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

Proceeding no.	92078349
Party	Defendant David J. Witchell Salon & Spa, Inc.
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Attachments	Registrant Reply in Support of Motion to Compel.pdf(134296 bytes)

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

Judith Gurley Plastic Surgery, LLC)	
)	
Petitioner,)	Cancellation No. 92078349
)	Registration No. 5845907
v.)	
)	
David J. Witchell Salon & Spa, Inc.)	
)	
Registrant.)	

**REGISTRANT’S REPLY BRIEF IN SUPPORT OF
REGISTRANT’S MOTION TO COMPEL**

I. SUMMARY

Registrant, David J. Witchell Salon & Spa, Inc. (“Registrant”), by its attorney, hereby files this brief in further support of Registrant’s Motion to Compel and in reply to the Response filed by Petitioner, Judith Gurley Plastic Surgery, LLC (“Petitioner”). Registrant seeks the Board to compel Petitioner to respond to written discovery demands, produce responsive, nonprivileged documents, and a privilege log, and to provide proper, unqualified responses to Registrant’s Interrogatories and, after testing the sufficiency of Petitioner’s answers or objections, that the Board strike Petitioner’s improper discovery objections and compel Petitioner to properly respond to Registrant’s admission requests.

II. ARGUMENT

Registrant seeks relevant information in its discovery requests to Petitioner. Rather than comply with Petitioner’s discovery obligations, Petitioner objects to Registrant’s requests and withholds relevant evidence Registrant is entitled to because Petitioner knows such information

would tend to support Registrant's Affirmative Defenses of Non-Exclusivity, Abandonment, and Fraud, as well as negate Petitioner's claim of prior use and ownership over the mark. In short, Petitioner provided baseless objections and evasive responses because Petitioner knows the information requested in Registrant's discovery demands will assist in defeating Petitioner's claims at trial or establish Registrant's entitlement to summary judgment after filing a pre-trial motion.

In Petitioner's Response to Registrant's Motion to Compel, Petitioner improperly argues a limited scope of discovery, and mischaracterizes the application of the information sought. Not only is the information sought by the Registrant relevant discovery for even what Petitioner alleges is a very narrow dispute of priority and likelihood of confusion, but it is also pertinent to other issues that Petitioner ignores. Petitioner's assertions are disingenuous and are designed to thwart discovery. A party may take discovery as to matters that are relevant to its claims and defenses (i.e., those specifically raised in the pleadings), and such discovery may serve as the basis for an additional claim, defense, or counterclaim. TBMP §402.01 Additionally, a party may not, by limiting its own discovery and/or presentation of evidence on the case, thereby restrict another party's discovery in any way. TBMP §402.01. Here, the pleadings show that, in addition to priority and likelihood of confusion, information relating to Registrant's affirmative defenses of non-exclusivity, abandonment, and fraud are also relevant and discoverable. As such, the scope of discovery also includes information relating a third party's use of a nearly identical mark in connection with the same or similar services as the mark used and services provided by Petitioner, because such information is the basis for Registrant's affirmative defenses. In addition, such requests are relevant to the very issues Petitioner references, since

priority and likelihood of confusion are not determined in a vacuum and the analysis does not exclude uses by others or what consumers encounter.

In Petitioner's response, Petitioner also asserts that Registrant has failed to meet the good faith requirement, that Petitioner has provided sufficient objections, and that Registrant's discovery requests fall outside the scope of discovery. Petitioner's arguments are not well-founded for the following reasons:

a. Registrant Has Met the Good Faith Requirement

Contrary to Petitioner's assertion, Registrant has made a good faith effort to resolve the parties' discovery disputes and only filed the Motion to Compel after numerous failed attempts at reaching such a resolution. Petitioner faults Registrant for not filing the Motion to Compel at an earlier date, but fails to appreciate the undue burden that Petitioner's careless and deficient responses have caused Registrant, both in terms of time and expense. Registrant attempted to contact Petitioner several times, was forced to write a letter explaining the deficiencies of Petitioner's discovery responses (when such deficiencies should be obvious to a legal professional), and to write a twenty-seven page Motion in order to adequately detail all the ways in which Petitioner's amended responses fail to even come close to meeting the low bar set for dealing in good faith and being cooperative during the discovery process. Additionally, throughout the parties' dealings, Petitioner has not provided Registrant with a single reason as to why Registrant should believe that any additional attempts at resolving such issues would result in Petitioner providing sufficient discovery responses in good faith, as Petitioner's amended responses provided no meaningful changes to the previously insufficient responses and further demonstrate the evasive character of Petitioner's responses, as well as the futility of attempting to repeat this process. Petitioner further states Registrant failed to cite any authority

that its discovery requests seek discoverable information, as if case law was required. Petitioner knows that Registrant is not required to cite authority to demonstrate that its requests seek discoverable information because Petitioner itself recites the rule that any nonprivileged matter relevant to any party's claim or defense and proportional to the needs of the case is discoverable. TBMP §402.01 (2021). 12 TTABVUE 3-4. The discovery sought relates to the facts and issues raised in the pleadings (Notice and Answer). As such, Petitioner cannot withhold this information.

