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

wbc

Mailed: April 16, 2014

Cancellation No. 92054201

Dan Foam ApS

v.

Sleep Innovations, Inc.

Wendy Boldt Cohen, Interlocutory Attorney:

In accordance with the parties' joint motion to extend trial dates, approved by the Board in a January 8, 2014 order, the petitioner's trial period was set to end January 17, 2014 . [1]

This case now comes up on petitioner's combined motion, filed January 3, 2014, to supplement its pretrial disclosures to add Jane Martin, a nonparty and customer of Overstock.com, also a nonparty, as a trial witness pursuant to Fed. R. Civ. P. 26(e)(1)(A) and to conduct the deposition of Ms. Martin telephonically pursuant to Fed. R. Civ. P. 30(b)(4). *See also* TBMP § 703.01(h). The motion has been fully briefed. Respondent filed a combined response, filed January 8, 2014 to petitioner's motion and cross-motion to quash the deposition of Ms. Martin.[2] The cross-motion is also fully briefed.

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[1] Discovery ended September 29, 2013. *See* Board's September 10, 2013 order.
[2] Respondent also seeks a protective order and stay of the proceedings pending disposition of petitioner's motion. The request for protective order and stay of the

Motion to Supplement Pretrial Disclosures/Motion to Quash Deposition of Jane Martin

The Board reminds the parties that a duty exists under Fed. R. Civ. P. 26(e) to supplement disclosures. Petitioner must supplement or correct its disclosures in a timely manner upon learning that the disclosure is materially incomplete or incorrect. Fed. R. Civ. P. 26(e)(1)(A); *see Spier Wines (Pty) Ltd. v. Shepher,* 105 USPQ2d 1239, 1242 n.6 (TTAB 2012) (Pretrial disclosures inform the adverse party of the identity to prospective trial witness, or any witness from whom testimony might be taken, thus avoiding surprise).

Petitioner need not seek leave of the Board to supplement its pretrial disclosures because a duty to supplement them already exists. Accordingly, petitioner's motion to supplement its pretrial disclosures is moot. To the extent petitioner learns that in some material respect its disclosure is incomplete or incorrect, petitioner must supplement or correct that disclosure if it has not otherwise made the information known to respondent. Notwithstanding the foregoing, to the extent petitioner still seeks to utilize Ms. Martin as a trial witness, on or before **April 24, 2014**, petitioner shall serve revised pretrial disclosures specifying the subjects about which Ms. Martin will testify pursuant to this order, and identifying the documents each

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proceedings is moot in view of the Board's January 8, 2014 order. Indeed, respondent notes the request for protective order and stay of the proceedings is moot and has not further addressed them in its reply brief.

Respondent's entry of appearance filed and change of correspondence address, both filed January 8, 2014, are noted and made of record.

will identify and present. *See Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d 1175, 1179 (TTAB 2010). If revised pretrial disclosures are not served, it will be presumed that petitioner no longer plans to utilize Ms. Martin as a witness at trial.

In support of its motion to quash, respondent argues, *inter alia*, that the Board should preclude petitioner from taking the testimonial deposition of Ms. Martin because she was not identified in petitioner's initial disclosures; that petitioner knew about Ms. Martin as early as February 2012, while discovery was still open; that petitioner referred to Ms. Martin's interactions with Overstock.com in its motion for summary judgment filed August 2, 2012; that petitioner waited until fourteen days before the close of petitioner's testimony period, "almost a full two years after [p]etitioner received documents placing it on notice of Ms. Martin's identity … and 17 days after the deposition of Overstock.com"; that allowing Ms. Martin's testimony would be disruptive because respondent will need follow-up discovery; that petitioner has not provided a "truthful and plausible explanation for its failure to identify Ms. Martin" in its disclosures; and that it is unfairly prejudiced by the late notice of this testimonial witness because it did not have the opportunity to depose Ms. Martin during the discovery period. Respondent also requests that if petitioner is permitted to amend its pretrial disclosures and depose Ms. Martin, that discovery be reopened for the limited purpose of allowing respondent to take the discovery deposition of

Ms. Martin and any additional discovery necessary as a result of Ms. Martin's testimony.

Petitioner alleges, *inter alia*, that it was unaware of the relevance of Ms. Martin's testimony until after it deposed a representative of Overstock.com; that respondent cannot claim surprise by the disclosure of Ms. Martin because respondent "received a copy of the documents provided by Overstock.com which included Ms. Martin's name" and could have deposed Overstock.com to understand the customer references in those documents;[3] that Ms. Martin's testimony will serve as "evidence of actual confusion, which is highly probative to the issues in this case"; that the deposed representative of Overstock.com's testimony was "arguably insufficient to provide the necessary foundation to authenticate the comments included in the customer service log or shed light on instances of actual confusion"; and that it sought to supplement its pretrial disclosures "as soon as it became reasonably practicable *and before either party's testimony period closed*" (emphasis in original).

