

This Motion is accompanied by a proposed Order to Compel.

STATEMENT OF FACTS

Opposer has and continues to use the mark "NPS" in connection with various pharmaceutical goods and services continuously since at least as early as October 6, 1988. Opposer is the owner of four federally registered marks that include the mark "NPS."

Through an application filed on March 18, 1999, Applicant seeks registration for the trademark "N.P.S." in connection with organizing and administering pharmacy benefit management programs in the field of prescription drugs. Applicant's application alleges that it first used "N.P.S." in commerce in 1994. Accordingly, Opposer used the mark "NPS" prior to Applicant's first use of the mark "N.P.S."

Use by Applicant of the trademark "N.P.S." in connection with services for organizing and administering pharmacy benefit management programs in the field of prescription drugs is likely to cause confusion, mistake, or deception with Opposer and its mark, "NPS."

Applicant's use of the trademark "N.P.S." will likely result in the belief by purchasers and others that Applicant's services are in some way legitimately connected with, sponsored by, or approved by Opposer. As a result, Opposer filed a Notice of Opposition on January 23, 2001, to initiate this proceeding.

On June 8, 2001, Opposer served Opposer's First Set of Requests for Production of Documents and Things (the "Requests for Documents"), Opposer's First Set of Interrogatories to Applicant (the "Interrogatories"), and Opposer's First Set of Requests for Admissions ("Requests for Admissions") upon Applicant. (A copy of the Requests

for Documents is attached hereto as Exhibit 1, a copy of the Interrogatories is attached hereto as Exhibit 2, and a copy of the Requests for Admissions is attached as Exhibit 3).

Opposer's Requests for Documents contained only nine requests, each of which were plainly relevant to this proceeding. Representative requests are listed below:

REQUEST NO. 3: Representative specimens of each product, advertisement, business card, letterhead, promotional literature, point of purchase or other display, or other promotional item used in connection with the mark "N.P.S." or any similar mark.

REQUEST NO. 7: All documents which refer or relate to the use, registration, prosecution, or application for registration of any mark containing the term or mark "N.P.S." or any similar mark in connection with any products in the United States.

REQUEST NO. 9: All documents which refer or relate to Applicant's first use of any mark containing the term or mark "N.P.S." or any similar mark in connection with any products in the United States.

The requests shown above and all requests made by Opposer are directly at issue in this proceeding and are quite reasonable in scope.

On July 27, 2001, Applicant served Applicant's Responses to Opposer's First Set of Requests For Production of Documents and Things to Applicant ("Responses to Requests") on Opposer. (A copy of the Responses to Requests is attached hereto as Exhibit 4.) The Responses to Requests contained a series of objections and absolutely no documents were produced. Although assurances were made that "responsive, non-privileged documents" would be produced, not a single document has been supplied to Opposer more than a year and two months later. *See* Responses 1-9 of the Responses to Requests.

Like the Requests for Documents, the Interrogatories are reasonable in scope and highly relevant to this proceeding. For example, Interrogatory No. 20 reads:

State the following with respect to Applicant's use of the term or mark "N.P.S." or any similar mark either alone or in combination with any other words or symbols:

(a) The date on which the term or mark was first used by Applicant on or in association with any goods and/or services;

(b) The goods and/or services to which the term or mark was initially applied by Applicant;

(c) The geographical location(s) where the goods and/or services identified in the answer to subpart (b) of this interrogatory were initially sold; and

(d) Identify all documents referring to or relating to the initial suggestion, adoption, and use of the term or mark by Applicant.

This interrogatory, like the remaining interrogatories, seeks plainly relevant information and is reasonable in scope. Nevertheless, Applicant's Responses to Opposer's First Set of Interrogatories to Applicant ("Responses to Interrogatories"), which is attached as Exhibit 5, although providing some information, generally constitutes a series of general objections. For instance, in response to Interrogatory No. 20, quoted above, Applicant states:

PTI restates and hereby incorporates its General Objections. In addition, PTI objects to this discovery request as overly broad and burdensome. PTI objects to this discovery request to the extent that it calls for the discovery of information protected by the attorney-client privilege and/or work product doctrine or are otherwise privileged and/or protected from discovery. PTI further objects to this discovery request to the extent that it requests information concerning claims and defenses not yet developed by the discovery process.

No answer is provided to the simple and critical question posed by subsection (a), which asks when the mark was first used by the Applicant. Furthermore, precisely the same objection recited above is advanced by Applicant in response to all but Interrogatory Nos. 8-10, 12, and 23.

The Interrogatories also request that Applicant identify "each and every document . . . supporting or evidencing" Applicant's denials of any of the Requests for Admissions. (See Interrogatory Nos. 40-51.) In Applicant's Response to Opposer's First Set of Requests for Admissions to Applicant ("Responses to Admissions"), which is attached as Exhibit 6, Applicant denied Opposer's first two requests, which state:

1. Admit that Applicant's first use anywhere of the mark "N.P.S." or any similar mark was after December 31, 1993.
2. Admit that Applicant's first use anywhere of the mark "N.P.S." or any similar mark on or in connection with the administration of pharmacy benefit management programs in the field of prescription drugs was after December 1, 1993.

