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

Proceeding	91200769
Party	Plaintiff Synthes USA, LLC
Correspondence Address	DENISE I MROZ WOODCOCK WASHBURN LLP CIRA CENTRE 12TH FLOOR , 2929 ARCH STREET PHILADELPHIA, PA 19104-2891 UNITED STATES dmroz@woodcock.com
Submission	Other Motions/Papers
Filer's Name	Jacqueline M. Lesser
Filer's e-mail	trademarks@woodcock.com, jlesser@woodcock.com, dmroz@woodcock.com, jdale@woodcock.com
Signature	/Jacqueline M. Lesser/
Date	01/04/2013
Attachments	2013-01-04 - Declarationof Jacqueline M. Lesser w-Exhibits.PDF (19 pages) (224618 bytes)

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

Synthes USA, LLC, <p style="text-align:right">Opposer,</p> <p style="text-align:center">v.</p> <p style="text-align:left">Ferring B.V.,</p> <p style="text-align:right">Applicant.</p>	In Re: Serial Nos.: 76702122 and 76702123 Filed: March 18, 2010 Published: March 22, 2011 Mark: SYNTESE Opposition No.: 91200769
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DECLARATION OF JACQUELINE M. LESSER

I, Jacqueline M. Lesser submit this declaration and supporting exhibits in support of Synthes USA, LLC's ("Synthes") opposition to Ferring B.V.'s ("Ferring") motion to compel:

1. Attached as Exhibit A are Ferring's first set of interrogatories
2. Attached as Exhibit B is the correspondence from Synthes regarding the number of interrogatories.
3. Attached here as Exhibit C is Ferring's 12/20/12 response to Synthes' letter .
4. Synthes and Ferring exchanged first sets of discovery requiring formal responses in November 2013. Ferring refused to respond to Synthes' Interrogatory requests on the ground that Request No. 23 exceeded the number of interrogatories. Attached as Exhibit D is Ferring's formal objection, and the correspondence between counsel relating to Ferring's objection to Synthes' Interrogatory No. 23.

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



Jacqueline M. Lesser

EXHIBIT A

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

SYNTHES USA, LLC,	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No. 91200769
	:	
FERRING B.V.,	:	Serial No. 76/702,122
	:	Serial No. 76/702,123
Applicant.	:	

APPLICANT'S FIRST SET OF INTERROGATORIES TO OPPOSER

Pursuant to Rule 33 of the Federal Rules of Civil Procedure and to 37 C.F.R. §§ 2.116(a) and 2.120(d)(1), Applicant, Ferring B.V., hereby serves the following interrogatories on Synthes USA, LLC ("Opposer") to be answered separately and fully in writing, under oath by an officer or agent of Opposer within 30 days from the date of service hereof.

I. INSTRUCTIONS AND DEFINITIONS

A. Reference herein to Opposer shall be construed as referring also to its business predecessors in interest and to companies, corporations or persons controlling Opposer and all persons employed thereby, including, but not limited to, directors, officers, attorneys, agents or other persons acting on behalf of Opposer, and these Interrogatories shall be answered in conformance with such construction.

B. In the event that Opposer asserts that any document or thing of which the identity is requested is privileged, it is requested to so state when identifying the document or thing, and to state with respect to the asserted claim of privilege: (1) why privilege is claimed; (2) the type of factual matter involved in the assertion of privilege to an extent necessary for understanding the assertion; and (3) each and every person to whom the asserted privileged

subject matter has been communicated.

C. As used herein, the term "document" is utilized to the full meaning of that term as defined in Rule 34 of the Federal Rules of Civil Procedure and includes, without limitation, the original (or copy when an original is not available) and each nonidentical copy (which is different from the original or any copy because of revisions, notations thereon, postscripts, amendments or addenda attached thereto or otherwise associated therewith) or distribution copy, of writings or other graphic material, whether inscribed by hand or by mechanical, electronic, photographic or other means, including, without limitation, correspondence, memoranda, publications, articles, transcripts, diaries, telephone logs, message sheets, records, voice recordings, tapes, film, disks, diskettes and other data compilations from which information can be obtained, which is or was at any time in Opposer's possession, custody or control or known or believed to exist or to have existed. Without limitation, as used in this definition, a document is deemed to be in Opposer's "control" if Opposer has or had the right to secure the document or a copy thereof from another person or governmental entity having actual physical possession thereof.

