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SANTANA'S GRILL, INC.

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

ARTURO SANTANA GALLEGRO

Petitioner,

v.

SANTANA'S GRILL, INC.

Registrant.

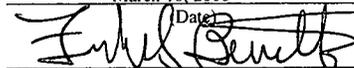
Cancellation Nos. 92043152
(Consolidated) 92043160
92043175

76345542

I hereby certify that this correspondence and all marked attachments are being deposited with Federal Express and addressed to Trademark Trial & Appeal Board, Trademark Assistance Center, Madison East, Concourse Level, Alexandria VA, 22314 on:

March 16, 2006

Date



Frederick S. Berretta

**REGISTRANT'S MOTION TO COMPEL AN ORAL TESTIMONIAL DEPOSITION OF
PETITIONER RATHER THAN BY WRITTEN QUESTIONS**

Registrant Santana's Grill, Inc. ("Registrant") hereby submits this Motion to Compel an Oral Testimonial Deposition Petitioner Rather Than By Written Questions and brief Memorandum in Support thereof. This Motion is prompted by the recent indication from Petitioner's counsel that Petitioner would not appear for a live oral deposition during Petitioner's testimony period, but would invoke the procedure to testify by written questions. Registrant



seeks a live oral testimonial deposition of Petitioner so that it may question and/or cross-examine Petitioner in preparation for trial so that it may more adequately prepare its defense.

I. INTRODUCTION

On March 26, 2004, Arturo Santana Gallego ("Petitioner") initiated three cancellation proceedings (now consolidated) against Registrant. In support of his Petitions to Cancel, Petitioner submitted three separate declarations asserting that he is the owner of all three registered trademarks and that Registrant obtained its three trademark registrations through fraud. Petitioner's pleadings have cavalierly leveled these serious accusations at both Registrant and Registrant's experienced trademark attorney despite having no supporting evidence of any intent to deceive the Trademark Office.

Although Petitioner is a United States citizen and makes frequent trips to the United States from his residence in the border-town of Tecate, Mexico, Petitioner is now hiding behind the border in an attempt to avoid having to provide live oral testimony. Under these facts, the Trademark Trial and Appeal Board ("the Board") should not permit Petitioner to rely solely on attorney-influenced, pre-scripted written questions and answers. The Board should give Registrant full opportunity to question and cross-examine Petitioner by live oral testimony to probe the veracity and bases for Petitioner's bold assertions so that it may have a full and fair opportunity to defend itself against these specious charges.

The written questions procedure is also unnecessarily complex and time-consuming in this case given the proximity of Petitioner to the United States and San Diego, and would result in further delays to the prejudice of Registrant which is seeking to enforce its trademarks against infringers. The Board should therefore compel Petitioner to testify by oral deposition rather than by written questions and answers as recently proposed by Petitioner's counsel.

II. RELEVANT BACKGROUND FACTS

For a detailed discussion of the facts relating to this consolidated cancellation proceeding, please reference Registrant's previously filed Motion for Summary Judgment on file herein. The following is a brief procedural summary.

These proceedings began in March of 2004. Near the end of the discovery period, both parties moved for summary judgment. The Board denied both motions on October 27, 2005. The parties are currently in Petitioner's testimony period, which will end on March 30, 2006. Registrant's testimony period closes on May 29, 2006. During telephonic discussions between counsel which took place on March 6th to schedule deposition testimony, counsel for Petitioner indicated that Petitioner would not appear for an oral deposition but would use the complicated procedure to take testimony on written questions and answers.¹

Petitioner is a United States citizen who lives in the Mexican border town of Tecate, only about an hour's drive from San Diego which is the situs of this dispute. He is able to freely cross the border and come and go into the United States, and has attended the discovery depositions of Registrant as well as an Early Neutral Evaluation Conference in the United States District Court in San Diego that took place before the stay of the federal action.

¹ Petitioner has not filed or served the formal notice for a testimonial deposition by written questions required by 37 CFR § 2.124(b)(1), TBMP Rule 703.02(e), and it appears that the ten day deadline from the opening of Petitioner's testimony period to provide such notice has now expired. This Motion is being brought out of an abundance of caution, however, that Petitioner might argue that "notice" was provided during the March 6th telephone conversation between counsel, and to seek a live testimonial deposition of Petitioner as a hostile witness during Registrant's testimony period.

III. THERE IS GOOD CAUSE FOR THE BOARD TO ORDER

PETITIONER TO TESTIFY ORALLY

A party may take an oral testimony deposition in a foreign country where the party can show “good cause” for oral, rather than written testimony. 37 C.F.R. § 2.120(a)(2). In determining whether “good cause” is present, “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.” *Orion Group Inc. v. Orion Ins. Co.*, 12 USPQ 2d 1923, 1925 (T.T.A.B. 1989) (citation omitted).

