

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

Mailed: August 26, 2013

Opposition No. 91205483

Baba Slings Pty Ltd

v.

Baba Slings Limited

Jennifer Krisp, Interlocutory Attorney:

This proceeding is before the Board for consideration of applicant's May 15, 2013 motion to compel discovery. The motion has been fully briefed.

Applicant seeks an order compelling opposer's principal Ms. Shanti McIvor, opposer's sole witness as identified in opposer's initial disclosures, to be available and appear for a discovery deposition of opposer pursuant to Fed. R. Civ. P. 30(b)(6) and of her individually, pursuant to Trademark Rule 2.120(c)(2), at the office of applicant's counsel in Washington, D.C.

Initially, the Board notes, upon review of the communications which applicant's counsel initiated and has made of record, that applicant satisfied its obligation, under Trademark Rule 2.120(e)(1), to make a good faith effort, by conference or correspondence, to resolve with

applicant the issues presented in the motion prior to filing the motion.

Trademark Rules 2.120(c)(1) and (c)(2) address the discovery deposition of a party residing in a foreign country, and provide, in part:

- (1) The discovery deposition of a natural person residing in a foreign country who is a party or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, shall, if taken in a foreign country, be taken in the manner prescribed by § 2.124 unless the Trademark Trial and Appeal Board, upon motion for good cause, orders or the parties stipulate, that the deposition be taken by oral examination.
- (2) Whenever a foreign party is or will be, during a time set for discovery, present within the United States or any territory which is under the control and jurisdiction of the United States, such party may be deposed by oral examination upon notice by the party seeking discovery.

The Board will not order a natural person residing in a foreign country to come to the U.S. for his or her discovery deposition. However, the Board may, on motion and for good cause, order that the deposition be taken by oral examination. See TBMP § 404.03(b) (2013). This is essentially the relief which applicant seeks by way of its motion.

Whether such relief is to be granted is determined on a case-by-case basis, upon consideration of the particular facts and circumstances. *Id.* See also *Orion Group Inc. v.*

The Orion Insurance Co. P.L.C., 12 USPQ2d 1923, 1925 (TTAB 1989). Here, the record - which includes, inter alia, the declarations of counsel for both parties, letters and email communications between counsel, and applicant's notices of deposition - reflects that opposer's sole identified witness is Ms. Shanti McIvor, who resides in Australia, that applicant properly served notices of Fed. R. Civ. P. 30(b)(6) and individual depositions on October 8, 2012, and that the date for the depositions was based on opposer's counsel's representation that Ms. McIvor would be in the U.S. during the week of October 15, 2013. Opposer did not object to the notices of deposition.

Opposer's counsel communicated Ms. McIvor's unavailability for the noticed date to applicant's counsel and stated he would provide "alternative dates as soon as possible" (applicant's motion, exh. F), and applicant's counsel thereafter requested such alternative dates on two occasions. Opposer's counsel did not provide dates in response to either of these requests. Subsequent to suspension for settlement, further communications took place wherein, inter alia, applicant's counsel expressly requested potential dates that Ms. McIvor would be in the U.S., and opposer's counsel responded that Ms. McIvor would not be in the U.S., and made but withdrew an offer to allow the depositions by telephone or by Skype.

Applicant noticed the discovery depositions in accordance with applicable authorities. See Trademark Rule 2.120(c)(2); TBMP § 404.03(d)(2013). Moreover, it sought the depositions with diligence and early in the discovery period, as reset; specifically, opposer served its initial disclosures on September 20, 2012, applicant inquired about opposer's availability, and applicant noticed the depositions on October 8, 2012. The record does not reflect delay or lack of adherence to the Rules of Procedure on applicant's part.

