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

Proceeding	91121980
Party	Defendant ROBERT NOBLE & BONGO, S.A., DE C.V. ROBERT NOBLE & BONGO, S.A., DE C.V. ,
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Date	09/01/2006
Attachments	MF Sanctions.pdf (8 pages)(123029 bytes) Exhibit1.pdf (3 pages)(116849 bytes)

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

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ESTEFAN ENTERPRISES, INC.

Petitioner/Opposer,
vs.

Opposition No.: 91121980
Cancellation No.: 92042251
Registration No.: 2,347,247

BONGO, S.A. de C.V. and ROBERTO NOBLE,
Registrants/Applicants.

-----X

**PETITIONER/OPPOSER'S MOTION FOR SANCTIONS AS TO DEPOSITION
CONDUCT**

Registrant/Applicant ROBERTO NOBLE, as successor-in-interest to BONGO, S.A. de C.V., by and through undersigned counsel hereby file the herein Motion for Sanctions pursuant to TBMP §411.04, for Petitioner/Opposer's failure to provide discovery, and further state:

1. Registrant/Applicant BONGO, S.A. de C.V. and ROBERTO NOBLE as successor-in-interest to BONGO, S.A. de C.V., served Bongo's First Request for Production of Documents and Things on June 7th, 2004, to which Petitioner/Opposer failed to fully and adequately provide all of the documents which Registrant/Applicant is entitled to. (*See, Registrant's/ Applicant's Motion to Compel filed on August 31, 2006*).
2. Registrant/Applicant scheduled a deposition of Raul Matias, the general manager of Petitioner's/Opposer's Orlando restaurant.
3. Registrant/Applicant scheduled a deposition of a corporate representative of the Petitioner/Opposer entity for August 21st, 2006.

4. It was not until one (1) day prior to the deposition that the Petitioner/Opposer produced financial documents, which Registrant/Applicant requested over two (2) years earlier in its Request to Produce.

5. During both depositions, the counsel for Petitioner/Opposer was engaging in so-called *Rambo* litigation, by: a) making speaking objections; b) “coaching” the witness on how to answer specific questions while questions were pending; c) answering questions for the witness; d) instructing the witness not to answer specific questions without asserting any sort of privilege; e) engaging in long disruptive narratives and arguments about questions and the subject matters thereof before the witness had a chance to answer; f) interrupting questions midstream to argue; and g) refusing to answer any questions about the use of the respective marks in Mexico, or use by third parties, thus preventing the elicitation of any meaningful testimony from the witness on various material issues and thus severely compromising the witnesses’ testimony. (*Excerpts from the depositions of Petitioner’s/ Opposer’s corporate representative and witness Raul Matias shall be filed separately as a single combined supplement hereto when the transcript of the corporate representative is received by the undersigned. Said transcript was ordered at the deposition*).

6. *Augusto Odone v. Croda International PLC*, 170 Fed. R. Serv. 3d 157 (D.C. Dist. 1997) states as follows:

“It is well settled that in the course of a deposition, an attorney is prohibited from engaging in so-called *Rambo* litigation, in which he attacks every question posed by the opposing counsel thus preventing the elicitation of any meaningful testimony from the witness. The attorney also may not object to questions in such a way as to “coach” the witness or suggest an answer.”

7. In the case of *Collins V. Intern'l Dairy Queen, Inc.* 1998 WL 293314 (M.D.Ga. 1998), the U.S. District Court for the Middle District of Florida set forth a very instructive discussion of the various examples of deposition conduct employed by Petitioner's/Opposer's counsel, and clearly explained the reasons why such conduct is improper and worthy of sanction. It held:

