

ESTTA Tracking number: **ESTTA581463**

Filing date: **01/13/2014**

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

Proceeding	92054201
Party	Plaintiff Dan Foam ApS
Correspondence Address	AMY SULLIVAN CAHILL STITES HARBISON PLLC 400 WEST MARKET STREET , SUITE 1800 LOUISVILLE, KY 40202 3352 UNITED STATES acahill@stites.com
Submission	Other Motions/Papers
Filer's Name	Mari-Elise Taube
Filer's e-mail	mtaube@stites.com, acahill@stites.com
Signature	/mari-elise taube/
Date	01/13/2014
Attachments	Reply in Support of Petitioner's Motion to Supplement Pretrial Disclosures.pdf(124901 bytes) Exhibit A -- Declaration of Amy S. Cahill.pdf(60192 bytes) Exhibit 1 to Declaration of Amy S. Cahill.pdf(40511 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.)	

**REPLY IN SUPPORT OF PETITIONER’S MOTION FOR LEAVE TO SUPPLEMENT
PRETRIAL DISCLOSURES AND MOTION TO CONDUCT DEPOSITION
TELEPHONICALLY AND RESPONSE IN OPPOSITION TO REGISTRANT’S CROSS-
MOTION TO QUASH AND MOTION FOR A PROTECTIVE ORDER**

Pursuant to TBMP § 502.02, Petitioner Dan Foam APS (“Petitioner”), by counsel, hereby submits its reply in support of its Motion for Leave to Supplement its Pretrial Disclosures to add Jane Martin as an additional witness. Petitioner also submits this brief in opposition to Registrant Sleep Innovations, Inc.’s (“Registrant”) Cross-Motion to Quash the Notice of Deposition of Jane Martin and deny Registrant’s Motion for Protective Order Pursuant to Rules 26(c)(1)(B) and 32(a)(5)(A).

I. REPLY IN SUPPORT OF PETITIONER’S MOTION FOR LEAVE TO SUPPLEMENT PRETRIAL DISCLOSURES AND MOTION TO CONDUCT DEPOSITION TELEPHONICALLY

Petitioner seeks to supplement its Pretrial Disclosures to add Jane Martin, a customer of Overstock.com who suffered actual confusion, to its witness list and to depose Ms. Martin about a single purchase she made from Overstock.com.¹ Ms. Martin’s testimony is highly relevant to the issues before the Board. The request to add Ms. Martin to Petitioner’s witness list was made

¹ Petitioner also seeks leave to take the deposition of Ms. Martin, who is located in Phoenix, Arizona, by telephone as set forth more fully herein.

within the Petitioner's trial period and notice provided to Registrant in advance of her proposed deposition.

Petitioner moved for leave to supplement its Pretrial Disclosures as soon as was reasonably practicable after learning of Overstock.com's inability to provide the necessary information about the source of Ms. Martin's comments and first becoming aware of Ms. Martin's ability and availability to become a witness in this proceeding. *See* Declaration of Amy S. Cahill ("Cahill Decl."), attached hereto as Exhibit A. As Petitioner admits, Petitioner has been aware of the existence of Ms. Martin and of Petitioner's intent to rely on actual confusion evidence in support of Petitioner's claims for several months.

Petitioner was in no way attempting to skirt its pretrial obligations, nor was Petitioner seeking to "hide the ball" in requesting this amendment to its pretrial disclosures. *Id.* ¶ 14.

BACKGROUND

On February 10, 2012, in response to a subpoena issued by Petitioner, Overstock.com produced a log of consumer service communications. Cahill Decl. ¶ 2. Jane Martin was referenced in the documents produced by Overstock.com in response to the subpoena. Cahill Decl. ¶ 3. Petitioner produced the consumer service communication log to Registrant during discovery and relied upon the consumer service communication log in support of Petitioner's motion for summary judgment.

On November 22, 2013, Petitioner directed the issuance of a second subpoena to Overstock.com for the purpose of deposing a corporate representative regarding the log of consumer service communications produced by Overstock.com. Cahill Decl. ¶ 4; Exh. 1.

On December 17, 2013, Petitioner's counsel traveled to Salt Lake City, Utah to conduct the deposition of a representative of Overstock.com on the topics set forth in the subpoena.

Cahill Decl. ¶ 5. Among the topics specified in the subpoena were: “Overstock.com's business methods of collecting and retaining customer inquiries” and “Evidence of customer confusion between Bodipedic products and Tempur-Pedic products.” Cahill Decl. ¶ 6.

