

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

Mailed: August 15, 2011

Cancellation No. 92052713

PREMIUM DENIM, LLC

v.

SAND K., INC.

**Cheryl Butler, Attorney, Trademark Trial and Appeal Board:**

This case now comes up on respondent's fully briefed motion to compel, filed May 25, 2011.<sup>1</sup>

As background, petitioner alleged only abandonment as a basis for the petition to cancel. Respondent denied the essential allegations of the complaint and counterclaimed to cancel petitioner's pleaded registrations on the grounds of priority of use and likelihood of confusion and dilution. In its answer, petitioner denies the essential allegations of the counterclaim. On March 2, 2011, petitioner withdrew its petition to cancel. Thus, in accordance with the Board's order dated April 21, 2011, and respondent's May 19, 2011 request for resumption, this proceeding is going forward only with respect to respondent's counterclaims.

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<sup>1</sup> Respondent's motion, filed May 19, 2011, requesting resumption and a resetting of dates is granted. Petitioner, on May 24, 2011, indicated its agreement to resumption. Proceedings were subsequently suspended, on June 13, 2011, by the filing of respondent's motion to compel.

Respondent states that the discovery dispute involves two categories: 1) petitioner's claim (in its now-dismissed petition to cancel) of being impaired, and belief of being damaged, by the continued existence of respondent's trademark registration for the mark BETTE PAIGE; and 2) petitioner's communications with third-parties as to confusion involving petitioner's PAIGE, PAIGE PREMIUM and PAIGE PREMIUM DENIM marks. According to respondent, petitioner was going to use this evidence when it was pursuing the petition to cancel and is "improperly refusing to disclose evidence that shows the two parties' registrations should not coexist." Respondent identifies the specific discovery requests in dispute as interrogatory Nos. 4-9 and document request Nos. 4-6 for the first topic, and document request Nos. 29-30 for the second topic.

More specifically, respondent argues that the requested information and documents concerning petitioner allegations impairment and belief of damage are relevant to prove that likelihood of confusion exists, and that such allegations are admissions by petitioner of a conflict between the marks. Respondent argues that the documents sought concerning communications with third parties over the term PAIGE received by petitioner make it probable that the public would be confused by the existence of each party's marks; and that communications sent by petitioner to third parties would be direct evidence of confusion between each party's marks.

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In response, petitioner explains that the investigation it conducted in June 2010 to ascertain whether respondent was using its mark indicated that respondent had abandoned its mark. As a result, petitioner states, it sought to cancel the registration only on the grounds of abandonment and withdrew the cancellation once respondent provided petition with evidence that it had not abandoned use of its mark. Petitioner argues that respondent's discovery requests on the first topic are irrelevant now that the petition to cancel has been withdrawn; that, because petitioner did not assert a likelihood of confusion claim, its allegations are not an admission of likelihood of confusion; that, instead, petitioner's allegations of impairment and damage concerned the continued registration of respondent's mark, the use of which petitioner believed had been abandoned; and that such allegations were directed to petitioner's standing to bring the petition to cancel. Petitioner contends that its standing allegations cannot be transformed into an admission on likelihood of confusion. As to communications with third parties, petitioner notes that respondent's requests are overly broad because they are not limited to petitioner's PAIGE marks; that any communications sent by petitioner are not relevant because they involve the marks of third parties that are not at issue herein; and that any communications received by petitioner are "the self-serving opinion of a third party"; and that, contrary to respondent's position, any communications made outside this proceeding are not admissions.

Respondent argues that petitioner's allegation of impairment and damage is a binding admission; that damage resulting from the coexistence of the marks is a factor that should be considered in a likelihood of confusion analysis; and that petitioner asserted abandonment as an affirmative defense to the counterclaim. As to the document requests concerning communications with third parties, respondent states its willingness to narrow the requests to marks pertaining to the term PAIGE; that communications sent by petitioner are relevant to the issue of likelihood of confusion; and that letters received by petitioner can be evidence of consumer confusion. Respondent points out that, whether the sought documents are admissible or are binding admissions is not at issue for discovery purposes.

Petitioner's three-paragraph petition to cancel asserts only abandonment. The third paragraph, alleging impairment and belief of damage in the continued registration of respondent's mark, is directed solely to petitioner's standing. Respondent's discovery requests concerning this topic are not relevant. Contrary to respondent's position, the allegation is not a "binding admission" of anything. As with all allegations asserted in complaints, the facts must be proven. Moreover, petitioner did not make any assertions concerning the co-existence of the parties' marks in the context of likelihood of confusion. Now that the petition to cancel has been dismissed, based on petitioner's withdrawal, the claim of

abandonment and the issue of petitioner's standing are no longer before the Board.

As to petitioner's affirmative defense of abandonment in its answer to the counterclaim, an attack on the validity of a registration will not be considered by the Board outside the context of a petition to cancel or a counterclaim for cancellation. See TBMP §§ 311.02(b) and 313.01 (3d ed. 2011). Moreover, in view of the earlier dismissal of petitioner's claim of abandonment, petitioner is precluded from asserting that respondent has abandoned its mark. Thus, the question of abandonment of respondent's registered mark is not before the Board as an affirmative defense. To clarify matters for the parties, petitioner's second affirmative defense to the counterclaim is **stricken**.

Accordingly respondent's motion to compel is **denied** with respect to interrogatory Nos. 4-9 and document request Nos. 4-6.

The Board now turns to respondent's requests for documents concerning communications with third parties.

Information concerning a party's awareness of third-party use and/or registration of the same or similar marks for the same or closely related goods or services as the involved mark is discoverable to the extent that the responding party has actual knowledge thereof (without performing an investigation) and that information appears reasonably calculated to lead to the discovery of admissible information.

See TBMP § 413(9) (3d ed. 2011). In the context of likelihood of confusion, such information often is relevant to show the strength

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or weakness of a term and the purchaser perception of the involved marks.

Respondent's document request No. 29 and 30 are overly broad as written. However, respondent now has made it clear that it is seeking such documents as they pertain to the PAIGE marks at issue in the proceeding.

Accordingly, respondent's motion to compel is **granted**, as modified to pertain to the PAIGE marks at issue, with respect to document request Nos. 29 and 30.

Proceedings are resumed on the schedule below, which sets the time for petitioner to provide the discovery as ordered, the time for the discovery period to resume, as well as all remaining dates. Respondent is in the position of "plaintiff" and petitioner is in the position of "defendant" for the trial schedule.

Petitioner's due date for Discovery responses (Doc. Req. Nos.29 & 30)	9/15/2011
Discovery to resume	9/15/2011
Expert Disclosures Due	10/17/2011
Discovery Closes	11/15/2011
Plaintiff's Pretrial Disclosures	12/30/2011
Plaintiff's 30-day Trial Period Ends	2/13/2012
Defendant's Pretrial Disclosures	2/28/2012
Defendant's 30-day Trial Period Ends	4/13/2012
Plaintiff's Rebuttal Disclosures	4/28/2012
Plaintiff's 15-day Rebuttal Period Ends	5/28/2012

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on

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the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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