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UNITED STATES: Opposer's Motion to Strike Pre-Trial Disclosure of Authenticating Witnesses Denied by TTAB

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The Trademark Trial and Appeal Board (TTAB) held that Thatch LLC's (Thatch) failure to disclose authenticating witnesses until pre-trial disclosures was "substantially justified and harmless," thus denying the motion of Kate Spade LLC (Kate Spade) to strike pre-trial disclosures of authenticating witnesses. *Kate Spade LLC v. Thatch, LLC*, 126 U.S.P.Q.2d 1098 (TTAB Mar. 22, 2018).

Thatch filed applications for the marks PATIO BY SPADES and THE SPADES for clothing and handbags. Kate Spade opposed the applications based on its registrations and use of the KATE SPADE mark for clothing, handbags, and other goods.

Thatch's initial disclosures provided, in part, for categories of documents for use to support "its claims and defenses, including [d]ocuments reflecting third party use and registration of marks similar to" applicant's marks.

Thatch supplemented its initial disclosures during Kate Spade's trial period to identify a witness to authenticate "recently obtained third party use goods for use at trial" and "third party use witnesses to be determined" to testify on "authentication of third party use goods and services and use of third party marks."

Thatch served pre-trial disclosures identifying the witness in its supplemental initial disclosures to testify and authenticate third-party use and purchasers of third party use goods. Thatch also identified two additional witnesses to testify on "adoption, use and/or registration of third party marks" and to introduce associated exhibits.

Kate Spade filed a motion to strike Thatch's pre-trial disclosures.

In determining the merits of Kate Spade's motion, the TTAB followed Federal Rules of Civil Procedure 37(c)(1), which governs whether "evidence will be excluded for failure to disclose, or allowed because the failure to disclose is substantially justified or harmless." The TTAB looked to the five-factor test in *Great Seats Inc. v. Great Seats Ltd.*, 100 U.S.P.Q.2d 1323, 1327 (TTAB 2011). Those factors are: "(1) the surprise to the party against whom the evidence would be offered; (2) the ability of the 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 non-disclosing party's explanation for its failure to disclose the evidence."

The TTAB considered those factors regarding each witness identified in Thatch's supplemental initial disclosures and pre-trial disclosures. The TTAB first addressed whether Thatch's supplemental initial disclosures were deficient, and found that its "initial disclosures, supplemental initial disclosures, and pre-trial disclosures are entirely consistent in providing the necessary notice" for submitting documentary evidence of third-party use at trial.

For the testimony witness provided by Thatch in its supplemental initial disclosures, the TTAB denied Kate Spade's motion to

strike because of the timely identity of this authenticating witness and lack of deficiency in Thatch's evidence disclosure.

The other two witnesses were not specifically identified in Thatch's initial disclosures; however, the initial disclosures identified third-party use as a category of documents to be used at trial. The TTAB considered each of the *Great Seats* factors in view of Kate Spade's motion to strike the pre-trial disclosures. To rebut the *Great Seats* fourth and fifth factors regarding the importance of evidence and Thatch's failure to disclose explanation, Kate Spade argued that witness testimony regarding third-party use would be within the general knowledge of other witnesses and that Thatch was dilatory in its trial preparation. The TTAB was not persuaded by the arguments concerning any of the *Great Seats* factors, as Kate Spade did not claim surprise upon receipt of the supplemental initial disclosures and did not seek discovery regarding the third-party use.

The TTAB found that "on balance" with the *Great Seats* factors, the applicant's failure to disclose the identity of the witnesses for authenticating third-party use until pre-trial disclosures was both substantially justified and harmless, and thus denied Kate Spade's motion to strike.

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