

ESTTA Tracking number: **ESTTA678480**

Filing date: **06/16/2015**

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

Proceeding	91213597
Party	Defendant Tigercat International Inc.
Correspondence Address	CANDACE LYNN BELL ECKERT SEAMANS CHERIN & MELLOTT LLC 50 S 16TH STREET, 22ND FLOOR PHILADELPHIA, PA 19102 2523 UNITED STATES cbell@eckertseamans.com, rjacobsmeadway@eckertseamans.com, lscollon@eckertseamans.com
Submission	Other Motions/Papers
Filer's Name	Candace Lynn Bell
Filer's e-mail	cbell@eckertseamans.com, rjacobsmeadway@eckertseamans.com, afleisher@eckertseamans.com
Signature	/Candace Lynn Bell/
Date	06/16/2015
Attachments	DECLARATION OF JOHN F. METZGER ISO MOTION TO QUASH OP-POSER'S NOTICE OF DEPOSITION (M1383842).pdf(259610 bytes) EXHIBIT A TO METZGER DECLARATION ISO MOTION TO QUASH (M1383829).pdf(189439 bytes) EXHIBIT B TO METZGER DECLARATION ISO MOTION TO QUASH (M1383830).pdf(306889 bytes) EXHIBIT C TO METZGER DECLARATION ISO MOTION TO QUASH (M1383831).pdf(198017 bytes) EXHIBIT D TO METZGER DECLARATION ISO MOTION TO QUASH (M1383832).pdf(36435 bytes) EXHIBIT E TO METZGER DECLARATION ISO MOTION TO QUASH (M1383833).pdf(927593 bytes) EXHIBIT F TO METZGER DECLARATION ISO MOTION TO QUASH (M1383834).pdf(36969 bytes) EXHIBIT G TO METZGER DECLARATION ISO MOTION TO QUASH (M1383835).pdf(327765 bytes) EXHIBIT H TO METZGER DECLARATION ISO MOTION TO QUASH (M1383836).pdf(2149920 bytes)

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING TRANSMITTED ELECTRONICALLY TO THE COMMISSIONER FOR TRADEMARKS - [HTTP://ESB.TA.USPTO.GOV/FILING-TYPE.JSP](http://esb.ta.uspto.gov/filing-type.jsp)

BY *John F. Metzger*

DATE: June 16, 2015

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.	:	

**DECLARATION OF JOHN F. METZGER IN SUPPORT OF APPLICANT’S MOTION
TO QUASH OPPOSER’S 30(b)(6) NOTICE OF DEPOSITION OF TIGERCAT
INTERNATIONAL INC**

1. I am a citizen of the United States, over 18 years old and a resident of Delaware County in the Commonwealth of Pennsylvania.
2. I am employed as a paralegal with Eckert Seamans Cherin & Mellott, LLC in Philadelphia, Pennsylvania.
3. I have worked as a paralegal since October of 1994 and was employed at Ballard Spahr Andrews & Ingersoll, LLP in Philadelphia, Pennsylvania from September 1997 until February 2008 when I joined the firm of Eckert Seamans Cherin & Mellott, LLC.
4. My duties include general, internet and legal research, litigation support, document review and analysis, document organization and control, and electronic discovery support among others.

5. As part of my duties as a paralegal, I maintain the pleadings and correspondence files in this opposition proceeding.

6. Attached as Exhibit A is a true and correct copy of Opposer Caterpillar Inc.'s Notice to Take Deposition of Tigercat International Inc. and Schedule A dated May 11, 2015.

7. Attached as Exhibit B is a true and correct copy of a letter sent by Christopher P. Foley, counsel for Opposer Caterpillar Inc., via email to Candace Lynn Bell, counsel for Tigercat International Inc., on June 1, 2015.

8. Attached as Exhibit C is a true and correct copies of an email sent by Laura Johnson, counsel for Opposer Caterpillar Inc. to Candace Lynn Bell and Roberta Jacobs-Meadway re: Deposition scheduling on April 23, 2015 at approximately 12:30 pm, a response sent by Candace Lynn Bell to Laura Johnson on April 24, 2015 at approximately 10:58 am, and a reply sent by Laura Johnson to Candace Lynn Bell on April 24, 2015 at approximately 12:01 pm.

9. Attached as Exhibit D is a true and correct copy of an email sent by Candace Lynn Bell to Christopher Foley and Laura Johnson re: Deposition Dates on May 18, 2015.

10. Attached as Exhibit E is a true and correct copy of a series of emails begun on May 18, 2015 at approximately 10:55 am through May 20, 2015 at approximately 4:25 pm between Candace Lynn Bell and Laura Johnson on the subject of Deposition Dates. This exhibit includes the May 20, 2015 attachment of Peer Bearing Co. v. Roller Bearing Co. of America, Misc. Case. No. 12-216, 2012 WL 6628038 (E.D. Pa. Dec. 19, 2012).

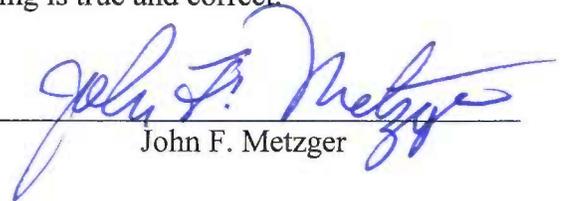
11. Attached as Exhibit F is a true and correct copy of an email sent by Christopher Foley to Candace Lynn Bell re: Discovery on May 28, 2015.

12. Attached as Exhibit G is a true and correct copy of an email sent by John Metzger to Christopher Foley and Laura Johnson re: Caterpillar/Tigercat Opposition on May 29, 2015,

and the accompanying attachments – a May 29, 2015 letter from Candace Lynn Bell to Christopher Foley and a copy of emails between Candace Lynn Bell and Laura Johnson on the subject of deposition scheduling.

13. Attached as Exhibit H is a true and correct copy of an email sent by Laura Johnson to Candace Lynn Bell and Roberta Jacobs-Meadway re: Notice of Deposition of Tigercat International Inc. on May 11, 2015 and the accompanying attachments – the May 11, 2015 Notice to Take Deposition of Tigercat International, Inc. and Rosenruist-Gestao E. Servicos LDA v. Virgin Enterprises, Ltd., 511 F.3d 437 (4th Cir. 2007).

I declare under penalty of perjury that the foregoing is true and correct.



John F. Metzger

Executed on: June 16, 2015
in Philadelphia, PA

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the attached Declaration of John F. Metzger in Support of Applicant's Motion to Quash Opposer's 30(b)(6) Notice of Deposition of Tigercat International Inc was served on counsel for the Opposer on the date listed below via electronic mail and a courtesy copy provided via U.S. Mail:

Christopher P. Foley
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.
901 New York Ave., N.W.
Washington, DC 20001-4413

Laura K. Johnson
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.
2 Seaport Boulevard
Boston, MA 02210

Dated: June 16, 2015

By: _____


John F. Metzger

EXHIBIT A

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

<p>CATERPILLAR INC.,</p> <p style="text-align: center;">Opposer,</p> <p style="text-align: center;">v.</p> <p>TIGERCAT INTERNATIONAL INC.,</p> <p style="text-align: center;">Applicant.</p>	<p>Opposition No. 91213597</p> <p>Application Serial No. 85/591,967 Mark: TIGERCAT Application date: April 8, 2012</p>
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NOTICE TO TAKE DEPOSITION OF TIGERCAT INTERNATIONAL INC.

PLEASE TAKE NOTICE that, pursuant to Rule 30(b)(6) of the Federal Rules of Civil Procedure, on June 24, 2015 at 9:00 am, Opposer Caterpillar Inc. (“Opposer” or “Caterpillar”) will take the deposition upon oral examination of Applicant Tigercat International Inc. (“Applicant” or “Tigercat”), by and through the officers, directors, managing agents, or other persons designated as being competent to testify on behalf of Defendant, at the Embassy Suites Buffalo, 200 Delaware Ave, Buffalo, NY 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, before a Notary Public or another person qualified by law to administer oaths.

The deposition(s) will continue day-to-day until such time as completed and will be recorded by stenographic, audio, video, or other means. You are invited to attend.

Dated: May 11, 2015

Respectfully submitted,

/Christopher P. Foley/

Christopher P. Foley
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.
901 New York Ave., N.W.
Washington, D.C. 20001-4413
Telephone: 202-408-4000
Facsimile: 202-408-4400

Laura K. Johnson
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.
2 Seaport Boulevard
Boston, MA 02210
Telephone: 617-646-1600
Facsimile: 617-646-1666

Attorneys for Opposer
Caterpillar Inc.

CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing NOTICE OF DEPOSITION OF TIGERCAT INTERNATIONAL INC. was served via electronic mail, upon counsel for Applicant, on May 11, 2015.

/Laura K. Johnson/

Laura K. Johnson

SCHEDULE A

DEFINITIONS AND INSTRUCTIONS

Caterpillar incorporates by reference the definitions and instructions set forth in Opposer's First Set of Interrogatories to Applicant served February 28, 2014.

TOPICS FOR EXAMINATION

1. The Products with which Applicant's Mark has been used, are currently used, and/or intend to be used from the date of first use of Applicant's Marks to the present.
2. The specifications and features of Applicant's Products and Services.
3. The applications and fields of use for Applicant's Products and Services.
4. Applicant's warranties to consumers relating to Applicant's Products and Services or the applications and fields of use for Applicant's Products and Services.
5. Applicant's product development and product expansion efforts in connection with goods offered or sold under Applicant's Mark.
6. The annual dollar volume and unit sales in the United States for products bearing or offered under Applicant's Mark from 2009 to the present.
7. Applicant's sale of goods in the forestry field for 2009 to the present.
8. Applicant's sale of goods in the off-road industrial field for 2009 to the present.
9. Applicant's sale of goods in outside of the forestry and off-road industrial fields for 2009 to the present.
10. The manufacturer's suggested retail price, wholesale prices (to Applicant's dealers), and actual selling prices of Applicant's Products and Services from 2009 to the present.
11. Applicant's annual dollar volume of advertising and promotional expenditures in the United States for products bearing or offered under Applicant's Mark from 2009 to the present.
12. Advertising and promotion of Applicant's Mark from 2009 to the present.
13. Applicant's advertising of machinery and equipment outside of the forestry field.
14. Applicant's advertising of machinery and equipment in the forestry field.

15. The channels of trade through which Applicant has marketed and offered, currently markets and offers, and intends to market and offer Applicant's Products and Services.

16. Trade shows at which Applicant has advertised, promoted, marketed, exhibited, offered, or sold Applicant's Products and Services.

17. Applicant's participation in any conferences or events in the forestry, agricultural, mining, vegetation management, off-road industrial, oil and gas, or construction fields.

18. The methods of distribution of Applicant's Products and Services from 2009 to the present.

19. Any meanings of Applicant's Mark.

20. Any use of Applicant's Mark in conjunction with feline imagery.

21. Any name or mark comprised of or containing the term "Cat" that Applicant has used or registered, or intends to use or register, apart from Applicant's Mark.

22. The categories, types, nature, and characteristics of distributors of products bearing Applicant's Mark from 2009 to the present.

23. The categories, types, nature, and characteristics of retailers of products bearing Applicant's Mark from 2009 to the present.

24. The categories, types, nature, and characteristics of customers of products bearing Applicant's Mark from 2009 to the present.

25. Any instance where a person has been confused, mistaken, or deceived about the source, affiliation, association, relationship, ownership, or sponsorship between Applicant's Mark and Opposer's Mark, or between products offered, promoted, or sold under those marks.

26. Any instance where a person has inquired whether an affiliation, connection, sponsorship, or relationship exists between Applicant's Mark or products offered under Applicant's Mark on the one hand and Opposer's Mark or products offered under Opposer's Mark on the other hand.

27. Any investigations, research, reports, surveys, focus groups, or studies relating to likelihood of confusion between Applicant's Mark and Opposer's Mark.

28. Any investigations, research, reports, surveys, focus groups, or studies conducted by or on behalf of Applicant that concern or relate to Applicant's Mark or Opposer's Mark.

29. All trademark searches, reports, research, or investigations obtained or conducted by or on behalf of Applicant concerning Applicant's Mark.

30. Objections Applicant has made to third parties' use and/or registration of marks, names, or designs based on Applicant's Mark.

31. Objections Applicant has received from third parties regarding Applicant's use and/or registration of Applicant's Mark.

32. All judicial and administrative proceedings involving or relating to Applicant's Mark other than this opposition proceeding.

33. Applicant's knowledge and awareness of Opposer's use of Opposer's Mark.

34. Applicant's knowledge and awareness of the fame of Opposer's Mark.

35. Applicant's knowledge and awareness of the public perception of Opposer's Mark.

EXHIBIT B

June 1, 2015

Candace Lynn Bell
Eckert Seamans Cherin & Mellott, LLC
50 S 16th Street, Floor 22
Philadelphia, PA 19102-2523

VIA E-MAIL

Caterpillar Inc. v. Tigercat International Inc.
T.T.A.B. Opposition No. 91213597

Dear Counsel:

We write in regards to your May 29, 2015 letter regarding deposition scheduling.

The parties spent the last six weeks diligently working to schedule fact and expert depositions. The Board's May 18, 2015 Order encouraged the parties to proceed with these depositions during stay of the proceedings. Tigercat waited until two business days before the first scheduled deposition to declare that it was refusing to participate in the scheduled fact and expert depositions.

Tigercat attempts to rationalize these last minute changes behind its claims of "outstanding" Caterpillar discovery. As evidenced below, no such delay has occurred. Even so, during the parties' numerous discussions, Tigercat never raised concerns about how this discovery could impact depositions. It is becoming readily apparent that Tigercat's true motivations are to frustrate and delay discovery, as well as the ultimate resolution of this matter.

Caterpillar Discovery

Tigercat spends an inordinate amount of its letter discussing Caterpillar's discovery responses. Caterpillar informed Tigercat in its May 13, 2015 Objections and Responses to Tigercat's Second Requests for the Production of Documents that it would produce representative, responsive, non-privileged documents to the extent that documents existed. Apart from the two documents produced today, which we uncovered last week, and those which can be found in Caterpillar's prior productions, Caterpillar's reasonable investigation of its business records has revealed no other representative, responsive, non-privileged documents. Caterpillar has supplemented its discovery responses to reflect this investigation.

Tigercat is premising its postponement of depositions on the production of documents that do not exist. Tigercat cannot continue to rely upon the false notion that Caterpillar is withholding discovery as a delay tactic for this case.

Caterpillar Witnesses

Tigercat noticed depositions for Ed Stembridge, Kurt Tisdale, and a 30(b)(6) witness. As Tigercat's own letter reflects, Tigercat adamantly pushed for dates of Caterpillar's fact witnesses since at least as early as April 17, 2015, and well after the Board's May 5, 2015 communication.

After discussion between counsel, Tigercat requested that Caterpillar's fact witnesses be made available the second and third weeks of June. Mr. Stembridge, Mr. Tisdale, and Ms. Diane Lantz Richards (one of Caterpillar's 30(b)(6) designees) are senior executives whose time is very valuable and who frequently travel from Peoria on business. Caterpillar was able to rework and coordinate these witnesses' schedules and on May 18, 2015, offered the witnesses for the following dates: Mr. Tisdale - June 2, Ms. Lantz Richard - June 4, and Mr. Stembridge - June 10th and 11th (in both his personal capacity and as the other 30(b)(6) designee).

Tigercat accepted these dates and offered every indication that it was moving forward with these depositions including:

- Counsel raised no objection to proceeding with fact witness depositions during the parties' May 18, 2015 telephone call with the Board.
- Counsel agreed to take the deposition of Caterpillar's witnesses on two separate weeks. *See* Bell email dated May 19, 2015.
- Counsel refused a 60-day extension of the discovery deadline before the Board clarified that discovery was stayed. *See* Bell email dated May 19, 2015.
- Counsel demanded identification of which witnesses would be covering each 30(b)(6) topic "no later than May 27." *See* Bell email dated May 19, 2015.
- Counsel demanded confirmation on May 26, 2015 that the witnesses would appear for their depositions. *See* Bell email dated May 26, 2015.
- Counsel finalized locations and times for these depositions. *See* Bell email, dated May 26, 2015.

To refuse to proceed with these depositions now is inexcusable. During the course of dozens of communications between the parties, Tigercat did not once object to these depositions or dates based on the perceived Caterpillar discovery deficiencies. In fact, during one telephone call between counsel, Tigercat informed Caterpillar that it would be proceeding with the depositions of Caterpillar's fact witnesses despite any outstanding discovery and that it would seek to reopen these depositions based on any subsequent production.

After having Caterpillar spend tremendous time and money to schedule and prepare its witnesses, Tigercat waited until less than two business days before the depositions were scheduled to commence to cancel them. We consider your conduct, as Tigercat's counsel, to be improper and unprofessional.

Tigercat claims in its letter that discovery is continuing. The cancellation of these depositions clearly evidence that Tigercat is willing to continue discovery only to the extent that is self-serving to their agenda and schedule.

Video Depositions

In April, the parties discussed the possibility of video depositions for expert witnesses. Caterpillar was initially receptive to this approach because it contemplated a very short deposition, particularly given the looming rebuttal report due date in May. 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. Further, in subsequently evaluating the logistical considerations of telephone depositions (i.e., the length of the depositions, the number of exhibits, the witnesses' familiarity with the legal process, the generally poor quality of telephonic transcription, etc.), it became clear that it will be more appropriate for both fact and expert witnesses to be deposed in person. Tigercat did not object to that change.

The simple truth is a face-to-face deposition is, in our opinion, most appropriate. The chief value of obtaining a deposition, as with any discovery proceeding, is to give all parties in a contested case a fair preview of the evidence. The process is designed to provide a level playing field of information among the litigants. Depositions, however, can become heated at times, with some attorneys asking harassing questions to provoke witnesses. When that happens, the playing field isn't level and the witness is at a distinct disadvantage. The imbalance is further distorted when the attorney is on a phone, and not face-to-face with the adverse witness. Given these considerations aimed at fundamental fairness, Caterpillar prefers in-person, face-to-face depositions, the standard procedure set forth in the Trademark Trial and Appeal Board Manual of Procedure.

Tigercat attempts to rationalize its request for fact and expert video depositions based on its own travel schedule. The rules contemplate having witnesses appear at locations convenient for the witnesses, not counsel.

During the parties' May 28, 2015 call, Tigercat raised objections about having to travel to Peoria twice. In a last ditch effort to have the Caterpillar depositions proceed, Caterpillar proposed a mutually-agreeable compromise whereby Mr. Tisdale was offered for deposition via video conference, if Tigercat would produce its 30(b)(6) witness for oral deposition in Washington, DC. While a solution to Tigercat's recently raised travel concerns, Caterpillar respects Tigercat's rights to refuse this request and will be seeking the in-person deposition of Tigercat's witnesses through other means.

Caterpillar will object to any motion to the Board to proceed on video depositions. Given the proceeding is stayed and that no deposition dates are currently scheduled, Tigercat should be able to obtain economical flights to the locations of each witness.

Expert Witnesses

Pursuant to the Board's schedule, the parties exchanged expert reports on April 13, 2015. Almost immediately, Caterpillar informed Tigercat that it intended to depose Tigercat's experts Mr. McHugh and Mr. Berger. The parties spent the next month exchanging telephone calls and written communications about available dates for these depositions and how those dates would impact the rebuttal deadline. During the parties' communications and the May 18, 2015 telephone call with the Board, Tigercat never once objected to proceeding with these depositions.

