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

Proceeding	92065051
Party	Plaintiff Master Inspector Certification Board, Inc.
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Date	05/14/2018
Attachments	Response to Motion to Quash Certified Inspection Expert.pdf(82241 bytes) Thornberry Response Ex A.pdf(1116642 bytes) Thornberry Response Ex B.pdf(1361844 bytes)

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

MASTER INSPECTOR CERTIFICATION)	
BOARD, INC.,)	
)	
Petitioner,)	Cancellation No. 92065051
)	
)	Certification Mark: CERTIFIED
)	INSPECTION EXPERT
)	
PHILLIP NATHAN THORNBERRY,)	Reg. No.: 4,801,335
)	
Registrant.)	
_____)	

RESPONSE TO MOTION TO QUASH

Petitioner submits this Response (Response) to Respondent’s Motion to Quash Discovery Deposition Notice (Motion). The TTAB should deny the Motion for the reasons below.

ARGUMENT

I. TO THE EXTENT THE MOTION RELIES ON F.R.C.P. 26 AND F.R.C.P. 30, THE MOTION IS PROCEDURALLY DEFECTIVE BECAUSE UNDER THE FEDERAL RULES OF CIVIL PROCEDURE A MOTION TO QUASH MAY ONLY BE USED TO QUASH A SUBPOENA TO A THIRD PARTY; THE PROPER REMEDY UNDER THE FEDERAL RULES WOULD HAVE BEEN TO SEEK A PROTECTIVE ORDER. THUS, IN EVALUATING THE MOTION, THE TTAB SHOULD CONSIDER ONLY TBMP SECTION 521.

Respondent’s Motion begins with citations to F.R.C.P. 26(c) and F.R.C.P. 30(b). Motion at page 1. The word “quash” does not appear in F.R.C.P. 26(c), not does it appear in F.R.C.P. 30. Under the federal rules, motions to quash are governed by F.R.C.P. 45(d)(3), which provides:

- (3) *Quashing or Modifying a Subpoena.*
- (A) *When Required.* On timely motion, the court for the district where compliance is required must quash or modify a subpoena that:

- (i) fails to allow a reasonable time to comply;
- (ii) requires a person to comply beyond the geographical limits specified in Rule 45(c);
- (iii) requires disclosure of privileged or other protected matter, if no exception or waiver applies; or
- (iv) subjects a person to undue burden.

In this case, Petitioner did not issued a subpoena to Respondent, but rather issued a deposition notice. The appropriate remedy under the federal rules, if Respondent felt grounds existed, would have been to seek a protective order under F.R.C.P. 26(c), which provides in relevant part:

(c) PROTECTIVE ORDERS.

(1) *In General.* A party or any person from whom discovery is sought may move for a protective order in the court where the action is pending—or as an alternative on matters relating to a deposition, in the court for the district where the deposition will be taken. The motion must include a certification that the movant has in good faith conferred or attempted to confer with other affected parties in an effort to resolve the dispute without court action. The court may, for good cause, issue an order to protect a party or person from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the following:

- (A) forbidding the disclosure or discovery;
- (B) specifying terms, including time and place or the allocation of expenses, for the disclosure or discovery;
- (C) prescribing a discovery method other than the one selected by the party seeking discovery;
- (D) forbidding inquiry into certain matters, or limiting the scope of disclosure or discovery to certain matters;
- (E) designating the persons who may be present while the discovery is conducted;
- (F) requiring that a deposition be sealed and opened only on court order;
- (G) requiring that a trade secret or other confidential research, development, or commercial information not be revealed or be revealed only in a specified way; and
- (H) requiring that the parties simultaneously file specified documents or information in sealed envelopes, to be opened as the court directs.

Therefore, to the extent the Motion relies on F.R.C.P. 27 and F.R.C.P. 30, Respondent has employed the wrong procedural device, the TTAB need not consider the merits of the Motion, and should deny it as procedurally defective under those rules without prejudice to Respondent's right to seek a protective order.

