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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Butler

Mailed: April 25, 2007

Opposition No. 91156417

The Sunrider Corporation

v.

Johannes W. Raats

Before Hohein, Rogers and Bergsman, Administrative Trademark Judges.

By the Board:

In accordance with the Board's summary judgment order dated October 24, 2005, opposer's first testimony period was set to close on January 18, 2006. This case now comes up on applicant's motion, filed February 16, 2006, for involuntary dismissal and applicant's motion, filed March 2, 2006, to suspend proceedings pending disposition of his motion for involuntary dismissal. Opposer has filed a response to each motion, and applicant has replied thereto.

Suspension of proceedings

Applicant seeks suspension on the basis that his motion for involuntary dismissal is potentially dispositive of this case. In response, opposer argues that the suspension is sought by applicant solely to delay this case.

Trademark Rule 2.127(d) provides in relevant part as follows: "When any party files … any … motion which is potentially dispositive of a proceeding, the case will be suspended by the [Board] with respect to all matters not germane to the motion…." Applicant's motion for involuntary dismissal under Trademark Rule 2.132(a) is a motion which is potentially dispositive of this case.

Accordingly, applicant's motion to suspend is granted and proceedings are considered to have been suspended since February 16, 2006, the filing date of applicant's motion for involuntary dismissal.

Applicant's motion for involuntary dismissal

In support of his motion for involuntary dismissal, applicant points out that opposer's testimony period expired on January 18, 2006 and argues that opposer did not take testimony, did not file a notice of reliance, and did not file any other evidence with the Board. Applicant, however, acknowledges receipt on January 11, 2006 of "… an untimely notice of deposition of Decra Roofing Systems, Inc., a non-party to this action, to take place in California on January 17, 2006, a mere three business days later."[1] Applicant states that he objected

[1] A copy of the notice of deposition accompanies opposer's response and is discussed in more detail, *infra.* Contrary to applicant's characterization of the notice to be "of Decra Roofing Systems, Inc.," the notice is of a named individual, Wendy Teng. Decra Roofing Systems, Inc. was inadvertently referenced in the body of the notice of deposition as the "party" that would be taking the deposition.

immediately to this notice and that opposer did not respond to the objection.[2]

In response, opposer argues that applicant's motion is inappropriate because opposer timely noticed a deposition which applicant "chose not to attend." More specifically, opposer argues that it noticed a deposition on January 11, 2006 to take place six calendar days later, on January 17, 2006. Opposer states that such notice was sent to applicant by First Class mail as well as by facsimile transmission and by email on January 11, 2006. Opposer provides accompanying documentation supporting such service and notification. According to opposer, in written correspondence dated January 12, 2006,[3] applicant's counsel acknowledged receipt of the notice and indicated neither he nor his client would be attending the deposition. Opposer submitted a copy of such correspondence wherein applicant's attorney states, in part, that "[t]he notice schedules testimony … a mere two business days away. Such notice is not reasonable…. It is impossible for us or our client to attend." A copy of the correspondence submitted by opposer shows that applicant did not object at the time to the reference to the non-party, Decra Roofing Systems, Inc. Opposer contends that applicant did not otherwise request the deposition be rescheduled or be conducted

[2] Applicant, in his motion for involuntary dismissal, does not state the basis for his objection other than a general characterization of the notice of deposition as "untimely."

[3] This correspondence indicates it was sent "via facsimile" with "mail confirmation" to follow.

telephonically and further did not agree to opposer’s earlier request seeking an extension of the testimony period.[4] Opposer relies on *Duke University v. Haggar Clothing, Inc.*, 54 USPQ2d 1443 (TTAB 2000) (three days notice was found to be reasonable notice) and argues that its notice was reasonable, emphasizing that applicant was provided twice as much notice, six days. Opposer indicates that the deposition took place as noticed on January 17, 2006.[5]

Opposer acknowledges that there was an inadvertent typographical error in the body of the notice where “Decra Roofing Systems” was referenced as the party noticing the deposition. Opposer expresses its belief that the notice was not fatally deficient, however, because the notice was otherwise proper, being captioned correctly, identifying the correct proceeding number, providing the time and place for the deposition, identifying the cause or matter in which the deposition is to be used, and providing the name and address of the witness, Wendy Teng. Opposer notes that its attorney who served the notice was properly identified as “Attorney for Opposer, The Sunrider Corporation dba Sunrider International.”

