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TTAB

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

PIONEER KABUSHIKI KAISHA dba PIONEER)	)	Opposition No: 91125458
CORPORATION,	)	Mark: SUPERSCAN ELITE
	)	Serial No.: 76/208230
Opposer,	)	Published: March 19, 2002
	)	
v.	)	(1) MEMORANDUM OF POINTS AND
	)	AUTHORITIES IN SUPPORT OF
NISSEI SANGYO AMERICA, LTD.,	)	OPPOSER'S OPPOSITION TO
	)	APPLICANT'S MOTION TO COMPEL
Applicant.	)	PRODUCTION OF SURVEY DOCUMENTS;
	)	
	)	(2) DECLARATION OF ROBERT
	)	SKOUSEN; and
	)	
	)	(3) DECLARATION OF MARK GNESIN.

Assistant Commissioner For Trademarks  
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07-27-2004  
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PIONEER'S OPPOSITION TO MOTION TO COMPEL PRODUCTION OF SURVEY  
DOCUMENTS

I.

PRELIMINARY STATEMENT

In its motion, Applicant is seeking to compel the production of documents from Opposer PIONEER Corporation ("PIONEER") that Applicant's lawyer failed to properly subpoena from a nonparty as required by Federal Rules of Civil Procedure 34 and 45.

Realizing his error and attempting to circumvent the discovery cut-off (which has now passed), applicant has brought the current motion to compel production of Survey Documents, generated by nonparty Robert Klein in the course of the survey, which he conducted in connection with this inter partes proceeding.

Significantly, Applicant's lawyer specifically sought "copies of all documents in the custody or control of Mr. Klein or his firm." Applicant's Exhibit 5. Nevertheless, Applicant's lawyer never served a subpoena on Mr. Klein to obtain these documents. Accordingly, Applicant's motion to compel should be denied.

As set forth in greater detail below, Applicant's counsel failed to properly serve a Subpoena Duces Tecum on Mr. Klein to obtain his file materials at the time of his deposition, taken by Applicant's counsel, on May 20, 2004. Thereafter, Applicant's counsel made an informal letter request for production of these documents on the last day of the discovery period - 4 hours before discovery closed. Nevertheless, these documents belong to

PIONEER'S expert, Robert Klein, and were not possessed by PIONEER. Skousen Decl. ¶¶ 8-11.

The applicable Federal Rules of Civil Procedure and the cases interpreting those requirements clearly set forth the proper methods for obtaining such documents. For reasons known only to Applicant's lawyer, he chose not to comply with those requirements. Such a failure does not constitute good cause or justification, in any form, for this Board to order PIONEER to produce documents, none of which are in possession of PIONEER. The moving papers do not set forth any evidence or justifiable grounds to support the granting of this motion. Applicant's motion is without merit and should be denied.

## II.

### FACTUAL AND PROCEDURAL HISTORY

This litigation involves PIONEER's opposition to Hitachi High Technologies America, Inc's. ("Applicant" or "HHTA") attempt to register the trademark "SUPERSCAN ELITE" for consumer electronics. In preparation of its opposition, PIONEER retained market survey research expert Robert Klein. Mr. Klein designed and fielded a survey to determine the likelihood of confusion that would result if this Board were to grant Applicant's registration application and allow it to register the mark SUPERSCAN ELITE, which closely resembles PIONEER's mark ELITE.

By letter of April 28, 2004, PIONEER identified expert Robert Klein as a survey expert who had performed a survey in connection with this case and would be prepared to testify as to the results of the survey regarding likelihood of confusion and actual confusion between PIONEER's mark and Hitachi's proposed mark. At that time, PIONEER offered several dates for the deposition of Mr. Klein prior to the discovery cut-off date of May 30, 2004. By mutual agreement, the date of May 20, 2004 was chosen. The report of Mr. Klein was sent to applicant's counsel by PIONEER on May 4, 2004. A true and correct copy of Mr. Klein's report and attachments, sent to applicant's counsel, is attached hereto as Exhibit "A."

On May 10, 2004, applicant's counsel, Evan Brown, sent out a notice of deposition of Mr. Klein (a true and correct copy of which deposition notice is attached hereto as Exhibit "B"). It indicated only the date and place of the deposition of Mr. Klein. There was no request for documents of any kind attached to the notice of deposition. Moreover, at no time prior to the taking of the deposition of Mr. Klein did applicant's counsel ever serve Mr. Klein with a subpoena to require him to bring any additional records with him to the deposition. This basic and essential procedural failure is fatal to applicant's motion.

III.

ARGUMENT

A. TO OBTAIN DOCUMENTS FROM A NONPARTY TO THE LITIGATION, A PROPER SUBPOENA MUST BE ISSUED AND SERVED TO COMPEL PRODUCTION OF THE DOCUMENTS

In this motion, applicant's counsel is seeking production of certain data obtained and prepared by PIONEER's survey expert Robert Klein in connection with the report he prepared in connection with the survey that he performed in this case. **The report, which summarizes the results of those requested documents, is currently in the possession of applicant's counsel and has been in their possession since May 4, 2004.**

Indeed, PIONEER previously produced this report in response to Applicant's rule 34 request. There is no question that Mr. Klein is **not a party** to this litigation. The proper manner to obtain documents from a nonparty, is by way of Subpoena Duces Tecum. In this instance, that is governed by Federal Rule of Civil Procedure 45, which provides:

"Every subpoena shall . . . (C) command each person to whom it is directed to attend and give testimony or to produce and permit inspection and copying of designated books, documents or tangible things in the possession, custody or control of that

person, or to permit inspection of premises,  
at a time and place therein specified..."

Fed. R. Civ. Proc. 45.

The commentary to Federal Rule of Civil Procedure 45 makes clear that its primary application is to nonparties. In section C45-1, *Introduction to Practice Commentaries*, following the text of Federal Rule of Civil Procedure 45, Commentator David Siegel notes that only a Rule 45 subpoena can be used to obtain documents from a nonparty: "Rule 34, for example in requiring production of documents and other tangibles, **applies only against a party. It is Rule 45 that must be turned to when those things are sought from a nonparty.**" (emphasis added). D. Siegel, *Commentary to Rule 45, 45-1* (West 2004). (Gnesin Decl. Exh. D.)

There is no question that to obtain documents from a nonparty, that nonparty must be served with a subpoena for the production of those documents. It is equally clear that no subpoena was ever served on Mr. Klein to obtain those documents. The service of the subpoena, on Mr. Klein - a nonparty, was a procedural prerequisite to the granting of a motion to compel production of the documents from him - which documents are currently in his possession and not in PIONEER's possession.

B. CASES INTERPRETING THE PROCEDURAL REQUIREMENTS FOR OBTAINING DOCUMENTS FROM A TRIAL EXPERT'S FILES, UNEQUIVOCALLY HOLD THAT SUCH DOCUMENTS MUST BE SUBPOENAED

It is well settled that there are "three major provisions in the federal rules pertaining to requests and orders for production of documents. Two of them, Rule 34 and Rule 30(b)(5) apply **only** to parties to the action. **If the person is a non-party, production of documents can be compelled only by a subpoena duces tecum issued under Rule 45(d)(1).**" *Fisher v. Marubeni Cotton Corp.*, 526 F.2d 1338, 1341 (8<sup>th</sup> Cir. 1975) (emphasis added) (reversing contempt citation for failure to produce documents).

Moreover, Wright, Miller & Marcus, one of the most respected treatise on federal procedure, concurs and reiterates the rule that to obtain documents from a nonparty, one must serve a subpoena on that nonparty:

The procedure for compelling production of documents at a deposition depends on whether the deponent is or is not a party. **If the deponent is not a party, production of the documents can be compelled only by a subpoena duces tecum issued under Rule 45.** As amended in 1991, Rule 45(a)(1)(C) now authorizes a

subpoena to command production of documents at a deposition or without a deposition. If the production is to occur at a deposition, the designation of the materials to be produced pursuant to the subpoena must be attached to or included in the notice of the deposition. If the production is to occur without a deposition, Rule 45(b)(1) requires that prior notice be given to the other parties.

8A Charles Alan Wright, Arthur R. Miller & Richard L. Marcus, *Federal Practice and Procedure* § 2108 (2d Ed. West 2004) (emphasis added) (footnotes omitted).

The courts have repeatedly applied this rule to deny motions to compel documents. Thus, if a party fails to subpoena documents from a nonparty, he cannot hope to obtain them from the party that does not have them. This rule naturally applies to nonparty experts. For example, in *Smith v. Transducer Technology Inc.*, No. Civ.1995/28, 2000 WL 1739217 (D.V.I. May 19, 2000) (Gnesin Decl. Exh. E.), the district court considered the very issue present in this case. The court considered whether a nonparty expert's

documents must be produced pursuant to a notice of deposition (Fed. R. Civ. P. 30 (b))

(5)). Defendant argues that production of documents from nonparties may only be compelled by subpoena duces tecum (Fed. R. Civ. P. 45(a) (1) (c)). Plaintiff retorts that subpoenas may not be issued to an opponent's retained witness pursuant to "Rule 26."

*Id.* at 1.

The court rejected the contention that documents could be obtained from a nonparty expert without the issuance and service of subpoena pursuant to FRCP Rule 45:

The procedure for compelling production of documents at a deposition depends on whether the deponent is or is not a party. If the deponent is not a party, **production of the documents can be compelled only by a subpoena duces tecum issued under Rule 45.**

*Id.* (emphasis added).

The court also specifically rejected the contention by the movant that "previously issued equivalent notices for production," required the court to grant the motion to compel the materials expert's documents. *Id.* at 2. In fact, the court observed that these notices were completely ineffective. This conclusion represents a complete repudiation of Applicant's

position in this matter. Applicant relies solely on its Rule 34 production request. This is insufficient.

Indeed, as recently as this year, in *Expeditors International of Washington Inc. v. Vastera Inc.*, No. 04 C 0321, 2004 WL 406999 (N.D. Ill. Feb. 26, 2004) (Gnesin Decl. Exh. F.), the movant made the very same argument that Applicant advances: "a document discovery regarding a party's testifying expert must proceed against that party under Rule 26 and the appropriate provisions of Rule 34, not through the use of a subpoena *duces tecum* directed to the expert under Rule 45." *Id.* at 3. The court rejected this argument, writing that a subpoena *duces tecum* issued pursuant to Rule 45 is an appropriate discovery mechanism against nonparties **such as a party's expert witness.**" *Id.* (emphasis added).

Finally, in *All West Pet Supply Co. v. Hill's Pet Products Div.* 152 F.R.D. 634 (D. Kan. 1993) (denying motion to compel production of expert's documents), the court considered defendant's motion for an order to compel the plaintiff's expert to produce certain documents and information related to the opinion testimony of plaintiff's expert witness. In denying defendant's motion to compel, the court stated:

**With regard to nonparties such as plaintiff's expert witness, a request for documents may be made by subpoena *duces tecum* pursuant to Rule 45. The defendants do not**

refute plaintiff's contention that **no subpoena duces tecum was submitted to plaintiff's expert requesting production of the reports, depositions, and transcripts in question.** Assuming they did not do so, Purinton's counsel had no opportunity to formally object to the defendants' request as envisioned by the provisions of *Fed.R. Civ. P. 45(c)(2)(B)*, which permits the recipient of a subpoena to serve a written objection and thereby avoid the subpoena except upon order of the issuing court. **The defendants have simply not followed the applicable procedural rules for obtaining these documents from Purinton as a deponent."**

*Id.* at 639-40 (emphasis added).

Moreover, the *All West* court noted that "the defendants do not even assert that the plaintiff has possession of any of the requested materials, which were prepared by Purinton, plaintiff's expert witness." *Id.* at 639. Thus, there never was any basis for obtaining the documents directly from the party.

The *All West* case is particularly relevant to the instant case in terms of the points that it established. First, it established that a party's expert witness is a nonparty for the purpose of obtaining documents from him, other than those required to be provided by a party pursuant to Federal Rule of Civil Procedure 26. Second, it established that the proper method for obtaining those documents from a nonparty witness was

by service of a subpoena duces tecum as provided in Federal Rule of Civil Procedure 45. Third, and perhaps most importantly, the case established that the failure to serve the appropriate subpoena duces tecum to obtain documents from a nonparty witness pursuant to Federal Rule of Civil Procedure 45 **was an appropriate and established ground for denial of a subsequent motion to compel production of documents.**

The facts of the instant case are strikingly similar to the facts of the *All West* case. Both instances involve a situation where one party seeks to obtain documents from the opposing party's retained trial expert. In both instances, the subject expert prepared a report which was provided to the requesting party prior to deposition of the expert. In both instances, the requesting party failed to serve a subpoena duces tecum to obtain additional documents, pursuant to Federal Rule of Civil Procedure 45, on the expert so as to compel him to produce additional documents at his deposition. The *All West* court correctly reasoned that the moving party defendants had failed to follow the appropriate procedural requirements to obtain the documents in issue and denied their motion to compel for their basic failure to follow the correct procedural steps - service of a subpoena duces tecum on the expert pursuant to Rule 45. In this case, as in the *All West* case, this court should follow that

precedent and summarily deny Applicant's motion to compel production of documents for the same basic reason.

C. PIONEER HAS COMPLIED WITH FRCP 26(a)(2) EVEN THOUGH THIS IS NOT REQUIRED UNDER TTAB PROCEDURE

Federal Rule of Civil Procedure 26 (a)(2)(B) sets forth the requirements for the disclosure, by a party, of the written documents prepared by a witness who is specially employed to provide expert testimony in a case:

Except as otherwise stipulated or directed by the court, this disclosure shall, with respect to a witness who is retained or specially employed to provide expert testimony in the case or whose duties as an employee of the party regularly involve giving expert testimony, be accompanied by a written report prepared and signed by the witness. The report shall contain a complete statement of all opinions to be expressed and the basis and reasons therefor; the data or other information considered by the witness in forming the opinions; any exhibits to be used as a summary of or support for the opinions; the qualifications of the witness, including a list of all publications authored by the witness within the preceding ten years; the compensation to be paid for the study and testimony; and a listing of any other cases in which the witness has

testified as an expert at trial or by deposition within the preceding four years.

Fed. R. Civ. Proc. 26(a)(2)(B).

As is more fully set forth in the Declaration of Robert J. Skousen, such a report was provided to opposing counsel. Without reiterating the entire substance of the report, it provided the following information:

1. A complete statement of all Mr. Klein's opinions, the basis and reasons therefor;
2. The data and other information considered by Mr. Klein in forming his opinions;
3. Mr. Klein's qualifications as an expert witness, including a list of all publications authored by him within the preceding ten years;
4. The compensation paid Mr. Klein for his work in this case;
5. A listing of other cases in which Mr. Klein participated as an expert within the preceding four years;
6. Mr. Klein's current Curriculum Vitae;
7. A list of the materials considered by Mr. Klein in connection with this case;
8. The names and addresses of the five separate shopping malls where the interviewing was conducted;

9. Copies of instructions provided to interviewers and supervisors in connection with this study;

10. Copies of the screening questionnaire and main questionnaire used in this study;

11. A tabulation of the participants in the study classified by age and gender;

12. A tabulation of the demographics involved in the study;

13. Pages from the Fall 2003 Elite catalog used in the study.

PIONEER produced all of the documents required of it and fully complied with the requirements of Federal Rule of Civil Procedure section 26 (a) (2) (B), even though under TTAB procedure (as explained below) mandatory disclosure is not required. After receiving this report, applicant did absolutely nothing to pursue getting any other documents from the nonparty expert. On this additional basis, Applicant's motion to compel production of survey documents should be denied as well.

**D. PIONEER COMPLIED WITH ITS DISCOVERY OBLIGATIONS UNDER THE FEDERAL RULES OF CIVIL PROCEDURE EVEN THOUGH IT WAS NOT REQUIRED TO DO SO IN THIS INTER PARTES PROCEEDING**

Title 37 of the Code of Federal Regulations governs the applicable procedures in Inter Partes proceedings before this board. 37 C.F.R. 2.120 specifically deals with the rules applicable to discovery. 37 C.F.R. 2.120 (a) describes discovery

rules for proceedings before the Board generally, stating in relevant part:

Whenever appropriate, the provisions of the Federal Rules of Civil Procedure relating to discovery shall apply in opposition, cancellation, interference and concurrent use registration proceedings except as otherwise provided in this section. **The provisions of the Federal Rules of Civil Procedure relating to automatic disclosure ...are not applicable to Board proceedings."**

37 C.F.R. 2.120(a) (West 2004) (emphasis added).

Thus, the automatic disclosure requirements of the Federal Rules of Civil Procedure do not apply to Board proceedings. Despite that provision, PIONEER complied with those obligations anyway. In complying with its obligations regarding the production of the expert report, it should be noted that the exact information, which Applicant's counsel now seeks, is provided there in summary form.

