

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

Baxley

Mailed: May 27, 2011

Cancellation No. 92049926

Penthouse Digital Media
Productions Inc.

v.

Cloudstreet, Inc. d/b/a
Roxbury Entertainment

Andrew P. Baxley, Interlocutory Attorney:

In the amended petition to cancel in the above-captioned proceeding, petitioner seeks to cancel respondent's three registrations for the mark ROUTE 66 in standard character form: (1) Registration No. 3189543¹ on grounds of fraud, nonuse at the time the amendment to allege use was filed in the application therefor, and abandonment of the mark with regard only to "videocassettes;" (2) Registration No. 3194255² on grounds of fraud and

¹ Such registration is for "pre-recorded DVD's and videocassettes featuring drama, action and adventure" in International Class 9. The registration issued on December 26, 2006 and alleges February 28, 1995 as the date of first use anywhere and the date of first use in commerce.

² Such registration is for "entertainment services, namely, entertainment in the nature of an on-going television program in the field of drama, action and adventure; television production services" in International Class 41. The registration issued on January 2, 2007 and alleges September 30, 1960 as the date of first use anywhere and the date of first use in commerce.

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abandonment; and (3) Registration No. 32917363³ on the grounds of fraud and nonuse at the time the statement of use was filed in the application therefor.⁴

This case now comes up for consideration of petitioner's motion (filed May 20, 2011) to compel appearance of respondent's witness under Fed. R. Civ. P. 30(b)(6) and respondent's president, Kirk M. Hallam, for discovery depositions. Respondent filed a brief in response thereto on May 26, 2011. In view of the time-sensitive nature of the motion, the Board determined that such motion should be resolved in an expedited manner with a telephone conference. See Trademark Rule 2.120(i)(1); TBMP Section 502.06(a) (3d ed. 2011). On the afternoon of May 27, 2011, such conference was held between petitioner's attorneys Kristin L. Holland and Cathay Y. N. Smith, respondent's president Kirk M. Hallam, and Board attorney Andrew P. Baxley.

In support of its motion, petitioner contends that, on March 23, 2011, it served a combined notice of deposition of respondent under Fed. R. Civ. P. 30(b)(6) and document

³ Such registration is for a "motion picture film series featuring drama, action and adventure" in International Class 9. The registration issued on September 11, 2007 and alleges May 7, 2007 as the date of first use anywhere and the date of first use in commerce.

⁴ On August 14, 2010, respondent filed a motion to dismiss the fraud claim against Registration No. 3189543. However, the Board denied that motion in an October 15, 2010 order.

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requests and a notice of deposition of respondent's president, Kirk M. Hallam, by hand delivery upon Mr. Supnik with such depositions scheduled for April 25, 2011 and April 26, 2011 respectively; that respondent failed to designate or produce any persons to appear for the Rule 30(b)(6) deposition; that Mr. Hallam failed to appear for his deposition; that respondent's president improperly asserts that discovery herein is closed based on a stipulation of the parties; that, notwithstanding respondent's assertion that discovery herein is closed, respondent noticed a deposition of petitioner's Rule 30(b)(6) witness for May 20, 2011 and a deposition of petitioner's in-house counsel for May 31, 2011; and that, while petitioner had hoped to be able to prosecute this cancellation proceeding relying solely on the discovery that the parties have taken in a now-suspended civil action between the parties,⁵ petitioner needs to take discovery regarding issues unique to the cancellation proceeding. Accordingly, petitioner asks that respondent be compelled to produce Mr. Hallam and respondent's Rule 30(b)(6) witness(es) and to produce documents responsive to the requests served with notices of deposition.

⁵ The civil action is styled *Rodbury Entertainment v. Penthouse Media Group, Inc.*, Case No. 2:08-cv-03872 JHN (FMOx), filed in the United States District Court for the Central District of California.

In response, respondent asserts that discovery in this case is closed by stipulation of the parties; that petitioner seeks improperly to take a second discovery deposition of Mr. Hallam without first obtaining leave of the Board. Respondent further contends that any discovery deposition of Mr. Hallam should be limited to one day of four hours.

As an initial matter, the Board finds that petitioner made a good faith effort to resolve the parties' discovery dispute prior to seeking Board intervention. See Trademark Rule 2.120(e)(1); TBMP Section 523.02 (3d ed. 2011).

