

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

J.T. COLBY & COMPANY, INC. d/b/a
BRICK TOWER PRESS, J. BOYLSTON &
COMPANY, PUBLISHERS LLC and
IPICTUREBOOKS LLC,

Case No. 11-cv-4060 (DLC)

Plaintiffs,

-against-

APPLE INC.,

Defendant.

PLAINTIFFS' MEMORANDUM OF LAW IN OPPOSITION
TO DEFENDANT APPLE INC.'S MOTION TO EXCLUDE ANY TESTIMONY,
ARGUMENT OR EVIDENCE REGARDING THE EXPERT REPORTS AND
OPINIONS OF PLAINTIFFS' EXPERT WITNESS ROBERT T. SCHERER

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Plaintiffs J.T. Colby & Co., Inc. d/b/a Brick Tower Press, J. Boylston & Co., Publishers, LLC, and ipicturebooks, LLC (“Plaintiffs”) respectfully submit this Memorandum of Law in opposition to the Motion of Defendant Apple Inc. (“Apple”) to exclude any testimony, argument or evidence regarding the expert reports and opinions of Plaintiffs’ expert witness Robert T. Scherer.

Preliminary Statement

Plaintiffs have proffered Robert T. Scherer, a trademark attorney with over 33 years of experience, first as a Trademark Examiner with the United States Patent and Trademark Office (“PTO”), and later as in-house trademark counsel for PepsiCo., Inc. and Time Warner Inc., to testify as an expert witness in this action. Mr. Scherer was responsible for the registration and maintenance of some of the most important, valuable and recognizable brands in the United States and around the world, aggregating to more than 30,000 trademarks over the course of his career. Plaintiffs intend to call Mr. Scherer to testify with respect to PTO procedures, trademark clearance custom and practice, trademark registration practice, and trademark assignment practice. Mr. Scherer analyzes the facts with the benefit of his experience as a trademark examiner and in-house trademark attorney, see Fed. R. Evid. 703, and offers his expert opinions on various complex aspects of this case, many of which involve the conduct of Apple’s in-house and outside counsel. As an experienced PTO examiner, practitioner, and in-house attorney, Mr. Scherer is well qualified to opine on the performance of Apple’s attorney-witnesses in their trademark clearance and transactional work.¹

All of these issues are beyond the everyday experience of the average juror, who may be inappropriately swayed by the attorney status of Apple’s fact witnesses, or confused by

¹ Mr. Scherer also provided a report in rebuttal to the opening expert report of Apple’s attorney expert witness Siegrun Kane, and provided deposition testimony concerning Apple’s attorney rebuttal expert witness Philip Hampton.

the technical jargon that will inevitably arise in their testimony and relevant documents. Accordingly, Mr. Scherer's reports and testimony should be deemed admissible for purposes of summary judgment, and should be considered by the jury at trial. If the Court holds that Mr. Scherer is not permitted to offer conclusory opinions concerning ultimate issues, cf. Fed. R. Evid. 704, his report and testimony concerning the factual underpinnings of his analysis – including his vast experience with the registration, recordation, and assignment of trademarks, as well as his own investigation of the databases and search results available to good-faith professional inquiries – should still be admitted, to aid the jury in understanding the workings of the PTO, professional standards in filings with the PTO, and the steps involved in the trademark clearance process.

Apple argues that Mr. Scherer's testimony could not possibly be of assistance to the trier of fact in understanding the factual issues raised in these areas, and that his expert opinions, report, and testimony should be excluded in their entirety. In an effort to caricature Mr. Scherer as somehow incompetent and unqualified, Apple also relies throughout its arguments on out-of-context, grossly misleading, or simply erroneous assertions about Mr. Scherer's reports and testimony. Apple's motion ignores the assistance that Mr. Scherer's analysis and opinions offer to the trier of fact, and must therefore be denied.

ARGUMENT

I. ROBERT SCHERER IS QUALIFIED AS AN EXPERT WITNESS IN THIS MATTER

A witness who is qualified as an expert by knowledge, skill, experience, training, or education may testify in the form of an opinion or otherwise if: (a) the expert's scientific, technical, or other specialized knowledge will help the trier of fact to understand the evidence or to determine a fact in issue; (b) the testimony is based on sufficient facts or data; (c) the

testimony is the product of reliable principles and methods; and (d) the expert has reliably applied the principles and methods to the facts of the case. See Fed. R. Evid. 702; see also Fed. R. Evid. 104(a). “In assessing whether a witness can testify as an expert, courts have liberally construed the expert qualification requirement.” Johnson & Johnson Vision Care, Inc. v. CIBA Vision Corp., No. 04 Civ. 7369(LTS), 2006 WL 2128785, at *5 (S.D.N.Y. July 28, 2006) (denying motions to exclude experts in false advertising case). “In considering a witness's practical experience and educational background as criteria for qualification, the only matter the court should be concerned with is whether the expert’s knowledge of the subject is such that his opinion will likely assist the trier of fact in arriving at the truth.” Id. (citations and quotation marks omitted).

A. Robert Scherer Is Qualified as an Expert in Trademark Law, Searching and Clearance

“Courts generally have admitted expert testimony from intellectual property lawyers in trademark cases.” Sam's Wines & Liquors, Inc. v. Wal-Mart Stores, Inc., 92 C 5170, 32 U.S.P.Q.2d 1906, 1994 WL 529331, at *9 (N.D. Ill. Sept. 27, 1994) (collecting cases and holding that trademark attorney expert witness “may testify about the technical aspects of applying for and obtaining a federal trademark registration and may opine on the similarities of the parties’ respective marks based on her experience as a practicing trademark attorney”).² Mr. Scherer is a trademark lawyer eminently qualified to testify as an expert on the technical aspects of federal trademark registration and other industry practices in the field of trademark law.

² In her treatise on this subject, one of Defendant’s attorney expert witnesses in this action agreed: “How do you find an expert? Authors of trademark texts and professors are generally a good bet Well-regarded practitioners in the field are also used as experts.” Siegrun D. Kane, Kane on Trademarks: A Practitioners’ Guide § 16:7:3, at 16-29 (PLI 2011) (Declaration of Partha P. Chattoraj in Opposition to Motion to Exclude, dated January 25, 2013 (“Chattoraj Decl.”) Ex. A).

