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

Proceeding	92055795
Party	Plaintiff Terrence Hastings
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Date	10/24/2013
Attachments	N1407 Petitioner's Reply In Support of Motion to Compel.pdf(294870 bytes)

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

In the matter of Trademark Registration No. 4,122,970
For the Mark: E.F. HUTTON
Date registered: April 3, 2012

In the matter of Trademark Registration No. 4,126,754
For the Mark: EF HUTTON and Design
Date registered: April 10, 2012

_____)	
TERRENCE HASTINGS,)	Consolidated Cancellation No. 92055795
)	
Petitioner,)	
)	
v.)	
)	
E.F. HUTTON GROUP, INC.,)	
)	
Respondent.)	
_____)	

Trademark Trial and Appeal Board
Commissioner for Trademarks
PO Box 1451
Alexandra, Virginia 22313-1451

**PETITIONER'S REPLY IN SUPPORT OF HIS MOTION TO COMPEL THE
DISCOVERY DEPOSITION OF ERIC J. VON VORYS**

Petitioner, Terrence Hastings, through his undersigned counsel, pursuant to 37 C.F.R. § 2.127(a), respectfully submits this Reply in support of Petitioner's Motion to Compel the testimony of Eric J. Von Vorys.

1. The Information Sought in Mr. Von Vorys' Testimony is Relevant and Not Subject to the Attorney-Client Privilege

Respondent takes the position that seeking Mr. Von Vorys' deposition is *prima facie* improper, since everything he claims to know in connection with the requested subject matter is protected by the attorney-client privilege and rendered in connection with delivery of his legal services to the Respondent. *See* Opp. at 5. This attempt to create a shield of absolute immunity around factual statements provided to the Trademark Office, in a case that alleges fraud, lacks precedent and should not stand. Respondent incorrectly states that Petitioner has misstated the standard for fraud by citing *Herbaceuticals, Inc. v. Xel Herbaceuticals, Inc.*, 86 U.S.P.Q.2d 1572 (TTAB 2008). *See*, Opp. at 2-3. Petitioner cited language from *Xel Herbaceuticals* for the simple proposition that even attorneys must be truthful and accurate in their dealings with the Trademark Office. This proposition of fundamental integrity and truthfulness in dealings with this tribunal has not been overturned by *In re Bose*, 91 U.S.P.Q.2d 1938 (Fed. Cir. 2009), which remains the controlling authority for the standard to prove fraud in dealings before the Trademark Trial and Appeal Board.

The right to take the deposition of an attorney of record in a lawsuit is permitted where justice so requires. *See Shelton v. Amer. Motors Corp.*, 805 F.2d 1323, 1327 (8th Cir. 1986) (determining whether an attorney may be deposed based on the “*Shelton* Factors”: “(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 also, Hina v. Anchor Glass Container Corp.*, 2008 U.S. Dist. LEXIS 41577 (S.D. Ohio May 23, 2008); *see*

Nicholson v. Great Lakes Towing Co., 2008 U.S. Dist. LEXIS 57559, at *6-7 (E.D. Mich. July 29, 2008) (permitting a deposition of opposing counsel that was limited in scope and relevant to the issue of legal services).

In this action, not only does the proposed witness satisfy this test, but in fact, Mr. Von Vorys, in signing the Statements of Use in this case, made statements under oath and subject to penalty of perjury. These statements were regarding Respondent's alleged use of the marks in commerce, and, included other factual representations as to the truth of the information contained in the Specimens of Use. These statements were relied upon by the Trademark Office in issuing the subject registrations. His deposition testimony is relevant, proper, and non-privileged as it relates to factual statements submitted to the Trademark Office in support of registration¹.

2. Applicant's Counsel is Properly Noticed For Testimony

For purposes of the subject cancellation action, this Board has the authority to compel Mr. Von Vorys to appear for deposition. The rationale behind the Board's requirement for a subpoena such as the limited jurisdiction over non-parties is inapplicable to the facts in this instance. While the Board does not have personal jurisdiction over non-parties, it does indeed have jurisdiction over both the parties to an action and their attorneys of record. Given the Board's jurisdiction over parties and their attorneys, the Board may order a party and/or its attorney to appear, respond, and/or command them to undertake other acts in connection with the Board's inherent powers.

¹ Petitioner notes that he also disclosed Mr. Von Vorys as a trial witness in his pre-trial disclosures served on Respondent on September 16, 2013.

This is not a case where Mr. Von Vorys is not subject to the jurisdiction of this tribunal — he is an attorney of record who has filed pleadings and motions before the Board, taken discovery, and has otherwise availed himself of the privileges and responsibilities of being a practitioner before the Trademark Trial and Appeal Board. Based on Mr. Von Vorys' relationship with Respondent, actual knowledge of the Notice of Deposition, his knowledge regarding the subject matter disputed in this cancellation, and his signing the Statements of Use that are at issue in this cancellation proceeding, he is equivalent to a party, officer, director, or managing agent and should be permitted to be deposed on notice. Most critically, counsel of record may not simply ignore a deposition notice and completely elect not to move to quash in a timely fashion. It is contrary to the Rules governing these proceedings for attorneys to simply choose to ignore a deposition notice rather than availing itself of a motion to quash.