A. The Equities In This Case Weigh Heavily In Favor Of Requiring Petitioner To Testify Orally Rather Than By Written Questions

Petitioner’s refusal to testify orally unfairly precludes Registrant from effectively cross-examining him. The ability to cross-examine Petitioner is particularly important in this case given the heavily fact-dependent nature of this case – as demonstrated by the Board’s denial of the parties’ cross-motions for Summary Judgment – and Petitioner’s personal involvement in many of the disputed activities. For example, a dispute exists as to the circumstances of Petitioner’s transfer of a restaurant to Abelardo Santana, an owner of Registrant. There are also relevant facts about Petitioner’s alleged continuing role as a “licensor” of the disputed trademarks that Registrant must be allowed to explore directly with the witness.

Moreover, Petitioner has already refused to appear for an oral discovery deposition, so a testimony deposition will be Registrant’s only chance for meaningful questioning and cross-examination. Without an oral testimony deposition, Registrant would be left with Petitioner’s pre-scripted written responses to pre-written deposition questions, which would no doubt reflect extensive preparation with Petitioner’s counsel rather than Petitioner’s own testimony and

knowledge of the facts. Given the nature of the testimony, it would be unjust to deprive Registrant of “the valuable aid of confronting the witness by way of oral cross-examination.” *Century 21 Real Estate Corp. v. Century Life*, 15 USPQ 2d 1079, 1080 (T.T.A.B. 1990); *Feed Flavors Inc. v. Kemin Indus. Inc.*, 209 USPQ 589, 590-91 (T.T.A.B. 1980).

In addition, there are no factors that strongly weigh against compelling an oral deposition. There would be no financial hardship to Petitioner or his attorney. Petitioner lives in the border-town of Tecate, Mexico. Tecate is approximately a one hour drive from San Diego and would be convenient for both parties. Indeed, given Petitioner’s frequent visits to the United States, including trips to attend Registrant’s depositions in these proceedings, it is likely that once compelled to testify orally, Petitioner would voluntarily agree to have his deposition taken in the United States. In fact, an oral deposition will likely be less expensive and far more convenient and efficient than the complex procedure for a deposition on written questions.

The written deposition process would be involved and time-consuming. *See* TMBP Rule 703.02. Aside from the inherent nature of the process, a written deposition would be even more time-consuming in this case because the questions and responses would need to be translated into Spanish (Petitioner does not read or speak English). A live deposition with a certified court reporter and certified court translator would proceed much more expeditiously and accurately and avoid disputes about any conflicts in the translations of the written questions and answers. Registrant has already endured various lengthy delays in this matter and should not be deprived further of the certainty it needs to adequately police its trademarks.

B. The Reasons Previously Offered By Petitioner's Counsel Are Insufficient To Preclude The Board From Compelling Petitioner's Oral Testimony

Petitioner's counsel had previously refused to make Petitioner available for an oral discovery deposition. In previous correspondence Petitioner's counsel identified two reasons for her refusal. First, counsel asserted that Petitioner's answers to interrogatories and his declarations provided enough detail to make oral testimony unnecessary. Second, counsel noted that Petitioner was upset by the dispute with his son and wished to preserve his "failing emotional health." Both are insufficient to reasons to allow Petitioner to avoid cross-examination.

Petitioner's answers to interrogatories and declarations are no substitute for testimony and cross-examination by oral testimony. For one, both documents were obviously prepared with the aid of his attorneys and are not admissible at trial (other than for admissions against interest or impeachment by Registrant). In addition, there is no opportunity for Registrant to effectively probe the bases for the written answers and the veracity of the statements in the written answers or declarations. Lastly, it is simply unfair to Registrant to permit the initiator of these proceedings and the key witness on many disputed points to submit only pre-scripted written answers to pre-cast questions.

Petitioner's "failing emotional health" is also no basis to deny Registrant its right to question and cross-examine Petitioner. Although Registrant is not unmindful of Petitioner's advanced age, he is in relatively good health and could easily handle a live oral deposition. Further, Petitioner initiated these cancellation proceedings, accusing Registrant of fraud and deceit in obtaining the subject trademark registrations. Petitioner should not now be allowed to avoid an oral testimony deposition simply because of his residence just across the Mexican

border and his understandable desire to avoid cross-examination. Registrant should be allowed to defend itself against these serious but baseless charges to the greatest extent possible.

In sum, there is good cause in this case to compel Petitioner to testify at a live oral deposition, and Petitioner has no basis to argue otherwise.

IV. CONCLUSION

For all these reasons, the Board is respectfully requested to grant Registrant's Motion to Compel an Oral Testimonial Deposition Petitioner Rather Than By Written Questions.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: March 16, 2006

By: _____



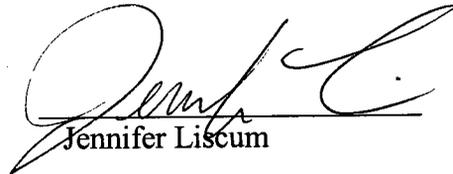
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CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **REGISTRANT'S MOTION TO COMPEL AN ORAL TESTIMONIAL DEPOSITION OF PETITIONER RATHER THAN BY WRITTEN QUESTIONS** upon Petitioner's counsel by placing it in a sealed envelope, via **Facsimile** and **First Class Mail**, postage prepaid, on March 16, 2006, addressed as follows:

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