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[4] In email correspondence to opposer dated December 27, 2005, after the opening of opposer’s testimony, applicant responded to opposer’s request to extend the testimony periods by stating, in part, “I personally find that the existence of the TTAB deadlines is best motivating factor to finally resolve this dispute…. Have a Happy New Year." Thus, it is apparent that applicant wished to adhere to the set schedule.

[5] In addition, opposer notes that the deposition transcript was timely served and filed on February 16, 2006. *See* Trademark Rule 2.125(a).

Further, opposer observes that applicant's attorney expressly acknowledged receipt of the notice by virtue of his response thereto the following day.

In reply, applicant argues, based on the circumstances of the case, that the notice of the deposition was not reasonable because there was a Federal Holiday extending a weekend between the date the notice was sent and the date the deposition was scheduled, making opposer's six-day notice only a three-business day notice. Applicant relies on Fed. R. Civ. P. 6(a) for purposes of calculating time under the Federal Rules, which states, in part, that "[w]hen the period of time prescribed or allowed is less than 11 days, intermediate Saturdays, Sundays, and legal holidays shall be excluded in the computation." Applicant, relying on *Duke University, supra,* argues that opposer's witness, Ms. Wendy Teng, was not identified in opposer's responses to applicant's discovery requests or at any time prior to the notice of deposition. Applicant contends that the reference to "Decra Roofing Systems" made the notice facially defective. Applicant also argues that opposer never responded to applicant's written objection to the timeliness of the notice, never offered to produce the witness telephonically, and never requested the date of the deposition be rescheduled.

Pursuant to Trademark Rule 2.132(a), "[i]f the time for taking testimony by any party in the position of plaintiff has expired and that party has not taken testimony or offered any

other evidence, any party in the position of defendant may, without waiving the right to offer evidence in the event the motion is denied, move for dismissal on the ground of the failure of the plaintiff to prosecute. The party in the position of plaintiff shall have fifteen days from the date of service of the motion to show cause why judgment should not be rendered against him. In the absence of a showing of good and sufficient cause, judgment may be rendered against the party in the position of plaintiff. If the motion is denied, testimony periods will be reset for the party in the position of defendant and for rebuttal."

As a matter preliminary to consideration of applicant's motion for involuntary dismissal, we must determine whether opposer's notice of deposition was timely and reasonable. If so, then opposer has evidence of record upon which it may rely to meet its burden of proof. If not, then judgment may be entered against opposer.

Applicant's objection to opposer's testimonial deposition on the basis that the notice was untimely

Trademark Rule 2.121(a)(1) provides, in relevant part, that "[t]he Trademark Trial and Appeal Board will issue a trial order assigning to each party the time for taking testimony. No testimony shall be taken except during the times assigned …." To the extent applicant objects to opposer's notice of deposition of Ms. Teng based on timeliness, such objection is overruled. Opposer noticed and took the deposition during its testimony

period. However, to the extent applicant's "objection" based on "timeliness" is actually an objection based on the reasonableness of the notice, such objection is discussed, *infra*.

Applicant's objections to opposer's testimonial deposition on the basis that the notice was unreasonable

Applicant objects to the reasonableness of opposer's notice of deposition on three bases: 1) opposer did not previously identify its witness; 2) the notice was facially deficient by its reference to "Decra Roofing Systems, Inc."; and 3) the number of days between the notice and the deposition should be counted in business days (three), not in calendar days (six).

Whether notice of a deposition is reasonable is determined by the individual circumstances of each case. *See Duke University v. Haggar Clothing, Inc., supra,* and cases cited therein. A brief review of the circumstances of *Duke University*, relied upon by both parties, is in order. In that decision, the Board noted that the applicant had informed the opposer that it intended to schedule depositions in early November and requested that the opposer reserve the dates of November 3-5, 1999 for depositions. The applicant, on November 1, 1999, tried to fax written notices of five depositions to the opposer but was unsuccessful. The applicant then successfully faxed the five notices the next day, November 2, 1999. Later the same day, the applicant faxed a second set of notices for four of the depositions inserting identifying information about the deponents, which implies that the first set of notices did not

