

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

PIONEER KABUSHIKI KAISHA d/b/a)
PIONEER CORPORATION,)
)
Opposer,)
)
v.)
NISSEI SANGYO AMERICA, LTD. n/k/a)
HITACHI HIGH TECHNOLOGIES AMERICA,)
INC.,)
)
Applicant.)

Opposition No. 125,458

Mark: SUPERSCAN ELITE

Serial No.: 76/208,230

Published: March 19, 2002

12-20-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #30

APPLICANT'S MOTION FOR PROTECTIVE ORDER

Applicant, Nissei Sangyo America, Ltd., now known as Hitachi High Technologies America, Inc., moves for a protective order pursuant to Rule 26(c) of the Federal Rules of Civil Procedure to prevent Opposer from engaging in a vexatious and harassing course of discovery. In support of this motion, Applicant states as follows:

1. On February 9, 2001, Applicant filed an Intent to Use application to register the mark SUPERSCAN ELITE for "video and audio products and systems, including televisions, video cassette recorders, digital versatile disc players, digital video disc players and combination units." A Notice of Publication was issued on February 27, 2002, and Opposer filed this opposition proceeding on April 16, 2002. Opposer owns Registration No. 1,591,868 for the mark ELITE for "audio and video products, namely amplifiers, video disc players, compact disc players, combination video disc and compact disc players, monitor televisions, loud speakers, tuners, and stereo radio/audio cassette players."

2. On November 14, 2002, Applicant's counsel spoke by telephone with Opposer's counsel concerning pending discovery requests and concerning the possibility of an amicable

resolution of the case. Both counsel agreed that it would be worthwhile to explore the possibility of settlement and to inquire whether each party would agree to a meeting between appropriate officers of the respective companies to discuss possible resolutions. A few days later, both parties agreed that such a meeting was desirable and began efforts to arrange a mutually agreeable time for a videoconference.

3. In the November 14th telephone conference between counsel, Applicant's counsel proposed that further discovery be held in abeyance until the parties met and had an opportunity to fully explore settlement possibilities. In response to Opposer's concern that discovery cutoff dates were impending, Applicant's counsel assured that Applicant would not object to Opposer taking depositions after the cut-off date if an extension could not be obtained. This would allow the parties to explore settlement without the expense and time pressure of further discovery.

4. The parties exchanged letters and phone calls seeking to find a mutually agreeable date for the videoconference in mid-December. In the meantime, on December 6, 2002, Opposer issued deposition subpoenas to a third-party Hitachi America, Ltd. for December 20, 2002.

5. On December 12, 2002, telephone conferences between counsel indicated that the earliest date the videoconference could occur would be January 14, 2003.

6. On December 12, 2002, when it became clear that the videoconference would not proceed until January 14, Applicant's counsel stated in a telephone conference with Opposer's counsel that any deposition of Hitachi America, Ltd. should be put off until after the January 14th videoconference. Applicant's counsel also suggested the parties file a stipulated motion for an extension of time to conduct discovery, and Opposer's counsel agreed. This would allow the parties to engage in settlement efforts in January without the pressure of an impending discovery cut-off date. Opposer's counsel indicated that he had been in contact with an attorney from Hitachi America,

Ltd. and that it was not clear whether the deposition would occur on the scheduled date of December 20, 2002. Opposer and Hitachi America, Ltd. were attempting to negotiate a declaration in lieu of a deposition. Applicant's counsel indicated his view that the Applicant and Opposer had agreed that no deposition would take place until after the videoconference.

7. On December 16, 2002, Applicant's counsel submitted to the TTAB a stipulated motion for extension of time, proposing a discovery close date of March 17, 2003.

8. After the close of business on December 18, 2002, Opposer's counsel sent a fax letter to Applicant's counsel stating that the deposition would go forward in San Francisco on December 20, 2002. (Copy attached). Applicant's counsel did not receive this fax letter until the morning of December 19, 2002.

9. At approximately 9:00 a.m. (P.S.T.), after reviewing the fax letter, Applicant's counsel called Opposer's counsel's cell phone, and left a message that the deposition would not proceed. Thereafter, at approximately 10:30 a.m. (P.S.T.), Applicant's counsel sent a letter indicating that the deposition would not proceed, and that if Opposer's counsel insisted on travelling to San Francisco he did so at his own risk and expense. (Copy attached).

10. The latest communication received from Opposer's counsel late in the day on December 19th indicated that Opposer disagreed with Applicant's position and that he was proceeding to San Francisco. Opposer's view is that any agreement to defer depositions related only to depositions between the *parties* only, not to depositions of third-parties. Such a view makes little sense, however, since it would not accomplish the very purpose of an agreement to defer depositions until after settlement efforts had been fully explored. It would not spare the parties the time, expense, travel and effort incurred in preparing for and conducting such third-party deposition. While Opposer's letter of November 15, 2002 (copy attached) confirming the deferral of depositions

refers only to "these depositions" (i.e., the depositions of Applicant), those were the only depositions that had been noticed in this matter at that point in time.

