

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

Mailed: January 24, 2012

Cancellation No. 92053398

Nowstalgic Toys, Inc.

v.

Tradex Corp.

Jennifer Krisp, Interlocutory Attorney:

This proceeding is before the Board for consideration of petitioner's motion (filed October 15, 2011) to compel discovery. The motion has been fully briefed.¹

The Board may, upon its initiative, resolve a motion filed in an inter partes proceeding by telephone conference. See Trademark Rule 2.120(i)(1); TBMP § 502.06(a) (3d ed. 2011). On January 23, 2012, the Board convened a telephone conference to resolve the issue(s) presented in the motion. Participating were petitioner's counsel Margeaux Kimbrough, Esq., respondent's counsel Simor L. Moskowitz, Esq., and the assigned Interlocutory Attorney.

The Board has reviewed the parties' arguments and submissions, but for efficiency does not restate them herein

¹ Inasmuch as petitioner's Certificate of Service indicates service of its motion on respondent by U.S. Certified Mail on

in their entirety. This order summarizes the Board's analysis and findings based on the briefs, and clarifications provided by the parties during the conference.

Written discovery requests

With respect to written discovery, petitioner states with inadequate specificity in its motion that which it seeks. It asserts that the responses to its first set of discovery requests contain "numerous objections and refusals to provide information based on the lack of a suitable protective order" (petitioner's brief, p. 2, only referring in a footnote to Interrogatory Nos. 1 - 4 and Document Request Nos. 1 - 5), and "requests that the Board compel discovery from Registrant" (petitioner's brief, pages 1 and 9). In its reply brief, petitioner more pointedly articulates that respondent "should be compelled to supplement any response previously objected to on the basis of a lack of suitable protective order" (petitioner's reply brief, p. 8).

With respect to certain written discovery requests, namely, Interrogatory Nos. 1 - 4 and Document Request Nos. 1 - 5, respondent objected on the basis that the discovery seeks information "which will not be disclosed without and until the entry of a suitable protective order." Petitioner's specific inquiry on this point in its September 26, 2011 letter to

October 17, 2011, respondent's brief in opposition thereto, filed

respondent's counsel, referencing an earlier telephone conversation that counsels had on the point, satisfies the requirement, under Trademark Rule 2.120(e)(1), that petitioner make a good faith effort, by conference or correspondence, to resolve with respondent or its counsel the issue prior to seeking the Board's intervention.²

Respondent objected on this basis in connection with Interrogatory Nos. 1 - 4, and Document Requests Nos. 1 - 5, of petitioner's first set of discovery, despite the fact that the Board, at page 3 of the December 14, 2010 order instituting this proceeding, clearly informed the parties that its Standard Protective Order was applicable as of the institution of this proceeding pursuant to Trademark Rule 2.116(g). Respondent is represented by counsel who was or should have been well aware of the applicability of the Standard Protective Order, and should have proposed to petitioner, or moved the Board for approval of, an alternative or modified order pursuant to Trademark Rule 2.116(g) if it was respondent's position that said order was insufficient. See TBMP § 412 (3d ed. 2011). No alternative order was proposed. In view of these findings, respondent's objections on this basis are overruled.

November 7, 2011, is timely. See Trademark Rule 2.127(a).

² With respect to respondent's objections to written discovery that respondent made on bases other than the asserted lack of a protective order, petitioner does not pursue these matters in seeking to compel discovery, and the record does not indicate that petitioner made a good faith effort to resolve them.

Accordingly, insofar as petitioner seeks supplemental responses to Interrogatory Nos. 1 - 4, and Document Requests Nos. 1 - 5 of petitioner's first set of discovery, the motion to compel is granted. Respondent is directed, within twenty (20) days from the conference date, to serve substantive supplemental responses to said discovery. See Fed. R. Civ. P. 26(e)(1). See also TBMP § 408.03 (3d ed. 2011).