D. The term "identify" or "give the identification of" a document or thing is defined to mean a demand for a detailed description of each specific item for which identification is requested, whether or not it may be privileged or subject to an immunity and whether or not it is in Opposer's possession, custody or control, by setting forth:

- 1) a description of its nature or type (e.g., letter, contract, e-mail, etc.);
- 2) its date;
- 3) the present location and custodian of the original and all copies;

- 4) the names of the writer and recipients of the original and all copies; and
- 5) the title or subject matter with sufficient particularity to enable it to be identified.

For any individual named as a writer or a recipient of such an item, the individual's full name and address should be stated, together with his present or last position and business affiliation. For any firm or corporation named, its full address should be stated, together with the name, address, and title of the official responsible for preparing or having custody of any such item. A copy of a document may be provided in lieu of identification thereof.

E. The term "identify" or "give the identification of" with respect to a person is defined to mean a demand for the full name, residence address, present or last known business affiliation, and job title and description of job responsibilities of such person, together with a statement as to his relationship with Opposer, if any, and if not presently related, a statement as to whether any such relationship ever existed and the inclusive dates thereof.

F. The term "identify" or "state the identity of" with respect to a person that is not a natural person is defined to mean a demand for its full name, specifying its nature (e.g., corporation, partnership, etc.); the general nature of its business (e.g., products manufactured or sold, services rendered, etc.); its present or last-known principal business address, identified as such, and such other of its business addresses as are known; and setting forth: (i) if it is a corporation, the state of its incorporation, and identity of the principal officers of said corporation; (ii) if it is a partnership, whether it is a general or limited partnership, and identity of each general or limited partner; and (iii) in the case of any other business entity, the identity of

each owner thereof.

G. These Interrogatories seek answers as of the date they are answered. Opposer should also supply any additional information relating in any way to these Interrogatories which is acquired by or which becomes known to Opposer up to and including the time of trial promptly after such information is acquired or becomes known.

H. The terms "trademark," "service mark" or "mark" include trademarks, service marks, trade names, or any word or symbol utilized in connection with business activities.

I. The term "the SYNTESE Mark" means the mark in Application Serial No. 76/702,122, and Serial No. 76/702,123.

J. The term "the SYNTHES Mark" refers to Opposer's marks identified in the Notice of Opposition and any other mark that includes the word "SYNTHES".

K. The term "the SYNTHES Goods" means the goods covered by Registration No. 999,397, No. 2,561,835, and No. 2,788,064, and any other goods and services that Opposer is using or intends to use in association with a mark that includes the word "SYNTHES".

L. All answers relating to use of Opposer's trademark, sales amounts, and advertising should be construed as geographically within the United States of America and its territories. Any dates of use and other particulars related to Opposer's trademark use in other countries shall require qualifying the geographic scope outside the U.S.

II. INTERROGATORIES

INTERROGATORY NO. 1

Identify all marks used by Opposer that incorporate the word SYNTHES, and the date such mark was adopted.

INTERROGATORY NO. 2

Identify by common commercial name all the products that have been offered under the SYNTHES Mark.

INTERROGATORY NO. 3

For each product that has been offered under the SYNTHES Mark, set forth Opposer's date of first use of the SYNTHES Mark on the product.

INTERROGATORY NO. 4

For each product that has been offered under the SYNTHES Mark, identify each type of establishment or institution to which the product has been sold.

INTERROGATORY NO. 5

Identify the retail price for each product that has been offered under the SYNTHES Mark.

INTERROGATORY NO. 6

Identify the annual volume of sales by dollar amount and by number of units sold for each product that has been sold under the SYNTHES Mark.

INTERROGATORY NO. 7

Identify the channels of trade for each product that has been offered under the SYNTHES Mark.

INTERROGATORY NO. 8

For each product that has been offered under the SYNTHES Mark, identify the classes of consumers that purchase each product, and the classes of consumers that are the end users of each product.

INTERROGATORY NO. 9

For each product that has been offered under the SYNTHES Mark, identify the conditions under which sales are made.

INTERROGATORY NO. 10

State the total dollar amount spent annually in promoting the SYNTHES Goods.

INTERROGATORY NO. 11

Identify all media (including, but not limited to, social media, websites, trade journals, newsletters, magazines, advertising, direct-mail, radio programs, television programs, radio shows, trade shows, and conferences) in which Opposer has advertised the SYNTHES Goods.

INTERROGATORY NO. 12

Identify each product offered under the SYNTHES Mark that Opposer has sought government approval to sell the product.

INTERROGATORY NO. 13

Identify each product offered under the SYNTHES Mark that Opposer has received government approval to sell the product.

INTERROGATORY NO. 14

Identify all assignments or licenses concerning or involving the SYNTHES Mark.