The deposition of the corporate representative produced by Overstock.com provided information regarding the steps taken by Overstock.com to query its internal database for purposes of generating the “log” report it produced, and general information about the three methods by which customer communication information is collected in an internal database by Overstock.com. However, the deponent produced by Overstock.com was not able to testify with particularity regarding the business methods used to collect customer inquiries or about actual confusion evidence that appeared in the log, which topics were identified in the issued subpoena. Cahill Decl. ¶ 7. This testimony was arguably insufficient to provide the necessary foundation to authenticate the comments included in the customer service log or to shed additional light on instances of actual confusion witnessed by Overstock.com.² Cahill Decl. ¶ 8.

Because the testimony period remained open, Petitioner immediately contacted Ms. Martin in order to determine her availability for a deposition. Cahill Decl. ¶ 9. Petitioner was unable to reach Ms. Martin until December 31, 2013, when Ms. Martin first contacted the offices of counsel for Petitioner by phone about her availability. Prior to this contact, Petitioner was unaware whether the contact information for Martin was valid. Cahill Decl. ¶ 10. Ms. Martin advised that she was available for a deposition on January 10, 2014, a date within Petitioner’s testimony period. Cahill Decl. ¶ 11. Petitioner disclosed the identity of Ms. Martin as a witness and moved the Board for leave to amend its pretrial disclosures as soon as was reasonably practical. Cahill Decl. ¶ 12.

² Petitioner has reserved its right to take a second deposition Overstock.com by objecting to the representative’s lack of knowledge of the topics identified in the subpoena and advising counsel for Registrant of same on the deposition record. Petitioner has advised Overstock.com of the same possibility.

Contrary to Registrant's assertions, Petitioner is not attempting to skirt the Board rules. *Id.* ¶ 14-16. To the contrary, Petitioner is simply attempting to comply with its ongoing duty to supplement its pretrial disclosures. *See* Fed. R. Civ. P. 26(e)(1)(A). Fed. R. Civ. P. 26(e)(1)(A) permits a party who has made a disclosure under Rule 26(a) to supplement its disclosures "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...." Because Petitioner learned of Ms. Martin's potential to serve as a witness after the pretrial disclosure date and moves to supplement its Pretrial Disclosures in good faith, the Board should grant Petitioner leave to supplement its Pretrial Disclosures. Registrant will not be prejudiced by this delay as it was aware of Ms. Martin and her relevance in the case and because Registrant will be afforded the ability to participate in the deposition and to take its own depositions to refute this testimony during its trial period.

A. Petitioner supplemented its disclosures as soon as practicable.

Registrant maintains that Petitioner should not be allowed to supplement its Pretrial Disclosures to add Ms. Martin as a witness and take the testimony deposition of Ms. Martin because Petitioner did not supplement its initial disclosures. Registrant suggests that Petitioner had a duty to identify during discovery any witness that it would use as a witness during the trial period. But Petitioner did not have such a duty.

Petitioner was unaware of the need to take the deposition of Ms. Martin until after the close of discovery and after the commencement of Petitioner's testimony period. As soon as it became reasonably practicable *and before either party's testimony period closed*, Petitioner moved to supplement its Pretrial Disclosures. *See Spier Wines (PTY) Ltd. v. Shepherd*, 105 USPQ2d 1239, *8-9 (TTAB June 12, 2012) ("In identifying individuals through initial

disclosures, a party need not identify all those that may be called at trial as potential ‘trial witnesses,’ and instead must identify any trial witnesses through pretrial disclosures.”) The purpose of pretrial disclosures is to inform the adverse party of the identity of prospective trial witnesses, or any witness *from whom it might take testimony if needed*. *Id.* at *9, n.6 (citing 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)).

Furthermore, Fed. R. Civ. P. 26(e)(1)(A) requires parties to supplement their 26(a) disclosures “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 during the discovery process or in writing.” However, the Advisory Committee Notes to Rule 26(e) provide that there is “no obligation to provide supplemental or corrective information that has been otherwise made known to the parties in writing or during the discovery process, as when a witness not previously disclosed is identified during the taking of a deposition....” It is therefore unnecessary, “as a matter of course, to submit a supplemental disclosure to include information already revealed by a witness in a deposition or otherwise through formal discovery, including the identity of the witness.” *Galaxy Metal Gear, Inc. v. Direct Access Tech., Inc.*, 91 USPQ2d 1859, *7 (TTAB Aug. 24, 2009) (opposer’s failure to supplement initial disclosures to identify a foreign nonparty witness as a potential witness did not preclude the introduction of the witness’ discovery deposition at trial, even though opposer should have supplemented initial disclosures, because applicant was aware of witness’s identity and subject matter of her testimony and was able to cross-examine the witness during the discovery phase) (internal citation omitted).