include such identifying information. The first deposition was scheduled for the next day, November 3, 1999. While the Board observed that the first notice was not for the witness anticipated, it was the fact that only one day of notice was provided that made the notice unreasonable. Similarly, the opposer was given two days notice for the applicant's second and third witnesses, both employees of the applicant first identified by the notices that were the subject matter of the second fax transmission on November 2, 1999. The Board observed that one of the two days was unavailable as a preparation day because the deposition of the applicant's first witness was scheduled on that day and the other day was unavailable because it was a travel day. Thus, under the circumstances, the Board found the two days of notice unreasonable without further comment about the identification of the witnesses. The Board found the notice for the applicant's fourth witness to be reasonable because he was an employee of the applicant with whom the opposer was familiar, having been previously deposed. Under these circumstances, three days of notice was sufficient. As to the fifth witness, the Board observed that she was not one of the applicant's employees and commented that the opposer had not been previously notified that a person not employed by the applicant would be called as a witness. Specifically, while the fifth witness had been identified by name (Jennifer Rather), neither an address nor identifying information about the witness (i.e., "an employee of

applicant's counsel's law firm") had been provided in the notice of deposition. Thus, the notice for the fifth witness was found to be inadequate on its face as to the identity and address of this witness.

1. Applicant's objection that opposer did not previously identify the witness is overruled

Here, insofar as opposer was not required to identify its own witnesses in advance of trial, applicant's objection to the deposition on the basis that Ms. Teng was not identified as a witness in opposer's responses to applicant's discovery requests or prior to the notice of deposition being sent is overruled. *See* TBMP §414(7) (2d ed. rev. 2004). In addition, Trademark Rule 2.123(c) recognizes that the name of the witness need not be disclosed even in the notice if the name is unknown so long as an identifying description is provided. (" … if the name of a witness is not known, a general description sufficient to identify the witness or the particular class or group to which the witness belongs, together with a satisfactory explanation, may be given instead.")

2. Applicant's objection to the notice as facially deficient is overruled

Trademark Rule 2.123(c) provides in relevant part that "[b]efore the depositions of witnesses shall be taken by a party, due notice in writing shall be given to the opposing party or parties, as provided in §2.119(b), of the time when and place where the depositions will be taken, of the cause or matter in

which they are to be used, and the name and address of each witness to be examined…."

The Board finds that the inadvertent reference to "Decra Roofing Systems" in the body of the notice does not make the notice fatally deficient. This is so because there was enough other correct information on the face of the notice. More specifically, the notice provided the time when and place where the deposition was to take place ("Tuesday, January 17, 2006 at 8:30 a.m. at the office of Ladas & Parry, 5670 Wilshire Blvd., Suite 2100, Los Angeles, California 90036"); the cause or matter in which it was to be used (the notice is captioned correctly, identifies the correct parties, refers to the correct opposition proceeding number, identifies the mark, and identifies the application serial number, including its date of publication in the Official Gazette); and identified the name and address of the witness ("Ms. Wendy Teng," with a specified address, "Torrance, California, 90501"). In addition, the signatory to the notice was identified as "Attorney for Opposer, The Sunrider Corporation, dba Sunrider International."

Applicant clearly understood what matter was involved in the notice of deposition notwithstanding the inadvertent reference to "Decra Roofing Systems, Inc." Applicant's understanding is evidenced by his letter to opposer of January 12, 2006 expressing his belief that the notice was not reasonable, informing opposer

that he would not attend the deposition and failing to object to the "unknown party."

In view thereof, applicant's objection to the notice as facially deficient is overruled.

3. Applicant's objection to the notice as unreasonable because only three business days existed between the notice and the date for the deposition is overruled

At the outset, applicant's reliance on Fed. R. Civ. P. 6(a) is misplaced because the basic purpose of Fed. R. Civ. P. 6 is to provide general guidelines and reasonable flexibility concerning the measurement of time periods under the Federal Rules of Civil Procedure, court orders, and a number of statutes. *See* Wright & Miller, 4B Fed. Prac. & Pro. Civ.3d §1161 (2007). In contrast, Fed. R. Civ. P. 30(b)(1), applicable to discovery depositions, requires that a party seeking to take a deposition upon oral examination give **reasonable notice** (emphasis added) to every other party to the action. Similarly, Trademark Rule 2.123(c), applicable to trial testimonial depositions in Board proceedings, requires that **due** (i.e., reasonable) **notice** (emphasis added) be given to every other party.[6]

[6] The Board points out that, in court, trial testimony is taken live, while trial testimony is taken by deposition for Board proceedings. Thus, there is a fundamental difference between a discovery deposition under Fed. R. Civ. P. 30 and the Board's trial testimonial deposition governed by Trademark Rule 2.123(c) that may be taken into account when considering the circumstances to determine whether a notice of deposition is reasonable. For example, insofar as the assigned periods for taking testimony set by the Board are relatively short (30 days) compared to the assigned period for conducting discovery in an inter partes proceeding (six months), each party is effectively on notice that any of the approximately 20 business days during a typical 30-day trial period may potentially be used for the taking of testimony depositions.

