

**UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451**

Mailed: December 16, 2011

Opposition No. 91192781

Bayer HealthCare LLC

v.

Biogen Idec MA Inc. and  
Cardiokine Biopharma, LLC

**George C. Pologeorgis,  
Interlocutory Attorney:**

This case now comes before the Board for consideration of opposer's motion (filed November 30, 2011) to extend discovery by sixty days. Applicants filed a response to the motion on December 14, 2011.

The Board, in its discretion, suggested that the issues raised in opposer's motion should be resolved by telephonic conference as permitted by TBMP § 502.06 (3d ed. 2011). The Board contacted the parties to discuss the date and time for holding the phone conference.

The parties agreed to hold a telephone conference at 1:30 p.m. Eastern time on Thursday, December 15, 2011. The conference was held as scheduled among Beth M. Goldman and Thomas H. Zellerbach, as counsel for opposer, Michael Albert and Christina M. Licursi, as counsel for applicants, and the

above signed, as a Board attorney responsible for resolving interlocutory disputes in this case.

The Board carefully considered the arguments raised by the parties, as well as the supporting correspondence and the record of this case, in coming to a determination regarding the above matters. During the telephone conference, the Board made the following findings and determinations:

**Opposer's Motion to Extend Discovery**

For the reasons set forth below, opposer's motion to extend discovery is **granted** to the limited extent provided below.

As background, discovery in this case initially opened on February 1, 2010. Neither party conducted any discovery in this case until opposer served its first request for written discovery upon applicant Biogen Idece MA Inc. ("Biogen") on September 21, 2010. Thereafter, applicant Biogen filed a motion for summary judgment on October 15, 2010 which suspended these proceedings until December 14, 2010 when the Board issued an order denying applicant Biogen's motion for summary judgment. On January 13, 2011, applicant Biogen served its responses to opposer's written discovery requests. On January 18, 2011, the Board issued an order joining applicant Cardiokine Biopharma, LLC ("Cardiokine") as a party defendant to this proceeding

inasmuch as applicant Biogen assigned all rights, title and interest to the subject application to Cardiokine. On March 25, 2011, the Board suspended this case to allow the parties to take discovery limited to their designated expert witnesses. By order dated August 1, 2011, the Board resumed proceedings and set the close of discovery for November 30, 2011. On October 27 2011, opposer conducted a discovery deposition of a non-party witness, i.e., William Johnson of the Brand Institute, Inc., both in his individual capacity and as the designated 30(b)(6) witness of Brand Institute, Inc., because, according to opposer, Brand Institute, Inc. was integrally involved with the selection of applicants' LIXALEV mark. On November 28, 2011, opposer took the 30(b)(6) discovery deposition of applicant Biogen. Applicant Biogen produced Joerg Hermans, Senior Director of Operations of the Emerging Markets Group, as their 30(b)(6)(6) witness. On November 29, 2011, opposer took the 30(b)(6) deposition of applicant Cardiokine. Applicant Cardiokine produced Leonard M. Selihar as their 30(b)(6) witness.

We now turn to opposer's motion to extend discovery. In support thereof, opposer contends that applicant Biogen's 30(b)(6) witness, Mr. Hermans, was neither knowledgeable nor prepared to testify on various matters which opposer sought information as identified in opposer's 30(b)(6) deposition

notice. Specifically, opposer argues that Mr. Hermans was unable to testify as to (1) the names of all individuals employed by applicant Biogen who were responsible for the selection of applicants' LIXALEV mark, (2) communications between applicant Biogen and Brand Institute, Inc. concerning the results of a focus group survey conducted by Brand Institute, Inc.; in particular, a survey regarding the correct pronunciation of applicants' LIXALEV mark, (3) the process which applicant Biogen searched for documents responsive to opposer's document requests and whether applicant Biogen conducted a search regarding electronic documents which may be responsive to those requests, and (4) clinical trials conducted with respect to applicants' identified goods and the results of such trials, including results regarding the safety and efficacy of the goods. In view of Mr. Hermans' alleged inability to respond to the aforementioned topics, opposer seeks to extend discovery in order to take an additional 30(b)(6) deposition of a deponent who would have knowledge of the above-identified topics.

Additionally, opposer argues that it requires an extension of the discovery period in light of applicant Cardiokine's alleged failure to supplement its production of documents responsive to opposer's document request which seeks production of "prototypes and drawings, of all

packaging and labeling, currently used or intended to be use" in association with applicants' goods. Opposer maintains that, although applicant Cardiokine has produced some prototypes and drawings of the packaging and labeling of applicants' identified goods, there appears to be additional prototypes and drawings which were identified during applicant Cardiokine's 30(b)(6) deposition but have not yet been produced. Moreover, once these supplemental documents are produced, opposer argues it will need to propound requests for admission to authenticate the supplemental production of these responsive documents.<sup>1</sup>

The appropriate standard for allowing an extension of a prescribed period prior to the expiration of that period is "good cause." See Fed. R. Civ. P. 6(b) and TBMP § 509 (3d ed. 2011) and the authorities cited therein.