As Registrant admits in its Response and Cross-Motion, Ms. Martin's name was made known through the discovery process. Ms. Martin's name was included in the documents that had been produced by Overstock.com in response to the February 2012 subpoena as a consumer who had suffered consumer confusion between Registrant's and Petitioner's marks. *See Cahill Decl.* at ¶3. Because Ms. Martin's identity was disclosed through a response to a subpoena, it was therefore unnecessary, as a matter of course, to submit a supplemental initial disclosure. *See Galaxy Metal Gear, Inc.*, 91 USPQ2d 1859 at *7. Nevertheless, Petitioner attempted to make such supplementations in a timely manner.

The Board in the *Alcatraz* proceeding, considered a similar factual scenario. Following the denial of cross-motions for summary judgment, the Petitioner's pretrial disclosure deadline was reset for February 28, 2011, and Petitioner's testimony period was set to open on March 15, 2011. On the first day of Petitioner's testimony period, Petitioner served amended pretrial disclosures naming two additional third-party witnesses and noticed the depositions of the new witnesses for within the set trial period. The Registrant moved to quash the newly added witnesses and their depositions.

The Board in *Alcatraz* issued an order holding that the Respondent should not have been surprised by the addition of the third-party witnesses because the existence of the witness was made known to Registrant during discovery, and thus it was not substantially prejudiced by the late identification. *See Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, (interim Board Order dated March 24, 2011) at pp. 12-13.

Registrant admits that it was aware of the existence of Ms. Martin during the discovery period. Registrant was aware of the Petitioner's intent to rely on evidence of actual confusion by third-parties, as the same evidence was used in support of Petitioner's motion for summary

judgment. This Registrant cannot be substantially prejudiced by the formal amendment to include Ms. Martin as a witness.

B. Petitioner's late disclosure of Ms. Martin as a witness was both substantially justified and harmless.

To determine whether Petitioner's late disclosure of the witness in question in Pretrial Disclosures is substantially justified or harmless, the Board is guided by the following five-factor test: 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, Inc. v. Great Seats, Ltd.*, 100 USPQ2d 1323, 1327 (TTAB 2011). Applying the *Great Seats* factors to the facts at hand, it is clear that Petitioner's late disclosure of Ms. Martin as a witness was both substantially justified and harmless.

Looking to the first and second factors, Petitioner submits that Registrant is hard-pressed to feign surprise as the disclosure of Ms. Martin as a witness. As Registrant itself admits and as has been previously discussed, Registrant had the name of Ms. Martin in its possession since February 2012. *See Cahill Decl.* at ¶ 2. Ms. Martin was referenced in the documents that had been produced by Overstock.com in response to the February 2012 subpoena as a consumer who had suffered consumer confusion between Registrant's and Petitioner's marks. *Id.* at ¶3. Because Registrant had Ms. Martin's name in its possession as a result of Overstock.com's subpoena, Registrant can hardly assert surprise and certainly cannot assert incurable surprise.

The facts here parallel closely to those in *Sheetz of Del., Inc. v. Doctor's Assocs.*, 108 USPQ2d 1341 (TTAB Sept. 15, 2013). In *Sheetz*, Applicant objected to the admission of evidence on the ground that opposer failed to disclose various witnesses in its initial disclosures. However, the Board found that because the applicant had knowledge of the existence of the

witnesses at issue and their businesses, applicant had adequate and reasonable notice about these witnesses and opposer's failure to supplement its discovery responses or initial disclosures did not preclude the introduction of their testimony declarations. *Id.* at *8.

Additionally, the Board found that applicant was "hard-pressed to argue convincingly that it was surprised" when the opposer attempted to introduce the declaration of two additional restaurateurs who identify 12-inch sandwiches using the term "footlong" after opposer had previously filed a motion for summary judgment in which it relied on substantial evidence of third-party use of the term "footlong" to refer to 12-inch sandwiches. *Id.* at *10. The Board noted that there was "no real surprise to cure." *Id.*

Registrant draws attention to the fact that Petitioner, in its brief in support of its Motion for Summary Judgment, quoted the exchange between Ms. Martin and Overstock.com's customer service representative, which Petitioner characterized as an example of consumers referring to the BODIPEDIC products already purchased from Overstock.com as TEMPUR-PEDIC brand products. As in *Sheetz*, Registrant is hard-pressed to convincingly argue that it was surprised by the late disclosure of Ms. Martin. Like in *Sheetz*, there is no real surprise to cure. *See Sheetz of Del., Inc.*, 108 USPQ2d at *10.

