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More importantly, Applicant brings this motion with "unclean hands." Applicant's responses to Pioneer's reasonable discovery requests have been less than forthcoming, forcing Pioneer to bring motions to compel to vindicate its discovery rights. Applicant refuses to produce Michael Levans, Applicant's general manager for his individual deposition, forcing Pioneer to file a motion to compel his deposition. Even at present, Pioneer's motion to compel Mr. Levans' individual deposition is pending. Moreover, Applicant refuses to produce Michael Levans for the continuation and completion of his deposition 30(b)(6) that began on March 6, 2003 but was not completed because he failed to produce the documents he was commanded to produce. Pioneer has also filed a second motion to compel completion of the 30(b)(6) deposition; this motion is also pending.

Applicant's brief fails to cite any authority in its motion that allows the Board to issue terminating sanctions based on the facts of this proceedings. Accordingly, this motion should be denied.

II.

PROCEDURAL HISTORY

A. THE JULY 2, 2003 DEPOSITIONS

On June 4, 2003, Applicant served deposition notices for Craig McManis, a Pioneer employee, and Pioneer's person most knowledgeable pursuant to Federal Rule of Procedure 30(b)(6). These depositions were set to be taken on July 2, 2003 in Los Angeles, California. Skousen & Skousen ("the Skousen Firm"), Pioneer's counsel in this opposition proceeding, informed Pioneer's general counsel and Mr. McManis on June 6, 2003 of the July 2, 2003 depositions. In the weeks

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prior to the depositions, the Skousen Firm was in regular contact with Pioneer with respect to the pending depositions. Robert Skousen Decl. ¶ 2.

Nonetheless, Mr. McManis did not believe he had to attend the deposition scheduled on July 2, 2003, because he was no longer employed as Pioneer North America, Inc.'s Vice President of Marketing. See Craig McManis Declaration ¶¶ 2-6. Mr. McManis believed his co-worker, Mr. Russell Johnston, would take his place at the deposition. McManis Decl. ¶ 3. Mr. Johnston, Pioneer's senior vice president of marketing, was unaware he was Pioneer's 30(b)(6) designee until June 30, 2003. See Russell Johnston Declaration ¶¶ 2-7. At that time, Mr. Johnston informed the Skousen Firm on June 30, 2003, of both his and Mr. McManis' unavailability because both gentlemen had a business trip scheduled to another part of the country. Johnston Decl. ¶ 6.

Robert Skousen ("Mr. Skousen") did not learn of Messrs. Johnston's and McManis' unavailability until approximately 4:30 p.m., Pacific Daylight Time, on June 30, 2003. Mr. Skousen then immediately attempted to contact William McGrath, counsel for Applicant, of his clients' unavailability by facsimile at approximately 5:00 p.m., Pacific Daylight Time, on June 30, 2003. Skousen Decl. ¶ 4, Ex. "A". Mr. Skousen's letter to Mr. McGrath specifically identified alternative dates for the canceled depositions. Nevertheless, Mr. McGrath did not respond.

On July 1, 2003, Mr. McGrath left to travel to the depositions in Los Angeles. Later on July 1, 2003, Mr. McGrath contacted Mr. Skousen and informed him that he was already in Los Angeles and expected the

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accepted for the specific purpose of resolving the pending motion for sanctions. Skousen Decl. Ex. "E".

On August 1, 2003, Mr. McGrath spoke with Mr. Skousen by telephone and informed him that he wanted to postpone taking the depositions to a date in the future. Mr. McGrath also sent a confirming letter dated August 1, 2003 indicating that he was postponing the depositions to a "mutually agreeable date in the future." Skousen Decl. Ex. "F". As of the filing of this opposition, counsel for Pioneer has not received notice that the motion for sanctions has been withdrawn by Applicant.

III.

ARGUMENT

A. APPLICANT'S MOTION FOR SANCTIONS IS MOOT BECAUSE APPLICANT AND OPPOSER AGREED TO INFORMALLY RESOLVE THIS MOTION

Pioneer respectfully submits, based upon the correspondence set forth above, that this Motion for Sanctions is moot. Mr. McGrath's July 25, 2003 letter to Mr. Skousen indicates Applicant's desire to reach a reasonable conclusion to the dispute and Mr. Skousen's July 28, 2003 letter clearly indicates an agreement to the terms set forth in Mr. McGrath's July 25, 2003 letter. Consequently, Applicant's motion for sanctions is moot because Applicant agreed to withdraw the motion and end this discovery dispute in exchange for the appearance of Messrs. McManis and Johnston in Chicago, Illinois.

