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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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Attachments	Applicants Reply in Response to Opposition to Motion for Leave to Disclose Re- buttal Expert.pdf(63733 bytes)

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

CATERPILLAR INC., :
 :
 OPPOSER, :
 :
 v. : Opposition No. 91213597
 :
 TIGERCAT INTERNATIONAL INC. :
 :
 APPLICANT. :

**APPLICANT’S REPLY MEMORANDUM IN
RESPONSE TO OPPOSER’S OPPOSITION TO APPLICANT’S MOTION FOR LEAVE
TO DISCLOSE AND RELY ON A REBUTTAL EXPERT REPORT TO OPPOSER’S
SURVEY EXPERT REPORT**

Tigercat International Inc. (“Applicant” or “Tigercat”) respectfully submits this reply memorandum in response to Opposer’s memorandum in opposition to Applicant’s Motion for leave to disclose and rely on a rebuttal expert report to Opposer’s recently disclosed expert report and survey.

Opposer seeks to preclude Applicant from responding to Opposer’s recently disclosed expert report and survey based on the misapplication of trial testimony presumptions with respect to objections made during Applicant’s expert’s discovery deposition, and on the grounds that Applicant’s choice of sur-rebuttal expert is objectionable and would necessitate an additional trial period. Neither argument is valid or even relevant to Applicant’s Motion for Leave.

As the Board held in the recent precedential *Newegg* decision, “. . . the Board finds that, under appropriate circumstances, a sur-rebuttal expert report would be proper as long as a party that wishes to provide a sur-rebuttal expert report promptly seeks leave to do so.” *Newegg Inc. v. Schoolhouse Outfitters, LLC*, Opposition No. 91214178 at 5-6 (TTAB, March 30, 2016) (precedential) citing *City of Gary v. Shafer*, No. 07-56, 2009 WL 1370997, at *6 (N.D. Ind. May

13, 2009) . In this case, Applicant promptly sought leave to disclose and rely on a sur-rebuttal report. It sought Opposer’s consent to Applicant’s motion and filed the instant motion within thirty (30) days of the disclosure of Opposer’s rebuttal expert, Mr. Hal Poret’s report and survey. Opposer did not consent, but Opposer does not dispute the timeliness of Applicant’s Motion. Applicant’s Motion for Leave should be granted.

The Board in *Newegg* identified what constitutes “appropriate circumstances i.e., the existence of two conflicting expert surveys”, which circumstances are the same as the circumstances in this case. *Newegg* p. 6.

The Board in *Newegg* based its decision to allow a sur-rebuttal report on the grounds that “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” *Newegg Inc. v. Schoolhouse Outfitters, LLC*, Opposition No. 91214178 at 6 (TTAB, March 30, 2016) (precedential). The chronology of expert disclosure in the instant case, even more so than in *Newegg* , warrants grant of leave to Applicant to disclose and rely on a sur-rebuttal expert report in the interest of fairness. The relevant chronology has been as follows:

- April 13, 2015 – the deadline for expert disclosure¹. Both parties served expert disclosures on this date. Applicant served the expert report and survey of Mr. Berger regarding the likelihood of confusion using the *Squirt* methodology. Opposer did not disclose any survey expert report.
- December 23, 2015 – the date for expert disclosure as reset by the Board Order of December 22, 2015. Opposer did not disclose any survey expert report.
- March 3, 2016- Opposer took the discovery deposition of Mr. Berger.
- April 4, 2016 - Opposer served its rebuttal expert report of Mr. Hal Poret. The Poret report contained two parts: a critique of Mr. Berger’s survey, and an entirely new likelihood of confusion survey which employed an *Ever-Ready* methodology.
- April 25, 2016 – Applicant sought Opposer’s consent to file its instant motion. To eliminate any possible prejudice to Opposer, and not delay the proceeding,

¹ A motion was before the Board to suspend proceedings before the deadline for expert disclosures, but no order had issued and the parties disclosed expert reports on that date.

Applicant offered to provide Mr. Kramkowski's expert rebuttal report to Opposer within thirty (30) days of the disclosure of Mr. Poret's report and to make Mr. Kramkowski available for deposition prior to the close of discovery.

- April 28, 2016 – Opposer informed Applicant that it would not consent to Applicant's Motion for Leave.
- May 4, 2016 - Applicant filed its Motion for Leave to Disclose and Rely on a rebuttal expert to Opposer's expert report.
- May 4, 2016 - In keeping with the offer made to Opposer when seeking Opposer's consent, Applicant provided Opposer with a copy of the rebuttal expert report of Mr. Kramkowski Applicant intends to disclose and rely on, if granted leave by the Board to do so.

Opposer did not disclose a survey expert report before the original April 13, 2015 deadline for expert disclosures, nor before the December 23, 2015 deadline, the date reset for expert disclosures by the Board in its December 22, 2015 Order, nor before the deposition of Mr. Berger. Opposer has had its chance to critique Mr. Berger's survey. Applicant should be afforded the same opportunity to critique Mr. Poret's survey. Discovery has been extended four times and the parties have consented to a motion for an additional extension of sixty (60) days, which is awaiting Board action.

