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

Proceeding	91223262
Party	Defendant Twitter, Inc.
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Date	02/03/2016
Attachments	REDACTED Twitter_s Motion to Take Depos of Foreign Deponents by Oral Exam.PDF(124450 bytes)

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

In re Serial No. 86328428
to register: TWEETSTORM
Filed: July 3, 2014
Published: April 14, 2015

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CONTENT GURU LIMITED,	:	
	:	Opposition No. 91223262
Opposer,	:	
	:	
v.	:	
	:	
TWITTER, INC.,	:	
	:	
Applicant.	:	
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**TWITTER, INC.’S MOTION TO TAKE DEPOSITIONS OF FOREIGN DEPONENTS
BY ORAL EXAMINATION AND BRIEF IN SUPPORT**

Pursuant to 37 C.F.R. § 2.120(c) and for good cause shown, Applicant Twitter, Inc. (“Twitter”) moves the Trademark Trial and Appeal Board (the “Board”) to permit the taking of deposition testimony by oral examination of representatives of Content Guru Limited (“Opposer”) upon whom Twitter has served timely deposition notices, namely, Martin Taylor and Opposer’s designated 30(b)(6) witness(es), all of whom are believed to be located in the United Kingdom, and respectfully shows the Board as follows:

I. INTRODUCTION

On July 3, 2014, Twitter filed application Serial No. 86328428 to register the mark TWEETSTORM for various services in Classes 38, 41, and 45 (the “Application”). On August 12, 2015, Opposer initiated this proceeding by filing a notice of opposition, claiming a likelihood of confusion with Opposer’s STORM mark (the “STORM Mark”), for which Opposer had filed intent-to-use application Ser. No. 77544841 on August 12, 2008, covering various goods and

services in Classes 9 and 28 (“Opposer’s STORM Application”). Dkt. 1, ¶¶ 2 & 9. A notice of allowance issued for Opposer’s STORM Application on November 5, 2013, but Opposer has yet to file a Statement of Use. Opposer’s Notice of Opposition, however, alleges that Opposer has in fact used its STORM Mark in commerce in the United States. Specifically, Opposer alleges that it has “marketed and sold its STORM goods and services in the United States since before Applicant’s filing date” and that “Opposer’s use of its mark in commerce also predates July 3, 2014.” Dkt. 1, ¶¶ 3 & 7.

On November 20, 2015, Opposer served its initial disclosures, identifying Sean Ploen, Esq., the attorney responsible for prosecuting Opposer’s STORM Application, Martin Taylor, Opposer’s Sales and Marketing Director, and Pradeep Sharma, Opposer’s Financial Controller, as individuals who might have discoverable information that Opposer may use to support its claims or defenses in this proceeding. *See* Declaration of Allison S. Roach (“Roach Decl.”) ¶ 6, Ex. 3. Sean Ploen, Esq. is or was outside counsel for Opposer, and it is Twitter’s understanding that the two individuals in Opposer’s initial disclosures who are officers/representatives of Opposer (Martin Taylor and Pradeep Sharma) both reside in the United Kingdom.

Opposer’s initial disclosures further state that “Opposer incorporates by reference those persons identified in its other discovery responses” *Id.* The individuals that Opposer has identified in its discovery responses are [REDACTED]

[REDACTED]. *See* Roach Decl., Exs. 4 & 5. These individuals also all appear to reside in the United Kingdom. Opposer’s responses to Twitter’s discovery requests seeking identification of individuals with knowledge about the selection and adoption of the STORM Mark, Opposer’s U.S. application for the STORM Mark, and Opposer’s use/intended

use and sales and/or marketing efforts in the United States [REDACTED] [REDACTED] (*see* Roach Decl., Ex. 4, Resp. to Interrogs. #10, 13, 17, & 18). As noted above, Opposer’s officers/representatives identified in its initial disclosures both appear to reside in the United Kingdom.

Thus, none of the individuals identified by Opposer—in their initial disclosures or in their discovery responses—are located in the United States. Rather, all of the individuals Opposer has identified as having knowledge relevant to this proceeding are located in the United Kingdom.

In light of this fact, during the parties’ discovery conference on October 5, 2015, Twitter proposed that depositions of Opposer’s representatives, all of whom reside in the United Kingdom, be taken live by video conference rather than on written questions, and requested Opposer’s consent to do so. Roach Decl. ¶ 2. Following up on its request, on November 20, 2015, counsel for Twitter contacted counsel for Opposer by email, seeking Opposer’s consent to the taking of depositions by oral examination of Opposer’s foreign witnesses by video conference. *Id.*, ¶ 3, Ex. 1. Opposer replied to Twitter’s request on November 25, 2015, refusing to consent to producing foreign witnesses for live depositions by video conference. *Id.*, ¶ 4, Ex. 2.

On February 3, 2016, Twitter served notice of deposition for the oral depositions of Martin Taylor and Opposer’s designated 30(b)(6) witness(es). *Id.*, ¶¶ 9 & 10, Exs. 6 & 7.

