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

Proceeding	91213597
Party	Defendant Tigercat International Inc.
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Attachments	APPLICANT'S MOTION TO QUASH NOTICE OF DEPOSITION OF TIGERCAT INTERNATIONAL (M1383840).pdf(414607 bytes)

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

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

APPLICANT'S MOTION TO QUASH OPPOSER'S 30(b)(6) NOTICE OF DEPOSITION OF TIGERCAT INTERNATIONAL INC. AND SUPPORTING MEMORANDUM

Applicant, Tigercat International Inc. ("Tigercat" or "Applicant"), by its undersigned counsel and pursuant to Trademark Rules §§2.120(c) and 2.124, 37 CFR §§2.120(c) and 2.124, and TBMP §§404.03(b) and 521, hereby moves the Board to quash Opposer's Notice of Deposition of Tigercat International Inc. pursuant to Rule 30(b)(6) of the Federal Rules of Civil Procedure.

I. STATEMENT OF ISSUE.

The issue before the Board is whether or not Opposer's 30(b)(6) Notice of Deposition of Tigercat, a Canadian corporation formed under the laws of the Province of Ontario, Canada, should be quashed since it improperly seeks to force the foreign natural persons who are the persons Tigercat designates under Rule 30(b)(6) to come to the United States for the taking of their depositions.

II. TIGERCAT'S 30(b)(6) REPRESENTATIVES ARE FOREIGN NATURAL PERSONS.

Opposer served Tigercat with a 30(b)(6) Notice for Deposition on May 11, 2015. The Notice set the time and place for the depositions as June 24, 2015 at 9:00 am at the Embassy Suites Buffalo, 200 Delaware Avenue, Buffalo, New York 14202, or at a location to be mutually agreed upon by the parties with respect to the matters set forth in the attached Schedule A. (See Declaration of John Metzger Ex. A, hereinafter Metzger Dec. Ex. __). Counsel for Opposer and counsel for Tigercat continued discussions on the 30(b)(6) Notice for Tigercat from that time until June 1, 2015. In a June 1, 2015 letter, Opposer stated it "will be seeking the in-person deposition of Tigercat's witnesses through other means". (Metzger Dec. Ex. B).

Tigercat is a Canadian corporation formed under the laws of the Province of Ontario, Canada with its registered office in Cambridge, Ontario, Canada. (See Declaration of Kathy Billings Ex. A, hereinafter Billings Dec. Ex. __). The persons Tigercat designates under Rule 30(b)(6) as it representatives with the most knowledge of the subject matters listed in Schedule A of the Notice are employees of Tigercat Industries Inc. (See Declaration of Suzanne Cline ¶¶ 4-9, hereinafter Cline Dec. ¶ _ , Ex. _). Tigercat Industries Inc., is a Canadian corporation formed under the laws of the Province of Ontario, Canada with its registered office in Brantford, Ontario, Canada, and is a wholly owned subsidiary of Tigercat. (Billings Dec. Ex. B; Cline Dec. Ex. B) The persons Tigercat designates under Rule 30(b)(6) reside in Canada and are citizens of Canada and so are foreign residents. (Cline Dec. ¶¶ 4-9). Tigercat has no corporate presence in the United States and no officer, director, managing agent, or other person who is most knowledgeable of the subject matters listed in Schedule A of the Notice who consent to testify on its behalf residing in the United States. (Billings Dec. ¶¶ 8-10).

Prior to Opposer serving the Notice, Opposer's counsel and counsel for Tigercat engaged in conference calls and e-mail exchanges regarding the 30(b)(6) deposition of Tigercat. (Metzger Dec. Ex. C). Counsel for Tigercat reminded counsel for Opposer that Tigercat is a Canadian corporation with corporate representatives who are Canadian and reside in Canada. Tigercat has proposed the depositions be on written questions, as provided for in Trademark Rule §2.124, 37 CFR §2.124, by e-mail on May 18, 2015. (Metzger Dec. Ex. D). Opposer has persisted in seeking to force Tigercat's corporate representatives to appear in Buffalo, New York or in the alternative, Philadelphia, Pennsylvania, based on the mailing address of Tigercat's domestic representative named in the application which is the subject of this action. Counsel have exchanged correspondence on the issue but have not come to agreement on the manner of deposition for Tigercat. (Metzger Dec. Ex. E). Most recently, Opposer offered to take Tigercat's deposition in the Washington, D.C. office of Opposer's counsel. (Metzger Dec. Exs. F and G).

Tigercat now seeks to quash the improper 30(b)(6) Notice of Deposition served by Opposer.

III. OPPOSER MISTAKENLY INSISTS TIGERCAT'S FOREIGN CORPORATE REPRESENTATIVES CAN BE COMPELLED TO ATTEND A DEPOSITION IN THE UNITED STATES.

