AND APPEAL BOARD
PO BOX 1451
ALEXANDRIA VA 22313-1451

**APPLICANT'S MOTION UNDER RULE 56(d) OF THE FEDERAL RULES OF CIVIL
PROCEDURE FOR ADDITIONAL DISCOVERY**

This is a Motion under Rule 56(d) of the Federal Rules of Civil Procedure for additional Discovery. The Opposer filed for a Motion for Summary Judgment which was accepted by the Trademark Trial and Appeal Board on March 4, 2019. This motion is timely filed as it has been filed within 30 days.

When a party believes that it cannot effectively oppose a motion for summary judgment without first taking discovery it may file a request with the Board for time to

take the needed discovery. The request must be supported by an affidavit or declaration showing that the nonmoving party cannot, for reasons stated therein, present facts essential to justify its opposition to the motion. See Fed. R. Civ. P. 56(d); *Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1475 (Fed. Cir. 1992) (finding sufficient need for additional discovery); *Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1860 (TTAB 2007) (nonmoving party may respond to summary judgment motion by filing motion for Rule 56(f) discovery).

If a party has demonstrated a need for discovery that is reasonably directed to obtaining facts essential to its opposition to the motion, discovery will be permitted, especially if the information sought is largely within the control of the party moving for summary judgment. See *Orion Group Inc. v. Orion Insurance Co.*, 12 USPQ2d 1923, 1925-26 (TTAB 1989). The motion should set forth with specificity the areas of inquiry needed to obtain the information necessary to enable the party to respond to the motion for summary judgment.

Background

On March 22, 2018, Opposer filed an Opposition to Applicant's US Serial Number 87638836 and on September 19, 2018, Opposer filed an Opposition to Applicant's US Serial Number 86779422. These actions were consolidated into Opposition No. 91240240.

Applicant took a deposition of Opposer's Witness, ROSSANA ARRAS, on March 1, 2019. Opposer filed a Motion for Summary Judgment on March 4, 2019.

During the discovery deposition of Opposer's principal, ROSSANA ARRAS, Opposer objected and refused to answer questions about who produced. This brings up a red flag as to why the Opposer refused to answer the question.

From page 11, lines 2-8 of the March 1, 2019 deposition.

Q. Who produced the product?

MS. LEBRON-DYKEMAN: Objection as to relevancy.

MR. FURR: Relevant on seeing who else was producing the product. They originally got it from Salud, so the question is where did they get the product from.

From page 15, lines 10-25 through page 16 lines 1-4 of the March 1, 2019 deposition.

Q. Okay. Do you manufacture the syrup?

MS. LEBRON-DYKEMAN: Again, objection as to relevancy.

MR. FURR: Discovery deposition, so relevancy really shouldn't apply.

MS. LEBRON-DYKEMAN: Well, the federal rules are somewhat limited on proportionality and relevance. They've been much more narrowed after 2016, and I'm trying to understand why the manufacturer relates to the trademark usage.

MR. FURR: My next question will probably answer that one, but you can object, and we'll -- Are you going to let her answer or are you just going --

MS. LEBRON-DYKEMAN: If you're

asking for her manufacturer, I'm not going to let her answer.

MR. FURR: Okay. Then I'm just going to ask the next question.

Who manufactured the product for the Opposer is important to the questions of unclean hands, abandonment and priority. Did the Opposer continue to buy Applicants products directly or indirectly through Applicant's sellers or did they take Applicant proprietary products to be made by someone else or did not have anyone manufacture it basically abandoning it or are the rights with the manufacturer. These questions are relevant to the case and need to be answered as they go to unclean hands, abandonment and priority.

The Applicant asked that the Board find the questions relevant and to have the Opposer answer them through the attached written discovery requests.

In support of this Motion, Applicant states as follows:

The Applicant cannot effectively oppose the motion for summary judgment without first taking proposed written discovery Interrogatives (Exhibit 1) and Request for Documents (Exhibit 2) based on the line of questioning that the Opposer refused to answer. of the Opposer as the Opposer is a key witness in this case.

The information sought by the Applicant is only within the control of the Opposer (the party moving for summary judgment). The information cannot be obtained from anyone else or anywhere else.

As required, the Applicant has included a declaration by Jeffrey Furr, attorney for the Applicant, to support its Fed. R. Civ. P. 56(d) motion. Exhibit 3.

