This decision is a precedent of the Trademark Trial and Appeal Board.

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Baxley

Mailed: February 15, 2007

Opposition No. **91125329**

Terry P. Gaudreau, Ronald Knutson, TNT Fireworks, Inc. (Montana corporation), and TNT Fireworks, Inc. (North Dakota corporation)

v.

American Promotional Events, Inc.

Before Quinn, Grendel and Drost, Administrative Trademark Judges

By the Board:

American Promotional Events, Inc. ("applicant") seeks to register the word mark TNT FIREWORKS, INC. for "distributorship services for fireworks" in International Class 35.[1]

Terry P. Gaudreau ("Mr. Gaudreau"), Ronald Knutson, TNT Fireworks, Inc. (Montana corporation), and TNT Fireworks (North Dakota corporation) opposed registration of applicant's mark on the ground of likelihood of confusion with their previously used mark TNT FIREWORKS, INC. for

[1] Application Serial No. 76090310, filed July 17, 2000, based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. Section 1051(b).

"fireworks." Applicant denied the salient allegations of the notice of opposition in its answer.

On January 20, 2004, Ronald Knutson and TNT Fireworks, Inc. (North Dakota corporation) filed a withdrawal of their opposition with prejudice. Accordingly, the Board, in a March 23, 2004 order, dismissed the opposition with prejudice as to Ronald Knutson and TNT Fireworks, Inc. (North Dakota corporation) only and indicated that the proceeding would go forward with Mr. Gaudreau and TNT Fireworks, Inc. (Montana corporation) (collectively "opposers") as the remaining plaintiffs herein. Opposers appeared *pro se* herein following the withdrawal of their attorney on August 5, 2004.

Pursuant to the Board's June 20, 2006 order, the most recent scheduling order in this proceeding, opposers' testimony period was last reset to close on November 16, 2006. Opposers took a testimony deposition of Mr. Gaudreau on November 16, 2006, though applicant's attorney appeared under protest and conducted minimal cross-examination. Opposers filed a transcript of that deposition on December 13, 2006 and submitted no other testimony or evidence in support of their opposition.

This case now comes up for consideration of applicant's motion (filed November 20, 2006) to strike the entire testimony deposition of Mr. Gaudreau, pursuant to Trademark Rule 2.123(e)(3), on the ground that opposers' notice of

that deposition was neither adequate nor reasonable.[2] The motion has been fully briefed.

As an initial matter, we note that, on November 16, 2006, opposers' attorneys filed an entry of appearance for the limited purpose of taking Mr. Gaudreau's testimony. In the entry of appearance, opposers' attorneys asked that the Board continue to send correspondence in this proceeding to Mr. Gaudreau and stated as follows:

> We will not appear before the Trademark Trial and Appeal Board in this matter for any other purpose. We will not serve as counsel in any other aspect of this opposition. In other words, we will not participate in cross-examining the applicant during its testimony, we will not conduct rebuttal testimony, and we will not prepare any brief or other document in this matter.

Notwithstanding the limited nature of their appearance herein, opposers' attorneys, on November 28, 2006, filed a withdrawal from this proceeding. In this withdrawal opposer's attorneys presented arguments, in apparent response to applicant's motion to strike, concerning the conduct of applicant's attorney during Mr. Gaudreau's testimony deposition. However, those arguments exceed the scope of opposers' attorneys' stated appearance on opposers' behalf herein. Moreover, opposers, appearing *pro se*, timely filed their own brief in response to the motion to strike on

[2] Under the circumstances, the better practice would have been for applicant to file a motion to quash the notice of deposition prior to the commencement of Mr. Gaudreau's testimony deposition. See TBMP Section 521 (2d ed. rev. 2004). Given the time-sensitive nature of the motion to quash, the Board could have resolved a motion to quash by telephone conference prior to the commencement of Mr. Gaudreau's testimony deposition. See TBMP Section 502.06 (2d ed. rev. 2004).

December 5, 2006. Because opposers are allowed only one brief in response to the motion to strike, we have not considered the arguments of opposers' former attorneys in deciding that motion and have considered only opposers' brief in response to the motion to strike.[3] See Trademark Rule 2.127(a).

In support of its motion to strike, applicant contends that, between May 22, 2006 and November 15, 2006, it did not receive any communications from opposers with regard to this proceeding;[4] and that, during opposers' testimony period that closed on November 16, 2006, opposers did not file any notices of reliance. Applicant further contends that, at 6:58 p.m. EST on Tuesday, November 14, 2006,[5] opposers' new

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[3] We hasten to add, however, that consideration of those arguments would not have changed this decision.

