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

Proceeding	92048667
Party	Plaintiff Jules Jurgensen/Rhapsody, Inc.
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IN THE UNITED STATES PATENT AND MARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

JULES JURGENSEN/RHAPSODY, INC.:

	:	Cancellation No. 92-048,667
Petitioner	:	
	:	Registration No. 3,181,224
	:	
v.	:	Mark: URBAN JÜRGENSEN
	:	
	:	
PETER BAUMBERGER	:	
	:	
Respondent	:	

PETITIONER'S REQUEST FOR RECONSIDERATION OF THE
BOARD'S DECISION OF JULY 6, 2009 STRIKING
THE TESTIMONY DEPOSITION OF MORTON CLAYMAN,
AND BRIEF IN OPPOSITION TO RESPONDENT'S
MOTION FOR JUDGEMENT UNDER TRADEMARK RULE 2.132(a)

I Introduction:

Jules Jurgensen/Rhapsody, the Petitioner in this cancellation, requests reconsideration and reversal of the Board's decision of July 6, 2009, striking the testimony deposition of Morton Clayman in its entirety, and that Respondent's motion for judgement under trademark rule 2.132(a) be denied

The Board's decision on the motion to strike is based on incorrect facts and a failure to follow the Rules of Practice. Accordingly, it should be reversed.

Further, after the board reverses its decision on Respondent's motion to strike, Respondent's motion for judgement should be denied.

II Background:

On July 6, 2009, the board ordered that Mr. Clayman's testimony be stricken in its entirety.

The basis for this ruling was the first part of Rule 2.121(e) which states, in the part relied upon by the Board,

"... no later than fifteen days prior to the opening of each testimony period.. The party scheduled to present evidence must disclose the name, and ... telephone number and address of each witness from whom it intends to take testimony or may take testimony if the need arises, ..."

The Board, however, ignored the last two sentences of the Rule:

"If a party does not plan to take testimony from any witnesses, it must so state in its pretrial disclosure
When a party fails to make required pretrial disclosures, any adverse party or parties may have remedy by way of a motion to the Board to delay or reset any pretrial disclosures or deadlines and/or testimony periods." 37CFR 2.121(e).

Subsequent to that order, on July 20, 2009, Respondent filed a motion for judgement under Trademark Rule 2.123(a) claiming that no evidence had been admitted that would support Petitioner's claim, and that judgement be entered in its favor.

III Mr. Clayman's Testimony Deposition Was Properly Taken

Respondent Was on notice of Mr. Clayman's identity
and that his testimony would be taken

On October 21, 2008 during a telephone conference between Petitioner and Respondent, Petitioner advised Respondent that Mr. Clayman's testimony would be taken..

In addition to advising Respondent that Mr. Clayman's testimony deposition would be taken, the parties discussed their open discovery requests, settlement, and the prospect of Respondent testifying by affidavit.

Mr. Clayman was formally identified to Respondent in answers to interrogatories filed on December 17, 2008. He was identified as the president of Petitioner, and his address was given. Further, he was identified as the person who supplied the answers to Respondent's interrogatories

Mr. Clayman's discovery deposition was not taken
because of inaction on the part of Respondent

Respondent was informed of Mr. Clayman's identity as president of Petitioner and the person most knowledgeable about the facts in this case well before the commencement of Petitioner's testimony period.

Respondent has personal knowledge of Mr. Clayman and his position as president of Petitioner. This is because they had already appeared before the Board in Cancellation No. 92021824, April 17, 1998 concerning trademark registration No. 965,536 for URBAN.

Thus, the failure to take Mr. Clayman's discovery deposition falls squarely on Respondent, not Petitioner.

IV The Board Failed to Recognize That Neither Respondent's Motion to Strike Nor its Decision Complied with the Rules of Practice

Respondent Failed To Comply with Rule 2.121(e)

The Respondent did not comply with Rule 2.121(e) if it believed that it did not receive proper notice that Mr. Clayman was going to be a witness for Petitioner.

Thus, under Rule 2.121(e), cited by both the Respondent and the Board, the proper remedy for an alleged failure to make a pretrial disclosure is to move the Board to delay or reset any pretrial disclosures or deadlines and/or testimony periods.

"When a party fails to make required pretrial disclosures, any adverse party or parties may have remedy by way of a motion to the Board to delay or reset any pretrial disclosures or deadlines and/or testimony periods."

37CFR 2.121(e).

Accordingly, the proper action for Respondent if it felt aggrieved was to file a motion under Rule 2.121(e).

It is clear that this provision is a tacit acknowledgment that cases should be decided on the merits and not on technicalities.