Not unexpectedly, Applicant's counsel fails to mention that salient fact in his moving papers. Nevertheless, applicant's failure does not justify the granting of Applicant's motion to compel production of survey documents when it has failed to comply with the long established and well known requirement of serving a subpoena duces tecum (under Rule 45) on a nonparty expert witness to obtain documents within his file. That is

especially true here where all documents and information required to be provided by the expert, his opinions and the basis of those opinions, had previously been provided to Applicant's counsel in advance of the expert's deposition.

**E. THE CASES, CITED AND RELIED UPON BY APPLICANT'S COUNSEL  
IN THIS MOTION, ARE DISTINGUISHABLE AND SINGULARLY  
INAPPOSITE TO THE ISSUES HEREIN**

As support for its motion, Applicant's counsel cites an amazing array of cases that are not applicable to the issues in this motion. To fully understand the completely disingenuous and misleading nature of this motion, an analysis of those cases is necessary. The first case cited by applicant's counsel is *Quadrini v. Sikorsky Aircraft Division*, 74 F.R.D. 594 (D. Conn. 1977). In that case, defendants propounded a request for production of documents, pursuant to Federal Rule of Civil Procedure 34, to plaintiff for expert reports and documents. The court granted the motion to compel production of the documents. However, that case is distinguishable from the case at bar in that the court ruling was based on a pre 1993 version of Federal Rule of Civil Procedure 26 which: 1) did not require the pre-deposition production of an expert report as currently required under Rule 26(a)(2)(B); and 2) Pursuant to old subparagraph (b)(4)(A)(ii) of Rule 26 (no longer a part of the current Rule 26), the court had discretion to order further expert discovery

as the court deemed appropriate. In *Quadrini*, the court based its ruling on the provisions of old Federal Rule of Civil Procedure 26 (b) (4) (A) (ii) and the fact that Plaintiff's counsel apparently had possession of the documents. Such a situation would be dealt with quite differently today under Rule 26. That treatment would also be different as a result of the 1991 amendment to Rule 34, which reflected the change to Rule 45 to provide for the use of subpoenas to compel nonparties (such as a party's expert) to produce documents. In fact, the language of Rule 34(c) specifically states that a "person not a party to the action may be compelled to produce documents and things or to submit to an inspection as provided in Rule 45." Fed. R. Civ. Proc. 34(c). Counsel's reliance on this case is not only inapposite, it is patently misleading to this Board. Such conduct should not be condoned.

Next, counsel cites the case of *In re Air Crash Disaster*, 720 F. Supp. 1442 (D. Colo. 1988). In that case, defendants noticed the depositions of two of plaintiffs' experts and included requests for production of various documents possessed by the experts in deposition notices pursuant to Federal Rule of Civil Procedure 30. That case is factually distinguishable from the case at bar because Applicant's counsel never sent any request of any kind for production of documents in connection with the notice of deposition of Mr. Klein.

Counsel next cites the case of *Mushroom Associates v. Monterey Mushrooms Inc.*, 25 U.S.P.Q. 2d 1304 (N.D. Cal. 1992). That case dealt with the discoverability of the work product of a patent attorney who had been named as an expert witness by one party. It is further noted that this decision was made in the context of a motion to compel production of documents and a motion to compel further answers to interrogatories. As to the plaintiff's motion to compel production of documents in that case, it is not applicable to the instant matter because the request for production of documents was directed to a party (who allegedly had the documents in his possession) not a nonparty as in the instant case.

The same is true of defendant's motion to compel further answers to interrogatories - i.e. that it was directed to a party, not a nonparty. The last motion considered in that case was defendant's motion to compel production of documents which plaintiff's expert had potential access to but did not in fact consider. None of these motions are, in any way, analogous to the factual context in which the instant matter is being considered. Furthermore, PIONEER does not dispute the general proposition that documents, upon which an expert relies in forming his opinions, are discoverable. **However, the documents must be requested in the procedurally correct manner. That was not done by Applicant's counsel in the instant case.** This cited

case does nothing to support Applicant's request to compel production of documents.

Counsel next cites the case of *Vaughan Furniture Co. v. Featureline Mfg. Inc.*, 156 F.R.D. 123 (M.D.N.C. 1994) for the proposition that "when a party names its attorney as an expert witness, the witness must produce all documents considered by him or her in the process of formulating an expert opinion, including documents containing the attorney's opinions." That case is easily distinguishable from the instant situation for multiple reasons. In the instant case, there is no issue whatsoever regarding any application of the Attorney-Client or Attorney/work product privilege to the documents in question. More importantly, in *Vaughan Furniture Co.*, the requesting party served subpoenas (under Rule 45) to obtain the documents sought - which was the proper procedure to be followed in obtaining those documents but which was not done by Applicant's counsel in this case. If anything, *Vaughan Furniture Co.* is a case that supports PIONEER's contention that if documents are sought from an expert (a nonparty), they must be subpoenaed pursuant to Federal Rule of Civil Procedure 45.

The last two cases, cited by applicant's counsel, may be discussed together. Counsel relies on the cases of *B.C.F. Oil Refining, Inc. v. Consolidated Edison Co.*, 171 F.R.D. 57 (S.D.N.Y. 1997) and *Hager v. Bluefield Regional Medical Cent.*

Inc., 170 F.R.D. 70 (D. D.C. 1997) for the proposition that the documents, at issue in this motion, are not protected by the attorney/work product or attorney-client privilege. These cases may be summarily dealt with by pointing out that PIONEER has never taken the position that either one of those privileges applies to the documents at issue here.

Applicant's counsel knows this well. In fact, Mark Gnesin of Skousen & Skousen wrote a letter to Applicant's counsel advising him of the basis of the refusal to produce the documents - i.e. that Applicant's counsel had failed to properly subpoena the documents in question pursuant to Federal Rule of Civil Procedure 45. A true and correct copy of that letter is attached hereto as Exhibit "C". Counsel has merely adopted the tactic of "raising a strawman in order to knock him down." This is simply further evidence of applicant's lawyer's failure to follow proper discovery practice in this inter partes proceeding.

F. APPLICANT'S COUNSEL HAS COMPLETELY FAILED TO SHOW ANY REASON WHATSOEVER AS TO WHY HE SHOULD BE EXCUSED FROM COMPLIANCE WITH THE REQUIREMENT FOR SERVING A RULE 45 SUBPOENA ON PIONEER'S NONPARTY EXPERT WITNESS TO OBTAIN DOCUMENTS IN HIS POSSESSION

The request for the specific documents sought herein is enumerated in Applicant's Exhibit 5 to their motion. Applicant's

lawyer, in his correspondence of May 28, 2004 to Mr. Skousen, states:

"On a related issue, Mr. Klein testified to the existence of various documents which should have been produced but have not been. (See Klein Dep. 81-83, 87). I would ask that **you immediately produce copies of all documents in the custody or control of Mr. Klein or his firm** relating to the survey he performed, including, but not limited to the data print-outs (p. 87), the completed questionnaires and screeners (p. 81-83), and the validation documents and tally sheets (p. 87)."

This letter points out the central problems with applicant's motion herein. It demonstrates that Applicant's lawyer did nothing, prior to taking the deposition of Mr. Klein on May 20, 2004, to ensure that Mr. Klein would appear for his deposition **with documents in his possession**. It is clear, from his letter, that Applicant's lawyer knew these documents were in the possession, custody and control of Mr. Klein in Boston, Massachusetts - not possessed by PIONEER.

It should also be noted that even after learning of the existence of the documents, Applicant's lawyer did nothing (for eight days), until the afternoon of the last day of the discovery period, to attempt to get those documents. Applicant's lawyer's

informal letter request for the documents was properly refused at that point.

Without reiterating the entirety of the case law supporting PIONEER's position and demonstrating the completely untenable approach taken by applicant's counsel, it is abundantly clear that the proper way for Applicant's lawyer to have obtained the subject documents was to subpoena them directly from Mr. Klein as provided for in *Federal Rule of Civil Procedure 45*. He did not do so. His unexcused failure to comply with that procedure is fatal to his motion.

All of the relevant case law unequivocally sets forth the requirement that to obtain documents in the possession of a non-party expert witness, the proper subpoena must be served on the expert in accordance with the Federal Rules of Civil Procedure. There is no provision to compel a party's attorney to produce documents generated by an expert where the documents are in the possession of the expert. Such a proposition flies in the face of *Federal Rules of Civil Procedure 34(c) and 45* as well as all of the cases dealing with that procedural question. Applicant's lawyer does not offer nor can he even articulate an explanation of how or why he should be excused from compliance with the applicable federal rules herein. There is no such explanation. This motion has no proper basis in law, is patently without merit and should be denied.

IV.

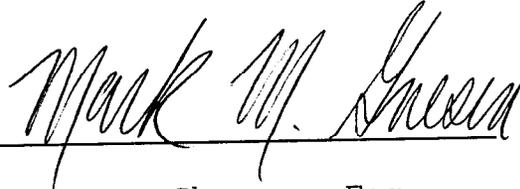
CONCLUSION

For all of the foregoing reasons, it is respectfully requested that applicant's motion to compel production of survey documents, in the possession of PIONEER's expert Robert Klein, be denied based on applicant's failure to comply with the established requirements of Federal Rules of Civil Procedure 34 and 45. It is further requested that this Board issue an appropriate sanction against applicant, dismissing their registration application with prejudice, to deter their ongoing and long-standing pattern of obstructionist discovery tactics.

Dated: July 27, 2004

SKOUSEN & SKOUSEN

A Professional Corporation

By: 

Robert James Skousen, Esq.  
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DECLARATION OF ROBERT JAMES SKOUSEN

I, Robert James Skousen, certify as follows:

1. I am one of the attorneys for the Opposer, Pioneer Kabushiki Kaisha dba Pioneer Corporation, in the above-captioned opposition now pending before the Trademark Trial and Appeal Board as Opposition Number 125,458.

2. I make this declaration in opposition to Applicant's Motion to compel production of survey documents.

3. By correspondence of April 28, 2004, I provided written notice to applicant counsel William McGrath that I had retained and would be using Mr. Robert Klein as a survey expert regarding likelihood of confusion and actual confusion involving the SUPERSCAN ELITE mark.

4. By correspondence of May 4, 2004, I sent a copy of Mr. Klein's survey report and all attachments to Mr. McGrath. A true and correct copy of Mr. Klein's report and its attachments, which I sent to Mr. McGrath, is attached hereto as Exhibit "A."

5. On May 10, 2004, Applicant counsel sent me a facsimile copy of the notice of Deposition of Robert Klein. A true and correct copy of the notice of deposition of Robert Klein is attached hereto as Exhibit "B". As can be seen from a review of the Deposition notice, no document request of any kind was attached to the deposition notice. At no time prior to the actual deposition of Robert Klein, taken by Mr. McGrath, on May

20, 2004, was any subpoena duces tecum served on Mr. Klein to compel him to bring any additional documents to his deposition.

6. On May 20, 2004, I was present in Boston, Massachusetts to attend the deposition of Robert Klein. The deposition was taken by applicant counsel William McGrath. At no time, prior to the commencement of that deposition, did Mr. McGrath indicate that he did not wish to proceed with the deposition of Mr. Klein because Mr McGrath did not have any of the documents. The deposition proceeded as scheduled.

7. During the deposition, Mr. McGrath questioned Mr. Klein regarding the data print-outs, completed questionnaires and screeners, validation documents and tally sheets. At no time during the deposition did Mr. McGrath request the production of those documents. At no time during the deposition did Mr. McGrath seek to adjourn the deposition to obtain the documents which he now seeks. At no time during the deposition did Mr. McGrath reserve his right to continue the deposition or have a second session of the deposition following the obtaining of those documents. In fact, it took Mr. McGrath eight days to put together a two paragraph letter (applicant's Exhibit 5 to their motion) informally requesting the documents. It was then faxed to my office approximately 4 hours prior to the close of the discovery period.

8. At no time have I ever had possession, custody or

control of the documents referred to, by Mr. Klein in his deposition, as completed questionnaires and screeners.

9. At no time have I ever had possession, custody or control of the documents referred to, by Mr. Klein in his deposition, as validation documents.

10. At no time have I ever had possession, custody or control of the documents referred to, by Mr. Klein in his deposition, as tally sheets.

11. With regard to the 1 page data print-out sheet, this was first provided to me by Mr. Klein in Boston, Massachusetts on May 19, 2004 - the day before his deposition was taken. That document has been returned to Mr. Klein and is not in my possession, custody or control.

I declare under the penalty of perjury under the laws of the United States that the foregoing statements are true to the best of my knowledge, information, and belief.

Executed this 26<sup>th</sup> day of July 2004 at Los Angeles, California.

  
Robert James Skousen

DECLARATION OF MARK GNESIN

I, Mark Gnesin, declare as follows:

1. I am one of the attorneys for the Opposer, Pioneer Kabushiki Kaisha dba Pioneer Corporation, in the above-captioned opposition now pending before the Trademark Trial and Appeal Board.

2. I make this declaration in opposition to Applicant's motion to compel production of survey documents.

3. On or about June 14, 2004, I reviewed Mr. Mcgrath's letter of that date to Robert Skousen.

4. On or about June 15, 2004, I faxed my written reply to Mr. McGrath's letter of June 14, 2004. A true and correct copy of my reply correspondence is attached hereto as Exhibit "C."

5. I have attached to my declaration true and correct copies of the following documents:

a. Exhibit "D": D. Siegel, Commentary to Rule 45, 45-1 (West 2004);

b. Exhibit "E": *Smith v. Transducer Technology Inc.*, No. Civ.1995/28, 2000 WL 1739217 (D. V.I. May 19, 2000); and

c. Exhibit "F": *Expeditors International of Washington Inc. v. Vastera Inc.*, No. 04 C 0321, 2004 WL 406999 (N.D. Ill. Feb. 26, 2004).

I declare under the penalty of perjury under the laws of the United States that the foregoing statements are true to

DECLARATION OF MARK GNESIN

I, Mark Gnesin, declare as follows:

1. I am one of the attorneys for the Opposer, Pioneer Kabushiki Kaisha dba Pioneer Corporation, in the above-captioned opposition now pending before the Trademark Trial and Appeal Board.

2. I make this declaration in opposition to Applicant's motion to compel production of survey documents.

3. On or about June 14, 2004, I reviewed Mr. Mcgrath's letter of that date to Robert Skousen.

4. On or about June 15, 2004, I faxed my written reply to Mr. McGrath's letter of June 14, 2004. A true and correct copy of my reply correspondence is attached hereto as Exhibit "C."

5. I have attached to my declaration true and correct copies of the following documents:

a. Exhibit "D": D. Siegel, Commentary to Rule 45, 45-1 (West 2004);

b. Exhibit "E": *Smith v. Transducer Technology Inc.*, No. Civ.1995/28, 2000 WL 1739217 (D. V.I. May 19, 2000); and

c. Exhibit "F": *Expeditors International of Washington Inc. v. Vastera Inc.*, No. 04 C 0321, 2004 WL 406999 (N.D. Ill. Feb. 26, 2004).

I declare under the penalty of perjury under the laws of the United States that the foregoing statements are true to

the best of my knowledge, information, and belief.

Executed this 26<sup>th</sup> day of July 2004 at San Bernardino,  
California.

  
\_\_\_\_\_  
Mark Gnesin



Report of Robert L. Klein

in the matter of

Pioneer Corporation

v.

