

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

Mailed: July 31, 2013

Cancellation No. 92054629

Sheltered Wings, Inc.

v.

Wohali Outdoors, LLC

**George C. Pologeorgis,  
Interlocutory Attorney:**

This case now comes before the Board for consideration of respondent's construed motion (filed May 17, 2013) to limit the scope of testimony to be provided by a trial witness identified in petitioner's pretrial disclosures, namely, Mr. Ben Lizdas. The motion is fully briefed.

The Board, in its discretion, suggested that the issues raised in respondent's construed motion should be resolved by telephonic conference as permitted by TBMP § 502.06 (3d ed. rev. 2 2013). The Board contacted the parties to discuss the date and time for holding the phone conference.

The parties agreed to hold a telephone conference at 3:00 p.m. EDT, on Friday, July 26, 2013. The conference was held as scheduled among Jennifer L Gregor, as counsel for petitioner, S. Max Harris, as counsel for respondent, and George C. Pologeorgis, as a Board attorney responsible for resolving interlocutory matters in this proceeding.

The Board carefully considered the arguments raised by the parties during the telephone conference, as well as the supporting correspondence and the record of this case, in coming to a determination regarding the above matters. During the telephone conference, the Board made the following findings and determinations:

**Respondent's Construed Motion to Limit the Trial Testimony of  
Mr. Ben Lizdas**

For the reasons discussed below, respondent's construed motion to limit the testimony of Mr. Lizdas is **DENIED**.

As background, on March 5, 2012, petitioner served its initial disclosures on respondent. Mr. Ben Lizdas, petitioner's sales manager, was not identified as a person with discoverable information in petitioner's initial disclosures. On August 24, 2012, petitioner filed its response to respondent's motion for summary judgment.<sup>1</sup> In support of its response, petitioner submitted the declaration of Mr. Lizdas, among others. Mr. Lizdas' declaration concerned issues regarding petitioner's marketing and advertising efforts. Additionally, in his declaration, Mr. Lizdas specifically declared that he had personal knowledge of the facts in his declaration and, if called upon, could and would testify to those facts.

On December 10, 2012, petitioner served its responses to respondent's first set of interrogatories. In response to respondent's Interrogatory No. 18,

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<sup>1</sup> By order dated November 8, 2012, the Board denied respondent's motion for summary judgment.

(which requested the identification of any witnesses petitioner intended to use at trial), petitioner only lodged objections to the interrogatory, including the objection that the request is premature since discovery is ongoing. On January 15, 2013, petitioner served supplemental responses to respondent's written discovery but did not supplement its response to Interrogatory No. 18.

On May 3, 2013, petitioner timely served its pretrial disclosures on respondent, and listed Mr. Lizdas, among others, as a witness to provide testimony concerning (1) petitioner's advertising and promotion activities, (2) use of petitioner's EAGLE marks, (3) goods sold and offered under the EAGLE marks, (3) notoriety of petitioner's pleaded marks, (4) similarity of the parties' respective marks, (5) strength of petitioner's pleaded marks, (6) geographic scope and channels of trade, (7) level of consumer sophistication, (8) likelihood of confusion and actual confusion, and (9) that Mr. Lizdas may be used to identify certain documents.

We now turn to respondent's construed motion under consideration herein. In support thereof, respondent argues that since petitioner (1) did not identify Mr. Lizdas in its initial disclosures, (2) did not supplement its initial disclosures to identify Mr. Lizdas as a person with discoverable information prior to the close of discovery, and (3) did not identify Mr. Lizdas in response (or in any supplemental response) to respondent's interrogatory request seeking the identity of potential trial witnesses, Mr. Lizdas' testimony, if offered, should be limited to the narrow scope of his declaration

submitted in support of petitioner's response to respondent's motion for summary judgment. Respondent further contends that to allow Mr. Lizdas to provide testimony beyond the matters addressed in his declaration would unfairly prejudice respondent and would only reward petitioner for its failure to disclose properly Mr. Lizdas as a potential witness.

In response, petitioner maintains that respondent's motion should be denied because respondent has known about Mr. Lizdas' role as a potential witness since August 2012 (the time in which the declaration of Mr. Lizdas was submitted in support of petitioner's response to respondent's motion for summary judgment) – approximately seven months before the close of discovery in this matter. Petitioner further maintains that because respondent had ample knowledge of Mr. Lizdas and ample opportunity to depose or otherwise take discovery concerning Mr. Lizdas, respondent cannot now complain that Mr. Lizdas was not identified in petitioner's initial disclosures. Accordingly, petitioner contends that it should not be penalized for respondent's failure to take discovery that it apparently now wished it would have taken. Petitioner also argues that it was under no obligation to provide supplemental or corrective information with regard to its initial disclosures since Mr. Lizdas was made known to respondent in writing vis-à-vis his declaration submitted in connection with petitioner's response to respondent's motion for summary judgment.

