

**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513**

**Mail date: January 13, 2004**

**Opposition No. 91/125,458**

**Pioneer Kabushiki Kaisha dba  
Pioneer Corporation**

**v.**

**Hitachi High Technologies  
America, Inc. formerly known  
as Nissei Sangyo America, Ltd.**

**Cheryl Butler, Interlocutory Attorney, for Elizabeth Dunn,  
Interlocutory Attorney**

Discovery was last set to close on July 6, 2003 by the parties' request in opposer's consented motion, filed May 27, 2003, to extend dates. Said motion was granted by the Board in its order of August 4, 2003 suspending proceedings pending disposition of the motions considered herein. This case now comes up on the following motions:

- 1) opposer's fully-briefed motion, filed March 3, 2003, for leave to amend its notice of opposition, accompanied by its proposed amended notice of opposition;
- 2) applicant's fully-briefed motion, filed July 8, 2003, for discovery sanctions; and
- 3) opposer's related motions, filed July 21, 2003, for an order compelling the attendance of a witness for continued deposition and for discovery sanctions under Trademark Rule 2.120(g)(2).

**Applicant's motion for sanctions (filed July 8, 2003)**

Applicant seeks sanctions against opposer for opposer's failure to produce witnesses for deposition on July 2, 2003 (noticed on June 5, 2003). Applicant argues that its attorney spoke with an attorney for opposer on June 30, 2003 at 4:00 p.m. (CST); left the office at 5:15 p.m. (CST); and departed for Los Angeles the next day, July 1, 2003. Upon arriving in L.A., applicant's attorney was informed that opposer sent a facsimile letter to applicant's attorney's offices the evening of June 30, 2003 (which arrived at 7:07 p.m. CST) stating that opposer would not be attending the deposition. Opposer was not able to produce witnesses for the July 2, 2003 deposition.

In response, opposer states the applicant's motion is now moot because the parties have agreed to a resolution of the dispute. Opposer explains that the witnesses were confused as to who was going to attend the deposition; that each witness had scheduled a conflict; that opposer's attorney was not aware of the confusion and conflicts giving rise to the unavailability of the witnesses until late on June 30, 2003; and the opposer's attorney then attempted immediately to contact applicant attorney. Opposer has now agreed, in order to resolve applicant's pending motion for sanctions, to make the witnesses available in Chicago, per applicant's request, at a mutually agreeable date.

In view of the agreement between the parties, applicant's motion for sanctions is moot, and hereby denied.

**Opposer's motion to compel the attendance of a witness at a continued deposition; opposer's motion for sanctions under Trademark Rule 2.120(g)(2)**

In support of its motions, opposer argues that the deposition of applicant's 30(b)(6) witness, Mr. Levan, commenced on March 6, 2003 in Chicago. During the course of the deposition, opposer was made aware that applicant had not had time to complete its document search. Consequently, opposer adjourned the deposition for completion pending receipt of requested documents. Proceedings were subsequently suspended by the Board pending disposition of others motions. Upon resumption, opposer argues that it attempted to make arrangements to complete the 30(b)(6) deposition of Mr. Levan; and that applicant informed opposer that Mr. Levan would not be made available because applicant had made him available earlier and opposer had the opportunity "to take the full seven hours" at that time. In an effort to resolve the matter, opposer argues that it agreed to depose any other 30(b)(6) witnesses as a possible means of completing the deposition, reserving the right to compel completion of Mr. Levan's deposition if the testimony given by the other 30(b)(6) designee(s) proved insufficient. Opposer contends that, during the course of the June 30, 2003 deposition of another 30(b)(6) designee for applicant, it became

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apparent that Mr. Levan was the person most knowledgeable about several categories of information.

Opposer also attempted to make arrangements and notice the deposition of Mr. Levan in his individual capacity during May and June 2003, and was informed by applicant's attorney that Mr. Levan would not be produced again for deposition.

With respect to its motion for sanctions, opposer seeks as relief judgment in its favor under Trademark Rule 2.120(g)(2) because applicant's attorney informed opposer's attorney that Mr. Levan would not be produced for deposition in his individual capacity. Alternatively, opposer seeks an order compelling production of Mr. Levan for deposition in his individual capacity.

With respect to its motion to compel, opposer seeks an order compelling the continued deposition of Mr. Levan in his 30(b)(6) capacity. Opposer requests that either or both depositions be ordered in Los Angeles.

Although applicant has not responded to opposer's motions, the Board will consider the motions on their merits. See Trademark Rule 2.127(a).

A motion for sanctions under Trademark Rule 2.120(g)(2) is available for discovery depositions where the responding party (1) has not responded and (2) informs the requesting party that no response will be made. In this case, applicant's refusal to produce Mr. Levan appears to arise from its perception that,

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having produced Mr. Levan once, applicant need not produce him again. Applicant has continued to participate in discovery, including producing a different 30(b)(b) witness. Thus, opposer's motion for sanctions in the nature of judgment is denied.

