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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91205483
Party	Plaintiff Baba Slings Pty Ltd
Correspondence Address	MARK BORGHESE BORGHESE LEGAL LTD 10161 PARK RUM DRIVE , SUITE 150 LAS VEGAS, NV 89145 UNITED STATES mark@borgheselegal.com
Submission	Opposition/Response to Motion
Filer's Name	Mark Borghese
Filer's e-mail	mark@borgheselegal.com,docket@borgheselegal.com
Signature	/MB/
Date	05/30/2013
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**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Application No.: 79/103197

Mark: theBabaSling

Filed on: September 6, 2011

Baba Slings Pty Ltd,)	
)	
Opposer,)	Opposition No: 91205483
)	
vs.)	
)	
BabaSlings Limited,)	
)	
Applicant.)	
_____)	

RESPONSE IN OPPOSITION TO MOTION TO COMPEL

Pursuant to Trademark Rule § 2.120 and TBMP § 404.03, Opposer Baba Slings Pty Ltd (“Opposer”) hereby responds to Applicant’s Motion to Compel Discovery Depositions. In Opposition, Opposer states that Applicant’s Motion should be denied because (1) Shanti McIvor lives and works full time in Australia and Opposer is an Australian company; (2) Applicant vacated the original depositions and has never reset them, thus there is nothing for the Board to compel; (2) when Applicant finally requested new deposition dates for Shanti McIvor with less than three weeks left in the discovery period, Ms. McIvor was not going to be in the United States and, in fact, had not been in the United States since last October.

I. FACTUAL BACKGROUND

Opposer Baba Slings Pty Ltd. is an Australian company. *See* Declaration of Mark Borghese at ¶ 2, attached as Exhibit A. Its principal, Shanti McIvor, lives and works full time in Australia. *Id.* Upon information and belief, Applicant BabaSlings Limited, is a United Kingdom corporation. *See* Borghese Declaration at ¶ 3. Upon information and belief, Applicant’s

principals live and work full time in the United Kingdom. *Id.*

On October 5, 2012, Applicant's newly appointed counsel sent an email to Opposer's counsel indicating that he believed Opposer's principal, Shanti McIvor would be in Louisville, Kentucky from October 15-17, 2012. *See* Borghese Declaration at ¶ 4. Opposer's counsel responded that he was unaware whether Ms. McIvor would be in Kentucky on those dates. *Id.* Apparently those dates coincided with the ABC Kids Expo in Louisville. Applicant -- Opposer's competitor -- was hoping to schedule depositions of Opposer's principal during the tradeshow.

On October 8, 2012, Applicant's counsel contacted Opposer's counsel by telephone and stated that he would be setting Ms. McIvor's deposition for October 16, 2012 in Louisville. *See* Borghese Declaration at ¶ 5. Counsel for Opposer again reiterated that he had not yet spoken with Ms. McIvor and did not know whether she would be in the United States on those days. *Id.* Applicant thereafter unilaterally set Ms. McIvor's deposition for October 16, 2012 in Louisville, Kentucky. Applicant also improperly set a 30(b)(6) deposition of Opposer, an Australian company, for that same date in Louisville.

On October 11, 2012, counsel for Opposer contacted Applicant's attorney and informed him that Ms. McIvor was not available to have her deposition taken on October 16, 2012. *See* Borghese Declaration at ¶ 6. Applicant's counsel thereafter vacated the depositions. At no time did Opposer's counsel agree that a rescheduled deposition for Shanti McIvor or the 30(b)(6) deposition would take place in the United States. Rather, Opposer's counsel suggested numerous times that the depositions could take place telephonically from Australia. *Id.* Applicant's counsel was well aware that Ms. McIvor lived and worked in Australia full-time and that Opposer is an Australian company. Moreover, since the ABC Kids Expo last October Ms. McIvor has not been back in the United States. *See* Borghese Declaration at ¶ 7. Even if Applicant hoped to find a date when Ms. McIvor was available in the United States after October, none existed.

Furthermore, after the depositions were vacated, at no time did Applicant's counsel ever re-notice these depositions. In fact, after October 23, 2013, Applicant's counsel did not even inquire as to Ms. McIvor's availability until three weeks prior to the close of discovery.

