

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

BUO

Mailed: August 22, 2016

Cancellation No. 92061629

StrongVolt, Inc.

v.

Matey Michael Ghomeshi

Benjamin U. Okeke, Interlocutory Attorney:

This case comes up for consideration of Petitioner's motion, filed May 11, 2016, to quash the notice of deposition under Fed. R. Civ. P. 30(b)(6) served by Respondent; and Respondent's motion to dismiss under Fed. R. Civ. P. 12(b)(5), filed May 17, 2016. As to its motion to quash, Petitioner asserts that its designated corporate "deponent is unavailable on the date and time stated in the Notice ... the matters on which examination is requested is vague, overly broad, and not within the scope of discoverable information as set forth by the TBMP; the noticed deposition location is improper; and ... the deposition notice does not indicate the manner of recording." 18 TTABVUE 2. As for his motion to dismiss, Respondent argues the petition to cancel should be dismissed "for lack of timely service," inasmuch as "the petition for cancellation period expired on June 8, 2015," but "[t]he [p]etition [f]or [c]ancellation

was hand delivered and placed in Respondent's PO Box address on June 25, 2015."¹
20 TTABVUE 2-3. The motion to dismiss is fully briefed.²

Motion to Dismiss

Fed. R. Civ. P. 12(b) reads in pertinent part:

(b) ... a party may assert the following defenses by motion:

- (1) lack of subject-matter jurisdiction;
- (2) lack of personal jurisdiction;
- (3) improper venue;
- (4) insufficient process;
- (5) insufficient service of process;
- (6) failure to state a claim upon which relief can be granted; and
- (7) failure to join a party under Rule 19.

A motion asserting any of these defenses must be made *before* pleading if a responsive pleading is allowed.

Fed. R. Civ. P. 12(b) (emphasis added).

Respondent asserts its motion to dismiss under Fed. R. Civ. P. 12(b)(5), alleging insufficient service of process. However, Respondent's answer in this proceeding was filed July 14, 2015. Petitioner has not filed any amended petition to cancel such that the date for a responsive pleading would have been reset. Therefore, any motion to

¹ Respondent appears to conflate the concepts of opposition periods, which only apply to pending applications, and the limitations identified in Trademark Act Section 14(3), which limits the grounds upon which a registration that is more than five years old may be cancelled. There is no "cancellation period," as Respondent implies inasmuch as, with the exceptions listed in Section 14(3), "[a] petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed ... at any time ..." 15 U.S.C. § 1064. In either event, these concepts are not applicable to the current proceeding.

² Although Respondent's reply brief, filed June 10, 2016, is noted, the filing of reply briefs is discouraged, as the Board generally finds, as in the present case, that reply briefs have little persuasive value and are often a mere reargument of the points made in the main brief. *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1553 (TTAB 2000); *Johnston Pump/General Valve Inc. v. Chromalloy Am. Corp.*, 13 USPQ2d 1719, 1720 n.3 (TTAB 1989) ("The presentation of one's arguments and authority should be presented thoroughly in the motion or the opposition brief thereto").

dismiss under Rule 12(b) would have had to be filed concurrent with or before Respondent's July 14, 2015 answer.

Accordingly, pursuant to Fed. R. Civ. P. 12(b), Respondent's motion to dismiss is untimely filed, and therefore, the motion will be given no further consideration.

Motion to Quash

A motion to quash may be filed on a variety of grounds, including assertions that the proposed deposition constitutes harassment or is without proper basis, *see Kellogg Co. v. New Generation Foods Inc.*, 6 USPQ2d 2045, 2049 (TTAB 1988) (notice to take deposition of CEO merely to discuss settlement was found baseless); *Gold Eagle Prods. Co. v. Nat'l Dynamics Corp.*, 193 USPQ 109, 110 (TTAB 1976) (written discovery requests directed to assignor need not be answered where assignment occurred prior to institution of proceeding), and that the deposition is not scheduled to be taken in the Federal judicial district where the proposed deponent resides or is regularly employed, *see* Trademark Rule 2.120(b).

Prior to the taking of a discovery deposition on notice alone, the party seeking to take the deposition ("the deposing party") must give reasonable notice in writing to every adverse party. Fed. R. Civ. P. 30(b)(1); Trademark Rule 2.124(b). Whether notice is reasonable depends upon the individual circumstances of each case. *Gaudreau v. Am. Promotional Events Inc.*, 82 USPQ2d 1692, 1696 (TTAB 2007). The elements to be included in the notice are specified in Fed. R. Civ. P. 30(b)(1), *e.g.* the time and place of the deposition, in the case of a 30(b)(6) deposition, a description with reasonable particularity of the matters for examination sufficient to allow the

organization to designate a knowledgeable witness to testify as to those matters, the deponents address, and the method for recording the testimony. *See, e.g., Red Wing Co. v. J.M. Smucker Co.*, 59 USPQ2d 1861, 1864 (TTAB 2001).

It is strongly recommended that the deposing party contact the party sought to be deposed (or whose officer, director, etc., is sought to be deposed) well in advance of the proposed deposition in order to arrange a mutually convenient time for the deposition.

A. Location

Respondent argues that “Orange County California is the mid-way point between Petition and Respondent,” and therefore, the deposition should be taken there rather than Petitioner’s “principle place of business.” However, as stated, Trademark Rule 2.120(b) mandates that unless otherwise stipulated by the parties, the deposition “shall be taken in the Federal judicial district where the person resides or is regularly employed.” Trademark Rule 2.120(b). This is not simply a matter of convenience, but is also meant to facilitate the required officer who must be present at the deposition pursuant to Fed. R. Civ. P. 28(a)(1).³ Accordingly, Petitioner’s motion to quash based upon an improper location for the deposition is **GRANTED**.

