

ESTTA Tracking number: **ESTTA706402**

Filing date: **11/03/2015**

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

Proceeding	92060849
Party	Plaintiff FINAM
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Date	11/03/2015
Attachments	Brief in Opposition to Motino to Quash Redacted.pdf(146266 bytes)

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

FINAM,

Petitioner,

v.

Sunkiss Thermoreactors, Inc.,

Registrant.

Cancellation No.: 92060849

Registration No.: 1,200,333

Mark: SUNKISS

**PETITIONER’S OPPOSITION TO REGISTRANT’S MOTION TO QUASH NOTICE
OF RULE 30(b)(6) DEPOSITION ON WRITTEN QUESTIONS AND FOR
PROTECTIVE ORDER**

Petitioner hereby submits its Opposition to Registrant’s Motion to Quash Notice of Rule 30(b)(6) Deposition on Written Questions and for Protective Order (“Motion to Quash”).

I. INTRODUCTION

The Registrant has no cognizable basis to quash a timely Notice of Deposition. Petitioner timely filed and served its Notice of Deposition on Written Questions weeks prior to the close of discovery. By their very nature, depositions on written questions require a significant amount of time to complete. See TBMP § 404.07(e); 37 C.F.R. § 2.124(d)(1). To the extent trial dates will need to be extended to accommodate the orderly taking of this deposition, it is well within the Board’s discretion to grant such extensions and it regularly does so. See TBMP §§ 404.07(b), (e) (citing 37 C.F.R. § 2.124(d)(2)). For these reasons, Registrant’s argument that Petitioner’s Notice of Deposition should be quashed on the ground that it is untimely is not well-taken.

The questions propounded in Petitioner's direct examination are all relevant and within the wide scope of permissible discovery. The questions inquire about the Registrant's use of the SUNKISS mark, the documents produced by Registrant in response to Petitioner's document production requests, and other issues that are directly relevant, and likely to lead to the discovery of relevant evidence or information. There is no evidence to support Petitioner's broad accusations that the deposition is being taken for the purposes of delay, harassment, annoyance or embarrassment.

Petitioner therefore requests that the Board deny Registrant's Motion to Quash in its entirety and otherwise order suspension of the proceedings to allow for the orderly taking of a deposition on written questions of Registrant's Rule 30(b)(6) witness.

II. PETITIONER'S NOTICE OF DEPOSITION IS TIMELY AND PROPER

Petitioner filed and served its Notice of Deposition of Registrant's Rule 30(b)(6) witness on September 24, 2015 (see DE 12), more than three weeks prior to the scheduled close of discovery.¹ If Petitioner were noticing an in-person deposition it would have certainly been able to schedule and complete the deposition prior to the close of discovery without any challenge as to timeliness. *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1653 (TTAB 2007) (six days notice reasonable); *Duke Univ. v. Haggard Clothing Co.*, 54 USPQ2d 1443, 1444 (TTAB 2000) (three days notice reasonable); *Hamilton Burr Publishing Co. v. E.W. Comm'ns, Inc.*, 216 USPQ 802, 804 n. 6 (TTAB 1982) (two days notice of deposition not unreasonable when no specific prejudice was shown).

Because Registrant is a foreign-entity, Petitioner has to take the deposition of Registrant's Rule 30(b)(6) witness on written questions. See TBMP § 404.03(b); 37 C.F.R. §§

¹ Since the Board suspended this proceeding on October 15, 2015, discovery has yet to close and will continue upon the Board's lifting of the suspension. See DE 16.

