

ESTTA Tracking number: **ESTTA186094**

Filing date: **01/11/2008**

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

Proceeding	92042082
Party	Defendant International Gold Star Trading Corp.
Correspondence Address	Roger S. Thompson Cohen, Pontain, Lierberman & Pavane 551 Fifth Avenue New York, NY 10176 UNITED STATES
Submission	Motion to Quash
Filer's Name	Roger S. Thompson
Filer's e-mail	docket@cplplaw.com, rthompson@cplplaw.com
Signature	/Roger S. Thompson/
Date	01/11/2008
Attachments	5060-2L Motion to Quash.pdf (7 pages)(525203 bytes) 5060-2L Motion to Quash - Dec. of R. Thompson.pdf (3 pages)(285495 bytes) 5060-2L Motion to Quash - Ex A.pdf (5 pages)(189972 bytes) 5060-2L Motion to Quash - Ex. B.pdf (1 page)(93675 bytes)

hereinafter: "Thompson Dec., ¶ ___"). Pursuant to 37 C.F.R. § 2.124(b)(1), Petitioner filed (by mail) a copy of the Notices, but not the questions, with the Board (Docket Entry No. 44). Attached as Exhibit A to the Thompson Declaration is a copy of the (single) set of the proposed written questions served (but not filed). (Thompson Dec., ¶ 5). Attached as Exhibit B to the Thompson Declaration is a copy of the sole page of "exhibits" attached to the Notices. (Thompson Dec., ¶ 5).

The Notices of Written Deposition are substantially identical, differing only in the name and address of the individual witness named in each Notice. Each Notice specifies that the individual proposed written deposition "will be taken before a person authorized by law to administer oaths".

Counsel for both registrant and petitioner are located in Manhattan, New York City. (Thompson Dec., ¶ 6). Nine of the named deponents are located in Brooklyn, New York, and the tenth is in Hillside, New Jersey, approximately 15 miles from the office of counsel for Petitioner. (Thompson Dec., ¶ 7).

There is no information available to counsel for registrant to suggest that any of the deponents are scheduled to be out of the country at any time in the future. (Thompson Dec., ¶ 8).

Registrant hereby moves to quash the Notices for failing to specify the "name or descriptive title" of the person before whom the proposed written depositions will be taken, and, if the Notices are not quashed, to compel the taking of the depositions on oral questions. If the Board denies these motions, so that the depositions on written questions proceed, registrant requests that its time to serve cross-examination question be extended, to permit registrant to prepare and serve written cross-examination question for the witnesses after any decision denying the first two prongs of the instant Motion.

Each Notice Fails to Comply with the Requirements of 37 C.F.R. § 1.124(c) and So Should be Quashed.

The requirements of 37 C.F.R. § 1.124(c) are clear:

“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.” (emphasis supplied)

This requirement is not permissive (“may be accompanied” or “should be accompanied”), but rather is mandatory (“*shall* be accompanied”).

Furthermore, 37 C.F.R. § 123(b) permits the taking of written depositions “before *any person authorized to administer oaths*” **only** where stipulated by the parties **in writing**. There has been no such stipulation.

The proposed Notices are therefore not in compliance with 37 C.F.R. § 1.124(c), and should be quashed. Although taking the proposed depositions upon written questions could be done before “anyone authorized to administer oaths” if the parties so agree, petitioner should not be allowed to arrogate to itself the right to impose such a stipulation upon registrant without its consent.

Thus, the ten Notices are facially non-compliant with the rules and should be quashed.

If Permitted to Proceed, the Proposed Depositions Should be Taken on Oral Questions

A party on whom a notice of taking deposition on written questions is served has the right, pursuant to 37 C.F.R. § 2.123(a)(1), and for good cause, to move the Board for an order that the deposition be taken by oral examination. Registrant respectfully submits that good cause exists in this case to order the depositions noticed to be taken on written questions to instead be taken on oral questions.

Depositions on written questions are generally “disfavored”, “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”, *Zito v. Leasecomm Corp.*, 233 F.R.D. 395, 397 (S.D.N.Y. 2006). There are only limited circumstances (not present here), where such depositions are “an adequate substitute” such as “where the issues to be addressed by the witness are narrow and straightforward and the hardships of taking an oral deposition would be substantial”, *Mill-Run Tours, Inc. v. Khashoggi*, 124 F.D.R. 547, 549 (S.D.N.Y. 1989).