Federal case law is extensive supporting a court's denial of a motion for protective order because the issues in the motion have become moot. A court may deny a motion to compel, a motion for

1013, 1014 (T.T.A.B. 1983) (Board refused to issue terminating sanctions on second motion for sanctions when deponent failed to show up for deposition in violation of a Board order even though the Board noted deponent deliberately "sought to evade and frustrate petitioner's attempt at discovery.") However, the Board, in *Unicut*, warned the deponent that a repeated violation of the Board's discovery order would warrant dismissal. In a later discovery dispute involving the same case and parties, (*Unicut Corp. v. Unicut Inc.*, 222 U.S.P.Q. 341 (T.T.A.B. 1983)), Unicut Corporation violated the Board's order to produce the deponent for the third time, and a motion for sanctions was filed for a third time. In the earlier motion, the Board pointed out that "strong showing...of willful evasion" was necessary for terminating sanctions to be issued by the Board. In the later case, the Board noted the circumstances for issuing terminating sanctions:

Petitioner brought this action over three and one half years ago and despite one motion for judgment, two motions to compel (granted by the Board), and two previous motions for sanctions, petitioner has been unable to obtain discovery depositions and documents from respondent.

Id. at 344.

The Board issued terminating sanctions only after its discovery order was wilfully violated for the **third time**. The Board concluded that "Respondent's wilful failure to comply with the November 18, 1983 order of the Board after having been advised of the possible consequences warrants the sanction [dismissal] requested by petitioner." *Id.* at 344.

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Discovery orders were violated in both *Unicut* cases unlike the present matter before the Board. Here, no order of the Board has ever been issued compelling Pioneer to take some action with respect to pending discovery. Pioneer did not violate a discovery order that ordered the production of Messrs. McMannis and Johnston. (See Skousen Decl. ¶ 5.) Pioneer's failure to appear at its deposition was due to the individual employees' mistaken beliefs that they did not have to appear for their deposition due to rumors of settlement discussions and confusion over who was the 30(b)(6) designee. Once Pioneer's counsel was aware that Messrs. McMannis and Johnston were not available, Pioneer's counsel promptly notified opposing counsel. Pioneer did not wilfully violate a discovery order of the Board that would warrant dismissal as a sanction. Accordingly, this motion for sanctions should be denied.

C. **PIONEER HAS, ON MORE THAN ONE OCCASION, OFFERED ALTERNATIVE DATES FOR THE TAKING OF THESE DEPOSITIONS**

The arguments raised in Applicant's motion each rely solely upon the applicability of Trademark Rule 2.120(g)(2). The relevant portion of Rule 2.120(g)(2) states:

(2) If a party, or an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6)...fails to attend the party's or person's discovery deposition, after being served with proper notice...**and such party or the party's attorney or other authorized representative informs the party seeking discovery that no response will be made thereto**, the Board may make any appropriate order, as specified in paragraph (g)(1) of this section.

37 C.F.R. § 2.120(g)(2) (emphasis added).

Based upon on the highlighted language above, this section is inapplicable because Pioneer has never refused to produce Messrs. Johnston and McManis for their discovery depositions. On June 30, 2003, July 18, 2003, and again on July 24, 2003, Pioneer offered several alternative dates for Applicant to depose Pioneer's employees. These offers culminated in the rescheduling of the depositions for August 5 and 6, 2003 in Chicago, Illinois. Despite the agreement to take the depositions on August 5 and 6, 2003 in Chicago, Mr. McGrath, of his own accord, decided to postpone the depositions. See Ex. "F". Consequently, this motion for sanctions should be denied.

D. **MESSRS. MCMANIS AND JOHNSTON DID NOT APPEAR AT THEIR DISCOVERY DEPOSITIONS BECAUSE OF A PREVIOUSLY PLANNED BUSINESS TRIP TO ANOTHER PART OF THE COUNTRY**

Messrs. McManis and Johnston did not appear at their depositions because there was confusion between the employees at Pioneer as to who the Rule 30(b)(6) designee should be and whether they were obligated to appear at the deposition because of rumors of settlement discussions among the parties.

Mr. McManis did not believe he had to attend the deposition scheduled on July 2, 2003, because he had changed positions within Pioneer and was no longer employed as Pioneer North America, Inc.'s Vice President of Marketing. Mr. McManis believed his co-worker, Mr. Russell Johnston, would take his place at the deposition. On June 30, 2003, two days prior to his deposition, Mr. McManis informed Mr. Skousen that he would be unavailable due to a business trip to another state.

