

ESTTA Tracking number: **ESTTA636524**

Filing date: **11/03/2014**

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

Proceeding	91210379
Party	Plaintiff Atlas Brewing Company, LLC
Correspondence Address	LEMA A KHORSHID FUKSA KHORSHID LLC 70 W ERIE, 2ND FLOOR CHICAGO, IL 60654 UNITED STATES lema@fklawfirm.com, robert@fklawfirm.com
Submission	Motion to Quash
Filer's Name	Perry Gattegno
Filer's e-mail	perry@fklawfirm.com, lema@fklawfirm.com
Signature	/perry gattegno/
Date	11/03/2014
Attachments	Motion to Quash - McEvoy Deposition.pdf(4158900 bytes )

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

<b>ATLAS BREWING COMPANY, LLC,</b>	)	
	)	
<b>Opposer,</b>	)	<b>Opposition No. 91210379</b>
	)	
v.	)	<b>Serial No. 85/642,549</b>
	)	
<b>ATLAS BREW WORKS LLC,</b>	)	<b>Mark: ATLAS</b>
	)	
<b>Applicant.</b>	)	

**OPPOSER’S MOTION TO QUASH NOTICE OF DEPOSITION OF APPLICANT**  
**and**  
**MOTION FOR SUSPENSION OF PROCEEDINGS**

Opposer ATLAS BREWING COMPANY (“Opposer”) hereby moves pursuant to Rule 26(a)(3) and 37(c)(1) of the Federal Rules of Civil Procedure and Rules 2.121(e) and 2.123(c) of the Trademark Rules of Practice, 37 C.F.R. § 2.121 and 2.123, for an order quashing the Notice of Deposition of ATLAS BREW WORKS LLC (“Applicant”) set for November 10, 2014, and preventing the deposition of Mr. Pat McEvoy, a private investigator engaged by Applicant. This Motion does not apply to Applicant’s Notice of Deposition of Mr. Justin Cox, currently set for November 6, 2014, to which Opposer has no objection.

**INTRODUCTION**

Applicant has noticed-up the trial testimony deposition of a witness, Pat McEvoy, whose identity and intention to testify were not disclosed at any point before Applicant’s September 2014 pretrial disclosures. Opposer has no idea who this witness is, why his testimony might be relevant to this case, or what evidence he is likely to discuss. Potential witnesses must be disclosed in the early stages of a case under Federal and Trademark Trial and Appeal Board (“Board”) rules of procedure. More importantly, Opposer would be prejudiced by the

introduction of Mr. McEvoy as a witness at this time, given that Opposer did not have the benefit of discovery to learn the nature of Applicant's witness's testimony, his relationship to the matter at bar, or generally what his involvement in the case may be. Accordingly, the inclusion of any such testimony would be unreasonably prejudicial to Opposer. The testimony should be barred.

### **FACTS**

Applicant's trial period in this proceeding opened after Opposer's trial period expired on September 5, 2014. Initial Disclosures and Expert Disclosures, according to the original dates issued by the Board, were due on August 2, 2013, and November 30, 2013, respectively.

Applicant's Initial Disclosures, dated August 2, 2013, listed Mr. Justin Cox, Chief Executive Officer of Applicant, and Mr. William Durgin, Head Brewer of Applicant, as potential witnesses.

Applicant did not submit any Expert Disclosures before or after the November 30, 2013, deadline. Discovery in this Opposition closed on December 30, 2013. Pat McEvoy was not mentioned in either disclosures.

According to trial dates issued by the Board on August 4, 2014, Applicant's Pretrial Disclosures were due on September 20, 2014, then reset upon consent of the parties to October 20, 2014. Applicant provided its Pretrial Disclosures on September 18, 2014. The Pretrial Disclosures are attached hereto as Exhibit A.

Applicant provided a Notice of Deposition for Mr. Pat McEvoy on October 15, 2014. The Notice of Deposition is attached hereto as Exhibit B. He is listed as an Investigator for Research Consultants Group. Mr. McEvoy was not listed in Applicant's Initial Disclosures or Expert Disclosures. His name and involvement with this Opposition were not known to Opposer until Applicant filed its Pretrial Disclosures, which stated that Mr. McEvoy would be available to testify about Opposer's use of its ATLAS mark.

