

TTAB

500-171



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

NUMICO FINANCIAL SERVICES, S.A.

Opposer,

v.

DR. JOEL D. WALLACH

Applicant.



11-01-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #00

Opposition No.: 91150888

02 NOV 20 AM 9:50  
COMMUNICATIONS SECTION

**OPPOSER'S MOTION TO COMPEL DISCOVERY RESPONSES**

On July 19, 2002, after the opening of the discovery period, Opposer served by mail Interrogatories and Document Requests on the Applicant. Copies of the Interrogatories, Document Requests and Certificate of Service are attached as **Exhibits 1, 2 & 3**, respectively.

On August 16, 2002, Applicant's counsel purportedly mailed to Opposer's counsel, Applicant's Response to Opposer's First Set of Interrogatories and Applicant's Response to Opposer's First Request for Production. Copies of these responses are attached as **Exhibits 4 & 5**, respectively. Applicant's counsel also provided a signed Protective Order, which has now been signed by all the parties and counsel, and has been filed with the Board. **See Ex. 6.**

As will be discussed in more detail below, Applicant's discovery responses are incomplete and insufficient. Accordingly, on October 8, 2002, Opposer's counsel sent a letter via facsimile and first-class mail to Applicant's counsel requesting supplemental responses. **See Ex. 7.** After receiving no response, Opposer's counsel called Applicant's counsel on October 17, 2002 to discuss the discovery conflict. During that telephone conversation, Applicant's counsel expressly promised

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to provide supplemental responses to Opposer's discovery, and expressly promised to send responsive documents to Opposer's counsel. Applicant's counsel stated that he would provide the supplemental responses during the week of October 21.

Unfortunately, Applicant's counsel has failed to provide any supplemental discovery of any kind, and has not produced one document. Nor has Applicant's counsel contacted Opposer's counsel to explain this failure. Therefore, Opposer has no option but to file this motion to compel.

### **Discovery Requests at Issue**

#### **I. First Set of Interrogatories**

##### **Interrogatory Nos. 1 & 17**

Interrogatory No. 1: State all marks Applicant has used and/or intends to use that contain the word OSTEOP and/or OSTEOP-FX.

Applicant's Response: Applicant *has also used* the word OSTEOP on a liquid vitamin and mineral product known as OSTEOP-CAL. [Emphasis added]

Interrogatory No. 17: State whether Applicant is currently using its Mark in commerce.

Applicant's Response: Applicant currently uses its mark in commerce.

As stated in Opposer's counsel's October 8 letter, these responses need to be clarified because they contend that Applicant is using the mark OSTEOP-FX. Applicant's application is, however, based on an intent to use, and no amendment to allege use has been filed. Moreover, Applicant's filings with the TTAB confirm that no use has begun. For example, paragraph 16 of Applicant's Answer to Opposition reads: "Respondent admits that the mark OSTEOP-FX is intended for nutritional supplements containing glucosamine and chondroitin, which have been shown to be beneficial to joints." (Emphasis added).

Opposer has a right to know whether Applicant is, in fact, using its mark. Intent to use versus use can alter the manner in which this matter is prosecuted by Opposer. Moreover, Opposer has a right to rely on the affirmative representations made by Applicant that no actual use has occurred. Submitting discovery responses that obfuscate the issue is not proper. Therefore, Applicant should provide full and complete responses to these interrogatories.

### **Interrogatory No. 3**

Interrogatory No. 3: Identify any subsidiaries, parent companies or related companies of Applicant which have used and/or intend to use the Applicant's Mark, and for each such entity, please state:

- a) the common generic name of the products offered and/or intended to be offered bearing the name and/or mark; and
- b) the actual and/or intended channels of trade for the products offered bearing the name and/or mark.

Applicant's Response: The Applicant is president of Wellness Lifestyles, Inc., a California corporation, d.b.a. American Longevity.

- a. Please see Response to Interrogatory No. 1.
- b. Please see Response to Interrogatory No. 2.

Applicant's response is insufficient. First, the response merely states the Applicant's position and the company he works for. The response does not state whether "any subsidiaries, parent companies or related companies of Applicant" have used and/or intend to use Applicant's Mark. Second, the response fails to provide "the common generic name of the products offered and/or intended to be offered bearing the name and/or mark." Instead, the Applicant's response to part b. merely refers to the response to Interrogatory No. 1, which does not provide the common generic name of the products. Third, the response fails to properly "identify," as that term is defined in Definition 5 of the Opposer's Interrogatories, namely, to provide, *inter alia*, a "present or last known address." Fourth, for the same reason as discussed above in connection

with Interrogatory No. 1, Response No. 3, which incorporates by reference the response to Interrogatory No. 1, needs to be clarified and supplemented.

### **Interrogatory No. 6**

Interrogatory No. 6: Identify any inquiry, search, or investigation of the records of the United States Patent and Trademark Office, any state agency (e.g., trademark or trade name records) or any other records and/or publications including but not limited to trade directories, in connection with the selection, adoption, registration, registrability or use of Applicant's Mark.

Applicant's Response: The U.S. Patent and Trademark Office database was researched during the selection process of the Applicant's mark.

Applicant's response is insufficient. "Identify" with respect to documents as defined in Opposer's Interrogatories "means to give, to the extent known: (a) the type of document; (b) the general subject matter; (c) the date of the document; and (d) author(s), address(es), and recipient(s)." See Ex. 1 at 2. Applicant's response fails to provide any of this information, and thus needs to be supplemented.

### **Interrogatory No. 7**

Interrogatory No. 7: Identify all media in which Applicant's goods bearing the Applicant's Mark have been and/or will be advertised or promoted.

Applicant's Response: The products are promoted by independent distributors who may use various forms of advertising media, including the internet, to promote their particular distribution. The Respondent provides catalogs and other forms of support for the independent distributors.

Applicant's response is insufficient. As discussed above, "identify" with respect to documents as defined in Opposer's Interrogatories "means to give, to the extent known: (a) the type of document; (b) the general subject matter; (c) the date of the document; and (d) author(s), address(es), and recipient(s)." See Ex. 1 at 2. "Identify" with respect to persons as defined in Opposer's Interrogatories "means to give, to the extent known, the person's full name, present or

last known address and additionally, when referring to a natural person, his or her present or last known place of employment and title.” Id. Applicant’s response encompasses both documents and persons, but fails to provide any of the required information. Accordingly, Applicant needs to supplement its response to provide a full and complete answer.

### **Interrogatories Nos. 8 & 9**

Interrogatory No. 8: State in round numbers the dollar amount Applicant has expended in connection with advertising and promoting goods bearing the Applicant’s Mark in each medium identified in response to the preceding interrogatory.

Applicant’s Response: Applicant objects to this interrogatory on the grounds that the interrogatory seeks confidential financial information and further on the grounds that the information sought is proprietary and confidential. Subject to and without waiving said objection, Applicant will respond to this interrogatory upon execution and entry of a protective order limiting review of the response to attorneys and non-party experts.