2.120(c), 2.124(d). As a result of the lengthy process for completing a deposition on written questions, the Board has the authority to suspend the proceedings or extend dates so the actual deposition need not take place outside of the discovery period. See TBMP §§ 404.01 and 404.07(b),(e) (citing 37 C.F.R. § 2.124(d)(2) (upon receipt of written notice that one of more testimonial depositions are to be taken upon written questions, the Trademark Trial and Appeal Board *shall* suspend or reschedule other proceedings in the matter to allow for the orderly completion of the depositions on written questions) (emphasis added). Sections 404.07(b) and (e) of the TBMP reference 37 C.F.R. § 2.124(d)(2), which states that the Board *shall* suspend or reschedule dates in the proceeding to allow for the completely of a deposition on written questions, to discovery depositions. As the rules contemplate a sua sponte suspension of the proceedings upon the filing of a Notice of Deposition, Petitioner is not required to explicitly request the Board to do so. Nonetheless, Petitioner respectfully requests that the Board suspend this proceeding or extend the trial dates to accommodate Petitioner's timely and proper discovery deposition.

Failure to suspend would often negate the ability to execute a deposition on written questions. Under Registrant's theory Petitioner would have to have served its Notice of Deposition and direct examination questions at a time when neither party had served any discovery responses and when, as a result, much of the subject-matter which forms the basis for Petitioner's direct examination questions was unknown. See Declaration of Kristen A. Mogavero ("Mogavero Dec.") at ¶ 2. Being required to serve a Notice of Deposition and direct examination questions that early in discovery would have denied Petitioner the opportunity to ask Registrant's Rule 30(b)(6) witness about critical and relevant documents and issues. This is

an unfair burden to place on a party who, through no fault of its own, is forced to take a deposition on written questions as opposed to an oral deposition.

Registrant's arguments make no mention of the fact that the rules expressly provide for suspension of proceedings in order to allow for depositions on written questions. The cases cited by Registrant do not support its contention that Petitioner's Notice of Deposition is untimely. See DE 15 at 2-3. In *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372 (TTAB 1978), the applicant attempted to take an oral deposition of a foreign corporation in violation of the Rules. That is not the case here. In *National Football League v. DNH Management LLC*, 85 USPQ2d 1852, 1855 (TTAB 2008), the Opposer did not notice its oral deposition until the day before discovery closed; this too is irrelevant to this case.

III. PETITIONER'S NOTICE OF DEPOSITION AND DIRECT EXAMINATION ARE PROPER AND SEEK RELEVANT INFORMATION WITHIN THE SCOPE OF PERMISSIBLE DISCOVERY

It has been generally held that the requirement of relevancy must be construed liberally and that discovery should, therefore, be generously allowed unless it is clear, beyond any doubt, that the information sought can have "no possible bearing" upon the issues involved in the particular proceeding. *La Chemise Lacoste v. Alligator Co.*, 60 F.R.D. 164, 171 (D. Del. 1973) (internal citations omitted). Parties are granted wide-latitude in discovery to inquire both as to the matters specifically raised in the pleadings as well as any matters which might serve as the basis for an additional claim, counterclaim, or affirmative defense. See *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 187 (TTAB 1974); *J.B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 579 (TTAB 1975). In light of this liberal standard, Petitioner's direct

examination questions are undoubtedly relevant. Nor are they duplicative and redundant as Registrant argues.

a. Petitioner’s Direct Examination Questions Are Neither Duplicative Nor Redundant

Registrant alleges that direct examination questions numbered 159 through 166 are “facially duplicative” because they pertain to Registrant’s answer to a request for admission. *See* DE 15 at 4, Ex. 1 (questions 159-166) and Ex. 2 (Request for Admission No. 8). This is not true. These direct examination questions are narrowly tailored to elicit further information pertaining to Registrant’s response to Petitioner’s Request for Admission No. 8 in which Petitioner alleges the existence of [REDACTED]

[REDACTED] See DE 15, Ex. 1 (Questions 159-166) and 2 (Request for Admission No. 8). [REDACTED] challenged mark is certainly relevant to a claim of abandonment as it could give rise to evidence about actual use and/or naked licensing. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Whether or not Registrant wishes to answer such questions does not impact their appropriateness.

