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

Proceeding	91192781
Party	Defendant Biogen Idec MA Inc. and Cardiokine Biopharma, LLC
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Date	12/14/2011
Attachments	Applicants' Opposition to Opposer's Motion to Extend Discovery (redacted - final).pdf (15 pages)(1853830 bytes) Declaration of C. Licursi (confidential).PDF (7 pages)(972864 bytes) Exhibits (redacted).PDF (91 pages)(5355310 bytes)

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

Opposer: Bayer HealthCare, LLC
Applicants: Biogen IDEC MA Inc. and
Cardiokine Biopharma, LLC
Serial No.: 77/701134
Filing Date:
Mark: LIXALEV
Published: July 28, 2009

Bayer HealthCare, LLC)	Opposition No. 91192781
)	
Opposer,)	Application Serial No. 77/701134
)	Mark: LIXALEV
)	
v.)	
)	
Biogen Idec MA Inc. and)	
Cardiokine Biopharma, LLC)	
)	
Applicants)	
)	

**APPLICANTS' OPPOSITION TO OPPOSER'S
MOTION TO EXTEND DISCOVERY AND ALL SUBSEQUENT DATES**

Applicants Biogen Idec MA Inc. and Cardiokine Biopharma LLC (collectively, "Applicant") hereby oppose Opposer Bayer HealthCare LLC's ("Opposer") Motion to Extend Discovery and All Subsequent Dates in the above-captioned opposition for an additional sixty (60) days ("Motion to Extend"). Opposer's alleged inability to meet discovery deadlines is self-inflicted: it simply has not been diligent in prosecuting the case it chose to initiate. Moreover, it has taken all the discovery it needs, and has shown no need for more and no relevance such further discovery would have to any material issue in dispute.

Excluding periods of suspension, Opposer has had nearly **500 days** to seek discovery.

Remarkably, Opposer now complains that “third-party scheduling issues that were out of Opposer’s control” (Opposer’s Br. at 12) prevented it from scheduling depositions of Applicant witnesses any earlier than two days before the close of discovery. Yet Opposer fails to explain why it waited **232** days after discovery opened to get around to serving discovery requests. Bayer, one of the world’s largest pharmaceutical conglomerates, had ample resources and opportunities to take any discovery that might have been material to this case. Cardiokine, by contrast, is a [REDACTED] which can ill afford the needless delay and expense of yet another extension. (Deposition Testimony of Mr. Leonard M. Selihar (“Selihar Dep.”) at 43:12; attached as Ex. Y).¹

Opposer’s negligence is not without consequence. If indulged, Opposer’s continued delay would unduly prejudice Applicant by adding unnecessary uncertainty to upcoming business decisions, as well as additional expense to this already lengthy proceeding. Here, Opposer’s lack of diligence has been several hundred days in the making; its Motion to Extend should be denied.

I. Opposer Cannot Show the Diligence Required to Extend Discovery

A motion to extend discovery may be granted only upon a showing of good cause. T.B.M.P. § 509. “The moving party...retains the burden of persuading the Board that it was diligent in meeting its responsibilities and should therefore be awarded additional time.” National Football League, NFL Properties LLC v. DNH Management, LLC, 85 U.S.P.Q.2d 1852, 1854 (T.T.A.B. 2008). Denials of motions to extend often arise where opposers delay the initiation of discovery. E.g., NFL Properties, 85 U.S.P.Q.2d at 1855 (denying extension: “[T]he opposers’ claimed need for an extension of discovery is the product solely of opposers’ unwarranted delay in initiating discovery.”); Luemme Inc. v. D.B. Plus Inc., 53 U.S.P.Q.2d 1758, 1760 (T.T.A.B. 1999) (denying

¹ All exhibits herein refer to exhibits attached to Declaration of Christina M. Licursi in Support of Applicant’s Opposition to Opposer’s Motion to Extend Discovery and All Subsequent Dates (“Licursi Decl.”).

extension: “[I]t is clear from the record that petitioner’s delay in initiating discovery has resulted in the instant motion.”); Procyon Pharmaceuticals Inc. v. Procyon Biopharma Inc., 61 U.S.P.Q.2d 1542, 1544 (T.T.A.B. 2001) (non-precedential) (denying extension and noting petitioner’s failure to explain “why petitioner waited until the last day of its testimony period to request the extension.”).

Opposer filed its Notice of Opposition relating to Applicant’s application for the mark LIXALEV on November 23, 2009 (the “Proceeding”). Since that time, Opposer has requested **four** extensions of time. While Opposer argues that it has exercised “continued diligence” in this proceeding, Opposer waited nearly eight months to serve initial discovery requests and allowed another eight months (excluding suspensions) to pass before noticing Applicant’s depositions for November 14, 2011. (Licursi Decl. ¶ 13; Exs. K-M). Indeed, Opposer’s **fifth** request to extend discovery demonstrates its failure to exercise the diligence the Board requires of those who initiate proceedings before the TTAB. See Procyon, 61 U.S.P.Q.2d at 1544 (denying extension: “Petitioner brought this cancellation proceeding and, thus, carries the burden of going forward in a timely manner.”).

The original discovery period opened on February 1, 2010. Excluding suspended periods, Opposer has had about **16 months** to seek any necessary discovery. Remarkably, after receiving 440,000 pages of documents and deposing four witnesses, Opposer now argues that Applicant’s responses have been “deficient.” (Br. at 3). To the contrary, Applicant has addressed each of Opposer’s requests and fully satisfied its discovery obligations. (Licursi Decl. ¶¶ 3-4; Exs. B-C). With discovery deadlines now expired, Opposer’s last-minute request would simply squander limited Board resources on unnecessary discovery.

Moreover, Opposer invites legal error by labeling as “deficient” Applicant’s inability to produce evidence that does not exist. It should go without saying that a party “cannot be compelled to produce what it does not have.” Byer California v. Clothing for Modern Times Ltd., 95

U.S.P.Q.2d 1175, 1177 (T.T.A.B. 2010) (non-precedential) (denying motion to compel). Here, much of the information that Opposer has requested of Applicant simply does not exist. For example, Opposer characterizes Applicant's January 13, 2011 responses to requests for discovery as "deficient." (Br. at 3). However, Opposer and Applicant held a telephone conference on March 7, 2011 to discuss Bayer's concerns over purportedly "deficient" responses. (Licursi Decl. ¶ 3; Ex. B). During the course of this telephone conversation, as confirmed by Applicant's March 14, 2011 letter, Applicant confirmed that pursuant to Fed. R. Civ. Pro. 34, in responding to Bayer's First Request for Production, both Cardiokine and Biogen conducted reasonable searches for the requested information and documentation. (Licursi Decl. ¶¶ 2-4; Exs. A-C).

Despite Applicant's repeated explanation that no responsive documents exist, Opposer continued to insist that Applicant was withholding information from Opposer. (Licursi Decl. ¶ 3; Ex. B). Inexplicably, Opposer refused to accept the obvious explanation: the application for LIXALEV was filed on an intent-to-use basis [REDACTED] [REDACTED] (Ex. X, Selihar Depo. 10:21-22; 11:25-12:3). Therefore, much of the documentation that Bayer is requesting does not exist. Nevertheless, Applicant has continuously addressed Opposer's requests for additional information and supplemented discovery responses. (Licursi Decl. ¶¶ 3-4; Exs. B-C).

Having waited more than a year (excluding suspension periods) to notice any depositions, Opposer now directs attention to recent activity to distract from its earlier tardiness. In particular, Opposer makes the centerpiece of its diligence story the most recent four months – when it finally got around to deposing its three fact witnesses. Yet even here, Opposer's blame-shifting fails. Throughout October and November 2011, Applicant repeatedly attempted to accommodate the unpredictable schedule of Opposer's counsel in order to move this case forward and keep within the Board's discovery deadlines. (Licursi Decl. ¶¶ 7-14; Exs. E-N). Having bent over backwards to

avoid further delay, Applicant now faces Opposer's manufactured objections regarding deficient 30(b)(6) responses. Indeed, Opposer's most recent communication makes clear that its deposition objections are merely a ploy to delay the Board reaching a decision on the merits and instead to wear down Applicant with endless discovery. (Licursi Decl. ¶ 22; Ex. W).

Despite Applicant's best efforts, Opposer has managed to utilize depositions as a stalling tactic. For example, Opposer argues that its preparation for the deposition of William Johnson of Brand Institute, Inc. ("Brand Institute") justifies extending the discovery period. (Br. at 4). However, Opposer did not raise the issue of scheduling the depositions of Applicant's two 30(b)(6) witnesses until October 19, 2011. (Licursi Decl. ¶ 5; Ex. D). As evidence of Applicant's continuous cooperation and good faith, counsel for Applicant responded that very same day, notifying counsel for Opposer that they would obtain dates and respond shortly. (Id.). They did so, and indeed the deposition went forward promptly thereafter. On October 27, 2011, counsel for Opposer and Applicant both attended the deposition of William Johnson of the Brand Institute, Inc. in New York, NY. During this deposition, counsel for Opposer could have raised the issue of solidifying dates for the depositions of Biogen and/or Cardiokine. (Licursi Decl. ¶ 6.) Opposer, however, chose not to. In fact, Opposer did not revisit the issue of depositions for the Applicants until November 2, 2011, when still approximately one month remained in the discovery period. (Licursi Decl. ¶ 7; Ex. E).

Applicant promptly responded to Opposer on November 4, 2011, confirming the availability of Rule 30(b)(6) designees for both Biogen and Cardiokine. (Licursi Decl. ¶ 8; Ex. F). In light of the impending close of discovery, as an exercise of good faith, counsel for Applicant offered to conduct the depositions after the November 30, 2011 discovery deadline to accommodate Opposer's schedule, if necessary. (Id.). Three days later, counsel for Applicant had to send counsel for Opposer yet another e-mail requesting that he solidify dates for the deposition and provide

Applicant with a list of topics for the depositions. (Licursi Decl. ¶ 9; Ex. G). On November 8, counsel for Opposer finally responded to counsel for Applicant, identifying November 15 and 16th as possible deposition dates. (Licursi Decl. ¶ 10). Counsel for Applicant replied the very next day, confirming Applicants' availability on November 15th and 16th. (Licursi Decl. ¶ 10; Ex. H). Again, as a measure of good faith, counsel for Applicant offered to accommodate any issues with scheduling by agreeing to give Opposer an additional 15-30 days to complete the depositions of Biogen and Cardiokine after the close of discovery. (Id.).

On November 9, 2011 counsel for Opposer informed counsel for Applicant that he was no longer available for depositions on November 15th and 16th and that they would be filing a Motion to Extend with the Board. (Licursi Decl. ¶ 11; Ex. I). On November 11, 2011, counsel for Applicant sent counsel for Opposer a letter outlining the history of the discovery period and informing them that we simply could not agree to any further extensions of the discovery period. (Licursi Decl. ¶ 12; Ex. J). Counsel for Opposer responded by finally noticing the depositions of Biogen and Cardiokine on November 14, 2011. (Licursi Decl. ¶ 13; Exs. K-M). Counsel for Applicant promptly responded that it could coordinate for the depositions to be held on November 28 and 29th. (Licursi Decl. ¶ 14; Ex. N). As an added convenience and courtesy to Opposer, Applicant offered to make both witnesses available in the same city – at its counsel's office – sparing Opposer the need to travel to two different cities to complete these depositions or to retain space at a local counsel or court reporter's office.

After solidifying dates, the depositions of Biogen and Cardiokine were held on November 28 and 29, 2011, respectively. Despite Applicant's willingness to accommodate the scheduling of these depositions, Opposer now asserts that it needs an extension of time to take discovery, alleging (as it clearly had been planning to allege all along, regardless of the scope of testimony that it

obtained at these depositions)² that Applicant has failed to comply with its discovery obligations. (Br. at 2). However, Applicant has provided knowledgeable 30(b)(6) witnesses and has produced all relevant, responsive information available after reasonable searches. (See e.g., Licursi Decl. ¶¶ 2-4; Exs. A-C).

II. Applicant Has Satisfied Its Discovery Obligations

Opposer argues that its Motion to Extend is necessary because Applicant failed to fulfill its discovery obligations, despite the fact that Opposer did not notice the depositions for either Biogen or Cardiokine until November 14, 2011. (Exs. M & N). Moreover, Opposer skirts any responsibility for waiting until the very end of nearly **500 days** of discovery to take the depositions of Applicant. See Tony & Guy (USA) Ltd. v. Ardell Nelson, No. 92040118, 2004 WL 725459, at *10 (T.T.A.B. Mar. 30, 2004) (non-precedential) (denying motion to re-open discovery to take additional 30(b)(6) deposition to remedy allegedly unprepared witness testimony where moving party “delayed until the waning days of discovery to serve on petitioner the notice of deposition under Rule 30(b)(6)”) (attached to Licursi Decl. ¶ 16 as Ex. Q).

Instead, Opposer suggests that it needs to extend discovery once again because Biogen allegedly did not produce a knowledgeable 30(b)(6) witness on November 28, 2011 and Cardiokine allegedly did not produce all the responsive documents in its possession. However, Opposer gets both the facts and the law wrong.

² During the Brand Institute deposition, Opposer contended on the record that Applicant had failed to produce one of Brand Institute’s reports. Immediately after that deposition concluded (within about an hour), Applicant pointed out by email that in fact this document had been produced *twice*, and provided Opposer with the bates-number ranges of each production. (Licursi Decl. ¶ 27; Ex. Z). Undaunted, at the Biogen deposition, Opposer again claimed that Applicant had failed to produce a document, causing Applicant’s counsel to spend the lunch break locating it, only to have Opposer yet again have to admit that, in fact, it had already been produced. (Exhibit R of Licursi Decl.; Hermans Depo.81:10-25). The pattern is unmistakable – Opposer’s goal has been to find some excuse to demand further discovery time.

A. Biogen's 30(b)(6) Witness Was Knowledgeable and Adequately Prepared

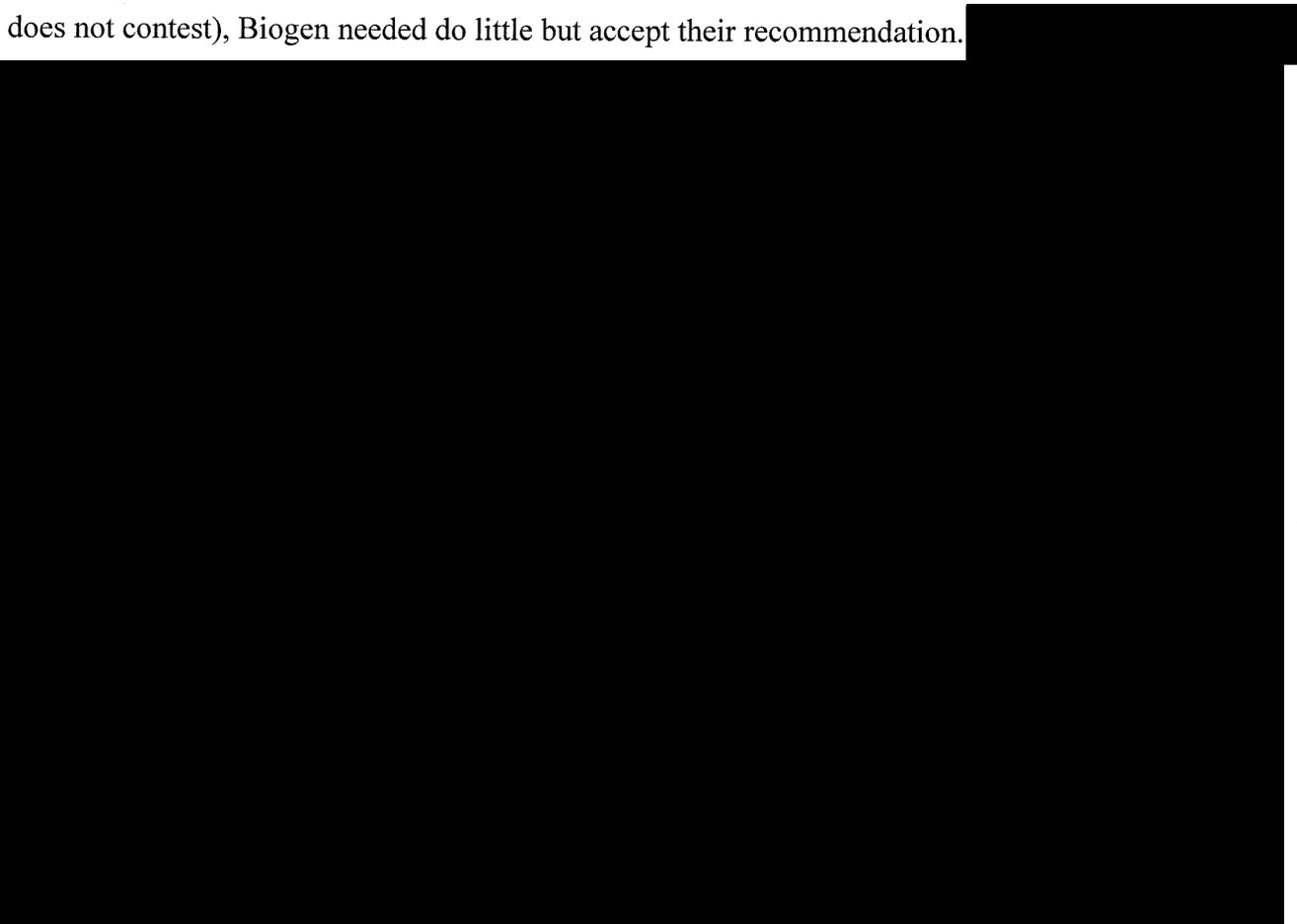
On November 28, 2011, Biogen produced Mr. Joerg Hermans, the current Senior Director of Operations in the Emerging Markets Group at Biogen, as the 30(b)(6) witness to testify on behalf of Biogen regarding the topics listed in the Biogen Deposition Notice relating to the LIXALEV mark and product. (Licursi Decl. ¶ 15; Ex. O). Consistent with the obligations regarding 30(b)(6) witnesses under T.B.M.P. § 404.06(b) and the Federal Rules of Civil Procedure, Biogen designated Mr. Hermans because he was the person most knowledgeable about the selection of LIXALEV as the brand name to be used in connection with lixivaptan. (Licursi Decl. ¶ 23). 


