

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

gcp/jk

Mailed: April 22, 2008

Cancellation No. 92043811

ROGER OROZCO AND NORA OROZCO

v.

MICHAEL HWANG

George C. Pologeorgis, Interlocutory Attorney:

This case is before the Board for consideration of registrant's two motions, both filed January 30, 2007, (1) to strike petitioner's trial testimony depositions of Nora Orozco and Tony Sugden pursuant to Trademark Rule 2.123(c) or, in the alternative, for leave to cross-examine said witnesses outside of petitioner's testimony period, and (2) to reset registrant's testimony period and all subsequent testimony and briefing periods. The motions have been fully briefed.

We first consider registrant's motion to strike. In support thereof, registrant asserts that petitioners failed to provide reasonable notice of the depositions of two of petitioner's witnesses during petitioner's testimony period. In particular, registrant contends that its receipt on November 21, 2006 of the notice of the two depositions, to

take place on November 27, 2006, constitutes inadequate notice, and that it had only two business days to prepare for travel from New York to California to attend the depositions. Essentially, it is registrant's position that it was unable to attend the depositions due to inadequate notice thereof. Having not attended the depositions, registrant moves, in the alternative, for leave to cross-examine the two deposed individuals outside of petitioner's testimony period.

Petitioner argues that it served registrant with proper and sufficient notice of its testimony depositions pursuant to Trademark Rule 2.123(e)(3), that registrant's motion is not timely, and that registrant chose to neither file a motion to quash, nor call counsel for petitioner, nor contact the Board prior to the taking of the depositions.

Trademark Rule 2.123(e)(3) states, in pertinent part:

Every adverse party shall have full opportunity to cross-examine each witness. If pretrial disclosures or the notice of examination of witnesses served pursuant to paragraph (c) of this section are 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, to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances.

As registrant points out, the Board has found one and/or two days notice of a deposition to be unreasonable.

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*See, e.g., Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072, 1704 (TTAB 1990) (one day notice not sufficient time for applicant to prepare for deposition but opposer allowed time to recall witness for purpose of cross-examination and redirect); *Duke University v. Haggard Clothing Co.*, 54 USPQ2d 1443, 1444 (TTAB 2000) (one and two-day notices were not reasonable without compelling need for such haste; three-day notice was reasonable); *Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1776 (TTAB 1999) (two-day notice was not reasonable and opposing counsel's failure to appear was excused).

However, the record before us presents facts that are readily distinguishable from those the Board dealt with in these prior cases. Petitioner's written notice of the November 27, 2006 depositions of Nora Orozco and Tony Sugden clearly evidences service of said notice on registrant on November 16, 2006. Given that this constituted eleven calendar days' notice, we find that petitioner complied in full with the requirement for reasonable notice, and that it provided such notice in accordance with Trademark Rule 2.123(c). Registrant's arguments that it did not receive the notice "until late in the day on November 21, 2006, the Tuesday immediately preceding the Thanksgiving holiday," that last minute travel during the holiday "is very expensive," and that it did not receive notice via email,

are not persuasive.<sup>1</sup> Registrant, as the party asserting itself to have been put in a difficult situation, failed to avail itself of any of the options at its disposal: file a motion to quash the notice of depositions; propose a change in date of the depositions; participate in the depositions by telephone.<sup>2</sup> Given the availability of these alternatives, registrant's filing of a motion to strike two months after the completion of the depositions, on the grounds of inadequate notice thereof, is, in itself, inadequate.

Furthermore, it is entirely disingenuous for registrant to argue that its eleven-days notice was inadequate, while contending that counsel for petitioner "did not respond until November 28, 2006" to the November 27, 2006 communication registrant sent to petitioner on the very day counsel for petitioner was conducting the two noticed depositions.

Accordingly, under these circumstances we find that petitioner provided reasonable notice of the depositions of

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<sup>1</sup> Parties to Board proceedings are on advance and ample notice when their particular assigned time periods and deadlines might span or encompass holiday times or times that give rise to scheduling issues. Counsels are expected to be mindful of this in carrying out their obligations with respect to Board proceedings.

<sup>2</sup> Under such circumstances, the better practice would have been for registrant to file a motion to quash the notice of deposition prior to the commencement thereof. See TBMP § 521 (2d ed. rev. 2004), which provides for the Board's expeditious consideration of allegations of unreasonable notice of the taking of depositions.

