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

Proceeding	92067794
Party	Defendant The Burton Corporation
Correspondence Address	CATHLEEN E STADECKER DOWNS RACHLIN MARTIN PLLC 199 MAIN STREET PO BOX 190 BURLINGTON, VT 05402-0190 UNITED STATES tmip@drm.com 802-863-2375
Submission	Motion to Strike
Filer's Name	Cathleen E. Stadecker
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Date	06/25/2019
Attachments	Registrant Mot. to Strike Expert Disclosure.pdf(298661 bytes )

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

In the Matter of Reg. No. 2,207,535 issued on December 1, 1998  
and Reg. No. 3,598,502 issued on March 31, 1999

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Joshua S. Schoonover,	:	
	:	
Petitioner,	:	Cancellation No. 92067794 (parent)
	:	Cancellation No. 92069499
-against-	:	
	:	
The Burton Corporation	:	
	:	
Registrant.	:	

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**REGISTRANT’S MOTION TO STRIKE PETITIONER’S DISCLOSURE OF  
“UNRETAINED” EXPERT OR, IN THE ALTERNATIVE, TO COMPEL EXPERT  
REPORT**

Registrant, The Burton Corporation (“Burton”), by and through its attorneys Downs Rachlin Martin PLLC, hereby moves to strike Petitioner Joshua S. Schoonover’s April 19, 2019 disclosure of “unretained” expert Toby F. Bost in the above-captioned proceeding (“Bost Disclosure”). Contrary to Schoonover’s assertions, Bost is not a witness who is “not required to provide a written report” pursuant to Fed. R. Civ. P. 26(a)(2)(C). Given Schoonover’s failure to serve an expert report for over two months—despite multiple opportunities to cure—the Board should strike the Bost Disclosure so that the parties can proceed to trial. In the alternative, the Board should order Schoonover to promptly serve an expert report that complies with Rule 26.<sup>1</sup> Furthermore, Burton requests that the Board suspend all proceedings pending the resolution of the instant Motion. In support thereof, Burton states as follows:

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<sup>1</sup> Burton certifies that, pursuant to Fed. R. Civ. P. 37(a)(1) and Trademark Rule 2.120(f)(1), it has made a good-faith effort to resolve this dispute with Mr. Schoonover, who, while self-represented, is an attorney at law.

## RELEVANT FACTUAL AND PROCEDURAL HISTORY

1. On April 19, 2019—the last day he was permitted to do so under the case schedule—Schoonover served a document identifying Toby F. Bost as his “unretained” expert, together with Bost’s curriculum vitae. **Exhibit A.**<sup>2</sup> The Bost Disclosure states that Bost is “expected to testify by declaration” that he reviewed a Burton press release and ESPN interview, both dated October 23, 2012. Based on that review, Bost purports to opine that:

- the words “exit out of”, “exiting out of”, and/or “putting to bed” the “PROGRAM BRANDS” means, with respect to the FORUM mark, and to those in the relevant field of sporting goods and apparel, the act (or more accurately, the omission) amounting to ceasing manufacture of goods bearing the FORUM mark and stopping the sale of goods bearing the FORUM mark;
- it is his expert opinion that, based on and at the time of the Burton Press Release, Burton intended to stop manufacture and sale of goods bearing the FORUM mark; and
- it is his expert opinion that, as would be received and appreciated by those in the relevant field of sporting goods and apparel, based on and at the time of the ESPN Interview, Burton merely intended to preserve rights to the FORUM mark on the trademark register subsequent to exiting out of the PROGRAM BRANDS.

Id.

2. By letter dated May 17, 2019, undersigned counsel advised Schoonover that the Bost Disclosure failed to comply with Rule 26, as interpreted in the precedential decision RTX Scientific, Inc. v. Nu-Calgon Wholesaler, Inc., 2013 WL 3168102 (TTAB Mar. 22, 2013). **Exhibit B.** In an effort to resolve the issue, undersigned counsel requested that Schoonover serve a written report on or before May 28, 2019.<sup>3</sup>

3. In an email dated May 28, 2019, Schoonover declined to serve an expert report. In doing so, Schoonover added completely new facts, opinions, and purported reliance material which were not disclosed in the Bost Disclosure:

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<sup>2</sup> As a courtesy to Schoonover, Burton has redacted Bost’s address and phone number (which Schoonover designated as “Attorney’s Eyes Only”) in Exhibit A because this information is not material to the issues raised in the Motion.