 In

other words, this fact proves not that Mr. Hermans was the wrong witness, but rather that Biogen neither has nor could be expected to have much evidence relevant to this case. Opposer makes no

contrary showing.

Contrary to Opposer's allegation, Mr. Hermans was knowledgeable about the selection of the LIXALEV mark. Indeed, during his tenure as Director of Marketing for the Cardiovascular Group, Mr. Hermans was involved in the selection of the LIXALEV brand name. (Ex. R, Hermans Dep. at 7:14). Opposer incorrectly argues that Mr. Hermans spent "limited time working on the LIXALEV mark and product" and that "he took few or no steps to familiarize himself with what happened before he joined or after he left the group." (Br. at 7.) Mr. Hermans, however, was the "primary person at Biogen" responsible for interfacing with Brand Institute, which involved coordinating the name selection for the lixivaptan drug. (Ex. R, Hermans Dep. at 24:22). Because the name selection task had largely been delegated to Brand Institute, however (which was deposed extensively on the subject and the adequacy of whose document production and testimony Opposer does not contest), Biogen needed do little but accept their recommendation.



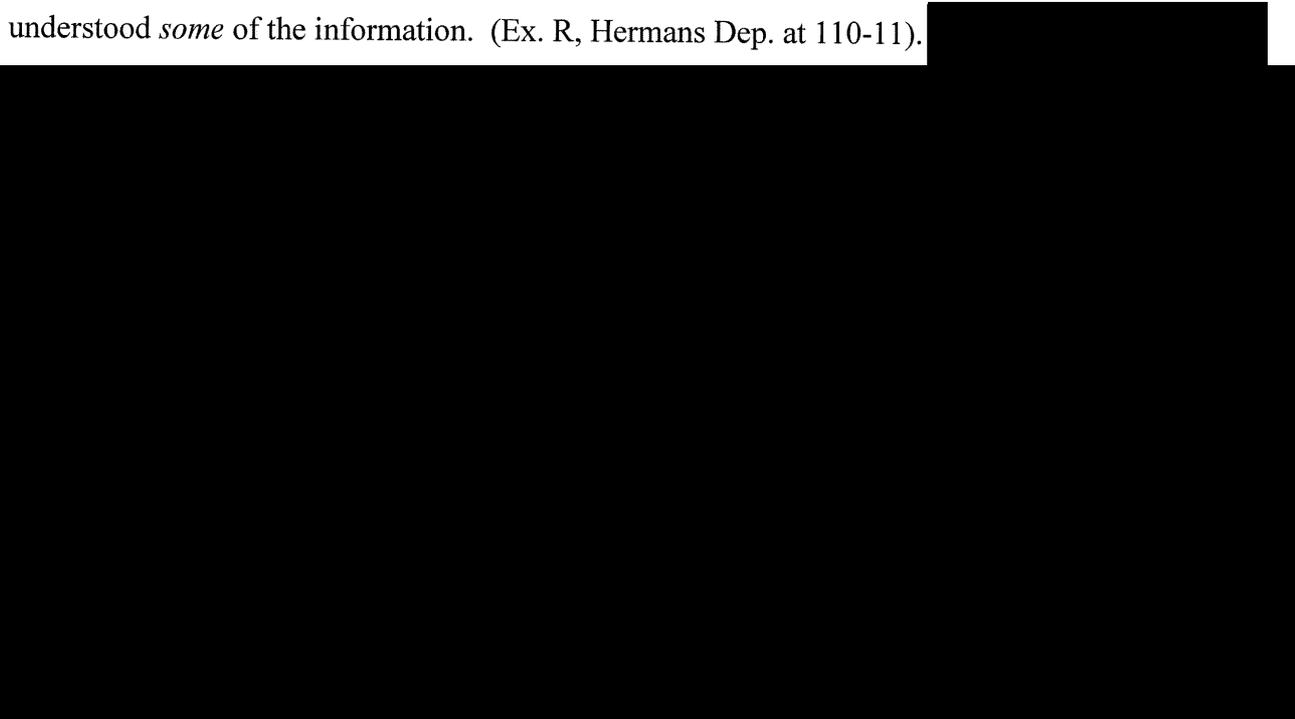


Opposer, however, blatantly mischaracterizes Biogen’s lack of information as a “lack of personal knowledge [by Mr. Hermans] and lack of preparation for the deposition,” contending that it warrants an additional 30(b)(6) deposition. (Br. at 8.) This misstates the law. Mr. Hermans – or any potential Biogen designee – is not required to testify on the clinical trials related to lixivaptan, the testing of the product that Biogen and/or Cardiokine intend to market under the LIXALEV mark, or on the safety and/or efficacy of the product – all topics about which Biogen simply does not have relevant information. Byer California, 95 U.S.P.Q.2d at 1177 (denying motion to compel because a party “cannot be compelled to produce what it does not have.”).

This does not mean, however, that Opposer was unable to get a witness to testify about these topics. On the contrary, Leonard Selihar, corporate designee for Cardiokine, testified on November

30, 2011 and answered in full Opposer's detailed questions about each of Opposer's noticed topics. Moreover, Opposer did not object to the sufficiency of Cardiokine's 30(b)(6) deposition. Applicant, therefore, has satisfied its obligation under T.B.M.P. §404.06(b) and produced witnesses who provided knowledgeable and binding answers reflecting the information reasonably available to each of the companies. While some of the information came from Biogen and other information came from Cardiokine, each answered thoroughly as to the topics about which they had relevant information. Moreover, the Federal Rules of Civil Procedure do not require Biogen's corporate designee to regurgitate the same information as Cardiokine's. See Fed. R. Civ. P. 26(b)(2)(C) (precluding discovery that "is unreasonably cumulative or duplicative.").

Opposer also requested a witness knowledgeable about any surveys or focus groups regarding the LIXALEV mark and communications with Brand Institute. (Licursi Decl. ¶ 15; Exs. O-P). Opposer notes that one survey conducted by Brand Institute on behalf of Biogen related to the pronunciation of the LIXALEV mark and that when asked about documents relating to this survey, Mr. Hermans testified that he only remembered *some* of the information shown and understood *some* of the information. (Ex. R, Hermans Dep. at 110-11).



[REDACTED]

In sum, Biogen has fulfilled its obligations to produce a witness pursuant to T.B.M.P. §404.06(b) and Rule 30(b)(6).

B. Responsive Documents Produced By Cardiokine

Opposer speculates (erroneously) that Cardiokine has additional documents that are responsive to Opposer’s First Set of Document Requests to Applicant (“Document Requests”) that it has not produced. However, Applicant has already produced representative documents responsive to Opposer’s requests for “prototypes and drawings, of all packaging and labeling, currently used or intended to be used.” (Licursi Decl. ¶ 21; Ex. V). Moreover, Opposer errs in arguing that a failure to produce cumulative documents means that Applicant “has not fulfilled its obligation to supplement Applicants’ document production with these responsive documents.” See Harjo v. Pro-Football Inc., 45 U.S.P.Q.2d 1789, 1790 (T.T.A.B. 1998) (denying motion to re-open discovery because proposed evidence was merely cumulative).

III. Conclusion

Opposer’s alleged need to extend discovery is due to its initial tardiness in failing to seek discovery for nearly eight months. Moreover, once discovery was finally underway, Opposer served overly broad requests and then used Applicant’s diligent production as a further excuse for delay. Having dragged its feet for nearly 500 days, Opposer cannot now be heard to complain that its tardiness was somehow Applicant’s fault.

In sum, Opposer has failed to meet its burden to establish good cause for an extension. Separately and as a further basis for denial of the motion, Opposer has failed to make any showing at all – or even attempt to show – that any of the allegedly missing information would have been

material to any disputed legal issue in this case, which turns on the relatively simple and straightforward question as to whether there is a likelihood of confusion between the marks LIXALEV and ALEVE.³

Since the beginning of this proceeding, Applicant has indicated to Opposer that its preference was to have this matter resolved as quickly as possible. Despite Applicant's desire to expedite matters, Applicant has continuously been reasonable and cooperative throughout this proceeding, consenting to Opposer's requests for extensions of dates on multiple occasions. However, this accommodation has gone on long enough: "[A]ny further delay of this case will severely prejudice respondent's right to a speedy and inexpensive determination of the proceeding." Harjo, 45 U.S.P.Q.2d at 1790 (denying motion to re-open discovery).

Moreover, Applicant's good faith attempts to cooperate in discovery have been met with procedural maneuvers – like the present motion – that have only prolonged this case, increased legal expenses, and wasted Board resources. Here, Applicant has repeatedly provided Opposer with the relevant information that it requested. Indeed, Applicant's counsel sought to resolve the present dispute by allowing for an informal process after the close of discovery whereby Applicant would work with Opposer to address specific concerns and provide Opposer whatever additional information it genuinely needed (by way of declaration or stipulation). Instead, true to form, Opposer filed the Motion to Extend.

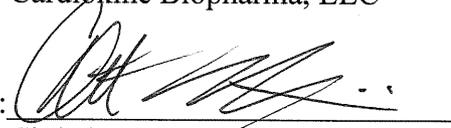
Applicants request that the Board put an end to Opposer's expensive tactics and deny Opposer's Motion to Extend.

³ As to this issue, Applicant notes that both parties have put forward linguistics experts, each of whom has served expert reports and has also been extensively deposed.

Respectfully submitted,

Biogen IDEC MA Inc. and
Cardiokine Biopharma, LLC

By:



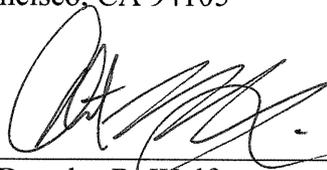
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Date: December 14, 2011
Attorney Docket No: C1346.50000US00

CERTIFICATE OF SERVICE

I hereby certify that on December 14, 2011, I served a copy of **APPLICANTS' OPPOSITION TO OPPOSER'S MOTION TO EXTEND DISCOVERY AND ALL SUBSEQUENT DATES** upon counsel for Opposer, Bayer HealthCare, LLC. by first-class mail, postage-prepaid, addressed to:

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Attorney Docket: C1346.50000US00
Date: December 14, 2011

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Opposer: Bayer HealthCare LLC
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Opposer,)	Application Serial No. 77/701134
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Biogen Idec MA Inc., and)	
Cardiokine Biopharma, LLC)	
Applicant)	

**DECLARATION OF CHRISTINA M. LICURSI IN SUPPORT OF APPLICANT'S
OPPOSITION TO OPPOSER'S MOTION TO EXTEND
DISCOVERY AND ALL SUBSEQUENT DATES**

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or document or any registration resulting therefrom, hereby declares as follows:

1. I am an associate at the law firm of Wolf Greenfield & Sacks, P.C., counsel for Biogen Idec MA Inc. and Cardiokine Biopharma, LLC (collectively, "Applicant"). I submit this declaration in support of Applicant's Opposition to Opposer's Motion to Extend Discovery and All Subsequent Dates.

2. On January 13, 2011, Biogen Idec MA Inc. (Biogen”) provided Opposer documents responsive to Opposer’s first set of discovery requests. Attached hereto as Exhibit A is a true and correct copy of Applicant’s letter to counsel for Opposer regarding the discovery responses. Notably, as early as January 13, 2011 counsel for Applicant asked that counsel for Opposer contact them regarding the scheduling of depositions.

3. On March 7, Opposer and Applicant held a telephone conference to discuss Bayer’s concerns over purportedly “deficient” responses. During the course of this telephone conversation, as confirmed by Applicant’s March 14, 2011 letter, Applicant confirmed that pursuant to Fed. R. Civ. Pro. 34, in responding to Bayer’s First Request for Production, both Cardiokine and Biogen conducted reasonable searches for the requested information and documentation. Attached hereto as Exhibit B is a true and correct copy of Applicant’s March 14, 2011 letter to counsel for Opposer.

4. Attached hereto as Exhibit C is a true and correct copy of Applicant’s letter to counsel for Opposer dated March 17, 2011, whereby Applicant enclosed supplemental discovery responses.

5. On October 19, 2011, I received an e-mail from counsel for Opposer, requesting dates for the depositions of Cardiokine and Biogen. Attached hereto as Exhibit D is a true and correct copy of Opposing’s counsel’s October 19th e-mail and counsel for Applicant’s response also dated October 19, 2011.

6. On October 27, 2011, counsel for Opposer and counsel for Applicant both attended the deposition of William Johnson of the Brand Institute, Inc. in New York, NY. During this deposition, counsel for Opposer did not raise the issue of solidifying dates for the depositions of Biogen and/or Cardiokine.

7. On November 2, I received an e-mail from counsel for Opposer, requesting dates for the depositions of Cardiokine and Biogen and requesting an extension of the discovery period. Attached hereto as Exhibit E is a true and correct copy of Opposer's counsel's November 2, 2011 e-mail.

8. I responded to Opposer on November 4, 2011, confirming the availability of Rule 30(b)(6) designees for both Biogen and Cardiokine. Attached hereto as Exhibit F is a true and correct copy of my e-mail to counsel for Opponent dated November 4, 2011. In light of the impending close of discovery, as an exercise of good faith, counsel for Applicant offered to conduct the depositions after the November 30, 2011 discovery deadline to accommodate Opposer's schedule, if necessary.

9. Three days later, I still did not receive a response to my November 4, 2011, which confirmed the availability of designees for Biogen and Cardiokine during the week of November 14, 2011. On November 7, 2011, I had to send counsel for Opposer yet another e-mail requesting that he solidify dates for the deposition and provide Applicant with a list of topics for the depositions. Attached hereto as Exhibit G is a true and correct copy of my e-mail to counsel for Opponent dated November 7, 2011.

10. On November 8, counsel for Opposer finally responded to counsel for Applicant, identifying November 15 and 16 as possible deposition dates. Counsel for Applicant replied the very next day, confirming Applicants' availability on November 15 and 16. Attached hereto as Exhibit H is a true and correct copy of my e-mail to counsel for Opponent dated November 9, 2011. Again, as a measure of good faith, counsel for Applicant offered to accommodate any issues with scheduling by agreeing to give Opposer an additional 15-30 days to complete the depositions of Biogen and Cardiokine after the close of discovery.

11. On November 9, 2011 counsel for Opposer informed counsel for Applicant that he was no longer available for depositions on November 15th and 16th and that they would be filing a Motion to Extend with the Board. Attached hereto as Exhibit I is a true and correct copy of counsel for Opponent's e-mail to me dated November 9, 2011.

12. On November 11, 2011, I sent counsel for Opposer a letter outlining the history of the discovery period and informing them that we could simply not agree to any further extensions of the discovery period. Attached hereto as Exhibit J is a true and correct copy of our November 11, 2011 letter to counsel for Opposer.

13. Counsel for Applicant responded by finally noticing the depositions of Biogen and Cardiokine on November 14, 2011. Attached hereto as Exhibits K-M are the 30(b)(6) deposition notices for Biogen and Cardiokine dated November 14, 2011, as well as counsel for Opposer's letter to Applicant.

14. In an effort to further accommodate scheduling conflicts, Counsel for Applicant promptly responded that it could coordinate for the depositions to be held on November 28 and 29th. Attached hereto as Exhibit N is a true and correct copy of our November 16, 2011 e-mail to counsel for Opposer.

15. Attached hereto as Exhibits O and P are the 30(b)(6) deposition notices from Opposer for Biogen and Cardiokine dated November 21, 2011.

16. Attached hereto as Exhibit Q is a true and correct copy of Tony & Guy (USA) Ltd. v. Ardell Nelson, No. 92040118, 2004 WL 725459, at *10 (T.T.A.B. Mar. 30, 2004).