Respondent also cites TMBP Section 521, which provides in relevant part:

521 Motion to Quash Notice of Deposition A party to an inter partes proceeding before the Board may file a motion, prior to the taking of a noticed discovery or testimonial deposition, to quash the notice of deposition. Alternatively, in the case of a notice of discovery deposition and under appropriate circumstances, the party may file a motion for a protective order. See TBMP § 410.

It is not clear why TBMP Section 521 provides for a Motion to Quash as an alternative to a motion for a protective order when the federal rules of civil procedure do not. The Introduction to the Manual states, “The manual does not modify, amend, or serve as a substitute for any existing statutes, rules, or decisional law and is not binding upon the Board, its reviewing tribunals, the Director, or the USPTO.” In any event, the TTAB must consider the Motion, if at all, only under TBMP Section 521, not F.R.C.P. 26 or F.R.C.P. 30. Respondent appears confused because in Respondent’s “Conclusion,” Respondent asks for a “protective order.”

II. THE TTAB SHOULD DENY THE MOTION ON ITS MERITS.

A. THE MOTION IS BASED ON FALSE ALLEGATIONS AND IRRELEVANT MATTERS.

False and Irrelevant Statement No. 1 – the Allegation that Petitioner Stated it Would Not Seek Discovery.

When Petitioner represented last year that it did not intend to conduct discovery, that was in response to Respondent’s Motion to Compel responses to written discovery, and what Petitioner meant was it did not intend to conduct “written” discovery.¹ The TTAB denied the Motion to Compel, finding that Respondent had failed to cooperate. But Respondent misses the point in any event because, no matter what Petitioner may have said, Petitioner is entitled to conduct discovery at any time before the discovery cutoff, which is May 21, 2018. Respondent has not alleged that

¹ Petitioner is under no duty to conduct written discovery prior to a deposition. F.R.C.P. 26(d)(3) specifically states a party may conduct discovery “in any sequence.”

what Petitioner may have said at one point in time somehow confers a vested right on Respondent, nor has Respondent alleged it would somehow be unfairly prejudiced even if Petitioner had simply changed its position. This allegation is a straw man argument. Courts frown on straw man arguments. *Jones v. NL Industries*, 2006 WL 1666691 (N.D. Miss. 2006). See also, *In Re Gushlak*, 2012 WL 2564523 (E.D.N.Y. 2012) (Use of straw man argument was frivolous and warranted award of attorney's fees).

False and Irrelevant Statement No. 2 – the Allegation that Petitioner Requested the Deposition of Respondent “With Barely Seven Days Left in the Discovery Period.”

Exhibit 4 to the Motion shows that Petitioner’s counsel emailed Respondent’s counsel on May 9, 2018. The discovery cutoff is May 21, 2018. Simple subtraction shows that $21 - 9 = 12$. Thus, contrary to Respondent’s assertion, Petitioner requested deposition dates *twelve* days in advance of the cutoff – not “barely seven days.”² Courts may take judicial notice of mathematical calculations. See., e.g., *Thomas v. Duvall*, 2017 WL 2928153 3:16-CV-00451(M.D. Penn 2017). Moreover, the number of days’ notice given is only marginally relevant because the issue is not how many days’ notice was given, but whether the proposed deposition “is untimely.” TBMP Section 521. That is discussed below.

False and Irrelevant Statement No. 3 – Petitioner’s Disclosures Were Not Updated.

