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

Proceeding	91194864
Party	Defendant Undivided Design, LLC
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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**H&M HENNES & MAURITZ AB,**

Opposer,

vs.

**UNDIVIDED DESIGN, LLC, ,**

Applicant.

**Opposition No.: 91194864**

**Application Serial No. 77/888,150**

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**MOTION TO STRIKE TRIAL TESTIMONY DEPOSITION OF  
JEFFREY MILLER AND EXHIBITS OFFERED THROUGH HIS TESTIMONY;  
AND BRIEF ON MOTION**

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**MOTION**

Pursuant to 37 CFR § 2.123(e)(3) and TBMP §§ 533.02(a), 533.02(b), 707.03(b)(2), 707.03(b)(3) and 707.03(c), UNDIVIDED DESIGN, LLC (“**Applicant**”), through counsel, hereby moves the Board to strike from the record the trial testimony deposition of Jeffrey Miller, and all exhibits offered through his testimony.

The grounds for the motion are, in summary:

1. H&M Hennes & Mauritz AB (“**Opposer**”) did not identify Mr. Miller in its initial disclosures as required by 37 CFR § 2.120, TBMP § 401.02 and the trial order of the Trademark Trial and Appeal Board entered in this opposition proceeding. Rather, Opposer (though counsel) informed Applicant that it did not intend to offer testimonial or other evidence in connection with this opposition proceeding, but would rely solely upon argument together with the application files and Opposer’s registered marks.

2. Applicant relied upon Opposer’s failure to designate witnesses, documents and things, and upon Opposer’s representations regarding its intent to proceed without testimony or other evidence, in its decision not to undertake any discovery prior to the cutoff date.

3. To the extent Opposer seeks to offer opinion testimony through Mr. Miller, the testimony is additionally improper for Opposer's failure to satisfy its obligation to make expert disclosures as required by 37 CFR § 2.120, TBMP § 401.03 and the trial order.

4. Opposer failed to identify any documents or things in its initial disclosures as required by 37 CFR § 2.120, TBMP § 401.02 and the trial order entered in the opposition proceeding. Again, Applicant relied upon this, and upon Opposer's statement regarding the intended scope of the opposition proceeding, in not seeking discovery during the discovery phase of the opposition proceeding.

5. Many of the exhibits offered through the trial testimony of Mr. Jeffrey Miller were not disclosed in Opposer's final pretrial disclosures, which only referred to "documents" in two narrow categories.

WHEREFORE, Applicant respectfully requests that the Board will strike the trial testimony deposition of Mr. Jeffrey Miller, and all exhibits offered through his testimony.

### **BRIEF ON MOTION**

#### **I. PROCEDURAL BACKGROUND**

1. On May 12, 2010, Opposer filed its *Notice of Opposition*, thereby initiating this proceeding.

2. On May 12, 2010, the Board issued its notice and trial order setting dates and deadlines in this proceeding. According to the trial order, and applicable rules and regulations:

- a. Initial Disclosures were due on August 20, 2010;
- b. Expert Disclosures were due on December 18, 2010;
- c. Discovery Closed on January 17, 2010; and
- d. Plaintiff's Pretrial Disclosures were due March 3, 2011.

3. Opposer did not serve Initial Disclosures. Instead, Opposer's counsel informed Applicant that Opposer did not intend to offer testimonial or other evidence in connection with the opposition proceeding, but would rely solely upon argument together with the application files and Opposer's registered marks.

4. Opposer did not serve expert disclosures.

5. Applicant relied upon Opposer's failure to designate witnesses, documents and things, and upon Opposer's representations regarding its intent to proceed without evidence, in its decision not to undertake any discovery prior to the cutoff date.

6. Opposer served final pretrial disclosures on March 3, 2001. Opposer identified Mr. Jeffrey Miller as a potential witness, and indicated that he "has knowledge of the advertising, marketing, promotion and sale of products bearing the DIVIDED mark in the United States."

Opposer identified two categories of exhibits:

1. Documents relating to the marketing, advertising and promotion of products bearing the DIVIDED mark in the United States; and

2. Documents relating to the sales of products bearing the DIVIDED mark in interstate commerce.

7. Opposer served its notice of deposition of Mr. Miller on September 19, 2011.

8. On September 21, 2011, counsel for Applicant wrote to counsel for Opposer by e-mail, stating in pertinent part:

Thank you for your e-mail. I would like to make arrangements to attend and participate in the deposition of Jeffrey Miller telephonically. In this regard, it would be helpful if you provide to me by e-mail any exhibits that you intend to discuss or review with the witness during the testimony. If this will be a problem, please let me know immediately. Further, the 10:00 a.m. (Eastern Time) start time for the deposition will not be a problem.

