

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

Mailed: March 14, 2011

Opposition No. 91189474

Cheryl Cooley

v.

Bernadette Cooper and Joyce
Irby

**George C. Pologeorgis,
Interlocutory Attorney:**

This case now comes before the Board for consideration of applicants' motion (filed October 28, 2010) to quash the notice of testimony deposition of opposer Cheryl Cooley on the ground that opposer failed to serve her pretrial disclosures, as required by Fed. R. Civ. P. 26(a)(3) and by Board order dated August 25, 2010. Opposer filed an opposition to applicants' motion on November 19, 2010.¹

¹ Opposer's response to applicant's motion was due by November 17, 2010. See Trademark Rules 2.119(c) and 2.127(a). Although opposer's response is dated November 13, 2010 and includes a certificate of service also dated November 13, 2010, the response does not include a certificate of mailing. When a paper is filed with the Board that does not include a certificate of mailing, the paper is deemed filed upon the actual date of receipt of the paper by the Board. See Trademark Rule 2.197. In this instance, the Board received opposer's response on November 19, 2010. Despite the lateness of opposer's response, the Board, in its discretion, has nonetheless decided to consider the response.

The Board, in its discretion, suggested that the issues raised in the applicant's motion should be resolved by telephonic conference as permitted by TBMP § 502.06 (2nd ed. rev. 2004). The Board contacted the parties to discuss the date and time for holding the phone conference.

The parties agreed to hold a telephone conference at 1:00 p.m. Eastern time on Wednesday, March 9, 2011. The conference was held as scheduled among Jack F. Scherer, as counsel for opposer, Jamie Shelden, as counsel for applicant, and George C. Pologeorgis, as a Board attorney responsible for resolving interlocutory disputes in this case.

The Board carefully considered the arguments raised by counsels for both parties, as well as the supporting correspondence and the record of this case, in coming to a determination regarding the above matters. During the telephone conference, the Board made the following findings and determinations:

Applicants' Motion to Quash

Before turning to the merits of applicants' motion, a brief history of this case is warranted. On November 30, 2009, applicants filed a consented motion to extend disclosure, discovery and trial dates. The Board granted applicants' consented motion on December 2, 2009 and reset the close of discovery to February 3, 2010 and the close of

opposer's testimony period to May 5, 2010. On July 15, 2010, applicants filed a motion to dismiss for failure to prosecute on the grounds that opposer failed to take testimony or offer any evidence during her assigned testimony period. Opposer filed a response to the motion on August 3, 2010 concurrently with a cross-motion to reopen her testimony period. By order dated August 25, 2010, the Board denied applicants' motion to dismiss for failure to prosecute and granted opposer's motion to reopen opposer's testimony period. By the same order, the Board reset trial dates, beginning with the deadline of opposer's testimony period, and allowed opposer thirty days from the mailing date of the Board's order, i.e., until September 24, 2010, in which to serve her pretrial disclosures upon applicants in the event that opposer had not yet served such disclosures.

Opposer's reset testimony period commenced on October 10, 2010. On October 20, 2010, opposer served her notice of testimony deposition upon applicant noticing that the testimony deposition of opposer Cheryl Cooley would take place on Monday, November 1, 2010 in Pasadena, California. On October 28, 2010, applicants filed their motion to quash the notice of testimony deposition of opposer. The Board suspended proceedings on October 28, 2010 pending the disposition of applicants' motion to quash.

We now turn to applicants' motion to quash.² In support thereof, applicants maintain that opposer never served her pretrial disclosures upon applicants despite the fact that the Board required opposer to do so in its order dated August 25, 2010. Moreover, applicants contend that, by serving her notice of testimony deposition so late in her testimony period and without the of advance notice provided by pretrial disclosures, opposer has hindered applicants' ability to prepare effectively for the deposition, as well as their defense. For these reasons, applicants request that the Board quash opposer's notice of testimony deposition.

