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

Proceeding	91221339
Party	Defendant David M. Reid
Correspondence Address	CLINTON J CUSICK CUSICK IP PLLC 623 N BROAD STREET LANSDALE, PA 19446-2316 UNITED STATES ccusick@cusickip.com
Submission	Other Motions/Papers
Filer's Name	Clinton J. Cusick
Filer's e-mail	ccusick@cusickip.com
Signature	/43573/
Date	11/10/2016
Attachments	Motion to Strike.pdf(375898 bytes )

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

In re Application Serial No. : 86/438,474  
For the Mark : HIGH IMPACT  
Filed on : October 29, 2014  
Published on : March 31, 2015

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Planned Furniture Promotions, Inc. :   
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Opposer, : Opposition No. 91221339  
:   
v. :   
:   
David M. Reid :   
:   
Applicant. :   
----- X

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**MOTION TO STRIKE OPPOSER’S DECLARATIONS  
AND EXHIBITS AND REQUEST TO RESET DATES  
FOR APPLICANT’S TESTIMONY PERIOD**

Applicant David M. Reid hereby moves to strike pursuant to TBMP § 532 the declarations and exhibits filed by Opposer<sup>1</sup> Planned Furniture Promotions (“PFP”) and presents memorandum in support of same.

Applicant requests suspension of the current proceeding pending the disposition of this motion including procedural grounds that may be cured, namely the relevance of internet evidence. TBMP § 704.08(b). The opening of Applicant’s testimony period is currently scheduled for November 27, 2016. It is requested that the testimony period and subsequent

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<sup>1</sup> PFP continues to refer to itself as Petitioner in the caption, title, and throughout filed documents.

dates be reset following the Board's disposition of this motion.

## I. INTRODUCTION

At the conclusion of Opposer's trial period, Opposer has filed with the Board the following documents:

1. Discovery deposition of David M. Reid. Opposer states that this document is a Testimony Deposition. However, the deposition was taken during the discovery period and is therefore a discovery deposition.

2. Exhibits 1 through 29 of the discovery deposition of David M. Reid.

3. Petitioner's Notice of Filing Declaration of Leo L. Esses, Esq. and Exhibits A-G.

4. Trial Declaration of Leo L. Esses, Esq.

5. Exhibits 1-10, 13-17, 19-21, and A-G to the trial declaration of Leo Esses.

6. Petitioner's Notice of Filing Declaration of Thomas Liddell, Vice President of Petitioner.<sup>2</sup>

7. Exhibits 11, 12, 18, and 22-29 to the trial declaration of Thomas Liddell.

All of these documents and exhibits should be stricken as inadmissible.<sup>3</sup> Declarations are not an acceptable form of evidence, absent a stipulation by the parties. TBMP § 703.01(b). "Documents and other exhibits may not be introduced in connection with the declaration or affidavit of a witness unless the parties have mutually agreed to accept same in lieu of testimony." *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.* 107 USPQ2d

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<sup>2</sup> PFP is the Opposer.

<sup>3</sup> "Petitioner's Trial Brief" was also filed, but is not addressed here. Applicant's trial period has not commenced.

1424, 1427 (TTAB 2013).

Public records submitted pursuant to Trademark Rule 2.122(e) must be accompanied by a notice of reliance setting out the relevance of the documents. Exhibits 13-17, 19-21, and A-G are not accompanied by a notice of reliance indicating the relevance of the documents. This procedural requirement must be raised prior to the start of Applicant's trial period. TBMP § 704.08(b).

Opposer's own document production cannot be admitted by notice of reliance. Trademark rule 2.120. Exhibits 11 through 29 are inadmissible for failure to comply with the Board's procedure.

## **II. Declaration of Leo Esses and Exhibits**

### **A. Declarations are inadmissible trial testimony.**

Declarations are inadmissible as trial testimony absent a stipulation from the other party. Trademark Rule 2.123(b). Here, there is no stipulation to accept declarations as trial testimony. The declaration is inadmissible and should be stricken from the record. *Calypso Technology Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213, 1216-19 (TTAB 2011) (several affidavits submitted by plaintiff under notice of reliance not considered); *Wonderbread 5 v. Gilles*, 115 USPQ2d 1296, 1300 (TTAB 2015).

### **B. Exhibits not authenticated are inadmissible.**

Exhibits 13-17 and 19-21 are not admissible because they were not authenticated during a trial deposition. Authentication by declaration of counsel is not permissible. "Evidence may be introduced in the form of testimony depositions taken by a party during

its testimony period, and documents and other exhibits may be made of record with appropriate identification and introduction by the witness during the course of the deposition.” TBMP § 702.02. Here, no deposition was taken to authenticate Exhibits 13-17 and 19-21, and they are inadmissible.

