

**THIS ORDER IS NOT A
PRECEDENT OF THE TTAB**

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

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Mailed: June 2, 2016

Opposition No. **91198660**

Broadcom Corporation

v.

Broadchip Technology Group Ltd

**Before Cataldo, Mermelstein and Lykos,
Administrative Trademark Judges.**

By the Board:

This matter comes up on Opposer's motion (filed September 12, 2013) for sanctions in the form of judgment against Applicant for Applicant's failure to comply with the Board's order compelling Applicant's responses to Opposer's discovery requests.¹ Opposer asserts that it has received no responses from Applicant. *See Motion for Sanctions*, 14 TTABVUE 3.

On September 13, 2013, Applicant filed its responses to interrogatories with the Board and stated its willingness to "answer all the reasonable questions from the Opposer" but due to its corporate representative's duty posting in China, requested that Opposer conduct its "interrogatories and investigation through paper (e-mail)" and if Opposer insists on "oral

¹ By the Board's order of August 9, 2013, Applicant was allowed thirty days, i.e., until September 8, 2013, to respond to Opposer's discovery requests and to produce its witnesses for oral deposition.

interrogatories,” which presumably refer to the depositions of Mr. Dai, individually and as Applicant’s Rule 30(b)(6) witness, sought by Opposer, that Opposer “come to China or ... pay the travel cost for me to go to US.” *Applicant’s Response*, 15 TTABVUE 1.

On October 2, 2013, Opposer filed a reply brief acknowledging receipt of Applicant’s interrogatory responses but noting various deficiencies and objecting to the responses as unresponsive and incomplete. *Opposer’s Reply*, 16 TTABVUE 3-4. Opposer further noted Applicant’s continuing failure to serve any responses to Opposer’s requests for admission or to produce any documents in response to Opposer’s document requests, as well as Applicant’s failure to produce any witnesses for deposition. *Id.* at 4-5.

Decision

Where a party fails to comply with an order of the Board relating to discovery, the Board may order appropriate sanctions, including entry of default judgment. Trademark Rule 2.120(g)(1) and Fed. R. Civ. P. 37(b)(2). However, default judgment is a harsh remedy that is granted where no less drastic remedy would be effective and where there is a strong showing of willful evasion. *See Unicut Corp. v. Unicut, Inc.*, 222 USPQ 341, 344 (TTAB 1984).

Here, we do not find Applicant to have been so willfully evasive as to warrant the sanction of default judgment. This is not a situation where there was complete disregard of a Board order. Applicant attempted to respond to

Opposer's interrogatories and expressed its willingness to produce Jerry Dai, Applicant's President, for deposition in China or in the United States at Opposer's expense. *Applicant's Response*, 15 TTABVUE 1. Although Applicant's response was late and incomplete², it reflects some effort on the part of Applicant to comply.

Additionally, we do not fault Applicant for its failure to produce Mr. Dai for a deposition in the United States during a time when he was out of the United States because Opposer's demand for such attendance was inappropriate. Specifically, Opposer overreached in seeking to compel Mr. Dai or any other particular witness to attend a deposition in the United States at a time when the witness was in another country. The Board will not order a witness in a foreign country to appear for a deposition in the United States. *See Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998). Thus, we vacate that portion of the August 9, 2013, order to the extent that it grants Opposer's motion to compel Mr. Dai's travel to the United States to appear for a personal or a Rule 30(b)(6) deposition. The discovery deposition of witnesses located in a foreign country, assuming such depositions are allowed by that country, must be taken on written questions pursuant to Trademark Rule 2.124 unless the parties stipulate or the Board orders, on motion for

² Applicant failed to address Opposer's document requests and the deposition of Applicant's Secretary Kathy Geng. To the extent that Opposer asserts in its reply brief that Applicant has failed to comply with the Board's order vis-à-vis its requests for admission, Opposer's requests for admission were not a part of Opposer's motion to compel. As Opposer recognized in its motion to compel, Applicant failed to serve timely responses to Opposer's requests for admission and, therefore, the requests are deemed admitted by operation of law. *See Fed. R. Civ. P. 36(a)(3)*.

good cause, that the deposition be taken by oral examination. *See* Trademark Rule 2.120(c)(1).

