

Responses To Document Requests Can Be Fatal!

Law360, New York (August 26, 2011) -- In a published decision believed to be the first in which the Trademark Trial and Appeal Board has squarely addressed the issue, the board held that written responses to requests for production of documents can be made of record by a notice of reliance and, furthermore, can constitute evidence sufficient to sustain an opposition.

The board so held even though documents submitted in response to requests for production cannot be made of record by a notice of reliance. *Spirits International BV v. S.S. Taris Zeytin Ve Zeytinyagi Tarim Satis Kooperatifleri Birligi*, Opposition No. 91163779 (TTAB, July 6, 2011) (Opposer is hereinafter referred to as "SPI" and Applicant as "Taris").

SPI opposed Taris' application to register the mark MOSKONISI for products in International Classes 32 and 33, some of which were alcoholic beverages, on two grounds: (1) that the mark MOSKONISI for alcoholic beverages is likely to cause confusion with SPI's MOSKOVSKAYA mark for vodka, and (2) that Taris lacked a bona fide intent to use the MOSKONISI mark for alcoholic beverages. The TTAB upheld the opposition on the "lack of a bona fide intent" ground and, because the opposition could be sustained on this ground alone, declined to address SPI's likelihood of confusion contention.

During its testimony period, SPI submitted a notice of reliance that included Taris' written responses to certain of SPI's document requests, in which Taris stated that it did not have any documents of the kinds requested. Taris filed a motion to strike the notice of reliance insofar as it included Taris' responses to document requests on the ground that they could not be made of record through a notice of reliance under Trademark Rule 2.120(j)(3)(ii), which provides in relevant part that:

"A party that has obtained documents from another party through disclosure or under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance"

SPI opposed the motion on the grounds (1) that, on its face, this rule does not apply to written responses to document requests, and (2) that Taris' written responses constituted admissions against interest because they conceded that Taris did not have various categories of documents it would be expected to have if it truly had a bona fide intent to use the MOSKONISI mark for alcoholic beverages.

The TTAB agreed, first in a June 4, 2010, order denying the motion to strike, and again in its July 6, 2011, decision sustaining the opposition. The board based its decision on the fact that Taris' document responses admitted that Taris had no documents falling into any of the following categories:

- documents evidencing, reflecting or referring to applicant's use or intended use of its mark in connection with any alcoholic product;
- promotional and marketing materials and advertisements for any alcoholic product offered or to be offered under the mark in the United States;
- marketing plans involving any alcoholic product to be sold under the mark; and
- documents evidencing or referring to any channel of trade through which alcoholic products have been sold or through which applicant intends to sell such products under the mark in the United States. *Id.* at 7-8.

The board held that "Opposer's submission of these responses is sufficient for opposer to satisfy its initial burden of proving that applicant did not and does not have an intention to use its applied-for mark on or in connection with alcoholic beverages." *Id.* at 9.

And, since Taris submitted no evidence in rebuttal, its written responses to SPI's document requests proved fatal to Taris' application for registration of its mark for all of the products for which it sought registration in International Classes 32 and 33, including not only alcoholic beverages but also the non-alcoholic products for which it sought registration in those classes. *Id.* at 4, n. 3.

This decision should put all TTAB practitioners on notice that they need to be very careful what they say in written responses to document requests. In particular, applicants should be mindful that statements in their written document responses could be deemed to constitute admissions supporting one of the grounds on which the opposition is based.

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