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

Proceeding	92043811
Party	Defendant Michael Hwang Michael Hwang 12-25 Robin Lane Bayside, NY 11360
Correspondence Address	Irene E. Hudson FISH & RICHARDSON P.C. 153 EAST 53RD STREET, 52ND FLOOR NEW YORK, NY 10022-4611 UNITED STATES jjohnson@fr.com, hudson@fr.com
Submission	Other Motions/Papers
Filer's Name	Irene E. Hudson
Filer's e-mail	jjohnson@fr.com, hudson@fr.com, tmdocny@fr.com
Signature	/izh/
Date	01/30/2007
Attachments	Registrant's Motion to Strike Testimony or to Take Cross-Examination.pdf (15 pages)(415848 bytes)

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

Roger Orozco and Nora Orozco, Petitioners, v. Michael Hwang Respondent.	**Cancellation No.:** 92/043,811 **Registration No.:** 2,846,833 **Mark:** OAKTREE (& Design) **Date Registered:** May 25, 2004

REGISTRANT'S MOTION TO STRIKE PETITIONERS' TRIAL TESTIMONIAL DEPOSITIONS OF NORA OROZCO AND TONY SUGDEN PURSUANT TO TBMP § 533.02, 37 C.F.R. §§ 2.123(c), (e)(3), OR IN THE ALTERNATIVE, FOR LEAVE TO CROSS-EXAMINE NORA OROZCO AND TONY SUGDEN OUTSIDE OF PETITIONERS' TESTIMONY PERIOD, AND BRIEF IN SUPPORT OF SAME

Respondent/Registrant Michael Hwang ("Registrant" or "Hwang"), by and through his undersigned attorneys, hereby moves to strike Petitioners' trial testimonial depositions of Nora Orozco and Tony Sugden pursuant to Section 533.02 of the Trademark Trial and Appeal Board Manual of Procedure ("TBMP"), 37 C.F.R. §§ 2.123(c), (e)(3), since Petitioners failed to provide Registrant with due (i.e., reasonable) notice of the depositions. In the alternative, Registrant seeks leave to cross-examine Ms. Orozco and Mr. Sugden outside of Petitioners' testimony period.

It should be noted that Registrant has also contemporaneously herewith filed a motion pursuant to Sections 703.01(k), (m) of the TBMP, 37 C.F.R. § 2.125(a), to reset Registrant's testimony and all subsequent testimony and briefing periods because Petitioners have failed to serve Registrant with copies of the transcripts of the testimony and the documentary exhibits from the depositions of Ms. Orozco and Mr. Sugden. Registrant requested that his testimony

period and all subsequent trial and briefing dates be reset to close thirty (30) days after receipt of the transcripts of the testimony and the documentary exhibits.

I. LEGAL STANDARD

Pursuant to TBMP § 533.02, 37 C.F.R. § 2.123(c),

> [b]efore the depositions of witnesses shall be taken by a party, due notice in writing shall be given to the opposing party or parties, as provided in § 2.119(b),[1] of the time when and place where the depositions will be taken, of the cause or matter in which they are to be used, and the name and address of each witness to be examined ....

TBMP § 533.02, 37 C.F.R. § 2.123(e)(3), further provides that

> [e]very adverse party shall have full opportunity to cross-examine each witness. If the notice of examination of witnesses which is served pursuant to paragraph (c) of this section is *improper or inadequate* with respect to any witness, an adverse party may cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, if he wishes to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all of the relevant circumstances. A motion to strike the testimony of a witness for lack of proper or adequate notice of examination must request the exclusion of the entire testimony of that witness and not only a part of that testimony.

TBMP § 533.02, 37 C.F.R. § 2.123(e)(3) (emphasis added). An example of "improper or inadequate [notice]" is one that "does not give due (i.e., reasonable) notice." TBMP § 533.02 & fn. 471 (citing cases). Even though a motion to strike "will be decided on the basis of all

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[1] 37 C.F.R. § 2.119(b) provides that service of papers must be on the attorney or other authorized representative of the party, and may be made in one of five ways: (1) By delivering a copy of the paper to the person served; (2) By leaving a copy at the usual place of business of the person served, with someone in the person's employment; (3) When the person served has no usual place of business, by leaving a copy at the person's residence, with a member of the person's family over 14 years of age and of discretion; (4) Transmission by the "Express Mail Post Office to Addressee" service of the United States Postal Service or by first-class mail, which may also be certified or registered; (5) Transmission by overnight courier. It further provides that "[w]henever it shall be satisfactorily shown to the Director that none of the above modes of obtaining service or serving the paper is practicable, service may be by notice published in the Official Gazette."