C. Relevance of exhibits not indicated.

Exhibits 13-17 and 19-21 are internet materials that are not supported by a notice of reliance indicating the relevance of the documents. TBMP 704.08(b), *FUJIFILM SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234 (TTAB 2014). The exhibits should be stricken. This objection must be lodged “before the opening of the next testimony period.” TBMP § 704.08(b).

D. Internet search summaries are not admissible.

Regarding Exhibit 13, internet search summaries “are not admissible by notice of reliance.” *Id.* *See also Edom Laboratories, Inc. v. Lichter*, 102 USPQ2d 1546, 1550 (TTAB 2012) (search summary inadmissible because it merely offers links to information not otherwise of record.)

E. Party cannot submit own documents by notice or reliance.

To the extent a declaration and exhibits are tantamount to a notice of reliance, disclosures in Exhibits 13-17 and 19-21 are inadmissible. A party cannot make its own discovery disclosures of record, that is limited to disclosures and admissions by the receiving or inquiring party. 37 C.F.R. § 2.120(j)(5). Each of these disclosures are

stamped with a production number ranging from PFP00037 to PFP000149, and as such are inadmissible by notice of reliance. *Id.*

F. Exhibits are not published documents under 37 CFR 2.122(e).

Exhibits 13, 20, and 21 are not published documents suited for admission by notice of reliance. Exhibit 13 does not contain the URL.

Exhibit 20 is a business listing from Manta.com and the URL provided at the bottom of the printout is not a static URL and does not lead to the content of Exhibit 20. The URL currently forwards to a listing for lingerie sales in Utah.

Exhibit 21 is not a published document. The URL leads to a “page not found” error. <http://www.furnitureoptionsinc.com/index.php/82-promotionals/91-add-2.html>. The entire top level domain returns the same error.

G. Exhibits A-G

Exhibits A through D are TTAB records from another proceeding, are public documents, but a notice of reliance is not provided and the relevance of the documents is not provided as required by 37 CFR § 2.122(e) in order to be admissible. These exhibits are inadmissible.

As to Exhibits E through G, the application file and the pleadings are already of record.

**III. Declaration of Thomas Liddell and Exhibits**

The declaration of Thomas Liddell is an improper attempt to introduce testimony and should be stricken.

The Exhibits 11, 12, 18, and 22-29 are not authenticated, are not admissible, and should be stricken.

A. Declarations are inadmissible trial testimony.

Declarations are inadmissible as trial testimony absent a stipulation from the other party. Trademark Rule 2.123(b). Here, there is no stipulation to accept declarations as trial testimony. The declaration is inadmissible and should be stricken from the record. Calypso Technology Inc. v. Calypso Capital Management LP, 100 USPQ2d 1213, 1216-19.

B. Exhibits not authenticated are inadmissible.

As the declaration of Thomas Liddell should be stricken, all exhibits to the declaration should be stricken as well. Exhibits 11, 12, 18, and 22-29 are not admissible because they were not authenticated during a trial deposition. TBMP § 702.02. Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc., 107 USPQ2d 1424, 1427.

C. Party cannot submit own documents by notice or reliance.

A party cannot admit its own discovery documents or written disclosures by notice of reliance alone. 37 C.F.R. § 2.120(j)(5). Opposer has not filed a notice of reliance. However, to the extent a declaration and exhibits are tantamount to a notice of reliance, disclosures in Exhibits 11, 12, 18, and 22-29 are inadmissible. Each of these Exhibits are stamped with a production number in the range of PFP00001 to PFP000212, and as such are inadmissible by notice of reliance. 37 CFR § 2.120(3)(i), 37 CFR § 2.120(j)(5).

D. Exhibits are not printed publications pursuant to 37 CFR § 2.122(e).

Exhibits 11, 12, 18, and 22-29 are not printed publications, official records, or published documents suited for admission by notice of reliance. The documents are alleged to be kept in “the files of Petitioner” and as such are not published or publicly available. As stated above, Opposer has not filed a notice of reliance, but to the extent a declaration can be construed as a notice of reliance, the cited Exhibits are not the type of documents admissible under Trademark Rule 2.122(e).

**IV. Discovery Deposition of David M. Reid**

A. A notice of reliance has not been filed.

Discovery depositions can be submitted to evidence with a notice or reliance. 37 CFR 2.120(j)(3)(i). Opposer PFP has not filed a notice of reliance, and so the transcript and Exhibits should be stricken.<sup>4</sup> *American Skein & Foundry Co. v. Stein*, 165 USPQ 85, 85 (TTAB 1970) (discovery deposition timely filed but not accompanied by notice of reliance not considered).

B. Authentication of Opposer’s disclosure documents has not been provided by David M. Reid.

Exhibits 11 through 31 are referenced in the transcript of the discovery deposition. Deponent David M. Reid does not have any knowledge of these documents, produced by Opposer during discovery. Exhibits 11 through 31 bear production numbers PFP00001

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<sup>4</sup> Opposer has presented documents entitled “notice of filing” which on their face are not a “notice of reliance.”



through PFP00212. Opposer cannot admit its own document production into evidence by passing it in front of Applicant.