[4] Applicant admits, however, that its attorney had limited communications with attorneys who are representing opposers in a civil action styled *American Promotional Events, Inc. v. Terry P. Gaudreau and TNT Fireworks, Inc.*, Case No. 4:06-CV-014, filed in the United States District Court for the District of North Dakota, with regard to negotiating a scheduling order and the parties' initial disclosures in that case.

The parties did not previously notify the Board of this pending civil action. Had they so notified the Board, this proceeding may have been suspended pending disposition of the civil action, provided that the civil action has a bearing upon this case. See Trademark Rule 2.117(a); TBMP Section 510.02(a) (2d ed. rev. 2004).

[5] Opposers' attorneys are based in Washington, D.C., and applicant's are based in St. Louis, Missouri. For purposes of this decision, all times listed are Eastern Standard Time.

Applicant states throughout its brief and reply brief in support of its motion to strike that opposers' attorney sent the November 14, 2006 letter by facsimile at 5:58 p.m. EST. However, a review of the copy of that letter that applicant submitted as an exhibit to its motion to strike indicates that such letter was

attorney sent by facsimile a letter to applicant's attorney indicating that opposers wanted to take Mr. Gaudreau's testimony deposition upon oral examination on Thursday, November 16, 2006; that such letter did not include a time or place for the deposition and therefore did not constitute adequate notice under Fed. R. Civ. P. 30(b)(1); that, due to travel and a court appearance in another case, none of applicant's attorneys was made aware of such letter until after 11 a.m. on November 15, 2006 and that applicant's lead attorney did not see such letter until mid-afternoon on that day; that, at 4:02 p.m. EST, applicant's lead attorney sent via facsimile a letter to opposers' attorney advising him of errors and irregularities in opposers' notice of deposition; that opposers' attorneys did not send applicant a more detailed notice of the deposition, which was scheduled to commence at 2 p.m. EST on November 16, 2006 in Williston, North Dakota, until 4:06 p.m. EST on November 15, 2006, i.e., less than twenty-four hours before the deposition was to take place; and that attending such deposition in person would have required applicant's attorney to travel from St. Louis, Missouri to Williston, North Dakota, "which has only two flights per day, on less than one day's notice." Applicant contends in addition that, less than two hours prior to the commencement of Mr. Gaudreau's deposition on November 16, 2006, applicant's attorney received from

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sent from the offices of opposers' attorney in Washington, D.C. at "18:58," i.e., 6:58 p.m. EST.

opposers eighteen undated photographs and forty-one pages of documents that had been sought in discovery and were previously unproduced; that, at 11:55 a.m. EST on November 16, 2006, applicant's attorney sent via facsimile to opposers' attorney written notice of its objection to opposers' notice of Mr. Gaudreau's testimony deposition; that applicant's attorney attended the deposition by telephone and under protest; and that, while applicant's attorney appeared for Mr. Gaudreau's testimony deposition, he was unable to conduct substantive cross-examination of Mr. Gaudreau due to the short notice. Based on the foregoing, applicant asks that the Board strike Mr. Gaudreau's testimony deposition from the record and grant such other relief as is appropriate.

Applicant's exhibits in support of its motion to strike include the following: 1) a copy of the November 14, 2006 letter from opposers' attorney to applicant's attorney, wherein opposers' attorney proposes to take Mr. Gaudreau's testimony deposition by oral examination on the afternoon of November 16, 2006, but provides neither a specific time nor a place for such deposition; 2) declarations of applicant's attorneys R. Prescott Sifton and Ralph W. Kalish Jr., recounting the events set forth in applicant's motion to strike; and 3) copies of applicant's first sets of interrogatories, document requests and requests for admission that were served upon opposers on July 3, 2002. The Sifton and Kalish declarations introduce the following

exhibits: a) applicant's attorney's November 16, 2006 letter to opposers' attorney objecting to opposers' notice of Mr. Gaudreau's testimony deposition; b) a copy of the notice of Mr. Gaudreau's testimony deposition that opposers' attorneys sent on November 15, 2006; c) copies of electronic mail and facsimile cover sheets regarding photographs and documents sent to applicant's attorneys on the morning of November 16, 2006; and d) a copy of a November 15, 2006 letter from applicant's attorney in response to opposers' letter of November 14, 2006.

