ESTTA Tracking number: **ESTTA248003**

Filing date: **11/10/2008**

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

Proceeding	91180212
Party	Plaintiff Schering Corporation
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Date	11/10/2008
Attachments	1246-314399US-mot.pdf (6 pages)(177934 bytes)

Attorney Docket No.: 314399US-21

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

Schering Corporation,	)	
	)	
Opposer	)	
	)	
v.	)	Opposition No.: 91/180,212
	)	U. S. Appln. Serial No.: 77/070,074
IDEA AG,	)	DIRACTIN
	)	
Applicant	)	
	)	

Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

OPPOSER'S REPLY TO APPLICANT'S AMENDED OPPOSITION TO OPPOSER'S MOTION TO COMPEL DISCOVERY RESPONSES AND MOTION TO TEST SUFFICIENCY OF RESPONSES

AND

OPPOSER'S OPPOSITION TO APPLICANT'S MOTION FOR MODIFICATION OF THE BOARD'S STANDARD PROTECTIVE ORDER

PROTECTIVE ORDER

Opposer argues first on Applicant's motion for modification of the Board's standard protective order. Applicant cites TBMP 412.02(a) as authority for its motion to have the Board modify the standard protective order. TBMP 412.02(a) does not provide any authority for Applicant's proposition. Under TBMP 412.02(a), which dates back to a time before the standard protective order was automatically in effect for all opposition

and cancellation proceedings, the Board granted a motion for a protective order by directing preparation of an order mutually agreeable to the parties or, alternatively, permitting one party to accept a protective order proffered by the other party, or by ordering the parties to adhere to the Board's standard protective order. There is no language in TBMP 412.02(a) that authorizes the Board to impose a modification of the standard protective order in response to a contested motion by one of the parties.

The difference between the parties concerning the modification of the standard protective order is where venue will lie in the event litigation ensues to enforce a term or provision of the standard protective order and which court will have jurisdiction.

There is, at present, no stipulated protective order between the parties. Opposer is not presently subject to jurisdiction in any German court and does not wish to subject itself to jurisdiction in any German court as a result of being a party to this opposition. The proceeding is an opposition in the United States Patent and Trademark Office and it is appropriate that the governing law for any action to enforce a protective order would be governing law in the United States. Since Opposer has an office in New Jersey, that is the most appropriate state for venue and also for jurisdiction.

Applicant voluntarily chose to apply to register its mark in the United States and therefore voluntarily assumed the burden of subjecting itself to appropriate law in the United States.

In any case, there is no authority for the Board to modify the standard protective order over the objection of one of the parties.

MOTION TO COMPEL RESPONSES AND TEST ADEQUACY OF RESPONSES TO REQUESTS FOR ADMISSIONS

Applicant's arguments on Opposer's motion to compel responses to interrogatories and requests for production and to test the adequacy of responses to Opposer's requests for admissions fall into four categories.

First, Applicant argues that German law precludes the disclosure even of the existence of a document protected by the attorney-client privilege in Germany. Secondly, Applicant argues that confidential information should not be disclosed until a protective order (acceptable to Applicant) is in place. Thirdly, Applicant argues that some of the information and documents are not in existence. Fourthly, Applicant argues that the discovery requests are irrelevant because the application was filed under Section 1(b) of the Trademark Act on the basis of an intention to use the mark.

To the extent that German law precludes the disclosure of the contents or even the existence of any document, the Board should issue an order precluding Applicant from introducing any evidence or testimony related to any fact or evidence withheld from disclosure on the ground that disclosure would be in violation of German law.

Applicant should be compelled to disclose information it is withholding as confidential on the basis of its argument that a satisfactory protective order is not in place. The Board adopted the standard protective order for the express purpose of saving the time and effort that was invested in deciding motions between competing protective orders, and that objective would be frustrated if any party could argue unilaterally for the modification of the standard protective order or withhold the disclosure of information in the absence of a protective order the withholding party deems to be acceptable.

Any withholding of information on the ground it is irrelevant because the application was filed under Section 1(b) of the Trademark Act is incorrect. An application may be filed under Section 1(b) even though the mark of that application may in fact have been in use for the goods described in the application prior to the filing date. There is also the possibility that use of a mark may be started subsequent to the filing date. In either case, information concerning the use of the mark and the promotion and sale of the goods would be highly relevant.

Furthermore, pursuant to Rule 26(e)(1) Fed. R. Civ. P., which is made applicable to proceedings before the Board by 37 C.F.R. § 2.116(a), Applicant has a duty to serve supplemental and corrective disclosures in a timely manner if Applicant learns that, in any material respect, prior disclosures or responses were incomplete or incorrect.

The obligation to provide supplemental or corrective information applies to information which Applicant says is currently nonexistent and to information which comes into existence later because the mark is put into use.

Applicant should be ordered to serve responses and documents that have been withheld because Applicant disagrees with the standard protective order or because Applicant believes that use of a mark subsequent to the filing date of the application is not relevant.

Respectfully submitted,

Schering Corporation

By: David J. Kera

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Date: November 10, 2008

DJK/ojb [illegible]

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing **OPPOSER'S REPLY TO APPLICANT'S OPPOSITION TO OPPOSER'S MOTION TO STRIKE AND OPPOSER'S REPLY TO APPLICANT'S COUNTER-MOTION TO STRIKE OPPOSER'S MOTIONS TO COMPEL DISCOVERY RESPONSES AND TEST SUFFICIENCY OF RESPONSES** was served on counsel for Applicant, this 10th day of November, 2008, by sending via First Class mail, postage prepaid to,

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D. Jean Barrett

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