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

TTAB

Attorney Docket No.: 231349US-33

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
 Appln. Serial Nos.: 76/074,595
 and 76/075,729

**APPLICANT'S MOTION FOR LEAVE TO FILE A REPLY BRIEF
 IN SUPPORT OF APPLICANT'S MOTION
 TO COMPEL DISCOVERY AND PRODUCTION OF WITNESSES,
 TO DETERMINE THE SUFFICIENCY OF ADMISSIONS
AND TO SUSPEND PROCEEDINGS**

Pursuant to 37 CFR § 2.127 and Fed. R. Civ. P. 26, Applicant Konami Corporation ("Applicant") submits this Motion for Leave to File a Reply Brief and the attached Reply Brief ("Reply Brief") in Support of Applicant's Motion to Compel Discovery and Production of Witnesses, to Determine the Sufficiency of Admissions and to Suspend Proceedings ("Applicant's Motion"). In further support of this Motion for Leave, Applicant states as follows:

Applicant respectfully submits that its attached Reply Brief will: 1) clarify for the Board that Opposer has failed to fully respond to Applicant's outstanding discovery as outlined in Applicant's Motion; 2) identify the one area of Applicant's Motion that has been resolved by Opposer's supplemental and second supplemental discovery responses; 3) provide the Chart attached as Exhibit 1 to the Reply Brief, which outlines those areas of Opposer's discovery responses that remain deficient notwithstanding Opposer's supplemental and second supplemental discovery responses; 4) rebut Opposer's legally insufficient arguments that Applicant's Japanese witnesses based in Japan are somehow subject to deposition in the United States; and 5) refute Opposer's claim that it was justified in refusing to produce

its witnesses for deposition in response to timely noticed depositions based on an unfounded claim of priority in the sequence of discovery.

Conclusion

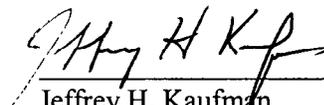
For all of the foregoing reasons, Applicant respectfully requests that the Board grant Applicant's Motion for Leave to file the attached Reply Brief in support of Applicant's Motion.

Respectfully submitted,

KONAMI CORPORATION

Dated: January 5, 2004

By:



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A. Opposer has Not Fully Disclosed
or Identified Relevant Fact Witnesses

In response to Interrogatories 2, 17 and 24, Opposer has failed to provide full contact information for each of the identified witnesses, including the last known address of Linda Wright or of Opposer's former employees, Alex Loucopoulos and Jerry Lyons.

B. Opposer has Improperly Withheld Documents Relied Upon in
Answering Interrogatories and Responding to Requests for Admissions

Opposer's response to Document Requests 18 and 21 seeking the production of documents relied upon in responding to Applicant's Interrogatories and Requests for Admissions is wholly non-responsive. Opposer objected without providing any responsive documents whatsoever. To the extent Opposer possesses documents responsive to these requests, it should be compelled to produce those documents at this time.

C. Opposer Has Refused to Admit or Deny
Requests for Admissions 4 through 10

Requests for Admissions Nos. 4 through 10 are not substantively identical. Opposer is entitled to a response to each of these seven requests. Rather than meet the Requests for Admissions head on, Opposer has responded in a manner that effectively precludes Applicant from using the responses in evidence during Applicant's case in chief. Accordingly, the Board should deem Opposer's responses to Requests Nos. 4 through 10 insufficient and compel Opposer to admit or deny each of these Requests without objection.

D. Opposer Cannot Refuse to Produce Its Witnesses
For Deposition Simply Because Opposer has Not
Sought to Depose Applicant on Written Questions In Japan

Opposer's refusal to produce its witnesses for deposition is not justified by its improper notice of deposition of Applicant in the United States.

As a preliminary matter, Opposer had no legal basis for seeking to depose Applicant, a Japanese corporation, in the United States. The authority is clear that "the discovery deposition of a party domiciled in a foreign country may be taken only by way of written questions unless the parties stipulate

otherwise.” Rhone-Poulenc Indus. v. Gulf Oil Corp., 198 U.S.P.Q. 372, 374 (T.T.A.B. 1978). In this case, the parties have not stipulated otherwise. If Opposer seeks to depose Applicant, it must do so in Japan on written questions. Id. Opposer’s suggestion in its brief that it had the right to depose Applicant in the United States is incorrect and without supporting legal authority.

In addition, Opposer insinuates that there was an “understanding between the parties . . . that Applicant would produce its witnesses if Opposer were agreeable to subsequently producing its own witnesses.” Opposer’s Brief, p. 11. There was never any agreement about the sequence of discovery and the “understanding” Opposer hypothesizes is incorrect.

