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

Proceeding	91217618
Party	Defendant Trump Your Competition, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 86/116,800
Published in the Official Gazette on April 8, 2014
Mark: TRUMP YOUR COMPETITION

DONALD J. TRUMP,

Opposer,

Opposition No. 91217618

Serial No. 86116800

-against-

Mark: TRUMP YOUR COMPETITION

TRUMP YOUR COMPETITION

Applicant.

**APPLICANT’S PETITION TO DISQUALIFY ATTORNEY & MOTION TO
EXCLUDE OR RESTRICT NON-DISCLOSED EXPERT TESTIMONY**

Pursuant to the provisions of 37 CFR §§ 2.127, 37 CFR 10.63 (a) and Trademark and Appeal Board §§ 115.03 and 513.02, Applicant Trump Your Competition, LLC (“Applicant”), through its counsel, Rod Underhill, hereby petitions to disqualify Alan Garten from serving as counsel for Opposer Donald J. Trump (“Opposer”) and motion to exclude or restrict non-disclosed expert testimony.

I. INTRODUCTION

Applicant seeks to disqualify Mr. Garten from serving as Opposer’s counsel in this proceeding, and to further disqualify his fellow in-house attorney members of The Trump Organization. Mr. Garten is the Executive Vice President and General Counsel of The Trump Organization. Applicant also seeks to exclude or restrict non-disclosed expert testimony.

On or about July 31, 2015, Opposer served a timely Opposer’s Pre-Trial Disclosures upon Applicant’s legal counsel (Attachment “A”.) Attorney Matthew R. Maron signed the Opposer’s Pre-Trial Disclosures, rather than Mr. Garten, as “Attorney for the Opposer” and as a fellow member of the Trump Organization. Mr. Garten entered his first appearance as legal counsel for the Opposer on June 25, 2015, and remains the attorney of record for the Opposer. As is self evident by the dates indicated, the attorney-client team of

the Opposer made a determination to proffer Mr. Garten as Opposer's sole factual witness subsequent to Mr. Garten stepping in as Opposer's new counsel of record.

II. ARGUMENT REGARDING DISQUALIFICATION

A. 37 CFR 10.63(a) should apply.

Regarding whether 37 CFR §§ 10.62(b), 10.63(a) or (b) should apply, Applicant respectfully maintains that 10.63(a) is the applicable rule for the present set of facts.

*37 CFR § 10.63 Withdrawal when the practitioner becomes a witness.
(a) If, after undertaking employment in a proceeding in the Office, a practitioner learns or it is obvious that the practitioner or another practitioner in the practitioner's firm ought to sign an affidavit to be filed in the Office or be called as a witness on behalf of a practitioner's client, the practitioner shall withdraw from the conduct of the proceeding and the practitioner's firm, if any, shall not continue representation in the proceeding, except that the practitioner may continue the representation and the practitioner or another practitioner in the practitioner's firm may testify in the circumstances enumerated in paragraphs (1) through (4) of § 10.62(b).*

In the instant matter, Mr. Garten disclosed, via what appears to be his associate counsel, Mr. Maron, that he would be the sole factual witness to be called by the Plaintiff during the Plaintiff's Trial Period. Regarding the "ought to be called" requirement, "*The test is whether or not the lawyer's testimony could be significantly useful to his client, if so, he ought to be called.*" Supreme Beef Processors v. American Consumer, Industries, Inc. 441 F. Supp. 1064, 1068 (N.D. Tex 1977.)

Consequently, 10.63(b), which applies to situations where it is obvious that a practitioner may be called as a witness by opposing counsel, is not applicable in this matter. Further, the issue of whether or not Mr. Garten "ought to be called" as a witness has been resolved by the Plaintiff himself. Mr. Garten is and remains the sole Plaintiff's witness of any nature as identified by the Plaintiff. As the sole witness of any nature for the Plaintiff, Mr. Garten's testimony must be considered as truly necessary to the Plaintiff. The Plaintiff has proffered no alternate witness to Mr. Garten.