In response, opposers, appearing *pro se*, contend that they received only the first page of the Board's June 20, 2006 order and did not receive a complete copy of that order until October 17, 2006, when a Board employee instructed Mr. Gaudreau on how to obtain a copy of that order online.[6] Opposers further contend that their attorney sent applicant's attorney the November 14, 2006 letter regarding Mr. Gaudreau's testimony deposition "only after fruitless efforts by phone were made" by opposers' attorneys; that opposers' attorney told applicant's attorney that the deposition was noticed for November 16, 2006 to avoid a technical default; that opposers' attorney was authorized to stipulate to a postponement of Mr. Gaudreau's deposition, if applicant's attorneys needed more time to prepare for that deposition; that, inasmuch as applicant took a discovery

[6] The record does not indicate that opposers attempted to obtain a complete copy of the June 20, 2006 order between the issuance of that order and October 17, 2006.

deposition of Mr. Gaudreau, little, if any, preparation was necessary for his testimony deposition; that applicant had ample opportunity to prepare for cross-examination because nearly all of the documents that Mr. Gaudreau relied upon in his testimony deposition were produced nearly six months prior to that deposition; that any newly produced evidence was discussed during Mr. Gaudreau's discovery deposition; and that opposers' former attorney suggested that applicant could cross-examine Mr. Gaudreau during opposers' rebuttal testimony period. Accordingly, opposers ask that the Board deny applicant's motion to strike.

Opposers' exhibits in support of their brief in response to the motion to strike include: 1) a copy of the first page of the Board's June 20, 2006 order; 2) a copy of an Express Mail receipt which indicates that applicant's attorney received correspondence from Mr. Gaudreau on May 22, 2006; 3) excerpts from Mr. Gaudreau's discovery deposition, which indicate that such deposition took place on April 27, 2006; 4) a copy of the State of Montana Certificate of Registration of the pleaded TNT FIREWORKS and design mark; and 5) a copy of a November 15, 2006 letter from opposers' attorney to applicant's attorney.

In reply, applicant contends that opposers are essentially arguing that applicant neither needs nor deserves notice that trial testimony will be taken; that neither opposers nor their attorneys expressed any

willingness to postpone Mr. Gaudreau's testimony deposition; and that opposers' attorney's suggestion that Mr. Gaudreau would not object to reasonable cross-examination during opposers' rebuttal testimony period is insufficient because such cross-examination would not take place during opposers' case-in-chief, and because there is no guarantee that Mr. Gaudreau would appear for rebuttal testimony.

Applicant's motion to strike is made pursuant to Trademark Rule 2.123(e)(3), which states as follows:

> Every adverse party shall have full opportunity to cross-examine each witness. If the notice of examination of witnesses which is served pursuant to paragraph (c) of this section is improper or inadequate with respect to any witness, an adverse party may cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, if he wishes to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances. A motion to strike the testimony of a witness for lack of proper or adequate notice of examination must request the exclusion of the entire testimony of that witness and not only a part of that testimony.

Fed. R. Civ. P. 30(b)(1) states in relevant part as follows: "A party desiring to take the deposition of any person upon oral examination shall give reasonable notice in writing to every other party in the action. The notice shall state the time and place for taking the deposition...." See also Trademark Rule 2.123(c); and TBMP Section 703.01(d) and (e) (2d ed. rev. 2004). The Board's standard practice is to apply Rule 30(b)(1) together with

Trademark Rule 2.123(c) in determining the reasonableness of notice in the case of testimony depositions as well as for discovery depositions. Whether notice is reasonable depends upon the individual circumstances of each case. See *Duke University v. Haggar Clothing Co.*, 54 USPQ2d 1443 (TTAB 2000) (two days notice unreasonable); *Electronic Industries Association v. Patrick H. Potega DBA Lifestyle Technologies*, 50 USPQ2d 1775 (TTAB 1999) (two days notice unreasonable); and *Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072 (TTAB 1990) (twenty-four hours notice insufficient).

