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

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|------------------------|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Proceeding | 91218001 |
| Party | Plaintiff Tod's S.p.A. |
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| Attachments | Opposition to Motion to Compel Deposition - Memo of Law.pdf(1612674 bytes) Sincini Decl in Support of Opposition.pdf(70237 bytes) Mandel Decl in Support of Opposition.pdf(2410879 bytes) |

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

In re Application Serial No. 86/004,044
Filed: July 8, 2013
For Mark: TOMS
Published in the Official Gazette: April 29, 2014

In re Registration Nos. 4,097,948; 4,192,925; 4,313,981; 4,410,344
Registered: February 14, 2012; August 21, 2012; April 2, 2013; October 1, 2013
For Mark: TOMS

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| ----- | X | |
| TOD'S S.P.A., | : | |
| | : | |
| Opposer, | : | |
| v. | : | Opposition No. 91218001 |
| MYCOSKIE, LLC, | : | |
| | : | |
| Applicant. | : | |
| ----- | | |

| | | |
|----------------|---|---------------------------|
| TOD'S S.P.A., | : | |
| | : | |
| Petitioner, | : | |
| v. | : | |
| MYCOSKIE, LLC, | : | Cancellation No. 92061234 |
| | : | |
| Respondent. | : | |

----- X

**OPPOSER/PETITIONER'S OPPOSITION TO
APPLICANT/RESPONDENT'S CROSS-MOTION TO
COMPEL THE ORAL DEPOSITION OF STEFANO SINCINI**

PRELIMINARY STATEMENT

Mycoskie's cross-motion to compel an oral deposition of Stefano Sincini is legally deficient and should be denied. First and most fundamentally, Mycoskie has failed to comply with the requirement that it make a good faith effort to resolve the dispute before bringing a motion to compel. Mycoskie made a unilateral demand in mid-December 2015 that Tod's produce Mr. Sincini, a resident of Italy with no scheduled plans to be in the United States, for a deposition to take place in New York within the next thirty days. When Tod's explained that Mr. Sincini would not be traveling to the United States during that time frame, and that in any event the rules only provided for depositions on written question in the case of foreign residents such as Mr. Sincini, Mycoskie filed its motion without further discussion.

As part of that motion, Mycoskie now offers solutions that it never proposed to Tod's at any time during the meet and confer process, such as scheduling a deposition to coincide with Mr. Sincini's future travel plans to the United States or taking the deposition in Italy while paying the travel and accommodation costs of Tod's' counsel. The Board's precedents make plain that a good faith effort to resolve a discovery dispute means just that – a party must “lay its cards on the table” and provide the same level of “candor and specificity” in negotiations that it later reveals in its briefing on the motion. Only through such efforts can there be the kind of “frank exchange” indicative of a real effort to investigate possible resolutions of the dispute. By depriving Tod's of the opportunity to consider proposals that Mycoskie now offers to the Board, Mycoskie turned the meet and confer process into a sham and rendered the requirement of good faith negotiation meaningless. On that basis alone, its motion to compel should be denied.

Mycoskie's motion is also substantively without merit. In an obvious effort to distract from the lack of any legal basis for the relief it seeks, Mycoskie focuses extensively on the fact

that Tod's first disclosed Mr. Sincini as an individual with relevant knowledge in supplemental initial disclosures served as the close of fact discovery approached. Mycoskie conveniently ignores the fact that it was already well aware of Mr. Sincini's role in the case through an interrogatory response identifying him three months earlier as the person who decided to file this opposition, as well as his identification on multiple occasions as the person with overall responsibility for trademarks during the deposition of another Tod's witness held two months earlier. The Federal Rules, as well as the Advisory Notes to such rules, are explicit in providing that a party need not supplement its initial disclosures if the relevant individual has otherwise been made known to the other side during the discovery process, such as by identification during the taking of a deposition. While Tod's erred on the side of caution by identifying Mr. Sincini as well as another Tod's witness in Italy whom Mycoskie had already elected not to depose on written questions, there can be no doubt that Mycoskie was fully aware of both these individuals long before Tod's' service of its supplemental initial disclosures.

More importantly, Mycoskie suffered no prejudice from any delay in the disclosure because Tod's readily agreed to extend the discovery period and provide Mycoskie with exactly what the rules provide – a deposition on written questions of Mr. Sincini. In this respect, the question of whether Mr. Sincini should have been disclosed earlier is beside the point. Whether Tod's disclosed him from the outset or not, the fact remains that he is and was at all relevant times a resident of Italy, and he has not traveled to the United States at any time period during the pendency of this proceeding. Indeed, he has only been to the United States on three occasions during the last five years, each for a period of a week or less. Under these circumstances, Mycoskie's contention that he is "regularly employed" in New York is not even colorable, and its insistence that Tod's produce him there for a deposition lacks any legal basis.

Nor has Mycoskie made the requisite showing as to why an oral deposition in Italy is required instead of the deposition on written questions provided for under the rules. Were it as simple as saying that an oral deposition is more effective, then every foreign witness would be required to submit to an oral deposition. Such is clearly not the rule under the Board's precedents, which require a particularized showing of specific need that Mycoskie cannot make.

STATEMENT OF FACTS

The facts on which Tod's relies in its opposition to Mycoskie's cross-motion to compel the oral deposition of Stefano Sincini are set forth in detail in the accompanying declarations of Stefano Sincini ("Sincini Decl.") and Richard S. Mandel ("Mandel Decl."), and are summarized below for the Board's convenience.

On July 2, 2015, Mycoskie served a 30(b)(6) deposition notice seeking to take the deposition of Tod's in New York. Mandel Decl. ¶ 2 & Ex. A. The deposition notice contained 29 different topics, including many relating to issues concerning Tod's' management and enforcement of its trademarks. Id.

After Tod's indicated that any 30(b)(6) deposition of the company would have to be conducted by written questions because Tod's was an Italian company, Mycoskie requested that Tod's consider whether any Tod's witnesses located in the United States would be appropriate corporate representative witnesses for any of the topics listed in Mycoskie's notice. Id. ¶¶ 3-4 & Ex. B. In response, Tod's identified Claudio Castiglioni, a Tod's employee with a dual residency in Italy and Florida, as a 30(b)(6) witness for 15 of the 29 topics in Mycoskie's notice. Id. ¶ 5 & Ex. D. Tod's advised Mycoskie that the 30(b)(6) witness for the remaining topics (dealing generally with Tod's' trademarks and its enforcement efforts) would need to be an

individual from Italy (later identified as Andrea Varsavia, a lawyer for Tod's). Id. ¶¶ 5-7 & Ex. E.

On September 11, 2015, Tod's responded to Mycoskie's second set of interrogatories. In those responses, Tod's identified Stefano Sincini, Tod's co-CEO, Executive Director and General Manager, as the sole person responsible for the decision to file the Notice of Opposition against Mycoskie. Id. ¶ 6 & Ederer Decl. Ex. 3. Tod's also identified Andrea Varsavia in numerous other responses as a witness with knowledge regarding various trademark related matters. Id.

On October 9, 2015, Mycoskie took the deposition in New York of Claudio Castiglioni in both his individual capacity and as a designated 30(b)(6) witness for Tod's with respect to the previously identified 15 topics. Id. ¶ 8. There was extensive testimony during Mr. Castiglioni's deposition about Mr. Sincini and his involvement with respect to trademark matters. Id. Indeed, an index of the transcript shows that Mr. Sincini's name appears on no fewer than 35 separate pages of the transcript. Id. & Ex. F. Some of the exchanges clearly showing Mr. Sincini's role with respect to trademark decisions are reproduced below:

- Q. Was there another counsel prior to Mr. Varsavia who was in Italy and who was in Italy and who was responsible for monitoring trademarks?
- A. You know, it's not a field that I'm in charge with. Dr. Sincini is the person that is related to all this trademark. So probably there is one but he was not somebody that deal directly with me.
- Q. Did you say Dr. Sincini?
- A. Stefano Sincini.
- Q. So Mr. Sincini has overall responsibility for the trademark area?
- A. Exactly.

* * *

Q. Do you know why Mr. Sincini approved the Notice of Opposition but Mr. Varsavia approved the Petition for Cancellation?

A. It's not something that I do it. It is Dr. Sincini that decides.

Q. Did Dr. Sincini tell you that it was Mr. Varsavia who approved the Petition for Cancellation?

A. No. But that I speak with Dr. Sincini is my boss and I understand what's happening, you know, it's one story. But that he appointed people in the company, it's up to him that is his field to decide who he has to talk to.

* * *

Q. Do you recall a conversation with Dr. Sincini where one of you said we have to monitor TOMS?

A. He told me.

Q. He said we have to monitor TOMS?

A. He point to the brand TOMS and say, you know, what is your feeling about this brand. We need to monitor.

Q. And how did you respond to him?

A. Well, I don't recall exactly the words but, you know, since the name is so close I probably, you know, say you're right.

Q. Well, were you concerned at the time?

A. But it's happen that this conversation take place to have feedback about somebody but he's in charge of that so he's the one to take care.

* * *

Q. So what happened between July 2011 and July – and August 2014? With respect to your company's monitoring of the TOMS brand?

A. Because as I mention to you, Dr. Sincini is in charge of that so I don't know what he did.

* * *

Q. Did you ever go back to Dr. Sincini after July of 2011 and say, you

know, TOMS is – we have to do something about TOMS in the United States?

A. No.

Q. Or what’s going on with TOMS in the United States?

A. No.

Q. Any reason why not?

A. Not really.

Q. It was his area?

A. Probably.

* * *

Q. And as the brand manager of the company, did anybody come to you and say what types of goods should we be challenging TOMS registrations for?

A. I think it was decided with Dr. Sincini.

* * *

Q. Okay. So to your understanding is that one of the reasons why your company has not challenged the TOMS registration for footwear in the United States?

A. That’s something that Dr. Sincini decided.

* * *

Q. Do you know why it took you six months to file the Petition for Cancellation after you received the answer to the Notice of Opposition?

A. As I mentioned to you, Dr. Sincini is taking care of this, not us.

* * *

Q. Do you know why your company has not challenged any of TOMS design mark applications or registrations in the United States?

A. No, I don't.

Q. Is that something that's Dr. Sincini's area?

A. Yes.

* * *

Q. Do you know any reason why a registration for the wordmark Tod's was not included in this chart?

A. I'm not trying to avoid your question, but this is part of Dr. Sincini.

* * *

Q. Having seen all of these documents does that refresh your recollection as to any prior trademark opposition that your company filed in the United States other than the one we are here about today?

A. I know that the company is very active to keeping up the brand protected, but I believe they are all things that Dr. Sincini is involved with.

Mandel Decl. Ex. F (pp. 35, 44, 50-52, 56-57, 87, 89, 96, 98-99, 102-103, 108) (objections omitted).

Subsequent to the completion of Mr. Castiglioni's October 9, 2015 deposition, Mycoskie decided not to pursue a 30(b)(6) deposition by written questions of Tod's with respect to the remaining trademark deposition topics that were not part of Mr. Castiglioni's designations. Id. ¶ 9. Although the above passages of deposition testimony leave no doubt that Mycoskie was fully aware that Mr. Sincini had relevant knowledge concerning Tod's' trademark activities, and both Mr. Sincini and Mr. Varsavia had also been identified in interrogatory responses as well, Tod's erred on the side of caution by serving supplemental initial disclosures (Ederer Decl. Ex. 28) on December 10, 2015 identifying both Mr. Sincini and Mr. Varsavia as additional individuals with relevant knowledge. Mandel Decl. ¶ 10.

On December 14, 2015, Mycoskie served a notice of deposition purporting to require Mr. Sincini's appearance in New York for a deposition on January 13, 2016, while also demanding that Mr. Sincini be produced in New York for a deposition within the next thirty days. Id. ¶ 11 & Ex. G; Ederer Decl. Ex. 28. Mr. Sincini is a resident of Italy. Sincini Decl. ¶ 2. He is not regularly employed in New York or anywhere else in the United States, and has not even visited the United States since October 2013. Id. ¶ 3. During the past five year period, Mr. Sincini has only been to the United States three times: August 6-12, 2011 (the first three of those days in New York); November 7-10, 2012 (all in New York) and October 26-31, 2013 (the first four of those days in New York). Id. ¶ 4. Although he is the Chairman of the Board of Directors of Tod's New York based affiliate, Deva Inc., his duties do not require his regular presence in New York, and he has not personally attended a Board meeting of Deva in New York since 2011. Id. ¶ 5.

Nevertheless, Mycoskie insisted in the only pre-motion communications preceding the filing of this motion to compel (Ederer Decl. Exs. 28, 29, 31) that Tod's produce Mr. Sincini for an oral deposition in New York. Mandel Decl. ¶ 13. Although Tod's offered to extend the discovery period to allow Mycoskie to take a deposition on written questions of Mr. Sincini, as provided for by the rules, Mycoskie refused to proceed in that fashion. Id. ¶ 12. At no time during the meet and confer process leading to this motion did Mycoskie ever suggest the possibility of taking Mr. Sincini's deposition to coincide with any scheduled travel to the United States or taking his oral deposition in Italy at Mycoskie's expense. Id. ¶ 13.

ARGUMENT

I. **Mycoskie’s Motion Should Be Denied Because It Failed To Make A Good Faith Effort To Resolve The Issues Raised In Its Cross-Motion**

Trademark Rule 2.120(e)(1) requires that a party moving to compel discovery show that it “has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion but the parties were unable to resolve their differences.” 37 C.F.R. § 2.120(e)(1). See also Hot Tamale Mama...and More, LLC v. SF Investments, Inc., 110 U.S.P.Q.2d 1080, 1081 (T.T.A.B. 2014). A Board finding of a lack of good faith effort is sufficient standing alone to justify denial of the discovery motion. Emilio Pucci Int’l BV v. Sachdev, Opp. No. 91215100 (Docket No.18)¹ at 7 (T.T.A.B. Jan. 20, 2016) (precedential ruling).

As the Board has explained, “[t]he purpose of the conference requirement is to promote a frank exchange between counsel to resolve issues by agreement or to at least narrow and focus the matters in controversy before judicial resolution is sought.” Amazon Techs., Inc. v. Wax, 93 U.S.P.Q.2d 1702, 1705 (T.T.A.B. 2009) (emphasis in original). Toward that end, it is essential that the parties present their positions “with the same candor, specificity, and support during informal negotiations as during the briefing of discovery motions.” Id. “The meet and confer process cannot be truly complete until after all the cards have been laid on the table,” id. (citations omitted), and the parties have gone through a process of “actually investigating ways in which to resolve the dispute.” Hot Tamale Mama, 110 U.S.P.Q.2d at 1081 (“Where it is apparent that the effort toward resolution is incomplete, establishing the good faith effort that is a prerequisite for a motion to compel necessitates that the inquiring party engage in additional effort toward ascertaining and resolving the substance of the dispute”).

¹<http://ttabvue.uspto.gov/ttabvue/v?pno=91215100&pty=OPP&eno=18>

While Mycoskie includes a pro forma statement that it has made a good faith effort to resolve the dispute raised by its motion to compel (Mycoskie Cross-Motion at 28), a review of the email exchanges annexed to the motion, as well as the relief sought in Mycoskie's cross-motion, makes plain that this is not the case. On December 14, 2015, Mycoskie served a notice of deposition purporting to require Stefano Sincini, a resident of Italy who has not even been to the United States since 2013, to appear for a deposition in New York on January 14, 2016. Mandel Decl. ¶ 11 & Ex. G. The email transmitting the deposition notice likewise demanded that he appear for a deposition in New York within the next thirty days. Ederer Decl. Ex. 28. Tod's responded by indicating that Mr. Sincini had no plans to be in the United States within the next thirty days, and noted that the rules clearly only provided for a deposition on written questions inasmuch as Mr. Sincini was a resident of Italy. Ederer Decl. Ex. 29. Tod's offered to extend the discovery period to permit Mycoskie an opportunity to take such a deposition on written questions if it so desired (*id.*), but Mycoskie rejected that proposal and simply reiterated its demand that Mr. Sincini be produced for an oral deposition in New York. Ederer Decl. Ex. 31.

In its motion, Mycoskie now has apparently decided that it can take the deposition at the time of Mr. Sincini's next scheduled trip to the United States (Mycoskie Cross-Motion at 26 n. 26), or is even willing to schedule the deposition in Italy while paying the travel and accommodation costs required for Tod's' counsel to attend. *Id.* at 27 n. 29. Notably, neither of those options was ever presented before Mycoskie filed its motion to compel. Mandel Decl. ¶ 13. In this respect, Mycoskie failed to lay "all the cards ... on the table" and certainly did not provide the "same candor [and] specificity" during the pre-motion negotiations as it has now set out during the briefing of its motion to compel. See Amazon, 93 U.S.P.Q.2d at 1705. Had

Mycoskie actually attempted to resolve the dispute by offering these options to Tod's, the parties could have had the kind of "frank exchange between counsel" that actually serves Rule 2.120(e)'s intended purpose "to investigate the possibility of resolving the dispute." Id.; Hot Tamale Mama, 110 U.S.P.Q.2d at 1081. By insisting on an immediate deposition in New York that Mycoskie knew full well it had no legal right to obtain, and not raising other options that it planned to present in its motion, Mycoskie failed to make a good faith effort to resolve the parties' discovery dispute. For this reason alone, its motion to compel should be denied. Emilio Pucci, Opp. No. 91215100 (Docket No.18) at 7.

II. Mycoskie Is Not Entitled to an Oral Deposition of Stefano Sincini

Mycoskie's papers repeatedly emphasize the fact that Mr. Sincini was disclosed in supplemental initial disclosures served by Tod's near the end of the fact discovery period. While Mycoskie seeks to impute bad faith into such disclosure, the reality is that Tod's was not even required under the rules to make such disclosure at all inasmuch as Mycoskie had already been fully aware for months of Mr. Sincini's knowledge through other discovery in the case. In any event, the timing of the disclosure is completely irrelevant to the issues raised by Mycoskie's cross-motion. Tod's agreed to extend the discovery period for the purpose of permitting Mycoskie to conduct exactly what the rules provide for witnesses such as Mr. Sincini who reside outside the United States – a deposition on written questions. The problem is that Mycoskie insists on a tortured reading of the rules that would somehow transform Mr. Sincini – who has been in New York for less than a dozen days over the past five years – into someone who is "regularly employed" in New York. Because there is no basis for Mycoskie's position, and it has not showed good cause as to why a deposition on written questions will not suffice, its motion to compel an oral deposition of Mr. Sincini should be denied.

A. Tod's Went Beyond What the Rules Require by Serving Supplemental Initial Disclosures Identifying Stefano Sincini

Rule 26(a)(1)(A)(i) of the Federal Rules of Civil Procedure requires parties to provide initial disclosures identifying “each individual likely to have discoverable information – along with the subjects of that information – that the disclosing party may use to support its claims or defenses” Fed. R. Civ. P. 26(a)(1)(A)(i). Rule 26(e)(1)(A) requires parties to supplement their initial disclosures “if the party learns that in some material respect the disclosure or response is incomplete or incorrect, and if the additional corrective information has not otherwise been known to the other parties during the discovery process or in writing.” Fed. R. Civ. P. 26(e)(1)(A) (emphasis added). The 1993 Advisory Committee Notes to Rule 26(e) explain that there is “no obligation to provide supplemental or corrective information that has been otherwise made known to the parties in writing or during the discovery process, as when a witness not previously disclosed is identified during the taking of a deposition” (emphasis added). As the Board explained in Galaxy Metal Gear, Inc. v. Direct Access Technology, Inc., 91 U.S.P.Q.2d 1859 (T.T.A.B. 2009), “there is no need, as a matter of course, to submit a supplemental disclosure to include information already revealed by a witness in a deposition or otherwise through formal discovery, including the identity of the witness.” Id. at 1861.

In the present case, the identity and role of Mr. Sincini was clearly made known to Mycoskie during the discovery process long before the service of Tod's' December 2015 supplemental disclosures. First, in response to an interrogatory asking for the identity of the “person(s) who decided to file and/or approved the filing of the Notice of Opposition,” Tod's identified Mr. Sincini in September 2015 as the sole individual responsible for such decision. Ederer Decl. Ex. 3 (response 15). A month later, on October 9, 2015, Mycoskie took the deposition of Claudio Castiglioni, a Tod's employee with dual residence in the United States and

Italy. Mandel Decl. ¶ 8. As the index to Mr. Castiglioni's deposition reveals, Mr. Sincini's name appears on thirty five separate pages of the transcript. Mandel Decl. ¶ 8 & Ex. F. Nor were these passing references that failed to apprise Mycoskie of the scope of Mr. Sincini's knowledge. To the contrary, as the various passages quoted in the statement of facts above reveal, Mr. Castiglioni's testimony made abundantly clear that Mr. Sincini was the person with overall responsibility for the trademark area, including enforcement decisions relating to Mycoskie's TOMS mark. See pp. 4-7 supra.

In addition, Mycoskie had previously been advised that decisions concerning trademarks were made out of Italy and that if Mycoskie wanted a 30(b)(6) witness concerning those topics, it would have to take the deposition by written questions. Mandel Decl. ¶ 5 & Ex. D. Tod's designated Andrea Varsavia, the in-house lawyer in Italy who works with Mr. Sincini on trademark issues and who had also been identified in numerous interrogatory responses, as the 30(b)(6) witness for the fourteen topics in Mycoskie's 30(b)(6) notice of Tod's concerning this area. Id. ¶ 7 & Ex. E. Following the completion of Mr. Castiglioni's deposition, Mycoskie elected not to pursue the 30(b)(6) deposition. Id. ¶ 9.

