

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

BENIKO, INC.,)	
)	
Opposer)	Opposition No. 91168617
)	
v.)	Serial No. 79/011,411
)	
PIRELLI & C.S p.A)	
)	
Applicant)	
)	

OPPOSER'S REPLY TO APPLICANT'S OPPOSITION TO OPPOSER'S MOTION FOR RECONSIDERATION OF DECISION ON MOTION TO EXTEND THE DISCOVERY PERIOD AND TAKE THE DEPOSITION OF APPLICANT BY MEANS OF ORAL EXAMINATION

Mail Stop TTAB
Trademark Trial and Appeal Board
United States Trademark Office
P.O. Box 1451
Alexandria, Virginia 22313-1451

Dear Sir:

Beniko, Inc., ("Opposer") in the above-referenced proceeding, replies to Pirelli & C, S.p.a.'s ("Applicant") Opposition to Opposer's Motion for Reconsideration on Motion to Extend the Discovery Period to Take the Deposition of Applicant by Means of Oral Examination ("App. Opposition Motion"). Opposer's Motion for Reconsideration of Decision on Motion to Extend the Discovery Period and Take the Deposition of Applicant By Means Of Oral Examination ("Motion") sought reconsideration of the Board's Order, dated November 5, 2007, denying Opposer's Motion to Extend the Discovery Period and to Take the Deposition of Foreign Party by Means of Oral Examination under Trademark Rule 2.127(b). In Opposer's Motion, Opposer


01-17-2008

respectfully suggested that the Board concluded that there was not good cause to order the deposition on oral examination without fully considering the particular facts and circumstances in the instant case, as required in *Orion Group, Inc. v. Orion Insurance Co., P.L.C.*, 12 USQP 2D 1923, 1925 (TTAB 1989) (finding good cause to take oral deposition in England to obtain information in applicant's control).

The Board, upon motion for good cause, may order that the deposition of a party residing in a foreign country be taken by oral examination. Trademark Rule 2.120(c); TBMP §404.03(c)(1). In *Orion Group*, the Board stated that a finding of good cause "must be determined on a case-by-case basis, upon consideration of the particular facts and circumstances in each situation." *Id.* at 1925. In determining whether good cause exists, the Board is to weigh the equities involved, including the inherent advantages of oral examination and financial hardships faced by the parties. *Id.*

Applicant contends that it has answered any complex, fact specific questions in its discovery responses. (App. Opposition Motion Pages 2-3). In light of Applicant's recent document production, Opposer seeks information under the control of Applicant, relating to sales records and information. Applicant contends these issues have already been resolved by Applicant's responses, and in support of its contention attached samples of documents produced to Opposer. (App. Opposition Motion Page 3 and Exhibit B). Unfortunately, the samples attached as Exhibit B are not representative of Applicant's document production. In this regard, Applicant admits that it has produced "sales summaries reflecting U.S. sales for its products bearing the marks at issue, but because those documents were designated confidential pursuant to the Protective Order herein, [Applicant] is not attaching those documents as exhibits, thereto." *Id.* It is these "sale summaries," as well as other documents marked confidential, that Opposer

seeks to ask questions of Applicant's witness in order to obtain information in Applicant's control as these documents in many instances are ambiguous and of no help without proper context achieved through oral discovery.

Applicant also asserts that there is no reason for an oral deposition because a deposition by written question would be sufficient. (App. Opposition Motion Page 3). However, as cited in Opposer's Motion, two Board members have commented on the inherent advantages of oral examination and insufficiency of written questions. *Simms*, "Compelling Attendance of a Witness in a Proceeding Before the Board" 75 TMR 296, 298 (1985) (procedure for taking written depositions is "cumbersome and often yield unsatisfactory results"); *Rice*, "Tips from the TTAB: Recent Changes in TTAB Discovery Rules," 74 TMR 449, 450 (1984) (written questioning precludes effective examination as it is "highly unsatisfactory because it requires the parties to formulate all direct, cross, re-direct and re-cross questions before any questions have been answered"). Accordingly, the inherent advantage of oral examination with respect to fact-sensitive issues as they relate to Opposer's confidential documents, is more than sufficient cause to order the taking of the oral deposition of Applicant's 30(b)(6) witness.