In response, opposer argues that her notice of testimony deposition was timely and that it provided applicants adequate notice to prepare for the testimony deposition. Specifically, opposer contends that, in addition to serving her notice of testimony deposition upon applicants on October 20, 2010, opposer's counsel emailed applicants' counsel on that same day advising applicants' counsel of the upcoming deposition. In this email, opposer's counsel also acknowledged the Board's August 25, 2010 order and the requirement that opposer serve

² The Board notes that the parties have briefed applicant's motion to quash pursuant to the briefing time permitted under Trademark Rule 2.127(a). However, when time is of the essence, as is the case when a party seeks to quash a deposition notice, the better practice would be to contact the Board telephonically and request an expedited telephonic hearing resolving the issues concerning the motion to quash prior to the scheduled date for the deposition.

her pretrial disclosures within thirty days of the mailing of the Board's decision, if she had not already done so. To that end, opposer's counsel stated in his October 20, 2010 email that opposer had served her second set of interrogatories upon applicants on September 14, 2010, which was well within the Board's 30 period. Moreover, opposer maintains that the purpose of pretrial disclosures is to furnish the adverse party with all relevant information to a proceeding and, by filing a complaint which set forth the grounds for opposition and by propounding and responding to discovery, the requirement for pretrial disclosures was satisfied. Opposer further states that opposer's testimony deposition took place on November 1, 2010 without applicants' counsel in attendance and that excluding her testimony would prejudice opposer since opposer would not be able to carry her burden of proof in this case. Finally, opposer maintains that she did not have notice of applicants' motion to quash or the Board's order suspending the proceeding pending the disposition of applicants' motion to quash until after her testimony deposition was taken and had applicants' counsel contacted opposer's counsel prior to the testimony deposition and asked for an adjournment, opposer's counsel would have accommodated applicants' counsels' request.

Initially, the Board finds that opposer is under the mistaken belief that she satisfied her requirement to serve

pretrial disclosures by serving her second set of interrogatories upon applicants within the thirty day deadline set forth in the Board's August 25, 2010 order.³ Discovery requests do not constitute or serve as a substitute for pretrial disclosures, particularly since discovery requests generally request information in the possession of the adverse party and do not identify potential trial witnesses of the propounding party. Accordingly, the Board finds that, by serving her second set of interrogatories upon applicants within thirty days from the mailing date of the Board's August 25, 2010, opposer did not satisfy the pretrial disclosure requirement under Fed. R. Civ. P. 23(a)(3).

Notwithstanding the foregoing, since the testimony deposition of opposer has already taken place, applicants' motion to quash is deemed moot and, therefore, is denied as such. However, the issue of whether opposer's testimony should be excluded in light of opposer's failure to serve her required pretrial disclosures still remains.

The requirement for parties to make pretrial disclosures, which are provided for in Fed. R. Civ. P. 26(a)(3), was introduced into Board inter partes proceedings by amendments to the Trademark Rules, and is applicable to

³ The Board notes that discovery in this case closed on February 3, 2010. Accordingly, any discovery requests served by opposer subsequent to this date are untimely and, therefore, applicants are not required to respond to such untimely requests.

all proceedings which commenced on or after November 1, 2007.⁴ See *Notice of Final Rulemaking, Miscellaneous Changes to Trademark Trial and Appeal Board Rules*, 72 Fed. Reg. 42242 (Aug. 1, 2007). Such disclosures allow parties to know prior to trial the identity of trial witnesses, thus avoiding surprise witnesses. See *id.* at 42257-58. These disclosures require that a party, in advance of the presentation of its testimony, inform its adversary of the names of, and certain minimal identifying information about, the individuals who are expected to, or may, if the need arises, testify at trial. See *id.* at 42257.

