

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

STAMPS.COM INC.,

Opposer,

v.

PSI SYSTEMS, INC.,

Applicant.

Opposition No. 91177737

Serial No. 78/591,795

Mark: ISTAMPS



07-21-2008

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**PSI SYSTEMS' OPPOSITION TO STAMPS.COM'S MOTION TO
COMPEL RESPONSES TO DOCUMENT REQUESTS AND
INTERROGATORIES AND MOTION FOR PROTECTIVE ORDER**

I.

INTRODUCTION

Opposer Stamps.com Inc. ("Stamps.com") has moved to compel Applicant PSI Systems, Inc. ("PSI") to produce documents in response to Stamps.com's First Set of Requests for Production of Documents and Things and to provide further amended and supplemental responses to Stamps.com's First Set of Interrogatories.

Pursuant to 37 C.F.R. § 2.120(f), PSI opposes and responds by moving the Trademark Trial and Appeal Board for a protective order directing Stamps.com to amend its First Set of Requests for Production of Documents and Things to withdraw requests that are duplicative, irrelevant, overly broad, unduly burdensome or improperly request confidential and trade secret information. The relief sought by Opposer—including production of a massive quantity of documents in electronic form—is unreasonable and unwarranted and does not outweigh the burden and expense to PSI in this opposition proceeding over an intent-to-use

trademark. Also, PSI has already served further amended and supplemental responses to Stamps.com's interrogatories, so that relief sought by Opposer is moot.

Filed herewith in support of this opposition is the Declaration of Susan Hwang ("Hwang Decl."), with accompanying exhibits.

II.

FACTUAL BACKGROUND

Applicant PSI is a provider of goods and services in the Internet postage industry, based in Palo Alto, California. Among other things, PSI's product lines include labels, sheets of labels, label printers, postage scales and bundled software to allow consumers to buy and print postage online. On March 21, 2005, PSI filed its intent-to-use trademark application, U.S. Application Serial No. 78/591,795, for the mark ISTAMPS in connection with "specialized labels or sheets of labels upon which postage can be printed," in International Class 16. The application was published for opposition on April 10, 2007. Stamps.com filed a Notice of Opposition on June 8, 2007, asserting that PSI's mark ISTAMPS was likely to be confused with Stamps.com's registrations for STAMPS.COM, NETSTAMPS, E-STAMP and I-MAIL.

PSI and Stamps.com are not unfamiliar parties to each other. Stamps.com has previously filed a patent infringement action against PSI in United States District Court for the Central District of California, Case No. CV 06-7499 ODW (CTx). That case is currently ongoing. *See* Hwang Decl. ¶ 1.

In this proceeding, on July 6, 2007, PSI served a First Set of Interrogatories and First Set of Requests for the Production of Documents and Things on Stamps.com. *See* Hwang Decl. ¶ 2.

On July 30, 2007, Stamps.com served a First Set of Interrogatories and First Set

of Requests for the Production of Documents and Things on PSI. *See* Hwang Decl. ¶ 3 & Exhibit A.

On August 10, 2007, Stamps.com served responses to PSI's First Set of Interrogatories and First Set of Requests for the Production of Documents and Things, but did not produce any documents. *See* Hwang Decl. ¶ 4.

On September 7, 2007, PSI timely served written objections and responses to Stamps.com's First Set of Interrogatories and First Set of Requests for the Production of Documents and Things. *See* Hwang Decl. ¶ 5 & Exhibit B. PSI's timely objections included objections on the ground that the document requests were irrelevant, overly broad and unduly burdensome. *Id.* PSI also served a set of documents Bates labeled PSI T 000001-000074. *Id.*

On November 5, 2007, the undersigned counsel from the law firm of Sheppard, Mullin, Richter & Hampton LLP substituted in as new counsel for PSI. *See* Hwang Decl. ¶ 6.

Because new counsel for PSI required additional time to get familiar with the proceeding and because the parties required time to negotiate and stipulate to a protective order, the parties filed a stipulation to extend the discovery period from December 25, 2007 to February 25, 2008, which was granted by the Board on December 6, 2007. *See* Hwang Decl. ¶ 7.

