

TTAB

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. )  
 )  
HITACHI HIGH TECHNOLOGIES AMERICA, )  
INC., by change of name from )  
NISSEI SANGYO AMERICA, LTD., )  
 )  
Applicant. )

Opposition No. 125,458  
Mark: SUPERSCAN ELITE  
Serial No.: 76/208,230  
Published: March 19, 2002



04-26-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #78

**APPLICANT'S MOTION FOR PROTECTIVE ORDER**

Applicant, Hitachi High Technologies America, Inc. ("Applicant" or "HHTA"), moves for a protective order pursuant Rule 26(c) of the Federal Rules of Civil Procedure to prevent Opposer, Pioneer Corporation, from taking five (or possibly six) additional depositions of HHTA personnel which are unnecessary and clearly meant to harass Applicant. In support of this motion, Applicant states as follows:

**Factual Background**

1. This opposition proceeding was filed on April 16, 2002. Opposer, owner of the mark ELITE, challenges Applicant's intent-to-use application for the mark SUPERSCAN ELITE. Since the proceeding commenced, Opposer has engaged in extensive and disproportionate discovery, much of it irrelevant to any issues in the case. In its scheduling order dated January 13, 2004, the Board ordered discovery to close on May 30, 2004.

2. Seeking to take the depositions of five or six additional HHTA employees is the the latest chapter in Opposer's ongoing campaign of vexatious and excessive discovery in this

case. The Board need only look through the pleadings to get a sense of the scale of Opposer's discovery campaign. In what should have been a fairly straightforward case involving an intent-to-use application, Opposer has served four sets of interrogatories totaling 65 questions, four sets of requests for production totaling 61 requests, and three sets of requests for admission totaling 41 requests. It has also issued a subpoena duces tecum to HHTA with 18 production categories. It has deposed two of Applicant's Senior Officers (Mr. Levans, Vice President and General Manager of the Electronic Products Division, and Mr. Snoke, who serves as Executive Vice President and General Counsel). Despite having already taken Mr. Levans' deposition, Opposer insisted on conducting a further deposition of Mr. Levans, which the Board has permitted pursuant to its order dated January 13, 2004. As result of the Board's order, Mr. Levans will be made available for another full day of depositions. Opposer has deposed a 30(b)(6) witness for Hitachi America, Ltd. (a related company which is not a party to this action). It has conducted depositions of two employees of another third-party, Hitachi Home Electronics, Inc. It has issued subpoenas duces tecum to both of these third-parties. It has requested production of massive amounts of irrelevant documents, resulting in Applicant making hundreds of boxes of the documents made available to Opposer. In June, 2003, when the time came for depositions of Pioneer's witnesses, it failed to produce the witnesses even though HHTA's counsel had traveled to California for the depositions.

### **Opposer's Current Request for Additional Depositions**

3. By letter dated April 16, 2004, Opposer indicated that it seeks to take the deposition of five (or possibly six) additional employees of Hitachi. In light of the discovery that has already occurred in this case and that will soon occur, these additional depositions are unnecessary duplicative, and clearly meant to be vexatious.

4. Opposer seeks to take the deposition of Messrs. Dennis Battaglia, Yuji Hidaka, Hidaka, Masatsugu Misu, Anthony Duda, Shigehiko Kobayashi, and "Hakai" (Applicant has no employee by this name and is unaware of the intended identity of this person).

5. Messrs. Battaglia, Hidaka, Misu, and Duda all work in the Electronic Products Division of HHTA and all ultimately report to Mr. Michael Levans. All these gentlemen assist Mr. Levans in conducting the business of the Electronics Products Division and are part of his sales team. Mr. Battaglia is the Home Electronics Department Manager in the Home Electronics Department. Mr. Misu is a Sales Account Manager. Mr. Hidaka is the Deputy General Manager and the immediate subordinate of Mr. Levans. Mr. Duda is a Marketing Manager in the Home Electronics Department, providing training to customers in connection with HHTA's electronic products. None of these persons has decision-making authority with respect to the adoption or use of the SUPERSCAN ELITE trademark or any other mark used by HHTA. All such determinations are made by Mr. Levans. None of the above named gentlemen would have any pertinent information relating to the adoption or use of the SUPERSCAN ELITE mark that has not already been testified about by Mr. Levans. Whatever knowledge they have is clearly duplicative of the knowledge of each other and of Mr. Levans.

