

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

Mailed: March 22, 2010

Cancellation No. 92048444

Oxford Tutoring Inc.

v.

Oxford Learning Centres,
Inc.

**Robert H. Coggins,
Interlocutory Attorney:**

This case now comes up on respondent's motion (filed July 15, 2009). The motion is fully briefed.

Telephone Conference

On March 19, 2010, at approximately 3:00 p.m. EDT, the Board exercised its discretion and conducted a telephone conference to resolve the motion. Participating in the conference were Edward T. Attanasio, counsel for petitioner; Purvi J. Patel, counsel for respondent; and the above-referenced Board attorney responsible for resolving interlocutory matters in this case.¹

The Board considered the comments made by both parties during the telephone conference, as well as the supporting

¹ The Board appreciates the professionalism of the parties during the telephone conference.

motion and briefs. The Board presumes familiarity with the issues, and for the sake of efficiency this order does not summarize the parties' arguments raised in the motion, briefs, or during the telephone conference. Instead, this order outlines the decisions made by the Board.

Procedural Issues

As a procedural matter, the Board noted petitioner's December 22, 2009 appearance of new counsel.

The Board also noted that inasmuch as Trademark Rule 2.127(a) provides that "[t]he time for filing a reply brief will not be extended," respondent's reply brief should have been filed by August 24, 2009. Notwithstanding Trademark Rule 2.127(a), the Board had previously granted respondent's consented motions (filed September 4 and 22, 2009) to extend respondent's time in which to file a reply brief based on the parties' settlement negotiations. Inasmuch as the Board had granted the motions to extend, and as a matter of equity, respondent's reply (filed September 29, 2009) was considered.

Motion to Quash

On June 6, 2009, petitioner served notice of an oral deposition of respondent under Fed. R. Civ. P. 30(b)(6). By way of its motion, respondent seeks to quash the notice of deposition and seeks to proceed with any discovery

deposition of respondent by the manner prescribed by Trademark Rule 2.124 (depositions on written questions).

During the telephone conference, and in an effort to resolve the outstanding matter, petitioner offered to travel to respondent's corporate office in Canada, to the offices of respondent's counsel in the United States, or to any location to conduct the discovery deposition by oral examination. Citing cost as a deterrent, respondent declined petitioner's offer but remained amenable to a deposition on written questions.

Trademark Rule 2.120(c)(1) states:

The discovery deposition of a natural person residing in a foreign country who is ... a person designated under Rule 30(b)(6) ... shall, if taken in a foreign country be taken in the manner prescribed by §2.124 unless the Trademark Trial and Appeal Board, upon motion for good cause, orders or the parties stipulate, that the deposition be taken by oral examination.

Ordinarily, the discovery deposition of a natural person who resides in a foreign country, and who is a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(3) to testify on behalf of a party, must, if taken in a foreign country, be taken upon written questions in the manner described in Trademark Rule 2.124. Moreover, the Board will not order a natural person, including a person designated under Fed. R. Civ. P. 30(b)(6), residing in a foreign country to come to the United States for the taking of his or her discovery

deposition. TBMP §520 (2d ed. rev. 2004). See *Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998), and *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372, 374 (TTAB 1978). See also TBMP §§ 404.03(b) and 521.

Inasmuch as respondent is a Canadian corporation with no corporate presence in the United States, and no officer, director, managing agent, or other person who consents to testify on its behalf residing in the United States, respondent's motion was granted. Accordingly, petitioner's notice of an oral deposition of respondent was quashed.

Schedule

Proceedings were resumed, and discovery was reopened for the sole purpose of allowing petitioner to depose respondent. Dates were reset on the schedule below.

Expert Disclosures Due	5/23/2010
Discovery (for Deposition of Respondent) Closes ²	6/22/2010
Plaintiff's Pretrial Disclosures	8/6/2010
Plaintiff's 30-day Trial Period Ends	9/20/2010
Defendant's Pretrial Disclosures	10/5/2010
Defendant's 30-day Trial Period Ends	11/19/2010
Plaintiff's Rebuttal Disclosures	12/4/2010
Plaintiff's 15-day Rebuttal Period Ends	1/3/2011

² It is noted that respondent expressed its willingness to cooperate in a deposition on written questions, and to cooperate in requests to extend or suspend proceedings if petitioner is unable to complete the deposition by June 22, 2010.

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125. Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

Possible Settlement

The parties stated that although no settlement proposal was under active consideration, each party remained open to the possibility of settlement. The Board informed the parties that the Board is liberal with regard to suspension of proceedings to accommodate settlement discussions.