On January 29, 2013, with less than three weeks left in the discovery period (which was set to end on February 19, 2013), Applicant's counsel contacted Opposer's counsel and requested that the proceedings be stayed. *See* Borghese Declaration at ¶ 8. Opposer agreed and the proceedings were stayed until May 1, 2013. *Id.* On April 30, 2013, Applicant's counsel contacted Opposer's counsel and again requested another stay of the proceedings. *See* Borghese Declaration at ¶ 9. The request was refused and Applicant's counsel for the first time since last October, requested dates when Ms. McIvor would be in the United States on or before the close of discovery set for May 20, 2013. *Id.* On May 2, 2013, Opposer's counsel informed Applicant's counsel that Ms. McIvor would not be in the United States before the close of discovery. *See* Borghese Declaration at ¶ 10. On May 6, 2013, Opposer's counsel indicated that Ms. McIvor could have her deposition taken by telephone or Skype on May 14, 2013 (May 15, 2013 Australia time). *See* Borghese Declaration at ¶ 11. Applicant's counsel responded on May 6, 2013 demanding an in-person deposition in the United States. *See* Borghese Declaration at ¶ 12. Opposer's counsel responded that Ms. McIvor would not be in the United States prior to the close of discovery. Since Opposer's offer of a telephonic deposition was not accepted, it was withdrawn and Applicant's counsel was invited to proceed with a deposition on written questions. Without further communication, Applicant's counsel filed the instant motion.

At no time was there an agreement between the parties that Ms. McIvor would have her deposition taken in the United States or that the 30(b)(6) depositions would take place in the United States. *See* Borghese Declaration at ¶ 13. The first time this alleged "agreement" is

brought up is in a May 10, 2013 email from Applicant’s counsel clearly sent in anticipation of filing the instant motion. Applicant’s repeated statement in the motion and sworn declaration that Opposer’s counsel withdrew an agreement for an in-person deposition is either a serious misreading of an email or an intentional attempt to deceive the Board. The May 6, 2013 email in question (attached to Applicant’s motion at Exhibit I, page 3) states in part (*emphasis in original*):

Our prior offer to allow the deposition to take place telephonically or by Skype is withdrawn. If you would like to seek an in-person deposition, please file a motion pursuant to TBMP § 520. Otherwise the deposition must proceed pursuant to 37 CFR 2.124 (i.e. pursuant to written questions). Ms. McIvor is a natural person residing in a foreign country and an officer of the Opposer.

As is readily apparent from the text of the email, the only offer that is being “withdrawn” is Opposer’s good faith attempt to resolve this issue by allowing the deposition to take place telephonically or by Skype, an offer that Opposer had made several times, including on May 2, 2013. *See also* Borghese Declaration at ¶ 14.

The reality of the situation is that Applicant made no effort to obtain deposition dates for months and then less than three weeks prior to the close of discovery Applicant’s counsel demanded that Ms. McIvor come to the United States for her deposition. All attempts at accommodation made by Opposer’s counsel, including providing specific dates and times to hold a telephonic deposition were rejected. Upon information and belief, the instant motion was not filed for any actual grievance, but merely to delay the proceedings after Opposer refused to stay the proceedings a second time.

II. ARGUMENT

A. There is Nothing to Compel as Applicant Vacated the Original Depositions and Never Reset them

It is undisputed that the depositions originally set for October 16, 2012 were vacated by Applicant’s counsel. It is also undisputed that those depositions have never been re-noticed.

There is thus nothing for the Board to compel and Applicant's motion should be denied. Trademark Rule § 2.120(e) states in pertinent part,

(e) Motion for an order to compel disclosure or discovery. (1) If a party fails to . . . attend a deposition . . .

Here, the only depositions ever set were long ago vacated. Ms. McIvor has therefore not failed to "attend a deposition" as the vacated deposition was never re-noticed.

B. When Applicant Requested Dates for Ms. McIvor's Deposition with Less than Three Weeks to go in Discovery, Ms. McIvor was Not in the United States

It is undisputed that after October 23, 2012, Applicant made no attempt to even request deposition dates for Ms. McIvor until three weeks prior to the close of discovery. In fact, on January 29, 2013, with three weeks before the close of discovery (then set for February 19, 2013) it is Opposer's counsel (not Applicant's) that brings up the topic on in response to Applicant's request for a stay of the proceedings (*See* Applicant's Motion, Exhibit G).

On April 30, 2013, Applicant's counsel contacted Opposer's counsel and again requested another stay of the proceedings. The stay request was refused and Applicant's counsel thereafter requested dates when Ms. McIvor would be in the United States on or before the close of discovery on May 20, 2013. Applicant is well aware that Ms. McIvor lives and works full time in Australia and that Opposer is an Australian Company. While understandably Applicant would prefer to have an in-person deposition, it was simply not possible with the limited time left in the discovery period.

Opposer attempted to accommodate Applicant's request for a deposition by setting up a telephonic deposition of Ms. McIvor on May 14, 2013 (May 15 in Australia). Applicant refused, demanding an in-person deposition. Such a request was not only impractical, but also contrary to Trademark Rule 2.120.

While Section 2.120 (c)(2) of that rule permissively allows depositions of officers of foreign parties to be taken in the United States, it requires that the person being deposed be present in the United States.

Specifically, Trademark Rule § 2.120(c)(2) states in pertinent part,

The deposition of a person under this paragraph shall be taken in the Federal judicial district where the witness resides or is regularly employed, or, if the witness neither resides nor is regularly employed in a Federal judicial district, where the witness is at the time of the deposition. This paragraph does not preclude the taking of a discovery deposition of a foreign party by any other procedure provided by paragraph (c)(1) of this section.

