

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Mailed: June 13, 2013

Cancellation No. 92045971

Evengro Canada, Inc.

v.

Mastronardi Produce Ltd.

**Cheryl S. Goodman, Interlocutory Attorney:**

This case now comes up on petitioner's motions, filed September 16, 2011, for leave to take oral depositions, and its motion, filed October 29, 2012, to use testimony from another proceeding.

The Board turns first to the motion to use testimony from another proceeding.<sup>1</sup>

Trademark Rule 2.122(f) allows the use of testimony taken in a suit or action in a court, between the same parties or those in privity, to be used in a Board proceeding, if relevant and material, subject to the right of any adverse party to recall or demand recall of any witness that has been offered and to rebut the testimony.

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<sup>1</sup> After reconsideration was denied, proceedings remained suspended pending consideration of the motion for leave to take oral testimony. Although the motion under Trademark Rule 2.122(f) was filed while proceedings remained suspended, the Board finds the Trademark Rule 2.122(f) motion germane to the motion for leave.

The term "testimony" as used in Trademark Rule 2.122(f), has been construed by the Board as meaning only trial testimony or a discovery deposition which was used, by agreement of the parties, as trial testimony in the other proceeding. *Threshold.TV, Inc. and Blackbelt TV, Inc. v. Metronome Enterprises, Inc.*, 96 U.S.P.Q.2d 1031 (TTAB 2010); see also TBMP Sections 530 and 704.13 (3d ed. rev. 2012).

According to petitioner, the deposition, cross-examination, was taken in a Canadian opposition action involving the parties with respect to respondent's application to register the mark CAMPARI in Canada. The deposition was used as evidence for trial. Petitioner submits that the testimony involves "relevant and material testimony . . . including testimony about Registrant's adoption of the CAMPARI mark and its knowledge that CAMPARI is a genetic varietal." The testimony has been submitted with the motion.

Respondent concurs that the testimony concerned "rights to the CAMPARI trademark" and that "any relevant and material testimony from the Canadian proceeding may be used in these proceedings, subject to evidentiary or other objections at trial."

Accordingly, inasmuch as the cross-examination deposition testimony was taken from an action involving the same parties, the CAMPARI mark, was used at trial, and is relevant and material to the matters in this proceeding, the motion is granted. The use of the cross-examination testimony is subject to the right of respondent to recall the witness that has been offered to rebut the testimony. Trademark Rule 2.122(f).

The Board now turns to petitioner's motion to take oral discovery and testimonial depositions of respondent's witnesses located in Canada. Petitioner indicated that if the Board granted its Trademark Rule 2.122(f) motion, it still maintained its motion to take discovery and testimonial depositions orally. Both parties have provided limited additional argument relating to the taking of oral deposition testimony in the event the Rule 2.122(f) motion was granted, which the Board, in its discretion, has considered.

Ordinarily, the discovery or testimonial deposition of a party or a person designated under Fed. R. Civ. P. 30(b)(6) must, if taken in a foreign country, be taken upon written questions in the manner prescribed by Trademark Rule 2.124 unless the Board, upon motion for good cause, orders or the parties stipulate, that the deposition be

taken by oral examination. Trademark Rule 2.120(c)(1); Trademark Rule 2.123(a)(2). What constitutes good cause for a motion to take a discovery or testimonial deposition orally must be determined on a case-by-case basis, upon consideration of the particular facts and circumstances in each situation. See *Feed Flavors Inc. v. Kemin Industries, Inc.*, 209 USPQ 589, 591 (TTAB 1989). In determining such a motion, the Board weighs the equities and may order that the deposition be taken orally in appropriate cases. See *Orion Group Inc. v. The Orion Insurance Co. PLC*, 12 USPQ2d 1923, 1925 (TTAB 1989).

In the instant case, petitioner seeks to take the oral discovery and testimonial depositions of witnesses Paul Mastronardi, Donald Mastronardi and respondent's Rule 30(b)(6) witness in Ontario, Canada. Petitioner submits that there is no great expense to respondent in seeking to take depositions orally as respondent's U.S. counsel is located in Ontario, Canada which is less than 300 miles away from Chicago. Respondent does not dispute these assertions.

Respondent does argue, however, that petitioner has not met the good cause standard for taking oral deposition testimony and that the written deposition procedure will allow "Petitioner to craft appropriate questions and cover

any points that Petitioner deems unclear based on the extensive testimony and evidence that exists."

Oral Discovery depositions

*Donald Mastronardi and Rule 30(b)(6) witness*

Respondent submits that petitioner has not set forth "good cause—or any cause—" for leave to take the oral deposition testimony of Donald Mastronardi. Respondent also argues that petitioner's motion for leave to take the oral deposition testimony of respondent's Rule 30(b)(6) witnesses is "unsupported by any argument or facts."

Petitioner, on the other hand, argues that respondent's state of mind is "highly fact-sensitive and difficult to discern through written interrogatories" which require oral depositions to "confront and cross-examine" Donald Mastronardi regarding his firsthand knowledge as to first use of the mark CAMPARI and the relationship of the CAMPARI varietal name and the CAMPARI mark. Petitioner asserts that it seeks to question respondent's 30(b)(6) witness regarding produced documents and respondent's intent/knowledge at the time of filing its U.S. application.