relevant circumstances," TBMP § 533.02, the Trademark Trial and Appeal Board has ruled that one- and two-days notice was not reasonable. *See, e.g., Jean Patou Inc. v. Theon Inc.*, 18 U.S.P.Q.2d 1072 (TTAB 1990); *Duke University v. Haggar Clothing Co.*, 54 U.S.P.Q.2d 1443 (TTAB 2000); *Electronic Industries Association v. Potega*, 50 U.S.P.Q.2d 1775 (TTAB 1999).

II. FACTUAL AND PROCEDURAL BACKGROUND

Petitioners noticed the testimony depositions of Nora Orozco and Tony Sugden for November 27, 2006, the first Monday after the Thanksgiving holiday (i.e., November 23, 2006) in Ventura, California. Annexed hereto as Exhibit A is a true and correct copy of the Notice of Deposition. Even though the Certificate of Service states that the notice was sent on November 16, 2006, it was not received by the office of undersigned counsel for Registrant until late in the day on November 21, 2006,[2] the Tuesday immediately preceding the Thanksgiving holiday. Due to the Thanksgiving holiday, the undersigned counsel for Registrant, who both practice in the New York office of Fish & Richardson P.C., were out of the office from November 22, 2006, through and including November 26, 2006. It is submitted that last minute travel during the Thanksgiving holiday, if it can be accomplished, is very expensive.

On November 27, 2006, counsel for Registrant advised counsel for Petitioner Kurt Koenig by facsimile and electronic and first class mail that Registrant objected to Petitioner going forward with the deposition. Annexed hereto as Exhibit B are true and correct copies of the correspondence. Counsel for Registrant did not attend the depositions. Counsel for Petitioner did not respond until November 28, 2006, when he advised counsel for Registrant that he went forward with the deposition on November 27, 2006.

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[2] Due to the repeated delay in receiving correspondence from counsel for Registrant, counsel for Registrant has repeatedly requested that counsel for Petitioner communicate with and/or serve papers on them via electronic mail. Counsel for Petitioner apparently does not have an issue with communicating with counsel for Registrant via electronic mail but does, unfortunately, repeatedly ignore that request when it relates to service of papers.

On December 26, 2006, counsel for Registrant contacted counsel for Petitioners reiterating that it was unable to attend the depositions of Ms. Orozco and Mr. Sugden based on the inadequate notice and requesting that Registrant be allowed to conduct the cross-examinations of Ms. Orozco and Mr. Sugden outside of Petitioners' testimony period. Annexed hereto as Exhibit C is a true and correct copy of Registrant's December 26, 2006 letter. Petitioners have not responded to Registrant's request to conduct such cross-examinations.

III. ARGUMENT

Counsel for Registrant did not have a full opportunity to cross-examine Nora Orozco and Tony Sugden on account of Petitioner's failure to provide adequate notice of the depositions. Even though the Certificate of Service states that the notice was served on December 16, 2006, it was not received by counsel for Registrant until the Tuesday immediately preceding the Thanksgiving holiday. Thus, counsel for Registrant, even if they were in the office on the Wednesday before Thanksgiving Day, which they were not, would have had two business days (three days if one were to count the Friday after Thanksgiving Day) to prepare for and travel to the depositions in California noticed for the Monday morning after Thanksgiving Day.

Accordingly, Registrant hereby moves to strike Petitioners' deposition testimony from the record based Petitioners' failure to provide adequate notice thereof, or, in the alternative, seeks leave to cross-examine Ms. Orozco and Mr. Sugden outside of Petitioners' testimony period.

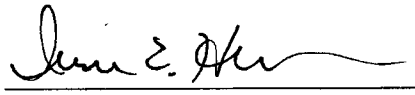
IV. CONCLUSION

For the foregoing reasons, Registrant Hwang respectfully requests that the Board strike Petitioners' deposition testimony of Nora Orozco and Tony Sugden from the record, or, in the alternative, allow Registrant to cross-examine Ms. Orozco and Mr. Sugden outside of Petitioners' testimony period.

