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

Proceeding	91215142
Party	Defendant Palmaz Scientific, Inc.
Correspondence Address	J PETER PAREDES ROSENBAUM IP 1480 TECHNY RD NORTHBROOK, IL 60062-5447 UNITED STATES ldunham@rosenbaumip.com
Submission	Opposition/Response to Motion
Filer's Name	J. Peter Paredes
Filer's e-mail	trademarks@rosenbaumip.com
Signature	/J. Peter Paredes/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Serial No.: 85/954,196
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Boston Scientific Corporation and
Boston Scientific Scimed, Inc.
Opposers,

v.

Opposition No. 91215142

Palmaz Scientific, Inc.
Applicant

**APPLICANTS' RESPONSE IN OPPOSITION TO OPPOSERS'
MOTION TO COMPEL DISCOVERY**

STATEMENT OF FACT

On May 13, 2014 Applicant was served with Opposers' First Set of Interrogatories and First Set of Requests for Production of Documents (collectively the "Discovery Requests"). [Walz Decl. ¶¶ 3, 4.] On July 11, 2014, Applicant responded with its Responses and Objections to the Discovery Requests. [Walz Decl. ¶¶ 5, 6.] On July 25, 2014, Applicant received a meet and confer letter addressing alleged deficiencies in Applicants' Response to the Discovery Requests. [Walz Decl. ¶ 7.] On August 5, 2014, Applicant supplemented the Discovery Requests by providing its privilege log. [Walz Decl. ¶ 8.] On August 5, 2014 Opposers informed Applicants' counsel via e-mail that the privilege log was insufficient. [Walz Decl. ¶ 9.]

On August 15, 2014, Applicant responded to Opposers' meet and confer letter. [Walz Decl. ¶ 10.] Applicant responded by including its Supplemental Responses to the Discovery

Requests and a revised privilege log. [Walz Decl. ¶¶ 11, 12, 13.] On August 22, 2014, the parties held a telephone conference to discuss Applicants' discovery responses. [Walz Decl. ¶ 14.] Despite Applicants' timely responses to the Opposers' Discovery Requests and Applicants' production of a revised privilege log, Opposers maintain that there are deficiencies in the Applicants' discovery responses and have filed the Motion to Compel Discovery and Motion to Test the Sufficiency of Applicants Responses.

APPLICANTS' RESPONSE IN OPPOSITION TO OPPOSERS' MOTION TO COMPEL APPLICANTS TO PRODUCE DOCUMENTS

ARGUMENT

Applicant respectfully requests that the Trademark Trial and Appeal Board (the "Board") deny Boston Scientific Corporation and Boston Scientific Scimed, Inc. ("Opposers") Motion to Compel Applicants to produce documents responsive to Request No. 20.

Opposers' claim that "Applicant appears to be using the work-product doctrine and attorney-client privilege to evade having to produce responsive documents that are in its possession." The Applicant has timely responded with responses and objections and is not evading the Opposers' request. A document in the privilege log is protected by attorney-client privilege when the primary purpose of the document in the privilege log is to obtain or provide legal advice. *See SmithKline Beecham Corp. v. Apotex Corp.*, 403 F.3d 1331 (Fed. Cir. 2005). The document in the privilege log is "a request from Peter to Lori for a search; and an opinion on the search results." [Walz Decl. Ex.11.] The purpose of obtaining a search and providing an opinion of the search results is to provide legal advice. The Applicant has properly demonstrated that the document in the privilege log is protected by the attorney-client privilege.

Furthermore, Applicant is not evading the Opposers' request to produce documents because the Applicant has already produced "all documents, other than those documents created for purposes of this proceeding, that concern or include mention of Opposers' Mark." On August 15, 2014, Applicant responded to Opposers' meet and confer letter. Applicant responded by including its Supplemental Responses to the Discovery Requests and a revised privilege log in accordance with FRCP 26. [Walz Decl. ¶¶ 11, 12, 13.] Furthermore, Applicant complied with Opposers' request to provide a privilege log, which properly identifies the document withheld, including the date of creation, author, title or caption, addressee and recipient, and the general nature or purpose of creation. *Zander v. Craig Hosp.*, 743 F.Supp.2d 1225, 1231-32 (D Colo. 2010). Applicant has properly responded to all of the Opposers' requests in writing.