Here, the taking of the depositions on written questions would be needlessly burdensome to the registrant, and provide unfair advantage to the petitioner.

First, it is noted that there are ten witnesses whose depositions have been noticed to be taken on written questions. Judging by the documents produced, these witnesses have many different potential connections to this proceeding, although registrant cannot know for certain the nature and scope of those respective connections. For example, some appear to be employees of competitors of the parties, perhaps alleged customers of petitioner, others appear to work for a printer, perhaps the printer who allegedly made labels for petitioner, while others work for a business services firm, whose potential testimony is uncertain. (Thompson Dec., ¶ 9).

Petitioner, however, has submitted only one set of questions (Exhibit A), each of which is apparently to be posed to each witness, so that cross-examination of these ten witnesses having disparate areas on knowledge must be prepared as though *each* witness has actual knowledge of *every* area on which questions are to be posed. Registrant would be unable to prepare suitable follow-up or additional questions without having an idea of the actual testimony of each of the ten prospective witnesses, which could only be ascertained after they each testified. Thus, the scattershot approach of serving ten notices of depositions on written questions of ten disparate witnesses but with one set of common questions can only be seen as an attempt to obscure the true nature of the questions to be asked to any one of the witnesses, thereby making even more important the ability to attend the depositions in person, so that the cross-examination and follow-up questions may be meaningful.

Second, as noted by the Court in *Zito, supra.*, the use of depositions on written questions “prevents the spontaneity of direct interrogation”, which would be detrimental to the registrant, here, when dealing with individuals who may have business interests inimical to the registrant’s business interests, or who may have favorable business relations with the petitioner. All of this is difficult to sound out, in advance, on written questions, and requires the in-person confrontation of an oral deposition to provide a full and fair opportunity to the registrant to explore possible bias and other issues.

Moreover, the noticed witnesses seem to be those that would be presenting a substantial part of the record that petitioner seeks to use as its case-in-chief, and so the witnesses’ testimony is likely to be contested, with the possibility of using rebuttal exhibits and/or documents to impeach each witnesses testimony and/or credibility. Depriving registrant of the opportunity to confront these potentially biased and hostile witnesses live, and providing the witnesses with potential cross-examination questions before actually responding to direct questions would permit these witnesses to tailor their testimony, potentially with the assistance of counsel, and foreclose truly meaningful examination.

Third, each of the witnesses is local, with nine being located in Brooklyn and one a short distance away in New Jersey, so there is no hardship or difficulty of record in serving them or securing their attendance at an oral deposition. Both counsel have offices in Manhattan, and both parties have offices in Brooklyn, so there is no issue of hardship for travel or difficulty in compelling attendance, if necessary, at an oral deposition. There is also no indication that any of these noticed individuals are either out of the country or planning to leave the country. Thus, securing their attendance at an oral deposition would be more orderly and facilitate the process of taking the depositions orally, rather than by written questions.

Fourth, the process of taking depositions on written questions is extremely drawn out, leading to even further delays in the ultimate resolution of this case, which is already quite old. Simple oral depositions would speed up the process immensely.

What constitutes "good cause" for compelling the taking of a deposition on oral questions must be evaluated on a case-by-case basis. *Feed Flavors Inc. v. Kemin Ind., Inc.*, 209 U.S.P.Q. 589, 591 (T.T.A.B. 1980). As the Board has noted, "[a] deposition on written question is a cumbersome, time-consuming procedure. . . . [I]t deprives an adverse party of the right to confront the witness and ask follow-up questions on cross-examination." T.B.M.P. § 703.02(m). While the procedure does have some utility, as where the deponent is located out of the country, or where the testimony is short and not likely to be disputed, *id.*, the circumstances that are recognized as providing that limited utility are not present in this case.

Registrant has demonstrated the existence of several factors, each of which, it is submitted, constitutes good cause for the taking of these depositions on oral questions, and cumulative effect of which strongly demonstrates the propriety of requiring the depositions to be taken on oral questions. There is no evidence or information in the record sufficient to the above showing of good cause, or of any justification for requiring registrant to participate in the "cumbersome and time-consuming process" of ten depositions on written questions.

Accordingly, it is submitted that good cause exists to direct that the depositions, if permitted to go forward, should be taken on oral questions, and registrant therefore request the entry of an order compelling petitioner to follow that procedure.