“It has been said that depositions are the factual background where the vast majority of litigation actually takes place. Depositions should be limited to what they are intended to be under the Federal Rules of Civil Procedure, question-and-answer sessions between a lawyer and a witness aimed at uncovering the facts in a lawsuit. When a deposition becomes something other than that, due to strategic interruptions, suggestions or cautions to the witness through speaking objections, arguments of counsel, instructions to a witness not to answer a question when there is no valid basis for a refusal to answer, and the like, the deposition not only becomes unnecessarily long but ceases to serve the overriding goal of the Federal Rules of Civil Procedure, to reach the truth. See, *Hall v. Clifton Precision*, 150 F.R.D. 525 (E.D.Penn.1993); *Odone v. Croda International PLC*, 170 F.R.D. 66 (D.D.C.1997); *Damaj v. Farmers Insurance Co., Inc.*, 164 F.R.D. 559 (N.D.Okl.1995). The rules are designed to insure that the testimony taken during the deposition is completely that of the deponent, rather than a version of the testimony which has been edited or glossed by the deponent's lawyer. *Hall*, supra. Since most objections, such as those grounded on relevance, materiality, and admissibility, are preserved for trial, they need not be made. For those objections which the Rules provide are or may be waived if not made immediately, such objections should be stated as briefly as possible. If a further explanation is called for, such explanation should be succinct, and not designed to coach or suggest an answer to the witness or otherwise to interfere with questioning of the witness by opposing counsel.

*2 Counsel should keep in mind during the conduct of a deposition and in raising objections during a deposition, that Rule 30(c) of the Federal Rules of Civil Procedure cautions that the examination and cross-examination of witnesses during depositions should generally proceed as it does at trial. It is incumbent upon counsel for both sides, as officers of the court, to refrain from conduct which their lawyering skills tell them crosses over or may cross over the line between good lawyering and proper representation of their client's interests, and deliberate or merely overzealous interference in depositions which abuses the rules governing the deposition process and the goal of that process to allow opposing counsel in a reasonable manner

to determine the facts of the case from the witnesses having knowledge of those facts....

...A lawyer should not object to a question on the assumption that the witness cannot or does not understand the question, unless the lawyer reasonably believes that the witness may be misled or the witness indicates confusion by the question. In such instances, the lawyer should not proceed to state his own interpretation of the question, which is usually irrelevant and often suggestive of a particularly desired answer, but instead should simply ask examining counsel to rephrase and clarify the question, if the witness indicates some confusion.” *Collins V. Intern’l Dairy Queen, Inc.* 1998 WL 293314 (M.D. Ga. 1998)(Not Reported in F.Supp) Case No. CIV.A. 94-95-4MACWDO (***A copy of this opinion has been provided for the Board’s convenience and is attached as Exhibit “1” hereto.***)

8. Standards for deposition conduct in the TTAB follow these same principles. See, *Johnston Pump/General Valve, Inc. V. Chromalloy American Corp.*, 13 U.S.P.Q.2d 1719 (TTAB 1989), Opposition No. 76,991, 1989 WL 274413 (Acknowledging that instruction to a witness to not answer questions is improper conduct).

9. Instead of permitting Petitioner’s/Opposer’s corporate representative to answer the undersigned’s questions, subject to a stated objection, counsel for Petitioner/Opposer unilaterally decided that various broad subject matter areas “have no bearing on this matter,” and instructed the witness not to answer, or in many cases, prevented him from answering, or finishing his answers by interrupting and filibustering. Attorney-client and work-product privileges were never asserted by Petitioner’s/Opposer’s counsel as to any deposition questions.

10. One clear example of this outright refusal to permit any questions or answers, relates to an issue which was not only plead as an affirmative defense, but is also a *DuPont* factor, and was expressly asserted by Registrant/Applicant in opposition to

Petitioner's/Opposer's Motion for Summary Judgment. That being the issue of estoppel resulting from Petitioner's/Opposer's actions which are inconsistent with their claim of likelihood of confusion. Namely, that a restaurant was opened in Mexico City, Mexico, (where it is undisputed that Registrant/Applicant has priority) in connection with the mark **BONGO'S CUBAN CAFÉ**, in the same exact style, logo and appearance as that asserted by Petitioner/Opposer in these actions. Upon information and belief, this restaurant has some affiliation with Petitioner/Opposer.

