

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

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Mailed: August 24, 2011

Opposition No. 91194042

Cantine Riondo S.p.A.

v.

Renu Sood

Before Bucher, Kuhlke and Taylor,  
Administrative Trademark Judges.

By the Board:

This proceeding is before the Board for consideration of applicant's motion (filed March 25, 2011) to strike the testimony of Mr. Charles Massie. The motion has been fully briefed.<sup>1</sup>

By way of background, opposer did not serve timely initial disclosures, and served its first discovery requests on the last day of the discovery period; applicant declined to respond to said discovery inasmuch as opposer had not served initial disclosures.

By operation of the Board's April 22, 2010 order, opposer's pretrial disclosures were due January 31, 2011 and its 30-day testimony period was set to close March 17, 2011.

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<sup>1</sup> Opposer's surreply, filed April 13, 2011, has been given no consideration. See Trademark Rule 2.127(a); TBMP § 502.02(b) (3d ed. 2011).

On the opening day of said period, February 16, 2011, opposer served a letter bearing the line "Re: Supplemental Initial And Pretrial Disclosures,"<sup>2</sup> wherein opposer identified three individuals and their locations and telephone numbers, including Mr. Charles Massie, Chief Executive Officer of Riondo USA located in New Jersey. The disclosure included a list of documents; it did not provide a summary of the subjects on which any witness was expected to testify.

Although titled "Supplemental Initial" disclosures, opposer had never served initial disclosures on applicant. Thus, opposer's initial disclosure, the February 16, 2011 communication, was over six months untimely. In addition, opposer's pretrial disclosure was over two weeks untimely.

On March 8, 2011, the parties filed, and the Board granted, a stipulation to reset the close of opposer's 30-day testimony period to March 24, 2011. The deposition of Mr. Massie took place on March 24, 2011. Applicant's counsel attended said deposition by telephone by agreement, and on the record noted an objection that applicant was attending under protest, cross-examined "the best it could" (applicant's brief, p. 3), and objected to the introduction of documents as exhibits that had been requested but not produced during discovery and/or had not been listed in opposer's disclosure.

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<sup>2</sup> Applicant had not moved to compel opposer's initial disclosures under Trademark Rule 2.120(e)(1). A motion to compel initial

The following day, applicant moved to strike Mr. Massie's testimony in its entirety.

In moving to strike, applicant argues that it has been severely prejudiced because it had no opportunity to take discovery of Mr. Massie, and because its cross-examination was compromised due to both lack of notice regarding the subjects on which Mr. Massie would testify and opposer's introduction of documents that it had not copied and mailed to applicant's counsel during discovery. It argues that, inasmuch as Mr. Massie "testified that he created the trademark and the product, and that he runs the business in the United States" (applicant's brief, p. 2; Reidl Decl. para. 36), his identity should have been disclosed in opposer's initial disclosures, or at least in timely pretrial disclosures. Applicant argues that its receipt of opposer's late initial and pretrial disclosures "was the first time that Applicant learned that Opposer had offices and an employee in the United States" (applicant's brief, p. 2; Reidl decl. para 25). Regarding exhibits introduced during Mr. Massie's testimony, applicant argues that "it was impossible to cross examine Mr. Massie effectively without the documents" (applicant's brief, p. 6). Applicant asserts that it was placed in this position because during discovery opposer refused to copy and mail documents responsive to discovery requests even after applicant offered to pay

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disclosures must be filed prior to the close of the discovery

opposer's expense of doing so, because after discovery closed opposer sent only some documents to applicant, and because certain testimony exhibits (media reviews, Mr. Massie's market research, a business plan for goods bearing the mark, distribution agreements) were not disclosed in opposer's untimely pretrial disclosures.