Aside from direct examination questions 159-166 (discussed above), there are only a handful of remaining questions that Registrant claims to be duplicative of previous discovery requests propounded by Petitioner. *See* DE 15 at 3-4. There is no basis for any of Registrant’s arguments regarding these questions. For example, direct examination question 26, which Registrant claims is duplicative, inquires about the identity of the person responsible for the day to day management of Sunkiss Thermoreactors, Inc. None of the previous requests seeks this

particular information. Such broad and patently inaccurate allegations discredit Registrant's arguments. See DE 15 at 3-4 and Ex. 1, 2.

Petitioner declines to individually address each of the remaining questions that Registrant baldly claims to be duplicative. To the extent that these questions may overlap with previous discovery requests (which Petitioner is not admitting), they are either necessary to lay the foundation for subsequent questions or seek relevant information that Petitioner is entitled to inquire about. It should also be noted that Registrant responded to all of Petitioner's Interrogatories with only document production pursuant to Rule 33(d) of the Federal Rules of Civil Procedure. (See DE 15 at 3-4 and Ex. 2). Petitioner is properly utilizing this deposition to illicit actual answers and information from Registrant on these relevant issues. Registrant's novel argument that Petitioner could obtain all the information it seeks in its deposition through the use of interrogatories (see DE 5) finds no support in the Federal Rules of Civil Procedure nor the TBMP or 37 CFR. Various types of discovery devices are provided to parties and there is no hierarchy which must be followed – putting aside the fact that limiting Petitioner to interrogatories would improperly limit the scope and amount of information which it can obtain from its adversary.

b. Registrant's Direct Examination Questions are Relevant

Registrant also challenges the relevance Petitioner's direct examination questions, including questions which are intended to obtain further information regarding documents and agreements produced by Registrant in response to Petitioner's discovery requests. If the documents which are the subject of these direct examination questions are not relevant to this

proceeding, why did Registrant produce them in the first place as opposed to resting on an objection as to their relevance?

For example, questions 68 through 110 and 126 through 158 pertain to [REDACTED]

[REDACTED] See DE 15 at p. 4 and Ex. 1 (Questions 68-110 and 126-158); See Mogavero Dec. at ¶¶ 3, 4 Ex. A (Exhibits 1-3, 6). Registrant omits from its Motion the exhibits which accompany Petitioner's direct examination. Given that Registrant chose to include hundreds of pages of discovery requests and responses with its Motion, Petitioner presumes Registrant's choice to omit these exhibits was intentional to obscure the fact that many of the exhibits Petitioner's questions pertain to are actually documents produced by Registrant in this proceeding. [REDACTED]

Registrant also attacks the relevance of these questions on the basis that [REDACTED]

[REDACTED] prior to Registrant's acquisition of the Registration. See DE 15 at 4. [REDACTED]

[REDACTED] which forms the basis for direct examination questions 126-158.

See DE 15 at Ex 1; Mogavero Dec., ¶¶ 3, 7, 8 and Ex. A (Exhibits 1 and 6), D, and E. [REDACTED]

Registrant's challenges to the other direct examination questions posed by Petitioner are similarly flawed as all of Petitioner's questions are relevant (see *infra* at 8-10). Registrant's meritless motion to quash should therefore be denied.

IV. REGISTRANT'S MOTION TO QUASH SPECIFIC QUESTIONS SHOULD ALSO BE DENIED

As an alternative form or relief, Registrant requests (in a footnote) that the Board specifically quash direct examination questions 21-25, 28, 30 through 35, 45 through 49, 54, 57 through 61, 68 through 110, 126 through 158, 188 through 198, and 273 through 284. See DE 15 at 7, n. 5. Petitioner will briefly summarize each of these questions and their relevance below:

- Questions 21-25: These questions about the Registrant's corporate history and the identity of its shareholders are relevant and could lead to the identification of additional individuals with knowledge of Registrant's use of the SUNKISS mark.
- Question 28: This question seeks identification of the products (other than space heaters) that Registrant sells in the United States. Registrant's response could reveal that it has modified its product lines such that it would not reasonably include space heaters, thereby supporting Petitioner's claim for abandonment.
- Questions 30-35: These questions regarding the manufacturer of the space heaters sold under the SUNKISS mark could illicit an answer that there is no current manufacturer. This is relevant as it would evidence Registrant's lack of use of the mark in association with space heaters.
- Questions 45-49: These questions inquire as to whether Registrant ever sold or contemplated selling space heaters in the United States under a mark other than SUNKISS. Registrant's answers to the questions could reveal relevant information about its use of other marks and/or intention to abandon the SUNKISS mark.

