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Filing date: **03/13/2009**

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

Proceeding	91168033
Party	Plaintiff UBS AG
Correspondence Address	Patrick J. Jennings Pillsbury Winthrop Shaw Pittman LLP 1650 Tysons Blvd. McLean, VA 22102 UNITED STATES kevin.kramer@pillsburylaw.com
Submission	Motion to Strike
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Signature	/Stephanie F. Goeller/
Date	03/13/2009
Attachments	Motion to Strike.pdf ( 23 pages )(374688 bytes )

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

UBS AG,	)	
	)	
	)	
Opposer,	)	Opposition No. 91168033
	)	
v.	)	
	)	Application Ser. No. 78/524,329
	)	
United Bankers' Bank,	)	
	)	
Applicant.	)	
	)	

**OPPOSER UBS AG'S MOTION TO STRIKE PORTIONS OF APPLICANT'S  
SECOND AND THIRD NOTICES OF RELIANCE AND PORTIONS OF CASSIE  
ORLOSKE AND CHARLES HOKANS' TESTIMONY DEPOSITIONS**

Kevin T. Kramer  
Patrick J. Jennings  
Stephanie F. Goeller  
PILLSBURY WINTHROP  
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Washington, D.C. 20037  
Tel. (202) 663-8000

Date: March 13, 2009

*Attorneys for Opposer  
UBS AG*

Opposer UBS AG (“Opposer”) hereby moves the Trademark Trial and Appeal Board (“Board”) for an order striking portions of Applicant United Bankers’ Bank’s (“Applicant’s”) Second and Third Notices of Reliance which improperly rely upon discovery deposition testimony of Opposer’s employees testifying in their individual capacity. Opposer also moves to strike portions of Applicant’s Third Notice attempting to rely upon discovery deposition testimony that was later retaken after the Board compelled Applicant to produce the documents it had attempted to surprise the witness with at the initial deposition. Further, portions of the testimony depositions of Applicant’s witnesses Cassie Orloske and Charles Hokans should be stricken to the extent such testimony was given with regard to exhibits never produced by Applicant to Opposer in this proceeding.

Because the proffered testimony is procedurally improper, and because Opposer will also be unfairly prejudiced if the testimony is admitted, Opposer respectfully moves to strike.

While Opposer believes that Applicant cannot cure these defects, Opposer files this motion in a timely manner. Opposer reserves all rights to raise additional objections to this testimony in its brief on the case.

## **I. BRIEF STATEMENT OF RELEVANT FACTS**

Discovery in this proceeding opened on January 4, 2006. Applicant noticed the discovery deposition of a 30(b)(6) representative of Opposer for 13 topics on September 19, 2007. Opposer served its objections and responses to Applicant’s notice on September 24, 2007, and designated Markus Straessle, William Gaine, and Nadine Genet to testify with regard to specific topics. *See* Third Notice, Ex. 2. On September 28, 2007, Applicant took the discovery deposition of UBS AG’s employee Markus Straessle. The discovery deposition of UBS AG employees William Gaine and Nadine Genet were taken on October 2, 2007.

At Ms. Genet's deposition, Applicant attempted to question her regarding documents concerning third-party marks not previously produced to Opposer. Counsel for Opposer instructed Ms. Genet not to answer on the grounds that such tactics were unfairly prejudicial. Both parties raised this issue in motions to compel discovery and the Board held a telephonic hearing on the issue on December 12, 2007. On December 21, 2007, in resolution of this discovery dispute, the Board ruled that Applicant must produce the documents relating to third-party marks to Opposer, and that Opposer must make the witness available for a second deposition to respond to those questions not answered at the first deposition. The parties agreed to substitute Neil Gluckin for Ms. Genet in this second deposition. Applicant took Mr. Gluckin's discovery deposition on February 29, 2008.

Discovery in this proceeding closed on April 30, 2008. Subsequently, during its testimony period, Applicant took the testimony deposition of its two witnesses—Cassie Orloske and Charles Hokans—on January 7, 2009. At those depositions, Applicant questioned the witnesses regarding documents not produced to Opposer. Applicant further submitted three notices of reliance on February 2, 2009. Applicant's Second Notice of Reliance ("Second Notice") attaches portions of the discovery depositions of Neil Gluckin and William Gaine and exhibits. Applicant's Third Notice of Reliance ("Third Notice") attaches portions of the discovery depositions of Markus Straessle and Nadine Genet and exhibits.

