

12-23-2002

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #73

TAB

UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD

BELL, INCORPORATED

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Petitioner,

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v.

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Cancellation No. 31904

BELL PACKAGING CORPORATION

\*

Respondent.

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The Trademark Trial and Appeal Board  
U.S. Trademark Office  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

DEC 27 11 56 AM '02

**BRIEF IN OPPOSITION TO RESPONDENT'S MOTION  
TO QUASH AND RELATED MOTIONS**

Respondent's Motion to Quash and two related motions, filed December 12, 2002, is Respondent's only response to Petitioner's Notice of Testimonial Deposition by written questions. It did not serve cross questions, nor serve written objections to the questions, as it might have done under Rule 2.124(d)(1).

**I. RESPONDENT'S FIRST MOTION**

Respondent's first Motion (under TBMP 521) is based on (i) there was not due notice of the proposed deposition; and (ii) the deposition schedule failed to follow the procedures for such depositions.

**Petitioner's Notice was Timely and  
Complied with all Requirements of the Rule**

Under Rule 2.124(b)(1), petitioner is required to serve respondent with a notice of taking a testimonial deposition upon written questions within ten days from the opening of date of petitioner's testimony period. That period opened November 15, 2002. Petitioner served its notice November 22, 2002, clearly within that ten day period.

In its notice, petitioner specified that the deposition would take place on December 2, 2002 because it had been informed by the officer (before whom the deposition was to be taken) of that scheduled date. However, it is not required that the notice specify the date on which such deposition will occur, presumably because that date is not relevant to any of the responses an adverse party may wish to make. It is the date of service of the notice, which is significant. Cross questions may be served within twenty days of the notice. Rule 2.124(d)(1). The twenty days run from service of the notice, without regard to when the deposition may occur.

Furthermore, Rule 2.124(d)(2) provides that upon receipt of notice of testimonial deposition upon written questions, the TTAB shall suspend or reschedule other proceedings to allow for orderly completion of the depositions upon written questions.

It cannot be reasonably asserted that petitioner's timing of its notice, or scheduling of the deposition in any way prejudiced respondent's ability nor limited its schedule to serve cross questions and objections; nor was in any way inconsistent with the requirements for depositions upon written questions.

**II. RESPONDENT'S SECOND MOTION**

Respondent's second motion (under TBMP 532) requests the Board to order that the

deposition be taken on oral examination. It must show good cause and a reason why the Board should contravene petitioner's exercise of the procedural option provided under Rule 2.124(d).

Respondent has not shown any such good cause. So far as petitioner can understand respondent's reasons for this motion, they seem to be objections to basic idea of depositions by written questions. "Respondent cannot adequately prepare cross-examination questions or follow up questions..." (Page 3, para.2 of Respondent's Motions). "The format...is not appropriate for...it allows the witness an opportunity to be aware of all the questions in advance..." (Page 3, para.3). "The types of questions does not provide respondent any information of the evidence intended to be put into the record through this witness." (Page 5, para. 1).

It should be noted that on October 2, 2002, petitioner submitted a Motion for Summary Judgment, that was based largely on the affidavit of Mark Graham (copy attached hereto as Exhibit 1) which has 14 sentences, which express the exact same information that is elicited by the 12 written questions presented in petitioner's Notice of Testimonial Deposition. The written questions are even presented in the same order as those in the affidavit. The Exhibit 1 of the affidavit, (initial pages of tax returns) is the same as Exhibit A of the written questions. Exhibit 3 of the affidavit are the same as Exhibit B of the written questions.

So, since October 2, 2002 respondent has had all of the information and seen all of the exhibits that will result from the deposition on written questions.

**III. THERE IS NO GOOD CAUSE THAT THIS DEPOSITION BE TAKEN ON ORAL EXAMINATION.**

The basis for the petition to cancel respondent's registration is petitioners's prior use of the same mark (i.e., BELL) for the same goods (i.e., paper or paperboard packaging). So

petitioner needs only to prove it has been in the business of designing, manufacturing and selling paperboard packaging under the name BELL for at least the past ten years. It is a fairly simple premise. It does not involve subtle issues as to confusing similarity of the marks and goods. The witness is testifying only as to factual matters, the basic aspects of which could easily be verified by respondent. It is difficult to imagine what kind of cross questions or follow up, respondent might want to ask and respondent has suggested none. Indeed, respondent has served no written questions, as it might have done under Rule 2.124(d)(1).

TBMP 532 states that the determination of what constitutes good cause is made on a case-by-case basis and it refers to several prior decisions as guidelines. A review and analysis of those cases disclose the following.

The *Century 21* case involved testimony of an expert witness concerning the accuracy and validity of a telephone survey applicant had conducted and introduced into evidence. This would involve controversial testimony and opinion. Furthermore, the deposition by written questions was to be taken during opposer's rebuttal period, meaning that applicant had no opportunity to offer counter evidence. So the Board found good cause that the deposition should be taken by oral examination.

In the *Feed Flavor* case, former employees of respondent (who were now employees of petitioner) were to testify by written questions as to respondent's prior knowledge of petitioner's use of its trademark. As in the *Century 21* case, this deposition by written questions was to occur during petitioner's rebuttal period thus precluding respondent from offering counter evidence.