<sup>3</sup> Burton further expressly reserved, and continues to reserve, its right to argue that Bost’s purported opinions are inadmissible under Fed. R. Evid. 702. It is nearly inconceivable that Bost can—consistent with Rule 702 and Daubert v. Merrell Dow Pharms., 509 U.S. 579 (1993)—opine as to the meaning of ordinary English words that any lay person is capable of comprehending, nor especially as to the “intent” Burton allegedly possessed on October 23, 2012.

Mr. Bost is the former CEO of O'Neill, he knows action sports brands and the business, he recalls the press release and Burton announcing its exit from the program brands, and he is lending his opinion to the record concerning what it means (or meant at the time) to those in the industry to "exit out of" a brand. His opinion arises from his "on-the-scene" involvement as a businessman in the relevant field (action sports apparel) who received an impression from the "Burton Press Release" coupled with his familiarity of terms and phrases of art in the relevant field. His opinions do not arise from being hired, or review of the record, except for the Press Release as a refresh. Note the difference here, his opinion concerns his impression, as an expert in the industry, of the Burton Press Release at the time he encountered it and what it means (or meant at the time). He has not been hired or retained and has no interest in the outcome of the proceeding, he is not compensated. He is, however, an expert, and therefore an unretained expert. I would encourage you to file your motion if you disagree. Perhaps you may be correct, but I intend to test the theory before the TTAB, I think the facts and circumstances here are distinct from RTX Scientific and worthy of review, perhaps a new precedent.

**Exhibit C.** Despite exchanging further correspondence, the parties reached an impasse.

## **ARGUMENT**

### **I. BOST IS NOT AN "UNRETAINED EXPERT" AND THE BOST DISCLOSURE SHOULD THEREFORE BE STRICKEN**

Rule 26(a)(2) distinguishes between experts who "must" provide an expert report and those who are "not required" to do so. In RTX Scientific, the Board held that "[w]here an expert's opinion testimony arises from his enlistment as an expert and not from an on-the-scene involvement in any incidents giving rise to the litigation, that expert is 'retained' for purposes of Rule 26(a)(2)(B) and that rule therefore requires a written report." 2013 WL 318102, at \*4 (ordering petitioner to provide a written report regarding intended expert testimony).

Applying RTX Scientific to this proceeding, neither the Bost Disclosure nor Schoonover's subsequent representations establishes that Bost is an "unretained" expert within the meaning of Rule 26. The Bost Disclosure makes clear that he had no "on-the-scene" involvement in, or personal knowledge regarding, the "incidents giving rise to the litigation." **Ex. A** (disclosing that Bost "has reviewed and is familiar with" materials at issue in this proceeding). That Bost allegedly worked in the "relevant field" and allegedly recalls certain events which took place in 2012 is

insufficient. Almost by definition, Bost was not “on-the-scene” when the relevant events occurred and his “personal knowledge” only consists of having heard about these events (one must presume) through hearsay. While Bost may not be employed by Schoonover or compensated for his opinions, under RTX Scientific, these facts “are not controlling.” 2013 WL 318102, at \*5; cf. Innogenetics, N.V. v. Abbott Laboratories, 512 F.3d 1363, 1375, 85 USPQ2d 1641, 1649-50 (Fed. Cir. 2008) (given witness’s role as inventor, mere fact that he was not being compensated did not exempt him from furnishing an expert report as a witness who will be giving scientific testimony).