If the Depositions on Written Questions are to Proceed, the Period of Time in which Registrant may Submit Cross-Examination Questions Should be Extended.

In the event that the Board denies both of the foregoing prongs of the instant motion, and permits the taking of the noticed depositions on written questions, registrant requests that the period in which it may propound questions on cross-examination be reset, so that registrant has the opportunity to cross-examine the witnesses, and not be compelled to undertake the preparation of cross-examination questions prior to the Board's determination of the instant motion.

Early and favorable action on the instant motion is respectfully solicited.

Respectfully submitted,
COHEN, PONTANI, LIEBERMAN & PAVANE

By



Roger S. Thompson
551 Fifth Avenue
New York, New York 10176
(212) 687-2770

Attorneys for Registrant,
International Gold Star Trading Corp.

Dated: January 11, 2008

CERTIFICATE OF SERVICE

I hereby certify that on the date set forth below, a true and correct copy of the foregoing Registrant's Motion to Quash Notice of Written Depositions or to Compel the Taking of Depositions on Oral Questions or to Extend the Time for Serving Cross-Examination Questions, was served by first class mail, postage prepaid, on counsel for petitioner, addressed as follows:

Samuel Friedman, Esq.
225 Broadway, Suite 1804
New York, New York 10007



Roger S. Thompson
Counsel for Registrant

January 11, 2008
Date

items made upon information and belief, which statements are believed to be true after a search of the files at CPLP.

4. On December 26, 2007, I received in the mail a set of ten Notices of Testimonial Deposition from counsel for petitioner, Four Seasons Dairy, Inc. These Notices bore a date of December 22, 2007, certified by counsel as the date on which they were mailed to me.

5. Upon information and belief, petitioner filed (by mail) a copy of the Notices, but not the questions, with the Board (Docket Entry No. 44). The proposed written questions were not filed. Attached as Exhibit A is a true and correct copy of the (single) set of the proposed written questions served (but not filed). Attached as Exhibit B is a true and correct copy of the sole page of "exhibits" attached to the Notices.

6. Counsel for both registrant and petitioner are located in Manhattan, New York City.

7. Nine of the named deponents are located in Brooklyn, New York, and the tenth is in Hillside, New Jersey, approximately 15 miles from the office of counsel for Petitioner, according to my search on Mapquest.com.

8. There is no information available to me to suggest that any of the deponents are scheduled to be out of the country at any time in the future.

9. None of the witnesses named in the proposed testimonial depositions have been deposed during the discovery phase of this cancellation. Judging by the documents produced by petitioner during discovery, however, these witnesses have many different potential connections to this proceeding, although registrant cannot know for certain the nature and scope of those respective connections. For example, some appear to be

employees of competitors of the parties, perhaps alleged customers of petitioner, others appear to work for a printer, perhaps the printer who allegedly made labels for petitioner, while others work for a business services firm, whose potential testimony is uncertain.

10. I make this declaration under penalties of perjury.

By


Roger S. Thompson
551 Fifth Avenue
New York, New York 10176
(212) 687-2770

Dated: January 11, 2008

PETITIONER'S TESTIMONIAL DEPOSITION ON WRITTEN QUESTIONS

Instructions and Definitions

1. "Petitioner" or "Plaintiff" or "Four Seasons Dairy Inc." or "Four Seasons" means the Petitioner in this action.
2. "Registrant" or "International Gold Star Trading, Corp." or "Gold Star" shall mean the Registrant in this action.
3. "Gold Star's Mark" or "Babushka's Recipe" shall mean the mark owned by the Registrant, Registration No. 2,479,287.
4. "Petitioner's Mark" or "Four Seasons' Mark" or "Babushkino" or the "Babushkino Mark" or "БАБУШКИНО" shall mean the mark owned by the Applicant, Ser. No. 76-174746.
5. "The United States" or "United States" or "U.S." or "USA" shall mean The United States, its territories and possessions.
6. The terms "data", "document" and "documents" include correspondence, papers, books, messages, publications, recordings, literature, letters, photographs, price lists, brochures, memoranda, notes, reports, drawings, diaries, or any information that is stored electronically or otherwise and is capable of being retrieved, and any other writings whether in final or draft form and whether or not such draft was actually used or completed, or any "document" as otherwise described in Federal Rule of Civil Procedure 34.
7. The terms "identify" and "state the identify of" shall mean a complete identification to the best of the ability.
8. All questions are to be read so as to give the question the broadest possible meaning, so that, for example, when either the term "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.

