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 CALCAR, INC. and AMERICAN CALCAR, INC.

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UNITED STATES DISTRICT COURT
 NORTHERN DISTRICT OF CALIFORNIA

CALCAR, INC., a California corporation;
 and AMERICAN CALCAR, INC., a
 Delaware corporation,

Plaintiff(s),

vs.

THE CALIFORNIA CARS INITIATIVE,
 INC., an unknown business entity; and
 FELIX KRAMER, an individual,

Defendant(s).

Case No. 3:08-MC-80083 MHP (WDBx)
 Underlying Civil Action Pending in U.S.
 District Court for the Central District of
 California (Civil Action Case No. SACV07-
 00723)

**PLAINTIFFS' NOTICE OF MOTION
 AND MOTION TO COMPEL
 DEPOSITION TESTIMONY OF THIRD
 PARTY DAVE BAGSHAW**

DATE: August 6, 2008
TIME: 4:00 p.m.
CTRM: 4, 3rd Floor

Honorable Wayne D. Brazil

I. NOTICE OF MOTION AND MOTION

TO DAVE BAGSHAW, THE CALIFORNIA CARS INITIATIVE, INC., FELIX
 KRAMER AND THEIR ATTORNEYS OF RECORD:

PLEASE TAKE NOTICE that on August 6, 2008 at 4:00 p.m., or as soon thereafter as
 the matter may be heard in this Court, Calcar, Inc. and American Calcar, Inc. (collectively

1 "Calcar"), Plaintiffs in the above referenced action pending in the Central District of California,
2 by and through their attorneys, Christie, Parker & Hale, LLP, will move for an Order
3 compelling Dave Bagshaw ("Bagshaw") to comply with a subpoena issued from this Court and
4 appear to provide deposition testimony.

5 **II. RELIEF REQUESTED**

6 The relief sought by Calcar via this motion includes the following:

7 1. An Order compelling Bagshaw to appear for the deposition commanded by
8 subpoena properly served on May 23, 2008.

9 Pursuant to Local Rule 37-1, Calcar met and conferred with Bagshaw on June 19 in a
10 final attempt to obtain Bagshaw's compliance with the subpoena. (Declaration of G. Warren
11 Bleeker ("Bleeker Decl.") filed herewith at ¶ 2.) Calcar submits the following Memorandum of
12 Points and Authorities in support of Plaintiffs' motion.

13 **III. MEMORANDUM OF POINTS AND AUTHORITIES**

14 **A. Introduction**

15 Plaintiffs Calcar, Inc. and American Calcar, Inc. (collectively "Calcar") seek to enforce
16 a third party deposition subpoena served on Dave Bagshaw ("Bagshaw"). Calcar is a plaintiff
17 in a trademark infringement case pending in the Central District of California. Calcar owns
18 United States Trademark Registration No. 2,419,611 (the "711 Registration") for the mark
19 CALCAR, Calcar has marketed, distributed and sold products under the CALCAR mark to the
20 automotive industry since 1994, including the "Auto Director," a device protected by United
21 States Patent No. 6,175,782 and incorporating visual display and conversion kit technology.

22 Defendants The California Cars Initiative ("TCCI") and Felix Kramer ("Kramer") have
23 adopted wholesale Calcar's registered mark CALCAR, adding the letter "s" to the mark and
24 then using it to provide and promote goods and services, including visual displays and
25 conversion kits, in which Calcar is engaged. TCCI also uses the registered domain name
26 <http://www.calcars.org>, which is confusingly similar to Calcar's domain name,
27 <http://www.calcar.net>. Bagshaw is a Senior Advisor of TCCI and is actively involved in
28 shaping key initiatives, including converting TCCI from a non-profit to for-profit organization.

1 Further, Bagshaw is identified in a large number of relevant documents produced by
2 Defendants. These documents include emails from Defendant Kramer directly to or copying
3 Bagshaw.

