

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Ryan

MAILED: April 11, 2003

Opposition No. 150,298

Baxter International, Inc.

v.

Inviro Medical Devices, Ltd.

Before Karyn K. Ryan, Interlocutory Attorney
Trademark Trial and Appeal Board:

This case now comes up for consideration and review of several outstanding matters.

OPPOSER'S CONTESTED MOTION TO EXTEND DISCOVERY

It has come to the Board's attention that opposer's September 12, 2002 motion to extend discovery was contested by applicant. The Board, however, had not associated applicant's September 30, 2002 response brief with the proceeding file prior to issuance of the October 1, 2002 order herein. The oversight is regretted.

While we are mindful of applicant's concerns and objections, we are not persuaded that our October 1, 2002

Opposition No. 150,298

decision to reset the close of discovery was inappropriate. Accordingly, that decision stands. See Fed. R. Civ. P. 6(b).

OPPOSER'S MOTION TO AMEND ITS NOTICE OF OPPOSITION

Opposer's October 21, 2002 response to the Board's October 1, 2002 order is noted. Opposer's August 29, 2003 motion to amend its notice of opposition is **granted** as consented. See Fed. R. Civ. P. 15(a).

Opposer's August 29, 2002 amended notice of opposition and applicant's October 1, 2002 answer thereto are now the operative pleadings in this proceeding.

OPPOSER'S MOTION FOR PROTECTIVE ORDER

Opposer's September 27, 2002 motion for a protective order and applicant's October 16, 2002 response thereto are acknowledged.

The stipulated protective agreement filed on October 15, 2002 is noted. The parties are referred, as appropriate, to TBMP §§ 416.05 (Signature of Protective Order), 416.06 (Filing Confidential Materials With Board), 416.07 (Handling of Confidential Materials by Board).

The parties are advised that only confidential or trade secret information should be filed pursuant to a stipulated protective agreement. Such an agreement may not be used as

Opposition No. 150,298

a means of circumventing paragraphs (d) and (e) of 37 CFR § 2.27, which provide, in essence, that the file of a published application or issued registration, and all proceedings relating thereto, should otherwise be available for public inspection.

Under the circumstances, the opposer's motion for protective agreement is now moot.

CROSS MOTIONS TO COMPEL WRITTEN DISCOVERY RESPONSES

Upon review of the record on the cross motions to compel, the Board observes that the record is incomplete. For reasons unknown, some of the exhibits filed with the parties' briefs on their cross motions to compel are not located with the Board's proceeding records. Likewise, several certificates of service and mailing do not appear in the Board's records for these motions.

In view thereof, the parties are allowed **THIRTY** days from the mailing date set forth on this order to furnish the Board with substitute copies of the following:

1. All exhibits and declarations, if any, previously submitted on September 27, 2002 by opposer with opposer's motion to compel;
2. The certificates of mailing and certificates of service on opposer's September 27, 2002 motion to compel;
3. All exhibits and declarations, if any, previously submitted on October 16, 2002 by applicant with

Opposition No. 150,298

applicant's response brief on opposer's motion to compel;

4. All exhibits and declarations, if any, previously submitted on November 7, 2002 by opposer with opposer's reply brief on opposer's motion to compel; and,
5. The certificates of mailing and certificates of service on opposer's November 7, 2002 reply brief on opposer's motion to compel.

Opposer shall furnish copies of those papers identified above as previously filed by opposer; applicant shall furnish copies of those papers identified above as previously filed by applicant. If the parties fail to respond within the permitted time, the Board may consider only the papers presently of record when it takes up review of the cross motions to compel. The Board regrets any inconvenience caused to the parties by this resubmission of documents.

Under the circumstances, further decision on the cross motions to compel is **deferred** pending completion of the record.

OPPOSER'S MOTION TO STRIKE SURREPLY BRIEF OF APPLICANT

On December 9, 2002, opposer moved to motion to strike applicant's November 19, 2002 brief as an impermissible surreply. While it appears this motion is uncontested, the Board in this instance shall consider the motion on the

Opposition No. 150,298

merits. Generally, the Board prefers to consider the rules when assessing the propriety of striking a brief or portions thereof. Trademark Rule 2.127(a) does not authorize the filing of surreplies, e.g., papers filed in response to a reply brief on a particular motion. Accordingly, opposer's motion to strike is **granted** in part, to the extent of those portions on pages one, two and three of applicant's November 19, 2002 brief that constitute an impermissible surreply on opposer's September 27, 2002 motion to compel. The Board will give no consideration to these portions of applicant's brief.

Opposer's motion to strike is **denied** as to all other portions of applicant's November 19, 2002 brief to the extent that the concerned brief serves as a permissible reply brief on applicant's October 16, 2002 cross motion to compel.

OPPOSER'S CONTESTED MOTION FOR ORAL DEPOSITION OF FOREIGN APPLICANT

Opposer's November 12, 2002 motion for oral deposition of foreign applicant and applicant's November 25, 2002 response thereto are duly noted.

As a preliminary matter, we note that the motion concerns a discovery deposition of Dr. F. Ross Sharp, to

appear individually and as applicant's designee pursuant to notices under Fed. R. Civ. P. 30(b)(1) and (6).¹

The Board has carefully considered the parties' arguments and submissions. An exhaustive review of the arguments made by each party, and of the Board's reasons for its decisions herein would only further delay this case. As such, and in an effort to determine this pending matter as expeditiously as possible, the Board will address this motion summarily.

