UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: September 15, 2008

Opposition No. 92049146

Arcadia Group Brands Limited

v.

Studio Moderna SA

Cancellation No. 92049146

Arcadia Group Brands Ltd.

v.

Studio Moderna SA

(as consolidated)[1]

Angela Lykos, Interlocutory Attorney

I. **Motions Pending in Opposition No. 91169226**

This case now comes before the Board for consideration of (1) plaintiff's motion (filed August 21, 2007) to take the oral deposition of a Fed. R. Civ. P. 30(b)(6) representative(s) of defendant in Switzerland; and (2) plaintiff's motion (filed September 5, 2008) to compel supplemental responses to plaintiff's first set of

[1] By this order, the referenced proceedings are hereby consolidated. Consequently, the parties' future submissions should be captioned in the above manner.

interrogatories and document production requests.[2] The motions are fully briefed.

A. Plaintiff's Motion to Take the Oral Deposition of a Fed. R. Civ. P. 30(b)(6) Representative of Defendant in Switzerland

Plaintiff seeks to take the oral deposition of a Fed. R. Civ. P. 30(b)(6) representative(s) of defendant (an entity organized under the laws of Switzerland) in Switzerland on the grounds that the witness(s) knows facts that are central to this case (namely defendant's intent to use its applied-for mark in commerce based on its Section 44(d) application). Plaintiff also maintains that depositions on written questions are cumbersome.[3] For the reasons set forth below, plaintiff's motion is denied.

Pursuant to Board practice, the discovery deposition of a party located in a foreign country must be taken upon written questions unless the Board orders, upon motion for good cause, that the deposition be taken by oral examination. Trademark Rule 2.120(c)(1). "In determining whether good cause exists for a motion to take a foreign deposition orally, the Board weighs the equities, including the advantages of an oral deposition and any financial hardship that the nonmoving party might suffer if the

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[2] Plaintiff's consented motion to extend the discovery and testimony periods in this case (filed August 20, 2007) is hereby approved. *See* Trademark Rule 2.127(a).

deposition were taken orally in the foreign country." TBMP Section 520 (2d ed. rev. 2004) and cases cited therein.

The Board find that plaintiff has failed to demonstrate the requisite good cause to take defendant's Rule 30(b)(6) deposition(s) orally in Switzerland. Defendant would incur considerable attorneys' fees and costs if its counsel were forced to travel from California to Europe for an oral depositions. In addition, insofar as defendant's witness(es) are not native English speakers and will likely need a translator at deposition, a deposition on written questions would be more efficient. *Compare Orion Group, Inc. v. Orion Ins. Co. P.L.C.,* 12 USPQ2d 1923 (TTAB 1989) ("*Orion*") (good cause shown where airfares to England were not that much greater than fares within the United States and no translator required). Lastly, we note that the circumstances presented herein are distinguishable from those in *Orion* where the non-movant had sought summary judgment based upon the affidavit of the witness whose oral deposition was sought. *Id.* at 1925.

Accordingly, plaintiff's motion to take defendant's Rule 30(b)(6) deposition(s) orally in Switzerland is denied. In view of our denial above of plaintiff's motion to take the oral deposition of a Fed. R. Civ. P. 30(b)(6)

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[3] Plaintiff did alternatively timely notice defendant for a deposition(s) on written questions in the event plaintiff's motion to take an oral deposition(s) is denied.

representative of defendant in Switzerland, the previously noticed deposition on written questions (originally scheduled to take place on September 29, 2007) may now take place.

B. Plaintiff's Motion to Compel Supplemental Responses to Plaintiff's First Set of Interrogatories and Document Production Requests

On September 19, 2007, the Board granted defendant's motion to extend its time to respond to plaintiff's motion to compel, finding the requisite good cause under Fed. R. Civ. P. 6(b), on the basis that defendant indicated that it intends to supplement its responses to the discovery requests at issue in the motion to compel.

On September 27, 2007, defendant supplemented its responses to plaintiff's discovery requests in a manner that resolved most of the issues raised in plaintiff's motion to compel.[4] However, plaintiff maintains that defendant's responses to Interrogatory Nos. 2, 9, 11, 12, 13, 17, 18, 20, 21, and 28 remain deficient insofar as the responses state that defendant "has produced documents from which a response" can be derived, without pointing specifically to such documents. Plaintiff also requests that the estoppel sanction be imposed against defendant.

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[4] The Board finds that plaintiff made a good faith effort to attempt to resolve the discovery dispute prior to seeking Board intervention. See Trademark Rule 2.120(g).

The Board agrees with plaintiff. A party may respond to interrogatories by specifying business records only if the "the burden of deriving or ascertaining the information is substantially the same for the propounding party as for the responding party." *See* TBMP Section 405.04(b) (2d ed. rev. 2004). The specification must be "in sufficient detail to permit the interrogating party to locate and to identify, as readily as can the responding party, the records from which the answer may be ascertained." *Id.* Insofar as defendant has failed to identify which specific documents are responsive to each particular interrogatory, defendant's responses fail to meet the standards set forth above. Moreover, the deficiency is compounded by the fact that the majority of the documents are in a foreign language (presumably Slovenian). Indeed, as plaintiff points out, the cost of translating thousands of documents from Slovenian to English to ascertain which are relevant to each interrogatory could potentially be prohibitive.

