

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Baxley

Mailed: March 31, 2011

Cancellation No. 92051006

Couch/Braunsdorf Affinity,
Inc.

v.

12 Interactive, LLC

Andrew P. Baxley, Interlocutory Attorney:

This case now comes up for consideration of respondent's motion (filed October 27, 2010) to quash petitioner's notices of testimony depositions of Branden Smythe, Sean Keeler, and Daniel Kristal on the ground that the aforementioned trial witnesses were not named in petitioner's initial disclosures herein.

In an October 27, 2010 order, the Board granted the motion to quash the notice of deposition of Mr. Smythe, respondent's vice president of national sales, who the Board presumed was unwilling to appear voluntarily for such deposition, based on petitioner's failure to have Mr. Smythe's appearance secured therefor by subpoena. In that order, the Board also suspended proceedings and set time for remaining briefing on the motion to quash.

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The record herein indicates that, on October 28, 2010, Mr. Smythe was served with a subpoena to appear for a deposition in this case. Accordingly, the Board's grant in the October 27, 2010 order of respondent's motion to quash with regard to Mr. Smythe based on petitioner's failure to have Mr. Smythe's appearance secured therefor by subpoena is hereby vacated.

In support of the motion to quash, respondent contends that petitioner did not disclose Messrs. Smythe, Keeler, and Kristal until petitioner served supplemental pretrial disclosures on October 20, 2010, ten days prior to the close of its testimony period, as last reset in the Board's July 19, 2010 order. Respondent contends that petitioner improperly failed to disclose these witnesses as individuals likely to have discoverable information that petitioner may use to support its claims in its initial disclosures under Fed. R. Civ. P. 26(a) and Trademark Rule 2.120(a)(1) and then failed to supplement those initial disclosures. Respondent further contends that petitioner should have known that Messrs. Keeler and Kristal were likely to have discoverable information because they are employees of petitioner's parent company. Respondent contends in addition that, even if petitioner only became aware of Mr. Smythe through respondent's production of discovery documents, respondent completed its discovery document

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production prior to petitioner's service of pretrial disclosures and that petitioner had ample time to review those documents, supplement its initial disclosures and serve complete pretrial disclosures by the September 15, 2010 due date therefor. Respondent further contends that, with the discovery period now closed, it cannot take discovery regarding the witnesses and that it cannot prepare for their trial testimony. Accordingly, respondent asks that the notices of the testimony depositions of Messrs. Smythe, Keeler, and Kristal be quashed.

In response, petitioner contends that its failure to disclose the witnesses prior to October 20, 2010 was substantially justified because the substance of their intended testimony had not come to light or had not occurred. In particular, petitioner contends that it was not aware of Mr. Smythe's evidence of confusion when it served its pretrial disclosures because respondent did not name him in its initial disclosures that it served on February 9, 2010 and in interrogatory, document request, and request for admission responses that it served on August 13, 2010, and because petitioner did not receive respondent's discovery documents until September 20, 2010, five days after petitioner timely served its pretrial disclosures, and three days after respondent sent petitioner an electronic disc with its discovery documents. Petitioner further notes

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that Mr. Smythe was served with a subpoena on October 28, 2010. With regard to Mr. Keeler, a call center representative of petitioner's parent company, petitioner contends that Mr. Keeler did not receive the telephone call that petitioner believes is evidence of actual confusion until after until October 6, 2010 and thus petitioner could not have named in pretrial disclosures. With regard to Mr. Kristal, the vice president of petitioner's parent company, petitioner contends that, while Mr. Kristal participated in an e-mail exchange in October 2009 in which a third party confused respondent with petitioner, petitioner did not become aware of that exchange until October 12, 2010, twelve days into trial. Petitioner further contends that two additional witnesses, Michelle Whitehead and Cindy Blackburn, both of whom are employees of one of petitioner's clients, can provide evidence of another incident of actual confusion that occurred on October 26, 2010, and that it supplemented its initial disclosures to name Messrs. Keeler and Kristal, Ms. Whitehead, and Ms. Blackburn as persons likely to have discoverable information that petitioner may use to support its claim under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), and further supplemented its pretrial disclosures to name Ms. Whitehead and Ms. Blackburn as potential trial witnesses on November 5, 2010.¹

¹ The record does not indicate that any testimony depositions of

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In reply, respondent contends that any delay in learning about Mr. Smythe was the result of petitioner's decision to wait until the last day of the discovery period to serve any discovery requests on respondent; that it did not name Mr. Smythe in its initial disclosures because he does not have discoverable information that respondent may use to support its defense herein; and that it is irrelevant that petitioner did not learn of the incidents that give rise to the testimony of the witnesses, Ms. Whitehead, and Ms. Blackburn until after petitioner served its pretrial disclosures because a trial must proceed on a schedule.