Since 1972, Mr. Scherer's legal career has been focused exclusively on trademarks. Mr. Scherer began his career at the PTO as a trademark examiner, where, among other duties, he reviewed trademark applications for compliance with mandatory filing requirements; conducted trademark searches; reviewed marks for descriptiveness; prepared PTO office actions and reviewed responses thereto; and reviewed registrations for Sections 8 and 15 compliance and Section 9 renewal. In his years at the PTO, Mr. Scherer reviewed over 2,000 trademark applications. See Declaration of Robert T. Scherer in Opposition to Defendant's Motion to Exclude dated January 25, 2013 ("Scherer Decl.") Ex. B ("Scherer Report"), at 1-2.

After his time at the PTO and five years in trademark practice at Pennie & Edmonds, a large intellectual-property law firm, Mr. Scherer went in-house, first at PepsiCo, Inc. and then, in 1983, at Time Inc. When Mr. Scherer joined Time Inc., he immediately assumed responsibility for its entire portfolio of U.S. and foreign trademarks. In that position, Mr. Scherer was responsible for (i) the selection and clearance of new marks; (ii) the filing of applications; (iii) prosecution of applications; (iv) maintenance and protection of more than 20,000 U.S. and foreign trademark registrations, including such well-known marks as TIME, FORTUNE, SPORTS ILLUSTRATED, and, in the field of book publishing, WARNER BOOKS and LITTLE, BROWN, as well as the TIME WARNER corporate mark and logo; (v) filing approximately 900 U.S. trademark applications; and (vi) supervising the assignment and recordation of several large trademark portfolios. At the end of 2005, Mr. Scherer retired as Assistant General Counsel at Time Warner Inc. See id. at 2-3.

Notwithstanding this background, Apple argues that "Mr. Scherer does not have superior knowledge regarding current trademark law or trademark search and clearance practices, and certainly should not be allowed to opine regarding such matters as an expert under

Rule 702.” Defendant’s Memorandum of Law in Support of Motion to Exclude Robert T. Scherer, dated December 21, 2012 (“Br.”), at 7. In reality, of course, Mr. Scherer’s career history and experience clearly meet and surpass the requirements for qualification as an expert on PTO, trademark clearance, trademark registration, and trademark assignment practices. See McCulloch v. H.B. Fuller Co., 61 F.3d 1038, 1043 (2d Cir. 1995) (proposed expert engineer “easily qualifies for admission under Daubert” because of “extensive practical experience”); Wechsler v. Hunt Health Sys., Ltd., 381 F. Supp. 2d 135, 142-43 (S.D.N.Y.2003) (CPA with 17 years of experience reviewing financial documents qualified as expert on health care company’s accounting practices).³

As one of its main arguments for disqualification, Apple focuses on Mr. Scherer’s retirement from Time Warner in 2005, alleging that he is incapable of opining on “current trademark law,” about “apps,” and other developments. As a preliminary matter, Apple ignores Mr. Scherer’s un rebutted testimony that he began consulting as an expert in this matter in 2011, and as a consulting expert on a prior trademark matter on behalf of Crayola after 2007. See Deposition of Robert T. Scherer, dated Nov. 16, 2012 (“Scherer Dep.”) at 39:24-42:9 (Chattoraj Decl. Ex. B). Apple also ignores Mr. Scherer’s statement in his report that he “retired from active practice in December, 2005, but ha[s] continued to stay abreast of developments in the trademark field.” Scherer Report at 1. Furthermore, Apple ignores the abundant evidence,

³ Indeed, courts have found experts qualified with far less relevant experience. See, e.g., Pension Comm. of Univ. of Montreal Pension Plan v. Banc of America Secs., LLC, 691 F. Supp. 2d 448, 459-60 (S.D.N.Y. 2010) (“decade-long career in the financial sector” sufficient experience to qualify as expert on “hedge fund due diligence”); Rosco, Inc. v. Mirror Lite Co., 506 F. Supp. 2d 137, 145 (E.D.N.Y. 2007) (in trademark and patent infringement case, expert witness employed as high school mathematics teacher deemed qualified as expert witness on “method of measuring the radius of a multidimensional” mirror despite lack of evidence that he “constructed or tested mirrors, published papers or lectured on the subject, or worked for a company that designed or manufactured mirrors”); Wechsler, 381 F. Supp. 2d at 144 (“Whether [proposed expert] is more or less qualified than witnesses in other cases, or than an ideal expert in this case, does little to justify excluding his testimony in this case.”); 29 Wright & Miller, Federal Practice & Procedure, Evidence § 6265 (2012) (“[I]t is not necessary that the witness be recognized as a leading authority in the field in question or even a member of a recognized professional community.”) (citations omitted).

appearing throughout Mr. Scherer's report and testimony, that Mr. Scherer utilized or searched Google, Amazon.com, Internet databases maintained by the PTO, web pages for and search results from the Thomson Compumark commercial database, various book seller websites and online library catalogs, and other "web-based" technology in preparing his detailed report on search tools and protocols, as well as Mr. Scherer's testimony about the importance of Internet searching and online databases in his experience working at Time Warner on trademark clearances through 2005. See Scherer Report at 5-6, 7-8, 13-15, 37-38; Scherer Dep. 90:9-91:4, 94:20-101:19 . This argument is therefore without merit. See Medisim Ltd. v. BestMed LLC, 861 F. Supp. 2d 158, 168 (S.D.N.Y. 2012) (holding that expert's experience was not "stale and outdated" despite 1995 retirement, after which expert only engaged in "professional expert witness" activities), reconsidered in part on other grounds, 10 Civ. 2463(SAS), 2012 WL 1450420 (S.D.N.Y. Apr. 23, 2012); see also Scherer Decl. ¶¶ 7, 11.

Apple also suggests that Mr. Scherer is not qualified as an expert witness in this matter because he has not taught a trademark law class, published scholarly articles or delivered "any public speeches about trademark law." Br. at 1. These factors provide no basis to find that Mr. Scherer is not qualified to testify as an expert. See Scherer Decl. ¶ 8. Whether an expert has "taught in an educational institution or published in his field necessarily go to the weight, rather than the admissibility," of the expert's testimony. Wechsler, 381 F. Supp. 2d at 143 (citing McCulloch, 61 F.3d at 1043-44); see also Khatri v. Lazarus, 225 A.D.2d 302, 303, 639 N.Y.S.2d 1, 2 (1st Dep't 1996) (trial court's refusal to deem proffered physician expert witness qualified on grounds that she had not "published and lectured" and that "she is not recognized as a person that is in command of the subject matter by the public and the doctors in her specific field" was abuse of discretion and reversible error).

