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

Proceeding	91168617
Party	Plaintiff Beniko, Inc. Beniko, Inc. 2707 S. Alameda Street Los Angeles, CA 90058 UNITED STATES
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Attachments	91168617 Reply to Opp to Mo to Extend.PDF (6 pages)(211282 bytes)

corporate designee in late June in Milan, Italy. Pirelli, however, refused to agree to these proposed dates on the grounds that the dates were outside the discovery period while simultaneously rejecting Beniko's offer to extend the discovery date an additional 30 days to accommodate the scheduling issues. Had Pirelli agreed to the dates proposed by Beniko, the depositions would have been completed well in advance of when the deposition will now ultimately be slated for, in light of Pirelli's decision to file its series of motions.

The question presented by Beniko's instant motion is quite simple: Whether good cause exists to allow Beniko to take the deposition of Pirelli's corporate designee upon oral examination. Pirelli suggests that this matter is not "complex", because it involves "basic use information . . . relevant to almost all oppositions. . ." (Pirelli Opp. p. 3). Just because something is typical or found in most opposition proceedings does not mean that it cannot be complex in the sense that it focuses on specific issues relevant to the instant action. As shown in the deposition notice attached as Exhibit A to Beniko's moving papers, Beniko is seeking information on at least the 24 topics listed in the Notice. Issues relating to the adoption, clearance and selection of Pirelli's mark, the positioning of the products bearing the mark, channels of trade, factual basis for Pirelli's contention that there is no likelihood of confusion, etc., all require the back and forth structure of a deposition to adequately obtain the necessary information, which is solely within Pirelli's control. *Orion Group, Inc. v. Orion Insurance, PLC*, 12 USPQ 2D 1923, 1925 (TTAB 1989) (finding good cause to take the deposition in England to obtain information in applicant's control). Specifically, Pirelli fails to address the two statements made by Board members Rice and Simms (cited in Beniko's moving papers) in connection with the highly unsatisfactory process of written questions and the much more beneficial approach of oral depositions. This was the reason that Trademark Rule 2.120(c) (1) was amended in the first place to allow depositions of foreign witnesses.

Pirelli's opposition does not claim that it will be prejudiced in any way by requiring its corporate designee to be orally deposed in Milan, Italy. In fact, Pirelli had already proposed May 24, 2007 as a date for such deposition to take place. Unfortunately, Beniko's counsel had a conflict with that date and therefore proposed alternative dates in late June. As discussed above, the reason Pirelli gave for refusing to consider alternative dates was because the discovery cut-off period closed on May 29, 2007. It remains unclear exactly why Pirelli refused to agree to extend the discovery cut-off date to allow both parties to complete their respective depositions, but one thing is clear, Beniko has been forced to incur significant expenses in connection with all the motions caused by Pirelli's decision. Pirelli is a very large company and by adopting the strategy of filing motions in lieu of cooperating, it is making this process burdensomely expensive for the much smaller Beniko.

Pirelli complains that the firm representing Beniko could have sent someone else besides its lead counsel to attend the oral deposition in Milan on May 24, 2007. This makes no sense, especially in the context of this opposition proceeding where a very limited number of depositions are going to take place; to have anyone other than Beniko's lead counsel take the deposition, would be highly unusual and potentially disastrous. Interestingly enough, Pirelli opposed having anybody but its United States based attorney defend the deposition in Milan, despite the fact that it may have competent and available local counsel. (Pirelli Opp., p 8)

Pirelli also spills a considerable amount of ink arguing or trying to portend that Beniko has somehow continuously failed to comply with its discovery obligations. This is not the case. Pirelli only noticed depositions once – setting them for the second week of April, prior to the previous discovery cut-off date. Pirelli had no real intention of taking the depositions on such dates as the protective order had not yet been entered and as a result many documents had not been produced by both parties. Accordingly, had

Pirelli taken the deposition in April, it would have to subsequently take an additional deposition once documents were exchanged.

For Pirelli to contend that Beniko has adopted some formulated plan of delay is disingenuous at best. Contrary to Pirelli's position, Beniko has complied with its discovery obligations. It has produced numerous documents, responded to interrogatory requests and provided dates certain on which depositions could take place. On the other hand, Pirelli has refused to cooperate in connection with setting deposition dates and has, instead, adopted a strategy of filing numerous motions which have not only directly resulted in costing both parties substantial amounts of money, but also delayed the opposition proceeding. It is ironic that Pirelli is claiming that Beniko is responsible for unwarranted delays when in fact had Pirelli cooperated and agreed to the dates proposed by Beniko, the discovery process could have been completed by the end of June. Instead, in light of Pirelli's "motion-filing" strategy, it appears that the discovery process will continue well past June.

At page 9 of its brief, Pirelli states that "if the Board is inclined to permit an extension of discovery for Opposer, Pirelli requests that Opposer be permitted only the deposition of Pirelli subject to this motion." Beniko does not have any problem with such proposal, however, if Beniko learns during the deposition that Pirelli failed to produce certain documents in response to outstanding discovery requests, then Beniko will be entitled to further discovery, depending on the contents of the new document(s).

CONCLUSION

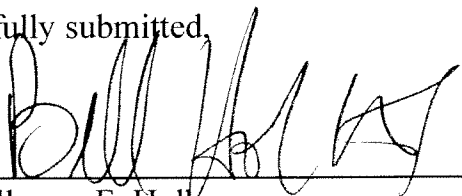
For the above stated reasons, it is quite clear that Beniko has established good cause for taking the oral deposition and then extension. As Pirelli previously agreed to the deposition of its corporate designee upon oral examination in Milan, Italy on May 24, 2007, ordering the deposition to take place in the near future will not prejudice Pirelli, as it merely postpones the deposition to a mutually agreeable date. In addition, the written questions process is entirely too cumbersome, costly and ineffective and limits the necessary exchange of relevant information. An oral deposition is also necessary as Pirelli is in sole control of the facts and information relating to the various topics listed on the 30(b)(6) Notice. [See *Orion Group*, 12 USPQ 2D at 1925 (granting deposition require to acquire information within control of party to be deposed)]. As discussed above, the written questions procedure is not a suitable means to obtain the necessary information. Moreover, to allow Pirelli to take the deposition of Beniko's corporate designee and prohibit the reverse, is manifestly unfair.

As a result, Beniko respectfully requests the Board grant its motion requiring Pirelli to produce witnesses for oral examination and to extend the discovery cut-off period for 45 days following the entry of the Board's Order to allow time for the parties find mutually agreeable dates for the respective depositions.

Respectfully submitted,

Dated: June 21, 2007

By:



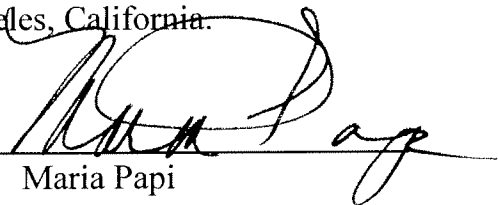
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PROOF OF SERVICE

I hereby certify that a true and correct copy of the foregoing **BENIKO'S REPLY TO APPLICANT'S OPPOSITION TO BENIKO'S MOTION TO EXTEND DISCOVERY AND TAKE THE DEPOSITION OF APPLICANT BY MEANS OF ORAL EXAMINATION** on June 21, 2007, with sufficient postage fully prepaid as follows:

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Executed on June 21, 2007, at Los Angeles, California.



Maria Papi