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

Proceeding	91213597
Party	Defendant Tigercat International Inc.
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Submission	Other Motions/Papers
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Signature	/Candace Lynn Bell/
Date	05/04/2016
Attachments	Exhibits 1 and 2 to Motion for Leave to Disclose and Rely on Expert Rebuttal Report.pdf(221469 bytes )

# **EXHIBIT 1**



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April 25, 2016

**VIA E-MAIL**

Naresh Kilaru, Esquire  
Finnegan, Henderson, Farabow, Garrett &  
Dunner, L.L.P.  
901 New York Ave., N.W.  
Washington, DC 20001

**Re: Caterpillar, Inc. v. Tigercat International, Inc.  
Opposition No. 91213597  
Our File No: 303621 – 00011**

Dear Naresh :

We have reviewed the rebuttal report of Mr. Hal Poret served on April 4, 2016, which also included a previously undisclosed expert survey. We anticipate submitting a rebuttal report to Mr. Poret's survey and report. We intend to seek leave to serve the sur-rebuttal report in a motion to the Board. Please let us know if on behalf of Opposer you consent to the motion for leave to file a sur-rebuttal expert report with respect to Mr. Poret's previously undisclosed survey and report. We refer you in this connection to the recent decision of *Newegg Inc. v. Schoolhouse Outfitters, LLC*, Opposition No. 91214178 (March 30, 2016) (precedential).

We represent that the sur-rebuttal report will be restricted to a critique of Mr. Poret's rebuttal report and survey; and that the sur-rebuttal report will not offer any corrections or amplifications to the report or survey of Mr. James Berger.

We further commit to serve the sur-rebuttal report on or before May 4, 2016, *i.e.*, within 30 days of the date of service of Mr. Poret's rebuttal report and survey, in anticipation of the Board's consent and so as not to delay the ongoing discovery in this matter. We will also commit to make the sur-rebuttal expert available for deposition on the sur-rebuttal report at a mutually agreed upon date within two weeks after service of the sur-rebuttal report.

The parties are still in discovery (currently scheduled to end on May 21, 2016) and have been discussing a sixty day extension of discovery to accommodate depositions of party witnesses which are currently contemplated for dates in June 2016, so there is no undue delay and no prejudice in connection with the sur-rebuttal.

Please let us know if on behalf of Opposer you consent to Applicant's motion for leave to submit a sur-rebuttal expert report no later than close-of-business on April 28, 2016.

Very truly yours,



Candace Lynn Bell  
ECKERT SEAMANS CHERIN & MELLOTT, LLC

cc: Christopher P. Foley, Esquire  
Laura K. Johnson, Esquire

# **EXHIBIT 2**

April 28, 2016

Candace Lynn Bell, Esq.  
Eckert Seamans Cherin & Mellott, LLC  
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VIA E-MAIL

Caterpillar, Inc. v. Tigercat International, Inc.  
Opposition No. 91213597

Dear Candace:

This responds to your letter dated April 25, 2016 and our telephone conversation today.

We are aware of the Board's decision in *Newegg Inc. v. Schoolhouse Outfitters, LLC*, Opposition No. 91214178 (March 30, 2016). As you know, the Board in *Newegg* allowed a sur-rebuttal expert report under the specific circumstances of that case:

Under the particular circumstances of this case, i.e., the existence of two conflicting expert surveys, and based upon the Board's interpretation of the Federal Rules of Civil Procedure, it would not only serve the interest of fairness but would benefit the Board in its ability to make a just determination of the merits of this case to allow Opposer to provide a sur-rebuttal by Dr. Kaplan, but only to the limited extent provided below.

In view of the foregoing, Opposer's motion for leave to allow a sur-rebuttal expert report is GRANTED to the extent that Opposer is allowed until April 29, 2016 in which to serve on Applicant a sur-rebuttal expert report authored by Dr. Kaplan which solely rebuts and/or critiques the methodology of the survey conducted by Dr. Ericksen, as well as the analysis of the data resulting from the survey. Dr. Kaplan, however, is precluded from offering any corrections and/or amplifications to his original expert report or introducing any new evidence or consumer surveys. *See ProMark Brands*, 114 USPQ2d at 1241 (Fed. R. Civ. P. 26(e) does not permit expert to bolster previously disclosed opinions or add new opinions). In turn, Applicant is permitted, if it so chooses, to

Candace Lynn Bell, Esq.  
April 28, 2016  
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depose Dr. Kaplan again once it receives Dr. Kaplan's sur-rebuttal expert report. This deposition, however, must be limited to the subject matter of Dr. Kaplan's sur-rebuttal expert report, as restricted by this order. Furthermore, the parties are precluded from seeking any future rebuttal reports from experts.

*Newegg Inc. v. Schoolhouse Outfitters, LLC*, Opposition No. 91214178 (March 30, 2016) (emphasis added).

While we appreciate the representation in your letter that the sur-rebuttal report "will be restricted to a critique of Mr. Poret's rebuttal report and survey; and that the sur-rebuttal report will not offer any corrections or amplifications to the report or survey of Mr. James Berger," your letter does not indicate whether that "critique" will involve introducing any new evidence or consumer surveys. I understand from our telephone conversation today that the sur-rebuttal report will most likely not include any new evidence or consumer surveys, but you were not able to confirm that fact specifically.

In addition, you disclosed during our call today that the sur-rebuttal expert will not be Mr. Berger, but will be a completely new, undisclosed expert witness. This fact is a clear departure from *Newegg*, where the sur-rebuttal witness was the same as the party's initial expert.

For these reasons, Caterpillar does not consent to Tigercat's intended motion for leave to serve a sur-rebuttal report. When filing your motion seeking leave with the Board, we request that you append a copy of this letter to your motion so the Board is aware of Caterpillar's position. Further to our telephone conversation today, we also request that you state both parties consent to moving forward with discovery while Tigercat's motion is pending.

We are hopeful that the parties can work together to complete discovery as planned. To the extent the Board grants Tigercat's motion to serve a sur-rebuttal report, Caterpillar reserves its rights to depose the newly disclosed expert at that time and we assume Tigercat will be cooperative in modifying the case schedule to accommodate that deposition if needed.

If you would like to discuss further, please feel free to call.

Sincerely,



Naresh Kilaru

cc: Christopher P. Foley, Esq.  
Laura K. Johnson, Esq.  
Roberta Jacobs-Meadway, Esq.  
Candace Lynn Bell, Esq.