

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
General Contact Number: 571-272-8500

EJW

Mailed: December 8, 2015

Opposition No. 91216077

*RevenueWire, Inc.*

*v.*

*Future Payment Technologies, L.P.*

**ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:**

**Motion to Quash**

On December 4, 2015, the parties, RevenueWire, Inc. (represented by Michelle Katz of Advitam IP LLC) and Future Payment Technologies, L.P. (represented by Peter Loh of Gardere Wynne Sewell LLP), and Elizabeth Winter, the assigned Interlocutory Attorney, participated in an impromptu<sup>1</sup> telephone conference regarding Applicant's motion (filed December 3, 2015) to quash noticed depositions or, in the alternative, for a protective order with regard thereto. *See* Trademark Rules 2.120(i)(1) and 2.127(c), 37 C.F.R. §§ 2.120(i)(1) and 2.127(c); and Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 502.06 (2015). This order summarizes the conference and the Board's ruling in regard to the subject motion.

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<sup>1</sup> The telephone conference on the motion was requested on December 3, 2015, by Applicant's counsel and, in view of the imminent schedule for the depositions, the Board contacted Opposer's counsel, who made herself available immediately for the conference. The Board appreciates counsel's cooperation.

By way of background, on October 2, 2015, the Board suspended this proceeding pending the parties' settlement negotiations until October 30, 2015, and reset the discovery period to close on November 29, 2015. On November 23, 2015, Opposer served on Applicant three notices for depositions that would be conducted on December 7, 2015, December 8, 2015, and on December 9, 2015, respectively. In its motion, Applicant argues, *inter alia*, that the notices of deposition are untimely, were served without reasonable notice, and designate an improper location for conducting the depositions. Applicant requests an order quashing the notices of deposition or, in the alternative, for a protective order directing Opposer to confer with Applicant's counsel regarding a mutually agreeable time and location for the requested depositions of Applicant and Mr. Dierks, and forbidding the deposition of Jason Fulmer, Applicant's counsel.

In response, Opposer said that it was amenable to changing the dates for the noticed depositions and that it still needed discovery responses from Applicant in order to conduct the depositions.

The Board advised the parties that, pursuant to Trademark Rule 2.120(a)(3), 37 C.F.R. § 2.120(a)(3), discovery depositions must be taken on or before the closing date of the discovery period as originally set or as reset. Therefore, because the discovery period closed on November 29, 2015, prior to the dates noticed for the depositions, the Board was obligated to grant Applicant's motion to quash on the basis that the notices were untimely. *See National Football League v. DNH Management LLC*, 85 USPQ2d 1852 (TTAB 2008) (motion to quash granted on

deposition noticed during discovery but scheduled after close of discovery); *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372, 373 (TTAB 1978) (motion to quash granted where party noticed deposition for a date after the discovery period expired). Accordingly, Applicant's motion to quash was **granted** on the basis that the notices were untimely.

Additionally, to be complete, the Board notes that the depositions were noticed to occur at the offices of Opposer's counsel in Chicago, Illinois. With respect to the noticed depositions of Chris Dierks and Jason Fulmer, the location of the depositions was improper. The deposition of a natural person under Fed. R. Civ. P. 30(b)(1) 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. Trademark Rule 2.120(b), 37 C.F.R. § 2.120(b). Insofar as the parties did not agree to conduct the deposition of Mr. Dierks or Mr. Fulmer at the office of Opposer's counsel and they do not reside in Chicago, Illinois, the noticed location was improper. Additionally, the deposition of a corporation through its agents or officers is normally taken at the corporation's principal place of business. *See, e.g., Thomas v. Int'l. Business Machs.*, 48 F.3d 478, 483 (10th Cir. 1995); *Martin v. Allstate Ins. Co.*, 292 F.R.D. 361 (N.D. Tex. 2013) (citing *Resolution Trust Corp. v. Worldwide Ins. Mgmt. Corp.*, 147 F.R.D. 125, 127 (N.D. Tex. 1992)); 8A Fed. Prac. & Proc. Civ. § 2112 (3d ed. 2015). Therefore, the location of the noticed depositions was also improper. Accordingly, the motion to quash is also **granted** for that reason.

As discussed, Opposer is allowed to file a motion to reopen the discovery period and to seek to schedule depositions during a re-opened discovery period. Should Opposer succeed in doing so, Opposer is **ORDERED** to consult with Applicant's counsel first to arrange for a mutually convenient time and place to conduct depositions, and to give reasonable notice of said depositions. *See* TBMP §§ 404.05 and 408 (duty to cooperate).

In view of the foregoing order, the Board does not need to address the alternative motion for protective order.<sup>2</sup>

### **Proceeding Suspended**

It is noted that Opposer filed a motion for summary judgment on December 7, 2015. In view thereof, proceedings herein are **SUSPENDED** pending disposition of Opposer's motion. Any paper filed during the pendency of this motion which is not relevant thereto will be given no consideration. However, Applicant is allowed to file its reply brief in connection with its motion to suspend for a civil action filed on November 30, 2015. *See* Trademark Rule 2.127(d).

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<sup>2</sup> The Board hastens to note, however, that depositions of opposing counsel are generally disfavored in federal courts. *See Hickman v. Taylor*, 329 U.S. 495, 513 (1947); *Theriot v. Parish of Jefferson*, 185 F.3d 477, 491 (5th Cir. 1999) (*cert denied*, 529 U.S. 1129 (2000)); *Shelton v. Am. Motors Corp.*, 805 F.2d 1323, 1327 (8th Cir.1986); *Jennings v. Family Mgmt.*, 201 F.R.D. 272, 276–77 (D.D.C.2001). Additionally, the deposition of a non-party witness residing in the United States may be taken by subpoena under Fed. R. Civ. P. 45 or, or on notice alone, if the non-party witness agrees to appear voluntarily. *See* TBMP § 404.03(a)(2) (2015). *See also Ate My Heart v. GA GA Jeans*, 111 USPQ2d 1564, 1565 n.5 (TTAB 2014) (notice of deposition of unwilling non-party witness must include subpoena, and related motions must be filed with district court that issued subpoena, not Board).