

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

January 21, 2020

Cancellation No. 92067794 (parent)

Cancellation No. 92069499

*Joshua S. Schoonover*

*v.*

*The Burton Corporation*

**Rebecca Stempien Coyle, Interlocutory Attorney:**

Now before the Board is Respondent's June 25, 2019, motion to strike Petitioner's disclosure of his unretained expert, or, in the alternative, to compel an expert report.

**1. Preliminary Matters**

Before considering the merits of Respondent's motion, the Board must first address several preliminary matters.

First, Petitioner submitted his notice of designation of the unretained expert under seal, however he did not separately file a copy for public viewing with the confidential portions redacted in accordance with Trademark Rule 2.126(c). Rather, Petitioner attached the redacted version of his submission under seal, as part of the confidential filing.

In view thereof, Petitioner is allowed until **TWENTY DAYS** from the date of this order to submit public copies of his notice of designation with only the confidential

information redacted, failing which the confidential designation may be removed and the filing may be available for public view. Trademark Rule 2.116(g), 37 C.F.R. § 2.116(g).<sup>1</sup>

Second, Petitioner's response, filed on July 25, 2019, was untimely. Trademark Rule 2.127(a). Nevertheless, the Board has exercised its discretion and elected to consider Respondent's motion on the merits, rather than grant it as conceded. *See, e.g., Promgirl Inc. v. JPC Co.*, 94 USPQ2d 1759, 1760 n.1 (TTAB 2009) (Board considered motion on its merits even though late response to motion was not considered); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1854 (TTAB 2000); *Hartwell Co. v. Shane*, 17 USPQ2d 1569, 1570 (TTAB 1990). Petitioner is advised, however, that strict compliance with the Board's deadlines is expected in the future.

Third, Respondent's motion was filed after the close of discovery.<sup>2</sup> Accordingly, to the extent that Respondent moves to compel a written expert report,<sup>3</sup> Respondent's motion is untimely. Trademark Rule 2.120(f)(1).

## **2. Analysis and Determination**

The Board therefore turns to Respondent's motion to strike the expert disclosure of Mr. Bost. Mr. Bost was identified in Petitioner's April 19, 2019, expert disclosure

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<sup>1</sup> The parties are advised that only matter that is truly confidential, such as trade secrets or commercially sensitive information, should be designated confidential, failing which the Board has the authority to "treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party." Trademark Rule 2.116(g), 37 C.F.R. § 2.116(g).

<sup>2</sup> *See* 12 TTABVue 3.

<sup>3</sup> Written reports must accompany the disclosure of a retained expert witness. Fed. R. Civ. P. 26(a)(2)(B), *see also* Trademark Rule 2.120(a)(2)(iii), TBMP § 401.03.

statements as an unretained expert.<sup>4</sup> Respondent argues that because Petitioner's expert disclosure of Mr. Bost did not include the required written report, the disclosure fails to comply with Fed. R. Civ. P 26(a)(2)(B) and Mr. Bost's expert testimony should be precluded. Since Respondent's argument is that Petitioner's timely-served expert disclosure is procedurally deficient, and in the interest of resolving the issue, the Board addresses Respondent's motion to strike at this time.

Pursuant to Petitioner's expert disclosure, Mr. Bost's expected testimony includes: the meaning of certain phrases and words (found in Respondent's press release) in the relevant field, and whether they amount to the cessation of manufacturing and sale of goods; that, "based on and at the time of" a specific press release issued by Respondent, Respondent intended to cease manufacture and sale of the goods; and that, "based on and at the time of" a specific interview by Respondent, those in the relevant field would have understood that Respondent merely intended to preserve rights to its mark.<sup>5</sup>

Petitioner asserts, in the correspondence between the parties, that Mr. Bost "recalls the press release and [Respondent] 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", and "[h]is opinion arises from his 'on-the-scene' involvement as a businessman in the relevant field ... who received an impression from [Respondent's press release] coupled with his familiarity of terms

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<sup>4</sup> 15 TTABVUE 9-11.