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Applicant for his individual deposition. This refusal resulted in the recent filing of a motion to compel that deposition. Similarly, Applicant's continued refusal to produce Michael Levans for continuation and completion of his 30(b)(6) deposition also resulted in the recent filing of a motion to compel. Thus, Applicant is in no position to seek the penultimate sanction of dismissal where its own discovery conduct has clearly been less than forthcoming and where Applicant brings this motion with unclean hands.

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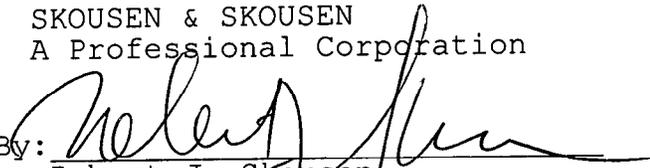
IV.

CONCLUSION

Based on the foregoing facts, arguments, and points of law, Pioneer respectfully, yet earnestly, urges the Board to deny this motion for sanctions. This motion is moot based upon an agreement between the parties to resolve the dispute. Nevertheless, if the Board does not find that the motion is moot, Pioneer has not wilfully evaded a discovery order by the Board in this matter and Pioneer's employees were confused as to whether their attendance at the deposition was required and thus failed to inform Pioneer's outside counsel until two days before the deposition. For the foregoing reasons, Pioneer requests that the Board deny the Applicant's motion for sanctions including dismissal.

DATED: August 4, 2003

SKOUSEN & SKOUSEN
A Professional Corporation

By: 

Robert J. Skousen
Skousen & Skousen
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Los Angeles, California 90025-1060
Telephone: (310) 277-0444
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Attorneys for Opposer Pioneer Kabushiki
Kaisha dba Pioneer Corporation

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6. On at least three occasions, I have offered alternative dates for Applicant to depose Pioneer's employees, Messrs. Johnston and McManis. Neither this firm nor Pioneer has ever refused to produce Messrs. Johnston and McMannis for their depositions in this matter.

7. On July 18, 2003, I sent a letter to Mr. McGrath indicating that we would make Messrs. Johnston and McManis available for discovery deposition on several dates at the end of July and the beginning of August 2003.

8. On July 24, 2003, in follow-up to my telephone conversation with Mr. McGrath, I sent a letter to Mr. McGrath indicating that both Mr. McManis and Mr. Johnston were available on August 5 or 6, 2003 in Chicago, Illinois. My letter specifically stated that both deponents were being produced in a good faith effort to resolve Applicant's motion for sanctions.

9. On July 25, 2003, I received a letter from Mr. McGrath with a counter-offer for resolving the dispute over the depositions and for the withdrawal of this motion for sanctions. Mr. McGrath's letter asked that Pioneer have its witnesses appear in Chicago and that Pioneer pay his expenses in traveling to Los Angeles on July 1, 2003.

10. Thereafter, on July 28, 2003, I conveyed my client's acceptance of the proposal set forth in Mr. McGrath's July 25, 2003 letter. My letter clearly stated that the offer was being accepted for the specific purpose of resolving the pending motion for sanctions.

11. Thereafter, on August 1, 2003, I spoke with Mr. McGrath by telephone and he informed me that he wanted to postpone taking the depositions to a date in the future. Mr. McGrath also sent a confirming letter to me dated August 1, 2003 indicating that he was postponing the depositions to a "mutually agreeable date in the future."

12. Attached hereto and incorporated herein by reference are true and correct copies of the following documents submitted in support of this motion to compel:

Exhibit A-June 30, 2003 letter from Robert Skousen to William McGrath;

Exhibit B-July 18, 2003 letter from Robert Skousen to William McGrath;

Exhibit C-July 24, 2003 letter from Robert Skousen to William McGrath;

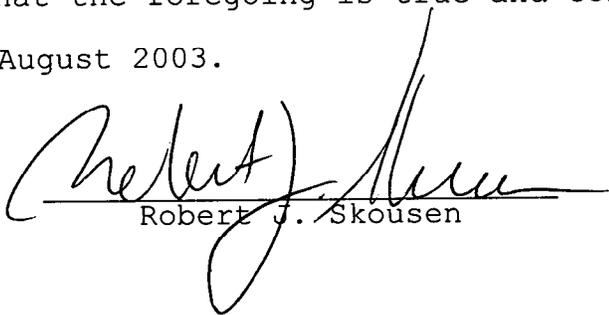
Exhibit D-July 25, 2003 letter from William McGrath to Robert Skousen;

Exhibit E-July 28, 2003 letter from Robert Skousen to William McGrath;

Exhibit F-August 1, 2003 letter from William McGrath to Robert Skousen.