In response, opposer provides no reason for having failed to serve timely initial disclosures or pretrial disclosures, and provides no reason for failing to include a list of subjects in its untimely pretrial disclosures. Opposer maintains: "[T]here was no refusal to comply with the Board's disclosure rules. Mr. Massie had been identified in Answers to Applicant's Interrogatories on October 1, 2010 and later in continuing answers on January 13, 2011" (opposer's brief, p. 3), and that Mr. Massie "was identified twice in the Opposer's Answers to Applicant's Interrogatories," and "was identified in papers sent to Applicant's counsel on January 13, 2011, in continued response to Applicant's discovery requests" (opposer's brief, p. 2).<sup>3</sup> Opposer submitted counsel's declaration, stating that "[T]he discovery answers twice identified Mr. Charles Massie in answers to Interrogatory 1 and Interrogatory 6" (Wray decl., p. 2), and that opposer produced search results from an Internet search of "Riondo" done on January 12, 2011 that displayed a website "Riondo usa.com,"

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period.

which bears a copyright notice of 2010 and which identifies Charlie Massie as CEO and founder of Riondo USA" (Wray declaration, p. 3). Opposer states that Riondo USA, of which Mr. Massie is CEO, is an importer, and that "[T]here is no indication that Applicant's counsel ever intended to take a deposition or investigate the wholesalers or importers that Applicant's counsel knew of" (opposer's brief, p. 4).

Lastly, opposer argues that applicant's counsel chose not to travel to opposer's counsel's office to review the document production during discovery, and chose to attend Mr. Massie's deposition by telephone.

With its reply, applicant submitted copies of opposer's responses to Interrogatory Nos. 1 and 6, and asserted that "throughout discovery Applicant reasonably believed that Mr. Massie, like the other individuals identified in the responses, was located in Italy where Opposer is located. Applicant had no reason to know or to believe that there was a Cantine Riondo USA in New Jersey and that Mr. Massie was its CEO" (applicant's reply brief, p. 5).

### Analysis

Trademark Rule 2.121(e) states, in pertinent part,

A party need not disclose, prior to its testimony period, any notices of reliance it intends to file during its testimony period. However, no later than fifteen days prior to the opening of each testimony period, or on such alternate schedule as may be provided by order of the Board, the party scheduled to

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<sup>3</sup> Discovery closed on December 17, 2010.

present evidence must disclose the name and, if not previously provided, the telephone number and address of each witness from whom it intends to take testimony, or may take testimony if the need arises, general identifying information about the witness, such as relationship to any party, including job title if employed by a party, or, if neither a party nor related to a party, occupation and job title, a general summary or list of subjects on which the witness is expected to testify, and a general summary or list of the types of documents and things which may be introduced as exhibits during the testimony of the witness. (emphasis added)

Trademark Rule 2.123(e)(3) states that if pretrial disclosures are improper or inadequate with respect to any 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. Promptly after the testimony is completed, the adverse party, to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances. 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 § 2.121(e).

*See also* TBMP § 533.02(b) (3d ed. 2011); *Jules Jurgensen/Rhapsody, Inc. v. Baumberger*, 91 USPQ2d 1443 (TTAB 2009).

Inasmuch as the testimony at issue was taken on March 24, 2011, and applicant filed its motion on March 25, 2011, applicant moved to strike promptly after the testimony was taken.

Opposer failed to comply with Trademark Rule 2.121(e), and provides no explanation for this. What opposer served on February 16, 2011 was both untimely, and substantively deficient inasmuch as opposer did not provide the subject(s) about which opposer intended that Mr. Massie would give testimony.

Regarding opposer's argument that it named Mr. Massie in its responses to Interrogatory Nos. 1 and 6, said responses did not absolve opposer from its obligation to timely ascertain and serve applicant with notice of whose testimony it intended to use. Similarly, the discovery responses did not substitute for or satisfy opposer's obligation to affirmatively disclose Mr. Massie as a witness and the subject(s) on which it expected him to testify. As the Board has stated, "a pretrial disclosure is an independent requirement of the rules and not one that can be ignored simply because some information about a testifying individual may be known by the adverse party or parties." *Jules Jurgensen/Rhapsody*, 91 USPQ2d at 1445.

The Board adopted the pretrial disclosure requirement to give all parties the benefit of knowing in advance what witnesses will be presented, so parties can prepare for trial and avoid surprise witnesses. *Miscellaneous Changes to Trademark Trial and Appeal Board Rules*, 72 Fed. Reg. 42242, 42257-58 (August 1, 2007). Adoption of the disclosure model was intended to foster the orderly administration of the

proceeding, and timely service of pretrial disclosures avoids incidents of unfair surprise and increases the likelihood of a fair disposition of the case. See *Carl Karcher Enterprises, Inc. v. Carls Bar & Delicatessen, Inc.*, 98 USPQ2d 1370, 1372 (TTAB 2011). Here, what opposer produced during discovery did not satisfy opposer's separate disclosure obligation, and its contention that a timely-filed initial and/or pretrial disclosure would have or might have included the information that it provided in its *discovery* responses is immaterial.<sup>4</sup>