Ordinarily, a discovery deposition of a natural person who resides in a foreign country, and who is a party or who, at the time set for the taking of the deposition is an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(3) to testify on behalf of a party, must, if taken in a foreign country, be taken upon written questions in the manner described in Trademark Rule 2.124. See Trademark Rule 2.120(c)(1). Moreover, the Board will not order a natural person residing in a foreign country to come to the United States for the taking of his or her discovery deposition. See TBMP § 404.04(c)(1) and 520. However, the parties may stipulate, or the Board, upon motion for good cause, may order, that the deposition, when taken in a foreign country,

¹ Attached to opposer's motion is a copy of a deposition notice issued on September 23, 2002 pursuant to Fed. R. Civ. P. 30(b)(6) and Trademark Rule 2.124, which we observe was served prior to the filing date of opposer's motion to compel.

be taken by oral examination. See Trademark Rule 2.120(c)(1).

In determining whether good cause exists for a motion to take a foreign deposition orally, the Board weighs the equities, including the advantages of an oral deposition and any financial hardship that the nonmoving party might suffer if the deposition were taken orally in the foreign country. See *Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923 (TTAB 1989). See TBMP §520.

Upon consideration of the circumstances and the parties arguments on the motion, we find good cause exists for taking an oral discovery deposition of applicant's designated witness, Dr. Sharp and accordingly, opposer's motion is **granted**. To minimize the cost and burdens to applicant, applicant may elect to have the deposition taken via teleconference, rather than in person. Additionally, the re-scheduled time, date, and location for this deposition shall be subject to applicant's approval.

Notwithstanding, it is observed that there are several pending motions that the Board should address prior to commencement of this deposition. In view thereof, and in the interest of judicial economy, to promote the orderly administration of proceedings, and flowing from the Board's inherent power² to schedule disposition of the cases on its docket, we hereby **stay** further action by the parties in

² See also *Opticians Ass'n of America v. Independent Opticians of America Inc.*, 734 F. Supp. 1171, 14 USPQ2d 2021 (D.N.J. 1990), rev'd on other grounds, 920 F.2d 187, 17 USPQ2d 1117 (3d Cir. 1990).

Opposition No. 150,298

connection with Dr. Sharp's discovery deposition. See TBMP Section 510.01. The Board will notify the parties, in writing, if and when they may resume activities pertinent to the taking of the aforesaid deposition.

APPLICANT'S CONTESTED MOTION TO CONSOLIDATE

The Board notes applicant's December 10, 2002 motion to consolidate and opposer's December 18, 2002 objections filed thereto. The Board has considered the parties' arguments and again, in the interest of administrative expediency, we rule summarily as follows.

When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases. See Fed. R. Civ. P. 42(a). See also TBMP §511 and cases cited therein. Consolidation falls within the discretion of the Board. See TBMP §511. At present, we recognize that each case is proceeding at a different pace, with contested discovery and dispositive motions pending in Opposition No. 150,298. Consolidation at this time would not aid in the administrative efficiency of proceedings.

Accordingly, the Board in the exercise of its discretion hereby **denies** applicant's motion to consolidate. Note, however, the Board may, at a later date, revisit the consolidation issue *sua sponte*.

NO FURTHER PAPERS SHOULD BE FILED, WITH SOME EXCEPTIONS;
REVIEW OF APPLICANT'S MOTION TO SUSPEND DISCOVERY,
APPLICANT'S MOTION TO AMEND ITS ANSWER AND ADD A
COUNTERCLAIM, THE PARTIES' CROSS MOTIONS FOR SUMMARY
JUDGMENT, AND APPLICANT'S MOTION UNDER FED. R. CIV. P. 56(F)
DEFERRED

We observe a flurry of filings in this proceeding since the date opposer filed its motion to compel discovery responses. The parties' overlitigious conduct in this proceeding has hampered the administrative efficiency of this proceeding.

With the exception of stipulated withdrawals of any pending motion, papers in settlement of this case, papers affecting the correspondence address of the parties, or papers germane to the cross motions to compel and for summary judgment, the parties should refrain from filing any more papers in this proceeding until further written notice by the Board. See Trademark Rule 2.120(e)(2), as amended effective October 9, 1998. See Trademark Rule 2.127(d). The parties are warned that the Board may give no consideration to papers filed in violation hereof.

In addition to action on the cross motions to compel, as discussed *infra*, the Board hereby **defers** its review, evaluation, and action on applicant's December 10, 2002 motion to suspend discovery, applicant's December 10, 2002 motion to amend its answer and add a counterclaim, the

Opposition No. 150,298

parties' cross motions for summary judgment (filed by applicant on December 10, 2002 and by opposer on January 21, 2003)³, and applicant's February 5, 2003 motion under Fed. R. Civ. P. 56(f). In due course, the Board will address these motions, including any threshold timeliness issues pertinent thereto.

This proceeding otherwise remains **suspended** in accordance with the Board's January 27, 2003 order.

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³ The Board notes applicant's February 21, 2003 response to the Board's January 27, 2003 order.