Opposer has discounted the established procedure for discovery depositions of foreign persons as provided for in the 37 CFR Part 2 "Rules for Practice in Trademark Cases". In an e-mail exchange, Opposer, as a basis for compelling the foreign residing natural persons Tigercat designates under Rule 30(b)(6) to attend depositions in the United States, has relied on *Rosenruist-Gestao E Servicos LDA v. Virgin Enters. Ltd.,* 85 USPQ2d 1385 (4th Cir. 2007). (Metzger Dec. Ex. H). The Court in *Rosenruist* held that a foreign corporation party to a Board proceeding at the UPSTO can be subject to an oral testimony deposition in the United States

when a subpoena is properly issued by a United States district court having jurisdiction over the foreign party. The decision in *Rosenruist* is not binding on the Board nor applicable in this matter.

The decision in *Rosenruist* was issued by the Fourth Circuit Court of Appeals. The TBMP sets forth decisional law in Board matters. TBMP §101.03 states:

> Proceedings before the Board are also governed, to a large extent, by precedential decisions in prior cases. These decisions include those of the Board itself, as well as the decisions of the Court of Appeals for the Federal Circuit (which determines appeals from decisions of the Board); the Court of Customs and Patent Appeals (predecessor of the Court of Appeals for the Federal Circuit); and the Director of The United States Patent and Trademark Office (formerly the Commissioner of Patents and Trademarks) ("Director"), who determines petitions seeking review of Board actions on procedural matters.

The Board is not bound by the *Rosenruist* decision; and there is no nexus between the Fourth Circuit and this proceeding.

Rosenruist is in any event distinguishable since the deposition at issue there was a testimonial deposition, not a discovery deposition. The aberrant decision in *Rosenruist* was subject to a lengthy dissent, has been heavily criticized, and has not been followed. *See TTABlog,* "Will the TTAB Follow the 4th Circuit's *Rosenruist* Ruling?", posted March 25, 2010 at http://thettablog.blogspot.com/2010/03/will-ttab-follow-4th-circuits.html; "Fourth Circuit Rules that Foreign Company Must Appear in the USA for TTAB Testimony Period Pursuant to E.D.Va. Subpoena". Posted January 2, 2008 at http://thettablog.blogspot.com/2008/01/fourth-circuit-rules-that-foreign.html. The Board has subsequently declined to follow *Rosenruist*, and has instead properly relied on Trademark Rule §2.120(c), Trademark Rule §2.124 and TBMP §§404.03(b) and 404.06(b). See, e.g., *White Wave Services, Inc. v. LBI Brands, Inc.*, Opposition No. 91179526 (TTAB Aug. 13, 2008); *Oxford Tutoring Inc. v. Oxford Learning Centres, Inc.*,

Cancellation No. 92048444, (TTAB Mar. 22, 2010).

Opposer has also sought in its communications with Applicant to rely on *Peer Bearing Co., v. Roller Bearing Co. of Am. Inc.*, Misc. Case 12-216, 2012 U.S. Dist. LEXIS 179782 (E.D. Pa. Dec. 19, 2012). (See Metzger Ex. E). The Court in *Peer Bearing* held a federal district court did not have the authority to issue subpoenas in an Opposition before the Board with respect to Petitions to Disqualify Counsel. The decision in *Peer Bearing* was issued by the Third Circuit Court of Appeals. For the reasons set forth in TBMP §101.03, the Board is not bound by the *Peer Bearing* decision. *Peer Bearing* is in any event distinguishable since the deposition at issue was related to a petition to disqualify counsel, not a discovery deposition in an opposition proceeding.

IV. TRADEMARK RULES GOVERN *INTER PARTES* PROCEEDINGS AND RULE §2.120(C) PROTECTS FOREIGN PERSONS FROM BEING FORCED INTO THE UNITED STATES FOR DEPOSITIONS.

Under 35 U.S.C. §2(b)(2)(A), Congress granted the USPTO broad authority to govern the conduct of proceedings before it. The Federal Circuit has held that §2(b)(2)(A): "is 'the broadest of the [USPTO's] rulemaking powers' and '[b]y this grant of power we understand Congress to have delegated plenary authority over [USPTO] practice to the [USPTO]'." *Cooper Techs. Co. v. Dudas,* 536 F.3d 1330, 1335 (Fed Cir. 2008) (quoting *Stevens v. Tamai*, 366 F.3d, 1325, 1333 (Fed Cir. 2004). Congress has also granted the USPTO the power to establish rules for taking affidavits and depositions required in the Patent and Trademark Office. 35 U.S.C. §23.