*Fischer GmbH* involved an attempt to use a deposition by written questions during the discovery period. The testimony related to survey evidence.

In the *Orion* case, a discovery deposition was to be taken in a foreign country by written questions. Opposer argued that oral examination was necessary because, among other things, "the factual issues involved herein are unusually complex and depend on a myriad of factors." The Board found that opposer had shown good cause for the deposition to be taken orally.

The present case has none of the significant factors in these cited cases. Petitioner's deposition by written questions is not taking place during its rebuttal period, but during its initial testimony period, so respondent can present contrary evidence (if it has any) during its testimony period. Furthermore, the written questions are not directed to survey evidence, opinions or speculations. The factual and legal issues involved are not complex, and not dependent on myriad factors.

Petitioner submits that its written questions are few in number, the issues are simple and it is an appropriate use of deposition by written questions. Respondent has shown no good cause to the contrary.

For the foregoing reasons it is respectfully submitted that Respondent's Motion to Quash and other motions be denied.

Respectfully submitted,  
BELL, INCORPORATED

  
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J.W. Gipple  
Gipple & Hale  
Attorneys for Petitioner

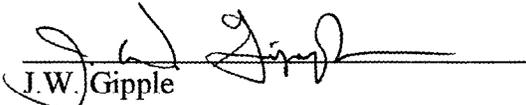
December 19, 2002  
J.W. Gipple  
GIPPLE & HALE  
(703) 448-1770 Ext. 302  
P. O. Box 40513  
Washington, D.C. 20016

**CERTIFICATE OF MAILING AND SERVICE**

I hereby certify that the foregoing **BRIEF IN OPPOSITION TO RESPONDENT'S MOTION TO QUASH AND RELATED MOTION** is being mailed first class U.S. mail, postage prepaid to Trademark Trial and Appeal Board, U.S. Trademark Office, 2900 Crystal Drive, Arlington, Virginia 22202-3513 and upon Counsel for OPPOSER:

Priscilla L. Dunckel, Esquire  
Baker Botts, LLP  
2001 Ross Avenue  
Suite 600  
Dallas, Texas 75201-2980

this 19<sup>th</sup> day of December, 2002.

  
J.W. Gipple  
Attorney for Applicant

GIPPLE & HALE  
P. O. Box 40513  
Washington, D.C. 20016  
(703) 448-1770 Ext. 302

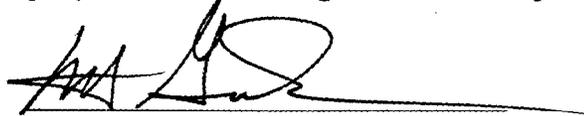
**EXHIBIT 1**

AFFIDAVIT OF MARK GRAHAM

I, the undersigned, Mark Graham, do hereby swear and affirm as follows:

1. I am 56 years of age, a citizen of the United States of America and domiciled in Sioux Falls, South Dakota.
2. I acquired all assets of Bell Paper Box, Inc. in 1976. At that time its business was the manufacture and sale of paper and paperboard packaging products. It had annual sales of approximately \$40,000.
3. From the records of Bell Paper Box, Inc. (hereinafter referred to as "the Company"), which I acquired in 1976, I found evidence that the company had been in paper and paperboard packaging products business nationwide since 1920.
4. Since my acquisition of the company, and to the present day, it has continuously remained active in the business of designing, manufacturing, promoting and selling paperboard packaging products to customers throughout the United States.
5. For the past ten years, the company's annual sales of paperboard packaging products have increased from approximately \$18,000,000 to in excess of \$30,000,000.
6. I attached hereto as Exhibit 1, the initial pages of the company's tax returns for the past ten years.
7. I attach hereto as Exhibit 2, the initial pages of audit reports for the past ten years.
8. Continuously since 1976 (and to my best knowledge and belief, long prior thereto) the company has used BELL or BELL PAPER BOX as its trade name, and it is so known to its customers and in its industry.

9. Continuously since 1976, the company has also used BELL or BELL PAPER BOX as a service mark in connection with its service of custom designing and producing paperboard containers for specific customer's needs, and as a trademark applied to some of its containers.
10. I attach hereto as Exhibit 3, an example of service mark use.
11. I attach hereto as Exhibit 4, an example of trademark use.
12. Continuously, and consistently since 1976, all of the company's advertising has been directed to promoting its trade name and marks BELL and BELL PAPER BOX.
13. I attached hereto as Exhibit 5, reports reflecting the company's advertising budget for the past several years.
14. In December of 2000, the company's name was changed to Bell Incorporated.

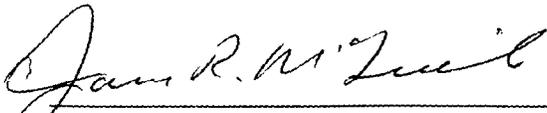


Mark Graham

September 27, 2002

COUNTY OF: LINCOLN )  
STATE OF SOUTH DAKOTA )

On this day, September 27, 2002, MARK GRAHAM appeared before me, a Notary Public in and for the County and State above written, and acknowledged to me that the above is true and correct to the best of his knowledge and belief and that he executed the same, under oath and under penalty of perjury as his true and correct statement.

  
NOTARY PUBLIC

My Commission Expires:  
OCTOBER 8, 2002