

ESTTA Tracking number: **ESTTA679637**

Filing date: **06/23/2015**

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

Proceeding	91213597
Party	Plaintiff Caterpillar, Inc.
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Date	06/23/2015
Attachments	2015.06.23 Opposition to Applicant's Motion to Quash 30b6.pdf(16248 bytes)

**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. 85/814,584 Mark: TIGERCAT Application date: January 3, 2013</p>
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**OPPOSER CATERPILLAR INC.'S RESPONSE TO
APPLICANT'S MOTION TO QUASH NOTICE OF 30(b)(6)
DEPOSITION, AND REQUEST TO DENY MOTION AS MOOT**

Caterpillar is well aware of the Board's rules providing that depositions of foreign parties must be on written questions, unless the parties stipulate otherwise. Indeed, it was in recognition of those rules—and in the interest of efficiently conducting this proceeding by avoiding the issuance of subpoenas—that Caterpillar sought Applicant's consent when sending the notice of 30(b)(6) deposition that Applicant now seeks to quash. Caterpillar believed seeking such consent was reasonable under the circumstances of this case for a number of reasons, including the fact that Applicant is located only an hour drive from the U.S. border, Applicant does substantial business in the United States, and Applicant's officers regularly travel to the United States for business.

Unfortunately, Applicant did not consent and has instead chosen to use the Board's rules regarding the deposition of foreign parties as a shield—while at the same time noticing the oral 30(b)(6) deposition of Caterpillar and the oral depositions of two other Caterpillar witnesses, and most recently even requesting leave from the Board to take those depositions by videoconference. As Caterpillar would have obviously been disadvantaged by having its

witnesses subject to oral deposition while Applicant's witnesses provided deposition testimony through written questions, Caterpillar was left with no choice but to pursue an oral deposition through the issuance of a subpoena. Accordingly, on June 19, 2015, Caterpillar served Applicant's President with subpoenas while he was attending a trade show in Arkansas. Pursuing the deposition of Applicant and Applicant's officer in this manner was proper. *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372, 374 (TTAB 1978) ("There is nothing in the rules to preclude the taking of an oral deposition of a person designated therefor if said person is physically in the United States."); *Rosenruist-Gestao E Servicos LDA v. Virgin Enters., Ltd.*, 85 USPQ.2d 1385, 1390 (4th Cir. 2007) ("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.").

Applicant openly acknowledges that it was aware Caterpillar would be proceeding in this manner. In the third paragraph of its motion, Applicant quotes a June 1, 2015 letter from Caterpillar responding to Applicant's refusal to consent to an oral deposition in which Caterpillar stated it "will be seeking the in-person deposition of Tigercat's witnesses through other means." In view of this acknowledgment, Applicant's motion to quash (which is accompanied by no less than three declarations and numerous exhibits) is bewildering, to say the least. The parties' communications could not have been any clearer that the May 11, 2015 deposition notice was premised upon Applicant's consent and that, absent such consent, Caterpillar would not be moving forward with that deposition. Without so much as informing Caterpillar of its intent to file a motion to quash, Applicant now wastes the Board's time with a motion that could have been easily avoided.

In any event, to the extent there was any ambiguity in the parties' earlier communications on this issue, Caterpillar hereby withdraws its 30(b)(6) Notice of Deposition to Applicant dated May 11, 2015. In view of that withdrawal, Applicant's motion should be denied as moot.

Dated: June 23, 2015

Respectfully submitted,

/Christopher P. Foley/
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CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing OPPOSER CATERPILLAR INC.'S RESPONSE TO APPLICANT'S MOTION TO QUASH NOTICE OF 30(b)(6) DEPOSITION, AND REQUEST TO DENY MOTION AS MOOT was served via electronic mail on June 23, 2015 upon counsel for Applicant:

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