As the above sequence of events makes clear, the identification of both Mr. Sincini and Mr. Varsavia in Tod's December 2015 supplemental initial disclosures could not possibly have come as any surprise to Mycoskie. While Mycoskie insists that it did not previously understand these individuals (or at least Mr. Sincini) might be trial witnesses, parties do not identify their specific trial witnesses through initial disclosures, but through pretrial disclosures (which Tod's has not yet even made). See Spier Wines (PTY) Ltd. v. Shepher, 105 U.S.P.Q.2d 1239, 1241-42 (T.T.A.B. 2012). Tod's would have been justified in waiting to list both Mr. Sincini and Mr. Varsavia as trial witnesses in its pretrial disclosures, but followed the "better practice" of first

supplementing its initial disclosures so as to avoid any possible misunderstanding or later issues. See, e.g., Galaxy Metal Gear, 91 U.S.P.Q.2d at 1861 (denying motion to preclude use of witness at trial where not identified in initial disclosures, while noting “better practice would have been for opposer to have supplemented its initial disclosures”). Tod’s also cured any possible element of surprise by offering to extend the discovery period and permitting Mycoskie the same deposition upon written questions that it had previously rejected with respect to Mr. Varsavia. Thus, it is not the timing of Tod’s’ supplemental disclosures which has led to the present motion, but rather Mycoskie’s insistence on trying to parlay that disclosure into a basis for an oral deposition not provided for in the rules.

All of the cases cited by Mycoskie in its papers are readily distinguishable from the present case. In each of those cases, the party never supplemented its initial disclosures to list the relevant witness whose testimony it sought to take at trial, while Tod’s has supplemented its initial disclosures in this case. Indeed, in one of the cases on which Mycoskie relies, the party not only failed to identify the witness in its initial disclosures, but also neglected to identify the witness in its pretrial disclosures as well. See Jules Jurgensen/Rhapsody, Inc. v. Baumberger, 91 U.S.P.Q.2d 1443 (T.T.A.B. 2009). Moreover, in several of the cases cited by Mycoskie, even though no identification of the witness was ever made in initial disclosures, the Board did not preclude the witness from offering testimony. For example, in, Great Seats, Inc. v. Great Seats, Ltd., 100 U.S.P.Q.2d 1323 (T.T.A.B. 2011), the Board permitted a witness identified by opposer for the first time in pretrial disclosures to testify as long as applicant was first permitted to take his deposition.² Id. at 1328. Tod’s has offered that same opportunity to Mycoskie here.

²Similarly, in Byer California v. Clothing for Modern Times Ltd., 95 U.S.P.Q.2d 1175 (T.T.A.B. 2010), the witness who was not identified in initial disclosures was also permitted to testify at trial, as long as he was made available for a discovery deposition. In AmeriCareers

However, unlike in Great Seats, the relevant witness resides outside the United States, and accordingly such deposition must proceed under the rules by written questions. It is that key distinction, and not any failure on Tod's part to provide relevant information, which prevents Mycoskie from the oral deposition on which it insists.

B. The Rules Do Not Permit Mycoskie to Compel the Oral Deposition in the United States of a Foreign Resident

Trademark Rule 2.120(c) provides in unequivocal language that the discovery deposition of a natural person who is an officer of a party and resides in a foreign country shall be taken by means of a deposition upon written questions unless the Board, upon a showing of good cause, orders an oral deposition. 37 C.F.R. § 2.120(c). Consistent with the plain language of this rule, “the Board will not order a natural person residing in a foreign country to come to the United States for the taking of his or her discovery deposition. Under the Board’s practice, discovery depositions of foreign-resident witnesses may be taken only by way of written questions, unless the parties stipulate otherwise or unless the Board, upon motion for good cause shown, orders that the deposition be taken orally in the foreign country.” Jain v. Ramparts, Inc., 49 U.S.P.Q.2d 1429, 1431 (T.T.A.B. 1998). See also TBMP § 404.03(b) (describing deposition rules for “Person Residing in a Foreign Country – Party” as requiring deposition on written questions); TBMP § 404.03(a) (describing deposition rules for “Person Residing in the United States – Party” as allowing for either oral deposition or deposition on written questions).

Ignoring the clear dictates of the rules, as well as the language of the TBMP and the Board’s decision in Jain, Mycoskie claims that Mr. Sincini, a resident of Italy, may be compelled

LLC v. Internet Employment Linkage, Inc., Opp. No. 91198027 (Docket No. 23) (T.T.A.B. Oct. 5, 2011), <http://ttabvue.uspto.gov/ttabvue/v?pno=91198027&pty=OPP&eno=23>, the Board denied a motion to strike the summary judgment declaration of a witness who was not identified in initial disclosures.

to give an oral deposition in New York pursuant to 37 C.F.R. § 2.120(b) because Mycoskie claims he is “regularly employed” there. As an initial matter, under standard rules of statutory construction, the specific statutory language of Rule 2.120(c) detailing the applicable rules for foreign residents controls over the more general language of Rule 2.120(b) describing the ordinary deposition rules. See, e.g., Thiess v. Witt, 100 F.3d 915, 919 (Fed. Cir. 1996) (specific terms in a statute prevail over general terms in same or another statute which might otherwise be controlling). Such an interpretation is borne out by the detailed explanation of the TBMP, which draws a clear dichotomy between the rules applicable to depositions of party witnesses residing in the United States and those residing outside the United States. Compare TBMP § 404.03(a) with TBMP § 404.03(b).

In any event, even assuming that it were theoretically possible for an individual to be both a resident of a foreign country under Rule 2.120(c) and a regular employee within the United States under Rule 2.120(b), Mr. Sincini is surely not such an individual. One could imagine that such a situation might exist, for example, where a resident of Canada works on a daily basis a few miles over the border within the United States. However, Mr. Sincini has not even been physically present in the United States since 2013. Sincini Decl. ¶ 3. During the past five years, he has spent a total of under 12 days in New York during the course of three short visits of less than a week in each of the years 2011, 2012 and 2013. Id. ¶ 4. While Mycoskie emphasizes Mr. Sincini’s status as the Chairman of the Board of Tod’s’ New York based subsidiary, Deva Inc., his duties as Chairman do not require his physical presence in New York. Id. ¶ 5 He has not personally attended a Deva Board meeting in New York since 2011, as meetings since that time have been conducted either by written resolution or teleconference

without his physical presence in New York.³ Id. There is no basis for treating Mr. Sincini as being “regularly employed” in New York under these circumstances.

Not surprisingly, Mycoskie cannot point to a single case that supports its novel interpretation of Rule 2.120(b). In a desperate attempt to invent some basis for dragging Mr. Sincini to New York for a deposition, Mycoskie draws an analogy to the test under Fed. R. Civ. P. 45(c) for subpoenaing a witness who “regularly transacts business” within a state. However, such a rule is not analogous to 37 C.F.R. § 2.120(b) because one can “regularly transact business” in a location without being “regularly employed” there. In any event, even if the analogy were appropriate, the single case of Halliburton Energy Servs. v. M-I, LLC, 2006 U.S. Dist. WL 2663948 (S.D. Tex. Sept. 15, 2006) on which Mycoskie relies involved a witness with a much greater connection to the deposition locale than Mr. Sincini has to New York. In Halliburton, the witness averaged four trips to Houston each year over the past ten years, with each trip lasting approximately ten days. Id. at *1-2.

Numerous other cases have found insufficient contacts under Rule 45(c) for witnesses who were present in the deposition jurisdiction more frequently than Mr. Sincini has been here. See, e.g., Perez v. Progenics Pharms., Inc., 2015 U.S. Dist. LEXIS 83557, at *6 (S.D.N.Y. June 24, 2015) (copy attached in Appendix) (occasional meetings in New York did not open a witness up to being required to testify there); M’Baye v. N.J. Sports Prod., 246 F.R.D. 205, 208 (S.D.N.Y. 2007) (“traveling to an area ... for fourteen to eighteen days in two years is

³The deposition testimony of Mr. Castiglioni cited by Mycoskie is not to the contrary, as he clearly testified to what Deva “used to” do in connection with Board meetings. See Ederer Ex. 21 (25:25-26:11). The examination did not probe as to the relevant time period. And while Ms. Rothfeld recalled Mr. Sincini being present in New York with greater frequency, her off the cuff recollection cannot control over the sworn statement of the individual himself focused on this specific issue. In any event, even the 2-3 visits a year recalled by Ms. Rothfeld would hardly constitute “regular employment” in New York.

insufficient to render a person amenable to a subpoena”); Bostian v. Suhor Indus., Inc., 2007 WL 3005177, at *1 (N.D. Okla. 2007) (copy attached in Appendix) (“twice yearly visits to Oklahoma to conduct business ... [does] not qualify as regularly transacting business”); In re Order Quashing Depositions Subpoenas, 2002 U.S. Dist. LEXIS 14928 (S.D.N.Y. Aug. 14, 2002) (copy attached in Appendix) (person who comes to New York for business four times within five years does not regularly transact business in New York under Rule 45(c)). Thus, even if Rule 45(c) had any relevance to the present inquiry – and there is no reason why it should – it would still not support the relief sought by Mycoskie.

In sum, there is no possible basis for compelling Mr. Sincini to appear for a discovery deposition in New York. Mycoskie’s refusal to consider anything other than an immediate oral deposition of Mr. Sincini in New York before seeking Board relief only serves to highlight the complete lack of good faith underlying its present motion.

C. Mycoskie Has Not Shown Good Cause for an Oral Deposition in Italy In Place of the Deposition on Written Questions Provided for by the Rules

Finally, although it never offered such an option prior to filing this motion, Mycoskie alternatively asks for an order permitting an oral deposition of Mr. Sincini in Italy. While it may be true that a deposition on written questions is more cumbersome than an oral deposition, the differences in these procedures are not sufficient to establish good cause permitting an oral deposition. See, e.g., Sabra Salads Food Indus. Ltd. v. Blue & White Food Prods. Corp., Opp. No. 91110383, 1999 TTAB LEXIS 647 (T.T.A.B. Nov. 18, 1999) (copy attached in Appendix) (granting motion to quash oral deposition of foreign opposer; good cause not shown despite “truism” that depositions upon written questions are “cumbersome”).

Were the more unwieldy nature of a deposition upon written questions sufficient to justify an oral deposition, the exception would swallow the rule by requiring oral depositions in

every case. However, the Board has made clear that the question of “[w]hat constitutes good cause so as to warrant requiring a deposition to be taken orally must be determined on a case by case basis upon consideration of the particular facts and circumstances in each situation.” Feed Flavors Inc. v. Kemin Indus., Inc., 209 U.S.P.Q. 589, 591 (T.T.A.B. 1980). For example, in Feed Flavors, the Board found that respondent had shown good cause for requiring petitioner to take oral depositions of former employees of respondent who now worked for petitioner, where the testimony depositions were being taken during petitioner’s rebuttal period and thus constituted the only opportunity respondent would have to confront these witnesses by way of oral cross-examination. Id.

Similarly, in the sole case on which Mycoskie relies in support of its request for an oral deposition in Italy, Orion Group, Inc. v. The Orion Insurance P.L.C., 12 U.S.P.Q.2d 1923 (T.T.A.B. 1989), applicant was seeking summary judgment based on the affidavit of a single witness. Id. at 1925. Having already found that the opposer needed a deposition pursuant to Fed. R. Civ. P. 56(f) in order to gather information within applicant’s control that was necessary to respond to applicant’s summary judgment motion, the Board ruled that opposer had demonstrated good cause. Id. Given that opposer was potentially facing dismissal of its entire case without any opportunity to confront the sole witness being offered by applicant on the dispositive motion, the Board found it would be “unjust in these circumstances to deprive opposer of obtaining discovery and specifically of confronting and examining the witness by oral examination.” Id.

Mycoskie cannot make a similar showing requiring an oral deposition in the circumstances of the present case. In the event that Tod’s ultimately determines to bring Mr. Sincini to the United States for an oral deposition during its testimony period, Mycoskie will

have the opportunity to confront the witness by way of oral cross-examination at that time. There is no reason why the relatively limited information Mycoskie seeks regarding Tod's knowledge of Mycoskie's registration and use of the TOMS mark cannot be adequately obtained through a deposition on written questions. Indeed, as Mycoskie acknowledges in its papers, it has already obtained a good deal of this information through interrogatory responses. Under these circumstances, Mycoskie cannot overcome the presumption in favor of deposition on written questions that is embodied in the applicable rules, and its motion to compel an oral deposition of Mr. Sincini should therefore be denied.

CONCLUSION

For the foregoing reasons, Tod's respectfully requests that the Board deny Mycoskie's motion to compel an oral deposition of Stefano Sincini.

Dated: New York, New York
February 2, 2016

Respectfully submitted,

COWAN, LIEBOWITZ & LATMAN, P.C.
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APPENDIX

Perez v. Progenics Pharms., Inc.

United States District Court for the Southern District of New York

June 24, 2015, Decided; June 24, 2015, Filed

10-cv-08278 (LAP)

Reporter

2015 U.S. Dist. LEXIS 83557

JULIO PEREZ, Plaintiff, - v - PROGENICS PHARMACEUTICALS, INC., Defendant.

Prior History: Perez v. Progenics Pharms., Inc., 965 F. Supp. 2d 353, 2013 U.S. Dist. LEXIS 104298 (S.D.N.Y., 2013)

Core Terms

issues, protected activity, disputed, state of mind, allegations, termination, accusations, prior act, deposition testimony, drafted

Counsel: [*1] Julio Perez, Plaintiff, Pro se, Tarrytown, NY.

For Christopher P Keenan, Petitioner: Christopher P. Keenan, Westermann, Hamilton, Sheehy, Aydelott & Keenan, White Plains, NY.

For Progenics Pharmaceuticals, Inc., Defendant: Blair Courtney Fensterstock, LEAD ATTORNEY, Evan Steele Fensterstock, Fensterstock & Partners LLP, New York City, NY.

For Robert Baker, Defendant: Eric David Raphan, LEAD ATTORNEYS, Sheppard, Mullin, Richter & Hampton, LLP (NYC), New York, NY.

Judges: LORETTA A. PRESKA, Chief United States District Judge.

Opinion by: LORETTA A. PRESKA

Opinion

MEMORANDUM & ORDER

LORETTA A. PRESKA, U.S.D.J.:

In anticipation of trial, Plaintiff has filed a number of motions in limine, several of which remain pending. Specifically, he seeks to call Nicole Williams to testify at trial [dkt. no. 229], to exclude evidence of prior litigation with his former employer and disputes with his attorney in this case [dkt. nos. 198, 199], and to limit the issues to be decided at trial [dkt. no. 222]. For the reasons below, Plaintiff's request to call Ms. Williams is denied, his request to exclude prior acts evidence is granted, and his request to limit the issues at trial is denied.

I. BACKGROUND

The facts of this case are detailed [*2] in Judge Karas's previous Opinion & Order of July 24, 2013 [dkt. no. 107] as well as his Opinion & Order of September 8, 2014 [dkt. no. 123], with which the Court assumes familiarity. This section accordingly presents only a brief summary of the case as it relates to the pending motions.

Plaintiff was previously employed by Defendant, a publicly traded biotechnology company, beginning in 2004. During his employment, Plaintiff's primary responsibility involved working on the development of a drug called Relistor, which Defendant was developing together with another pharmaceutical company called Wyeth Pharmaceuticals Division. In 2008, Defendant and Wyeth completed the second phase of clinical trials on an oral tablet form of Relistor. On May 22, 2008, Wyeth and Defendant issued a joint press release stating, among other things, that the second phase of trials "showed positive activity" and that the two companies were "pleased by the preliminary findings of this oral formulation" of Relistor. Subsequently, executives at Wyeth presented a Relistor Development Strategy Update (the "Wyeth Update"), which noted, among other things, that the second phase of clinical trials did not reflect [*3] "sufficient activity" to justify a third round of trials and recommended that the tablet not advance to a third phase of trials.

Defendant alleges that the Wyeth Update was a confidential document that its General Counsel, Mark Baker, shared with five members of the senior management team, not including Plaintiff. Nevertheless, Plaintiff somehow came to review a copy of the Wyeth Update, and in response he drafted a Memorandum dated August 4, 2008, in which he informed Defendant that it was "committing fraud against shareholders since representations made to the public were not consistent with the actual results of the relevant clinical trial, and [Plaintiff] think[s] this is illegal." Plaintiff delivered the Memorandum to Baker and Dr. Thomas Boyd, Senior Vice-President of Product Development, with certain slides from the Wyeth Update, the joint press release, and an article written by Wyeth employees attached.

Later that same day, Robert McKinney, Defendant's CFO, asked Plaintiff how he obtained a copy of the Wyeth Update. Plaintiff asked to speak with his attorney, and McKinney agreed. The next morning, Plaintiff met with McKinney and Baker, who presented Plaintiff with two letters indicating [*4] that the Memorandum's allegations were "without foundation" and that because Plaintiff refused to reveal how he came to possess the Wyeth Update, Baker concluded that he had "obtained the document through inappropriate or illicit means." At the end of the meeting, Baker terminated Plaintiff's employment with Defendant effective immediately. Later that same day, the Audit Committee of the Board of Directors for Defendant held a meeting, at which Baker reported the circumstances surrounding the Memorandum and Plaintiff's termination.

On September 12, 2008, Plaintiff, filed a complaint with the U.S. Department of Labor/Occupational Safety and Health Administration alleging that Defendant fired him in retaliation for the Memorandum. On December 5, 2008, the Secretary of Labor issued an order dismissing Plaintiff's allegations. After objecting to that order, Plaintiff filed the present suit alleging that Defendant violated the Sarbanes-Oxley Act of 2002 ("Sarbanes-Oxley"), 18 U.S.C. § 1514A, by terminating him in retaliation for the Memorandum, which he alleges constituted protected activity under that statute.

II. NICOLE WILLIAMS

Plaintiff seeks to call Nicole Williams, who is the Chair of Defendant's Audit [*5] Committee and a member of Defendant's Board of Directors, as a live witness at trial. Specifically, Plaintiff argues that because Ms. Williams's position includes overseeing compliance, she witnessed Baker's report to the Audit Committee on August 5, 2008 and can testify concerning the details of the decision to

terminate Plaintiff. (See Letter dated Nov. 20, 2014 [dkt. no. 185] at 2-3; Letter dated Apr. 14, 2015 [dkt. no. 229].)

Defendant opposes the request, arguing both that Ms. Williams has no personal knowledge of any relevant events and that she resides in Chicago and is therefore beyond the geographical limits of the Court's subpoena power. (See Letter dated Apr. 28, 2015 [dkt. no. 216].) Moreover, Defendant notes that Plaintiff had the opportunity to depose Ms. Williams and may therefore present her deposition testimony at trial even if she is unavailable to testify.

That Defendant listed Ms. Williams on its Witness List contradicts its contention that her testimony would be irrelevant. Indeed, Defendant's Witness List notes that Defendant expects to introduce deposition testimony from Ms. Williams concerning, among other topics, "the Perez termination, the Perez litigation, [*6] [and] the Joint Press Release." (See Witness List, dated Apr. 28, 2015 [dkt. no. 215] at 2.) Accordingly, Defendant's only colorable objection to Ms. Williams offering live testimony at trial hinges on her residence in Chicago, more than 100 miles from the location of trial. See FED. R. CIV. P. 45(c)(1)(A).

In response, Plaintiff notes that Ms. Williams is required to attend, either in person or telephonically, Audit Committee and Board meetings at least quarterly, which suggests that she is periodically physically present at Defendant's headquarters in Tarrytown, New York, within the 100 mile limit of Rule 45(c)(1)(A). Yet such infrequent trips do not appear to fit within the meaning of Rule 45(c)(1)(A)'s requirement that a witness only be forced to appear at trial in person within 100 miles of where she "regularly transacts business in person." Id. Although the Court is not aware of a specific number of days per year that Ms. Williams spends in New York to conduct business, it appears a stretch to say that she opened herself up to testifying in New York by virtue of her occasional meetings in Tarrytown. See M'Baye v. New Jersey Sports Prod., Inc., 246 F.R.D. 205, 207-08 (S.D.N.Y. 2007); see also Price Waterhouse LLP v. First Am. Corp., 182 F.R.D. 56, 62 (S.D.N.Y. 1998) ("Rule 45's goal is to prevent inconvenience to the flesh-and-blood human beings who are asked to testify, not the legal entity [*7] for whom those human beings work."). Given the apparent infrequency with which Ms. Williams conducts in-person business in New York, as well as the availability of her deposition testimony for Plaintiff's use at trial, the Court denies Plaintiff's request to call Ms. Williams in person.

Furthermore, Plaintiff's request for an adverse inference instruction concerning Ms. Williams's absence from trial is denied. Such an instruction lies in the discretion of the trial

court and should be given where a party "fail[s] to call a witness when the witness's testimony would be material and the witness is peculiarly within the control of that party." United States v. Caccia, 122 F.3d 136, 138 (2d Cir. 1997). "No instruction is necessary where the unrepresented testimony would be merely cumulative." United States v. Torres, 845 F.2d 1165, 1169 (2d Cir. 1988). Here, although Ms. Williams appears to be within Defendant's control for purposes of this standard, her testimony, though relevant, would be cumulative of evidence available through introduction of the Audit Committee's minutes as well as her own deposition testimony. Indeed, it appears that Ms. Williams' testimony would do little to elucidate the key disputed issues at trial, as she had no involvement in Plaintiff's termination other than receiving a report from [*8] Baker after the fact. Because Ms. Williams' live testimony would be cumulative and nonmaterial, the Court declines to issue an adverse inference instruction concerning her absence from trial.

III. PRIOR ACTS EVIDENCE

Defendant seeks to introduce evidence at trial concerning two of Plaintiff's prior acts. First, Defendant wishes to present evidence of Plaintiff's accusations that his prior attorney in this case engaged in misconduct. Second, Defendant wishes to raise Plaintiff's previous litigation against another former employer, Purdue Pharma L.P. ("Purdue"), which involved Plaintiff's removal of confidential documents without permission and accusations against his employer of, among other things, retaliation, discrimination, slander, and libel in 2005. The Purdue litigation was ultimately resolved through a consent judgment and permanent injunction that required Plaintiff to return the documents he took.