For these reasons, Schoonover was required to submit an expert report that complies with Rule 26, which the Bost Disclosure plainly does not. After the Bost Disclosure was served, Burton advised Schoonover of this deficiency and gave him multiple opportunities to cure, which he has flatly refused. More than two months have passed since the deadline to serve expert disclosures, and trial deadlines are now rapidly approaching. In the absence of an expert report that actually contains “a complete statement” of Bost’s opinions and the “basis and reasons for them” (among other required content), see Fed. R. Civ. P. 26(a)(2)(B), Burton remains in the dark about what Bost’s expert testimony will be at trial. It should not have to wait several more months until Bost’s trial declaration is served before it learns the scope and basis for these opinions.

This predicament is solely attributable to Schoonover’s decisions to serve the Bost Disclosure at the last minute and to take the calculated risk not to serve an expert report. It is too late for Schoonover to correct this fundamental discovery defect, as doing so will likely result in undue delay in the adjudication of this proceeding and in further (avoidable) litigation regarding the admissibility of Bost’s opinions. Because Schoonover’s failure to serve an expert report violates Rule 26 and is not substantially justified, the Board should strike the Bost Disclosure and preclude his testimony so that the parties can proceed to trial and litigate issues which should never have required expert testimony in the first place. Cf. RTX Scientific, 2013 WL 3168102, at \*2 (noting that “expert testimony is expensive and typically not utilized in Board proceedings”).

**II. IN THE ALTERNATIVE, THE BOARD SHOULD ORDER SCHOONOVER TO SERVE AN EXPERT REPORT**

In the alternative, the Board should order Schoonover to provide a written expert report that complies with Rule 26(a)(2)(B). The expert disclosure Rules are designed to give each party fair notice of its adversary's expert testimony. As is evident from the bare-bones Bost Disclosure, Burton has not received the fair notice required by the Rules. While the appropriate remedy for this discovery violation at this late date is to strike the Bost Disclosure and preclude any opinion testimony by Bost, Burton is, at a minimum, entitled to an expert report that satisfies the criteria set forth in Rule 26(a)(2)(B).<sup>4</sup>

**III. THE BOARD SHOULD SUSPEND ALL PROCEEDINGS PENDING RESOLUTION OF THE MOTION**

Because trial deadlines in this proceeding are rapidly approaching, neither party will be able to adequately or thoroughly prepare for trial and comply with these deadlines while the status of the Bost Disclosure remains disputed. Trademark Rule 2.120(f)(2) provides that "[w]hen a party files a motion for an order to compel . . . expert testimony disclosure, or discovery, the case will be suspended by the Board with respect to all matters not germane to the motion." Because Burton seeks an order from the Board to strike, or in the alternative, to compel an expert disclosure, all proceedings should be suspended regarding matters not germane to the motion.

**CONCLUSION**

WHEREFORE, for the foregoing reasons, Burton respectfully requests that the Board GRANT the instant Motion and STRIKE the Bost Disclosure and preclude any testimony by Bost in this proceeding or, in the alternative, ORDER Schoonover to promptly serve a written report regarding Bost's intended expert testimony pursuant to Rule 26(a)(2)(B).

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<sup>4</sup> For the avoidance of doubt, Burton does not imply that such an expert report would cure the inadmissibility of Bost's opinions. Even assuming that Schoonover can submit a report that complies with Rule 26 at this late date, Bost's intended testimony is not admissible under Rule 702 and Daubert. Burton reserves the right to file an appropriate motion raising these issues, if necessary.

Date: June 25, 2019.

DOWNS RACHLIN MARTIN PLLC

By: /s/ Cathleen E. Stadecker  
Cathleen E. Stadecker  
Attorney for Registrant  
The Burton Corporation  
199 Main Street, P.O. Box 190  
Burlington, VT 05402-0190  
Phone: (802) 863-2375  
Fax: (802) 862-7512  
CStadecker@drm.com

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the foregoing document entitled **REGISTRANT'S MOTION TO STRIKE PETITIONER'S DISCLOSURE OF "UNRETAINED" EXPERT OR, IN THE ALTERNATIVE, TO COMPEL EXPERT REPORT**, was served on Petitioner at the following email address on June 25, 2019: LawGroup@CoastalPatent.com

/s/ Jennifer W. Parent  
Jennifer W. Parent

# EXHIBIT A



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

In the matter of Reg. No. 2,207,535 issued on December 1, 1998, and  
Reg. No. 3,598,502 issued on March 31, 2009,  
each for the mark FORUM.

