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## United States Patent and Trademark Office Rules on Deposing Non-U.S. Resident Executives in Trademark Proceedings

A recent ruling should provide some comfort for non-U.S. companies involved in U.S. trademark oppositions or cancellations. The United States Patent and Trademark Office (USPTO) has clarified that companies with no U.S. operations cannot easily be forced to travel to the U.S. for oral depositions.

In 2007, an appeals court ruled that a foreign corporation party to a proceeding before the Trademark Trial and Appeal Board (TTAB) of the USPTO can be subjected to oral deposition in the U.S. whenever a subpoena is properly issued by a court having jurisdiction over the party. Merely because a Portuguese corporation prosecuted a U.S. trademark application through U.S. counsel, the court compelled it to attend oral depositions in the U.S. This seemed to be contrary to guidance issued by the TTAB.

Last week, in a cancellation proceeding being handled by Haynes and Boone, the adverse party served a Notice of Deposition against our client, a corporation with a principal office in Canada. The adverse party demanded to orally depose our client's corporate representative in the U.S. We persuaded the TTAB that the 2007 appeals court decision is not binding on the TTAB, and that it would unfairly penalize companies with no real U.S. operations or presence. The TTAB agreed and granted our motion to quash the deposition.

What does this mean for your clients? They should not be dissuaded from filing U.S. trademark applications—nor filing or defending U.S. trademark oppositions or cancellations—due to a fear that they will necessarily be required to appear in the U.S. for an oral deposition.

We should note, however, that the recent TTAB decision to grant our motion to quash could be subject to further review.

For more information on the Trademark practice group and its members, you may visit the [Trademark, Advertising and Brand Management](#) page of the Haynes and Boone, LLP Web site. If you have questions or desire further information, please contact one of the following:

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