Defendant argues that both instances reflect Plaintiff's state of mind at the time that he drafted the Memorandum, which is directly at issue when determining whether he engaged in protected activity. Specifically, Defendant suggests that these incidents tend to show that Plaintiff [*9] either did not truly believe that Defendant had made misrepresentations or that Plaintiff's belief was not reasonable, either of which would mean that Plaintiff did not engage in protected activity. See Nielsen v. AECOM Tech. Corp., 762 F.3d 214, 221 (2d Cir. 2014) ("[T]he plaintiff must have a subjective belief that the challenged conduct violates a provision listed in § 1514A, and . . . this belief must be objectively reasonable."). Plaintiff objects to the introduction of this evidence as irrelevant, impermissible propensity evidence, and prejudicial.

A. Applicable Law

Under Federal Rule of Evidence 404(b), evidence of "other act[s] is not admissible to prove a person's character in order to show that on a particular occasion the person acted in accordance with the character." FED. R. EVID. 404(b)(1). Such evidence may, however, "be admissible for another purpose, such as proving motive, opportunity, intent, preparation, plan, knowledge, identity, absence of mistake, or lack of accident." FED. R. EVID. 404(b)(2). The Court of Appeals has indicated that courts should apply "an inclusionary approach" to 404(b), which "allows evidence for any purpose other than to show . . . propensity." United States v. Garcia, 291 F.3d 127, 136 (2d Cir. 2002) (quoting United States v. Pitre, 960 F.2d 1112, 1118 (2d Cir. 1992) (internal quotation marks omitted)). "Courts may admit evidence of prior bad acts if the evidence is relevant to an issue at trial other than [*10] the defendant's character, and if the probative value of the evidence is not substantially outweighed by the risk of unfair prejudice." Id. (quoting United States v. Tubol, 191 F.3d 88, 95 (2d Cir. 1999)) (internal quotation marks omitted). Under this standard, courts "consider whether: (1) the prior act evidence was offered for a proper purpose; (2) the evidence was relevant to a disputed issue; (3) the probative value of the prior act evidence substantially outweighed the danger of its unfair prejudice; and (4) the court [can administer] an appropriate limiting instruction." Id.

Even if evidence is permissible and relevant under 404(b), however, the Court may still exclude it "if its probative value is substantially outweighed by a danger of . . . unfair prejudice, confusing the issues, misleading the jury, undue delay, wasting time, or needlessly presenting cumulative evidence." FED. R. EVID. 403.

B. Plaintiff's Prior Attorney

Turning first to Plaintiff's conflict with his attorney, Defendant has failed to demonstrate the relevance of that incident to Plaintiff's state of mind when he drafted the Memorandum years earlier. See Garcia, 291 F.3d at 137-38. Plaintiff's recent accusations reveal nothing about what was in his mind at the time that he engaged in the allegedly protected [*11] activity at issue here, and Defendant has not explained with any particularity how Plaintiff's conflict with his attorney parallels his 2008 Memorandum. See United States v. Curley, 639 F.3d 50, 61 (2d Cir. 2011) ("This Circuit has upheld the admission of subsequent act evidence to prove a state of mind only when it so closely paralleled the charged conduct that it was probative regardless of the temporal difference."); Dallas v. Goldberg, 143 F. Supp. 2d 312, 318 (S.D.N.Y. 2001). Rather, Defendant's desire to raise Plaintiff's conflict with his

attorney strikes the Court as an attempt to suggest that Plaintiff made supposedly frivolous accusations of misconduct against his attorney, which makes it more likely that his accusations in the Memorandum were frivolous. This reasoning falls squarely into the category of propensity evidence that Rule 404(b) prohibits.

Although Defendant correctly points out that this Circuit applies an inclusionary approach to Rule 404(b), merely saying the magic words "state of mind" does not satisfy this standard. See Garcia, 291 F.3d at 137 ("The government may not invoke Rule 404(b) and proceed to offer, *carte blanche*, any prior act of the defendant in the same category of crime."). Instead, Defendant must demonstrate that Plaintiff's conflict with his former attorney in fact bears some connection to his state of mind at [*12] the time of his allegedly protected activity several years beforehand. See id. at 137-38. This it cannot do. Accordingly, Defendant is prohibited from raising or presenting any evidence concerning Plaintiff's conflict with and allegations against his attorney at trial.

C. Purdue Litigation

Defendant faces similar difficulty explaining the relevance of the Purdue litigation to Plaintiff's state of mind at the time he drafted the Memorandum. Although Defendant again claims to present this evidence for a proper purpose, it does not explain how the existence of this 2005 litigation is relevant to the reasonableness of Plaintiff's belief three years later that he was identifying illegal conduct when drafting the Memorandum. See id. at 136. The only probative value that might be gleaned from the Purdue litigation is a demonstration that Plaintiff made potentially frivolous allegations against a different employer in the past that were of a different kind and in a different context. This limited value is further diminished because the Purdue litigation ultimately settled without any resolution determining whether Plaintiff's allegations were in fact accurate. It is thus difficult to grasp how Plaintiff's prior [*13] accusations against a completely different company of discrimination, slander, and "deception" offer any insight into Plaintiff's state of mind when accusing Defendant of defrauding its shareholders three years later.

Although Plaintiff's retention of confidential documents without permission in the Purdue litigation presents a possible parallel to his use of the Wyeth Update, that prior act would, at most, only bear upon his state of mind when procuring the Wyeth Update. Plaintiff's potential awareness that he should not access confidential documents without permission, however, has nothing to do with the "disputed

issue" of whether Plaintiff reasonably believed that Defendant violated federal law. Id. at 136. Rather, it appears as though Defendant wishes to raise this prior act to illustrate Plaintiff's supposed propensity to make unfounded allegations against his employers. Again, such evidence is barred by 404(b). Furthermore, this evidence of other litigation risks "confusing the issues" and even "misleading the jury" with a distracting point of limited probative value that may run awry of Rule 403. FED. R. EVID. 403. Accordingly, Defendant is barred from presenting evidence of the Purdue litigation at trial.

IV. [*14] ISSUES FOR TRIAL

Finally, Plaintiff seeks to limit further the issues to be decided at trial. Based on the mutual agreement of the parties, the Court previously ordered that the only disputed issues for trial are the first and fourth elements of Plaintiff's Sarbanes-Oxley claim (i.e., whether Plaintiff engaged in protected activity and whether that activity was a contributing factor to Plaintiff's termination). (See Order dated Apr. 2, 2015 [dkt. no. 211] at 1-2.) Plaintiff now suggests that the first element should no longer be disputed based on one of the Department of Labor's findings in its 2008 decision, which determined that Plaintiff engaged in protected activity but ultimately concluded that activity was not a contributing factor to his termination. (See Letter dated Apr. 28, 2015 [dkt. no. 222]; Letter dated May 1, 2015 [dkt. no. 221].) As Defendant correctly points out, however, Plaintiff cannot expect the Court to accept the first portion of those findings while ignoring the ultimate conclusion. Indeed, were the Court to credit the Department of Labor's findings as dispositive, there would be no need for trial at all. The Court declines to rely on this agency decision to [*15] determine the issues for trial and the proper resolution of this case.

Plaintiff's other evidence to support his assertion that the protected activity element cannot be disputed rests on his own characterization and interpretation of witness deposition testimony. (See Letter dated Apr. 28, 2015.) Yet as demonstrated by Defendant's letter response, these witnesses' statements are open to interpretation and do not constitute dispositive evidence that Plaintiff in fact engaged in protected activity. (See Letter dated May 1, 2015.) If anything, Plaintiff's letter and Defendant's response demonstrate that this issue is a contested factual issue that is best left to the jury. As such, Plaintiff's request for a pre-motion conference on this issue is denied.

CONCLUSION

For the foregoing reasons, IT IS HEREBY ORDERED that:

1. Plaintiff's request to call Nicole Williams as a live witness at trial [dkt. no. 229] is DENIED.

2. Plaintiff's motions to exclude evidence [dkt. nos. 198, 199] are GRANTED in part and DENIED in part. Specifically, they are granted with respect to the Purdue litigation and Plaintiff's former counsel. Defendant will not be permitted to present evidence of these events at trial. [*16] As indicated in the Court's April 2, 2015 Order [dkt. no. 211], however, these motions are denied with respect to Plaintiff's resume, unemployment compensation, and admissions in his 56.1 Statement or Response.

3. Plaintiff's request to limit the issues to be decided at trial [dkt. no. 222] is DENIED. Concomitantly, Defendant's motions opposing this request [dkt. nos. 220, 221] are GRANTED.

4. The parties are instructed to confer and attempt to resolve their remaining disputes concerning objections to proposed

exhibits, witnesses, and deposition designations for trial. Plaintiff is also reminded that the time for additional motions in limine has now passed. The Court will address any disputes that cannot be resolved by the parties themselves at the final pretrial conference scheduled to take place on July 8, 2015 at 10:00 AM.

SO ORDERED.

Dated: New York, New York

June 24, 2015

/s/ Loretta A. Preska

LORETTA A. PRESKA

Chief United States District Judge

2007 WL 3005177

Only the Westlaw citation is currently available.
United States District Court,
N.D. Oklahoma.

Jonna BOSTIAN, Plaintiff,
v.
SUHOR INDUSTRIES, INC., Tulsa Monument,
Inc., and Russ Rogers, an individual, Defendant.

No. 07-CV-151-GFK-FHM.

|
Oct. 12, 2007.

Attorneys and Law Firms

Bill V. Wilkinson, Wilkinson Law Firm, Tulsa, OK, for Plaintiff.

Stephanie Terry Gentry, Marshall James Wells, Hall Estill Hardwick Gable Golden & Nelson, Tulsa, OK, for Defendant.

OPINION AND ORDER

FRANK H. McCARTHY, United States Magistrate Judge.

*1 The Motion to Quash of Defendant Suhor Industries, Inc. (Suhor) and John Spies [Dkt. 15] is before the undersigned United States Magistrate Judge for disposition. The matter has been fully briefed and is ripe for decision. The Motion to Quash [Dkt. 15] is GRANTED.

Mr. Spies is the Human Resource Director for Defendant Suhor. A subpoena duces tecum was served on Mr. Spies while he was in Tulsa on business for Suhor. According to Mr. Spies' affidavit, he is not an officer of Suhor. He lives in Overland Park, Kansas and works at Suhor's home office located there, although he has traveled to Oklahoma twice a year since 2003 on business. [Dkt. 15-4].

The subpoena is properly quashed under 45(c)(3)(A)(ii), which provides that a subpoena may be quashed if it:

requires a person who is not a party or an officer of a party to travel to a place more than 100 miles from the place where that person resides,

is employed or regularly transacts business in person ...

Mr. Spies' home and place of employment are more than 100 miles from Tulsa, therefore since Mr. Spies is not a party nor the officer of a party he may not be summoned to Tulsa for a deposition unless he regularly transacts business in person in Tulsa. The question is whether Mr. Spies' twice yearly visits to Oklahoma to conduct business qualifies as regularly transacting business for purposes of the subpoena. The Court concludes that those infrequent visits do not qualify as regularly transacting business.

The parties did not cite any authority concerning what will qualify as regularly transacting business to sustain a subpoena. The Courts own research found little guidance. The Court considered the question in *Regents of University of California v. Kohne*, 166 F.R.D. 463 (S.D.Cal.1996) and rejected the argument that a jurisdictional analysis should be applied. The Court reasoned that a jurisdictional analysis is inappropriate for addressing Rule 45 objections because the analysis a court engages in to determine whether a party should be subject to the jurisdiction of a state responds to an entirely different set of concerns. *Id.* at 464. In considering specific or general jurisdiction, courts consider what circumstances due process would permit a state to enforce its laws over a party. Jurisdictional considerations involve determinations as to the reasonable limits of the power of the state and notice to a party that its conduct may be subject to the laws of a particular jurisdiction. In contrast, Rule 45 is concerned with the burden to a party forced to physically appear. *Id.* The Court in *Regents* determined that the language in Rule 45 should be read literally and concluded that visiting the jurisdiction ten times in seven years did not qualify as regularly conducting business for a Rule 45 subpoena. *Id.* at 465.

The undersigned is persuaded that the approach taken by the *Regents* Court is reasonable. Mr. Spies' twice yearly business visits to Oklahoma are not frequent enough to be considered regularly transacting business. Therefore, as a non-party he will not be required to travel here for a deposition.

*2 Defendant Suhor objects to subpoena on the basis that the documents sought are not the property of Mr. Spies. Rather, the documents belong to Suhor and have been requested from Suhor in discovery, although production is awaiting the entry of a protective order. Suhor's objection stands as an additional reason to quash the subpoena. The Court rejects Plaintiff's argument that Mr. Spies should be

required to produce the requested documents because under Rule 45, regardless of ownership, he has “control” of the documents. Although the cases cited by Plaintiff define the term control as used in Rule 45, none of those cases address the situation presented here where documents belonging to the defendant corporation are subpoenaed directly from a non-party employee. Since the documents sought belong to Defendant Suhor, they are appropriately obtained directly from Suhor under Fed.R.Civ.P. 34.

Based on the foregoing, The Motion to Quash of Defendant Suhor Industries, Inc. and John Spies [Dkt. 15] is GRANTED.

SO ORDERED.

All Citations

Not Reported in F.Supp.2d, 2007 WL 3005177

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Nissan Fire & Marine Ins. Co. v. Fortress Re, Inc. (In re Order Quashing Deposition Subpoenas)

United States District Court for the Southern District of New York

August 13, 2002, Decided ; August 14, 2002, Filed

Misc. No. M8-85, 1:02CV00054 (M.D.N.C.)

Reporter

2002 U.S. Dist. LEXIS 14928

In the Matter of the Application for an Order Quashing Deposition Subpoenas, dated July 16, 2002, served upon TAKAO SHIDA, TAKAO SASAKI, and SHUYA KOJIMA, Non-Party Movants. THE NISSAN FIRE & MARINE INSURANCE COMPANY, LTD., a foreign corporation, Plaintiff, -against- FORTRESS RE, INC., a North Carolina corporation, MAURICE D. SABBAH, ZMIRA SABBAH, LEEOR B. SABBAH, and KENNETH H. KORNFELD, Defendants.

Disposition: [*1] Motion to quash the subpoena served upon Sasaki was granted. Motion for sanctions pursuant to Fed. R. Civ. P. 45(c)(1) was denied.

Core Terms

subpoena, deposition, movants, modify, discovery, circumstances, modification, territorial, appearance, requires, quashing a subpoena, motion to quash, district court, consular, motion for sanctions, arbitration, non-party, regularly, resident, attend, courts, travel

Case Summary

Procedural Posture

Non-party movants, officers of a foreign corporation, sought an order under Fed. R. Civ. P. 45(c)(3)(A)(ii), (iv) quashing subpoenas issued in this judicial district and served requiring their personal appearance for depositions in New York and an order under Fed. R. Civ. P. 45(c)(1) imposing sanctions upon respondents, a reinsurance underwriter and individuals, and their counsel.

Overview

There was an action pending in North Carolina concerning a dispute between respondents and another foreign corporation. The officers worked for a Japanese company in Japan and were Japanese citizens. While the officers maintained offices in New York, the officer served with a subpoena had only used the office four times during the preceding 10 years. While in New York to attend a meeting with respondents to discuss their corporation's potential claims and the possibility of settling the dispute, respondents served a subpoena on one of the officers. Respondents claimed that the officers' knowledge of how they ran the business was relevant to their defense in the North Carolina action. The court found that based on representations made by counsel for the movants at oral argument that the officers had no knowledge of any facts relevant to the North Carolina action. Service of the subpoenas was proper since the subpoenas sought the officers' appearance for depositions in New York and were personally served upon them within the district. The subpoenas could not have been reasonably modified to enable the depositions to occur in Japan.

Outcome

The officers' motion to quash the subpoena served upon one of the officers was granted. The officers' motion for sanctions was denied.

LexisNexis® Headnotes

Civil Procedure > ... > Jurisdiction > Subject Matter Jurisdiction > General Overview

Civil Procedure > ... > Subject Matter Jurisdiction > Jurisdiction Over Actions > General Overview

Civil Procedure > ... > Subject Matter Jurisdiction > Jurisdiction Over Actions > General Jurisdiction

Civil Procedure > Discovery & Disclosure > Discovery > Subpoenas

HN1 Under Fed. R. Civ. P. 45(a)(2), a subpoena for attendance at a deposition must issue from the court for the district in which the deposition is to be taken. Fed. R. Civ. P. 45(b)(2) authorizes service of such a subpoena (1) at any place within the district of the court by which it is issued; (2) at any place outside the district that is within 100 miles of the place of the deposition, hearing, trial, production, or inspection specified in the subpoena; or (3) at any place within the state if state law authorizes statewide service of a subpoena issued by a state court of general jurisdiction sitting in the place of the deposition, hearing, trial, production, or inspection specified in the subpoena.

Civil Procedure > ... > Jurisdiction > In Rem & Personal Jurisdiction > General Overview

Civil Procedure > Discovery & Disclosure > Discovery > Subpoenas

Labor & Employment Law > ... > Disability Discrimination > Evidence > General Overview

HN2 An individual may be subjected to liability by the exercise of so-called tag jurisdiction far from home without the Due Process Clause being violated, there is no reason why service of a subpoena under Fed. R. Civ. P. 45(b)(2), which is simply a discovery mechanism and does not subject a person to liability, requires more.

Civil Procedure > Pleading & Practice > Motion Practice > General Overview

Civil Procedure > Pleading & Practice > Motion Practice > Time Limitations

Civil Procedure > Discovery & Disclosure > Discovery > Subpoenas

Labor & Employment Law > ... > Disability Discrimination > Evidence > General Overview

HN3 The authority to serve a subpoena under Fed. R. Civ. P. 45(b)(2) is explicitly made subject to the provisions of Fed. R. Civ. P. 45(c)(3)(A)(ii), which provides that upon a timely motion, a district court by which a subpoena is issued shall quash or modify the subpoena if it requires a person who is not a party or an officer of a party to travel to a place more than 100 miles from the place where that person resides, is employed or regularly transacts business in person. The purpose of the territorial limitation is to protect non-party witnesses from being subjected to excessive discovery burdens in litigation in which they have little or no interest. Non-party witnesses also are protected from being held in contempt for failure to obey subpoenas that purport to require them to attend depositions at places outside the territorial limits of Fed. R. Civ. P. 45(c)(3)(A)(ii). Fed. R. Civ. P. 45(e).

Civil Procedure > Discovery & Disclosure > Discovery > Subpoenas

Governments > Courts > Judicial Comity

International Law > Dispute Resolution > General Overview

International Law > Dispute Resolution > Comity Doctrine > General Overview

International Law > Dispute Resolution > Evidence > Assistance Obtaining Evidence

HN4 When it is necessary to seek evidence abroad, prudential considerations of international comity require a district court to supervise pretrial proceedings particularly closely to prevent discovery abuses.

Civil Procedure > Discovery & Disclosure > Discovery > Subpoenas

HN5 Fed. R. Civ. P. 45(c)(1) obligates a party or attorney responsible for the issuance and service of a subpoena to take reasonable steps to avoid imposing undue burden or expense on a person subject to that subpoena, and requires a district court on whose behalf the subpoena is issued to enforce this duty and impose upon the party or attorney in breach of this duty an appropriate sanction, which may include, but is not limited to, lost earnings and a reasonable attorney's fee.

Counsel: Thomas F. Bush, Lovells, Chicago, IL, for Non-Party Movants.

Marc J. Gottridge, Joseph T. McCullough IV, and Nazanin Lankarani, Lovells, of counsel, New York, NY, for Non-Party Movants.

Jack B. Gordon, Rita M. Odin, of counsel, Fried, Frank, Harris, Shriver & Jacobson, New York, NY, for Respondents.

Judges: GERARD E. LYNCH, United States District Judge.

Opinion by: GERARD E. LYNCH

Opinion

OPINION AND ORDER

GERARD E. LYNCH, *District Judge*:

Non-party movants Takao Shida, Takao Sasaki, and Shuya Kojima seek (1) an order pursuant to Fed. R. Civ. P. 45(c)(3)(A)(ii) & (iv) quashing subpoenas issued in this judicial district and served on July 16, 2002, requiring their

personal appearance for depositions in New York on August 15 and 16, 2002, and (2) an order pursuant to Fed. R. Civ. P. 45(c)(1) imposing sanctions upon respondents Fortress Re, Inc., Maurice D. Sabbah, Zmira Sabbah, Leeor B. Sabbah, Kenneth H. Kornfeld, and their counsel, Fried, Frank, Harris, Shriver & Jacobson, LLP, for breaching their duty to avoid imposing undue burden or expense upon [*2] the subpoena recipients. The subpoenas have been issued in connection with an action pending before the U.S. District Court for the Middle District of North Carolina, *Nissan Fire & Marine Insurance Co., Ltd. v. Fortress Re, Inc.*, No. 1:02-CV-00054 (M.D.N.C.).

Based on representations made by counsel for the movants at oral argument that Shida and Kojima have no knowledge of any facts relevant to the North Carolina action, counsel for respondents has agreed to withdraw the subpoenas served upon those two movants, leaving before the Court only the motion to quash as to the subpoena served upon Sasaki and the motion for sanctions. For the reasons that follow, the motion to quash will be granted, but the motion for sanctions will be denied.