INTERROGATORY NO. 15

Specify in detail how and when Opposer first learned of Applicant.

INTERROGATORY NO. 16

Specify in detail how and when Opposer first learned of Applicant's Mark.

INTERROGATORY NO. 17

Identify in detail all instances of confusion (actual or possible) between the SYNTHES Goods and Applicant's goods offered for sale or sold under the SYNTESE Mark.

INTERROGATORY NO. 18

Identify in detail each survey that has been or will be conducted in connection with the SYNTESE Mark, the SYNTHES Mark, or this proceeding.

INTERROGATORY NO. 19

In accordance with Rule 26(b)(4) of the Federal Rules of Civil Procedure, identify each person Opposer expects to call as an expert witness at trial, stating the subject matter on which each expert is expected to testify, the substance of the facts and opinions to which the expert is expected to testify and a summary of the grounds for each opinion.

INTERROGATORY NO. 20

Identify all proceedings or objections by or against Opposer involving the SYNTHES Mark.

INTERROGATORY NO. 21

Identify any market research conducted by or on behalf of Opposer regarding the SYNTHES Mark.

INTERROGATORY NO. 22

Identify all facts that support Opposer's claim that the SYNTHES Mark is famous.

INTERROGATORY NO. 23

Identify all facts that support Opposer's claim that the SYNTHES Mark is inherently distinctive.

INTERROGATORY NO. 24

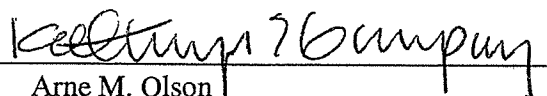
Identify all facts that support Opposer's claim that the SYNTESE Mark is likely to cause and has caused dilution of the distinctive quality of the SYNTHES Mark.

Respectfully submitted,

FERRING B.V.

Date: November 1, 2012

By:



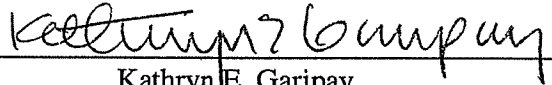
Arne M. Olson
Kathryn E. Garipay
Alissa A. Digman
OLSON & CEPURITIS, LTD.
20 North Wacker Drive
36th Floor
Chicago, Illinois 60606
(312) 580-1180
Attorneys for Applicant

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **APPLICANT'S FIRST SET OF INTERROGATORIES TO OPPOSER** is being served on Opposer's counsel, Denise I. Mroz, Esq. and Jacqueline Lesser, Esq., WOODCOCK WASHBURN LLP, Cira Centre, 12th Floor, 2929 Arch Street, Philadelphia, PA 19104 by electronic transmission, as agreed upon by the parties, at the following email addresses:

Dmroz@woodcock.com
Jlesser@woodcock.com

on this 1st day of November, 2012.



Kathryn E. Garipay

EXHIBIT B



INTELLECTUAL PROPERTY LAW
ATLANTA • PHILADELPHIA • SEATTLE

PHILADELPHIA OFFICE
Cira Centre, 12th Floor
2929 Arch Street
Philadelphia, PA 19104-2891
215.568.3100
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December 12, 2012

JACQUELINE LESSER
215.564.2155
jlesser@woodcock.com

VIA EMAIL: KGaripay@olsonip.com

Kathryn E. Garipay, Esq.
Olson & Cepuritis, Ltd.
20 North Wacker Drive, 36th Floor
Chicago, IL 60606

Re: **Synthes USA, LLC v. Ferring B.V.**
Opposition No. 91200769 against
SYNTESE, Serial No. 76/702,122
SYNTESE, Serial No. 76/702,123

Dear Kathryn:

This is further to your letter regarding Synthes' objections to the number of interrogatories propounded by Ferring. I will note that your letter contradicts your own analysis of Synthes' Interrogatories.

The Board will look to subparts of an interrogatory even where the requester has attempted to make the interrogatory look like a single interrogatory. Ferring's interrogatories have multiple subparts, requiring Synthes to identify – for each product under each mark – dates of first use, common commercial names, retail prices, annual dollar sales, *etc.* Indeed, it is the substance of the interrogatories at issue, not how the request has been made – and here, Synthes is called upon to answer separate questions for each product.

Without waiver of Synthes' rights to object on any other basis, we look forward to receipt of new interrogatories which comply in number with the Board's rules.

Sincerely,

A handwritten signature in cursive script that reads 'Jacqueline Lesser'.