Nora Orozco and Tony Sugden. In view thereof, registrant's motion to strike petitioner's trial testimony depositions of these individuals is denied. For the same reasons indicated above, registrant's alternative request to cross-examine petitioner's two witnesses outside of petitioner's testimony period is also denied.<sup>3</sup>

We now turn to registrant's motion to reset its testimony period, which we construe as a motion to extend time inasmuch as registrant filed this motion on January 30, 2007, the last day of its assigned testimony period.<sup>4</sup>

Registrant argues that its motion was necessitated by petitioner's failure to serve it with complete copies of the testimony transcripts and documentary exhibits, pursuant to Trademark Rule 2.125(a), following the depositions of Nora Orozco and Tony Sugden, and requests that its testimony period be reset to close thirty days after its receipt of the complete transcripts and exhibits.

Petitioner asserts that registrant filed its motion to reset for the sole purpose of delaying this proceeding,

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<sup>3</sup> The Board notes that on August 30, 2007, the parties filed with the Board an executed, yet undated, protective agreement. In view thereof, petitioner is allowed ten days from the mailing date of this order in which to serve upon registrant unredacted versions of the testimony depositions of Nora Orozco and Tony Sugden, if it has not done so already.

<sup>4</sup> Pursuant to Fed. R. Civ. P. 6(b), made applicable to Board proceedings by 37 CFR §2.116(a), a party may file a motion for an enlargement of the time in which an act is required or allowed to be done, and if the motion is filed prior to the expiration of the period as originally set or previously extended, the motion is a motion to extend.

specifying that registrant intentionally prevented the serving of complete transcripts and exhibits by not executing and forwarding to petitioner the parties' written protective agreement. Petitioner also argues that registrant was aware that the parties had not executed a protective agreement, was given an opportunity to execute it, and was on notice that the absence of such agreement was petitioner's reason for withholding the full transcript materials.

Testimony periods may be rescheduled by stipulation of the parties approved by the Board, upon motion granted by the Board, or by order of the Board. Pursuant to Fed. R. Civ. P. 6(b), made applicable to Board proceedings by 37 CFR §2.116(a), a party may file a motion for an enlargement of the time in which an act is required or allowed to be done. If the motion is filed prior to the expiration of the period as originally set or previously extended, the motion is a motion to extend, and the moving party need only show good cause for the requested extension.<sup>5</sup> Good cause must be set forth with particularity, and the movant must demonstrate that the extension is not necessitated by its own lack of diligence or

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<sup>5</sup> In the context of asserting that registrant knew petitioner would not forward confidential portions of the trial testimony in the absence of a signed protective agreement, petitioner states that registrant's "failure to act during the time allotted was the result of excusable neglect," and characterizes registrant's motion as a motion to reopen. As stated herein, in light of the fact that registrant filed its motion prior to the expiration of its testimony period, the standard to be applied is that of good cause, rather than excusable neglect.

unreasonable delay. See TBMP § 509.01(a) (2d ed. rev. 2004).

Registrant predicates its motion to reset its testimony period on its failure to receive from petitioner full, unredacted copies of the transcripts of the testimony depositions of Nora Orozco and Tony Sugden. In its brief, registrant states that it received from petitioner "portions of the transcripts and documentary exhibits" on December 27, 2006. During the several weeks that followed, registrant was aware and/or was made aware of petitioner's reason for not providing full transcripts. Yet, registrant did not file its motion until the last day of its assigned testimony period, as last reset, i.e., January 30, 2007.

Although we hesitate to find that registrant's sole purpose for filing its motion to reset testimony periods on the last day of its assigned testimony period was to delay these proceedings, registrant's own inaction indeed caused the delay. Moreover, the facts reveal that the exercise of a heightened level of diligence on registrant's part with respect to either executing the protective agreement, or otherwise assuring that petitioner was aware of registrant's consent to the parties' protective agreement, could have rendered a full transcript forthcoming and may have obviated registrant's apparent need to seek what is essentially an additional testimony period. The capability of removing petitioner's stated condition precedent to providing full

copies of the deposition transcripts in the weeks following December 27, 2006 lied with registrant. Registrant's statement, in its January 30, 2007 motion to reset its testimony period, that registrant "consents to the use of the standard TTAB Protective Order," is insufficient to overcome its previous inaction during the nearly entire length of its assigned testimony period.

Under these circumstances, we find that registrant has failed to demonstrate good cause for a resetting of its testimony period. Accordingly, registrant's motion to reset its testimony period is denied.

With respect to the progression of this case, petitioner's 30-day testimony period, and registrant's 30-day testimony period, are both closed. Petitioner's 15-day rebuttal testimony period is reset as follows:

15-day rebuttal testimony period to close:       **05/15/08**

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

**NEWS FROM THE TTAB:**

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For

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further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>  
[http://www.uspto.gov/web/offices/com/sol/notices/72fr42242\\_FinalRuleChart.pdf](http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf)

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>