Apple argues that Mr. Scherer’s qualifications are also suspect because he has only consulted as an expert in one other litigation and has not yet been qualified to testify as an expert witness. Controlling and persuasive authority rejects this argument. See United States v. Locascio, 6 F.3d 924, 937 (2d Cir. 1993) (“Although he had never before been qualified as an expert witness, even the most qualified expert must have his first day in court.”); Bobak Sausage Co. v. A & J Seven Bridges, Inc., 07 C 4718, 2010 WL 1687883, at *4 (N.D. Ill. Apr. 26, 2010) (“An expert witness should not be precluded from testifying simply because he has never testified as an expert witness. In fact, many courts have expressed more concern about expert witnesses who have too much – not too little – experience as witnesses in court.”) (collecting cases); Pension Comm. of Univ. of Montreal Pension Plan v. Banc of America Secs., LLC, 716 F. Supp. 2d 220, 222-25 (S.D.N.Y. 2010) (“The only category of experience that courts are generally wary of is experience gained as a litigation consultant and expert witness.”). The sole authority that Apple cites in support of its argument, Fernandez v. Central Mine Equipment Co., 670 F. Supp. 2d 178 (E.D.N.Y. 2009), is not on point here for many reasons – among other things, the proposed expert in that case had not only never been qualified as an expert in a court proceeding, he had also “previously been disqualified as an expert on five separate occasions.” Id. at 183-84. Mr. Scherer has never been found unqualified, or otherwise disqualified, as an expert by any court.

Apple asserts broadly that “Mr. Scherer is not aware of the prevailing search and clearance practices of other law firms,” Br. at 7, but the cited deposition testimony does not support this assertion. See Scherer Dep. 109:6-110:11 (“I understand some firms are beginning to do that but I would question the efficacy of that practice. . . . I don’t know if it’s becoming more common. I just know some firms are beginning to do that.”); Scherer Decl. ¶ 12.

Apple's remaining attacks on Mr. Scherer's qualifications as a trademark law and clearance expert essentially duplicate its attacks on the reliability of his testimony. In either context, Apple's arguments grossly mischaracterize Mr. Scherer's actual opinions, and are in any event ill-founded.

Apple repeatedly asserts that Mr. Scherer "opines several times that there is a duty to search and clear a trademark, when in fact there is no such duty." Br. at 8, 15-16. This characterization of Mr. Scherer's opinions is simply false. Scherer Decl. ¶¶ 9-10. Based on his experience and expertise in standard and customary practices, Mr. Scherer opined repeatedly on the importance of conducting a proper search for conflicting trademarks – without ever positing, or even mentioning, any legal duty to do so:

- "When selecting a new trademark or materially expanding the use of an existing mark, it is imperative that the trademark attorney conduct the necessary searches and, if appropriate, follow-up investigations to determine whether the proposed mark is available for the intended use." (Scherer Report at 7);
- "In my opinion, Apple's failure to conduct an appropriate search/investigation was irresponsible and a serious departure from standard trademark searching practice, I find it surprising that a large and sophisticated company, like Apple, did not follow-up with a more comprehensive search." (Scherer Report at 8-9);
- "To have either failed to perform these investigations or to have ignored the results of an investigation is highly irresponsible." (Scherer Report at 15);
- "Despite the fact that Apple's attorneys are accomplished trademark professionals with years of experience, they appear to have departed from the recommended protocol of their own outside counsel and proceeded to use the IBOOKS mark in connection with downloadable books based solely upon a preliminary or screening search." (Scherer Report at 16);
- "This failure to follow the customary steps in clearing the IBOOKS mark was a glaring omission and evidences a total disregard for the trademark rights of others." (Scherer Report at 17).

In one instance, not cited in Apple’s motion brief, Mr. Scherer does use the word “duty,” when he opines, “Apple has a duty to properly search and clear new marks or new uses of existing marks; being a very large and successful company does not excuse Apple from responsibility and respect for the trademark rights of others.” Scherer Report at 10. In context, it is obvious that Mr. Scherer, informed by his decades of experience as in-house trademark attorney for PepsiCo. and Time Warner, is stating his opinion about the ethical, not legal, duties of large, successful corporate citizens. See Scherer Decl. ¶ 10.⁴

Mr. Scherer testified in his deposition that he is well aware of this distinction. See Scherer Dep. at 80:3-13 (“I think the case law has made it clear that there's no duty to conduct a full search but it is certainly a good practice and evidence of good faith when you conduct an appropriate full search.”). Apple bizarrely characterizes this testimony as a “flip-flop” demonstrating Mr. Scherer’s “lack of expertise in the subject matter generally.” Br. at 15. Of course, in reality, there is no contradiction between Mr. Scherer’s deposition testimony and the statements in his report. Indeed, as Mr. Scherer pointed out in his report, Apple’s outside counsel Glenn Gundersen, who supervised Apple’s clearance search and testified in this matter, appeared to share Mr. Scherer’s view when he wrote his treatise on trademark searching: “A trademark search is the critical legal step in the process of selecting a new mark.” Scherer

⁴ Mr. Scherer’s personal views are informed by his experience; these views do not render him unqualified to testify as an expert in this action. For example, as a minor aside in a footnote about trademark International Classes that was intended to be humorous, Mr. Scherer wrote that the “primary purpose” of the “arbitrary classes of goods and services numbered from 1-45” “is to allow the PTO to charge separate filing fees per class.” Scherer Report at 9 n.2. Apple cites this footnote and alleges that Mr. Scherer “mistakenly asserts that the trademark classification system used by the PTO is motivated by the PTO’s efforts to collect more fees.” Br. at 8. Of course, Mr. Scherer’s attempt at humor in one footnote, in the context of his meticulous and detailed 45-page report and exhibits, in no way suggests that he is “unqualified” to testify as an expert, and if Apple truly believed otherwise, its counsel could have asked him about the footnote at his deposition. See Scherer Decl. ¶ 25.

Report at 16 (quoting Glenn A. Gundersen, Trademark Searching 3 (2d ed. 2000)).⁵ In any event, this opinion clearly does not undermine Mr. Scherer's qualifications.

