

ESTTA Tracking number: **ESTTA499741**

Filing date: **10/12/2012**

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

Proceeding	92045971
Party	Defendant Mastronardi Produce Ltd.
Correspondence Address	JOHN C FILOSA BAKER & MCKENZIE LLP 130 EAST RANDOLPH DRIVE, SUITE 3500 CHICAGO, IL 60601 UNITED STATES john.c.filosa@bakernet.com, m.tally.george@bakernet.com, Meri.A.McLaughlin@BakerNet.com, judy.a.krason@bakernet.com
Submission	Opposition/Response to Motion
Filer's Name	M. Tally George
Filer's e-mail	john.c.filosa@bakernet.com, m.tally.george@bakernet.com, Meri.A.McLaughlin@BakerNet.com, judy.a.krason@bakernet.com
Signature	/MTGeorge/
Date	10/12/2012
Attachments	Mastronardi_-_Response_to_Motion_for_Discovery_and_Testimonial_Depositio ns-#3093929-v2.pdf ( 7 pages )(30267 bytes )

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

	)	
Evergro Canada, Inc.,	)	Cancellation No. 92045971
f/k/a Westgro Sales, Inc.	)	Registration No. 3037538
Petitioner,	)	
vs.	)	
	)	
Mastronardi Produce, Ltd.	)	
Registrant.	)	
	)	
	)	
	)	

**REGISTRANT’S RESPONSE TO PETITIONER’S MOTION  
FOR LEAVE TO TAKE DISCOVERY  
AND TESTIMONIAL DEPOSITIONS ON ORAL EXAMINATION**

Respondent, Mastronardi Produce, Ltd. ("Mastronardi" or "Registrant") for its opposition to the motion for leave to for leave to take discovery and testimonial depositions on oral examination, brought by Petitioner Evergro Canada, Inc. (formerly known as Westgro Sales, Inc.) ("Evergro" or "Petitioner"), responds as follows:

**I. INTRODUCTION**

Petitioner has filed a motion for leave to take discovery and testimonial depositions on oral examination of two natural persons residing in a foreign country and a foreign corporation. Specifically, Petitioner seeks to depose two Canadian citizens and to take a Rule 30(b)(6) deposition of a Canadian entity in the United States. Petitioner has not met the good cause standard to take oral depositions and should proceed by written questions as provided by 37 C.F.R. § 2.124. Moreover, Petitioner's motion fails to provide any argument whatsoever for one of the individual depositions and for the representative deposition, thereby waiving those

requests. Accordingly, Petitioner's motion for leave to take discovery and testimonial depositions on oral examination should be denied.

## **II. FACTS**

On September 16, 2011, Petitioner filed a motion for leave to take discovery and testimonial depositions on oral examination of natural persons residing in a foreign country, pursuant to Trademark Rule 2.120(c). Petitioner seeks leave to depose Paul Mastronardi, a Canadian citizen and an officer and director of Registrant, and Donald Mastronardi, a Canadian citizen and director of Registrant. Petitioner also seeks to take a Rule 30(b)(6) witness deposition of Registrant, a Canadian corporation, but has not specified any of the matters for which it is seeking testimony. On September 24, 2012, the Board allowed twenty days for Registrant to respond to Petitioner's motion.

Petitioner argues that Paul Mastronardi's oral deposition is necessary by relying on testimony from a Canadian matter, thereby conceding that it already has a significant base of knowledge about Mr. Mastronardi's possible testimony. Petitioner provides no facts or argument in support of taking Donald Mastronardi's oral deposition or the corporate representative oral deposition. Because Petitioner has not cited any relevant authority nor provided supporting facts for its motion, Petitioner's motion for leave to take discovery and testimonial depositions on oral examination should be denied as to all of the depositions sought.