Applicant has no further documents within his possession and control responsive to defendants. *See Tobin v. WKRZ*, 12 F.R.D. 200, 201 (W.D.Pa.1952). (Purpose of federal rule for production of documents is not to discover what exists but to force production of items that do exist. FRCP 34, 28 U.S.C.A.) A motion to compel responses after complete responses have been provided is moot and must be denied. *Byer California v. Clothing for Modern Times Ltd.*, Opposition No. 91189238 (May 6, 2010) (*precedential*). Applicant has timely responded with responses and objections. Applicant has provided full and complete written responses along with responsive documents. Therefore, Applicant's response to Request No. 20 is sufficient and the Board should deny Opposers' motion.

CONCLUSION

Based on the foregoing, Applicant respectfully requests that the Board deny Opposers' Motion to Compel Applicants to produce documents responsive to Request No. 20.

**APPLICANTS' RESPONSE IN OPPOSITION TO OPPOSERS' MOTION TO COMPEL
RESPONSES TO OPPOSERS' FIRST SET OF INTERROGATORIES**

ARGUMENT

Applicant respectfully requests that the Trademark Trial and Appeal Board (the "Board") deny Boston Scientific Corporation and Boston Scientific Scimed, Inc. ("Opposers") Motion to Compel Responses to Interrogatory Nos. 4 and 5 of Opposers' First Set of Interrogatories.

A. Interrogatory No. 4

By way of example, Interrogatory No. 4 states: "Describe your process for selecting Applicants' Mark including, but not limited to, any alternative marks that were considered."

Applicant responded to Interrogatory No. 4 in a timely manner pursuant to its obligations under FRCP 33 and TBMP § 405 et seq. as follows: "Applicant objects to the form of the interrogatory on the grounds that it is impermissibly compound to the extent that it requests the process and alternative marks considered. Applicant further objects on the grounds that it requests attorney work product to the extent that the process for selecting any trademark in general is in anticipation of future litigation. Applicant further objects to this interrogatory on the grounds that it is irrelevant to the extent that the selection process or considered alternative marks are not relevant to any party's claims or defenses. Finally, Applicant objects to this interrogatory on the grounds that the request is not reasonably calculated to lead to the discovery of admissible evidence."

In Applicants' Supplemental Responses and Objections to Opposers' First Set of Interrogatories, Applicant maintained the prior objections to Interrogatory No. 4 on the same grounds and added the following with respect to the objection to the form "Applicant maintains the objection to the form pursuant to Federal Rule of Civil Procedure 33(a) which 'allows a party to submit interrogatories that contain "discrete subparts," but does not allow parties to combine

multiple interrogatories into one.’ *U.S ex rel. Pogue v. Diabetes Treatment Centers of Am. Inc.*, 235 F.R.D. 521, 526-527 (Dist. D.C. 2006). The interrogatory is ‘impermissibly compound because [it] requires separate responses to individual subparts that are not so related that they may be considered one interrogatory.’ *Id* at 527.”

Applicants’ objections are sufficient under FRCP 33(b)(4), which provides, in pertinent part: “The grounds for objecting to an interrogatory must be stated with specificity.” *See also Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984) (party must articulate objections to interrogatories with particularity. Additionally, no further information responsive to Opposers’ interrogatories is available. Applicant has timely responded with responses and objections and has provided full and complete written responses. Therefore, Applicants’ objection to Interrogatory 4 is sufficient and the Board should deny Opposers’ motion.

B. Interrogatory No. 5

By way of example, Interrogatory No. 5 states: “Describe your process for clearing Applicants’ Mark including, but not limited to, any alternative marks that were considered.”

Applicant responded to Interrogatory No. 5 in a timely manner pursuant to its obligations under FRCP 33 and TBMP § 405 et seq. as follows: “Applicant objects to this interrogatory on the grounds that it is irrelevant to the extent that the selection process is not relevant to any party’s claims or defenses. Applicant further objects on the grounds that it requests attorney work product to the extent that the process for clearing any trademark in general is in anticipation of future litigation. Notwithstanding the objection, Opposers’ Mark was not revealed during a search. Applicant reserves the right to supplement this response as discovery continues.”

In Applicants' Supplemental Responses and Objections to Opposers' First Set of Interrogatories, Applicant maintained the prior objections to Interrogatory No. 5 on the same grounds and added the following: "Notwithstanding the objection, Applicant refers to the document produced in response to Request for Production No. 1 which shows Opposers' Mark was not revealed during a search."