Deposition

Petitioner seeks an order directing respondent to make its president and designee, Mr. Ken Hakuta, available for an individual and Fed. R. Civ. P. 30(b)(6) deposition. Petitioner's letters of August 23, 2011, September 26, 2011 and October 4, 2011, each directed to respondent's counsel, together satisfy petitioner's obligation, under Trademark Rule 2.120(e)(1), to make a good faith effort to resolve this matter.

Respondent's counsel indicates that the designee is a Florida domicile resident who lives in the United States for about half of the year. Petitioner noticed the depositions on two occasions.

Respondent's argument that petitioner waited until the end of discovery to notice its deposition is an unavailing mischaracterization. Discovery had been reset to close September 20, 2011 when petitioner served notice on August 23,

2011 for a September 7, 2011 deposition, and discovery had been reset to close October 20, 2011 when petitioner re-served notice on September 26, 2011 for an October 10, 2011 deposition. At any point that respondent's counsel was aware of Mr. Hakuta's upcoming schedule, such as in his October 6, 2011 letter informing petitioner's counsel that Mr. Hakuta would return from Japan on November 2, 2011, respondent's counsel could have demonstrated cooperation by proposing dates that would accommodate his client's schedule. Furthermore, it was reasonable for petitioner to elect to wait until receiving responses to written discovery, and any supplemental responses that it believed might have been forthcoming, before undertaking the deposition. Moreover, respondent's argument that petitioner chose dates for said depositions without prior consultation with respondent's counsel is not well taken, given that petitioner specifically requested alternative dates, and respondent did not timely reply to said requests. If respondent's client was unavailable during long periods due to travel and/or business activities, it was respondent, who had been made amply aware of petitioner's desire to depose respondent company, who was in the position to determine and communicate potential dates for the deposition, or to consider proposing an alternative Fed. R. Civ. P. 30(b)(6) designee. In view of all of the circumstances, respondent's characterization

of the motion to compel the deposition as "a mere scheduling issue" (respondent's brief, p. 1) is not well taken.

While both parties could have worked more diligently to engage in liberal communication and mutually schedule the deposition, in view of all the circumstances, petitioner has demonstrated that it is entitled to the order it seeks. Accordingly, insofar as petitioner seeks an order directing that respondent make its designee available for individual and Fed. R. Civ. P. 30(b)(6) depositions, the motion to compel is granted.

Respondent is directed, within ten days from the date of the conference, to provide to petitioner's counsel at least two dates on which its designee, Mr. Hakuta will be available for deposition. Said dates shall be within sixty days from the conference date. The Board considers these scheduling parameters to be lenient, reasonable, and accommodating of respondent's designee's schedule.

In the event that respondent's counsel represents in writing to petitioner's counsel that Mr. Hakuta will not be in the United States at any time during the sixty days from the conference date, the deposition shall proceed, within the sixty-day timeframe allowed herein, by telephone or other remote means such as video conferencing. See Fed. R. Civ. P. 30(b)(4); TBMP § 404.06 (3d ed. 2011); *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1654 (TTAB 2007) (to resolve conflict in

scheduling a deposition where travel is involved, parties may stipulate or the Board may order upon motion that deposition be taken by telephone or other remote means).

In its discretion, the Board resets dates so as to accommodate the parties' needs. The Board trusts that the parties will proceed in full cooperation and that no further discovery-related motions will be necessary in this proceeding.

Schedule

Proceedings are resumed. The close of discovery, and trial periods, are reset as follows:

Discovery Closes	3/23/2012
Plaintiff's Pretrial Disclosures due	5/7/2012
Plaintiff's 30-day Trial Period Ends	6/21/2012
Defendant's Pretrial Disclosures due	7/6/2012
Defendant's 30-day Trial Period Ends	8/20/2012
Plaintiff's Rebuttal Disclosures due	9/4/2012
Plaintiff's 15-day Rebuttal Period Ends	10/4/2012

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.

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