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

Proceeding	91164280
Party	Plaintiff REGAL WARE, INC
Correspondence Address	JOSEPH A. KROMGOLZ RYAN KROMHOLZ & MANION, S.C. P.O. BOX 26618 MILWAUKEE, WI 53226
Submission	Other Motions/Papers
Filer's Name	Daniel R. Johnson
Filer's e-mail	djohnson@rkmiplaw.com, ppechulis@rkmiplaw.com
Signature	/Daniel R. Johnson/
Date	01/27/2006
Attachments	060127 motion for protective Order.pdf (13 pages)

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Attorneys for Regal Ware, Inc.

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

Regal Ware, Inc. **Opposer** **v.** **Advanced Marketing Int'l, Inc.** **Applicant**	)	Opposition No.:91164280 Atty. Docket No. :9513.18067-LIT

OPPOSER'S MOTION FOR A PROTECTIVE ORDER

Regal Ware, Inc. (Opposer), by its attorneys, Ryan Kromholz & Manion, S.C. by Joseph A. Kromholz, and Daniel R. Johnson, hereby move, pursuant to Fed.R.Civ.P. 26(c)(1), for a protective order prohibiting Advanced Marketing Int'l, Inc. (AMI) from taking the deposition of Regal Ware, Inc.'s outside counsel. The bases for this motion are set forth below.

A PROTECTIVE ORDER IS REQUIRED TO PREVENT THE DEPOSITION OF ATTORNEY JOHN MANION FROM PROCEEDING

a. Factual Background

AMI has noticed the deposition of Attorney John Manion of Ryan Kromholz & Manion, S.C., Regal Ware's outside counsel. *See* Exhibit A, attached. Attorney Manion is trademark counsel for Regal Ware and has been involved in this case. AMI would like to depose Attorney Manion regarding an alleged voicemail message he left for Ms. Lori Milvain, AMI's outside counsel. *See* Exhibit B, attached. AMI has failed to produce a recording of the alleged voicemail, despite being asked repeatedly to do so. *See, e.g.,* Exhibit C, attached.

AMI apparently believes that this voicemail constitutes some type of assignment of Regal Ware's trademark rights in Regal's WHERE CRAFTSMEN STILL CARE mark, yet AMI has no written evidence of any assignment of trademark rights regarding this mark.

Ms. Milvain represented to Regal Ware that she had saved a tape of this alleged voicemail. *See* Exhibit D, attached. However, when asked to provide a copy of the tape, Ms. Milvain failed to do so.

As required by Fed.R.Civ.P. 26(c) counsel for Regal Ware conferred with counsel for AMI on January 19 and January 26, 2006 in an attempt to resolve this dispute without Board involvement. However, AMI demanded that the deposition proceed, necessitating this motion. *See* Exhibit E, attached.

b. Legal Standards

For good cause shown, the Board "may make any order which justice requires to protect a party or person from annoyance, embarrassment, oppression, or undue burden or expense." Fed.R.Civ.P. 26(c). Such orders may include completely prohibiting certain discovery or imposing a designated method by which discovery must be conducted. Fed.R.Civ.P. 26(c)(1) and (3). In this case, it is requested that the board completely prohibit the deposition of Attorney Manion.

In Shelton v. American Motors Corp., 805 F.2d 1323, 1326 (8th Cir. 1986), the Court held that depositions of opposing counsel should be limited to those circumstances when the party seeking to take the deposition has shown that: (1) no other means exist to obtain the information except to depose opposing counsel; (2) the information sought is relevant and non-privileged; and (3) the information is crucial to the preparation of the case. *Id.* The burden is on the party seeking the deposition to establish that the criteria are met – in this case AMI. *Id.*

c. Analysis

In this case, AMI cannot even attempt to meet the Shelton criteria. First, Ms. Milvain represented that she indeed had the alleged recording. If this were true, then there certainly are other

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means that exist to obtain the information without deposing Attorney Manion, namely by producing the recording she stated she had.

Second, the information sought is not relevant. No statement based upon a purported recording can be admitted when the recording itself cannot be produced. The contents of a recorded conversation cannot be admitted into evidence where the foundation for admission is "clearly insufficient to insure the accuracy of the recording." *See, e.g.*, United States v. Jones, 730 F.2d 593, 597 (10th Cir. 1984). AMI never produced the original recording. To prove the content of a recording, the **original** recording is **required**. FRE 1002. AMI cannot authenticate the contents of the alleged original recording. FRE 1003. Therefore, any testimony by Attorney Manion would be entirely inadmissible without the original recording as an evidentiary foundation.

