UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: May 15, 2018

Cancellation No. 92065051

Master Inspector Certification Board, Inc.

v.

Phillip Nathan Thornberry

Wendy Boldt Cohen, Interlocutory Attorney:

This case comes up on Respondent's construed motion for protective order[1] prohibiting the discovery deposition of Phillip Nathan Thornberry and to prohibit extension of the discovery deadline. *See* Fed. R. Civ. P. 26(c)(1); Trademark Rule 2.120; TBMP §§ 404, 412 (June 2017). Petitioner contests the motion. To address the motion, the Board convened a telephone conference on May 15, 2018; in attendance were Petitioner's attorneys, Mike Cohen and James Sheridan, Respondent's attorneys, Shyla Jones and Alice Kelly and Board Interlocutory Attorney, Wendy Boldt Cohen.

As an initial matter, given the record before the Board and the tenor of the parties' filings, it is clear that the parties have been less than cooperative during the discovery process. The Board finds it necessary to again remind the

[1] As discussed in the conference, although captioned as a motion to quash, inasmuch as Respondent's motion seeks to prohibit a discovery deposition, the Board construes its motion as a motion for protective order. Whether construed as a motion to quash or motion for protective order, the Board's decision would not be changed.

parties that it expects the parties to cooperate with one another in the discovery process and looks with extreme disfavor on those who do not. *See* Trademark Rule 2.120(i)(1); *Panda Travel Inc. v. Resort Option Enterprises, Inc.*, 94 USPQ2d 1789, 1791 (TTAB 2009); *Amazon Technologies Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009). "[E]ach party and its attorney has a duty … to make a good faith effort to satisfy the discovery needs of its opponent." *See Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1305 (TTAB 1987); *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986). It is believed that both parties, and Respondent in particular, have failed in their obligation in this case. As a consequence, the parties and the Board have been saddled with needless motions which could have been avoided had the parties sought to deal with each other in a good faith cooperative manner. *Luehrmann*, 2 USPQ2d at 1305. Indeed, the dispute at hand could have been resolved without Board involvement had the parties simply cooperated with each other in the scheduling of Mr. Thornberry's discovery deposition.

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. *See* Trademark Rule 2.120(a)(3); *National Football League v. DNH Management LLC*, 85 USPQ2d 1852, 1855 (TTAB 2008). 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. *Sunrider Corp. v. Raats*,

83 USPQ2d 1648, 1654 (TTAB 2007); *Luehrmann*, 2 USPQ2d at 1304. However, a deposing party may notice a deposition and subsequently discuss alternative dates with the party to be deposed. TBMP § 404.01.

The party seeking to take the deposition must give reasonable notice in writing to every adverse party. *See* TBMP § 404.05 and authorities cited therein. Whether notice is reasonable depends upon the individual circumstances of each case. *Gaudreau v. American Promotional Events Inc.*, 82 USPQ2d 1692, 1696 (TTAB 2007).

"Although issuance of a protective order totally prohibiting a deposition occurs only in extraordinary circumstances, the Board has the discretion to limit a deposition or order a deposition not to be had if it determines that the discovery sought is obtainable from other sources that are more convenient and less burdensome or duplicative." TBMP 412.06(a); *see* Fed. R. Civ. P. 26(c)(1); Trademark Rule 2.120(g); *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America Inc.*, 74 USPQ2d 1672, 1674 (TTAB 2005); *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1761-62 (TTAB 1999). The party seeking a protective order to limit a deposition or for a deposition not to be had bears the burden to show good cause therefor by submitting "a particular and specific demonstration of fact, as distinguished from stereotyped and conclusory statements." *The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149, 2152 (TTAB 2013) (citing *FMR Corp.*, 51 USPQ2d at 1761). "Rule 26(c) emphasizes 'the complete control that the court has over the

discovery process.'" *Pioneer Kabushiki Kaisha*, 74 USPQ2d at 1674 (citing Wright & Miller, 8 *Fed. Prac. & Proc. Civ.2d* §2036 (1990)).