4 On May 23, 2008, Calcar personally served Bagshaw with a deposition subpoena and
5 notice for a deposition to take place on June 17, 2008 in San Francisco. On June 5, counsel for
6 Bagshaw wrote counsel for Calcar claiming: (1) improper service based on lack of personal
7 service and failure to provide witness or mileage fees; (2) Bagshaw's unavailability on June 17;
8 and, (3) lack of relevancy of Bagshaw's testimony. After Calcar's counsel provided proof of
9 personal service, flexibility in scheduling and information pointing to the relevance of
10 Bagshaw's testimony, Bagshaw's counsel continued to stonewall. Bagshaw did not appear for
11 his subpoenaed June 17 deposition and Bagshaw's counsel refused to provide alternate dates.
12 Prior to the deposition date, and, in fact to this day, Bagshaw never filed a motion to quash the
13 subpoena nor has he filed a motion for a protective order. Instead, a week after the passage of
14 the deposition date, Bagshaw's counsel, in a letter to Calcar's counsel, reasserted improper
15 service, lack of relevance and claimed Bagshaw's single objection without more excused his
16 refusal to comply with the subpoena. The letter from Bagshaw's counsel also justifies
17 Bagshaw's failure to comply with subpoena based upon false accusations regarding conduct by
18 Calcar's counsel during the deposition of another witness.

19 Bagshaw possesses information that will reasonably lead to the discovery of admissible
20 evidence, including, but not limited to, Defendants' use of the CALCAR mark, Defendants'
21 purported status as a "non-profit" (which Defendants have argued repeated somehow excuses
22 their conduct), selling and marketing of products including visual displays and conversion kits
23 and Defendants' efforts to partner with others in commercial enterprises.

24 **B. Factual Background**

25 On May 23, 2008, Calcar served Bagshaw with a subpoena issued from this Court for
26 deposition testimony. (Bleeker Decl. at Ex. A.) Calcar also served a check for witness fees
27 and mileage along with the subpoena. (*Id.*) Bagshaw remained silent for two weeks after being
28 served. (*Id.* at ¶ 4.) Finally, on June 5, 2008, Bagshaw's counsel sent a letter to Calcar's

1 counsel acknowledging the June 17 deposition date, but claiming improper service because
2 Calcar "sent" the subpoena to Bagshaw and "it appears that no witness fees or mileage fees
3 were provided with the subpoena." (*Id.*, Ex. B.) This is simply not true as Calcar *personally*
4 served Bagshaw and provided a check in the amount of \$83.80 for witness and mileage fees.
5 (*Id.*, Ex. A.)

6 In the June 5 letter, Bagshaw's counsel only offered a single objection "to the subpoena
7 on the grounds that it is unduly burdensome in light of the fact that Mr. Bagshaw does not
8 appear to have any relevant information." (*Id.*, Ex. B.) According to TCCI's own website,
9 Bagshaw joined TCCI sometime around December 2006. (*Id.*, Ex. C.) TCCI praised Bagshaw
10 because of his "stellar entrepreneurial, management and technical background" and touted that
11 Bagshaw "will be actively involved in shaping key initiatives of the non-profit start-up,
12 including possible organization of a spin-of [*sic*] for-profit company." (*Id.*) Bagshaw
13 maintains an email address with calcars.org in the address line. (*Id.*, Ex. D.) Further,
14 Bagshaw's name and picture appear in several locations on TCCI's website. (*Id.*, Ex. C.)
15 Defendants also produced documents that contained over 585 separate instances where
16 Bagshaw is mentioned by name. (*Id.* at ¶ 7.) These documents include emails from Defendant
17 Kramer directly to or copying Bagshaw in 2006 and 2007. (*Id.*, Ex. D.)

18 The June 5 letter from Bagshaw's counsel also asserted that Bagshaw would not be
19 available on June 17. (*Id.*, Ex. B.) Accommodating Bagshaw's purported unavailability, Calcar
20 responded on June 12 that it was "willing to consider alternate dates." (*Id.*, Ex. G.) When
21 Calcar attempted to ascertain whether Bagshaw would comply with the subpoena and appear at
22 the deposition, Bagshaw's counsel simply stated "Bagshaw will not be appearing on June 17."
23 (*Id.*, Ex. E.) Although Bagshaw's counsel claimed he would "respond in due course," he failed
24 to do so before the June 17 deposition date. (*Id.* ¶ 8, Ex. E.) Thus, the June 17 deposition date
25 passed without any action or communication from Bagshaw regarding his failure to comply
26 with the subpoena. On June 19, Calcar's counsel broached the subject of Bagshaw's availability
27 during a break in the deposition of Ronald Gremban, but Bagshaw's counsel still refused to
28 provide a date. (*Id.* at ¶ 9.) Finally, on June 23, ten days after Bagshaw's counsel stated he