The following table is provided to show that Applicant has not authenticated documents produced by Opposer. The Exhibit number, Question and Answer text, and transcript location are provided for each of the Exhibits referenced in the declaration of Thomas Liddell.

Exhibit	Q/A	Transcript
11	A: I was never privileged to see this.	71: 1
12	Q: Have you ever seen this brochure before?  A: No.	71: 20,21.
18	Q: Do you know when this ad was printed?  A: I have no idea	81:23,24
18 -- page 2	Q: Do you know when this was printed?  A: I have no idea. I've never seen it before.	82: 15-16
22	Q: Have you ever seen this before?  A: No.	86: 17-18
23	Q: Have you ever heard of the company Impact Marketing, Inc.?  A: No, I haven't. ...	87: 9-11
24	Q: This is Profit Management Promotions. This is Mike Egan's company.  A: How do I know that?	89:17-19.

	<p>Q: I'm representing to you it is. I'm telling you that.</p> <p>A: Now, this is - - almost everything you've shown me at this point I've never seen before. So why would I send them a letter?</p>	
25	<p>Q: You've never heard of them?</p> <p>A: Never heard of them.</p>	91:5-6
26	<p>A: I didn't know they existed. I've never seen anything from them. I have no reason under the sun to send them a letter.</p>	92: 19-21
27	<p>A: I don't remember sending them one, no. I've never seen this either.</p>	94: 12-13.
28	<p>Q: Have you ever seen this letterhead before?</p> <p>A: No.</p>	95: 3-4
29	<p>Q: Have you ever communicated with MBA regarding its use of the term "high impact"?</p> <p>A: I think I answered that before. I didn't know Mark was in the promotion business for his own company, and I've never seen any of his literature before. So I have absolutely no reason to send him a letter.</p>	96: 14-20.

Similarly, deponent David Reid had no personal knowledge sufficient to authenticate the internet documents in Exhibits 13-17 and 19-21 referenced in the Esses Declaration.

## V. CONCLUSION

It is requested that the declaration of Leo Esses be struck from the record as inadmissible form of testimony. Trademark Rule 2.123 states that testimony of witnesses shall be by deposition unless altered by stipulation. Here, there is no stipulation to accept declaration testimony, and the declaration is inadmissible.

The same analysis applies to the declaration of Thomas Liddell. Declaration testimony is not admissible unless the parties so stipulate. Here, there is no stipulation. Wonderbread 5 v. Gilles, 115 USPQ2d at 1300.

The Exhibits to the declarations fall into three main categories. Exhibits 1-10 to the Reid deposition are offered by the requesting or receiving party. Trademark Rule 2.120(j).

The Exhibits to the Esses declaration are not presented according to the requirements for printed publications under Rule 2.122(e). As discussed above, the relevance of the documents must be provided. FUJIFILM, 111 USPQ2d at 1237. Exhibits 13-17, 19-21, and A-D are inadmissible for procedural deficiency on a number of grounds discussed above and should be struck from the record. They should be excluded as improperly offered with a declaration of counsel and also lacking indications of relevance as required by TBMP § 704.08(b). Additionally, deponent David M. Reid is not familiar with any of these documents and has not authenticated them.

None of the Exhibits to the Liddell declaration meet any of the exceptions, and so they are inadmissible. See Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc., 107 USPQ2d 1424. Exhibits 11, 12, 18, and 22-29 are not admissible for procedural deficiency and should be struck from the record. Additionally, deponent David M. Reid is not familiar with any of these documents and has not identified or authenticated them in his discovery deposition.

All of the submissions of Opposer on October 28, 2016 fail to meet at least one requirement of the Board's procedure or rules of practice in trademark cases. Evidence not obtained and filed in compliance with the rules of practice will not be considered by the Board. 37 CFR § 2.123(l).

Applicant further requests a suspension of the current proceeding pending the outcome of this motion to allow applicant to properly prepare its evidence after the Board has determined the admissibility of Opposer's submissions.

Dated: November 10, 2016

Respectfully submitted,

David M. Reid

By His Attorneys

A handwritten signature in blue ink, appearing to read "Clinton J. Cusick".

Clinton J. Cusick  
Cusick IP, PLLC  
623 N. Broad Street  
Lansdale, PA 19446

Our Ref.: 2166-401

CERTIFICATE OF SERVICE

It is hereby certified that on November 10, 2016, a copy of the foregoing MOTION TO STRIKE DECLARATIONS AND EXHIBITS AND REQUEST TO RESET DATES FOR APPLICANT'S TRIAL PERIOD has been sent by first class mail, postage prepaid to the address of counsel for Opposer:

Leo L. Esses, Esq.  
750 Third Avenue, 9<sup>th</sup> Floor  
New York, NY 10017

  
\_\_\_\_\_  
Clinton J. Cusick