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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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Signature	/Joseph Petersen/
Date	03/08/2016
Attachments	Twitter_s REPLY ISO its Motion to take Live Deposition Testimony for Good Cause Shown.pdf(21070 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,	:	
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v.	:	
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TWITTER, INC.,	:	
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Applicant.	:	
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**TWITTER, INC.’S REPLY BRIEF IN SUPPORT OF ITS MOTION TO TAKE
DEPOSITIONS OF FOREIGN DEONENTS BY ORAL EXAMINATION**

Applicant Twitter, Inc. (“Twitter”) respectfully submits this reply brief to address arguments raised by Opposer Content Guru Limited (“Opposer”) in its opposition to Twitter’s Motion to Take Depositions of Foreign Deponents by Oral Examination.

After cutting through Opposer’s rhetoric, it is clear not only that Opposer’s complaints regarding a video deposition are unfounded and unsupported by any authority, but that Opposer has ignored the relevant standard for determining whether a party has shown good cause for taking the oral deposition of a foreign party. As explained in *Orion Grp. Inc. v. The Orion Ins. Co. PLC*, 12 U.S.P.Q.2d 1923, 1925 (T.T.A.B. 1989), whether good cause has been shown must be determined “on a *case-by-case basis*, upon consideration of the particular facts and circumstances in each situation.” (emphasis added.) Further, 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.” *Id.*

Here, Twitter has demonstrated good cause for its narrow request to take the live depositions of one of Opposer’s witnesses and Opposer’s 30(b)(6) designee (who may be the same individual), and the equities clearly weigh in Twitter’s favor. Twitter’s motion is timely in view of the likely inadequate time left in discovery; Opposer’s vague discovery responses have made clear that written affidavits will be inadequate, and Opposer will suffer little, if any, financial hardship from a video deposition—a technological solution that provides a convenient and relatively inexpensive means of taking live depositions of Opposer’s representatives in the United Kingdom. Accordingly, the Court should grant Twitter’s motion.

As an initial matter, Twitter’s motion is not premature. Twitter timely filed its motion upon the service of the notices of deposition to which its motion is directed, and did so early enough to allow the motion to be fully briefed, for the Board to consider and rule on the issue, and for the parties to continue and conclude discovery within the scheduled period. Significantly, Twitter now has less than three months left¹ to receive documents from Opposer (which has yet to produce any documents or provide a date for its production); review those documents; schedule, coordinate, and take depositions; and serve any post-deposition discovery requests before discovery closes. While Opposer would have Twitter sit on its hands and wait for documents Opposer has yet to produce, such a “wait-and-see approach” would likely leave Twitter with no time to submit a subsequent motion, await its consideration and then take its depositions and follow-up discovery once its motion were granted. Twitter’s motion is clearly timely, and Opposer’s argument that Twitter’s motion is premature is misplaced.

¹ Based on the Board’s original order, discovery in this case was set to close April 18, 2016, Dkt. 2, and following the Board’s grant of Opposer’s motion for an extension, the discovery period was extended a month to May 18, 2016, Dkt. 10.

In addition, Opposer's arguments attempting to distinguish cases cited by Twitter—namely, the Board's decision in *Orion*—disregard *Orion*'s statement of the general rule that the Board considers whether to allow oral depositions on a “case by case basis.” 12 U.S.P.Q.2d at 1925. While *Orion*'s facts are not identical to those here, that is not detrimental to Twitter's motion; indeed, given the dearth of authority on this issue—evidenced by Opposer's failure to cite *any* authority in its favor—it is not surprising that no reported case is exactly on all fours with this proceeding. However, taking the specific facts of this case and the Board's case-by-case standard stated in *Orion*, Twitter has shown good cause for taking the live depositions, via videoconference, of Opposer's representatives.

