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

Proceeding no.	92078349
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE  
THE TRADEMARK TRIAL AND APPEAL BOARD**

**Judith Gurley Plastic Surgery, LLC**

**Petitioner**

**v.**

**David J. Witchell Salon & Spa, Inc.,**

**Registrant**

**Cancellation No. 92078349**

**PETITIONER’S RESPONSE IN OPPOSITION TO REGISTRANT’S RENEWED  
MOTION TO COMPEL DISCLOSURE AND DISCOVERY AND TO TEST THE  
SUFFICIENCY OF PETITIONER’S ANSWERS AND OBJECTIONS**

COMES NOW Petitioner, by and through counsel, and hereby moves the Board to deny Registrant’s Motion to Compel and request to re-open discovery. In support of its opposition, Petitioner states as follows:

**BACKGROUND AND UNDISPUTED FACTS**

This cancellation involves Registrant’s registration for “EVERYONE WILL NOTICE BUT NO ONE WILL KNOW” for hair and salon services and beauty spa services for cosmetic body care in International Category 44 (Reg. No. 5845907) and Applicant’s application to register “NO ONE WILL KNOW...EVERYONE WILL NOTICE” for medical, cosmetic and plastic surgery services in International Class 44 (Ser. No. 88304473). The parties’ dispute is very narrow and simple: priority and likelihood of confusion of the mark. There are also several undisputed facts in this matter that further narrow and simplify the issues of priority and likelihood of confusion for the mark. The undisputed facts are as follows:

- a. On November 14, 2016, Registrant filed its intent to use application for “EVERYONE

WILL NOTICE BUT NO ONE WILL KNOW in International Class 44 (Reg. No. 5845907). [9 TTABVUE 2, ¶1-3]

- b. Registrant's first use of Registrant's Mark occurred at least as early as March 16, 2016 and Registrant's first use of Registrant's Mark in international commerce occurred at least as early as March 16, 2016. [9 TTABVUE 2, ¶4]
- c. On February 16, 2019, Petitioner filed an application to register NO ONE WILL KNOW...EVERYONE WILL NOTICE in International Class 44. (Ser. No. 88304473). [9 TTABVUE 8, ¶11]
- d. That in an Office Action dated May 24, 2021 the Trademark Examining Attorney has cited, under Section 2(d), Registrant's Registration No. 5845907 as a basis for refusal of Petitioner's Application Serial No. 88304473 due to the fact that the services are related and the marks are confusingly similar. [9 TTAB 8-9, ¶¶12-14)
- e. Petitioner made of record evidence that the PTO has refused registration of its mark in Petitioner's pending application on the basis of Respondent's registration and Respondent admitted such in his Answer to Petitioner's Petition to Cancel. [9 TTABVUE 7, ¶¶10-17]
- f. Priority has been established in as much as Registrant admits that the alleged first date of use precedes Registrant's first date of use. [9 TTABVUE 8, ¶10].

### **LEGAL STANDARD**

Parties may not engage in "fishing expeditions" and must act reasonably in framing discovery requests. TBMP §402.01 (2021); *See Luehrmann v. Kwik Kopy Corp.*, 2 U.S.P.Q.2d 1303, 1305 (T.T.A.B. 1987) (parties should seek only discovery which is proper and relevant to the specific issues involved in the case); *FMR Corp. v. Alliant Partners*, 51 U.S.P.Q.2d 1759, 1761 (T.T.A.B. 1999)(...the right to discovery is not unlimited. Both the Trademark Rules and

the Federal Rules of Civil Procedure grant the Board discretion to manage the discovery process.) Discovery is proper if it falls within the scope defined in Fed. R. Civ. P. 26(b)(1): any nonprivileged matter relevant to any party's claim or defense and proportional to the needs of the case, considering the importance of the issues at stake in the action, the amount in controversy, the parties' relative access to relevant information, the parties' resources, the importance of the discovery in resolving the issues, and whether the burden or expense of the proposed discovery outweighs its likely benefit. TBMP §402.01 (2021). Each party has a duty to make a good faith effort to satisfy the discovery needs of its adversary and to seek only such discovery as is proper and relevant to the specific issues involved in the proceeding. TBMP §402.01 (2021); *See Domond v. 37.37, Inc.* 113 U.S.P.Q.2d 1264, 1267-68 (T.T.A.B. 2015) (plaintiff's discovery requests were irrelevant and improper because they went beyond what was necessary to prove the claims before the Board and were not appropriately tailored to elicit discoverable information); *The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 U.S.P.Q.2d 2149, 2152 (T.T.A.B. 2013) (parties are entitled to seek discovery as they may deem necessary to help them prepare for trial, but it is not the practice of the Board to permit unlimited discovery to the point of harassment and oppressiveness); *Luehrmann v. Kwik Kopy Corp.*, 2 U.S.P.Q.2d 1303, 1305, (T.T.A.B. 1987) (each party and its attorney has a duty not only to make a good faith effort to satisfy the discovery needs of its opponent but also to make a good faith effort to seek only such discovery as is proper and relevant to the specific issues involved in the case); *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 U.S.P.Q. 666,667 (T.T.A.B. 1986) (same); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 U.S.P.Q. 80, 83 (T.T.A.B. 1984) (same). Furthermore, the scope of discovery in Board proceedings is generally narrower than in a court proceedings. TBMP §402.01 (2021); *See Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 100 U.S.P.Q.2d