17. Attached hereto as Exhibit R is a true and correct copy of excerpts of the Deposition Transcript of Joerg P. Hermans, November 28, 2011.

18. Attached hereto as Exhibit S is a true and correct copy of Home Design Services, Inc. v. W. Gargas Const., Inc., No. 08-00244, 2009 WL 3190462, at *4 (N.D. Fla. Oct. 1, 2009).

19. Attached hereto as Exhibit T is a true and correct copy of Collaboration and License Agreement between Biogen Idec MA Inc. and Cardiokine Biopharma, LLC, dated June 27, 2007 and amended November 3, 2008 (“Collaboration and License Agreement”).

20. Attached hereto as Exhibit U is a true and correct copy of Kimberly-Clark Worldwide, Inc. v. First Quality Baby Products, LLC, 2011 WL 3880787, at *2 (E.D. Wis. Sep. 1, 2011).

21. Attached hereto as Exhibit V is a true and correct copy of documents produced by Applicant related to product packaging.

22. Attached hereto as Exhibit W is a true and correct copy of counsel for Opposer’s December 12, 2011 letter to counsel for Applicant.

23. In preparation for the November 28, 2011 deposition of Biogen Idec MA, Inc., counsel for Applicant held multiple telephone conferences with Joerg Hermans and Jennifer Riley and spent considerable time determining he most knowledgeable and appropriate 30(b)(6) designee.

24. In preparation for the November 28, 2011 deposition of Biogen Idec MA, Inc., counsel for Applicant held multiple telephone conferences with Joerg Hermans to review files and responsive documents and to coordinate conversation with other Biogen employees who had relevant knowledge or information so as to make sure it was all provided to Joerg and he was well prepared for the deposition.

25. Attached hereto as Exhibit X is a true and correct copy of the Termination Agreement, effective November 1, 2011, which formerly terminated the Collaboration and License Agreement.

26. Attached hereto as Exhibit Y is a true and correct copy of excerpts of the Deposition Transcript of Leonard M. Selihar, November 29, 2011.

27. Attached hereto as Exhibit Z is a true and correct copy of counsel for Applicant's e-mail correspondence with counsel for Opposer dated October 27, 2011 confirming that documents that counsel for Opposer claimed with withheld by Applicant were actually produced *twice* (first by Applicant and later by Brand Institute).

28. Attached hereto as Exhibit AA is a true and correct copy of printout of the USPTO assignment records indicating the December 15, 2010 assignment of the LIXALEV mark.

I declare under penalty of perjury that the foregoing is true and correct.

Executed this 14th day of December 2011, in Boston, Massachusetts.



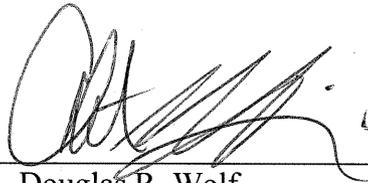
Christina M. Licursi

Date: December 14, 2011
Attorney Docket No: C1346.50000US00

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing DECLARATION OF CHRISTINA M. LICURSI IN SUPPORT OF APPLICANT'S OPPOSITION TO OPPOSER'S MOTION TO EXTEND DISCOVERY AND ALL SUBSEQUENT DATES was served on counsel for Opposer, this 14th day of December 2011 by sending same via First Class Mail, postage prepaid, to:

Beth M. Goldman
Chelsea Bush
Orrick, Herrington & Sutcliffe LLP
The Orrick Building
405 Howard Street
San Francisco, CA 94105



Douglas R. Wolf
Christina M. Licursi
Michael A. Albert
Wolf, Greenfield & Sacks, P.C.
Federal Reserve Plaza
600 Atlantic Avenue
Boston, Massachusetts 02210
Attorneys for Applicant

Attorney Docket No.: C1346.50000US00

EXHIBIT A

January 13, 2011

VIA FIRST CLASS MAIL

Beth M. Goldman
Orrick, Herrington & Sutcliffe LLP
The Orrick Building
405 Howard Street
San Francisco, CA 94105

Re: Bayer HealthCare LLC v. Biogen Idec (LIXALEV)
Our Reference No. C1346.50000US00

Dear Ms. Goldman-

Enclosed, please find the following:

1. Applicant's Response to Opposer's First Request for Production to Applicant;
2. Applicant's Response to Opposer's First Set of Interrogatories to Applicant; and,
3. Applicant's Responses to Opposer's First Set of Requests for Admissions to Applicant.

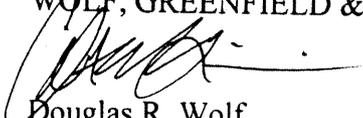
A verified copy of Applicant's Response to Opposer's First Set of Interrogatories to Applicant will follow under separate cover.

Please note that the Standard Protective Order is in effect and that each of the documents produced herewith are marked Trade Secret/ Commercially Sensitive. We have also marked certain answers to Interrogatories as Trade Secret/ Commercially Sensitive.

We appreciate your continuing cooperation with scheduling requests. Please feel free to contact us at your convenience to discuss the deposition schedule and any other questions you may have.

Very truly yours,

WOLF, GREENFIELD & SACKS, P.C.


Douglas R. Wolf
Christina M. Licursi

CXL/ajf
Enclosures

EXHIBIT B



Douglas R. Wolf
dougwolf@wolfgreenfield.com
direct dial 617.646.8260

Christina M. Licursi
cllicursi@wolfgreenfield.com
direct dial 617.646.8384

March 14, 2011

VIA E-MAIL AND FIRST CLASS MAIL

Beth.Goldman@orrick.com

Beth M. Goldman
Orrick, Herrington & Sutcliffe LLP
The Orrick Building
405 Howard Street
San Francisco, CA 94105

Re: Bayer Healthcare, LLC v.
Biogen Idec MA, Inc. and Cardiokine Biopharma, LLC
In re U.S. Application Serial No. 77/701134 for LIXALEV
Opposition No. 91192781
Our Ref.: C1346.50000US00

Dear Ms. Goldman:

In follow-up to your letter dated March 4, 2011 and our ensuing telephone conference on March 7, 2011, we confirm that both Cardiokine Biopharma, LLC and Biogen Idec provided the information necessary to respond to Bayer Healthcare, LLC's initial discovery requests.

This letter also confirms that, pursuant to Fed. R. Civ. Pro. 34, in responding to Bayer's First Request for Production, both Cardiokine and Biogen conducted reasonable searches for the requested information and documentation. Nevertheless, both Biogen and Cardiokine are working to ameliorate any concerns that you may have regarding the scope of their search for documents.

As we discussed during our telephone conference, additional information is simply not available in response to your claims that information was withheld. As we have explained to you many times, the application for LIXALEV was filed on an intent-to-use basis and the drug is in the early phases of clinical trials, so much of the documentation that Bayer is asking for does not exist.

Beth M. Goldman
March 14, 2011
Page 2

Should either Biogen or Cardiokine uncover any additional relevant information responsive to Bayer's First Request for Production or Bayer's First Set of Interrogatories, we will supplement our responses no later than March 17, 2011.

Very truly yours,

WOLF, GREENFIELD & SACKS, P.C.



Douglas R. Wolf
Christina M. Licursi

CML/smo

O'Gorman, Susan M.

From: Goldman, Beth [Beth.Goldman@orrick.com]
Sent: Thursday, March 17, 2011 5:27 PM
To: Licursi, Christina M.
Cc: O'Gorman, Susan M.
Subject: RE: US Opposition No. 91192781 Bayer v. Biogen and Cardiokine; Our ref. C1346.50000US00
Thank you.



ORRICK

BETH M. GOLDMAN

Partner

ORRICK, HERRINGTON & SUTCLIFFE LLP

THE ORRICK BUILDING
405 HOWARD STREET
SAN FRANCISCO, CA 94105

tel 415-773-4580

fax 415-773-5759

beth.goldman@orrick.com

www.orrick.com

From: Christina M. Licursi [mailto:Christina.Licursi@WolfGreenfield.com]
Sent: Thursday, March 17, 2011 2:26 PM
To: Goldman, Beth
Cc: O'Gorman, Susan M.
Subject: FW: US Opposition No. 91192781 Bayer v. Biogen and Cardiokine; Our ref. C1346.50000US00

Beth-

A small correction to our cover letter: as you will see, we began numbering our supplemental responses at A001087. Apologies for the inconvenience.

Thank you,

Christina

From: O'Gorman, Susan M.
Sent: Thursday, March 17, 2011 5:13 PM
To: beth.goldman@orrick.com
Cc: Licursi, Christina M.
Subject: US Opposition No. 91192781 Bayer v. Biogen and Cardiokine; Our ref. C1346.50000US00

Per instructions received from Christina Licursi, please see the attached letter and supplemental

3/18/2011

REDACTED COPY

document.

Susan O'Gorman

Legal Secretary

Susan.OGorman@WolfGreenfield.com

Direct Dial 617.646.8362

Wolf Greenfield

Specialists in Intellectual Property Law

Wolf, Greenfield & Sacks, P.C.

600 Atlantic Avenue

Boston, Massachusetts 02210-2206

617.646.8000 | 617.646.8646 fax

For more information about Wolf Greenfield, please visit us at <http://www.wolfgreenfield.com>

This e-mail message and any attachments may contain confidential or privileged information. If you are not the intended recipient, please notify me immediately by replying to this message. Please destroy all copies of this message and any attachments. Thank you.

IRS Circular 230 disclosure: To ensure compliance with requirements imposed by the IRS, we inform you that any tax advice contained in this communication, unless expressly stated otherwise, was not intended or written to be used, and cannot be used, for the purpose of (i) avoiding tax-related penalties under the Internal Revenue Code or (ii) promoting, marketing or recommending to another party any tax-related matter(s) addressed herein.

NOTICE TO RECIPIENT: THIS E-MAIL IS MEANT FOR ONLY THE INTENDED RECIPIENT OF THE TRANSMISSION, AND MAY BE A COMMUNICATION PRIVILEGED BY LAW. IF YOU RECEIVED THIS E-MAIL IN ERROR, ANY REVIEW, USE, DISSEMINATION, DISTRIBUTION, OR COPYING OF THIS E-MAIL IS STRICTLY PROHIBITED. PLEASE NOTIFY US IMMEDIATELY OF THE ERROR BY RETURN E-MAIL AND PLEASE DELETE THIS MESSAGE FROM YOUR SYSTEM. THANK YOU IN ADVANCE FOR YOUR COOPERATION. For more information about Orrick, please visit <http://www.orrick.com/>

EXHIBIT C



Douglas R. Wolf
dougwolf@wolfgreenfield.com
direct dial 617.646.8260

Christina M. Licursi
clicursi@wolfgreenfield.com
direct dial 617.646.8384

March 17, 2011

VIA E-MAIL AND FIRST CLASS MAIL
Beth.Goldman@orrick.com

Beth M. Goldman
Orrick, Herrington & Sutcliffe LLP
The Orrick Building
405 Howard Street
San Francisco, CA 94105

Re: Bayer Healthcare, LLC v.
Biogen Idec MA, Inc. and Cardiokine Biopharma, LLC
In re U.S. Application Serial No. 77/701134 for LIXALEV
Opposition No. 91192781
Our Ref.: C1346.50000US00

Dear Ms. Goldman:

In follow-up to our March 14, 2011 correspondence, enclosed please find documents to supplement our responses to Bayer's First Request for Production gathered from Biogen Idec.

As you will see, this document is responsive to Bayer's Request No. 8. While Biogen registered the domain names lixalev.com, lixalev.net, lixalev.org, lixalev.biz, and lixalev.info on March 27, 2009, there is no further documentation available because these domain names were registered online. Note that we began our numbering for supplemental documents at A00187.

We are still working with Cardiokine to compile any additional documents that they may have that are responsive to your initial requests. Should Cardiokine uncover any additional relevant information responsive to Bayer's First Request for Production or Bayer's First Set of Interrogatories, we will supplement our responses as necessary.

Very truly yours,

WOLF, GREENFIELD & SACKS, P.C.


Douglas R. Wolf
Christina M. Licursi

CML/smo
Enclosure

EXHIBIT D

Licursi, Christina M.

From: Zellerbach, Thomas H. <tzellerbach@orrick.com>
Sent: Wednesday, October 19, 2011 5:25 PM
To: Licursi, Christina M.
Cc: Goldman, Beth M.; Bush, Chelsea
Subject: Depositions

Christina,

I want to confirm that the deposition of Brand Institute/William Johnson is going forward on October 27, 2011 at Orrick's New York office located at 51 West 52nd Street. It will begin at 10 a.m. EDT.

In addition, we would like to schedule the depositions of both Biogen and Cardiokine for next month. Can you please provide me some dates?

Thanks,

Tom



O R R I C K

THOMAS H. ZELLERBACH

Partner

ORRICK, HERRINGTON & SUTCLIFFE LLP

1000 MARSH ROAD
MENLO PARK, CA 94025-1015

tel (650) 614-7446

fax (650) 614-7401

tzellerbach@orrick.com

www.orrick.com

IRS Circular 230 disclosure: To ensure compliance with requirements imposed by the IRS, we inform you that any tax advice contained in this communication, unless expressly stated otherwise, was not intended or written to be used, and cannot be used, for the purpose of (i) avoiding tax-related penalties under the Internal Revenue Code or (ii) promoting, marketing or recommending to another party any tax-related matter(s) addressed herein.

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Fitzpatrick, April J.

From: Licursi, Christina M.
Sent: Wednesday, October 19, 2011 5:39 PM
To: Zellerbach, Thomas H.
Cc: Goldman, Beth M.; Bush, Chelseaa
Subject: RE: Depositions

Tom-

Thanks for confirming the Oct. 27 date.

As to the depositions of Cardiokine and Biogen, I will check with them on dates and revert back to you shortly.

Kind regards,

Christina

From: Zellerbach, Thomas H. [<mailto:tzellerbach@orrick.com>]
Sent: Wednesday, October 19, 2011 5:25 PM
To: Licursi, Christina M.
Cc: Goldman, Beth M.; Bush, Chelseaa
Subject: Depositions

Christina,

I want to confirm that the deposition of Brand Institute/William Johnson is going forward on October 27, 2011 at Orrick's New York office located at 51 West 52nd Street. It will begin at 10 a.m. EDT.

In addition, we would like to schedule the depositions of both Biogen and Cardiokine for next month. Can you please provide me some dates?

Thanks,

Tom



O R R I C K

THOMAS H. ZELLERBACH

Partner

ORRICK, HERRINGTON & SUTCLIFFE LLP

1000 MARSH ROAD

MENLO PARK, CA 94025-1015

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=====
IRS Circular 230 disclosure: To ensure compliance with requirements imposed by the IRS, we inform you that any tax advice contained in this communication, unless expressly stated otherwise, was not intended or written to be used, and cannot be used, for the purpose of (i) avoiding tax-related penalties under the Internal Revenue Code or (ii) promoting, marketing or recommending to another party any tax-related matter(s) addressed herein.
=====

NOTICE TO RECIPIENT: THIS E-MAIL IS MEANT FOR ONLY THE INTENDED RECIPIENT OF THE TRANSMISSION, AND MAY BE A COMMUNICATION PRIVILEGED BY LAW. IF YOU RECEIVED THIS E-MAIL IN ERROR, ANY REVIEW, USE, DISSEMINATION, DISTRIBUTION, OR COPYING OF THIS E-MAIL IS STRICTLY PROHIBITED. PLEASE NOTIFY US IMMEDIATELY OF THE ERROR BY RETURN E-MAIL AND PLEASE DELETE THIS MESSAGE FROM YOUR SYSTEM. THANK YOU IN ADVANCE FOR YOUR COOPERATION.
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=====

EXHIBIT E

REDACTED

EXHIBIT F

REDACTED

EXHIBIT G

REDACTED

EXHIBIT H

REDACTED

EXHIBIT I

REDACTED

EXHIBIT J



Christina M. Licursi
clicursi@wolfgreenfield.com
direct dial 617.646.8384

November 11, 2011

VIA E-MAIL AND FIRST CLASS MAIL
tzellerbach@orrick.com

Thomas H. Zellerbach, Esq.
Orrick, Herrington & Sutcliffe LLP
The Orrick Building
405 Howard Street
San Francisco, CA 94105

Re: Bayer Healthcare, LLC v.
Biogen Idec MA, Inc. and Cardiokine Biopharma, LLC
In re U.S. Application Serial No. 77/701134 for LIXALEV
Opposition No. 91192781
Our Ref.: C1346.50000US00

Dear Tom:

In follow-up to your e-mail correspondence dated November 9, 2011 and our earlier correspondence regarding the same, we are disappointed by your refusal to agree to our offer to allow Bayer to take the proposed depositions of Biogen and Cardiokine after the close of discovery. We have tried to be accommodating, but we simply cannot consent to any further requests to extend the discovery period.

If you recall, the discovery period originally opened on February 1, 2010. Accordingly, both sides have now had seventeen months to take any necessary discovery. We have been more than reasonable and accommodating throughout this proceeding. In fact, there have already been six requests for extensions of time made with the Board, each of which we have consented to.

