

TTAB

Attorney Docket No. 03367.8055



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

Novo Nordisk A/S,)
)
Opposer,)
)
v.)
)
Innoject, Inc.,)
)
Applicant.)
)

Opposition No. 125,203
Serial No. 78/059,125
Mark: INNOJECT



02-12-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

**OPPOSER'S BRIEF IN RESPONSE TO APPLICANT'S
MOTION TO DISMISS AND REPLY IN SUPPORT OF
OPPOSER'S MOTION TO EXTEND TESTIMONY PERIOD**

Opposer, Novo Nordisk A/S, by and through its attorneys, respectfully submits this response to Applicant's motion to dismiss and reply brief in support of its motion to extend the opening and closing dates of Opposer's testimony period, and to extend remaining testimony dates accordingly.

I. Opposer's Motion to Extend Testimony Dates

Opposer filed this motion to extend the opening and closing dates of Opposer's testimony period on January 6, 2003, and *before* the testimony period opened. The reason Opposer seeks an extension of time is because *Applicant* had not served discovery responses as of the date of Opposer's motion and, in fact, *Applicant* did not

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP
1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

serve discovery responses until January 13, 2003, during the middle of Opposer's testimony period. Opposer therefore needs additional time, before the opening of its first testimony period, to review *Applicant's* discovery responses, consider the sufficiency of those responses, and prepare for trial based upon those responses.

Applicant's brief fails to mention, or even address, these important factors. Moreover, *Applicant* fails to mention the fact that *Applicant* took advantage of the parties' consented extensions of time to respond to outstanding discovery, and served discovery responses on the very last day of the extension period. Indeed, if *Applicant* had served its discovery responses earlier, there would be no need for Opposer's motion.

Applicant's contentions that Opposer has not been diligent during the discovery period, or that Opposer has not provided a detailed explanation in support of its motion are simply untrue and miss the point. As stated, Opposer does not seek an extension of the discovery period or an extension of time to respond to discovery. Further, Opposer's motion presented detailed facts outlining the reasons for Opposer's motion, as well as Opposer's diligence preceding the testimony period.¹ More important, it is the timing of *Applicant's* discovery responses, and not Opposer's discovery responses, that prompted this motion.

Finally, Opposer has proven its diligence during the critical time period by filing this motion to extend before the commencement of the testimony period, and by moving

¹ *Applicant* suggests that an affidavit from Opposer is required in support a motion to extend. However, neither Fed. R. Civ. P. 6, the Trademark Rules, or the case law cited by *Applicant* require an affidavit in order to establish good cause.

forward with testimony (to the extent possible) during the pendency of this motion. In fact, Opposer filed two Notices of Reliance on February 6, 2003 in an abundance of caution, and inasmuch as the Board has not yet ruled on the pending motion.²

II. Applicant's Motion to Dismiss

Applicant relies upon the Board's recent decision in Procyon Pharmaceuticals, Inc. v. Procyon Biopharma Inc., 61 USPQ2d 1542 (TTAB 2001), in support of its position that Opposer has not shown good cause, and that the opposition should be dismissed with prejudice under Trademark Rule 2.132(a). Applicant's reliance on this case, however, is misplaced.

In Procyon, the Board denied the petitioner's motion to extend and dismissed the proceeding because petitioner filed the motion on the final day of its testimony period, and failed to adequately explain the delay. Id. at 1543. In particular, the Board rejected petitioner's explanation that an extension of the testimony period was warranted because its principal officer was engaged in a "rearrangement" of its laboratory facilities during the relevant time period. Id. The Board was troubled by, among other things, the fact that petitioner failed to provide details sufficient to explain why its officers were occupied during the entire testimony period. Id.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

² The filing of the Notices of Reliance is not intended to waive Opposer's Motion to Extend (filed January 6, 2003) the opening of Opposer's testimony period, or Opposer's right to file any motions under Fed. R. Civ. P. 37 and Trademark Rules 2.120(e) or Fed. R. Civ. P. 56 and Trademark Rule 2.127(e).

In contrast, Opposer filed this motion to extend *before* the commencement of the testimony period. Opposer does not seek an extension of time because its principals are engaged in any reorganization, or because its officers are unavailable during the testimony period. To the contrary, this motion was brought for good cause.

Specifically, because *Applicant* did not serve discovery responses until the middle of Opposer's testimony period, and therefore Opposer needs time to review *Applicant's* discovery responses, consider the sufficiency of those responses, and prepare for trial based upon those responses.

Finally, Applicant moves to dismiss this proceeding under Trademark Rule 2.132(a). Applicant's motion is based upon the assumption that Opposer's motion to extend would be denied, and that Opposer has not taken any testimony or offered any evidence. As stated above, however, Opposer filed two Notices of Reliance on February 6, 2003 as a precautionary measure, and because the Board has not yet ruled on the pending motion.³ Accordingly, Applicant's motion to dismiss for failure to prosecute should be denied.

III. Conclusion

For these reasons, Opposer respectfully submits that good cause has been shown for an extension of the testimony period, and that Applicant's motion to dismiss should be denied. In the event this Motion is granted, Opposer respectfully requests

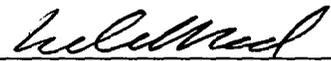
³ The filing of the Notices of Reliance is not intended to waive Opposer's Motion to Extend (filed January 6, 2003) the opening of Opposer's testimony period, or Opposer's right to file any motions under Fed. R. Civ. P. 37 and Trademark Rules 2.120(e) or Fed. R. Civ. P. 56 and Trademark Rule 2.127(e).

that the Board reset the trial calendar so that Opposer's testimony period opens within sixty-days (60) from the date of the Board's order on this Motion, and that the remaining trial dates be reset accordingly.

Respectfully submitted,

NOVO NORDISK A/S

Dated: February 12, 2003

By: 

David M. Kelly
Linda K. McLeod
Daniel B. Binstock
Finnegan, Henderson, Farabow,
Garrett & Dunner, L.L.P.
1300 I Street, N.W.
Washington, D.C. 20005-3315
Telephone: (202) 408-4000
Facsimile: (202) 408-4400

Attorneys for Opposer

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

CERTIFICATE OF SERVICE

I hereby certify that on February 12, 2003, a true and correct copy of the foregoing OPPOSER'S BRIEF IN RESPONSE TO APPLICANT'S MOTION TO DISMISS AND REPLY IN SUPPORT OF OPPOSER'S MOTION TO EXTEND TESTIMONY PERIOD was served by United States first class mail, postage prepaid to Applicant's counsel:

John A. Thomas
Glast, Phillips & Murray
2200 One Galleria Tower
13355 Noel Road, L.B.J. 48
Dallas, Texas 75240-1518

By: J. K. Valusek

FINNEGAN
HENDERSON
FARABO
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com