THIS ORDER IS A PRECEDENT OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500
General Email: TTABInfo@uspto.gov

June 14, 2019

Cancellation No. 92025859

Empresa Cubana Del Tabaco d.b.a. Cubatabaco

v.

General Cigar Co., Inc.

Katie W. McKnight,
Interlocutory Attorney:

This order concerns the means available to cross-examine a declarant or affiant testimonial witness outside the jurisdiction of the United States.

On October 6, 2018, Petitioner filed the testimony declarations of its employees Enrique Babot Espinosa and Lisset Fernandez Garcia, both residents of Cuba (collectively, the "Cuban Declarants"), in support of its case in chief.[1] On October 12, 2018, Respondent requested that Petitioner stipulate to producing the Cuban Declarants for oral examination at a location outside of the United States.[2] On October 15, 2018, Petitioner informed Respondent that it would not consent to oral

[1] 140 TTABVUE; 142 TTABVUE. The declarations, executed on October 3, 2018 in Havana, Cuba, include translations from Spanish to English in accordance with TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 104 (2018) and the authorities cited therein.

[2] 145 TTABVUE 27.

cross-examination of the Cuban Declarants or to Respondent's direct oral examination of Espinosa or Garcia during Respondent's testimony period.[3]

This case now comes up for consideration of Respondent's motion (filed October 26, 2018) "to cross-examine Petitioner's foreign witnesses orally" during Petitioner's trial period, "or, in the alternative to take direct testimony of Petitioner's foreign witnesses orally" during Respondent's trial period, filed with leave of the Board.[4] Respondent's motion is fully briefed.[5]

I. Respondent's Motion to Cross-Examine Petitioner's Foreign Witnesses Orally

Respondent recognizes[6] that cross-examination of a witness outside the jurisdiction of the United States is to be taken by deposition on written questions as provided in Trademark Rule 2.124, 37 C.F.R. § 2.124. *See also* Trademark Rule 2.123(a), 37 C.F.R. § 2.123(a); TBMP § 703.02(m) (depositions on written questions "may be the only means by which a deposition may be taken in a foreign country").

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[3] *Id*.

[4] By Board order dated July 2, 2018, the parties are prohibited from filing any additional unconsented or unstipulated motions without first obtaining prior Board permission. 131 TTABVUE 8. On October 19, 2018, the Board held a telephone conference with the parties during which the Board granted Respondent leave to file the instant motion. 143 TTABVUE 2.

[5] The Board notes that the parties were involved in a prior civil litigation where discovery was exchanged. *Empresa Cubana del Tabaco v. Culbro Corp. and General Cigar Co., Inc.*, No. 97-civ-8399 (S.D.N.Y.) (the "Prior Federal Action"). The parties have filed a number of stipulations in this case wherein they agreed, among other things, to treat discovery responses provided in the Prior Federal Action as responses to discovery propounded in this proceeding, and to introduce the discovery depositions of certain witnesses taken in this proceeding as trial testimony in lieu of taking their testimonial depositions. 89 TTABVUE 2-3; 132 TTABVUE 8; 137 TTABVUE 2-5.

[6] 145 TTABVUE 14-15, 17.

Nevertheless, Respondent argues that while the Trademark Rules do not expressly provide for an order directing oral cross-examination of a foreign witness, Trademark Rule 2.123(a)(2), 37 C.F.R. § 2.123(a)(2), provides that *testimony* may be taken orally upon Board order based on good cause, and this provision, according to Respondent, means that the Board can order oral cross-examination of a foreign witness if good cause is shown.[7]

Trademark Rule 2.123(a)(2) provides in pertinent part as follows:

> (2) Testimony taken in a foreign country shall be taken: by deposition upon written questions as provided by § 2.124, unless the Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate; or by affidavit or declaration, subject to the right of any adverse party to elect to take and bear the expense of cross-examination by written questions of that witness.

The rule accords the offering party the right to choose the means of taking testimony in a foreign country: (1) by deposition upon written questions as provided by Trademark Rule 2.124;[8] or (2) by affidavit or declaration, subject to the right of any adverse party to elect to take and bear the expense of cross-examination by written questions of that witness. If the offering party submits trial testimony in the form of an affidavit or declaration, as in this case, it is "subject to the right of the adverse party to elect to take and bear the expense of cross-examination by written questions

[7] *Id*. at 15.

[8] The Board may, depending upon the particular facts and circumstances in each case, upon motion for good cause, order that the deposition be taken by oral examination. *See* TBMP § 531. The motion for good cause to take an oral deposition referred to in Rule 2.123(a)(2) concerns testimony taken in a foreign country by oral deposition rather than by written questions, not cross-examination of an affiant or declarant. Under the rule, the parties may also stipulate that depositions may be taken in a foreign country by oral examination.

of that witness." Trademark Rule 2.123(a)(2). This echoes Trademark Rule 2.123(a)(1) which provides that "[t]he testimony of witnesses in inter partes cases may be submitted in the form of an affidavit or a declaration … subject to the right of any adverse party to elect to take and bear the expense of oral cross-examination of that witness as provided under paragraph (c) of this section if such witness is within the jurisdiction of the United States, or conduct cross-examination by written questions as provided in § 2.124 if such witness is outside the jurisdiction of the United States, and the offering party must make that witness available." Taken together, Trademark Rules 2.123(a)(1) and (a)(2) specifically and separately address the method of cross-examination available when direct testimony of a witness outside of the United States is offered by affidavit or declaration, i.e., written questions. Neither rule provides an exception to take oral cross-examination of a declarant or affiant outside of the United States upon motion for good cause.

