

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

DUNN

Mailed: April 10, 2007

Opposition No. 91159665

SONAFI S.A.

v.

RANDY JUDD

**Elizabeth A. Dunn, Attorney:**

This case comes before the Board on opposer's motion, filed February 8, 2007, for an order that the deposition of Randy Judd be taken by oral examination. Applicant filed a response.

Proceedings have been considered to have been suspended on the date of the filing of the notice of deposition by written questions.<sup>1</sup>

Randy Judd, owner of opposed application Serial No. 78164521, is an individual and U.S. citizen, with a mailing address in Utah. On January 24, 2007, applicant filed a notice that the testimony of Mr. Judd would be taken on written questions and attached a list of 130 questions,

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<sup>1</sup> Opposer's motion to suspend proceedings pending the Board's disposition of its motion for an order that the deposition of Mr. Judd be taken by oral examination is denied as moot.

including questions as to the circumstances surrounding applicant's first and continuing use of its mark, a subject central to the pleaded claims of priority and likelihood of confusion. Opposer's motion for an order that the deposition of Mr. Judd be taken by oral examination contends that allowing the deposition on written questions would be prejudicial to opposer's right to due process in this proceeding, particularly opposer's right to cross-examine an important witness, but also with respect to the unnecessary expense associated with preparation of written examination regarding such a large number of questions. Applicant contends that testimony on written questions should be allowed because the twenty questions which are not devoted to the authentication of documents are simple and straightforward.

Trademark Rule 2.123(a)(1) states, in part:

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 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.

A deposition on written questions is a cumbersome, time-consuming procedure and an exception to the Board's usual procedures for submission of testimony. It requires

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that cross questions, redirect questions, recross questions, and objections all be framed and served before the questions on direct examination have even been answered. Moreover, it deprives an adverse party of the right to confront the witness and ask follow-up questions on cross examination. TBMP §703.02(m) (2nd ed. rev. 2004). Here, the proposed questions are not short and to the point, but numerous, and could involve extended responses which then could trigger detailed cross-examination. This case does not present circumstances warranting an exception to the Board's usual procedures for submission of testimony. Opposer's motion for an order that the deposition of Mr. Judd be taken by oral examination is granted.<sup>2</sup>

On February 26, 2007, applicant filed a motion to suspend proceedings pending opposer's submission of an acceptable specimen in opposer's pending application Serial No. 76414192. On March 12, 2007, opposer filed its consent to suspension on that basis. The Board construes applicant's consented motion as providing for suspension until either an acceptable specimen is accepted by the examining attorney, or the application is abandoned. As construed, the consented motion is granted. See Trademark Rules 2.127(a).

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<sup>2</sup> Applicant's motion to suspend proceeding pending completion of the deposition by written questions is denied as moot.

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Upon resumption of proceedings, the remaining testimony periods will be reset, but applicant may only submit the oral testimony of Mr.Judd.

Proceedings herein are suspended pending either acceptance of an acceptable specimen for application Serial No. 76414192 by the examining attorney, or abandonment of the application.

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