With respect to this particular request for an extension, you first contacted us regarding possible depositions of Biogen and Cardiokine on October 19, 2011. Although both parties attended the deposition of the Brand Institute on October 27, you did not raise the issue of possible deposition dates with us at that meeting. In fact, the first substantive correspondence on possible dates came in an e-mail from you dated November 2, where you were already posturing

Thomas H. Zellerbach, Esq.
November 11, 2011
Page 2

for an extension of dates. At that time, we still had one month to iron out dates for depositions and we indicated that it was our strong preference to complete discovery in advance of the November 30 deadline. We confirmed that both of our clients would be available for depositions the week of November 14. In fact, as a measure of our good faith and as an effort to preemptively accommodate scheduling conflicts given the impending close of discovery, we offered to allow you to take these depositions in December after the formal close of the discovery period. We specified that this would not constitute a further extension of discovery generally, but would just be an accommodation of your client's need to complete these two depositions after the formal close of discovery. You allowed four days to pass before responding to our offer.

While you initially indicated that November 15th and 16th could work as possible dates, you finally responded on November 9th that these dates are no longer possible for you. While we agreed to an extension of time insofar as it was limited to the depositions of Biogen and Cardiokine, with twenty days still remaining in the discovery phase, you have nevertheless indicated that you will file another Motion to Extend with the Board. We note that we have yet to receive any formal notices for these depositions and that we are still awaiting lists of subjects for these depositions.

You have now had more than seventeen months to depose either of the defendants in this matter and to complete your discovery. At the very beginning of this proceeding we indicated that our clients were anxious to see this matter resolved as quickly as possible. We have nevertheless continuously been reasonable and cooperative throughout this proceeding, consenting to the extension of dates on multiple occasions. At this time we can only believe that these tactics to continue to extend discovery are attempts to obtain additional time to harass Biogen and Cardiokine and to waste their time and resources. We simply cannot allow this already protracted proceeding to continue ad infinitum. Obviously, we will formally oppose any Motion to Extend that Opposer filed with the Board.

Very truly yours,

WOLF, GREENFIELD & SACKS, P.C.

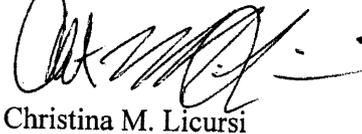

Christina M. Licursi

EXHIBIT K



ORRICK, HERRINGTON & SUTCLIFFE LLP
1000 MARSH ROAD
MENLO PARK, CALIFORNIA 94025-1015
tel +1-650-614-7400
fax +1-650-614-7401
WWW.ORRICK.COM

November 14, 2011

Via E-Mail and U.S. Mail
christina.licursi@wolfgreenfield.com

Thomas H. Zellerbach
(650) 614-7446
tzellerbach@orrick.com

Christina M. Licursi, Esq.
Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, MA 02210-2206

Re: Bayer HealthCare, LLC v. Biogen Idec MA, Inc., et al.

Dear Christina:

In an effort to avoid having to file a motion to extend dates, Bayer HealthCare is willing to depose Cardiokine in Philadelphia on Monday, November 28, 2011, and Biogen IDEC in Boston on Tuesday, November 29, 2011. Accordingly, I am enclosing Notices of Deposition for those depositions. I have noticed the deposition of Biogen IDEC for your office in Boston given your previous offer to hold it there. If that is no longer convenient, please let me know right away and I will provide an alternative address in Boston.

Very truly yours,

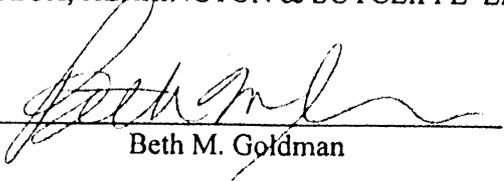
Thomas H. Zellerbach

Enclosures

EXHIBIT L

ORRICK, HERRINGTON & SUTCLIFFE LLP

Dated: November 14, 2011

By: 

Beth M. Goldman

Attorneys for Opposer
405 Howard Street
San Francisco, California 94105
(415) 773-5700

EXHIBIT A

TOPICS FOR EXAMINATION

1. Biogen's responses to Opposer's First Set of Interrogatories, First Set of Requests for Production and First Set of Requests for Admissions to Applicant.
2. Documents produced by Biogen in this proceeding.
3. Biogen's selection of the LIXALEV mark.
4. Any surveys or focus groups regarding the LIXALEV mark.
5. Applications for registration of LIXALEV with any governmental agency in the United States.
6. Advertising and promotional activities and plans relating to the LIXALEV mark.
7. The channels of trade for the product Biogen and/or Cardiokine Biopharma, LLC ("Cardiokine") intend to market under the LIXALEV mark.
8. Products and the packaging for those products that Biogen and/or Cardiokine intend to market under the LIXALEV mark.
9. Development and testing of the products that Biogen and/or Cardiokine intend to market under the LIXALEV mark.
10. Characteristics of purchasers or intended purchasers of the goods to be offered under the LIXALEV mark.
11. Use or future plans for use of the LIXALEV mark.
12. The identity of all witnesses Biogen intends to call at trial on this matter and the topics about which they will testify.
13. All facts Biogen intends to rely upon, if any, in order to demonstrate that there is no likelihood of confusion between ALEVE on one hand, and LIXALEV, on the other.
14. All facts Biogen intends to rely upon, if any, in order to demonstrate that use of the LIXALEV mark is not likely to cause dilution of the ALEVE mark.
15. Communications with Brand Institute, Inc.
16. The safety and efficacy of lixivaptan.
17. Filings with and responses from the US Federal Drug Administration and the European Medicines Agency regarding the LIXALEV mark.

CERTIFICATE OF SERVICE

I certify that a copy of the foregoing NOTICE OF DEPOSITION OF BIOGEN IDEC MA INC. PURSUANT TO RULE 30(b)(6) was served by First Class U.S. mail, on November 14, 2011, on Biogen's counsel at the following address:

Douglas R. Wolf
Christina M. Licursi
Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, MA 02210

Dated: November 14, 2011

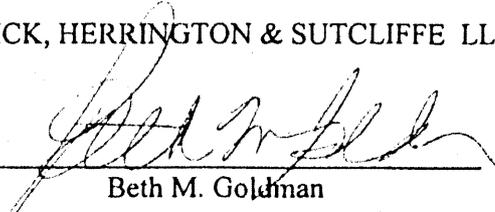


Karin Barnick

EXHIBIT M

ORRICK, HERRINGTON & SUTCLIFFE LLP

Dated: November/4, 2011

By: 

Beth M. Goldman

Attorneys for Opposer
405 Howard Street
San Francisco, California 94105
(415) 773-5700

EXHIBIT A

TOPICS FOR EXAMINATION

1. Applicants' responses to Opposer's First Set of Interrogatories, First Set of Requests for Production and First Set of Requests for Admissions to Applicant.
2. Documents produced by Applicants in this proceeding.
3. Applicants' selection of the LIXALEV mark.
4. Any surveys or focus groups regarding the LIXALEV mark.
5. Applications for registration of LIXALEV with any governmental agency in the United States.
6. Advertising and promotional activities and plans relating to the LIXALEV mark.
7. The channels of trade for the products Cardiokine intends to market under the LIXALEV mark.
8. Products and the packaging for those products that Cardiokine intends to market under the LIXALEV mark.
9. Development and testing of the products that Cardiokine intends to market under the LIXALEV mark.
10. Characteristics of purchasers or intended purchasers of Cardiokine's goods to be offered under the LIXALEV mark.
11. Use or future plans for use of the LIXALEV mark.
12. The identity of all witnesses Cardiokine intends to call at trial on this matter and the topics about which they will testify.
13. All facts Cardiokine intends to rely upon, if any, in order to demonstrate that there is no likelihood of confusion between ALEVE on one hand, and LIXALEV, on the other.
14. All facts Cardiokine intends to rely upon, if any, in order to demonstrate that use of the LIXALEV mark is not likely to cause dilution of the ALEVE mark.
15. Communications with Brand Institute, Inc.
16. The safety and efficacy of lixivaptan.
17. Filings with and responses from the US Federal Drug Administration and the European Medicines Agency regarding the LIXALEV mark.

CERTIFICATE OF SERVICE

I certify that a copy of the foregoing NOTICE OF DEPOSITION OF CARDIOKINE BIOPHARMA, LLC PURSUANT TO RULE 30(b)(6) was served by First Class U.S. mail, on November 14, 2011, on Cardiokine's counsel at the following address:

Douglas R. Wolf
Christina M. Licursi
Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, MA 02210

Dated: November 14, 2011



Karin Barnick

EXHIBIT N

Licursi, Christina M.

From: Licursi, Christina M.
Sent: Friday, November 18, 2011 11:35 AM
To: 'Zellerbach, Thomas H.'
Cc: 'Barnick, Karin'
Subject: RE: Bayer HealthCare, LLC v. Biogen Idec MA, Inc., et al.

Importance: High

Tom-

Can you confirm that these arrangements are acceptable?

Thanks,

Christina

From: Licursi, Christina M.
Sent: Wednesday, November 16, 2011 1:48 PM
To: Zellerbach, Thomas H.
Cc: 'Barnick, Karin'
Subject: RE: Bayer HealthCare, LLC v. Biogen Idec MA, Inc., et al.

Tom-

I can now confirm that we can do the depositions on the 28th and 29th. Note, however, that we will need to do both of the depositions here in Boston (at our offices) and that Cardiokine will need to be deposed on November 29, 2011 and Biogen on November 28, 2011.

Regards,

Christina

From: Barnick, Karin [<mailto:kbarnick@orrick.com>]
Sent: Monday, November 14, 2011 8:36 PM
To: Licursi, Christina M.
Cc: Zellerbach, Thomas H.
Subject: Bayer HealthCare, LLC v. Biogen Idec MA, Inc., et al.

Dear Ms. Licursi,

Please see the attached documents from Mr. Zellerbach.

Thank you.


ORRICK
KARIN BARNICK
Legal Secretary

EXHIBIT O

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

In the Matter of Application Serial No. 77/701134
Published in the *Official Gazette* on July 28, 2009
Trademark: LIXALEV

Bayer HealthCare LLC,
Opposer,

v.

Biogen Idec MA Inc. and
Cardiokine Biopharma, LLC,
Applicants.

**NOTICE OF DEPOSITION OF
BIOGEN IDEC MA INC.
PURSUANT TO RULE
30(B)(6)**

Opposition No.: 91192781

PLEASE TAKE NOTICE that, pursuant to Federal Rule of Civil Procedure 30(b)(6), Bayer HealthCare LLC (“Bayer”) will take the deposition upon oral examination of Biogen Idec MA Inc. (“Biogen”), commencing on November 28, 2011 at 9:30 a.m., at Wolf, Greenfield & Sacks, P.C., 600 Atlantic Avenue, Boston, Massachusetts, or at such other time and place as may be mutually agreed upon by counsel, and continuing from day to day thereafter.

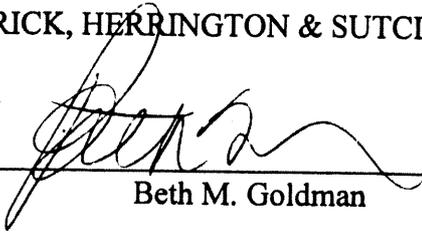
The deposition will be taken by stenographic means before a person authorized to administer oaths. Attorneys may also use equipment providing for simultaneous stenography during the deposition.

Pursuant to Fed. R. Civ. P. 30(b)(6), Biogen is notified that it must designate one or more officers, directors, managing agents, employees or other persons who are most qualified to testify on its behalf as to the matters set forth in Exhibit A attached hereto. Said deposition will commence at the above date and time and continue from day to day thereafter, Saturdays, Sundays, and holidays excepted, until completed by the noticing party.

ORRICK, HERRINGTON & SUTCLIFFE LLP

Dated: November 21, 2011

By: _____


Beth M. Goldman

Attorneys for Opposer
405 Howard Street
San Francisco, California 94105
(415) 773-5700

EXHIBIT A

TOPICS FOR EXAMINATION

1. Biogen's responses to Opposer's First Set of Interrogatories, First Set of Requests for Production and First Set of Requests for Admissions to Applicant.
2. Documents produced by Biogen in this proceeding.
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6. Advertising and promotional activities and plans relating to the LIXALEV mark.
7. The channels of trade for the product Biogen and/or Cardiokine Biopharma, LLC ("Cardiokine") intend to market under the LIXALEV mark.
8. Products and the packaging for those products that Biogen and/or Cardiokine intend to market under the LIXALEV mark.
9. Development and testing of the products that Biogen and/or Cardiokine intend to market under the LIXALEV mark.
10. Characteristics of purchasers or intended purchasers of the goods to be offered under the LIXALEV mark.
11. Use or future plans for use of the LIXALEV mark.
12. The identity of all witnesses Biogen intends to call at trial on this matter and the topics about which they will testify.
13. All facts Biogen intends to rely upon, if any, in order to demonstrate that there is no likelihood of confusion between ALEVE on one hand, and LIXALEV, on the other.
14. All facts Biogen intends to rely upon, if any, in order to demonstrate that use of the LIXALEV mark is not likely to cause dilution of the ALEVE mark.
15. Communications with Brand Institute, Inc.
16. The safety and efficacy of lixivaptan.
17. Filings with and responses from the US Federal Drug Administration and the European Medicines Agency regarding the LIXALEV mark.

CERTIFICATE OF SERVICE

I certify that a copy of the foregoing NOTICE OF DEPOSITION OF BIOGEN IDEC MA INC. PURSUANT TO RULE 30(b)(6) was served by First Class U.S. mail, on November 21, 2011, on Biogen's counsel at the following address:

Douglas R. Wolf
Christina M. Licursi
Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, MA 02210

Dated: November 21, 2011

By: ORRICK, HERRINGTON & SUTCLIFFE LLP



Chelsea Bush

Attorneys for Opposer
405 Howard Street
San Francisco, California 94105
(415) 773-5700

EXHIBIT P

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

In the Matter of Application Serial No. 77/701134
Published in the *Official Gazette* on July 28, 2009
Trademark: LIXALEV

<p>Bayer HealthCare LLC, Opposer, v. Biogen Idec MA Inc. and Cardiokine Biopharma, LLC, Applicants.</p>	<p>NOTICE OF DEPOSITION OF CARDIOKINE BIOPHARMA, LLC PURSUANT TO RULE 30(B)(6)</p> <p>Opposition No.: 91192781</p>
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PLEASE TAKE NOTICE that, pursuant to Federal Rule of Civil Procedure 30(b)(6), Bayer HealthCare LLC (“Bayer”) will take the deposition upon oral examination of Cardiokine Biopharma, LLC (“Cardiokine”), commencing on November 29, 2011 at 9:30 a.m., at Wolf, Greenfield & Sacks, P.C., 600 Atlantic Avenue, Boston, Massachusetts, or at such other time and place as may be mutually agreed upon by counsel, and continuing from day to day thereafter.

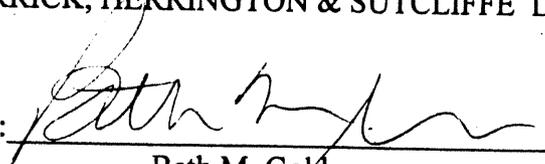
The deposition will be taken by stenographic means before a person authorized to administer oaths. Attorneys may also use equipment providing for simultaneous stenography during the deposition.

Pursuant to Fed. R. Civ. P. 30(b)(6), Cardiokine is notified that it must designate one or more officers, directors, managing agents, employees or other persons who are most qualified to testify on its behalf as to the matters set forth in Exhibit A attached hereto. Said deposition will commence at the above date and time and continue from day to day thereafter, Saturdays, Sundays, and holidays excepted, until completed by the noticing party.

ORRICK, HERRINGTON & SUTCLIFFE LLP

Dated: November 21, 2011

By:



Beth M. Goldman

Attorneys for Opposer
405 Howard Street
San Francisco, California 94105
(415) 773-5700

EXHIBIT A

TOPICS FOR EXAMINATION

1. Applicants' responses to Opposer's First Set of Interrogatories, First Set of Requests for Production and First Set of Requests for Admissions to Applicant.
2. Documents produced by Applicants in this proceeding.
3. Applicants' selection of the LIXALEV mark.
4. Any surveys or focus groups regarding the LIXALEV mark.
5. Applications for registration of LIXALEV with any governmental agency in the United States.
6. Advertising and promotional activities and plans relating to the LIXALEV mark.
7. The channels of trade for the products Cardiokine intends to market under the LIXALEV mark.
8. Products and the packaging for those products that Cardiokine intends to market under the LIXALEV mark.
9. Development and testing of the products that Cardiokine intends to market under the LIXALEV mark.
10. Characteristics of purchasers or intended purchasers of Cardiokine's goods to be offered under the LIXALEV mark.
11. Use or future plans for use of the LIXALEV mark.
12. The identity of all witnesses Cardiokine intends to call at trial on this matter and the topics about which they will testify.
13. All facts Cardiokine intends to rely upon, if any, in order to demonstrate that there is no likelihood of confusion between ALEVE on one hand, and LIXALEV, on the other.
14. All facts Cardiokine intends to rely upon, if any, in order to demonstrate that use of the LIXALEV mark is not likely to cause dilution of the ALEVE mark.
15. Communications with Brand Institute, Inc.
16. The safety and efficacy of lixivaptan.
17. Filings with and responses from the US Federal Drug Administration and the European Medicines Agency regarding the LIXALEV mark.

