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ESTTA Tracking number: **ESTTA993476**

Filing date: **08/08/2019**

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

Proceeding	92067794
Party	Defendant The Burton Corporation
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Date	08/08/2019
Attachments	Reply ISO Motion to Strike.pdf(39773 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

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

REGISTRANT'S REPLY IN SUPPORT OF
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 submits this reply memorandum of law in support of its Motion to Strike Petitioner Joshua S. Schoonover's April 19, 2019 disclosure of "unretained" Expert Toby F. Bost ("Bost Disclosure") or, in the alternative, to compel an expert report ("Motion").

In his untimely opposition to the Motion ("Opposition" or "Opp."), Schoonover has attached a never-before-seen Declaration signed by Bost on July 24, 2019—*one month after* Registrant filed the instant Motion and over three months after the expert disclosure deadline ("Bost Declaration"). See Opp. Ex.-004. Bost's constantly changing and ever-expanding opinions only underscore why the Board's disclosure rules exist in the first place: to promote the orderly and timely disclosure of evidence. Bost's improperly disclosed testimony—either as a fact or expert witness—should be precluded. In support thereof, Burton states as follows:

ARGUMENT

I. SCHOONOVER'S OPPOSITION WAS UNTIMELY FILED AND SHOULD NOT BE CONSIDERED BY THE BOARD

Burton filed the Motion on June 25, 2019. Under the Rules, Schoonover was required to file his response within twenty days of service, on or before July 15, 2019, since the Board did not specify, nor did the parties stipulate to, a different deadline. See 37 C.F.R. § 2.127(a). However, without seeking Burton's consent or leave from the Board, Schoonover helped himself to an extra ten days, filing a 67-page response (including exhibits) on July 25, 2019. Under the rules, "[i]f a brief in opposition to a motion . . . is not timely filed, it may be stricken, or given no consideration, by the Board." Trademark Trial & Appeal Board Manual of Procedure ("TBMP") § 517.

Here, no good cause or excusable neglect is apparent for Schoonover's tardiness.[1] If anything, it appears as if Schoonover used this extra time to develop and file a wholly new declaration by his "expert" dated July 24, 2019—more than three months after the expert disclosure deadline—sowing further confusion into these proceedings and causing manifest prejudice to Burton, which remains in the impossible position of trying to decipher and rebut Schoonover's ever-changing expert case. Because Schoonover's tardiness in filing his Opposition represents only his latest violation of the Board's procedural rules, the Board should exercise its discretion and decline to consider the Opposition and the never-before-seen material attached thereto. See Consolidated Foods Corp. v. Berkshire Handkerchief Co., 229 U.S.P.Q. 619, 1986 WL 83671, at *2 (TTAB 1986) (noting that party's response was untimely without showing of excusable neglect and therefore "has not been considered on its merits" by the Board).

II. BURTON IS NOT TO BLAME FOR SCHOONOVER'S VIOLATION OF RULE 26

On the merits, Schoonover's explanation for improperly disclosing a purported "expert" without serving a Rule 26 report rests on a total *non sequitur*. He insists that this disclosure was

[1] Although Schoonover is self-represented, he is an attorney at law.

necessitated by Burton's "refus[al] to provide meaningful answers" during discovery. Opp. 4. This assertion fails under the slightest scrutiny. Schoonover fails to explain why he is entitled to serve a deficient expert disclosure (which contains inadmissible opinions) because Burton purportedly did not provide "meaningful answers" during fact discovery.[2] His dissatisfaction with Burton's responses does not alter his obligation to follow applicable expert disclosure rules.

Moreover, Schoonover's argument fails because the allegedly deficient discovery responses he cites in his Opposition were, in fact, entirely appropriate. Opp. 1-4. Through multiple rounds of Requests for Admission ("RFA"), Schoonover sought to have Burton concede the ultimate issues in this proceeding, *i.e.* whether Burton abandoned the FORUM mark. Burton appropriately objected to these RFAs as calling for legal conclusions and otherwise denied them, subject to those objections. See Opp. Ex.-002 (Responses to RFA Nos. 49-54).[3] Schoonover cannot be heard to complain when Burton lodged appropriate objections and made appropriate denials to his RFAs. In any event, Burton's discovery responses bear no relationship to Schoonover's alleged need to disclose an expert and the manner in which he chose to do so.

The Board should give no weight to Schoonover's argument that the Bost Disclosure was necessitated by allegedly deficient discovery responses by Burton. Schoonover never once articulated this rationale in his prior correspondence with Burton's counsel during the meet-and-confer process pertaining to the expert disclosure. See Motion Ex. C. Nor, more significantly, did Schoonover ever engage in any meet-and-confer process regarding Burton's discovery responses, let alone file a motion to compel or seek the intervention of the interlocutory attorney to resolve any discovery issues. Schoonover also elected to forego taking the depositions of Burton or

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[2] Schoonover cites no authority for this novel proposition, and Burton is aware of none.

[3] While RFA No. 28 did not call for a legal conclusion, Burton denied the factual assertion contained therein. Schoonover fails to explain why this denial was not "meaningful."

individual witnesses. Discovery has long since closed, and Schoonover's insistence that Burton is somehow to blame for his failure to timely and properly disclose an expert rings hollow.

