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

In the Matter of Application Serial No. 75/457,081: MISCELLANEOUS DESIGN  
(Bezel)

Published in the Official Gazette of June 5, 2001 in International Class 9

OLD WORLD INDUSTRIES, INC., )  
 )  
 and )  
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 SPLITFIRE INTERNATIONAL, INC. )  
 )  
 Opposers )  
 )  
 v. )  
 )  
 AUTO METER PRODUCTS, INC., )  
 )  
 Applicant. )



08-19-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #70

Opposition No. 150,094

TRADEMARK TRIAL AND  
APPEAL BOARD  
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MOTION TO COMPEL

In accordance with Fed. R. Civ. P. 37 and Rule 2.120 of the Trademark Rules of Practice, Opposers, Old World Industries, Inc. and SplitFire International, Inc., move for entry of an order: (1) compelling applicant to produce its retained expert witness, John Bunge, for a further discovery deposition to answer certain questions that applicant's counsel improperly instructed Mr. Bunge not to answer, or, in the alternative, for an order barring applicant from introducing or relying on Mr. Bunge's testimony in this proceeding; (2) requiring production of all documents relating to the matters on which Mr. Bunge was improperly instructed not to answer; (3) re-opening the discovery period for sixty (60) days following the Board's ruling on this motion to allow time to conduct the discovery deposition of Mr. Bunge and any necessary follow-up discovery; and (4) rescheduling the testimony periods to reflect the re-opening of the discovery period.

**Certificate of Mailing**  
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, Attn: BOX TTAB NO FEE, 2900 Crystal Drive, Arlington, Virginia 22292-3513 on August 14, 2002.  
*M. J. [Signature]*

**I. INTRODUCTION AND STATEMENT OF RULE 2.120 COMPLIANCE**

On June 28, 2002, opposer took the deposition of John Bunge, identified by applicant as an expert witness on whose testimony applicant would rely in this proceeding.<sup>1</sup> Mr. Bunge conducted a survey on behalf of applicant concerning applicant's claim that the design shown in Trademark Application No. 75/457,081 had acquired secondary meaning as a trademark.

During Mr. Bunge's deposition, applicant's counsel objected to questions asking him if he has conducted other surveys either: (a) on behalf of Auto Meter; or (b) related to Old World or SplitFire. (Bunge dep. at 21:20-24, 22:1-24, 23:1-5 (Ex. 1)). Applicant's counsel claimed that such information was subject to protection as attorney work product and instructed the witness not to answer. (Bunge dep. at 21:20-23, 22:16-18 (Ex. 1)).

Opposers' counsel objected to applicant's counsel's instructions to Bunge and invited applicant's counsel to withdraw the objection and permit Bunge to answer the questions put to him. Applicant's counsel refused to do so. Opposers' counsel subsequently telephoned applicant's counsel to invite applicant to withdraw the objection, and applicant's counsel refused to do so. Opposers have therefore attempted to resolve the deficiencies with applicant without the Board's intervention pursuant to 37 CFR §2.120(e) and Fed. R. Civ. P. 37(a)(2)(A).

**II. ARGUMENT**

Applicant objected to any discovery of other work that Mr. Bunge has done or is doing for applicant, or any work that Mr. Bunge has done or is doing related to opposers, on the basis that information about such work is attorney work product and therefore not

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<sup>1</sup> Relevant excerpts from the deposition of John Bunge are attached as Exhibit 1. This deposition was taken on June 28, 2002 by mutual agreement of the parties.

subject to discovery. Applicant is mistaken. Rule 26(b)(1) of the Federal Rules of Civil Procedure permit a party to obtain discovery regarding any matter, not privileged, that is relevant to the claim or defense of any party. Fed.R.Civ.Proc. 26(b)(1).

