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

Reed Elsevier Properties, Inc.,	)	
	)	
Opposer,	)	Opposition No. 115,119
	)	
v.	)	
	)	
Interface Systems, Inc. and Dynamic Fax, Inc.,	)	
	)	
	)	
Applicants.	)	

REQUEST FOR RECONSIDERATION, STAYAND RESETTING OF TESTIMONY PERIODS, AND REQUEST FOR TELEPHONE HEARING

Opposer respectfully requests reconsideration of that portion of the Board's June 25, 2004 order requiring Opposer to depose Applicant's sole, key witness, Jeffrey Schneider, by telephone. This motion is timely pursuant to Trademark Rule 2.127 (b).

Preliminarily, Opposer does *not* seek to prohibit Applicant's counsel from attending the cross examination or taking the redirect of its witness by telephone. Opposer seeks reconsideration of only that portion of the order barring Opposer from cross-examining the witness in person.

Opposer respectfully maintains that the Board's specific and express order barring Opposer's counsel from cross-examining in person violates federal precedent by specifically disallowing the usual means of eliminating prejudice in a telephone deposition case. "In applying and interpreting our rules, the Board must look to federal court practice." See, *Hewlett Packard Co v Healthcare Personnel Inc.*, 21 USPQ2d 1552(1992).

As Professor Moore notes, even in those cases where a *party deponent* succeeds in having a deposition taken by telephone, the courts generally permit the cross-examining party to

appear in person if it wishes. *Moore's Federal Practice 3d, Section 30.24[1].* As noted by Professor Moore:

> "If another party finds a telephone deposition inadequate, nothing – absent a court order – bars that party from attending in person, .. which would ameliorate .. any potential prejudice."

Id. However, this is precisely the order the Board has entered in this case.

Opposer respectfully submits the effect (and Applicant's intended effect) of the Board's decision is to bar Opposer's counsel from the deposition room. And nothing in law or equity supports the Board's rule.

First, while presumptively favoring a party's motion to depose an adverse party, courts impose a higher standard on a *party deponent* insisting that its deposition be taken telephonically. *Id.* That is to say, in determining whether to order a telephone deposition, the courts distinguish between requests by a *party deponent, such as Mr. Schneider, and those requests by the party to do the questioning (as in Hewlett Packard) or a third party witness to perform the deposition telephonically.* As Professor Moore states:

> In the leading case requiring extreme hardship for the use of telephone depositions, the plaintiff [was] attempting to insist that *his* deposition be taken by telephone even though the defendant .. was obviously interested in deposing the plaintiff in person.... The case law is consistently favorable when the party seeking the deposition, *rather than the deponent,* makes the request.

Id. Two rationales support this distinction. First, any party who is being deposed by the adverse party obviously is interested in avoiding the crucible of a live deposition. Thus, courts must scrutinize such requests carefully and weigh the prejudice to the questioning party against the alleged need. In the case of a party deponent, the prejudice to the adverse party usually outweighs the deponent's need. That is, except in exceptional cases, such as involve traveling

great distances or impecunious plaintiffs, cost and mere inconvenience alone are not usually sufficient reasons for requiring a party to conduct a deposition of its adversary telephonically. *See, Moore's supra, and cases cited there.* Indeed, precisely because of these factors, some federal courts require *a party-deponent* (as opposed to a third party witness) attempting to insist that *its own deposition* be taken by telephone show "extreme hardship" or at least some "hardship" justifying the prejudice to the adverse part. See, *Moore's Federal Practice, Section 30:24.*

The Board's order will clearly prejudice Opposer. Cross-examining a witness is always difficult at best. Confronting a witness in person so as to be able to gauge the reactions of the party and to control activities in the room is a fundamental aspect of trial practice. Further by requiring cross-examining the witness over the phone, Opposer will be required to mark and yield any of its exhibits in advance to the other side. This takes much more time on Opposer's part and will permit Applicant and its counsel a significant procedural advantage in being able to review and discuss at length the exhibits before the deposition begins.

And, no reason exists for the Order. Barring Opposer's counsel from a live deposition will not save Applicant one penny (the sole reason advanced by Applicant for the Order). The Board's order saves Opposer, not Applicant, money because Applicant's attorney can choose to attend by telephone if it wishes. As Applicant has noted all of its direct testimony already has been taken and filed with the Board. Its testimony having been entered, Applicant has no need to attend personally. The Applicant's counsel can object telephonically. The remainder of the deposition will consist largely of Opposer's counsel questioning the witness, while Applicant's counsel monitors the questioning, objects, where needed, and then briefly conducts redirect.

Further, the Board should note that the cost of traveling from Applicant's attorney's offices in Michigan to Applicant's offices in Illinois is really very minimal. Applicant is a sufficiently large organization and the distance between Applicant's office and its counsel is roughly equivalent to the distance between Boston and Philadelphia. The deposition should take no more than a few hours. Applicant's counsel cannot seriously contend that travel on behalf of Applicant by one of its attorneys for a deposition constitutes such a severe burden that Opposer should suffer the prejudice of being barred from the deposition in person.

Finally, Opposer respectfully requests that the testimony periods be stayed pending the disposition of this motion; that the Board hold a teleconference to expedite a ruling on this motion; and that the Board reset the time for the parties to hold the cross-examination of Mr. Schneider and the rebuttal testimony period.

Respectfully submitted,

REED ELSEVIER PROPERTIES, INC.

Date: July 20, 2004

By: 

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the Opposer's Request for Reconsideration, Stay and Resetting of Testimony Periods, and Request For Telephone Hearing is being served upon Applicant/Party Defendant's counsel this 20th day of July, 2004 by first class mail postage prepaid as follows:

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July 20, 2004

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Re: *Reed Elsevier Properties, Inc. v. Interface Systems, Inc. and Dynamic Fax, Inc.*
Opposition No. 115,119

Dear Sirs:

We enclose for filing Opposer's Request for Reconsideration, Stay and Resetting of Testimony Period, and Request for Telephone Hearing.

No fee is believed necessary. The Assistant Commissioner for Trademarks is hereby authorized to draw on the deposit account of Rothwell, Figg, Ernst & Manbeck, Account No. 02-2135, if a fee is deemed necessary.

Please call if there are any questions.

Very truly yours,

Carla C. Calcagno

CCC/jea
Enclosures