## **II. ARGUMENT**

### **A. Petitioner Has Not Met the Good Cause Standard.**

Trademark Rule 2.120(c)(1) provides a procedure for depositions of a foreign party. The rules provide that the taking of the deposition of an officer or director of a party or a person designated under Rule 30(b)(6) shall be taken in the manner prescribed by Trademark Rule 2.124, namely upon written questions. *See* TBMP § 404.03 and § 520. To depose a foreign party

other than by written questions requires the Board to find good cause for oral examination. *Id.* Good cause may be found by weighing the equities, including the advantages of an oral deposition and the hardships upon the party to be deposed. *See* TBMP § 404.03(b) and § 520. Nonetheless, the Board will not compel foreign parties not physically resident in the United States to travel to the United States for depositions. *See Rhone-Poulenc Indus. v. Gulf Oil Corp.*, 198 USPQ 372, 374 (TTAB 1978) (weighing equities and hardships and declining to order Indian party to travel to the United States for a deposition); *Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998) (the Board will not order a foreign resident witness to appear for a deposition in the United States). *See also* 37 C.F.R. §§ 2.120(c)(1), 2.124; TBMP §§ 404.03(b) and § 520.

Petitioner relies on *Orion Group Inc. v. The Orion Ins. Co. P.L.C.*, 12 USPQ2d 1923 (TTAB 1989), a case where the deposition of a foreign party was allowed because the deponent's affidavit was the sole evidence in support of an applicant's motion for summary judgment. Petitioner misreads or mischaracterizes *Orion*, and it is not applicable here.<sup>1</sup>

Here, unlike in *Orion*, Petitioner has not shown that there are any advantages of or need for an oral deposition in the United States. Petitioner already has Paul Mastronardi's oral deposition from a Canadian proceeding involving the same parties, marks and issues. Decl. of M. Gorelnik in Support of Motion for Leave to Take Depositions on Oral Examination, ¶ 3. Petitioner seeks to take what is a significant advantage, the existing oral testimony of Paul Mastronardi, and attempts to turn it into some kind of burden. Because Petitioner already has the

---

<sup>1</sup> *Orion* is readily distinguishable, and those distinctions establish that under any reasonable case-by-case analysis, there is no advantage to an oral deposition in this case. In *Orion*, an oral deposition of the foreign applicant pursuant to Rule 56(f) was sought so that the opposer could respond to a motion for summary judgment brought under a single theory based upon the testimony of a single witness, the affiant/applicant. The only theory in that opposition was likelihood of confusion. By contrast, there are multiple theories being asserted in this case, genericism and, pleading in the inconsistent alternative, Petitioner's theory that it owns the mark and that there is a likelihood of confusion. In this case not only has the motion for summary judgment already been decided by the Board, citing multiple questions of fact and legal grounds for denying the motion, Petitioner's motion for reconsideration has also been denied, citing the same factual and legal reasons. Therefore, under a case by case analysis and *Orion*, no good cause has been established by Petitioner and the motion should be denied.

prior testimony, Petitioner is in a much better position than any typical litigant. Petitioner's advantage mandates that the motion be denied.

Moreover, Petitioner entirely ignores the Trademark Rule that the Board will not compel foreign parties to appear in the United States for depositions. The reason the Board will not so order is because the Trademark Rules for cancellation actions already provide a suitable procedure, namely, Trademark Rule 2.120(c)(1), which provides for depositions of foreign persons by written questions. *See* TBMP § 404.03(b). Petitioner has not provided any reason for the Board to apply any exception to Trademark Rule 2.124.

**B. There is no Good Cause for an Oral Deposition of Paul Mastronardi.**

Petitioner's motion for leave to take oral testimony of Paul Mastronardi primarily relies upon deposition testimony given in a Canadian proceeding involving the same marks, parties, and issues. Decl. of M. Gorelnik in Support of Motion for Leave to Take Discovery and Testimonial Depositions, ¶ 3. The testimony provides a more than sufficient basis upon which Petitioner, represented here by capable and competent counsel, can easily ask further written questions. Petitioner argues that Mr. Mastronardi is recalcitrant and did not properly answer questions asked in the Canadian proceeding. That Mr. Mastronardi did not answer in the way or manner Petitioner's Canadian counsel wanted simply is not good cause for a further oral deposition. On the contrary, Petitioner's general, non-specific complaint is wholly speculative. The Canadian testimony may simply reflect inartful questioning or miscommunication. There is no indication that further oral questions will elicit a response from Paul Mastronardi that Petitioner likes better.