In view of respondent's notices of discovery depositions of petitioner's Rule 30(b)(6) witness(es) and inhouse counsel,⁶ respondent cannot assert that discovery is

⁶ Depositions of opposing counsel should be limited to where the party seeking to take the deposition has shown that: (1) no other means exist to obtain the information than to depose opposing counsel; (2) the information sought is relevant and non-privileged; and (3) the information is crucial to the preparation of the case. See *Shelton v. American Motors Corp.*, 805 F.2d 1323, 1327 (8th Cir. 1986). In *Shelton*, the United States Court of Appeals for the Eighth Circuit gave the following rationale for its decision to restrict the circumstances under which opposing counsel may be deposed:

Taking the deposition of opposing counsel not only disrupts the adversarial system and lowers the standards of the profession, but it also adds to the already burdensome time and costs of litigation. It is not hard to imagine additional pretrial delays to resolve work-product and attorney-client objections, as well as delays to resolve collateral issues raised by the attorney's testimony. Finally, the practice of deposing counsel detracts from the quality of client representation. Counsel should be free to devote his or her time and efforts to preparing the client's case without fear of being interrogated by his or her opponent.

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closed in this case by stipulation of the parties. Moreover, any stipulations are "[s]ubject to the approval of the Board," which has the inherent authority to control the scheduling of cases on its docket. TBMP Sections 501.01 and 510.01. In the Board's October 15, 2010 order, the Board reset dates herein with the discovery period reset to close on June 10, 2011. Therein, the Board noted that "petitioner also indicated [in an April 30, 2010 request to resume proceedings] that 'it appears that [the parties] agree that ... the discovery period should be closed' herein. If the parties want to modify the discovery and trial schedule herein, they should prepare a stipulation which sets forth their agreed upon discovery and trial schedule." October 15, 2010 order at 7, fn.9. Because no such stipulation was either filed or approved by the Board, the trial schedule set forth in the October 15, 2010 order was operative until the Board issued its May 23, 2011 suspension order.

Further, the Board notes that petitioner took an earlier discovery deposition of Mr. Hallam in the civil action regarding some of the issues in this case. Nonetheless, because petitioner has filed an amended petition to cancel in which it changes the factual basis on which it seeks cancellation of respondent's registrations,

Id. Moreover, it may be necessary for any attorney who becomes a fact witness herein to withdraw as counsel herein. See Patent and Trademark Rules 10.62 and 10.63.

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the Board hereby grants leave to take a second discovery deposition of Mr. Hallam as respondent's Rule 30(b)(6) witness for limited purposes of taking discovery regarding changes in the factual basis of the operative complaint herein and to update information from the earlier deposition which took place two years ago. See Fed. R. Civ. P. 26(b)(2) and 30(a)(2)(A)(ii); TBMP Section 408.01.

In view thereof, the motion to compel is hereby granted to the extent modified by this order. Respondent is allowed until May 31, 2011 to verify that documents requested in the notice of deposition of respondent's Rule 30(b)(6) witness have been produced and to designate by Bates numbers which documents that were produced in the civil action are responsive to those requests.⁷ Subject to the aforementioned limitations, Mr. Hallam will appear for a discovery deposition as respondent's Rule 30(b) witness on either June 1, 2011 or June 3, 2011 in the Federal judicial district where he resides or is regularly employed or at any place on which the parties agree by stipulation.⁸ See Trademark Rule 2.120(b). Such deposition shall be limited to one day of seven hours. See Fed. R. Civ. P. 30(d)(1).

⁷ In the telephone conference, the parties agreed that discovery from the civil action can be used in this proceeding.

⁸ Because Mr. Hallam is appearing as respondent's Rule 30(b)(6) witness, he need not appear for his individually noticed deposition.

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Proceedings herein are resumed. In view of the four-day suspension of this case that resulted from the Board's May 23, 2011 order, the Board deems it appropriate to extend the discovery period by four days. Accordingly, dates are reset as follows.

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| Discovery Closes | 6/15/11 |
| Plaintiff's Pretrial Disclosures | 7/30/11 |
| Plaintiff's 30-day Trial Period Ends | 9/13/11 |
| Defendant's Pretrial Disclosures | 9/28/11 |
| Defendant's 30-day Trial Period Ends | 11/12/11 |
| Plaintiff's Rebuttal Disclosures | 11/27/11 |
| Plaintiff's 15-day Rebuttal Period Ends | 12/27/11 |

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

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.

If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.