

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



01-06-2003

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

OPPOSER'S MOTION TO EXTEND TESTIMONY PERIOD

Opposer, Novo Nordisk A/S, by and through its attorneys, respectfully moves the Board to extend the opening and closing dates of Opposer's testimony period, and to extend remaining testimony dates accordingly.

I. Background

In early September 2002, the parties served written discovery requests, with discovery responses for Opposer due on October 11, 2002, and discovery responses for Applicant due shortly thereafter.

On September 16, 2002, counsel for Opposer forwarded a copy of Applicant's discovery requests to Opposer in Denmark, and followed-up with an e-mail communication regarding the preparation of written responses.

On October 1, 2002, counsel for Opposer contacted Opposer in Denmark to discuss the progress on gathering information and documents responsive to Applicant's discovery requests.

On October 2, 2002, counsel for Opposer contacted counsel for Applicant to discuss an extension of time to respond to outstanding discovery, and the need for a Stipulated Protective Order to govern the exchange of confidential information and documents. Counsel for Applicant agreed at that time to a thirty-day (30) extension for both parties to respond to outstanding discovery, up to and including November 11, 2002.

On October 11, 2002, Opposer and its counsel discussed various discovery issues and follow-up questions regarding the preparation of discovery responses.

On October 14 and 25, 2002, Opposer continued to gather information responsive to Applicant's discovery requests.

In October and early November, counsel for Opposer began drafting a Stipulated Protective Order.

On November 6, 2002, counsel for Opposer forwarded a draft Stipulated Protective Order to counsel for Applicant for consideration.

On November 7, 2002, counsel for Opposer contacted counsel for Applicant to follow-up on the Stipulated Protective Order, and to discuss a further extension of time to respond to discovery. In particular, Opposer requested an extension of time for both parties to respond to outstanding discovery, pending the signing of the proposed Stipulated Protective Order. Opposer also requested an extension of trial dates to allow the parties time to serve and review discovery responses before the commencement of trial. Counsel for Applicant agreed to the extensions. He also indicated that Applicant

agreed to the proposed Stipulated Protective Order, and that he would forward a signed version shortly.

On November 8, 2002, Opposer filed a combined stipulation to extend the parties time to respond to outstanding discovery, and to extend all testimony dates. The extended dates set Opposer's testimony period to close February 7, 2003; Applicant's testimony period to close April 8, 2003; and Opposer's rebuttal testimony period to close May 23, 2003.

On November 13, 2002, counsel for Applicant forwarded a signed copy of the Stipulated Protective Order to Opposer.

On December 2, 5, and 6, 2002, counsel for Opposer contacted Opposer in Denmark by telephone and email to discuss draft discovery responses and objections.

On December 6, 2002, counsel for Opposer contacted counsel for Applicant to request an additional thirty-day (30) extension of time for both parties to respond to outstanding discovery requests. Opposer, who is located in Denmark, needed additional time to correspond with its U.S. affiliate and to gather information in order to complete discovery responses. Applicant consented to the extension for both parties to respond to outstanding discovery requests up to and including January 13, 2003, but indicated that his client was unwilling to consent to any further extensions.

On December 10, 2002, Opposer and counsel communicated regarding the discovery response deadline, and draft discovery responses. Opposer's in-house counsel indicated that she had been out of the office for the past week, but that she was

continuing to gather information and review discovery responses.

On December 16, 17, and 24, 2002, Opposer and its counsel again communicated regarding discovery matters.

On December 26, 2002, Opposer filed and served a copy of the fully executed Stipulated Protective Order.

On January 2, 2003, Opposer and its counsel communicated by telephone regarding specific discovery issues.

II. Argument

The standard for allowing an extension of a testimony period prior to the expiration of that period is good cause. Fed. R. Civ. P. (6)(b)(1) and TBMP Section 509. Good cause will ordinarily be found so long as the moving party has not been guilty of negligence or bad faith, and the privilege of extensions is not abused. American Vitamin Products Inc. v. DowBrands Inc., 22 USPQ2d 1312, 1314 (TTAB 1992). In addition, the motion must "state with particularity the grounds therefor, including detailed facts constituting good cause." Luemme Inc. v. D.B. Plus Inc., 53 USPQ2d 1758, 1760 (TTAB 1999); HKG Industries, Inc. v. Perma-Pipe, Inc., 49 USPQ2d 1156, 1158 (TTAB 1998). Opposer respectfully submits that the details set forth above, and the circumstances of this case evidence good cause, and warrant a sixty-day (60) extension of the opening of its testimony period.

First, an extension of the testimony period is warranted because Opposer has

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

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

not yet received Applicant's discovery responses. Discovery responses for both parties are due January 13, 2003, which falls in the middle of Opposer's testimony period. It is the timing of the discovery response deadline that has prompted this motion. Opposer will need 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, in part, upon those responses.

Second, Opposer has been diligent during the relevant time period preceding the opening of the first testimony period, and has acted in good faith throughout this proceeding. As detailed above, Opposer and its counsel have communicated regularly since early September regarding discovery responses. Opposer's diligence is particularly noteworthy given the fact that Opposer is located in Denmark, and it must correspond with its U.S. affiliate regarding the discovery responses. Further, Opposer has been diligent in preparing a Stipulated Protective Order, and communicating with counsel for Applicant regarding the status of Opposer's discovery responses. More important, Opposer has not been guilty of any undue delay or negligence during the prescribed period. Indeed, this motion was filed *prior* to the commencement of the first testimony period, and this is the first motion to extend the testimony period filed by Opposer.

Finally, Opposer's request for an extension of the testimony period will not prejudice Applicant's ability to defend against Opposer's claims. This Board has held that delay alone does not constitute prejudice. Regatta Sport Ltd. v. Telux-Pioneer Inc.,

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

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

20 USPQ2d 1154 (TTAB 1991). In contrast, Opposer would be significantly prejudiced if the Board were to deny Opposer's Motion. As noted above, Opposer would be effectively precluded from taking any meaningful testimony if this Motion to Extend is not granted.

III. Conclusion

For these reasons, Opposer respectfully submits that good cause has been shown for an extension of the testimony period. In the event this Motion is granted, Opposer respectfully requests 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: January 6, 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 January 6, 2003, a true and correct copy of the foregoing
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
FARABOW
GARRETT &
DUNNER LLP

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

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