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

Proceeding	91197947
Party	Defendant Advance Watch Company Ltd
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UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

_____/

TISSOT SA

Opposer

v.

ADVANCE WATCH COMPANY LTD.

Applicant.

_____/

Opposition No. 91197947 (parent)
Serial No. 85024910

Opposition No. 91197949
Serial No. 77967275

Opposition No. 91198605
Serial No. 85001891

REPLY IN SUPPORT OF APPLICANT'S 1) CROSS-MOTION TO COMPEL, AND 2) MOTION FOR SANCTIONS

Applicant Advance Watch Company Ltd. ("ADW" or "Applicant") hereby responds to Opposer Tissot SA's ("Tissot" or "Opposer") November 14, 2011 Opposition to Applicant's 1) Cross-Motion to Compel and 2) Motion for Sanctions.

I. REPLY

A. Applicant's Cross-Motion to Compel

Tissot has self-determined ADW's Notice of 30(b)(6) Deposition of Tissot to be both improper and untimely, and concludes that it was not required to respond. However, Tissot did not move to quash (or, for a protective order) and the Board has not ruled that ADW's Notice of 30(b)(6) Deposition of Tissot was improper.[1] As such, ADW is required to designate a 30(b)(6) witness.

1. Applicant's Motions are Germane to Opposer's Motion

Tissot argues that ADW's Cross-Motion to Compel is procedurally defective because it raises issues that are "separate and distinct from those raised by Opposer's Motion to

[1] Had Tissot made such a motion, it would have been required to support its motion with more than the mere assertion of counsel that Tissot does not have anyone that is (or would be) in the United States to designate as a 30(b)(6) witness. The opening motion papers show that Tissot likely has somebody to designate for examination in the United States under Rule 30(b)(6). *See* page 8 of ADW's Cross-Motion to Compel and Exhibit 8 thereto (evidence of Tissot's U.S. presence), as well as ADW's subsequent discussion of *Swatch AG v. Amy T. Bernard and Beehive Wholesale, LLC*, at pages 9-10 of ADW's Cross-Motion to Compel. Indeed, it is likely that the person most qualified to testify on Tissot's behalf regarding the topics listed in ADW's Notice of 30(b)(6) Deposition of Tissot is located in the United States (i.e., Tissot's U.S. Brand Manager). As support, see Opposer's November 28, 2011 Responses to Applicant's Second Set of Request for Admission, attached hereto as **Exhibit 1** ("Opposer admits that The Swatch Group (U.S.) Inc. is the exclusive distributor of TISSOT-branded products in the United States and **bears all responsibilities as to the TISSOT brand which are associated therewith**"). (**Emphasis added**.) Other relevant admissions are highlighted in Exhibit 1.

Compel," and Tissot concludes that ADW's Cross-Motion should be denied. ADW disagrees for the following reasons.

Both parties' motions to compel were necessitated by the parties' failure to resolve scheduling issues themselves, which efforts were further frustrated by Tissot's counsel's stonewalling regarding a 30(b)(6) representative. To the extent that Tissot's arguments in support of its own motion are intertwined with its arguments in opposition to ADW's motions, it is quite clear that the issues raised in both ADW's Cross-Motion to Compel and Motion for Sanctions are closely related to those raised in Tissot's Motion to Compel, and the Board may consider the parties' motions together.

2. Applicant's Notice of 30(b)(6) Deposition is Proper

Tissot deems ADW's Notice of 30(b)(6) Deposition of Tissot to be "invalid on its face because it noticed an oral deposition of a foreign entity in the United States," citing 37 C.F.R. § 2.120(c)(1) regarding the discovery deposition of a natural person *residing in a foreign country,* and relies on this language as an excuse for its failure to designate a 30(b)(6) witness. Tissot maintains that a 30(b)(6) notice of a foreign party in the United States is automatically defective. However, a *foreign party* may be deposed in the United States – 37 C.F.R. § 2.120(c)(2) clearly states that the deposition of a foreign party may be taken on notice:

> Whenever a foreign party is or will be, during a time set for discovery, present within the United States or any territory which is under the control and jurisdiction of the United States, such party may be deposed by oral examination upon notice by the party seeking discovery. Whenever a foreign party has or will have, during a time set for discovery, an officer, director, managing agent, or other person who consents to testify on its behalf, present within the United States or any territory which is under the control and jurisdiction of the United States, such officer, director, managing agent, or other person who consents to testify in its behalf may be deposed by oral examination upon notice by the party seeking discovery. The party seeking discovery may have one or more officers, directors, managing agents, or other persons who consent to testify on behalf of the adverse party, designated under Rule 30(b)(6) of the Federal Rules of Civil Procedure.

> The deposition of a person under this paragraph shall be taken in the Federal judicial district where the witness resides or is regularly employed, or, if the witness neither resides nor is regularly employed in a Federal judicial district, where the witness is at the time of the deposition. This paragraph does not preclude the taking of a discovery deposition of a foreign party by any other procedure provided by paragraph (c)(1) of this section.

In addition, the Fourth Circuit Court of Appeals has held that "a party may name a corporation as a deponent, in either a notice of deposition or a subpoena," and "the examining party [may] seek the corporation's testimony without regard to who actually provides the testimony on behalf of the organization." *Rosenruist-Gestao E Servicos LDA v. Virgin Enterprises Ltd.,* 511 F.3d 437, 85 U.S.P.Q.2d 1385, 1390 (4th Cir. 2007), *cert. denied*, 128 S. Ct. 2508 (2008) (holding that a district court has the power to issue a subpoena for a trial deposition noticed under Fed. R. Civ. P. 30(b)(6) in a Board proceeding, requiring a foreign corporate party to produce an appropriate representative in the United States for testimony, regardless of the domicile of the representative). Clearly, the residence of the individual corporate representative is irrelevant to whether the deponent corporation resides in the United States.

Tissot's failure to designate any 30(b)(6) witness cannot be excused. As further addressed in section B below ("Applicant's Motion for Sanctions"), ADW seeks sanctions if Tissot maintains that there is not an officer, director, managing agent, or other person residing in the United States who would consent to testify on Tissot's behalf regarding the topics identified in ADW's Notice of 30(b)(6) Deposition of Tissot.

3. Opposer's Demand for a Subpoena

In an effort to repeat history, Tissot suggests that ADW subpoena The Swatch Group (U.S.) Inc., as in the prior Board proceeding, *Swatch AG v. Amy T. Bernard and Beehive Wholesale, LLC*, Opposition No. 91169312 (hereinafter "*Swatch v. Bernard"*).

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