Interrogatory No. 9: State in round numbers broken down by year and month the dollar amount of sales of goods bearing the Applicant’s Mark.

Applicant’s Response: Applicant objects to this interrogatory on the grounds that the interrogatory seeks confidential financial information and further on the grounds that the information sought is proprietary and confidential. Subject to and without waiving said objection, Applicant will respond to this interrogatory upon execution and entry of a protective order limiting review of the response to attorneys and non-party experts.

As shown in Exhibit 6, the parties have entered into a Stipulated Protective Order, which has been filed with the Board. In both the October 8 letter and the October 17 telephone conversation, Opposer’s counsel told Applicant’s counsel that as the protective order has been executed by Applicant’s and Opposer’s counsel, the objections to Interrogatories 8 & 9 were no longer valid. During the October 17 telephone conversation, Applicant’s counsel expressly promised to provide responses within a week. Applicant, however, has failed to do so.

Moreover, Applicant's objections imply that it has started advertising and promoting goods bearing its mark, and has actually sold such goods. In other words, Applicant has started to use its mark in commerce. However, as discussed above, this contradicts Applicant's prior position (evidenced, in part, by the intent to use nature of the application and the fact that no amendment to allege use has been filed) that no use has begun. Applicant's response, therefore, is misleading and incomplete.

### **Interrogatory No. 11**

Interrogatory No. 11: Identify all instances in which any person has inquired of Applicant or indicated to Applicant that the goods or services bearing the Applicant's Mark is/are sponsored, authorized or endorsed by or affiliated or otherwise connected in any way with Opposer or Opposer's goods or services, or whether Opposer or its goods or services is/are sponsored, authorized or endorsed by or affiliated or otherwise connected in any way with Applicant or Applicant's goods and services bearing the Applicant's Mark, and, for each such instance:

- (a) identify the person(s) making the inquiry or indication; and
- (b) state whether a record was made of such instance and, if so, identify such record.

Applicant's Response: No instances of confusion are known to exist, whatsoever.

Applicant's response merely provides Applicant's counsel's personal legal opinion as to whether there have been instances of confusion. However, Opposer's Interrogatory is not limited to instances which, in Applicant's counsel's personal opinion, constitute instances of actual confusion. Opposer needs to answer the Interrogatory as written, and thus needs to supplement its response.

### **Interrogatory No. 13**

Interrogatory No. 13: Describe in detail all facts and circumstances supporting your denial of paragraph 14 of the Notice of Opposition.

Applicant's Response: Please see the Responses [sic] to Interrogator [sic] No. 12, above. Additionally, the two products have significant differences in the actual ingredients that make up the product.

Paragraph 14 of the Notice of Opposition reads: “The virtual identity of these two marks, in sound, appearance and meaning, and intended for use on similar products for treating the same physical conditions creates a likelihood of confusion.” Applicant denied this paragraph, stating: “Respondent denies that Respondent’s mark OSTEO-FX closely resembles the Opposer’s mark OSTEO-BI-FLEX in any manner including sound or appearance. Respondent further denies that any likelihood of confusion exists, whatsoever.” **See Applicant’s Answer to Opp’n ¶ 17.**

Applicant’s response to Interrogatory No. 13 fails to “describe in detail” the alleged “significant differences in the actual ingredients that make up the product.” Indeed, nowhere in its responses does Applicant provide any information of what “actual ingredients” make up the Applicant’s product(s). Therefore, Applicant needs to supplement its answer to provide a full and complete response.

## **II. First Request of Applicant for Production of Documents and Things**

Rather than provide individual responses to Opposer’s twenty-one Requests for Production, Applicant’s counsel merely provides the following paragraph:

### **RESPONSE TO REQUEST NOS. 1-21:**

Applicant objects to any request for documents which violate the attorney-client privilege. Furthermore, Applicant objects to any request for documents which contain confidential or financial information on the grounds that the information sought is proprietary and confidential. Subject to and without waiving said objections, Applicant will produce documents which are in its possession and control at a mutually agreed to time, between the hours of 9:00 a.m. and 4:00 p.m. PDT, at the offices of HASKINS & ASSOCIATES, 4045 Bonita Road, Suite 206, Bonita, California.

Applicant’s general response and objection is improper. See 7 James W. Moore, Moore’s Federal Practice § 34.13[2][b] (3d ed. 2002) (“An objection to a Rule 34 request must clearly set forth the specifics of the objection and how that objection relates to the documents being demanded.

Generic, non-specific objections are improper.”) Therefore, Applicant needs to provide full and complete responses to Opposer’s individual Requests.

In addition, Applicant must provide responsive documents to Opposer’s counsel. In its October 8 letter, Opposer’s counsel asked Applicant’s counsel for further information on the nature and quantity of the Applicant’s responsive documents, and asked Applicant’s counsel to provide more explanation as to why personal inspection in California, as opposed to mailing copies to Opposer’s counsel, was necessary. After receiving no response, Opposer’s counsel called Applicant’s counsel on October 17 to discuss the issue. During that telephone conversation, Applicant’s counsel expressly promised to mail all responsive documents to Opposer’s counsel “next week,” which was the week of October 21.<sup>1</sup> The week of October 21 has come and gone, and no documents of any kind have been received by Opposer’s counsel. Applicant’s counsel has not provided any justification for failing to provide responsive documents.

Time is of the essence, with the testimony period in this case beginning on November 10, 2002. Opposer’s ability to adequately prepare its case has been unfairly hindered by Applicant’s failure to provide full and complete responses to Opposer’s discovery requests. Opposer simply cannot spend more time trying to obtain discovery from a recalcitrant adversary without the Board’s assistance.

Opposer therefore moves to compel the Applicant to supplement its responses to Opposer’s discovery requests. Opposer also requests that all the deadlines in this case, including the discovery period, be re-opened and extended for 60 days from the date of the Board’s decision on this Motion.

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<sup>1</sup> Opposer mailed documents responsive to Applicant’s request for production directly to Applicant’s counsel along with individual responses to the individual requests. Therefore, unlike Opposer, Applicant was not forced to wait for a document production.

This will allow Opposer time to adequately follow-up on Applicant's discovery responses, especially the late-in-the-day contention that Applicant is using its mark.

Respectfully submitted,

NUMICO FINANCIAL SERVICES, S.A.

By: 

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Date: November 1, 2002

# EXHIBIT 1

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

NUMICO FINANCIAL SERVICES, S.A.

Opposer,

v.

DR. JOEL D. WALLACH

Applicant.

Opposition No.: 91150888  
Serial No. 76/274,080

**OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT**

Pursuant to Rules 26 and 33 of the Federal Rules of Civil Procedure and Trademark Rules 2.116 and 2.120, Opposer hereby requests that Applicant answer separately and fully, in writing and under oath, each of the following interrogatories, and serve such answers on counsel for Opposer within thirty (30) days of service of these interrogatories. Applicant shall supplement and/or amend its responses to the interrogatories in accordance with Rule 26(e) of the Federal Rules of Civil Procedure.