CERTIFICATE OF SERVICE

I certify that a copy of the foregoing NOTICE OF DEPOSITION OF CARDIOKINE BIOPHARMA, LLC PURSUANT TO RULE 30(b)(6) was served by First Class U.S. mail, on November 21, 2011, on Cardiokine's counsel at the following address:

Douglas R. Wolf
Christina M. Licursi
Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, MA 02210

Dated: November 21, 2011



Chelsea Bush

EXHIBIT Q

C

2004 WL 725459 (Trademark Tr. & App. Bd.)

THIS OPINION IS NOT CITABLE AS PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board
Patent and Trademark Office (P.T.O.)TONI & GUY (USA) LIMITED
v.
ARDELL NELSON

Cancellation No. 92040118

March 30, 2004

Before Walters, Rogers, and Drost
Administrative Trademark Judges

By the Board:

There are now a number of interlocutory matters that have arisen in this case and which must be resolved prior to trial. However, to provide necessary context for our discussion and disposition of these matters, a review of the involved registrations, claims and defenses will be helpful.

Respondent and counterclaim plaintiff Ardell Nelson [respondent] is the current owner of Registration No. 2,198,699, issued October 20, 1998, for the mark ESSENSUALS in typed form. Respondent's registration, which issued on October 20, 1998 to respondent's predecessor, Canyon Global Corporation [Canyon], covers "skin care products, namely, skin moisturizers and skin cleansers, and hair shampoos" in International Class 3.^[FN1]

Petitioner and counterclaim defendant Toni & Guy (USA) Limited [petitioner] also has a registration for the mark ESSENSUALS, Registration No. 2,367,309^[FN2], which covers "shampoo, hair conditioner, and spray gel for hair care professionals" in International Class 3. Office records indicate that it issued to TIGI Linea, Inc. on July 18, 2000. Assignment Branch records indicate that this registration was assigned from TIGI Lines, Inc. to petitioner on December 14, 2000. (Reel 2225, Frame 0783) For purposes of this decision, we accept as true that petitioner owns registration 2,367,309 and that either the designation of the original registrant (TIGI Linea) or the assignor listed in Assignment Branch records (TIGI Lines) includes a typographical error (i.e., Linea should be Lines, or vice versa).

There is a story behind how the USPTO came to issue two registrations for the same mark, each covering, inter alia, shampoo, to different parties. However, it is immaterial to the resolution of the motions now pending before us.

On October 31, 2001, after two of its applications for additional registrations of the ESSENSUALS mark^[FN3] were refused because of respondent's registration, petitioner petitioned to cancel that registration. The sole ground asserted in the petition is

that respondent has abandoned his mark pursuant to §14 of the Trademark Act, 15 U.S.C. §1064. Petitioner asserts that respondent's mark is no longer being used in interstate commerce and that Canyon Global Corporation "appears to have dissolved its business." Although petitioner does not state a claim under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in the petition to cancel, petitioner asserts that "a cloud" is placed on petitioner's title in and to its own registration for the ESSENCIALS mark.

*2 In his answer to the petition to cancel, respondent claims ownership of Registration No. 2,198,699 and "admits that Registration No. 2,198,699 was issued on October 20, 1998 to Canyon Global Corporation, which was [respondent] Nelson's predecessor-in-interest..." Respondent further admits that Canyon Global Corporation was dissolved on or about December 3, 1999. Respondent denies all other salient allegations in petitioner's petition. In addition, respondent asserts a counterclaim under Section 2(d) of the Trademark Act for cancellation of petitioner's pleaded Registration No. 2,367,309.

Petitioner's answer to the counterclaim denies all salient allegations therein. As affirmative defenses, petitioner asserts that the counterclaim is barred by the doctrines of laches and acquiescence, and that respondent does not have standing to seek cancellation of petitioner's registration.

Now ready for consideration are the following contested matters:

- (1) a March 27, 2003 motion by petitioner for summary judgment dismissing the counterclaim;
- (2) an April 1, 2003 motion by respondent to compel responses by petitioner to interrogatories;
- (3) an April 1, 2003 motion by respondent to compel responses by petitioner to respondent's requests for production of documents;
- (4) an April 1, 2003 motion by respondent to reopen discovery for the limited purpose of deposing a more "knowledgeable" Rule 30(b)(6) witness of petitioner; and,
- (5) petitioner's April 16, 2003 and April 17, 2003 motions for a protective order.

Inasmuch as the motion for summary judgment is potentially dispositive of the counterclaim in this proceeding, we shall address that motion first.

I. PETITIONER'S MOTION FOR SUMMARY JUDGMENT ON RESPONDENT'S COUNTERCLAIM AGAINST REG. NO. 2,367,309

It is well settled that the burden falls on the party moving for summary judgment to demonstrate the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. Fed. R. Civ. P. 56(c). See also, Celotex Corp. v. Catrett, 477 U.S. 317 (1986). The evidence of record and any inference which may be drawn from the underlying undisputed facts must be viewed in the light most favorable to the non-moving party. See Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). In considering the propriety of summary judgment, the Board may not resolve issues of material fact against the non-moving party; it may only ascertain whether such issues are present. See Opryland USA, Inc. v. Great American Music Show, Inc., 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1993); and Lloyd's Food Products Inc. v. Eli's Inc., 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993).

*3 Petitioner has moved for summary judgment dismissing respondent's Section 2(d) counterclaim on the basis that there is no likelihood of confusion and, in the alternative, on the basis of petitioner's affirmative defenses of laches and acquiescence. There is no formal cross-motion for summary judgment by respondent, on his counterclaim or petitioner's affirmative defenses thereto, and we decline respondent's invitation, included in his response to petitioner's motion, to enter summary judgment for respondent on the counterclaim.^[FN4] Moreover, for reasons we will discuss, entry of summary judgment on the counterclaim, for either party, seems to us quite premature until the question of whether respondent has abandoned its registered mark, for all the listed goods, or even just for shampoo, is settled.

In support of its motion on the likelihood of confusion issue, petitioner argues that there are no genuine issues of material fact that: the parties' marks are dissimilar; the parties' goods are "very distinguishable"; the goods at issue move in distinctly different channels of trade; there is no evidence of actual confusion; the parties' products are purchased by sophisticated and

discriminating purchasers; respondent has not used its mark on shampoos and petitioner has not used its mark on skin care or cosmetics and has no plans to do so; and "there is no likelihood that either party will 'bridge the gap' between the actual uses of their marks."

As evidence on the likelihood of confusion issue, petitioner submits a statement of undisputed facts, photocopies of status and title copies of the parties' respective registrations, portions of a discovery deposition of respondent Ardell H. Nelson, portions of the discovery deposition of petitioner's representative Tamara Dickerson, portions of respondent's responses to petitioner's written discovery requests, and portions of petitioner's responses to respondent's requests for admission.

It is readily apparent that petitioner is not entitled to summary judgment finding no likelihood of confusion, given that the involved marks are identical and each of the respective identifications of goods includes an identical item, specifically shampoo. While petitioner's identification is restricted as to channels of trade, respondent's identification is not and, therefore, respondent's shampoo must be presumed to travel in all possible channels of trade, including that utilized by petitioner. See Octocom Systems Inc. v. Houston Computer Services, Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (Board's comparison of the parties' goods is limited to consideration of the identifications set forth in the respective registrations) and Interstate Brand Corp. v. McKee Foods Corp., 53 USPQ2d 1910, 1913 (TTAB 2000).

From the thrust of petitioner's argument and evidentiary submissions, it is apparent that the real basis for its argument that there is no likelihood of confusion is predicated on the alleged fact that respondent does not use his mark, indeed, according to petitioner, has never used his mark, for shampoo.^[FN5] Therefore, petitioner's view of the likelihood of confusion analysis is very definitely colored by its conclusion that the question of likelihood of confusion must be focused on petitioner's hair care products for professionals and respondent's skin care products. Of course, we cannot adopt such a view so long as shampoo remains an item listed in respondent's registration. That is why we find it premature for petitioner to be arguing that it is entitled to a judgment that there is no likelihood of confusion without first establishing that it is entitled to judgment on its claim of abandonment.^[FN6]

*4 In short, petitioner has failed to carry its burden as the moving party seeking summary judgment dismissing respondent's counterclaim on the theory that no likelihood of confusion is possible. Since we decline respondent's informal invitation to consider finding no genuine dispute that there is a likelihood of confusion and, therefore, to enter summary judgment granting the counterclaim, we need not consider respondent's arguments in any detail. We do note, however, that, at a minimum, the existence of petitioner's claim that respondent has abandoned use of its mark for shampoo presents a genuine issue of disputed fact and, if the claim were proven, that very well might undermine respondent's counterclaim. Accordingly, even if we were to have accepted respondent's informal invitation and considered in detail the question whether to enter summary judgment in respondent's favor on its counterclaim, we would find genuine issues of disputed fact precluding any grant of summary judgment.

As noted above, petitioner moves, in the alternative, for summary judgment dismissing the counterclaim on its affirmative defenses of laches and acquiescence. We find that summary judgment on these defenses is inappropriate.

With respect to laches, the mere passage of time does not constitute laches. Advanced Cardiovascular Systems v. SciMed Life Systems, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993). Rather, a *prima facie* defense of laches requires a showing of (1) unreasonable delay in asserting one's rights against another, and (2) material prejudice to the latter as a result of the delay. Lincoln Logs Ltd. v. Lincoln Pre-cut Log Homes, Inc., 971 F.2d 732, 23 USPQ2d 1701, 1703 (Fed. Cir. 1992). In the context of a trademark opposition or cancellation proceeding, this defense must be tied to a party's registration of a mark rather than to its use of the mark. National Cable Television Assoc., Inc. v. American Cinema Editors, Inc., 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991). This is so even when the party against whom the defense is asserted can be shown to have been aware of its adversary's pending application to register a mark.

It might be expected that respondent, if he was aware of petitioner's application for registration for the identical mark for, in part, the identical goods, would have monitored and opposed the application. Nonetheless, the clock for laches does not begin

to run until a mark is published for opposition and the Trademark Act provides that a party may petition to cancel a mark for up to five years on any ground that might have been asserted in an opposition. See *National Cable, supra*; see also, Section 14(1) of the Trademark Act, 15 U.S.C. §1064(1). Plainly, then, petitioner has failed to prove that it is entitled to summary judgment dismissing the counterclaim on its affirmative defense of laches.^[FN7]

*5 Likewise, petitioner has failed to prove that it is entitled to summary judgment dismissing the counterclaim on its affirmative defense of acquiescence or, to the extent asserted, equitable estoppel. Proof of an affirmative defense of acquiescence or estoppel requires proof of an affirmative act or misleading conduct by the party against whom the defense is asserted, with such act or conduct signaling to the adverse party that its use and/or registration of a mark would not be challenged. See *Lincoln Logs, supra*, as to the elements of proof for equitable estoppel; see also *DAK Industries Inc. v. Daiichi Kosho Co. Ltd.*, 25 USPO2d 1622 (TTAB 1992) (acquiescence requires some affirmative act). Petitioner, in its motion for summary judgment, includes no clear statement regarding any affirmative act or misleading conduct by respondent that would be sufficient to support a defense of acquiescence or equitable estoppel. Accordingly, we find that petitioner has failed to prove that it is entitled to summary judgment on its alternate theory of acquiescence or equitable estoppel.

Petitioner's motion for summary judgment is, therefore, denied on each of its alternative bases.

II. DISCOVERY MOTIONS BETWEEN THE PARTIES

We turn now to the three discovery motions filed by respondent on April 1, 2003 which have been separately and fully briefed. As we consider these motions and petitioner's objections thereto, it is necessary for us to make threshold determinations regarding whether respondent's motions are, as petitioner argues, "untimely" and whether respondent has met the "good faith" requirement of Trademark Rule 2.120(e)(1).

Looking to petitioner's responsive briefs on the discovery motions, petitioner contends that each of these motions are "untimely" insofar as respondent has unreasonably delayed in seeking redress for the alleged inadequate discovery responses. See TBMP §523.03 (2d Edition, June 2003). Inasmuch as petitioner concedes that "it does appear [respondent's motions were] filed the day before [petitioner's] first testimony period", petitioner is not really arguing that respondent's motion are untimely *per se*. Rather, the essence of petitioner's argument is that respondent, having unreasonably delayed in seeking redress for perceived insufficient discovery responses, has waived his right to obtain the relief requested.

Petitioner's argument is unsupported by the record. A review of the record reveals that: the deadline for petitioner's responses to respondent's written discovery requests was extended until August 16, 2002; that petitioner's responses and supplemental responses to respondent's various written discovery requests nonetheless were not served until October 23, 2002, November 1, 2002, November 12, 2002, and March 4, 2003, respectively; that around January 8, 2003, the parties began negotiating a protective agreement and a draft was sent to petitioner; that the deposition of Ms. Tamara Dickerson, petitioner's Rule 30(b)(6) designee was not taken until March 4, 2003; and that despite prior discussions between the parties' counsel, petitioner did not return the draft protective order, marked up with petitioner's proposed modifications, until March 19, 2003. Respondent's discovery motions then were filed March 28, 2003. We find that respondent did not unreasonably delay in filing its motions.

*6 Moreover, we reject petitioner's argument that respondent has failed to make a good faith effort to resolve his discovery dispute without the Board's intervention in accordance with Fed. R. Civ. P. 26(g) and Trademark Rule 2.120(e)(1). See also TBMP §523.02 (2d. Edition, June 2003). We are reluctant to deny respondent's motions for failure to comply with the "good faith" requirement where, as here, the parties were engaged in discovery activities well past the close of discovery and the movant was faced with the imminent opening of trial, so that it did not have the luxury of extended negotiations with petitioner. Under these circumstances, we find respondent's March 28, 2003 attempt to telephone petitioner prior to filing the motion a sufficient attempt to negotiate the issues set forth in his motions.^[FN8]

As we review the briefs filed on respondent's three discovery motions, petitioner in its responses "requests that the Board enter a protective order denying" respondent's motions to compel. In several instances, petitioner has objected to providing full and complete responses to respondent's written discovery requests on grounds that the information sought is confidential.

As mentioned above, the record shows that the parties have an ongoing dispute over the terms of an agreement for the protection of confidential information revealed during the course of this proceeding. In the Official Gazette of June 20, 2000, the Board published a standard protective order that may be imposed in an appropriate situation. Given the parties' failure to reach an agreement without Board intervention, it is adjudged appropriate in this instance for the standard Board protective order to be imposed, and accordingly, an executed order is attached. The parties are free to modify or amend the terms of this protective order by mutual agreement, subject to Board approval.^[FN9] Absent agreement on, and filing of, an amended order, the Board order shall govern terms of production of confidential material.

We turn our attention now to the specific issues raised by each of respondent's discovery motions.

A. RESPONDENT'S MOTION TO COMPEL PETITIONER'S RESPONSES TO RESPONDENT'S INTERROGATORY REQUESTS

By way of background, we observe that on June 13, 2002 respondent served its first set of interrogatories on petitioner. Petitioner's responses were originally due by July 18, 2002; however, respondent agreed to enlarge petitioner's time for response until August 16, 2002. Petitioner served its responses with objections on November 12, 2002, three months after expiration of its time for response. Respondent has moved to compel supplemental responses, without objection, by petitioner to Interrogatory Request Nos. 1, 4(c), 11, 13, 14, 15, and 18. Respondent asserts that petitioner, by filing a late response, has waived its right to object to these interrogatory requests.

*7 In response to the motion, petitioner argues that the three month delay in serving its discovery responses should be excused because "[d]uring this period, the parties were engaged in potential settlement discussions and in efforts to minimize the costs associated with discovery, [petitioner] served its responses ... after the initial round of settlement discussions collapsed..."

Respondent counters this argument, stating that petitioner is without factual basis for assuming that the parties' settlement activities had suspended petitioner's obligation to timely respond to his discovery requests. Respondent asserts that "while [petitioner] was allegedly engaged in potential settlement discussions and attempting to minimize costs associated with discovery, [petitioner] still continued to serve respondent with discovery requests" and respondent was fully and timely complying with these discovery requests. As evidence of the simultaneous nature of the parties' discovery and settlement activities, respondent submits as Exhibits D and E to his reply brief copies of letters between between the parties' counsel during the period in question.

In a Board proceeding, a party is under an obligation to respond to an adversary's request for discovery during the time allowed therefor. See TBMP §403.03 (2d. Edition, June 2003). A party which fails to respond to a request for discovery during the time allowed therefor, and which is unable to show that its failure was the result of excusable neglect^[FN10], may be found, upon motion to compel filed by the propounding party, to have forfeited its right to object to the discovery request on its merits. See *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000). See also TBMP §405.04(a), footnote 139 and cases cited therein.