6. On March 6, 2003, Opposer took the deposition Mr. Levans and inquired at length about matters relevant to this lawsuit. Mr. Levans has testified fully in response to Opposer's questions concerning the SUPERSCAN family of marks, including SUPERSCAN ELITE, and HHTA's plans for implementation of that mark. Pursuant to the Board's January 13 Order, Mr. Levans will soon be providing yet another day of testimony. In light of the fact that Opposer will then have two days of deposition testimony from Mr. Levans, as well as a deposition of Mr. Snoke,

HHTA's General Counsel, there is no need for depositions of his subordinates. Such requested depositions will be expensive, time consuming and will be disruptive to the operations of the Electronics Products Division.

7. Mr. Kobayashi is a high-ranking executive at HHTA. He is Executive Vice President of the entire Electronics Group of HHTA, and is Mr. Levans' immediate superior. Mr. Kobayashi is a member of HHTA's Board of Directors and reports directly to the President of HHTA. Any information relating to the adoption or intended use of the SUPERSCAN ELITE trademark would come to him through Mr. Levans. Mr. Kobayashi would have nothing significant to add to the testimony of Mr. Levans. Naming such a high-ranking officer for a deposition is harassment.

8. In short, Opposer has already transformed what should have been a straightforward opposition proceeding into a litigation maelstrom. It is attempting to perpetuate this maelstrom by asking for yet another five or six unnecessary depositions. This is an opportunity for the Board to stem the tide of unnecessary and duplicative discovery in this case.

9. The Board has the power to control discovery in opposition proceedings. See, 37 C.F.R. 2.120(f) (providing that the TTAB may issue protective orders to protect a party from annoyance, embarrassment, oppression, or undue burden or expense). As the Board has noted:

Although the rules contemplate liberal discovery, the right to discovery is not unlimited. Both the Trademark Rules and the Federal Rules of Civil Procedure grant the Board discretion to manage the discovery process in order to balance the requesting party's need for information against any injury that may result from discovery abuse.

*FMR Corp. v. Alliant Partners*, 1999 TTAB Lexis 354 at \*5. See also, TBMP §402.02 ("Even if the discovery sought by a party is relevant, it will be limited, or not permitted, where, *inter alia*, it is unreasonably cumulative or duplicative; or is obtainable from some other source that is more

convenient, less burdensome, or less expensive. . .”).

10. In a case in which a litigant before the Board alleged that the deposition of corporate officers constituted harassment, the Board has made clear that such harassment will not be tolerated. In *FMR Corp. v. Alliant Partners*, 1999 TTAB Lexis 354, the Board granted a protective order against the deposition of two corporate officers, where it had been shown that there were other individuals with adequate knowledge of relevant facts. See also, *Kellogg Co. v. New Generation Foods, Inc.*, 6 U.S.P.G. 2d 2045, 1988 TTAB Lexis 12, at \*14-17 (protective order issued to preclude deposition of corporate officer).

11. There is no valid reason why Opposer needs depositions from the high-ranking Mr. Kobayashi or the lower ranking employees who report to Mr. Levans and are part of his sales team. A far less intrusive alternative is to seek the information from Mr. Levans in his upcoming deposition.

WHEREFORE, Applicant requests that this Board enter a protective order precluding Opposer from deposing Messrs. Battaglia, Hidaka, Misu, Duda, Kobayashi, or any other employees of HHTA, except for Mr. Levans who will be made available for his second day of deposition.

Respectfully submitted,

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### CERTIFICATE OF MAILING

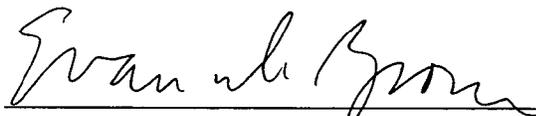
I hereby certify that the foregoing APPLICANT'S MOTION FOR PROTECTIVE ORDER is being deposited with the United States Postal Service, first class postage prepaid, in an envelope addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202, BOX TTAB, on **April 21, 2004**.



Evan D. Brown

### CERTIFICATE OF SERVICE

I hereby certify that the foregoing APPLICANT'S MOTION FOR PROTECTIVE ORDER is being transmitted by facsimile to 310-782-9579, and is being deposited with the United States Postal Service, first class postage prepaid, in an envelope addressed to Mr. Robert J. Skousen, SKOUSEN & SKOUSEN, P.C., 12400 Wilshire Boulevard, Suite 900, Los Angeles, California, 90025-1060, on **April 21, 2004**.



Evan D. Brown