## Analysis

Initial disclosures, discovery responses and pretrial disclosures should be viewed as a continuum of *inter partes* communication designed to avoid unfair surprise and to facilitate fair adjudication of the case on the merits. *Speir Wines (PTY) Ltd. v. Sheper*, 105 USPQ2d 1239, 1246 (TTAB 2012). In identifying individuals through initial disclosures, a party need not identify all those that may potentially be called as “trial witnesses,” but instead must identify any trial witnesses through pretrial disclosures.<sup>2</sup> However, because individuals identified through initial disclosures have knowledge that the disclosing party may use to support its claims or defenses, the persons identified in initial disclosures may reasonably be viewed as possible trial witnesses. *Jules Jurgensen/Rhapsody, Inc. v. Baumberger*, 91 USPQ2d 1443, 1443 n.1 (TTAB 2009). *Cf. Great Seats, Inc. v. Great Seats, Ltd.*, 100 USPQ2d 1323, 1326 n.5 (TTAB 2011) (“If the identity of the witness is known when initial disclosures are made, and the relevant knowledge of the witness is known, then a party may have to disclose the identity of the witness when making initial disclosures, even if the party has no plans at that time to rely on testimony from the witness.”). Additionally, the Board has stated that, unless seasonably remedied, a party's failure to identify a witness in its

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<sup>2</sup> 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).

initial disclosures deprives the adverse party of the opportunity to seek discovery of the identified witness, and this fact “must [be] consider[ed] ... as one of the relevant circumstances ... in determining whether to strike [the witness's] testimony deposition.” *Jules Jurgensen*, 91 USPQ2d at 1444-45.

In opposition and cancellation proceedings commenced after November 1, 2007, a party generally is required, in its pretrial disclosures, to name the witnesses it expects will testify, or may testify if the need arises, by oral testimony or, as provided for in this case, by declaration, and must provide general identifying information about the witness(es). *See* 37 CFR § 2.121(e). However, a party is **not required** to supplement or correct its initial disclosures to provide identifying information about a witness listed in pretrial disclosures if that information previously has been made known to the other party **in writing** or during the discovery process. *See Galaxy Metal Gear Inc. v. Direct Access Technology Inc.*, 91 USPQ2d 1859, 1861 (TTAB 2009) (opposer’s failure to supplement its initial disclosures to identify foreign nonparty witness as a potential witness does not preclude introduction of 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). *See* TBMP § 408.03 (3d ed. rev. 2 2013).

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 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.” To determine whether petitioner’s failure to disclose the witness in question in its initial disclosures, in any supplemental initial disclosures, or in its response or supplemental response to respondent’s interrogatories 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 at 1327.

Four of the above-identified factors – surprise to the opposing party, ability to cure the surprise, disruption of the trial, and importance of evidence—relate mainly to the harmless exception, while the remaining factor – explanation for the nondisclosure—relates primarily to the

substantial justification exception. *Southern States Rack & Fixture, Inc. v. Sherwin-Williams Co.*, 318 F.3d 592, 597 (4<sup>th</sup> Cir. 2003).

We now turn to the application of these factors. We begin with the fifth factor, namely, the explanation for the nondisclosure. As stated above, petitioner maintains that it was under no obligation to provide supplemental or corrective information with regard to its initial disclosures since Mr. Lizdas was made known to respondent in writing vis-à-vis his declaration submitted in connection with petitioner's response to respondent's motion for summary judgment. Petitioner further maintains that respondent's complaint that petitioner should have identified Mr. Lizdas in response to respondent's Interrogatory No. 18 is unfounded inasmuch as that interrogatory prematurely sought petitioner's pretrial disclosures, to which petitioner contends it appropriately objected. Petitioner also contends that respondent never challenged petitioner's objection nor did respondent seek to compel a response.

The Board finds petitioner's arguments unpersuasive. While we recognize that respondent obtained knowledge of Mr. Lizdas at the time his declaration was submitted in support of petitioner's response to respondent's motion for summary judgment, the better practice would have been for petitioner to supplement its initial disclosures once petitioner confirmed that Mr. Lizdas had discoverable information regarding petitioner's asserted claims. As noted above, initial disclosures, discovery responses and pretrial