## MEMORANDUM OF LAW

Applicant's Notice of Deposition for Pat McEvoy of Research Consultants Group should be quashed because Applicant did not disclose him as a potential witness in its Initial Disclosures. Opposer will be prejudiced by the introduction of testimony from such a surprise witness because it has had no opportunity to conduct discovery about the likely content of his testimony of the evidence he plans to discuss.

Trademark Rule 2.121(e) requires that:

"...no later than fifteen days prior to the opening of each testimony period, or on such alternate schedule as may be provided by order of the Board, the party scheduled to present evidence must disclose the name and, if not previously provided, the telephone number and address 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."

According to the original dates the Board set in this Opposition, Applicant's Initial Disclosures were due August 2, 2013, and Applicant's Expert Disclosures were due November 30, 2013. If Applicant wished to name Mr. McEvoy as a potential trial witness, he should have been disclosed prior to the close of discovery December 30, 2013, allowing Opposer to conduct discovery about his testimony. Applicant failed to do so, and never sought to file amended or supplementary disclosures of any kind.

Applicant finally named Mr. McEvoy as a trial witness on September 18, 2014. This first mention of Mr. McEvoy's potential involvement with the Opposition came after each of the disclosure deadlines and the discovery deadline had passed, and after Opposer had already conducted its trial period, which closed on September 5, 2014. Even if Applicant did not know that it would be engaging Mr. McEvoy specifically as a private investigator during the initial

disclosure period, it presumably knew that such an engagement would be a part of its trial strategy well in advance of the close of discovery. Applicant had every chance to provide Opposer with notice of its intention to call such a witness and, for reasons of its own, chose not to disclose this potential witness at any appropriate point in the litigation. Had Opposer known about Mr. McEvoy's involvement in the Opposition, it might have elicited testimony from its own witnesses or filed other evidence via Notice of Reliance in order to address his potential testimony. Applicant's untimely disclosure has robbed Opposer of the ability to do so. McEvoy's testimony would unreasonably prejudice the outcome of this Opposition and should be quashed.

Fed. R. Civ. P. 26(a)(3), allows parties to know the identity of trial witnesses well in advance of trial, thus avoiding surprise and ensuring a fair trial. *See Spier Wines (PTY) Ltd. V. Ofer Z. Shepherd*, 105 U.S.P.Q.2d 1239 (T.T.A.B. 2012) (failure to identify a witness in initial disclosures, supplemental initial disclosures, or in response to interrogatories was prejudicial to the opposing party such that the witness in question was excluded from testifying). Parties are required to disclose timely the names and identifying information of any witness who might testify at trial. *Jules Jurgensen/Rhapsody Inc. v. Baumberger*, 91 U.S.P.Q. 2d 1443 (T.T.A.B. 2009). Applicant did not disclose Mr. McEvoy as a potential trial witness, in violation of Rule 26(a)(3). His testimony should be barred and the Notice of Deposition quashed.

The Federal Rules of Civil Procedure and the Board's rules clearly require parties to disclose the name of each individual likely to have discoverable information in both initial disclosures and pretrial disclosures. Fed. R. Civ. P. 26(a)(3)(A); 37 C.F.R. § 2.121(e). Additionally, the Board's rule regarding pretrial disclosures requires not only the name of any potential witness, but also identifying information such as relationship to any party, job title, occupation, and a general summary of subjects on which the witness is expected to testify. 37

C.F.R. § 2.121(e). Even after Applicant disclosed Mr. McEvoy in September, its disclosure contravened Rule 26 and Rule 2.121 because it only informed Opposer of the most bare-bones generic information, and without the benefit of discovery to allow Opposer to prepare reasonably for his testimony. *See Ex. A.*

This is not an instance where new information organically came to light outside the bounds of the dates set forth by the Board. Instead, Applicant has retained an outside consultant, presumably for the specific purpose of uncovering information related to this Opposition, yet it never stopped to inform Opposer that such testimony may be part of the Opposition – not in initial disclosures, not in expert disclosures, not in responses to interrogatories, not in responses to requests for production, not even in response to any discussions about Opposer’s use of its mark during Opposer’s entire trial period.