- Question 54: This question inquires as to the consumers of space heaters allegedly sold by Registrant (or authorized third parties) under the SUNKISS mark. Information about the consumers could lead to relevant information about the location and extent of sales, if any, by Registrant, all of which is relevant to Petitioner's abandonment claim.
- Questions 57-61: These questions seek information about the business relationship between Registrant and a third party, Sunkiss SAS. Documents produced by Registrant indicate that Registrant [REDACTED] [REDACTED] of the SUNKISS mark both prior to and after Registrant's acquisition of the Registration. See Mogavero Dec. at ¶ 3 and Ex. A (Exhibits 1 and 6). These questions pertaining to the relationship between Registrant and Sunkiss SAS are therefore relevant.
- Questions 68-110, 126-158: See *supra* at 7.
- Questions 188-198: These questions pertain to Registrant (and Registrant's authorized distributors') use of the SUN-SPOT mark. Registrant produced a document which allegedly evidences its use of the SUNKISS mark in association with model numbers HT-100 and HT-200. See Mogavero Dec. at ¶¶ 3-6, Ex. A (Ex. 9), Ex. B (SUNKISS000004-5, SUNKISS000007-8) and Ex. C (Registrant's Response to Petitioner's Interrogatory No. 2). Registrant also produced a series of invoices which prominently display the SUN-SPOT mark directly above and in close proximity to "HT-100-200." See Mogavero Dec. at ¶¶ 3, 5 and Ex. A (Ex. 8, SUNKISS000272-276 and SUNKISS000294) and Ex. B. Registrant's alternating use of the SUNKISS and SUN-SPOT mark in association with the

HT100 and HT200 models lead to the reasonable conclusion that Registrant may have abandoned the SUNKISS mark and adopted the SUN-SPOT mark in association with space heaters. This line of questioning goes to the heart of an abandonment claim and Petitioner must be permitted to question Registrant on this discrepancy.

- Questions 273-284: These questions are designed to illicit further information about entities or individuals who may have further information about Registrant's use (or lack thereof) of the SUNKISS mark. For all of the reasons set forth above with respect to Questions 57-61, inquiries about SUNKISS SAS' involvement with Registrant and Registrant's use of the SUNKISS mark are relevant. Les Radiants SMR is, upon information and belief, a shareholder of Registrant and questions about its involvement in the management of the company and the use of the SUNKISS mark could lead to relevant information.

V. THERE IS NO BASIS FOR ENTRY OF A PROTECTIVE ORDER

Because Petitioner's Notice of Deposition is timely and its direct examination questions are relevant and not duplicative, there is no basis for the Board to issue a protective order prohibiting Petitioner from proceeding with this meritorious discovery deposition.

Registrant has not set forth any other grounds that would justify a protective order. No such grounds exist. The cases in which protective orders have been issued by the Board involve blatantly harassing or unduly burdensome discovery tactics. See *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1761 (TTAB 1999) (protective order against taking deposition of high level executive granted where executive has not been identified in initial disclosures or discovery requests); *Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1268 (TTAB 2015) (protective order

granted against 707 requests for admission, 247 document production requests, and 26 interrogatories). Petitioner has engaged in no such activity.

Registrant's baseless motion for a protective order should be denied. The rules provide that "[i]t is generally inappropriate for a party to respond to a request for discovery by filing a motion attacking it, such as a motion to strike, or a motion for a protective order. Rather, the party ordinarily should respond by providing the information sought in those portions of the request that it believes to be proper, and stating its objections to those which it believes to be improper." See TBMP § 526 (citing TBMP §§ 410, 412.06). "Objections to questions and answers in depositions upon written questions may be considered at final hearing." See TBMP § 404.07(f) (citing 37 C.F.R. § 2.124(g)).