No supplemental pretrial disclosures, pursuant to Federal Rule of Procedure 26(e), have been presented to the Defendant as of yet. Defendant's counsel has requested that Plaintiff's counsel and Defendant's counsel meet and confer regarding the issues contained in this Petition and Motion, and as of yet, such a meeting has not taken place, although the Plaintiff remains hopeful that such a

meeting will take place in the near future. Defendant's counsel remains willing to attempt to resolve the issues presented herein through discussions with the Plaintiff's counsel, but given the proximity of the start of the Plaintiff's trial period, which is set to begin on August 14, 2015, which is a week away from the day this Petition is being filed, and due to the Defendant's expectation of receiving reasonable notice from the Plaintiff regarding the scheduling of the testimonial deposition pursuant to Trademark Rule 2.123(c), Defendant is compelled to file this Petition and Motion in a timely manner to seek a ruling on the issues presented should the parties fail to reach an accord on their own.

B. NO EXCEPTION UNDER 10.62(b) IS APPLICABLE

10.62(b) provides a brief list of exceptions to be considered:

- (1) If the testimony will relate solely to an uncontested matter.*
- (2) If the testimony will relate solely to a matter of formality and there is no reason to believe that substantial evidence will be offered in opposition to the testimony.*
- (3) If the testimony will relate solely to the nature and value of legal services rendered in the case by the practitioner or the practitioner's firm to the client.*
- (4) As to any matter, if refusal would work a substantial hardship on the client because of the distinctive value of the practitioner or the practitioner's firm as counsel in the particular case.*

It is clear from the body of the Opposer's Pre-Trial Disclosures that Mr. Garten will offer testimony that goes to the heart of this contested matter. *"Alan Garten is expected to testify concerning the history and business of the TRUMP MARKS...and Opposer's efforts to police the TRUMP MARKS."* Attachment "A", section B.

Mr. Garten also intends to enter a lengthy list of documents and accordingly, testify as to the foundation of each of those documents.

Accordingly, Mr. Garten's testimony will relate to a contested matter, will not relate to merely a matter of formalities, and is not designed to address solely the nature and value of his legal services to Mr. Trump.

In terms of 10.62 (b) (4) and the issue of "hardship," and the separate issue of the disadvantage to the Defendant that would be created by Mr. Garten's testimony, Applicant offers the following two items from the General Mill Supply case:

Regarding the "hardship" issue:

"We think, however, that the hardship situation covered by subparagraph (4) is one

where the lawyer-client team come unexpectedly upon a disqualification situation, against which they neither actually did nor could have safeguarded themselves.”

Regarding the issue of disability to the Defendant:

“... the opposing counsel may be handicapped in challenging the credibility of the lawyer when the lawyer also appears as an advocate in the case. An advocate who becomes a witness is in the unseemly and ineffective position of arguing his own credibility. The roles of an advocate and of a witness are inconsistent; the function of an advocate is to advance or argue the case of another, while that of a witness is to state facts objectively.”

General Mill Supply Company v. Sca Services Inc, 697 F. 2d 704. (As to both quotes.)

Consequently, Applicant does not predict that Opposer will successfully establish that subparagraph (4) rightfully applies to his present situation and further argues that Mr. Garten’s testimony creates an unfair situation for the Defendant and also places the Plaintiff, and the Board at a disadvantage.

III. ARGUMENT REGARDING MR. GARTEN AS NON-DISCLOSED EXPERT WITNESS

The Plaintiff has not provided an Expert Witness Disclosure. A party may seek to exclude expert testimony based on untimely disclosure. Fed. R. Civ. P. 37(c) (1). The discovery period is currently closed.

Should Mr. Garten be allowed to testify regarding subjects that concern the “ultimate issues” of the Opposition, pursuant to Federal Rule of Evidence 704, Mr. Garten would be testifying as an expert witness.

And, even when an attorney testifies as an expert, there must be limitations.

With respect to the use of an attorney as an expert witness, the challenge is even greater. It is established law that expert testimony that consists of legal conclusions is not admissible at trial. C.P. Interests, Inc. v. California Pools, Inc. 238, F.3d 690, 697 (5th Cir. 2001.)

However, expert witness opinion testimony on “ultimate issues” is admissible under Federal Rule of Evidence 704, which certainly provides a strong argument for use of attorneys as properly and timely disclosed expert witnesses, on specialized areas of legal issues and practices such as those that concern the sometimes highly technical area of trademark law. However, Mr. Garten was not properly and timely disclosed as an expert witness for the Plaintiff; the Defendant cannot predict the full scope of Mr. Garten’s expected testimony with accuracy based on the Plaintiff’s Pre-Trial Disclosures.

The nature of the testimony itself would define whether or not Mr. Garten testifies as a lay or an expert witness.

