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

Proceeding	92055795
Party	Defendant E.F. Hutton Group, Inc.
Correspondence Address	ERIC J VON VORYS SHULMAN ROGERS GANDAL PORDY ECKER PA 12505 PARK POTOMAC AVENUE, 6TH FLOOR POTOMAC, MD 20854 UNITED STATES evonvorys@shulmanrogers.com
Submission	Opposition/Response to Motion
Filer's Name	Eric J. von Vorys
Filer's e-mail	evonvorys@shulmanrogers.com
Signature	/EricJvonVorys/
Date	10/04/2013
Attachments	Opposition to Mot Compel 10-4-13.PDF(1034077 bytes)

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

TERRENCE HASTINGS	:	
Petitioner,	:	Cancellation No. 92/055795
v.	:	Registration No. 4122970 E.F. HUTTON Registration No. 4126754 EFHutton
E.F. HUTTON GROUP INC.	:	
Respondent.	:	

OPPOSITION TO MOTION TO COMPEL THE DISCOVERY DEPOSITION OF ERIC J. VON VORYS AND REQUEST FOR A TELEPHONE CONFERENCE

Respondent E.F. Hutton Group Inc. ("Respondent") through counsel submits this Opposition to Petitioner's Motion to Compel the Discovery Deposition of Eric J. von Vorys and states as follows: (i) nothing in the TBMP or Fed. R. Civ. P. authorizes Mr. von Vorys' deposition; (ii) Petitioner's cited precedent does not support Petitioner taking Mr. von Vorys' deposition; (iii) even if Mr. von Vorys was required to sit for a deposition, Petitioner has not followed the proper procedure to compel it; and (iv) taking Mr. von Vorys' deposition would be futile as he has, at all relevant times, been Respondent's attorney of record and everything he would testify about is protected by the attorney-client privilege.

Respondent explained all the reasons why it is improper to take Mr. von Vorys' deposition in multiple letters and email messages to Petitioner's counsel. *See* Exhibit A to Petitioner's Motion to Compel, Email to Jess Collen dated July 17, 2013; Email to Jess Collen dated July 31, 2013; Letter to Jess Collen dated August 5, 2013 and Letter to Jess Collen dated August 27, 2013. Even though

Petitioner was aware that this Motion is a waste of the Board's time and resource, he filed it nonetheless.

GOVERNING AUTHORITY.

The Trademark Trial and Appeal Board Manual of Procedure (TBMP) Third Edition, Revision 2 (June 2013) governs who is required to sit for depositions in cancellation proceedings. Section 404.03(a) (1) identifies the persons who may be deposed without leave: "a party, or, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b) (6) or 31(a) (4) to testify on behalf of a party." Mr. von Vorys is none of these identified persons. He is Respondent's attorney of record and under the TBMP, Mr. von Vorys may not be deposed without leave.

In addition, Petitioner's Motion to Compel is outside of the Discovery period set forth in the current scheduling order. According to the current scheduling order dated May 24, 2013, Discovery closed on August 2, 2013. Petitioner was not willing to extend the Discovery period as requested by Respondent. *See* Exhibit A to Petitioner's Motion to Compel, Letter from Jess Collen dated July 30, 2013. Petitioner's Motion to Compel was filed on September 30, 2013, fifty-nine days past the Discovery deadline. TBMP § 404.01 states that all "[d]iscovery depositions must be both noticed and taken prior to the expiration of the discovery." *See also Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 U.S.P.Q. 372, 373 (TTAB 1978) ("it is clear from the language of Fed. R. Civ. P. 30 and 33 that while interrogatories need only be 'served' during the discovery period, depositions must be 'taken' during the discovery period.). As Petitioner's Motion to Compel is fifty-nine days outside of the Discovery period set forth in the current scheduling order, Petitioner's Motion to Compel is untimely and should be denied.

PETITIONER'S CITED AUTHORITY.

Petitioner cites three cases to support its Motion: (i) *Hachette Filipacchi Presse v. Elle Belle LLC*, 85 U.S.P.Q.2d 1090 (TTAB 2007); (ii) *Herbaceutical Inc. v. Xel Herbaceuticals Inc.*, 86

U.S.P.Q.2d 1572 (TTAB 2008) and (iii) *In re Brainybrawn.com*, 2002 TTAB LEXIS 406 (TTAB 2002). None of these cases provide any support for Petitioner's contention that he can take the deposition of a non-party attorney representing the Respondent. As a preliminary matter, *In re Brainybrawn.com* is unpublished and is not citable as precedent before the Board. In addition, each of Petitioner's alleged authorities was decided under the 2003 holding in *Medinol Ltd. v. Neuro Vasx, Inc.* 67 U.S.P.Q. 2d 1205 (TTAB 2003), which was overturned by *In re Bose*, 91 U.S.P.Q.2d 1938 (Fed. Cir. 2009). In fact, the Board in *Herbaceutical Inc.* specifically referenced the *Medinol* decision as support for the proposition Petitioner mistakenly relies on. Petitioner's Motion, p.5. However, as the Board is likely aware, the *Herbaceutical Inc.* decision was vacated on February 25, 2010 because the Federal Circuit decided *In re Bose*. Accordingly, Petitioner's cited quotation from the *Herbaceutical Inc.* decision has no authoritative weight. Since *Medinol* was overturned and Petitioner's cited authorities were decided under *Medinol*, Petitioner's Motion is without current support.