Applicant’s failure to disclose Mr. McEvoy cannot be excused under board precedent. *See Great Seats, Inc. v. Great Seats, Ltd.*, 100 U.S.P.Q.2d 1323 (T.T.A.B. 2011) (setting forth five factors to evaluate whether the failure to identify a witness is substantially justified or harmless). The five factors the board considers under such circumstances are:

"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."

*Id.*

Regarding surprise to Opposer, Applicant, until its Pretrial Disclosures, provided Opposer absolutely no notice that Mr. McEvoy would be involved in this Opposition; Opposer had never seen nor heard Mr. McEvoy’s name until that point. This is prejudicial to Opposer, which was deprived of the opportunity to seek discovery from Mr. McEvoy and will continue to have no ability to predict the purpose of Mr. McEvoy’s testimony, which the discovery process

would have elicited. *See Great Seats*, 100 U.S.P.Q.2d at 1327. Indeed, Applicant's Pretrial Disclosures or Notice of Deposition do not disclose even a general summary of subjects on which the witness is expected to testify, instead merely stating that he would testify about Opposer's use of its ATLAS mark. *See Ex. A*; 37 C.F.R. § 2.121(e). The Board's rules require identifying information of this sort, as well as the witness's relationship to a party, job title, and occupation. Merely listing Mr. McEvoy's occupation, title and contact information as well as a general note that he would testify about Opposer's use of its own mark are insufficient to allow Opposer to prepare for his deposition. Accordingly, Applicant failed to disclose the connection Mr. McEvoy has to this Opposition. *See Ex. A*. This factor weighs in favor of Opposer. *See Great Seats*, 100 U.S.P.Q.2d at 1327 *et seq.*

Regarding Opposer's ability to cure the surprise, Opposer, plainly put, has none without resort to procedural filings that will greatly delay the adjudication of this case. Opposer's first opportunity to determine the nature of Mr. McEvoy's testimony and his relationship with the parties will be at the deposition itself. *Id.* To attempt otherwise, it must file this Motion and potentially others to reopen procedural aspects of this Opposition that have been closed for nearly a year. The Board has issued initial, expert and pretrial disclosure deadlines precisely to stave off such delays in adjudication. Accordingly, this factor weights in Opposer's favor.

Regarding disruption to the trial, this factor clearly favors Opposer as well. Opposer's only practical options at this point are to file this Motion or to file a motion to reopen discovery, despite the fact that its trial period has already ended. Either way, Applicant's failure to disclose Mr. McEvoy prior to its Pretrial Disclosures has resulted in the Board's need to review an additional dispute and, if this motion is granted, suspend or at least toll the overall Opposition proceedings in order to adjudicate it. *See Great Seats*, 100 U.S.P.Q.2d at 1327 *et seq.*

Regarding the importance of the evidence to the trial, Opposer cannot speculate as to the nature of Mr. McEvoy's testimony. However, it should be noted that Mr. McEvoy is listed in the Pretrial Disclosures as being available to testify about Opposer's use of its ATLAS mark, not Applicant's use of its ATLAS mark. If Applicant wished to raise questions about an outside consultant's accounts of Opposer's use, it should have done so in discovery, allowing Opposer the opportunity to produce documents or testimony in response. Without such an opportunity, the prejudicial nature of Mr. McEvoy's testimony will far outweigh whatever importance it may or may not have at trial.

Finally, regarding Applicant's explanation for its nondisclosure, Applicant has yet to proffer any. To allow Mr. McEvoy "to testify under these circumstances would overlook and essentially excuse [Applicant's] failure to supplement discovery and reward its correspondingly late disclosure of these witnesses." *Great Seats*, 100 U.S.P.Q.2d at 1327 *et seq.* Accordingly, this factor weighs strongly in Opposer's favor as well.

