

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Mailed: October 16, 2015

Opposition No. 91204122

Empire State Building Company
L.L.C.

v.

Michael Liang

**M. Catherine Faint,
Interlocutory Attorney:**

In accordance with the Board's order of January 20, 2015 denying summary judgment, the deadline for Opposer's pretrial disclosures to be served on Applicant was February 11, 2015, and the trial period, including the date for Opposer's rebuttal testimony period, closed July 11, 2015. Opposer's trial brief on the case, and evidentiary objections, were submitted September 9, 2015. This case now comes up on Applicant's motion, filed two days before the due date for Applicant's trial brief on October 7, 2015, to strike Opposer's 1) pretrial disclosures; 2) certain evidence or arguments in Opposer's trial brief; and 3) to suspend for consideration of the motion. The motion is contested. The Board

exercises its discretion to decide the motion prior to the time for filing a reply brief.¹

Pretrial Disclosures

In support of its motion, Applicant first argues that Opposer’s pretrial disclosures should be stricken as untimely, because the certificate of service does not conform with the Board’s “suggested format” as it does not state the date of service and the means of delivery; and Applicant’s counsel did not receive the disclosures until February 19, 2015, eight days after the due date.² Applicant also argues that the pretrial disclosures fail to comply with the requirements of Trademark Rule 2.121(e) and Fed. R. Civ. P. 26, because the disclosures fail to identify the substance of the witnesses’ anticipated testimony and the exhibits “are not clearly identified.”

In response, Opposer argues that its pretrial disclosures were timely served as shown by the certificate of service and the postage meter date on the envelope shown in the attachment to Applicant’s motion. Opposer submits the declaration of its counsel averring that Opposer timely served its pretrial disclosures via first class mail on February 11, 2015 as shown in the certificate of service, and that

¹ The Interlocutory Attorney telephoned Applicant’s attorney on October 9, 2015 and left a voice message requesting counsel’s availability for a teleconference. To date, no response to the telephone call was received.

² Applicant’s argument that the pretrial disclosures do not have any proof of mailing because the disclosures were not accompanied by a mailing certificate is without merit. A certificate of mailing is used to show proof of mailing to the USPTO. Trademark Rule 2.197. Pretrial disclosures should not normally be filed with the Board, Trademark Rule 2.121(e); *Carl Karcher Ents., Inc. v. Carl’s Bar & Delicatessen, Inc.*, 98 USPQ2d 1370, 1372 (TTAB 2011).

the postage stamp shown on that envelope was made by a Pitney Bowes postage meter. Attached to the declaration was a printout from the United States Postage Service (USPS) website identifying such postage meters as a “postage evidencing system,” and naming Pitney Bowes as an “Authorized Meter Provider.”³ Also attached was a page from the Pitney Bowes website explaining, “[y]ou cannot change the printed date to a date earlier than the meter’s internally held date (in an effort to ‘backdate’ the mail.)” Opposer argues Applicant did not make any objection at the time the pretrial disclosures were received, upon receipt of the notices of deposition testimony, during depositions, or at any time before or during Opposer’s or Applicant’s testimony periods, waiting over seven months, until two days before Applicant’s trial brief was due, to file the motion to strike.

Pretrial disclosures are a device meant to facilitate the orderly taking of testimony and receipt of evidence at trial. 8A Wright & Miller, *Fed. Prac. & Proc. Civ. 3d* § 2054 (Westlaw 2015). Fed. R. Civ. P. 26(a)(3)(A) requires parties to provide pretrial disclosures identifying each witness a party expects to, or may, call and “an identification of each document or other exhibit.” The Federal Rule is slightly modified by Trademark Rule 2.121(e) which requires “a general summary or list of the types of documents and things which may be introduced as exhibits during the testimony of the witness.” *Carl Karcher*, 98 USPQ2d 1373 at n.4 (noting Board practice varies slightly from Fed. R. Civ. P. 26(a)(3)(A)); *see also*, *Great Seats, Inc. v. Great Seats, Ltd.*, 100 USPQ2d 1323, 1326 (TTAB 2011) (observing Board proceedings are governed by Federal Rules wherever applicable

³ 57 TABVUE 20-21 (October 9, 2015).

and appropriate except as otherwise provided in Trademark Rules of Practice). The Board has said previously that timely service of pretrial disclosures is meant to avoid incidents of “unfair surprise” to the adverse party. *Carl Karcher*, 98 USPQ2d at 1372. Under the Federal Rules, however, any objection to the pretrial disclosures that are not made within fourteen days after receipt of those disclosures is waived unless excused by the court for good cause. Fed. R. Civ. P. 26(a)(3)(B).

Where, as here, Applicant has waited until well after the close of the testimony period to move to strike the pretrial disclosures as untimely, and has provided no good cause for the Board to consider the motion, such motion is simply untimely. *See Spier Wines (PTY), Ltd. v. Sheper*, 105 USPQ2d 1239, ^ (TTAB 2012) (noting judicial economy is best served by bringing issue of untimely or insufficient pretrial disclosures promptly to Board’s attention prior to deposition).

Further, a review of Opposer’s pretrial disclosures attached to Applicant’s motion shows the disclosures contain a certificate of service stating they were sent to Applicant’s counsel via U.S. Mail on February 11, 2015, and the envelope in which the disclosures were received show a postage meter date of February 11, 2015.⁴ The certificate of service shows the date of service, identifies the document served, the party and address where the document was served and is signed,⁵ and meets the requirements of Trademark Rule 2.119(a). Applicant’s objection that

⁴ 56 TTABVUE 8-19 (October 7, 2015).

⁵ *Id.* at 18.

the certificate does not follow the “suggested format” shown in TBMP § 113.03 elevates form over substance. As long as the elements required by the Rule are met, the substance of the Rule is also met.

In view thereof, Applicant’s motion to strike Opposer’s pretrial disclosures is **denied**.

Evidence or Argument in Opposer’s Trial Brief

Applicant next argues that Opposer did not properly plead or disclose the version of its relied upon mark used at trial. Objections to exhibits or testimony based on substantive issues in the case, as contrasted with the technical issue presented in considering whether pretrial disclosures were filed, or filed in the proper form, will not be considered by the Board on a motion to strike. *Carl Karcher*, 98 USPQ2d at 1373 n.4.

Schedule

As the Board has denied Applicant’s motion to strike the pretrial disclosures, and the motion to strike evidence is deferred until final decision, Applicant’s motion to suspend is **denied**.

However, in light of the confusion that may have entered the briefing schedule due to Applicant’s motion, dates are reset as set out below:

Brief (if any) for party in position of defendant shall be due: October 20, 2015

Reply brief (if any) for party in position of plaintiff shall be due: November 4, 2015

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.