Registrant cannot credibly claim that it was surprised by the disclosure of Ms. Martin and that it would have conducted discovery or its testimony period any differently. It was aware of Ms. Martin and Petitioner's intent to rely on actual confusion evidence during the discovery period. And its testimony period has not yet begun.³

As to the third factor, allowing Petitioner to take the testimony deposition of Ms. Martin would not disrupt the trial. Petitioner will depose Ms. Martin within its testimony period, and

³ Registrant admits that it understands that Ms. Martin's testimony will pertain to actual confusion. *See* Response at page 10.

will not require further extension of the testimony period.⁴ Registrant will have the opportunity to cross-examine Ms. Martin during Ms. Martin's testimony deposition⁵, and Registrant will also have the opportunity to call Ms. Martin as a witness during its own testimony period, if it so chooses. It is unnecessary for the discovery period to be reopened; as Registrant admits, Registrant had within its possession the compilation of communications between Overstock.com customer service representatives and Overstock.com customers. If Registrant was interested in refuting evidence of actual confusion, it could have deposed Ms. Martin or any other particular individual identified in the Overstock.com documents during the discovery period.

As to the fourth factor, the testimony of Ms. Martin is critical evidence in a likelihood of confusion analysis. Petitioner will offer Ms. Martin's testimony as evidence of actual confusion suffered by a reasonably prudent purchaser who purchased a BODIPEDIC product thinking that it was actually a TEMPUR-PEDIC product. Actual confusion evidence is considered highly persuasive and often dispositive. The existence of actual confusion is typically very persuasive evidence of likelihood of confusion and undercuts possible claims that the marks are so dissimilar that there can be no likelihood of confusion. *Nanny Poppins, LLC v. Deneane Maldonado*, 2013 TTAB LEXIS 253, *22 (TTAB May 16, 2013) (citing *Thompson v. Haynes*, 305 F.3d 1369, 64 USPQ2d 1650 (Fed. Cir. 2002); *Exxon Corp. v. Texas Motor Exchange, Inc.*, 628 F.2d 500, 208 USPQ 384, 389 (5th Cir. 1980) ("The best evidence of likelihood of confusion is provided by evidence of actual confusion")). Evidence of actual confusion is often difficult to obtain, so it is essential that Petitioner be permitted to depose Ms. Martin to admit her testimony

⁴ By agreement, both Registrant and Petitioner will have sixty day testimony periods. Petitioner does not object to further extension of these periods in order to insure lack of prejudice to Registrant.

⁵ Registrant claims that it will be limited in its ability to cross-examine Ms. Martin since it did not have the opportunity to take her discovery deposition. However, Ms. Martin's testimony is relevant to the sole issue of actual confusion; since Petitioner will be deposing Ms. Martin on the issue of actual confusion and her purchase from Overstock.com, Registrant will have the opportunity to cross-examine Ms. Martin on this issue.

of actual confusion into evidence. *See Real Media, Inc. v. RealNetworks, Inc.*, 2002 TTAB LEXIS 474, *32 (TTAB Oct. 17, 2001) (citing *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992); *Block Drug v. Den-Mat Inc.*, 17 USPQ2d 1315, 1318 (TTAB 1989)). Because Ms. Martin can provide “testimony of a ‘reasonably prudent purchaser,’ who was in fact confused,” she is the best evidence of actual confusion. *See Lanard Toys, Ltd. v. Hasbro, Inc.*, 1997 TTAB LEXIS 430, *22 (TTAB April 17, 1997) (citing J. T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, Section 23.13 (4th ed. 1996)).

Finally, Petitioner has explained its failure to Ms. Martin as a witness prior to January 3, 2014. Petitioner was in no way attempting to skirt its pretrial obligations or make an end-run around the Board’s disclosure rules, as Registrant improperly alleges. *See Cahill Decl.* at ¶ 13. To the contrary, as previously explained by Petitioner, the need to proceed with Ms. Martin’s testimony to provide the necessary context for her consumer interactions with Overstock.com was not discovered until after the deposition of the representative of Overstock.com. *Id.* at ¶ 8. Immediately following the Overstock.com deposition, Petitioner attempted to contact Ms. Martin. *Id.* at ¶ 9. Petitioner was unable to reach Ms. Martin until December 31, 2013, when Ms. Martin contacted the offices of counsel for Petitioner by phone. *Id.* at ¶ 10. Petitioner disclosed Ms. Martin as a potential witness on January 3, 2014, as soon as reasonably practicable. *Id.* at ¶ 12.

