

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

K. C. PARKER, : MISCELLANEOUS ACTION
petitioner, :
 :
v. :
 :
HARTSTRINGS, INC., :
respondent. : NO. 00-132

MEMORANDUM ORDER

The court entered an order on June 27, 2000 denying the motion of respondent Hartstrings for a protective order. Presently before the court is respondent's Request for Clarification of that order.

It is respondent which has provided clarification. In the motion for a protective order, respondent asserted the medical condition of the witness, her lawyer's trial schedule, lack of sufficient advance notice and the inconvenience of the site of the deposition. The court thus assumed that respondent was not challenging the manner or process of scheduling a deposition of this key party witness. Respondent now advises, however, that the witness was not properly subpoenaed and such deficiency has not been excused or waived despite service of a proper notice of deposition pursuant to the Rules of the Trademark Trial and Appeal Board.

Respondent attaches and relies on the case of Babcock & Wilcox Co. v. Foster Wheeler Corp., 1972 U.S. Dist. LEXIS 14441 (D.N.J. Mar. 29, 1972) for the proposition that in PTO cases a federal court's jurisdiction "only arises from the issuance of a validly served subpoena." After resorting to the court for a protective order, respondent now suggests that the court lacks jurisdiction to act unless a subpoena has been validly served which respondent states had not been done.

The case relied on by respondent involved a motion for a court order compelling the attendance of a witness at a trial before the Patent Office. The Court stated that it lacked authority to command the presence of a witness at a trial unless he was served with a valid subpoena. Id. at *11. The Court noted that compelling trial testimony "is entirely different from the taking of pretrial depositions," and noted the distinction between party and "non-party witnesses" whose attendance at deposition or trial must be secured by subpoena. Id. at *12. Indeed, the Court in Babcock & Wilcox had earlier directed parties to appear for depositions pursuant to a discovery order which action was affirmed by the Third Circuit. Id. at *3. The Court expressly stated that a motion to compel the attendance of witnesses during discovery in a Patent Office case "is governed by the Federal Rules of Civil Procedure" and "is not limited by the subpoena requirement." Id. at *10.

When the Babcock & Wilcox opinion was issued, the law of this Circuit clearly provided that a federal court had ancillary jurisdiction pursuant to 35 U.S.C. § 24 to compel depositions and other discovery in Patent Office cases in a manner consistent with any of the discovery provisions of the Federal Rules of Civil Procedure. See In re Natta, 388 F.2d 215, 217 (3d Cir. 1968). Other courts have held the same. See Natta v. Hogan, 392 F.2d 686, 690 (10th Cir. 1968) (§ 24 "does not limit discovery to that permissible under rule 45"); Natta v. Zletz, 379 F.2d 615, 618 (7th Cir. 1967); Babcock & Wilcox Co. v. Combustion Engineering, Inc., 314 F. Supp. 235, 237 (D. Conn.), aff'd, 430 F.2d 1177 (2d Cir. 1968).

In a case noted by neither party, however, the Third Circuit overruled In re Natta and held that the language in § 24 regarding discovery pursuant to the Federal Rules of Civil Procedure should be read as limited to matters encompassed by Rule 45. See Frilette v. Kimberlin, 508 F.2d 205, 212 (3d Cir. 1974) (en banc). It thus follows that the authority of the court to grant a protective order in a USPTO proceeding is limited to the circumstances and relief provided in Fed. R. Civ. P. 45(c). The court may not grant a protective order under Rule 26(c). See Byrum v. Nakayama, 220 U.S.P.Q. 722 (E.D. Va. May 23, 1983). Respondent Hartstring's Motion for a Protective Order was properly denied. Moreover, it appears that Ms. Earle has since submitted to deposition pursuant to notice.

ACCORDINGLY, this day of July, 2000, upon
consideration of respondent Hartstring's Request for
clarification (Doc. #5) and petitioner Parker's response, **IT IS**
HEREBY ORDERED that said Motion is **DENIED**.

BY THE COURT:

JAY C. WALDMAN, J.