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

Proceeding	91155188
Party	Plaintiff Joe J. Alfaro, Jr. ,
Correspondence Address	Joe J. Alfaro, Jr. 481 W. Blaine Street Riverside, CA 92507
Submission	Motion to Take Testimony of Applicant on Oral Examination, filed by mail on 4/13
Filer's Name	Richard A. Clegg, Esq.
Filer's e-mail	clegg@scmv.com
Signature	/Richard A. Clegg/
Date	04/21/2005
Attachments	91155188_motion_oral.pdf (12 pages)

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

JOE J. ALFARO, JR.)	
)	
Opposer,)	Opposition No.: 91155188
)	
vs.)	IN RE:
)	Serial No.: 78/110,344
)	
GUY A. HOFFMANN,)	Mark: SUPERFREAKS FUNKY
)	DISCO REVUE
Applicant.)	
)	

**MOTION TO TAKE TESTIMONY OF APPLICANT
BY ORAL EXAMINATION AND BRIEF IN SUPPORT OF MOTION**

Opposer, Joe J. Alfaro, Jr. ("Opposer") moves the Board to enter an order, pursuant to 37 CFR § 2.123(a)(1), requiring that the testimony of Applicant, Guy A. Hoffmann ("Applicant"), be taken by oral examination, rather than by written questions.

BRIEF

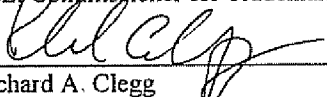
This opposition is currently in the Applicant's testimony period. On March 29, 2005, Applicant's counsel served notice that Applicant's testimony would be taken upon written questions, pursuant to 37 CFR § 2.124. A copy of the "Notice-Taking of Deposition on Written Questions" is attached as Exhibit A.

37 CFR § 2.123(a)(1) provides as follows (emphasis added):

If a party serves notice of the taking of a testimonial deposition upon written questions of a witness who is, or will be at the time of the deposition, present within the United States or any territory which is under the control and jurisdiction of the United States, any adverse

CERTIFICATION UNDER 37 CFR § 1.8

I hereby certify that the document referred to as enclosed herein is being deposited with the United States Postal Service as first-class mail on this date, April 13, 2005, in an envelope addressed to: Box TTAB, NO FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.


Richard A. Clegg

party may, within fifteen days from the date of service of the notice, file a motion with the Trademark Trial and Appeal Board, for good cause, for an order that the deposition be taken by oral examination.

What constitutes good cause so as to warrant requiring a deposition to be taken orally “must be determined on a case by case basis, upon consideration of the particular facts and circumstances in each situation.” *Feed Flavors, Inc. v. Kemin Industries, Inc.*, 209 USPQ 589, 591 (TTAB 1980) (granting motion to take testimony by oral examination rather than written questions); TMBP § 703.01(b). Here, good cause exists to require Mr. Hoffmann, the Applicant, to give his testimony by oral examination, rather than upon written questions.

Mr. Hoffmann’s testimony is crucial to this case. He is the Applicant and is the only witness whose testimony has been noticed on his behalf. This case, by its nature, involves hotly disputed issues regarding Mr. Hoffmann’s own conduct and past events. In particular, Opposer (Mr. Alfaro) alleges that he is the founder and current leader of a disco-themed band called “THE SUPERFREAKS.” Opposer further alleges that Applicant (Mr. Hoffmann) is a former band member who is now trying to appropriate the band’s name as his own, to harass and retaliate against Mr. Alfaro and the band.

Under the circumstances, Opposer should have an opportunity to conduct a live cross-examination of Mr. Hoffmann. Indeed, the only reason for Mr. Hoffmann to give his testimony by written questions is so he can avoid being subjected to any live cross-examination. Absent a live cross-examination, Mr. Hoffmann will be able to prepare and rehearse his responses to questions, including Opposer’s cross-examination questions. It would be “unjust for respondent to be deprived of the valuable aid of confronting the witnesses by way of oral cross-examination.” *See Feed Flavors* at 591 (“The argument most often advanced by one whose opponent wants to take a deposition under Rule 2.124

is that the advantage of being able to confront a witness on cross examination is lost. This is one of respondent's arguments in support of its motion and it is an argument that has merit.”).

Further, the questions that Opposer will ask Mr. Hoffmann on cross-examination will depend, in large part, upon the responses that he gives on direct examination. The questions that were attached to Mr. Hoffmann’s testimony notice (Exhibit A) include broad questions about alleged conversations and contractual discussions, about Mr. Hoffmann’s background and experience, and about Mr. Hoffmann’s activities while working with Mr. Alfaro and the Superfreaks. Question No. 50 asks him to “[s]tate in his own words why you should be awarded the service mark “SUPERFREAKS” by the USPTO.” If Mr. Hoffmann’s testimony is taken on written questions, it will be impossible for Opposer to anticipate and formulate all of the questions that might be appropriate in view of Mr. Hoffmann’s testimony on such issues. He will effectively avoid being subjected to important follow-on questions based on his prepared and rehearsed responses.