Putting together the five factors, Applicant's late disclosure clearly contravened Board and Federal rules of procedure and prejudiced Opposer's case. Opposer's discovery and trial periods have already been completed – in the first case, for nearly a year – and now it faces the prospect of walking blindly into a testimonial deposition where it has no inkling of the subject or nature of the testimony beyond the vague note that an outside, hostile witness will testify about Opposer's use of its own mark. Applicant's Notice of Deposition for Mr. McEvoy must be quashed, and his testimony barred.

**WHEREFORE**, Opposer respectfully requests that Applicant's Notice of Deposition of Mr. McEvoy be quashed and no trial deposition be had. Additionally, Opposer requests that this proceeding, after the deposition of Mr. Cox scheduled for November 6, 2014, but before the

deposition at issue noticed for November 10, 2014, be suspended pending the Board's ruling on this Motion.

Respectfully submitted,

FUKSA KHORSHID, LLC



---

Attorneys for Opposer, Atlas Brewing Company LLC  
Lema Khorshid  
Thomas Carroll  
Perry Gattegno  
70 W Erie, 2<sup>nd</sup> Floor  
Chicago, IL 60654  
Phone: (312) 266-2221  
Fax: (312) 266-2224

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of this Motion to Quash and Motion to Suspend has been sent via First Class Mail, postage prepaid to Anna L. King, by First Class Mail on November 3, 2014, and courtesy copy via electronic mail to:

Anna L. King, Esq.  
Banner & Witcoff, Ltd.  
Ten South Wacker, Suite 3000  
Chicago, IL 60606  
aking@bannerwitcoff.com

Signed:  \_\_\_\_\_

One of Applicant's Attorneys

# EXHIBIT A



BANNER & WITCOFF, LTD.  
INTELLECTUAL PROPERTY LAW

TEN SOUTH WACKER DRIVE  
SUITE 3000  
CHICAGO, ILLINOIS 60606-7407  
TEL: 312.463.5000  
FAX: 312.463.5001  
www.bannerwitcoff.com

Anna L. King  
Direct Dial: 312-463-5551  
Fax Number: 312-463-5001  
E-mail: [aking@bannerwitcoff.com](mailto:aking@bannerwitcoff.com)

September 18, 2014

**VIA FIRST CLASS MAIL & CONFIRMATION COPY VIA EMAIL to  
[lema@fklawfirm.com](mailto:lema@fklawfirm.com), [robert@fklawfirm.com](mailto:robert@fklawfirm.com) and [perry@fklawfirm.com](mailto:perry@fklawfirm.com)**

Lema A Khorshid  
Fuksa Khorshid LLC  
70 W Erie, 2nd Floor  
Chicago, IL 60654

Re: Atlas Brewing Company, LLC v. Atlas Brew Works LLC  
Opposition No. 91210379

Dear Ms. Khorshid:

Please find enclosed Applicant's Pretrial Disclosures.

Please contact us if you have any questions.

Sincerely,

Anna L. King

Enclosure

cc: Evan M. Clark (via email)  
Ross A. Dannenberg (via email)  
Helen Hill Minsker (via email)



Washington, DC 20002 Tel: (202) 832-0420	development;  (c) Advertising, marketing, promotion and sales of Applicant's goods bearing the ATLAS trademark;  (d) Goods offered by Applicant, channels of trade, geographic scope of offering of Applicant's goods.
Pat McEvoy Investigator Research Consultants Group P.O. Box 50250 Indianapolis, IN 46250 Tel: (800) 255-8976	(a) Opposer's use of its ATLAS mark.

