

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

PIONEER KABUSHIKI KAISHA dba)	Opposition No.:	91125458
PIONEER CORPORATION,)		
)	Mark:	SUPERSCAN ELITE
)	Serial No.:	76/208230
Opposer,)	Published:	March 19, 2002
)		
vs.)	OPPOSER'S MEMORANDUM OF POINTS	
)	AND AUTHORITIES IN OPPOSITION	
)	REPLY TO APPLICANT'S REQUEST	
)	FOR CLARIFICATION OF	
HITACHI HIGH TECHNOLOGIES)	SUSPENSION ORDER	
AMERICA, INC. formerly known as)		
NISSEI SANGYO AMERICA, LTD.,)		
)		
Applicant.)	DISC. CUT-OFF:	May 30, 2004
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Assistant Commissioner For Trademarks
Box TTAB
No Fee
2900 Crystal Drive
Arlington, Virginia 22202-3513



Opposer Pioneer Kabushiki Kaisha dba Pioneer Corporation (hereinafter "Pioneer") respectfully submits its reply to Applicant's Request for Clarification of this Board's Suspension Order and for additional time to respond to Pioneer's Motion for Sanctions and to Compel Depositions of Applicant's Employees.

I.

STATEMENT OF FACTS

On or about April 26, 2004, Applicant filed its motion for a protective order to prevent the taking of the depositions of its employees - specifically Anthony Duda, Dennis Battaglia, Masatsugu Misu, Shigehiko Kobayashi and Yuji Hidaka - after Pioneer had properly noticed the depositions and subpoenaed these witnesses. This was done **after** Applicant's counsel had already refused to produce these individuals for depositions previously scheduled during the pendency of the discovery period in this matter.

On or about May 7, 2004, Pioneer filed its opposition to Applicant's motion for this protective order. On or about May 28, 2004, Applicant filed its reply to Pioneer's opposition to their motion for a protective order. This Board did not file any order suspending proceedings at that time.

On May 20, 2004, the deposition of Pioneer's survey market research expert, Robert Klein, was taken by Applicant's attorney, William McGrath. It was claimed that Mr. Klein did not produce certain "survey documents" at that

deposition although they had never been subpoenaed as required by FRCP 45 or even separately requested by Mr. McGrath at the deposition.

The discovery period in this matter closed on May 30, 2004. On or about July 12, 2004 (42 days after the close of the discovery period), Applicant's counsel filed a motion to compel production of the "survey documents," which were never properly requested in connection with the deposition of Robert Klein. The Board did not issue any suspension order as of that date.

On or about July 19, 2004, Pioneer filed its motion for sanctions and/or to compel the depositions of Applicant's employees Anthony Duda, Dennis Battaglia, Masatsugu Misu, Shigehiko Kobayashi and Yuji Hidaka. No suspension order was issued by the Board as of that date.

On or about July 26, 2004, this Board issued its order suspending proceedings pending disposition of the then outstanding discovery motions filed by both parties.

On or about July 27, 2004, Pioneer timely filed its opposition to Applicant's motion to compel production of the "survey documents" pursuant to the provisions of 37 C.F.R. 2.120.

On or about August 9, 2004 (the last possible day upon which Applicant could have filed a response to Pioneer's motion for sanctions and/or to compel the taking of depositions), Applicant's counsel filed the instant request for clarification of this Board's suspension order of July

26, 2004. Applicant's request further sought additional time within which to respond to Pioneer's motion to compel depositions if the Board was going to consider Pioneer's motion to compel depositions in addition to Applicant's motion to compel production of the "survey documents." This request, in light of the clear wording of the Board's suspension order and the history of the conduct of Applicant's counsel in discovery in this matter, is disingenuous at best. The suspension order needs no clarification and Applicant's requests should be summarily denied.

II.

THIS BOARD'S SUSPENSION ORDER IS CLEAR ON ITS FACE AND REQUIRES NO CLARIFICATION

In the first paragraph of the Suspension Order of July 26, 2004, it unequivocally states: "Proceedings herein are suspended pending disposition of the **parties' cross motions to compel**, except as discussed below. The parties should not file any paper which is not germane to the motions to compel. See Trademark Rule 2.120 (e) (2)." (emphasis added).

There is no question that the suspension order plainly indicates that the Board will be considering the "parties' cross motions to compel." Obviously this reference is made with regard to a motion to compel made by **each party** - the motion to compel production of documents by applicant and the motion to compel the taking of applicant employee depositions by Pioneer. There is no other reasonable

construction of the order. Nowhere does the order indicate that Pioneer's motion to compel the taking of depositions is not properly before the Board. In fact, the order clearly sets forth the contrary - that the Board **will be considering** Pioneer's motion to compel the taking of the depositions of applicant's employees. It is difficult to imagine how the order could be any more explicit in stating the Board's intention to rule on the respective **"parties' cross motions to compel."**

If applicant's counsel thought the Board had asserted an erroneous position, he could have raised that as a point in his opposition to Pioneer's motion to compel depositions. He chose not to do so. However, his choice does not justify his request for more time within which to respond to Pioneer's motion herein. Applicant's requests should be summarily denied.