Based on the record before us, we find respondent's motion to compel interrogatory responses, overall, to be well founded and that petitioner has not demonstrated excusable neglect for its failure to timely respond. Exhibits D and E to respondent's reply brief unequivocally refute petitioner's implicit view that the parties' settlement activities had effected a de facto suspension of their discovery activities and obligations. Moreover, there is no evidence of confusion in the record over the deadline for response. See Exhibit E to respondent's reply brief.

Accordingly, respondent's motion to compel interrogatory responses is granted to the extent that petitioner is allowed thirty days from the mailing date hereof to serve its full and complete supplemental interrogatory responses to Nos. 1, 4(c), 11, 13, 14, and 15 without objection and in accordance with the following discussion. Petitioner may, however, provide responses which contain confidential information in accordance with the terms of the protective order imposed by this order.

*8 We also make the following observations. Annual sales and advertising figures may be stated in round numbers. See *Varian*

Associates v. Fairfield-Noble Corp., 188 USPQ 581, 583 (TTAB 1975); see also TBMP §414(18) (2d. Edition, June 2003). The identity of any advertising agency engaged by petitioner to advertise and promote petitioner's involved goods under its involved mark are discoverable. See J.B. Williams Co. v. Pepsodent G.m.b.H., 188 USPQ 577, 580 (TTAB 1975); see also TBMP §414(17) (2d. Edition, June 2003).

Petitioner's supplemental response to Request No. 15 should clearly and accurately set forth the requested information regarding all skin care products offered for sale by petitioner. It is wholly inappropriate and non-responsive for petitioner, in its response, to have referred generally to a web-site address (which respondent claims is "nonexistent") and to all documents produced by petitioner herein. Cf. In re Planalytics, Inc., ___ USPQ2d ___ (TTAB, March 30, 2004) (Application Serial No. 76322156).

With respect to Request No. 18 regarding support for petitioner's allegations of infringement, we deny the motion to compel. The Board is without jurisdiction to resolve questions of infringement and accordingly, discovery on this issue would be pointless. See Paramount Pictures Corp. v. White, 31 USPQ2d 1768, 1771 n.5 (TTAB 1999); see also TBMP §102.01 (2d. Edition, June 2003).

B. RESPONDENT'S MOTION TO COMPEL PETITIONER'S RESPONSES TO RESPONDENT'S REQUESTS FOR PRODUCTION OF DOCUMENTS

As in the case of the interrogatory responses, respondent served its first requests for production of documents on petitioner on June 13, 2002. Responses to the document requests were initially due by July 18, 2002; however, respondent agreed to enlarge petitioner's time for response until August 16, 2002. Petitioner's responses with objections were served two months later, on October 23, 2002, and supplemental responses were served on November 1, 2002 and again, on March 4, 2003.

Unhappy with petitioner's continued failure to provide responses to Request Nos. 21, 22, 27, 28, 30, and 31, respondent filed his motion to compel supplemental production. By his motion, respondent repeats his assertion that petitioner, by filing late and incomplete answers to these document requests, has waived its right to object thereto.

For the most part, petitioner's objections and its responsive brief on the motion and respondent's reply brief mirror the arguments set forth in relation to the motion to compel interrogatory responses. For the same reasons set forth above, we find that petitioner has failed to establish excusable neglect for its failure to timely respond to respondent's document requests. See No Fear Inc. v. Rule, 54 USPQ2d at 1554 (TTAB 2000). See also TBMP §405.04(a), footnote 139 and cases cited therein.

*9 Accordingly, respondent's motion to compel production is granted to the extent that petitioner is allowed thirty days from the mailing date hereof to serve its full and complete supplemental responses to Document Request Nos. 21, 22, 27, 28, and 31 without objection and in accordance with the following discussion. Petitioner's responses to request Nos. 21, 22 and 27 may be served in accordance with the terms of the Board's standard Protective order. In addition, as to Request Nos. 21 and 22, petitioner shall produce documents in response to these requests to the extent related to United States applications or registrations only.

With respect to Request No. 30 regarding petitioner's pleaded infringement allegation, respondent's motion to compel is denied. For the reasons previously discussed, we decline to compel discovery on the issue of infringement herein. Of course, we also will not hear, at trial, claims relating to infringement rather than the right to registration.

Turning to Request No. 31, we note that information concerning litigation and controversies including settlement and other contractual agreements between a responding party and third parties based on the responding party's involved mark is discoverable. See, e.g., Johnston Pump/General Valve Inc. v. Chromalloy American Corp., 10 USPQ2d 1671, 1675 (TTAB 1988). See also TBMP §414(10) (2d. Edition, June 2003). Nonetheless, we recognize petitioner's objection on the ground of attorney-client privilege, attorney work product, and confidentiality. Accordingly, petitioner shall produce all documents responsive to this request in accordance with the Board's standard Protective Order. Further, with respect to a legal proceeding, the only information which must be provided is the names of the parties thereto, the jurisdiction, the proceeding number, the outcome of

the proceeding, and the citation of the decision, if published.

C. RESPONDENT'S MOTION TO REOPEN DISCOVERY FOR THE PURPOSE OF TAKING A DISCOVERY DEPOSITION OF PETITIONER'S WITNESS UNDER RULE 30(B)(6)

Respondent, on January 17, 2003, served its first notice of Rule 30(b)(6) deposition on petitioner, scheduling the deposition for January 28, 2003, the last day of discovery. This deposition was twice renoticed and rescheduled to be taken after the close of discovery by mutual agreement of the parties. The deposition of petitioner's Rule 30(b)(6) designee, Ms. Tamara Dickerson eventually was taken on March 4, 2003.

Respondent has moved that the Board compel petitioner to produce one or more additional Rule 30(b)(6) witnesses competent to testify on the topics listed in respondent's deposition notices and that the Board reopen discovery for the limited purposes of deposing such witness(es). In support of its motion, respondent submits a copy of Ms. Dickerson's deposition transcript.

Respondent asserts that Ms. Dickerson was unprepared for the deposition, was not knowledgeable to testify on all of the matters identified in the deposition notice, and accordingly was not competent to serve as petitioner's sole designee. Relying on Fed. R. Civ. P. 30(b)(6), respondent argues that where, as here, no single person is competent to testify on all of the topics listed in the notice, it is the responsibility of the corporation to prepare the proffered witness and/or to designate more than one representative.

*10 Petitioner argues that respondent's motion should be denied insofar as respondent has failed to show that petitioner's designee, Ms. Dickerson was legally unqualified or incompetent as a Rule 30(b)(6) witness. Petitioner states that Ms. Dickerson, as petitioner's Vice President of Risk Management for the Department of Insurance and Legal Affairs, is the corporate officer responsible for petitioner's trademark procurement and enforcement. As such, petitioner argues, Ms. Dickerson was the appropriate Rule 30(b)(6) representative for petitioner. See declaration of Tamara Dickerson, Exhibit C attached to petitioner's response brief.

Petitioner claims that respondent's complaints regarding Ms. Dickerson's lack of knowledge pertain mostly to matters that were not germane to the issues in this proceeding, were not topics identified in the deposition notice, and/or were "not in Ms. Dickerson's realm of knowledge as the corporate representative of" petitioner. Petitioner further contends that "respondent's failure to elicit desirous testimony from Ms. Dickerson is not an appropriate ground to reopen the discovery period" to take additional depositions.

Petitioner accuses respondent of "dilatatory" conduct insofar as respondent delayed until the waning days of discovery to serve on petitioner the notice of deposition under Rule 30(b)(6). Additionally, petitioner argues that respondent had ample opportunity during discovery to notice the deposition of other individuals identified by petitioner in its November 12, 2003 discovery responses, but voluntarily chose not to do so.

In reply, respondent recites seven topics that were set forth in respondent's initial and amended deposition notices under Rule 30(b)(6). Respondent reiterates his argument that Ms. Dickerson was neither qualified to discuss these topics nor had taken reasonable steps or measures to acquire the necessary information to be able to testify with respect to each of the seven noticed topics as required by Rule 30(b)(6).

The broad question before us is whether to reopen the discovery period in this proceeding for the purposes of taking additional Rule 30(b)(6) depositions. However, the narrower question, which we address as a threshold matter, is whether to compel petitioner to produce additional Rule 30(b)(6) witnesses in this proceeding. We are not persuaded that additional Rule 30(b)(6) depositions are warranted under the circumstances.

We note that TBMP §527.01(e) provides an adequate remedy to respondent under these set of circumstances. TBMP §527.01(e)(1) states that:

*11 a party which responds to a request for discovery by indicating that it does not have the information sought, or by

stating objections thereto, may be barred by its own action from later introducing the information sought in the request as part of its evidence on the case, providing that the propounding party raises the matter by objecting to the evidence in question on that ground, and preserves the objection in its brief on the case.

Respondent thus is entitled to invoke the doctrine of estoppel if petitioner seeks to introduce into evidence on the case any information previously withheld by Ms. Dickerson or otherwise not provided by petitioner during its Rule 30(b)(6) discovery deposition. Having been notified of inadequacies in its designee's testimony, petitioner acts at its own peril in objecting to the taking of additional Rule 30(b)(6) depositions by witnesses who might have more complete knowledge.

Inasmuch as we find that further Rule 30(b)(6) depositions are not appropriate, respondent's motion to reopen is without basis and it is accordingly denied.

CONCLUSION

In sum:

- (1) petitioner's motion for summary judgment is **DENIED**;
- (2) the standard Board protective order is imposed herein;
- (3) respondent's motions to compel interrogatory responses and production of documents are **GRANTED** to the extent hereinabove discussed; and,
- (4) respondent's motion to reopen and to compel additional Rule 30(b)(6) depositions is **DENIED**.

DISCOVERY CLOSED; TRIAL DATES RESET

Discovery is closed and trial dates are **reset** as indicated below.^[FN11]

DISCOVERY PERIOD TO CLOSE:

30-day testimony period for party in the position of plaintiff to close:

CLOSED
June 22, 2004

30-day testimony period for party in the position of the defendant to close:

August 21, 2004

15-day rebuttal period for party in the position of the plaintiff to close:

October 5, 2004

***12 IN EACH INSTANCE**, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within **thirty days** after completion of the taking of testimony. 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.

FN1. Respondent's registration arose from an application filed May 19, 1993, on the basis of Canyon's stated intention to use the mark in commerce. A subsequent statement of use, filed March 27, 1998, asserted dates of first use on July 9, 1993. Though the assignment from Canyon to respondent apparently was made prior to issuance of the registration, it was not recorded until after the registration had issued to Canyon. (Reel 1934, Frame 0761)

FN2. The registration is based on an application filed August 8, 1994 under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), and claiming first use of the mark in commerce on March 28, 1994.

FN3. See Serial No. 76055474 (covering "educational services, namely providing courses in hairdressing, skin care, and general beauty services" in International Class 41) and Serial No. 76056032 (covering "salon services, namely beauty treat-

ments, hairdressing, skin care and tanning services” in International Class 42).

FN4. Respondent asserts the Board “may *sua sponte* find a likelihood of confusion ... and/or a likelihood of reverse confusion...”

FN5. The pleaded claim of abandonment was based on petitioner's belief that Canyon had been dissolved as a corporation and its conclusion that respondent's mark was no longer in use at all. The briefing of the summary judgment motion, however, makes it clear that petitioner's current approach to the abandonment issue is that respondent's mark has never been used on shampoo. We consider the general claim of abandonment to encompass this more specific claim.

FN6. If petitioner's claim of abandonment goes unproved, and respondent retains its registration in its entirety, then it appears almost inevitable that respondent will also prevail on its counterclaim. On the other hand, if petitioner succeeds in proving respondent has abandoned use of the ESSENSUALS mark for shampoo, so that that item must be stricken from respondent's registration, then petitioner may be in a better position to defend against the counterclaim on the basis that there is no likelihood of confusion despite the parties' respective registrations of the identical mark.

FN7. We note, too, that the equitable defense of laches does not offer petitioner a safe harbor when confusion is inevitable, which it would be so long as both parties have the identical mark registered for shampoo. Coach House Restaurant Inc. v. Coach and Six Restaurants, Inc., 934 F.2d 1551, 1564, 19 USPQ2d 1401, 1409 (11th Cir. 1991); Turner v. Hops Grill & Bar Inc., 52 USPQ2d 1310 (TTAB 1999) (any injury to the defendant caused by plaintiff's delay is outweighed by the public interest in preventing confusion in the marketplace); Reflange Inc. v. R-Con International, 17 USPQ2d 1125, 1131 (TTAB 1990).

FN8. We note that the parties were not precluded from continuing negotiations to resolve their discovery differences after respondent filed its motions to compel. If the issues raised by the motion are subsequently resolved by agreement of the parties, Trademark Rule 2.120(e)(1) permits the moving party to withdraw its motions and/or inform the Board which issues in the motions no longer require adjudication.

FN9. The parties are encouraged to file with the Board, within thirty days of the mailing date set forth on page one of this order, signed copies of the attached protective order and of the attached “acknowledgment” form so that the terms of the protective order shall survive dismissal of this proceeding.

FN10. The Supreme Court, in Pioneer Investment Services Company v. Brunswick Associates Limited Partnership, 507 U.S. 380 (1993), held that excusable neglect should be determined by considering the circumstances surrounding the omission. Such circumstances include: (1) the prejudice to the non-moving party, (2) the length of the delay and its potential impact on judicial proceedings, (3) the reason for the delay, and (4) whether the moving party had acted in good faith. Pioneer Investment Services Company v. Brunswick Associates Limited Partnership, 507 U.S. at 395. See also Pumpkin, Ltd. v. The Seed Corps, 43 USPQ2d 1582 (TTAB 1997).

FN11. If the parties seek any further extensions to the trial schedule in this case, any future consented motions to extend should set forth all dates in the format shown in this order. See Trademark Rule 2.121(d).

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

***13 Cancellation No. 92040118**

Toni & Guy (USA) Limited

v.

Ardell Nelson

PROVISIONS FOR PROTECTING CONFIDENTIALITY OF INFORMATION REVEALED DURING BOARD PROCEEDING

Information disclosed by any party or non-party witness during this proceeding may be considered confidential, a trade secret, or commercially sensitive by a party or witness. To preserve the confidentiality of the information so disclosed, **either** the parties have agreed to be bound by the terms of this order, in its standard form or as modified by agreement, and by any additional provisions to which they may have agreed and attached to this order, **or** the Board has ordered that the parties be bound by the provisions within. As used in this order, the term "information" covers both oral testimony and documentary material.

Parties may use this standard form order as the entirety of their agreement or may use it as a template from which they may fashion a modified agreement. If the Board orders that the parties abide by the terms of this order, they may subsequently agree to modifications or additions, subject to Board approval.

Agreement of the parties is indicated by the signatures of the parties' attorneys and/or the parties themselves at the conclusion of the order. Imposition of the terms by the Board is indicated by signature of a Board attorney or Administrative Trademark Judge at the conclusion of the order. If the parties have signed the order, they may have created a contract. The terms are binding from the date the parties or their attorneys sign the order, in standard form or as modified or supplemented, or from the date of imposition by a Board attorney or judge. The parties should note that there may be a remedy at court for any breach of contract that occurs after the conclusion of this Board proceeding. *See Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552, 1555 (TTAB 1987). *See also, Alltrade Inc. v. Uniweld Products Inc.*, 946 F.2d 622, 20 USPQ2d 1698 (9th Cir. 1991).

TERMS OF ORDER

1) Classes of Protected Information.

The Rules of Practice in Trademark Cases provide that all inter partes proceeding files, as well as the involved registration and application files, are open to public inspection. The terms of this order are not to be used to undermine public access to files. When appropriate, however, a party or witness, on its own or through its attorney, may seek to protect the confidentiality of information by employing one of the following designations.

Confidential—Material to be shielded by the Board from public access.

Highly Confidential—Material to be shielded by the Board from public access and subject to agreed restrictions on access even as to the parties and/or their attorneys.

Trade Secret/Commercially Sensitive—Material to be shielded by the Board from public access, restricted from any access by the parties, and available for review by outside counsel for the parties and, subject to the provisions of paragraph 4 and 5, by independent experts or consultants for the parties.

2) Information Not to Be Designated as Protected.

*14 Information may not be designated as subject to any form of protection if it (a) is, or becomes, public knowledge, as shown by publicly available writings, other than through violation of the terms of this document; (b) is acquired by a non-designating party or non-party witness from a third party lawfully possessing such information and having no obligation to the owner of the information; (c) was lawfully possessed by a non-designating party or non-party witness prior to the opening of discovery in this proceeding, and for which there is written evidence of the lawful possession; (d) is disclosed by a non-designating party or non-party witness legally compelled to disclose the information; or (e) is disclosed by a non-designating party with the approval of the designating party.

3) Access to Protected Information.