Hitachi High Technologies America

TTAB Opposition No. 125,458

## **Confusion Survey Results and Conclusions**

May 19, 2004

Applied Marketing Science, Inc.  
303 Wyman Street, Suite 205  
Waltham, MA 02451

## Qualifications

1. My name is Robert L. Klein and I am president and co-founder of Applied Marketing Science, Inc., a fifteen year old market research and marketing consulting firm located in Waltham, Massachusetts (suburban Boston.)
2. I have been a professional market researcher for over thirty years. I graduated from the Massachusetts Institute of Technology with a Bachelor of Science degree in 1966 and from the MIT Sloan School of Management with a Master of Science degree in 1968. Following a two-year tour of duty as a commissioned officer in the U.S. Public Health Service, I joined two of my former professors in 1970 as the second fulltime employee of Management Decision Systems, Inc. ("MDS") Over the next 15 years I designed, conducted and analyzed market research surveys for some of the largest companies in the U.S. including Coca-Cola, Nabisco, General Foods, Johnson's Wax, Ford, Gillette, Colgate, Oscar Mayer, Carnation, Pfizer, Dow Chemical, Miles Laboratories and many others. These surveys were used to support multi-million dollar marketing and product development decisions. Over this time MDS grew to employ over 250 people with offices around the world. At various times, MDS was listed as one of the fastest growing companies in the U.S. by *Inc. Magazine* and as one of the 25 largest market research companies in the U.S. by *Advertising Age*. In 1985, Information Resources, Inc. (IRI), then the 4th largest market research company in the world, acquired MDS and I became an Executive Vice President. I continued to design, conduct and analyze market research surveys for customers companies including General Motors, Hallmark, Chase Manhattan Bank, and others. In 1989 I left IRI to found Applied Marketing Science, Inc. (AMS) with an MIT professor and a former client as my partners. At AMS, I continued to design, conduct, and analyze market research surveys related to product development and customer satisfaction for a number of companies including American Airlines, Eastman Kodak, Xerox, General Cinema, Intuit, Pella, Polaroid, U.S. West, and many others. My C.V. is attached as Exhibit A of this report.
3. A number of times in the past three years, I have been asked to conduct market research in support of litigation and to provide criticism and rebuttal for expert reports involving surveys submitted by other experts. The cases in which I have submitted such reports or testimony are shown on my C.V. The surveys I have conducted in these matters have related to:
  - customer perceptions and beliefs regarding insurance policies,
  - secondary meaning and customer confusion related to continuing education catalogs,
  - secondary meaning related to the product design of automobile aftermarket equipment
  - automobile purchase behavior under alternative scenarios
  - the impact of false competitive rumors on business customer purchase plans

- confusion as to the sponsorship or approval of websites promoting group outings
- the extent of business lost as a result of specific competition

I have testified in Federal Court as an expert on survey research to rebut a confusion survey proffered by the other side in a trade dress confusion case and to present the results of two surveys related to Lanham Act and copyright infringement.

4. In addition to my role as a testifying expert, I have been involved along with others at AMS with the design, execution and analysis of surveys that have been relied upon by other experts as the basis of their opinions in both Federal and State courts. These surveys have related to anti-trust and market power issues, customer perceptions and actions, and the impact of various competitive actions on sales and profits. In every case courts have accepted the surveys conducted by AMS.

### **Background**

5. It is my understanding that the Hitachi High Technologies America, Inc. (hereafter Hitachi) has filed a trademark application for the word mark "SUPERSCAN ELITE" for use with televisions, projection televisions, plasma display televisions, video cassette recorders, DVD players, audio receivers, audio speakers, home theater systems and other home electronics. Pioneer Corporation (hereafter Pioneer) opposes this registration and believes that this trademark will be confusingly similar to its "ELITE" registered trademark that is used on its own televisions, projection televisions, plasma display televisions, video cassette recorders, DVD players, audio receivers, home theater systems and other home electronics.

### **Assignment**

6. I have been asked by counsel for Pioneer to develop, field and analyze a survey that would measure the extent to which consumers would confuse the "Superscan Elite" trademark with Pioneer's "Elite" mark. What follows in this report is a discussion of the survey and the conclusions I have drawn from these results regarding the extent of confusion that would exist if the "Superscan Elite" mark were to be used by Hitachi.
7. My work is ongoing; I may update and revise my results and conclusions as I review additional data and information. A complete list of materials I have considered to date in connection with this particular assignment is included as Exhibit B. To the extent that I review additional information, I will supplement this list.

8. I am being compensated at the rate of \$450 per hour, which is my standard fee for such services.

### **Overview of Survey Design and Findings**

9. The survey I designed was modeled on the methodology used in the *Berkshire Fashions v. Sara Lee*<sup>1</sup> case. My survey was a mall intercept study conducted in 5 sites across the U.S. with a total of 319 respondents. It was a double-blind, test and control design that measured the extent to which respondents who had been exposed to the Pioneer Elite brand in a catalog would mistakenly think they had seen a Superscan Elite product. My analysis of these results shows that 21.9% will confuse the Superscan Elite product with Pioneer Elite. It is my understanding that courts generally recognize measures of confusion above 20% as an unacceptably high level of confusion.

### **Discussion of the specific survey design and results**

10. The first step in any survey is to determine the appropriate target population. The appropriate target population in this case consists of potential purchasers of TV's, stereos and other home electronics. The Pioneer Elite brand is sold primarily in specialty home electronics stores such as Tweeter, and so it was desired that they consider shopping in a store like Tweeter where they would be exposed to the Pioneer Elite brand when they went shopping. This target population does not "exclusively" shop in Tweeter and when they are in the market for home electronics may visit several stores and view advertisements and promotional circulars of many retailers. By specifically mentioning Tweeter, however, their potential exposure to the Pioneer Elite brand can be assured.
11. Interviewing was conducted in five separate shopping malls in Boston, Chicago, Dallas, Miami and San Diego. The names and addresses of the malls used are shown Exhibit C. In each case, there was a Tweeter store within 2 miles of the shopping center. Interviewing was conducted from March 17, 2004 to April 17, 2004. Copies of all the supervisor and interviewer instructions are in Exhibit D and copies of the screening questionnaire and the main questionnaire are attached as Exhibit E.
12. As stated in the instructions included in Exhibit D, qualified respondents are males and females who are over 18 years of age, who
  - do not work for an advertising agency, a market research company or a company that manufactures or sells consumer electronics, and do not live in a household with anyone who does
  - do not work in any facility located in the mall where you are recruiting
  - have in the past shopped for TVs, Stereo equipment, or other home electronic products in a store like Tweeter and are likely to do so in the next 12 months

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<sup>1</sup> 725 F. Supp. 790

- have their reading glasses with them, if they use reading glasses (respondents will be viewing a product brochure that they will need to be able to read)

13. Interviewers intercepted potential respondents on the floor of the shopping mall and, if they qualified they were offered a \$5 incentive and invited to participate. The actual interview took place in a private interview location away from the floor of the mall. A total of 319 respondents were interviewed<sup>2</sup>, and these interviews were distributed equally by site and questionnaire used. Respondents were well distributed by age and gender. Tabulations of the sample demographics are shown in Exhibit G.

14. The interview procedure was "double-blind" in that neither the respondent nor the interviewer was aware of the identity of the sponsor or the purpose of the survey.

15. Interviewers first showed the respondent the pages from the Fall 2003 Pioneer Elite catalog (attached as Exhibit H) and asked to "Look at it the way you would if you were shopping for these products. Take as long as you want, and when you are finished, give it back to me and I will ask you a few questions." When the respondents had finished looking at the brochure, the interviewer retrieved it and put it out of sight. Respondents were then asked several "filler" questions to provide some distance between the exposure to the catalog and the key "confusion" question.

16. Respondents were then told "Now I am going to show you a list of names. If you see the name of the products from the brochure that you just saw, please place a check mark next to it. You may or may not find the name from the brochure on the list. Different people are shown different lists. If you don't find it, that's perfectly all right, just check off "None" at the bottom of the page.

17. Each person was then shown a list of six names. Each of the names was a two-word name (shown all in capital letters) that is currently used as a brand name for home electronics. Five of the names were the same for each respondent.

These names were

JVC GIGATUBE  
BOSE TRIPORT  
SHARP AQVOS  
SONY WEGA  
PHILIPS DIRECTV.

The sixth name on the list was either SUPERSCAN ELITE or SUPERSCAN SELECT. Half the respondents saw a list that contained the SUPERSCAN ELITE name and half saw a list with the name SUPERSCAN SELECT. There were 4 different orderings of names on the list, but SUPERSCAN ELITE/SELECT was never in the first or last position and SUPERSCAN ELITE/SELECT appeared in the second, third, fourth and

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<sup>2</sup> As is standard for these types of interviews, telephone validations with 20% of each site's respondents were conducted by an independent interviewing organization. No problems with the original interviews were detected.

fifth positions an equal number of times. Thus any effect due to the order in which the names were presented was eliminated and none of the names on either list appeared in the catalog they were shown.

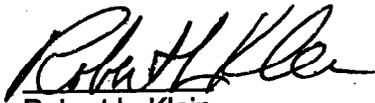
18. Half the respondents were shown the list that contained SUPERSCAN ELITE list and half saw the SUPERSCAN SELECT list. The result was a classic test vs. control experimental design. By subtracting the proportion checking SUPERSCAN SELECT (the "control" cell) from the proportion checking SUPERSCAN ELITE (the "test" cell), the impact of any other factors (including guessing) that might have influenced a respondent's answer is eliminated. The result is the "net" confusion after accounting for other factors. As can be seen in Table 1 (below), 21.6% of the relevant universe would be confused by the Superscan Elite brand name.

	<b>Test</b>	<b>Control</b>	<b>Net</b>
	<b>SUPERSCAN ELITE</b>	<b>SUPERSCAN SELECT</b>	
<b>% identifying</b>	<b>29.2%</b>	<b>7.6%</b>	<b>21.6%</b>
<b>Base</b>	<b>161</b>	<b>158</b>	

Table 1 – Measured Confusion

#### Conclusions

19. Based on the results of this survey, it is my opinion that if the name Superscan Elite is used by Hitachi to identify their line of home electronics, a significant number of potential customers of Pioneer will be confused.



Robert L. Klein  
May 19, 2004

**Exhibit A**  
**c.v. of Robert L. Klein**

**Robert L. Klein**

**Business Address:** Applied Marketing Science, Inc.  
303 Wyman Street, Suite 205  
Waltham, MA 02451  
(781) 684-1230 ext 121  
fax: (781) 684-0075

**E-mail:** bklein@ams-inc.com

**Web address:** www.ams-inc.com

**Home Address:** 203 Windsor Road  
Newton, MA 02468  
(617) 965-0605

**Education:** MASSACHUSETTS INSTITUTE OF TECHNOLOGY, SLOAN SCHOOL OF MANAGEMENT, Master of Science in Management, June 1968.  
Teaching Assistantship 2<sup>nd</sup> year.

MASSACHUSETTS INSTITUTE OF TECHNOLOGY, Bachelor of Science in Mechanical Engineering, June 1966, Dean's List 4 terms.

**Career Positions:**  
1989-present

APPLIED MARKETING SCIENCE, INC., Waltham, MA  
Co-founder and President. AMS is a marketing research and consulting organization with offices in Waltham, MA. AMS helps clients in a broad range of product and service industries identify and use the Voice of the Customer to develop new products and services and understand customer behavior. Developed the VOCALYST® system of market research and analysis to efficiently collect and structure customer wants and needs.

1985-1988

INFORMATION RESOURCES, INC., Waltham, MA  
Executive Vice President. Founded and lead the Custom Projects Group, a custom marketing science analysis and consulting organization emphasizing non-consumer packaged goods applications of management science models and measurement systems. Participated in the early development and popularization of Quality Function Deployment (QFD) in the United States and promoted its use through articles and speeches.

1970-1985

MANAGEMENT DECISION SYSTEMS, INC., Waltham, MA  
Senior Vice President. Participated in the founding of this prestigious software and marketing science consulting firm. Held a variety of positions during its growth to a \$25M company including Chief Financial Officer, Head of Models Development Division, member of Executive and Compensation Committees, Head of various client service and consulting groups prior to its merger with Information Resources. Responsible for the development and commercialization of numerous marketing science models including ASSESSOR, BRANDAID II, CATALYST, Coupon Laboratory, and DEFENDER.

Robert L. Klein

1968-1970

U.S. PUBLIC HEALTH SERVICE, National Institutes of Health, Division of Computer Research and Technology, Bethesda, MD, Commissioned Officer (rank equivalent to Army Capt.) Original member of a management science consulting group founded to apply these principles to the operations of the National Institutes of Health. Responsible for various projects in both the medical research area and the business and grants management area.

Publications:

"New Products Director in Wonderland," *Household and Personal Products Industry*, November 1977

"Researcher's Model can Help Marketer Do a Better Job," *Marketing News*, January 27, 1978

"ASSESSING the Difference: Simulation Can Mean An Edge," *Advertising Age*, February 19, 1979

"Using Supermarket Scanner Panels to Measure the Effectiveness of Coupon Promotions," *Marketing: Measurement and Analysis 1981*, Editor: John W. Keon, Proceedings of the Third ORSA/TIMS Special Interest Conference on Market Measurement and Analysis, March, 1981

"Determinants of Coupon Effectiveness," (with John Little and Karl Irons), *Advances and Practices of Marketing Science 1983*, Editor: Fred Zufryden, Proceedings of 1983 ORSA/TIMS Marketing Science Conference, March 1983.

"Getting the Product Mix Strategy Right via a Model for Positioning Assessment and Potential Prediction," (with Katherine Moore and Sandra Eubank), *Proceedings of the ESOMAR Seminar on New Product Development*, Athens, Greece, November 1983

"Simulation Model Helps Marketers Assess Effects of Defensive Moves," *Marketing News*, March 30, 1984.

"How to Use Research to Make Better Sales Promotion Marketing Decisions," *Handbook of Sales Promotion*, Editor: Stanley Ulanoff, McGraw-Hill, Inc. 1985

"Right Price on New Product Boosts Profit Potential," *Marketing Review*, AMA/New York Chapter, September-October, 1985

"Without Good Research, Quality Is A Shot In The Dark," (with John R. Hauser), *Marketing News*, January 4, 1988.

"New Techniques for Listening to the Voice of the Customer," *Transactions of the Second Symposium on Quality Function Deployment*, Novi, Michigan, June 1990.

Robert L. Klein

"How QFD Saved a Company," *Transactions of the Fourth Symposium on Quality Function Deployment*, Novi, Michigan, June 1992.

"QFD at PG&E," (with Amy Tessler and Norm Wada) *Transactions of the Fifth Symposium on Quality Function Deployment*, Novi, Michigan, June 1993.

"The Voice of the Customer for Groupware," *Proceedings of Groupware 94*, San Jose, CA, August 1994.

"Quality Programs and Quality Profits" *Transactions of the Seventh Symposium on Quality Function Deployment*, Novi, Michigan, June 1995.

"Incentive Pay for Customer Satisfaction," *Transactions of the Seventh Symposium on Quality Function Deployment*, Novi, Michigan, June 1995.

