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

Proceeding	92051006
Party	Defendant 12 Interactive, LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

COUCH/BRAUNSDORF AFFINITY, INC.,	)	
	)	
Petitioner/Counter-Registrant,	)	
	)	
v.	)	Cancellation No. 92051006
	)	
12 INTERACTIVE, LLC,	)	
	)	
Registrant/Counter-Petitioner	)	
	)	

REGISTRANT'S REPLY IN SUPPORT OF ITS
MOTION TO QUASH NOTICES OF DEPOSITION

Petitioner/Counter-Registrant, Couch/Braunsdorf Affinity, Inc. ("Petitioner") does not, and cannot, offer sufficient justification for its failure to timely disclose Branden Smythe, Sean Keeler, Daniel Kristal, Michelle Whitehead, and Cindy Blackburn as witnesses or potential witnesses in this matter. Pursuant to Federal Rule of Civil Procedure 26(a), Petitioner was required to disclose these witnesses as individuals likely to have discoverable information. Under Trademark Rule 2.121(e), Petitioner was required to provide the names of all witnesses from whom it would or might take testimony "no later than fifteen days prior to the opening of [its] testimony period." 37 C.F.R. § 2.121(e). Petitioner failed in both regards, and the testimony of these witnesses should therefore be excluded.

Indeed, Petitioner waited until there were a mere 10 days remaining in its testimony period to inform 12 Interactive, LLC ("Registrant") of the existence of two of these new witnesses, and to serve notice that it intended to take four depositions in this matter in the final three business days of its testimony period. Petitioner did not amend its Initial Disclosures to include these allegedly late-discovered witnesses until after Registrant filed its Motion to Quash

and these proceedings were suspended. Petitioner should not be permitted to "cure" these substantial defects in its attempt to procure testimony, and the Motion to Quash should therefore be granted.

A. Deposition of Mr. Smythe

Any delay Petitioner experienced in learning about Mr. Smythe and any relevant information he might possess is directly attributable to Petitioner's own litigation decisions. Whether due to lack of diligence or an intent to gain a tactical advantage, Petitioner waited until the final day of the discovery period, July 9, 2010, to serve its discovery requests on Registrant. In turn, Registrant timely filed its written responses, noting that, as no protective order had been entered in this case, it was withholding its document production. Petitioner again waited a full month to respond to Registrant's concerns regarding confidentiality. Within four days of that communication, the parties agreed upon and executed a protective order, and three days after that, Registrant produced its documents.

Even after Petitioner received Registrant's documents, however, it still had a full 10 days before its testimony period opened. However, Petitioner waited until the end of its testimony period to serve a Notice of Deposition for Mr. Smythe. Then, even when it did serve the Notice of Deposition, Petitioner failed to issue a valid subpoena for Mr. Smythe's testimony. Petitioner has since attempted to "cure" this defect by serving Mr. Smythe with a subpoena during the suspension of these proceedings. However, Petitioner should not be permitted to take advantage of Registrant's bringing this matter before the Board by fixing this serious deficiency after the fact.

Petitioner alleges Mr. Smythe should have been disclosed in Registrant's Initial Disclosures under Federal Rule of Civil Procedure 26, and even goes so far as to accuse Registrant of an "attempt to hide Mr. Smythe." (Response, p. 2.) Petitioner misunderstands

Rule 26. In fact, Registrant is required only to disclose individuals "likely to have discoverable information…*that the disclosing party may use to support its claims or defenses*." Fed. R. Civ. P. 26(a)(1)(A) (emphasis added). Because Mr. Smythe does not have discoverable information Registrant may use, Registrant was under no obligation to disclose him under the rules.

Thus, Petitioner has not and cannot proffer any justification for the failure to disclosure Mr. Smythe as a witness or potential witness on its Intial Disclosures or Pretrial Disclosures. Accordingly, under Rule 37, Petitioner should not be permitted to rely upon Mr. Smythe's testimony.

B. Depositions of Messrs. Keeler and Kristal and Potential Depositions of Mses. Whitehead and Blackburn

Petitioner asserts that it could not have named Messrs. Keeler and Kristal or Mses. Whitehead and Blackburn in its initial or pretrial disclosures because the alleged incidents of actual confusion to which they are purportedly witnesses had not yet occurred. This is irrelevant. Trials proceed on a schedule, and the primary goal of requiring initial disclosures under Rule 26 is to prevent a trial by surprise. *Salgado v. Gen. Motors Corp.*, 150 F.3d 735, 742 n.6 (7th Cir. 1998). Supplemental disclosures should not be allowed to permit an end-run around this goal. In any event, supplemental initial disclosures must be made in a "timely manner," and Petitioner here waited until after Registrant filed its Motion to Quash to even supplement.