Notwithstanding Applicant's denials of the first two Requests for Admissions, Applicant failed to identify a single document that supports the denials, as requested in Interrogatory Nos. 40 and 41. Furthermore, Applicant failed to produce the supporting documents, although Request for Documents No. 1 expressly asks for the production of all documents identified in response to the Interrogatories.

Applicant's failure to respond to Opposer's discovery request in good faith has severely hampered the progress of this case. Applicant's dilatory tactics and recalcitrant conduct should not be tolerated by the Board.

ARGUMENT

I. THE INFORMATION SOUGHT BY THE REQUESTS AND INTERROGATORIES IS CLEARLY RELEVANT.

Discovery may be obtained "regarding any matter, not privileged, that is relevant to the claim or defense of any party." Fed. R. Civ. Proc. 26(b)(1). Moreover, the information sought "need not be admissible at trial if the discovery appears reasonably calculated to lead to the discovery of admissible evidence." *Id.* The relevance standard for discovery is very liberal.

This proceeding requires the Board to determine whether Applicant's mark "N.P.S." may be registered in view of Opposer's use of the mark "NPS." Relevant to this determination is, for example, the date of Applicant's first use of the mark, the geographical scope of its use, and the nature of the goods or services used in connection with its mark. In this regard, consider the following request.

REQUEST NO. 3: Representative specimens of each product, advertisement, business card, letterhead, promotional literature, point of purchase or other display, or other promotional item used in connection with the mark "N.P.S." or any similar mark.

The documents requested seek to determine the nature of Applicant's use of the mark by obtaining documents containing Applicant's mark. The documents sought by Request for Documents No. 3 are relevant to this proceeding, as are each of the requests and interrogatories advanced by Opposer.

Furthermore, the circumstances indicate that much of the requested information is not protected by a privilege. Again, consider Request for Documents No. 3, which is quoted above. The information requested by Request for Documents No. 3 would generally not involve attorney-client communications or documents encompassed by the

work-product doctrine. The information sought would generally be distributed to current or prospective customers and, thus, would not involve confidential information.

Moreover, if any of the requested documents contained such information, it could easily be redacted to conceal privileged information without impinging on the requested information.

Accordingly, Applicant should be ordered to produce the requested information.

II. APPLICANT'S FAILURE TO PRODUCE A SINGLE DOCUMENT DEMONSTRATES THE INADEQUACY OF APPLICANT'S RESPONSES

The Requests for Documents seek clearly relevant, unprivileged information. Applicant's failure to produce even a single document reveals a complete lack of effort on Applicant's part to comply with the Requests for Documents. Applicant clearly has a duty to "thoroughly search its records for all information properly sought in the requests." TBMP 412.02. Furthermore, Applicant has a duty to supplement responses that are "incomplete." Fed.R.Civ.Proc. 26(e)(2) and TBMP 412.03. Undoubtedly, given the relevant nature of the Requests for Documents, numerous unprivileged documents can be produced if Applicant engages in good faith in an effort to comply with the Requests for Documents.

Referring again, by way of example, to Request for Documents No. 3, Applicant's failure to produce a single document suggests that not a single advertisement or promotional item contained Applicant's mark. Given the circumstances, this cannot be believed. A simple examination of Applicant's Web site shows repeated use of Applicant's mark. *See*, for example, the printouts attached as Exhibit 7. Surely, Applicant's Web site is not the only place that Applicant has used its mark.

As such, Applicant should be ordered to produce the requested information.

III. APPLICANT'S REPEATED (46 TIMES) AND CARELESS USE OF A BOILERPLATE OBJECTION INDICATES APPLICANT'S FAILURE TO RESPOND IN GOOD FAITH TO THE INTERROGATORIES.

The Interrogatories seek information that is clearly relevant to this proceeding.

Again, by way of example, Interrogatory No. 20 reads:

State the following with respect to Applicant's use of the term or mark "N.P.S." or any similar mark either alone or in combination with any other words or symbols:

(a) The date on which the term or mark was first used by Applicant on or in association with any goods and/or services;

(b) The goods and/or services to which the term or mark was initially applied by Applicant;

(c) The geographical location(s) where the goods and/or services identified in the answer to subpart (b) of this interrogatory were initially sold; and

(d) Identify all documents referring to or relating to the initial suggestion, adoption, and use of the term or mark by Applicant.

Interrogatory No. 20(a) seeks information that is central to this proceeding: when Applicant first used its mark. Not only is the information sought important to this proceeding, but it may be the most important information at issue in the case. Notwithstanding the clear relevance and importance of this information, Applicant's objection reads as follows:

PTI restates and hereby incorporates its General Objections. In addition, PTI objects to this discovery request as overly broad and

burdensome. PTI objects to this discovery request to the extent that it calls for the discovery of information protected by the attorney-client privilege and/or work product doctrine or are otherwise privileged and/or protected from discovery. PTI further objects to this discovery request to the extent that it requests information concerning claims and defenses not yet developed by the discovery process.