Dated: January 30, 2007
New York, New York

Respectfully submitted,

FISH & RICHARDSON P.C.

By: 

John T. Johnson
Irene E. Hudson
Citigroup Center – 52nd Floor
153 East 53rd Street
New York, NY 10022
Tel.: (212) 765-5070
Fax: (212) 258-2291

Attorneys for Respondent
MICHAEL HWANG

EXHIBIT A

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

Roger Orozco and Nora Orozco, Petitioner,	)	
V.	)	Cancellation No. 92043811
Michael Hwang, Respondent.	)	

PETITIONER'S NOTICE OF TESTIMONY DEPOSITION

Please take notice that, pursuant to Trademark Rule 2.123(c), Petitioner, Roger and Nora Orozco, by their attorney, will take the testimony deposition upon oral examination of Nora Orozco and Tony Sugden of 5235 Mission Oaks Blvd. #600, Camarillo, CA 93012 on November 27, 2006 beginning at 9:30 AM at the office of Pacific Coast Court Reporters at 1363 Donlon Street, Suite 8, Ventura, CA 93003.

The deposition(s) shall take place before a certified court reporter and shall run consecutively and continue until completed.

You are invited to attend and cross-examine.

Respectfully submitted,

KOENIG & ASSOCIATES

Dated: November 16, 2006 By:

Kurt Koenig
Koenig & Associates
226 E. Canon Perdido St. Suite M
Santa Barbara, CA 93101
Tel: 805-965-4400
Fax: 805-564-8262

Attorneys for Petitioner

CERTIFICATE OF SERVICE

I, KURT KOENIG, hereby certify that I caused a copy of the foregoing "**PETITIONER'S NOTICE OF TESTIMONY DEPOSITION**" to be served on November 16, 2006, by first class mail, postage prepaid, addressed to:

Mr. John Johnson
Ms. Irene Hudson
Fish & Richardson P.C.
Citigroup Center
153 E. 53rd St., 52nd Floor
New York, NY 10022-4611

Dated: November 16, 2006

Kurt Koenig

EXHIBIT B

FISH & RICHARDSON P.C.

Citigroup Center
153 East 53rd Street,
52nd Floor
New York, New York
10022-4611

Telephone
212 765-5070

Facsimile
212 258-2291

Web Site
www.fr.com

Frederick P. Fish
1855-1930

W.K. Richardson
1859-1951

VIA ELECTRONIC & FIRST CLASS MAIL & FACSIMILE

November 27, 2006

Mr. Kurt Koenig
Koenig & Associates
226 E. Canon Perdido St.
Suite M
Santa Barbara, California 93101

AUSTIN
BOSTON
DALLAS
DELAWARE
NEW YORK
SAN DIEGO
SILICON VALLEY
TWIN CITIES
WASHINGTON, DC

Re: Roger Orozco and Nora Orozco v. Michael Hwang
Our Ref.: 18503-002001

Dear Mr. Koenig:

We are in receipt of Petitioner's Notice of Testimony Deposition of Nora Orozco and Tony Sugden for November 27, 2006, at 9:30 AM in Ventura, California. We did not receive the notices with sufficient time in advance and will not be available to attend the depositions.

We look forward to hearing from you.

Very truly yours,

Irene Hudson

30313609.doc

Irene Hudson

From: Irene Hudson
Sent: Monday, November 27, 2006 11:28 AM
To: Kurt@incip.com
Cc: John Johnson
Subject: FW: Orozco and Orozco v Hwang

Importance: High

Attachments: Nov 27 ltr Koenig.pdf

Nov 27 ltr Koenig.pdf (26 KB)

Kurt,

Further to our letter of earlier today, we object to Petitioner going forward with the depositions today. Please provide us with some alternative deposition dates so we can schedule a mutually convenient time to hold the depositions.

Since the deposition notice was sent by mail, we did not receive it in sufficient time to make arrangements for the depositions. We have repeatedly asked that you please send us pleadings and/or correspondence by email to avoid the delay in mail service. We repeat that request again. Please send all future pleadings and correspondence to John Johnson and myself at jjohnson@fr.com and hudson@fr.com.