Testimonial Deposition on Written Questions

- 1) Please state your full name?
- 2) What is your home address?
- 3) What is your business address?
- 4) Who is your current employer?
- 5) In what business is your employer engaged?
- 6) What position do you hold with your current employer?
- 7) How long have you held this position?
- 8) Have you ever held any other position with your current employer?
- 9) If so, what were these positions?
- 10) How long did you hold each position?
- 11) What are your job responsibilities with your current employer?
- 12) By whom have you been employed and what have you been your positions and responsibilities since January 1, 1997?
- 13) Are you aware of Four Seasons?
- 14) Are you aware of products sold by Four Seasons Dairy Inc.?
- 15) What products are you aware of that are sold by Four Seasons?
- 16) Under what marks does Four Seasons sell dairy products and vegetable spreads?
- 17) What products does Four Seasons sell under the Babushkino Mark?

- 18) Since when did Four Seasons sell dairy products under the Babushkino Mark?
- 19) Please describe the basis of your knowledge for your answer to the question above.
- 20) Since when did Four Seasons sell vegetable spreads under the Babushkino Mark?
- 21) Please describe the basis of your knowledge for your answer to the question above.
- 22) Since when did Four Seasons sell butter blend under the Babushkino mark?
- 23) Please describe the basis of your knowledge for your answer to the question above.
- 24) Does your company do business with Four Seasons?
- 25) Please describe the business that your company transacts with Four Seasons?
- 26) Does any of the business that your company transacts with Four Seasons involve the Babushkino Mark as used on dairy products or vegetable spreads or butter blend?
- 27) Please describe this business?
- 28) Approximately when did your company start transacting this business with Four Seasons?
- 29) How often does your company transact the above-described business with Four Seasons?
- 30) Has your company continuously transacted the above described business with Four Seasons?
- 31) Are you familiar with A&O Corp.?
- 32) Did you or your company transact business with A&O Corp.?
- 33) Are you aware that A&O Corp. was composed of the same principals, Alexander Bekker and Oleg Kessler, as Four Seasons?

- 34) Are you aware that A&O Corp. was the predecessor to Four Seasons?
- 35) What business, if any, did your company transact with A&O Corp. in relation to dairy products and vegetable spreads sold under the mark Babushkino?
- 36) Please provide the approximate dates for your answer to the question above?
- 37) Did you previously sign any statements in relation to this proceeding.
- 38) Please identify any such statements.
- 39) I hand you what has been marked as Petitioner's Exhibit 1 (also marked with bates stamp number P 0022), please identify it?
- 40) Is Petitioner's Exhibit 1 representative of the Babushkino Mark found on the goods distributed by Four Seasons?
- 41) Are you familiar with International Gold Star?
- 42) Does International Gold Star distribute food products?
- 43) Are you familiar with the line or lines of food products sold by International Gold Star?
- 44) What are they?
- 45) Do you know whether International Gold Star sells products under the brand name of Babushka's Recipe?
- 46) Does International Gold Star sell any dairy products under the brand name Babushka's Recipe?
- 47) If so, please identify the products?
- 48) Does International Gold Star sell any marinated vegetables under the brand name Babushka's Recipe?
- 49) When, if ever, did International Gold Star begin selling dairy products under the name of Babushka's Recipe.

- 50) When, if ever, did International Gold Star begin selling marinated vegetables under the mark Babushka's Recipe?
- 51) Did Four Seasons start selling dairy products under the mark Bubushkinos' before International Gold Star started selling dairy products under the mark Babushka's Recipe.
- 52) Did Four Seasons Dairy start selling vegetable spread under the mark Bubushkinos' before International Gold Star started selling marinated vegetables under the mark Babushka's Recipe.
- 53) Did Four Seasons start selling butter blend under the mark Babushkino before International Gold Star started selling dairy products or marinated vegetables under the mark Babushka's Recipe.

Respectfully submitted,

Dated: December 22, 2007

By:



Samuel Friedman, Attorney at Law
225 Broadway, Suite 1804
New York, New York 10007
Tel. (212) 267-2900
Attorney for Petitioner



PETITIONER'S EXHIBIT 1