Fed. R. Civ. P. 37(c)(1) provides that a party that fails to provide information or the identity of witnesses through initial disclosures or

[3] Petitioner's contention that any prejudice to respondent from lack of prior notice was the result of its failure to depose Overstock.com is unavailing. "[T]he parties' obligations to serve initial, expert and pretrial disclosures are independent requirements of the Trademark Rules." *Spier Wines*, 105 USPQ2d at 1243 (*citing Jules Jurgensen/Rhapsody, Inc. v. Baumberger*, 91 USPQ2d 1443, 1445 (TTAB 2009)). The better practice would have been to name all potential witnesses, even if they are not called or their anticipated testimony may be duplicative of another witness' testimony.

discovery 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." *See Spier Wines,* 105 USPQ2d at 1242; *Great Seats, Inc. v. Great Seats, Ltd.,* 100 USPQ2d 1323, 1326-27 (TTAB 2011). To determine whether applicant's failure to identify Ms. Martin in its initial disclosures or discovery responses was "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) [the] importance of the evidence; and
> (5) the non-disclosing party's explanation for its failure to disclose the evidence.

See Sheetz of Del., Inc. v. Doctor's Assocs. Inc., 108 USPQ2d 1341, 1345 (TTAB 2013) *(quoting Great Seats,* 100 USPQ2d at 1327); *see also Spier Wines,* 105 USPQ2d at 1242.

Applying the *Great Seats* factors to Ms. Martin, the record shows, and respondent notes, that petitioner filed a motion for summary judgment in which it relied on evidence from Overstock.com[4] which references interactions with Overstock.com customers, which includes Ms. Martin. Under these circumstances, it does not appear that respondent can convincingly argue that it was surprised that petitioner is now seeking to

[4] Petitioenr alleges that on February 10, 2012, in response to a subpoena from petitioner, Overstock.com produced a log of consumer service communications, which referenced Jane Martin. The deposition of the Overstock.com representative purportedly occurred December 17, 2013.

take testimony from Ms. Martin. *Cf. Sheetz of Del.,* 108 USPQ2d at 1346. Accordingly, there is no surprise to cure and this factor weighs in favor of petitioner. *Id.*

Regarding the extent to which Ms. Martin's testimony would disrupt trial, petitioner's failure to disclose Ms. Martin earlier has indeed been disruptive to these proceedings. This factor weighs in favor of respondent.

In determining the importance of the evidence or testimony to the fair adjudication of the proceedings, the Board will consider various factors, including whether the testimony is cumulative or if the evidence can be introduced by other means, and whether the proposed testimony would be admissible. *Spier Wines*, 105 USPQ2d at 1244 (*citing Byer California v. Clothing for Modern Time Ltd.*, 95 USPQ2d 1175, 1179 (TTAB 2010)). In this proceeding, petitioner alleges that Ms. Martin's testimony will serve as evidence of actual confusion and there is no evidence on record that evidence of actual confusion has already been introduced or that it can be introduced by other means. It also appears that Ms. Martin's testimony would be otherwise admissible as it goes to the central issue in this case, likelihood of confusion. This factor favors petitioner.

With regard to petitioner's explanation for its failure to name Ms. Martin, petitioner argues, as discussed above, that its deposition of the Overstock.com representative was inadequate and it was not aware of the relevance of Ms. Martin's testimony until after the Overstock.com

representative's deposition. The Board, in its May 13, 2013 order, warned petitioner that the documents from Overstock.com were of "little probative value in the absence of testimony from the customers themselves…" Petitioner should have had a trial plan in place prior to the testimony of the Overstock.com representative which presumably, would have included testimony from other witnesses. *See Great Seats Inc.*, 100 USPQ2d 1328. This factor weighs in favor of respondent.

On balance, the Board finds petitioner's failure to previously name Ms. Martin as a trial witness as harmless. In view of the foregoing and subject to the limitations discussed below, respondent's motion to quash the testimony of Ms. Martin is **denied**.

Respondent further moved to reopen discovery, if its motion to quash was denied, to allow respondent to schedule and conduct a discovery deposition of Ms. Martin. would disrupt these proceedings. The motion to reopen discovery is **denied** in view of the Board's order herein. Fairness dictates a compromise approach to protect both parties' interests. *See Byer California,* 95 USPQ2d at 1179. Accordingly, petitioner may depose Ms. Martin only to the extent necessary to provide a proper foundation to introduce the Overstock.com documents into evidence and to testify as to whether she was confused and if so, what caused her confusion.

Motion to Conduct Deposition Telephonically

Petitioner seeks to depose Ms. Martin by telephone pursuant to Fed. R. Civ. P. 30(b)(4). *See* TBMP § 703.01(h). Petitioner argues that because Ms. Martin lives in Arizona, counsel for petitioner resides in Kentucky and counsel for respondent resides in New Jersey, travel would be burdensome such that a telephonic deposition is appropriate. Inasmuch as respondent does not contest this motion, the motion is hereby **granted** as conceded. The deposition of Ms. Martin may be taken telephonically pursuant to Fed. R. Civ. P. 30(b)(4); *see Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1654 (TTAB 2007); *Hewlett Packard Co. v. Healthcare Personnel Inc.*, 21 USPQ2d 1552, 1552-53 (TTAB 1991).

Proceedings are resumed. The Board treats the filing of petitioner's January 3, 2014 motion as tolling the dates. Dates are reset as follows:

Petitioner's Revised Pretrial Disclosures, if any	**4/24/2014**
Plaintiff's 30-day Trial Period Ends	**5/1/2014**
Defendant's Pretrial Disclosures	**5/16/2014**
Defendant's 30-day Trial Period Ends	**6/30/2014**
Plaintiff's Rebuttal Disclosures	**7/15/2014**
Plaintiff's 15-day Rebuttal Period Ends	**8/14/2014**

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. Trademark Rule 2.l25. Briefs shall be filed in accordance with Trademark Rules 2.l28(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.