

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

Mailed: April 23, 2010

Opposition No. 91164764

Brink's Network, Incorporated

v.

The Brinkmann Corporation

Jennifer Krisp, Interlocutory Attorney:

This proceeding is before the Board for consideration of 1) opposer's motion (filed October 1, 2009) to compel discovery deposition of Mr. J. Baxter Brinkmann, and 2) opposer's motion (filed December 21, 2009) to enforce suspension of proceedings. The motions have been fully briefed.

Opposer's motion to compel

Opposer seeks an order compelling applicant to produce for discovery deposition Mr. J. Baxter Brinkmann, President of applicant, and identified by applicant in response to opposer's Interrogatory No. 24 as a witness whose testimony applicant intends to present during its testimony period in this proceeding.¹ Opposer requests that applicant be required to produce Mr. Brinkmann for said deposition at a mutually agreeable location in Washington, D.C., the location of

¹ Opposer's motion includes a copy of Interrogatory No. 24 and applicant's response thereto.

The Board, in the exercise of its inherent authority to manage cases on its docket, considers the motion notwithstanding that it was filed during the time allowed for completion of the application divisional process. See TBMP § 510.01 (2d ed. rev. 2004).

opposer's counsel, "(D)ue to the continued pattern and practice of delay demonstrated by Applicant in connection with the deposition."²

A review of opposer's motion and documents in support thereof indicates that applicant identified Mr. Brinkmann as a witness on or about May 26, 2009, and that opposer informed applicant two days later of its desire to be informed of proposed dates on which opposer could depose Mr. Brinkmann. Opposer thereafter renewed its inquiry twice during June of 2009, and again during July of 2009. Applicant's repeated response to such inquiries was a general reply, essentially that proposed dates for the deposition would be forthcoming. In August, opposer noticed Mr. Brinkmann's deposition for October 6, 2009, sought confirmation of his availability for that date, and was informed by applicant six weeks after said notice that Mr. Brinkmann was unavailable for October 6, 2009, and that applicant desired to schedule the deposition for the same location (Dallas, Texas) as the depositions of other witnesses. Opposer requested applicant's confirmation of a rescheduled deposition date of October 14, 2009, to which applicant indicated that it could not respond, and for which it did not provide alternative dates. Opposer characterizes applicant's conduct surrounding opposer's efforts to secure the deposition of Mr. Brinkmann as a "continued pattern of refusal to cooperate."

² The Board notes that opposer, in its reply brief, withdrew its request for an order requiring applicant to supplement its discovery responses.

Applicant responds that it is opposer who has been uncooperative and that opposer has no basis on which to require the deposition to take place in Washington, D.C. Applicant states that opposer unilaterally chose the October 6, 2009 and October 14, 2009 deposition dates, and that applicant never agreed to said dates. Applicant further argues, inter alia, that Mr. Brinkmann has never refused to appear for his deposition, and that upon noting Mr. Brinkmann's unavailability for deposition on October 6, 2009, it informed opposer of its preference to schedule said deposition so as to coincide with the depositions of other individuals residing in the Dallas, Texas area.

With respect to the movant's compliance with Trademark Rule 2.120(e)(1), in support of its motion, opposer includes a series of May, 2009 through July, 2009 electronic mail communications between counsels, as well as the declarations of opposer's counsel and of a case manager for said law firm. The contents of these materials demonstrate that opposer made a good faith effort, through communication and conference with applicant's counsel, to resolve the issues it brings before the Board, and thus has complied with Trademark Rule 2.120(e)(1).

The record reveals conduct on applicant's part which is questionable and which, indeed, fails to demonstrate the level of cooperativeness that the Board expects of parties to inter partes proceedings, particularly in view of the fact that the problematic conduct centers on the primarily administrative objective of scheduling a deposition. See TBMP § 408.01 (2d

ed. rev. 2004). The Board notes opposer's repeated specific attempts to schedule Mr. Brinkmann's deposition, attempts which span from May 28, 2009 through September 28, 2009, as well as applicant's failure to promptly reply to such requests and/or to provide any firm dates for the individual's availability or explanation for his unavailability. Under these conditions, and given opposer's desire to adhere to the discovery and trial schedule set by the Board, it was not unreasonable for opposer to finally settle on and to notice a date certain on which it planned to take the deposition at issue. Opposer cannot be faulted for taking reasonable and necessary steps to secure the discovery to which it is entitled during the time allotted therefor. Applicant's uncooperativeness during the 2009 timeframe at issue, with respect to the rather straightforward task of scheduling the deposition of its President, is on record in this proceeding by way of opposer's motion and the instant order.³

Nevertheless, the circumstances presented do not rise to the level of sanctionable conduct, and thus do not warrant the Board's imposition of an order which procedurally deviates from the provisions of Trademark Rule 2.120(b), which provide that

³ While applicant states that it remained "flexible" with respect to the deposition date, applicant's failure to provide potential dates, when asked repeatedly for such information, simply does not support its contention. Moreover, applicant's assertion that Mr. Brinkmann "has never, at any time, refused to appear for his deposition" is unpersuasive and highly disingenuous in view of the fact that said deposition was never collaboratively scheduled due to applicant's own conduct.

the deposition of Mr. Brinkmann shall be taken in the Federal judicial district where he resides or is regularly employed.

