

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

CME

Mailed: April 8, 2016

Opposition No. 91223882 (parent)

Opposition No. 91223940

*Express Communications, LLC*

*v.*

*Samsung Electronics Co., Ltd.*

Christen M. English, Interlocutory Attorney:

Pursuant to Applicant's request, on April 8, 2016, the Board convened a telephone conference to hear Applicant's oral motion to compel the discovery deposition of Jeffrey Volk, Manager of Opposer. Matthew Googe participated on behalf of Opposer, Christopher Lay and Angela Kalsi participated on behalf of Applicant, and the assigned Interlocutory Attorney participated on behalf of the Board.

By way of background, Applicant first served a notice of deposition for Mr. Volk on December 23, 2015 in connection with the parent case captioned above. 8 TTABVUE 4-5. After consolidation of the above-captioned proceedings, Applicant served a second notice of deposition for Mr. Volk on February 1, 2016. *Id.* at 6-7.

On March 15, 2016, pursuant to Applicant's request, the Board convened a telephone conference (the "March 2016 Teleconference") to address Applicant's difficulties in scheduling the discovery deposition of Mr. Volk. During the March

2016 Teleconference, Applicant asserted that Opposer had been unresponsive to its numerous e-mail communications requesting possible dates for Mr. Volk's deposition. In response, Opposer offered that Mr. Volk was available for his deposition, among other dates, the week of April 18, 2016. The parties then agreed that Mr. Volk's deposition would take place on April 18, 2016 in Knoxville, Tennessee at 9:00 a.m. 7 TTABVUE.

In its oral motion to compel, Applicant asserts that a couple of hours after the March 2016 Teleconference, Opposer informed it that Mr. Volk was not, in fact, available to be deposed on April 18, 2016; that it attempted to contact Opposer numerous times to obtain an alternate date for Mr. Volk's deposition; that Opposer did not respond until after Applicant informed Opposer that it had contacted the assigned Interlocutory Attorney to intervene; that Opposer informed Applicant that Mr. Volk was available to be deposed on Fridays only; that Opposer proposed to reschedule Mr. Volk's deposition for April 29, 2016 or May 13, 2016; and that Applicant responded that it was not available to participate in a deposition on April 29, 2016 and that the proposed May 13, 2016 date was not acceptable because it was more than four months after Applicant first noticed Mr. Volk's deposition.

In response, Opposer asserts that there was a miscommunication between Opposer's counsel and Mr. Volk regarding Mr. Volk's availability to be deposed; that Opposer's counsel mistakenly believed Mr. Volk was available to be deposed on April 18, 2016 as the parties agreed; that Opposer immediately informed Applicant that Mr. Volk would not be available to be deposed on April 18, 2016; that Opposer

is not attempting to avoid the deposition of Mr. Volk; and that it offered April 29, 2016 and May 13, 2016 as alternate deposition dates in a good faith effort to resolve the discovery dispute with Applicant.

As an initial matter, the Board finds that Applicant made a good faith effort to resolve its discovery dispute with Opposer prior to seeking Board intervention.

Turning to the merits of Applicant's motion, and as discussed during the teleconference, the Board does not find that Opposer is acting in bad faith to avoid the discovery deposition of Mr. Volk, but the Board understands and shares Applicant's frustration over the difficulty in scheduling Mr. Volk's deposition. As the assigned Interlocutory Attorney explained during the teleconference, the Board looks with disfavor on plaintiffs in *inter partes* proceedings who do not cooperate in the discovery process. Opposer commenced these consolidated opposition proceedings and bears the burden of proof. As such, it must be prepared to engage in discovery – including discovery depositions – concerning the claims it has asserted.

Accordingly, and as discussed during the teleconference, Applicant's motion to compel is **GRANTED** to the extent that Opposer is order to produce Mr. Volk for his discovery deposition on May 13, 2016 at 9:00 a.m. in Knoxville, Tennessee.<sup>1</sup> The parties will work together to schedule the exact location for the deposition.<sup>2</sup> If

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<sup>1</sup> Opposer stipulated to the deposition in Knoxville, Tennessee where its counsel is located. *See* Trademark Rule 2.120(b).

<sup>2</sup> During the teleconference, Opposer indicated that it will stipulate to a thirty-day extension of the discovery period for Applicant if, after the deposition of Mr. Volk, Applicant believes such an extension is necessary.

Opposition Nos. 91223882 and 91223940

Opposer fails to comply with this order, it may be subject to sanctions, potentially including the entry of judgment against it. *See* Fed. R. Civ. P. 37(b)(2); Trademark Rule 2.120(g).

Dates remain as set in the Board' order of January 7, 2016.

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