

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

BUO

Mailed: February 24, 2015

Cancellation No. 92053315

*American University*

*v.*

*The American University for Science  
and Technology<sup>1</sup>*

**Benjamin U. Okeke, Interlocutory Attorney:**

Now before the Board is American University's ("Petitioner") motion, filed August 18, 2014, to compel The American University for Science and Technology ("Respondent") to produce its designated corporate witness, Dr. Mohamed Abdul Wahab, for depositions under Fed. R. Civ. P. 30(b)(6), and as an individual under Fed. R. Civ. P. 30(a). The motion is fully briefed.<sup>2</sup>

The Board, in its discretion, suggested that the issues raised in the motion be resolved by telephone conference as permitted by Trademark Rule

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<sup>1</sup> The Board notes Respondent's submissions of June 14, 2014, and August 2, 2014, in the form of responses to Petitioner's discovery requests. However, Respondent is cautioned that written discovery requests or responses, including the production of responsive documents, should not be filed with the Board except when submitted with a motion relating to discovery, or in support of or response to a motion for summary judgment, or under a notice of reliance, when permitted, during a party's testimony period. See Trademark Rule 2.120(j)(8). Accordingly, Respondent's submissions are not considered part of the record and will be given no consideration unless filed at the appropriate time.

<sup>2</sup> Petitioner's reply brief, filed September 8, 2014, is noted.

2.120(i)(1). *See* Trademark Rule 2.120(i)(1); TBMP § 502.06(a) (2014). The conference was held at 2:00 p.m. ET, on Wednesday, December 31, 2014. Participating in the conference were Petitioner's counsel Alisa C. Simmons, Respondent's President and CEO Dr. Wahab, appearing *pro se*, and Board interlocutory attorney Benjamin U. Okeke.

The Board carefully considered the arguments raised by the parties during the telephone conference, the briefs on the motion and exhibits attached thereto, as well as the record of this case in coming to a determination regarding the issues presented in the motion.

During the telephone conference, the Board made the following findings and determinations:

On July 1, 2011, Petitioner noticed the depositions of The American University for Science and Technology as an entity under Fed. R. Civ. P. 30(b)(6) and of Dr. M. A. Wahab, including the production of documents at the deposition under Fed. R. Civ. P. 30(b)(2). Due to then ongoing settlement negotiations, the parties agreed to several suspensions of this proceeding and extensions of the discovery period. *See* Dkt. 15-37. In light of the parties' efforts to settle the matter, the depositions were twice rescheduled, presumably to allow the parties to focus on their negotiations, the final date for the depositions was ultimately set for Wednesday, August 20, 2014.<sup>3</sup> However, in email correspondence exchanged by the parties, Respondent

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<sup>3</sup> Because Dr. Wahab was to also serve as Respondent's witness for the Fed. R. Civ. P. 30(b)(6) deposition, the parties agreed to consolidate both his individual deposition and the corporate deposition into a single deposition event.

indicated that it did not “authorize video or voice capturing of [the] meetings.” While, in several email communications to Respondent between August 13 and 15, 2014, Petitioner indicated that it would not be “videoing the depositions,” confirmed further by Petitioner during the conference call, Respondent repeatedly indicated that that it did not “authorize any capturing method either Video or Audio.” In light of Respondent’s continued objection to submitting to having the depositions recorded, Petitioner filed the instant motion to compel Respondent’s appearance notwithstanding any audio recording that may be made using the retained court reporter’s equipment.

Petitioner’s motion is clear that it seeks the audio recording only as a back-up to the court reporter’s stenographic notes and to assist the court reporter in preparing the written transcript. Petitioner argues that it is standard practice for court reporters to have the back-up audio recording of a deposition. Petitioner points out that an audio recording is permissible under Fed. R. Civ. P. 30(b)(3).

Respondent contends that any audio or video recording of the depositions would constitute a violation of the deponent’s right to privacy. Respondent cites California Penal Code (Cal. Pen. Code) §§ 631 and 632 to support the proposition that without the consent of both parties “it is a crime in California (Respondent’s domicile and the location of the depositions) to intercept or eavesdrop upon any communication, including a telephone call, wire communication or face-to-face conversation.” Respondent avers that his

assertion of his legal right to not authorize audio recording of the deposition should not be construed as a refusal to cooperate.

In reply, Petitioner points out that the Cal. Pen. Code is inapplicable to Board proceedings and that the specific sections referenced by Respondent address the criminal activities of wiretapping and eavesdropping.

The Board will first address some preliminary matters. Insofar as Petitioner has made it clear it is not seeking a video recording of the deposition, the Board need not consider further Respondent's arguments directed to that subject.

Respondent's reliance on the Cal. Pen. Code is misplaced. Sections 631 and 632 address the illegal acts of wiretapping and eavesdropping, which protect communications intended to be kept private from unauthorized interception by a third party. The proposed deposition is not such a communication. In civil cases, which would be similar to this cancellation proceeding before the United States Patent and Trademark Office, the California Code of Civil Procedure (Code Civ.) would be operative. Code Civ. § 2025.510(f) specifically contemplates recording a deposition by audio and video means. Accordingly, no further consideration is given to Respondent's arguments based on the Cal. Pen. Code that the deposition not be audio recorded.

The Board notes that Respondent does not refuse to appear for the deposition *per se*, only that it refuses to appear should the deposition be

recorded. Thus, the narrow matter now before the Board is Petitioner's motion to audio record the anticipated deposition. Respondent opposes the motion, essentially seeking a protective order that the deposition be held without the recording.

