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

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| Proceeding | 91213597 |
| Party | Defendant Tigercat International Inc. |
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| Attachments | APPLICANT'S MOTION AND MEMORANDUM TO ATTEND AND TAKE DEPOSITIONS BY VIDEO CONFERENCING (M1379298).pdf(442880 bytes) |

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

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| CATERPILLAR INC., | : | |
| | : | |
| OPPOSER, | : | |
| | : | |
| v. | : | Opposition No. 91213597 |
| | : | |
| TIGERCAT INTERNATIONAL INC. | : | |
| | : | |
| APPLICANT. | : | |

**APPLICANT’S MOTION AND MEMORANDUM IN SUPPORT OF
ITS MOTION FOR LEAVE
TO ATTEND AND TAKE DEPOSITIONS BY VIDEO CONFERENCE**

Applicant, Tigercat International Inc. (“Tigercat” or “Applicant”), by its undersigned counsel and pursuant to Fed. R. Civ. P. 30(b)(4), hereby moves the Board to enter an order granting Tigercat leave to attend and take discovery depositions remotely, specifically by video conference. The parties have been unable to agree to this manner of taking depositions, as set forth more particularly below.

I. STATEMENT OF ISSUE.

The issue before the Board is whether or not Tigercat should be granted leave to attend and take discovery depositions by video conference, when such leave will minimize the undue burden and cost of travelling to four different states, distant from each other and the locations of the parties’ counsel, and there will be no prejudice to the witnesses, as the locations of the depositions are not in issue and will be within one hundred (100) miles of their residence or place of employment, as required under FRCP 45(c)(1)(A) and there will be no prejudice to Opposer since its counsel may attend and participate in person at such depositions.

II. GIVEN THE DISPARATE LOCATIONS OF WITNESSES AND OPPOSER'S OWN ELECTION TO TAKE CERTAIN DEPOSITIONS TELEPHONICALLY, TIGERCAT SHOULD BE GRANTED LEAVE TO TAKE VIDEO CONFERENCE DEPOSITIONS.

Tigercat served Opposer with Notices of Deposition for Mr. Tisdale, Mr. Stembridge and a 30(b)(6) Notice for Opposer on August 26, 2014, prior to the case being suspended for Tigercat's Motion to Compel Discovery Responses. (the "Notices"), (See Declaration of John Metzger Exs. A, B and C, hereinafter Metzger Dec. Ex. __). The Notices, re-served on April 17, 2015, called for depositions the week May 4, 2015. (Metzger Dec. Ex. D). The discovery schedule in effect at that time set a close of discovery of May 13, 2015. On April 21, 2015, a consented thirty day extension of deadlines was filed, which moved the close of discovery to June 12, 2015. On April 23, 2015, Opposer's counsel sent an e-mail stating that depositions noticed for the week of May 4, 2015 would not work for Opposer. (Metzger Dec. Ex. E). Opposer identified Mr. Edward Stembridge and Ms. Lantz Rickard as the witnesses for the 30(b)(6) deposition, who along with Mr. Tisdale, were to be produced in Peoria, Illinois.

After April 23, 2015, counsel for Tigercat engaged in numerous communications with counsel for Opposer attempting to schedule depositions of Opposer's employees. The depositions of Kurt Tisdale, Ed Stembridge, and Diane Lantz-Rickard are all noticed for a location in Peoria, Illinois, where Opposer's counsel stated they would be produced. (Metzger Dec. Ex. F). Tigercat understands that Peoria is a location where each of the individuals regularly transacts business in compliance with FRCP 45(c)(1)(A). Tigercat raised the issue of travel burden for counsel in connection with depositions in Peoria, Illinois and sought to have the depositions scheduled to be taken in the same week. Opposer has refused to make the three Caterpillar witnesses available

during the same week. (Metzger Dec. Ex. F).

