

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: July 31, 2011

Opposition No. 91183196
Opposition No. 91183698

The Board of Regents,
The University of Texas
System

v.

Southern Illinois Miners, LLC

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

This consolidated proceeding now comes up for consideration of applicant's motion (filed July 21, 2011) to quash opposer's rebuttal testimony deposition of Chris Plonsky. The motion is fully-briefed.¹

On July 27, 2011, the parties, namely, Board of Regents, The University of Texas System, opposer and counterclaim-defendant (hereafter, "the University"; represented by Susan Hightower of Pirkey Barber LLP) and Southern Illinois Miners, LLC, applicant and counterclaim-plaintiff (hereafter "Miners"; represented by Paul Lesko of Simmons Browder Gianaris Angelides & Barnerd LLC), and Elizabeth Winter, the assigned

¹ The Board notes that opposer served its response to the subject motion by U.S. Mail on July 26, 2011. In reply, during the conference, applicant reiterated that the notice of Ms. Plonsky's testimony constitutes unfair surprise and that the purpose of early disclosure is to allow a party time to take discovery

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Interlocutory Attorney, all participated in a telephone conference regarding the above-referenced motion. See Trademark Rules 2.120(i)(1) and 2.127(c); and TBMP § 502.06(a) (3d ed. 2011). This order sets forth the Board's analysis and order with respect to the subject motion. For purposes of this order, the Board presumes the parties' familiarity with the arguments and evidence submitted with respect to the subject motion.

Each party in an *inter partes* proceeding is to disclose before the relevant trial period all witnesses from whom it intends to take testimony, as well as those that it may call should the need arise. Trademark Rule 2.121(e). See *Carl Karcher Enterprises, Inc. v. Carl's Bar & Delicatessen, Inc.*, 98 USPQ2d 1370, 1371-72 n.1 (TTAB 2011). See also *Miscellaneous Changes to Trademark Trial and Appeal Board Rules*, 72 Fed. Reg. 42242, 42246 (August 1, 2007). Should the original pretrial disclosure deadline and/or later deadlines be reset during the proceeding, each party is obliged to supplement or amend its disclosures, as necessary, if it has already served its pretrial disclosures. See Fed. R. Civ. P. 26(e)(1). See *Carl Karcher*, 98 USPQ2d at 1372.

Should a deposing party seek to take the testimonial deposition of a witness who was not properly identified in that

depositions of the parties identified as having discoverable information.

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party's pretrial disclosures, the adverse party may move to quash a notice of deposition on that basis.² See *Jules Jurgensen/Rhapsody Inc. v. Baumberger*, 91 USPQ2d 1443 (TTAB 2009); and TBMP § 521 (3d ed. 2011) ("the preferred practice is to file a motion to quash rather than a motion to strike the deposition after the testimonial deposition has occurred").

Miners argues that the notice of the testimonial deposition of Chris Plonsky should be quashed because the University failed to provide any disclosure during the pendency of this proceeding that she would be called as a witness. For the following reasons, the Board determined that the University did not improperly delay in disclosing its intent to use Ms. Plonsky as a witness, and that said disclosure after the University's initial trial period does not constitute unfair surprise to Miners.

In the first instance, insofar as the subject disclosures are considered to be in the nature of plaintiff's rebuttal disclosures, the University timely served those disclosures. Specifically, in accordance with the reset trial schedule (mailed on December 25, 2010), the University's disclosures (as counterclaim-defendant and plaintiff) were due on July 3, 2011.

² Failure to disclose a witness in accordance with Trademark Rule 2.121(e) without substantial justification therefor may also lead to the exclusion of evidence unless the failure to disclose was substantially justified or harmless, *i.e.*, where the adverse party has ample time to prepare for a previously undisclosed witness. See Fed. R. Civ. P. 37(c)(1); Trademark Rule 2.116(a).

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The University served said disclosures on July 5, 2011, in accordance with Trademark Rules 2.121(e) and 2.196. Thus, the University's rebuttal disclosures were not untimely.

Further, the subject disclosures state that Ms. Plonsky is expected to testify regarding, *inter alia*, the University's *continuous use* of the MINERS marks in association with the sponsoring and conducting college athletic exhibitions and competitions, which subject matter is relevant to Miners' counterclaims asserting that the University has not used the MINERS marks for many years. *See Cerveceria Centroamericana, S.A. v. Cerveceria India, Inc.*, 892 F.2d 1021 (Fed. Cir. 1989). In view of thereof, the testimonial deposition of Ms. Plonsky is clearly intended to be responsive, in part, to the evidence adduced by Miners as counterclaim-plaintiff during its testimony period that closed on June 18, 2011. As such, to the extent Ms. Plonsky will testify with respect to applicant's counterclaims, the disclosures referencing her forthcoming deposition were also timely because they were served fifteen days prior to the applicable trial period. *See Trademark Rules 2.121(e) and 2.196, 37 C.F.R. §§ 2.121(e) and 2.196.* In view of the foregoing, there is no unfair surprise caused by the notice of deposition and rebuttal disclosures regarding Ms. Plonsky.