B. Matters Subject to Deposition

Just as in the case of written discovery requests, deposition questions must be relevant to the claims or defenses in the subject proceeding. Parties are under a duty

³ The officer must be “authorized to administer oaths either by federal law or by the law in the place of examination,” or “a person appointed by the court where the action is pending to administer oaths and take testimony.” Fed. R. Civ. P. 28(a)(1)(A)-(B).

to make a good faith effort to seek only such discovery as is proper and relevant to the specific issues involved in the proceeding. *See* Fed. R. Civ. P. 26(g); *Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1267-68 (TTAB 2015) (plaintiff's discovery requests were irrelevant and improper because they went beyond what was necessary to prove the claims before the Board and were not appropriately tailored to elicit discoverable information). Moreover, a party generally need not provide discovery with respect to those of its marks and goods and/or services that are not involved in the proceeding and have no relevance thereto. *See Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 190 (TTAB 1979) (applicant's use of mark on goods other than those in application irrelevant); *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 122 (TTAB 1974) (interrogatory too broad, requiring identity of products having no relevance to opposition).

Therefore, Respondent's use of the phrase "including but not limited to ..." in relation to Petitioner's pleaded marks and the goods covered by those marks results in inquiries that, in order to be fully and completely answered, would require information regarding marks and/or goods and services other than those involved in the present proceeding. Respondent must tailor his inquiries to the marks, goods and claims at issue herein.

Further, Respondent asserts that he "is NOT aware of any protective order issued in this cancellation proceeding." 21 TTABVUE 3 (emphasis in original). However, pursuant to Trademark Rule 2.116(g) the Board's standard protective order is automatically applicable during disclosure, discovery and at trial in all *inter partes*

proceedings without action by the parties.⁴ The standard protective order is online at: <http://www.uspto.gov/trademarks/process/appeal/guidelines/stndagmnt.jsp>.

Additionally, it is important to note the unique issue raised by confidential documents designated “for attorney’s eyes only” in a proceeding involving *pro se* parties: because Respondent has elected to move forward in this proceeding representing himself, Respondent may be precluded from receipt of information and documents so designated. However, the parties are cautioned that designation of any confidential documents should be in good faith, and only when necessary to protect matter that is in fact confidential.

C. Recording

As stated, Fed. R. Civ. P. 30(b)(3) requires that the deposing party specify in the notice of deposition the method for recording the deposition testimony. Although Rule 30(b)(3) identifies several optional methods for recording a deposition, the deposing party should specify what method of recording is actually going to be used to record the noticed deposition in order to allow the deponent to properly prepare.

Accordingly, Respondent must amend its notice of deposition to specify the manner in which the Rule 30(b)(6) deposition will be recorded.

D. Scheduling

As a matter of convenience and courtesy and to avoid scheduling conflicts, the parties should attempt to schedule depositions by agreement rather than have the

⁴ Important! Effective June 24, 2016, a revised Standard Protective Order will be applicable to all TTAB proceedings with certain exceptions. See the TTAB home page for more information:

<http://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board-ttab>.

deposing party unilaterally set a deposition date. *See Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1654 (TTAB 2007) (parties have a duty to cooperate in resolving conflicts in the scheduling and taking of depositions); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1304 (TTAB 1987) (parties ordered to work out a mutually agreeable schedule for taking of discovery depositions). As is the case throughout the discovery process, the Board expects parties (and their attorneys or other authorized representatives) to cooperate with one another in the discovery process. *See Panda Travel Inc. v. Resort Option Enters., Inc.*, 94 USPQ2d 1789, 1791 (TTAB 2009) (“Each party has a duty to make a good faith effort to satisfy the reasonable and appropriate discovery needs of its adversary.”).

Conclusion

In light of the foregoing, Petitioner’s motion to quash is **GRANTED**. Accordingly, Respondent is allowed **TEN DAYS** from the issuance of this order to serve a revised notice of deposition conforming to the strictures described in this order. Petitioner is then directed to: (1) provide Respondent, within **FIFTEEN DAYS** of the issuance of this order, seven dates upon which Petitioner’s designated witness can be made available for deposition within the ensuing **THIRTY DAYS**; and (2) appear at such deposition on the mutually agreed upon date. The parties are both cautioned that in the event of uncooperative behavior in the scheduling of the deposition, failure to meet the deadlines set by this order, or failure to appear at the scheduled deposition without sufficient notice and explanation as ordered herein, the remedy may lie in a

motion for sanctions, as appropriate. *See* Trademark Rule 2.120(g)(1); TBMP § 411.05.

Finally, the proceeding is **SUSPENDED** for **FORTYFIVE DAYS** to allow the parties to conduct the deposition. The proceeding will be resumed at the expiration of this period without further action from the Board. The proceeding will resume with the remaining time in the discovery period. The remaining discovery, disclosure and trial dates are reset as indicated below:

Discovery Closes	11/4/2016
Plaintiff's Pretrial Disclosures	12/19/2016
Plaintiff's 30-day Trial Period Ends	2/2/2017
Defendant's Pretrial Disclosures	2/17/2017
Defendant's 30-day Trial Period Ends	4/3/2017
Plaintiff's Rebuttal Disclosures	4/18/2017
Plaintiff's 15-day Rebuttal Period Ends	5/18/2017

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.