Respondent alleges Petitioner “never subsequently updated” its initial disclosures. Motion at (un-numbered) page 2. This is both false and irrelevant. Petitioner filed initial disclosures, and subsequently filed trial disclosures and expert disclosures. The initial disclosures specifically listed the deponent, Mr. Thornberry, as a person with knowledge. The trial disclosures also listed him as a possible witness. Respondent never challenged the sufficiency of the disclosures, but in

² Respondent’s math is similarly flawed in describing in describing the deposition as an “eleventh hour” deposition. Motion at page 1. Twelve days multiplied by 24 hours would be 288 hours. Even subtracting seventeen hours because Petitioner sent the email at about 5:00 p.m., that would still be 271 hours.

any event those issues are wholly irrelevant to the issue of whether Petitioner has the right to depose the Respondent and whether the deposition notice was “untimely.” This is another straw man argument.

False Statement No. 4 – Respondent’s Counsel Informed Petitioner’s Counsel Respondent (sic) Would Need to Extend the Discovery Date.

The Motion alleges that Respondent’s counsel informed Petitioner’s counsel, “Respondent would need to extend the discovery deadline if it wanted to take depositions.” Motion at (un-numbered) page 4. As **Exhibit 4** to the Motion shows, Petitioner’s counsel told Respondent’s counsel on May 9th, “If no dates are available prior to May 21, we would be willing to stipulate extension of the discovery cutoff for that purpose.” However, rather than work cooperatively as required by TBMP 408.01, Respondent’s counsel declined that offer and simply took the position that Respondent was “not able to accommodate this unreasonable request.” Respondent’s counsel also wrote, “Nor do we agree to an extension of the discovery period.” Thus, Respondent’s counsel did not tell Petitioner’s counsel Petitioner would need to extend the discovery date and specifically rejected that proposal.

Irrelevant Statement No. 5 – Petitioner Knew of Mr. Thornberry’s Busy Schedule.

Respondent’s Motion suggests Petitioner knew of Mr. Thornberry’s busy schedule, but in her emails to Petitioner’s counsel dated May 10, 2018 (which are part of **Exhibit 4** to the Motion), Respondent’s counsel did not state that Mr. Thornberry was unavailable, she stated only that Petitioner’s request “could not be accommodated.” In any event, Petitioner’s counsel has better things to do than keep track of Mr. Thornberry. Once Respondent’s counsel refused to provide deposition dates or agree to an extension,

it would have been malpractice for Petitioner's counsel not to immediately send a deposition date prior to the discovery cutoff. Petitioner could not file a motion to extend the discovery cutoff because the cutoff would have passed before the TTAB ruled on such a motion, which is exactly what Respondent hoped for.

Irrelevant Allegation No. 6 – Petitioner Waited Too Long to Conduct Discovery.

How the long case has been pending is not relevant to the issue of whether the deposition notice is untimely. As pointed out above, the issue under TBMP Section 521 is whether the notice is “untimely.” (Discussed below). Petitioner is under no duty to conduct discovery as soon as possible. In fact, the TTAB can take judicial notice of the fact that parties routinely seek to avoid the expense of discovery in hopes of achieving a settlement. Here the parties were discussing settlement as recently as April of 2018.

EXHIBIT A. The fact that Petitioner attempted to avoid the need for an expensive deposition in the naïve hope that a settlement might be reached is not relevant.

B. THE TTAB SHOULD DENY THE MOTION BECAUSE OF RESPONDENT'S FAILURE TO COOPERATE.

TBMP 408.01 provides:

The Board expects parties (and their attorneys or other authorized representatives) to cooperate with one another in the discovery process, and looks with extreme disfavor on those who do not. Each party and its attorney or other authorized representative has a duty not only to make a good faith effort to satisfy the discovery needs of its adversary, but also to make a good faith effort to seek only such discovery as is proper and relevant to the issues in the case. Discovery before the Board is not governed by the concept of priority of discovery – that is, a party is not relieved of its discovery obligations, including its duty to cooperate, in spite of the fact that an adverse party wrongfully may have failed to fulfill its own obligations.

