UNITED STATES: Fourth Circuit Rules on Subpoena Powers in TTAB Proceedings  

In Rosenriust-Gestao E Servicos LDA v. Virgin Enterprises Limited, No. 06-1588 (4th Cir. December 27, 2007), the U.S. Court of Appeals for the Fourth Circuit ruled that a foreign trademark applicant may, through its domestic representative, be compelled to appear in the United States to give testimony in a trademark opposition proceeding pending before the Trademark Trial and Appeal Board (TTAB).

Rosenriust-Gestao E Servicos LDA, a Portuguese corporation that sold no products in the United States and had no presence in the United States, filed an intent-to-use trademark application in the U.S. Patent and Trademark Office to register VIRGIN GORDA for bags, clothing, and various accessories. Virgin Enterprises Limited opposed the Rosenriust application, alleging a likelihood of confusion with its VIRGIN mark, registered for similar goods.

During the opposition proceeding, Virgin subpoenaed Rosenriust, through the domestic representative designated in the Rosenriust application, to testify in a deposition in Virginia. U.S. law provides that the clerk of any U.S. district court for the district where testimony is to be taken for use in a TTAB proceeding shall, upon the application of any party to the action, issue a subpoena for any witness within that district,commanding the witness to appear and testify in that district.

The court held that the service of a subpoena on the domestic representative of the foreign applicant was sufficient to require the foreign applicant to appear and testify in the district where the domestic representative was located. If the foreign applicant fails to name a domestic representative in its trademark application, the Director of Patents and Trademarks in Alexandria, Virginia (the Eastern District of Virginia), is deemed to be the foreign domestic representative of the applicant.

The opinion included a strong dissent by one judge, who asserted that the mere appointment of a U.S. domestic representative in a trademark application is too minimal to justify a federal court’s exercise of its subpoena power.

Although every effort has been made to verify the accuracy of items carried in the INTA Bulletin, readers are urged to check independently on matters of specific concern or interest.

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