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

Mailed: August 13, 2008

Opposition No. 91161535

VIRGIN ENTERPRISES LIMITED

v.

ROSENQUIST - GESTAO E SERVICIOS SOCIEDAD UNIPESSOL LDA

Cheryl Butler, Attorney, Trademark Trial and Appeal Board:

Proceedings have been suspended since August 7, 2006 pending disposition of a procedural matter pertaining to this opposition for which the district court made a determination. Such determination was appealed to the Fourth Circuit and a Petition for a Writ of Certiorari was filed. It has now come to the Board's attention that the Supreme Court of the United States, on May 27, 2008, denied the petition. Accordingly, all avenues of appeal having been exhausted, and the decision of the Fourth Circuit being operative to this case, proceedings are resumed.

This case now comes up on applicant's fully briefed motion, filed September 7, 2006, for reconsideration of the Board's August 7, 2006, denial of applicant's motion to strike the testimonial deposition of opposer's witness, Neil Hobbs. Such deposition was taken on March 15, 2006. The Board also overruled applicant's objections on the grounds of timeliness to opposer's

amended notice of deposition in view of the circumstances presented. This case also comes up on opposer's fully briefed motion, filed January 31, 2008, to resume proceedings.

Applicant's motion for reconsideration

The Board, on August 7, 2006, denied applicant's motion to strike the deposition of Neil Hobbs. Before the Board at that time were the following facts: 1) both parties' acknowledged that the original notice of deposition, served March 3, 2006 for a testimonial deposition of opposer's witness to take place on March 15, 2006 at 2:00 p.m. in New York, was deficient; 2) applicant, at 4:00 p.m. on March 14, 2006, hand delivered objections to the notice as inadequate and improper; 3) opposer, "after the close of business," served (by first class mail and by email)[1] an amended notice for the deposition that was to take place the next day; 4) applicant hand delivered objections to the amended notice on March 15, 2006 prior to the deposition; 5) the interval between the service of the original, defective notice of deposition and applicant's objections thereto was eleven (11) days;[2] 6) the parties had been interacting between March 8 and 14, 2006 with respect to the other scheduled depositions without this matter being raised; 7) Mr. Hobbs' deposition covered two

[1] Applicant also stated that the amended notice was sent to the Virginia address for applicant's counsel.
[2] A party's main testimony period is set at thirty days. *See* Trademark Rule 2.121(c). Thus, the interval was about one-third of the period.

topics and lasted about 10 minutes;[3] 8) applicant maintained its objection during the deposition and did not cross examine the witness; and 9) opposer offered to adjourn the deposition and reconvene it later for applicant's convenience.

The Board, being cognizant of the facts presented, the evidence accompanying the briefs in support of and in opposition to applicant's motion, and the nature and length of a testimonial period, adjudged that applicant's objections were not made promptly and, thus, overruled applicant's objections and further denied applicant's motion to strike Mr. Hobbs' deposition. In making its determination, the Board additionally noted that the only reason applicant provided for not objecting earlier was that it was "under no obligation" to do so; that opposer cured the defect immediately upon being notified; that applicant's counsel was already in New York for other scheduled depositions for this case; and that the matters upon which the witness testified did not appear to be complicated.

In support of its motion for reconsideration, applicant indicates that, because the first scheduled deposition took place on March 8, 2006, it had no time to study the problem occurring with opposer's notices of deposition; and that it first realized the notice in question was defective on March 12, 2006 and prepared written objections which were hand delivered on March

[3] Those topics were the authentication of certain "web pages" associated with a specific domain name and the identification of certain Virgin Group

14, 2006. Applicant argues that the Board committed clear error based on the facts before it and the applicable law because the Board's ruling "effectively maintains a legal position that an eleven-day interval between mailing a notice of deposition and the hand service of objections thereto is not prompt"; that its service of an objection was prompt; that its delay of an eleven day interval does not require an explanation; that the Board's comment about the matters to which the witness testified did not appear complicated is not relevant; that the amended notice covered six topics, "none of which were uncomplicated" and for which applicant needed to prepare; and that applicant has been prejudiced.

In response, opposer points out that applicant had twelve days notice of the deposition; attended the deposition; and refused opposer's offers (made on the record) to bring the witness back for further examination. Opposer argues that it mailed and faxed the notice of the deposition in question on March 3, 2006; that applicant does not dispute it had notice of the deposition (including the copy faxed on March 3, 2006); and that applicant delayed eleven days before voicing an objection. Opposer points out that applicant now admits it began preparing objections on March 12, 2006. Opposer argues that the Board has broad discretion in determining whether a party's objections are prompt. Further, it is opposer's position that the Board's

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companies referred to in the Notice of Opposition as "royalty-paying

determination was correct and that applicant has not shown that the Board's discretionary ruing was made in error.

A motion for reconsideration under Trademark Rule 2.127(b), provides an opportunity for a party to point out any error the Board may have made in considering the matter initially, based on the evidence of record and the prevailing legal authorities before the Board at the time the motion was considered. Such a motion may not properly be used to introduce additional evidence, nor should it be devoted simply to a reargument of the points presented in a brief on the original motion. Rather, the motion should be limited to a demonstration that, based on the facts before it and the applicable law, the Board's ruling is in error and requires appropriate change. *See* TBMP §518 (2nd ed. rev. 2004).