Here, the record shows Petitioner’s counsel even offered to extend the discovery deadline cutoff for the limited purpose of taking the deposition if it could not be done prior to the cutoff date, and Respondent’s counsel refused to provide dates prior to the cutoff and did not agree to an extension. This is not the first time the TTAB has noticed Respondent’s failure to cooperate in this case. See, Order of April 18, 2018, in which the Interlocutory Attorney wrote, “Based on the foregoing, it does not appear that Respondent provided Petitioner with a meaningful opportunity to resolve the parties’ dispute prior to seeking Board intervention.”

C. THE RESPONDENT HAS FAILED TO MEET HIS BURDEN OF PROVE TO DEMONSTRATE THAT NOTICE OF DEPOSITION WAS UNTIMELY.

As a threshold matter, the burden of proof is on the party seeking a to quash a subpoena. See, e.g., *Booth v. City of Dallas*, 312 F.R.D. 427 (N.D. Tex. 2015). Similarly, the burden of proof is on the party seeking a protective order. See, e.g., *Shukh v. Seagate Technology, LLC*, 295 F.R.D. 228 (D. Minn. 2013).

F.R.C.P. 30 requires only “reasonable written notice” of a deposition. In TTAB cases, “several business days is usually considered to be the minimum reasonable advance notice that is required.” *A Legal Strategists’ Guide to Trademark Trial and Appeal Board Practice*, 2nd Edition, Jonathan Hudis, Editor, page 76. Attached as **EXHIBIT B**. TBMP 404.01 provides in relevant part:

Discovery depositions must be properly noticed and **taken during the discovery period** unless the parties stipulate that the deposition may be taken outside of the period... As a matter of convenience and courtesy and to avoid scheduling conflicts, the parties should attempt to schedule depositions by agreement rather than have the deposing party unilaterally set a deposition date. However, it is not unusual for the deposing party to notice a deposition and subsequently discuss alternative dates with the party to be deposed. (Emphasis added).

Here, the deposition is set to take place “during the discovery period.” TBMP Section 521 provides that a party may file a motion to quash only if the proposed deposition is “untimely.” Note 1 to that section provides some examples:

See National Football League v. DNH Management LLC, 85 USPQ2d 1852, 1855 (TTAB 2008) (notice for deposition to be taken outside discovery period quashed when served on last day of discovery); *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1298 (TTAB 1997) (notice was reasonable and timely; no scheduling conflict with depositions in civil action); *Marshall Field & Co. v. Mrs. Field’s Cookies*, 17 USPQ2d 1652, 1652 (TTAB 1990) (notices of 13 depositions on written questions served eight months after original opening of testimony period, but within ten days of latest extension, were timely); *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372, 373 (TTAB 1978) (deposition noticed during discovery but scheduled for date after discovery closed was untimely).

Unlike the *National Football League* and *Gulf Oil* cases, the deposition noticed here is to take place prior to the discovery cutoff. This case is more like the *Lamb-Weston* case where the Board noted:

In fact, respondent offered to reschedule the deposition to another mutually agreeable date. Petitioner, on the other hand, has been wholly uncooperative.

Other TTAB cases support Petitioner’s position. *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1653 (TTAB 2007) (six days’ notice reasonable); *Gaudreau v. American Promotional Events, Inc.*, 82 USPQ2d 1692, 1695 (TTAB 2007) (three-day notice was reasonable); *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, 804 n.6 (TTAB 1982) (two-day notice of deposition, although short, was not unreasonable where deposition was held a short distance from applicant’s attorney’s office and where no specific prejudice was shown).

It may also be helpful to review the case law and authorities concerning F.R.C.P. 30 in this regard. In 8A Fed. Prac. & Proc. Civ. § 2111 (3d ed.), Section 2111, the authors write:

The rules merely provide that a party must give “reasonable written notice” of taking a deposition. There has been very little controversy as to what constitutes a “reasonable” time. Obviously no fixed rule can be laid down because much will depend on the other circumstances of the particular case. Thus it has been held that fixing a date for taking depositions two days after the notice was served was unreasonable in the absence of a showing of any special need for haste. In some cases, one day's notice has been upheld, albeit under unusual circumstances, and notice of six or eight days has been upheld.

