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

Proceeding	92056629
Party	Defendant Octagon Worldwide Holdings B.V.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

OCTAGON LAW GROUP, INC.,

Petitioner,

v.

OCTAGON WORLDWIDE HOLDINGS,
B.V.,

Registrant.

Cancellation No. 92,056,629

Mark: OCTAGON

Registration No. 2,70,833

Registration Date: July 24, 2001

REGISTRANT'S MOTION TO TAKE PETITIONER'S DEPOSITION ORALLY

Registrant Octagon Worldwide Holdings, B.V. ("Registrant") respectfully requests that the Board issue an order permitting Registrant to take the deposition of Petitioner Octagon Law Group, Inc. ("Petitioner") by oral questions. Petitioner, a Canadian corporation, is seeking to cancel Registrant's registration for OCTAGON (the "OCTAGON Mark"), claiming that it will be damaged by continued registration of the OCTAGON Mark. Registrant has requested that Petitioner consent to appear at a deposition to be taken orally, to be taken in Toronto, Canada, which is the location of Petitioner's place of business. Petitioner's counsel has refused or ignored Registrant's request to stipulate to an oral deposition, therefore pursuant to 37 CFR § 2.120(c)(1), Registrant makes this motion for good cause seeking the deposition orally.

Good cause for a motion to take a discovery deposition orally is determined on a case by case basis, and the Board weighs the equities, including the advantages of an oral deposition and any financial hardship that the party to be deposed might suffer. *Orion Group Inc., v. The Orion Insurance Co. P.L.C.*, 12 U.S.P.Q.2D 1923 (TTAB 1989).

Petitioner seeks to cancel Registrant's OCTAGON Mark, claiming that it will be damaged by the continued registration of the OCTAGON Mark. Knowledge and information about this alleged damage and the basis therefore is information solely in the possession and control of Petitioner. Such information is central to the cancellation proceeding, and Registrant is entitled to discovery thereon. Given that Petitioner is located in Toronto, Canada, and Registrant has agreed to take the deposition in Toronto, Petitioner would suffer no hardship in attending an oral deposition.

If such a deposition were not permitted, however, Respondent would be prejudiced because Respondent would be unable to confront and examine Petitioner's witness by oral examination on the basis for Petitioner's claim. *Orion Group Inc., v. The Orion Insurance Co. P.L.C.*, 12 U.S.P.Q.2D 1923 (TTAB 1989) (permitting oral deposition of foreign party to be taken in England and holding that "[i]t would be unjust... to deprive opposer of the opportunity of obtaining discovery and specifically of confronting and examining the witness by oral examination"), *citing, Society Nationale Industrielle Aerospatiale, et. al. v. U.S. District Court for the Southern District of Iowa*, 107 U.S. 522 (1987).

In this case, the balance is clear—Petitioner will suffer no hardship in the event of an oral deposition. Respondent has offered to come to Toronto, Petitioner's place of business, for the deposition. On the other hand, Respondent will be prejudiced if it is unable to question and confront Petitioner's witness about the basis for its claim.

WHEREFORE, Registrant respectfully requests that the Board issue an order permitting the deposition of Petitioner to proceed by oral examination.

Respectfully submitted,

Dated: New York, New York
September 30, 2013

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