The cases cited by Registrant to the contrary are inapposite. The cases cited in its Response hold that whether notice of a deposition is sufficient is determined on a case-by-case basis, and that only a few days may be sufficient in some cases. *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1651 (TTAB 2007); *Hamilton Burr Publ'g Co. v. E.W. Commc'ns, Inc.*, 216 USPQ 802, 804 (TTAB 1982). However, the 2007 rule change requiring initial and pretrial disclosures under Rule 26 was not yet in effect in either of those cases, and thus they are not

precedential on whether a party may, after failing to disclose a witness in either its initial or pretrial disclosures, on merely nine days notice, depose several new witnesses.

Rather, the few cases considering this issue since the 2007 rule change suggest that Registrant should be prevented from taking presenting the testimony of these late-disclosed witnesses. In one such case, the petitioner failed to serve pretrial disclosures, but on the first day of its testimony period served the respondent with notice of a testimony deposition to take place two weeks later. *Jules Jurgensen/Rhapsody Inc. v. Baumberger*, 91 USPQ2d 1443, 1443 (TTAB 2009). The Board held that the two weeks' notice was insufficient to cure the petitioner's failure to disclose the witness in pretrial disclosures, even though the respondent was aware of the witness through discovery. *Id.* at 1445. Indeed, even though the objecting party was aware of the witness, he was precisely "the type of surprise witness that pretrial disclosure is intended to discourage." *Id.* Here, even more prejudicially, Registrant has had no opportunity to conduct discovery regarding this proposed testimony witnesses, and had even less than two weeks to prepare for Petitioner's proposed deposition dates. Thus, as in *Jurgensen*, these late-disclosed witnesses are precisely the type of surprise witnesses that should be discouraged. *See also Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d 1175, 1178 (TTAB 2010) (excluding portions of witness's testimony on grounds witness was not disclosed in initial disclosures).

Furthermore, the fact that the only instances of confusion Petitioner has asserted in this matter all occurred after its testimony period had opened is a bit suspect. Indeed, Petitioner alleges that another incident of confusion occurred just one day before Registrant filed the instant motion, and has attempted to supplement its Pretrial Disclosures a second time during the pendency of the Board's suspension of this matter to add Mses. Whitehead and Blackburn. Petitioner has been using its PERKSPOT mark for well over four years, and secured its federal

registration nearly three years ago, and it therefore seems incredible that the *only* evidence of actual confusion Petitioner has purportedly discovered occurred just during the last 30 days. Petitioner's lack of diligence in preparing for trial during the discovery period, or in any event, prior to the opening of its testimony period should not be permitted to unfairly prejudice Registrant. Thus, Petitioner should not be permitted to supplement its Initial or Pretrial Disclosures at this late date, and should therefore not be permitted to rely on the testimony of Messrs. Keeler and Kristal or Mses. Whitehead and Blackburn.

C. Conclusion

Petitioner failed to give Registrant the notice required by naming its witnesses in its Initial Disclosures as required under Federal Rule of Civil Procedure 26(a). Petitioner failed again to give Registrant the notice required by disclosing its witnesses in its Pretrial Disclosures as required under Trademark Rule 37 C.F.R. § 2.121(e). Petitioner failed again to subpoena Mr. Smythe as required under TBMP § 703.01(f)(2). Petitioner should not now, after repeatedly failing to proceed fairly and in accordance with the rules, be permitted to prejudice Registrant by introducing the testimony of these late-disclosed witnesses. Registrant's Motion to Quash should therefore be granted.

Respectfully submitted,

Dated: November 22, 2010

/Michael G. Kelber/
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CERTIFICATE OF SERVICE

I, Katherine Dennis Nye, an attorney, state that I served a copy of ***REGISTRANT'S REPLY IN SUPPORT OF ITS MOTION TO QUASH NOTICES OF DEPOSITION*** upon counsel for Petitioner-Counter Registrant:

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via First Class U.S. Mail and email on this 22nd day of November, 2010.

__/Katherine Dennis Nye/_____
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