<sup>5</sup> *Id.* at 9-10.

and phrases of art in the relevant field.”<sup>6</sup> Petitioner also stated in this correspondence that Mr. Bost’s “opinions do not arise from being hired, or review of the record, except for the press release as a refresh”, he has no interest in the outcome of the proceeding, and is not compensated.<sup>7</sup>

While both retained and unretained experts must be disclosed, only retained experts are required to provide a report. Fed. R. Civ. P. 26(a)(2); TBMP § 401.03. An expert is retained for purposes of Fed. R. Civ. P. 26(a)(2)(B) “[w]here an expert’s testimony arises from his enlistment as an expert and not from an on-the-scene involvement in any incidents giving rise to the litigation.” *RTX Scientific Inc. v. Nucalgon Wholesaler Inc.*, 106 USPQ2d 1492, 1495 (TTAB 2013). “In tort and personal injury cases, the on-the-scene involvement of an expert not required to provide a written report typically arises from the expert’s participation, in some way, in the ongoing sequence of events that gave rise to the litigation in question. *Id.* However, in Board inter partes proceedings, “there are usually no specific incidents” and “an expert is typically recruited on the basis of experience in the relevant trade or industry.” *Id.*

Neither Petitioner’s disclosure nor the supplemental explanation in his correspondence to Respondent indicate that Mr. Bost had on-the-scene involvement in any incident giving rise to this proceeding. Mr. Bost’s impressions of Respondent’s press release at the time he encountered it is insufficient to convert Mr. Bost into an unretained expert. As an initial matter, Petitioner’s correspondence does not indicate

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<sup>6</sup> *Id.* at 16.

<sup>7</sup> *Id.*

when Mr. Bost encountered the press release, nor did Petitioner contend that Mr. Bost recalled or had a prior impression of Respondent's interview. Moreover, there is no indication that Mr. Bost had any involvement in Respondent's press release or interview, Respondent's alleged decision to cease manufacturing and selling products under the involved mark, or any involvement in Respondent's business in any way. To the contrary, Petitioner's disclosure indicates that Mr. Bost is expected to provide a typical expert opinion on how the relevant industry would understand the press release and interview. *See RTX Scientific Inc.*, 106 USPQ2d at 1495. As such, Mr. Bost is a retained expert witness,<sup>8</sup> and Petitioner's expert disclosure is deficient due to the lack of a written report for Mr. Bost, as required by Fed. R. Civ. P. 26(a)(2)(B).

The provisions regarding the timing of expert disclosures are intended to facilitate the taking of any necessary discovery by any party or parties adverse to the disclosing party, in regard to the proposed expert witness, and to allow the adverse party or parties to determine whether it will be necessary to rely on a rebutting expert. *See General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 (TTAB 2011); *see also* TBMP § 401.03. A party that has made a disclosure must supplement or correct its disclosure in a timely manner if the party learns that in some material respect the disclosure is incomplete or incorrect (provided the corrective information has not otherwise been made known to the other party or parties during the discovery process or in writing). Fed. R. Civ. P. 26(e)(1).

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<sup>8</sup> The fact that Mr. Bost is not being compensated is not controlling. *Id.* at 1496 (citing *Innogenetics, N.V. v. Abbott Laboratories*, 512 F.3d 1363, 1375, 85 USPQ2d 1641, 1649-50 (Fed. Cir. 2008)).

*See also* Fed. R. Civ. P. 26(e)(2) (any additions or changes to information included in an expert report must be disclosed by the time the party's pretrial disclosures are due). Any information not disclosed in a timely manner pursuant to Fed. R. Civ. P. 26 may not be used as evidence at trial "unless the failure was substantially justified or harmless." Fed. R. Civ. P. 37(c)(1).

However, it is not the Board's policy to exclude the testimony to be proffered by a timely disclosed expert witness when there has been supplementation of the deficient expert disclosure. *See General Council of the Assemblies of God*, 97 USPQ2d at 1893; *see also* TBMP § 533.02(b). Accordingly, the Board will allow Petitioner an opportunity to cure the deficiency in its timely-served expert disclosure.

### **3. Summary and Suspension of Proceedings**

In view of the foregoing, Respondent's motion to strike Petitioner's expert disclosure of Mr. Bost is **granted**. Notwithstanding, Petitioner is allowed **THIRTY DAYS** from the date of this order to supplement his expert disclosure of Mr. Bost curing the defects as noted herein, and to file a notice with the Board indicating whether he has cured the defects in his expert disclosure.<sup>9</sup>

Proceedings otherwise remain **suspended** pending Petitioner's notification to the Board, at which time the Board will reset dates, beginning with an opportunity for Respondent to take a discovery deposition of Petitioner's expert witness and to obtain a rebuttal expert witness, should it so desire.

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<sup>9</sup> Petitioner should not file with the Board copies of the materials provided to Respondent. *See RTX Scientific Inc.*, 106 USPQ2d at 1493 n. 3; *see also* TBMP § 401.03.