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

Proceeding	92068068
Party	Defendant Insight Energy Ventures LLC DBA Powerley
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Attachments	Registrants Reply in Support of Its Motion to Exclude Declaration of Eric J. Ball in Support of Petitioner Pure Storage Incs Motion.pdf(219516 bytes)

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

In re Trademark of:

Registrant: Insight Energy Ventures LLC dba Powerley
Registration No. 5,156,080
Registration Date: March 7, 2017
Mark: P (Stylized/Design)

PURE STORAGE, INC.,

Plaintiff/Petitioner,

v.

Cancellation No. 92068068

INSIGHT ENERGY VENTURES LLC
DBA POWERLEY,

Defendant/Registrant.

**REGISTRANT’S REPLY IN SUPPORT OF ITS MOTION TO EXCLUDE
DECLARATION OF ERIC J. BALL IN SUPPORT OF PETITIONER PURE STORAGE,
INC.’S MOTION FOR PARTIAL SUMMARY JUDGEMENT UNDER RULE 37(C)**

Registrant, Insight Energy Ventures LLC dba Powerley (“Powerley”), respectfully requests that the Board grant its Motion to Exclude the Declaration of Eric J. Ball in Support of Petitioner Pure Storage, Inc.’s (“Pure Storage”) Motion for Partial Summary Judgment under Rule 37(c) of the Federal Rules of Civil Procedure (“FRCP”) and submits this Reply in support of its motion.

I. INTRODUCTION

Petitioner’s failure to cooperate in discovery is due to willfulness, bad faith, or fault. Petitioner failed to disclose attorney Eric J. Ball as a fact witness to introduce documents in support of its dispositive Motion for Partial Summary Judgment. Petitioner never supplemented its initial disclosures to add attorney Eric J. Ball as a fact witness. Registrant was both surprised and prejudiced by attorney Eric J. Ball as both legal advocate and fact witness to introduce facts

and documents in support of Petitioner Pure Storage, Inc.'s Motion for Partial Summary Judgment. The failure to identify or supplement by Petitioner were not substantially justified nor harmless and the documents in support of its dispositive Motion for Partial Summary Judgment are automatically excluded under FRCP Rule 37(c). Contrary to Petitioner, FRCP Rule 37(c) applies not only at trial but also to any motion, such as a motion for summary judgment, to automatically exclude both information not disclosed and witnesses not disclosed. The question here is whether the Declaration of Eric J. Ball and the documents attached thereto are automatically excluded for violating FRCP Rule 26(a) and (e). The answer is yes.

Petitioner attempts to confuse the issue by citing to TBMP § 528.05 in support of its documents attached to the Declaration of Eric J. Ball, but fails to cite Rule 37(c) that automatically excludes such declaration and documents as a sanction for failing to identify attorney Eric J. Ball as a fact witness and identify the documents attached to the Declaration of Eric J. Ball. Therefore, the Board should grant Registrant's Motion to Exclude Declaration of Eric J. Ball in Support of Petitioner Pure Storage, Inc.'s Motion for Partial Summary Judgment under Rule 37(c).

II. FACTUAL BACKGROUND

FRCP Rule 26(a) requires Petitioner to identify witnesses and documents that may be used to support Petitioner's claims and applies to motions for summary judgment. In Petitioner's Initial Disclosures, Petitioner identified only Jason Nadeau as a fact witness who had information and an expert witness to be identified later. *See* Declaration of James Bumbaugh in Support of Registrant's Motion and Brief to Exclude Declaration of Eric J. Ball in Support of Petitioner Pure Storage, Inc.'s Motion for Partial Summary Judgment under Rule 37(c) ("Bumbaugh Decl."), Ex. B. Eric J. Ball was never identified as a fact witness or an expert

witness. *See* Bumbaugh Decl. Petitioner never supplemented Petitioner's Initial Disclosure to add attorney Eric J. Ball as a fact witness or expert witness. *See* Bumbaugh Decl. Eric J. Ball is an attorney who represents Petitioner and filed Petitioner Pure Storage, Inc.'s Motion for Partial Summary Judgement. While Registrant received notice that attorney Eric J. Ball filed an appearance representing Petitioner two days before the close of discovery, Registrant never received notice that attorney Eric J. Ball would be a fact witness and was surprised by the Declaration of Eric J. Ball as a fact witness to submit both facts and documents in support of Petitioner Pure Storage, Inc.'s Motion for Partial Summary Judgment. Petitioner's surprise attempt to introduce an undisclosed fact witness and documents that were never previously identified was due to willfulness, bad faith, or fault of Petitioner and the Declaration of Eric J. Ball should be excluded for Petitioner Pure Storage, Inc.'s Motion for Partial Summary Judgement.