The Federal Rules of Civil Procedure and Trademark Rules already provide suitable procedures for deposing a foreign citizen, by written questions. *See* F.R.Civ.P. 31; TBMP §

404.03(b) and TBMP § 520. Those rules are applicable here and should be employed to avoid hardship to Mr. Mastronardi, a sovereign citizen of a foreign country. The written deposition procedure allows Petitioner to craft appropriate questions and cover any points that Petitioner deems unclear based on the extensive testimony and evidence that already exists. An oral deposition will not develop any dispositive evidence or shift the equities in Petitioner's favor, but simply afford Petitioner an opportunity to harass and hector Mr. Mastronardi. There is no good cause for Petitioner's motion, and it should be denied.

**C. There is no Good Cause for an Oral Deposition of Donald Mastronardi.**

Petitioner also seeks to take oral testimony of Donald Mastronardi, Paul Mastronardi's father, and a director of Registrant. Petitioner's motion merely makes reference to Donald Mastronardi in excerpts of Paul Mastronardi's Canadian testimony. Petitioner's Motion for Leave to Take Discovery and Testimonial Depositions, pp. 4-5. Petitioner provides no argument or facts supporting leave to take oral testimony of Donald Mastronardi. Petitioner has not set out good cause -- or any cause -- to take oral testimony in the United States of Donald Mastronardi and therefore, its motion is waived. Accordingly, no good cause exists to take an oral deposition of Donald Mastronardi, an individual not residing in the United States, and the motion should be denied.

**D. An Oral Deposition of a Mastronardi Representative is Not Warranted or Supported by Petitioner's Motion.**

Petitioner's motion for leave to take oral testimony for a Rule 30(b)(6) representative is similarly unsupported by any argument or facts to take a Rule 30(b)(6) deposition of a representative of Mastronardi, a Canadian entity. Petitioner has not identified the matters for which testimony is sought. Even though Registrant's website may identify some United States

locations and it has through its overall corporate structure certain produce growing operations in the United States, Petitioner cites no authority that indicates this is a basis to take a deposition in the United States. Every non-United States TTAB litigant has some United States connections or there would be no basis for proceeding in the United States about trademark issues. There is no good cause, and certainly none advanced by Petitioner in its motion, to bring a Canadian officer of Mastronardi to the United States for oral examination. Thus, Petitioner has waived its request for a representative deposition, and the motion for leave should be denied.

### III. CONCLUSION

Petitioner has not established good cause to grant its motion for leave to take discovery and testimonial depositions on oral examination, of natural persons residing in a foreign country and of a foreign entity. Therefore, Petitioner's motion should be denied.

Dated: October 12, 2012

/John C. Filosa/  
One of the Attorneys for Registrant,  
Mastronardi Produce Ltd.

BAKER & MCKENZIE LLP  
John C. Filosa  
M. Tally George  
300 East Randolph Street, Ste. 5000  
Chicago, Illinois 60601  
Ph.: (312) 861-8000  
Fax: (312) 698-2153  
john.filosa@bakermckenzie.com  
tally.george@bakermckenzie.com

**CERTIFICATE OF FILING AND SERVICE**

The undersigned hereby certifies that on this 12th day of October, a true and complete copy of the foregoing **REGISTRANT'S RESPONSE TO PETITIONER'S MOTION FOR LEAVE TO TAKE DISCOVERY AND TESTIMONIAL DEPOSITIONS ON ORAL EXAMINATION** was filed with the TTAB via ESTTA and served on Petitioner via United States mail and e-mail as follows:

Marc Gorelnik  
John Hughes  
KILPATRICK TOWNSEND & STOCKTON LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, CA 94111  
mgorelnik@kilpatricktownsend.com,  
jmay@kilpatricktownsend.com

Dated: October 12, 2012

/MTGeorge/  
M. Tally George

#3093929