Similarly, Apple contends that Mr. Scherer's understanding of "key trademark law concepts" is "errant" because "he has no understanding of the considerations for determining whether the assignment in gross rule applies." Br. at 8. In support of this extraordinary statement, Apple states that "Mr. Scherer expressly claims that one needs to acquire the patent associated with a trademarked product" to avoid assignment in gross. Id. The only basis for Apple's contention appears to be Mr. Scherer's straightforward testimony that, because Apple did not acquire or license Family Systems' "ibook web book" patent in connection with the purported trademark assignment, it is axiomatic that Apple "couldn't use the mark on the same goods and services." Scherer Dep. at 188:20-21, cited in Br. at 13. Scherer Decl. ¶ 14. Apple then omits Mr. Scherer's qualifying language that appeared in the very next sentence in the same deposition answer, which directly contradicts Apple's accusation: "I think the patent is terribly important in terms of what needed to be transferred, but it's one of several indicia of goodwill." Scherer Dep. at 188:22-25. Throughout his report, Mr. Scherer never once indicates that the patent "needs" to be transferred for the transfer of goodwill to occur:

- "The fact that [the Family Systems patent] was not acquired by Apple along with the IBOOK trademark raises questions regarding the transfer of goodwill and the validity of the trademark assignment." Scherer Report at 23-24.
- "We have to look at the totality of the assignment to see whether any other assets, such as patents, trade secrets, customer lists, specialized equipment and physical inventory, were transferred with the mark." Scherer Report at 26-27.

⁵ Siegrun Kane, one of Apple's attorney expert witnesses on trademark law, also shares Mr. Scherer's view: "Once a proposed mark is selected, it is prudent practice to run a trademark search. . . . Forgoing a search can be risky business. Defendant's failure to make a search may constitute 'carelessness' and weigh in favor of plaintiff's right to injunctive relief." Siegrun D. Kane, Kane on Trademarks: A Practitioners' Guide § 4:1 (PLI 2011) (Chattoraj Decl. Ex. A).

- “Perhaps the most glaring omission was [the Family Systems patent] This patent protects the manufacture, distribution and sale of the IBOOK interactive Web book system. That this patent was not assigned is powerful evidence that Apple never intended to use the IBOOK mark on the same goods or in the same business as its predecessor.” Scherer Report at 27.

To the contrary, Mr. Scherer’s views accord with those of Apple’s attorney expert witness Siegrun Kane, who has written that “the transfer of tangible assets, for example, machinery, secret formulae, and customer lists may provide evidence of the transfer of goodwill in a trademark assignment,” and further observes, “The importance of the assets to the continuity of the business must be examined. Where the product is the result of a secret formula, the formula is critical to the goodwill symbolized by the mark.” Siegrun D. Kane, Kane on Trademarks: A Practitioners’ Guide § 21:3.2[A] (PLI 2011). (Chattoraj Decl. Ex. A). Thus, Mr. Scherer’s opinions clearly fall well within the mainstream of trademark principles, and do not undermine his qualifications to testify.⁶

Finally, although Mr. Scherer admittedly did not take account of a statement in the PTO Trademark Manual of Examining Procedures regarding “i-formative” marks in preparing his report on the suggestiveness of Plaintiffs’ marks, see Scherer Dep. 264:23-265:4 (citing TMEP § 1209.3(d)), this omission does not render him unqualified to offer his opinions. As Mr. Scherer pointed out in his deposition testimony, the TMEP provision is not dispositive of the descriptiveness question; it merely indicated that the i-prefix would generally be understood

⁶ In making this argument, Apple repeatedly posits that “an assignor does not need to assign business assets such as patents to create a valid trademark assignment.” Br. at 8, 13-14 (citing Bambu Sales, Inc. v. Sultana Crackers, Inc., 683 F. Supp. 899, 908 (E.D.N.Y. 1988)). But Bambu Sales offers Apple no comfort. In that case, no assets needed to be transferred with the trademark assignment because the purchaser was continuing literally the same business as the assignor; the purchaser was the exclusive United States distributor and advertiser of the assignor’s products, which bore the assigned mark, such that the purchaser “was, in effect, the exclusive repository in the United States of this aspect of BAMBU’s good will for a decade prior to the assignment.” 683 F. Supp. at 904-05. Apple’s transaction with Family Systems bears no resemblance to those facts. See, e.g., Pilates, Inc. v. Current Concepts, Inc., 120 F. Supp. 2d 286, 311 (S.D.N.Y. 2000) (finding invalid assignment in gross, distinguishing Bambu Sales because purported assignee did not continue business of assignor).

to “signify Internet, when used in relation to Internet-related products or services,” TMEP § 1209.3(d), and only requires that the PTO examining attorney issue an initial refusal if the examiner deems this provision to apply, which could then be overcome in subsequent correspondence with the applicant. See Scherer Dep. 266:14-267:3. The omitted provision clearly does not mean that Plaintiffs’ iBooks mark, as used with their electronic and print book publishing business, is intrinsically “Internet-related,” and it does not mean that the PTO would ultimately find the mark descriptive as a matter of law. It is therefore not material to Mr. Scherer’s opinion regarding the suggestiveness of Plaintiffs’ mark, see Scherer Decl. ¶ 16, and provides no basis to find him unqualified. See, e.g., Amorgianos v. Nat’l R.R. Passenger Corp., 303 F.3d 256, 267 (2d Cir. 2002) (“A minor flaw in an expert’s reasoning or a slight modification of an otherwise reliable method will not render an expert’s opinion per se inadmissible.”); McCulloch, 61 F.3d at 1042-44 (expert qualified to testify on fume hazard despite deposition testimony that expert did not know the chemical constituents of the accused product, the fumes generated, or the concentration level of the fumes) (“Disputes as to the strength of [proposed expert witness’s] credentials, faults in his use of differential etiology as a methodology, or lack of textual authority for his opinion, go to the weight, not the admissibility, of his testimony.”) (citing Daubert, 509 U.S. at 596).

B. Mr. Scherer Need Not Be Qualified as an Expert in Patent Law or Computer Software to Offer His Expert Opinions on Trademark Law, Searching and Clearance

In his reports and deposition, Mr. Scherer offers his expert opinion that no “goodwill,” as trademark lawyers understand the term, appeared to be transferred in the IBOOK trademark assignment from Family Systems to Apple, based on the available evidence that Family Systems’ Wikipedia-like collaborative, interactive website IBOOK software was

radically different from Apple's e-book purchasing and reading app. Apple contends that Mr. Scherer must be qualified as an expert in patent law and computer software in order to be qualified to offer this opinion, pointing to Mr. Scherer's candid admissions that he is not an expert in patent law or in computer software as conclusive evidence that he is not qualified to offer his opinions in this action. Br. at 9-11 (citing Scherer Dep. 19:17-19, 162:15-20). But Mr. Scherer's candor about the limits of his expertise provides no basis to exclude his testimony. See Wechsler, 381 F. Supp. 2d at 143 n.5 (witness's reluctance to characterize his opinions as expert did not prevent qualification as expert witness).⁷