Third, the information is not crucial to the preparation of the case. Because assignments of trademark rights must be in writing, 15 U.S.C. § 1060, and in this case there is nothing in writing, there could not have been a transfer of Regal Ware's rights in the mark. So even if Attorney Manion testified that Regal Ware called AMI and wanted to donate the mark to AMI, this evidence would be insufficient to constitute an assignment as AMI would hope. Regal Ware would still own the trademark unless and until a written transfer of trademark rights took place. Therefore, any testimony by Attorney Manion on this subject is entirely irrelevant without written documentary evidence of any transfer of Regal Ware's rights.

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II. Conclusion

The burden is on AMI to establish that the criteria are met for taking a deposition of opposing counsel. AMI cannot possibly meet this burden and therefore a protective order barring Attorney Manion's deposition must issue.

Respectfully submitted:

Date: January 27, 2006

Ryan, Kromholz & Manion, S.C.

By: /Daniel R. Johnson/

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Attorneys for Regal Ware, Inc.

Michael J. Furbush, Florida Bar. No.:070009
Lori T. Milvain, Florida Bar. No.: 0116660
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Attorneys for Advanced Marketing Int'l, Inc.

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

REGAL WARE, INC., Opposer, v. ADVANCED MARKETING INT'L, INC. Applicant.	Opposition No.: 91164280 Atty. Docket No.: 9513.18067-LIT

NOTICE OF DEPOSITION

Please take notice that, pursuant to Federal Rule of Civil Procedure 30 and the relevant regulations of the United States Patent and Trademark Office, Applicant, through its attorneys, Gronek & Latham, LLP, will take the deposition of John M. Manion at the offices of Ryan Kromholz & Manion, 3360 Gateway Road, Brookfield, WI 53045, beginning at 2:00 p.m., on Monday, January 30, 2006. The testimony shall be recorded by stenographic means.

Respectfully submitted:

Date: January 19, 2006 GRONEK & LATHAM, LLP

By: Michael J. Furbush

Michael J. Furbush, Esquire
Lori T. Milvain, Esquire
Gronek & Latham, LLP
390 N. Orange Avenue, Suite 600
Orlando, FL 32801
Attorneys for Advanced Marketing Int'l, Inc.

EXHIBIT A

GRONEK & LATHAM, LLP

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January 26, 2006

VIA FACSIMILE (262) 783-1211 AND U.S. MAIL

Daniel Johnson, Esq.
Ryan Kromholz & Manion, S.C.
P.O. Box 26618
Milwaukee, WI 53226

Re: *Opposition No. 91164280 filed on behalf of Regal Ware, Inc. against Advanced Marketing Int'l., Inc.*

Dear Mr. Johnson:

I received your letter dated January 25, 2006, regarding our Notice of Taking Deposition under Federal Rule of Civil Procedure 30(b)(6). The notice is not invalid. Under Rule 30(b)(6), a corporation may be deposed in one of two ways. The party taking the deposition may either describe the matters on which examination is requested or permit the corporation to designate a representative to testify on its behalf, or it may designate a particular officer, director, or managing agent to testify on behalf of the corporation. Either method is equally permissible under the rules.

Furthermore, in your letter dated January 13, 2006, you specifically stated that David Beine would be your client's corporate representative for the purposes of taking the deposition. We did not just draw his name out of a hat.

Accordingly, your objections are untenable, and any motion for protective order would be frivolous on its face. Please confirm that you will be withdrawing your objections so that we may proceed with the taking of the deposition.

In addition, we intend to proceed with the deposition of Mr. Manion. If you do not want to cooperate with the deposition we will subpoena him. The purpose of the deposition is to

EXHIBIT B

GRONEK & LATHAM, LLP

discuss the voicemail message he left for my partner, Lori Milvain, so there are no privilege issues. I expect the deposition will take less than one hour.

Please let me know how you intend to proceed.

Sincerely,

Michael Furbush

cc: Lori T. Milvain, Esq.

RYAN KROMHOLZ & MANION, S.C.

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23 March 2005

Michael J. Furbush, Esq.
Gronek & Latham, LLP
390 North Orange Avenue
Suite 600
Orlando, FL 32801

VIA FACSIMILE AND US MAIL

Re: Opposition No. 91164280

Dear Mr. Furbush:

We respond to the substantive issues raised in your 23 March 2005 letter.

Ms. Milvain brought a sanctions motion. Ms. Milvain represented in her 22 March 2005 letter that she had an actual recording of the alleged statement of Mr. Manion. Clearly, this was not true.

Since you admit that you do not have the evidence that Ms. Milvain represented she had, it is clear there is no basis for any motion under Rule 11. Immediately withdraw your motion.