Tigercat also seeks to take discovery depositions of the three individuals Opposer has put forth as “experts”: Roy Chipley, located in Florence, South Carolina; Dave Foster, located in Henniker, New Hampshire and Terry Moren, located in Longview, Texas. (Metzger Dec. Exs. G, H, and I). Tigercat could subpoena these witness to appear at locations much more convenient for Tigercat’s counsel which have major or regional airports and that are within 100 miles of where the witness resides, is employed or regularly transacts business in person, as provided for in FRCP 45(c)(1)(A), but such locations would be less convenient for the witnesses. Tigercat could subpoena Mr. Chipley to travel to Columbia, South Carolina (82.7 miles), Mr. Foster to travel to Boston, Massachusetts (81.2 miles) and Mr. Moren to travel to Shreveport, Louisiana (65.1 miles) (Metzger Dec. Exs. J, K, and L). Tigercat has not elected to do so if Tigercat can proceed by video conference deposition.

Tigercat has repeatedly sought Opposer’s consent to take the depositions of these three individuals by video conference and to set dates for these depositions during conference calls with counsel for Opposer. Counsel for Tigercat has tried to accommodate Opposer’s counsel on scheduling for these individuals but has been met with no cooperation. On May 18, 2015, when it was still unclear to the parties the dates for close of discovery and pre-trial disclosures, counsel for Opposer sought consent to a sixty day extension of discovery. Counsel for Tigercat did not consent to the extension, but consented to depositions being taken out of time through and including June 26th , one month prior to the pre-trial disclosure deadline then in place, and to take the depositions of these three individuals during the weeks of June 16th and June 23rd. (Metzger Dec. Ex. F). On May 19, 2015, Counsel for Opposer stated: “We do not agree to grant an extension of the deposition deadline apart from the discovery deadline.” (Metzger Dec. Ex.

F). In a May 20, 2015 e-mail, counsel for Tigercat again sought to schedule these depositions with counsel for Opposer:

Given your unwillingness to agree to take depositions out of time, we will be deposing the three individuals Caterpillar offered as experts the week of June 8. Please let us know on what days each of the individuals are available for deposition. This will result in double tracking of depositions. Will you consent to video conferencing depositions of these witnesses that week? (Metzger Dec. Ex. F)

Counsel for Opposer responded on May 20, 2015 and stated: “We will reach out to Caterpillar’s experts regarding their availability the week of June 8. We will not consent to video conferencing of these witnesses.” (Metzger Dec. Ex. F). In this connection, it is worth noting that Opposer’s counsel stated in the April 23, 2015 e-mail regarding the unavailability of Caterpillar’s witnesses for depositions the week of May, that: “The depositions of Mr. McHugh and Mr. Berger will be by telephone.” (Metzger Dec. Ex. E). Mr. McHugh and Mr. Berger are Tigercat’s two expert witnesses. Tigercat’s expert witness, James Berger, is located in Chicago, Illinois and Tigercat’s expert witness, Brian McHugh, is located in Philadelphia, Pennsylvania. Tigercat made and makes no objections to Opposer taking Mr. Berger’s and Mr. McHugh’s depositions by telephone.

On May 28, 2015, the parties agreed that discovery is continuing, although whether or not the disclosure deadlines were still in effect was still an issue. Tigercat again engaged in a conference call about scheduling depositions in light of the various open discovery issues. Tigercat also raised again the issue of video depositions given the travel schedule to Peoria and the unavailability of the three Caterpillar witnesses during the same week. No agreement on scheduling or video conference depositions has been reached and counsel for Tigercat informed counsel for Opposer of their intention to move the Board for leave since no agreement could be

reached.

On May 28, 2015, after the conference call, in an e-mail, counsel for Opposer offered a video conference deposition for Mr. Tisdale, but only on the conditions that Tigercat, a Canadian corporation, waive its rights with respect to deposition on written questions and have its foreign based non-United States resident representatives for Opposer's 30(b)(6) deposition travel to Opposer's counsel's office in Washington, D.C. to be deposed. (Metzger Dec. Ex. M). To condition consent to one video conference deposition out of six on the prejudicial waiver of a foreign applicant's rights with respect to deposition on written questions is not an acceptable proposal and demonstrates a continued lack of cooperative conduct. Counsel for Tigercat rejected such offer. (Metzger Dec. Ex. N).