In view of the foregoing, plaintiff's motion to compel is granted to the extent that defendant is hereby ordered to serve supplemental responses to Interrogatory Nos. 2, 9, 11, 12, 13, 17, 18, 20, 21, and 28 of oppposer's first set of interrogatories **THIRTY (30) days** from the mailing date of this order, failing which plaintiff may move for sanctions,

including the entry of judgment, pursuant to Trademark Rule 2.120(g).

As to plaintiff's request to apply the estoppel sanction against defendant, the Board does not find that defendant's conduct rises to the level of requiring imposition of this sanction at this time. See TBMP Section 527.01(e) (2d ed. rev. 2004) and cases cited therein. However, as noted above, in the event defendant fails to comply with this Board order, defendant may be subject to sanctions, including the estoppel sanction.

II. **Motions Pending in Cancellation No. 92049146**

This case now comes before the Board for consideration of (1) plaintiff's motion to consolidate (filed April 25, 2008); (2) defendant's cross-motion to suspend Cancellation No. 92049146 pending the outcome of Opposition No. 91169226 (filed May 23, 2008); and (3) defendant's motion in the alternative to strike certain paragraphs of plaintiff's amended petition to cancel.[5] The motions are fully briefed.[6]

For the reasons explained below, plaintiff's motion to consolidate is granted; defendant's cross-motion to suspend

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[5] Plaintiff filed, as a matter of right, an amended pleading on May 6, 2008. *See* Fed. R. Civ. P. 15(a).

[6] The parties' consented motions and stipulations to extend defendant's time to file an answer in the cancellation proceeding as well as all other dates are hereby approved. *See* Trademark Rule 2.127(a).

Cancellation No. 92049146 pending the final outcome of Opposition No. 91169226 is denied; and defendant's motion in the alternative to strike certain paragraphs of plaintiff's amended petition to cancel is deferred.

When cases involving common questions of law or facts are pending before the Board, the Board may order, upon its own initiative or upon motion, the consolidation of the cases. *See* Fed. R. Civ. P. 42(a) and TBMP § 511 and authorities cited therein.

A review of the pleadings in the above identified proceedings indicates that the parties are the same, and the proceedings involved substantially identical questions of fact and law. In the cancellation proceeding, plaintiff seeks to cancel defendant's registration for the mark TOP SHOP TV. Similarly, in the opposition proceeding, defendant's application is for the mark TOP SHOP TV coupled with a design element. The literal components of defendant's registered and applied-for marks are therefore identical. Plaintiff has in each instance has challenged defendant on the basis of likelihood of confusion and priority under Section 2(d) and contractual estoppel. In the opposition proceeding, on April 26, 2007, the Board granted partial summary judgment in defendant's favor on plaintiff's claim of contractual estoppel. The contractual estoppel claim is also at issue in defendant's pending

motion to strike in the cancellation proceeding. As such, these cases may be presented on the same record without appreciable inconvenience or confusion.

Moreover, the consolidation would be equally advantageous to those parties in the avoidance of duplication of effort, loss of time, and the extra expense involved in conducting the proceedings individually. This is especially true here where the parties are both international, and consolidating the cases will facilitate the taking of discovery and testimony. For instance, the parties have already exchanged written discovery in the opposition proceeding which is potentially relevant to the cancellation proceeding. By consolidating the cases, the parties may use any discovery served and responded to in the later filed cancellation proceeding. This will include the previously noticed Rule 30(b)(6) deposition on written questions discussed above which by this order will take place shortly. By contrast, suspending the later filed case pending final disposition of the earlier filed case will not afford the parties the benefit of using discovery obtained from either case.

Under Board practice, the consolidated cases may be presented on the same record and briefs. *See Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989) and *Hilson Research Inc. v. Society for Human Resource*

Management, 26 USPQ2d 1423 (TTAB 1993). The Board file will be maintained in Opposition No. 91169226 as the "parent" case. As a general rule, only a single copy of any paper or motion should be filed herein; but that copy should bear all three proceeding numbers in its caption. Exceptions to the general rule involve stipulated extensions of the discovery and trial dates, see Trademark Rule 2.121(d), and briefs on the case, see Trademark Rule 2.128.

Despite being consolidated, each proceeding retains its separate character. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings; a copy of the decision shall be placed in each proceeding filed.

The parties are further advised that they are to inform the Board in any subsequent oppositions or cancellations are instituted which involve the same parties in the same issues.

Lastly, the Board notes that the cancellation proceeding was instituted pursuant to the Board's amended trademark rules for cases commenced on or after of November 1, 2007. See Miscellaneous Changes to Trademark Trial and Appeal Board Rules (Final Rule), 72 Fed. Reg. 42242, 42245 (August 1, 2007). Under Board practice, cases instituted prior to November 1, 2007, when consolidated with cases instituted under the amended trademark rules are suspended

until after the parties exchange initial disclosures in the amended trademark rules case. The rationale is to bring both cases in symmetry for discovery and trial purposes.

For this reason, proceedings are suspended in Cancellation No. 92049146 pending completion of the deposition on written questions in Opposition No. 91169226 and response to the Board order compelling discovery. Once the deposition on written questions is completed, the parties have **FIFTEEN (15)** days to notify the Board. The Board will then issue a subsequent order suspending proceedings in Opposition No. 91169226, rule on defendant's motion to strike, and resume proceedings in Cancellation No. 92049146. Once the parties exchange initial disclosures in Cancellation No. 92049146, the suspension in the opposition proceeding will be lifted, and both cases will proceed under the same amended trademark rules schedule.

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 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

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