

UNITED STATES PATENT AND TRADEMARK OFFICE  
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JMM

June 25, 2020

Cancellation No. 92068068

*Pure Storage, Inc.*

*v.*

*Insight Energy Ventures LLC DBA Powerley*

**Jill M. McCormack, Interlocutory Attorney:**

This case comes before the Board for consideration of Respondent's motion, filed December 19, 2019, to strike portions of Petitioner's pretrial disclosures and to exclude subsequently-filed testimony and documents based on Petitioner's failure to timely supplement its initial disclosures. The motion is fully-briefed.<sup>1</sup>

**I. Background**

On July 2, 2018, Petitioner served its initial disclosures, identifying Jason Nadeau, Petitioner's Vice President of Product Marketing at the time, as an individual knowledgeable about the following topics:

Selection and first and continued use of Petitioner's marks including its stylized P logo; advertising related to the marks; press coverage related to the marks; press releases related to the marks; goods and services offered under the marks; sales records of goods and services offered under the marks; history of formation and ownership of Petitioner; Petitioner's target consumers and trade channels.

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<sup>1</sup> Petitioner's consent motion, filed January 7, 2020, to extend time to respond to Respondent's motion to strike is granted. *See* Trademark Rule 2.127(a).

(26 TTABVUE 17). Petitioner also identified the following categories of documents that may be used to support its claims or defenses: (i) documents evidencing Petitioner's services offered under its trademarks; (ii) documents relating to use, advertising, sales, and marketing of the trademarks by Petitioner; and (iii) documents related to press coverage, accolades, recognition, and awards related to Petitioner's use of its trademarks. (*Id.* at 18).

During discovery, Respondent did not depose Mr. Nadeau, (29 TTABVUE 4), and discovery closed on March 17, 2019. (11, 12 TTABVUE). On April 30, 2019, proceedings were suspended through December 3, 2019, pending a decision on Petitioner's motion for summary judgment. (14 TTABVUE). During the suspension period, on October 11, 2019, Petitioner served supplemental initial disclosures with several changes from Petitioner's initial disclosures, three of which are relevant to the instant motion. First, Petitioner removed Mr. Nadeau and added Petitioner's employee, Matt Kixmoeller, as an individual knowledge about the following topics:

Pure Storage's rights in the stylized P logo registrations (collectively, the "P Logo"); the likelihood of confusion between Pure Storage's P Logo and Registrant's P logo; Pure Storage's use and promotion of the P Logo, including the types of goods and services offered by Pure Storage under the P Logo; Pure Storage's users and/or purchasers of goods and services offered with the P Logo; Pure Storage's channels of trade in which the P Logo is used or promoted; selection of Pure Storage's P Logo; first use of Pure Storage's P Logo; press coverage related to Pure Storage's P Logo; press releases related to Pure Storage's P Logo; sales records of goods and services offered under Pure Storage's P Logo; and history of formation and ownership of Pure Storage's P Logo.

(26 TTABVUE 23). Second, Petitioner added a "corporate representative" of Respondent as an individual knowledgeable about a number of topics. (*Id.* at 24).

Third, Petitioner revised the categories of documents that may be used to support its

claims or defenses to: (i) documents sufficient to show Petitioner's rights in the P Logo; (ii) documents sufficient to show the likelihood of confusion between Petitioner's P Logo and Respondent's P logo; (iii) documents sufficient to show Petitioner's use, promotion, marketing, and sales under the P Logo; (iv) documents sufficient to show Petitioner's goods and services under its P Logo; and (v) documents sufficient to show press coverage, accolades, recognition, and awards related to Pure Storage's use of the P Logo. (*Id.* at 25).

On October 25, 2019, Respondent sent Petitioner a letter acknowledging receipt of Petitioner's supplemental initial disclosures and lodging an objection to the (i) addition of Mr. Kixmoeller; (ii) the addition of a corporate representative of Respondent; and (iii) the addition of documents sufficient to show Petitioner's rights in the P Logo, the likelihood of confusion between Petitioner's P Logo and Respondent's P logo, and Petitioner's goods offered under its P Logo. (*Id.* at 30).