"Pilot Programs and What Utilities Are Not Learning About Marketing," *The Energy Daily, Special Edition – The Branded Utility: Marketing A New Approach*, January 1997

"How Much Is An Infringing Feature Really Worth," *Intellectual Property Today*, October 2002

Expert Witness

Young, et al. v. Nationwide Life Ins. Co., et al.  
Civ. No. G-97-628 (S.D. Texas)  
Class certification (1998, report)

Walker, et al. v. MediaOne Group, Inc., et al.  
C.A. No. 99-CV-1170 (N.D. Georgia)  
Class certification (1999, report)

State Farm, et al v. Birnbaum, et al.  
Case #308274, Superior Court, San Francisco, California  
Trade secrets (2000, report)

Providian Credit Card Cases  
Judicial Council Coordination Proceeding No. 4085  
Superior Court, San Francisco, California  
Trade secrets (2000, report)

Albert v. Warner-Lambert Company  
C.A. No. 99-CV-11700RGS (Massachusetts)  
Marketing and Business Forecasting (2001, report and deposition)

Tusher Family v. Bulldog Capital Management  
JAMS Binding Arbitration Ref No. 1100031683  
Statistical analysis of survey results (2002 report)

**Robert L. Klein**

**CE Resource v. National Center of Continuing Education  
Case # CIV. S-01-1796 DFL PAN (E.D. California, Sacramento)  
Trade Dress (Secondary Meaning and Confusion) (2002, report and  
deposition)**

**Adidas America and Adidas-Salomon AG v. Target Corp, E.S. Originals,  
Inc. and B.U.M. International, Inc., No. CV01-1582 ST (Oregon)  
Trademark Confusion (2003, report and deposition)**

**R. Straman and Newport Convertible v. Volkswagen of America, et al  
No. 812391 (Orange County, California Superior Court)  
Sales forecasting (2003 deposition)**

**Trade Service Corporation v. Material Express.com, et al  
No. 02 CV 1133 H (LAB), S.D. California  
Sales forecasting (2003 report and deposition)**

**Eco Manufacturing LLC v. Honeywell International Inc.  
1:03-CV-0170, S.D. Indiana, Indianapolis Division  
Trademark Confusion (2003 report, deposition and hearing testimony)**

**Aldridge, et al. v. A.T. Cross, et al., No. 00 203 ML (Rhode Island)  
New Product Forecasting (2003 report and deposition)**

**Grant Products International, Inc. v. American Products Company, Inc.  
EDCV-02-1198 VAP (SLGx) C.D. California, Eastern Division  
Secondary Meaning (2003 report and deposition)**

**Chicago National League Ball Club, Inc. v. Skybox on Waveland, et al.  
No. 02 C 9105, N.D. of Illinois, Eastern Division  
Trademark confusion(2003 report and trial testimony)**

**Professional:**

**Member INFORMS, ASQ, QFD Institute, PDMA,  
Certified New Product Development Professional**

**Exhibit B**  
**Materials relied upon**

Registration record of ELITE

Registration record of SUPERSCAN ELITE

First Amended Notice of Opposition

Applicant's Answer to First Amended Notice of Opposition

Weltner, Phyllis J., *Trademark Surveys*, West Group, Release #6, 6/99

McCarthy, J. Thomas, *McCarthy on Trademarks and Unfair Competition*, West, 4<sup>th</sup> Edition

Diamond, Sheri S. "Reference Guide on Survey Research" (2nd edition) In *Reference Manual on Scientific Evidence*. Washington, D.C.: Federal Judicial Center, 229-276

*Berkshire Fashions, Inc. v. Sara Lee Corporation*, 725 F. Supp. 790

**Exhibit C**  
**List of Malls and addresses**

**Natick Mall**  
**1245 Worcester Street**  
**Natick (Boston), Massachusetts**

**Stonebriar Centre**  
**2601 Preston Road**  
**Frisco (Dallas), Texas**

**Lincoln Mall**  
**208 Lincoln Mall**  
**Matteson (Chicago), Illinois**

**Parkway Plaza**  
**415 Parkway Plaza**  
**El Cajon (San Diego), California**

**Pembroke Lakes Mall**  
**11401 Pines Blvd.**  
**Pembroke Pines (Miami), Florida**

**Exhibit D**  
**Supervisor and Interviewer Instructions**

**SUPERVISOR AND INTERVIEWER INSTRUCTIONS**  
**CUNNINGHAM FIELD AND RESEARCH SERVICES: BOSTON, CHICAGO, DALLAS, MIAMI**  
**QUICKTEST/HEAKIN: SAN DIEGO**

**SUPERVISOR: Please read and review the Interviewer Instructions and the Screeners and Questionnaires prior to the briefing and distribution of materials to the interviewers.**

**LIST OF MATERIALS**

In addition to these Supervisor/Interviewer instructions, each site will receive the following:

65 screeners: Your quota is to complete 60 interviews. Note that we have provided a few additional screeners. Please use one screener during the intercept process until you have recruited a qualified respondent. We have designed this screener to capture recruiting statistics. The field site supervisor will be responsible for maintaining the daily tally of these results.

65 questionnaires: Again, your quota is to complete 60 interviews. Note that we have provided additional copies of this questionnaire in case of Terminates. However, we must receive all questionnaire back at the end of the study (both Completes and Terminates.). All questionnaires are pre-numbered.

Exhibits: 5 Home Electronics catalogs, so that up to 5 interviews may be conducted at a time.

Administrative Forms:

1. Master Tally Sheet for screening statistics.
2. Final Shipping Checklist.
3. Briefing Sign-in Sheet.

Anyone working on this study is to be instructed to take care in not misplacing any of the survey materials. No survey materials are to be removed from your facility with the exception of materials used in recruiting respondents. ALL SURVEY MATERIALS ARE CONFIDENTIAL.

***If any materials are missing, or any instructions are unclear, please notify Jennifer Parr (781-684-1230 X 139) immediately.***

**GO TO NEXT PAGE NOW FOR BRIEFING INSTRUCTIONS**

## **BRIEFING**

A conference call briefing will be set up for Friday, March 26, 2004, at 2:00 (EASTERN STANDARD TIME) for all locations. Please refer to the conference call procedure outlined below.

### **CONFERENCE CALL PROCEDURE IS AS FOLLOWS:**

**At 2:00 pm EASTERN STANDARD TIME call:**

**1-866-616-4804**

**You will be transferred directly to a Conference Bridge (or put on hold at this time until Conference Chairperson (Jennifer Parr) sets up her call.**

## **CREW SIZE**

A minimum of three recruiters/interviewers should be briefed and assigned to work on this study.

## **INTERVIEWING SCHEDULE AND QUOTA**

Every attempt must be made to complete 60 interviews in 12 business days starting on March 26 and ending on April 9. (note: Natick, MA will be on a different schedule, with 30 of the 60 interviews being completed between March 9 and March 15)

Interviewing is to be conducted during morning, afternoon, and evening mall hours.

## **RESPONDENTS**

Respondents will be paid \$5.00 for their time. Please provide a sign-out sheet that indicates that each respondent received the \$5.00 cash incentive.

Qualified respondents are males and females who are over 18 years of age, and who

- do not work for an advertising agency, a market research company or a company that manufactures or sells consumer electronics, and do not live in a household with anyone who does
- do not work in any facility located in the mall where you are recruiting
- have in the past shopped for TVs, Stereo equipment, or other home electronic products in a store like Tweeter and are likely to do so in the next 12 months
- have their reading glasses with them, if they use reading glasses (respondents will be viewing a product brochure that they will need to be able to read)

## **GENERAL RECRUITING AND INTERVIEWING PROCEDURE**

- The private interviewing area should contain a table and two chairs. The interviewer and the respondent are to be seated across and table from each other during the questionnaire portion of the interview.

- After positioning yourself at your assigned screening site, you should attempt to screen the first individual approaching your site who appears to be 18 years of age or older. If the individual does not qualify, or does not meet any available screening criteria, you should approach the next individual, and the next, until you locate a qualified participant.
- Proceed from attempt to screen/qualify to attempt to screen/qualify utilizing the selection method described, approaching each prospective respondent, regardless of race, dress, appearance or any other consideration.

**You must maintain an accurate record of screening stats on the screener itself. We have provided tally boxes under each question on the screening document for this purpose.**

- After qualifying a respondent, you are to take that individual to your facility to be interviewed in your interviewing area.
- Upon completion of the interview, you are to return to the mall and position yourself at your assigned screening site, and repeat the respondent selection process previously described. (NOTE: If you wish, trained/briefed recruiters may be assigned to recruit only...and then to escort the respondent to the facility for the survey where a trained/briefed interviewer may conduct the interview. No one may work on this study if they have not been trained/briefed with these materials AND have signed the appropriate paperwork.

#### **Screening Reminders:**

- Do not interview anyone you know
- Terminate the attempt to interview if there is a language or hearing difficulty. Note this difficulty on the screener.
- Do not attempt to screen/qualify anyone who has, or might have, overheard the screening of a previous respondent
- During the screening portion of the interview, if you approach a group of two or more, address your request to only one of the individuals and request that the other individual(s) not help or assist the participating individual with his/her answers. If this occurs, terminate the attempt to interview.
- Do not position yourself in a manner in which a respondent can read any of the words or questions on the Screener.

## **SCREENERS AND QUESTIONNAIRE PROCEDURE**

The interviews will proceed as follow:

- a) Respondent views product catalog,
- b) Respondent is asked a series of questions by an interviewer and
- c) Respondent completes pen-and-paper exercise

All specific instructions for execution of the Screeners and Questionnaires are on the Screeners and Questionnaires themselves, written in **BOLD CAPITAL LETTERS**.

#### **Administering the Survey:**

The Screeners and Questionnaires are short; however, it is important that:

- The questions are read verbatim
- the responses are recorded clearly and accurately and in a manner in which they can be read
- Administer each Screener and Questionnaire in a completely uniform manner, reading each question exactly as it is written. Allow the respondent as much time as he/she needs to answer before proceeding to the next question. Do not change the wording of any question, and ask only the questions included on the Screener and Questionnaire.
- All questionnaires must be initialed by the interviewer.

### **Terminations:**

If an interview is terminated during the Questionnaire portion, mark terminate (TM) on the Questionnaire where this occurred and note an explanation in the margin of the Questionnaire. Do not erase or reuse the Questionnaire. If you experience a terminated interview, recruit another respondent and continue with the next survey. You must return all surveys to us by the completion of the study. This includes TERMINATED surveys, as well as, completed surveys.

### **Erasing/Changing Responses**

**Do not erase** on either the Screener or the Questionnaire. If you make an error in executing the Screener or Questionnaire, put a line through the error and put the Initials "IE" (Interviewer Error) next to the error.

If the respondent makes an error, while you are executing the Screener or Questionnaire, put a line through the error and put the initial "RE" (Respondent Error) next to the error.

### **Handling of Exhibits:**

As stated on the questionnaire itself, please handle the exhibits as follows:

1. The questionnaire will instruct the interviewer when to show the Home Electronics Brochure to the respondent. Allow the respondent to read and handle the brochure for as long as he/she wants to.
2. When the respondent indicates that he or she has finished reviewing the brochure, place the brochure somewhere that is completely out of the respondent's sight before asking the first question. You may place the brochure on the floor under the table, or under a notepad or a thick piece of paper. Do not allow the respondent to see any part of the brochure for the rest of the interview.

### **Managing screeners**

For completed interviews, copy the respondent number from questionnaire to the corresponding screener.

All screeners must be stapled to the corresponding completed questionnaire.

All screeners must be initialed by the recruiter and by the interviewer.

## **VALIDATION**

- Validation in this study requires that a Supervisor personally meet 25% of each Interviewer's respondents and confirm that they took part in the survey.
- A Supervisor is to sign his/her name where indicated (see "Supervisor Validation" signature area) on the last page of the Questionnaire to affirm this in-person validation.
- Interviews with respondents who refuse name and/or telephone number will not be accepted toward quota, unless they are validated on site.
- If a Supervisor conducts an interview, that Supervisor should not validate his/her own interview. Another Supervisor should validate a Supervisor-conducted interview.
- Applied Marketing Science will also conduct additional telephone validations of the completed questionnaires.

## SHIPPING

### Shipping Information:

Applied Marketing Science uses OPTIMA Shipping for both outgoing and incoming shipments. Optima is a "consolidator" of sorts, getting us bulk prices through UPS and FedEx for being part of their group.

When shipping packages to AMS, you must use BOTH the Fedex/UPS account number AND the Optima Account numbers listed below. The Optima Account number goes in the "Reference Information" section of the waybill.

**FedEx** account number: **138876462**

**UPS** account number: **141897**

**Optima** Account number: **REF: 1537 Applied Marketing Science**

### Daily Shipments

Please send daily shipments of all completed Questionnaires with Screeners attached.

### Final Shipment

Please include the following materials with your final shipment:

- All remaining completed Questionnaires with Screeners attached
- Respondent sign-out sheet (confirming that they received their incentive.)
- Signed Briefing Sign-In Sheet for Supervisors and Interviewers
- Master Tally Sheet for Screening Statistics
- Any leftover Screeners and Questionnaires
- Final Shipping Checklist.

NOTE: Please do not return the Exhibits with your final shipment. In the event that another site should fall short of quota, or we should need your site to complete additional interviews for any reason, we would appreciate if you held on to the Exhibits until you hear from AMS that it's ok to send them back.

**Exhibit E**  
**Copies of the Questionnaires**

# SCREENER Home Electronics Shoppers

Interview date and time \_\_\_\_\_

NAME: \_\_\_\_\_

ADDRESS: \_\_\_\_\_

CITY: \_\_\_\_\_ STATE: \_\_\_\_\_ ZIP: \_\_\_\_\_

HOME PHONE: \_\_\_\_\_ WORK PHONE: \_\_\_\_\_

E-MAIL ADDRESS: \_\_\_\_\_ RECRUITER: \_\_\_\_\_

## APPROACH MALES AND FEMALES WHO APPEAR TO BE 18 YEARS OLD OR OLDER

Spoke to.....but initial refusal before Q.A

1	2	3	4	5	6	7	8	9	10	11	12	13	14	15	16	17	18	19	20
21	22	23	24	25	26	27	28	29	30	31	32	33	34	35	36	37	38	39	40

## INTRODUCTION

Hello, I'm \_\_\_\_\_ from \_\_\_\_\_, a market research company in here at the mall. We're conducting a short survey today. May I ask you a few quick questions?

A. First of all, are you 18 years old or older?

YES	1	CONTINUE with QB
NO	2	TERMINATE WITH THANKS

Not 18 or older

1	2	3	4	5	6	7	8	9	10	11	12	13	14	15	16	17	18	19	20
21	22	23	24	25	26	27	28	29	30	31	32	33	34	35	36	37	38	39	40

B. Into which of the following categories does your age fall? **READ LIST AND CIRCLE ONE CODE ONLY.**

18-35	1
36-50	2
51-65	3
66 or older	4

Not 18+

1	2	3	4	5	6	7	8	9	10	11	12	13	14	15	16	17	18	19	20
21	22	23	24	25	26	27	28	29	30	31	32	33	34	35	36	37	38	39	40

C. Have you ever shopped for TVs, Stereo equipment of other home electronics in a store like Tweeter? **(CHOOSE ONE ANSWER)**

YES	1	CONTINUE
NO	2	TERMINATE WITH THANKS

Has never shopped in a store like Tweeter

1	2	3	4	5	6	7	8	9	10	11	12	13	14	15	16	17	18	19	20
21	22	23	24	25	26	27	28	29	30	31	32	33	34	35	36	37	38	39	40

D. How likely would you be to shop for TV's, Stereo equipment or other home electronics in a store like Tweeter in the next 12 months?? (READ LIST, CHOOSE ONE ANSWER)

Definitely	1	CONTINUE
Probably	2	CONTINUE
Might or might not	3	CONTINUE
Probably will not	4	TERMINATE WITH THANKS
Definitely will not	5	TERMINATE WITH THANKS

Probably or Definitely won't shop in the next 12 months

1	2	3	4	5	6	7	8	9	10	11	12	13	14	15	16	17	18	19	20
21	22	23	24	25	26	27	28	29	30	31	32	33	34	35	36	37	38	39	40

E. Do you or does any member of your household work for any of the following types of companies?

An automotive manufacturer	1	CONTINUE
A company that manufactures or sells consumer electronics	2	TERMINATE WITH THANKS
An advertising agency	3	CONTINUE
A company that conducts market research	4	TERMINATE WITH THANKS
None of the above	5	CONTINUE

Works for market research or consumer electronics

1	2	3	4	5	6	7	8	9	10	11	12	13	14	15	16	17	18	19	20
21	22	23	24	25	26	27	28	29	30	31	32	33	34	35	36	37	38	39	40

F. Do you work in a store or restaurant that is located in this mall?

YES	1	TERMINATE WITH THANKS
NO	2	CONTINUE

Works in the mall

1	2	3	4	5	6	7	8	9	10	11	12	13	14	15	16	17	18	19	20
21	22	23	24	25	26	27	28	29	30	31	32	33	34	35	36	37	38	39	40

G. [RECORD GENDER - DO NOT ASK]

Male	1	WATCH QUOTA
Female	2	

H. Do you use glasses for reading? If so, do you have them with you?

YES	1	CONTINUE
NO	2	TERMINATE WITH THANKS

Did not have reading glasses

1	2	3	4	5	6	7	8	9	10	11	12	13	14	15	16	17	18	19	20
21	22	23	24	25	26	27	28	29	30	31	32	33	34	35	36	37	38	39	40

# INVITATION

I would like to invite you to our office right here in the mall to participate in a brief market research study. The interview will only take less than 10 minutes of your time and you will receive \$5 in cash for your participation. Can you help us today?

YES	1	CONTINUE
NO	2	TERMINATE WITH THANKS

Qualified, but refused invitation

1	2	3	4	5	6	7	8	9	10	11	12	13	14	15	16	17	18	19	20
21	22	23	24	25	26	27	28	29	30	31	32	33	34	35	36	37	38	39	40

RESP. # \_\_\_\_\_

## HOME ELECTRONICS QUESTIONNAIRE

INTERVIEWER \_\_\_\_\_ DATE \_\_\_\_\_

**READ:** I am going to show you some information about a line of TVs, stereos and other home electronics that is sold in stores like Tweeter. Look at it the way you would if you were shopping for these products. Take as long as you want, and when you are finished, give it back to me and I will ask you a few questions.