III

**BOARD PROCEEDINGS ARE NOT SUSPENDED UNLESS AND UNTIL
THE BOARD ISSUES AN ORDER FORMALLY SUSPENDING
PROCEEDINGS PENDING BEFORE IT**

Section 37 C.F.R. 2.120 (e) (2) provides in pertinent part: "When a party files a motion for an order to compel discovery, the case will be suspended by the Trademark Trial and Appeal Board. . . ." 37 C.F.R. § 2.120(e) (2) (West 2004).

37 C.F.R. 2.127(d) has virtually the same provision and states in relevant part: "When any party files a motion to

dismiss, or a motion for judgment on the pleadings, or a motion for summary judgment, or any other motion which is potentially dispositive of a proceeding, the case will be suspended by the Trademark Trial and Appeal Board. . . ."
37 C.F.R. § 2.127(d) (West 2004).

This Board has interpreted the identical "Suspension" provisions of these code sections in the context of cases involving dispositive motions. In *Consultants & Designers Inc. v. Control Data Corp.*, 221 U.S.P.Q. 635 (1984), the court explained:

[T]he provisions of Trademark Rule 2.127(d) do not automatically suspend a case. Instead, only an order by the board suspending proceedings has such effect. Since no such order was issued by the Board, the several papers subsequently submitted by respondent are not superfluous and may accordingly be considered by the Board if not otherwise objectionable.

Id. at 640 (emphasis added).

This interpretation was more recently upheld by the Board in the case of *Leeds Technologies Ltd. v. Topaz Communications Ltd.*, 65 U.S.P.Q. 2d 1303, 1305 (2002) where the Board unequivocally stated: "The filing of a potentially dispositive motion such as a motion for a judgment on the pleadings here, does not automatically suspend a case,

inasmuch as proceedings are not suspended until the Board issues a suspension order. . . ."

Id. at 1305 (emphasis added).

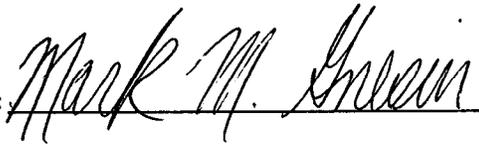
Thus, these cases make clear that until proceedings are suspended by the issuance of a Board order to that effect, there is no suspension of the proceedings. Here Pioneer filed its motion for sanctions and to compel the taking of depositions of Applicant's employees on or about July 19, 2004 - **7 days before the Board issued its suspension order.** Clearly proceedings had not been suspended as of the time Pioneer filed its motion to compel. In that situation, as pointed out by the Board in *Consultants & Designers Inc., supra*, subsequently filed papers are properly considered. In this matter, the Board has made the choice to consider these motions simultaneously while the proceedings are suspended. The Board's suspension order clearly reflected that decision. Applicant's counsel should not now be heard to plead for additional time to respond to Pioneer's motion to compel when it was apparent from the moment of the issuance of the Suspension order that the Board was going to consider Pioneer's motion to compel. Applicant's request is absolutely devoid of any showing of good cause to justify the granting of any additional time to respond to Pioneer's motion for sanctions and/or to compel the taking of the depositions of employees of Applicant. Applicants' requests should be denied forthwith so the Board may proceed to rule on the motions before it.

IV

CONCLUSION

For all of the foregoing reasons it is respectfully submitted that Applicant's requests, for clarification of the Suspension Order and for additional time to respond to Pioneer's motion for sanctions and/or to compel the taking of depositions of applicant employees, be denied based on applicant's failure to comply with the requirements of 37 C.F.R. 2.127 and their assertion of a meritless legal position. It is further requested that this Board proceed with the analysis of the current motions before it and rule upon said motions without further delay so as to proceed with an expeditious resolution to this opposition proceeding.

SKOUSEN & SKOUSEN
A Professional Corporation

By: 

Robert James Skousen, Esq.
Mark M. Gnesin, Esq.
Skousen & Skousen
A Professional Corporation
12400 Wilshire Blvd., Suite 900
Los Angeles, CA 90025-1060
Telephone: 310-277-0444
Facsimile: 310-782-9579

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I hereby certify that the foregoing OPPOSER'S MEMORANDUM OF POINTS AND AUTHORITIES IN OPPOSITION REPLY TO APPLICANT'S REQUEST FOR CLARIFICATION OF SUSPENSION ORDER is being deposited with the United States Postal Service, "Express Mail Post Office To Addressee" service in an envelope addressed to the Assistant Commissioner for Trademarks, Box TTAB, No Fee, 2900 Crystal Drive, Arlington, VA 22202-3513, on August 27, 2004.



Marlene Barnes

CERTIFICATE OF SERVICE

I, hereby certify that the foregoing OPPOSER'S MEMORANDUM OF POINTS AND AUTHORITIES IN OPPOSITION REPLY TO 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 Mr. William T. McGrath, DAVIS, MANNIX & McGRATH, Attorneys at Law, 125 South Wacker Drive, Suite 1700, Chicago, IL 60606-4402 on August 27, 2004.



Marlene Barnes