The provisions of this order regarding access to protected information are subject to modification by written agreement of the parties or their attorneys, or by motion filed with and approved by the Board.

Judges, attorneys, and other employees of the Board are bound to honor the parties' designations of information as protected but are not required to sign forms acknowledging the terms and existence of this order. Court reporters, stenographers, video technicians or others who may be employed by the parties or their attorneys to perform services incidental to this proceeding will be bound only to the extent that the parties or their attorneys make it a condition of employment or obtain agreements from such individuals, in accordance with the provisions of paragraph 4.

- **Parties** are defined as including individuals, officers of corporations, partners of partnerships, and management employees of any type of business organization.
- **Attorneys** for parties are defined as including **in-house counsel** and **outside counsel**, including support staff operating under counsel's direction, such as paralegals or legal assistants, secretaries, and any other employees or independent contractors operating under counsel's instruction.
- **Independent experts or consultants** include individuals retained by a party for purposes related to prosecution or defense of the proceeding but who are not otherwise employees of either the party or its attorneys.
- **Non-party witnesses** include any individuals to be deposed during discovery or trial, whether willingly or under subpoena issued by a court of competent jurisdiction over the witness.

Parties and their attorneys shall have access to information designated as **confidential** or **highly confidential**, subject to any agreed exceptions.

Outside counsel, but not in-house counsel, shall have access to information designated as **trade secret/commercially sensitive**.

Independent experts or consultants, non-party witnesses, and any other individual not otherwise specifically covered by the terms of this order may be afforded access to **confidential** or **highly confidential** information in accordance with the terms that follow in paragraph 4. Further, **independent experts or consultants** may have access to **trade secret/commercially sensitive** information if such access is agreed to by the parties or ordered by the Board, in accordance with the terms that follow in paragraph 4 and 5.

4) Disclosure to Any Individual.

*15 Prior to disclosure of protected confidential or highly confidential information by any party or its attorney to any individual not already provided access to such information by the terms of this order, the individual shall be informed of the existence of this order and provided with a copy to read. The individual will then be required to certify in writing that the order has been read and understood and that the terms shall be binding on the individual. No individual shall receive any protected information until the party or attorney proposing to disclose the information has received the signed certification from the individual. A form for such certification is attached to this order. The party or attorney receiving the completed form shall retain the original.

5) Disclosure to Independent Experts or Consultants.

In addition to meeting the requirements of paragraph 4, any party or attorney proposing to share disclosed trade secret/commercially sensitive information with an independent expert or consultant must also notify the party which designated the information as protected. Notification must be personally served or forwarded by certified mail, return receipt requested, and shall provide notice of the name, address, occupation and professional background of the expert or independent consultant.

The party or its attorney receiving the notice shall have ten (10) business days to object to disclosure to the expert or independent consultant. If objection is made, then the parties must negotiate the issue before raising the issue before the Board. If the parties are unable to settle their dispute, then it shall be the obligation of the party or attorney proposing disclosure to bring the matter before the Board with an explanation of the need for disclosure and a report on the efforts the parties have made to settle their dispute. The party objecting to disclosure will be expected to respond with its arguments against disclosure or its objections will be deemed waived.

6) Responses to Written Discovery.

Responses to interrogatories under Federal Rule 33 and requests for admissions under Federal Rule 36, and which the responding party reasonably believes to contain protected information shall be prominently stamped or marked with the appropriate designation from paragraph 1. Any inadvertent disclosure without appropriate designation shall be remedied as soon as the disclosing party learns of its error, by informing all adverse parties, in writing, of the error. The parties should

inform the Board only if necessary because of the filing of protected information not in accordance with the provisions of paragraph 12.

7) Production of Documents.

If a party responds to requests for production under Federal Rule 34 by making copies and forwarding the copies to the inquiring party, then the copies shall be prominently stamped or marked, as necessary, with the appropriate designation from paragraph 1. If the responding party makes documents available for inspection and copying by the inquiring party, all documents shall be considered protected during the course of inspection. After the inquiring party informs the responding party what documents are to be copied, the responding party will be responsible for prominently stamping or marking the copies with the appropriate designation from paragraph 1. Any inadvertent disclosure without appropriate designation shall be remedied as soon as the disclosing party learns of its error, by informing all adverse parties, in writing, of the error. The parties should inform the Board only if necessary because of the filing of protected information not in accordance with the provisions of paragraph 12.

8) Depositions.

*16 Protected documents produced during a discovery deposition, or offered into evidence during a testimony deposition shall be orally noted as such by the producing or offering party at the outset of any discussion of the document or information contained in the document. In addition, the documents must be prominently stamped or marked with the appropriate designation.

During discussion of any non-documentary protected information, the interested party shall make oral note of the protected nature of the information.

The transcript of any deposition and all exhibits or attachments shall be considered protected for 30 days following the date of service of the transcript by the party that took the deposition. During that 30-day period, either party may designate the portions of the transcript, and any specific exhibits or attachments, that are to be treated as protected, by electing the appropriate designation from paragraph 1. Appropriate stampings or markings should be made during this time. If no such designations are made, then the entire transcript and exhibits will be considered unprotected.

9) Filing Notices of Reliance.

When a party or its attorney files a notice of reliance during the party's testimony period, the party or attorney is bound to honor designations made by the adverse party or attorney, or non-party witness, who disclosed the information, so as to maintain the protected status of the information.

10) Briefs.

When filing briefs, memoranda, or declarations in support of a motion, or briefs at final hearing, the portions of these filings that discuss protected information, whether information of the filing party, or any adverse party, or any non-party witness, should be redacted. The rule of reasonableness for redaction is discussed in paragraph 12 of this order.

11) Handling of Protected Information.

Disclosure of information protected under the terms of this order is intended only to facilitate the prosecution or defense of this case. The recipient of any protected information disclosed in accordance with the terms of this order is obligated to maintain the confidentiality of the information and shall exercise reasonable care in handling, storing, using or disseminating the information.

12) Redaction; Filing Material With the Board.

When a party or attorney must file protected information with the Board, or a brief that discusses such information, the protected information or portion of the brief discussing the same should be redacted from the remainder. A rule of reasonableness should dictate how redaction is effected.

Redaction can entail merely covering a portion of a page of material when it is copied in anticipation of filing but can also entail the more extreme measure of simply filing the entire page under seal as one that contains primarily confidential material. If only a sentence or short paragraph of a page of material is confidential, covering that material when the page is copied would be appropriate. In contrast, if most of the material on the page is confidential, then filing the entire page

under seal would be more reasonable, even if some small quantity of non-confidential material is then withheld from the public record. Likewise, when a multi-page document is in issue, reasonableness would dictate that redaction of the portions or pages containing confidential material be effected when only some small number of pages contain such material. In contrast, if almost every page of the document contains some confidential material, it may be more reasonable to simply submit the entire document under seal. **Occasions when a whole document or brief must be submitted under seal should be very rare.**

*17 Protected information, and relevant portions of pleadings, briefs or memoranda that reproduce, discuss or paraphrase such information, shall be filed with the Board under seal. The envelopes or containers shall be prominently stamped or marked with a legend in substantially the following form:

CONFIDENTIAL

This envelope contains documents or information that are subject to a protective order or agreement. The confidentiality of the material is to be maintained and the envelope is not to be opened, or the contents revealed to any individual, except by order of the Board.

13) Acceptance of Information; Inadvertent Disclosure.

Acceptance by a party or its attorney of information disclosed under designation as protected shall not constitute an admission that the information is, in fact, entitled to protection. Inadvertent disclosure of information which the disclosing party intended to designate as protected shall not constitute waiver of any right to claim the information as protected upon discovery of the error.

14) Challenges to Designations of Information as Protected.

If the parties or their attorneys disagree as to whether certain information should be protected, they are obligated to negotiate in good faith regarding the designation by the disclosing party. If the parties are unable to resolve their differences, the party challenging the designation may make a motion before the Board seeking a determination of the status of the information.

A challenge to the designation of information as protected must be made substantially contemporaneous with the designation, or as soon as practicable after the basis for challenge is known. When a challenge is made long after a designation of information as protected, the challenging party will be expected to show why it could not have made the challenge at an earlier time.

The party designating information as protected will, when its designation is timely challenged, bear the ultimate burden of proving that the information should be protected.

15) Board's Jurisdiction; Handling of Materials After Judgment.

The Board's jurisdiction over the parties and their attorneys ends with the entry of a final judgment, unless jurisdiction is restored by grant of a post-judgment motion or as the result of an appellate proceeding. After entry of judgment, the parties' handling of protected information and materials is governed only by any agreements to which the parties may agree.

16) Other Rights of the Parties and Attorneys.

This order shall not preclude the parties or their attorneys from making any applicable claims of privilege during discovery or at trial. Nor shall the order preclude the filing of any motion with the Board for relief from a particular provision of this order or for additional protections not provided by this order.

By Agreement of the Following, effective _____
[insert signature date]

*18 David W. Carstens

Carstens, Yee & Cahoon LLP

Attorneys for plaintiff

Alan D. Rosenthal

Rosenthal & Osha LLP

Attorneys for defendant

By Order of the Board, effective March 30, 2004

/s/ Karyn K. Ryan

Karyn K. Ryan

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

Cancellation No. 92040118

Toni & Guy (USA) Limited

v.

Ardell Nelson

ACKNOWLEDGMENT OF AGREEMENT OR ORDER PROTECTING CONFIDENTIALITY OF INFORMATION REVEALED DURING BOARD PROCEEDING

I, _____ [print name], declare that I have been provided with a copy of the Agreement or Order regarding the disclosure of, and protection of, certain types of information and documents during and after the above-captioned opposition or cancellation proceeding before the Trademark Trial and Appeal Board.

I have read the Agreement or 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.

[signature]

[print title, if applicable]

[date]

2004 WL 725459 (Trademark Tr. & App. Bd.)

END OF DOCUMENT

EXHIBIT R

REDACTED

EXHIBIT S

Slip Copy, 2011 WL 3880787 (E.D.Wis.)
(Cite as: 2011 WL 3880787 (E.D.Wis.))

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Only the Westlaw citation is currently available.

United States District Court,
E.D. Wisconsin.
KIMBERLY-CLARK WORLDWIDE, INC., and,
Kimberly-Clark Global Sales, LLC, Plaintiffs,
v.
FIRST QUALITY BABY PRODUCTS, LLC, and
First Quality Retail Sales, LLC, Defendants.

No. 09-C-0916.
Sept. 1, 2011.

Aimee B. Kolz, Janice V. Mitrius, Jason S. Shull,
Jonathan Pieter Van Es, Joseph J. Berghammer,
Katherine L. Fink, Katie L. Becker, Marc S.
Cooperman, Matthew P. Becker, Michael L. Krashin,
Sean Jungels, Thomas J. Lerdal, Thomas K. Pratt,
Banner & Witcoff Ltd, Andrew G. Klevorn, Chad J.
Doellinger, Eimer Stahl Klevorn & Solberg LLP,
Chicago, IL, Anthony S. Baish, Godfrey & Kahn SC,
Milwaukee, WI, Daniel T. Flaherty, Godfrey & Kahn
SC, Appleton, WI, Vicki Margolis, Kimberly-Clark
Corporation, Neenah, WI, for Plaintiffs.

Brian A. Comack, David A. Boag, Ira E. Silfin,
Kenneth P. George, Michael J. Kasdan, Michael V.
Solomita, Amster Rothstein & Ebenstein, New York,
NY, David A. Caine, Kalina V. Laleva, Lisa K.
Nguyen, Michael A. Ladra, Ron E. Shulman, Wilson
Sonsini Goodrich & Rosati, Palo Alto, CA, David
Michael Underhill, Eric J. Maurer, Michael A. Brille,
Boies Schiller & Flexner LLP, Washington, DC,
Gregory B. Conway, Thomas Wickham Schmidt,
Liebmann Conway Olejniczak & Jerry SC, Green
Bay, WI, Gregory J. Wallace, Julie M. Holloway,
Wilson Sonsini Goodrich & Rosati, San Francisco,
CA, Jose C. Villarreal, Wilson Sonsini Goodrich &
Rosati, Austin, TX, for Defendants.

ORDER DENYING MOTION FOR SANCTIONS
WILLIAM C. GRIESBACH, District Judge.

*1 Defendants First Quality Baby Products, LLC,
and First Quality Retail Sales, LLC (collectively "First
Quality") seek sanctions against Plaintiffs Kimberly-
Clark Worldwide, Inc., and Kimberly-Clark

Global Sales, LLC (collectively "K-C") for K-C's
alleged failure to comply with discovery requests.
First Quality asserts that K-C produced an unknowl-
edgeable 30(b)(6) witness, Michelle Boudry. First
Quality's brief highlights some instances in which Ms.
Boudry was unable to answer questions posed. For the
reasons discussed below, First Quality's motion for
sanctions will be denied.

First Quality contends K-C has failed to fulfill its
obligations under Rule 30(b)(6) to produce a knowl-
edgeable witness to testify on its behalf concerning the
particular matters described in the deposition notices.
Rule 30(b)(6) authorizes a party seeking discovery
from a corporation to name the corporation as the
deponent and "describe with reasonable particularity
the matters on which examination is requested." *Id.* In
response, the corporation must designate the person or
persons who will testify on its behalf. The Rule re-
quires that "the persons so designated shall testify as
to matters known or reasonably available to the or-
ganization." *Id.* "Thus, the practical effect of serving a
Rule 30(b)(6) notice is to place a duty upon the
business entity to designate an individual to testify on
behalf of the corporation who has knowledge respon-
sive to subjects requested in the Rule 30(b)(6) requests
of its opponents ." *Sanyo Laser Products Inc. v. Arista*
Records, Inc., 214 F.R.D. 496, 502-03 (S.D.Ind.2003)
(internal quotes and citations omitted). As the Advi-
sory Committee Note states, the Rule is intended to
curb the practice of " 'bandying' by which officers or
managing agents of a corporation are deposed in turn
but each disclaims knowledge of facts that are clearly
known to persons in the organization and thereby to
it." Fed.R.Civ.P. 30(b)(6) advisory committee note.

First Quality claims its case has been harmed by
its inability to receive concrete answers on the design
and development of K-C's Libra and EZ-On projects.
On June 29, 2011, this Court ordered K-C to produce
for deposition "a corporate witness knowledgeable
about Topic 27 in First Quality's March 2, 2011 Rule
30(b)(6) notice ... limited to the LIBRA and EZ-On
projects." (ECF 434 at 3-4.) K-C designated Michelle
Boudry, who "spoke to everyone that we could think
of who is still around or even people who weren't still
around" in an attempt to obtain information regarding
the Libra project. (Shull Decl., Ex. 1 at 164.) She met

Slip Copy, 2011 WL 3880787 (E.D.Wis.)
(Cite as: 2011 WL 3880787 (E.D.Wis.))

with multiple attorneys on multiple occasions and testified at length about the Libra project for nearly seven hours. (See e.g., *id.* at 13, 19–21, 23, 53–55, 57, 60, 200, 232, 239, 254.) First Quality contends Ms. Boudry was not prepared and knowledgeable about Libra because she could not answer some of the questions posed regarding the A–3053, A–5208, A–5274, and A–5368 studies. Not satisfied with the responses to these and other questions, First Quality requests that the Court sanction K–C by taking as established fact that the Libra and Ez–On refastenable training pants are prior art to the '067 patent and teach all elements of the asserted claims.

*2 First Quality contends Ms. Boudry was not a “knowledgeable witness” in compliance with the Court’s order because she failed to answer some of the questions posed to her about the Libra and EZ–On projects. First Quality claims Ms. Boudry was unable to “describe the Libra and EZ–On refastenable training pants” and contends she had “no personal knowledge regarding their physical structure.” (ECF 473 at 2.) But Rule 37 does not contemplate sanctions merely because a Rule 30(b)(6) corporate designee cannot answer every question posed in a deposition. See Belmont Holdings Corp v. Unicare Life & Health Ins. Co., No. Civ. 98–2365, 2000 WL 1920039, at *3 (E.D.Pa. Dec. 1, 2000); United States v. Massachusetts Indus. Fin. Agency, 162 F.R.D. 410, 412 (D.Mass.1995). Notably, Rule 37 does not contemplate sanctions when a party no longer has information simply because of the passage of time and the fading of memories. See Walden v. City of Chicago, 2007 WL 328883, at *3 (N.D.Ill. Feb. 1, 2007) (holding that “due to the passage of time and the fact that the pertinent records no longer exist ... it is not appropriate or just to sanction the [defendant] pursuant to Rule 37 for its inability to produce a Rule 30(b)(6) witness.”). See also In Re JDS Uniphase, 2007 WL 219857, at * 2 (N.D.Cal. Jan. 29, 2007) (denying motion to compel, noting that since seven years had passed since the events occurred, the Rule 30(b)(6) designee testified on “matters [that] were reasonably available ... and, not surprisingly, was unable to answer questions about matters which were not reasonably available”); Barron v. Caterpillar. Inc., 168 F.R.D. 175, 177 (E.D.Pa.1999) (noting “parties should anticipate the unavailability of certain information” from events transpiring years ago).

