UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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EJW

Mailed: April 2, 2016

Opposition No. 91219403 (parent)
Opposition No. 91221395

Margaritaville Enterprises, LLC

v.

Rachel A Bevis DBA Rachel A Bevis

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

These cases now come up on Opposer's contested[1] motion (filed February 11, 2016) for leave to use expert testimony in these proceedings.[2]

By way of background, in accordance with the Board's order mailed June 11, 2015, expert disclosures were due by September 15, 2015. Opposer filed a motion for summary judgment on September 24, 2015. In the Board's January 29, 2016 order denying Opposer's motion for summary judgment, the Board reset the close of discovery and reset remaining disclosure and trial dates. In doing so, the Board did

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[1] Applicant's response filed February 26, 2016, in Opposition No. 91221395 is noted. Applicant is reminded that papers filed in these consolidated proceedings should be filed only in the parent case (Opposition No. 91219403). For a further explanation, Applicant is directed to the Board's June 11, 2015 consolidation order. A copy of Applicant's response has been added to the Board's record in Opposition No. 91219403.

[2] Although Opposer has not yet submitted a reply brief, the Board exercises its discretion to address Opposer's motion in view of the upcoming deadline for pre-trial disclosures.

not reset the expert disclosure due date because Opposer's motion for summary judgment was filed after that due date.

Opposer now requests the Board's leave for Opposer to rely on expert testimony at trial. In support thereof, Opposer explains that in view of the Board's rationale for denying Opposer's summary judgment motion, *i.e.*, that there remains an unresolved factual dispute as to the similarity of Opposer's pleaded marks and the applied-for marks, Opposer believes that offering the expert testimony of a linguist, for example, can assist the Board in resolving this factual question. In support of its motion, Opposer argues that Applicant will not be prejudiced insofar as the discovery period is still open and the Board can establish an appropriate time table for Applicant to review Opposer's expert disclosures and testimony, and seek expert discovery or engage a rebuttal expert, as appropriate. Opposer also requests that the Board issue a revised scheduling order so that Opposer can provide its expert disclosures and expert report to Applicant.

In opposition, Applicant argues that expert testimony is not necessary and that the Board can determine the similarities and the dissimilarities of the marks as to sound, connotation, and commercial impression. Applicant also contends that having such testimony is also time-consuming and a needless expense to the Board.

- *Decision*

The Board recognizes that there may be cases in which a party may not decide that it needs to present an expert witness at trial until after the deadline for expert disclosure. *See* Trademark Rule 2.120(a)(2). *Cf. Gemological Inst. of Am., Inc. v.*

Gemology Headquarters Int'l, LLC, 111 USPQ2d 1559, 1562 (TTAB 2014) ("Courts have applied a flexible approach, focusing on the prejudicial effect of the late disclosure before imposing the preclusion sanction."). In such cases, disclosure must be made promptly when the expert is retained and a motion for leave to present testimony by the expert must be filed.

Upon disclosure by any party of plans to use expert testimony, whether before or after the deadline for disclosing expert testimony, the Board may issue an order regarding expert discovery and/or set a deadline for any other party to disclose plans to use a rebuttal expert. Trademark Rule 2.120(a)(3). Prompt disclosure after the deadline, however, does not necessarily ensure that the expert's testimony or evidence will be allowed into the record at trial. The Board will decide on a case-by-case basis how to handle a party's late identification of experts. In determining whether to allow expert testimony notwithstanding the untimely service of expert disclosure, the Board may be 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 nondisclosing party's explanation for its failure to timely disclose its intention to use expert testimony.

Southern States Rack & Fixture, Inc. v. Sherwin-Williams Co., 318 F.3d 592, 597 (4th Cir. 2003); *see MicroStrategy, Inc. v. Business Objects, S.A.*, 429 F.3d 1344, 77 USPQ2d 1001, 1009-10 (Fed. Cir. 2005); *Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239, 1246 (TTAB 2012); *Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1327-28 (TTAB 2011).

The Board finds good cause for granting Opposer's motion for leave to serve late expert disclosures and to use expert testimony at trial. First, as required, Opposer promptly filed its motion, that is, within 13 days after the Board issued its order regarding Opposer's motion for summary judgment, which informed the parties of at least one remaining issue of material fact to be resolved at trial. Additionally, while the Board recognizes that there is surprise to Applicant that Opposer seeks to disclose an expert witness, insofar as trial has not begun and discovery was still open when the motion was filed, the discovery period can now be reopened for the limited purpose of allowing Applicant to take discovery with respect to Opposer's expert witness and allowing Applicant time to retain a rebuttal expert. These two steps, if desired, would cure the surprise and any potential harm to Applicant at trial. The disruption to trial, which has not yet begun, is not significant. Further, the testimony of Opposer's expert regarding factors considered in connection with the similarity of the parties' marks may be important, particularly given Opposer's burden at trial. *See Great Seats Inc.*, 100 USPQ2d at 1327.

On balance, the Board finds that any surprise or harm to Applicant can be mitigated by reopening the discovery period for the limited purpose of allowing

Applicant to take discovery[3] with respect to Opposer's expert and by allowing Applicant time to obtain a rebuttal expert. Accordingly, Opposer's motion for leave to use the testimony of an expert at trial is **granted**.

In view of the foregoing, the discovery period is reopened until **July 1, 2016**, for the limited purposes discussed below. Opposer is allowed until **April 15, 2016**, to serve on Applicant Opposer's expert disclosure of its linguist (or similar expert witness). Thereafter, Applicant is allowed until **May 16, 2016**, to depose or conduct other discovery regarding the noticed expert witness, should Applicant wish to do so. Applicant is then allowed until **June 1, 2016**, to disclose to Opposer whether she will use a rebuttal expert and to serve on Opposer her expert disclosures, if any; and Opposer is allowed until **July 1, 2016**, to conduct discovery of any rebuttal witness disclosed by Applicant.

In view of the foregoing, trial dates are reset as shown in the following schedule:

Opposer's Expert Disclosures Due	**4/15/2016**
Applicant's Limited Discovery Period Closes	**5/16/2016**
Applicant's Rebuttal Expert Disclosure Due	**6/1/2016**
Opposer's Limited Discovery Period Closes	**7/1/2016**
Plaintiff's Pretrial Disclosures Due	**8/15/2016**
Plaintiff's 30-day Trial Period Ends	**9/29/2016**
Defendant's Pretrial Disclosures Due	**10/14/2016**
Defendant's 30-day Trial Period Ends	**11/28/2016**
Plaintiff's Rebuttal Disclosures Due	**12/13/2016**
Plaintiff's 15-day Rebuttal Period Ends	**1/12/2017**

[3] Such discovery may include taking the discovery deposition of Opposer's expert witness.

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. *See* Trademark Rule 2.125, 37 C.F.R. § 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b), 37 C.F.R. §§ 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129, 37 C.F.R. § 2.129.

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