A review of the five *Great Seats* factors confirms that Petitioner’s late disclosure of Ms. Martin as a witness was substantially justified and cannot be prejudicial to Registrant. Permitting Petitioner to supplement its Pretrial Disclosures is critical to permitting the case to proceed on a full record and allow the Board’s consideration on the merits. Accordingly, Petitioner’s Motion for Leave to Supplement Pretrial Disclosures to add Jane Martin as a witness

should be granted. Now that the Board has effectively stayed the testimony period in the case, Respondent will have had adequate opportunity to prepare for the deposition.

II. RESPONSE IN OPPOSITION TO REGISTRANT’S CROSS-MOTION TO QUASH AND MOTION FOR A PROTECTIVE ORDER

Relying on Rules 26(c)(1)(B) and 32(a)(5)(A) of the Federal Rules of Civil Procedure, Registrant moves for a protective order preventing Petitioner from taking the deposition of Jane Martin. Registrant mischaracterizes Fed. R. Civ. P. 32(a)(5)(A), which, in its entirety states, “A deposition must not be used against a party who, having received less than 14 days’ notice of the deposition, promptly moved for a protective order under Rule 26(c)(1)(B) requesting that it not be taken or be taken at a different time or place--and this motion was still pending when the deposition was taken.” Contrary to Registrant’s characterization of the rule, Fed. R. Civ. P. 32(a)(5)(A) does not require a party to provide fourteen days of notice prior to a deposition, nor does it prevent the deposition from being taken entirely, as Registrant implies; the Rule only prevents the deposition from being taken and used against the movant while a motion for protective order is pending.

Registrant’s reliance on Fed. R. Civ. P. 26(c)(1)(B) is likewise misplaced. Fed. R. Civ. P. 26(c)(1)(B) pertains to discovery disclosures, not testimony depositions, and requires that a motion for a protective order under this rule, “include a certification that the movant has in good faith conferred or attempted to confer with other affected parties in an effort to resolve the dispute without court action.” Fed. R. Civ. P. 26(c)(1). No such certification is included in Registrant’s motion, and Registrant did not attempt to confer with Petition in good faith to resolve the issue pertaining to the timing of the discovery deposition before moving for a protective order before the Board.

As Registrant correctly notes, Petitioner notified Registrant of its intention to depose Ms. Martin for the first time on January 10, 2014, six days prior to Ms. Martin's scheduled deposition. Petitioner's notice of deposition for Jane Martin was timely and reasonable. Trademark Rule 2.123(c) states that "[d]epositions may be noticed for any reasonable time and place in the United States." Whether notice of a deposition is reasonable is determined by the individual facts of each case. *Duke University v. Haggard Clothing, Inc.*, 54 USPQ2d 1443 (TTAB 2000) (three days' notice found reasonable). The Board has found that notice of six days was reasonable. *See Sunrider Corp. v. Raats*, 83 USPQ2d 1648 (TTAB 2007). In fact, there are cases where the Board found, based on the circumstances presented, one or two days of notice for a deposition to be reasonable. *Id.* at 1661 (citing *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280 (TTAB 1998) (one day notice found reasonable); *Hamilton Burr Publishing Co. v. E.W. Communications, Inc.*, 216 USPQ 802 (TTAB 1982) (two days' notice found reasonable)). In this case, Petitioner provided Registrant with six days of notice, and noticed the testimony deposition for within Petitioner's testimony period. Because Petitioner's testimony period was scheduled to close on January 17, 2013, Petitioner was forced to notice the deposition of Ms. Martin within a short time frame. The Board has noted that "insofar as the assigned periods for taking testimony set by the Board are relatively short...each party is effectively on notice that any of the approximately 20 business days during a typical 30-day trial period may potentially be used for the taking of testimony deposition." *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1659, n. 6 (TTAB 2007). Accordingly, Petitioner's notice of deposition for Jane Martin was timely and reasonable, and Petitioner should be permitted to reschedule and take the testimony deposition of Jane Martin.