Opposer initiated these proceedings and is availing itself of the jurisdiction of the Board, an administrative tribunal within the U.S., with respect to the registrability of applicant's mark. Opposer identified only one witness, and had full and advance knowledge of applicant's desire to depose opposer and its principal. Opposer has been aware that the information needed by applicant in assessing and preparing its defense is solely or largely with opposer and its principal. Opposer's failure to provide alternative dates in a reasonable time after they were requested, and the unilateral withdrawal of its "offer" to allow the depositions by telephone or Skype, are not consistent with the Board's expectation that parties in inter partes proceedings will conduct themselves in accord with a shared obligation to cooperate in discovery matters, and in particular in the scheduling of depositions. *HighBeam Marketing LLC v. Highbeam Research LLC*, 85 USPQ2d 1902 (TTAB

2008). In the case of a foreign party, the Board's expected level of cooperation encompasses, at a minimum, mindfulness in making efforts to see that a foreign witness, who clearly has business in the U.S. from time to time, can be available for a noticed (or forthcoming rescheduled) in-person deposition. Furthermore, nothing in the record suggests that it was not apparent to opposer that applicant released opposer from the noticed depositions in reliance on opposer's statement that it would provide alternate dates for said depositions in the manner in which they were noticed. Viewed against the Board's expectation that parties will fully cooperate with each other in the discovery process, opposer's course of conduct is, at a minimum, problematic.

As noted, inasmuch as the party deponent is not presently or potentially in the U.S., the Board will not order Ms. McIvor to travel to the U.S. for the discovery depositions. Nonetheless, on this record the Board finds good cause to allow applicant to take the depositions of opposer and of Ms. McIvor by oral examination. Moreover, the Board allows and favors the use of technology in taking depositions. *See Hewlett-Packard Co. v. Healthcare Personnel Inc.*, 21 USPQ2d 1552, 1553 (TTAB 1991).

In view of these findings, applicant's motion to compel the discovery deposition of opposer pursuant to Fed. R. Civ. P. 30(b)(6), and of Ms. McIvor, is hereby granted as modified.

Applicant shall choose to take said depositions by telephone, by teleconference, by Skype, or on written questions pursuant to Trademark Rule 2.124.¹ Applicant is directed to communicate its choice to opposer within fifteen (15) days of the mailing date of this order. Within fifteen (15) days from the date of said notification, opposer shall provide to applicant at least three (3) dates on which Ms. McIvor is available for the depositions. Thereafter, applicant shall proceed to notice and take the depositions.

The Board expects that the parties will be fully cooperative in communicating and in rescheduling the depositions to be taken in the manner chosen by applicant.²

Schedule

Proceedings are resumed. To accommodate the directives in this order, the close of discovery, and trial dates, are reset as follows:³

¹ As the parties are likely aware, taking a deposition on written questions under Trademark Rule 2.124 has several disadvantages to both parties, is cumbersome and time-consuming, and deprives applicant of face-to-face confrontation and the opportunity to ask follow-up questions based on answers to previous questions. See TBMP § 404.07(j) (2013). Nevertheless, in the event that applicant elects to pursue this option, counsel should notify the Board by filing herein a paper indicating this such that the Board may issue an order suspending proceedings to allow for the orderly completion of the depositions. TBMP § 404.07(e) (2013).

² Applicant may elect to take the two depositions in two different manners.

³ The Board has sua sponte reviewed opposer's pleading. The notice of opposition fails to sufficiently set forth two of the three statutory grounds for opposition which opposer listed on the ESTTA filing cover sheet, namely, deceptiveness, and false

Discovery Closes	11/22/2013
Plaintiff's Pretrial Disclosures due	1/6/2014
Plaintiff's 30-day Trial Period Ends	2/20/2014
Defendant's Pretrial Disclosures due	3/7/2014
Defendant's 30-day Trial Period Ends	4/21/2014
Plaintiff's Rebuttal Disclosures due	5/6/2014
Plaintiff's 15-day Rebuttal Period Ends	6/5/2014

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.

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.

suggestion of a connection, under Trademark Act Section 2(a). The Board will give no consideration to these unpleaded grounds.