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

Proceeding	92053315
Party	Plaintiff American University
Correspondence Address	EDWARD W GRAY JR FITCH EVEN TABIN & FLANNERY 120 SOUTH LASALLE STREET , SUITE 1600 CHICAGO, IL 60603 UNITED STATES trademark@fitcheven.com, asimmons@fitcheven.com
Submission	Reply in Support of Motion
Filer's Name	Alisa C. Simmons
Filer's e-mail	trademark@fitcheven.com, asimmons@fitcheven.com
Signature	/Alisa Simmons/
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Attachments	Petitioner's Reply in Support of Motion to Compel Discovery Depositions.pdf(50841 bytes)

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

In re Supplemental Registration No. 3836388

American University,

Petitioner,
v.
The American University for
Science and Technology

Registrant.

CANCELLATION NO. 92053315

Petitioner's Reply in Support of Motion to Compel Discovery Depositions

Petitioner, American University, replies to the opposition papers filed by The American University for Science and Technology ("AUSTC"). AUSTC's response brief contains unexpected assertions that, instead of excusing AUSTC's conduct, confirm AUSTC's disruptive approach to and lack of understanding or respect for the discovery process. Petitioner is mindful that reply briefs are discouraged, but the assertions in AUSTC's brief could not have been anticipated, and Petitioner limits this reply to addressing those issues. For the reasons stated in the original motion and this reply, the motion to compel sought pursuant to TBMP § 523.01 and 37 C.F.R. § 2.120(e) should be granted and an order compelling AUSTC's participation and cooperation in the discovery deposition entered.

The need for the Board's direction and guidance in this discovery deposition dispute arises because AUSTC will not permit a court reporter to make a back-up audio copy of the deposition testimony of AUSTC's witnesses during a discovery deposition. AUSTC's refusal to cooperate and permit the court reporter to make this back-up audio recording of the deposition testimony has disrupted the previously noticed and scheduled August 20, 2014 discovery deposition of AUSTC's 30(b)(6) witness and Dr. Wahab, AUSTC's President.

Respondent's Response Brief Illustrates Need for Board Order Compelling Cooperation

AUSTC does not seem to appreciate or understand the discovery deposition process or procedures, reinforcing the need for the Board to provide its guidance and direction in this instance. In its Response, AUSTC repeatedly refers to the discovery deposition as a “conversation” between the parties (*See* pages 3, 4, 5 in Docket No. 39). Referring to the deposition testimony as a conversation shows that AUSTC either disregards or does not appreciate the importance of the discovery deposition testimony, which, when provided by AUSTC’s officer and 30(b)(6) witness, may be used as evidence in the proceeding. 37 C.F.R. § 2.120(j)(1) and TBMP § 704.09. Because of the importance of the discovery deposition testimony to the parties to the proceeding, it is important that the court reporter recording the testimony be permitted to record and preserve the testimony of AUSTC’s witness, including making a back-up audio recording, without disruption from AUSTC, to ensure the accuracy and integrity of the resulting transcript for later use by the parties and the Board.

AUSTC relies on the Invasion of Privacy Act of the California Penal Code, Cal. Penal Code §§ 630-638 et seq., addressing eavesdropping and wiretapping of confidential communications without consent as the basis for its objecting to the court reporter making a back-up audio recording of the testimony at the discovery deposition. Petitioner submits that the eavesdropping and wiretapping sections of the California Penal Code are inapplicable to discovery depositions (as well as to testimony depositions) in Board proceedings. Further, subparagraph (c) in Section 632 of the California Penal Code cited by AUSTC specifically excludes from the definition of protected confidential communications, “...a communication made in a public gathering or in any legislative, judicial, executive, or administrative proceeding open to the public, or in any other circumstance in which the parties to the communication may

be overhead or recorded.” Cal. Penal Code § 632(c). The discovery deposition in this proceeding is a communication in an administrative legal proceeding that the parties know will be overheard and recorded by a court reporter and would therefore fall within the stated statutory exception. AUSTC’s insistence that the court reporter’s making a back-up audio recording of its witness’ deposition testimony would violate the California Penal Code should be disregarded.