Questions 42-49 even allude to some “mystery package” that Mr. Hoffmann intends to discuss in his testimony, with the TTAB to provide copies of the package to Opposer at some later date. Opposer cannot submit written questions about materials and topics that have not even been revealed to it.

There is no good reason why Mr. Hoffmann’s testimony should *not* be taken by oral examination. Mr. Hoffmann is not a third-party witness who lives far away from the litigants; he is a party to these proceedings. Further, both Mr. Hoffmann (the Applicant) and Mr. Alfaro (the Opposer) live within 25 minutes of each other in Riverside County,

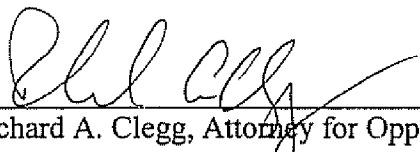
California. Mr. Hoffmann is not a busy executive whose schedule will be disrupted by giving live testimony; Opposer is not even aware that he is currently employed. *See Feed Flavors* at 591 (ordering witnesses to give testimony on oral examination, despite Petitioner's argument that they were "busy executives whose schedules would be disrupted less by their being deposed under Rule 2.124 rather than orally.")

Finally, Mr. Hoffmann is represented by counsel (Mr. Mandel), who can attend the deposition to ask questions of Mr. Hoffmann orally, and to represent Mr. Hoffmann while he is being cross-examined. Mr. Mandel represented Mr. Hoffmann when Mr. Alfaro (the Opposer) gave his own testimony by oral examination, and Mr. Mandel had an opportunity to fully and thoroughly cross-examine Opposer. Opposer should have the same opportunity to fully and thoroughly cross-examine Mr. Hoffmann.

Accordingly, Opposer respectfully moves the Board to order that the testimony of Applicant, Guy A. Hoffmann., be taken by oral examination, rather than by written questions.

Dated: April 13, 2005

By:


Richard A. Clegg, Attorney for Opposer
SELTZER CAPLAN McMAHON VITEK
A Law Corporation
750 B Street, Suite 2100
San Diego, California 92101
Telephone: (619) 685-3086
Facsimile: (619) 702-6845

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

JOE J. ALFARO, JR.

OPPOSITION NO. 91155188

V.

GUY A. HOFFMANN

APPLICATION NO. 78110344

**ATTACHMENT TO NOTICE-TAKING
OF DEPOSITION ON WRITTEN
QUESTIONS TO BE
PROPOUNDED(37CFR SECTION
2.124,FRCP 31(A))**

**QUESTIONS TO BE PROPOUNDED TO GUY A. HOFFMANN IN THE
ABOVE ENTITLED ACTION;**

- 1. WHAT IS YOUR NAME AND RESIDENCE?**
- 2. DESCRIBE THE CIRCUMSTANCES UNDER WHICH YOU FIRST MET MR. ALFARO, INDICATING THE DATE AND LOCATION.**
- 3. ARE YOU A PROFESSIONAL MUSICIAN?**
- 4. HOW LONG HAVE YOU BEEN A PROFESSIONAL MUSICIAN?**
- 5. WHICH MUSICAL INSTRUMENT DO YOU PLAY?**
- 6. BESIDES PLAYING A MUSICAL INSTRUMENT, DO YOU DO ANYTHING ELSE IN YOUR MUSICAL PERFORMANCES?**
- 7. DO YOU WEAR A COSTUME IN YOUR PERFORMANCE? DESCRIBE THE COSTUME.**
- 8. DO YOU USE A STAGE NAME WHEN YOU PERFORM? IF SO, WHAT IS THAT NAME? HOW LONG HAVE YOU USED IT?**
- 9. WHEN DID YOU FIRST DISCUSS PERFORMING AS A MUSICIAN WITH MR. ALFARO?**
- 10. DESCRIBE THE INITIAL CONVERSATION BETWEEN YOU AND MR. ALFARO REGARDING PERFORMING WITH HIM?**
- 11. STATE THE DATE, PLACE AND LOCATION OF YOUR FIRST MUSICAL PERFORMANCE WITH MR. ALFARO.**
- 12. WHAT NAME DID MR ALFARO USE FOR THIS MUSICAL GROUP ON YOUR FIRST PERFORMANCE/**
- 13. WERE THERE ANY POSTERS OR WRITINGS INDICATING THE NAME OF THIS GROUP ON YOUR FIRST PERFORMANCE WITH MR. ALFARO?**
- 14. IF THE ABOVE ANSWER IS IN THE AFFIRMATIVE, WHERE DID**

YOU SEE THESE POSTERS OR WRITINGS?