The argument that an expert witness must also be an expert regarding all data underlying the expert's analysis and opinion has been repeatedly rejected by the Second Circuit. See, e.g., Locascio, 6 F.3d at 937 (rejecting argument that FBI special agent interpreting tapes of wiretapped conversations among organized crime family members was not qualified expert witness, because his testimony allegedly "required knowledge of linguistics, the sociology of crime, tape recording technology, and voice analysis"); Stagl v. Delta Air Lines, Inc., 117 F.3d 76, 81-82 (2d Cir. 1997) (expert in "the interaction between machines and people" not unqualified because he lacked expertise in airline terminal or baggage claim area design);⁸ McCulloch, 61 F.3d at 1042-43 (consulting engineer qualified to testify as expert on product

⁷ Cf. Watson v. United States, 485 F.3d 1100, 1105-06 (10th Cir. 2007) ("While overly modest expert witnesses may not be exactly an everyday sort of problem in our legal system, neither can we ignore the prospect of mistakenly excluding a witness who really is expert but simply too demure to trumpet his or her qualities under cross-examination; it would hardly benefit the legal system to exclude from the stand self-deprecating individuals who rarely testify but have the expertise to do so in favor of those who are more extravagant and savvy to the legal system or who may make their living testifying in our courts.").

⁸ The Stagl panel also pointed out, "In determining whether an expert is sufficiently knowledgeable to be admitted to testify, one of the factors that the district court ought to consider is whether other experts exist who are more specifically qualified and who are nonetheless not in the employ of the company or industry whose practices are being challenged." 117 F.3d at 81. This consideration is especially urgent in the case at bar, where Mr. Scherer's testimony challenges the performance and practices of attorneys at one of America's largest companies and a leading law firm.

fume concentration despite lack of “formal education related to fume dispersal patterns” and lack of experience “performing or interpreting air quality studies”).

Nothing in the record suggests that Mr. Scherer needed to be an expert on computer software coding, or on construction of the claims in the underlying patent, in order to read the patent abstracts, web pages, and other data underlying his expert opinion regarding the transfer of goodwill. Scherer Decl. ¶¶ 20-21. See, e.g., Cedar Petrochemicals Inc. v. Dongbu Hannong Chem. Co., 769 F. Supp. 2d 269, 283 (S.D.N.Y. 2011) (non-chemist with “substantial experience in the shipping of petrochemicals” is “capable of assisting the trier of fact” on shipped chemical contamination issue); Johnson, 2006 WL 2128785, at *6 (accountant expert witness permitted to give opinions concerning “marketplace impact of the false advertising claims” in contact lens market despite lack of specific training “in the field of optometry or experience related to the eye care profession”) (citing TC Sys. Inc. v. Town of Colonie, 213 F. Supp. 2d 171, 175 (N.D.N.Y. 2002)).

Apple’s argument that Mr. Scherer is not qualified because he did not use the Family Systems software or Apple’s iBooks app before preparing his report, or because he did not know how the app “worked,” fares no better. Mr. Scherer was entitled to rely on facts and information provided to him, including hearsay evidence, and was not required to carry out all aspects of his investigation personally and directly. See Fed. R. Evid. 703; Cedar, 769 F. Supp. 2d at 284 (experts permitted to testify as to causation of chemical contamination “[w]ithout having interviewed anyone, without having the full inspection reports, without having performed [their] own tests, [and] without having reviewed all of the relevant documents”); Astra Aktiebolag v. Andrx Pharm., Inc., 222 F. Supp. 2d 423, 491 (S.D.N.Y. 2002) (“There is no requirement that an expert must run his own tests.”).

For all of these reasons, Mr. Scherer need not be qualified as an expert in computer software, or in patent law, in order to opine about the failure of Apple to acquire Family Systems' goodwill when it purported to acquire Family Systems' trademark.

II. ROBERT SCHERER'S OPINIONS ON COMPLEX LEGAL CONCEPTS ARE ADMISSIBLE OR, IF NECESSARY, SEPARABLE FROM HIS FACTUAL ANALYSIS OF TRADEMARK STANDARDS AND PROCEDURES

There is no blanket rule prohibiting experts from providing their opinions on ultimate issues, even if those opinions contain legal conclusions, if the testimony will "assist the trier of fact" in finding the truth. See, e.g., Fiataruolo v. United States, 8 F.3d 930, 942 (2d Cir. 1993) (taxpayer's attorney expert permitted to testify that taxpayer was not "responsible" for unpaid withholding taxes under Internal Revenue Code provision); 29 Wright & Miller, Federal Practice & Procedure Evidence § 6284 (1st ed. 2012) ("Thus, the admissibility of opinion testimony that may involve legal conclusions ultimately rests upon whether that testimony helps the jury resolve the fact issues in the case."); cf. Fiataruolo, 8 F.3d at 941 ("Experts may testify on . . . mixed questions of fact and law.").

Certain circumstances make attorney expert opinions particularly helpful to the trier of fact. For example, it is proper for a trademark attorney to provide expert opinions "as to questions of fact that are governed by the law." 4 McCarthy on Trademarks and Unfair Competition § 23:2.75 (4th ed. 2012).⁹

In non-jury matters, a trademark attorney expert can assist the judge in understanding trademark esoterica such as the meaning of terms of art like "distinctive," "generic," "secondary meaning," or "assignment in gross." In a jury trial, such attorney expert testimony can be helpful to jurors in

⁹ "A trademark attorney can assist the judge and jury about matters such as the technical aspects of applying for and obtaining a federal trademark registration but should not give her opinion on the ultimate issue of trademark infringement and likelihood of confusion." Id. But see Sterling Acceptance Corp. v. Tommark, Inc., 227 F. Supp. 2d 454, 462 (D. Md. 2002) (granting summary judgment, relying on report of trademark attorney that marks created different commercial impressions), aff'd, 91 Fed. App'x 880 (4th Cir. 2004).

understanding trademark law concepts which are unfamiliar and perhaps counter-intuitive to the uninitiated.

Id.¹⁰ Testimony by attorneys as to the application of facts to law is especially appropriate and admissible “where the conduct of other lawyers is at issue.” 29 Wright & Miller, Federal Practice & Procedure, Evidence § 6264 n. 36 (2012).