On May 20, 2015, Tigercat's counsel offered Mr. Berger for deposition in Chicago on June 5, 2015, and Mr. McHugh for deposition in Philadelphia on June 9, 2015. On May 26th and 27th, Caterpillar emailed counsel for Tigercat to confirm these dates.

On May 27, 2015, Ms. Bell informed Caterpillar that Tigercat would "not be proceeding with the depositions of our experts," stating that "(h)aving rebuttal expert disclosures due while fact discovery is ongoing, which discovery is likely to impact the information provided to and relied on by such experts is neither logical nor contemplated by the rules." *See* Bell, May 27, 2015 email. Tigercat was unable or unwilling to explain the basis for this position during the parties' May 28, 2015 call. Your May 29, 2015 letter simply states that Tigercat is unwilling to move forward with the depositions of Berger and McHugh with "fact discovery still open."

For the reasons discussed in detail below, Tigercat's position is inconsistent with the parties' prior discussions and Board practice, and, as such, appears simply to be another delay tactic.

First, Tigercat's refusal to offer Mr. McHugh and Mr. Berger for deposition with "fact discovery still open" violates Board rules that preclude discovery depositions after the close of discovery. *See* TBMP § 403.02.

Second, the Board intends that expert discovery take place while fact discovery is ongoing. This is clearly reflected in the Board's standard scheduling order requiring expert disclosures be served no later than 30 days prior to the close of discovery and rebuttal disclosures be served 30 days thereafter.

Third, Caterpillar seeks to depose Mr. Berger and Mr. McHugh on the subject matter of their reports, namely a likelihood of confusion survey and the public's linguistic perception of the CAT mark. Neither of these reports cite Caterpillar production materials. Even if there were outstanding fact discovery issues (which there are not), Tigercat has not explained how resolution of these issues may impact these depositions.

Fourth, the Board's May 18, 2015 Order specifically contemplates that "the parties may proceed to take fact discovery and expert discovery during the suspension." The Order in no way suggests that Tigercat can or should delay offering its expert witnesses for deposition.

Candace Lynn Bell
June 1, 2015
Page 5

Please promptly inform us of available dates for these experts. Caterpillar should not be forced to compel these depositions.

Sincerely,

Christopher P. Foley

Christopher P. Foley

CPF/LKJ

EXHIBIT C

John Metzger

From: Johnson, Laura <Laura.Johnson@finnegan.com>
Sent: Thursday, April 23, 2015 12:30 PM
To: Candace Lynn Bell; Roberta Jacobs-Meadway
Cc: Foley, Christopher; Reilly, Jenny; John Metzger
Subject: Deposition scheduling

Candace and Roberta,

We would like to schedule a call to discuss dates for the noticed Caterpillar depositions. The noticed dates will not work for Caterpillar.

Also, we plan on issuing deposition notices on Mr. McHugh, Mr. Berger, and a Tigercat 30(b)(6) witness. The depositions of Mr. McHugh and Mr. Berger will be by telephone. It would be productive to discuss available dates for these witnesses before we issue these notices.

Please let us know your availability today or tomorrow.

Thanks,
Laura

Laura K. Johnson
Attorney at Law
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
Two Seaport Lane, 6th Floor
Boston, MA 02210-2001
617.646.1645 | fax: 617.646.1666 | laura.johnson@finnegan.com
www.finnegan.com

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John Metzger

From: Candace Lynn Bell
Sent: Friday, April 24, 2015 10:58 AM
To: Johnson, Laura; Roberta Jacobs-Meadway
Cc: Foley, Christopher; Reilly, Jenny; John Metzger
Subject: RE: Deposition scheduling

Dear Laura

Can we schedule the call for Monday afternoon?
Please let me know your availability after 1:30.

Many thanks

Sincerely yours

Candace

Candace Lynn Bell, Esq. | Member
ECKERT SEAMANS CHERIN & MELLOTT, LLC
10 Bank Street • Suite 700 • White Plains, NY 10606
Direct (914) 286.6431 | Mobile (716) 835.0240
cbell@eckertseamans.com
eckertseamans.com | [bio](#) | [vCard](#)

From: Johnson, Laura <Laura.Johnson@finnegan.com>
Sent: Thursday, April 23, 2015 12:30 PM
To: Candace Lynn Bell; Roberta Jacobs-Meadway
Cc: Foley, Christopher; Reilly, Jenny; John Metzger
Subject: Deposition scheduling

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Please let us know your availability today or tomorrow.

Thanks,
Laura

Laura K. Johnson
Attorney at Law
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
Two Seaport Lane, 6th Floor
Boston, MA 02210-2001
617.646.1645 | fax: 617.646.1666 | laura.johnson@finnegan.com
www.finnegan.com

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John Metzger

From: Candace Lynn Bell [<mailto:CBell@eckertseamans.com>]
Sent: Friday, April 24, 2015 4:10 PM
To: Johnson, Laura; Roberta Jacobs-Meadway
Cc: Foley, Christopher; Reilly, Jenny; John Metzger
Subject: RE: Deposition scheduling

Dear Laura

We are also available at 4 on Monday.
Please circulate a call in number.

Many thanks

Candace

Candace Lynn Bell, Esq. | Member
ECKERT SEAMANS CHERIN & MELLOTT, LLC
10 Bank Street • Suite 700 • White Plains, NY 10606
Direct (914) 286.6431 | Mobile (716) 835.0240
cbell@eckertseamans.com
eckertseamans.com | [bio](#) | [vCard](#)

From: Johnson, Laura <Laura.Johnson@finnegan.com>
Sent: Friday, April 24, 2015 12:01 PM
To: Candace Lynn Bell; Roberta Jacobs-Meadway
Cc: Foley, Christopher; Reilly, Jenny; John Metzger
Subject: RE: Deposition scheduling

Candace,

We are available at 4 on Monday. If that timing works, we will give you a call then.

Thanks,
Laura

Laura K. Johnson
Attorney at Law
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
Two Seaport Lane, 6th Floor
Boston, MA 02210-2001
617.646.1645 | fax: 617.646.1666 | laura.johnson@finnegan.com
www.finnegan.com

From: Candace Lynn Bell [<mailto:CBell@eckertseamans.com>]
Sent: Friday, April 24, 2015 10:58 AM
To: Johnson, Laura; Roberta Jacobs-Meadway

Cc: Foley, Christopher; Reilly, Jenny; John Metzger
Subject: RE: Deposition scheduling

Dear Laura

Can we schedule the call for Monday afternoon?
Please let me know your availability after 1:30.

Many thanks
Sincerely yours
Candace

Candace Lynn Bell, Esq. | Member
ECKERT SEAMANS CHERIN & MELLOTT, LLC
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Direct (914) 286.6431 | Mobile (716) 835.0240
cbell@eckertseamans.com
eckertseamans.com | [bio](#) | [vCard](#)

From: Johnson, Laura <Laura.Johnson@finnegan.com>
Sent: Thursday, April 23, 2015 12:30 PM
To: Candace Lynn Bell; Roberta Jacobs-Meadway
Cc: Foley, Christopher; Reilly, Jenny; John Metzger
Subject: Deposition scheduling

Candace and Roberta,

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Please let us know your availability today or tomorrow.

Thanks,
Laura

Laura K. Johnson
Attorney at Law
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EXHIBIT D

John Metzger

From: Candace Lynn Bell
Sent: Monday, May 18, 2015 10:55 AM
To: Foley, Christopher; Johnson, Laura
Cc: Roberta Jacobs-Meadway; John Metzger
Subject: Deposition Dates

Dear Chris

Please confirm the deposition dates for Caterpillar's 30(b)(6) witnesses, and Mr. Tisdale. When last we spoke, you had stated depositions beginning on June 2 and continuing through the remainder of that week would work for those witnesses. Given this morning's call, I have rearranged my schedule again to make those dates work for me as well.

I am also checking on dates for Mr. Berger and Mr. McHugh. May 20 will not work for Mr. Berger's deposition.

With regard to Caterpillar's 30(b)(6) deposition for Tigercat, we have reviewed the case provided by Laura Johnson. We still disagree that Caterpillar may proceed with an oral discovery deposition in Philadelphia of a foreign entity or Canadian citizen resident in Canada. Please provide written questions for Tigercat's 30(b)(6) witnesses pursuant to 37 CFR 2.124.

Regards,
Candace

Candace Lynn Bell, Esq. | Member
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EXHIBIT E

John Metzger

From: Johnson, Laura <Laura.Johnson@finnegan.com>
Sent: Wednesday, May 20, 2015 4:25 PM
To: Candace Lynn Bell
Cc: Roberta Jacobs-Meadway; John Metzger; Foley, Christopher; Kilaru, Naresh; Reilly, Jenny
Subject: RE: Deposition Dates
Attachments: Deposition Notice of Gerald Smeak.pdf; Deposition Notice of Wayne Cale.pdf; Peer Bearing Co v Roller Bearing Co of Am Inc.rtf

Candace,

Out of an abundance of caution the parties should proceed with scheduling the expert and fact witnesses on or before June 12, 2015. We have a call into the Board seeking verification of the deadline, in view of the suspension order, and will provide an update once available.

Deposition Scheduling

Caterpillar currently intends to offer Ms. Lantz Rickard to cover Topic No. 2; however it reserves its rights to ask Ms. Lantz Rickard to cover additional topics.

Mr. Stembridge is not available on June 10th, only the 11th and 12th. This is not a date change on Mr. Stembridge's part. I mistranscribed the available dates in my earlier email.

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.

Please provide us with an update on dates for Berger and McHugh.

Finally, please see attached the Notices of Deposition of Wayne Cole and Jerry Smeak. These depositions are noticed for June 10th and 11th. We are prepared to triple track these depositions, if necessary. Please let us know if you will be able to discuss the availability of these witnesses tomorrow.

Tigercat 30(b)(6)

Caterpillar has yet to reach a decision regarding the Tigercat 30(b)(6) deposition, but the *Rosencruist* is hardly aberrational. The *Peer Bearing Co. v. Roller Bearing Co. of Am, Inc.* case (attached) evidences a Third Circuit court's affirmation of Caterpillar's interpretation of the *Rosencruist* case.

Caterpillar does not want to get into a discovery battle with Tigercat over its 30(b)(6) witness(es). It proposed an oral deposition to avoid the arduous and time consuming procedure of a deposition by written questions. Caterpillar could issue a subpoena requiring your client to travel to Pennsylvania for a deposition. Instead, it provided a convenient location only an hour away from your client's offices. In view of the *Peer Bearing* case, we ask that Tigercat reconsider its refusal.

We look forward to your prompt response.

Thanks,
Laura

Laura K. Johnson

Attorney at Law
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
Two Seaport Lane, 6th Floor
Boston, MA 02210-2001
617.646.1645 | fax: 617.646.1666 | laura.johnson@finnegan.com
www.finnegan.com

From: Candace Lynn Bell [<mailto:CBell@eckertseamans.com>]
Sent: Wednesday, May 20, 2015 8:51 AM
To: Johnson, Laura
Cc: Roberta Jacobs-Meadway; John Metzger; Foley, Christopher; Kilaru, Naresh; Reilly, Jenny
Subject: RE: Deposition Dates

Dear Laura

Please advise which topic will Ms. Lantz Rickard be covering.
Please confirm she will be available for as long as necessary until she is done on June 4. We would not anticipate the deposition requiring more than seven (7) hours.

We can take Mr. Stembridge's deposition on June 10 and 11 as in your original e-mail.
We cannot do the deposition on June 12.
Please confirm he will be available on June 10 and June 11, and we will endeavor to get the deposition done in one day on June 10.

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?

We disagree that the Board decisions included in our e-mail on the 30(b)(6) deposition are inapplicable to this Board proceeding. We view *Rosencruist* as an aberrational case. It is not a Third Circuit case in any event and has no precedential effect. We remain open to a discussion regarding timing of the deposition on written questions of Tigercat.

Regards,
Candace
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From: Johnson, Laura <Laura.Johnson@finnegan.com>
Sent: Tuesday, May 19, 2015 6:44 PM
To: Candace Lynn Bell
Cc: Roberta Jacobs-Meadway; John Metzger; Foley, Christopher; Kilaru, Naresh; Reilly, Jenny
Subject: RE: Deposition Dates

Candace,

Ms. Lantz Rickard will be covering one deposition topic and is only available on June 4th.

My email incorrectly identified the dates for Mr. Stembridge. He is available for deposition on June 11 and 12 in Peoria. Please confirm that these dates are acceptable.

We do not agree to grant an extension of the deposition deadline apart from the discovery deadline. If Tigercat refuses to an extension, we will proceed with closing expert rebuttals and discovery on June 12, 2015. Please ensure that all of Tigercat's fact and expert witnesses will be available during the discovery period.

Your 30(b)(6) case law is inapplicable as it interprets TTAB law and procedures, not federal law. The *Rosenruist* case addresses and rejects the very arguments you raise.

Caterpillar will provide you with an update on the format of the Tigercat 30(b)(6) deposition once a decision is made. If Caterpillar elects to proceed via written questions, the parties will need to discuss the response timing given the impending discovery deadline.

Thanks,
Laura

Laura K. Johnson
Attorney at Law
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From: Candace Lynn Bell [<mailto:CBell@eckertseamans.com>]
Sent: Tuesday, May 19, 2015 4:15 PM
To: Johnson, Laura
Cc: Roberta Jacobs-Meadway; John Metzger; Foley, Christopher; Kilaru, Naresh; Reilly, Jenny
Subject: RE: Deposition Dates

Dear Laura

We disagree with your characterization of the discussion regarding Caterpillar's witnesses and timing. We expected to take all depositions in Peoria during one week, as discussed. I only asked you to check on alternate availability.

Since we have dates, we will take the deposition of Mr. Tisdale on June 2nd, Ms. Lantz Rickard on June 4th and Mr. Stembridge on June 10th continuing if necessary until through June 11. Ms. Lantz Rickard may need to be continued through June 5th, as we do not know yet which topics she will be covering.

Please provide us with the list of topics for both 30(b)(6) witnesses no later than May 27th and please confirm that Ms. Lantz Rickard will be available on June 5th.

Tigercat does not consent to a sixty day extension of expert rebuttal and discovery deadlines. Tigercat will consent to depositions being taken out of time through and including June 26th. Tigercat will be noticing

depositions for Caterpillar's three witnesses named by it as experts for dates the week of June 16th and June 23rd, if you consent to depositions out of time.

I will have proposed dates for Berger and McHugh no later than close of business tomorrow.

Regarding the 30(b)(6) notice for Tigercat, pursuant to 37 C.F.R. 2.120(c)(1), "The discovery deposition of a natural person residing in a foreign country who is a party, 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) . . . shall, if taken in a foreign country, be taken in the manner prescribed by 2.124 . . ." Rule 2.124 requires such deposition on written questions. See e.g. Jain v. Ramparts Inc. 49 U.S.P.Q.2d 1429, 1431 (TTAB 1998); White Wave Services, Inc. v. LBI Brands, Inc., Opposition No. 91179526 (August 13, 2008); Oxford Tutoring Inc. v. Oxford Learning Centres, Inc. Cancellation No. 92048444, (October 4, 2010). Please confirm you will withdraw the notice of deposition or proceed with written questions in writing by close of business Thursday, May 21, 2015.

We will await your reply.

Regards,

Candace

Candace Lynn Bell, Esq. | Member

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From: Johnson, Laura <Laura.Johnson@finnegan.com>

Sent: Monday, May 18, 2015 8:08 PM

To: Candace Lynn Bell

Cc: Roberta Jacobs-Meadway; John Metzger; Foley, Christopher; Kilaru, Naresh; Reilly, Jenny

Subject: RE: Deposition Dates

Candace,

During our call last week, you requested that Caterpillar's witnesses be made available the second or third weeks of June. Mr. Stembridge has rearranged his schedule to accommodate this request. Based on previously discussed vacation and travel arrangements, Mr. Tisdale and Ms. Lantz Rickard are unavailable those weeks.

Accordingly, Caterpillar will make Mr. Tisdale available on June 2nd, Ms. Lantz Rickard available on June 4th, and Mr. Stembridge available on June 10th and if necessary continuing into the 11th. Ms. Lantz Rickard and Mr. Stembridge will be Caterpillar's 30(b)(6) witnesses. We will let you know which witness will be covering which topics closer to the deposition dates.

We disagree with your position regarding Tigercat's 30(b)(6) deposition and will be in touch regarding our plans for the deposition.

We look forward to an update regarding the availability of Mr. Berger and Mr. McHugh.

Finally, the scheduling of expert and fact depositions appears to be going into late June, at a minimum. To enable the parties sufficient time to take depositions, submit expert rebuttals, and address any outstanding discovery issues, please let us know whether Tigercat will agreed to a sixty-day extension of the expert rebuttal and discovery deadlines. Based

on our calculations, this would move both deadlines to August 11, 2015. If so, we will prepare the necessary stipulation for the Board.

We look forward to your response.

Laura

Laura K. Johnson

Attorney at Law

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Boston, MA 02210-2001

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From: Candace Lynn Bell [<mailto:CBell@eckertseamans.com>]

Sent: Monday, May 18, 2015 10:55 AM

To: Foley, Christopher; Johnson, Laura

Cc: Roberta Jacobs-Meadway; John Metzger

Subject: Deposition Dates

Dear Chris

Please confirm the deposition dates for Caterpillar's 30(b)(6) witnesses, and Mr. Tisdale.

When last we spoke, you had stated depositions beginning on June 2 and continuing through the remainder of that week would work for those witnesses.

Given this morning's call, I have rearranged my schedule again to make those dates work for me as well.

I am also checking on dates for Mr. Berger and Mr. McHugh.

May 20 will not work for Mr. Berger's deposition.

With regard to Caterpillar's 30(b)(6) deposition for Tigercat, we have reviewed the case provided by Laura Johnson. We still disagree that Caterpillar may proceed with an oral discovery deposition in Philadelphia of a foreign entity or Canadian citizen resident in Canada. Please provide written questions for Tigercat's 30(b)(6) witnesses pursuant to 37 CFR 2.124.

Regards,

Candace

Candace Lynn Bell, Esq. | Member

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2012 WL 6628038
Only the Westlaw citation is currently available.
United States District Court,
E.D. Pennsylvania.

PEER BEARING CO., Plaintiff,
v.
ROLLER BEARING CO. OF AM., INC.,
Defendant.

Miscellaneous Case No. 12–216. | Dec. 19, 2012.

Attorneys and Law Firms

Peer Bearing Company, pro se.

Dennis R. Callahan, Ward, Greenberg, Heller & Reidy,
LLP, Philadelphia, PA, John H. Mutchler, Middletown,
CT, for Defendant.

MEMORANDUM RE: MOTIONS TO QUASH SUBPOENAS

BAYLSON, District Judge.