In the present case, opposer's notice of six days was reasonable. The Board generally does not count only business days when assessing the reasonableness of a notice of deposition.[7] Similarly, the Board generally does not distinguish between calendar days and business days when setting other times to take action, unless the last day of the set period is not a business day.[8] For example, the parties' main testimony periods are thirty calendar days, not thirty business days. Indeed, the cases relied upon by applicant held only one or two calendar days of notice were unreasonable under the circumstances. *See Duke University, supra,* (one and two days notice unreasonable, three days notice reasonable)*; and Electronic Industries Association v. Patrick H. Potega DBA Lifestyle Technologies,* 50 USPQ2d 1775 (TTAB 1999) (two days notice not reasonable).[9] *See also Jean*

[7] Rather, as discussed earlier, the Board looks to the individual circumstances of the case. *See Duke University, supra.* Thus, a scenario could be presented in which business days and calendar days might have to be distinguished. Hypothetically, for example, if without prior discussion between the parties, a notice was sent on a Friday after business hours for a deposition to take place the Tuesday following a Saturday, Sunday and Federal holiday, the Board would be free to determine such notice to be unreasonable, accounting for the fact that the calendar days involved were not business days, because there is no expectation that the party receiving the notice would be working over a "three day weekend" which included a Federal holiday. Consequently, notice would not be received until the day of the deposition when the receiving party returned to his or her place of business.

[8] When the final calendar day of a set period does not fall on a business day but on a Saturday, Sunday or Federal Holiday, Trademark Rule 2.196 provides for an extension of the otherwise expired period to the next business day. The Rule states, "Whenever periods of time are specified in this part in days, calendar days are intended. When the day, or the last day fixed by statute or by regulation under this part for taking any action or paying any fee in the Office falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding day that is not a Saturday, Sunday, or a Federal holiday."

[9] We note that applicant has also cited *Lloyd v. Cessna Aircraft Co.,* 430 F.Supp. 25 (E.D. Tenn. 1976) in which the court refers to "working days"

Patou Inc. v. Theon, Inc., 18 USQP2d 1072 (TTAB 1990), not cited by applicant, (one day notice not reasonable). However, there are cases where, based on the circumstances presented, one or two days of notice have been found reasonable. *See Penguin Books Ltd. v. Eberhard,* 48 USPQ2d 1280 (TTAB 1998) (one day notice was found reasonable); and *Hamilton Burr Publishing Co. v. E.W. Communications, Inc.*, 216 USPQ 802 (TTAB 1982) (two days notice found reasonable).

In addition, and thanks to modern technology, applicant was notified on January 11, 2006 by email and facsimile of the notice of deposition scheduled for January 17, 2006.[10] These electronic notifications were in addition to the First Class Mail notification under Trademark Rule 2.119(b).[11] Thus, opposer provided applicant with adequate and reasonable notice of the deposition under the circumstances.

In view thereof, applicant's objection to opposer's notice of deposition as unreasonable because only three business days

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rather than "calendar days." However, in that case the court found two working days notice not reasonable notice. Here, of course, the six days notice provided by opposer included three working days.

[10] The facsimile cover sheet shows that the fax was sent before 9:30 a.m., which would have been before 12:30 p.m. for opposer.

[11] While email and facsimile notifications are not recognized for purposes of service under Trademark Rule 2.119 ("Service and Signing of Papers"), it is the Board's experience that these means of electronic communication have become routinely used by parties in Board cases. Such use is an effective means for each party to keep its adversary informed of many things, such as the status of details during the course of settlement discussions, status of discovery responses, and identifying mutually convenient dates for depositions. When used successfully, records of such electronic correspondence may be used to demonstrate circumstances bearing on the reasonableness of a notice of deposition.

existed between the notice and the date of the deposition is overruled.

Opposer's notice of deposition was timely and reasonable. Thus, the deposition that occurred on January 17, 2006 took place during opposer's testimony period and is timely. Opposer filed the transcript in accordance with Trademark Rule 2.125(a) and it is of record for trial.

Accordingly, because opposer properly made evidence of record during its testimony period, applicant's motion for involuntary dismissal for failure of opposer to make any evidence of record is denied.