disclosures should be viewed as a continuum of *inter partes* communication designed to avoid unfair surprise and to facilitate fair adjudication of the case on the merits. In the spirit of cooperation with the disclosure process, petitioner should have supplemented its initial disclosures to identify Mr. Lizdas. Moreover, petitioner's objections to respondent's Interrogatory No. 18 are without merit. The identity of potential trial witnesses is clearly discoverable matter in Board proceedings. See TBMP § 414(7) (3d ed. rev. 2 2013). Based upon the record, it is plausible that petitioner intended to call Mr. Lizdas as a witness during petitioner's testimony period, particularly since petitioner made the tactical decision to submit the declaration of Mr. Lizdas in response to respondent's motion for summary judgment and because Mr. Lizdas stated in his declaration that he had personal knowledge of the facts in his declaration and, if called upon, could and would testify to those facts. Accordingly, petitioner had a duty to supplement its response to Interrogatory No. 18 to identify Mr. Lizdas as a potential witness, even if petitioner never actually called upon Mr. Lizdas to testify during petitioner's testimony period.<sup>3</sup> The reasons for petitioner's failure to do so, however, are not justified.

Based upon the explanation (or lack thereof) provided by petitioner, the Board finds that petitioner's failure to supplement its initial disclosures or response to respondent's Interrogatory Request No. 18 so as to identify Mr.

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<sup>3</sup> See generally TBMP § 408.03 (3d ed. rev. 2 2013).

Lizdas as a potential trial witness and/or a person with discoverable information is not substantially justified.

We next turn to the remaining factors to ascertain whether petitioner's nondisclosure is harmless. As to the first factor, the surprise element, we note that, although petitioner did not originally identify Mr. Lizdas in its initial disclosures nor did it supplement its initial disclosures to include Mr. Lizdas when it became abundantly clear that Mr. Lizdas had discoverable information, respondent nonetheless had knowledge that Mr. Lizdas may be called upon as a potential witness when he declared in his declaration that "if called upon, I could and would testify to these facts." While Mr. Lizdas' declaration was limited to petitioner's marketing and advertising activities, although not a certainty, it is plausible that Mr. Lizdas, as petitioner's sales manager, would possess knowledge regarding petitioner's marks and associated goods and services above and beyond the subject matter of his declaration, including use of the marks, channels of trade, etc. In view thereof and inasmuch respondent had knowledge regarding Mr. Lizdas prior to the close of discovery in this case, respondent had ample opportunity to depose or otherwise take discovery concerning Mr. Lizdas, but respondent chose not to do so. Further, if respondent was unsatisfied with petitioner's failure to respond properly to its Interrogatory No. 18, under the Board's rules it was incumbent upon respondent to file a motion to compel. Having failed to do so in this instance, respondent cannot now be heard to complain

that petitioner's response to Interrogatory No. 18 was inadequate, *see Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1656 (TTAB 2002), and thereby causing any surprise to respondent that Mr. Lizdas may be called as a trial witness to testify on the matters identified in petitioner's pretrial disclosures. In view of the foregoing, we find that there was no reasonable surprise of the possibility of Mr. Lizdas being called as a trial witness on behalf of petitioner and for Mr. Lizdas to testify on matters beyond those set forth in his declaration.<sup>4</sup>

As to the second factor, the Board finds that since there was no reasonable surprise that Mr. Lizdas may testify to matters beyond those specifically identified in his declaration, there is nothing to cure. This factor weighs in favor of petitioner.

In regard to the third factor, i.e., disruption of trial, the Board finds that the trial has not been disrupted inasmuch as petitioner's testimony period has yet to commence. This factor also weighs in favor of petitioner.

And as to the fourth factor, namely, the importance of the evidence, the Board notes that it does not review evidence prior to final decision. However, petitioner's need for Mr. Lizdas' testimony above and beyond the issues specifically addressed in his declaration may be important to the extent that petitioner carries the burden of proof in this case. Therefore, we find this factor to favor petitioner.

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<sup>4</sup> The Board notes that respondent will have the opportunity to cross-examine Mr. Lizdas if he is called as a witness during petitioner's testimony period.

After considering all of these factors, that Board finds, on balance, that although petitioner's failure to disclose Mr. Lizdas in its initial disclosures, in any supplemental initial disclosures, or in its response or supplemental response to respondent's Interrogatory Request No. 18 is not substantially justified, petitioner's non-disclosure is nonetheless harmless.

In view thereof, respondent's construed motion to limit the potential testimony of Mr. Lizdas to the issues solely addressed in his declaration in support of petitioner's response to respondent's motion for summary judgment is **DENIED**.

**Trial Schedule**

Proceedings are resumed. Discovery is closed. Trial dates, beginning with the close of petitioner's testimony period, are reset as follows:

Plaintiff's 30-day Trial Period Ends	<b>9/30/2013</b>
Defendant's Pretrial Disclosures Due	<b>10/15/2013</b>
Defendant's 30-day Trial Period Ends	<b>11/29/2013</b>
Plaintiff's Rebuttal Disclosures Due	<b>12/14/2013</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>1/13/2014</b>

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 2.125.

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