

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

Baxley

Mailed: February 29, 2012

Opposition No. 91194864

H&M Hennes & Mauritz AB

v.

Undivided Design, LLC

Andrew P. Baxley, Interlocutory Attorney:

This case now comes up for consideration of applicant's motion (filed October 18, 2011) to strike opposer's testimony deposition of Jeffrey Miller, the young fashion and denim merchandiser in opposer's United States division. Opposer filed a brief in response thereto.

Applicant contends that the transcript of the October 7, 2011 testimony deposition of Mr. Miller should be stricken because opposer did not identify Mr. Miller in its initial disclosures as an individual likely to have discoverable information and did not disclose him as an expert witness prior to the close of discovery. Applicant contends in addition that opposer's former attorney "informed [a]pplicant that [o]pposer 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." Applicant did not include any exhibits to its motion.

In response, opposer contends that its failure to serve initial disclosures has not prejudiced applicant's ability to defend this opposition; that applicant itself did not serve initial disclosures and elected not to take discovery; that, after opposer's new attorney entered an appearance herein on February 16, 2011, opposer timely served its pretrial disclosures on March 3, 2011; and that applicant has not proffered any communication documenting opposer's former attorney's alleged statement that opposer did not intend to offer testimony or other evidence. Opposer's exhibits in response to applicant's motion include a declaration of its attorney, Alpa V. Patel, which introduces: 1) a July 29, 2010 letter from opposer's former attorney to applicant's attorney; 2) a series of e-mails from July to September 2011 between the parties' attorneys; 3) a copy of opposer's March 3, 2011 pretrial disclosures; and 4) a copy of the September 19, 2011 notice of opposer's testimony deposition of Mr. Miller.

As an initial matter, the Board is not persuaded that opposer stated that it did not intend to take testimony or offer evidence in this case. Applicant failed to submit any writing or other evidence to support its contention that

opposer so stated.¹ On the other hand, the July 29, 2010 letter from opposer's former attorney to applicant's attorney that opposer submitted as an exhibit to its brief in opposition indicates that opposer intends to litigate this opposition "to a conclusion."

Board *inter partes* proceedings are governed, in part, by the Federal Rules of Civil Procedure, except as otherwise provided in the Trademark Rules of Practice, and "wherever [the Federal Rules are] applicable and appropriate."

Trademark Rule 2.116. In turn, Fed. R. Civ. P. 26(a)(1)(A)(i) requires parties to provide an initial disclosure identifying "each individual likely to have discoverable information – along with the subjects of that information – that the disclosing party may use to support its claims or defenses, unless the use would be solely for impeachment." Fed. R. Civ. P. 37(c)(1) further states that to the extent the identity of a witness or information is not disclosed, such information and/or testimony may be excluded unless the failure was substantially justified or is harmless. See *Southern States Rack & Fixture, Inc. v. Sherwin-Williams Co.*, 318 F.3d 592, 597 (4th Cir. 2003); *Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323 (TTAB 2011).

¹ Any such statement should have been reduced to writing.

However, initial disclosures do not require an exhaustive search for all information or potential witnesses that could be used at trial.² See *Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d 1175, 1178 (TTAB 2010). Thus, the Board has declined to strike the witness testimony based on the offering party's failure to name the witness in initial disclosures. See *Great Seats Inc. v. Great Seats Ltd.*, *supra*.

Neither party served initial disclosures or expert testimony disclosures, and neither party filed a motion to compel initial disclosures or expert testimony disclosures from its adversary. Any motion to compel initial disclosures or expert testimony disclosures must be filed prior to the close of the discovery period. See Trademark Rule 2.120(e)(1); TBMP Section 523.02. Accordingly, applicant's objection to opposer's failure to serve initial disclosures or expert testimony disclosures is untimely. Cf. TBMP Sections and 523.04 and 524.04 (a party will not be heard to complain about the sufficiency of its adversary's discovery responses if it did not file a motion to compel). Rather, the Board will treat the parties' mutual failure to serve initial disclosures as their having waived such disclosures. Rule 37(c)(1) is therefore inapplicable.

² However, it would be curious for a trial witness not to have discoverable information. See *Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d at 1178.

To the extent that applicant seeks to strike Mr. Miller's testimony on the ground that opposer did not disclose him as an expert witness, the Board notes that Mr. Miller is not identified as an expert witness in opposer's pretrial disclosures. Rather, opposer's pretrial disclosures state that Mr. Miller has knowledge of the "advertising, marketing, promotion and sales of products bearing the [pleaded] DIVIDED mark in the United States." See also "Miscellaneous Changes to Trademark Trial and Appeal Board Rules," 72 Fed. Reg. 42242, 42246 (August 1, 2007). Because the record herein does not indicate that opposer is relying on Mr. Miller for expert testimony, the Board declines to strike the testimony deposition of Mr. Miller and exclude his testimony based on opposer's failure to name him expert testimony disclosures.

Regarding pretrial disclosures, Trademark Rule 2.121(e) states that a "party scheduled to present evidence must disclose the name" and identifying information "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" by not later than fifteen days prior to the opening of that party's testimony period. Trademark Rule 2.123(e)(3) states that "[a] motion to strike the testimony of a witness for lack of proper or adequate pretrial disclosure may seek exclusion of that portion of the testimony that was not adequately disclosed in accordance with Rule 2.121(e)."

Opposer timely served its pretrial disclosures on March 3, 2011, more than seven months prior to the taking of Mr. Miller's testimony deposition. Accordingly, Rule 2.123(e)(3) is inapplicable herein.

In view of the parties' waiver of initial disclosures, the absence of any indicia that opposer is relying upon Mr. Miller as an expert witness, and opposer's timely service of pretrial disclosures in compliance with Trademark Rule 2.121(e), the Board finds that striking Mr. Miller's testimony deposition is unwarranted. Applicant's motion to strike Mr. Miller's testimony deposition is denied.

Proceedings herein are resumed. Dates are reset as follows.

Defendant's Pretrial Disclosures Due	3/16/12
Defendant's 30-day Trial Period Ends	4/30/12
Plaintiff's Rebuttal Disclosures Due	5/15/12
Plaintiff's 15-day Rebuttal Period Ends	6/14/12

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.

If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.