Based upon the record and the arguments advanced during the telephone conference by both opposer and applicants, the Board initially finds that, inasmuch as applicants are willing to stipulate to the authenticity of documents produced during discovery and because applicants have

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<sup>1</sup> During the telephone conference, opposer's counsel indicated there were additional deficiencies with applicants' discovery responses. The Board advised opposer's counsel that the Board was going to limit its consideration of opposer's motion to extend to the deficiencies specifically identified in opposer's motion papers. The Board further advised that, if the parties could not resolve these additional alleged deficiencies after conducting a good faith effort to do so, opposer could then file an appropriate and timely motion for the Board's consideration.

voluntarily agreed to produce the prototype/drawings discussed in applicant Cardiokine's 30(b)(6) deposition, opposer has not demonstrated the required good cause to extend discovery based upon applicant Cardiokine's alleged failure to produce all responsive documents regarding the prototypes and drawings of labeling and packaging currently used or intended to be used in association with applicants' identified goods.

The Board also does not find good cause to extend discovery because of applicant Biogen's 30(b)(6) witness's alleged failure to identify all persons employed by Biogen who were involved in the selection of the LIXALEV mark, as well as his alleged inability to testify as to the results of the clinical trial studies concerning applicants' goods. Specifically, the Board notes that during the telephone conference applicants' counsel stated that applicant Biogen has already identified all individuals employed by applicant Biogen who were involved in the selection of the LIXALEV mark in their response to opposer's interrogatory request on the same topic. Moreover, applicants' counsel indicated during the phone conference that applicant Biogen has already produced the results of the clinical trials at issue and that the results of the clinical trials are nonetheless of public record.

Further, the Board does not find good cause to extend discovery on the ground that applicant Biogen's 30(b)(6) witness was unable to testify as to (1) the process which applicant Biogen searched for documents responsive to opposer's document requests and (2) whether applicant Biogen conducted a search of its electronically-stored documents for purposes of responding to opposer's document requests. To that end, the Board notes that applicant Biogen is under a duty to conduct a comprehensive search of documents in its possession, custody and control, whether electronically-stored or not, and produce documents responsive to opposer's document requests. To the extent applicant Biogen fails to produce responsive documents, it may be precluded from introducing such documents as evidence during its assigned testimony period.

Notwithstanding the foregoing, the Board does find that opposer has demonstrated sufficient good cause to justify its extension request solely in regard to the issue of whether any communications between applicant Biogen and Brand Institute, Inc. occurred concerning the results of a focus group survey conducted by Brand Institute, Inc. regarding the pronunciation of applicants' LIXALEV mark and, if so, what was the substance of such communications. The Board finds this information is relevant to the issues in this proceeding and, therefore, discoverable.

In view thereof, opposer's motion to extend is granted solely to the extent that opposer is allowed until December 22, 2011 to propound an interrogatory request upon applicants regarding whether applicant Biogen and Brand Institute, Inc. conducted any communications between themselves concerning the focus group survey results relating to the pronunciation of applicants' LIXALEV mark, whether in writing and/or orally, and, if so, identify the substance of those communications. In turn, applicants are allowed until January 9, 2012 in which to respond to said interrogatory request. Discovery is otherwise closed. Additionally, during the telephone conference, applicant voluntarily agreed to produce the prototypes and/or drawings of the labeling and packaging currently used or intended to be used in association with applicants' goods, as identified during applicant Cardiokine's 30(b)(6) deposition. Accordingly, applicant is allowed until January 9, 2012 to produce such prototypes and/or drawings.<sup>2</sup>

As a final matter, as noted above, applicants are willing to stipulate to the authenticity of documents

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<sup>2</sup> The time provided to applicants to respond to the interrogatory request permitted herein, as well as the time allowed to produce the prototypes and/or drawings of the labeling and packaging discussed during applicant Cardiokine's 30(b)(6) deposition, does not constitute an order compelling action by applicants but merely serves as a scheduling order.

produced during discovery. During the telephone conference, the Board inquired whether opposer was willing to enter into such a stipulation. Opposer's counsel stated that he first needed to review the documents that opposer has already produced, as well as consult with his client. To the extent opposer agrees to enter into such a stipulation, the parties should file the stipulation with the Board as soon as possible.

Remaining trial dates are reset as follows:

Plaintiff's Pretrial Disclosures	2/9/2012
Plaintiff's 30-day Trial Period Ends	3/25/2012
Defendant's Pretrial Disclosures	4/9/2012
Defendant's 30-day Trial Period Ends	5/24/2012
Plaintiff's Rebuttal Disclosures	6/8/2012
Plaintiff's 15-day Rebuttal Period Ends	7/8/2012

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 Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.