Fed. R. Civ. P. 30(d)(2) provides, in relevant part, that a deposition is limited to one day of seven hours unless otherwise authorized by the court or agreed upon by the parties. The Committee Note further advises that "preoccupation with timing is to be avoided," and longer depositions may be justified for a variety of reasons, including that requested documents have not been produced. See Wright, Miller & Marcus, 8A Federal Practice and Procedure Civil 2d § 2104.1 (2<sup>nd</sup> ed. 1994 & Supp. 2001). In addition, the 30(b)(6) deposition of a witness is a separate deposition from the deposition of that same person as an individual witness and is presumptively subject to a separate, independent seven-hour time limit. See *Sabre v. First Dominion Capital, Inc.*, 51 Fed. R. Serv. 3d 1405 (S.D.N.Y. 2001). This is not to say, however, that the inquiring party has *carte blanche* to depose an individual for seven hours as an individual and seven hours as a 30(b)(6) witness. *Id.*

Here, opposer combined its notice of deposition with a request for documents to be produced, and it became apparent during the course of the deposition that applicant had not completed its document search before the deposition. Thus,

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adjourning the deposition early for continuance at a later date was reasonable. Moreover, opposer is permitted to depose Mr. Levan in his individual capacity and his 30(b)(6) capacity, so long as the questioning is not duplicative or repetitive.

Accordingly, opposer's motion to compel the continued deposition of Mr. Levan in his 30(b)(6) capacity is granted; and opposer's motion to compel the deposition of Mr. Levan in his individual capacity is granted. However, a single day in accordance with Fed. R. Civ. P. 30(d)(2) should be sufficient to complete both depositions.

It is noted that opposer has agreed to produce its 30(b)(6) witnesses in Chicago at a mutually agreeable date. In view of this arrangement, the Board suggests that the parties agree to coincide the continued deposition of Mr. Levan with the depositions of opposer's 30(b)(6) witnesses in Chicago. Thus, in the interest of expediency, opposer's request that Mr. Levan be produced in Los Angeles for deposition is denied.

Proceedings are resumed. The parties are reminded that they must notice and conduct the depositions while discovery is open. See TBMP Section 404.01 (June 2003). Dates are reset later in this order.

**Opposer's motion for leave to file an amended notice of opposition**

As grounds for its original notice of opposition, opposer alleges that applicant's mark, when used on the identified goods, so resembles opposer previously used and registered mark

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as to be likely to cause confusion, mistake or to deceive. Opposer now seeks leave to amend its notice of opposition to include additional grounds it argues it uncovered during the discovery deposition of applicant. Those grounds are: that applicant does not have a bona fide intention to use the mark; that applicant's reliance on a prior mark is misplaced because this prior mark has been abandoned by applicant; and that applicant's use of its mark will dilute opposer's famous mark. Opposer's motion is accompanied by a proposed amended notice of opposition.

In response, applicant argues that opposer's dilution claim is legally insufficient because opposer has not alleged that its mark became famous before applicant's constructive use date; has not alleged that its mark is distinctive; and has not alleged sufficient similarities between the marks. Applicant argues that its alleged abandonment of a previously registered mark is not before the Board and has no relevance to this proceeding. Applicant also contends that opposer delayed in bringing its motion.

In reply, opposer resubmitted its proposed amended notice of opposition to be in compliance with stated requirements for pleading dilution as discussed in *Polaris Industries Inc. v. DC Comics*, 59 USPQ2d 1798 (TTAB 2000). In addition, opposer deleted its allegation of abandonment of applicant's previously

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registered mark,<sup>1</sup> and substituted an allegation of opposer's belief of the existence of said registration and ownership by applicant. Opposer brought the motion promptly after it found out about the additional grounds during a discovery deposition, and after a period of suspension ordered by the Board.

Once a responsive pleading is served, a party may amend its pleading only with the written consent of the adverse party or by leave of the Board. The Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties. See Fed. R. Civ. P. 15(a); and TBMP Section 507.02. Moreover, opposer brought its motion while discovery was still open. Thus, there is no prejudice to applicant. *Id.*

In view thereof, opposer's motion for leave to file an amended notice of opposition is granted, and the proposed amended notice of opposition filed with opposer's reply brief of May 27, 2003 is entered. Applicant is allowed until **thirty days** from the mailing date of this order to file its answer to opposer's amended notice of opposition.

**Discovery and trial dates reset**

Discovery and trial dates are reset as follows:

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<sup>1</sup> Any allegation of abandonment of an existing registration must be brought before the Board in a petition to cancel. See Trademark Act Section 14.

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THE PERIOD FOR DISCOVERY TO CLOSE:	May 30, 2004
30-day testimony period for party in position of plaintiff to close:	August 28, 2004
30-day testimony period for party in position of defendant to close:	October 27, 2004
15-day rebuttal testimony period to close:	December 11, 2004

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Rule 2.125.

Briefs shall be filed in accordance with Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Rule 2.129.

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