1904, 1907 (T.T.A.B. 2011). There are “ultimate and necessary boundaries” to discovery. *Oppenheimer Fund, Inc. v. Sanders*, 437 U.S. 340, 351 (1978). “Both the Trademark Rules and the Federal Rules of Civil Procedure grant the Board discretion to manage the discovery process in order to balance the requesting party’s need for information against any injury that may result from discovery abuse.” *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1761 (TTAB 1999)

## **ARGUMENT**

### **I. Petitioner has properly and sufficiently responded to all discovery requests.**

Despite Registrant’s complaints, Petitioner’s amended responses are responsive to each discovery request in that they either state valid objections or identify the documents responsive to the request or answer the request with sufficient particularity. Although it is true that a party will be excused from responding to discovery that is overly broad, unduly burdensome, vague or ambiguous, or not proportional to the needs of the case, the responding party may not rely on conclusory statements when objecting on these bases, but rather must state specifically the underlying basis for the objection. TBMP §408.01 (2021); *See Medtronic, Inc. v. Pacesetter Sys., Inc.* 222 U.S.P.Q. 80, 83 (T.T.A.B. 1984). Despite Registrant’s contentions, a review of Petitioner’s objections shows that Petitioner did not just apply boilerplate objections but provided specific objections and the underlying basis for each objection. Furthermore, Petitioner is allowed to redirect Registrant to a response previously given in the discovery requests, especially when the request is duplicative of a previous request and refer to documents with sufficient particularity. [See Interrogatory No. 7; Request for Production Nos. 1, 2, 3, 4, 5, 6, 7,14,15,19,26,30]

Additionally, Registrant complains that Petitioner changes the call of the request by replacing the phrase in the request with “Registrant’s Mark.” First, Petitioner states that

Registrant's Mark is EVERYONE WILL NOTICE BUT NO ONE WILL KNOW while Petitioner's Mark is NO ONE WILL KNOW...EVERYONE WILL NOTICE. Therefore, a careful reading of the requests and the responses show that the phrase Petitioner was being asked about was the Registrant's Mark. As such, merely changing the phrase to "Registrant's Mark" in no way changed the call of the question nor does it change the answer Petitioner provided.

Furthermore, Registrant's contentions that "the document speaks for itself" is not an adequate response is inaccurate. Petitioner responded that it admitted to the document and that the document speaks for itself as far for the contents requesting admission. Petitioner is not required to admit to piecemeal portions of a document when the document as a whole portrays Petitioner's position. [See Request for Admission Nos. 10,11,12,30,31].

Finally, Registrant cites zero legal authority supporting his contentions that the above responses are inadequate. Ultimately, Registrant is merely dissatisfied with the proper and adequate answers given which is not an appropriate matter for a motion to compel.

## **II. Petitioner has properly objected to all irrelevant discovery requests.**

Petitioner has made diligent efforts to respond to Registrant's extensive and unduly burdensome discovery requests and, contrary to Registrant's complaints, has substantially complied with its discovery obligations in this case which are narrow and simple: priority and likelihood of confusion. Registrant's discovery requests are not relevant nor proportional to this matter. In fact, the extensive and absurd requests are far beyond the scope of discovery needed for this action and amount to nothing more than a fishing expedition.

The majority of Registrant's dissatisfaction with Petitioner's discovery responses pertain to Petitioner's valid objections and the explanations for such. While there are multiple

objections to the various requests, as explained to Registrant's counsel, the main reason Petitioner has refused to respond to the various requests is because they are entirely irrelevant. The majority of the requested information revolves around Petitioner's awareness of third-party use of the **Registrant's mark**. Not only is this information obviously accessible to Registrant himself based on the numerous exhibits attached to his various pleadings (which notably exhibit mostly NON-trademark use or use of Registrant's Mark), it is highly irrelevant to this proceeding.

