

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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Mailed: October 28, 2014

**Opposition No. 91211530  
(PARENT CASE)**

Cancellation No. 92056491

J-Lynn Entertainment, LLC

v.

William T. Odonnell DBA Odonnell  
Entertainment

Jennifer Krisp, Interlocutory Attorney:

This proceeding is before the Board for consideration of the motions to quash opposer's notice of testimony depositions, filed herein on October 24, 2014 on behalf of William T. Odonnell DBA Odonnell Entertainment ("applicant").

The Board may, upon its initiative, resolve a motion filed in an inter partes proceeding by telephone conference. *See* Trademark Rule 2.120(i)(1); TBMP § 502.06(a) (2014). On October 27, 2014, the Board convened a telephone conference to resolve the issue(s) presented in the motion. Participating were J-Lynn Entertainment, LLC's ("opposer") acting member/officer and representative Mr. Neadom Medina, applicant's counsel Mr. Matthew Swyers, and the assigned Board attorney.

The Board has reviewed the parties' arguments and submissions, but for efficiency does not restate them in their entirety. This order summarizes, as necessary, the Board's analysis and findings based on the briefs and any clarifications provided during the conference.

As an initial matter, as the Board noted in the conference, both Mr. Medina and Mr. Swyers initiated ex parte telephone calls to the assigned Board attorney, and sent ex parte emails that deleted the other party, all being communications pertaining in some respect to this proceeding. Ex parte contacts with the Board are inappropriate and outside the purview of a Board proceeding. *See* Rule 11.305; TBMP § 105 (2014). In the event that either party initiates such contact in the future, said party should be prepared to set forth in detail the steps which the party has taken to secure the inclusion or participation of the other party.

Turning to applicant's motions, in view of opposer's October 27, 2014 agreement to cancel the deposition of William T. Odonnell, Sr. (filed with opposer's response to the motions to quash), which the Board construes as a withdrawal of the notice of deposition of Mr. Odonnell, Sr., applicant's motion to quash opposer's notice of deposition of Mr. Odonnell, Sr. is now moot.

With respect to the remaining notices of deposition at issue, Trademark Rule 2.123(c) provides, in pertinent part:

Before the depositions of witnesses shall be taken by a party, due notice in writing shall be given to the opposing party or parties, as provided in § 2.119(b), of the time when and place where the depositions will be taken, of the cause or matter in which they are to

be used, and the name and address of each witness to be examined; if the name of a witness is not known, a general description sufficient to identify the witness or the particular class or group to which the witness belongs, together with a satisfactory explanation, may be given instead. Depositions may be noticed for any reasonable time and place in the United States.

Objections to a testimony deposition based upon improper or inadequate notice may be raised by a motion to quash. *See, e.g., Duke University v. Haggard Clothing Co.*, 54 USPQ2d 1443, 1444 (TTAB 2000). Raising such objections by means of a motion to quash may avoid the time and expense of taking the deposition in the event the motion is granted, and further leaves open the possibility that such deposition could be rescheduled with more appropriate notice. Whether a notice of deposition is reasonable depends on the circumstances of each case. *See* TBMP § 521 (2014).

The parties clarified that opposer did not take discovery depositions of the individuals whom it wishes to depose during its trial period, that opposer identified the individuals it seeks to depose in its pretrial disclosures, and that each of the individuals lives within the United States. The parties also clarified that they have not stipulated to take testimony by affidavit, but did stipulate to take depositions by telephone.<sup>1</sup>

Mr. Swyers clarified that applicant's motion is based on the following objections to the adequacy of the notices of deposition, namely, that they: 1)

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<sup>1</sup> The Board notes opposer's October 17, 2014 filing of its motion for trial depositions by phone. In view of the parties' confirmation of this stipulation, said motion is granted. *See* Fed. R. Civ. P. 30(b)(4); TBMP § 703.01(h) (2014).

fail to provide proper and adequate notice;<sup>2</sup> 2) impermissibly set forth prejudicial and libelous matters in the preamble paragraphs to the notices to depose the six non-party witnesses; and 3) fail to provide with required specificity the details regarding the person(s) before whom the depositions will be taken, the location of such person(s), the person(s) authorized to administer the oaths, and the manner in which the depositions will be transcribed for entry into the record.<sup>3</sup> See Fed. R. Civ. P. 28(a); Trademark Rules 2.123(d) and (e).