The record herein indicates that opposers did not attempt to notify applicant that they wished to take Mr. Gaudreau's testimony deposition until two days prior to the close of opposers' testimony period.[7] We find that such notice was unreasonable. Given the more than adequate thirty-day period allowed for trial for each party in *inter partes* proceedings before the Board, there must be a compelling need to take testimony depositions on such short

[7] We note that applicant's attorney did not respond to the proposal to take Mr. Gaudreau's testimony deposition until mid-afternoon of November 15, 2006, when the facsimile transmission was sent to opposers' attorney at 4:02 p.m. EST, and that opposers provided the place and exact time of the deposition shortly thereafter. However, we do not consider applicant's attorney to have contributed in any way to the inadequate notice. Opposers waited until after the close of business on November 14, 2006 to send any written indication of an intent to take Mr. Gaudreau's testimony deposition, and we do not consider applicant to have acted unreasonably, in the particular circumstances, in not responding to opposers until mid-afternoon of the following day.

notice. See *Jean Patou Inc. v. Theon, Inc., supra*. The mere fact that opposers' testimony period was about to close does not constitute such a compelling need. See *Duke University v. Haggar Clothing Co., supra.*

While opposers contend that their attorney sent the November 14, 2006 letter to applicant's attorneys only after opposers' newly hired attorneys failed to reach applicant's attorneys by telephone, opposers' attorney states in that letter that the attorneys "were asked today to assist" in taking Mr. Gaudreau's testimony deposition. Therefore, opposers' attorneys could not have attempted to contact applicant's attorney by telephone until the morning of November 14, 2006 at the earliest. Even if opposers had served an adequate notice of deposition on that morning, opposers would have provided only two days notice, which was unreasonable.

Opposers' contention that their attorneys were authorized to stipulate to the postponement of Mr. Gaudreau's testimony deposition to allow applicant's attorney time to prepare for cross-examination is not credible. A review of Mr. Gaudreau's testimony deposition transcript and a November 15, 2006 letter from opposers' attorney to applicant's attorney indicates that postponing such deposition was not discussed and that opposers fully

intended to proceed with the deposition, notwithstanding applicant's protests.

This case is distinguished from those cases in which the Board has considered at final hearing transcripts of testimony depositions that were taken on unreasonable notice where the deposing party has offered to accommodate its adversary by making the witness available for further questioning at a later date or has agreed to extend its testimony period to allow for further questioning of the witness. See, e.g., *Penguin Books Ltd. v. Eberhard,* 48 USPQ2d 1280, 1284 (TTAB 1998); and *Jean Patou Inc. v. Theon, Inc., supra*. In particular, Mr. Gaudreau stated during his testimony deposition that he did not want to seek to extend opposers' testimony period. See Gaudreau testimony deposition transcript at 143. Further, in a November 15, 2006 letter from opposers' attorney to applicant's attorney, opposers' attorney suggests that "any cross-examination you deem necessary [can] be conducted during the rebuttal testimony of Mr. Gaudreau. We will suggest that he not object to any reasonable cross-examination occurring during the rebuttal testimony." However, this statement falls short of providing applicant with a full opportunity to cross-examine Mr. Gaudreau, as contemplated by Trademark

Rule 2.123(e)(3), because it does not allow for such cross-examination during opposers' main testimony period.[8]

In view of the unreasonable notice of Mr. Gaudreau's testimony deposition and opposers' efforts to deny applicant a full opportunity to cross-examine Mr. Gaudreau during opposers' testimony period-in-chief, we find that the appropriate remedy, under the circumstances herein, is to strike the transcript of Mr. Gaudreau's testimony deposition and all exhibits thereto.

Accordingly, applicant's motion to strike the transcript and exhibits of Mr. Gaudreau's testimony deposition is granted. The transcript of Mr. Gaudreau's testimony deposition and all exhibits thereto are hereby stricken.

Inasmuch as opposers' testimony period has closed and opposers have not taken any other testimony or offered any other evidence, dismissal of this proceeding is appropriate under Trademark Rule 2.132 because opposers' lack of evidence means that they cannot meet their burden of proof as plaintiff in this case. See TBMP Section 534 (2d ed.

[8] Moreover, Mr. Gaudreau is under no obligation to appear for further testimony during opposers' rebuttal testimony period. Although applicant could conceivably call Mr. Gaudreau as an adverse witness and, in effect, cross-examine him during its testimony period while taking his direct testimony, applicant should not need to resort to such a measure to secure the full opportunity to cross-examine him that Trademark Rule 2.123(e)(3) requires.

rev. 2004). Accordingly, judgment is hereby entered against opposers, and the opposition is dismissed with prejudice.

Applicant's involved application will be forwarded for issuance of a notice of allowance.