It is irrelevant whether or not Mr. Manion made such a statement since Regal Ware could withdraw its consent at any time and it is abundantly clear that Regal Ware does not consent.

At the time your client applied for its registration, it knew about Regal Ware's trademarks and did not bring them to the attention of the Patent and Trademark Office. Your client made a false statement under oath when it did not identify Regal Ware's trademark in its application to the Patent and Trademark Office.

EXHIBIT C

I strongly suggest that your client abandon its application.

Sincerely,
RYAN KROMHOLZ & MANION, S.C.

By:

Joseph A. Kromholz

JAK/pjp

CC: Regal Ware, Inc.

GRONEK & LATHAM, LLP

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March 21, 2005

VIA FACSIMILE (262) 783-1211 AND U.S. MAIL

Joseph A. Kromholz, Esq.
Ryan Kromholz & Manion, S.C.
P.O. Box 26618
Milwaukee, WI 53226

MAR 2 4 2005

Re: Opposition No. 91164280 filed on behalf of Regal Ware, Inc. against Advanced Marketing Int'l., Inc. - ***Rule 11 Notification***

Dear Mr. Kromholz:

As you know, this firm represents Advanced Marketing Int'l., Inc. ("AMI") with regard to its intellectual property matters. You recently filed an opposition against my client's trademark application for the mark, WHERE CRAFTSMEN STILL CARE, for cookware and other goods.

This letter is being written to put you on notice of the authorization granted to the undersigned by your partner, John Manion, on January 29, 2004, regarding AMI's use and registration of the trademark, WHERE CRAFTSMEN STILL CARE. A typed transcript of the authorization was previously sent via facsimile to David Beine, counsel at Regal Ware, Inc. A duplicate copy is enclosed for your reference. Despite our proof, in the form of a taped voice-mail message, that Mr. Manion consented on behalf of Regal Ware, Inc. to AMI's application and registration of WHERE CRAFTSMEN STILL CARE, you have filed the above-referenced opposition proceeding. In light of Mr. Manion's previous consent, this opposition is being brought against AMI by your client for the sole purpose of harassing AMI and delaying the processing of its trademark application.

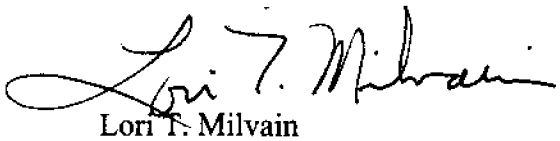
As I am sure you can imagine, it would be very embarrassing for a judge or a decision maker at the Trademark Trial and Appeal Board to hear your partner's voice granting my client permission (and giving his assurances that your client would enter into

EXHIBIT D

a consent agreement if the U.S. Patent and Trademark Office cited your client's mark against my client), while reviewing the Opposition proceeding subsequently filed by your firm.

In accordance with Rule 11 of the Federal Rules of Civil Procedure and Section 527.02 of the Trademark Trial and Appeal Board Manual of Procedure, we hereby demand that you withdraw the opposition proceeding against AMI within thirty (30) days of the date of this letter. Failure to do so may subject you and your client to Rule 11 sanctions.

Very truly yours,



Lori T. Milvain

LTM:bpm
Enclosure
cc: Advanced Marketing Int'l., Inc.

RYAN KROMHOLZ & MANION, S.C.

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January 19, 2006

Michael J. Furbush, Esq.
Gronek & Latham, LLP
390 North Orange Avenue
Suite 600
Orlando, FL 32801

Re: Opposition No. 91164280

Dear Mr. Furbush:

We are in receipt of your Notice of Deposition of Attorney John Manion. I write pursuant to Fed.R.Civ.P. 26(c) and request that you withdraw your Notice so that I do not have to file a Motion for a Protective Order. First, the Notice is invalid as Attorney Manion is not a party. Second, Attorney Manion represents Regal Ware and thus the Notice is improper. Please notify me whether you will be withdrawing the Notice.

Sincerely,
RYAN KROMHOLZ & MANION, S.C.

By: Daniel R. Johnson

DJ

EXHIBIT E

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Regal Ware, Inc. Opposer v. Advanced Marketing Int'l, Inc. Applicant	))))))))	Opposition No.:91164280 Atty. Docket No. :9513.18067-LIT

CERTIFICATE OF SERVICE

I hereby certify that a true copy of Opposer's Motion for Protective Order has been served on the following attorney of record by Facsimile and First Class Mail Addressed as follows:

Michael Furbush, Esq.
Gronek & Latham, LLP
390 North Orange Avenue
Suite 600
Orlando, Florida 32801

This 27th day of January 2006.

/Peggy Pechulis/
Peggy Pechulis
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