I. Introduction

*1 Respondent Roller Bearing Company of America, Inc. (“RBC” or “Respondent”) seeks discovery in support of its petition to disqualify Peer Bearing Co.’s (“Peer”) counsel (the “Petition to Disqualify”) from Peer’s opposition (the “Peer Opposition”) to RBC’s trademark application that is currently pending before the United States Patent and Trademark Office (the “USPTO”) through two sets of subpoenas served on third parties pursuant to 35 U.S.C. § 24:

1. The first set of subpoenas seeks discovery from Movants Pepper Hamilton LLP and two Pepper Hamilton LLP attorneys, David Richman and Matthew D. Janssen; and
2. The second set of subpoenas seeks discovery from SKF USA Inc. and SKF’s President and Chief Operation Officer, Poul Jeppesen (collectively “Movants”).

Movants filed Motions to Quash the Subpoenas (ECF Nos. 1 and 10) (the “Motions”).

The initial and threshold question presented by the Motions is whether 35 U.S.C. § 24 provides courts with the power to issue subpoenas in support of petitions to disqualify attorneys from proceedings before the USPTO Trade Mark Trial and Appeals Board (the “TTAB”). This is apparently a case of first impression. For the reasons below, the Court finds that § 24 does not provide a federal district court with authority to issue RBC’s subpoenas, and, therefore, Movants’ Motions to Quash are GRANTED.

II. Background

The Court provides only a short summary of the events leading up to RBC serving the subpoenas on Movants, because detailed facts are not germane to the question of whether 35 U.S.C. § 24 authorizes this Court to issue subpoenas in support of petitions to qualify.

RBC, SKF and Peer, a wholly owned subsidiary of SKF, are ball bearing manufacturers embroiled in a lengthy dispute regarding RBC’s application to trademark certain names for ball bearings (the “Ball Bearing Names”). A number of ball bearing manufacturers, including SKF and Peer, opposed RBC’s trademark application, claiming that the Ball Bearing Names cannot be trademarked because they are standard industry names.

RBC challenged SKF’s and Peer’s rights to oppose its trademark application based on a prior deal between RBC and SKF in which SKF sold part of its business to RBC. The dispute went to arbitration, and the panel rendered an interim award and a final award that:

1. Enjoined SKF from opposing RBC’s trademark application because SKF had sold its interest in using the Ball Bearing Names to RBC, but
2. Declined to enjoin Peer from opposing RBC’s trademark application, because SKF had acquired Peer after its deal with RBC, and Peer has an independent interest in using the Ball Bearing Names.

SKF subsequently withdrew its opposition; Peer continues to pursue its opposition.

RBC subsequently filed its Petition to Disqualify in the Peer Opposition, and served two sets of subpoenas

requesting discovery (both documents and depositions) from Movants in support of its petition. Movants request that the Court quash RBC's subpoenas.

III. Procedural History

*2 Movants' initially believed that RBC's subpoenas were for discovery in the Peer Opposition and argued that RBC's subpoenas should be quashed pursuant to the USPTO's rules for discovery in opposition proceedings, as set forth in the TTAB Manual of Procedure (the "TBMP"), (3d ed., Rev. 1, June 2012), http://www.uspto.gov/trademarks/process/appeal/tbmp_3rd_ed_rev_1.pdf.²

RBC responded (ECF 5) that it was not seeking discovery in the Peer Opposition, but in support of its Petition to Disqualify.³ (Resp't's Resp. at 9.) RBC's Response:

1. Failed to marshal any authority expressly authorizing the discovery it seeks; and
2. Is internally inconsistent as to whether RBC is, in fact, authorized to take discovery in support of its petition.

RBC's Response cites only one USPTO regulation as authorizing the discovery it seeks, 37 C.F.R. § 11.19(c), which grants the USPTO Director the authority to "handle[petitions to disqualify] on a case-by-case basis under such conditions as [he] deems appropriate." (Resp't's Resp. at 9.) RBC initially described 37 C.F.R. § 11.19(c) as "not preclud[ing] discovery in support of" its petition and later stated that its "right to seek further evidence in support of its petition" is conditioned on "the USPTO Director deem [ing] it necessary." (*Id.* at 9, 14.) Nevertheless, RBC also declared—without further explanation or mention of a determination by the USPTO Director regarding the necessity of its discovery—that it is "entitled to ... seek evidence through ... subpoenas." (*Id.* at 14.)

Movants' Reply (ECF 12) reasserted their argument that the discovery RBC seeks is disallowed by the TBMP. According to the Movants' Reply, the TBMP interprets the discovery regulations that apply "generally to discovery in " proceedings before TTAB, including petitions to disqualify. (Movants' Rep. at 7–8 & n.3.) Movants failed to address that the TBMP provision they cited, section 403.01, interprets procedures found in 37 C.F.R. Part 2, while, as discussed in Sections III.B. and IV.A., *infra*, the procedures for petitions to disqualify are governed by 37 C.F.R. Part 11, specifically § 11.19(c).

Movants also argued that 37 C.F.R. § 11.19(c) bars RBC's discovery, because it permits discovery only upon the USPTO Director's authorization, and RBC has no such authorization.

RBC submitted a Sur-Response (ECF 13) summarily stating that discovery under 37 C.F.R. § 11.19(c) does not require the USPTO Director's prior authorization, and that 35 U.S.C. § 24 authorizes this Court to issue subpoenas in support of petitions to disqualify.

On November 9, 2012, the Court held oral argument on the Motions. Prior to the hearing, the Court sent letters to counsel for both sides questioning whether § 24 does, in fact, authorize the Court to issue subpoenas in support of petitions to disqualify, and asking that counsel be prepared to address this issue. At the hearing, RBC abandoned its argument that 37 C.F.R. § 11.19(c) authorizes the discovery it seeks, arguing instead that its petition to disqualify should be considered merely a feature of the Peer Opposition, and, therefore that its petition should be subject to the procedures for oppositions found in 37 C.F.R. Part 2. According to RBC, this would permit the discovery it seeks, including the use of subpoenas issued by this Court. RBC brought a written summary of its new position to the hearing and subsequently filed it at the request of the Court (ECF 21).

*3 Movants also changed their tune, arguing that because RBC's Petition to Disqualify resulted in an automatic stay of the Peer Opposition, the discovery rules for oppositions found in 37 C.F.R. Part 2 should not apply. Instead, Movants argued that discovery in support of RBC's petition should be governed by 37 C.F.R. Part 11, specifically § 11.19(c), pursuant to which RBC may not obtain any discovery without prior authorization from the USPTO Director, which RBC had not obtained. (Hr'g Audio File 33:09–35:56 (ECF 19).)

III. Discovery in USPTO Proceedings

According to 35 U.S.C. § 2(b)(2)(A), Congress granted the USPTO the power to "establish regulations ... which shall govern the conduct of proceedings in the [USPTO]." Although the Court is aware of no Third Circuit case addressing the scope of the USPTO's authority under this provision, 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) (second and fourth alterations in original) (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 cases in the [USPTO].” 35 U.S.C. § 23.

Under the authority granted to it by Congress, the USPTO has promulgated a number of regulations governing the conduct of proceedings before it, including regulations for:

1. Trademark proceedings before the TTAB, 37 C.F.R. Part 2; and
2. Investigations and disciplinary proceedings, which include petitions to disqualify practitioners, 37 C.F.R. Part 11.

A. Trademark Opposition Proceedings

37 C.F.R. Part 2 sets forth the “Rules for Practice in Trademark Cases.” According to 37 C.F.R. § 2.116(a), “[e]xcept as otherwise provided, and wherever applicable and appropriate, procedure and practice in inter partes proceedings shall be governed by the Federal Rules of Civil Procedure.” For trademark oppositions, 37 C.F.R. § 2.120(a)(1) specifically provides that discovery will be governed by the Federal Rules of Civil Procedure “except as otherwise provided.” According to the TBMP, the USPTO “will presume the parties will comply with their obligation to make all required disclosures *and will utilize traditional discovery devices, as permitted by the Trademark Rules and Federal Rules of Civil Procedure.*” § 401 (emphasis added). Although not explicitly stated in its regulations, the TBMP makes clear that the USPTO intends for 37 C.F.R. § 2.120 to authorize use of the federal district courts’ subpoena powers, even with respect to non-parties. *E.g.*, TBMP § 404.03(a)(2) (“If the proposed deponent is not willing to appear voluntarily, the deposing party must secure the deponent’s attendance by subpoena” issued in accordance with the Federal Rules of Civil Procedure); *id.* § 406.01 (“if a discovery deposition deponent is a nonparty witness residing in the United States, production of designated documents by the witness at the deposition may be obtained by means of a subpoena duces tecum “ issued in accordance with the Federal Rules of Civil Procedure).

B. Investigations and Disciplinary Proceedings

*4 Discovery for investigations and disciplinary proceedings is governed by 37 C.F.R. Part 11, subpart C, which provides for much narrower discovery than is available in trademark proceedings under 37 C.F.R. Part 2. According to 37 C.F.R. § 11.52(a)(1)-(3), (d),

discovery for Part 11 proceedings is:

1. Permitted only upon authorization by the hearing officer after the party seeking discovery establishes that “the discovery sought is reasonable and relevant to an issue actually raised in the complaint or the answer”; and
2. Limited to “a reasonable number of written requests for admission or interrogatories,” “a reasonable number of documents,” and “a reasonable number of things other than documents.”

Parties are permitted to utilize federal district courts’ subpoena powers, but evidence so obtained “shall not be admitted into the record or considered unless leave to proceed” with the subpoena “was previously authorized by the hearing officer.” *Id.* § 11.38. “Depositions may not be taken to obtain discovery, except ... [w]hen the [Director of the Office of Enrollment and Discipline (“OED Director”)] and the respondent agree in writing,” and the witness must appear voluntarily. *Id.* § 11.51(a)-(b).

Particularly relevant to this case, petitions to disqualify attorneys are exempted from almost all of the regulations governing disciplinary proceedings, including all of the regulations related to discovery and the federal district courts’ subpoena powers. *Id.* § 11.19(c). In lieu of the standard procedures for Part 11 proceedings, petitions to disqualify “will be handled on a case-by-case basis under such conditions as the USPTO Director deems appropriate.” *Id.* The TBMP emphasizes the unique nature of petitions to disqualify, stating that “[p]etitions to disqualify ... are not disciplinary proceedings.” § 115.03; *id.* § 513.02.

In short, according to the plain meaning of 37 C.F.R. § 11.19(c), petitions to disqualify:

1. Have no pre-established procedures or authorizations for discovery; and
2. Are subject to the USPTO Director’s ad-hoc determinations.

C. Federal District Courts’ Subpoena Powers Related to USPTO Proceedings

Federal district courts do not possess the inherent authority to compel discovery in support of USPTO proceedings. *Frilette v. Kimberlin*, 508 F.2d 205, 208, 211 (3d Cir.1974) (en banc) (“Generally, discovery is not available in administrative procedures.”). Congress

granted federal district courts the power to issue subpoenas in support of USPTO proceedings under 35 U.S.C. § 24, *Rosenruist–Gestao E Servicos LDA v. Virgin Enters. Ltd.*, 511 F.3d 437, 443 (4th Cir.2007) (citing *Frilette*, 508 F.2d at 207, and *Vogel v. Jones*, 443 F.2d 257, 259 (3d Cir.1971)), which states that:

The clerk of any United States court for the district wherein testimony is to be taken *for use in any contested case* in the Patent and Trademark Office, shall, upon the application of any party thereto, issue a subpoena for any witness.... The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and the production of documents and things shall apply to *contested cases*.

*5 (emphasis added).

By its terms, § 24 applies only to “contested cases” before the USPTO. The Court is aware of no court decision defining the term “contested case.” Nevertheless, it is clear that it does not encompass every proceeding before the USPTO. For example, 37 C.F.R. § 11.38 specifically *includes* disciplinary proceedings under Part 11 within the definition of “contested cases.” *Id.* (“a disciplinary proceeding shall be regarded as a contested case within the meaning of 35 U.S.C. 24”). At the same time, petitions to disqualify are specifically excluded from 37 C.F.R. § 11.38. *Id.* § 11.19(c) (petitions to disqualify “are not governed by §§ 11.19 through 11.60”). The only logical inference to draw is that all proceedings before the USPTO, and petitions to disqualify in particular, do not qualify as “contested cases.” Therefore, § 24 does not authorize federal district courts to issue subpoenas in support of every proceeding before the USPTO.⁴

In addition to § 24’s requirement that subpoenas be in support of a “contested case,” a number of circuits, including the Third Circuit, have held that § 24 allows courts to issue subpoenas only if the discovery or testimony⁵ being sought is authorized by the USPTO. *Rosenruist–Gestao E Servicos LDA v. Virgin Enters. Ltd.*, 511 F.3d 437, 443 (4th Cir.2007); *Brown v. Braddick*, 595 F.2d 961, 966 (5th Cir.1979); *Sheehan v. Doyle*, 529 F.2d 38, 39 (1st Cir.1976) (per curium); *Sheehan v. Doyle*, 513 F.2d 895, 898 (1st Cir.1975) (“section 24 is simply a provision giving teeth, through the courts’ subpoena powers, to authority conferred upon the Commissioner of Patents” under 35 U.S.C. § 23 to “establish rules for taking affidavits and depositions” in

cases before the USPTO); *Frilette*, 508 F.2d 205 (overruling *In re Natta*, 388 F.2d 215 (3d Cir.1968), and adopting Judge Seitz’s dissenting opinion in that case). *But see Natta v. Hogan*, 392 F.2d 686, 690 (10th Cir.1968) (suggesting that § 24 permits discovery independent of USPTO regulations and rules by stating that § 24 “gives to parties in Patent proceedings the right to secure documents in accordance with the provisions of the federal civil rules”).

The Court favors interpreting § 24 narrowly, as having granted federal district courts only “a supportive role ... ensur[ing] the smooth functioning of the procedures adopted by the [US]PTO,” *Rosenruist–Gestao*, 511 F.3d at 444 (citing *Frilette*, 508 F.2d at 209–10), because a narrow interpretation is consistent with the USPTO’s plenary authority to determine the procedures for its proceedings,⁶ *Cooper Techs*, 536 F.3d at 1335.⁷

In sum, courts’ subpoena powers under § 24 are subject to two conditions:

1. Subpoenas may only be issued in support of “contested cases”; and
2. The discovery sought must be otherwise authorized by the USPTO.

IV. The Court Lacks the Authority to Issue RBC’s Subpoenas.

*6 RBC argues that because it initiated its Petition to Disqualify by a motion filed in the Peer Opposition, its petition is merely a feature of the opposition, and RBC is, therefore, entitled to the broad discovery available in opposition proceedings under 37 C.F.R. Part 2. Treating RBC’s petition as merely a feature of the Peer Opposition would effectively result in the petition qualifying as a “contested case” for the purposes of 35 U.S.C. § 24.⁸

Movants counter that because the Peer Opposition was automatically stayed by RBC filing its petition, Part 2’s procedures should not apply. Rather, Movants argue that the procedures for RBC’s petition should be governed by 37 C.F.R. § 11.19(c), and that RBC is not entitled to any discovery under this provision. For the reasons below, the Court finds that 37 C.F.R. § 11.19(c) governs the procedures for RBC’s petition, and that 35 U.S.C. § 24 does not provide the Court with the authority to issue RBC’s subpoenas.

A. Petitions to Disqualify Initiate Procedurally

Independent Proceedings.

Petitions to disqualify initiate new proceedings with procedures determined exclusively by 37 C.F.R. Part 11. Part 11, subpart C sets forth the procedures for Part 11 proceedings. Subpart C specifically addresses petitions to disqualify, exempting them from subpart C's procedures and making them subject to the USPTO Director's "case-by-case" determinations. *Id.* § 11.19(c). Petitions directly to the USPTO Director under Part 11 are expressly authorized by subpart A, 37 C.F.R. § 11.2(e), which states that "[p]etition may be taken to the USPTO Director to invoke the supervisory authority of the USPTO Director in appropriate circumstances in disciplinary matters."

Nothing in subparts A or C suggests that petitions to disqualify import procedures from the regulations for other proceedings. Doing so would, in fact, contravene the plain meaning of 37 C.F.R. § 11.19(c)'s provision that petitions to disqualify are handled "*under such conditions as the USPTO Director deems appropriate.*" (emphasis added). For example, treating a petition to disqualify as governed by the procedures for opposition proceedings under Part 2 would permit invocation of the federal courts' 35 U.S.C. § 24 subpoena powers without first consulting the USPTO Director—as RBC has tried to do in this case.

Furthermore, USPTO regulations generally contemplate that the proceedings initiated by petitions to the USPTO Director will run concurrently with the proceedings giving rise to the petitions. *Id.* § 11.2(e) ("The mere filing of a petition will not stay an investigation, disciplinary proceeding or other proceedings."); *see also id.* § 2.146(g) ("The mere filing of a petition to the Director will not act as a stay in any appeal or inter partes proceeding that is pending before the [TTAB]...."). This strongly supports treating proceedings concerning petitions as distinct, procedurally independent proceedings. The Court recognizes that petitions to disqualify result in automatic stays of the underlying proceedings, TBMP § 513.02 (proceedings in the underlying case are "immediately" suspended and "no additional papers should be filed by the parties until further notice, pending consideration of the petition"), but sees no reason to regard this as a basis for treating petitions to disqualify as merely features of those proceedings. If anything, the automatic suspension of underlying proceedings supports treating the petition proceedings as procedurally independent.

*7 The Court's reading of Part 11 is also supported by the TBMP, which contains no indication that petitions to disqualify are merely features of the proceedings giving rise to them. To the contrary, section 513.02, titled "Petition to Disqualify," refers to only Part 11's procedures and describes petitions to disqualify as being "*filed in connection with a proceeding pending before the*" TTAB. (emphasis added).

B. RBC's Subpoenas Do Not Fall Within the Court's 35 U.S.C § 24 Powers.

The Court has doubts regarding whether petitions to disqualify are "contested cases" under 35 U.S.C. § 24. As discussed in Section III.C., *supra*, not all proceedings before the USPTO are "contested cases," and the USPTO regulatory framework appears to exclude petitions to disqualify from the scope of this term.

However, the Court need not decide whether petitions to disqualify are "contested cases." Even if they are "contested cases," the Court would still not have the power to issue RBC's subpoenas, because the discovery RBC seeks is not authorized by the USPTO. As discussed above, petitions to disqualify are governed exclusively by 37 C.F.R. Part 11, and Part 11:

1. Exempts petitions to disqualify from even the narrow discovery allowed in disciplinary proceedings, and
2. Subjects petitions to disqualify to the USPTO Director's ad-hoc procedural determinations.

Id. § 11.19(c). It would be unreasonable for the Court to find that this amounts to a standing authorization for discovery in support of petitions to disqualify. Therefore, because RBC has not obtained authorization for the discovery it seeks, the Court has no authority to issue RBC's subpoenas.

V. Conclusion

Movants' Motions to Quash are GRANTED.¹⁰ An appropriate order follows.

Footnotes

¹ Movants Pepper Hamilton, Richman, and Janssen and Movants SKF and Jeppesen filed separate motions to quash RBC's subpoenas. Because Movants SKF and Jeppesen expressly adopted the reasoning of the motion filed by

Pepper Hamilton, Richman, and Janssen, the Court will discuss the two motions together.