On December 3, 2019, the Board granted, in part, and denied, in part, Petitioner's motion for summary judgment and reset the deadline for Petitioner's pretrial disclosures to December 6, 2019. (25 TTABVUE 9). On that date, Petitioner served its pretrial disclosures, identifying as it had in its supplemental initial disclosures, Matt Kixmoeller and a "corporate representative" of Respondent as witnesses. (26 TTABVUE 34–41). Petitioner also identified the list of subjects on which these witnesses were expected to testify, and a list of the types of documents and things which may be introduced as exhibits during the testimony of these witnesses. (*Id.*)

On December 19, 2019, Respondent moved to strike the portions of Petitioner's

pretrial disclosures that Respondent objected to in its October 25, 2019 letter, namely, the identification of Matt Kixmoeller as a witness, the identification of a corporate representative of Respondent as a witness, and any mention of documents sufficient to show Pure Storage's rights in the P Logo, documents sufficient to show the likelihood of confusion between Pure Storage's P Logo and Registrant's P Logo, and documents sufficient to show Pure Storage's goods offered under its P Logo. (26 TTABVUE 2). Respondent also requests that the Board preclude Petitioner from submitting testimony from Mr. Kixmoeller or a corporate representative of Respondent, and from relying on documents that fall within the objected-to categories. (*Id.* at 12).

## **II. Applicable Legal Principles**

Every party to an inter partes proceeding must serve initial disclosures that identify “each individual likely to have discoverable information ... that the disclosing party may use to support its claims or defenses, unless the use would be solely for impeachment.” Fed. R. Civ. P. 26(a)(1); *see* Trademark Rules 2.116(a) and 2.120(a)(2)(ii), 37 C.F.R. §§ 2.116(a) and 2.120(a)(2)(ii); *Kate Spade LLC v. Thatch, LLC*, 126 USPQ2d 1098, 1100 (TTAB 2018). “Parties are also required to supplement their initial disclosures ‘in a timely manner if the party learns that in some material respect the disclosure or response is incomplete or incorrect and if the additional or corrective information has not otherwise been made known to the other parties during the discovery process or in writing.’” *Kate Spade LLC*, 126 USPQ2d at 1100 (citing Fed. R. Civ. P. 26(e)(1)(A)).

The Board's rules also require service of pretrial disclosures, specifically:

no later than fifteen days prior to the opening of each testimony period . . . the party scheduled to present evidence must disclose the name and, if not previously provided, the telephone number and address of each witness from whom it intends to take testimony, or may take testimony if the need arises, general identifying information about the witness, such as relationship to any party, including job title if employed by a party, or, if neither a party nor related to a party, occupation and job title, a general summary or list of subjects on which the witness is expected to testify, and a general summary or list of the types of documents and things which may be introduced as exhibits during the testimony of the witness.

Trademark Rule 2.121(e), 37 C.F.R. § 2.121(e). Where a party believes the adverse party's pretrial disclosures are insufficient, untimely, or are otherwise technically deficient, judicial economy is best accomplished by bringing such issue to the Board's attention promptly by a motion to quash the deposition or to strike the pretrial disclosures as insufficient before the deposition takes place. *Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239, 1242 (TTAB 2012).<sup>2</sup>

Where evidence is submitted which was not properly disclosed, the party that fails to provide information via disclosure may, upon motion or objection by its adversary, be precluded from using that information or witness at trial, unless the failure was substantially justified or is harmless. Fed. R. Civ. P. 37(c) (1); *Great Seats, Inc. v. Great Seats, Ltd, (Great Seats)*, 100 USPQ2d 1323, 1326–27 (TTAB 2011). The determination whether the failure to disclose is substantially justified or is harmless

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<sup>2</sup> As of January 14, 2017, Trademark Rule 2.123(a)(1), 37 CFR § 2.123(a)(1), was amended to provide that “[t]he testimony of witnesses in inter partes cases may be submitted in the form of an affidavit or a declaration pursuant to § 2.20 and in conformance with the Federal Rules of Evidence, filed during the proffering party's testimony period, subject to the right of any adverse party to elect to take and bear the expense of oral cross-examination . . . .”

involves a five part test: 1) the surprise to the party against whom the evidence would be offered; 2) the ability of that party to cure the surprise; 3) the extent to which allowing the testimony would disrupt the trial; 4) importance of the evidence; and 5) the nondisclosing party's explanation for its failure to disclose the evidence. *Great Seats*, 100 USPQ2d at 1327 (citations omitted).