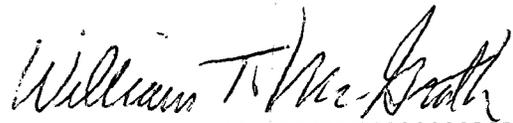
11. There is no urgency to conducting this third-party deposition, and there was no reason it had to proceed on December 20, 2002. Even if the parties had not agreed to defer depositions until after the videoconference, this deposition could have been re-scheduled for the last week of December or early January once it became clear that a declaration from Hitachi America, Ltd. in lieu of a deposition was not achieved.

12. It is unreasonable for Opposer's counsel, under these circumstances, to notify Applicant's counsel (in Chicago) on December 19th that Opposer insisted on proceeding in San Francisco on December 20th.

WHEREFORE, Applicant respectfully requests that the Board enter a protective order deferring any depositions of parties or third-parties until after the parties conduct the agreed upon videoconference.

Respectfully submitted,

By:



Attorney for Applicant

William T. McGrath
DAVIS, MANNIX & McGRATH
125 S. Wacker Dr., Suite 1700
Chicago, Illinois 60606
(312) 332-3033

CERTIFICATE OF EXPRESS MAILING

"Express Mail" mailing label number: EV116572349US

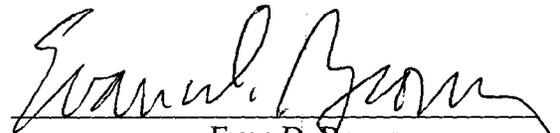
Date of Deposit: December 20, 2002

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee", postage prepaid, in an envelope addressed to Box TTAB, NO FEE, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513 on the date indicated above.


Evan D. Brown

CERTIFICATE OF SERVICE

A copy of the foregoing is also being sent on the date indicated above by the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to Robert James Skousen, Skousen & Skousen, 12400 Wilshire Blvd., Suite 900, Los Angeles, CA 90025-1060


Evan D. Brown

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FACSIMILE TRANSMITTAL

12-20-2002

U.S. Patent & TMO/IM Mail Rcpt Dt. #33

DATE: December 18, 2002

TO: William T. McGrath, Esq.
Davis, Mannix, & McGrath

FAX NO: (312) 332-6376

FROM: Skousen & Skousen

RE: Pioneer Corp. v. Nissei Sangyo America, Ltd.

- | | |
|---|---|
| <input checked="" type="checkbox"/> Original by U.S. Mail | <input type="checkbox"/> Please Contact me |
| <input type="checkbox"/> In accordance with your request | <input type="checkbox"/> Please read and advise me how to reply |
| <input type="checkbox"/> Copy Via Electronic Mail | <input type="checkbox"/> For your review and comments |

THE INFORMATION CONTAINED IN THIS FACSIMILE MESSAGE IS PRIVILEGED AND CONFIDENTIAL INFORMATION ONLY FOR THE USE OF THE INTENDED RECIPIENT NAMED ABOVE. IF YOU ARE NOT THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY COPYING OF THIS COMMUNICATION OR DISSEMINATION OR DISTRIBUTION OF IT TO ANYONE OTHER THAN THE INTENDED RECIPIENT IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS COMMUNICATION IN ERROR, PLEASE IMMEDIATELY NOTIFY US BY TELEPHONE AND RETURN THE ORIGINAL MESSAGE TO US AT THE ABOVE ADDRESS VIA U.S. MAIL.

WE ARE TRANSMITTING 2 PAGES (including this cover sheet). IF TRANSMISSION IS NOT COMPLETE, PLEASE CALL (909) 884-4867. THANK YOU.

SKOUSEN & SKOUSEN
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December 18, 2002

Via Facsimile (312) 332-6376 & U.S. Mail

William T. McGrath, Esq.
Davis, Mannix & McGrath
125 South Wacker Drive, Suite 1700
Chicago, Illinois 60606-4402

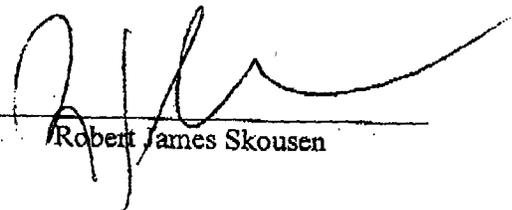
RE: Pioneer Corp. v. Hitachi High Technologies America, Inc.
Opposition Number 125,458
Deposition of Hitachi America, Ltd

Dear Mr. McGrath:

Although we have diligently sought to avoid the need for taking the deposition of Hitachi America, Ltd., we have been unable to reach an agreement with counsel. Accordingly, despite our efforts, the deposition will go forward at 10:00 a.m. on Friday, December 20, 2002 in San Francisco. If you have any questions or comments regarding this matter, please do not hesitate to contact me directly.