Plaintiff's rebuttal testimony period is scheduled to close on March 18, 2009.

## **II. ARGUMENT**

### **A. The Board Should Strike Discovery Deposition Testimony Given in Opposer's Witnesses' Individual Capacity**

Pursuant to 37 C.F.R. 2.120(j) and TBMP § 704.09, an adverse party may offer into evidence "[t]he discovery deposition of a party or of anyone who at the time of taking the

deposition was an officer, director or managing agent of a party, or a person designated by a party pursuant to Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure.” In contravention of these regulations, Applicant has submitted discovery deposition testimony of UBS AG witnesses given in the witnesses’ individual capacities and outside the scope of topics for which they were designated as corporate representatives pursuant to Federal Rule of Civil Procedure 30(b)(6).

**1. Applicant Improperly Relies Upon Mr. Gaine’s Personal Discovery Deposition**

In its Second Notice, Applicant purports to rely upon portions of William Gaine’s discovery deposition as relevant to Opposer’s knowledge of Applicant’s mark and Opposer’s history of doing business with Applicant. *See* Second Notice, Ex. 12, Gaine Discovery Depo. Tr., pp. 1-9:11; 16:10-19:15. These very pages, however, demonstrate that this testimony was given in Mr. Gaine’s individual capacity, and not as Opposer’s corporate representative. *See id.* at pp. 3:17-18 (Mr. Lafeber: “Just to clarify, I’m going to take your fact witness deposition first. Okay.”). Counsel for Applicant reaffirmed that this testimony was part of Mr. Gaine’s personal deposition—not as a 30(b)(6) corporate representative—in response to a question from counsel for Opposer. *See* Kramer Decl., Ex. 1, pp. 26:18–27:3 (stating that “[w]e have been [in the personal deposition] the whole time.”). Indeed, counsel for Applicant elicited very little testimony of Mr. Gaine as Opposer’s 30(b)(6) corporate representative. *See id.* at Ex. 2, pp. 52:5–56 (explaining that he had just “a couple questions” on the 30(b)(6) topics towards the end of the deposition).

Because this testimony was clearly given in Mr. Gaine’s personal capacity and not as a party or Opposer’s officer, director, managing agent, or 30(b)(6) corporate designee, as required

by 37 C.F.R. § 2.120(j), the Board should strike all of Applicant's Second Notice Exhibit 12 attaching portions of Mr. Gaine's discovery deposition testimony and exhibits.

**2. Applicant Should Not Be Permitted to Rely on Testimony That Falls Outside the Scope of 30(b)(6) Designations**

Applicant submits portions of the discovery deposition testimony of Markus Straessle and Neil Gluckin that fall outside the scope of the topics for which each witness was designated as Opposer's corporate representative. In so doing, Applicant once again violates 37 C.F.R. § 2.120(j).

In its Third Notice, Applicant relies upon Mr. Straessle's responses to questions regarding Opposer's business history in the United States and Opposer's use of the UBS mark in connection with those historical business activities. *See* Third Notice, Ex. 13, Straessle Discovery Depo. Tr., pp. 52:8-54:4; 72:20-79:1; 84:6-91:16; 95:7-96:20. Mr. Straessle was not designated to testify as Opposer's corporate representative regarding any topics that covered Opposer's historical business activities in the United States and use of the UBS mark therewith. *See id.* at pp. 96:17-97:17 (explaining that a different witness was designated to testify regarding "Opposer's creation and use of the UBS mark"). Indeed, Ms. Genet was designated to testify regarding this topic, and she did so. *See, e.g.,* Third Notice, Ex. 14, Genet Discovery Depo. Tr., pp. 41:13-50:12; 54:20-59:7.

