

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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CME

Mailed: June 29, 2016

Opposition No. 91218118

SUCCESS Partners Holding Co.

v.

*Eleanor Anne Sweet d/b/a The Remington
Group, LLC*

Christen M. English, Interlocutory Attorney:

This case now comes up on Opposer's motions, filed March 4, 2016, to strike Applicant's amended rebuttal expert disclosures, served February 26, 2016 (the "Amended Disclosures"). The motions are fully briefed.¹

By way of background, Opposer disclosed an expert witness on June 8, 2015. 8 TTABVUE. Applicant's deadline to serve rebuttal expert disclosures was July 8, 2015, but she did not serve any rebuttal expert disclosures by this deadline. 26 TTABVUE 5-6. On September 10, 2015, Applicant filed a motion to reopen her rebuttal expert disclosure deadline (18 TTABVUE), and on September 12, Applicant

¹ Applicant's brief in opposition to Opposer's motion to strike Applicant's own rebuttal expert disclosure is single-spaced in contravention of Trademark Rule 2.126(a)(1). Applicant is reminded to comply with the Board's formatting rules.

Opposer argues that its motions "should be treated as conceded" because Applicant "fail[ed] to address the issues raised by the Motion[s] or explain why [the motions] are incorrect, either factually or legally." 43 TTABVUE 2; see also 44 TTABVUE 4-5. Applicant timely responded to Opposer's motion and it is clear from Applicant's responses that she does not concede the merits of Opposer's motions. Accordingly, the Board will not grant Opposer's motions as conceded.

served one rebuttal expert disclosure designating herself as an expert. 19 TTABVUE and 21 TTABVUE 3. The Board issued an order on November 27, 2015 (“Prior Order I”) granting Applicant’s motion to reopen, accepting Applicant’s rebuttal expert disclosure, served September 12, 2015, and allowing Applicant until December 4, 2015 to serve an expert report in connection with her September 12, 2015 rebuttal expert disclosure and to serve “any additional rebuttal expert disclosures.” 26 TTABVUE 7.

Pursuant to Prior Order I, on December 4, 2015 Applicant served five rebuttal expert disclosures, again identifying herself as one of the five experts. 38 TTABVUE 3-4. On December 29, 2015, Opposer filed a motion to strike Applicant’s five rebuttal expert disclosures. On February 22, 2016, the Board issued an order (“Prior Order II”) granting Opposer’s motion, but allowing Applicant until February 26, 2016 to file amended rebuttal expert disclosures. 38 TTABVUE 9 and 12.

Pursuant to Prior Order II, on February 26, 2016, Applicant served the Amended Disclosures consisting of an amended rebuttal expert disclosure for herself and an amended rebuttal expert disclosure for Chris Sculles (the “Sculles Disclosure”). By its motions of March 4, 2016, Opposer moves to strike the Amended Disclosures.

As an initial matter, Opposer argues that Applicant’s response to the motion to strike the Sculles Disclosure should be given no consideration because the response was “not signed by Applicant, nor by an attorney for Applicant, but rather by Chris Sculles, the proposed expert witness himself.” 44 TTABVUE 2. Mr. Sculles did sign the filing, but Applicant signed the ESTTA cover sheet thereto, which is sufficient.

Trademark Rule 2.193 (c)(1); *DaimlerChrysler Corp. v. Maydak*, 86 USPQ2d 1945, 1946 (TTAB 2008); TBMP § 106.02 (2016) (“For documents filed via ESTTA, the electronic signature entered on the ESTTA form is sufficient as the required signature for the entire submission.”). Accordingly, notwithstanding that the brief was signed by a non-party, the Board exercises its discretion to consider the opposition brief because it was also signed by Applicant.

Turning to the merits of Opposer’s motions, the Board has considered all of the parties’ arguments and presumes the parties’ familiarity with the factual bases for its filings, and does not recount the facts or arguments here, except as necessary to explain the decision.

1. Applicant’s Own Rebuttal Expert Disclosure

Opposer argues that Prior Order II “did not provide that Applicant could amend her own rebuttal designation,” but granted Applicant leave to amend only her four other rebuttal expert disclosures. 40 TTABVUE 4 (emphasis omitted). The Board disagrees. Prior Order II granted Opposer’s motion to strike all of Applicant’s rebuttal expert disclosures, including her own rebuttal expert disclosure, and allowed Applicant until February 26, 2016 to file amended rebuttal expert disclosures. 38 TTABVUE 12. If the Board intended to preclude Applicant from amending her own rebuttal expert disclosure, it would have stated this expressly in Prior Order II. Because Prior Order II does not expressly prohibit Applicant from amending her own rebuttal expert disclosure, Applicant did not violate Prior Order II.

