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

Proceeding	92054201
Party	Plaintiff Dan Foam ApS
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Date	01/03/2014
Attachments	Motion for Leave to Supplement Pretrial Disclosures.pdf(82206 bytes ) Exhibit A -- Notice of Deposition for Jane Martin.pdf(59027 bytes )

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

DAN FOAM APS	)	
	)	
Petitioner,	)	
	)	Cancellation No. 92054201
v.	)	
	)	
SLEEP INNOVATIONS, INC.,	)	
	)	
Registrant.	)	

**MOTION FOR LEAVE TO SUPPLEMENT PRETRIAL DISCLOSURES AND MOTION  
TO CONDUCT DEPOSITION TELEPHONICALLY**

**I.    MOTION FOR LEAVE TO AMEND PRETRIAL DISCLOSURES**

Pursuant to Fed. R. Civ. P. 26(e)(1)(A), Petitioner Dan Foam APS (“Petitioner”), by counsel, hereby moves for leave to supplement its Pretrial Disclosures to add an additional witness. Specifically, Petitioner wishes to add Jane Martin, a customer of Overstock.com to its Pretrial Disclosures. Petitioner was unaware of the relevance of Ms. Martin’s interactions with retailer Overstock.com and her potential to serve as a witness until December 17, 2013, after Petitioner deposed a representative of Overstock.com. Ms. Martin was referenced in the documents that had been produced by Overstock.com in response to a subpoena as a consumer who had suffered consumer confusion between Registrant’s and Petitioner’s marks. However, the testimony deposition of Overstock.com provided necessary background information about the processes related to the collection of customer confusion data.

While Overstock.com had previously produced documents that included names of consumers who had made customer service inquiries pertaining to products bearing the BODIPEDIC mark, it was not until Petitioner deposed a representative of Overstock.com that Petitioner had an understanding of how the Overstock.com customer service information is

collected and the significance of the individuals referenced in the documents produced by Overstock.com. Immediately following the Overstock.com deposition, Petitioner attempted to contact Ms. Martin, but was unable to reach Ms. Martin until earlier this week, when Ms. Martin contacted the offices of counsel for Petitioner.

Because Petitioner just now learned of Ms. Martin's potential to serve as a witness, the Board should grant Petitioner leave to supplement its Pretrial Disclosures. Board inter partes proceedings are governed, in part, by the Federal Rules of Civil Procedure, except as otherwise provided in the Trademark Rules of Practice, and "wherever [the Federal Rules are] applicable and appropriate." Trademark Rule 2.116. In turn, Fed. R. Civ. P. 26(a)(3)(A)(i) requires parties to provide pretrial disclosures identifying each witness the "the party expects to present." Additionally, Fed. R. Civ. P. 26(e)(1)(A) permits a party who has made a disclosure under Rule 26(a) to supplement its disclosure "in a timely manner if the party learns that in some material respect the disclosure or response is incomplete or incorrect, and if the additional or corrective information has not otherwise been made known to the other parties...." Petitioner is simply attempting to comply with its ongoing duty to supplement pretrial disclosures. *See* Fed. R. Civ. P. 26(e)(1)(A). Granting Petitioner leave to do so would be appropriate in this situation.

Petitioner's failure to disclose Ms. Martin as a witness was justified; the relevance of Ms. Martin's consumer interactions with Overstock.com were not discovered until recently, and Petitioner disclosed Ms. Martin as a potential witness as soon as reasonably practicable. Additionally, Petitioner's late disclosure of Ms. Martin as a witness will in no way prejudice Registrant. Petitioner intends to only depose Ms. Martin about a single purchase she made from Overstock.com. Registrant will have the opportunity to cross-examine Ms. Martin during Ms. Martin's testimony deposition, and Registrant will also have the opportunity to call Ms. Martin

as a witness during its own testimony period, if it so chooses. Furthermore, Registrant cannot claim surprise by the disclosure of Ms. Martin or the subject matter of her testimony. Registrant received a copy of the documents provided by Overstock.com which included Ms. Martin's name, just as Petitioner did, and could have made an attempt to depose a representative of Overstock.com to understand the customer references in those documents during the discovery period.