1 would respond, Calcar's counsel sent an email to Bagshaw's counsel to see if Bagshaw would
2 comply with the subpoena and attend his deposition. (*Id.*, Ex. E.) Bagshaw's counsel finally
3 responded on June 24 in a letter that reasserts improper service, lack of relevance and claims
4 Bagshaw's single objection "satisfied all of [Bagshaw's] duties with regard to the subpoena."
5 (*Id.*, Ex. F.) In the June 24 letter, Bagshaw's counsel also justifies Bagshaw's his refusal to
6 comply with the subpoena based upon false accusations regarding conduct by Calcar's counsel
7 during the deposition of another witness. (*Id.* at ¶ 10, Ex. F.) The letter remains silent,
8 however, regarding numerous speaking objections during that deposition by Bagshaw's counsel
9 and also his claim of attorney client privilege regarding information shared with multiple third
10 parties. (*Id.* at ¶ 10.) Finally, Bagshaw's counsel asserts in the June 24 letter that "Mr.
11 Bagshaw will not voluntarily subject himself to that conduct and, for that additional reason,
12 declines your request that he appear for deposition." (*Id.*, Ex. F.)

13 **C. Bagshaw Has No Basis to Refuse to Comply with the Deposition Subpoena.**

14 Under Rule 45(a)(1), Calcar subpoenaed deposition testimony from Bagshaw. This
15 testimony meets the relevancy requirements of Rule 26(b)(1) in that the deposition topics
16 directly relate to the use and promotion of the infringing mark by TCCI and Kramer. The
17 inaccurate claims by Bagshaw's counsel regarding improper service and the single objection to
18 the subpoena fail to provide a basis to refuse compliance with the subpoena because "a
19 deposition subpoena may only be challenged by moving to quash or modify the subpoena
20 pursuant to Federal Rule of Civil Procedure 45(c)(3)(A), or by moving for a protective order
21 pursuant to Rule 26(c)." *Union Bank of California 401(k) Plan v. Hansen (In re Coan)*, 2007
22 U.S. Dist. LEXIS 6288, at *6 (N.D. Cal. Jan. 12, 2007) (finding "Subpoenaed Third Parties'
23 failure to appear for the noticed depositions is not excused merely by having served a written
24 objection to the subpoenas").

25 As explained below, Calcar is entitled to the requested discovery pursuant to Federal
26 Rule of Civil Procedure 30(a). In addition, the requested discovery is not overly burdensome
27 because the testimony sought relates to Bagshaw's own activities and knowledge of TCCI. Fed.
28 R. Civ. P. Rule 26(b)(2); *Nemirofsky v. Seok Ki Kim*, 523 F. Supp. 2d 998, 1000 (N.D. Cal.

1 2007) (balancing factors before compelling non-party deposition).

2 This Court properly has jurisdiction under Rule 37(a)(2) because the subpoena seeking
3 deposition testimony issued from this Court.

4 1. **Bagshaw's Testimony is Relevant to Plaintiff's Trademark**
5 **Infringement Claims.**

6 The key issue in any trademark infringement action is “the likelihood of confusion, *i.e.*,
7 whether the similarity of the marks is likely to confuse customers about the source of the
8 products.” *Brookfield Communs., Inc. v. West Coast Entm't Corp.*, 174 F.3d 1036, 1053 (9th
9 Cir. 1999) (citation omitted). In *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-349 (9th Cir.
10 1979), the Ninth Circuit provided the following, “non-exhaustive” list of factors that are
11 relevant in “determining whether confusion between related goods is likely”:

- 12 1. strength of the mark;
- 13 2. proximity of the goods;
- 14 3. similarity of the marks;
- 15 4. evidence of actual confusion;
- 16 5. marketing channels used;
- 17 6. type of goods and the degree of care likely to be exercised by
18 the purchaser;
- 19 7. defendant’s intent in selecting the mark; and
- 20 8. likelihood of expansion of the product lines.

21 In determining likelihood of confusion, courts within the Ninth Circuit typically apply
22 what has come to be known as the *Sleekcraft* test. *Mattel, Inc. v. MCA Records, Inc.*, 28 F.
23 Supp. 2d 1120, 1141 (C.D. Cal. 1998) (citations omitted), *aff'd*, 296 F.3d 894, *cert. denied*, 537
24 U.S. 1171 (2003); *see also, Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1140 (9th Cir.
25 2002) (noting the *Sleekcraft* test is intended to guide the court in determining likelihood of
26 confusion).