In its Second Notice, Applicant seeks to rely upon portions of Neil Gluckin's discovery deposition in which counsel for Applicant sought Mr. Gluckin's opinion regarding the potential confusion of third-party marks incorporating some or all of the letters "U" "B" and "S" with the UBS mark. *See* Second Notice, Ex. 11, Gluckin Deposition Depo. Tr., at pp. 20:25-103:23. Mr. Gluckin was only designated to testify with regard to "Opposer's knowledge of third party use of marks incorporating (in whole or in part) 'UBS' or other three letter acronym/abbreviation

including any of the letters “U”, “B” and/or “S”, including Opposer’s enforcement/policing against third party use of such marks.” *See id.* at Ex. 2. Opposer objects to Applicant’s reliance on Mr. Gluckin’s opinion regarding potential confusion as such opinion falls outside the scope of facts regarding Opposer’s knowledge of third-party use and enforcement policies. Any opinion rendered by Mr. Gluckin in this testimony was offered as his personal view and not as Opposer’s corporate representative. *See, e.g., id.* at pp. 51:25-52:12; 64:4-13; 74:12-23; 83:22-84:7; 87:1-12. Further, Applicant should be precluded from relying on this testimony because Applicant’s tactics were unfairly prejudicial. By failing to notice this topic prior to Mr. Gluckin’s deposition, Applicant deprived Opposer the opportunity to determine who, if anyone, was the most appropriate corporate representative to testify on this issue, and to adequately educate that person prior to the deposition.

Because neither Mr. Straessle nor Mr. Gluckin are a party to this opposition or are an officer, director, or managing agent of UBS AG, their responses to questions outside the scope of the 30(b)(6) designations were given in their individual capacities and should not be admitted into evidence. Accordingly, Opposer respectfully requests that the Board strike: (i) Applicant’s Third Notice Exhibit 13 attaching Markus Straessle’s discovery deposition transcript pages 52:8-54:4; 72:20-79:1; 84:6-91:16; 95:7-96:20 and accompanying exhibits; and (ii) Applicant’s Second Notice Exhibit 11 attaching Neil Gluckin’s discovery deposition transcript pages 20:25-103:23 and accompanying exhibits.

**B. Applicant Should Not Be Allowed to Rely on Discovery Deposition Testimony Elicited By Surprise**

In its Third Notice, Applicant relies upon testimony of Nadine Genet concerning use of the RBS and US BANK marks in commerce and any potential similarity between those marks and Opposer’s UBS mark. *See* Third Notice, Ex. 14, Genet Discovery Dep. Tr., pp. 122:8-130:7.

This testimony should be stricken, however, because Applicant failed to produce the documents regarding which it questioned the witness. *See id.* The parties engaged in a discovery dispute over Applicant's tactics, and the Board ordered a second deposition on the issue of third-party use after Applicant complied with its obligation to produce the documents. *See* December 21, 2007 Order. At the second deposition on this issue, Applicant questioned the witness on the very use of the same RBS and US BANK marks in commerce. *See* Second Notice, Ex. 11, Gluckin Discovery Dep. Tr. pp. 90:24-105:23.

Because Applicant had failed to produce the documents in advance of Ms. Genet's deposition, thus depriving Opposer the chance to educate its corporate designee on this issue, admission of this portion of Ms. Genet's testimony would be unfairly prejudicial to Opposer. Conversely, Applicant would not be prejudiced given that Applicant had the opportunity to question Mr. Gluckin on the same issues. Accordingly, Opposer respectfully requests that the Board strike Applicant's Third Notice Exhibit 14 attaching Nadine Genet's discovery deposition transcript pages 122:8-130:7 and accompanying exhibits.

**C. The Board Should Strike Applicant's Deposition Testimony Regarding Never-Produced Exhibits**

Applicant further attempts to circumvent the discovery process by purporting to rely on the testimony deposition of its witnesses concerning documents that have never been produced in this proceeding. In Cassie Orloske's testimony deposition, Applicant questioned the witness regarding what appear to be third-party website printouts that were not produced to Opposer. *See* Orloske Testimony Dep. Tr., pp. 15:12-31:16. Applicant also questioned Charles Hokans regarding documents purporting to depict a third-party website, a Bloomberg publication, and Applicant's website—all documents that were not produced to Opposer. *See* Hokans Testimony Dep. Tr., pp. 41:5-42:12; 44:8-45:14; and 52:5-64:17. Because Applicant should not be



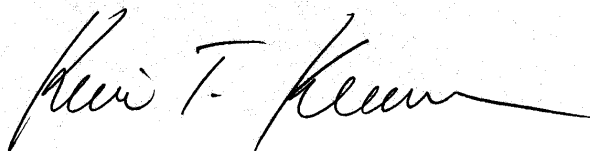
permitted to benefit from its unfair tactics and disregard for the discovery process established by the Board, Opposer respectfully requests that the Board strike Cassie Orloske testimony deposition transcript pages 15-12-31:16 and accompanying exhibits and Charles Hokans testimony deposition transcript pages 41:5-42:12; 44:8-45:14; and 52:5-64:17 and accompanying exhibits.