The plain wording of Trademark Rules 2.123(a)(1) and (a)(2) is mirrored in Trademark Rule 2.123(e)(1), 37 C.F.R. § 2.123(e)(1), which explicitly provides for cross-examination of testimony by affidavit or declaration made outside the jurisdiction of the United States: "When testimony is proffered by affidavit or declaration, every adverse party will have the right to elect oral cross-examination of any witness within the jurisdiction of the United States. For examination of witnesses outside the jurisdiction of the United States, see § 2.124," which provides solely for deposition upon written questions. These provisions are clear and unambiguous in their meaning and intent and there is no basis or cause to read into the rules a method

for taking cross-examination of an affiant or declarant in a foreign country beyond that explicitly provided for in the Board's rules. *Cf. BBA Nonwovens Simpsonville, Inc. v. Superior Nonwovens, LLC*, 303 F.3d 1332, 64 USPQ2d 1257, 1262 (Fed. Cir. 2002) ("If a statute's language is plain and unambiguous, and conveys a clear and definite meaning, there is no occasion for employing rules of statutory interpretation ….") quoting *Ray Bell Constr. Co. v. Sch. Dist. of Greenville Cnty.*, 331 S.C. 19, 501 S.E.2d 725, 729 (1998).

Accordingly, Respondent's motion for the Board to order oral cross-examination of the Cuban Declarants is **denied**.[9]

II. Respondent's Motion to Take Direct Testimony of Petitioner's Foreign Witnesses Orally

Alternatively, Respondent requests that the Board grant it leave to take the oral direct trial testimony of the Cuban Declarants during Respondent's trial period, "with the direct examination to encompass cross-examination of the facts set forth in the Cuban Witness Declarations."[10] Respondent notes that this would obviate any need for it to renew this motion during its trial period, which has not yet begun.[11]

Because Respondent's trial period has not yet begun, Respondent's motion in the alternative to take direct examination of the Cuban Declarants is **denied** as premature. *See* Trademark Rule 2.121, 37 C.F.R. § 2.121. Respondent is advised that, although the rules allow for a motion to take oral direct trial testimony of a witness

[9] Respondent's Notices of Election to orally cross-examine the Cuban Declarants (filed October 26, 2018) are therefore of no effect.

[10] 145 TTABVUE 18.

[11] *Id*.

outside the jurisdiction of the United States upon a showing of good cause, "there is no certain procedure for obtaining the trial testimony deposition of a nonparty who resides in a foreign country and is not willing to appear voluntarily, whether the deposition sought is intended to be taken orally or upon written questions." *Galaxy Metal Gear, Inc. v. Direct Access Tech., Inc.* 91 USPQ2d 1859, 1862 (TTAB 2009).[12]

Schedule

Inasmuch as Respondent's motions are denied, the parties' joint request to extend deadlines to serve notice of cross-examination on written questions of the Cuban Declarants, as well as redirect questions,[13] is **granted**. Pursuant to the parties' stipulation, proceedings are **suspended** to allow for completion of the cross-examination on written questions of the Cuban Declarants. Respondent is allowed **twenty days** from the mailing date of this order in which to serve notice of cross-examination on written questions of the Cuban Declarants, together with written cross-examination questions. In turn, Petitioner is allowed **twenty days** from the date of service of Respondent's cross questions in which to serve redirect questions. Respondent may serve recross questions, if any, pursuant to Trademark Rule 2.124(d)(1), 37 C.F.R. § 2.124(d)(1).

[12] A party which wishes to take a deposition in a foreign country should first determine whether the taking of the deposition will be permitted by the foreign country, and, if so, what procedure must be followed. *Cf.* TBMP § 404.04. Moreover, to the extent the Cuban Declarants are not willing to appear voluntarily to testify during Respondent's testimony period, the deposition may not be taken on notice alone, but Respondent must take steps to compel attendance of the Cuban Declarants. TBMP § 703.01(f).

[13] 145 TTABVUE 4.

Proceedings will resume on **September 6, 2019** upon the following schedule, taking into account the time remaining in Petitioner's trial period:

Plaintiff's 30-day Trial Period Ends	**September 16, 2019**
Defendant's Pretrial Disclosures Due	**October 1, 2019**
Defendant's 30-day Trial Period Ends	**November 15, 2019**
Plaintiff's Rebuttal Disclosures Due	**November 30, 2019**
Plaintiff's 15-day Rebuttal Period Ends	**December 30, 2019**
BRIEFS ARE DUE AS FOLLOWS:	
Plaintiff's Main Brief Due	**February 28, 2020**
Defendant's Main Brief Due	**March 29, 2020**
Plaintiff's Reply Brief Due	**April 13, 2020**

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125, 37 C.F.R. §§ 2.121 - 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b), 37 C.F.R. §§ 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a), 37 C.F.R. § 2.129(a).