When appropriate, therefore, the Court may exercise its discretion to permit attorney expert testimony on ultimate issues, even when such expert opinions are stated in legally conclusory terms. See, e.g., CP Interests, Inc. v. California Pools, Inc., 238 F.3d 690, 697-98 (5th Cir. 2001) (trademark attorney expert permitted to testify to legal conclusions addressing trademark transfer, ownership, and geographic scope); Sanders v. Mt. Sinai Sch. of Med., 418 F. Supp. 2d 339, 341-42 (S.D.N.Y. 2005) (plaintiff’s patent counsel permitted to submit expert report on patent claims, with opinion that defendant “failed to take reasonable measures to commercialize” the patent); Cary Oil Co., Inc. v. MG Ref. & Mktg., Inc., 99 Civ. 1725(VM), 2003 WL 1878246, at *6 (S.D.N.Y. Apr. 11, 2003) (attorney expert permitted to explain corporate governance, veil-piercing, and include opinion that evidence indicated that the relationship between defendant and subsidiary justified veil-piercing) (“As long as . . . [attorney expert] ‘couches his opinion specifically on the evidence that he looked at and the work that he did,’ the Court is satisfied that his opinions will fall within the accepted guidelines for admissible testimony.”) (quoting Fiataruolo, 8 F.3d at 942). Consistent with this overarching policy, the Federal Rules of Evidence were amended over twenty years ago to allow expert witnesses to render opinions even if they “embrace[] an ultimate issue to be decided by the trier of fact.” Fed. R. Evid. 704. The Advisory Committee Note on Rule 704 provided an example of how certain

¹⁰ For this reason, Apple’s effort to strike section 4 of Mr. Scherer’s report, which covers certain background trademark principles to provide context to his analysis and opinions, should be rejected. See, e.g., Pereira v. Cogan, 281 B.R. 194, 199 (S.D.N.Y. 2002) (declining to strike preliminary section of attorney expert’s report, discussing his opinion about good corporate practice based on industry custom and general legal principles).

legal conclusions, if adequately factually explored, could be admissible: “Thus the question, ‘Did T have capacity to make a will?’ would be excluded, while the question, ‘Did T have sufficient mental capacity to know the nature and extent of his property and the natural objects of his bounty and to formulate a rational scheme of distribution?’ would be allowed.”

Even if the Court decides that Mr. Scherer should not be permitted to testify as to his ultimate opinions, however, the Court should still permit him to testify as to his knowledge about search and clearance practices, PTO procedures, PTO document filing practices, and his listing of the facts relevant to the alleged transfer of goodwill from Family Systems to Apple. See, e.g., U.S. Information Systems, Inc. v. Int'l Bhd. of Elec. Workers Local Union No. 3, 313 F. Supp. 2d 213, 240-41 (S.D.N.Y. 2004) (accepting “compromise” suggestion for antitrust expert witness, barring conclusions but permitting testimony on “factors that would tend to show anticompetitive conduct in a market”) (quoting Union Carbide Corp. v. Montell N.V., 28 F. Supp. 2d 833, 843 (S.D.N.Y. 1998) (holding that antitrust experts could testify that a market was “not competitive and to explain how they reached that conclusion,” but could not testify that the defendant’s conduct was “anti-competitive” or “unlawful”)); see also International Mkt. Brands v. Martin Int’l Corp., __ F. Supp. 2d __, 2012 WL 621464, at *3-*4 (W.D. Pa. Feb. 22, 2012) (“While expert opinion on the ultimate factual issue of whether or not there exists a likelihood of confusion is inadmissible, expert opinion on the factual factors that develop the ultimate finding on confusion is generally proper and helpful.”) (denying in part motion to strike expert report of trademark attorney).

Accordingly, at a minimum, Mr. Scherer’s report and testimony of professional standards for trademark clearance procedures and PTO filings, and considerations concerning

transfers of “goodwill” in trademark assignments – subject matters beyond the experience of the average juror – should be admitted.¹¹

III. ROBERT SCHERER’S OPINIONS ARE RELIABLE

“No single factor is necessarily dispositive of the reliability of a particular expert’s testimony and a ‘review of the case law after Daubert shows that the rejection of expert testimony is the exception rather than the rule.’” Trouble v. Wet Seal, Inc., 179 F. Supp. 2d 291, 301-02 (S.D.N.Y. 2001) (quoting Advisory Committee Notes, 2000 Amendments, Fed. R. Evid. 702). Faced with Mr. Scherer’s detailed, meticulous report, and his testimony defending his work, Apple resorts to arguments of disputed facts, and blatant misrepresentations, in a futile effort to challenge the reliability of Mr. Scherer’s testimony.

First, Apple contends that Mr. Scherer’s testimony concerning clearance procedures is unreliable because of his alleged “belief” that “there is a legal duty to conduct a search.” Br. at 15. As set forth above, see supra at 8-9, Mr. Scherer believes no such thing, although, like Apple’s own trademark counsel, he believes that conducting a clearance search is “critical” or “imperative.” Scherer Report at 7,11; see Fund of Funds, Ltd. v. Arthur Andersen & Co., 545 F. Supp. 1314, 1372 (S.D.N.Y. 1982) (“It is appropriate for experts to testify about the ordinary practices of a profession or trade ‘to enable the jury to evaluate the conduct of the parties against the standards of ordinary practice in the industry.’”) (quoting Marx & Co. v. Diners Club, Inc., 550 F.2d 505, 509 (2d Cir. 1977)). Apple then argues that it did, in fact, conduct a “full comprehensive clearance search before it began using the iBooks mark.” Br. at 15.

¹¹ Specifically, to the extent the Court elects to exclude opinions of Mr. Scherer that are deemed to be conclusory, Plaintiffs have prepared versions of the Scherer Report and Rebuttal Report with proposed redactions highlighted for the Court’s consideration. See Chatteraj Decl. Ex. C.

But Mr. Scherer's challenges to the alleged comprehensiveness of Apple's search do not suggest that Mr. Scherer's opinions are unreliable. For example, Apple's own Rule 30(b)(6) witness on its clearance process admitted that, although Apple became aware of Plaintiffs' predecessors' abandoned trademark applications and bankruptcy, no one acting on Apple's behalf ever reviewed the bankruptcy docket (which would have revealed Plaintiffs' ongoing business) or the actual trademark file histories. See Deposition of Hal Borden, dated October 2, 2012 ("Borden Dep."), at 107:3-109:23, 121:19-123:21, 163:13-164:9, 170:5-10. Chatteraj Decl. Ex. D. Apple's trademark counsel also testified that they never searched on Amazon or any other online retail sites, and they never searched state business name registries. Deposition of Glenn A. Gundersen dated October 3, 2012 ("Gundersen Dep.") at 292:3-294:6, 323:4-22, Chatteraj Decl. Ex. E; Borden Dep. at 148:25-149:14. Either of those searches would have disclosed Plaintiffs' ongoing business. When confronted with his own treatise's recommendations that these databases were a "useful source of common law marks," Glenn Gunderson, Trademark Searching 111 (2d ed. 2000), Apple's counsel testified that his view had changed. Gundersen Dep. at 334:8-337:22. The need to parse such testimony demonstrates the value that Mr. Scherer's testimony concerning industry standards could bring to the trier of fact.