### **III. CONCLUSION**

Because Applicant improperly relies upon deposition testimony of Opposer's employees testifying in their individual capacity and of testimony unfairly elicited based on unproduced documents, Opposer respectfully moves the Board for an order striking: (i) all of Applicant's Second Notice Exhibit 12 attaching portions of Mr. Gaine's discovery deposition testimony and exhibits; (ii) Applicant's Third Notice Exhibit 13 attaching Markus Straessle's discovery deposition transcript pages 52:8-54:4; 72:20-79:1; 84:6-91:16; 95:7-96:20 and exhibits; (iii) Applicant's Second Notice Exhibit 11 attaching Neil Gluckin's discovery deposition transcript pages 20:25-103:23 and exhibits; (iv) Applicant's Third Notice Exhibit 14 attaching Nadine Genet's discovery deposition transcript pages 122:8-130:7 and exhibits; (v) Cassie Orloske testimony deposition transcript pages 15-12-31:16 and exhibits; and (vi) Charles Hokans testimony deposition transcript pages 41:5-42:12; 44:8-45:14; 52:5-64:17 and exhibits.

Dated: March 13, 2009

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Kevin T. Kramer". The signature is fluid and cursive, with a long horizontal stroke extending to the right.

---

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*Attorneys for Opposer UBS AG*

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

UBS AG,	)	
	)	
Opposer,	)	Opposition No. 91168033
	)	
v.	)	
	)	Application Ser. No. 78/524,329
	)	
United Bankers' Bank,	)	
	)	
Applicant.	)	
	)	

**DECLARATION OF KEVIN T. KRAMER IN SUPPORT OF OPPOSER UBS AG'S  
MOTION TO STRIKE PORTIONS OF APPLICANT'S SECOND AND THIRD  
NOTICES OF RELIANCE AND PORTIONS OF CASSIE ORLOSKE AND CHARLES  
HOKANS' TESTIMONY DEPOSITIONS**

I, Kevin T. Kramer, am a partner of Pillsbury Winthrop Shaw Pittman LLP in Washington, D.C., I represent UBS AG in the above-captioned proceeding, and I hereby declare:

1. Attached hereto as Exhibit 1 is a true and correct copy of transcript pages 26:18-27:3 from the deposition of William Gaine conducted on October 2, 2007.
2. Attached hereto as Exhibit 2 is a true and correct copy of transcript pages 52:5-56 from the deposition of William Gaine conducted on October 2, 2007.

I declare under penalty of perjury that the foregoing is true and correct. Executed on March 13, 2009.



---

Kevin T. Kramer

# **EXHIBIT 1**

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

-----x  
UBS AG,

Opposer,

Opposition No.  
91168033

v.

Serial No. 78/524,329

UNITED BANKERS' BANK,

Applicant.  
-----x

DEPOSITION of WILLIAM GAINÉ, taken at the  
offices of Pillsbury Winthrop Shaw Pittman, LLP,  
1540 Broadway, New York, New York 10036, on  
October 2, 2007, at 3:00 o'clock p.m., before  
Catherine M. Donahue, a Certified Court Reporter  
and Notary Public within and for the State of New  
York.

COPY

1 William Gainé - October 2, 2007

2 buy a bond would provide you with some type of a  
3 report?

