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

Mailed: November 1, 2013

Cancellation No. 92056629

Octagon Law Group Inc.

v.

Octagon Worldwide Holdings B.V.

Jennifer Krisp, Interlocutory Attorney:

This proceeding is before the Board for consideration of respondent's September 30, 2013 motion to take petitioner's deposition orally, as well as respondent's October 15, 2013 motion to quash respondent's notice of deposition of petitioner.

To resolve the issues presented in the motions, the Board convened a telephone conference, held on October 31, 2013. *See* Trademark Rule 2.120(i)(1); TBMP § 502.06(a) (2013).[1] Participating were petitioner's counsel Maria

[1] Telephone conferences are particularly useful for resolving motions where time is of the essence. The Board has the discretion to decide a motion by conference prior to the expiration of the written briefing period for filing a response and/or reply brief. If a response has not yet been filed, the non-moving party should be prepared to make an oral response to the motion during the conference. Similarly, if a reply brief in support of a pending motion has not yet been filed, the moving party should be prepared to present its reply during the conference. TBMP § 502.06(a) (2013).

Hardison, Esq., respondent's counsel Tamara Carmichael, Esq., and the assigned interlocutory attorney.

The Board has reviewed the parties' arguments and submissions, but for efficiency does not restate them herein in their entireties. This order summarizes the analysis and findings based on the briefs, and any responsive or reply arguments and clarifications made during the conference.

Trademark Rule 2.120(c)(1) provides:

> The discovery deposition of a natural person residing in a foreign country who is a party or 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 Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, shall, if taken in a foreign country be taken in the manner prescribed by § 2.124 unless the Trademark Trial and Appeal Board, upon motion for good cause, orders or the parties stipulate, that the deposition be taken by oral examination.

Trademark Rule 2.123(a)(2) provides:

> A testimonial deposition taken in a foreign country shall be taken by deposition upon written questions as provided by § 2.124, unless the Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate.

In determining whether good cause exists for a motion to take a foreign deposition orally, the Board, taking into account all relevant circumstances, weighs the equities, including the advantages of an oral deposition, as well as any financial hardship that the nonmoving party might suffer if the deposition were taken orally in the foreign country. *See Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998);

Orion Group Inc. v. Orion Insurance Co.P.L.C., 12 USPQ2d 1923, 1925-26 (TTAB 1989).

Counsel clarified that on October 1, 2013, respondent noticed the oral deposition of petitioner, pursuant to Fed. R. Civ. P. 30(b)(6), to take place November 7, 2013, in Toronto, Canada, where petitioner is located.[2]

The Board is satisfied that the common and standard advantages of taking the deposition orally, including the ability to confront the witness and employ exhibits in a direct fashion, are present in this proceeding.

Regarding direct financial hardship that petitioner might suffer if the deposition were taken orally in Canada, the Board finds that any such hardship – identified by counsel for petitioner as petitioner's expense of having its counsel travel to Toronto – is minimal. Counsel's travel is not an exceptional expense associated with litigation, and petitioner's situation does not pose extraordinary circumstances. By commencing this proceeding, petitioner is availing itself of a U.S. tribunal, and seeking to take the deposition orally is not overreaching on respondent's part. As a practical matter, travel to Toronto is not significantly more costly or more troublesome than travel within the fifty states. Counsel for petitioner has the

[2] The notice of deposition is not of record in this proceeding. Counsel for petitioner clarified that petitioner does not contest

option to attend the deposition by teleconference; in general, the Board encourages parties to use technological benefits in taking depositions. *See Hewlett-Packard Co. v. Healthcare Personnel Inc.*, 21 USPQ2d 1552, 1553 (TTAB 1991).

Lastly, petitioner's argument regarding inconvenience and projected loss of income for its designee does not present a hardship which is unique to this deponent, or is of the nature that outweighs respondent's right to depose petitioner in the manner it deems to be most appropriate. Although acknowledged, this hardship is minimal. Counsel for respondent will travel to Toronto, and she indicated that she does not anticipate that the deposition will be inordinately lengthy.

In view of all of the circumstances presented on motion and during the conference, the Board finds that respondent has demonstrated good cause to justify taking the deposition of petitioner by oral examination, as noticed. Respondent's motion to take petitioner's deposition orally is granted. Petitioner's motion to quash respondent's notice is denied.

Discovery and trial dates remain as reset in the Board's February 14, 2013 order.

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any element of the notice, other than that which is briefed on the record herein.