Emphasis Added. Although Applicant never re-noticed its vacated depositions, even if it had re-noticed them in May, Shanti McIvor was not in the United States after last October, and would not be in the United States, through the remainder of the discovery period which was set to close May 20, 2013. Pursuant to Trademark Rule 2.120(c)(1) the only method available to take Shanti McIvor's deposition through the remainder of discovery was through written questions pursuant to Section 2.120(c)(1).

In order to reach a compromise on this issue Opposer offered to set up a telephonic or Skype deposition, but this offer was refused by Applicant and has since been withdrawn. The Applicant now files the instant Motion to Compel demanding that Shanti McIvor fly from Australia to the United States to have her discovery deposition taken at the office of Applicant's counsel.

The Board does not generally order a natural person, including a person designated under Fed. R. Civ. P. 30(b)(6), residing in a foreign country to come to the United States for the taking of his or her discovery deposition. TBMP §520 (3rd ed. rev. 1, 2012). *See Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998), and *Rhone- Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372, 374 (TTAB 1978). *See also* TBMP §§ 404.03(b) and 521.

The Board should therefore deny Applicant's motion to compel.

Respectfully submitted,

Dated: May 30, 2013

By: 
Mark Borghese, Esq.
Borghese Legal, Ltd.
10161 Park Run Drive, Suite 150
Las Vegas, Nevada 89145
Tel: (702) 382-0200
Fax: (702) 382-0212
Email: mark@borgheselegal.com
Attorney for Opposer Baba Slings Pty Ltd

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **RESPONSE IN OPPOSITION TO PLAINTIFF'S MOTION TO COMPEL** has been served on the attorney of record for the Applicant on May 30, 2013, by serving a copy via email as well as by mailing a copy via First Class Mail, postage prepaid, to the attorney's correspondence address of record:

Brian A. Coleman
Drinker Biddle & Reath LLP
1500 K Street, N.W.
Washington, DC 20005-1209
Brian.Coleman@dbr.com



Mark Borghese

EXHIBIT A

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BabaSlings Limited,)	
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)	
)	
_____)	

DECLARATION OF MARK BORGHESE

I, Mark Borghese, declare as follows:

1. I am an attorney with Borghese Legal, Ltd., counsel of record for the Opposer in the above-captioned proceeding.

2. Opposer Baba Slings Pty Ltd. is an Australian company. Its principal, Shanti McIvor, lives and works full time in Australia.

3. Upon information and belief, Applicant BabaSlings Limited, is a United Kingdom corporation. Upon information and belief, its principals live and work full time in the United Kingdom.

4. On October 5, 2012, Applicant's newly appointed counsel sent an email to me indicating that he believed Opposer's principal, Shanti McIvor would be in Louisville, Kentucky from October 15-17, 2012. I responded that I was unaware whether Ms. McIvor would be in Kentucky on those dates.

5. On October 8, 2012, Applicant's counsel contacted me by telephone and stated that he would be setting Ms. McIvor's deposition for October 16, 2012 in Louisville. I again reiterated that I had not yet spoken with Ms. McIvor and did not know whether she would be in the United States on those days.

6. On October 11, 2012, I contacted Applicant's attorney and informed him that Ms. McIvor was not available to have her deposition taken on October 16, 2012. Applicant's counsel thereafter vacated the depositions. At no time did I agree that a rescheduled deposition for Shanti McIvor or the 30(b)(6) deposition would take place in the United States. Rather, I suggested numerous times that the depositions could take place telephonically from Australia.

7. Based on communications with my client, it is my understanding that since the ABC Kids Expo last October Ms. McIvor has not been back in the United States.

8. On January 29, 2013, Applicant's counsel contacted me and requested that the proceedings be stayed. I agreed and the proceedings were stayed until May 1, 2013.

9. On April 30, 2013, Applicant's counsel contacted me and again requested another stay of the proceedings. The request was refused and Applicant's counsel for the first time since last October, requested dates when Ms. McIvor would be in the United States on or before the close of discovery set for May 20, 2013.

10. On May 2, 2013, I informed Applicant's counsel that Ms. McIvor would not be in the United States before the close of discovery.

11. On May 6, 2013, I indicated that Ms. McIvor could have her deposition taken by telephone or Skype on May 14, 2013 (May 15, 2013 Australia time).

12. Applicant's counsel responded on May 6, 2013 demanding an in-person deposition in the United States.

13. At no time was there an agreement between the parties that Ms. McIvor would have her deposition taken in the United States or that the 30(b)(6) deposition would take place in the United States.

14. The only offer I “withdrew” was an offer to allow the deposition of Ms. McIvor to proceed by telephone or Skype.

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.



Mark Borghese
Dated: 5/30/2013