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

Mailed: June 9, 2005

Opposition No. 91153915
Opposition No. 91155119

CONVERSE INC.

v.

COLEY, KISCHENNA L.

David Mermelstein, Attorney:

This matter now comes up on opposer's motions to exclude testimony and to quash applicant's notices of testimonial depositions. Opposer has requested that the Board resolve its motions by telephone conference. On June 6, 2005, the Board held a telephone conference. Participating were Matthew Himich for opposer, Eslanda Dasher for applicant, and the above Board attorney.

Background

The essential facts are not disputed. During discovery, opposer propounded the following interrogatories (among others):

> 7. Identify each person whose testimony Applicant intends to offer as evidence during this proceeding either at trial or by deposition.
>
> 8. Identify each person who has knowledge relevant to this proceeding as defined in Fed. R. Civ. P. 26(b)(1). [emphasis in original]
>
> 20. Identify all persons Applicant may call as an expert to testify in these proceedings and identify the

> field of specialization, if any, of each expert, the subject matter on which each such expert may testify, the opinions held by each such expert regarding such subject matter, the basis and reason of such opinions, the facts known and information used to form such opinions, the qualifications of such expert, the compensation such expert has or will be paid in regard to these proceedings, any other cases or proceeding in which the expert has testified as an expert at trial or by deposition during the past four years, and all other information listed in Fed. R. Civ. P. 26(a)(2)(B).[1]

In response to interrogatories 7 and 20, applicant originally responded that the information was "[u]nknown at this time but subject to change." Applicant added that it would supplement its responses should answers become known. Applicant's response to Interrogatory 8 was "Kischenna L. Coley, Joann D. Coley and Linwood D. Coley."

Pursuant to the trial schedule, discovery closed on December 20, 2004. After a further extension,[2] opposer's thirty-day trial period was set to close on April 19, 2005, thus opening on March 20, 2005. On March 14, 2005, applicant served upon opposer supplemental responses to interrogatories 7 and 20. Applicant's supplemental responses designated several fact and expert witnesses it may call at trial, and provided the report of the designated experts.

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[1] Fed. R. Civ. P. 26(a)(2)(B) is not applicable to Board proceedings. *See* TBMP § 401 (2d ed. rev. 2004).
[2] The parties disagreed as to the reason for the consent motion to extend testimony periods, filed February 18, 2005. It is clear from the motion itself, as well as the e-mail exchange between counsel (which was submitted by applicant) that the parties were still resolving at least some discovery issues, thus necessitating a postponement of trial.

Opposer proceeded with its trial period, filing a notice of reliance on March 24, 2005. Then, on April 19 – the last day of opposer's trial period – opposer filed a motion to exclude the testimony of applicant's late-disclosed expert and lay witnesses. Opposer argued that the witnesses were not timely disclosed in response to opposer's interrogatories and their testimony, if offered, should therefore be excluded.

In connection with its trial period, applicant noticed the testimonial depositions of the expert and lay witnesses disclosed in its March 14 supplemental discovery responses, whereupon opposer contacted the Board seeking to quash the notices and for a telephone conference to decide the matter. For its motion to quash, opposer essentially relies on the arguments set out in its motion to exclude.

Pending resolution of opposer's motion, the parties agreed to postpone the testimonial depositions of applicant's witnesses.

Discussion

As a preliminary matter, we note that opposer's motion to exclude is essentially a motion *in limine*, which the Board does not typically entertain. *Greenhouse Systems Inc. v. Carson*, 37 USPQ2d 1748, 1750 (TTAB 1995)("It is not the Board's practice to make prospective or hypothetical evidentiary rulings such as those requested by applicant,

nor will the Board undertake to screen all of opposer's proffered evidence to see whether it might fall within one of applicant's suggested categories of excludable evidence.”). Nonetheless, given applicant’s notices of deposition of the witnesses in question, the matter is no longer a hypothetical question, and we consider the motion now ripe for consideration.