Finally, any claimed prejudicial effect to Registrant is outweighed by the value of the testimony provided by Ms. Martin. Ms. Martin serves as evidence of actual confusion, which is highly probative to the issues in this case. Permitting Petitioner to supplement its pretrial disclosures would serve the interests of justice and grant Petitioner the opportunity to put forth its best evidence. Accordingly, Petitioner's motion for leave to supplement its Pretrial Disclosures should be granted.

## **II. MOTION TO CONDUCT DEPOSITION TELEPHONICALLY**

Additionally, Petitioner moves for an order granting Petitioner permission to take the testimony deposition of Jane Martin telephonically. Fed. R. Civ. P. 30(b)(4) and TBMP § 703.01(h) permit depositions to be conducted telephonically. Specifically, Fed. R. Civ. P. 30(b)(4) provides:

The parties may stipulate—or the court may on motion order—that a deposition be taken by telephone or other remote means. For the purpose of this rule and Rules 28(a), 37(a)(2), and 37(b)(1), the deposition takes place where the deponent answers the questions.

Likewise, TBMP § 703.01(h) states that a deposition may be taken by telephone pursuant to a stipulation of the parties or on motion granted by the Board. The Board regularly allows parties may conduct deposition by telephone or other electronic means. *See Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1654 (TTAB 2007). In fact, the Board has recognized that federal

court practice favors the use of technology and has, at times, encouraged parties to conduct depositions by telephone. *See Hewlett-Packard Co. v. Healthcare Personnel, Inc.*, 21 USPQ2d 1552, 1552-53 (TTAB 1991).

In this case, a telephone deposition is appropriate. No harm or prejudice which would result from a deposition by telephone; counsel for Registrant would still have the opportunity to cross-examine the witness, just telephonically rather than live. Additionally, Ms. Martin resides in Arizona, but counsel for Petitioner resides in Kentucky and counsel for Registrant resides in New Jersey. Taking into consideration the burdensome distance counsel for both parties would be forced to travel to attend the deposition, and the substantial costs that accompany such travel, Petitioner respectfully moves to allow the deposition of Ms. Martin to be conducted telephonically. Petitioner has scheduled the deposition of Ms. Martin for Friday, January 10, 2013 at 1:00 p.m. Mountain Time. A copy of the Notice of Deposition is attached hereto as Exhibit A.

### **III. CONCLUSION**

For the foregoing reasons, Petitioner respectfully requests that the Board grant Petitioner leave to supplement its Pretrial Disclosures and issue an Order granting Petitioner's request to take the deposition of Jane Martin telephonically. Due to the limited amount of time remaining in Petitioner's testimony period and Ms. Martin's availability for a deposition next Friday, January 10, 2013, Petitioner also requests an emergency hearing on these motions and an expedited decision.

Respectfully submitted,

s/Amy Sullivan Cahill  
Amy Sullivan Cahill  
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**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing was served on counsel for Registrant, this 3<sup>rd</sup> day of January, 2014, by sending same via First Class Mail, postage prepaid, to:

Irene Hurtado  
Robert W. Smith  
MCCARTER & ENGLISH LLP  
Four Gateway Center  
100 Mulberry Street  
Newark, New Jersey 07102

s/Amy Sullivan Cahill  
Amy Sullivan Cahill

**EXHIBIT A**

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DAN FOAM APS	)	
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Petitioner,	)	
	)	Cancellation No. 92054201
v.	)	
	)	
SLEEP INNOVATIONS, INC.,	)	
	)	
Registrant.	)	

**NOTICE OF DEPOSITION**

PLEASE TAKE NOTICE that on Friday, January 10, 2014, at 1:00 p.m. Mountain Time, the Petitioner, Dan Foam APS, by counsel, will take the deposition of Jane Martin, telephonically. The deposition will be taken in accordance with the Federal Rules of Civil Procedure and will be used for all purposes allowed by the Federal Rules of Evidence and the Trademark Rules. You are invited to attend and to cross-examine.

s/ Amy Sullivan Cahill  
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s/ Amy Sullivan Cahill  
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