**HAND RESPONDENT BROCHURE; ALLOW THEM TO TAKE AS MUCH TIME AS THEY WISH TO LOOK AT IT. WHEN RESPONDENT IS DONE, TAKE BACK THE BROCHURE AND PUT IT AWAY SO THAT RESPONDENT CANNOT SEE IT.**

1. How many television sets do you have in your home?

**[RECORD NUMBER]:** \_\_\_\_\_

2. Have you ever looked on the Internet for information about TVs, stereos, or other home electronics?

**[CIRCLE ONE ANSWER]**

Yes	1
No	2

3. Do you purchase these products online, shop in a store, or do both?

**[CIRCLE ONE ANSWER]**

Online	1
Store	2
Both	3

**READ:** Now I am going to show you a list of names. If you see the name of the products from the brochure that you just saw, please place a check mark next to it. You may or may not find the name from the brochure on the list. Different people are shown different lists. If you don't find it, that's perfectly all right; just check off "None" at the bottom of the page.

**HAND RESPONDENT THE NEXT PAGE OF THE SURVEY. RESPONDENTS MAY TAKE AS MUCH TIME AS THEY WISH, BUT DO NOT ALLOW THEM TO SEE THE BROCHURE PAGES.**

RESP. # \_\_\_\_\_

If you see the name of the products from the brochure that you just saw on this list, please place a check mark next to it. You may or may not find the name from the brochure on the list. Different people are shown different lists. If you don't find it, that's perfectly all right; just check off "None" at the bottom of the page.

JVC GIGATUBE

SUPERSCAN ELITE

BOSE TRIPORT

SHARP AQVOS

SONY WEGA

PHILIPS DIRECTV

NONE

**Note:**

In case the supervisor of this project wants to check to make sure this questionnaire was actually completed, please write your first name and phone number below. This information will only be used to confirm that this interview took place.

Name: \_\_\_\_\_

Phone #: \_\_\_\_\_

**PLEASE HAND THIS SHEET BACK TO THE INTERVIEWER WHEN YOU ARE DONE.**



If you see the name of the product please place a check mark next to it on the list. Different products are shown different prices; just check off

If you see the name of the products from the brochure then please place a check mark next to it. You may or may not see the same products on the list. Different people are shown different prices; just check off "None" at the bottom of the list.

SONY WEGA

PHILIPS DIRECTV

PHILIPS DIRECTV

JVC GIGATUBE

JVC GIGATUBE

SUPERSCAN SELECT

SUPERSCAN SELECT

BOSE TRIPORT

BOSE TRIPORT

SHARP AQVOS

SHARP AQVOS

SONY WEGA

NONE

NONE

**Note:**  
In case the supervisor of this project actually completed, please write your name and phone information will only be used to confirm that this interview was completed.

Name: \_\_\_\_\_

Phone #: \_\_\_\_\_

PLEASE HAND THIS SHEET BACK TO THE INTERVIEWER

**Note:**  
In case the supervisor of this project wants to check to see if you actually completed, please write your first name and phone information will only be used to confirm that this interview was completed.

Name: \_\_\_\_\_

Phone #: \_\_\_\_\_

PLEASE HAND THIS SHEET BACK TO THE INTERVIEWER

RESP. # \_\_\_\_\_

If you see the name of the products from the brochure that you just saw on this list, please place a check mark next to it. You may or may not find the name from the brochure on the list. Different people are shown different lists. If you don't find it, that's perfectly all right; just check off "None" at the bottom of the page.

- SHARP AQVOS
- SONY WEGA
- PHILIPS DIRECTV
- JVC GIGATUBE
- SUPERSCAN SELECT
- BOSE TRIPORT
  
- NONE

**Note:**

In case the supervisor of this project wants to check to make sure this questionnaire was actually completed, please write your first name and phone number below. This information will only be used to confirm that this interview took place.

Name: \_\_\_\_\_

Phone #: \_\_\_\_\_

**PLEASE HAND THIS SHEET BACK TO THE INTERVIEWER WHEN YOU ARE DONE.**

**Exhibit F  
Response Rate Statistics**

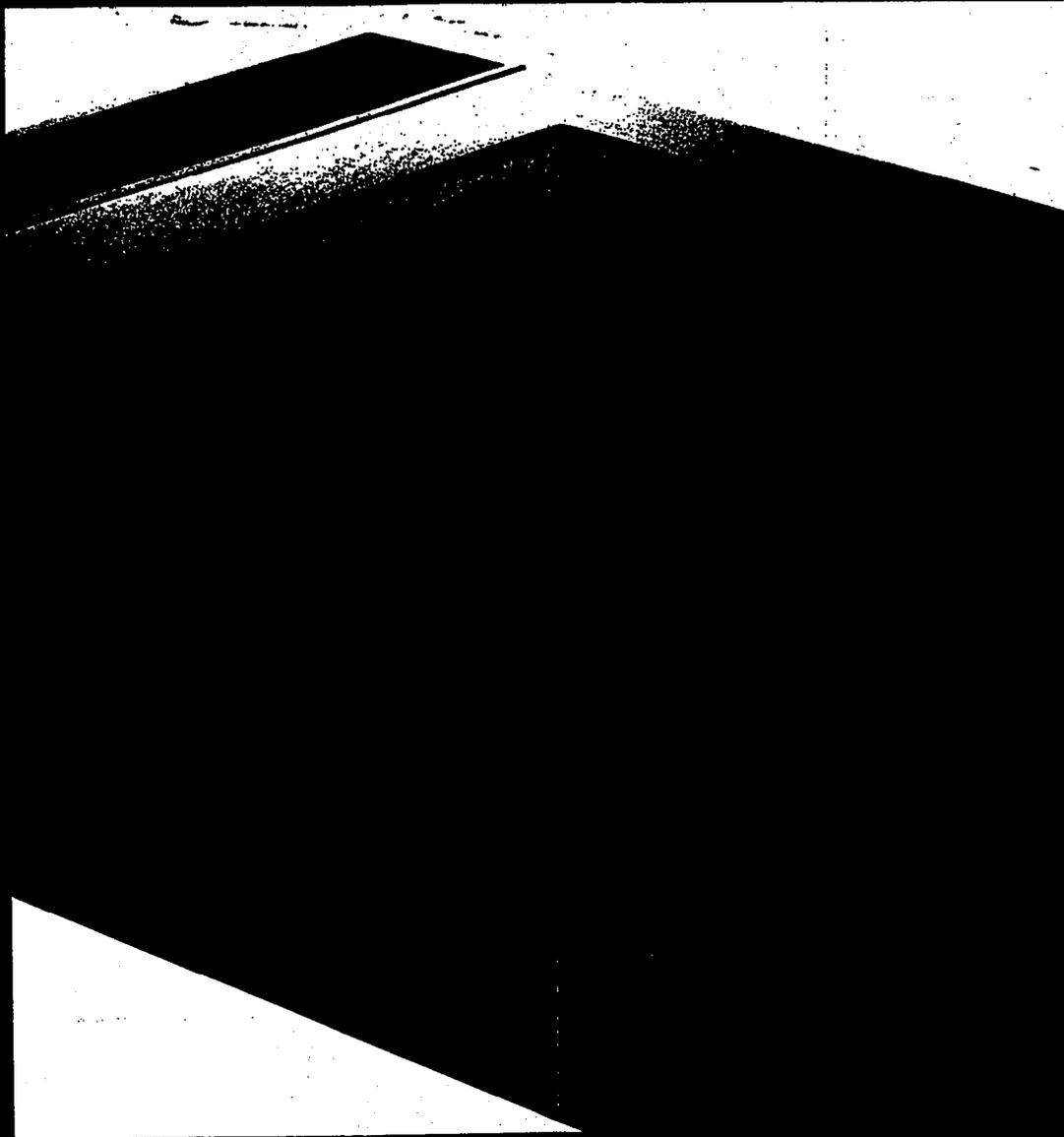
	Chicago	Dallas	Miami	Natick	San Diego	TOTAL
Initial refusals	91	71	151	200	65	578
<b>Total respondents screened</b>	<b>202</b>	<b>237</b>	<b>151</b>	<b>204</b>	<b>343</b>	<b>1137</b>
<b>Total not qualified (A)</b>	<b>133</b>	<b>156</b>	<b>80</b>	<b>126</b>	<b>267</b>	<b>762</b>
Not 18 or older	52	79	22	0	72	225
Has never shopped in store like Tweeter	19	14	18	62	65	178
Won't shop in next 12 months	38	24	16	43	106	227
Works for market res or consumer electronics	5	13	6	5	14	43
Works in the mall	12	21	12	13	6	64
Did not have reading glasses	7	5	6	3	4	25
<b>Qualified but refused to be interviewed (B)</b>	<b>6</b>	<b>17</b>	<b>9</b>	<b>14</b>	<b>10</b>	<b>56</b>
<b>Completed Interviews (C)</b>	<b>63</b>	<b>64</b>	<b>62</b>	<b>64</b>	<b>66</b>	<b>319</b>

**Qualification Rate:  $(B + C) / (A + B + C)$  33%**

**Cooperation Rate:  $C / (B + C)$  85%**

**Exhibit G**  
**Tabulation of Respondent Age and Gender**

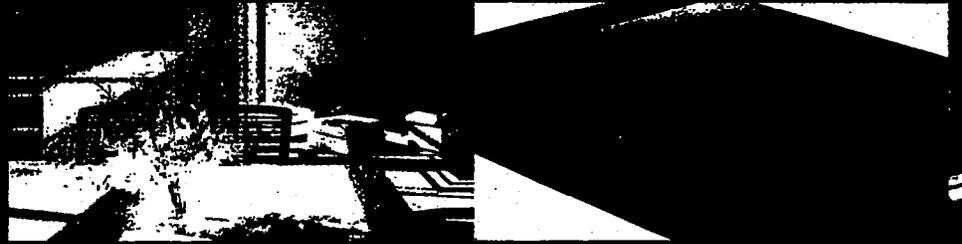
	<b>Male</b>	<b>Female</b>	<b>Total</b>
<b>18 to 35</b>	<b>73</b>	<b>55</b>	<b>128</b>
<b>36 to 50</b>	<b>52</b>	<b>47</b>	<b>99</b>
<b>51 to 65</b>	<b>21</b>	<b>44</b>	<b>65</b>
<b>Over 65</b>	<b>13</b>	<b>14</b>	<b>27</b>
<b>Total</b>	<b>159</b>	<b>160</b>	<b>319</b>



Complete>Elite

Definitive Home Theater from Pioneer Fall 2003

Director's cuts on DVD. Late-season playo



2

10

12

20

28

32

> > > On a truly great home theater system, these will be unforgettable moments and your daily life moves into the background. Chills and thrills, wild dancing in your media room - they're all part of the package.

Elite home theater systems are built to deliver these extra-sensory experiences by Pioneer's leading-edge audio and video expertise, each component with extreme attention to detail. We use only the best optical glass and the most powerful processors and top-grade electronics. And even when the Elite components are stunning.

The purchase of an Elite home theater system is an investment in your entertainment. Each movie, game, or concert you'll see - and hear - your investment

Go ahead, turn it on. The experience will change

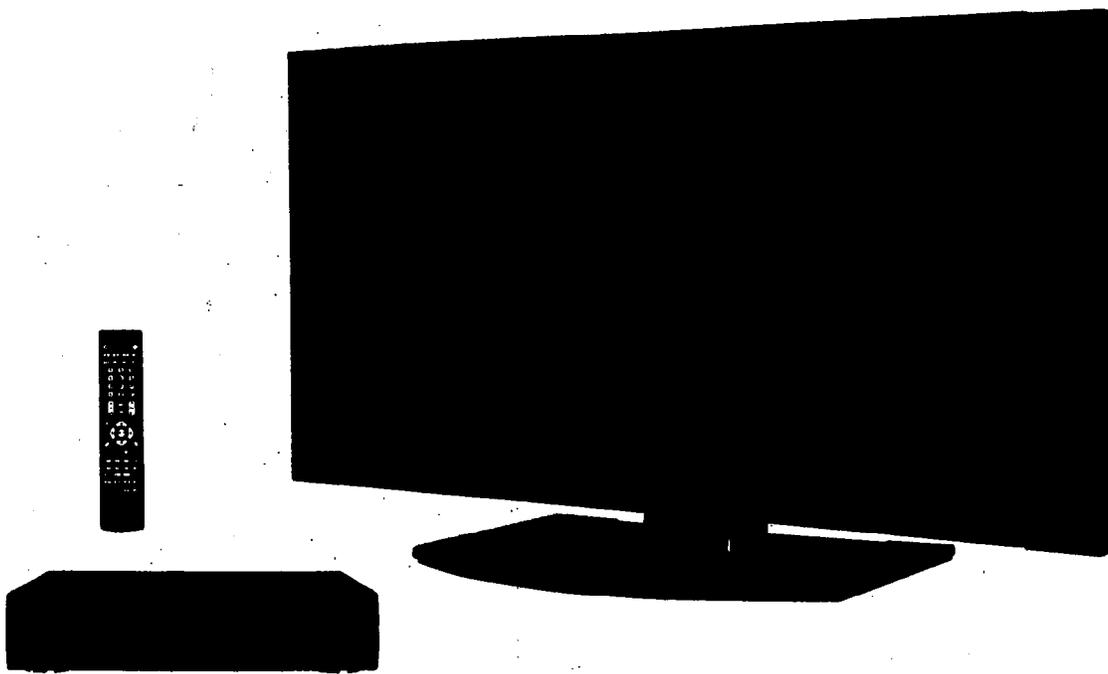


# PRO-1110HD



- High Definition WXGA (1280 x 768) Resolution
- Advanced Continuous Emission II (ACE II)
- PureDrive
- Pure Color Filter II

# PRO-910HD

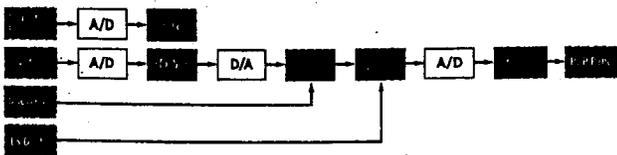


• XGA (1024 x 768) Progressive Resolution

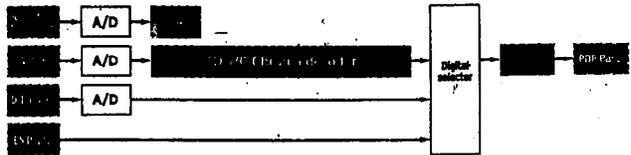
• PureDrive

• Advanced PureCinema with 3:3 Pulldown

• Certified ISF C<sup>2</sup> Modes



Conventional PDP



PureVision's PureDrive

## I/P CONVERSION

Even the most common plasma displays contain an I/P converter, a chip that turns interlaced images into progressive images. That's the easy part; inexpensive, low-performance I/P conversion chips are available to all manufacturers. But performing that conversion with total precision and without visible distortion cannot be done with an inexpensive chip. Go into a store, begin watching a plasma display and look for a moving image that contains a straight edge such as a pillar or fence. As motion continues, look for a jagged effect along the edges. That imperfection can be eliminated, and powered by PureDrive, the Elite PRO-1110HD and PRO-910HD plasma TVs are up to the task. Each contains a custom IC that performs high-grade I/P conversion, so those straight edges will look straight and clean, like they're supposed to. Better technology, better performance: It's another reason why Pioneer plasmas are the best in their class.

## ADVANCED PURECINEMA WITH 3-3 PULLDOWN

Film doesn't translate to a standard that a TV can process without some alterations. Here's why: all movies are shot on film at 24 frames per second (fps), but televisions display images using the long-standing NTSC standard of 30 frames per second (or more precisely, 60 interlaced fields per second, or 60Hz). In order to display a movie, 6 fps must

be added to the film's original 24 fps, to equal 30. This is done by examining each frame of film and creating three "partial" frames from the first frame of film, two partial frames from the second, then three again, and so on. This conversion process is called 3-2 (or sometimes 2-3) frame pulldown.

Today's 3-2 pulldown standard greatly improves NTSC reproduction of film-based material. It requires a processor to take those 24 fps into a buffer, interpolate how to compose the 6 frames to be added, and re-send the "new" 30 frames. This is exceptionally difficult to do and often results in uneven motion, especially during fast-moving action in a film.

