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

Proceeding	91157636
Party	Plaintiff BIOMIRA, INC.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Biomira Inc.,	§	
Opposer,	§	
	§	Opposition No. 157,636
v.	§	
	§	Application Serial No. 76/240,537
Biomarin Pharmaceutical Inc.,	§	
Applicant.	§	

**Biomira’s Response in Opposition to Biomarin Pharmaceutical’s
Motion for Leave to Take Foreign Deposition Orally**

Opposer, Biomira Inc., files this response stating its opposition to the Motion for Leave to Take Foreign Deposition Orally filed by Applicant, Biomarin Pharmaceutical Inc. Because Applicant has not served a Notice of Deposition to take Opposer’s oral discovery deposition in Canada, Opposer has filed this brief in opposition to the motion instead of filing a motion to quash pursuant to TBMP § 521.

REMARKS

Applicant seeks leave to take an oral discovery deposition of Opposer’s 30(b)(6) witness in Canada pursuant to 37 CFR § 2.120(c)(1) and TBMP § 520. Opposer submits that Applicant’s motion does not contain sufficient facts or law in support of this request and respectfully asks that Applicant’s motion be denied based on the remarks contained herein.

I. Opposer is a Canadian Corporation Who Has Not Consented to an Oral Deposition

It is well established that under Rule 2.120(c) the Board will not require a party who resides in a foreign country to travel to the United States for the purposes of attending a discovery deposition. *See Jain v. Ramparts Inc.*, 49 USPQ 2d 1429, 1431 (TTAB 1998).

Discovery depositions of foreign parties are to be taken by written questions pursuant to Rule 25404262.1

2.124, unless the parties stipulate to an oral deposition or upon an order of the Board based on a motion for good cause. TBMP § 404.03(b). This rule does not distinguish between foreign parties located in North America, South America or Australia; nor does it distinguish between foreign parties who claim trade name rights, rights in a use-based or intent-to-use based application, or in a U.S. registration.

In the Notice of Opposition filed July 30, 2003, and at all times thereafter, Opposer has clearly identified itself as a Canadian corporation having a principal place of business at 2011-94 Street, Edmonton, Alberta, Canada. Additionally, the official U.S. Patent and Trademark Office record for Opposer's BIOMIRA mark, Serial No. 75/552,893, that serves as the partial basis for this opposition, also clearly identifies Opposer as a Canadian corporation located at 2011-94 Street, Edmonton, Alberta, Canada.

In fact, there exists a previous *Canadian* opposition history between the parties. In 1999, Applicant sought to register its BIOMARIN mark in Canada. In 2001, Opposer filed an opposition before the Canadian Intellectual Property Office and Applicant voluntarily abandoned its application during the opposition proceeding. Applicant has recently filed a second application for its BIOMARIN mark in Canada, albeit with a different description of goods (nearly identical to the description covered by its U.S. application that is the subject of this opposition).

In light of the history between the parties, Applicant did not just receive notice that Opposer is a Canadian corporation after it served its Notice of Deposition, or for that matter, at the time it received the Notice of Opposition. Applicant has known that Opposer is a Canadian corporation located in Alberta, Canada since at least as early as 2001 — if not before — and thus

has had sufficient time to avail itself to the proscribed method of taking a discovery deposition of a foreign party. TBMP § 404.03(b).

II. The Hardship to Opposer Would be Inequitable

In its Motion, Applicant asserts that the ease of modern transportation should influence the Board's decision to waive its own rule requiring foreign depositions to be taken by written questions. However, even with developments in modern transportation, the financial burden placed on Opposer to pay for its attorney to travel to Edmonton, Alberta, Canada would be untenable. Applicant's attorney's office is located in Chicago, Illinois. Opposer's attorneys' office is located in Washington, D.C. Travel from Washington, D.C. to Edmonton, Alberta, Canada would require a minimum of 6 to 10 hours spent either in flight or waiting for connecting flights, each way. Additionally, because of the limited number of flight times available, a two-night stay for a single discovery deposition would likely be necessary.