BACKGROUND

The action pending in North Carolina concerns a dispute between plaintiff Nissan Fire and Marine Insurance Co., Ltd. ("Nissan"), a Japanese corporation, and defendants Fortress Re, Inc. ("Fortress Re"), a reinsurance underwriting manager based in North Carolina, and the individual defendants, who are all directors, officers, or shareholders of Fortress Re. (Drew Decl. PP 3--4.) Since 1972, Fortress Re has served as managing underwriting [*3] agent for a group of several Japanese insurance companies, which in recent years has included Nissan, Taisei Fire and Marine Insurance Co., Ltd. ("Taisei"), and Aioi Insurance Co., Ltd. ("Aioi"). (Drew Decl. PP 4--5.) All three of these Japanese companies are now involved in disputes with Fortress Re arising from the termination of their respective management agreements with Fortress Re. (Drew Decl. PP 8--9.) Nissan initiated the North Carolina action and an arbitration proceeding against Fortress Re and the individual defendants, alleging, *inter alia*, that the respondents engaged in fraud and misrepresentation when disclosing information to Nissan. Fortress Re has served Nissan with a counter-demand for arbitration and has served Aioi with a separate demand for arbitration. (Drew Decl. P 9; Juceam Decl. PP 2--3.) Taisei and Aioi are not parties to the North Carolina action filed by Nissan, but respondents maintain that testimony

from Aioi's officers and employees is relevant to Fortress Re's defense of the North Carolina action because a significant issue in that dispute concerns whether Nissan had knowledge of Fortress Re's practices and understood its disclosures. According [*4] to respondents, Nissan, Taisei, and Aioi received substantially identical information from the respondents and discussed that information amongst themselves, making Aioi employees a source of substantial, material evidence to their defense of the North Carolina action. (Drew Decl. P 4; Juceam Decl. P 4.)

Sasaki is a citizen and resident of Japan and is General Manager of Aioi's Reinsurance Department. While Aioi has a New York office, Sasaki maintains that he does not regularly work out of that office and has only come to New York for business four times within the past five years.¹ (Sasaki Decl. PP 2, 4--5.) One of those instances, however, was a trip to New York to attend a meeting held with representatives of Fortress Re on July 16, 2002, for the purpose of discussing Aioi's own potential claims against Fortress Re and the possibility of settling their disputes. Shida and Kojima accompanied Sasaki to that meeting, which was held in New York, rather than North Carolina, at the request of the three Aioi employees and for their convenience. (Juceam Decl. PP 6--8; Sasaki Decl. PP 6--7; Kojima Decl. PP 6--7; Shida Decl. PP 6--7.) The meeting did not, however, result in any settlement [*5] of the dispute between Fortress Re and Aioi, and at the end of the meeting, counsel for Fortress Re asked counsel for the movants to accept service of subpoenas seeking their appearance for depositions in New York on August 15 and 16, 2002. While counsel for the movants vigorously objected to service of the subpoenas, the movants ultimately accepted service under protest, without agreeing that service was proper and expressly reserving their rights to challenge those subpoenas. (McCullough Decl. P 9; Sasaki Decl. P 9; Kojima Decl. P 9; Shida Decl. P 9; Juceam Decl. PP 9--10.)

Subsequent attempts to work out an amicable resolution concerning the movants' depositions were unsuccessful. (Juceam Decl. PP 11--12.) This motion followed and was heard before this Court as a miscellaneous application on August 8, 2002.

[*6] DISCUSSION

I. Motion to Quash Subpoena

HNI Under Rule 45(a)(2) of the Federal Rules of Civil Procedure, a subpoena for attendance at a deposition must

¹ By contrast, respondents maintain that Sasaki has traveled to North Carolina at least six times within the past ten months for the purpose of discussing Aioi's business with Fortress Re. (Drew Decl. P 13.)

issue from the court for the district in which the deposition is to be taken. Fed. R. Civ. P. 45(a)(2). Rule 45(b)(2) authorizes service of such a subpoena (1) "at any place within the district of the court by which it is issued," (2) at any place outside the district "that is within 100 miles of the place of the deposition, hearing, trial, production, or inspection specified in the subpoena," or (3) "at any place within the state" if state law authorizes statewide service of a subpoena "issued by a state court of general jurisdiction sitting in the place of the deposition, hearing, trial, production, or inspection specified in the subpoena." Fed. R. Civ. P. 45(b)(2).

Service of the subpoenas in this case properly complied with both of these requirements, since the subpoenas sought the movants' appearance for depositions in New York and were personally served upon the movants within this district. While the movants protests that service upon the movants was improper because they were "ambushed" with service after being "induced" [*7] by the respondents to come all the way from Japan to New York for the express and sole purpose of engaging in settlement negotiations with Fortress Re (Movants Br. 3--4), the Court finds no basis to conclude that the movants were in any way privileged or immunized -- whether on account of the transient nature of their sojourn to New York or the purpose for which they made that trip -- from service of process in this judicial district. *See, e.g., Kadic v. Karadzic*, 70 F.3d 232, 246--47 (2d Cir. 1995) (upholding exercise of personal jurisdiction over citizen of foreign country visiting New York for purpose of addressing United Nations). The movants fully "knew, or should have known, that by" attending the meeting in New York, they were also "risking exposure to personal jurisdiction in New York." *First Am. Corp. v. Price Waterhouse LLP*, 154 F.3d 16, 20--21 (2d Cir. 1998) (citing *Burnham v. Superior Court*, 495 U.S. 604, 635, 109 L. Ed. 2d 631, 110 S. Ct. 2105 (1990)). Given that *HN2* an individual may be subjected to liability by the exercise of so-called "tag" jurisdiction far from home without the Due Process Clause being violated, there [*8] is no reason why service of a subpoena under Rule 45(b)(2), "which is simply a discovery mechanism and does not subject a person to liability, requires more." *In re Edelman*, 295 F.3d 171, 179 (2d Cir. 2002); *see First Am.*

Corp., 154 F.3d at 20. As for the "ambush" argument, while the movants make much rhetorically of this claim, they in fact make no legal argument, and cite no authority, for the proposition that persons engaged in business discussions relating to the settlement of a dispute may not be served with process. Actual service of the subpoenas upon the movants, therefore, itself raises no legal question.

However, *HN3* the authority to serve a subpoena under Rule 45(b)(2) also is explicitly made "subject to the provisions of" Rule 45(c)(3)(A)(ii), which provides that upon a timely motion,

the court by which a subpoena was issued *shall* quash *or* modify the subpoena if it . . . requires a person who is not a party or an officer of a party to travel to a place more than 100 miles from the place where that person resides, is employed or regularly transacts business in person.

Fed. R. Civ. P. 45(c)(3)(A)(ii) (emphasis added). [*9] The purpose of the territorial limitation "is to protect [non-party] witnesses from being subjected to excessive discovery burdens in litigation in which they have little or no interest." *Edelman*, 295 F.3d at 178; *see Price Waterhouse LLP v. First Am. Corp.*, 182 F.R.D. 56, 63 (S.D.N.Y. 1998). Non-party witnesses also are protected from being held in contempt for failure to obey subpoenas that purport to require them to attend depositions at places outside the territorial limits of Rule 45(c)(3)(A)(ii). Fed. R. Civ. P. 45(e).²

It is undisputed [*10] that Sasaki, who lives and works in Japan, would be required to travel more than 100 miles from their place of residence and employment in order to be deposed in New York. It also seems perfectly clear that Sasaki does not "regularly transact[] business in person" in New York to the extent contemplated by Rule 45(c)(3)(A)(ii).³ *See Regents of University of California v. Kohne*, 166 F.R.D. 463, 465 (S.D.Cal. 1996) (under Fed. R. Civ. P. 45(c)(3)(A)(ii), "'regularly' does not mean ten times in seven years").

² Arguably, given Rule 45(c)(3)(A)(ii), the movants could have simply ignored the subpoenas, rather than moving to quash them, without fearing any contempt sanction from this Court on account of their noncompliance. *See* Fed. R. Civ. P. 45(e). Understandably and appropriately, however, they have sought to have their obligations adjudicated in advance, rather than defying the subpoenas and asserting defenses in a contempt proceeding.

³ Respondents emphasize Sasaki's extensive contacts in North Carolina in connection with Aioi's business relationship with Fortress Re, noting that he made at least six trips to North Carolina within the past ten months. (Drew Decl. P 13.) While those contacts may or may not support the conclusion that Sasaki "regularly transacts business in person" in North Carolina under Rule 45(c)(3)(A)(ii), they are simply irrelevant to whether he does so in New York.

What is not altogether clear, however, [*11] is the effect that should be given to the cross-referencing language making Rule 45(b)(2) "subject to" the provisions of Rule 45(c)(3)(A)(ii), for that language is, to say the least, somewhat ambiguous. See David B. Siegel, *Federal Subpoena Practice Under the New Rule 45 of the Federal Rules of Civil Procedure*, 139 *F.R.D.* 197, 209 (1992) ("In some situations when one consults Rule 45 for guidance about the territorial reach of a subpoena and starts to hop back and forth among [Rule 45's various subsections], the rule comes off like a Tower of Babel, an inferno with shrill voices jabbering simultaneously in a confusion of tongues."). Sasaki argues that a subpoena that transgresses the territorial limitations set forth in Rule 45(c)(3)(A)(ii) is invalid *ab initio*, and accordingly that the Court *must* quash the subpoena as beyond the authority conferred in Rule 45(b)(2) to serve it. By contrast, respondents maintain that the cross-referencing language making Rule 45(b)(2) "subject to" the provisions of Rule 45(c)(3)(A)(ii) does not *automatically* render a subpoena invalid if it exceeds those territorial limitations, but instead vests discretion in the [*12] district court, as provided in the latter rule, either to quash *or* modify the subpoena when presented with a timely motion for relief by the subpoena recipient. On respondents' reading of Rule 45(b)(2), the court still must do *something* when faced with the circumstances described in Rule 45(c)(3)(A)(ii) and presented with a timely motion -- given the mandatory language of the rule, which states that the court "*shall* quash or modify" the subpoena, the court cannot simply let such a subpoena stand as issued. At the same time, quashing the subpoena is not the only option available to the court. Rather, at its discretion, the court is permitted either to quash *or* to modify the subpoena as the circumstances warrant. On this view, Rule 45 permits a party to serve a subpoena that cannot be enforced according to its terms, "subject to" later modification (or quashing) of the subpoena.

The parties draw our attention to only a handful of cases involving circumstances akin to those presented here. For example, in *Matthias Jans & Assocs., Ltd. v. Dropic*, 2001 *U.S. Dist. LEXIS 4841*, No. 01-MC-26, 2001 WL 1661473 (W.D. Mich. Apr. 9, 2001), the court concluded that the movant was entitled to [*13] relief from a subpoena issued in Western District of Michigan and served upon a resident of that district in connection with an action pending in the Northern District of Ohio, since the subpoena sought the appearance of the movant for a deposition in Cleveland, Ohio -- a location outside the territorial restrictions set forth in Rule 45(c)(3)(A)(ii). Rather than quashing the subpoena altogether, however, the court ordered that the subpoena be modified to require its recipient to appear for the deposition

"at a place to be agreed upon by all counsel, no greater than 100 miles" from her residence. *Id.* at *3, 2001 *U.S. Dist. LEXIS 4841*. Similarly, in *Comm-Tract Corp. v. Northern Telecom, Inc.*, 168 *F.R.D.* 4, 7 (*D.Mass.* 1996), the court modified a subpoena issued and served in Massachusetts upon a non-party witness who, by the time scheduled for his appearance at trial, was to have commenced work on a three-year expatriate assignment in Hong Kong, concluding that the "just result" was to modify the subpoena to require the witness to submit to a videotape deposition in Hong Kong. By contrast, in *St. Paul Fire & Marine Insurance Co. v. Royal Insurance Co.*, 1993 *U.S. Dist. LEXIS 9415*, No. 91 *Civ. 6151 (PNL)*, 1993 WL 267347, [*14] (S.D.N.Y. July 12, 1993), the court stated that "Rule 45(c)(3)(A)(ii) appears to require the quashing of a subpoena if it requires a person who is neither a party nor an officer of a party to travel to a place more than 100 miles from his or her residence or place of business to testify," and on that basis quashed the subpoena. *Id.* at *1, 1993 *U.S. Dist. LEXIS 9415* (emphasis added); cf. *Price Waterhouse LLP v. First Am. Corp.*, 182 *F.R.D.* 56, 63--64 (S.D.N.Y. 1998) (concluding that the court could not modify a subpoena that sought the appearance of residents of England for a deposition in New York to provide instead that the deposition take place in London because such a modification would "create a subpoena that *does not* issue from 'the district in which the deposition is to be taken.'" in violation of Rule 45(a)(2)). Plausible policy arguments support both readings. It seems peculiar to permit a party to serve a subpoena that is unenforceable according to its terms. On the other hand, it is not uncommon that non-jurisdictional defects may be waived if they are not asserted, and the rule may contemplate the possibility of securing jurisdiction over a witness who is otherwise difficult [*15] to locate or serve, leaving it to later court action -- if sought by the witness -- to achieve a fair result. Given that the rule expressly authorizes the Court to quash *or* modify the subpoena, it seems equally odd to conclude that the sensible results ordered by the courts in *Matthias Jans* and *Comm-Tract* were simply unauthorized by law.

Nevertheless, the Court need not resolve in this case whether Rule 45(b)(2) requires that a subpoena in violation of Rule 45(c)(3)(A)(ii) be quashed or confers discretion upon the court to modify such a subpoena. Assuming, without deciding, that Rule 45(b)(2) permits a court to modify a subpoena whose enforcement would violate Rule 45(c)(3)(A)(ii), on the facts of this case the Court would in any event exercise its discretion to quash, rather than modify, the subpoena served upon Sasaki.

It is not clear that the Court can fashion a modification to the subpoena that would both satisfy the requirements of

Rule 45(c)(3)(A)(ii) and be appropriate to the particular circumstances presented here. As already noted, even on respondents' interpretation of Rule 45, the Court cannot order Sasaki to appear for a deposition here in New York -- the [*16] Court must either "quash or modify" that deposition. The only plausible modification that would bring the subpoena into compliance with Rule 45(c)(3)(A)(ii) would change the location of the deposition from New York to Tokyo. Were Sasaki a resident of another judicial district in the United States, that approach might seem an altogether sensible, appropriate, and straightforward exercise of this Court's discretion to "quash or modify" the subpoena. See Matthias Jans, 2001 U.S. Dist. LEXIS 4841, 2001 WL 1661473, at *2--*3.

In this case, however, modifying the subpoena to require attendance at a deposition in Japan would be a more complicated endeavor. Japanese law authorizes a deposition in Japan for use in U.S. courts only if (1) the witness or party is willing to be deposed, (2) the deposition takes place on U.S. consular premises, (3) a consular officer presides over that deposition, pursuant either to a letter rogatory issued by a U.S. court or to a court order (for example, under the All Writs Act, 28 U.S.C. § 1651) that specifically authorizes a U.S. consular officer to take the deposition on notice, and each participant traveling from the United States to Japan to [*17] participate in the deposition obtains a "deposition visa." Resp. Ex. C. (circular on obtaining evidence in Japan issued by U.S. Department of State); see Consular Convention and Protocol, Mar. 22, 1963, U.S.-Japan, art. 17(1)(e)(ii), 15 U.S.T. 768; Fed. R. Civ. P. 28(b); 22 C.F.R. §§ 92.49--92.71.⁴ Respondents are perfectly aware of these procedures -- indeed, they characterize the burdens of these procedures as one of the reasons why the motion to quash should be denied, arguing that they are "not likely to be able to obtain satisfactory discovery" from Sasaki unless he is deposed in the United States or, in respondents' paradoxical phrase, is "required to consent" to his deposition in Japan. (Resp. Br. 13.) It is not clear, however, that the authority granted in Rule 45(c)(3)(A)(ii) to modify a subpoena extends to the kinds of "modifications" that would be required to permit the subpoena to comply with these requirements by functioning as the equivalent of a letter rogatory or a court order authorizing a U.S. consular officer to take the deposition. Even less clear is how this Court would be able to modify the subpoena, as the

respondents [*18] suggest, so as to "require" Sasaki to "consent" to his deposition in Japan.⁵

But even if such authority did exist under Rule 45, prudential, international comity-based considerations counsel that the Court refrain under the circumstances of this case. "American courts, in supervising pretrial proceedings, should exercise special vigilance to protect foreign litigants from the danger that unnecessary, or unduly burdensome, discovery may place them in [*19] a disadvantageous position." Societe Nationale Industrielle Aerospatiale v. U.S. District Court for the Southern District of Iowa, 482 U.S. 522, 546, 96 L. Ed. 2d 461, 107 S. Ct. 2542 (1987); see also In re Chase Manhattan Bank, 297 F.2d 611, 613 (2d Cir. 1962) (modification of subpoena directing production of documents located in Panama is appropriate where compliance would necessitate violation of Panamanian law); Ings v. Ferguson, 282 F.2d 149, 152 (2d Cir. 1960) ("Upon fundamental principles of international comity, our courts dedicated to the enforcement of our laws should not take such action as may cause a violation of the laws of a friendly neighbor or, at the least, an unnecessary circumvention of its procedures."); Laker Airways, Ltd. v. Pan American World Airways, 607 F. Supp. 324, 326 (S.D.N.Y. 1985) (quashing subpoenas seeking depositions of non-party witnesses where service of the subpoenas in New York constitutes "a transparent attempt to circumvent the Hague Convention on the Taking of Evidence Abroad in Civil or Commercial Matters"). The Court in the best position to exercise such supervision is not [*20] this Court, which merely has jurisdiction over the subpoena issued on its behalf, but the district court in North Carolina before which the underlying action itself is pending. This Court may not transfer the instant motion to quash to the North Carolina court, since "only the issuing court has the power to act on its subpoenas." In re Sealed Case, 329 U.S. App. D.C. 374, 141 F.3d 337, 341 (D.C. Cir. 1998) (reversing D.C. district court's transfer of motion to quash subpoena and cross-motion to compel to district court in Arkansas). However, the respondents remain perfectly free to seek from the North Carolina court a letter rogatory or an order authorizing consular officials to preside over the deposition of Sasaki and any other witnesses in Japan whose testimony might be relevant to this action.

If these various considerations counseling against modification of the subpoena might be overcome in some

⁴ Japan is not a party to the Hague Convention on the Taking of Evidence Abroad in Civil or Commercial Matters, *opened for signature* Mar. 18, 1970, 23 U.S.T. 2555, T.I.A.S. No. 7444, 847 U.N.T.S. 231, and accordingly, the "letter of request" procedures under that convention are not available to the respondents.

⁵ Tellingly, while the respondents argue vigorously that the Court has the authority to modify the subpoena served upon Sasaki, they finesse the question of what *particular* modifications the Court should make to that subpoena.

unusual circumstances by a compelling need of a party to obtain discovery, this case presents no such circumstances. As an officer of Aioi, Sasaki has no direct knowledge of the facts at issue between Nissan and Fortress Re in the pending litigation; the testimony he could provide would at [*21] best constitute indirect evidence on the issues in that case. Nor is it clear that Sasaki personally is the best source of information about Fortress Re's contacts with Aioi; neither party to this motion has addressed the potential for serving a Rule 30(b)(6) deposition or other discovery demand on Aioi in North Carolina. As for Fortress Re's dispute with Aioi, that dispute is apparently under arbitration, and the arbitrators will have ample power to determine what discovery is necessary in that matter.

Accordingly, it is not necessary to resolve the various questions raised by this motion concerning the interpretation of Rule 45. *HN4* "When it is necessary to seek evidence abroad," prudential considerations of international comity require the district court "to supervise pretrial proceedings particularly closely to prevent discovery abuses." *Aerospatiale*, 482 U.S. at 546. This Court is ill placed to play that supervisory role, given its limited knowledge of the underlying case. Thus, the motion to quash will be granted without prejudice to an application by the respondents to that court for a letter rogatory or other appropriate order relating to discovery from Aioi or [*22] Sasaki.

II. Motion for Sanctions

HN5 Rule 45(c)(1) of the Federal Rules of Civil Procedure obligates a party or attorney responsible for the issuance and service of a subpoena to "take reasonable steps to avoid imposing undue burden or expense on a person subject to that subpoena," and requires the court on whose behalf the subpoena is issued to "enforce this duty and impose upon the party or attorney in breach of this duty an appropriate sanction, which may include, but is not limited to, lost earnings and a reasonable attorney's fee." Fed. R. Civ. P. 45(c)(1).

Sanctions are not appropriate under the circumstances of this case. Issuance and service of the subpoenas upon the movants was not itself in any way improper, since the respondents had a good faith basis for believing that the

movants' testimony would be relevant to the North Carolina action, and as the above discussion shows, there are legitimate questions concerning the effect of Rule 45(c)(3)(A)(ii) on this case. Moreover, subsequent to the issuance of the subpoenas, respondents and their counsel have negotiated in good faith to make any accommodations necessary with respect to time, location, or both in order to [*23] ease the potential burden that appearance for the deposition would present to the movants. While the movants argue that "an attempt to enforce a subpoena that violates the mandatory provisions of Rule 45(c)(3) is a *per se* violation of the Rule 45(c)(1) duty," Movants Br. 7 (quoting *Matthias Jans & Assocs.*, 2001 U.S. Dist. LEXIS 4841, 2001 WL 1661473, at *3), the Court cannot conclude that at the time the subpoenas were served, the respondents lacked a good faith belief that the subpoenas were properly served. The various questions concerning the proper interpretation of the territorial restrictions set forth in Rule 45(c)(3)(A)(ii) have not yet been addressed by many courts, let alone definitively resolved. It would seem appropriate, therefore, that the difficult "questions about [the rule's] territorial range . . . should have definitive answers from decisional law before attorneys who must guess at the answers start getting sanctioned for guessing wrong." Siegel, *supra*, 139 F.R.D. at 227--28.

Since the respondents have heeded their obligation to "take reasonable steps to avoid imposing undue burden or expense on a person subject to that subpoena," Fed. R. Civ. P. 45(c)(1), the motion [*24] for sanctions will be denied.

CONCLUSION

For the foregoing reasons, the motion to quash the subpoena served upon Sasaki is GRANTED. The motion for sanctions pursuant to Fed. R. Civ. P. 45(c)(1) is DENIED.

