

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Baxley

May 29, 2020

Opposition No. 91243297

Opposition No. 91248487

Spotify AB

v.

U.S. Software, Inc.

Andrew P. Baxley, Interlocutory Attorney:

This case now comes up for consideration of Opposer's motion (filed May 18, 2020) for a protective order requiring that the discovery deposition of Opposer's witnesses under Fed. R. Civ. P. 30(b)(6) be taken by video conference and not in person. Applicant has filed a brief in response thereto.

Under Trademark Rule 2.120(g), the Board,

[u]pon motion by a party ... from whom discovery is sought, and for good cause ... may make any order which justice requires to protect a party from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the types of orders provided by clauses (A) through (H), inclusive, of Rule 26(c)(1) of the Federal Rules of Civil Procedure.

The above-captioned proceeding is concerned solely with the registrability of Applicant's mark. *See* TBMP § 102.01 (2019). In addition, federal practice favors the use of technology in the taking of depositions; leave to take depositions remotely is liberally granted in most cases. *See Hewlett-Packard Co. v. Healthcare Personnel Inc.*,

21 USPQ2d 1552, 1553 (TTAB 1991). Since March 13, 2020, the USPTO, due to the COVID-19 pandemic, has been conducting all interviews, oral hearings and in-person meetings remotely or by telephone. See <https://www.uspto.gov/coronavirus>, accessed May 27, 2020.

Further, the Center for Disease Control (CDC) website states as follows: “COVID-19 cases and deaths have been reported in all 50 states, and the situation is constantly changing. Because travel increases your chances of getting infected and spreading COVID-19, **staying home is the best way to protect yourself and others from getting sick.**” <https://www.cdc.gov/coronavirus/2019-ncov/travelers/travel-in-the-us.html> (emphasis in original), accessed May 27, 2020. The CDC website further states as follows: “Travel increases your chances of getting and spreading COVID-19. We don’t know if one type of travel is safer than others; however, airports, bus stations, train stations, and rest stops are all places travelers can be exposed to the virus in the air and on surfaces.” *Id.*, accessed May 27, 2020.

Applicant notes that Opposer produced nearly 17,000 pages of documents only last week. However, the case law upon which Applicant relies does not contemplate a global pandemic involving a highly contagious virus for which there is currently no cure or vaccine. As the Board stated in the May 5, 2020 order, “current circumstances are far from normal. The [COVID-19] pandemic is an unprecedented health situation that has disrupted business activities globally since at least as early as mid-March and may continue to so disrupt for the immediate future.” 19 TTABVUE 4. Bearing in mind (1) the USPTO’s current practice of conducting outside business remotely, (2)

the Board's empowerment only to determine the right to register, and (3) the health risks posed by travel during the COVID-19 pandemic as noted by the CDC, the parties should anticipate that, on account of such pandemic, depositions in Board proceedings will be taken remotely for the immediate future.

Based on the foregoing, the Board finds that health risks resulting from travel to Opposer's Rule 30(b)(6) discovery deposition during the COVID-19 pandemic outweigh any inconveniences in the taking that deposition by videoconferencing and that there is good cause that Opposer's Rule 30(b)(6) discovery deposition should be taken by videoconferencing. Accordingly, Opposer's motion for a protective order is **granted**.¹ Opposer's Rule 30(b)(6) discovery deposition shall be taken by videoconferencing only.

Dates remain as last reset in the Board's March 24, 2020 order. If Applicant needs additional time to prepare for the deposition in light of Opposer's recent document production, the Board expects Opposer to cooperate in rescheduling Opposer's Rule 30(b)(6) discovery deposition for a mutually convenient time, including after the close of discovery if necessary (*see* Trademark Rule 2.120(a)(3); TBMP § 404.01), in accordance with Trademark Rule 2.120(b), i.e., "in the Federal judicial district where the person resides or is regularly employed or at any place on which the parties agree

¹ To the extent that Opposer asks that the Board threaten Applicant with sanctions in the event of noncompliance with this order, that request will receive no consideration.

in writing,”² and to make all reasonable accommodations for the taking of that deposition.

² Opposer states in its motion that its Rule 30(b)(6) witnesses “live in multiple states.” 20 TTABVUE 5. In determining where the deposition at issue should take place, Opposer must provide the Federal judicial districts where each of its Rule 30(b)(6) witnesses reside and are regularly employed.