Applicant further asserts that Applicant's agreement to make available a witness for deposition in Milan, Italy on May 24, 2007 was conditional upon the deposition occurring prior to the May 29, 2007 close of discovery. (App. Opposition Motion Page 5). On May 8, 2007, Opposer informed Applicant that it was unable to travel to Milan, Italy for a deposition in late May due to a pre-existing conflict and suggested alternative dates for the deposition in June. Despite Opposer's lead counsel's inability to travel to Milan, Italy in late May, and Opposer's offer to reach a mutually agreeable date within the next thirty (30) days for the taking of the deposition, Applicant, on May 9, 2007, informed Opposer that it had five days – May 24 through

May 29, 2007 – to take the deposition of its foreign witness in Milan, Italy. In essence, Applicant gave Opposer five (5) available dates to take an international deposition, some 6000 miles away, the dates all falling within a period Applicant was aware that Opposer's lead counsel was unavailable. Had the situations been reversed, *e.g.*, Opposer was a company organized abroad, it is highly unlikely that Applicant would find such a situation equitable.

In light of Opposer's lead counsel's unavailability to take the deposition in Milan in late May, Applicant further contests that Opposer could have made available another member of its firm to take the deposition (App. Opposition Motion Page 6). However, the majority of Opposer's firm consists of patent prosecution attorneys unfamiliar with U.S. trademark law and procedure. Moreover, despite Applicant's contention that Opposer could have sent any one of its attorneys, qualified or not, to take the deposition of Applicant's foreign witness, Applicant opposed to having anyone but its United States based attorney defend the deposition in Milan, Italy, asserting that Applicant "could not use an Italian attorney...but must use [its] U.S. attorney who is authorized to proceed before the Board and who knows U.S. trademark law and procedure." (App. Opposition Motion Page 7). Applicant's unwillingness to cooperate and allow both parties to complete their respective depositions is yet another basis of good cause for ordering the deposition of Applicant's designated Rule 30(b)(6) witness on oral examination.

Applicant further asserts that its size does not justify the expense to Applicant of having to conduct a deposition in Milan, Italy. (App. Opposition Motion Page 7). However, the Board has held that in determining whether good cause exists, the Board is to weigh the equities involved, including the financial hardships faced by the parties. *Orion Group, Inc. v. Orion Insurance Co., P.L.C.*, 12 USQP 2D 1923, 1925 (TTAB 1989). Applicant faces far greater financial hardship as Opposer is a considerably smaller company and its U.S. attorneys are West

Coast (rather than East Coast) based. In light of the size and resources of Applicant, it is clear that an order that the deposition be taken by oral examination in Milan, Italy would not place Applicant under any significant financial burden.

CONCLUSION

For the above stated reasons, and despite Applicant's contentions, it is respectfully submitted that the Board erred in concluding that there was no good cause by not taking into account the equities involved, such as the inherent advantages of oral examination in fact-sensitive cases, the lack of financial hardship faced by Applicant, and Applicant's refusal to cooperate and otherwise act in good faith. As a result, despite Applicant's contentions, Opposer respectfully requests the Board reconsider its analysis and order the deposition of Applicant's designated Rule 30(b)(6) witness on oral examination and extend the discovery cut-off period for 45 days following the entry of the Board's Order to allow time for the parties to find mutually agreeable dates for the respective depositions.

Respectfully submitted,

Dated: 1/08

By: 

Willmore F. Holbrow

Daniel J. Russell

BLAKELY SOKOLOFF TAYLOR & ZAFMAN

12400 Wilshire Boulevard

Los Angeles, CA 90025

(310) 207-3800

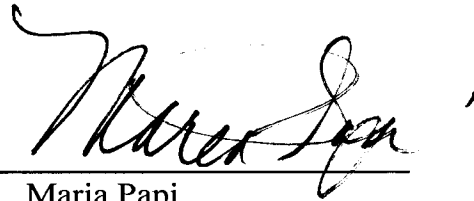
Attorneys for Beniko

PROOF OF SERVICE

I hereby certify that a true and correct copy of the foregoing **OPPOSER'S REPLY TO APPLICANT'S OPPOSITION TO OPPOSER'S MOTION FOR RECONSIDERATION OF DECISION ON MOTION TO EXTEND THE DISCOVERY PERIOD AND TAKE THE DEPOSITION OF APPLICANT BY MEANS OF ORAL EXAMINATION** was served on the interested parties via United States Mail on January 14, 2008, with sufficient postage fully prepaid as follows:

Virginia L. Carron
Finnegan, Henderson, Farabow, Garrett & Dunner LLP
3500 SunTrust Plaza
303 Peachtree Street, NE
Atlanta, GA 30308-3201

Executed on January 14, 2008, at Los Angeles, California.

A handwritten signature in black ink, appearing to read 'Maria Papi', written over a horizontal line.

Maria Papi