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 and deny Registrant's Cross-Motion to Quash the Notice of Deposition of Jane Martin and deny Registrant's Motion for Protective Order Pursuant to Rules 26(c)(1)(B) and 32(a)(5)(A).

Respectfully submitted,

s/Amy Sullivan Cahill
Amy Sullivan Cahill
STITES & HARBISON PLLC
400 West Market Street, Suite 1800
Louisville, KY 40202-3352
Telephone: 502-587-3400
Facsimile: 402-587-6392
acahill@stites.com

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing was served on counsel for Registrant, this 13th day of January, 2014, by sending same via First Class Mail, postage prepaid, to:

Irene Hurtado
Scott S. Christ
MCCARTER & ENGLISH LLP
Four Gateway Center
100 Mulberry Street
Newark, New Jersey 07102

s/Amy Sullivan Cahill
Amy Sullivan Cahill

**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.)	

DECLARATION OF AMY S. CAHILL

I, Amy Sullivan Cahill, pursuant to 28 U.S.C. § 1746, declare as follows:

1. I am a member of Stites & Harbison, PLLC and represent Petitioner Dan Foam APS (“Petitioner”) in the above-captioned proceeding. This Declaration is submitted in support of Petitioner’s Reply in Support of Petitioner’s Motion for Leave to Supplement Pretrial Disclosures and Motion to Conduct Deposition Telephonically and Response in Opposition to Registrant’s Cross-Motion to Quash and Motion for a Protective Order.
2. On February 10, 2012, in response to a subpoena issued to it by Petitioner, Overstock.com produced a log of consumer service communications.
3. Jane Martin was referenced in the documents produced by Overstock.com in response to the subpoena.
4. On November 22, 2013, I directed the issuance of a second subpoena to Overstock.com for the purpose of deposing a corporate representative regarding the log of consumer service communications produced by Overstock.com. Exhibit 1.
5. On December 17, 2013, I traveled to Salt Lake City, Utah to take a testimony deposition of a representative of Overtsock.com on the topics set forth in the subpoena.

6. Among the topics specified in the subpoena were: “Overstock.com's business methods of collecting and retaining customer inquiries” and “Evidence of customer confusion between Bodipedic products and Tempur-Pedic products.”

7. The deposition of the corporate representative produced by Overstock.com provided information regarding the steps taken by Overstock.com to query its internal database for purposes of generating the “log” report it produced, and general information about the three methods by which customer communication information is collected in an internal database by Overstock.com. However, the deponent produced by Overstock.com was not able to testify with particularity regarding the exact methods used to collect customer inquiries or about evidence of actual confusion among consumers of products purchased from deponent, which topics were identified in the issued subpoena.

8. It was only after the deposition of the representative of Overstock.com on December 17, 2013, that Petitioner had an understanding of how the Overstock.com customer service information was collected and the significance of the individuals referenced in the documents produced by Overstock.com in response to the subpoena. However, this testimony was arguably insufficient to provide the necessary foundation to authenticate the comments included in the customer service log.

9. Because the testimony period remained open, I immediately attempted to contact Ms. Martin, including those within my supervision, to determine Ms. Martin’s availability and sought the necessary amendment from the Board to include her as a witness in Petitioner’s pretrial disclosures.

10. I was unable to reach Ms. Martin until December 31, 2013, when Ms. Martin contacted the offices of counsel for Petitioner by phone about her availability. Prior to this contact, I was unable to determine whether the contact information for Ms. Martin was valid.

11. Ms. Martin advised that she was available for a deposition on January 10, 2014, a date within the testimony period.

12. Though it was just fourteen days before Petitioner's testimony period closed, Petitioner disclosed the identity of Ms. Martin as a witness as soon as was reasonably practicable.

13. Petitioner was in no way attempting to skirt its pretrial obligations, nor was Petitioner seeking to "hide the ball."

14. Petitioner was not attempting to act in a deceitful or obstructive manner by disclosing Ms. Martin as a witness on January 3, 2014.

15. Petitioner seeks leave to supplement its Pretrial Disclosures in good faith.

I hereby declare that the foregoing statements made by me are true. I am aware that if any of the foregoing statements made by me are willfully false, I am subject to punishment.

Executed this 13th day of January, 2014, in Louisville, Kentucky.



Amy Sullivan Cahill

UNITED STATES DISTRICT COURT

for the
District of Utah

DAN FOAM APS

Plaintiff

v.

SLEEP INNOVATIONS, INC.