VII. CONCLUSION

Petitioner filed and served its Notice of Deposition and direct examination questions in accordance with the applicable Rules. Petitioner's Notice is timely and, to the extent the lengthy process for a deposition on written questions requires a suspension of the proceedings (or extension of the discovery period), Petitioner requests that the Board exercise its discretion to order such a suspension.

Respectfully Submitted,

Dated: November 3, 2015

By: /Kristen A. Mogavero/

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JMC/KAM:cs

SHOULD ANY OTHER FEE BE REQUIRED, THE PATENT AND TRADEMARK OFFICE IS HEREBY REQUESTED TO CHARGE SUCH FEE TO OUR DEPOSIT ACCOUNT 03-2465.

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING FILED ELECTRONICALLY WITH THE UNITED STATES PATENT AND TRADEMARK OFFICE.

Date: November 3, 2015

By: /Kristen A. Mogavero/

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

FINAM,

Petitioner,

v.

Sunkiss Thermoreactors, Inc.,

Registrant.

Cancellation No.: 92060849

Registration No.: 1,200,333

Mark: SUNKISS

**DECLARATION OF KRISTEN A. MOGAVERON IN SUPPORT OF PETITIONER'S
OPPOSITION TO REGISTRANT'S MOTION TO QUASH AND FOR A PROTECTIVE
ORDER**

I, Kristen A. Mogavero, declare and state, under penalty of perjury, as follows:

1. I am an attorney at Collen IP, attorneys for FINAM ("Petitioner") in the above referenced action. The facts set forth in this declaration are personally known to me and I have first-hand knowledge thereof. If called as a witness, I could and would competently testify to all the following facts that are within my personal knowledge.

2. By agreement of the Parties, objections and responses to both parties' respective first sets of discovery requests was due on August 10, 2015.

3. A true and correct copy of the exhibits to Petitioner's direct examination questions of Registrant's Rule 30(b)(6) witness, as served on Registrant on September 24, 2015, is attached hereto as Exhibit A.

4. Exhibits 1-3 and 6 to Petitioner's direct examination (see Exhibit A hereto) were produced by Registrant in response to Petitioner's First Set of Interrogatories and Request for the Production of Documents and things.

5. A true and correct copy of documents produced by Registrant in this proceeding and labelled Bates Nos. SUNKISS000004-5, SUNKISS000007-8, SUNKISS000272-276 and SUNKISS294 are attached hereto as Exhibit B.

6. A true and correct copy of Registrant's Objections and Responses to Petitioner's Second Set of Interrogatories is attached hereto as Exhibit C.

7. A true and correct copy of an English translation of Exhibit 1 to Petitioner's Direct Examination (provided herewith as part of Exhibit A) is attached hereto as Exhibit D.

8. A true and correct copy of an English translation of Exhibit 6 to Petitioner's Direct Examination (provided herewith as part of Exhibit A) is attached hereto as Exhibit E.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed November 3, 2015 at Ossining, New York.



Kristen A. Mogavero

Exhibit A

(Confidential)

Exhibit B

(Confidential)

Exhibit C

(Confidential)

Exhibit D

(Confidential)

Exhibit E

(Confidential)

CERTIFICATE OF SERVICE

I, Carina Scorcia, hereby certify I caused a true copy of the foregoing PETITIONER'S OPPOSITION TO REGISTRANT'S MOTION TO QUASH NOTICE OF RULE 30(b)(6) DEPOSITION ON WRITTEN QUESTIONS AND FOR PROTECTIVE ORDER to be served upon Registrant's Attorney of Record at the following address via first class mail, postage pre-paid, on this 3rd day of November, 2015:

Levy & Grandinetti
PO Box 18385
Washington, DC 20036-8385
Attn.: Ms. Rebecca J. Stempien Coyle
mail@levygrandinetti.com