Furthermore, inasmuch as applicant's motion placed the sufficiency of opposer's notices in issue, the Board reviewed them in their entirety, including the notice of deposition of Mr. Odonnell, Jr. Specifically, the Board reiterated the nature of and elements of the sole pleaded ground for opposition and the sole pleaded ground for cancellation (*see* August 19, 2014 order, p. 1-2), and noted that the evidence that the Board expects opposer to introduce is that which is probative of and relevant to these grounds. The list of topics included with each notice of deposition contains several topics

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<sup>2</sup> The parties dispute the number of days of notice that opposer provided for the October 28, 2014 deposition of applicant, Mr. Odonnell, Jr., inasmuch as the notice itself includes a certificate of service that indicates service of a "notice of reliance" by first class mail on October 16, 2014, and counsel for applicant states that he did not receive this service copy. The Board clarified for Mr. Medina that the *filing* of this and other notices with the Board on October 17, 2014 did not, as contended, constitute service thereof. Furthermore, opposer apparently emailed the notice to applicant's counsel on October 23, 2014, which applicant's counsel acknowledges. In any event, the Board, upon consideration of all circumstances, has quashed the notice, and directed the parties to clarify the method of service for all future notices of deposition so as to avoid further disputes of this nature.

which are not appropriate for a non-party witness and/or are not relevant to opposer's pleaded grounds. Accordingly, opposer's attention to the list is necessary.

With respect to the testimony depositions of the six non-party individuals, the Board finds that applicant's objections are well-taken and are supported by the record. Furthermore, Mr. Medina indicated that some or all of said witnesses may be unwilling to appear voluntarily to testify, and that he has commenced or plans to commence subpoena proceedings, as appropriate.

Having considered all of the circumstances, the Board finds that opposer's notice is insufficient. In view of these findings, applicant's motion to quash is granted, and the notices are hereby quashed.

With respect to the notice of testimony deposition of applicant William Odonnell Jr., noticed to take place on the morning of October 28, 2014, the Board finds that opposer failed to provide due notice, and that the notice repeats several of the same insufficiencies that are in the notices to depose the non-parties. Furthermore, it is unclear whether Mr. Odonnell is a willing party witness, that is, willing to appear voluntarily; thus, it is unclear whether opposer would need to secure his attendance by subpoena, and the status of any such proceedings.

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<sup>3</sup> Applicant asserts that the statement in the notices that the depositions will be "recorded by audio recording" fails to comply with governing rules. Applicant's argument is well-taken.

Having considered all of the circumstances, the Board finds that opposer's notice is insufficient. In view of these findings, the notice of deposition is hereby quashed.

Opposer shall serve reissued notices of deposition, as appropriate, which provide due notice, and which address and correct the deficiencies noted herein, including deletion of any statements or matters regarding the merits of opposer's case and alleged activities on the part of applicant, addition of proper details regarding how the depositions will take place and will be transcribed, and attachment of a narrowed list of topics tailored to each respective individual deponent.

As a final matter, in the conference, the parties stipulated that service of notices of testimony deposition shall be by email.<sup>4</sup>

Schedule

By stipulation of the parties during the conference, trial dates are reset as follows:

Plaintiff's 30-day Trial Period Ends	<b>12/20/2014</b>
Defendant's Pretrial Disclosures	<b>1/4/2015</b>
Defendant's 30-day Trial Period Ends	<b>2/18/2015</b>
Plaintiff's Rebuttal Disclosures	<b>3/5/2015</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>4/4/2015</b>

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

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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.

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<sup>4</sup> Opposer is directed to be mindful of the accuracy of the information set forth in the certificates of service.