



Pursuant to 37 CFR 2.127(a), Applicant's brief in opposition, if any, shall be filed within fifteen (15) days from the date of service of this motion unless this time is extended by the Board.

Dated: New York, New York  
November 12, 2003

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**CERTIFICATE OF SERVICE**

I certify that a copy of the foregoing OPPOSER'S MOTION TO COMPEL AND TO PRECLUDE was served on counsel for Applicant, this 12<sup>th</sup> day of November 2003, by sending same via First Class Mail, postage prepaid, to:

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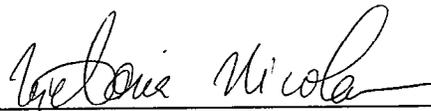


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\_\_\_\_\_  
Victoria Nicolau

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

\_\_\_\_\_  
UGO NETWORKS, INC.,

Opposer,

v.

KONAMI CORPORATION,

Applicant.  
\_\_\_\_\_

Consolidated Opposition No. 91/153,578  
Serial Nos.: 76/074,595 and 76/075,729

\_\_\_\_\_  
  
11-12-2003

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**OPPOSER'S MEMORANDUM OF POINTS AND AUTHORITIES  
IN SUPPORT OF MOTION TO COMPEL AND TO PRECLUDE**

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## PRELIMINARY STATEMENT

Opposer, UGO NETWORKS, INC. ("Opposer"), submits this memorandum of points and authorities in support of its motion to compel proper responses by Applicant, KONAMI CORPORATION ("Applicant"), to Opposer's discovery requests or, alternatively, to preclude Applicant from offering evidence on the matters withheld. As stated in the accompanying statement under 37 C.F.R. 2.120, Opposer has made unsuccessful, good faith attempts to resolve the instant issues without the intervention of this Board.

## BACKGROUND

On January 29, 2003, Opposer served upon Applicant: (i) Opposer's First Set of Interrogatories (the "Interrogatories"); (ii) Opposer's First Request for Production (the "Request for Production"); and (iii) Opposer's First Request for Admissions (the "Request for Admissions").<sup>1</sup> After obtaining from Opposer several extensions of time to respond, on April 25, 2003, Applicant served: (i) Applicant's Objections and Answers to Opposer's First Set of Interrogatories (the "Interrogatory Responses"); (ii) Applicant's Objections and Responses to Opposer's First Request for Production (the "Document Responses") and (iii) Applicant's Objections and Responses to Opposer's First Request for Admissions (the "Admission Responses").<sup>2</sup>

Applicant's discovery responses call into question Applicant's credibility.<sup>3</sup> Further,

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<sup>1</sup> See Declaration of Natasha Snitkovsky, dated November 12, 2003 ("Snitkovsky Dec.") at ¶ 7.

<sup>2</sup> See *Id.* at ¶ 9.

<sup>3</sup> For example, Applicant refused to identify the goods sold under Applicant's Mark (Interrogatory Response 6) or licenses concerning Applicant's Mark (Interrogatory Response 18), but denied that it markets video game software (Admission Response 11) or computer games (Admission Response 12) under Applicant's Mark. Yet, video game software and computer games clearly are marketed in Commerce under Applicant's Mark. See Snitkovsky Dec. at ¶ 10.

Applicant has served deliberately vague responses<sup>4</sup> and refused to identify documents and supply information essential to the opposition.<sup>5</sup> For example, Applicant stated repeatedly that it could not supply or complete responses because its investigation was ongoing<sup>6</sup> and that it would produce additional responses or documents upon entry of a protective order.<sup>7</sup> Yet, more than seven months after serving its initial responses and five weeks after entry of a protective order in this matter, Applicant has still produced no supplemental information or documents.

Applicant's conduct of discovery has forced Opposer to move to compel further production or to preclude the later introduction of evidence presently withheld.