Defendant

US Patent and Trademark Office
Civil Action No. Trademark Trial and Appeal Board
Cancellation No. 92054201

(If the action is pending in another district, state where:
Trademark Trial and Appeal Board)

SUBPOENA TO TESTIFY AT A DEPOSITION IN A CIVIL ACTION

To: Overstock.com, Inc., Attention: Krysta Pecharich, 6350 South 3000 East, Salt Lake City, Utah 84121

Testimony: **YOU ARE COMMANDED** to appear at the time, date, and place set forth below to testify at a deposition to be taken in this civil action. If you are an organization that is *not* a party in this case, you must designate one or more officers, directors, or managing agents, or designate other persons who consent to testify on your behalf about the following matters, or those set forth in an attachment: See Exhibit A, which is attached.

Place: Offices of Overstock.com, Inc. 6350 South 3000 East Salt Lake City, Utah 84121	Date and Time: December 17, 2013, 9:30 am MT
---	---

The deposition will be recorded by this method: Stenographically

Production: You, or your representatives, must also bring with you to the deposition the following documents, electronically stored information, or objects, and permit their inspection, copying, testing, or sampling of the material:

Results of a search of all customer inquiries directed to any Bodipedic product including the term "TEMPUR", "TEMPER," "TEMPUR-PEDIC," or "TEMPURPEDIC" between April 2, 2008 and November 22, 2013.

The provisions of Fed. R. Civ. P. 45(c), relating to your protection as a person subject to a subpoena, and Rule 45 (d) and (e), relating to your duty to respond to this subpoena and the potential consequences of not doing so, are attached.

Date: 12/9/13

CLERK OF COURT

OR

Man-Elise Laube

Signature of Clerk or Deputy Clerk

Attorney's signature

The name, address, e-mail, and telephone number of the attorney representing (*name of party*) DAN FOAM APS, who issues or requests this subpoena, are:

Amy S. Cahill, Stites & Harbison, PLLC, 400 West Market Street, Suite 1800, Louisville, Kentucky 40202;
acahill@stites.com; (502) 681-0597

Civil Action No. US Patent and Trademark Office
Trademark Trial and Appeal Board
Cancellation No. 92054201 **PROOF OF SERVICE**

(This section should not be filed with the court unless required by Fed. R. Civ. P. 45.)

This subpoena for *(name of individual and title, if any)* _____
was received by me on *(date)* _____.

I served the subpoena by delivering a copy to the named individual as follows: _____

_____ on *(date)* _____; or

I returned the subpoena unexecuted because: _____

Unless the subpoena was issued on behalf of the United States, or one of its officers or agents, I have also
tendered to the witness fees for one day's attendance, and the mileage allowed by law, in the amount of
\$ _____.

My fees are \$ _____ for travel and \$ _____ for services, for a total of \$ 0.00.

I declare under penalty of perjury that this information is true.

Date: _____

Server's signature

Printed name and title

Server's address

Additional information regarding attempted service, etc:

Federal Rule of Civil Procedure 45 (c), (d), and (e) (Effective 12/1/07)

(c) Protecting a Person Subject to a Subpoena.

(1) *Avoiding Undue Burden or Expense; Sanctions.* A party or attorney responsible for issuing and serving a subpoena must take reasonable steps to avoid imposing undue burden or expense on a person subject to the subpoena. The issuing court must enforce this duty and impose an appropriate sanction — which may include lost earnings and reasonable attorney’s fees — on a party or attorney who fails to comply.

(2) *Command to Produce Materials or Permit Inspection.*

(A) *Appearance Not Required.* A person commanded to produce documents, electronically stored information, or tangible things, or to permit the inspection of premises, need not appear in person at the place of production or inspection unless also commanded to appear for a deposition, hearing, or trial.

(B) *Objections.* A person commanded to produce documents or tangible things or to permit inspection may serve on the party or attorney designated in the subpoena a written objection to inspecting, copying, testing or sampling any or all of the materials or to inspecting the premises — or to producing electronically stored information in the form or forms requested. The objection must be served before the earlier of the time specified for compliance or 14 days after the subpoena is served. If an objection is made, the following rules apply:

(i) At any time, on notice to the commanded person, the serving party may move the issuing court for an order compelling production or inspection.

(ii) These acts may be required only as directed in the order, and the order must protect a person who is neither a party nor a party’s officer from significant expense resulting from compliance.