Jacqueline Lesser

JL/jw

EXHIBIT C

Lesser, Jackie (Woodcock Washburn)

From: Kathryn E. Garipay <KGaripay@olsonip.com>
Sent: Thursday, December 20, 2012 5:31 PM
To: Mroz, Denise Incorvaia (Woodcock Washburn); Lesser, Jackie (Woodcock Washburn)
Cc: Arne M. Olson; Alissa A. Digman; Mary Burton
Subject: SYNTESE Opposition
Attachments: Motion to Compel.pdf

Re: Synthes USA, LLC v. Ferring B.V.
 Opposition No. 91200769 against
 SYNTESE, Serial No. 76/702,122 in Class 5
 SYNTESE, Serial No. 76/702,123 in Class 1

Dear Denise and Jackie:

We have filed with the Trademark Trial and Appeal Board (“the Board”) the attached Motion to Compel. In view of the differences of opinion on how interrogatories should be counted, we will let the Board determine whether the interrogatories we served exceed the 75 limit.

Sincerely,

Kathryn

Kathryn E. Garipay
OLSON & CEPURITIS, LTD.
20 North Wacker Drive, 36th Floor
Chicago, Illinois 60606
(312) 580-1180
(312) 580-1189 (fax)
kgaripay@olsonip.com

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EXHIBIT D

Lesser, Jackie (Woodcock Washburn)

From: Lesser, Jackie (Woodcock Washburn)
Sent: Thursday, November 29, 2012 4:44 PM
To: 'Kathryn E. Garipay'
Cc: Mroz, Denise Incorvaia (Woodcock Washburn); Arne M. Olson; Dale, Judy (Woodcock Washburn); Williams, Clara Jackie (Woodcock Washburn)
Subject: RE: Synthes v. Ferring. U.S. Opposition No. 91200769

Kathryn,

Thank you for identifying for us the interrogatory that forms the basis of Ferring's objections as to the number of interrogatories.

In order to avoid the number of interrogatories served on Ferring becoming a contested discovery issue, Synthes will agree to remove Interrogatory No. 23 from Opposer's First Set of Interrogatories to Applicant. We look forward to Ferring's substantive responses in the next two weeks.

Best regards,

Jackie

Jacqueline Lesser
Counsel
Woodcock Washburn LLP
Cira Centre, 12th Floor
2929 Arch Street
Philadelphia, PA 19104-2891
Tel: 215.564.2155
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From: Kathryn E. Garipay [mailto:KGaripay@olsonip.com]
Sent: Wednesday, November 28, 2012 2:44 PM
To: Lesser, Jackie (Woodcock Washburn)

Cc: Mroz, Denise Incorvaia (Woodcock Washburn); Arne M. Olson; Dale, Judy (Woodcock Washburn); Williams, Clara Jackie (Woodcock Washburn)

Subject: RE: Synthes v. Ferring. U.S. Opposition No. 91200769

Dear Jackie:

In response to your inquiry, we followed the Board's guidance set forth in Section 405.03(d) of the TBMP in counting interrogatories. Based on that guidance, which counts interrogatories and subparts (whether numbered or not), we determined that Synthes' interrogatories totaled over 75. For example, Interrogatory No. 23 alone is over 75. That interrogatory has two sub-parts for each interrogatory (23) and for each Request for Production (16); $(2 \times 23) + (2 \times 16) = 78$. Thus, even if you count the remaining numbered interrogatories, and ignore their subparts, the total number (100) well exceeds the limit of 75.

Sincerely,

Kathryn
Kathryn E. Garipay
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20 North Wacker Drive, 36th Floor
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(312) 580-1180
(312) 580-1189 (fax)
kgaripay@olsonip.com

From: Lesser, Jackie (Woodcock Washburn) [<mailto:jlesser@woodcock.com>]

Sent: Tuesday, November 27, 2012 2:48 PM

To: Kathryn E. Garipay

Cc: Mroz, Denise Incorvaia (Woodcock Washburn); Arne M. Olson; Dale, Judy (Woodcock Washburn); Williams, Clara Jackie (Woodcock Washburn)

Subject: Synthes v. Ferring. U.S. Opposition No. 91200769

Kathryn,

We received Ferring's responses to Synthes' discovery requests and initially note Ferring's objections to Synthes' First Set of Interrogatories on grounds that Ferring is of the view that the numbered 22 requests total over 75.

We would like to know how you have counted over 75 requests – please provide us with the basis for your re-numbering.

Regards,

Jacqueline Lesser
Counsel
Woodcock Washburn LLP
Cira Centre, 12th Floor
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Philadelphia, PA 19104-2891
Tel: 215.564.2155
Fax: 215.568.3439

Email: jlesser@woodcock.com

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