## ARGUMENT

### POINT I

#### **Applicant Should Be Compelled to Disclose the Identity of Relevant Fact Witnesses**

The names of Applicant's employees who are knowledgeable about Applicant's business are relevant and discoverable. *Bahlsen K.G. v. Mother's Cake & Cookie Co.*, 1996 TTAB LEXIS 482, 5 (TTAB 1996). Applicant is not entitled to withhold the identity of persons with

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<sup>4</sup> For example, in response to a request for minutes of meetings attended by Applicant at which Applicant's Mark or Opposer's Mark were discussed, Applicant responded, *seriatim*, that: (i) the request called for privileged documents (although Applicant identified none); (ii) the request was "overly broad, harassing and unduly burdensome"; (iii) Applicant "will provide only those documents which are sufficient to meet the needs of this request"; (iv) the request called for confidential documents, which would be produced after entry of a protective order (though none were so produced after entry of a protective order on October 7, 2003, see Snitkovsky Dec. at ¶ 9(e)); and (v) the request sought documents publicly available and...therefore as readily accessible to Opposer as it is to Applicant." (Document Response 21).

<sup>5</sup> For example, Applicant refused to supply any substantive response when asked to identify the channels of commerce through which it markets goods under Applicant's Mark (Interrogatory Response 6; Document Response 20).

<sup>6</sup> See Snitkovsky Dec. at ¶ 9(d) (Interrogatory Responses 4, 5, 14 and 21 and Document Response 37).

<sup>7</sup> See Snitkovsky Dec. at ¶ 9(e) (Interrogatory Responses 1-3, 8,9,14-21, 24 and 25 and Document Responses 1-5, 7, 17, 18, 20-23, 41, 42 and 46).

knowledge of the facts at issue on the basis of a vague claim of privilege or undue burden without specifically delineating why the privilege applies, or without making specific factual allegations to support its claim as to burden. See *Bristol-Meyers Squibb Co. v. Rhone-Poulenc Rorer Inc.*, 44 USPQ 2d 1463 (SDNY 1997); *Flanagan v. Travelers Ins. Co.*, 111 FRD 42 (WDNY 1986). Parties are entitled to discovery of "the identity and location of persons having knowledge of any discoverable matter." Fed. R. Civ. P. 26(b)(1); *Lloyd v. Cessna Aircraft Co.*, 434 F.Supp. 4, 8 (ED Tenn. 1976).

In an effort to identify witnesses for possible discovery depositions,<sup>8</sup> Opposer requested information identifying possible fact witnesses. For example, Opposer asked for the identity of persons who participated in the selection, clearance and adoption of Applicant's Mark. (Interrogatory No. 3). Such persons could have knowledge relevant to Applicant's bad faith in adopting Applicant's Mark with knowledge that it conflicts with Opposer's prior marks. Yet, Applicant responded only with general objections and trade secret claims,<sup>9</sup> and thus failed to state

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<sup>8</sup> The current discovery cutoff is December 30, 2003. Because of Applicant's refusal to provide meaningful discovery, Applicant has moved to stay these proceedings and extend Opposer the close of discovery pending resolution of this motion.

<sup>9</sup> INTERROGATORY NO. 1: Identify each person with knowledge concerning Applicant's use (past, current or planned) of Applicant's Mark in Commerce, including the first use in Commerce of Applicant's Mark.

RESPONSE: Applicant objects to this interrogatory on the basis that it is vague and ambiguous. Applicant objects to this objection as overly broad, harassing and unduly burdensome. To the extent not otherwise objected to, Applicant will provide only that information which is sufficient to meet the needs of the Interrogatory. Applicant objects to this interrogatory on the grounds that it seeks the production of trade secret or other confidential research, development or commercial information within the meaning of Rule 26(c)(7), Fed. R. Civ. P. To the extent not otherwise objected to, Applicant will produce representative, responsive, confidential information only after the entry of a suitable protective order by the Board.

INTERROGATORY NO. 2: Identify each person who participated, in any fashion or capacity, in preparing, filing and/or prosecuting any application to register Applicant's Mark.

INTERROGATORY NO. 3: Identify each person who participated, in any fashion or capacity, in the consideration, selection and adoption of Applicant's Mark and in conducting any search or investigation by or on behalf of Applicant concerning Applicant's Mark including, but not limited to, any search or investigation of the records at the

its objections with the required particularity.