Trademark Rule 2.116(a) provides that “[e]xcept as otherwise provided, and wherever applicable and appropriate, procedure and practice in *inter partes* proceedings shall be governed by the Federal Rules of Civil Procedure.” That is, on issues where the Trademark Rules are silent the Board applies the Federal Rules of Civil Procedure. Trademark Rule 2.120, which governs discovery in Board cases, including the taking of depositions, is silent on the issue of audio recordings made in connection with the taking of depositions. Therefore, it is appropriate to look to the Federal Rules of Civil Procedure on this topic.

Specifically, as applicable here, Fed. R. Civ. P. 30(b)(3) states:

(A)... Unless the court orders otherwise, testimony may be recorded by audio, audiovisual, or stenographic means.

The Rule does not contain restrictive provisions with respect to recording a deposition.

Although it is generally inappropriate to respond to a request for discovery by seeking a protective order, in certain situations, a party may request that the disclosure or discovery not be had, or be had only on specified terms and conditions. *See* Trademark Rule 2.120, 37 CFR § 2.120(f);

TBMP § 412.06. The party seeking the protective order must establish good cause. TBMP § 412.06. Respondent's misplaced reliance on the Cal. Pen. Code does not establish the requisite good cause.

Moreover, in the present case, Petitioner has indicated repeatedly that the audio recording will be used solely by the court reporter to ensure an accurate transcription of the deposition testimony, therefore a legitimate and *bona fide* litigation purpose has been advanced for the recording.

Accordingly, Petitioner's motion to compel is **GRANTED**, to the extent that Respondent is ordered to produce its designated witness, Dr. W. A. Wahab, for the previously noticed depositions under Fed. R. Civ. P. 30(a) and 30(b)(6). An audio recording of those depositions may be made by, and solely for the use of Petitioner's retained court reporter for the express purpose of creating and ensuring the accuracy and trustworthiness of the deposition transcripts.

Respondent, within **FIVE DAYS** of the mailing date of this order, shall provide Petitioner with a listing of available dates within the following **TWENTY DAYS** for the Rule 30(a) and 30(b)(6) depositions of its designated witness, to be held at the previously agreed upon location.

In the event Respondent fails to comply with this order and make its witness available for the previously noticed depositions, Respondent is cautioned that it may be barred from relying upon or using any information or witnesses to supply evidence on a motion or at a hearing, where such

witness was withheld from discovery.<sup>4</sup> See Fed. R. Civ. P. 37(c)(1); *Quality Candy Shoppes/Buddy Squirrel of Wisconsin Inc. v. Grande Foods*, 90 USPQ2d 1389, 1392 (TTAB 2007); *Presto Prods. v. Nice-Pak Prods.*, 9 USPQ2d 1895, 1896 n.5 (TTAB 1988); TBMP § 527.01(e).

The parties are expected to move this case forward efficiently, and to cooperate with one another going forward to avoid unnecessary motions that tax the Board's limited resources.

### ***Schedule***

Proceedings are **RESUMED**. The Board notes, however, that this proceeding has been pending for over four years, progressing at a lethargic pace, due in large part to the delays caused by the parties' excessive suspension and extension requests for settlement negotiations; discovery having been open since February 7, 2011, and remaining open to date. Each of the parties' motions has alleged that the parties were engaged in discussions aimed at a possible settlement of this dispute. The most recent motions report some progress in the parties' negotiations (draft agreements exchanged, ongoing counterproposal etc.), although a final resolution has not

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<sup>4</sup> Petitioner must raise this matter by objecting to the evidence in question during the trial period and preserving its objection in its brief on the case. See *Panda Travel, Inc.* 94 USPQ2d at 1792-93; *General Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1593-94 (TTAB 2011); TBMP § 527.01(e).

Petitioner may also find its remedy in a motion for sanctions, pursuant to Trademark Rule 2.120(g)(1). However, prior to filing such a motion Petitioner *must first seek leave to file the motion by contacting the assigned Board interlocutory attorney*. Failure to obtain such leave may result in the motion being given no consideration.

been reached, and it remains unclear if and when that will happen. Each of these motions has been granted by the Board.

Inasmuch as the parties have been involved in what the Board assumes to have been earnest and good-faith — but as yet unsuccessful — settlement negotiations for well over three years, it does not appear to the Board that further extension or suspension for settlement purposes would be useful or appropriate.

Notwithstanding the Board's misgivings about the utility of further delaying this proceeding, to avoid hardship and surprise, the Board will allow a 30 day extension of the discovery period.

The Board commends the parties for their efforts, and urges them to continue their discussions. But given the glacial pace of their progress to date, the parties should be prepared to proceed promptly to trial if an agreement is not sooner reached. Further extensions or suspensions for the purposes of settlement will not be granted absent a showing of **extraordinary circumstances**.<sup>5</sup> To the extent the parties seek to settle this case, they are free to use the remaining time in the discovery period to resolve any remaining settlement issues and finalize a settlement agreement, or to continue their settlement talks as the case proceeds forward. In any

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<sup>5</sup> The parties should note that neither the general press of other business matters, nor any difficulties with communicating with each other will be seen to present **extraordinary circumstances**.

event, the parties should promptly inform the Board of any settlement so this case may be promptly concluded.

Remaining discovery, disclosure, and trial dates are reset as follows:

Discovery Closes	<b>2/22/2015</b>
Plaintiff's Pretrial Disclosures	<b>4/8/2015</b>
Plaintiff's 30-day Trial Period Ends	<b>5/23/2015</b>
Defendant's Pretrial Disclosures	<b>6/7/2015</b>
Defendant's 30-day Trial Period Ends	<b>7/22/2015</b>
Plaintiff's Rebuttal Disclosures	<b>8/6/2015</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>9/5/2015</b>

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 Trademarks Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.