**DEFINITIONS**

The following definitions shall apply to these interrogatories and instructions thereto:

1. "You," "Your" or "Applicant" refers to Dr. Joel D. Wallach and any of his affiliates, agents, employees, distributors and representatives.
2. "Opposer" refers to Numico Financial Services, S.A.
3. "Document" means the original and all non-identical copies of any writing or electronic recording or transcription of any kind, which is known by you to exist or to have existed or which at any time has been in your possession, custody, or control, including, but not limited to letters, envelopes, forms, affidavits, correspondence, telegraphs, telecopies, telefaxes,

**OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT**  
**Opposition No.: 91150888**

paper communications, signed statements, tabulations, charts, memoranda, checks, appointment books, records, proposals, memoranda or other transcripts by mechanical device, by longhand or shorthand recording, tape recorded or by electronic or by any other means, computer generated information, computer software, data stored in a computer, intraoffice communications, inter-office communications, all summaries of all communications, telephonic or otherwise, microfiche, microfilm, lists, bulletins, calendars, circulars, desk pads, opinions, ledgers, minutes, agreements, journals, diaries, contracts, invoices, balance sheets, telephone messages or other messages, magazines, pamphlets, articles, notices, newspapers, studies, worksheets, telexes, cables and all other graphic materials, writings and instruments, however produced or reproduced. A document includes all documents appended thereto.

4. "Concerning," "Relating to" or "Relate to" means constituting, discussing, mentioning, containing, analyzing, embodying, reflecting, identifying, incorporating, describing, commenting on, referring to, considering, recommending, dealing with or pertaining to in whole or in part.

5. "Identify" with respect to persons means to give, to the extent known, the person's full name, present or last known address and additionally, when referring to a natural person, his or her present or last known place of employment and title. Once a person has been identified in accordance with this paragraph, only the name of that person need to be listed in response to subsequent discovery requests in the identification of that person.

6. "Identify" with respect to each document means to give, to the extent known: (a) the type of document; (b) the general subject matter; (c) the date of the document; and (d) the author(s), addressee(s), and recipient(s).

**OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT**  
**Opposition No.: 91150888**

7. "Identify" with respect to oral communications shall mean: (a) the communication medium, i.e., in person or telephonic; (b) the date of each such communication; (c) the full name and current business and residence address of those who were present at each communication; and (d) the substance and nature of each such communication.

8. "Person" means any natural person or any business, legal or governmental agency or association.

9. The connectors "and" and "or" shall be construed either disjunctively or conjunctively as necessary to bring within the scope of the discovery requests all responses that might otherwise be construed to be outside its scope.

10. "Including" means including without limitation.

11. "Media" shall mean newspapers, television, radio, and written advertising including, but not limited to, billboards, magazines and handbills.

12. "Promotional materials" means items such as, but not limited to, sales brochures, catalogs, Internet web sites, and giveaway items.

13. "Channels of trade" means "how and to whom the respective goods of the parties are sold." See 4 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 24:51 (4<sup>th</sup> ed. 2001).

14. "Applicant's Mark" means the mark OSTEO-FX as set forth in U.S. Application Serial No. 76/274,080.

15. "Opposer's Mark" means the mark OSTEO-BI-FLEX as set forth in U.S. Registration No. 2,205,607 and in the Notice of Opposition.

**INSTRUCTIONS**

1. Answers to these interrogatories should reflect a thorough and complete review of the knowledge resident with the Applicant's employees, their files, and the knowledge and files of Applicant's agents, officers, servants and any other person under the control of the Applicant.
2. In answering these interrogatories, please furnish all information currently known or available to you or your attorneys.
3. A separate answer should be recorded for each interrogatory and interrogatory subpart setting forth and identifying the source of each answer separately
4. If you contend that any information is protected by privilege, identify the privilege relied on, the persons who have the requested information and any document which contains the information, including for each document:
  - a) the type of document;
  - b) the author;
  - c) the recipients;
  - d) the date;
  - e) the subject matter; and
  - f) the basis of the privilege.
5. If you are unable to respond fully to any interrogatory herein, or object to a part of any interrogatory, you should respond fully to the extent possible to that part of the interrogatory to which you do not object and provide an explanation as to why you cannot respond to the remainder of the interrogatory.

**OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT**  
**Opposition No.: 91150888**

6. All interrogatories herein are directed to that information or those documents within your possession, custody or control, or within the possession, custody or control of your agents, servants and employees and, unless privileged, your attorney. They are also directed to those firms, corporations, partnerships, or trusts that you control and to documents in the possession, custody or control of the employees, agents, next friends, trustees, guardians and/or representatives of such entities.

7. These interrogatories shall be deemed to be continuing. You are expected to comply with Rule 26(e)(2) of the Federal Rules of Civil Procedure which provides as follows:

A party is under a duty seasonably to amend a prior response to an interrogatory, request for production, or request for admission if the party learns that the response is in some material respect incomplete or incorrect and if the additional or corrective information has not otherwise been made known to the other parties during the discovery process or in writing.

8. Whenever Applicant answers any interrogatory by reference to records from which the answer may be derived or ascertained, as permitted by Rule 33(d) of the Federal Rules of Civil Procedure, the documents shall be available to Opposer for inspection and copying as of the date the answers to the interrogatories are served or at a date mutually agreed upon by the parties.

9. All discovery is subject to the Protective Order attached hereto, which is to be signed by the Applicant and returned to Opposer for filing with the Board.

**INTERROGATORIES**

**INTERROGATORY NO. 1**

State all marks Applicant has used and/or intends to use that contain the word OSTEO and/or OSTEO-FX.

**INTERROGATORY NO. 2**

Describe the actual and/or intended channels of trade for the goods bearing the Applicant's Mark.

**INTERROGATORY NO. 3**

Identify any subsidiaries, parent companies or related companies of Applicant which have used and/or intend to use the Applicant's Mark, and for each such entity, please state:

- a) the common generic name of the products offered and/or intended to be offered bearing the name and/or mark; and
- b) the actual and/or intended channels of trade for the products offered bearing the name and/or mark.

**INTERROGATORY NO. 4**

Identify the person(s) most knowledgeable about the selection, adoption, use and application for registration of Applicant's Mark.

**OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT**  
**Opposition No.: 91150888**

INTERROGATORY NO. 5

Identify the person(s) most knowledgeable about Applicant's actual and/or intended marketing, advertising and sale of products bearing Applicant's Mark.

INTERROGATORY NO. 6

Identify any inquiry, search, or investigation of the records of the United States Patent and Trademark Office, any state agency (e.g., trademark or trade name records) or any other records and/or publications including but not limited to trade directories, in connection with the selection, adoption, registration, registrability or use of Applicant's Mark.

INTERROGATORY NO. 7

Identify all media in which Applicant's goods bearing the Applicant's Mark have been and/or will be advertised or promoted.

INTERROGATORY NO. 8

State in round numbers the dollar amount Applicant has expended in connection with advertising and promoting goods bearing the Applicant's Mark in each medium identified in response to the preceding interrogatory.