Conclusion

If a party has demonstrated a need for discovery that is reasonably directed to obtaining facts essential to its opposition to the motion, discovery will be permitted, especially if the information sought is largely within the control of the party moving for summary judgment. In this case, the Applicant has demonstrated a need for discovery and that information is known by the Opposer and only the Opposer. It is not available anywhere else. This motion sets forth with specificity the areas of inquiry needed to obtain the information necessary to enable the party to respond to the motion for summary judgment.

WHEREFORE, Applicant prays that its Motion under Rule 56(d) of the Federal Rules of Civil Procedure for Additional Discovery be granted.

Respectfully Submitted,

/jmf/

Jeffrey M. Furr 38,146
Attorney for Applicant
Salud Natural Mexicana SA de CV
2622 Debolt Road
Utica, Ohio 43080
740-817-2381 (telephone)
740-892-2118 (fax)
JeffMFurr@FurrLawFirm.com

CERTIFICATE OF FILING

I hereby certify that this answer is being electronically filed with the United States Patent and Trademark Trial and Appeal Board on the 3rd day of April, 2019.

/jmf/
Jeffrey M. Furr, Esquire

CERTIFICATE OF SERVICE

I hereby certify that this paper is being transmitted by electronic mail on the 3rd day of April, 2019 addressed to:

CHRISTINE LEBRON DYKEMAN
MCKEE VOORHEES & SEASE PLC
christine.lebron-dykeman@ipmvs.com

/jmf/
Jeffrey M. Furr, Esquire

Exhibit 1

In the Matter of
US Serial Number 87638836

ARSA DISTRIBUTING, INC.

Opposer,

v.

Opposition No. 91240240

SALUD NATURAL MEXICANA SA de CV

Applicant.

UNITED STATES PATENT AND
TRADEMARK TRIAL AND APPEAL BOARD
PO BOX 1451
ALEXANDRIA VA 22313-1451

APPLICANT'S FIRST SET OF INTERROGATORIES TO OPPOSER

Applicant, SALUD NATURAL MEXICANA SA de CV, requests that Opposer answer separately and fully in writing, under oath, within 30 days, pursuant to Rule 33 of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice, the following interrogatories.

INSTRUCTIONS

If any one or more of these interrogatories is or are objected to on the ground of privilege, overbreadth, vagueness or similar ground, Opposer is instructed for each such interrogatory to answer the interrogatory within the 30-day period as narrowed to

conform with the objection. Where Opposer lacks knowledge of exact information responsive to an interrogatory, Opposer is instructed to say so and to answer the interrogatory to the best of its present knowledge, to supply the best available estimate of the requested information, and to explain the basis of the estimate.

These interrogatories are continuing and Opposer is instructed to supplement its responses immediately whenever it acquires additional information pertinent thereto.

Any document asserted to be confidential or subject to a claim of privilege or attorney work product should be identified by a description of the document, the date, the authors, the addresses, those receiving copies and the subject matter discussed in the document.

If Opposer contends that any information requested by these interrogatories is confidential, Opposer is instructed to so indicate and supply a proposed protective order to apply to such confidential information in this litigation. Opposer will stipulate to a reasonable protective order.

DEFINITIONS

The following definitions are applicable to terms employed in these Interrogatories, in the Instructions accompanying these Interrogatories and in these Definitions.

- A. The term “person” refers to natural persons, organizations, associations, partnerships, joint ventures, corporations (including Opposer) and other legal entities, and the actions taken by a person include the actions of

directors, officers, owners, members, partners, joint venturers, employees, agents or attorneys acting on the person's behalf.

- B. The singular includes the plural and vice versa; the words "and" and "or" shall be construed in both the conjunctive and disjunctive; the word "all" means "any and all"; the word "any" means "any and all".
- C. The terms "relates" and "refers" mean directly or indirectly mentioning, discussing, describing, pertaining to or connected with, a stated subject matter.
- D. The term "document" is used in its customary broad sense and encompasses, without limitation, all handwritten, typed, printed or otherwise visually or aurally reproduced materials, whether copies, drafts or originals, and irrespective of whether they are privileged against discovery on any ground, or within the possession, custody or control of Opposer, or its directors, officers, employees, agents, attorneys, consultants, independent contractors or representative, including but not limited to: letters, correspondence, cables, wires, facsimiles, telegrams, notes, memoranda, diaries, e-mails and other electronic messages, notes or records of telephone conversations, notes or records of personal conversations or interviews, interoffice and intraoffice communications of all types, drawings, plans, sketches, charts, notebooks, data, operating and maintenance manuals, operating and product specifications, photographs, movies and recordings, books, catalogs, labels, packaging, containers, tags, advertisements, promotional materials, storyboards, press releases,

reports, studies, questionnaires, assignments, agreements and other official papers and legal instruments, annual reports, management reports, project reports, reports to shareholders and minutes and reports of meetings (including meetings of directors, officers, executive boards and committees), lists of persons attending meetings, bills, invoices, orders, books, records, files, published material of any kind, and microfilms of documents that may have been destroyed.