- 2 Movants also made a number of arguments based on attorney-client privilege and the Federal Rules of Civil Procedure. The Court does not address these arguments.
- 3 RBC filed separate responses to Movants' two motions to quash. Because RBC expressly adopted the same reasoning for both of its responses, the Court will discuss them together.
- 4 The Court notes that the USPTO recently filed an amicus brief in an appeal pending before the Federal Circuit, *Abbott Labs. v. Cordis Corp.*, No.2010-1244, 2012 WL 5248064 (Oct. 11, 2012) (Doc. 43), in which it expressly adopted the position that "contested case" refers to only a narrow subset of proceedings before the USPTO. According to the USPTO, "contested case":
1. "[S]ignif[ies] the small but important category of genuinely trial-like, adjudicative proceedings that occur before the agency"; and
- Requires more than a "proceeding in which a party challenges, i. e., 'contests,' a position adopted by some other party in the proceeding."
- Id.* at * 18-19 (quotation omitted). The USPTO supports its position by discussing the history of the term, stating that in the late 1800's it meant only patent interferences, but that it has since been expanded to encompass a small number of other proceedings, including disciplinary proceedings.
- The USPTO also expressly adopted the position that requiring that discovery be in support of a "contested case" is a "long-recognized predicate[]" to invocation of courts' § 24 powers. *Id.* at * 18.
- 5 USPTO regulations differentiate between depositions taken for discovery purposes and depositions for testimony that may be "use[d] at [a] hearing in lieu of personal appearance of a witness." 37 C.F.R. § 11.51(a); *see also id.* § 2.123(a)(1) ("The testimony of witnesses in *inter partes* cases [before the TTAB] may be taken by depositions")
- 6 As Judge Wilkinson stated in his dissent in *Rosenruist-Gestao*—in which he agreed with the majority holding regarding the scope of courts' § 24 powers, but disagreed as to whether the USPTO had authorized the particular deposition in question—a more expansive reading of § 24 would "divorce[] the subpoena authority from 'the rudder that the court or agency which should have control over the case can provide,' and permit[] evasion of the [US]PTO's framework for obtaining evidence do[ing] violence to [§ 24's] role—established by its text—as an aid to [US]PTO proceedings." 511 F.3d at 460 (quoting *Frilette*, 508 F.2d at 211).
- 7 The Court's conclusion is also consistent with the USPTO's amicus brief in *Abbott Labs.*, in which the USPTO expressly adopted the position that "seek[ing] evidence consistent with [US]PTO rules" is a "long-recognized predicate[]" to utilizing courts' § 24 powers. 2012 WL 5248064, at * 18.
- 8 RBC appears to be correct that trademark opposition proceedings are "contested cases." The TBMP, when interpreting the USPTO's discovery regulations for opposition proceedings, repeatedly refers to § 24 subpoenas as a permissible, and sometimes necessary, discovery mechanism. *E.g.*, § 404.03(a)(2) ("If the proposed deponent is not willing to appear voluntarily, the deposing party must secure the deponent's attendance by subpoena, pursuant to 35 U.S.C. § 24") (emphasis added); *id.* §§ 404.09, 406.01, 411.04. However, the Court need not decide this issue, because petitions to disqualify are not opposition proceedings.
- 9 RBC suggests that the authorization for petitions to disqualify in trademark cases is found in 37 C.F.R. § 2.146, which permits petitions to the Director in trademark cases under certain circumstances. RBC cites no authority for its position, and provides no explanation for why the Court should treat petitions to disqualify as being authorized under Part 2 when they are clearly authorized under Part 11. In rejecting RBC's position, the Court notes that for patent proceedings under 37 C.F.R. Part 41, the USPTO has expressly provided that the Patent Trial and Appeal Board "may disqualify counsel in a specific proceeding after notice and an opportunity to be heard." *Id.* § 41.5(b)(1). It would be unreasonable for the Court to conclude that despite Part 2's lack of a similar provision, petitions to disqualify in trademark proceedings arise under Part 2.
- 10 Movants and Respondent also made requests for sanctions, both of which are DENIED.

EXHIBIT F

John Metzger

From: Foley, Christopher <christopher.foley@finnegan.com>
Sent: Thursday, May 28, 2015 12:15 PM
To: Candace Lynn Bell
Cc: Roberta Jacobs-Meadway; John Metzger; Kilaru, Naresh; Johnson, Laura
Subject: Discovery

Dear Candace and Bobbi:

We continue to be surprised by your lack of cooperation in resolving discovery issues. As an accommodation, we are prepared to make Mr. Tisdale available on Tuesday, June 2, for a video deposition, provided that: (1) any exhibits you contemplate using are delivered to Caterpillar no later than Monday morning, June 1, and (2) Tigercat's 30(b)(6) witness is made available for deposition at our offices in Washington, D.C. Ms. Lantz Rickard and Mr. Stembridge will be available on June 10 and 11, respectively. Therefore, you will only have to make one trip to Peoria.

Please let us know if you find this acceptable.

Very truly yours,

Chris

Christopher P. Foley

Partner

Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P.

Two Freedom Square | 11955 Freedom Drive | Reston, VA 20190-5675

571.203.2720 | fax: 202.408.4400 | christopher.foley@finnegan.com | www.finnegan.com

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EXHIBIT G

John Metzger

From: John Metzger
Sent: Friday, May 29, 2015 2:51 PM
To: 'christopher.foley@finnegan.com'; 'laura.johnson@finnegan.com'
Cc: Candace Lynn Bell; Roberta Jacobs-Meadway
Subject: Caterpillar/Tigercat Opposition
Attachments: LTR TO C. FOLEY RE. SCHEDULING OF DEPOSITIONS (M1377227).pdf; 05292015 LETTER ATTACHMENT TWO PRIOR E-MAILS (M1377206).pdf

Good afternoon:

Please see the letter and attachment appended to this email.

Thank you.

John F. Metzger
Trademark Paralegal
Eckert Seamans Cherin & Mellott, LLC
Two Liberty Place
50 S. 16th Street
Philadelphia, PA 19102
(215) 851-6622

Candace Lynn Bell, Esq.
716-835-0240
cbell@eckertseamans.com

May 29, 2015

Via Email

christopher.foley@finnegan.com

Christopher P. Foley, Esq.
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
Two Freedom Square
11955 Freedom Drive
Reston, VA 20190-5675

Re: Caterpillar, Inc. v Tigercat International, Inc.
Opposition No. 91213597
Discovery Scheduling and Deficiencies in Caterpillar's Discovery Responses
Our File No: 303621 – 00011

Dear Chris:

This letter is in reference to your e-mail of May 28, 2015 regarding deposition scheduling.

We disagree with your contention that we have not cooperated with you.

Most of the delay and difficulty in discovery has been occasioned by Opposer's failure to provide timely and proper responses to interrogatories and requests for production of documents, and that failure has made it more difficult to prepare for and proceed with depositions.

As you will recall, we served you with Notices of Deposition for Mr. Tisdale, Mr. Stembridge and a 30(b)(6) Notice for Opposer on August 26, 2014 (the "Notices"), prior to the case being suspended when we had to file a Motion to Compel Discovery Responses based on Opposer's unfounded objections to discovery.

After the February 4, 2015 Board Order requiring Opposer to respond to certain of Tigercat's discovery requests, Tigercat engaged in another round of letter writing seeking appropriate discovery responses from Opposer as ordered by the Board to no avail. Accordingly, Opposer's failure to cooperate in the discovery process as ordered by the Board required Tigercat to file a Motion for Sanctions and Suspension on April 7, 2015. The Motion for Sanctions is still pending and Tigercat still has not received the responses and documents to which it is entitled and which it should have for the depositions it has noticed as well as for the depositions to be noticed of the persons you have identified as "experts."

Christopher P. Foley, Esq.
May 29, 2015
Page 2

Since the case was not suspended until May 5, 2015, Tigercat continued to comply with the Board's discovery schedule, served its expert disclosures and re-served its Notices of deposition on April 17, 2015, all without the benefit of the discovery to which it is entitled.

The Notices re-served on April 17, 2015 sought depositions during the week of May 4, 2015 since the discovery schedule in effect at that time set a close of discovery of May 13, 2015. On April 21, 2015, the parties were able to agree on a thirty day extension of deadlines which moved the close of discovery to June 12, 2015. On April 23, 2015, Attorney Johnson sent an e-mail confirming that depositions noticed for the week of May 4, 2015 would not work for Opposer. A copy of the e-mail is attached for your reference.

Since April 23, 2015, Tigercat has continued to engage in numerous e-mails and conference calls with you attempting to schedule the depositions, both before and after the Board's suspension Order of May 5, 2015.

On May 13, 2015, Opposer served inadequate discovery responses to Tigercat's Second Set of Requests for Production. On May 14, 2015, Tigercat sent a letter outlining the deficiencies in Opposer's responses, seeking in good faith to resolve the issues with Opposer. On May 18, 2015, Attorney Johnson sent an e-mail stating that counsel was ". . . working with the client to produce any documents relevant to Tigercat's requests" and "We will provide a timely update this week." A copy of the e-mail is attached for your reference. On May 19, 2015, we again wrote seeking responses by May 21, 2015. On May 19, 2015, you sought justification for the May 21, 2015 response deadline. On May 20, 2015, we replied that:

The case is rapidly proceeding to close of discovery. The responses and documents were requested over thirty days ago. You did not ask for or seek an extension of time to respond. Instead, what was served was non-responsive and no documents were produced. We are preparing for depositions and trial and expect the discovery we served to be responded to without further delay.

The week of May 18, 2015 ended and we received no update.

As of today, Opposer still has not provided any update, still has not provided appropriate responses to the discovery requests and still has not produced all responsive documents.

Since it was unclear when pre-trial disclosures were due and the impact of the May 5, 2015 Board Suspension Order, Tigercat again sought to move forward with the case, despite the outstanding discovery issues, by seeking agreement to continue the depositions in light of the

Christopher P. Foley, Esq.
May 29, 2015
Page 3

pending discovery disputes. On May 26, 2015, Attorney Johnson stated Opposer would object to any continuation outside that permitted under the Trademark Rules and any Board Order.

As of yesterday, 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 e-mail exchanges and a conference call yesterday morning about scheduling depositions in light of the various open discovery issues. We also raised again the issue of video conference depositions given the travel schedule to Peoria and the unavailability of the three Caterpillar witnesses during the same week. You did not consent to video conference depositions. No agreement on scheduling could be reached.

Moving forward with the Caterpillar fact depositions without the information and materials Opposer should have produced, and in light of the open discovery issues and without agreement to continue such depositions to address with the witnesses any matters raised by subsequently produced information and documents is prejudicial to Tigercat. For that reason, granted that discovery remains open, and all dates will be reset pursuant to the Board's Order of this morning, the depositions of Mr. Tisdale, Mr. Stembridge and Ms. Lantz Rickard will be rescheduled.

Yesterday afternoon, after the telephone call, you sent an e-mail offering the video conference deposition of Mr. Tisdale only, and only on the conditions that our Canadian client waive its rights with respect to deposition on written questions and have its representatives travel to your office in Washington, D.C. to be deposed. This offer is one we deem inappropriate and it is not acceptable.

We note that in the April 23, 2015 e-mail sent by Attorney Johnson, she stated: "The depositions of Mr. McHugh and Mr. Berger (the experts disclosed by Tigercat) will be by telephone." Mr. Berger resides in Chicago and Mr. McHugh in Philadelphia, both easily accessible major U.S. cities. We made and make no objections to Opposer taking Mr. Berger's and Mr. McHugh's depositions by telephone. We demanded no concessions. You have failed to return the cooperation or courtesy we extended with respect to the depositions of Caterpillar's witnesses. We remind you that with respect to the three individuals Caterpillar has offered as experts, who reside in Henniker, New Hampshire, Florence, South Carolina, and Longview, Texas, respectively (locations that are approximately an hour and a half to a two hour drive from major airports), we have repeatedly sought consent to take their depositions by video conference and to set dates for these depositions. You have not consented to video conference depositions or provided us with dates.

So that there is no doubt, we are not prepared to go forward with the depositions of Mr. Tisdale, Ms. Lantz Rickard and Mr. Stembridge until responsive documents necessary for the depositions are produced. Nor are we prepared to move forward with the depositions of Mr. Berger and Mr. McHugh with fact discovery still open. We expect Opposer to provide complete

Christopher P. Foley, Esq.
May 29, 2015
Page 4

responses and the documents responsive to Tigercat's Second Set of Requests for Production without further meritless objections no later than Thursday, June 4, 2015.

We continue to be open to resetting dates and working cooperatively with you to schedule depositions as appropriate, and to conduct the depositions by appropriate means, but not in a manner that is prejudicial to Tigercat.

As discussed in yesterday morning's call, we will be seeking leave from the Board to proceed with video conference depositions, on notice and without conditions.

Very truly yours,

A handwritten signature in cursive script, appearing to read "Candace Lynn Bell".

Candace Lynn Bell
ECKERT SEAMANS CHERIN & MELLOTT, LLC.

cc: Roberta Jacobs-Meadway, Esq.

Deposition scheduling

Johnson, Laura <Laura.Johnson@finnegan.com>

Thu 4/23/2015 12:30 PM

To: Candace Lynn Bell <CBell@eckertseamans.com>; Roberta Jacobs-Meadway <RJacobsMeadway@eckertseamans.com>;

Cc: Foley, Christopher <christopher.foley@finnegan.com>; Reilly, Jenny <Jenny.Reilly@finnegan.com>; John Metzger <JMetzger@eckertseamans.com>;

Candace and Roberta,

We would like to schedule a call to discuss dates for the noticed Caterpillar depositions. The noticed dates will not work for Caterpillar.

Also, we plan on issuing deposition notices on Mr. McHugh, Mr. Berger, and a Tigercat 30(b)(6) witness. The depositions of Mr. McHugh and Mr. Berger will be by telephone. It would be productive to discuss available dates for these witnesses before we issue these notices.

Please let us know your availability today or tomorrow.

Thanks,
Laura

Laura K. Johnson

Attorney at Law

Finnegan, Henderson, Farabow, Garrett & Dunner, LLP

Two Seaport Lane, 6th Floor

Boston, MA 02210-2001

617.646.1645 | fax: 617.646.1666 | laura.johnson@finnegan.com

www.finnegan.com

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RE: Emailing: C. BELL LETTER TO C. FOLEY RE. DISCOVERY
RESPONSE DEFICIENCIES. 5-14-15 (M1371949).PDF

Johnson, Laura <Laura.Johnson@finnegan.com>

Mon 5/18/2015 9:02 PM

To: Candace Lynn Bell <CBell@eckertseamans.com>; Roberta Jacobs-Meadway <RJacobsMeadway@eckertseamans.com>;

Cc: Foley, Christopher <christopher.foley@finnegan.com>; Alexander Fleisher <AFleisher@eckertseamans.com>; John Metzger
<JMetzger@eckertseamans.com>; Kilaru, Naresh <Naresh.Kilaru@finnegan.com>; Reilly, Jenny
<Jenny.Reilly@finnegan.com>;

Counsel,

In view of your communication, we are evaluating the sufficiency of Caterpillar's discovery response, as well as working with the client to produce any documents relevant to Tigercat's requests.

We will provide a timely update this week.

Laura

Laura K. Johnson

Attorney at Law

Finnegan, Henderson, Farabow, Garrett & Dunner, LLP

Two Seaport Lane, 6th Floor

Boston, MA 02210-2001

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www.finnegan.com

From: John Metzger [mailto:JMetzger@eckertseamans.com]

Sent: Thursday, May 14, 2015 6:13 PM

To: Foley, Christopher; Johnson, Laura

Cc: Candace Lynn Bell; Roberta Jacobs-Meadway; Alexander Fleisher

Subject: Emailing: C. BELL LETTER TO C. FOLEY RE. DISCOVERY RESPONSE DEFICIENCIES. 5-14-15
(M1371949).PDF

Good evening:

Please see the attached letter.

Thank you.

John F. Metzger

Trademark Paralegal

Eckert Seamans Cherin & Mellott, LLC

Two Liberty Place

EXHIBIT H

John Metzger

From: Johnson, Laura <Laura.Johnson@finnegan.com>
Sent: Monday, May 11, 2015 11:40 PM
To: Candace Lynn Bell; Roberta Jacobs-Meadway
Cc: John Metzger; Foley, Christopher; Reilly, Jenny
Subject: Notice of Deposition of Tigercat International
Attachments: Tigercat 30b6 Deposition Notice.pdf; Rosenruist-Gestao E Servicos LDA v Virgin Enterprises Ltd.rtf

Counsel,

Please find attached the Notice of Deposition of Tigercat International Inc.

While we would prefer to reach an agreement regarding the in-person deposition of Tigercat in the Buffalo area, attached is the referenced case law that would permit Caterpillar to take the deposition of Tigercat in your Philadelphia office.

We will be prepared to discuss the Rule 30(b)(6) Notice and deposition location during our call tomorrow.

Thanks,
Laura

Laura K. Johnson
Attorney at Law
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<p>CATERPILLAR INC.,</p> <p style="text-align:center">Opposer,</p> <p style="text-align:center">v.</p> <p>TIGERCAT INTERNATIONAL INC.,</p> <p style="text-align:center">Applicant.</p>	<p>Opposition No. 91213597</p> <p>Application Serial No. 85/591,967</p> <p>Mark: TIGERCAT</p> <p>Application date: April 8, 2012</p>
--	--

NOTICE TO TAKE DEPOSITION OF TIGERCAT INTERNATIONAL INC.

PLEASE TAKE NOTICE that, pursuant to Rule 30(b)(6) of the Federal Rules of Civil Procedure, on June 24, 2015 at 9:00 am, Opposer Caterpillar Inc. (“Opposer” or “Caterpillar”) will take the deposition upon oral examination of Applicant Tigercat International Inc. (“Applicant” or “Tigercat”), by and through the officers, directors, managing agents, or other persons designated as being competent to testify on behalf of Defendant, at the Embassy Suites Buffalo, 200 Delaware Ave, Buffalo, NY 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, before a Notary Public or another person qualified by law to administer oaths.

The deposition(s) will continue day-to-day until such time as completed and will be recorded by stenographic, audio, video, or other means. You are invited to attend.

Dated: May 11, 2015

Respectfully submitted,

/Christopher P. Foley/

Christopher P. Foley
FINNEGAN, HENDERSON, FARABOW,
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901 New York Ave., N.W.
Washington, D.C. 20001-4413
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2 Seaport Boulevard
Boston, MA 02210
Telephone: 617-646-1600
Facsimile: 617-646-1666

Attorneys for Opposer
Caterpillar Inc.

CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing NOTICE OF DEPOSITION OF TIGERCAT INTERNATIONAL INC. was served via electronic mail, upon counsel for Applicant, on May 11, 2015.

/Laura K. Johnson/

Laura K. Johnson

SCHEDULE A

DEFINITIONS AND INSTRUCTIONS

Caterpillar incorporates by reference the definitions and instructions set forth in Opposer's First Set of Interrogatories to Applicant served February 28, 2014.

