UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

PTH

Opposition No. 116,554

Adobe Systems Incorporated

v.

Acro Software, Inc.

Before Quinn, Hairston and Holtzman, Administrative Trademark Judges.

By the Board:

This case now comes up on the following matters: (1) applicant's motion to quash notice of deposition and for a protective order; (2) applicant's motion to quash supplemental notice of deposition and for a protective order; (3) opposer's motion to compel, extend opposer's discovery period and testimony periods, or in the alternative, for judgment against applicant; and (4) opposer's amended motion to compel, extend opposer's discovery period and testimony periods, or in the alternative, for judgment against applicant. These motions have been fully briefed by the parties.

Before deciding the respective motions, a review of the background of this case is necessary. The notice of

opposition in this matter was mailed to applicant on January 11, 2000. Answer was due on February 22, 2000. No answer having been filed, on April 20, 2000, the Board issued a notice of default. In response, on April 28, 2000, applicant filed an explanation for its late filing and an informal answer. Applicant stated that its president, Ching Luo, had mailed the answer from China where he was traveling on business, and that apparently the answer never reached the Board. By order dated June 23, 2000, the Board vacated the default, and allowed applicant thirty days until July 23, 2000, in which to file a proper answer. On August 22, 2000, thirty days late, applicant filed its answer. Applicant explained that it is a small business whose president, Mr. Luo, was out of the country from May 9 to August 12, and that it was seeking counsel to represent it in this matter. On October 23, 2000, opposer filed a motion for default judgment, or in the alternative, for a resetting of discovery and testimony periods. Opposer's motion for default judgment was denied in view of applicant's explanation and trial dates, including the period for discovery, were rescheduled. The discovery period was set to close April 5, 2001. On February 23, 2001 opposer served on applicant interrogatories and requests for production of documents. On March 20, 2001 opposer served on applicant a notice of deposition scheduled for April 5, 2001 at 9:00 am

in Richmond, Virginia. Applicant, who is represented by its president, Mr. Luo, on March 26, 2001, moved to quash the notice of deposition and for a protective order with respect to the discovery requests. Opposer then served, on March 28, 2001, a supplemental notice of deposition on applicant wherein it withdrew the prior notice of deposition and requested that the deposition be rescheduled, for a date and time to be determined, after the Board ruled on the motion to quash. Applicant, on March 30, 2001 filed a motion to quash this supplemental notice of deposition and for a protective order with respect to the discovery requests. On April 4, 2001 opposer filed a motion to compel, extend opposer's discovery period and testimony periods, or in the alternative, for judgment against applicant; and on May 17, 2001 opposer filed an amended motion to compel, extend opposer's discovery period and testimony periods, or in the alternative, for judgment against applicant.

We consider first applicant's motions to quash. Applicant requests that opposer not be allowed to take the deposition of applicant's president, Ching Luo, because English is not Mr. Luo's native language. In particular, applicant states that Mr. Luo is "slow" in his ability to understand and speak English, and that it would be embarrassing and oppressive for him to submit to an oral deposition. Also, applicant contends that such a discovery

deposition is unnecessary because it would be duplicative of the information opposer seeks in its interrogatories and request for production of documents. Further, applicant objects to the supplemental notice of deposition on the basis that it fails to designate the date and time of the deposition.

Opposer, however, argues that it is applicant's duty under Fed. R. Civ. P. 30(b)(6) to designate and make available an officer or other knowledgeable person for purposes of conducting a discovery deposition; and that applicant should not be allowed to thwart this discovery by designating Mr. Luo and then requesting that he be excused from appearing for the deposition because he is not fluent in English. Further, opposer maintains that it is entitled to take the discovery deposition irrespective of whether some of the deposition topics are duplicative of opposer's interrogatories and request for production of documents. As regards the supplemental notice of deposition, opposer states that it simply wanted to give the Board an opportunity to rule on the motion to quash before scheduling a new date and time for the deposition.

Pursuant to Fed. R. Civ. P. 30(b), opposer is permitted to take the discovery deposition of an officer or other person knowledgeable about the matters set forth in opposer's notice of deposition. In this case, it appears

that applicant's president, Mr. Luo, is that person. We note in this regard that applicant has not indicated that there is another person who is knowledgeable about such matters. In view thereof, Mr. Luo must make himself available for the discovery deposition, notwithstanding his apparent deficiencies with respect to English. If Mr. Luo believes that his deficiencies are such that he would not be able to understand and effectively respond to the questions posed to him, he should arrange for a translator to be present at the deposition. Additionally, opposer is correct that it is of no consequence that some of the matters which are to be covered in the deposition are also the subject of opposer's interrogatories and request for production of documents. As pointed out by opposer, discovery depositions serve a different purpose from written discovery requests. Further, in view of applicant's motion to quash, opposer can not be faulted for withdrawing the first notice of deposition and requesting that the deposition be rescheduled for a date and time to be determined after the Board's ruling on the motion to quash. In view of the foregoing, applicant's motions to quash the first and supplemental notices of deposition are denied. Mr. Luo is directed to make himself available for the discovery deposition at a date and time to be agreed upon by the parties, no later than thirty days from the mailing date of this order.