### **III. Analysis**

#### **A. Corporate Representative of Respondent**

As noted above, Trademark Rule 2.121(e) expressly requires that the party scheduled to present evidence must disclose the name of each witness from whom it intends to take testimony. *See also Jules Jurgensen /Rhapsody Inc. v. Baumberger*, 91 USPQ2d 1443, 1444 (TTAB 2009). Here, Petitioner has not identified the name of a specific witness, but rather a "corporate representative" of Respondent. This does not comply with the procedural requirements of Trademark Rule 2.121(e).<sup>3</sup> Accordingly, Respondent's motion to strike Petitioner's pretrial disclosures with respect to a "corporate representative" of Respondent is granted.

#### **B. Testimony of Matt Kixmoeller**

Respondent contends that the Board should strike Matt Kixmoeller from Petitioner's pretrial disclosures and preclude Petitioner from relying on his testimony because Petitioner did not identify Mr. Kixmoeller as a witness in its original initial

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<sup>3</sup> The Board also notes that a deposition pursuant to Fed. R. Civ. P. 30(b)(6) is a discovery device that is unavailable in the context of testimony depositions. *See Fed. R. Civ. P. 30(b)(6); Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998). "The rules applicable to the Board's proceedings provide no basis for the noticing of a testimony deposition under Rule 30(b)(6)." *Jain*, 49 USPQ2d at 1431.

disclosures and waited until seven months after the close of discovery to serve supplemental initial disclosures. (26 TTABVUE 5). Respondent contends that the failure to identify Mr. Kixmoeller was not substantially justified or harmless, as Respondent was surprised by the identification and has been deprived of the opportunity to seek discovery from Mr. Kixmoeller. (*Id.* at 8).

In response, Petitioner contends that its failure to identify Mr. Kixmoeller earlier in the proceeding was substantially justified and harmless. (29 TTABVUE). Specifically, Petitioner contends that Mr. Nadeau, the employee identified in Petitioner's original initial disclosures, left Petitioner's employment in June 2019, after the close of discovery and while proceedings were suspended pending disposition of Petitioner's motion for summary judgment. (*Id.* at 18). Petitioner argues that "there is no material difference between Mr. Nadeau and Mr. Kixmoeller," and that Respondent "presents no evidence for why the difference in witnesses would suddenly make discovery more desirable or necessary now." (*Id.* at 10). In addition, Petitioner states that it "is not opposed to the Board reopening discovery so [Respondent] can take Mr. Kixmoeller's deposition." (*Id.* at 11).

In its reply, Respondent contends that "Petitioner's failure to cooperate in discovery and surprise Registrant with new fact witnesses and identifying documents after the close of discovery and in [Petitioner's] Pretrial Disclosures is due to willfulness, bad faith, or fault." (30 TTABVUE 2). Specifically, Respondent argues that "Petitioner previously knew about these newly identified fact witnesses and documents before the close of discovery and long before it untimely supplemented and

identified them in pretrial disclosures.” (*Id.*).

With respect to the first and fifth *Great Seats* factors, as noted above, pursuant to Fed. R. Civ. P. 26(a)(1), Petitioner was obligated to disclose “each individual likely to have discoverable information,” but did not list its trial witness Mr. Kixmoeller in its initial disclosures. Although initial disclosures do not require an exhaustive search for all information or potential witnesses that could be used at trial, it would be curious for a trial witness not to have discoverable information.<sup>4</sup> *See Byer California v. Clothing for Modern Times Ltd.*, 95 USPQ2d 1175, 1178 (TTAB 2010). However, after learning that its previously disclosed witness, Mr. Nadeau, was no longer employed by the company, Petitioner served supplemental initial disclosures that identified Mr. Kixmoeller several weeks before serving its pretrial disclosures.<sup>5</sup>

In addition, while the identity of the witness was a surprise, Respondent does not contend that the subject matter of the testimony was a surprise.<sup>6</sup> The disclosed subjects of testimony are set forth below:

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<sup>4</sup> Therefore, if the identity of the witness is known when initial disclosures are made, and the relevant knowledge of the witness is known, then a party may have to disclose the identity of the witness when making initial disclosures, even if the party has no plans at that time to rely on testimony from the witness.

