

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

Mailed: August 12, 2013

Cancellation No. 92053501

Christian M. Ziebarth

v.

Del Taco, LLC

**Ann Linnehan, Interlocutory Attorney**

This case now comes up for consideration of respondent's motion filed March 8, 2013<sup>1</sup> which is captioned as a "motion for sanctions." The motion is fully briefed.

In support of its motion, respondent argues that due to petitioner's willful violation of the Board's order of December 12, 2012 that this proceeding be dismissed in its entirety. In the alternative, respondent seeks an order that petitioner be prohibited from offering the testimony of previously undisclosed witnesses Michael Annis and William Odell and from presenting any evidence, documents, or testimony on the categories identified by petitioner for the very first time in his pretrial disclosures.<sup>2</sup> Respondent further renews its August 22, 2012 motion for sanctions in

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<sup>1</sup> A redacted copy was filed on March 22, 2013.

<sup>2</sup> This includes the testimony of Mr. Rob Hallstrom which respondent argues should be limited to "only the basic

the form of dismissal. Respondent states that on January 24, 2013 petitioner served over 30 pages of disclosures in his pretrial disclosures and that "such disclosures identified numerous witnesses as well as document and information categories far beyond the scope of any discovery responses ever provided by petitioner in this case, notwithstanding the clear order of the Board in the Sanction Order that petitioner could not rely upon witnesses, documents and categories of information upon which petitioner had refused to produce discovery."

As a preliminary matter, the Board notes that in its order of December 12, 2012 it specifically advised respondent to notify the Board in its brief on the case if petitioner's evidence and arguments at trial exceeded the information provided during discovery, but it appears, from much of the arguments submitted with its present motion, that respondent has ignored the Board's direction claiming the it had "no choice" because of the resulting expense it would incur at trial. Future compliance with the Board's orders is expected.

**Documents and Categories of Information**

The Board first considers the documents and categories of information which respondent alleges that petitioner identified for the first time in its pretrial disclosures

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information and topics" contained in two emails produced by

and for which respondent says the sanction of dismissal is warranted or, at a minimum, for which petitioner should be precluded from submitting at trial. The Board construes such motion as a motion in limine.

The Board does not make prospective or hypothetical evidentiary rulings. *See, e.g., Greenhouse Systems Inc. v. Carson*, 37 USPQ2d 1748, 1750 (TTAB 1995) (the Board does not consider motions in limine). Thus, to the extent that respondent moves to sanction petitioner prospectively or exclude these documents and categories the motion is denied as premature. *See* Trademark Rules 2.123(c) and (e)(3); TBMP Section 527.01(f).

In addition, respondent's "renewal" of the August 22, 2012 motion for sanctions in the form of dismissal is construed as motion in limine and, therefore, is denied as premature. The request for judgment will not be considered.

**Witnesses**

Respondent alleges that for the first time ever in its pretrial disclosures petitioner cited two witnesses:

Michael Annis and William Odell. Respondent argues that these two witnesses were never disclosed by petitioner in discovery or even referenced in any documents provided by petitioner and that petitioner deliberately withheld their identity from respondent. Respondent further argues that

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petitioner which referenced such witness.

the testimony of Rob Hallstrom, who was named in petitioner's pretrial disclosures, should be limited to only the "basic information and topics contained in the two emails produced by petitioner referencing Mr. Hallstrom."

While it appears that petitioner has yet to notice any depositions for these witnesses, in the interest of judicial economy, the Board finds it appropriate to consider the motion with respect to the witnesses. Where a party believes the adverse party's pretrial disclosures are insufficient, untimely, or are otherwise technically deficient, judicial economy is best accomplished by bringing such issue to the Board's attention promptly by a motion to strike the pretrial disclosures as insufficient before the deposition takes place. See *Spier Wines Ltd. V. Ofer Z. Shepherd*, 105 USPQ2d 1239. Here, respondent is essentially contending that petitioner's failure to previously identify Messrs. Annis and Odell before its pretrial disclosures resulted in an unfair surprise and that Mr. Hallstrom testimony should be limited. Rather than seeking a ruling on a particular evidentiary issue in advance of these witnesses' testimony being introduced, respondent is seeking to preclude these witnesses from testifying at all (about anything) or limiting the testimony to certain subjects (for one of them), and its motion is, therefore, not construed as a motion in limine, but rather as a combined motion to

strike the pretrial disclosures and preclude the taking of testimony.