Interrogatories are not burdensome or harassing where information is in the possession or knowledge of defendants, and defendants would be required to compile the information anyway, in their own preparation for trial. *U.S. v. Nysco Laboratories, Inc.*, 26 FRD 159 (SDNY 1960). The information sought by Opposer regarding fact witnesses will likely be compiled by Applicant in the preparation of its own case. Therefore, Opposer's interrogatories and requests are not, by definition of law, overly burdensome or harassing. In any event, it clearly would not be a burden for Applicant to reveal who, for instance, has knowledge of the first use of Applicant's Mark (Interrogatory No. 1), participated in the preparation of the instant applications (Interrogatory No. 2) or is responsible for marketing goods under Applicant's Mark (Interrogatory No. 8).

Applicant should be compelled to respond to Opposer's requests for an identification of relevant fact witnesses.

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United States Patent and Trademark Office or state corporation or trademark records or domain name registration records.

**INTERROGATORY NO. 8:** In connection with each product or service identified in response to Interrogatory No. 6, identify all person(s) who are or have been responsible for:

- a. manufacture or production;
- b. marketing, advertising and promotion; and
- c. sale.

**INTERROGATORY NO. 14:** Identify each entity that has rendered services on Applicant's behalf in connection with the advertising or promotion of products or services sold or offered for sale under Applicant's Mark and, for each such entity, describe the nature and dates of such service.

**INTERROGATORY NO. 35:** With respect to each interrogatory herein, identify the person or persons who furnished information regarding the answers given.

**RESPONSES:** Applicant objects to this objection as overly broad, harassing and unduly burdensome. To the extent not otherwise objected to, Applicant will provide only that information which is sufficient to meet the needs of the Interrogatory. Applicant objects to this interrogatory on the grounds that it seeks the production of the trade secret or other confidential research, development or commercial information within the meaning of Rule 26(c)(7), Fed. R. Civ. P. To the extent not otherwise objected to, Applicant will produce representative, responsive, confidential information only after the entry of a suitable protective order by the Board.

## POINT II

### **Applicant Should be Compelled to Disclose Knowledge and Discussions of Opposer's Mark**

The purpose of discovery is to provide information which may aid a party in the preparation of its own case or in the cross-examination of its adversary's witnesses. It is unfair for a party to... refuse to answer interrogatories posed by its adversary or, as appears to be the case here, fail to make a complete investigation to locate the information.

*Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ 2d 1718, 1720 (TTAB 1987).

A failure to produce documents in response to discovery requests "because no thorough investigation was made initially" thus has been held as a basis to exclude such material from evidence. *Id.* at 1720-1721. The Board has made clear:

If proper discoverable matter is withheld from the requesting party, the responding party will be precluded from relying on such information and from producing testimony with regard thereto during its testimony.

*Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ 2d 1671, 1677 (TTAB 1989). *Yves Saint Laurent Fashion, B.V. v. Y&S Handbags*, 2002 TTAB LEXIS 375, 7 (TTAB 2002).

Clearly, Applicant's knowledge of Opposer's marks is relevant to issues of priority and likelihood of confusion; the Board has found that information regarding when an applicant first became aware of an opposer's marks and what steps, if any, the applicant took thereafter as a result of this knowledge, is discoverable. *No Fear, Inc. v. James G. Beneventi*, 2000 TTAB LEXIS 194 (TTAB 2000).

However, Applicant has failed substantively to respond to such inquiries and instead has

responded only with general objections and claims of privilege.<sup>10</sup>

Applicant's responses to requests relevant to its first knowledge of Opposer's mark are evasive and intended to frustrate discovery. Applicant should be compelled to respond to discovery requests concerning its knowledge of Opposer's marks.

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<sup>10</sup> INTERROGATORY NO. 21: Describe the date and circumstances under which Applicant first learned of Opposer's use of Opposer's Mark and identify each document reflecting or referring or relating to such notice.