11. As argued in Registrant's/Applicant's Memorandum of Law in Opposition to Petitioner's/Opposer's Motion for Summary Judgment:

“One of the *DuPont* factors includes a consideration of “...laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.” *DuPont*, 476 F.2d 1357, 1361, 177 USPQ 563, 567. As shown by the photographs of Exhibit “F” to the Declaration of Isaac Halabe, Registrant has discovered that despite knowledge that Registrant has used his COCO BONGO mark in Mexico, years before Petitioner began use of its BONGOS CUBAN CAFÉ mark anywhere, Petitioner is set to open a nightclub and restaurant under the mark BONGOS CUBAN CAFÉ in Mexico City, Mexico. Such actions are inconsistent with a claim of likelihood of confusion.” *Id.*

12. Not only did Petitioner's/Opposer's counsel file written objections to any questions regarding this potentially embarrassing blunder on her client's part, she obstructed just about all of the witness's attempts to answer such questions, and throughout most of the deposition instructed him not to answer. (*Transcript is forthcoming*). The only answers she did permit were extremely limited, and were only permitted after various breaks in the deposition whereby counsel and the witness left the deposition room and were outside of the presence of the undersigned.

13. Petitioner/Opposer also refused to produce any documents relative to the above stated issue.

14. Another example of what Petitioner/Opposer may assert is a “relevancy” or “scope” objection is her instructions not to answer and other obstructions based on her spoken objections to the effect that *the witness is not prepared to answer such questions*, or that *such issues or questions were not specifically stated in the Notice of Deposition*. It is well settled law that the requirements of a Notice of a Deposition of a corporation under Rule 30(b)6), Fed.R.Civ.P. are intended to be broad categories of possible areas of questioning required only to insure that the appropriate witness or witnesses were offered by the corporation for deposition. It is also well-settled that counsel should permit her witness to answer subject to her objections which are required to be stated briefly merely for purposes of preserving a record thereof.

15. Petitioner’s/Opposer’s counsel also instructed her witnesses not to answer questions regarding third party use of the COCO BONGO, BONGO’S CUBAN CAFÉ and related marks; its substantial delay in policing such uses; and the lack instances of actual confusion for many years despite such third party uses. These instructions and refusals were maintained despite Registrant’s/Applicant’s Affirmative Defenses to this effect, and despite Petitioner’s/Opposer’s counsel boasting to the media about such efforts. Such matters could hardly be privileged or confidential give such public statements, and are directly relevant to meritorious defenses to these actions.

16. However, even given counsel’s awareness of these procedures and their purposes which she stated on the record, she maintained her instructions not to answer even when the witness himself testified that he did, in fact, have knowledge of such issues and facts. Counsel even went so far as to instruct the witness not to answer questions limited simply to whether he in fact had any knowledge of specific issues.

17. Petitioner's/Opposer's intention to be coached as to how to answer every question possible could not be made any clearer by these actions.

18. The damage resulting from Petitioner/Opposer's counsel's deposition techniques and conduct, has already been done, and is irreversible in many ways. Even if this Board were to overrule all of Petitioner's/Opposer's counsel's objections, order that the depositions be continued, and order that the subject questions be fully answered without further objection or obstruction, counsel has had the unilateral benefit of a preview of each of Registrant's/Applicant's deposition questions, and time to further coach and otherwise prepare answers. In other words, Registrant/Applicant has been denied his right to the kind of true, complete and honest answers which only come from the spontaneity of depositions upon oral examination as contemplated by the TBMP and the Federal Rules of Civil Procedure.

19. The testimony of corporate representative for Petitioner/Opposer, and that of Raul Matias should be excluded from the trial periods of these consolidated actions. Petitioner/Opposer should be denied the benefit of use of the transcript to said depositions, or any other testimony during the testimony and rebuttal period of these witnesses.