TOPICS FOR EXAMINATION

1. The Products with which Applicant's Mark has been used, are currently used, and/or intend to be used from the date of first use of Applicant's Marks to the present.
2. The specifications and features of Applicant's Products and Services.
3. The applications and fields of use for Applicant's Products and Services.
4. Applicant's warranties to consumers relating to Applicant's Products and Services or the applications and fields of use for Applicant's Products and Services.
5. Applicant's product development and product expansion efforts in connection with goods offered or sold under Applicant's Mark.
6. The annual dollar volume and unit sales in the United States for products bearing or offered under Applicant's Mark from 2009 to the present.
7. Applicant's sale of goods in the forestry field for 2009 to the present.
8. Applicant's sale of goods in the off-road industrial field for 2009 to the present.
9. Applicant's sale of goods in outside of the forestry and off-road industrial fields for 2009 to the present.
10. The manufacturer's suggested retail price, wholesale prices (to Applicant's dealers), and actual selling prices of Applicant's Products and Services from 2009 to the present.
11. Applicant's annual dollar volume of advertising and promotional expenditures in the United States for products bearing or offered under Applicant's Mark from 2009 to the present.
12. Advertising and promotion of Applicant's Mark from 2009 to the present.
13. Applicant's advertising of machinery and equipment outside of the forestry field.
14. Applicant's advertising of machinery and equipment in the forestry field.

15. The channels of trade through which Applicant has marketed and offered, currently markets and offers, and intends to market and offer Applicant's Products and Services.

16. Trade shows at which Applicant has advertised, promoted, marketed, exhibited, offered, or sold Applicant's Products and Services.

17. Applicant's participation in any conferences or events in the forestry, agricultural, mining, vegetation management, off-road industrial, oil and gas, or construction fields.

18. The methods of distribution of Applicant's Products and Services from 2009 to the present.

19. Any meanings of Applicant's Mark.

20. Any use of Applicant's Mark in conjunction with feline imagery.

21. Any name or mark comprised of or containing the term "Cat" that Applicant has used or registered, or intends to use or register, apart from Applicant's Mark.

22. The categories, types, nature, and characteristics of distributors of products bearing Applicant's Mark from 2009 to the present.

23. The categories, types, nature, and characteristics of retailers of products bearing Applicant's Mark from 2009 to the present.

24. The categories, types, nature, and characteristics of customers of products bearing Applicant's Mark from 2009 to the present.

25. Any instance where a person has been confused, mistaken, or deceived about the source, affiliation, association, relationship, ownership, or sponsorship between Applicant's Mark and Opposer's Mark, or between products offered, promoted, or sold under those marks.

26. Any instance where a person has inquired whether an affiliation, connection, sponsorship, or relationship exists between Applicant's Mark or products offered under Applicant's Mark on the one hand and Opposer's Mark or products offered under Opposer's Mark on the other hand.

27. Any investigations, research, reports, surveys, focus groups, or studies relating to likelihood of confusion between Applicant's Mark and Opposer's Mark.

28. Any investigations, research, reports, surveys, focus groups, or studies conducted by or on behalf of Applicant that concern or relate to Applicant's Mark or Opposer's Mark.

29. All trademark searches, reports, research, or investigations obtained or conducted by or on behalf of Applicant concerning Applicant's Mark.

30. Objections Applicant has made to third parties' use and/or registration of marks, names, or designs based on Applicant's Mark.

31. Objections Applicant has received from third parties regarding Applicant's use and/or registration of Applicant's Mark.

32. All judicial and administrative proceedings involving or relating to Applicant's Mark other than this opposition proceeding.

33. Applicant's knowledge and awareness of Opposer's use of Opposer's Mark.

34. Applicant's knowledge and awareness of the fame of Opposer's Mark.

35. Applicant's knowledge and awareness of the public perception of Opposer's Mark.

511 F.3d 437
United States Court of Appeals,
Fourth Circuit.

ROSENROIIST-GESTAO E SERVICOS LDA,
formerly known as Rosenruist-Gestao E Servicos
Sociedade Unipessoal LDA, Plaintiff-Appellee,

v.

VIRGIN ENTERPRISES LIMITED,
Defendant-Appellant.

No. 06-1588. | Argued March 16, 2007. | Decided
Dec. 27, 2007.

Synopsis

Background: Interested party brought inter partes adversarial action before Trademark Trial and Appeal Board (TTAB) regarding registerability of foreign corporation's proposed trademark. The United States District Court for the Eastern District of Virginia, Claude M. Hilton, Senior District Judge, denied party's motion to compel foreign corporation to designate witness to appear for deposition. Party appealed.

Holdings: The Court of Appeals, Traxler, Circuit Judge, held that:

[1] term "witness," as used in statute that granted district courts subpoena authority to command appearance of witnesses in administrative proceedings before Patent and Trademark Office (PTO), was not limited to natural persons and allowed court to reach corporations and other juristic persons;

[2] foreign corporation's arguments regarding validity of subpoena were not properly before Court of Appeals on opponent's appeal of issue of whether term "witness" was limited to natural persons; and

[3] Court of Appeals was neither bound by Trademark Board Manual of Procedure (TBMP) nor obligated to consider its statutory interpretation particularly persuasive.

Reversed and remanded.

Wilkinson, Circuit Judge, filed dissenting opinion.

West Headnotes (11)

[1] **Trademarks**
☞ Nature and Extent of Use

Under the Lanham Act, ownership rights in a trademark flow from actual use of the mark in commerce. Lanham Act, § 1(b, d), 15 U.S.C.A. § 1051(b, d).

2 Cases that cite this headnote

[2] **Patents**
☞ Proceedings in general

Term "witness," as used in statute that granted district courts subpoena authority to command appearance of witnesses in administrative proceedings before Patent and Trademark Office (PTO), was not limited to natural persons and allowed court to reach corporations and other juristic persons. 35 U.S.C.A § 24.

1 Cases that cite this headnote

[3] **Witnesses**
☞ Persons Who May Be Required to Appear and Testify

The word "person" in the Federal Rule of Civil Procedure governing subpoenas is not limited merely to "natural persons" but includes juristic persons like corporations and governments. Fed.Rules Civ.Proc.Rule 45, 28 U.S.C.App. (2000).

1 Cases that cite this headnote

[4] **Trademarks**

↔Discovery

§ 24.

If a party to an inter partes proceeding before the Trademark Trial and Appeal Board (TTAB), which is an adversarial action between parties regarding the registerability of a proposed trademark, wishes to take the trial testimony of an adverse party or an official of an adverse party who is unwilling to appear voluntarily, then the examining party must secure attendance of the deponent by subpoena. 35 U.S.C.A. § 24; Fed.Rules Civ.Proc.Rule 45, 28 U.S.C.App. (2000).

2 Cases that cite this headnote

3 Cases that cite this headnote

[7]

Federal Courts

↔Appellees; necessity of filing cross-appeal

A cross-appeal is required if the prevailing party raises arguments that seek to alter or modify the judgment below.

Cases that cite this headnote

[5]

Trademarks

↔Preservation of questions in administrative proceeding; record

Foreign corporation's arguments on appeal, regarding district court's rejection of its motion to quash in which it asserted in part that it was not subject to court's subpoena power, were not properly before Court of Appeals on opponent's appeal of issue of whether term "witness" as used in statute that granted district courts subpoena authority to command appearance of witnesses in administrative proceedings before Patent and Trademark Office (PTO) was limited to natural persons, since corporation did not cross-appeal issue of whether subpoena was valid. 35 U.S.C.A § 24; Fed.Rules Civ.Proc.Rule 45, 28 U.S.C.App.(2000).

[8]

Federal Courts

↔Appellees; necessity of filing cross-appeal

A prevailing party may urge an appellate court to affirm a judgment on any ground appearing in the record and may do so without having to file a cross-appeal.

1 Cases that cite this headnote

1 Cases that cite this headnote

[9]

Administrative Law and Procedure

↔Trade or business

Trademarks

↔Scope of review

Court of Appeals was neither bound by Trademark Board Manual of Procedure (TBMP) nor obligated to consider its statutory interpretation particularly persuasive, since TBMP did not provide, or even purport to provide, authoritative interpretive guidance with regard to scope of statute that granted district courts subpoena authority to command appearance of witnesses in administrative proceedings before Patent and Trademark Office (PTO) or any other statute, but, instead, it merely set forth TTAB's informal opinion that statute did not provide authority for district court to issue subpoena to unwilling foreign deponent. 35 U.S.C.A. § 24.

[6]

Patents

↔Proceedings in general

Statute that granted district courts subpoena authority to command appearance of witnesses in administrative proceedings before Patent and Trademark Office (PTO) did not require "systematic and continuous" presence as needed for exercise of general jurisdiction. 35 U.S.C.A.

3 Cases that cite this headnote

[10] Trademarks
⇒ Alphabetical listing

VIRGIN GORDA.

Cases that cite this headnote

[11] Trademarks
⇒ Alphabetical listing

VIRGIN.

Cases that cite this headnote

Attorneys and Law Firms

***439 ARGUED:** James Wilson Dabney, Fried, Frank, Harris, Shriver & Jacobson, L.L.P., New York, New York, for Appellant. Douglas Vernon Rigler, Young & Thompson, Arlington, Virginia, for Appellee. **ON BRIEF:** Darcy M. Goddard, Fried, Frank, Harris, Shriver & Jacobson, L.L.P., New York, New York, for Appellant. Andrew J. Patch, Jeff Goehring, Young & Thompson, Arlington, Virginia, for Appellee.

Before WILKINSON and TRAXLER, Circuit Judges, and WILKINS, Senior Circuit Judge.

Reversed and remanded by published opinion. Judge TRAXLER wrote the majority opinion, in which Senior Judge WILKINS joined. Judge WILKINSON wrote a dissenting opinion.

OPINION

TRAXLER, Circuit Judge.

Rosenruist–Gestao E Servicos LDA (“Rosenruist”) is a Portuguese company that seeks to obtain a United States trademark registration and enjoy the benefits that accompany ownership of a registered mark under the Lanham Act. Virgin Enterprises Ltd. (“VEL”), a British conglomerate that owns numerous United States registrations, opposes the registration of Rosenruist’s mark and commenced an administrative proceeding before the Trademark Trial and Appeal Board (“TTAB”) against Rosenruist to prevent the registration. When Rosenruist refused to appear voluntarily for a Rule 30(b)(6) deposition under the procedural rules promulgated by the Patent and Trademark Office (“PTO”), *see* 37 C.F.R. § 2.123 (2006), the district court issued a subpoena under 35 U.S.C.A. § 24 directing Rosenruist to produce a designee to testify on behalf of the corporation at a deposition in Virginia. The district court refused Rosenruist’s request to quash the subpoena and then subsequently imposed sanctions against Rosenruist when it failed to attend the deposition.

Seeking to ensure Rosenruist’s cooperation, VEL filed a motion to compel Rosenruist, on pain of contempt sanctions, to designate its Rule 30(b)(6) representative and appear for the corporate deposition as directed by the subpoena. Notwithstanding its earlier ruling that Rosenruist had been properly served with a valid subpoena for a Rule 30(b)(6) deposition, the court determined that it could not require Rosenruist to produce a corporate designee for the deposition unless that designee personally resided within the district of the issuing court. Because there are no individuals residing within the Eastern District of Virginia who Rosenruist could designate as its witness under Rule 30(b)(6), the court denied VEL’s request to compel an appearance.

VEL appeals this ruling. For the reasons that follow, we reverse.

I.

^[1] Rosenruist filed an application in December 2002 with the PTO to register the mark VIRGIN GORDA under section 1(b) of the Lanham Act. *See* 15 U.S.C.A. § 1051(b) (West Supp.2007). At the time, Rosenruist had not sold any products in the United States or established a business presence here. Section 1(b) of the Act permits an applicant to seek trademark registration based on the applicant’s intent to use the trademark in commerce rather than the actual use of the mark, provided that the

applicant later files “a verified statement that the mark is in use in commerce.” *See* *440 15 U.S.C.A. § 1051(d)(1) (West Supp.2007).¹

Rosenruist applied to register based on its intent to use the mark VIRGIN GORDA in connection with forty-one categories of goods, including “[b]ags, purses, ... traveling bags, trunks, make-up bags and empty vanity cases, document holders, umbrellas, [and] handbags,” as well as various kinds of clothing and footwear. J.A. 46. In its application with the PTO, Rosenruist appointed various members of the Virginia-based law firm prosecuting the application as “domestic representatives” under 15 U.S.C.A. § 1051(e) to act as Rosenruist’s designees “upon whom notices or process in proceedings affecting this mark may be served.” J.A. 52.

Initially, the PTO’s examining attorney refused registration on the basis that the VIRGIN GORDA mark is “primarily geographically deceptively misdescriptive,” 15 U.S.C.A. § 1052(e)(3) (West Supp.2007), explaining that Virgin Gorda is an island located within the British Virgin Islands and that its proposed use would cause the public to mistakenly believe that Rosenruist’s goods bearing this mark came from the Virgin Islands. Ultimately, however, the examining attorney agreed with Rosenruist that there was insufficient basis for believing that the misdescription would be a material factor in the consuming public’s purchasing decisions, withdrew the refusal to register, and caused the PTO to publish the mark in its Official Gazette. *See* 15 U.S.C.A. § 1062(a) (West Supp.2007).

In July 2004, VEL filed a Notice of Opposition with the PTO. *See* 15 U.S.C.A. § 1063(a) (West Supp.2007). VEL has a substantial presence in the United States through a vast array of businesses such as Virgin Atlantic Airways, Virgin Records, Virgin Mobile, Virgin Wines, and Virgin Digital. The VEL conglomerate and its related companies sell and distribute a wide variety of goods and services under the registered VIRGIN mark, including clothing, cosmetics, luggage, bags, wallets, umbrellas, records and CDs, telecommunications products, airline and travel-related services, and restaurant and hotel services. VEL asserted that it would be damaged by the proposed VIRGIN GORDA registration because it is confusingly similar to VEL’s VIRGIN mark. Under the trademark practice rules adopted by the PTO, VEL conducted limited discovery through written questions, but it did not seek to conduct a discovery deposition prior to the expiration of the discovery period. *See* 37 C.F.R. § 2.120(a).

In December 2005, VEL, pursuant to Rule 30(b)(6) of the

Federal Rules of Civil Procedure, sought to conduct a testimonial deposition of Rosenruist to present in evidence at trial before the TTAB.² When *441 Rosenruist refused to appear voluntarily in the United States for an oral deposition, VEL moved pursuant to the PTO’s rules of procedure to compel Rosenruist to identify a Rule 30(b)(6) representative and produce that person to testify for the corporation at an oral deposition in Portugal. *See* 37 C.F.R. § 2.123(a)(2) (2006). The TTAB denied VEL’s motion to compel, noting that, according to its manual of procedure, a party residing in a foreign country may be compelled to appear for an oral testimonial deposition only through the procedures provided in The Hague Convention or the issuance of letters rogatory to the appropriate Portuguese legal authority. *See* Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) §§ 703.01(a), (f)(3) (2d ed.2003).

In January 2006, VEL served Thomas Perkins—one of the lawyers designated by Rosenruist as its representative under § 1051(e)—with a Rule 30(b)(6) deposition subpoena directing the Rosenruist corporation to appear in McLean, Virginia, and produce the “person having [the] most knowledge” regarding, among other topics, “[t]he factual representations made in [Rosenruist’s trademark] Application.” J.A. 140, 142.

The subpoena was issued by the district court for the Eastern District of Virginia pursuant to 35 U.S.C.A. § 24, which provides in pertinent part:

The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the [PTO], shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses ... shall apply to contested cases in the [PTO].

35 U.S.C.A. § 24 (West 2001).

Rosenruist moved pursuant to Rule 45(c)(3)(A) to quash the subpoena, *see* Fed.R.Civ.P. 45(c)(3)(A), arguing that the district court lacked the authority to subpoena a

foreign resident to appear in the United States for a deposition, that VEL was attempting to circumvent the proper procedure for compelling Rosenruist's testimonial deposition as outlined by the TTAB in its order denying VEL's initial motion to compel, and that service of the subpoena on counsel for Rosenruist was ineffective even if the subpoena was valid.

The magistrate judge concluded that the subpoena was properly issued and valid under 35 U.S.C.A. § 24 and rejected Rosenruist's argument that § 24 did not give the district court subpoena power over non-resident foreign corporations. The magistrate judge also concluded that service of the subpoena on counsel for Rosenruist was effective because Rosenruist, in conjunction with its registration application, had designated counsel to accept service of "notices or process in proceedings affecting the mark." 15 U.S.C.A. § 1051(e) (West Supp.2007). Accordingly, on March 2, 2006, the magistrate judge entered an order denying Rosenruist's motion to quash and directing Rosenruist "to *442 designate a Rule 30(b)(6) witness residing or being within this judicial district to appear for deposition by March 15, 2006." J.A. 185. Rosenruist filed objections to the order of the magistrate judge, *see* Fed.R.Civ.P. 72(a), arguing primarily that the district court lacked the authority to issue a subpoena to non-resident aliens. The district court denied Rosenruist's objections, finding that the decision of the magistrate judge was not contrary to law and did not rest on clearly erroneous factual findings. Rosenruist did not appeal the order denying its motion to quash.

Following the court's denial of Rosenruist's motion to quash, VEL re-served the subpoena and rescheduled the deposition. Rosenruist, however, refused to produce a Rule 30(b)(6) designee at the deposition. Instead, counsel for Rosenruist appeared and announced that Rosenruist did not intend to designate a representative to testify on behalf of the corporation as there was no such person "residing or being" within the Eastern District of Virginia. J.A. 259.³ VEL then sought and obtained sanctions against Rosenruist for its failure to appear at the deposition. The magistrate judge ordered that Rosenruist pay the legal fees and costs incurred by VEL in connection with counsel's preparation for and appearance at the deposition.

On March 31, 2006, in view of Rosenruist's continued belief that it was neither required nor able to comply with the subpoena, VEL moved the district court for an order compelling Rosenruist to obey the subpoena, which the court had already deemed valid, and to produce an appropriate representative under Rule 30(b)(6) to be deposed on the subjects identified in the subpoena. VEL

argued that, because a corporation can only testify through its individual representatives, Rosenruist was technically the witness in a Rule 30(b)(6) deposition. And, because Rosenruist had designated a Virginia resident as domestic representative under 15 U.S.C.A. § 1051(e), it was within the judicial district wherein the deposition testimony would be taken. *See* 35 U.S.C.A. § 24. VEL asserted that "Rosenruist can no more refuse to attend its own deposition than can any other alien corporate litigant that is subject to the Court's *in personam* jurisdiction." J.A. 345-46.

In response, Rosenruist argued that all of its potential Rule 30(b)(6) designees were foreign citizens residing outside the United States and beyond the reach of the court's subpoena power under 35 U.S.C.A. § 24; that the court did not even have personal jurisdiction over Rosenruist, which had not conducted any business in the country; and that Rosenruist, as a corporation, did not qualify as a witness under 35 U.S.C.A. § 24 because the statute pertains only to subpoenas directed to natural person witnesses.

After hearing VEL's motion to compel, the magistrate judge concluded that, even though Rosenruist had been properly served with a valid subpoena, Rosenruist was not required to produce a Rule 30(b)(6) designee unless that designee resided within the district. The decision of the magistrate judge rested on his conclusion that the term "witness" as used in the statute applied only to natural persons. The court instructed Rosenruist to file a declaration indicating that there was no officer, director, or managing agent of Rosenruist residing in the district who could address the topics listed in the subpoena. Likewise, the court instructed Rosenruist *443 to include in its declaration a statement regarding whether there resided within the district "other persons" who "consent[ed] to testify on its behalf." J.A. 409. Because the magistrate judge did not compel Rosenruist to produce a Rule 30(b)(6) designee but did require Rosenruist to respond with the aforementioned declaration, the magistrate judge issued an order "grant[ing] in part and deny[ing] in part" VEL's motion to compel. J.A. 381. Following the hearing, Rosenruist filed a declaration stating that there was "no officer, director, or managing agent or other person who consents to testify on Rosenruist's behalf in this District," J.A. 414.