Opposer's argument that Applicant should not be able to amend her rebuttal expert disclosure because Opposer "already deposed Applicant over her expert 'opinions' [on September 18, 2015]" is similarly without merit. 40 TTABVUE 9. Applicant's rebuttal expert disclosure served September 12, 2015 was untimely. As of September 18, 2015, it was unclear whether Applicant would be allowed to rely on her untimely rebuttal expert disclosure as Applicant's motion to reopen her time to serve rebuttal expert disclosures was pending. And ultimately, Opposer opposed the motion to reopen. *See* 21 TTABVUE. The Board will not hamstring Applicant because Opposer conducted premature expert discovery.

Next, Opposer argues that certain paragraphs should be stricken from Applicant's amended rebuttal expert disclosure because such paragraphs: (1) exceed "the scope of proper rebuttal," 40 TTABVUE 4-5; (2) "merely assert bias or credibility issues, not rebuttal opinions," *id.* at pp. 5-6; (3) "merely recite facts, not rebuttal opinions," *id.* at 6-7; or (5) attack the credibility of Opposer's expert. *Id.* at p. 8. These arguments seek to prospectively exclude the testimony of Applicant as a rebuttal expert witness, and as such, are in the nature of a motion in limine.² As

² In its motion to strike Applicant's amended rebuttal expert disclosure, Opposer has embedded a "motion" to strike the survey evidence included in Applicant's disclosure on the ground that the "survey fails to meet the standards of *Ava Enters. Inc. v. Audio Boss USA, Inc.*, Opp. No. 91125266 (TTAB Jan. 12, 2006)." 40 TTABVUE 5, n.11; *see also* 43 TTABVUE p. 5, n. 8. Opposer also argues that the survey "was not designated in [Applicant's] initial disclosures nor in her discovery responses." 40 TTABVUE 8. These arguments will be given no consideration because the Board does not consider motions embedded in other filings and because the arguments are in the nature of a motion in limine seeking to prospectively exclude evidence. *Greenhouse Sys. Inc. v. Carson*, 37 USPQ2d 1748, 1750 (TTAB 1995). (denying Applicant's motion in limine seeking to exclude evidence that purportedly should have been produced in discovery); *see also RTX Scientific, Inc. v. Nu-Calgon Wholesaler, Inc.*, 106 USPQ2d 1492, 1493 (TTAB 2013).

Opposer itself recognizes (*see id.*), it is the Board's practice not to make evidentiary rulings prior to trial.³ *See RTX Scientific, Inc. v. Nu-Calgon Wholesaler, Inc.*, 106 USPQ2d 1492, 1493 (TTAB 2013) ("The Board does not make prospective or hypothetical evidentiary rulings."); *Greenhouse Sys. Inc. v. Carson*, 37 USPQ2d 1748, 1750 (TTAB 1995). Accordingly, such arguments are premature.⁴

Lastly, Opposer argues that Paragraphs 14, 16-18 and 21 should be stricken because these opinions are not supported by "facts or basis" as required by Fed. R. Civ. P. 26(a)(2)(C). 40 TTABVUE 7-8. But Applicant's rebuttal expert disclosure in its entirety identifies sufficient factual bases for Applicant's opinions, and therefore, the Board will not strike these few paragraphs.

In view of the foregoing, Opposer's motion to strike Applicant's own rebuttal expert disclosure is **DENIED**.

2. The Rebuttal Expert Disclosure of Chris Sculles

As with Applicant's amended rebuttal expert disclosure, Opposer argues that the Sculles Disclosure should be stricken because it exceeds the scope of rebuttal. Again, this argument is in the nature of a motion in limine, and as such, is

³ Prior Order II granting Opposer's December 29, 2015 motion to strike is not inconsistent with this determination. On February 19, 2016, the Board held a teleconference to address Opposer's December 29, 2015 motion to strike. During that teleconference, the Board observed that Applicant had merely copied Opposer's expert disclosure "converting the subjects of testimony listed by Opposer to subjects of testimony which would be offered in support of Applicant's position," and Applicant admitted "that she did not understand that she was limited in rebuttal to disproving the evidence offered by Opposer's expert." 38 TTABVUE 8-9. In view of Applicant's admission, the Board struck Applicant's rebuttal expert disclosures but allowed Applicant time to serve proper rebuttal expert disclosures. Such circumstances are not present here.