20. Other similar sanctions and remedies for such conduct were discussed in various other TTAB and federal court opinions. For example, in TTAB matters, a refusal to answer may be construed against the non-answering party. *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409 (TTAB 1990).

21. Registrant/Opposer reserves the right to supplement this Motion with further argument, and deposition transcripts identifying specific questions and issues upon which the witness failed or refused to answer, or was instructed not to answer.

WHEREFORE, ROBERTO NOBLE and respectfully request this Board to sanction the Petitioner/Opposer for its failure to provide discovery, by striking pleadings, excluding any deposition or testimony by any corporate representative for Petitioner/Opposer, and witness Raul Matias, and/or construe the facts relative to questions which such witnesses failed, refused, or were instructed to, or obstructed from answering against Petitioner/Opposer. ROBERTO NOBLE also requests that the Board in its order set from strict instructions not to engage in any of the above conduct, or risk further sanction.

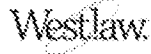
CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing has been served on this 1st day of September, 2006, by first class mail to Karen Stetson, Esq.,
P.O. Box 403023, Miami, Florida 33140.

Respectfully submitted,

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Not Reported in F.Supp.

Page 1

Not Reported in F.Supp., 1998 WL 293314 (M.D.Ga.)
(Cite as: Not Reported in F.Supp.)

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Briefs and Other Related Documents

Only the Westlaw citation is currently available.

United States District Court, M.D. Georgia, Macon
 Division.

Hugh COLLINS, Max Collins, Matt Mullis, Dairy
 Queen of Powder Springs, Inc., T-Jazer, Inc. and
 Dairy Queen and Brazier of Eastman, Inc. Plaintiffs,
 v.

INTERNATIONAL DAIRY QUEEN, INC., and
 AMERICAN DAIRY QUEEN CORPORATION,
 Defendants.

No. CIV.A. 94-95-4MACWDO.

June 4, 1998.

William Camp Harris, Mr., John Elvis James, Mr.,
 Lisa Neill-Beckmann, Ms., Macon, Diane Green
 Smith, Ms., Lee Abrams, Mr., Chicago, IL, for
 Hugh Collins, Max Collins, Matt Mullis, Dairy
 Queen of Powder Springs, Inc., T-Jazier, Inc., Dairy
 Queen and Brazier of Eastman, Inc., All Plaintiffs,
 plaintiffs.

Emmet J. Bondurant, II, Mr., Atlanta, Benjamin M.
 Garland, Mr., F. Kennedy Hall, Mr., Macon,
 William L. Killion, Mr., Quentin R. Wittrock, Mr.,
 Troy A. Bader, Minneapolis, MN, for International
 Dairy Queen, Inc., American Dairy Queen
 Corporation, defendants.

ORDER

NORMAN.

*1 This Order relates to the conduct of future
depositions in this action. Plaintiffs contend,
 specifically with reference to, but not limited to, the
 February 19-20, 1998 **deposition** of IDQ employee
 Morris Mundahl, that counsel for defendants have
 obstructed **deposition** discovery by plaintiffs,
 through improper objections and speaking
 objections that interfered with counsel's
 questioning, "**coached**" the witness, and the like.
 Plaintiffs do not seek any sanction with respect to

the Mundahl **deposition** or other **depositions**
 already taken, but request the Discovery Special
 Master to enter an Order prohibiting defendants'
 counsel from engaging in such alleged conduct in
 future **depositions** in this action.

Counsel for defendants contend that plaintiffs are
 seeking by their request to impose on defendants a
 standard for defending **depositions** that plaintiffs'
 counsel themselves have not complied with in
depositions defended by them. In support of this
 contention, defendants have submitted excerpts
 from several **depositions** defended by plaintiffs'
 counsel which defendants contend demonstrate
 similar improper and disruptive objections by
 plaintiffs' counsel.