RESPONSE: Applicant objects to this interrogatory to the extent that it calls for the production of attorney-client communications or information subject to the attorney work-product doctrine. Such information will not be produced. Applicant objects to this objection as overly broad, harassing and unduly burdensome. To the extent not otherwise objected to, Applicant will provide only that information which is sufficient to meet the needs of the Interrogatory. Applicant objects to this interrogatory on the grounds that it seeks the production of trade secret or other confidential research, development or commercial information within the meaning of Rule 26(c)(7), Fed. R. Civ. P. To the extent not otherwise objected to, Applicant will produce representative, responsive, confidential information only after the entry of a suitable protective order by the Board. Without waiving the foregoing objections, Applicant refers to its responses to Request No. 4 of Opposer's First Request for Admissions. Investigation of this matter is ongoing. Applicant reserves the right to supplement its answer to this interrogatory should the investigation reveal relevant, non-privileged information.

DOCUMENT REQUEST NO. 17: All documents reflecting or referring to communications between Applicant and any entity regarding use by a third party by any mark allegedly identical or similar to Applicant's Mark or the term "YU-GI-OH."

RESPONSE: Applicant objects to this request to the extent that it calls for the production of attorney-client communications or materials subject to the attorney work-product doctrine. Such materials will not be produced. Applicant objects to this request as calling for the production of trade secret or other confidential research, development or commercial information. To the extent not otherwise objected to, Applicant will produce representative, responsive, confidential documents only after the entry of a suitable protective order by the Board. Subject to an without waiver of the foregoing objections, Applicant will produce non-privileged, non-confidential documents that are responsive to this request.

DOCUMENT REQUEST 21: Minutes and notes from any meeting of Applicant or attended by Applicant referring to Applicant's Mark and/or Opposer's Mark.

RESPONSE: Applicant objects to this request to the extent that it calls for the production of attorney-client communications or materials subject to the attorney work-product doctrine. Such materials will not be produced. Applicant objects to this request as overly broad, harassing and unduly burdensome. To the extent not otherwise objected to, Applicant will provide only those documents which are sufficient to meet the needs of the request. Applicant objects to this request as calling for the production of trade secret or other confidential research, development or commercial information. To the extent not otherwise objected to, Applicant will produce representative, responsive, confidential documents only after the entry of a suitable protective order by the Board. Applicant objects to this request on the basis that the information sought is publicly available and is therefore as readily accessible to Opposer as it is to Applicant.

### POINT III

#### **Applicant Should be Compelled to Disclose Applicant's Enforcement Efforts**

The Board has held that information regarding litigation between a party and third parties is relevant and discoverable. *Johnston Pump/General Valve, Inc. v. Chromalloy American Corporation*, 10 USPQ 2d 1671, 1675 (TTAB 1988); *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193 (TTAB 1976); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167 (TTAB 1975).

Opposer requested information regarding Applicant's enforcement efforts relating to Applicant's Mark. Applicant responded with its standard boilerplate objections and claims of privilege and, additionally, asserted that it would produce the request information and materials upon entry of a suitable protective order.<sup>11</sup> However, although a protective order was entered on

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<sup>11</sup> INTERROGATORY NO. 21: If Applicant has ever objected to any entity's use or registration of any trade name, trademark, service mark or descriptive term on the basis of Applicant's Mark, summarize the substance of each such objection and the resolution of the objection.

RESPONSE: Applicant objects to this interrogatory to the extent that it calls for the production of attorney-client communications or information subject to the attorney work-product doctrine. Such information will be produced. Applicant objects to this interrogatory on the grounds that it seeks the production of trade secret or other confidential research, development or commercial information within the meaning of Rule 26(c)(7), Fed. R. Civ. P. To the extent not otherwise objected to, Applicant will produce representative, responsive, confidential documents only after the entry of a suitable protective order by the Board. Subject to and without waiving the foregoing objections, Applicant states that it objected to a number of applications for federal trademark registration filed by Syconet.com incorporating the term YUGI-OH. The Syconet.com applications that were the subject of Applicant's objections were subsequently abandoned.

DOCUMENT REQUEST 17: All documents reflecting or referring or relating to communications between Applicant and any entity regarding use by a third party of any mark allegedly identical or similar to Applicant's Mark or the term "YU-GI-OH."