Procedural comment

The Board wishes to note that the instant procedural dispute presents a close question and that alternative solutions to the apparent conflict over the scheduling of opposer's trial deposition were available to the parties and would have resulted in less delay in this case. In situations such as that presented here concerning the convenience of the scheduled trial deposition, the parties are encouraged to resolve the matter amicably. Several options are available to the parties. One is provided by Trademark Rule 2.121(a)(1) which allows testimony to be taken outside the assigned periods "… by stipulation of the parties approved by the Board, or, upon motion, by order of the Board." In addition, the Rule provides, in part, that "[t]estimony periods may be rescheduled by stipulation of the

parties approved by the Board, or upon motion granted by the Board, or by order of the Board." It is the Board's preference that in such situations the parties stipulate to such extensions, rather than file a contested motion that requires the Board's consideration. We note that in this case, applicant refused opposer's request to extend opposer's main testimony period, at a point in time when 22 days, but only 14 business days, remained in that testimony period. By refusing to agree to an extension, applicant had to know that opposer would have to utilize one or more of those 14 days to take testimony.

Another remedy available for the parties to resolve a conflict concerning the scheduling of a deposition where, for example, travel for one party is involved, is provided by Fed. R. Civ. P. 30(b)(7) which states, in part, that "[t]he parties may stipulate in writing or the court may upon motion order that a deposition be taken by telephone or other remote electronic means." *See Hewlett-Packard Co. v. Healthcare Personnel Inc.,* 21 USPQ2d 1552 (TTAB 1991) (parties may participate in TTAB testimonial depositions telephonically); and TBMP §703.01(h) (2d ed. rev. 2004). Thus, a party which is unable to attend a testimony deposition for any reason may nonetheless participate by telephone by stipulation or upon a motion.

We note that applicant has asserted that *opposer never offered* to change the date of the deposition or to utilize the telephone in taking it. Opposer, on the other hand, has asserted

that *applicant never asked* that either of these options be considered. This evidences lack of cooperation by the parties. Normally, the party asserting itself to be in a difficult position, here the applicant, should take the lead and suggest practical alternatives. If applicant had done so, any resistance by opposer to such suggestions might have weighed in the Board's evaluation of the reasonableness of the notice.[12]

If the parties are unable to resolve a scheduling conflict amicably, another option that is available is provided by Trademark Rule 2.120(i)(l), which allows a party to seek a telephone conference with a Board attorney. *See also* TBMP §502.06 (2d ed. rev. 2004). Had applicant requested a telephone conference to determine the sufficiency of the notice, he could have obtained a ruling prior to the deposition. By failing to request a telephone conference to challenge opposer's notice of deposition and deciding he would not attend the deposition, applicant assumed the risk that the transcript would nonetheless be made of record and that the testimony would be taken without

[12] The Board expects the parties to cooperate with each other during the testimony periods, as well as during discovery. To this extent, we note that in the *Duke University* case, one of the factors that led to finding that three days notice was reasonable was that early in its testimony period, applicant informed opposer that it intended to take a deposition and to reserve the dates of November 3-5, 1999 for the depositions. Keeping in mind that the determination of whether a notice of deposition is reasonable is made on a case-by-case basis, a better practice for any party seeking testimonial depositions is to identify potential dates for anticipated depositions prior to or early in the testimony period. Such party should then inform its adversary of its intent to take depositions and request that the adversary reserve specific dates by inquiring into the availability of opposing counsel, and potential witnesses, on those dates or other times during the testimony period.

cross-examination. Applicant is not without remedy, however, as he may yet call the witness during his own testimony period.[13]

Proceedings resumed

Proceedings are resumed. Discovery and opposer's initial testimony period are closed. The remaining trial dates are reset as follows:

THE PERIOD FOR DISCOVERY TO CLOSE:	CLOSED
30-day testimony period for party in position of plaintiff to close	CLOSED
30-day testimony period for party in position of defendant to close:	June 15, 2007
15-day rebuttal testimony period to close:	July 30, 2007

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.l25.

Briefs shall be filed in accordance with Trademark Rules 2.l28(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.

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[13] Applicant is reminded, though, that the trial testimonial deposition of the adverse party or a non-party, if either is unwilling to appear voluntarily, may not be taken upon notice alone. Instead, the attendance of such witnesses must be secured by a subpoena. *See* TBMP §703.01(f)(2d ed. rev. 2004).