

ESTTA Tracking number: **ESTTA25106**

Filing date: **02/04/2005**

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

Proceeding	91159871
Party	Defendant Servicios de Franquicia Pardo's S. A. C. Servicios de Franquicia Pardo's S. A. C. Avenida Dos de Mayo 1002 PEX Lima 27,
Correspondence Address	CYNTHIA C. HENDERSON FULBRIGHT & JAWORSKI L.L.P. 801 PENNSYLVANIA AVENUE, N.W. WASHIINGTON, DC 20004-2623
Submission	Opposition/Response to Motion
Filer's Name	Cynthia C. Henderson
Filer's e-mail	chenderson@fulbright.com, wotrademark@fulbright.com
Signature	/CCH/
Date	02/04/2005
Attachments	91159871.pdf (4 pages)

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

Mario Diaz)		
)	Opposer,	
)		
v.)		Opposition No. 91159871
)		
Servicios De Franquicia Pardo's S.A.C.)		
)		
Applicant.)		

**APPLICANT'S RESPONSE TO OPPOSER'S VERIFIED EMERGENCY
MOTION FOR LEAVE TO TAKE ORAL DEPOSITION FOR USE IN
OPPOSING MOTION FOR SUMMARY JUDGMENT**

Applicant, Servicios De Franquicia Pardo's S.A.C., through undersigned counsel, submits this response to Opposer's Verified Emergency Motion for Leave to Take Oral Deposition for use in Opposing Motion for Summary Judgment. Opposer has moved to take discovery in order to respond to Applicant's Motion for Summary Judgment pursuant to Rule 56(f), Fed. R. Civ. P., 37 C.F.R. § 2.127(e)(1), and TBMP § 528.06. Applicant submits that the requested discovery is not germane to Applicant's Motion for Summary Judgment and should therefore be denied.

Pursuant to TBMP § 528.06, a party which believes it cannot effectively oppose a motion for summary judgment without first taking discovery may file a request with the Board for time to take the needed discovery. Opposer, in its motion, claims that the question of Applicant's use of the PARDO'S CHICKEN mark in the United States is relevant and a genuine issue of material fact which may defeat summary judgment. However, the issue of whether Applicant has used the mark in the United States has no relevance to the determination of priority under the General Inter-American Convention for Trademark and Commercial Protection of Washington, 1929 ("Pan American Convention).

Under Article 7 of the Pan American Convention, an owner of a mark protected in one of the contracting states has the right to oppose use and registration of an interfering mark in any of the other contracting states, and upon proof that the interfering party had knowledge of the existing and continuous use of the mark in the contracting state, may claim the preferential right to use and register such mark where the claim is being made. The material facts at issue for the Motion for Summary Judgment are: (1) whether Applicant had legal protection of the PARDO'S CHICKEN mark in Peru prior to the date Opposer adopted the name and mark PARDO'S CHICKEN and applied to register the mark in the United States; and (2) whether Opposer had knowledge of the existence and continuous use of the mark PARDO'S CHICKEN in Peru prior to using and applying to register the PARDO'S CHICKEN mark. The issue of whether Applicant has used the PARDO'S CHICKEN mark in the United States has no bearing on the grounds for the motion and is not a "material fact" which may defeat this motion for summary judgment. Accordingly, Applicant requests that the discovery be denied.

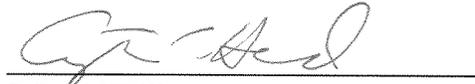
In the event that additional discovery is allowed, Applicant submits that the discovery be in the form of written interrogatories rather than by oral telephonic deposition. Pursuant to 37 C.F.R. § 2.120(c)(1), the discovery deposition of a natural person residing in a foreign country shall, if taken in a foreign country, be taken by written questions, unless the Board orders, upon motion for good cause, or the parties stipulate, that the deposition be taken by oral deposition. In determining whether good cause exists to take a foreign deposition orally, the Board will weigh the equities involved, such as the advantages of an oral deposition and any financial hardship that the nonmoving party may incur. *See, e.g., Orion Group Inc. v. Orion Group Insurance Co. P.L.C.*, 12 U.S.P.Q.2d 1923 (TTAB 1989). Applicant submits that the person to be deposed, Mr. Arnold Wu, is not comfortable communicating in the English language and as such, an oral

phone deposition would require the additional expense, time and awkwardness of a translator. Accordingly, Applicant requests that the Board deny Opposer's motion for an oral deposition rather than one on written questions.

Respectfully submitted,

SERVICIOS DE FRANQUICIA PARDO'S S.A.C.

Date: February 4, 2005 By:



J. Paul Williamson
Cynthia Henderson
Fulbright & Jaworski L.L.P.
801 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
(202) 662-0200

Attorneys for Applicant

CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing "Applicant's Response To Opposer's Verified Emergency Motion For Leave To Take Oral Deposition For Use In Opposing Motion For Summary Judgment" was served upon Opposer's attorney this 4 day of February, 2005, by first class mail, postage prepaid, as follows:

Edward M. Joffe, Esq.
Sandler, Travis & Rosenberg, P.A.
5200 Blue Lagoon Drive Suite 600
Miami, FL 33126


Selena Hamilton