⁴ Substantive objections to any evidence or testimony should be raised at trial (or on a properly filed motion for summary judgment) and will be considered at final hearing. *See* TBMP §§ 707.02(c) and 707.03(c).

premature. *See RTX Scientific*, 106 USPQ2d at 1493; *Greenhouse Sys.*, 37 USPQ2d at 1750.

Opposer also argues that the Sculles Disclosure is deficient and should be stricken because it does not include: (1) “the facts, reasons, or bases for his opinions,” 41 TTABVUE 5-6; (2) “a list of Mr. Sculles publications” or a statement that Mr. Sculles does not have any publications, *id.* at p. 5-6; and (3) “sufficient information regarding Mr. Sculles qualifications.” *Id.* at p. 6. The Sculles Disclosure, however, includes a few paragraphs regarding Mr. Sculles’s expert qualifications, and in response to Opposer’s motion, Applicant filed a copy of Mr. Sculles’s resume.⁵ Moreover, for the opinions expressed in paragraphs 3 and 5 of the Sculles Disclosure, Mr. Sculles has referred to an exhibit upon which his opinion is based.⁶ Accordingly, the only information missing from the Sculles Disclosure is an identification of the facts or data on which the opinion in paragraph 4 is based and a list of Mr. Sculles publications for the last 10 years.

⁵ Opposer argues that Applicant’s response to the motion is an attempt to amend the Sculles Disclosure in violation of Prior Order II, which provided that “Applicant must file a single copy of her disclosures and may not thereafter amend the disclosures.” 44 TTABVUE 4. The purpose of prohibiting amended disclosures was to prevent Applicant from filing multiple copies of her rebuttal expert disclosures as she did on December 4, 2015. Allowing Applicant to supplement the Sculles Disclosure with Mr. Sculles’s resume does not contravene this purpose. But to the extent Applicant may have intended for pages 4-5 of her March 21, 2016 filing to amend or supersede the Sculles Disclosure, the filing will be given no further consideration. The operative Sculles Disclosure remains the disclosure served on February 26, 2016.

⁶ In her response to the motion, Applicant clarified that the referenced exhibit is Exhibit 1 to her filing of February 26, 2016.

“Any information not disclosed pursuant to Fed. R. Civ. P. 26 may not be used as evidence at trial ‘unless the failure was substantially justified or is harmless.’”⁷ (citing Fed. R. Civ. P. 37(c)). *Gen. Council of the Assemblies of God v. Heritage Music Found.*, 97 USPQ2d 1890, 1892 (TTAB 2011). But this case is “analogous to those situations in which one party moves to strike the notice of reliance of its adversary on procedural grounds, and the notice of reliance is defective but such defect is curable.” *Id.* In such circumstances, “[t]he Board has allowed the party which filed the timely, but defective, notice of reliance to cure such defect,” *id.*, and the Board finds it appropriate to allow Applicant an opportunity to cure here.

Accordingly, Applicant is allowed until **TEN DAYS** from the mailing date of this order to supplement the Sculles Disclosure by filing with the Board and serving on Opposer a list of Mr. Sculles’s publications in the last ten years and a statement identifying the facts or data upon which the opinion in paragraph 4 of the Sculles Disclosure is based. If Applicant fails to supplement the Sculles Disclosure with this information within the time provided herein, the Board will *sua sponte* strike the Sculles Disclosure.

Except as provided in this order, Applicant may not further supplement or amend her Amended Disclosures of February 26, 2016. And the Board will not consider any further motions regarding the sufficiency of the Amended Disclosures.

⁷ The Board may consider the following factors in determining whether the failure was substantially justified or is harmless: (1) the surprise to the party against whom the witness was to have testified; (2) the ability of the party to cure that surprise; (3) the extent to which allowing the testimony would disrupt the trial; (4) the explanation for the party’s failure to name the witness before trial; and (5) the importance of the testimony. *Gen. Council of the Assemblies of God*, 97 USPQ2d at 1892.

Proceedings Suspended

Proceedings remain suspended and the parties are allowed until **August 22, 2016** to complete discovery limited to the expert reports accompanying the disclosures.⁸ Opposer is then allowed until **September 1, 2016** to notify the Board in writing as to whether it wishes to proceed with briefing its motion for summary judgment, filed November 20, 2015 (24 TTABVUE), or whether it withdraws the motion for summary judgment. Upon receipt of Opposer's filing, the Board will issue an appropriate order.

⁸ If a party requires an extension of the suspension period to complete expert discovery, such party may file a motion to extend the suspension period.