In *Pearl v. Keystone Consol. Industries, Inc.*, 884 F.2d 1047 (7th Cir. 1989), the plaintiff in an employment discrimination action received six days' notice by the employer of the deposition of employer's general sales manager. The Court denied the challenge to the deposition and noted the party opposing the deposition failed to explain why six days' notice was insufficient notice. Similarly, in *Paul v. Winco Holdings, Inc.*, 249 F.R.D. 643 (D. Idaho 2008), the Court held that a deposition notice served eight days prior to the discovery cutoff was reasonable. Another court also considered eight days reasonable. *Jones v. U.S.*, 720 F. Supp. 355 (S.D. N.Y. 1989).

Generally, courts have held notices for depositions prior to the discovery cutoff, given on more than a few days' notice, to be reasonable, in the absence of exceptional circumstances. For instance, in *Mims v. Central Manufacturer's Mutual Ins. Co.*, 178 F.2d 56 (5th Cir. 1949), the court found that notice of taking sixteen deposition in ten cities on the same date served ten days before trial was not reasonable.” *U.S. v. Phillip Morris, Inc.*, 312 F.Supp.2d 27 (three days' notice not sufficient “especially to busy litigators who need to prepare to testify about events occurring six to nine years previously.”). *Harry A. v. Duncan*, 223 F.R.D. 536, 538–39 (D. Mont. 2004) (“It is difficult to conceive how a party can adequately prepare for 85 depositions within two weeks.”).

CONCLUSION

F.R.C.P. 26 and F.R.C.P. 30 do not authorize a motion to quash. The TTAB may quash a deposition notice under TBMP Section 521 only if the notice is “untimely.” Here, Petitioner’s

counsel contacted Respondent's counsel twelve days before the discovery cutoff and asked for dates. Petitioner's counsel even agreed to extend the cutoff if Respondent could not find a date that would work prior to the cutoff. Rather than work cooperatively with Petitioner, Respondent's lawyers were obstinate and set themselves up the sole arbiters of what was reasonable, stated without explanation that they could not accommodate Petitioner's request, and forced Petitioner's counsel to unilaterally pick a deposition date prior to the cutoff. Even then, the deposition notice was emailed to Respondent's counsel eight days prior to the deposition. Respondent's Motion is based on false statements and specious arguments. The TTAB precedents and the federal case law support Petitioner's position. The TTAB should deny the Motion under TBMP Section 521 on the merits and as a sanction for Respondent's failure to cooperate. If the TTAB denies the Motion, Petitioner remains willing to stipulate to an extension of the cutoff if Respondent prefers to do that rather than move forward with the scheduled deposition.

/ Mark Cohen /

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**ATTORNEYS FOR PETITIONER
MASTER INSPECTOR CERTIFICATION BOARD,
INC.**

CERTIFICATE OF SERVICE

I certify that on May 14, 2018, I served a true and correct copy of this Response on:

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via email to them at alix@alixvollmer.com, Alice.Kelly@icemiller.com,
Shyla.Jones@icemiller.com, and chiipdockete@icemiller.com.

/ Mark Cohen/

From: Mark Cohen, J.D., LL.M.
To: ["Nathan Thornberry"](#); ["Nick Gromicko"](#)
Cc: ["Alix Vollmer"](#)
Bcc: ["James A. \("Jamie"\) Sheridan"](#); ["Rita Bachman"](#)
Subject: RE: Potential Settlement Terms
Date: Monday, April 02, 2018 12:42:00 PM

EXHIBIT A

I just spoke with Nick.

MICB and InterNACHI reject this proposal.