SO ORDERED.

Dated: New York, New York

August 13, 2002

GERARD E. LYNCH

United States District Judge

1999 TTAB LEXIS 647

Trademark Trial and Appeal Board

November 18, 1999, Decided

Opposition No. 110,383

Reporter

1999 TTAB LEXIS 647

Sabra Salads Food Industries (1985) Ltd. / Salatey Tzabar (1985) Ltd. v. Blue & White Food Products Corporation

Core Terms

deposition, notice, discovery, adverse party, registration, written question, salad, oral deposition, affirmative defense, oral examination, motion to quash, managing agent, motion to strike, foreign country, ten days, incontestable, ownership, depose

Opinion

[*1]

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

Introduction

An application has been filed by the Blue & White Food Products Corporation to register the mark "SABRA SALADS and cactus design" ("salads" disclaimed) as shown below, on "salads except pasta, macaroni, rice, or fruit salads; sesame or bean-based snack dips":

[SEE ILLUSTRATION IN ORIGINAL]

Registration has been opposed by Sabra Salads Food Industries (1985) Ltd. / Salatey Tzabar (1985) Ltd. As grounds for opposition, opposer has alleged that it has had a registration for the identical mark, "SABRA SALADS and cactus design," in Israel since 1985, and that it merely licensed this mark for use in the United States to Sabra USA (applicant's alleged predecessor in interest), which could therefore not have transferred any ownership rights in the mark to applicant.

In its answers to the notices of opposition, applicant admits that it seeks to register the marks of the involved applications, but otherwise denies the salient allegations of the notices of opposition. Applicant also raises an affirmative defense of estoppel against opposer.

Motions Presently Before The Board [*2]

This case now comes up on two different motions filed by opposer - opposer's motion to strike applicant's affirmative defense, filed on June 26, 1998, and opposer's motion to quash applicant's notice of oral deposition, filed on June 29, 1998. On July 9, 1998, applicant submitted a memorandum in opposition to the motion to strike the affirmative defenses, opposer filed a reply brief on July 29, 1998 and applicant filed a surreply brief on August 20, 1998. On July 24, 1998, applicant submitted a memorandum in opposition to the opposer's motion to quash, and opposer filed a reply brief on July 28, 1998.

Opposer's Motion to Strike

Opposer urges the Board to strike paragraphs 15, 16, and 17 of the applicant's affirmative defenses on the basis that the paragraphs are insufficient, immaterial, and impertinent.

The paragraphs in question read, as follows:

* PARAGRAPH P15:

Applicant filed for registration of the trademark SABRA SALADS in the United States on January 3, 1989, which mark was registered to applicant on December 26, 1989 under registration no. 1,573,621, and Applicant's mark became incontestable in the United States on December 26, 1989.

* [*3] PARAGRAPH P16:

Applicant filed the mark SABRA SALADS in the United States in its new name and obtained the registration therefor with the knowledge and acquiescence of Alfons Janco, President and 70% owner of Opposer's predecessor.

* PARAGRAPH P17:

As proved by the actual registration, actual knowledge of the registration, constructive knowledge of the registration, and reliance on the registration in a lawsuit brought by Applicant, then jointly owned by Alfons Janco and Zohar Norman, entitled *Sabra Food Products Corp., d/b/a Sabra Salads and Sabra Foods v. Galilee Cheese Corp., a/k/a Infood/Galilee and Tnuva Central Co-Op for the Marketing of Agricultural Produce in Israel Ltd.*, 90 Civ. 4308 (RR), and including the allegation that "Sabra is the owner of a trademark which includes the designation "Sabra Salads" and "Sabra Foods"" (Complaint, paragraph 25), Opposer is estopped to deny Applicant's ownership. (emphasis in original).

Fed.R.Civ.P. 12(f) provides, in relevant part, for striking from a pleading any redundant, immaterial, impertinent or scandalous matter. However, motions to strike are generally disfavored. Hence, matter will not be stricken [*4] unless it clearly has no bearing upon the issues under litigation. See *FRA S.p.A. v. Surg-O-Flex of America, Inc.*, 194 USPQ 42, 46 (S.D.N.Y. 1976); *Leon Shaffer Golnick Advertising, Inc. v. William G. Pendil Marketing Co., Inc.*, 177 USPQ 401, 402 (TTAB 1977); and cases cited therein.

Opposer argues that because Reg. No. 1,573,621 was cancelled in 1996 under Sec. 8 of The Trademark Act, these three paragraphs should be struck under Fed.R.Civ.P. 12(f).

Regarding paragraph 15, applicant agrees that the last clause of that defense: "(,) and Applicant's mark became incontestable in the United States on December 26, 1989" is inaccurate, and could well be stricken. However, opposer argues that because applicant knew this registration had been cancelled, the incontestability claim was a "ruse" justifying this Board's striking, at a minimum, the entire paragraph, if not all three paragraphs.

We find that the allegations of these three paragraphs, when taken together, comprise applicant's defense of estoppel against opposer. The fact that this registration had existed at some point in the past with alleged partial ownership [*5] by one of opposer's principals could well have some possible relationship to, or consequences for, the instant controversy. It could well be relevant to the adverse parties' claims of ownership, intent, and state of mind. Nevertheless, that portion of P15 of applicant's answer/affirmative defense claiming that a federal trademark registration that had actually been cancelled under § 8 had instead achieved the status of incontestability is clearly objectionable, and that clause must be stricken. 2A Moore's Federal Practice P12.21[1].

On the other hand, the allegations which opposer seeks to have stricken bear directly on the use of the mark by the applicant and on opposer's claims of ownership of this mark in the United States. The allegations are not prejudicial to opposer, and in fact give opposer a more complete notice of applicant's claims. See *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988). Since the parties' arguments on this motion demonstrate that these critical facts are in dispute, striking

all three paragraphs under Rule 12(f) would be an abuse of discretion. For example, one can certainly anticipate a set of circumstances [*6] wherein this affirmative defense could succeed - although we need make no such determination in deciding this contested motion. See *Lunsford v. United States*, 418 F.Supp. 1045 (D.S.D. 1976), aff'd 570 F.2d 221 (8th Cir. 1977).

Decision: The last clause of P15 is hereby stricken: "(,) and Applicant's mark became incontestable in the United States on December 26, 1989." Otherwise, opposer's motion to strike is denied.

Opposer's Motion to Quash Applicant's Notice of Oral Deposition

On June 29, 1998, opposer filed a motion to quash applicant's notice of oral depositions in New York City. Opposer is an Israeli corporation located in Israel. It alleges that none of its directors, officers, managing agents or anyone else associated with the company is located in the United States. Opposer argues that under the rules governing opposition proceedings, oral depositions may only be taken of a natural person residing in a foreign country by stipulation of the parties or by order of the Board, upon good cause shown. See, The Trademark Rules of Practice, § 2.120(c) [37 C.F.R. § 2.120(c)].¹ Opposer points out [*7] that there is no provision in The Trademark Rules of Practice which allows for the taking of an oral deposition of a foreign party on notice as applicant's counsel has attempted here.

[*8]

Applicant opposed opposer's motion to quash applicant's notice of deposition. Specifically, applicant requests an order denying opposer's motion, enforcing applicant's outstanding deposition notice and compelling opposer to appear for an oral deposition.

Applicant argues that because opposer commenced this proceeding in the United States, opposer selected the forum and should now be required to deal with the consequences and burdens of its selection. Applicant contends that by refusing to appear for an oral deposition, opposer is effectively arguing that it should be allowed to depose applicant but that applicant should not be afforded the same opportunity for meaningful discovery. Such a result, applicant argues, would be fundamentally unjust and improper.

Applicant contends that having selected this forum, opposer cannot take advantage of the rules of this forum, including an oral deposition of applicant, and then refusing to allow applicant equally effective discovery methods. Applicant cites to

¹ § 2.120 Discovery . . .

(c) Discovery deposition in foreign countries.

(1) The discovery deposition of a natural person residing in a foreign country who is a party or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Rule 30(b) (6) or Rule 31(a) of the Federal Rules of Civil Procedure, shall, if taken in a foreign country be taken in the manner prescribed by § 2.124 unless the Trademark Trial and Appeal Board, upon motion for good cause, orders or the parties stipulate, that the deposition be taken by oral examination.

(2) Whenever a foreign party is or will be, during a time set for discovery, present within the United States or any territory which is under the control and jurisdiction of the United States, such party may be deposed by oral examination upon notice by the party seeking discovery. Whenever a foreign party has or will have, during a time set for discovery, an officer, director, managing agent, or other person who consents to testify on its behalf, present within the United States or any territory which is under the control and jurisdiction of the United States, such officer, director, managing agent, or other person who consents to testify in its behalf may be deposed by oral examination upon notice by the party seeking discovery. The party seeking discovery may have one or more officers, directors, managing agents, or other persons who consent to testify on behalf of the adverse party, designated under Rule 30(b) (6) of the Federal Rules of Civil Procedure. The deposition of a person under this paragraph shall be taken in the Federal judicial district where the witness resides or is regularly employed, or, if the witness neither resides nor is regularly employed in a Federal judicial district, where the witness is at the time of the deposition. This paragraph does not preclude the taking of a discovery deposition of a foreign party by any other procedure provided by paragraph (c) (1) of this section.

a truism contained in a published article by the most senior judge of the Board: "Those who are familiar with the procedure for taking depositions upon written questions are aware, [*9] however, that this procedure is cumbersome and often yields unsatisfactory results . . ." Simms, "Compelling the Attendance of a Witness in Proceedings Before the Board," 75 TMR 296, 298 (1985).

Further, applicant argues that usually when federal district courts have addressed this issue under the Federal Rules of Civil Procedure, most hold that the plaintiff cannot select a forum and then refuse to attend a deposition because of the alleged burden of traveling to that forum. See Seathe v. Renwal Prods., 38 F.R.D. 323 (S.D.N.Y. 1965); Rifkin v. United States Lines, 177 F.Supp. 875 (S.D.N.Y. 1959); Schulz v. Koninklijke Luehtvaart Maatschappij N.V., 21 F.R.D. 20 (E.D.N.Y. 1957); but see Hyam v. American Export Lines, Inc., 213 F.2d 221 (2d Cir. 1954) (court will quash notice of deposition upon a showing of substantial undue financial and or physical hardship). Applicant argues that, similarly, it cannot be the intent of the TTAB to allow a foreign company to oppose the issuance of a United States trademark, while simultaneously depriving the applicant of equal discovery opportunities. [*10]

In its reply brief, opposer argues that Rule 2.120(c) is most clear on its face: a discovery deposition "shall, if taken in a foreign country, be taken in the manner prescribed by § 2.124 unless the TTAB, upon motion for good cause, orders or the parties stipulate, that the deposition be taken by oral examination." Opposer argues that Section 2.124 of the Rules set out the appropriate procedures for applicant to follow in proceeding with "depositions upon written questions."

Applicant has not moved for an order from the Board that the deposition of an officer of opposer be taken by oral examination, nor has it provided any "good cause" in its opposition to the Motion to Quash. The record shows that opposer has certainly not stipulated to a deposition by oral examination. Finally, there is no indication in the file that any of opposer's officers, directors or managing agents, or other persons who might consent to be deposed on a opposer's behalf, would possibly be present in the United States or any territory which is under the jurisdiction of the United States during the discovery period.

For all the foregoing reasons, and for those outlined in opposer's motion, opposer's motion [*11] to quash is hereby granted, applicant's outstanding Notice of Deposition is quashed, and applicant's discovery should proceed according to Section 2.124 of the Rules, "Depositions upon written questions."²

² § 2.124 Depositions upon written questions.

(a) A deposition upon written questions may be taken before any person before whom depositions may be taken as provided by Rule 28 of the Federal Rules of Civil Procedure.

(b) (1) A party desiring to take a testimonial deposition upon written questions shall serve notice thereof upon each adverse party within ten days from the opening date of the testimony period of the party who serves the notice. The notice shall state the name and address of the witness. A copy of the notice, but not copies of the questions, shall be filed with the Trademark Trial and Appeal Board.

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

(c) Every notice given under the provisions of paragraph (b) of this section shall be accompanied by the name or descriptive title of the officer before whom the deposition is to be taken.

(d) (1) Every notice served on any adverse party under the provisions of paragraph (b) of this section shall be accompanied by the written questions to be propounded on behalf of the party who proposes to take the deposition. Within twenty days from the date of service of the notice, any adverse party may serve cross questions upon the party who proposes to take the deposition; any party who serves cross questions shall also serve every other adverse party. Within ten days from the date of service of the cross questions, the party who proposes to take the deposition may serve redirect questions on every adverse party. Within ten days from the date of service of the redirect questions, any party who served cross questions may

[*12]

Proceedings are considered to have been suspended during the pendency of these motions. Proceedings are herein resumed.

The trial dates, including the close of discovery, are reset as follows:

| | |
|------------------------------------------------------------------------------------------------------|-------------------|
| THE PERIOD FOR DISCOVERY TO CLOSE: | May 16, 2000 |
| Testimony period for party in position of plaintiff to close: (opening thirty days prior thereto) | August 14, 2000 |
| Testimony period for party in position of defendant to close: (opening thirty days prior thereto) | October 13, 2000 |
| Rebuttal testimony period to close (opening fifteen days prior thereto) | November 27, 2000 |

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b).

An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

D. E. Bucher

Administrative Trademark Judge, Trademark Trial and Appeal Board

serve recross questions upon the party who proposes to take the deposition; any party who serves recross questions shall also serve every other adverse party. Written objections to questions may be served on a party propounding questions; any party who objects shall serve a copy of the objections on every other adverse party. In response to objections, substitute questions may be served on the objecting party within ten days of the date of service of the objections; substitute questions shall be served on every other adverse party.

(2) Upon motion for good cause by any party, or upon its own initiative, the Trademark Trial and Appeal Board may extend any of the time periods provided by paragraph (d) (1) of this section. Upon receipt of written notice that one or more testimonial depositions are to be taken upon written questions, the Trademark Trial and Appeal Board shall suspend or reschedule other proceedings in the matter to allow for the orderly completion of the depositions upon written questions.

(e) Within ten days after the last date when questions, objections, or substitute questions may be served, the party who proposes to take the deposition shall mail a copy of the notice and copies of all the questions to the officer designated in the notice; a copy of the notice and of all the questions mailed to the officer shall be served on every adverse party. The officer designated in the notice shall take the testimony of the witness in response to the questions and shall record each answer immediately after the corresponding question. The officer shall then certify the transcript and mail the transcript and exhibits to the party who took the deposition.

(f) The party who took the deposition shall promptly serve a copy of the transcript, copies of documentary exhibits, and duplicates or photographs of physical exhibits on every adverse party. It is the responsibility of the party who takes the deposition to assure that the transcript is correct (see § 2.125(b)). If the deposition is a discovery deposition, it may be made of record as provided by § 2.120(j). If the deposition is a testimonial deposition, the original, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, shall be filed promptly with the Trademark Trial and Appeal Board.

(g) Objections to questions and answers in depositions upon written questions may be considered at final hearing.

[48 FR 23139, May 23, 1983]

Graphic:

Picture 1, no caption

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

In re Application Serial No. 86/004,044
Filed: July 8, 2013
For Mark: TOMS
Published in the Official Gazette: April 29, 2014

In re Registration Nos. 4,097,948; 4,192,925; 4,313,981; 4,410,344
Registered: February 14 ,2012; August 21, 2012; April 2, 2013; October 1, 2013
For Mark: TOMS

| | | |
|----------------|---|-------------------------|
| TOD'S S.P.A., | : | |
| | : | |
| Opposer, | : | |
| v. | : | Opposition No. 91218001 |
| MYCOSKIE, LLC, | : | |
| | : | |
| Applicant. | : | |

| | | |
|----------------|---|---------------------------|
| TOD'S S.P.A., | : | |
| | : | |
| Petitioner, | : | |
| v. | : | |
| MYCOSKIE, LLC, | : | Cancellation No. 92061234 |
| | : | |
| Respondent. | : | |

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**DECLARATION OF STEFANO SINCINI IN
OPPOSITION TO MYCOSKIE'S CROSS-MOTION TO COMPEL**

STEFANO SINCINI, pursuant to 28 U.S.C. §1746, declares:

1. I am Co-Chief Executive Officer, Executive Director and General Manager of Opposer/Petitioner Tod's S.p.A.
2. I am a resident of Civitanova Marche, Italy.

3. I am not regularly employed in New York or anywhere else in the United States. I have not even been to the United States since October 2013.

4. During the past five year period, I have been to the United States only three times. I was in the United States between August 6 and August 12 in 2011 (the first three of those days in New York); November 7-10 in 2012 (all of those days in New York); and October 26-31 in 2013 (the first four of those days in New York). I did not travel to the United States at all in either 2014 or 2015.

5. Although I am the Chairman of the Board of Directors of Deva Inc., my duties do not regularly require my presence in New York. The last Board meeting of Deva that I personally attended was during August 2011. Since that time, Board meetings have been conducted either by written resolution or teleconference without my physical presence in New York.

6. I do not presently have any plans set to travel to the United States during 2016.

I DECLARE UNDER PENALTY OF PERJURY UNDER THE LAWS OF THE UNITED STATES THAT THE FOREGOING IS TRUE AND CORRECT. EXECUTED ON JANUARY 28 2016 AT SANT'ELPIDIO A MARE, ITALY.


STEFANO SINCINI

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

In re Application Serial No. 86/004,044
Filed: July 8, 2013
For Mark: TOMS
Published in the Official Gazette: April 29, 2014

In re Registration Nos. 4,097,948; 4,192,925; 4,313,981; 4,410,344
Registered: February 14, 2012; August 21, 2012; April 2, 2013; October 1, 2013
For Mark: TOMS

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| ----- | X | |
| TOD'S S.P.A., | : | |
| | : | |
| Opposer, | : | |
| v. | : | Opposition No. 91218001 |
| MYCOSKIE, LLC, | : | |
| | : | |
| Applicant. | : | |
| ----- | | |

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|----------------|---|---------------------------|
| TOD'S S.P.A., | : | |
| | : | |
| Petitioner, | : | |
| v. | : | |
| MYCOSKIE, LLC, | : | Cancellation No. 92061234 |
| | : | |
| Respondent. | : | |

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**DECLARATION OF RICHARD S. MANDEL IN OPPOSITION
TO APPLICANT/RESPONDENT'S CROSS-MOTION TO COMPEL**

RICHARD S. MANDEL, pursuant to 28 U.S.C. §1746, declares:

1. I am a shareholder of Cowan, Liebowitz & Latman, P.C., attorneys for Opposer/Petitioner Tod's S.p.A ("Tod's"). I submit this declaration in opposition to the cross-

motion of Applicant/Respondent Mycoskie, LLC (“Mycoskie”) to compel an oral deposition of Stefano Sincini.

2. On July 2, 2015, Mycoskie served a 30(b)(6) deposition notice of Tod’s. The deposition was noticed to take place on September 16, 2015 in New York. The notice contained 29 different topics, including many concerning Tod’s’ management and enforcement of its trademarks. A true and accurate copy of the deposition notice is attached hereto as Exhibit A.

3. On July 23, 2015, I sent an email to Mycoskie’s counsel, Louis Ederer, in which I explained that we did not believe it was proper under the rules to notice the deposition of Tod’s, an Italian company, in New York, and that any such deposition should proceed by way of written questions. A true and accurate copy of my July 23, 2015 email is attached hereto as Exhibit B.

4. On August 6, 2015, Mr. Ederer and I had a telephone conversation in which we further discussed the subject of depositions. During that call, I agreed to look into whether any Tod’s’ witnesses located in the United States would be appropriate corporate representative witnesses for Tod’s with respect to any of the topics included in Mycoskie’s 30(b)(6) notice. Mr. Ederer confirmed the substance of our conversation in an email later that same day. A true and accurate copy of Mr. Ederer’s August 6, 2015 email is attached hereto as Exhibit C.

5. On August 31, 2015, I advised Mr. Ederer by email that Claudio Castiglioni, a Tod’s employee who has a dual residency in Italy and Florida, would be able to testify as a 30(b)(6) witness for Tod’s with respect to topics 1, 4-6 and 8-18 of Mycoskie’s 30(b)(6) notice. We had previously agreed to produce Mr. Castiglioni for his individual deposition in New York during the week of October 5, 2015. I also advised Mr. Ederer in my email that the 30(b)(6) witness for the remaining fourteen topics (dealing generally with Tod’s’ trademarks and its

enforcement efforts) would need to be an individual from Italy. A true and correct copy of my August 31, 2015 email is attached hereto as Exhibit D.

6. On September 11, 2015, Tod's served responses to Mycoskie's second set of interrogatories (copies of which were attached to Mr. Ederer's declaration on this motion as Exhibit 3). In response to interrogatory no. 15 asking for the identity of the "person(s) who decided to file and/or approved the filing of the Notice of Opposition," Tod's identified Stefano Sincini as the sole individual responsible for such decision. Numerous other responses identified Andrea Varsavia, a Tod's attorney in Italy, as a witness with knowledge regarding various trademark related matters.

7. On October 1, 2015, Mr. Ederer sent me an email in which he requested that Tod's identify its 30(b)(6) witness with respect to the remaining topics for which Mr. Castiglioni was not designated, regardless of the place of residence for any such designated witness. I responded by email later that same day identifying Andrea Varsavia with respect to such topics (2-3, 7 and 19-29 of Mycoskie's notice). I reiterated in my email that since Mr. Varsavia was located in Italy, it was Tod's' position that any deposition of him would have to take place by way of written questions. True and accurate copies of my October 1, 2015 email exchange with Mr. Ederer are attached hereto as Exhibit E.