4 **A. Correct.**

5 Q. How is that generally provided?

6 **A. It could be faxed or e-mailed.**

7 Q. What happens to that document?

8 **A. We hand it to a sales assistant who  
9 processes it. After that, I have no idea.**

10 Q. Would there be a file created for  
11 that account?

12 **A. I'm not sure.**

13 Q. Do you know if anyone checked to see  
14 if there was such a file for my client, UBB?

15 MS. GOELLER: Objection. Beyond  
16 the scope.

17 **A. I don't know.**

18 MR. LAFEVER: I'm asking him as a  
19 fact witness.

20 Q. Do you know if anyone checked?

21 **A. I do not know.**

22 MS. GOELLER: Are we now in the  
23 personal deposition? Have we switched  
24 from the 30(b)(6) to the personal  
25 deposition?

1 William Gaine - October 2, 2007

2 MR. LAFEBER: We have been the  
3 whole time.

4 BY MR. LAFEBER:

5 Q. Is there someone in your office who  
6 is responsible for maintaining the files on your  
7 different customers?

8 A. No.

9 Q. Is there a file room?

10 A. No.

11 Q. An area where you keep files?

12 A. You may check with someone in  
13 credit.

14 Q. You're unaware of any record, paper  
15 recordkeeping within your office?

16 A. Unaware.

17 Q. You have no filing cabinets anywhere  
18 in your office?

19 MS. GOELLER: Objection.

20 A. Not that I am aware of.

21 Q. If you had to get information for a  
22 specific client, where would you go?

23 MS. GOELLER: Objection. Vague  
24 as to information.

5 A. In terms of what?

# **EXHIBIT 2**



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

-----x  
UBS AG,

Opposer,

Opposition No.  
91168033

v.

Serial No. 78/524,329

UNITED BANKERS' BANK,

Applicant.  
-----x

DEPOSITION of WILLIAM GAINÉ, taken at the  
offices of Pillsbury Winthrop Shaw Pittman, LLP,  
1540 Broadway, New York, New York 10036, on  
October 2, 2007, at 3:00 o'clock p.m., before  
Catherine M. Donahue, a Certified Court Reporter  
and Notary Public within and for the State of New  
York.

COPY

1 William Gaine - October 2, 2007

2 p.m., a recess was taken to 3:58

3 o'clock p.m.)

4 MS. GOELLER: I have no cross.

5 MR. LAFEBER: I just have a

6 couple questions on the 30(b)(6) topic,

7 and I just want to remind Mr. Gaine that

8 he still under oath.

9 BY MR. LAFEBER:

10 Q. Mr. Gaine, are you aware that you  
11 have been designated to respond and address  
12 certain topics on behalf of the company today?

13 A. Yes.

14 Q. Is it your understanding you're  
15 being produced by UBS to testify regarding  
16 certain transactions between UBS, AG, and United  
17 Bankers' Bank and how USB, AG, identifies the  
18 applicant.

19 A. I'm not sure what you mean,  
20 "identifies the applicant"?

21 MS. GOELLER: Which topic is  
22 that?

23 MR. LAFEBER: Topic 5.

24 BY MR. LAFEBER:

5 Q. Sir, I'm showing you what was

1 William Gaine - October 2, 2007  
2 previously marked as Applicant's Exhibit No. 2,  
3 which I'll represent to you is UBS's Objections  
4 and Responses to Applicant's 30(b)(6) Deposition  
5 Notice.

6 I'll call your attention to page 6  
7 of that document, which indicates you have been  
8 designated as the corporate representative to  
9 respond to Topic 5.

10 Is that accurate, sir?

11 **A. Yes.**

12 Q. What did you do, sir, to prepare to  
13 testify on behalf of the company with respect to  
14 Topic 5 today?

15 **A. I spoke with Stephanie yesterday.**

16 Q. And I don't want to know anything  
17 about your conversations with counsel, but did  
18 you do anything else to prepare for your  
19 deposition to prepare for your testimony on  
20 behalf of the company today?

21 **A. Not really. It is just pretty  
22 straightforward.**

23 **The only communications I had with  
24 United Bankers' Bank is Bloomberg transactions  
25 and that's about it.**

1 **William Gaine - October 2, 2007**

2 Q. But if I understood some of your  
3 testimony earlier as a fact witness, other than  
4 persons in your office, who may deal with United  
5 Bankers' Bank?

