

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

Mailed: February 24, 2023

Cancellation No. 92066411

Oneida Nation

v.

Oneida Indian Nation

Wendy Boldt Cohen, Interlocutory Attorney:

Oneida Nation (“Petitioner”) filed a motion for protective order regarding Oneida Indian Nation’s (“Respondent”) Rule 30(b)(6) notice of deposition. 55 TTABVUE. The motion is fully briefed.¹

In its motion, Petitioner argues that some of Respondent’s topics of discovery indicated in the Rule 30(b)(6) notice of deposition should be limited because they are overbroad and irrelevant. 55 TTABVUE 5-8. Specifically, Petitioner objects to the following topics:

- Petitioner’s knowledge and awareness of Respondent’s use of Respondent’s Marks;
- Petitioner’s knowledge and awareness of any third-party marks comprised of or containing ONEIDA;
- Petitioner’s U.S. Application No. 88129469 for ONEIDA DOWNS, including all filings, signatures, specimens, declarations and statements of Petitioner before the USPTO in connection with the

¹ The Board has considered the parties’ submissions and presumes the parties’ familiarity with the factual bases for the motion and does not recount them here except as necessary to explain the Board’s order.

prosecution of this application, and all use of the ONEIDA DOWNS mark in connection with any goods or services;

- Objections Petitioner has made against any third party's use and/or registration of any names or marks based in whole or in part on Petitioner's Marks;
- Objections Petitioner has received from any third party concerning Petitioner's use and/or registration of Petitioner's Marks.

Id. at 55-56.

In response, Respondent argues that the topics “are well within the scope of discovery”; that Petitioner's arguments are “meritless”; and that as such, the Rule 30(b)(6) deposition should proceed without any modification. 57 TTABVUE 3-4.

“It is generally inappropriate for a party to respond to a request for discovery by filing a motion attacking it, such as a motion to strike, or a motion for a protective order.” TBMP § 526. Rather, the party ordinarily should respond by providing the information sought in those portions of the request that it believes to be proper, and stating its objections to those which it believes to be improper. *See Luemme Inc. v. D. B. Plus Inc.*, 53 USPQ2d 1758, 1761 (TTAB 1999).

However, there are certain situations (e.g., when a request for discovery constitutes clear harassment, or when a party has not provided its initial disclosures, or when a defendant upon which a request for discovery has been served is not and was not, at the time of the commencement of the proceeding, the real party in interest) in which a party may properly respond to a request for discovery by filing a motion for a protective order that the discovery not be

had, or be had only on specified terms and conditions. *See, e.g.*, Fed. R. Civ. P. 26(c); Trademark Rule 2.120(g); *Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1268 (TTAB 2015); *The Phillies v. Philadelphia Consol. Holding Corp.*, 107 USPQ2d 2149, 2154 (TTAB 2013); *Weatherford/Lamb Inc. v. C&J Energy Serv., Inc.*, 96 USPQ2d 1834, 1835 n.3 (TTAB 2010). Courts have broad discretion to decide when a protective order is appropriate. *See, e.g.*, 8A C. Wright & A. Miller, FED. PRAC. & PROC. CIV. § 2036 (3d. ed. 2022).

Fed. R. Civ. P. 26(c)(1)(D) allows for an order that certain matters not be inquired into, or that the scope of the discovery be limited to certain matters.

Fed. R. Civ. P. 26(c) reads, in pertinent part, that:

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:

...

(D) forbidding inquiry into certain matters, or limiting the scope of disclosure or discovery to certain matters.

After careful consideration of the parties' submissions, the Board is not persuaded that Respondent's requests are of such a nature as to indicate that a protective order to protect Petitioner from "annoyance, embarrassment, oppression or undue burden or expense"² is appropriate at this time. Fed. R.

² The Board notes that Petitioner asserts that Respondent's requests would impose an undue burden because they are purportedly irrelevant and not proportional to the needs of this proceeding. 55 TTABVUE 5. Although an assertion of "undue burden"

Civ. P. 26. Rather, objections regarding the subject matter of a deposition, including overbroad and relevancy objections, should be raised during, not prior to, the actual taking of the deposition. *See Neville Chem. Co. v. The Lubrizol Co.*, 183 USPQ 184, 189 (TTAB 1974) (overruled on other grounds, *Johnson & Johnson v. Rexall Drug Co.*, 185 USPQ 167, 172 (TTAB 1975)).

Petitioner's motion is therefore, **denied**. Notwithstanding, in the event that Petitioner continues its objections during the course of the deposition but also refuses to answer certain questions, Respondent may seek to compel an answer under Trademark Rule 2.120(f). *See, e.g.*, TBMP § 523.01 and authorities cited. If Petitioner, on the other hand, having stated its objections to disputed questions, chooses to answer such questions subject to its specified objections and the deposition is subsequently made of record,³ the Board will at final hearing evaluate the testimony contained therein in the light of Petitioner's stated objections if preserved in the final brief. *See Fischer GmbH v. Molnar & Co.*, 203 USPQ 861, 866 (TTAB 1979); *Neville Chemical Co.*, 183 USPQ at 189; TBMP § 404.05(c).

has been made, the assertion is related to the relevancy of the requests; and to the extent not related thereto, the Board remains unpersuaded that a protective order is warranted.