b. Petitioner's Objections are Insufficient

Next, Petitioner asserts that its objections were proper, as specific objections which specifically state the underlying basis for the objection. Petitioner's argument fails to address the numerous arguments made in Registrant's Motion to Compel, which do not support such a finding and instead show that Petitioner's objections are insufficient. Specifically, Petitioner does not address the argument that Petitioner's explanations amount to nothing more than a mere restatement of the objections themselves and are insufficient. Moreover, the only case cited by Petitioner, Medtronic, Inc. v. Pacesetter Sys., Inc., further supports Registrant's position (in that case the Board granted the Motion to Compel):

A blanket objection that interrogatories are too numerous or burdensome ordinarily will not suffice because such general objections are vague and conclusionary. [citation omitted] Except in those cases where it is readily apparent that a set of interrogatories is so oppressive as to constitute clear harassment [citation omitted], it is incumbent upon a party who has been served with interrogatories to respond by articulating his objections (with particularity) to those interrogatories which he believes to be objectionable, and by providing the information sought in those interrogatories which he believes to be proper. [citations omitted] The burden of persuasion is on the objecting party to show that the interrogatories should not be answered. 4A Moore's Federal Practice, Paragraph 33.20. In the instant case, the Board is unpersuaded that opposer's 122 interrogatories, some with subparts, are so oppressive as to constitute clear harassment. In this regard, we note that applicant itself has served upon opposer a first set of interrogatories containing

97 interrogatories and a second set of interrogatories continuing 17 additional interrogatories. Under the circumstances, the Board has little sympathy for applicant's claim that opposer's interrogatories constitute harassment.

Medtronic, Inc. v. Pacesetter Sys., 1984 TTAB LEXIS 154, *10-12 (TTAB 1984)

(Motion to Compel GRANTED).

Petitioner's argument is unsupported and without merit. As such, the Board should grant Registrant's Motion to Compel and strike Petitioner's insufficient responses.

c. Registrant's Discovery Requests are Relevant and Proportional to the Needs of this Matter

Lastly, Petitioner argues that Registrant's discovery requests are unduly burdensome and that Petitioner has substantially complied with its discovery obligations, limited by the narrow scope of discovery. Specifically, Petitioner contends that the discovery requests are neither relevant nor proportional to the needs of the case because they seek information relating to third party use of the mark. Petitioner claims that such use is not relevant to priority or likelihood of confusion and that they are burdensome because such requests are too numerous or Petitioner has no knowledge of such uses.

As stated, the discovery requests are relevant and proportional to the needs of the case because they call for information related to Registrant's affirmative defenses of fraud, non-exclusivity, and abandonment, as well as the very issues that Petitioner identifies (priority and likelihood of confusion). Such requests do not impose an undue burden on Petitioner. If Petitioner has no knowledge or evidence relating to the request, then all that Registrant requests is that Petitioner state it lacks knowledge or possesses no responsive documents (Petitioner, a plastic surgeon, may claim never to have heard of Juvederm, and, if that is Petitioner's honest answer, then it should be stated – but not avoided). Instead, however, Petitioner responded to many of Registrant's requests by objecting to their relevance and/or claiming that such

documents or information is privileged (despite, apparently not having any such documents or information in Petitioner's possession, nor providing a privilege list).

Petitioner further contends that Registrant's requests fall outside the scope of discoverable information because Board proceedings are limited in that they are only concerned with the right to register marks. Conversely, Registrant's requests call for such information pertaining to the prior use a confusingly similar mark in connection with related services or goods by a third party to establish that Petitioner is not entitled to register its mark and is barred from doing so (as the other's use is what Petitioner alleges is its mark with a product used for the same or similar goods/services), and there is widespread use of the Petitioner's alleged mark by others providing the same services as Petitioner. Petitioner does not have continuous and exclusive use. Petitioner knows that evidence negating its claimed priority over Petitioner's mark would definitively defeat Petitioner's claims and negate even the claim of common law rights to the mark, which is why Petitioner's responses are so evasive. For the same reasons, Petitioner pretends that the scope of discovery is limited to dispute over priority and confusion, alone (which still renders the information sought relevant). Petitioner, however, ignores Registrant's pleading of the affirmative defenses of fraud, non-exclusivity, and abandonment. The relevance and proportionality of Registrant's discovery requests are readily apparent from a reading of Registrant's Answer. For example, Registrant's affirmative defense of non-exclusivity provides as follows:

