

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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General Contact Number: 571-272-8500

CME

Mailed: March 4, 2015

Opposition No. 91204897

John G. Marino

v.

Laguna Lakes Community  
Association, Inc.

**Christen M. English, Interlocutory Attorney:**

This case now comes up on Applicant's motion, filed October 17, 2014, to strike the testimony deposition of Opposer, John Gerard Marino, and (the "Marino Deposition"). The motion is fully briefed.

Applicant argues that "the totality of the circumstances and egregiousness of Opposer's conduct tainted the entire trial deposition of Opposer, which must consequently be stricken in its entirety." Motion, pp. 3-4. More specifically, Applicant argues that: (1) Opposer's counsel impermissibly coached Opposer's testimony through his questions and annotations to exhibits, *see id.* at p. 3; (2) the exhibits to Opposer's testimony are inadmissible hearsay because they contain annotations, *see id.* at pp. 2-3; (3) Opposer "inappropriate[ly] introduce[ed] ... documents during [the Marino] [D]eposition that were never produced during discovery and never identified in his [p]retrial [d]isclosures," *id.* at p. 4 (emphasis omitted); *see also id.* at

pp. 6-7 and 11-14; (4) Opposer served his pretrial disclosures two weeks late, *id.* at pp. 4-5; (5) Opposer's pretrial disclosures were deficient because Opposer "failed to provide 'a general summary or list of subject on which [his identified witnesses were] expected to testify,'" *id.* at p. 5; and (6) at the deposition, Opposer failed to provide copies of the testimony exhibits to Applicant's lead trial counsel who appeared at the deposition by telephone. *See id.* at pp. 1 and 9.

In response,<sup>1</sup> Opposer contends that Applicant was aware that Mr. Marino would testify as Mr. Marino identified himself as a witness in his initial disclosures and Applicant took Mr. Marino's discovery deposition, *see* Response, p. 3; that "even if this tribunal believes that there was some procedural deficiency in the trial testimony of [Mr.] Marino, '[u]ltimately, the Board is capable of reviewing the relevant strength or weak[ness] of the objected to testimony and evidence,'" *id.*; that "it is not the fault of [Opposer] that [Applicant's lead trial] counsel chose not to attend, in person, the trial testimony of [Mr.] Marino," *id.* at p. 4; that "there was an attorney present on behalf of [Applicant] who was provided with copies of each trial exhibit upon which [Mr.] Marino was examined," *id.*; and that "at no time during the deposition did counsel on the phone bother to attempt to have all of the exhibits faxed or emailed to him," *id.*; that any prejudice can be cured by Applicant taking the testimony deposition of Mr. Marino, *see id.* at pp. 4-5;

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<sup>1</sup> Opposer's response brief is not paginated as required by Trademark Rule 2.126(a)(5). Strict compliance with this rule is required in all future filings.

that the annotations on the trial exhibits were “demonstrative aids” that “should not be objectionable,” *id.* at p. 5; and that “all of the documents used as trial exhibits were encompassed in the pretrial disclosures.” *Id.*

As an initial matter, the Board does not review trial testimony or evidence prior to final decision. *See* TBMP § 502.01 (2014) and cases cited in footnote 2 therein; *see also Carl Karcher Enters. Inc. v. Carl’s Bar & Delicatessen Inc.*, 98 USPQ2d 1370 (TTAB 2011) p. 1372, n.2 and 4 (“[A]n objection to exhibits or testimony based upon the substance being beyond the scope of the pretrial disclosure ... will be decided in connection with a final decision.”). For this reason, the Board defers until final decision consideration of Applicant’s motion to the extent it seeks to strike the Marino Deposition on grounds of alleged witness coaching, hearsay, and that the deposition includes documents that were not produced in discovery or adequately identified in Opposer’s pretrial disclosures.<sup>2</sup> As such, the Board in this order addresses

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<sup>2</sup> To the extent Applicant’s motion is based on the argument that Opposer did not specifically identify documents in his pretrial disclosures and did not provide Applicant with copies of his trial exhibits in advance, Applicant should note that Trademark Rule 2.121(e) requires that pretrial disclosures include only 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). “The Board does not require pretrial disclosure of each document or other exhibit that a party plans to introduce at trial...” TBMP § 702.01. Similarly, to the extent Applicant argues for the estoppel sanction on the ground that Opposer failed to adequately respond to its discovery requests 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 his answers to Applicant’s interrogatories,’” Motion, p. 9, Applicant is advised that such discovery requests are improper as a party is not required, in advance of trial, to disclose each document or other exhibit it plans to introduce. TBMP § 414(7); *see also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42246 (August 1, 2007).

only whether the Marino Deposition should be stricken on grounds that Opposer's pretrial disclosures were untimely and technically deficient and that Applicant's lead trial counsel did not have copies of Opposer's testimony exhibits during the Marino Deposition.