Central to Respondent's motion is his arguments that the notice of discovery deposition for Mr. Thornberry did not provide enough notice; that he "is unable to accommodate the request due to travel for the remainder of the discovery period"; and that Mr. Thornberry has a publicized speaking engagement on "the evening of May 17, 2018 in Fort Lauderdale, Florida." *See* 27 TTABVUE 4-7.

As discussed in the conference and pursuant to the record, discovery was set to close on May 21, 2018. *See* 26 TTABVUE 4. Petitioner included Mr. Thornberry as a potential witness in both its initial disclosures and pretrial disclosures. 27 TTABVUE 13; 42; 28 TTABVUE 5. Petitioner's notice of deposition was served May 11, 2018 with the deposition scheduled for May 18, 2018, prior to the close of discovery, in Indianapolis, IN. 27 TTABVUE 56-57. Further, it is clear that Petitioner contacted Respondent to find mutually agreeable dates for the deposition and noted that because of the discovery deadline, if a date could not be agreed upon, Petitioner would "arbitrarily pick a date … [and we] can then agree to change the date." 27 TTABVUE 48-51. Under the circumstances of this case and as discussed in the telephone conference, Petitioner's notice of the deposition was reasonable.

In view of the foregoing, although Petitioner's notice of deposition was adequate and in compliance with Board rules, because Mr. Thornberry is

unable to attend the deposition as noticed, *see* 27 TTABVUE 4-5, the motion for protective order is **granted as modified.** The discovery deposition of Mr. Thornberry will not take place as noticed in Petitioner's original notice of discovery deposition, namely, May 18, 2018. *See* 27 TTABVUE 56. Notwithstanding the foregoing, fairness dictates a compromise approach to protect both parties' interests. *See Byer California v. Clothing for Modern Times Ltd.,* 95 USPQ2d 1175, 1179 (TTAB 2010). Accordingly, proceedings remain suspended for the sole purpose of allowing Petitioner to re-schedule and depose Mr. Thornberry at a mutually agreeable date and time, to take place by **June 20, 2018**.[2] The parties are expected to cooperate in scheduling Mr. Thornberry's discovery deposition.[3]

In view of the Board's order and as discussed in the telephone conference, Respondent's request that an extension of the discovery period be prohibited, is **denied**. *See* 27 TTABVUE 8-9.

Proceedings will automatically resume on **June 21, 2018**. Dates are reset as follows:

Discovery Closes	July 1, 2018

[2] Respondent indicated that he needs until June 20, 2018 to participate in the discovery deposition to accommodate his travel schedule. The Board emphasized that it expects Respondent to cooperate with Petitioner in scheduling the deposition inasmuch as over a month has been provided as a courtesy to Respondent's schedule.

[3] Should the parties require additional time to schedule Mr. Thornberry's deposition beyond the date set forth herein, the parties should so advise the Board by filing a motion, as appropriate.

In the conference, Petitioner indicated that it had previously noticed the depositions of certain other parties, along with corresponding subpoenas. This order does not prohibit the taking of any deposition already properly noticed prior to the date of this order.

Plaintiff's Pretrial Disclosures Due	August 15, 2018
Plaintiff's 30-day Trial Period Ends	September 29, 2018
Defendant's Pretrial Disclosures Due	October 14, 2018
Defendant's 30-day Trial Period Ends	November 28, 2018
Plaintiff's Rebuttal Disclosures Due	December 13, 2018
Plaintiff's 15-day Rebuttal Period Ends	January 12, 2019
BRIEFS SHALL BE DUE AS FOLLOWS:	
Plaintiff's Main Brief Due	March 13, 2019
Defendant's Main Brief Due	April 12, 2019
Plaintiff's Reply Brief Due	April 27, 2019

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.