

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

Mailed: April 24, 2009

Opposition No. 91162370

Opposition No. 91164615

DE BOULLE DIAMOND & JEWELRY, INC.

v.

DE BEERS LV LTD.

Cheryl Butler, Attorney, Trademark Trial and Appeal Board:

In accordance with the Board's order dated December 16, 2008 (granting opposer's consented motion, filed December 15, 2008, to extend the schedule), opposer's main testimony period closed on January 14, 2009 and applicant's testimony period was set to close on March 15, 2009. This case now comes up on applicant's fully briefed motion, filed February 20, 2009, to extend its testimony period.

In support of its motion, applicant argues that it seeks to take the deposition of Mr. Denis Boulle, opposer's CEO; that, because Mr. Boulle is an unwilling, adverse witness, applicant obtained a subpoena; that applicant has not been able to serve the subpoena successfully despite numerous attempts; and that applicant must seek relief from the federal district court which issued the subpoena in order to effect service, necessitating an extension of the testimony period in this opposition proceeding.

Applicant explains that opposer's testimony period opened once when it was set to close on July 16, 2008; that opposer took the deposition of Mr. Boulle during that earlier testimony period; that applicant attended the deposition; that direct examination took all day; and that the parties agreed to continue the deposition for another date for the purpose of cross examination. Applicant indicates that the parties then entered into settlement discussions; that complete settlement was not imminent; and that the testimony periods were again reset. Applicant states that, in preparing for its testimony period, it determined it would call two witnesses to testify, one witness being Mr. Boulle.

In response, opposer argues that applicant has not shown good cause for the sought extension because it has had ample time to conduct its cross examination of Mr. Boulle and took no steps to do so; that applicant allowed opposer's testimony period to close without reconvening the deposition for cross examination; and that applicant has not acted diligently with respect to its testimony period. Opposer characterizes applicant's motion to extend its testimony period as an attempt to have the Board enforce a subpoena. Opposer also states it is not acting in bad faith and Mr. Boulle is not evading service of process.

In reply, applicant states that it initiated a miscellaneous action in federal district court on March 18, 2009 with respect to the subpoena; that a hearing was held on March 31, 2009; and that the Court granted applicant's motion and ordered substituted

service of the subpoena on Mr. Boulle. Applicant argues it has been diligent; that it elected to call Mr. Boulle during its own testimony period rather than reconvene his deposition during opposer's testimony period for the sole purpose of cross examination; and that such a choice is permissible under Board practice.

The standard for allowing an extension of a prescribed period prior to the expiration of that period is good cause. A motion to extend must set forth with particularity the facts said to constitute good cause for the requested extension. See Fed. R. Civ. P. 6(b)(1)(A). See also *Luemme Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758 (TTAB 1999). The Board will review the facts set forth in any such motions in determining whether good cause has been shown, including the diligence of the moving party, and whether the moving party is guilty of negligence or bad faith and whether the privilege of extensions has been abused. *Id.* See also *American Vitamin Products, Inc. v. Dow Brands Inc.*, 22 USPQ2d 1316 (TTAB 1992).

If a party wishes to take the trial testimony of an adverse party (or an official or employee of an adverse party) residing in the United States, and the proposed witness is not willing to appear voluntarily to testify, the party wishing to take the testimony must secure the attendance of the witness by subpoena. If a person named in a subpoena compelling attendance at a testimony deposition fails to attend the

deposition, or refuses to answer a question propounded at the deposition, the deposing party must seek enforcement from the United States district court that issued the subpoena as the Board has no jurisdiction over subpoenas. See TBMP §703.01(f)(2) (2d ed. rev. 2004).

In this case, applicant followed the Board's procedures with respect to securing the testimonial deposition of an adverse, unwilling witness. Any matters arising with respect to service of process are properly brought before the court which issued the subpoena. The Court's order dated March 31, 2009 now resolves the parties' dispute concerning service of the subpoena. According to the order, applicant may serve Mr. Boulle by serving a re-issued subpoena Bruce Kaye, Mr. Boulle's counsel. The order specifies a street address and a facsimile number.

In this case, applicant acted appropriately in seeking a subpoena once it ascertained Mr. Boulle would not be a willing witness. Applicant did not act in bad faith by seeking to depose Mr. Boulle during its testimony period as applicant had a choice either to work with opposer to reconvene the deposition during opposer's testimony period for purposes of cross examination or to call Mr. Boulle as a witness during its own testimony period. While it is true this case has a long history, the privilege of extension has not been abused. Moreover, with respect to the activities requiring the

involvement of the district court, the Board tends to adjust its schedule as necessary.

Accordingly, applicant's motion for an extension of its testimony period is granted. 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, 2009
15-day rebuttal testimony period to close:	July 30, 2009

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 2.125.

Briefs shall be filed in accordance with Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

☼☼☼