INTERROGATORY NO. 9

State in round numbers broken down by year and month the dollar amount of sales of goods bearing the Applicant's Mark.

**OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT**  
**Opposition No.: 91150888**

INTERROGATORY NO. 10

Describe the circumstances surrounding Applicant's first awareness of Opposer's use of Opposer's Mark.

INTERROGATORY NO. 11

Identify all instances in which any person has inquired of Applicant or indicated to Applicant that the goods or services bearing the Applicant's Mark is/are sponsored, authorized or endorsed by or affiliated or otherwise connected in any way with Opposer or Opposer's goods or services, or whether Opposer or its goods or services is/are sponsored, authorized or endorsed by or affiliated or otherwise connected in any way with Applicant or Applicant's goods and services bearing the Applicant's Mark, and, for each such instance:

- (a) identify the person(s) making the inquiry or indication; and
- (b) state whether a record was made of such instance and, if so, identify such record.

INTERROGATORY NO. 12

Describe in detail all facts and circumstances supporting your denial of paragraph 12 of the Notice of Opposition.

INTERROGATORY NO. 13

Describe in detail all facts and circumstances supporting your denial of paragraph 14 of the Notice of Opposition.

**OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT**  
**Opposition No.: 91150888**

INTERROGATORY NO. 14

Describe in detail all facts and circumstances supporting your denial of paragraph 15 of the Notice of Opposition.

INTERROGATORY NO. 15

Describe in detail all facts and circumstances supporting your denial of paragraph 16 of the Notice of Opposition.

INTERROGATORY NO. 16

Describe in detail all facts and circumstances supporting your denial of paragraph 17 of the Notice of Opposition.

INTERROGATORY NO. 17

State whether Applicant is currently using its Mark in commerce.

INTERROGATORY NO. 18

Identify all persons who participated in any way in the preparation of the answers or responses to these interrogatories separately by interrogatory, and state specifically with reference to interrogatory number the area of participation of each such person.

OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT  
Opposition No.: 91150888

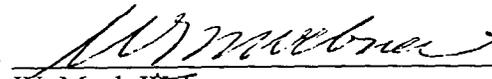
INTERROGATORY NO. 19

Identify each person which Applicant expects or intends to call as a witness to present evidence in the above-captioned opposition proceeding including but not limited to expert witnesses.

Respectfully submitted,

NUMICO FINANCIAL SERVICES, S.A.

By:



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Date: July 1, 2002

# EXHIBIT 2

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

NUMICO FINANCIAL SERVICES, S.A.

Opposer,

v.

DR. JOEL D. WALLACH

Applicant.

Opposition No.: 91150888  
Serial No. 76/274,080

**OPPOSER'S FIRST REQUEST OF APPLICANT FOR  
PRODUCTION OF DOCUMENTS AND THINGS**

In accordance with the provisions of Rule 34 of the Federal Rules of Civil Procedure and Trademark Rule 2.120, Opposer makes the following requests for the production of documents and things to Applicant. The requested documents and things shall be produced for inspection and copying at the offices of Opposer's counsel, SUGHRUE MION, PLLC, 2100 Pennsylvania Avenue, N.W., Washington, D.C. 20037-3202, or at any other location which is mutually agreeable to the parties, within thirty (30) days from service of these requests. The definitions and instructions set forth in OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT served concurrently herewith are incorporated herein by reference.

**REQUESTS**

1. All documents and things identified in response to Opposer's first set of interrogatories to Applicant.
2. All documents and things relating to the development of the Applicant's Mark.

**OPPOSER'S FIRST REQUEST OF APPLICANT FOR PRODUCTION OF DOCUMENTS AND THINGS**  
**Opposition No. 91150888**

3. All documents and things which comprise or relate to the results of any search or investigation conducted by or on behalf of Applicant which relate to the availability or registrability of Applicant's Mark.

4. All documents and things relating to the use and/or intended use of the Applicant's Mark, and any variation thereof, in interstate commerce, including but not limited to advertising, invoices and product brochures.

5. All documents and things that establish Applicant's proposed or actual channels of trade for the goods bearing the Applicant's Mark.

6. All documents and things in the possession or control of Applicant which relate to the Opposer's Mark.

7. All documents and things which indicate when and how Applicant first learned of the Opposer's Mark.

8. All documents and things in the possession or control of Applicant that refer or relate to Opposer in any way.

9. All documents and things in the possession or control of Applicant relating to any third party objections to Applicant's Mark.

10. All state or federal trademark or service mark applications or registrations filed or owned by Applicant for marks which consist of or include the word OSTEO and/or OSTEO-FX.

11. All documents and things showing Applicant's past, current and/or projected customers for its products bearing Applicant's Mark.

**OPPOSER'S FIRST REQUEST OF APPLICANT FOR PRODUCTION OF DOCUMENTS AND THINGS**  
**Opposition No. 91150888**

12. All documents and things showing Applicant's sales, in dollars, unit(s) and by month, for each product bearing Applicant's Mark.

13. Copies of all advertising and display and promotional materials, including but not limited to point of sale displays, which have been used or will be used bearing Applicant's Mark.

14. All documents and things reflecting expenditures for promotion and/or advertising for products or services bearing Applicant's Mark or variants thereof.

15. Any and all labels, tags, or packaging for Applicant's products sold bearing the Applicant's Mark.

16. All documents and things which support your denial of paragraph 12 of the Notice of Opposition.

17. All documents and things which support your denial of paragraph 14 of the Notice of Opposition.

18. All documents and things which support your denial of paragraph 15 of the Notice of Opposition.

19. All documents and things which support your denial of paragraph 16 of the Notice of Opposition.

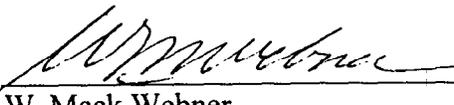
20. All documents and things which support your denial of paragraph 17 of the Notice of Opposition.

**OPPOSER'S FIRST REQUEST OF APPLICANT FOR PRODUCTION OF DOCUMENTS AND THINGS**  
**Opposition No. 91150888**

21. All documents or things upon which Applicant intends to rely in this proceeding.

Respectfully submitted,

NUMICO FINANCIAL SERVICES, S.A.