MICB and InterNACHI make this counterproposal:

1. Mr. Thornberry assigns all rights to Certified Inspection Expert (CIE) to MICB with no restrictions of any kind and agrees to cease offering new CIE designations immediately. He will provide a list of existing CIE's and may continue selling CIE merchandise to those people for six months. Mr. Thornberry agrees that neither he nor any for-profit entity with which he is associated will ever apply for a federal certification mark for home inspectors.
2. InterNACHI and MICB drop their opposition to RWS's Home Inspection University trademark and agree not to contest any use of "University" by Mr. Thornberry or any entity associated with him.

Sincerely,

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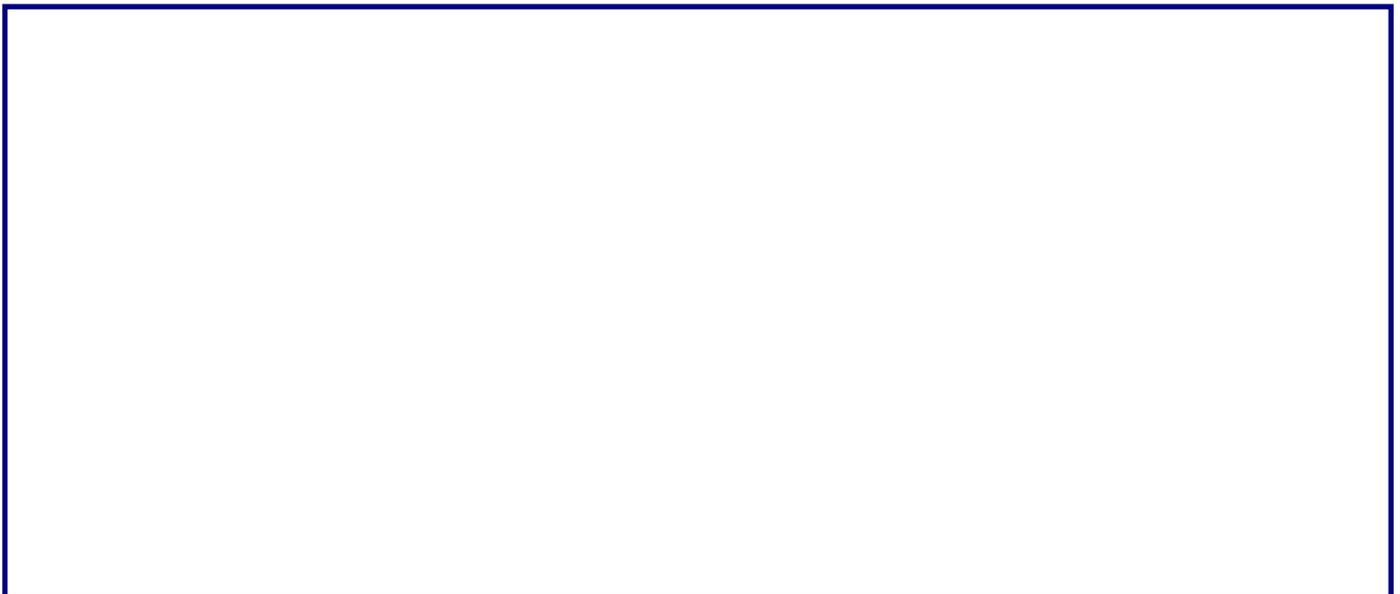


EXHIBIT B

A Legal Strategist's Guide to

TRADEMARK TRIAL AND APPEAL BOARD PRACTICE

SECOND EDITION

Jonathan Hudis, Editor

A Legal Strategist's Guide to TRADEMARK TRIAL AND APPEAL BOARD PRACTICE Second Edition



ABA Section of
Intellectual Property Law
AMERICAN BAR ASSOCIATION

A Legal Strategist's Guide to

**TRADEMARK TRIAL
AND APPEAL BOARD
PRACTICE**

SECOND EDITION

Jonathan Hudis, Editor

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not own a pleaded USPTO registration, it is doubtful that *Rosenruist* could be used to compel a deposition in the United States.

