

RK

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
General Contact Number: 571-272-8500

Mailed: June 6, 2016

Opposition No. **91212441 (parent)**  
Cancellation No. **92057845**

*Multisorb Technologies, Inc.*

*v.*

*Clariant AG*

**Yong Oh (Richard) Kim, Interlocutory Attorney:**

This matter comes up on Opposer/Petitioner's ("Opposer") motion to compel complete responses to certain of its interrogatories and document requests and motion to make Applicant/Respondent ("Applicant") available for a Rule 30(b)(6) deposition in the United States (filed January 1 and January 11, 2016, respectively). The motions are fully briefed.

The Board presumes the parties' familiarity with the pleadings, the history of the proceeding and the arguments and evidence submitted in connection with the briefing of the motions. As such, this order will not summarize the proceeding background or recount the parties' arguments except as necessary.

Opposer's Motion to Compel

As an initial matter, the Board finds the motion to compel timely as it was filed prior to the commencement of Opposer's testimony period as reset.<sup>1</sup> *See* Trademark Rule 2.120(e)(1).

As part of any motion to compel, the moving party must certify that it made a good faith effort to resolve with the other party the issues presented in the motion but was unable to resolve them. *Id.* Based on the declaration of Opposer's counsel and supporting documents, the Board finds the good faith requirement under Trademark Rule 2.120(e)(1) discharged.

Turning to the merits of the motion, Opposer's second set of interrogatories, i.e., Interrogatory Nos. 16 - 20, and third set of document requests, i.e., Document Request Nos. 33-35, are at issue.

Interrogatory No. 16

Identify the person or persons responsible for the research and development of each of Clariant's products that uses the OXY-GUARD mark, indicating the role that each individual performed or will perform, as well as the period during which each person was or will be so responsible.

In reviewing Applicant's various objections, the Board does not find them well-taken. Opposer has asserted a claim of mere descriptiveness under Section 2(e)(1) of the Trademark Act, alleging that the subject marks merely describe "the qualities, features, functions, purpose, and use" of Applicant's goods. *See Notice of Opposition*, ¶ 21, and *Petition for Cancellation*, ¶ 17. As such, the identity of individuals responsible for the research and development of Applicant's products under the subject mark are relevant and discoverable as they will likely have information

---

<sup>1</sup> As last reset, Opposer's testimony period was scheduled to open on March 15, 2016.

concerning the qualities, features, functions, purpose and use of the goods. Applicant has set forth no reason why the identification of such individuals would prove unduly burdensome or oppressive or why the request is overly broad. Furthermore, Applicant has failed to explain why the identities of such persons and descriptions of their roles, as opposed to certain of the technical information they possess, would constitute confidential business information so as to preclude disclosure. Even if it could be argued that these individuals' identities and roles constitute confidential information, Applicant may not withhold such information on the basis of confidentiality in light of the parties' stipulated protective order. *See Amazon Techs., Inc. v. Wax*, 93 USPQ2d 1702, 1706 n.6 (TTAB 2009). In view thereof, Opposer's motion to compel a further response to Interrogatory No. 16 is hereby **GRANTED**.

Interrogatory No. 17

Describe in detail the technical process by which Clariant's products under the OXY-GUARD mark inhibit oxidation.

Request for Production No.33

All documents relating to the technical process by which Clariant's products under the OXY-GUARD mark inhibit oxidation.

In response to these discovery requests, Applicant asserted the same objections as those in response to Interrogatory No. 17. In these instances, the Board finds them well-taken. The basis of Opposer's opposition and cancellation is the claim that Applicant's mark merely describes Applicant's goods under that mark. These discovery requests already assume the putatively descriptive quality/feature/function/purpose/use of the goods, i.e., to inhibit oxidation, yet seeks detailed

technical information on how the goods are able to perform that function. Opposer overreaches in seeking such information. Although such technical information may be relevant in a patent infringement action, it is of little relevance here. The question of descriptiveness “is determined from the viewpoint of the relevant purchasing public,” see *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985), which will often have little, if any, information (or concern) regarding how a product works as opposed to what it does. Even if it can be argued that such technical information has some relevance, the requests are wholly disproportionate to the needs of this case. Accordingly, Opposer’s motion to compel further responses to Interrogatory No. 17 and Request for Production No. 33 is hereby **DENIED**.

Interrogatory No. 18

Describe in detail the chemical process by which the presence of oxygen causes oxidation.

As in Interrogatory No. 17, a description of the chemical process of oxidation is of little relevance to Opposer’s claim of mere descriptiveness. Furthermore, such general information is equally available to Opposer and Applicant. Accordingly, Opposer’s motion to compel Applicant’s response to Interrogatory No. 18 is hereby **DENIED**.

Interrogatory No. 19

Identify all Clariant products that are designed to guard or protect oxygen within a package, bottle, or container.

This interrogatory is overbroad as it seeks the identification of all of Applicant’s products that satisfy this criteria without regard to the involved marks and the

goods thereunder. The determination of whether a mark is merely descriptive must be made in relation to the goods or services identified in the application or registration and not in the abstract. *See In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012). In view thereof, Opposer's motion to compel Applicant's response to Interrogatory No. 19 is **DENIED in part** and **GRANTED in part** to the extent that the interrogatory is limited to those goods identified in the involved application and registration.

Interrogatory No. 20

Explain how plastic packaging containers are used to guard or protect the oxygen found within a package, bottle, or container.

Request for Production No. 34

All documents relating to the use of plastic packaging containers to guard or protect oxygen found within a package, bottle, or container.

Without regard to the mark involved herein and the goods thereunder, these requests are overbroad. Even if properly limited, these requests go beyond the putative feature or purpose of the goods, i.e., to guard or protect the oxygen within, and seek technical information on *how* the goods are able to guard or protect oxygen. Such technical information is of little relevance to Opposer's mere descriptiveness claim. Thus, Opposer's motion to compel further responses to Interrogatory No. 20 and Request for Production No. 34 is hereby **DENIED**.

Request for Production No. 35

All documents demonstrating products made by Clariant that protect the oxygen found within a package, bottle, or container.

Again, without regard to the mark involved herein and the goods thereunder, the request is overbroad and seeks information of little relevance to this proceeding.

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.