<sup>5</sup> While the Board recognizes that there was a delay between when Petitioner learned of Mr. Nadeau’s departure in June 2019 and when it served its supplemental initial disclosures in October 2019, during the entirety of that time, proceedings were suspended pending disposition of Petitioner’s motion for summary judgment. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 528.03 (2019) (“In addition to tolling the time to respond to outstanding discovery requests, suspension of proceedings tolls the time for parties to make required disclosures.”).

<sup>6</sup> Respondent argues that “Petitioner can still use Mr. Nadeau as a fact witness during its testimony period and does not need to substitute Mr. Kixmoeller.” (30 TTABVUE 6–7).

<b>Petitioner’s Initial Disclosures</b>	<b>Petitioner’s Supplemental Disclosures and Pretrial Disclosures</b>
Jason Nadeau Selection VP, Product Marketing Pure Storage, Inc.	Matt Kixmoeller
Selection and first and continued use of Petitioner’s marks including its stylized P logo; advertising related to the marks; press coverage related to the marks; press releases related to the marks; goods and services offered under the marks; sales records of goods and services offered under the marks; history of formation and ownership of Petitioner; Petitioner’s target consumers and trade channels.	Pure Storage’s rights in the stylized P logo registrations (collectively, the “P Logo”); the likelihood of confusion between Pure Storage’s P Logo and Registrant’s P logo; Pure Storage’s use and promotion of the P Logo, including the types of goods and services offered by Pure Storage under the P Logo; Pure Storage’s users and/or purchasers of goods and services offered with the P Logo; Pure Storage’s channels of trade in which the P Logo is used or promoted; selection of Pure Storage’s P Logo; first use of Pure Storage’s P Logo; press coverage related to Pure Storage’s P Logo; press releases related to Pure Storage’s P Logo; sales records of goods and services offered under Pure Storage’s P Logo; and history of formation and ownership of Pure Storage’s P Logo.

Respondent did not seek to depose Mr. Nadeau, the witness identified in Petitioner’s initial disclosures, during the discovery period, and Respondent does not explain how its inability to seek discovery from Mr. Kixmoeller, after failing to depose Mr. Nadeau is prejudicial.<sup>7</sup> Accordingly, these factors favor Petitioner.

With respect to the fourth *Great Seats* factor, “in determining the importance of the evidence or testimony to the fair adjudication of the proceedings, the Board will consider various factors, including whether the testimony is cumulative or if evidence

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<sup>7</sup> There is no obligation by either party to take discovery in a Board proceeding. However, when moving to strike testimony on the basis that discovery of the witness was unavailable, it is up to Respondent to make the case why failing to seek discovery was appropriate with one witness, but not the other, particularly when Respondent refers to the new witness as a “substitute.” (30 TTABVUE 6–7).

can be introduced by other means, and whether the proposed testimony would be admissible.” *Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239, 1244 (TTAB 2012). Here, Petitioner, as plaintiff, has the burden of proof in this proceeding, and Mr. Kixmoeller is the sole employee of Petitioner identified in its pretrial disclosures. In addition, he is designated to testify on several topics that may be relevant to the Board’s likelihood of confusion analysis. Accordingly, this factor favors Petitioner.

Lastly, with respect to the second and third *Great Seats* factors, Petitioner contends that, to the extent there was surprise to Respondent, such surprise can be cured by reopening discovery or making Mr. Kixmoeller available for deposition during the trial period. (29 TTABVUE 7). In light of the limited nature of such discovery, the Board finds that allowing Mr. Kixmoeller to testify at trial, provided that Respondent first be allowed to take his discovery deposition, will not significantly disrupt trial.<sup>8</sup> Accordingly, these factors slightly favor Petitioner.