27 At the same time, courts have discouraged an overly mechanistic approach to
28 determining likelihood of confusion. Not all of the *Sleekcraft* factors have equal weight, and

1 not every factor will be at issue in every case. *See Thane Int'l, Inc. v. Trek Bicycle Corp.*, 305
2 F.3d 894, 901 (9th Cir. 2002).

3 Bagshaw's deposition testimony is relevant to at least five of the eight *Sleekcraft* factors
4 — proximity of the goods, evidence of actual confusion, marketing channels used, types of
5 goods and the degree of care likely to be exercised by the purchaser and likelihood of
6 expansion of the product lines. The over 580 identifications of Bagshaw in relevant documents
7 produced by Defendants indicates Bagshaw's intimate involvement with every aspect of TCCI.
8 As TCCI's Senior Advisor with technical and marketing expertise, Bagshaw's likely possession
9 of detailed knowledge regarding Defendants' visual display and conversion kit technology
10 similar to Calcar's patented Auto Director goods will provide evidence of the proximity of
11 those goods and the types of goods provided by Defendants that bear the infringing mark.
12 Further, Bagshaw's knowledge of Defendants marketing efforts will provide information on any
13 instances of actual confusion between the parties' goods, the different marketing channels used
14 by Defendants to provide its goods, the degree of care likely to be exercised by the purchaser
15 and Defendants' plans to expand its products lines. Thus, the relevant nature of the testimony
16 sought overcomes Bagshaw's single objection of unduly burdensome based on lack of
17 relevance.

18 Bagshaw's testimony is also relevant to TCCI's claims that it is purportedly not-for-
19 profit and can thereby be excused from infringing Calcar's mark. TCCI's own press release
20 upon hiring Bagshaw quotes Kramer praising Bagshaw's "stellar entrepreneurial, management
21 and technical background." Further, that same press release notes that Defendants desire to
22 employ Bagshaw arose from a need to have Bagshaw "actively involved in shaping key
23 initiatives of the non-profit start-up, including possible organization of a spin-of [*sic*] for-profit
24 company." (Bleeker Decl., Ex. C.) Documents produced by Defendants include emails from
25 Kramer directly to or copying Bagshaw and discussing the commercialization of TCCI.
26 (Bleeker Decl., Ex. D.) Defendants' own words show the importance and relevance of
27 Bagshaw's testimony to Calcar's claims.

28

1 2. **Bagshaw Never Filed a Motion to Quash or Modify the Subpoena.**

2
3 Rule 45(c)(3) provides that the only mechanism by which to challenge a deposition
4 subpoena is to file a motion to quash or modify the subpoena. Bagshaw did neither. Instead,
5 Bagshaw falsely claimed improper service and provided a single relevance objection before
6 utterly failing to respond to repeated requests from Calcar's counsel to provide a proposed date
7 for Bagshaw's deposition. When faced with the June 13 letter from Calcar's counsel,
8 Bagshaw's counsel stated he "will respond in due course." However, "[a] motion to quash or
9 modify must be made promptly, allowing it to be heard and granted before the scheduled
10 deposition." *Union Bank*, 2007 U.S. Dist. 2688, at *6 (quotations and citations omitted). With
11 the passage of the original deposition date, Bagshaw waived the right to bring either a motion
12 to quash or modify the subpoena. *See, e.g., Auto-Owners Ins. Co. v. Southeast Floating Docks,*
13 *Inc.*, 231 F.R.D. 426, 248 (M.D. Fla. 2005); *Estate of Ungar v. Palestinian Auth.*, 400 F.
14 *Supp.2d* 541, 554 (S.D.N.Y. 2005); *King v. Fidelity Nat'l Bank of Baton Rouge*, 712 F.2d 188,
15 191 (5th Cir. 1983); Rutter Cal. Practice Guide, Civil Proc. Before Trial, § 11:2286, 2288
16 (2008).

17 Bagshaw's only substantive response came a week after Bagshaw failed to attend his
18 deposition and that response claims "Mr. Bagshaw timely served objections on June 5 and,
19 therefore, satisfied all of his duties with regard to the subpoena." (Bleeker Decl., Ex. F.)
20 Apparently Bagshaw's counsel believes a witness may choose to comply with a subpoena or not
21 because he wrote that "Mr. Bagshaw . . . declines your request that he appear for deposition."
22 (*Id.*) In the letter Bagshaw's counsel complains about apparent misconduct by Calcar's counsel
23 during a prior deposition as an excuse to ignore a subpoena issued by this Court. (*Id.*) What
24 the letter does not state is that Bagshaw's counsel instructed the witness in the prior deposition
25 not to answer question based on attorney client privilege when the witness already testified to
26 giving that information to multiple third parties. If Bagshaw's counsel had legitimate concerns
27 about Calcar's counsel he could have asked for different Calcar counsel to attend the Bagshaw
28 deposition or sought the protection of this Court. In either case, Bagshaw's counsel chose to do

1 nothing while the deposition date passed. Therefore, Bagshaw waived any right to seek
2 protection under a motion to quash or a protective order.