The deposition of an unwilling third-party witness located outside of the United States is very difficult and has an unpredictable chance for success. 28 U.S.C. § 1781 is the statute that permits the use of letters rogatory or a request under the Hague Convention on the Taking of Evidence Abroad in Civil or Commercial Matters. Either procedure is very cumbersome, requires the assistance of the U.S. Department of State and the cooperation of foreign authorities, and may take years to implement. While this discovery procedure is pending, the TTAB proceeding will be suspended.

When the proposed deponent is a party to a TTAB proceeding and is located abroad, Trademark Rule 2.120(c)(1), 37 C.F.R. § 2.120(c)(1), prescribes that a deposition shall be taken by written questions unless the parties stipulate or the TTAB orders otherwise. The TTAB will order an oral deposition of a party located abroad only in unusual circumstances.

Depositions on written questions are the subject of Trademark Rule 2.124, 37 C.F.R. § 2.124, and TBMP Section 404.07. The procedure is cumbersome, but not nearly as cumbersome as the use of letters rogatory. Depositions on written questions have further drawbacks in that the proposed deponent will know all of the questions and suggested answers in advance, and will often provide answers that were in fact prepared by counsel for the party being deposed. In addition, any cross-examination questions, redirect questions, and recross questions also are prepared in advance of the deposition, are served together with the direct examination questions, and are known to the deponent, who will have an opportunity to prepare answers. There is no opportunity for follow-up questions to explore newly disclosed facts.

Proceedings will be suspended at the TTAB until the deposition on written questions is completed.⁶⁰

C. Notice of Deposition

Notice of the date, time, and place of a deposition, the taking of a deposition before a reporter qualified to swear the witness, and an invitation to attend and to cross-examine the witness must be given prior to an oral deposition.⁶¹ Several business days is usually considered to be the minimum reasonable advance notice that is required. It is better practice, and most often happens, that counsel for the parties will agree on a date, time, and place for a deposition. If the deposition will be taken of a nonparty witness, counsel for the nonparty witness must also be consulted for agreement on the date, time, and place of the deposition.

60. Trademark Rule 2.124(d)(2), 37 C.F.R. § 2.124(d)(2).

61. FED. R. CIV. P. 30(b)(1).

If a notice of deposition states that a party is to designate, pursuant to Fed. R. Civ. P. 30(b)(6), an officer, director, managing agent, or other person willing to testify on behalf of the party, the notice should list, with specificity, the subjects on which the witness will be examined. It is then the duty of the responding party to equip the prospective witness with the information so that the witness will be able to testify on behalf of the party.⁶² If a witness is deposed in a personal capacity, the witness is expected to be able to testify only on the basis of information within her or his knowledge.⁶³

**D. Suggested Form of Notice of Taking Deposition
of Rule 30(b)(6) Witness**

_____)	
XYZ Corporation,)	
)	
Opposer)	
)	Opposition No.: 91/000,000
v.)	Mark: WIDGET
)	
1234 Corporation,)	
)	
Applicant)	
_____)	

NOTICE OF DISCOVERY DEPOSITION

To: Name of Counsel

Address:

Please take notice that, on the 4th day of January 2012, at 1776 Independence Boulevard, Any Town, Any State 10101, commencing at 10:00 A.M. EST and continuing until completed, Opposer XYZ Corporation will take the discovery of Applicant 1234 Corporation by oral deposition before a reporter authorized to administer oaths.

(continued)

⁶² FED. R. CIV. P. 30(b)(6).

⁶³ DHL Express (USA), Inc. v. Express Save Indus., Inc., 2009 U.S. Dist. LEXIS 102981, at *13-14 (S.D. Fla. 2009) (discussing the distinction between the required knowledge of a witness deposed in his individual capacity versus pursuant to FED. R. CIV. P. 30(b)(6)).