Pursuant to 37 CFR § 2.123(e)(3) and TBMP §§ 533.02 and 533.02, Undivided Design LLC ("Applicant") will cross-examine Jeffrey Miller under protest, while reserving the right to object to the receipt of the testimony in evidence. Promptly after the deposition is completed, Applicant will move to strike Mr. Miller's testimony from the record. Applicant further reserves its right to object to any exhibits that H&M HENNES & MAURITZ AB ("Opposer") may offer through the testimony of Mr. Miller. The bases for objecting to the testimony and any exhibits will be, among others, the failure of Opposer to provide proper or adequate pretrial disclosures.

As you know, Opposer did not identify Mr. Miller in its initial disclosures as required by TBMP § 401.02 and the orders of TTAB entered in the opposition proceeding. Rather, Opposer (though counsel) informed Applicant that it did not intend to offer testimonial or other evidence in connection with the opposition proceeding, but would rely solely upon argument together with the

application files and upon Opposer's registered marks. Applicant relied upon Opposer's failure to designate witnesses and documents, and upon Opposer's representations of its intent to proceed without evidence, in its decision not to undertake any discovery prior to the cut off date.

Likewise, Opposer failed to identify any documents or things in its initial disclosures as required by TBMP § 401.02 and the orders of TTAB entered in the opposition proceeding. Again, Applicant relied upon this and upon Opposer's statement regarding the intended scope of the opposition proceeding in not seeking discovery during the discovery phase of the opposition proceeding.

Finally, to the extent Opposer seeks to offer opinion testimony through Mr. Miller (as we suspect), the testimony is additionally improper for Opposer's failure to satisfy its obligation to make expert disclosures as required by 37 CFR § 2.120 and TBMP § 401.03.

9. On October 5, 2011, counsel for Applicant wrote to Opposer's counsel to inquire whether Opposer intended to proceed with the deposition, and to "reiterate [the] request for copies of any exhibits that you intend to introduce through the witness."

10. At 7:23 p.m. (Eastern Time) on October 6, 2011, Opposer e-mailed several potential exhibits to Applicant.

11. At 8:48 a.m. (Eastern Time) on October 7, 2011, Opposer e-mailed additional potential exhibits to Applicant.

12. At 10:02 a.m. (Eastern Time) on October 7, 2011, Opposer e-mailed an additional potential exhibit to Applicant.

13. None of the proposed exhibits previously had been produced or disclosed to Applicant.

14. The deposition of Mr. Jeffrey Miller commenced at approximately 10:15 a.m. (Eastern Time) on October 7, 2011, and continued for approximately three hours and ten minutes. During the deposition, Applicant stated its intent to cross-examine Mr. Miller under protest, and gave notice that would file a motion to strike his testimony following the deposition. Applicant also formally objected to each of the exhibits on grounds of failure of adequate disclosure, among other grounds.

## II. ARGUMENT

### A. The Board Should Strike the Trial Testimony Deposition of Jeffrey Miller Because Opposer Failed to Disclose Him in Initial Disclosures.

Opposer was required to serve its Initial Disclosures on or before August 20, 2010. See 37 CFR § 2.120(a)(2) (“Initial disclosures must be made no later than thirty days after the opening of the discovery period.”); TBMP § 401.01(b) (“Each party involved in an inter parties proceeding is obligated to make initial disclosures to every other party, by the deadline set in the Board’s institution order”).

Among other things, Opposer was mandated to identify “each individual likely to have discoverable information that the disclosing party may use to support its claims or defenses.” Fed. R. Civ. Pro. 26(a)(1); see also 37 CFR §§ 2.116(a) and 2.120(a); Byer California v. Clothing for Modern Times Ltd., 95 USPQ2d 1175 (TTAB 2010); Jules Jurgensen/Rhapsody, Inc., 91 USPQ2d 1443, n.1 (TTAB 2009).

Indeed, section 533.02(b) of the Trademark Trial and Appeal Board Manual of Procedure (3d ed. May 2011) (“**TBMP**”) provides, in pertinent part:

Although a party need not identify particular individuals as prospective trial witnesses through its mandatory initial disclosures, it must identify “each individual likely to have discoverable information that the disclosing party may use to support its claims or defenses.” ...

If pretrial disclosures are improper or inadequate with respect to a particular witness, the adverse party may cross-examine that witness under protest while reserving its right to object to receipt of the testimony into evidence. However, promptly after the deposition is completed, the adverse party, if it wishes to preserve the objection, must move to strike the testimony from the record.