8. On October 9, 2015, Mycoskie conducted the deposition in New York of Claudio Castiglioni in both his individual capacity and as the designated 30(b)(6) witness for Tod's with respect to the 15 topics previously identified in my August 31, 2015 email. At that deposition, there was extensive testimony about Mr. Sincini and his role and responsibilities with respect to trademarks. The index to the transcript from that deposition shows that references to Mr. Sincini's name appear on 35 separate pages of the transcript. True and accurate copies of those

excerpts in which Mr. Sincini is referenced, along with a true and accurate copy of the index page showing the references to his name, are attached hereto as Exhibit F.

9. Subsequent to the completion of Mr. Castiglioni's deposition, Mr. Ederer eventually advised me that Mycoskie did not intend to pursue a 30(b)(6) deposition by written questions of Tod's with respect to the remaining deposition topics not covered by Mr. Castiglioni's designations.

10. Although Mycoskie was clearly aware through both prior interrogatory responses and the deposition testimony of Claudio Castiglioni that both Mr. Sincini and Mr. Varsavia had relevant knowledge concerning the various trademark topics included in Mycoskie's 30(b)(6) deposition notice, Tod's erred on the side of caution by serving supplemental initial disclosures on December 10, 2015 (exhibit 23 to Mr. Ederer's declaration) identifying both Mr. Sincini and Mr. Varsavia as additional individuals with relevant knowledge.

11. On December 14, 2015, I received an email from Mr. Ederer (exhibit 28 to Mr. Ederer's declaration) in which he served a notice to take Mr. Sincini's deposition in New York on January 13, 2016. A copy of the deposition notice is attached hereto as Exhibit G. Mr. Ederer's email demanded that Mr. Sincini be produced for a deposition in New York within the next 30 days as a condition for Mycoskie's consent to an amendment of its pleadings that I had sought on December 10 (and that is the subject of a separate pending motion to amend).

12. On December 15, 2015, I sent an email in response (exhibit 29 to Mr. Ederer's declaration) to Mr. Ederer's email from the preceding day. I indicated that Mr. Sincini did not reside in the United States and had no plans to travel to the United States within the next 30 days. Accordingly, any deposition of Mr. Sincini would have to proceed by deposition on written questions. I indicated that I had assumed Mycoskie would not be interested in such a deposition

in light of its prior decision not to proceed with Mr. Varsavia's deposition by written questions, but that if it wanted to take Mr. Sincini's deposition by written questions, we would agree to extend the discovery period for that purpose.

13. On December 16, 2015, Mr. Ederer sent an email response (exhibit 31 to Mr. Ederer's declaration) to my December 15, 2015 email. Mr. Ederer reiterated his demand that Tod's produce Mr. Sincini for a deposition in New York. The above-referenced email communications (exhibits 28, 29 and 31 to Mr. Ederer's declaration) are the only communications between the parties concerning the subject of Mr. Sincini's deposition. At no time during the process of meeting and conferring on Mycoskie's request to take Mr. Sincini's deposition did Mr. Ederer ever raise the suggestions contained in Mycoskie's cross-motion regarding the possible taking of Mr. Sincini's deposition to coincide with any scheduled travel to the United States or the taking of such deposition in Italy with Mycoskie bearing the travel and accommodation costs of Tod's' counsel.

I DECLARE UNDER PENALTY OF PERJURY THAT THE FOREGOING IS TRUE AND CORRECT. EXECUTED ON FEBRUARY 1, 2016 AT NEW YORK, NEW YORK.


RICHARD S. MANDEL

EXHIBIT A

Dated: July 2, 2015

ARNOLD & PORTER LLP

By: Louis S. Ederer

Louis S. Ederer

Matthew T. Salzmann

399 Park Avenue

New York, New York 10022

Tel: 212.715.1000

Fax: 212.715.1399

*Attorneys for Applicant/Respondent
Mycoskie, LLC*

EXHIBIT A

DEFINITIONS

As used herein, the terms below shall have the following meanings:

1. "Tod's," "You," or "Your" shall refer to Opposer/Petitioner Tod's S.p.A., including any subsidiaries, parents, affiliates, divisions, agents, servants, employees, representatives, officers, directors, accountants, attorneys, persons or entities under Tod's S.p.A.'s control, or acting or purporting to act on behalf of Tod's S.p.A..
2. "TOMS" shall refer to Applicant/Petitioner Mycoskie, LLC, and any of its subsidiaries, parents, affiliates, divisions, licensors, licensees, agents, servants, employees, representatives, officers, directors, accountants, attorneys, and investigators, and any other persons or entities under Mycoskie, LLC's control, or acting or purporting to act on behalf of Mycoskie, LLC.
3. "Application" shall mean the U.S. Trademark Application Serial No. 86/004,044 to register the mark TOMS in International Class 18, filed by TOMS on July 8, 2013.
4. "Notice of Opposition" shall mean the Notice of Opposition filed by Tod's before the Trademark Trial and Appeal Board of the United States Patent and Trademark Office on August 25, 2014 against TOMS and the Application.
5. "Petition for Cancellation" shall mean the Petition for Cancellation filed by Tod's before the Trademark Trial and Appeal Board of the United States Patent and Trademark Office on April 8, 2015 against TOMS and U.S. Trademark Registration Nos. 4,097,948; 4,192,925; 4,313,981; and 4,410,344.
6. "TOMS Marks" shall refer to the marks that are the subject of U.S. Trademark Application Serial No. 77/219184, filed by TOMS on July 8, 2013; and U.S. Trademark Registration Nos. 4,097,948; 4,192,925; 4,313,981; and 4,410,344, registered on February 14, 2012; August 21, 2012; April 2, 2013; and October 1, 2013, respectively.

7. "TOMS Incontestable Registrations" shall refer, collectively, to United States Trademark Registration Nos. 3,353,902; 3,566,093; and 3,662,112.

8. "TOD'S Mark" shall have the meaning attributed to the term in Paragraph 3 of the Notice of Opposition and/or Paragraph 3 of the Petition for Cancellation.

9. "Concerning" shall mean directly or indirectly, in whole or in part, referring to, relating to, connected with, commenting on, discussing, impacting upon, affecting, responding to, explaining, showing, indicating, describing, analyzing, reflecting or constituting.

10. "Document" shall include, without limitation, all written or graphic matter or any other means of preserving thought or expression of every type and description regardless of origin or location, whether written, recorded, transcribed, taped, punched, filmed, microfilmed, or in any other way produced, reproduced or recorded, and including, but not limited to: originals, drafts, computer-sorted and computer-retrievable information, copies or duplicates that are marked with any notation or annotation, copies or duplicates that differ in any way from the original, correspondence, memoranda, reports, notes, minutes, contracts, agreements, books, records, checks, vouchers, invoices, purchase orders, ledgers, diaries, logs, calendar notes, computer printouts, computer disks, card files, lists of persons attending meetings or conferences, sketches, diagrams, calculations, evaluations, analyses, directions, work papers, press clippings, sworn or unsworn statements of employees, requisitions, manuals or guidelines, audit work papers, financial analyses, tables of organizations, charts, graphs, indices, advertisements or other promotional materials, audited and unaudited financial statements, trade letters, trade publications, newspapers or newsletters, diagrams, photographs, e-mail, electronic or mechanical records, telegrams, telecopies, audiotapes, and all other receptacles or repositories housing or containing such documents, and all other media used to record, in any form, information. A draft, annotated or otherwise non-identical copy is a separate document within

the meaning of this term. "Document" shall also include any removable "Post-It" notes or other attachments affixed to any of the foregoing, as well as the file, folder tabs, and labels appended to or containing any documents. "Document" expressly includes all Electronic Data stored on any Electronic Media.

11. "Communicate" or "Communication" shall mean and include every manner or means of disclosure, transfer, or exchange, and every disclosure, transfer, or exchange of information, whether orally or by Document, or whether face-to-face, by telephone, telecopier, mail, written correspondence, facsimile, personal delivery, electronic or computer transmission, overnight delivery or otherwise.

12. "Market Research" shall mean any type of research, study survey, or analysis of consumers or potential consumers of a product or potential product, including, but not limited to, polls, focus groups, consumer surveys, market analyses, behavioral analyses, and consumer research, whether or not such investigations were completed, discontinued, or fully carried out. As used herein, "Market Research" also includes all research materials sufficient to show the complete results and methods of the research, including, but not limited to, summary reports, screening questionnaires, coding materials, and verbatim responses of survey subjects.

13. "Person" shall mean any natural person, corporation, partnership, company, joint venture, trust, agency, governmental agency or department, and any other business, governmental, legal, for-profit or nonprofit organization, association or entity.

14. All topics are to be read so as to give it the broadest possible meaning, so that, for example, when either of the terms "and" or "or" is used, it is to be construed as "and/or". Similarly, use of the singular also includes the plural, use of any female pronouns also includes the male, and so forth.

TOPICS OF TESTIMONY

1. The creation, development, selection, and/or adoption of the TOD'S Mark.
2. Your decision to register and/or apply to register the TOD'S Mark as a trademark.

3. Your decision not to register the TOD'S Mark as a word mark, namely, without the addition of "other words and/or design elements" as referenced in Paragraph 4 of the Petition for Cancellation.

4. The imagery, logos and designs You use or have used in immediate conjunction with the term "Tod's" or the TOD'S Mark.

5. The creation, development, selection, and/or adoption of any imagery, logos, or designs You use or have used in immediate conjunction with the term "Tod's" or the TOD'S Mark.

6. The fame, strength, and/or consumer recognition of the TOD'S Mark.

7. The date of and the circumstances Concerning Your first awareness of TOMS and/or any TOMS Mark(s).

8. The products and/or services that were in the past, are currently, or will be offered, sold, distributed, and/or marketed by You and/or Your licensee(s) or affiliate(s) under the TOD'S Mark, including, but not limited to, the following product and service categories: (a) footwear; (b) goods made of leather or imitations of leather, including, but not limited to, any goods enumerated in Paragraph 5 of the Notice of Opposition; (c) clothing and/or garments for infants and/or babies; (d) eyewear; (e) on-line retail store services; and (f) retail store services.

9. Your use of advertising, promotional and/or marketing materials depicting or Concerning any products bearing the TOD'S Mark, or any mark containing the "Tod's" name.

10. Media reports, articles, or other references Concerning the TOD'S Mark, Tod's products, and/or the Tod's brand.

11. The target demographic for the distribution and/or sale of any products bearing and/or services offered under the TOD'S Mark, including such factors as age, gender, financial income, and geographic location.

12. The geographic distribution and/or sale of products bearing and/or services offered under the TOD'S Mark, or any mark containing the "Tod's" name.

13. The retail outlets located in the United States that sell and/or offer for sale products bearing and/or services offered under the TOD'S Mark.
14. Market Research, brand recognition studies or similar research conducted by or on behalf of You or any Person regarding public perception of the Tod's brand, the TOD'S Mark, or any mark containing the "Tod's" name.
15. Demographic or consumer studies regarding actual or potential consumers of products bearing and/or services offered for sale under the TOD'S Mark in the United States.
16. The channels of trade through which products offered for sale under the TOD'S Mark have been, are presently, or will be offered for sale in the United States.
17. Your projections, forecasts or business plans relating to products bearing and/or services being offered for sale or sold under the TOD'S Mark in the United States.
18. Your gross revenue from the distribution and/or sale of any products bearing and/or services offered under the TOD'S Mark, including, but not limited to, the breakdown of such revenue, both in the United States and internationally, according to the following product and service categories: (a) footwear; (b) goods made of leather or imitations of leather, including, but not limited to, any goods enumerated in Paragraph 5 of the Notice of Opposition; (c) clothing and/or garments for infants and/or babies; (d) eyewear; (e) on-line retail store services; and (f) retail store services.
19. Any instance(s) of confusion between products and/or services bearing the TOD'S Mark, on the one hand, and products and/or services bearing the TOMS Mark, on the other hand.
20. Your method of identifying possible infringements of, or otherwise monitoring the strength of, the TOD'S Mark, including the identity of any watch service or Person with whom You have contracted to perform such services, or any of Your employees responsible for performing such activities.

21. Documents and Communications reviewed by any Person, including any Person employed by You, who is responsible for identifying possible infringements, or otherwise monitoring the strength of, the TOD'S Mark

22. The process by which You decide whether to file an opposition and/or cancellation proceeding, including the identities of any Person involved in such process.

23. The process by which You decide whether to file a lawsuit alleging infringement(s) of the TOD'S Mark, including the identities of any Person involved in such process.

24. Your decision to oppose the registration of U.S. Trademark Application Serial No. 86/004,044, including the identities of any Person involved in such decision.

25. Your decision to file the Petition for Cancellation in opposition to United States Registration Nos. 4,097,948; 4,192,925; 4,313,981; and 4,410,344, including the identities of any Person involved in such decision.

26. Your decision not to oppose and/or seek to cancel the registration of any TOMS Mark(s) prior to August 27, 2014, including the identities of any Person involved in such decision.

27. Your decision not to oppose and/or seek to cancel the registration of Registration Nos. 4,097,948; 4,192,925; 4,313,981; and 4,410,344, prior to April 8, 2015, including the identities of any Person involved in such decision.

28. Your decision not to oppose and/or seek to cancel the registration(s) of the TOMS Incontestable Registrations, including the identities of any Person involved in such decision.

29. The facts, allegations, and/or denials set forth in Your Notice of Opposition and Petition for Cancellation.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing
APPLICANT/RESPONDENT'S NOTICE OF DEPOSITION OF
OPPOSER/PETITIONER TOD'S S.P.A. was served upon the following attorneys of record
for Opposer/Petitioner Tod's S.p.A. by U.S. Mail, this 2nd day of July, 2015:

Richard S. Mandel, Esq.
Lindsay M. Rodman, Esq.
COWAN, LIEBOWITZ & LATMAN, P.C.
1133 Avenue of the Americas
New York, NY 10036-6799

Attorneys for Opposer/Petitioner Tod's S.p.A.

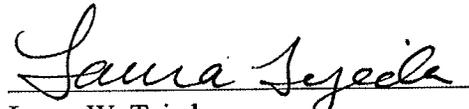

Laura W. Tejada

EXHIBIT B

Mandel, Richard

From: Mandel, Richard
Sent: Thursday, July 23, 2015 11:46 AM
To: 'Ederer, Louis S.'
Cc: Emert, Aryn M.
Subject: Tod's v. Toms

Lou,

I am writing to you with respect to your recently served discovery requests and deposition notices. With respect to the discovery requests, we are going to need some additional time to respond. Because Tod's is effectively closed down for several weeks during August, we would ask that you extend our time until September 11 (a little over 30 days) to respond to the interrogatories and document requests. Let us know if that is acceptable.

With respect to depositions, Ms. Rothfeld is available on the September 17 date you have noticed and we can proceed at that time. However, if you would rather reschedule to a later date based on our requested extension of time to answer your discovery requests, we would of course be willing to do so. Let us know your preference in this respect and if necessary, we can look for alternative available dates.

Although Mr. Castiglioni does not reside in New York, he has a dual US residency in Florida (along with his Italian residence), and accordingly we are prepared to produce him in the U.S. for a deposition. For everyone's convenience, we will make him available in New York. He would be available for a deposition the week of October 5. Let us know if there are any dates that week that would be convenient for you. My preference would be to avoid the Monday, Oct. 5 if possible.

Finally, with respect to Ms. Pinotti and the 30(b)(6) deposition of Tod's, we do not believe that it is proper under the rules to notice them for oral depositions in New York. Rather, because Ms. Pinotti and Tod's reside in Italy, any such depositions should be taken by written questions. See TBMP 404.03(b). Please advise whether you wish to proceed in such fashion, or whether the depositions of Ms. Rothfeld and Mr. Castiglioni will be sufficient for your purposes.

If you wish to discuss any of these issues further, please feel free to call me.

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EXHIBIT C

Mandel, Richard

From: Ederer, Louis S. <Louis.Ederer@APORTER.COM>
Sent: Thursday, August 06, 2015 5:10 PM
To: Mandel, Richard
Cc: Emert, Aryn M.; Salzmann, Matthew T.; Wolverton, Benjamin
Subject: RE: Tod's v. Toms

Richard:

Thank you for taking the time to speak with me today. I am writing to confirm the following discussion points.

First, while we do not concede that Tod's S.p.A. ("Tod's") cannot be noticed for a 30(b)(6) deposition, or that its corporate representative witnesses need not be produced for oral deposition in the US, as a starting point we have asked whether you can advise us if there are any potential witnesses residing in the US, including, for example, Mr. Castiglioni and Ms. Rothfeld, who can be designated for certain of the topics in the notice, particularly those which concern Tod's US activities, and then we can determine how to deal with any 30(b)(6) topics for which you might be inclined to designate an Italian resident. We appreciate your willingness to look into this further.

Further, we renew our request that Tod's make available Sylvia Pinotti for oral deposition, which we are willing to conduct remotely via telephone or video conference. Although we understand that Tod's has yet to determine whether Ms. Pinotti will actually testify as a witness in this proceeding, to the extent she will, we believe we should have an opportunity to depose her, particularly since Ms. Pinotti appears to be the only individual listed by Tod's as being knowledgeable about claims of actual consumer confusion. In any case, and as a matter of courtesy, we ask you to consider this request, and appreciate your willingness to at least address this issue with your client.

Finally, we preliminarily confirm that we are available to conduct depositions of Mr. Castiglioni and Ms. Rothfeld on consecutive days during the week of October 5 (not including October 5 itself, as you requested), subject to confirmation from both Ms. Rothfeld and our client as to their availability. We will contact you when we receive such confirmation.

Please do not hesitate to contact me if you would like to discuss any of the foregoing.

Regards,

Louis S. Ederer
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New York, NY 10022-4690

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From: Ederer, Louis S.
Sent: Wednesday, August 05, 2015 5:34 PM
To: 'Mandel, Richard'
Cc: Emert, Aryn M.; Salzmann, Matthew T.; Wolverton, Benjamin
Subject: RE: Tod's v. Toms

Richard:

I will call you tomorrow.

Regards,

Louis S. Ederer
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New York, NY 10022-4690

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Fax: +1 212.715.1399
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From: Mandel, Richard [mailto:RSM@cll.com]
Sent: Wednesday, August 05, 2015 12:05 PM
To: Ederer, Louis S.
Cc: Emert, Aryn M.; Salzmann, Matthew T.; Wolverton, Benjamin
Subject: RE: Tod's v. Toms

Hi, Lou. Did you finish your trial? Wanted to check in to talk about how to proceed regarding depositions when you have a chance.

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From: Ederer, Louis S. [mailto:Louis.Ederer@APORTER.COM]
Sent: Sunday, July 26, 2015 12:44 PM
To: Mandel, Richard
Cc: Emert, Aryn M.; Salzmann, Matthew T.; Wolverton, Benjamin
Subject: RE: Tod's v. Toms

Richard, that should be OK. The rest will have to wait.

Thanks,

Louis S. Ederer
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From: Mandel, Richard [<mailto:RSM@cjl.com>]
Sent: Sunday, July 26, 2015 11:00 AM
To: Ederer, Louis S.
Cc: Emert, Aryn M.; Salzmann, Matthew T.; Wolverson, Benjamin
Subject: RE: Tod's v. Toms

Thanks, Lou. If it's possible to have someone get back to me at least on the extension for discovery responses, I would appreciate it since we're closing in on that deadline. But if it has to wait also until after your trial, then we can discuss then.

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From: Ederer, Louis S. [<mailto:Louis.Ederer@APORTER.COM>]
Sent: Sunday, July 26, 2015 6:31 AM
To: Mandel, Richard
Cc: Emert, Aryn M.; Salzmann, Matthew T.; Wolverson, Benjamin
Subject: Re: Tod's v. Toms

Richard:

I am on trial this week. I will get back to you next week.

Thanks,

Louis S. Ederer
Arnold & Porter LLP
louis.ederer@aporter.com

From: Mandel, Richard [<mailto:RSM@cjl.com>]
Sent: Thursday, July 23, 2015 11:46 AM Eastern Standard Time
To: Ederer, Louis S.
Cc: Emert, Aryn M. <AME@cjl.com>
Subject: Tod's v. Toms

Lou,

I am writing to you with respect to your recently served discovery requests and deposition notices. With respect to the discovery requests, we are going to need some additional time to respond. Because Tod's is effectively closed down for several weeks during August, we would ask that you extend our time until September 11 (a little over 30 days) to respond to the interrogatories and document requests. Let us know if that is acceptable.

EXHIBIT D

Mandel, Richard

From: Mandel, Richard
Sent: Monday, August 31, 2015 11:26 AM
To: 'Ederer, Louis S.'
Cc: Emert, Aryn M.; Salzmann, Matthew T.; Wolverton, Benjamin
Subject: RE: Tod's v. Toms

Lou,

I have confirmed that we can make Stephanie Rothfeld available for a deposition on October 8 and Claudio Castiglioni available on October 9. Please confirm that those dates would work for you.

With respect to the 30(b)(6) issue, Mr. Castiglioni can testify as the corporate representative with respect to topics 1, 4-6 and 8-18 from your notice. The witness for the remaining topics would need to be an individual in Italy. Let us know if that is sufficient for your purposes.

Finally, we are not prepared to make Ms. Pinotti available for a deposition other than through the procedure of depositions upon written questions.

Richard S. Mandel, Esq.
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From: Ederer, Louis S. [<mailto:Louis.Ederer@APORTER.COM>]
Sent: Wednesday, August 12, 2015 10:01 AM
To: Mandel, Richard
Cc: Emert, Aryn M.; Salzmann, Matthew T.; Wolverton, Benjamin
Subject: RE: Tod's v. Toms

Richard:

As a follow-up, we confirm that we are prepared to take the depositions of the two Tod's witnesses the week of October 5. Please provide suggested dates, and also let us know where things stand on the other points we discussed recently by phone.