In a June 1, 2015 letter, Opposer states: "Caterpillar withdrew its offer to depose Mr. McHugh and Mr. Berger via telephone when more time was available and volunteered to travel to Chicago and Philadelphia for these depositions." (Metzger Dec. Ex. O). Counsel for Applicant has no record or recollection of any such "offer" or "withdrawal of an offer". Opposer's Notices of Deposition state: "Opposer . . . will take the deposition upon oral examination . . . The deposition(s) will continue day-to-day until such time as completed and will be recorded by stenographic, audio, video or other means." (Metzger Dec. Ex. P). In the June 1, 2015 letter, Opposer also stated: "Caterpillar will object to any motion to the Board to proceed on video depositions." (Metzger Dec. Ex. O).

Tigercat now seeks leave from the Board to take and attend the depositions by video conference of Kurt Tisdale, Ed Stembridge, Diane Lantz-Rickard, Roy Chipley, Dave Foster, and Terry Moren.

III. USE OF TECHNOLOGY TO TAKE DEPOSITIONS BY REMOTE MEANS IS ENCOURAGED BY THE BOARD AND FEDERAL COURT PRACTICE.

The Board may grant leave to a party to take or attend a deposition by telephone or other remote means, such as video conferencing. Fed. R. Civ. P. 30(b)(4); TBMP §404.06.

Fed. R. Civ. P. 30(b)(4) provides:

The parties may stipulate – or the court may on motion order – that a deposition be taken by telephone or other remote means. For the purpose of this rule and Rules 28(a), 37(a)(2) and 37(b)(1), the deposition takes place where the deponent answers the questions.

Likewise, TBMP §404.06, states: “On stipulation of the parties, or on motion granted by the Board, a deposition may be taken or attended by telephone or other remote means, such as video conferencing.” The Board regularly allows parties to conduct depositions telephonically or by video conference. *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1654 (TTAB 2007). The Board has long recognized that federal practice favors the use of technology to promote flexibility, simplification of procedure and reduction of cost to parties. *Hewlett Packard Co. v. Healthcare Personnel Inc.* 21 USPQ2d 1552, 1553 (TTAB 1991). In his June 1, 2015 letter, Opposer’s counsel misapplies the law regarding the location of a deposition with the law regarding the factors to be considered regarding the manner of depositions and specifically depositions by remote means. FRCP 45(c)(1)(A) mandates the location of the deposition must be within 100 miles of the residence or place of employment of the witness. Tigercat does not seek to change the locations for the depositions proposed by Opposer or leave otherwise to require the deponents to travel beyond the area permitted by the applicable Rule. With respect to the three individuals Opposer has identified as experts, Tigercat has specifically sought to take depositions by video conference in the locations in which individuals conduct business as set forth in their reports (Metzger Dec. Exs. G, H, and I) There is no prejudice to the witnesses in this circumstance. What Tigercat seeks

is leave to have its counsel attend and take the deposition by video conference. The proper analysis here looks to the costs and travel for counsel related to such depositions, and it is based on those factors that Tigercat seek its leave. *Hewlett Packard Co. v. Healthcare Personnel Inc.* 21 USPQ2d 1552, 1553 (TTAB 1991)

Granting of leave to take depositions by remote means should be granted unless the non-moving party shows harm or prejudice arising therefrom. *Hewlett Packard Co. v. Healthcare Personnel Inc.* 21 USPQ2d 1552, 1553 (TTAB 1991).