15. DO YOU PRESENTLY HAVE ANY OF THESE POSTERS OR WRITINGS? IF SO, WOULD YOU ATTACH ANY OF THESE TO YOUR ANSWERS.

16. AFTER YOUR INITIAL PERFORMANCE WITH MR. ALFARO, DID YOU DISCUSS CHANGING THE NAME OF THE MUSICAL GROUP? IF THE ANSWER IS IN THE AFFIRMATIVE, PLEASE STATE IN DETAIL THE CONVERSATION BETWEEN YOU AND MR. ALFARO REGARDING CHANGING THE MUSICAL GROUP'S NAME. STATE THE APPROXIMATE DATE OF THIS CONVERSATION BETWEEN YOU AND MR. ALFARO. WAS THE CONVERSATION FACE TO FACE OR BY TELEPHONE?

17. IF THE NAME OF THE MUSICAL GROUP WAS CHANGED TO SUPER FREAKS, STATE THE DATE, PLACE AND LOCATION OF THE FIRST PERFORMANCE IN WHICH YOU PARTICIPATED IN THAT NAME.

18. BEFORE WORKING AS A MUSICIAN WITH THE SUPER FREAKS, DID YOU WORK IN A DIFFERENT ENDEAVOR OF EMPLOYMENT? WHAT WAS THAT? HOW LONG HAD YOU WORKED IN THAT FIELD?

19. DID YOU TELL MR. ALFARO ABOUT LEAVING YOUR PRIOR EMPLOYMENT TO WORK WITH HIM AND OTHERS IN THE MUSICAL GROUP?

20. WHAT EXACTLY DID MR. ALFARO SAY IN RESPONSE?

21. DID YOU ASK MR. ALFARO ABOUT A WRITTEN CONTRACT REGARDING PERFORMING IN THE MUSICAL GROUP?

22. WHAT WAS MR. ALFARO'S RESPONSE TO YOUR REQUEST FOR A WRITTEN CONTRACT?

23. DID YOU AND MR. ALFARO MAKE A VERBAL AGREEMENT AS TO YOUR REMUNERATION FOR PERFORMING WITH HIM AS A MUSICIAN? STATE THE COMPLETE TERMS OF THE VERBAL AGREEMENT.

24. DID YOU BOOK ANY "GIGS" (PERFORMANCES) WHILE WORKING WITH MR. ALFARO AND THE SUPER FREAKS?

25. APPROXIMATELY HOW MANY GIGS DID YOU BOOK WHILE WORKING WITH MR. ALFARO AND THE SUPER FREAKS?

26. WHAT WAS THE FIRST AND LAST DATE OF THE GIGS YOU BOOKED FOR THE SUPER FREAKS WHILE WORKING WITH MR. ALFARO?

27. STATE THE AMOUNT OF MONEY YOU RECEIVED AS YOUR SHARE OF ALL THE GIGS YOU BOOKED FOR THE SUPER FREAKS.

28. WHILE BOOKING GIGS FOR THE SUPER FREAKS, DID YOU SPEND ANY MONEY OF YOURS TO BOOK THESE GIGS? IF SO, STATE FOR WHAT THE MONEY WAS EXPENDED AND THE AMOUNTS SPENT.

29. STATE THE NAMES AND LOCATIONS OF PLACES WHERE YOU BOOKED GIGS FOR THE SUPER FREAKS WHILE WORKING WITH MR. ALFARO.

30. STATE THE FIRST AND LAST DATE YOU PERFORMED WITH MR. ALFARO. AND THE SUPER FREAKS.

31. AT SOME POINT DID MR ALFARO PREVENT YOU FROM PERFORMING WITH THE SUPER FREAKS? HOW DID HE DO THIS? WHAT DATE WAS THAT?

32. AT THE TIME YOU LEFT YOUR ASSOCIATION WITH MR ALFARO AND THE SUPER FREAKS, DID YOU BELIEVE HE OWED YOU MONEY? WHY DID YOU BELIEVE HE OWED YOU MONEY?

33. DID MR. ALFARO PAY YOU ANY MONEY AFTER THE TIME HE BARRED YOU FROM PERFORMING WITH THE SUPER FREAKS?

34. DID YOU FILE A SMALL CLAIMS ACTION IN RIVERSIDE COUNTY SUPERIOR COURT FOR MONEYS YOU BELIEVED MR. ALFARO OWED YOU? STATE THE REASONS WHY YOU BELIEVED MR. ALFARO OWED YOU MONEY.