(3) *Quashing or Modifying a Subpoena.*

(A) *When Required.* On timely motion, the issuing court must quash or modify a subpoena that:

(i) fails to allow a reasonable time to comply;

(ii) requires a person who is neither a party nor a party’s officer to travel more than 100 miles from where that person resides, is employed, or regularly transacts business in person — except that, subject to Rule 45(c)(3)(B)(iii), the person may be commanded to attend a trial by traveling from any such place within the state where the trial is held;

(iii) requires disclosure of privileged or other protected matter, if no exception or waiver applies; or

(iv) subjects a person to undue burden.

(B) *When Permitted.* To protect a person subject to or affected by a subpoena, the issuing court may, on motion, quash or modify the subpoena if it requires:

(i) disclosing a trade secret or other confidential research, development, or commercial information;

(ii) disclosing an unretained expert’s opinion or information that does not describe specific occurrences in dispute and results from the expert’s study that was not requested by a party; or

(iii) a person who is neither a party nor a party’s officer to incur substantial expense to travel more than 100 miles to attend trial.

(C) *Specifying Conditions as an Alternative.* In the circumstances described in Rule 45(c)(3)(B), the court may, instead of quashing or modifying a subpoena, order appearance or production under specified conditions if the serving party:

(i) shows a substantial need for the testimony or material that cannot be otherwise met without undue hardship; and

(ii) ensures that the subpoenaed person will be reasonably compensated.

(d) Duties in Responding to a Subpoena.

(1) *Producing Documents or Electronically Stored Information.* These procedures apply to producing documents or electronically stored information:

(A) *Documents.* A person responding to a subpoena to produce documents must produce them as they are kept in the ordinary course of business or must organize and label them to correspond to the categories in the demand.

(B) *Form for Producing Electronically Stored Information Not Specified.* If a subpoena does not specify a form for producing electronically stored information, the person responding must produce it in a form or forms in which it is ordinarily maintained or in a reasonably usable form or forms.

(C) *Electronically Stored Information Produced in Only One Form.* The person responding need not produce the same electronically stored information in more than one form.

(D) *Inaccessible Electronically Stored Information.* The person responding need not provide discovery of electronically stored information from sources that the person identifies as not reasonably accessible because of undue burden or cost. On motion to compel discovery or for a protective order, the person responding must show that the information is not reasonably accessible because of undue burden or cost. If that showing is made, the court may nonetheless order discovery from such sources if the requesting party shows good cause, considering the limitations of Rule 26(b)(2)(C). The court may specify conditions for the discovery.

(2) *Claiming Privilege or Protection.*

(A) *Information Withheld.* A person withholding subpoenaed information under a claim that it is privileged or subject to protection as trial-preparation material must:

(i) expressly make the claim; and

(ii) describe the nature of the withheld documents, communications, or tangible things in a manner that, without revealing information itself privileged or protected, will enable the parties to assess the claim.

(B) *Information Produced.* If information produced in response to a subpoena is subject to a claim of privilege or of protection as trial-preparation material, the person making the claim may notify any party that received the information of the claim and the basis for it. After being notified, a party must promptly return, sequester, or destroy the specified information and any copies it has; must not use or disclose the information until the claim is resolved; must take reasonable steps to retrieve the information if the party disclosed it before being notified; and may promptly present the information to the court under seal for a determination of the claim. The person who produced the information must preserve the information until the claim is resolved.

(e) *Contempt.* The issuing court may hold in contempt a person who, having been served, fails without adequate excuse to obey the subpoena. A nonparty’s failure to obey must be excused if the subpoena purports to require the nonparty to attend or produce at a place outside the limits of Rule 45(c)(3)(A)(ii).

EXHIBIT A

DEPOSITION TOPICS

1. Overstock.com's document retention policies
2. Overstock.com's method of searching all customer inquiries directed to any Bodipedic product that include any of the following terms: "TEMPUR," "TEMPER," "TEMPUR-PEDIC," or "TEMPURPEDIC".
3. Results of the search of all customer inquiries directed to any Bodipedic product that include any of the following terms: "TEMPUR," "TEMPER," "TEMPUR-PEDIC," or "TEMPURPEDIC".
4. The method by which the results of the search for customer inquiries regarding any Bodipedic product that include any of the following terms: "TEMPUR," "TEMPER," "TEMPUR-PEDIC," or "TEMPURPEDIC" were gathered and were produced to Dan Foam APS or its representatives.
5. Overstock.com's business methods of collecting and retaining customer inquiries.
6. Evidence of customer confusion between Bodipedic products and Tempur-Pedic products.