As part of its creation of PureDrive, Pioneer solved this issue by developing a custom, industry-exclusive IC that creates 3 full copies of each frame x 24 frames per second, for 72 progressive fps (72Hz). This is 3-3 pulldown, which synchronizes perfectly with the frame rate of film so there's no need to make interpolations. It's actually a far less complicated process that doesn't force the processors into guesswork. Now, film-based material on DVD, videotape, and even regular television will match the smooth, natural reproduction you'd see in a theater. Advanced PureCinema 3-3 pulldown - unequalled by other plasma display brands - will become the new industry standard.

## ADVANCED CONTINUOUS EMISSION II (ACE II)

Some of the most gripping movie moments come in low-light scenes. Most plasma panels don't properly reproduce all the detail in these dark scenes, leaving you thinking, "what was that?" and playing it over again. But the Elite PRO-1110HD and PRO-910HD overcome this: Advanced Continuous Emission II uses 10-bit processing to produce 1,024 gradation steps for each red, green, and blue cell, creating a palette of over 1.07 billion colors. This industry-leading technology gives you a wider range of hues and far more accurate reproduction.

## PURE COLOR FILTER II

The clear front of an Elite PureVision plasma display is actually a precisely machined, optical-grade glass panel. Besides offering high-impact protection, this glass panel acts as a color filter that increases the spectrum of light emitted by the plasma. With our Pure Color Filter II - an Elite exclusive - you'll see a fuller range of colors with a higher level of color accuracy than ever before. It also helps to increase contrast by limiting ambient light reflection, so it's ideally suited to your everyday viewing conditions. Our high-performance glass panels actually out-perform CRTs in color reproduction.

#### 10-BIT 3D Y/C SEPARATION

NTSC (analog) video images are comprised of two signals, luminance (brightness information, expressed as "Y") and chrominance (color information, expressed as "C"). When analog video is played back, the Y and C signals must be kept separate or they'll interfere with one another. The result is video noise in the form of the dreaded "dot crawl" - distracting, visible dots moving along the edges of images. To combat this, the Elite plasma displays include a PureDrive-powered processor that features 10-Bit 3D Y/C Separation, effectively keeping the Y and C signals separate. This feature enables a significant improvement to the integrity of the images.

#### DIGITAL AND MPEG NOISE REDUCTION

Digital video and MPEG video both use compression that can create unwanted noise. "Digital noise" often appears as a checkerboard pattern on solid images like the sky or skin. "MPEG noise", also known as "mosquito noise", appears as a fuzziness around the edge of an image. The Elite PRO-110HD and PRO-910HD are designed to greatly reduce both types of noise, for a higher level of realism.

#### NATURAL RE-SIZE

Many plasma displays allow the user to select a screen mode best suited to the material being viewed - for example, when watching a regular 4:3 TV show on a 16:9 widescreen monitor, the image can be stretched to fill the entire screen. But in nearly all plasma displays, that stretching process causes problems such as blocky, fuzzy, or over-stretched images. The Elite PRO-110HD and PRO-910HD have an industry-exclusive Natural Re-Size function that re-shapes the picture and allows it to maintain a natural appearance, without adding the artifacts that deteriorate picture quality.

#### DYNAMIC RANGE EXPANDER (D.R.E.)

So, you're watching a movie and an actress with jet-black hair is wearing a bright white shirt - a high-contrast situation that gives nearly all plasma displays trouble. Usually, if her hair color is a true black, her shirt will appear as a slightly dull off-white. Or, her shirt will be pure white but her hair isn't a true black. And, of course, it doesn't help to adjust your brightness because either the hair or the shirt will lose its true value. Enter Dynamic Range Expander (D.R.E.). With enormous processing power, D.R.E. manages to raise the values of both lights and darks, noticeably improving the contrast ratio and creating a more vivid presentation.

#### NATURAL ENHANCER

Another technology that the Elite PRO-110HD and PRO-910HD use to deliver such a stunningly sharp picture is Natural Enhancer, an industry first. On any source, analog or digital, PureDrive-powered Natural Enhancer cleans up those wavy Moire ("moray") patterns and enhances the contrast at the edges of images - rendering a clean, detailed picture.

#### DIGITAL COLOR TRANSIENT IMPROVEMENT (C.T.I.)

Run-of-the-mill plasma displays have a hard time accurately rendering a colored image laying over another colored image - for example a man in a dark blue jacket standing against a red wall. The usual result is a dithered pattern and an unwanted combination of colors where the two images intersect. Digital Color Transient Improvement (C.T.I.), a Pioneer PureDrive development, smoothes out edges of color images so that they're more distinct, and colors are reproduced more accurately.

#### DIGITAL CHROMA DECODER

Color noise is another form of analog video interference - noticeable speckled imperfections seen within solid colors on your screen. The Elite PRO-110HD and PRO-910HD feature a 10-bit Digital Chroma Decoder to reduce noise and provide better frequency response, for pure, clean colors.

PRO-1

#### COLOR MANAGEMENT

Exclusive to the Elite PRO-1110HD and PRO-910HD, Color Management enables greater control of colors, selectively boosting or scaling back values to match the actual image without affecting other colors on the screen. As you can imagine, this takes a lot of processing power, but it results in far more accurate reproduction. Two examples: Color Management will enhance a flowering tree without distorting the blue sky behind it; and facial skin tones will be reproduced more accurately without discoloring the subject's clothing.

#### MULTI-WINDOW DISPLAY

OK, admit it: sometimes you want to watch two shows at the same time. Picture In Picture (one full-screen image with a smaller image inset) has been around a long time, but now Multi-Window Display takes dual-material viewing to new levels: it lets you display any combination of HDTV, NTSC, and even a computer, either as twin images (50/50 split screen) or as Picture In Picture. Watch pro football on HDTV alongside fantasy football from your PC. Two college bowl games, two music specials...OK, you get the picture.\*

#### A MULTIMEDIA MONITOR FOR PC AND MAC

An Elite PureVision plasma display makes an exceptional monitor for a PC or Mac laptop

computer. The high-definition native resolution of our 50" models is 1280 x 768, and for 43" models it's 1024 x 768, so charts, graphs, the Web, and full-motion DVDs will all look clean and crisp. And of course you can display more than one source simultaneously, using either Picture-In-Picture or 50/50 split screen.\*

#### SELECTABLE SCREEN MODES

Whether you're watching regular (analog) television, a DVD, or an extreme wide-screen movie, all Elite PureVision models enable you to adapt the panel's image to the source, for optimal viewing.

#### FROM NTSC TO HIGH DEFINITION

With all Elite PureVision plasma displays, you'll be able to watch NTSC (analog) broadcasts, plus three types of ATSC digital broadcasts: Standard-, Enhanced-, and High-Definition. Because the Elite plasma panels feature true high-definition native resolution, everything you watch will be maximized for the highest quality, whether it's high-definition or NTSC. In fact, all Elite panels automatically up-convert video from any source - including regular TV - to 1280 x 768p (on the 50") or 1024 x 768p (on the 43") display.

Keep in mind: when a manufacturer says its plasma panel is "high-definition compatible",

this does not mean it has native resolution. It's a broadcast, so you'll get picture quality that's better than the panel's lower performance.

#### MEDIA RECEIVER SPEAKERS

The Elite PRO-1110HD high definition plasma system includes a media receiver, a set of speakers, and a color

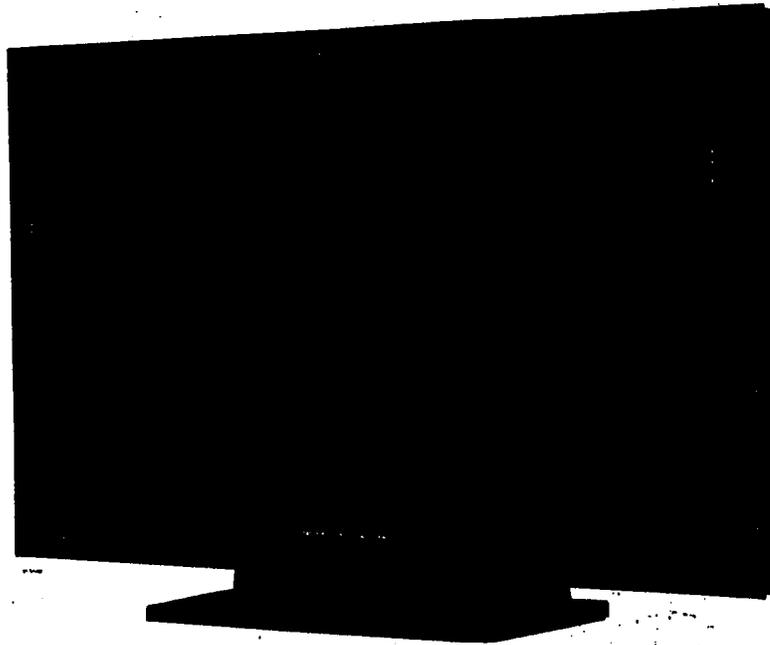
**Media Receiver:** This delivers both terrestrial (digital) and NTSC (analog) video connections for your computer. It offers connections for video and audio via the new HDMI, or Multimedia Interface,

**Speaker System:** Comes with 3-way speakers with side and two speakers are side or recessed. The television's WOW\*, further enhances options to include 3 bass reproduction.

**Stand:** New, stylish matching black finish. For optimal viewing

\* In order to maintain longevity, avoid taking when using a computer

# PRO-800HDI

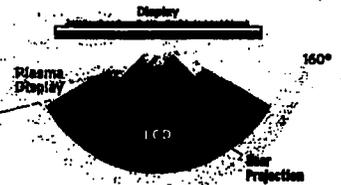


- HDMI Inputs with HDCP
- Automatic Format Conversion

- PureCinema II with 3:2 Pull Down
- Pure Color Filter

**HDMI**  
HIGH DEFINITION MULTIMEDIA INTERFACE

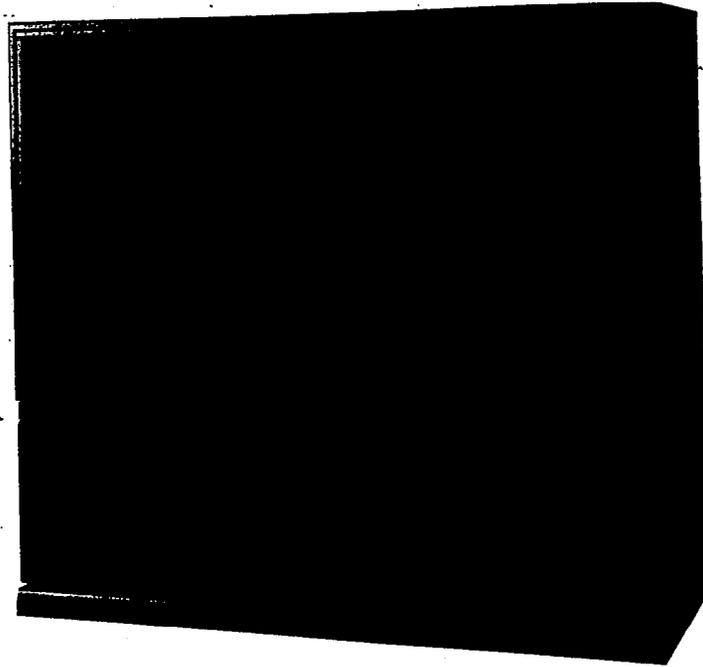
**PURE CINEMA II**



Wide field of view of more than 160°

**Wide-angle Viewing**

# PRO-730HDI



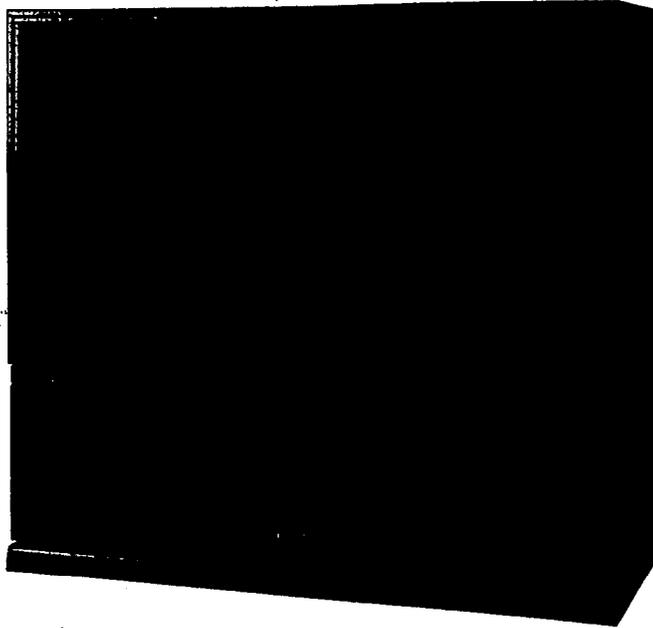
- Certified ISF C<sup>2</sup> Modes
- Reference Theater and Pro Modes
- PureCinema III™ Format Converter
- Scratch Resistant Anti-Reflective Panel



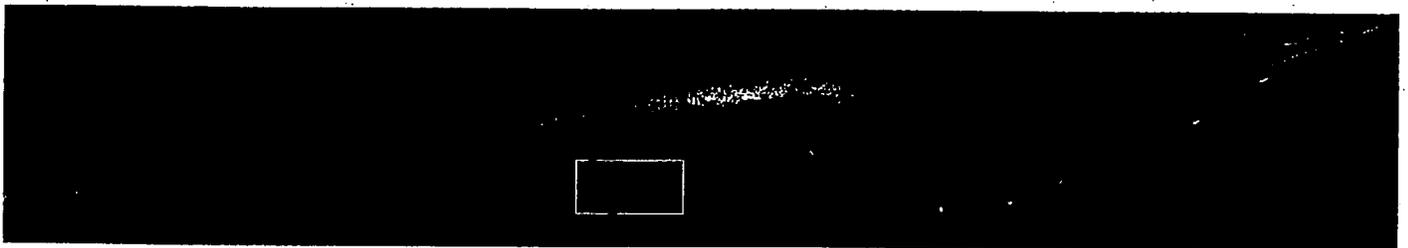
Blue Achromatic Lens



# PRO-530HDI



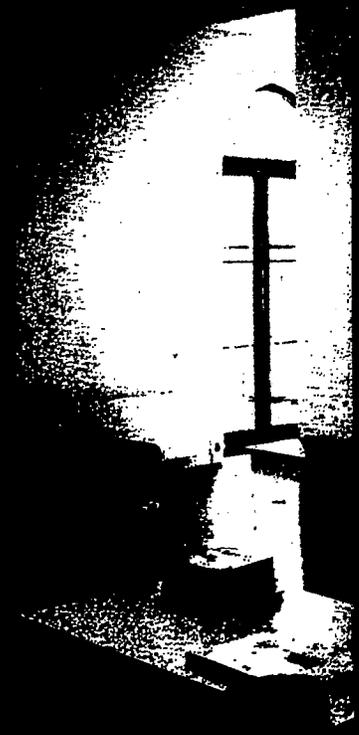
- Certified ISF C<sup>2</sup> Modes
- Reference Theater and Pro Modes
- PureCinema III™ Format Converter
- Scratch Resistant Anti-Reflective Panel



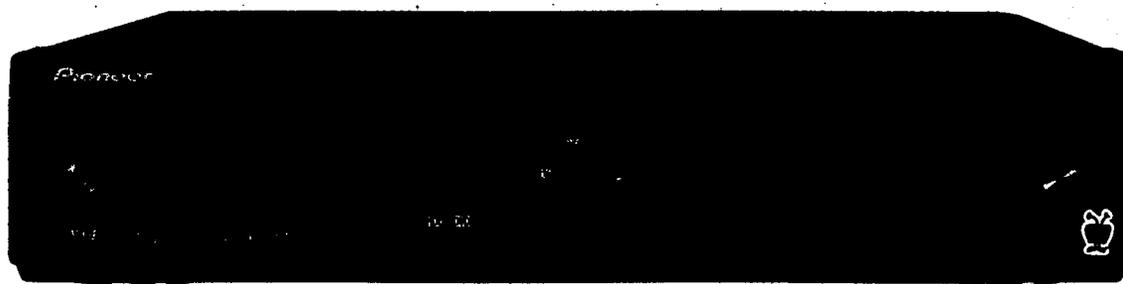
Standard 0.72 mm Lenticular Screen

Elite Ultra-Fine 0.52 mm Lenticular Screen

ere's the next generation in DVD recording and playback.