III. REGISTRANT'S MOTION TO EXCLUDE DECLARATION OF ERIC J. BALL SHOULD BE GRANTED BECAUSE PETITIONER FAILED TO IDENTIFY ATTORNEY ERIC J. BALL AS A WITNESS, RULE 37(C) AUTOMATICALLY APPLIES TO SUCH FAILURE, AND THE FAILURE IS NOT JUSTIFIED AND IS HARMFUL TO REGISTRANT

The Board should grant Registrant's Motion to Exclude the Declaration of Eric J. Ball for the following reasons: (1) attorney Eric J. Ball was not identified as a fact or expert witness in Petitioner's initial disclosures or in any supplemental disclosures; (2) FRCP Rule 37 (c) automatically excludes both witnesses not disclosed and the documents in support of Petitioner Pure Storage, Inc.'s Motion for Partial Summary Judgment; and (3) Petitioner's failure to use Jason Nadeau as a fact witness who had information and to use the Declaration of Eric J. Ball as a fact witness to support Petitioner Pure Storage, Inc.'s Motion for Partial Summary Judgment

was not substantially justified nor harmless and the documents attached in support of its dispositive Motion for Partial Summary Judgement should be excluded under FRCP Rule 37(c).

A. Petitioner was Required to Identify Attorney Eric J. Ball as a Fact Witness and Identify the Documents Attached to the Declaration of Eric J. Ball as Required under Rule 26(a) and (e)

FRCP Rule 26(a) lists mandatory disclosures that must be made even in the absence of a request from the opposing party. These disclosures include the identification of witnesses and documents that may be used to support the disclosing parties' claims or defenses, computations of damages, and insurance agreements. Fed. R. Civ. P. 26(a)(1)(A). In addition, FRCP Rule 26(e) imposes a duty to supplement a Rule 26(a) initial disclosure or a response to an interrogatory "in a timely manner if the party learns that in some material respect the disclosure or response is incomplete or incorrect." Fed. R. Civ. P. 26(e); *Colon-Millin v. Sears Roebuck De Puerto Rico, Inc.*, 455 F.3d 30, 37 (1st Cir. 2006) ("[A] party must supplement its answers to interrogatories if the party learns that the response is in some material respect incomplete or incorrect and the other party is unaware of the new or corrective information."). The duty to supplement discovery responses is ongoing, and failure to supplement responses adequately can result in the exclusion of the untimely disclosed information. A "party may not free itself of the burden to fully comply" with the obligation to supplement by placing "a heretofore unrecognized duty of repeated requests for information on its adversary." *Arthur v. Atkinson Freight Lines Corp.*, 164 F.R.D. 19, 20 (S.D.N.Y. 1995) (discussing duty to supplement under Rule 26(e)). The duty to supplement applies whether the corrective information is learned by the client or the attorney and extends not only to newly discovered evidence but also to information that was not originally provided even though it was available at the time of the initial disclosure or response. *Am. Friends of Yeshivat Ohr Yerushalayim, Inc. v. United States*, 2009 WL 1617773, at *5

(E.D.N.Y. June 9, 2009). In addition, the duty to supplement continues even after the discovery period has closed. *See, e.g., McKinney v. Connecticut*, 2011 WL 166199, at *2 (D. Conn. Jan. 19, 2011) (noting that the “fact that discovery has closed has no bearing on [the d]efendant’s duty to supplement under Rule 26(e)”). Thus, if newly discovered evidence is offered at trial or at summary judgment, a party may seek to exclude the evidence on the grounds that the proponent had a duty to supplement its discovery responses and that its failure to do so resulted in prejudice. *See, e.g., Net 2 Press, Inc. v. 58 Dix Ave. Corp.*, 266 F. Supp. 2d 146, 161 (D. Me. 2003) (“While supplementation of interrogatory answers may be allowed under some circumstances, it should not be allowed after the filing of dispositive motions and on the eve of trial.” “It makes no sense . . . to allow the plaintiff to avoid summary judgment by placing the necessary information in an affidavit submitted in opposition to the defendants’ motion for summary judgment.”).

