

TTAB

**WILLKIE FARR & GALLAGHER LLP**

WILLIAM M. RIED  
212 728 8729  
wried@willkie.com

787 Seventh Avenue  
New York, NY 10019-6099  
Tel: 212 728 8000  
Fax: 212 728 8111

November 20, 2003



**VIA FACSIMILE - 703-308-9333**  
**CONFIRMATION VIA FIRST-CLASS MAIL**

11-24-2003  
U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

Trademark Trial and Appeal Board  
BOX TTAB, NO FEE  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3514

Re: Consolidated Opposition No.: 91/153,578  
Serial Nos. 76/074,595 and 76/075,729  
Opposer's Motion to Compel/Preclude filed November 12, 2003

Dear Sir or Madam:

On November 12, 2003, Opposer, UGO Networks Inc. ("Opposer"), filed a motion in the captioned action to compel discovery or to preclude the introduction of withheld evidence by applicant, Konami Corporation ("Applicant"), as well as to stay discovery and reset the discovery deadline and other dates after a decision on this motion.

Applicant subsequently served supplemental objections and answers to Opposer's interrogatories, request for production and request for admissions, and produced additional documents. The following is an analysis of the five points of Opposer's Memorandum of Points and Authorities, dated November 12, 2003, and the effect, if any, of Applicant's supplemental responses on these points:

**Point I: Applicant Should be Compelled to Disclose the Identity of Relevant Fact Witnesses**

In its supplemental production, Applicant identified relevant fact witnesses in response to Opposer's Interrogatories 2, 3 and 8.<sup>1</sup> However, Applicant has advised that many of its employees are located in Japan and will not be produced in the United States for depositions. Applicant has also stated that it might consider producing witnesses from Applicant's US subsidiary who are based in California. Instructions accompanying Opposer's interrogatories explained that a request for the identity of a witness asks for "his/her full name and last known address." Applicant has not supplied this information, and Opposer renews its motion to compel production of this information.

As to Interrogatory 1, asking Applicant to identify each person with knowledge concerning Applicant's use of Applicant's Mark, Applicant's supplemental response was:

Applicant objects to this interrogatory on the basis the information sought is within the custody or control of third-persons over whom Applicant does not exercise control.

While third parties may have knowledge of Applicant's use of its mark in Commerce and the first use of Applicant's Mark, this interrogatory inquires into *Applicant's knowledge* of witnesses, not whether Applicant controls these witnesses. Opposer thus renews its motion to compel a complete response to Interrogatory 1.

As to Interrogatory 14, Opposer asked for the identity of persons involved in advertising and promoting goods under Applicant's Mark, with the nature and dates of such service. Applicant's supplemental response was:

Subject to the objections in its original response, the following entities have rendered services on Applicant's behalf in connection with the advertising and promotion of Applicant's products: Vendor Help Impact, Shounen-Jump (Viz Communications), Mattel, 4 Kids Entertainment, Kids WB, Department X and Freelance Designer.

Again, this information is incomplete. Applicant was instructed to identify an entity by giving its full name and the address of its principal place of business. In addition, the interrogatory asked for a description of the nature and dates of service provided by each entity. Applicant has supplied none of this information. Opposer thus renews its motion to compel production of this information.

---

<sup>1</sup> Supplemental Response to Interrogatory 2 - Subject to the foregoing objections, Applicant states that Yukio Kobayashi, Manager of Konami Corporation's Trademark Group, participated in activities relating to preparing, filing and/o prosecuting the application to register Applicant's Mark.  
Supplemental Response to Interrogatory 3 - Applicant objects to this interrogatory on the basis that the information sought within the custody or control of third-persons over whom Applicant does not exercise control. Subject to the foregoing objections, Applicant states Yukio Kobayashi, Manager of Konami Corporation's Trademark Group, participated in activities relating to the consideration, selection and adoption of Applicant's Mark.  
Supplemental Response to Interrogatory 8 - a. Linda Stackpoole, manufacturing; Dennis Lee and Monique Catley, production and packaging; b. Dennis Lee, Rich Naylor, Chris Garske, Tammy Schachter. c. Catherine Fowler, Brad Robinson, Matt Robinson, Daniel Castillo and Jean Chung.