Second, Apple contends that Mr. Scherer's "assignment in gross" analysis is unreliable because of two factual issues: the date that Apple acquired the IBOOK mark from Family Systems, and Apple's "attempt" to acquire Family Systems' mark in foreign countries. As a preliminary matter, neither allegation is material to Mr. Scherer's opinions, see Scherer Decl. ¶ 15 (b) & (c)), but in any event, these are actually fact disputes, rather than indicia of unreliability. As Mr. Scherer testified, Scherer Dep. at 151:19-152:3, the assignment document that Apple filed with the PTO is dated January 29, 2010, the date on which Plaintiffs contacted

Apple to alert them to Plaintiffs' prior use of the iBooks mark; similarly, documents show that Apple authorized the payment to Family Systems on January 29, 2010, although the money was apparently not paid until later. See Chatteraj Decl. Ex. F; Scherer Decl. ¶ 15(b). Moreover, although the Family Systems assignment agreement was allegedly signed at 3 AM on the morning of Apple's announcement of the iBooks product, Apple did not actually complete the transaction until early February 2010, as Mr. Scherer pointed out in his testimony. Scherer Dep. 320:6-321:2. Tellingly, with respect to the "attempt" to acquire Family Systems' foreign registrations, Mr. Scherer pointed out that Family Systems had very few foreign registrations, and that Apple clearly did not focus on the conveyance of those registrations in its negotiations with Family Systems. Scherer Decl. ¶ 15 (c).

Third, Apple calls Mr. Scherer's analysis of Apple's statements to the PTO concerning the Family Systems IBOOK mark "demonstratively [sic] incorrect," Br. at 18, because Mr. Scherer does not agree that Apple's specimen from the iTunes website accurately reflected Family Systems' use of the mark. Moreover, Apple argues that Mr. Scherer's opinions should be excluded because the iBooks app is "computer software used to support and create interactive, user-modifiable electronic books," like Family Systems' software. Id. Apple bases this contention on its arguments that highlighting and taking notes make downloaded e-books "interactive" and "user-modifiable," and that the iBooks app "creates" an electronic book when it displays a downloaded book on an Apple device. (That is the strained sense in which Apple accuses Mr. Scherer of "admitting" that the iBooks app permits "creation of an electronic book on Apple's iPhone device." See Scherer Dep. 227:22-228:9.) This factual dispute goes to the heart of Defendant's fraud on the PTO, and the fact that Apple repeatedly and conclusorily asserts that its position is correct does not mean that Mr. Scherer's opinion is unreliable.

Fourth, in attacking the reliability of Mr. Scherer’s opinion concerning Apple’s fraud on the PTO, Apple states that Mr. Scherer “rejects the possibility that Apple acquired the IBOOK mark from Family Systems to avoid litigation with Family Systems.” This is flatly incorrect: Mr. Scherer specifically testified to his opinion that Apple had “two reasons, I think. One, the primary reason, yes, to get priority over plaintiffs’ mark and two, to deal with the consent agreement from 1999. It had to reach an accommodation with Family Systems.” Scherer Dep. 240:6-10. Mr. Scherer’s point is that Apple did not need to purchase the mark from Family Systems to avoid litigation; it could have entered into another consent agreement, like the one in 1999, raising the inference that Apple wished to benefit from Family Systems’ priority. See Scherer Dep. 241:2-16; Scherer Report at 15-16. Similarly, although Apple asserts that Mr. Scherer “is wrong” because the Family Systems agreement was allegedly executed two days before Mr. Colby’s January 29, 2010 notice to Apple, Apple’s 30(b)(6) witnesses testified that, at minimum, Apple was aware of Plaintiffs’ predecessors by mid-January 2010.¹² See Borden Dep. at 90:9-19; La Perle Dep. at 190:8-191:11. Again, Apple’s disagreement with Mr. Scherer’s opinion does not undermine his opinion’s reliability.

Fifth, Apple accuses Mr. Scherer of disregarding certain press releases produced by Plaintiffs and a TMEP provision in opining on the suggestiveness of Plaintiffs’ ibooks mark. Br. at 19-20. As a preliminary matter, Mr. Scherer did not “disregard” the press releases; he testified that he was aware of them. See Scherer Dep. 264:2-19. In reality, although Apple contends that it is “undisputed” that the cited press release by Plaintiffs’ predecessor indicates

¹² Moreover, Apple’s trademark counsel testified that his final iBooks clearance opinion was delivered to Apple in early February, after Plaintiffs’ contact with Apple on January 29, 2010. Gundersen Dep. at 120:12-18. Apple claimed that the contents of that opinion, including specifically the impact of the Family Systems’ assignment agreement on clearance, were privileged, because Apple was not relying on an “advice of counsel” defense. See Gundersen Dep. at 330:11-21; Deposition of Thomas La Perle dated September 19, 2012 (“La Perle Dep.”) at 60:8-10. Chatteraj Decl. Ex. G. Apple should be precluded from using the existence of these communications, the contents of which they have refused to reveal, to attack Mr. Scherer.

that its founder “intended to focus on the Internet in marketing and distributing books under that imprint,” the documents do not indicate that the lower-case letter “i” in the name of the company actually stands for “Internet.” See Chatteraj Decl. Ex. H. For example, the use of the light bulb in Plaintiffs’ logo suggests an altogether different meaning (“idea”) for the lower-case “i”. See 30(b)(6) Deposition of John T. Colby, Jr., dated July 18, 2012, at 320:6-9. Chatteraj Decl. Ex. I; Scherer Decl. ¶ 16. This is obviously a disputed fact issue, rather than an “error” attributable to Mr. Scherer. Furthermore, as indicated above, see supra at 11-12, TMEP § 1209.03(d) is not material to, and is arguably inapplicable to, Plaintiffs’ mark as used with hard-copy and electronic books.