**B. A copy of, or a description by category and location of all documents, data compilations and tangible things in the possession of the party that are relevant to disputed facts alleged with particularity in the pleadings.**

Applicant believes the following categories of documents may be relevant to disputed facts as alleged in the pleadings:

1. Documents containing information relating to Applicant's application to register the ATLAS mark ("Applicant's Mark");
2. Documents containing information relating to Applicant's selection, adoption, proposed use and use of Applicant's Mark;
3. Documents containing information relating to knowledge of Applicant's business and business development;
4. Documents evidencing advertising, marketing, promotion and sales of Applicant's goods bearing Applicant's Mark;
5. Documents demonstrating the nature of the goods offered by Applicant, channels of trade, and geographic scope of offering of Applicant's goods;

6. Documents containing information relating to Opposer's use of its ATLAS trademark.

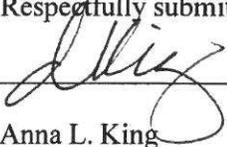
At this time, Applicant believes essentially all documents within its control are located at its office in Washington, DC, or are publicly available through the United States Patent and Trademark Office.

**C. Certification of Disclosure**

The undersigned hereby certifies that, to the best of her knowledge, information and belief, formed after an inquiry that is reasonable under the circumstances, the foregoing Pretrial Disclosure is complete and correct as of the time made. However, as noted above, Applicant reserves its right to amend these disclosures as additional or different information comes to light.

Respectfully submitted,

Date: 9/18/2014

By:  \_\_\_\_\_

Anna L. King  
Ross A. Dannenberg  
Banner & Witcoff, Ltd.  
10 South Wacker Drive  
Suite 3000  
Chicago, IL 60606  
(312) 463-5000  
Attorneys for Applicant

CERTIFICATE OF SERVICE

I hereby certify that a copy of these Pretrial Disclosures was served by first class mail to the following address on September 18, 2014, such being the Opposer's correspondence address listed in the TTABVUE system as of this date:

Lema A Khorshid  
Fuksa Khorshid Llc  
70 W Erie, 2nd Floor  
Chicago, IL 60654

  
\_\_\_\_\_  
Anna L. King

## EXHIBIT B



BANNER & WITCOFF, LTD.  
INTELLECTUAL PROPERTY LAW

TEN SOUTH WACKER DRIVE  
SUITE 3000  
CHICAGO, ILLINOIS 60606-7407

TEL: 312.463.5000  
FAX: 312.463.5001  
www.bannerwitcoff.com

Anna L. King  
Direct Dial: 312-463-5551  
Fax Number: 312-463-5001  
E-mail: [aking@bannerwitcoff.com](mailto:aking@bannerwitcoff.com)

October 15, 2014

**VIA FIRST CLASS MAIL & CONFIRMATION COPY VIA EMAIL to  
[lema@fklawfirm.com](mailto:lema@fklawfirm.com), [robert@fklawfirm.com](mailto:robert@fklawfirm.com) and [perry@fklawfirm.com](mailto:perry@fklawfirm.com)**

Lema A Khorshid  
Fuksa Khorshid LLC  
70 W Erie, 2nd Floor  
Chicago, IL 60654

Re: Atlas Brewing Company, LLC v. Atlas Brew Works LLC  
Opposition No. 91210379

Dear Ms. Khorshid:

Please find enclosed the Notice of Deposition of Pat McEvoy and Notice of Deposition of Justin Cox in connection with the above-referenced matter.

Please contact us if you have any questions.

Sincerely,

Anna L. King

cc: Evan M. Clark (via email)  
Ross A. Dannenberg (via email)  
Helen Hill Minsker (via email)



Ross A. Dannenberg  
BANNER & WITCOFF, LTD.  
Ten South Wacker Drive, Suite 3000  
Chicago, Illinois 60606  
(312) 463-5000

CERTIFICATE OF SERVICE

I hereby certify that on this 15th day of October, 2014, I caused a copy of the foregoing NOTICE OF DEPOSITION to be served by First Class Mail, postage prepaid, on counsel for Applicant, addressed as follows:

Lema A Khorshid  
Fuksa Khorshid LLC  
70 W Erie, 2nd Floor  
Chicago, IL 60654

In addition to service by First Class Mail, on this same date, a courtesy copy of the NOTICE OF DEPOSITION by email, addressed to the following email addresses:

lema@fklawfirm.com  
perry@fklawfirm.com  
tom@fklawfirm.com

  
\_\_\_\_\_