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

Proceeding	91200769
Party	Defendant Ferring B.V.
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**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 REPLY IN SUPPORT OF MOTION TO COMPEL**

It is apparent that the dispute concerning whether the interrogatories served by Applicant exceed the limit allowed centers around Interrogatory Nos. 3 through 9. Of the remaining interrogatories, Opposer and Applicant are almost in agreement with how the interrogatories should be counted, with the exception of interrogatory numbers 17 and 20. *Compare* Motion to Compel, p. 3 with Opposer's Response, p. 4. The parties, however, disagree with the method of counting the number of questions posed by interrogatories 3 through 9. Applicant's counting method is based on the questions asked. Opposer's counting method is based on the *possible response*, claiming that "many of the requests require substantively different responses, and therefore create different and separate interrogatories." (Response, p. 1). Thus, the issue to be decided by the Board is how many questions are asked in Interrogatory Nos. 3 through 9, and how is that determination made.

The disputed interrogatories, Nos. 3 through 9, are reproduced below:

**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.

Opposer claims that each of these interrogatories ask at least 15 questions. That counting is based on a *possible response* to the interrogatory, not on the questions asked: "The information requested for each product is substantively a separate response" (Response, p. 2); "separate substantive responses would be required for at least 15 products, thus creating at least 15 subparts for Interrogatory Nos. 3-9 (Response, p. 3); and "Here, [Applicant's] Interrogatory Nos. 3-9 require separate substantive responses for each of the products that [Opposer] identifies as offered under the SYNTHES mark." (Response, p. 5). Opposer, however, has not provided any support for its contention that the number of questions posed by an interrogatory is based on the response.

The determination of the number of questions an interrogatory asks is based on the *questions asked*, not on the response. TBMP §405.03(d). If Opposer's counting method is adopted, a company having over 75 products could avoid answering any interrogatories on the ground that just asking for a list of products exceeds 75.

Opposer also claims that Applicant did not make a good faith effort to resolve the issues

before filing the Motion to Compel. Opposer, however, misrepresents the facts, and has presented the Board with only part of the picture.

Upon receipt of Opposer's objection that the interrogatories exceeded the 75 limit, Applicant wrote Opposer asking for "the counting method showing that the interrogatories served exceeds 75." (Motion to Compel, Ex. 3, Dec. 3, 2012, email corresp.). Opposer responded on December 5, 2012, providing its method. (Motion to Compel, Ex. 3, Dec. 5, 2012, email corresp.). In reply to Opposer's counting method, Applicant, in a letter dated December 6, 2012, stated that it disagreed with the counting method, set forth the reasons why, and again requested Opposer to withdraw the objection. (Motion to Compel, Ex. 4). Opposer refused, and Applicant filed the motion to compel.

To the extent that Opposer claims that Applicant's efforts to resolve the dispute were superficial, Applicant did provide Opposer with the merits of its position. In fact, the motion to compel is based upon and expands on Applicant's position as set forth in its December 6, 2012, letter to opposing counsel. (Motion to Compel, Ex. 4). By conveniently omitting Applicant's December 6, 2012, letter from its response, Opposer was able to paint an incomplete and inaccurate picture that Applicant had failed to try to resolve the discovery dispute. The facts, however, demonstrate otherwise.

Opposer's efforts to attempt to object to the interrogatories on their merits should not be considered. The question before the Board is whether Applicant's interrogatories exceed the limit of 75, not the merits of the interrogatories. In any event, to the extent that Opposer has an objection to the interrogatories because they seek information on each product sold under the SYNTHES Mark, that information is relevant to the opposition proceeding. In the Notice of Opposition, Opposer has asserted that Applicant's goods are "related to and/or substantially

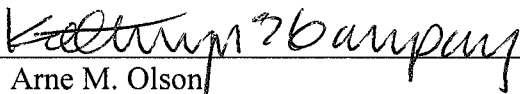
similar to those claimed in the SYNTHES® Registrations and *otherwise associated with the SYNTHES® mark.*" (Notice of Opposition, ¶13, emphasis added). In addition, information as to the date of first use of the SYNTHES mark on each product also is relevant to Applicant's case. Applicant is entitled to know when each of the goods were first sold under the SYNTHES mark, as the date may be after Applicant's first use. Because of when Applicant first used its mark, some of Opposer's goods appear to be after Applicant acquired its trademark rights. Opposer has chosen to rely on both goods covered by the registrations and those goods not covered by the registrations in claiming that the SYNTHESE mark is confusing similar to Opposer's mark. Opposer cannot now try to limit that discovery merely because it claims that it has sold hundreds of products.

For the foregoing reasons, Applicant, Ferring B.V., respectfully requests that the Trademark Trial and Appeal Board grant its motion to compel, determine that Applicant's First Set of Interrogatories does not exceed 75 interrogatories, and compel Opposer to fully answer Applicant's First Set of Interrogatories.

Respectfully submitted,

FERRING B.V.

Date: January 17, 2013

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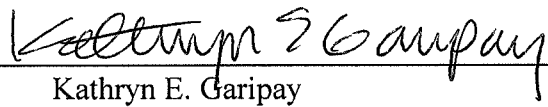
**CERTIFICATE OF SERVICE**

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

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on this 17<sup>th</sup> day of January, 2013.

  
Kathryn E. Garipay