The Board Failed To Comply With Rule 2.121(e)

Even though Respondent failed to comply with Rule 2.121(e), when it filed its motion to strike, the Board should have recognized that a motion to strike was not contemplated by the rule. Thus, it should have treated the motion to strike as a motion to "to delay or reset any pretrial disclosures or deadlines and/or testimony periods."

V The Board Failed To Recognize The Significance Of Petitioner Not Filing A Statement That It Did Not Plan to Take Testimony

The Board accepted (at page 3) Respondent's claim that it relied upon Petitioner's lack of disclosure of witnesses to indicate that Respondent intended to only introduce documentary evidence at trial.

Rule 2.121(e) requires a party who does not plan to take testimony from any witness to so state in its pretrial disclosure.

Petitioner never made such a statement.

Since Petitioner never made a statement that it did not plan to take testimony, as required by Rule 2.121(e), Respondent was on notice that Petitioner planned to take testimony.

Therefore, its claim of surprise is not well taken and should be ignored.

Further, Respondent's claim that it relied upon Petitioner's lack of disclosure of witnesses to indicate that Respondent intended to only introduce documentary evidence at trial is belied by its conduct prior to Mr. Clayman's testimony deposition..

Thus, Respondent cooperated with Petitioner in the scheduling of Mr. Clayman's deposition. It is unreasonable to permit the Respondent to profit by its obviously misleading conduct. *Beecham Products Inc. v. Hawaiian Perfumers, Inc. D.b.a. Liana of Waikiki*, 440 F.2d 1037; 169 USPQ 492 (CCPA 1971)

VI Respondent Had Substantial Opportunity To File
The Motion Contemplated By Rule 2.121(e)

On March 4, 2009, before the notice of Mr. Clayman's testimony deposition was drafted, Petitioner's and Respondent's counsel had a telephone conference concerning where and when Mr. Clayman's testimony would be taken, and how Respondent would be represented.

Set out below, from Petitioner's counsel's time record for March 4, 2009 is the record of that conference.

Prepare Notice of Testimony deposition of Morton Clayman, conference with the attorney for Peter Baumberger with respect to when and when the deposition would be taken and how Peter Baumberger would be represented.

Respondent received the formal notice of Mr. Clayman's testimony deposition on March 4, 2009. The testimony deposition was scheduled for March 18, 2009.

Respondent could have objected to the deposition during that telephone conference, but it did not do so. *The Sunrider Corporation v. Johannes W. Raats*, 83 USPQ2d 1649 (TTAB 2007). Instead it chose to cooperate with Petitioner on the scheduling of that deposition.

Respondent could have filed its Rule 2.121(e) motion at any time over the next two weeks, *Sunrider*, but it did not do so.

While it could have objected to the scheduling of Mr. Clayman's deposition, or filed a motion under Rule 2.121(e), Respondent cooperated in the scheduling of the deposition. Thus, it encouraged Petitioner to incur the expense of a court reporter and disrupt Mr. Clayman's schedule while sitting quietly waiting to pounce with its motion to strike.

At least the day before the deposition there was at least one more telephone conference between Respondent's and Petitioner's counsel during which Respondent's counsel disclosed that it would attend the deposition by telephone.

At that time Respondent could have objected to the scheduling of Mr. Clayman's deposition, or filed a motion under Rule 2.121(e).

However, it chose not do so.

VII **THE PROVISIONS OF TRADEMARK RULE 2.123(e)(3)
DO NOT GOVERN RESPONDENT'S MOTION TO STRIKE**

The provisions of Trademark Rule 2.121(e) preempt
the provisions of Trademark Rule 2.123(e)(3)

Under Trademark Rule 2.121(e) a party's remedy for alleged failure to make a pretrial disclosure of a witness is to file a motion to "to delay or reset any pretrial disclosures or deadlines and/or testimony periods."

Under Trademark Rule 2.123(e)(3) the party's remedy is to seek to strike the offending deposition. The motion

"... will be decided on the basis of all the relevant circumstances."

A motion under 2.121(e) and a motion under 2.123(e) are not alternative remedies; both of which are available to the Respondent.

This is because it makes no sense for both rules to provide remedies for the same alleged action. Thus, if both remedies were available to a party, then the provisions in Rule 2.121(e) would be superfluous. This is because a party given the choice to strike or delay an opponent's testimony would always choose to strike it.

In *Piel v. Falkner*, 426 F.2d 412 (CCPA 1970) the court was confronted with an alleged defective notice of taking testimony in a patent interference.

Piel argued that testimony taken by Falkner should be excluded from the proceeding because of improper notice. The Court agreed that the notice was improper, but that in *all the relevant circumstances* the interference should be reopened to provide Faulkner with an opportunity to retake its depositions upon proper notice.