# DVR-57H



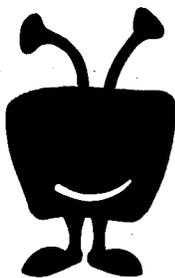
- 120GB Hard Disc Drive (Maximum 123 Hours Recording Capacity)

- Double-Layered Chassis

- TiVo Basic™ Service Included; Upgradeable to TiVo Plus™ Service\*

- 3:2 Progressive Scan with Faroudja DCDI Processing

## TiVo Basic™ Service



The DVR-57H is a world's first, combining a DVD Recorder and the revolutionary TiVo Basic™ Service in one component. TiVo is by far the most popular of the "Digital Video Recorder" (DVR) services, and its integration with the DVR-57H makes a very powerful combination.

With the DVR-57H and TiVo,™ you can Find, Store, and Burn what you want, when you want.

**Find It:** The simple-to-use TiVo service will let you search for, find, and select individual TV programs to record. That way, you're in charge. So, no matter how busy you are, you'll never miss your favorite shows.

**Store It:** The 120GB hard drive provides up to 123 hours of temporary storage. Record a show tonight, watch it tomorrow or next week. Plus, you can actually control Live TV: pause it, reverse it, play it in slow motion. You can even watch a recorded program from the beginning, while the recorder simultaneously finishes the recording. All of these functions are very simple to use.

Actual recording capacity varies depending upon the type of programming being recorded.

**Burn It:** Programs stored on the hard drive can then be copied onto a DVD. You can create an extensive DVD library of your favorite movies, shows, sporting events, even your own home movies, that can be played in most DVD players.

### WITH TIVO, THERE'S NO GOING BACK

Once you experience the TiVo conveniences delivered by the DVR-57H, there's no going back to the old way of watching and recording TV. Here are a few additional TiVo features:

- Schedule and then record programs on the hard drive while playing a DVD.
- Play programs from the hard drive while recording a different program from the hard drive to a DVD.
- Watch a program from the beginning while the recorder simultaneously finishes the recording.
- Transfer content at high speeds from the hard drive to a DVD for long-term storage.

### GETTING STARTED WITH TIVO

- TiVo Basic™ service is included with the DVR-57H; you don't have to do anything else and there's no fee. Once you make

the necessary connections, the TiVo interface appears on your display.

- TiVo Set-up uses an easy on-screen navigator that walks you through the process, which initially takes only about one hour.
- Whether you get your TV signal via cable, digital cable, satellite, antenna or a combination thereof, TiVo has you covered. It holds a database of over 13,000 channels covering the United States. (To use both satellite and cable at the same time, an upgrade to the TiVo Plus™ service is required. For more on TiVo Plus™, please see the following section entitled "The TiVo Plus™ upgrade.")
- Once it knows what channels you receive, TiVo lets you find the programs you want to view or record. The DVR-57H includes connections for telephone and broadband so that program guide information for the next three days can be updated on a regular basis (the DVR-57H contacts TiVo for updates automatically).

### THE TIVO PLUS™ UPGRADE\*

For even more convenience and flexibility, a higher level of TiVo service is available. Called TiVo Plus™, it offers these additional programming features:

- **14-day Program Guide Data:** Provides programming data for the next 14 days – vs. 3 days with TiVo Basic™ – so finding future shows and selecting them for

10:30

11:14

11:30

Status Bar

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

PIONEER KABUSHIKI KAISHA d/b/a )  
PIONEER CORPORATION, )

Opposer, )

v. )

NISSEI SANGYO AMERICA, LTD. n/k/a )  
HITACHI HIGH TECHNOLOGIES AMERICA, )  
INC., )

Applicant. )

Opposition No. 91125458

Mark: SUPERSCAN ELITE

Serial No.: 76/208,230

Published: March 19, 2002

**NOTICE OF DEPOSITION OF ROBERT L. KLEIN**

TO: Robert L. Klein  
c/o Skousen & Skousen  
12400 Wilshire Boulevard, Suite 900  
Los Angeles, California 90025-1060

Please take notice that at 10:00 a.m. on May 20, 2004 at the Offices of Cantugno Court Reporting, 10 Commercial Wharf, Fifth Floor, Boston, Massachusetts 02110, Applicant Hitachi High Technologies America, Inc. ("Hitachi") will take the deposition of Robert L. Klein. The deposition will take place pursuant to the applicable statutes and rules of procedure, and before a notary public or other person authorized to administer oaths.

Date: May 10, 2004

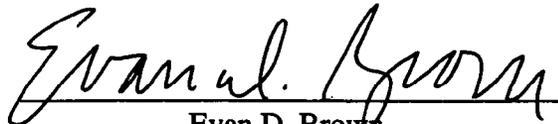
William T. McGrath  
Evan D. Brown  
DAVIS, MANNIX & McGRATH  
125 South Wacker Drive, Suite 1700  
Chicago, Illinois 60606-4402  
(312) 332-3033 (phone)  
(312) 332-6376 (fax)

**Nissei Sangyo America, Ltd., n/k/a Hitachi  
High Technologies America, Inc.**

  
By One of Its Attorneys

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing NOTICE OF DEPOSITION OF ROBERT L. KLEIN is being sent via facsimile to 310-782-9579 and by U.S. Mail, first class postage prepaid, in an envelope addressed to: Robert J. Skousen, Esq., SKOUSEN & SKOUSEN, 12400 Wilshire Blvd., Suite 900, Los Angeles, California 90025-1060 on **May 10, 2004**.

  
Evan D. Brown

SKOUSEN & SKOUSEN  
A PROFESSIONAL CORPORATION  
SUITE 900  
12400 WILSHIRE BOULEVARD  
LOS ANGELES, CALIFORNIA 90025-1060  
TELEPHONE (310) 277-0444  
TELECOPIER (310) 782-9579

June 15, 2004

Via Facsimile (312) 332-6376 & U.S. Mail

William T. McGrath, Esq.  
Davis, Mannix & McGrath  
125 South Wacker Drive, Suite 1700  
Chicago, Illinois 60606

Re: Pioneer Corp. v. Hitachi High Technologies America, Inc., etc.  
TTAB Opposition Number 125,458

Dear Mr. McGrath:

We have received your letters of May 28, 2004 and June 14, 2004 regarding your informal request for additional documents from our expert Robert Klein. After having given the request consideration and researching this particular issue, we feel that your request is not well taken for several reasons.

TTAB Manual of Procedure, Section 404.03 (b) (2) states in relevant :

"If a proposed deponent residing in the United States is not a party, or a person who, at the time set for the taking of the deposition, is an officer, director or managing agent of a party, or a person designated under FRCP 30 (b)(6) or 31 (a)(3) to testify on behalf of a party, **the responsibility rests wholly with the deposing party to secure the attendance of the proposed deponent.**"

Thus, had there been no agreement to produce Mr. Klein for deposition, you would have had to subpoena him for the appearance for his deposition. It is axiomatic that the same would be true for the documents which you informally request in your correspondence. We note specifically that not only did you not subpoena these documents, you did not even request them in the notice of Mr. Klein's deposition. We further note that, at no time during the deposition of Mr. Klein, did you ever ask to see these documents, review them or reserve any right to continue the deposition of Mr. Klein after having reviewed these documents. Your failure, in hindsight, to properly undertake the discovery which you belatedly realize as important, does not justify your request - which came by way of faxed letter approximately 4 hours prior to the close of the discovery period.

Your attention is directed to the case of Smith v. Transducer Technology, (2000) 2000WL 1739217. That case specifically dealt with the issue of an expert witnesses' failure to bring documents to his deposition, which were **actually** requested by opposing counsel in their amended

William T. McGrath, Esq.  
Davis, Mannix & McGrath  
Page 2  
June 15, 2004

notice of expert deposition. The court specifically held that: **"The procedure for compelling production of documents at a deposition depends on whether the deponent is or is not a party. If the deponent is not a party, production of the documents can be compelled only by a subpoena duces tecum issued under Rule 45...With regard to non-parties, such as Plaintiff's expert witness, a request for documents may be made by subpoena duces tecum pursuant to Rule 45."** (Emphasis added)

The court also noted that **"If the production is to occur at a deposition, the designation of the materials to be produced pursuant to the subpoena must be attached to or included in the notice of the deposition."** (Emphasis added). Your deposition failed to include designation of any materials to be produced. This case makes it abundantly clear that in order for you to have obtained any documents whatsoever from Mr. Klein, it was incumbent upon you to subpoena them. For reasons, known only to yourself, you chose not to proceed in that manner.

Your request is further unjustified by your own delays in this case. As you know, our office identified Robert Klein as our expert some time ago. Thereafter, Mr. Klein's report was provided to you. In that report, Mr. Klein identified all of the documents which you apparently now seek - although the report summarized those documents. You then noticed and took the deposition of Mr. Klein in which he discussed those documents. You still waited an additional eight days after the deposition before sending your informal request for these documents, only hours before the discovery period closed. Your request is inappropriate and unreasonable on that ground as well.

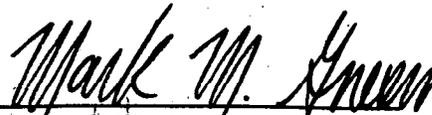
Finally, we note that you have sent an informal request to us for the documents referenced in this letter. You have not properly subpoenaed the documents as required by FRCP 45. Based upon the manner in which you have chosen to approach discovery in this proceeding and your obvious tactics, we decline to voluntarily provide you with the documents in question. The information is already in your possession via Mr. Klein's report.

I trust you understand our position in this matter.

Very truly yours,

SKOUSEN & SKOUSEN  
A Professional Corporation

By:

  
Mark M. Gnesin

MMG:mg

## ➔Rule 45. Subpoena

## CREDIT(S)

(As amended Dec. 27, 1946, eff. Mar. 19, 1948; Dec. 29, 1948, eff. Oct. 20, 1949; Mar. 30, 1970, eff. July 1, 1970; Apr. 29, 1980, eff. Aug. 1, 1980; Apr. 29, 1985, eff. Aug. 1, 1985; Mar. 2, 1987, eff. Aug. 1, 1987; Apr. 30, 1991, eff. Dec. 1, 1991.)

## PRACTICE COMMENTARIES

*by David D. Siegel*

## TABLE OF CONTENTS

## C45-1. Introductory.

Rule 45 of the Federal Rules of Civil Procedure governs subpoena practice in the federal courts, as to both deposition subpoenas and subpoenas used for the trial or hearing itself. It prescribes on matters of issuance right through matters of enforcement.

Rule 45 was extensively amended in 1991, effective December 1st of that year. Because of that, the ensuing Commentaries, in treating the rule generally, will stress changes made by the 1991 amendment.

A subpoena, like a summons, is a jurisdiction-getting paper. The summons secures jurisdiction of a defendant in an action, subjecting the defendant to the jurisdiction of the court so that any judgment that may be rendered in the action will bind the defendant. The mission of the subpoena is to secure jurisdiction of a witness, who is usually not a party to the action, so as to obtain from the witness testimony or documents (or other things) needed by one of the parties.

The incentive of the summoned defendant is to appear in the action so as to avoid a default judgment. The incentive of the subpoenaed witness is to obey the subpoena so as to avoid punishment for contempt, the sanction that backs a subpoena. See Commentary C4-26 below.

There are two kinds of subpoenas. The common one that seeks the testimony of the witness is usually referred to simply as a "subpoena". Its full Latin name is "subpoena ad testificandum". The other one is the "subpoena duces tecum", which usually keeps its Latin name in practice to distinguish it from the testimonial subpoena. The subpoena duces tecum seeks documents and other tangible things instead of testimony. If both testimony and things are sought from the same person, a single subpoena, containing both testificandum and duces tecum clauses, can be used. The form presently used is a simplified one in which the user need merely check off the applicable boxes and fill in the appropriate blanks. Commentary C45-2, below, discusses the form.

As a general rule a subpoena is used only on a nonparty. (A party can of course be subpoenaed, too, if need be.) A mere notice or request ordinarily suffices to get testimony or things from a party, with the sanctions of Rule 37 of the Federal Rules of Civil Procedure standing by to assure the party's compliance.

Rule 37 is a component of the "Depositions and Discovery" segment (Part V) of the Rules, embracing Rules 26-37. That part interplays with Rule 45 frequently, an interplay that will be noted at a number of junctures in the ensuing Commentaries. Rule 34, for example, in requiring the production of documents and other tangibles, applies only against a party. It is Rule 45 that must be turned to when those things are sought from a nonparty. The 1991 amendment of subdivision (c) of Rule 34 recognizes this with a cross-reference to Rule 45. See Commentary C45-6 below.

2000 WL 1739217 (D.Virgin Islands)  
Only the Westlaw citation is currently available.

District Court of the Virgin Islands, Division of St. Croix.  
Paul K. SMITH, Plaintiff,

v.

TRANSDUCER TECHNOLOGY, INC. Endeveco Corporation and Meggitt-USA, Inc.  
Defendants  
No. Civ.1995/28.  
May 19, 2000.

ORDER DENYING PLAINTIFF'S MOTION FOR SANCTIONS

RESNICK, Magistrate J.

\*1 THIS MATTER came for consideration on Plaintiff's Motion for Sanctions. Defendant's filed a response in opposition to the motion and Plaintiff filed a response to such opposition.

At issue is the failure of Defendants' expert witness, Carmelo Rivera, to bring to his deposition (on 4/25/00) documents that were requested in Plaintiff's First Amended Notice of Expert Deposition dated April 19, 2000. Plaintiff contends that such documents must be produced pursuant to a Notice of Deposition [Fed.R.Civ.P. 30(b)(5)]. Defendant argues that production of documents from non-parties may only be compelled by subpoena *duces tecum* [Fed.R.Civ.P. 45(a)(1)(c)]. Plaintiff retorts that subpoenas may not be issued to an opponent's retained witness pursuant to "Rule 26."

The 1970 Advisory Committee notes to Fed.R.Civ.P. 30(b)(5) state:

A provision is added to enable a party through service of notice, to require another party to produce documents or things at the taking of his deposition. This may now be done as to a non-party deponent through use of a subpoena *duces tecum* as authorized by Rule 45.

As stated in Wright, Miller & Marcus, Federal Practice and Procedure: Civil 2d § 2108:

The procedure for compelling production of documents at a deposition depends on whether the deponent is or is not a party. If the deponent is not a party, production of the documents can be compelled only by a subpoena *duces tecum* issued under Rule 45. As amended in 1991, Rule 45(a)(1)(C) now authorizes a subpoena to command production of documents at a deposition or without a deposition. If the production is to occur at a deposition, the designation of the materials to be produced pursuant to the subpoena must be attached to or included in the notice of the deposition. If the production is to occur without a deposition, Rule 45(b)(1) requires that prior notice be given to the other parties.

The cases cited by Plaintiff do not establish that Plaintiff may compel documents from an expert witness by notice of deposition absent subpoena, nor that such documents may not be obtained by subpoena *duces tecum*. In *Encarnacion v. Kmart Corp.* [FN1] D.Ct. STX Civ.1997/63 (order dated 5/4/00), the issue concerned a letter request for documents sent by opposing counsel to an expert witness who was also a treating doctor.

FN1. Henceforth, when citing an unpublished local order, Plaintiff's attorney must identify the case by civil number and the order by date. There have been numerous orders entered in Encarnacion and it was time consuming for the court (and nigh impossible for Defendants) to locate such order.

Fed.R.Civ.P. 34(c) expressly provides that "A person not a party to the action may be compelled to produce documents and things ... as provided in Rule 45."

With regard to non-parties, such as Plaintiff's expert witness, a request for documents may be made by subpoena *duces tecum* pursuant to Rule 45.

All West Pet Supply Co. v. Hill's Pet Products Div. 152 F.R.D. 634, 639 (D.Kan.1993). See also e.g. Oneida Ltd. v. U.S., 43 Fed. Cl. 611, 613 (U.S.Ct.Fed.Claims, 1999). The tension between Rule 45 and Rule 26(b)(4) was analyzed in Marsh v. Jackson, 141 F.R.D. 431, 432-33 (W.D.Va.1992). The court held that a "naked" subpoena *duces tecum* issued without request for deposition may not be served on an expert witness, noting that "[i]n conjunction with that deposition, the expert might be served also with a Rule 45 subpoena *duces tecum* requiring him to produce a designated list of

materials or things." That analysis appears cogent and is adopted by this Court.