Interrogatory No. 20 is clearly not overly broad or burdensome, nor is the information protected by the attorney-client privilege or the work product doctrine. Furthermore, a response to this interrogatory does not require the development of claims and defenses. It requests purely factual information.

The response to Interrogatory No. 20 is not unusual. In fact, 46 of Applicant's 51 responses to the Interrogatories are identical verbatim to Applicant's response to Interrogatory No. 20. Applicant's repeated and almost mindless use of this boilerplate objection indicates the careless manner in which Applicant responded to Opposer's Interrogatories.

In view of the foregoing, Applicant should be ordered to produce the requested information.

IV. IN THE ALTERNATIVE, APPLICANT SHOULD NOT BE PERMITTED TO USE DOCUMENTS ESTABLISHING ITS DATE OF FIRST USE OF THE MARK "N.P.S." BECAUSE IT FAILED TO PRODUCE SUCH DOCUMENTS WHEN PROPERLY REQUESTED TO DO SO.

Through the Requests for Documents, Requests for Admissions, and Interrogatories, Opposer has clearly and repeatedly requested documents showing Applicant's first use of the mark or term "N.P.S." For example, Interrogatory No. 4 requests that Applicant identify all documents that relate to Applicant's assertion in the Answer that it "first began using the mark shown in U.S. trademark application Ser. No.

75/662,884, at least as early as 1994." Request for Documents No. 1 specifically requests all documents identified by Applicant in response to the Interrogatories. No documents were either produced or identified in response to Interrogatory No. 4 and Request No. 1.

As another example, Interrogatory 20(a) asks Applicant to identify the date it first used the mark "N.P.S." or any similar mark. Interrogatory No. 14(d) similarly asks Applicant to identify the date that the mark "N.P.S." or any similar mark was first used by any business "in which Applicant is engaged or has any interest" in. Request for Documents No. 2 requests that Applicant produce all documents "reviewed or relied upon" by Applicant in responding to the Interrogatories. Once again, no documents were produced in response to this request.

Furthermore, Request for Documents No. 9 seeks "[a]ll documents which refer or relate to Applicant's first use of any mark containing the term or mark 'N.P.S.' or any similar mark in connection with any product in the United States." Also, as explained in the Statement of Facts, Applicant failed to identify or produce a single document to support its denials of the Requests for Admission Nos. 1 and 2, which request that Applicant admit that its first use of "N.P.S." or any similar mark was after December 31, 1993. (*See* Interrogatory Nos. 40-41 in view of Request for Documents No. 1) Thus, Opposer has repeatedly asked Applicant to produce all documents showing Applicant's date of first use of the mark or term "N.P.S." Applicant has failed to produce any such document.

This failure to produce the requested documents precludes Applicant from introducing these documents at trial. *See Bison Corp. v. Perfecta Chemie B.V.*, 4

USPQ2d 1718 (TTAB 1987) (barring the introduction of documents that were previously requested by the opposing side) and TBMP 412.02.

Accordingly, Applicant should be barred from using documents to show its date of first use of the mark or term "N.P.S." at trial.

CONCLUSION


Applicant did not produce a single document in response to Opposer's Requests for Documents. Furthermore, Applicant's careless and repeated use of a boilerplate objection to the Interrogatories is indicative of Applicant's feeble attempt to comply with the discovery requests. Accordingly, Applicant should be ordered to produce the requested information. In the alternative, Applicant should be precluded from introducing documents to prove its date of first use of the mark "N.P.S."

Opposer further requests that, in accordance with 37 CFR 2.120(e), that this case be suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to this Motion.

Respectfully submitted,

NPS Pharmaceuticals, Inc.,

By:



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Attorney for Opposer
Registration No. 31,398

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing MOTION TO COMPEL was served upon the attorney of record for Applicant via first class mail postage prepaid, on this 24 day of October, 2002 in an envelope addressed as follows:

James R. Menker
PILLSBURY WINTHROP LLP
1600 Tyson Boulevard
McLean, Virginia 22102

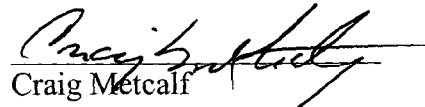


CERTIFICATE OF DEPOSIT

I hereby certify that the attached MOTION TO COMPEL is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to Box TTAB No Fee, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.

Dated this 24 day of October, 2002.

Respectfully submitted



Craig Metcalf
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That Applicant be precluded from introducing any documents showing Applicant's date of first use of the mark or term N.P.S. or any similar mark.

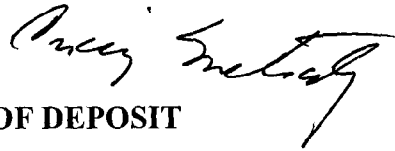
Dated this _____ day of _____, 20_____.

TRADEMARK TRIAL AND APPEAL BOARD

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PILLSBURY WINTHROP LLP
1600 Tyson Boulevard
McLean, Virginia 22102

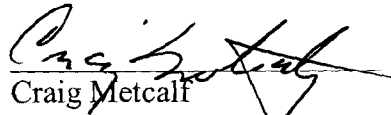


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