Petitioner's desire to question respondent's 30(b)(6) witness regarding its produced documents does not establish good cause for taking an oral deposition as this is a

common use of depositions in general. As to petitioner's desire to explore respondent's intent/knowledge at the time of filing its U.S. application through respondent's 30(b)(6) witness and to explore Donald Mastronardi's knowledge of first use of the mark, these are common issues in Board cases, and petitioner has not established why the Board should make an exception for the general rule under the circumstances of this case. Otherwise, any plaintiff could obtain an oral deposition of foreign witnesses on the basis of its desire to question the witnesses orally regarding its knowledge/intent, first use, or its produced documents.

The Board also finds that petitioner's desire to question Donald Mastronardi regarding the relationship of the CAMPARI varietal name and the CAMPARI mark an insufficient basis to require an oral deposition of Mr. Mastronardi.

Accordingly, the motion for leave to take an oral discovery deposition of Donald Mastronardi and respondent's Rule 30(b)(6) witness is denied.

*Paul Mastronardi*

Petitioner has asserted it needs oral testimony from Paul Mastronardi regarding his "knowledge that CAMPARI was a varietal name at the time of filing the application

versus a brand name," the source of information offered by Paul Mastronardi on personal knowledge, and respondent's first use of the CAMPARI mark. These topics have already been covered in the oral cross-examination deposition testimony of Paul Mastronardi in the Canadian opposition proceeding, now approved for use in this proceeding, and therefore, the Board finds no good cause to take an oral deposition on this basis. Petitioner's need, without more, to take follow-up testimony with regard to the testimony taken in the Canadian opposition proceeding also fails to establish good cause for taking an oral deposition of Paul Mastronardi.

In addition, petitioner seeks to take oral testimony of Mr. Mastronardi regarding matters not addressed in the Canadian deposition including use of the mark in the U.S., state of mind at the time of filing its U.S. application, and authentication of documents produced and relied on by respondent.

However, as stated supra, the issue of state of mind (intent) at the time of filing and use of the mark in the United States are common matters in Board proceedings on the claims petitioner has asserted, and petitioner has failed to establish good cause to take Mr. Mastronardi's deposition on these issues under the circumstances of this

case. Lastly, petitioner's desire to authenticate documents produced and relied on by respondent is a use of depositions in general, and common to all Board proceedings, and does not establish good cause for taking oral deposition testimony. Otherwise, any plaintiff could obtain an oral deposition of foreign witnesses on the basis of its desire to question a witness orally regarding its first use or intent or its produced documents. Oral depositions of foreign deponents are the exception not the rule.

As an additional basis for taking oral depositions, petitioner has complained about respondent's "disingenuous" and "evasive" discovery responses.

However, petitioner's remedy for respondent's alleged "evasive" discovery responses is to move to compel adequate responses, not to seek oral depositions of foreign witnesses. Accordingly, the Board does not find good cause on this basis.

In view thereof, the motion to take oral discovery depositions of respondent's witnesses is denied.<sup>2</sup>

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<sup>2</sup> Petitioner has indicated its concern that respondent's witness responses will be "filtered through the hands of respondent's counsel." However, on a deposition on written questions, the answers to the questions must be the deponent's answers, and although counsel can review the questions prior to the deponent answering them, it is not appropriate for respondent's counsel to answer the questions under the Rule.

Oral Testimonial Depositions

For the reasons discussed supra, the motion to take oral testimonial depositions of Paul Mastronardi, Donald Mastronardi and respondent's Rule 30(b)(6) witness also is denied.

The motion for leave to take oral testimony (discovery or testimonial) depositions is denied without prejudice subject to the right of petitioner to renew the motion, if after the taking of the discovery depositions on written questions, petitioner establishes that respondent has failed to provide meaningful responses to the written questions on issues critical to the proceeding.

Petitioner advises of respondent's offices and personnel in California, Florida and Michigan. If any of respondent's witnesses shall be present in the United States during the discovery period, respondent shall so advise petitioner so that a discovery deposition can be taken orally. The location of the deposition is where the witness is at the time of deposition. Trademark Rule 2.120(c)(2); TBMP Section 404.3(d). In addition, if any of

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Fed. R. Civ. P. 31. In addition, petitioner's counsel's written questions may include questions to the deponent regarding his preparation such as who assisted deponent in preparing for deposition, what the preparation consisted of, and whether the deponent had an opportunity to review the questions prior to deposition with counsel, so that credibility can be assessed by the fact finder in this context.

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these witnesses will be present within the United States at the noticed time of a testimonial deposition, respondent shall so advise, and petitioner may file a motion for an order that the deposition be taken by oral examination for good cause. Such deposition will be where the witness is located at the time of deposition. TBMP Section 703.02.

Proceedings remain suspended for the taking of depositions on written questions.

After the depositions have been completed, petitioner should advise the Board so that proceedings can be resumed and remaining dates reset.