The only proposal Applicant raised, which still is not an agreement between the parties, was that Applicant would consider making employees of Applicant’s U.S. subsidiary, Konami Digital Entertainment, available for deposition in Alexandria, Virginia or in New York City, if Opposer is willing to consider a similar concession. However, whether KDE – a non-party – is willing to agree to travel from California to Virginia or New York City for depositions is up to it to decide. To date it has not authorized such an agreement.

In any event, it was improper for Opposer to refuse to produce its witnesses for deposition on the theory that it had first noticed Applicant’s deposition in the United States. Not only is there no priority in the sequence of discovery, but Opposer’s notice of deposition of Applicant in the United States was without legal foundation. To date, Opposer has not taken any steps to depose Applicant on written questions in Japan, which is the appropriate mechanism for seeking the deposition of a foreign party domiciled outside of the United States.

At bottom, Opposer unilaterally refused to produce its witnesses for properly and timely noticed depositions. The Board should compel Opposer to produce its witnesses for deposition regardless of whether and when Opposer may seek to depose Applicant on written questions in Japan.

E. Opposer Still Withholds Evidence Concerning Its Knowledge of Applicant's Marks and Any Opinions Concerning Any Claimed Likelihood of Confusion Between Opposer's Marks and Applicant's Marks

Notwithstanding its claim that it has fully responded, Opposer has simply refused to provide relevant information and documents in response to Interrogatories 12 and 13 and Document Requests 13 and 14 concerning its knowledge of Applicant's Mark and whether it considered or received opinions concerning any potential likelihood of confusion between the parties' respective marks. Without question, Opposer possesses relevant information and documents concerning both issues. As outlined in Applicant's opening brief, such evidence is relevant and discoverable. Accordingly, the Board should compel Opposer to produce this evidence to Applicant.

F. Opposer's Information Concerning Claimed Instances of Actual Confusion Remains Incomplete

Opposer's supplemental and second supplemental responses to Interrogatory No. 18 and Document Request 17 concerning claimed instances of actual confusion remain incomplete. First, many of the purported instances of claimed actual confusion would not constitute actual confusion as a matter of law. Moreover, although Opposer claims that employees of Opposer have observed instances of actual confusion from advertisers, clients and family members, Opposer nowhere identifies any instances involving the family members, advertisers or clients, nor does Opposer identify the names of the family members, advertisers or clients. In addition, although Opposer states that its paid columnist, Gary Coleman, has reported that players of Postal 2 are regularly confused about an association between the parties' respective marks, Opposer has failed to identify any such instance, the persons involved, the events which supposedly reflect this claimed confusion or any other evidence that would permit Applicant to test the uncorroborated hearsay Opposer has provided. Opposer also has failed to identify the employee at Summit Media with whom Seth Ingram allegedly spoke.

Furthermore, apart from the production of uncorroborated website printouts from unidentified sources, Opposer has not produced a single document reflecting any supposed claimed instance of actual confusion on the part of consumers of the parties' respective products or services. There are no

documents reflecting the claimed instances of confusion on the part of Opposer's family members, clients or advertisers, no documents concerning alleged confusion on the part of Postal 2 players, no documents concerning Mr. Coleman's reports of alleged confusion (if there were any such reports), no documents concerning the alleged interview of Mr. Fontana, and no documents concerning the conversation between Seth Ingram and an employee at Summitt Media.

These omissions by Opposer are not accidental. The information it has withheld, if provided, would permit Applicant to depose the relevant witnesses and establish that the claimed instances of actual confusion are legally irrelevant in that they do not involve the relevant consuming public or are merely inquiries concerning the pronunciation of the marks at issue. However, if Opposer is permitted to withhold this information, it will prejudice Applicant's ability to discover and rebut the conclusory information Opposer has provided. Accordingly, Applicant respectfully requests that the Board compel Opposer to fully supplement its responses to Interrogatory 18 and Document Request 17.

G. Opposer has Withheld Responsive Evidence
Concerning Opposer's Marks

Notwithstanding its claims to the contrary, Opposer has failed to provide all relevant evidence concerning factual witnesses regarding the conception of its marks (Interrogatory 4), the meaning and commercial impression of its marks (Interrogatory 23) and documents concerning the appearance, pronunciation, meaning and commercial impression of its marks (Document Request 20). Opposer has not fully responded to this discovery and its reliance on its responses to requests for admissions is misplaced. There, Opposer refused to respond to Requests for Admissions Nos. 4 through 10, specifically refusing to respond directly to requests addressing the meaning and commercial impression of its marks. Opposer's conclusory claims of full compliance should not cloud its deliberate attempt to avoid responding to Applicant's discovery. Applicant respectfully requests that the Board compel Opposer to provide full responses to Interrogatories 17 and 23 and Document Request 20.