Regards,

Louis S. Ederer
Arnold & Porter LLP
399 Park Avenue
New York, NY 10022-4690

Telephone: +1 212.715.1102
Fax: +1 212.715.1399

EXHIBIT E

Mandel, Richard

From: Mandel, Richard
Sent: Thursday, October 01, 2015 2:24 PM
To: 'Ederer, Louis S.'
Cc: Emert, Aryn M.; Salzmann, Matthew T.; Wolverton, Benjamin
Subject: RE: Tod's v. Toms
Attachments: 10012015140602.pdf

Lou,

We are confirmed on the depositions. With respect to topics 2-3, 7 and 19-29, the designated Tod's witness is Andrea Varsavia. As previously indicated, inasmuch as this witness is located in Italy, it is our position that any deposition must proceed on written questions. Let us know if you intend to go forward on that basis.

I am also enclosing copies of deposition notices that we have served today for the four individuals identified in Mycoskie's initial disclosures and for the corporate entity Mycoskie LLC. We have noticed the depositions to take place over 3 consecutive days in December. However, if the 30(b)(6) witnesses are comprised of the same four noticed individuals, we may be able to complete all of the depositions within two days. We can discuss timing and other logistics further, but have noticed for dates in early December that would work for us and that we would like to try to keep if possible.

Richard S. Mandel, Esq.

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From: Ederer, Louis S. [mailto:Louis.Ederer@APORTER.COM]
Sent: Thursday, October 01, 2015 9:38 AM
To: Mandel, Richard
Cc: Emert, Aryn M.; Salzmann, Matthew T.; Wolverton, Benjamin
Subject: RE: Tod's v. Toms

Richard,

In anticipation of next week's depositions, this is to confirm that Mr. Castiglioni's deposition on October 9 will be a combined individual/corporate representative deposition, such that Mr. Castiglioni will be testifying as Opposer/Petitioner's 30(b)(6) witness as to the topics designated by you below, as well as in his individual capacity. In addition, we ask that you promptly provide Opposer/Petitioner's designation of 30(b)(6) witnesses with respect to topics 2-3, 7, and 19-29, regardless of the place of residence of the identified individuals.

For the depositions next week, we anticipate beginning at 930 am on each day.

Thanks,

Louis S. Ederer
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From: Ederer, Louis S.
Sent: Wednesday, September 09, 2015 10:01 AM
To: Mandel, Richard
Cc: Emert, Aryn M.; Salzmann, Matthew T.; Wolverson, Benjamin
Subject: RE: Tod's v. Toms

Richard, yes, let's keep those dates.

Thanks,

Louis S. Ederer
Partner
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From: Mandel, Richard [<mailto:RSM@cjl.com>]
Sent: Tuesday, September 08, 2015 6:54 PM
To: Ederer, Louis S.
Cc: Emert, Aryn M.; Salzmann, Matthew T.; Wolverson, Benjamin
Subject: FW: Tod's v. Toms

Hi, Lou. Just following up to see if the Oct. 8 and 9 dates work for you, as want to lock in people's schedules.

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From: Mandel, Richard
Sent: Monday, August 31, 2015 11:26 AM
To: 'Ederer, Louis S.'

EXHIBIT F

USPTO TRADEMARK TRIAL AND APPEAL BOARD

-----x

TOD'S S.P.A.,

Plaintiff,

vs.

Case No. 91218001-OPP

MYCOSKIE, LLC,

Defendant.

-----x

DEPOSITION OF CLAUDIO CASTIGLIONI

New York, New York

October 9, 2015

9:43 a.m.

Reported by:
ERICA L. RUGGIERI, RPR
JOB NO. 41197

1 CLAUDIO CASTIGLIONI

2 October 9, 2015

3 9:43 a.m.

4
5
6 Deposition of CLAUDIO

7 CASTIGLIONI, held at the offices of
8 Arnold & Porter LLP, 399 Park Avenue,
9 New York, New York 10022-4690,
10 pursuant to Notice, before Erica L.
11 Ruggieri, Registered Professional
12 Reporter and Notary Public of the
13 State of New York.

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22
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24
25

1 A P P E A R A N C E S:
2

3 ATTORNEYS FOR PLAINTIFFS

4 COWAN, LIEBOWITZ & LATMAN, P.C.

5 1133 Avenue of the Americas

6 New York, NY 10036

7 (212) 790-9200

8 BY: RICHARD S. MANDEL, ESQ.

9 rsm@c11.com

10 ARYN M. EMERT, ESQ.

11 ame@c11.com
12

13 ATTORNEYS FOR DEFENDANTS

14 ARNOLD & PORTER, LLP

15 399 Park Avenue

16 New York, New York 10022

17 212-715-1000

18 BY: LOUIS S. EDERER, ESQ.

19 Louis.Ederer@aporter.com

20 MATTHEW T. SALZMANN, ESQ.

21 Matthew.Salzmann@aporter.com
22
23
24
25

1 Q. And then just to put a date on
2 this document, there's a stamp on the
3 right-hand side which is a stamp by the
4 Florida Division of Corporations that
5 appears to have a date of July 10th, 2012.

6 Do you see that?

7 A. Yes.

8 Q. Okay. And so this appears to be
9 an application filed by Deva, Inc. with
10 the state of Florida to be able to conduct
11 or transact business in that state.

12 And if you look at the next page
13 of the document it lists the directors of
14 the company and it says, "Chairman,
15 Stefano Sincini" and "Vice Chairman,
16 Claudio Castiglioni."

17 Do you see that?

18 A. Yes, I do.

19 Q. Did you understand that you held
20 the title of vice chairman of Deva, Inc.
21 in July of 2012?

22 A. Now that I see the document I
23 remember.

24 Q. And is it the case that Mr.
25 Sincini was the chairman of the board of

1 directors of Deva, Inc. at that time?

2 A. Yes.

3 Q. And do you know whether you
4 still continue to hold a position on the
5 board of directors of Deva, Inc.?

6 A. No.

7 Q. You don't know?

8 A. No, I don't. I don't know.

9 Q. Do you know whether
10 Mr. Sincini -- well, first of all, who is
11 Mr. Sincini?

12 A. He's the CEO of Tod's SpA.

13 Q. In Italy?

14 A. Exactly.

15 Q. And do you report to him?

16 A. Yes, I do.

17 Q. Does he report to anyone within
18 the company?

19 A. To the owner of the group.

20 Q. Is that Mr. Della Valle?

21 A. Exactly.

22 Q. Is it Diego Della Valle?

23 A. Yes.

24 Q. So he's the owner of the group.

25 Is he considered the chairman of Tod's

1 SpA, if you will?

2 A. He doesn't have a title but,
3 yes.

4 Q. He's the boss?

5 A. Exactly.

6 Q. And Mr. Sincini reports to him
7 but in turn Mr. Sincini is the chief
8 executive officer of the company, right?

9 A. Yes.

10 Q. Now, if you turn the page and go
11 two pages further, this is a document that
12 states that it was filed on January 8th,
13 2013, and I can indicate to you that this
14 is a document that we downloaded from the
15 Internet from the state of Florida and it
16 appears to be an annual report filed by
17 Deva, Inc. with the state of Florida in
18 2013. And as you can see, Mr. Sincini is
19 still listed as a director and you are
20 still listed as a director.

21 Do you see that?

22 A. Yes, I do.

23 Q. So as of the beginning of 2013,
24 do you recall that you were still
25 considered a director of Deva, Inc.?

1 A. No.

2 Q. You don't recall?

3 A. No, I mean because I'm not so I
4 don't know. I see this document but.

5 Q. Do you know whether Mr. Sincini
6 continued to be a member of the board or
7 the chairman of the board of directors of
8 Deva, Inc. in 2013?

9 A. Yes. In 2013, yes, because he's
10 the chairman still today.

11 Q. And also in 2014 if you turn the
12 page you see Mr. Sincini's name still
13 appears?

14 A. Yes.

15 Q. Although your name no longer
16 appears. So sometime between 2013 and
17 2014 you went off the board of directors
18 of Deva; is that right?

19 A. Yes. Because according to what
20 you show me, yes.

21 MR. MANDEL: Well, that's what
22 the documents say. I mean if you have
23 a different understanding, you can
24 testify to it.

25 Q. Yeah. I'm asking you based upon

1 your own recollection whether from 2013 to
2 2014 you went off the board of directors
3 of Deva?

4 A. Yes.

5 Q. Was there a reason why you went
6 off the board of directors of Deva?

7 A. Just because I have other duties
8 to accomplish.

9 Q. And then if you turn the page
10 once more, there's a filing in January of
11 2015 with the Florida Secretary of State
12 and it continues to show Mr. Sincini as a
13 director of the company, correct?

14 A. Yes.

15 Q. And is that your understanding
16 is that he continues to be the chairman of
17 the board of the company?

18 A. It's my understanding, correct.

19 Q. Did you ever participate in any
20 board of directors meetings for Deva,
21 Inc.?

22 A. Yes.

23 Q. And do you recall when last time
24 was that you did so?

25 A. The year exact no, but we used

1 to handle periodically annually because
2 that was the way to fill up the minutes
3 book and sign documents.

4 Q. Do you recall any discussions
5 that took place at any board of directors
6 meeting of Deva, Inc. that you attended?

7 A. Any discussion?

8 Q. Any subject that was discussed?

9 A. We used to review the minutes
10 book and we used to like talk about, you
11 know, the business in general.

12 Q. Did the name TOMS Shoes come up
13 at a board of directors meeting of Deva,
14 Inc. that you recall?

15 A. No.

16 Q. Where did those meetings take
17 place?

18 A. In New York.

19 Q. At the office?

20 A. At the office.

21 Q. On 15th Street?

22 A. Well, we move the office so in
23 certain periods, certain years it was like
24 in 57th Street, some others was in 15th
25 Street and 450 West 15th Street. So the

1 two office we have there.

2 Q. Do you continue to maintain an
3 office at 15th Street?

4 A. No.

5 Q. Did Mr. Sincini attend these
6 board of directors meetings that you were
7 testifying about?

8 A. Yes. Yes.

9 Q. Now earlier you mentioned some
10 answers to interrogatories that you recall
11 signing in this proceeding. Do you recall
12 that?

13 A. Excuse me?

14 Q. You were looking at the document
15 that I showed you and you thought at first
16 that these were documents that you had
17 signed.

18 A. The first one, yes. D-17.

19 Q. D-17. So do you recall actually
20 signing some documents in this case?

21 A. Yes.

22 Q. And as your counsel may have
23 mentioned before, these documents were
24 called interrogatories?

25 A. Yes.

1 Q. Before that was there another
2 counsel who worked in your home office in
3 Italy?

4 A. There's several according to the
5 topic.

6 MR. MANDEL: Are you asking
7 specifically about trademark
8 responsibility?

9 MR. EDERER: Well, that's my
10 next question.

11 Q. Was there another counsel prior
12 to Mr. Varsavia who was in Italy and who
13 was responsible for monitoring trademarks?

14 A. You know, it's not a field that
15 I'm in charge with. Dr. Sincini is the
16 person that is related to all this
17 trademark. So probably there is one but
18 he was not somebody that deal directly
19 with me.

20 Q. Did you say Dr. Sincini?

21 A. Stefano Sincini.

22 Q. So Mr. Sincini has overall
23 responsibility for the trademarks area?

24 A. Exactly.

25 MR. MANDEL: Objection. You can

1 answer.

2 A. I believe, yes.

3 Q. Mr. Sincini is not a lawyer,
4 though, is he?

5 A. He's not.

6 Q. He's a business person?

7 A. Yeah.

8 Q. So if I wanted to find out who
9 was responsible as an in-house lawyer for
10 trademarks prior to Mr. Varsavia, I should
11 ask Mr. Sincini, correct?

12 A. Yes.

13 Q. Now, if you turn to
14 Interrogatory 15 on page 4. Interrogatory
15 15 says, "Identify the persons who decided
16 to file and/or approve the filing of the
17 Notice of Opposition."

18 Do you see that?

19 A. Yes, I do.

20 Q. Do you know what the Notice of
21 Opposition is?

22 A. Yes.

23 Q. Why don't we just make sure that
24 we are talking about the same document.
25 So if you look at that pile of exhibits

1 over there, I believe it's D-2.

2 Do you have D-2 in front of you?

3 A. Yes, I do.

4 Q. D-2 is a document that was filed
5 on August 25th, 2014 by your company,
6 Tod's SpA, in the U.S. Trademark Office
7 and do you understand what that document
8 is?

9 A. Yes, I do.

10 Q. What is your understanding?

11 A. Is that our company is opposing
12 this against the applicant Mycoskie, the
13 fact of the trademark.

14 Q. So just to be clear, if we go to
15 page 3 of the Notice of Opposition -- do
16 you have page 3?

17 A. Yes, I do.

18 Q. And if we look at paragraph 5,
19 would you agree or is it your
20 understanding that in this document Tod's
21 is opposing Mycoskie's application to
22 register the trademark TOMS for the goods
23 that are specified in paragraph 5?

24 A. Yes.

25 Q. And do you understand that in

1 this document Tod's is opposing any other
2 application of registration of Mycoskie?

3 MR. MANDEL: Objection. The
4 document speaks for itself.

5 Q. I'm asking what his
6 understanding is?

7 A. It's against all these category,
8 clutch bag, purse, cosmetic bags, key
9 bags, key case, wallets, luggage.

10 Q. So just to be clear, is it your
11 understanding that there's only one
12 trademark application that your company
13 was opposing in this Notice of Opposition
14 for all these goods?

15 A. Yes.

16 Q. Okay. Going back to the
17 interrogatories that we were looking at,
18 Exhibit D-20, Interrogatory 15 on page 4.
19 It indicates that the person who approved
20 the filing of Notice of Opposition, which
21 is the document we were just looking at,
22 is Mr. Sincini, correct?

23 A. Correct.

24 Q. How did you -- how did you
25 verify the accuracy of that answer?

1 A. What.

2 Q. On your verification on the last
3 page of the document you indicate that the
4 answers are true to your knowledge based
5 upon your review of company records and
6 discussions with individuals and so forth?

7 A. Yes.

8 Q. So how did you learn that
9 Mr. Sincini was the person who approved
10 the filing of the Notice of Opposition?

11 A. Because I talk with Dr. Sincini.

12 Q. So you spoke to Mr. Sincini and
13 you said who approved the filing of the
14 opposition. He said I did. Is that
15 right?

16 MR. MANDEL: Objection. Assumes
17 facts not in evidence.

18 Q. Is that right?

19 MR. MANDEL: You can answer.

20 Q. More or less?

21 A. Well, if you say more or less,
22 but he was the one that did it, no. I
23 write it and it match.

24 Q. And he confirmed that to you in
25 a conversation that you had with him,

1 eyewear related products, correct?

2 A. Yes.

3 Q. And in paragraph 8 you are
4 challenging a registration for online and
5 presumably bricks and mortar retail store
6 services, correct?

7 A. Yes.

8 Q. Now, going back to the answers
9 to interrogatories, which is Exhibit D-20
10 that we were looking at.

11 A. Okay.

12 Q. In response to number 16 it
13 indicates that Mr. Varsavia was the person
14 who approved the filing of the Petition
15 for Cancellation.

16 Do you see that?

17 A. Yes.

18 Q. How did you learn that?

19 A. Reading the document. Because
20 he's liaison with Dr. Sincini and Varsavia
21 and so --

22 Q. Well, did Mr. Varsavia come to
23 Tod's SpA after August of 2014 when the
24 Notice of Opposition was filed?

25 A. That I don't know.

1 Q. Do you know why Mr. Sincini
2 approved the Notice of Opposition but
3 Mr. Varsavia approved the Petition for
4 Cancellation?

5 A. It's not something that I do it.
6 It is Dr. Sincini that decides.

7 Q. Did Dr. Sincini tell you that it
8 was Mr. Varsavia who approved the Petition
9 for Cancellation?

10 A. No. But that I speak with
11 Dr. Sincini is my boss and I understand
12 what's happening, you know, it's one
13 story. But that he appointed people in
14 the company, it's up to him that is his
15 field to decide who he has to talk to.

16 Q. And did he tell you that?

17 A. I find out that, you know, he
18 was Andrea Varsavia because I read the
19 document. That Andrea Varsavia is the
20 counsel to talk to and he was in charge of
21 this reading the documents.

22 Q. Reading what documents?

23 A. The documents.

24 Q. I'm sorry?

25 A. The documents.

1 Q. You mean the Petition for
2 Cancellation?

3 A. The one -- no. Talking with
4 Sincini explain to me that there was this
5 case and there was this two petition in
6 course and that's what I'm here to
7 testify.

8 Q. Yes. But one of them was
9 approved by Sincini and one of them was
10 approved by Varsavia, right?

11 A. Varsavia is the counsel that
12 work with Dr. Sincini.

13 Q. But according to this answer,
14 Varsavia didn't approve the first
15 document. He only approved the second
16 document; is that correct?

17 A. Yeah. According to what is
18 written here, yeah.

19 Q. According to?

20 A. Yeah, yeah. What is written,
21 yes.

22 Q. Well, okay. Who wrote this,
23 these answers?

24 MR. MANDEL: I mean the document
25 was prepared by counsel. It's not

1 like this witness wrote them.

2 Q. But you signed a verification?

3 A. For sure. But like --

4 Q. Let me finish the question. You
5 signed a verification. We looked at it.
6 It's the last page.

7 A. Yes.

8 Q. And on the last page it says
9 that you signed the verification based
10 upon your own personal knowledge, your
11 review of company records and/or
12 discussions with relevant individuals from
13 Tod's, correct?

14 A. Yeah.

15 Q. So how did you find out that
16 Mr. Sincini or Dr. Sincini approved the
17 Notice of Opposition but Mr. Varsavia
18 approved the Petition for Cancellation?

19 A. Because I was talking with
20 Dr. Sincini with this document in front to
21 explain the fact.

22 Q. Okay. Now, a few more questions
23 about the interrogatory answers. If we go
24 to Interrogatory 19 it says, "State the
25 date on which the persons identified in

1 response to Interrogatory 14 first became
2 aware of the TOMS brand and/or the TOMS
3 marks."

4 Do you see that?

5 A. Yes.

6 Q. And the answer, the response
7 says that Mr. Varsavia first became aware
8 of the TOMS marks in or around
9 December 2014.

10 Do you see that?

11 A. Yes.

12 Q. And how did you verify the
13 accuracy of that information?

14 A. Well, this document has been
15 prepared and so when I sign I read it and
16 I ask and they told me that they ask
17 Andrea Varsavia.

18 Q. Who did you ask?

19 A. Dr. Sincini.

20 Q. Well, is this an indication to
21 you that perhaps Mr. Varsavia wasn't with
22 Tod's SpA in August of 2014 when the first
23 opposition was filed?

24 MR. MANDEL: Objection. Asked
25 and answered and calls for speculation

1 but you can answer to the best of your
2 knowledge.

3 A. He was working for the company.

4 Q. For the Hong Kong company or for
5 the Italian company?

6 A. That I don't know.

7 Q. If you look at Interrogatory 20,
8 "State the date upon which the persons
9 identified in response to Interrogatory 15
10 first became aware of the TOMS brand
11 and/or the TOMS marks." And the response
12 indicates that Mr. or Dr. Sincini first
13 became aware of the TOMS brand and/or the
14 TOMS marks in or around July 2011.

15 Do you see that?

16 A. Yes.

17 Q. And did you do anything to
18 verify the accuracy of that answer?

19 A. Yes. We talked to him.

20 Q. You talked to?

21 A. To Dr. Sincini.

22 Q. To Dr. Sincini?

23 A. Yes.

24 Q. Can you tell me what you asked
25 him and what he said to you?

1 A. Well, we talk about, you know,
2 if I recall that around the period of
3 July 2011 we were talking, you know, about
4 the trademark.

5 Q. When you saw we, you mean you
6 and him?

7 A. Exactly.

8 Q. So that was my next question.
9 Because if you look at Interrogatory 25 it
10 says, "State the date upon which Claudio
11 Castiglioni first became aware of the TOMS
12 brand and/or the TOMS marks."

13 Do you see that?

14 A. Yes.

15 Q. And I would imagine you didn't
16 have to ask anybody to verify this because
17 that's you, right?

18 A. Yes.

19 Q. Okay. And if you look at the
20 answer on the next page it says that you
21 became aware, first became aware of the
22 TOMS brand and/or the TOMS marks in or
23 around July 2011?

24 A. Yes.

25 Q. And that's the same date that

1 was indicated for Dr. Sincini?

2 A. Exactly.

3 Q. So did you both become aware of
4 the TOMS brand around the same time?

5 A. That was our conversation. I
6 remember we talked about it.

7 Q. So tell me about your
8 conversation. What do you recall about
9 your conversation in July 2011 with
10 Dr. Sincini about the TOMS brand?

11 A. There was not much to be said.
12 It was just a confrontation between the
13 party and it was just a moment that
14 Dr. Sincini told me about, you know, the
15 TOMS and we just, you know, briefly
16 probably just said we have to monitor.
17 But we didn't really went more than that.

18 Q. Do you recall a conversation
19 with Dr. Sincini where one of you said we
20 have to monitor TOMS?

21 A. He told me.

22 Q. He said we have to monitor TOMS?

23 A. He point to the brand TOMS and
24 say, you know, what is your feeling about
25 this brand. We need to monitor.

1 Q. And how did you respond to him?

2 A. Well, I don't recall exactly the
3 words but, you know, since the name is so
4 close I probably, you know, say you're
5 right.

6 Q. Well, were you concerned at the
7 time?

8 A. But it's happen that this
9 conversation take place to have feedback
10 about somebody but he's in charge of that
11 so he's the one to take care.

12 Q. Well, do you know whether your
13 company did anything to try and challenge
14 the use of the TOMS name in July 2011?

15 A. That I'm not aware.

16 Q. Do you know when was the first
17 time are your company did anything to try
18 and challenge the use of the TOMS name in
19 the United States after July 2011?