VEL filed objections to the magistrate judge's order, arguing that 35 U.S.C.A. § 24 did not limit "witness" to natural persons and that, therefore, a corporation could be compelled to appear at a deposition regardless of where the Rule 30(b)(6) designee might personally reside. The district court again concluded that the ruling of the

magistrate judge was not clearly erroneous or contrary to law. VEL then filed this appeal.

II.

Before turning to the particular arguments of the parties, we believe it is helpful to consider very briefly the role of the district court in the context of an opposition proceeding before the TTAB, as well as the interplay between the Federal Rules of Civil Procedure and the PTO's rules of procedure.

The TTAB is an administrative tribunal of the PTO with jurisdiction over *inter partes* challenges to the registration of trademarks. See 15 U.S.C.A. § 1067(a) (West Supp.2007).⁴ Procedure in *inter partes* matters diverges from that in district court at the trial stage, in that the taking of testimony does not occur in the presence of the TTAB. Instead, testimony is taken by deposition during set testimony periods, and the TTAB resolves all factual issues based on the written record submitted by the parties. See 37 C.F.R. §§ 2.121, 2.123, 2.125 (2006).

Inter partes proceedings before the TTAB are governed by the Rules of Practice in Trademark Cases adopted by the PTO and set forth in Part 2 of Title 37 of the Code of Federal Regulations. See 35 U.S.C.A. § 23 (West 2001) (granting the Director of the PTO the authority to “establish rules for taking affidavits and depositions required in cases in the [PTO]”). The PTO's rules were “adapted from the Federal Rules [of Civil Procedure], with modifications appropriate to the administrative process.” *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1575 (Fed.Cir.1988). Under the PTO's rules, the Federal Rules of Civil Procedure generally apply to all phases of *inter partes* proceedings, see 37 C.F.R. § 2.116(a), including discovery and the taking of depositions, see 37 C.F.R. § 2.120(a).

As an administrative tribunal of limited jurisdiction, the TTAB is empowered only to decide whether a given trademark is registrable. See 15 U.S.C.A. §§ 1067, 1068 (West Supp.2007); 15 U.S.C.A. § 1070 (West 1997); *Person's Co. v. Christman*, 900 F.2d 1565, 1571 (Fed.Cir.1990). Although the TTAB has the authority to impose limited sanctions upon *parties* that *444 fail to cooperate during discovery, see 37 C.F.R. §§ 2.120(e), (g), the TTAB lacks the authority to compel witnesses through the subpoena power to appear for testimony in *inter partes* proceedings. See 37 C.F.R. § 2.120(b); *Consolidated Foods Corp. v. Ferro Corp.*, 189 U.S.P.Q. 582, 583 (T.T.A.B.1976).

Accordingly, Congress granted district courts subpoena authority under 35 U.S.C.A. § 24 to command the appearance of witnesses in administrative proceedings before the PTO. See *Frilette v. Kimberlin*, 508 F.2d 205, 207 (3d Cir.1975) (en banc); *Vogel v. Jones*, 443 F.2d 257, 259 (3d Cir.1971). Under this statute, district courts have “jurisdiction to ... issu[e] ... subpoenas” in PTO proceedings. *Frilette*, 508 F.2d at 207. This narrow jurisdictional grant assigns district courts the limited function in contested PTO matters of “issu[ing] and enforc[ing] subpoenas in connection with the preparation of evidence for submission” to the administrative tribunal. *Id.* at 209. Thus, § 24 assigns a supportive role to the district courts to ensure the smooth functioning of the procedures adopted by the PTO. See *id.* at 210 (describing the function of the district court as “co-operatively complementing” the PTO) (internal quotation marks omitted).

A.

With this context in mind, we turn to VEL's challenge to the conclusion of the magistrate judge that “witness” in 35 U.S.C.A § 24 refers only to natural persons and not to corporations or other juristic persons. The effect of the magistrate judge's conclusion was that, despite the fact that Rosenruist *itself* was properly served a valid subpoena directing it to designate a corporate representative for a Rule 30(b)(6) deposition of the *corporation*, the court could not require Rosenruist to produce its designee unless the designee was “residing or being within” the Eastern District of Virginia.

^[2] For the reasons set forth below, we agree with VEL that the term “witness,” as used in the statute, is not limited to natural persons and allows the court to reach corporations and other juristic persons. Because the unappealed order of March 2, 2006, established for purposes of this case that the subpoena was valid and that Rosenruist, as the subject of the subpoena, was required to obey it, it follows that the district court should have granted VEL's motion to compel.

1.

As we noted above, the PTO's rules of practice generally incorporate the deposition procedures prescribed by the Federal Rules of Civil Procedure, specifically including

Rule 30(b)(6). See 37 C.F.R. § 2.120(b) (2006). Pursuant to Rule 30(b)(6), a party may name a *corporation* as a deponent, in either a notice of deposition or a subpoena:

A party may in the party's notice and in a subpoena name as the deponent a public or private corporation or a partnership or association or governmental agency and describe with reasonable particularity the matters on which examination is requested. In that event, the organization so named shall designate one or more officers, directors, or managing agents, or other persons who consent to testify on its behalf, and may set forth, for each person designated, the matters on which the person will testify.

Fed.R.Civ.P. 30(b)(6).

Prior to the adoption of this rule in 1970, a party wishing to establish the knowledge of a corporate entity was forced to identify and subpoena a specific officer or representative of the corporation who qualified *445 as a director, officer, or managing agent. See *Founding Church of Scientology of Washington, D. C., Inc. v. Webster*, 802 F.2d 1448, 1451 (D.C.Cir.1986). That practice was supplemented with the addition of Rule 30(b)(6), which allows the examining party to seek the corporation's testimony without regard to who actually provides the testimony on behalf of the organization. If "[t]he party seeking discovery ... simply name[s] the corporation ... as the deponent," it becomes "the duty of the corporation to name one or more persons who consent to testify on its behalf ... as to matters known or reasonably available to the corporation." 8A Charles Alan Wright, Arthur R. Miller, & Richard L. Marcus, *Federal Practice and Procedure* § 2102, at 30–31 (2d ed.1994). Essentially, "[i]n a Rule 30(b)(6) deposition, there is no distinction between the corporate representative and the corporation." *Sprint Commc'ns. Co. v. Theglobe.com, Inc.*, 236 F.R.D. 524, 527 (D.Kan.2006).

^[3] Thus, like any person named in a subpoena to appear as a deponent or witness, a corporation may be named in a subpoena issued under Rule 45, which "command[s] each *person* to whom it is directed to attend and give testimony" at a trial or deposition. Fed.R.Civ.P. 45(a)(1)(C) (emphasis added); see Fed.R.Civ.P. 30(a)(1) ("A party may take the testimony of any *person*, including a party, by deposition upon oral examination")

(emphasis added). Thus, the word "person" in Rule 45 is not limited merely to "natural persons" but includes juristic persons like corporations and governments as well. Cf. *Yousuf v. Samantar*, 451 F.3d 248, 257 (D.C.Cir.2006) (explaining that "[t]he term 'person' as used in the Federal Rules of Civil Procedure consistently means ... natural persons and business associations ... [as well as] governments" and holding that "the Government is a 'person' subject to subpoena under Rule 45").

^[4] If a party to an *inter partes* proceeding wishes to take the trial testimony of an adverse party or an official of an adverse party who is unwilling to appear voluntarily, then the examining party must secure attendance of the deponent by subpoena. See *Health-Tex, Inc. v. Okabashi (U.S.) Corp.*, 18 U.S.P.Q.2d 1409, 1410 (T.T.A.B.1990). As mentioned previously, the TTAB is not vested with the power to subpoena witnesses in *inter partes* PTO cases. Under 35 U.S.C.A. § 24, Congress instead granted to district courts the power to enforce the rights of litigants to secure the presence of witnesses in contested proceedings in the PTO: "The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent and Trademark Office, shall, upon the application of any party thereto, issue a subpoena for any *witness* residing or being within such district ..." 35 U.S.C.A. § 24 (emphasis added).

We agree with VEL that the "witness" is not limited only to natural persons. The PTO regulations expressly contemplate the use of Rule 30(b)(6) depositions in which the corporation is the "person" named in the subpoena as the deponent. See 37 C.F.R. §§ 2.120(b), 2.124(b)(2). Nothing in the text of 35 U.S.C.A. § 24 suggests to us that, in the context of a contested PTO action, the interplay between Federal Rules 30(b)(6) and 45 operates differently. Indeed, the statute expressly provides that, in contested PTO cases, "[t]he provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses ... shall apply." 35 U.S.C.A. § 24. Nor do we see anything in the statute indicating that Congress wished to tie the court's power to subpoena corporate testimony under Rule 30(b)(6) to the personal *446 residence of the individuals ultimately designated by the corporation to testify on its behalf. Foreign corporations that are subject to the personal jurisdiction of a district court can be and often are required to produce officers, directors, or managing agents—regardless of where such witnesses personally reside—in the United States for a Rule 30(b)(6) deposition. See *Custom Form Mfg., Inc. v. Omron Corp.*, 196 F.R.D. 333, 336 (N.D.Ind.2000); *In re Honda Am. Motor Co. Dealership Relations Litig.*, 168 F.R.D. 535, 540–42 (D.Md.1996).

Accordingly, we do not agree with the magistrate judge's narrow interpretation of "witness," and we hold that corporations, as well as natural persons, are subject to the issuance of Rule 30(b)(6) subpoenas pursuant to 35 U.S.C.A. § 24. And, as a result, we believe the magistrate judge incorrectly concluded that Rosenruist could avoid designating and producing a Rule 30(b)(6) deponent because none of its potential designees were personally "residing or being within" the Eastern District of Virginia.

2.

¹⁵¹ Rosenruist contends that even if the corporation itself can be considered a "witness" under 35 U.S.C.A. § 24, rendering the individual designee's residence or location irrelevant for purposes of a *corporate* subpoena, the subpoena was invalid because Rosenruist itself was not "residing or being within" the district. Rosenruist has not developed this argument except to assert that it lacks the required presence because it "has no business activities, no managing agents, and no agents consenting to testify within the district or anywhere in the U.S." Brief of Appellee at 25. Additionally, Rosenruist points out, the designation of a statutory agent for service under 15 U.S.C.A. § 1051(e) is not sufficient to subject a corporation to the court's subpoena power under § 24.

Rosenruist also contends that the subpoena was not valid because the Rosenruist corporation lacked the "continuous and systematic contacts" with the Eastern District of Virginia necessary to support the district court's exercise of *in personam* jurisdiction. *Helicopteros Nacionales de Colombia, S.A. v. Hall*, 466 U.S. 408, 416, 104 S.Ct. 1868, 80 L.Ed.2d 404 (1984); see *Ratliff v. Cooper Labs., Inc.*, 444 F.2d 745, 748 (4th Cir.1971) (concluding that the designation of a statutory agent for service was insufficient to confer general jurisdiction over an out-of-state corporation).

Although Rosenruist advances these arguments as separate challenges to the validity of the subpoena, they are essentially one and the same argument—that Rosenruist is not subject to the court's subpoena power under § 24 because Rosenruist lacks sufficient contacts in the Eastern District of Virginia. We infer that Rosenruist views the "residing or being" requirement of § 24 as commensurate with the requirements for a court's exercise of general jurisdiction over a party.

¹⁶¹ We conclude these arguments are not properly before the panel because the validity of the subpoena has already been determined. Thus, we need not determine precisely

what is required for a witness to satisfy the statute's "residing or being" component, although we find no support for the notion that the statute requires the "systematic and continuous" presence needed for the exercise of general jurisdiction.⁵

*447 The March 2, 2006, order rejected Rosenruist's motion to quash in which Rosenruist asserted in part that it was not subject to the court's subpoena power. The order established that the subpoena was valid and that the requirements of 35 U.S.C.A. § 24 had been satisfied. Rosenruist did not appeal this ruling.

Subsequently, in its opposition to VEL's motion to compel a Rule 30(b)(6) designation and appearance, Rosenruist argued that the court lacked *in personam* jurisdiction over it and therefore could not enforce the subpoena against it. The court effectively rejected Rosenruist's jurisdictional argument and reiterated that Rosenruist was subject to the subpoena when it granted VEL's motion in part and ordered Rosenruist to designate a Rule 30(b)(6) witness or submit a declaration that no qualifying witness resided or was present within the district. The court, however, refused to require an appearance. VEL, of course, appealed the latter portion of the order, and that appeal is before us now. Rosenruist did not file a cross-appeal.

¹⁷¹ ¹⁸¹ A prevailing party may urge an appellate court "to affirm a judgment on any ground appearing in the record," *Toll Bros., Inc. v. Dryvit Sys., Inc.*, 432 F.3d 564, 572 (4th Cir.2005), and may do so without having to file a cross-appeal, see *Blum v. Bacon*, 457 U.S. 132, 137 n. 5, 102 S.Ct. 2355, 72 L.Ed.2d 728 (1982). If the prevailing party raises arguments that seek to alter or modify the judgment below, then a cross-appeal is required. See *El Paso Nat. Gas Co. v. Neztosie*, 526 U.S. 473, 479, 119 S.Ct. 1430, 143 L.Ed.2d 635 (1999) ("Absent a cross-appeal, an appellee may urge in support of a decree any matter appearing in the record, although his argument may involve an attack upon the reasoning of the lower court, but may not attack the decree with a view either to enlarging his own rights thereunder or of lessening the rights of his adversary." (internal quotation marks omitted)); see also *JH ex rel. JD v. Henrico County Schl. Bd.*, 326 F.3d 560, 567 n. 5 (4th Cir.2003) ("The general rule is that without taking a cross-appeal, the prevailing party may present any argument that supports the judgment in its favor as long as the acceptance of the argument would not lead to a reversal or modification of the judgment" (internal quotation marks and alteration omitted)).

Here, Rosenruist asks us to affirm the court's refusal to

require it to produce a Rule 30(b)(6) witness as commanded by the subpoena based on Rosenruist's lack of presence and the issuing court's lack of personal jurisdiction. As explained previously, the court below clearly concluded that the subpoena was valid and that Rosenruist *as a corporation* was subject to the subpoena. Thus, these particular arguments, were the panel to accept them, would require us to modify the court's judgment below and enlarge Rosenruist's rights thereunder. Because Rosenruist did not assert a cross-appeal, we decline to consider these issues.

B.

Rosenruist next contends that § 24 was enacted only to enforce the rules and procedures developed by the PTO, and VEL's reading of the statute will permit it to exercise procedural rights beyond those established by the PTO. *See Frilette*, 508 F.2d at 209–11 (rejecting the notion that 35 U.S.C.A. § 24 allows a party to bootstrap itself into additional means of discovery not provided by the PTO).

Relying on the TBMP (the TTAB's Manual of Procedure) Rosenruist suggests that the PTO's rules do not permit the attendance of a foreign witness to be secured by a subpoena. According to the *448 TBMP, a "party [who] wishes to take the trial testimony of an adverse party or nonparty (or an official or employee of an adverse party or nonparty) residing in the United States ... [who] is not willing to appear voluntarily to testify ... must secure the attendance of the witnesses by subpoena." TBMP § 703.01(f)(2). The TBMP provides that for an unwilling witness who resides in a foreign country, however, "[t]here is no certain procedure for obtaining ... the trial testimony deposition of [such] a witness" and that the deposing party may obtain such testimony through "the letter rogatory procedure or the Hague Convention letter of request procedure." TBMP § 703.01(f)(3).

^[9] It is important to recognize that the TBMP is simply a manual issued by the TTAB "to practitioners with basic information generally useful for litigating cases before the [TTAB]," which expressly acknowledges that it "does not modify, amend, or serve as a substitute for any statutes, rules or decisional law and is not binding upon the [TTAB]." TBMP, Intro. The TBMP does not provide, or even purport to provide, authoritative interpretive guidance with regard to the scope of 35 U.S.C.A. § 24 or any other statute. Rather, it merely sets forth the TTAB's informal opinion that the statute does not provide authority for a district court to issue a subpoena to an unwilling foreign deponent. We are neither bound by the

TBMP nor obligated to consider its statutory interpretation particularly persuasive.

We conclude that reading the statute to permit the issuance of a Rule 30(b)(6) subpoena to Rosenruist does not expand or add to the procedures established by the PTO. As noted above, the PTO's rules of procedure allow for the use of Rule 30(b)(6) depositions in *inter partes* cases and permit the taking of trial testimony "by depositions upon oral examination." 37 C.F.R. § 2.123(a); *see id.* § 2.123(c) ("Depositions may be noticed for any reasonable time and place in the United States.")⁶ The issue here simply involves the extent of the district court's subpoena power under § 24 to ensure that parties are able to use the existing PTO *inter partes* procedures. VEL is not seeking to exercise a right or use a procedure that the PTO has not provided.

C.

Finally, Rosenruist argues that the service of the subpoena was ineffective because it failed to comply with Rule 45(b)(1), which requires the witness fee and reasonably estimated mileage to be tendered at the time of service. *See Fed.R.Civ.P.* 45(b)(1); *In re Dennis*, 330 F.3d 696, 705 (5th Cir.2003). We reject this argument. In the March 2, 2006, order denying Rosenruist's motion to quash, the magistrate judge determined that service was effective. Rosenruist did not appeal that order. The magistrate judge also reiterated that conclusion in the May 2, 2006, order which is the subject of this appeal. Because Rosenruist did not cross-appeal this portion of the court's decision, we decline to address it. *See Pritchett v. Alford*, 973 F.2d 307, 315 (4th Cir.1992).

III.

For the foregoing reasons, we reverse the order of the district court denying *449 VEL's motion to compel Rosenruist to obey the subpoena, and we remand for further proceedings consistent with this opinion.

REVERSED AND REMANDED

WILKINSON, Circuit Judge, dissenting:

In a first for any federal court, my colleagues hold that a foreign company that has no United States employees,

locations, or business activities must produce a designee to testify at a deposition in the Eastern District of Virginia so long as it has applied for trademark registration with a government office located there. 35 U.S.C. § 24 (2000). As a result, foreign witnesses can be compelled to travel to the United States and give in-person deposition testimony at the behest of any litigant in a trademark dispute, “for use in any contested case in the Patent and Trademark Office” (“PTO”)—though the PTO’s own procedures call for obtaining testimony from foreign companies through other means. *Id.*

The majority’s holding that this subpoena is enforceable is problematic for many reasons. It fails to properly apply the statute, 35 U.S.C. § 24, that is directly relevant to its decision, and it reaches a result that is bound to embroil foreign trademark applicants in lengthy, procedurally complex proceedings. It inverts longstanding canons of construction that seek to protect against international discord, and it disregards the views of the PTO whose proceedings 35 U.S.C. § 24 is designed to aid. In view of the statutory text (*see* Section I), interpretive canons, international relationships, and separation of powers concerns (II), and the PTO’s own framework (III), I firmly believe this subpoena must be quashed.

