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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.

12-24-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #72

Opposition No.: 91150888

**OPPOSER'S OPPOSITION TO APPLICANT'S MOTION  
FOR JUDGMENT ON THE PLEADINGS**

Opposer, Numico Financial Services, S.A. ("Opposer"), hereby opposes Applicant, Dr. Joel D. Wallach's ("Applicant") Motion for Judgment on the Pleadings ("Motion for Judgment"), as barred by 37 CFR § 2.120(e)(2). Opposer requests that Applicant's Motion for Judgment be denied.

**INTRODUCTION**

On December 12, 2002, Applicant mailed its Motion for Judgment to the TTAB and Opposer's counsel seeking judgment on the pleadings based solely on the argument that Opposer has failed to produce any testimony during the testimony period, and the case should thus be dismissed under 37 C.F.R. § 2.132. Noticeably absent from the Applicant's Motion, however, is the fact that on November 1, 2002, prior to the commencement of the first testimony period, Opposer timely filed a Motion to Compel discovery from Applicant, which requires suspension

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of the proceeding including all deadlines herein. See Ex. A. Moreover, Applicant's Motion for Judgment also fails to mention that Opposer's Motion to Compel requested that all deadlines in this case, including the testimony period, be extended for sixty days after a ruling on the Motion, **and** that Applicant has failed to oppose or respond to Opposer's Motion to Compel. For all these reasons, Applicant's Motion for Judgment should be denied.

### **ARGUMENT**

According to the scheduling order in this case, the first testimony period was to commence on November 10, 2002. See Ex. B. Under 37 C.F.R. § 2.120(e)(2):

When a party files a motion for an order to compel discovery, the case **will** be suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion, and no party should file any paper which is not germane to the motion, except as otherwise specified in the Board's suspension order. The filing of a motion to compel shall not toll the time for a party to respond to any outstanding discovery request or to appear for any notice discovery deposition. [Emphasis added].

A motion to compel is timely if it is "filed prior to the commencement of the first testimony period as originally set or reset." 37 C.F.R. § 2.120(e)(1).

In the instant case, Opposer filed its Motion to Compel on November 1, 2002, well before the commencement of the first testimony period. Therefore, § 2.120(e)(2) requires that this proceeding be suspended, retroactively effective to November 1, 2002.

Despite this well-established TTAB procedure, on December 12, 2002, Applicant filed its Motion for Judgment- in direct violation of the plain and unequivocal language of § 2.120(e)(2). Accordingly, Opposer respectfully requests that the Applicant's Motion for Judgment be denied.

Applicant's Motion for Judgment is also improper given Applicant's failure to oppose or respond to Opposer's request for an sixty day extension of all the deadlines in this case, including the testimony period. This request was made in Opposer's Motion to Compel, which is uncontested.<sup>1</sup>

In sum, it is improper for the Applicant to base its Motion for Judgment on the failure of Opposer to take actions that Opposer is prohibited from doing under the applicable Trademark Rules, namely, entering evidence during the testimony period after the timely filing of a motion to compel. It is also improper for Applicant to file its motion without any mention of a pending uncontested request for an extension of all the deadlines in this case, including the testimony period.

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<sup>1</sup> Although the Applicant did provide some additional supplemental discovery in response to the filing of Opposer's Motion to Compel, Applicant has still failed to provide full and complete responses to Opposer's First Set of Requests for Production of Documents and First Set of Interrogatories. Opposer is continuing to undertake efforts to obtain Applicant's full and complete discovery responses.

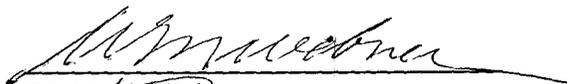
**CONCLUSION**

For all the above-stated reasons, Opposer respectfully requests that the Board deny Applicant's Motion for Judgment.

Respectfully submitted,

NUMICO FINANCIAL SERVICES, S.A.

By:



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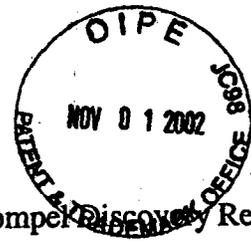
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Opposition No.: 91150888  
Serial No.: 76/274,080



Paper Filed:

1. Opposer's Motion to Compel Discovery Responses

**DOCKET NO.: 500-171  
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NUMICO FINANCIAL SERVICES, S.A.

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DR. JOEL D. WALLACH

Applicant.

