

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

Baxley

Mailed: September 7, 2016

Cancellation No. 92057132

Tao Licensing, LLC

v.

Bender Consulting Ltd. dba Asian Pacific  
Beverages

**Andrew P. Baxley, Interlocutory Attorney:**

In a stipulation filed December 14, 2015, the parties agreed to witness testimony by signed affidavit or declaration, provided that the party offering the testimony makes the witness available for cross-examination. 39 TTABVUE 3. *See* Trademark Rule 2.123(e)(3).

Respondent's testimony period closed on February 19, 2016. On June 2, 2016, Petitioner filed a motion to strike the testimony declarations of Respondent's owner Marcus Bender ("Bender") (52 TTABVUE 1-52) and Nguyen Danh Vinh ("Vinh") (53 TTABVUE 17) that were filed on February 19, 2016, the last day of Respondent's testimony period. The motion has been fully briefed.

Trial testimony in Board proceedings shall be sworn, i.e., under oath. *See* Trademark Rule 2.123(e)(1); TBMP § 703.01(h). The Bender declaration was not made under oath in compliance with either 28 U.S.C. § 1746<sup>1</sup> or Trademark Rule

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<sup>1</sup> 28 U.S.C. § 1746 states as follows:

2.20.<sup>2</sup> Notwithstanding that the Bender declaration was filed pursuant to Patent and Trademark Office Rule 11.18(b),<sup>3</sup> that declaration does not constitute testimony in the absence of an oath or affirmation thereof. *See McDonald's Corp. v. McKinley*,

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Wherever, under any law of the United States or under any rule, regulation, order, or requirement made pursuant to law, any matter is required or permitted to be supported, evidenced, established, or proved by the sworn declaration, verification, certificate, statement, oath, or affidavit, in writing of the person making the same (other than a deposition, or an oath of office, or an oath required to be taken before a specified official other than a notary public), such matter may, with like force and effect, be supported, evidenced, established, or proved by the unsworn declaration, certificate, verification, or statement, in writing of such person which is subscribed by him, as true under penalty of perjury, and dated, in substantially the following form:

- (1) If executed without the United States: "I declare (or certify, verify, or state) under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. Executed on (date). (Signature)".
- (2) If executed within the United States, its territories, possessions, or commonwealths: "I declare (or certify, verify, or state) under penalty of perjury that the foregoing is true and correct. Executed on (date). (Signature)".

<sup>2</sup> Trademark Rule 2.20 states as follows:

Instead of an oath, affidavit, or sworn statement, the language of 28 U.S.C. 1746, or the following declaration language, may be used:

The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

<sup>3</sup> The Board considered an unsworn declaration from Mr. Bender in deciding the parties' cross-motions for summary judgment in a June 26, 2015 decision. 35 TTABVUE 4-5. However, the Board is more liberal in considering evidence in connection with such motions than it is at trial. In deciding motions for summary judgment, the Board is merely deciding whether factual disputes exist, whereas at trial the Board is deciding those factual disputes.

**Cancellation No. 92057132**

13 USPQ2d 1895, 1897 n.4 (TTAB 1989). Accordingly, the motion to strike is granted with regard thereto.

However, the defect in the Bender declaration is curable. Therefore, Respondent is allowed until twenty days from the mailing date set forth in this order to file an amended Bender declaration made under oath, failing which the Bender declaration will stand as stricken. See *FUJIFILM SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1237 (TTAB 2014); *M-Tek Inc. v. CVP Systems Inc.*, 17USPQ2d 1070, 1073 (TTAB 1990). Such amended declaration shall not include any substantive changes.

Regarding the Vinh declaration, such declaration is also unsworn. Although Respondent states that it understands that Vietnamese law does not permit Vietnamese citizens to testify in foreign lawsuits where the witness could be subject to foreign liability for perjury if judicial assistance from the Vietnamese authorities was not previously obtained, it was incumbent upon Respondent as the party relying on that testimony to obtain the requisite judicial assistance so that Mr. Vinh could provide sworn testimony in this case. Further, Mr. Vinh, a Vietnamese citizen residing in Vietnam, did not appear for cross-examination under oath in accordance with the parties' stipulation. Although Respondent contends that the Vinh declaration is admissible as an exhibit to the Bender declaration as a writing used to refresh a witness under Federal Rule of Evidence 612, Respondent has cited to no case law, nor is the Board aware of any case law, that supports such admissibility.

**Cancellation No. 92057132**

Accordingly, the motion to strike is granted with regard thereto. The Vinh declaration will receive no consideration.

Proceedings herein are resumed. Remaining dates are reset as follows.

Plaintiff's Rebuttal Disclosures Due	<b>10/13/2016</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>11/12/2016</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 Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129. If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.