Parties are required to serve pretrial disclosures to inform the adverse party of the identity of prospective trial witnesses, or any witness from whom it might take testimony if needed, thus avoiding surprise witnesses and facilitating the orderly taking of testimony. See Fed. R. Civ. P. 26(a)(3); Trademark Rule 2.116(a). See also *Notice of Final Rulemaking, Miscellaneous Changes to Trademark Trial and Appeal Board Rules*, 72 Fed. Reg. 42242, 42257-58 (Aug. 1, 2007).

Under the estoppel sanction, a party that fails to provide information via disclosure or appropriate response to a discovery request may, upon motion or objection by its adversary, be precluded from using that information or witness at trial, "unless the failure was substantially justified or is harmless." Fed. R. Civ. P. 37(c)(1); Trademark Rule 2.116(a). See *Great Seats*, 100 USPQ2d at 1326-27.

To determine whether petitioner's failure to disclose these witnesses (or the witness' knowledge on certain subjects as in the case of Mr. Hallstrom) in his responses to respondents' discovery requests is substantially justified or harmless, the Board is guided by the following five-factor test applied in *Great Seats*, namely: "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 non-disclosing party's explanation for its failure to disclose the evidence." See *Great Seats*, 100 USPQ2d at 1327 (internal citations omitted).

*Mr. Annis*

Mr. Annis is the CEO for respondent (the record indicates that he is now a former employee). The Board has reviewed the discovery requests propounded by respondent and finds that none of the requests would have likely prompted a response which would have included Mr. Annis' name. Seeking his testimony should not be considered a surprise to respondent. Hence, the first two factors favor petitioner.

Regarding the extent to which allowing the testimony of the Mr. Annis would disrupt this trial, this factor also favors petitioner. Regarding the importance of the evidence at issue, the testimony of Mr. Annis may be important in petitioner's meeting its burden of proof in this proceeding. This factor therefore also favors petitioner.

Petitioner's explanation for its failure to disclose Mr. Annis is well-taken. Therefore, this factor strongly favors petitioner.

In view thereof, the Board finds that it is inappropriate to apply the estoppel sanction with regard to Mr. Annis. Respondent's motion to preclude the testimony of Mr. Annis is denied.

*Mr. Odell*

The record shows that respondent's Interrogatory No. 3 asked petitioner to identify "each person with any information concerning Petitioner's selection of Petitioner's NAUGLES Mark." In response, petitioner named certain individuals none of whom were Mr. Odell. Petitioner asserts that in response to respondent's document requests petitioner provided a copy of a calendar entry from February 13, 2010 which states, "drove with Bill up to Visalia to meet w/Jeff Naugle to talk about reviving the old Naugles fast food chain." Petitioner states that this entry references "Bill" who is Mr. Odell. Petitioner argues that the fact that respondent never thought to conduct follow-up discovery to ask about the parties referenced in this document should not be used against petitioner. Respondent's argument is not well-taken. The Board agrees with petitioner that it is indeed curious that petitioner would disclose several other individuals in response to Interrogatory No. 3, but not Mr. Odell when it seems clear that Mr. Odell was indeed involved in the selection of

petitioner's NAUGLES mark as indicated in the calendar entry referenced.