Any original or copy of a document containing or having attached to it any alterations, notes, comments or other material not included in the first document shall be deemed a separate document.

- E. “Identify”, as used with respect to a document, means to state, irrespective of whether it is privileged or within the possession, custody or control of Opposer, (1) a brief description of the document and the subject matter discussed in the document; (2) the name of each author, maker or sender of the document; (3) the name of each addressee or recipient of the document and, if the document is an agreement, the names of the parties to the agreement; (4) the date the document bears, or if undated, the date the document was prepared; (5) the number of pages comprising the document; (6) the present location of the document; and (7) the name, job title, employer and address of the custodian of the document. A copy of the document may be furnished in lieu of stating the substance of its contents and any other information that would be evident from the document itself. If any document that is responsive to any of these

interrogatories has been destroyed, Opposer should provide the date, author, recipient, as much text as can be recalled, and the date of and reason for the destruction of each destroyed document.

- F. “Identify” as used with respect to a person, means to state: (1) the full name of the person; (2) the present or last known business or home address of that person; (3) the present or former relationship, if any, of that person to the Opposer; (4) if a natural person, the present or last known occupation and employer, if any, of that person; and (5) if an organization, association, partnership, joint venture, corporation or other legal entity, the identity and business titles of the individuals associated with such entity who have knowledge of the matter inquired about.
- G. “Identify” as used with respect to an institution or business entity (including without limitation any government body, corporation or partnership) means to state its name, its principal business, the principal place at which it conducted its activities at the time of the events referred to in the interrogatory and at present, and to “identify” the persons at the institution or business entity having knowledge of the matters inquired about.
- H. “Identify” as used with respect to an oral communication, means to state all participants in and recipients of the communication, and to state its date, location, subject matter and method of communication.
- I. “Identify” as used with respect to an agreement or offer to enter into an agreement, means to state its title and the parties involved and to

summarize the terms or the proposed terms and to “identify” all documents constituting the agreement or offer.

- J. “Identify” as used with respect to goods or services, means to describe the goods or services briefly and the types of purchases to whom they are marketed and sold and the intended use for the goods or services.
- K. “Opposer” refers to ARSA DISTRIBUTING, INC. itself and as represented by its partners, directors, officers, employees, agents, attorneys, consultants, independent contractors and representatives, and includes all parents, divisions, subsidiaries, affiliates and joint ventures and other legal entities which control or are wholly or partly owned or controlled by ARSA DISTRIBUTING, INC. either directly or indirectly, all predecessors and successors in interest, and the directors, officers, employees, agents, attorneys, consultants and representatives of these divisions, subsidiaries, affiliates, joint ventures, predecessors, successors and other legal entities. Where use of a mark is concerned, “Opposer” also means all of the Opposer’s past and present licensees and all others who use or have used such mark with Opposer’s consent or under Opposer’s control or authority.
- L. “Mark” means all forms of trademarks and trade names, including without limitation service marks, fictitious names, corporate and business names, logos, designs, trade dress and devices.
- M. “Use in commerce” means the definition given in Section 45 of the Trademark Act of 1946 (15 U.S.C.1127).

N. “Opposer's Mark” means EUCALIN.

INTERROGATORIES

Interrogatory No. 1: Identify who produced the products sold under the EUCALIN mark for each year from 2008 until the present?

Interrogatory No. 2: Identify who produced the packaging for the goods sold under the EUCALIN mark for each year from 2008 until the present?

Interrogatory No. 3: Has ARSA at any time manufacture the syrup sold under the EUCALIN mark?

Interrogatory No. 4: Has ARSA at any time manufacture any goods sold under the EUCALIN mark?

Respectfully Submitted,

/jmf/
Jeffrey M. Furr 38,146
Attorney for Applicant
Salud Natural Mexicana SA de CV
2622 Debolt Road
Utica, Ohio 43080
740-817-2381 (telephone)
740-892-2118 (fax)
JeffMFurr@FurrLawFirm.com

CERTIFICATE OF FILING

I hereby certify that this answer is being electronically filed with the United States Patent and Trademark Trial and Appeal Board on the 3rd day of April, 2019.

