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

Proceeding	91156321
Party	Defendant United States Hispanic Chamber of Commerce Foundation
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<p>In Re Application Serial No. 78/081,731 for U.S. HISPANIC CHAMBER OF COMMERCE FOUNDATION & Design</p> <p>THE CHAMBER OF COMMERCE OF THE UNITED STATES OF AMERICA,</p> <p style="text-align: center;">Opposer,</p> <p style="text-align: center;">vs.</p> <p>UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION,</p> <p style="text-align: center;">Applicant.</p>	<p>Opposition No. 91-156,321</p> <p>APPLICANT’S REPLY IN SUPPORT OF ITS MOTION TO EXTEND TESTIMONY PERIOD OR TO SUSPEND THE PROCEEDING</p>
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I. APPLICANT MET ITS BURDEN OF SHOWING GOOD CAUSE FOR THE
EXTENSION OR SUSPENSION

Applicant United States Hispanic Chamber of Commerce Foundation (“Applicant”), moved the Board for an extension of 60 days of its testimony period, or a suspension of the proceeding, to finish third-party testimony depositions that were made impossible by Opposer The Chamber of Commerce Of The United States Of America’s (“Opposer”) filing of ten unjustified motions to quash in three federal courts, four of which are still pending. Opposer responded with an opposition to Applicant’s good faith request charging that Applicant did not have good cause for an extension and including many inaccuracies. This reply is necessary to respond to Opposer’s allegations in the Opposition and to correct Opposer’s inaccurate assertions. *See Seculus da Amazonia S/S v. Toyota Jidosha Kaisha*, 66 U.S.P.Q.2d 1154, 1156, n.4 (T.T.A.B. 2003).

A. Opposer Conceded It Lacked Standing to Challenge Applicant's Third-Party Subpoenas

Opposer failed to address its lack of standing to challenge Applicant's third-party subpoenas, thus conceding the issue. The case law discussed in Applicant's motion unequivocally provides that a party in the position of Opposer cannot file a motion to quash a subpoena directed to a third party. One of the discussed cases, *In re Subpoena Served on Rum Marketing Int'l, Ltd.*, 2007 WL 2702206 at *4 (S.D. Fla. Sept. 14, 2007), goes into detail explaining the impropriety of challenging a third-party subpoena in a federal court by a party such as Opposer. Opposer presented no arguments whatsoever to address the *Rum Marketing* decision and the issues discussed there.

As to the decision of the New York court which hastily heard and decided Opposer's motion to quash, its order shows the court's misunderstanding of the facts and law – all due to the fact that Applicant was deprived of the opportunity to fully present its arguments in opposition to Opposer's motion. The court does not appear to have reviewed the statutory and case law on the issue, and in fact cited in support of its position the very statute, 35 U.S.C. § 24, which is express in its intent to confer the right to challenge a subpoena only to the parties standing in the shoes of Applicant or the subpoenaed parties. The New York court's decision is clearly incorrect and should not be relied upon by the Board.

Further, Opposer ignored the favorable to Applicant decision issued in the Eastern District of Virginia after Applicant received a full opportunity to be heard.

Opposer knew well it lacked standing to challenge Applicant's subpoenas: the above statute and the related case law are quite straightforward on that issue. Opposer also knew that its attempt to raise the subpoena issue before the Board would most certainly fail. Therefore, Opposer decided to file its motions to quash, knowing that such a move, regardless of whether it is going to succeed, would hinder Applicant's ability to obtain third-party testimonies within the small, 30-day window. These unjustified filings provide ample good cause for the requested extension.

B. Applicant's Third-Party Testimony Scheduling Was Fully Justified

The Opposition is replete with assertions that Applicant's testimony period "opened way back on July 31, 2007" and that Applicant had "*seven months* to put on its case." (Opposition at pp. 1, 2, 6, 7, 10 and 13; emphasis in original). Opposer thus accuses Applicant of waiting until the last weeks of its "seven-month" testimony period to call on its witnesses. These assertions are simply untrue.

After the parties stipulated on August 15, 2007 for a thirty-day continuance of the case schedule, Applicant was set to take its testimony depositions during the new testimony period scheduled to open on August 30, 2007 and last through the month of September 2007. Due solely to Opposer's failure to agree to a deposition schedule, Applicant was forced to yet again continue the case schedule – this time until January 30, 2008. Siding with Applicant that Opposer's failure to agree to the September 2007 deposition dates was nothing more than "maneuverings," the Board stated in its November 26, 2007 Order (emphasis added): "Petitioner's arguments in favor of consolidation lends support for registrant/applicant's statements that **its maneuverings with the objections to applicant's testimonial depositions were 'bogus' and designed to manipulate the calendar.**" In light of these facts, there is no question that Opposer's statements that Applicant's testimony period was open from July 2007 are not incorrect. It appears that Opposer is not done with its maneuvering in this case.

Similarly incorrect is Opposer's assertion that Applicant waited until the eleventh hour to schedule its depositions. As Applicant pointed out in its opening brief, Applicant served the notices of deposition of its party and party-affiliated witnesses on the first day of its testimony period, and issued third-party subpoenas eight days later. Opposer tries to make it seem like Applicant had been procrastinating until the last days of its testimony period before taking its and third-party testimony depositions. This is not true. The fact remains that Applicant had only 30 calendar days, or 22 business days, to conduct thirteen depositions. As can be seen from the third-party

deposition schedule recreated on p. 9 of the Opposition, such depositions were scheduled to last at most three hours. Therefore, scheduling several of them to be taken on the same day was fair and reasonable.

