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

TTAB

Reed Elsevier Properties, Inc.)		
	)	Opposition No. 115,119
Opposer,	)	
	)	Application Serial No. 75/497,661
v.	)	
	)	Published: June 1, 1999
Interface Systems, Inc.,	)	
	)	
Applicant,	)	
	)	
Dynamic Fax, Inc.,	)	
	)	
Party Defendant.	)	

RESPONSE TO OPPOSER'S REQUEST FOR RECONSIDERATION, STAY AND RESETTING OF TESTIMONY PERIODS, AND REQUEST FOR TELEPHONE HEARING

LAW OFFICES YOUNG & BASILE, P.C., 2001 COMMONWEALTH BLVD., SUITE 301, ANN ARBOR, MI 48105-1562 (734) 662-0270

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I. INTRODUCTION

On December 23, 2003, pursuant to notice duly served, Defendant Dynamic Fax, Inc. took the testimony deposition of Jeffrey C. Schneider. For reasons which remain unclear, Opposer's counsel apparently failed to receive notice of this deposition, and thus was not in attendance at the scheduled time and place to cross-examine Mr. Schneider. Nevertheless, having found that Defendant complied with all applicable rules in noticing Mr. Schneider's testimony deposition, the Board denied Opposer's Motion to Strike that testimony in its Order of June 25, 2004. In that Order, the Board further adopted Defendant's suggestion that Opposer be provided the opportunity to telephonically cross-examine Mr. Schneider. That deadline has now come and gone, however. And instead of taking Mr. Schneider's testimony, Opposer has filed the instant request for reconsideration of the Board's Order that Mr. Schneider's cross-examination be taken telephonically.

II. LAW AND ARGUMENT

A. *A Reconsideration Request Requires Demonstration of Error*

To support a request for reconsideration, the movant must demonstrate "that, based on the facts before it and the applicable law, the Board's ruling is in error and requires appropriate change." TBMP § 518.

In this instance, Opposer asserts that the Board's decision to grant the opportunity for Mr. Schneider's telephonic cross-examination departs from precedent, and, moreover, will prejudice Opposer. As evidenced below, however, these contentions are simply wrong, and the Board's June 25th Order should thus stand undisturbed.

B. *Telephonic Depositions are Favored, and No Showing of Hardship is Required in this Instance*

Telephone depositions are, quite contrary to Opposer's arguments, perfectly appropriate, and should be liberally employed. The TTAB acknowledged as much in Hewlett-Packard Company v. Healthcare Personnel, Inc., 21 USPQ2d 1552 (TTAB 1991):

> "In applying and interpreting our rules the Board must look to federal court practice, *and currently federal practice favors the use of technological benefits in order to promote flexibility, simplification and reduction of costs to parties.*" *Id.* (*emphasis added*).[1]

Equally contrary to Opposer's assertions, it is unnecessary, at least in this instance, for Defendant to demonstrate "extreme hardship" in order for the Board to take advantage of the flexibility, simplification, and cost savings associated with a telephonic cross-examination. Such is simply inconsistent with the TTAB's own precedent. As the Board noted in Hewlett-Packard:

> "As the courts have pointed out, when Fed.R.Civ.P. 30(b)(7) was amended in 1980 to permit the taking of telephone depositions, the purpose was to encourage courts to be more amenable to employing non-traditional methods for conducting depositions. *Nothing* in the language of Rule 30 requires a showing of necessity, financial inability or other hardship to obtain an order to proceed via telephone, and *leave to take telephonic depositions should be liberally granted* in appropriate cases." 21 USPQ2d at 1553 (*emphasis added*).

1 Notably, this is the very same sentence from which Opposer so disingenuously ripped from context the statement, offered to support its position against telephonic cross-examination, that the Board looks to federal court practice for guidance.

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And while Professor Moore does identify two reported cases where other courts required a showing of hardship in order to proceed with telephone depositions, these cases are inapposite and misapplied by Opposer to the circumstance at bar. For in both of these cases, it was the party deponent's *insistance* on a telephone deposition which led the courts to impose a higher standard for granting the request. *See* Clem v. Allied Van Lines Int'l Corp., 102 FRD 938 (S.D.N.Y. 1984), and U.S. v. Rock Springs Vista Dev., 185 FRD 603 (D. Nev. 1999). Instantly, however, Defendant makes no such demand. On the contrary, Defendant's *suggestion* to depose Mr. Schneider was made simply as a possible accommodation to Opposer in the face of its motion to strike, not as an effort to avoid the "crucible of a live deposition." In point of fact (conveniently overlooked by Opposer), Mr. Schneider was, pursuant to duly served notice, already presented for and gave his in-person testimony in this matter.[2]