II. TWITTER SHOWS GOOD CAUSE FOR THE BOARD TO ORDER THE ORAL VIDEO DEPOSITIONS OF OPPOSER’S REPRESENTATIVES

The Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) provides that the deposition testimony of a foreign deponent may be taken by oral examination on consent of the parties or if “the Board, upon motion for good cause” issues an appropriate order requiring live testimony. *See* TBMP §404.03(b) (citing 37 C.F.R. § 2.120(c)).

The Board makes its determination as to whether good cause exists to take live deposition testimony of a foreign party “on a case-by-case basis, upon consideration of the particular facts and circumstances in each situation.” *Orion Grp. Inc. v. The Orion Ins. Co. PLC*, 12 U.S.P.Q.2d 1923, 1925 (T.T.A.B. 1989); *accord Feed Flavors Inc. v. Kemin Indus., Inc.*, 209 U.S.P.Q. 589, 1980 WL 39356, at *2 (T.T.A.B. 1980) (permitting live deposition because “it would be unjust for respondent to be deprived of the valuable aid of confronting the witnesses by way of oral cross-examination”). In determining whether to order live depositions, the “Board weighs the equities, including the advantages of an oral deposition and any financial hardship that the party to be deposed might suffer if the deposition were taken orally in the foreign country, and orders that the deposition be taken orally in appropriate cases.” *Orion*, 12 U.S.P.Q.2d at 1925.

As set forth below, the significant advantages of depositions by oral examination greatly outweigh any minor inconvenience of Opposer, establishing good cause for the taking of oral depositions of Opposer’s U.K. officers/representatives identified in its initial disclosures and discovery responses and on whom Twitter has served deposition notices.

A. Live deposition testimony is significantly preferable to written depositions.

It is axiomatic and well-recognized that written deposition testimony is inferior to a live deposition because the former deprives the party taking the deposition from confronting and cross-examining the witness based on the answers given. *Orion*, 12 U.S.P.Q.2d at 1925; *Kemin*, 1980 WL 39356, at *2; *see also Zito v. Leasecomm Corp.*, 233 F.R.D. 395, 397 (S.D.N.Y. 2006) (“Written questions are rarely an adequate substitute for oral depositions both because it is difficult to pose follow-up questions and because the involvement of counsel in the drafting process prevents the spontaneity of direct interrogation.”) (citing cases); *Page v. Arkansas State Univ.*, No. 3:13-CV-00077-KGB, 2014 WL 6901117, at *1 (E.D. Ark. Dec. 4, 2014) (refusing to

require deposition by written questions in lieu of live deposition); John Kimpflen, et. al, 10A *Fed. Proc., L. Ed.* § 26:482 (Deposition by written format “does not permit the probing follow-up questions necessary in all but the simplest litigation, counsel are unable to observe the demeanor of the witness and evaluate the witnesses’ credibility in anticipation of trial, and written questions provide opportunity for counsel to assist the witness in providing answers so carefully tailored that they are likely to generate additional discovery disputes.”).

The Board has specifically acknowledged the numerous advantages of taking live depositions of foreign deponents, and accordingly, Twitter should be able to take the depositions of Opposer’s representatives by oral examination rather than by written questions. First, the Board has recognized that the ability to cross-examine a witness, which is a crucial element of a deposition, is lost when a deposition is not conducted by oral examination. *See Kemin*, 1980 WL 39356, at *2 (“The argument most often advanced by one whose opponent wants to take a [live] deposition [of a foreign deponent] is that the advantage of being able to confront a witness on cross examination is lost. This is one of respondent’s arguments . . . and it is an argument that has merit.”).

Here, Twitter already has, through written discovery requests, sought from Opposer specific details regarding its selection and adoption of the STORM Mark, the filing of its U.S. trademark application, its use and intended use of the mark in the United States, and its U.S. sales and marketing efforts in connection with the mark, as well as identification of the individuals with knowledge about these relevant topics. *See* Roach Decl. ¶ 7, Ex. 4, Interrogatories #10, 13, & 18. All of Opposer’s officers/representatives that it has identified in response to these written discovery requests and in its initial disclosures as having information relevant to this proceeding are residents of the United Kingdom [REDACTED]

[REDACTED]. Roach Decl. ¶¶ 6-8, Exs. 3-5. Twitter should be able to cross-examine the relevant individuals regarding their knowledge relating to Opposer's STORM Mark and issues relevant to this proceeding.

The knowledge of the noticed deponents is crucial to the proceeding, especially considering Opposer's vague and incomplete responses to Twitter's discovery requests. For example, although Opposer claims in its interrogatory responses [REDACTED], it provides no details [REDACTED].

[REDACTED]. Roach Decl., Ex. 4. at Interrogs. #1, #8. Moreover, in response Applicant's interrogatory requesting identification of advertising, marketing, or promotional use of Opposer's STORM Mark in the United States, Opposer responded [REDACTED].

[REDACTED]. *See id.* at Interrog. #4; *see also id.* at Interrog. #2.