By: 

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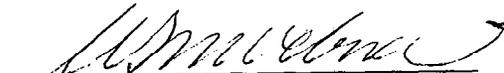
Date: July 19, 2002

# EXHIBIT 3

**CERTIFICATE OF SERVICE**

I, W. Mack Webner, Esq., hereby certify that on July 19, 2002 a true copy of the foregoing OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT, OPPOSER'S FIRST REQUEST OF APPLICANT FOR PRODUCTION OF DOCUMENTS AND THINGS, STIPULATED PROTECTIVE ORDER and ACKNOWLEDGMENT OF STIPULATED PROTECTIVE ORDER was sent via U.S. mail postage prepaid to:

Ned Ardagna, Esq.  
Haskins & Associates  
4045 Bonita Road, Suite 206  
Bonita, CA 91902

  
\_\_\_\_\_  
W. Mack Webner

# EXHIBIT 4

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

In the Matter of Trademark Application

Applicant: Joel D. Wallach

Trademark: OSTEOPLEX

Serial No. 76/274,080

Published in the  
Trademark Official Gazette: January 8, 2002

NUMICO FINANCIAL SERVICES, SA.,	)	
	)	
Opposer	)	
	)	
v.	)	
	)	Opposition No.91150888
DR. JOEL D. WALLACH	)	
	)	
Applicant	)	
	)	
	)	

**APPLICANT'S RESPONSE TO OPPOSER'S  
FIRST SET OF INTERROGATORIES**

**General Objections**

Pursuant to Federal Rule of Civil Procedure 33, Applicant, Dr. Joel D. Wallach, (hereinafter "Applicant") responds to Opposer, Numico Financial Services's (hereinafter "Opposer") First Set of Interrogatories.

1. Applicant objects to all instructions, definitions and interrogatories to the extent they purport to impose obligations beyond those imposed by the Federal Rules of Civil procedure and the Trademark Rules of Practice.

2. Applicant responds to these interrogatories to the best of its present ability as of the date of this response. Applicant specifically reserves the right to supplement, modify or vary these responses at a later date and to present relevant information at trial if Applicant uncovers additional facts in discovery and/or as a result of further investigation, legal research and analysis.

3. Applicant objects to all instructions, definitions, or interrogatories to the extent that they use or define terms inconsistent with Applicant's interpretation of those terms. Applicant in no way adopts or accepts any of the Petitioner's definitions by responding to those interrogatories or otherwise.

4. All responses below incorporate, without reference, these General Objections, and each response is made without waiving these General Objections.

5. The responses and objections below are given without prejudice to Applicant's rights to produce evidence of any subsequently discovered fact or facts which this Applicant may later recall. Applicant accordingly reserves the right to change any and all responses herein as additional facts are ascertained, analyses are made, legal research is completed and contentions are made.

6. The responses contained herein are made in good faith effort to supply as much factual information and as much specification of legal contentions as is presently known and should in no way be to the prejudice of Applicant in relation to further discovery, research or analysis. Furthermore, the responses contained herein are made without prejudice to responding

parties rights to produce facts, witnesses, and documents omitted from these responses by oversight, inadvertence and good faith error or mistake.

7. No incidental or implied admissions are made by the responses. The fact that Applicant may respond or object to any interrogatory or part thereof shall not be deemed an admission that Applicant accepts or admits the existence of any fact set forth or assumed by such interrogatory, or that such response constitutes admissible evidence. That Applicant responds to any or part of any interrogatory is not to be deemed a waiver by Applicant of its objections to other parts of such interrogatory.

8. To the extent that any interrogatory or part thereof calls for information, legal analysis or reasoning, writings, communications, compilations, or anything else protected from disclosure by the work product doctrine, by the attorney-client privilege, by the right to privacy afforded under Federal or State law, or by any other privilege or protection, Applicant objects to each and every interrogatory or part thereof and declines to furnish such protected information.

9. Applicant objects to any interrogatory of part thereof that purports to require Applicant to conduct an investigation or prepare an analysis beyond those already prepared or found in its records, or otherwise available upon reasonable; investigation. Each such requirement for investigation, analysis, or otherwise, including, without limitation, an investigation to determine, identify, and locate persons, documents, or conversations, is objected to as unduly burdensome.

10. Applicant objects to as unduly burdensome any interrogatory or definition which would require Applicant to identify documents not within Applicant's possession.

### **RESPONSES TO INTERROGATORIES**

RESPONSE TO INTERROGATORY NO. 1:

Applicant has also used the word OSTEO on a liquid vitamin and mineral product known as OSTEO-CAL.

RESPONSE TO INTERROGATORY NO. 2:

Applicant's products are sold via Multi-level Marketing (MLM) techniques, whereby the products are sold by individual contact between the buyer and seller, and are not sold to the general public through retail outlets. Applicant's and Opposer's products would not be displayed nor sold in a manner that would place the products in competition for a customer's attention on a shelf. The products are neither advertised nor marketed in traditional channels.

RESPONSE TO INTERROGATORY NO. 3:

The Applicant is president of Wellness Lifestyles, Inc., a California corporation, d.b.a. American Longevity.

- a. Please see Response to Interrogatory No. 1.
- b. Please see Response to Interrogatory No. 2.

RESPONSE TO INTERROGATORY NO. 4:

Dr. Joel Wallach and Steve Wallach are the persons most knowledgeable with respect to the selection and use of the mark that is the subject of this Opposition.

RESPONSE TO INTERROGATORY NO. 5:

Please see Applicant's Response To Interrogatory No. 4, above.

RESPONSE TO INTERROGATORY NO. 6:

The U.S. Patent and Trademark Office database was researched during the selection process of the Applicant's mark.

RESPONSE TO INTERROGATORY NO. 7:

The products are promoted by independent distributors who may use various forms of advertising media, including the internet, to promote their particular distribution. The Respondent provides catalogs and other forms of support for the independent distributors.

RESPONSE TO INTERROGATORY NO. 8:

Applicant objects to this interrogatory on the grounds that the interrogatory seeks confidential financial information and further on the grounds that the information sought is proprietary and confidential. Subject to and without waiving said objection, Applicant will respond to this interrogatory upon execution and entry of a protective order limiting review of the response to attorneys and non-party experts only.

RESPONSE TO INTERROGATORY NO. 9:

Applicant objects to this interrogatory on the grounds that the interrogatory seeks confidential financial information and further on the grounds that the information sought is proprietary and confidential. Subject to and without waiving said objection, Applicant will respond to this interrogatory upon execution and entry of a protective order limiting review of the response to attorneys and non-party experts only.

RESPONSE TO INTERROGATORY NO. 10:

Applicant first became aware of Opposer's mark when the Notice Of Opposition was received, on or about February 23, 2002.

RESPONSE TO INTERROGATORY NO. 11:

No instances of confusion are known to exist, whatsoever.

RESPONSE TO INTERROGATORY NO. 12:

As stated in Applicant's Answer to the Notice Of Opposition, the similarity between the marks is in the word "OSTEO." Among the differences are included, the actual mark itself, the

placement of the mark on the product (with the Applicant's mark on a single line and the Opposer's mark on two lines), color, font and the actual packaging of the product causing the marks to be completely different in site and appearance. Furthermore, OSTEO is a word that has been used with such regularity as descriptive of products recommended for bone health and especially products which contain calcium, such as the Applicant's product. The word OSTEO is merely a descriptive medical term and is often used to promote products recommended for bone health.

RESPONSE TO INTERROGATORY NO. 13:

Please see the Responses to Interrogator No. 12, above. Additionally, the two products have significant differences in the actual ingredients that make up the product.

RESPONSE TO INTERROGATORY NO. 14:

Please see Applicant's Responses to Interrogatory Nos. 12 and 13, above. Additionally, no similarity exists between the marks or the actual products.