Expert testimony may reach the ultimate issue of fact in a cause of action to be decided by the trier of fact. Fed. R. Evidence 704(a); Specht v. Jensen, 853 F.2d 805, 808 (10th Cir. 1988.) However, a non-disclosed expert witness would rightfully be prohibited from testifying as an expert in the present Opposition. “*An expert may base an opinion on facts or data in the case that the expert has been made aware of or personally observed.*” **Fed. Rule 703.** Mr. Garten intends to testify on facts that he, as general counsel for the Trump Organization, has been made aware of, in part due to his many years as legal counsel for Mr. Trump, including his opinions regarding Mr. Trump’s “policing of the TRUMP MARKS.” (Attachment “A”).

As the body of Attachment “A” illustrates, no particular limitations as to Mr. Garten’s proposed testimony has been set forth in the pre-trial disclosure. An expert may be retained for the purpose of providing testimony concerning a particular industry, or marketing practices, or consumer behavior in a particular field and certainly attorneys have appeared as experts in prior actions. The required disclosure helps to prevent unfair surprise. **Fed. R. Civ. P. 26.**

Should Mr. Garten offer testimony that exceeds the boundaries of a lay witness and enters the boundaries of an expert witness, Defendant will be placed at an unfair disadvantage.

Pre-Trial Disclosures require “general” information only about a planned witness. Only a “general” summary of the subject matter on which the witness is expected to testify is required. **Trademark Rule 2.12(e).** As such, the Defendant cannot predict with any accuracy the full scope of the testimony that will be offered by the Plaintiff through the testimony of Mr. Garten based on the Pre-Trial Disclosure and its contents.

The Defendant wishes to ensure that Mr. Garten’s testimony does not make findings of fact or conclusions of law or ventures into the territory reserved for an expert witness. If not prohibited, then the Plaintiff asks for the testimony to be sufficiently restricted in nature.

IV. CONCLUSION

For the reasons set forth above, Plaintiff respectfully requests that Mr. Garten and the attorney staff of The Trump Organization be disqualified from serving as advocates in this Opposition and that Mr. Garten be excluded from testifying as a non-disclosed expert witness, or in the alternative, that his testimony be suitably restricted to that of a lay witness.

Date: August 7, 2015

Respectfully submitted,

/Rod Underhill/
Rod Underhill
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PO BOX 1238
Julian, CA 92036
(619) 540-0631

ATTORNEY FOR APPLICANT

ATTACHMENT "A"

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

DONALD J. TRUMP,

Opposer,

-against-

TRUMP YOUR COMPETITION, INC.,

Applicant.

Opposition No. 91217618

OPPOSER'S PRETRIAL DISCLOSURES

Pursuant to Rule 26(a)(3) of the Federal Rules of Civil Procedure and Rule 37 C.F.R. §

2.121, Opposer Donald J. Trump ("Opposer") provides the following pretrial disclosures:

A. Witness List.

Opposer intends to or may take the testimony of the following witness:

Alan Garten
Executive Vice President and General Counsel
The Trump Organization
725 Fifth Avenue
New York, New York 10022

B. Subject Matters and Documents Introduced During Testimony.

Alan Garten is expected to testify concerning the history and business of the TRUMP MARKS (as defined in Opposer's Responses to Applicant's First Set of Interrogatories, dated February 19, 2015) and Opposer's efforts to police the TRUMP MARKS.

The types of documents and things which may be introduced as exhibits during the testimony of Mr. Garten include the following:

- Documents concerning Opposer's history and business.

- Documents concerning the TRUMP MARKS.
- The contents of the United States Patent and Trademark Office file histories, applications and certificates of registration for the TRUMP MARKS.

Dated: New York, New York
July 31, 2015

THE TRUMP ORGANIZATION

By: 

Matthew R. Maron
725 Fifth Avenue
New York, New York 10022
(212) 715-6783
Attorney for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing APPLICANT'S PETITION TO DISQUALIFY ATTORNEY & MOTION TO EXCLUDE OR RESTRICT NON-DISCLOSED EXPERT TESTIMONY has been served on Attorney Alan Garten by

mailing said copy on August 7, 2015, via First Class Mail, Postage prepaid to:

Alan Garten
Executive Vice President & General Counsel
The Trump Organization
725 Fifth Avenue
New York, New York 10022

/RodUnderhill/

Rod Underhill