To the extent Applicant objects to Opposer's proposed Fed. R. Civ. P. 30(b)(6) deposition on the ground that Mr. Dai is out of the country, the objection is without merit. That rule provides in relevant part:

In its notice or subpoena, a party may name as the deponent a public or private corporation, a partnership, an association, a governmental agency, or other entity and must describe with reasonable particularity the matters for examination. The named organization must then designate one or more officers, directors, or managing agents, or designate other persons who consent to testify on its behalf; and it may set out the matters on which each person designated will testify. A subpoena must advise a nonparty organization of its duty to make this designation. The persons designated must testify about information known or reasonably available to the organization. . . .

A Rule 30(b)(6) deposition is a deposition of the corporate party, not of any particular individual. Opposer may not insist on a 30(b)(6) deposition of any particular individual; it is up to Applicant to designate someone to appear on its behalf. But by the same token, a party present in the United States may not *avoid* a 30(b)(6) deposition by naming someone outside the country as its designee but refusing to produce that person for the deposition on account of his or her absence. Under 30(b)(6), the deposing party must set out in its notice of deposition the topics to be raised at the deposition. The entity to be deposed then designates a witness who "must testify about information known or reasonably available to the organization." In other words, the

designated witness need not be the person *most* knowledgeable about the listed subjects, and need not even testify from his or her personal knowledge. “It is well-established that an organization served with a Rule 30(b)(6) deposition notice is obligated to produce a witness knowledgeable about the subjects in the notice and to prepare that witness to testify not just to his own knowledge, but the corporation’s knowledge.” *Consol. Rail Corp. v. Grand Trunk W.R. Co.*, 853 F. Supp. 2d 666, 670 (E.D. Mich. 2012). If necessary, the corporation must prepare its designated deponent to testify.

Thus while Opposer may not insist on the appearance of Mr. Dai for a Rule 30(b)(6) deposition, neither may Applicant insist on nobody else. It appears from the record that at least one of Applicant’s officers or employees resides in the United States. No reason has been given why Ms. Geng, Applicant’s Secretary, or any other person similarly available, could not appear on Applicant’s behalf at a Rule 30(b)(6) deposition. She need not testify from her own knowledge; any witness must provide “information known or reasonably known” to Applicant, whether known personally to the witness or not. *Brazos River Auth. v. GE Ionics, Inc.*, 469 F.3d 416, 433 (5th Cir. 2006). Mr. Dai may — but will not be required to — travel to the United States to appear as a witness. But his absence from the United States will not frustrate or impede Opposer’s request for a deposition under Fed. R. Civ. P. 30(b)(6).

Under these circumstances, we find that to render judgment against Applicant would be too harsh a sanction and therefore **DENY** Opposer's motion for sanctions in the form of judgment. We do find, however, that in view of Applicant's failure to respond to Opposer's document requests and to produce Ms. Geng for deposition, lesser sanctions are warranted and hereby **GRANT** Opposer's motion for sanctions as follows:

- (1) Within **THIRTY DAYS** of the mailing date of this order, Applicant shall prepare and serve its responses to Opposer's document requests without objection on the merits and copy all responsive documents at its own expense and deliver them to Opposer;
- (2) Any documents produced by Applicant in response to Opposer's discovery requests will be deemed authentic and admissible if and to the extent that the document is filed and relied upon by Opposer during Opposer's trial period;
- (3) Applicant may not rely at trial on any documents requested by Opposer during discovery but which Applicant failed to produce within the time allowed by the Board's order granting Opposer's motion to compel; however, Applicant is not precluded from relying on documents which were reasonably not part of Opposer's document requests;
- (4) Applicant shall produce Ms. Geng for an oral deposition at the Palo Alto offices of Opposer's counsel within **SIXTY DAYS** of the mailing date of this order. Any representation by Applicant that Ms. Geng will not be present in the United States during that time must be supported by an affidavit or declaration under Trademark Rule 2.20, and documentary evidence of Ms. Geng's unavailability in the United States. If Ms. Geng is declared to be absent from the United States, Applicant must promptly notify Opposer of her return to this country;
- (5) Applicant shall produce Mr. Dai for an oral deposition at the Palo Alto offices of Opposer's counsel within **SIXTY DAYS** of the mailing date of this order. Any representation by Applicant that Mr. Dai will not be present in the United States during that time must be supported by an affidavit or declaration under Trademark Rule 2.20, and documentary evidence of Mr. Dai's unavailability in the United States. If Mr. Dai is

declared to be absent from the United States, Applicant must promptly notify Opposer of his return to this country;

- (6) Applicant shall produce a Rule 30(b)(6) witness for an oral deposition at the Palo Alto offices of Opposer's counsel within **SIXTY DAYS** of the mailing date of this order. Any representation by Applicant that no director, officer, or employee will be present in the United States during that time must be supported by an affidavit or declaration and documentary evidence of that witness's unavailability in the United States. If all of Applicant's directors, officers, and employees are declared to be absent from the United States, Applicant must promptly notify Opposer of the return of any such person to this country;

To the extent that Opposer believes Applicant's responses to its interrogatories are deficient, Opposer is directed to confer with Applicant to resolve the putative deficiencies. Should the parties be unable to resolve the discovery dispute, Opposer may move to compel further responses pursuant to Trademark Rule 2.120(e).