RESPONSE TO INTERROGATORY NO. 15:

Please see Applicant's Responses to Interrogatory Nos. 12, 13, and 14 above, Additionally, the Applicant's products are not sold via normal retail sales channels and are sold via MLM techniques, which is more personal.

RESPONSE TO INTERROGATORY NO. 16:

The US Patent and Trademark Office database indicates that 75 products using the term OSTEO in International Classification 005 have sought registration of mark and approximately a third of these applications have received registrations, many of them prior to the registration of Opposer's mark. Research on the internet indicates more than 70,000 results in Google for the search term OSTEO, including Opposer's's website. OSTEO is not a unique or distinctive term.

RESPONSE TO INTERROGATORY NO. 17:

Applicant currently uses its mark in commerce.

RESPONSE TO INTERROGATORY NO. 18:

Dr. Joel Wallach, Steve Wallach and attorney Ned Ardagna assisted with all of the responses.

Dated: August 16, 2002

**LAW OFFICES OF HASKINS & ASSOCIATES**

By:  \_\_\_\_\_

Ned Ardagna, Esq.

Attorneys for Applicant Dr. Joel Wallach

# EXHIBIT 5

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

In the Matter of Trademark Application

Applicant: Dr. Joel D. Wallach

Trademark: OSTEOPATHY

Serial No. 76/274,080

Published in the  
Trademark Official Gazette: November 6, 2001

NUMICO FINANCIAL SERVICES, SA	)	
	)	
Opposer	)	
	)	
v.	)	
	)	Opposition No. 91,150,888
DR. JOEL D. WALLACH	)	
	)	
Applicant	)	
	)	
	)	

**APPLICANT'S RESPONSE TO OPPOSER'S  
FIRST REQUEST FOR PRODUCTION**

**General Objections**

Pursuant to Federal Rule of Civil Procedure 33, Applicant, Dr. Joel D. Wallach, (hereinafter "Applicant") responds to Opposer, Numico Financial Services's First Request For Production of Documents and Things.

1. Applicant objects to all instructions, definitions, interrogatories and requests to the extent they purport to impose obligations beyond those imposed by the Federal Rules of Civil procedure and the Trademark Rules of Practice.

2. Applicant responds to those requests to the best of his present ability as of the

date of this response. Applicant specifically reserves the right to supplement, modify or vary these responses at a later date and to present relevant information at trial if Applicant uncovers additional facts in discovery and/or as a result of further investigation, legal research and analysis.

3. Applicant objects to all instructions, definitions, interrogatories and requests to the extent that they use or define terms inconsistently with Applicant's interpretation of those terms. Applicant in no way adopts or accepts any of the Petitioner's definitions by responding to those requests or otherwise.

4. All responses below incorporate, without reference, these General Objections, and each response is made without waiving these General Objections.

5. The responses and objections below are given without prejudice to Applicant's rights to produce evidence of any subsequently discovered fact or facts which this Applicant may later recall. Applicant accordingly reserves the right to change any and all responses herein as additional facts are ascertained, analyses are made, legal research is completed and contentions are made.

6. The responses contained herein are made in good faith effort to supply as much factual information and as much specification of legal contentions as is presently known and should in no way be to the prejudice of Applicant in relation to further discovery, research or analysis. Furthermore, the responses contained herein are made without prejudice to responding parties rights to produce facts, witnesses, and documents omitted from these responses by oversight, inadvertence and good faith error or mistake.

7. No incidental or implied admissions are made by the responses. The fact that Applicant may respond or object to any request or part thereof shall not be deemed an admission

that Applicant accepts or admits the existence of any fact set forth or assumed by such request, or that such response constitutes admissible evidence. That Applicant responds to any or part of any request is not to be deemed a waiver by Applicant of its objections to other parts of such request.

8. To the extent that any request or part thereof calls for information, legal analysis or reasoning, writings, communications, compilations, or anything else protected from disclosure by the work product doctrine, by the attorney-client privilege, by the right to privacy afforded under Federal or State law, or by any other privilege or protection, Applicant objects to each and every interrogatory or part thereof and declines to furnish such protected information.

9. Applicant objects to any request or part thereof that purports to require Applicant to conduct an investigation or prepare an analysis beyond those already prepared or found in its records, or otherwise available upon reasonable investigation. Each such requirement for investigation, analysis, or otherwise, including, without limitation, an investigation to determine, identify, and locate persons, documents, or conversations, is objected to as unduly burdensome.

10. Applicant objects to as unduly burdensome any request or definition which would require Applicant to identify documents not within Applicant's possession.

### **RESPONSES TO REQUESTS**

#### **RESPONSE TO REQUEST NOS. 1 - 21:**

Applicant objects to any request for documents which violate the attorney-client privilege. Furthermore, Applicant objects to any request for documents which contain confidential or financial information on the grounds that the information sought is proprietary and confidential. Subject to and without waiving said objections, Applicant will produce documents which are in its possession and control at a mutually agreed to time, between the

hours of 9:00 a.m. and 4:00 p.m. PDT, at the offices of HASKINS & ASSOCIATES, 4045  
Bonita Road, Suite 206, Bonita, California.

Dated: August 15, 2002

**LAW OFFICES OF HASKINS & ASSOCIATES**

By:   
Ned Ardagna, Esq.  
Attorneys for Applicant Dr. Joel Wallach

**PROOF OF SERVICE**

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

Numico Financial Services vs. Joel D. Wallach  
Opposition No. 91150888

STATE OF CALIFORNIA, COUNTY OF SAN DIEGO

I am employed in the County of San Diego, State of California. I am over the age of 18 and not a party to the within action.

On August 16, 2002, I served the following documents described as:

**APPLICANT'S RESPONSE TO OPPOSER'S FIRST SET OF INTERROGATORIES**

**APPLICANT'S RESPONSE TO OPPOSER'S FIRST REQUEST FOR PRODUCTION**

**PROTECTIVE ORDER**

on all Parties in this action by placing in a separate envelope, with postage fully prepaid for each addressee named below, for collection and mailing on August 16, 2002, following the ordinary business practices of Haskins and Associates at 4045 Bonita Road, Suite 206, Bonita California. I certify that I am familiar with the ordinary business practice of my place of employment with regard to collection for mailing with the United States Postal Service.

W. Mack Webner, Esq.  
SUGHRUE MION, PLLC  
2100 Pennsylvania Ave., N.W.  
Washington, D.C. 20037-3202

I declare under penalty of perjury under the laws of the State of California that the above is true and correct. Executed on August 16, 2002, at Bonita, California.

  
Vangie Samson

# EXHIBIT 6

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

NUMICO FINANCIAL SERVICES, S.A.

Opposer,

v.

DR. JOEL D. WALLACH

Applicant.