In initial disclosures, parties must identify "each individual likely to have discoverable information that the disclosing party may use to support its claims or defenses." Fed. R. Civ. P. 26(a)(1). Although it would be curious for a trial witness not to have discoverable information, parties need not identify all prospective trial witnesses in their initial disclosures. See *Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d 1175 (TTAB 2010). The Board further notes that petitioner was not aware of information that Messrs. Smythe, Keeler, and Kristal

Ms. Whitehead and Ms. Blackburn have been noticed. Accordingly, any determination as to whether any notices of deposition of these potential witnesses should be quashed would be premature. The Board notes that Ms. Whitehead and Ms. Blackburn are not employees of petitioner and that, if they are unwilling to appear voluntarily for testimony depositions, their attendance would

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possessed concerning alleged incidents of actual confusion when petitioner served its initial disclosures (or prior to the commencement of trial), and that petitioner promptly supplemented its initial disclosures once it became aware of these persons. Accordingly, under the circumstances herein, the Board finds that petitioner's failure to name Messrs. Smythe, Keeler, and Kristal in its initial disclosures do not warrant quashing their notices of testimony depositions.

Rather, pretrial disclosures, as provided for in Fed. R. Civ. P. 26(a)(3) and Trademark Rule 2.121(e), require each party to inform its adversary, prior to the opening of its testimony period, of the names of, and certain minimal identifying information about, the individuals who are expected to, or may, if the need arises, testify as trial witnesses, thus avoiding surprise witnesses. See Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42242, 42257-58 (Aug. 1, 2007). Fed. R. Civ. P. 37(c)(1), made applicable to this proceeding by Trademark Rule 2.116(a), provides that "[i]f a party fails to provide information or identify a witness as required by Rule 26(a) ... the party is not allowed to use that information or witness to supply evidence on a motion, at a hearing, or at a trial, unless the failure was substantially justified or is harmless."

need to be secured by subpoena. See TBMP Section 703.01(f)(2) (2d ed. rev. 2004).

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In determining whether to exclude witness testimony, the Board is guided by the following five-factor test to determine whether non-disclosure of evidence is substantially justified or harmless: "1) the surprise to the party against whom the evidence would be offered; 2) the ability of that party to cure the surprise; 3) the extent to which allowing the testimony would disrupt the trial; 4) importance of the evidence; and 5) the nondisclosing party's explanation for its failure to disclose the evidence." *Southern States Rack & Fixture, Inc. v. Sherwin-Williams Co.*, 318 F.3d 592, 597 (4th Cir. 2003). See also *MicroStrategy, Inc. v. Business Objects, S.A.*, 429 F.3d 1344, 1357, 77 USPQ2d 1001 (Fed. Cir. 2005). The Board will address each of these factors.

Regarding surprise to respondent, petitioner did not name Messrs. Smythe, Keeler, and Kristal in pretrial disclosures and, therefore, respondent was not apprised of their identity as potential trial witnesses. This surprise and lack of advance notice of such witness hindered respondent's ability to prepare its defense herein. See 72 Fed. Reg. at 42255. Accordingly, this factor favors respondent.

Regarding the ability of respondent to cure the surprise, the Board notes that respondent could not cure the surprise without filing the motion to quash, otherwise seeking to exclude the testimony of Messrs. Smythe, Keeler,

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and Kristal, or engaging in previously unplanned preparation to cross-examine those witnesses. This factor favors respondent.

Regarding the extent to which allowing the testimony would disrupt this trial, we find that petitioner's late disclosure of Messrs. Smythe, Keeler, and Kristal has indeed been disruptive to the orderly administration of this trial. Such late disclosure prompted the filing of the motion to quash and led the Board to suspend this case pending a decision thereon. This factor also favors respondent.

