

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

Mailed: August 22, 2011

Cancellation No. 92051140

Leonid Nahshin

v.

Product Source International,  
LLC

**Ann Linnehan, Interlocutory Attorney**

This case now comes up for consideration of respondent's motion (filed March 16, 2011) to strike the testimony of Yael Menkin. The motion is fully briefed.

According to the record, pretrial disclosures were due on December 30, 2010. On February 2, 2011, the Board issued an order wherein proceedings were suspended for the orderly completion of two depositions upon written questions to be taken by petitioner. Despite the suspension of proceedings, four months after he submitted his initial disclosures and more than five weeks after his pretrial disclosures were due, petitioner informed respondent for the first time on February 8, 2011, that he intended to rely on testimony from Yael Menkin. Petitioner did not identify Ms. Menkin in his initial disclosures. On February 9, 2011, petitioner served his overdue pretrial disclosures wherein he identified Ms.

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Menkin as a witness. On February 10, 2011 petitioner served respondent with notice that petitioner intended to depose Ms. Menkin on February 16, 2011. Such notice specifically stated that petitioner "will take the oral deposition of Yael Menkin." At the scheduled deposition, Ms. Menkin did not testify by oral examination at all, but rather she produced an affidavit which she proceeded to sign and swear to as her testimony. Petitioner filed a copy of this affidavit on February 22, 2011, despite the suspension of proceedings.<sup>1</sup>

In support of its motion, respondent argues that petitioner's failure to identify Ms. Menkin as a witness until after the close of discovery has seriously prejudiced respondent's defense of this action; that petitioner wrongfully submitted an affidavit; that respondent was left with no opportunity to cross examine the witness; that petitioner's "continued disregard for the rules of this forum should not be countenanced"; that Ms. Menkin's testimony should be stricken in its entirety pursuant to Rule 26(a) and 37(c)(1) of the Federal Rules of Civil Procedure and Trademark Rules 2.121 and 2.123. Respondent argues that Ms. Menkin's testimony should be stricken because petitioner failed to identify Ms. Menkin in petitioner's initial disclosures and because Ms. Menkin

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<sup>1</sup> See Board's order of May 2, 2011.

impermissibly testified by written affidavit and not by oral examination.

Trademark Rule 2.123 provides, in relevant part, as follows: "By written agreement of the parties, the testimony of any witness or witnesses of any party, may be submitted in the form of an affidavit by such witness or witnesses."

In this instance, there is no evidence of a written agreement that the testimony of Ms. Menkin would be submitted in the form of an affidavit and counsel for respondent states there was no agreement between the parties to this effect. Inasmuch as the parties did not enter into a written agreement to allow testimony by such means, Ms. Menkin's affidavit constitutes improper testimony. See *Tri-Star Marketing, LLC v. Nino Franco Spumanti S.R.L.*, 84 USPQ2d 1912 (TTAB 2007).

Trademark Rule 2.121(e) provides, in pertinent part,

no later than fifteen days prior to the opening of each testimony period ... the party scheduled to present evidence must disclose the name and, if not previously provided, the telephone number and address of each witness from whom it intends to take testimony, or may take testimony if the need arises, general identifying information about the witness, such as relationship to any party, including job title if employed by a party, or, if neither a party nor related to a party, occupation and job title, a general summary or list of subjects on which the witness is expected to testify, and a general

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summary or list of the types of documents and things which may be introduced as exhibits during the testimony of the witness ...

Trademark Rule 2.123(e)(3) provides, in part, as follows:

Every adverse party shall have full opportunity to cross-examine each witness. If pretrial disclosures or the notice of examination of witnesses served pursuant to paragraph (c) of this section are improper or inadequate with respect to any witness, an adverse party may cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party...shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances...."

The requirement for parties to make pretrial disclosures, which are provided for in Fed. R. Civ. P. 26(a)(3), was introduced into Board inter partes proceedings by amendments to the Trademark Rules, and is applicable to all proceedings which commenced on or after November 1, 2007.<sup>2</sup> See *Notice of Final Rulemaking, Miscellaneous Changes to Trademark Trial and Appeal Board Rules*, 72 Fed. Reg. 42242 (Aug. 1, 2007). Such disclosures allow parties to know prior to trial the identity of trial witnesses, thus avoiding surprise witnesses. See *id.* at 42257-58. These disclosures require that a party, *in advance* of the

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<sup>2</sup> The instant proceeding was filed on December 26, 2007.

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presentation of its testimony, inform its adversary of the names of, and certain minimal identifying information about, the individuals who are expected to, or may, if the need arises, testify at trial. See *id.* at 42257.

Petitioner's pretrial disclosures were due on or before December 30, 2010. During the suspension of proceedings and well after the start of its testimony period, petitioner served such disclosures on February 9, 2011, only one day after petitioner's counsel informed respondent's counsel of petitioner's plan to rely on Ms. Menkin's testimony. While petitioner did identify Ms. Menkin in these disclosures, the record is clear that Ms. Menkin was not identified in petitioner's initial disclosures (which, according to the record were also not timely served). Petitioner has provided no explanation as to why it did not identify Ms. Menkin as a knowledgeable individual in his initial disclosures, despite the fact that petitioner states that Ms. Menkin was "the recipient of Petitioner's first shipment to the United States, which information is one of the most important facts to this case and therefore it was reasonable to anticipate...that the Petitioner would rely on Mrs. Menkin as a witness." Petitioner's failure to identify Ms. Menkin in his initial disclosures deprived respondent of the opportunity to seek discovery of Ms. Menkin. More importantly, petitioner has failed to provide a sufficient

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explanation as to why he improperly served his pretrial disclosures five weeks after they were due and after the start of his testimony period (and, of course, one day before he served the notice of his plans to take the "oral deposition" of Ms. Menkin).

After carefully considering all the relevant circumstances herein, the Board finds that petitioner has failed to comply with Trademark Rule 2.121(e) by not timely serving his pretrial disclosures. Petitioner's assertion that respondent was somehow aware of Ms. Menkin because of certain of his responses to respondent's discovery requests is not well taken. Nor is petitioner's assertion that he indicated his intent to take the testimony of Ms. Menkin in his notice of reliance of January 11, 2011. Ms. Menkin is the type of surprise witness that pretrial disclosure practice is intended to discourage.

In view of petitioner's failure to comply with Trademark Rule 2.123 and because of petitioner's failure to properly serve his pretrial disclosures in accordance with Trademark Rule 2.121(e), the Board finds it appropriate to grant respondent's motion to strike.

The testimony of Ms. Menkin in its entirety is hereby stricken.<sup>3</sup>

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<sup>3</sup> Petitioner is reminded that he cannot use his rebuttal period to submit testimony that is properly part of its case in chief.

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Proceedings herein are resumed. A review of the record indicates that petitioner's has had ample time to file testimony in this proceeding. Petitioner's testimony period is closed. Strict compliance with the Board's schedule and deadlines is expected of both parties going forward. Petitioner is encouraged to review the Board's rules and orders with respect to all deadlines. Dates are reset as follows:

Defendant's Pretrial Disclosures	9/23/2011
Defendant's 30-day Trial Period Ends	11/7/2011
Plaintiff's Rebuttal Disclosures	11/22/2011
Plaintiff's 15-day Rebuttal Period Ends	12/22/2011

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 of completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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See Trademark Rule 2.121(b)(1) and *Wet Seal Inc. v. FD Mgmt. Inc.*, 82 USPQ2d 1629 (TTAB 2007).

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