The parties continued in January 2008 to discuss a joint stipulated protective order. *See* Hwang Decl. ¶ 8. In order to provide the parties additional time to stipulate to a protective order and to conduct discovery, the parties again filed a stipulation on February 20, 2008 to extend the discovery period from February 25, 2008 to April 25, 2008, which was granted by the Board on March 21, 2008. *Id.*

On March 18, 2008, the parties held a telephone conference to discuss document production. PSI stated to Stamps.com that it was difficult to ascertain the amount and nature of

PSI's responsive documents, based on the broad nature of Stamps.com's document requests. *See* Hwang Decl. ¶ 9. PSI reminded Stamps.com that the amount of document production in the unrelated patent case between the parties was considerable and suspected that a large number of documents might have to be sifted through in the present proceeding because of Stamps.com's broad document requests. *Id.* PSI stated that it would most likely have to produce any responsive documents on a "rolling basis." *Id.*

On March 27, 2008, the parties stipulated to a protective order, which was approved by the Board on April 29, 2008. *See* Hwang Decl. ¶ 10.

On April 10, 2008, Stamps.com requested PSI to agree to a further extension of the discovery period, and PSI did so. *See* Hwang Decl. ¶ 11.

PSI produced documents Bates labeled PSI T 000075-001346 on April 15, 2008 and then served supplemental and amended responses to Stamps.com's First Set of Interrogatories on May 7, 2008. *See* Hwang Decl. ¶ 12. Those documents included printouts of the respective parties' websites (where both parties advertise and offer their respective products and services) and prosecution file histories of the respective parties' trademark applications in the U.S. Patent and Trademark Office. *Id.*

On May 15, 2008, the parties filed a stipulation to extend the discovery period from April 25, 2008 to August 25, 2008, which was granted by the Board on June 3, 2008. *See* Hwang Decl. ¶ 13.

On May 16, 2008, Stamps.com produced a hard drive containing almost a million documents (Bates labeled STAMPS TM 00000001 – 00957768) in response to PSI's First Set of Requests for Production of Documents and Things. *See* Hwang Decl. ¶ 14. A brief spot review of the documents identified documents that are not relevant to any of PSI's documents requests,

as well as publicly available documents (e.g., U.S. patents and prosecution file histories) that are nevertheless designated "Highly Confidential" under the joint stipulated protective order. *Id.*

On June 2, 2008, the parties held another telephone conference to discuss discovery. PSI repeated to Stamps.com that it was still working on production of additional responsive documents. *See* Hwang Decl. ¶ 15. PSI did not make any representations as to whether PSI's document production was complete. *Id.*

On July 3, 2008, Stamps.com filed a motion to compel documents in response to Stamps.com's First Set of Requests for Production of Documents and Things and to provide further amended and supplemental responses to Stamps.com's First Set of Interrogatories. *See* Hwang Decl. ¶ 16.

On July 14, 2008, PSI sent a letter to Stamps.com requesting a meet and confer to withdraw requests that are unreasonably and overly broad, burdensome, cumulative or duplicative and to more properly narrow the scope of documents requested by Stamps.com. Hwang Decl. ¶ 17 and Exhibit C. PSI pointed out that it had identified at least 24 GB of data that might be potentially responsive to Stamps.com's First Set of Requests for Production of Documents, which translated to over 385,000 documents, and at least a million pages of documents. *Id.* Because of the extensive amount of "raw" data involved, the potentially responsive data was identified using automated searches of keywords that were selected from Stamps.com's First Set of Requests for Production of Documents. *Id.* PSI used broad keywords because Stamps.com's document requests contained very broad requests. *Id.* PSI pointed out Stamps.com's Request Nos. 23 and 57 as examples of overly broad requests. PSI also noted that the large volume of documents ultimately might not, however, be responsive to the information that Stamps.com is necessarily seeking through its document requests, because of the possibility

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