Applicant has not pointed to any error the Board made in considering the matter initially. The original, acknowledgedly defective, notice of deposition was served on March 3, 2006, with twelve days remaining in opposer's thirty-day testimony period. That is, almost half the period remained. Applicant, now telling the Board it first became aware of the deficiencies in the notice on March 12, 2006, posed its objections thereto at 4:00 p.m. on March 14, 2006. Simply put, the objections were not prompt. Moreover, even recognizing that applicant was involved in travel and other depositions, applicant should have looked at the notice

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licensees." A copy of the transcript from the deposition was made of record.

earlier, especially considering the course of action applicant decided to pursue. Parties often work out many non-conformities in an amicable manner without involving the Board. As to the scope of the deposition, while it is true many topics were noticed, the actual topics that were the subject of direct examination were far fewer and, based on the transcript submitted, do not appear to have been complicated. Moreover, opposer offered to reconvene the deposition for applicant's convenience, yet applicant declined this reasonable offer which would have allowed it time to prepare for the matters it feels were complicated.

In view thereof, applicant's motion for reconsideration is denied. However, in view of opposer's offer to reconvene the deposition, the Board resets a time later in this order for the deposition to reconvene for cross examination and redirect.[4]

Opposer's motion to resume proceedings

On January 31, 2008, opposer moved to resume proceedings in view of the decision rendered by the Fourth Circuit which reversed the order of the district court denying opposer's motion to compel applicant to obey a subpoena. *Rosenruist Gestao E Servicios Lda v. Virgin Enterprises Ltd.*, No. 06-1588 (4th Cir.

[4] The Board has the inherent authority to schedule the disposition of cases on its docket. *See Carrini, Inc. v. Carla Carini, S.r.L.,* 57 USPQ2d 1067, 1071 (TTAB 2000). *See also Opticians Ass'n of America v. Independent Opticians of America, Inc.,* 734 F.Supp. 1171, 14 USPQ2d 2021 (D. N.J. 1990), rev'd on other grounds, 920 F.2d 187, 17 USPQ2d 1117 (3d Cir. 1990). Thus, in many instances, it has broad discretion in determining whether an action is prompt and in deciding to reopen a period for a limited purpose.

Dec. 27, 2007).[5] Opposer informs the Board that the district court set a hearing date of February 8, 2008 "for the purpose of scheduling further proceedings in this case." Opposer also asks for a ruling on its motion to extend the testimony period to accommodate the deposition now required by the subpoena. A ruling on such motion was deferred pending final disposition of this matter, which was then pending before the district court (Eastern District of Virginia).

In response, applicant argued that a final determination has not yet been made insofar as its time to petitioner for a writ of certiorari before the United States Supreme Court has not yet expired. Applicant indicated its intent to file such a petition and further indicated it had so informed opposer.

In reply, opposer indicates that the Fourth Circuit denied applicant's motion to stay enforcement of its judgment; that the district court, on March 7, 2008, issued an order enforcing the Fourth Circuit's mandate; and that the district court also rejected applicant's arguments that this matter should be delayed further on the "possibility that the Supreme Court … might decide to take up the merits of a trial subpoena enforcement dispute."

[5] The Board has read the opinion of the Fourth Circuit and comments that it is somewhat puzzled by the Court's characterization of the deposition sought as a "30(b)(6) deposition." The Board presumes the Court's reference to 30(b)(6) to be comparative because a 30(b)(6) deposition is a discovery deposition. The Board was always cognizant that opposer was seeking a testimonial deposition of a non-willing, adverse party residing in a foreign country. The Board never referred to the deposition sought as "30(b)(6)," which is not available for trial depositions.

On March 24, 2008, applicant informed the Board that it filed a petition for a writ of certiorari. As mentioned earlier, the Supreme Court denied applicant's petition for a writ of certiorari on May 27, 2008.

In view thereof, opposer's motion to resume proceedings is granted. Insofar as the courts have ordered the deposition to take place, and such order is binding on this proceeding, the Board accommodates the schedule as necessary for the deposition.

The Schedule

It is unclear whether the testimonial deposition of applicant which opposer successfully sought through the court system has taken place. Opposer is allowed until **TWENTY DAYS** from the mailing date of this order to inform the Board whether the deposition has taken place and, if not, whether the district court set a schedule for such deposition or whether the parties are waiting for the Board to set a time frame for the deposition to take place.

As discussed earlier, because opposer offered to reconvene its testimonial deposition of Mr. Hobbs for applicant in view of the irregularities in the original notice of deposition, the parties are allowed until **August 29, 2008** to identify a mutually agreeable date between **September 8, 2008 and October 8, 2008** for the continuance of the deposition, commencing with cross examination of the witness.

All periods have closed except rebuttal testimony, which is reset below.[6]

THE PERIOD FOR DISCOVERY TO CLOSE:	CLOSED
30-day testimony period for party in position of plaintiff to close	CLOSED
30-day testimony period for party in position of defendant to close:	CLOSED
15-day rebuttal testimony period to close:	December 1, 2008

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. Trademark Rule 2.125.

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 Trademark Rule 2.129.

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[6] The date is reset generously to allow time for the other activities ordered herein to take place.