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I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. Executed on this the 5th day of August 2003.


Robert J. Skousen

DECLARATION OF CRAIG McMANIS

I, Craig McManis, certify as follows:

1. I am an employee of Pioneer Corporation and my current job title is Vice President of Nation Account and Industrial Display. Formerly, I was employed by Pioneer North America, a subsidiary of Pioneer Kabushiki Kaisha d/b/a Pioneer Corporation and held the job title of Senior Vice President of Marketing. I make this declaration in support of Pioneer's opposition to the motion for sanctions, including dismissal, brought by Hitachi High Technologies America, Inc.

2. I was informed on June 6, 2003, by Robert Skousen of Skousen & Skousen, outside counsel for Pioneer Corporation that Hitachi High Technologies America, Inc., had noticed my deposition on July 2, 2003 in the matter.

3. However, I believed that I was not required to attend my deposition because I had accepted a new position at another Pioneer subsidiary on April 1, 2003, which was not a party to this matter. Further, I believed that Russell Johnston would take my place at the deposition.

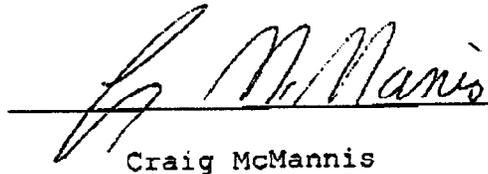
4. Moreover, I was unavailable for my deposition on July 2, 2003 because I had a business trip in another state and could not attend the deposition.

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5. I informed Mr. Skousen on the afternoon of the June 30, 2003 for the first time that I would be unavailable for my scheduled deposition on July 2, 2003.

6. I informed Mr. Skousen that I am available for depositions on August 5 and 6, 2003.

I declare under the penalty of perjury under the laws of the United States that the foregoing statements are true to the best of my knowledge, information, and belief.


Craig McMannis

I declare under the penalty of perjury under the laws of the United States that the foregoing statements are true to the best of my knowledge, information, and belief.



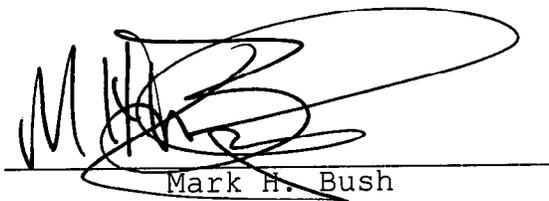
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Russell Johnston

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CERTIFICATE OF MAILING BY FIRST CLASS MAIL

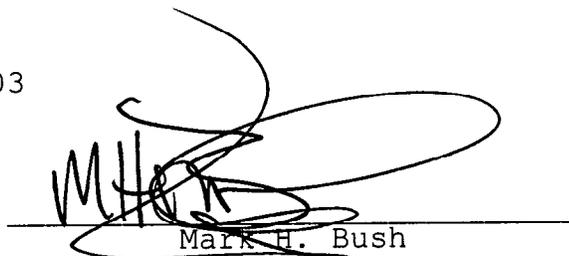
I hereby certify that the foregoing described as: **PIONEER'S OPPOSITION TO APPLICANT'S MOTION FOR SANCTIONS, INCLUDING DISMISSAL; DECLARATION OF ROBERT JAMES SKOUSEN; DECLARATION OF CRAIG MCMANIS; and DECLARATION OF RUSSELL JOHNSTON** is being deposited with the United States Postal Service, First Class postage prepaid, addressed to the Assistant Commissioner for Trademarks, Box TTAB No Fee, 2900 Crystal Drive, Arlington, Virginia 22202-3513. Executed on this, the 5th day of August 2003.


Mark H. Bush

CERTIFICATE OF SERVICE

I hereby certify that the foregoing **PIONEER'S OPPOSITION TO APPLICANT'S MOTION FOR SANCTIONS, INCLUDING DISMISSAL; DECLARATION OF ROBERT JAMES SKOUSEN; DECLARATION OF ROBERT JAMES SKOUSEN; DECLARATION OF CRAIG MCMANIS; and DECLARATION OF RUSSELL JOHNSTON** is being deposited with the United States Postal Service, first class postage prepaid, in an envelope addressed to William T. McGrath, Esq., Davis, Mannix & McGrath, 125 South Wacker Drive, Suite 1700, Chicago, Illinois 60606.

DATED: August 5, 2003


Mark H. Bush