Applicant did not supplement its response to Interrogatory 35, asking Applicant to identify persons who furnished information regarding Applicant's answers to the interrogatories.

**Point II: Applicant Should be Compelled to Disclose and Discussions of Opposer's Mark**

Applicant's supplemental response to Interrogatory 21 was:

Subject to the objections included in its original response above, Applicant states that Konami of America, Inc. first learned of Opposer's use of Opposer's Mark on December 26, 2002, via internal e-mail correspondence of the same date.

This contradicts Applicant's supplemental response to Request for Admission 4, which stated:

Denied as to Konami Corporation Japan. Admit that Konami of America, Inc. had some awareness of Opposer's use of Opposer's Mark at some point and time prior to June 2000, and otherwise deny request no. 4.

In addition, Applicant has ignored the instructions to identify a document by "its date, author(s) and the identity of its present location and present custodians." In its supplemental response to Document Request 37, Applicant advised that it would produce documents previously withheld that relate to the date and circumstances under which Applicant first learned of Opposer's use of Opposer's Mark; however, its response did not specifically identify any documents. Opposer has searched through Applicant's document production without locating any emails on this subject and renews its motion to compel the requested information and documents.

**Point III: Applicant Should be Compelled to Disclose Applicant's Enforcement Efforts**

In Interrogatory 19 (incorrectly labeled 21 in Opposer's brief, p. 7, n. 11), Opposer asked for details of Applicant's efforts to enforce its rights in Applicant's Mark. Applicant did not supplement its response, which had provided no information. Applicant did supplement its response to the related Document Request 17, stating that it would produce previously withheld documents, but did not identify any such documents. Opposer has been able to identify few documents responsive to this request and renews its motion to compel a complete response to Interrogatory 19.

**Point IV: Applicant Should be Compelled to Disclose Licenses Under Applicant's Marks**

It is apparent that Applicant has licensed a number of entities to market goods under Applicant's Mark. However, neither Applicant's initial nor its supplemental response to Interrogatory 18 supplied the requested details of such licenses. Applicant's supplemental response was:

Subject to the foregoing objections, Applicant will produce relevant confidential documents responsive to this interrogatory pursuant to Rule 33(d), Fed. R. Civ. P. and TBMP §407.02, in response to Opposer's request for production no. 43.

Applicant's supplemental response to Document Request 43 (reflecting Applicant's acquisition of rights to Applicant's Mark from another entity) and Document Request 45 (requesting copies of

agreements concerning Applicant's Mark) was the same: Applicant agreed to produce previously withheld documents but identified no documents. In its supplemental production, Applicant did produce certain documents describing its minimum advertising price policy in connection with various products, but it did not produce the requested licenses. Opposer thus renews its motion to compel production of such licenses.

**Point V: Applicant Should be Compelled to Disclose Facts Supporting Applicant's Affirmative Defenses or be Precluded from Offering Evidence of Such Facts**

Applicant did not supplement its responses to Opposer's discovery requests concerning Applicant's affirmative defenses. Opposer thus renews its motion to compel production of such evidence or to preclude Applicant from offering such evidence in this proceeding.

Please let us know if any of this information is unclear or if other explanations or documentation would be helpful to the Board.

Respectfully,

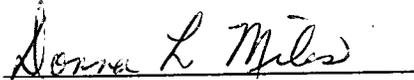


William M. Ried  
Natasha Snitkovsky

cc: Jeffrey H. Kaufman, Esq.

**Certificate of Mailing**

I hereby certify that the attached letter was sent to the addressee by Facsimile and deposited with the United States Postal Service via First-Class Mail, postage prepaid, addressed to the Trademark Trial and Appeal Board, Box TTAB, No Fee, Commissioner of Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514, on November 21, 2003.

  
\_\_\_\_\_  
Donna L. Miles

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing letter was served on counsel for Applicant, this 21<sup>st</sup> day of November 2003, by sending same via First-Class Mail, postage prepaid, to:

**Jeffrey H. Kaufman, Esq.  
OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.  
1940 Duke Street  
Alexandria, Virginia 22314**

  
\_\_\_\_\_  
Donna L. Miles