Regarding surprise to respondent, respondent had no reason to believe that petitioner's response to interrogatory no. 2 was anything other than a complete and good faith response to that interrogatory. Petitioner's failure to name Mr. Odell during discovery and then naming him for the first time in petitioner's pretrial disclosures resulted in unfair surprise to respondent and deprived respondent of any opportunity to take discovery from him. See "Miscellaneous Changes to Trademark Trial and Appeal Board Rules," 72 Fed. Reg. 42242, 42255 (August 1, 2007) (explaining that one reason for the Board's adoption of a pretrial disclosure requirement was to address assertions of unfair surprise at trial). Accordingly, this factor strongly favors respondent.

Regarding the ability of respondent to cure the surprise, the Board notes that respondent could not cure the surprise without filing the present motion decided in this order or by seeking to reopen discovery to take the discovery deposition of Mr. Odell. This factor also favors respondent.

Regarding the extent to which allowing the testimony of the Mr. Odell would disrupt this trial, petitioner's failure to disclose this witness earlier in its response to

Interrogatory No. 3 or through supplementation of its interrogatory response has indeed been disruptive to the orderly administration of this trial. Such late disclosure caused respondent to file its motion in response thereto and caused the Board to suspend this case pending a decision thereon. This factor also favors respondent.

Regarding the importance of the evidence at issue, the testimony of Mr. Odell may be important. Petitioner, as plaintiff, has the burden of proof in this proceeding, and its selection of the NAUGLES mark and its claims of the abandonment of such mark by respondent may help it prevail on the claim it has pleaded. This factor therefore may favor petitioner. The Board notes, however, that petitioner has other witnesses upon whom it may rely in support of this cancellation.

Regarding the fifth factor, petitioner's explanation for its failure to disclose Mr. Odell is disingenuous. The fact that it submitted a calendar entry with its document production with the first name only of Mr. Odell is not enough to overcome the fact that it failed to include Mr. Odell in its response to Interrogatory No. 3. Therefore, this factor strongly favors respondent.

On balance, the Board finds that petitioner's failure to name Mr. Odell until service of its pretrial disclosures after the close of discovery was neither harmless nor

substantially justified. In view thereof, the Board finds that it is appropriate to apply the estoppel sanction. Respondent's motion to preclude the testimony of Mr. Odell is granted to the extent that petitioner may not take testimony of Mr. Odell.

*Mr. Hallstrom*

Respondent also contends that while Mr. Rob Hallstrom was briefly referenced in two emails produced by petitioner during discovery, these two emails did not reference or disclose the numerous categories of information and documents that petitioner now purports (in the pretrial disclosures) Mr. Hallstrom will address in his testimony. Respondent contends that Mr. Hallstrom's testimony should be limited to only the basic information and topics contained in the two emails produced by petitioner referencing Mr. Hallstrom.

In response, petitioner submitted the 18 pages of emails in connection with his document production which were written between petitioner and Mr. Hallstrom.

The Board has carefully reviewed these emails as well as the other discovery requests propounded by respondent and finds that respondent had enough notice of Mr. Hallstrom such that respondent's failure to seek further discovery about Mr. Hallstrom and his knowledge cannot now be blamed on petitioner. In other words, there was no surprise that

petitioner might be relying on Mr. Hallstrom's testimony and so there is no need to cure here. Mr. Hallstrom's testimony will, therefore, not be limited by this order.

In conclusion, the motion to strike the pretrial disclosures with respect to Mr. Odell is granted, but denied as to Messrs. Annis and Hallstrom. The testimony of Mr. Odell is precluded, but the testimonies of Messrs. Annis and Hallstrom is not.

Proceedings herein are resumed. Dates are reset as follows:

Plaintiff's 30-day Trial Period Ends	10/18/2013
Defendant's Pretrial Disclosures	11/2/2013
Defendant's 30-day Trial Period Ends	12/17/2013
Plaintiff's Rebuttal Disclosures	1/1/2014
Plaintiff's 15-day Rebuttal Period Ends	1/31/2014

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 the taking of testimony. See Trademark Rule 2.125. Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b).

An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.