Petitioner notes that prior to this Motion to Compel, Mr. Von Vorys did not object to appearing for his deposition based on lack of a subpoena. This resistance is only articulated for the first time in opposition to Petitioner's Motion to Compel. Prior correspondence between the parties did not indicate that Mr. Von Vorys believed that he needed to be subpoenaed in order to be deposed. Since Respondent did not originally raise this objection, the Board should not permit Respondent to raise it in response to Petitioner's Motion to Compel for the first time.

Therefore, Petitioner respectfully submits that the Motion to Compel the noticed deposition be granted in all respects, and that Mr. Von Vorys' deposition testimony as it relates to the basis of his factual representations to the Trademark Office in connection with the filing of the Statements of Use be permitted.

3. Petitioner's Motion to Compel Was Timely

Petitioner filed his Motion to Compel on September 30, 2013. Petitioner's testimony period was set to open on October 1, 2013. "A motion to compel discovery must be filed prior to the commencement of the first testimony period as originally set or as reset." TMBP § 523.03 (citing 37 C.F.R. § 2.120(e); *see also, Johnson & Johnson v. Diamond Medical, Inc.*, 183 USPQ 615, 617 (TTAB 1974) (a "motion for an order to compel . . . is not untimely simply because it is made after the discovery period has expired, merely because it relates back to the earlier timely request.") Therefore, Petitioner's Motion to Compel was timely under the Trademark Rules. Additionally, Respondent acted reasonably under the circumstances by moving to compel shortly after the deposition of Mr. Daniels, when it became apparent from Mr. Daniels' testimony that he did not have knowledge of the facts regarding the declarations in the Statements of Use. *See* Petitioner's Motion at 6.

Furthermore, Mr. Von Vorys' deposition was noticed on July 12, 2013, while the discovery period closed on August 2, 2013. Petitioner's deposition notice was served and the deposition was scheduled within the discovery period. Mr. Von Vorys refused to appear for the noticed deposition during the discovery period. Additionally, while the discovery period was open, Petitioner's counsel corresponded with Mr. Von Vorys regarding Petitioner's intention to take his deposition during the period and agreed to take the deposition through other means or at a later date, if he preferred. Thus, Mr. Von Vorys was aware of the deposition notice and he should not be permitted to complain that Petitioner is now precluded from filing a motion to compel after the discovery period has

closed, when Petitioner's Motion to Compel relates back to the earlier timely deposition notice.

4. Respondent Has Waived Any Objections To Notice Of Deposition Since It Did Not File A Motion To Quash or a Motion for a Protective Order

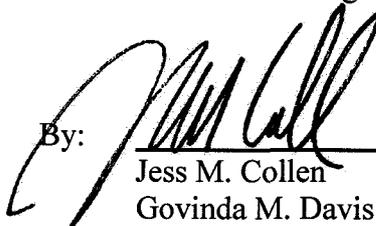
The TBMP states that if a party objects to a notice of deposition, that party should move for a protective order or to quash the deposition. *See*, TBMP §§ 521 and 526. "A motion to quash a notice of deposition should be filed promptly after the grounds therefore become known to the moving party." *See*, TBMP § 521. Respondent neither filed a motion for a protective order in response to Petitioner's deposition notice nor as a response to Petitioner's Motion to Compel. Similarly, Petitioner did not file a motion to quash after the grounds for its objection became known, or request a Board conference to resolve the discovery dispute. The correspondence between the parties attached to Petitioner's Motion to Compel as Exhibit A demonstrates that Mr. Von Vorys knew of the Notice of Deposition and chose not request the Board's assistance if he believed that the Notice was improper. Therefore, Respondent has waived such objections.

CONCLUSION

Because the information sought from Mr. Von Vorys' testimony is non-privileged, relevant and necessary to this proceeding, Petitioner respectfully requests that the Board grant his Motion to Compel the discovery deposition of Mr. Eric Von Vorys.

Respectfully submitted for,
Terrence Hastings

By:



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Attorneys for Petitioner

Dated: October 24, 2013

CERTIFICATE OF SERVICE

I, Govinda M. Davis, hereby certify that on October 24, 2013, I caused a true and correct copy of the foregoing **Reply In Support of Petitioner's Motion to Compel** to be filed with the Trademark Trial and Appeal Board and served via first class mail, postage pre-paid, upon the following counsel of record:

Shulman Rogers Gandal Pordy & Ecker, P.A.
12505 Park Potomac Ave Fl 6
Potomac, MD 20854-6803
Attention: Mr. Eric J. Von Vorys

A handwritten signature in black ink, appearing to read "Govinda M. Davis", is written over a horizontal line.