

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

Mailed: October 3, 2014

Opposition No. 91204897
(**Parent Case**)
Opposition No. 91204941

John G. Marino

v.

*Laguna Lakes Community
Association, Inc.*

**George C. Pologeorgis,
Interlocutory Attorney:**

On Friday, October 3, 2014 at 3:00 p.m. EDT, the Board, at the request of Applicant's counsel, held a telephone conference with counsel for each party regarding issues arising from notices of testimony depositions served by Opposer on Applicant.

The Board carefully considered the arguments raised by the parties, as well as the supporting correspondence and the record of this case, in coming to a determination regarding the above matters. During the telephone conference, the Board made the following findings and determinations:

1. On October 2, 2014, Opposer served a notice of testimony deposition of Opposer John G. Marino scheduled to take place on Wednesday, October 8, 2014 at 11:00 a.m. EDT. Applicant's counsel, W. Scott

Harders, stated that he was unavailable to attend the testimony deposition at the noticed date and time due to previously scheduled oral arguments before the Court of Appeals for the Federal Circuit in Washington, DC. During the telephone conference, Applicant's counsel indicated that Applicant's co-counsel, Chad Rothschild, would be able to attend the testimony deposition on the scheduled date and time. Accordingly, Mr. Marino's testimony deposition will proceed as noticed and Applicant's motion to quash the notice of deposition of Mr. Marino filed on October 3, 2014 is deemed moot and will be given no further consideration;

2. Opposer also noticed the testimony deposition of one of Applicant's attorneys, namely, Donna Flammang. Opposer contends that Ms. Flammang is an important fact witness who can provide relevant information regarding issues in this proceeding. Opposer has failed, however, to demonstrate that no other means exist to obtain the information required by Opposer other than to depose Ms. Flammang. *See Shelton v. American Motors Corp.*, 805 F.2d 1323 (8th Cir. 1986); *see also* Board order dated April 25, 2013 (TTABVue Entry No. 32). In view thereof, the notice of testimony deposition of Ms. Flammang is *sua sponte* quashed;
3. Additionally, Opposer noticed the testimony depositions of Mr. Jeffrey A. Kelly and Ms. Mary Ann Cowart. Applicant contends that both of these

individuals are unwilling non-party witnesses. Opposer is advised that if he wishes to take the trial testimony of an adverse party or nonparty (or an official or employee of an adverse party or nonparty) residing in the United States, and the proposed witness is not willing to appear voluntarily to testify, as is the case here, Opposer must secure the attendance of the witness by subpoena. TBMP § 703.01(f)(2). The subpoena must be issued, pursuant to 35 U.S.C. § 24 and Fed. R. Civ. P. 45, from the United States district court in the federal judicial district where the witness resides or is regularly employed. *Id.* Similarly, any request to quash a subpoena must be directed to the United States district court that issued the subpoena. *Id.* The Board has no jurisdiction over depositions by subpoena. *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1304 n.3 (TTAB 1987) (no authority to quash subpoena)

4. Opposer also noticed the testimony depositions of Patrick Tardiff, as Applicant's designated 30(b)(6) deponent, and Robert Hajicek, one of Applicant's officers. The record demonstrates that Opposer has already taken the discovery depositions of each of these individuals. Opposer is advised that he may submit these discovery deposition transcripts under a notice of reliance during his testimony period in accordance with Trademark Rule 2.120(j)(1). To the extent Opposer wishes to also take the testimony depositions of these two individuals, Opposer must first file a request to do so with the Board no later than **Tuesday, October 7, 2014**, advising why it is necessary to take the

testimony depositions of Mr. Tardiff and Mr. Hajicek when Opposer has already taken their discovery depositions which may be submitted under a notice of reliance under Board rules and procedure.¹ The fact that either Mr. Tardiff or Mr. Hajicek did not provide desirous testimony during their respective discovery depositions does not constitute a proper ground to pursue their testimony depositions. Instead, Opposer may invoke the doctrine of estoppel if Applicant seeks to introduce into evidence on the case any information previously withheld by either Mr. Tardiff or Mr. Hajicek. See TBMP § 527.01(e) (2014).

Trial Schedule

Trial dates remains as reset by Board order dated September 29, 2014.

¹ As discussed *supra*, if Opposer attempts to notice the testimony depositions of either Mr. Tardiff or Mr. Hajicek, as unwilling party witnesses, Opposer must do so pursuant to a subpoena issued from a United States district court in the federal judicial district where each witness resides or is regularly employed.