Petitioner had a mandatory disclosure requirement for the identification of witnesses and documents that may be used to support Petitioner’s claims even if offered at summary judgement. Once again, attorney Eric J. Ball was never identified as a fact witness or an expert witness. *See Bumbaugh Decl.* Petitioner never supplemented Petitioner’s Initial Disclosure to add attorney Eric J. Ball as a fact witness or expert witness. Petitioner had the responsibility to supplement its disclosures to identify attorney Eric J. Ball as a fact witness. The duty to supplement continued after the close of discovery and Petitioner’s failure results in prejudice to Registrant since the Declaration of Eric J. Ball was submitted with the filing of a dispositive motion. Petitioner’s failure to identify attorney Eric J. Ball as a fact witness was untimely and the documents attached to the Declaration of Eric J. Ball were untimely disclosed to Registrant to support Petitioner Pure Storage, Inc.’s Motion for Partial Summary Judgement. Petitioner’s

failure to cooperate in discovery is due to willfulness, bad faith, or fault and Petitioner's failure results in prejudice to Registrant.

B. Rule 37(c) Automatically Excludes the Declaration of Eric J. Ball and the Documents Attached Thereto for Failure to Disclose Information Required

FRCP Rule 37(c) sanctions apply to failures to disclose information required by FRCP Rule 26(a), as well as to failures to supplement discovery responses in accordance with FRCP Rule 26(e). The automatic exclusion sanction of material not disclosed pursuant to Rule 26(a) was added by the 1993 amendments to the rule. In 2000, a subsequent amendment made the same remedy available for material that should have been disclosed in discovery responses.

The adoption of Federal Rule of Civil Procedure 37(c)(1) in 1993 “gave teeth to a significantly broadened duty” to comply with discovery obligations. Chief among the sanctions provided by Rule 37(c) for failure to timely disclose materials in discovery is the exclusion of the undisclosed information. The rule is said to be automatic, or self-executing, because a court may exclude undisclosed evidence even if no motion to compel has been brought. There is no meet-and-confer requirement prior to bringing a motion to exclude evidence under Rule 37(c). *See, e.g., Fulmore v. Home Depot, U.S.A., Inc.*, 423 F. Supp. 2d 861, 871–72 (S.D. Ind. 2006) (“The Advisory Committee Notes to both the 1993 and 2000 Amendments to Rule 37 make clear that Rule 37(c) operates independent of any motion required by Rule 37(a). Rule 37(c) simply does not require conferral.”). The rule applies not only at trial but also to any motion, such as a motion for summary judgment, or a hearing. It applies both to information not disclosed and to witnesses.

1. The Declaration of Eric J. Ball is Automatically Excluded

Petitioner failed to identify or supplement its initial disclosures to identify attorney Eric J. Ball as a fact witness before filing its dispositive Motion for Partial Summary Judgment. FRCP

Rule 26(a) and (e) requires the identification of witnesses and documents that may be used to support the disclosing parties' claims even for summary judgment. FRCP Rule 37(c) sanctions apply to failures to disclose information required by Rule 26(a), as well as to failures to supplement discovery responses in accordance with Rule 26(e). The rule applies to any motion, such as a motion for summary judgment and applies both to information not disclosed and to witnesses.

Attorney Eric J. Ball was not identified as a fact witness. Petitioner's failure to identify attorney Eric J. Ball as a fact witness is not substantially justified and is due to willfulness, bad faith, or fault of Petitioner. Petitioner's failure to cooperate in discovery to identify attorney Eric J. Ball as a fact witness and not allow Registrant the opportunity to depose attorney Eric J. Ball is harmful to Registrant. Under FRCP Rule 37(c), the Declaration of Eric J. Ball is automatically excluded to introduce facts and documents in support of Petitioner Pure Storage, Inc.'s Motion for Partial Summary Judgment.

2. Documents Attached to the Declaration of Eric J. Ball are Automatically Excluded

FRCP Rule 26(a) and (e) requires the identification of documents that may be used to support the disclosing parties' claims even for summary judgment. FRCP Rule 37(c) for failure to timely disclose materials in discovery is the exclusion of the undisclosed information or documents. The rule is said to be automatic, or self-executing, because a court may exclude undisclosed evidence even if no motion to compel has been brought.

