

TTAB

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

PIONEER KABUSHIKI KAISHA d/b/a)	
PIONEER CORPORATION,)	
)	Opposition No. 125,458
Opposer,)	
)	Mark: SUPERSCAN ELITE
v.)	Serial No.: 76/208,230
)	Published: March 19, 2002
HITACHI HIGH TECHNOLOGIES AMERICA,)	
INC., by change of name from)	
NISSEI SANGYO AMERICA, LTD.,)	
)	
Applicant.)	

APPLICANT'S REQUEST FOR CLARIFICATION OF SUSPENSION ORDER

Applicant, Hitachi High Technologies America, Inc., hereby requests clarification of the Board's Order issued July 26, 2004, in which the Board suspended proceedings as of July 12, 2004. In particular, Applicant seeks clarification with respect to the effect of Opposer's motion for sanctions and to compel, filed after the effective date of the suspension.

1. On July 12, 2004, Applicant filed a Motion to Compel Production of Survey Documents and for Other Relief. This Motion seeks production of documents relied on by Opposer's expert witness.

2. By order of the TTAB dated July 26, 2004, these proceedings were suspended "retroactive to the filing of applicant's motion to compel on July 12, 2004."

3. Trademark Rule §2.120(e)(2) provides that when a party files a motion to compel discovery, the case will be suspended, "*and no party should file any paper which is not germane to the motion*, except as may otherwise be specified in the Board's suspension order." (Emphasis added).



08-13-2004

4. On July 19, 2004, Opposer filed a motion styled Opposer's Motion for Sanctions Pursuant to Trademark Rule of Practice 2.120(g)(2) and Federal Rule of Civil Procedure 37, or Alternatively for an Order to Compel the Depositions of Anthony Duda, Dennis Battaglia, Yuji Hidaka, Masatsugu Misu, and Shigehiko Kobayashi (hereinafter "Motion for Sanctions or to Compel"). Opposer's Motion for Sanctions or to Compel is not germane to Applicant's previously filed motion to compel.

5. Opposer filed its Motion for Sanctions or to Compel a full week after Applicant filed its motion to compel. Applicant's motion was properly served on Opposer, and Opposer was made aware of the filing of the motion well in advance of the filing of Opposer's Motion for Sanctions or to Compel. This is not a situation in which the motions filed by each party simply crossed in the mail.

6. Opposer's July 19 motion is completely unrelated to and not germane to the issues raised in Applicant's July 12 motion. The July 12 motion deals with Opposer's failure to provide documents relied on by Opposer's retained expert, while Opposer's July 19 motion seeks sanctions or, alternatively, to compel the attendance of Applicant's employees for discovery depositions.

7. Because Opposer's Motion for Sanctions or to Compel was filed after Applicant's motion to compel and after the effective date of the suspension of proceedings, it appears to have been improperly filed and in contravention to Trademark Rule §2.120(e)(2), which prohibits the filing of papers not germane to Applicant's motion to compel.

8. Because Opposer's Motion for Sanctions appears to have been improperly filed, Applicant has not yet filed a response inasmuch as any response would not be germane to the initial motion to compel.

9. It is unclear from the Board's July 26 Order whether the Board will rule on the Motion for Sanctions or to Compel at this time, and whether Applicant should file a response to that Motion even though it is not germane to the original motion to compel. Though the first sentence of the Order mentions disposition of the pending "cross motions to compel," the final sentence of the Order states that "The motion to compel will be decided in due course." This final sentence presumably refers to Applicant's July 12 motion to compel production of documents, and since it is stated in the singular, it is not clear if it was intended to refer to Opposer's July 19 motion as well. Moreover, Opposer's July 19 motion may be rendered moot by the fully briefed and pending Motion for Protective Order.

WHEREFORE, Applicant respectfully requests clarification of the Board's July 26, 2004 Order suspending proceedings to indicate whether Opposer's Motion for Sanctions or to Compel was properly filed, and whether the Board will address and rule on that motion at this time. If the Board determines that it will address that motion at this time, Applicant requests time to respond to that motion.

Respectfully submitted,

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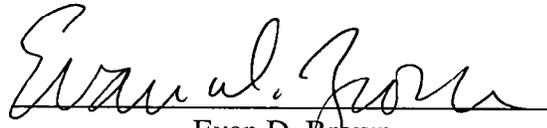
Opposition No. 125,458

Mark: SUPERSCAN ELITE

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CERTIFICATE OF MAILING

I hereby certify that the foregoing APPLICANT'S REQUEST FOR CLARIFICATION OF SUSPENSION 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 **August 9, 2004**.


Evan D. Brown

CERTIFICATE OF SERVICE

I hereby certify that the foregoing APPLICANT'S REQUEST FOR CLARIFICATION OF SUSPENSION 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 **August 9, 2004**.


Evan D. Brown