The Lanham Act allows for cancellation of a Principal Register registration by anyone "who believes that he is or will be damaged...by the registration." 15 U.S.C.A. §1064. See also *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945, 55 USPQ2d 1842 (Fed. Cir. 2000). The party seeking cancellation must prove two elements: (1) that it has standing and (2) that there are valid grounds for cancelling the registration. *Cunningham*, 222 F.3d at 945. (citing *International Order of Job's Daughters v. Lindeburg & Co.*, 727 F.2d 1087, 1091, 220 USPQ 1017, 1019 (Fed. Cir. 1984); 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §20:41 (4<sup>th</sup> Ed. 1996 & Supp. 1999).

As for standing, Petitioner made of record evidence that the PTO has refused registration of its mark in Petitioner's pending application on the basis of Respondent's registration and Respondent admitted such in his Answer to Petitioner's Petition to Cancel. (9 TTABVue 7, ¶¶10-17). The citation of Respondent's registration against Petitioner's application gives Petitioner standing to petition to cancel the cited registration. See, e.g., *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *WeaponX Performance Prods. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1040 (TTAB 2018).

As for the valid grounds for cancelling the registration, Section 2(d) of the Trademark Act prohibits the registration of a mark the “consists of or compromises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. §1052(d). To prevail on a Section 2(d) claim, Petitioner must prove, by a preponderance of the evidence, that it has priority with respect to its asserted mark **vis-à-vis Registrant’s mark**, and that **Registrant’s use of its mark** in connection with the goods identified in his registration is likely to cause confusion, mistake, or deception as to the source or sponsorship of those goods. *Cunningham*, 55 USPQ2d at 1848(emphasis added); *WeaponX*, 126 USPQ2d at 1040.

Here, priority has been established in as much as Registrant admits that the alleged first date of use precedes Registrant’s first date of use. [9 TTABVUE 8, ¶10]. Registrant also admits that the Trademark Examining Attorney assigned to review Petitioner’s application issued a final office action citing Registration No. 5845907 as a basis for refusing registration under Trademark Act §2(d) because the marks are confusingly similar in appearance, sound, and commercial impression and the services are legally identical or related. More importantly, Registrant does not expressly deny that any of those facts. Instead, Registrant denies that Petitioner has a mark. [9 TTABVUE 8-10, ¶¶10-17].

The reason the above information is important is because it outlines what is relevant in discovery for this matter. A review of the discovery requests and the amended responses containing the objections shows that the information being objected to is highly irrelevant to the pleaded issues in this case as outlined above. Moreover, the majority of Registrant’s requests regard Petitioner’s awareness of third-party use of **Registrant’s mark** which are irrelevant to the



pleaded issues. [Specifically, Request for Admission Nos 6,7,8,9,19,20,23,24,25,26,28,36,37, 38,39,40[sic]; Interrogatory Nos 28,29,45; and Requests for Production Nos 8,20,21, 37,38,39,40,45,50,53]. Furthermore, by making such requests, Registrant has further demonstrated that it agrees that not only are the two marks at issue are confusingly similar, so are the services. Therefore, the only issue Registrant seeks extensive discovery on is whether he can prove some sort of fraud as an affirmative defense which is irrelevant to this proceeding.

Fraud in procuring a trademark registration or renewal occurs when an applicant knowingly makes false, material representations of fact in connection with his application. *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986). Absent the requisite intent to mislead the PTO, even a material misrepresentation would not qualify as fraud under the Lanham Act warranting cancellation. *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009). A trademark applicant has no duty to investigate potential conflicting uses that might be found through a trademark search, and therefore there is no duty to investigate specific information such as when a third party may have started using a mark. *Maids to Order of Ohio, Inc. v. Maid-to-Order, Inc.* 78 USPQ2d 1899, 1909 (TTAB 2006). Furthermore, in determining whether an applicant, when he signed his application oath, held an honest, good faith belief that he was entitled to registration of his mark, the Board has stated that “if the other person’s rights in the mark, vis-à-vis the applicant’s rights are not known by the applicant to be superior or clearly established, e.g. by court decree or prior agreement of the parties, then the applicant has a reasonable basis for believing that no one else has the right to use the mark in commerce, and that applicant’s averment of that reasonable belief in its application declaration or oath is not fraudulent.” *Intellimedia Sports, Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203, 1207 (TTAB 1997).