We turn next to applicant’s motions for a protective order and opposer’s motion and amended motion to compel. Because these motions all deal with opposer’s interrogatories and request for production of documents, we will consider them together. At the outset, we note that the first motion to compel was essentially based on applicant’s failure to file any responses to opposer’s discovery requests. Applicant has since served responses to opposer’s discovery requests, which caused opposer to file the amended motion to compel. Thus, opposer’s first motion to compel is denied as moot. Turning then to opposer’s amended motion to compel, opposer argues that responses to its discovery requests were due March 30, 2001; that opposer did not receive applicant’s responses until April 9, 2001; that although the responses bear a certificate of service dated March 30, 2001, the postmark on the envelope bearing the responses was dated April 2, 2001; that this means the responses were actually mailed sometime between March 31 and April 2, 2001; that not only are the responses untimely, but they are wholly inadequate; and that on May 3, 2001, opposer sent a letter to applicant offering five afternoons during which opposer’s counsel would make herself available to discuss with applicant the deficiencies in the responses, but that applicant made no response to opposer’s letter.

Applicant, on the other hand, states that it placed its discovery responses in the mail on March 30, 2001; that a number of opposer's discovery requests are overly broad, burdensome and misleading and thus, applicant should not be required to answer such requests; that applicant is a small business and is unable to afford an attorney; and that its president has spent a tremendous amount of time learning the applicable rules of procedure in order that applicant may be in compliance therewith.

First, as regards the alleged untimeliness of the responses, it is conceivable that applicant placed the responses in a mail box on Friday, March 30, 2001, and that they were not picked up by the Postal Service until Monday, April 2, 2001. Second, as regards opposer's contention that applicant's responses to opposer's interrogatories and request for production of documents are wholly inadequate, we disagree. After review of applicant's responses, we find that applicant has made a credible effort to respond to the discovery requests. We believe that the deficiencies to which opposer points could easily have been resolved if applicant had conferred with opposer as requested and the parties had entered into a protective order that would govern confidential information. In view of the foregoing, applicant's motions for a protective order with respect to opposer's interrogatories and request for production of

documents are denied and applicant is directed to confer with opposer within thirty days of the mailing date of this order to resolve the matters raised in opposer's amended motion to compel. Again, if Mr. Luo believes that he will unable to confer with opposer's attorney effectively because of his difficulties with English, he should retain the services of a translator. Opposer's amended motion to compel is denied without prejudice, and opposer may renew the motion if the parties are unable to work out their differences. The Board strongly believes, however, that a truly good faith effort by the parties will result in resolution of most, if not all, of the discovery dispute.

Finally, in view of our above rulings, opposer's alternative motion for entry of judgment against applicant is denied as moot. We note, however, that in support of this motion, opposer argues, inter alia, that applicant has failed to comply with deadlines and mandates set by this Board; that applicant has failed to cooperate with respect to discovery; and that applicant has been less than honest regarding Mr. Luo's deficiencies in English and the contention that applicant is being represented solely by Mr. Luo in this proceeding.

We wish to make clear to applicant that it is under a duty to be truthful with respect to all filings in this proceeding, and as pointed out in a previous order,

applicant is expected to comply with the Trademark Rules of Practice. Also, we wish to make clear to applicant that the Board expects parties to cooperate with one another in the discovery process, and we look with extreme disfavor upon those that do not.

Lastly, we turn to opposer's motion for an extension of the period in which it may take discovery. Inasmuch as opposer served its written discovery requests early enough in the discovery period to allow it to take follow-up discovery, opposer's motion is granted.

Trial dates, including the period in which opposer may take discovery, are rescheduled below.

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. Rule 2.125.

THE PERIOD FOR DISCOVERY TO CLOSE: (**for opposer only**)	February 8, 2002
Testimony period for party in position of plaintiff to close: (opening thirty days prior thereto)	May 9, 2002
Testimony period for party in position of defendant to close: (opening fifteen days prior thereto)	July 8, 2002
Rebuttal testimony period to close: (opening fifteen days prior thereto)	August 22, 2002

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