

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Baxley

Mailed: January 18, 2008

Cancellation No. 92042082

Four Seasons Dairy, Inc.

v.

International Gold Star
Trading Corp.

Andrew P. Baxley, Interlocutory Attorney:

On December 22, 2007, petitioner filed with the Board and served upon respondent notices of testimony depositions upon written questions of Leo Nigro, Arkadiy Golub, Leon Sheikhet, Mark Goulumb, Arie Zhurinam, Edward Kraven, Aron Walewitsch, Mark Gorereck, Sonya Sheyduassel, and Alexander Bob.

On January 11, 2008, respondent filed a motion to quash those notices of depositions and to require that the noticed depositions be taken orally or, in the alternative, to extend its time in which to serve cross-examination questions.¹ Inasmuch as the issues presented in

¹ A review of the record herein indicates that, on August 21, 2007, respondent filed an affidavit under Trademark Act Sections 8 and 15, 15 U.S.C. Section 1058 and 1065, in connection with its involved Registration No. 75865702, and that, on September 6, 2007, the Office's Post-Registration Division accepted the Section 8 affidavit and acknowledged the Section 15 affidavit. Because this proceeding was pending at the time of such filing, respondent could not properly file the Section 15 affidavit. See Trademark Act Section 15(2), 15 U.S.C. Section 1065(2).

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respondent's motion are simple and full briefing would delay resolution of respondent's motion by several weeks, the Board, in exercising its inherent authority to control the scheduling of cases on its docket, determined that the motion to quash should be resolved by telephone conference. See Trademark Rule 2.120(i)(1); TBMP Section 502.06 (2d ed. rev. 2004). On January 18, 2008, such conference was held among petitioner's attorney Samuel Friedman, respondent's attorney Roger Thompson, and Andrew Baxley, the Board attorney assigned to this case.

As an initial matter, the Board agrees with respondent that all of the notices of testimony deposition upon written questions at issue are procedurally improper because they state that the testimony deposition at issue will be taken "before a person authorized by law to administer oaths" and are not accompanied by the parties' written stipulations to take those depositions before such a person. Under Trademark Rule 2.124(c), a notice of deposition upon written questions "must be accompanied by the name or descriptive title of the officer before whom the deposition is to be taken." Parties may only take testimony depositions before any person authorized to administer oaths upon written stipulation of the parties. See Trademark Rule 2.123(b); TBMP Section 703.02(e) (2d ed. rev. 2004). Inasmuch as the parties have not stipulated in writing to the taking of the

depositions before any person authorized by law to administer oaths, the notices of deposition should have included the name or descriptive title of the officer before whom the depositions were to be taken.

The Board turns next to respondent's motion to require that petitioner's noticed depositions be taken by oral examination. Parties may take witness testimony depositions in Board *inter partes* cases upon oral examination or written questions. See Trademark Rule 2.123(a)(1). If a party serves notice of the taking of a testimony deposition upon written questions of a witness who is, or will be at the time of the deposition, present within the United States (or any territory which is under the control and jurisdiction of the United States), that party's adversary may file with the Board a motion, for good cause, for an order that the deposition be taken by oral examination.² See Trademark Rule 2.123(a)(1); TBMP Section 703.02(a) (2d ed. rev. 2004). What constitutes good cause for a motion to take a deposition orally must be determined on a case-by-case basis, upon consideration of the particular facts and circumstances in each situation. In determining such a

² Inasmuch as the notices of testimony depositions upon written questions at issue were served by mail, respondent was allowed until twenty days from the date of service to file such motion. See Trademark Rules 2.119(c) and 2.123(a)(1); TBMP Section 703.02(a) (2d ed. rev. 2004). Accordingly, respondent's motion was timely filed.

motion, the Board weighs the equities, including the advantages of depositions by oral examination and any financial hardship that the party to be deposed might suffer if the deposition were taken orally. See *Orion Group Inc. v. Orion Insurance Co., P.L.C.*, 12 USPQ2d 1923 (TTAB 1989).

Depositions upon written questions are useful for witnesses are located in foreign countries and in those cases where the testimony will be short, simple, straightforward, and not likely to be disputed, such as to establish for the record examples of third-party usage. See *Feed Flavors Incorporated v. Kemin Industries, Inc.*, 209 USPQ 589 (TTAB 1980); TBMP Section 703.02(m) (2d ed. rev. 2004).

However, the procedure for depositions on written questions is cumbersome and time-consuming and usually takes several months to complete. Such procedure requires that direct questions, cross questions, redirect questions, recross questions, and objections all be framed and served before the questions on direct examination have even been answered. See Trademark Rule 2.124(d)(1); TBMP Section 703.02(m) (2d ed. rev. 2004). Further, they deprive an adverse party of the right to confront witnesses and ask follow-up questions on cross-examination. See *Feed Flavors Incorporated v. Kemin Industries, Inc.*, *supra*; TBMP Section 703.02(m) (2d ed. rev. 2004).

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The Board notes that the parties' attorneys are both based in Manhattan, New York; that the parties and nine of the ten proposed witnesses reside in Brooklyn, New York; and that the remaining witness resides in Hillside, New Jersey, a nearby New York City suburb. Further, there is no indication that any of the witnesses will be outside of the United States or any territory which is under the control and jurisdiction of the United States at the time of the depositions.

In addition, a review of petitioner's direct questions that respondent submitted as an exhibit to its motion indicates that portions of the testimony of the proposed witnesses, such as information regarding the basis for witnesses' statements regarding the parties' sales of various items under the marks at issue herein, is likely to be disputed. Moreover, taking the testimony depositions of the proposed witnesses by the written question procedure will unreasonably delay this case and will deprive respondent of the right to confront witnesses and ask follow-up questions on cross-examination. Based on the foregoing, the Board finds that there is good cause for petitioner's noticed testimony depositions to be taken by oral examination.

In view thereof, respondent's motion to quash petitioner's notices of testimony deposition upon written

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question and to require that those depositions be taken by oral examination is granted. Petitioner's testimony depositions of Leo Nigro, Arkadiy Golub, Leon Sheikhet, Mark Goulumb, Arie Zhurinam, Edward Kraven, Aron Walewitsch, Mark Gorereck, Sonya Sheyduassel, and Alexander Bob must be re-noticed and taken by oral examination.³

Proceedings herein are resumed from the point where they stood when petitioner served and filed its notices of testimony deposition upon written questions. Petitioner will be allowed a testimony period of twenty days, the number of days remaining in its testimony period when it filed and served those notices.⁴ Remaining testimony periods are reset as follows.

Plaintiff's **20-day** testimony period to close: **March 14, 2008**

Defendant's 30-day testimony period to close: **May 13, 2008**

Plaintiff's 15-day rebuttal testimony period to close: **June 27, 2008**

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

³ The parties, petitioner's proposed witnesses, and their attorneys may attend such depositions by telephone. See Fed. R. Civ. P. 30(b)(7).

⁴ If petitioner needs additional time in which to take its testimony depositions, it may file a motion to extend its testimony period. See Fed. R. Civ. P. 6(b); TBMP Section 509.01 (2d ed. rev. 2004).

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Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.