RESPONSE: Applicant objects to this request to the extent that it calls for the production of attorney-client communications or materials subject to the attorney work-product doctrine. Such materials will not be produced. Applicant objects to this request as calling for the production of trade secret or other confidential research, development or commercial information. To the extent not otherwise objected to, Applicant will produce representative, responsive, confidential documents only after the entry of a suitable

October 7, 2003, Applicant has not to date provided the requested information or materials.

In addition, the standard common law definition of the attorney-client privilege is as follows:

(1) Where legal advice of any kind is sought, (2) from a professional legal advisor in his capacity as such, (3) the communications relating to that purpose, (4) made in confidence, (5) by the client, (6) are at his instance permanently protected, (7) from disclosure by himself or by the legal advisor, (8) except if their protection be waived.

8 Wigmore, EVIDENCE §2292, at 554 (McNaughton Rev. 1961).

The attorney-work product doctrine, as outlined in Fed.R.Civ.Pro. 26(b)(3), provides that documents and things otherwise discoverable "prepared in anticipation of litigation or for trial by or for another party or by or for that party's representative" need be produced "only upon a showing that the party seeking discovery has substantial need of the material in the preparation of the party's case and that the party is unable without undue hardship to obtain the substantial equivalent of the materials by other means." Fed.R.Civ.Pro. 26(b)(3). Thus, this privilege is not absolute and may be pierced where the sought-after document or information is essential to the preparation of the discoverer's case and cannot be obtained by other means or can only be so obtained with great difficulty. *See, e.g., United States v. Lipshy*, 492 F. Supp. 35 (N.D. Tex. 1979), 492 F. Supp. 35 (N.D. Tex. 1979). In addition, the Board has held that:

Any claim that otherwise responsive documents are privileged requires a particular particularized expression of the privilege relied on, and a description of the documents which, without revealing the privileged information, is sufficient to allow the inquiring party to assess the applicability of the privilege.

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protective order by the Board. Subject to and without waiver of the foregoing objections, Applicant will produce non-privileged, non-confidential documents that are responsive to this request.

*No Fear, Inc. v. Ruede D. Rule*, 54 USPQ 2d 1551, 1556 (TTAB 2000), (citing A. Wright, Miller & Marcus, Federal Practice and Procedure: Civil §2213 (2d ed. 1994)). The burden of demonstrating the applicability of privilege rests on the party who invokes it. See, e.g., *Hodges, Grant & Kaufman v. United States*, 768 F.2d 719, 721 n.7 (5th Cir. 1985), 768 F.2d 719, 721 n.7 (5th Cir. 1985). Moreover, because a blanket claim of privilege is not acceptable, each objection must be separately identified. See, e.g., *United States v. Keplinger*, 776 F.2d 678, 700 n.13 (7th Cir. 1985), cert. denied, 106 S.Ct. 2919 (1986).

Moreover, Opposer made Applicant aware of its obligation to specify its claims of privilege.

For example, Opposer's Request for Production including the following instruction:

L. If Applicant claims attorney-client privilege or any other privilege in reference to any request for production, the allegedly privileged document need not be produced, but Applicant shall state with respect to such document sufficient information to explain the claim or privilege and permit the adjudication of the propriety of that claim, including the following information (i) the date of the document; (ii) a description of the subject matter of the document; and (iii) the name(s) and address(es) of each person who has prepared, received and/or had possession, custody or control of the document or a copy thereof.

Request for Production at 4. See *Snitkovsky Dec.* at ¶7. It is well established that the existence of privileged documents must be revealed in responding to interrogatories that call for their identification, even if production of the documents themselves would be excused because of privilege. See *Goodyear Tire & Rubber Co. v. Tyrco Industries*, 186 USPQ 207, 208 (TTAB 1975); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ at 171.

Yet, while Applicant stated blanket privilege objections 28 times in its Interrogatory Response and its Document Response (see *Snitkovsky Dec.* at ¶9), Applicant ignored its obligations under the Federal Rules and rejected Opposer's instructions that it specifically identify purportedly

privileged information and documents.