Even assuming *arguendo* that *In re Bose* did not overturn *Medinol* for the purpose of the present issue, none of Petitioner's cases stand for the proposition that Petitioner can take the deposition of a non-party attorney. In *Hachette Filipacchi Presse*, the Board granted Summary Judgment in finding that Respondent Elle Belle LLC committed fraud on the USPTO. Likewise in *Herbaceutical*, the Board granted Summary Judgment as to certain counts in the cancellation petition. Finally, *In re Bainybrawn.com*, was an ex parte appeal of the USPTO's final refusal. There were no depositions taken in *In re Bainybrawn.com*. In fact, none of Petitioner's cited cases actually decided that a party can take the deposition of the attorney of the other party. Petitioner has taken sentences completely out of context to support his frivolous claim that he can take the deposition of a non-party attorney.

Respondent also searched all published authority and cannot find even one decision supporting Petitioner's contention that he can take the deposition of a non-party attorney. As such, there is no authority to support Petitioner's Motion and it should be DENIED.

PROPER PROCEDURAL FORUM.

Mr. von Vorys is Respondent's attorney of record. He is neither "a party, or, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b) (6) or 31(a) (4) to testify on behalf of a party." In short, he is a non-party person residing in the United States. TBMP § 404.03(a) (2) sets forth the proper procedure for securing the deposition of a nonparty person residing in the United States.

> If a proposed deponent residing in the United States is not a party, or a person who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(4) to testify on behalf of a party, the responsibility rests wholly with the deposing party to secure the attendance of the proposed deponent. If the proposed deponent is not willing to appear voluntarily, the deposing party must secure the deponent's attendance by subpoena, pursuant to 35 U.S.C. § 24 and Fed. R Civ. P. 45. The subpoena must be issued from the United States district court in the federal judicial district where the deponent resides or is regularly employed.

Id. (internal footnotes omitted, emphasis added).

TBMP § 404.03(a) (2) is very clear on the proper procedures for securing the deposition of a nonparty person residing in the United States and it is not by filing a Motion to Compel at the Board. As such, Petitioner's Motion should be DENIED.

ATTORNEY-CLIENT PRIVILEGE.

The attorney-client privilege is intended to "encourage full and frank communication between attorneys and their clients." *Upjohn Co. v. United States,* 449 U.S. 383, 389 (1981). The privilege serves the dual purpose of shielding "from discovery advice given by the attorney as well as communications from the client to the attorney, made in pursuit of or in facilitation of the provision of legal services." *Diversified Group, Inc. v. Daugerdas*, 304 F. Supp. 2d 507, 512 (S.D.N.Y. 2003). For that reason, the "privilege attaches not only to communications by the client to the attorney, but

also to advice rendered by the attorney to the client." *Bank Brussels Lambert v. Credit Lyonnais (Suisse) S.A.*, 160 F.R.D. 437, 441-42 (S.D.N.Y. 1995). Here, Petitioner is asking the Board to compel the deposition of Respondent's attorney, in short because Petitioner does not believe Respondent's testimony with respect to the filing of Respondent's Statements of Use and the reason why Respondent advertised its services on the free Internet classified backpage.com. Anything Mr. von Vorys knows with respect to these subjects was made in connection with the provision of legal services to Respondent. Hence, they are protected by the attorney-client privilege and it would be futile for the Board to grant Petitioner's Motion to Compel.

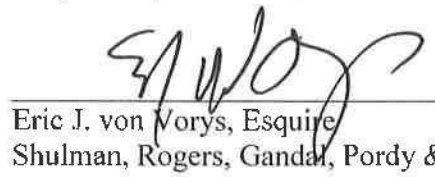
For all the above reasons, Respondent requests the Board DENY Petitioner's Motion to Compel.

REQUEST FOR TELEPHONE CONFERENCE.

TBMP § 413.01 states that "[w]hen appropriate and necessary, a motion or stipulation relating to discovery may be resolved by telephone conference involving the parties and/or their attorneys and a Board attorney or judge." Respondent respectfully requests the instant Motion to Compel be resolved by telephone conference.

Dated: October 4, 2013

Respectfully submitted,



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Counsel for Respondent E.F. Hutton Group Inc.

CERTIFICATE OF SERVICE

I hereby certify that on the 4th day of October, 2013, a copy of the foregoing document was sent via first class mail and email, to:

Jess M. Collen, Esquire
COLLEN IP, INTELLECTUAL PROPERTY LAW P.C.
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Eric J. von Vorys