**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

CME

Mailed: July 5, 2016

Cancellation No. 92062543

*Mombacho Cigars S.A.*

*v.*

*Tropical Tobacco, Inc.*

**Christen M. English, Interlocutory Attorney:**

Pursuant to the parties' request, on June 30, 2016, the Board convened a telephone conference to address: (1) Respondent's motion, filed June 27, 2016, to quash the discovery deposition of its attorney Stewart Gitler; and (2) Petitioner's combined motion to extend and to compel, filed June 28, 2016. Lauren Sabol appeared on behalf of Petitioner, Stewart Gitler appeared on behalf of Respondent, and the assigned Interlocutory Attorney participated on behalf of the Board. The motions are opposed.

The Board first addressed Petitioner's motion to extend discovery by two months for itself only. Because Petitioner filed its motion to extend prior to the close of discovery, Petitioner need only establish "good cause" for the requested extension. Fed. R. Civ. P. 6(b)(1)(A); TBMP § 509 (2016). Generally, "the Board is liberal in granting extensions of time before the period to act has elapsed, so long as the moving party has not been guilty of negligence or bad faith and the privilege of extensions is

not abused." *Am. Vitamin Prods. Inc. v. DowBrands Inc.*, 22 USPQ2d 1313, 1315 (TTAB 1992).

As discussed during the teleconference, the Board finds that Petitioner acted diligently in pursuing discovery and there is no evidence that Petitioner has acted in bad faith in moving to extend. In addition, this is the first extension that Petitioner seeks in this proceeding. For these reasons, Petitioner's motion to extend is **GRANTED**. Nevertheless, for the reasons discussed during the teleconference, the Board orders that the depositions of Josefa Vega and Paul Palmer, scheduled for July 7, 2016 and July 8, 2016, respectively, proceed as scheduled unless Respondent consents to postpone the depositions.

Turning to the motion to quash, on June 27, 2016, Petitioner served a notice to take the deposition of Respondent's attorney Mr. Gitler. 5 TTABVUE 5-6. No subpoena accompanied the notice of deposition.

The deposition of a non-party witness residing in the United States may be taken upon notice alone if the non-party witness agrees to appear voluntarily, or by subpoena under Fed. R. Civ. P. 45. Fed. R. Civ. P. 30(a)(1); Trademark Rule 2.120(b); TBMP §§ 404.02 and 404.03(a)(2). It is clear from Respondent's motion to quash that Mr. Gitler is not willing to appear voluntarily for his deposition. Mr. Gitler also is not a party to this proceeding or an officer, director or managing agent of a party to this proceeding. Accordingly, the deposition of Mr. Gitler may not occur on notice alone. Petitioner must obtain a subpoena to depose Mr. Gitler. *Cf. Lloyd Lifestyle Ltd. v. Soaring Helmet Corp.,* 2006 WL 753243 (W.D. Wash. 2006) (considering whether to

quash a subpoena for the deposition of defendant's attorney who signed declarations in support of the involved applications). For this reason, Respondent's motion to quash is **GRANTED**.[1]

Lastly, the Board addresses Petitioner's motion to compel supplemental responses to its Interrogatory Nos. 10, 18, and 19. As an initial matter, the Board finds that Petitioner made a good faith effort to resolve its discovery dispute prior to seeking Board intervention. *See* Trademark Rule 2.120(e)(1).

With respect to Interrogatory No. 10, as explained during the teleconference, the Board finds that Respondent's response is sufficient. Accordingly, Petitioner's motion to compel is **DENIED** as to Interrogatory No. 10.

Interrogatory No. 18 requests Respondent to "[i]dentify each and every distributor, wholesaler and retailer in the U.S. who has ever purchased MOMBACHO cigars from Respondent." 6 TTABVUE 24. Although customer names are confidential, where a petitioner, like the one here, has asserted a claim of abandonment, the need for customer names "outweigh[s] the justification for protecting consumer confidentiality." *Fisons Ltd. v. Capability Brown Ltd.*, 209 USPQ 167, 169 (TTAB 1980); *see also Johnston Pump v. Chromalloy Am. Corp.,* 10 USPQ2d 1671, 1675 (TTAB 1988). Nevertheless, this interrogatory is overbroad to the extent that it is not limited to a specific time frame, and Petitioner has not pleaded a specific time frame for abandonment.

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[1] If Petitioner obtains a subpoena to depose Mr. Gitler and Respondent wishes to quash such subpoena, Respondent must seek relief from the district court that issued the subpoena as the Board has no jurisdiction to quash subpoenas. *Ate My Heart v. GA GA Jeans*, 111 USPQ2d 1564, 1565 n.5 (TTAB 2014).

Accordingly, Petitioner's motion to compel is **GRANTED, IN PART**, contingent upon Petitioner providing to Respondent by **July 17, 2016**, the time frame of Respondent's alleged abandonment. If Petitioner timely provides such information, Respondent is ordered by **August 16, 2016**, to identify: (1) its first distributor, wholesaler or retailer in the United States, *see Varian Assocs. v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975); and (2) two distributors, wholesalers or retailers in the United States for each specified year of abandonment. *Johnston Pump*, 10 USPQ2d at 1675 ("[A] party may be required to furnish, under protective order, the names of one or two of its customers for each year of a specified period of years, if there is a question of possible abandonment involved."). In the event that there are no sales to disclose for a particular year, Respondent shall so state.

Interrogatory No. 19 requests information regarding Respondent's geographic areas of distribution or sales (6 TTABVUE 24), which is discoverable information. *See* TBMP § 414(16) and cases cited in footnote 24 thereto. As discussed during the teleconference, Respondent's response to this interrogatory is vague and ambiguous as it is unclear whether Respondent has distributed its goods throughout the United States or only in Texas, Florida, New York and New Jersey. 6 TTABVUE 24. Accordingly, Petitioner's motion to compel is **GRANTED** with respect to Interrogatory No. 19 and Respondent is ordered by **August 16, 2016** to supplement its response to make clear the geographic areas in the United States in which it has distributed or sold the goods identified in its involved registration.

Dates are reset as follows:

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| Discovery Closes for Respondent | **7/8/2016** |
| Discovery Closes for Petitioner | **9/8/2016** |
| Plaintiff's Pretrial Disclosures Due | **10/23/2016** |
| Plaintiff's 30-day Trial Period Ends | **12/7/2016** |
| Defendant's Pretrial Disclosures Due | **12/22/2016** |
| Defendant's 30-day Trial Period Ends | **2/5/2017** |
| Plaintiff's Rebuttal Disclosures Due | **2/20/2017** |
| Plaintiff's 15-day Rebuttal Period Ends | **3/22/2017** |

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.

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