Opposition No.: 91150888  
Serial No. 76/274,080

STIPULATED PROTECTIVE ORDER

IT IS HEREBY STIPULATED AND AGREED by the undersigned attorneys for the respective parties, subject to the Order of the Board, that:

1. Certain documents, information or material taken, given or exchanged in the course of these proceedings (the "Opposition") may contain, constitute or disclose confidential, commercial or proprietary information. This Stipulation and Order for the Production and Exchange of Confidential Information shall govern documents, information and any other discovery, hearing or trial materials which any party to this Opposition produces or provides pursuant to a discovery request and designates as "Confidential."
2. All documents produced and all information obtained through discovery in the Opposition designated as "Confidential" (as provided below) shall be used by the parties receiving it only for the purposes of preparing for and conducting the Opposition and for no other purpose.
3. In connection with discovery proceedings in the Opposition, any party may designate any document, material or information as "Confidential" under the terms of this Stipulation and Order if such party in good faith believes that such document, material or information constitutes or reveals confidential commercial or other proprietary business information which requires the protection provided in this Stipulation and Order.

**STIPULATED PROTECTIVE ORDER**  
**Opposition No.: 91150888**

4. Any documents or other tangible material designated as "Confidential" shall be so designated by stamping the same with the legend "Confidential" or similar legend at the time of their production.

5. Any interrogatory response designated as "Confidential" shall be so designated by stamping the same with the legend "Confidential" or a similar legend at the time of the response.

6. Any deposition or other testimony may be designated as "Confidential" by indicating on the record that the testimony is "Confidential" and subject to the provisions of this Order. Alternatively, the attorneys for a party need not designate specific testimony as "Confidential" during the course of the deposition but may request that the entire contents of the deposition shall be designated "Confidential" and subject to the provisions of this Order. The attorney designating an entire deposition as "Confidential" shall have fifteen (15) days from the receipt of the transcript to designate those portions of the testimony deemed "Confidential" and inform opposing counsel of such designations. The portions of the testimony so designated shall be subject to the provisions of this Order. Failure to so designate shall remove the entire deposition from the provisions of this Order.

7. Documents or material, including portions of deposition transcripts, and interrogatory responses designated as "Confidential" or information derived therefrom may only be disclosed or made available to "Qualified Persons," who consist exclusively of:

- (a) The Board (in the manner provided by paragraph 8 hereof);
- (b) Outside counsel to the parties who have entered appearances in this action and attorneys, clerical, paralegal and secretarial staff employed by such counsel;
- (c) Court reporters employed in connection with the Opposition;

(d) Attorney employees of the parties and their clerical, paralegal and secretarial staffs.

8. If documents, exhibits, answers to interrogatories, material (including portions of deposition transcripts) or other information designated as "Confidential" pursuant to any of the provisions hereof are to be included in any papers to be filed before the Board, such papers shall be endorsed with the caption of this action, labeled as "CONFIDENTIAL UNDER PROTECTIVE ORDER" and a statement substantially in the following form:

"This envelope containing documents which are filed in this case by (name of party) is not to be opened nor the contents thereof to be displayed except by Order of the Board" and filed under seal and kept under seal.

9. Because it is possible that a document will be produced in error without a "Confidential" designation, the producing party may, within five (5) business days thereafter, identify each such undesignated document, as well as any copy of each such document, and request that such document be treated as "Confidential." Upon receipt of such a request, the receiving party shall thereafter mark such document as constituting or containing "Confidential" information and shall treat such document in accordance with the provisions of this Protective Order.

10. At the conclusion of the Opposition, all documents, material or other information designated as "Confidential," all copies of the same and (except as provided herein with respect to documents reflecting attorney work-product) all documents reflecting same shall be promptly returned by the receiving party to the producing party or, after consultation with and approval by opposing counsel, destroyed by the receiving party. In the event that it is agreed that the

**STIPULATED PROTECTIVE ORDER**  
**Opposition No.: 91150888**

materials may be destroyed, the receiving party shall provide the opposing party with a signed statement attesting to the destruction of the documents.

11. Nothing herein shall preclude a party from exhibiting, during depositions, hearing or trial proceedings, in connection with briefs or other papers filed with the Board, any documents, exhibits, answers to interrogatories, material (including portions of deposition transcripts) or other information designated as "Confidential". However, if use is to be made of such materials or information at trial, during a hearing or deposition or in a brief, that portion of the brief, or the trial, hearing or deposition transcript wherein such use is made shall be maintained confidential and retained under seal, unless the parties waive this provision in writing or in open court as to any part or all of such material.

12. If the attorneys of record in this action for any receiving party object to the designation of any information, documents or materials as "Confidential" those attorneys shall so notify the attorneys for the producing party in writing (the "Notice"). The Notice shall identify the document, information or other material so objected to and shall (a) state that the receiving party objects to the designation of such document, information or materials as "Confidential"; (b) set forth the reasons for such objection; and (c) name the particular person to whom disclosure is sought to be made. If the producing party objects to the proposed disclosure within five business days after receipt of the written notice, the receiving party may seek a hearing with respect to the propriety of the designation and the producing party will cooperate in obtaining a prompt hearing with respect thereto. Until the Board rules on the receiving party's application, the documents and information in question shall not be disclosed by the receiving party to the person specified in the Notice.

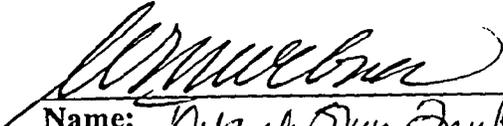
13. In addition to the provisions of paragraph 7 above, "Confidential" material or information may be disclosed or made available to a consultant or expert retained solely for the Opposition by the receiving party proposing to make such disclosure; provided that such consultant or expert is not (a) advising any business competitor of the producing party or (b) advising the receiving party seeking to make such disclosure with respect to any of the parties hereto, other than solely in connection with the Opposition; and further provided that such consultant or expert agrees in writing to be bound by the terms and conditions of this Stipulation and Order (including, without limiting the generality of the foregoing, paragraph 8 hereof); and agrees not to disclose or use such material or information for purposes other than the Opposition (a sample form is appended hereto as Exhibit A). It is further agreed that such disclosure shall only be made if written notice of the name, address, employment history, clients, education and published works of such consultant or expert is given to the party producing the material and such party does not object thereto within seven business days after receipt of such written notice (which objection must be made in good faith).

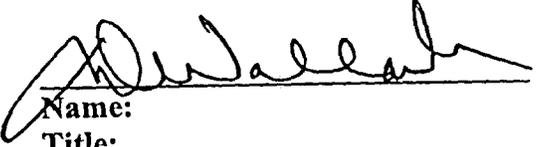
14. Any person other than those designated in paragraph 7 to whom confidential documents, information or other materials are disclosed or shown shall be given a copy of this Stipulation and Order and shall acknowledge in writing that he or she had read, understands and is subject to the terms and conditions of this Stipulation and Order and will not disclose such information, documents or materials except in accordance with the terms of this Stipulation and Order (see form attached hereto as Exhibit A).

APPROVED AS TO FORM AND SUBSTANCE

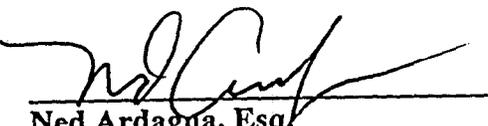
NUMICO FINANCIAL SERVICES, S.A.