Applicant should be directed to provide a privilege log of all information and documents it refuses to produce on the grounds of privilege.

#### **POINT IV**

##### **Applicant Should be Compelled to Disclose Licenses of Applicant's Mark**

Discovery questions concerning license agreements and arrangements between Applicant and third parties concerning Applicant's Mark are proper subjects of discovery and should be answered. *See, e.g., Johnston Pump/General Valve, Inc.*, 10 USPQ 2d 1671; *Neville Chemical Co. v. The Lubrizol Corp.*, 183 USPQ 184 (TTAB 1974).

However, Applicant has refused to produce any such evidence in response to Opposer's requests.<sup>12</sup>

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<sup>12</sup> **INTERROGATORY NO. 9:** If Applicant claims to have acquired the right to use or register Applicant's Mark from any other entity, identify:

- a. each such entity;
- b. the date of such acquisition; and
- c. each and every document reflecting, referring to or relating to such acquisition.

**RESPONSE:** Applicant objects to this interrogatory on the grounds that it seeks the production of trade secret or other confidential research, development or commercial information within the meaning of Rule 26(c)(7), Fed. R. Civ. P. To the extent not otherwise objected to, Applicant will produce representative, responsive, confidential information only after the entry of a suitable protective order by the Board. Investigation of this matter is ongoing. Applicant reserves the right to supplement its answer to this interrogatory should the investigation reveal relevant, non-privileged information.

Applicant should be compelled to respond to discovery requests concerning licenses of Applicant's Mark.

In addition, a party responding to discovery responses must respond to each request. It is thus improper to respond that "'responsive documents, if any,' will be produced." *No Fear, Inc. v. Rule*, 54 USPQ 2d at 1555.

In its Interrogatory Response and its Document Response, Applicant twenty-one times

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INTERROGATORY NO. 18: If Applicant has ever entered an agreement or other understanding, written or oral (including, but not limited to, licenses and agency, distributorship and joint venture agreements), with any entity concerning use of Applicant's Mark or goods or services sold or provided thereunder:

- a. identify the date of the agreement or understanding;
- b. identify the parties to the agreement or understanding;
- c. identify all persons who were involved with the negotiation or approval of such agreement or understanding;
- d. detail the quality control actually exercised under the agreement or understanding and the person(s) responsible therefore; and
- e. identify each and every document reflecting, referring or relating to such agreement, undertaking or understanding.

RESPONSE: Applicant objects to this interrogatory on the basis that it is vague and ambiguous. Applicant objects to this objection [*sic*] as overly broad, harassing and unduly burdensome. To the extent not otherwise objected to, Applicant will provide only that information which is sufficient to meet the needs of the Interrogatory. Applicant objects to this interrogatory on the grounds that it seeks the production of trade secret or other confidential research, development or commercial information within the meaning of Rule 26(c)(7), Fed. R. Civ. P. To the extent not otherwise objected to, Applicant will produce representative, responsive, confidential information only after the entry of a suitable protective order by the Board.

DOCUMENT REQUEST NO. 43: All documents reflecting, referring to or relating to Applicant's acquisition of the right to use or register Applicant's Mark from another entity.

DOCUMENT REQUEST NO. 45: All agreements or other indicia of understanding (including, but not limited to, licenses and agency, distributorship and joint venture agreements) with any entity concerning use of Applicant's Mark or to any plans by Applicant to consider or commence licensing or other exploitation by third parties of Applicant's Mark.

RESPONSES: Applicant objects to this request to the extent that it calls for the production of attorney-client communications or materials subject to the attorney work-product doctrine. Such materials will not be produced. Applicant objects to this request as calling for the production of trade secret or other confidential research, development or commercial information within the meaning of Rule 26(c)(7), Fed. R. Civ. P. To the extent not otherwise objected to, Applicant will produce representative, responsive, confidential information only after the entry of a suitable protective order by the Board.

made the statement: "To the extent not otherwise objected to, Applicant will provide only that information which is sufficient to meet the needs of the Interrogatory/Request."<sup>13</sup> Applicant should be required to amend its response to delete this statement.