Registrant asserts that Petitioner has not gained any common law rights in Petitioner's purported mark connection (for use in connection with Petitioner's applied-for services) through prior use because Petitioner failed to make continuous and exclusive use of the mark in U.S. commerce. Rather, Petitioner's purported mark was already being used by third-parties in connection with Petitioner's applied-for services at the time of Petitioner's date of first use (i.e., as early as 2007) and, since then, has been used by numerous other third-parties in connection with Petitioner's applied-for services. As

such, Petitioner cannot claim any common law rights to its purported mark because it has not made continuous and exclusive use of such a mark and, therefore, the Petitioner's purported mark fails to identify a source. Specifically, Registrant asserts that a mark that Petitioner admits is substantially similar to Petitioner's alleged NO ONE WILL KNOW ... EVERYONE WILL NOTICE mark was already in use by Juvéderm (a company and brand-name dermal filler approved for use by the FDA in 2006) and other third-parties in connection with medical, cosmetic, and plastic surgery services at, and/or before Petitioner's claimed first use in 2007.

9 TTABVUE 11.

Similarly, the relevancy of Registrant's requests calling for information related to third party use of a similar mark is also readily apparent from Registrant's second affirmative defense of Abandonment:

Specifically, Registrant asserts that, in the alternative, Petitioner has lost any and all rights it may have acquired through Petitioner's alleged prior use by failing to enforce its common law rights and through extensive third-party use of Petitioner's purported mark in connection with Petitioner's applied-for services, and/or related goods and services. ... More specifically, Registrant alleges in the alternative that, even if Petitioner's date of first use were to predate the first use of Registrant, or the first use of the purported mark by Juvéderm and other third parties, then Petitioner has effectively abandoned its rights by conduct (i.e., Petitioner's total failure to enforce its purported trademark rights).

9 TTABVUE 13.

The relevancy of such information is also apparent from a reading of Registrant's third affirmative defense of Fraud, which provides, inter alia, as follows:

Petitioner knew of senior users, such as Juvéderm, who began using the same or a confusingly similar mark prior to Petitioner's date of first use – and Petitioner possessed knowledge of this fact at the time it signed its declaration in support of its application and, therefore, Petitioner could not have formed a reasonable basis for believing a likelihood of confusion would not result from Petitioner's use of the mark at the time the declaration was filed. Additionally, or in the alternative, Petitioner knew of extensive third-party use of the same and/or confusingly similar marks; that, due to extensive third-party use of the mark, Petitioner could not truthfully claim any exclusive right to use the mark in commerce; that, in fact, Petitioner knew the third-parties using such marks possessed superior rights in the mark (if any rights could be had at all); that

Petitioner had no reasonable basis for believing confusion would not result from Petitioner's use of that mark; and Petitioner made such false representations with the intent to deceive the USPTO to procure a registration to which it was not entitled.

9 TTABVUE 15.

As stated previously, "[a] party may take discovery as to matters that are relevant to its claims and defenses (i.e., those specifically raised in the pleadings), and such discovery may serve as the basis for an additional claim, defense, or counterclaim." TBMP §402.01. Accordingly, Petitioner's argument that Registrant's discovery requests call for irrelevant information is entirely without merit, since the requested information (knowledge and/or evidence of a prior user's use of a confusingly similar mark) is necessary for the establishment of Registrant's affirmative defenses of non-exclusivity, abandonment, and fraud.

CONCLUSION

As Registrant is entitled to responses to Registrant's Discovery Demands, which are vital to the case at hand, Registrant respectfully requests that the Board grant Registrant's Motion to Compel, issue an Order striking Petitioner's improper and baseless objections, and compel Petitioner to respond to Registrant's Discovery Demands and produce documents, provide proper responses (including amended responses to the Registrant's document production requests, interrogatories and requests for admission), and to produce a privilege log (if indeed any privileged documents or information exists).

Respectfully submitted,

David J. Witchell Salon & Spa, Inc.

Dated: January 4, 2023

/Frank J. Bonini, Jr./
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CERTIFICATE OF SERVICE

I hereby certify that true and complete copies of the following:

1. REGISTRANT’S REPLY BRIEF IN SUPPORT OF REGISTRANT’S MOTION TO COMPEL; and
2. CERTIFICATE OF SERVICE,

were served on the following, via Email on January 4,2023:

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Dated: January 4, 2023

/Frank J. Bonini, Jr./