C. *A Telephone Deposition Is Not Prejudicial*

In a further effort to persuade the Board that its June 25th Order was wrong, Opposer offers up a multitude of supposed prejudices attributable to a telephone cross-examination of Mr. Schneider, including denial of the opportunity to personally confront the witness, and unfair advantage to Defendant in reviewing exhibits with the witness in advance of the deposition. Conversely, Opposer suggests that no prejudice is worked on Defendant if the instant motion is granted and Opposer allowed the chance to cross-examine Mr. Schneider in person, as Defendant is not itself restricted from participating telephonically and, in any

2 Which fact should certainly discredit Opposer's baseless contention that Defendant's intended effect of a telephone cross-examination is to bar Opposer's counsel from the deposition room.

event, the costs for Defendant to personally attend the cross-examination are not that great. These assertions have little merit.

It is ludicrous, in the first instance, to assert that the mere absence of face-to-face confrontation of a witness is prejudicial. If such were the case, then telephone depositions would *never* be appropriate, as the court in Jahr v. IU International Corp. so rightly observed:

> "In civil cases, the better rule is that a request for telephonic deposition should not be denied on the mere conclusory statement that it denies the opportunity for face-to-face confrontation. Unlike criminal cases, depositions for unavailable witnesses are routinely read to the jury. Reading a telephonic deposition will be no different than reading any other deposition. The only change that is created by a telephonic deposition is that the attorneys cannot see the witness. However, telephone conferences are becoming an increasing reality in business and law. Finally, lack of face to face questioning is the very essence of a telephonic deposition. Acceptance of defendant's argument would be tantamount to repealing subsection (b)(7)." 109 FRD 429, 432 (M.D. N.C. 1986)(Analyzing Rule 30(b)(7) at length).

As for the supposed prejudice of reviewing deposition exhibits in advance, it should be noted that any conceivable documentary evidence to be used in cross-examination has already been known to the witness and Defendant, which doubtless produced the same, for a great long while. This fact notwithstanding, it is certainly the case that Opposer can control the manner in which its selected exhibits are made available to Defendant's counsel and the deponent; provided, of course, that the same are delivered in time for the deposition. Thus, for instance, it is well within Opposer's power to simply fax or deliver on the morning of the deposition such documents as it intended to employ in Mr. Schneider's cross-examination.

Turning then to the alleged lack of prejudice to Defendant, Opposer's arguments certainly have a hollow ring. Defendant cannot very well permit Opposer to personally attend the deposition of Mr. Schneider without itself providing in-person representation for the witness. To proceed otherwise would be to foolishly subject a lay person to the undue

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pressure of facing seasoned litigation counsel alone. And as for the contention that a second excursion to Illinois is no great expense, Opposer's argument simply misses the point that Defendant, having once in good faith undertaken the considerable expense of sending counsel to take the in-person testimony deposition of Mr. Schneider, should not be forced to incur such expense a second time.

Importantly, these supposed "prejudices" were already considered by the Board in making its June 25th Order, as reflected therein. Particularly as they are coupled in Opposer's instant motion with no new demonstration of how the Board misapplied these facts in the face of precedent, they present no compelling reason in favor of reconsideration.

III. CONCLUSION

In light of the foregoing, Defendant respectfully submits that there is no error which can be assigned to the Board's June 25th Order allowing Opposer until July 20th to take the telephonic cross-examination of Jeffrey C. Schneider. Accordingly, that Order should be sustained. Relatedly, Defendant respectfully submits that, in view of the clear lack of merit in Opposer's position on this matter, the dates in the Board's June 25th Order remain undisturbed and Opposer not be permitted a further opportunity to cross-examine Mr. Schneider.

Respectfully submitted,

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DATED: August 2, 2004

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	)	
Dynamic Fax, Inc.,	)	
	)	
Party Defendant	)	

CERTIFICATE OF MAILING

The undersigned hereby certifies that an original of Dynamic Fax, Inc.'s Response to Opposer's Request for Reconsideration, Stay and Resetting of Testimony Periods, and Request for Telephone Hearing was filed with the United States Patent and Trademark Office, Trademark Trial and Appeal Board, 2900 Crystal Drive, Arlington, Virginia 22202-3513, via First Class Mail on August 2, 2004.

CHRISTOPHER A. MITCHELL

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Party Defendant	)	

CERTIFICATE OF SERVICE

The undersigned hereby certifies that Defendant Dynamic Fax, Inc. served the following documents on Carla C. Calcagno, Rothwell, Figg, Ernst & Manbeck, P.C., 1425 K Street, NW, Suite 800, Washington, D.C. 20005, via facsimile at (202) 783-6031, on August 2, 2004:

- Response to Opposer's Request for Reconsideration, Stay and Resetting of Testimony Periods, and Request for Telephone Hearing

Linda L. Braman

Linda L. Braman