Sixth, in arguing that Mr. Scherer’s opinion on secondary meaning is unreliable, Apple contends that Mr. Scherer “ignored nearly all of” the factors considered by courts in assessing secondary meaning. Br. at 21. This is not true; in his report and his testimony, Mr. Scherer analyzed several factors – sales success, advertising expenditures, unsolicited media coverage and length and exclusivity of use – in arriving at his secondary meaning opinion. See Scherer Decl. ¶ 18; Scherer Report at 35-36; Scherer Dep. at 185:8-186:8. Apple’s assertion that Mr. Scherer relied on “a single unsubstantiated claim of sales in 2002 to support his conclusion,” Br. at 21-22, is simply false. Mr. Scherer relied on cited transcript sections of the deposition of Plaintiffs’ principal John Colby, see Scherer Report at 35 (citing over \$20 million in sales for the years 2003-2011), and on transcripts of depositions of several other named witnesses, see Scherer Dep. 286:5-23; Scherer Decl. ¶ 18.

In sum, all of Apple’s assaults on the reliability of Mr. Scherer’s testimony arise from Apple’s disputes with Mr. Scherer’s opinions or on Apple’s arguments about disputed issues of fact. These issues hardly suggest that Mr. Scherer’s testimony should be excluded. To

the contrary, all of the foregoing disputes make clear exactly why Mr. Scherer's testimony, analyzing the evidence by the lights of his experience and legal knowledge, would be helpful to the trier of fact.

IV. MR. SCHERER'S OPINION REGARDING APPLE'S PATTERN OF TRADEMARK LITIGATION IN SIMILAR CIRCUMSTANCES IS RELEVANT AND ADMISSIBLE

In Section 15 of his Report, Mr. Scherer lists Apple's many disputes with and lawsuits by companies whose trademarks Apple adopted and announced without those companies' consent, and opines, based on his 33 years in the trademark field, that this pattern of unusually frequent disputes demonstrates "either shoddy clearance procedures, corporate arrogance or a blatant disregard for the trademark rights of others" by Apple. Scherer Report at 43-44. Apple contends that this opinion is inadmissible "because this case is about one mark: iBooks." This contention fails. It is well-established that evidence of other trademark infringement lawsuits against a defendant is a factor in assessing the defendant's willfulness. See, e.g., Bambu Sales, Inc. v. Ozak Trading Inc., 58 F.3d 849, 854 (2d Cir. 1995) (finding willful trademark infringement because, among other factors, "defendants had been sued in a similar trademark infringement case in the past"); GTFM, Inc. v. Solid Clothing Inc., 214 F. Supp. 2d 273, 297 (S.D.N.Y. 2002) ("That [defendant] has been involved in numerous infringement actions in the past confirms its bad faith.") (Cote, J.); see also Telebrands Corp. v. HM Import USA Corp., No. 09-CV-3492, 2012 WL 3930405, at *5 (E.D.N.Y. July 26, 2012) ("A finding of willful infringement is particularly appropriate where, as here, the same defendant had been previously sued for similar violations, yet failed thereafter to take steps to avoid infringing the intellectual property rights of others."), adopted, 2012 WL 3957188, at *1 (E.D.N.Y. Sept. 10, 2012). Because the facts on which his opinion is based have been deemed to

be relevant as a matter of law, and the inference Mr. Scherer draws from those facts is expressly contemplated by existing authorities, no basis exists to exclude this evidence, or Mr. Scherer's opinion based on it.¹³

V. MR. SCHERER'S OPINION REGARDING APPLE'S BAD FAITH WAS ADEQUATELY DISCLOSED

Apple argues that the Court should exclude Mr. Scherer's opinion that Apple's continued use of the iBooks mark after being notified by Plaintiffs of the conflicting use in January 2010 evinced "bad faith." First, Apple argues that "Mr. Scherer is factually incorrect" because it contends that Plaintiffs' January 29, 2010 email to Apple was not a "cease and desist" letter. Br. at 24 n.8. Plaintiffs contend that the email was intended to, and did, put Apple on notice of Plaintiffs' potential claims. See Deposition of John T. Colby, Jr., dated July 20, 2012 at 251:22-253:2, Chatteraj Decl. Ex. J; La Perle Dep. at 288:9-289:2. Mr. Scherer could reasonably rely on the latter view, based on his professional experience and training; in any event, this is obviously a dispute over facts that does not undermine the reliability of Mr. Scherer's opinion. Second, Apple argues that this opinion was not sufficiently disclosed in Mr. Scherer's two reports, and instead only emerged at his deposition.¹⁴ To the contrary, however, Mr. Scherer's reports disclose his opinion about Apple's bad faith conduct in several contexts. See Scherer Dep. at 334:12-336:17; Scherer Report at 17, 32, 44; Scherer Decl. ¶ 24. In light of

¹³ Moreover, contrary to Apple's contentions, no judge presiding over this action has ever expressly denied Plaintiffs' discovery requests as to other products or trademarks, instead holding that, after resolution of the parties' pending motions, Plaintiffs should meet and confer with Defendant's counsel, and if no resolution was reached, parties were free to address their differences in a letter to the Court. See Chatteraj Decl. Ex. K.

¹⁴ Although Apple contends that Mr. Scherer's opinion was only "disclosed" through objectionable re-direct examination by Plaintiff's counsel, Br. at 24, Mr. Scherer actually testified to the basis for his opinion, and pointed out its appearance in his report, in responses to Defendant's counsel's re-cross. See Scherer Dep. 333:14-336:19.

these statements, the notion that Mr. Scherer's disclosures did not put Apple on notice of his opinion that Apple had acted in bad faith cannot be credited.¹⁵

CONCLUSION

For the foregoing reasons, Mr. Scherer's reports, testimony and opinions should not be excluded, and Apple's Motion to Exclude Any Testimony, Argument or Evidence Regarding The Expert Reports and Opinions of Robert T. Scherer should be denied.

Respectfully submitted,

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¹⁵ In any event, Apple's counsel took the opportunity to question Mr. Scherer concerning his "bad faith" opinion at his deposition, and Apple can point to no prejudice that could have arisen from the alleged nondisclosure. See, e.g., Hein v. Cuprum, S.A., 53 Fed. App'x 134, 136-37 (2d Cir. 2002); Harkabi v. Sandisk Corp., No. 08 Civ. 8203(WHP), 2012 WL 2574717, at *5-*6 (S.D.N.Y. June 20, 2012) (no plausible claim of surprise, and testimony merely added evidentiary details for existing opinions).