

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

Mailed: May 18, 2009

Opposition No. 91175319

Intuitive Surgical, Inc.

v.

DaVinci Radiology Associates,
P.L.

Linda Skoro, Interlocutory Attorney

On May 7, 2009 opposer filed a notice of taking a deposition upon written questions of one of its witnesses. On May 15, 2009 applicant objected to and moved to strike the notice and further requested that opposer be made to take the deposition orally, should the motion to strike be denied.¹

Trademark Rules 2.123(a)(1) and 2.124(b)(1) provide for the taking of depositions on written questions. It also allows for an adverse party to file, within fifteen days from the date of service of the notice, a motion for good cause, for an order that the deposition be taken by oral examination. Also, the rules state that the notice of the taking of a deposition on written questions is to be

¹ Applicant need only have filed a motion, for good cause shown, for an order that the deposition to taken by oral examination pursuant to Trademark Rule. 2.123(a)(1).

requested within ten days of the opening of the moving party's testimony period.²

In this case, the witness opposer seeks to depose is in the United States. Further, while the rule allows for notice within ten days of the opening of the "testimony" period, the rule contemplates depositions on written questions be conducted during the main testimony periods, not the shorter rebuttal period, given the lengthy process that allows applicant to serve cross questions and redirect questions by opposer.³

In light of the foregoing, applicant's motion to strike the notice is hereby granted and, for good cause shown, the motion to take the testimony by oral examination is hereby granted.⁴ In that opposer's rebuttal period closed on May 14, 2009, that period is hereby extended by ten days to conduct the deposition.

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.

³ The notice also fails to set forth when the answers to the written questions were to be taken, although it does provide that they were to be taken in front of a court reporter and recorded.

⁴ The parties are reminded that they may stipulate in writing how testimony may be submitted. See Trademark Rule 2.123(b).

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.

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