UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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mbm

November 16, 2018

Cancellation No. 92066392

Covidien LP

v.

ERBE Elektromedizin GmbH

Mary Beth Myles, Interlocutory Attorney:

This proceeding now comes before the Board for consideration of Respondent's motion (filed August 3, 2018) to compel the discovery deposition of Gregory Seitz. The motion is fully briefed.

As an initial matter, the Board finds that Respondent made the required good faith effort to resolve the parties' discovery dispute prior to seeking Board intervention. *See* Trademark Rule 2.120(f)(1), 37 C.F.R. § 2.120(f)(1).

Respondent seeks to compel the discovery deposition of Mr. Seitz, who is a former sales representative for Respondent and the current Director of Global Marketing of the Colorectal and Chronic Diseases Division of Medtronic, Inc., Petitioner's parent company. 16 TTABVUE 3; 17 TTABVUE 28.

Pursuant to Trademark Rule 2.120(b), 37 C.F.R. § 2.120(b):

> The responsibility rests wholly with the party taking discovery to secure the attendance of a proposed deponent other than a party or anyone who, at the

> time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure.

Medtronic is not a party to this proceeding, nor is Mr. Seitz a party or a **current** officer, director, or managing agent of a party to this proceeding.[1] The Trademark Rules and Board precedent are clear that if a party wishes to take the discovery deposition of a non-party and the proposed non-party deponent is not willing to appear voluntarily, the deposing party must secure the non-party deponent's attendance by subpoena pursuant to 35 U.S.C. § 24 and Fed. R. Civ. P. 45. TBMP § 404.03(a)(2); *Ate My Heart v. GA GA Jeans*, 111 USPQ2d 1564, 1565 n.5 (TTAB 2014) (notice of deposition of unwilling non-party witness must include subpoena); *Highbeam Marketing LLC v. Highbeam Research LLC*, 85 USPQ2d 1902, 1905 n.2 (TTAB 2008) ("As a non-party, [the witness] could not be deposed on notice alone, unless willing."); *Kellogg Co. v. New Generation Foods Inc.*, 6 USPQ2d 2045, 2048-49 (TTAB 1988) (deposition of former employee could only be taken by voluntary appearance or by subpoena). The subpoena must be issued from the United States district court in the federal judicial district where the deponent resides or is regularly

[1] In Respondent's reply brief, Respondent states that Mr. Seitz "has been employed as a sales and/or marketing representative by both [Respondent] and Petitioner Covidien LP…" 18 TTABVUE 2. Nothing in the record indicates that Mr. Seitz is a current employee of Petitioner, however. Mr. Seitz submitted a declaration identifying himself as an employee of Medtronic, Inc., not Petitioner. 17 TTABVUE 28. Moreover, in its motion to compel, Respondent similarly identifies Mr. Seitz as an employee of Petitioner's **parent** company and **former** employee of Respondent only. 16 TTABVUE 3. Thus, there is nothing in the record to support the statement that Mr. Seitz is a party to this proceeding or is currently an officer, director, or managing agent of a party.

employed. *See* 35 U.S.C. § 24; Fed. R. Civ. P. 45. *See also* TBMP § 404.03(a)(2) and cases cited therein.

It is clear based on the filings before the Board that Mr. Seitz has not voluntarily agreed to appear for a discovery deposition; thus, to the extent Respondent wished to secure the discovery deposition of Mr. Seitz, it was Respondent's responsibility, pursuant to Trademark Rule 2.120(b), to seek an appropriate subpoena. Moreover, any motions related to a subpoena issued pursuant to Fed. R. Civ. P. 45 must be brought in the district court that issued the subpoena, not with the Board.[2] *See Ate My Heart*, 111 USPQ2d at 1565 n.5.

In view of the foregoing, Respondent's motion to compel Mr. Seitz's appearance at a discovery deposition is **denied**.

Proceedings are resumed. Remaining dates are reset as follows:

Discovery Closes	**11/20/2018**
Plaintiff's Pretrial Disclosures Due	**1/4/2019**
Plaintiff's 30-day Trial Period Ends	**2/18/2019**
Defendant's Pretrial Disclosures Due	**3/5/2019**
Defendant's 30-day Trial Period Ends	**4/19/2019**
Plaintiff's Rebuttal Disclosures Due	**5/4/2019**
Plaintiff's 15-day Rebuttal Period Ends	**6/3/2019**
Plaintiff's Opening Brief Due	**8/2/2019**
Defendant's Brief Due	**9/1/2019**
Plaintiff's Reply Brief Due	**9/16/2019**
Request for Oral Hearing (optional) Due	**9/26/2019**

[2] Respondent appears to contend that the deposition of Mr. Seitz is necessary because Petitioner's Fed. R. Civ. P. 30(b)(6) witnesses were unable to provide specific required information. Petitioner disagrees and contends that its Rule 30(b)(6) witnesses were able to provide adequate information and, in any event, Mr. Seitz has no non-cumulative knowledge relevant to this proceeding. The only motion pending before the Board is Respondent's motion to compel Mr. Seitz's attendance at a discovery deposition. The Board therefore makes no determination regarding Petitioner's Rule 30(b)(6) discovery depositions.

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).