Based on all relevant circumstances, and applying the *Great Seats* factors, the Board finds that Petitioner’s failure to identify Mr. Kixmoeller in its initial disclosures was substantially justified or harmless. Accordingly, Respondent’s motion to strike Petitioner’s pretrial disclosures with respect to Mr. Kixmoeller is denied to the extent that Petitioner may rely on testimony from Mr. Kixmoeller, provided that Respondent has an opportunity to take Mr. Kixmoeller’s discovery deposition prior to

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<sup>8</sup> Respondent filed its motion to strike prior to the start of Petitioner’s trial period and proceedings were subsequently suspended. (26, 27 TTABVUE). Moreover, because Petitioner supplemented its initial disclosures to identify Mr. Kixmoeller in October, Respondent could have moved to reopen discovery for the limited purpose of taking the discovery deposition of Mr. Kixmoeller following the Board’s order denying Petitioner’s motion for summary judgment.

trial.<sup>9</sup> Respondent is allowed **forty-five days** from the date of this order to take such a discovery deposition.<sup>10</sup>

### **C. Objected-To Categories of Documents**

Respondent contends that Petitioner should be precluded from relying on any documents at trial that fall into three categories of documents that appear in Petitioner's supplemental initial disclosures, but not its original initial disclosures: (i) documents sufficient to show Petitioner's rights in the P Logo; (ii) the likelihood of confusion between Petitioner's P Logo and Respondent's P logo; and (iii) and Petitioner's goods offered under its P Logo. The Board construes Respondent's request as a motion in limine to exclude evidence that Petitioner might offer at trial.

To the extent Respondent is seeking an order prohibiting Petitioner from offering as evidence, in the future, information or documents, the Board will not make prospective or hypothetical evidentiary rulings and will not screen a party's evidence before trial. *See Greenhouse Sys. Inc. v. Carson*, 37 USPQ2d 1748, 1750 (TTAB 1995) ("It is not the Board's practice to make prospective or hypothetical evidentiary rulings such as those requested by applicant, nor will the Board undertake to screen all of opposer's proffered evidence to see whether it might fall within one of applicant's suggested categories of excludable evidence."); TBMP § 527.01(f) ("[T]he Board will deny a motion to prospectively exclude evidence that might be introduced at trial and

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<sup>9</sup> Respondent may forego such a discovery deposition if it so chooses.

<sup>10</sup> The parties should confer as soon as possible to discuss their options for moving forward with Mr. Kixmoeller's deposition. In particular, in light of travel disruptions from the current COVID-19 pandemic, the parties should discuss whether Respondent wishes to take the deposition by video teleconference, telephone or similar acceptable means. *See, e.g., Hewlett-Packard Co. v. Healthcare Personnel Inc.*, 21 USPQ2d 1552, 1553 (TTAB 1991).

that might be inconsistent with discovery responses or other material not provided during discovery.”).

Accordingly, Respondent’s motion to strike as to the above-objected-to categories of documents is denied. The parties are referred to TBMP § 707 for the timing and procedure for raising objections to trial evidence.

#### **IV. Proceeding Schedule**

Proceedings are resumed. Discovery is hereby reopened for the sole purpose of Respondent’s taking the deposition of Mr. Kixmoeller. Remaining dates are reset as follows:

Discovery Solely For Deposition Closes	8/10/2020
Plaintiff’s 30-day Trial Period Ends	11/8/2020
Defendant’s Pretrial Disclosures Due	11/23/2020
Defendant’s 30-day Trial Period Ends	1/7/2021
Plaintiff’s Rebuttal Disclosures Due	1/22/2021
Plaintiff’s 15-day Rebuttal Period Ends	2/21/2021
Plaintiff’s Opening Brief Due	4/22/2021
Defendant’s Brief Due	5/22/2021
Plaintiff’s Reply Brief Due	6/6/2021
Request for Oral Hearing (optional) Due	6/16/2021

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits,

declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).