Fed. R. Civ. P. 37(c)(1), made applicable to this proceeding by Trademark Rule 2.116(a), provides "[i]f a party fails to provide information or identify a witness as required by Rule 26(a)...the party is not allowed to use that information or witness to supply evidence on a motion, at a hearing, or at a trial, unless the failure was substantially justified or is harmless."

Trademark Rule 2.123(e)(3) provides, in part, that if pretrial disclosures are improper or inadequate with respect to a witness,

an adverse party may cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. ... A motion to strike the testimony of a witness for lack of proper or adequate pretrial

⁴ As noted earlier, this proceeding was filed on March 24, 2009.

disclosure may seek exclusion of the entire testimony, *when there was no pretrial disclosure...*

(emphasis added). The rule further provides that such a motion to strike the testimony of a witness "will be decided on the basis of all the relevant circumstances."

While the Board's rules explicitly allow for a motion to strike the entire deposition after the fact, that is not the exclusive remedy available to a party facing an adversary's attempt to take testimony from a witness not identified. Indeed, as is the case here, a motion to quash prior to an objected-to deposition is typically a preferable and more expeditious remedy.

In determining whether to exclude opposer's testimony, we must first ascertain whether opposer's non-disclosure is substantially justified and, if not, whether opposer's failure to disclose is deemed harmless. Fed. R. Civ. P. 37(c)(1).

We are guided by the following five-factor test to determine whether the failure to serve pretrial disclosures is substantially justified or harmless: "1) the surprise to the party against whom the evidence would be offered; 2) the ability of that party to cure the surprise; 3) the extent to which allowing the testimony would disrupt the trial; 4) importance of the evidence; and 5) the nondisclosing party's explanation for its failure to disclose the evidence."

Southern States Rack & Fixture, Inc. v. Sherwin-Williams Co., 318 F.3d 592, 596 (4th Cir. 2003). See also *Microstrategy Incorporated v. Business Objects, S.A. and Business Objects Americas, Inc.* 77 USPQ2d 1001 (Fed. Cir. 2005) (wherein the Court considered the five-factor test in determining whether a party's nondisclosure of evidence was substantially justified or harmless, although it found, for other reasons, that the test was inapplicable to the particular facts of the case).

Four of the above-identified factors - surprise to the opposing party, ability to cure the surprise, disruption of the trial, and importance of evidence—relate mainly to the harmless exception, while the remaining factor - explanation for the nondisclosure—relates primarily to the substantial justification exception. *Southern States Rack, supra*, 318 F.3d at 597.

We now turn to the application of these factors. We begin with the fifth factor, namely, the explanation for the nondisclosure. As stated above, opposer maintains that the purpose of pretrial disclosures is to furnish the adverse party with all relevant information to a proceeding and, by filing a complaint which set forth the grounds for opposition and by propounding and responding to discovery, the requirement for pretrial disclosures was satisfied.

The Board finds opposer's arguments unpersuasive and misplaced. The purpose of pretrial disclosures is to provide an adverse party the identity of potential trial witnesses and the scope of testimony of such witnesses to enable that party to prepare for trial. The filing of a complaint, the service of initial disclosures, and the exchange of discovery does not satisfy the pretrial disclosure requirement under Fed. R. Civ. P. 26(a)(3) nor does it absolve a party from its obligation to serve pretrial disclosures. More telling, however, is opposer's failure to advance any explanation as to why she did not comply with the Board's August 25, 2010 order that required opposer to serve her pretrial disclosures if she had not already done so.

Based upon the explanation (or lack thereof) provided by opposer, the Board finds that opposer's failure to serve her pretrial disclosures is not substantially justified.

We next turn to the remaining factors to ascertain whether opposer's nondisclosure is harmless. As to the first factor, the surprise element, we note that since opposer failed to serve her pretrial disclosures, applicants were not apprised of Ms. Cooley's identity as a trial witness. This surprise or lack of advance notice arguably hindered applicants' ability to prepare their defense. However, in this instance, any surprise to applicants was

mitigated for two reasons: (1) opposer, in support of her cross-motion to reopen testimony filed on August 3, 2010, stated that she would be the principal witness at trial and (2) while not a certainty, applicants could plausibly have expected that opposer, as an individual party plaintiff, would testify on her own behalf at trial. Therefore, we find this factor to slightly favor opposer.