Accordingly, opposer's motion to compel the deposition of Mr. Brinkmann is hereby granted to the extent that **1)** applicant is directed to provide to opposer, within fifteen (15) days of the mailing date of this order, at least three (3) firm proposed dates, each being within the forty-five (45) day period following the mailing date of this order, on which Mr. Brinkmann will be available for his entire deposition; and **2)** said deposition shall take place in the Federal judicial district where Mr. Brinkmann resides or is regularly employed, or any place on which the parties agree by stipulation. See Trademark Rule 2.120(b).

Opposer's motion to enforce suspension of proceedings

Opposer seeks an order directing applicant to refrain from compelling the discovery deposition of and production of documents by non-party Hampton Products International Cooperation ("Hampton"), pursuant to a subpoena obtained by applicant and issued by the U.S. District Court for the Central District of California ("District Court") on August 10, 2009 under 35 U.S.C. § 24, until determination of opposer's instant motion to compel the discovery deposition of applicant's President, Mr. Brinkmann. Opposer requests an order indicating that "an appropriate sanction will be imposed" on applicant if applicant files any motion in the District Court seeking to compel discovery pursuant to said subpoena, before the Board decides opposer's instant motion to compel and directs that

proceedings are resumed. Opposer makes the request on the basis that, under Trademark Rule 2.120(e)(2), the filing of the motion to compel suspended proceedings, tolled Hampton's obligation to respond to outstanding discovery, and thus precluded the deposition and discovery which applicant seeks by way of subpoena.

Applicant responds, inter alia, that the Board has no jurisdiction over the enforcement of the District Court subpoena, that opposer has no standing to bring its motion to enforce suspension, and that compliance with the subpoena is not tolled under Trademark Rule 2.120(e)(2) inasmuch as the Rule is silent with respect to a non-party's obligations.

In a Board proceeding, where a proposed deponent residing in the United States is not a party thereto, the responsibility to secure his or her attendance rests wholly with the deposing party. Trademark Rule 2.120(b). If a deposing party must secure attendance by subpoena pursuant to 35 U.S.C. § 24 and Fed. R. Civ. P. 45, the subpoena must be issued from the U.S. district court in the Federal district where the deponent resides or is regularly employed, and the deposing party must seek the enforcement of said subpoena from the District Court that issued the subpoena. The Board is an administrative tribunal which has limited jurisdiction. The Board has no jurisdiction over depositions of third parties by subpoena, and thus proceedings relating to the depositions of subpoenaed non-parties are within the control of the district court. See *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1304 n.3 (TTAB

1987). See also *Touch Tel Corp v. AirTouch Communications*, 41 USPQ2d 1541, 1542 n.4 (TTAB 1996); TBMP § 404.03(a)(2) (2d ed. rev. 2004).

The district court having jurisdiction over a subpoena has the power to enforce a subpoena against a non-party witness, and a party seeking to enforce a subpoena against a non-party must return to the court with jurisdiction over the subpoena. See, e.g., *HighBeam Marketing, LLC v. Highbeam Research, LLC*, 85 USPQ2d 1902, 1906 (TTAB 2008). No provision or exception is in place which provides the Board with the authority to interfere with this power, or to take this power from the district court, by way of enforcing the procedural posture of a Board proceeding.

Accordingly, opposer's motion to enforce suspension of proceedings is hereby denied.

Schedule

Proceedings are resumed.⁴ Opposer is allowed until thirty (30) days from the mailing date of this order in which to file its answer to the counterclaims (filed on August 26, 2009) to cancel opposer's pleaded Registration Nos. 529622,⁵ 1412587 and 1411610.

⁴ It is noted that the Office's divisional process, dividing application Serial No. 76483115, is complete.

⁵ The Office's finance records indicate that the required fee for cancellation of Registration No. 529622, which applicant authorized by way of deposit account, has not been associated with that registration. The Office will correct this in due course.

Remaining discovery and trial dates are reset as indicated below:⁶

THE PERIOD FOR DISCOVERY TO CLOSE:	7/2/2010
Testimony period for plaintiff in the opposition to close:	9/30/2010
Testimony period for defendant in the opposition and as plaintiff in the counterclaim to close:	11/29/2010
Testimony period for defendant in the counterclaim and its rebuttal testimony as plaintiff in the opposition to close:	1/28/2011
Rebuttal testimony period for plaintiff in the counterclaim to close:	3/14/2011
Briefs shall be due as follows: [See Trademark Rule 2.128(a)(2)].	
Brief for plaintiff in the opposition shall be due:	5/13/2011
Brief for defendant in the opposition and as plaintiff in the counterclaim shall be due:	6/12/2011
Brief for defendant in the counterclaim and its reply brief (if any) as plaintiff in the opposition shall be due:	7/12/2011
Reply brief (if any) for plaintiff in the counterclaim shall be due:	7/27/2011

⁶ Any motion to suspend or extend these dates must set forth an

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 Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

appropriate proposed trial and briefing schedule.