Thus, it is apparent that the remedy under Rule 2.123(e) is only available if an adverse party did not know of the deposition until it was too late to cure the alleged defect.

In the case at bar the all the relevant circumstances weigh in Petitioner's favor and against Respondent

All the relevant circumstances in the case at bar weigh against Respondent's motion to strike.

By way of comparison with the case at bar, in *Gaudreau v. Am. Promotional Events*, 82 USPQ2d 1692 (TTAB 2007) the Board found that a notice of testimony deposition served two days before the date of the deposition was unreasonable and struck the deposition.

Respondent had *two weeks* to file a motion under the provisions of Rule 2.121(e) but chose not to do so.

Further, Respondent cooperated with Petitioner in the scheduling of Mr. Clayman's deposition.

These facts are a part of the "*the relevant circumstances*" which must be considered in deciding Respondent's motion to strike. Clearly, they show that prior to Mr. Clayman's Deposition, Respondent was not mis-led by Petitioner. Just the opposite happened. Respondent mis-led Petitioner.

The Board's assertion that Respondent was deprived of an opportunity to seek discovery from Mr. Clayman is not well taken.

Thus, Respondent was aware of Mr. Clayman on October 21, 2008, five months before his testimony deposition..

Furthermore, it had ample opportunity to file a motion for delay under Trademark Rule 2.121(e).

VIII Respondent Was Not Harmed By Its Failure
To Take Mr. Clayman's Deposition

Respondent had received virtually all of the documents used at Mr. Clayman's testimony deposition well before that deposition and as soon as they were located.

Petitioner identified Mr. Clayman to Respondent at least as early as December 17, 2008 according to Annie Chu Haselfeld, one of Respondent's attorneys in her Declaration of May 6, 2009.

In spite of Respondent's claim that it could not formulate a cross examination strategy in spite of having at least *two weeks* to do so, it still was able to mount an effective cross examination that ran for 59 pages. Petitioner's direct examination only took 22 pages.

Respondent, other than a bland statement that it could not properly prepare for Mr. Clayman's testimony deposition, did not identify any area of inquiry it would have explored or any strategy that it would have considered had it taken Mr. Clayman's discovery deposition prior to his testimony.

IX The Board Should Try Cases On Their
Merits Not On Technicalities

This cancellation should be decided on the merits, not on a technicality.

The Respondent claimed, that could not prepare to cross-examine Mr. Clayman's at his testimony deposition because it had not deposed him.

As pointed out earlier, Respondent effectively cross-examined Mr. Clayman for 59 pages with only one objection by Petitioner.

Further, Respondent merely states, with out pointing out or explaining how the subject matter of Mr. Clayman's deposition would have been any different than the cross-examination that it administered because it did not take that discovery deposition. Petitioner has fully explained, with supporting facts, why Respondent was not damaged or if it was damaged, it was its own fault.

Accordingly, in the absence of additional information from Respondent, it is clear that it was not damaged.

In it's opinion the Board accepted Respondent's claim that not knowing that Mr. Clayman was going to be one of Petitioner's witnesses, could not properly prepare for it's cross-examination of Mr. Clayman since it didn't have an opportunity to take his deposition.

But, as just explained, Respondent was not damaged.

Further, under the Rule 2.122(e) Respondent should have moved the Board to delay Mr. Clayman's testimony deposition, until it could depose him.

However, it elected not to do this even though it has several opportunities to do so, either by motion to the Board, or by requesting a stipulation from Petitioner for time to take the deposition.

Non-the-less, it let all of these opportunities pass, content in the belief that if Mr. Clayman's deposition revealed information damaging to its position, it would move the Board to strike the deposition.

The rationale behind the notification and motion for delay in rule 2.121(e) are to avoid surprise, and to assure that cases are decided on their merits and not on technicalities. However, this rationale is being perverted by Respondent's conduct.

If Respondent was surprised by Mr. Clayman's testimony deposition, it was because it chose to be surprised, and for no other reason.\

Conclusion

The Board should reverse its decision and deny Respondent's motion to strike the testimony deposition of Mr. Clayman. Further, after the board reverses its decision on respondent's motion to strike, Respondent's motion for judgement under trademark rule 2.132(a) be denied.

Respectfully submitted,

/Stuart E. Beck/

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Certification of Filing and of Service

I hereby certify that on August 16, 2009 copies of Petitioner's Request for Reconsideration of the Board's Decision of July 6, 2009 Striking The Testimony Deposition of Morton Clayman, And Brief in Opposition to Respondent's Motion for Judgement under Trademark Rule 2.132(a) was filed at the Trademark Trial and Appeal Board of the United States Patent and Trademark Office electronically in accordance with Rule 126; and upon counsel for the Respondent by email and by first class mail to:

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/Stuart E. Beck/