See also TBMP § 707.03(b)(3) (3d ed. 2011); and 8A Fed. Prac. & Proc. Civ. § 2054 (3d ed. 2011).

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With respect to Miners' argument that the disclosure regarding Ms. Plonsky should have been made earlier in the proceeding, it was noted that applicant's amended answers that include its counterclaims were not filed until late in the proceeding, *i.e.*, January 4, 2011, well after the August 1, 2008 due date for serving initial disclosures in this matter.³ Under the circumstances of this case, it is not reasonable to expect that the University could comply with its mandatory obligations for disclosure with respect to Miners' counterclaims before their submission to the Board in January, 2011. Further, allowing the University to conduct Ms. Plonsky's deposition will facilitate the orderly administration of this proceeding by enabling the current trial schedule to continue apace, and will increase the likelihood of a fair disposition of the parties' respective claims and defenses. *See Carl Karcher Enterprises, Inc. v. Carl's Bar & Delicatessen Inc.*, 98 USPQ2d 1370, 1372 (TTAB 2011).

The Board also noted during the conference that Ms. Plonsky is the Athletics Director at The University of Texas at Austin and will discuss subject matter similar to information apparently already discussed by the Assistant Athletics Director at The University of Texas (Craig Westemeier) in his testimonial deposition. Notably, Miners

³ The University filed its answers to the counterclaims on January 20, 2011.

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could have deposed Mr. Westemeier during the discovery period; but, apparently chose not to do so.⁴ In view thereof, the Board finds Miners' assertion of unfair surprise (and implied harm) to be unpersuasive.

Additionally, applicant (as counterclaim-plaintiff) will have an opportunity to rebut the University's evidence during its rebuttal period as counterclaim-plaintiff. *Cf. Rowland v. American General Finance, Inc.*, 340 F.3d 187, 196 (4th Cir. 2003) (no abuse of discretion by district court in allowing testimony of previously unidentified witness because adverse party had time to prepare for the witness and no argument by appellant as to how the district court ruling prejudiced her ability to prepare for and conduct her case at trial).

Finally, Miners argues that Ms. Plonsky is not a proper rebuttal witness because she will testify on topics already covered by the University's trial witness, Craig Westemeier. It is well established that a party cannot use its rebuttal period to submit testimony that is properly part of its case in chief.⁵ However, substantive objections to testimony, such as

⁴ Opposer states in its opposition to the motion to quash that applicant did not take discovery depositions of any of the fact witnesses identified in its initial disclosures and discovery responses. During the conference, applicant did not contradict opposer's statement.

⁵ See Trademark Rule 2.121(b)(1), 37 C.F.R. § 2.121(b). See also *Baumberger*, 91 USPQ2d at 1443 n.1, citing *Wet Seal Inc. v. FD Mgmt. Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007) (motion to strike notice of reliance granted inasmuch as rebuttal evidence was not submitted for the proper purpose of denying, explaining or

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applicant's objection going to the asserted improper rebuttal nature of the testimony, are not considered by the Board prior to final hearing.⁶ See Trademark Rules 2.123(e)(3) and 2.123(k), 37 C.F.R. §§ 2.123(e)(3) and 2.123(k); and TBMP § 707.03(c). See, e.g., *Krause v. Krause Publications Inc.*, 76 USPQ2d 1904, 1907 (TTAB 2005) (Board considers substantive objections in evaluating probative value of testimony at final hearing).

For the reasons discussed herein, the Board concluded that the University's disclosure of Chris Plonsky as a witness was timely and did not otherwise result in unfair surprise. Accordingly, applicant's motion to quash the testimonial deposition of Chris Plonsky was denied.⁷

Trial dates remain as previously reset in the Board's order mailed on December 25, 2010.

discrediting applicant's case but, instead, was clearly an attempt by opposer to strengthen its case-in-chief).

⁶ A motion to strike the testimony of a witness for lack of proper or adequate pretrial disclosure may seek exclusion of the entire testimony, when there was no pretrial disclosure, or may seek exclusion of that portion of the testimony that was not adequately disclosed in accordance with Trademark Rule 2.121(e)(3).

⁷ The parties' stipulation (filed March 31, 2011) to agree to the admission and use at trial of all produced documents (with specific exceptions described therein) is approved. See TBMP § 705 (3d ed. 2011) and cases cited therein.