## POINT V

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

The purpose of discovery is to provide information which may aid a party in preparation of its case or in the cross-examination of its adversary's witnesses. *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ 2d at 1720. Applicant thus must present evidence to support its affirmative defenses in this proceeding and Opposer is entitled to discover facts or documents Applicant intends to submit on these matters. However, Applicant has refused to produce any such evidence.<sup>14</sup>

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<sup>13</sup> See Snitkovsky Dec. at ¶9 (Interrogatory Responses 1, 2, 21, 35; Document Responses 1-7, 10, 16, 18, 20-23, 40, 41 and 46).

<sup>14</sup> INTERROGATORY NO. 29: State fully and completely all facts which support Applicant's second affirmative defense, dated December 27, 2002.

INTERROGATORY NO. 30: State fully and completely all facts which support Applicant's third affirmative defense, dated December 27, 2002.

INTERROGATORY NO. 33: State fully and completely all facts which support Applicant's sixth affirmative defense, dated December 27, 2002.

INTERROGATORY NO. 34: State fully and completely all facts which support Applicant's seventh affirmative defense, dated December 27, 2002.

**RESPONSES:** Applicant objects to this objection as overly broad, harassing and unduly burdensome. To the extent not otherwise objected to, Applicant will provide only that information which is sufficient to meet the needs of the Interrogatory. Applicant objects to this interrogatory on the grounds that it seeks the production of trade secret or other confidential research, development or commercial information within the meaning of Rule 26(c)(7), Fed. R. Civ. P. To the extent not otherwise objected to, Applicant will produce representative, responsive, confidential information only after the entry of a suitable protective order by the Board.

DOCUMENT REQUEST 29. All documents and things which support Applicant's second affirmative defense, dated December 27, 2002.

The Board has held that with regard to information refused to an opposer during discovery, an applicant will be precluded from relying on such information and from adducing this testimony as evidence at trial. *See Shoe Factory Supplies Co. v. Thermal Engineering Co.*, 207 USPQ 517 (TTAB 1980). Accordingly, Applicant should be precluded from offering into evidence any information or documents withheld from disclosure in response to those discovery requests.

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DOCUMENT REQUEST 30. All documents and things which support Applicant's third affirmative defense, dated December 27, 2002.

DOCUMENT REQUEST 33. All documents and things which support Applicant's sixth affirmative defense, dated December 27, 2002.

DOCUMENT REQUEST 34. All documents and things which support Applicant's seventh affirmative defense, dated December 27, 2002.

RESPONSES: Applicant objects to this request to the extent that it calls for the production of attorney-client communications or documents subject to the attorney work product doctrine. Such information will not be produced. Applicant objects to this request as overly broad, harassing and unduly burdensome. Applicant object to this request on the grounds that it seeks the production of trade secret or other confidential research, development or commercial information within the meaning of Rule 26(c)(7), Fed. R. Civ. P.

CONCLUSION

Based upon the foregoing and the accompanying declaration and the exhibits annexed thereto, Opposer respectfully urges this Board to issue an order compelling Applicant's proper responses, without objection, to Opposer's discovery requests or, in the alternative, precluding Opposer from introducing any evidence concerning such matters, in addition to granting Opposer such other and further relief as this Board deems just and proper under the circumstances.

Dated: New York, New York  
November 12, 2003

Respectfully submitted,

WILLKIE FARR & GALLAGHER LLP

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**CERTIFICATE OF SERVICE**

I certify that a copy of the foregoing OPPOSER'S MEMORANDUM OF LAW IN SUPPORT OF MOTION TO COMPEL was served on counsel for Applicant, this 12<sup>th</sup> day of November 2003, by sending same via First-Class Mail, postage prepaid, to:

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



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Victoria Nicolau

**CERTIFICATE OF MAILING**

Express Mail Label No. EL798004207US

I hereby certify that this OPPOSER'S MEMORANDUM OF LAW IN SUPPORT OF MOTION TO COMPEL is being deposited as "Express Mail Post Office to Addressee" in an envelope addressed to: BOX TTAB, NO FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514, on November 12, 2003.



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Victoria Nicolau