

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3514

Mailed: 4/16/04

Opposition No. 91157636

Biomira Inc.

v.

Biomarin Pharmaceutical Inc.

Linda Skoro, Interlocutory Attorney

This case now comes up on applicant's motion for leave to take a 30(b)(6) discovery deposition orally in Canada, filed March 26, 2003. Opposer has filed a response.

Background

This proceeding was instituted on September 6, 2003. Trial dates were set and discovery was scheduled to close on March 24, 2004. No extension requests have been filed with the Board. On March 1, 2004 applicant noticed a discovery deposition of opposer under Fed. R. Civ. P. 30(b)(6) to be

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taken in Canada on March 18, 2004.<sup>1</sup> On March 11, 2004 opposer's counsel sent a letter to applicant's counsel indicating, *inter alia*, "that no person who may be designated as a 30(b)(6) witness will be present in the United States before the discovery cut off date. If an appropriate witness does become available for an oral deposition before the close of discovery, we will let you know." On March 26, 2004 applicant filed its "Motion for Leave to Take Foreign Deposition Orally".

Foreign Depositions

Trademark Rule 2.120(c), 37 CFR § 2.120(c), provides that discovery depositions of

"a party, or who, at the time set for taking the deposition, is an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6)... of the Federal Rules of Civil Procedure, shall, **if taken in a foreign country**, be taken in the manner prescribed by § 2.124 unless the Trademark Trial and Appeal Board, upon motion for good cause, orders or the parties stipulate, that the deposition be taken by oral examination."

As grounds for its good cause applicant states that it has had written discovery, but has found it to be of limited value in exploring potential channels of trade and future use of a mark in an ITU application; that cost of travel to

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<sup>1</sup> Opposer states in its response that this notice has not been served.

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Canada is less than to Europe and language is not an obstacle.

On the other hand, opposer points out that applicant has known that it is a Canadian corporation; that it had sufficient time to avail itself of the proscribed method of taking a discovery deposition of a foreign party; that travel convenience does not lessen the financial burden; and finally that discovery has now closed and no time remains for even a deposition upon written questions to be conducted.

Ordinarily, the discovery deposition of a person designated under Fed. R. Civ. P. 30(b)(6) must, if taken in a foreign country, be taken upon written questions in the manner prescribed by 37 CFR § 2.124. While the Board, upon a showing of good cause, may order that a discovery deposition be taken by oral examination in a foreign country, the Board does not find that applicant has established sufficient good cause in this instance. 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 *Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998) and *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372, 374 (TTAB 1978). See also TBMP § 404.03(b) (2d ed. Rev. 1 March 2004).

Accordingly, applicant's motion for leave to take a foreign deposition orally is hereby DENIED.

Extension of Time

In the closing sentence of its motion, applicant states "If necessary, the discovery period should [sic] reopened or extended solely to accommodate the deposition" with a footnote indicating that the parties had agreed to a thirty-day "standstill" agreement on outstanding discovery obligations. In its response, opposer states that "although the parties have agreed to extend the time period in which Opposer must respond to Applicant's outstanding discovery requests beyond the close of discovery, Opposer has not consented to a deposition outside of the discovery period."

In that there is no request to extend the discovery period before the Board, the dates remain as set in the Board's institution order of September 6, 2003. The Board hereby grants a thirty-day extension for opposer to respond to outstanding discovery requests before it.

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