

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

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Mailed: August 2, 2016

Opposition No. **91212445**

*Red Bull GmbH*

*v.*

*Bullson Co., Ltd.*

**Yong Oh (Richard) Kim, Interlocutory Attorney:**

This opposition proceeding was instituted on September 12, 2013, based on a notice of opposition that was filed on September 9, 2013. Approximately six months later on March 17, 2014, Opposer filed a consented motion to extend all remaining dates, beginning with the expert disclosure due date, by sixty days. On April 23, 2014, Opposer filed a second consented motion to suspend this matter for ninety days for the purpose of settlement and provided a revised schedule wherein Opposer's testimony period opened on December 17, 2014.

On December 23, 2014, Opposer filed an unconsented motion to reschedule the close of its testimony period by sixty days. Applicant opposed the motion. On May 7, 2015, the Board granted the motion and reset the opening of Opposer's testimony period to May 18, 2015. On May 28, 2015, Opposer filed notice of taking the testimony deposition on written questions

of Jorge Casals, an employee of Opposer who presumably would not be present in the United States at the time of the deposition. *See* Trademark Rule 2.123(a)(2). Concurrently with the filing of the notice, Opposer filed a consented motion for a further thirty-day extension of its testimony period to facilitate the taking of the foreign deposition as well as additional domestic depositions. The extension of time was granted on May 29, 2015, and the Board suspended the proceeding on July 6, 2015, to allow for the orderly completion of the foreign deposition and ordered Opposer to advise the Board within thirty days of its completion.

On January 25, 2016, the Board inquired as to the status of the deposition. On February 24, 2016, Opposer noted that “Austria is not a member of the Hague Convention and additional and further processing is required beyond the normal foreign deposition,” that it has been “in the process of obtaining the additional supporting documents required by the Austrian government,” that it has “been consulting with foreign counsel in Austria so that the request will comply with Austrian laws and be granted by the Austrian government,” and that it “will submit a proposed Letters Rogatory to the TTAB” as “soon as the papers are in proper form and approved by Austrian counsel.” *Opposer’s Response*, 19 TTABVUE 2. On March 7, 2016, Applicant filed its opposition to the continued suspension of this matter and cross-moved to terminate this proceeding for Opposer’s failure to prosecute and on March 28, 2016, Opposer filed a reply and

opposition to the cross-motion.<sup>1</sup> The Board finds Applicant's opposition well taken.

Over a year has passed since Opposer filed notice of taking the deposition of Jorge Casals on written questions and the deposition has yet to take place. The Board finds these circumstances unacceptable. Opposer's testimony period opened on December 17, 2014. Shortly thereafter, Opposer sought and was granted a sixty-day extension and a further thirty-day extension as of May 29, 2015. When the Board inquired as to the status of the foreign deposition over six months later, Opposer took another month to respond to the Board's inquiry, which response was simply to inform the Board of the difficulties encountered in taking the deposition on written questions of its foreign witness.

Notwithstanding the procedural hurdles associated with the taking of a foreign deposition, Opposer has provided little explanation as to why it has yet to take the testimonial deposition of its own employee. While the Board is mindful of the difficulties and attendant delay with the letter rogatory procedure, it is wholly unclear why Opposer needs to resort to such an "uncertain and onerous" procedure, *see Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998), to present its own evidence. Even with the delay and putative efforts made by Opposer to take this deposition, there is no

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<sup>1</sup> Although the reply deadline to Applicant's filing is March 27, 2016, *see* Trademark Rules 2.119(c) and 2.127(a), the filing is timely pursuant to Trademark Rule 2.196.

certainty that, when all is said and done, the deposition of Mr. Casals may even be taken in Austria. *See Applicant's Opposition*, 20 TTABVUE 7-8.

In view thereof, the Board will not countenance any further delay in the completion of Opposer's testimony in chief. Proceedings herein are **RESUMED** and Opposer's trial period will close on **AUGUST 30, 2016**. No further extensions of this deadline will be allowed unless consented to by Applicant. In keeping with this directive, Opposer's testimonial deposition, if taken, of Mr. Casals (or any other official or employee of Opposer not in the United States), will be by oral examination. If the foreign deposition is not permitted under the law of the foreign jurisdiction, it may be necessary for Opposer to take the deposition of its witness in the United States or else forego the testimony of that witness. The Board will not order a foreign-resident witness to appear for a deposition in the United States. *See Jain*, 49 USPQ2d at 1431. Since Opposer's testimony period has yet to close, Applicant's cross-motion to dismiss this matter for failure to prosecute is **DENIED** as premature.

Dates are **RESET** as follows:

Plaintiff's 30-day Trial Period Ends	<b>8/30/2016</b>
Defendant's Pretrial Disclosures Due	<b>9/14/2016</b>
Defendant's 30-day Trial Period Ends	<b>10/29/2016</b>
Plaintiff's Rebuttal Disclosures Due	<b>11/13/2016</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>12/13/2016</b>

**IN EACH INSTANCE**, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party

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within **THIRTY DAYS** after completion of taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 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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