\_\_\_\_\_  
Joshua S. Schoonover,

Petitioner,}

v.}

The Burton Corporation,

Registrant.}

Cancellation No. 92067794 (parent)  
Cancellation No. 92069499

**PETITIONER JOSHUA S. SCHOONOVER’S NOTICE OF EXPERT AND EXPERT**  
**DISCLOSURE**

In accordance with Fed.R.Civ.P.26(a)(2), Petitioner Joshua S. Schoonover hereby provides the following expert disclosures:

Toby F. Bost (unretained expert)



\*Attorney eyes only, please do not disseminate the Expert’s address and phone number.

Mr. Bost is expected to testify by declaration that:

- he has reviewed and is familiar with the Burton Press Release dated October 23, 2012 titled “Burton Realigns its Family of Brands for Long-Term Success”, hereinafter (the “Burton Press Release”) [*BUR\_00001 - BUR\_00005*];
- he has reviewed and is familiar with the ESPN interview published October 23, 2012 titled “Burton 'restructures'” (the “ESPN Interview”) [*SCH-000006 – SCH-000012*];

- the words “exit out of”, “exiting out of”, and/or “putting to bed” the “PROGRAM BRANDS” means, with respect to the FORUM mark, and to those in the relevant field of sporting goods and apparel, the act (or more accurately, the omission) amounting to ceasing manufacture of goods bearing the FORUM mark and stopping the sale of goods bearing the FORUM mark;
- it is his expert opinion that, based on and at the time of the Burton Press Release, Burton intended to stop manufacture and sale of goods bearing the FORUM mark; and
- it is his expert opinion that, as would be received and appreciated by those in the relevant field of sporting goods and apparel, based on and at the time of the ESPN Interview, Burton merely intended to preserve rights to the FORUM mark on the trademark register subsequent to exiting out of the PROGRAM BRANDS.

DATED this 19<sup>th</sup> day of April, 2019.

Respectfully submitted,  
Coastal Patent Law Group, P.C.

/Joshua Schoonover/  
Joshua S. Schoonover, Esq.  
*Petitioner, Pro Se*  
*Reg. No. 63,294*

Coastal Patent Law Group, P.C.  
PO Box 131299  
Carlsbad, CA 92013  
Telephone: (858) 565-4730  
Facsimile: (858) 408-3339

**CERTIFICATE OF SERVICE**

I hereby certify that on April 19, 2019, I caused a true and correct copy of PETITIONER JOSHUA S. SCHOONOVER'S NOTICE OF EXPERT AND EXPERT DISCLOSURE to be served by email upon the following attorneys of record for Registrant:

Cathleen E. Stadecker: tmip@drm.com

/Joshua S. Schoonover/

Joshua S. Schoonover

# EXHIBIT B

May 17, 2019

Cathleen E. Stadecker  
Tel: (802) 846-8618  
Fax: (802) 862-7512  
cstadecker@drm.com

**VIA ELECTRONIC MAIL**

Joshua S. Schoonover, Esq.  
Coastal Patent Law Group, P.C.  
PO Box 131299  
Carlsbad, CA 92013

Re: *Joshua S. Schoonover v. The Burton Corporation* (TTAB Nos. 92067794 & 92069499)

Dear Mr. Schoonover:

On behalf of The Burton Corporation (“Burton”), I write to address your discovery requests and notice of expert, which we received on April 19, 2019.

Burton will respond to your Third Set of Interrogatories, Requests for Production, and Requests for Admission as required by the Federal Rules of Civil Procedure and Trademark Rules, subject to its objection that no initial disclosures were served in Cancellation Proceeding No. 92069499, and the deadline to do has now passed. *Dating DNA, LLC v. Imagini Holdings, LLC*, 94 USPQ2d 1889, 1893 (TTAB 2010) (service of initial disclosures is a prerequisite to taking discovery).