Information concerning other work that Mr. Bunge has done on behalf of applicant or related to opposers is relevant because it relates to his credibility as a witness. As noted by the court in *Behler v. Hanlon*, 199 F.R.D. 553, 557 (D. Md. 2001), quoting Jack B. Weinstein & Margaret A. Berger, WEINSTEIN'S FEDERAL EVIDENCE §607.04[1] (2d. ed. 1997):

Impeachment by showing the witness to be biased rests on two assumptions: (1) that certain relationships and circumstances impair the impartiality of a witness, and (2) that a witness who is not impartial may, consciously or otherwise, shade his or her testimony in favor of or against a party. Since bias of a witness is always significant in assessing credibility, the trier of fact must be sufficiently informed of the underlying relationships, circumstances, and influences operating on the witness to determine whether a modification of testimony reasonably could be expected as a probable human reaction.

Such bias-inducing relationships can include business relationships and payments such as those made to an expert witness. *Id.*

In *Behler*, the plaintiff in a personal injury action sought to discover information about a medical expert's ties to insurance companies and to attorneys defending personal injury actions, including financial information concerning the income earned by the witness for providing expert witness services. The *Behler* court held that "no intellectually honest argument can be made that the information sought by plaintiff regarding Dr. Keehn's activities as a defense expert witness is not relevant to bias/prejudice impeachment, and, therefore, within the scope of discovery permitted by Rule 26(b)(1)." *Id.* at 561.

The discovery that opposers seek here is far narrower than the discovery allowed in *Behler*. Here, opposers seek only to discover information about the other work that Mr. Bunge has done or is doing for Auto Meter. Such information is clearly relevant because if Mr. Bunge has, for example, been retained either as a consultant or as a testifying expert for Auto Meter in any other cases or potential cases, the potential financial benefits to him from such an ongoing relationship could hamper his ability to remain impartial in this proceeding. Similarly, if Mr. Bunge has been retained with respect to other matters involving opposers, such an engagement could affect his impartiality in this proceeding.

In *Boselli v. Southern Pennsylvania Transportation Authority*, 108 F.R.D. 723, 726 (E.D. Pa. 1985), the court held that a party was entitled to discover information about the compensation paid by the defendant to experts retained for purposes of both the case at bar and other cases. The *Boselli* court noted that "the information requested is primarily concerned with SEPTA's acts with regard to the witnesses rather than the discovery of facts known and opinions held by the experts" and that the information requested "would be useful for purposes of effective cross examination of the expert witness." *Id.* Similarly, in this case, opposers are simply seeking to discover whether Bunge has undertaken any additional work for applicant or any other work related to opposers. This is information related to the acts of applicant and applicant's counsel with respect to Bunge, and is relevant to his credibility and ability to be impartial.

In sum, there is no basis for applicant to claim that opposer is not entitled to discover information about any other work that Bunge has done on behalf of applicant or with respect to opposers. The existence of an ongoing relationship between Bunge and

applicant is relevant to Bunge's credibility and impartiality. It was improper for applicant to deny opposer discovery concerning this relationship.

### III. CONCLUSION

For the foregoing reasons, opposers request entry of an order:

- (1) requiring applicant to produce Mr. Bunge for a further discovery deposition to answer questions concerning his relationship with applicant and other work that he has done on behalf of applicant;
- (2) requiring applicant to produce all documents relating to the matters on which Mr. Bunge was improperly instructed not to testify;
- (3) re-opening discovery for a period of sixty (60) days after the Board's ruling on this motion to allow sufficient time for follow-up discovery after the second deposition of Mr. Bunge;
- (4) re-setting all testimony periods to reflect the extension of discovery.

Respectfully submitted,

PATTISHALL, McAULIFFE, NEWBURY,  
HILLIARD & GERALDSON

By



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Attorneys for Opposers Splitfire  
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Industries, Inc.

**CERTIFICATE OF SERVICE**

I, Sanjiv D. Sarwate, certify that a copy of the foregoing MOTION TO EXTEND DISCOVERY AND TESTIMONY PERIODS was served upon Philip T. Petti, Fitch, Even, Tabin & Flannery, 120 S. LaSalle Street, Suite 1600, Chicago, Illinois 60603, by facsimile and first class mail, postage prepaid, on August 14, 2002.