Opposer's failure to serve any initial disclosures during discovery, failure to serve timely pretrial disclosures, and failure to identify specific subjects on which Mr. Massie was expected to testify is clearly in violation of Trademark Rule 2.121(e) and subjected applicant to unfair surprise. Although applicant never moved to compel opposer's initial disclosures, which would have been the preferred practice, opposer, who determined that Mr. Massie's testimony was important to its case, did not identify him as such at a time when applicant could have sought discovery from him. Moreover, as noted

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<sup>4</sup> For the same reason, the Board finds opposer's statement in its declaration that "[a] timely filed initial disclosure would have provided the same information that was provided in the Answers and Responses to the Applicant's three discovery requests" (Wray decl., p. 3) to be indicative of opposer's failure to appreciate the importance of and reasons for the Board's adoption of the disclosure requirements. Moreover, opposer's statement that it does not believe applicant's counsel contacted any of the wholesalers or importers that opposer identified in discovery responses, including Mr. Massie, misses the point (see Wray decl., p. 4). The purpose of opposer's pretrial disclosure was to timely identify any witnesses that *opposer* intended to use.



above, the mere mention of Mr. Massie in two discovery responses does not absolve opposer from its obligations under Trademark Rule 2.121(e).

In view of opposer's failure to comply with Trademark Rule 2.121(e), applicant's motion to strike the testimony of Mr. Charles Massie is hereby granted.

Dismissal

Trademark Rule 2.122(d)(1), reads, in relevant part:

A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by an original or photocopy of the registration prepared and issued by the United States Patent and Trademark Office showing both the current status of and current title to the registration, or by a current printout of information from the electronic database records of the USPTO showing the current status and title of the registration.

*See also Research in Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1928 (TTAB 2009). In its amended pleading, opposer asserts ownership of Registration No. 2693676; however, inasmuch as the registration copy it attached fails to establish current status and title thereto, it is insufficient to make opposer's pleaded registration of record.<sup>5</sup> Moreover, applicant's admission, in its answer, of only the first sentence of Paragraph 2 of the amended notice of opposition ("Opposer owns Federal Registration No. 2,693,676 for the trademark RIONDO for wines

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<sup>5</sup> We observe that the copy of the registration submitted with the amended notice of opposition is identical to the one submitted with the original notice of opposition.

and sparkling wines.") is insufficient to establish the current status of the registration.

In view thereof, opposer's pleaded registration is not of record and cannot be relied upon by opposer in support of its claims. Furthermore, opposer has not made any other evidence of record.

Inasmuch as the record includes no evidence on which opposer can meet its burden of proof as plaintiff, based on its failure to prosecute this case, judgment is hereby entered against opposer and the opposition is dismissed with prejudice. See Trademark Rule 2.132(a).

Applicant's counterclaim

In view of the dismissal of opposer's claims, applicant is allowed until thirty (30) days from the mailing date of this order in which to file a notice herein indicating whether it wishes to pursue its counterclaim, failing which the Board will dismiss the counterclaim with prejudice.

Applicant's counterclaim asserts that Registration No. 2693676 is void *ab initio*, and in particular that the mark was not lawfully in use on any of the identified goods in the United States as of the filing date of the statement of use. Said claim is predicated on allegations that opposer had not received approval for its labels from the United States Department of Treasury Alcohol and Tobacco Tax and Trade Bureau

prior to importation, and had not entered into any importation agreement with any licensed importer in the United States.

To assist applicant in assessing the viability of its counterclaim, the Board notes that prevailing on a claim of this nature, centering on whether opposer's use of a mark is lawful under one or more regulatory statutes, is dependent on applicant's ability to present a determination of non-compliance by a court or government agency having competent jurisdiction under the statute involved, or a determination that there has been a *per se* violation of a statute regulating the sale of the goods. *See Kellogg Co. v. New Generation Foods Inc.*, 6 USPQ2d 2045, 2047 (TTAB 1988), citing *Santinine Societa v. P.A.B. Produits*, 209 USPQ 958 (TTAB 1981). The claim must be proven by clear and convincing evidence. *Id.*