DR. JOEL D. WALLACH

  
Name: Rexall Gudum, Inc.  
Title: NUMICO Financial Services

  
Name: \_\_\_\_\_  
Title: \_\_\_\_\_

\_\_\_\_\_  
W. Mack Webner, Esq.  
SUGHRUE MION, PLLC

  
\_\_\_\_\_  
Ned Ardagna, Esq.  
HASKINS & ASSOCIATES

By Order of the Board, effective \_\_\_\_\_.

\_\_\_\_\_  
Name:  
Title:

# **EXHIBIT A**

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

NUMICO FINANCIAL SERVICES, S.A.

Opposer,

v.

DR. JOEL D. WALLACH

Applicant.

Opposition No.: 91150888  
Serial No. 76/274,080

**ACKNOWLEDGMENT OF STIPULATED PROTECTIVE ORDER**

I, \_\_\_\_\_, declare that I have been provided with a copy of the Stipulated Protective Order regarding the disclosure of, and protection of, certain types of information and documents during and after the above-captioned opposition proceeding before the Trademark Trial and Appeal Board.

I have read the Stipulated Protective Order and understand its terms and provisions, by which I agree to be bound. Specifically, I agree to hold in confidence any information or documents disclosed to me in conjunction with any part I take in this proceeding.

I declare under the penalty of perjury that these statements are true and correct.

\_\_\_\_\_  
Name:

Title:

\_\_\_\_\_  
Date

# EXHIBIT 7



Paul M. Higgins  
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October 8, 2002

**VIA FACSIMILE/FIRST CLASS MAIL**

Ned Ardagna  
Haskins & Associates  
4045 Bonita Road, Suite 206  
Bonita, California 91902-1336

Re: Trademark Opposition No.: 91,150,888  
Application Serial No. 76/274,080  
Mark: OSTEO-FX  
Applicant: Dr. Joel D. Wallach  
Our Ref: 500-171

Dear Mr. Ardagna:

In reviewing the Applicant's response to Opposer's First Set of Interrogatories and First Request for Production of Document and Things, it is apparent that additional information and documentation are required. I will discuss below the specific areas that need to be supplemented. We would appreciate the supplemental responses within the next ten days.

### **INTERROGATORIES**

#### **Interrogatory No. 1**

In your response to this interrogatory, you state that, "Applicant has also used the word OSTEO on a liquid vitamin and mineral product known as OSTEO-CAL." Applicant's statement "has also used," implies that the Applicant is using the mark that is the subject of the opposition, namely, OSTEO-FX. However, there is no evidence that Applicant has made any actual use of this mark. Indeed, the application for the OSTEO-FX mark is based on an intent to use, and according to the PTO records, no statement of use has been filed. Therefore, the Applicant needs to correct and clarify its response.



Ned Ardagna  
October 8, 2002  
Page 2 of 4

**Interrogatory No. 3.**

Applicant's response to this is incomplete on its face. The Applicant provides only the name of the company for which he is an officer. This answer is not responsive to the remainder of the interrogatory which requests the "common generic name of the products offered and/or intended to be offered bearing the name and/or mark." Moreover, Applicant's response does not state whether there are any subsidiaries, parent companies or related companies of Applicant that have used or intend to use the Applicant's mark. Finally, for the same reason as discussed above with connection to Interrogatory No. 1, Interrogatory No. 3, which incorporates by reference the response to Interrogatory No. 1, needs to be clarified and supplemented.

**Interrogatory No. 6**

The Applicant's response to Interrogatory No. 6 is incomplete on its face. Opposer refers Applicant's counsel to Definition No. 6 of Opposer's First Set of Interrogatories to Applicant, which requires much more information than simply stating that a search of the USPTO database was accomplished. Applicant needs to provide all the information set forth in Definition No. 6.

**Interrogatory No. 7**

It is unclear why Applicant's response reads as if the Applicant's mark is currently being promoted and advertised in view of the intent to use status of the application. The Applicant needs to either change its answer to this Interrogatory or amend all of its discovery responses to reflect that actual use has been made on its mark.

**Interrogatories Nos. 8 and 9**

As the parties have signed the Stipulated Protective Order, Applicant is now in a position to provide full and complete responses to these interrogatories.

**Interrogatory No. 11**

Applicant's response provides a legal conclusion, namely that "no instances of confusion are known to exist." However, Opposer's Interrogatory No. 11 is not limited to examples of what the Applicant deems "instances of confusion." Instead, Interrogatory No. 11 clearly requests that the Applicant "[i]dentify all instances in which any person has inquired of Applicant or indicated to Applicant the goods or services bearing the Applicant's mark is/are sponsored, authorized or endorsed by or affiliated or otherwise connected in any way with Opposer or Opposer's goods or services, or whether Opposer's goods or services is/are



Ned Ardagna  
October 8, 2002  
Page 3 of 4

sponsored, authorized or endorsed by or affiliated or otherwise connected in any way with Applicant or Applicant's goods and services bearing the Applicant's mark." Applicant needs to provide a full response to Interrogatory No. 11 as written.

**Interrogatory No. 13**

Applicant needs to clarify what it means when it states that "the two products have significant differences in the actual ingredients that make up the product." Applicant needs to state exactly what these differences are.

**Interrogatory No. 14**

Applicant needs to supplement its response to clarify what it means when it states that "[a]dditionally, no similarity exist between the marks for the actual products."

**Interrogatory No. 17**

Applicant needs to either correct this answer, or amend all of its discovery responses to reflect that actual use has begun.

**DOCUMENT REQUESTS**

Applicant's response is insufficient on its face. The Applicant has not provided specific responses to the specific document requests, which is required by the applicable rules of procedure. In addition, it is unduly burdensome for the Applicant to merely offer to produce documents in California without first identifying any of the documentation, and without providing any justification for requiring Opposer's counsel to travel across the country to obtain unknown documents of unknown quantity.

Not only must Applicant provide individual responses to each and every document request, but the documents have to be identified and provided if possible. If Applicant and its counsel truly believe that the documents are of such volume, or of such nature, that it is unduly burdensome and unfair for them to be mailed to counsel for Opposer, please state all justifications for such a position.



Ned Ardagna  
October 8, 2002  
Page 4 of 4

If you have any questions, please contact me to discuss these matters. However, please be advised that Opposer's position is set forth completely in this letter, and Opposer does not intend to withdraw any of its objections without receipt of anything less than full responses as set forth in this letter.

Very truly yours,

A handwritten signature in cursive script, appearing to read 'Paul Higgins', with a long horizontal flourish extending to the right.

Paul M. Higgins

WMW/PMH/clb

**CERTIFICATE OF SERVICE**

I, Paul M. Higgins, Esq., hereby certify that on November 1, 2002 a true copy of the foregoing **OPPOSER'S MOTION TO COMPEL DISCOVERY RESPONSES** was sent via U.S. mail postage prepaid to:

Ned Ardagna, Esq.  
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Paul M. Higgins