\*2 Plaintiff has not demonstrated any basis for Defendants' expert witness to have produced documents at his deposition pursuant to Plaintiff's Notice of Deposition without an accompanying subpoena *duces tecum* in accordance with Rule 45(a)(1)(c). That Defendants may have previously issued equivalent notices for production does not compel otherwise. [FN2]

FN2. The parties are nonetheless encouraged to cooperate in facilitation of discovery and may by agreement utilize simplified procedures.

Accordingly, there is no basis for sanctions. Because the issues merit consideration, there is also no basis for costs to be awarded.

Upon consideration, it is hereby;

ORDERED as follows:

1. Plaintiff's Motion for Sanctions is DENIED.
2. Defendants' request for costs is DENIED.

D.C.V.I.St.Croix.Div., 2000.

Smith v. Transducer Technology, Inc.

2000 WL 1739217 (D.Virgin Islands)

END OF DOCUMENT

Copr. (C) West 2004 No Claim to Orig. U.S. Govt. Works

2004 WL 406999 (N.D.Ill.)

Only the Westlaw citation is currently available.

United States District Court,  
N.D. Illinois, Eastern Division.  
EXPEDITORS INTERNATIONAL OF WASHINGTON, INC., a Washington corporation, and  
Expeditors Tradewin, L.L.C., a Washington limited liability company,  
Plaintiffs,

v.

VASTERA, INC., a Delaware corporation, Vastera Solution Services Corporation, a  
Delaware corporation, and Jennifer Sharkey, an individual, Defendants.

No. 04 C 0321.

Feb. 26, 2004.

Paul D. Cranley, Wildman, Harrold, Allen & Dixon, Chicago, IL, Ali Reza Sharifahmadian, Michael C. Augustini, Arnold & Porter, Washington, DC, for Defendants.

**MEMORANDUM OPINION AND ORDER**

ZAGEL, J.

Underlying Action Pending in United States District Court for the Eastern  
District of Michigan, Docket No. 01-71000. (Borman, J.).

*Introduction*

\*1 In March 2001, Expeditors International of Washington, Inc., *et al.* (collectively "Expeditors") filed a trade secret misappropriation action against Vastera, Inc. *et al.* (collectively "Vastera") in the United States District Court for the Eastern District of Michigan. Louis G. Dudney is Expeditors' designated expert on damages issues in the lawsuit. On May 2, 2003, Dudney signed a Federal Rule of Civil Procedure 26 report rendering his opinion that Expeditors has "suffered" more than \$20 million in damages as a result of Vastera's alleged misappropriation of trade secrets. To buttress his damages opinion against Vastera, Dudney touted his qualifications and professional experience in various types of litigation, including intellectual property litigation. As required by Rule 26(a)(2)(B), Dudney also provided Vastera with a listing of his recent trial and deposition testimony. In light of Dudney's claimed intellectual property experience, Vastera promptly requested in a letter dated May 15, 2003, the production of Dudney's prior testimony and reports in trade secret and patent infringement litigations. When Dudney did not produce the requested materials, Vastera served him with a subpoena *duces tecum* on August 27, 2003. [FN1] In addition to several other requests not at issue here, the subpoena included the following two requests:

[FN1]. As a designated expert, Dudney agreed to abide by the protective order entered by the Michigan Court in the underlying litigation, which by its terms covers responses to subpoenas *duces tecum*. Vastera's counsel advised Dudley that he could designate as confidential any materials he produced pursuant to Vastera's subpoena under the protective order. Moreover, Vastera's counsel made it clear that Vastera was not interested in using any confidential business information that might be contained in Dudney's prior reports and testimony, and that Vastera's counsel was willing to review redacted materials and then consider whether there was a need for further information from Dudney. For months, Dudney's counsel rejected Vastera's offers, asserting that "it was not feasible" to redact portions of the reports, and thus Dudney, as of November 2003, produced nothing in response to Requests No. 6 and 7. Shortly before Vastera filed the instant motion to enforce the subpoena, Dudney made an incomplete production of redacted *plaintiff* reports from selected prior matters.

6. All transcripts of the deposition testimony, trial testimony, and/or expert reports of Louis G. Dudney, in any matter involving allegations of trade secret misappropriation during the past ten years.

7. All transcripts of the deposition testimony, trial testimony, and/or expert reports of Louis G. Dudney, in any matter involving allegations of patent infringement during the past five years.

The subpoena was issued by the United States District Court for the Northern District of Illinois, Eastern Division, and directed Dudney to produce the requested materials by September 15, 2003. [FN2] He made no production by that response date.

FN2. Because Dudney is based in Chicago, the subpoena properly issued from this Court under the signature of Vastera's counsel. See Fed.R.Civ.P. 45(a)(2) & (3).

In the ensuing four months after the subpoena's issue, Vastera made a good faith effort, pursuant to Rule 37(a)(2)(B), to encourage Dudney to comply with the subpoena without a court order. After the deadline for objections as well as the deadline for production had passed, Vastera requested by letter dated September 18, 2003 that Dudney immediately comply with the subpoena. It was then suggested that Dudney would produce at least some responsive materials, but despite Vastera's additional follow up efforts, Dudney produced no prior reports or testimony.

On October 20, 2003, Dudney's counsel represented that Dudney might be willing to produce his prior expert reports and testimony without a motion to compel, and so the attorney requested an additional ten days for Dudney to contact the clients. Yet ten more days passed, and Vastera again received no response from either Dudney or his counsel.

On November 7, 2003, Vastera again inquired why Dudney had not produced his prior reports and testimony, as required by subpoena, and advised Dudney's counsel that further delays would not be acceptable. In response, Dudney again requested additional time, and Vastera agreed to give Dudney another week to comply with the subpoena. But another week came and went, and Dudney did not comply.

\*2 Vastera followed up with another letter on November 20, 2003 advising that it would have no choice but to proceed with a motion to compel and for sanctions should Dudney refuse to provide concrete assurances that he would produce the requested materials. Dudney's counsel replied by email on the same day, confirming that Dudney had provided his prior reports and testimony to Expeditors' counsel prior to the September 15 response date of the subpoena and further representing that "[Expeditors' counsel] acknowledges that he did not make a timely production." Nonetheless, Dudney refused to produce the materials requested. Accordingly, Vastera filed the instant motion, pursuant to Rule 37 and Rule 45, to enforce the subpoena *duces tecum* against Dudney and to request that Dudney be ordered to pay all expenses associated with the motion should Vastera prevail.

#### *Motion to Enforce Subpoena Duces Tecum*

As noted above, Expeditors has sued Vastera for trade secret misappropriation, and based on the damages opinion proffered by Dudney, Expeditors claims more than \$20 million in damages. To defend against these claims, Vastera is entitled to explore the purported factual and legal bases of Dudney's damages opinions as well as potential inconsistencies between the views he intends to express in the underlying case and the testimony and opinions he has given, and the damages theories and methodologies he had adopted, in his prior trade secret and patent cases. See Fed.R.Civ.P. 26(b)(1) (authorizing parties to obtain discovery regarding "any matter, not privileged, that is relevant to the claim or defense of any party"); Ortiz-Lopez v. Sociedad Espanola de Auxilio Muto y Beneficiencia de P.R., 248 F.3d 29, 34-35 (1st Cir.2001) (holding that an expert's credibility and qualifications, including prior testimonial experience in cases involving similar claims, was "directly at issue" and affirming the preclusion of expert's testimony for failing to make a timely disclosure of the cases in which the expert previously had testified). Indeed, Rule 26(a)(2)(B) now requires that an expert report contain a complete listing of any other cases in which the witness has testified as an expert at trial or by deposition within the preceding four years, and the Advisory Committee notes authorize the pursuit of an expert's prior testimony even beyond the four year period for which a listing is required. Advisory Comm. Notes for 1993 Amendments to Fed.R.Civ.P. 26(a). Accordingly, Vastera's requests for copies of the transcripts of Dudney's deposition testimony, trial testimony, and expert reports in trade secret during the past ten years and patent matters during the past five years are within the bounds of permissible discovery. See Western Res., Inc. v. Union Pac. R.R. Co., No. 00-2043-CM, 2002 WL 1822428, at \*3 (D.Kan. July 23, 2002) (ordering testifying expert to produce prior testimony from other litigations, administrative proceedings, and arbitrations that related to the subject matter or his opinions in the underlying action, as well as documents considered in forming those prior opinions); Ladd Furniture, Inc. v. Ernst & Young, No.

2:95CV00403, 1998 WL 1093901, at \*10-11 (M.D.N.C. Aug.27, 1998) (compelling production of prior expert reports and prior deposition and trial testimony dating back six years).

**\*3** Regarding any opposition from Dudney, Vastera argues that Dudney waived all objections to the subpoena by failing to object within 14 days of service, and that he thus has no basis to refuse to produce the requested materials. In response, Dudney argues that the 14-day time limit in which to object does not apply to those objections that relate to information subject to a privilege or other prohibition on disclosure, citing Vente v. Datronic Rental Corp., No. 92 C 3289, 1995 WL 42345, at \*4 (N.D.Ill. Feb.2, 1995). This argument regarding waiver of objections may be irrelevant in light of the fact that a party cannot waive certain discovery protections. See Ludwig v. Pilkington North America, Inc., No. 03 C 1086, 2003 WL 22242224, at \*3 (N.D.Ill. Sept.29, 2002). More importantly, this discussion is irrelevant because considering Dudney's objections on the merits, I find that they are not valid.

Dudney first argues that the motion should be denied because a document discovery regarding a party's testifying expert must proceed against that party under Rule 26 and the appropriate provisions of Rule 34, not through the use of a subpoena *duces tecum* directed to the expert under Rule 45. He points out that subpoenas issued under Rule 45 may not be used to circumvent the limitations on expert discovery set forth in Rule 26, citing Marsh v. Jackson, 141 F.R.D. 431, 432 (W.D.Va.1992). However, a subpoena *duces tecum* issued pursuant to Rule 45 is an appropriate discovery mechanism against nonparties such as a party's expert witness. Fed.R.Civ.P. 34(c) ("A person not a party to the action may be compelled to produce documents and things ... as provided in Rule 45"); All W. Pet Supply Co. v. Hill's Pet Prods. Div., 152 F.R.D. 634, 639 (D.Kan.1993) ("With regard to nonparties such as plaintiff's expert witness, a request for documents may be made by subpoena *duces tecum* pursuant to Rule 45."); Western Res., 2002 WL 1822428, at \*3 (ordering expert to produce testimony pursuant to Rule 45 subpoena). Dudney's reliance on Marsh in support of the proposition regarding a blanket prohibition against serving document subpoenas on experts is misplaced. At most, Marsh criticizes the service of subpoenas on experts to obtain information pertaining directly to the party, but it does not prohibit the use of a subpoena "to uncover information about other cases" in which an expert has served. Thomas v. Marina Assocs., 202 F.R.D. 433, 434 (E.D.Pa.2001) (denying motion to quash subpoenas directed to expert); Quaille v. Carol Cable Co., Civ. A. No. 90-7415, 1992 W: 277981, at \*2 (E.D.Pa. Oct. 5, 1992) (discussing Marsh and granting motion to compel discovery regarding expert's opinions pursuant to subpoena). Unlike the Marsh case, Vastera is not seeking to circumvent the normal discovery process by pursuing from Dudney information relating to Expeditors, the party in the underlying action. Rather, as in Thomas, Vastera is attempting to uncover information regarding Dudney's damages opinions in his prior trade secret and patent cases. Accordingly, Rule 26 does not prohibit the use of a subpoena in this situation.

**\*4** Dudney also argues that the motion should be denied because the subpoena was improperly issued during a stay of discovery in the underlying action in Michigan. However, I find no legal support for the argument that an expired stay in discovery requires the denial of a motion to compel compliance with a subpoena issued during the stay. See In re Air Crash Disaster, 130 F.R.D. 627, 630 (E.D.Mich.1989). In addition, even if there was a stay at some point, it is undisputed that there presently is no stay in the underlying action and thus no prohibition against Vastera seeking this discovery from Dudney at this time.

Dudney further argues that the propriety of the discovery requests should be decided by the Michigan Court. In Kearney v. Jandernoa, 172 F.R.D. 381 (N.D.Ill.1997), this Court faced a scenario that is nearly identical to the one presented here. However, as the Court in Kearney recognized, a motion dealing with a subpoena "must be filed and decided in the court from which the subpoena issued," so the approach in Kearney--namely deferring to the decision of the Michigan Court--cannot be used here. *Id.* at 383 n. 4.

Finally, Dudney argues that the motion to compel should be denied because protective orders in his other engagements preclude him from complying with the subpoena. As a general rule, however, protective orders should not be used as shields to resist the production of relevant information even when the information is considered to be confidential. See Jepson, Inc. v. Makita Elec. Works, Ltd., 30 F.3d 854, 859-60 (7th Cir.1994). There is a strong presumption that pretrial discovery must take place in public, and it is Dudney's burden to prove with specific evidence that his prior reports and testimony should be afforded some protection. *Id.*, see also Andrew Corp. v. Rossi, 180 F.R.D. 338, 341-42 (N.D.Ill.1998) (noting that protective orders are designed to encourage apprehensive litigants to produce responsive materials and should not be used as an excuse to avoid discovery).

Dudney's conclusory and unsupported assertions are insufficient for me to exempt prior reports and testimony from discovery, but even if I find that some confidentiality protection is warranted, this cannot serve as a proper basis to deprive Vastera of this discovery. See Western Res., 2002 WL 1822428, at \* 3 (rejecting expert's protective order argument and ordering expert to produce prior testimony).

In the end, I see no reason to deny the instant motion. Accordingly, Dudney is hereby ordered to produce without further delay all materials responsive to Requests Nos. 6 and 7 in Vastera's subpoena.

*Motion for Sanctions*

Rule 37(a)(4) "presumptively requires" every loser to pay the attorneys' fees and costs that the prevailing party incurred in connection with a motion to compel. Rickels v. City of South Bend, 33 F.3d 785, 786-87 (7th Cir.1994). In this case, by requiring a motion to compel in order to obtain materials that he should have produced voluntarily, Dudney engaged in sanctionable conduct under Rule 37(a)(4). Illinois Tool Works, Inc. v. Metro Mark Prods., Ltd., 43 F.Supp.2d 951, 960 (N.D.Ill.1999). In addition to having no valid objection to complying with the subpoena, Dudney has failed to make timely objections to the requests, failed to timely seek a protective order if one was needed, ignored the response date of the subpoena, and still has not produced the materials requested. Accordingly, I find that it is entirely appropriate to order Dudney to reimburse Vastera for its fees and costs. See Sparks Tune-Up Ctrs., Inc. v. Strong, No. 92 C 5902, 1994 WL 87458, at \*3 (N.D.Ill. March 16, 1994) (granting motion for sanctions where party should have lodged objections or sought a protective order, but instead let deadlines pass). Vastera is instructed to submit a bill of costs detailing the fees and costs incurred in connection with this motion, to which Dudney will have an opportunity to respond.

**\*5** For the reasons above, Vastera's Motion to Enforce Subpoena *Duces Tecum* against Louis G. Dudney and for Sanctions is GRANTED.

N.D.Ill.E.Div., 2004.

Expeditors International of Washington, Inc. v. Vastera, Inc.

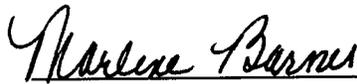
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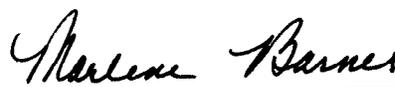
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Marlene Barnes

CERTIFICATE OF SERVICE

I, hereby certify that the foregoing Opposser's (1) MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT OF OPPOSSER'S OPPOSITION TO APPLICANT'S MOTION TO COMPEL PRODUCTION OF SURVEY DOCUMENTS; (2) DECLARATION OF ROBERT SKOUSEN; and (3) DECLARATION OF MARK GNESIN is being deposited with the United States Postal Service, first class postage prepaid, in an envelope addressed to Mr. William T. McGrath, DAVIS, MANNIX & McGRATH, Attorneys at Law, 125 South Wacker Drive, Suite 1700, Chicago, IL 60606-4402 on July 27, 2004.

  
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Marlene Barnes