Here, Opposer has provided vague interrogatory responses, has not produced any documents, and names only representatives residing in the United Kingdom as persons with relevant knowledge (despite claiming in its Notice of Opposition to have made prior actual use of its mark in the United States). More specifically, Opposer's discovery responses do not provide any details regarding its original selection and adoption of the STORM Mark, its claimed prior use and future intended use of its mark in the United States, or its U.S. sales and marketing efforts in connection with the mark. Twitter should be permitted to direct live questions on these issues to the one or two noticed deponents—the very persons Opposer identified as having the most relevant knowledge—particularly in light of Opposer's failure to provide details in its responses to Twitter's interrogatories and its failure to produce any documents. Opposer's written discovery responses (or lack thereof) demonstrate Twitter's need for live deposition testimony, as simply asking additional written questions will undoubtedly result in similarly incomplete and vague responses.

Opposer accuses Twitter of “twisting” the balance of the equities but it is Opposer's

argument that it cannot prepare its witnesses and defend a videoconference deposition that rings hollow. Opposer fails to explain why a video deposition would prevent Opposer's counsel from preparing its witness(es). Certainly Opposer—a sophisticated technology and telecommunications company—has the ability to hold deposition preparation sessions with its U.S. counsel via phone and videoconference; presumably Opposer would need to hold similar sessions anyway to coordinate with its U.S. counsel to respond to depositions on written questions.

Moreover, Opposer can similarly and capably defend its witness during the videoconference deposition. Indeed, the attendance and taking of depositions by remote means is a common practice, not only permitted by the Board and the Federal Rules, but favored for its cost benefits. *See, e.g., Hewlett-Packard Co. v. Healthcare Personnel Inc.*, 21 U.S.P.Q.2d 1552, 1552-53 (T.T.A.B. 1991) (“In applying and interpreting our rules the Board must look to federal court practice, and currently federal practice favors the use of technological benefits in order to promote flexibility, simplification of procedure and reduction of cost to parties.”); *see also Guillen v. Bank of Am. Corp.*, No. 10-05825 EJD PSG, 2011 WL 3939690, at *1 (N.D. Cal. Aug. 31, 2011) (noting that leave to take remote depositions “is granted liberally” and that “[a] videoconference deposition is cost-effective since it avoids or minimizes expensive travel time and costs”). As is the standard practice in videoconference depositions, exhibits will be circulated to all participating parties and counsel in advance, and Opposer's counsel can just as easily interject and object to questions and discuss matters with Twitter's counsel during a live videoconference as she could in person. Opposer's counsel can also hold separate and private video or telephone meetings to confer with her witness(es) as needed prior to the deposition or during breaks. Opposer, a sophisticated technology company, is certainly no stranger to

videoconferencing technology. Further, Opposer will incur very little additional costs, if any, by having to attend video depositions, while Twitter would bear the costs of setting up the videoconference, including the costs of an appropriate facility and court reporter in London.

In balancing the equities, it is also important to note that it was *Opposer* who commenced this proceeding *in the United States* against Twitter's application, and in its pleadings claims to be using its mark *in the United States*. Clearly, it is inequitable for Twitter to be forced to depose Opposer's representatives, particularly its 30(b)(6) representative, solely through written questions (a process that has proved of little value thus far) when Opposer has the benefit of taking the live depositions of Twitter's representatives. Opposer should not be allowed to evade equal disclosure of discoverable information simply by failing to identify any U.S. individuals involved in its sales and marketing efforts in the United States, or at least making its representatives available for depositions by videoconference.

Because Twitter has shown good cause and that the equities weigh heavily in its favor, the Court should grant Twitter's motion and order that those of Opposer's officers/representatives on whom Twitter has served deposition notices, namely, Martin Taylor² 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: March 8, 2016

By: /s/Joseph Petersen
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² Twitter anticipates that it is likely that Martin Taylor, Director and Co-founder of Content Guru and the only representative of Opposer identified in Opposer's initial disclosures, will likely be designated as Opposer's 30(b)(6) representative. Twitter therefore essentially seeks only a single deposition via videoconference.

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CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing TWITTER, INC.'S REPLY BRIEF IN SUPPORT OF ITS MOTION TO TAKE DEPOSITIONS OF FOREIGN DEPONENTS BY ORAL EXAMINATION 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: March 8, 2016

/s/Alberto Garcia
Alberto Garcia