A handwritten signature in black ink, appearing to read "S. Sarwate", is written over a horizontal line.

1 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

2 BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

3 OLD WORLD INDUSTRIES, INC., )

4 and )

5 SPLITFIRE INTERNATIONAL, INC., )

6 Opposers, )

7 vs. ) Opposition No.

8 AUTO METER PRODUCTS, INC., ) 150,094

9 Applicant. )

10 The deposition of JOHN BUNGE, called  
 11 for examination, taken pursuant to the Federal  
 12 Rules of Civil Procedure of the United States  
 13 District Courts pertaining to the taking of  
 14 depositions, taken before KRISTIN C. BRAJKOVICH, a  
 15 Notary Public within and for the County of Cook,  
 16 State of Illinois, and a Certified Shorthand  
 17 Reporter, CSR. No. 84-3810, of said state, at Suite  
 18 1600, 120 South LaSalle Street, Chicago, Illinois,  
 19 on the 28th day of June, A.D. 2002, at 9:30 a.m.

20  
21  
22  
23  
24

ORIGINAL

1 Q. In connection with this case, have you  
2 been asked to do a likelihood of confusion survey?

3 MS. SCAVO: Objection, work product. I am  
4 instructing the witness not to answer.

5 BY MR. SARWATE:

6 Q. The survey that you conducted, the  
7 results of which are reflected in Exhibit 35, does  
8 that survey relate to likelihood of confusion?

9 A. No.

10 Q. Does it relate to likelihood of  
11 dilution?

12 A. Interesting question. Does it?

13 I was not asked to do anything oriented  
14 toward dilution. However, given the fact that  
15 secondary meaning is one evidence of fame, I  
16 suppose in that sense if someone wanted to use it  
17 as such, it could have some relationship to  
18 dilution, but I have not been asked to opine on  
19 that.

20 Q. Okay. Have you done any other surveys  
21 on behalf of Auto Meter other than the one  
22 reflected in Exhibit 35?

23 MS. SCAVO: Objection, work product.

24 MR. SARWATE: We are entitled to know

1 everything he has done -- he is doing for Auto  
2 Meter in this matter, and I don't think that  
3 objection is well taken at all. We will move to  
4 strike the report if he does not provide an answer.

5 MS. SCAVO: Mr. Bunge is being offered for  
6 a -- his secondary meaning survey that he has  
7 completed and that we have produced, and to the  
8 extent that this testimony calls for subject matter  
9 that goes beyond, that is not being offered here.

10 MR. SARWATE: These are all issues relating  
11 to his credibility and to the relationship between  
12 Mr. Bunge and Auto Meter, and we are entitled to  
13 know that information.

14 MR. NEWBURY: Just move to strike it at the  
15 right time.

16 MR. SARWATE: Are you still instructing the  
17 witness not to answer?

18 MS. SCAVO: Yes.

19 MR. SARWATE: We will deal with that at the  
20 appropriate time then.

21 BY MR. SARWATE:

22 Q. Have you done any other surveys  
23 relating to Old World or Splitfire?

24 MS. SCAVO: I will renew my same objection,

1 that he is being offered for testimony relating to  
2 a secondary meaning survey and report that he has  
3 prepared.

4 MR. SARWATE: Okay. So noted, and we will  
5 deal with that at the appropriate time.

6 BY MR. SARWATE:

7 Q. If you can turn to page 23 of your  
8 report. Starting in numbered paragraph 14 and  
9 continuing on through the top of page 26, these are  
10 documents Bates numbered AMP 001714 to 001717, and  
11 I would like to ask you if these -- this is a list  
12 of cases in which you have testified either by  
13 trial or by deposition?

14 A. No. These are only the cases that I  
15 have testified by trial.

16 Q. Only cases that you have testified by  
17 trial?

18 A. Right.

19 Q. If you would turn to -- I guess it  
20 starts at page 27, which is AMP 001718 to  
21 AMP 001719. Is this a list of cases at which you  
22 testified by trial or by deposition?

23 A. For the last, what is it, four years,  
24 prior to the date of signing in August of last