³ The discovery deposition *of a party* (or of anyone who, at the time of taking the deposition, was an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(4) to testify on behalf of a party) may be offered in evidence *by any adverse party*. Trademark Rule 2.120(k)(1); *see Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1325 (TTAB 1992); *First Int'l Serv. Corp. v. Chuckles Inc.*, 5 USPQ2d 1628, 1630 n.5 (TTAB 1988); *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552, 1555 (TTAB 1987).

General Guidance

In view of the parties' dispute and to obviate the need for further motions on this matter, the Board provides the following general guidance.

Rule 30(b)(6) requires the organization to be deposed to designate one or more officers, directors, or managing agents to testify. "Rule 30(b)(6) anticipates that a party's designated witness will not necessarily have personal knowledge of all matters but will nonetheless offer testimony regarding information that the 'party' should be able to provide." *Flanders v. DiMarizio, Inc.*, 2020 USPQ2d 10671, 2020 BL 226081, at *4 n. 17 (TTAB 2020) (quoting *City Nat'l Bank v. OPGI Mgmt. GP Inc.*, 106 USPQ2d 1668, 1671 n.4 (TTAB 2013)). "[U]nlike all other depositions, there is an implicit obligation to prepare the witness. As specified in the rule, this preparation is not limited to matters of which the witness has personal knowledge, but extends to all information reasonably available to the responding organization." *Flanders*, 2020 BL 226081, at *4 n. 17 (quoting 8A C. Wright & A. Miller, FED. PRAC. & PROC. CIV. § 2103 (3d ed. 2020)). However, while a party served with a Rule 30(b)(6) deposition notice must prepare its witness on the topics of examination, such preparation need only include "matters known or reasonably available to the corporation." *OMS Inv., Inc. v. Habit Horticulture LLC*, 2022 USPQ2d 1074, at *12 n. 36 (TTAB 2022) (quoting *Red Wing Co. v. J.M. Smucker Co.*, 59 USPQ2d 1861, 1864 (TTAB 2001)); see *Flanders*, 2020 BL 226081, at *4 n.17.

Information concerning a party's awareness of third-party use and/or registration of the same or similar marks for the same or closely related goods or services as an involved mark, is discoverable to the extent that the responding party has actual knowledge thereof (without performing an investigation) and that the information appears to be reasonably calculated to lead to the discovery of admissible evidence. *See, e.g., Sheetz of Delaware, Inc. v. Doctor's Assoc. Inc.*, 108 USPQ2d 1341, 1348 (TTAB 2013); *Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1071-72 (TTAB 2011); *Sports Auth. Michigan Inc. v. PC Auth. Inc.*, 63 USPQ2d 1782, 1788 (TTAB 2001); *Am. Soc'y of Oral Surgeons v. Am. College of Oral & Maxillofacial Surgeons*, 201 USPQ 531, 533 (TTAB 1979).

Ordinarily, a party need not provide discovery with respect to those of its marks and goods and/or services that are not involved in the proceeding and have no relevance thereto. *See, e.g., TBC Corp. v. Grand Prix Ltd.*, 16 USPQ2d 1399, 1400 (TTAB 1990); *Johnston Pump/General Valve Inc. v. Chromalloy Am. Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988); *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147, 149 n.2 (TTAB 1985).

Schedule

Proceedings are resumed and dates are reset as follows:⁴

⁴ Inasmuch as the parties' prior motion to extend indicates that the expert disclosure deadline has passed and there is no indication on record that the parties intend to use experts in this proceeding, the Board does not reset the expert disclosure deadline. *See* 53 TTABVUE; TBMP § 509.02 (when the Board resets the closing date for discovery, the expert disclosure deadline, which is 30 days prior to the close of the

Discovery Closes	April 5, 2023
Plaintiff's Pretrial Disclosures Due	May 20, 2023
30-day Testimony Period for Plaintiff's Testimony to Close	July 4, 2023
Defendant and Counterclaim Plaintiff's Pretrial Disclosures Due	July 19, 2023
30-day Testimony Period for Defendant and Plaintiff in the Counterclaim to Close	September 2, 2023
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	September 17, 2023
30-day Testimony Period for Defendant in the Counterclaim and Rebuttal Testimony for Plaintiff to Close	November 1, 2023
Counterclaim Plaintiff's Rebuttal Disclosures Due	November 16, 2023
15-day Rebuttal Period for Plaintiff in the Counterclaim to Close	December 16, 2023

BRIEFS SHALL BE DUE AS FOLLOWS:

Brief for Plaintiff Due	February 14, 2024
Brief for Defendant, and Plaintiff in the Counterclaim Due	March 15, 2024
Brief for Defendant in the Counterclaim and Reply Brief, if any, for Plaintiff Due	April 14, 2024
Reply Brief, if any, for Plaintiff in the Counterclaim Due	April 29, 2024

General Information

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

discovery period, and the testimony periods, including pretrial disclosure deadlines, will usually be automatically reset).

include pretrial disclosures, matters in evidence, the manner and timing of taking testimony, 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). Such briefs should utilize citations to the TTABVUE record created during trial, to facilitate the Board's review of the evidence at final hearing. *See* TBMP § 801.03. 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)