Very Truly Yours,

SKOUSEN & SKOUSEN
A Professional Corporation

By: 

Robert James Skousen

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WILLIAM T. McGRATH
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WMcGRATH@DMMLAW.COM

December 19, 2002

Via Fax - 310/782-9579
and U.S. Mail
Robert James Skousen
Skousen & Skousen, P.C.
12400 Wilshire Boulevard
Suite 900
Los Angeles, CA 90025-1060

Re: Pioneer Corp. v. Hitachi High
Technologies America, Inc.
Opposition No. 125,458

Dear Mr. Skousen:

First, this letter will confirm that the video conference is scheduled to proceed on January 14, 2003 at 9:00 a.m. (PST). Our technical people will be in touch with yours to arrange for the video conference.

Second, I was very surprised to receive your letter dated December 18, 2002 in which you indicate your intention to go forward with the deposition of Hitachi America Limited on Friday, December 20, 2002 in San Francisco. The deposition will not take place at that time or location. We had an agreement that no depositions would take place until the parties had fully explored settlement in this matter, namely by way of the video conference scheduled for January 14th. I ask you to withdraw your statement that the deposition will go forward on December 20. If you refuse to do so, I will file a motion for a protective order with the TTAB. You can be assured, however, under any circumstances the deposition will not occur on December 20th, and if you insist on going to San Francisco, you do so at your own risk and expense.

There is no urgency to obtaining this deposition prior to the video conference. As you know, we have filed a joint stipulation to extend discovery for an additional two months. As you also know, I have indicated to you that even in the unimaginable situation where the TTAB did not grant the stipulated motion for extension of time, I would not object to your attempt to take the deposition after the formal close of discovery.

DAVIS, MANNIX & McGRATH

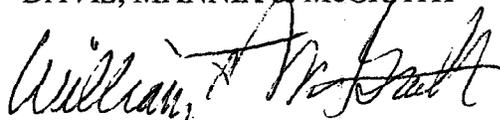
Robert James Skousen
December 19, 2002
Page 2

Your "hard ball" tactics are not appreciated and do not advance the cause of achieving an agreed upon resolution of this case.

If you have any questions or comments, please do not hesitate to contact me directly.

Very truly yours,

DAVIS, MANNIX & McGRATH

A handwritten signature in cursive script, appearing to read "William T. McGrath".

William T. McGrath

WTM:ph

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November 15, 2002

Via Facsimile (312) 332-6376 & U.S. Mail

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Chicago, Illinois 60606-4402

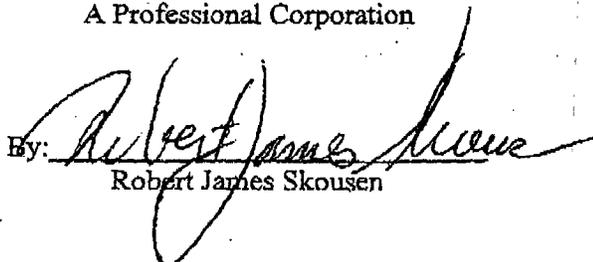
RE: Pioneer Corp. v. Hitachi High Technologies America, Inc.
Opposition Number 125,458
Confirmation Letter

Dear Mr. McGrath:

This letter will confirm our conversation yesterday regarding our pending notice to take the deposition of your client's person(s) most knowledgeable. Specifically, you agreed to stipulate to our right to take these depositions after November 15, 2002 even if the TTAB does not grant the stipulated motion to extend time. We also agreed that before taking these depositions we will fully and completely explore settlement in this matter. If you have any questions or comments, please do not hesitate to contact me directly.

Very Truly Yours,

Skousen & Skousen
A Professional Corporation

By: 
Robert James Skousen

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December 20, 2002

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Assistant Commissioner for Trademarks
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Arlington, Virginia 22202-3513

12-20-2002

U.S. Patent & TMO/c/TM Mail Rpt Dt. #30

RE: Opposition No. 125,458
SUPERSCAN ELITE

Dear Sir or Madam:

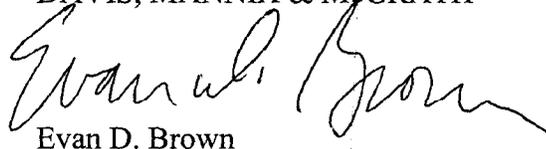
Please find the following enclosed documents related to the above referenced matter:

1. Applicant's Motion for Protective Order
2. Postcard for confirmation of your receipt of this correspondence.

Do not hesitate to contact our office with any problems regarding this filing.

Sincerely,

DAVIS, MANNIX & McGRATH


Evan D. Brown

Encls.
EDB:st