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

Proceeding	91204897
Party	Defendant Laguna Lakes Community Association, Inc.
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Attachments	Reply in Support of Motion to Strike Marino Deposition.pdf(30781 bytes )

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

<b>John Gerard Marino,</b>	)	
	)	<b>Consolidated Opp. No. 91/204,897</b>
<b>Opposer,</b>	)	<b>91/204,941</b>
	)	
v.	)	<b><u>REPLY IN SUPPORT OF MOTION</u></b>
	)	<b><u>TO STRIKE TRIAL TESTIMONY</u></b>
<b>Laguna Lakes Community Association,</b>	)	<b><u>OF JOHN GERARD MARINO,</u></b>
<b>Inc.,</b>	)	<b><u>INCLUDING EXHIBITS</u></b>
	)	
<b>Applicant.</b>	)	

Opposer, John Gerard Marino, not only misses the mark in his Response to Applicant’s Motion to Strike his trial testimony, including the exhibits introduced therein [62 TTABVUE], but makes several misrepresentations warranting reply.

First, Opposer’s continued lack of knowledge of Board rules and procedure is palpable. Applicant does not “fear[] that [it has] no ability to win this proceeding on the merits” as wildly insinuated by Opposer. *See* 66 TTABVUE, Response to Motion to Strike, at ¶1. Rather, Board rules require Applicant to file its Motion to Strike before proceeding to the merits. *See* TBMP § 702.01 (“Promptly after the testimony is completed, the adverse party, to preserve the objection [regarding inadequate pretrial disclosures], shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances.”); TBMP § 533.02 (“an adverse party may cross-examine the witness under protest while reserving the right to object to the receipt of the testimony in 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”). Consequently, two decisions that Opposer generally cited to – *Ctrl Systems Inc. v. Ultraphonics of North America Inc.*, 52 USPQ.2d 1300 (TTAB 1999) (which concerns a motion to set aside a judgment) and *Florists’ Transworld Delivery, Inc. v. McAfee*,

1999 LEXIS 582 (TTAB 1999) (which concerns the late filing of answers to requests for admission) – have absolutely no application whatsoever to the evaluation of Applicant’s Motion to Strike trial testimony that was filed pursuant to 37 C.F.R. § 2.123 (e)(3) and TBMP §§ 533.02 and 702.01.

Second, and similarly, Opposer’s reliance on *Hunt Control Sys. v. Koninklijke Philips Elec. N.V.*, 98 U.S.P.Q.2d 1558 (TTAB 2011), *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 U.S.P.Q.2d 1750 (TTAB 2013), and *Marshall Field & Co. v. Cookies*, 25 U.S.P.Q.2d 1321 (TTAB 1992) is entirely misplaced. Applicant is not seeking to strike Opposer’s trial testimony on the basis of substantive objections (at least not yet). Rather, Applicant is seeking to strike Opposer’s trial testimony because it was not “taken in accordance with the applicable [Board] rules.” *Alcatraz Media, Inc.*, 107 U.S.P.Q.2d 1750; *accord Marshall Field & Co.*, 25 U.S.P.Q.2d 1321 (emphasis added) (providing the Board’s general practice not to “strike testimony depositions which were regularly taken”).

Third, Opposer claims that *Jules Jurgensen/Rhapsody, Inc. v. Peter Baumberger*, 91 U.S.P.Q.2d 1443 (TTAB 2009), *ConAgra Inc. v. Saavedra*, 4 USPQ2d 1245 (TTAB 1987), and *National Aeronautics and Space Administration v. Bully Hill Vineyards Inc.*, 3 USPQ2d 1671, (TTAB 1987) are “non-precedential.” *See* 66 TTABVUE, Response to Motion to Strike, at ¶2. This is simply wrong. All are precedential decisions that are binding upon the Board. Opposer cannot rectify his failure to comply with these precedents and the Board rules discussed therein by falsely claiming the decisions are “non-precedential.”

Under *Peter Baumberger*, “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. \* \* \* [T]he disclosure of the name of

each prospective witness still must be made, along with identifying information, a summary of subjects on which the witness will or may testify and a summary of the types of documents or exhibits that will or may be introduced during the testimony.” *Id.* Opposer failed to include the required summaries and failed to supplement his pretrial disclosures as ordered by the Board – incurable violations that have resulted in considerable prejudice to Applicant. Opposer’s suggestion that Applicant has “no basis to cry foul” (*see* 66 TTABVUE, Response to Motion to Strike, at ¶3) over Opposer’s intentional disregard of Board rules and orders is an unfortunate reflection of the outrageousness of his conduct during his trial deposition which cannot go unsanctioned.