35. DID MR ALFARO FILE A COUNTERCLAIM IN THE SMALL CLAIMS ACTION AGAINST YOU?

36. WAS THE JUDGMENT FOR MR ALFARO ON YOUR CLAIM AND FOR YOU ON HIS COUNTERCLAIM? IN OTHER WORDS, A SPLIT DECISION?

37. DID THE JUDGE IN THE SMALL CLAIMS ACTION EVER DECIDE WHO HAD THE RIGHT TO USE THE NAME SUPER FREAKS IN A MUSICAL PERFORMANCE?

38. AFTER THE TERMINATION OF YOUR RELATIONSHIP WITH MR ALFARO, DID YOU PERFORM AS A MUSICIAN WITH OTHERS USING THE NAME SUPER FREAKS? IF SO, STATE THE DATES AND LOCATIONS WHERE YOU SO PERFORMED.

39. ARE YOU STILL DOING MUSICAL PERFORMANCES PROFESSIONALLY SINCE TERMINATING YOUR RELATIONSHIP WITH MR ALFARO? IF SO, DESCRIBE THE FREQUENCY OF THESE PERFORMANCES AND YOUR ROLE IN THESE PERFORMANCES.

40. DO YOU HAVE ANY KNOWLEDGE AS TO WHETHER MR. ALFARO AND HIS ASSOCIATES HAVE PERFORMED GIGS AT PLACES YOU INITIALLY BOOKED SINCE YOUR DEPARTURE FROM THE SUPER FREAKS? IF YOU HAVE SUCH KNOWLEDGE, STATE WHAT THOSE FACTS ARE.

41. AT SOME TIME AFTER THE MUSICAL GROUP'S NAME WAS CHANGED TO SUPER FREAKS AT YOUR REQUEST, DID YOU DO SOMETHING TO PROVE THAT YOU ORIGINATED THE NAME SUPER FREAKS?

42. STATE WHAT YOU DID TO DOCUMENT THAT YOU ORIGINATED THE NAME SUPER FREAKS FOR THE MUSICAL GROUP.

43. WHEN DID YOU DO THIS?
44. HAVE YOU KEPT THE PACKAGE IN A SEALED CONDITION SINCE THEN?
45. WHERE DID YOU KEEP THAT PACKAGE?
46. HAVE YOU MADE ANY ALTERATIONS, CHANGES, ADDITIONS OR OMISSIONS WITH REGARD TO THE PACKAGE AND ITS CONTENTS SINCE YOU FIRST SEALED IT?
47. WILL YOU ATTACH THIS SEALED PACKAGE TO YOUR ANSWERS TO THESE INTERROGATORIES?
48. ARE YOU REQUESTING TTAB TO OPEN THE SEALED PACKAGE, EXAMINE THE WRAPPER, POST MARKS AND ITS CONTENTS AND RETAIN THEM AND CONSIDER THEM AS EVIDENCE IN THIS CASE?
49. ARE YOU REQUESTING TTAB TO MAKE COPIES OF THE AFOREMENTIONED PACKAGE AND ITS CONTENTS, SEND THEM TO MR ALFARO AND YOUR ATTORNEY? DO YOU AGREE TO REIMBURSE TTAB FOR THE EXPENSES OF MAKING SUCH COPIES?
50. STATE IN YOUR OWN WORDS WHY YOU SHOULD BE AWARDED THE SERVICE MARK "SUPERFREAKS" BY THE USPTO.

DATED: MARCH 28, 2005

LEONARD H. MANDEL, ESQ
3034 NORTH 151ST LANE
GOODYEAR, ARIZONA 85338
(623)935-3519
ATTORNEY FOR APPLICANT
AND DEFENDANT IN
OPPOSITION
GUY A. HOFFMANN

CERTIFICATE OF SERVICE

I HEREBY CERTIFY THAT ON MARCH 29 2005, A TRUE AND
CORECT COPY OF THE FOREGOING NOTICE OF DEPOSITION
WAS SERVED ON OPPOSER, JOE. J. ALFARO, JR., VIA FIRST
CLASS, CERTIFIED MAIL POSTAGE PREPAID AT THE FOLLOWING

ADDRESS:

JOE J. ALFARO, JR.
481 BLAINE STREET
RIVERSIDE, CALIFORNIA 92507

DATED: MARCH 29 2005

BY: 

LEONARD H. MANDEL, ESQ.
ATTORNEY FOR APPLICANT
AND DEFENDANT IN OPPOSITION
GUY A. HOFFMANN

CERTIFICATE OF SERVICE

I hereby certify that, on April 13, 2004, a true and correct copy of the foregoing **MOTION TO TAKE TESTIMONY OF APPLICANT BY ORAL EXAMINATION AND BRIEF IN SUPPORT OF MOTION** was served on Applicant's counsel, via First Class Mail, postage prepaid, at the following address:

Leonard H. Mandel, Esq.
3034 North 151st Lane
Goodyear, Arizona 85338

Dated: 4/13/05