I recognize this is an extensive dissent. However, the brevity of the majority’s conclusion belies its significance. No matter how one cuts the cookie, the bottom line is that the majority enforces the subpoena. In so doing, the majority creates a standard that is in fact a national one: the PTO is located in the Eastern District of Virginia; applications for trademark registration are filed there; and subpoena enforcement will frequently be sought in that district. Indeed, for any foreign corporation without a pre-existing United States presence, the majority’s decision will be controlling. For this reason, among others, I think this decision is unfortunate. The decision to extend the subpoena power under 35 U.S.C. § 24 to foreign companies situated similarly to Rosenruist is one that is plainly before this court, and its importance warrants full discussion.

I.

The first obstacle to the majority’s view is the language of the statute itself. The statute provides,

The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent and

Trademark Office, shall, upon the application of any party thereto, issue a subpoena for *any witness residing or being within such district*, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena.

35 U.S.C. § 24 (emphasis added). The majority argues correctly that Rosenruist is a “witness” under this provision. My colleagues hold properly that the term “‘witness’ is not limited only to natural persons.” *Ante* at 446. “[C]orporations, as well as natural persons, are subject to the issuance of Rule 30(b)(6) subpoenas pursuant to 35 U.S.C. § 24.” *450 *Ante* at 445–46. This is correct, and I agree with it fully.

The majority then gives short shrift, however, to the statute’s very next words, which state that a party in patent proceedings may seek to subpoena only a “witness *residing or being within such district.*” *Id.* (emphasis added). Through a strained interpretation of this case’s procedural posture, the majority first claims that the issue of whether Rosenruist is “residing or being” within the Eastern District of Virginia is “not properly before the panel because the validity of the subpoena has already been determined.” *Ante* at 446. Thus, the majority seems content to interpret only half of the relevant statutory phrase.

However, the majority then issues a conclusory statement, albeit in dicta, that “Rosenruist’s activities in this case were sufficient to qualify it as ‘being within [the] district.’” *Ante* at 446 n. 5. It is not a good idea to have a single sentence of dicta pass upon matters of such foreign and domestic import. As a result, the majority expresses its view on the merits in a manner that avoids any need for explication, but is simultaneously bound to influence how district courts interpret this enactment.

The upshot of this ruling is painfully clear. The majority first entangles foreign trademark applicants in a procedural web by misapplying basic principles of appellate process. It then flatly and wrongly concludes that the statute affords no protection to the prospective trademark registrants.

A more effective one-two punch could not have been landed upon foreign trademark applicants. Because I think that the question of the statute’s application is clearly before us and that Rosenruist cannot be described, under

any reasonable interpretation of 35 U.S.C. § 24, as “residing or being” within the Eastern District of Virginia, I respectfully dissent from both the majority’s procedural and substantive conclusions.

A.

Because, through any lens, 35 U.S.C. § 24 is integral to the resolution of this case, I begin with a discussion of the statute itself. In plain language, the statute limits the geographic scope of a PTO litigant’s subpoena powers to those “residing or being” within a U.S. judicial district. In ordinary use, limiting compulsory depositions to witnesses “residing or being” within a district requires a physical presence or at least sustained contacts in a district. *The Random House Dictionary of the English Language*, for example, defines to “reside” as “to dwell permanently or for a considerable time,” and defines “to be” as “to exist or live” or “to occupy a place or position.” *Random House Dictionary of the English Language* (2d ed.1987).¹

The PTO itself has embraced a geographically constrained view of the subpoena powers that § 24 confers with respect to its proceedings. Its clearest guidance on this matter comes from its Trademark Trial and Appeal Board Manual of Procedure. The manual states that a district in which a domestic witness is “residing or *451 being” is a district “where the witness resides or is regularly employed.” Trademark Trial and Appeal Board Manual of Procedure (“TTAB Manual”) § 703.01(f)(2) (2d ed. revision 1, 2004). If a PTO litigant wishes to obtain testimony of an unwilling adverse party, the litigant “must secure the attendance of the witness by subpoena ... pursuant to 35 U.S.C. § 24 and Fed.R.Civ.P. 45, from the United States district court in the Federal judicial district *where the witness resides or is regularly employed.*” *Id.* (emphasis added). As the majority notes, the manual does not substitute for the statute itself or for the PTO’s regulations, *ante* at 448, but the manual is entitled to respect as the PTO’s own description of its “current practice and procedure under the applicable authority.” *See* TTAB Manual, Introduction.

B.

Rosenruist, a Portuguese company, cannot be described as “residing or being” in the Eastern District of Virginia within the meaning given to these terms by the PTO or

indeed with any meaning consistent with ordinary use. Rosenruist has no physical or commercial presence in the district, and no officers or employees either there or anywhere in the United States. It has no facilities, buildings, or operations in the Eastern District and has not carried out commercial activities there or elsewhere in the country.

Virgin Enterprises Ltd. (“VEL”), which seeks in-person depositions in the United States with Rosenruist officials, argues that Rosenruist can nevertheless be compelled to testify because it has filed an application for trademark registration with a government office located within the Eastern District of Virginia, and is “affirmatively press[ing] a claimed right to issuance of a United States trademark registration.” *Brief of Appellant* at 37. But a person or company is no more “residing or being” within a district by virtue of seeking trademark protection with an office located there than a person would be “residing or being” within a district because he or she applied for a license without so much as setting foot in the territory. Filing an application with a government office is a contact within a jurisdiction, but it does not establish a physical presence or sustained contact akin to a presence within a district.

This trademark application and the attendant proceedings are Rosenruist’s sole contacts with the district—as evidenced by the way in which VEL subdivides paperwork and proceedings surrounding the single trademark application in an effort to portray multiple, incidental contacts. Rosenruist designated attorneys as its representatives for service of process in proceedings affecting its proposed trademark, under a statute providing that if a company does not name a representative, the Director of the Patent and Trademark Office will be designated to fill the role. 15 U.S.C. § 1051(e) (2000). Appointment of an agent for service of process is a contact so minimal that our circuit has held it cannot render a company subject to judicial compulsion under *any* statute consistent with Due Process principles limiting personal jurisdiction, much less under a statute whose language requires more than the constitutional minimum. *Ratliff v. Cooper Labs.*, 444 F.2d 745, 748 (4th Cir.1971). Moreover, under § 1051, a trademark applicant always has a representative for service of process as a result of registering a mark, whether by designation or default—making this so-called contact no more than an aspect of filing a trademark application with the PTO.

Nor can the existence of a case before the PTO mean that Rosenruist is “residing or being” within the Eastern District *452 of Virginia. VEL contested Rosenruist’s trademark application by filing an opposition, *see* 15

U.S.C. § 1063 (2000), generating a “contested case in the Patent and Trademark Office,” in which Rosenruist is the defendant. But this is also a consequence that may obtain whenever a company files an application for a trademark, because other companies or persons are free to contest trademark registrations. Moreover, the existence of a “contested case in the Patent and Trademark Office” is itself a precondition for a subpoena under § 24, separate from the statute’s second requirement that witnesses can only be subpoenaed in a United States judicial district in which they are “residing or being.” It is highly implausible that Congress meant this separate “residing or being” limitation to allow any witness, domestic or foreign, to be subpoenaed in the Eastern District whenever the statute’s apparently distinct first requirement is satisfied and there is a “contested case” in the PTO.

In sum, the only contacts Rosenruist has had with the Eastern District of Virginia are the de minimis contacts from the act of filing for trademark registration itself. This does not entitle VEL to enforcement of the subpoena. Whatever consequences may ensue from Rosenruist’s failure to appear is something Rosenruist might wish to ponder, but the only question before us is whether the subpoena must be quashed. I believe it must be. No matter how many times the act of filing for a trademark application is repackaged and restated by VEL, this act does not make up for the lack of any physical facilities, business activities, or company employees within a district sufficient to render a Portuguese company “residing or being” within the district. This is true under the PTO’s own definition or under any definition consistent with the ordinary meaning of the limiting language enacted by Congress.

C.

There is thus no question that 35 U.S.C. § 24 does not permit this subpoena to be enforced. The majority—in enforcing the subpoena and in concluding flatly that “Rosenruist’s activities in this case were sufficient to qualify it as ‘being within [the] district’ ” —manages astonishingly to say that the issue of the subpoena’s enforcement pursuant to 35 U.S.C. § 24 is somehow not before the court. *Ante* at 447. This is too clever by half. The district court’s ultimate judgment was that Rosenruist could not be compelled to give an in-person deposition because the conditions of 35 U.S.C. § 24 had not been met. *See ante* at 443. The majority, however, discusses who may be a “witness” under 35 U.S.C. § 24 and then re-labels the “residing or being” requirement of § 24 as a

question bearing upon the “validity” of the subpoena, as though that will somehow make the statute go away. *See ante* at 444–47. But courts cannot interpret one word in a prepositional phrase and ignore another. By picking only selective portions of § 24 to interpret, the majority manages to enforce the subpoena, in violation of the explicit standard Congress has given us to apply.

With its actions, the majority ignores the fact that, as an appellate court, we sit to review *judgments*, not the reasons underlying such judgments. The district court rejected VEL’s objections to the magistrate’s denial of VEL’s motion to compel Rosenruist’s appearance at a deposition in this country. This is the judgment order VEL appeals. But the majority has elevated reasons into judgments. In focusing on the district court’s construction of the term “witness,” the majority fails to consider an alternate and valid *453 reason for affirming the district court’s judgment—namely, that Rosenruist cannot be deemed to “be” or “reside” within the district as § 24 requires. The majority cleaves § 24 in two, and finds that the district court rested its judgment on only part of the statute in question. But this is not the case: the enforceability of the subpoena rests on both the “witness” and the “residing or being” requirements, and we review the district court’s judgment that the subpoena is not enforceable as to Rosenruist’s deposition as a whole.

This is precisely how the parties understood the issue on appeal. *See Brief of Appellant* at 3 (“This case concerns the scope of the District Court’s subpoena power under 35 U.S.C. § 24.”); *Brief of Appellee* at 4 (at issue is “whether the district court correctly denied VEL’s motion to compel, subsequent to the Court’s satisfying itself that Rosenruist had no ‘witness’ under 35 U.S.C. § 24 residing or being in the district”). Rosenruist is seeking to affirm the judgment declining to enforce the subpoena, not to modify any part of it, and a party seeking affirmance of a judgment need not lodge a cross-appeal to have that affirmance rest on an alternate ground. In view of the fact that this is a single judgment, and Rosenruist prevailed on that judgment, one cannot possibly saddle Rosenruist—as the majority has—with the obligation to file a cross-appeal. This at best creates busy work and at worst compounds the procedural snares the majority has devised for foreign companies at the outset of their trademark applications.

Furthermore, despite what I respectfully suggest is an incorrect rendering of the case’s procedural posture, the majority cannot hide the true import of its opinion: that this subpoena is in its view perfectly enforceable. The majority reaches this conclusion by eschewing any interpretation of the “residing or being” language of 35

U.S.C. § 24, while at the same time expressing unequivocally its view on the merits of this question in a conclusory footnote. *Ante* at 446 n. 5. This unexplained declaration is also error. It is inescapable that Rosenruist is not “residing or being” within the Eastern District of Virginia. Therefore, the subpoena may not be enforced.

II.

A.

My problems with the majority’s decision do not end with what I respectfully suggest is its erroneous and conclusory view of 35 U.S.C. § 24. I also disagree with the disregard of cautionary canons of interpretation that apply to statutes bearing upon other nations’ interests and international norms. The reach of American law in “situations involving one or more foreign contacts,” *Romero v. Int’l Terminal Operating Co.*, 358 U.S. 354, 382, 79 S.Ct. 468, 3 L.Ed.2d 368 (1959), is constrained by maxims that “protect against unintended clashes between our laws and those of other nations which could result in international discord,” *EEOC v. Arabian American Oil Co.*, 499 U.S. 244, 248, 111 S.Ct. 1227, 113 L.Ed.2d 274 (1991) (citing *McCulloch v. Sociedad Nacional de Marineros de Honduras*, 372 U.S. 10, 20–22, 83 S.Ct. 671, 9 L.Ed.2d 547 (1963)). The majority decision risks such disruption by enabling litigants to compel in-person depositions from foreign companies with the most minimal U.S. contacts, as a condition of those companies obtaining a legal protection that is critical to international commerce.

A sense of comity, not needless friction, should govern this whole area. The contours of the “rule of construction ... derived from the principle of ‘prescriptive *454 comity,’ ” *Hoffmann–La Roche Ltd. v. Empagran S.A.*, 542 U.S. 155, 164, 124 S.Ct. 2359, 159 L.Ed.2d 226 (2004) (internal citations omitted), are fatal to the majority’s view of § 24. The rule requires that judges “ordinarily construe[] ambiguous statutes to avoid unreasonable interference with the sovereign authority of other nations” and assumes “that legislators take account of the legitimate sovereign interests of other nations when they write American laws.” *Id.* While the majority of course is not trying to tell Portuguese authorities how to enforce Portuguese law, it is wading into international waters, not only without congressional authority but in the face of contrary congressional intent. All canons of statutory construction mandate caution in this context. By

brushing aside 35 U.S.C. § 24 as well as the canons that should inform its construction, the majority instead mandates maximum levels of foreign corporate exposure to American judicial process. This approach does anything but help “the potentially conflicting laws of different nations work together in harmony ... particularly needed in today’s highly interdependent commercial world.” *Hoffmann–La Roche*, 542 U.S. at 164–65, 124 S.Ct. 2359.

This presumption of comity, so helpful to good will and active commerce among nations, exists even with respect to statutes that specify no geographic limit. It emphatically exists with respect to statutes such as § 24 whose terms indicate that Congress wanted a limited territorial reach. Courts work from the “commonsense notion that Congress generally legislates with domestic concerns in mind.” *Small v. United States*, 544 U.S. 385, 388, 125 S.Ct. 1752, 161 L.Ed.2d 651 (2005) (quoting *Smith v. United States*, 507 U.S. 197, 204 n. 5, 113 S.Ct. 1178, 122 L.Ed.2d 548 (1993)). Indeed, courts do so even when “the more natural reading of the statutory language” would be to include foreign companies or conduct. *Hoffmann–La Roche*, 542 U.S. at 174. For instance, *Small* held that a statute referring to a person “convicted in *any court* ” did not apply to persons convicted in foreign courts, in part by invoking canons counseling limited construction of general statutes in international contexts. 544 U.S. at 388, 125 S.Ct. 1752 (emphasis added). It cannot be contended that these canons somehow do not apply to § 24, which is not even written in universal terms, but contains terms of geographic limitation.

These interpretive principles are too important for my good colleagues simply to ignore. It hardly respects the legitimate interests of other nations, *see Hoffmann–La Roche*, 542 U.S. at 164, 124 S.Ct. 2359, to allow litigants to compel in-person testimony in the Eastern District from representatives of foreign companies whose only act within our borders has been the filing of a trademark application. In giving regard to other nations’ interests, the Supreme Court has held that judges “must assume” Congress ordinarily seeks to follow the Restatement of Foreign Relations Law in determining whether a U.S. statute applies. *Id.* at 164, 124 S.Ct. 2359. The Restatement provides that a nation will not exercise its jurisdiction “when the exercise of such jurisdiction is unreasonable,” *Rest. (Third) Foreign Rels. Law* § 403(1) (2006), and that a foreign person or company’s “connections, such as nationality, residence, or economic activity” to the state are one relevant consideration, *id.* § 403(2)(b). To make the price of a simple trademark application an overseas trip by a company officer or officers to answer a deposition is to impose a substantial

burden from a minimal connection.

I realize that when a subpoena is served upon a corporation, the corporation can designate whom it wishes to produce for *455 the subpoena. *See* Fed R. Civ. P. 30. But this provides no meaningful relief, because an organization's Rule 30 designee must be fully prepared to "testify as to matters known or reasonably available to the organization." Fed.R.Civ.P. 30(b)(6). The heart of Rosenruist's predicament is that it has no U.S. employees or U.S. operations, and consequently that no person within this country is equipped to testify "as to matters known or reasonably available" to the company. *Id.* VEL is surely correct that Rosenruist could change this, but only at considerable expense and over time. Rosenruist could hire a lawyer or other U.S. resident to serve as its representative for Rule 30 purposes, and provide the newly minted designee with a crash course in the matters of corporate strategy and intellectual property on which the company's testimony was sought. But a company's right to pay for a capable U.S.-based representative and then divert its officers to fully prepare the representative is hardly a compliance option that renders the extension of § 24 to foreign companies such as Rosenruist a minimal imposition.

It may or may not be burdensome for the designee of a company large or small to fly from Portugal or India or Japan for a deposition in the Eastern District of Virginia. It may be that technology in time may provide less burdensome alternatives. District courts always have the power to quash subpoenas as posing an "undue burden," but litigation over burdensomeness is not inconsequential and imposes a burden in its own right upon trademark applicants. *See* Fed.R.Civ.P. 45. If Congress had struck a balance that imposed these costs upon foreign companies with de minimis United States contacts, that would be one thing, but for courts to impose these burdens based upon a foreign company's minimal contacts here reads a statute that is at best ambiguous in a manner that impinges on other nations' interests and risks at least a measure of international discord.

B.

The majority's disregard for these cautionary canons of construction invites retaliatory actions of all sorts. The Supreme Court has sought to avoid applications of U.S. statutes to foreign companies or conduct that could generate "retaliatory action from other nations," *McCulloch*, 372 U.S. at 21, 83 S.Ct. 671, and "disrupt[on] of international commerce," *Romero*, 358

U.S. at 384, 79 S.Ct. 468. Yet the new burden that the majority places upon foreign companies to give in-person depositions in our country simply because they filed for registration of their trademark—a burden that so far as I can tell has never before been imposed by any court under § 24—risks just such retributive measures. It is simply unrealistic to suppose that other nations will sit quietly while their own companies and citizens are subjected to depositions in this country. It is thoroughly realistic to anticipate their imposing corresponding burdens and inconveniences upon Americans who seek trademark protection for their own activities abroad.

Congress has indicated that trademark protection is vital to commerce since it first made actionable "the deceptive and misleading use of marks" based upon the harms that such abuses cause to interstate commerce. 15 U.S.C. § 1127 (2000). It declared that the trademark system sought "to protect persons engaged in such commerce against unfair competition" that would ensue if one company could use another's name, logo, or other mark to benefit from the other's good will and sow confusion among consumers. *Id.* Foreign companies are no less dependent upon the protection of their products and properties *456 for their commercial activities. The imposition of new burdens upon foreign companies, when they take no more than the first perfunctory step to register their trademark here, undermines a predicate of international commerce that a more modest conception of the judicial function would avoid.

The majority also fails to inquire as to "the degree to which the desirability of such regulation [subpoena authority] is generally accepted" and "the extent to which the regulation is consistent with the traditions of the international system," as well as "the character of the activity to be regulated." *Rest. (Third) Foreign Rels. Law* § 403(2)(c), § 403(2)(f). The majority does not ask whether, in authorizing subpoenas of foreign witnesses to the Eastern District of Virginia for in-person depositions, it is rebuking a consensus surrounding reciprocal reductions in barriers to the protection of intellectual property. Under the Madrid Protocol Relating to the Madrid Agreement Concerning International Registration of Marks, which the United States joined in 2003, an increasing number of nations permit the citizens of signatory states to seek trademark protection through a single transnational application, without filing new papers from country to country.² This agreement does not by any means decide the issue, but the reciprocal actions of these signatory nations suggest no basis in trademark law for the procedural hurdle that the majority today erects. And insofar as the Protocol indicates that a norm of reciprocity carries weight in this arena, other states could well

consider my colleagues' imposition of this novel procedural hurdle upon their companies to be an invitation to impose corresponding retaliatory hurdles of their own.