20 A. For this petition 2014.

21 Q. So what happened between
22 July 2011 and July -- and August 2014?

23 MR. MANDEL: What happened with
24 respect to what?

25 Q. With respect to your company's

1 monitoring of the TOMS brand?

2 MR. MANDEL: If you know.

3 A. Because as I mention to you,
4 Dr. Sincini in charge of that so I don't
5 know what he did.

6 Q. So you don't know whether he
7 spoke to attorneys, whether he did any
8 monitoring himself, anything like that?

9 A. Exactly.

10 Q. You don't know?

11 A. I don't know.

12 Q. Did you have any follow-up
13 discussion with him about this issue after
14 July 2011?

15 A. No.

16 Q. When was the first time after
17 July 2011 that you found out that your
18 company was challenging the TOMS brand's
19 application to register the name?

20 MR. MANDEL: Anywhere in the
21 world or in the U.S.?

22 Q. U.S.

23 A. Probably recently.

24 Q. Meaning in the last year?

25 A. Yes.

1 Q. Are you aware that your company
2 is challenging our client's attempts to
3 register the TOMS name in other countries
4 of the world?

5 A. Yes, I know.

6 Q. Do you know how long your
7 company has been doing that?

8 A. Probably for a long time.

9 Q. Do you know for sure?

10 A. For sure not, but I think it's
11 probably like three or four years.

12 Q. Three or four years? Going back
13 to sometime around 2011?

14 A. Yeah.

15 Q. What is your basis for saying
16 that?

17 A. Because I remember that I saw an
18 application for Macau so it was like, you
19 know, it was the first probably opposition
20 that the company did.

21 Q. So you are saying -- you are
22 referring to an application that my client
23 filed in the country of Macau?

24 A. No, that we opposed to the
25 registration of TOMS in Macau.

1 Q. And you believe that goes back
2 three or four years?

3 A. I do.

4 Q. And did you have a discussion
5 with Dr. Sincini about that?

6 MR. MANDEL: At the time you
7 mean?

8 MR. EDERER: At the -- okay.
9 Well, let me withdraw it.

10 Q. How did you find out about that,
11 about the Macau situation?

12 A. Because coming for this
13 deposition, you know, I saw that there was
14 the first time that there was like this
15 incident with Macau but I didn't pay too
16 much attention.

17 Q. Coming to the deposition, do you
18 mean you reviewed documents in preparation
19 for the deposition?

20 A. I reviewed some, yes.

21 Q. What documents did you review?

22 A. With my counselor. The document
23 pertaining to sales, pertaining to
24 advertisement.

25 Q. And also a document relating to

1 a proceeding in Macau?

2 A. No. It was one document that
3 I notice was there but it was not
4 something that, you know -- it was
5 pertaining to this case but I notice it
6 was the first situation that we have in
7 opposition with Macau.

8 Q. When you had your conversation
9 with Dr. Sincini in July of 2011 about
10 TOMS, were you looking at something or did
11 he show you something?

12 A. There was something written but
13 I don't remember exactly what.

14 Q. Written by who?

15 A. I don't remember. It was like
16 they show me the name and they told me if
17 I knew something about TOMS.

18 Q. Since that time have you learned
19 anything about TOMS?

20 A. Yeah. Little by little.

21 Q. And what have you learned?

22 MR. MANDEL: Objection. Calls
23 for a narrative but -- can you be more
24 specific. I mean what has he learned
25 about TOMS.

1 Q. Back in 2011 what types of
2 products did you understand TOMS to be
3 selling?

4 A. Shoes.

5 Q. And have you learned since that
6 time that TOMS is still selling shoes?

7 A. Yes.

8 Q. And have you learned that they
9 are selling other products?

10 A. Yes.

11 Q. How did you learn that?

12 A. Through the website and in
13 general.

14 Q. But at the time in July 2011 you
15 were only aware of shoes?

16 A. Yes.

17 Q. Did you ever go back to
18 Dr. Sincini after July of 2011 and say,
19 you know, TOMS is -- we have to do
20 something about TOMS in the United States?

21 A. No.

22 Q. Or what's going on with TOMS in
23 the United States?

24 MR. MANDEL: Objection. But you
25 can answer.

1 A. No.

2 Q. Any reason why not?

3 A. Not really.

4 Q. It was his area?

5 A. Probably.

6 Q. Now, we were just looking at the
7 different TOMS applications and
8 registrations that your company is
9 challenging, correct?

10 A. Yes.

11 Q. And we saw that you are
12 challenging TOMS applications and
13 registrations for bags, for eyewear, for
14 retail store services and for one
15 particular type of children's wear,
16 correct?

17 A. Yes.

18 Q. There doesn't seem to be an
19 indication in any of those two filings
20 that you are challenging TOMS registration
21 in the United States for footwear. Did
22 you notice that?

23 A. Yes.

24 Q. Do you know any reason why not?

25 MR. MANDEL: And let me just

1 caution you not to reveal any
2 privileged information. If you can
3 answer that without revealing
4 information that you learned solely
5 from counsel, you can do so.

6 MR. EDERER: Well, no, he can --

7 MR. MANDEL: No, he can't. I
8 mean, you know, you are getting into
9 why certain registrations were or
10 weren't challenged. There's obviously
11 legal determinations that go into
12 that. If he knows that based on
13 solely from lawyers or explaining to
14 him legal reasons that may be relevant
15 to that, I'm not going to let him
16 disclose to you what legal advice may
17 have gone into that.

18 Q. Did you ever ask Mr. Sincini
19 whether we should -- whether your company
20 should challenge my client's ability to
21 maintain trademark registrations for
22 footwear in the United States?

23 A. We have a conversation which we
24 talk about the fact of having the shoes in
25 canvas with the logo, with the flag, the

1 Argentina flag, and he was less concerned
2 of the fact of how everything was used,
3 meaning the shoes I was looking and the
4 logo that was used on the shoes.

5 Q. Is this the conversation you
6 were talking about earlier in July of 2011
7 or another conversation?

8 A. No. Another conversation.

9 Q. When did this conversation take
10 place?

11 A. Recently.

12 Q. Recently?

13 A. (Witness nods.)

14 Q. Within the last year?

15 A. Yeah.

16 Q. Six months?

17 A. It was -- yeah. Because knowing
18 that I was coming here we talked together
19 and he explain to me that he was having a
20 conversation with the company to try to
21 co-exist with the shoes have been using
22 the logo TOMS with the flags.

23 Q. So as far as you understood,
24 Mr. Sincini didn't have or Dr. Sincini
25 didn't have a problem with TOMS using the

1 name TOMS as part of the logo, is that
2 what you are saying?

3 A. He was less concerned.

4 Q. Okay. Well, why don't we take a
5 look at what was marked yesterday as
6 Exhibit D-5. Do you have that? You see
7 that?

8 A. Yeah.

9 Q. And do you understand that to be
10 an example of a TOMS footwear product?

11 A. Yes.

12 Q. And is the logo that you are
13 referring to the one that appears on the
14 heel of the shoe?

15 A. Yes.

16 Q. So do I understand that
17 Dr. Sincini told you he was less concerned
18 about the logo that appears on the heel of
19 the shoe than, for example, the tab that
20 exists on the side of the shoe which just
21 says TOMS?

22 A. We didn't go so far. We focused
23 on that particular logo with the flag.

24 Q. Okay.

25 MR. EDERER: Well, why don't we

1 your personal knowledge. You are
2 not the designated corporate
3 representative but if you have an
4 understanding, you can testify.

5 A. I don't know.

6 Q. By the way, these concerns that
7 you've expressed about the use of the
8 wordmark TOMS on various products, have
9 you shared those concerns with
10 Dr. Sincini?

11 A. Well, what happened recently not
12 yet.

13 Q. You mean when you went to the
14 store yesterday?

15 A. Exactly. That we have like, we
16 have been talking about this very similar
17 name between TOMS and Tod's, yes, we have
18 been discussing that.

19 Q. And how long have you been
20 discussing that?

21 A. In 2011 when it first started
22 was the first time.

23 Q. And you've discussed that issue
24 subsequent to 2011 also?

25 MR. MANDEL: It's been asked and

1 answered.

2 A. As I mentioned, he's in charge.

3 Q. The discussions that you had
4 with Dr. Sincini about your concern
5 include your concern about the use of TOMS
6 on footwear?

7 A. I don't know.

8 MR. MANDEL: He already
9 testified about footwear also.

10 A. I don't know if I talk with him
11 exactly about it but it's my concern.
12 When I see the letter TOMS written on the
13 back of the shoes without the flag, with
14 just imprint on the sole is my concern.

15 Q. Do you recall whether you said
16 the that to Dr. Sincini?

17 A. Specifically referring to shoes,
18 no.

19 Q. Do you recall whether he said
20 that to you specifically referring to
21 shoes, that he was concerned -- that he
22 had a similar concern?

23 A. I don't remember.

24 Q. You don't remember?

25 A. No.

1 Q. Do all of those -- do all of
2 those registrations concern you?

3 A. Yes.

4 Q. For the same reasons you've
5 indicated?

6 A. Yes.

7 Q. Going back to your discussions
8 with Dr. Sincini about your concerns with
9 TOMS and the use of the TOMS wordmark in
10 particular, did any of those conversations
11 take place after your first conversation
12 in July 2011 but before you filed the
13 Notice of Opposition in August of 2014?

14 A. Could be.

15 Q. You don't recall?

16 A. We meet so often that, you
17 know, we talk about several topics. We
18 probably --

19 MR. MANDEL: Well, don't
20 speculate. If you can remember
21 specifically. He's asking you a
22 specific time period.

23 Q. Do you remember for example
24 Dr. Sincini telling you we've decided to
25 file an opposition against TOMS in the

1 A. No.

2 MR. MANDEL: You can answer yes

3 or no.

4 A. No.

5 Q. You don't know why?

6 A. No.

7 MR. MANDEL: Can we take a break

8 when you get to a good place?

9 MR. EDERER: Sure.

10 Q. Did you ever ask Dr. Sincini

11 that question?

12 A. As I mentioned to you, I know

13 that he talked specifically about the

14 shoes, that he was not concern if it was

15 done in canvas and with the flag.

16 Q. Right. But you understand that

17 these three registrations in this chart

18 are for the TOMS wordmark not for the

19 design mark? Okay?

20 A. Yes.

21 Q. So my question is a simple one.

22 Do you know -- did you have any

23 conversation with Dr. Sincini or anyone

24 else as to why your company was not

25 challenging the TOMS wordmark

1 registrations for shoes and clothing?

2 MR. MANDEL: Just answer that
3 yes or no.

4 A. No.

5 Q. Is today the first day that you
6 ever learned that your company is not
7 challenging or has not challenged the TOMS
8 wordmark registration for shoes and
9 clothing?

10 MR. MANDEL: Objection to the
11 extent that you may have learned any
12 information relevant to that from
13 counsel before today.

14 MR. EDERER: He can answer that
15 question. If the answer is it's not
16 today, then he can say, no, I learned
17 that on some other day.

18 MR. MANDEL: Well, you can
19 answer yes or no if you learned it
20 before today.

21 A. No. I learn before today.

22 Q. You learned before today. When
23 did you first learn?

24 A. As I mentioned to you, it's when
25 I talk about it with Dr. Sincini that he

1 was less concerned about the shoes. So
2 that's why it was not challenged.

3 Q. So that conversation took place
4 when, back in 2011?

5 A. No.

6 Q. When did that conversation take
7 place?

8 A. I don't know exactly the time.

9 Q. Within the last year?

10 A. Probably.

11 Q. So is it the case that you are
12 more concerned about one piece garments
13 for infants and babies than you are about
14 shoes?

15 MR. MANDEL: You are asking if
16 he's, him personally now?

17 MR. EDERER: Yes.

18 MR. MANDEL: He's not here as
19 the company representative, let's be
20 clear. Are you asking about him or
21 the company?

22 MR. EDERER: I can ask him
23 whether he has personal knowledge as
24 to whether or not the company is more
25 concerned about one piece garments for

1 yesterday, did you see any one piece
2 garments for infants and babies?

3 A. No. I saw the name used in
4 different other category.

5 Q. And as the brand manager of the
6 company, did anybody come to you and say
7 what types of goods should we be
8 challenging TOMS registrations for?

9 A. I think it was decided with
10 Dr. Sincini.

11 MR. MANDEL: Would this be an
12 okay time to break?

13 MR. EDERER: Sure.

14 (Whereupon, there is a recess in
15 the proceedings.)

16 Q. Just a follow-up question,
17 Mr. Castiglioni, with respect to Exhibit
18 D-5, the shoe product that we have been
19 looking at, the TOMS shoe product. So
20 just so I'm clear, as brand manager for
21 Tod's do you have a problem with TOMS
22 selling this shoe with the TOMS mark as it
23 appears?

24 A. Since it's shoes that's made
25 with canvas, there is a flag on the back

1 that --

2 Q. Less concerned?

3 A. Less.

4 Q. Okay. So to your understanding
5 is that one of the reasons why your
6 company has not challenged the TOMS
7 registration for footwear in the United
8 States?

9 A. That's something that
10 Dr. Sincini decided.

11 Q. Did Dr. Sincini decide to
12 challenge the TOMS registration for
13 footwear in any other countries?

14 A. I don't know.

15 Q. Well, let's mark for
16 identification as --

17 MR. MANDEL: I'm just going to
18 object for the record if we are
19 getting into foreign proceedings,
20 which have nothing to do with the U.S.

21 Q. So just to be clear, for the
22 record, you don't know whether your
23 company is challenging the TOMS footwear
24 mark in any other country?

25 MR. MANDEL: Objection to

1 TOMS mark for footwear in Canada but not
2 in the United States?

3 MR. MANDEL: Objection. It's
4 been asked and answered several times
5 already. The witness has already
6 answered what he knows and there's
7 nothing more to add on it.

8 Q. Okay. Can I have an answer to
9 my question?

10 A. What was your question?

11 MR. EDERER: Can you read it
12 back, please.

13 (Record read.)

14 A. No.

15 Q. There's no reason?

16 A. No.

17 Q. If you take a look at Exhibit
18 D-22, which is my client's answer to the
19 Petition for Cancellation. Do you have
20 that?

21 A. Yes.

22 Q. Before that, let me ask you this
23 question. My client filed an answer to
24 the Notice of Opposition in September of
25 2014. That's one of the documents we were

1 looking at before, Exhibit D-21, I
2 believe. And then your company filed a
3 petition to cancel the four registrations
4 in August -- sorry, April of 2015. Okay.
5 Approximately six months later.

6 Do you know why it took you six
7 months to file the Petition for
8 Cancellation after you received the answer
9 to the Notice of Opposition?

10 A. As I mentioned to you,
11 Dr. Sincini is taking care of this, not
12 us.

13 Q. So now you have in front of you
14 my client's answer to the Petition for
15 Cancellation, Exhibit D-22. Do you have
16 that?

17 A. Yes.

18 Q. And I'm referring you to
19 paragraph 3 on page 3 of the answer. In
20 that paragraph we indicate that
21 Respondent, which is TOMS Shoes, owns the
22 following applications and registrations
23 for the mark TOMS and design. In classes
24 925 and 35 in the United States. And then
25 it goes on to have a chart with all the

1 different registrations and applications
2 for the Tom's and design mark that goes on
3 to page 6.

4 Do you see that?

5 A. Yes.

6 Q. Have you ever seen that chart
7 before today?

8 A. No.

9 Q. Were you aware that TOMS had
10 those registrations or applications for
11 the TOMS and design mark in the United
12 States before today?

13 A. No.

14 Q. Do you know whether your company
15 is opposing or seeking to cancel any TOMS
16 and design mark in the United States or is
17 it just the TOMS wordmark?

18 A. I think it's the name TOM.

19 Q. Just the wordmark?

20 A. Yeah.

21 Q. So to your understanding, your
22 company is not challenging any of the TOMS
23 design marks that appear in the chart that
24 starts on page 3 and goes over to page 6?

25 A. I don't know for sure.

1 Q. Did you ever hear in your
2 conversations with Dr. Sincini or anyone
3 else whether your company is challenging
4 any Tom's design marks in the United
5 States?

6 MR. MANDEL: I mean we can
7 stipulate, if you want, that we
8 haven't filed oppositions against
9 them. If you really need to ask this
10 witness. He's not designated on this
11 topic.

12 MR. EDERER: Well, I have
13 another question. I'm asking if he
14 knows from his own personal knowledge.

15 MR. MANDEL: We can stipulate.
16 We haven't challenged them. It's a
17 stipulated fact that we haven't
18 brought proceedings against the design
19 mark.

20 Q. Do you know why your company has
21 not challenged any of TOMS design mark
22 applications or registrations in the
23 United States?

24 A. No, I don't.

25 Q. Is that something that's

1 Dr. Sincini's area?

2 A. Yes.

3 Q. Now, let's take a look at your
4 company's Petition for Cancellation, which
5 I believe is Exhibit D-3. Do we have
6 that?

7 A. Yes.

8 Q. On page 2 of your Petition for
9 Cancellation all lawyers like to make
10 charts so there's a chart on page 2 of
11 your company's petition with a list of
12 various Tod's trademarks.

13 Do you see that?

14 A. Yes.

15 Q. And do you understand those to
16 be trademark registrations that Tod's
17 maintains in the United States?

18 A. Yes.

19 Q. And three of those trademarks in
20 the chart, the marks themselves are the
21 identical logo, would you agree?

22 A. You refer to one, two and four.

23 Q. One, two and four?

24 A. Yes.

25 Q. Do you have a name for that logo

1 Q. What was that mark used for?

2 A. It was used for a particular
3 line of bags.

4 Q. Is it still being used?

5 A. We are working on developing the
6 line.

7 Q. The one mark that I don't see in
8 this chart is the wordmark Tod's by
9 itself, just the name Tod's. Do you see
10 that anywhere?

11 A. No.

12 Q. Do you know whether your company
13 has registered the wordmark Tod's by
14 itself in the United States?

15 A. I don't know.

16 Q. Would it surprise you to learn
17 that your company does not have a
18 registration for the wordmark Tod's in the
19 United States?

20 MR. MANDEL: Objection.

21 A. I don't know.

22 Q. Do you know any reason why a
23 registration for the wordmark Tod's was
24 not included in this chart?

25 A. I'm not trying to avoid your

1 question, but this is a part of
2 Dr. Sincini.

3 Q. Have you been involved in any
4 other trademark proceedings in the United
5 States on behalf of your company before
6 this one?

7 MR. MANDEL: You are asking him
8 personally?

9 MR. EDERER: Yes.

10 MR. MANDEL: By involved, you
11 mean been a witness --

12 Q. A witness, submitted any
13 documents or affidavits, anything like
14 that?

15 A. No.

16 Q. Are you aware of whether your
17 company has engaged in any trademark
18 proceedings in the United States other
19 than the one that you are here testifying
20 about today?

21 A. My best recollection, no.

22 MR. EDERER: Let's mark for
23 identification as Exhibit D-24 a
24 document bearing Bates numbers 8197
25 through 8289.

1 trademark Todes?

2 A. I don't know.

3 Q. Having seen all of these
4 documents does that refresh your
5 recollection as to any prior trademark
6 opposition that your company filed in the
7 United States other than the one we are
8 here talking about today?

9 A. I know that the company is very
10 active to keeping up the brand protected,
11 but I believe there they are all things
12 that Dr. Sincini is involved with.

13 Q. Okay. Now, would you agree that
14 the Tod's brand is a luxury brand?

15 A. Yes.

16 Q. Okay. And is your target
17 consumer the person -- and I'm talking
18 about the United States right now. Is
19 your target consumer the person who buys
20 luxury goods?

21 A. Yes.

22 Q. And who do you consider to be
23 your most direct competitors in the United
24 States?

25 A. Could be Gucci, Prada, Miu Miu,

| | | | | | |
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EXHIBIT G

**UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 86/004,044
Published in the *Official Gazette* on April 29, 2014
For the Mark: TOMS

In the Matter of Registration Nos. 4,097,948; 4,192,925; 4,313,981; 4,410,344
Registered: February 14, 2012; August 21, 2012; April 2, 2013; October 1, 2013
For the mark: TOMS

| | | |
|------------------------------|---|------------------------------------------|
| _____ |) | |
| TOD'S S.P.A., |) | Opposition No.: 91218001 (parent) |
| |) | Cancellation No.: 92061234 |
| <i>Opposer/Petitioner,</i> |) | |
| |) | APPLICANT/RESPONDENT'S NOTICE |
| - against - |) | OF DEPOSITION OF STEFANO SINCINI |
| |) | |
| MYCOSKIE, LLC, |) | |
| |) | |
| <i>Applicant/Respondent.</i> |) | |
| _____ |) | |

PLEASE TAKE NOTICE that, pursuant to Rules 26 and 30 of the Federal Rules of Civil Procedure and 37 C.F.R. § 2.120, Applicant/Respondent Mycoskie, LLC, by and through its undersigned attorneys, will take the deposition upon oral examination of Stefano Sincini beginning at 9:30 a.m. on January 14, 2016 at the offices of Arnold & Porter LLP, 399 Park Avenue, New York, NY 10022. The deposition will be taken before a notary public or other officer authorized by law to administer oaths and will be recorded by stenographic, audiotape, realtime transcription, and/or videographic means. The deposition will continue from day to day until completed. Counsel are invited to attend and cross-examine.

Dated: December 14, 2015

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the attached Opposer/Petitioner's Opposition to Applicant/Respondent's Cross-Motion to Compel the Oral Deposition of Stefano Sincini and accompanying Declaration of Stefano Sincini and Declaration of Richard S. Mandel, along with the supporting exhibits, was served upon Applicant/Respondent's counsel of record on February 2, 2016 by first class mail, postage prepaid addressed to:

Louis S. Ederer, Esq.
Arnold & Porter LLP
399 Park Avenue
New York, New York 10022

/Bridget A. Crawford/

Bridget A. Crawford