Conclusion

For all of the foregoing reasons as well as those outlined in Applicant's Opening Brief, Applicant respectfully requests that the Board grant Applicant's Motion to Compel Discovery and Production of Witnesses, to Determine the Sufficiency of Admissions and to Suspend Proceedings and enter an Order:

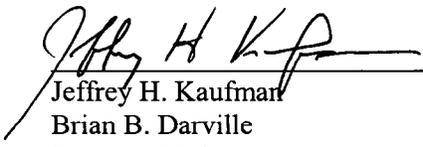
1. Directing Opposer to supplement its answers to Applicant's Interrogatories Nos. 2, 4, 12, 13, 18, 23 and 24;
2. Directing Opposer to supplement its responses to Applicant's Requests for Production of Documents and Things Nos. 13, 14, 17, 18, 20 and 21;
3. Directing Opposer to produce all unprivileged documents responsive to Applicant's Interrogatories and Requests for Production of Documents and Things;
4. Directing Opposer to produce witnesses for depositions at a mutually agreeable time and place;
5. Deeming Opposer's responses to Applicant's First Request for Admissions Nos. 4-10 insufficient; and
6. Directing Opposer to fully respond to Applicant's First Requests for Admissions Nos. 4-10; and
7. Directing Opposer to provide a log of all documents withheld on grounds of any privilege; and
8. Suspending proceedings pending resolution of these motions.

Respectfully submitted,

KONAMI CORPORATION

Dated: January 5, 2004

By: _____


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**EXHIBIT 1 TO APPLICANT'S REPLY BRIEF IN SUPPORT OF
 APPLICANT'S MOTION TO COMPEL DISCOVERY AND
 PRODUCTION OF WITNESSES, TO DETERMINE THE SUFFICIENCY
 OF ADMISSIONS AND TO SUSPEND PROCEEDINGS**

DISCOVERY TOPIC	REMAINING DEFICIENT RESPONSES
Administrative Information & Unreliable Responses	
Interrogatory Nos. 2, 17, 24	Incomplete: Opposer failed to provide complete contact information for each individual identified. The response to Interrogatory No. 17 will be sufficient once the contact data for Alexander Loucopoulos is provided.
Interrogatory No. 20	<i>The Answer to Interrogatory No. 20 is Sufficient</i>
Doc. Req. Nos. 18, 21	Non-responsive: Opposer failed to produce documents and things forming the basis for responding to requests for admissions and/or referred to in its responses to interrogatories.
Admissions Req. Nos. 4-10	Non-responsive: Opposer failed to directly admit or deny several requests and, in effect, has not responded at all.
Knowledge Regarding Applicant's Mark, Likelihood of Confusion, and Actual Confusion	
Interrogatory Nos. 12, 13, 18	Non-responsive: Opposer failed to identify its knowledge regarding when it became aware of Applicant's Mark, advice as to likelihood of confusion between the marks at issue, and instances of actual confusion between the marks at issue. Opposer's disclosure of purported instances of actual confusion remains deficient.
Doc. Request Nos. 13, 14	Non-responsive: Opposer failed to produce any documents regarding its first knowledge of Applicant's Mark or any action related thereto.
Doc. Request No. 17	Incomplete: Opposer failed to produce documentary evidence of actual confusion within its custody or control
Mark Similarity	
Interrogatory No. 4	Non-responsive: Opposer failed to identify any persons involved in the conception of its marks and the persons involved in first considering Opposer's acquisition and use of Opposer's Marks.
Interrogatory No. 23	Non-responsive: Opposer failed to identify the meaning and commercial impression of its marks.
Doc. Req. No. 20	Non-responsive: Opposer failed to produce all documents regarding the appearance, pronunciation, meaning & commercial impression of its marks.

CERTIFICATE OF SERVICE

I hereby certify that I have caused a true and correct copy of APPLICANT'S MOTION FOR LEAVE TO FILE A REPLY BRIEF and REPLY BRIEF IN SUPPORT OF APPLICANT'S MOTION TO COMPEL DISCOVERY AND PRODUCTION OF WITNESSES, TO DETERMINE THE SUFFICIENCY OF ADMISSIONS AND TO SUSPEND PROCEEDINGS to be served on counsel for Opposer, this 5th day of January, 2004, by sending same via First Class Mail, postage prepaid, to:

William M. Ried, Esquire
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787 Seventh Avenue
New York, New York 10019-6099