Nor can the majority claim a basis for its decision by asserting that there is a need for in-person testimony in cases where a trademark holder claims that a foreign company has made or sold goods here that infringe an existing mark. Section 24, which applies only to PTO proceedings, does not in any way diminish the ability of trademark holders to bring infringement actions in federal court against companies that—unlike Rosenruist—distribute potentially infringing goods or conduct operations here. *See Steele v. Bulova Watch Co.*, 344 U.S. 280, 286–27, 73 S.Ct. 252, 97 L.Ed. 319 (1952). Section 24 does not bear upon the availability of in-person testimony in such infringement cases, because § 24 governs only PTO proceedings. *See* 35 U.S.C. § 24. A proper view of § 24 would do no more than protect companies such as Rosenruist that have taken only the first step to register their marks from the burdens of in-person depositions in cases before the PTO—burdens that can be adjusted by Congress as the exigencies of commerce and international trade require.

C.

Separation of powers considerations are present also. I recognize that the statute at issue here is one that regulates judicial process, an issue on which courts rightly claim an expertise. That does not change the equation, however. Congress regulates judicial process through rules and statutes too numerous to mention. None of this regulation affords courts the authority to displace congressional enactments on judicial process with their own. *457 Notwithstanding the fact that 35 U.S.C. § 24 bears upon judicial process, the impact of in-person depositions of foreign companies in the Eastern District of Virginia is quite beyond the ken of judges. Courts have recognized consistently that we should act cautiously where foreign relations are in play, because other branches of government are best suited to make judgments in these areas. For instance, extraterritorial application of federal law has long been disfavored in part because “such a construction would have had foreign policy implications.” *Weinberger v. Rossi*, 456 U.S. 25, 32, 102 S.Ct. 1510, 71 L.Ed.2d 715 (1982). And a narrow construction of the National Labor Relations Act has been justified where “international implications” would ensue from a broad one. *NLRB v. Catholic Bishop of Chicago*, 440 U.S. 490, 500, 99 S.Ct. 1313, 59 L.Ed.2d 533 (1979). It is essential

to recognize the international ramifications that may ensue from far-reaching holdings such as this one, and to defer to the political branches, as the Supreme Court has long done, in a matter of some international delicacy.

Other statutes in fact suggest the judgment of my fine colleagues is not in line with the judgment of Congress. As noted earlier, the majority's decision seems in some tension with the Madrid Protocol's scheme of reciprocal reduction in barriers to intellectual property protections abroad. In addition, 28 U.S.C. § 1783 authorizes subpoenas of an *American* citizen or resident “who is in a foreign country” only upon a showing “that particular testimony or the production of the document or other thing by him is necessary in the interest of justice” and, in civil cases, “that it is not possible to obtain his testimony in admissible form without his personal appearance or to obtain the production of the document or thing in any other manner.” 28 U.S.C. § 1783(a) (2000). The high standard Congress has imposed upon litigants seeking to put even our own citizens to the expense and inconvenience of international travel to give a deposition here suggests that this court's unwarranted extension of subpoena powers is not just a judgment that should be left to Congress but a judgment that is out-of-step with Congress' approach.

III.

My friends in the majority not only make a policy decision that should be left to Congress, but also disregard the views of the most relevant expert agency in doing so. My colleagues disregard the limited view of the Patent and Trademark Office for whose sole benefit testimony under § 24 is intended, and authorize litigants to circumvent the framework that the PTO has established for obtaining testimony from foreign witnesses. This is unsound, both because of the PTO's expertise in trademark matters and because the text of § 24 indicates that it should be invoked only in aid of PTO proceedings—“for use in any contested case in the Patent and Trademark Office.” 35 U.S.C. § 24.

A.

The Trademark Trial and Appeal Board's view that § 24 excludes foreign companies with minimal American contacts is evident from the record. The TTAB attorney overseeing the instant dispute denied VEL's motion to

compel Rosenruist to appear for an oral testimony deposition in its home country of Portugal, in a letter that indicated there was no ready mechanism for obtaining in-person depositions from foreign adverse parties. In particular, the attorney wrote, “where the adverse party or unwilling witness *resides in a foreign country*, the party seeking to take the testimony deposition of such witness *458 *may not be able to do so absent the letter rogatory procedure or The Hague Convention letter of request procedure.*” (emphasis added).

The TTAB attorney relied upon the TTAB Manual, which likewise indicates that foreign companies like Rosenruist are not generally subject to compulsion under § 24 because they are not “residing or being” in any district of the United States. The manual’s provisions on domestic and foreign witnesses present a striking contrast. The manual first indicates that parties to a PTO proceeding may use § 24 to subpoena domestic witnesses in the judicial districts where they reside or are employed. It provides,

If a party wishes to take the trial testimony of an adverse party or nonparty (or an official or employee of an adverse party or nonparty) residing in the United States, and the proposed witness is not willing to appear voluntarily to testify, the party wishing to take the testimony must secure the attendance of the witness by subpoena.

TTAB Manual § 703.01(f)(2). The subpoena “must be issued, pursuant to 35 U.S.C. § 24 and Fed.R.Civ.P. 45, from the United States district court in the Federal judicial district where the witness *resides or is regularly employed.*” *Id.* (emphasis added).

The immediately subsequent provision entitled “Unwilling witness residing in a foreign country,” describes no role for § 24 with respect to such witnesses. It states, to the contrary,

There is *no certain procedure* for obtaining, in a Board inter partes proceeding, the trial testimony deposition of a witness who resides in a foreign country, is an adverse party or a nonparty (or an official or employee of an adverse party or nonparty), and is not willing to appear voluntarily to testify.

TTAB Manual § 703.01(f)(3) (emphasis added); *see also* TTAB Manual § 703.01(f)(1) (“[W]here a party wishes to take the testimony of an adverse party or nonparty, or an official or employee of an adverse party or nonparty, and the proposed witness is not willing to appear voluntarily to testify ... the party that wishes to obtain the deposition must take steps, discussed below, to compel the attendance of a witness. *If the witness resides in a foreign country, the party may not be able to take the deposition.*”) (emphasis added).

The regulations governing PTO proceedings, while less explicit, fully support the TTAB Manual and the TTAB hearing officer in concluding that a party cannot demand in-person oral testimony from a foreign party such as Rosenruist simply because the foreign party filed a trademark application. The regulations make no mention of subpoenaing foreign witnesses under § 24 for testimony or discovery depositions,³ but they *do* describe § 24 as available to compel discovery depositions from persons who “live or reside” in *459 the United States—indicating again that the agency construed § 24 as applicable only to witnesses that “live or reside” in the country. *Compare* 37 C.F.R. § 2.120(b) (2006) (stating that the discovery “deposition of a natural person shall be taken in the federal judicial district where the person *resides or is regularly employed* or at any place on which the parties agree by stipulation”) (emphasis added) *with* 37 C.F.R. § 2.120(c) (providing for discovery depositions of representatives of foreign witnesses abroad on written questions unless the TTAB orders oral deposition on motion for good cause).⁴ These provisions are simply incompatible with VEL’s view that foreign trademark applicants can *always* be compelled to give in-person depositions in contested PTO cases, so long as they are subpoenaed in the Eastern District of Virginia. They indicate, to the contrary, that because § 24 authorizes the compulsion of witnesses only in judicial districts where they are “residing or being,” foreign companies with de minimis ties to our country are outside the statute’s scope because they are not “residing or being” in the United States.

In addition, the TTAB has elaborate provisions that allow litigants to take the testimony of foreign adverse parties or other witnesses through mechanisms other than in-person deposition testimony, which would make little sense if such parties could simply be called to give oral deposition testimony in the United States. Litigants may take foreign witnesses’ depositions through the letter rogatory procedure and Hague Convention letter of request procedure, *see* TTAB Manual § 703.01(f)(3); *id.* § 404.03(c)(2), and may take depositions upon written questions without regard to a witness’s or party’s country

of origin, *see* 37 C.F.R. § 2.124; *id.* § 2.123. Perhaps most critically, the regulations establish a presumption in favor of written depositions by foreign witnesses in foreign countries over oral depositions abroad. They provide, “A testimonial deposition taken in a foreign country shall be taken by deposition upon written questions ... unless the Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate.” *Id.* § 2.123(2).

It is hard to imagine that the TTAB would have made it so difficult to subpoena foreign parties for oral depositions in their home countries, if it viewed § 24 as permitting parties to require such witnesses to travel to the United States to give such depositions. In sum, like the TTAB Manual and the TTAB ruling in this case, the PTO’s framework of regulations suggests that the agency whose expertise in trademark *460 disputes is entitled to respect viewed foreign companies with very limited American contacts as beyond the reach of adverse parties under § 24.

B.

Congress has provided that the PTO “shall be responsible for the granting and issuing of patents and the registration of trademarks” and “may establish regulations, not inconsistent with law” that “shall govern the conduct of proceedings in the Office.” 35 U.S.C. § 2 (2000). We have therefore noted that TTAB decisions interpreting the extent of intellectual property protections under the Lanham Act are entitled to “great weight.” *Int’l Bancorp, LLC v. Societe des Bains de Mer et du Cercle des Etrangers a Monaco*, 329 F.3d 359, 378 (4th Cir.2003); *see also In re Dr. Pepper Co.*, 836 F.2d 508, 510 (Fed.Cir.1987) (“While the interpretations of the statute by the board are not binding on this court, under general principles of administrative law, deference should be given by a court to the interpretation by the agency charged with its administration.”).

A number of our sister circuits have noted the perils of simply disregarding the PTO’s view in construing other aspects of § 24’s scope. Those circuits have placed especial emphasis upon § 24’s authorization of in-person depositions only when the “testimony is to be taken for use in any contested case in the Patent and Trademark Office.” 35 U.S.C. § 24 (emphasis added). The First, Third, and Fifth Circuits have thus held that § 24 authorizes district courts to issue subpoenas for discovery materials only when the PTO’s rules also authorized the parties to obtain the materials in question. *See Brown v.*

Braddick, 595 F.2d 961, 966 (5th Cir.1979); *Sheehan v. Doyle*, 529 F.2d 38, 39 (1st Cir.1976) (“*Doyle I*”); *Sheehan v. Doyle*, 513 F.2d 895 (1st Cir.1975) (“*Doyle I*”); *Frilette v. Kimberlin*, 508 F.2d 205 (3d Cir.1974) (en banc). *But see Natta v. Hogan*, 392 F.2d 686, 690 (10th Cir.1968) (suggesting § 24 authorizes district courts to issue subpoenas without regard to limitations in PTO’s rules).

The First Circuit explained based upon § 24’s text and structure that the statute “is simply a provision giving teeth, through the courts’ subpoena powers, to authority conferred upon the Commissioner of Patents.” *Doyle I*, 513 F.2d at 898. It “provided for judicial subpoenas to be used in aid of contested Patent Office cases (including for purposes of broad-based Federal Rules of discovery) but only to the extent permitted by the Commissioner of Patents,” who heads the PTO. *Doyle II*, 529 F.2d at 39. “What we rejected,” the First Circuit concluded, “was the use of the federal district courts ‘as alternative forums of first resort rather than as forums acting strictly in aid of a primary proceeding.’ ” *Id.* (quoting *Doyle I*, 513 F.2d at 899).

VEL’s view suffers the problems identified by the First, Third, and Fifth Circuits. While § 24’s authorization of subpoenas only for testimony “to be taken for use in any contested case in the Patent and Trademark Office” led those circuits to reject use of § 24 to obtain evidence the PTO does not authorize, VEL glosses over this limitation entirely. This enables disruptions of PTO proceedings that our sister circuits explained would be incompatible with the statute’s design as an aid to PTO proceedings. In particular, because of the majority’s decision, PTO litigants can now routinely seek to stay the agency’s proceedings, as VEL has done here, and then go before a district court and get evidence not provided for under the PTO’s own rules. *See Frilette*, 508 F.2d at 210. This divorces the subpoena authority from “the rudder that the court or agency which *461 should have control over the case can provide,” *id.* at 211, and permits evasion of the PTO’s framework for obtaining evidence in its own cases. The majority’s disregard for the PTO’s ruling in this case, the TTAB Manual, and the structure set forth in PTO regulations not only ignores the expertise of the agency most familiar with the statute before us, but also does violence to the statute’s role—established by its text—as an aid to PTO proceedings.

IV.

In concluding without explanation that foreign companies

with the most minimal U.S. contacts ought to be subject to compulsory in-person depositions in PTO cases, the majority overlooks the guideposts—including the very statute governing this situation—that should control its decision. It disregards the statutory text limiting such compulsion to entities “residing or being” within a United States judicial district. It ignores numerous canons of construction relevant to the statute’s foreign reach. It disregards the evident expert view of the PTO whose proceedings § 24 is intended to aid.

I fear the result is not simply one that Congress did not intend, but one that could in time negatively impact not only the operations of the PTO, but also international trade and foreign relations. Since a statute that authorizes compulsory depositions only of entities “residing or being” within a judicial district does not clearly reach

foreign companies that have done nothing more than file an application for trademark registration, I would heed the Supreme Court’s cautionary words: “[f]or us to run interference in such a delicate field of international relations there must be present the affirmative intention of the Congress clearly expressed.” *Benz v. Compania Naviera Hidalgo, S.A.*, 353 U.S. 138, 147, 77 S.Ct. 699, 1 L.Ed.2d 709 (1957). The “affirmative intention” of the Congress is affirmatively at odds with the result reached here. I respectfully dissent.

Parallel Citations

69 Fed.R.Serv.3d 1147, 85 U.S.P.Q.2d 1385

Footnotes

- 1 Although the owner of a mark may *apply* for registration based on his intent to use the mark in the future, the mark is not registrable until it has actually been used in commerce and the applicant has filed a statement verifying such use. See 15 U.S.C.A. §§ 1051(b), (d). This requirement reflects the fundamental principle in American trademark law that ownership rights flow from actual use of the mark in commerce. See *Emergency One, Inc. v. American Fire Eagle Engine Co.*, 332 F.3d 264, 267 (4th Cir.2003).
- 2 We note that the discovery period had expired by the time VEL requested Rosenruist appear for a Rule 30(b)(6) deposition. In opposition proceedings before the TTAB, discovery depositions and testimonial depositions for presentation at trial are treated very differently. Compare 37 C.F.R. § 1.120 (2006) with 37 C.F.R. § 1.123 (2006); see generally *Fischer Gesellschaft M.B.H. v. Molnar & Co.*, 203 U.S.P.Q. 861 (T.T.A.B.1979). A deposition taken pursuant to Rule 30(b)(6) strikes us as a discovery tool, given its general purpose of permitting the examining party to discover the corporation’s position via a witness designated by the corporation to testify on its behalf. Nevertheless, we are not faced today with the issue of whether the PTO’s rules allow a Rule 30(b)(6) deposition to be taken during the testimony periods set by the TTAB. The magistrate judge below concluded that Rosenruist did not contest VEL’s right to seek the Rule 30(b)(6) testimony, and Rosenruist has not challenged that conclusion on appeal. Thus, we assume for purposes of this appeal that the Rule 30(b)(6) deposition sought by VEL is a testimonial deposition like any other under the PTO’s procedures.
- 3 Meanwhile, Rosenruist, through counsel, attended and participated fully in the testimonial depositions of various VEL officers.
- 4 An *inter partes* proceeding before the TTAB is an adversarial action between parties regarding the registrability of a proposed trademark. An *inter partes* proceeding can take the form of an opposition proceeding, see 15 U.S.C.A. § 1063 (West 1997 & Supp.2007); a cancellation proceeding, see 15 U.S.C.A. § 1064 (West 1997 & Supp.2007); an interference proceeding, see 15 U.S.C.A. § 1066 (West Supp.2007); or a concurrent use proceeding, see 37 C.F.R. § 2.42 (2006).
- 5 Were the issue before us, however, we would conclude that Rosenruist’s activities in this case were sufficient to qualify it as “being within [the] district.”
- 6 The regulations relied upon in the dissenting opinion pertain to *discovery* depositions, see 37 C.F.R. §§ 2.120(b), (c), as opposed to the testimonial depositions at issue here. As such, these regulations do not support the premise that our decision permits VEL to use § 24 as a means of circumventing the PTO’s procedures. Likewise, 37 C.F.R. § 2.123(a)(2) is of no use in this case because it applies only when a party seeks to take a testimonial deposition *in a foreign country*; VEL, of course, does not desire to do so.
- 1 Section 24’s limitation to witnesses “residing or being” in a district is virtually unique and has not been the subject of prior judicial construction. Only three provisions of the U.S.Code, including this one, contain the “residing or being” phrase. See 7 U.S.C. § 2354(a) (2000) (subpoena power for contested cases in Plant Variety Protection Office); 50

U.S.C. § 207 (2000) (Civil War-era statute concerning “commercial intercourse by and between persons residing or being within districts within the lines of national military occupation in the States ...”).

- 2 Signatory nations retain the right to refuse applications filed through this mechanism, and United States law provides for the filing of oppositions such as VEL's to applications submitted in this manner. See 15 U.S.C. § 1141h(a)(2); see also J. Thomas McCarthy, 3 *McCarthy on Trademarks and Unfair Competition* § 19:31.50 (4th ed.2007).
- 3 PTO proceedings have a discovery phase, in which discovery depositions are permitted, and a trial phase, in which testimony depositions are permitted, subject to somewhat more restrictive evidentiary and other limitations. See TTAB Manual § 404.09 (setting forth the “most significant” differences between discovery and testimony depositions, including, for example, that the content of testimony depositions is limited to evidence admissible under applicable rules of evidence; that every testimony deposition must be filed and when filed, becomes part of the record; and that testimony depositions, if not obtained voluntarily, may be taken only pursuant to a subpoena issued by a United States district court); Gary D. Krugman, *Tips From the TTAB: Testimony Depositions*, 70 Trademark Rep. 353 (1980).
- 4 Although my colleagues in the majority are correct that the provisions contained in 37 C.F.R. § 2.120 pertain to discovery depositions, see *ante* at 448 n. 6, they are incorrect that such provisions are unrelated to the PTO's procedures for conducting testimony depositions. While differences between testimony and discovery depositions in fact exist, none of the differences pertain to the question of whether a foreign party may be compelled to provide in-person oral testimony in the United States. See *supra* at 32 n. 3 (citing TTAB § 404.09 “Discovery Depositions Compared to Testimony Depositions”). In fact, the TTAB manual—in setting forth the requirement that testimony depositions, unless “obtained voluntarily,” can only be taken pursuant to a subpoena issued by a United States district court—directly references 37 C.F.R. § 2.120(b), which is instructive on the issue of securing the attendance of a natural person for a deposition in the United States. See TTAB Manual § 404.09 & n. 114. Moreover, the explicit references in 37 C.F.R. § 2.120 to discovery depositions do not dilute the fact that the PTO took seriously Congress's limitation in 35 U.S.C. § 24 that oral depositions can be taken only from witnesses that “live or reside” in the United States.