

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

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Mailed: May 27, 2009

Opposition No. 91173105

Honda Motor Co., Ltd.

v.

Michael Dalton

By the Board:

This proceeding is before the Board for consideration of the following: (1) applicant's motion (filed March 6, 2009) to strike the trial testimony of Cyndee Mangham; (2) applicant's motion (filed March 10, 2009) to strike the discovery deposition of applicant, Michael Dalton; and (3) applicant's motion (filed March 11, 2009) to dismiss this proceeding under Trademark Rule 2.132(a). The motions are fully briefed.

Motion to strike trial testimony of Cyndee Mangham

Applicant moves to strike the trial testimony, and exhibits, of Cyndee Mangham, taken on September 16, 2008, asserting that such testimony is untimely on the ground that it was taken outside of opposer's assigned testimony period.

In response, opposer argues that (1) its testimony period opened July 28, 2008, and by the Board's August 20, 2008 order remained open and extended until the testimony period closing date noted on said order, namely, October 27, 2008; and (2) opposer, "(0)ne week following the Board's order ... provided

Applicant with reasonable notice that Ms. Mangham's deposition had been rescheduled to September 16, 2008."

The pertinent rule of procedure, Trademark Rule 2.121(a), states, in pertinent part,

The Trademark Trial and Appeal Board will issue a trial order setting a deadline for each party's required pretrial disclosures and assigning to each party its time for taking testimony. No testimony shall be taken except during the times assigned, unless by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board.

Accordingly, a party may not take testimony outside of its assigned testimony period, except by stipulation of the parties approved by the Board, or on motion granted by the Board, or by order of the Board. See TBMP § 707.03(b)(1) (2d ed. rev. 2004).

An objection to a testimony deposition must be raised promptly if the defect is one that can be obviated or removed, failing which it is waived. See TBMP § 707.03(a) (2d ed. rev. 2004). When a testimony deposition is noticed for a date prior to the opening of the deposing party's testimony period, an adverse party that fails to promptly object to the scheduled deposition on the ground of untimeliness may be found to have waived this ground for objection, because the premature scheduling of a deposition is an error which can be corrected on seasonable objection. See TBMP § 707.03(b)(1) (2d ed. rev. 2004). *Cf. Of Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555, 1556 n.2 (TTAB 1991).

In the instant proceeding, by operation of the Board's August 20, 2008 order, and as restated in the Board's December 17, 2008 order granting the parties' December 1, 2008 stipulated motion, opposer's 30-day testimony period had been reset to close on October 27, 2008. Opposer's testimony period thereby opened September 28, 2008, and continued until October 27, 2008.¹ The record and briefs on motion confirm that the trial deposition of Cyndee Mangham was noticed by opposer on August 27, 2008, and was taken on September 16, 2008 as noticed,² a date prior to the opening date of opposer's testimony period, as reset. Applicant states in his brief that he did not participate in this testimony deposition, and applicant has not demonstrated that he interposed a timely objection thereto.

Opposer's scheduling and notice of its testimony witness deposition to take place on a date that was prior to the September 28, 2008 commencement of its testimony period constitutes an error or oversight which could have been addressed and corrected on seasonable objection. Accordingly, under these circumstances applicant is found to have waived any objection to the trial deposition in question on the grounds of alleged untimeliness.

¹ Opposer is mistaken in its argument that the Board's resetting of its testimony period did not reset the date on which opposer's testimony period commenced. As each of the Board's orders indicate, the testimony period, both as originally set and as reset, comprised thirty (30) days.

² Opposer filed under notice of reliance the transcript thereof, and accompanying exhibits, on October 27, 2008.

In view thereof, the trial testimony of Cyndee Mangham is properly of record, and applicant's motion to strike the trial testimony and exhibits thereto is hereby denied.

Motion to strike discovery deposition of Michael Dalton

In this motion, applicant seeks to strike the discovery deposition, and exhibits, taken of him on May 5, 2008, for failure to comply with the Trademark Rules of Procedure. In particular, applicant asserts that opposer "failed to provide the required reading within thirty days of taking the deposition and continued failing to provide the reading while submitting the transcript for admission during their testimony period." Applicant further asserts that he did not waive a right to a reading and signing of the transcript, and submits in support thereof the affidavit of Jonathan P. Dameron, an attorney who "assisted" applicant at the deposition in which Mr. Dalton was deposed by opposer, stating therein that neither he nor Mr. Dalton waived Mr. Dalton's right to review and sign the deposition transcripts.³ Applicant further argues that opposer's counsel was aware that applicant requested that he be notified, by the officer before whom the deposition was taken,