The projects relevant here occurred approxi-

mately twenty years ago. Ms. Boudry’s deposition responses indicate she made a good faith effort to obtain answers but could not in the face of time and memory constraints. See, e.g., Shull Decl., Ex. 1 at 164. (“We asked multiple people if they were aware of what the product looked like or what the product was like, and they did not know.”). In preparation for the deposition, Ms. Boudry spoke with nearly thirty people. (*Id.* at 186–87.) Despite First Quality’s claims, Ms. Boudry did not need to review every single document created by K–C twenty years ago in connection with these studies; it is enough that she reviewed several documents relating to each pertinent study, including research notes and written reports. (*Id.* at 17–18, 25, 268–70, 314–16.) In light of the time that has passed, First Quality’s demand that K–C contact every former employee listed on the distribution list for the projects in question is not supportable. As Ms. Boudry’s testimony suggests, the specific information First Quality is seeking simply seems to exist no longer.

I am satisfied that Ms. Boudry’s inability to give more specific information in response to particular questions pertaining to the Libra and EZ–On projects is the result of the lengthy passage of time. Plaintiff is free to challenge the credibility of the witness at trial, but I find no violation of Rule 30(b)(6) warranting the drastic sanction plaintiff seeks. First Quality’s motion for sanctions, Docket 473, is accordingly **DENIED**.

E.D.Wis.,2011.
Kimberly-Clark Worldwide, Inc. v. First Quality Baby Products, LLC
Slip Copy, 2011 WL 3880787 (E.D.Wis.)

END OF DOCUMENT

EXHIBIT T

REDACTED

EXHIBIT U

Slip Copy, 2009 WL 3190462 (N.D.Fla.)
(Cite as: 2009 WL 3190462 (N.D.Fla.))

C

Only the Westlaw citation is currently available.

This decision was reviewed by West editorial staff and not assigned editorial enhancements.

United States District Court, N.D. Florida,
Pensacola Division.

HOME DESIGN SERVICES, INC., Plaintiff,

v.

W. GARGAS CONSTRUCTION, INC., and Wagih
Gargas, Defendants.

No. 3:08cv244/MCR/EMT.
Oct. 1, 2009.

Kirt Ross Posthuma, Jon Douglas Parrish, Parrish
Lawhon & Yarnell PA, Naples, FL, for Plaintiff.

James Andrew Talbert, Bozeman Jenkins & Matthews
PA, Pensacola, FL, Jonathan Thomas Holloway, Esq.,
Holloway Law Firm PA, Crestview, FL, for Defend-
ants.

ORDER

ELIZABETH M. TIMOTHY, United States Magis-
trate Judge.

*1 This copyright infringement action is before the court upon the "Motion to Strike Plaintiff's Notice of Taking a Second Deposition and For Protective Order Precluding Plaintiffs [sic] from Taking a Second Deposition Without Court Order" filed by Defendants W. Gargas Construction, Inc. ("Gargas Construction") and Wagih Gargas ("Gargas") (together, "Defendants") (Doc. 94). Also before the court is Plaintiff Home Design Services, Inc.'s "Motion to Compel the Rule 30(B)(6) Depositions of W. Gargas Construction, Inc.'s Corporate Representative(s), Motion to Compel Document Production and Response to Defendants' Motion to Strike (Dkt.# 94)" (Doc. 100), to which Defendants have responded (Doc. 104). For the reasons stated below, the court grants Defendants' motion to strike and for a protective order, and it denies Plaintiff's motion to compel.

I. BACKGROUND

Plaintiff is a residential design firm engaged in

the business of designing houses, and Defendants build houses. In its amended complaint Plaintiff alleges that Defendants made unauthorized use of its copyrighted houseplans (*see* amended complaint at Doc. 17). As relief for Defendants' alleged conduct, Plaintiff seeks preliminary injunctive relief, actual or statutory damages, and attorney's costs and fees (*see* Doc. 17 at 3-4).

The district court entered an Initial Scheduling Order which directed the parties to complete discovery by November 13, 2008; in its Final Scheduling Order the court extended this date to December 31, 2008 (Docs.7, 11). On December 11, 2008, Plaintiff deposed Gargas, the corporate representative of Gargas Construction. On April 22, 2009, the district court granted the parties' motion for continuance of trial and amendment of certain pretrial deadlines established in the Final Scheduling Order (Doc. 72). Among other matters, the district court reopened discovery and directed that all discovery must be completed by September 28, 2009 (Doc. 72). The parties have not sought, or obtained, either from the undersigned or the district court any additional enlargement of the discovery period, which therefore closed September 28, 2009.

On September 10, 2009, Plaintiff served Gargas Construction with notice that it would take the continued deposition of Gargas and Gargas Construction's corporate representative on September 24, 2009. Defendants filed their instant motion to strike the notice on Friday, September 18, 2009. The motion was routinely referred to the undersigned the following Monday, September 21, 2009. As directed by this court, on September 23, 2009, Plaintiff filed an expedited response to the motion; Plaintiff also included with its response a motion to compel Gargas' deposition. On September 23, 2009, the parties also filed a notice stating that, pending the court's ruling on their motions, they had agreed to postpone Gargas' scheduled September 24, 2009, deposition (Doc. 103). Defendants filed an expedited response to Plaintiff's motion at 4:59 p.m., on September 28, 2009. Both motions before the court therefore are now ripe for review.

*2 In their motion Defendants submit that one

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month prior to his December 11, 2008, deposition, Gargas-through his counsel at the time-agreed to provide Plaintiff's counsel with copies of his entire construction file for the houses Plaintiff asserts Defendants built using Plaintiff's copyrighted house-plans. Gargas arranged for a copying service to make the copies but learned after he had delivered several boxes of documents to the copying service that Plaintiff's counsel had directed the service to send the boxes to their office. Gargas retrieved the boxes and took them to a different copying service, which copied the documents and sent them to Plaintiff's attorneys prior to the scheduled deposition. Gargas did not bring copies of the documents to the deposition, nor did Plaintiff's counsel bring all of their copies of Defendants' documents to the deposition. After the district court extended the discovery period to September 28, 2009, Plaintiff requested that it be allowed to retake the deposition of Gargas, in his personal capacity and as the corporate representative of Gargas Construction, on the ground it did not have all of the documents it needed during the initial deposition. Defendants did not agree to the deposition, contending that all relevant documents had been provided to Plaintiff prior to the December 11, 2008, deposition. Defendants acknowledge, however, that some documents were located after the deposition and provided to Plaintiff. Nevertheless, according to Defendants, the later-provided documents were either full-sized sets of plans already in Plaintiff's possession or were insurance policies that do not require the further deposition of Gargas.

In its response to Defendants' motion and its own motion to compel, Plaintiff asserts that at the December 11, 2008, deposition Gargas was not prepared to testify on topics noticed for deposition and was unfamiliar with the documents produced during discovery, pointing to Gargas' deposition statements that he had not looked at the documents he had bound for production. Plaintiff also contends that no proper search was conducted to produce the specific documents responsive to the documents request. In fact, Plaintiff submits, Defendants produced hundreds of documents-from twelve different construction jobs-that are unrelated to the plans at issue or the houses it alleges Defendants built from those plans. Since the deposition, Plaintiff asserts, it has repeatedly requested those documents, as well as others relevant to its documents request, and sought to coordinate Gargas' continued deposition, but Defendants have either delayed or refused to cooperate. Plaintiff denies

that it seeks a continued deposition of Gargas simply based on late document production and copying problems or on its counsel's failure to adequately review the documents prior to the deposition. According to Plaintiff, Defendants recently produced-albeit ten days late-three additional boxes of documents in response to subpoenas delivered to Defendants' expert witnesses; these documents, which include six sets of full-sized blue prints and materials from outside designers, plan books, construction documents, notes, and cost papers-indicate to Plaintiff that Defendants have not complied with its previous discovery requests. Plaintiff also notes that Defendants' current counsel advised that he had no record of what documents had been produced by prior counsel and could not confirm that all responsive documents had previously been provided. Plaintiff contends that because Gargas was unprepared to testify at the December 11, 2008, deposition and was not familiar with the documents produced (and because Defendants failed to timely produce all requested documents), as provided by Fed.R.Civ.P. 30(d)(1) the court must allow them to examine Gargas further in a continued deposition. They further ask the court to compel Defendants to produce immediately (or deny the existence of) all documents responsive to their discovery requests. Plaintiff also seeks sanctions for Defendants' alleged refusal to provide a knowledgeable and prepared Rule 30(b)(6) representative and to provide the requested documents.

*3 Responding to Plaintiff's motion, Defendants maintain that Gargas was well prepared for the December 11, 2008, deposition and that Plaintiff has been given *all* relevant documents in their possession.^{FN1} In support, they point to excerpts of Gargas' deposition testimony, copies of emails between opposing counsel, and the affidavit of Jonathan Holloway ("Holloway"), Defendants' counsel at the time the December 2008 deposition was taken. Defendants further assert, in the alternative, that sanctions are improper because Gargas has not willfully or egregiously violated any rules of discovery.

^{FN1}. Defendants state that Gargas recently located an additional document responsive to the request for production of documents, the closing documents for one of his properties. The document is attached as an exhibit to Defendants' response.

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II. DISCUSSION

Rule 30(b)(6) of the Federal Rules of Civil Procedure provides:

A party may in the party's notice and in a subpoena name as the deponent a public or private corporation or a partnership or association or governmental agency and describe with reasonable particularity the matters on which examination is requested. In that event, the organization so named shall designate one or more officers, directors, or managing agents, or other persons who consent to testify on its behalf, and may set forth, for each person designated, the matters on which the person will testify. A subpoena shall advise a non-party organization of its duty to make such a designation. The persons so designated shall testify as to matters known or reasonably available to the organization. This subdivision (b)(6) does not preclude taking a deposition by any other procedure authorized in these rules.

Fed.R.Civ.P. 30(b)(6).

Additionally, Federal Rule of Civil Procedure 30(d)(1) provides that “[u]nless otherwise stipulated or ordered by the court, a deposition is limited to 1 day of 7 hours. The court must allow additional time consistent with Rule 26(b)(2) if needed to fairly examine the deponent or if the deponent, another person, or any other circumstance impedes or delays the examination.”^{FN2} Rule 30(d)(1) thus establishes the presumptive duration of a deposition and requires courts to order that a deposition exceed that length under certain circumstances. The Advisory Committee Notes state that “[t]he party seeking a court order to extend the examination ... is expected to show good cause to justify such an order.” Good cause for permitting an extension may include the failure to produce requested information. *See Fed.R.Civ.P. 30(d) Advisory Committee's Note (2000 Amendment)*.

FN2. The factors in Rule 26(b)(2) that may be considered are:

- (i) the discovery sought is unreasonably cumulative or duplicative, or can be obtained from some other source that is more convenient, less burdensome, or less expensive;
- (ii) the party seeking discovery has had

ample opportunity to obtain the information by discovery in the action; or

(iii) the burden or expense of the proposed discovery outweighs its likely benefit, considering the needs of the case, the amount in controversy, the parties' resources, the importance of the issues at stake in the action, and the importance of the discovery in resolving the issues.

Fed.R.Civ.P. 26(b)(2)(C).

In this case, it is undisputed that Gargas' December 11, 2008, deposition was concluded by Plaintiffs after approximately three and one-half hours, well within the seven hour time limit provided in Rule 30(d)(1). It also appears to be undisputed that Plaintiff did not request a continuation of the deposition at the time it was concluded (*see* Doc. 104-4, ¶¶ 11, 13). The question before the court is whether to permit a second deposition of Gargas at this time. Based on the evidence presented, the court concludes that Plaintiff has not shown good cause for a second deposition.

*4 First, Gargas testified at his December 11, 2008, deposition that he had provided Plaintiff with all of the documents in his possession pertaining to all of the houses he had built (Doc. 104-6 at 6). Also, Holloway states in his affidavit that he determined that in its requests for production Plaintiff was seeking the construction file of every house Gargas had built and therefore the files for all twelve houses completed by Gargas were provided (Doc. 104-4, ¶ 5). The court is satisfied that, with minor exceptions, Defendants timely produced all of the relevant documents in their possession sought by Plaintiff. To the extent Defendants may have untimely produced some blue prints, the court accepts that the plans had been originally obtained from Plaintiff and thus need not have been produced. Furthermore, based on the court's understanding of the liability issues at stake, and the relative unimportance of any inadvertently late-produced insurance policies or property closing documents to resolving those issues, the court concludes that the further deposition of Gargas and its associated inconvenience and expense is not warranted at this time. *See Fed.R.Civ.P. 26(b)(2)(C)*. If necessary, these documents can be authenticated by Gargas' affidavit prior to the submission of any dispositive motions.^{FN3} To the extent the documents are

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relevant to ascertaining Plaintiff's alleged damages, should Defendants' liability be determined, additional discovery at a later date may be appropriate.

FN3. As noted above, discovery closed on September 28, 2009. To the extent the court's permission is required to obtain Gargas' affidavit authenticating these documents, it is given.

The court further concludes, based on the evidence provided to it and taking into consideration the limited time the parties have afforded it to resolve this dispute, that Gargas was adequately prepared to respond to the noticed topics at his December 11, 2008, deposition. In its response/motion Plaintiff does not identify the specific noticed topics as to which it contends Gargas was not adequately prepared to testify. Defendants, however, point to several topics which they say were discussed in emails between counsel (*see* Doc. 104 at 2-6).^{FN4} The transcript excerpts before the court reflect that Gargas testified he had never heard of Home Design Services and had never seen its plans prior to the filing of this lawsuit (Doc. 104-3 at 1). Accordingly, the court concludes that Gargas' testimony as to Topics 4, 5, 6, 8, 9, 10, and 12 was adequate. Gargas' testimony as to Topics 14-17 was likewise adequate. Gargas was the only officer or employee of Gargas Construction who could testify about discovery compliance, answers to interrogatories, production of requested documents, and "substantial similarity." Although Gargas was not sure of the specific documents he had produced, due to their number, he testified that he provided for copying all of the construction documents he had (*see* Doc. 104-6). He also testified that he found no substantial similarities between the parties' houseplans (*see* Doc. 104-5). Furthermore, in his affidavit Holloway states that he spent several hours in person preparing Gargas for his deposition (Doc. 104-4 at 3).

FN4. The topics noted by Defendants, which are taken from Plaintiff's notice of the December 11, 2008, deposition (Doc. 100-2 at 1-6) include:

Topic 4: Access to or receipt of any house plan or advertisement from Home Design Services, Inc.;

Topic 5: The number of homes constructed

based upon the plans listed in Paragraph No. 1; their physical location; any profits and gross revenues derived from the sale of these homes; expenses for the homes constructed based on the plan referenced in Paragraph No. 1;

Topic 6: Any advertising and/or marketing of the Defendant's plans and/or homes constructed based on any plan referenced in Paragraph No. 1;

Topic 8: W. Gargas Construction, Inc.'s license, business dealings and/or contractual relationships with any other person or entity, regarding the creations, modification or use any of the plan[s] listed in Paragraph No. 1;

Topic 9: The basis and detail for any defenses raised by you in this lawsuit;

Topic 10: The existence and whereabouts of any development documents relating to the origin or creation of [] any plan referenced Paragraph No. 1;

Topic 12: Information regarding the involvement of any third-party in the creation or modification of any plan referenced in Paragraph No. 1;

Topic 14: Discovery compliance;

Topic 15: Answers to interrogatories;

Topic 16: Production of requested documents; and

Topic 17: Substantial similarity.

*5 In summary, the court concludes that Defendants' "Motion to Strike Plaintiff's Notice of Taking a Second Deposition and For Protective Order Precluding Plaintiffs [sic] from Taking a Second Deposition Without Court Order" should be granted and that Plaintiff's "Motion to Compel the Rule 30(B)(6) Depositions of W. Gargas Construction, Inc.'s Corporate Representative(s) [and] Motion to Compel Document Production ..." should be denied.

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The parties shall bear their own costs.

Accordingly, it is ORDERED:

1. Defendants' "Motion to Strike Plaintiff's Notice of Taking a Second Deposition and For Protective Order Precluding Plaintiffs [sic] from Taking a Second Deposition Without Court Order" (Doc. 94) is GRANTED. Plaintiff may not take the second deposition of Wagih Gargas, either in his individual capacity or as the corporate representative of W. Gargas Construction, Inc.

2. Plaintiff's "Motion to Compel the Rule 30(B)(6) Depositions of W. Gargas Construction, Inc.'s Corporate Representative(s) [and] Motion to Compel Document Production ..." (Doc. 100) is DENIED.

DONE AND ORDERED.

N.D.Fla., 2009.
Home Design Services, Inc. v. W. Gargas Const., Inc.
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END OF DOCUMENT

EXHIBIT V

REDACTED

EXHIBIT W

REDACTED

EXHIBIT X

REDACTED

EXHIBIT Y

REDACTED

EXHIBIT Z

REDACTED

EXHIBIT AA

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