The Special Master has reviewed the submissions of
 both sides on this issue, and has discussed and
 heard arguments from counsel on this matter in a
 conference call on May 27, 1998. To some extent,
 the proper conduct and defense of **depositions** is
 already addressed in Rule 30 of the Federal Rules
 of Civil Procedure, as well as in the voluntary
 Standards of Conduct contained in the Local Rules
 of this Court. Counsel for both sides have agreed,
 nevertheless, that entry of an Order applicable to
 both sides setting out specific requirements for the
 conduct of **depositions** would benefit future
deposition discovery, so that counsel for both sides
 will know by what standards of conduct they will be
 governed in future **depositions**, and so that specific
 rules will be in place to decide any similar
 contentions in the future that one side or the other
 has engaged in improper conduct during **depositions**
 .

Taken together, Rules 26(f), 30, 37(a), along with
 Rule 16, which gives the Court control over pretrial
 case management and discovery, vest the Court with
 broad authority and discretion to control discovery,
 including the conduct of **depositions**. This Order,
 unless and until modified, shall govern the conduct
 of all future **depositions** of any fact witness in this

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Page 2

Not Reported in F.Supp., 1998 WL 293314 (M.D.Ga.)
(Cite as: **Not Reported in F.Supp.**)

action.^{FN1}

FN1. As a general rule, the requirements of this Order should also be followed in **depositions** of the parties' expert witnesses. If either side, or the Special Master, determines after initiation of expert witness discovery that an Order is necessary for conduct of those **depositions**, an appropriate Order will be entered at that time.

It has been said that **depositions** are the factual background where the vast majority of litigation actually takes place. **Depositions** should be limited to what they are intended to be under the Federal Rules of Civil Procedure, question-and-answer sessions between a lawyer and a witness aimed at uncovering the facts in a lawsuit. When a **deposition** becomes something other than that, due to strategic interruptions, suggestions or cautions to the witness through speaking objections, arguments of counsel, instructions to a witness not to answer a question when there is no valid basis for a refusal to answer, and the like, the **deposition** not only becomes unnecessarily long but ceases to serve the overriding goal of the Federal Rules of Civil Procedure, to reach the truth. *See, Hall v. Clifton Precision*, 150 F.R.D. 525 (E.D.Penn.1993); *Odone v. Croda International PLC*, 170 F.R.D. 66 (D.D.C.1997); *Damaj v. Farmers Insurance Co., Inc.*, 164 F.R.D. 559 (N.D.Okl.1995). The rules are designed to insure that the testimony taken during the **deposition** is completely that of the deponent, rather than a version of the testimony which has been edited or glossed by the deponent's lawyer. *Hall, supra*. Since most objections, such as those grounded on relevance, materiality, and admissibility, are preserved for trial, they need not be made. For those objections which the Rules provide are or may be waived if not made immediately, such objections should be stated as briefly as possible. If a further explanation is called for, such explanation should be succinct, and not designed to coach or suggest an answer to the witness or otherwise to interfere with questioning of the witness by opposing counsel.

*2 Counsel should keep in mind during the conduct of a **deposition** and in raising objections during a **deposition**, that Rule 30(c) of the Federal Rules of Civil Procedure cautions that the examination and cross-examination of witnesses during **depositions** should generally proceed as it does at trial. It is incumbent upon counsel for both sides, as officers of the court, to refrain from conduct which their lawyering skills tell them crosses over or may cross over the line between good lawyering and proper representation of their client's interests, and deliberate or merely overzealous interference in **depositions** which abuses the rules governing the **deposition** process and the goal of that process to allow opposing counsel in a reasonable manner to determine the facts of the case from the witnesses having knowledge of those facts.