Opposer's argument that Applicant should be precluded from disclosing a sur-rebuttal report based on Applicant's attorney work product objections to certain questions in the discovery deposition of Mr. Berger is without merit. Opposer's citations to the *Levi Strauss* and *Data Packaging* decisions to support a presumption of adverse inference from objections at a discovery deposition are inapposite. Those decisions concern objections at trial testimony depositions, not a discovery deposition. *Levi Strauss & Co. v. R. Josephs Sportswear, Inc.*, 28 U.S.P.Q.2d 1464 (TTAB 1993); *Data Packaging Corp. v. Morning Star, Inc.*, 212 U.S.P.Q. 109 (TTAB 1993); *Polaris Indus., Inc. v. H-D Michigan, Inc.*, 43 U.S.P.Q.2d 1528 (TTAB 1997). Further, the *Polaris* decision cited for the proposition of the propriety of sanctions is also unavailing, as the *Polaris* decision concerned a motion to compel discovery -- namely, the

deposition of a witness on specified topics pursuant to a prior Board order. Opposer's citation to *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.3d 1372 (Fed. Cir. 1983) for the proposition that a witness inappropriately refused to answer questions is also misplaced. In *Notre Dame*, the Federal Circuit noted that the witness did not refuse to answer a question at a trial deposition in a way that permitted an adverse inference, but found no harmful error concerning the Board's ruling of an inference of intent to trade on the University's goodwill. In a discovery deposition, if the propounding party believes an objection made in the course of the deposition is improper, such party, if it wishes to compel a response, should file a motion to compel with the Board. 37 CFR §2.120(e), *See also*, TBMP §411.04. Opposer has a remedy, which it has chosen not to avail itself of, to address the objections made during Mr. Berger's deposition. Such objections have no bearing on the issue of fairness in allowing Applicant to submit a sur-rebuttal report. Applicant could not anticipate whether Opposer would conduct its own survey as part of its rebuttal or only provide a critique of Mr. Berger's report. Applicant also could not anticipate what survey methodology might be used and what flaws would exist in Mr. Poret's survey and what the deficiencies would be in his report.

In the interest of fairness, Applicant should be granted leave to file a sur-rebuttal report to address the new survey evidence disclosed by Opposer. As in *Newegg*, where the Board found it central to the just determination of the merits to understand all perspectives on the dueling survey formats -- specifically, the *Ever-Ready* and *Squirt* formats -- and to understand the opinions of the experts, all to the benefit of the Board, so too would the Board benefit in this case by allowing the sur-rebuttal report. *Newegg* at 6.

Applicant acknowledges the Board placed limits on the sur-rebuttal report allowed in the *Newegg* decision, specifically, that the sur-rebuttal report "solely rebuts and/or critiques the

methodology of the survey . . . as well as the analysis of the data resulting from the survey” and that the sur-rebuttal report “is precluded from offering any corrections and/or amplifications to the . . . original expert report or introducing any new evidence or consumer surveys.” *Newegg* at 6. Applicant represented and confirms that its sur-rebuttal report, if given leave to disclose and rely on, would be restricted to a rebuttal and critique of Mr. Poret’s survey. Applicant has provided Opposer with a copy of the sur-rebuttal report it seeks to disclose and rely on. Opposer is aware that the report is so restricted and does not address any issues with respect to the Berger survey. There is no prejudice to Opposer in permitting Applicant to rely upon the sur-rebuttal report of Mr. Kramkowski. Indeed, Applicant selected another expert, Mr. Kramkowski, to provide sur-rebuttal testimony to critique the survey and opinion of Mr. Poret to avoid any argument from Opposer that Mr. Berger was now amplifying or correcting his opinions, particularly in light of the restrictions the Board placed on the sur-rebuttal report in the *Newegg* decision. Denying Applicant the opportunity to present Mr. Kramkowski’s report, which was structured to comply with the Board’s limitations in *Newegg*, would unfairly prejudice Applicant and diminish the quality of the analysis of the surveys in this case, and the ultimate issue of likelihood of confusion.

Opposer’s attempt to distinguish the *Newegg* decision, merely because the same expert provided the sur-rebuttal testimony, is misplaced. In *Newegg*, the opposer, specifically sought in its motion to use the same expert in sur-rebuttal and the Board granted the request. In *Newegg*, the Board was concerned with the scope of the sur-rebuttal report, not the identity of the witness providing the report.

Opposer’s argument that an additional trial period would be needed for the trial testimony of the sur-rebuttal expert is baseless. Mr. Kramkowski’s trial testimony would be taken during

Applicant's testimony period should Opposer elect to present Mr. Poret's survey and report during its case in chief, or it could be taken pursuant to the direction of the Board during Opposer's rebuttal testimony period following Mr. Berger's and Mr. Poret's testimony.

The parties have not yet even made pretrial disclosures.² Applicant has timely moved for leave to disclose and rely on its sur-rebuttal report. There are two conflicting expert surveys based on different methodology. Opposer will not be prejudiced by allowing Applicant's sur-rebuttal expert report to Opposer's newly disclosed expert report and survey, and no additional trial testimony period will be needed. For these reasons and in the interest of fairness and for the benefit of the Board, Tigercat respectfully requests that its motion be granted, and that the sur-rebuttal expert report of Mr. Kramkowski be permitted.

Respectfully submitted,

Date: June 3, 2016

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² The parties filed a consented motion to extend discovery on May 13, 2016 because the parties needed additional time to complete discovery and to take depositions in this case. The Board has not yet ruled on that motion for extension.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the attached Applicant's Reply Memorandum in Response to Opposer's Opposition to Applicant's Motion for Leave was served on counsel for the Opposer on the date listed below via email:

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Dated: June 3, 2016

By: s/ John F. Metzger
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