6 **A. Correct.**

7 Q. Including Mr. Connelly, correct?

8 **A. Okay.**

9 Q. Is that correct?

10 **A. I guess.**

11 **You showed me the documentation with**  
12 **his name on it. I would assume so.**

13 Q. If I understand from your earlier  
14 testimony that the only person you talked to  
15 about how persons within UBS referred to my  
16 client was Mr. Murphy?

17 **A. Correct.**

18 Q. Did you investigate to determine  
19 whether anyone else in your office had any  
20 dealings with my client?

21 **A. No.**

22 Q. Why not?

23 **A. It didn't involve me.**

24 **I deal with your client basically**  
25 **selling agencies and that's it.**

1 William Gaine - October 2, 2007

2 Q. But you understood --

3 A. It is pretty straightforward.

4 Q. You understand you're being produced  
5 today not solely as an individual, but as a  
6 representative of the company?

7 MS. GOELLER: Objection.

8 Argumentative.

9 THE WITNESS: I don't understand.

10 BY MR. LAFEVER:

11 Q. You don't understand that?

12 A. No.

13 Q. I'm going to show you what was  
14 marked earlier during your fact witness  
15 testimony as Gaine Exhibit 1.

16 Did you do anything to prepare  
17 yourself to testify on behalf of the company to  
18 determine where Gaine Exhibit 1 came from?

19 A. No.

20 Q. Do you see in Gaine Exhibit 1 there  
21 is several references to my client as UBB?

22 A. I see that, yes.

23 Q. Did you inquire at all within UBS as  
24 to whether anybody had seen these documents?

5 A. No.

1 William Gaine - October 2, 2007

2 MR. LAFEVER: That's all I have,  
3 sir.

4 Thank you very much for your time  
5 today.

6 MS. GOELLER: No cross.

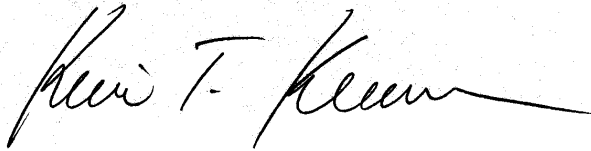
7 (Whereupon, at 4:00 o'clock  
8 p.m., the deposition was concluded.)

9  
10 \_\_\_\_\_  
11 WILLIAM GAINE

12  
13  
14  
15 Subscribed and Sworn to  
16 before me this \_\_\_\_ day  
17 of \_\_\_\_\_, 2007

**CERTIFICATE OF ELECTRONIC TRANSMISSION**

I hereby certify that the foregoing OPPOSER UBS AG'S MOTION TO STRIKE PORTIONS OF APPLICANT'S SECOND AND THIRD NOTICES OF RELIANCE AND PORTIONS OF CASSIE ORLOSKE AND CHARLES HOKANS' TESTIMONY DEPOSITIONS, DECLARATION OF KEVIN T. KRAMER, and accompanying exhibits are being transmitted to the Board via the electronic system for Trademark Trial and Appeals on March 13, 2009.

A handwritten signature in black ink, appearing to read "Kevin T. Kramer", written in a cursive style. The signature is positioned above a horizontal line.

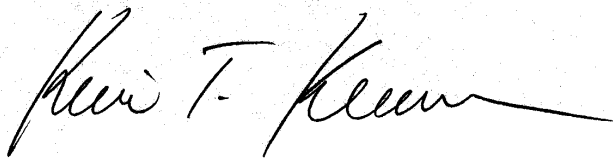
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Kevin T. Kramer

**CERTIFICATE OF SERVICE**

I hereby certify that on March 13, 2009, one copy of the foregoing OPPOSER UBS AG'S MOTION TO STRIKE PORTIONS OF APPLICANT'S SECOND AND THIRD NOTICES OF RELIANCE AND PORTIONS OF CASSIE ORLOSKE AND CHARLES HOKANS' TESTIMONY DEPOSITIONS, DECLARATION OF KEVIN T. KRAMER, and exhibits was served on counsel for applicant via first class mail, postage pre-paid, addressed as follows:

Mr. Michael M. Lafeber  
Briggs and Morgan, P.A.  
2200 IDS Center  
80 South Eighth Street  
Minneapolis, Minnesota 55402

A handwritten signature in black ink, appearing to read "Kevin T. Kramer", written over a horizontal line.

Kevin T. Kramer