Opposition No.: 91150888

**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

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.

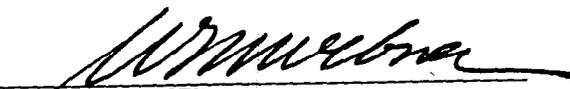
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<sup>1</sup> Opposer mailed documents responsive to Applicant’s request for production directly to Applicant’s counsel along with individual responses to the individual requests. Therefore, unlike Opposer, Applicant was not forced to wait for a document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

W. Mack Webner  
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Date: November 1, 2002



**B**

UNITED STATES DEPARTMENT OF  
COMMERCE  
Patent and Trademark Office  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Mailed: February 23, 2002

Opposition No 91150888  
Serial No. 76274080

OSTEO-FX  
4045 BONITA RD STE 206  
BONITA, CA 91902-1336

Rexall Sundown, Inc.

v.

Wallach, Joel, D. Dr.

KENNETH STRICK  
NUMICO FINANCIAL SERVICES, S.A.  
611 BROKEN SOUND PARKWAY, NW  
BACA RATON, FL 33487

SANDRA THOMPSON, LEGAL ASSISTANT

A notice of opposition to the registration sought in the above-identified application has been filed. A copy of the notice is attached.

**ANSWER IS DUE FORTY DAYS** after the mailing date hereof.  
(See Patent and Trademark Rule 1.7 for expiration date falling on Saturday, Sunday or a holiday).

Proceedings will be conducted in accordance with the Trademark Rules of Practice, set forth in Title 37, part 2, of the Code of Federal Regulations. The parties are reminded of the recent amendments to the Trademark Rules that became effective October 9, 1998. See Notice of Final Rulemaking published in the *Official Gazette* on September 29, 1998 at 1214 TMOG 145. Slight corrections to the rules, resulting in a correction notice, were published in the *Official Gazette* on October 20, 1998 at 1215 TMOG 64. A copy of the recent amendments to the Trademark Rules, as

well as the *Trademark Trial and Appeal Board Manual of Procedure* (TBMP), is available at <http://www.uspto.gov>.

**Discovery and testimony periods are set as follows:**

Discovery period to open:	<b>March 15, 2002</b>
Discovery period to close:	<b>September 11, 2002</b>
30-day testimony period for party in position of plaintiff to close:	<b>December 10, 2002</b>
30-day testimony period for party in position of defendant to close:	<b>February 8, 2003</b>
15-day rebuttal testimony period for plaintiff to close:	<b>March 25, 2003</b>

A party must serve on the adverse party a copy of the transcript of any testimony taken during the party's testimony period, together with copies of documentary exhibits, within 30 days after completion of the taking of such testimony. See Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

**NOTE:** The Board allows parties to utilize telephone conferences to discuss or resolve many interlocutory matters that arise in inter partes cases. See the *Official Gazette* notice titled "Permanent Expansion of Telephone Conferencing on Interlocutory Matters in Inter Partes Cases Before the Trademark Trial and Appeal Board," 1235 TMOG 68 (June 20, 2000). A hard copy of the *Official Gazette* containing this notice is available for a fee from the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402 (Telephone (202) 512-1800). The notice is also available at <http://www.uspto.gov>. Interlocutory matters which the Board agrees to discuss or decide by phone conference may be decided adversely to any party which fails to participate.

If the parties to this proceeding are also parties to other Board proceedings involving related marks or, during the

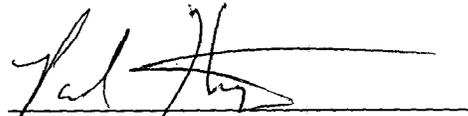
pendency of this proceeding, they become parties to such proceedings, they should notify the Board immediately, so that the Board can consider consolidation of proceedings.



**CERTIFICATE OF SERVICE**

I, Paul M. Higgins, Esq., hereby certify that on December 24, 2002 a true copy of the foregoing **OPPOSER'S OPPOSITION TO APPLICANT'S MOTION FOR JUDGMENT ON THE PLEADINGS** was sent via U.S. mail postage prepaid to:

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

  
Paul M. Higgins