Petitioner attempts to confuse the issue of admissibility of the documents by citing to TBMP § 528.05. However, the issue here is whether documents attached to the Declaration of Eric J. Ball are automatically excluded for Petitioner violating Rule 26(a) and (e). The Petitioner attempts to assert that these documents were available during discovery. However, the

documents attached to the Declaration of Eric J. Ball were never identified or produced to Registrant. In fact, Petitioner admits that on page 10 of its Opposition brief that the documents as evidenced by their date stamps were collected by attorney Eric J. Ball shortly before filing Petitioner Pure Storage, Inc.'s Motion for Partial Summary Judgement. Petitioner's failure to identify the documents attached to the Declaration of Eric J. Ball is not substantially justified and is due to willfulness, bad faith, or fault of Petitioner. Petitioner's failure to cooperate in discovery to identify the documents attached to the Declaration of Eric J. Ball did not allow Registrant sufficient time to review and challenge these documents and is harmful to Registrant. Under FRCP Rule 37(c), the documents attached to the Declaration of Eric J. Ball are automatically excluded in support of Petitioner Pure Storage, Inc.'s Motion for Partial Summary Judgment.

C. The Failure of Petitioner to Identify Attorney Eric J. Ball as a Fact Witness is Not Justified and is Harmful to Registrant

Petitioner attempts to make its willful failure to identify attorney Eric J. Ball as a fact witness justified and harmless. The factors a court may consider in determining whether the nondisclosure is justified or harmless include prejudice or surprise to the party against whom the evidence is offered, the ability of the party to cure the prejudice, the likelihood of disruption to the trial, and bad faith or willfulness involved in not disclosing evidence at an earlier date. *Woodworker's Supply, Inc. v. Principal Mut. Life Ins. Co.*, 170 F.3d 985, 993 (10th Cir. 1999); *see also David v. Caterpillar, Inc.*, 324 F.3d 851 (7th Cir. 2003) (same); *MicroStrategy, Inc. v. Bus. Objects, S.A.*, 429 F.3d 1344 (Fed. Cir. 2005) (applying five-factor test); *Macaulay v. Anas*, 321 F.3d 45, 51 (1st Cir. 2003) (factors to consider include "the history of the litigation, the proponent's need for the challenged evidence, the justification (if any) for the late disclosure, and the opponent's ability to overcome its adverse effects."). *See also Gagnon v. Teledyne Princeton*,

Inc., 437 F.3d 188, 197 (1st Cir. 2006) (noting that the advisory committee notes to the 1993 amendments to Rule 37(c) “suggest a fairly limited concept of ‘harmless’”). However, all factors weigh in favor of Registrant and not Petitioner.

1. There was Surprise to Registrant

Contrary to Petitioner, Registrant was surprised that attorney Eric J. Ball would act as both legal advocate and fact witness in support of Petitioner Pure Storage, Inc.’s Motion for Partial Summary Judgment. Registrant never had notice and did not know that attorney Eric J. Ball would be acting as a fact witness and would introduce documents to support Petitioner’s Motion for Partial Summary Judgment. Registrant did not know about each of the documents attached to the Declaration of Eric J. Ball and Petitioner never identified nor produced these documents to Registrant prior to filing Petitioner Pure Storage, Inc.’s Motion for Partial Summary Judgment. Petitioner willfully and in bad faith failed to identify attorney Eric J. Ball as a fact witness to surprise Registrant. Therefore, this factor weighs in Registrant’s favor.

2. Registrant did Not Have Time to Cure Any Surprise

Registrant did not have time to cure the surprise of attorney Eric J. Ball as a fact witness. Registrant did not have time to depose attorney Eric J. Ball during discovery because he was not identified as a fact witness. Due to the surprise of attorney Eric J. Ball as a fact witness, Registrant sought to exclude the Declaration of Eric J. Ball on the grounds that Petitioner had a duty to supplement its discovery responses and that its failure to do so resulted in prejudice. *See, e.g., Net 2 Press, Inc. v. 58 Dix Ave. Corp.*, 266 F. Supp. 2d 146, 161 (D. Me. 2003) (“While supplementation of interrogatory answers may be allowed under some circumstances, it should not be allowed after the filing of dispositive motions and on the eve of trial.” “It makes no sense .

. . . to allow the plaintiff to avoid summary judgment by placing the necessary information in an affidavit submitted in opposition to the defendants' motion for summary judgment.”).

Since Petitioner filed its dispositive Motion for Partial Summary Judgment, Registrant had to use its time period drafting its Brief in Opposition to Petitioner's Pure Storage, Inc.'s Motion for Partial Summary Judgment. Petitioner seeks to avoid the sanctions imposed by FRCP Rule 37(c) by putting the burden on Registrant to cure Petitioner's surprise in having attorney Eric J. Ball to act as a fact witness to introduce documents to support its dispositive Motion for Partial Summary Judgment. Contrary to Petitioner, Registrant was not required to file a motion under FRCP 56(d) to cure the willful and bad faith surprise of Petitioner. In fact, Petitioner was required under the mandatory disclosure of FRCP Rule 26(a) and (e) to identify fact witnesses and documents prior to filing its dispositive Motion for Partial Summary Judgment. Therefore, this factor weighs in Registrant's favor.