Thank you and regards,

Irene Hudson
Associate
~ Fish & Richardson P.C.
Citigroup Center - 52nd Floor
153 East 53rd Street
New York, NY 10022-4611
tel: (212)641-2325
fax: (212)258-2291
email: hudson@fr.com
website: www.fr.com

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-----Original Message-----
From: Irene Hudson
Sent: Monday, November 27, 2006 10:49 AM
To: Kurt@incip.com
Cc: John Johnson
Subject: Orozco and Orozco v Hwang
Importance: High

Please see attached.

Irene Hudson
Associate
~ Fish & Richardson P.C.

Citigroup Center - 52nd Floor
153 East 53rd Street
New York, NY 10022-4611
tel: (212)641-2325
fax: (212)258-2291
email: hudson@fr.com
website: www.fr.com

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EXHIBIT C

FISH & RICHARDSON P.C.

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Frederick P. Fish
1855-1930

W.K. Richardson
1859-1951

VIA ELECTRONIC & FIRST CLASS MAIL & FACSIMILE

December 26, 2006

Mr. Kurt Koenig
Koenig & Associates
226 E. Canon Perdido St., Suite M
Santa Barbara, California 93101

Re: Roger Orozco and Nora Orozco v. Michael Hwang
Our Ref.: 18503-002001

AUSTIN
BOSTON
DALLAS
DELAWARE
NEW YORK
SAN DIEGO
SILICON VALLEY
TWIN CITIES
WASHINGTON, DC

Dear Mr. Koenig:

Further to our letter and e-mail of November 27, 2006, we did not receive Petitioner's Notice of Testimony Deposition of Nora Orozco and Tony Sugden for November 27, 2006, in Ventura, California, with sufficient time in advance. In particular, we had at most two business days (three business days if you count the Friday after Thanksgiving Day) to prepare for and travel to California for the depositions. Due to this inadequate notice, Registrant did not have an opportunity to cross-examine the witnesses on November 27, 2006. Thus, we ask that you make Nora Orozco and Tony Sugden available for cross-examination, either by phone or in person deposition, after we have had an opportunity to review their testimony.

TBMP § 533.02, 37 C.F.R. § 2.123(e)(3) provides that "[e]very adverse party shall have full opportunity to cross-examine each witness." Pursuant to TBMP § 533.02, 37 C.F.R. § 2.123(c), "[b]efore the depositions of witnesses shall be taken by a party, due notice in writing shall be given to the opposing party or parties, as provided in § 2.119(b), of the time when and place where the depositions will be taken, of the cause or matter in which they are to be used, and the name and address of each witness to be examined ...." The Trademark Trial and Appeal Board has ruled that one- and two-days notice was not reasonable and did not provide adequate notice under the circumstances. *See, e.g., Jean Patou Inc. v. Theon Inc.*, 18 U.S.P.Q.2d 1072 (TTAB 1990); *Duke University v. Haggar Clothing Co.*, 54 U.S.P.Q.2d 1443 (TTAB 2000); *Electronic Industries Association v. Potega*, 50 U.S.P.Q.2d 1775 (TTAB 1999).

We look forward to hearing from you.

Very truly yours,

Irene Hudson

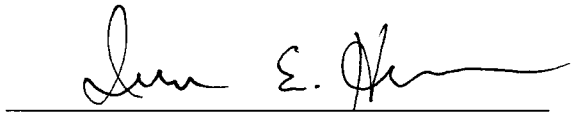
Irene Hudson

30316816.doc

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of RESPONDENT'S MOTION TO STRIKE PETITIONERS' TRIAL TESTIMONIAL DEPOSITIONS OF NORA OROZCO AND TONY SUGDEN PURSUANT TO TBMP § 533.02, 37 C.F.R. §§ 2.123(c), (e)(3), OR IN THE ALTERNATIVE, FOR LEAVE TO CROSS-EXAMINE NORA OROZCO AND TONY SUGDEN OUTSIDE OF PETITIONERS' TESTIMONY PERIOD, AND BRIEF IN SUPPORT OF SAME was sent via first class mail, postage prepaid, on January 30, 2007, to Petitioners' Attorney of Record at the following address:

Kurt Koenig
KOENIG & ASSOCIATES
220 E. Canon Perdido Street, Suite M
Santa Barbara, California 93101



Irene E. Hudson

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