The fact that third parties may or may not have rights in the mark superior to petitioner is irrelevant if it is proven that petitioner's rights are superior to registrants. *McCarthy on Trademarks and Unfair Competition* §20:53 (5<sup>th</sup> Ed. 2021)(citing *Acme-McCrory Corporation v. Oxford Manufacturing Co., Inc.*, 151 U.S.P.Q. 721, 1966, WL 7365 (T.T.A.B. 1966); *Famous Artists Schools, Inc., Et Al. v. Famous Musicians, Inc.*, 165 U.S.P.Q. 723, 728, 1970 WL 9937 (T.T.A.B. 1970). Here, Petitioner's rights are superior to Registrant as admitted and discussed above. Therefore, Registrant's extensive discovery requests concerning whether a third party may or may not have rights superior to Petitioner is irrelevant. Finally, even if third party use were somehow relevant, Registrant would be just as able as Petitioner to find the third-party use that he seeks, as exhibits by the numerous exhibits attached to all of his various motions.

Additionally, as far as Petitioner's privilege objections, it should be noted that those objections were made in addition to the overall objections that the information being requested is not discoverable. As highlighted by Registrant, under Fed.R.Civ.P. 26(b)(5)(A), "when a party withholds information **otherwise discoverable** by claiming that the information is privileged or subject to protection..." then the party must produce a privilege log identifying the responsive documents. (emphasis added). Here, Petitioner has not provided a privilege log because, as highlighted above, the documents and information being requested is not otherwise discoverable.

Finally, the remaining responses Registrant takes issue with deal with highly irrelevant, overly broad, and extensive requests, including but not limited to: each person employed or retained by Petitioner (Interrogatory 19); number of procedures, patient identification, revenues, expenses, advertising sources & expenditures, each instance of service and more (Interrogatories 20, 23, 33, 35; Requests for Production 10, 11, 12); channels of trade, percentage of sales in each channel, ordinary purchasers sold to and intended to sell to, each instance a person recognized

Petitioner as a source of services under the mark, market penetration, and more (Interrogatories 21, 24, 31; Request for Production 22); the brand of products used in connection with Petitioner's services and each instance of use of the products (Interrogatories 38, 39; Requests for Production 41, 42, 44); insurance policies (Interrogatory 50; Requests for Production 13, 54); searches, studies, investigation, and knowledge on Registrant's Mark, including Petitioner's attorney's knowledge (Requests for Production 16, 17, 31, 33, 34, 35, 36); and, unbelievably, statements and opinions given to Petitioner concerning this cancellation proceeding, including from Petitioner's attorney (Interrogatory 22). There is no doubt that these requests are extensive, absurd, and far beyond the scope of discovery needed for this action.

**III. Due to Registrant's admissions and the timely and adequately responded to discovery requests in this matter there is no need to reopen discovery.**

Petitioner states that this matter has been suspended on more than one occasion since October of 2021 which already extended the discovery period. The discovery period has come and gone with zero communication from Registrant to express any dissatisfaction with the amended responses until after the window had already closed and Petitioner had prepared and filed its pretrial disclosures. Finally, as highlighted above, there is zero need for additional discovery in this matter in light of all the admissions of Registrant alone, as well as all the documents previously produced and the appropriate responses to the relevant discovery requests by Petitioner.

**CONCLUSION**

Finally, a review of the discovery requests and the amended responses to those requests demonstrate nothing more than Registrant's wish for a different answer, Registrant's wish that it

had asked a different question, or Registrant's impertinent suggestion that the fraudulent actions of Petitioner warrant the Board compelling extensive discovery including the production of privileged information. [See 16 TTABVUE 141-209, Exhibits K-M which contain the requests, the original responses, and the amended responses for ease of review]. For the above reasons, Petitioner prays the Board enters its order denying Registrant's motion because (1) Petitioner provided valid and specific objections and the underlying basis for each objection; (2) Registrant has not met his burden in that Registrant has failed to provide any reason or explanation to overcome Petitioner's specific objections; and (3) Registrant's discovery requests far exceed the scope of discovery by failing to address the narrow and simple issue of this matter: priority and likelihood of confusion. Registrant also respectfully requests this Board deny Registrant's request to re-open discovery in this matter.

Respectfully submitted,

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### **CERTIFICATE OF SERVICE**

I, Annette P. Heller, attorney for Petitioner, hereby certify that a copy of this document was served on counsel of record, Frank J Bonini Jr via email to [fbonini@boninilaw.com](mailto:fbonini@boninilaw.com) this 28<sup>th</sup> day of April, 2023.

/aph76/

Annette P. Heller, Attorney for Petitioner