Opposer's Objections and Responses to Applicant's First Set of Requests for the Production of Documents and Things provide no additional detail regarding Opposer's use, intended use, channels of trade, sales, or advertising methods or expenditures. Indeed, for *every single request*, and in violation of Federal Rule of Civil Procedure 34(b)(2)(C), which requires that a party specify as to whether documents are being withheld on the basis of objections, Opposer merely responded:

Subject to, and without waiving, any of the foregoing Specific or General Objections, Opposer will produce or make available, pursuant to the parties' coordination of production of documents and the Protective Order entered by the Trademark Trial and Appeal Board, responsive, non-privileged documents within its possession, custody, or control if any exist.

Roach Decl., Ex. 5. From Opposer’s responses, Twitter cannot determine whether Opposer is in fact in possession of any documents to support its vague claims, and despite having served it responses over a month ago (on December 17, 2015), Oppose has yet to produce a single document, nor has it specified when it intends to produce responsive documents. Roach Decl. ¶ 11.

Thus, the disclosures, responses, and documents (or lack thereof) that Opposer has served on Twitter to date in this proceeding underscore the inferiority of written questions and responses as an effective discovery tool compared to live testimony, demonstrating the need for live cross-examination in this case. Moreover, Opposer commenced this proceeding in the United States against Twitter’s application. Allowing Opposer to avoid equal disclosure of discoverable information through vague and incomplete written responses not subject to live cross-examination—particularly where Opposer’s claim is based on an intent-to-use application for which no proof of use has been made of public record with the U.S.P.T.O.—will make it difficult for Twitter to gather adequate information to confront Opposer’s claims. And as Twitter’s offices and witnesses *are* located in the United States, Opposer is able to benefit from the advantages of live depositions, while refusing the same to Twitter.

Second, the Board has found that good cause based on a party’s argument it “needed information on facts within [the other party’s] control” and thus required the live deposition of a deponent located *in England*. *Orion*, 12 U.S.P.Q.2d at 1925. As set forth above, the only officers/representatives that Opposer has identified as having knowledge relevant to this proceeding all reside in the United Kingdom. Knowledge regarding Opposer’s sales and marketing efforts, use and intended use of the STORM mark, selection and adoption of the

STORM mark, and filing of Opposer's STORM Application in the United States¹ is decidedly within the control of such individuals. Accordingly, there is good cause for Twitter to conduct oral examinations of those individuals.

B. The parties to be deposed would be subject to minimal inconvenience if required to submit oral depositions.

Requiring Opposer's representatives to sit for video depositions so that their depositions may be taken by oral examination will cause little inconvenience to Opposer. First, the Board has held that the equities favor depositions by oral examination where the taking of the foreign representatives' depositions will not "involve problems of translating to and from a foreign language." *Orion*, 12 U.S.P.Q.2d at 1925. Thus, the fact that Opposer's representatives are native English speakers weighs in favor of granting Twitter's motion.

Second, Twitter would bear the lion's share of any cost incurred with the depositions in having to coordinate an appropriate location and court reporter near Opposer's representatives. Opposer, on the other hand, would have to engage in minimal travel to the site of the deposition, and Opposer's attorney could attend the deposition via videoconference, obviating any need for Opposer's counsel to travel to the United Kingdom.

Significantly, even if the parties' attorneys attended the depositions in the United Kingdom, the equities would still tip in Twitter's favor. In ordering the oral depositions of applicant's foreign representatives in England in *Orion*, the Board found noteworthy that the moving party's counsel was located in San Francisco, whereas counsel for the foreign deponent was in New York City and held that the deponent's counsel would presumably encounter less expense than the moving party's attorney. 12 U.S.P.Q.2d at 1925. Likewise here, Twitter's counsel is located in California and Opposer's counsel is located in Washington, D.C., and thus

¹ As reflected in Exhibit A to Twitter's Notice of Opposer's 30(b)(6) deposition, Twitter will seek further information regarding these, as well as other topics, in that deposition.

travel to the United Kingdom would presumably be more expensive and time consuming for Twitter's counsel.

Because the little (if any) inconvenience to Opposer of conducting video depositions is clearly and significantly outweighed by the value of live testimony regarding topics in Opposer's control, Twitter has shown good cause for depositions by oral examination.

III. CONCLUSION

Accordingly, for good cause shown, Twitter respectfully requests that the Board grant Twitter's motion and order that those of Opposer's officers/representatives on whom Twitter has served deposition notices, namely, Martin Taylor and Opposer's designated 30(b)(6) witness, submit to depositions by oral examination, to be taken by videoconference or in person.

KILPATRICK TOWNSEND &
STOCKTON LLP

Dated: February 3, 2016

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	:	
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CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing MOTION TO TAKE DEPOSITIONS OF FOREIGN DEponents BY ORAL EXAMINATION AND BRIEF IN SUPPORT has been served on Opposer by depositing said copy with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to:

Janet F. Satterthwaite
Potomac Law Group
1300 Pennsylvania Ave NW
Washington, DC 20004

Dated: February 3, 2016

/s/Alberto Garcia
Alberto Garcia