Under the authority granted to it by Congress, the USPTO has promulgated a number of rules governing the conduct of proceedings before it, including rules for trademark proceedings before the Trademark Trial and Appeal Board, as set forth 37 CFR Part 2, the "Rules for Practice in Trademark Cases." 37 C.F.R. §2.116(a) provides: "Except as otherwise provided (emphasis

added), and wherever applicable and appropriate, procedure and practice in *inter partes* proceedings shall be governed by the Federal Rules of Civil Procedure." If 37 CFR Part 2 "Rules for Practice in Trademark Cases" provides a procedure in *inter partes* proceedings, such as an opposition, the procedure is followed. If there is no procedure established in the "Rules for Practice in Trademark Case", the Federal Rules of Civil Procedure govern.

The discovery rules within 37 CFR Part 2 "Rules for Practice in Trademark Cases" protect foreign residents from having to travel to the United States to be deposed. Trademark Rule §2.120(c), 37 C.F.R.§2.120(c), states:

> The discovery deposition of a natural person residing in a foreign country . . . or who, at the time set for taking the deposition, is an officer, director or managing agent of a party, or a person designated under Rule 30(b)(6). . . . of the Federal Rules of Civil Procedure, shall, if taken in a foreign country, be taken in the manner prescribed by §2.124 (deposition on written questions) 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.

Rule §2.124 requires such deposition to be on written questions. Since the "Rules for Practice in Trademark Cases" provide a procedure, the Federal Rules of Civil Procedure do not govern.

Opposer's Notice seeks to compel the foreign residing natural persons Tigercat designates under Rule 30(b)(6) to travel to the United States for their depositions. As set forth in TBMP §404.03(b), "The Board will not order a natural person residing in a foreign country to come to the United States for the taking of his or her discovery deposition." See *Jain v. Ramparts Inc.,* 49 USPQ2d 1429, 1431(TTAB 1998), *Rhone-Poulenc Industries v. Gulf Oil Corp.* 198 USPQ 372, 374 (TTAB 1978), *White Wave Services, Inc. v. LBI Brands, Inc.*, Opposition No. 91179526 (TTAB Aug. 13, 2008); *Oxford Tutoring Inc. v. Oxford Learning*

Centres, Inc., Cancellation No. 92048444 (TTAB Mar. 22, 2010).

Opposer's 30(b)(6) Notice should be quashed pursuant to TBMP §521 since it improperly seeks to force foreign natural persons to come to the United States for the taking of their depositions.

V. TIGERCAT'S 30(b)(6) DEPOSITION MUST PROCEED ON WRITTEN QUESTIONS AS PROVIDED FOR IN TRADEMARK RULE §2.124.

The procedure for deposition of a foreign party provided for in the Trademark Rules is a deposition on written questions. Trademark Rule §2.124, 37 CFR §2.124 provides in part:

> (a) A deposition upon written questions may be taken before any person before whom depositions may be taken as provided by Rule 28 of the Federal Rules of Civil Procedure.
> (2) A party desiring to take a discovery deposition upon written questions shall serve notice thereof upon each adverse party and shall file a copy of the notice, but not copies of the questions, with the Board. The notice shall state the name and address, if known, of the person whose deposition is to be taken. If the name of the person is not known, a general description sufficient to identify him or the particular class or group to which he belongs shall be stated in the notice, and the party from whom the discovery deposition is to be taken shall designate one or more persons to be deposed in the same manner as is provided by Rule 30(b)(6) of the Federal Rules of Civil Procedure.

Tigercat has raised no objection to deposition by written question and requested Opposer proceed in this manner. Opposer has not withdrawn its Notice nor stated it would proceed with the deposition on written questions. Opposer will not be prejudiced by proceeding on written questions. Opposer was on notice that Tigercat was a foreign corporation based on the information in the pending application in this matter. Tigercat informed Opposer it was a Canadian corporation and would not produce its Canadian resident corporate representatives in the United States in discussions between counsel even prior to Opposer issuing its Rule 30(b)(6) Notice. (Metzger Dec. Ex. H). Since the case is currently under suspension, but discovery is

proceeding, there is no bar to Opposer serving such questions and complying with the procedures set out in Trademark Rule §2.124.

Opposer cannot show good cause for not proceeding with a deposition on written questions of Tigercat, since the natural persons Tigercat designates under Rule 30(b)(6) reside in Canada and there is sufficient time for Opposer to proceed on that basis.

VI. CONCLUSION

Opposer's Notice seeks to improperly force the foreign residing natural persons Tigercat designates under Rule 30(b)(6) to be deposed in the United States. Tigercat respectfully requests the Board issue an order quashing Opposer's Notice for Deposition of Tigercat, pursuant to FRCP Rule 30(b)(6). Should Opposer seek a deposition of Tigercat, it may do so on written questions as provided for in Trademark Rule §2.124.

Respectfully submitted, this 16th 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 Quash 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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