3. Excluding the Declaration of Eric J. Ball will Not Disrupt the Trial

Excluding the Declaration of Eric J. Ball will not negatively affect trial. Petitioner does not argue nor does it cite any evidence of possible disruption at trial by excluding the Declaration of Eric J. Ball. While the exclusion of the Declaration of Eric J. Ball may prevent the Board from granting Petitioner Pure Storage, Inc.'s Motion for Partial Summary Judgment, Petitioner would not suffer jury prejudice and would be able to introduce evidence at trial through their identified fact witness Jason Nadeau. Therefore, this factor weighs in Registrant's favor.

4. Declaration of Eric J. Ball is Not Important for Summary Judgement

The Declaration of Eric J. Ball is not important for summary judgement. If the Board denies Petitioner Pure Storage, Inc.'s Motion for Partial Summary Judgment, the proceeding will continue to trial and Petitioner can then use its identified fact witness Jason Nadeau to

introduce documents into evidence during its testimony period. Therefore, this factor weighs in favor of Registrant.

5. Explanation for Not Disclosing Attorney Eric J. Ball as a Fact Witness is Not Adequate Nor Justified

Petitioner could have supplemented its initial disclosures to identify attorney Eric J. Ball as a fact witness prior to filing its dispositive Motion for Partial Summary Judgement. Petitioner could have also identified and produced the documents to Registrant prior to filing its dispositive Motion for Partial Summary Judgment. Instead, Petitioner willfully acted in bad faith by failing to identify either before filing its dispositive Motion for Partial Summary Judgement. Petitioner make excuses for its failure to identify and attempts to somehow state that Registrant was given notice about documents that Petitioner never identified nor produced to Registrant. In fact on page 10 of its Opposition brief, Petitioner admits that the documents were collected by attorney Eric J. Ball shortly before filing Petitioner Pure Storage, Inc.'s Motion for Partial Summary Judgement. Petitioner acted in bad faith to surprise Registrant with the Declaration of Eric J. Ball and the documents attached thereto to support Petitioner Pure Storage, Inc.'s Motion for Partial Summary Judgement knowing that Registrant would not be in position to depose attorney Eric J. Ball or challenge the documents attached to the Declaration of Eric J. Ball. Petitioner has failed to adequately explain why it did not identify attorney Eric J. Ball as a fact witness or identify and produce the documents that were collected after the close of discovery and attached to the Declaration of Eric J. Ball. Therefore, this factor weighs in favor or Registrant. Thus, the Board should grant Registrant's Motion to Exclude the Declaration of Eric J. Ball under Rule 37(c).

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IV. CONCLUSION

Since Petitioner failed to identify attorney Eric J. Ball as a fact witness as required by FRCP Rule 26(a) or (e), Rule 37(c) automatically excludes the Declaration of Eric J. Ball and the documents attached thereto to support Petitioner Pure Storage, Inc.'s Motion for Partial Summary Judgment. Because Petitioner's failure was not justified nor harmless and prejudicial to Registrant, Registrant requests that the Board grant Registrant's Motion to Exclude the Declaration of Eric J. Ball in Support of Petitioner Pure Storage, Inc.'s Motion for Partial Summary Judgment under Rule 37(c) and deny Petitioner Pure Storage, Inc.'s Motion for Partial Summary Judgment, dismiss the cancellation proceeding, or render a judgment by default against the disobedient Petitioner for willfully failing to cooperate in discovery.

Respectfully submitted,

HOWARD & HOWARD ATTORNEYS
PLLC

Dated: July 12, 2019

By: /Daniel H. Bliss/

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true, correct, and complete copy of the foregoing REGISTRANT’S REPLY IN SUPPORT OF ITS MOTION TO EXCLUDE DECLARATION OF ERIC J. BALL IN SUPPORT OF PETITIONER PURE STORAGE, INC.’S MOTION FOR PARTIAL SUMMARY JUDGMENT UNDER RULE 37(C) has been served upon all parties, via electronic mail at their email address of record on this date.

Date: July 12, 2019 By: /Daniel H. Bliss/
Daniel H. Bliss