Finally, Applicant is directed to carefully read through the *pro se* information provided at the end of this order and to pay close attention to the deadlines in this matter. Applicant is further directed to submit its filings through ESTTA, the Board's electronic filing system.

Should the Board have occasion to consider a second motion for sanctions for Applicant's failure to comply with an order of the Board, judgment will likely be entered as a sanction against Applicant.

Proceedings herein are **RESUMED** and dates are **RESET** as follows:

Expert Disclosures Due	7/6/2016
Discovery Closes	8/5/2016
Plaintiff's Pretrial Disclosures Due	9/19/2016
Plaintiff's 30-day Trial Period Ends	11/3/2016
Defendant's Pretrial Disclosures Due	11/18/2016

Defendant's 30-day Trial Period Ends	1/2/2017
Plaintiff's Rebuttal Disclosures Due	1/17/2017
Plaintiff's 15-day Rebuttal Period Ends	2/16/2017

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 taking of testimony. Trademark Rule 2.125.

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

Pro Se Information

It is noted that Applicant is not represented by legal counsel in this proceeding. While Patent and Trademark Rule 11.14(e) permits any person to represent itself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in an opposition proceeding to secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney.

The Trademark Rules of Practice, other federal regulations governing practice before the Patent and Trademark Office, and many of the Federal Rules of Civil Procedure govern the conduct of this proceeding. The Trademark Act, the Trademark Rules of Practice, and the Trademark Trial and Appeal Board Manual of Procedure (TBMP) are all available on the TTAB page of the USPTO website at <http://www.uspto.gov/trademarks/>

[process/appeal/index.jsp](#). This web page also includes information on Alternative Dispute Resolution (ADR), Frequently Asked Questions about Board proceedings, and other relevant topics.

Applicant is reminded that Trademark Rules 2.119(a) and (b) require that every paper filed in the Patent and Trademark Office in a proceeding before the Board must be served upon the attorney for the other party (or adversary), and proof of such service must be made before the paper will be considered by the Board. Consequently, copies of all papers that the parties may subsequently file in this proceeding must be accompanied by “proof of service” of a copy on the other party or the other party’s counsel.

“Proof of service” usually consists of a signed, dated statement stating: (1) the nature of the paper being served, (2) the method of service (e.g., first class mail), (3) the person being served and the address used to effect service, and (4) the date of service. For future reference, a suggested format for the certificate of service is provided below:

I hereby certify that a true and complete copy of the foregoing (*insert title of submission*) has been served on (*insert name of opposing counsel or party*) by mailing said copy on (*insert date of mailing*), via First Class Mail, postage prepaid (*or insert other appropriate method of delivery*) to:

(set out name and address of opposing counsel or party)

Signature

See TBMP § 113.

Applicant should further note that any paper it is required to file with the Board should not take the form of a letter; proper format should be utilized. The form of submissions is governed by Trademark Rule 2.126. *See also* TBMP § 106.03. In particular, “[a] paper submission must be printed in at least 11-point type and double-spaced, with the text on one side only of each sheet” and text “in an electronic submission must be in at least 11-point type and double-spaced.” Trademark Rule 2.126(a)(1) and 2.126(b).

While it is true that the law favors judgments on the merits wherever possible, it is also true that the Patent and Trademark Office is justified in enforcing its procedural deadlines. *Hewlett-Packard v. Olympus*, 18 USPQ2d 1710 (Fed. Cir. 1991). In that regard, the parties should note that any paper they are required to file herein must be received by the Board by the due date, unless one of the filing procedures set forth in Trademark Rules 2.197 and 2.198 is utilized.

Files of TTAB proceedings can be examined using TTABVue, accessible at <http://ttabvue.uspto.gov/ttabvue>. After entering the 8-digit proceeding number, click on any entry in the prosecution history to view that paper in PDF format.

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