Turning to the interrogatories in question, it is clear that opposer has received at least as much as it is entitled to with respect to interrogatories 7 and 8, even without applicant’s supplemental response. Interrogatory 7 calls for the disclosure of fact witnesses, which is not required in Board cases. *See* TBMP § 414(7) (2d ed. rev. 2004), and cases cited therein (“A party need not, in advance of trial, specify in detail the evidence it intends to present, or identify the witnesses it intends to call, except that the names of expert witnesses intended to be called are discoverable.”).

Further, while applicant partially responded to interrogatory 8, that interrogatory is extremely broad, and requires the applicant to make the legal determination of what information is relevant to this proceeding. While applicant’s response to this interrogatory may have been somewhat wanting in retrospect, it is not entirely clear what information opposer was seeking. It is not the job of

the responding party in discovery to both formulate the questions and answer them.

The gravamen of opposer's motions is apparently that it has been denied discovery with respect to applicant's witnesses because they were not disclosed until after the close of discovery.[3] Opposer's actions, however, indicate a different motivation. Applicant's supplemental discovery was served prior to the opening of opposer's testimony period. (The copy opposer attached to its motion to exclude bears a date stamp from opposer's office of March 18, 2005.) But instead of seeking a reopening of discovery to depose the new witnesses (and a telephone conference for the immediate resolution of the motion), opposer proceeded with its testimony period. Indeed, opposer did not respond in any way to applicant's late disclosure until it filed its motion to exclude on the last day of its own testimony period, more than thirty days after applicant's supplemental response.

Clearly, any prejudice opposer may suffer by applicant's recent supplemental discovery responses could have been mitigated or eliminated by a reopening of

[3] Applicant argued that its late disclosure was occasioned by opposer's late disclosure of responses to discovery propounded by applicant. Applicant explained that, with meager financial resources, it could not afford to engage in extensive planning for trial until it received opposer's full discovery responses. We need not decide this issue, however, because it is tangential to the matter at hand. We repeat, however, that it is clear that

discovery – had it been immediately sought. In response to the Board's questioning on this point, opposer's counsel responded that he did not believe that the Board would grant such a request. On the contrary, the Board is generally liberal in granting extensions and even the reopening of discovery when appropriate, and there is no indication in this file that the Board would have been unwilling to do so in this case.[4]

By proceeding with its testimony period instead of seeking immediate resolution of this matter and any discovery to which it may have been entitled, opposer elected to take its chances with its motion to exclude and to simultaneously make it considerably more burdensome to reopen discovery.[5]

We are not unsympathetic to opposer's complaint that applicant's supplemental discovery responses should have been served earlier. However, because opposer did not

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the parties were engaged in some further exchanges of discovery after the close of discovery. *See* supra note 2.

[4] There is, of course, no guarantee that discovery would have been reopened had opposer sought such relief. However, if the Board had found reopening to be inappropriate because applicant's supplemental discovery requests were untimely (and the lateness was not the result of excusable neglect), opposer would have been virtually assured of prevailing on a motion to quash any attempt to take the testimony of the witnesses at issue.

[5] Prior to the opening of opposer's trial period, discovery could have briefly been reopened for the purpose of taking any necessary depositions with a delay of a few weeks at most. Now that opposer's testimony period has opened (and closed), it would be necessary to repeat that period, as well, delaying resolution of this matter by several months.

timely seek to remedy or mitigate its alleged prejudice, opposer has waived its complaint.

Opposer's motion to quash is accordingly DENIED.[6]

Dates Reset

Proceedings are RESUMED. Trial dates are reset as follows:

DISCOVERY PERIOD TO CLOSE:	**CLOSED**
Thirty-day testimony period for party in position of plaintiff to close:	**CLOSED**
Thirty-day testimony period for party in position of defendant to close:	**August 12, 2005**
Fifteen-day rebuttal testimony period to close:	**September 26, 2005**

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 Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.

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[6] Needless to say, since the date originally set for the testimonial depositions in quesstion has passed, opposer must provide opposer notice of the rescheduled depositions. *See* Trademark Rule 2.123(c).