

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

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Mailed: July 19, 2012

**Opposition No. 91203410**

The Plubell Firm LLC

v.

East West Bank

**Cancellation No. 92053712**

East West Bank

v.

The Plubell Firm LLC

**Elizabeth A. Dunn, Attorney (571-272-4267):**

This case comes up on the motion of East West Bank to compel the continued deposition of Ann Marie Plubell. The motion is contested, and the Board held a phone conference on July 17, 2012.<sup>1</sup> The participants were Mina Hamilton, attorney for The Plubell Firm LLC (hereafter, TPF), Aaron Craig,

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<sup>1</sup> The conference also was to address TPF's motion to compel the deposition of EWB witness Douglas Krause. Based on the conflicting versions of relevant facts, the Board ordered the parties to brief the motion, as detailed at the end of this order.

attorney for East West Bank (hereafter, EWB), and Elizabeth Dunn, attorney for the Board.<sup>2</sup>

From the beginning, the scheduling and conduct of depositions has been unduly contentious. In the cancellation EWB served notices of deposition of Ms. Plubell and a Fed. R. Civ. P. 30(b)(6) witness for November 10, 2011 in Washington DC , and TPF then served notices of deposition for EWB's three top executives for the same day in Los Angeles, California. EWB filed a combined motion to quash the depositions of its officers and to compel the depositions of TPF's witnesses. Because TPF did not first seek the deposition of marketing Director Emily Wang, the witness identified in EWB's initial disclosures, or a Fed. R. Civ. P. 30(b)(6) witness, the Board quashed the notices of deposition of the three corporate officers.

However, because neither party was cooperating in discovery, the Board denied the motion to compel and ordered the parties to serve new notices of deposition, to cooperate in scheduling depositions within the same week, and to file a stipulation with the deposition schedule with the Board by January 9, 2012. The January 9, 2012 stipulation scheduled the deposition of Ms. Wang in Los Angeles, California on

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<sup>2</sup> TPF's co-counsel David Starr also attended the conference and Ms. Plubell attended briefly.

January 30, 2012 and Ms. Plubell in Washington, DC on February 2, 2012.

By party stipulation filed February 13, the schedule was modified and expanded to schedule the continued deposition of Ms. Wang on March 7, 2012 and Ms. Plubell on March 30, 2012, and to provide that the total deposition time would not exceed 12 hours for either witness. The Board approved the stipulation on February 17, 2012. As discussed at the conference, Ms. Wang's deposition was completed on March 7, 2012 as scheduled. Ms. Plubell's deposition began on March 30, 2012 as scheduled, but ended after seven hours. Based on a personal emergency, counsel for EWB had to leave town before concluding the deposition.

Following Ms. Wang's deposition, the Board consolidated these proceedings, and granted TPF's motion to amend its answer to add counterclaims to cancel EWB's pleaded Registration No. 2025824 in the grounds of nonownership and fraud based on misrepresentations of ownership, and Registration No. 3430148 on the ground of fraud based on misrepresentations of use with the services listed in the application. The Board denied TPF's request to extend discovery based on the insufficiency of Ms. Wang's testimony as a Fed. R. Civ. P. 30 (b)(6) witness, finding that she was "reasonably knowledgeable and responsive in the face of often convoluted questioning."

MOTION TO COMPEL CONTINUED DEPOSITION IS GRANTED

EWB now moves to compel continuance of Ms. Plubell's deposition begun March 20, 2012. EWB's first effort to reschedule was made in April, and was unsuccessfully repeated, most recently with EWB's request to have Ms. Plubell testify on June 22, 2012 or July 1, 2012. Without disputing that the parties had stipulated to no more than 12, and not 7, hours of deposition for the two witnesses who testified as both Fed. R. Civ. P. 30(b)(6) designates and knowledgeable individuals identified in initial disclosures, or that EWB's counsel had an emergency which precluded immediate resumption after the interrupted first day, TPF has failed to reschedule the deposition.