/jmf/
Jeffrey M. Furr, Esquire

CERTIFICATE OF SERVICE

I hereby certify that this paper is being transmitted by electronic mail on the 3rd day of April, 2019 addressed to:

CHRISTINE LEBRON DYKEMAN
MCKEE VOORHEES & SEASE PLC
christine.lebron-dykeman@ipmvs.com

/jmf/
Jeffrey M. Furr, Esquire

Exhibit 2

In the Matter of
US Serial Number 87638836

ARSA DISTRIBUTING, INC.

Opposer,

v.

Opposition No. 91240240

SALUD NATURAL MEXICANA SA de CV

Applicant.

UNITED STATES PATENT AND
TRADEMARK TRIAL AND APPEAL BOARD
PO BOX 1451
ALEXANDRIA VA 22313-1451

OPPOSER'S FIRST REQUEST FOR PRODUCTION OF DOCUMENTS

Opposer, BRANDED, LLC., requests that Opposer, pursuant to Rule 34 of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice, produce and permit the inspection and copying of the documents described in the following Requests regardless of whether only a part of any document meets the description.

Opposer requests that such documents be made available at the office of Jeffrey M. Furr, 2622 Debolt Road, Utica, Ohio 43080 within 30 days of the mailing of this Request.

INSTRUCTIONS

These Requests are intended to cover all documents in the possession of Opposer, or subject to its custody and control, or available to Opposer wherever such documents are located, including, but not limited to, any of Opposer 's offices or any other office maintained or used by Opposer, its agents, employees, joint ventures, partners, independent contractors, accountant or attorneys, or any other locations where documents are kept.

If any document covered by these Requests is withheld for any reason, on a claim of privilege, attorney work product or otherwise, please provide a listing of such withheld documents stating the form of the document withheld, the date of its preparation, the author, each addressee or recipient, the subject matter, the reason for which the document is being withheld, the basis for any claim of privilege for which a document is withheld, and the name and address of any person or persons presently having custody or control of the same or a true copy thereof.

If documents requested herein cannot be produced because they have been destroyed, cannot be located, or are otherwise thought no longer to exist, please provide a statement indicating, to the best of your ability, the form of the document, the date of its preparation, the author(s), each addressee or recipient, and the subject matter.

These Requests are continuing. Consequently, if any of the documents which were not produced or could not be produced for the reasons given above, or for any other reason, are discovered, or located, or, if additional documents formerly unknown to you are discovered, which are covered by any of these Requests, you should immediately

notify Opposer's attorney, name below, and make such documents available for inspection and copying.

DEFINITIONS

The following definitions are applicable to terms employed in these Requests, in the Instructions accompanying these Requests and in these Definitions.

A. The term "person" refers to natural persons, organizations, associations, partnerships, joint ventures, corporations (including Opposer) and other legal entities and the actions taken by a person include the actions of directors, officers, owners, members, partners, joint venturers, employees, agents or attorneys acting on the person's behalf.

B. The singular includes the plural and vice versa; the words "and" and "or" shall be construed in both the conjunctive and disjunctive; the word "all" means "any and all" the word "any" means "any and all".

C. The terms "relates" and "refers" mean directly or indirectly mentioning, discussing, describing, pertaining to or connected with, a stated subject matter.

D. The term "document" is used in its customary broad sense and encompasses, without limitations, all handwritten, typed, printed or otherwise visually or aurally reproduced materials, whether copies, drafts or originals, and irrespective of whether they are privileged against discovery on any ground, or within the possession, custody or control of Opposer, or its directors, officers, employees, agents or attorneys, consultants, independent contractors and representatives, including but not limited to: letter, correspondence, cables, wires, facsimiles, telegrams, notes, memoranda, diaries, e-mail and other electronic messages, notes or records of telephones conversations, notes or

records of personal conversations or interviews, interoffice and intraoffice communications of all types, drawings, plans, sketches, charts, notebooks, data, operating and maintenance manuals, operating and product specifications, photographs, movies and recordings, books, catalogs, labels, packaging, containers, tags, published material of any kind, assignments, agreements and other official papers and legal instruments, annual reports, managements reports, project reports, reports to shareholders and minutes and reports of meetings (including meetings of directors, officers, executive boards and committees), lists of persons attending meetings, advertising and promotional literature, press releases, bills, invoices, orders, books, records, files, and microfilms of documents that may have been destroyed.

Any original or copy of a document containing or having attached to it any alterations, notes, comments or other material not included in the first document that shall be deemed a separate document.