No One Attempted to Mislead AUSTC, And Petitioner’s Counsel Made Good Faith Effort to Resolve Dispute

Petitioner’s counsel did not mislead or attempt to mislead AUSTC about the court reporter making a back-up audio recording of the deposition testimony. In fact, as shown in the July 30, 2014, through August 16, 2014 email exchange between the parties (Exhibit D to Motion to Compel, Docket No. 38), the opposite is true. After confirming to AUSTC that the official means used for recording the deposition testimony would be stenographic via a court reporter and not via video, it occurred to counsel for Petitioner that AUSTC’s pro se representative may not appreciate that court reporters make back-up audio copies of the deposition testimony to refer to when preparing the official written transcript of the testimony.

Wanting to ensure that the back-up audio recording made by the court reporter would not be an issue during the scheduled August 20, 2014 deposition, counsel for Plaintiff, in its August 14 and 15, 2014 emails followed up with AUSTC’s pro se representative to make him aware that the court reporter (not Petitioner) would make a back-up audio recording of the testimony. Counsel for Petitioner tried to reassure AUSTC about the discovery deposition procedure and the manner in which the deposition testimony would be recorded. Counsel for Petitioner tried to explain the reasons why the court reporter makes the back-up audio recording of deposition testimony, how the court reporter will use the back-up audio recording, that the parties will not receive a copy of the back-up audio recording made by the court reporter, what the Trademark

Rules permit, and how AUSTC may use the protections of the Board's standard protective order to maintain the confidentiality of information disclosed during the deposition. Despite these reassurances and counsel for Petitioner's good faith effort to resolve the dispute, AUSTC still refused to permit the audio recording of the deposition testimony by the court reporter, which then necessitated Petitioner seeking relief and direction from the Board.

AUSTC Has Not Cooperated Fully in the Discovery Process

AUSTC represents in its Response that it has cooperated on all discovery issues, but that is not so. In addition to refusing to permit the court reporter to make a back-up audio recording of the discovery deposition testimony, AUSTC only recently responded to Petitioner's written interrogatories and document requests after numerous written reminders and demands for responses were put to it by Petitioner's counsel. Even then, AUSTC has only provided vague and incomplete responses (Docket Nos. 35 and 37) to those interrogatories and document requests. The Petitioner anticipates that a separate motion to compel may eventually be necessary to address AUSTC's responses to written discovery requests. However, the Petitioner needed first to seek for the parties the immediate guidance and direction of the Board about the discovery deposition and AUSTC's refusal to permit the court reporter to make a back-up audio copy of the deposition testimony.

Petitioner respectfully requests that the Board provide guidance and direction to the parties concerning the discovery deposition and that the Board issue an order compelling AUSTC's witnesses to appear for the previously noticed discovery depositions and to permit the court reporter taking down the testimony to make any necessary back-up audio recordings for use when preparing the official testimony transcripts.

Suspension Is Unnecessary Because Prior Case Will Soon Conclude

AUSTC's request to suspend the proceedings is not an appropriate response to the motion to compel and should have been noticed separately. Petitioner informs the Board that Proceeding No. 92041869 (on which AUSTC bases its suspension request), subsequently consolidated with Proceeding No. 92031743 (Parent case), will soon conclude. The parties to that separate proceeding reached settlement and filed with the Board on August 25, 2014, a stipulated motion that will finally conclude those consolidated proceedings. Suspending this case to wait for the outcome of consolidated Proceeding No. 92031743 is therefore unnecessary.

Respectfully submitted,



September 8, 2014

By: _____

Joseph T. Nabor
Edward W. Gray, Jr.
Alisa C. Simmons
Fitch, Even, Tabin & Flannery LLP
120 South LaSalle Street, Suite 1600
Chicago, Illinois 60603-3406
Telephone: 312.577.7000
Facsimile: 312.577.7007

Attorneys for Petitioner

Certificate Of Service

The undersigned hereby certifies that a copy of the foregoing ***PETITIONER'S REPLY IN SUPPORT OF MOTION TO COMPEL DISCOVERY DEPOSITIONS*** was served via first class mail, postage paid, upon:

Dr. M.A. Wahab
The American University for Science and Technology
18345 Ventura Boulevard, Suite 210
Tarzana, CA 91356

on this 8th day of September, 2014.



Alisa C. Simmons
FITCH, EVEN, TABIN & FLANNERY LLP
120 South LaSalle Street, Suite 1600
Chicago, Illinois 60603-3406
Telephone: 312.577.7000
Facsimile: 312.577.7007
Attorneys for Petitioner