3 **3. Bagshaw's Deposition Testimony is Proper Under Rule 26(b)**

4 Bagshaw's deposition testimony is permissible under the Federal and Local Rules.
5 Calcar's need to obtain deposition testimony from Bagshaw regarding information only
6 Bagshaw possesses outweighs the minimal inconvenience to Bagshaw from complying with the
7 subpoena. Bagshaw cannot be surprised that he might be called upon to provide deposition
8 testimony regarding Defendants after his years of involvement with Defendants. Bagshaw
9 chose to associate himself with Defendants and he cannot now disassociate himself from them.
10 After years working for or with Defendants, the burden on Bagshaw to provide deposition
11 testimony is minimal.

12 **4. Bagshaw Has Waived All Objections**

13 "[A] deposition subpoena may only be challenged by moving to quash or modify the
14 subpoena pursuant to Federal Rule of Civil Procedure 45(c)(3)(A), or by moving for a
15 protective order pursuant to Rule 26(c)." *Union Bank*, 2007 U.S. Dist. LEXIS 6288, at *6
16 (citing to 9-45 Moore's Federal Practice - Civil § 45.30 (2006)). Serving a single written
17 objection alone does nothing to preserve any objections or excuse Bagshaw's failure to comply
18 with the subpoena. *See Id.* at *5-*7 n.3. Moreover, "[a] motion to quash or modify 'must be
19 made promptly,' allowing it to 'be heard *and granted before* the scheduled deposition.'" *Id.* at
20 *5-*7 (citing to *The Rutter Group*, § 11:2288 (2006)) (emphasis in original). "A motion for
21 protective order ordinarily should be noticed at the earliest possible time and *certainly before*
22 the discovery procedure is set to occur." *Rutter Group* § 11:1162 (emphasis added).

23 Bagshaw has not only failed to file for a motion to quash or a protective order as early
24 as practicable, he never filed one at all. With nearly a month between service of the subpoena
25 and the noticed dated of deposition, Bagshaw had the opportunity to seek such protection as
26 early as practicable before the deposition date passed. Instead, Bagshaw's counsel spewed forth
27 false accusations of improper service along with a single objection before the deposition date
28 passed. When pressed by Calcar to engage in a meaningful exchange of proposed dates before

1 the June 17 deadline, Bagshaw's counsel simply refused to offer alternate dates for the
2 deposition. Bagshaw thus waived his single objection of unduly burdensome based on a lack of
3 relevance by failing to file for a motion to quash or a protective order before the June 17
4 deposition. Calcar's counsel, however, on June 23, offer Bagshaw an opportunity to comply
5 with the subpoena. Instead of working with Calcar's counsel, Bagshaw's counsel reiterated that
6 the his earlier letter "satisfies all of [Bagshaw's] duties with regard to the subpoena" and
7 therefore "Mr. Bagshaw . . . declines your request that he appear for deposition."

8 **IV. CONCLUSION**

9 Calcar's need for the important and relevant deposition testimony far outweighs any
10 inconvenience to Bagshaw. In light of Bagshaw's false accusations of improper service and
11 failure to comply with the subpoena or seek any form of protection from this Court, Calcar
12 respectfully requests this Court compel Bagshaw to provided deposition testimony.

13 DATED: June 26, 2008

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

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15
16 By 

Brian K. Brookey

Attorneys for Plaintiffs,
CALCAR, INC. and AMERICAN CALCAR,
INC.

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CERTIFICATE OF SERVICE

I hereby certify that on June 26, 2008 I electronically filed the document described as PLAINTIFFS' NOTICE OF MOTION AND MOTION TO COMPEL DEPOSITION TESTIMONY OF THIRD PARTY DAVE BAGSHAW with the Clerk of the Court using the ECF system which will send notification of such filing to the parties. I further certify that I have served a true copy of the paper via electronic mail to the non-ECF participants as follows:

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