Also, contrary to Opposer's repeated and unsupported assertions in its Opposition, Applicant contacted each and every third party (and many of them, a number of times), prior to sending out the subpoenas. Understandably, many of the subpoenaed third parties were less than thrilled at the requirement to appear at a testimony deposition. However, as is apparent from the copies of the correspondence from some of them, attached as Exhibits E through I to the Opposition, the third parties were further encouraged and emboldened by the pendency of Opposer's baseless motions to quash.

Lastly, Applicant's waiting to take short third-party depositions during its testimony (rather than discovery) period was fully justified. If Applicant conducted depositions of the third parties during its discovery period, Applicant would still have to re-take the depositions during the testimony period in order to make the deposition testimony part of the record. *Fischer Gesellschaft m.b.H. v. Molnar & Co., Inc.*, 203 U.S.P.Q. 861, 867 (T.T.A.B. 1979). As the Board suggested in *Fischer*, "[t]he duplication of effort involved in taking a non-party witness's deposition twice can be avoided, in most instances, by not taking a deposition of the witness until the party's trial period opens." *Id.* Applicant's counsel, which represents Applicant in this and related cancellation proceedings *pro bono* and therefore is limited in its resources, did just that – it waited until the opening of Applicant's testimony period and promptly scheduled short depositions designed to obtain testimony regarding the third parties' use of their CHAMBER OF COMMERCE marks. Any suggestion by Opposer that Applicant was "fishing" for discovery during the depositions is preposterous – Applicant solicited testimony regarding the third-parties' use of their respective names and marks after

having conducted reasonable discovery regarding such use on its own from the publicly available sources.

C. **Opposer Failed to Inform Applicant of the Changes Made in the Deposition Transcripts by Opposer's Witnesses**

Opposer also misrepresented in its Opposition that it had provided Applicant with pages showing the changes in the deposition transcripts made by Opposer's witnesses. No such information was provided to Applicant. As stated in Applicant's motion, all that Applicant received was pages supposedly containing the changes made. Those pages, however, do not indicate whatsoever what changes were made. Applicant thus is unable to determine whether any of the changes are material. Pursuant to 37 C.F.R. § 2.125(b) (emphasis added), "[t]he party who takes testimony is responsible for having all typographical errors in the transcript and all errors of arrangement, indexing and form of the transcript corrected, on notice to each adverse party" Opposer did not comply with the rule, and misstated in its Opposition that the changes were shown to Applicant. More importantly, however, it is unfair for Applicant to wait until six days before the end of its testimony period to obtain final versions of Opposer's testimony transcripts which also do not show the corrections made by Opposer's witnesses.

D. **This Proceeding Needs to Move Forward, But Not in the Way Which Would Unfairly Prejudice Applicant**

Applicant does not generally disagree with Opposer's statement that this case needs to move forward. Opposer's eagerness is somewhat disingenuous in view of Opposer's dragging this dispute out for over five and a half years. This dispute began in 2002, when Opposer filed six requests for extension of time to oppose. After the filing of the notice of opposition, this proceeding has been extended or suspended ten times, all but twice initiated or necessitated by Opposer. Opposer should not now act incensed at Applicant's request to suspend the case for 60 days. Applicant should be allowed to complete taking its third-party testimonies that were disrupted by Opposer's

filing of its improper motions to quash. Although this case should indeed move forward, Opposer should not be rewarded for its maneuverings that so far have resulted in prejudicing Applicant's ability to put on its case. Therefore, the Board should allow the requested short extension.

E. **Opposer Failed to Show Why This Case Should Not Be Suspended Pending the Resolution of Opposer's Motions Filed in the District of Columbia Federal Court**

Opposer did not address, and therefore appears to have conceded, the issue of the suspension of this proceeding until the resolution of Opposer's four motions to quash pending in the federal district court for the District of Columbia. As of the date of this Reply, a hearing on the motions still has not been set. Thus, although the Board could suspend this proceeding pending the resolution of the motions, due to the uncertainty regarding the hearing on the motions (which may not be heard even in another 60 days), a more sensible solution would be to extend Applicant's testimony period by 60 days.

II. **CONCLUSION**

Having no standing to challenge Applicant's third-party subpoenas, Opposer nevertheless filed ten motions to quash in federal courts that have no knowledge of the Board rules, the procedural history of this proceeding, or plenary authority over it. Those filings prevented Applicant from taking all of its testimony depositions and obtaining important third-party documents that would assist in illustrating and supplementing the third parties' testimonies. Opposer should not be rewarded for its end run around the Board rules, and Applicant should be afforded additional 60 days to

finish obtaining the subpoenaed testimonies and documents.

Respectfully submitted,

Date: April 1, 2008

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CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that this correspondence is being transmitted electronically through ESTTA pursuant to 37 C.F.R. §2.195(a), on this 1st day of April, 2008.

/s/Paulette E. Surjue
Paulette E. Surjue

CERTIFICATE OF SERVICE

I hereby certify that the foregoing document has been served upon the attorney for Applicant by depositing a copy thereof in an envelope addressed to: Erik Kane, Kenyon & Kenyon, 1500 K Street, N.W., Washington, DC 20005-1257, on this 1st day of April, 2008.

/s/ Paulette E. Surjue
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