Applicant cites a single case, *Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ 2d 1923 (TTAB 1989), in support of its position that good cause exists for its motion for leave; however, this case supports Opposer's position in the present circumstances. The *Orion* case concerned the ability of the opposer to respond to the applicant's motion for summary judgment under Rule 56(f) of the Federal Rules of Civil Procedure. The applicant filed a motion for summary judgment based entirely on a single affidavit from the applicant's corporate secretary, located in England. In weighing the respective burdens on the parties, the Board considered the fact the attorneys for the opposer (who were seeking the foreign deposition) were located in California and would therefore have the greater hardship in traveling to England to take the deposition than the applicant's attorneys, who were located in New York City. The exact opposite is true here where the greater burden would be placed on Opposer, located in

Washington, D.C., and not Applicant, located in Chicago, which is geographically closer to Alberta, Canada.

Orion is further distinguishable because in that instance, the party seeking an oral deposition in a foreign country sought discovery in order to respond to a motion for summary judgment which could have determined the outcome of the entire opposition. *See* 12 USPQ 2d at 1924. The Board found that it would be unjust if the opposer in *Orion* was not permitted to obtain discovery on specific factual issues needed to respond to the applicant's motion for summary judgment. *Id.* at 1926. There are no like circumstances here. Applicant has availed itself three types of available discovery (interrogatories, document requests and requests for admission) and has only lately sought to orally depose Opposer.

III. Applicant's Motion is Untimely

Applicant seeks permission to take an oral foreign discovery deposition at the end of the discovery period. Discovery in this matter was opened September 26, 2003 and closed on March 24, 2004. On March 1, 2004, more than five months after the start of discovery, Applicant noticed its oral deposition of Opposer at Opposer's attorneys' Washington, D.C. office for March 18, 2003. On March 2, 2004, Opposer's attorneys notified Applicant's counsel that the Notice of Deposition sent the previous day was improper under the Rule 404.3(b) of the TBMP covering discovery depositions for foreign parties, as well as 37 C.F.R. §§ 2.120(c) and 2.124. On March 3, 2004, Applicant's attorney responded to Opposer's letter with a request that he be notified if an appropriate 30(b)(6) witness would be present in the United States prior to the close of discovery on March 24, 2004. Thereafter, on the last day of discovery, Opposer's attorneys received an email message from Applicant's attorney advising that he had filed a motion for

leave to take the 30(b)(6) deposition orally in Canada. Opposer's attorneys received a copy of that motion by first class mail on March 29, 2004.

Because the discovery period in this matter closed on March 24, 2004, any oral or written discovery deposition would take place after the close of discovery. Taking of a discovery deposition outside of the discovery period is not permitted under the Rules of the Trademark Trial and Appeal Board or the Federal Rules, unless the parties stipulate otherwise. TBMP § 403.02. *See also Rhone-Poulenc Industries v. Gulf Oil Corporation*, 198 USPQ 372, 373 (TTAB 1978) (discovery depositions must be taken during the discovery period, while responses to interrogatories may be served after the close of discovery). 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. Nor, in fact, was Opposer ever served with the proper form of deposition request, namely, a discovery deposition on written questions. Finally, even if Applicant had properly noticed a deposition on written questions on March 1, 2004, the date of its first Notice of Deposition, that deposition would still have been untimely given the time periods established for written cross questions, redirect questions, recross questions and objections established under 37 CFR § 2.124.

CONCLUSION

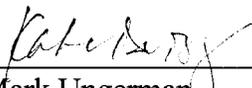
Opposer should not be penalized by Applicant's failure to timely serve a Notice of Deposition on Written Questions. Applicant has known that Opposer is a Canadian corporation located in Edmonton, Alberta, Canada since the time of the Canadian opposition between the parties in 2001. Applicant has known that this opposition was based on an intent-to-use and Section 44(e) application as well as Opposer's trade name use since the opposition was instituted

in September 2003. As such, Applicant has had ample time to avail itself of the methods established by the Board and the Federal Rules regarding discovery depositions of foreign parties and discovery matters in general.

In view of the remarks contained herein and Opposer's stated opposition to both an oral foreign deposition and a discovery deposition outside the discovery period, Opposer respectfully requests that the Board deny Applicant's Motion for Leave to Take Foreign Deposition Orally.

Respectfully submitted,

Date: April 12, 2004



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CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing "Biomira's Response in Opposition to Biomarin Pharmaceutical's Motion for Leave to Take Foreign Deposition Orally" was served upon Applicant's attorney by first class mail, postage prepaid, on this 12th day of April, 2004, as follows:

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