Federal Rule of Civil Procedure 37, which is made applicable in this proceeding pursuant to 37 CFR § 2.116(a), provides in pertinent part:

If a party fails to provide information or identify a witness as required by Rule 26(a) or 26(e), *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.

Fed. R. Civ. Pro. 37(c)(1) (emphasis added).

Consistent with this, the Code of Federal Regulations provides, in pertinent part: “If a party fails to make required initial disclosures or expert testimony disclosure, and such party or the party’s attorney or other authorized representative informs the party or parties entitled to receive disclosures that required disclosures will not be made, the Board may make any appropriate order, as specified in paragraph (g)(1) of this section.” 37 CFR § 2.220(g)(2). Subparagraph (g)(1), in turn, provides that: “the Board may make any appropriate order, including those provided in Rule 37(b)(2) of the Federal Rules of Civil Procedure, except that the Board will not hold any person in contempt or award expenses to any party.” 37 CFR § 2.220(g)(2). Rule 37(b)(2), in turn, specifically authorizes an order “prohibiting the disobedient party from supporting or opposing designated claims or defenses, or from introducing designated matters in evidence.” Fed. R. Civ. Pro. 37(b)(2)(A)(ii).

Opposer failed to serve its mandatory initial disclosures. It did not identify Mr. Jeffrey Miller or any other persons with discoverable information that it might use to support its claims or defenses. Instead, Opposer (through counsel) informed Applicant that it intended to proceed without testimony or evidence other than the application files and Opposer’s registered marks. Applicant relied upon Opposer’s failure to designate witnesses, documents or things in not undertaking discovery prior to the deadline established by the Board’s trial order. If Opposer had given notice of potential witnesses, documents and things in its mandatory initial disclosures, Applicant would have considered different discovery and trial strategies.

Applicant has been prejudiced by Opposer’s failure to disclose Mr. Miller as a witness. The failure is neither substantially justified nor harmless. As the Board held in matter of Jules Jurgensen/Rhapsody, Inc. v. Baumberger, 91 USPQ2d 1443, Cancellation No. 92048667 (TTAB July 6, 2009): “[Opposer]’s failure to identify Mr. [Jeffrey Miller] in its initial disclosures deprived [Applicant] of the opportunity to seek discovery of Mr. [Miller].” Id. at 6. Mr. Miller is the type of surprise witness that pretrial disclosure practice is intended to discourage.

Accordingly, Opposer should be precluded from offering the undisclosed testimony of Mr. Jeffrey Miller, and his trial testimony deposition should be stricken.

**B. The Board Should Strike and Refuse to Consider Any Expert Opinions Offered through the Trial Testimony Deposition of Jeffrey Miller Because Opposer Failed to Disclose Him as an Expert or Serve Expert Disclosures.**

Opposer did not serve any expert disclosures in this case. As such, pursuant to TBMP §§ 533.02(b) and 707.03(b)(3), the Board should strike and refuse to consider any opinion testimony offered through Jeffrey Miller.

**C. The Board Should Strike and Refuse to Consider the Exhibits Offered Through the Trial Testimony Deposition of Jeffrey Miller.**

Opposer failed to disclose any documents or things in its mandatory initial disclosures. As such, Applicant was denied the opportunity to conduct any discovery regarding the documents and things upon which Opposer now seeks to rely as evidence.

Opposer also provided only limited disclosure of two categories of documents in its final pretrial disclosures. Opposer did not disclose any things as exhibits.

As such, for the reasons more fully discussed in section II.A., supra, the Board should strike and refuse to consider all of Opposer's proposed exhibits. At a minimum, the Board should strike and refuse to consider those exhibits that exceed the scope of Opposer's final pretrial disclosures, *to wit*, all "things" and those documents outside the scope of the disclosures.

WHEREFORE, the Board should STRIKE from the record the trial testimony deposition of Jeffrey Miller, and all exhibits offered through his testimony.

DATED this 18th day of October, 2011.

**PARSONS KINGHORN HARRIS**

/Matthew M. Boley/

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**CERTIFICATE OF SERVICE**

I hereby certify that, on this 18th day of October, 2011, I served or caused to be served a true and correct copy of the foregoing **MOTION TO STRIKE TRIAL TESTIMONY DEPOSITION OF JEFFREY MILLER AND EXHIBITS OFFERED THROUGH HIS TESTIMONY; AND BRIEF ON MOTION** upon the following named persons by depositing the same in the United States mail, postage prepaid, addressed as shown below:

Mark I. Peroff, Esq.  
Alpa V. Patel, Esq.  
Hiscock & Barclay, LLP  
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New York, New York 10036

/Matthew M. Boley/\_\_\_\_\_