With these general guidelines, specific mention will be made concerning several particular objections the Special Master has noted from a review of the **deposition** excerpts submitted by the parties. Counsel should not direct or request that a witness not answer a question by the examining attorney, unless counsel has a reasonable, good faith objection to the question, on grounds that the answer is protected by some privilege, or if counsel has a reasonable basis for seeking a protective order or for enforcing a limitation imposed by the Court with respect to the subject matter of the question. A lawyer should not object to a question on the assumption that the witness cannot or does not understand the question, unless the lawyer reasonably believes that the witness may be misled or the witness indicates confusion by the question. In such instances, the lawyer should not proceed to state his own interpretation of the question, which is usually irrelevant and often suggestive of a particularly desired answer, but instead should simply ask examining counsel to rephrase and clarify the question, if the witness indicates some confusion. With respect to relevant documents, it is not a valid objection in the **deposition** of a witness who has or may have some relevant knowledge concerning the document or its subject matter, that the document "speaks for itself". The questioning attorney ordinarily is entitled to inquire of a witness concerning his or her relevant knowledge concerning the contents and subject matter of a

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Page 3

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document. Similarly, in a case such as this one where the issues involve contractual relationships and a party's understanding and application of contractual provisions, it is ordinarily not a valid objection to a question concerning the witness' understanding of contractual provisions and how they have been interpreted and applied by a party (assuming the witness has relevant knowledge), to assert that the question seeks a "legal conclusion" or that "the contract speaks for itself".

Having stated these general principles and guidelines, the following specific requirements are imposed for the conduct of further **depositions** of fact witnesses in this case:

*3 1) The parties and their counsel are expected to act reasonably, and to cooperate with and be courteous to each other and to deponents at all times during the **deposition**, and in making and attempting to resolve objections.

2) At the beginning of the **deposition**, deposing counsel should instruct the witness to ask deposing counsel, rather than the witness' own counsel, for clarification, definition, or explanation of any words, questions, or documents presented during the course of the **deposition**, and the witness should abide by these instructions.

3) Except for those objections which would be waived if not made at the **deposition** under FRCP 32(d)(3)(B), and those necessary to assert a privilege or to enforce a limitation on **depositions** or evidence directed by the Court or to present a motion pursuant to FRCP 30(d), objections shall be preserved and ordinarily should not be made during the course of **depositions**.

4) Counsel shall not make any objections or statements which might suggest an answer to a witness or which are intended to communicate caution to a witness with respect to a particular question. There should be no lengthy or narrative objections. Counsel's statements when making objections and any explanation of the objection, if any is necessary, should be succinctly stated, without being argumentative and without attempting to suggest to the witness any particular or desired response. Further explanation of the objection should be provided only if opposing counsel requests clarification, and such further explanation should be succinctly and directly stated.

5) Opposing counsel shall provide to the witness' counsel a copy of all documents shown to the witness during the **deposition**. The copy shall be provided either before the **deposition** begins or contemporaneously with the showing of each document to the witness. The witness and his or her counsel do not have the right to discuss documents privately before the witness answers questions about them.

6) Counsel should not direct or request that a witness not answer a question, unless that counsel has objected to the question on the basis of a reasonable and good faith belief that the answer or information solicited is protected by privilege, or by a limitation on evidence or discovery imposed by the Court, or by a reasonable and good faith belief that the subject matter of the answer is appropriate for a motion for a protective order.

It is not possible to set forth in this Order requirements and guidelines that will control every particular question or objection or disagreement between counsel that may arise during the course of a **deposition**. In such situations, counsel should be guided by what they believe to be reasonable and fair and within the spirit of this Order under the circumstances. Counsel are invited to seek further guidance from the Special Master, prior to or during the course of future **depositions**, if disputes arise with respect to the conduct of **depositions** which are not dealt with by the requirements and guidelines contained in this Order. If a dispute arises which the attorneys cannot resolve by agreement, and which if not promptly decided will critically disrupt the **deposition**, the parties should thereupon attempt to submit the matter by phone or otherwise to the Special Master for resolution.

M.D.Ga.,1998.

Collins v. International Dairy Queen, Inc.

Not Reported in F.Supp., 1998 WL 293314
(M.D.Ga.)

Briefs and Other Related Documents (Back to top)

• 5:94cv00095 (Docket) (Apr. 05, 1994)

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