³ Applicant's assertion in his brief that he "therefore did not have the deposition available for the filing of a summary motion prior to the Opposer's testimony period" is irrelevant and misplaced inasmuch as the citations thereto, Trademark Rules 2.127(e)(1) and 2.127(e)(2) govern the filing of a motion for summary judgment, no such motion is at issue in this proceeding, and any such motion was required to have been filed prior to the commencement of the first testimony period as originally set or, as in this case, as reset. See Trademark Rule 2.127(e)(1). Similarly, applicant's reliance on Trademark Rule 2.125(b), Rule 2.123(e)(5), and other provisions is misplaced.

when the transcript became available, and that applicant be permitted to review it.

In response, opposer asserts that (1) Mr. Dalton's discovery deposition was taken during the discovery period and was thereafter properly offered into evidence through opposer's notice of reliance pursuant to Trademark Rule 2.120(j); and (2) there is no rule requiring that a discovery deposition transcript be first signed before it is offered into evidence under a notice of reliance filed by an adverse party.

The discovery deposition of a party may be offered in evidence by an adverse party. See Trademark Rule 2.120(j)(1). Such a discovery deposition may be offered in evidence and made of record by filing, during the testimony period of the offering party, the deposition or any part thereof with any exhibit(s) to the part that is filed, together with a notice of reliance. See Trademark Rule 2.120(j)(3)(i).

Opposer is correct in stating that no rule of procedure obligates a party who has taken a discovery deposition to provide a copy of the transcript thereof to an adverse party for review prior to the filing of a notice of reliance, and that no rule requires a court reporter or person acting in that capacity to provide such a copy. Moreover, Trademark Rule 2.120(j)(6) does not operate to place such a mandate on a party seeking to make of record a discovery deposition. As a practical matter, under the circumstances here, it is ultimately a party's responsibility to secure a copy of a discovery deposition, and the fact that applicant here

"requested that he be notified, by the officer, that the transcript was available" to permit applicant's review thereof does not place or shift this burden to opposer or to the officer or reporter who took the deposition.

In view thereof, the discovery deposition of Michael Dalton is properly of record, and applicant's motion to strike is hereby denied.

Motion to dismiss

In its third motion, applicant seeks an order dismissing this proceeding, asserting that, "(U)pon the granting of the pending strike motions, the plaintiff should be deemed to have failed to prosecute and defendant is entitled to his motion to dismiss."⁴

Trademark Rule 2.132(a) provides for the involuntary dismissal of a proceeding before the Board for an opposer's failure to prosecute its case. In particular, that Rule states that, if the time for taking testimony by opposer has expired and opposer has not taken testimony or offered any other evidence, applicant may, without waiving the right to offer evidence in the event the motion is denied, move for dismissal on the ground that plaintiff has failed to prosecute its case.

⁴ Applicant's assertion, in its reply brief in support of its motion to dismiss, that appears to reargue or augment its earlier motion to strike by stating that opposer's notice of deposition of Cyndee Mangham "lacks the proper certificate of service" because the date of service is not indicated thereon, has not been considered, is untimely, and furthermore is unpersuasive. The assertion is not directly germane to the motion to dismiss under Trademark Rule 2.132(a), and any valid procedural objection which could be found to have been included in such assertion is an objection that could have been remedied at a prior point in time, and has thus been waived.

Inasmuch as applicant's motion to strike trial testimony and motion to strike its deposition have been denied on the merits thereof, respectively, the record in this case is not devoid of testimony and other evidence that has been introduced by opposer in support of its case.⁵

Accordingly, applicant's motion to dismiss pursuant to Trademark Rule 2.132(a) is hereby denied as moot.

Schedule

Opposer's testimony period is closed. In view of the passage of time during the briefing of the three motions addressed herein, and so as to avoid potential prejudice to either party, the remaining testimony periods in this proceeding are hereby reset as indicated below:

30-day testimony period for party in position of defendant to close: **07/31/09**

15-day rebuttal testimony period to close: **09/14/09**

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.

⁵ It is noted that opposer, by way of its notice of reliance, also introduced, for example, applicant's answers to opposer's first set of interrogatories and first request for admission, and various publications. Thus, the record clearly does not indicate a failure to prosecute.

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.

NEWS FROM THE TTAB:

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:
<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:
<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>