The conference demonstrated that EWB made the necessary good faith effort to resolve this matter before seeking a Board order compelling the deposition. TPF does not dispute that multiple requests to reschedule were made. Rather, TPF contends that continuing the deposition is unnecessary, inconvenient to Ms. Plubell, and that this motion is premature inasmuch as TPF wishes to negotiate a global agreement to streamline the remaining depositions. EWB contends that this deposition was already the subject of a stipulation by the parties, and there was no undue delay but Ms. Plubell's answers did not come as quickly as anticipated, that substantial time was spent on the origins

of her business, and that the nature of her services had not been fully explored at the time the deposition ended.

The Board agrees with EWB that this deposition was the subject of a stipulation which provided for 12 hours of testimony, disagrees with TPF that this is an inordinate period or extraordinary inconvenience to Ms. Plubell, and grants EWB's motion to compel. Ms. Plubell must appear for continuance of her deposition to take place on August 22, 2012 for no more than 4 hours beginning at 9:30AM EST unless the parties agree to an alternate date and time which does not involve any extension of the discovery period.

Discovery is set to close on September 24, 2012. The compelled deposition date of August 22, 2012 apparently is a date during which counsel for TPF is not available. The Board wishes it to be clear on this record that TPF only agreed to depositions when ordered to do so by the Board, that the resulting stipulation was not followed, that after the Board granted the motion to compel during the conference, TPF was prepared with no prospective dates for the continued deposition, and that TPF informed the Board that Ms. Plubell was unavailable until September. It was only after a substantial effort by the Board, including a recess in which Ms. Plubell was consulted on her availability, that the information that Ms. Plubell was available on August 22, 2012 was elicited.

While it is unfortunate that the conference did not result in a mutually convenient date, TPF has only itself to blame. In view of the prior stipulation entered after Board intervention, and after the Board's rejection of TPF's attempts to force additional depositions with criticism of EWB's witness, Ms. Plubell should have been aware that the delay in completing her deposition from March 30 to the present could be abruptly ended if the Board granted the motion to compel with just two months left in discovery. Unless the parties agree to a different date within the existing discovery period, the Board will entertain a motion for sanctions if Ms. Plubell does not appear as ordered on August 22, 2012.

MOTION FOR PROTECTIVE ORDER DEFERRED

As discussed, TPF wishes to compel the deposition of Douglas Krause based on the deficiencies of the earlier testimony of EWB's Fed. R. Civ. P. 30(b) (6) witness Emily Wang, based on his role in obtaining EWB's registrations, and because he was identified in the initial disclosures for the opposition.<sup>3</sup> The Board agreed the phone conference could also address that motion. However, on the eve of the conference, EWB filed "objections" to the deposition and

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<sup>3</sup> Until the opposition is dismissed or sustained, it remains part of this consolidated proceeding. As discussed the Board will take no action based on papers which may be filed in the future.

during the conference EWB argued that the deposition is redundant. Because the parties disagree on the relevant facts, it was inappropriate to address the motion orally.

The Board will construe EWB's filing as a motion for a protective order barring the deposition. EWB is allowed until TWO DAYS from the mailing date of this order to file a supplement to its motion. Page limits remain in effect and apply to the combined filing.

TPF is allowed until FIFTEEN DAYS from the date of service of the supplement to prepare its response. As set forth above, the Board notes that its May 7, 2012 order denied TPF's motion for extension of discovery and found Ms. Wang's testimony as a Fed. R. Civ. P. 30(b)(6) witness to be sufficient. Since the period for seeking reconsideration of that order has passed, TPF is barred from raising defects in Ms. Wang's testimony as a reason to compel deposition of a different witness. EWB's supplement to its motion should not address, or address further, the need for more testimony from a Fed. R. Civ. P. 30 (b) (6) witness.

TPF must inform the Board by phone when its response to the motion seeking a protective order has been filed. At that time the Board will schedule another phone conference with the parties.

The parties remain barred from filing any unconsented motion without the express permission of the Board, which must

be obtained by calling Board attorney Elizabeth Dunn at 571-272-4267.

The party seeking to file an unconsented motion must (i) discuss with the other party and agree on three alternative dates and times when a conference with the Board attorney could be held; (ii) arrange the conference with the Board and the other party; and (iii) during the conference, explain the circumstances warranting the filing. If appropriate, the Board will authorize filing or addressing by phone the unconsented motion.

This order does not affect the parties' ability to file consent motions or stipulations.

Dates remain as set in the Board's May 7, 2012 order.