Applicants' objections are sufficient under FRCP 33(b)(4), which provides, in pertinent part: "The grounds for objecting to an interrogatory must be stated with specificity." *See also Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80, 83 (TTAB 1984) (party must articulate objections to interrogatories with particularity. Additionally, no further information responsive to Opposers' interrogatories is available. Applicant has timely responded with responses and objections and has provided full and complete written responses. Therefore, Applicants' objection to Interrogatory 5 is sufficient and the Board should deny Opposers' motion.

CONCLUSION

Based on the foregoing, Applicant respectfully requests that the Board deny Opposers' Motion to Compel Responses to Interrogatory Nos. 4 and 5 of Opposers' First Set of Interrogatories.

APPLICANTS' RESPONSE IN OPPOSITION TO OPPOSERS' MOTION TO TEST THE SUFFICIENCY OF APPLICANTS' RESPONSES TO OPPOSERS' FIRST SET OF REQUESTS FOR ADMISSION

ARGUMENT

Applicant respectfully requests that the Board deny Opposers' Motion to Test the Sufficiency of Applicants' Responses to Opposers' First Set of Requests for Admission numbered 2, 3, and 6.

By way of example, Request No. 2 states: “Admit that the identification of goods description in Applicants’ Application, namely ‘Medical devices, namely, stents’ does not identify a specific channel of trade.” By way of example, Request No. 3 states: “Admit that the identification of goods description in Registration No. 2,732,940; namely, ‘Medical guide catheters’ does not identify a specific channel of trade.” By way of example, Request No. 6 states: “Admit that attached as Exhibit C is a copy of a Web page from Medtronic’s website located at www.medtronic.com stating that, with respect to Aortic Stent Grafts, ‘[t]he stent graft is put in the body via a catheter....’”

In response to Request No. 2 and 3, Applicant responded as follows pursuant to its obligations under FRCP 36 and TBMP §407 *et seq.*: “Applicant lacks knowledge and information regarding whether the identification of goods does not identify a specific channel of trade.” In Applicants’ Second Supplement to Opposers’ Requests for Admissions, Applicant added the following in response to Request No. 2 and 3: “Applicant objects to the request on the grounds that it is vague and ambiguous to the extent that the application does not identify specific limitations regarding trade and methods of distribution. Applicant further objects that ‘channel of trade’ has not given any specific definition.”

In response to Request No. 6, Applicant responded as follows pursuant to its obligations under FRCP 36 and TBMP §407 *et seq.*: “Applicant objects to this request on the grounds that it is irrelevant to the extent that the subject matter of the request is ‘stent grafts’ which is distinct and separate from the trademark identified goods described as stents.” In Applicants’ Second Supplement to Opposers’ Requests for Admissions, Applicant maintained the prior objection to Request No. 6 on the same grounds and added the following: “Applicant further provides true and accurate copies of the Physician’s Desk Reference Medical Dictionary defining the stent as a

device providing structural support, and defining a stent graft as the ‘inlay skin’ or the covering material supported by the stent.”

Applicants’ responses are sufficient under FRCP 36(a)(4), which provides, in pertinent part: “The answering party may assert lack of knowledge or information as a reason for failing to admit or deny only if the party states that it has made reasonable inquiry and that the information it knows or can readily obtain is insufficient to enable it to admit or deny.” Further, Applicants’ responses are sufficient under FRCP 36(a)(5), which provides, in pertinent part: “The grounds for objecting to a request must be stated.” Moreover, federal courts have held that the reasonable inquiry requirement is limited to “information that is reasonably available to the answering party.” See *Heartland Surgical Specialty Hospital, LLC v. Midwest Division, Inc*, 2007 WL 3171768 (D. Kan. 2007) (quoting *U.S. ex. Rel. England v. Los Angeles County*, 235 F.R.D. 675, 685 (E.D. Cal. 2006). Therefore, Applicants’ responses to Requests 2, 3, and 6 are sufficient and the Board should deny Opposers’ motion.

CONCLUSION

Based on the foregoing, Applicant respectfully requests that the Board deny Opposers’ Motion to Test the Sufficiency of Applicants’ Responses to Opposers’ First Set of Requests for Admission numbered 2, 3, and 6.

WRITTEN STATEMENT OF GOOD FAITH EFFORT

Counsel for Applicant confirms that it has made a good faith effort to resolve the discovery issues identified above with Opposers by properly responding to all of Opposers' Discovery Requests.

Respectfully Submitted,

PALMAZ SCIENTIFIC, INC.

By: Their Attorneys



J. Peter Paredes

Rosenbaum IP, P.C.
1480 Techny Rd.
Northbrook, IL 60062
Phone: (847) 770-6000
Fax: (847) 770-6006