As to your Notice of Expert and Expert Disclosure of Toby F. Bost dated April 19 (“Expert Disclosure”), this fails to comply with Fed. R. Civ. P. 26. On its face, the Expert Disclosure makes clear that Mr. Bost is not an “unretained” expert, and that he must serve a written report that complies with Rule 26(a)(2)(B). The TTAB’s precedential decision in *RTX Scientific, Inc. v. Nu-Calgon Wholesaler, Inc.*, 2013 WL 3168102, at \*4 (TTAB Mar. 22, 2013) speaks directly to this issue: “Where an expert’s opinion testimony arises from his enlistment as an expert and not from an on-the-scene involvement in any incidents giving rise to the litigation, that expert is ‘retained’ for purposes of Rule 26(a)(2)(B) and that rule therefore requires a written report.”

By this authority, Mr. Bost is, in fact, a “retained” expert, and the Expert Disclosure is deficient. If no written report is served by **May 28, 2019**, Burton will file an appropriate motion with the TTAB. Burton expressly reserves its objections to the admissibility of Mr. Bost’s testimony under Fed. R. Evid. 702 and to the untimeliness of his disclosure. Please be further advised that any obligations Burton may have to disclose its own responsive expert(s) in this proceeding are hereby tolled, pending the service of a report that complies with the Rules and/or any motion practice which may result therefrom.

Please contact me if you would like to discuss any of these matters.

May 17, 2019  
Joshua S. Schoonover, Esq. Page 2

Sincerely,

A handwritten signature in cursive script, appearing to read "C. Stadecker".

/s/ Cathleen E. Stadecker

Cathleen E. Stadecker

19275345.2

# EXHIBIT C

**Evan J. O'Brien**

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**From:** jschoonover@coastalpatent.com  
**Sent:** Tuesday, May 28, 2019 11:53 PM  
**To:** Cathleen Stadecker  
**Subject:** Joshua S. Schoonover v. The Burton Corporation (TTAB Nos. 92067794 & 92069499) [DRM-ID.FID934837]  
**Attachments:** 2018-05-09\_Initial-Disclosures.pdf

Hi Cathleen,

I am writing in response to your letter of May 17, 2019 to address two items:

- (i) I served initial disclosures on May 09, 2018 (see attached copy). I think you are suggesting that I did not serve initial disclosures in the '499 Proceeding (Child) and therefore Burton objects to the discovery. However, as you know, I served initial disclosures on May 09, 2018 in the Parent Proceeding, and the Child Proceeding was consolidated with the Parent Proceeding on January 24, 2019, prior to my discovery requests of April 19, 2019. My belief is that the initial disclosures that I submitted in the Parent case are incorporated into the Child case by way of the consolidation. Thank you for providing the requested discovery.
- (ii) Mr. Bost's testimony will be offered to show the apparent intent illustrated by the Burton Press Release, specifically concerning the phrase "exit out of". Mr. Bost is the former CEO of O'Neill, he knows action sports brands and the business, he recalls the press release and Burton announcing its exit from the program brands, and he is lending his opinion to the record concerning what it means (or meant at the time) to those in the industry to "exit out of" a brand. His opinion arises from his "on-the-scene" involvement as a businessman in the relevant field (action sports apparel) who received an impression from the "Burton Press Release" coupled with his familiarity of terms and phrases of art in the relevant field. His opinions do not arise from being hired, or review of the record, except for the Press Release as a refresh. Note the difference here, his opinion concerns his impression, as an expert in the industry, of the Burton Press Release at the time he encountered it and what it means (or meant at the time). He has not been hired or retained and has no interest in the outcome of the proceeding, he is not compensated. He is, however, an expert, and therefore an unretained expert. I would encourage you to file your motion if you disagree. Perhaps you may be correct, but I intend to test the theory before the TTAB, I think the facts and circumstances here are distinct from RTX Scientific and worthy of review, perhaps a new precedent.

I don't think we need a phone call, but wanted you to know my position.

All the best,

Josh

Joshua S. Schoonover, Esq.  
*Intellectual Property Attorney*

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