Pursuant to *ConAgra Inc.* and *National Aeronautics and Space Administration*, documents not produced until after the start of trial generally are stricken when the documents are within the scope of documents requested but not produced during discovery. Opposer cannot seriously contend that Applicant’s counsel “did not ask in advance of the trial testimony [for] any trial exhibits” (*see* 66 TTABVUE, Response to Motion to Strike, at ¶4) when he is aware that Applicant requested via interrogatory that Opposer “[i]dentify all exhibits [he] intend[ed] to introduce into evidence at trial” and produce copies of all documents identified or that reasonably should have been identified in response to said interrogatory. *See* 64 TTABVUE, Motion to Strike, at pp. 9-10. For Opposer to represent to the Board that “these documents were not requested in any discovery request” (*see* 66 TTABVUE, Response to Motion to Strike, at ¶5) is a desperate, flat-out, bold-faced lie and intentional misrepresentation. “A party is required to respond completely to discovery to the best of its ability and to supplement discovery responses as soon as it becomes aware of new information.” *Quality Candy Shoppes/Buddy Squirrel of Wisconsin Inc. v. Grande Foods*, 90 U.S.P.Q.2d 1389 (TTAB 2007).

Applicant and its counsel were fully prepared based on everything that had been produced by Opposer. Applicant's counsel justifiably expected Opposer to rely on only those documents that had been produced before trial. Of course neither Applicant nor its counsel can be prepared for what they do not know exists (or what was not produced to them). Did Opposer really expect Applicant to look through the entire world of "public records" and "internet printouts" and guess which ones out of the millions of potential "records" and "printouts" (none of which Opposer produced in discovery) were going to be used as exhibits at trial?<sup>1</sup> Opposer makes no attempt to refute that he purposely "hid the ball" and "sandbagged" Applicant by making the deliberate and calculated decision to conduct his trial "by ambush." Opposer made absolutely no effort to supplement his discovery responses, and for this reason, "[a]ll of the document[s] used as trial exhibits were [not] encompassed in the pretrial disclosures." *See* 66 TTABVUE, Response to Motion to Strike, at ¶5. Under these circumstances, for Opposer to suggest that Applicant's counsel was "sorely unprepared" and that any "issues really were due to [Applicant] counsel's lack of preparation" is not only ridiculous, but frankly unprofessional.

Fourth, Opposer cites no precedent or other authority for the novel contention that previously produced documents with new annotations can be used for "demonstrative purposes." Perhaps if Opposer had produced these documents with new annotations to Applicant in discovery or before trial as requested in written discovery, this would be acceptable. However, Opposer failed to do this. At this point, the proverbial "bell cannot be unrung," and the continued damage to Applicant cannot be undone. If these documents were so important or vital

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<sup>1</sup> Moreover, Opposer is incorrect that the "internet printouts" would be admissible "as general internet searches that the Trademark Office regularly relies upon to determine whether an applicant is entitled to trademark registration." *See* 66 TTABVUE, Response to Motion to Strike, at ¶5. Again, there are specific Board rules and procedures regarding the use of "internet materials" that may be submitted pursuant to a notice of reliance. *See* TBMP §704.08(b). Opposer not only failed to identify any "internet materials" in his notice of reliance, but also failed to explain how each of the "internet printouts" independently satisfy TBMP §704.08(b).

to Opposer's case, he should have produced them to Applicant as required by Board rules and procedures – plain and simple. Opposer should not be provided with any special treatment.

The charade that Opposer is playing must stop. Opposer's dilatory conduct and disregard for Board rules and procedures have done nothing but continue to delay these proceedings and force Applicant to incur a substantial amount of expenses that would otherwise be avoidable if Opposer simply played by the rules. For all of the reasons discussed herein and those discussed in Applicant's Motion to Strike, Applicant requests that Opposer's testimony be stricken in its entirety.

Respectfully submitted,

/s/ Chad R. Rothschild

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**CERTIFICATE OF SERVICE**

I hereby certify that on the 18th day of November, 2014 a copy of the foregoing *Reply in Support of Motion to Strike Trial Testimony of John Gerard Marino, Including Exhibits* was served by e-mail upon:

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