III. BOST IS NOT A FACT OR REBUTTAL WITNESS AND HIS EXPERT DISCLOSURE SHOULD BE STRICKEN

Also for the first time in this proceeding, Schoonover advances the possibility—he does not take a firm stance—that Bost is actually a fact or "rebuttal" witness. However, Schoonover claims he ultimately decided to disclose Bost as an expert "in anticipation that [Burton] might object to the Declaration of Toby F. Bost on the basis that he is an expert" and so he decided "to weigh on the side of early disclosure." Opp. 7.[4] Schoonover should not be permitted to move the goalposts in this manner. In serving the Bost Disclosure in April, Schoonover took the position that Bost is an expert. See Motion Ex. A (citing Fed. R. Civ. P. 26(a)(2) and summarizing Bost's "expert" opinions). He cannot change his position in the middle of motion practice and suggest that Bost could be an expert, a fact witness, or possibly both.

To the extent Schoonover wishes to designate Bost a fact witness, he was required to have done so consistent with the discovery schedule. It is far too late to spring a new purported fact witness on Burton. In any event, Bost is not a percipient witness. He only claims to recall hearing about a Burton press release seven years ago and what he remembers thinking about it at the time. Opp. 6 ("Bost recalls receiving the news and what it meant to him at the time"). Bost plainly lacks any personal, first-hand knowledge or observation that would render him a "fact witness" under Rule 701(a).

For the reasons stated in Burton's Motion, if Bost is an expert, Schoonover was required to serve an expert report consistent with Rule 26(a)(2)(B) because Bost had no "on-the-scene"

[4] The record, however, does not support the conclusion that he has ever "weigh[ed] on the side of early disclosure." Schoonover served the deficient Bost Disclosure on April 19, 2019—the last day under the discovery schedule. He refused to serve a report despite multiple requests from Burton that he do so, as required by Rule 26. He has now served a new Declaration three months after the deadline. During this three-month period, the content and purported bases for Bost's opinions have changed on multiple occasions.

involvement in any incidents giving rise to this litigation. He is therefore a "retained" expert (if even that), regardless of whether he is being compensated in this role. See RTX Sci., Inc. v. Nu-Calgon Wholesaler, Inc., 2013 WL 3168102 (TTAB Mar. 22, 2013); Innogenetics, N.V. v. Abbott Laboratories, 512 F.3d 1363, 1375, 85 USPQ2d 1641, 1649-50 (Fed. Cir. 2008).[5] For three months, Schoonover has failed to provide an expert report to Burton, and he persists in this refusal. Opp. 9 ("No expert report is available, and thus none has been provided.").[6]

The prejudice to Burton from this pattern of conduct is severe. Had Schoonover served an expert report, Burton could have responded accordingly, including by taking discovery and/or challenging the admissibility of Bost's opinions under Rule 702. Instead, the past three months have been consumed by avoidable motion practice in which Schoonover has, on multiple occasions, altered or enlarged Bost's purported expert opinions and reliance material. The July 24, 2019 Bost Declaration is just the latest example. In the meantime, resolution on the merits has been delayed, and this motion practice has occasioned significant and unnecessary expense and cost to Burton. Both the Bost Disclosure and the Bost Declaration should be stricken.

Of concern to Burton is that Schoonover will persist in making untimely and prejudicial disclosures even if Bost's "expert" testimony is precluded. Schoonover has suggested that he may try to use Bost as a fact or rebuttal witness. Opp. 10 ("Bost's declaration should at least be allowed as witness testimony, or rebuttal testimony, should it become necessitated.").[7] Under such circumstances, the appropriate remedy is for the Board to preclude *any* testimony by Bost in order

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[5] Schoonover's reliance on Downey v. Bob's Discount Furniture Holdings, Inc., 633 F.3d 1, 6-7 (1st Cir. 2011) is unavailing. That case involved testimony by an exterminator whose testimony was "premised on personal knowledge and observations made in the course of treatment." Bost has no such personal knowledge or observations.

[6] Burton objects to Schoonover's characterization – in the past tense – that Bost "provided a declaration" to Burton and that it "has been shared" with Burton's counsel. Opp. 8. This can be read to inaccurately suggest that the Bost Declaration was served at some earlier time, when in fact it was served upon Burton on July 25, 2019, together with Schoonover's Opposition.

[7] Schoonover incorrectly discerns "surprising" "admissions" in Burton's argument that Bost's opinions relate to "the meaning of ordinary English words that any lay person is capable of comprehending." Opp. 9 (quoting Motion 2). This is not an admission of anything. It is, instead, a legal argument that Bost's "expert" opinions are improper and inadmissible because, among other reasons, no scientific, technical, or other specialized knowledge is necessary to assist the trier of fact to understand the evidence or determine a fact in issue. Fed. R. Evid. 702.

to prevent further undue prejudice to Burton and undue delay in the adjudication of this proceeding.

CONCLUSION

WHEREFORE, for the foregoing reasons and the reasons stated in its Motion, Burton respectfully requests that the Board GRANT the instant Motion and STRIKE the Bost Disclosure and the Bost Declaration, and preclude any testimony by Bost in this proceeding.

Date: August 8, 2019.

DOWNS RACHLIN MARTIN PLLC

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing document entitled **REGISTRANT'S REPLY IN SUPPORT OF 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 August 8, 2019: LawGroup@CoastalPatent.com

/s/ Jennifer W. Parent
Jennifer W. Parent