Trademark Rule 2.123(e)(3) provides that if pretrial disclosures are improper or inadequate, "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."<sup>3</sup> In determining Applicant's motion, the Board is guided by the following five-factor test: "1) the surprise to the party against whom the evidence would be offered; 2) the ability of that party to cure the surprise; 3) the extent to which allowing the testimony would disrupt the trial; 4) importance of the evidence; and 5) the nondisclosing party's explanation for its failure to disclose the evidence." *Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1327-28 (TTAB 2011); *see also* TBMP § 533.02(b).

Trademark Rule 2.121(e) requires that a party serve its pretrial disclosures "no later than fifteen days prior to the opening of [its] testimony period" and that such disclosures disclose (1) "the name and, if not previously

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<sup>3</sup> As a practical matter, however, judicial economy would have been better served if Applicant had raised objections regarding the timeliness and adequacy of Opposer's

provided, the telephone number and address of each witness from whom it intends to take testimony, or may take testimony if the need arises, and 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; (2) “a general summary or list of subjects on which the witness is expected to testify”; and (3) “a general summary or list of the types of documents and things which may be introduced as exhibits during the testimony of the witness.”

With respect to timeliness, Opposer’s deadline to serve pretrial disclosures, as last reset, was April 15, 2014. *See* Board’s order of February 3, 2014, p. 8. Opposer served its pretrial disclosures more than two weeks late on May 1, 2014. *See* Motion, Exhibit 4 to Rothschild Declaration. Subsequently, on June 9, 2014, these consolidated proceedings were suspended pending disposition of two contested motions. On September 29, 2014, the Board issued an order addressing the motions, resuming proceedings and resetting Opposer’s testimony period to close on October 10, 2014. *See* TTABVUE # 58. The Marino Deposition took place on October 8, 2014. Accordingly, although Opposer’s pretrial disclosures were untimely, Applicant was aware that Opposer intended to testify on his own behalf more than five months prior to the Marino Deposition. In addition, Applicant does not dispute that Mr. Marino identified himself as a potential witness in his

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pretrial disclosures before the deposition was set to take place. *Carl Karcher*, 98 USPQ2d at 1372, n.4.

initial disclosures. As such, the Board cannot conceive of any real surprise or harm to Applicant as a result of Opposer's untimely pretrial disclosures, and Applicant has identified no such harm.

In addition to being untimely, Opposer failed to include in his pretrial disclosures a general summary or list of subjects about which his potential witnesses were expected to testify as required by Trademark Rule 2.121(e). However, Opposer's pretrial disclosures did include a list of the types of documents that might be introduced as exhibits during the testimony of Opposer's witnesses. As a practical matter, the list of document types in Opposer's pretrial disclosures provided Applicant with some information about the types of subjects upon which Opposer's witnesses might testify lessening any surprise resulting from the deficiency. Moreover, Applicant may cure any surprise caused by the technical deficiency by taking Mr. Marino's deposition during its trial period.<sup>4</sup> The Board notes that Applicant already took the discovery deposition of Mr. Marino. *See* Response, p. 3.

In addition, with respect to both the untimeliness of Opposer's pretrial disclosures and the technical deficiency therein, Applicant has not pointed to any disruption that will result if Mr. Marino's testimony is allowed, and the testimony is important evidence for trial as Mr. Marino is the Opposer in these consolidated proceedings.

Lastly, the Board considers Applicant's objection that its lead trial counsel

who appeared at the Marino Deposition by telephone did not have copies of the testimony exhibits until after the Marino Deposition was completed. Applicant's lead trial counsel chose to appear at the Marino Deposition by telephone with an "observer" counsel appearing in person "to assist" him. Motion, pp. 6 and 9. Applicant has not explained why its lead trial counsel did not arrange for a video conference, which would have allowed him to see the exhibits. More importantly, Opposer provided copies of the deposition exhibits to Applicant's "observer" counsel who, as Applicant has explained, was physically present at the deposition "to assist" Applicant's lead trial counsel. The Board finds that this was sufficient.

In view of the foregoing, and upon consideration of all the relevant circumstances, the Board finds that Opposer's untimely and technically deficient pretrial disclosures were harmless and that it was sufficient for Opposer to provide copies of the testimony exhibits to Applicant's counsel who was physically present at the deposition. Accordingly, Applicant's motion to strike the Marino Deposition on these bases is **DENIED**.

Proceedings are resumed and dates are reset as follows:

Defendant's Pretrial Disclosures Due	<b>3/22/2015</b>
Defendant's 30-day Trial Period Ends	<b>5/6/2015</b>
Plaintiff's Rebuttal Disclosures Due	<b>5/21/2015</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>6/20/2015</b>

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<sup>4</sup> If Applicant wishes to depose Opposer during its testimony period and Opposer is unwilling to testify voluntarily, Applicant will need to secure Opposer's attendance by subpoena. *See* TBMP § 703.01(f)(2).

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 Trademarks Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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