E. "Identify," as used with respect to a document, means to state, irrespective of whether it is privileged or within the possession, custody or control of Opposer, (1) a brief description of the document and the subject matter discusses in the document; (2) the name of each author, maker or sender of the document; (3) the name of each addressee or recipient of the document and, if the document is an agreement, the names of the parties to the agreement; (4) the date the document bears, or if undated, the date the document was prepared; (5) the number of pages comprising the document; (6) the present location of the document; and (7) the name, job title, employer and address of the custodian of the document. A copy of the document may be furnished in lieu of stating the substance of its contents and any other information that would be evident from the

document itself. If any document that is responsive to any of these interrogatories has been destroyed, Opposer should provide the date, author, recipient, as much text as can be recalled, and the date of and reason for destruction for each destroyed document.

F. " Opposer " refers to ARSA DISTRIBUTING, INC. itself, it's Parent Companies and subsidiaries and as represented by any partners, directors, officers, employees, agents, attorneys, consultants, independent contractors and representatives, and includes all parents, divisions, subsidiaries, affiliates and joint ventures and other legal entities which are own ARSA DISTRIBUTING, INC. or wholly or partly owned or controlled by ARSA DISTRIBUTING, INC. either directly or indirectly, all predecessors and successors in interest, and the directors, officers, employees, agents, attorneys, consultants, independent contractors and representatives of these legal divisions, subsidiaries, affiliates, joint ventures, predecessors, successors and other legal entities. Where use of a mark is concerned, "Opposer" also means all of Opposer's past and present licensees and all others who use or have used such mark with Opposer's consent or under Opposer's control or authority.

G. "Mark" means all forms of trademarks and trade names, including without limitation service marks, fictitious names, corporate and business names, logos, designs, trade dress and devices.

H. "Use in commerce" means the definition given in Section 45 of the Trademark Act of 1946 (15 U.S.C. 1127).

Document Requests

Request No. 1: All documents dealing with any company used by Opposer to manufacture products under the EUCALIN mark.

Request No. 2: All document dealing with any company used by Opposer to product packaging for products sold under the EUCALIN mark.

Respectfully Submitted,

/jmf/
Jeffrey M. Furr 38,146
Attorney for Applicant
Salud Natural Mexicana SA de CV
2622 Debolt Road
Utica, Ohio 43080
740-817-2381 (telephone)
740-892-2118 (fax)
JeffMFurr@FurrLawFirm.com

CERTIFICATE OF FILING

I hereby certify that this answer is being electronically filed with the United States Patent and Trademark Trial and Appeal Board on the 3rd day of April, 2019.

/jmf/
Jeffrey M. Furr, Esquire

CERTIFICATE OF SERVICE

I hereby certify that this paper is being transmitted by electronic mail on the 3rd day of April, 2019 addressed to:

CHRISTINE LEBRON DYKEMAN
MCKEE VOORHEES & SEASE PLC
christine.lebron-dykeman@ipmvs.com

_____/jmf/_____
Jeffrey M. Furr, Esquire

Exhibit 3

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

In the Matter of US Serial Number 87638836

ARSA DISTRIBUTING, INC.

Opposer,

v.

Opposition No. 91240240
(parent)

91243700

SALUD NATURAL MEXICANA SA de CV

Applicant.

UNITED STATES PATENT AND
TRADEMARK TRIAL AND APPEAL BOARD
PO BOX 1451
ALEXANDRIA VA 22313-1451

DECLARATION OF JEFFREY M. FURR

I, JEFFREY M. FURR, declare the following;

1. I am the attorney for the Applicant, SALUD NATURAL MEXICANA SA de CV and I have personal knowledge of the case and the facts set forth herein.

2. It is my opinion and belief that the Applicant cannot effectively oppose the motion for summary judgment without first having the Opposer answer questions that

were objected and not answered in the Discovery Deposition on March 1 of Opposer's witness, ROSSANA ARRAS and follow up questions about who manufactured or sourced the Opposer's product.

3. Who produced the Applicant's product and where they produced it I believe could provide evidence that is key to Applicant's defense of the Motion for Summary Judgment.

4. The information sought by the Applicant is only within the control of the Opposer who is the party moving for summary judgment. It cannot be obtained from anyone else or anywhere else.

I declare, under penalty of perjury under the laws of the United States of America, that the foregoing is true and correct to the best of my knowledge. I understand that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting there from, declares that all statements made of my own knowledge are true and all statements made on information and belief are believed to be true.

Executed on April 3, 2019 in Alexandria, Virginia.

s/Jeffrey M. Furr/
Jeffrey M. Furr, Esq.