However, regarding the importance of the evidence at issue, petitioner's need for the testimony of Messrs. Smythe, Keeler, and Kristal may be important.² In particular, petitioner, as plaintiff, has the burden of proof in this cancellation proceeding, and actual confusion between the marks at issue is a factor in determining likelihood of confusion under Section 2(d). See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); TMEP Section 1207 (7th ed. 2010). This factor therefore favors petitioner.

Regarding petitioner's explanation for its failure to disclose, the Board notes that its standard protective order has been operative throughout this proceeding. See

² The Board does not review testimony prior to final decision. See TBMP Section 502.01.

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Trademark Rule 2.116(g). Accordingly, any refusal to produce documents until after the parties had executed a protective agreement was unwarranted. Had respondent not delayed in serving its discovery documents until after petitioner served its pretrial disclosures, petitioner may have become aware of Mr. Smythe prior to serving its pretrial disclosures and could have named him as a potential witness therein.³ In addition, petitioner did not unduly delay in supplementing its pretrial disclosures to name Mr. Smythe as a trial witness. Therefore, this factor favors petitioner with regard to Mr. Smythe.

Likewise, regarding petitioner's failure to disclose Mr. Keeler, as a trial witness in its pretrial disclosures, the alleged incident of actual confusion of which petitioner intends Mr. Keeler to provide testimony did not occur until after the commencement of trial herein and petitioner acted promptly to amend its pretrial disclosures upon being made aware of such alleged incident. Accordingly, this factor favors petitioner with regard to Mr. Keeler.

However, regarding petitioner's failure to disclose Mr. Kristal as a potential trial witness in its pretrial

³ Respondent's motion to quash could have been rendered unnecessary if petitioner, upon receipt of respondent's discovery documents, had filed a motion to extend testimony periods to allow it to review respondent's discovery documents and supplement its initial and/or pretrial disclosures as necessary prior to the commencement of trial. The Board could have ruled

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disclosures, we note that the alleged incident of actual confusion to which petitioner intends to have him testify took place in October 2009. Although petitioner contends that it did not become aware of such incident until the twelfth day of trial herein, petitioner had a duty to thoroughly search its records in preparing for trial and easily could have discovered well in advance of trial the alleged incident to which Mr. Kristal, the vice-president of petitioner's parent company, intends to provide trial testimony. Cf. TBMP Section 408.02. Accordingly, this factor favors respondent with regard to Mr. Kristal.

On balance, the Board finds that petitioner's failure to name Messrs. Smythe and Keeler in its pretrial disclosures was substantially justified, but that the failure to name Mr. Kristal in pretrial disclosures was neither harmless nor substantially justified.

In view thereof, respondent's motion to quash is granted with regard to Mr. Kristal, but denied with regard to Messrs. Smythe and Keeler. Proceedings herein are resumed under the following schedule, with petitioner being allowed the four days that remained in its testimony period when respondent filed the motion to quash and respondent being allowed roughly one month prior to the recommencement of petitioner's testimony period.

on such a motion by telephone conference shortly after the filing

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Petitioner's four-day testimony period as plaintiff in the cancellation to close: ⁴	May 6, 2011
Respondent's pretrial disclosures due:	May 21, 2011
Respondent's 30-day testimony period as defendant in the cancellation and as plaintiff in the counterclaim to close:	July 5, 2011
Petitioner's pretrial disclosures for rebuttal in the cancellation and as defendant in the counterclaim due:	July 20, 2011
Petitioner's 30-day testimony period as defendant in the counterclaim and for rebuttal as plaintiff in the cancellation to close:	September 3, 2011
Respondent's rebuttal disclosures as plaintiff in the counterclaim due:	September 18, 2011
Respondent's 15-day rebuttal testimony period as plaintiff in the counterclaim to close:	October 18, 2011
Brief for petitioner as plaintiff in the cancellation due:	December 17, 2011
Brief for respondent as defendant in the cancellation and as plaintiff in the counterclaim due:	January 16, 2012
Brief for petitioner as defendant in the counterclaim and reply brief, if any, as plaintiff in the cancellation due:	February 15, 2012
Reply brief, if any, for respondent as plaintiff in the counterclaim due:	March 1, 2012

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of

thereof. See Trademark Rule 2.120(i)(1); TBMP Section 502.06(a).

⁴ Petitioner's remaining testimony period will commence on May 3, 2011.

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the taking of testimony. Trademark Rule 2.125. An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.