In this case, video conference depositions are appropriate. No harm or prejudice to the witnesses or Opposer would result from a video conference deposition; the deposition would be transcribed in the same manner as an in-person oral deposition, the witnesses would still see and hear counsel for Tigercat, counsel for Opposer would still have the opportunity to observe and cross-examine the witness, and such an order does not prohibit counsel for Opposer from travelling to be with the witness and attend in person, if counsel so chooses. In the June 1 2015 letter, Opposer misconstrues the technology of a video conference deposition, since contrary to Opposer's contention, video conference depositions, unlike telephonic depositions, permit the witness and counsel who is or are remote to see as well as hear one another. Opposer's Notices of Deposition for McHugh and Berger, served on May 12, 2105, state: "Opposer . . .will take the deposition upon oral examination . . . The deposition(s) will continue day-to-day until such time as completed and will be recorded by stenographic, audio, video or other means" and contain no statements to contradict Opposer's April 23, 2015 e-mail stating: "The depositions of Mr. McHugh and Mr. Berger will be by telephone." (Metzger Dec. Ex. E). There was no discussion between counsel for the parties of whether Opposer would travel or not. It is and was counsel for Opposer's choice. The attempt by Opposer in its June 1, 2015 letter to characterize the facts as anything other

than above is simply not accurate and does not alter the fact that there is no prejudice to either Opposer or the witnesses if the deposition of each is taken by Tigercat by video conference. Opposer cannot now credibly claim it would be unduly prejudiced if Tigercat takes depositions by video conference. That Opposer changed its mind about how it wanted to take the depositions of Tigercat's experts is immaterial to whether or not it is prejudiced in any way by Tigercat taking the depositions of Opposer's representatives and witnesses by video.

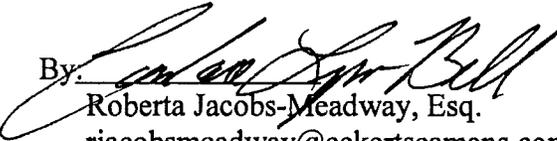
Tigercat's counsel are located in Philadelphia, Pennsylvania and Buffalo, New York. Opposer's counsel are located in Reston, Virginia and Boston, Massachusetts. What Opposer has offered would compel counsel to travel to Peoria, Illinois, more than once, Florence, South Carolina, Henniker, New Hampshire and Longview, Texas, unless Tigercat notices depositions in such a manner to compel the witnesses to travel within the geographic bounds set forth in FRCP Rule 45(c)(1)(A). These four locations all are approximately an hour and a half to a two and a half hour drive from the major airports of Chicago, Illinois, Charlotte, North Carolina, Boston, Massachusetts and Dallas, Texas. (Metzger Dec. Ex. Q) Flying into these airports would require counsel to seek ground transportation to reach the deposition location which would further increase costs. The locations are closer to regional airports in Peoria, Illinois, Florence, South Carolina, Manchester, New Hampshire and Shreveport, Louisiana, but the need to make connecting flights, the layover times and the more limited flight times are likely to require counsel to secure overnight accommodations potentially for one if not two nights. (Metzger Dec. Exs. R and S) Taking into consideration the travel distances for counsel for both parties, the overnight accommodations for counsel who will be travelling, and the substantial costs that accompany such travel, Tigercat seeks to avoid what should be unnecessary costs of attending in person to take depositions in four states by seeking leave to take such depositions by video conference, which manner of deposition does

not prejudice the witnesses or Opposer.

IV. CONCLUSION

In circumstances where travel and the costs associated therewith , can be avoided, without prejudice to the witnesses or the other side, the requesting party is entitled to leave to take discovery depositions by remote means and for an order granting such leave. Tigercat respectfully requests the Board issue an order granting leave for Tigercat to attend and conduct its discovery depositions in this case by video conference.

Respectfully submitted, this 3rd day of June, 2015.

By: 

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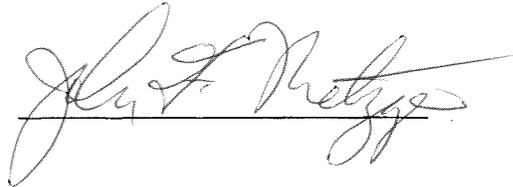
CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of Applicant's Motion to Leave to Attend and Take Depositions by Video Conference was served on counsel for Opposer listed below via electronic mail, as agreed to by the parties, with a courtesy copy sent by U.S. mail:

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Dated: June 3, 2015

A handwritten signature in black ink, appearing to read "Christopher P. Foley", is written over a horizontal line.