As to the second factor, the Board finds that any surprise for nondisclosure is curable by reconvening opposer's testimony deposition and allowing applicants to cross-examine opposer based upon the testimony already provided. This factor weighs in favor of opposer.

In regard to the third factor, i.e., disruption of trial, the Board finds that the trial has not been disrupted inasmuch as twelve days remained in opposer's testimony period when this proceeding was suspended pending the disposition of applicants' motion to quash. This factor also weighs in favor of opposer.

And as to the fourth factor, namely, the importance of the evidence, the Board notes that it does not review evidence prior to final decision. However, opposer's need for her own testimony, as an individual party plaintiff, may be important to the extent that opposer carries the burden of proof in this case. In fact, opposer argues that she would be sorely prejudiced if her testimony is excluded, as

she would not be able to sustain the opposition. Therefore, we find this factor to favor opposer.

After considering all of these factors, that Board finds, on balance, that although opposer's failure to serve her pretrial disclosures is not substantially justified, opposer's non-disclosure is nonetheless harmless.

Accordingly, the Board will not exclude opposer's testimony on the ground that opposer failed to serve her pretrial disclosures.

As stated above, however, in order to cure any surprise resulting from opposer's nondisclosure, opposer is hereby required to make herself available for a continuation of her testimony deposition, during her reset testimony period as set forth below, for the sole purpose of allowing applicants the opportunity to cross-examine opposer based on the testimony already taken, as well for purposes of re-direct, if necessary and appropriate.⁵ To that end, opposer's counsel has agreed to promptly provide applicants' counsel with a copy of opposer's testimony deposition transcript, including all exhibits. Moreover, to the extent either counsel wishes to attend the continuation of opposer's testimony deposition by telephone, they may do so.

⁵ To the extent applicants wish to object to any questions asked or responses made during opposer's initial testimony deposition, applicants may interject their objections during cross-examination.

Proceedings herein are resumed. Trial dates are reset as follows:

Opposer's remaining 12-day testimony period commences on **March 15, 2011** and closes on **March 26, 2011**.⁶

Defendant's Pretrial Disclosures	4/9/2011
Defendant's 30-day Trial Period Ends	5/24/2011
Plaintiff's Rebuttal Disclosures	6/8/2011
Plaintiff's 15-day Rebuttal Period Ends	7/8/2011

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

As a final matter, the Board expects parties in proceedings before it to comply with by Board orders and abide by the rules and regulations governing Board procedure. The Board is quite dismayed that opposer failed

⁶ To the extent opposer wishes to submit appropriate evidence under a notice of reliance, she may do so during her testimony period, as reset herein. Opposer is precluded, however, from noticing any further testimony depositions, except for rebuttal testimony. Opposer is reminded she cannot use her rebuttal period to submit testimony that is properly part of her case in chief. See Trademark Rule 2.121(b)(1) and *Wet Seal Inc. v. FD Mgmt. Inc.*, 82 USPQ2d 1629 (TTAB 2007). Therefore, opposer may not serve rebuttal period disclosures and identify witnesses therein as a means for presenting evidence that is properly considered part of opposer's case in chief. Rebuttal testimony is limited to rebutting the evidence applicants may place in the record.

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to comply with its August 25, 2010 order requiring opposer to serve her pretrial disclosures or to provide a justifiable explanation for failing to do so. To the extent opposer unjustifiably fails to comply with future Board orders that results in an unnecessary disruption of this proceeding and/or prejudices applicants, the Board will entertain a motion for sanctions in the form of judgment dismissing this proceeding with prejudice.